chapter 20

Appeals to the Court of Appeals for the Federal Circuit

Mixing law and technology can be complex, especially for district courts trying to follow the precedent of appellate courts that lacked a steady diet of patent cases. This complexity led to a lack of uniformity in patent law. The lack of uniformity and concomitant lack of predictability led to many calls for specialized courts of one form or another. The U.S. Court of Appeals for the Federal Circuit was established by the Federal Courts Improvement Act of 1982,[1] in part, to provide for the " 'special need for nationwide uniformity' in certain areas of the law."[2] The Federal Circuit is an Article III court under the U.S. Constitution and is a "co-equal member" of the system of 13 U.S. courts of appeals.[3] The Federal Circuit has nationwide jurisdiction over a number of specialized legal areas, including patent appeals from district courts.

A familiarity with the case law and procedural law in all jurisdictional areas of the court is necessary to formulate the strongest positions during appeal. Because the Court of Appeals for the Federal Circuit hears virtually all patent appeals, and because the Supreme Court reviews only a small number of patent cases each year, the Federal Circuit is more often than not the highest court that will hear a patent appeal. It is worth noting, however, that the Supreme Court issued five significant patent opinions in 2014, and three in 2015.[4]

The Federal Circuit, which has authorized 12 active judges,[5] also has six senior judges[6] who hear and resolve cases. Ap-

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1. Pub. L. No. 97-164, 96 Stat. 25.

2. United States v. Hohri, 482 U.S. 64, 72 (1987).

3. *In re* Roberts, 846 F.2d 1360, 1362 (Fed. Cir. 1988) (en banc).

4. *See* Kimble v. Marvel Entm't, LLC, __ U.S. __, 2015 WL 2473380 (June 22, 2015); Commil U.S., LLC v. Cisco Sys., Inc., 135 S. Ct. 1920 (2015); Teva Pharms. USA, Inc. v. Sandoz, Inc., 135 S. Ct. 831 (2015); Alice Corp. v. CLS Bank Int'l, 134 S. Ct. 2347 (2014); Limelight Networks, Inc. v. Akamai Techs., Inc., 134 S. Ct. 2111 (2014); Nautilus, Inc. v. Biosig Instruments, Inc., 134 S. Ct. 2120 (2014); Octane Fitness, LLC v. ICON Health & Fitness, Inc., 134 S. Ct. 1749 (2014); Highmark Inc. v. Allcare Health Mgmt. Sys., 134 S. Ct. 1744 (2014).

5. The 12 active judges are (1) Chief Judge Sharon Prost; (2) Judge Pauline Newman; (3) Judge Alan David Lourie; (4) Judge Timothy B. Dyk; (5) Judge Kimberly Ann Moore; (6) Judge Kathleen M. O'Malley; (7) Judge Jimmie V. Reyna; (8) Judge Evan Wallach; (9) Judge Richard G. Taranto; (10) Judge Raymond T. Chen; (11) Judge Todd M. Hughes; and (12) Judge Kara Farnandez Stoll.

6. The six senior judges are (1) Judge Haldane Robert Mayer; (2) Judge S. Jay Plager; (3) Judge Raymond Charles Clevenger III; (4) Judge Alvin Anthony Schall; (5) Judge William Curtis Bryson; and (6) Judge Richard Linn.

peals are randomly assigned to panels to provide each judge "with a representative cross-section of the fields of law within the jurisdiction of the court."[7] Cases are generally heard by a panel of three judges; however, any odd number of at least three judges may form the panel.[8]

Panels of the Federal Circuit are bound by the decisions of the Supreme Court, the precedential (or published decisions) of the Federal Circuit, and the decisions of the Federal Circuit's predecessor courts: the Court of Customs and Patent Appeals and the Court of Claims.[9] A precedential decision of the Federal Circuit or one of its predecessor courts is binding on subsequent Federal Circuit panels unless overruled by the Supreme Court or the Federal Circuit sitting en banc.[10] When a conflict occurs between the decisions of a prior and subsequent panel, the decision of the first panel is considered precedential; provided, of course, that the first panel opinion is not itself conflicting with other applicable precedent (i.e., an earlier Federal Circuit decision or any Supreme Court decision).[11] A panel, however, will not be overruling precedent if it is simply "refin[ing] holdings in its precedent which were stated or have been interpreted too broadly."[12]

Apparent conflicts can also arise from dicta in a case. These typically infrequent "conflicts" are not usually problematic because, according to the Federal Circuit, any statements "beyond what was needed to decide the facts of the precedential case is properly characterized as *dicta*" and, therefore, is not binding.[13] While only statements necessary for the decision are binding, dicta of course can be persuasive, especially to the judge who authored the apparent dicta in the first instance.

I. Scope of Review

The Federal Circuit reviews district court decisions for errors of law de novo[14] but will not set aside factual findings unless the district court's factual determination was clearly erroneous[15] or the jury lacked substantial evidence for its factual finding.[16]

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[7] . FED. CIR. R. 47.2(b).

[8] . FED. CIR. R. 47.2(a).

[9] . South Corp. v. United States, 690 F.2d 1368, 1370 (Fed. Cir. 1982) (en banc); Remington Prods., Inc. v. N. Am. Philips Corp., 892 F.2d 1576, 1579 (Fed. Cir. 1990).

[10]. Newell Co. v. Kenney Mfg. Co., 864 F.2d 757, 765 (Fed. Cir. 1988); Kimberly-Clark Corp. v. Fort Howard Paper Co., 772 F.2d 860, 863 (Fed. Cir. 1985).

[11]. *Newell Co.*, 864 F.2d at 765; Johnston v. Ivac Corp., 885 F.2d 1574, 1579 (Fed. Cir. 1989); *see, e.g.*, Atl. Thermaplastics Co. v. Taytex Corp., 970 F.2d 834, 838 n.2 (Fed. Cir. 1992) (refusing to follow a previous case that had not considered earlier Supreme Court precedent).

[12]. Woodward v. Sage Prods., Inc., 818 F.2d 841, 851 (Fed Cir. 1987) (en banc).

[13]. Mingus Constructors, Inc. v. United States, 812 F.2d 1387, 1394 (Fed. Cir. 1987); *see* Hayes v. Dep't of Health & Human Servs., 829 F.2d 1092, 1105 (Fed. Cir. 1987); Horner v. Schuck, 843 F.2d 1368, 1377 (Fed. Cir. 1988).

[14]. Litton Sys., Inc. v. Honeywell Inc., 87 F.3d 1559, 1566 (Fed. Cir. 1996).

[15]. FED. R. CIV. P. 52(a)(6); Spindelfabrik Suessen-Schurr Stahlecker & Grill v. Schubert & Salzer Maschinenfabrik, 829 F.2d 1075, 1077 (Fed. Cir. 1987).

Thus, even if the Federal Circuit would have come to a different factual conclusion than the lower tribunal, it will nevertheless affirm unless the finding was clearly erroneous or the record lacks substantial evidence for the finding.[17] If no factual determination has been made, the Federal Circuit "may make a finding of fact on evidence that is undisputed";[18] however, the Federal Circuit generally avoids fact finding.[19] Moreover, to successfully overturn a district court decision, a mere mischaracterization of the facts is insufficient; instead, the mistake must amount to reversible error.[20]

For areas that are not unique to patent law, the Federal Circuit will review the decisions of the trial court under the law of the regional circuit.[21] For example, the court has confirmed that it reviews rulings on judgment as a matter of law under the standards applied by the circuit from which the appeal originated.[22]

Federal Circuit judges of course appreciate the great importance to the parties of all cases they hear. However, they will most likely not overturn a lower tribunal's decision unless it is required by law, puts issues of significant public policy at stake, presents an issue that has not previously been resolved, or requires further clarification of the law in some respect. Because of the standard of review, any errors that would be considered a question of law are favored issues to appeal, since review is de novo (i.e., the legal issues are freely reviewed). Chief among these areas of review had been claim constructions, which had long been reviewed under a de novo standard.[23] The Supreme Court recently addressed that standard and its resulting opinion is interpreted to mean that underlying factual determinations related to claim construction are fact questions now reviewed for

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[16]. Baxter Healthcare Corp. v. Spectramed, Inc., 49 F.3d 1575, 1582 (Fed. Cir. 1995).

[17]. Orion IP, LLC v. Hyundai Motor Am., 605 F.3d 967, 974 (Fed. Cir. 2010); Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 1571 (Fed. Cir. 1986); Henkel Corp. v. P&G, 560 F.3d 1286, 1291 (Fed. Cir. 2009); Harris Corp. v. Ericsson Inc., 417 F.3d 1241, 1259 (Fed. Cir. 2005); Blount Bros. Corp. v. United States, 872 F.2d 1003, 1003 (Fed. Cir. 1989); FMC Corp. v. United States, 853 F.2d 882, 883 (Fed. Cir. 1988).

[18]. The Federal Circuit has observed that "[a]n appellate court may make a finding on evidence that is undisputed" and then may resolve the issue by applying the proper rules of law to the findings; accordingly, a remand for the trial court to make findings and conclusions would then be unnecessary. SmithKline Diagnostics, Inc. v. Helena Lab. Corp., 859 F.2d 878, 886 n.4, 891 (Fed. Cir. 1988); UMC Elecs. Co. v. United States, 816 F.2d 647, 657 (Fed. Cir. 1987); Black & Decker, Inc. v. Hoover Serv. Ctr., 886 F.2d 1290, 1294 (Fed. Cir. 1989); *see also* Consol. Aluminum Corp. v. Foseco Int'l Ltd., 910 F.2d 804, 814 (Fed. Cir. 1990). Furthermore, such a finding of fact may be made even when the evidence is disputed if, as a matter of law, the trial tribunal could make only one finding of fact or decide the fact in only one way. "Otherwise, protracted litigation and unnecessary delay and expense would occur." *SmithKline*, 859 F.2d at 886 n.4; B.D. Click Co. v. United States, 614 F.2d 748, 755 (Ct. Cl. 1980); Maxwell Dynamometer Co. v. United States, 386 F.2d 855, 870 (Ct. Cl. 1967); Torncello v. United States, 681 F.2d 756, 761 (Ct. Cl. 1982). The Federal Circuit has also stated that it "may infer findings necessary to explicit findings of a prior tribunal." Webster v. Dep't of Army, 911 F.2d 679, 684 n.2 (Fed. Cir. 1990); Bott v. Four Star Corp., 807 F.2d 1567, 1576 (Fed. Cir. 1986).

[19]. Mittal Steel Point Lisas Ltd. v. United States, 542 F.3d 867, 875 (Fed. Cir. 2008) (and cases cited therein) ("Appellate courts do not make factual findings; they review them."); Atl. Thermoplastics Co. v. Faytex Corp., 5 F.3d 1477, 1479 (Fed. Cir. 1993) ("Fact-finding by the appellate court is simply not permitted.").

[20]. *See* Hines *ex rel.* Sevier v. Sec'y of DHHS, 940 F.2d 1518, 1528 (Fed. Cir. 1991) ("If the special master has considered the relevant evidence of record, drawn plausible inferences and articulated a rational basis for the decision, reversible error will be extremely difficult to demonstrate."); *see also* Ill. Tool Works Inc. v. Grip-Pak, Inc., 906 F.2d 679, 684 (Fed. Cir. 1990) (inappropriate "to quote mere language from a court opinion while disregarding" the facts that led to the quoted language).

[21]. DMI Inc. v. Deere & Co., 802 F.2d 421, 428 (Fed. Cir. 1986); Mitutoyo Corp. v. Cent. Purchasing, 499 F.3d 1284, 1290 (Fed. Cir. 2007).

[22]. *E.g.*, Activevideo Networks v. Verizon Commc'ns, 694 F.3d 1312, 1319 (Fed. Cir. 2012) (applying Fourth Circuit's de novo review standard to rulings on pre- and post-verdict judgment as a matter of law in case appealed from the Eastern District of Virginia).

[23]. Cybon Corp v. FAS Techs., Inc., 138 F.3d 1448, 1455 (Fed. Cir. 1998) (en banc).

clear error,[24] but the ultimate determinations are still reviewed de novo.[25] Thus, when a challenged claim construction relies on extrinsic evidence, the Federal Circuit will provide greater deference; however, it does not hesitate to overturn the district court's construction when it believes it lacks sufficient support.[26] Further, when a claim construction is based solely on the intrinsic record (as it often is under the *Phillips* framework),[27] the district court's claim construction is reviewed de novo, as it has been since *Markman* proceedings began.[28]

Under the de novo standard, since the *Phillips* framework was established in 2005, the Federal Circuit has reversed about 30 percent of cases including a claim construction appeal (and about 25 percent of claim constructions on a per term basis).[29] Other common areas for patent litigation appeals are obviousness,[30] enablement,[31] and definiteness[32] as well as appeals from granted summary judgments.[33]

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[24]. *See* Lighting Ballast Control LLC v. Philips Elecs. N. Am. Corp., No. 2012-1014, __ F.3d __, 2015 WL 3852932, at *6 (Fed. Cir. June 23, 2015) (applying clear-error standard to district court's factual findings and reversing Federal Circuit's pre-*Teva* holding).

[25]. Cadence Pharms. Inc. v. Exela Pharmsci Inc., 708 F.3d 1364, 1368 (Fed. Cir. 2015) ("In reviewing questions of claim construction and obviousness, we review underlying factual determinations for clear error and ultimate determinations *de novo*.") (citing Teva Pharm. USA, Inc. v. Sandoz, Inc., 135 S. Ct. 831, 841 (2015)).

[26]. *See* Teva Pharm. USA, Inc. v. Sandoz, Inc., No. 2012-1567, Slip Op. at p. 3 (Fed. Cir. June 18, 2015) (on remand from Supreme Court, finding claims still indefinite and invalid under new Supreme Court standard).

[27]. Phillips v. AWH Corp., 415 F.3d 1303, 1318 (Fed. Cir. 2005) ("We have viewed extrinsic evidence in general as less reliable than the patent and its prosecution history in determining how to read claim terms, for several reasons.").

[28]. Fenner Invs., Ltd. v. Cellco P'ship, No. 778 F.3d 1320, 1322 (Fed. Cir. 2015) (citing *Teva*, 135 S. Ct. at 841); *see also* Teva Pharm. USA Inc. v. Sandoz, Inc., 135 S. Ct. 831, 841 (2015) ("[W]hen the district court reviews only evidence intrinsic to the patent (the patent claims and specifications, along with the patent's prosecution history), the judge's determination will amount solely to a determination of law, and the Court of Appeals will review that construction *de novo*."); Shire Dev. v. Watson Pharms., __ F.3d ___, 2015 WL 3483245, at *4 (Fed. Cir. 2015) ("In this case, we review the district court's constructions *de novo*, as the intrinsic evidence fully determines the proper constructions.").

[29]. J. Jonas Anderson & Peter S. Menell, *Informal Deference: A Historical, Empirical, and Normative Analysis of Patent Claim Construction*, 108 NW. U. L. REV. 1, 6 (2013) (citations omitted); Richard S. Gruner, *How High Is Too High?: Reflections on the Sources and Meaning of Claim Construction Reversal Rates at the Federal Circuit*, 43 LOY. L.A. L. REV. 981, 984 & n.2 (Spring 2010) (and articles cited therein); Ted Sichelman, *Myths of (Un)Certainty at the Federal Circuit*, 43 LOY. L.A. L. REV. 1161, 1171–74 (Spring 2010) (and articles cited therein).

[30]. Oakley, Inc. v. Sunglass Hut Int'l, 316 F.3d 1331, 1339 (Fed. Cir. 2003) ("obviousness is a question of law based on underlying factual determination").

[31]. Janssen Pharmaceutica N.V. v. Teva Pharms. USA, Inc., 583 F.3d 1317, 1323 (Fed. Cir. 2009) ("Enablement is a question of law we review without deference. We review the factual issues underlying enablement for clear error.").

[32]. Exxon Res. & Eng'g Co. v. United States, 265 F.3d 1371, 1376 (Fed. Cir. 2001) ("[d]efiniteness is a question of law, which we review de novo").

[33]. While a grant of summary judgment is reviewed de novo by the Federal Circuit, *Petrolite Corp. v. Baker Hughes Inc.*, 96 F.3d 1423, 1425 (Fed. Cir. 1996) ("We review a district court's grant of summary judgment de novo."); *Glaverbel Societé Anonymé & Fosbel, Inc. v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1559 (Fed. Cir. 1995) ("We give plenary review to whether the issue was appropriately disposed of by summary judgment."), a denial of a motion for summary judgment is reviewed for abuse of discretion. Elekta Instrument S.A. v. O.U.R. Scientific Int'l, Inc., 214 F.3d 1302, 1306 Fed. Cir. 2000) ("In reviewing a denial of a motion for summary judgment, we give considerable deference to the trial court, and 'will not disturb the trial court's denial of summary judgment unless we find that the court has indeed abused its discretion.'").

Other areas will present themselves as hot areas, depending on recent case law. For example, while written description is a question of fact,[34] the expansion of its interpretation in recent years makes it an area potentially ripe for appeal that should be considered if the case presents the issue.[35] Likewise, the Supreme Court's recent holding in *Limelight Networks, Inc. v. Akamai Technologies, Inc.*, may provide grounds for appealing factual determinations related to whether or not there has been induced infringement.[36]

II. Mechanics of Filing the Appeal

The Rules of Practice for the Court of Appeals for the Federal Circuit[37] contain the Federal Rules of Appellate Procedure as well as the Federal Circuit Rules, which contain modifications for appeals to the Federal Circuit. The Rules of Practice also contain the Federal Circuit Practice Notes, which provide helpful guidance concerning how the Federal Circuit applies these rules. While the rules of an appellate court outline the standards the court must use to review a case, the Federal Circuit also helpfully posts its internal operating procedures.[38] The Federal Circuit has also set up a new mediation program that went into effect on December 6, 2013.[39]

The parts of the Federal Rules of Appellate Procedure that do not apply to the Federal Circuit are indicated by strikeout in the Rules of Practice, with the Federal Circuit's rule printed alongside. The practice notes, which annotate many of the rules, provide a further understanding of the rules. The Foreword to the Rules of Practice, however, states that "Counsel may rely on the [practice] notes but may not use them to avoid controlling statutes or rules, which govern in the event of conflict. As a general practice, do not cite the [practice] notes."

The rules set forth requirements of how briefs should be written, filed, and served on opposing counsel, and also include instructions on motions practice and oral argument. The rules also explain in detail what must be included in filings and the timetables for appeal events. The rules should always be consulted in every appeal and any questions can be directed to the office of the clerk of court or experienced counsel.

Failing to abide by the court's rules may result in a waiver of certain rights or even dismissal with prejudice of the appeal.[40] Furthermore, disregarding the rules can suggest carelessness and generally will not be viewed favorably. If it is a close question,

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[34]. Vas-Cath, Inc. Mahurkar, 935 F.2d 1555, 1563 (Fed. Cir. 1991).

[35]. *See* Ariad Pharms., Inc. v. Eli Lilly & Co., 598 F.3d 1336, 1344 (Fed. Cir. 2010) (en banc).

[36]. 134 S. Ct. 2111, 2117 (2014) ("[W]here there has been no direct infringement, there can be no inducement of infringement under [35 U.S.C.] § 271(b).").

[37]. http://www.cafc.uscourts.gov/rules-of-practice/rules.

[38]. The Federal Circuit's Internal Operating Procedures can be found at http://www.cafc.uscourts.gov/rules-of-practice/internal-operating-procedures. These procedures include a notice that "[b]ecause the Internal Operating Procedures (IOPs) govern internal court procedures, they are not intended to replace or supplement the Federal Rules of Appellate Procedure or the Federal Circuit Rules, which govern procedures in appeals. Counsel should not cite the IOPs in appeal filings or rely on them to avoid controlling statutes or rules."

[39]. Details on the mediation program are also available on the Federal Circuit's website, http://www.cafc.uscourts.gov/mediation/mediation.

[40]. *See* Pi-Net Int'l, Inc. v. JPMorgan Chase & Co., No. 2014-1495, D.I. 74, Fed. Cir. Order at 2–3 (Fed. Cir. Apr. 20, 2015) (striking appeal in its entirety because "[n]either the previously filed brief nor the most recent proffered corrected brief comply with the court's rules. Instead, they represent an attempt to file briefs that, if written properly, exceed the permitted word limitation.").

human nature embraces the party that has shown the greatest reliability.

The court expects counsel to be familiar with the current rules.[41] The present version of the Rules of Practice became effective June 1, 2011; however, the rules are amended with some regularity, so counsel must check for updates or changes to the rules. While Federal Rule of Appellate Procedure 2 permits suspension of any provision of the rules by the court on its own or on a party's motion, it is a necessity to carefully review the rules and to understand them, as such suspensions rarely occur.

To appeal a district court decision, a notice of appeal and the associated filing fee must be filed with the district court clerk within 30 days of the date of the appealed judgment or order.[42] This deadline can be, but should not be expected to be, extended by the district court by motion of a party, for excusable neglect, or for good cause.[43] The Federal Circuit lacks the authority to sua sponte waive the late filing of a notice of appeal, even if the document was deposited in the mail in a timely fashion.[44]

An appeal is filed when the notice of appeal is received by the trial court.[45] The date the appeal is docketed by the clerk of the Federal Circuit is not ordinarily the same as the date of the filing of the notice of appeal in the district court. After receiving the copy of the notice of appeal and the docket entries from the district court clerk, the clerk of the Federal Circuit will docket the appeal under the title of the district court action and identify the appellant.[46] The date of docketing at the Federal Circuit starts the timeline for filing briefs.[47] The Federal Circuit clerk will then notify all parties of the docket date and provide the official caption for the case.[48]

The notice of appeal must specify the party taking the appeal by naming each one in the caption or body of the notice.[49] Multiple parties may, however, be described as "all parties," "the defendants," "the plaintiffs A, B, et al.," or "all defendants except X."[50] Only a party that has filed a notice of appeal may attack all or any part of the trial court judgment.[51] Any party at the trial court level that does not file a notice of appeal may participate in the appeal as an appellee but may not seek to overturn

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[41]. For example, the preface, which is contained in the Foreword to the Rules of Practice, states that "Counsel are assumed to be familiar with this information [i.e., the Federal Rules of Appellate Procedure, the Federal Circuit Rules, and the Federal Circuit Practice Notes]."

[42]. FED. R. APP. P. 3(c)(1)(A); if the United States or its officer or agency is a party, this is extended to 60 days for any party. FED. R. APP. P. 4(a)(1)(B).

[43]. FED. R. APP. P. 4(a)(5)(A); *see* Two-Way Media LLC v. AT&T, Inc., No. 2014-1302, Op. at 1 (Fed. Cir. Mar. 19, 2015) (finding that district court did not abuse its discretion or clearly error in refusing to extend AT&T's appeal window after the appeal period lapsed). AT&T's request for rehearing en banc has been denied and AT&T has stated that it will file a certiorari petition to the Supreme Court.

[44]. FED. R. APP. P. 26(b); *see also* Durango Assoc. Inc. v. Reflange, Inc., 912 F.2d 1423, 1425 (Fed. Cir. 1990).

[45]. FED. CIR. R. 12 practice note.

[46]. FED. R. APP. P. 12(a).

[47]. FED. CIR. R. 12 practice note.

[48]. FED. CIR. R. 12 and practice note.

[49]. FED. R. APP. P. 3(c)(1)(A).

[50]. FED. R. APP. P. 4(a)(1)(A).

[51]. FED. CIR. R. 3 practice note.

or modify the judgment.[52] A party may present additional arguments in support of the judgment as an appellee. Notably, offering additional arguments in support of the judgment as the appellee does not constitute proper grounds for a cross-appeal.[53] Consequently, parties should be prepared to defend their reasoning for filing a cross-appeal at all stages of briefing and at oral argument.[54]

Service of appellate documents is explained in detail in the rules, which state that service may be personal—including delivery to the office of counsel, by mail, by commercial carrier for delivery within three days, or by electronic means (if the party being served consents in writing).[55] Significantly, although the rules state that for electronic service there must be consent in writing, on May 17, 2012, the court issued an administrative order regarding electronic case filing, which includes specific guidelines for electronic filings and electronic service at the Federal Circuit.[56] To the extent the administrative order conflicts with the existing rules, the order supersedes the rules.

The administrative order provides that electronic filing of documents constitutes service on all parties represented by attorneys, who are required to have registered for the court's case management/electronic case files (CM/ECF) system.[57] Electronic service is considered completed upon transmission.[58] Such documents are considered served on the day sent unless it is not a business day, in which case service is considered completed on the next business day.[59] Not surprisingly, the rules require a certificate of service for all electronically served documents.[60] Three days are ordinarily added to the response date for documents served electronically because only documents that are hand-delivered are not subject to the three-day rule.

If a party is not represented by counsel and has not registered for the CM/ECF system, that party is to be served under the other means outlined in Federal Circuit Rule 25.[61] Confidential documents are filed under separate cover in ECF. The rules provide special provisions for serving confidential documents that are not to be served electronically.[62] Notably, service of a filing

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[52]. *Id.*

[53]. FED. CIR. R. 28 practice note; *see* Bailey v. Dart Container Corp., 292 F.3d 1360, 1362 (Fed. Cir. 2002).

[54]. Aventis Pharma S.A. v. Hospira, 637 F.3d 1341, 1343 (Fed. Cir. 2011) ("Our precedent consistently warns against the improper use of a cross-appeal to reach issues that do not otherwise expand the scope of the judgment. A cross-appeal may only be filed when a party seeks to enlarge its own rights under the judgment or to lessen the rights of its adversary under the judgment.") (citations omitted); *see also* Radio Steel & Mfg. Co. v. MTD Prods., Inc., 731 F.2d 840, 844 (Fed. Cir. 1984) (finding that cross-appeals are proper when the proposed argument advocates for a reversal or modification of the judgment rather than an affirmance).

[55]. FED. R. APP. P. 25(c).

[56]. http://www.cafc.uscourts.gov/sites/default/files/cmecf/Final_ECF_Administrative_Order_5-17-12.pdf.

[57]. ECF-6(A); *see also* ECF-2 (noting that attorneys who appear before the Federal Circuit must register for the CM/ECF system).

[58]. FED. R. APP. P. 25(c)(4).

[59]. ECF-6(E).

[60]. ECF-6(B).

[61]. ECF-6(C).

[62]. ECF-6(D); *see also* ECF-8; ECF-9.

to an invalid e-mail address constitutes valid service if the intended recipient has failed to timely provide a current address.[63]

In general, the evidence of record available for a Federal Circuit appeal includes everything that was available to the district court. Specifically, the record on appeal is composed of any papers and exhibits filed in the district court; the transcripts of proceedings, if any; and a certified copy of the docket entries prepared by the clerk of the district court.[64] Generally, the Federal Circuit will not consider "non-record, post appeal events" and limits its review to the record made before the district court.[65] Indeed, it is difficult to fathom how the district court could have clearly erred or abused its discretion in coming to a conclusion at odds with evidence not before it. Notably (and perhaps somewhat obviously), argument of counsel is not evidence of record, is not a substitute for evidence, and is not helpful to an appeal if not tied to record evidence.[66]

The timetable for filing briefs at the Federal Circuit is as follows. Typically, the appellant must serve and file its initial brief within 60 days after the date of the docketing of its appeal.[67] Docketing a cross-appeal does not affect the time for serving and filing the appellant's initial brief.[68] The appellee or cross-appellant must serve and file its brief within 40 days after the appellant's brief is served.[69] In a cross-appeal, the appellant must serve and file its reply brief within 40 days from the time the cross-appellant's brief is served and the cross-appellant must serve and file its reply brief within 14 days after the appellant's reply brief is served.[70]

In the absence of a cross-appeal, the appellant should serve and file a reply brief within 14 days of service of the appellee's brief.[71] Ordinarily, the briefing schedule will not run too close to oral argument, but, if it does, the reply brief may need to be filed early. A reply brief that is filed within seven days of oral argument must be served so that it reaches all parties before the argument.[72] As a general practice regarding citations within briefs, the Federal Circuit discourages parallel citations to reporters

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[63]. ECF-6(F).

[64]. FED. R. APP. P. 10.

[65]. Datascope Corp. v. SMEC Inc., 879 F.2d 820, 824 (Fed. Cir. 1989); Am. Standard, Inc. v. Pfizer Inc., 828 F.2d 734, 746 (Fed. Cir. 1987); Ballard Med. Prod. v. Wright, 821 F.2d 642, 643 (Fed. Cir. 1987).

[66]. C.R. Bard, Inc. v. Advanced Cardiovascular Sys., Inc., 911 F.2d 670, 674 n.2 (Fed. Cir. 1990); *In re* Teledyne Indus., Inc., 696 F.2d 968, 971 (Fed. Cir. 1982); Weinar v. Rollform, Inc., 744 F.2d 797, 806 (Fed. Cir. 1984) ("[a]rgument of counsel on appeal, however, cannot substitute for evidence"); Broadcom Corp. v. Qualcomm, Inc., 543 F.3d 683, 694 (Fed. Cir. 2008); Johnston v. Ivac Corp., 885 F.2d 1574, 1581 (Fed. Cir. 1989) ("[a]ttorneys' argument is no substitute for evidence"); Invitrogen Corp. v. Clontech Labs., Inc., 429 F.3d 1052, 1067 (Fed. Cir. 2005) ("Unsubstantiated attorney argument regarding the meaning of technical evidence is no substitute for competent, substantiated expert testimony."); Enzo Biochem v. Gen-Probe, Inc., 424 F.3d 1276, 1284 (Fed. Cir. 2005) ("Attorney argument is no substitute for evidence.").

[67]. FED. CIR. R. 31(a)(1)(A).

[68]. *Id.*

[69]. *Id.*

[70]. *Id.*

[71]. *Id.*

[72]. *Id.*

other than the Federal Reporter.[73]

The length of the brief is set by Federal Rule of Appellate Procedure 32(a)(7) and, for cross-appeals, by Rule 28.1(e). The preferred approach for most Federal Circuit litigants to comply with the length limitation is by using the type-volume limitation described in Rule 32(a)(7). Under this rule, the appellant's and the appellee's principal briefs may include no more than 14,000 words or, if these briefs use a monospaced face, they may contain no more than 1,300 lines of text. The appellant's reply brief is limited to 7,000 words or 650 lines of text.

In cases including cross-appeals,[74] the appellant's principal brief is limited to 14,000 words (or 1,300 lines of monospaced text), while the appellee's (cross-appellant's) principal and responsive brief may contain no more than 16,500 words (or no more than 1,500 lines of monospaced text). The appellant's response and reply brief is limited to 14,000 words (or 1,300 lines of monospaced text), while the appellee's reply brief may contain no more than 7,000 words (or no more than 650 lines of monospaced text). Any brief submitted under the type-volume limitations must contain a certificate of compliance by counsel that the brief complies with the type-volume limitation and must state the number of words (or the number of lines of monospaced type) in the brief.[75]

In determining the type-volume of the brief, while headings, footnotes, and quotations count toward the word and line limitations, the corporate disclosure statement, table of contents, table of citations, statement with respect to oral argument, any addendum containing statutes, rules of regulations, and any certificates of counsel do not count toward the limitation.[76] Similarly, the certificate of interest, the statement of related cases, and the addendum in an initial brief are not counted in the type-volume limitations.[77]

Alternatively, the parties may base the length of their briefs on the total page length of an individual brief. This approach is not typically used because it results in substantially less space for presenting your arguments when compared to the word count approach. If this approach is followed, the appellant's and the appellee's principal briefs are limited to 30 pages, while the appellant's reply brief is limited to 15 pages.[78] For cross-appeals under this approach, the appellant's opening brief cannot exceed 30 pages, the appellee's (cross-appellant's) principal and response brief cannot exceed 35 pages,[79] the appellant's response and reply brief is limited to 30 pages, and the appellee's reply brief is limited to 15 pages.[80]

The Federal Circuit "looks with disfavor" on a motion to file an extended brief and grants it only for "extraordinary" reasons.[81] On those occasions when an extended brief is permitted, a responsive brief is ordinarily (but not always) permitted to

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[73]. FED. CIR. R. 28(e).

