

LITIGATORS CORNER:

My Top Ten List



BY JOSEPH N. HOSTENY,
OF NIRO, SCAVONE,
HALLER & NIRO

Regular IP Today columnist Joseph N. Hosteny is an intellectual property litigation attorney with the Chicago law firm of Niro, Scavone, Haller & Niro. A Registered Professional Engineer and former Assistant US Attorney, his articles have also appeared in Corporate Counsel Magazine, The Docket (American Corporate Counsel Association), American Medical News, Inventors' Digest, Litigation Magazine and Assembly Engineering Magazine. Listed in Who's Who, Mr. Hosteny was recently named to the Board of Editors of Patent Strategy & Management (a monthly publication of American Lawyer Media), for which he will also be writing periodic guest columns. In addition, an article quoting him appeared in the November, 1999 issue of Entrepreneur Magazine. Mr. Hosteny can be reached at (312) 236-0733, or by e-mail at jhosteny@hosteny.com, or by visiting his web site at <http://www.hosteny.com>.

I think it was Oliver Wendell Holmes who said the life of the law is not logic — it is experience. My take on this is that experience predominates, but that more logic would be very nice to see. Much of my experience consists of observation of quite a few judges, and their behavior in the courtroom. Like lawyers, some judges are great, most try to do their best, and a small handful are very trying. Over the years, I've accumulated my wish list of things I wish judges would — and would not — do, and I'd like to share some of them with you. So, here are ten things I wish judges would do, or do more of. Lest I be thought unfair, this will be followed in the near future by an article about the ten things I imagine judges would like lawyers to do!

(1) Don't tell litigants that you have read their briefs when you have not. In one of our cases, we had briefed whether two cases should be consolidated under the local rules for our district. The plaintiff was the same in each case. In one, the defendant was a manufacturer accused of infringing some patents. In the other, the defendant bought the

first defendant's product, and did more processing, thus leading to an accusation of infringement of the same patents.

After carefully briefing the issue, we all appeared for oral argument. Our judge came out and said, "I've read your briefs, but tell me what this case is about." The discussion that followed made it clear that he was "blowing smoke," and had not read our briefs at all. Because the judge was afraid to admit that he hadn't read our briefs, the oral argument was distorted and largely useless, and the snap decision the judge made at the argument deserved little respect. The lesson: don't tell the litigants that the dog ate your homework. No one believes it. I've seen some judges say that they have not been able to read the papers, and apologize for it. That is graceful, and certainly commands my respect. It also tells the litigants what points they need to pay particular attention to in presenting their positions.

(2) Avoid the "Biden Shuffle." The so-called Biden report is the semi-annual report required by the Civil Justice Reform Act of 1990. The report must identify any motions pending for more than six months, and any case pending for more than three years. 28 U.S.C. § 476. In our district (and perhaps others, as well), there is an entry to indicate whether a status hearing has been recently held in a case. I call it a "Look, Ma! I'm busy!" excuse. Both the defendants' counsel and I were directed to appear for a status hearing before one of our judges in August or September of one year, shortly before the September 30 deadline for the semi-annual report. We dutifully trooped in, some of us from out of town. Our judge asked, "What are you doing here?" One of us said, "Well, your honor, you set the case for a status hearing." The judge said, "Oh. Well, this case is taking up too much of my time." We made some conciliatory noises. The judge said, "Thank you. Next case." After we left, I figured it out. The case had been set for a status, just so someone could check off the status hearing box on a form.

In another of our cases, a judge dismissed a motion right before the September 30 deadline on a minor, rather hypertechnical point, with leave to reinstate the motion. The motion was refiled a week or two later, but was off the docket long enough to avoid being listed as a motion more than six months old.

Lawyers know the kinds of workloads judges have, that patent cases are messy, and

that the great majority of judges are doing everything they reasonably can. We don't like delay, but we understand why it occurs and can face the reality. Pulling stunts like the "Biden Shuffle," to reduce the number of matters listed on a Biden report, doesn't increase a lawyer's respect for a court.

