THE THREE STAGES TO SUCCESSFUL APPELLATE ADVOCACY BEFORE THE FEDERAL CIRCUIT

CHARLES W. SHIFLEY

Abstract

To succeed at the CAFC, the advocate must succeed in three stages of appeal. The first stage of appeal is actually the stage of proceedings in the trial court. The trial court proceedings are the first stage of appeal because in the absence of correct advocacy in the trial court, there is no opportunity for appeal. The action in the trial court need not be the success of winning at trial. It must, however, at least be the success of preserving issues for appeal – preserving critical error that cannot be remedied at the trial level. In the second stage of appeal, the appeal must be successfully taken and briefed: clear, credible, powerful persuasion is essential. And in the third stage, the appeal must be sustained at oral argument in the face of the appellate judges' vigorous views and incisive questions. A combination of three successes that radiates its own strong energy offers the best prospect of reaching the advocate's goal at the Federal Circuit.

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THE THREE STAGES TO SUCCESSFUL APPELLATE ADVOCACY BEFORE THE FEDERAL CIRCUIT

CHARLES W. SHIFLEY*

The United States Court of Appeals for the Federal Circuit is a "hot" court. As said of all U.S. Courts of Appeals, "history, tradition and heavy responsibility all contribute to a massive discharge of psychic energy by the judges."[1] This is true of the Federal Circuit.[2] Federal Circuit judges study appellate positions thoroughly before making decisions, and they come to oral arguments with fully formed thoughts and incisive questions. The judges have pointedly strong opinions on many subjects of the law and express their views with vigor.

The advocate entering the Federal Circuit's field of psychic discharge in a patent case has a challenging task of persuasion. "Appellate advocacy [by itself] is specialized work."[3] Persuading the CAFC in a patent case is much more: doing the appellate advocate's specialized work in the specialized field of patent law before high-powered and specialized judges as against high-powered and specialized opponents, following specialized rules.

To succeed before the CAFC, the advocate must succeed in three stages of appeal. The first stage of appeal is actually the stage of proceedings in the trial court. The trial court proceedings are the first stage of appeal because in the absence of correct advocacy in the trial court, there is no opportunity for appeal. The action in the trial court need not be the success of winning at trial. It must, however, at least be the success of preserving issues for appeal—preserving critical error that cannot be remedied at the trial level. In the second stage of appeal, the appeal must be successfully taken and briefed: clear, credible, powerful persuasion is essential. And in the third stage, the appeal must be sustained at oral argument in the face of the appellate judges' vigorous views and incisive questions. A combination of three successes that radiates its own strong energy offers the best prospect of reaching the advocate's goal at the Federal Circuit.

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* Charles W. Shifley is a practicing patent litigation lawyer at Banner & Witcoff, Ltd. in Chicago. He is also an Adjunct Professor at The John Marshall Law School. Along with Federal Circuit Judge Paul Michel and other lawyers, he teaches Master Classes on appellate practices. He can be reached at cshifley@bannerwitcoff.com. This article expresses the views of the author alone.

[1] RUGGERO J. ALDISERT, WINNING ON APPEAL: BETTER BRIEFS AND ORAL ADVOCACY 297 (1996).

[2] The abbreviation "CAFC" is sometimes used for the Federal Circuit.

[3] ALDISERT, *supra* note 1, at 3.

I. THE FIRST STAGE: TO SUCCEED IN APPEAL, THE ADVOCATE MUST ACT WELL BEFORE APPEAL

For there to be success on appeal, the advocate must first protect the case for appeal in the trial court. Initially, the trial court record must be protected. "It is trial counsel's duty to perfect the record in the trial court."[4]

To protect the record, the advocate must act in specific ways. Importantly, he must stand his ground when he is right. Some district court judges are known for their capacity to get lawyers to go along quietly with court actions. These judges create case records free of any indication of lawyer disagreement. Some bully: they express themselves as if lawyers have no say in the decisions the judges are making. Others ridicule: they badger lawyers into silence and stipulations. Still others persuade, often by befriending. Some do all three, and more. A first rule of effective appellate advocacy is to have strength in the trial court: the strength to take positions and maintain them, even when the trial judge is acting so as to avoid preservation of error.

Second, to appeal later, lawyers must object in the moment. Any conduct that is not opposed in the trial court cannot be corrected on appeal. "[A] party cannot raise on appeal legal issues not raised and considered in the trial forum."[5] Raising an issue in the trial forum frequently means objecting immediately, not later, not overnight.[6] In the absence of objection in the necessary moment, most objections are lost.

Third, lawyers must sometimes force formality. Rulings must sometimes be forced into existence. Rulings also sometimes must be forced onto records. Testimony must be on the record. As well, prejudicial judicial remarks must be kept on the record, as against the relaxed reporting that sometimes occurs in some courts. Formal procedures simply must be caused where necessary to preserve records and prejudicial error.

Fourth, lawyers must be thoroughly thoughtful and consistent with permanent interests: judicial estoppel and invited error must be avoided. Some lawyers appear to believe that positions can be taken and reversed at will.[7] Positions are not so malleable, assuming alert opposing counsel. Lawyers who take positions, get their positions adopted by courts and quasi-judicial agencies, and then seek to reverse positions, can expect to be blocked by the doctrine of judicial estoppel.[8] Error also

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[4] James F. Hewitt, *Preserving and Assembling the Record for Appeal: Getting Through the Mine Field*, *in* AMERICAN BAR ASS'N, APPELLATE PRACTICE MANUAL 6 (Priscilla Anne Schwab ed., 1992).

