2014 Friedman Appellate Advocacy Lecture

Donald R. Dunner*

Introduction

I have long admired Judge Friedman and his incredible background: the Solicitor General’s Office (Deputy Solicitor General); frequent Supreme Court advocate; Chief Judge of the Court of Claims; one of the original Federal

* Presented by Donald R. Dunner, a partner in the Washington, D.C. firm, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP on November 21, 2014. He is a graduate of Purdue University and Georgetown University Law School. He has argued more than 165 cases at the Court of Appeals for the Federal Circuit and has argued before the U.S. Supreme Court. He is a past President of the American Intellectual Property Law Association, past Chair of the American Bar Association Intellectual Property Law Section, is a member of the ABA House of Delegates (2002 - present), and is a member of the ABA Board of Governors (2014 - present). He served as Chairman of the Advisory Committee of the Federal Circuit from 1982-92 and served on the PTO Advisory Commission on Patent Law Reform in 1991-92. Mr. Dunner is a co-author of Court of Appeals for the Federal Circuit: Practice and Procedure and past co-author of Patent Law Perspectives. Mr. Dunner is a Fellow of American College of Trial Lawyers (1995). In June 2004, Mr. Dunner was honored as the 2004 NJIPL Jefferson Medalist and he is a 2004 inductee of the American Academy of Appellate Lawyers. In July 2000, the National Law Journal named Mr. Dunner one of the 100 Most Influential Lawyers in America. He has been selected by his peers for inclusion in the Best Lawyers in America®, making him one of a distinguished group of attorneys who have been listed in Best Lawyers® for ten years or longer. In 2005, he was named International Lawyer of the Year for Patents by Who’s Who Legal: The International Who’s Who of Business Lawyers. In May 2008, he was listed in Legal Times’ “Greatest Washington Lawyers in the Past 30 Years.” He was a 2010 Inductee to Intellectual Asset Management magazine’s IP Hall of Fame and was honored in October 2011 with the AIPLA Board of Directors’ Award. Mr. Dunner was recognized by the George Washington University Law School students as Adjunct Professor of the Year, 2012. In May 2012, he was honored with the Linn Inn Alliance Lifetime Achievement Award and the 2012 IP Jurisprudence Award of Hispanic National Bar Association. He was the recipient of the 2002 Sedona Lifetime Achievement Award (2002), the 2013 Samuel E. Gates Litigation Award presented by the American College of Trial Lawyers, 2006 Attorney of the Year “Good Scout” Award presented by Boy Scouts of America, National Capital Area, Managing Intellectual Property Lifetime Achievement Award in IP (2014), the Who’s Who Legal Award - Patent Lawyer of the Year (2014), and the 2014 The American Lawyer Lifetime Achievement Award.

This paper was prepared by Mr. Dunner with the assistance of Stacy D. Lewis, law clerk, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP.
Circuit judges, who was instrumental in the formation of the court; and author of countless opinions in the Federal Circuit and other circuit courts, to mention only the highlights.

Judge Friedman was not only a legend in the law, but a truly warm and gentle person, as described so wonderfully in remarks delivered by Judge Newman on his passing. So I could not be more honored to appear before you today to deliver the third Friedman Appellate Advocacy Lecture.

**Impact of the Federal Circuit on the IP World**

I’d like to start with some general observations:

When I first started in the profession, fifty-nine years ago, IP lawyers—and particularly patent lawyers—occupied the backwaters of the legal profession, typified by *New Yorker* cartoons showing them in green eyeshades, greeting some loony inventors with some Rube Goldberg-type inventions.

An IP revolution has occurred since then, initiated by the formation of the Federal Circuit in 1982. This court brought patent law into the mainstream of the law. So successful were the efforts of the judges of this court to achieve that result that today IP law in general and patent law in particular have become one of the hottest areas of legal practice. While the pre-1982 legal landscape was dominated by boutique IP firms, today many of those firms have been gobbled up by major generalist firms, and there is hardly a major firm that does not have a significant IP practice group. Even the Supreme Court and the White House have gotten into the act. The Supreme Court has developed a particular interest in reviewing decisions of the Federal Circuit; and the White House has appointed an IP czar to coordinate the efforts of the Federal Government to curb IP-piracy and is currently leading an effort to curb patent trolls.

The bottom line is that my fellow IP lawyers and I are now in the mainstream of patent law and can throw away our green eyeshades.

**The Federal Circuit’s Mission to Achieve Predictability & Uniformity: The Current Landscape**

But it’s not enough to be in the mainstream.

