

# Appellant's Brief: Writing an Answering Brief in a Patent Case

A Lexis Practice Advisor® Practice Note adapted from *Patent Appeals: The Elements of Effective Advocacy in the Federal Circuit*, by Mark Davies, Orrick, Herrington & Sutcliffe LLP



Mark Davies  
Orrick, Herrington & Sutcliffe LLP

This practice note provides pointers on how to draft an answering brief in an appeal to the Court of Appeals for the Federal Circuit in a patent case. For a complete discussion of appeal briefs to the Federal Circuit in patent cases, see: 1-8 Patent Appeals: Effective Federal Circuit Advocacy § 8.01 (2018). When writing your brief, also be aware that the Federal Circuit has modified the Federal Rules of Appellate Procedure in some respects. See [here](#).

## Include Everything

Fed. R. App. P. 28(b) requires the appellee's brief (better called the answering brief for clarity) to comply with the ordinary briefing requirements, except for the jurisdictional statement, the statement of the issues, the statement of the case, the statement of the facts, and the standard of review.

Do not take the lazy way out by opting to omit these sections. All of these sections can contain subtle advantages for the position urged in the argument. While a Federal Circuit local rule purports to limit the appellee to "areas of disagreement" for these sections, in reality, these sections are never neutral—there is always sufficient disagreement to warrant including an answering version.

## Write It Mostly as an Opening Brief

Do not write a brief that responds seriatim to the points made by the appellant's opening brief. Never adopt the structure of the opening brief. Instead, state the affirmative reasons for prevailing and then address any remaining arguments. Have your own story to tell.

## Keep It Simple

As the appellee, boring is good. Do not make the case more interesting than the opening brief makes it. For example, sometimes there is an interesting wrinkle to a case that the other side mentions but does not exploit. Avoid the temptation to answer fully. Instead, give a short answer and move on.

## Put the Focus on the District Court

As the appellee, try to wrap yourself around the district court as much as possible. Better the lower court says something than a paid advocate.

## Imagine the Answering Brief Is Read First

Judges vary a great deal in the order in which they read a set of briefs. Some start with the reply brief, to get a sense

of where the arguments really join. If there is a brief from the government, some judges start there, confident that the government will explain the case well. Some may dip in and out. The point is that the answering brief should be self-contained.

## Illustrative Samples

Here is a sample introduction from an answering brief in an antitrust case that illustrates these points. Note that this introduction does not at all assume that the reader has just finished the opening brief. To the contrary, the introduction assumes the reader is just learning about the case. The issue is presented as easy—or “straightforward” (a favorite word of mine)—and uncontroversial.

### INTRODUCTION

This is an appeal from a straightforward and correct application of New York’s class action procedures. Although New York law permits class action law suits, it sets out specific criteria that must be met. One of those prerequisites is that an action to recover a statutorily authorized “penalty” is not amenable to class action procedures unless the substantive law “specifically authorizes” the class action mechanism. Here, Paul Sperry attempts to bring a class action law suit under state antitrust laws (the “Donnelly Act”). The Donnelly Act’s treble damages remedy, however, is a “penalty” for purposes of New York class action procedures. Further, the Donnelly Act does not specifically authorize the class action mechanism, despite repeated proposals to so amend the Act. Accordingly, as fourteen New York courts to consider the question have concluded, and as the trial and appellate courts also concluded, a plaintiff cannot bring a class action law suit founded on New York antitrust law.

Sperry’s brief to this Court cannot evade the plain language of New York’s laws. Offering a grab bag of cases from various unrelated contexts, Sperry suggests that “penalty” does not include the antitrust treble damages remedy, even though such a remedy plainly penalizes the wrongdoer by authorizing damages beyond the actual damages caused by the conduct. Sperry also resorts to the “unjust enrichment” cause of action in a transparent effort to circumvent the statutory bar on state antitrust class actions. New York law prohibits assertion of an unjust enrichment cause of action where the claim is based on the same wrong as a statutory claim. Moreover, as the trial and appellate courts correctly concluded, Sperry’s unjust

enrichment claim fails because he lacks a direct relationship with the defendants.

Indeed, Sperry’s “relationship” with defendants highlights the fundamental defect of this suit. Sperry bought a tire that, he alleges, was made in a complex manufacturing and distribution process that at some point used small amounts of chemicals manufactured by defendants. This sort of highly attenuated connection to defendants does not meaningfully distinguish Sperry from any other consumer. The state antitrust laws do not permit such roving “consumer” law suits.

