

Nineteen Hundred and Twenty-two

NYIPLA

The New York Intellectual Property Law Association®

The Amicus Brief Process

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DISCLAIMER

- **The following presentation reflects the personal opinions of its authors and does not necessarily represent the views of their respective clients, employers or of the New York Intellectual Property Law Association. Additionally, the following content is presented solely for the purposes of discussion and illustration, and does not comprise, nor is it to be considered, as legal advice.**

Agenda

- **Introduction:** Background on the Amicus Briefs Process
- **Conflict Clearance:** NYIPLA and Other Guidelines
- **Pro Bono Credit:** Discussion of Pro Bono Credit Requirements
- **Federal Circuit Amicus Briefs:** Formal Considerations, including selected examples from NYIPLA Federal Circuit Amicus Briefs
- **Supreme Circuit Amicus Briefs:** Formal Considerations, including selected examples from NYIPLA Supreme Court Amicus Briefs
- **Conclusion:** Some Strategic Considerations
- **Suggested Additional Reading**
- **Questions?**

Introduction: The Amicus Briefs Committee

- The Amicus Briefs Committee (“ABC” or “Committee”) represents the New York Intellectual Property Law Association’s (“NYIPLA” or “Association”) diverse Intellectual Property constituency before the courts. In particular, the ABC coordinates the activities of the Association in the preparation and filing of briefs *amicus curiae* and makes recommendations with respect thereto to the Board of Directors.

Introduction: Committee Guidelines

- NYIPLA guidelines mandate that the “substantive touchstone for the Committee . . . Should be an overriding concern for improvements in the application of the intellectual property laws by the courts and agencies in a consistent fashion which fulfills their Constitutionally mandated objectives. Additionally, the Association’s substantive positions should be formulated with a view to transparency, clarity and predictability.”
- Association guidelines also state that to the extent possible, the ABC should “avoid positions and arguments which might offend the legitimate concerns of significant minority membership factions.”
- Finally, guidelines admonish that “the Committee should strive for a tone that is neither overtly partisan nor strident.”
- As a practical matter, please note that 9 of the 16 NYIPLA Board Members must approve of a proposed Amicus Brief for it to be filed on the Association’s behalf.

Introduction: Committee Practice

- In accordance with these guidelines, the ABC leadership:
 - Strives to ensure that all sides of the issues presented by the cases before the Committee are fairly and thoroughly represented in Committee meetings;
 - Seeks to bring the Committee to a consensus position based on the legal merits of the cases before the Committee; and
 - Helps volunteer brief writers to prepare proposals to the Board, draft Amicus Briefs for Board approval, and file Amicus Briefs with the appropriate Court.
- The Committee primarily prepares and files amicus briefs in the US Court of Appeals for the Federal Circuit and in the US Supreme Court. That said, the Committee occasionally prepares briefs that are filed in other federal appeals courts, in state supreme courts, or in other venues.

Introduction: Committee Members

- Amicus briefs are prepared by ABC members on a volunteer basis.
- The Committee recognizes that its members have different skill sets and time constraints. Accordingly, the Committee encourages ALL WHO ARE INTERESTED (and who have no conflicts) TO PARTICIPATE in the brief writing process.
- Members can participate in a number of different ways, depending on their strengths and availability. Some Committee members may wish to take the lead in drafting arguments and giving voice to the Association's concerns. Others may wish to participate in the editing process to refine the brief and its tone. Still others may wish to provide legal research in their areas of expertise, or otherwise contribute to the amicus brief preparation process, such as assisting with logistics or cite checking.

Conflict Clearance: NYIPLA Guidelines

- The NYIPLA has mandated that the Committee “should strive to prevent undue influence by the parties in interest over the amicus process, and will require disclosure of all current representation of the parties in interest by the Committee . . . Members.”
- The Association also understands that ABC members “almost always will have a philosophical position they wish to espouse” and “may have clients that, although not parties, may be interested in the outcome of the litigation [at issue].” Nevertheless, “[n]either philosophical bias nor client interest should present any conflict of interest problem so long as . . . no conflicts exist under the [NYIPLA] guidelines”
- Accordingly, all ABC members should understand the NYIPLA’s conflict clearance guidelines. These guidelines are available at [https://www.nyipla.org/images/nyipla/Documents/Amicus Briefs/NYIPLA Procedural Guidelines for Amicus Briefing.pdf](https://www.nyipla.org/images/nyipla/Documents/Amicus%20Briefs/NYIPLA%20Procedural%20Guidelines%20for%20Amicus%20Briefing.pdf).

