CHAPTER 21
THE TRIAL
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Chapter 21

THE TRIAL*

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I. INTRODUCTION

From the moment that the possibility of litigation becomes a reality, every letter, every conversation, every event, every pleading, every fact learned in discovery, and every motion made are done in preparation for trial. Each decision made along the way will limit or affect the ability to present evidence or preclude the presentation of evidence by the adverse party. By the time work begins in earnest in anticipation of the imminent commencement of trial, the factual and legal issues have been identified, and the universe of witnesses and documentary evidence has become known and been limited. If, to this point, matters have been handled under the assumption that the case will settle before trial,1 a party will be unprepared to make the best possible presentation of its case. If pretrial matters have been handled under the maximum of si vis

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1 Assuming that a case will settle is not inconsistent with the experience of most patent trial lawyers. Only a fraction of patent cases actually reach the trial stage. For the period ending September 30, 2004, for example, only 3.6 percent (98 out of 2,744) filed patent actions reached trial. See U.S. District Courts—Civil Cases Terminated, by Nature of Suit and Action Taken, During 12-Month Period Ending September 30, 2004, Table C-4, http://www.uscourts.gov/judbus2004/contents.html.
The trial itself will be a seamless extension of the natural continuum of litigation.

The pitfalls and perils that plague other complex litigation exist for patent trials. Yet, the overlay of science and engineering enhances the problems and dangers for the litigator. It is not enough for the patent litigator to know the complexities of patent law and the rules of evidence. The patent trial lawyer must develop an expertise in the technology of the patent.

As with other complex litigation, a patent trial requires painstaking and careful planning and early identification of the determinative facts and legal issues and the documentary and testimonial evidence to be presented at trial. By the eve of trial, having long since identified the universe of possible evidence, the issues will, or should, be as streamlined as possible. The number of issues raised at trial affects the weight and serious consideration that is likely to be given to the totality of the issues. Every additional issue raised dilutes the importance of the issues that came before. Prioritization and selection are the order of the day. Trial should be viewed as a “less is more” proposition. Understatement is more powerful than overstatement. Lead the jury to the right conclusion down a straight and simple path.

Although common myth would have it otherwise, the patent trial does not have to be a dull slog through a mass of hypertechnical details. A well-tried patent infringement trial, particularly when tried to a jury, can maintain its focus on technology while still personalizing the issues presented to the jury. (As most patent trials are jury trials and not bench trials, and for clarity and ease of reading, this chapter is principally directed to jury trials. Distinction is made between the rules or strategy for jury trials and non-jury trials where appropriate.)

2 Patent litigation frequently includes claims of antitrust, trade secret, unfair competition, trademark, breach of contract, or other legal issues. These are outside the scope of this chapter, and issues unique to those additional claims will not be addressed specifically herein.

3 It has become relatively commonplace for a jury demand to be made in patent cases, and the majority of patent trials are tried to a jury, and by 2002 this number increased to 72 percent. See Kimberly A. Moore, Judges, Juries, and Patent Cases—An Empirical Peek Inside the Black Box, 11 Fed. Cir. Bar J. 209, 210 (2001). Statistics on success justify the demand for a jury. For example, juries are more likely than judges to uphold the validity of a patent. John R. Allison & Mark A. Lemley, Empirical Evidence on the Validity of Litigated Patents, 26 AIPLA Q.J. 185, 187 (1998). Juries also are more likely than judges to find patents infringed and willfully infringed at that. Kimberly A. Moore, Judges, Juries, and Patent Cases—An Empirical Peek Inside the Black Box, 11 Fed. Cir. Bar J. 209, 212 (2001). Another reason for both parties to prefer jury trials is the fact that the verdict is rendered shortly after the conclusion of the evidence and not months later.

4 Trial procedure in a bench trial generally differs in several significant respects from that in a jury trial. In a bench trial there is less concern that prejudicial and improper evidence will lead to reversal. Evidentiary issues are handled by the court as objections to evidence as it is adduced at trial. Opening statements and closing arguments are frequently not permitted by judges, who opt to rely instead on the trial briefs and proposed findings of facts and conclusions of law submitted by the parties. Cross-examination is generally shorter and more focused because the judge will want the examination limited to the important issues. Finally, judges will frequently take a more active role in the questioning of witnesses when a jury is not present. It is not uncommon in a patent trial for the judge to ask in-depth questions of the experts regarding the technology, and some judges will avail themselves of plant visits if plants are located in the jurisdiction. Federal Rule of Evidence 611 gives the trial judge great control of the order of presentation, and most judges, in the interests of conserving their most valuable asset—time—will not let counsel drift far down the garden path in a bench trial.
Just as in any other type of case, the jury is interested in the “who, what, where, when, why, and how” of the matters in dispute. The jury not only wants but needs to know the motivation of the actors. The human element of the case is the element with which the jurors feel most comfortable and is as important as—if not more important than—the science and technology in driving the jury’s verdict. Jurors typically care about the reasoning behind an amendment to a claim during prosecution or why a particular piece of prior art was not disclosed during prosecution. Failure to supply motivation will result in its being supplied by the jury, often in a way detrimental to the case. A well-tried patent case is not just about the technology; it is a story, hopefully an appealing one, about the decisions made by people, including inventors, the management of corporations, customers of the respective parties, and many others. The jury needs to understand that decisions were made, as well as when, how, and why they were made. Trial counsel who drone on ad nauseum about the technology do so at their peril.

The challenge for the patent trial lawyers is to find the best way to present a logical, interesting, appealing, and understandable story of complex technology and the people who create it.

II. Preparation for Trial

A. General

There is a theory that the trials most likely to be successful are those for which the verdict has been “reverse-engineered” before trial commences. Application of the reverse-engineered theory invites the first step of trial preparation to be defining the goal or verdict sought and working backward from there. In this scenario, the patentee starts from the premise that it needs a finding of infringement and deconstructs the hypothetical trial, starting first with jury instructions, then crafting of closing argument, taking a step back to define evidence to be elicited through witnesses and documents, and moving backward step by step thereafter. This thesis appears a sensible strategy. In practice, however, it requires a devotion to detail and deconstruction that most lawyers find difficult to maintain. In fact, whether this theory is applied or other theories of trial preparation are adopted, one of the most important attributes for a good patent trial lawyer is organization.

Patent cases are difficult for the jury even when well organized and well presented. If the discovery and pretrial preparation are done with appropriate care and planning, the trial itself will provide few surprises. But organization and teamwork are paramount. Patent cases generally involve a team of many lawyers, extensive discovery involving an enormous amount of document production, a large number of live witnesses, and myriad complex issues. Organization must start at the beginning of the case, not merely at the onset of trial. It begins with the early selection of a core team of lawyers and associated dedicated support personnel who will shepherd the case through discovery to trial under the guidance of the lead trial lawyer. Generally, most of the truly important fact witnesses will have been identified in the Federal Rule of Civil Procedure
26 Initial Disclosures. Ideally, each fact and expert witness will have been assigned to a trial team lawyer who (with the help of junior lawyers) thereafter “owns” that witness, is responsible for developing the scope of knowable information about that witness, and eventually, now that trial is imminent, will prepare to take that witness on direct or cross-examination at trial. Individual legal and factual issues likewise will have been assigned as soon as they became known to the team member who will have consistent responsibility for developing all facts and law pertinent to this issue. The responsibility to manage and evaluate the development and progress of the proof on each issue continues through the completion of trial (and perhaps any appeal) under the overall supervision of the lead lawyer. As the time draws near for the commencement of trial, the universe of information about any given witness or issue is thus available from the responsible team lawyer even while generally being known to the entire team. The facts learned through every person interviewed, every deposition taken, and the key documents presumably will have been recorded in written or electronic form and circulated to every member of the trial team. The wonders of modern litigation-support technology permit the instantaneous sharing and retrieval of all information by any team member if the technology is used effectively and implemented at the commencement of the litigation. Everyone should be on the same page.

There is a special place in trial preparation for in-house counsel, if they are willing to embrace it. Their familiarity with the business of the company and its employees, the invention, the products and processes sold under the patent, and devices and processes accused to infringe postures them to provide significant substantive input. Their personal knowledge of, and relationship with, many of the fact witnesses to be called at trial make them ideally suited to offer encouragement and support and to help soothe the nerves of anxious employees. In-house counsel provide a sounding board for ideas and theories and unquestionably can be a full contributing member of the trial team, albeit one that does not examine witnesses. They are great resources even if not patent lawyers, and it is folly not to take complete advantage of the benefits to be obtained from having them fully integrated into the team.

B. Know Your Judge and the Local Rules

Recently, a number of jurisdictions have adopted rules of procedure specifically directed to patent litigation. But these rules, in large part, do not extend so far as to govern the conduct of the trial. For this, it is important to be mindful of the fact that every jurisdiction, every courtroom, and every judge have idiosyncrasies that will affect the trial and the presentation of the evidence.

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5 See e.g., the United States District Courts for the Northern District of California, the Eastern District of Texas, the Northern District of Georgia, and the Western District of Pennsylvania.

6 Some jurisdictions have very detailed written local rules governing the conduct of counsel at trial. The Local Rules of the Middle District of Tennessee, for example, specifically provide that “attorneys shall stand when speaking” (Rule 12(a)(5) a.); that no counsel may leave the courtroom without permission of the court during examination of a witness (Rule 12(a)(5) b.); that an attorney may not approach the witness without approval of the court (Rule 12(c)(3)); and that all exhibits are to be passed to the witness through the court officer (id).
The practical aspects of patent practice mean that few patent litigators consistently try cases in a single location, including their home jurisdiction, and thus may lack complete and up-to-date familiarity with the particular judge assigned to try the case. A further impediment to thorough personal knowledge of the trial judge arises from the practice in many jurisdictions of deciding pretrial discovery, and even dispositive motions, without oral argument or assigning nondispositive discovery matters and even Markman hearings to a magistrate judge for resolution. In such jurisdictions, the first time the trial team meets the judge who will try the case may be during the pretrial conference or on the first day of trial. Under such circumstances, the trial lawyer will have few, if any, face-to-face contacts with the judge and must by necessity rely on the experience of others.

When lead trial counsel is unfamiliar with the judge, reliance must be placed on knowledgeable local counsel who are familiar with the courtroom idiosyncrasies of the trial judge or have in their firm former law clerks and/or attorneys who have previously been before the judge at actual trials, whether patent or otherwise, where the judge’s trial practices and preferences are well learned. Understanding the judge’s practices and procedures requires being aware of such mundane things as when to stand, the point from which examination can be conducted (e.g., only from the podium, near the jury, sharing space with the witness, etc.), when and if a witness may be approached (and whether or not permission is needed each time), how to present exhibits, how much time will be allotted to try the case, how trial time will be divided and counted, whether the judge is strict or liberal on the admissibility of evidence, how long opening and closing arguments can or should be, how demonstrative exhibits should be handled, whether the judge is an “eye” or “ear” person, the judge’s technical background and prior patent experience, whether the judge likes or respects patent attorneys, and myriad other details that ensure a smooth and effective presentation of evidence. Determination of the judge’s prior experience and rulings in patent cases is important, and copies of all prior opinions should be obtained as early as possible if available. Up-to-date standing orders or written statements that many judges issue as guides on how they want things done should also be obtained.

C. Planning the Trial Presentation

1. Narrowing the Issues

The first step in developing the trial presentation is to determine the issues to be tried. There are two questions to be asked in assessing the merits of any issue: What am I trying to prove? and Why am I trying to prove it? There are, of course, legal issues and factual issues to be considered. The larger legal issues are determined early on during the pleadings stage and, if they have survived summary judgment, are not likely to be narrowed on the eve of trial. This big picture of the case is fundamental and pretty well carved in stone once the date passes for amending the pleadings. Infringement, invalidity, patent misuse, inequitable conduct, and any other counts of the complaint and counterclaims must still be proven. The overriding questions still remain: Is
there infringement? Was there copying? Is the patent valid? What are the damages? But the elements that comprise the big picture will and should change as the case progresses, at least to some degree. As to infringement, an honest and hard assessment must be made as to which claims of the patent-in-suit will be asserted at trial as being infringed and which elements of those claims are the essential focus of proof of infringement (or noninfringement). As to invalidity, among many other considerations, an assessment should be made of such things as whether to continue to press anticipation or to focus instead upon obviousness. Assessment of the merits of claims for damages, of course, requires a consideration of whether to seek lost profits or a reasonable royalty or present proof in the alternative. Even after these decisions are made, myriad smaller issues are still to be decided: What is the best art to put forth on obviousness? Should evidence of price erosion be presented in the lost-profits analysis? And so on.

Different approaches are applied in selecting the theories and issues to present at trial. One method is the use of jury consultants, discussed in more detail in Section III.E, who provide advice based on mock trials or focus groups, among other methods. But before undertaking the considerable expense of jury consultants, there are other less costly but still effective ways to narrow the issues for trial. One is based upon the method employed especially in graduate programs or at scientific meetings to defend a theory, thesis, or premise. Team members are assigned individual issues and prepare a presentation that includes all factual evidence to support the legal theory and any difficult evidence undercutting that support. The predicate facts are set forth in a chart. In a brainstorming session, the facts are attacked by the team and defended by the responsible team member until a conclusion is reached regarding whether the issue will be presented at trial and, if it will, what evidence will be adduced to support it. This only works, of course, if the brainstorming session is totally open, without regard to whether the presenter is a partner or associate. It should mimic the sort of give-and-take done by the jurors in their deliberations, if at all possible. It can be successful only if certain basic governing principles are applied: (1) there are no bad ideas and should be no criticism; (2) in the first instance only the facts can be challenged; (3) the rules of evidence are irrelevant (for the moment); and (4) after the facts are narrowed to those likely to be successfully proven, all reasonable and even unreasonable inferences based on the facts must be evaluated fairly. Free discourse, the ability and willingness to challenge a premise, will serve to identify the arguments that are strongly defensible and persuasive.

The overarching goal, of course, is identifying which issues will be persuasive; which will resonate with the jury in some fashion and tap into some basic value; and whether the proof on the issues can be elicited in a reasonably coherent fashion. Yet even while identifying the most persuasive elements of the case, it is imperative to develop an honest assessment of the unavoidable weaknesses of the case. All cases have at least some bad facts and adverse legal issues. This evaluation must be done as early as possible before trial to permit sufficient time to plan how best to curtail their effect at trial.

As to all marginal or troubling facts, there are several questions to be answered: whether they are likely to surface at trial, whether there will be
grounds for excluding those facts, and, if not, how the facts should be treated at trial. Whatever the shortcomings may be, difficult facts must be properly managed in order to be discounted by the jury. The answer may be as simple as preparing a motion in limine (if the fact is surely known to the opposition). But if they cannot be excluded, the facts must be finessed through testimony. Pretrial preparation that does not confront and plan to address the deficiencies in a case is self-destructive. Generally, the party who raises the issue controls the issue. Bad facts left unacknowledged are an invitation to the opponent to introduce and characterize the evidence in the most negative light. Minimize the potential damage to be caused by the shortcomings of a case by raising them first. If a potentially harmful fact is to be dealt with at trial, rather than before, preparation must be made as to how it will be disclosed and how it will be explained, justified, distinguished, or excused so that the jury will be desensitized to it. Once this is done, move past it. There is no benefit in dwelling on difficult facts. It is essential to dictate the scientific, factual, and legal battles to be fought before the other party sets the agenda.

2. Educating the Jury

After the issues have been evaluated and narrowed, it is time to plan the presentation of the proof on each issue. In this regard, it is essential to consider the audience who will hear the proof. For the period of the trial, the jurors are akin to students, hoping to learn the facts and technology presented and, in the process, to be led to the appropriate verdict through the orderly presentation of the evidence. In this regard, the presentation of a case at trial is best likened to teaching a science class. The lawyer presents or frames the facts in a way that permits the jurors to be sufficiently well versed so that they can reach a fair and just decision. Information set out in discrete bites, each small enough to digest and understand, is the foundation for a favorable verdict. Counsel will have had months or years in which to understand the technology—the jury or judge has days or weeks. Individual jurors may have been turned off by science during their educational experiences or may be afraid that they will not be able to grasp the technology. It is the patent trial lawyer’s task to overcome this initial apprehension.

All decisions by the jury are driven by the way the issues are framed and the evidence presented; the success in any trial is contingent upon counsel’s ability to present a persuasive and understandable case that will maintain the

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7 This method of presentation is curiously, and far too often, avoided in the patent trial, much as in other complex trials. Judge B. Michael Dann, retired judge of the Superior Court of Maricopa County, Arizona, has commented that most trials fall short of providing an optimal learning environment. He noted that there is a stark contrast between the presentation of information to juries and to college students. The familiar jury system, in which virtually everything relevant to sound learning is concealed—what the subject is, who the teachers are, what the point of the exercise is, how long the class will take, what will be on the examination, when it will be given, with discussion among the students banned and note-taking prohibited—would summarily be rejected in any college classrooms.

interest of the jury. The cardinal rule of any jury trial is to avoid boring the fact-finder. This is especially so in a patent case before a jury. Once a juror loses interest in the presentation, it is unlikely that his interest can be resurrected.

In preparing the trial presentation, it is important to keep in mind that all people learn through one or a combination of visual, auditory, and tactile methods. All persons, not just jurors, retain significantly more information if it is received both visually and aurally. Thus, hearing testimony while viewing an exhibit enhances the likelihood that information will be understood and retained by the jurors or judge. Plan to reinforce the learning process, and build the jurors’ confidence in their ability to understand the technology, by preparing to present the necessary facts through as much variety and repetition as may be done without taxing the jurors’ patience, and as permitted by the court. This will go a long way in reducing the jurors’ anxiety regarding the technology.

Jurors and most judges are unfamiliar with science, engineering, and even the language and trade lingo used so frequently by patent attorneys. Even as to the law governing patent cases, most judges find it impossible to feel confident in their understanding of the law because the average judge hears a patent case once every few years. Both judge and jury are looking for help throughout the trial. They want to understand the evidence and the issues and want to reach the proper result at the end of the case. The trial attorney’s job is to direct them to the right result. When the facts and issues are complex, the jury will instinctively look for a trustworthy guide through the maze. Credibility is the lawyer’s most important characteristic. The ability to win any case is tied to developing a bond of trust with the jury through actions in the courtroom. Credibility is earned; it is not a gift. Respond quickly and competently to issues raised and new developments. Be understanding and understandable. Use plain and simple language. Be plausible and reasonable. Give deference to the judge, and act respectfully toward opposing counsel and witnesses. Each of these factors into the jury’s measure of the veracity and reliability of the lawyers.

3. Persuading the Jury

It is generally accepted that jurors apply a “story model” to develop their understanding of the evidence presented at trial and are likely to adopt the story line that is most easily understood. In other words, the jury will create a story model to understand the evidence if one is not presented to them. This

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8 Information presented solely through a lecture format is retained at a rate of 5 percent. This increases to 10 percent for information conveyed through reading, 20 percent for information conveyed by audiovisual presentation, and 30 percent for information conveyed by means of a demonstration. The numbers jump significantly when the learner affirmatively participates in the process. The rate of retention for information presented in a discussion group is 50 percent, 75 percent when learning is practiced by doing, and 90 percent when learning is put to immediate use. See Proceedings of the Second Western Regional Conference on State-Federal Judicial Relationships, October 11–13, 2000, at 7–8, http://www.ce9.uscourts.gov/Web/OCELlibra.nsf/0/1d9f6c825f879ac388256e090068ef9/$FILE/State-Federal%20Proceedings.PDF.

is a key consideration during the planning of the trial presentation. The “story”
cannot and should not focus only on the science and technology—a lawyer
who brings no more to the story than science will not connect with or persuade
the jury. Given the predisposition of jurors to place the facts and evidence
presented at trial into a story model, lawyers are most likely to persuade juries
if they present their theory of the case in this context. Stories have beginnings
and endings. They occur in a given place and at a set time. As in any good
novel, they have interesting characters—some good, some bad. The characters
say things, do things, and have events happen to them. Even in patent cases,
the reality is that evidence can fit this model. Presenting the fundamental “story”
of the technology, the creative process of the inventor, and the facts surrounding
infringement in a logical and chronological account will greatly increase the
comprehension of, and will persuade, the jurors.

The concept of persuasion is usually characterized as an “art” as in the
“art of persuasion.” Like other art forms, it must be tailored to the artist—here
trial counsel—and the persuasive elements must be considered in light of the
audience—here the jury. The question that must be asked is, What techniques
will most effectively be used to persuade this jury? There may be variations
from one jury to the next, but the methods of persuasion adopted in the trial
setting remain consistent.

As a first matter, the presentation must accommodate the personality and
style of trial counsel if it is to be believed. Some lawyers excel at rhetoric;
others fail in delivery of the grand statement and look foolish. Jurors are
sensitive to dishonesty in all its forms. A personal style, above all, must
be sincere.

The story must be presented in language familiar and comfortable for the
jurors. If they are to be persuaded, they must first understand. The choice of
words, especially the key words that unlock the core of the story, are an essential
element of persuasion. Every case has its own vocabulary. Choose it, define
it for the jury, and use it to emphasize the story of the case.

To be persuasive, the story presented to the jury must be straightforward,
concise, and uncluttered. The adage that a straight line is the shortest distance
between two points is applicable here. The simple story line is the easiest to
follow. Nothing is gained by asserting infringement of every claim or putting
forward every possible prior art reference or every theory of invalidity. Facts
learned in discovery should permit concentration on only the strong points of
the case. Not every theory can be effectively presented. Comprehension, interest,
and attention will suffer greatly unless the jury can find a consistent and
relatively simple unifying theme in the presentation.

The story must be comprehensive. It must address all the issues to be
presented and the theme of the case. The facts as woven together must account
for all pertinent facts, whether they be good facts or bad. The theory or model
must address all important inconsistencies in the evidence or be able to explain
why the inconsistencies are not material to the issues before the jurors. The
theory must confront every deficiency to avoid ceding the issue to the opposition.

Lead; don’t push. If the story unfolds piece by piece in a natural progres-
sion, the jurors will reach the obvious conclusion. Show them the way; don’t
tell them.
There must be internal consistency to the story adopted. Alternative theories are appropriate in the pleading and discovery phases, but they have no place in trial. Here, consistency is king. By far, the overriding rule of good advocacy is to avoid confusing the audience. Promoting multiple justification, rationalizations, and theories makes for divergent argument and jury confusion. Asserting a position regarding validity that is inconsistent with the position espoused on infringement is dangerous, particularly before a jury that is likely not to see the subtleties of the arguments.

The story must provide the opportunity for the jurors to identify with some aspect of it. It must be plausible when measured against the “ordinary man” standard. Jurors bring their own expectations of human behavior to the deliberations. They bring their own opinions as to what is possible and what is reasonable. If the issue is whether an inventor withheld material prior art during prosecution, the jurors will evaluate intent based upon their own experiences.

The story presented must demand a satisfying verdict. Jurors are reluctant to reach a result that is personally distasteful. A claim such as willful infringement must provide an explanation that will overcome the juror’s natural tendency to avoid concluding that someone failed to conform to societal rules. A finding of infringement requires only a weighing of the evidence. A finding of willful infringement, especially when the corporate representative is a personable and likable witness, requires presenting a case that will leave the jurors comfortable, even satisfied, in their verdict.

The relief sought on the basis of the story must respect conventional values, particularly of the community in which the trial occurs. Some jurisdictions from which jury panels are drawn are more conservative or more liberal than others. This will influence the facts that can be used to persuade. The jury drawn from a community beset by unemployment due to plant closings likely will not be as receptive to the same theories (particularly as to damages) as a jury drawn from a community experiencing a period of economic boom.

The story presented must accommodate the ordinary beliefs of the jurors. Jurors have certain preconceived notions regarding the patent system and the behavior of corporate parties. Studies have demonstrated that jurors believe patents to be difficult to obtain and lasting far longer than they do. Jurors (reflective of societal beliefs in general) also believe that companies steal ideas from each other on a regular basis; that companies make one or two insignificant changes in an old idea and assert that it is new; and that patents hurt competition. Because jurors are more likely to believe facts that are consistent with their beliefs, it is important to present a story or theory of the case that works with, rather than against, the general notions of the jury.

Finally, the model for the story adopted, and its related theory and themes, cannot be rigid. It must permit adjustment during trial if the case does not unfold as expected. The story will guide the selection of exhibits, the witnesses and their order of presentation, and the evidence presented. It must allow for

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adjustments to be made in response to the nonverbal feedback from jurors. If jurors show lack of interest or skepticism through body language, then reasonable, believable, and subtle modifications will be required. To be successful, the story, and all potential modifications, must be given serious thought as early as possible in the trial preparation process.

D. The Pretrial Statement and Conference

1. The Pretrial Statement

Essentially every trial is conducted pursuant to extensive pretrial statements prepared by the parties and approved by the court. Most jurisdictions do not have requirements for the pretrial statements specific to patent cases, leaving such matters instead to the trial judge. Although practice varies from jurisdiction to jurisdiction, most pretrial statements are extremely detailed. They typically set forth a narrative statement of the case (with factual and legal contentions), a statement of any unusual legal issues, the identification of all witnesses to be called, together with a short but detailed offer of proof on their testimony; attach copies of expert reports; and provide lists of exhibits and narrative summaries or designations and counterdesignations of depositions to be used at trial, including videotaped depositions. Some jurisdictions require a statement of objections to exhibits or other unique items. Except as used for impeachment, the pretrial statement captures the universe of potential evidence, and anything not identified therein generally will be excluded at trial unless used for impeachment purposes.

Because the pretrial statement normally governs the subsequent conduct of the trial and will limit what can and cannot be proven at trial, every member of the trial team must know completely the contents of the pretrial statement as well as the local practice with respect to after-the-fact modifications of the information contained in the statement. Most jurisdictions will not allow any exhibit to be introduced or any witnesses to be called, except for impeachment purpose, unless they have been precisely identified in the pretrial statement or good cause can be established for the omission. Attempted proofs or presentation of legal and factual issues not fairly noticed in the pretrial statement may be

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11 Many jurisdictions do, however, have local rules governing the scope and content of pretrial statements in any civil case, including patent cases. For example, the United States District Court for the Western District of Pennsylvania Local Rule 16.1.4 requires that the pretrial statements exchanged by the parties and submitted to the court include (but are not limited to):

1. a brief narrative statement of the material facts to be offered at trial;
2. a statement of all damages, including their amount and method of calculation;
3. the name, address, and telephone number of each witness, distinguishing between those that definitely will be called and those that might be called;
4. designations of all witnesses to be called through deposition with a designation of the page and line numbers of the deposition transcripts;
5. the identification of all exhibits to be offered, distinguishing between those that definitely will be offered and those that might be offered;
6. a list of all legal issues that should be addressed in the final pretrial conference;
7. copies of all expert disclosures under Fed. R. Civ. P. 26(a)(2); and
8. copies of the reports of any treating physician.
The trial rejected unless good reason can be shown why they were not set forth originally. This is particularly true in patent cases where multiple experts are frequently called and pretrial expert reports and expert depositions are intended to prevent surprise testimony or positions at trial.

As discussed in Section III.C, many judges allow the jury to receive three-ring binders or notebooks containing key documents (such as the patent, any stipulations of the parties, preliminary jury instructions, etc.). In such cases, the court generally requires that the parties agree on those items that will comprise the initial content of the notebooks. The list of the items to be included in the notebooks at the commencement of the trial should be stated (and possibly attached to) the pretrial statement to avoid disputes on the first day of trial.

In a similar vein, some courts permit the jurors to take notes or ask questions during trial as a method of boosting juror comprehension and understanding of the evidence. Some judges do not. If the court generally does not, the parties should consider making a formal motion to the court to permit note taking and juror questions or, at least, to including a formal statement in the respective pretrial statements regarding these matters.

2. Stipulations

Patent cases involving multiple patents, claims, or products (or processes) are particularly difficult to try. When more than a few claims are at issue and in aid of juror comprehension, the parties should consider reaching a stipulation (to be included in the pretrial statements) limiting the presentation of proof to representative claims or products (and processes). This helps to avoid confusion of the judge or jury and permits the presentation of evidence in a more coherent, easily understood manner. By doing this, of course, the parties are waiving any objections and rights of appeal related to the nonrepresentative claims, products, or processes. This is a frightening proposition for many patentees and accused infringers, but a more frightening proposition is presenting proof on a dozen asserted claims against a dozen accused products or processes. The

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12 Some jurisdictions have adopted local rules clarifying the dangers of failing to disclose fully the evidence to be offered at trial. For example, the Western District of Pennsylvania provides:

Failure to fully disclose in the pretrial statements (or, as permitted by the court, at or before the final pretrial conference) the substance of that evidence proposed to be offered at trial, may result in the exclusion at trial, at a hearing or on a motion unless the parties otherwise agree or the court orders otherwise. The only exception will be evidence used for impeachment.

Local Rules for the United States District Court for the Western District of Pennsylvania, LR 161.4.G.

13 There has been a groundswell of support for jury note taking in recent years, although it is not a new idea. Judge Avern Cohn of the Eastern District of Michigan adopted juror note taking and even permitted juror questions in patent cases as long ago as the early 1990s. In every patent case, Judge Cohn provided counsel with written “Requirements for a Patent Case” that included the following statement: “Jurors will be permitted to ask questions and take notes. The Court will screen the questions at the conclusion of each witness’s testimony.” Recently, the American Bar Association, in its American Jury Project, prepared “Principles for Juries and Jury Trials” delineating principles to promote juror understanding of the facts and the law during trial. Specifically, its Principle 13—“The Court and Parties Should Vigorously Promote Juror Understanding of the Facts and the Law”—provides:

Jurors should be instructed at the beginning of the trial that they are permitted, but not required, to take notes in aid of their memory of the evidence and should receive appropriate cautionary instructions on note-taking and note use. Jurors should also be instructed that after they have reached their verdict, all juror notes will be collected and destroyed.
possibility of error and jury confusion is magnified with each additional claim or product. Regardless of whether one is the plaintiff or the defendant, controlling the length and confusion of trial far outweighs the waiver of one of the multitude of appellate issues.

Trial counsel additionally should work diligently toward preparing a comprehensive statement of stipulations regarding such elements of the facts as can be agreed upon, including the prior art, the inventive process and file history, the background of the technology, and sales of accused products. This avoids the tedium of presenting proof on preliminary facts not truly in dispute. The jury can absorb, retain, and understand only so much information in any given day or any given trial. Written stipulations that can be referred to during deliberations will significantly ease the job of the jury. If properly drafted, they also will lay the foundation for presentation of evidence in an orderly, cogent fashion. A word of caution, however, as to the drafting of stipulated facts: Jurors, as would any person, will naturally draw inferences from any set of given facts. In drafting stipulated facts, counsel must evaluate and consider all inferences that reasonably (or even unreasonably) might be drawn from those facts, particularly when coupled with such adverse testimony as may be adduced at trial.

3. Transitional Statements

Although many judges remain uncomfortable with the use of transitional statements, the complex nature of a patent infringement trial lends itself well to the use of these statements as the trial progresses. Transitional statements are statements made by counsel at various points in the trial but are typically made between witnesses. They are designed to aid and educate the jurors about what is to come and to assist the jury in processing the evidence by putting the forthcoming new evidence into context. Transitional statements regarding the science help tie the opinion testimony of experts to testimony from fact witnesses. Jurors welcome being told what to expect from a new witness, including identification of issue(s) to which the testimony will relate.

