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OF THE
JUDICIAL CONFERENCE OF THE UNITED STATES
WASHINGTON, D.C. 20544

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To: **Honorable Anthony J. Scirica, Chair, Standing Committee on Rules of Practice and Procedure**

From: **Paul V. Niemeyer, Chair, Advisory Committee on the Federal Rules of Civil Procedure**

Date: **December 10, 1998**

Re: **Report of the Civil Rules Advisory Committee**

I Introduction

The Civil Rules Advisory Committee met on November 12 and 13, 1998, in Charleston, South Carolina. The three following parts of this Report present: (II) a recommendation to publish for comment changes in the rules governing impoundment of things claimed to infringe a copyright; (III) a report of the Advisory Committee's deliberations on the proposal to establish a uniform effective date for local district-court rules; and (IV) brief summaries of other matters that remain on the Advisory Committee's agenda.

In addition to these matters, the Advisory Committee took action with respect to some of the proposals that have accumulated on the docket. Agenda items have accumulated for a variety of reasons. Some topics, having been studied in some detail, seem to present questions that must be deferred until there is time for another major project. The study of special masters, described below, is one such topic. Other topics seem closely related, and to deserve periodic study as a group. The perennial suggestions to revise the service-of-process provisions of Civil Rule 4 are an example. Part of the accumulation has arisen only because of the time demanded by the major projects to review class-action practices and discovery, and the Advisory Committee's role as leader of the Mass Torts Working Group. The Agenda Subcommittee has been reestablished to undertake a comprehensive review of the docket for the purpose of recommending appropriate courses of action.

The draft minutes of the November meeting are attached.

II Action Item
Copyright Rules Proposals Recommended for Publication

The Advisory Committee recommends publication for comment of three related rules changes: (1) Abrogation of the Copyright Rules of Practice; (2) Amendment of Civil Rule 65 by adding a new subdivision (f) that explicitly brings copyright impoundment procedures within Rule 65 injunction procedures; and (3) Amendment of Civil Rule 81(a)(1), primarily for the purpose of reflecting abrogation of the Copyright Rules of Practice. These proposals seek to establish a firm legal foundation for the practices that have been adopted by several district courts. Confirming these practices will ensure that effective pretrial remedies are in fact available to protect copyrights as a central form of intellectual property. The changes will provide reassurance to other countries that the United States can honor its international obligations in these matters.

Most lawyers, including many copyright lawyers, do not know that an independent set of Copyright Rules of Practice, adopted under the 1909 Copyright Act, seems to persist to this day. The Advisory Committee first proposed abrogation of the Copyright Rules in 1964, but the question was put aside in deference to the copyright reform efforts that eventually led to the 1976 Copyright Act. Nothing has been done since then, despite grave constitutional doubts about the ex parte seizure provisions and about the actual life or accidental death of the rules. Several federal courts have recognized the problems that arise from these anachronistic rules, and have invented apparently successful means to overcome the problems. At least a few anecdotes suggest that some practitioners have continued to invoke the ex parte seizure remedies provided by the Copyright Rules, however, and in any event it is desirable to get our house in order. This proposal renews the 1964 proposals to abrogate the 1909 Copyright Rules and to amend Civil Rule 65 to provide a secure foundation for all appropriate pretrial remedies.

These proposals are designed to ensure that federal courts can continue to do what they are doing now — providing effective remedies and procedures in copyright cases. As matters now stand, there is a plausible technical argument that there are no rules of procedure for copyright actions. Almost universally, federal courts ignore this potential problem and apply the Federal Rules of Civil Procedure. Beyond this general difficulty lies a more pointed problem. The prejudgment seizure provisions in the Copyright Rules of Practice, even if they apply to actions under the 1976 Copyright Act, probably are inconsistent with the Act and quite probably are unconstitutional. Here too the federal courts seem to have adapted by applying the safeguards of Civil Rule 65 procedure in ways that both satisfy constitutional requirements and provide effective protection against copyright infringements. Appropriate rule changes are more than thirty years overdue. It is time to make the rules conform to practice.

Congressional staff members have expressed some concern that the proposed action, although taken for the purpose of establishing a secure foundation for effective copyright remedies, might be misunderstood in other countries. The United States is actively encouraging all countries to provide effective intellectual property schemes. If the Committee decides that

these problems have lingered more than long enough, care must be taken to reassure the world that the purpose and effect are to bolster present effective practice, not to diminish it.

The Problems

No Procedure. Civil Rule 81(a)(1) presents the question whether there are any procedural rules to apply in copyright actions. It states that the Civil Rules "do not apply to * * * proceedings in copyright under Title 17, U.S.C., except in so far as they may be made applicable thereto by rules promulgated by the Supreme Court of the United States." Rule 1 of the Copyright Rules of Practice reads:

> Proceedings in actions under section 25 of the Act of March 4, 1909, entitled "An Act to amend and consolidate the acts respecting copyright", including proceedings relating to the perfecting of appeals, shall be governed by the Rules of Civil Procedure, in so far as they are not inconsistent with these rules.

The problem is that all of the 1909 Copyright Act was superseded in 1976. On the face of Civil Rule 81 and Copyright Rule 1, there is no Supreme Court rule that makes the Civil Rules applicable to proceedings in copyright under present Title 17.

Courts have mostly reacted by ignoring this seeming problem. In *Kulik Photography v. Cochran*, E.D.Va.1997, 975 F.Supp. 812, 813, the court noted an unpublished opinion by a magistrate judge that apparently holds the Civil Rules inapplicable in a copyright action. The court observed that many courts continue to apply the Civil Rules, and then concluded that it need not decide whether to follow the Civil Rules because in any event it could grant the defendants' motion to dismiss for lack of personal jurisdiction. Otherwise, federal courts seem to follow the sensible course of applying the Civil Rules without further anguish. The Civil Rules nonetheless should be amended to securely establish this result.

