

# LITIGATORS CORNER: About Summary Judgments



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There is a substantial belief among lawyers and judges that the layperson is not competent to understand a patent case. People can design computers, fly airplanes, transplant hearts, build roads, erect skyscrapers, teach children, run rapids, scale mountains, launch rockets, establish space stations, navigate ships, write plays, operate the internet, ride bicycles, understand DNA, load cargo, catch terrorists, drive cars and trucks, sculpt statues, wire a house, plant a field of corn, run a marathon, raft a river, herd cattle, run a telephone company, repair a jet engine, mine coal, pump oil from under the sea, dam a river, find a polio vaccine, defeat small pox, bake bread, divine the structure of the atom, pay taxes, invent DVDs, lay a wall of bricks, train horses, sail the Pacific Ocean in an open boat, refine iron ore, weave cloth, photograph the other side of the moon, put a robot on Mars, set a broken bone, catch a trout, orbit a satellite, paint a

portrait, walk a straight line, compose a song, and, well, you get it.

Yet we lawyers think of ourselves as special, and condescendingly believe that ordinary humans are incapable of understanding the law. The hubris of lawyers is remarkable. We see examples of human skill and intelligence every day, but we still think that the ordinary person is too dumb to figure out what we lawyers can understand because of our education and special intelligence.

This supercilious attitude manifests itself in one particular way that I would like to discuss in this column. These days, patent cases are thought to be suitable for disposition by summary judgment, where the disposition tends to be anything but simple or summary. When I started as a lawyer, the common conception was that summary judgment motions were not very useful in patent lawsuits. The reason was that the subject matter was sometimes too complicated for "summary" disposition. The questions of obviousness, and of understanding the technology at hand, were thought to make summary judgments unreliable, because they would be based on incomplete understanding. I dug up a few old cases that depict this view of things. *Safe Flight Instrument Corp. v. McDonnell-Douglas Corp.*, 482 F.2d 1086 (9th Cir. 1973) ("The district court did not deny the motion because it was convinced that the motion was without merit, but because the issue presented was so complicated the court did not wish to dispose of it on a motion for partial summary judgment. In effect, the denial was without prejudice. Under the circumstances we believe this was a judicious way to deal with the matter."); *C-Thru Products, Inc. v. Uniflex, Inc.*, 397 F.2d 952 (2d Cir. 1968) ("A summary judgment disposition was appropriate because plaintiffs' counsel agreed that there were no facts in dispute, and the prior art and patent claims were not complex."); and *Freeman v. Hammond Corp.*, 464 F. Supp. 404 (N.D. Ill. 1987) ("We do not know the 'ordinary level of skill' of such a hypothetical person, especially in the complex field of design and improvement of

sophisticated electronic organs. Nor are we permitted to speculate as to what this person's solution to the problem might be. This factual issue must be explored at trial, where the finder of fact will be able to observe and assess the credibility of expert testimony.").

But the old view was dealt a blow in 1984 by *Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd.*, 731 F.2d 831 (Fed. Cir. 1984) ("*Barmag* asserts that patent cases generally are inappropriate for summary judgment disposition. We disagree. Summary judgment is as appropriate in a patent case as in any other."). So, since 1984, summary judgment motions are regularly entertained, and my impression is that they are granted with increasing frequency, comfortable in the mistaken notion that lawyers and judges can figure out the right answer, where laypersons cannot. But, if we were right, and the answers were so clear-cut, there would not be so many reversals on appeal. After all, even claim construction is supposed to be simple enough not to require, in the ordinary course, testimony or special expertise. The court can read and interpret the patent like any other legal document. That is what the Supreme Court told us in *Markman*.

The notion is that patent cases, when analyzed by legal experts, do not require any trial in front of a jury composed of unknowledgeable laypersons, who would probably err, anyway. Any disputed facts aren't material (and sometimes real disputed facts are analyzed into non-existence). But, if it were true that the experts can understand the issues, we would not have the reversal rate that we do on claim construction rulings. After all, claim construction rulings do not — at least in theory — involve any factual issues at all. They should therefore be the simplest sort of summary judgment motions to deal with in a patent case. As a result, legal skill should shine through, and the quality and reliability of the decisions should be quite high. Nevertheless, according to what I have read, the reversal rate still approaches one out of two.

