

3 Reasons IP Cases Still Need General Trial Lawyers

By Erin Coe

Law360, San Diego (March 15, 2016, 1:29 PM ET) -- While they may not have a technical degree or be regular practitioners at the U.S. Patent and Trademark Office, general trial lawyers will always have an important role to play in bringing to life and illuminating complicated intellectual property cases for judges and jurors, attorneys say.

In a two-part series, Law360 examines the benefits that specialists who focus primarily on IP cases and generalists who have broader commercial litigation experience offer to clients at an IP trial.

Here, we take a look at why generalists will continue to remain a key component of IP litigation.

They Know How to Engage the Audience

Even though patent litigation can be highly technical in nature, that doesn't mean there is not a good story to tell. Generalists often make it their mission to find the human angle and explain the case in a way that helps the judge or jury get a handle on the case, no matter how convoluted the facts and law may be.

"I find that if I struggle to understand the case myself, it's easier to put it in terms that the jury or judge will understand and care about," said Aaron Charfoos, a member of Dykema Gossett PLLC who handles patent, privacy and technology-heavy cases and considers himself a generalist. "Patent litigation is also about the human story. ... You don't need a technical degree to show that someone stole something or is following on the coattails of someone else who did a good job. Generalists tend to engage the jury a little bit more."

Like any case, a patent suit comes with a stream of extraneous information that a skilled lawyer must pare down to get the fact finder to center on what's important, he said.

"There is so much in these accused products at issue in the litigation that has nothing to do with the patent and its claims," he said. "I focus on being honest about the technology while simplifying it and removing extraneous details so that they are not distracting to everybody in the litigation."

In defending a client whose technology for managing mobile smartphones was accused of infringing a patent a few years ago, Charfoos and his trial team tried to simplify the case for a California federal jury by boiling the patent claims down to three categories, which he argued didn't apply to his client's technology but did encompass the prior art to invalidate the patent.

The jury found that the patent was mostly invalid yet was infringed by the defendant, but the judge threw out the infringement finding because of misconduct by the plaintiff's lawyers and ruled in favor of Charfoos' client, a decision that was upheld by the Federal Circuit in 2014.

"It was a big win for my client," he said. "There are two audiences — the jury and the judge — and the judge got it at the end of the day."

Specialists sometimes struggle with choosing the right witnesses for a case, according to Steven Moore, a Kilpatrick Townsend & Stockton LLP partner who has focused on patent litigation for more than 10 years but is proud of coming from a general commercial litigation background.

"Most cases are won or lost on the witnesses," he said. "Attorneys might have a case that looks good on paper but doesn't translate with the witnesses, and if attorneys focus too much on the substantive merits of the paper case, they may not be paying attention to how well their witnesses will do at trial. Sometimes attorneys fail to think about their witnesses and the human elements and whether they will be able to sell them to a jury."

They Make the Technical Details Accessible

Generalists also tend to be careful about getting too far ahead of the judge or jury or wading too deeply in the technical nitty-gritty, according to Moore.

"I've seen people try cases who seem to think the jury is made up of a bunch of patent lawyers," he said. "They are focused on the technical patent law requirements and less on making the case accessible and understandable."

But most jurors don't have degrees in the technology in dispute and may not even know what a patent is, according to Moore.

"In the first patent case I worked on, I had never taken an IP course in law school, and I had a friend who was a patent lawyer tell me what a patent was," he said. "I can still relate to what jurors are thinking. Sometimes attorneys rush through telling all the complex details at once and expect jurors to remember everything, but they really need to go slow and explain things clearly."

Charfoos said he has met attorneys throughout his career who believe patent cases should only be tried by those who have earned a technical degree and passed the prosecution bar.

"I've found that the person standing up in the courtroom doesn't need to know every nook and cranny of the technology and doesn't need to have passed the prosecution bar," he said. "What's more important is that the attorney matches up how they explain the case in a way that a person who has not been studying the technology at issue for years can grasp. It's about getting the audience to understand the scope of the claims and what the technology is. Jurors who feel the attorney has helped them with that ... will connect with that attorney better."

Although IP specialists risk getting too technical for a jury, one criticism against generalists is they can sometimes oversimplify the case. But many generalists work closely with specialists to make sure their big-picture presentation fits in with the facts of the case, according to Charfoos.

“I’m very lucky at my firm to have technical specialists in just about every area,” he said. “I talk to them, and they help me work through the technical nuances of a case.”

In many ways, patent cases are no different from any other case, according to Laurie Fitzgerald, a McKool Smith PC principal who has a degree in chemistry. She started her career handling personal injury, breach of contract and other commercial disputes, but she has been handling more patent cases over time. In any type of litigation, she said, lawyers should be able to connect with the jury, have their own style so they are authentic, and be able to clearly explain the subject matter.

“In my experience, attorneys who are the best at trying patent cases are great trial lawyers, period,” she said. “If you have a great trial lawyer who also has IP experience, that’s the best thing a client can hope for in a patent case, but what’s most important is having a great trial lawyer in the courtroom.”

They Ensure a Consistent Legal Strategy

While the Patent Trial and Appeal Board has become a popular venue for patent validity challenges and shifted some of the disputes away from district courts, generalists will continue to have staying power in IP disputes because of their ability to see the broader legal strategy, according to Charfoos.

“Generalists are often the ones who are making the overall strategy decisions,” he said. “I don’t think generalists’ role has diminished, but it has changed, and they are working more with prosecutors.”

While inter partes reviews give accused infringers an easy way to attack a patent, defendants still tend to be most concerned about the risk of an injunction and damages in district court litigation, he said.

“Generalists are still the ones who stand up in court after the dust settles at the patent office and defend the accused infringer,” he said. “They make sure that everything in the district court and the patent office is consistent and that the petitioner is not making admissions at the patent office that could hurt it at the trial court later on.”

Clients are often looking for trial lawyers with experience in the IP and technology involved in a dispute, but lawyers who excel at trying cases generally are still actively being sought after, according to Fitzgerald.

“If you happen to be a generalist over a specialist, you will still find yourself in demand in patent cases,” she said. “At McKool, we have an equal number of generalists and specialists, and clients like to staff cases with a mix of both.”

--Editing by Jeremy Barker and Kelly Duncan.