The failure to amend Copyright Rule 1 in 1976 may reflect the obscurity of the Copyright Rules. Although it is embarrassing to have waited so long, it would be easy to adopt a technical amendment that substitutes an appropriate reference to the 1976 Act in Copyright Rule 1.

The reason for inquiring beyond this simple technical correction is revealed on examining the balance of the Copyright Rules. Rule 2, which imposed special pleading requirements, was abrogated in 1966. The remaining Rules 3 through 13 deal with one subject only — the procedure for seizing and holding, before judgment, "alleged infringing copies, records, plates, molds, matrices, etc., or other means of making the copies alleged to infringe the copyright." These rules require a bond approved by the court or commissioner, but do not appear to require any particular showing of probable success. The marshal is to retain the seized items and keep them in a secure place. The defendant has three days to object to the sufficiency of the bond. The defendant also may apply for the return of the articles seized with a supporting "affidavit stating all material facts and circumstances tending to show that the articles seized are not

infringing * * *." Rule 10 provides that "the court in its discretion, after such hearing as it may direct, may order such return" if the defendant files a bond in the sum directed by the court.

Since the Copyright Rules deal only with prejudgment seizure, and have not been reviewed for many years, it seems appropriate to ask whether they continue to reflect evolving concepts and practices that have transformed the due process constraints on prejudgment remedies.

Due Process. In 1964, the Civil Rules Advisory Committee considered the Copyright Rules and published for comment a proposal to abrogate the Copyright Rules. The proposal was driven in part by a belief that all civil actions should be governed by the Civil Rules, and in part by grave doubts about the wisdom of the prejudgment seizure provisions in Rules 3 through 13. The seizure procedure:

> is rigid and virtually eliminates discretion in the court; it does not require the plaintiff to make any showing of irreparable injury as a condition of securing the interlocutory relief; nor does it require the plaintiff to give notice to the defendant of an application for impounding even when an opportunity could feasibly be provided.

Opposition was expressed by the American Bar Association and by the Ninth Circuit Judicial Conference, who apparently relied on the same advisers. The opponents expressed satisfaction with the working of the Copyright Rules. The Reporters were not swayed; they suggested that alleged infringers were not likely to be heard in the rulemaking process. In the end, the Advisory Committee concluded that its proposals were sound, but that the final decision whether to recommend adoption should be made by the Standing Committee in light of the needs of sound relations with Congress while the process of revising the Copyright Act was going on. The Standing Committee recommended that only the special pleading requirements embodied in Rule 2 be abrogated.

For more than thirty years, the Copyright Rules of Practice have been published in U.S.C.A. with the following Advisory Committee Notes appended to each remaining rule:

> * * * The Advisory Committee has serious doubts as to the desirability of retaining Copyright Rules 3-13 for they appear to be out of keeping with the general attitude of the Federal Rules of Civil Procedure * * * toward remedies anticipating decision on the merits, and objectionable for their failure to require notice or a showing of irreparable injury to the same extent as is customarily required for threshold injunctive relief. However, in view of the fact that Congress is considering proposals to revise the Copyright Act, the Advisory Committee has refrained from making any recommendation regarding Copyright Rules 3-13, but will keep the problem under study.

The line of contemporary decisions revising due process requirements for prejudgment remedies began soon after this paragraph was written. See *Sniadach v. Family Fin. Corp.*, 1969, 395 U.S. 337, 89 S.Ct. 1820; *Fuentes v. Shevin*, 1972, 407 U.S. 67, 92 S.Ct. 1983; *Mitchell v. W.T. Grant Co.*, 1974, 416 U.S. 600, 94 S.Ct. 1895; *North Georgia Finishing, Inc. v. Di-Chem, Inc.*, 1975, 419 U.S. 601, 95 S.Ct. 719; *Connecticut v. Doehr*, 1991, 501 U.S. 1, 111 S.Ct. 2105. These decisions do not establish a crystal-clear formula for evaluating the process required to support no-notice prejudgment remedies. But they do make it clear that the procedures established by the Copyright Rules would have at best a very low chance of passing constitutional muster. It seems to be accepted that no-notice preliminary relief continues to be available on showing a strong prospect that notice will enable the opposing party to defeat the opportunity for effective relief. But it is almost certainly required that this showing be made in ex parte proceedings before a judge or magistrate judge. A mere affidavit filed with a court clerk will not do. The Copyright Rules do not approach this standard.

Statutory Provision: In addition to the due process problem, the Copyright Rules also seem inconsistent with the interim impoundment remedy established by the 1976 Copyright Act. 17 U.S.C. § 503(a) provides:

> At any time while an action under this title is pending, the court may order the impounding, on such terms as it may deem reasonable, of all copies or phonorecords claimed to have been made or used in violation of the copyright owner's exclusive rights, and of all plates, molds, matrices, masters, tapes, film negatives, or other articles by means of which such copies or phonorecords may be reproduced.

This provision gives the court discretion whether to order impoundment, and discretion to establish reasonable terms. Apart from the terms of the bond posted by the plaintiff, discretion seems to enter the Copyright Rules only at the Rule 10 stage of an order to return the seized items.