As everyone in this audience knows, a fundamental reason for the formation of the Federal Circuit was to provide predictability and uniformity in the national patent jurisprudence. Before the formation of the Federal Circuit, the patent system was not functioning properly since the federal circuit courts harbored widely varying attitudinal views in their interpretation of the patent law, ranging from one extreme in the 8th Circuit—which was totally hostile to patents—to the other extreme in the 5th and 7th Circuits—which were totally hospitable to patents. The end result of this disparity in views was a patent jurisprudence lacking in uniformity and predictability and in
rampant forum-shopping between friendly and hostile circuits by patent owners and accused infringers. This, in turn, created real problems in corporate boardrooms and research departments, which needed predictability to justify the large investment in time and money to support their innovation efforts.

Placing all patent review responsibility in one court was perceived as the solution to this problem, once the aversion to a specialized court was overcome by giving the Federal Circuit diverse jurisdiction. And indeed, immediately on opening its doors, the court set out to achieve this goal. The court in its first opinion adopted the law enunciated by its predecessor courts, the Court of Customs and Patent Appeals (“CCPA”) and the Claims Court, in South Corp. v. United States. The court then proceeded to clear up existing conflicts in the patent law decisions of the federal appellate courts and to develop a body of law that would instruct the bar and the district courts in the proper application of the patent laws. Former Chief Judge Markey reported with pride that “[i]n its first three years . . . [the Federal Circuit] identified and resolved all of the thirteen conflicts in the previous patent law decisions of the regional circuit courts and removed the slogans that for years had barnacled the patent law.” More significantly, in those first few years, the court wrote uncharacteristically long and detailed opinions, which—in full effect—constituted tutorials on sound patent law as the court saw it for the benefit of the lower courts and the bar. The court also rendered a number of en banc decisions, the most notable of which were Markman v. Westview Instruments, Inc., and Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc., all designed to provide uniformity in the law.

In the early days of the Federal Circuit, that worked well; the patent law did become more predictable and litigants before the court had a reasonably good idea, even before they knew the panel, whether they would win or lose. But it was not long before a problem developed. The Supreme Court had paid little attention to the Federal Circuit in the early days, but slowly and surely developed a keen interest in what the Federal Circuit was doing. The problem is that the Supreme Court does not like bright line rules.

To compound the problem, the Supreme Court does not believe that the crisp, clear language of 35 U.S.C. § 101 means what it says, that “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter . . . may obtain a patent therefor, subject to the

---

1 690 F.2d 1368, 1369 (Fed. Cir. 1982).
3 52 F.3d 967, 970, 976, 979 (Fed. Cir. 1995) (en banc).
conditions and requirements of this title.”

Instead, the Supreme Court has engrafted onto these words an exclusionary test: even if an invention falls into one of these categories, it does not pass § 101 muster if it involves an abstract idea, law of nature, or natural phenomena. The end result of the Supreme Court’s abhorrence of bright line rules and the gloss it has placed on § 101’s language has resulted in much uncertainty, not only among the litigants and patent bar, but among the Federal Circuit judges themselves.

Let me provide a couple of examples.

First, in order to provide a pathway through the maze of § 101 Supreme Court holdings, the Federal Circuit came up with a two-part test of § 101 patent eligibility: the “machine-or-transformation” test. In *Bilski v. Kappos*, the Supreme Court held that while this test is “a useful and important clue, an investigative tool, for determining” patent eligibility, it was not an exhaustive or exclusive test.

Second, in order to provide some predictability to the law of § 103 obviousness, the Federal Circuit came up with the Teaching, Suggestion, Motivation (“TSM”) test. In *KSR International Co. v. Teleflex Inc.*, the Supreme Court held that applying the TSM test as a rigid rule governing the obviousness inquiry was incompatible with its precedents.

So, what has the Supreme Court done to replace these bright-line rules? On the § 101 front, the Supreme Court has replaced the machine-or-transformation test with a number of unhelpful guidelines. Thus, the Supreme Court has mandated a search for an “inventive concept” that is sufficient to ensure the patent amounts to “significantly more than” a patent on the ineligible concept.


---

9. Id. at 604.
10. In *re Geiger*, 815 F.2d 686 (Fed. Cir. 1987) (“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.”).
12. Id. at 419.
13. Mayo Collaborative Servs. v. Prometheus Labs., Inc., 132 S. Ct. 1289, 1294 (2012) (“[A] process that focuses upon the use of a natural law also contain other elements or a
ticular technological environment will not suffice.\textsuperscript{14} Nor will adding purely conventional or obvious post-solution activity suffice.\textsuperscript{15}

So, wholly aside from the fact that focusing on an additional “inventive concept” is a backward step from the goal of predictability, it unfortunately conflates the mission of § 101 with the other, patentability-oriented statutory provisions.

