3 Tips For Any Fed. Circ. Appeal


On May 14, 2013, the Federal Circuit issued its decision in *Metso v. Powerscreen*, invalidating the asserted patent and erasing a more than $30 million judgment for the patentee.[1] In the district court, the jury found that Powerscreen willfully infringed a valid patent, and the district judge doubled the damages award for willfulness. Merchant & Gould was brought in to handle Powerscreen’s appeal to the Federal Circuit, and our team prevailed.

In public commentary,[2] several judges of the Federal Circuit have provided useful advice about how to present a case on appeal. In preparing the briefs for Powerscreen, we found three aspects of that advice particularly useful. The three simple strategies below should be considered in any appeal to the Federal Circuit.

1) Explain and Simplify the Technology

While some of the Federal Circuit judges have technical backgrounds, the odds are slim-to-none that all three judges on a panel will be familiar with the technological field at issue in any given case, let alone the specific technology on which the case turns. Just as it is important in any appeal to master the factual record and present it clearly on appeal, it is important in patent cases to explain the technology clearly so that the court will understand your arguments.

Judge William Curtis Bryson has specifically urged lawyers to “walk us through some of the technologies, at least in two or three pages, [so that] the court will get a better education about your case and come to a much better sense of how the law applies to the facts that you have.”

Judge Alvin Schall agrees: “If you have a patent case make that accused device or patented invention understandable.”

This makes sense — how can the court effectively construe a claim or determine whether a patent is valid if it does not understand the technology?

Consistent with this advice, Powerscreen’s appeal briefing presented a detailed technical discussion that was simple and easy to understand. We dedicated several pages of our opening brief to present a simple and logical discussion of the prior art and the technology claimed in the patent in suit. The Federal Circuit’s opinion contained an extensive discussion of the prior art and the technology claimed in the patent. A clear technical discussion is obviously important in any patent case, and key when the issue on
appeal is obviousness.

2) Use Images, Labels and Color

In addition to advising lawyers to explain the technology clearly, the Federal Circuit judges have specifically encouraged the use of images, labels and color. Just as good trial lawyers will often use colorful demonstrative exhibits to explain a patent case to a jury, the judges of the Federal Circuit have advised that good appellate lawyers would do well to include similar materials in their briefs.

Consistent with the adage that a picture is worth a thousand words, Judge Raymond Clevenger has counseled, “I think that any form of demonstrative evidence that is going to speed the process by which the court is going to understand what you are saying makes great sense. ... And we are seeing an increasing use, at least I am, especially in patent cases, of Technicolor inserts, photographs and things like that in the briefs that are very helpful, at least to me.”

Likewise, retired Judge Paul Michel has counseled, “I just want to put in a plug for diagrams, photographs, charts, and other graphic ways of communicating. Everything doesn’t have to be communicated with long sentences. Some things are better done through graphs.”

Following this guidance, Powerscreen’s two briefs on appeal included over 50 images from the patent in suit, the prior art and the trial record, many of them labeled and in color. Pictures from the record can be extraordinarily helpful in explaining the technology (or other issues) in the case without taking up many words, something that is particularly important because there are strict word limits for appeal briefs. There is no doubt that our use of the images from the record was effective in our appeal — the Federal Circuit’s opinion used four images pulled directly from Powerscreen’s briefing.

3) Limit the Issues Appealed

While it may be tempting to appeal many different issues, the Federal Circuit judges have strongly counseled against it. It is rare that the district court committed numerous separate reversible errors, and the Federal Circuit judges have explained that raising numerous issues on appeal issues distracts from potentially meritorious claims and suggests that there may not be any really strong appeal issue.

Judge Pauline Newman has warned that attorneys should avoid the “shotgun approach” and they should limit themselves to their best points.

Judge Alan Lourie has counseled, “Limit the issues. Having more than three issues in a brief suggests to us that you don’t have a strong appeal.”

This is, of course, equally good advice in any appeal. The opening line of a recent Sixth Circuit opinion stated bluntly that “[w]hen a party comes to us with nine grounds for reversing the district court, that usually means there are none.”[3]

Appellants should really evaluate potential appeal issues and select only a few of the most important, most dispositive, and/or most likely to win. A long succession of marginal appeal issues dramatically decreases the chances that any one issue will ultimately be successful.

Thus, while there were several issues Powerscreen could have raised, it limited its appeal to three: obviousness, claim construction and willfulness. Obviousness had the potential to be — and ultimately
was — dispositive of the entire appeal. The Federal Circuit agreed with Powerscreen that the patent was invalid as a matter of law, so there was no need for a remand.

**Conclusion**

It is important to be strategic in any appeal. In public commentary, the judges have provided guidance on some very simple yet very powerful things any appellant can do to make its appeal brief more persuasive and increase its chances of success on appeal. Powerscreen listened to advice from the Federal Circuit judges, who consistently counsel attorneys to explain the technology clearly (with pictures) and to limit the issues on appeal.

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