

HOW TO MAXIMIZE YOUR PROSPECTS OF SUCCESS BEFORE THE FEDERAL CIRCUIT

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- A. Introduction
 - 1. Federal Circuit Judge Giles S. Rich always gave the same advice as to how to maximize success before CAFC: Be on the right side.
 - 2. The problem is: what is right side?
 - 3. Some cases: law/facts are so one-sided that result is all but preordained; in such cases, appellate advocacy plays little if any role.
 - 4. In many other cases, however, this is not so. In those cases, appellate advocacy and strategy play a critical role; in such cases, a given appeal can be won by one attorney and lost by another without regard to the particular judicial panel that hears the case.
 - 5. It is those cases I want to talk about today, and about which I'd like to share insights that I've collected over the years as to how to maximize success before the CAFC.
- B. Summary of Presentation
 - 1. And to do that, I'd like to talk about 5 aspects of a CAFC appeal:
 - a. Who should handle the appeal?
 - b. If a person different from the one who tried the case below, when should the appellate lawyer first get involved?
 - c. Pre-appeal actions.
 - d. Preparation of the brief.
 - e. Oral argument.
 - f. Predicting success on appeal.
- C. Who should handle the appeal?
 - 1. Counsel who handled proceeding in lower tribunal vs. new counsel
 - a. Relationship with client
 - b. Effectiveness in lower tribunal
 - c. Familiarity with case
 - d. Effectiveness as appellate advocate
 - e. Importance of appeal
 - f. Cost
- D. If counsel is different from trial counsel, when should he/she get involved?

- E. Pre-appeal actions
 - 1. Making certain case is in proper posture for appeal
 - a. Ex parte patent appeal
 - (1) Possible refiling to add evidence, improve claims, etc.
 - (2) Petitions for reconsideration
 - b. Bench trials
 - (1) Petitions for reconsideration
 - c. Jury trials
 - (1) JMOL/new trial motions
 - (2) Timely objections
 - d. Avoiding waiver problems
- F. Preparation of brief
 - 1. Preliminary matters
 - a. Review of record
 - b. Decide on issues to be raised on appeal
 - (1) Don't necessarily raise all issues, only issues on which there is decent prospect of success
 - (2) Don't diminish good issues with bad
 - (3) Be bold: consider raising only strongest issue(s)
 - 2. Content and organization of brief
 - a. The court's rules and FRAP require a certain format, which must be followed
 - (1) Outline of format
 - (2) Within this format, there's much flexibility
 - b. Statement of Issues
 - (1) Argumentative but not too argumentative
 - (2) Examples
 - c. Statement of facts
 - (1) Preliminary statement - pithy, hard hitting, essence of appeal up front
 - (2) Factual background
 - (a) Must be factual, *not* argumentative
 - (b) But within this framework, it should in effect make the argument, without seeming to be argumentative
 - (c) Use pictures
 - (d) Don't worry about length (other than keeping within overall page limits); may be most of brief
 - (e) Keep simple and understandable; use lay language if possible
 - (f) Don't include any unnecessary facts
 - (g) Glossaries if necessary or helpful
 - (h) Use record cites liberally; if you can't support it, don't state it

- (i) Must stay within record or support through judicial notice
 - (j) If properly done, it should grip reader and lean court in your client's favor
 - d. Summary of argument
 - (1) Prepare last
 - (2) Nothing sophisticated here
 - (3) Possibly use titles as guide
 - e. Argument
 - (1) If facts are well laid out and developed, argument may be short, though not necessarily
 - (2) Strong arguments first
 - (3) Should be logical development, with each succeeding argument flowing from preceding one
 - (4) Must pay attention to burden of proof; should spell out and argument should meet it
 - (5) Use citations sparingly but effectively
 - f. Conclusion
 - g. In general - miscellaneous
 - (1) Lay language; if court doesn't understand, it will take easy way out
 - (2) Limit footnotes
 - (3) Maintain credibility; don't exaggerate, misstate or improperly crop quotes
 - (4) Avoid too harsh attacks on lower court/adversary
 - (5) Avoid slur words
 - (6) Proofread, proofread, proofread
 - (7) Titles of sections
 - (8) Pay attention to court's rules
 - (9) Look at other, well-written briefs if a beginner
 - (10) Recognize that not everyone is a good brief writer
 - (11) Concentrate on Supreme Court/Federal Circuit precedent; be candid with precedent
 - (12) Sometimes anticipate argument to neutralize it
- G. Oral argument
 - 1. Preparation - in general
 - a. Steep yourself in briefs/record
 - b. Visit another argument if unfamiliar with court procedures
 - c. Mock oral argument
 - d. An effective approach to preparation
 - 2. General guidelines
 - a. Short: 5-7 minutes
 - b. Get to essence immediately; assume court is familiar with case
 - c. Don't hit all points; not enough time
 - d. Try to open with attention grabber

- e. Be prepared to point out essence of lower tribunal's error
- f. Use visual aids if helpful; be familiar with court rules regarding use of visual aids and notice to adverse party
- g. Answer questions immediately and directly
- h. How to deal with constant interruptions
- i. Don't patronize ("that's a good question")
- j. Avoid being cute/funny/too friendly
- k. Avoid personalities
- l. Use lay terms
- m. Don't read; avoid long quotes, cites, etc.
- n. Rebuttal: save time for rebuttal; use where necessary but know when not to and when to sit down
- o. Sit down when through, whether or not your full time has been consumed

H. Predicting success on appeal.

- 1. Historically
- 2. Currently