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CHAPTER 7

How To Try an Intellectual Property Case Economically

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§ 7.01. Introduction.

The first person to whom I indicated the topic of this paper stated that it was a contradiction of terms because "no trial can be economical." The analogy my friend used was "military intelligence," implying that both cannot coexist.

Whether my friend was or was not correct, I intend to tell you some ways you can reduce the cost of litigation for your client or, if you are a corporate counsel, for your employer. I begin with the assumption that a decision has been made to file suit or, from the defendant's point of view, that suit has already been filed. Also, as a word of warning, you should understand my perspective. I am normally on the plaintiff's side of the docket, suing some "mean infringer" for "stealing" my client's patent, trademark, copyright, or trade secret. As a typical plaintiff's attorney, I usually want to get to trial as quickly and as inexpensively as possible. That goal should be of interest to the defendant as well as the plaintiff, though that is not always the case.

§ 7.02. Public Concern Over Skyrocketing Costs of Litigation.

In three of the past five years the annual Institute on Patent Law, sponsored by The Southwestern Legal Foundation, has presented topics on economics in litigation of intellectual property cases.[1] One of the speakers talked about complex litigation and the use of computers to control the litigation. My feeling is that for every intellectual property law trial involving "complex litigation" and

[1] Medlock et al., "Controlling the Costs of Litigation: A Panel Discussion," 1984 *Patent Law Annual* 297; Felsman, "Cost-Effective Patent Litigation," 1982 *Patent Law Annual* 195; Vaden, "Interplay Between House Counsel and Outside Counsel—A Lesson in Economics," 1981 *Patent Law Annual* 167.

requiring the use of computers merely to manage the documents, there are many more intellectual property cases tried on a much more frequent basis but not considered complex litigation under the prior speaker's definition. While my topic can be applied to complex litigation, it focuses on the much larger number of cases that intellectual property attorneys frequently try that need not be considered complex. Personally, I am somewhat amazed at how intellectual property attorneys can make a relatively simple case complex. Recently an author in the *American Bar Association Journal* commented he had never seen a complex case, even though he personally tried the Karen Silkwood case, which lasted for months.[2]

There have been numerous attempts by bar associations to reduce the cost of litigation, with the American Bar Association leading the way through various projects and studies. Probably the most complete documentation by the ABA concerning costs of litigation is entitled *Attacking Litigation Costs and Delay—Project Reports and Research Findings.*[3] Further studies have been made on how to reduce costs in state court litigation.[4] One attempt to reduce the costs of litigation is by the use of telephone conferences with the court.[5]

The cost of civil litigation is getting so high that the public, as well as lawyers and judges, is becoming concerned. As an example of the concern, the *Rutgers Law Review* devoted an entire issue to the subject of costs of civil litigation.[6] Numerous other articles have been written about litigation costs[7] and how to control them.[8]

[2] Spence, "How to Make A Complex Case Come Alive For the Jury," 72 A.B.A.J. 64 (April 1986).

[3] Action Commission To Reduce Court Costs And Delay, American Bar Association, *Attacking Litigation Costs and Delay—Research Findings,* (1984).

[4] ABA National Conference of State Trial Judges, American Bar Association, *Standards Relating to Court Delay Reduction* (1984).

[5] Joint Project Of The Institute For Court Management and the American Bar Association, *Evaluation of Telephone Conferences in Civil and Criminal Court Cases* (Dec. 1983).

[6] "Symposium: Reducing the Costs of Civil Litigation," 37 Rutgers L. Rev. 219 (Winter 1985).

[7] "The Chilling Impact of Litigation," Bus. Wk. 58 (June 6, 1977); Mercherle, "What Does The Client Expect for Dollars Expended?" 17 Forum 510 (1982).