Added to this is the extraordinarily difficult task of discerning what constitutes an abstract idea, law of nature, or natural phenomenon, particularly since every invention at some level involves a law of nature or natural phenomenon. And given the \textit{Association for Molecular Pathology v. Myriad Genetics, Inc.}\textsuperscript{16} holding on the lack of patent eligibility of a synthetic, isolated gene sequence, what impact will it have based on the patent eligibility of new life-saving antibiotics and other materials isolated from their natural environments?\textsuperscript{17} And in light of the Supreme Court’s negative comment on obvious post-solution activity, what if the last claimed step of the \textit{Mayo Collaborative Services} \textsuperscript{18} patent claims involved applying the thiopurine drug to a patient rather than ending with a “wherein” clause? Surely that should make the claim patent eligible, but not under a literal interpretation of the Supreme Court’s language in the \textit{Mayo Collaborative Services} case.

As to § 103 obviousness, the Supreme Court has replaced the TSM test with what it characterizes as a “flexible approach,”\textsuperscript{19} but which is calculated to interfere with the Federal Circuit’s mission of bringing uniformity and predictability to IP jurisprudence. Indeed, of particular concern is the Supreme Court’s citation in \textit{KSR International Co. of Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.},\textsuperscript{20} \textit{Anderson’s–Black Rock, Inc. v. Pavement Salvage Co., Inc.},\textsuperscript{21} and \textit{Sakraida v. Ag Pro, Inc.}\textsuperscript{22} combination of elements, sometimes referred to as an inventive concept, sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the natural law itself.” (internal quotation marks omitted) (citations omitted).

\textsuperscript{14} Alice Corp. Pty. Ltd. v. CLS Bank Int’l., 134 S. Ct. 2347, 2352 (2014).
\textsuperscript{15} \textit{Mayo Collaborative Servs.}, 132 S. Ct. at 1294; Bilski v. Kappos, 561 U.S. 593, 609–10 (2010).
\textsuperscript{16} 133 S. Ct. 2107 (2013).
\textsuperscript{17} \textit{Myriad Genetics, Inc.}, 133 S. Ct. at 2119.
\textsuperscript{18} \textit{Mayo Collaborative Servs.}, 132 S. Ct. at 1295.
\textsuperscript{20} 340 U.S. 147, 152–53 (1950) (“A patent for a combination which only unites old elements with no change in their respective functions . . . .”).
\textsuperscript{21} 396 U.S. 57, 60–62 (1969) (finding absence of “synergy” resulting from the combination).
\textsuperscript{22} 425 U.S. 273, 282 (1976) (“[T]his patent simply arranges old elements with each performing the same function it had been known to perform,” and yields no more than one would expect from such an arrangement).
So what can be done about this problem? Federal Circuit judges have no choice but to follow the Supreme Court’s lead as best they can given the Court’s imprecise guidance, but I do have a suggestion. A well-known and highly respected appellate advocate related to me advice he received from a Supreme Court Justice for whom he had just started clerking: do not take as gospel every word in prior Supreme Court opinions; focus on the holdings of those opinions, since all of the Justices signing on to a given holding may not—and often do not—subscribe to every word in that holding. And that advice has been mirrored in comments I have heard from other respected Supreme Court gurus. Following this advice may minimize splintered decisions, such as resulted in *Alice Corp. Pty. Ltd. v. CLS Bank International*.

Beyond that, we in the bar and our fellow IP professors can do our best to write and speak out on the issues, supplemented by amicus briefs when appropriate, to send a message to the Supreme Court that while bright line rules may not be desirable in all fields, they can not only be helpful, but crucial in permitting the Federal Circuit to achieve its mandate of providing uniformity and predictability in patent law. Hopefully, this message will be heard at some point in the not distant future.

**Appellate Advocacy**

In the interim, I would like to turn to a different subject. The title of this afternoon’s program is “The 2014 Daniel M. Friedman Appellate Advocacy Lecture.” Two years ago, then-7th Circuit Chief Judge Easterbrook delivered the first such lecture, which was devoted entirely to his thoughts on effective appellate advocacy, drawing heavily on Judge Friedman’s views, which he had witnessed first-hand when they worked together in the Solicitor General’s Office. His lecture, divided into the three topics of good substance, good exposition, and good presentation, was an excellent one and I commend it to you to it since it is available on the web.

I thought it might be useful for me to use my remaining time to supplement Judge Easterbrook’s thoughts with some of my own, gleaned from arguing over 165 cases before the Federal Circuit and one of its predecessor courts.

I will first deal with the brief, which is the most important element of appellate advocacy since in 80-85% of cases it will be the dispositive factor in whether you win or lose the appeal.