Conflict Clearance: Committee Practice

- As a practical matter, the ABC typically distributes agendas at least several days before scheduled meetings. This procedure is intended to allow its members time to conduct conflict checks before participating in Committee meetings. If an ABC member determines that he or she has a conflict, that member (and others from that member's firm) should recuse themselves from participating in any discussions or drafting with respect to the subject case.
- In the event that one or more Committee member(s) have a conflict, the Committee leadership will attempt to reorder the agenda to leave discussion of that case to the end of the meeting (allowing the conflicted member to participate in discussions of the other cases before signing off the call). However, if multiple members have conflicts regarding different cases, this may not be possible.

Conflict Clearance: Running Conflict Checks

- Committee members should conduct conflict checks in accordance with:
 - The NYIPLA Conflict Clearance Guidelines, available at <https://www.nyipla.org/images/nyipla/Documents/Amicus%20Briefs/NYIPLA%20Procedural%20Guidelines%20for%20Amicus%20Briefing.pdf>;
 - Their own firm's conflict clearance guidelines; and
 - Relevant state and other conflict clearance guidelines:
 - For New York, see <http://www.nycourts.gov/rules/jointappellate/ny-rules-prof-conduct-1200.pdf>
 - For New Jersey, see <https://www.judiciary.state.nj.us/attorneys/assets/rules/rpc.pdf>
 - For Connecticut, see <https://www.jud.ct.gov/Publications/PracticeBook/PB.pdf>
 - For USPTO, see <https://www.uspto.gov/learning-and-resources/patent-and-trademark-practitioners/current-patent-practitioner/ethics-rules>

NYIPLA Amicus Brief Conflict Guidelines

- We will discuss:
 - Recusal of attorney / law firm from amicus activities
 - Past situations involving recusal of attorney / law firm from amicus brief
 - NYIPLA 2008 Amicus Brief Rules
 - When conflicts may arise
 - NYIPLA's and attorneys' responsibilities in determining whether conflict exists
 - What action attorney can / cannot take if there may be a conflict

NYIPLA Amicus Brief Conflict Guidelines

Phillip Morris Case

- Sup. Ct of Illinois: Firm represented Phillip Morris, Inc.
- Sup. Ct of Massachusetts: Firm counsel of record for Amicus Brief of the National Association of Manufacturers (NAM).
 - Failed to disclose significant interest
 - Court denied NAM's motion for leave to file amicus brief

“A full and honest disclosure of the interest of amici is crucial to the fairness and integrity of the appellate process. Briefs of amicus curiae are intended to represent the views of non-parties; they are not intended as vehicles for parties or their counsel to make additional arguments beyond those that fit within the page constraints of their briefs”

Aspinall v. Philip Morris Cos., 442 Mass. 381, 385 n. 8, 813 N.E.2d 476 (2004)

NYIPLA Amicus Brief Conflict Guidelines

Champa Case

- Case involved settlement agreements between a public school and parents of public school student
- Attorney's law firm represented the public school's town
 - Attorney represented the town and drafted settlement agreement between plaintiff parents and town
- Attorney filed a separate amicus brief on behalf of herself

“attorney’s filing of a separate brief, purportedly as an amicus, to make further arguments supporting the client’s position, was ‘ill-advised’,”

NYIPLA Amicus Brief Conflict Guidelines

In re: World Trade Center Disaster Site Lit., No. 11-4021 (2nd Cir. 2013)

- Two former law clerks to Judge joined a law firm
- That firm was appointed to draft amicus brief
- Opposing counsel sought to disqualify firm
 - former law clerks working on the brief
 - New York Rule of Professional Conduct 1.12
“Specific Conflicts of Interest for Former Judges, Arbitrators, Mediators, or Other Third-Party Neutrals”:
“... prohibits the unfair and uneven access to confidential knowledge of former judicial law clerks ...”
 - Firm argued that this rule did not apply
- Second Circuit allowed amicus brief

2008 Conflict of Interest Guidelines (1/2)

Request for amicus support

1. [U]pon learning of any request for amicus support from a party in interest to an action, or any sua sponte proposal for amicus participation from a member of [certain NYIPLA committees] ... each member of the Committee shall undertake reasonable steps to determine whether any conflict of interest may disqualify such member from participating in the Committee's consideration of and voting on whether the Association should participate as an amicus in such action.
2. Each Committee member shall report in writing or by email ... whether the Committee member or the member's firm or corporate employer (i) currently represents a party in interest in any matter; or (ii) prosecuted a patent, trademark, copyright or other form of intellectual property at issue in the action under consideration.

