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# Intellectual Property Litigation

## The Truth about the Orthodoxy of Cross-Examination

By Robert A. Spanner

There are a number of well-recognized truths about how to cross-examine a witness. But experience teaches that these truths are an orthodoxy based on a perception of what goes on during a trial that is at odds with reality, and they put a litigator at a distinct disadvantage against someone who has a different perception and is playing by different rules.

In deciding what rules to play by, the trial lawyer needs to take into account these realities of the courtroom:

- The term *trial* for the process of determining the truth in a courtroom is an apt one; it conjures up primal images of ordeal and contention. That is what jurors expect, and if the

witness leaves the witness box with his testimony intact, the cross-examiner has lost on points.

- A jury, as Vincent Bugliosi once famously said, remembers the tune but not the words. This is probably even more so in IP cases, where the subject matter is often outside the jurors' personal experience. (In a bench trial, the judge is just a smaller jury. The judge can remember some of the words, but not as many as you might think, especially in a case of any length.) Juries are constantly evaluating and assessing witnesses in

*Continued on page 12*

## The In-House Perspective on Jury Trials: Be Prepared to Tell Your Story

By Scott L. D'Angelo

It is often said that a good trial lawyer is a good storyteller—someone who is able to take the most complex, and often boring, legal and factual concepts and weave them into a relevant and engaging narrative. While some lawyers are able to develop their themes and stories on the eve of trial, the rest of us mere mortals must do so through preparation—early and often. As a jury trial approaches, nothing will make your in-house counterpart happier than knowing that you are

prepared to tell a story at trial and not just “put on evidence.” The best way to do so is to use in-house counsel to help you reach that goal. This article highlights a few tips designed to assist you in doing so.

First, always litigate the case with the assumption that it is going to go to trial. Start thinking about your trial story and themes from the inception of your engagement. Share your thoughts early

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# Message from the Chairs

This third issue of our new and improved *Intellectual Property Litigation* newsletter has another change: Steve Gardner from Kilpatrick Stockton in Winston-Salem, North Carolina, is our new editor in chief. Steve takes over from Brad Lyerla, our editor for nearly 15 years. Brad made an extraordinary commitment to the Committee and to the Section as he, without fail, published this newsletter every quarter all those years for the members of the Intellectual Property Litigation Committee. We will miss his steady hand at the controls, but he has promised to be a prominent contributor to the publication—an endeavor that is dear to his heart and in which he could not indulge with gusto while being the boss. A huge thanks to Brad and our congratulations and good wishes to Steve.

While we have generally used this column for bringing our members up to date on Committee and Section activities, we have decided to better use our Web site for that sort of information and to use this space for commentary on initiatives of the Section, programs of the ABA, and issues of prominence in the IP practice. The theme of this issue is Jury Trials in IP Litigation. Coincidentally, one of the major initiatives of ABA President Robert J. Grey's tenure is the jury system. He appointed past Section Chair Trish Refo to lead the American Jury Project, a comprehensive review, consolidation, and update of the existing ABA standards relating to jury trials. The end product of that project is The ABA Principles Relating to Juries and Jury Trials that the House of Delegates adopted on February 14.

To draw together a wide representation of viewpoints, President Grey created an advisory committee to the American Jury Project. The committee, including representatives from across the profession who have an interest in, and deep knowledge of, jury-related issues, offered written comment on the draft principles and provided oral testimony at the National Symposium on the American Jury System held at Washington and Lee University School of Law in October 2004. The draft principles

were disseminated widely and written comment sought from judges, lawyers, academics, jury experts, court administrators, bar leaders, and others interested in the health of our nation's jury system. The American Jury Project approached its review and commentary by dividing the existing principles into five general categories: (1) General; (2) Assembling a Jury; (3) Conducting Jury Trials; (4) Jury Deliberations; and (5) Postverdict Activity. Some of the highlights:

Principle 2, Citizens Have the Right to Participate in Jury Service and Their Service Should Be Facilitated, recommends that courts should use a term of service of one day or the completion of one trial, whichever is longer; however, in no event should a person have to remain available for service for longer than two weeks. Clearly, this recommendation is sensitive to the personal and professional lives of jurors and the need to accommodate the laudable activity of jury service with the reality of everyday lives.

One of the most significant recommendations is under Principle 3, Juries Should Have 12 Members, which states that juries in civil cases should be constituted of 12 members wherever possible with 10 of the 12 being able to render a verdict. Principle 4 deals with the unanimity of jury decisions and recommends that decisions should be unanimous where possible. A less-than-unanimous decision should be accepted only after jurors have deliberated for a reasonable period of time and if concurred in by at least five-sixths of the jurors. In no civil case should a decision concurred in by fewer than six jurors be accepted unless the parties stipulate to such a decision and specify the number of concurring jurors required for the verdict.

Principle 7, Courts Should Protect Juror Privacy Insofar as Consistent with the Requirements of Justice and the Public Interest, sets forth safeguards for jurors with respect to personal information necessary for counsel to know, but that ideally should be protected by private disclosure. One safeguard recommendation, for example, is that cameras, if permitted in the

**Thank You, Brad Lyerla, for 15 years  
of service as Editor in Chief!**

courtroom, should not be allowed to record or transmit images of the jurors' faces.

Principle 11, directed to the process of empanelling jurors, serves the goal of assembling a fair and impartial jury. It recommends that the voir dire process should be held on the record with the questioning of jurors conducted initially by the court followed by questioning from each party subject to reasonable time limits. This Principle also advises that all challenges, whether for cause or peremptory, should be exercised so that the jury panel is not aware of the nature of the challenge, the party making the challenge, or the basis of the court's ruling on the challenge. Principle 13, The Court and Parties Should Vigorously Promote Juror Understanding of the Facts and the Law, urges taking all steps to facilitate juror note taking. Under this Principle, juror questioning of witnesses by written submission is also encouraged. Upon receipt of a question from a juror, the court should disclose it to the parties outside the hearing of the jury and provide the parties with an opportunity to object or make modifications to the question.

The above is obviously a very short summary of the rich substance of the American Jury Project Principles. More information about the project can be found at [www.abanet.org/juryproject/standards/home.html](http://www.abanet.org/juryproject/standards/home.html). Although many of the principles may be commonplace in your jurisdiction, many are not practiced widely. As a result, the American juror is not entering and engaging in this important process with all of the tools, education, and respect necessary to undertake this significant contribution to the administration of justice in America. The product of the American Jury Project should be a valuable guidepost to courts across the country in formulating and implementing jury processes. ●

# “Tort Reform” in Patent Litigation

By Richard L. Rainey and Tryn T. Stimart

The American legal system is no stranger to the hue and cry for reform. Of late, reform of the tort laws has been at the top of the list, at least among politicians, as the tort laws are perceived by some to be harming the economy through expensive, unnecessary litigation and runaway juries. Indeed, during the 2005 State of the Union Address, President George W. Bush urged Congress to reform this area of the law, stating, “[T]o make our economy stronger and more competitive, America must reward, not punish, the efforts and dreams of entrepreneurs. . . . Justice is distorted, and our economy is held back, by irresponsible class actions and frivolous asbestos claims, and I urge Congress to pass legal reforms this year.”<sup>1</sup> Several days later, Congress passed the Class Action Fairness Act of 2005.<sup>2</sup>

Over the years, the patent laws have also been the subject of reform. Notable examples of congressional reforms include passage of the landmark 1952 Patent Act and creation of the United States Court of Appeals for the Federal Circuit. Indeed, one of the key goals in creating the Federal Circuit was to unify the interpretation of the patent laws to avoid circuit splits that had plagued the patent system. The judiciary has also played a role in “reforming” the patent system through interpretation and application of the patent laws. In recent years, those judicial reforms have had a notable effect on the role of juries in resolving patent disputes. Slowly but surely, juries are playing an ever-decreasing role in resolving patent disputes. Merely by way of example, in the past decade the Supreme Court<sup>3</sup> and the Federal Circuit<sup>4</sup> have held that claim construction is a pure issue of law for the court, and not the jury, to decide. Before these pronouncements, it was not at all uncommon for juries to decide the meaning of claim terms. The courts have also erected many legal limitations on the doctrine of equivalents, including the all-limitations rule,<sup>5</sup> prosecution history estoppel,<sup>6</sup> and the “inherent narrowness of the claim language,”<sup>7</sup> removing that issue from the jury in many

cases. To many (though not all), these are positive reforms designed to promote uniformity and predictability in the patent laws, thereby strengthening the economy.

