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THE PREPARATION AND TRIAL OF INTELLECTUAL PROPERTY AND OTHER COMPLEX CASES

*Charles J. Faruki**

This article explains the practical aspects of trial preparation in an intellectual property case, focusing not on general trial preparation, but on trial concepts and advice particular to intellectual property cases. The article shows how to conceptualize, organize, and pull together the pieces necessary to take an intellectual property case to trial. Many of the observations and suggestions also apply to other complex litigation cases.

This article's emphasis is on jury trials, but much of what is said also applies to bench trials. Before the decrease in the size of juries in the federal courts,¹ the saying among trial lawyers was that "the judge is the thirteenth juror," meaning that it was important to make the judge, too, believe that a wrong had been done -- or if defending, that the facts did not show a violation, defendant had not over-reached, etc. This principle remains true, and such steps as filing a trial brief -- regardless of whether one is required by the court -- are necessary to help make the court want to rule in favor of the client.

An intellectual property trial differs from other trials in several ways, including the fact that argument and presentation of evidence over ideas -- and not just facts -- is necessary to the case. Many jurors are not routinely required to think about or analyze ideas, or to think about or analyze questions such as:

- What is a patent (trademark, copyright, trade secret)?
- What rights does it give (and not give) to the holder?
- What is "infringement"?
- What is the alleged infringer allowed to do?
- How do we determine "how close" the alleged infringer may come?
- How does the law set forth in preliminary instructions from the court apply to the facts being shown through the evidence?

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¹ See Fed. R. Civ. P. 48.

- What does the “public domain” mean, and what are the boundaries between public domain material and protected material (for patents, copyrights, and trade secrets)?²
- What does it mean for an invention to be “obvious”?³

² How many jurors can grasp a point of evaluation of evidence for its sufficiency, represented by the statement, “absence of evidence is not evidence of absence”? Other examples of concepts that may be difficult for jurors to grasp may be drawn from the boundaries of protection for various types of intellectual property. While a patent protects “any new and useful process, machine, manufacture, or composition of matter,” 35 U.S.C. § 101 (2000), it does not protect ideas or theories, laws of nature or scientific principles; material outside of what is “claimed” in the patent; or inventions that are obvious. *AT&T Corp. v. Excel Commun., Inc.*, 172 F.3d 1352, 1356-57 (Fed. Cir. 1999), *cert. denied*, 528 U.S. 946 (1999); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005), *cert. denied*, 546 U.S. 1170 (2006); *KSR Intl. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007). While patentable subject matter “is extremely broad,” *In re Comiskey*, 499 F.3d 1365, 1375, 84 U.S.P.Q.2d 1670, 1677 (Fed. Cir. 2007), “abstract ideas are not patentable.” *Id.* at 1376, 84 U.S.P.Q.2d at 1677. While a copyright protects “original works of authorship fixed in any tangible medium of expression,” 17 U.S.C. § 102(a) (2000), it does not protect ideas or concepts; compilations that do not display some minimal level of creativity; fair use; or independent creation. *Stromback v. New Line Cinema*, 384 F.3d 283, 296, 72 U.S.P.Q.2d 1545, 1552 (6th Cir. 2004). In cautioning “against misuse or over-extension of trade dress” protection, *Traffix Devices, Inc. v. Mktg. Displays, Inc.* explained that copying and reverse engineering are often allowed, and indeed valuable:

Trade dress protection must subsist with the recognition that in many instances there is no prohibition against copying goods and products. In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying. As the Court has explained, copying is not always discouraged or disfavored by the laws which preserve our competitive economy. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 160, 103 L. Ed. 2d 118, 109 S. Ct. 971 (1989). Allowing competitors to copy will have salutary effects in many instances. “Reverse engineering of chemical and mechanical articles in the public domain often leads to significant advances in technology.”

532 U.S. 23, 29 (2001). A trade secret protects information that derives independent economic value from not being generally known to and not being readily ascertainable by proper means by other persons who can obtain economic value from its disclosure or use, and which is the subject of efforts that are reasonable under the circumstances to maintain its secrecy. *See generally* Ohio Rev. Code Ann. §§ 1333.61-69 (Lexis 2006), Ohio’s version of the Uniform Trade Secrets Act. In determining that a plaintiff in a trade secret case did not take reasonable steps to preserve secrecy of the claimed trade secret, the Ninth Circuit reasoned that keeping files private is insufficient. *Incuse Inc. v. Timex Corp.*, 488 F.3d 46, 53, 83 U.S.P.Q.2d 1032, 1035 (1st Cir. 2007) (“The fact that Incuse kept its work for Timex private from the world is not sufficient; discretion is a normal feature of a business relationship. Instead, there must be affirmative steps to preserve the secrecy of the information as against the party against whom the misappropriation claim is made.”). However patented items, items in the public domain, items in which the owner has failed to take reasonable action to maintain confidentiality, or items that have been reverse engineered are not deserving of protection. These distinctions may be slippery for jurors.

³ *KSR Intl.*, 127 S. Ct. 1727, rejected a narrow application of the “teaching, suggestion, or motivation” test that had been used by the Court of Appeals for the Federal Circuit, under which a patent was proved obvious only if “some motivation or suggestion to combine the prior art teachings can be found in the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art.” *Id.* at 1734 (internal quotation marks and citation omitted). Stating that the correct test was an “expansive and flexible approach”, *id.* at 1739, to a determination of obviousness, as set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the court explained:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim,

This article examines post-fact-discovery work in intellectual property cases. While written and signed expert reports are required by Federal Rule of Civil Procedure 26(a)(2),⁴ and experts' depositions typically follow fact discovery (except in actions where a preliminary injunction is sought and expert discovery may be necessary, or in patent cases where expert discovery is part of preparation for a *Markman*⁵ hearing on claim construction issues⁶), for purposes of this article's exploration of trial preparation, expert reports are included because in intellectual property cases, work with experts is part and parcel of trial preparation. Indeed, trial counsel works with experts at least twice: once when the expert is working on the expert report, which includes "any exhibits that will be used to summarize or support"⁷ the data or other information used or conveyed by the witness, and again when presenting the expert's testimony at trial. In a patent case, the first occasion for work with experts may be their use in a claim construction hearing before trial.⁸ Hence, it is a mistake to view work with experts as a discovery-focused endeavor; such work is and should be viewed as a trial-focused endeavor. This article includes practical advice on the major post-discovery tasks that must be accomplished to ready an intellectual property case for trial. Because proof in intellectual property cases necessarily varies depending upon the case, this discussion does not make generalities of the "you should always prove" type. Rather, the purpose of the article is to teach the intellectual property-specific considerations that must be borne in mind as the trial lawyer goes through the tasks necessary for trial preparation. This article does not focus on pretrial motion practice (e.g., motions to dismiss, motions to sever, motions for summary judgment),⁹ and is not an exegesis of the caselaw on the

for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Intl., 127 S. Ct. at 1740-41. These principles are difficult for judges and jurors to apply. *Id.* at 1740 ("Following these principles may be more difficult in other cases than it is here"); *Graham*, 383 U.S. at 18 ("This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context."); Kimberly A. Moore, *Patent System Reform: Jury Demands: Who's Asking?* 17 *Berkeley Tech. L. J.* 847, 861 (2002) ("The less knowledgeable factfinder is more likely to think that the technical documents look the same because they are less likely to find meaning in small technical distinctions. This increases the chances that the patent will be invalidated.").

⁴ All opinions should be disclosed in the expert's report. See *Cell Genesys Inc. v. Applied Research Sys. ARS Holding, N.V.*, 499 F. Supp. 2d 59, 80, 85 U.S.P.Q.2d 1733, 1749 (D. Mass. 2007).

⁵ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 U.S.P.Q.2d 1321 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996).

⁶ See generally *Phillips v. AWH Corp.*, 376 F.3d 1382, 71 U.S.P.Q.2d 1765 (Fed. Cir. 2004) (en banc).

⁷ Fed. R. Civ. P. 26(a)(2)(B)(iii).

⁸ See generally Federal Circuit Bar Association, *Guidelines for Patent Claim Construction: The Basics of a Markman Hearing*, 14 Fed. Cir. B.J. 771 (2004); Federal Circuit Bar Association, *Guidelines for Patent Claim Construction: Post-Phillips—The Basics of a Markman Hearing*, 16 Fed. Cir. B.J. 13 (2006).

⁹ See C. J. Faruki, *The Practical Use of Motions to Structure a Complex Civil Case*, 41 *Ohio St. L.J.* 107 (1980).

developments in the substantive law of patents, trademarks, copyrights, or trade secrets. Such issues are of concern here only insofar as they set the requirements of proof discussed (such as the elements of the claims and defenses, and the burden of proof).

In preparing the intellectual property case for trial, there are intellectual property-specific considerations that relate to:

1. the opening statement and closing argument;
2. demonstrative evidence and experts;
3. trial writings (trial brief, jury instructions, joint final pretrial statement or joint final pretrial order, motions in limine, bench briefs);
4. voir dire;
5. sequence of witnesses; and
6. evidence and trial presentation.

A note on the mediation of intellectual property cases is also included.

I. OPENING STATEMENT AND CLOSING ARGUMENT

If the trial lawyer does not create an outline of the opening statement early in the case, then he or she is not ready to formulate questions for experts, to prepare the necessary trial writings (trial brief, jury instructions, joint final pretrial statement or joint final pretrial order, motions in limine, bench briefs), or to undertake many other tasks. The trial lawyer must have what José Ortega y Gasset described as “the vocation for clarity.”¹⁰ Linguistic legerdemain is not likely to impress jurors, but only to confuse or bore them. As Anthony Trollope said: “Do not fire too much over the heads of your readers.”¹¹ The same is true of opening statement and closing argument.

Identification and development of the themes for the opening statement are important for any opening statement, but in the trial of an intellectual property case, it is frequently a challenge to create the themes with an eye toward simplicity and emotional punch. Themes in an intellectual property case should not be technology-driven, although much of the proof in the case may be. Rather, the themes, psychological anchors in the case, should be those emotive concepts that will appeal to jurors and which form the thematic umbrella for the proof. Here is an ennead of useful themes in an intellectual property case:

1. ownership;
2. theft;

¹⁰ José Ortega y Gasset, *The Modern Theme* 5 (James Cleugh trans., Harper Torchbook 1961).

¹¹ *The Oxford Dictionary of Literary Quotations* 10 (Peter Kemp ed., 2d. ed., Oxford U. Press 2003).

3. poaching or trespass;
4. sweat equity (long, hard work and expense);
5. independent development;¹²
6. creativity;
7. public availability;¹³
8. copying;¹⁴ and
9. cheating or overreaching.

Not all of these themes will be used in every case; two or three themes are best. A number greater than three makes the message too diffuse, and dilutes the power of the themes. In selecting themes, avoid terminology that lay people typically do not understand (such as “the public domain”). Select two or three themes which fit the evidence, characterize the other side’s conduct, and cannot be turned around against the client. Word choice is very important in crafting and communicating the themes of the case.

