

2013 Patent Colloquium: Patent Advocacy Panel
by CILP

The first panel in the Second Annual University of Toronto Patent Colloquium was on Patent Advocacy. The panel was chaired by [Chief Justice Paul Crampton of Federal Court of Canada](#). The 4 panelists included: [Judge Kathleen O'Malley, US Federal Circuit](#); [Harry Marcus, LockeLord LLP](#); [Andrew Bernstein, Torys](#); and [Mark Davis, Heenan Blaikie \(now at Belmore Neidrauer\)](#).

Judge O'Malley started her comments by talking about importance of giving trial judges hands-on management regarding patent cases. Judge O'Malley mentioned three methods that the US courts have been using to reach such a goal. First, trial judges should be directed towards an understanding that no two cases are the same. Second, hands-on involvement of trial judges should be encouraged. Lastly, tutorials should be provided to trial judges and a record of that should be made.

When it comes to settlement the Judges said that first question that the trial judges should ask is what impact would the settlement have on the case. For instance judges should ask whether the settlement silence the main issue in the case, while it is something that needs to be litigated? Also, trial judges should consider the amount of discovery that is necessary to have and should find out whether there is a need for further discovery. But as how long the length of the trial is important it would not be unusual for a trial judge to say that this trial should not take more than 3 weeks.

Judge O'Malley also talked about selection of juries for patent trial. On the issue of selection of juries, it is important to consider cultural norms and take them into account. For instance if the general perception of patent infringement in one region is theft or robbery, then selection of jury from that region might change the outcome of the case.

Judge O'Malley also extensively talked about using electrical proceedings and advanced technologies for patent trials. She was a strong advocate for such a use and based her reasoning on studies confirming that people retain 1/3 of what they hear, but 2/3 of what they see and hear. Such a use would be beneficiary as both the judge and also the jury try to understand each case. She mentioned that in all courts in the US except where a judge completely refuses the use of the electronic equipment, there is equipment in all courts.

Judge O'Malley mentioned that use of electronic equipments can reduce the length of trial by 50-60% and it will also reduce the trial's complexity. The other benefit of the use of electronic equipments in trials is that parties do not need to repeat the same story to jurors a number of times. A party's case would be more effectively communicated when they use such equipments and jurors feedback supports this claims. That being said, there has to be supervision by the trial judge on how the equipment is being used.

She also talked about the advantages of electronic filing and benefits that such a filing might provide. Such a filing let the judge to see all documents electronically and can be very helpful in multi-district cases. Electronic filing would also be very supportive of smaller practitioners, as their resources and opportunities are limited and such a filing would work as an equalizer.

Harry Marcus

Mr. Marcus talked about the importance of defining the claim before trial in the US system and also the importance of claimant's active participation in the case and educating judges and juries. He also talked about his support of shorter trial process and why he thinks the shorter the trial, the more the chance that parties would stick to their best arguments and therefore the trial would be more effective.

On the issue of use of more extensive use of electronic equipment in trial of patent cases, Mr. Marcus was a supporter of the proposal, however, he indicated that a proper use of the equipment need major cooperation between bar and bench.

Mr. Marcus acknowledged the fact that in pharmaceutical cases there is a great amount of money at stake. But he mentioned that that fact does not mean that every issue in the case has to be litigated. He argued that it is the ethical responsibility of a lawyer to put his strongest arguments for issues that should be tried and refrain from trying each issue regardless of their weight.

Andrew Bernstein

In terms of setting limits for the duration of trials Mr. Bernstein argued that there is a general consensus in Canada that the bar is ready for accepting such limits. That being said, there has to be involvement of judges in the process as well. In other words there has to be a clear leadership by the bench to help this limits be created. The issue of timing of the trial is also important when one party does not reside in Canada. For instance, when the patent holder is not in Canada, s/he has to be given enough time to prepare the logistics for trial.

Mr. Bernstein was in favor of using electronic equipment in patent trials, however mentioned that there exists a learning curve. He talked about the importance of getting federal government invest in such new equipment and this is the job of the bar to convince the federal government that such an investment is worthy and important. He also mentioned that there might be some resistance at the beginning within lawyers, because they might not know how to use the technology or what benefits it has, but a positive push by the bench can make this happen.

Regarding pharmaceutical trials, Mr. Bernstein was of the idea that not every issue should be trial. He mentioned that because of the amount of money at stake the client might insist that every issue should be tried, but it is the responsibility of lawyers to resist such pressure of their clients.

Mark Davis

Mr. Davis agreed that there has to be a limit on the trial time, but at the same time warned that so many times the amount of time required to accomplish legal tasks are being underestimated. Therefore, the rules that are externally imposed on the bench, though practitioners might have to adopt to, might not be very useful and it might jeopardize the quality of their work from some important aspects.

If there is a willingness for getting to trial as quickly as possible and saving on time and energy, there must not be any interruption in the process. Mr. Davis emphasized the importance of the appropriate standard of review on further encouragement or discouragement of such interruptions.

On the issue of using electronic equipment, Mr. Davis mentioned that if such a use would help presenting the case and facilitates understanding of the case, it should be seriously considered.

As for the pharmaceutical trials and whether each issue has to be tried Mr. Davis agreed with other panelists but also mentioned that there has to be consistency from court in this regards as well. He emphasized that the more consistency the courts show, the less willingness for interlocutory fights. Obviously no client wants to be disadvantaged by losing the chance to try an issue in its case, but when they see that such consistency exists, there can be more easily satisfied to rely solely on important issues in the case and dismiss those that are less relevant.