In the view of a number of organizations, however, more reforms are needed. Recently, the National Academy of Sciences (NAS) proposed sweeping reforms to the patent system to address, among other things, what the NAS perceived as the high costs and unpredictability of patent litigation.<sup>8</sup> These proposals include, among others, elimination of the subjective elements of patent law and establishment of a postgrant opposition

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***Juries are playing  
an ever-decreasing  
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proceeding at the United States Patent and Trademark Office (PTO).<sup>9</sup> These proposals, if implemented, may well further reduce the role of juries in patent litigation as issues traditionally resolved by juries, such as compliance with the best mode<sup>10</sup> requirement and willful infringement,<sup>11</sup> would be eliminated. Again, to many, these are attractive proposals—though, also, not without controversy.

Following publication of the NAS report, the American Bar Association’s Section of Intellectual Property Law (ABA Section) established a task force to study the NAS proposals and determine what action, if any, the ABA Section should take in response.<sup>12</sup> In the end, the task force recommended adoption of

many of the NAS proposals.<sup>13</sup> Other bar groups, such as the American Intellectual Property Law Association (AIPLA), have also weighed in on the NAS proposals, supporting many of them. On those issues where there is agreement, the next step will likely be pressure on Congress to pass legislation to change the patent laws, and further reforms to the patent system may well occur in the near future. Some highlights from the NAS Report and ABA Section response follow.

## **Recommendations by the NAS**

In 2004, in response to what it perceived as the high costs of patent litigation and the unpredictability of outcomes, the National Research Council of the NAS published the NAS Report, which included seven recommendations to “ensure the vitality and improve the functioning of the patent system.”<sup>14</sup> Specifically, it recommends: (1) an open-ended, unitary, flexible patent system;<sup>15</sup> (2) a stricter application of the nonobviousness standard;<sup>16</sup> (3) a postgrant open review procedure; (4) increased funds for the PTO; (5) protection for noncommercial uses of patented inventions;<sup>17</sup> (6) removal or modification of subjective elements in patent litigation;<sup>18</sup> and (7) further international harmonization of examination procedures and standards.<sup>19</sup>

## **Modifying or Removing the Subjective Elements of Patent Litigation**

The NAS recommends limitations on the subjective elements of patent litigation because “[a]mong the factors that increase the cost and decrease the predictability of patent infringement litigation are issues . . . that depend on the assessment of the party’s state of mind at the time of the alleged infringement or the time of patent application.”<sup>20</sup> The NAS suggests reforms in the areas of willful infringement, best mode, and inequitable conduct to “increase the predictability of patent dispute outcomes and reduce the cost of litigation without substantially affecting the underlying principles that these aspects of the enforcement system were meant to pro-

mote.”<sup>21</sup> Whether a goal of the report or not, a natural result of eliminating subjective elements is to further erode the jury’s role in patent litigation.

## Elimination or Modification of Willful Infringement/Enhanced Damages

The NAS recommends either the complete elimination of the enhanced damages provision in 35 U.S.C. § 284 or alternatives short of elimination. Section 284 allows a court to increase damages up to three times if it determines the case is exceptional. One basis for increased damages identified by the Federal Circuit is when the infringement is found to be willful.<sup>22</sup> To support its recommendation to eliminate the enhanced damages provision, the NAS cites evidence that “exposure to claims of willful infringement” encourages purposeful ignorance of existing patents. Specifically, the NAS explains that “[t]he mere existence of the doctrine [of willful infringement] in its current form means that any time an individual or company learns of a patent that might bear on its products, the company is at risk.”<sup>23</sup> Thus, “in-house counsel and many outside lawyers regularly advise their clients not to read patents if they can avoid it.”<sup>24</sup> The NAS also points to the high costs associated with the need for opinion advice upon learning of another’s patent, along with the associated collateral litigation issues and costs associated with willful infringement in its current form.

In further support of eliminating this provision, the NAS argues that the “criteria courts now employ in determining willfulness” have an overdeterrent effect, “discouraging marginally lawful behavior and taking advantage of the patent disclosure” leading to “undesirable social costs.”<sup>25</sup> At the same time, the NAS points out that the system already provides adequate deterrence against unlawful behavior without the need for enhanced damages. The NAS explains that “there has been no empirical demonstration that the availability of enhanced damages provides substantial additional deterrence over and above that associated with the usual costs and risks of defending an infringement claim, the threat of pretrial injunction relief ... and post-trial award of attorney’s fees against deliberate infringement.”<sup>26</sup>

The NAS recognizes, nevertheless, that full elimination of the enhanced damages provision is only one possibility.

Alternatives include: (1) abolishing the requirement that infringers obtain and then disclose a written opinion of counsel; (2) limiting the inquiry into willful infringement until infringement has been established; and (3) requiring either actual written notice of infringement from the patentee or deliberate copying of a known invention as a predicate for willful infringement.<sup>27</sup> The NAS also recognizes that its proposals raise questions that merit further consideration about the “duty of care” to avoid infringement, which it did not address.

The ABA Section supports in principle the NAS approach to willful infringement and also encourages legislation to further alter the law of attorney-client privilege in this area.<sup>28</sup>

## Elimination of the Best Mode Requirement

The NAS also recommends elimination of the best mode requirement under 35 U.S.C. § 112, ¶ 1. As motivating factors, the NAS states:

Given the cost and efficiency of this defense, its limited contribution to the inventor’s motivation to disclose beyond that already provided by the enablement provisions of Section 112, its dependence on a system of pretrial discovery, and its inconsistencies with European and Japanese patent laws, the committee recommends that the best-mode requirement be eliminated.<sup>29</sup>

Under current law, a determination of whether the inventor has complied with the best mode requirement is a question of fact, which entails a two-step process. First, the factfinder determines whether, at the time of filing the application, the inventor possessed a best mode for practicing the invention. This inquiry is highly subjective and focuses on the applicant’s state of mind at the time of filing. Second, the factfinder decides whether the inventor’s disclosure is adequate to enable one of ordinary skill in the art to practice the best mode of the invention. This inquiry is objective and depends on the scope of the claimed invention and the level of skill in the relevant art.<sup>30</sup>

In support of eliminating the best mode requirement, the NAS cites to the fact that a best mode determination is based on “historical facts ... and usually can be established only by circumstantial evi-

dence.”<sup>31</sup> These factors naturally increase the cost of litigation, since significant discovery is necessary to prove a violation of the requirement. Regarding the usefulness of the doctrine, since the defense is applicable only to information and belief personal to the inventor, “the doctrine as applied gives only a limited assurance that the best mode will be disclosed.”<sup>32</sup>

Moreover, the NAS notes that eliminating the best mode requirement will assist in harmonizing U.S. patent law with Europe and Japan. The NAS states: “The ‘best mode’ requirement, having no analog in foreign patent law, imposes an additional burden and element of uncertainty on foreign patentees in the United States.”<sup>33</sup>

The ABA Section “fully endorses” the NAS proposal to eliminate the best mode requirement. The ABA Section also ties the repeal of the best mode requirement to coordinating other harmonization-related changes, such as changing the U.S. law to a first-to-file regime, noting that “such coordination could produce a patent system in which there would be no issues of patent validity that would require discovery of inventor records and inventor intentions in most patent infringement litigations.”<sup>34</sup>

## Conclusion

As the NAS Report and ABA Section Response demonstrate, there is significant support for continued reform of the patent laws to address, among other things, the perceived high cost and unpredictability of patent litigation. These proposed reforms touch on areas of the patent law such as willful infringement, inequitable conduct, best mode, first-to-invent, and many others. While predicting congressional action is difficult, if not impossible, the NAS Report and ABA Section Response (and other input in this area) are, at the very least, worthy of study and debate. ●

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## Endnotes

<sup>1</sup> President George W. Bush, State of the Union Address (Feb. 2, 2005).