The opening statement must tell the story, cover the principal proof on the liability issues (claims and defenses), and the evidence as to damages.¹⁵ In an intellectual property case it must also typically explain the intellectual property at issue (what it is and, sometimes, what it does), sometimes the technology at issue (including introduction of key terms), and why it is or is not valuable. To avoid an unduly lengthy opening (or even a short one that is mired in complexity) it is sometimes necessary to explain that there will be expert testimony and demonstrative evidence which will describe the technology, and to keep the opening statement at a high level of generality.

While skirting around a description of issues that are for the court, not the jury -- so as to avoid drawing an objection during the opening statement that you are telling the jury the law, which is the function of the Court¹⁶ -- it will nevertheless be necessary to talk about the type of intellectual property at issue. A request that the court give preliminary jury

¹² *Maharam v. Patterson*, 84 U.S.P.Q.2d 1056, 1057 (S.D.N.Y. 2007) (copyright action; “There is no infringement, however, if the evidence supports the conclusion that a defendant created his or her work independently.”).

¹³ “[T]he principle that no individual may copyright a work in the public domain,” *Golan v. Gonzales*, 501 F.3d 1179, 1189, 84 U.S.P.Q.2d 1076, 1084 (10th Cir. 2007) is well established. See generally *id.* at 1183-84, 84 U.S.P.Q.2d at 1079-1080. Information contained within an issued patent “or contained in published materials reasonably accessible to competitors” is ordinarily regarded as part of the public domain and not subject to protection as a trade secret. *Tank Tech, Inc. v. Neal*, 84 U.S.P.Q.2d 1116, 1123 (E.D. Mo. 2007) (internal quotation marks and citation omitted).

¹⁴ Of course sometimes copying is permitted. *TraFFix*, 532 U.S. at 29 (“Trade dress protection must subsist with the recognition that in many instances there is no prohibition against copying goods and products.”); *McNeil Nutritionals, LLC v. Heartland Sweeteners, LLC*, 511 F.3d 350, 368-69, 85 U.S.P.Q.2d 1545, 1559 (3d Cir. 2007) (discussing the issue of how close a store brand can resemble the package design of national brands).

¹⁵ See Charles J. Faruki, *Clear Openings in the Business Case*, 10 Litig. 29 (No. 4, 1984) (reprinted in *The Litigation Manual: Jury Trials* 225 (ABA, 2008)).

¹⁶ See *infra* n. 61.

instructions that describe what the intellectual property is, and state certain fundamental principles of law, will help during the opening statement, because trial counsel can refer to them (“as the Court explained to you, a patent is . . .”), thereby avoiding such an objection.

The temptations in crafting and delivering an opening statement in an intellectual property case are those of quantity and complexity.¹⁷ That is, the opening statement can be boring or otherwise ineffective if it conveys too much information, or conveys the information at too complex a level. As with so much of trial practice, the goal is to simplify, simplify, simplify. One way to simplify and organize the presentation is to organize the opening statement around factual questions (not issues; issues are for the court). Display for the jury the factual questions that the evidence will address, followed by a statement as to what the evidence will show, as the answer to that question. For example, in a patent case counsel may display to the jury the following types of questions:

Q. What is the proof of independent invention?

or

Q. What is the evidence of infringement?

or

Q. What did the prior art teach or suggest?

Each of these questions would be followed by the answer, beginning: “evidence will show” so that counsel is posing the questions, and answering them for the jury, with the answers being couched as descriptions of what the evidence will show. If the jurors are being permitted to take notes, then the resulting roadmap of the evidence for the jury should be easily digestible by the jurors who do take notes. Those jurors will have the assistance of their notes when talking to the other jurors during deliberations. They will also be able to “check off” the items of proof as they are admitted into evidence. These principles are so important in intellectual property cases because the complexity horizon¹⁸ of individual jurors in our country -- the limit of one’s ability to comprehend ideas and explanations -- is frequently exceeded by the concepts and the technology in intellectual property cases.

In complex cases simple headings stand out because the rest of the material is so complicated. Therefore, headings such as “The Facts” (or in closing argument, “The Truth”) are powerful. As Winston Churchill said:

¹⁷ For a useful commentary on jurors in patent cases, see generally Moore, *supra* n. 3, at 847.

¹⁸ The “complexity horizon” is a useful concept from complexity theory. See John Allen Paulos, *A Mathematician Reads the Newspaper* 5 (Basic Books 1995).

“You must look at the facts because they look at you.”¹⁹ Trial counsel can tell the jury that we look at the facts while the opponent engages in rhetoric. If possible, divide the facts which must be covered into undisputed facts and facts shown by the evidence. The undisputed facts can be explained as those admissions from the adversary’s documents and witnesses’ mouths. Begin with the heading “Undisputed Facts,” listing those most harmful to the adversary, and continue with the facts shown by the proof. The opening statement (and the closing argument) must be actual and factual; it must deal with the core or central realities of the dispute, and must summarize the most important facts.

Put differently, the facts must first be examined objectively, in light of their own sequence, context, and causal connections. Some lawyers approach the creation of an opening statement *ex vacuo*, focusing too much on the need for explanations of the technology and slighting the powerful story of the parties’ conduct. The failure to deal in the opening statement with the crucial weak spot in the client’s conduct can be a fatal elision. As part of the determination of how to deal with such a potential fatal flaw, ask of the parties’ conduct: *Quo animo?* (With what intent?). What was the intent of the critical action, and how may it be explained?

Many intellectual property cases have two types of opposing arguments: plaintiffs make theft-type arguments; and defendants respond with free or vigorous competition-type arguments. (Some jurors do not like “tough” competition; a good word choice is to argue “vigorous” competition.) Examples of vigorous competition arguments are independent development, design-around efforts, or reverse engineering coupled with improvements. If the case is likely to be shaped by such arguments, then marshalling the evidence by plaintiff of bad faith, and by defendant of good faith, is important. Again, think about how to present the evidence to answer the question: *Quo animo?* (With what intent?). The ability to make such arguments will be bound by the documents available from discovery (e.g., the presence or absence in the adversary’s files of documents about topics such as the competition between the parties; communications or negotiations between them; competitive intelligence about the adversary, and plans to deal with the other company).

As in other complex business cases, timelines are effective aids in telling a story. In addition to its use as an organizational device, a timeline that displays the timing (or length of awareness) of facts with reference to exhibits, can be a powerful summary. Examples include awareness of inventorship or delay in action. Much more than a sequence of events may be illustrated with timelines; they can help to show cause and effect relationships. An opening statement or closing argument in an intellectual

¹⁹ James C. Humes, *The Wit & Wisdom of Winston Churchill* 35 (Harper Collins Publishers 1994).

property case may be a lot for a jury to absorb,²⁰ timelines and other charts provide a systematic way for jurors to assimilate information and for note takers to capture and organize it.

In trials seeking an injunction in intellectual property cases, the opening statement or closing argument can readily be organized around the traditional four-part test for injunctive relief.²¹ There are significant public interests at issue in intellectual property cases (e.g., fostering innovation, fostering competition, protecting a statutory grant of rights, not extending protection beyond the bounds of the grant of intellectual property rights), so the testimony may explicitly address such interests (e.g., through an economist's testimony), as can the opening statement and closing argument.

A closing argument in an intellectual property case is quite similar to that in other complex civil cases. This article is not the place for discussion of closing argument points which the author has long used, such as distinguishing cause and effect, distinguishing facts from opinions, commenting on consistency of the evidence, making a comparison to what one's adversary said in the opening would be proven, cautioning against hindsight bias,²² instructing on how to use the themes in the case from the

²⁰ Moore, *supra* n. 3, at 857-58 ("It is surely more expensive and time-consuming to educate a jury that is seeing the technology for the first time at the trial than to educate a judge who has presided over the litigation since its inception and who has rendered a claim construction along the way.")

²¹ In holding that the traditional four-factor test used by courts of equity when considering whether to award injunctive relief to a prevailing plaintiff applies to disputes under the Patent Act. *EBay Inc. v. MercExchange, LLC*, 547 U.S. 388, 391 (2006), disapproved the "general rule" that had developed in the Court of Appeals for the Federal Circuit, "that courts will issue permanent injunctions against patent infringement absent exceptional circumstances." *Id.* at 393 (internal quotation marks and citation omitted).

²² While the author cautions the jurors against hindsight bias in closing argument, reminding them that the client did not know then the outcome we all know now, or that they must view the facts through the eyes and position of the party's knowledge at the time, the law also has principles in which warnings against hindsight bias are explicit.

The Court of Appeals, finally, drew the wrong conclusion from the risk of courts and patent examiners falling prey to hindsight bias. A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham*, 383 U.S., at 36, 86 S. Ct. 684, 15 L. Ed. 2d 545 (warning against a "temptation to read into the prior art the teachings of the invention in issue" and instructing courts to "'guard against slipping into the use of hindsight'" (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (CA6 1964))).

KSR Int'l., 127 S. Ct. at 1742; see also *Innogenetics, N.V. v. Abbott Laboratories*, 512 F.3d 1363, 1373, 85 U.S.P.Q.2d 1641, 1648 (Fed. Cir. 2008) (witness did not "state how or why a person ordinarily skilled in the art would have found the claims of the '704 patent obvious in light of some combination of those particular references Such vague testimony would not have been helpful to a lay jury in avoiding the pitfalls of hindsight that belie a determination of obviousness. See *Graham v. John Deere Co.*, 383 U.S. at 36 (discussing the importance of 'guarding against [slipping into use of] hindsight . . . and resist[ing] the temptation to read into the prior art the teachings of the invention in issue' when considering the obviousness of a patent.); accord *Ortho-McNeil Pharm., Inc. v. Mylan Laboratories, Inc.*, 520 F.3d 1358, 1364, 86 U.S.P.Q.2d 1196, 1201 (Fed. Cir. 2008) (The expert "simply retraced the path of the inventor with hindsight, discounted the number and complexity of the alternatives, and concluded that the invention . . . was obvious. Of course, this reasoning is always inappropriate for an obviousness test based on the language of Title 35 that requires the analysis to examine 'the subject

opening statement, distinguishing between a justification and a mere excuse (and how a jury instruction supports such an argument), and engaging in the subtleties of *tu quoque* arguments.²³ However, in an intellectual property case, counsel must use the themes to organize the evidence and avoid the temptation to recapitulate all of the dense testimony about technology and markets. Keeping it simple must be the guiding principle. Closing argument is the flip side of the opening statement, but counsel must be selective and focused, or the closing argument will lack punch. Knowing which witnesses did well, counsel must select the most powerful evidence and work to demonstrate its support of the client's argument, the consistency of the relevant facts with the themes of the opening statement, and the inconsistency of the other side's case with the facts.