An early reaction to these difficulties was provided by Judge Harold Greene in *WPOW, Inc. v. MRLJ Enterprises*, D.D.C.1984, 584 F.Supp. 132, 134-135. Judge Greene concluded that § 503(a) makes prejudgment impoundment discretionary, and that an exercise of discretion requires "procedures which are other than summary in character." Decisions under the pre-1976 Act Copyright Rules no longer control. Instead, the normal injunction requirements of Civil Rule 65 apply. A later decision by Judge Sifton provides a strong statement that the Copyright Rules are inconsistent with § 503(a), and an equally strong suggestion that they probably are unconstitutional. *Paramount Pictures Corp. v. Doe*, E.D.N.Y.1993, 821 F.Supp. 82. The reasoning of these decisions was found persuasive in *Religious Technology Center v. Netcom On-Line Communications Servs., Inc.*, N.D.Cal.1995, 923 F.Supp. 1231, 1260-1265, where the court adopted Civil Rule 65 procedures. The doubts expressed by the WPOW and Paramount Pictures courts are reflected, without need for resolution, in *First Technology Safety Systems, Inc. v. Depinet*, 6th Cir.1993, 11 F.3d 641, 648 n. 8. *Columbia Pictures Indus. v. Jasso*, N.D.Ill.1996, 927 F.Supp. 1075, 1077, may seem to look the other way by stating that the Copyright Rules

govern impoundment, but the court then proceeds through all of the appropriate steps for a court-determined temporary restraining order under Civil Rule 65. *Century Home Entertainment, Inc. v. Laser Beat, Inc.*, E.D.N.Y.1994, 859 F.Supp. 636, is similar to the Columbia Pictures decision.

If there is room for significant doubt, it is whether even the Civil Rule 65(b) temporary restraining order procedures may support no-notice seizures. The Supreme Court decisions are not as clear as could be wished. There is room to argue that even after an ex parte hearing, free use of a defendant's property can be restrained without notice only if the plaintiff's claim falls into a category that is easily proved and that gives the plaintiff some form of pre-existing interest in the property. A secured creditor can qualify, as with the vendor's lien in *Mitchell v. W.T. Grant*. A tort claimant does not qualify, as in *Connecticut v. Doehr*. A copyright owner is asserting a property interest that might, for this purpose, be found to attach to an infringing item. But the claim of infringement often will be difficult to establish. The Court emphasized the risk of error in *Connecticut v. Doehr*, and there is a genuine risk of error in making many claims of copyright infringement.

These doubts cannot be completely dispelled, but they can be satisfactorily met. There is strong appellate authority justifying no-notice seizure of counterfeit trademarked goods. The consensus classic decision is *Matter of Vuitton et Fils S.A.*, 2d Cir.1979, 606 F.2d 1. *Vuitton* showed that it had initiated 84 counterfeit goods actions, and filed affidavits detailing experience with notices of requested restraints. The defendants regularly arranged to transfer the infringing items. The court found this showing sufficient to establish why notice should not be required in a case such as this one. If notice is required, that notice all too often appears to serve only to render fruitless further prosecution of the action. This is precisely contrary to the normal and intended role of "notice," and is surely not what the authors of the rule [65(b)] either anticipated or intended."

Congress reacted to continuing trademark infringement problems with the Trademark Counterfeiting Act of 1984, which establishes an elaborate temporary-restraining-order-like procedure for no-notice seizure. 15 U.S.C. § 1116(d). This procedure was explored and approved in *Vuitton v. White*, C.A.3d, 1991, 945 F.2d 569.

The analogy to trademark problems is bolstered by the relative frequency of proceedings that combine copyright and trademark claims. The *Time Warner Entertainment* case, for example, involved both copyright and trademark rights in Looney Tunes and Mighty Morphin Power Rangers figures.

The most significant question raised by the trademark analogy is whether it would be better to shape the Enabling Act response to the prospect that Congress may wish to enact a copyright analogue to the trademark statute. A letter from the American Intellectual Property Law Association, which otherwise supports the changes proposed below, reports a division of opinion on the desirability of supplemental legislation. Supplemental legislation indeed should be welcomed if Congress were to conclude that a new statute would usefully give more pointed guidance than a combination of the copyright impoundment statute, § 503(a), and Civil Rule

65(b). But there is little indication that courts have encountered any special difficulties in adapting Rule 65(b) to copyright impoundment. It seems better to supplement repeal of the Copyright Rules and amendment of Rule 81(a)(1) by a revision that expressly applies Civil Rule 65 to copyright impoundment. This revision was first proposed in 1964, and continues to make sense. Additional measures can safely be left to Congress.

International Obligations

The TRIPS provisions of the Uruguay Round of GATT require that effective remedies be provided "against any act of infringement of intellectual property rights covered by this Agreement, including expeditious remedies to prevent infringements." Article 41(1). "Defendants shall have the right to written notice which is timely and contains sufficient detail, including the basis of the claims." Article 42. "The judicial authorities shall have the authority to order a party to desist from an infringement * * *." Article 44(1). Provisional measures are covered in Article 50:

> 1. The judicial authorities shall have the authority to order prompt and effective provisional measures: (a) to prevent an infringement of any intellectual property right from occurring * * *; (b) to preserve relevant evidence in regard to the alleged infringement.
>
> 2. The judicial authorities shall have the authority to adopt provisional measures *inaudita altera parte* where appropriate, in particular where any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed.
>
> 3. The judicial authorities shall have the authority to require the applicant to provide any reasonably available evidence in order to satisfy themselves with a sufficient degree of certainty that the applicant is the right holder and that the applicant's right is being infringed or that such infringement is imminent, and to order the applicant to provide a security or equivalent assurance sufficient to protect the defendant and to prevent abuse.
>
> 4. Where provisional measures have been adopted *inaudita altera parte*, the parties affected shall be given notice, without delay after the execution of the measures at the latest. A review, including a right to be heard, shall take place upon request of the defendant with a view to deciding, within a reasonable period after the notification of the measures, whether these measures shall be modified, revoked or confirmed. * * *

These procedures can be implemented fully under Civil Rule 65, and as suggested above the ex parte — *inaudita altera parte* — provisions seem compatible with due process requirements. Abrogating the Copyright Rules and amending Civil Rule 65 to expressly govern impoundment proceedings will help ensure that we are in compliance with TRIPS by removing

the doubts surrounding current practice and provisions. Such room for doubt as might remain goes to the Article 50(1) authority "to preserve relevant evidence in regard to the alleged infringement," and the Article 50(2) authority to act "where there is a demonstrable risk of evidence being destroyed." A combination of Rule 65 with the discovery rules, however, should be relied upon to establish this authority. Only if these tools prove inadequate should consideration be given to a procedural rule governing no-notice, prejudgment seizure of evidence.

