Portfolio Media. Inc. | 860 Broadway, 6th Floor | New York, NY 10003 | www.law360.com
Phone: +1 646 783 7100 | Fax: +1 646 783 7161 | customerservice@law360.com

6 Tips For Maximizing Your 15 Minutes At The Fed. Circ.

By **Erin Coe**

Law360, San Diego (October 8, 2015, 11:06 PM ET) -- With only 15 minutes to argue their side of an intellectual property dispute before the Federal Circuit, attorneys need to know their case inside out, make their strongest points up front and brace for a deluge of questions.

Unlike other federal appeals courts, the Federal Circuit has nationwide jurisdiction over various subject matters, including international trade, trademark and veterans' benefits appeals, and also is known for its heavy patent docket that continues to expand, particularly as proceedings in the Patent Trial and Appeal Board grow in popularity.

"The result of that is judges at the Federal Circuit who know patent law as well or better than the advocates who appear before them," said William Jenks, founder of Jenks IP Law and a former associate solicitor in the Solicitor's Office of the U.S. Patent and Trademark Office.

The appeals court also has earned a reputation as a "hot bench," with exceedingly well-prepared and engaged judges who are ready to pepper attorneys with questions at oral arguments, according to attorneys.

"There have been cases at the Federal Circuit where I was able to speak based on planned comments for fewer than 30 seconds before the questions began coming in," said Latham & Watkins LLP litigator Michael Morin. "Attorneys need to be versatile, and they need to know the record and their arguments well because the judges may have questions that lead in another direction."

Here, Federal Circuit experts offer six tips on how litigators can squeeze the most out of their time before the court:

Know Your Case Cold

Because the judges sitting on the bench have a deep level of familiarity with the legal and technical aspects of patent litigation, attorneys have no excuse but to come to oral arguments over-prepared.

"Federal Circuit judges come to oral arguments very prepared, and they often want to engage with you about the specifics, not just about the law and facts and record in your case," said Deanne Maynard, co-chair of Morrison & Foerster LLP's appellate practice who has argued before the Federal Circuit more than 25 times. "You want to be able to turn right to the relevant part of the record and talk to the judges about how it helps you."

Sometimes she has seen lawyers flipping through documents as thick as a phone book trying to find the page they should be on — wasting precious seconds they could be using to bolster their case.

“You don’t want to be at the podium looking for the relevant citation,” she said. “You want to know where all your key points are in the record.”

Attorneys need to be well-versed in all the cases that could be relevant to the dispute at hand, whether they are cited in parties’ briefs or not, and they must be able to put references in the factual record into context, according to Morin.

“Knowing the factual record below doesn’t just mean finding support for your case based on citations in the briefs or knowing where a quote came from, but having a sense of what the surrounding context was for the comment and how it fits into the overall record,” he said.

Predict the Questions

Thinking the court is going to let attorneys give a 15-minute speech without interruption is unrealistic. Instead, attorneys should identify potential questions by the panel and develop a stable of answers that will best assist their case.

“Oral arguments are more of a question-and-answer session than a soliloquy or formal argument by the advocate,” said Daryl Joseffer, head of King & Spalding LLP’s appellate practice who has argued before the Federal Circuit about 20 times.

Attorneys tend to forget that listening is often more important than speaking at oral arguments, according to Jenks.

“One of your primary roles is to determine what the judges are most concerned about and addressing those issues,” he said. “Their questions are letting you know what they are worried about in terms of your case.”

While lawyers are under a time crunch to deliver the core arguments in support of their position, it’s crucial that they answer judges’ questions without hesitation.

“The way attorneys get into trouble is they hear a question from the court, but they fail to give a direct answer,” Joseffer said. “If you try to dance around the question and the court has to ask it three or four times, it gets much worse. Even if you prefer not to answer the question, it’s much better that you answer it after the first time than the fourth.”

If attorneys want to deliver a message or a theme, their best opportunity is the moment their argument begins, according to Morin.

“It’s important to make your point right out of the box because the judges may take you in a direction you didn’t anticipate,” he said. “Rule number one is to answer the court’s questions directly. Rule number two is to bring it back to the key points you want to deliver when there are opportunities to do so.”

Argue Only the Best of the Best

When arguing before the Federal Circuit, attorneys should focus on the quality of their arguments over the quantity, according to Morin.

“It’s not a numbers game at the Federal Circuit, so raising additional arguments does not mean a greater chance of success,” he said. “Attorneys are better off picking one to three arguments that are most likely to succeed, rather than making five to seven arguments that have some chance of success.”

Lawyers may want to concentrate more on big-ticket items, like claim construction issues or matters of a question of law, than on minor disputes over admissibility of specific evidence, he said.