It is critical to avoid the temptation of listing all supporting facts on the chart, resulting in information overload. Over-trying the case can include, in closing argument, assembling all supporting facts when one or two suffice. If the key adverse witness conceded the fact, then quoting (showing) the admission, *simpliciter*, is enough.

Even a complicated case can be simplified in the closing by discussing the three or four indisputable facts or central realities in the case. When those core realities have been elicited on cross examination, and can be shown to be from the mouths of the other side's witnesses, this device can be a useful way to organize all or part of the closing argument. When coupled with references to items that are likely to be in the notes of the jurors who took notes, this device can help to create a powerful closing argument.

A useful, high-level outline for closing argument in an intellectual property case might be the following one. Start strong, with a summary of the evidence (for plaintiff) as to how defendant's conduct harmed plaintiff, or (for defendant) that the plaintiff overstates both the scope (reach) of the intellectual property and its value -- then discuss each. Next, cover the undisputed facts or core realities of the case, as the beginning of the liability/non-liability argument. Then summarize the contested facts, showing first what the client has proven, and then what the client has not proven. (In some cases, where the adversary's opening has made exaggerated claims of one to three points that it promised to prove, consider starting with a reminder that the opponent said it would prove A and B, but instead the proof has been X and Y.) The objective here is to let the jury know that counsel has dealt with the opponent's strong points, and to leave the jurors with the belief that, *mutatis mutandis*, the story and points made

matter as a whole' to ascertain if it 'would have been obvious at the time the invention was made.' 35 U.S.C. § 103(a) (emphasis added)."

²³ Charging one's adversary with doing or saying what he charges you with doing or saying.

indicate that the verdict should be for the client. Finally, the discussion of damages, or lack thereof, and if defendant has offered an alternative calculation such as a royalty, then an explanation of it (“Even if you would find . . .”) may follow. A strong conclusion such as discussion of witnesses’ credibility problems, or driving home key admission(s), should conclude the closing argument.

As in any complex case, trial counsel’s credibility must be harbored. It may be tested later in the trial,²⁴ and must not be found wanting. Candor is necessary. Unfavorable facts must be faced directly. Unfavorable facts, such as oral or written statements by the client, must be put into perspective and explained. A “mistake” should be explained so that it is evident that it was not a mistake, or it should be admitted (with an explanation such as no harm flowing from it) -- do not deny it.

Given the importance of intellectual property to companies’ sales and marketing efforts, and the prominence with which intellectual property is used, and frequently highlighted, in promotion of products, consider whether the following argument fits the evidence for the defense. The defendant can explain that this lawsuit is merely the continuation of marketing by other means. That is, the plaintiff is trying through the lawsuit to obtain what it cannot achieve in the marketplace. Its losses are either self-inflicted or are the result of tough competition. Such an argument can be powerful if it can be supported by documents (even one or two) obtained during discovery.

In closing argument the trial lawyer fears failure to explain something that jurors later, in deliberations, will believe to be important. This fear is that an omitted point in the closing argument will leave jurors in the state described by the saying, “ignoramus et ignorabimus” (“we are ignorant and will remain so”) as to a key fact or event. How can this risk be minimized? How does counsel decide what may be pretermitted? In intellectual property cases, conduct of the parties, explanation of the intellectual property, and damages, must be covered. In addition to the ideas described above (such as undisputed facts, basic realities, etc.), counsel must explain cause and effect relationships, and the parties’ motivations and intent. For example, while the United States has a free-market economy, many jurors need to be reminded about the fact, and virtue, of competition, else they are susceptible to the belief that the rule should be, “thou shalt not covet thy competitor’s profits.”

²⁴ As Justice Stevens observed in discussing the plain error doctrine: “Murphy’s law applies to trial lawyers as well as pilots. Even an expert will occasionally blunder.” *Unitherm Food Sys., Inc. v. Swift-Eckrich, Inc.*, 546 U.S. 394, 407 (2006) (Stevens, J., dissenting).

II. DEMONSTRATIVES AND EXPERTS

Experts and demonstrative evidence are discussed together because in intellectual property cases demonstratives are usually necessary to the testimony of inventors, creators, or authors. As noted previously, Rule 26(a)(2)(B)(iii) requires the written report of the expert to include “any exhibits that will be used to summarize or support” the data or other information considered by the witness. Even beyond that requirement, the use of pictures, diagrams, films, and animations help to convey complex concepts in an interesting, understandable fashion.

In certain judicial districts, local rules come into play. For example, the Northern District of California has a rule that requires disclosure of asserted claims and infringement contentions, and which includes “[a] chart identifying specifically where each [patent] limitation . . . is found within each Accused Instrumentality, [and] the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function.”²⁵ Such a local rule must be considered (and, indeed, furnished to the expert) when conferring with an expert about the contents of the expert’s report. As always, counsel will need to check the local rules and the pretrial order or package of the particular judge to determine what the requirement may be for a particular case.

For ease of the factfinder’s comprehension and consistency of presentation of the trial themes, careful word choice must be coupled with visual communications. After voir dire, no part of the intellectual property trial (opening statement, direct and cross examinations, closing argument) should be unaccompanied by strong visual aids.²⁶

The best uses of demonstrative evidence in the liability case are frequently to explain the technology involved, the creation of the intellectual property, the structure, function, or use of the intellectual property, the violation of law (the infringing or appropriating conduct), the prior art in patent and trade secret cases, and the rights of others to use what has been dedicated to the public. On the damages side of the case, common uses of demonstrative evidence are to show investments in the technology, the identities or numbers of customers, descriptions of markets and submarkets, financial statements, and damage calculations.

In deciding what demonstratives to create, consider the following questions:

1. What needs to be explained?
2. Who will do it?

²⁵ Patent L.R. 3-1(c).

²⁶ See generally Lisa C. Wood, *Making Your Case with Graphics: An Interview*, 22 *Antitrust* 103 (No. 3, 2008).

3. What should the jury take back to the jury room (as opposed to the more limited use in court as an illustrative piece of demonstrative evidence, one that is not admitted into evidence)?

This last question is very important as it will dictate the type of exhibit that is to be created, the foundation or evidence that will be necessary to support its admissibility, and the style of exhibit (as, for example, a summary under Federal Rule of Evidence 1006).²⁷

In creating the demonstrative aids, there are several principles and guidelines that are of paramount importance. As with all writing, the “ABCs” (Accuracy, Brevity, and Clarity), are paramount. In addition to those principles, ease of use, ease of comprehension, information overload (e.g., avoid putting too much information into a chart or schedule), visibility in the courtroom, and the double-edged sword problem (can this exhibit be turned against us?) must be considered. Regardless of the medium used to convey the information (objects themselves, enlargements mounted on foam board, photographs, animations, PowerPoint presentations, other films or videotapes, etc.), and regardless of the type of display of information (e.g., graphs, charts, schedules), creation of the demonstratives should consider such points as: foundational materials and whether and how they will need to be admitted; using color to convey information; the necessity to avoid putting too much detail into the exhibit; and the necessity to avoid having an exhibit carry too much weight (that is, too many different concepts or points in the case).²⁸

When beginning to craft an explanatory exhibit, do not start with the data; start with an outline, as brief as possible, of the message(s) to be conveyed. An explanation of clarity in writing by Somerset Maugham long ago, applies to creation of demonstrative exhibits:

Another cause of obscurity is that the writer is himself not quite sure of his meaning. He has a vague impression of what he wants to say, but has not, either from lack of mental power or from laziness, exactly formulated it

²⁷ Fed. R. Evid. 1006:

The contents of voluminous writings, recordings, or photographs which cannot conveniently be examined in court may be presented in the form of a chart, summary, or calculation. The originals, or duplicates, shall be made available for examination or copying, or both, by other parties at reasonable time and place. The court may order that they be produced in court.

²⁸ An example from the patent area serves to illustrate these concepts. The complexities of the disclosure-dedication rule (the principle that the action of a patent drafter in disclosing but failing or declining to claim subject matter dedicates that unclaimed subject matter to the public, *Toro Co. v. White Consol. Indus., Inc.*, 383 F.3d 1326, 1331-33, 72 U.S.P.Q.2d 1449, 1452-53 (Fed. Cir. 2004)), may be made plain to a factfinder with a colored chart showing the disclosed-but-unclaimed matter.

in his mind and it is natural enough that he should not find a precise expression for a confused idea. This is due largely to the fact that many writers think, not before, but as they write. The pen originates the thought. The disadvantage of this, and indeed it is a danger against which the author must be always on his guard, is that there is a sort of magic in the written word. The idea acquires substance by taking on a visible nature, and then stands in the way of its own clarification. But this sort of obscurity merges very easily into the wilful. Some writers who do not think clearly are inclined to suppose that their thoughts have a significance greater than at first sight appears. It is flattering to believe that they are too profound to be expressed so clearly that all who run may read, and very naturally it does not occur to such writers that the fault is with their own minds which have not the faculty of precise reflection. Here again the magic of the written word obtains. It is very easy to persuade oneself that a phrase that one does not quite understand may mean a great deal more than one realizes. From this there is only a little way to go to fall into the habit of setting down one's impressions in all their original vagueness. Fools can always be found to discover a hidden sense in them.²⁹

This passage illustrates the dangers of not working from an outline of the “big message units” to be conveyed by an exhibit, and of poor word choice. By nature, a demonstrative exhibit is a summary or example, and its message must be clear, not obscure or subject to different meanings.

For the factfinder's ease of comprehension, the use of side-by-side charts and graphics is especially effective in intellectual property cases. The reason is that the nature of the intellectual property at issue usually lends itself to a side-by-side comparison and contrast. Examples include claim charts in patent cases (comparing the claims of the patent to the accused product, devise, process, etc.); side-by-side comparison of trademarks; and juxtaposition of passages in copyright cases. Labeling, using colors for, and highlighting the similar (or dissimilar, if defending) portions of the chart or graphic exhibit both enables a smooth walk-through of the elements to be referenced, and facilitates a ready grasp of the similarities and differences, if any, while keeping the factfinder oriented to the big picture.

The Advisory Committee Note to Federal Rule of Evidence 1006 states that “admission of summaries of voluminous books, records, or

²⁹ W. Somerset Maugham, *The Summing Up* 31-32 (The Literary Guild of America 1938).

documents offers the only practicable means of making their contents available to judge and jury.” Even experienced lawyers can have difficulty with admissibility of both demonstratives and summaries. The following methodology will minimize those difficulties. The author conceives of many demonstrative exhibits -- even enlarged charts or diagrams -- as Rule 1006 summarizes. Indeed, the author frequently creates two forms of a demonstrative chart or summary, one for display to the jury and one for use with the court in getting the exhibit admitted into evidence. The latter version, for use with the court, is annotated to the other trial exhibits and supporting documents for each item on the chart. While its appearance is thereby cluttered with the annotations, the footnoted version used with the court can show the court relatively quickly that: (a) everything on the chart is indeed based on trial exhibits, documents, or other evidence; and (b) such documents or evidence have been admitted or are being offered with the summary, which, in the language of Rule 1006, are being “produced in court.”

