

**The Art of Preservation in Patent Infringement Lawsuits: The Benefits of Appellate
Counsel in the Trial Court**

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Introduction

In 2005, the Federal Circuit Court of Appeals granted some form of relief in 67% of patent infringement cases appealed after trial.¹ With such a high reversal rate, the last thing any practitioner wants to read in a Federal Circuit opinion is that the golden argument on appeal has been waived.² Having a good appellate lawyer assist at trial can help avoid waiver while allowing the trial lawyers to focus on the merits of the case, the judge, and the jury. This paper highlights the procedural steps to preserving issues for appeal in patent infringement lawsuits and provides strategical suggestions on how best to use these steps (and an appellate lawyer) during the litigation process.

General Principles Governing Error Preservation

Absent exceptional circumstances, a party may not raise an argument on appeal unless it was first raised in the trial court.³ Specifically, to preserve an argument for appeal, the complaining party must state the argument clearly to the district court so that the court may make an informed ruling.⁴ While this standard sounds simple enough, a substantial body of case law has developed around this basic procedure. For instance, how distinct must an objection be? When is it sufficient to simply point out the error, and when must it be corrected? And, at what point must the objection be made?

The answers to these questions vary depending upon the procedural posture of the case and the jurisdiction governing the procedural standards. On procedural questions, the Federal Circuit has stated that it will defer to “the law of the regional circuit in which the appeal from the district court would usually lie.”⁵ However, noting the significance to Federal Circuit law of

¹ This statistic is based on an informal review of published opinions from bench and jury trials in patent infringement lawsuits from January 1, 2005 through December 10, 2005. During this time period, the Federal Circuit issued written opinions in 39 patent infringement cases that were appealed after trial. In 27 of those cases (67% of the time) the Federal Circuit granted some form of relief that resulted in either the vacatur of a district court ruling or the reversal in whole or part of the judgment. More formal studies focused on appeals from all stages of patent infringement lawsuits have similarly found significant reversal rates by the Federal Circuit. See, e.g., Stephen P. Swinton and Adam A. Welland, *Patent Injunction Reform and the Overlooked Problem of ‘False Positives’*, 70 BNA’S PATENT, TRADEMARK, AND COPYRIGHT J. no. 1728, n.4 (Jul. 15, 2005); see also *The Law, Technology & the Arts Symposium: The Past, Present and Future of the Federal Circuit*, 54 CASE W. RES. L. REV. 671, 680-82 (2004) (estimating recent reversal rates in patent infringement appeals as high as 71 percent).

² See, e.g., *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277, 1287-88, 63 USPQ2d 1545, 1551-52 (Fed. Cir. 2002) (“[i]nitially we note that [the Defendant] failed to move for a JMOL of invalidity with respect to the [patent-in-suit]. Our review of the jury’s findings with respect to the [patent-in-suit] is therefore limited to errors of law and we cannot enter a judgment in [the Defendant’s] favor based on the sufficiency of the evidence.”).

³ FED. R. CIV. P. 51; *Southwest Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280, 1290 n.7, 56 USPQ2d 1161, 1167 n.7 (Fed. Cir. 2000) (internal quotations omitted); *Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1262, 75 USPQ2d 1701, 1721 (Fed. Cir. 2005) (Garjarsa, Cir. Judge, dissenting).

⁴ See *Eli Lilly & Co. v. Aradigm Corp.*, 376 F.3d 1352, 1361, 71 USPQ2d 1787, 1793 (Fed. Cir. 2004) (quoting FED. R. CIV. P. 51) (“[i]t is black letter law that objections must state ‘distinctly the matter objected to and the grounds of the objection.’”); *Union Carbide Chems. & Plastics Tech. Corp. v. Shell Oil Co.*, 425 F.3d 1366, 1374, 76 USPQ2d 1705, 1710 (Fed. Cir. 2005) (applying Third Circuit law and noting that to preserve error for appeal a party “need only lodge a sufficiently specific objection before jury deliberations.”).

⁵ *Summit Tech., Inc. v. Nidek Co., Ltd.*, 363 F.3d 1219, 1223, 70 USPQ2d 1276, 1280 (Fed. Cir. 2004); *Ultra-Precision Manufacturing, Ltd. v. Ford Motor Co.*, 411 F.3d 1369, 1376, 75 USPQ2d 1065, 1069 (Fed. Cir. 2005) (“Regional circuit law governs the question of waiver of a defense.”).

preserving error in the context of patent infringement cases, the circuit court applies its own standards to preservation questions when the issue being raised is uniquely one of patent law.⁶ Thus, whether a pre-verdict JMOL directed to inequitable conduct and the on-sale bar defense is sufficient to preserve the right to raise a post-verdict JMOL on the broader question of obviousness, pertains uniquely to patent law and is governed by Federal Circuit standards.⁷