If we intellectual property attorneys do not realize that rules of economy apply even in patent, trademark, copyright, or unfair competition litigation, we may soon price ourselves out of the market. As Judge Higginbotham stated, "As the costs and benefits of litigation axes cross, lawyers must cut total costs or be priced out of the dispute resolution mechanism." [9]

If we do not efficiently handle litigation, we will soon lose clients, and cases that should be litigated will be resolved some other way without us. This was perhaps stated best in a publication by the American Bar Association as follows:

> Clients are spending more money and losing patience. By increasing their efficiency, lawyers will increase their own profits and control litigation costs. It is only a question of time before clients demand this.[10]

The decisions of the United States Supreme Court prohibiting minimum fee schedules[11] and permitting lawyer advertising[12] force each of us to be economical in our handling of intellectual property cases. In recent years I have seen personal injury attorneys and/or criminal attorneys trying intellectual property cases. I might add that they did a reasonably good job in presenting the issues to the court. I have also seen general civil litigation attorneys do an excellent job trying intellectual property cases with an intellectual property attorney available in a second chair or consulting capacity. If we do not control litigation costs, we will begin to see general attorneys instead of intellectual property attorneys trying intellectual property cases as the rule rather than the exception.

[8] Lempert, "Litigation Budgeting: Yes After All," Legal Times 1 (March 22, 1982); "New Alternatives to Litigation," N.Y. Times, Nov. 1, 1982, p. D1; Turner, "Law Office Management: A Way To Control Litigation Costs," 14 Forum 1076 (Summer 1979).

[9] Higginbotham, "Does the System Cause Excessive Fees," 14 Forum 681, 692 (Spring 1979).

[10] Bernstein, Diamond, and Zamore, "New Approaches to Controlling Litigation Costs," 7 Litigation 4, 25 (Summer 1981).

[11] Goldfarb v. Virginia State Bar, 421 U.S. 773 (1975).

[12] Bates v. State Bar, 433 U.S. 350 (1977).

§ 7.03. Selection of a Trial Counsel by Corporate Attorney.

[1] Involvement of Corporate Counsel.

Depending upon the involvement corporate counsel plans to exercise in the case, he might consider selecting a general civil litigation attorney who is very familiar with both litigation and the court that will try the case. The corporate counsel could provide the legal expertise on intellectual property matters.[1] This is particularly effective in a patent infringement action where the patent issues can be discussed with and briefed by corporate counsel. A general civil litigation attorney, such as a personal injury attorney, knows how to move a case economically through trial to a speedy resolution.

The same co-counsel relationship can also be considered in trademark infringement and copyright infringement cases where the in-house corporate counsel has the legal expertise and knowledge to provide the technical backup for a general civil trial lawyer. It has been my experience that general civil trial lawyers have very good courtroom manners and expertise but lack knowledge of the nuances in intellectual property law. Good backup support from corporate counsel can overcome this problem for a good trial presentation. Corporate counsel can also help reduce costs by gathering evidence within the company, knowing who within the company may have useful information, and dealing with company people.[2]

[2] Selection of the Only Trial Counsel.

Assuming as corporate counsel you have decided to retain an intellectual property attorney to try the case, you will want one with civil trial experience in that particular field. Although many intellectual property attorneys will contend they have considerable litigation experience, you should find out how many cases the attorney actually has tried to a jury verdict or a judge-rendered decision. You will find that number to be amazingly low. You should, if possible, interview the proposed trial counsel whom you

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[1] Haring, "Stemming the Tide of Litigation Costs," 13 The Brief 14 (Nov. 1983).

[2] Whitehead, "In House, Outside Counsel," Nat'l L.J. 16 (June 7, 1982).

are considering to handle your case. After interviewing several attorneys, select *one* who will handle the particular litigation. *Do not* simply look up an attorney in the *Martindale-Hubbell Law Directory* and make a selection based upon that publication. If you do, you may be surprised at your attorney's lack of trial experience or courtroom presence.

In determining courtroom presence, it is good to speak with the other attorneys in the area who have tried cases with and/or against your prospective trial attorney. Obviously, if the case is a judge-alone case, you will want to know the individual's reputation in the legal community, especially as it may be viewed by the court. If the case is a jury trial case, you should be keenly aware of the person's ability to relate to the jury and develop jury rapport. Remember that in jury cases your attorney is an actor on stage making the most convincing presentation possible for your case.

In the selection process, you want *one attorney* to be in charge of your case from beginning to end. That attorney should handle essentially all the discovery and the trial preparation. That does not mean he cannot have assistance, such as the preparation of briefs by junior attorneys; however, you do not want to have to educate two attorneys for your case. It is cheaper and more economical to have one person directing *all* discovery and trial preparation. The reason for having the single attorney take essentially all depositions, attend all hearings, try the case, and handle the appeal is to incur the cost of educating one attorney, not a number of attorneys, about the facts of your case. In the long run this will reduce the costs of your litigation.