~~RULES OF PRACTICE AS AMENDED~~

~~Rule 1~~

~~Proceedings in actions brought under section 25 of the Act of March 4, 1909, entitled "An Act to amend and consolidate the acts respecting copyright", including proceedings relating to the perfecting of appeals, shall be governed by the Rules of Civil Procedure, in so far as they are not inconsistent with these rules.~~

~~Rule 3~~

~~Upon the institution of any action, suit or proceeding, or at any time thereafter, and before the entry of final judgment or decree therein, the plaintiff or complainant, or his authorized agent or attorney, may file with the clerk of any court given jurisdiction under section 34 of the Act of March 4, 1909, an affidavit stating upon the best of his knowledge, information and belief, the number and location, as near as may be, of the alleged infringing copies, records, plates, molds, matrices, etc., or other means for making the copies alleged to infringe the copyright, and the value of the same, and with such affidavit shall file with the clerk a bond executed by at least two sureties and approved by the court or a commissioner thereof.~~

~~Rule 4~~

~~Such bond shall bind the sureties in a specified sum, to be fixed by the court, but not less than twice the reasonable value of such infringing copies, plates, records, molds, matrices, or other means for making such infringing copies, and be conditioned for the prompt prosecution of the action, suit or proceeding; for the return of said articles to the defendant, if they or any of them are adjudged not to be infringements, or if the action abates, or is discontinued before they are returned to the defendant; and for the payment to the defendant of any damages which the court may award to him against the plaintiff or complainant. Upon the filing of said affidavit and bond, and the approval of said bond, the clerk shall issue a writ directed to the marshal of the district where the said infringing copies, plates, records, molds, matrices, etc., or other means of making such infringing copies shall be stated in said affidavit to be located, and generally to any marshal of the United States, directing the said marshal to forthwith seize and hold the same subject to the order of the court issuing said writ, or of the court of the district in which the seizure shall be made.~~

~~Rule 5~~

~~The marshal shall thereupon seize said articles or any smaller or larger part thereof he may then or thereafter find, using such force as may be reasonably necessary in the premises, and serve on the defendant a copy of the affidavit, writ, and bond by delivering the same to him personally, if he can be found within the district, or if he can not be found, to his agent, if any, or to the person from whose possession the articles are taken, or if the owner, agent, or such person can not be found within the district, by leaving said copy at the usual place of abode of such owner or agent, with a person of suitable age and discretion, or at the place where said articles are found, and shall make immediate return of such seizure, or attempted seizure, to the court. He shall also attach to said articles a~~

~~tag or label stating the fact of such seizure and warning all persons from in any manner interfering therewith.~~

~~**Rule 6**~~

~~A marshal who has seized alleged infringing articles, shall retain them in his possession, keeping them in a secure place, subject to the order of the court.~~

~~**Rule 7**~~

~~Within three days after the articles are seized, and a copy of the affidavit, writ and bond are served as hereinbefore provided, the defendant shall serve upon the clerk a notice that he excepts to the amount of the penalty of the bond, or to the sureties of the plaintiff or complainant, or both, otherwise he shall be deemed to have waived all objection to the amount of the penalty of the bond and the sufficiency of the sureties thereon. If the court sustain the exceptions it may order a new bond to be executed by the plaintiff or complainant, or in default thereof within a time to be named by the court, the property to be returned to the defendant.~~

~~**Rule 8**~~

~~Within ten days after service of such notice, the attorney of the plaintiff or complainant shall serve upon the defendant or his attorney a notice of the justification of the sureties, and said sureties shall justify before the court or a judge thereof at the time therein stated.~~

~~**Rule 9**~~

~~The defendant, if he does not except to the amount of the penalty of the bond or the sufficiency of the sureties of the plaintiff or complainant, may make application to the court for the return to him of the articles seized, upon filing an affidavit stating all material facts and circumstances tending to show that the articles seized are not infringing copies, records, plates, molds, matrices, or means for making the copies alleged to infringe the copyright.~~

~~**Rule 10**~~

~~Thereupon the court in its discretion, and after such hearing as it may direct, may order such return upon the filing by the defendant of a bond executed by at least two sureties, binding them in a specified sum to be fixed in the discretion of the court, and conditioned for the delivery of said specified articles to abide the order of the court. The plaintiff or complainant may require such sureties to justify within ten days of the filing of such bond.~~

~~**Rule 11**~~

~~Upon the granting of such application and the justification of the sureties on the bond, the marshal shall immediately deliver the articles seized to the defendant.~~

~~**Rule 12**~~

~~Any service required to be performed by any marshal may be performed by any deputy of such marshal.~~

~~**Rule 13**~~

~~For services in cases arising under this section the marshal shall be entitled to the same fees as are allowed for similar services in other cases.~~

Rule 65. Injunctions

(f) Copyright impoundment. This rule applies to copyright impoundment proceedings.

