

**Best Practice Guide**  
**Preparing a Joint Appendix for PTAB Appeals**  
*January 2021*

Federal Circuit Rule of Practice 30(b)(1) encourages parties to reach agreement on compiling a joint appendix for an appeal. *See Fed. Cir. R. 30(b)(1)(A)*. The targeted, and typically limited, record in appeals from PTAB proceedings presents an opportunity for parties to satisfy this Rule efficiently and without conflict. These Best Practices propose an approach for achieving this result.

The first step in preparing a joint appendix is the parties' attempt to agree on the initial designation of appendix materials at least forty-five days before the appellant's principal brief is due. *See Fed. Cir. R. 30(b)(1)(A)*. If the parties cannot agree on the initial designation of appendix materials, the appellant is required to serve its designation on the appellee with a statement of issues no later than thirty days before the appellant's principal brief is due. *See Fed. Cir. R. 30(b)(1)(B)*. Because the record in PTAB proceedings is limited, the parties should designate the PTAB record in its entirety. The appellant should take care to designate all exhibits, including demonstrate exhibits, to the PTAB proceeding. Although it may be tempting for an appellant not to designate ministerial filings, such as entries of appearance, the simplicity of designating the entire record and the risk of inadvertently omitting valuable record material outweighs the benefit of having a slightly smaller master appendix. This approach also ensures that the designations satisfy Federal Rule of Appellate Procedure 30(d) because the appendix materials are ordered chronologically.

Under the Rules, the appellee next has the opportunity to counter-designate record materials for the appendix within fourteen days after service of appellant's designation. *See Fed. Cir. R. 30(b)(1)(B)*. With the appellant having already designated the entire record, however, this counter-designation step typically is obviated. Not having to finely tailor initial designations or prepare and review counter-designations saves all parties needless effort.

The Rules contemplate after all designations are complete, the appellant should prepare appendix pagination and a summary table containing those numbers. *See Fed. Cir. R. 30(b)(2)(A)*. The parties are permitted, however, to agree to extend the Rule deadlines without leave of the court so long as it does not affect the time for filing a brief. *See Fed. Cir. R. 30(b)(3)*. This deadline is a one where the parties should agree to extend until the deadline for the appellant's opening brief. This approach streamlines the parties' exchanges without much, if any, practical downside. In practice, parties take this approach more often than not.

The appellant should serve a master appendix when it files its opening brief. This master appendix should include all of the designated materials (i.e., all materials from the PTAB proceeding) and should be stamped with appendix numbers that are centered in the bottom margin. *See Fed. Cir. R. 30(c)(2)*. They should begin with "Appx" and the designated material must be numbered by the automated Bates numbering feature of the software used to convert the document into a PDF. *See id.*; *see also* Quick Reference: Formal Brief Requirements in the United States Court of Appeals for the Federal Circuit (July 2020). The master appendix should begin the judgement or order being appealed from, the patent(s) being challenged, and the

Committee on Appeals from the PTAB  
PTAB Bar Association

certified list, in that order. *See* Fed. Cir. R. 30(a)(1)(A)–(C). In accordance with Federal Rule of Appellate Procedure 30(d), the remaining appendix materials should follow chronologically. *See* Fed. Cir. R. 30(c)(2).

The appellee will now have a comprehensive master appendix that it can cite in its responsive brief. If, for some reason, material needs to be added to the master appendix, the parties should agree that such material may be appended to the appendix at the filing time of the party's brief.

Finally, the appellant must submit to the court a final joint appendix seven days after filing its reply brief. *See* Fed. Cir. R. 30(a)(2). To prepare this final submission, the parties should each separately identify the appendix materials actually cited in each brief. After resolving any discrepancies, the appellant should pare the master appendix down to only these cited materials and submit to the court as the joint appendix. *See* Fed. Cir. R. 30(b)(5).

Preparing the joint appendix is ultimately the appellant's responsibility. *See* Fed. Cir. R. 30(b)(5). Therefore, the appellant should seek to forge agreement with the other parties in the appeal early in the appeal briefing, ideally before or when the appellant initially designates appeal material. Below is a draft letter that the appellant can send to the other parties that lays out this general approach:

*Counsel,*

*Pursuant to Federal Circuit Rule 30(b)(1), we write to coordinate preparing the joint appendix in appeal [Appeal #]. We propose that all material from the PTAB record be designated for the appendix and stamped for a master appendix. As appellant in this appeal, we will designate and stamp this material. This will create a master appendix in each appeal that both parties can cite in their respective briefs. The final joint appendix submitted to the court will include only the subset of materials actually cited by the briefs. This approach aims to provide a common numbering for citation purposes while also satisfying Federal Rule of Appellate Procedure 30(d) by ordering the appendix materials chronologically.*

*Also, if either party identifies additional material from the records below inadvertently not captured in our original designations, we agree to adding such materials to the end of the appendix at the time of the parties' briefs.*

*Please let me know if you have any issue with this approach, otherwise we will move forward with it.*

*Sincerely,*  
*[Name]*