[3] Medium-Level Attorney in a Large Firm.

Since you are selecting a single attorney to try your case, he should not be the senior partner in a large patent firm. The senior partner obviously will be more expensive on an hourly rate basis and probably will not have the time necessary to devote to your case. This means the senior partner will assign many tasks to junior attorneys in the firm, resulting in your corporation having to pay for the education of those junior attorneys.

At the same time, you do not want a young attorney with little or no trial experience being the lead attorney in your case. I have

found that junior partners in large patent firms have a tendency to give the best representation in an intellectual property case. The junior-level partner, if properly selected, will have enough trial experience to give you effective representation and at the same time will not have too high a billing rate. The junior-level partner can attend all depositions and hearings, try the case, and handle the appeal. While he may get assistance from others, you want to make it emphatically clear to the law firm that you expect the attorney you select to be in charge of the entire litigation and to handle it personally.[3]

[4] Solo Practitioners or Small Intellectual Property Firms.

While there are many very effective litigators who are solo practitioners or are in small intellectual property firms, I have one word of caution regarding them. If you have determined that the solo practitioner or the small law firm has the background requirements for the handling of your case (sufficient litigation experience, good courtroom presence, etc.), consider how much of the attorney's time would be required to handle the suit. For example, a solo practitioner who is already very busy may not be able to devote the amount of time necessary to your case without other clients suffering. This results in the attorney trying to stretch time far beyond the available and practical limits.

On the other hand, a solo practitioner or an attorney with a small firm is likely to be much more cost conscious than an attorney in a larger firm. It certainly may be easier to control the dollars and have one person handling the entire case if a solo practitioner or an individual in a small firm is doing the work.

§ 7.04. Location of Trial of the Lawsuit.

If the location of the trial of the lawsuit has already been determined, this factor alone may considerably narrow the selection of an attorney by corporate counsel. From a corporate counsel standpoint, if you are trying a patent infringement case in Lubbock, Texas, and you want a local patent attorney to handle the entire

[3] § 7.03 N. 1 *supra* at 16.

matter, your selection is probably limited to one person, Wendell Coffee. On the other hand, you may have previously used very competent counsel from Dallas, Texas, who can associate with very good local counsel in Lubbock and still effectively represent you in the case. If your lead attorney is not from the area where the case is being tried, always associate with a very good, competent, experienced local counsel. A senior partner in a firm with which I was formerly associated always said, when there was a question of whether local counsel was needed, "Don't play ball on somebody else's court unless you know the rules of the game." This is as true in intellectual property cases as in any other type of case. Your local counsel should be familiar with the judge and the judge's preferences and idiosyncrasies.

The ideal, if possible, is to locate a good intellectual property attorney with trial experience in the area where the suit is pending, an attorney who is well acquainted with the court and the judge before whom the case will be tried. In smaller cities, this may be difficult.

Many times a corporation may have one particular attorney who is familiar with its overall intellectual property situation, not with just that particular case. If he is also a good, experienced trial attorney, you might consider using him, regardless of where the case is to be heard. That attorney could associate with a good local counsel to try the case. I personally like to have local counsel who is very familiar with the workings of civil court proceedings before the court in which the case is pending. In one case I am using a former assistant U.S. attorney who, prior to joining a general law firm, tried civil cases in the United States district court to which the case was assigned. The local counsel is more familiar with the inner workings of civil cases in that particular court than any patent attorney in the entire area. Personally, I believe our combination gives the client the most effective possible representation for the dollar spent.

If you have the option to select the location for the lawsuit, naturally you want to choose a place that is convenient for both you and your client. For example, if you sue a large manufacturing and distribution company for patent infringement and that company has numerous outlets across the United States, you may be able to bring

your case at any location where there is a sales office with paid employees. While this may be inconvenient for the defendant, it will certainly be convenient for you and your client, resulting in cost savings.