Preservation at Specific Stages of the Trial Process

1. Preserving Objections to the *Markman* Ruling.

It is standard practice to have disputed claim terms construed at a pre-trial *Markman* hearing.⁸ But what happens when neither party disputes a term at that hearing? The failure to request construction of a claim term means that the parties implicitly concede the terms are clear and require no further interpretation.⁹ This does not mean that the *Markman* hearing is the last chance to dispute claims. The Federal Circuit has held only that it is improper to modify claim construction *after* the case goes to the jury for deliberation; the case authorities do not prohibit raising disputed terms up to that point.¹⁰ Thus, if a claim term was not challenged at the *Markman* hearing, but testimony at trial calls for clarification by the trial court, it would be wise to raise these questions with the trial court at the earliest possible date but by all means no later than charge conference.

Rule 51 of the Federal Rules of Civil Procedure requires that a party object clearly “before the jury retires to consider its verdict.”¹¹ Arguably, arguments made at the *Markman* hearing should satisfy this requirement without an obligation to reurge *Markman* objections at trial. The Federal Circuit has approved of preserving claim construction arguments through charge objections.¹² But, more recent authorities tend to indicate that arguments fully briefed and argued at the *Markman* hearing need not be reiterated at trial to preserve the argument for

⁶ See *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1344-46, 59 USPQ2d 1401, 1417-19 (Fed. Cir. 2001).

⁷ See, e.g., *Duro-Last, Inc. v. Custom Seal, Inc.*, 321 F.3d 1098, 1106, 66 USPQ2d 1025, 1029 (Fed. Cir. 2003); see also *Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1250-51, 75 USPQ2d 1705, 1712 (“Because the ability to make claim construction arguments on appeal is intimately bound up with patent enforcement, we hold that Federal Circuit law controls waiver in the context of claim construction arguments.”).

⁸ See *Amgen Inc. v. Hoeschst Marion Roussel, Inc.*, 314 F.3d 1313, 1324, 65 USPQ2d 1385, 1392 (Fed. Cir. 2003) (“The rules by now are well known. Because claim language defines claim scope, the first step in an infringement analysis is to construe the claims”) (citing *Markman v. Westview Instr., Inc.*, 52 F.3d 967, 976, 34 USPQ2d 1321, 1326 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370, 38 USPQ2d 1461 (1996)).

⁹ See *Eli Lilly*, 376 F.3d at 1360, 71 USPQ2d at 1792 (holding that the failure to request a claim construction until after the presentation of all evidence to the jury waives the right to seek a claim construction and “implicitly concede[s] that the meanings of the [disputed] terms . . . are clear and not in need of construction.”).

¹⁰ *Hewlett-Packard Co. v. Mustek Systems, Inc.*, 340 F.3d 1314, 1320, 67 USPQ2d 1825, 1825, 1829 (Fed. Cir. 2003) (holding that it is “improper for the district court to adopt a new or more detailed claim construction” at the post-trial stage); *Abbott Labs v. Syntron BioResearch, Inc.*, 334 F.3d 1343, 1352, 67 USPQ2d 1337, 1343 (Fed. Cir. 2003) (“Abbott cannot wait until after the jury returns a verdict against it and then on JMOL request a different construction by attempting to have the district court delete a portion of the construction that Abbott itself agreed to.”) (citing *Interactive Gift*, 256 F.3d at 1345-46, 59 USPQ2d at 1418).

¹¹ FED. R. CIV. P. 51.

¹² See *Texas Digital, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1201, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002) (holding that timely charge objections at trial preserved argument that jury instructions developed from district court’s erroneous *Markman* claim limitation construction were prejudicial).

appeal. Specifically, the Federal Circuit has held that “[w]hen the claim construction is resolved pre-trial, and the patentee presented the same position in the *Markman* proceeding as is now pressed, a further objection to the district court’s pre-trial ruling . . . was not required to preserve the right to appeal the *Markman* ruling.”¹³

But what if a claim construction argument in the court of appeals is different than the argument raised in the trial court? The general rule is that new arguments cannot be raised for the first time on appeal.¹⁴ However, Federal Circuit authorities have drawn a distinction between arguments on appeal that “merely clarif[y] or defend[] ‘the original scope’ of a claim construction offered below, or offer[] additional support for existing claim construction arguments by further citation to the patent specification” and those arguments that raise completely new positions on appeal.¹⁵ The former is permitted, the latter is not.