This type of annotation to demonstrate foundation can be done with other types of demonstrative evidence. For example, an animation or other video presentation to be shown to the jury can be supported by a bench brief and a copy of the screen shots of the video presentation, with the screen shot pages containing source notes or footnotes to the witness testimony, caselaw, and trial exhibits. Because the annotated copy is not to be offered into evidence, it need not be tendered to the other side with the trial exhibits (unless local rule or court order requires otherwise), but can be used in argument, at the time that the exhibit is offered into evidence.

How can one most effectively create and use a Rule 1006 summary? The author’s preferred methodology can best be illustrated by an example. Suppose that plaintiff’s proof of damages in the case includes lost (canceled) sales, i.e., sales that had been made but the orders for which were canceled by customers. This hypothetical damage calculation would include prejudgment interest, the amount of the lost sales, and a calculation of other out-of-pocket expenses incurred, all of which constitute the total damage number. The proof of those lost sales is then organized in six parts, which comprise six portions of a composite exhibit. If the relevant damage exhibit is exhibit 10, then the back of the exhibit, exhibit 10F, is the collection of sales orders, invoices, cancellations, etc. that comprise the underlying business records. Those business records should themselves be admissible under the business records exception to the hearsay rule.³⁰ Exhibit 10E is then a schedule that lists each of the orders by number, date, customer, and amount. Note that Exhibit 10E is itself a Rule 1006 summary of the documents collected as Exhibit 10F. Exhibit 10D is a chart summarizing the

³⁰ See Fed. R. Evid. 803(6).

company's selling expenses to be recovered, together with the records of those expenses. The other out-of-pocket expenses would then be summarized, with supporting documentation, as Exhibit 10C. Exhibit 10B is the prejudgment interest calculation on those items in Exhibits 10C through 10F for which prejudgment interest is sought. Exhibit 10A is the schedule, which is the master damage summary; it simply lists the item or type of damages, the amount sought for those damages, and a reference to the respective exhibit component (Exhibits 10B-10F) where the supporting documentation is found.

This method, of providing in one composite exhibit the backup documentation for various components of damages, with the higher-level summaries at the beginning of the exhibit, makes it much easier for counsel to argue for the admissibility of the exhibit and for the court to see that there has been compliance with Rule 1006. Different witnesses may testify to the foundation for admissibility of different portions of the composite exhibit; for example, in the illustration above, a lay witness from the client may testify to Exhibits 10C through 10F (the out of pocket costs, the selling expenses, the summary of sales orders and cancellations, and the supporting documents evidencing those orders and cancellations), followed by the expert testifying to Exhibits 10A and B (the prejudgment interest calculation and the top-level summary of damages). Counsel can show that various foundation witnesses have testified to the respective components of the exhibit (because it is not unusual for different witnesses to be required to testify to different foundational pieces of a damage study), and then use in closing argument only the master damage schedule (Exhibit 10A in this example) as an enlarged chart which the jury can then take back to the jury room. Counsel can more easily demonstrate admissibility by going from the back of the exhibit to the front, i.e., from the specific to the general.

The factors to be considered in the admissibility of electronic evidence are being developed in the caselaw.³¹ In complex cases between businesses, electronic evidence will become the norm. Getting it into evidence, and displaying it properly, are two separate but critical steps, which require planning.

Creation of a good record on the admissibility of expert testimony is all the more important in light of the Supreme Court's ruling in 2000 in *Weisgram v. Marley Co.*,³² which dealt with the situation in which the court

³¹ The leading case on admissibility of electronic evidence is *Lorraine v. Markel Am. Ins. Co.* 241 F.R.D. 534 (D. Md. 2007); see also, *Victor Stanley, Inc. v. Creative Pipe, Inc.*, 250 F.R.D. 251 (D. Md. 2008); George L. Paul, *Foundations of Digital Evid.* (1st ed., ABA 2008); Sheldon M. Finkelstein & Evelyn R. Storch, *Admissibility of Electronically Stored Information: It's Still the Same Old Story*, 34 Litig. 13 (No. 3, 2008); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 U.S.P.Q.2d 1856, 1858-59 (T.T.A.B. 2007) (regarding the admissibility of Internet materials (printouts of information from the Internet)).

³² 528 U.S. 440 (2000).

of appeals decided that expert testimony was erroneously admitted at trial, and without that erroneously admitted expert testimony, the record was insufficient to support the verdict. The plaintiff in that case, successful in obtaining a jury verdict, argued that when a court of appeals determines that a jury verdict cannot be sustained because of an erroneous admission of evidence, the appellate court may not order the entry of judgment for the verdict loser, but instead there must be an automatic remand to the district court for consideration whether a new trial is warranted.³³ The Supreme Court rejected that argument, instead holding “that the authority of courts of appeals to direct the entry of judgment as a matter of law extends to cases in which, on excision of testimony erroneously admitted, there remains insufficient evidence to support the jury’s verdict.”³⁴ Thus, while the district court can grant a new trial,³⁵ a party may find that expert testimony, which an appellate court rules to have been erroneously admitted, leaves the case shorn of evidence sufficient to uphold the verdict, resulting not in a new trial, but in the entry of judgment for the adverse party.

An intellectual property trial presentation may require multiple experts.³⁶ Experts in intellectual property cases may be used to explain such subjects as: the technology at issue; the invention or creation; why the invention or creation is or is not unique; why the invention or creation has value or lacks value; and damages. The experts in intellectual property and other complex cases must have the ability to teach, and to hold the attention of the factfinder. In selecting experts it is important to ask about the expert’s teaching experience, and then to test it by having the expert explain

³³ Specifically, the Supreme Court explained the verdict winner’s argument as follows:

Under this Rule, [Fed. R. Civ. P. 50,] Weisgram urges, when a court of appeals determines that a jury verdict cannot be sustained due to an error in the admission of evidence, the appellate court may not order the entry of judgment for the verdict loser, but must instead remand the case to the trial court for a new trial determination.

Id. at 448-49. Again, “[i]nsufficiency caused by deletion of evidence, Weisgram contends, requires an ‘automatic remand’ to the district court for consideration whether a new trial is warranted.” *Id.* at 452.

³⁴ *Id.* at 457.

³⁵ Fed. R. Civ. P. 59.

³⁶ A defense that there is no harm to the plaintiff because the defendant and the plaintiff do not compete in the same market or at overlapping price ranges may be presented through the testimony of an economist. For another example, suppose there is an antitrust counterclaim in a patent case, alleging an unlawful tying arrangement, so that proof of the defendant’s market power in the tying product must be an issue, as in *Illinois Tool Works Inc. v. Independent Ink, Inc.*, 547 U.S. 28, 45-46 (2006):

Congress, the antitrust enforcement agencies, and most economists have all reached the conclusion that a patent does not necessarily confer market power upon the patentee. Today, we reach the same conclusion, and therefore hold that, in all cases involving a tying arrangement, the plaintiff must prove that the defendant has market power in the tying product.

In that circumstance, an expert witness such as an economist would need to testify about existence *vel non* of market power in addition to the other liability testimony.

a subject matter, so that the expert's teaching ability may be demonstrated.

Sometimes the subject of the expert testimony will be apparent. Yet, what if the need for expert testimony is unclear? To be sure that the proof in the case is complete, a chart of proof showing what must be proven (the elements of the claims or defenses, and the evidence (witnesses, documents, and other evidence)) to be used to prove or disprove each element, will fill the holes in the proof of the case. The experts can then be used to fill those holes, as well as to corroborate the testimony of witnesses from the client.

Frequently the report prepared by the expert for compliance with Rule 26(a)(2)(B) will not be offered into evidence.³⁷ Indeed, the requirement of Rule 26(a)(2)(B)(ii)³⁸ that "the data or other information considered by the witness in forming" the expert opinions must be disclosed, may preclude admissibility of some or all of the expert report because of Federal Rule of Evidence 703,³⁹ which includes the point that "the facts or data need not be admissible in evidence in order for the opinion or inference to be admitted." If the expert report contains facts or data that are not admissible in evidence (but which must be in the expert's report because of Rule 26(a)(2)(B)(ii)), then one cannot offer the expert report, or at least those portions of it which contain inadmissible information. This restriction on the admissibility of an expert's Rule 26(a) report makes the expert's use of demonstrative or illustrative exhibits very important.

As a result of the variety of the types of intellectual property actions and of the subjects of those actions, generalizations about experts in intellectual property actions are difficult. The opinions of the experts⁴⁰ should meet the requirements of the substantive law as to the proof

³⁷ An expert may not testify about conclusions reached by another expert in a report that has not been admitted into evidence, because each testimony is inadmissible hearsay. *Mike's Train House, Inc. v. Lionel, L.L.C.*, 472 F.3d 398, 409, 81 U.S.P.Q.2d 1161, 1167 (6th Cir. 2006). "Other circuits have squarely rejected any argument that Rule 703 extends so far as to allow an expert to testify about the conclusions of other experts." *Id.* (collecting cases).

³⁸ This rule requires that the expert report must contain "the data or other information considered by the witness in forming" the opinions. Fed. R. Civ. P. 26(a)(2)(B)(ii).

³⁹ Fed. R. Evid. 703:

The facts or data in the particular case upon which an expert bases an opinion or inference may be those perceived by or made known to the expert at or before the hearing. If of a type reasonably relied upon by experts in the particular field in forming opinions or inferences upon the subject, the facts or data need not be admissible in evidence in order for the opinion or inference to be admitted. Facts or data that are otherwise inadmissible shall not be disclosed to the jury by the proponent of the opinion or inference unless the court determines that their probative value in assisting the jury to evaluate the expert's opinion substantially outweighs their prejudicial effect.

⁴⁰ All opinions should be disclosed in the expert's report. See *Cell Genesys*, 499 F. Supp. 2d at 80, 85 U.S.P.Q.2d at 1749.

necessary in the case, should meet the requirements of Rule 702⁴¹ of the Federal Rules of Evidence, and of the *Daubert*⁴² line of cases in the Supreme Court and their progeny, and should be consistent with the themes of the case as set forth in the opening statement.

⁴¹ Fed. R. Evid. 702:

If scientific, technical, or other specialized knowledge will assist the trier of fact to understand the evidence or to determine a fact in issue, a witness qualified as an expert by knowledge, skill, experience, training, or education, may testify thereto in the form of an opinion or otherwise, if (1) the testimony is based upon sufficient facts or data, (2) the testimony is the product of reliable principles and methods, and (3) the witness has applied the principles and methods reliably to the facts of the case.