These cost considerations must be balanced against other factors. In determining where the suit is to be filed, do not ignore the possible makeup of the jury or the judge to whom the case is likely to be assigned. If your client owns a patent that is being infringed and is a large employer in a local community, if there is a basis for jurisdiction in that community (i.e., a sales office of the infringer is located there), it is probably where you want to file the suit. If your client is being charged with patent infringement, you feel that the patent is invalid, and you want to file a declaratory judgment seeking to prove patent invalidity, you naturally may want to file the suit where your client has a favorable public image. On the other hand, some employers have such a bad reputation in their own community that they might prefer the suit to be elsewhere. In any event, in determining where the suit is to be filed, economics of litigation should be one of the most important criteria.

§ 7.05. Theme of the Case.

Whether you are the plaintiff or the defendant, you want to develop a theme of the case very early and follow it all the way through the trial. Do not change your theme unless there has been a drastic change due to the evidence found in discovery. In determining the theme of the case, remember the KISS principle: "Keep It Simple, Stupid." The theme should be like a story you can tell to the judge or the jury.[1] If you are representing the patent owner, your theme should be how your inventor struggled until finally coming up with the breakthrough that solved the problem with prior "widgets." You should be able to show how your client's widgets had tremendous commercial success until they were copied by the bad infringer. Thereafter, sales started decreasing for the first time since introduction of the invention. Remember, you want to portray your client with a white hat and the infringer with a black hat.

If you are representing the infringer, you may want to develop a

[1] § 7.02 N. 2 *supra.*

recurring theme such as how your client was simply using what was already in the literature. For example, if you can show how your client looked at magazine articles or other published periodicals before redesigning the widgets that plaintiff now contends infringe, you may be able to convince the jury that what your client gathered from the prior art was known and obvious to those in the industry. Do not overcomplicate your case by trying to bring in every conceivable defense. Avoid as much as possible alternative theories of the case that deviate from your central theme.

You may have heard the story of a plaintiff who was bitten by a dog on the defendant's property. When the defendant appears in court, he makes the following alternative arguments to the jury:

(1) Plaintiff was not bitten by a dog.

(2) The dog that bit the plaintiff was not my dog.

(3) I do not own a dog.

Obviously, if the defendant argued and failed on the first two arguments, the jury is not going to pay very much attention when he denies owning a dog. While alternative arguments are good in theory, in practice they are extremely dangerous in a jury trial.

No matter how complex the case, a centralized theme should be developed, regardless of whether you are representing the plaintiff or the defendant. Do *not* use a shotgun approach.

§ 7.06. Pretrial Matters.

[1] Filing the Suit.

In preparing the complaint, use a generalized pleading. A fifty-page complaint on a single count of patent infringement is ridiculous. All one has to do is go to the form books, copy a form pleading, and make whatever changes are necessary for the particular case. An elaborate, detailed pleading serves no legitimate purpose in patent, trademark, or copyright infringement cases. Sometimes in an unfair competition case, slightly more detail may be necessary. In any event, brevity is the name of the game.

If you are representing the plaintiff, monitor the service of process to ensure that the defendant is timely and properly served. Since we are talking about economics in the trial of a lawsuit, you

probably do not want to request a temporary restraining order or a preliminary injunction because this tends to increase the cost of litigation. This is especially true if the case is not settled after a preliminary injunction hearing.

Assuming you are representing the defendant, you probably want to allege the standard affirmative defenses and counterclaims as well as to answer the complaint. The standard defenses and counterclaims are contained in many form pleadings and can be modified for your case without a major expenditure of time. However, be careful not to allege affirmative defenses or counterclaims on which there is *no proof.* If you do, you or your client could suffer sanctions, as will be discussed below.[1]

[2] Your Request for Discovery.

If you represent the plaintiff, as soon as the answer has been received, send out a notice of depositions and a request for production of documents; if you are the defendant, do this immediately before filing your answer. There probably are no other pleadings more helpful in controlling the costs of litigation than the first notice of depositions and the request for production of documents. They set the tone of the entire discovery process. My preference is to attach an exhibit that (1) indicates the category of documents I want produced and (2) uses the same categories to designate individuals to be deposed under Rule 30(b)(6) of the Federal Rules of Civil Procedure. In this manner I have simultaneously designated the documents to be produced and the witnesses who can testify with respect to those documents. If specific witnesses are known, they may also be designated at the same time.