<sup>2</sup> Class Action Fairness Act of 2005, Pub. L. No. 109-2 (2005).

<sup>3</sup> See *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996) (holding that claim

construction is for the court and not the jury).

<sup>4</sup> See *Cybor Corp. v. Fas Technologies, Inc.*, 138 F.3d 1448, 1456 (Fed. Cir. 1998) (en banc) (holding that claim construction is a pure question of law and on appeal reviewed de novo).

<sup>5</sup> See *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29 (1997) (adopting Judge Nies's "all limitations" rule); see also *id.* at 39 n.8 (stating "[o]f course, the various legal limitations on the application of the doctrine of equivalents are to be determined by the court, either on a pretrial motion for partial summary judgment or on a motion for judgment as a matter of law at the close of the evidence and after the jury verdict").

<sup>6</sup> See *Glaxo Wellcome, Inc. v. Impax Labs., Inc.*, 356 F.3d 1348, 1356 (Fed. Cir. 2004) (affirming district court's grant of summary judgment of noninfringement under the doctrine of equivalents holding that "Glaxo has not rebutted the presumption that prosecution history estoppel bars a finding of infringement under the doctrine of equivalents.").

<sup>7</sup> See *Moore U.S.A., Inc. v. Standard Register Co.*, 229 F.3d 1091, 1106 (Fed. Cir. 2000) (holding that the applicant's claim term was not entitled to a range of equivalents and noting that under prior decisions "many limitations warrant little, if any, range of equivalents.").

<sup>8</sup> The members of the NAS making its proposals include cochairs Richard C. Levin, President, Yale University, and Mark B. Meyers, Visiting Executive Professor of Management, The Wharton School, University of Pennsylvania, as well as other distinguished members.

<sup>9</sup> See Nat'l Research Council of the Nat'l Acad., "A Patent System for the 21st Century" (Stephen A. Merrill, et al. eds., 2004), available at [www.nas.edu](http://www.nas.edu) [hereinafter NAS Report].

<sup>10</sup> See *Great Northern Corp. v. Henry Molded Prods., Inc.*, 94 F.3d 1569 (Fed. Cir. 1996) (affirming jury verdict of invalidity for failing to disclose best mode).

<sup>11</sup> See *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 1250 (Fed. Cir. 1989)

(stating "[w]illfulness of behavior is a classical jury question of intent. When trial is had to a jury, the issue should be decided by the jury.") (citations omitted).

<sup>12</sup> Mr. Rainey is a member of the task force.

<sup>13</sup> See Response to the Recommendations of the National Research Council of the National Academies on "A 21st Century Patent System," 2005 ABA Sec. Intell. Prop. Law, available at [www.abanet.org/intelprop/bulletin/2005\\_03](http://www.abanet.org/intelprop/bulletin/2005_03) [hereinafter ABA Section Response].

<sup>14</sup> See NAS Report, *supra* note 9.

<sup>15</sup> The NAS recommends that the patent system remain open to new technologies as well as exploiting the PTO's guidelines for new or newly patented technologies. In addition, the NAS recommends that the Federal Circuit encourage submission of amicus briefs, the Federal Circuit engage in more exchanges with other courts, and appointments to the Federal Circuit include individuals familiar with innovation with a variety of perspectives (e.g., management, finance, economics). See NAS Report, *supra* note 9, at 83-87.

<sup>16</sup> For example, the NAS recommends that, with respect to gene-sequence-related inventions, the Federal Circuit abandon the per se rule announced in *In re Bell*, 991 F.2d 781 (Fed. Cir. 1993), and *In re Deuel*, 51 F.3d 1552 (Fed. Cir. 1995), that prevents consideration of technical difficulty faced in obtaining pre-existing genetic sequences and consider using a reasonable expectation standard set forth in *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988), or an approach similar to that used in other industrialized countries. *Id.* at 87-95.

<sup>17</sup> The NAS recommends that Congress consider narrow legislation to protect noncommercial uses of patented inventions. Alternatively, the NAS recommends that the Office of Management and Budget and the federal government agencies extend "authorization and consent" to grantees as well as contractors to use patented inventions strictly limited to research and not to any resulting commercial products or services. *Id.* at 108-17.

<sup>18</sup> For example, the NAS recommends reforms in the areas of willful infringement,

the best mode requirement, and inequitable conduct. *Id.* at 117-23.

<sup>19</sup> The NAS recommends that the United States, Europe, and Japan reduce redundancies in search and examination procedures and mutually recognize results. The NAS recommends reconciling application priority, the grace period for filing an application after publication, the best mode requirement, and the U.S. exception to the rule of publication of patent applications after 18 months. The NAS also proposes that the United States switch from a first-to-invent to a first-to-file regime. *Id.* at 123-29.

<sup>20</sup> *Id.* at 117.

<sup>21</sup> *Id.* at 117-18.

<sup>22</sup> See *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1378 (Fed. Cir. 2002) (holding that "[a] finding of willful infringement 'authorizes but does not mandate an award of increased damages.'") (emphasis in original) (citation omitted).

<sup>23</sup> See NAS Report, *supra* note 9, at 119.

<sup>24</sup> *Id.*

<sup>25</sup> *Id.*

<sup>26</sup> *Id.* The NAS contrasts deliberate infringement with mere willful infringement. It explains that "intentional infringement is viewed as more culpable, justifying punishment. In practice, exposure to a claim of willfulness is not limited to cases of calculated, deliberate infringement." *Id.* at 118.

<sup>27</sup> *Id.* at 120.

<sup>28</sup> See ABA Section Response, *supra* note 13, at 3, 29-31. The ABA Section acknowledges that the recent Federal Circuit decision in *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337 (Fed. Cir. 2004) (en banc), addressed one problem associated with willful infringement, namely, the adverse inference, but argues that the Federal Circuit has not gone far enough. The ABA Section "proposes further limits on both the timing and the scope of waiver when an opinion of counsel is relied upon." *Id.* at 3. For example, the ABA Section proposes that attorney-client privilege between the accused client and his litigation counsel not be waived when the client has asserted the defense of reliance on advice of counsel when "(1) the litigation counsel was at no time involved in rendering the advice upon which the client has asserted reliance; and (2) the opinion relied upon was rendered prior to the service of any summons and complaint alleging infringement." *Id.* at 31.

<sup>29</sup> See NAS Report, *supra* note 9, at 121.

<sup>30</sup> See *Telecom Ltd. v. Samsung Elec. Co.*, 215 F.3d 1281 (Fed. Cir. 2000).

<sup>31</sup> See NAS Report, *supra* note 9, at 121.

<sup>32</sup> *Id.*

<sup>33</sup> *Id.* at 127.

<sup>34</sup> See ABA Section Response, *supra* note 13, at 37.

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# Using Opinion of Counsel Effectively at Trial

By Bradford P. Lyerla

*Author's Note: This article is an edited version of a talk that I gave in late 2004, sponsored by the Association of Patent Law Firms. I thank the APLF for allowing me to reprint my remarks here.*

In *Knorr-Bremse*, the Federal Circuit took steps to make the reliance on counsel defense in patent litigation resemble the defense as it exists outside patent law. I hope the Supreme Court does not disturb this part of the Federal Circuit's holding. It is an improvement. It allows the trial team to be more strategic about how and when to use the reliance on counsel defense. No longer are we at the pain of choosing between waiving the privilege or not waiving and facing an adverse inference. Before *Knorr-Bremse*, the danger presented by

defendant now controls when and how to raise the reliance on the advice of counsel defense.