If transitional statements are to be used during the trial, and because transitional statements are unfamiliar to many judges (and lawyers), it is important to seek the entry of a written order governing the process. The proposed order should be submitted with the pretrial statement and should set forth the parties’ agreement on the timing, length, and content of the statements. Typically the court is amenable to an allocation of a preset total amount of time for transitional statements. This allotted time may be used by each party at that party’s discretion, except that the use may never be made for the purpose of disrupting opposing counsel’s presentation. The proposed order should set forth whatever parameters are necessary to prevent just this sort of abuse of the transitional statements. Typically the lawyers are permitted to speak directly to the jury and may, depending on the judge, be able to comment upon the

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14 A model order regarding interim statements appears in Appendix B (Model Order No. 26 “Order re Interim Statements, Arguments, and Instructions”).
The evidence presented thus far. The statements may not be argumentative and may be used only to illuminate the significance of the evidence to the issues in the case or to refresh the jurors’ recollection of earlier testimony so they can understand how the upcoming evidence fits together with the prior evidence.

The novelty of the transition statement may make it awkward for counsel unfamiliar with the technique. But it has particular value in any complex or lengthy case before a jury. Jurors do process, weigh, and form opinions regarding the evidence as it is elicited. They make assessments as to the credibility of the evidence and the credibility of counsel. Likelihood of a verdict in favor of one party increases after direct examination and decreases after cross-examination as the trial progresses. Transitional statements can be used to help the juror keep an open mind by confirming that evidence on a particular issue is not complete.

4. Bifurcation of Issues

The question of whether to seek bifurcation of trial on liability from trial on damages no doubt has been explored and perhaps even raised with the court long before the final pretrial conference. If it has, and the court denied bifurcation at an earlier point (efforts at bifurcation of discovery are typically denied), it may be well nonetheless to raise the issue a second time at the pretrial conference when, no doubt, more facts are available to support bifurcation. Indeed, bifurcation is frequent in patent cases and recommended by some courts and authorities. There is little doubt that separating already complex or highly

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15 Federal Rule of Civil Procedure 42(b) authorizes district courts to bifurcate actions into separate trials for several reasons: convenience, to avoid prejudice to one party, or when separate trials will be conducive to expeditious trial and the preservation of judicial resources. See Gardco Mfg., Inc. v. Herst Lighting Co., 820 F.2d 1209, 1211–12, 2 USPQ2d 2015, 2017–18 (Fed. Cir. 1987); Union Carbide Corp. v. Montell N.V., 28 F. Supp. 2d 833, 837 (S.D.N.Y. 1998); see also Saxion v. Titan-C-Mfg. Inc., 86 F.3d 553, 556 (6th Cir. 1996).

16 A statistical analysis of patent infringement trials during 1999 to 2000 confirmed that the issues of damages and willfulness were bifurcated from liability in 34.5% of the cases. At first blush, this percentage suggests that bifurcation is not as likely to be granted as it is to be denied, but these percentages do not account for the number of cases in which bifurcation was never requested. It is believed that if cases in which bifurcation was not requested were excluded from consideration, the percentage of motions for bifurcation that were granted would be substantially above 50%. Kimberly A. Moore, Empirical Statistics on Willful Patent Infringement, 14 The Federal Circuit B.J., 227, 235 (2004).

technical issues from the complex issues of damages will serve to enhance juror comprehension.

If the court did not bifurcate on its own initiative, and even if a motion to bifurcate trial was previously made and denied, it is still appropriate to request bifurcation at the pretrial conference. A persuasive argument for bifurcation, as renewed at the pretrial conference, will emphasize that (1) the issues to be bifurcated are significantly different from one another, (2) bifurcation of the issues will result in judicial and party economies, and (3) bifurcation of issues will avoid prejudice to the parties.18

Bifurcation certainly eases the task of the jury by parsing the issues and evidence into small chunks. Additionally, if liability is found in a bifurcated trial, the parties could potentially minimize further expense by negotiating a settlement. The costs to be saved by potentially obviating a damages phase are likely to be dramatic. Litigation of damages generally includes a massive amount of documents and accompanying expert testimony addressing various alternative measurements of damages, including but not limited to a purported reasonable royalty rate or an elaborate calculation of the accused infringer’s profits from its distribution of its allegedly infringing product. The expenditures of time and money that introducing such evidence on these points will entail can and should be safely deferred, given the considerable possibility that trial on these issues can be avoided altogether.

Many accused infringers will seek bifurcation to prevent evidence of willfulness and damages from being presented to the jury before the jurors reach a verdict on infringement and other issues. By the time the pretrial conference has occurred, the accused infringer will have a substantially complete idea as to how the patentee intends to prove willfulness, thus raising again the specter of jury prejudice during their deliberations on infringement, validity, and inequitable conduct. This is a double-edged sword, however, for a jury having mixed feelings on validity may find the patent valid and infringed and award minimal damages if presented with all the evidence at once. A larger damage award may result if the jury is left in a bifurcated trial with only damages to decide.

Rather obviously, the party opposed to bifurcation should argue that the facts and evidence are so inextricably woven that it would be manifestly unfair and prejudicial to that party’s case if bifurcation were granted.19 Of course, in response, the patentee will argue, for example, that evidence of the accused infringer’s revenues and profits will be presented during the liability phase in support of commercial success, one of the secondary considerations of nonobviousness, and thus the evidence is overlapping and bifurcation unnecessary.20

18 See, e.g., Union Carbide Corp., 28 F. Supp. 2d at 837; Slater Elec., 223 USPQ at 730.
19 Slater Elec., 223 USPQ at 730-31. See also Shepard v. International Bus. Mach. Corp., 45 F.R.D. 536, 536 (S.D.N.Y. 1968) (noting that “[t]here is no doubt that separate trial of the issues of validity and infringement will provide a more rapid trial. The issue of damages is often more complex than the issues of validity and infringement. Trial of all three issues would only clutter the record and tend to confuse the jury.”).
5. Consent to Trial of Issues by the Jury

Patent cases have many equitable issues that are tried to the court rather than the jury. Whether there has been inequitable conduct before the Patent Office and whether a patent is invalid are issues of law for the court, not the jury.21 Issues of fact for the jury related to liability include infringement,22 whether the best mode is disclosed and other Section 112 written description requirements,23 novelty,24 the factual underpinnings of obviousness such as scope and content of the prior art, consideration of analogous versus nonanalogous art, the differences between the prior art, the differences between the prior art and the asserted claims, the level of ordinary skill in the art, and objective indicia of nonobviousness.25 Both damages26 and willfulness27 are issues of fact for the jury. Even so, Federal Rule of Civil Procedure 39(c)28 permits trial of any issue to a jury, or with an advisory jury, if the parties have consented.29 In common practice, under the auspices of Rule 39(c), legal issues in patent cases frequently go to the jury. This is particularly so when there are complex factual determinations to be made by the jury that underpin the legal issues. Inequitable conduct, for example, is commonly tried to the jury.30 Because underlying factual issues

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21 See Gardco Mfg., 820 F.2d at 1212, 2 USPQ2d at 2018 (stating the defense of inequitable conduct is “equitable in nature” and does not give rise to the right of a jury trial). See also Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 720, 223 USPQ 1264, 1275 (Fed. Cir. 1984), in which the court noted: [Jury] instructions [on obviousness] are typically drafted in general terms charging the jury to consider the above factual inquiries (which is, in large part, a paraphrasing of the statute, 35 U.S.C. §103), and decide the issue of obviousness. Indeed, the instruction appears in standard forms as the correct instruction. We do not so regard it.

22 Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261, 1271 (Fed. Cir. 1986).


27 Hoechst Celanese Corp. v. BP Chem., Ltd., 78 F.3d 1575, 1583 (“willfulness is a question of fact to be submitted to the jury”) (Fed. Cir. 1996); National Presto Indus., Inc. v. W. Bend Co., 76 F.3d 1185, 1193 (Fed. Cir. 1996).

28 Rule 39(c), Advisory Jury and Trial by Consent, states:

   In all actions not triable of right by a jury the court upon motion or of its own initiative may try any issue with an advisory jury or, except in actions against the United States when a statute of the United States provides for trial without a jury, the court, with the consent of both parties, may order a trial with a jury whose verdict has the same effect as if trial by jury had been a matter of right.


30 The Federal Circuit has held that inequitable conduct is an issue of law for the court. Gardco Mfg., Inc. v. Herst Lighting Co., 820 F.2d 1209, 1212, 2 USPQ2d 2015–18 (Fed. Cir. 1987) (“‘inequitable conduct’ is derived from the doctrine of unclean hands and is purely equitable in nature”) (citing General Tire & Rubber Co. v. Watson-Bowman Assoc., Inc., 74 F.R.D. 139, 141, USPQ 484, 485 (D. Del. 1977)). However, the jury frequently and appropriately makes findings as to the elements of intent and materiality that are the underpinnings for the court’s determination, as well as on the issue of whether the conduct was inequitable. Hupp v. Siroflex of Am., Inc., 122 F.3d 1456, 1465–66, 43 USPQ2d 1887, 1893 (Fed. Cir. 1997). Id. at 1213. The finding of inequitable conduct or patent misuse is the predicate step for a determination that a patent is unenforceable. While the jury frequently makes the findings regarding materiality and intent and will even weigh the factors to determine if there is inequitable conduct, the issue of whether that conduct makes the patent unenforceable is uniformly decided by the court.
of obviousness are jury issues, the determination of invalidity is often made by the jury in concert with its determination of the factual issues underpinning invalidity. In both circumstances, the court may permit the jury to make the ultimate determination regarding inequitable conduct or validity, provided both parties affirmatively consent or when the court instructs the jury to make determinations regarding these issues and neither party objects. The trial judge has discretion as to how the ultimate determination will be made, and the Federal Circuit has indicated that it will not disturb the court’s choice of procedure unless there is a clear showing of prejudice or failure to achieve a fair trial.

The trial judge may exercise her discretion in several ways. She may choose to address legal issues without the assistance of the jury. If this is the case, and the issue is inequitable conduct, the patentee likely will not want the jury to hear evidence of misconduct and may ask the court to bifurcate the issue from the rest of the trial. The testimony regarding withheld prior art or affirmative misrepresentations and whether there is materiality and intent is not germane to other patent issues. The presentation of this evidence to a jury is likely to be prejudicial to the patentee by casting the patentee in a bad light. If the ultimate decision is to be made by the judge, there is no good reason for the evidence to be presented to the jury.

If an issue of law, such as inequitable conduct or the ultimate consideration of invalidity, is to be determined by the jury, special interrogatories should be submitted to the jury for findings on the underlying factual issues. The court may treat the jury’s findings in this regard as merely advisory, but the parties certainly may consent to a determination by the jury on the ultimate legal issues as well as the underlying facts. No one approach is universally favored over the others, although some facts may play better to the jury than the court. Whichever approach is adopted, the methodology for resolution of these legal issues should be set out in the pretrial statement and not left to be decided during the court’s consideration of final jury instructions and special interrogatory-

31 Factual issues related to validity that must be decided by the jury include utility, enablement, whether the patent contains a written description of the invention, whether the patent describes the best mode of carrying out the claimed invention contemplated by the inventor at the time of filing of the patent application, novelty, prior use or sale, obviousness, and secondary considerations of nonobviousness.

32 Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 719–20, 223 USPQ 1264, 1274 (“it must be left to the sound discretion of the trial court what form of verdict to request of a jury”) (Fed. Cir. 1984), See also Railroad Dynamics, Inc. v. A. Stucki Co., 727 F.2d 1506, 1515, 220 USPQ 929 (Fed. Cir. 1984) (“[I]t is neither error nor dangerous to justice to submit legal issues to juries, the submission being accompanied by appropriate instructions on the law from the trial judge.”) (emphasis in original), and Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1569, 1 USPQ2d 1081, 1084 (Fed. Cir. 1986) (“[T]he obviousness/nonobviousness issue is a legal issue and may be submitted to the jury with proper instructions.”).

33 Duro-Last, Inc. v. Custom Seal, Inc., 321 F.3d 1098, 1110, 66 USPQ2d 1025, 1032 (Fed. Cir. 2003) (treating the jury findings as advisory since both parties agreed that the district court intended them to be treated as such).

34 Hebert v. Lisle Corp., 99 F.3d 1109, 1114, 40 USPQ2d 1611, 1614 (Fed. Cir. 1996); see also General Electro Music Corp. v. Samick Music Corp., 19 F.3d 1405, 1408 (Fed. Cir. 1994) (explaining that because Samick requested that the issue of inequitable conduct be decided by special jury verdict and both parties consented to a jury trial of all factual issues, special verdicts had the same effect as if the jury trial were a matter of right. In such circumstances the special verdicts cannot be treated as advisory).
ries. Indeed, the Federal Circuit has specifically counseled that a pretrial order from the court should clarify the methodology adopted:

Similarly, courts should consider pretrial orders in jury trials that specify precisely what the jury will be asked to do after it has been given instructions prepared in light of the evidence and at the end of its deliberations: (1) return a general verdict (“we find for plaintiff/defendant”); (2) return a general verdict accompanied by answer to factual interrogatories prepared in light of the evidence; (3) return special verdicts on specific issues appearing in the evidence (“we find for plaintiff/defendant on the XXXXXXX issue”); or (4) merely “advise.”

6. The Final Pretrial Conference

At the final pretrial conference, witness lists, exhibits, motions in limine, preliminary and final jury instructions, verdict slips, and other pretrial matters will be discussed and objections entertained (although many judges defer any consideration of final jury instructions and verdict slips until the conclusion of the evidence). To expedite the trial, most judges will rule upon objections to exhibits at the pretrial conference. If the judge does not, and a particular exhibit will be referred to in the opening statement, a specific ruling should be obtained so as to avoid drawing an objection in the middle of the opening statement. The use and admissibility of models that will be in the well of the courtroom and visible when the jury first enters should be addressed and rulings thereon entered by the court.

Frequently, a judge will rule on some motions in limine, leaving others for another day when the record is better developed. This is far too frequently the case in patent trials because the judge often is not confident enough in his or her understanding of the technical (and legal) issues in these early stages. A motion on which a definitive ruling has been obtained before the start of trial need not be renewed during trial to preserve the objection. But if the judge fails to make a definitive ruling on a motion, it must be renewed at trial the first time evidence subject to the motion is about to be offered. Otherwise, the objection will be waived.

As a method of controlling the case, it has become common in patent trials for courts to limit the time allotted for each party to present its case. While this practice helps judges to manage their own calendars, it has the effect of forcing the lawyers to be more concise in their presentation and generally is a benefit to the process of trial, assuming the court is reasonable in its allocation of time. Time limits should be discussed in detail at the pretrial conference, with particular attention given to the methodology applied by the court to counting the allocated minutes. Some judges simply start the clock

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35 Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1571, 1 USPQ2d 1081, 1084 (Fed. Cir. 1986).
36 Fed. R. Evid. 103(a). The 2000 Amendment to this Rule “provides that a claim of error with respect to a definitive ruling is preserved for review when the party has otherwise satisfied the objection or offer of proof requirement of Rule 103(a). When the ruling is definitive, a renewed objection or offer of proof at the time the evidence is to be offered is more a formalism than a necessity.”
when examination of a witness begins by a party and stop it when the examination ends, charging the time against the party examining the witness. The assumption in support of this practice is that any time spent arguing objections during witness examination will even out in the end. This may be the case when there is one plaintiff and one defendant, but it works to the detriment of the plaintiff when there are multiple defendants. A discussion should be instituted at the pretrial conference regarding a method for requesting more time during the trial if multiple defendants are intentionally carving into a plaintiff’s time by belaboring objections. Confirmation should be made as to whether opening statements and closing arguments are counted against the clock. If the court has limited the time allocated so much that it makes it impossible to reasonably present the necessary evidence, a formal objection should be made on the record that the time limit set by the court is insufficient for presenting proof and the party is being harmed as a result.38

It is a good practice to ask the court to enter an order at the pretrial conference governing such things as the use of technology at trial (such as the parties agreeing on the use of common courtroom hardware and software if possible), daily exchange of lists of upcoming witnesses and exhibits, and statements of deposition summaries (if they can be agreed upon) or a list of portions of deposition transcripts to be read or shown.39

III. The Jury

A. Introduction

Most jurors have had little personal experience in a courtroom setting, yet they bring with them their individual beliefs and expectations about the legal system, judges and lawyers, and the roles of judges and lawyers. Some of these are accurate, some are not. Many jurors will not have a lawyer of their own and perhaps have never met a lawyer, except in passing. Television, popular fiction, and newspapers provide an image of the typical lawyer that likely is not consistent with reality. Lawyers representing certain types of large corporations (insurance and chemical companies in particular) come to court saddled with the black hat of the juror’s negative perceptions. Those jurors whose knowledge is limited to the fictional lawyer may be willing to believe that lawyers, if provided the chance, will manipulate the rules and perhaps the law and the facts. It is a matter of human nature that information consistent with belief is more easily accepted. That which is inconsistent with belief is more likely to be rejected than accepted. Actions in the courtroom frequently will be measured by jurors against preconceived notions of how fictional lawyers behave. The trial lawyer who is overly aggressive and ruthless, who stretches

38 See Daly v. Far Eastern Shipping Co. PLC., 238 F. Supp. 2d 1231, 1236 (“A party must raise its objection to a time limit during the trial” and affirmatively identify the harm suffered.) (W.D.Wash. 2003), aff’d, 108 Fed. Appx. 476 (9th Cir. 2004).
39 See Appendix B, Model Order No. 21, “Order re Certain Aspects of Trial Administration,” for a typical order regarding trial administration.
otherwise strong points beyond reasonable grounds, fights battles that cannot be won, contests trivial matters, objects to every piece of evidence, and wastes the jury’s time will quickly be believed consistent with the negative stereotype. Similarly, the lawyer whose presentation of evidence is convoluted and overly complex may be viewed as intentionally muddying the waters of truth. The predicate step to any successful presentation to a jury is developing a bond or sense of trust with the jurors.

The jury pool is comprised of individuals yanked out of the routine of their day-to-day lives by the obligation to serve. They are there to serve and want to serve effectively. But with rare exception, they each have other things they would much rather be doing. From the start, it is imperative not to waste a moment of their precious time or keep them in attendance a moment longer than necessary.

Jurors instinctively want to put a case into a context that will lead them to a right rather than a wrong conclusion. They want and need to believe that the system works. Research on jury decision making actually confirms that jurors handle their obligations competently.\textsuperscript{40} Despite the misgivings of some, jurors are capable of understanding complex cases if the case is presented effectively.\textsuperscript{41} Indeed, most jurors will work diligently to understand complex issues and facts, at least up to the point at which it becomes plain to them that the presentation is not designed to aid comprehension.

In patent cases, jurors have two formidable hurdles to overcome: learning the scientific and technical information and understanding complicated and often confusing instructions on the law. Much like judges, jurors want to hear the information that will help them decide the case, and they will respect and will credit the lawyers who provide the necessary information if it is presented in a manner comprehensible to the average juror. Too often, the presentation in the courtroom does not provide the jurors the best opportunities to learn the science or understand the legal issues. If understanding the technology is beyond their grasp because the presentation is inadequate, the jurors will still need to develop trust in the integrity and honesty of trial counsel and a personal sense of the witnesses and what motivated their actions. Nowhere is this more important than in issues like inventorship and inequitable conduct.

In less complicated cases, the pooling of individual jurors improves recall of the evidence by each juror because the give-and-take of group discussion during deliberations helps to fill in the gaps in the facts and enables the discovery and correction of any incorrect assumptions regarding the evidence.\textsuperscript{42} Although

\textsuperscript{40} \textit{Jury Trial Innovations} 1 n.2 (G. Thomas Munsterman, Paula L. Hannaford & G. Marc Whitehead eds., 1997).

\textsuperscript{41} A discussion regarding the advisability of using juries in complex cases such as patent infringement actions appears in Paul R. Michel & Dr. Michelle Rhyu, \textit{Improving Patent Jury Trials}, \textit{Fed. Cir. Bar J.}, 89, 90-91 and n.5 (Summer 1996) (“Some suggest that jurors, mostly people of only average education and intelligence, cannot properly decide complex cases, particularly technological disputes. Jury defenders answer that jurors have not been shown to be any less competent technologically than generalist judges.”). See also discussion of studies regarding jury decision making in D. Lee & Michelle Evans, \textit{The Charade of Trying A Patent Case for All “Three” Juries}, \textit{8 Tex. Intell. Prop. L.J.}, 6 (Fall 1999).

the dynamics of juror deliberations remain the same, the task of sorting through
the law and the evidence increases in difficulty with the complexity of the
scientific and legal issues. Without any doubt, improving clarity of the presenta-
tion improves the understanding of the jurors. If the jury does not comprehend
the evidence, it is likely the fault of the presentation and not the jury.

Jurors, despite the court’s instructions to the contrary, do not merely absorb
the evidence as it is presented and await notice by the court that it is time to
commence deliberations. Just as the evidence is evaluated by the respective
trial teams and the court as it is presented, so too is it evaluated and weighed
by the jurors. It is critical in a patent case that the jurors do evaluate the
evidence as it is received if they are to have any hope of understanding it. The
technology and the facts presented are complex. If the jurors are not actively
processing the information as it is received, it will be lost before deliberations
are commenced, or it will be very poorly understood. One of the most important
methods used to assist the jurors in being active listeners, prone to processing
the information as it is received, is the use of juror note taking (discussed in more
detail in Section III.C). This enables the jurors to reinforce their understanding of
testimony by writing down important facts.

As a final note, jurors are not merely the same as the “average man”—they
are the average person, drawn from a cross-section of the community. Like any
average person, they appreciate courtesy and teamwork among counsel. Any trial
team that fails to demonstrate common courtesy among the team and to others in
the courtroom does itself a disservice with the jury. Likewise, failure to work
together as a team shows a lack of respect not only for fellow team members but,
because it invariably delays the progress of trial, to the jury and judge as well.

B. Jury Selection

Jurors are not selected. Rather, potential jurors are “de-selected” during
voir dire. It is a process of winnowing, designed to cull those jurors who are
expected to have a bias or who potentially may react unfavorably to the case
presented. The purpose of voir dire is to learn as much information as possible
about each of the prospective jurors even where judges limit the role of the
lawyers in voir dire and the types of questions that can be asked of prospective
jurors. When possible, it is important to learn whether prospective jurors are
likely to be open-minded and to learn their attitudes toward advancing technol-
yogy, their familiarity with the field of technology of the invention, their attitudes
 toward monopolies and the patent system (this is especially important with
younger jurors in cases related to computer technology), and any other informa-
tion pertinent to the particular patent or technology.

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43 Not all courts require this instruction. Since 1995, jurors in trials of civil cases in Arizona have
been instructed that, subject to certain limitations, they may discuss the evidence in the jury room as the
trial proceeds. See id. at 138–39.

44 Some commentators argue that jurors make an initial evaluation of the relative merits of the respective
parties’ positions early in the case, some as soon as opening statements have concluded, and then are
To obtain the maximum benefit from voir dire and enhance the likelihood of selecting the best individuals for the panel, there are certain simple guidelines:\textsuperscript{45}

- Make a good first impression. The prospective jurors assess the lawyers with as critical an eye as the lawyers assess the prospective jurors. Counsel are not the only ones in the courtroom who “observe and learn.” So, too, do the jurors. Courtesy, propriety, knowledge, and organization should rule the day. The potential jurors and the judge assess the words and body language of counsel. In this way, early appraisal is made of counsel’s credibility and the degree to which counsel believes in her case. While counsel is picking the jury, the jurors are deciding whom to trust. First impressions are hard, if not impossible, to undo. It is common knowledge that people cling stubbornly to first impressions, even when later facts seemingly contradict them.

- Observe and learn. It is important not only to hear the verbal answers of the jurors but to attend to the nonverbal cues, the body language, that constitute a modification or clarification of a verbal response.

- Make a connection. While a prospective juror is being questioned, be attentive. If counsel is doing the questioning, make eye contact. Demonstrate sensitivity to the potential jurors by not asking questions that will embarrass a juror unless the answer is essential. In this case, it may be appropriate to ask the court in advance if detailed voir dire can be done in the court’s conference room on an individual basis.

- Ask open-ended questions. Questions that beg a yes or no response do not leave open the possibility of hearing the thoughts of the prospective jurors. Find out what they watch on television, what they like to read, and what is important in their lives.

- Speak English. Questioning during voir dire in technical terms or legal-ese will alienate some of the jurors. Most jurors will not know the difference between a plaintiff and a defendant any more than they can distinguish a spectrometer from a barometer. Chances are that at least one person in the panel had a visceral dislike for the smartest kid in the class way back in high school. Do not give him the chance to make a connection between then and now in that regard. Do not talk above the jurors. Use commonly understood language and explain necessary terms that may not be commonly understood.

- Keep it short, or at least as short as possible. Many judges or jurisdictions don’t permit lawyer-conducted voir dire for the very reason that the process is abused far too often.\textsuperscript{46} The unnecessary

\textsuperscript{45} An interesting and more detailed discussion regarding the process of jury selection in civil cases is presented in Kenneth P. Nolan, \textit{Jury Selection}, 16 Litig. 24–26 (Spring 1990).

\textsuperscript{46} The Western District of Pennsylvania, for example, has local rules that limit the voir dire of jurors to the clerk or the representatives of the clerk, although frequently the trial judge conducts voir dire. United States Western District of Pennsylvania, Local Rules of Court 47.1. The rules specify five general questions to be posed to the jurors collectively, such as: Do you know any of the parties? Do you know anything about this case? The rule then contemplates 11 questions to be posed to jurors individually, directed to residency, employers, and similar matters. All other questions must be submitted to, and approved by, the trial judge in advance. As a matter of general practice, additional questioning is carefully screened by the trial judge.
waste of time will be mentally assessed as a negative impression of
counsel doing the wasting.

- Avoid the juror as an expert. If someone has significant background in
the technology, odds are he or she will be a leader during jury deliberations. Be
cognizant of the fact that individual jurors are subject to the
same perils of human nature as everyone else. Most will tend to accept
at face value those statements that are strongly and confidently made.
They are susceptible to giving in to the herd instinct. Chances are good
that someone educated in the technical field will substitute his opinion
for that of the parties’ experts, will strongly argue that position, and
will, as a result, be followed in that opinion by other jurors.

Whatever rules may be applied in jury selection or yardsticks applied for
measurement of the jury pool, a fundamental rule of jury selection is to be
aware that the prospective jurors are taking the measure of counsel as well.
Once trial begins, jurors may not fully understand the details of technology or
the meaning of patent claims, complex diagrams, formulas, and expert testi-
mony. But they likely have spent their lives reading people and deriving impres-
sions from their demeanor and reactions to events. The process of jury selection
is their first opportunity to develop impressions of trial counsel and trial coun-
sel’s first opportunity to connect with the jurors. This impression will be
modified or honed throughout trial. But first impressions are hard to set aside.

C. Juror Notebooks, Note Taking, and Questions

Involved audiences are more likely than passive audiences to care about,
think about, and evaluate the content of what is presented to them. Permitting
the jurors to have their own copies of key documents, to take notes, and to
ask questions increases the jury’s involvement with the trial and thus their
attention to the presentation of the respective cases. This in turn leads to a
better understanding of the difficult material that is presented to the jury. The
complex nature of a patent trial lends itself well to the use of these tools to
simplify the jurors’ task.

Juror notebooks are individual to each juror and will be marked with the
juror’s name, collected at the close of the day’s evidence, and redistributed at
the start of the next day of trial. Jurors are permitted to retain and refer to their
notebooks during deliberations. If admissibility can be agreed upon in advance,
and subject to the court’s approval, selected key documents should be included
in the juror notebooks at the commencement of the trial. In addition to pertinent
exhibits, some suggestions for documents to be contained within the juror

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47 One commentator has noted, “Law school teaches us the core of lawyering as logic, precedent, and
reasoning. The way people connect, are persuaded, and respond, however, depends more on feelings, facial
expressions, and affect.” Alan K. Cotler, *Face Time Before a Jury*, 31 Litig. 8, 10 (Winter 2005).
48 See *JURY TRIAL INNOVATIONS* 110 (G. Thomas Munsterman, Paula L. Hannaford & G. Whitehead
eds., 1997); and see Model Case Management Orders for Patent Cases, Model Order No. 23, “Order re
Juror Notebooks.”
The Trial

notebooks include paper for taking notes; the patent (with the asserted claims highlighted for emphasis); an agreed glossary of terms, especially terms such as “specification,” “file history,” “claims,” “claim elements,” and the like; a short statement of the parties’ claims and defenses; stipulations of the parties; curricula vitae of the experts; a list of witnesses by name, including identifying information and photographs; a seating chart for the courtroom that identifies all trial participants; a chronology or timeline of events; and the court’s final jury instructions. Throughout trial, the notebooks should be supplemented by additional key exhibits approved by the court. In this case, at the end of each trial day (or before the start of the next day), a member of each party’s trial team should work with the court’s clerk to update the contents of the notebooks, to include exhibits to be covered the next day, and to add a new index to aid in the location of exhibits during trial. These notebooks can be used most effectively if the jurors are alerted to the presence in the notebook of an exhibit to be discussed so as to allow them sufficient time to locate it and follow along as the testimony progresses. It should go without saying, however, that the contents of the notebooks should be limited to the most critical documents. If the notebook becomes unwieldy, it loses its essential purpose of focusing the issues. Remember, the rule that “less is more” is just as applicable here as in other phases of the trial.

Most judges who permit juror notebooks will also permit the notebook to contain writing paper on which jurors can take notes to supplement any annotations of exhibits in the notebooks made during testimony. Although this is unlikely, note taking by any individual juror may be so extensive that it prevents full attention to testimony and other presented evidence. In this event, it is appropriate to ask the court for a cautionary instruction clarifying, at the bare minimum, that (1) the jurors are not required to take notes and that those who do take notes should not take extensive notes, (2) the note taking is designed merely to be a memory aid and should not distract the jurors from paying full attention to the evidence, and (3) jurors who do not take notes should not permit their independent recollections of the evidence to be swayed by the notes taken by another juror. To assure maximum benefit to the jurors of the process of note taking, the jurors should be advised and assured that their notes are confidential and will not be shared with either counsel or the court and will be destroyed at the end of trial.

Not many judges are comfortable with permitting jurors to ask questions during trial. But if handled properly, it greatly enhances the individual juror’s attention during examination of witnesses. Presenting a request to the court to permit submission of questions by jurors should emphasize the need for special

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measures required by the complex technology to ensure maximum comprehension by the jury.

If appropriate procedures are in place, juror questions will not disrupt the flow of trial. Typically, the court instructs the jurors regarding the process of submitting questions during the preliminary instructions. Included among the instructions are cautions that any questions posed should relate to important points only and be limited to clarification of testimony; that questions should not be posed that advocate a position but instead should be neutral in context; and that the jurors should not weigh the response to their questions more heavily than any other question posed to a witness.

The process generally permits individual jurors to submit questions in written form to the judge, via the judge’s clerk, at the close of a witness’s testimony. The judge reviews the question, makes it part of the record, and discloses it to counsel outside the presence of the jury. The judge then entertains any objections to the question by counsel and rules on the objections. Counsel is permitted the opportunity to suggest modifications to the questions to eliminate any objectionable matter. The judge generally permits counsel to pose the question and to ask any follow-up questions that may be necessary, although some judges prefer to pose the question themselves and to limit any follow-up questions.

An important part of the equation, however, is that the court provide instruction to the jury in the preliminary instructions, possibly repeated in interim or final instructions, explaining that not all questions posed by jurors will be asked of the witnesses and to explain that evidentiary rules may preclude some questions. The jury needs to understand that some questions are objectionable on evidentiary and other legal reasons and that no negative inference is to be drawn from the court’s refusal to ask a particular question.

The benefits of permitting jurors to ask questions extend to the lawyers as well as the jurors. While enhancing the jurors’ comprehension and making them feel a part of the proceedings rather than mere voyeurs, juror questions provide counsel with an “in-time” assessment of how well the jurors are understanding or misunderstanding the presentation, provide insight into whether a lawyer is connecting with the jury, and identify evidentiary areas that the jurors see as pertinent to their deliberations. Experience has shown that the questions posed by jurors tend to be relevant to the testimony and seriously designed to clarify the evidence presented.

Each of these tools has significant benefit in the patent trial. They increase the jurors’ sense of participation and thus their attention to the presentation. They aid the jurors’ memories regarding difficult or complex issues and help them to reconstruct the testimony during deliberations. Patent trials far too frequently (and possibly unnecessarily) are weeks (and sometimes months) long. Providing means to help the jurors remember the testimony during this period is critical to a fair and just verdict.

50 The procedures discussed in this section are based in part on Model Case Management Orders for Patent Cases, Model Order No. 25, “Order re Juror Questions for Witnesses.”
D. Jury Tutorials

The “jury tutorial”\textsuperscript{51} is appropriately used when the presentation of evidence will require the jury to absorb unfamiliar technology. It is an essential and important tool in highly technical or complicated cases. Judges who hear many patent cases frequently are amenable to the use of some form of tutorial to aid the jury’s understanding of the industry and the specific technology at issue. This can be extremely detailed or a general overview, depending on the judge’s practices. Some judges will permit the presentation to be made only by a neutral expert selected by the court.\textsuperscript{52} Other judges will permit trial counsel, within well-defined limits, to make the presentation as part of an opening statement. The tutorial introduces the minimum basic material required for the jury to understand the evidence, and it is essential that it be agreed upon by both (or all) parties. Another version of the tutorial is one presented solely to the court as part of the pretrial proceedings to educate the judge sufficiently that he or she will be able to rule on evidentiary issues.\textsuperscript{53} In this case, the respective parties may be permitted to present separate tutorials.

The pretrial statement should contain a proposed agreed-on specified format for the tutorial, if one is to occur. It should indicate the degree of formality of the presentation and precisely when it is to be presented. Often, the most beneficial form is to adopt the classroom lecture format with the jurors having a limited and well-controlled opportunity to ask questions to clarify the material presented. Some judges require the tutorial to be prepared jointly by the parties and presented in videotape or electronic format. This has the advantage of being able to be submitted to the court in advance of trial to permit the judge to rule on whether the tutorial is appropriate for viewing by the jury. The tutorial may and should be part of the trial record, but it is not evidence upon which the jury may base its verdict. The jury should be reminded of this in the preliminary instructions and again after the tutorial and possibly in final instructions.

E. Jury Consultants (Litigation Support)

Jury consultants are widely and successfully used in most large patent cases. Consultants provide a range of services, including telephone surveys, mock juries, shadow juries, witness preparation, and focus groups, as well as aid in preparing and using exhibits at trial, among others. The argument supporting the use of jury consultants is based upon the reality that jurors, like all people, interpret new information differently based upon multiple factors, including education, religion, ethnicity, cultural orientation, the geographic region of their upbringing, and individual personal values. The consultants’ work is directed

\textsuperscript{51}The use of the term “jury tutorial” here is not intended to suggest that a tutorial is beneficial only in jury trials. The use of a tutorial in bench trials is actually a more commonplace practice and frequently utilized during the process of claim construction at the \textit{Markman} hearing.

\textsuperscript{52}Proceedings of the Second Western Regional State Conference on State-Federal Judicial Relationship (Oct. 11–13, 2000), at 8.

to developing an understanding of the background of potential jurors to such a detailed degree that decisions can be made at trial based upon those understandings. Their role typically is one of suggesting the facts and issues that will be most persuasive at trial and ways of presenting them in the best possible light. They assist in developing a persuasive case story to present to the jury. But they also can identify societal attitudes that may have an impact on the case. During voir dire, jury consultants can help formulate questions to flush out individual prejudices, particularly those related to the industries or types of businesses of the respective parties; identify behavior patterns of potential jurors that may be undesirable; or catch nuances in body language of the prospective jurors that may be missed by the trial attorney.

In the mock jury context, the case is usually presented to a mock jury in brief argumentative form through an opening statement. The mock jurors who are selected to hear the statements are chosen at random from the area in which the trial will be held. An opening statement by the patentee is followed by a series of specific questions, possibly in questionnaire form, presented to the jurors. The same scenario is followed for the presentation of an accused infringer and a rebuttal presentation. Afterward, there is a mock deliberation, together with jury instructions and submission of a special verdict form. The jury’s deliberations are usually private but videotaped for review by the trial team.

Myriad variations of the mock jury are used by different consultants, but the goals are generally the same: determine the issues prospective jurors might struggle with or identify with, obtain suggestions for improvement, identify the issues that the jurors believed to be not adequately addressed, identify the most and least persuasive arguments, and identify questions not answered. Of particular importance in patent cases is determining what type of evidence will assist in understanding the technology and learning reactions to specific exhibits or witness testimony related to the technology. The mock jury permits counsel the opportunity to test a different theme or story model and to develop a strategy for the order or sequence of presentation. Remembering that jurors form opinions early in the case, whether instructed against it or not, it is important to develop a sense of which issues will resonate with the jurors and then develop a strategy to unfold the evidence on those issues early in the trial. In patent cases, the mock jury is particularly helpful in determining the floor of knowledge for a particular science (i.e., how far the technology has to be “dumbed down” to be understood). It assists in the presentation of the case by forcing the trial team to perform an analysis of the best case presentation that might be made by the other party. Knowing this may cause a change in strategy or presentation.

The unquestionable benefit of using a mock jury is that trial counsel can observe the jury’s discussions to learn their reactions to the case theme and story model and can develop a sense of how jurors are able to influence one another on particular issues.

Another tool of jury consultants is the focus group. This is not as time-consuming for the trial team as a mock jury, and it is less expensive. Although it provides less overall information, it is still a useful tool. A well-run focus group will help identify the factual inquiries that will be of the most interest to the juries and the facts that the jury believes to be most persuasive. For the
results to have any degree of reliability or validity, the focus group, like the
mock jury, should be selected from a fair cross-section of the community from
which the jury itself will be selected.

The temptation to rely heavily on mock trials, focus groups, and other
tools of the jury consultants is certainly attractive, particularly in preparation
for patent trials, but there are some things jury consultants cannot do. They
cannot, for example, predict the opponent’s case or how it will be presented.
They cannot account for a witness’s failure to perform competently on the
stand, nor can they predict jury verdicts or guarantee a cross-section of the
same types of jurors used in the mock jury or focus group. These things make
the difference between a case won or lost but are governed only by random
chance and the vagaries of fate.

F. Pretrial Jury Instructions

Frequently, too little attention is paid to preliminary jury instructions.
Each instruction from the court, whether given before, during, or after trial, is
important and cannot be overlooked as a potential source of support for the
theory of a case. Of course, every judge has a standard set of preliminary jury
instructions covering general matters such as the jurors’ obligations, the format
of the trial, burdens of proof, and other preliminary matters. But these will not
include instructions pertaining to patent law or, rather obviously, instructions
that will put the case at hand into context for the jury. The court’s standard
preliminary instructions need to be expanded, if the court permits, to include
as much information as is necessary to set the jury off down the right path in
their understanding of the case and their role in the trial process. It is critical
that these instructions provide a background of the technology to the extent
possible (particularly if the court does not permit jury tutorials), as well as a
brief summary of the law. As former Justice Sandra Day O’Connor has noted:

[J]urors should be given general instructions on the applicable law before the
case begins. How are they to make sense of the evidence and the mass of
information that the parties will put before them, unless they know in advance
what they are looking for? Jurors are not mere receptacles in which information
can be stored, to be retrieved intact when the jurors are finally told what to do
with it. Jurors are people, and people organize information as they receive it,
according to their individual frames of reference. Unless they are given proper
frames of reference at the beginning of a case, jurors are likely either to be
overwhelmed by a mass of information they are incapable of organizing, or to
declare their own frames of reference, which may well be inconsistent with what
the law requires.54

The court will most likely order, and it is best to work diligently toward
preparing, a joint set of preliminary instructions that present a fair and cogent
picture of the task before the jury. In addition to a discussion of the technology,
consider proposing instructions on the patent system, the file history, the role
of expert witnesses, the significance of the technology used in the courtroom,

and any other general element or issue that may aid the jury’s understanding. These preliminary instructions, along with the patent and glossary of terms, are key elements to be included in the juror notebooks at the commencement of trial.

G. Post-trial Instructions

Final jury instructions are the educational vehicle to inform the jurors of the governing legal principles. A comprehensive set of post-trial jury instructions should be one of the first documents prepared in anticipation of trial.\textsuperscript{55} Because jury instructions define the case, these instructions will guide the preparation of the case and the selection of witnesses and exhibits and will shape the testimony to be elicited. They provide the frame upon which to drape the fabric of the case. They dictate the form and substance of the opening statement as well as the closing arguments. If properly drafted, they provide a road map for the jury to reach a verdict that will be upheld on appeal. They serve a second purpose as well by detailing every element of proof necessary to prove a case.

As the instructions are prepared, it is a necessary and beneficial exercise for the trial team to identify every fact that will be relied upon to support each element of proof identified in each instruction (or to rebut the proof elicited by the opposing party for those counts for which the opposing party has the burden of proof). Knowing the facts that will need to be presented is the first step. After the universe of necessary facts is determined, consideration should be given to how those facts will be admitted into the record. If live testimony can be used, a determination must be made as to the best witness to use to present the particular testimony. If no live witness can present the facts, but deposition testimony can be used, a listing of deposition designations should be made. All exhibits to be used in conjunction with presentation of the facts must be compiled, whether the exhibits are to be admitted or used only for demonstrative purposes.\textsuperscript{56} The jury instructions and analysis of the source of proof are too important to be left to the end.

The pretrial order will have made provision for the exchange of final jury instructions\textsuperscript{57} before the commencement of trial. Judges who have tried few or no patent trials may follow their ordinary practice regarding the exchange of instructions, a practice generally not more sophisticated than requiring the

\textsuperscript{55}Of course, in bench trials, jury instructions are not necessary. However, the parties will be required to submit proposed findings of facts and conclusions of law in their stead. They not only summarize the case but also lay the foundation for the court’s findings of fact and conclusions of law required under Federal Rule of Civil Procedure 52(a), as well as a party’s motion under Rule 52(b) to amend those findings, should one become necessary.

\textsuperscript{56}This exercise has the added benefit of serving as the preliminary witness outline. One simply reads the annotated instructions, looking for each witness’s name and identifying the facts allocated to his or her presentation.

\textsuperscript{57}The timing of the submission of requested jury instructions is governed by Federal Rule of Civil Procedure 51(a)(1), which provides that “[a] party may, at the close of the evidence or at an earlier time that the court reasonably directs, file and furnish to every other party written requests that the court instruct the jury on the law as set forth in the requests.”
parties to exchange proposed instructions, agree upon whatever can be agreed upon as to the law, and submit the instructions in a single document denominated "Joint Proposed Jury Instructions," with each side setting out its own version of instructions that cannot be agreed upon. Patent cases, however, are particularly well suited to final instructions that are more user-friendly and yet more structured than the ordinary form of jury instructions.

It is essential that the language used in the instructions be in plain English and, to the extent possible, that confusing "patent speak" be avoided. The jurors will have only these instructions (and the special verdict form, discussed in the next section) to inform their deliberations and help them find their way. As with any other directions, whether it be instructions for assembly of a toy, a recipe, or a road map, the steps must logically follow one another, be expressed in comprehensible terms, and be easy to follow. Jurors always have struggled, and no doubt will continue to struggle, with terms lawyers take for granted, such as "plaintiff." During trial, and particularly in jury instructions, parties should be referred to by name, not by the side of the "v" on which they sit. Jury instructions should never use the terms "accused product" or "accused process." The jurors will be sufficiently bewildered by the instructions on such things as the doctrine of equivalents and invalidity; there is no need to add to the confusion. Identify the accused products and processes in the pretrial instructions (or not later than the opening statement) by their given names, use those names throughout the trial, and continue that use through final jury instructions. Remember, "when the legal issue is complex, simplicity of language is vital."58

Keep the instructions as simple and as short as possible. In aid to clarity, it is helpful to have someone who is unfamiliar with the case, preferably a layperson, read the proposed instructions before they are finalized. It is even better if the instructions can be read aloud. This helps to pinpoint language that is too archaic or convoluted to be easily understood. Jurors spend as much as 25 percent of their deliberations discussing the applicable law, and they may be correct on their assumptions about the governing law as little as 50 percent of the time.59 Given this, it is imperative that instructions be as easy to understand as possible.

In preparing proposed instructions to submit to the court, counsel must state the law accurately despite the temptation to state the instruction in a way that most benefits the client. Although the Federal Circuit has not developed a large body of case law directed to jury instructions,60 tailoring instructions too much in one party’s favor risks offending the judge and, if accepted as the jury charge, creating reversible error. However, it may be appropriate to include in the proposed instructions not just a statement of the governing law but also

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any facts that have been agreed upon by the parties relating to a particular issue, the respective factual contentions, and the respective burdens of proof. Although typically the instructions closely follow the governing law, there may be circumstances in which it is appropriate to tailor a proposed instruction to the direction in which the law is developing. The deciding factor in framing the instruction is the consideration of the issue that will be raised on appeal.

A helpful suggestion for jury instructions in patent cases was made in the Model Case Management Orders for Patent Cases, prepared by Committee 956 (Special Committee on IP Litigation Forms) of the American Bar Association Section of Intellectual Property Law in its Model Order No. 18, “Order re Jury Instructions.” The proposal suggests combining the instructions with the special verdict form in the following format:

- a statement of the governing law, followed by:
- the facts agreed upon by the parties, followed by:
- the parties’ respective factual contentions as to this issue, followed by:
- a statement identifying the party having the burden of proof on the issue and what that burden is, followed by:
- a statement of the special interrogatory to be answered by the jury on the issue.

Preparing this type of instruction requires serious cooperation by both or all parties to the litigation and may not be possible in all cases. But its design is intended to, and does, reduce the possibility of juror confusion because the statement of the law is coupled with the precise question to be answered by the jury. This method is far preferable to submitting jury instructions with a lengthy special verdict form that requires the jurors to move back and forth between the documents in an attempt to relate the instructions to the interrogatories.

There are pattern or standard jury instructions that have been developed for patent cases, most recently those adopted by the United States District Court for the District of Northern California in 2004. However, patent law is not static; it is constantly and sometimes rapidly evolving. Care should be taken to confirm that the pattern instructions reflect the current state of the law. Instructions that are only a month old may already be out of date.

H. Special Verdicts

“Use of special verdicts and interrogatories that direct juries to sequentially address the specific issues presented could greatly enhance the rationality, reliability, and predictability of jury verdicts, and their reviewability on post-
trial motions and on appeal as well.” Special verdicts and interrogatories properly should cover all the issues to be decided by the jury and any factual findings important for the judge’s consideration of issues of law, such as inequitable conduct, anticipation, and obviousness. Failure to provide for all the issues in the special verdict may cause an issue to be deemed waived.

Special verdicts are particularly well suited for use in patent cases, as noted by the United States Supreme Court in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.* The Court noted:

> With regard to the concern over unreviewability due to black-box jury verdicts, we offer only guidance, not a specific mandate. . . . Finally, in cases that reach the jury, a special verdict and/or interrogatories on each claim element could be very useful in facilitating review, uniformity, and possibly postverdict judgments as a matter of law.

Indeed, long before the Supreme Court’s encouragement in this regard, in *Railroad Dynamics, Inc. v. A. Stucki Co.*, the Federal Circuit counseled the use of special verdicts:

> The role of the trial judge in deciding upon motions for JNOV and new trial, and that of this court on review, are greatly facilitated when the jury has answered a series of factual inquiries in writing. When obviousness is an issue, interrogatories seeking answers in writing to inquiries drawn about those listed in Graham v. John Deere Co., 383 U.S. 1, 86 S. Ct. 684, 15 L. Ed.2d 545, 148 USPQ 459 (1966), insofar as the evidence adduced at trial relate to those inquiries, should be employed. Connell, supra, 722 F.2d at 1547, and cases cited therein; American Hoist and Derrick Company v. Sowa & Sons, Inc., 725 F.2d 1350, 1361 (Fed. Cir. 1984).

There are different theories regarding the structure of special verdict, but one thing is certain: special verdict forms are outcome determinative and thus

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64 “Interrogatories” in this context are governed by Federal Rule of Civil Procedure 49(b), which provides that interrogatories “upon one or more issues of fact” may be submitted to the jury together with one or more forms for a general verdict.
65 Fed. R. Civ. P. 49(a) (“If [in submitting a special verdict to the jury] the court omits any issue of fact raised by the pleadings or by the evidence, each party waives the right to trial by jury of the issue so omitted unless before the jury retires the party demands its submission to the jury.”).
66 520 U.S. 17, 38 n.8 (1997).

> While the form of jury verdict is normally a matter of discretion with the trial court, one court has noted that the “failure to utilize this method in a patent case places a heavy burden of convincing the reviewing court that the trial judge did not abuse his discretion.” . . . The use of special interrogatories . . . facilitates appellate review (and review by the trial court on any motion for judgment notwithstanding the verdict), for such use frees the court from having to survey every possible basis for the jury’s decision.”

*Id.* at 1361 (citation omitted).
68 Special verdicts are governed by Federal Rule of Civil Procedure 49(a), which provides:

> The court may require a jury to return only a special verdict in the form of a special written finding upon each issue of fact. In that event the court may submit to the jury written questions susceptible of categorical or other brief answer or may submit written forms of the several specific findings which might properly be made under the pleadings and evidence. . . .
require extreme care in the drafting. Many follow the approach of using special verdict forms that are only one step removed from a general verdict form. These seek only a finding of such things as whether:

- the patentee has proven infringement by a preponderance of the evidence;
- the patentee has proven that infringement was willful by a preponderance of the evidence;
- the accused infringer has proven the stated claims of the patent-in-suit to be obvious by clear and convincing evidence;
- the accused infringer has proven inequitable conduct by clear and convincing evidence.

This type of special verdict form, unfortunately, is not useful in “facilitating review, uniformity, and possibly pass[ing] verdict judgments as a matter of law,” as contemplated in *Warner-Jenkinson*.

A second approach is to draft the individual interrogatories such that if the jury (in considering infringement) fails to find one element of a claimed invention in the accused product or process, they are instructed to skip ahead to other counts. While this approach saves the jury time and potential confusion, it likewise is not significantly helpful on appeal. Assume, for example, that a patent claim has four elements. Assume further that the special verdict form states that the jury should cease deliberating on the infringement count if they find one element missing from the accused product. In this construct, if the jury finds the first element missing from the accused system or product, they will make no further findings on infringement. If this one finding is reversed on appeal, there will have been no findings as to the second through the fourth elements of the claims. In the worst-case scenario, the issue of infringement based upon whether elements two through four exist in the accused product or process will be deemed waived.

In a properly drafted special verdict form, all elements of infringement should be addressed. If that had been done in the example given, the verdict of noninfringement would have been reversed and not remanded (assuming that the second, third, and fourth elements were found to exist in the infringing product). The value of the special interrogatory depends largely on its specificity. The interrogatory that only asks the jury to state their findings on only some but not all of the elements of any count being tried is simply not helpful on appeal.69

Although general verdicts are not forbidden in patent cases, they rarely make sense. “Absent special verdicts or interrogatories, the fact findings of the jury are unknown and must be inferred from the jury’s verdict. This approach

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69 The purpose of the special interrogatories is fairly compared to that for the proposed findings of fact and conclusions of law submitted to the court. While the latter are more detailed than any special interrogatory to a jury, they invariably ask for findings of infringement on every element of the asserted claim, on both materiality and intent as well as inequitable conduct, on each of the *Graham* factors as well as all secondary considerations of nonobviousness. It makes no sense not to ask the jury to make similar findings.
The Trial is cumbersome and may allow jury errors to go uncorrected.” Consider the circumstances in which obviousness is submitted to the jury. Without a special verdict or interrogatories, it is impossible to determine whether the jury applied the appropriate factual inquiries and if they did, whether the jurors reached the appropriate conclusion based on those factors. Special verdicts also limit the possibility of misunderstanding of the complicated jury instructions that are almost a given in any patent case. Another benefit is that jury instructions themselves do not need to be as elaborate when accompanied by a well-structured special verdict form.

If this were not reason enough to adopt the special verdict form in all patent cases, special verdicts have the added benefit of aiding the jury in approaching the necessary elements of their deliberations in a simplified and organized fashion. In any complex case in which the jury will struggle with the law, but particularly in the patent case, the jury will benefit by being provided with a simplified outline of the steps to be taken to reach a verdict.

IV. SELECTION AND PREPARATION OF WITNESSES

A. Introduction

Without doubt, the most significant factor at any trial is the presentation of evidence. Lawyers don’t make the facts, but they influence how the jurors perceive the facts by controlling their presentation. All trials, including patent trials—whether in support of a patent or in defense to validity, enforceability, or infringement—require competent and coherent testimony of live witnesses. Improper witness selection and inadequate preparation of the witnesses for testimony once they are selected will almost guarantee that the case will be lost. Properly presented, live testimony brings science and technology to life. If presented correctly, live witness testimony creates a bond of truth between the witnesses and the jurors. The proper selection and preparation of witnesses, both fact and expert, are the key to a successful presentation.

B. Selection of Fact Witnesses

Witness selection is a deliberative process. It is driven by the proof required but tempered by considerations of presentation and persuasion. A good witness

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71 Authorities have interpreted the patent statute to require specific inquiry on the following points to determine whether an invention is obvious in light of the prior art, including consideration of: (1) the scope and content of the prior art; (2) the differences between the prior art and the claimed invention whose obviousness is at issue; (3) the level of skill in the pertinent art; and (4) such secondary considerations of nonobviousness as may be appropriate in the given circumstance. Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

72 Many jurisdictions automatically require the use of special verdict(s) in complex cases. However, if a court does not require a special verdict form, consideration should be given to proposing an order requiring special verdicts in a form similar to that shown in Appendix B, Model Order No. 17, “Order re Special Verdicts.”
needs to be familiar with the facts of the case and be able to communicate those facts in an effective manner. The inexperienced lawyer will always choose the witnesses closest to the facts, whether or not he or she is a good communicator. But this is a mistake as to all but the most essential witnesses.

Obviously, the inventor should be called by the patentee to testify, particularly if the inventor is still employed by or associated with the patent owner. The jury will not only want but expect to hear the story of the invention, and this can come in successfully only through the inventor. His story will have emotional appeal if presented properly. If, as the patent owner, a choice is made not to call at least one inventor during a trial, a justification for this failure should be explained to the jury (e.g., another witness who is called at trial should mention that the inventor is dead, too sick to testify, has left the company and gone with a competitor, or is otherwise unavailable to attend the trial and testify). If one, but not all, of the named co-inventors is called at trial, she should explain the nonattendance of the other inventors. This undercuts any argument from opposing counsel that the patent owner did not have the courage to call the inventor(s). Even if opposing counsel does not affirmatively raise the issue, the absence of the inventor will be raised in jury deliberation, and the jurors will be left to draw their own conclusions. If the inventor has a particularly appealing story and was assisted in his undertakings by others who likewise have appealing attributes, consideration should be given to calling a co-inventor who can testify to the shared struggle of creation.

Other fact witnesses who must be called include a businessperson who can describe the company, its products, its goals, why it sent a cease-and-desist letter or commenced the lawsuit (or for the accused infringer, what its response was to the letter), and, if it is a local company, its contribution to the community in terms of employment of the local workforce.

A marketing or salesperson must be called for the patentee who will, from the patentees’ view, describe the success of the invention and the damage done by the infringement (lost sales, reduced price, etc.). (This type of witness on behalf of the accused infringer will testify, for example, about the accused product or process and its commercial success being based on factors other than elements of the claimed invention.) Anyone involved in sales should be able to “sell the product” at trial, but it is essential to define for the witness on the stand precisely the product to be sold and the ultimate goal of the testimony. Sales teams are very much driven by goals. Defining the goals in precise terms, particularly for this type of witness, maximizes the possibility of successful testimony.

The choice of witnesses may be a determination of the lesser of evils rather than the selection of the best possible witness from a pool of available and knowledgeable candidates. Often, people with firsthand knowledge are few in number, and the choice of trial witnesses employed by the company may be very limited. Still, the ultimate choice of fact witnesses for trial depends on the facts to be proven; the available candidates with personal knowledge; a consideration of potential witnesses’ time and willingness to make the effort to be prepared for and attend trial; the age, character, demeanor, appearance, and intelligence of the potential witnesses; and whether a witness testified during pretrial depositions. Further factors include whether the pretrial witnesses
were identified in initial disclosures or during discovery as knowledgeable; whether they testified before in similar trials; and whether they are still employed by or under the control of a party (and if not, the circumstances under which their situation changed).

Because the time allowed for trial in patent cases is increasingly limited, it is usually best to select witnesses who have personal knowledge about a variety of facts important to the case, covering a long time period. This reduces the number of witnesses actually called at trial. Every witness called by a party at trial represents a considerable investment of time by someone on that trial team—time to evaluate, prepare the witness for testimony, and present the witness at trial. By the same token, the opponent must also invest time preparing to cross-examine each witness, researching each one’s background, and guessing what each witness might say. Time is a precious commodity just before and during trial. Reducing the number of witnesses economizes the trial team’s resources, limits the potential for contradictory testimony from multiple witnesses, and makes for an easier presentation of the case. But it can have a downside as well, for jurors tire of seeing the same witness on the stand hour after hour.

Every witness represents both an opportunity to tell the story and prove the case and an opportunity for disaster if the witness makes critical admissions on cross-examination, testifies inconsistently with other witnesses called in the case-in-chief, or generally performs badly on the stand and does not make a good impression. Despite intensive preparation and the firm conviction that a given witness will perform well, witnesses can and do break down and make mistakes for a variety of reasons that sometimes defy prediction.

In choosing witnesses for trial, consideration should be given to the use of deposition testimony if there are concerns that the witness will be ineffective on the stand (and is out of the reach of the court). Generally, reading depositions into the record is a pale substitute for the impact of a live witness at trial, and most jurors are put off by the replaying of videotaped depositions except in the most unusual circumstances, such as where it is plain that the deposition was taken because severe illness, disability, or impending death forced the use of this format. Videotaped depositions are better than reading aloud a deposition transcript, but watching even carefully edited video still lacks the impact of a live witness. On the other hand, an already-taken deposition is a known commodity. There will be no further opportunity for cross-examination or foul-ups at trial. Because some witnesses appear more credible on the written record than they do in person, reading their testimony may have advantages, particularly where certain adverse matters did not come up during the deposition but might be raised at trial.

C. Selection of the Testifying Expert Witnesses

An expert witness is necessary when the ability to draw sound inferences from a particular set of facts is beyond common experience and education. The expert witness holds a more significant and prominent place in patent cases than in most other types of cases. Indeed, a patent infringement trial often is (although it should not be) a simple battle of the experts. There generally are
four categories of experts in a patent infringement trial: the technical expert, the patent office expert, the damages expert, and the evidentiary expert who lays the foundation for computer animations or simulations.

An expert in any trial should honestly believe in the opinion he or she will promote on the stand. If she is testifying for the patentee, she needs to believe in the strength of the patent and the importance of the invention. If he is a witness for the accused infringer, he needs in-depth experience in the art and a firm belief that there is nothing new about the invention claimed in the patent. Without this foundation, the expert cannot remain firm, sure, and believable on the major points of testimony during cross-examination. The expert should be able to recognize and graciously concede minor points (when truth requires) that will have no detrimental effect on the case. He or she should be articulate and more than just presentable. Of course, it almost goes without saying that the expert should not have a personal interest in the outcome of the case.

The technical expert in the patent case needs these characteristics and more. The desirable characteristics of the testifying expert witness in the patent trial are both similar to and different from those of experts in any civil case. The technical expert provides instruction as to complex scientific principles and technology, and opinions as to the application of those principles in the particular circumstances of the case. Because the science is such an overarching factor in the patent case, the expert technical witness must be suitable to work as an important member of the trial team, guiding and teaching the team as to nuances in the technology. He must be capable of conveying the science in a manner and expression that will hold the attention of the jurors through the long days of the trial. If trial testimony is designed to educate, as it should be, the expert witness must be a great teacher, aware of the jurors’ education levels. The testimony cannot be dry or tedious. Science is difficult enough for the lay juror to understand but impossible if it is not put into a context that will be interesting to the jury.

There are four considerations to be made in beginning the process of selecting the testifying technical expert on liability issues in patent cases. First, timing of the selection is everything. The expert should be chosen early in the case to maximize the benefit he or she is to provide and to preclude the adverse party from retaining the better experts.73 Second, consideration should be given to the areas of expertise that will be needed to prove a case or rebut the other party’s case. Next, a decision must be made regarding the type of skill and personality the expert should have. Finally (and this is true for all experts except damages experts), it is always beneficial if the expert has obtained patents or has had exposure to patents in some context. This is important because the expert must be familiar with the genesis of the court’s claim

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73 There are cases involving technology or issues where the number of true experts is limited. Waiting too long before selecting a consulting and/or testifying expert may result in the opposition tying up the best experts through consulting relationship or other agreements. In a major patent case involving a narrow area of technology, the pool of true experts may be limited, and the fact that the pool has been tied up by one side and thus denied to the other may be as important as selecting the one “perfect” expert to testify at the trial.
construction and be able to understand that claim construction as applied in the case. A *Markman* hearing may have resulted in a claim construction months before trial, but claim construction may be revisited by the district court any time up to the entry of the final verdict and judgment by the court based upon evidence elicited that causes the court to need to reevaluate the earlier construction.\(^{74}\)

Proper selection and use of the expert witness is essential. Well-chosen and reputable expert witnesses not only help to prove the case, but they provide a reality check on counsel’s view of the technology and potential damages.

### 1. Areas of Expertise

Among other areas, experts in patent trials can and should be used to provide the background of the technology at issue and perhaps even to present a tutorial on the technology. Experts may be employed to explain the accused product or process and where and how each element of the claims is present in that product or process;\(^{75}\) to explain technical differences between the patented invention and prior art relied upon by the accused infringer; to describe the level of knowledge of a person of ordinary skill in the art at the time the invention was made; to describe the technical differences between the invention and the prior art; to discuss the reason the claimed invention would not have been obvious from the accused infringer’s prior art;\(^{76}\) and to testify regarding the secondary considerations of nonobviousness, such as prior unsuccessful attempts to resolve the problem solved by the inventor, industry recognition and adaptation, lack of suggestion to combine elements, or prior belief of the impossibility of combining elements, among others.