The exhibit attached to the first notice of depositions and request for production of documents is probably the most important document prepared during the litigation. Have some very general paragraphs that indicate documents by a broad, general category; some intermediate paragraphs that are more specific as to the documents to be produced; and then some paragraphs that are very, very specific on those documents. In that manner, you will have covered all the bases on the designation of documents.

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[1] Fed. R. Civ. P. 11.

The reason for exercising such detail is that "the cost of discovery in most cases far exceeds the cost of trial."[2] Attention to detail at the outset will ultimately save time and money. As Judge Higginbotham stated, discovery is "almost everyone's candidate for number one contributor to cost."[3]

[a] Reviewing Documents Produced and Deposing Witnesses Pursuant to First Notice.

At the time of the first document production and deposition of witnesses, be sure to verify which witness is the one designated for each category of documents produced. Have the witness identify the documents produced under each of your designated categories. Be very complete with him when you review designation under Federal Rule 30(b)(6). As you proceed with the deposition, many times witnesses who were requested and have knowledge of a certain category of documents are not produced or documents requested are not produced. If such occurs (as regrettably it is in most intellectual property cases), file a motion to compel if opposing counsel does not agree immediately to locate and/or produce the witnesses or the documents at the scheduled deposition. By such a move you force opposing counsel to comply with discovery rules, which should ultimately reduce the probability of discovery abuse.[4] Always request costs and attorney's fees on any motion to compel. With the 1983 amendments to the Federal Rules of Civil Procedure, sanctions by way of costs and attorney's fees can be awarded by the court in any abusive discovery situation.[5] In fact, Rule 37(a)(4) uses the mandatory term. This indicates that the court "shall" give the movant party reasonable expenses and attorney's fees if the movant is successful. Other 1983 amendments to the Federal Rules of Civil Procedure also have provided for sanctions by way of attorney's fees or other remedies.[6] Because of the increased emphasis in recent years on discovery abuse, the courts are more likely today to grant

[2] Felsman, § 7.02 N. 1 *supra* at 202.

[3] § 7.02 N. 9 *supra* at 686.

[4] Glasser, "Should Law Firms Worry About Corporate Business?" Legal Times 10 (Oct. 11, 1982).

[5] Fed. R. Civ. P. 16(b)(3) and 26.

[6] Fed. R. Civ. P. 11, 26(g), 16(f), and 37.

sanctions than ever before. "A favorite whipping boy for those who write on reduction of legal costs is pretrial discovery."[7] Most states have adopted state court rules providing for sanctions in the event of discovery abuse.[8]

In filing the motion to compel discovery, all you need is a fairly short motion pointing out the facts and citing the rule as authority. Every federal judge is well aware of the rules concerning discovery, and you likewise should be familiar with them, especially Rules 26 through 37.[9] You will be using those rules continually throughout litigation in the United States district courts.

[b] Second Request for Production and Notice of Depositions.

After you have received a ruling from the court, renotice the depositions and the request for production of documents, including the items ordered produced by the court, plus any additional items of which you became aware during the first round of discovery. By now you should be pinpointing your discovery toward particular witnesses and particular documents. Inquire in detail as to whether you have the proper category of requested witnesses and all the requested documents. If you now do not have the requested documents and they are part of the documents included in the court's prior order, opposing counsel is in real trouble. If you have to file a second motion to compel and request for sanctions under Rule 37 because the opposing side has not complied with the court's prior order concerning discovery, in all probability you will get sanctions awarded by the court, at least by way of costs and attorney's fees.[10] Judges today are very aware of discovery abuse and how it prolongs litigation, making litigation more expensive. In a survey of litigators in Chicago, Illinois, discovery abuse in the form of using discovery for the purpose of applying economic pressure on another party or attorney existed in more than one-third of the large cases. Moreover, a motive such as this was the main factor affecting the litigator's decision to use discovery tools.[11]

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[7] § 7.03 N. 1 *supra* at 16.

[8] Tex. R. Civ. P. 215.

[9] Fed. R. Civ. P. 26–37.

[10] Fed. R. Civ. P. 37.

[11] Brazil, "Civil Discovery: Lawyers' Views of Its Effectiveness, Its Principal Problems and Abuses," 1980 A.B.F. Res. J. 787, 857.

Concerning documents that opposing counsel claims to be privileged, asking the witnesses some questions about the privileged documents will help determine whether the documents are truly privileged. If this cannot be accomplished, request an *in camera* review by the court of those documents. Many times opposing counsel may contend that something is privileged when it is not. A claim of privilege may be used to protect a very critical document from discovery. A motion requesting an *in camera* review requires a minimum of time on your part, even though such a review may take a good deal of the court's time to examine the allegedly privileged documents.

[3] Your Production.

My strongest advice on production by your client is *be complete!* Unless there is no way a particular document could be considered relevant, do not unilaterally decide not to produce it because you believe it is not relevant. My personal philosophy is to produce all documents that are conceivably related and/or requested and are not covered by the attorney/client privilege or the attorney work product rule. The only point where I would be conservative in my client's favor is on the question of attorney/client privilege and work product rule. If documents are produced that should have been covered by the privilege or are work product, the privilege or the work product is waived at the point of production. Otherwise, be overly generous in producing documents and witnesses.

If you are making a conscious decision not to produce something that may conceivably be relevant to the case, always file written objections to the production of the requested documents[12] and possibly even move for a protective order.[13] Do *not* unilaterally decide simply not to produce. NEVER DO YOU SIMPLY NOT PRODUCE! Personally, I normally make whatever objections I feel are appropriate to interrogatories or requests for production of documents but produce despite my prerecorded objection unless the attorney/client privilege or work product is involved.

One alternative used considerably in state court and sometimes in

[12] Fed. R. Civ. P. 34(b).

[13] Fed. R. Civ. P. 26(c).

federal court is simply to have the opponent come to your client's workplace and examine the files as they exist in the normal course of business.[14] This can be dangerous because you might accidentally waive the attorney/client privilege as a result of documents inadvertently being left in the files. Also, opposing counsel would be able to obtain a better feel for your client's operation. This may aid your opponent at trial.

[4] Marginally Fruitful Discovery.

One of the hardest decisions for most attorneys to make is when to stop discovery. Most intellectual property attorneys want to depose every conceivable witness and see every conceivable document before being satisfied of adequate preparation for trial. We could learn a lot from personal injury attorneys on how extensively to prepare (or not to prepare) for a trial. Take the necessary depositions that are central to your case, depose the experts, and STOP! Do not chase down every conceivable rabbit trail that may exist.[15]

One time I had the pleasure of trying a case as co-counsel with a very learned attorney who had been practicing law for more than fifty years. Two defendants in the case were a divorced couple, each represented by a separate attorney. The husband had testified one way on a particular matter, and the wife subsequently took the stand and was testifying exactly the opposite way. The wife's testimony was clearly based upon hearsay. I leaned across the table and whispered to my older, slightly hard-of-hearing co-counsel, "That testimony is objectionable. Do you want to object?" He answered in a loud whisper, "Huh? What did you say?" Again, I responded in a loud whisper that could be heard throughout the courtroom, "That testimony is objectionable. Do you want to object?" The elderly attorney leaned back in his chair and stated in a whisper loud enough for everyone to hear, "She says it's a white rabbit. He says it's a black rabbit. I'm not going to prove it's a gray rabbit. Let them go down all those rabbit trails they want to." The entire courtroom burst into laughter, with the examining attorney suddenly developing a wimpish look on his face.

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[14] Tex. R. Civ. P. 167(1)(f).

[15] § 7.06 N. 4 *supra;* Mercherle, § 7.02 N. 7 *supra.*

The important thing to learn in discovery is when to stop. This does not mean that if you take a large number of additional depositions you might not discover something, somewhere, somehow that might aid your case. Nevertheless, such overextended discovery does not lead to economical trials of intellectual property cases. Be selective in your discovery.[16]

[5] Use of Forms, Pleadings, and Briefs.

Almost every conceivable type of patent, trademark, copyright, or unfair competition case is included in form pleadings. You are free to use these, making the changes necessary for your case. Once the facts have been gathered, anyone should be able to prepare a patent infringement complaint in a maximum of two hours. If it takes you longer than that, you have not gotten your procedure down properly.