A good distillation of Rule 702 and *Daubert* principles is contained in the opinion in *In re Scrap Metal Antitrust Litig.*, 527 F.3d 517, 528-29 (6th Cir. 2008):

Parsing the language of the Rule, it is evident that a proposed expert's opinion is admissible, at the discretion of the trial court, if the opinion satisfies three requirements. First, the witness must be qualified by "knowledge, skill, experience, training, or education." Fed. R. Evid. 702. Second, the testimony must be relevant, meaning that it "will assist the trier of fact to understand the evidence or to determine a fact in issue." *Id.* Third, the testimony must be reliable. *Id.* Rule 702 guides the trial court by providing general standards to assess reliability: whether the testimony is based upon "sufficient facts or data," whether the testimony is the "product of reliable principles and methods," and whether the expert "has applied the principles and methods reliably to the facts of the case." *Id.* In addition, *Daubert* provided a non-exclusive checklist for trial courts to consult in evaluating the reliability of expert testimony. These factors include: "testing, peer review, publication, error rates, the existence and maintenance of standards controlling the technique's operation, and general acceptance in the relevant scientific community." *United States v. Langan*, 263 F.3d 613, 621 (6th Cir. 2001) (citing *Daubert*, 509 U.S. at 593-94, 113 S. Ct. 2786). The test of reliability is "flexible," and the *Daubert* factors do not constitute a "definitive checklist or test," but may be tailored to the facts of a particular case. *Kumho*, 526 U.S. at 150, 119 S. Ct. 1167 (citing *Daubert*, 509 U.S. at 593, 113 S. Ct. 2786). Indeed, we have recognized that the *Daubert* factors "are not dispositive in every case" and should be applied only "where they are reasonable measures of the reliability of expert testimony." *Gross v. Comm'r*, 272 F.3d 333, 339 (6th Cir. 2001).

⁴² *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579 (1993) (The expert testimony at issue in *Daubert* dealt with whether the drug Bendectin caused birth defects.). The proposed expert must testify to "(1) scientific knowledge that (2) will assist the trier of fact to understand or determine a fact in issue." *Id.* at 592. These two tests insure that the testimony is reliable as well as relevant. *Id.* at 592-93. Effective December 1, 2000, Rule 702 of the Federal Rules of Evidence was amended to codify the Supreme Court's *Daubert* reliability standard. The Supreme Court's *Daubert* trilogy consists of the *Daubert* opinion followed by two other cases. In the first case, *General Electric Co. v. Joiner*, the court held that a trial judge's decision to admit or to exclude expert testimony can be reversed only for abuse of discretion; a judge may exercise discretion to exclude evidence when there is "too great an analytical gap between the data and the opinion [or conclusion] proffered." 522 U.S. 136, 146 (1997). In the second case, *Kumho Tire Co. v. Carmichael*, dealt with plaintiffs' expert in tire failure analysis, who opined that the blowout of a minivan tire was due to defective manufacture; the court held that the *Daubert* factors were not restricted to scientific evidence, and that "*Daubert*'s list of specific factors neither necessarily nor exclusively applies to all experts or in every case." 526 U.S. 137, 141 (1999), *Daubert* was followed in Ohio. *Miller v. Bike Athletic Co.*, 80 Ohio St. 3d 607, 613 (1998) (holding that the *Daubert* reliability factors should be applied by Ohio state courts placing emphasis on "helpfulness to the trier of fact").

III. A WORD ON MEDIATION OF INTELLECTUAL PROPERTY CASES

Though not strictly a part of trial preparation, the elements of good trial preparation of an intellectual property case are important to effective preparation for mediation of such a case. This note on mediation of intellectual property cases appears at this point in the article because work with experts and demonstrative evidence is sometimes overlooked when consideration is given to mediation in intellectual property cases. The expert's work product, and exhibits that the expert prepares, can be used effectively in mediation of intellectual property cases.

How can the results of an expert's work be used in this context? There are several ways. First, quotations or excerpts from the expert's report are useful to educate the mediator -- and the other party, if mediation statements are exchanged, because the other party representative may not have seen or read the experts' reports. There is no prejudice from quotation of the expert reports because the other side has the reports anyway. Second, exhibits prepared by the expert may be used to convey a lot of information while keeping the mediation statement short. Third, statements of what the expert will be prepared to say in response to the expected principal points of the adversary's case can effectively meet the anticipated thrust of the other side's mediation statement. For example, in a trade secrets case, the pleadings and discovery will have shown what the trade secret is alleged to be; in defense of the case, demonstrative displays that deconstruct the components of the trade secret and show where they are located in the public domain can make an effective, brief presentation.

The subject of damages provides another example. In a mediation, why is it important to know what an expert would say on the subject of damages? Because specific points lend credibility to a presentation and use of the points from an expert's report to support arguments in a mediation statement are going to be more persuasive than "our evidence will be" generalities. Thus, if the plaintiff wants to argue that damages are conservatively estimated, or if defendant wants to argue that damages are overstated, then support for such arguments with a description, or quotation, of what the expert says about that topic will produce a more persuasive mediation statement, and will give the mediator specific ammunition to use on the adversary during the mediation.

IV. TRIAL WRITINGS

The author uses the term "trial writings" to encompass the post-summary judgment writings that are necessary to prepare a case for trial. Most of these writings are filed in the thirty days before trial. They include: trial briefs; jury instructions; joint final pretrial statement or proposed joint

final pretrial order; motions *in limine* (including *Daubert*⁴³ motions); and bench briefs for use during trial.

The trial brief. The purposes of trial briefs in an intellectual property case are to specify the issues in a case, delineating which issues are for the court and which are for the jury;⁴⁴ to set up the jury instructions, i.e., to familiarize the judge with the principal cases and points that the judge will see in the jury instructions; to deal with important evidentiary arguments expected to arise (counsel should be able to say, “Your honor, the cases that bear on the admissibility of this exhibit are at page __ of our trial brief”); and to provide the law relevant to a motion for judgment as a matter of law,⁴⁵ unless that motion is going to be briefed as a separate motion with supporting memorandum. The trial brief also helps to make an effective record for appeal, showing what issues were argued in the trial court. Although, generally speaking, factual issues are for the jury, in an intellectual property case a careful explanation of the evidence that will come in, including charts and schedules where necessary, will assist the court in understanding the relevance or irrelevance of evidence that is to be offered, i.e., it will assist the judge’s understanding of arguments over admissibility.

The point of setting up the jury instructions is important in an intellectual property case; jury instructions not only must be a correct statement of law, but also must be clear.⁴⁶ Of course counsel can request jury charges to be given on points of law in the case. However, in intellectual property cases the jury instructions are frequently quite lengthy, and the temptation for the judge is to try to cut back on counsel’s requested instructions, so as not to further lengthen the set of jury instructions that must be read to, and provided to, the jury. Therefore, the inclusion in the trial brief of a clear statement of the issues to be decided by the court and the jury, and the law applicable to those issues, will help the judge to realize, when it is time to assemble jury instructions, that counsel’s proposed charge must be given.

Jury instructions. Of course, the purpose of jury instructions is to inform the jurors of the applicable law. “The Court is mindful of the challenges that sometimes arise in applying existing legal principles in the context of newer technologies.”⁴⁷ Similarly, there are challenges for the jury in applying the law stated in the jury instructions to newer technologies.

⁴³ See generally *Daubert*, 509 U.S. 579.

⁴⁴ See *infra* nn. 51, 61.

⁴⁵ See Fed. R. Civ. P. 50(a).

⁴⁶ *Molten Metal Equip. Innovations, Inc. v. Metallics Sys. Co.*, 2003 U.S. App. LEXIS 1821 at *6 (Fed. Cir. Jan. 30, 2003) (“Jury instructions are reviewed for correctness in their statement of the law, with due attention to their clarity, objectivity, and adequacy.”).

⁴⁷ *Buying for the Home, LLC v. Humble Abode, LLC*, 459 F. Supp. 2d 310, 323, 83 U.S.P.Q.2d 1881, 1889 (D.N.J. 2006).

Jury instructions in plain English, without jargon, are essential. Model or pattern jury instructions are available,⁴⁸ which should be adapted to the case by use of parties' names, dates, and other facts.

For the trial attorney it is another way to structure, or to support, closing argument. Especially in intellectual property cases in which evidence is complicated, the ability to use a jury instruction ("the judge will tell you that . . .") to anchor a critical point, and then to state the evidence on that point, can be a clean way to organize a closing argument, or to highlight evidence for the jury by using the court-approved jury instruction to explain why the evidence deserves great weight. From the trial lawyer's standpoint, still another purpose of the jury instructions is to preserve error for appeal by tendering a correct statement of the law on a claim or defense which, if not given, renders the instructions as a whole defective.⁴⁹ Review on appeal is fraught with many hurdles, such as determining the following: the existence of proper objection to an alleged error; the issue of whether the objection was waived; the appropriate standard of review; and the applicable burden of proof; etc.⁵⁰ One of the best arguments on appeal can be a question of law presented by a clear, accurate, relevant, non-argumentative jury instruction that the court declined to give, and which was not otherwise covered in the instructions given by the court. For this reason, a useful tactic is to offer separate, somewhat overlapping jury instructions to make sure all points are covered and that an accurate statement of the law has been requested of the court; in a charge conference there is frequently some negotiation among the court and counsel over jury instructions. Because it is difficult to predicate error upon the failure to give a jury instruction,⁵¹

⁴⁸ See e.g. ABA Intell. Prop. Litig. Comm., *Model Jury Instructions: Copyright, Trademark and Trade Dress Litigation* (Todd S. Holbrook & Alan Nathan Harris eds., ABA 2008).

⁴⁹ *Eaton v. Charter Township of Emmett*, 2008 U.S. App. LEXIS 6603 at *4 (6th Cir. Mar. 21, 2008); *In re Scrap Metal*, 527 F.3d at 536 ("judgment may be reversed based upon an improper jury instruction only if the instructions, viewed as a whole, were confusing, misleading, or prejudicial") (internal quotation marks and citation omitted).

⁵⁰ "[D]etermination [of obviousness] is a legal conclusion based on underlying findings of fact." *In re Sullivan*, 498 F.3d 1345, 1350, 84 U.S.P.Q.2d 1034, 1038 (Fed. Cir. 2007). "Whether a prior art reference is enabling is a question of law based upon underlying factual findings." *Forrest Laboratories, Inc. v. Ivax Pharms., Inc.*, 501 F.3d 1263, 1268, 84 U.S.P.Q.2d 1099, 1103 (internal quotation marks and citation omitted). So is obviousness. *Id.* at 1269, 84 U.S.P.Q.2d at 1104. "Anticipation is a question of fact that we review for clear error following a bench trial." *Id.* at 1268, 84 U.S.P.Q.2d at 1103. "Whether a party may receive lost profits is a question of law that we review de novo." *Mitutoyo Corp. v. Central Purchasing, LLC*, 499 F.3d 1284, 1291, 84 U.S.P.Q.2d 1001, 1006 (Fed. Cir. 2007).