In what may be seen as a departure from these basic rules, a majority panel from the Federal Circuit recently noted in *Harris Corp. v. Ericsson Inc.*, that it may apply waiver on a “case-by-case basis”.¹⁶ Thus, in a case where the defendant argued to the district court that it was advocating a two-step “function” theory claim construction under the doctrine of equivalents and switched its argument on appeal to a two-step “structure” theory of literal infringement, the Federal Circuit refused to find waiver because the defendant was arguing the “same concept” in both courts.¹⁷ Notably, in *Harris Corp. v. Ericsson Inc.*, the majority emphasized that the patent holder failed “in over 60 pages of briefing . . . to advance an argument supporting the district court’s construction on the merits” but instead argued waiver at every turn, a factor supporting application of an exception to waiver in any event.¹⁸ Notwithstanding the Federal Circuit’s willingness to overlook waiver in specific cases, the best practice is to preserve arguments at each stage of the proceedings to avoid having to rely on an exception.

2. Preserving Objections to a Summary Judgment Ruling.

An order denying a motion for summary judgment preserves nothing for appeal.¹⁹ Rather, to preserve a legal argument raised in an unsuccessful summary judgment motion, the movant must reassert the argument at trial, usually in a motion for judgment as a matter of law, both before and after the case goes to the jury.²⁰

¹³ *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 381 F.3d 1371, 1380-81, 72 USPQ2d 1333, 1340 (Fed. Cir. 2004).

¹⁴ See *Harris Corp.*, 417 F.3d at 1262, 75 USPQ2d at 1721 (Gajarsa, Cir. Judge, dissenting) (“It is a long-settled rule that appellate courts will not consider an issue neither pressed nor passed upon below.”).

¹⁵ *Id.* at 1264 (Gajarsa, Cir. Judge, dissenting); see also *Gaus v. Conair Corp.*, 363 F.3d 1284, 1288, 70 USPQ2d 1380, 1383 (Fed. Cir. 2004).

¹⁶ *Harris Corp.*, 417 F.3d at 1251-52, 75 USPQ2d at 1713.

¹⁷ *Id.* (“Because Ericsson is advocating the same concept as it did in the district court, we hold that Ericsson’s district court claim construction arguments do not preclude its . . . argument on appeal.”).

¹⁸ *Id.* at 1252 n.3.

¹⁹ See *Glaros v. H.H. Robertson Co.*, 797 F.2d 1564, 1573, 230 USPQ2d 393, 399 (Fed. Cir. 1986) (“a denial of summary judgment is not properly reviewable on an appeal from the final judgment entered after trial.”); see also *Lisle Corp. v. A.J. Manufacturing Co.*, 398 F.3d 1306, 1317, 73 USPQ2d 1891, 1897-98 (Fed. Cir. 2005) (finding argument raised in unsuccessful summary judgment motion waived by failure to reurge at trial).

²⁰ See FED. R. CIV. P. 50.

Even when successful on summary judgment, it is necessary to take certain steps to preserve error for appeal. The summary judgment is reviewed solely on the grounds raised in the motion. This means that clever new arguments should not be considered for the first time on appeal, but the Federal Circuit has proved willing to view the grounds asserted in the summary judgment motion broadly. For instance, where a party raised the general issue of enablement in support of a defensive motion for summary judgment, on appeal the party was allowed to extrapolate on specific arguments in support of its enablement defense that were not clearly articulated in the district court.²¹ Notwithstanding such broad interpretation of summary judgment grounds in specific cases, it may not be wise to rely on the court's generosity. Just how broadly the Federal Circuit will interpret summary judgment grounds may depend largely upon the panel.²²

Preservation issues also arise in the context of rulings on partial summary judgment. A district court's ruling is always subject to change until a final judgment is entered. Thus, all favorable partial rulings should be reurged to avoid waiver.²³

3. Preservation of Error on Evidentiary Rulings.

To properly preserve evidentiary objections, a party must state the objection clearly and get a ruling from the court. Under Rule 103, a party preserves error from the erroneous admission of evidence when "a timely objection or motion to strike appears of record, stating the specific ground of objection, if the specific ground was not apparent from the context."²⁴ A party preserves error from the exclusion of evidence when "the substance of the evidence was made known to the court by offer or was apparent from the context within which questions were asked."²⁵

Prior to 2000, it was necessary to reassert an objection every time the opposing party tried to introduce the objectionable evidence. It was not sufficient to simply raise an objection in the pretrial limine motion. Nor was a running objection sufficient to preserve the point.²⁶ An

²¹ See *Warner-Lambert Co. v. Teva Pharmaceuticals USA, Inc.*, 418 F.3d 1326, 1338 n.11, 75 USPQ2d 1865, 1872-73 (Fed. Cir. 2005) ("[W]e reject Warner-Lambert's assertion that Teva waived some of its enablement arguments, such as the unpredictability of the art, by not raising them before the trial court. In this case, it was sufficient that Teva raised the general issue of enablement.") (citing *Interactive Gift*, 256 F.3d at 1346, 59 USPQ at 1419 and *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1540, 218 USPQ 871, 880 (Fed. Cir. 1983)); see also *MerExchange, L.L.C. v. eBay, Inc.*, 401 F.3d 1323, 1330, 74 USPQ2d 1225, 1231 (Fed. Cir. 2005) (finding that obviousness arguments preserved right to articulate invalidity argument based on anticipation on appeal because "anticipation is the epitome of obviousness.").