One of the most important decisions one can make in writing a brief is selecting the issues to be raised in the appeal. Ideally, one should raise as few issues as possible consistent with the goal of prevailing on the appeal. Consis-

---

tent with this goal, weak issues should be jettisoned and clients who wrongly object to dropping issues based only on the notion that the dropped issue may well prevail on appeal should be politely advised of the “less-is-more” theory of appellate advocacy.

A case in point is a case I argued, Merck & Co., Inc. v. Biocraft Laboratories, Inc. At the trial level, three principal issues were advanced by Biocraft, two § 103 issues and an inequitable conduct issue. One of the § 103 issues, however, was as close to a § 102 anticipation issue as one could get, and the other two issues were much more complicated and contentious. I successfully urged the client to agree to appeal only on the § 103/§ 102 issue. The result was a successful, 2-to-1 reversal. But of particular relevance was a sentence at the beginning of the majority opinion, confirming the wisdom of the appellate strategy: “[r]efreshingly, Biocraft challenges the judgment of the district court only as to obviousness, and restricts its arguments to the teachings of U.S. Patent No. 3,313,813 (the `813 patent), also assigned to Merck.”

As to the brief itself, while all parts of a brief are important, by far the most important part is the fact section. Some appellate advocates employ relatively short fact sections, just enough to lay out a bare-bones recitation of the relevant facts, leaving the argument section to do the heavy lifting of the necessary advocacy. I prefer a very different approach, where the fact section is the dominant portion of the brief—often encompassing two-thirds or more of the 14,000 word limit for principal briefs—and which not only develops all the equities of the case, but which effectively presents the argument without crossing over the fact/argument line. And how is this accomplished without crossing over the argument line? Very simply, by repeatedly contrasting the lower tribunal’s findings or the adversary’s arguments with a counterpoint (e.g., the district court found “X,” notwithstanding that the evidence supports “Y”; “Party P” argues “A,” notwithstanding “Party P”’s admission that “B,” not “A,” is correct; etc.). If this technique is properly employed, by the time the court has completed reading the fact section, the essence of your case on appeal should be crisply clear. This approach, of course, mandates a streamlined argument section which hits the highlights of the argument, but which relies on the fact section for details.

Beyond these principal points, there are some subsidiary but important points to note about the brief-drafting process. A few examples follow:

27 Id. at 806.
• Do not stretch your arguments on the facts; your credibility will be undermined if you do.
• Make certain that the arguments you are making were made below. Waiver contentions are routinely made and the Federal Circuit has often relied on them to dispose of otherwise worthy contentions.
• Reduce highly technical issues to the level of lay comprehension wherever possible; while a number of Federal Circuit judges have technical degrees, a majority do not.
• Discuss all issues you choose to raise on appeal in your principal brief; failure to do so may result in a holding of abandonment as to those issues.
• Avoid *ad hominem* arguments, both as to the lower tribunal and your adversary; they will only serve to influence the court in your adversary’s favor.
• Proofread, proofread, proofread; another turnoff for the court is a brief riddled with typos and other non-substantive errors.

While oral argument is not as important as the brief, it can in specific cases be the difference between winning and losing. The fifteen minutes allotted for oral argument is a short time and since the appellant has rebuttal, the appellant’s opening is usually no more than twelve minutes. Moreover, most of that time involves responding to questions from the bench, so counsel must be ready to go to any issue the panel wants to discuss and somehow try to stay on track. Beyond that, here are a few pointers to consider in making an oral argument:

• Where there are multiple issues, do not necessarily expect to cover all of them, but be prepared on all.
• Answer questions immediately and directly; do not answer hypos *only with “that’s not this case.”*
• If in preparing for oral argument you have found a weak spot, be prepared to acknowledge it in oral argument, or even waive the issue.
• If challenged on a point by a judge, be prepared to disagree, but with an explanation (e.g., “I disagree, your honor, and let me explain why . . . .”).
• As is the case in briefing, do not engage in *ad hominems*, with respect to your adversary or the lower tribunal.
• Usually avoid the use of visual aids; they often are difficult to see from the bench, can create awkward moments, and the advance notice requirement can assist your adversary more than it will assist you.
• Do not read your argument, though it may be appropriate to read a short, critical quote.
• Do not attribute a prior judicial holding to its author; though an opinion may be authored by a single judge, the opinion is the court’s, not the judge’s, and counsel have been reprimanded in open court for violation of this admonition.
• If you represent the appellee, do not worry about the planned order of your argument; your response and the order of your response are dictated by the appellant’s argument and questions from the bench.

And, as Judge Easterbrook ended his lecture, following John W. Davis’s Rule #10, “When you have made your point, sit down.” And that concludes my lecture.