[5] Finch v. Hughes Aircraft Co., 926 F.2d 1574, 1575 (Fed. Cir. 1991) (dismissing the complaint without opposition affirmed).

[6] *See, e.g.,* Cardiac Pacemakers, Inc. v. St. Jude Med., Inc., No. IP-96-1718, 2002 WL 392499, at *78 (S.D. Ind. Feb. 13, 2002) (reversing $140 million verdict and denying new trial motion as to remarks in opening statement).

[7] *See id.* at *70 ("The court has never before seen a party who elicited testimony over an objection . . . then move for a mistrial based on that testimony.").

[8] *See* Yniquez v. Arizona, 939 F.2d 727, 738-39 (9th Cir. 1991) (applying the doctrine of judicial estoppel to prohibit a litigant from asserting on appeal a contrary position on a legal issue after having persuaded the trial court to adopt its prior position on the issue). "[T]he doctrine of judicial estoppel . . . is invoked to prevent a party from changing its position over the course of judicial

cannot be invited. The court cannot be induced into action which is later claimed as error. "The invited error doctrine prevents a party from inducing action by a court and later seeking reversal on the ground that the requested action was error."[9] Specific trial court situations also merit specific attention.

A. In Summary Judgment Proceedings, the Advocate Must Preserve the Case Against Summary Judgment

Many patent cases are lost at summary judgment, and the appeals from the judgments become affirmances. To defeat the adverse summary judgment motion, or at least have potential on appeal, the advocate must prove judgment does not follow from the facts that are undisputed, or prove an issue of material fact.[10]

If the lawyer wants more discovery in opposition to a summary judgment motion, or to appeal on the point that more discovery was needed and denied, the lawyer must prove the need by the standard of the regional circuit. For example, in the trial courts of the First Circuit, the lawyer must prove "an authentic need for, and an entitlement to, an additional interval in which to marshal facts essential to mount an opposition."[11] The lawyer must "(i) make an authoritative and timely proffer, (ii) show good cause for the failure to have discovered these essential facts sooner, (iii) present a plausible basis for the belief that there are discoverable facts sufficient to raise a genuine and material issue, and (iv) show that the facts are discoverable within a reasonable amount of time."[12] These rules vary by regional circuit, and the lawyer must satisfy the regional rule.

B. In Any Issue of Referral to a Magistrate Judge or Master, the Lawyer Must Preserve the Objection to Referral

Some appeals complain of referrals to magistrate judges and masters. The rule is that both nondispositive and dispositive issues may be referred to magistrate judges without consent, and all issues may be referred with consent.[13] A master may also be ordered to prepare a report with or without consent.[14] "Consent" may take the form of untimely objection. That is, untimely objection may work as a waiver.[15] Thus, to save an issue of referral for appeal, any objection must be timely.

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proceedings when such changes have an adverse impact on the judicial process." *Id.* (citations omitted).

[9] United States v. Edward J., 224 F.3d 1216, 1222 (10th Cir. 2000); *see also Cardiac Pacemakers,* 2002 WL 392499, at *70.

[10] Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc., 200 F.3d 795, 812 (Fed. Cir. 1999).

[11] Morrissey v. Boston Five Cents Sav. Bank, 54 F.3d 27, 35 (1st Cir. 1995) (quoting Resolution Trust Corp. v. N. Bridge Assocs., Inc., 22 F.3d 1198, 1203 (1st Cir. 1994)).

[12] *Id., quoted in Vivid Techs.*, 200 F.3d at 809.

[13] FED. R. CIV. P. 72-73.

[14] FED. R. CIV. P. 53.

[15] Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1566 (Fed. Cir. 1988) ("A party cannot wait to see whether he likes a master's findings before challenging the use of the master. Failure to object in a timely fashion constitutes a waiver.").

C. At Trial, the Lawyer Must Preserve the Case Against Adverse Judgment

An appeal that a patent case was tried without a jury may be a fruitless appeal. A lawyer may inadvertently waive the right to a jury. Local rules may cause a trap. Where a jury is desired, the lawyer must preserve that right in district court proceedings.[16]

At trial, and on matters of evidence, to have prospect for appeal, the trial lawyer must preserve objections to exclusion of evidence. The lawyer must make an offer of proof.[17] The offer must be a proper offer of proof: it must offer admissible evidence.[18] Appeal of the exclusion of evidence without an offer of proof is pointless.

Objections to objectionable jury instructions must be preserved. To accomplish this, the lawyer must first object.[19] Curative instructions must also be offered.[20]

Issues of inconsistencies in jury verdicts must be preserved. Where necessary, dependent on regional rules, objections must come before the jury is discharged. An advocate may find he or she cannot argue verdict inconsistency on appeal if he or she failed to object in a narrow window of time: for example, "after the verdict was read and before the jury was discharged."[21] This may be a time period of minutes.

The right to judgment "notwithstanding the verdict" (JMOL) must be preserved. The lawyer must make a timely and proper motion. It must be made at the close of the evidence.[22] The absence of a motion prevents JMOL.[23] A late motion is the same as no motion.[24] A motion without an issue is also the same as no motion as to that issue.[25] The frequency of mistakes in JMOL practice is surprising, even among prominent counsel.

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[16] As an example, the right to a jury was waived in *Transmatic Inc. v. Gulton Industries Inc.*, 53 F.3d 1270 (Fed. Cir. 1995), where a local rule was not followed to object to an order for a bench trial.