(from *Sperry v. Crompton*, 8 N.Y. 3d 204, 863 N.E.2d 1012 (2007))

The following is a sample introduction from a patent case:

### INTRODUCTION

In a detailed opinion reflecting careful consideration of the undisputed facts, an experienced district court judge, agreeing with the recommendation of an experienced magistrate judge, found that “Bayer’s case . . . became more anemic upon review of each piece of evidence,” and that its litigating positions—which “made no commercial sense” and was “contradicted” by Bayer’s “own witnesses as well as key documents”—stood out from the run-of-the-mill meritless action. A14, 26. The district court judge and magistrate judge further found that Bayer litigated the case in an unreasonable manner by conducting no investigation into the facts before filing its complaint, A27-29; by filing a frivolous motion for a preliminary injunction despite the fact that DAS was years away from selling anything allegedly infringing, A29-30; and by taking positions that it knew were contradicted by the evidence, A23-25.

Bayer’s opening appellate brief is a sly historical fiction. The problem for Bayer is not that “it read the relevant license for MS Tech to include only a gene-research license and not commercialization rights,” as Bayer suggests. OB 5. The problem for Bayer is the record evidence: there is no evidence to support the claim that anyone at Bayer or elsewhere thought at the time of the deal that MS Tech received only, and therefore could sublicense only, a gene-research license.

Indeed, Bayer’s in-house counsel, who negotiated the agreements on Bayer’s behalf, admitted as much when she testified that she “d[id]n’t have a specific memory,” before Bayer filed its lawsuit, of having thought MS

Technology, Inc. (MS Tech) could not commercialize (and therefore sublicense its commercialization rights to DAS) under its license from Bayer. A7453 (95:16-96:12). And while Bayer repeatedly cites to the testimony of its paid expert (e.g., OB 34-35), Bayer withheld key facts, A11,674 (174:11-25), prompting that district court to observe that the expert was not “so confident in [his] opinion without really knowing what the facts are.” A26 n.10 (citing A11,704-05 (205:19-206:18)). Bayer’s litigation position was “contrived lawyer argument,” A22, invented after the filing of this meritless suit. And that “contrived lawyer argument” required the Court to accept that although Bayer sought to get out of the soybean business, it retained valuable commercial rights at the request of the very companies to which it divested its soybean business. A18,325.

The actual evidence, by contrast, shows that MS Tech received a license to commercialize seeds, as well as the right to sublicense its commercialization rights. Even the Bayer executive who oversaw the deal thought “it was relatively black and white” that Bayer was divesting its patented technology for use in soybean crops, and that MS Tech and Stine Seed—another company that received a license from Bayer as part of the deal—could “make full use of them,” including by commercializing seeds. A16-17 (citing A4480-81 (61:23-62:8)). And Bayer’s in-house counsel

emphasized that Bayer did not care how MS Tech and Stine Seed structured the rights that Bayer divested. A4844 (97:7-24).

But instead of “inquir[ing] into the background or surrounding circumstances” of the agreements, Bayer chose to advance a “contorted reading.” A26. “Had Bayer done any due diligence, it would have learned that no witness supported Bayer’s construction . . . and this case . . . should never have been filed.” A27. Instead of doing any due diligence, Bayer chose “creative lawyering” and “contrived lawyer argument,” tactics that the district court concluded “did not trump the reality of the clear understanding between the parties.” A22-23 (internal quotation marks and citation omitted).

Throughout this litigation—including in its latest opening brief in this Court—Bayer has pretended not to see the mountains of evidence undermining its positions. But Bayer cannot hide from these facts—facts that Bayer would have uncovered with minimal presuit investigation. Judge Bumb and Magistrate Judge Schneider, both of whom lived with this case for years (after both presided over an earlier suit between the parties), were well positioned to determine whether this case was exceptional, and neither of them found it to be a close call. Their findings and conclusions deserve this Court’s deference, and the district court’s decision to award fees should be affirmed.

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## Mark Davies, Partner, Orrick, Herrington & Sutcliffe LLP

Mark Davies is co-head of the firm’s Supreme Court & Appellate Litigation practice.

Mark believes in Progress through persuasion. As a life-long early adopter of the latest technology, Mark has always believed in the promise of innovation. And as a believer in the justice embedded in the appellate process, Mark has time and time again persuaded Federal Circuit judges to rule for his clients.

Mark leads a team with spectacular credentials, deep expertise in intellectual property law, and that shares his belief in the client’s case. In the past few years, Mark has led Dow AgroSciences, EMC, NVIDIA, and Nintendo among others to victories that live out the Constitutional vision of a sound intellectual property regime. Mark feels lucky to have a legal practice he enjoys so much, one that combines his admiration for technological advances with enjoyment of the art of legal persuasion.

The author of the “user manual” for Federal Circuit appeals, Patent Appeals: The Elements of Effective Advocacy in the Federal Circuit (LexisNexis® Intellectual Property Law and Strategy Series, November 2017), Mark brings nearly twenty years’ of experience in intellectual property appeals, both in private practice and government. He was recognized in a Reuters special report as a member of the “elite cadre” of lawyers that are “the most influential members of one of the most powerful specialties in America: the business of practicing before the Supreme Court.” