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Peter G. McCabe, Secretary
Committee on Rules of Practice and Procedure
Administrative Office of the United States Courts
One Columbus Circle, NE
Washington, DC 20544

Re: Opposition to Proposed Federal Rule of Appellate Procedure 32.1, Citation of Non-precedential Dispositions

Dear Mr. McCabe:

We write in opposition to proposed Federal Rule of Appellate Procedure 32.1, which would force courts to allow citation of non-precedential opinions. Particularly in the field of patents, the proposed rule would increase the risk of confusion, raise costs, delay resolution, and likely increase the use of summary affirmances.

We are principals of Fish & Richardson P.C.[1] with considerable experience litigating patent cases before the International Trade Commission, federal district courts, and the United States Court of Appeals for the Federal Circuit ("Federal Circuit"). We also served as law clerks at the Federal Circuit and are familiar with the Federal Circuit's Rule 47.6(b), which provides that non-precedential opinions "must not be employed or cited as precedent." The Federal Circuit's discretion to adopt and maintain rules like Rule 47.6(b) should be preserved, and proposed Rule 32.1 should be rejected.

First, proposed Rule 32.1 would sow confusion as to what is precedent. Although the proposed rule does not require courts to give precedential effect to non-precedential appellate opinions, the rule would inevitably lead attorneys and lower courts to treat these opinions as significant authority because they come from the Federal Circuit, the only Circuit court that decides patent appeals. As attorneys, we must put in context for district court judges (many of whom do not regularly hear patent cases), decisions of split panels, panels that arguably disagree, and dissents of all sorts from opinions of the Federal Circuit. Add to this task an order of magnitude of more unpublished opinions and a challenging situation will become virtually unmanageable.

Moreover, because non-precedential opinions could be cited under the proposed rule, attorneys would be ethically obliged to review the many thousands of non-precedential opinions in search of potentially relevant language. They would also be forced to address the non-precedential opinions cited by opposing counsel. A nationwide survey conducted in 2003 by the American Intellectual Property Law Association found the

[1] The views expressed herein are our own and not those of the firm or any of its clients.

median cost of litigating a single-patent case all the way through trial is between $2 and $4 million. Proposed Rule 32.1 would raise this cost further by expanding the scope of legal research.

Proposed Rule 32.1 also would delay resolution of patent cases. According to the Judges of the Federal Circuit, the court would pay greater attention to the precise wording of non-precedential opinions under proposed Rule 32.1, which would delay the release of these opinions to the public. This need to devote more resources to non-precedential opinions would likely delay issuance of precedential opinions as well. Delaying the resolution of cases serves no public interest. In patent cases, delay is particularly harmful because a successful patentee is generally entitled to an injunction, which a losing defendant typically seeks to stay pending the outcome of an appeal. Additional delay deprives either a later-vindicated inventor of his exclusive right to his invention (if the injunction is stayed) or a later-vindicated defendant the opportunity to compete in the market (if the injunction takes immediate effect).

Finally, it is likely that proposed Rule 32.1 would increase the use of summary affirmances (for example, pursuant to Federal Circuit Rule 36, Judgment of Affirmance Without Opinion), which offer the parties no explanation of the outcome. As former clerks, we know that the Federal Circuit elects this type of disposition for a variety of reasons, and not only because the panel voted overwhelmingly to affirm. However, a client, who may have only one or two cases ever heard by the Federal Circuit, may not appreciate the import of a Rule 36 summary affirmance, especially if he or she is on the losing end of one. For many patent litigants, their case is a bet-the-company case and a Rule 36 affirmance is a dissatisfying end, even when they win.

We believe that, on balance, Federal Circuit Rule 47.6(b) is the best one for both courts and litigants. Therefore, we urge the Committee to reject Proposed Rule 32.1. We appreciate this opportunity to comment and thank you for your consideration.

Sincerely,

Lauren A. Degnan, Esq.

Howard G. Pollack, Esq.

Frank E. Scherkenbach, Esq.