[17] 1 WIGMORE ON EVIDENCE § 20a, at 864 (Tillers rev. 1983) ("An offer of proof . . . is required because an appellate court needs an adequate basis for determining whether a trial court's error regarding an evidentiary matter is prejudicial or merely harmless . . . . The offer of proof places the excluded evidence on the record so that the appellate court can determine whether the improper exclusion of evidence at trial warrants reversal.").

[18] Shapiro, Bernstein & Co. Inc. v. Club Lorelei Inc., 35 U.S.P.Q.2d (BNA) 1852, 1854 (W.D.N.Y. 1995) (attorney affidavit not evidence).

[19] FED. R. CIV. P. 51 ("No party may assign as error the giving or the failure to give an instruction unless that party objects thereto before the jury retires to consider its verdict. . . .").

[20] Biodex Corp. v. Loredan Biomedical, Inc., 946 F.2d 850, 862 (Fed. Cir. 1991) ("In order to prevail on the jury instruction issue in this case, Biodex must demonstrate both that the jury instructions actually given were fatally flawed and that the requested instruction was proper and could have corrected the flaw.").

[21] McIsaac v. Didrikson Fishing Corp., 809 F.2d 129, 134 (1st Cir. 1987), *quoted in* Coastal Fuels of P.R., Inc. v. Caribbean Petroleum Corp., 79 F.3d 182, 201 (1st Cir. 1996).

[22] FED. R. CIV. P. 50(a)(2).

[23] *Biodex Corp.*, 946 F.2d at 854 ("[T]he only available remedy upon finding error in a judgment entered on a jury verdict where there has been no motion for JNOV is . . . a remand for a new trial.").

[24] Browder v. Director, Dep't of Corr., 434 U.S. 257, 264-65 (1977).

[25] Foster-Miller, Inc. v. Babcock & Wilcox Can., 210 F.3d 1, 8 (1st Cir. 2000).

D. Post Trial: The Lawyer Must Preserve the Right to JMOL and New Trial

After moving for a JMOL at the close of the evidence, the lawyer must renew the JMOL motion no later than ten days after entry of judgment.[26] Any motion for new trial must be made in the same time period.[27] As with JMOL, the absence of a motion or the absence of an issue is fatal.

E. Before Moving to the Second Stage: The Advocate Must Take a Timely and Proper Appeal

In handling any notice of appeal, whether the first notice in the case, or a later one, the advocate-appellant must be timely. A notice of appeal must be filed "within 30 days after the judgment or order appealed from is entered."[28] The "30-day time limit is 'mandatory and jurisdictional.'"[29] The point bears repeating: filing of the notice of appeal must occur within thirty days of entry of judgment, and the time period is jurisdictional. There are exceptions for late notices, but they are limited.[30] Late and unexcused notice constitutes no notice: there is no jurisdiction in the CAFC.

Any cross appeal must also be timely. The lawyer must file any cross appeal within fourteen days after the filing of the first notice of appeal, or the remaining time of the thirty days from judgment, whichever is longer.[31] Both the motions from the appellant and cross-appellant indeed may be early. An appeal is effective if filed after judgment is entered but before any motion described in Federal Rule of Civil Procedure 4(a)(4)(A) is disposed.[32] An appeal filed after announcement of decision, even if before judgment, is also effective.[33]

The notice of appeal must also be in the right form and should be in the right court. It must specify the parties appealing.[34] It must designate the judgment(s) or order(s) appealed.[35] It must name the Federal Circuit.[36] Most importantly, the notice should be in the right court: "[a]n appeal . . . may be taken only by filing . . . with the district clerk. . . ."[37]

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[26] FED. R. CIV. P. 50(b).

[27] Arachnid, Inc. v. Medalist Mktg. Corp., 972 F.2d 1300 (Fed. Cir. 1992) (waiving an issue not in post trial motions).

[28] FED. R. APP. P. 4(a)(1)(A).

[29] *Browder*, 434 U.S. at 264 (citation omitted).

[30] FED. R. APP. P. 4(a)(5)-(6).

[31] FED. R. APP. P. 4(a)(3); *see* Bradley C. Wright, *Ten Mistakes to Avoid at the Federal Circuit*, 17 INTELL. PROP. L. NEWSL. 3, 6 (1999) (commenting that a lawyer cannot cross appeal any judgment on a claim that she won in district court due to lack of standing).

[32] FED. R. APP. P. 4(a)(4)(B)(i).

[33] FED. R. APP. P. 4(a)(2).

[34] FED. R. APP. P. 3(c)(1)(A).

[35] FED. R. APP. P. 3(c)(1)(B).

[36] FED. R. APP. P. 3(c)(1).

[37] FED. R. APP. P. 3(a)(1); *see also* FED. R. APP. P. 4(d) (allowing a mistaken filing in the CAFC to be corrected by the clerk).

