

Trying patent cases in US federal courts: telling the story behind the technology

Presenting patent cases is as much about how you tell it as what you tell. A compelling well-rehearsed story about the obstacles an inventor has overcome to secure a patent is key to helping a judge and jury comprehend complex technical issues

By **Louis Genevie** and **Daniel Cooper**

In patent infringement cases, the judge or jury is often asked to assess not only whether a disputed invention has been infringed, but also whether it is truly novel. While there are laws in place that govern these issues, the heart of the decision is left to the personal judgement of the judge or jury. This judgement usually revolves around how important a particular change in a molecule, algorithm or electronic circuit really is to the technology at issue. In most cases the assessment involves complicated technology that may never be fully understood, despite the best attempts of counsel to explain it in simple terms. The line that divides new from old and real innovation from the ordinary progression of technology can remain unclear to even the most intelligent jurists. While most will pay attention and learn the technology as best they can, their decision cannot be based firmly on technology that they do not fully understand.

So if not based solely on the technology at issue, how do non-technical fact finders distinguish between a truly novel invention and one that a person of ordinary skills would have found without undue experimentation, given the prior art? We have found that the answer to this question

has profound implications for how cases should be tried before any non-technical judge of the facts, including juries in the United States. So where do jurors and judges look to determine whether a patent has been infringed and whether the patented change in the technology was a mere tweak or a real discovery? In a nutshell, our experience with thousands of jurors and hundreds of judges over the years is that the trier of fact wants to hear the behind-the-scenes story: the who, what, when, and why of the events and people that led to the invention, and any contact between the parties before or after the patent was issued. Cases that are left to be decided on the technology alone fail to recognise the importance and value of context and fairness in shaping the fact finder's perception. The development of the human side of the discovery process – telling the story behind the technology – allows jurors and judges to relate and evaluate the technology from a perspective they understand, a perspective that will ultimately control the outcome of the case at trial.

Every case is a story

Jurors tend to organise material into coherent stories. If the case is not presented as a story, the jurors will create one by filling in gaps in the facts with their own speculation about what happened. Thus, it is important to present your case as a fully integrated and thematically anchored story. Although an understandable technical presentation is essential, jurors, as non-technical fact finders, will tend in their deliberations to focus more on the relationship between the parties and what went on behind the scenes than on the relevant technical issues. The story should thus detail the

relationship between the litigants in a clear manner that supports the conclusion that your client's conduct was fair and just.

The story of the discovery and how it can define an invention's value

How is an effective invention story built? Like any story, it has a beginning, middle and end. It focuses on people facing a difficult challenge; it has tension, suspense and uncertainty flowing from the initial failures and unrewarded hard work that often precede discovery. If the patent is being defended against an invalidity claim, the story has a successful climax – the hard-fought discovery uncovers a solution that is intellectually satisfying and valuable. Of course, if you are defending the case, it is important to negate as many of these positive aspects of the patent as possible. The more you can tell the story of the development of the product or the prior art in the same way – as if it were the invention – the better your chances for success.

Setting the stage

In most patent cases the beginning of the discovery story dates back many years. The world, especially the world of technology, was far different and the challenges and problems – the things that were unknown at the time – often forgotten. To understand the problem and why it was a problem, non-technical triers of fact such as jurors and most judges must be brought back in time. They need some general social and cultural landmarks, as well as a sense of the company and the inventor's working environment. Once transported to the time and place of the discovery effort, they need to understand what the inventor's objective was, what was known and unknown at the time, why the existing solutions were not adequate and who else was at work on the same or similar challenges.

Exploring the options, alternatives and competing theories

Creative endeavours typically do not occur in vacuums. When faced with a problem, a variety of options or alternative approaches usually appear to have promise. The invention story should address the direction in which the science was pointing and why the prior knowledge and work had not yet produced the solution. The law in the United States separates infringement issues from invalidity issues and goes so far as to set different standards of proof for each. However, jurors typically view the two

issues as part of the same story that starts with the prior art and explains why the problem remained and why the answer was not apparent from the knowledge that already existed.

Choosing a creative path

There is an expectation among fact finders that the road to the invention starts with an idea of what might work and why. The path to the invention was not arbitrarily chosen; it was not uncovered by a simple process of trial and error. To be creative, at least in the minds of most non-technical people, the innovation should have been the result of a new idea. Ideally, there was a moment in time when the proverbial light bulb went off in the inventor's head, which can serve as the story's high point. The insight takes the inventor down a new path; in describing this unexplored road it is also useful to describe where everyone else was working in the field? What were the common expectations of reputable scientists? Was there disagreement or criticism of the inventor for his alternative perspective? These are the kind of elements that make for an interesting, compelling and memorable story.

Working towards an answer

One of the indicators that jurors use to measure creativity, innovation and "newness" is the amount of time and the amount of work it took to find the solution. Sometimes when the solution to a problem is found relatively quickly or is perceived as a small change in the existing technology, this becomes the most persuasive evidence to jurors that copying of some sort must have taken place; otherwise, how could something so important have been done so quickly? The more effort, the bigger the problem, the more people the solution helps, the more public acclaim for the discovery, then the more credit the inventor deserves in the eyes of the fact finder, irrespective of the technological details at issue. This is true for both patent holders and accused infringers. There are three inventors who can benefit from this principle:

- Prior art inventors.
- Patent holders.
- Accused infringers.

In the invention story, jurors ask: "Who did the most and whose work was most important?" Many inventors can be quite humble and understate the effort that went into their work. They need to realise that most judges and jurors are trying to

understand an experience that is unknown to them. While an idea may spring forth suddenly, the work of the actual discovery of the technology that makes the idea real needs to reflect the blood, sweat, and tears that accompanied it. Often, the most persuasive proof of the extraordinary nature of the work is found when many excellent scientists were working on the same problem but no one else discovered the solution.