[74]. FED. R. APP. P. 28.1(e)(2).

[75]. FED. R. APP. P. 32(a)(7)(C); FED. R. APP. P. 28.1(e)(3).

[76]. FED. R. APP. P. 32(a)(7)(B)(iii).

[77]. FED. CIR. R. 32(b).

[78]. FED. R. APP. P. 32(a)(7)(A).

[79]. FED. R. APP. P. 28.1(e)(1).

[80]. *Id.*

[81]. FED. CIR. R. 28(c).

have the same number of additional pages or words.[82] Failure, by an appellant or petitioner, to file an initial brief provides the clerk with authority to dismiss the appeal.[83] The rules, however, do not include such a restriction for reply briefs. For extensions of time, unless extraordinary circumstances require otherwise, any motions for extension must be made at least seven days before the respective due date.[84] Oppositions, if warranted, should be filed promptly because the court will not necessarily wait for an opposition before ruling on the extension request.[85]

Preparing the joint appendix requires extensive cooperation between the parties and failure to file an appendix that conforms to Federal Circuit Rule 30 may result in dismissal.[86] According to Rule 30(a), the purpose of the rule is to limit the size of the appendix. Nevertheless, certain documents are required to be reproduced in the appendix, including the relevant docket entries in the proceeding below and the relevant portions of the pleadings, charge, findings, or opinion, as well as the judgment, order, or decision in question.[87] Specific to the Federal Circuit is the inclusion of the entire docket sheet from the proceedings below including, in jury cases, the judge's charge, verdict, and any jury response to interrogatories as well as the patent-in-suit and any other necessary patents.[88] Any nonprecedential opinion or order cited must be included, and in addition to providing cited transcript pages, the parties are encouraged to provide sufficient surrounding pages to give the court context.[89] Uncited parts of the record that are otherwise authorized by Federal Rule of Appellate Procedure 30(a)(1)(D) must *not* be included in the appendix (except for context purposes).[90] The rules permit including in the appendix briefs and memoranda in their entirety where the only issue on appeal is the propriety of summary judgment by the district court.[91] If the appellant considers parts of the record to have been referenced in violation of Rule 30, the appellant may require the appellee to "advance the costs of including those parts in the appendix."[92]

As noted, the Federal Circuit "requires electronic filing of documents" with certain exceptions.[93] Accordingly, most filings

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[82]. *Id*.

[83]. FED. CIR. R. 31(d).

[84]. FED. CIR. R. 26(b)(l).

[85]. FED. CIR. R. 26 practice note.

[86]. FED. CIR. R. 30 practice note.

[87]. FED. R. APP. P. 30(a)(1)(A)–(C).

[88]. FED. CIR. R. 30(a)(2).

[89]. *Id.*

[90]. FED. CIR. R. 30(a)(2)(B).

[91]. FED. CIR. R. 30(a)(2)(F)(iii).

[92] . FED. CIR. R. 30(a)(2)(D).

[93] . Revised FED. CIR. R. 25(a); *see also* ECF-8, Exceptions to Requirements for Electronic Filing and Service.

are done electronically. The logistical guidelines for following the court's e-filing process are outlined in the previously noted administrative order regarding electronic case filing.[94] As part of e-filing, attorneys who appear before the court must register with the e-filing system.[95] Documents are considered to be filed at the time they are filed in accordance with the court's e-filing notice—on due dates, filings must be completed before midnight Eastern Time.[96] For e-filing, where required, parties can submit confidential and nonconfidential versions.[97]

Generally, e-filed documents do not need to be submitted in paper form to the court.[98] However, six identical paper copies of briefs (principal briefs, response or reply briefs, supplemental briefs, or amicus briefs) are to be filed within five days of an accepted ECF filing.[99] Six paper copies of appendices are also to be filed within five days of their ECF acceptance.[100] There are also special requirements to submit three paper copies of any petition for panel rehearing, 16 paper copies of any petition for en banc review (hearing or rehearing), and 16 paper copies of any combined panel and en banc rehearing petition.[101] Importantly, paper copies related to rehearing petitions or en banc petitions are to be submitted within *two business days* of the ECF filing.[102]

In addition to petitions, briefs in en banc cases also have special paper copy requirements. Twenty-eight paper copies of en banc (hearing and rehearing) briefs are required to be filed with the court.[103] Generally, paper copies of en banc related briefs are due within five days of the ECF filing, though those that were filed before the court's order granting en banc review are due seven days after ECF filing.[104]

For any necessary paper filings, the Federal Circuit Clerk's Office is located in the National Courts Building, 717 Madison Place, N.W., Washington, D.C. 20439, Room 401. Although it is open from 9:00 a.m. to 5:00 p.m. on business days, papers may be deposited until midnight in a drop box in the garage entrance on H Street N.W. between Madison Place, N.W. and 15th Street N.W. Alternatively, a party may deposit the briefs and appendices with a commercial delivery service before midnight on the day for filing under terms calling for delivery to the clerk within three days.[105]

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[94] . http://www.cafc.uscourts.gov/sites/default/files/cmecf/Final_ECF_Administrative_Order_5-17-12.pdf.

[95] . ECF-2(A).

[96] . ECF-5(A).

[97] . ECF-9.

[98] . ECF-10.

[99] . ECF-10(B).

[100]. ECF-10(C).

[101]. ECF-10(D).

[102]. *Id.*

[103]. ECF-10(E).

[104]. *Id.*

[105]. FED. CIR. R. 25(a)(2)(B)(ii).

When the situation arises, a party may—without leave of the court—file a letter citing any significant authority that came to the party's attention after the party's brief was filed or even after oral argument but before a decision has been issued.[106] For letters that are e-filed, the six paper copies called for in Rule 28 are not required.[107] The letter must state the reason for the supplement, referring to the page of the brief (or the issue argued), and the body of the letter is limited to 350 words or less.[108] Any response must be filed promptly and is limited by the same constraints.[109]

If counsel fails to follow the Federal Circuit's rules, the office of the clerk of court will call the principal attorney. While the clerk will often be able to resolve such mistakes, they are never advisable, and can result in a wholly rejected brief or motion.

The Federal Circuit's website lists the top reasons briefs and motions are rejected:[110] (1) the document is not text searchable;[111] (2) the document does not comply with format rules;[112] (3) the wrong event or wrong relief is selected when e-filing;[113] (4) the entry of appearance is not filed or is incomplete;[114] (5) the certificate of interest is missing or incomplete;[115] (6) the docketing statement is incomplete;[116] (7) the attorney filing a brief does not represent a party;[117] (8) the attorney filing the brief is not a member of the Federal Circuit Bar;[118] (9) multiple documents are filed together;[119] and (10) the brief or appendix is filed out of

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[106]. FED. CIR. R. 28(i).

[107]. FED. CIR. R. 28(i).

[108]. FED. R. APP. P. 28(j).

[109]. *Id.*

[110]. Fed. Cir., Top Ten Most Common Errors in Briefs and Motions (2014), http://www.cafc.uscourts.gov/sites/default/files/rules-of-practice/top_ten_briefs_and_motions_rejection_list.pdf.

[111]. FED. CIR. R. 25.

[112]. FED. CIR. R. 28, 32.

