The Fed. Circ. In February: A Reminder On Procedure Rule 28

By **Jeremiah Helm and Sean Murray** (March 28, 2024)

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This article is part of a monthly column that highlights an important patent appeal from the previous month. In this installment, we examine the Federal Circuit's comments on Rule 28 of the Federal Rules of Appellate Procedure in Promptu Systems Corp. v. Comcast Cable Communications LLC.

The U.S. Court of Appeals for the Federal Circuit does not often issue a sua sponte precedential order emphasizing an important rule of practice before the court. But in February, the Federal Circuit did just that in Promptu Systems Corp. v. Comcast Cable Communications LLC.

It is useful to look at how the Federal Circuit most recently applied the restrictions of Rule 28 of the Federal Rules of Appellate Procedure and explore the precedential decisions that provide context for the Promptu ruling.

The Federal Circuit polices its rules vigorously. One notable example is the Federal Circuit's rule that if an argument is raised in a footnote, it is not preserved.[1] The reason for this rule is that such arguments are typically underdeveloped and without adequate citation to either legal authority or the record.

Thus, in Cross Medical Products Inc. v. Medtronic Sofamor Danek Inc. in 2005, the Federal Circuit rejected an argument raised in a footnote that did not "request[] relief or provide[] record cites for its assertions."[2] Despite developing the argument further on reply, the court held that the argument was not properly raised in the "opening brief to warrant relief from this court."

Likewise, in Fuji Photo Film Co. v. Jazz Photo Corp., Fuji attempted to "raise a specter of … [an] argument in a footnote," and then "more fully in its reply brief."[3] But, the Federal Circuit explained in 2005, "this court will not address arguments not properly raised in an Appellee's opposition brief, which also served as an opening brief for its cross-appealed issues." Like Cross Medical, Fuji's argument, raised in a footnote, was not sufficiently developed and thus not considered by the court.

Perhaps the seminal example of the "arguments raised in footnotes are waived" line of cases is Graphic Controls Corp. v. Utah Medical Products Inc. from 1998.[4] In Graphic Controls, the Federal Circuit was, once again, faced with an underdeveloped argument raised in a footnote. But the footnote in Graphic Controls was not just a barebones argument; instead the footnote "reiterate[d] and incorporate[d] the arguments found in the [appendix]."

The Federal Circuit focused on the incorporation of arguments by reference as an improper attempt to evade the appellate rules. As the court explained: "Under the Federal Rules of Appellate Procedure, arguments may not be properly raised by incorporating them by reference from the appendix rather than discussing them in the brief."

The Federal Circuit cited Rule 28, and explained that a brief must include any arguments as well as the supporting authority, statutes, and citations to the record. Likewise, the court explained, Rule 28 requires that any brief must conform to the corresponding page limits and that "[t]he practice of incorporating arguments by reference from the appendix undermines these explicit rules." Accordingly, the court explained: "[W]e cannot and do not render a decision on this issue" raised only through incorporation.

The policy underlying this line of cases, and many of the Federal Circuit's other rules, is the issue of fairness to both advocates and the court. An underdeveloped argument, in a footnote or otherwise, does not put the court on sufficient notice of the party's positions. Likewise a party responding to an underdeveloped argument must guess at the actual position advocated and spend valuable briefing space to address arguments not properly raised.

The Federal Circuit thus routinely refers to and enforces Rule 28's requirement that a party's arguments must be raised in the brief with attendant support, and conform to the page and word limits set by the court.

The Federal Circuit's recent order in Promptu v. Comcast is a spiritual successor to the "footnote" line of cases, and continues the Federal Circuit's considered application of Rule 28.

In Promptu, the appellee attempted "to incorporate by reference multiple pages of argument from the brief in one case into another." The appellant complained in its reply, and pointed to the Federal Circuit's 2014 decision in Microsoft Corp. v. DataTern Inc.[5]

In Microsoft, the court held that a party cannot incorporate briefing from another party in a nonconsolidated case; although incorporation might be allowed in a consolidated case under Rule 28(i), a party cannot otherwise evade the briefing limits through incorporation of arguments from other briefs. Any other result, the court in Microsoft explained, "would be fundamentally unfair" because a party could "use incorporation to exceed word count."

In Promptu, the Federal Circuit rejected the idea that incorporating arguments from another brief might "enhance efficiency," "streamline the briefing," or "save the time and resources of the Court." Instead, the Federal Circuit explained, "[r]equiring the Court to cross-reference arguments from multiple briefs in multiple, separate cases does not increase efficiency nor does exceeding the word count."

Though the appellee asserted it was not aware of the court's previous decisions, including Microsoft, it did not withdraw the improperly incorporated arguments. That was the wrong approach: "When it becomes apparent that a lawyer has violated a court rule, as an officer of the court, it would be best for that lawyer to bring it to the court's attention and withdraw the improper argument."

The Federal Circuit viewed as "unreasonable" the appellee's position that the court had never previously addressed the specific issue of incorporation of arguments from the same party's brief in a companion appeal. Instead, the Federal Circuit explained, incorporation "from one brief by reference into another" is not allowed "unless in compliance with Fed. R. App. P. 28." And the Federal Circuit indicated that "in no event is such incorporation permitted if it would result in exceeding the applicable word count."

Fortunately for the appellee in Promptu, there were no sanctions. But that might not be the case the next time around. The Federal Circuit was clear that "violating these provisions in

the future will likely result in sanctions."

All of this is completely consistent with the Federal Circuit's decadeslong practice, dating back to at least Graphic Controls, of vigorously policing any attempt to evade Rule 28's requirements.

Whether raising barebones arguments in a footnote or via incorporation, practice before the Federal Circuit requires fully developed arguments made within the constraints of the briefing allowed by the Rules of Appellate Procedure and the Federal Circuit.

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[1] SmithKline Beecham Corp. v. Apotex Corp., 439 F.3d 1312, 1320 (Fed. Cir. 2006).

[2] Cross Medical Products Inc. v. Medtronic Sofamor Danek Inc., 424 F.3d 1293, 1320-21 n. 3 (Fed. Cir. 2005).

[3] Fuji Photo Film Co. v. Jazz Photo Corp., 394 F.3d 1368, 1375 n. 4 (Fed. Cir. 2005).

[4] Graphic Controls Corp. v. Utah Medical Products Inc., 149 F.3d 1382, 1385 (Fed. Cir. 1998).

[5] Microsoft Corp. v. DataTern Inc., 755 F.3d 899, 910 (Fed. Cir. 2014).