²² See *Harris Corp.*, 417 F.3d at 1262, 75 USPQ2d at 1721 (Gajarsa, Cir. Judge, dissenting).

²³ See, e.g., *Hewlett-Packard*, 340 F.3d at 1325 n.5, 67 USPQ2d at 1832 (finding that Hewlett-Packard waived a claim construction made by the district court in ruling on summary judgment by failing to urge the district court to raise the same construction in the *Markman* briefs).

²⁴ FED. R. EVID. 103(a)(1).

²⁵ FED. R. EVID. 103(a)(2). To make an offer of proof under this rule, the party must (1) explain the purpose of the evidence, (2) explain the grounds for admission, and (3) offer the evidence on the record outside the presence of the jury. *Id.* The offer should typically be made contemporaneously with the court's exclusion of the evidence. However, no offer of proof is necessary if the substance of the evidence sought to be admitted is apparent from the context in which the questions were asked [FED. R. EVID.103(a)(2)] or if the party makes clear to the court the evidence he wants admitted and the grounds for admissibility and the court, either at or before trial, has made a definitive ruling excluding the evidence.

²⁶ See *United States v. Fortenberry*, 919 F.2d 923, 924 (5th Cir. 1990) (strongly cautioning "both the district courts against granting and counsel against accepting pretrial continuing objections.").

amendment in 2000 to Rule 103(a) added the following: “Once the court makes a definitive ruling on the record admitting or excluding evidence, either at or before trial, a party need not renew an objection or offer of proof to preserve a claim of error for appeal.”²⁷ The Federal Circuit has acknowledged this rule change in at least one opinion, finding on the facts of that case that an evidentiary objection raised at limine but not renewed at the time the testimony was given properly preserved the evidentiary challenge.²⁸ Despite this apparent loosening of the standards, it is too soon to tell how courts will apply this rule in various cases.²⁹ Further, if the trial court’s ruling is tentative or conditional, the objection should be renewed or the court should be asked to clarify the ruling. Thus, notwithstanding the revised rules of evidence, the better course of action is to renew limine objections at the time the evidence is introduced at trial.

Finally, one must walk a fine line when trying to explain away or defend against evidence that the trial court has erroneously introduced. If the party objecting to evidence later introduces that same evidence or calls a witness to explain the evidence, the party risks a finding that the error in introducing the evidence was invited or harmless.

4. Preservation of Error in the Jury Charge.

Rule 51 of the Federal Rules of Civil Procedure provides that “[n]o party may assign as error the giving or the failure to give an instruction unless that party objects thereto before the jury retires to consider its verdict, stating distinctly the matter objected to and the grounds of the objection.”³⁰ To satisfy Rule 51, it is not enough to just complain of the opponent’s proposed instruction. The party must articulate the problem and propose a legally correct alternative instruction.³¹ As with objections generally, objections to the jury charge must be sufficiently specific to identify the claimed error to the district court so that the court has an opportunity to correct itself.³² Thus, a party may not complain on appeal that a jury instruction on willfulness placed undue emphasis on the defendant’s failure to obtain an opinion of counsel where the party

²⁷ FED. R. EVID. 103(a).

²⁸ See *Micro Chem., Inc. v. Lextron, Inc.*, 317 F.3d 1387, 1391, 65 USPQ2d 1532, 1534-35 (Fed. Cir. 2003).

²⁹ See, e.g., *Wilson v. Waggener*, 837 F.2d 220, 222 (5th Cir. 1988) (finding that a motion in limine is insufficient to preserve evidentiary error at trial).

³⁰ FED. R. CIV. P. 51.

³¹ See *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 853-54, 20 USPQ2d 1252, 1254-55 (Fed. Cir. 1991); see also *Union Carbide*, 425 F.3d at 1374, 76 USPQ2d at 1710 (specific requests for clarifying instructions on three claim terms before the judge delivered instructions to the jury found sufficient to preserve arguments for appeal); *Eolas Technologies Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1338, 73 USPQ2d 1782, 1792-93 (Fed. Cir. 2005) (finding waiver of challenge to jury instruction construing claim where party challenging interpretation on appeal expressly stated to district court that it did not dispute the interpretation given).