2008 Conflict of Interest Guidelines (3/4)

Recusal of committee member

3. A committee member who is recused *shall not*:
 - a. **participate in the discussion of such action,**
 - b. **vote on any proposition affecting the nature or filing of any amicus brief** on behalf of the Association in such action;
 - c. **actively seek to influence** the vote of any other Committee or Board member; and
 - d. **participate in or contribute to the preparation of any amicus brief** intended for filing in such action on behalf of the Association.
4. A committee member shall be recused if such member or such member's law firm or corporate employer:
 - a. represents a party in the specific matter under consideration, or
 - b. is a party to the specific matter under consideration.

2008 Conflict of Interest Guidelines (5)

Recusal of committee member

5. A committee member *shall consider* recusal if such member:
 - a. ... represents any party to the action ... in any other matter;
 - b. ... as a parent, affiliate, or subsidiary company or as a party to a joint venture with such party;
 - c. ... prosecuted ... intellectual property at issue in the action;
 - d. ... has been engaged to prepare another amicus brief in the same action on behalf of any entity other than a bar association;
 - e. ... is requested by another Committee member to consider if recusal is warranted, or
 - f. Any other facts are known ... which might... create ... an appearance of a conflict of interest, or in any other way adversely affect the credibility of the Association.

2008 Conflict of Interest Guidelines ^(6/7)

Recusal of committee member

6. In any situation contemplated by Paragraph 5, the Committee member may in such member's discretion be recused voluntarily.

If such member elects not to be recused voluntarily, and if such refusal is challenged by another Committee member, the Committee Chair and Board Liaison shall promptly make a determination ...

7. Any disclosures to the Committee or Board required by these Guidelines shall only be made

- a. the extent permitted consistent with the Committee member's professional responsibility to any client.
- b. If the Committee member concludes that no disclosure is permissible consistent with the member's professional responsibilities, then the member shall be recused.

2008 Conflict of Interest Guidelines (8-10)

Committee and Board members

8. If any Committee member learns at any time before an amicus brief is filed that such member should have been recused, such Board member shall promptly so advise the Committee Chair ...
9. That the outcome of a particular action that is being considered for *amicus* briefing may impact clients of a member of the Committee, will not ... present a conflict of interest ...
10. All discussions and voting on amicus matters by the Committee and Board shall be maintained in confidence.

Key Points to Remember

Potential Problem Areas

- 1. Disclosing Other Interests of an Amicus**
- 2. Indirect Monetary Contributions**

Amicus Work May Qualify for Some Pro Bono Credit

“Each matter would have to be evaluated independently to determine whether it meets the ABA’s, Pro Bono Institute’s or bar’s definition of pro bono work. (I use every definition I can to increase the chances our no-fee work can qualify as pro bono; if the work qualifies under any definition, it qualifies.)”

- Anonymous (attributed to a law firm pro bono counsel outside of New York)

1. Pro Bono Institute Principle 7

As used in this statement, the term pro bono refers to activities of the firm undertaken normally without expectation of fee and not in the course of ordinary commercial practice and consisting of (i) the delivery of legal services to persons of limited means ...; (ii) the provision of legal assistance to ... organizations seeking to secure or protect civil rights, civil liberties or public rights; and (iii) the provision of legal assistance to charitable, religious, civic, community, governmental or educational organizations in matters in furtherance of their organizational purposes, where the payment of standard legal fees would significantly deplete the organization’s economic resources or would be otherwise inappropriate.

Amicus Work May Qualify for Some Pro Bono Credit

2. ABA Model Rule 6.1

Every lawyer has a professional responsibility to provide legal services to those unable to pay. A lawyer should aspire to render at least (50) hours of pro bono publico legal services per year. In fulfilling this responsibility, the lawyer should:

(b) provide any additional services through:

(1) delivery of legal services at no fee or substantially reduced fee to individuals, groups or organizations seeking to secure or protect civil rights, civil liberties or public rights, or charitable, religious, civic, community, governmental and educational organizations in matters in furtherance of their organizational purposes, where the payment of standard legal fees would significantly deplete the organization's economic resources or would be otherwise inappropriate[.]