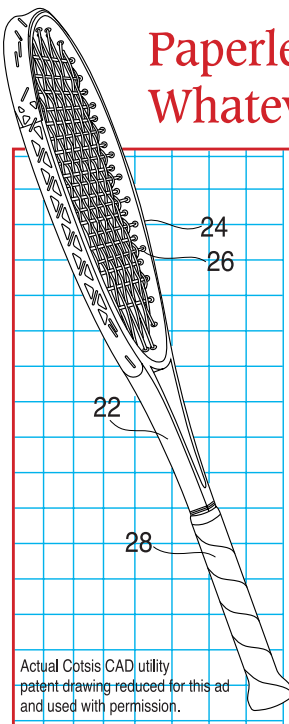
(3) Require notice for any matter that is discussed in court. Our system operates on the theory that the party is supposed to be advised in advance about the subject matter of a motion, because our rules require service in advance and an opportunity to respond. Yet I have often seen an opposing party raise a new matter, mis-describing it as "housekeeping." When I hear that word, I know I am about to be stabbed with an entirely new and potentially important issue. One of our magistrates repeatedly fell for it in a case that was much too complicated for decisions to be made without notice, and therefore without any chance to prepare. The result was a mess. One of the finest judges who presided in our district was Prentice Marshall. One day, a litigant raised a "housekeeping" matter. Judge Marshall said, "I only rule on what is before me." Music to my ears. Over the long term, following the rules leads to a greater chance of just results.

(4) Enforce courtroom etiquette. In our high school debates, when we had a proposition to argue about, the proponent went first, the adversary responded, and the proponent replied. Interrupting each other was frowned upon. Too many judges let arguments turn into a free-for-all. Why can't adults follow a set of rules similar to those high school students are required to — and do — observe?

(5) Stop requiring lawyer affidavits. Many courts, frustrated with quarrels between litigants, require affidavits or declarations from lawyers concerning various issues. Two such uses are to authenticate exhibits, and to describe efforts to resolve discovery differences. These are a bad idea. First, lawyers are already subject to the power of the court; contempt doesn't require a sworn statement as a predicate. Second, these affidavits lead to credibility contests between lawyers, which puts a court in the position of deciding which lawyer to believe. The lawyers should be lawyers, and the witnesses should be witnesses. The lawyer-advocate should not become a witness.

(6) Use written orders. A magistrate in one of our patent cases would never issue a written order, nor would he require the prevailing party to submit an order. The orders, which our adversary accused us of violating every time it filed a motion or response, were purely oral. There often was no transcript, since proceedings before magistrates in our

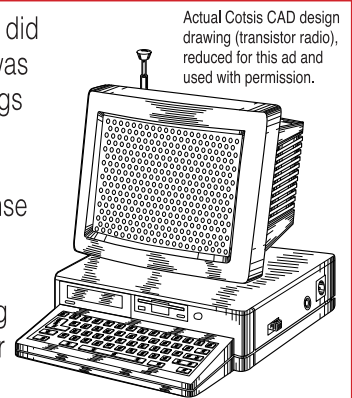
Paperless Patent Drawings, Computerized Patent Drafting... Whatever you call it: we've been in this racket for ten years.



When we started Cotsis CAD in 1991, we would tell patent attorneys that we did all of our drawings on a computer, and some of them clearly thought that was a strange idea. But we knew that we could use computers to create drawings with the artistic style of a good pen and ink draftsman. We've been doing exactly that ever since: accurate, fast turnaround (no rush charges), reasonable rates (we still average under \$80 per sheet) and prompt response on revisions. Our clients (from Fortune 100 firms to solo patent attorneys) have rewarded us with rapid growth. Personal attention to our customers remains our top priority. Ten years later, it seems as if most patent drafting services have finally discovered the advantages of computers. Maybe our idea wasn't so strange after all. **Call for a free brochure or price quote.**

- Design and Utility Patent Drawings
- Secure Drawing Transmission via email (password protected.pdf)
- High Resolution Digital Photography

CotsisCAD
Digital Patent Illustration and Photography
845.469.9594 Fax: 845.469.5201
<http://www.patentcad.com>



- Trademark Drawings
- We can access most digital files: Word, Power Point, AutoCad, Jpeg, etc.

district are normally only tape-recorded. Figuring out an order required depending on memory and scribbled notes. It is not possible even for well-intentioned adversaries to decide what the order is under such circumstances. When one of the parties decides to be manipulative, even more trouble results.