For the infringer, experts provide the reverse side of the equation. Among other areas, they explain why claim elements are missing from the accused

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\(^{74}\) A determination of claim construction made before trial is not a final judgment and is thus reviewable and “subject to revision at any time before the entry of judgment adjudicating all the claims and the rights and liabilities of all the parties.” *Fed. R. Civ. P.* 54 (b). *See also* *RF Del., Inc. v. Pacific Keystone Tech., Inc.*, 326 F.3d 1255, 66 USPQ2d 1593 (in which the Federal Circuit held that the claim construction made on motion for partial summary judgment is not a final judgment and may not be grounds for collateral estoppel or res judicata).

\(^{75}\) Expert testimony is permitted on infringement, but it must explain in detail whether the accused product or process meets every limitation of a claim literally or by equivalents. The proffered testimony cannot be merely conclusory. *See Zelinski v. Brunswick Corp.*, 185 F.3d 1311, 1317, 51 USPQ2d 1590, 1594 (Fed. Cir. 1999) (finding that an expert opinion regarding infringement that is merely “conclusory” is insufficient to support a finding of infringement under the doctrine of equivalents.); *Lear Siegler v. Sealy Mattress Co.*, 873 F.2d 1557, 1559 (Fed. Cir. 1989) (“absent ‘a showing of how [patentee] compares the function, means, and result of its claimed invention and those of the accused device, a jury is more or less put to sea without guiding charts when called upon to determine doctrine of equivalents’.”).

\(^{76}\) The ultimate question of obviousness, like other questions of validity, is one of law for the court. The Federal Circuit has held that expert testimony is not required or controlling and it is not evidence. *Nutrition 21 v. United States*, 930 F.2d 867, 871 n.2, 18 USPQ2d 1347 (Fed. Cir. 1991) (citing *Avia Group Int’l, Inc. v. L.A. Gear Calif., Inc.*, 853 F.2d 1557, 1564, 7 USPQ2d 1548, 1554 (Fed. Cir. 1988). However, the Federal Circuit has fallen short of holding that it is inadmissible. *See Mendenhall v. Cedarapids, Inc.*, 5 F.3d 1557, 1574 n.17, 28 USPQ2d 1081, 1096 n.17 (Fed. Cir. 1993), in which the court states: *Indeed, the spectacle of experts arguing over legal conclusions of obviousness before the jury, even if not error, should be avoided inasmuch as such opinions are not substantive evidence. The practice of using experts developed in bench trials where they informed the judge, like a brief, on the intricacies of patent law.*
product or process, explain the lack of novelty of the invention, and provide opinions regarding the failure of the specification to disclose the best mode contemplated by the inventor for carrying out the invention or failure to distinctly claim the subject matter of the invention. The accused infringer’s expert also provides testimony describing the prior art and how it relates to the invention so as to set the stage for the jury to conclude that the invention was nothing more than the next logical, and obvious, step in the progression of the science.77

Even when the inventor is available to testify concerning the invention, a follow-up expert witness can be used to put the invention into context and, in the process, to pay tribute to the creativeness of the inventor. The expert can be called upon to explain its novelty and benefits over the prior art, to explicate the improvements made by the patented invention, and to convey the difficulty that others had in solving the problem faced by the inventor. This is important even in the rare circumstance in which validity is not challenged. Such testimony enhances the jury’s impression of the value of the invention and lays the foundation for their comprehension of the evidence in the damages phases of trial, particularly as to reasonable royalty analyses.

The patent expert will provide testimony centered around events in the Patent Office, summarizing the prosecution of the patent-in-suit, putting important events in context, and identifying the prior art before the Patent Office examiner, and will even provide testimony identifying statements related to prosecution history estoppel. Although the patent expert should not offer testimony on a hypothetical response of a particular examiner to information withheld from the office, the patent expert (especially one previously affiliated with the Patent Office) can provide testimony related to the duty of disclosure under 37 C.F.R. §1.56,78 the extent of the examiner’s search of materials (and the small likelihood of finding documents other than issued patents), and the materials potentially available from the files searchable by the Patent Office. Most courts today will not permit the expert to testify regarding the propriety or impropriety of the events that occurred in the Patent Office.

The types of damages experts are accounting experts, licensing experts, industry experts, and economists. The financial expert can be expected to pull the damages presentation cohesively together and provide a narrative summary of the facts established by the previously presented fact witnesses. The lost-profits expert is used to provide the nexus for the “but for” test. He should be familiar with industrywide products, customers and what drives their purchasing decisions, how branding and marketing influence purchasing decisions, how service and reputation influence purchasing decisions, price levels, and market highs and lows. This expert likely will testify regarding market share, capacity, assumptions of acceptable noninfringing substitutes, and price erosion. The foundation for the damages expert’s opinion will come largely from fact witnesses, but it is essential that the expert witness on damages have a basic

77 Motorola Inc. v. Interdigital Tech. Corp., 43 USPQ2d 1481, 1489 (Fed. Cir. 1997) (holding that testimony by an expert as to the teaching of prior art references and the motivation that one of ordinary skill in the art may have to combine references was sufficient to support the jury verdict of invalidity.)
understanding of the technology. Without this, any opinion on acceptable non-infringement substitutes will ring hollow. The lost-profits expert also lays the foundation for the licensing expert, if there is to be a separate expert. The licensing expert must be knowledgeable about standard industry licensing practices and royalty rates.

2. Types of Skills and Qualifications

The expert with the most experience and knowledge in the technology at issue is not always the best choice for a trial witness where the expert is called upon to have not only a depth of knowledge but also the ability to communicate effectively, and to explain and convey that knowledge to lay jurors. While long and impressive credentials and a specialty in the area of the relevant technology are important, other and more practical considerations play a significant role in the selection of the expert. Two essential skills are required of all testifying experts: excellent communication skills and qualifications in the relevant area of technology, patent law, or damages. Opinions and explanations of complex technical matters, no matter how sound, are useless if they cannot be communicated and justified to a jury. Science and technology are being taught to the jury, and the expert must excel at educating people who do not know even the most basic concepts of the subject.

In addition to teaching the subject in the first instance, the expert must be able to defend that teaching under cross-examination without being defensive, smug, or hostile. University professors may have appropriate expertise because they have the background qualifications and reputation and presumably have taught (at least at one time), but beware of the professor who has lectured only graduate students for the last decade or so. He or she may be unable to teach at a level that the judge or jury can understand. Also beware of the college professional who is not used to having his or her opinions or pronouncements challenged or questioned. Many university teachers live in a world where their word is law and where the students are expected to listen, not argue. Such professors may fare very poorly on cross-examination.

The expert’s qualifications depend on the needs of the case. The expert must be shown at trial to have the knowledge, skill, experience, training, or education sufficient to remove any doubt that he or she can testify as an expert. Federal Rule of Evidence 702 requires that an expert be qualified by “knowledge, skill, experience, training, or education” to express an opinion on a particular issue.70 That opinion is for the purpose of “assist[ing] the trier of fact to understand the evidence or to determine a fact in issue.”80 The party calling the expert to the stand must elicit testimony sufficient to establish that the witness has the requisite expertise to offer a reliable opinion in each subject matter of his proffered testimony.81 In addition to education and experience, it is important to consider any prestigious honors received by the potential expert,

70 Fed. R. Evid. 702.
71 Id.
80 Id.
memberships, professional recognition, lectures, and the like. Exceptional qualifications set forth in the expert report are not sufficient in and of themselves. Those qualifications must be directly related to the opinion being offered, and the witness, if his credentials are challenged at trial, must be able to articulate precisely why and how those credentials support the opinions offered.

The mere fact that an “expert” has excellent credentials in a particular field does not qualify the expert to provide testimony in a related field. Courts routinely exclude testimony where there are differences between the area of expertise in which the expert is qualified and the issues on which the expert purports to offer an opinion, thereby rendering his or her testimony of little benefit to the jury. Selection of the testifying expert also requires evaluation of factors less concrete than the laundry list of education and experience contained in the expert’s curriculum vitae. These include:

- prior experience in testifying successfully (not a requirement, but can be helpful provided the prior testimony is not so frequent and extensive that the expert is freighted with the excess baggage of possibly inconsistent statements or gives the impression of a person who testifies to anything for anyone for a price);
- physical appearance (however politically incorrect it may be, physical appearance will have an important impact on a jury);
- ready access to research facilities, computers, libraries, or other tools needed to prepare to testify;
- hourly rate (it will come out at trial);
- the chemistry between counsel, the expert, and the client;
- reputation from other trials (trial counsel should identify and talk with prior counsel who either have used the prospective expert or have had that expert testify against them, and garner their impressions on such things as how the expert performed on cross-examination, whether the expert worked independently, made time available to work on the case, and reviewed the materials received from counsel, and whether the expert was a resource of information or relied on trial counsel to supply everything); and
- the ability, time, and willingness to work with fact witnesses and other experts.

Frequently, the key expert is the last trial witness. He is called upon to sum up the evidence that came before and is a party’s last opportunity before closing argument to impress upon the jury the accuracy and reasonableness of the position espoused. He is, to borrow a phrase from baseball, the cleanup hitter. The jury in the patent trial basically hears two equally impressive experts

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82 See In re Independent Serv. Org. Antitrust Litig., 85 F. Supp. 2d 1130, 1163–64 (D. Kan. 2000) (striking the declaration of an alleged patent infringer’s expert, a chemist who was not shown to have specialized knowledge or relevant experience in the pertinent subject area, in part because there was no showing that his opinion was “relevant or would assist the trier of fact to understand or determine a fact in issue”); In re Unisys Savings Plan Litig., 173 F.3d 145, 156–57 (3d Cir.), cert. denied, 528 U.S. 950 (1999) (affirming decision to exclude testimony where expert’s alleged expertise, limited to methods of investing with respect to property casualty insurance, did not fit with or meet the need of the court for expert testimony in life insurance investing).
present diametrically opposed opinions based on the same set of scientific facts about which the jury has little understanding or appreciation. Thus, the verdict may hinge upon a swearing match between experts and which expert the jury believes.

3. *Prior Inconsistent Statements*

Most experts will have a background that includes scores, if not hundreds, of prior writings the expert has authored or coauthored. Many will have given testimony in other proceedings, by deposition or live at trial. All of these prior patents, publications, and presentations should be discussed carefully with the expert. A member of the trial team should read all these documents, searching for inconsistent or, perhaps more likely, seemingly inconsistent statements. This is the only way to confirm that the expert has not been irreparably damaged by prior statements. This should be done before retention of the expert, not merely in preparation for trial. Of course, prior expert testimony is often beyond the reach of trial counsel because of confidentiality orders in earlier cases. In this case, the witness needs to be questioned closely regarding prior opinions on the possibility of conflicts in prior testimony. Prior inconsistent testimony usually can be mitigated but only if preparation has been made to do so.

D. *Preparation of Witnesses for Testimony at Trial*

1. *Introduction*

The success of most witnesses on the stand is directly proportionate to the degree of trust they have in the lawyer conducting direct examination. Every witness wants to do a good job, wants to be proud of her work on the stand, and, if the appropriate bond exists between counsel and witness, wants counsel to be proud of her as well. A witness’s sense of trust in counsel is developed much the same as any other interpersonal bond, through honest communication, time spent together, accommodation of personality and personal beliefs, willingness to compromise, and a firm belief in mutual trust. The degree of the witness’s success is contingent upon the degree of her preparation by and confidence in the lawyer conducting direct examination. Proper witness preparation begins early in the case and continues through depositions, up to trial and during trial. Every witness has his own pace of development, and this pace cannot be hurried or changed, no matter how time-consuming it may be and no matter how many other things need to be accomplished before the trial.

Without question, the first step to effective direct examination is preparing the outline of the goals of the examination. This should be done well in advance of trial and should state exactly what elements of proof are sought to be solicited from this witness and then work backwards to determine the questions necessary to elicit the proof sought. This then becomes the outline for the witness’s testimony. There are many important reasons that the witness should never be provided a copy of this outline. Setting aside the risks of it being left someplace and picked up by someone with an adverse interest, it is important that the witness not develop the sense that the testimony will always follow some particularly well-worn path. Objections will be raised at trial and adjustments
made to the order of the witness’s questioning while the witness is on the stand. Even for an experienced witness, this can be confusing if he or she has learned a “routine.” Ideally, the early practice sessions with the witness should be not much more than a discussion of topics to be covered, inviting input from the witness as to the best series of questions to elicit a particular fact or conclusion. It should be something in the nature of a brainstorming session in which the witness feels comfortable enough to make suggestions regarding the presentation of the testimony; it is, after all, the witness’s testimony and it is essential that it unfold in a manner comfortable to the witness. The witness must be assured that “there are no bad ideas” and receive positive feedback even if a suggestion is not workable in the context of the testimony. Negative reinforcement and criticism will only serve to create a reluctant witness. Pretrial preparation sessions are trust-building sessions.

The early practice sessions are designed for more than practicing question and answer. They are the foundation of the relationship that will carry the direct examination through to a successful presentation. The same theory of learning that is true for the jurors is true for a witness. If he is a real participant in developing the testimony, the witness will feel more comfortable with it and will remember the goals of the testimony no matter what objections or distractions may come to pass at trial. This simply cannot be overstated. If the witness believes counsel is truly interested in his opinion, it goes a long way toward building trust. It really is true that “we all admire the wisdom of those who come to us for advice.” Invite the witness’s opinion. Make the witness know that her opinion is valued. This technique invariably enhances the confidence of the witness and improves her performance at trial. This holds true whether the witness is a fact witness, a novice expert, or the survivor of many legal battles.

Many courts require that each witness called on direct, whether a fact witness or an expert witness, be provided with a binder containing the trial exhibits intended to be used during the examination of that witness. The purpose of this is to streamline the presentation and avoid the delay caused by trial counsel having to present each exhibit individually for the witness. The use of an identical copy of this exhibit book during witness preparation will help the witness to become well versed in these exhibits. However, the witness’s copy of the exhibit book should not follow the witness to the courtroom but should remain in counsel’s offices because it is far too likely that the witness may have made inadvertent notes on the exhibits. This is the only way to avoid any mix-ups in which an annotated version of exhibits is taken to the witness stand. Opposing counsel has the right to review and copy anything the witness takes to the stand, and this includes any notes the witness made containing his impressions of trial counsel’s advice regarding how to express certain testimony on particular exhibits.

2. Preparation of Fact Witnesses

Most trial lawyers are comfortable in the courtroom. Most do not have a sufficient sense of the discomfort experienced by the fact witness who has never testified before and has never seen the inside of a courtroom except in fictionalized and misleading versions on television or at the movies.
any fact witness testifies for the first time, he or she should be shown the physical courtroom where the trial will take place. This can be done during breaks in the trial or, preferably, while the trial is ongoing. Point out where the judge (and jury) will sit and the point from which counsel will question the witness. Explain generally how the questioning will proceed, including the fact that once the witness’s testimony is over, he or she may leave the courtroom. Before testifying, the witness should sit in the actual witness chair to see what it feels like and to learn where to place papers and how to use the microphone. This will give the witness an appreciation of the sometimes distracting view over the courtroom (second only to the judge’s) that the witness chair commands.

Every witness, even one who has previously testified, will be nervous and uncertain about the actual testimony and what will happen. There should be as few surprises as possible, and the testimony should be as uneventful as it can be. The inexperienced witness must be shown (through practice) that he can withstand cross-examination without serious damage to himself or his employer. A fact witness who is an employee of a party is no doubt concerned that a poor performance may adversely affect his employment status or future compensation. No one can blame this witness for wanting to avoid the emotional, time-consuming, and painful experience of preparing to testify and handling often harsh cross-examination. It is the trial lawyer’s responsibility to take the initiative to calm the witness’s anxieties and apprehensions. With practice, the trial lawyer can help the fact witness who has no innate ability to improve. The witness can benefit from videotape sessions in which he can observe his own demeanor and ability to follow instructions and answer questions. Hearing and seeing his own testimony will increase the ability to answer in clear, concise, and understandable language. Most important, any witness must be assured that, whatever his initial skill level, if he fails on the stand it will be the fault of counsel for failing to properly prepare and support him. The more secure a witness feels, the better he or she will perform on the stand.

All witnesses need to understand why they are being called, the nature of their role in the overall theme of the case, how their testimony fits with the testimony of other witnesses and the documentary evidence to be presented, and the basic theories for recovery or in defense. They also need to know at least a basic outline of the opposing party’s case to be able to respond to any surprise questions on cross-examination.

It cannot be stated too often that personal contact and interaction with the witnesses are essential to a successful result. For key witnesses, practice sessions should last no more than an hour or two at any given sitting and be repeated frequently instead of being long in duration and short in number. The inexperienced witness, much like the new devotee to exercise, will fatigue in a short time. The capacity to withstand a lengthy examination must be built slowly if it is to be sustained at trial. Reinforce testimony through repetition when the prospective witness is fresh and rested.

Clearly, the mechanics noted above of preparing the fact witness for testimony in the patent trial are governed by the traditional concepts for preparation of fact witnesses in any civil case—with one extremely important addition: the witness must learn to explain and relate the facts while minimizing the use of his or her colloquial language: scientific, technical, and industry jargon. It
is, of course and again, the lawyer’s obligation to assure this happens. The use of terms not easily understood by the jurors or for which there is a common meaning different from a technical meaning must be eradicated during practice rounds. Witnesses sometimes forget themselves on the stand and use technical terms that have not previously been explained to the jury. In this case, it is counsel’s job to interject a question asking for an explanation of the term. The witness should comfortably feel that counsel will catch misstatements and give the witness the opportunity to repair the mistake on the stand. Witnesses know when they’ve fumbled on the stand and need to know that counsel will protect them to the extent possible and guide them with follow-up questions designed to repair any misstatements.

Witnesses need to be given rules on behavior, but to follow them, they need to know why the rules exist. The extent to which these rules are followed will depend on whether the witness understands the underlying justifications for these principles. On direct examination the rules to be given to the witness are simple:

- The witness must tell the truth, even if it hurts. This is the single most important and most critical rule governing any witness’s testimony. Absolute truthfulness is the fundamental first step to building the jury’s sense of trust in the witness. Unfortunately, many witnesses perceive that truth is subjective rather than objective. An intentional misstatement or obvious mischaracterization of the facts can and likely will be terminally damaging to the case and the witness’s credibility. Difficult facts undoubtedly will surface during examination. But the witness needs to be reminded of the old adage that “if you have to eat a toad, there is no sense looking at it.” If there is no way around a hurtful fact that will be raised on cross-examination, the witness should willingly face it on direct to avoid the invariably awkward fight with the cross-examiner. Denying or attempting to avoid the inevitable damaging admission simply draws attention to it and emphasizes it.

- The witness must be natural and not adopt a “persona.” The witness needs to be comfortable in his own skin. Convey to him that he is and will be accepted for who and what he is. Advise him to act naturally, as he would under normal business circumstances. Knowing that he is expected to be who he is and not posture will help the witness to remain calm and measured in his demeanor and not convey a loss of temper or appear annoyed.

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83 Even relatively common terms may easily be misunderstood. An example is the word “grommet.” Most engineers understand that a grommet is a reinforced eyelet or opening through which a fastener may be introduced, such as an opening for a shoelace. But not all jurors will know this. To some, the opening for a shoelace is just called an eyelet or even a “hole,” much like the opening through which a shirt button is slipped. But to a young mother of two small children the word “grommet,” left unexplained, may well conjure up the only meaning she knows for the term—the back half of the Claymation characters Wallace and Gromit. The choice of words and their comprehension by the audience (the jury) cannot be taken for granted.
• The witness should not ignore the jury. It may not be natural for a witness to look at the jurors when answering a question, but this should be encouraged. The witness should engage the jury as she is answering questions, making eye contact with each of the jurors. If the fact witness is asked specifically to explain or demonstrate something to the jury, then it will be natural for the witness to look at the jury. This is an important part of developing that bond of trust between the witness and the jurors.

• If the judge asks a question, the witness should turn directly to the judge and fully respond as long as the judge continues the questioning, and then turn back to the lawyer at the podium for the lawyer’s next question. The witness can leave the witness chair if permitted (and only after asking) to explain a poster board, an image projected from a DVD, or other physical exhibit.

• The witness should not memorize testimony. Fact witnesses should be told that they are not expected to remember every aspect or element of the “model answer.” They should answer the initial question to their best ability and recollection at the time, and then wait for follow-up questions to elicit the complete response.

• No notes or other material should be taken to the witness stand unless approved by counsel. Witnesses should not take crib notes, write on their hands, or carry to the stand various devices to aid their memory or refresh their recollection.

• When an objection is made, the witness needs to await a ruling. Most witnesses do not understand the meaning of the terms “sustained” or “overruled” and must be guided as to their behavior once a ruling is entered.

As on direct examination, some witnesses instinctively are better than others on cross-examination. Some, because they are nervous, or simply prone to it, will be argumentative on the stand no matter how often warned against it. It is a good practice to remind the witness that if score were being kept during cross-examination, the score would be zero–zero at the start. And it should be zero–zero at the end. The goal is not to make points in cross-examination. The goal is to avoid making mistakes.

As with direct, all witnesses need to be schooled in the appropriate way to respond when challenged during cross-examination, and as with direct examination, there are certain basic rules that must be given, and explained to the witness:

• Listen to the question, understand it fully, answer it concisely, and then stop. Wait for the next question. Cross-examination does not afford the comfort of direct examination, where the witness should already know the approximate questions, the documents to be covered, and the order of presentation because it was covered in the practice sessions. (Even so, this is a rule that should be followed on direct examination as well.) Don’t be an advocate; only answer the question posed.

• Understand how the testimony fits into the larger frame of the presentation. The significance of testimony may seem small and irrelevant out
of the context of the trial as a whole. Answering truthfully, as all witnesses should do, requires understanding the issues and the context into which the witness’s facts fit.

- **Be in control on the stand.** If any question is not understood, the witness may ask for clarification. It is appropriate to ask; have the reporter read it back, if necessary; have it broken down if the question is too complex. There is no shame in admitting to confusion if it is genuine and not merely a ruse to buy time (the jury will see through this).

- **Know all prior testimony and statements.** Every fact witness who has testified in a prior deposition must be completely familiar with his or her prior testimony. It is the responsibility of the witness’s attorney to direct the witness’s attention to any apparent inconsistencies between what the witness is expected to say on direct and what he or she may have said in a deposition (or in prior documents that the witness authored).

- **Be aware of the difference between a leading (in cross-examination or with an adverse witness) and a nonleading question.** Any question that begins with “isn’t it a fact that,” “isn’t it fair to state that,” or “wouldn’t you agree that,” or that constitutes a carefully phrased statement followed by “right” or “isn’t that true” bears careful study. A “yes” to that type of a question means that the witness agrees with every part of the statement, all built-in assumptions, and all adjectives and adverbs employed. Carefully consider such questions before answering.

- **Do not allow the cross-examiner to cut off the answer before it is finished.** The witness should be comfortable that a complete answer has been given to the previous question before answering the next question. A cross-examiner who hears the start of an answer that he or she recognizes will be harmful may try to cut off the answer before it is completed. Trial counsel can object if his or her witness is cut off in mid-answer, but it is much more effective for the witness to police his or her own answers and ensure they are complete. Most judges will permit a witness to complete an answer and will not allow opposing counsel to cut off the witness in mid-answer.

- **The same question may be asked more than once.** On direct examination, this will be to emphasize a point. On cross-examination, it will be to see if the witness will change the answer or qualify it in some manner. On cross-examination, a question should be answered in the same way every time—no matter how many different ways the question is posed or how repetitive the answer becomes.

- **When being challenged on prior testimony, the witness can ask to review any portion of prior testimony being used as an alleged prior inconsistent statement.** The witness needs to know it is permissible to ask the cross-examiner to provide him a copy of the transcript (if counsel has not done so). The witness should read the portions before and after that part of the deposition selected by opposing counsel to place the testimony in proper context. The witness should never accept opposing counsel’s representation that the witness testified a certain way previously—he or she can demand to see the transcript and read the before and after portions. The witness should never simply agree with opposing counsel’s
representation that the witness being examined (or any other witness) testified in a particular manner unless absolutely certain that the characterization and phraseology used by opposing counsel are correct.

- When being questioned regarding a document, the witness can ask to see the entire document being used for cross-examination and should read not just the page or paragraph to which attention is directed but as much of the rest of the document as is needed to place the selected portion in proper context. Frequently, only a portion of a document will be reproduced on a poster board or on a TV screen, and the witness should ask for a hard copy of the entire document for proper context. The witness needs to understand that there are proper techniques available to witnesses to control the situation. By asking to read the testimony and/or document, even if the witness is relatively certain of its content, the witness slows the cross-examiner down and has time to think and prepare an appropriate response. If the witness concludes there is no inconsistency, he or she should so state, firmly and with conviction. If there is an inconsistency between a document or a prior answer given in deposition and the testimony given at trial, the witness should be prepared to explain it (the original question was misunderstood, the original answer was taken out of context, the witness has learned more since his deposition, etc.). And if the attorney and witness know that an inconsistency exists between expected trial testimony and prior statements in a critical area, that should be acknowledged during the direct examination and the appropriate explanation given then.

3. Preparation of Expert Witnesses

There is a common misconception that expert witnesses are so experienced in the courtroom that they don’t need as much preparation as the average fact witness. This unquestionably is a fallacy. Even the most experienced experts have developed over time bad habits or verbal ticks that need to be worked out of their repertoire through practice sessions. All experts, whether experienced or novice, need to work with counsel until they can comfortably present direct testimony and can withstand the heat of cross-examination in a manner that conveys to the jury both honesty and dedication to the truth.

Many trial attorneys prefer new or second-time expert witnesses, who are less shopworn and have little, if any, prior testimony that might generate inconsistent statements. An expert witness who lacks courtroom experience will have the same apprehensions as the average fact witness and must be familiarized with the nuts and bolts of courtroom etiquette and standard rules on examination. Furthermore, even though the expert has previously testified in other cases for other attorneys, if this expert is new to counsel, she must become familiar with this counsel’s methods and style.

Each of the earlier-discussed points for preparing fact witnesses is potentially applicable to expert witnesses. But there are additional considerations for the expert witness.

The expert must be prepared so as to state his opinion using everyday language understandable by the jurors. If appropriate, the expert should be
prepared to use analogies that are commonly understood. The testimony should be as streamlined and focused as possible to maximize its value to the jury.

The expert should plan to state his opinion early in his testimony so that it can be repeated freely throughout the testimony. The expert will, in effect, be teaching the jurors the science through his opinion. This is the time for extensive use of visual aids. Whether charts, models, videotapes, or computer animations are used, it is essential that the expert be sufficiently rehearsed in incorporating the visual aids into his testimony that there are no mishaps at trial. Sufficient preparation in this regard does not happen in a single preparation session, or even two sessions. It takes time. The expert should also be well prepared for a vigorous and possibly aggressive or hostile cross-examination.

The use of experts also poses problems different from those posed by the fact witnesses. For example, Federal Rule of Civil Procedure 26(a)(2)(B) requires a detailed expert statement well before trial and the opportunity for the opponent to conduct a deposition of the expert. Generally, the expert will not be allowed to testify beyond what was said in the statement and deposition unless there are good reasons for any change or addition (such as new facts becoming known). A detailed and careful review of the expert’s report must be made shortly before trial to map out a strategy together to explain and justify any new, changed, or expanded areas of testimony. This includes not only the opinions to be offered at trial but the reasons underlying the opinion. Because discovery frequently ends long before trial, there is an increasing chance that new facts will emerge between the deposition and trial or even at trial. If the changes are significant, and the jurisdiction is one that strictly holds an expert to the pretrial statement, opposing counsel should be made aware of the change and the basis for the change and seek consent to modify the pretrial statement so that surprise and prejudice cannot be argued. If consent is not given, and the grounds for the change are reasonable, most counts will permit the amended expert report, applying a rule of reason.

The expert must be prepared to speak to the level of the jury. Experts are just that—experts in a particular field of technology, economics, or the law with which laypersons, including judges, may have little or no experience. Every expert must be cautioned that his or her job is to explain to the jury, step by step, what the issue is, the nature of the technology, and the basis for the expert’s opinion. Both expert and counsel should avoid jargon and long words and speak instead in simple, short sentences.

There also are jurisdictional and judge-by-judge variations in what will be permitted by way of expert testimony. Every court, and essentially every

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84 Some jurisdictions do not permit experts to testify on direct examination in the traditional question-and-answer model but require instead the reading of a narrative statement. For example, the Middle District of Tennessee provides the following procedure:

As appropriate to the case and as included as part of customized case management under Local Rule 11, if applicable, or as otherwise ordered, the case management judge or the Judge before whom the trial is scheduled may require that the direct testimony of an expert witness, other than a medical expert, be reduced to writing and a copy thereof filed and served upon opposing counsel at least five (5) days before trial or as otherwise provided by the Court. If so ordered, such written statement shall contain every material fact and/or opinion to which the witness would testify on direct examination if the witness were asked the appropriate questions. When the witness is called to testify at trial, he
judge, has its own rules on what experts can and cannot testify to. It is critical to know, therefore, whether the trial judge will allow a patent expert to opine on obviousness, anticipation, inequitable conduct, infringement, or the like. Some judges will allow a patent expert to explain Patent Office procedure to the jury and nothing more. No opinions on invalidity, inequitable conduct, or other ultimate issues are permitted.

V. ORDER OF PRESENTATION

A. The Case in Chief

In the ordinary course, the trial proceeds in the following manner. The patentee presents proofs on infringement sufficient to demonstrate infringing activities under 17 U.S.C. §271.85 Even if invalidity has been asserted, the patentee is generally not permitted to present proof of validity (other than submission of the patent itself) because a patent is presumed to be valid.86 The patentee has no burden on validity unless the accused infringer makes out a prima facie case of invalidity.87 Once the patentee rests its case in chief, the accused infringer then presents proof of noninfringement, invalidity, and other defenses. The patentee then presents its rebuttal to the noninfringement proofs and its response to the accused infringer’s evidence on invalidity, unenforceability, or other defenses. Finally, the accused infringer presents rebuttal evidence as to invalidity and other defenses.

The question of whether this process should be followed when the accused infringer is the plaintiff is an interesting one. Most courts permit the patentee to present proof first, regardless of who instituted the litigation. The basis for this is the historical treatment given to judgments of invalidity by the Federal or she shall be sworn in the usual fashion. The qualifications as an expert shall be recited by the attorney who has called the expert witness. Thereafter, the attorney may interrogate the witness as to the specific qualifications of expertise that have direct bearing on the subject matter of the case. If objection to the witness’ qualifications is raised, the objecting party may conduct a voir dire as to qualifications outside the presence of a jury. Unless objection is raised to the qualifications of the witness as an expert, the witness shall then read the written statement aloud to the trier of facts. During the reading of the statement, the witness may refer to a mechanical device, drawing, chart, photograph, or other exhibit in order to explain his or her testimony. After the witness has read the prepared statement, the attorney who called the witness may ask additional questions to further explain his opinion. However, the witness may not proffer any opinion not encompassed in the written statement. At the conclusion of the witness’ direct examination of the manner described above, opposing counsel shall be given the opportunity to cross-examine the witness in the usual fashion.

85 This discussion presupposes that the case is the usual one where the patent owner is the plaintiff. Special problems exist when the trial arises as a declaratory judgment action, the causes of action are mixed with only some being patent-oriented, and/or the patent issues are raised by way of defense or counterclaim. Other difficulties are caused where both parties are asserting their own patent(s) against the other.