[113]. ECF User Guide.

[114]. FED. CIR. R. 47.3.

[115]. *See* Form 9, available on the Clerk's Office tab under Forms.

[116]. *See* Form 26.

[117]. FED. R. APP. P. 29; FED. CIR. R. 29.

[118]. FED. CIR. R. 46.

[119]. ECF User Guide.

time.[120] While many of these are minor oversights, they indicate what the clerk's office will focus on.

III. Preparing the Shell

Each brief and argument will be driven by the specific facts of the case; however, there are several broad concepts that may be of value, each of which can be applied for crafting an initial shell of a brief. Appeal briefs should be organized to parallel a speech or an oral argument. Naturally, the focus of any appeal should be sharpened as answering briefs are reviewed and considered. Thus, as the appeal progresses, the focus of the arguments may change. Each brief written (and the initial shell), on the side of the appellant or the appellee, should be organized to best follow the arguments that the party expects (at the time of drafting) to present to the court at oral argument. Generally, the stronger arguments are advisably presented first; however, there can be reasons to depart from this order. Significantly, you will hurt your chances of prevailing if you do not address substantial arguments made by your opponent.

The headings (within the shell and the final brief) should be short statements that plead your case. When the judge and the judge's clerks read the table of contents, they should be able to divine the gist and flow of the argument. Active headings are most persuasive. Thus, "The District Court Erred by Impermissibly Narrowing the Claims" is superior to "The District Court's Claim Construction."

From start to finish, credibility is crucial to the brief. Counsel must be brutally accurate in stating the facts. If any of the facts are challenged, any incorrect or misleading information will operate to undermine credibility. Even items as mundane as Bluebook form and, in particular, case law cite checking, should be carefully reviewed; clerks or judges who believe you are sloppy or lack attention to detail may not be willing to fully trust you in areas where they are less familiar with the facts and law.

Rule 28, which sets out the general framework for briefs, was updated as of December 1, 2013.[121] The new framework includes a detailed recitation of the contents and structure required for briefs. Notably, the outlined framework in the rule now more closely mirrors that of briefs filed with the Supreme Court.

A. Introduction

Federal Rule of Appellate Procedure 28 does not require an introduction; however, one should ordinarily be included. The first few sentences of the brief provide the initial and best chance to grab the reader's attention and orient the appeal in the most favorable way. The act of writing the brief will distill and crystallize the arguments in the case. Consequently, while the initial draft introduction is helpful in getting started and removing any writer's block, it will be necessary to rewrite the introduction once the brief has taken a more definite forum.

B. Statement of Related Cases

The statement of related cases is outlined in Rule 47.5. This section is to include (1) whether any other appeal in or from the same civil action or proceeding in the lower court or tribunal was previously before the Federal Circuit or any other appellate court, and (2) the title and number of any case known to counsel to be pending in the Federal Circuit or any other court that will directly affect or be directly affected by the Federal Circuit's decision in the pending appeal.

C. Jurisdictional Statement

The Federal Rules of Appellate Procedure require a "jurisdictional statement" that includes

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[120]. FED. CIR. R. 26, 30, 31.

[121]. The updated rule can be found at http://www.cafc.uscourts.gov/sites/default/files/rules-of-practice/Amendments/f_c_r%2028%20conformed_eff_12-1-2013%20.pdf.

> (A) the basis for the district court's . . . subject-matter jurisdiction, with citations to applicable statutory provisions and stating relevant facts establishing jurisdiction; (B) the basis for the Court of Appeals' jurisdiction, with citations to applicable statutory provisions and stating relevant facts establishing jurisdiction; (C) the filing dates establishing the timeliness of the appeal; and (D) an assertion that the appeal is from a final order or judgment that disposes of all parties' claims, or information establishing the court of appeals' jurisdiction on some other basis.[122]

Without proper jurisdiction, the Federal Circuit is unable to rule on a case.[123] The jurisdictional statement provides a quick and efficient way to satisfy the court that the case is properly before it. Tracking the language of the rule (assuming the facts confirm the required statements), the parties can provide a solid explanation of jurisdiction and allay any concerns that the case should not be reviewed by the court.

D. Statement of the Issues

It is very important to limit the number of issues presented on appeal. Ordinarily, three or four issues should be the maximum. Of equal or greater importance is how the limited issues are articulated for the court. Each individual issue should be phrased as a question and in a manner that is accurate and clear. Further, the issues should be framed such that it would be difficult for the court to answer in a manner that is unfavorable to the drafter.

E. Statement of the Case: Setting Out the Facts Relevant to the Issues

The statement of the case used to be a vehicle for very succinctly setting out the nature of the case and its procedural history for the court. It was preferable to keep this section to just one or two (short) paragraphs. However, a 2013 rule amendment provides much more flexibility in making this section more detailed and substantive.[124]

In supporting the amendment, the committee explained that the new statement of the case section "allow the lawyer to present the factual and procedural history chronologically, but would also provide flexibility to depart from chronological ordering."[125] As such, the new section may (preferably) include internal headings and can (also preferably) be crafted to clearly describe the background of the case, weaving together the procedural history of the case with the facts so that the court has a firm understanding of the case posture and why the facts support the drafter's position(s). Although the statement of the case can be persuasive, it should not be argumentative.

Under the changes to Rule 28, the section previously designated as "statement of the facts" now falls under the umbrella of statement of the case. In this regard, this section should set forth the facts. It should be designed to tell a story, be factually accurate, and avoid significant omissions without engaging in argument. If necessary, a statutory background providing concise neutral statements of the law can be provided. Generally, any necessary technological tutorial can be laid out here. A clear rendition of any key prior art, the technology of the case, and other issues facing those of skill in the art and germane to the appeal will help orient the court to the case's most compelling issues. A good statement of the case will entertain and concentrate exclusively on materials relevant to the issues at hand.

While a good statement of the case will speak through the district court record, in limited circumstances, using nonrecord information may be useful if it helps explain the technology or events. For example, citations to recognized scientific textbooks

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[122]. FED. R. APP. P. 28(a)(4).

[123]. Nat'l Presto Indus., Inc. v. Dazey Corp., 107 F.3d 1576, 1580 (Fed. Cir. 1997) ("Without jurisdiction, federal courts are powerless to make findings or otherwise decide a case.").

[124]. Amended FED. CIR. R. 28, http://www.cafc.uscourts.gov/sites/default/files/rules-of-practice/Amendments/f_c_r%2028%20conformed_eff_12-1-2013%20.pdf. The amendment to Federal Circuit Rule 28 conforms to changes to Federal Rule of Appellate Procedure 28, which both became effective on December 1, 2013.

[125]. Memorandum from Advisory Committee on Rules of Appellate Procedure (May 2, 2011), http://www.uscourts.gov/rules-policies/archives/committee-reports/advisory-committee-rules-appellate-procedure-may-2011.

or treatises may be appropriate. Footnotes should generally be avoided; they break up the flow of the story and are often unnecessary. However, in some cases, they can be a useful vehicle for delivering bad facts or discussing or preserving less-key points.[126] Every case ordinarily has some bad facts for each side. It is always advisable to address bad facts directly, delivering them in the most favorable light. Ignoring bad facts will tarnish credibility and can be detrimental to an appeal.

First drafts of the statement of the case are ordinarily far longer and more boring than is advisable or, even, acceptable. Once the entire brief is drafted, it will be possible to condense the section and sharpen the story by removing information that is irrelevant or only marginally relevant to the limited issues on appeal.

F. Summary of the Argument

The summary of the argument must (1) "contain a succinct, clear, and accurate statement of the arguments made in the body of the brief," and (2) "not merely repeat the argument headings."[127] Although it is useful to draft the summary of the argument early in the process, it is valuable to revisit the section while the argument is being drafted. When the argument section is finished, it is necessary to revise the summary of the argument section to ensure that it accurately presents the final argument contained in the brief. The summary is a useful check on the organization of the argument and acts as a map for the rest of the brief.