Let's review the analysis that I go through in my own mind when I think about whether I'm going to assert the reliance on counsel defense. For me, it is never an automatic decision that just because I have an opinion I will use it. If I think the opinion will cause me more trouble than it will save me, then I recommend to the client that we hold the opinion, assert the privilege and not produce it. That has worked for me in the past. But now it is a much easier decision because I do not have to worry about the adverse inference. Here is the process that I step through when I think about what to do with an opinion: My client has been sued. There is an allegation of willful infringement. I ask myself, how am I going to respond in discovery with respect to the opinion of counsel that the client obtained? To answer that question, I focus on four things.

First, there must be an allegation of willful infringement. This is so elementary I may not even need to say it, but let me review. An opinion of counsel is material and relevant only as to the defendant's state of mind. It is admissible only to prove the defendant's state of mind. It is hearsay if offered for the truth of the matter asserted. For example, if the opinion is that there is no infringement because Element A is missing, then the opinion is not admissible to prove that Element A is missing.

It is admissible only to prove that the defendant had a reasonable basis to believe it was not infringing. Of course, the defendant's belief is relevant only on

the issue of willfulness. If there is no allegation of willfulness, then the opinion is irrelevant and inadmissible at trial.

Next, I ask myself if the opinion is competent. Does it say the right things? Is the file history considered? Was the opinion timely? Was the author a competent member of the patent bar? Are there other problems with the opinion?

Third, I know that if I produce the opinion, I will have to produce other materials that fall within the scope of the subject matter waiver of the attorney-client privilege and/or work product protection. So, I must review that material and make sure that there isn't anything there that I'm concerned about producing. If there is unfavorable material there, I may not want to waive the privilege. Instead, I may advise the client that I don't want to use the opinion because in order to use it, we have to waive the privilege. But by waiving the privilege, we may create more trouble for ourselves than we avoid.

The fourth thing that I think about is whether the substance of the opinion is consistent with the theory of defense that I plan to present to the jury. For example, what if your opinion is about invalidity, but your theory of defense for trial is noninfringement? Some of you might believe that this presents no problem. You might believe that there is no reason not to use the opinion just because it is an invalidity opinion and you are not going to argue invalidity at trial. As lawyers, we understand that there is no logical inconsistency. It makes sense to us. But not so for the jury. In a patent jury, we typically have eight jurors. If you put into evidence an opinion that the patent is invalid, but your whole case is about noninfringement, that will confuse at least three members of the jury.

I recommend that you think this through very carefully. In patent trials, you want to put in front of a jury only one theory and you want to sell that theory over and over again. Sell it consistently, constantly, and repetitively throughout the trial. If you present an

## When to Use an Opinion of Counsel at Trial

- When there is an allegation of willful infringement.
- When the opinion is competent.
- When waiving the privilege as to the opinion will **not** result in a waiver as to other materials you do not want to produce.
- When the opinion is consistent with your trial theory.

the adverse inference often forced a waiver, sometimes even when it was not in the client's best interest. But with the inference gone after *Knorr-Bremse*, the

opinion of counsel to the jury that does not follow the same theory that you are selling to the jury in your opening statement, presentation of evidence, and closing argument, then you have introduced the opportunity for confusion. That is not a good thing.

Here is an illustrative story from a case that I tried a few years ago. My client learned of the patent-in-suit a year or so before the complaint was filed. The client discussed the patent with counsel and obtained an oral opinion that was well documented in meeting notes. The notes were specific and clear. The client also authorized preparation of a written opinion. The written opinion was prepared over a period of months. It was a beautiful written opinion. It was on beautiful bonded paper and printed very handsomely. It had a large number of attachments and was nicely bound. It would have been

very impressive visually in front of a jury if one were to put it in evidence during a trial. The problem with the written opinion was that it had a different theory of defense than the oral opinion that had been given earlier.

The written opinion—as it turned out—wasn't ready as quickly as had been hoped. The written opinion was delivered to the client a number of months after the complaint alleging infringement was filed.

Fast forward a couple of years. I am now at trial. We are ready to begin, but first the court must decide the motions in limine. Opposing counsel was very able. They filed at least three dozen motions in limine. One was directed at excluding the written opinion because it was delivered after the complaint was filed. The morning the trial was to begin, the trial judge granted the motion and excluded the written opinion.

I had assigned this motion to one of my partners. He made a fine argument

as to why the written opinion, although delivered after the litigation began, was evidence the court ought to allow the jury to consider. He argued eloquently, but still he lost. That did not completely surprise me. There are cases questioning postlitigation opinions. And so, our trial judge granted the motion and the written opinion was excluded.

## How to Use an Opinion of Counsel at Trial

- Have the opining attorney describe the client's request for advice, the opinion that was given and the delivery of the opinion to the client.
- Have the client describe why it sought the advice of its counsel and that it relied on the advice.
- Have an expert testify that the client's reliance was reasonable.

My partner returned to counsel's table and sat next to me muttering under his breath. "The judge doesn't understand. He really screwed us." But I said, "I think he just did us a favor. Now, we can use the oral opinion instead." The oral opinion said exactly what I planned to tell the jury in the opening and the closing argument. By using the oral opinion, we would avoid potential for inconsistency or misunderstanding. Our trial presentation and the evidence concerning our client's belief about these patents would be consistent. The first opinion the client received would be exactly the same as the defense we would present at trial. By not using the written opinion, we would avoid looking like a "flip-flopper," to use a term of recent popularity. I felt very good about that approach and I think the presentation, with respect to the opinion, was very effective with the jury. They were out only about two hours. We won the case and saved our client from a verdict that potentially could have

exceeded \$90 million.

As trial lawyers, we must think very carefully about what the opinion says substantively and whether it tracks what we plan to tell the jury during the course of the trial. If it doesn't track, it must be explained. And too much explaining, any good trial lawyer will tell you, will lose you at least some part of the jury. Avoid this. My advice is to make sure that the opinion is consistent with your trial theory.

Now we are ready for trial. We did our homework. We made the decision to waive the privilege with respect to the opinion. It has been produced. The lawyer who gave the opinion has been deposed. The person to whom the opinion was directed has been deposed. There may have been other discovery as well with respect to the opinion. But now that's behind us. We are ready to face the jury. How are we going to use the opinion at trial to optimize its effectiveness? Here is what I do, and I urge you to think seriously about doing it this way yourself the next time you are relying on advice of counsel to rebut an inference of willful patent infringement.

I have the opining attorney testify first. I have him or her describe the assignment received from the client. I have him or her testify that the opinion was given and delivered to the client. I introduce the opinion into evidence. In my experience, it will be received into evidence. Some judges will not let the opinion go back to the jury during deliberations, but it will be received into evidence if it is in writing. Referring back to the example I gave a moment ago where the opinion was oral, I offered the notes from the meeting into evidence. We put the notes on a large placard, and the jurors read the notes as the meeting where the advice was given was described by the witnesses. You want to put the physical evidence, in whatever form it takes, in front of the jury. Let them see the opinion, what it says and when it was given.

As the opining attorney testifies, he or she should also explain that this advice was given to the client for the client to use in making business decisions. The jury should understand that this is a client that seeks legal advice in order to conduct business in a way that is lawful. If there is a history of giving such advice

to the client, then that history can be described as well and the history can be used to explain why the advice in this case was sought.