The advocate must assure jurisdiction. Final judgments are usually appealable.[38] Grants and denials of preliminary injunctions are appealable.[39] Appeals of partial judgments are primarily only by certification from the district courts.[40] The appeal must have a non-frivolous issue.[41]

Finally, before appeal, the advocate must learn the rules of the particular court and learn about the Federal Circuit. The rules to be learned include the Federal Circuit's rules, with its practice notes. "[The Federal Circuit] Rules . . . are distributed to members of the bar upon their admission to practice before this court and to counsel for both parties whenever an appeal is filed. . . ."[42] The advocate must also develop a familiarity with the court.[43]

A most important example of knowing the court is knowing the court's chronological approach to its own precedent. Later decisions (of three-judge panels) are not superior to earlier decisions (of three-judge panels); they are *inferior*. The court follows its precedential panel decisions in chronological order: first decisions are superior to later decisions.[44]

II. THE SECOND STAGE: A CLEAR, CREDIBLE, AND POWERFULLY PERSUASIVE BRIEF

A. Once Appeal Is Underway, the Advocate Must Act Swiftly at the Briefing Stage

Federal Circuit appeals move swiftly. The advocate in the role of appellant must plan that she has only about sixty days from taking the appeal to file the appellant's first and essentially only brief. The appellant must serve and file the initial brief within sixty days after Federal Circuit docketing.[45] Docketing occurs promptly after notice of appeal is filed. The appellee must plan for forty days: a cross-appellant has forty days from service of appellant's brief to file the appellee's brief.[46]

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[38] 28 U.S.C. § 1291 (2000); s*ee also* Coopers & Lybrand v. Livesay, 437 U.S. 463, 467 (1978) (noting that "a decision by the District Court that 'ends the litigation on the merits and leaves nothing for the court to do but execute the judgment'" is a prerequisite for federal appellate jurisdiction (citation omitted)).

[39] 28 U.S.C. § 1292(a)(1) (2000).

[40] FED. R. CIV. P. 54(b).

[41] State Indus., Inc. v. Mor-Flo Indus., 948 F.2d 1573, 1578 (Fed. Cir. 1991) (commenting that appellants who file a frivolous appeal risk sanctions).

[42] *Id.* at 1580 n.7 (criticizing counsel's failure to follow the Practice Note to Federal Rule of Appellate Procedure 38).

[43] Wright, *supra* note 31, at 8 (noting that the failure to know the court personnel and procedures often leads to embarrassing situations).

[44] *See* Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563 (Fed. Cir. 1991) ("[W]e note that decisions of a three-judge panel of this court cannot overturn prior precedential decisions."); Kimberly-Clark Corp. v. Ft. Howard Paper Co., 772 F.2d 860, 863 (Fed. Cir. 1985) ("Counsel is apparently unaware that a panel of this court is bound by prior precedential decisions unless and until overturned en banc."); *see also* Yunus v. Dept. of Veterans Affairs, 242 F.3d 1367, 1372 n.1 (Fed. Cir. 2001) (citing *Newell Companies v. Kenney Manufacturing Co.*, 864 F.2d 757, 765 (Fed. Cir. 1988), for the proposition that upon direct conflict between Federal Circuit decisions, "the precedential decision is the first").

[45] FED. CIR. R. 31(a)(1)(A).

[46] FED. CIR. R. 31(a)(2).

B. The Brief: Clear and Concise

In the sixty days for appellant's principal brief, the advocate has much to do. A brief must be written. But first, the appellant must marshal all the arguments. The appellant must thoroughly, creatively comb the record for issues. Arguments not made in the opening brief are waived; they cannot be added to the reply brief.[47] Unless there is a remand, all issues within the scope of the appealed judgment are deemed incorporated within the mandate and thus are precluded from further adjudication.[48] Thus, unless the brief due in sixty days preserves arguments, they are lost to any further contention. The record must also be checked against memories. Beliefs formed from the record alone may be wrong.[49]

1. The Appellant Must Know and Understand the Standards of Review

After cataloging the issues, the advocate must filter the issues through the standards of review. The proper standards must be applied to the issues that have been cataloged. No appeal will have success unless the standard(s) of review is (are) identified and appreciated. "Standards of review . . . influence the disposition of appeals far more than many advocates realize."[50] There are five standards: *de novo*; clear error; substantial evidence; abuse of discretion; and arbitrary and capricious.[51] Examples of issues and the applicable standards follow.

- Statutory interpretation—reviewed *de novo*.[52]
- Claim interpretation—reviewed *de novo*.[53]
- Contract interpretation—reviewed *de novo*.[54]
- Pretrial stipulation interpretation—reviewed *de novo*.[55]
- Grant of summary judgment—reviewed *de novo*.[56]
- Denial of a motion for JMOL—reviewed *de novo*.[57]
- Whether an invention was on sale—a question of law reviewed without deference.[58]

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[47] Becton Dickinson & Co. v. C.R. Bard Inc., 922 F.2d 792, 795 (Fed. Cir. 1990); *see also* Wright, *supra* note 31, at 4 (commenting that raising new issues late is a surprisingly frequent mistake).

[48] Engel Indus., Inc. v. Lockformer Co., 166 F.3d 1379, 1383 (Fed. Cir. 1999).

[49] *E.g.*, Lummus Indus., Inc. v. D.M. & E. Corp., 862 F.2d 267, 270 (Fed. Cir. 1988) (accepting position of timely jury instructions off the record).

[50] Paul R. Michel, *Appellate Advocacy—One Judge's Point of View*, 1 FED. CIR. B.J. 1, 2 (1991).

[51] DONALD R. DUNNER & RICHARD L. RAINEY, *Appeals to the Federal Circuit*, *in* PATENT LITIGATION STRATEGIES HANDBOOK 556 (Barry L. Grossman & Gary M. Hoffman eds., 2000).

[52] Hodges v. Sec'y of the Dep't of Health & Human Servs., 9 F.3d 958, 960 (Fed. Cir. 1993).

[53] Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1456 (Fed. Cir. 1998) (en banc).

[54] Ethicon, Inc. v. U.S. Surgical Corp., 135 F.3d 1456, 1466 (Fed. Cir. 1998).

[55] *See* Intel Corp. v. ULSI Sys. Technology, Inc., 995 F.2d 1566, 1569 (Fed. Cir. 1993).

[56] Augustine Med., Inc. v. Progressive Dynamics, Inc., 194 F.3d 1367, 1370 (Fed. Cir. 1999).

[57] *See, e.g.*, Odetics, Inc. v. Storage Tech. Corp., 185 F.3d 1259, 1266 (Fed. Cir. 1999).

- The ultimate determination of whether an invention would have been obvious—a legal conclusion reviewed without deference.[59]
- Factual findings in bench trials—reviewed for clear error.[60]
  - As to infringement.[61]
  - As to validity.[62]
  - As to inequitable conduct.[63]
  - As to the exceptional nature of a case.[64]
  - In all issues with factual components.[65]
- Jury fact-finding—reviewed for substantial evidence.[66]
- PTO fact-finding—reviewed for substantial evidence.[67]
- Grant or denial of preliminary injunction—within sound discretion.[68]
- Exclusion of evidence—reviewed for abuse of discretion.[69]
- Denial of a motion for new trial—reviewed for abuse of discretion.[70]

The lawyer must next apply "the standard within the standard" to get a better appreciation of the standard for the specific issue under consideration for appeal. The "standard within the standard" may significantly improve the prospect for appeal on the subject issue, or significantly diminish that prospect. For example, summary judgment is reviewed *de novo*, but a conclusion of laches, even by summary judgment, is reviewed for abuse of discretion.[71] An appeal over a summary judgment of laches is less desirable than might have been thought. Other examples follow.

- Review of denial of a motion for JMOL is *de novo*, but the review is in part to decide whether substantial evidence supports the verdict.[72] If

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[58] Robotic Vision Sys., Inc. v. View Eng'g, Inc., 249 F.3d 1307, 1310 (Fed. Cir. 2001).

[59] Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 229 F.3d 1120, 1124 (Fed. Cir. 2000).

[60] FED. R. CIV. P. 52(a); *see* Winner Int'l Royalty Corp. v. Wang, 202 F.3d 1340, 1348 (Fed. Cir. 2000).

[61] *See* Insituform Techs., Inc. v. Cat Contracting, Inc., 161 F.3d 688, 692 (Fed. Cir. 1998).

[62] *E.g.*, B.F. Goodrich Co. v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582 (Fed. Cir. 1996).

[63] *See* Molins PLC v. Textron, Inc., 48 F.3d 1172, 1178 (Fed. Cir. 1995).

[64] *E.g.*, Enzo Biochem, Inc. v. Calgene, Inc., 188 F.3d 1362, 1380 (Fed. Cir. 1999).

[65] FED. R. CIV. P. 52.

[66] Kearns v. Chrysler Corp., 32 F.3d 1541, 1547-48 (Fed. Cir. 1994).

[67] Dickinson v. Zurko, 527 U.S. 150, 164-65 (1999); *see also In re* Gartside, 203 F.3d 1305, 1315 (Fed. Cir. 2000).

[68] Purdue Pharma L.P. v. Boehringer Ingelheim GMBH, 237 F.3d 1359, 1363 (Fed. Cir. 2001).

[69] ATD Corp. v. Lydall, Inc., 159 F.3d 534, 548 (Fed. Cir. 1998) ("The abuse of discretion standard is applied to review of evidentiary rulings . . . generally in the federal system."); Schrand v. Fed. Pac. Elec. Co., 851 F.2d 152, 156-57 (6th Cir. 1988).

[70] Railroad Dynamics, Inc. v. A. Stucki Co., 727 F.2d 1506, 1512 (Fed. Cir. 1984).

[71] A.C. Aukerman Co. v. R.L. Chaides Constr. Co., 960 F.2d 1020, 1039 (Fed. Cir. 1992) (en banc).

[72] Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 893 (Fed. Cir. 1984).

the issue is the sufficiency of the evidence, the appeal may be less desirable than first considered.

- A decision of obviousness is reviewed as a matter of law, but any underlying judicial factual finding is reviewed for clear error.[73] Appeal may be less desirable if the issue is couched as error of fact.
- Discretion is reviewed for abuse, but abuse occurs where a decision is based on an erroneous interpretation of law or clearly erroneous fact-finding, or if the "decision represents an unreasonable judgment in weighing relevant factors."[74] An appeal from a discretionary decision is potentially more profitable where the appeal is that the district court erroneously interpreted the law, leading to the abuse, or erred in fact-finding. These are better situations than where the attack is simply on the judge's truly discretionary weighing of relevant factors.

The standards of review themselves must also be appreciated. Their definitions must be taken in. As an example, "substantial evidence" is not just "a lot of" evidence. It is evidence from which a reasonable jury could have found in favor of the prevailing party.[75] As another example, "clear error" is present only when "the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed."[76]

2. Trimming the Fat

Having cataloged the issues and considered them in the context of the standards of review, the advocate must then "lose" most of them. They must be lost in two senses of the word: appeal must be lost on them because they are abandoned, and they must be lost in the casual sense of dropping them.

Issues must be lost because they must be stripped, mercilessly. In contrast to the many available issues, one, two or three issues must be identified that will be the only issues pursued on appeal. All other issues must be dumped. The word "dumped" is not wrong in its color. Good issues must be abandoned, like dearly beloved children left at convent doorsteps. Love for them is immaterial; they must go.