One time I tried a suit where the opponent was represented by a very large, prestigious firm. In support of one of the opponent's motions, opposing counsel used a brief that had (1) a short statement of the facts; (2) a section called "authorities," which was generic for any similar motion that would be filed in that Circuit; and (3) a single paragraph of conclusions. I suddenly realized that I had been served a form brief which opposing counsel could prepare in a minimum of time by reusing the authorities section over and over again. All that was required was to update the authorities periodically. The facts and conclusions could be prepared in a few minutes. From that date I prepared my briefs the same way. My firm keeps a collection of old pleadings in previous cases that can be referred to for subsequent litigation. This results in considerable reduction in costs to the client, greatly reduces the time involved, and adequately presents the matter to the court.[17] The court is not impressed by a lengthy, detailed brief and motion when a short, simple brief and motion is all that is needed.

[6] Expert Witnesses.

Very early in the trial of your case, line up your expert witness. If

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[16] § 7.03 N. 1 *supra.*

[17] Turner, § 7.02 N. 8 *supra; ibid.*

there is a particular expert who is better than others, you will want to have him on your side. Therefore, make a point of contacting your expert witness early and committing him to your particular case. You can treat the expert witness as a consultant until such time as you are ready to designate him as your expert. To the extent possible, try to select a local expert if one exists. Normally, you can find a damage expert from a local college or university who can testify about the issues in an intellectual property case. You may need two experts, depending upon the particular facts.

After you have lined up your expert, do not have him do a significant amount of work on the case until shortly before designation as an expert witness. The reason is that the case may settle and, if so, you do not want to have incurred unnecessary expense.

In selecting an expert, you should look for the following characteristics:

(1) Is knowledgeable concerning the subject matter (this is automatically presumed for all experts, though it is not necessarily true), and this knowledge can have been gained from work experience;

(2) Is very personable, so he would have good rapport with the judge and/or the jury;

(3) Has the ability to explain things in very simple terms;

(4) Portrays an image to the court of being somewhat humble;

(5) Will not rattle under pressure of cross-examination by opposing counsel.

In selecting an expert, you need to make sure that his theory of the case is the same as the theory that you want to present to the jury. Be sure of your expert witness's opinions before you designate him as an expert. Remember the KISS principle of a central theme of the case. Your expert witness presentation has to support the central theme you are trying to develop. Most important, do not let your expert witness control the case.

[7] Pretrial Order.

While many attorneys agonize over a pretrial order and argue

back and forth with opposing counsel, preparing a pretrial order should be very simple. Every pretrial order has sections that state (1) the matters on which both sides agree; (2) plaintiff's version of facts or law; and (3) defendant's version of facts or law. Simply ask opposing counsel to agree as to a proposed fact or law. If he does not, put the proposed fact or law in your section. Opposing counsel can do likewise. Once you prepare the parts you want in a pretrial order, if the opposing counsel does not agree with the proposed agreed-upon facts or law, simply shift to your particular section. There should not be a dispute over what is or is not included in the pretrial order. You should almost be able to dictate your part of the pretrial order and the agreed-upon parts.

§ 7.07. Trial.

[1] Trial Briefs.

Do not prepare long, complicated trial briefs. First, the judge will not read them; and, second, they are unnecessary. If you need trial briefs, prepare short ones (a few pages) directed toward particular points. If a trial brief is requested by the court, one that is short and concise is preferred by the court and less expensive for your client. On evidence points, a two- or three-page simple trial brief on the particular evidence point is the best approach to use. A detailed trial brief will not increase your client's odds of winning that particular point.

[2] Jury Instructions/Interrogatories.

In preparing your jury instructions or interrogatories, always have a source for your requested instruction. Note the source on your copy so that if the judge asks for authority for that instruction or interrogatory, an immediate source is indicated. Concerning instructions requested by the other side, if there is a reasonable basis for them, do not put up a serious fight to their being granted. Many commentators have indicated that instructions to the jury go in one ear and out the other. Today's trend is to give the instructions to the jury to take into the jury room. You do not want to build possible grounds for appeal by the other side by getting your opponent's requested instructions excluded when they should have been given.

Concerning the interrogatories asked of the jury, again remember the key principle: KISS. Use general interrogatories if at all possible. Even if you are representing the defendant, if detailed interrogatories are used, they simply increase the probability for error. If they are given and found in favor of the defendant, the plaintiff has a greater probability of reversal than if general interrogatories are used. The opposite is also true. If you have stuck to a central theme of the case, the judge will probably give an interrogatory that relates to that theme. This is true whether you are the plaintiff or the defendant.