Second, I have the client describe why it sought the advice of counsel and how it relied on the advice. You can imagine how that testimony might go:

*“We learned of the patent. We have a relationship with our law firm. We rely on our lawyers to advise us on such matters. Patents sometimes are complicated. We rely on our lawyers because they are experts. We turned this over to them. We gave them all the information that we had. They asked us more questions. [Assuming this is consistent with the lawyer’s time sheets and deposition testimony], it was a very probing investigation by our lawyer. We expect our lawyers to be thorough. They were thorough and they gave us this advice. We relied on the advice. We did the following based on the advice.”*

The witness is excused. Then I call a third witness to testify about custom and practice. Some lawyers elect not to call a witness of this type, but I think it is very important for reasons I explain below. My slide describes the witness as an expert. That is not quite accurate. This witness is really going to testify about custom and practice. Ideally, this witness is a luminary from the industry rather than a lawyer. Some judges do not feel good about lawyers giving this sort of testimony; other judges are okay with it. When I spoke at the APLF Annual Meeting last year, Chief Judge Young of the Federal District Court of Massachusetts was present. Afterwards he came up to me and he said, “I agree with everything you said except for one thing. I would not let a lawyer give testi-

mony on custom and practice. It should be a person from the industry. I would not let a lawyer do it.” So, if you have a judge like Judge Young, you should find somebody from your client’s industry who can testify that responsible corporate citizens, when faced with a potentially relevant patent owned by somebody else, seek advice from their lawyer. The witness should explain that what happened in your case is a routine and appropriate thing in the client’s industry.

This is an important message for the jury. It may seem to you that this should be plain to a jury, but it is far from obvious. I learned this through participating in a number of jury studies over the years. Some jurors, possibly the majority of jurors, assume the defendant was act-

## Who May Be Opinion Counsel?

- Opinion counsel **may not** be trial counsel.
- Opinion counsel **may** be a member of trial counsel’s law firm in most jurisdictions.
- Juries do not care if opinion counsel is from the same firm as trial counsel.

ing with a guilty conscience when the jurors learn that the defendant sought a lawyer’s advice. We may think that is very unsophisticated. And, it is unsophisticated. But it is a widely held belief among jurors. A lot of folks out there hold the belief that you do not need to talk to a lawyer unless you have done something wrong.

Let me offer an illustration of how you might see this in a jury study. Some of the jury-study vendors have technology that allows mock jurors to input data in real time during the jury-study exercise. The jurors punch buttons as lawyers are making their presentations. They punch green when they like something they hear. They punch red when

they do not like something they hear. They punch blue when they are bored, and so forth. They are given instructions to do this ahead of time. I have observed that whenever a presenting lawyer—it can be either the plaintiff’s or the defendant’s lawyer—describes that one of the parties consulted a lawyer before the trial, you see negative inputs immediately from the jury. The approval rating dips sharply. The first time that I saw this I was puzzled until we interviewed the jurors and they explained it. Many of the jurors think only the guilty consult lawyers. This is a widespread misperception. You must address it head on. I think that calling this third kind of witness whom I have described is the best way to address it.

Of course, the client should exercise care in choosing the lawyer who will give the advice. An issue that often comes up is whether trial counsel can be from the same law firm as the lawyer who gave the advice. You must check the Rules of Professional Conduct in the jurisdiction in which the trial is going to take place. The rules vary by jurisdiction.

As for the jury, I will tell you from personal experience that the jury does not care. They do not put it together. It is not important to jurors that Mr. Jones wrote the opinion and he is the partner of Mr. Smith who is giving the closing argument. That seems completely natural to them. They do not question it unless someone tries to make something out of it. And, when somebody tries to make something out of it, it is ineffective. That is my own anecdotal experience. But the rules must be carefully attended to. In some jurisdictions, it is very difficult for the same law firm to render the opinion and defend the trial. For example, the Central District of California disfavors the same law firm performing both roles. In Colorado, on the other hand, it is permitted, but the client must give its written approval. There is no prohibition against it in Illinois. Other jurisdictions fall on different points along that spectrum. You must check. ●

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# Electronic Communication with Today's Juror in IP Litigation

By Joanna Gallant, Ph.D., Jessica Evans, M.A., J.D., and Jim Dobson, M.A.

**A**lthough attorneys communicate with jurors during every phase of a trial, the way information is delivered depends upon the stage of trial and the purpose of the intended communication. For example, in the opening statement, attorneys have the luxury of planning and rehearsing their statements. They can script their arguments and prepare a polished presentation of case facts. Given the time and resources available pretrial, most IP litigators today are opting to use presentation software, such as PowerPoint, to enhance their opening statements. Properly used, this type of media helps attorneys teach jurors specific case facts on-screen in a slow, systematic fashion that permits easy assimilation and retention of case material. This type of media also allows for effective, side-by-side comparisons of products, patent claims, and other information.

PowerPoint is used to create slide-show presentations containing graphics or animations. Litigators can design and detail the slides in countless ways, so as to present clearer and more concise arguments for their clients. For example, there are often certain documents that are essential to show in a closing argument. Instead of simply describing the documents, or holding them up in front of the jury, PowerPoint slides can be created to introduce the document to the jurors and to walk them through the key language contained within them.

It is important to remember that simply projecting an image on a screen does not facilitate juror learning or retention of case facts, but it can promote better retention if used effectively. For example, instead of showing an entire document on screen and asking jurors to take in the information globally, enlarging and highlighting key text is an effective means of directing jurors' attention to what one wants them to notice, and will help them retain that information.

Understandably, some attorneys raise concerns that jurors may attribute the

choice of using specific call-outs to a deceptive trial strategy calculated to deflect or shield attention from "bad" information in a document, but this issue is easily addressed with a simple explanation provided when the first call-out is shown. One recommended approach is to tell jurors during an opening statement that in order to provide an overview of important facts and evidence, some evidence is going to be displayed with call-outs instead of showing an entire document. Assure them that these documents will be seen again throughout the trial, and remind them that they can look through the entire document during deliberations. Such an approach has proven to be extremely effective in introducing jurors to electronic displays of evidence.

The same is true of testimony. The use of ellipses, although often hotly debated among trial team members, can be an effective way to convey the main point of rather lengthy testimony. When jurors are informed about the purpose of ellipses (i.e., to save some time going through rather lengthy testimony and to help clarify the key points of the testimony), they are less likely to assume that omitted text is problematic and it can actually help jurors better grasp important case points. In addition, bolding specific text and fading out already described testimony are also effective methods of focusing juror attention and promoting juror retention of specific details.

Another technique IP attorneys are using more and more these days in court is animation. For example, when highlighting what is contained in a document and what someone said regarding that document, it may be advantageous to use animation to build the slide instead of putting all of the information up simultaneously. By revealing the testimony after the jury has had time to review the document, the jurors can slowly encode the information presented to them, first taking in the key language from the document then absorbing the information contained in the

testimony. By controlling the sequence of the animation, the presenter maintains the attention of the jury because there will be no competition between the oral statement and what is revealed graphically subsequent to the statement. Research shows that a lack of congruency between information presented visually and what is heard can result in failure of the individual to encode one, if not both, pieces of evidence (Moreno & Mayer, 2002; Swell, 1999). Again, since there is time to plan and rehearse one's opening statement, one can ensure that animations are in sync with the scripted argument so that the presentation sends a fluid and coherent message to the jury.

In addition to documentation-based slides, graphics can also be created to help organize and/or clarify other types of information. For example, organizational charts, summary graphics and checklists are often very beneficial when dealing with complex cases. These slides can be animated to incorporate specific components, as well as to manipulate various aspects of existing slides (e.g., moving an entry from one list to another or an entity from one relationship to another). The ability to animate slides is particularly helpful in explaining various types of financial transactions (e.g., to show where money changes hands and in what quantities), as well as in explaining temporal events (e.g., timelines and historical events charts). Without the ability to animate graphics, jurors would likely be overwhelmed with the amount of data presented and their attention would be divided between the electronic display and the speaker, assuming they could focus on the speaker at all.

One important thing to keep in mind when designing these analytical graphics is that the choice of what to include within the slide is equally important as what to omit. While Allport, Antonis, and Reynolds (1972) found that recall was improved when participants read information as opposed to hearing it, a finding

that has been consistently upheld in current research. In other words, including too much information in chart form can be counterproductive. Keep in mind, the goal of analytical charts is to help jurors organize information so that when they deliberate, they have a clear understanding of case materials and arguments.