Circuit. Originally, the Federal Circuit routinely vacated declaratory judgments regarding patent invalidity in those cases where it found noninfringement. The court considered the declaratory judgment to be jurisdictionally moot when the finding of noninfringement completely resolved the dispute. In 1993, the Supreme Court of the United States disagreed with this practice, pointing out that once jurisdiction has been established in the trial court, jurisdiction continues into the appellate court. Further, “the Federal Circuit is not a court of last resort,” and its decisions are subject to review by the Supreme Court. Therefore the Federal Circuit’s finding of noninfringement does not eliminate its power to decide the issue of invalidity.

The significance of this change is that the rationale for trying infringement before invalidity in an action commenced by a complaint for declaratory judgment no longer has a solid foundation. The declaratory-judgment accused infringer asserting invalidity has a reasonable basis to argue to the court that it should be given the prerogative of a plaintiff to present proof first. The courts that have permitted the declaratory-judgment plaintiff to put on its case first do so under the usual rule that the plaintiff proceeds first with proof. Such a reversal of the traditional order in patent trials gives the accused infringer an enormous advantage in that the patent is under attack from the very beginning, without the patent owner having a chance to tell his or her story first. Regardless of prior cases or local rules, however, the mode and order of presentation is

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88 Cardinal Chem. Co. v. Morton Int’l, Inc., 508 U.S. 83, 89, 26 USPQ2d 1721, 1724 (1993). The reverse is not true, however. While a judgment of noninfringement does not necessarily moot validity issues on appeal, a judgment of invalidity necessarily moots the issue of infringement. Typeright Keyboard Corp. v. Microsoft Corp., 374 F.3d 1151, 1157, 71 USPQ2d 1501, 1504 (Fed. Cir. 2004); see also Sandt Tech., Ltd. v. Resco Metal & Plastics Corp., 264 F.3d 1344, 1356–57, 60 USPQ2d 1091, 1699 (Fed. Cir. 2001) (affirming district court’s determination that because the claims were invalid, the court did not need to determine infringement).


90 Id. at 98.

91 Id. at 97.

92 See also Fin Control Sys. Pty, Ltd. v. OAM, Inc., 265 F.3d 1311, 1321, 60 USPQ2d 1203, 1210 (Fed. Cir. 2001) (explaining that because OAM raised invalidity in the counterclaim, the court must rule on it as a prerequisite to entering judgment in the case). See also Durel Corp. v. Osram Sylvania Inc., 256 F.3d 1298, 1306, 59 USPQ2d 1238, 1243–44 (Fed. Cir. 2001) (finding no patent infringement, the court went on to address the declaratory judgment counterclaim of validity).

93 There have been other rationales articulated for permitting the patentee to present proof first in a declaratory judgment context, including merely that it “will lead to a more orderly presentation of proof” and “aid the Court in deciding issues.” John Wood Co. v. Metal Coating Corp., 148 USPQ 246, 247 (N.D. Ill. 1966). The concept of “more orderly presentation of proof” may have made some sense before the decision in Markman that claim construction was an issue for the court, not the jury. Before then, proof on the interpretation of the claims was presented typically to the jury, and it made some sense to permit the jury to hear the patentee’s evidence on claim construction in the first instance. But most courts now rule on claim construction before trial, and the court’s construction can be presented to the jury along with the preliminary jury instructions contained in the juror notebooks so as to aid the jury’s comprehension of the case on invalidity. Thus, the order of proof is “orderly” whether proof is presented first or last as to inequitable conduct, invalidity, and noninfringement. There no longer is a good reason to deprive a declaratory-judgment plaintiff of the traditional right of a plaintiff to proceed with presentation of proofs in the first instance. In fact, in 2005, one district court adopted local rules governing patent cases which require the “plaintiff” to make the first submission to the court regarding the construction of the patent claims. Local Rules of Court for the Western District of Pennsylvania, Local Patent Rule 4.3. While this rule applies only to the Markman briefing, it indicates a willingness by the court to recognize the perogative of a plaintiff, one that presumably will extend to trial.
within the discretion of the trial judge, who will decide whether patentee or accused infringer is to proceed first. 94

Although proof of infringement requires only a comparison of the claims of the patent to the accused product or process, limiting the patentee’s case in chief to this dry presentation is a disservice to the patentee’s case. The inventor should play a prominent role at trial even if the inventor is not a great communicator but can be made to be at least a reasonably good communicator. Application of the chronological story model to the patentee’s case certainly suggests that the patentee should begin its presentation by calling the inventor to the stand. If every story has a beginning and an ending, then the inventor and the invention unquestionably are the beginning of the story in any patentee’s case. No doubt all jurors will have an understandable curiosity about the developments made by the inventor and his motivation for developing the patented invention. If he is not available, the patentee should provide an explanation for his absence. (If the inventor is disaffected and will testify for the opposing party, a witness will need to be presented to show bias on the part of the inventor.)

The inventor (or the substitute for the inventor) should be prepared to testify regarding the creative process that led to the invention. The significance of development of the invention (the “story” of the invention) is most easily understood when combined with an introduction to the technology. This leads naturally to testimony regarding the importance and difficulty of the problem faced by the inventor. Testimony should be elicited as to how the problem was identified, and a characterization of the difficulties attendant in solving the problem should be provided, including all steps in the trial and error by which the inventor arrived at a solution to the problem. The inventor should describe the invention’s contributions to society and its many benefits. This testimony puts the inventor in a sympathetic light as someone who has worked hard and should be rewarded for his efforts.

If knowledgeable, the inventor can provide testimony on the accused product or process and when and how he learned of it. This testimony has the added benefit of being highly persuasive evidence of nonobviousness even though in the typical case, the accused infringer will not yet have had the opportunity to put in evidence regarding obviousness. 95 The benefit arises because, as noted before, jurors tend to weigh evidence as it comes in. Thus, presenting the first proofs on the issue of validity of the patent is of tremendous benefit to the patentee. The inventor, in the process of describing the background of the invention, necessarily will provide testimony regarding the level of skill of one of ordinary skill in the art and the commercial success of the invention, among other things.

94 See Fed. R. Evid. 611(a) (“The court shall exercise reasonable control over the mode and order of interrogating witnesses and presenting evidence . . . ”).

95 Judge Easterbrook described the significance of this type of evidence as follows: [T]he existence of an enduring, unmet need is strong evidence that the invention is novel, not obvious, and not anticipated. If people are clamoring for a solution, and the best minds do not find it for years, that is practical evidence—the kind that can’t be bought from a hired expert, the kind that does not depend on fallible memories or doubtful inferences—of the state of knowledge. In re Mahurkar Double Lumen Hemodialysis Catheter Patent Litig., 831 F. Supp. 1354, 1378 (N.D. Ill. 1993), aff’d, 71 F.3d 1573, 37 USPQ2d 1138 (Fed. Cir. 1995).
The inventor’s background, particularly if the inventor has worked in the field of invention for some time, is often an excellent way to introduce some prior art before the issue of invalidity is raised by the accused infringer. But be careful: since the inventor is not necessarily one of ordinary skill in the art, his testimony regarding prior art may not be admissible if it relates too directly to an obviousness determination. If a key patent or publication relied upon by the accused infringer represents the state of the art from which the invention came—an improvement over that prior art—that art normally can be addressed by the patent owner at this point either by subject or by specific citation. Inventors likely have had experience in presenting their invention to other audiences and may be most comfortable and effective if put into the role of teacher. Care must be taken here as well so as to avoid turning the inventor into an expert subject to cross-examination about the scope and content of the prior art. The inventor is best relegated to the role of a fact witness, absent unusual circumstances.

Although a substitute for the inventor may be able to provide testimony concerning the invention and the patenting process, the substitute—without firsthand knowledge—may not be able to provide the motivation to develop the invention, the trial and error necessary to solve the problem identified, or other key information known only by the inventor. If the inventor is available, his or her testimony leads naturally to the next witness, one who can explain (if the inventor cannot) the parts of the patent, the pertinent facts of the file history, and the identity of the claims at issue.

Most patentees with an appealing story regarding the importance and success of the invention will want to present that story. Despite the prohibition against presenting proof of validity in the plaintiff/patentee’s case in chief, most courts will permit a patent owner to explain the invention and the patent-in-suit with reference to the general history and setting in the art, the problem, at least some of the efforts to solve the problem, the making of the invention, and its subsequent commercialization, licensing, and recognition. Such evidence not only serves to explain the invention but also is relevant to such issues as the scope of the claims, the amount of damages that should be awarded if liability is found, and willfulness.

Patentees also generally will attempt to establish in their initial presentation and through the inventor as many secondary factors supporting validity as possible. The inventor may be able to provide testimony regarding efforts by others to solve the problem and failures either within the inventor’s company

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The issue of obviousness is determined entirely with reference to a hypothetical “person having ordinary skill in the art.” It is only that hypothetical person who is presumed to be aware of all the pertinent art. The actual inventor’s skill is irrelevant to this inquiry, and this is for a very important reason. The statutory emphasis is on a person of ordinary skill. Inventors, as a class, according to the concepts underlying the Constitution and the statutes that have created the patent system, possess something—call it what you will—which sets them apart from the workers of ordinary skill, and one should not go about determining obviousness under §103 by inquiring into what patentees (i.e., inventors) would have known or would likely have done, faced with the revelation of references. Id. at 448 (emphasis in original).
or by the art generally. He may know of research by other qualified scientists and the cost of that research. He may also be able to provide testimony regarding whether his approach or similar approaches have previously been rejected in the scientific community, and possibly the extensive development necessary to bring the invention to commercialization stage.

The corporate representative likely should be the second witness. The goals in putting forth the company representative are multiple. First is to educate the jury as to the significant investment made in the invention (or the accused product or process) and how that investment benefits the community. The second goal is to lay the first block in the foundation of evidence of damages yet to come. Third—and this is very important—the corporate representative becomes the face of the corporation and personalizes the corporate patent holder. The company representative may have an “American success” story, the poor boy who rose to the top through sheer force of determination. If so, the jury should know about it. If the company has increased its workforce and the economic prospects of the community from which the jurors are drawn, the jury should know about it. The witness selected must be knowledgeable as well as personable. He or she must inherently convey the corporate party to be likable.

Other evidence relevant to secondary considerations of nonobviousness may be elicited through presenting a marketing or sales witness, particularly if damages have not been bifurcated. This includes the extent to which the patentee’s products embodying the invention have been commercialized, industry recognition and adoption of the invention, commentary and applause from the scientific community (e.g., subsequent patents, literature, seminars, and lectures favorably describing the invention and its attributes), the commercial success of the invention and whether it has supplanted competitive products, the importance of the invention to the company and its growth/very existence (“jewel in the crown”), and its ability to generate sales of other products.

The obvious purpose of presenting any evidence additional to infringement in the plaintiff-patentee’s case in chief, if the court permits its admission, is to defang effectively the accused infringer’s invalidity evidence before the defendant even begins its case in chief. The strategy question to be resolved by the accused infringer is how much of his case on invalidity should be disclosed through impeachment on cross-examination. To hold back too much risks having the jurors reach a conclusion before the patentee rests.

If damages are not bifurcated, certainly consideration should be given to calling the company employee responsible for licensing, both into and out of the company. This, of course, provides support for the damages evidence to come, but this testimony regarding licensing of the invention to others again supports secondary considerations of nonobviousness—again before the accused infringer has attacked the validity of the patents.

Of course, where willfulness is asserted and not bifurcated, the patentee will want to supply a witness to present proof of copying by the defendant (and others if this is available), another secondary consideration. The failure by the accused infringer to find commercial success without a product or process having the patented features is important proof of nonobviousness. But presentation of this proof is also acceptable in the patentee’s case because it
relates to willfulness (if willfulness is not bifurcated. If it has been, this proof may have to wait for cross-examination in the accused infringer’s case).

The patentee will also call its expert on infringement, who will explain exactly and precisely how the accused product or process contains every element of the asserted claims. The placement and timing of this expert’s testimony is subject to many variables and will change depending on whether, for example, the issue of damages is bifurcated. If it is not, the logical sequence hereto is the chronological one. Proof of infringement, including the technical expert’s testimony, should be presented before proof on damages to be fully understood by the jurors.

Difficult strategy decisions must be made by both the patent owner and the alleged infringer where either or both of their fact witnesses (e.g., the inventor(s) or in-house experts) are within the subpoena power of the court and hence can be called as adverse witnesses. For example, the accused infringer must decide whether to cross-examine fully the plaintiff’s inventor or to wait for the second stage of the case and then attempt to recall the inventor as an adverse witness.

B. The Answering Case and Case-in-Chief

Once the initial case-in-chief has been concluded and all appropriate motions\footnote{Fed. R. Civ. P. 50 motions for judgment as a matter of law are discussed in Section VII.A.} presented, decided, or deferred, the second stage of the trial begins. Again speaking of the typical plaintiff-patentee case, the defendant (the accused infringer) now has the opportunity to answer the patent owner’s evidence and present its case-in-chief on the matters where it bears the burden of proof. Thus, in addition to answering on such issues as ownership, infringement, quantum of damages, and willfulness, the defendant will present its evidence on invalidity, unenforceability, and the appropriate measure of damages.

Assuming, as is the typical case, that the accused infringer has asserted defenses other than noninfringement, it must make the strategic decision as to the order of proof in its case. It must be determined whether the jury should hear the immediate response to the infringement proof or whether it will be best to set forth proof on invalidity or inequitable conduct first so as to attack the patentee’s credibility and make the jury more amenable to the evidence on noninfringement. The latter would follow the chronological presentation that can be most easily comprehended by the jury.

C. Subsequent Stages

In the typical plaintiff-patentee case, once the defendant has answered the opening case and presented its evidence on invalidity and unenforceability, and all motions have been decided or deferred, the patent owner presents answering evidence on invalidity and inequitable conduct. The patent owner will want to present evidence challenging the prior art asserted by the accused infringer including evidence challenging the dates of the prior art or its teachings.
or discrediting the art as being inoperative or never put to a practical use. Any testimony and other evidence in the secondary considerations of nonobviousness not presented in the case-in-chief will be presented now. Finally, rebuttal evidence on those issues where the patent owner has the burden of proof, such as infringement, will be presented. This will be followed by the accused infringer’s rebuttal on invalidity and unenforceability.

Where multiple patents are asserted by the parties and the trial is not bifurcated, and each party is suing the other for infringement, the trial stages become quite complex and can be illustrated as follows:

**Stage One.** The plaintiff-patentee’s case-in-chief on ownership, infringement, damages, and willfulness.

**Stage Two.** The accused infringer’s answering case on ownership, infringement, damages, and willfulness, regarding the plaintiff’s patent(s); case-in-chief on ownership, infringement, damages, and willfulness of its own patent(s) and on invalidity and unenforceability of the plaintiff’s patent(s).

**Stage Three.** The plaintiff’s answering case on invalidity and unenforceability of its patent(s); rebuttal case on ownership, infringement, damages, and willfulness of its patent(s); case-in-chief on invalidity and unenforceability of the accused infringer’s patent(s); and answering case on ownership, infringement, damages, and willfulness of the accused infringer’s patent(s).

**Stage Four.** The accused infringer’s rebuttal case on invalidity and unenforceability of the plaintiff’s patent(s); answering case on invalidity and unenforceability of the accused infringer’s patent(s); and rebuttal case on ownership, infringement, damages, and willfulness of the accused infringer’s patent(s).

**Stage Five.** The plaintiff’s rebuttal case on invalidity and unenforceability of the accused infringer’s patent(s).

In such circumstances, the complexity of the issues provides serious support for a bifurcated or staged trial procedure. The court has wide discretion to set the order of proofs at any trial, with an eye towards jury comprehension, simplification, and conservation of judicial resources.

### VI. Opening Statement

All jury trials provide the opportunity for opening statements, although this is a matter of custom rather than statute in most jurisdictions. The opening
statement should develop the issues being tried in a simple, logical, and chronological fashion, explaining the witnesses to be called and facts to be proven. But first and foremost, the presentation of these issues must have an emotional appeal to the jury. The foundation for emotional appeal begins with choice of language. Words have psychological impact. The chosen words shape the thoughts and conclusions of the jurors. The right word is a powerful tool and too often overlooked. The words “truth” and “honor” may sound old-fashioned but they resonate with the jury because they are concrete terms conjuring up simple, but important, ideas.

Lawyers who specialize in patent cases too often rely upon the dry language of patent law, science, and the overeducated. Patent lawyers speak of “prosecution history” and assume others understand when, in fact, the average layperson knows the word “prosecution” only in the criminal context. The unexplained use of “prosecution history” in an opening statement is not only confusing but evokes a negative connotation to the uninformed. In addition, most juries (and many judges) know nothing about patents or science or the terminology which patent attorneys use on a daily basis. It is important in the opening (and through trial) to use simple, everyday language. Words like “anticipation,” “priority,” “specification,” and “prior art” mean nothing to the average juror at the start of the trial. Describe the parts of the patent and the science in plain English and don’t use only the technical terms until the jurors have become familiar with and accustomed to those terms.

The use of arcane terms does not have to, and should not, be the norm at trial. When discussing a “means-plus-function” claim, counsel should use the word “function” and not “functionality” when describing what the structure does. Simple words with fewer syllables have more impact than complex words. If the goal is to conjure “unfair” treatment, it is more powerful to tell the jury that it is “plainly unfair” than to tell them it is “manifestly unfair.” The traditional lawyer’s arsenal of “submit,” “contend,” and “aver” should be left at counsel table. They have no place in opening statements.99

It is certainly true that the underlying purpose of any opening statement is to explain the case to the jury, to provide a road map of the evidence that will be presented so as to enable them to understand the expected evidence and testimony in the context of the case as a whole. But the opening statement must catch the jurors’ interest. The theme of the case should be introduced in the opening and should be reducible to a single sentence using key words that convey powerful and unambiguous meaning. This initial use in the opening statement sets the theme up for repetition in different contexts throughout the presentation and in the closing argument. Each time the jurors hear it invoked after the first incantation, even by inference, it will be a signal of something important about to occur. The concise theme must be, as they say in the public relations industry, “a hook.” While opening statements may not contain

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argument, they may still, and should, persuasively predispose the jury to consider the evidence from a particular point of view. They lay the foundation for what is to come and continue the process of building the base of credibility hopefully constructed during voir dire.

As discussed earlier, jurors typically adopt a story model to aid their own understanding of the facts. Jurors will approach their deliberations in the way they would in their everyday lives—chronologically. Thus, the opening statement should unfold as a presentation of a cohesive timeline of events so as to provide a context for the jury to begin its understanding of the science and technology. If a story model covering the chosen themes and theories is adopted and presented to the jury in the opening—and it is strongly recommended this be done—it should be discussed on three levels: legal, factual, and persuasive.

The legal theory describes why, as a matter of law, a party is entitled to judgment in its favor. Whatever legal theory is adopted and presented, it must be sustainable on appeal.

The factual component of the story model explains the details (the story) of what occurred, who the players are, and how the facts play out. One of the most important aspects of the story for the jurors will be the motivation of the actors. Asserting that an individual or a corporation engaged in behavior that is being characterized as “bad” (“he stole my invention”) must be accompanied by a reasonable explanation of the motivation for such behavior if the jurors are to have any chance of concluding that the acts occurred and should be characterized in such a negative fashion. Before the presentation of the factual theory to the jury in the opening, the story should be tested from all angles to confirm that it will hold together during the jury’s critical analysis during deliberations. Any blanks or gaps in the testimony and other evidence will be filled in by the jurors during deliberations by inference as to what might have or should have happened. The story told cannot be a mere recital of events. It has to weave together all important facts, and the facts must work together as a unified whole.

Although various factual theories may have been considered and investigated during discovery, by the time of opening statements, the jury must hear a single unified theory. Alternative theories or motivations are confusing and should be avoided. This is particularly so, for example, when a party attempts to argue evidence as to validity differently than it argued it for purposes of infringement. Too often the presentation of evidence has too many shades of gray that are apparent, and disturbing, to the jury. To ask a jury to pick and choose among alternative theories and alternative evidence, rather than to consider straightforward presentation of the case, invites tragedy.

The problem with the adoption of alternative and inconsistent theories can be demonstrated through the old story of the cabbages and the goats.\(^{100}\) It has various iterations but generally recounts that the owner of a cabbage patch sued her neighbor for common-law trespass and conversion. Her single and

simple assertion was that the neighbor’s goat ate her cabbages. In defense, the
neighbor promoted several theories: that there never were any cabbages; if
there were, they were not eaten; if they were eaten, it was not by a goat; if it
was by a goat, it was not the neighbor’s goat; if it was the neighbor’s goat,
the goat was insane. Although this analogy seems an oversimplification when
applied to the complexities of patent litigation, it is particularly apt. A jury
that cannot sift through alternative theories in a simple case with simple facts
will be wholly at sea in the maze of facts and alternative theories in complex
patent cases.

Last, there is the persuasive element of the story that must be presented.
There must be some element of the story that speaks to the jurors’ individual
sense of fair play and justice. The fact that the trial is a patent trial doesn’t
remove it from the jury’s inherent sense of right and justice. The determination
of each juror to find a just result comes with the juror into the courtroom and
stays throughout deliberations (unless counsel extinguishes it through a tedious
and exhausting presentation of evidence). The theory or story model presented
must invoke a commonsense application of the rules that govern or should
govern human behavior and provide for a fair penalty for breaching those rules.
Ask the jury to do the right thing.

From the patentee’s side, it may be that the “right thing” is to reward the
inventor for creativity, for providing an invention that benefits mankind or
makes everyday life simpler and easier. Certainly, the patent owner’s opening
may emphasize such things as the following:

- The American patent system is at the heart of this country’s standard
  of living and success in the world.
- Patents, issued after the diligent and hard work of the United States
government, are presumed to be valid.
- The infringer saw the invention, wanted the invention, and stole the
  invention.
- The infringer’s intentional copying deprives the patent owner of the
  reward for the substantial investment required to develop new ideas.

For the accused infringer, the right thing, the just thing to consider may
be the fairness of competition or the unfairness in rewarding misbehavior of
the inventor before an arm of the United States government—the Patent and
Trademark Office. The opening statement of the accused infringer may focus
on themes such as the following:

- The inventor violated the trust of the government by not being truthful
  when he applied for the patent.
- The inventor did not tell the government that he was selling the invention
  for more than a year before he asked for protection for his idea.
- Having a patent on a “type” of product doesn’t prevent others from
  competing, if they do so fairly.
- There are limits to patent protection.

Remember, the jury is composed of laypersons knowing absolutely nothing
about the case that is to be tried. The judge may not know much more about
the overall picture even though she has presided over pretrial discovery disputes.
The judge may have seen only a small part of the dispute during discovery and pretrial activities and may have forgotten even that. If, as often is the case in patent trials, the technology is complex and difficult, tell the jury how they will be educated about the technology. Never intimate that the jury will be unable to understand the technology due to their lack of education or the complex nature of the patent and its underlying science. Assure the jury in the opening statement by use of understandable language and clear presentation of evidence that they will be able to understand the complexities of the patent by the end of trial. Without actually telling them so, the opening statement should leave the jurors with the sense that if there is a comprehension problem, it won’t be their fault.

Finally, the opening statement may be the place to address the difficult or bad facts, particularly if they are important facts. Acknowledgment in the opening statement of bad facts in a frank and open fashion, coupled with a reasonable explanation of what the forthcoming evidence will show regarding those facts, will begin the process of placing them in a more favorable and less damaging light.

VII. Presentation of Proof

A. Examination of Witnesses

It is a natural human characteristic to try to identify with a newly met person or situation. In this regard, each witness is akin to a new acquaintance with whom each juror will attempt to identify some common bond, whether it be a goal or a motivation. The jurors will place the witness and his or her testimony into the context of their own set of beliefs and understandings, but they will unconsciously attempt to find a common ground with the witness. They most certainly will more readily identify with a witness than with a lawyer. If a witness is unfairly treated on the stand, it will have a direct negative impact on the juror’s opinion of counsel.

1. Order of Witnesses

The jury must be able to grasp the significance of each fact, preferably at the time it is presented, and understand its relationship with all other facts. The order in which witnesses are called to the stand must be dictated by this reality and not the convenience of the witnesses.¹⁰¹ If a story model has been adopted for the presentation, the evidence should unfold with each fact acting as a building block or foundation for the next. The sequence of witnesses and proofs presented through them must be logical. Some patent trial counsel first present the foundation for any ultimate scientific or legal conclusion desired.

¹⁰¹Bench trials should be handled no differently. A judge, like a juror, processes information more effectively if presented in a chronological way. The presentation of witnesses in a bench trial must still be designed to tell the story of the case and the technology in the most effective and persuasive fashion. A judge without a technical background, unversed in the law of patent infringement, is no better positioned than a juror to piece together a puzzle of evidence that is not presented in a logical fashion.
of the jury because infringement is the focus of the trial. But a better approach would be to introduce the personalities involved to permit the jury the opportunity to become comfortable in its role before inundating it with the details of the science. At the beginning of trial in the average patent case, neither the judge nor the jury will have even a minimal level of comprehension of the science or the legal or factual issues. But when the case is properly tried, the level of comprehension should increase rapidly in the middle and later stages of trial. The usual patent case starts slowly but moves rapidly at the end when the jury has become familiar with the terminology and scientific concepts.

Presentation of proof at trial is akin to putting together the pieces of a puzzle. The evidence presented will gradually fill in the puzzle to complete the picture for the jury, but in the interim, the jurors will naturally and subconsciously turn the evidence over in their minds to find a reasonable way to fit it together with the evidence previously presented. Important evidence presented early in the case and not tied together in a reasonably short period thereafter will either be lost on the jury altogether or relegated mentally to an unintended part of the puzzle. Once a juror mentally allocates a fact, it becomes hard to displace it (the principle of inertia applied to mental processes). The natural human tendency to process information as it is received is precisely the reason the court cautions the jurors against forming any opinions until deliberations begin. But human nature is what it is, and trial presentation must account for this. Thus, the order of witnesses should accommodate the themes and adopted story model of the case, fulfill the need to have interesting and dynamic witnesses lead off and close the case-in-chief, and allow for a way to address the problem of evidentiary loose ends in a prompt fashion. Problems with witness schedules may force a witness to be taken out of order, but a written plan should be made in advance of trial detailing the order in which each witness is expected to appear and outlining the testimony and proofs to be elicited through that witness and the way they fit with the testimony and proofs from other witnesses.

There is one idiosyncrasy in considering the order of the witnesses. Federal Rule of Evidence 703 requires that an expert’s testimony be based on facts “made known to the expert at or before the hearing,” coupled with those facts known through education and experience. Because the foundation for the expert’s testimony, in part, is facts disclosed to him for purposes of forming an opinion, the direct examination of the expert is more effective if it comes after those witnesses whose factual support is important to the expert’s opinions. Certainly the expert will know about those facts prior to trial and may assume them to be true and then rely upon them whether or not they were introduced previously by fact witnesses. But the impact of his testimony will be significantly enhanced to the jurors if they first hear the predicate facts from a witness with firsthand knowledge of those facts.

2. Direct Examination

The main purpose of any civil trial is to prove the case. Normally, the most important tool in proving a case or a defense is direct examination coupled, where possible, with documents and various visual aids to illustrate and back
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up the oral testimony. Direct examination must prove all the elements necessary to merit a favorable decision. It should provide, with clarity, understanding, and interest, all facts that support the desired verdict. Witnesses must be presented to the greatest possible advantage to secure acceptance of their stories as true, and they should identify and permit the introduction of all documentary and physical evidence needed to prove and, most important, corroborate the contentions of the lawyers.

When preparing for direct examination, the chosen story model should inform the testimony. Direct examination should not assume facts. It must provide the history of the people, the science, and the invention. It must start at the beginning without dwelling upon details that have little or no impact on or interest to the jury. When outlining the proofs before trial, honestly and critically assess whether it really makes any difference in the long run that the jury understands a particular piece of technology or a particular event. Present only what is truly necessary in simple and concise terms; eliminate the marginal and unnecessary, even if it is easy to prove. Limiting the proofs to essential elements eliminates confusion and enhances the jury’s comprehension.

As discussed earlier, information received only through lecture format is only minimally retained. All important facts disclosed through direct testimony should be reinforced through some visual medium. It could be as simple as showing an enlargement of a document, highlighted to emphasize the important information. It could be as complicated as computer simulation. But if the goal is to have the jury learn and retain particular information, it is important that the testimony that discloses that information be reinforced through some visual medium.

There are three basic types of questions that can be asked on direct: questions that seek a yes/no answer; questions that seek basic information and answers such as name, dates, times, and places; and questions that require an explanation by way of an answer. Direct examination is generally presented in the form of conversation largely comprised of the open-ended form of question. But consideration should be given to other techniques for direct examination that stray from the traditional form that asks a witness to provide a long, detailed answer or explanation. Adopting a variation on the cross-examination form of asking questions that have only a yes or no answer is effective. Of course, “leading the witness” in this fashion is inappropriate if the questions asked are truly yes/no questions. But the same effect may be obtained on direct by asking the witness questions in a form that requires a choice between two possibilities. This can be particularly effective on issues

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102 Presentation of direct evidence in a bench trial should not be fundamentally different from that in a jury trial with the exception that the judge likely will forgo detailed questioning regarding an expert’s credentials, be loath to entertain objections of marginal worth, and will anticipate significant use of stipulations in the pretrial statement designed to foreshorten the testimony. The “interim statement” philosophy applied in jury trials is used fully in the bench trial, with counsel being able to advise the court during the presentation of a witness’s testimony if there is a stipulation that applies or should be considered relevant to a particular matter. This is not to say that in the aid of efficiency, the testimony should be cut-and-dried. The sitting judge will still retain information better if it is presented in a vivid fashion and reinforced through the use of visual and auditory means.
in which a fact witness had multiple options available and the reasonableness of his choice needs to be emphasized, such as the issue of willful infringement.

3. Deposition Designations

Some courts encourage the parties to prepare and use narrative statements summarizing deposition testimony for unavailable witnesses instead of designating portions of the transcripts to be read. As a narrative, they are read in story form rather than the question-and-answer form of a deposition transcript. This process has certain significant advantages in a patent case, particularly when the evidence sought to be offered is dry and technical in nature. It avoids juror boredom. But there are risks attendant in this process. The narratives take significant time to negotiate and prepare and, at the end of the day, may not be a completely accurate representation of a witness’s testimony because, of course, the testimony is being paraphrased. Use of narratives also demands additional time to deal with the unavoidable and difficult issue of ruling upon the inevitable objections as to whether the characterization of the testimony that is contained in the narrative is accurate.

Although reading narrative statements has its pitfalls, so, too, does the reading of the deposition transcript or designated portions of the transcript. Even the most artfully presented reading of testimony transcript—where one member of the trial team sits in the witness chair, playing the part of the witness and reading the answers with suitable emphasis and emotion, while another team member stands at the podium reading the questions—usually does not provide an acceptable substitute for live testimony, where a choice is available. However, if it is necessary to read depositions into the record, carefully choose the persons to play the questioner and the witness. It is probably best to use

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103 In most bench trials, the trial judge will not want the depositions read into the record. Usually the judge will request that the parties submit copies of the transcript as an exhibit identifying the designations and counterdesignations on which they wish to rely, together with objections, noted in the margins. See, e.g., In re Adair, 965 F.2d 777, 779 (9th Cir. 1992) (use of written testimony is acceptable and encouraged technique to shorten bench trial). Most judges will permit the parties to highlight the submitted designation, with each party’s designations appearing in a different color. If the deposition was videotaped, the court will still insist on having the designated portions cobbled together into a new whole, rather than searching the entire videotape for the relevant portions. The judge, in theory, will read those depositions before reaching a decision, or at least those portions to which his or her attention is specifically directed in posttrial briefing. But the judge likely will form at least preliminary opinions, which can be difficult to change, during the trial, long before posttrial briefing and the reading of any deposition testimony. Consequently, if there is particularly damaging deposition testimony from the opposing party’s unavailable witnesses, that testimony can be worked into the questioning of live trial witnesses (e.g., “Mr. X, defendant’s senior vice president, testified at his deposition as follows . . . . Do you agree, and if so, why?”). Alternatively, a request may be made to the court for permission to read short, carefully selected excerpts at appropriate points in the trial.