Committee Note

New subdivision (f) is added in conjunction with abrogation of the antiquated Copyright Rules of Practice adopted for proceedings under the 1909 Copyright Act. Courts have naturally turned to Rule 65 in response to the apparent inconsistency of the former Copyright Rules with the discretionary impoundment procedure adopted in 1976, 17 U.S.C. § 503(a). Rule 65 procedures also have assuaged well-founded doubts whether the Copyright Rules satisfy more contemporary requirements of due process. See, e.g., *Religious Technology Center v. Netcom On-Line Communications Servs., Inc.*, 923 F.Supp. 1231, 1260-1265 (N.D.Cal.1995); *Paramount Pictures Corp. v. Doe*, 821 F.Supp. 82 (E.D.N.Y.1993); *WPOW, Inc. v. MRLJ Enterprises*, 584 F.Supp. 132 (D.D.C.1984).

A common question has arisen from the experience that notice of a proposed impoundment may enable an infringer to defeat the court's capacity to grant effective relief. Impoundment may be ordered on an ex parte basis under subdivision (b) if the applicant makes a strong showing of the reasons why notice is likely to defeat effective relief. Such no-notice procedures are authorized in trademark infringement proceedings, see 15 U.S.C. § 1116(d), and courts have provided clear illustrations of the kinds of showings that support ex parte relief. See *Matter of Vuitton et Fils S.A.*, 606 F.2d 1 (2d Cir.1979); *Vuitton v. White*, 945 F.2d 569 (3d Cir.1991). In applying the tests for no-notice relief, the court should ask whether impoundment is necessary, or whether adequate protection can be had by a less intrusive form of no-notice relief shaped as a temporary restraining order.

This new subdivision (f) does not limit use of trademark procedures in cases that combine trademark and copyright claims. Some observers believe that trademark procedures should be adopted for all copyright cases, a proposal better considered by Congressional processes than by rulemaking processes.

Rule 81. Applicability in General

(a) ~~To What~~ Proceedings to which the Rules Apply~~icable.~~

(1) These rules do not apply to prize proceedings in admiralty governed by Title 10, U.S.C., §§ 7561-7681. They do ~~not~~ apply to proceedings in bankruptcy as provided by the Federal Rules of Bankruptcy Procedure ~~or to proceedings in copyright under Title 17, U.S.C., except in so far as they may be made applicable thereto by rules promulgated by the Supreme Court of the United States. They do not apply to mental health proceedings in the United States District Court for the District of Columbia~~.

*** * *

Committee Note

Former Copyright Rule 1 made the Civil Rules applicable to copyright proceedings except to the extent the Civil Rules were inconsistent with Copyright Rules. Abrogation of the Copyright Rules leaves the Civil Rules fully applicable to copyright proceedings. Rule 81(a)(1) is amended to reflect this change.

The District of Columbia Court Reform and Criminal Procedure Act of 1970, Pub.L. 91-358, 84 Stat. 473, transferred mental health proceedings formerly held in the United States District Court for the District of Columbia to local District of Columbia courts. The provision applying the Civil Rules to these proceedings is deleted as superfluous.

The reference to incorporation of the Civil Rules in the Federal Rules of Bankruptcy Procedure has been restyled.

The following model is an example of an order that could be used to abrogate the copyright rules:

ORDER OF _____

1. That the Rules of Practice for proceedings in actions brought under section 25 of the Act of March 4, 1909, entitled "An Act to amend and consolidate the acts respecting copyright," be, and they hereby are, abrogated.

2. That the abrogation of the foremention ed Rules of Practice shall take effect on December 1, ____.

3. That the Chief Justice be, and hereby is, authorized to transmit to the Congress the foregoing abrogation in accordance with the provisions of Section 2072 of Title 28, United States Code.

[Explanatory Note]

The Copyright Rules of Practice were adopted under the final, undesignated, paragraph of the Act of March 4, 1909, c. 320, § 25, 35 Stat. at 1081-1082:

§ 25 That if any person shall infringe the copyright in any work protected under the copyright laws of the United States such person shall be liable:

*** * *

(c) To deliver up on oath, to be impounded during the pendency of the action, upon such terms and conditions as the court may prescribe, all articles alleged to infringe a copyright;

*** * *

(e) * * *

Rules and regulations for practice and procedure under this section shall be prescribed by the Supreme Court of the United States.

This final paragraph of § 25 was repealed in 1948, apparently on the theory that it duplicated the general Enabling Act provisions. Act of June 25, 1948, c. 646, § 39, 62 Stat. 992, 996 & n. 31. See Historical Notes, 17 U.S.C.A., following Copyright Rule 1. It seems appropriate to rest abrogation on § 2072, for want of any other likely source of authority.

III Civil Rule 83 — Local Rules — Recommended for Discussion

The Committee discussed two drafts that would amend Civil Rule 83(a), following the request of the Standing Committee that the advisory committees study adoption of a uniform effective date for local rules. The Appellate Rules Committee has approved a draft Appellate Rule 47 that makes two changes. First, the draft sets December 1 as the effective date unless a different effective date is specified when there is "an immediate need for the amendment." Second, the draft prohibits "enforcement" of a local rule before a copy is received by the Administrative Office.

Two versions of Civil Rule 83 are set out below. The first follows the lead of the Appellate Rules Committee, with one change that reflects a statutory difference between local district-court rules and local circuit-court rules. A district-court rule must be "furnished" not only to the Administrative Office, but also to the judicial council of the circuit. This first draft prohibits enforcement before a rule is received by both the Administrative Office and the judicial council.

The second draft Rule 83 goes farther. It sets a 60-day advance notice and comment requirement before a local rule can be adopted or amended, with an exception that reflects the "immediate need" provision in 28 U.S.C. § 2071(e). Moreover, it prohibits enforcement of a local rule until 60 days after notice is given to the judicial council and the Administrative Office and until it is made available to the public. It also requires the Administrative Office both to publish all local rules by electronic means and to report to the district court and the judicial council any rule that does not conform to Rule 83 requirements. Once a rule has been reported by the Administrative Office, enforcement is prohibited until the judicial council has approved.