³² See *Palmer v. Hoffman*, 318 U.S. 109, 119 (1943) (“In fairness to the trial court and to the parties, objections to a charge must be sufficiently specific to bring into focus the precise nature of the alleged error.”); but see *Riverwood Int’l. Corp. v. RA Jones & Co., Inc.*, 324 F.3d 1346, 1353, 66 USPQ2d 1331, 1336 (Fed. Cir. 2003) (acknowledging that some jurisdictions may recognize a “futility” exception as a means to avoid waiver of charge error).

failed to object to the submission at trial.³³ Similarly, the failure to propose a jury instruction on obviousness waives any claim of invalidity based on obviousness on appeal.³⁴

Recent Federal Circuit opinions may indicate a willingness by the court to loosen preservation standards when the court wants to reach the issue. In *CollegeNet, Inc. v. ApplyYourself, Inc.*, the defendant wanted to argue on appeal that the district court’s grant of summary judgment of infringement was based on an incorrect construction of the term “automatically.”³⁵ Although the defendant did not formally object to the jury instruction, the defendant did flag the instruction as “disputed” in the joint submission of jury instructions and referred to the court’s rejection of its proposed claim construction in the *Markman* ruling.³⁶ The Federal Circuit held that while the defendant’s “actions may have been ‘deficient in terms of the plain language of Rule 51,’ they ‘fall []within the limited exception we have recognized for a pointless formality.’”³⁷

As noted above, even if a party has fully vetted its claim construction arguments at the *Markman* hearing, it is wise to reurge such arguments in the form of objections to the jury instructions. The jury charge conference may also provide an opportune time to raise objections to the district court’s claim construction, even if not previously raised.³⁸ But even if a party does not object to the submission of a particular claim construction at trial, at least two judges on the Federal Circuit have held that the party may still challenge whether a reasonable jury could find that a party infringed the properly construed claims based on the evidence presented by filing a motion for judgment as a matter of law.³⁹ The dissent saw the defendant’s argument on appeal as “a distinct paradigm shift” and the majority’s opinion as abolishing “the doctrine of waiver from the Federal Circuit law.”⁴⁰

5. Preservation of Error Through the Motion for Judgment as a Matter of Law.

To challenge the sufficiency of the evidence on appeal, a party must file a motion for judgment as a matter of law (JMOL) at the close of all evidence and a renewed JMOL after verdict. A JMOL made before the submission of the case to the jury must “specify the judgment

³³ See *Engineered Prods. Co. v. Donaldson Co., Inc.*, Nos. 04-1596, 05-1002, 05-1037, 2005 U.S. App. LEXIS 18828, at *29 (Fed. Cir. Aug. 31, 2005) (citing FED. R. CIV. P. 51(c) and *Chem-Trend, Inc. v. Newport Indus., Inc.*, 279 F.3d 625, 629 (8th Cir. 2002)).

³⁴ *Pandrol USA, LP v. Airboss Railway Prods., Inc.*, 424 F.3d 1161, 1167, 76 USPQ2d 1524, 1528 (Fed. Cir. 2005).

³⁵ *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1234, 75 USPQ2d 1733, 1741 (Fed. Cir. 2005).

³⁶ *Id.*

³⁷ *Id.* (quoting *Voorhies-Larson v. Cessna Aircraft Co.*, 241 F.3d 707, 714 (9th Cir. 2001)).

³⁸ See *Eli Lilly*, 376 F.3d 1361, 71 USPQ2d 1793 (“Aradigm never indicated what aspect of the claim the paraphrase left out. Generically alleging that the wording of a jury instruction is confusing, without suggesting the logical error the jury might make, does not give the district court the information that it requires to see the alleged error of its ways and to have a meaningful first opportunity to consider changing course.”); see also *Texas Digital*, 308 F.3d at 1201, 64 USPQ2d at 1817 (holding that timely objections to the jury instructions at trial preserved argument that jury instructions developed from district court’s erroneous *Markman* claim limitation construction were prejudicial).

³⁹ See *Harris Corp.*, 417 F.3d at 1252, 75 USPQ2d at 1713 (“irrespective of any jury instructions, the JMOL decision is based on whether a reasonable jury could find that Ericsson infringed the properly construed claims based on the evidence presented.”).

⁴⁰ *Id.* at 1262-63 (Gajarsa, Circuit Judge dissenting).

sought and the law and the facts on which the moving party is entitled to the judgment.”⁴¹ The JMOL is intended to “afford the opposing party an opportunity to cure the defects in proof that might otherwise preclude the party from taking the case to the jury.”⁴²

The renewed JMOL may not raise any issues that were not first raised to the trial court prior to the close of the evidence. Thus, a JMOL that challenged the sufficiency of the evidence to support a materiality finding for inequitable conduct did not preserve a post-verdict JMOL on obviousness.⁴³ However, a renewed JMOL may be used to strengthen or better articulate the arguments raised pre-verdict.⁴⁴ The question is whether there was substantial evidence to support the verdict under the instructions given to the jury. It is not proper for the district court to create a new or more detailed claim construction in ruling on the renewed motion for judgment as a matter of law.⁴⁵ Moreover, it is not sufficient to just blankly ask the court to reconsider the arguments you have already made. Rather, the renewed JMOL must rearticulate each and every sufficiency challenge.