104 The use of portions of a deposition transcript, rather than the entire transcript, is permitted under Fed. R. Civ. P. 32(a)(4), which provides:

If only a part of a deposition is offered in evidence by a party, an adverse party may require the offeror to introduce any other part which ought in fairness to be considered with the part introduced, and any party may introduce any other parts.

The key provision here is that the counterdesignations are limited to those designations that “ought in fairness” to be included. Opposing counsel cannot require the other party to include excessive additional designations designed solely to dilute the impact of the use of a deposition in that party’s case in chief.
persons who have not previously been present at trial so fresh voices are heard
(they do not need to be lawyers and might even be professional actors). By
careful selection, the play-actor may appear more impressive than the real
witness. In jury trials, the reader of the transcript may be chosen so as to appeal
to the makeup and background of the jury.

Typically the designations, counterdesignation, and choppiness caused by
excerpting objections, coupled with the jury’s unfamiliarity with the deposition
process, lead to confusion and lack of clarity when depositions are read at trial.
This is particularly true in patent cases, where the deposition may involve
scientific matters and concepts that were not fully explained (because both the
questioner and the witness knew the terms and what they meant so did not
take the time to explain them as a witness at trial would do). In short, reading
lengthy depositions at trial may put the jury to sleep, and the impact of the
testimony may be seriously limited. Deposition designations should be read
only when absolutely necessary.

Videotaped depositions have advantages over a bare transcript because
the jury is able to see, hear, and evaluate the demeanor of the witness as he
or she testifies. Playing video depositions, however, usually requires a darkened
courtroom, often considered a signal for rest and inattention. If a videotaped
deposition is used, the judge should have a monitor, and the jurors should have
one large or two small monitors to ensure every opportunity to clearly see the
demeanor of the witness. As with transcript designations read at trial, most
judges will insist on ruling on any objections in advance of showing the
videotape so that it can be edited to delete the objections or questions and
answers found objectionable.

A word of caution about using deposition transcripts substantively. Generally deposition testimony cannot be used to prove the existence of a fact
or admission by a party witness if the deponent is available to be called in
open court. When available, the deponent will have to be called to the stand
and may be cross-examined on prior testimony including testimony from prior
cases (if the prior testimony meets the requirements of Federal Rule of Evidence
804(b)). It is a particularly tempting strategy to attempt to use prior testimony
from the expert witness who makes a living testifying about particular types
of technologies or subject matter and who has previously testified about the
patent-in-suit. But prior deposition testimony cannot be affirmatively used

105 Federal Rule of Civil Procedure 32(a) permits the substantive use of deposition transcripts “so far
as admissible” under evidentiary rules “as though the witness were then present and testifying.”
106 Prior testimony generally may be used, however, to refresh recollection (Fed. R. Evid. 612); as
proof of a statement against interest (Fed. R. Evid. 804(b)(3)); and for impeachment by a prior inconsistent
statement (Fed. R. Evid. 613 and Fed. R. Civ. P. 32(a)(1)). Impeachment by means of a videotape deposition
is particularly effective as it permits the jury to view the inconsistent statement and assess the witness’s
body language. This makes the impeachment more powerful. But to be effective, the precise sequence in
the videotape must be instantaneously available.
107 Rule 804(b)(1) provides that former testimony is not hearsay if it is (1) testimony taken under oath
and received in accordance with procedural requirements and (2) taken in the course of a proceeding; and
(3) if the party against whom it is being used had an opportunity and motive to develop the testimony either
by direct, cross, or recross.
absent a finding that the expert gave the designated testimony as an agent for
the party against whom the statement is designed to be used.108

4. Cross-Examination

Cross-examination is not obligatory, although most trial lawyers are loath
to admit this. It is permissive. It should be undertaken only if there is a good
reason to cross-examine a witness. If the direct examination of a witness has
failed to elicit any damaging testimony, cross-examination should be resisted.
The primary object of cross-examination is to secure admissions of fact that
tend to prove a contention or to corroborate proof of a claim. The secondary
object is to discredit a witness or her story. Every question asked opens the
doors for potential damage, particularly when a witness avails herself of the
opportunity to explain or elaborate. Any points to be made on cross-examination
must clearly relate to the story or theory of the case and should make a fact
to be decided by a jury more or less likely to be true. Only in rare circumstances
can the sole purpose of the questioning be to point out with unchallengeable
certainty that the witness is untruthful and not credible. Even then, the point
made must be undeniable.

There are a few general principles to follow in any cross-examination:
select only a few key points upon which to cross-examine the witness, let the
ultimate conclusion of the line of questions be unstated (to be inferred by the
jury), and ask only leading questions.109 Focus on prior inconsistent statements
and documents that contradict testimony, making it nearly impossible for the
witness to disagree with the statement. Admissions secured from the mouths
(or documents) of the opponent’s client and witnesses usually are given
great weight.

Cross-examination requires well-defined goals and objectives. With the
advent of the modern pretrial procedures and the disclosure requirements of
the Federal Rules of Civil Procedure, any surprise witness or document (in all

147, 164 (3d Cir. 1995), cert. denied, 516 U.S. 1145 (1996), the United States Court of Appeals for the
Third Circuit explained the rationale for this conclusion as follows:
In theory, despite the fact that one party retained and paid for the services of an expert witness,
expert witnesses are supposed to testify impartially in the sphere of their expertise. Thus, one can
call an expert witness even if one disagrees with the testimony of the expert. Rule 801(d)(2)(C)
requires that the declarant be an agent of the party-opponent against whom the admission is offered,
and this precludes the admission of the prior testimony of an expert witness where, as normally will
be the case, the expert has not agreed to be subject to the client’s control in giving his or her testimony.
is not subject to the control of the party opponent with respect to consultation and testimony he or
she is hired to give, the expert witness cannot be deemed an agent. See Restatement (Second) of
Agency §1 cmt. a (1958) (“The relation of agency is created as the result of conduct by two parties
manifesting that one of them is willing for the other to act for him subject to his control, and that
the other consents so to act.”).

109 These principles apply as well in bench trials with the caveat that a judge, even more than a jury,
wants the cross-examination to be limited to the important points. If questioning the witness will fail to
unearth anything significant to the legal issues to be decided, it may be best to forgo cross-examination in
a bench trial rather than risk annoying the judge with an irrelevant cross-examination focused only on
collateral issues that will not affect the rulings of the court.
but the most rare situations) will be anticipated before trial. A detailed outline of cross-examination should be prepared before trial actually commences, rather than during trial. In doing this, it is imperative to make an honest assessment of the statements the witness will likely make on direct examination and whether those statements will contradict prior statements. If they will, the outline must contain a specific and detailed reference to the prior statement so that immediate reference to it may be made during cross-examination. The documents or depositions used to impeach the witness must be close at hand so that there is no delay in presenting the witness with the inconsistent statement. Certainly the jury will be grateful that time is not being wasted, and having references to impeach immediately at hand will afford the witness less time to consider the formulation of any justification for the changed testimony. Most important, any evidence used to impeach a witness must be admissible. Before attempting to impeach any witness with any evidence, determine whether the evidence is relevant, whether it is hearsay, and the basis of its foundation.

Cross-examination, particularly when it is directed to difficult-to-understand scientific and technical issues, is not necessarily an exercise in finding the correct answer. Most jurors will not be educated or sophisticated enough to comprehend whether testimony regarding science and technology is correct. But they most certainly will understand whether a witness can be trusted to tell the truth. A witness who testified differently at trial than in deposition probably testified differently on more than one fact or issue. No doubt one of the inconsistent statements is markedly more important than the others. If this is the case and time permits, it may be best to start with statements having less importance first and build to the key statement. The jurors are accustomed to a story building to a great conclusion, even if they can sense the direction it is going. Tripping up a witness on lesser (but still pertinent) inconsistent statements while building to the key fact creates a sense of anticipation in the jury (and the witness as well, of course). By the time the conclusion comes, the credibility of the witness is already shaken and any justification or explanation made for the critical prior inconsistent statement is less likely to be accepted by the jury.

Cross-examination should be avoided unless there is sufficient ammunition to extract important admissions or impeach the credibility of the witness. This is true even if the direct examination has scored points. If concessions cannot be obtained, cross-examination serves only as a method for the witness to repeat and reconfirm the direct testimony. Consider whether it is preferable to counter this witness’s testimony through expert testimony or other fact witnesses than to risk reinforcing the testimony on direct. If more attractive or less time-consuming options to counter the witness’s direct testimony are available, cross-examination may be waived entirely or limited significantly.

Demeanor on cross-examination can be of critical importance. Generally, a firm but polite approach will pay dividends while a harsh, overbearing manner, particularly with fact witnesses, will not, especially with a witness who has the jury’s sympathy. Too harsh an approach may only confirm the juror’s likely view that lawyers are simply mean-spirited and able to confuse and intimidate even the most truthful witness. This is particularly important with the inventor,
who may be well respected in his field or has obtained significant recognition for his work over his career. Aggressive cross-examination of expert witnesses generally does not generate the same reaction. The jury recognizes that the expert is being paid to attend trial and has subjected himself voluntarily to cross-examination. But any witness with the right approach and demeanor on direct examination can become a sympathetic figure if the cross-examination is unnecessarily extreme and if the impeaching evidence and/or admissions extracted do not match the cross-examiner’s tone of voice and body language. Gratuitous sarcasm and disrespect to any witness generally will not pay rewards.

Where permitted by local court practice, the considerations of whether to conduct recross-examination are essentially the same as when deciding whether to conduct cross-examination in the first place. Neither the jury nor the judge appreciates questioning that is a mere rehashing of what came before. Do not recross unless a real purpose for doing so exists.

There are particular goals to consider when cross-examining the inventor, but it is important to remember that unless the inventor has testified on direct in a particularly unfavorable light, particular care must be taken in his cross-examination. The jurors will just have learned of his great accomplishments and his contributions to society. To attack the inventor in a direct and overt fashion may be more harmful than helpful even if admissions against interest are torn out of him. A more oblique cross-examination is more effective. He should be asked to explain his invention in detail, without reference to the patent itself, particularly if discovery has shown that his understanding does not comport with the theories of the patentee. If his explanation differs markedly from the claims, it may be supportive of a Section 112 defense of failure to point out and distinctly claim the invention. If he insists on answering only after having referred back to the specification of the patent, point out that he is not able to describe his own invention without looking at the patent. When attacking the best mode, confirm his understanding of the most effective component, ingredient, compound, or method of making or accomplishing the invention described in the claims with the goal of gaining admissions not described in the specification. He should be questioned on his understanding of the prior art that he believes to be closest to his invention. Try to obtain concessions from him regarding what others of ordinary skill in the art may have known or been aware of at the time of his invention. Make him walk through the asserted prior art and question him regarding whether certain changes would have been obvious and why they would or would not have been.

When infringement under the doctrine of equivalents has been asserted by the patentee, the inventor is rightly cross-examined on the way the disputed elements of the claims contribute to the function of the invention. If the inventor is knowledgeable about the commercialized product (or process), and most inventors are, question him regarding the features of the commercial invention that are not part of the claims of the patent. Ask him why they needed to be added to the commercial embodiment of the invention. Every additional feature of the commercial embodiment of the invention that is not present in the patent claims supports a reduced nexus between the commercial success of the product or process and the patent claims.
5. Examining the Expert Witness

Direct examination of the expert witness\textsuperscript{110} has three components: (1) qualifying the expert sufficiently to obtain a ruling that her testimony is being received as expert testimony; (2) obtaining the expert’s opinion (“Have you formed an opinion . . . ?” and “What is that opinion?”); and (3) laying the factual foundation for the opinion. If an expert is particularly well qualified, a party may wish to stipulate that she is an expert so as to deprive the jury of the full impact of those credentials, although it certainly is acceptable nonetheless for the party calling the expert to elicit testimony describing the expert’s education and experience related to the technology, any pertinent publications, and any honors or other distinctions.

In eliciting the expert’s credentials, it is important to emphasize the factors that weigh in favor of credibility in the eyes of the jurors, particularly when contrasted with the other side’s expert. Experts with a combination of university or publishing credentials, coupled with hands-on experience in the business world, are traditionally received better than the pure academic scholar.

Occasionally, it is appropriate to seek permission to voir dire the expert before the jury regarding her credentials so as to challenge them. While this is not likely to be successful, it does provide an opportunity to weaken the expert’s credentials before any opinion is elicited. But it is important not to quibble about qualifications of an expert if there is not a significant disparity. Jurors with a high-school education are unlikely to perceive a college degree from a major university to be anything other than impressive.

The fundamental consideration in conducting the direct examination of any expert, but particularly the expert in a case with complex technology, is that the jury will give little weight to an opinion that cannot be understood. On direct, the expert’s testimony should present the scientific principles and related facts at issue, describe any appropriate inferences that may be drawn from those facts and principles, and provide a reasonable conclusion drawn from the facts, principles, and inferences. The examination should take the jury, in small progressions with easily digestible facts, through each step taken by the expert to reach her ultimate opinion.

Unquestionably, cross-examination of an expert is an especially delicate matter. Experts are paid to be advocates of their positions, and they uniformly know more about their area of expertise than any counsel in the courtroom. It is essential during cross-examination of the expert to keep the questions keenly

\textsuperscript{110} The examination of an expert witness frequently differs substantially when trial is to a judge rather than a jury. Most likely the court will not want to waste the time required for the traditional give-and-take on direct examination that is involved in eliciting the expert’s credentials. Instead, a judge more likely will receive those credentials in the form of the curriculum vitae of the expert and ask for a stipulation from opposing counsel. Most lawyers will stipulate except in the unusual circumstance in which the expert’s credentials are wholly inappropriate for the testimony being offered. The trial judge, like most judges except those of the Federal Circuit, is a generalist. Most likely he or she will not have a degree in the sciences. It is extremely important for the expert witness to develop a rapport with the judge and, if this is done effectively, the witness will become the teacher, the guide for the court through the confusing details of the science at issue.
focused on only those points that can be quickly and clearly made. It is always a mistake to stray into uncharted territory. But even the expert witness who has made valid and well-stated points on direct examination can be successfully cross-examined.

If the expert’s testimony on direct was strong and her opinion well stated, it may be that the cross-examination of an expert can be limited to questioning only those facts or points that are supportive of the cross-examiner’s case. There may be areas in which the science underlying her opinion is weak, and it is fair to point this out. If the expert’s opinion is predicated on facts assumed rather than facts known, this too can be pointed out on cross-examination. This tactic is especially helpful if the facts being assumed were provided by opposing counsel rather than being received directly from persons knowledgeable about the facts. Even a very successful direct examination can be attacked on the grounds of bias. One particularly successful way to present bias is to juxtapose the questions on bias with the questions on important substantive points to be made. The jury will instinctively tie the two together. Bias may also be shown by highlighting that the witness has testified previously on behalf of opposing counsel’s lawyer or law firm, provided consulting to the opposing party, or has other financial ties to a party, although quibbling over minor connections is likely to be unpersuasive. Although useful in some contexts on cross-examination, hypothetical questions tend to be a mystery for jurors. Instead of the hypothetical question, an effective method of cross-examining the foundation of the expert’s opinion is to question whether the opinion would change if this fact or that fact were different. The expert may also be challenged by other authorities that contradict her position, or by a lack of real-world experience to support theoretical concepts.

It is almost always a mistake to attack a well-credentialed expert head-on with brute force. It is better to attack the facts and not the person. It is better that the attack be subtle rather than offensive. It cannot be emphasized too often that jurors identify with the witness, even the expert witness. They rarely identify with counsel.

B. Evidentiary Issues

The rules of evidence define specifically “when” an objection111 to (or motion to strike) evidence must be made, although they provide little guidance as to the “how” of an objection. Making an objection serves a dual purpose that is of great import in a patent trial. An objection preserves an issue for appeal, but at its heart, the objection is an opportunity to persuade the court and lay the foundation for objections to related evidence. Because the technology and the law are complex, judicious use of objections helps to clarify the technical and legal issues for the court. If a judge permits objections to be argued in the presence of the jury,112 it is an invitation to restate in broad terms the case and

111 Fed. R. Evid. 103(a)(1).
112 The number of federal courts that permit argument of objections before a jury is dwindling, particularly in light of the caution of Fed. R. Evid. 103(c) that trials should be conducted so as to “prevent
how this piece of evidence fits into the case. On appeal, trial counsel is rarely
taken to task for having said too much but frequently is deemed to have waived
an issue by having said too little.

It is assumed for purposes of this chapter that anyone trying a patent case
is familiar with the Federal Rules of Evidence, as well as the law applicable
to patent cases. Yet “litigators must preserve issues if they are to test in [the
Federal Circuit] the boundaries of the law. They can preserve issues for appellate
review only by objecting during trial.” 113 The trial isn’t just about technology
or about themes and presentation; it is also about making a record for appeal.
Evidence proffered by the other party that can be excluded on some evidentiary
ground probably should be excluded absent unusual circumstances. Full and
complete knowledge of the hearsay rule is paramount; hearsay abounds in
patent trials. It exists in the inventor notebooks, and it is the basis for expert
testimony and the computer simulations used to explain the technology.

1. The Inventor Notebooks

The inventor notebooks create a special problem in patent trials. They are
invaluable for proof of inventorship, confirming dates, and helping the jury
understand the complexity of the problems solved by the invention of the
patent-in-suit. The use of inventor notebooks, however, is typically to prove
the truth of what is contained therein. They also are relied upon to show the
nonexistence or nonoccurrence of an event that ordinarily would be contained
in such a log of activities. They thus contain hearsay. As essential as they may
be to the proof, inventor notebooks are subject to exclusion under Federal Rule
of Evidence 802 (the “hearsay rule”) 114 unless used for purposes that fall under
Federal Rule of Evidence 801(d) 115 or one of the exceptions to the hearsay rule.

Typically, inventor notebooks may be used substantively in a patentee’s
case-in-chief regardless of whether the inventor is available to authenticate
them, but only if they fall under Federal Rule of Evidence 803(6)—Records
of Regularly Conducted Activity. To qualify for the Rule 803(6) exception,
the notebook entries must be (1) made at or near the time of the activity
recorded; (2) made by a person with knowledge; (3) kept within the “course
of a regularly conducted business activity;” and (4) kept as a regular practice
of the business. 116 This is easy enough for a large corporation with a highly
developed and well-organized research and development department. But this
is not true for all companies or all inventors. If the inventor is unavailable,
and the accused infringer will not stipulate to the admissibility of the inventor

114 “Hearsay” is a statement, other than one made by the declarant while testifying at the trial or
hearing, offered in evidence to prove the truth of the matter asserted.” Fed. R. Evid. 801(c).
115 Rule 801(d) excludes from hearsay certain prior statements of a witness and admissions of a
party-opponent.
116 Fed. R. Evid. 803(6).
notebooks, a “custodian or other qualified person” must provide testimony supporting compliance with the elements required by Rule 803(6).117

In circumstances in which inventor notebooks have been excluded, it is generally because there was no testimony from the “custodian or other qualified person” that the notebooks were “records of regularly conducted activity.” In this case, the notebooks also would not fall within protection of Rule 807 because there was no evidence of “circumstantial guarantees of trustworthiness.”118 Exclusion on this basis is easily preventable by planning in advance to present a sufficient foundation for the admission of the notebooks through the custodian of the records.119

Even when the authenticity of the inventor’s notebook is stipulated, it is still good practice to review with the inventor on direct the process of creation of the notebook. A series of questions should be posed designed to walk the inventor through the routine of creating the notebooks, including how he determined which results of which experiments would be transcribed into the notebook. The inventor also should confirm his habit of capturing details of the experiments in clear, complete language. The inventor should explain the significance of the signing, dating, and witnessing of each page and should confirm that it was done contemporaneously (or nearly so) with the entry of each day’s notes. These facts help the jury to understand the significance of the notebook and confirm the accuracy and trustworthiness of its contents. Help the inventor point out that if there were any errors, they were not erased but were struck through with a single line, and have him confirm that no entry on any page was changed after the page was signed and witnessed.

In circumstances in which the inventor is available to testify and the accused infringer has successfully excluded the inventor notebooks, cross-examination must tread lightly. The inventor notebooks will be deemed “non-hearsay” if they are consistent with present testimony and are necessary to combat a charge of recent fabrication or improper influence or motive.120

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117 Id. Of course, there is always the possibility of admission under the Residual Exception to the Hearsay Rule set forth in Federal Rule of Evidence 807, but this requires proof that the notebook possess “circumstantial guarantees of trustworthiness.” To bring the notebooks under the umbrella of Rule 807, trial counsel additionally must prove that the notebooks (1) support a material fact, and (2) are more probative toward the point that they support than any other evidence the proponent can offer.

118 Shu-Hui Chen v. Bouchard, 347 F.3d 1299, 1308 and n.7 (Fed. Cir. 2003).

119 Knowledge of the hearsay rule and what constitutes nonhearsay isn’t the end of the inquiry regarding the inventor notebooks. They may still be excluded if the purpose for which they are offered does not meet the threshold Rule 401 test of relevance (i.e., evidence is relevant if it has “any tendency” to make the existence of any fact that is of consequence to the determination of the action more probable or less probable than it would have been without the admission of the evidence). If an objection is made on the grounds of relevance, the party opposing the objection should be made to explain with specificity the fact of consequence that is made more or less probable by the purported nonhearsay. Nonhearsay must also meet the requirements of Rule 403. Even if 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.

120 Fed. R. Evid. 801(d)(1)(B) (“A statement is not hearsay if—The declarant testifies at the trial or hearing and is subject to cross-examination concerning the statement, and the statement is consistent with the declarant’s testimony and is offered to rebut an express or implied charge against the declarant of recent fabrication or improper influence or motive.”).
2. Admissions

Often overlooked in preparation of the pretrial statement and preparation of motions in limine is consideration of the admissions made by witnesses involved in earlier litigations concerning the same or related patents. Prior statements by parties, and sometimes their expert witnesses, are fertile grounds for cross-examination. But they may also, if they meet certain criteria, be deemed judicial or evidentiary admissions. In anticipation of trial, the existing record, including all important documents produced in discovery, depositions transcripts, and transcripts of arguments before the court, should be combed to identify any potential admissions made during the course of the earlier litigation. Early identification of admissions helps to uncover potential motions in limine and to limit the scope of what may be elicited by the opposing party at trial. There are two types of admissions: evidentiary admissions and judicial admissions.

Evidentiary admissions are words or conduct admissible in evidence as an admission of a party opponent under Federal Rule of Evidence 801(d)(2). Although made and presumably binding, these may still be contested by a party. Typically they are made in the context of pleadings in other cases (not the one before the court) such as interrogatory answers, depositions, and statements of a party made in open court. But except for those specialized, rare assertions characterized as judicial admissions, a party is entitled to explain an admission and even to retract it. When that is done, the factual evaluation of the admission vis-à-vis explanation, retraction, or repudiation is for the judge or jury. In these circumstances, the statement may still be used for cross-examination even though it will not have binding effect.

Distinct from evidentiary admissions, judicial admissions are made through pleadings, responses to requests for admission, memoranda of law, stipulations, or by counsel in open court and generally, but not always, in the case presently before the court. Once made, they are binding on a party and cannot be controverted by the party at trial or on appeal. Examples of judicial admissions are formal statements by a party or his counsel made during the course of the present judicial proceedings that concede the truth of some alleged fact. Such statements act to dispense with the need to produce evidence of the alleged fact. To be an admission, it must be a clear and unequivocal statement of fact and must relate to an essential fact or defense alleged by an opponent. This type of admission has particular application to patent infringement actions when a single patent is used as the basis of multiple lawsuits against various defendants.

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121 Martinez v. Bally's Louisiana, Inc., 244 F.3d 474, 476–77 (5th Cir. 2001). Rule 801(d)(2) provides that a statement is not hearsay if the statement is offered against a party and is that party’s own statement, a statement of which a party has manifested an adoption or belief in its truth, a statement made by a person authorized to make that statement concerning that subject, a statement made by an agent concerning matters within the scope of that agency, or a statement made by a coconspirator during the course and in furtherance of the conspiracy.


123 Reynolds v. C.I.R., 296 F.3d 607, 612 (7th Cir. 2002).


125 Id.
Some circuits even permit an expert admission to become binding and preclude later contradiction in certain circumstances.\(^{126}\) Prior expert testimony relating to the patent-in-suit in an earlier action against another infringer is a particularly fertile source of potential admissions, depending upon the relationship between the expert and the patentee. If enough facts exist to create an agency relationship, earlier testimony may be binding.

The key question regarding admissions is how best to have them presented to the jury for maximum impact. Certainly, an unequivocal admission may, with court approval, be included in the jury notebook along with the stipulations. But the court must first rule on whether the “admission” is one that may be controverted or is one that is binding. If the admission is in an answer to a request for admission, it potentially can be read to the jury with the permission of the court and included in the jury notebook. If it is an evidentiary admission, it likely has to be used during cross-examination, solely for impeachment.

There are pros and cons to be weighed in evaluating whether a potential admission should be the subject of a pretrial motion. Certainly, if the admission is clean enough and it is clear that the opposing party will have difficulty controverting it, the admission should be raised before trial and a ruling made on whether contradictory testimony can be elicited at trial. If, however, the potential exists for the party to avoid the finding of an admission at the pretrial stages, the disclosure of the admission through a motion in limine will signal the opposing party to be ready for the use of the inconsistent statement at trial and to be prepared to deal with the statements during cross-examination. But the benefit of having made a record to exclude testimony inconsistent with an admission probably militates in favor of a formal motion to exclude the evidence.

3. Offers of Proof

Offers of proof are governed by Federal Rule of Evidence 103 and are required to be made out of the hearing of the jury if it is practicable to do so.\(^{127}\) If the other party objects to the admission of certain evidence, the court

\(^{126}\) Fox v. Taylor Diving & Salvage Co., 694 F.2d 1349, 1355–56 (5th Cir. 1983); City of San Antonio v. Miranda, 683 S.W.2d 517, 520–21 (Tex. App.—San Antonio 1984). However, the better theory is that the statements of an expert may only be admissions if the expert was acting as an agent for a party. In Kirk v. Raymark Industries, Inc., 61 F.3d 147, 164 (3d Cir. 1995), the court explained the reasoning as follows:

In theory, despite the fact that one party retained and paid for the services of an expert witness, expert witnesses are supposed to testify impartially in the sphere of their expertise. Thus, one can call an expert witness even if one disagrees with the testimony of the expert. Rule 801(d)(2)(C) requires that the declarant be an agent of the party-opponent against whom the admission is offered, and this precludes the admission of the prior testimony of an expert witness where, as normally will be the case, the expert has not agreed to be subject to the client’s control in giving his or her testimony. See Sabel v. Mead Johnson & Co., 737 F. Supp. 135, 138 (D. Mass. 1990). Since an expert witness is not subject to the control of the party opponent with respect to consultation and testimony he or she is hired to give, the expert witness cannot be deemed an agent. See RESTATEMENT (SECOND) OF AGENCY §1 cmt. a (1958) (“The relation of agency is created as the result of conduct by two parties manifesting that one of them is willing for the other to act for him subject to his control, and that the other consents so to act.”).

\(^{127}\) Federal Rule of Evidence 103(c) provides:

Hearing of the Jury. 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.
may ask for an offer of proof regarding the evidence. Principally, the offer of proof functions to make the court aware of the specific arguments for the admissibility of evidence while there is still time for the court to rule on the admissibility. But it is also to make a record for appeal that the evidence, if excluded, was excluded improperly. The offers of proof, like objections, must be very detailed, specific statements, factually and legally supported, that provide the basis or theory upon which evidence should be admitted into the record. They must explain the evidence, generally technical in nature, in a way that allows the court to understand it well enough to make an informed decision regarding admissibility.

The offer of proof in the patent case provides an opportunity to educate the court as to the technology as well as the issues. Counsel has the chance to make a mini-presentation of how the specific evidence, frequently technical, is substantial to the case and negates the position of the opposing parties. If there is any hope of convincing the judge that the evidence should be admitted, the legal relevance needs to be easily understood and persuasively presented. The science and the law in patent trials make it particularly important to construct an understandable summary of the evidence offered and its legal relevance. When the issue relates to testimony, it may, and sometimes should, require counsel to use models, animation, simulations, or other tools to inform the court. The offer must be made in clearly articulated and plain English, free of technical mystery. In some jurisdictions, the court may permit a witness to testify out of hearing of the jury as the form of offer of proof, with a determination of admissibility deferred until after the testimony is heard by the court. The offer of proof is a critical tool for preserving issues on appeal.

4. The Bench Brief

In anticipation of and in connection with the offer of proof made in response to objections to critical evidence, a bench memo should be available for contemporaneous submission to the court to put the proffered evidence into its legal context. Motions in limine will have, or should have, resolved most evidentiary issues before trial, except unexpected testimony that strays into the realm of hearsay, lay expert opinions, or irrelevant material. However, it may be wise not to raise all issues through motions in limine. If there is doubt as to whether an issue will be framed by the opposing party, it may be best to defer raising the issue until trial itself so as not to signal the issue to the adverse party. In these cases, it is essential to prepare bench briefs on these issues to hand up to the court once an objection is made. The briefs ideally are only a page or two in length and provide a quick review of the law to the court. It is also appropriate to provide the court copies of any cited cases.

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128 Federal Rule of Evidence 103(a)(2) requires, in the first place, that to preserve for appeal the issue of whether evidence was wrongly excluded by the district court, the proponent must make known the substance of the evidence sought to be admitted by an offer of proof unless it “was apparent from the context within which questions were asked.” Beech Aircraft Corp. v. Rainey, 488 U.S. 153, 174 (1988).

129 Reese v. Mercury Marine Div. of Brunswick Corp., 793 F.2d 1416, 1421 (5th Cir. 1986).

130 Indeed, some district court judges do not want bench briefs but would prefer copies of cases handed up that have been highlighted to identify the relevant passages related to the objection being asserted.
C. Direct Evidence

To the extent possible, evidence should be presented visually to help the jurors, and exhibits, particularly physical exhibits, are critical in this regard. Too many attorneys focus the presentation of their own case solely through the oral testimony of their witnesses. Oral testimony is essential at trial, but as previously discussed, the jury will understand and retain more of the evidence if witness testimony is supplemented and reinforced through the use of pictures, videos, animations, charts, or drawings that accompany the testimony. Visual evidence used in combination with oral testimony will increase believability, capture attention, and prevent boredom. This is particularly important in patent cases, where the jurors are exposed to technology about which they have little, if any, advanced knowledge. Visual evidence should be used in the courtroom whenever possible in combination with the testimony. And if the nature of the case permits—and frequently this happens in patent cases—use as many three-dimensional physical exhibits as possible, even exhibits with smell or taste. But beware of overtaxing the jurors and distracting focus from the testimony. The purpose of exhibits, particularly physical exhibits, is to enhance and strengthen the witnesses’ testimony, not distract the jurors from the substance of the testimony.