These drafts are reported to the Standing Committee for discussion, without further recommendation. The Civil Rules Committee determined unanimously that there should be further consideration of the question whether the general Enabling Act authority established by § 2072 should be invoked to supersede the explicit "effective date" provisions of § 2071; it may be wiser to seek § 2071 amendments. The Civil Rules Committee also unanimously recommends adding June 1 as an alternative effective date. Discussion of these issues is reflected in the draft Minutes at pages 25 to 30. The distinction adopted in proposed Appellate Rule 47 between the "effective date" and "enforcement" of a local rule also will be noted briefly.

The problem of statutory authority is easily stated. Section 2071(a) establishes district courts' authority to "prescribe rules for the conduct of their business." Section 2071(b) provides that any "[s]uch rule shall take effect upon the date specified by the prescribing court * * *." Section 2071(c)(1) provides that a district-court rule "shall remain in effect unless modified or abrogated by the judicial council of the relevant circuit." Both forms of proposed Civil Rule 83 are inconsistent with these statutory provisions. Specification of an effective date conflicts with § 2071(b). Provisions barring "enforcement" until specified events occur also seem inconsistent with the effective date provision. This inconsistency is particularly glaring with respect to the proposal that would bar enforcement between the time the Administrative Office reports a local

rule as inconsistent with Rule 83 and the time — if ever — that the judicial council chooses to reinstate the rule.

The obvious response to this difficulty is that the general Enabling Act, § 2072(b), provides that "[a]ll laws in conflict with" a national rule adopted by the Supreme Court "shall be of no further force or effect after such rules have taken effect." Although all rulesmaking committees have been cautious about invoking this supersession power, it might seem appropriate to rely on it for the high purpose of restraining the problems that seem to be created by the proliferation of local rules.

Reliance on the supersession clause, however, may not be a certain thing. There is a powerful argument that §§ 2071 and 2072 should be read in pari materia, as parts of a single scheme for adopting both national and local rules of procedure. Congress considered these matters together a decade ago, and maintained the supersession clause only after careful study. It might come as a surprise to be told that the supersession clause applies not only to statutes outside the seemingly integrated rulemaking provisions, but also to the explicit provisions of § 2071.

There is an additional ground to challenge the draft provision that would suspend a local rule upon report of nonconformance by the Administrative Office to the judicial council. 28 U.S.C. § 332(d)(4) requires that judicial councils review local district-court rules, and empowers the councils to modify or abrogate a local rule that is inconsistent with the national rules. Section 332(d)(4), however, does not expressly authorize a judicial council to suspend a local rule pending review. Giving the Administrative Office authority to effect an automatic suspension may seem to go too far beyond the implicit limits of § 332(d)(4).

The question whether to push ahead with provisions establishing uniform effective dates is not one of power alone. It seems a fair guess that some district court, somewhere, would advance the argument that the supersession clause does not apply to its § 2071 authority. The argument should not be shirked if the stakes are really high. But there may be grounds to question that importance of a uniform effective date for all district-court rules. Several members of the Civil Rules Committee believed that a uniform effective date would be a useful convenience, but that it does not go to the heart of the problems posed by local rules. Easy access to an assuredly complete text of all local rules was thought to be far more important. If the goal, though worthy, is not of the first importance, it may be prudent to forgo the confrontation.

An alternative to amending the various local-rules provisions of the national rules may be to invite renewed consideration of these problems by Congress. Congress could readily adopt each of the proposals made in the more sweeping draft Rule 83, and might find other and more effective means to cabin the continuing excesses of some district-court rules.

Turning to the effective date provision, Advisory Committee members emphasized that substantial time is required to act on a local rule proposal. To defer the effective date for up to a year after the lengthy process grinds to a conclusion is too much. After considering various proposals, it was agreed that two effective dates each year would be sufficient — June 1 and December 1. The June 1 date cannot claim the particular advantages that have been attributed to the December 1 date, but provides effective flexibility without adding undue confusion.

The distinction drawn by draft Appellate Rule 47 between the "effective date" for a local rule and "enforcement" of the rule was accepted by the Civil Rules Committee. This drafting strategy makes it possible to avoid potential confusion about the effective date. Perhaps more importantly, it leaves the way open for voluntary compliance with a local rule by parties who know of it. Voluntary compliance often may be a good thing — a good local rule should be viewed as an aid for lawyers, not an obstacle. Barring "enforcement" both protects those who have not learned of the rule and provides an incentive to comply with requirements for reporting and publication.

The following draft of Civil Rule 83 is submitted to illustrate adaptation of the Appellate Rules model. Whatever substantive changes may be agreed upon, the Standing Committee will be concerned to achieve as much uniformity of style as possible among the several different sets of Rules.

Rule 83. Rules by District Courts; Judge's Directives

(a) Local Rules.

(1)(A) Each district court, acting by a majority of its district judges, may, after giving appropriate public notice and an opportunity for comment, make and amend rules governing its practice.

(B) A local rule shall be consistent with — but not duplicative of — Acts of Congress and rules adopted under 28 U.S.C. §§ 2072 and 2075, and shall conform to any uniform numbering system prescribed by the Judicial Conference of the United States.

(C) A local rule or amendment takes effect on ~~the date specified by the district court~~ the June 1 or December 1 next following adoption unless the [district] court specifies an earlier date to meet an immediate need, and remains in effect unless amended by the court or modified or abrogated by the judicial council of the circuit.

(D) Copies of rules and amendments shall, upon their ~~promulgation~~ adoption, be furnished to the judicial council and the Administrative Office of the United States Courts and be made available to the public. A rule or amendment must

[may] not be enforced before it is received by the Administrative Office and [by] the judicial council.