The consequences can be severe for failing to raise sufficiency challenges by JMOL. A party that fails to move for judgment as a matter of law under Rule 50(a) on the basis of insufficient evidence at the conclusion of all of the evidence “is precluded from challenging the sufficiency of the evidence supporting the jury’s factual findings.”⁴⁶ This does not mean that all review of the evidence is curtailed, but it limits appellate review “to whether there was *any* evidence to support the jury’s verdict, irrespective of its sufficiency or whether plain error was committed which, if not noticed, would result in a manifest miscarriage of justice.”⁴⁷ Under this standard, if any evidence supports the jury verdict, the verdict will be upheld.

6. Perfecting Appeal.

As in all other cases, an appeal in a patent infringement lawsuit is perfected by filing a notice of appeal that broadly designates the “judgment, order, or part thereof being appealed.”⁴⁸ The notice should designate the United States Court of Appeals for the Federal Circuit as the

⁴¹ FED. R. CIV. P. 50(a).

⁴² *Duro-Last*, 321 F.3d at 1105, 66 USPQ2d at 1028.

⁴³ *See id.* at 1107.

⁴⁴ *See Gaus*, 363 F.3d at 1288, 70 USPQ2d at 1383.

⁴⁵ *Hewlett-Packard*, 340 F.3d at 1321, 67 USPQ2d at 1829 (“The verdict must be tested by the charge actually given and by giving the ordinary meaning of the language of the jury instruction.”).

⁴⁶ *Biodex Corp.*, 946 F.2d at 854, 20 USPQ2d at 1261 (Fed. Cir. 1991) (“we conclude that we cannot review the sufficiency of the evidence after a jury verdict absent some post-verdict disposition, either by a deferred ruling or upon a post-verdict motion.”); *see Catalina Lighting*, 295 F.3d at 1290, 63 USPQ2d at 1553 (declining to review sufficiency challenge to damage award because “Catalina failed to move for JMOL regarding damages for the ‘141 patent prior to the jury’s verdict.”) (citing FED. R. CIV. P. 50(a)(2)); *Southwest Software*, 226 F.3d at 1290, 56 USPQ2d at 1168).

⁴⁷ *Biodex Corp.*, 946 F.2d at 854, 20 USPQ2d at 1255 (“When no motion challenging the legal sufficiency of the evidence has been made at any stage in the district court, the law is uniform in all circuits that review is limited to plain error.”); *Catalina Lighting*, 295 F.3d at 1288, 63 USPQ2d at 1551-52 (“Initially, we note that Catalina failed to move for a JMOL of invalidity with respect to the ‘141 patent. Our review of the jury’s validity findings with respect to the ‘141 patent is therefore limited to errors of law and we cannot enter a judgment in Catalina’s favor based on the sufficiency of the evidence.”) (citing *Southwest Software*, 226 F.3d at 1290, 56 USPQ2d at 1168).

⁴⁸ FED. R. APP. P. 3(c)(1)(B).

proper court to receive the appeal and should be filed with the district court. It is advisable to put this designation in bold print and to physically escort the notice to the district court clerk. The clerk should be given a gentle reminder that the filing is not to be sent to the normal circuit court of appeals.

The notice must be filed within thirty (30) days of entry of the judgment. To avoid ambiguity in determining what document constitutes the judgment, the rules require that the judgment be put down in a separate document. But what happens when the district court fails to put the judgment in a separate written and signed document? Rule 58 provides that judgment is entered *de facto* 150 days after the court signs the judgment.⁴⁹ This Rule can pose a problem when a district court enters orders denying post-verdict motions, but never signs a written judgment.

What to Do When Error Is Not Preserved

Although the preferred practice is to preserve error every step of the process, in instances where the circuit courts want to reach an issue, they will apply an exception to waiver that allows them to reach the merits.⁵⁰ First, where the error in the district court's ruling is plain on its face, it may not be necessary to object to be able to raise the argument on appeal. Second, and similar to the plain error doctrine, the appellate court always has the discretion to ignore waiver due to "special circumstances" or "manifest injustice."⁵¹ However, these doctrines are exceptions and are not frequently applied.⁵²

Strategic Considerations

It is important for all trial lawyers to understand the rules of preservation. Strategic considerations may render it beneficial to have a preservation specialist assist at trial. Indeed, sometimes the mere presence of an appellate lawyer at trial can help focus the district court – faced with an increased awareness that the case will be appealed -- on getting the legal rulings right in the first instance.

Perhaps more importantly, use of a preservation specialist to argue certain pretrial procedural issues leaves trial counsel open to prepare for the opening statement. And, use of the appellate lawyer to argue the charge leaves trial counsel free to prepare closing statements. In sum, having an appellate specialist enhances the trial team and allows the trial lawyer to focus more on the judge, jury, and witnesses.

