French Client, German Court & You Speak Only English?

Clients often call on American lawyers to conduct international patent litigation. The client typically is American, but with increasing frequency, both the client and the forum are outside the United States.

One's attention is drawn immediately to differences in language and in legal systems. Most American lawyers are monolingual, which is regrettable, but not quickly remedied. The American lawyer also generally is not expert in other legal systems. In these circumstances, it is, of course, vital to select and to work closely with patent and legal counsel in the forum country. Translations usually are necessary.
The author respectfully submits, however, that principles of effective advocacy transcend language, national borders, and legal systems. As a member of an international litigation team, the American lawyer can and should make a substantive contribution through her knowledge of the facts, the client, the technology, and the industry. But even more than this, the American lawyer can use her skills in the preparation of the case, using the principles of effective advocacy to present a compelling story to the court.

I. Effective Advocacy

There is a great deal of hair-splitting in patent litigation. Issues often are multiplied unduly, perhaps nowhere more so than in the United States.

II. Simplify The Issues

It may be suggested that most patent cases involve one or two basic issues:

1. Whether an invention has been patented in compliance with law.

2. Whether an accused product makes use of the patented invention.

Notwithstanding differences in language and in legal systems, these issues are likely to be at the core of patent litigation everywhere. There may be differences in form, procedure, and precedent, but the same kinds of facts and the same kinds of arguments are likely to be relevant to the same basic issues.

Effective lawyers everywhere struggle to eliminate unnecessary complexity. Still, with broad rules of discovery and admissibility, especially in the United States, it is common for lawyers to present "reams of documents," "masses of exhibits," and "mounds of expert testimony" in their efforts to prove their cases. *Aghnides v. F.W. Woolworth Company*, 335 F. Supp. 370, 372, 379 (D. Md. 1971), *aff'd mem.*, 475 F.2d 1339 (4th Cir. 1973).

The effective advocate, however, quickly identifies the key issue and aims at it from the beginning to the end of the case:

> The issue in most cases lies in a very narrow compass, and the really great lawyer disregards everything not directly tending to that issue. The mediocre advocate is apt to miss the crucial point in his case and is easily diverted with minor matters, and when his eyes are opened he is usually angry and always surprised.

F. Hill, *Lincoln the Lawyer* 211-12 (1906).

B. Marshal The Facts

Thus, the key is to marshal the facts in an orderly sequence and to interpret them in simple language until the "mere recital of the issues" has the force of argument. *Id.* at 208.

> The objective is to master our material rather than to be controlled by it: Many people suppose that there is only one way of telling the truth, and that, given honesty, no art is required to make a frank and fair statement of matters in dispute; but this is a popular delusion. "A truth which is badly put," says Mr. Wells in his "Mankind in the Making," "is not a truth, but an infertile, hybrid lie," and every lawyer of experience knows that not one man in a thousand can make facts speak for themselves. Certainly the average practitioner does not master his material. He is controlled by it, and presents his cause in such a manner as to necessitate contradiction, invite confusion, or challenge belief.

F. T. Hill, *Lincoln the Lawyer* 208-09 (1906).

C. Prefer Plain Language Over Technical Jargon

In patent cases, we have taxed the patience of the courts by using technical jargon or "patentese." We delude ourselves if we believe that we can require the courts to accept our complicated presentations at face value. In some cases, the courts will reject our efforts as hopelessly confused:

> Propositions which in an ordinary patent cause would be understood the moment they were stated are here confused by a jargon of terms of art and diagrams which convey no meaning to the uninitiated. * * * We mention these facts to emphasize the incongruity of a system which requires the submission of such questions to a tribunal composed wholly of lawyers. * * * It will serve no useful purpose, even if we were able to do so, to follow counsel and experts through the maze of contradictory assertions and conclusions drawn from the descriptions and drawings of the . . . patents . . . . The decree is affirmed.

Westinghouse Electric & Mfg. Co. v. Columbia Meter Co., 200 F. 584, 584-587 (2d Cir. 1912).

> In such a waste of abstract verbiage . . . it takes the scholastic ingenuity of a St. Thomas with the patience of a yogi to decipher their meaning, as they stand.

Victor Talking Mach. Co. v. Thomas A. Edison, Inc., 229 F. 999, 1001 (2d Cir. 1916). (Judge Learned Hand).

D. Suggestions On Effective Writing

It is submitted that lawyers, to whom this article is addressed, already know all the elements of writing necessary to write good briefs. What is needed is discipline in marshaling facts and arguments and a willingness to use plain language and simple illustrations to convey our thoughts.

Here are a few suggestions on writing. It is useful to marshal the facts and the arguments into a logical and persuasive order. A concise statement of the issues may require rewriting the brief until there is a thread that flows through the issues, the facts, and the arguments. Short and simple constructions seem to work best. Edit.

E. Use Simple Exhibits & Analogies

The single greatest use for exhibits is that of illustrations in briefs. This is because the courts will make crucial determinations on, for example, claim interpretation. Generally, the courts' first and last clear chance to understand the patent will be based on written submissions.

The patent offices of most countries require drawings in all patent applications in which the invention can be so illustrated. Why should we expect the courts to settle for less?

But it may not be enough to provide the courts with unmodified patent drawings. Lawyers may wish to remove confusing reference numerals and lead lines, *see Westinghouse*, 200 F. at 585 (criticizing the obscurity of patent drawings and reference numerals). The most important elements of the invention can be clearly labeled and called out by name.