Providing too many words on a slide or too many graphic elements simultaneously will confuse jurors and will fail to help them encode this information. Instead, charts should be clear and concise and contain only the limited information essential to assist in the retrieval process that occurs subsequently during deliberations. The language contained in a slide should reinforce the main point of the attorney's argument, and the attorney should elaborate on key phrases contained in a graphic rather than spelling them out.

It is always important to remember the goal of your graphic. During the creation and development of graphics one should ask oneself: Is its purpose to educate? To clarify? To help organize? To compare? For example, when creating a timeline, one should design the timeline based on the intent of the communication exchange. What is the intended message? Is it to describe a general history of events, or to highlight the actions of one party versus the inactions of another during a specific time frame? The specific underlying goal of the communication should always shape and direct the visual depiction. The same is true for organizational or relationship charts. What message does the attorney want to convey to the jury? Is the point to show that there is a clear and direct relationship between specific parties, or is the point to show an intricate and unspecified labyrinth of interactions? Does the chart convey the dominant party in a transaction accurately, or does the visual compete with the underlying argument? Although information is more readily remembered when displayed visually than when it is described orally, the visual image must support the underlying message.

The more advanced versions of PowerPoint also have other features worthy of mention. For example, newer versions of PowerPoint allow one to play video files and other multimedia files (e.g., .asx, .wmx, .wvx, .wax, .avi and .mpg files) within the slide itself. Not only does this allow for a seamless presentation of material, but it negates the need for clunky tel-

evision sets, VCRs, setup time, etc. Instead, with a simple click of a mouse, a video can be played to the jury, with or without a running transcript or other corresponding graphics components.

Another major advantage of modern technology is the ability to integrate high- and low-tech approaches into one presentation. For example, trial teams can create effective static summary charts that are integrated with on-screen displays. Static boards are often very attractive choices to trial teams, especially since they remain in view of the jury for a considerable amount of time and continuously reinforce select points. While these large poster boards are generally effective at conveying key points to jurors, they often work better in con-

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***The witness becomes  
the teacher, the  
authority of the  
subject matter, and the  
jurors become her or  
his students.***

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junction with an electronic display of the supporting evidence. By using both, for example, in an opening statement, the attorney provides jurors with a means of evaluating the evidence they are to see at trial—a method of organization and evaluation that the jurors can adopt as their own and employ throughout the trial.

### **Technology Specific to Expert Witness Testimony**

PowerPoint is often very useful in the examination of expert witnesses. One of the key challenges of expert testimony is that the expert must educate the jury about certain complex information. To effectively teach this complex information, the witness must be able to sequentially introduce small amounts of information and build upon that educational base. For example,

if a case concerns a patent dispute, jurors may first need to understand how patents are obtained, including how the application and approval process works before discussing the actual dispute. Another example is where certain industry-specific language needs to be introduced before case facts can be understood by jurors. By taking jurors through this information sequentially, the chances of comprehension and later retention are greatly enhanced.

In addition, the use of graphics during expert witness testimony also allows for greater interaction between the witness and the jury. As the witness describes an animated graphic, he or she leads the jurors through a lesson. During the witness's testimony, he or she can say to the jury, "if you look at this chart/slide, you will see ..." In this sense, jurors learn to take cues from the witness who will direct their attention to, and away from, graphics. In addition, the witness can also sense the level of juror comprehension by reading the facial expressions of the jurors as he or she walks them through the graphics, and can tailor the pace of his or her testimony accordingly (e.g., by slowing down, repeating or rephrasing statements, etc.). This also establishes a "command for audience." The witness becomes the teacher, the authority of the subject matter, and the jurors become her or his students.

Education is not the only reason to use graphics. Demonstratives also serve as a simple tool to break up the monotony of often long, and at times, complex IP subject matter. By integrating graphics with testimony, jurors remain stimulated and attentive and can become more active participants in the information exchange.

### **Technology As a Tool for Teaching Scientific Information**

When a case involves scientific information, it is often only through the use of technology that this information can be effectively taught. For instance, teaching jurors the underlying mechanical processes involved in the proper function of a machine is impossible to do with words alone. By employing modern technology, the presenter can simulate how a machine operates in a manner conducive to lay comprehension and retention. Graphics allow jurors to visualize the inner workings of a machine that ordinarily would not be perceptible. Furthermore, by incorporating graphical elements to help explain

the visual display, such as animated text boxes to clarify different processes or to label various components, the presenter is able to highlight key points about how the machine operates in a simple, sequential fashion, thereby facilitating juror understanding.

### Teaching Scientific or Medical Issues with Technology

Technology will also shape attorneys' trial strategies, particularly in cases involving scientific or medical issues that benefit greatly from electronic modes of communication. Teaching someone how the human body works (e.g., explaining the human visual system) or how the body was harmed (e.g., how toxins, various cosmetic applications, or foreign objects affect the human body) is more effectively done through the use of computer programs and visual displays. Furthermore, as mentioned earlier in this article, the ability to recreate and pause animation sequences is extremely helpful because, for example, a witness would be able to walk through the sequence slowly, and even pause, to ensure the jurors understand every intricate detail of the testimony. Thus, with the use of high-tech computer software, one can illustrate structures, processes and events that otherwise would be difficult or impossible to observe and understand at trial.

### Conclusion

Given that our society as a whole is shifting towards more visually oriented modes of communication, attorneys should adapt their trial techniques accordingly by incorporating electronic means of communication. Whether the setting is an arbitration, or a bench or jury trial, research and practice show that the evidence presented is more clearly understood when technology is used to clarify and enhance one's presentation. The key to successful communication with jurors today is not only to have technology available in the courtroom but to really understand how to equip oneself with the tools and advantages offered by that technology.

Using courtroom technology is not simply about having images flash on flat panel screens. Effectively communicating a particular message involves thinking about the case theory beforehand, deciding what points need to be made, and closely working with the trial team to use

the agreed upon tools that will help clarify those key points in the best way and at the right moments.

Overusing videos, being overinclusive in slides, incorporating "bells and whistles" for their own sake, and showing too much evidence without providing a way to mentally organize the information are tactics that do not advance one's case, regardless of how aesthetically pleasing the visual display might be. The electronic visual display should facilitate a clear explanation of case facts, provide a timely and coordinated display of various pieces of evidence and/or testimony, and allow for some flexibility needed to help jurors understand and effectively analyze the key pieces of evidence. However, it must be harnessed by a litigator who recognizes the advantages, and the limitations and risks, involved in choosing to use technology. As times change and the matters in our courts become much more complex, so must today's trial teams competently equip themselves with the most

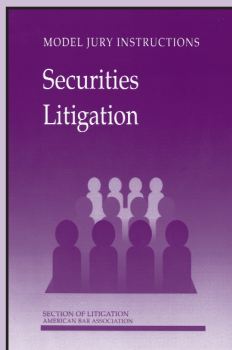
effective and appropriate tools that today's courtroom technology can provide. ●

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*The authors are with DOAR, a litigation consulting firm. Dr. Gallant is a jury consultant and has consulted with attorneys on a diverse set of matters, including those in the areas of securities, insurance, environmental, and advertising law. Ms. Evans holds a law degree and is a specialist in the psychology and sociology of jury decisionmaking. Mr. Dobson is the vice president of research and analytical graphics at DOAR and oversees jury research and trial graphics teams involved in the design and implementation of courtroom presentations. The authors may be contacted through DOAR's Web site at [www.DOAR.com](http://www.DOAR.com).*

Online Extra: For an expanded version of this article, including sample slides, graphics and a bibliography, go to [www.abanet.org/litigation/committee/intellectual/articles.html](http://www.abanet.org/litigation/committee/intellectual/articles.html).