[Subparagraph C could be brought closer to the style of draft Appellate Rule 47 like this:

(C) A local rule or amendment takes effect on December 1 following its adoption, unless a majority of the court's judges in regular active service determines that there is an immediate need for the amendment, and remains in effect * * *.

There are two significant differences. This version repeats the majority of the judges requirement already set out in subparagraph (A), adding the "in regular active service" embellishment that is now stated in Appellate Rule 47 but not in present Civil Rule 83. It might be better to add this requirement to subparagraph (A) if it seems desirable. And this version seems to imply that the choice is between immediate effect and effect on the following December 1. Perhaps it would be inferred that an "immediate need" can be met by specifying an effective date that is not immediate. Subparagraph (C) in the full draft avoids the ambiguity by allowing the court to specify "an earlier date to meet an immediate need."]

Committee Note

A uniform effective date is required for local rules to facilitate the task of lawyers who must become aware of changes as they are adopted. Exceptions should be made to meet immediate needs when special circumstances arise that cannot be accommodated by other means during the period before the next June 1 or December 1.

The present requirements of filing with the Administrative Office and circuit judicial council are bolstered by prohibiting enforcement of a local rule or amendment before a copy is received by the Administrative Office and by the judicial council. This requirement need not entail any significant delay in enforcement. District courts should regulate their local rules activities in a way that allows ample time for transmitting copies before the next June 1 or December 1; receipt well in advance of June 1 or December 1 will be all to the good. If immediate effect is desired, the copies can be transmitted by means — including electronic means — that entail little or no delay.

New technology will help discharge the obligation to make local rules available to the public. Many courts have posted local rules on the Internet. All courts should seek to make local rules available in this form as resources become available. In addition, it is expected that the Administrative Office will place all local rules in a single easily accessible location, preferably the Internet,[1] for the benefit of the bench, bar, and public.

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[1] This reference to "the Internet" is temporizing. A better reference should be found — the reference in the next draft to "means that provide convenient public electronic access" may be a suitable beginning.

A More Controlling Model

The draft based on the Appellate Rules draft will protect against unintended violations of local rules that were not known to the offender. It does not go as far as might be gone, however, toward ensuring any effective review of local rules. Greater control might be established by formalizing the § 2071(b) requirement of "appropriate public notice and an opportunity for comment," and by stimulating judicial council review. Judicial councils are required to undertake "periodic" review of local district rules, but different circuits approach this responsibility with different levels of attention. It would be ideal to find a means to ensure that the local circuit judicial council reviews every local rule. Assuming that this ideal is not practicable, substantial good might flow from requiring the Administrative Office to review new rules or amendments and to notify the judicial council of potential problems. The following draft illustrates this approach:

Rule 83. Rules by District Courts; Judge's Directives

(a) Local Rules.

(1) Each district court, acting by a majority of its district judges, may~~, after giving appropriate public notice and an opportunity for comment,~~ make and amend rules governing its practice only as follows:

(A) A local rule shall be consistent with — but not duplicative of — Acts of Congress and rules adopted under 28 U.S.C. §§ 2072 and 2075, and shall conform to any uniform numbering system prescribed by the Judicial Conference of the United States.

(B) At least 60 days before adopting or amending a local rule, the court shall give appropriate public notice of the proposed rule and an opportunity for comment. The court may give immediate effect to a rule without satisfying this notice and comment requirement if it determines that there is an immediate need for the rule, but it must promptly afford notice and opportunity for comment after the rule becomes effective.

(C) A local rule or amendment takes effect on ~~the date specified by the district court~~ the June 1 or December 1 next following its adoption unless the court specifies an earlier date to meet an immediate need, and remains in effect unless amended by the court or modified or abrogated by the judicial council of the circuit. ~~Copies of rules and amendments shall, upon their promulgation, be furnished to the judicial~~

~~council and the Administrative Office of the United States Courts and be made available to the public.~~

(D) A court may not enforce a local rule or amendment until:

(1) 60 days after the court gave notice of the rule or amendment to the judicial council of the circuit and to the Administrative Office of The United States Courts; and

(2) the court has made the rule or amendment available to the public by convenient means, including electronic means where feasible.

(2) The Administrative Office of the United States Courts shall promptly publish all local rules by means that provide convenient public electronic access. The Administrative Office also shall review all new local rules or amendments, and shall report to the district court and the judicial council of the circuit if it finds that a rule or amendment does not conform to the requirements of this Rule. A district court may not enforce a local rule provision that has been reported by the Administrative Office until the judicial council of the circuit approves the provision.

(~~2~~3) * * * (Renumber present (2), (3), (4), (5), (6), and note abrogation of former (7).)

Committee Note

Practicing attorneys continue to complain about the difficulty of complying with local rules of practice. The complaints address such matters as a lack of uniformity between districts, the difficulty of learning the meaning and even existence of local rules, and occasional inconsistency with the national rules. A careful examination of local rules by the Ninth Circuit Judicial Council, for example, uncovered several local rules that seem inconsistent with the national rules. Rule 83 already requires consistency with the national rules, and the present requirement that rules be filed with the judicial council is intended to provide some means of enforcement. More effective measures seem called for, but measures that do not create unnecessary roadblocks to effective adoption and enforcement of local rules.

Paragraph (B) implements the present requirements of Rule 83 and 28 U.S.C. § 2071(b) by requiring at least 60-day public notice before adopting or amending a local rule.

A uniform effective date is provided in paragraph (C) to facilitate the task of lawyers who must become aware of changes as they are adopted. Exceptions can be made to meet immediate needs when special circumstances arise that cannot be accommodated by other means during the period before June 1 or December 1. The material in paragraph (C) also is changed to reflect the

provision in 28 U.S.C. § 2071(c)(1) that allows a judicial council to modify, rather than abrogate, a local rule.