A considerable amount of documentary evidence is admitted in the average patent trial that simply does not focus on the key issues to be decided by the jury. The number of documents in even a small patent case can run to the hundreds of thousands, and only a small number of these should end up as trial exhibits. Every exhibit admitted dilutes the impact of the other admitted exhibits. The greater the number of exhibits at trial, the greater the risk of juror confusion. Serious effort should be made to streamline the presentation of documentary evidence. As with so many other parts of the trial, here, too, “less is more.”

The selection of a document for use as an exhibit from within the voluminous mass of document production, or creation of an exhibit from whole cloth, is just the first step in developing reinforcement for the live testimony of witnesses. The way exhibits are handled at trial and how they are presented, explained, and highlighted is as important as their actual content. Particularly in patent cases, where complex scientific concepts are difficult to comprehend, key exhibits that state or strongly infer the scientific concepts to be proven are invaluable in raising the understanding of the jurors but only if handled properly.

Exhibits serve two purposes: first, to explain information, and second, to persuade. To accomplish this they need to be organized and clearly presented. The exhibit should be simple enough that a juror can quickly understand it and, if necessary during deliberations, explain it. When the exhibits used are photographs, videotape re-creations, computer animation and simulations, and models, they should be fully incorporated into the witness’s testimony to emphasize and reinforce that testimony. If the court allows it, the witness should ask to step down from the witness box and to stand next to the exhibit while she uses it to explain her testimony. This will make the trial more interesting for the jury and will enhance the jury comprehension.
Exhibits do not need to be fancy or complex to be helpful to the jury and persuasive. For example, a simple “Yes/No” chart created as the testimony is related helps to visualize that the accused device contains every element of the asserted claim or claims of the patent and can easily be used for reference during closing arguments. Timelines relating to inventorship, when contrasted with or overlying the prior art, help refine issues of obviousness and unenforceability. Decision trees can be used to show the potential options for action and the course selected (the decision made). In the case of inequitable conduct assertions, this can help demonstrate intent by showing that the inventor had a particular series of choices available regarding withheld prior art and yet chose the one course that prevented the Patent Office from learning of the reference that coincidentally would enhance his ability to obtain a patent. This focuses the jury on the issue of intent and whether the actions of the inventor were appropriate.

A good exhibit will be referred to by the jury during deliberations to confirm the statements contained in it, particularly if there is confusion among the jurors as to the oral testimony presented at trial. The well-selected or prepared exhibit stands as independent corroboration of a witness’s testimony (or its false nature). There are certain universally accepted characteristics of a “good exhibit”:

- It is easily viewed by the jury.
- It has simplicity and is not cluttered with multiple points but contains only a single idea or concept.
- It is clear and concise, leading the reader to understand its point with little extrapolation.
- It has visual appeal.
- It is admissible (this cannot be repeated enough).

In this regard, there are several questions to be asked and answered to confirm that a proper legal foundation exists before attempting to introduce the exhibit at trial:

- Is it relevant?\(^{131}\)
- If relevant, is the relevance outweighed by unfair prejudice or other factors?\(^ {132}\)
- Is the exhibit admissible as nonhearsay?\(^ {133}\)
- If hearsay, is the exhibit admissible under one of the exceptions to the hearsay rule?\(^ {134}\)
- Is the exhibit speculative?\(^ {135}\)

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\(^{131}\) Fed. R. Evid. 402 (“All relevant evidence is admissible.”).

\(^{132}\) Id. 403 (the probative value of the evidence must outweigh the dangers of unfair prejudice, confusion of the issues, etc.).

\(^{133}\) Id. 801 and 802 (Hearsay Rule).

\(^{134}\) Id. 803 (Hearsay Exceptions; Availability of Declarant Immaterial).

\(^{135}\) Id. 602 (“A witness may not testify to a matter unless evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter.”).
If the answers to these questions confirm that a proper legal foundation can be laid, the exhibit can be used at trial. Once at trial, there are several steps to the successful admission of exhibits into evidence. Once the foundation is laid, any asserted objections raised by opposing counsel must be overcome. This is typically part of the pretrial conference, where each party is required to state any objection(s) to the other side’s exhibits. This practice often leads to an objection to most of the listed exhibits (to preserve the right to object at trial) followed by a final determination during trial as to whether the objection really is worth making. In a jury trial, most judges will hear and decide exhibit objections prior to trial.\footnote{In a bench trial, the judge will admit all exhibits subject to the stated objection(s) and then wait until the exhibit is actually relied on either at trial or in posttrial briefing before ruling on the objection.}

The witness is questioned about the exhibit to authenticate it and lay the foundation for its admission. The exhibit then must be “moved” into evidence. Some courts will allow a general offer at the beginning of each party’s respective case of all exhibits identified and not objected to at the pretrial conference. The offering party need only provide the clerk or the court reporter with a list of exhibits to which no objection has been made. Then when an exhibit is referred to during testimony, the exhibit will be deemed offered and admitted. Other courts, especially in jury trials, require an individual offer and admission of each exhibit. The offer can be during or at the end of the identifying witness’s testimony. The identifying witness should not step down from the stand until the exhibit has been offered into evidence and a ruling has been obtained on each exhibit for which the witness is responsible. If an objection to the admission of the exhibit is made, the witness may need to offer testimony to further explain or support the admissibility of the exhibit.

An affirmative ruling from the court as to the admissibility of each disputed exhibit must be obtained in order to preserve issues for appeal. Do not let the court avoid a ruling if admissibility is contested, and ask the court for clarification if any ambiguity exists as to the ruling on admissibility. Many times the opponent will ask to reserve objection pending cross-examination of the sponsoring witness. Once cross-examination is completed, the exhibit must be reoffered to obtain a ruling on admissibility. Alternatively, if opposing counsel asks to defer his or her objection pending some future event, such as cross-examination, ask the court to admit the exhibit now, subject to objection if made after the event (e.g., cross-examination) has occurred. This shifts the burden to the opposing party to make a future objection and obtain an exclusionary ruling. Otherwise, the document will stand admitted.

A record should be made that unambiguously establishes that the exhibit has been offered and either excluded or admitted into evidence. Someone on the trial team should be assigned the task of noting (typically on a copy of the exhibit list attached to the pretrial statement) the fate of each exhibit: when it was offered (e.g., by date and witness), whether it was admitted and when, whether it was objected to, the ruling on an objection, and if admitted, whether the exhibit was admitted for all purposes or only for a limited purpose. Someone on the trial team should review the daily transcript to be certain that it accurately
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reflects what was offered and admitted and that there have been no transcription errors such as transposing exhibit numbers. If ambiguities or errors are noted, they should be corrected immediately on the record the next day so they are not lost among all the other needed actions as the trial winds down. If the daily transcript cannot be reviewed each day, then it must be reviewed by the end of the case-in-chief so that there are no errors respecting what was admitted into evidence.

If the court permits, reoffer all exhibits at the end of the case-in-chief by preparing and submitting to the court reporter a written list of every exhibit believed to have been offered and admitted so it can be entered in the record (even then, check for errors once the transcript is available). Such a list should be provided to opposing counsel at least a day before the reoffer to avoid delay during trial.

A jury trial is not the place to admit exhibits in bulk (except as those exhibits may support a summary chart or provide the basis for testimony by an expert at trial). A document left unexplained by testimony in a jury trial likely will have no impact on the ultimate verdict.\footnote{This is not the case in a bench trial, where the significance of exhibits may be argued in post-trial briefing.} The jury will retire immediately after the judge’s instructions and closing argument, and the jury will not consider documents admitted into evidence but not explained through oral testimony. While offering exhibits in bulk preserves the record for appeal and allows reference to admitted backup exhibits should an issue arise on appeal, do not expect the jury to give any weight to an exhibit about which there was no trial testimony.

1. Documentary Evidence

Jurors know that memory is tricky at best and that a selective memory of what one wishes had happened is more likely to be heard from interested witnesses at trial. They also realize that sometimes people reasonably have different recollections of the same event. It is natural to assume that the memory of a witness may be inaccurate or suspect if contradicted by the testimony of a second witness. But if memory is backed up by contemporaneous documents and things, created before the controversy began and confirming the oral testimony, then that testimony is much more powerful evidence of the truth than oral testimony alone.

When there is a dispute as to the facts, a witness testifying from a corroborating document is more believable than bare oral testimony. This is true even if the witness only uses the document as a springboard to recollections well beyond what the document actually says. The document provides at least apparent substance and support for the testimony. A good example of this is the inventor notebook. If an inventor is testifying as to extensive underlying experimentation and there are thick laboratory notebooks recording that work, the jury is more likely to believe the testimony summarizing those experiments. Merely having the notebooks available in the courtroom and before the witness
on the stand functions as a constant reminder of the extensive experiments that were conducted and the difficulty of arriving at the invention. It helps the jurors find the inventor’s testimony to be believable.

If information, such as the experiments in the inventor notebook, is so voluminous or so complicated that it is difficult to convey in open court, it is an appropriate vehicle for presentation in the summary format of a chart, diagram, graph, or other demonstrative evidence from which the witness can then be questioned.138

2. Models and Other Physical Exhibits

Jurors love models, especially if they are small and discrete enough to be passed, hand to hand, among the jurors. The importance of models cannot be overstated. These kinds of exhibits attract greater attention than mere oral testimony and give the jury the opportunity to handle physical embodiments of the accused and patented devices. They can manipulate them to see how they work and compare. Models, while used to enhance testimony and demonstrate the correlation between the accused product and the patent claims, do not have to be merely “demonstrative” evidence. The admission of models as representative of an accused product too large or cumbersome to bring to court is within the discretion of the court.139 Models are generally admissible if (1) they can be proved to be fairly accurate, (2) their deficiencies are made known to the fact finder, and (3) the judge determines that they will be helpful in understanding the matters in issue.140 The accuracy requirement is not required to be precise. Some difference between the functioning of the model and the item in question is acceptable, if the difference is not material to the case.141 The most important question to be resolved in considering the admissibility of any model is whether the differences between the model and that which it purports to represent are misleading and thus unfairly prejudicial under Federal Rule of Evidence Rule 403.

If the patent relates to a component of a larger product, or some physical object that can be easily manipulated by hand, bring samples into the court-

138 Such exhibits are admissible if they comply with Fed. R. Evid. 1006. The rule states:
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.
139 See Young Dental Mfg. Co. v. Q3 Special Prod., Inc., 112 F.3d 1137, 42 USPQ2d 1589 (Fed. Cir. 1997), in which the court refused to find error in permitting the use of a demonstrative model of the accused device. The court noted:
On this point, the district court did not err. Demonstrative evidence such as the Thiedemann model 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. Such a determination is within the trial court’s considerable discretion. Young does not allege that the model misrepresented the Thiedemann embodiment in any way other than oversimplifying it. Nor does Young allege that it did not have ample opportunity to cross-examine the witnesses that relied on the model in an effort to lessen the model’s evidentiary weight. We therefore see no error in the trial court’s discretionary decision.
Id. at 1145–46, 42 USPQ2d at 1596 (citations omitted).
§ 21.VII.C.2.  The Trial

If the subject matter relates to the molecular structure of chemicals, use models of the atoms and show how they fit together. Bring the chemicals into the courtroom so the jury can see what they look like and smell them if pertinent. Put a physical form of the invention before the jury—even if it is only a working model—and not merely words. Where possible, exemplify through physical embodiments both the prior art and the patented invention. If color, texture, corrosion, weakness, strength, or any other physical change, character, or configuration separates the invention from the prior art (or brings it closer), have actual examples of the products in court so that the jury can see with their own eyes what is involved. In chemical cases, show what the starting materials and final products look like.

If the nature of the patented subject matter is too large or too messy to bring into the courtroom, take photographs, videos, or movies of the actual machine or process in operation. Experts should visit the opponent’s plant and observe the machine or process in actual operation while it is being photographed or videotaped. Where possible, use sound coupled with the pictures to give the jury an opportunity to understand the normal environment of the invention, where and how it works, and what it does and sounds like in operation. Lay a proper foundation for the photographs, movie, or video and they become direct evidence, rather than merely demonstrative evidence. The expert should explain his or her testimony and/or the invention or prior art with reference to precise three-dimensional exhibits, videos, or movies, which portray in pictures, not merely words, what the invention really involves. If appropriate, relive the making of the invention with laboratory glassware and pictures of the laboratory, coupled with blown-up copies of the actual laboratory notebook as the inventor explains what happened.

Physical exhibits may demonstrate how close the prior art is to the claimed invention or how far the accused device departs from the invention (e.g., the commercial embodiment sold by the patent owner). While it is not proper for infringement purposes to compare the accused device with the device sold by the patent owner (because it is the claims that measure infringement), both devices may be present in the courtroom for the psychological effect of displaying significant physical differences between the accused device and that of the patent owner. If damages are not bifurcated and the patent holder is seeking lost profits, the patent holder’s device is appropriately presented to the jury in connection with its assessment of the “but for” test. If the two devices look very different, the accused infringer will want them in court, and if they look very similar, the patent owner will want them in court, side by side.

Three-dimensional exhibits are not limited to those that can be handled or easily seen. If the nature of the case allows, do not overlook the use of microscopes, magnified video images, and other devices that will show the jury enlargements of the patented device and/or the prior art. In today’s world of advanced technology, there are numerous electronic and optical devices that

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142 In a bench trial, invite the judge to come down from the bench to experience hands-on the heavier physical exhibits, and have the witness come down from the witness chair to stand next to the judge and show how the device works.
can project very small embodiments of a patented device on a suitable screen. And do not overlook the use of colored lights, X-rays, lasers, and other suitable scientific methods to enhance presentation of physical exhibits of the invention or the prior art.

Any use of physical exhibits at trial should be practiced and carefully orchestrated before trial. It is essential that the testifying witness hold the exhibit in a manner that provides a clear line of sight for the jury, and that the physical exhibit being explained is close enough to the jury so that it, and its key features, can be easily seen by the concerned parties. It is then that it should be handed to the jury for their review.

The best time to consider potential physical exhibits is during discovery, particularly during the preparation of witnesses known to be likely trial witnesses. Many attorneys fail to address their physical exhibits until close to trial, possibly expecting the case to settle before then. But at this late date the press of other matters leaves little time for carefully thought-out exhibits. Given their potential impact on the jury, it is a mistake to wait until the last minute of trial preparation to assemble physical exhibits, particularly because some high-tech exhibits take a long time to prepare. These exhibits frequently are an essential part of the proofs, and they should not be an afterthought. Many highly complex patent cases require visual aids to enable comprehension of difficult scientific theories and mechanical devices. Those physical exhibits should be planned and executed well in advance of trial.

3. Experiments at Trial

Particularly in chemical cases, there is a sometimes an overwhelming urge to conduct actual experiments in the courtroom. The trial lawyer envisions setting up a miniature laboratory and asking the inventor, an expert, or some chemist to come down from the witness stand and mix and manipulate chemicals to prove a pertinent point. The judge is invited to approach the experiment to see how the materials react. The experiment is conducted as close as possible to the jury box so that each member of the jury can observe the chemicals reacting and the unexpected result that is the hallmark of the invention.

A surprising and unexpected effect may well be the result of such an experiment, but it may not be the result the counsel expected or wanted. Experiments can go wrong. No matter how many times they are practiced, the results at trials somehow are not the results obtained during rehearsals. Chemicals splash and spill. Test tubes and glassware are overturned. Their contents burn the skin, they smell, they burst into flame. Glassware breaks, water floods the courtroom or at least wets other exhibits, drenches the judge or jury, or stains their clothes or the courtroom rug. Few judges appreciate this kind of assault on their courtroom.

The potential pitfalls bear close consideration before presenting a live experiment at trial.143 Certainly, the potential perils militate against conducting...
all but the most foolproof experiments live in the courtroom. The better practice is to conduct the experiment outside the courtroom until it is perfected. It should then be captured in digital or videotape format while the testifying witness is present.\textsuperscript{144} At trial, the expert can then explain the experiments through live testimony as the experiment is being replayed. Not only does electronic capture of the experiment avoid spills, stains, smells, and unexpected failures, but it allows a wide variety of stop action and special effects wherein the video or movie can be stopped and started at will for detailed explanation, and/or the images can be magnified, presented in split screen, color-enhanced, or subjected to a variety of other techniques that will emphasize important points.

Furthermore, that videotape will itself become an exhibit and will be available to the jury during deliberations as part of the record on appeal. It, or some small part of it, can be used to illustrate the final argument. Particularly pertinent parts or frames can be isolated, blown up, or converted into poster board-sized reproductions that can be used by other witnesses or in cross-examination and reproduced in posttrial briefs or briefs on appeal. Those poster boards can be left in front of the jury as long as opposing counsel does not object or take them down, as a constant reminder of the key points made therein.

\textbf{D. Demonstrative Evidence}

A demonstrative exhibit is designed to argue the point being made through the direct examination of a witness, but it is not intended, if it is demonstrative in the pure sense of the word, to be admitted into evidence. Because of this, the requirements of accuracy are lessened, the assumption and anticipation being that any inaccuracies will be handled on cross-examination.\textsuperscript{145} It helps guide the understanding of the jury and helps them to connect and follow the

\textsuperscript{144} Videotaped demonstrations are admissible if a foundation has first been laid confirming that the conditions under which the test or demonstration was performed were so substantially similar to the conditions at issue as to afford a fair comparison with them. The issue of admissibility is governed under the laws of the jurisdiction in which the trial occurs. For a summary of state and circuit case law on this issue, see Gregory P. Joseph, Modern Visual Evidence §4.04 (2005).

\textsuperscript{145} For example, when a model is used solely for demonstrative purposes, and not for admission, the courts are more lenient in their requirement of accuracy of the model on the basis that vigorous cross-examination is the appropriate method of challenging any discrepancies between the exhibit and what it purports to represent. See, e.g., Motorola v. Interdigital Tech. Corp., 121 F.3d 1461, 43 USPQ2d 1481, 1488 (Fed. Cir. 1997), in which the Federal Circuit noted: ITC also contends that the trial judge erred by allowing Motorola to use a “generic prior art” exhibit. Here again, however, the record shows that Motorola did not use the “generic prior art” exhibit as a substitute for real prior art. Rather, it used the generic prior art as a demonstrative exhibit that allowed the experts to summarize and explain the components found in each prior art reference. The overall record shows that Motorola presented a rigorous comparison of the claims to the accused products and to the prior art references. The use of a demonstrative exhibit to facilitate this presentation does not constitute improper evidence. To the extent that ITC contends that the exhibit tended to oversimplify disputed issues, effective cross-examination is the remedy for that objection. Id. at 1470. A purely demonstrative exhibit should not be admitted into evidence and most certainly should not find its way into the jury room. In GNB Battery Technology v. Exical eCorp., 876 F. Supp. 582 (D. Del. 1995), the court discussed the appropriate use of demonstrative exhibits as follows:
threads of the case. Demonstrative evidence differs from direct or actual evidence in that its use, in theory, is simply to illustrate a witness’ testimony, and it has no separate or independent evidentiary value.

Almost every piece of physical evidence is “demonstrative” because the attorney and the witness will use it to demonstrate some point. A three-dimensional component or machine “demonstrates” how the accused device works or at least functions as a scale model. Models, computer animations, charts, time lines, and the like created solely for use at trial that do not meet the test of admissibility may still be used as “demonstrative only” evidence if they assist the witness in explaining the substance of testimony. Most judges will allow attorneys to use the evidence if they merely say “for demonstrative purposes only” before or while they are using or offering it, leaving it to cross-examination to point out discrepancies or inaccuracies. A suitable instruction may be given to the jury as to the limited purpose of the exhibit, but it is questionable whether they will understand the distinction or remember it while they are deliberating to reach a verdict.146

One important type of demonstrative is an animation made from the rapid sequence of illustrations, creating the illusion of movement. Stopping points can be interjected into the animation to permit a witness using a touch screen to annotate the display. Use of color enhancements and views from varying angles increases the educational value of the animation. Presumably, potential demonstratives will have been considered and developed in the early stages of the litigation. Such things as photographs, computer-generated animation, live video footage, exhibit boards, and physical models should be weighed and decisions made long before trial.

Charts that change colors; metallic boards with chemical structures that adhere through magnets and can be removed or moved easily; velcro boards that allow pictures, numbers, or drawings to be exposed or covered; holograms; split-screen/side-by-side comparison videos and photographs; and all varieties of claim charts and checklists of proven claim elements are only some of the exhibits that can be created, depending on needs and budget.

The court finds no error in the refusal to admit these demonstrative exhibits into evidence which the jury could take into the jury room during deliberation. The court stated in its ruling that “the jury is entitled to look at those and use them to help them understand the evidence during the course of the trial, but they are not evidence and you won’t have them in the jury room during the deliberations.” Therefore, the court permitted the jury to see the models and view the videotape with the understanding that they represented the opinion of the defendants as to what certain patents and publications offered as prior art described or depicted.146

146 In these cases, a limiting or cautionary instruction must be requested explicitly advising the jury as to the purposes for which the evidence may, or may not, be used. Of course, a limiting instruction has the tendency of drawing attention to the evidence and the purpose for which it should not be used. Advising the jurors not to consider some piece of evidence for a particular purpose “is like telling someone not to think about a hippopotamus. To tell someone not to think about the beast is to assure at least a fleeting mental image.” United States v. DeCastris, 798 F.2d 261, 264–65 (7th Cir. 1986). The decision as to whether to request a limiting instruction requires a balancing of competing interests. Clearly, once the jury has been instructed not to consider evidence for a particular purpose, a mental connection is created between the purpose and the objected-to evidence on a subconscious level. On the other hand, failure to continue an objection and ask for a limiting instruction may waive grounds for appeal if the admitted evidence was unfairly prejudicial.
Static exhibits as well as expensive computer animations can be created to illustrate the invention and how it works, as well as how the claims compare with the accused device and/or the prior art. In some major trials, a technician or knowledgeable paralegal is present at trial solely to arrange and display these high-tech exhibits. At closing argument, some of these demonstrative exhibits, with which the judge or jury is already familiar, can be used to illustrate the argument as a final reminder to drive home the points to be remembered as the final decision is reached.

Many highly sophisticated companies specialize in preparing demonstrative exhibits with high visual impact. Tens of thousands of dollars can be spent in preparing a single exhibit, and the total cost of demonstrative exhibits in a major patent case can exceed $100,000, not counting the cost of transportation to get the exhibits safely to and from trial or the expense necessary to properly display them at trial.

But highly effective demonstrative exhibits need not be overly expensive. Poster boards that reproduce key portions of the patent specification, drawings, and claims or important parts of prior deposition testimony or a particularly pertinent document remain a favored and relatively low-cost demonstrative exhibit. Used properly to illustrate a witness’s testimony or for impeachment purposes, these types of exhibits, including claim charts, can have as much impact as the higher-priced, highly technical exhibits. Indeed, some trial attorneys resist the urge to use too many expensive demonstrative exhibits for fear that they will telegraph the deep pockets of their client or the impression of great concern about the case. Find out before trial whether the judge is computer-literate and likes all things electronic. Investigate what facilities exist already in the courtroom to demonstrate or play demonstrative exhibits.

One presentation tool is the relationship chart. Typically used in nonpatent and criminal cases, it can be helpful in certain contexts in the patent case. It typically is used to present the relationship between key actors or events or a combination of both. It can be helpful if used in conjunction with appropriate testimony to lead the jury to a determination that undisclosed but known prior art was material, or that the patent is invalid as obvious over the prior art.

Demonstrative exhibits normally must be exchanged before trial in most jurisdictions. The opponent thus will have an opportunity to see those exhibits in advance, guess the nature of the testimony, and be better prepared to meet them at trial. Typically, courts require disclosure of demonstrative exhibits only days before trial and well after other exhibits have been exchanged.

Even with this delayed exchange of exhibits, some trial counsel do not want to disclose their demonstrative exhibits to their opponent before the witness actually testifies. The fear is that important “surprise” evidence or a particular “spin” on the evidence will be disclosed too soon and the opponent will have time to prepare a response. In this instance, where early disclosure is not desired, the demonstrative exhibits—e.g., charts, time lines, drawings, and graphs—can be created by the attorney or the witness as the testimony is given. Special write boards enable drawings and charts to be placed on the board and then copied immediately with the push of a button. Alternatively, a simple large pad of paper on an easel and the use of various colored markers can be employed. This can be very effective, particularly if the attorney and/or the
witness is a decent draftsperson with legible handwriting or printing. If the demonstrative exhibit is to be created by hand on the spot, while the testimony is being given, its preparation should be practiced well in advance and the witness and attorney should know exactly what will be drawn or charted. This will obviate mistakes and ensure a smooth and orderly presentation, without the loss of trial time. At the end of the testimony, mark the demonstrative with an exhibit number and use it with other witnesses. Each reuse of that exhibit will be a reminder of the oral testimony and the witness who prepared it, and may well be admissible.

E. Computer-Created Exhibits

Computer-generated graphic presentations reduce complicated ideas or concepts to a few seconds of concise explanation. Use of them has the secondary benefit of providing an essential respite for the jury from the monotony of witness examination. Jurors appreciate the use of technology in the courtroom.\textsuperscript{147} It breaks up the tedium, enlivens the proceedings, and makes the process of learning a much easier one. Younger jurors are used to learning through use of computers. All this argues in favor of presenting as many of the exhibits as can be presented well through the use of some electronic medium.

The admissibility of multimedia does “not necessarily rest upon the validity of the process used in its creation, but rather may be established by testimony that [it] accurately reproduces phenomena actually perceived by a witness.”\textsuperscript{148} Generally, foundation is provided through testimony of the witness substantively testifying about the exhibit. But some computer animations and simulations may require the testimony of the creator to lay the necessary foundation for reliability and trustworthiness,\textsuperscript{149} especially if the substantive witness was not involved in its creation\textsuperscript{150} or if it is used with a fact witness as opposed to an expert witness.\textsuperscript{151}

Computer animation and the related but more expensive computer simulation are used more and more frequently in patent and other trials. These work particularly well if the expert witness with whom they are used can utilize them as a teaching tool. But ample practice and preparation of alternatives should be considered to account for the possibility that the exhibit could be excluded at trial. While computer animation breaks up the boredom of long

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\item \textsuperscript{147} Judges appreciate visually interesting evidence in juror trials as well as in bench trials. The assessment of whether to use a particular type of exhibit should be no different whether the trial is to a jury or to the court. The purpose of the exhibit is to enhance the understanding of the finder of fact, whether jury or judge, and to increase the retention of important information.
\item \textsuperscript{148} JOHN W. STRONG, ED., McCORMICK ON EVIDENCE §214, 17 (5th ed. 1999).
\item \textsuperscript{149} The witness’s testimony is required to substantiate the reliability of the information depicted in an animation or simulation. If it is challenged, a witness is generally required to provide a detailed authentication of the input, the processing, and the ultimate output viewed by the jurors.
\item \textsuperscript{150} See McCORMICK ON EVIDENCE §214 n.26 (2003).
\item \textsuperscript{151} The expert witness has more latitude in relying upon computer animations and simulation without laying a comprehensive foundation regarding the creation of this type of exhibit if it comprises part of the expert’s opinion. Under Federal Rule of Civil Procedure 703, the facts and data upon which an expert’s opinion or inference is based need not be admissible in evidence in order for the opinion or inference to be admitted.
\end{itemize}
hours of witness testimony and provides visual interest, it may also be suspect. All jurors are aware, from movies, of what can be done with computer animation to create an impression that is not in accord with reality. There must be sufficient information presented to the jury to demonstrate clearly and fully that the animation fairly depicts what it purports to demonstrate or it will be discounted. Next, there are a host of questions raised by the use of computer animations and simulations, including those that need to be answered not only for the court but for the jury as well:

- Does the simulation fairly depict that which it purports to depict?
- If it purports to portray a scientific theory, is the theory admissible?
- Is the data underlying the simulation complete and accurate? Has it been made available to the adverse party? Was the data properly used in preparing the simulation or has it been gently worked in some fashion?
- Are the contents of the simulation independently verifiable? (Is the simulation a valid simulation?)
- Should the simulation be admitted into evidence and go to the jury room during deliberations or be limited to designation as a “demonstrative” exhibit only?

Whatever form is used, such technology in the courtroom requires practice, preparation, and imagination. Be sufficiently trained in the technology that it seamlessly weaves into the presentation rather than constituting a distraction from the presentation. A poor performance in operating equipment not only distracts the jury but calls into question a lawyer’s competency in technical matters. But even if technology is to be relied upon, there should be contingency plans in the event of equipment failure.

VIII. Rule 50 and 52 Motions

A. Rule 50 Motion for Judgment as a Matter of Law

During any jury trial, a party may make a motion for judgment as a matter of law (motion JMOL) under Federal Rule of Civil Procedure 50(a) asking a court to find against the other party on any issue on which that party has been fully heard. In ruling on the motion, the standard applied by the trial judge is whether there is a legally sufficient evidentiary basis upon which a jury could find for the nonmoving party on the issue. For a district court to grant a motion JMOL during a trial, the facts must be accepted as established and all reasonable inferences from those facts must be drawn in the nonmovant’s favor. The

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152 This list is based upon a more detailed list in JURY TRIAL INNOVATIONS 117 (G. Thomas Munsterman, Paula L. Hannaford & G. Whitehead eds., 1997).

153 Allied Colloids Inc. v. American Cyanamid Co., 64 F.3d 1570, 1572, 35 USPQ2d 1840, 1841 (Fed. Cir. 1995). See also Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1546 (Fed. Cir. 1983). The Connell court also noted that

[d]ecision due a jury’s fact findings in a civil case is not so great, however, as to require acceptance of findings where . . . those findings are clearly and unquestionably not supported by the substantial evidence. To so hold would be to render a trial and the submission of evidence a farce.

Id.
timing for filing a Rule 50(a) motion JMOL is critical and specific. The motion may not be raised until after a party has been fully heard on an issue. Only then may the opposing party properly submit a motion.\textsuperscript{154} To preserve the right to contest an adverse jury verdict, a motion JMOL must be renewed under Rule 50(b) within 10 days after entry of the judgment, but no issue may be raised unless it was first raised in the Rule 50(a) motion. Here again, timing is critical because a party’s “renewed” motion can be “renewed” only if a motion JMOL was timely made before the jury began deliberations.\textsuperscript{155} A posttrial motion JMOL can be granted only on grounds advanced in the preverdict motion.\textsuperscript{156}

In the typical patent trial, the patentee will present proof first as to infringement and, if the trial is not bifurcated, on damages. The accused infringer may move for JMOL at any time after the close of the patentee’s case-in-chief. While this typically is immediately after the close of the patentee’s case, it is not limited to that time. The ability for the court to take early action to end the trial and enter judgment for the defendant is necessary where “economy and expedition will be served.”\textsuperscript{157} Of course, if not granted, the motion must be renewed at the close of all evidence\textsuperscript{158} and again after the jury renders its verdict if the verdict is against the patentee. The defenses asserted by the infringer will likely include both noninfringement and invalidity, if not others. Once the case-in-chief of the accused infringer has closed, the patentee must move for JMOL on these issues or it will fail to preserve the right to renew the motion JMOL after the jury’s verdict is rendered, thus effectively defeating the right to raise issues on appeal.