⁵¹ Review of a district court's jury instructions is under an abuse of discretion standard, *Smith v. U.S.*, 2008 U.S. App. LEXIS 14113 at *13 (6th Cir. July 1, 2008), and a judgment will be reversed only if the instructions, viewed as a whole, were confusing, misleading, fail to state the law correctly, or prejudicial. *Id.* at **13-14. The Federal Circuit "reviews jury instructions in their entirety and only orders a new trial when errors in the instructions as a whole clearly mislead the jury." *DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293, 1304, 81 U.S.P.Q.2d 1238, 1246 (Fed. Cir. 2006) (internal quotation marks and citations omitted). In the Sixth Circuit refusal to give a requested jury instruction is reversible error only where the omitted instruction (1) was a correct statement of the law, (2) was not substantially covered by other delivered charges, and (3) impaired the requesting party's theory of the case. *Micrel, Inc. v. TRW, Inc.*, 486 F.3d 866, 881 (6th Cir. 2007); *Surles v. Greyhound Lines, Inc.*, 474 F.3d 288, 299 (6th Cir. 2007). There will be no reversal unless it was likely that the jury was misled, *Johnson*

some redundancy in instructions that counsel requests the court to give is frequently a good idea.

Along with the jury instructions, counsel should give thought to an appropriate form of jury verdict. Special interrogatories may be appropriate.⁵² The plaintiff may want to propose a jury verdict that gives more bites at the apple of liability, while the defendant may sometimes propose a series of questions that are difficult to work through, thus maximizing the chance of inconsistent answers to the questions. Of course jury verdict forms that are clear and concise are most likely to be understandable and followed. Show these jury forms to a nonlawyer who is not intimately involved in the case to determine if they are unambiguous.

Proposed Joint Final Pretrial Order. There is little in the proposed joint final pretrial order or joint final pretrial statement required by some judges which is unique to intellectual property cases. The local rule, general order, or a particular judge's order will specify the forms to be used, and they vary widely among courts and among judges. Regardless of whether the local rule or applicable court order so provides, in intellectual property cases it is generally a good idea to include the following: (1) a limitation on the number of experts to be called by each side; (2) a consideration of stipulations of authenticity of documents produced by the parties from their corporate files and, sometimes, of admissibility of certain exhibits (especially those exhibits created before a dispute arose between the parties); (3) a statement that one or both sides are in favor of permitting the jurors to take notes; (4) a clarification (really, a reminder to the trial judge) if equitable relief such as an injunction⁵³ is also sought, so that the court understands that the case is not only a damages case; and (5) a statement of the issues to be decided on the verdict form.

Given the complexities of many intellectual property cases, display of documents in the opening statement, in an interesting fashion, is important. Courts differ in the extent to which they allow documents to be displayed (as opposed to referenced) in opening statement. Because the documents are not in evidence yet, some courts will not allow the jury to be shown the text of documents in the opening statement. To deal with that obstacle, trial counsel should seek a stipulation of authenticity, at least of

Controls, Inc. v. Jay Indus., Inc., 459 F.3d 717, 727 (6th Cir. 2006), and there is no review for technical error, *McMillan v. Castro*, 405 F.3d 405, 413 (6th Cir. 2005). As to the quantum of evidence necessary to support a requested instruction, *compare Taylor v. Teco Barge Line, Inc.*, 517 F.3d 372, 387 (6th Cir. 2008) ("A party needs only a slim amount of evidence to support giving a jury instruction, but jury instructions must be reviewed as a whole . . ."); *with Tuttle v. Metro. Govt. of Nashville & Davidson Co.*, 474 F.3d 307, 322 (6th Cir. 2007) (error to instruct jury when insufficient evidence was "presented to support a jury finding on that issue") (internal quotation marks and citation omitted), *cert. denied*, 128 S. Ct. 366 (2007).

⁵² See Fed. R. Civ. P. 49.

⁵³ *EBay*, 547 U.S. at 392-93.

documents from the parties' files (or, more narrowly, at least of pre-dispute or pre-suit documents from the parties' files) in the proposed final pretrial order. Courts welcome such a stipulation. Then if the use of a document in the opening statement does draw an objection, a reminder at sidebar that the authenticity of the document has been stipulated to and that counsel is simply explaining what the evidence is expected to show, should suffice to deal with the objection.

Motions in Limine. Pretrial motion practice in intellectual property cases bears many similarities to such practice in complex commercial cases generally. Federal Rules of Evidence 103(c)⁵⁴ and 104(c)⁵⁵ seek to assure that proceedings shall be conducted out of the hearing of the jury to prevent them from hearing inadmissible evidence or consideration of preliminary matters. Those rules, along with Federal Rule of Evidence 403,⁵⁶ and *Daubert*⁵⁷ and its progeny, form the basis for much motion *in limine* practice. In intellectual property cases, another common subject⁵⁸ of motions *in limine* is testimony by attorneys.⁵⁹ There is a substantial body of

⁵⁴ Federal Rule of Evidence 103(c) reads: "In jury cases, proceedings shall be conducted, to the extent practicable, so as to prevent inadmissible evidence from being suggested to the jury by any means, such as making statements or offers of proof or asking questions in the hearing of the jury." Reliance on a ruling on a motion *in limine* to preserve an objection for appeal may be risky, *Z4 Technologies, Inc. v. Microsoft Corp.*, 507 F.3d 1340, 1355-56, 85 U.S.P.Q.2d 1340, 1351 (Fed. Cir. 2007), *cert. dismissed*, 128 S. Ct. 2107 (2008):

While we question the merits of Microsoft's reliance on its denied motion in limine to preserve this argument for appeal in light of the district court's admonition that its "rulings on the pre-trial motions in limine were not definitive rulings," JMOL Opinion at 17; Fed R. Evid. 103(a) (requiring a "definitive ruling" to preserve a claim of error for appeal without renewing an objection), we need not decide whether Microsoft properly preserved any § 271(f) arguments."

(emphasis omitted.)

⁵⁵ Federal Rule of Evidence 104(c) reads: "Hearings on the admissibility of confessions shall in all cases be conducted out of the hearing of the jury. Hearings on other preliminary matters shall be so conducted when the interests of justice require, or when an accused is a witness and so requests."

⁵⁶ Federal Rule of Evidence 403 reads: "Although relevant, evidence may be excluded if its probative value is substantially outweighed by the danger of unfair prejudice, confusion of the issues, or misleading the jury, or by considerations of undue delay, waste of time, or needless presentation of cumulative evidence."

⁵⁷ In reaching the conclusion that an expert who created his report for the purposes of litigation and created the methodology at issue for that purpose as well, should not have been allowed to testify, the Sixth Circuit explained in a trade secrets case that "the district court [had] abandoned its gate-keeping function by failing to make any findings regarding the reliability of Stein's testimony." *Mike's Train House, Inc. v. Lionel, LLC*, 472 F.3d 398, 407, 81 U.S.P.Q.2d 1161, 1166 (6th Cir. 2006). The Sixth Circuit emphasized that the fact that an expert's methodology was created for the purposes of litigation supports a conclusion that the testimony was not reliable under *Daubert*. *Id.* at 408, 81 U.S.P.Q.2d at 1166-67.

⁵⁸ There are limitations to motion *in limine* practice. *E.g. McClatchey v. Associated Press*, 83 U.S.P.Q.2d 1095, 1102-03 (W.D. Pa. 2007). When a reply brief on a motion in limine sought sanctions under Title 28 U.S.C. section 1927, the court wrote: "The Court is loath to go down this path and urges all counsel to restore the professionalism with which this case has been litigated to date." *Id.* at 1103.

⁵⁹ See *e.g. Daiichi Pharm. Co. v. Apotex, Inc.*, 2005 U.S. Dist. LEXIS 26177 at *8, *9 (D.N.J. Nov. 1, 2005) (patent case; denying defendant's motion to bar plaintiff from asserting that wrong publication date of a German patent on information disclosure statement was a typographical error; attorney client privilege "should not be heedlessly swept aside"); *McKesson Info. Solutions, Inc. v. Bridge Med., Inc.*,

caselaw holding that it is improper to admit any testimony by a lawyer on questions of law (aside from proof of foreign law⁶⁰) because such testimony invades the province of the court.⁶¹ A motion to exclude such testimony can prevent the problem of a lawyer spouting legal opinions from the witness stand, and can serve to get the trial judge to restrict the scope of the lawyer's testimony. The following are other common examples of situations where motions *in limine* are used: when questions arise concerning the disclosure of materials to an expert witness;⁶² when issues arise concerning attorney-client privilege;⁶³ when questions arise concerning the admissibility of pretrial statements about settlement (such as the offer of a license);⁶⁴ when issues arise concerning the admissibility of electronically stored

434 F. Supp. 2d 810, 812 (E.D. Cal. 2006) (patent case; granting defendant's motion *in limine* asserting attorney-client privilege over an opinion of counsel it received); *U.S. v. Al-Shahin*, 474 F.3d 941, 946-47 (7th Cir. 2007) (affirming denial of defendants' motion *in limine* based on attorney-client privilege, because crime-fraud exception applied); *St. Cyr v. Flying J, Inc.*, 2008 U.S. Dist. LEXIS 39962 at **20-21 (M.D. Fla. May 16, 2008) (denying plaintiffs' motion *in limine* to prevent mention or entry into evidence of work product correspondence, as privilege was waived); *Christopher v. First Mut. Corp.*, 2008 U.S. Dist. LEXIS 32781 at **45-46 (E.D. Pa. Apr. 21, 2008) (granting defendants' motion to preclude testimony of attorney, as barred by attorney-client privilege); *U.S. v. Rozin*, 552 F. Supp. 2d 693 (S.D. Ohio 2008) (denying defendant's motion *in limine* in criminal tax case).

⁶⁰ See generally Fed. R. Civ. P. 44.1.

⁶¹ Several United States courts of appeals have explained that it is improper to allow a lawyer to testify as an expert witness on legal conclusions, to opine as to the law, or to interpret terms and documents for a jury. *Adalman v. Baker, Watts & Co.*, 807 F.2d 359, 365-69 (4th Cir. 1986); *Askanase v. Fatjo*, 130 F.3d 657, 673 (5th Cir. 1997); *Molecular Tech. Corp. v. Valentine*, 925 F.2d 910, 919 (6th Cir. 1991); *U.S. v. Johnson*, 2001 U.S. App. LEXIS 29450 at **22 (6th Cir. Nov. 21, 2001); *Harbor Ins. Co. v. Continental Bank Corp.*, 922 F.2d 357, 366-67 (7th Cir. 1990); *Specht v. Jensen*, 853 F.2d 805, 808-09 (10th Cir. 1988); *Burkhart v. Washington Metro. Area Transit Auth.*, 112 F.3d 1207, 1213-14 (D.C. Cir. 1997); *Endress + Hauser, Inc. v. Hawk Measurement Sys. Pty. Ltd.*, 122 F.3d 1040, 1042, 43 U.S.P.Q.2d 1849, 1852 (Fed. Cir. 1997); *Mendenhall v. Cedarapids, Inc.*, 5 F.3d 1557, 1574, 28 U.S.P.Q.2d 1081, 1096 (Fed. Cir. 1993); cf. *Champion v. Outlook Nashville, Inc.*, 380 F.3d 893, 908 (6th Cir. 2004) ("patent lawyers can serve as experts in patent law").