The reason is the suspicion generated by appeals that raise many issues. The advocate must plan to appeal with no more than one to three issues. "A brief presenting more than two or three issues may be viewed with suspicion."[77] Appellate judges have such suspicion of multiple issues that a "litmus" test of issues exists:

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[73] Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 229 F.3d 1120, 1124 (Fed. Cir. 2000).

[74] *A.C. Aukerman Co.*, 960 F.2d at 1038.

[75] *See* Tec Air, Inc. v. Denso Mfg., 192 F.3d 1353, 1357 (Fed. Cir. 1999).

[76] United States v. United States Gypsum Co., 333 U.S. 364, 395 (1948).

[77] Michel, *supra* note 50, at 8; *see also* Wright, *supra* note 31, at 18 (noting that an advocate may lose credibility with the court for including both frivolous arguments with meritorious ones in her brief).

Number of Issues	Judge's Reaction
Three	Presumably arguable points.
Four	Probably arguable points.
Five	Perhaps arguable points.
Six	Probably no arguable points.[78]

The Federal Circuit has strongly stated its own view: that "appellants serve their interests best by focusing their appeals only on their most meritorious arguments rather than raising all of the issues on which they disagree with the district court . . . for which they can proffer only weak arguments and for which there is a very deferential standard of review."[79]

Of course, the advocate should immediately strip any issue that is frivolous. "Prospective appellants . . . must assure themselves that they can make a nonfrivolous argument for reversal before filing an appeal."[80] The advocate should also strip anything harmless—in the nature of harmless error.[81] She should strip issues based on adverse standards of review.[82] That is, the advocate should favor issues with low standards, and drop issues where they have high standards of review. Consider this pithy advice: "One who blindly challenges on appeal the exercise of discretion might do better to take a leisurely stroll through an uncharted minefield."[83]

Issues should be stripped if the advocate cannot phrase a reasoned and persuasive analysis of why a claimed error was actually an error. "We certainly will not reverse based merely on attorney assertion that the finding or ruling was 'clearly erroneous.' We need a reasoned and persuasive analysis of why."[84] Advocates should strip issues because their arguments do not convince themselves. Nagging doubt that an issue has merit should be reason to eliminate an issue. And the advocate should strip issues by vetting them. Issues should be vetted with former Federal Circuit clerks, senior lawyers and associates, and friends and family. Instead of preparing an appeal in an ivory tower, the advocate should prepare the appeal in a public bazaar. To be casual: If they won't buy it, you can't sell it, and you probably should stop trying, especially if you can't sell it after several rephrasings of it.

Finally, when four and more solid issues remain, the advocate must simply make hard choices from among them. A plain fact of lawyering is that lawyering involves choosing. A wise advocate states this fact as a maxim of the advocate's reality: "To litigate . . . is to choose."[85] Litigating is most definitely about choosing, and choosing is about abandoning arguments and positions in favor of others. "Good

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[78] ALDISERT, *supra* note 1, at 120.

[79] Univ. of W. Va. Bd. of Trs. v. Vanvoorhies, 278 F.3d 1288, 1305 (Fed. Cir. 2002).

[80] State Indus., Inc. v. Mor-Flo Indus., 948 F.2d 1573, 1578 n.3 (Fed. Cir. 1991).

[81] FED. R. CIV. P. 61.

[82] Wright, *supra* note 31, at 4 (commenting on the failure to appreciate the standard of review).

[83] ALDISERT, *supra* note 1, at 66. *But see supra* Part II.B.1 (discussing the concept of the "standard within the standard").

[84] Michel, *supra* note 50, at 3.

[85] Joseph Miller, Sidley & Austin, Lecture on Patent Trial Advocacy, Chicago-Kent College of Law (August 1998).

lawyers are selective. Great lawyers sniff out decisive issues as relentlessly as a dog its bone."[86] On appeal, issues must be chosen, and some must simply be "lost."

3. Structuring the Brief

The advocate must then plan the opening brief to gain immediate attention. The brief must lead from strength—it must lead from the strongest issue. It also must express a compelling argument, and one that meets and exceeds the standard of review. Judge Michel of the Federal Circuit puts the matter succinctly: "[W]hat . . . should [advocates] do? Only two things: (1) describe the 'marriage' of the few facts and the few authorities that compel your result; and (2) demonstrate how they meet . . . the applicable standard of review."[87] In the same vein, Judge Aldisert, Senior Third Circuit Judge, proposes a constantly self-imposed question: "As you write, prop a sign, literally or figuratively, on your desk that asks, 'Will this brief persuade the reader?'"[88] And one important way for a brief to gain attention is to express an issue calling for a precedential opinion, and perhaps an issue of first impression for the court.

Most important is that the brief express a message the reader will understand—a message that is simple and clear. The brief must be structured within the framework of the judges' knowledge, beliefs and attitudes. It cannot come from left field. If the advocate has never seen his interpretation of a precedent expressed anywhere, the advocate should consider if perhaps his interpretation is not the correct interpretation, rather than that every following court and commentator has failed to understand the case. "The best techniques and theories tend to be those that mesh with the judges' own decision-making process."[89]

4. Strip Content

Having stripped issues mercilessly and written a brief, the advocate must now strip content mercilessly. Again, obviously, content should be stripped for frivolousness.

