BIOTECHNOLOGY IN THE COURTROOM

By Thomas H. Jenkins

I am always a bit daunted when asked to comment on biotechnology patent litigation because people expect me to say something unique about biotechnology patents and about how litigation is conducted in biotechnology cases. Generally speaking, however, biotechnology patent cases are like any other patent litigation. They are unique in that they are often very complex, even compared to other types of patent cases. This complexity affects not only the presentation of the case, but also the strategy of the case, particularly in jury trials.

We are now seeing more and more jury trials in biotechnology cases. In part this is because attorneys who litigate patents have learned that juries have a strong bias in favor of patents. The reasons for this bias are not entirely clear. In this time of great skepticism about the performance of the federal government, one would think that a jury would have a healthy dose of skepticism about the Patent Office and the patents it issues, but that is usually not the case. Instead, it is difficult to prove that a patent is invalid before a jury. Juries relate well to inventors, and they react positively to the concept of rewarding innovation.

Given the pro-patent viewpoint of most juries, patent owners should give serious consideration to requesting a jury, even though the case involves complex subject matter and will be difficult for the jury to understand. If you are the accused patent infringer and faced with a jury, well that's the real challenge in patent litigation these days.

In deciding how to present a complex biotechnology case, you should put yourself in the shoes of the fact finder--consider how the judge or the jury will try to decide the case. In doing so, you must be aware of the importance of establishing and maintaining your credibility before the judge or the jury. Neither may understand the detailed complexities of the case, but both will understand if you are overreaching, if you are overstating, or if you are caught in a lie. And once you lose your credibility, then, in my view, the fact finder is unlikely to be persuaded by any part of your case.

The next point to be made is that you must keep your case simple. There is nothing new in saying this, and yet I do not think that anyone who has not actually tried a case, particularly before a jury, can appreciate how hard you must work at simplifying your case. This is particularly important for the accused infringer because, if the case is too complex, the jury will revert to its initial instinct, which is to believe that the patent must be valid (why else would the Patent Office have issued it?) and the accused infringer must have infringed (why else would the parties be going to all this trouble?). An overly complex case can only work to the benefit of the patent owner.

The first way to simplify your case is to minimize the number of issues you raise. You cannot go into a trial, before either a judge or a jury, with a half dozen or more claims or defenses. You must make hard choices and go to trial with your best issues. Otherwise, the wheat will be lost with the chaff. Weak claims and defenses also hurt your credibility.

The second way to simplify your case, of course, is to simplify your presentation. You must start with the basics, with definitions, and build slowly. If by chance you are the party who goes first, make sure your first witness can effectively educate the jury. If this witness is successful at this task, he or she will have particular credibility, and the remainder of the first witness's testimony will be important to the merits of the rest of your case.

Try to develop simple repetitive themes in your presentation. If you have a good point to be made, make it not only through your own witnesses but also through cross-examination, so that the point will be foremost in the minds of the judge or the jury when they decide the case. Choose witnesses who will be effective on the stand. This does not necessarily mean choosing Nobel prizewinners as your expert witnesses, but witnesses who are good teachers and who can be nimble on cross-examination.

Work with your witnesses before they testify to make sure their presentations are simple and understandable. Include practice examination before a mock jury, preferably laypeople, not scientists or lawyers. This experience will give you feedback as to whether or not the witness is explaining things on a simple level and whether or not the issues you are trying to present are coming through.

If you are concerned about how a jury will react to part or all of your case, you should consider ways of taking issues away from the jury. For example, equitable issues, such as inequitable conduct in the procurement of a patent, can be taken away from the jury and decided by the judge. The issues presented to the jury can also be limited to deciding particular facts (a special verdict), as distinguished from deciding who wins and who loses (a general verdict). When a special verdict is used, the judge decides the ultimate issues. Finally, some patent validity defenses that may not appeal to a jury may be raised before the Patent Office through a reexamination proceeding. Consider foregoing presenting those issues to the jury and presenting them to the Patent Office instead.

These are a few basic strategies for biotechnology patent litigation. But the first and foremost thing you must do, no matter what else you do, is establish and maintain your credibility. In the end, credibility is one of the principal ways that juries and judges decide cases—they rule in favor of whomever they believe is telling the truth.

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