

# Intellectual Property Today™

## Handling Appeals in Patent Cases: Tips for Practitioners

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Whether your client is the patent owner or the accused infringer, patent cases are high-stakes litigation. But even if the outcome in district court has gone against your client, all is not necessarily lost. An appeal to the Federal Circuit offers the possibility of redemption.

Published data shows that the Federal Circuit reverses the district court in 17% of appeals – the highest reversal rate for any circuit in civil cases.

Writing an effective appeal brief poses the many of the same challenges in patent cases as in other types of cases. However, some points are unique to patent cases. Here are ten suggestions for briefing patent appeals:

- **Limit the number of issues you raise.** Raising many issues will not increase your chances of success on appeal. As the appellant, your client is better served by raising the three, or at most four, issues that offer the best chance of reversal. Raising more issues will dilute the force of your arguments and increase the danger that strong arguments may get lost in the mix.
- **Consider the applicable standard of review.** Deciding which issues to raise may involve hard choices. In making that decision, it is important to understand that the Federal Circuit is more receptive to some types of arguments than others. For example, the Court reviews claim construction rulings *de novo* as a matter of law, and often reverses them. Moreover, post-*KSR*, the Court is increasingly receptive to obviousness challenges. In contrast, evidentiary rulings and rulings on allegedly improper trial conduct are reviewed under a standard that gives great deference to the district judge. If you have other strong arguments, complaining about evidentiary rulings or opposing counsel's improper conduct probably is not worth the effort.
- **If there will be a cross-appeal, position your client to be the appellant.** In cases involving multiple patents, one side may have won on Patent A, but lost on Patent B. In these cases, the appellant will be the party that files its notice of appeal first; the party that files second will be the cross-appellant. As the appellant, you have the first opportunity to describe the facts, frame the issues and set the agenda for the appeal. In addition, the applicable rules entitle the appellant to nearly 20% more words than the cross-appellant. Of course, if your client prevailed for all practical purposes – for example, the accused product was found to infringe one of your client's patents, but not another – then you should let the other side be the appellant to reflect the fact that your side was the real winner in the district court.
- **Anchor your arguments in the essence of the invention.** Whether you represent the patent owner or the accused infringer, the inventor's solution to a particular problem should provide a focus for your arguments. After all, patent cases are about an invention. The Court will want to know what the inventor contributed and whether the accused product incorporates that solution.

Too often, however, appellate briefs focus in isolation on excerpts from the specification or prosecution history without addressing what the invention contributes. The result can be a brief that seems mired in technicalities. Your arguments can take on added force if they can be connected to the inventor's solution to a particular problem.

- **Write a statement of facts that will make the Court want to rule in your favor.** The key to any persuasive brief is a statement of facts that makes the reader want to rule in your client's favor. This requires marshaling the useful facts and presenting them in a well-organized way to tell a clear, coherent and persuasive story.
- **Generate and maintain credibility.** You want the Court to use your brief – not the other side's – as its guide through the relevant facts and applicable law. That won't happen unless your brief generates credibility and maintains it. Your brief must leave the reader with the impression that he or she can rely on your presentation to be fair and honest. You can generate credibility by fairly portraying the facts and by quoting – not paraphrasing – key portions of the record. The Court will expect you to portray the facts and law in the light most favorable to your side. But bending the truth or stretching the cases will work against you. So will ignoring facts that undercut your argument. It is far better to deal directly with harmful facts, without being defensive.
- **Don't assume that the reader shares your familiarity with the facts.** By the time a case has worked its way to the Federal Circuit, you may have been immersed in it for years. The technology and the vocabulary associated with it may be second nature to you, but they may be much less comprehensible to the uninitiated – unless you take the time to explain them. Showing your brief to a colleague who has not been involved in the case can provide a useful way to learn if you've taken too much for granted in discussing the technology.
- **Use graphics.** More than other types of cases, patent cases often lend themselves to the use of graphics. Concepts that may be difficult to explain in words often become understandable when illustrated. And while a picture may be worth a thousand words, graphics don't count against the applicable word limits.
- **Think creatively about the issues.** In speeches to the patent bar, Federal Circuit judges have signaled a willingness to re-think points of patent law that might appear to be settled. As long as an issue has been preserved for appeal, don't be afraid to raise it on appeal.
- **Critically edit your own drafts.** Appellate briefs require repeated editing. My practice is to prepare a draft well in advance of the due date, then set it aside and look at it later with a critical eye, trying to read the brief the way a skeptical judge would read it. Good editing should address both substance and style. Identify the weak spots in your argument and work on strengthening them. Try to eliminate traces of defensiveness. Consider whether the brief can be better organized. Make sure you've provided support in the record for all facts, weaving short quotes from the record into your argument. Strive for clarity and simplicity of expression. Short sentences are better than long ones. If a sentence or a paragraph doesn't add to your argument, then delete it. Use short headings with active verbs that give the reader a road map for where your argument is heading. Hopefully, the result of editing will be a brief that communicates clearly and directly, and conveys with assurance the correctness of your position.