⁴⁹ Rule 58(b)(2)(B) provides that if no separate judgment document is entered in the civil docket, judgment is deemed entered 150 days from the date the order granting judgment is entered in the civil docket.

⁵⁰ See, e.g., *Harris Corp.*, 417 F.3d at 1252, 75 USPQ2d at 1712 ("An appellate court retains case-by-case discretion over whether to apply waiver.").

⁵¹ *Id.* at 1252 n.3 (finding that the "beyond any doubt" and "manifest injustice" exceptions applied to the waiver analysis).

⁵² See *Eolas Technologies*, 399 F.3d at 1338, 73 USPQ2d at 1793 (finding "no grievous unfairness in this instruction" that would overcome the failure to challenge the instruction in the district court).

Procedural Checklist

I. Motion in Limine

- Include unfavorable claim construction references in limine motion.
- No need to reurge at trial if ruling definitive per FRE 103(a).
- Renew objection if pre-trial ruling is tentative.
- Consider re-urging in any event; if the objection draws force from its context, the renewal of that objection in the thick of trial will put you in a better position on appeal.

II. Opening Statements

- Ask the judge to preclude the opponent from mentioning any non-limited, prejudicial evidence in opening statement.

III. Presentation of Evidence at Trial

- Object to evidence, move to strike, request limiting instruction, move for mistrial.
- Running objections should not be necessary in light of FRE 103(a).
- Excluded evidence should be presented through an offer of proof:
 - explain the purpose of the evidence
 - explain grounds for admission
 - offer evidence on the record outside the presence of the jury
 - should be made contemporaneously with the court's exclusion of evidence.
- Avoid invited error where possible.

IV. Close of All Evidence

- Move for Judgment as a Matter of Law, arguing:
 - legal sufficiency of the evidence
 - legal bar to recovery, such as erroneous claim construction under *Markman* or statute of limitations.

V. Charge Conference

- Object, stating grounds clearly.
- Tender revised charge in substantially correct form.

VI. Post Verdict

- Renewed Motion for Judgment as a Matter of Law:
 - limited to points raised in earlier JMOL motion
 - general verdict inconsistent with special interrogatories
 - legal sufficiency of the evidence
 - legal bars to recovery, such as erroneous claim construction.
- Motion for New Trial:
 - not a prerequisite to appeal if the objection was made during trial and ruled upon
 - jury verdict is against the weight of the evidence
 - newly-discovered evidence
 - some unfairness in the proceeding that could not have been raised at trial.

Phillip B. Philbin

Phillip Philbin earned his bachelor's degree in Engineering Science from Trinity University, and his law degree from Baylor University. Following law school, he served as law clerk to The Honorable Reynaldo G. Garza, United States Circuit Judge for the Fifth Circuit Court of Appeals.

A partner in Haynes and Boone, LLP, in Dallas, Texas, Mr. Philbin concentrates on intellectual property litigation and technical business litigation. Although he spends considerable time pursuing and defending patent litigation claims in courts across the country, he has litigated a full range of intellectual property cases, including trademark, copyright, trade secret, and trade dress. His general business litigation practice is primarily in the technical field and encompasses breach of contract, breach of warranty, fraud, fraud in the inducement, misrepresentation, and unfair competition.

Mr. Philbin is admitted to practice before the U.S. Supreme Court; the U.S. Patent and Trademark Office; the U.S. Courts of Appeals for the Federal and Fifth circuits; the U.S. District Courts for the Eastern, Northern, Southern, and Western districts of Texas; and the Supreme Court of Texas.

At home on either side of the courtroom, Mr. Philbin represents both plaintiffs and defendants. A sampling of recent cases:

- Defended telephone equipment manufacturer in patent infringement action involving SS7 network for mobile phones.
- Pursued an enforcement campaign for patents covering the electronic processing of call detail records against AT&T, several other long distance providers, several RBOCs; and other service providers.
- Defended telecommunications provider in patent infringement action involving prepaid, point-of-sale activated calling cards.
- Defended lighting manufacturer in patent and copyright infringement actions involving lamp designs.
- Defended patent infringement claims involving chemical composition of circular saw cutting tips.
- Defended various patent and trademark infringement cases involving treadmills, abdominal exercisers, and other exercise equipment.
- Represented renowned sculptor Glenna Goodacre in the copyright enforcement campaign for the Golden Dollar featuring Sacagawea.

- Defended and prosecuted breach of contract, breach of warranty, fraud, and fraud in the inducement claims involving software licenses, development and consulting services.