[3] Visual Aids.

Although I cannot quote a source, I do recall numerous attorneys telling me that juries remember 10 percent of what they hear but 90 percent of what they see. Therefore, on all critical evidence, use a large chart or poster or the actual device to physically show the jury your side of the case. Charts or posters should be very simple and easy to understand. *Always* use charts for your damage calculations, which should be the last item presented to the jury, especially if you are the plaintiff.

Further, you want to tell the jury members how they should answer the interrogatories. Since they remember 90 percent of what they see but only 10 percent of what they hear, you might consider having the interrogatories enlarged on a display and writing in your proposed answers during your closing argument. Certainly, the jury will then know how your client wants the interrogatories answered.

[4] Order of Presentation.

Always start the trial with a strong witness. If it is a patent infringement case and you represent the patentee, you may want to start with the inventor telling how he struggled to develop the invention to solve the problem that had long existed. Whatever your case, it should be told in a storybook fashion that is logical and believable. You also want to conclude your presentation with a strong witness. If you are the plaintiff, you will want to end with your damage expert so that the damage figures will be the last thing in the mind of the trier of fact.

In the presentation of your case, you should always remember

that if the other side has advanced a legal theory in its presentation, you have to rebut the legal theory so that you have "some evidence" in your favor. While this is many times recognized as a battle of experts, "some evidence" ensures that if you win the trial court verdict, the opposing side cannot get the verdict reversed based upon "no evidence." If the opposing side raises a large number of frivolous matters that you have to rebut, rebut them during the central portion of your case, not at the beginning or at the end, which you want to be the strong parts of your presentation.

One of the most important aspects of the trial of the case is to be concise and to the point. Many times I have seen opposing counsel drag out a lawsuit, much to his client's detriment. While the counsel may think he is being effective by presenting all the possible issues in his client's favor, he may bury the stronger, more important issues along with a large number of frivolous or less important issues. Completeness with brevity is the name of the game in litigation.

§ 7.08. Settlements.

Always be willing to explore possible settlement. There are several logical points at which a case may settle. Some of these are as follows:

(1) Immediately after the filing of the suit;

(2) After the first round of depositions, when both sides should have a fairly good feel for the evidence in the case; or

(3) Immediately prior to trial.

United States district courts have begun to emphasize various matters that are designed to encourage settlement, including settlement conferences, summary jury trials, and/or mini-trials.[1] You should realize that approximately 90 percent of all cases settle prior to trial. Also, you should emphasize to your client not to be "greedy," because there is always the possibility that your side may lose. A good settlement is normally a settlement in which neither side is entirely satisfied.

[1] Green, "Growth of the Mini-Trial," 9 Litigation 12 (Fall 1982).

If you are on the plaintiff's side of the case, you should realize that the odds of obtaining a favorable settlement are greatly increased by your rapidly pursuing discovery and pushing the case to trial as quickly as possible. The more you delay, the less likely you are to obtain a favorable settlement.

§ 7.09. Conclusions.

There is public awareness occurring throughout the nation about the tremendous cost of litigation. If you promptly pursue discovery with proper discovery requests and, when the documents or the witnesses are not produced, promptly pursue your remedies before the court, you will greatly reduce your costs of discovery. When discovery is requested from your client, make sure your production of witnesses and documents is complete so that opposing counsel does not have grounds for requesting sanctions against you or your client. While your discovery should be complete, do not pursue every conceivable rabbit trail to possibly find new evidence that may be the needle in the haystack. This is not economical and is often counterproductive.

The use of form pleadings as examples and form briefs for case authority can greatly reduce the cost of preparing pleadings. In the presentation of the actual trial, have a central theme to bring out your best points. Never use a shotgun approach that simply confuses the trier of fact. While your instructions to the jury may be detailed, have authority for each requested instruction. Keep interrogatories simple to avoid possible conflict in answers by the jury. The interrogatories submitted to the jury should follow your central theme of the case.

If you follow these rules and obtain a favorable jury verdict, the probabilities are greatly in your favor that the opposing side cannot get the decision reversed on appeal. Moreover, you will have shown your client that "economical" and "trial" can successfully coexist.