

EFFECTIVE APPELLATE PRACTICE BEFORE THE FEDERAL CIRCUIT

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Like our sister appellate courts, we are a “court of errors.” We do not re-try cases. Our charge is to review proceedings in the courts and administrative agencies over which we have appellate jurisdiction and to correct errors that affect the outcome of those proceedings. Our ability to do that effectively and efficiently depends in large measure on how well the members of the practicing bar bring the errors to our attention for adjudication. To assist the bar in this task, I make the following observations and offer a few suggestions on what I have learned about effective appellate practice from the briefs I have read and the arguments I have heard as a member of the Federal Circuit bench.

THE APPELLATE PROCESS

I can recall many casual conversations among my colleagues when I was in private practice about the level of preparation of Federal Circuit judges. I think it is fair to say that Federal Circuit judges got high marks for being fairly well prepared, with one judge or another occasionally recognized as being somewhat better or lesser prepared than the others. But no one really knew how or to what extent the judges prepared for oral argument. All we knew was that some seemed to know more and to ask more questions than others. And after all, the decisions did not come out for months after the hearing, so the thinking was that the judges had lots of time to study the record in due course. Let me peel back the first layer of secrecy and reveal the fact that all judges of the Federal Circuit come to court not only fully prepared for the hearing, but fully prepared to decide the case. That is because each argued case is in fact decided – at least by straw vote – immediately following the oral argument.

Six weeks before the week of scheduled oral argument, two sets of briefs are distributed to each judge on the panel. One set is for the judge and one is for the judge’s law clerks. As do my colleagues, I read all of the briefs in all of the cases assigned to me. I usually do not have time to read all of the appendices, but I do review those things in the record that I perceive from the briefs to be significant to the merits of the case. The law clerk assigned to each case also reads the briefs as well as the entire appendix in each case. I have my law clerks prepare a bench memo for each argued case. The bench memo identifies the issues, states the applicable standards of review, and summarizes the positions of the parties. Issues of first impression or areas of possible conflict or uncertainty in our precedent are flagged. I also ask my clerks to identify arguments in the briefs that are not supported on the record or where the advocacy of counsel may have put more spin on an issue that is warranted.

Usually the week before the argument, I meet with all of my law clerks and we go over each case. We critically test each side’s position and consider any policy issues that might be implicated by the case. Issues that we do not believe have been

fully briefed are researched, cases are read, and a preliminary sense of how the case should be decided begins to emerge. But usually we are left with a number of unanswered questions for consideration at oral argument.

The judges normally do not meet or discuss the cases before oral argument. Each judge prepares independently for the oral arguments. The first time the judges discuss the case is at a conference that takes place immediately after the oral arguments for that session are concluded. At that conference, which is attended only by the judges, each judge, in reverse order of seniority, expresses his or her views of the case. Following the discussion, a straw vote is taken as to how the case should be decided. If no further discussion is warranted, the senior judge in the majority makes the authoring assignment and the conference is concluded.

The briefs thus play a primary role in framing the issues for review, and the judges come to the oral argument prepared to decide the cases before them based on the briefs. It is against that backdrop that oral argument takes place. At oral argument, counsel is addressing an informed audience looking for answers to questions that remain in their minds and seeking confirmation or clarification of whatever preliminary views they bring to the hearing based on the arguments presented in the briefs.

THE BRIEFS

There is wisdom in taking a few moments after suffering a loss at trial to reflect on what happened to cause that loss before filing an appeal. It is important to recognize that at the moment of that loss, your position will have changed dramatically—with the court, with the client, and with your colleagues. The client's loss will be perceived by many to be your loss, and your changed position will color your initial assessment of the grounds for appeal and will cloud your judgment.

If you do not take the time to carefully reflect on why the case was lost, emphasis may be placed on the wrong errors, errors that ultimately will not be dispositive or are not likely to carry the day under the applicable standard of appellate review. There is also the risk that, in an effort perhaps driven in part by a need to be vindicated, you may generate such a long list of errors that the few strong ones get lost amidst the multitude of weak ones. Therefore, it is of paramount importance before putting pen to paper that you step back, critically assess what happened at the trial, and objectively evaluate possible grounds for appeal, selecting for appeal only those issues that realistically and objectively stand a chance to succeed.

The briefs are where you really must shine. Oral argument gives you the opportunity to drive home your case, but the briefs must and should contain all of the tools we will need to find in your favor. There are lots of suggestions one can make on how best to write a brief. The following points are those I consider to be particularly important.

First, I reiterate: select only the errors that count. A long laundry list of errors suggests a shotgun approach, taken with the hope that some target will get hit. All of the judges on our court admire and respect the skilled and scholarly work of the trial judges and administrative law judges who preside over the cases that come before us for review. To contend that the trial judge made a multitude of errors risks

a serious loss of credibility right at the outset. Be selective and let go of the arguments that are of marginal importance.

Be concise and avoid using footnotes. Using the full word count permitted by the rules will not, in and of itself, increase your chances of success. In fact, the opposite may be true. We have a lot to read and you will score points if you get right to the point and just stop. Substantive footnotes force the reader to interrupt his or her train of thought. If it's important enough to say, put it in the body of the text. If it's not that important, leave it out.

Appellant has the burden to convince us that an error has been committed. Help us find it. Point to the record and cite the applicable precedent. Put the real gems from the record right into the brief not just in the appendix. That assures that the judge and not only the law clerk will read them.

State the facts with clarity and be absolutely true to the record. Do not overstate your case. Do not misstate precedent or take snippets of prior cases out of context. It won't work. Some may challenge me on this, but we do understand our own precedent.

