August 16, 2011

via email to: https://edis.usitc.gov

The Honorable James Holbein
Secretary
U.S. International Trade Commission
500 E Street, S.W.
Washington, D.C. 20436

Re: Comments on July 6, 2011 Federal Register Notices,

Dear Secretary Holbein:

I am writing on behalf of the American Bar Association Section of Intellectual Property (the “Section”) to provide comments in response to the United States International Trade Commission’s (“the Commission”) invitation for public comment on the Notice of Proposed Rulemaking and the Notice of Proposed Handbook on Filing Procedures, 76 Fed. Reg. 39750-56 and 76 Fed. Reg. 39757-62 (MISC-036). These comments have not been approved by the American Bar Association’s House of Delegates or Board of Governors and should not be considered as views of the American Bar Association.

The members of the Section are lawyers that practice in and are interested in intellectual property law and in the International Trade Commission. Many members of the Section regularly practice before the International Trade Commission and/or are clients that are involved in investigations at the International Trade Commission. Therefore, the members of the Section have an interest in proposed rules of the International Trade Commission.

In general, the Section supports the Commission’s efforts to implement electronic filing. The Section’s specific recommendations with respect to the Notices follow.

Notice of Proposed Rulemaking, 76 Fed. Reg. 39750-56:

Section 210.4(f) – Proposed section 210.4(f) sets out the procedures for written submissions in section 337 proceedings including the requirement that the electronic filing of all written submissions should be followed by the submission of paper copies.
by noon on the next business day. The Section supports the Commission’s efforts in this regard. However, section 210.4(f) also requires compliance with proposed section 201.8, which in turn refers to compliance with section 201.6(b). Section 201.6(b)(iii)(5) refers back to section 201.8(d) and section 201.6(f) stating that section 201.6 does not refer to adjudicative section 337 proceedings. The Section is concerned that users of the Proposed Rules and Procedures may be confused as to what the Commission intended for filing electronic and paper copies of confidential and non-confidential submissions because of the internal references between the various sections of the rules. Accordingly, the Section suggests that the procedures for filing electronic and paper copies of confidential and non-confidential submissions in section 337 proceedings be set forth clearly and exclusively in section 210.4 to avoid ambiguity and to confirm that the Commission does not seek to institute a same-day rule for filing a public version of a confidential submission in adjudicative section 337 proceedings.

Further, proposed section 210.4(f) requires that “submissions pursuant to an order of the presiding administrative law judge (“ALJ”) shall be filed electronically.” The Section supports this proposal but believes that this language is overbroad inasmuch as there are submissions that the presiding ALJ orders served but not filed. To clarify this rule, the Section suggests the proposed language be changed to read: “submissions filed with the Secretary pursuant to an order of the presiding administrative law judge shall be filed electronically.”

Section 210.8 – Proposed section 210.8 sets out the filing procedures for complaints and motions for temporary relief in section 337 proceedings. In particular, the proposed amendment would require the filing of exhibits, appendices and attachments to such filings be provided on approved electronic media. The Section supports this proposal but notes that, as written, the proposed sections 210.8(a)(1) and (a)(2) depart substantially from the current practice of requiring copies of these submissions for service upon the respondents and their respective embassies. The Section suggests that the Commission consider and clarify whether this modification is intended.

Further, the Section notes that the proposed section 210.8 no longer refers to the separation of confidential and non-confidential versions of a complaint, motion for temporary relief, exhibits, appendices and attachments. Likewise, the proposed section 210.8 no longer refers to the number of electronic copies of the exhibits, appendices and attachments that are required. The Section has concern that the omission of these requirements may cause substantial confusion among users and suggests that the Commission consider and clarify whether these omissions are intended.

Section II(C) – This proposed section sets forward the filing requirements for documents electronically filed through the Commission’s electronic docketing system. The Section supports the Commission’s efforts in this regard. However, the Section believes that portions of the documents listed in sections (C)(2)(b)(ii) and (iii) are duplicative and, as with proposed section 210.4(f) above, include documents that a presiding ALJ may order served but not filed. To clarify this rule, the Section suggests the proposed language in (C)(2)(b)(ii)(9) be changed to read: “submissions filed with the Secretary pursuant to an order of the presiding administrative law judge.” Also, the Section suggests that document categories such as discovery statements and expert reports be stricken from section (C)(2)(b)(iii).1

Further, the Section supports a new provision in this section to make clear that where the guidelines of the Electronic Filing Handbook conflict with either an order or the Ground Rules of the presiding administrative law judge, that the directives of the administrative law judge control.

Proposed section (C)(4) sets forth the conditions for an extension of time for filing in the event of a malfunction in the electronic docketing system. However, this rule does not address the situation where the Commission is closed, for example by weather or emergency. If the Commission has closed, it is not clear to whom one would report a malfunction or request an extension. Some administrative law judges’ ground rules provide that the parties automatically have until the next business day to make a filing if the Commission is closed during normal business hours. The Section suggests that the Commission adopt a default filing date of the next business day in the event of Commission closure regardless of whether the electronic docketing system is operational. Alternatively, the Commission should clarify the procedure for electronic filing in the event of a Commission closure.

Section (II)(J)(3) – Proposed section (J)(3) sets forth the procedure for electronic signatures on Commission filings. The Section supports the Commission’s efforts to accept electronic signatures. However, the documentation and attestation requirements for proposed signature procedures appear to be more complicated and burdensome to the parties than necessary. Also, it is unclear exactly what attestation is required. The Section is unaware of any perceived problems with the procedures and self-policing measures currently in place so it suggests that the current procedure of the parties policing multiple electronic signatures remain in place. The Section recommends that these requirements be removed from the Handbook.

1 The Section also notes that in section II(C)(2)(b)(iii), the first sentence appears to be missing the word “are” between the words “that” and “not.”
Section (II)(K) – Proposed section (K) proposes allowing electronic service of documents between the parties only after written consent is provided to the Secretary or presiding administrative law judge and subject to the discretion of the administrative law judge or the Secretary while the proceeding is pending before the ALJ and Commission, respectively. The Section supports the Commission’s efforts to allow electronic service and notes that electronic service between the parties by agreement has already become the norm in section 337 proceedings. The Section is not aware of any problems with the current procedures. Rather, the proposed rule requiring formal permission by Commission officials appears to add additional burden to the parties, the Secretary and the administrative law judges that would lead to delays before electronic service could occur. The Section suggests that the Commission consider adopting a rule to allow electronic service on lead counsel for a party represented by counsel as a default method of service in addition to first class mail, overnight delivery and hand delivery. Obviously, the Commission could also provide for an “opt-out” mechanism for any party or individual who does not wish to serve or be served documents by electronic means.

Conclusion

The Section supports the Commission’s efforts to adopt e-filing and appreciates the opportunity to provide comments and clarifications as outlined above.

Very truly yours,

Robert A. Armitage
Section Chair
American Bar Association
Section of Intellectual Property Law