

Recent cases underscore the need for alliance between litigator and patent attorney

By Steven Susser

Doctors do it all the time. An internist may refer a patient to a specialist who may in turn refer that patient to a surgeon. It is just that sort of symbiotic partnership that is most effective in dealing with complex matters of medicine.

And so it should be with law.

Patent law is a particularly complex area of the law, akin perhaps to the most involved medical procedure. Like specialists in the medical field who often operate, patent lawyers often also make fine trial lawyers. But sometimes the skill set a patent attorney develops for prosecution work doesn't always necessarily mesh perfectly with the skills needed to present to a jury. In these instances, there is room for a trial lawyer to work with the patent attorney to try a case in a court of law.

Very few - not the judge, nor the jury, nor the trial attorney - will know matters of patent law any better than the patent attorney. That knowledge, experience and background are vital to any patent dispute. Conversely, there is scarcely an attorney not regularly in court who is the equal of a seasoned trial attorney in presenting to both judge and jury. In the ideal, a patent attorney and a trial attorney will join forces to gain the best possible command of pertinent patent law and then present that pertinent law in court.

While it never makes strategic sense for a trial attorney to try a patent case without the assistance of a patent attorney, there are instances in which it makes sense for a patent lawyer to conduct a patent trial without using a trial lawyer. However, considering the inherent skill set of an able trial attorney, the team approach is more often than not the winning formula.

- Trial attorneys are in court arguing before a judge and jury on a regular basis. That vital skills are continually honed and mastered - daily experience for which there is no substitute.
- Trial attorneys develop a sense for how to appeal to the sensitivities of and persuade a judge and jury - acumen that is reinforced through repetition.
- Good commercial trial lawyers are adept at taking very complex concepts and rendering them understandable by the lay person in ways that many patent attorneys find challenging. This skill can be critical to winning the patent dispute. *What's easiest to understand is usually the most persuasive.*

In the case Shertech, Inc. v L&W, Inc.¹, the judge was charged with determining what the term "standoff" meant in a patent dispute involving automotive heat shield technology. While the patent attorney presented a very complex explanation of the term, the trial attorney convinced the judge that "standoff" means what the dictionary says it means, in effect turning the summary judgment in favor of the patent holder.

- Optimally, the trial attorney with whom the patent lawyer partners would be one possessing knowledge of and experience with patent law, so as to maximize strengths and facilitate communication between counsel.
- Few, but some, trial attorneys will be willing to perform his or her piece on a contingency basis, whereby the trial attorney is compensated on a contingency, while the patent attorney

gets compensated hourly. In addition to strategic advantage, then, this tack may also present cost efficacy to the client.

In my experience in patent litigation, the most effective and most persuasive cases are those presented when trial counsel worked closely with patent counsel. Each "side" brings different perspective to issues critical to the trial. The patent attorney has a command of the intricacies of patent law, and the trial lawyer possesses the skills necessary to persuade a judge or jury. In most cases, the team of patent and trial attorney have been able to defeat a patent counsel adversary because the team has the experience, knowledge and breadth of acumen to approach a trial from a more creative and more unpredictable direction than does their adversary.

In addition to the Shertech case, Teleflex, Inc. v KSR International Co.² demonstrates the effect that combining expertise in patent and trial law can have on the outcome of a trial. In this case, as in many trials, the trial lawyer served as a "filtering device" for the judge, presenting the argument in a very understandable way.

In its ruling, the United States Court of Appeals for the Federal Circuit vacated a previous summary judgment that determined the patent was invalid and remanded the case to the district court for further proceedings. The patent at issue, U.S. Patent No. 6,237,565 81, described a product that combined an electronic throttle control (ETC) with an adjustable pedal system (APS). (ETC is a revolutionary method of delivering fuel to the car engine electronically as opposed to mechanically, while APS is a relatively new technology that allows a driver to adjust the gas and brake pedals to suit his size and comfort.)

The patent was originally ruled as invalid by U.S. District Court (Eastern District of Michigan, Southern Division) Judge Lawrence P. Zatkoff for the reason that combining these two progressive technologies was deemed "obvious," as claimed by KSR. However, Teleflex argued that combining the two technologies was not "obvious" as a matter of law because there was no clear and convincing evidence that there was a motivation to combine the two technologies. In the end, the Federal Circuit agreed that KSR had not demonstrated Teleflex's patent to be invalid as a matter of law.

In this instance, the Federal Circuit rejected a hindsight-based analysis and instead found that the combination of two ground-breaking automotive technologies was not necessarily obvious at the time of its conception. It was only through the trial team's examination of what is "obvious" against what is "obvious" as a matter of law that allowed the patent holder to maintain legal validity of the patent.

The term "obvious" is a rather simple term that can be made complex by patent attorneys and rendered confusing to judge and jury. In fact, it was in the case of KSR. But forgetting for a moment about the context of patent law, the meaning of "obvious" should be, well, obvious. The trial, in essence, hinged on this simple definition, and it was the team of patent lawyer and trial attorney that made this connection for the judge more comprehensively than did the patent-law adversary.

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Steven Susser is a shareholder in the Southfield, Mich., firm Young & Susser, P. C. The firm specializes in complex business litigation, including patent disputes. Susser can be reached at 248-353-8620 or via e-mail at susser@youngpc.com.