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## The Truth about the Orthodoxy of Cross-Examination

Continued from cover

real time to determine what the truth is, not by considering their testimony deductively but rather by a subconscious process, making tentative decisions about who is winning and who is losing; who is good and who is bad; who is deserving and who is not.

- The holding of a trial means *someone* has made a mistake. In IP cases, the opposing counsel is usually intelligent enough to understand the law, so the mistake is generally not a mistake of law. And given that the stakes in IP litigation discovery are usually comprehensive, so the mistake is generally not based on a misunderstanding of the facts. Rather, the mistake invariably is a mistake of judgment, as to such things as what the preconceptions of the jury will be, how compelling the client's case is, and how attractive the various witnesses will be.

It is these jury intangibles that will dictate the outcome if the facts are close and the law is close.

The accepted rules of cross-examination are primarily designed to avoid fumbling—but there is a cost. The consequence of limiting cross-examination to the objective of not fumbling makes for an insipid presentation, and if an opponent is using cross-examination to influence these intangible factors every moment while you are not, the opponent may well prevail for that very reason.

Consider these old chestnuts:

### Examining from an Outline

The way cross-examination is usually taught, one is advised to prepare an outline along the lines of points to be made in one column and the supporting or impeaching evidence in another. In the greatest elaboration of this teaching, a flow sheet is prepared, anticipating follow-up questions for both an affirmative and a negative response as to each and every question.

Preparing such an outline is an essential discipline. In this manner, the examiner avoids surprise and has every tool at hand to address an inaccurate answer. The question is not whether to prepare an elab-

orate outline; but rather what to do with it.

Most litigators examine from an outline, and some practitioners of this skill are very, very good at it, making the examination seamless. But many lawyers fall into the trap of using an outline as a crutch, fearful that something will be forgotten, and march through the outline in lockstep, barely listening to the witness since it is hard to do two things at once. A number of untoward effects result:

- The examiner is looking at his outline for the next question while the witness is answering; as a consequence, the examiner is only dimly aware of the answer. Information is lost.
- The witness's answer should drive the next question—not what's in the outline.

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***It is through eye contact that we communicate dominance, incredulity, or contempt to the witness.***

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- If the examiner is not watching the witness every moment, subtle (and not so subtle) cues from the witness that the jury is seeing will be missed. Is the witness answering so quickly that it looks like the answers were coached? Is the witness answering too slowly, indicating that the witness is walking through a mental minefield? Does the body language convey discomfort? Is the witness looking to the counsel table for help? If the examiner is looking at his outline and thinking about the next question, he or she will miss these vital cues.
- Breaking eye contact with a witness means losing control of the witness. It is through eye contact that we com-

municate dominance, incredulity, amusement, or contempt to the witness, and by these cues shape what the witness says and how he says it.

- A follow-up question half-a-second after a response is ten times more effective than the same question ten seconds later, after looking down at an outline, and the devastating effect of a great question is lost by having to look for it. If it was such a compelling question, why wasn't it just asked?
- During these brief interludes, while counsel is forming the next question, jurors' attention may wander, and they may forget the previous answer, the previous question, the context, or all three. Cross-examination needs to flow; otherwise, it is stilted and ineffective.
- A trial lawyer who is constantly looking down for the next question is not making a good impression. The examiner should be watching the witness and the effect of the testimony on the jury—not looking at a piece of paper. A trial lawyer needs to convey during cross-examination that everything that can be known about the case *is* known to the examiner, and that what he or she says can be believed. Constantly looking down at one's outline sends the exact opposite message.

The remedy is to reduce one's reliance on an examination outline. This may be a horrifying thought, given the complexities of IP litigation. How will you know what to ask next? The answer is that you just *will* (once you overcome the anxiety of not being able to question out of an outline)—just as you knew what to write down in the outline in the first place.

Besides losing the false security of an outline, the fears of working without a safety net include forgetting to ask something, asking questions in the wrong sequence, and not having impeachment material readily at hand. But a colleague at the counsel table can follow along in the outline, the examiner can practice the cross to get the sequences right, and a list of impeaching material can be loaded into a computer so that it's just a click away. Besides, the effect of overreliance on an outline is considerably worse than forgetting to ask a question or reversing a sequence.

Good cross-examination is an interrogation, not a presentation. Consider a

mom. She comes on the scene when one child is screaming and the other is sulking, and her task is to find out what happened, so she asks questions. She watches her children as they give answers, she tests the explanations, and she tests the commitment of each child to the answers given. Without any preparation or the benefit of discovery, she ferrets out the truth. You cannot conduct an interrogation from an outline.

Besides, you don't *have* to ask everything in an examination outline. Indeed, forcing a witness into a dramatic admission may make everything else moot.

### Contending with the Witness

Two of the most ingrained edicts of cross-examination are to never—*ever*—ask a question you don't know the answer to, and to never—*ever*—ask anything but a leading question.

What happens if the examiner follows that advice? Nothing. That's the problem. An uninspired presentation of disembodied

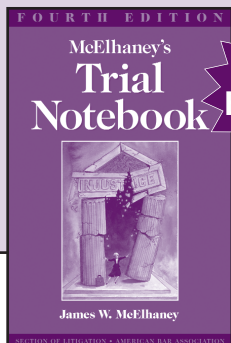
facts elicited on cross-examination from a witness defers joining the issue until closing argument. But argument of the client's case through examination must persist from opening statement through closing argument and every witness in between. The jury *expects* cross-examination to be a contest, and the testimony of the witness to be tested and challenged. If the examiner does not do so, the jury will tend to deem the witness credible—after all, what better proof of that is there than the failure of opposing counsel to challenge the witness on cross?

It is not enough to tie everything up in closing (except possibly in a criminal case), because the jury is “learning the tune” throughout the trial, forming impressions about what the truth is and who the credible witnesses are. If the examiner makes no concerted attempt to change these impressions during cross, how can those impressions be changed during closing argument?

There are some common situations where nonleading questions to which the answer is not known can yield big returns:

- Where the witness is obviously uncomfortable with his or her testimony, the truth may be lurking just beneath the surface, ready to burst forth like the cross-examination of Colonel Jessep in the final scenes of *A Few Good Men*. And there are other benefits. If the witness repeats the testimony in response to scornful questioning, in the same agonized (and obviously untruthful) manner, the jury will be focusing on the witness, not the words. And think of how much more memorable the event will be in closing argument when you remind the jury how the witness was so obviously dissembling.
- Where the answer is unexpected, and the implications will unravel the other side's case, it would be a shame not to explore that chain of implications with the witness. What can the witness do, realize what he has done and recant? That would be memorable grist for closing argument, too.
- When the witness admits that something shouldn't have been done, there is only upside to elaborating on that theme with questioning on such topics as what else shouldn't have been done, what are the implications of doing what shouldn't have been done, and so forth.
- When there is an odious or thoroughly discredited witness on the stand, you want to ask him more questions so that when he embraces the opponent's version of the account, that account will suffer by the association. In your closing argument that witness will become your standard-bearer for the opponent's case.
- When the witness is tied down to a fact that is favorable, it is a waste to bury it in a leading question. Instead, ask an open-ended question and have the *witness* state the favorable fact. (*Compare* the impact of asking the patentee, “Isn't it true that you didn't look at the patent application after the attorney prepared it?” “Yes.” *With*, “So what did you do with the application when you received it?” “Nothing. I didn't read it.”) And eliciting the

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testimony with an open-ended question may deliver unmatched opportunities for follow-up examination; for example, the witness in the foregoing example might have said, "Nothing. The president told me I didn't need to read it."

### Eliciting "Bad" Answers on Cross-Examination

The orthodoxy of cross-examination is to prevent answers that are adverse. Thus, litigators are taught to keep their questions short, to ask only leading questions, not to argue with the witness, and to prevent the witness from explaining, all to the end of keeping the witness on a short leash so that he or she can't give a "bad" answer. But this presupposes that the jury is taking in the evidence as if it were an indiscriminate receptacle into which words are poured, which is precisely why this advice is dead wrong. A jury does not consider evidence as if it was receiving a transcript.