Paragraph (D) prohibits enforcement of a local rule or amendment for 60 days after notice is given to the judicial council and the Administrative Office. It also prohibits enforcement until the district court has made the rule or amendment available to the public.

Paragraph (E) imposes new duties on the Administrative Office. It is required to publish local rules on the Internet or whatever future system of readily accessible electronic communication proves convenient. In addition, the Administrative Office is required to review all new local rules or amendments and report to the district court and judicial council if the rule does not conform to Rule 83 requirements. The district court may not enforce a rule reported by the Administrative Office until the judicial council approves the reported provision.

IV Continuing Agenda Items
Civil Rule 51

Consideration of the jury-instruction provisions of Civil Rule 51 came to the Civil Rules Committee as the result of the work of the Ninth Circuit Judicial Council. Finding many local rules that require submission of instruction requests before trial begins, the Judicial Council expressed concern that these desirable rules seem inconsistent with Rule 51. It suggested a Rule 51 amendment that would legitimate the local rules. The Criminal Rules Committee, in addition, has published for comment a proposal that would amend Criminal Rule 30 to authorize the court to direct that requests be made at the close of the evidence "or at any earlier time that the court reasonably directs."

The Civil Rules Committee has concluded that there is no reason to make the timing of instruction requests turn on the choices made by local rules. If it is desirable to authorize a district court to require that requests be made before trial begins, the authority should be provided by a uniform national rule.

Before turning to a simple Rule 51 amendment, however, the question was put whether it might be desirable to revise Rule 51 to state more clearly the practices that have grown up around the present opaque language. A draft has been prepared and briefly considered by the Committee. Understanding that the Criminal Rules Committee is interested in the instructions project, but that it does not feel an urgent need for action, the Civil Rules Committee has carried the proposal forward for further consideration.

Civil Rule 53

In 1994, spurred by suggestions from local Civil Justice Reform Act committees, the Committee briefly considered a revision of the special-master provisions of Civil Rule 53. The underlying motive arose from the perception that Rule 53 speaks directly only to the use of special masters for trial purposes, a use that has fallen into near-disuse. At the same time, special masters have come to be used extensively for pretrial and post-judgment purposes that are not directly regulated by Rule 53. In some situations, moreover, courts seem to be experimenting with the use of court-appointed experts in ways that blur the line between witness and judicial adjunct, and even to be appointing advisers who function entirely outside Evidence Rule 706.

After brief review, the Committee has concluded that it should take up the Rule 53 draft for further study. A Rule 53 Subcommittee has been appointed to study the questions raised by the draft and to report to the Fall, 1999 meeting on the desirability of pursuing the proposal. If a suitable project can be designed, the Federal Judicial Center will be asked to support the Subcommittee in its work.

Corporate Disclosure Statements

The question whether a new Civil Rule should be adopted to require corporate disclosure statements in all civil actions came late to the Advisory Committee agenda. Appellate Rule 26.1 provided a model that was briefly considered. The Advisory Committee expressed doubt about the recent amendment of Appellate Rule 26.1 that deleted the requirement that a corporate party identify "subsidiaries (except wholly-owned subsidiaries), and affiliates that have issued shares to the public." It also wondered whether any disclosure requirement should extend to some noncorporate entities. Uncertainty was expressed whether it would be better to adopt a single uniform rule for Appellate, Bankruptcy, Civil, and Criminal Rules; to adopt different provisions for each of these bodies of rules; to prepare a recommended disclosure form for use by such courts as might like it; or to adopt some other course.

It was recognized that these questions are better pursued through coordinated efforts by each of the Advisory Committees. The Committee concluded that further study should be initiated by the two Committee members to be appointed to the Standing Committee's ad hoc committee on federal rules of attorney conduct. Perhaps these issues could be considered by the ad hoc committee as a separate matter, or perhaps some other means of coordinated study should be developed.

Discovery

Proposals to amend several provisions of the civil discovery rules were published in August, 1998. A review of the proposals is provided in the draft Minutes, pages 4 to 11. A oral summary will be provided at the Standing Committee meeting.

Mass Torts Working Group

Nearly a year ago, Chief Justice Rehnquist authorized formation of a Mass Torts Working Group under the leadership of the Civil Rules Committee. The Civil Rules Committee was chosen to lead the group because its consideration of proposed class-action amendments had given it a useful body of information about mass torts. Time and again, the problems of mass torts seemed to the Committee to call for coordinated legislative and rulemaking responses. The Working Group was chaired by Judge Anthony J. Scirica and assisted by Professor Francis E. McGovern as special consultant. The Civil Rules Committee considered and approved an advanced draft of the Working Group report. The discussion is summarized at pages 11 to 22 of the draft minutes. Final work on the report continues, with presentations to three of the other Judicial Conference committees that contributed liaison members to the Working Group. The report describes the mass-torts phenomena, noting that each mass tort seems to present problems different from any of those that have gone before. The report also summarizes the questions that have been described as problems by some observers, and describes proposals that have been made to address these problems. The only recommendation, however, is that a new ad hoc Judicial Conference committee be created, with authority to report directly to the Judicial Conference, to study the problems further.

It is important to note that nothing in the recommendation for creation of an ad hoc committee would impinge on the Enabling Act process. A new committee would consider possible legislation and court rules, but any recommendations for court rules would be made as suggestions for further study in the regular process of Advisory Committee, Standing Committee, Judicial Conference, Supreme Court, and ultimately Congress.

Mass tort litigation involves so many different problems, and continues to evolve at such a pace, that in the end it may prove better to rely on gradual judicial evolution than to launch more ambitious legislative and rulemaking projects. There is good ground to hope, however, that at least modest improvements can be recommended by a new committee. The work is worth undertaking, even knowing the risk that nothing immediate may come of it.