> Our court recently catalogued some of the types of appellate litigation misconduct which are considered sanctionable. Sanctionable misconduct has been held to include (though is by no means limited to): seeking to relitigate issues already finally adjudicated; failing to explain how the trial court erred or to present clear or cogent arguments for reversal; rearguing frivolous positions for which sanctions had already been imposed in the trial forum; failing to cite authority and ignoring opponent's cited authority; citation of irrelevant or inapplicable authority; distorting cited

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[86] HENRY G. MILLER, ON TRIAL: LESSONS FROM A LIFETIME IN THE COURTROOM 25 (2001).
[87] Michel, *supra* note 50, at 10.
[88] ALDISERT, *supra* note 1, at 17.
[89] Michel, *supra* note 50, at 2.

> authority by omitting language quotations; making irrelevant and illogical arguments; misrepresenting facts or law to the court.[90]

All content with these problems should be stripped. As with the issues, content should be stripped by vetting the content.

Content should also be stripped for better tone: "A persuasive brief reads like a judicial opinion: unbiased, not argumentative; neutral, yet forceful. . . . There is no need to use up the entire page limit when filing a brief."[91]

And again, content should be stripped by making choices. "The worst problem facing advocates is that they know too much. . . . The first principle of effective advocacy therefore lies in selectivity."[92]

4. Formalities

The brief must finally be filed on time in proper form. Preferentially, words should be counted, not pages, and the brief should be formatted accordingly.[93] It should have all necessary sections—and not necessarily stop there. It should have an argument, a summary of argument, a statement of issues, a statement of the case, a statement of facts, a jurisdictional statement, etc.[94] The advocate should also then consider adding a "preliminary statement," used to excellent effect in some advocates' briefs.

Fine details of excellence help. The brief should use pinpoint citations to the record. Citations to masses of pages should be edited; the judges and clerks should not be forced to hunt for cited points.[95]

The brief should load up on graphics. Graphics can and perhaps should accompany related text, as in CAFC opinions. With a brief filed based on a word count, page length is not an issue. Whole pages can be added for full-page graphics. The use of separate, whole pages may helpfully minimize the brief's electronic file size, to minimize current problems with some computers in handling large electronic files.[96]

Every brief should also employ wise suggestions. It should:

- Have "an ample number of meaningful headings";[97]
- Use a glossary;[98]

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[90] State Indus., Inc. v. Mor-Flo Indus., 948 F.2d 1573, 1579 n.4 (Fed. Cir. 1991) (citations omitted).

[91] Wright, *supra* note 31, at 8.

[92] Michel, *supra* note 50, at 1.

[93] FED. R. APP. P. 32(a)(7)(B).

[94] FED. R. APP. P. 28; FED. CIR. R. 28.

[95] Wright, *supra* note 31, at 5 (noting that an attorney's failure to use pinpoint citations frustrates judges and leads to a diminishment of the attorney's credibility).

[96] *See* FED. R. APP. P. 32(a)(7)(b) (suggesting that there is no page limit with a proper word count).

[97] 1 DONALD R. DUNNER ET AL., COURT OF APPEALS FOR THE FEDERAL CIRCUIT: PRACTICE & PROCEDURE §4.02, at 4-71 (Charles Marro et al. eds., 2000).

[98] *Id.*

- Perhaps have fold-out charts and colored drawings;[99]
- Use claim charts;[100]
- Type important handwritten material from the record;[101]
- Reduce issues to the level of lay comprehension;[102]
- Avoid undue length;[103]
- Discuss all issues;[104]
- Avoid the "ingenious";[105]
- Avoid personal attacks on opposing counsel;[106]
- Cite no non-precedential decisions;[107] and
- NEVER personally criticize the district court.[108]

And the brief should avoid common criticisms:

- Too long;
- Too many issues;
- Too many facts and legal points;
- Lack central theme;
- Lack organization;
- Fail to engage; and
- Misrepresent facts and holdings.

Once the appellant has filed the first brief and received the second, the appellant must also write a persuasive reply. Briefly, and importantly, the reply should engage the second brief, and introduce no new issues.

III. THIRD STAGE: THE ADVOCATE MUST PREPARE WELL FOR ORAL ARGUMENT

Oral argument at the Federal Circuit is the "lightning round"—typically fifteen minutes per side.[109] Some lawyers consider this time period to be too brief to be useful. That is the wrong thinking. The advocate has a fantastic opportunity at oral

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[99] *Id.* at 4-75.
[100] *Id.*
[101] *Id.* at 4-77.
[102] *Id.* at 4-81.
[103] *Id.*
[104] *Id.*
[105] *Id.* at 4-83
[106] *Id.*
[107] *Id.* at 4-84.
[108] *Id.*
[109] FED. CIR. R. 34 practice notes.

argument. The advocate should come to oral argument considering the argument session as if it were the first half of a conference of the court's panel of judges, assuming a panel is prepared to decide the case, with the advocate as a colleague on the panel.[110]

Given the importance of the argument, and the typical pre-argument preparation of the judges, the advocate should come to the argument with mastery. He should master the facts. "Know the record. Be prepared to refer to appendix citations."[111] He should master the procedure, following Federal Circuit Rule 34, the associated Practice Note, and the court's Information Sheet, Notice to Counsel on Oral Argument, and Notice Regarding Courtroom Decorum. He should master the law. Judge Michel puts this most memorably: "names and numbers, citations and quotations."[112] This means the lawyer should come to the oral argument with specifics: with the names and numbers of the cases and record evidence which control the case. The advocate should be prepared to cite the cases and quote the record. The advocate should in a sense be transparent. He should be channeling the cases and the record: they should be speaking through him.