Some districts require submission of a proposed order as part of a motion or a response. This probably isn't worthwhile because the two versions merely track the parties' briefs, and most discovery motions are resolved somewhere in the middle.

The best solution is an order dictated on the record at the conclusion of the argument. The second-best solution is an order drafted by the parties and submitted to the court after the argument.

(7) Don't require pre-motion letters. Some districts have local rules requiring that motions be preceded by a letter or letters. This may be a joint letter, including the views of both plaintiff and defendant, or separate letters from each of the parties. In other districts, this procedure is used by individual judges. The idea behind the practice is to head off discovery disputes at the pass, before things reach the complexity of a motion under Rule 37 of the Federal Rules of Civil Procedure. The intention is good, but all I have seen result from this practice is that a party that refuses to provide legitimate discovery now has another tool to use as an obstacle. In one of our cases, we conferred with the opposing party to try to get the discovery we needed. That failed. Then we filed a motion to compel discovery. Our district judge then assigned the motion to a magis-

trate who employed the letter procedure. Our motion was for naught. Next, we had to draft a joint letter giving the views of the parties. We drafted the letter and sent it to the defendants for their inserts. They added their material. Their additions raised the need for further comments from us. Then we sent the draft letter back to the defendants for review. They wanted to add more comments. And so on and so on.

The movant has the burden, and should have a chance to present its argument clearly and simply. But the joint letter procedure was a mish-mash, particularly when the defendants used it as a means of presenting extraneous issues and complaints. They weren't there so much for their merit; the real purpose was to obscure the reason we wrote the letter in the first place, and bog the magistrate down in complexity.

Like most documents written by committee, these joint letters are usually turgid, confusing, and bloated. Add to that the fact that the members of the committee are at war with each other, and joint letters get even worse.

Of course, there is one advantage in a letter procedure. It isn't a motion, and evades being listed on a Biden report. That, however, isn't good for anyone.

(8) Make accurate docket entries. In one lengthy case, we decided to resolve a pending motion by an agreement to produce some materials we believed were irrelevant. We so advised the court. Nevertheless, the docket entry reflected that a motion to compel was granted; it should have stated that the motion was mooted or resolved by agreement. Our adversary deliberately used this and

other inaccurate docket entries later to argue that the court had to force us to provide discovery, and that our client was continuing to be contemptuous of the court and the law.

(9) Have a little heart when scheduling. Courts are under pressure to resolve matters in a timely manner. But forcing litigants to respond to twenty-one motions *in limine* on the Monday after Thanksgiving in a case with no trial date is harsh. So is requiring a party to participate in a hearing or trial or meeting virtually on top of Christmas or Thanksgiving, or stepping on someone's vacation. There are times when this has to be done, and I have seen judges who are very considerate on this score. Others, unhappily, do not seem to care about the hardship they inflict. I would like to see a return to earlier practices, where some parts of the calendar are off-limits for hearings and trials.

(10) Make oral argument useful. Oral argument isn't always necessary. But, when it is held, make it useful. One practice I like is when a judge tells me at the outset what his or her thinking is. That way, I can tune my argument a bit to address points that trouble the court. Second, I like to have a chance to make my pitch as I see fit, within reasonable time limits. Too many oral arguments break down because too many questions are asked, and because the argument turns into a free for all.

These are just a few of the ideas I have, based on my experience. I am sure you have more. My next article will turn the table, and I will forecast the ten things that I believe judges would like lawyers to do – or to avoid. **IPT**