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5 Tips For Arguing Your Patent Case At The Supreme Court

By **Ryan Davis**

Law360, New York (March 28, 2013, 9:08 PM ET) -- If you find yourself arguing a patent case before the U.S. Supreme Court, don't rely on the game plan you use at the Federal Circuit — the justices won't be swayed by highly technical details or arguments that focus on case law from the patent appeals court. Law360 spoke with IP attorneys who have faced the Supreme Court and won. Here are their five winning tips.

Keep It Simple

Compared to the Federal Circuit, which is deeply steeped in patent law, the Supreme Court hears, at most, a few patent cases per year. Attorneys must bear that in mind when preparing briefs and arguments, said Gregory Garre of Latham & Watkins LLP.

"The most important thing to appreciate is that while the justices know a great deal about patent law, they're not experts in patent law," he said. "They're going to approach cases from the perspective of a generalist."

For that reason, it's most effective to frame the arguments in the context of the important legal principles and not focus on technical issues, Garre said.

"It can be helpful to take a step back from the intricacies of the area of patent law at issue and think about it more from a common-sense perspective," he said.

The justices have shown little appetite for hearing cases that hinge on arcane scientific issues, so when asking them to take a case, "it's important, as much as humanly possible, to not be too technical," said Carter Phillips of Sidley Austin LLP. "The more technical you make your presentation, the less likely the court is to hear the case, and if they do hear it, to be enthusiastic about it."

And no matter how involved the technology or patent issues at stake, arguments at the Supreme Court must be translated into plain English and broad legal principles, said Donald Falk of Mayer Brown LLP.

"The court will dive into things, so you don't have to dumb it down by any means," he said. "But you do have to express your argument in a way that makes sense."

Focus On Supreme Court Precedent

Although the bulk of modern patent law precedent comes from the Federal Circuit, citing those cases is much less likely to sway the high court than support from its own case law, attorneys say.

"You see a lot of patent practitioners putting their briefs all in terms of what the Federal Circuit has done," Falk said. "But if you're going to convince the court that the issue is worth its time and involves an issue above the Federal Circuit's pay grade, you need to work from Supreme Court patent cases."

It can often be challenging to find Supreme Court patent case law that is directly on point, because many of the relevant cases date from decades ago, before the Federal Circuit was created. Still, there is enough there to build an argument in most cases, and nonpatent decisions from the high court dealing with constitutional principle or statutory interpretation can also be helpful in guiding the justices in patent cases, Garre said.

The Supreme Court has stressed that even its old patent decisions are still binding on the Federal Circuit, and has lately taken a dim view of attempts by the lower court to craft rules that conflict with its precedent. Such rulings by the Federal Circuit are therefore a fertile avenue for Supreme Court arguments.

"The Supreme Court has made clear that the Federal Circuit may have national patent jurisdiction, but it's still underneath the Supreme Court," Falk said.

It's also important to resist the temptation to tell the Supreme Court that a lower court decision is obviously wrong, said James W. Dabney of Fried Frank Harris Shriver & Jacobson LLP.

"There's a fine line you have to walk between complaining of error and saying a case should be reviewed because of the importance of the legal principle at stake," he said.

Amicus Briefs and Dissents Can Be Key

The toughest part of any Supreme Court case is getting the justices to hear it. In most areas of the law, a circuit split is a surefire way to get the court's attention, but that can't happen in patent cases, where one court hears all the appeals.

As a result, amicus briefs play an important role in helping the justices understand the importance of a patent issue, and litigants should lobby for briefs that support their position.

"There's a much higher premium on amicus briefs at the cert stage, and there's a cottage industry of groups that file briefs," Phillips said.

Along the same lines, a dissent at the Federal Circuit on a patent issue can also help focus the attention of the Supreme Court by creating a sort of split within the court, he said.

"That probably forces you to seek rehearing en banc because of the value of hopefully scaring up a dissenting opinion," he said.

Another way to persuade the court of the importance of a patent issue is to look to the past, when the circuit courts decided patent cases, Dabney said.

"It's still very often the case that a Federal Circuit decision can be argued to stand in conflict with regional circuit decisions from the pre-Federal Circuit era, and that can be a source of support for seeking Supreme Court review," he said.

Make Friends with the Solicitor General

The Supreme Court often invites the solicitor general to submit briefs in patent cases explaining the views of the federal government, recognizing the economic importance of decisions on patent law and the government's role in overseeing the U.S. Patent and Trademark Office.

Because the justices often take the solicitor general's advice, it's a good strategy for litigants to make their case to the government even before the court asks it to get involved in a case, Garre said.

"It's very important to encourage the U.S. to support your position and work with the solicitor general's office to educate them about the issues," he said.

It can be helpful to craft a Supreme Court petition in a way that encourages the justices to ask for the government's view, Phillips said. While the high court generally grants cert in less than 1 percent of cases, it agrees to hear about 30 percent of the cases in which it seeks the government's input.

"If you can convince the federal government this is important, it at least gives you a fighting chance," he said.

Lay the Groundwork Early

The foundation of a successful Supreme Court patent case is built long before it reaches Washington, and attorneys should be mindful of what the high court is looking for even at the early stages of the case.

"In my own experience, the process actually begins at trial," Dabney said. "You must raise the grounds for Supreme Court review, even if you think it's not going to be accepted by the lower court."

To that end, attorneys should be thinking about Supreme Court precedent when requesting jury instructions or making pre- and post-verdict motions, he said.

"That way, you can argue that the court was given the opportunity to do the right thing and didn't do it," he said.

--Editing by Elizabeth Bowen and Chris Yates.

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