Mr. Philbin's recent publications and presentations include:

- "Intellectual Property Law," *SMU Law Review*, 2005
- "Beware of Fraudulent Inducement Claims in Software Contracts," *Dallas Business Journal*, July 16, 2004
- "Owners of Famous Trademarks Must Prove 'Actual Dilution' in Federal Trademark Dilution Act Claims," *IP Litigator*, October 2003
- "Patent Law Update – The Cases That Influenced the Practice the Most," State Bar of Texas Intellectual Property Law Seminar, March 6, 2003
- "The Rest of the Story: The Supreme Court's Decision in *Festo*," *For the Defense*, July 2002
- "The Impact of *Festo* in Patent Infringement Litigation," *For the Defense*, June 2002

Mr. Philbin's professional memberships include: the American Intellectual Property Law Association; the College of the State Bar of Texas; the Dallas Bar Association; and the State Bar of Texas. He is also an active member of the W.M. "Mac" Taylor, Jr. American Inn of Court, where he was a Barrister from 1998-2004 and currently holds the Master designation. On a community level, he is a member of Highland Park United Methodist Church, the Dallas Zoological Society, and the Dallas Country Club, and has served seven years on Trinity University's National Alumni Board.

At Haynes and Boone, Mr. Philbin is a litigation section chair, and a former practice group leader in both the business litigation and intellectual property litigation practices. He was named one of the "Best Lawyers in America" (2006) by Woodward/White, Inc., one of the "Best Attorneys in Dallas" by *D Magazine* (2001), as well as a "Super Lawyer" by the *Texas Lawyer* (2003, 2004, and 2005).

Debbie J. McComas

Debbie McComas earned her bachelor's degree in International Studies with honors from Austin College, and her law degree from Tulane University School of Law, *cum laude*.

A partner in Haynes and Boone, LLP's appellate practice group, Ms. McComas has extensive experience in complex civil litigation, with an emphasis on trial court preservation and appellate matters in state and federal court. Ms. McComas has participated in appeals to the United States Supreme Court, United States Federal Circuit Court of Appeals, United States Fifth Circuit Court of Appeals, Texas Supreme Court and numerous Texas courts of appeals. She has written articles on trial and appellate procedure, including co-authoring an annual survey on appellate procedure in Texas for the SMU Law Review for the past 6 years.

Ms. McComas has handled cases at all levels of state and federal court. Some recent matters include:

- Provided appellate counsel on trial court preservation of error and jury charge formation for lamp designer and manufacturer in patent infringement lawsuit (case currently pending in the Federal Circuit Court of Appeals).
- Provided appellate counsel on trial court preservation of error and jury charge formation for telecommunications company in patent infringement lawsuit.
- Provided appellate counsel on trial court preservation of error and jury charge formation in multimillion dollar retaliatory discharge case, resulting in take nothing jury verdict.
- Provided appellate counsel for preservation of error and jury charge formation in multimillion dollar international fraud and conspiracy case involving the airline industry, resulting in take nothing jury verdict. Obtained award of attorney's fees for successful defendants on appeal. *Air Routing Int'l Corp. (Canada) v. Britannia Airways, Ltd.*, 150 S.W.3d 682 (Tex. App.—Houston [14th Dist.] 2004, no pet.).
- Obtained reversal of a class action lawsuit against more than 60,000 class members on claims of “junk faxing” under the Telephone Consumer Protection Act. *Kondos v. Lincoln Property Company*, 110 S.W.3d 716 (Tex. App.—Dallas 2003, no pet.).
- Through a petition for certiorari to the United States Supreme Court, upheld a municipality's right to impose safety regulations on municipal towing services. *Stucky v. City of San Antonio*, 266 F.3d 342 (5th Cir. 2001), *cert. granted and judgment vacated*, 536 U.S. 936 (2002); *on remand*, 307 F.3d 315 (5th Cir. 2002).

Recent Publications and Speeches

Co-Author, “Appellate Practice and Procedure,”
58 SMU LAW REVIEW (Summer 2005)
57 SMU Law Review 515 (2004)

56 SMU Law Review 1061 (2003)
55 SMU LAW REVIEW 655 (2002)
54 SMU LAW REVIEW 1093 (2001)
53 SMU LAW REVIEW 617 (2000)
52 SMU LAW REVIEW 717 (1999)
51 SMU LAW REVIEW 669 (1998)
50 SMU LAW REVIEW 899 (1997)

“Preserving Error Before Trial,” STATE BAR OF TEXAS, APPELLATE BOOT CAMP (September 2005)

“Preserving Error Before Trial,” THE ADVOCATE, Winter 2004

“Post-Verdict Preservation of Error,” State Bar of Texas Advanced Civil Trial, Dallas, Texas, August 25, 2004

“Appellate Practice,” State Bar of Texas, Advanced Civil Litigation, August 2003

“Recent Developments in Class Action Litigation in Texas,” Presented to the DBA, September 30, 2003 and to the DAYL Friday Clinic CLE, August 15, 2003