G. Argument

The argument section should set forth the relevant law first and must include a summary of the applicable standards of review.[128] The statement of the case, as noted, educates the court on the relevant facts of the case, preferably in a manner that ties the terminology of case law to the facts. The argument section explains the law in a manner that demonstrates support for your position.

In the argument section, first present the applicable (and precedential) case law. Then, show that the facts in your case fall within and are consistent with the case law. If possible, demonstrate that the policy concerns behind the prevailing law are advanced by the proposed resolution; this can be a powerful tool.

Although the argument section may have provided counterarguments to the other sides' position throughout its development, a separate section addressing the opposition's position is often advisable. Putting the counterarguments at the end of the argument section lets the strength of the brief center on the drafting party's own case. Summarizing your party's position at the end of the counterarguments section is also helpful to reorient the reader. It is always advisable to be careful about addressing counterarguments that have not been and may not be advanced by the opposition. Consequently, it is often preferable to wait until the reply brief before advancing counterarguments, so the exact arguments made by your opponents (and no additional arguments) are addressed. It is not, of course, beneficial to make the other side's case for them or create nonexistent arguments.

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[126]. Note, however, that attempting to preserve points by merely mentioning them in a footnote can be dangerous. *See* ConocoPhillips v. United States, 501 F.3d 1374, 1381–82 (Fed. Cir. 2007) ("In this court, ConocoPhillips refers to the trial court's waiver ruling with respect to the minority preference claim only in a single conclusory statement in a footnote in its opening brief. Its entire argument on that issue consists of the following statement: '[T]he law and the record do not support such a holding [of waiver] with respect to ConocoPhillips' . . . illegal minority price preference claims.' That summary statement, made in passing only in a footnote, is not sufficient under our precedents to preserve an argument for review. . . ."); *see also* SmithKline Beecham Corp. v. Apotex Corp., 439 F.3d 1312, 1320 (Fed. Cir. 2006); Cross Med. Prods. v. Medtronic Sofamor Danek, Inc., 424 F.3d 1293, 1320–21 n.3 (Fed. Cir. 2005); Fuji Photo Film Co. v. Jazz Photo Corp., 394 F.3d 1368, 1375 n.4 (Fed. Cir. 2005); Graphic Controls Corp. v. Utah Med. Prods., 149 F.3d 1382, 1385 (Fed. Cir. 1998); 20A JAMES W. MOORE ET AL., MOORE'S FEDERAL PRACTICE § 328.20[9] (3d ed. 2007) ("an argument or claim mentioned only in passing or only in a footnote is not adequately raised or preserved for appellate review").

[127]. FED. R. APP. P. 28(a)(8).

[128]. FED. CIR. R. 28(a)(10). The standard of review is often crucial because it is the "lens" through which the Federal Circuit judges review the "alleged errors" in an appeal. As former Federal Circuit Chief Judge Michel observed, "Standards of review . . . influence the disposition of appeals far more than many advocates realize." Hon. Paul R. Michel, *Appellate Advocacy—One Judge's Point of View*, 2 FED. CIR. BAR. J. 1, 2 (Summer 1991); *see id.* at 2–5 (discussing the meaning and importance of various appellate standards of review).

IV. Answering Brief

The answering brief needs to comply with the ordinary briefing requirements, except (in appropriate circumstances) for the jurisdictional statement, the statement of the issues, the statement of the case, and the standard of review, which do not have to be included if there is no disagreement with the opening brief.[129] Nevertheless, omitting some or all of these sections in the appellee's brief can be detrimental. The sections written by the opposition are seldom, if ever, actually neutral. Although the Federal Circuit rule limits the appellee to "areas of disagreement," it is always acceptable to include a competing section if the opposition's material was argumentative, incorrect, misleading, and/or incomplete.

V. Drafting Federal Circuit Appeal Briefs

The general framework for a brief and the contents of each section is previously set forth. Those individual sections, however, cannot be viewed in isolation. The brief sections must work together as a cohesive unit that persuasively tells an understandable story and orients the reader to the themes advanced therein. The discussion that follows outlines an overall stylistic review of briefs and how they can be authored in the most persuasive way.

A brief is called a brief for a reason. Every judge and one or more of his or her law clerks reads hundreds of pages of relevant materials including the briefs, relevant parts of the trial court record, and parts of the appendix. This can be exhausting, so it is vital to focus them on the key issues in, if possible, an interesting manner. Poor writing, overly complicated arguments, and unnecessary scientific or technical complexity should be avoided.

Similarly, including all possible arguments in a brief is not advisable and will not increase the chance of winning. In fact, too many arguments will actually decrease your chances of prevailing. Overinclusion of arguments inevitably de-emphasizes the strongest arguments. Additionally, raising too many issues will give the impression that the appellant believes *nothing* was done correctly by the trial court, a suggestion that is rarely accurate and usually hurts your credibility. Instead of asserting as many arguments as possible to see if any stick, it is far more advisable to prioritize and limit the arguments and issues. Ordinarily, it is preferable to lead with the strongest argument, thereby grabbing the court's attention at the outset. For complicated appeals including multiple issues, appellants are encouraged to narrow the appeal and reduce the number of issues to, if possible, no more than two or three issues.

As with all legal advocacy, the strongest case cannot be presented unless it is clear and concise (both orally and in writing). Clarity and brevity can be achieved in the briefs by avoiding lengthy paragraphs and including division, subdivision, sections, and captions throughout. Additionally, and as noted in the Federal Rules of Appellate Procedure, counsel can help to make their case clearer by using the parties' actual names, the designations used in the lower court, or descriptive terms such as "inventor," "patent owner," or "accused infringers" instead of "appellant" or "appellee."[130] All together, these tips assist in framing the issues for the court, using the facts in the most persuasive way, and presenting the law in the most favorable light.

It is not helpful to use excessively complex language, especially of a technical nature. This is a special problem for patent cases, which for many years existed outside of the mainstream of normal law practice. Appellate practice, and advocacy in general, involves persuading the decision maker(s) to adopt your view. Decision maker(s) cannot make the most informed determinations, or be persuaded, if (1) they are mentally translating highly technical jargon that is only understandable or decipherable to a Ph.D. in a particular scientific discipline, or (2) they do not understand the meaning of the convoluted materials before them. Simply because clients or inventors prefer particular technical jargon does not mean it is the best vehicle for advocating a particular position to the Federal Circuit. Moreover, if not presented properly, many aspects of technology can be boring or in-

[129]. FED. R. APP. P. 28(b).

[130]. FED. R. APP. P. 28(d).

comprehensible to the uninitiated, even if they have a solid technical background.

Any roadblocks to the judges'—or, almost (and sometimes just) as importantly, their law clerks'—understanding is detrimental to any appeal. Thus, crisp, clean statements that quickly and clearly convey information are best for explaining the case, describing technology, and making arguments at the Federal Circuit. Unnecessary words should be omitted to the maximum extent possible. Also, technical ideas should always be expressed in a manner comprehensible to a layman. Many of the judges on the Federal Circuit do not have technical degrees and none on the panel may have a relevant technical degree for the technology at issue in the pending case. While they generally have law clerks with a technical background and access to the court's technical advisors, it is a mistake to craft any brief in a manner that necessitates an advanced technical degree for proper comprehension. The same is true regarding lofty arguments not well tied to the relevant law or the facts of the case. If it is difficult for a layperson to understand, it should be rewritten: any attorney who properly understands the issues in his or her case should be able to simplify and clarify the issues so they can be understood by a layperson.

Thus, a general mantra for Federal Circuit appeal briefs is that less is often more. Always strive to be as concise as possible when drafting, and remember that there should be a reason for each and every word in a brief.