“If you make too many arguments … it can take time and attention away from your best arguments — which you never want to do — and it can affect the overall credibility of arguments because you’re advancing in addition to your strong arguments those that are less likely to succeed.”

With the clock ticking, attorneys should not waste time regurgitating material from their briefs or giving the court the rundown on relatively settled legal principles, according to Joseffer.

“The Federal Circuit judges don’t need to hear much background information,” he said. “They want to know where the rubber meets the road.”

Because patent cases can very quickly become bogged down by the claim language, prosecution history, competing expert testimony and other technical details, attorneys should try to tie the pieces to a strong overarching narrative, according to Luke Dauchot, a trial lawyer at Kirkland & Ellis LLP.

One narrative might argue that the integrity of the patent should be preserved or another might contend that the reversal of the jury verdict would risk undermining the trial process. Regardless of what the theme is, it should be used to help the court sort out the details and point it in the direction of making a decision.

“You want to make your end result compelling and inviting,” Dauchot said. “With that in place, it is more likely that judges will work the technical details of the case to get to that result.”

Sometimes when there are multiple parties on one side, they want each of their lawyers to get a moment in the spotlight at oral arguments, but Joseffer said the parties would be wise to designate one attorney for the job.

“Fifteen minutes goes by fast, and it’s better to have one person up there for the full time,” he said. “There is a rhythm to oral arguments, but when different attorneys are popping up to answer the judges’ questions, it disrupts the flow and makes for an ineffective argument.”

If attorneys float a weak argument that the Federal Circuit judges ask them to concede, it may be worthwhile for attorneys to back down, according to Dauchot.

“The judges have done their homework, and ignoring, dodging or prevaricating a point is not going to get you anywhere,” he said. “Rather than bobbing and weaving, concede it and move on to your stronger points. When you stand your ground on your stronger points after conceding on your weaker points, your credibility will reap dividends.”

Know Your Audience

Some judges on the Federal Circuit may give more deference to claim construction decisions at the district court or may be sticklers when it comes to trial judges’ review of the evidence to support a damages award.

“Judges anywhere in the country come with philosophies,” Dauchot said. “With the Federal Circuit, a lot of patent-related doctrines and damages issues associated with patent cases leave plenty of room for varied perspectives and philosophies to manifest themselves.”

While attorneys won’t find out the panel of judges who will be presiding over their case until the morning of oral arguments, they can anticipate the philosophies and should try building them into their arguments, he said.

“If you’ve done your homework, when you get to the Federal Circuit in the morning and find out who is on the panel,

you can put a face to the position that you've already prepared for and baked into your game plan," he said.

At the same time, attorneys should expect pushback from the court if they try to pander to particular judges.

"Be careful about waving a particular opinion around and calling it a particular judge's opinion," Dauchot said. "The panel will push back and note that an opinion 'isn't the judge's opinion; it's the court's.' While it's important to be aware of judges' individual approaches and idiosyncrasies, you need to be careful how you handle those in oral arguments. … Pandering to them may seem intuitively like the way to go, but it comes at the risk of drawing some hostility."

Rather than getting entangled in judges' various beliefs, savvy attorneys consider the full jurisprudence of the court and make their argument in that way, according to Jenks.

"Experienced advocates would much rather tailor their arguments to the case law and the concerns expressed in the case law and maybe the policy behind the case law than try to appeal to one judge or another," he said.

Keep It Civil

Attorneys who make personalized attacks against their opponents or trial court judges are not scoring any points with the appeals court.

"Decorum at the Federal Circuit lends itself to more civility and less nastiness than you might find at the trial court level," Dauchot said. "It's a function of the lawyers. It's a function of the facts dealing with appellate arguments as opposed to the underlying factual back-and-forth at the trial court level. It's also a function of the Federal Circuit judges who insist on civility and will reprimand behavior that is anything less than professional."

Attorneys said they have seen Federal Circuit judges become frustrated during oral arguments when lawyers take cheap shots at the other side and its positions or when they make derogatory comments about the lower court or patent office.

"Taking the high ground is always a good practice in any court, but particularly the Federal Circuit," Morin said.

Practice Makes Perfect

If junior attorneys are eager to become more familiar with practicing before the Federal Circuit, they may want to first try their hand at nonpatent disputes on a pro bono basis there, according to Morin, whose first three arguments at the Federal Circuit were veterans' pro bono cases.

"It was a great opportunity to become more comfortable arguing in front of the court," he said. "If attorneys are looking to gain some experience at a time in their career where it might be harder to convince clients or colleagues to have their first argument be one of their patent cases, pro bono cases are one way to break in."

--Editing by Aaron Pelc.