If what the witness is saying is contrary to the common experience of the jury, the evidence will be rejected and the witness's testimony will be disregarded. Thus, a good example of eliciting "bad" answers to win cases is the time-honored tactic of giving a witness enough latitude to stroll happily over a cliff taking a proposition to an extreme. The examiner takes a witness's improbable "bad" answer, and then asks the witness to adopt succeeding more and more absurd elaborations of the bad answer until he has disgraced himself.

Witnesses will follow this path because they want to remain consistent with their preceding answer, because they can't reconcile a contrary answer with their preceding answer, because they are afraid of giving an answer that the examining attorney apparently wants, and because they are afraid the examiner will use a statement to the contrary to circle back and attack the original answer. By taking an extreme position with "bad" answers a witness so destroys his credibility that it doesn't matter what answers he gave.

The same is true of eliciting misleading "bad" answers that are demonstrably untrue. If it can be shown that an answer is false, is misleading, or is improbable, the witness is worse off for having given the "bad" answer.

Cross is not just or primarily about what the witness says. It is about how the witness looks when he testifies. It is about the manner in which the examiner puts questions to the witness. It is about the witness's refusal to accept perfectly reasonable propositions, or the witness's refusal to give a straight answer. It is about the contrary evidence presented to the witness that the witness refuses to acknowledge. It is about answers that are contrary to common sense. Sometimes the best examinations consist almost entirely of open-ended questions that an examiner doesn't know how the witness will answer, and doesn't care; the questions themselves serve as the first phase of closing argument, and the "bad" answers unclasp a "bad" witness. Since

the premise—avoiding "bad" answers at all costs—is wrong, the conventional advice to avoid "bad" answers at all costs is also wrong.

### Making the Call

In every case and at every moment of the trial, the safety of the conventional rules has to be evaluated against the opportunities lost by following them. Making the call can be made easier by evaluating the opportunity in discovery. Depositions aren't just for learning about the case; they are also for learning about the witness. Will the witness turn tail and run if challenged? Try it in deposition and find out. Can the witness be led to more and more absurd extremes? Lead in a deposition and see if the witness follows. (But don't give away your killer cross just for the security of knowing how the witness is going to respond to it; that would be telling.) And videotape the testimony of significant witnesses, not only for more effective impeachment but also to remind you *how* he or she answers. In this manner when you come to one of those critical decision points as to whether to exploit an opportunity by breaking the conventional rules, you will be ready.

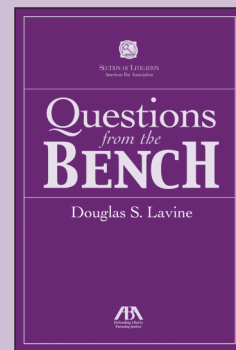
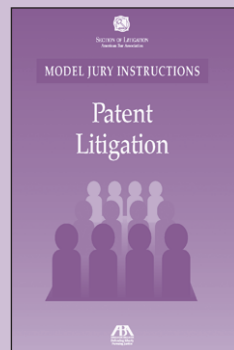
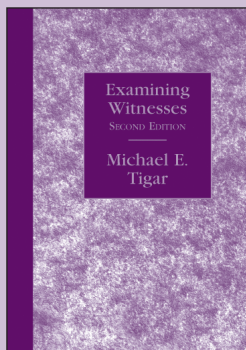
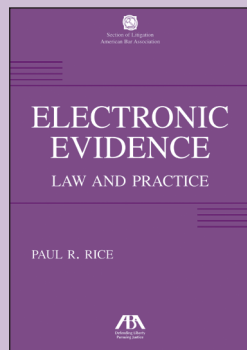
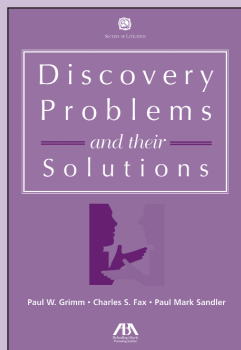
Beware the cost of convention; it comes at a high price. ●

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## The In-House Perspective on Jury Trials: Be Prepared to Tell Your Story

*Continued from cover*

on with in-house counsel. Since in-house counsel will know the client, and often the key witnesses, better than you, he or she can provide valuable advice on the efficacy of your themes and strategies. Most importantly, he or she can tell you what he or she does not like. Clearly, it is better to know that sooner rather than later.

Second, learn as much about your client's business as early as you can. Offer to visit the client's headquarters or manufacturing facility—on your own time—to understand how it operates and what is important. Doing so will not only demonstrate your commitment to the client, it will help you develop your client's story at trial. Corporations are so often viewed as nameless, faceless entities that are synonymous with greed. Understanding that your client's manufacturing facility is the largest employer in a rural area, or that the company was started in the CEO's garage with one big idea, may help to provide the backbone or background for your trial story.

Third, when economically feasible, test your trial story or a subset of your themes using jury research. Invite in-house counsel to attend the session. It is important for in-house counsel to have a firsthand understanding of the effectiveness of the trial story and, in particular, whether the participants express negative opinions of the client or the client's brand(s). When conducting jury research, make sure to give your client the most "bang for the buck." Schedule the research early enough in the litigation to be able to adjust your strategy if necessary. Make sure your opponent's position is presented in an effective manner. Otherwise, your results will not be an accurate gauge of the strengths and weaknesses of your trial story.

Fourth, revisit your trial story periodically throughout discovery. Identify the holes or gaps in your story while you still have the ability to fill them by disclosing or identifying new or additional witnesses. Use in-house counsel as an ongoing resource to assist with the process. Too often, those gaps are left until the eve of trial when it is too late to address them or

testimony is introduced through a witness who is not the best candidate to present such testimony.

The same logic applies to your expert witnesses. Think early in your case about topics on which expert testimony is needed, and start searching for your witnesses sooner rather than later. Allow enough time to review your expert's credentials, background, and, if applicable, past testimony thoroughly. Make sure that your expert's personality meshes with your overall trial story and themes and that you are confident he or she will represent the client's brand appropriately. Again, discuss with in-house counsel how you view your expert's role in your trial story.

Fifth, while it may seem like a simple proposition, make sure to communicate effectively with in-house counsel about the logistics of the trial. Where will it be held? What is the anticipated start date? Who must be there and for what duration? Who will be the company representative? It is important for in-house counsel to understand these issues early so that he or she can effectively communicate with the witnesses. With all of the substantive issues addressed during the life of the case, these little details can easily get lost in the shuffle.

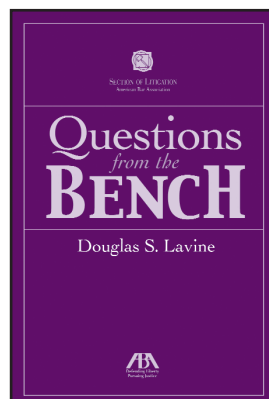
Sixth, 30 to 60 days from trial, if not already required by in-house counsel, be prepared to present a trial plan. Meet with in-house counsel to present your final trial plan and story after the dust from discovery has settled. Do so by discussing your story and the final themes of your case. Discuss the witnesses you will present and the specific areas of testimony that you expect each to present. To the extent that certain witnesses will need more preparation than others, bring that fact to in-house counsel's attention. Doing so will help further refine your story and themes and ensure that in-house counsel and your client fully understand the strengths and weaknesses of the case so they can make an informed decision about whether to settle if that possibility still exists.

In sum, remember that your client always has a story to tell at trial. Make sure that you plan your case and your trial strategy to account for and include that story. Partner with your in-house counsel to achieve that goal and, ultimately, you will get better results and have a happier client. ●

*Scott L. D'Angelo is counsel at McDonald's Corporation, located in Oakbrook, IL.*

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