It is important to remember that there is a personal aspect to patent cases. When alleging infringement, the inventor is claiming that his work has been stolen. He needs to explain the value of his work and why it is entitled to protection. The inventor is also, in many cases, being accused of getting credit for something of little value; that is, an obvious or anticipated invention. His integrity as a scientist is being challenged, and his response must reflect his belief in the value of his discovery stated in a strong positive – not defensive – manner. Of course, when defending against a claim of infringement the issues are the same, only they are reversed: the story must show the minimal efforts that went into the patented invention, while telling a compelling tale of the development of the product and respect for the patent system.

Does the difference make a difference?

Describing the process that leads to a new solution of an important problem is critical, but so too is providing the answer to the other central question in every patent case: how and why does the difference make a difference in the performance of the technology? How does the fact finder determine whether the changes in the technology at issue represent a fundamental and unpredictable change or an insubstantial, cosmetic change? To make this determination, most fact finders will look to concrete effects of the change – does the change make the technology ‘better’ in some way? What are the advantages of the change, both in terms of improving or altering the technology and in terms of its real-life benefits? The claimed difference cannot be merely argued or asserted – it must be concrete and it must be taught, not argued. The side that teaches the best has a distinct advantage. Lawyers often speak in terms of “dumbing down” the material; rather, the process is really one of elevating the judge or jurors by finding the right way to help them understand. The best teachers do not blame their students for their own failure to communicate the material in a way that their students can understand and apply.

Developing, re-writing, testing and practising

Developing a story is a challenge and the first draft is rarely the best. The presentation in court, – the story telling – also benefits from practice and feedback. For every story in litigation there is a competing story. Resolving the clash between these stories leads jurors to their ultimate verdict. Your story, then, must be evaluated not only on its own merits but also in relation to the competing story. When the case is important enough this process should be driven by empirical research that identifies the way the fact finder will perceive the particular facts of your case. Such research, whether it be focused on a judge, a jury or both, can be most effective if three essential elements are present:

- Accurate anticipation of the central themes and issues that both sides will present at trial.
- The use of probable mock juries that accurately represent the jury that will hear the case at trial.
- Replication of the process to ensure reliability.

Anticipating the opposition

For jury research to assist in story development, the adversary’s case – in its most difficult, yet realistic configuration – must first be anticipated, written in summary form, and then delivered to several panels of mock jurors, whose responses can then be analysed in detail and used to refine further the story line and central themes.

The use of probable juries

Testing your story before mock judges or jurors who represent the type of audience you are likely to encounter is an important aspect of doing the best work possible in developing your story. Juries that actually hear cases are often highly filtered and, at times, substantially influenced by the *voir dire* process. Their decision making is not likely to be reflected in a random sample of the *venire*. Jury research that uses the random selection of individuals in a venue to create mock panels will often fall short when it comes to making accurate predictions on how a story will resonate with an actual jury. The opportunity to take advantage of counsel’s initial encounter with the jurors in *voir dire* is missing, and the mock panels will probably not reflect the important characteristics of jurors who are likely actually to hear the case. Research juries that result from our patented mock *voir dire*

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programme are much more likely to reflect the jury that will actually hear the case and are therefore more valuable in assessing the story that you plan to present at trial. The de-selection process at the conclusion of *voir dire* results in a Probable Jury™, comprising the first eight or so jurors who were not stricken; and a Stricken Jury™. All jurors, whether stricken or not, return the following day to hear the case and deliberate. This procedure creates unique information. The Probable Jury comprises people who would typically make it onto a jury in a particular case and provide counsel with more accurate information about key case themes and the probability of an adverse verdict than random groups, which are typically used in jury research. The Struck Jury typically comprises the most ardent deliberation leaders on each side, providing a rich source of intense discussion on the issues that help hone the story themes further. In addition, both juries provide a check on decisions made during the de-selection process: who was left on the Probable Jury, who should have been struck and was anyone struck who should not have been? Answers to these questions hone our quantitative jury selection model, which helps us get a jury that will be receptive to the story underlying a particular case.

Replication

Every story benefits from practice and re-working. Great stories and great storytellers are made more often than born, and it is important to give your storytellers – lawyers, inventors and experts – an opportunity to improve. Repetition also allows for the consideration of additional or different variables. For example, different evidence can be introduced to fill gaps or misunderstandings that the judges or jurors expressed in prior research exercises, the effectiveness of graphics can be tested, witnesses examined and assessed, and the tone of the presentation and impact of trial counsel can be tested.

Conclusion

The complexity of technology in patent cases demands that attorneys preparing for trial find communication vehicles that engage jurors. The story of the human struggle of discovery and the resulting competitive clash is just such a teaching tool. Jurors relate to and learn from stories. Stacking fact after fact, as might be presented in a legal brief, provides insufficient context and relevance for jurors. It is in the story of the discovery that jurors connect with the case. This connection

provides the foundation for their assessment of the value of the innovation.

Rather than lament judges' and jurors' lack of technical competency, embrace the opportunity to invite them into the world of the invention. Help them connect with the fascinating story of the enormous obstacles overcome by real people in the struggle for creation and discovery that resulted in a new and valuable innovation. More often than not, so engaged, jurors or judges can and do understand the case issues in their own way. ■

To read more about the importance of Probable Juries™ in predicting the outcome at trial and jury research in general, see our article, "Jury Research and Trial Outcome Prediction", published in the April 2004 edition of For the Defense. This article and the US patent covering this methodology can be found - at: www.LitStrat.com.

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