VI. Oral Argument

While the court generally holds oral argument during the first full week of each month in Washington, D.C., the court may sit elsewhere in the United States and at other times, though this usually only occurs once or twice per year. If no enlargements for briefing (or other reasons, such as mediation) are granted, oral argument is typically held about six to nine months after the clerk of the Federal Circuit dockets the case. Appeals are usually calendared for oral argument within two to four months after all of the briefs and the joint appendix are filed.[131] The clerk will advise the parties of a firm argument date approximately 30 to 45 days from the hearing and will provide a pamphlet, *Notice to Counsel on Oral Argument*, which contains detailed instructions regarding the conduct of oral arguments.[132] Once scheduled, a case is unlikely to be postponed except on a motion showing compelling need; consequently, counsel should advise the clerk in writing within 30 days of the end of the briefing of potential conflicts or as soon as a potential conflict arises.[133]

The identities of the judges on the panel assigned to a case are disclosed on the day of oral argument. This makes it more difficult to craft the appeal and oral argument to any particular judge on the panel. The judges and their clerks generally receive all of the briefing material for the case at least 30 days prior to the oral hearing. Often, one of the four law clerks for each active judge will be assigned to prepare a bench brief of the case, to fully understand the record and to brief the judge on issues articulated in the briefs or uncovered in the clerk's research.[134] Consequently, the judges, who ordinarily read all of the briefs themselves, are quite familiar with the briefs and the facts of the case at the time of the oral argument and it is important to emphasize only the truly important issues.

Counsel are instructed to report to the clerk's office at least 30 minutes before their scheduled session and before proceeding to the courtroom. The participants will then be permitted to indicate how much of their time should be reserved for rebuttal argument. Generally, each side is permitted 15 minutes for oral argument, but the court may vary this time depending on the nature of the case. Appellants and cross-appellants can reserve time for rebuttal and must inform the clerk's office of how much

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[131]. FED. CIR. R. 34 practice note.

[132]. FED. CIR. R. 34 practice note.

[133]. *Id.*

[134]. Judges who have assumed senior status are assigned at least one law clerk.

they are so reserving. The court will sometimes involve the participants in questioning that extends beyond the allocated time. In such cases, the court will ordinarily still provide the requested rebuttal time and will often increase the time permitted for opposing counsel to argue. If the panel has questions, they will generally provide additional time to respond.

There are many articles and expositions on presenting an appellate argument. One often recommended, though dated, is that of the Honorable John W. Davis of the New York City Bar in 1940.[135] Another that is very helpful for Federal Circuit appeals is *Appellate Advocacy—One Judge's Point of View*, which was written by now retired Federal Circuit Chief Judge Michel.[136] The approach to the oral argument will be dictated by the facts, the procedural posture, and (especially) the issues that become sharpened in the briefing process.

There are, however, a number of points that may be generally helpful for oral arguments to any Federal Circuit panel. Precise and persuasive "attention grabbers" are always advisable to open an argument—a simple statement that centers the court and puts everyone on the same stage. Next, a road map: immediately state the points that will be covered. For example, "I want to cover three issues for the court today; they are (1) . . . , (2) . . . , and (3). . . ." As with the briefs: (1) the number of issues should be very limited, and (2) starting with a theme and weaving it in throughout (including in response to questions from the bench) can be extremely useful and persuasive.

Allocation of time is also key. The judges appreciate that argument time is very limited and that some (or many) of the briefed arguments will not be covered during oral argument. Those arguments and their underlying reasoning are not waived by a failure to address them during oral argument. Provide a very succinct version of the critical facts that support your most important arguments. Do not discuss irrelevant or tangentially related facts. Counsel should assume that at least one judge—and, usually, all members of the panel—is thoroughly familiar with the case.

Credibility is vital. Thus, the best and strongest arguments should be the focus of oral argument and you should (1) not dispute the indisputable, and (2) concede points where you have no substantial opposing arguments or where the failure to concede makes you appear to be unreasonable or disingenuous. Counsel should also be courteous, honest, and accurate; maintain eye contact with the panel; and always remain professional to the opposing party, the judges, and the court staff.

The judges of the Federal Circuit are often very active during oral arguments, and counsel are most often engaged in substantial dialogue with the bench. An uninterrupted monologue is very rare. To maintain credibility, counsel must directly answer all questions asked and, to repeat an important point, concede points of law or fact where there simply is no contrary support (in the law or the facts).

In addressing questions from the bench, look to the question *behind* the question asked. Sometimes judges provide softball questions for you to knock out of the park (so, for example, you can educate another judge on that issue or to bolster a judge's preformed opinion on an issue). Alternatively, sometimes judges direct you down a path you do not want to go. In both cases, a strong advocate will recognize what is happening in real time, not when it is too late to adequately respond.

An oral argument that begins with an unnecessarily detailed discussion of the facts or a long explanation of the procedural history will usually be interrupted by the judges, who will then try to focus the argument on key issues that are bothering them. Addressing the judges' concerns is always the top priority. Even if you begin the oral argument with a short list of issues, as suggested previously, the judges may interrupt. However, if at all possible, it is preferable to briefly outline the road map of the issues that you intend to cover. To the extent questioning from the bench consumes all allotted time, the judges often expand the time permitted so that counsel can briefly address most of the points set forth in the road map.

All arguments will, no doubt, have soft spots that will be probed by the bench. A strong advocate should rehearse at least the outline of how to respond to those expected probes of soft spots.

In short, as questions are received from the panel, take a moment to make sure that you understand the question. At all times the question should be viewed and interpreted from the judge's perspective, which permits a more reasoned response as well as one that is more likely to resolve the judge's concern. The questions from the bench are not usually designed to trap; instead, the panelist may be testing the argument or trying to simplify the issue. Indeed, as noted, the panelist may be trying to

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[135]. John W. Davis, *The Argument on an Appeal*, 26 A.B.A. J. 895 (1940).

[136]. Michel, *supra* note 127.

steer counsel in a direction that is more convincing to other panel members. It is surprising how often the arguing attorney does not recognize or appreciate when one of the judges is actually asking a question that strongly supports the attorney's position. At all times, it is important to candidly answer the court's questions. Credibility is, as noted, crucial. Nothing is more detrimental to a case than to have a judge perceive that an attorney has been less than forthright or candid with respect to an issue.

It is important to appreciate the role of an appellate court; the case has been tried and some issues have either been resolved or are very difficult to challenge at the appellate level. An appellate argument is not a replay of district court closing argument. The role of an appellate court is to review what went on below, not to retry the case. The panel needs to hear what was in error and, most importantly, how that error affected the result. Litigation is sufficiently complex—especially for a trial—that some errors nearly always occur. A party is not, however, guaranteed a perfect trial-level proceeding but only due process, which ultimately means fairness. Error must be shown to be more than harmless because an appellate court reviews judgments, not opinions, and minor errors will not force the Federal Circuit to reverse an otherwise fair judgment.[137] Concentrate on the key errors and emphasize *how* those key errors negatively affected the judgment.

As with the briefs, technical and legal jargon should be avoided during the oral argument. Jargon can be convenient, and a shorthand way to communicate to those in the know. Often, however, the recipient of the information is not quite as knowledgeable about the subject as counsel. When jargon is conveyed, the listener may need to "translate" that into the vernacular. There is no value in forcing the judges to make that on-the-fly translation; it impedes their tracking of the argument and may not provide them all of the information necessary to make an informed decision or that you believe is associated with the jargon. Whatever the concept is, it needs to be presented in words that the judges readily understand. Distilling the technology to the simplest elements is especially useful. Often, in advance of oral argument, it is advisable to explain technology to and make sure it is understood by a colleague or legal assistant who is not technically trained and not a patent professional. Similarly, on the legal side, judges usually cannot know as much law in a particular field as an attorney who has given it months or, sometimes, years of contemplation, research, and consultation with experts. The rebuttal period is limited to addressing materials discussed in your opponent's oral presentation. Counsel is not allowed to introduce new subject areas. Such an improper introduction, in addition to being unfair, opens the possibility that the court will grant a period for response and remember you for your improper argument, which most likely will injure your credibility before the court.

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[137]. Atl. Thermoplastics Co. v. Faytex Corp., 5 F.3d 1477, 1480 (Fed. Cir. 1993); Newell Co. v. Kenney Mfg. Co., 864 F.2d 757, 765 (Fed. Cir. 1988) ("Trials must be fair, not perfect.").