In practice, many judges typically defer ruling upon motions JMOL until after the jury has rendered a verdict. The rationale for this is that a jury verdict in favor of the moving party will moot the motion JMOL, and a preverdict ruling “gambles that a reversal may result in a new trial that might have been avoided” if the jury had been permitted to render a verdict.\textsuperscript{159} The rationale has been stated by the Federal Circuit as follows:

This case illustrates again that it is usually better practice for a district court, faced with a motion for directed verdict, to allow the case to go to the jury, and address the issue by way of judgment n.o.v. if necessary. The jury may find for the moving party, in which case the issue disappears. If the verdict is against the moving party, and if judgment n.o.v. is granted, and if this Court decides on appeal that it should have been denied, the verdict can simply be reinstated, and no new trial is necessary.\textsuperscript{160}

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\textsuperscript{154} Fed. R. Civ. P. 50(a)(1).
\textsuperscript{155} Advanced Display Sys., Inc. v. Kent State Univ., 212 F.3d 1272, 1281 (Fed. Cir. 2000).
\textsuperscript{156} Fed. R. Civ. P. 50(b) advisory committee’s notes.
\textsuperscript{157} Fed. R. Civ. P. 50(a) advisory committee’s notes.
\textsuperscript{158} Rule 50 uses slightly inconsistent language. In stating the earliest time at which the motion may be made, it provides that it “may be made at any time before submission of the case to the jury.” Rule 50(b)(2). Rule 50(b) also makes reference to “motion[s] for judgment as a matter of law made at the close of all the evidence. . .” (emphasis added). This language confirms the risks attendant with failure to restate the motion JMOL at the close of all the evidence—that a motion made only at the close of the plaintiff’s case in chief (or the defendant’s) but not renewed at the close of all evidence will be treated as if it had not been made at all.
\textsuperscript{160} Fed. R. Civ. P. 50(b) advisory committee’s notes.
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The Trial

Whether submitted by plaintiff or defendant, patentee or accused infringer, a motion JMOL should be in writing, with supporting law and facts. While there is no requirement that the motion be made in writing, it is certainly easier to fulfill the requirement of the rule that the motion specify the judgment sought, together with the law and facts upon which it is based, if the motion is in written format. The time to begin drafting the written motion and supporting brief is before trial begins. This is not impossible. The disclosure obligations of the Federal Rules of Civil Procedure permit few surprises. The case of the opposition and all the potential evidence should be known or, with a bit of diligence, knowable. The draft should be prepared and modified as the trial commences so that it can be finalized and submitted after the close of the opposing party’s case-in-chief.

Rule 50 motions are considered procedural in nature. Whether an issue is properly preserved for appeal is generally governed under the precedent of the circuit in which trial occurred. Most circuits apply a liberal view of whether a preverdict Rule 50(a) motion constituted a sufficient predicate for a postverdict Rule 50(b) motion. However, when the issue raised on motion JMOL is distinctly a patent law issue, the Federal Circuit will review the sufficiency of the motion under Federal Circuit law. Because the failure to raise an issue in the Rule 50(a) motion precludes its being raised in the Rule 50(b) motion, and the failure to raise an issue in a Rule 50(b) motion precludes its being raised on appeal, extreme care must be taken at trial when drafting or presenting the original motion to ensure all issues are fully addressed.

B. Judgment on Partial Findings Pursuant to Rule 52

In bench trials, when there has been an advisory jury on an issue, or when the case or an issue is tried to the judge, the court "shall find the facts specially and state separately its conclusions of law thereon, and judgment shall be entered." The findings must be comprehensive and detailed. The bench trial, like the jury trial, has provision for entry of judgment before the close of all the evidence. In this regard, Federal Rule of Civil Procedure 52(c) applies rather than Rule 50. It provides that:

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161 Zodiac Pool Care, Inc. v. Hoffinger Indus., Inc., 206 F.3d 1408, 1416 (Fed. Cir. 2000) (“We must respect the precedent of the Eleventh Circuit on this issue, because this court defers to the law of the regional circuits on matters of procedural law.”)

162 Duro-Last, Inc. v. Custom Seal, Inc., 321 F.3d 1098, 1106, 66 USPQ2d 1025, 1029 (Fed. Cir. 2003). Duro-Last argued that its preverdict JMOL motion with respect to the on-sale bar encompassed a motion for JMOL with respect to its assertion that the patents were not invalid for obviousness. Id. at 1107. However, the Federal Circuit noted that anticipation is not the same issue as obviousness because they require different elements of proof. It concluded that since obviousness was not addressed in the original JMOL, it could not be brought up after the verdict. Id. at 1107–08.

163 Id. at 1106, 66 USPQ2d at 1029.

164 The 1946 amendment to Fed. R. Civ. P. 52(a) confirmed that the “requirement for findings of fact and conclusions of law thereon applies in any case with an advisory jury.”


166 Graco, Inc. v. Binks Mfg. Co., 60 F.3d 785, 791, 35 USPQ2d 1255,1259 (Fed. Cir. 1995) (remanding to the district court for further findings on claim construction because “[i]n this case, the court provided no enlightenment on the first step [of the infringement analysis]. The court’s opinion is absolutely devoid of any discussion of claim construction.”) (emphasis in original).
If during a trial without a jury a party has been fully heard on an issue and the court finds against the party on that issue, the court may enter judgment as a matter of law against that party with respect to a claim or defense that cannot under the controlling law be maintained or defeated without a favorable finding on that issue, or the court may decline to render any judgment until the close of all the evidence. Such a judgment shall be supported by findings of fact and conclusions of law as required by subdivision (a) of this rule.

Thus, a defendant must move for judgment at the close of the plaintiff’s case. The issue of entry of judgments on an asserted count may be addressed only after a party has been fully heard on a claim or defense if the issue “cannot under the controlling law be maintained or defeated without a favorable finding on the issue.” Of course, the court may also “decline to render any judgment until the close of all the evidence.” In either case, if the Rule 52(c) motion is granted, the court is required to set forth the facts and law to support its conclusions. The party making such a motion must therefore present the court with detailed proposed findings setting forth every fact supporting the judgment sought.

A Rule 52(c) motion will be granted when a party fails to make out a prima facie case on any claim for which it has the burden of proof. It may also be granted, despite a prima facie case, if the court determines that the preponderance of evidence weighs against a party’s claim. In this regard, when a motion is made under Rule 52(c), unlike a motion under Rule 50, the court is not limited to consideration of the evidence in the light most favorable to the nonmoving party. The court instead is the ultimate finder of fact in assessing whether the evidence as presented by the moving party supports a finding in its favor by a preponderance of the evidence. For a court to grant a JMOL under Rule 52(c), “a district judge must weigh the evidence and resolve credibility.”

Whether in a bench trial or before an advisory jury, the district courts have specific guidelines to be followed when entering a judgment. Rule 52 states that “the court shall find the facts specially and state separately its conclusion of law thereon ....” This means a trial court is required to set forth the facts and the law which it believes should apply to its determination to permit a meaningful review on appeal. The Federal Circuit has held that “findings of fact satisfy Rule 52(a) when they are sufficiently comprehensive

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167 Fed. R. Civ. P. 52(c).
168 Id.
169 Id.
172 Yamanouchi Pharm. Co. v. Danbury Pharmacal, Inc., 231 F.3d 1339, 1343 (Fed. Cir. 2000). See Fed. R. Civ. P. 52(a) (“due regard shall be given to the opportunity of the trial court to judge the credibility of the witness”) and 52(c).
and pertinent to the issue in dispute to form a basis for the district court’s
decision.” Further, “although the district court need not make elaborate
findings on every factual issue raised, it must find and specify as many subsidiary facts
as necessary to inform the reviewing court of the steps by which it determined
factual issues and reached its ultimate conclusions.”

The findings of fact and conclusions of law are also required for judgments on partial findings pursuant
to Rule 52(c).

Like Rule 50, Rule 52(b) allows a party to file a motion within (but not
more than) 10 days after entry of judgment. This motion must request the trial
court to amend its findings or make additional specified findings. A motion to
amend the court’s findings may be made in conjunction with a motion for a
new trial under Rule 59. It is important to note that when “findings of fact are
made in actions tried without a jury, the sufficiency of the evidence supporting
the findings may be later questioned whether or not in the district court the
party raising the question objected to the findings, moved to amend them, or
moved for partial findings.”

On appeal, the court will look at the underlying record and determine if
any legal errors were made. If legal errors are found, the court will determine
whether the outcome would have been different if the errors had not been
made. In the situations where factual determinations are made, the appellate
court reviews these findings using the “substantial evidence” test. The “substan-
tial evidence” test has been defined as being “such relevant evidence as a
reasonable mind might accept as adequate to support a conclusion.”

This means the court will determine if there is any evidence present in the record
that the fact finders used to support their determinations. If even a minimal
amount of support is found, the judgment is deemed supported. In light of this,
the proposed findings of fact submitted to the court should be as detailed as
possible, reciting every item in the record that supports the fact.

IX. THE CHARGE CONFERENCE

During the appeal process, jury instructions, special verdict, and interroga-
tories may be challenged as confusing, incorrect, or incomplete. To be reversible
on appeal, however, the error in the instructions must cause prejudicial effect.

\[\text{\textsuperscript{175} Id. at 1276; Atlantic Thermoplastics Co. v. Faytex Corp., 5 F.3d 1477, 1479, 28 USPQ2d 1343, 1345 (Fed. Cir. 1993).}\]

\[\text{\textsuperscript{176} Fed. R. Civ. P. 52(b).}\]

\[\text{\textsuperscript{177} Consolidated Edison Co. of N.Y. v. NLRB, 305 U.S. 197, 229 (1938); see also Dickinson v. Zurko, 527 U.S. 150, 162 (1999).}\]

\[\text{\textsuperscript{178} See Sulzer Textil A.G. v. Picanol N.V., 358 F.3d 1356, 1364, 69 USPQ2d 1961, 1967–68 (Fed. Cir. 2004) (holding that the trial court’s failure to instruct jury was legally erroneous but harmless); NTP, Inc. v. Research in Motion, Ltd., 392 F.3d 1336, 1365–66, 73 USPQ2d 1231, 1257 (Fed. Cir. 2004) (remanding the erroneous jury instruction claim to the district court for proper resolution in a patent infringement case brought by an owner of several patents for a method of sending e-mail over wireless networks); Chiron Corp. v. Genentech, Inc., 363 F.3d 1247, 1258–60, 70 USPQ2d 1321,1329–30 (Fed. Cir. 2004) (affirming the district court’s ruling not to correct jury instructions by including further explanation regarding the presumption of patent validity, the law of written description, and the law of enablement); Environ Prods., Inc. v. Furon Co., 215 F.3d 1261, 1266–67, 55 USPQ2d 1039, 1043 (Fed. Cir. 2000) (quoting 11 Charles Alan Wright & Arthur R. Miller, Federal Practice and Procedure §2886,}\]
and an objection must have been asserted before the jury retired. The charge conference is the opportunity to preserve objections to prejudicial error in jury instructions. In regard to jury instructions (and thus objections to jury instructions), however, the Federal Circuit historically has provided little guidance to practitioners in defining what might constitute the essential elements of properly articulated jury instructions. Although guidance from the Federal Circuit on appropriate language and form of jury instruction has been less than expansive, at least Judge Michel has complained that the district courts and trial counsel are doing a poor job of preparing instructions:

[In eight years on the bench, I do not recall seeing any instruction on the doctrine of equivalents that I thought were clear and complete. Defective instructions on the doctrine are all the more significant in view of the en banc restatement in Hilton Davis that the determination of infringement by equivalents is ordinarily for the jury. While we tolerate minor misstatements of the law in jury instructions as likely non-prejudicial, I believe it is reasonable to expect that instructions on the doctrine of equivalents, serious errors or omissions will always be prejudicial.]

Similarly, since its pronouncements in 1984, the Federal Circuit has provided little guidance as to the form or substance of special verdict forms. In fact, it appears that the Federal Circuit rarely overturns or remands lower court decisions for erroneous jury instructions or special verdict forms, presumably because it rarely finds prejudicial error. In general, the Federal Circuit “re-

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181 Id.
183 Id.
184 Id.
185 Judge Michel has expressed the view that the paucity of Federal Circuit cases have been devoid of guidance in this regard. In Structural Rubber Products Co. v. Park Rubber Co., 749 F.2d 707, 223 USPQ 1264 (Fed. Cir. 1984), the court evaluated the propriety of a lower court’s instruction regarding obviousness. The lower court provided instruction as to the law of obviousness, harvested mostly from the patent statute, but failed to provide instruction to the jury regarding the role of the jury in evaluating such things as the secondary considerations of nonobviousness. The court noted that the error was not that the law was misstated but rather that the lower court abdicated its responsibility to inform the jury of how the statute applied to the particular circumstance before them. “We join other courts that have held that the duty of a trial court in any jury trial is to give instructions which are meaningful, not in terms of some abstract case, but which can be understood and given effect by the jury once it resolves the issues of fact which are in dispute.” Id. at 723.
186 See Ecolab, Inc. v. Paraclipse, Inc., 285 F.3d 1362, 1373 (Fed. Cir. 2002) (concluding that Ecolab suffered prejudice by the erroneous jury instruction, vacating the verdict of noninfringement, and remanding the claim for a new trial.)
views jury instructions in its entirety and only orders a new trial when errors in the instructions as a whole clearly mislead the jury.” Thus, the drafting of instructions, special verdicts, and the objections to instruction and verdict forms has not been elevated, in most trials, to much of an art. This lack of guidance by the Federal Circuit is not an excuse to give short shrift to objections to jury instructions.

In practice, the trial court generally provides counsel with final jury instructions at the close of evidence. Objections to any final instructions are entertained at this time, although written objections to any instruction deemed unacceptable that were proposed by the opposing party should have been made in writing and filed earlier with the court. A party who fails to make an objection to an instruction or special verdict on the record and to distinctly state the matter objected to and the grounds for the objection before the jury retires waives that objection under Federal Rule of Civil Procedure 51(c). Object on the wrong ground and the issue will be waived.

During the course of trial, evidence will have been elicited that will require a modification to some of the jury instructions originally proposed so as to conform the instruction to the evidence of record. It is not sufficient to present these modified instructions orally during the charge conference. New proposed instructions, with the modifications, should be filed with the clerk and not merely exchanged with opposing counsel and handed up to the court. This process sounds like a simple matter, but it is sometimes overlooked in the excitement of the moment and yet is critical to preserving issues for appeal. One lawyer on the team should be charged with the job of keeping track of the status of all proposed instructions, all modifications to instructions, and all objections made and preserved.

During the charge conference with the court, it is essential at the close of the discussion on each instruction to consider whether the instruction as requested (or as objected to) has been modified in a small or large degree. The charge conference is a negotiations session with the judge, who no doubt hopes to craft an instruction that will overcome the objections of both parties (thus limiting grounds for appeal). There will be circumstances in which a party proposes a modification to improve an instruction by making it less detrimental than the original instruction even though the instruction as modified still falls

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185 See generally Advanced Display Sys., Inc. v. Kent State Univ., 212 F.3d 1272, 1281 (Fed. Cir. 2000).
186 See Fed. R. Civ. P. 51. A “futility” exception to this requirement is recognized by many circuits. “A litigant is excused from complying with the strict obligation requirement of Rule 51 if the district court is aware of the party’s position and it is plain that further objection would be futile” if the “litigant’s position [were] ‘clearly made’ to the district court.” 9 James Wm. Moore et al., Moore’s Federal Practice §51.12[2][A], at 51-40.2 to 51-41 (3d ed. 1997). Since the requirements of Rule 51 are governed by regional circuit law, the Federal Circuit will follow the regional circuit law regarding application of this so-called futility exception. Ecolab Inc., 285 F.3d at 1369.
187 Rule 51 applies only to instructions to the jury governing the verdict to be rendered by the jury. The advisory committee notes to the 2003 amendments to this rule confirm that the rule does not cover other types of instructions including “preliminary instructions to a venire, and cautionary or limiting instructions delivered in immediate response to events at trial.”
188 The application of Rule 51 and the determinations regarding the timing of objections and whether an objection is waived are procedural in nature and thus governed under the law of the circuit in which the trial occurs. See Advanced Display Systems, 212 F.3d at 1281–82.
short of being acceptable. In these circumstances, an objection must be reiterated to the modified instruction. The objection must briefly but completely reiterate all bases for the objection. The objection, as stated, must be specific enough to support the issue if it needs to be raised on appeal. As a final matter, objections must be ruled upon by the judge. The court’s ruling on objections sometimes takes the form of simply providing counsel with the final form of the instruction just prior to instructing the jury. In this case, all objections must be renewed before jury deliberations commence in order to preserve those objections.

When the charge conference takes place at or near the close of evidence, which is usually the case, all arguments, law, and the evidence adduced at trial supporting a proposed instruction should be provided to the court. This creates a record for appeal and makes it easier for the judge to rule on the proposed instruction. If the evidence is presented artfully, it may provide an additional opportunity to restate the Rule 50(b) motion JMOL. Circuit courts apparently disagree as to whether an objection made during the charge conference will suffice to preserve the issue for appeal, or whether the objection must be restated after the jury has been instructed. It is best, then, to make the objection on the record during the charge conference and renew and restate it after the jury has been charged but before it retires to deliberate.

Preparations should begin for the charge conference once the parties have exchanged proposed jury instructions and hammered out a set of joint proposed instructions. Before trial begins, a compilation of possible objections to the opposing party’s proposed instructions should be prepared in anticipation of the charge conference. Ideally, short bench memos should be prepared on specific areas of the Federal Circuit law and/or law of the jurisdiction in which the trial occurs. It is unfortunate but true that patent trial lawyers often focus so intently on objections based upon patent law that they miss objecting to instructions based on general legal principles. Potential grounds for objections not based in patent law include the following:

- The instruction fails to provide relevant criteria for the jury’s determination of the issue.
- The instruction assumes the answer to an issue of fact and thereby takes that issue from the jury.
- The instruction contradicts another instruction or is internally inconsistent.
- The instruction effectively grants a directed verdict for the other party.

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191 Bollenbach v. United States, 326 U.S. 607, 612 (1946) (the discharge of the jury’s responsibility for drawing appropriate conclusions from the testimony depends on a “discharge of the judge’s responsibility to give the required guidance by a lucid statement of the relevant legal criteria”).
194 Cf. Hardin v. Ski Venture, Inc., 50 F.3d 1291, 1294 (4th Cir. 1995) (“A set of legally accurate instructions that does not effectively direct a verdict for one side or the other is generally adequate.”).
The instruction is confusing or misleading.\textsuperscript{195} The instruction incorrectly states the law or is not supported by the evidence.\textsuperscript{196} (This, standing alone, is not a sufficient objection. Case law confirming the correct law or recitation of evidence adduced at trial must be submitted to the court on the record to support this objection.) The instruction “indulges and even encourages speculations.”\textsuperscript{197}

Regardless of whether the Federal Circuit historically has largely ignored defects in jury instructions as grounds for reversal, trial counsel is well-advised to consider and raise each and every applicable objection.

X. Closing Argument

The reality is that by the time closing arguments are presented, most of the jurors will have formed certain ideas about the evidence, and the closing argument will have little impact on those already formed ideas. But the jurors, even if they have formed ideas about evidence and impressions about the witnesses and counsel and whether either or both may be trusted, do not have a clear grasp at this point of the legal issues that they are to decide. Hence the closing argument is the last and a critical opportunity to weave together the evidence adduced during trial with the jury’s task during deliberations. Illuminate and educate the jurors on important facts. Make key issues unforgettable by emphasizing and even dramatizing them. Drama is riveting (when it is not overdone) and it is memorable.

While it is the rare closing argument that turns the tide once it is flowing in favor of one party and against the other, it certainly is an opportunity for counsel to lose the case if the jurors are undecided about certain evidence. The quickest way to an unhappy verdict is to violate certain cardinal rules:

- Don’t misstate the evidence. Even if the jurors did not capture the misstated evidence in written notes, someone will remember the evidence and point out during deliberations that counsel is leading them down the garden path.
- Don’t stretch the inferences that can be drawn from the evidence or push an issue or a point too far. Jurors use their common sense to assess inferences and are perfectly capable, after hearing weeks of testimony, of reaching reasonable conclusions even regarding inferences to be drawn from highly technical evidence. If the proposed inference isn’t reasonable, believability on other issues suffers as well.

\textsuperscript{195} Id. at 1294 (“[S]o long as the charge is accurate and does not confuse or mislead the jury, it is not erroneous.”); Japan Airlines Co. v. Port Authority of N.Y. & N.J., 178 F.3d 103, 110 (2d Cir. 1990) (“[A] jury instruction is erroneous if it misleads the jury or does not adequately inform the jury on the law.”).

\textsuperscript{196} Jaffee v. Redmond, 51 F.3d 1346, 1353 (7th Cir. 1995) (“Jury instructions ‘must be correct statements of the law that are supported by the evidence.’” (citation omitted); see also United States v. Branch, 91 F.3d 699, 712 (5th Cir. 1996) (“the court may, however, refuse to give a requested instruction that lacks sufficient foundation in the evidence”) (citing United States v. Tannehill, 49 F.3d 1049, 1047 (5th Cir.), cert. denied, 516 U.S. 857 (1995)).

\textsuperscript{197} Branch, 91 F.3d at 712 (quoting United States v. Collins, 690 F.2d 431 (5th Cir. 1982), cert. denied, 460 U.S. 1046 (1983)).
Don’t focus the argument on obscure technical points and do not repeat and argue (for the nth time) irrelevant facts. This is the home stretch for the jurors, and they are anxious to begin deliberations and resume their lives. It is important to remain focused on the theme of the case and the story model that was adopted. Focus on the main facts and main issues. Closings should be relatively short affairs limited to summing up important evidence.

Don’t condescend to the jury. Adopting the colloquial language of engineers or lawyers presumptively condescends to the jurors. Use plain English.

Use rhetoric when appropriate. Too many patent litigators feel uncomfortable with rhetoric in the courtroom. But rhetoric motivates the jurors to argue a given conclusion. It energizes the deliberations. It has a particularly important place in a jury trial, especially in closing argument. “The art of advocacy is the art of persuasion. It is counsel’s duty to use all legitimate means to convince the jury or the court that a finding for his client will be in accord with justice.” Of course, rhetoric can backfire if used improperly. But closing arguments that are risk-free tend to bore the jurors. In patent trials, it is not improper and sometimes is essential to invoke widely recognized authorities during a closing statement (such as Shakespeare and the Bible). This is an effective, and certainly a time-honored method of argument.

Don’t be disrespectful of opposing counsel or witnesses for the opposition. This is particularly important if it has been a difficult trial. The jury has a good sense of who was honest and who was not. It is fair to say that testimony offered lacked a certain credibility. It is over the line to suggest a bald-faced lie.

Don’t give in to sudden inspiration. Great things are not done on impulse. This is perhaps the most important for the plaintiff because the plaintiff, traditionally the party to close last, may want to respond to statements made in the defendant’s closing argument. It is important to stay with the closing argument as originally planned. The purpose of the closing is to sum up the evidence for the jury. It is not to give in to the temptation to debate opposing counsel.

There are limits to rhetoric, of course; it must remain within the confines of legally appropriate argument. For an informative discussion on improper argument at trial, see Ronald L. Carlson, “Over the Top” Final Argument: How Far Is Too Far?, 49 FED. L. 37 (Jan. 2002); and Craig Lee Montz, Why Lawyers Continue to Cross the Line in Closing Argument: An Examination of Federal and State Cases, 28 OHIO N.U.L. REV. 67 (2001).


In bench trials, the closing argument properly may be delivered as a response to comments of adverse counsel’s argument. It is the time to explain why the evidence does or does not support the key facts in the proposed findings of fact and to argue why the suggested conclusions of law are or are not correctly formulated. Because final argument in bench trials usually is preceded and followed by extensive written materials, the trial attorney will want to limit the argument to only the key or hotly disputed issues while directing the court to places within the briefing that more fully develop certain arguments. At this stage, the judge will be asking herself whether all the elements have been proven. This is the time to answer that unspoken question in the affirmative. Thus, closing argument in a bench trial should review each element
Closing argument is the last opportunity to organize for the jury the material facts established by the testimony, trial exhibits, stipulated facts, and written discovery and to explain how those facts allow the jury to answer the verdict questions that will be submitted to it by the court. If the jurisdiction permits lawyers to provide the jury with a copy of the verdict form during closing argument, take full advantage of this. This is the time to assist the jurors by walking through the analysis they will perform during their deliberations and the navigation of the special verdict form. The factual underpinnings to invalidity defenses can be clarified by walking the jurors through the verdict form. Pose the interrogatories and direct the jury with the evidence that makes it more probable than not that the interrogatory should be answered in a given way. In this regard, and remembering that statistics confirm that using a lecture format to present information results in a retention rate of only 5 percent, it is helpful again to rely upon the concept of reinforcing jurors’ understanding by providing visual support. An enlargement of the verdict form, whether as a blow-up, a flip chart, or some electronic format is essential to the jurors’ understanding. The principle of “show, don’t tell” is appropriate here. The jurors want to come away from the closing with an understanding of what their job is and how they can accomplish it. They don’t want to be told “the answer” without more.

Make the closing interesting for the jury. Use as many visual aids as can conveniently and easily be incorporated into the closing in the limited time allocated. Again, as it was through the trial, reinforcing the jury’s learning is the goal. Straight lecture is the least appealing and least successful of the learning vehicles.

When representing the patent owner, make full use of all presumptions of validity and enforceability, reminding the judge and the jury that the experts in the U.S. Patent and Trademark Office, who deal with validity issues day in and day out, concluded that the subject matter of the claims was patentable. Also take full advantage of the clear-and-convincing burden of proof required to invalidate an issued patent. The accused infringer does not have the benefit of these presumptions but can explain to the jury the reasons behind the presumption and remind them that even experts make mistakes. That is why there are patent trials, and it is the jury (if the parties consented) who must decide the ultimate fate of the patent’s validity.

If arguing noninfringement, emphasize the function and purpose of patent claims and their statutory requirements. If there is no literal infringement, point out the missing claim elements, using a colored or underlined claim chart to required to be proven and the facts that have been elicited in support of those elements. Judges are looking for a fair and just outcome within the confines of the legal analysis, and the closing argument is the place to emphasize the right and legal verdict to be rendered. Close attention during trial should have identified the questions that the judge has regarding the evidence. Answer these for her. If questions are asked, the responses should be direct and simple but comprehensive. The worst sin to commit is the one of assumption—assuming that the judge has understood the technology based upon the presentation at trial.

202 There are some jurisdictions and some judges that do not permit counsel to disclose the special verdict form to the jury during closing. Before undertaking this technique in an unfamiliar jurisdiction, it is essential to confirm the local practice.
emphasize the terms in the claims that do not apply to the accused device, composition, or process. Talk about the investment by the accused infringer in connection with the independent development of the accused product or process. If attempts were made to design around the patent, review them. The patent owner will, of course, in response, emphasize copying, commercial success, long-felt need, industry recognition, and as many other "secondary considerations" as possible, particularly in a jury case.

Whether damages are tried with liability or as a separate trial, both the patent owner and the asserted infringer should put a damage number before the jury. The patentee will want to provide full detail of the damages claim, with all individual elements spelled out in chart form or on a poster board (but avoid such terms as “S, G&A,” “incremental costs,” “gross margins,” and the like in final argument, particularly before a jury—the jury wants help in deciding how much, but those terms will not do the job). The accused infringer typically does not want to discuss any damage amount because that assumes liability, which the alleged infringer disputes. Nonetheless, the asserted infringer must come up with a number, emphasizing that it is only presented under the unlikely assumption there is liability. Without its own damage number, the infringer will be stuck with the patentee’s damage calculation if liability is found.

As a final note, patent trials are too often a passionless exercise. But tempered passion has an important place, particularly in closing argument. It conveys a sense of deep belief in the merits of a case. And there is much about which to be passionate in a patent trial. The invention was copied, stolen. The inventor lied to the Patent Office. This so-called invention was invented by someone else first. If counsel cannot be passionate about the loss of tens of millions of dollars (or much more), surely the jurors will not.

XI. THE INJUNCTION

Even after the jury returns a verdict, the trial is still not over. Subsequent to a verdict of patent infringement, it is important to submit a motion to the court for a permanent injunction even if an injunction was well pled in the complaint or counterclaim. Courts have the discretion under 35 U.S.C. §283 (but are not required) to grant an injunction “in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.”

Injunctions are permitted because “[w]ithout the right to obtain an injunction, the right to exclude granted to the patentee would have only a fraction of the value it was intended to have, and would no longer be as great an incentive to engage in the toils of scientific and technological research.”

The court’s decision as to whether to grant an injunction after a finding of infringement must consider the balance between damages awarded and the

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204 Id. at 970 (quoting Smith Int’l, Inc. v. Hughes Tool Co., 718 F.2d 1573 (Fed. Cir. 1984)).
requested injunction.\textsuperscript{205} The district court “must consider all of the circumstances, including the adequacy of the legal remedy, irreparable injury, whether the public interest would be served, and hardship on the parties and third parties.”\textsuperscript{206} Certainly, an injunction serves to prevent future infringement and monetary loss by continued use of a patented technology.\textsuperscript{207} Anytime patent infringement is found and there is a potential for continued infringement, monetary damages are considered inadequate.\textsuperscript{208} But sometimes it may be appropriate that an injunction be denied. According to the Supreme Court in \textit{Union Tool Co. v. Wilson}, \textsuperscript{209} “[a] patentee, in demanding and receiving full compensation for the wrongful use of his invention in devices made and sold by a manufacturer adopts the sales as though made by himself, and therefore, necessarily licenses the use of the devices, and frees them from the monopoly of the patent.” If a patentee received an award based upon a reasonable royalty for making and selling a patented technology that fully compensates the patentee, an injunction may be unavailable. In this circumstance, payment of the monetary judgment is treated like an implied license to any purchaser of the technology.\textsuperscript{210}

\begin{itemize}
\item \textsuperscript{205} \text{Stickle v. Hublein, Inc., } 716 F.2d 1550, 1563 (Fed. Cir. 1983) (“[I]njunctions and damages must be tailored to the circumstances and be correlative determined.”).
\item \textsuperscript{206} \text{Shiley, } 601 F. Supp. at 969–70.
\item \textsuperscript{207} The form of the injunction is set forth in Federal Rule of Civil Procedure Rule 65(d), which requires the order to “set forth the reasons for its issuance,” be “specific in terms,” and “describe in reasonable detail, and not by reference to the complaint or other document, the act or acts sought to be restrained,” concluding with the statement that an injunction is binding “only upon the parties to the action, their officers, agents, servants, employees, and attorneys, and upon those persons in active concert or participation with them who receive actual notice of the order.”
\item \textsuperscript{208} \text{Shiley, } 601 F. Supp. at 970.
\item \textsuperscript{209} \text{259 U.S. 107, 113 (1922); see also King Instrument Corp. v. Otari Corp., } 814 F.2d 1560, 1564 (Fed. Cir. 1987); \textit{Stickle}, 716 F.2d at 1563; \textit{Wagner Sign Serv. Inc. v. Midwest News Reel Theatres}, 119 F.2d 929, 930 (7th Cir. 1941); \textit{Amstar Corp. v. Envirotech Corp.}, 823 F.2d 1538, 1543 (Fed. Cir. 1987).
\item \textsuperscript{210} \textit{Stickle}, 716 F.2d at 1563.
\end{itemize}