3. New Jersey Rule 6.1

Every lawyer has a professional responsibility to render public interest legal service. A lawyer may discharge this responsibility by providing professional services at no fee or a reduced fee to persons of limited means or to public service or charitable groups or organizations, by service in activities for improving the law, the legal system or the legal profession, and by financial support for organizations that provide legal services to persons of limited means.

Amicus Work May Qualify for Some Pro Bono Credit

4. New York Rule 6.1

Lawyers are strongly encouraged to provide pro bono legal services to benefit poor persons.

(a) Every lawyer should aspire to:

(1) provide at least 50 hours of pro bono legal services each year to poor persons; and

(2) contribute financially to organizations that provide legal services to poor persons.

Fed. Cir. Amicus Briefs: Introduction

- The ABC typically files brief in support of “Petitions for Rehearing or Rehearing En Banc” or merits briefs in en banc rehearings. That said, the ABC on occasion files merits briefs at the panel-level.
- Amicus filings at the Federal Circuit are primarily governed by Fed. R. App. P. 29, 35 & 40 and Fed. Cir. R. 29, 35 & 40, although other rules regarding timing, formatting, and similar procedural matters also apply.

Fed. Cir. Amicus Briefs: When Permitted?

- Amicus briefs in brief in support of “Petitions for Rehearing or Rehearing En Banc” may be filed by leave of the court. Fed. Cir. R. 35(g).
- Amicus briefs on the merits may be filed either on consent of all parties or by leave of the court. Fed. R. App. P. 29(a).
- Parties often file blanket consents, which can be found on the docket. If not, consent from all parties should be obtained before the due date. These facts should be noted in the amicus brief. Fed. R. App. P. 29(a)(2).
- If one or more of the parties refuse their consent, the amicus curiae must file a motion requesting leave of the court to file an amicus brief. Typically, the amicus brief is attached as an exhibit to the motion. Fed. R. App. P. 29(a)-(b).
- Absent unusual circumstances, such motions are likely to be granted.
- An amicus curiae may participate in oral argument only upon approval by the court. Fed. R. App. P. 29(g). Such approval is rarely granted.

Fed. Cir. Amicus Briefs: Timing & Length

- Amicus briefs in support of a Petition for Rehearing or Rehearing En Banc must be filed within 14 days of the petition and may be up to 10 pages long. Fed. Cir. R. 35(g).
- Unless specifically requested by the court, responses to such petitions are not allowed. However, if the court does request such a response, then amicus briefs in opposition to a petition may be filed within 14 days of the response and may be up to 10 pages long. Fed. Cir. R. 35(g).
- Amicus briefs on the merits are due 7 days after the Principal Brief of the party supported. Fed. R. App. P. 29(e). If the brief is in support of no party, then it is due 7 days after Appellant's Principal Brief. *Id.* Amicus Briefs on the merits may be up to 15 pages or 7,000 words in length. Fed. R. App. P. 29(d); see also Fed. R. App. P. 32(a)(7).

Practical Example

Appeal Nos. 2015-1944, -1945, -1946

United States Court of Appeals
for the
Federal Circuit

WI-FI ONE, LLC,

Appellant,

– v. –

BROADCOM CORPORATION,

Appellee,

MICHELLE K. LEE, Director, U.S. Patent and Trademark Office,

Intervenor.

APPEAL FROM THE U.S. PATENT AND TRADEMARK OFFICE, PATENT TRIAL
AND APPEAL BOARD IN NOS IPR2013-00601, IPR2013-00602 AND IPR2016-00636

**AMICUS CURIAE BRIEF OF THE NEW YORK INTELLECTUAL
PROPERTY LAW ASSOCIATION IN SUPPORT OF NEITHER PARTY**

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INTEREST OF *AMICUS CURIAE*

The New York Intellectual Property Law Association (“NYIPLA”) is a bar association of over 1,100 attorneys who practice in the area of patent, copyright, trademark and other intellectual property (“IP”) law.¹ It is one of the largest regional IP bar associations in the United States. Its members include in-house counsel for businesses and other organizations, and attorneys in private practice who represent both IP owners and their adversaries (many of whom are also IP owners). Its members represent inventors, entrepreneurs, businesses

¹ No party’s counsel authored any part of this brief. No party, party’s counsel or other person besides the NYIPLA contributed money to fund the preparation or submission of this brief.