⁶² Compare Regl. Airport Auth. of Louisville & Jefferson Co. v. LFG, LLC, 460 F.3d 697, 715 (6th Cir. 2006) ("We agree with the district court and the majority view that Rule 26 now requires disclosure of all information provided to testifying experts."); with *Helton v. Kincaid*, 2005-Ohio-2794, at ¶16, 2005 Ohio App. LEXIS 2621 at **8-9 (Ohio App. 12th Dist. Jun. 6, 2005) ("We agree with those courts who have determined that work product does not lose its protected status simply because it is disseminated to an expert."); see generally Sidney I. Schenkier, *The Limits of Privilege in Communications with Experts*, 33 Litig. 16 (No. 2, 2007).

⁶³ Attorney-client privilege issues can be perilous. One court has ruled that the attorney-client privilege did not reach communications of in-house counsel that were viewed as business advice, even though disclosure of the requested documents would allow the plaintiffs to use a reverse-engineering-type of process to determine the privileged advice that counsel had given. *In re: Viox Prods. Liab. Litig.*, 501 F. Supp. 2d 789, 804-05 (E.D. La. 2007).

⁶⁴ The Sixth Circuit's recognition of a settlement privilege, *Goodyear Tire & Rubber Co. v. Chiles Power Supply, Inc.*, 332 F.3d 976, 980-82 (6th Cir. 2003), has been rejected by the Supreme Court of Ohio which refused to adopt it as part of Ohio law. *Ohio Consumers' Counsel v. Pub. Utilities Commn.*, 111 Ohio St. 3d 300, 322-23, 2006-Ohio-5789 (2006). The Sixth Circuit has held that Federal Rule of Evidence 408 does not allow admission of settlement terms or negotiations to prove or disprove mitigation of damages. *Stockman v. Oakcrest Dental Ctr., P.C.*, 480 F.3d 791, 798-99 (6th Cir. 2007). Evidence offered in violation of Rule 408 is properly the subject of a motion *in limine*. *Accord Bridgeport Music, Inc. v. Justin Combs Publ.*, 507 F.3d 470, 480, 84 U.S.P.Q.2d 1449, 1455 (6th Cir. 2007) ("One of the principal justifications for Rule 408 is that evidence of settlement offers is irrelevant [A] settlement offer or the fact of settlement negotiations is not direct evidence regarding the factual issues in a case." (Internal quotation marks and citation omitted) (alteration in original)).

information,⁶⁵ then issues arise concerning the use of an expert to give a preview of closing arguments,⁶⁶ and when issues arise concerning damages based upon speculation.⁶⁷ In long-running litigation it is also proper to prevent an expert from telling the jury the significance or import of a prior opinion in the litigation.⁶⁸

Bench Briefs. The bench brief is a short (ideally two-page) memorandum that is not filed before trial, but is kept handy for use in supporting admissibility, or an objection to admissibility, of an important exhibit. Examples include: a bench brief supporting the admissibility of chain hearsay (showing why each statement within the chain of hearsay is admissible); a bench brief supporting or opposing admissibility of a Rule 1006 summary (as inaccurate, argumentative, or lacking proper foundation); and a bench brief supporting or opposing a Rule 403 argument that an exhibit or piece of testimony is unduly prejudicial.⁶⁹

A bench brief may be made more effective by the inclusion of a chart or diagram which shows the foundation (or, if opposing admissibility, the gaps in the foundation) of an exhibit. The court can quickly see the holes in the foundation, or if an argument of undue prejudice is being made under Federal Rule of Evidence 403, the court can quickly see the prejudicial points, if they are extracted from the document and highlighted.

V. VOIR DIRE

The themes for the opening statement should inform the voir dire questions and trial counsel must watch carefully for reactions to the emotive themes. Of course, voir dire is a process of de-selection (identifying and seeking rejection of jurors likely to be unfavorable). Voir dire questions should include those questions designed to plumb the ability of prospective jurors to understand the technology and other complex facts in the case, and to digest and understand the large amount of opinion testimony inherent in most intellectual property trials. The use of a jury consultant for this purpose is desirable when the size of the case justifies it. Because judges

⁶⁵ The term “electronically stored information” comes from the 2006 amendments to Federal Rule of Civil Procedure 26. See generally Finkelstein, *supra* n. 31, at 13.

⁶⁶ While Federal Rule of Evidence 704 allows an expert to express an opinion on the ultimate issue in the case, it may still be possible to prevent an expert from doing so. *E.g.*, *Patsy’s Italian Rest., Inc. v. Banas*, 531 F. Supp. 2d 483, 485-86, 86 U.S.P.Q.2d 1751, 1752-53 (E.D.N.Y. 2008) (granting motion to exclude expert from testifying at trial about issues of likelihood of confusion and the overall commercial impact of the parties’ trademarks; collecting cases on expert testimony on such issues).

⁶⁷ Speculative damages may also be attacked by motion. *E.g.*, *El Aguila Food Prods., Inc. v. Gruma Corp.*, 131 Fed. Appx. 450, 453 (5th Cir. 2005) (antitrust action; even though a more relaxed burden of proof exists for the amount of damages in an antitrust case than for the fact of damage, “antitrust damages may not be determined by guesswork or speculation,” but rather upon a “reasonable estimate of the damage based upon relevant data”) (internal quotation marks and citations omitted).

⁶⁸ *Cordis Corp. v. Medtronic AVE, Inc.*, 511 F.3d 1157, 1170, 85 U.S.P.Q.2d 1427, 1436 (Fed. Cir. 2008) (“Moreover, it was for the court, not the jury, to interpret this court’s prior opinion.”).

⁶⁹ Fed. R. Evid. 403, *supra* n. 56.

frequently allow notetaking by jurors in intellectual property trials, ask the jurors, “How many of you are used to taking notes in your jobs or other activities?” Then follow up with those note takers, as the jurors who take notes will be more likely to be important participants, and leaders, in the jury deliberations at the end of the case. Ask if they know anyone who has received a patent for an invention, or holds a trademark, copyright, or a license for any of these pieces of intellectual property, or who owns a trade secret. In cases in which there has been publicity, a broad question (“Have you heard or read or do you know anything about the subject matter of this trial?”), which seeks to uncover whether jurors believe they know about the subject matter of the case, is essential.

As there is considerable skepticism about large corporations, counsel may want to ask whether anyone believes that large companies often steal ideas from smaller companies, or from competitors. If jurors respond affirmatively, counsel can ask who disagrees. Depending upon the size of one’s client, it may be advisable to ask for the basis of one or the other of those beliefs. To identify the others in the jury with similar beliefs, ask the panel, “Who else agrees with that statement?” or “Which of you agree with him?”

In addition to the usually-available information about education and jobs, ask how many are computer-literate, consider themselves comfortable with technology, use the Internet, and, having heard from the court and counsel what the case is about, consider themselves to have some experience with the technology, device, or field of endeavor involved in the case. Assessment of jurors’ responses as to their beliefs about the form of intellectual property at issue should be made not by plausibility of the beliefs but by the potential for harm to one’s case. A firmly-held, erroneous but harmless belief⁷⁰ is less of a threat than a belief at variance with a key element of the client’s case.

Most courts’ jury questionnaires ask prospective jurors no questions regarding intellectual property. Ask who believes they know what a patent (or other piece of intellectual property) is, and then follow up by asking the basis of their knowledge or belief, and then asking them to state their belief or definition. Asking such a question is another way to identify people with relevant experience who may not have been forthcoming in response to previous questions. Also ask questions designed to uncover whether jurors have false beliefs, or use false analogies, regarding the type of intellectual property at issue in the case.

⁷⁰ Tongue in cheek, Ambrose Bierce defined “absurdity” as: “A statement or belief manifestly inconsistent with one’s own opinion.” Ambrose Bierce, *The Devil’s Dictionary* 10 (Thomas Y. Crowell 1911). Time and effort spent in disabusing jurors of irrelevant beliefs is profitless; it is time-consuming to dislodge firmly-held beliefs, and too much else must be done in a trial.

Intellectual property cases are typically complex litigation; therefore asking jurors questions about whether they consider themselves problem solvers, or which of them enjoy dealing with complex subject matters, and then which of them do not, can be very useful. Asking them who has to use technical concepts in their jobs or hobbies, and then what they consider to be or believe those technical concepts or problems are will tell something about both the level of sophistication of the panel member, and which jurors do indeed deal with complex technical issues in jobs or hobbies.

Care must be taken in voir dire to blunt the harmful effect of what economists label as the informational cascade: the tendency to replace our beliefs and opinions with those of the crowd. Thus, if a question about the case elicits a panel member's response that is bad for the case, ask who disagrees. Asking only, "Who else agrees with that statement?," risks strengthening that sentiment or belief among the potential jurors.

VI. SEQUENCE OF WITNESSES

There is much conventional wisdom about selection of witnesses in civil trials, and ordering the presentation of evidence. Most of those concepts (calling the opponent's witnesses as adverse witnesses on cross examination in plaintiffs' case; using the primacy/recency principle by beginning and ending strong; bookending a necessary but weaker witness between two stronger witnesses;⁷¹ telling the story chronologically, etc.) are beyond the scope of this article. In intellectual property cases, it is frequently important to determine, when planning the witness sequence, the answer to the question: "What must be explained first so that the factfinder understands what comes later?" While telling the story chronologically is both convenient and frequently easier for jurors to grasp, it can also be boring. Case presentation must use the three Ps: Power, Pace, and Punch. That idea must be balanced, for example, against the idea that explanation of the technology may need to be made early in the case for the factfinder to understand the rest of the liability/non-liability presentation in the case.⁷² One way for the plaintiff to solve this tension is to start with a witness who is either an employee or ex-employee of the defendant, called as on cross examination, or to start with a witness who states or describes the harm caused to the plaintiff by the defendant's conduct. One way for the defendant to deal with the same dilemma is to start with a "good faith" witness, an employee of the defendant who explains that defendant's

⁷¹ Sometimes it is necessary to bookend a client-witness. This problem was described in one of the stories of Rumpole, the mythical English barrister: "I could win most of my cases if it weren't for the clients. Clients have no tact, poor old darlings. No bloody sensitivity! They will waltz into the witness-box and blurt out things which are far better left unblurred." John Mortimer, *Rumpole for the Defence: Rumpole and the Confession of Guilt*, in *The Second Rumpole Omnibus* 13 (Viking 1987).

⁷² See generally Charles J. Faruki, *Litigation Involving Trademarks: Preparing the Trademark Case for Trial*, 16 U. Dayton L. Rev. 85 (1990).

conduct was not targeting plaintiff, or why defendant believed that its conduct was lawful, or the business circumstances that caused or drove the defendant's actions, or the fact that the defendant operates in a market different from that in which the plaintiff operates.