In my view, the use of summary judgments has been encouraged by other factors. One is the increased pressure to dispose of additional cases that have resulted from legislation enacted in the past twenty years. There are simply lots of cases

that weren't there when the when the Safe Flight, C-Thru and Freeman decisions were written. Any case that can be disposed of without a trial is one more case that won't require days of trial time, or rulings on scads of pretrial issues, or the need to rule on post-trial motions. And, of all the cases judges would like to be rid of, patent cases seem to be among the highest on their list. The reasons are not hard to see: these cases are messy and complicated. Decisions in recent years about the doctrine of equivalents have made them more complicated. The temptation to dispose of a patent case (or any other complicated case) by granting summary judgment is stronger than ever. Even if the decision is reversed on appeal, I imagine that the trial judge figures that at least he won't have wasted time going through a trial, only to be told that the trial has to be done again. We have gone from being leery of summary judgments because of the chances of error, to a rather enthusiastic use of such motions, even though the sources of potential error certainly haven't decreased. On the contrary, they have probably increased. We are jeopardizing intellectual property.

The heap of paper is getting humongous, too. Many courts, like our Northern District of Illinois, have adopted local rules concerning summary judgment motions, too. The pertinent rule here is LR 56.1. Such rules typically require a list of the material facts which the summary judgment movant regards as undisputed, and a responsive list of material, disputed facts from the non-movant. The rules are aimed at getting specificity about the undisputed facts and the citations to the evidence that shows they are undisputed. The goal, I gather, is to make it unnecessary for the court to scour the record for evidence. I find reading these statements to be stultifying; it's like watching a PowerPoint program, but without the pictures. The findings rehash the brief, and are often argumentative.

These statements can be misleading in their own way, too. Several years ago, we responded to a proposed undisputed fact that a method was not infringed because there was no extrusion at a certain point in the accused process. We said that the proposed finding was true but irrelevant; the extrusion occurred elsewhere in the process. In other words, we were honest. But the court's decision, granting summary



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judgment against our client, erroneously used the finding against us. "Deny everything" is the lesson some will learn from that. The proposed findings hampered the court's understanding of both the invention and the accused process.

Just one more war story, which I hope illustrates my points. In one of our recent cases, the judge appointed a legal advisor who was very experienced in patent law. The case involved more than a dozen patents, and the court selected six of them for accelerated discovery and trial. Two of the six were resolved informally, leaving four in the accelerated phase. The parties fired off salvos of summary judgment motions, accompanied by memoranda, responses, replies, a sur-reply here and there, and reams of other documents: declarations of experts, deposition testimony, interrogatory responses, and statements of undisputed facts, disputed facts, responses to undisputed facts, responses to disputed facts, and more replies.

One of the statements of supposedly undisputed facts attributed to one prosecuting attorney the testimony of another attorney who had not prosecuted the application in question. Even worse, the brief then distorted that testimony, both as to its author and its import. We dutifully pointed out the errors in our response to the statement of undisputed facts. But the court adopted our opponent's position, concluding that inequitable conduct had occurred, and granting summary judgment to that effect.

Fortunately, we were able to get the decision vacated on a motion for reconsideration. But the jumble of paper on the original motion probably helped obscure the error. One of the most respected judges of the Northern District of Illinois, Hubert Will, would often say, "You can file a brief of

whatever length you want, but I have to tell you, I begin to lose interest after fifteen pages or so." He was right; the complex briefs and fact statements associated with summary judgments these days may hurt more than they help. I would prefer a brief brief, with good citations, presenting a lucid argument, using sentences, paragraphs, and good grammar. The local rules I have described simply allowed our adversary to repeat its balderdash.

This error also occurred, despite the fact that the people involved were all legally trained — the parties' lawyers, the judge, and the legal advisor. Would a layperson have made the same mistake after hearing the testimony at trial? I doubt it. Most likely the court and the legal advisor would have understood it correctly, too. The lengthy paper record and legal training were not enough to protect against the error.

Perhaps I am looking at the past through rose-colored glasses. But I would like to see a return to the idea that summary judgment motions should be simple, should be presented in a cogent brief with good citations, and should be denied, not only when there are disputed issues of material facts, but also when the appropriate relief is not clear — for example, because of the potential lack of understanding of the technology. *Chore-Time Equipment v. Cumberland Corp.*, 713 F.2d 774, 778 (Fed.Cir. 1983) ("Many, if not most, suits for patent infringement give rise to numerous and complex fact issues, rendering those suits inappropriate for summary disposition."). Admitting uncertainty shouldn't be a sin. Nor should trusting a jury. **IPIT**