For best effect, the advocate should definitely practice. She should "mock it up" by having moot court arguments. Again Judge Michel is eloquent: "Rarely does success depend on the 'speech' that you work so hard to prepare. It lies instead in anticipating the inevitable, skeptical questions, and preparing answers in advance. Testing them is crucial. One good way to test them out is to conduct a moot court."[113] Good lawyers know this need, and choose to moot court their arguments: "I favor using a moot court."[114]

A. Making the Argument: Immediately Get to the Heart of the Case

As with the brief, the argument should lead from strength. The advocate should skip his name, his partner's name, and his client's name. The court knows these. As well, the advocate should skip the facts.[115] Skip the visual aids, too.[116] The advocate should get to the heart of the case in the first sentences. "Make your first sentence *count* by getting to the heart of your case."[117] "Get to the essence of the case and your position as quickly as possible."[118]

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[110] Court of Appeals for the Federal Circuit, Internal Operating Procedures, no. 3 para. 2., no. 8 para. 1; Mark T. Banner, Appeal: Winning on Infringement at the Federal Circuit 16 (1999) (on file with author). "Oral argument . . . in a very real sense, . . . is the start of the conference at which the case is decided." Banner, *supra*, at 16; *accord* Michel, *supra* note 50, at 7 (stating that a "conference follows immediately after the panel's last oral argument of the day"); *see also* Wright, *supra* note 31, at 8 (noting attorneys often make the mistake of treating judges as adversaries).

[111] Banner, *supra* note 110, at 17.

[112] Judge Paul Michel, CAFC, Lecture at the Master Class on Appellate Brief Writing, The John Marshall Law School (November 21, 1997).

[113] *Id.* at 7.

[114] Banner, *supra* note 110, at 17.

[115] Wright, *supra* note 31, at 3 (commenting that recitation of facts is unneeded).

[116] *Id.* at 4 (overusing and misusing exhibits at oral argument often leads to unintended consequences).

[117] Banner, *supra* note 110, at 17.

[118] DUNNER, *supra* note 97, at §5.04.

Issues have been stripped, and the content of briefs has been stripped. Now comes the most important stripping of all. Everything up to the oral argument must be stripped down to the nub. The argument must emphasize and simplify the pivotal issues. The possibilities for argument taken from the briefs must again be stripped mercilessly. Time will not allow otherwise. As Dunner and Gholz say: "[T]ouch the highlights."[119] The advocate must plan an oral argument of a maximum of eight to ten minutes, but preferably seven minutes.[120] In the author's experience, planning seven minutes may indeed be planning too much. Planning seven, but also planning a critical three, is best practice. If questions occupy essentially the full fifteen minutes, as they often do, then getting the content of a critical three minutes of argument into the fifteen will be an accomplishment.

B. Adjusting to the Panel Members and Anticipating Questions

Sometimes, the lawyer can helpfully adjust at the last minute to the panel members. The adjustment is recommended. The advocate may learn of the specific panel members the morning of the argument. Critical cases in which the panel members participated can be identified. The advocate can adjust appropriately.

To be truly effective at oral argument, the advocate must answer the court's questions. This is frequently extremely difficult. The judges typically ask the hard questions. Again, the advocate must prepare for questions. Again, according to Judge Michel: "What then characterizes the very best oral arguments? Not 'argument' at all, but mainly *answers,* answers that resolve in your client's favor the 'nagging doubts' of panel members."[121]

In preparing for questions, the advocate must prepare for the pointedly adverse questions. Good answers to tough questions must be found, and not left to chance. "[M]ore cases are lost at oral argument than won. Often, that is because honestly answering tough questions exposes the weaknesses of the case."[122]

At the podium, the lawyer must always welcome questions. They are not impositions. They are an essence to creating the good argument. The lawyer must also always, always, answer the questions, preferably first with "yes" or "no." The answers must not be non-answers; they must not avoid the questions. "[N]on-answers . . . tell us there *is* no satisfactory answer."[123]

C. Be Respectful

Finally, at oral argument the advocate must respect and enhance decorum. Paperwork should be streamlined and bound for the podium. Easel materials and movement in the courtroom should be minimized. Each judge should preferably be

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[119] *Id.*

[120] *Id.*

[121] Michel, *supra* note 50, at 6; *see also* Wright, *supra* note 31, at 6 (commenting on failure to anticipate questions or answer hypothetical questions).

[122] Michel, *supra* note 50, at 7.

[123] *Id.*

addressed as "Your Honor" and not personally. By doing this, mistakes in names can be avoided. And the advocate should let any humor be the court's. No remarks should be flip, snide, personal or casual, no matter how embittered the case. And finally, the advocate should definitely speak only while a judge is not speaking—never speaking over a judge, not for a split second.

IV. SUCCESS IN THE THREE STAGES MEANS LIKELY SUCCESS ON APPEAL

The appellate advocate at the CAFC has a complex, difficult, and exciting assignment. Preparation for success should begin well before appeal. The sooner an advocate who has a wise focus on appeal is a part of a trial team, the sooner the odds begin increasing for success on appeal. Once on appeal, the advocate must make breathtaking choices in selecting issues and content for the briefing and argument. The choices must be made. The more the advocate effectively uses the initial period of the appeal, in marshalling issues and choosing the few to pursue, the better still the odds. And the more the advocate moots the argument, by practicing tough questions, the better yet the odds.

Success can never be assured at the Federal Circuit, as at any court of appeals, but with excellent preparation and selection of issues, a Federal Circuit appeal can proceed with confidence that the best case has been made, and the probabilities of success are high.