Of course there are different types of intellectual property and there are different types of conduct (e.g., apparently deliberate overreaching and infringement, inadvertent or unintentional infringement, etc.), and the sequence of witnesses to be called will be guided by the facts to be covered and the available raw material (the lay witnesses with knowledge, and the expert witnesses). *Ceteris paribus*, the author's bias is to start strong with an eye-opener, whether that be an adverse party called as on cross examination or a good witness from the client to tell the story chronologically and without excessive details of the relevant technology.

While it is difficult to generalize about intellectual property cases, the choices for witnesses in the liability case typically include: the inventor/creator/compiler; the client or client witness(es) in charge of the project or activity; witnesses to explain the technology or technologies involved; witnesses to explain the defendant's conduct and its effects on the company; and expert witnesses on relevant topics. In defending a case, it is sometimes possible to have two bites at the apple of non-liability: lead with a witness who explains that the defendant's product or process was not the result of copying, theft, or infringement; and then present a separate defense witness who explains that the defendant's product or process was a design-around, or was an independent effort to create the product or process claimed to be a trade secret. Presenting those facts through two different witnesses helps to support a closing argument that there are two separate and independent reasons for a finding of no liability.

With respect to damages, an effective plaintiff's presentation may start with an explanation of the *fact* of damage that has been caused by defendant's conduct, and then to follow with the calculations of the amount of damages. Of course, depending on the type of calculation, it may be necessary to present an expert testifying on markets, financial statements, or other facts before the methodology of the damage calculation, and the calculations themselves, are presented.⁷³

⁷³ The need for complex damage testimony is illustrated by *Mitutoyo Corp. v. Central Purchasing, LLC*:

We hold that the trial court correctly determined that Mitutoyo failed to meet its burden of establishing any market overlap, so as to entitle it to a jury trial on lost profit damages. See *BIC Leisure Prods. v. Windsurfing Int'l, Inc.*, 1 F.3d 1214, 1218 [27 U.S.P.Q.2d 1671] (Fed. Cir. 1993) ("To recover lost profits as opposed to royalties, a patent owner must prove a causal relation between the infringement and its loss of profits. The patent owner must show that 'but for' the infringement, it would have made the infringer's sales."). As discussed above, Mitutoyo's

VII. EVIDENCE AND TRIAL PRESENTATION

Having explored the witness sequence, a discussion of other evidence and trial presentation matters is necessary. Much has been written about trial skills⁷⁴ and innovations in jury trials of complex cases,⁷⁵ which are subjects beyond the scope of this article. In a short trial with few exhibits, organizing the exhibits chronologically and putting the experts' exhibits at the end of the trial exhibits will make it easier to find the exhibits quickly during trial. In a larger, longer case with hundreds of exhibits, exhibit sequence does not matter as a computer will be used to locate and display the exhibits. Given the complexity of many intellectual property trials, a system that will highlight (for example in yellow) passages in text or portions of diagrams will assist a jury in focusing on the relevant portions, will save time in moving through a series of exhibits, and will help to prevent boredom. When using the composite exhibit described earlier,⁷⁶ spend more time on the master summary chart at the beginning of the exhibit, and as little time as necessary to make the rest of the exhibit admissible.

Given the complicated set of proofs in an intellectual property case, how is the evidence to be made, and kept, understandable? There are several methods. In direct and cross examination, it is important, given the complexity of the subject matter, to label or announce the "chapters," or topics, as counsel turns to them. The use of a "big picture chart" as an illustrative aid (not to be admitted into evidence) can smooth and speed the presentation greatly. This chart might be labeled "What _____ will prove" or "Facts _____ will prove" and has the elements of the claim or defense that are being addressed by the witnesses. Such an organizational device is not objectionable in a complex case because it aids juror

calipers are a more complex product than that marketed by Central, and very little price overlap exists. This alone may have been insufficient to support the trial court's conclusion that Mitutoyo's and Central's products compete for entirely different market segments. However, Mitutoyo also did not put any direct evidence into the record to suggest overlap among the consumers buying the companies' respective goods. And Central demonstrated that the demand for its products was highly elastic . . . meaning that Mitutoyo's products are sold almost entirely outside the price range in which Central customers are likely to buy. Taken together, there was no basis from which a jury could have found lost profit damages.

499 F.3d 1284, 1291, 84 U.S.P.Q.2d 1003, 1006 (Fed. Cir. 2007) (alteration in original). The various elements of proof offered or deemed to be missing in that case (price overlap, different market segments, overlap among consumers buying the goods, elasticity of demand) would be the subject of both client and expert testimony.

⁷⁴ See Charles J. Faruki, *Cross-Examination That Hurts the Witness, Not You*, 33 Litig. 38 (No. 3, 2007).

⁷⁵ See e.g. John C. Lowe, *Reinventing an Outdated Wheel: Innovations in Complex Litigation*, 2 Va. J.L. & Tech. 6 (1997); Greg J. Michelson, Student Author, *Note and Comment: Did the Markman Court Ignore Fact, Substance, and the Spirit of the Constitution in its Rush Toward Uniformity?* 30 Loy. L.A. L. Rev. 1749, 1785 (1997).

⁷⁶ See Fed. R. Evid. 803(6), *supra* n. 30.

comprehension, it is not leading the witness, and the court can instruct the jurors that it is not evidence. If an objection is made, the trial brief can be referenced in response, showing that these items are indeed at issue. Then, during the examination, the examining lawyer can check off the items covered with different witnesses; the name of the witness testifying to the point, and the relevant exhibit numbers, can be added to the chart. Those jurors taking notes are likely to replicate the chart in their notes. Care must be taken not to overcrowd the chart; for this reason it must be kept very simple to start with, so that pertinent information may be added. It may even be possible to ask for admission of the chart as a Rule 1006 summary exhibit. On cross examination, asking the witness to help you (involuntarily, of course) make a chart of points or omissions can be a very powerful tool for closing argument. Stopping the cross examination, asking the court reporter to read back the last answer, and saying, "Let me write that answer on the easel so that I can ask you several questions about it," is an effective way to preserve a key admission on cross examination for use in the closing argument, and for use in impeaching the witness with his own answer if the witness later strays from that answer. Such an answer on the easel can also be used in presenting rebuttal testimony; one can ask a friendly witness about the answer on the easel page. If a lengthy or complex explanation of technology is to be presented, another useful illustrative chart is a wheel-shaped or pie-shaped chart with the witnesses' names, or names and photographs, on it. It might be called "the pizza chart," with the slices of pizza labeled with the relevant facts.

What can be done to handle the other side's criticism of the evidence, if one represents the owner of the mark or property? Prepare a chart that is a table of criticisms, and review it with your expert or other rebuttal witness:

Defendant's Claims:

But, the facts:

For example, if the case is a trade secrets case and secrecy, or reasonable precautions to maintain secrecy, is an issue, or if the case is a trademark case and the strength of the mark is an issue, or if the case is a patent case and prior art is an issue, such a chart can list the facts undermining the criticism of one's proof.

In complex intellectual property cases, some lawyers try their cases as if they believe that clarity is their enemy. The form of argument they use is *ignoratio elenchi* (to argue for one point as if it proved another; essentially confusing different, but apparently similar, conclusions). If an opponent's argument is a verbal fan dance, seeking to confuse, or disguise issues of technology or conduct, how can counsel penetrate the obfuscation? One method is by "going back to basics" -- listing the undisputed facts and central realities of the case, and then labeling the opponent's arguments in

closing argument as a deliberate attempt to cloud the issues. The stark contrast between the opponent's murky arguments and the lists of key facts, basic realities, and evidence will show the jury which lawyer is seeking to teach them and to persuade them. Give them a path to follow that is not made twisted by excessive details of technology or proof of damages.

Lengthy trials require special steps to aid juror comprehension.⁷⁷ In addition to allowing jurors to take notes and ask questions, and to receive copies of preliminary instructions, other innovations in jury trials may be used to facilitate comprehension and avoid drowsiness. Imposing limitations on the number of witnesses, experts, and exhibits; giving the jurors a trial notebook with stipulations, key exhibits, and charts; giving the jurors a short tutorial before the trial begins; allowing counsel to give a one-paragraph summary before a witness testifies, of who the witness is and what the witness is expected to say on direct examination; providing deposition summaries rather than deposition Q and A for the jurors; allowing a mini-opening (5-6 minutes) statement before voir dire; minimizing trial interruptions; and making jury instructions understandable and case-specific are techniques that can be used to facilitate sound decision making by jurors.

Quantity does not suffice;⁷⁸ specific facts must be introduced into evidence. To avoid juror boredom, trial counsel must keep the pace moving but vary the stimuli in the trial, humanize the corporate parties and the events in the trial, keep the presentation as simple as possible, and explain both the importance of the intellectual property at issue and how it applies to people's lives. Starting the case with what is familiar to the jurors, and giving them a roadmap through the proof, will assist. The principle of "teach before you advocate" appears to be a good idea, but frequently in an intellectual property case determining what and how to teach the material is difficult. Asking the judge for preliminary jury instructions and for the jurors to have copies of those instructions can also assist.

Simplicity and lucidity must characterize the trial presentation. The maxim "simplify and clarify" applies to each of the stages or components of trial preparation discussed in this article. As part of the work on each task in

⁷⁷ "Lengthy trials demand the most of jurors because of the sheer amount of documentary and testamentary evidence. Furthermore, such cases tend to include evidence that is inherently difficult." Joe S. Cecil, Valerie P. Hans & Elizabeth C. Wiggins, *Citizen Comprehension of Difficult Issues: Lessons from Civil Jury Trials*, 40 Am. U. L. Rev. 727, 750-51 (1991) (footnotes omitted).

⁷⁸ *Black & Decker Inc. v. Robert Bosch Tool Corp.*, 476 F. Supp. 2d 887, 898, 84 U.S.P.Q.2d 1307, 1314 n.4 (N.D. Ill. 2007) ("Also, because Bosch cannot meet its burden of providing clear and convincing evidence by merely entering the alleged prior art references into evidence, the Court need not address any references to which there was no explanatory testimony."). The law frequently requires specificity. *McZeal v. Sprint Nextel Corp.*, 501 F.3d 1354, 1363, 84 U.S.P.Q.2d 1315, 1322 (Fed. Cir. 2007) (Dyk, J., concurring in part and dissenting in part) ("We have consistently held that, under the doctrine of equivalents, to create an issue of material fact a patentee must prove infringement on a limitation-by-limitation basis by submitting particularized testimony.") (collecting cases).

trial preparation, repeatedly asking the question “How can this piece of the case presentation be made simpler or clearer?” is a necessity. As the trial lawyer and his client await the verdict, suffering the existential pain of contingency, it is both necessary and a comfort to know that the trial presentation consisted of clear, powerful, and consistent messages and proof.