Technology that at first appears complicated usually can be explained in layman's terms. As noted, it is helpful to translate technical jargon into plain language. It also is helpful to use commonplace examples or analogies from everyday life, for example, by comparing chemical processes to ordinary cooking. Similarly, mechanical, electrical and biological technologies can be explained in terms of common experience. A "promoter" in genetic sequencing can be compared to a "start signal." A ratchet-and-pawl mechanism can be explained with an old-fashioned bumper jack for an automobile. Gas springs can be described as the devices used to lift modern car trunks. Valves can be compared to kitchen faucets.

The use of exhibits and analogies can help to bring life and meaning into otherwise dry and technical subject matter.

The foregoing principles of effective advocacy in patent litigation have application not only in the United States but also in other countries. The American lawyer can provide valuable assistance in international patent litigation by helping to simplify the issues, to marshal the facts, to prefer plain language to technical jargon, to write clearly, and to use simple exhibits and analogies.

II. Selection of International Patent and Litigation Counsel

Notwithstanding the substantive contributions, which can be made by the American lawyer, it remains of critical importance to identify and retain the best available counsel in the forum country.

A. More Than Reputation

Reputation justifiably plays an important part in the selection of international counsel, but reputation in the U.S. may not be determinative. Such reputation may rest on past laurels or on prominence in international bar associations, which, although valuable, are not sufficient to prove one's skills in advocacy. Also, it is the lawyer's reputation in the forum country and especially the forum court, which is of utmost importance. Moreover, while the reputation of a law firm or its senior members may be strong, one cannot always be certain that the lawyers actually working on the case will have similarly strong capabilities. Finally, reputation is at best an indicator, and not a guarantor, of competence.

B. Triangulation

The author has found that the practice of "triangulation" has been helpful in identifying and selecting international counsel. According to this method, one makes inquiries of knowledgeable sources regarding the best counsel in a particular country. Members of the International Association for the Protection of Industrial Property (AIPPI) can provide valuable recommendations, referrals, and other leads. Then, following these leads, one attempts to find at least three sources that agree that a particular counsel is competent and has obtained success in a variety of cases including ones similar to the case at hand. Further inquiries may be necessary during the process of clearing conflicts and retaining counsel.

C. Patent Attorneys and Lawyers

In most countries, of course, the profession of a patent attorney is distinct from that of a lawyer. Thus, to conduct patent litigation in the courts, one often must retain both a patent attorney and a lawyer. Moreover, in Germany, for example, lawyers typically practice in either the trial court or the appellate court, but not both, so that it is necessary to retain lawyers at both levels. Further delineations occur in relatively small geographic areas. Also, given the relatively small number of patent attorneys and lawyers in most countries, and their representation of both domestic and foreign clients and the resulting conflicts of interest, it can be difficult to retain counsel. Some flexibility may be necessary.

III. Working With International Counsel

It takes more than the selection of counsel to assure success. The likelihood of a successful outcome can be increased, by working closely with counsel in the forum

country to prepare and present the case, using the principles of effective advocacy discussed above.

A. Preparation

There is, of course, no substitute for the drudgery of preparation. In international litigation, the distance alone makes it tempting to rely solely on counsel in the forum country for the preparation of the case. This is risky, however, particularly if one does not actively monitor the progress of the case.

1. Providing International Counsel With Information And Instructions

It is assumed for purposes of this paper that the American lawyer is familiar with the client's business and the technology involved in the particular patent litigation. Thus, the American lawyer should be in a good position to obtain relevant information from the client and to make sure that the information is transmitted to international counsel.

Many of us are reluctant to impose our views on others, particularly regarding matters in other countries. It is suggested, however, that we provide valuable assistance to international counsel when we give them clear instructions regarding the goals of the client and the steps expected to be taken to accomplish the goals. This can be demonstrated by considering how much we value clear instructions and communications from our clients.

For example, if it is expected that international counsel will independently evaluate all of the facts and the documents in a case, identify all of the issues, and develop all of the arguments, counsel should be forewarned of that expectation. If, on the other hand, the American lawyer has investigated and analyzed the facts, the issues, and the most compelling arguments, international counsel should be provided with the benefit of that investigation and analysis. Such communication reduces legal expenses even as it increases the likelihood of a favorable outcome.

In summary, it is both reasonable and effective to provide international counsel with clear communications and instructions regarding the case.

2. Early And Regular Meetings And Communications

Along with the proposition that international counsel should be provided with information and instructions, it is very useful and helpful to meet early in the case, preferably face-to-face, in order to discuss the case, the issues, the evidence, and the arguments to be developed. Regular meetings and communications are helpful in moving the case forward. Moreover, early activity in the case will help to identify potential problems and will allow time to take corrective action if necessary.

B. When Things Don't Work Out

Occasionally, despite all assurances and efforts, it may occur that a case is not progressing satisfactorily. If early and regular meetings and communications are not effective in improving the posture of the case, it may be necessary to consider remedial action or even a change of counsel. Such problems are most likely to come to light when drafts are circulated or during moot court preparations for court hearings. A schedule usually is essential to monitor the case; delays should be a cause for concern and inquiry. Similarly, any lack of preparation for meetings and moot courts should be a cause for concern.

If repeated efforts to take remedial action are not successful, it may be necessary to consider change of counsel. One may need, once again, to identify and interview potential counsel prior to making such a decision. By continually monitoring the preparation and progress of the international case, one hopes to avoid such a course of action, but if necessary, one may change counsel with a minimum of harm to the client's case, not to mention avoidance of lost time and effort, legal expenses, and harm to the client's business and legal objectives.

Conclusion

The American lawyer can play a key role in forming and mobilizing an international patent litigation team. In this role, the American lawyer can and should take a substantive role in the preparation of the case, using the principles of effective advocacy to present a compelling story to the court.

Richard P. Beem
Mr. Beem is the Principal of Beem Patent Law Firm in Chicago, Illinois
Presented October 14, 1998 to the International Association for the Protection of Industrial Property in Washington, D.C.