Frequent use of colorful adjectives and adverbs do not make an argument more effective. Words like "clearly," "patently," and "undoubtedly" suggest that what follows is the *ipse dixit* of the writer and not really the compelling conclusion the writer would like us to reach.

Do not get bogged down in drafting the "statement of issues presented." I seldom find it very helpful. You may think it very creative and even more compelling to frame a question like: "Was the appellant denied a fair trial when the district court time after time repeatedly and unfairly ruled against the appellant on every substantive motion?" But that type of question does not really add much. Effective "issues present" should have a factual component, a legal component, and a standard of review component.

Recognize the applicable standard of review and factor that into your presentation of the issues. If you read our opinions, you will see that in each case we set forth the standards of review right at the outset and measure the arguments of the parties and our analysis against those standards.

Do not make *ad hominem* attacks or attribute motive to your adversary. Nothing irritates me more than an argument framed like this: "Apparently convinced of the weakness of his position, my adversary has chosen to ignore the record and mislead the court." That sort of characterization adds nothing positive to your case.

THE ARGUMENT

Oral argument has been characterized by one of my colleagues, Senior Judge Daniel Friedman, as "the capstone of the appellate process." As he put it, "all that has gone before comes to a head in a brief period of spoken exposition and exploration." This is when the court can question counsel and test the positions articulated in the briefs. It is the first time the parties have to face up to each other's positions, and it is decision time for the court.

There is an old adage that goes something like this: "If you don't know where you are going, you will go nowhere." This is very true when it comes to oral argument. Many advocates know what they are not supposed to do, but they are not

always clear in their minds as to what their objectives are at oral argument. They know, for example, that they are not supposed to repeat what is in the brief, so they try to repeat the same things in different words. But that is not what the oral argument is all about.

While the briefs should give the court all the tools it needs to decide the case in your favor, the oral argument should make the court want to decide the case that way. In your argument, you should not repeat the briefs but should instead focus on the critical points in your case and expound on them in a compelling and concise way. You also should provide clear answers to any questions the court raises.

How to get ready? The three most important things you need to do to prepare for oral arguments are read the record, read the record, and read the record again. Read every case cited in each of the briefs at least twice. Read every page of the briefs. Read every page of the appendix. Go over the main points of your argument and frame your exposition to explain concisely in one or two sentences the key reasons the court should find in your client's favor. The words should be simple and the concepts understandable.

Write out the first minute of your argument. This is when you will be most nervous, and having a script will help you break through the nerves. It is important to get your key points out early, since you may only get a few seconds into your argument before the questions start. I tend not to be overly aggressive in my questioning so I at least wait until counsel finishes stating who he or she is and which party he or she represents.

Prepare not only the opening minute of your argument, but a crisp, closing statement that you should save for the close of your rebuttal. Start strong on the merits and end strong on the merits.

Do a dry run before a few experienced colleagues and have them test you with the tough questions they anticipate the court will ask. It is not necessary to enlist someone to play opposing counsel, because the oral argument is not a contest between advocates. It is an opportunity for each advocate to reinforce the key positions he or she contends are controlling and to answer the questions on the minds of the judges hearing the case.

To be effective, the dry run requires that the mock judges do more than just show up and shoot questions from the hip. Well before the mock hearing, they must study the record, identify the questions left unanswered by the briefs, identify holes in precedent relied on for support, identify policy issues which may be implicated by the appeal, and draft every tough question they anticipate from the court.

At the argument, when a question is asked, answer crisply, and directly. Do not offer to come back to it later. If a judge asks where the record supports a proposition being asserted, be prepared to go right to the page and line of the appendix. The judges always have the entire record before them at the bench but generally do not take the briefs and appendices back to the conference room during the time the case is discussed and decided. That means if you are only able to say something like, "the document can be found in plaintiff's submissions in the appendix," there is a risk that it will not be found before the straw vote is taken.

If you are the appellant, it is generally a good idea to reserve time for rebuttal. That will give you the last word and keeps your adversary honest. But do recognize that it does come at a price. Once you get back on your feet, you open yourself up to more questions and risk saying something that does more harm than good. My

colleague, Senior Judge Jay Plager, likes to say to appellant's counsel when it comes time for rebuttal, "Counsel, did you hear anything in your opponent's argument that gives you any pause or warrants any comment?" Senior Judge Plager's inquiry is not just a polite way of inviting appellant's counsel back to the lectern, but is sound advice worth taking to heart.

TEN POINTS TO REMEMBER

In closing, here are ten points I consider critical to successful appellate practice before the Federal Circuit:

1. Pursue only the issues most likely to succeed.
2. Be mindful of the applicable standard of review.
3. Be absolutely true to the record and straightforward with the court in both your briefs and at oral argument.
4. Be concise and do not use substantive footnotes.
5. Identify the errors the court must correct.
6. Open strong and end strong.
7. Know the record and the relevant precedent, and come to the oral argument prepared to give direct and specific answers to the judges' questions.
8. Prepare to respond convincingly and persuasively to your adversary's strong points.
9. Avoid *ad hominem* attacks and do not attribute motive to others.
10. Use demonstrative materials sparingly at the oral argument.

If you come to our court prepared and with a clear sense of what you want to accomplish, following the points outlined in this paper, I can assure you that you will be amply rewarded—if not with victory for you client, at least with the gratification of knowing that you will have served your client's interests well.



THE GENETIC AGE: WHO OWNS THE GENOME?
*A SYMPOSIUM ON INTELLECTUAL PROPERTY AND THE HUMAN
GENOME*

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