² The arguments made in this brief were approved by an absolute majority of NYIPLA’s officers and members of its Board of Directors, but do not necessarily reflect the views of a majority of the members of the Association, or of the law or corporate firms with which those members are associated. After reasonable investigation, the NYIPLA believes that no officer or director or member of the Amicus Briefs Committee who voted in favor of filing this brief, nor any attorney associated with any such officer, director or committee member in any law or corporate firm, represents a party to this litigation. Some officers, directors, committee members or associated attorneys may represent entities, including other *amici curiae*, which have an interest in other matters that may be affected by the outcome of this litigation.

SCOTUS Amicus Briefs: For Or Against Certiorari Petitions

- An amicus brief submitted before the Court considers a cert. petition requires written consent of all parties or motion to file under Section 2(b) of S.Ct. Rule 37 (with accompanying copy of the brief itself). The motion must disclose the movant's interest. Such motions are not favored.
- An amicus brief for the petitioner must be filed within 30 days after the case is placed on the docket.
- An amicus brief for the respondent must be filed must be filed within the same time as that to file an opposition brief (or motion to dismiss or affirm)
- Must provide notice to all parties of intent to file at least ten days before the deadline (unless filed more than ten days before the deadline), and the brief must disclose if consent granted or denied.

SCOTUS Amicus Briefs: After Cert. Granted

- An amicus brief submitted after the Court grants cert. requires written consent of all parties or motion to file under Section 3(b) of S.Ct. Rule 37 (with accompanying copy of the brief itself). The motion must disclose the movant's interest.
- An amicus brief must be filed within 7 days after the brief of the party supported, or if in support of neither party, within 7 days after the petitioner's brief. No motions to extend are permitted.
- Must provide notice to all parties of intent to file (although ten-day rule for cert. petitions does not apply), and disclose if consent granted or denied. Must also provide electronic copies to counsel at time of filing (in addition to paper copies).

Practical Example

No. 15-1189

IN THE
Supreme Court of the United States

IMPRESSION PRODUCTS, INC.,

Petitioner,

vs.

LEXMARK INTERNATIONAL, INC.,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF OF *AMICUS CURIAE* NEW YORK
INTELLECTUAL PROPERTY LAW
ASSOCIATION IN SUPPORT OF RESPONDENT
ON THE FIRST QUESTION PRESENTED

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STATEMENT OF INTEREST¹

The New York Intellectual Property Law Association (“NYIPLA” or “the Association”) is a professional association of more than 1,100 attorneys whose interests and practices lie in the area of patent, copyright, and other intellectual property law. It is one of the largest regional intellectual property bar associations in the United States. The Association’s members include a diverse array of attorneys specializing in patent law, and a substantial percentage of the Association’s members

1. Pursuant to Sup. Ct. R. 37.6, the Association and its counsel represent that they have authored the entirety of this brief and that no person other than *amicus curiae* or its counsel has made a monetary contribution to the preparation or submission of this *amicus* brief.

2. Pursuant to Sup. Ct. R. 37.3(a), Petitioner’s written consent to this filing has been submitted herewith. Respondent consented to the filing of *amicus curiae* briefs in support of either party or neither party in a docket entry dated December 20, 2016.

Suggested Additional Reading

- The Amicus Brief: Answering the Ten Most Important Questions About Amicus Practice, 4th ed. (2015) by Reagan W. Simpson, Esq. and Judge Mary Vasaly, a 280-page single-volume paperback published by the Tort, Trial, and Insurance Practice Section of the ABA.
- Supreme Court Practice, 10th ed. (2013) by Stephan M. Shapiro, Kenneth S. Geller, Timothy S. Bishop, Edward A. Hartnett, and Dan Himmelfarb, which contains information peculiar to amicus practice in that Court. Published by Bloomberg BNA.
- Federal Appellate Practice, 2nd ed. (2013) edited by the law firm of Mayer Brown LLP. It contains a single chapter devoted to amicus practice in the various circuits of the U.S. Court of Appeals. Published by Bloomberg BNA.

Questions?

Thank you and please
consider joining the NYIPLA
Amicus Briefs Committee!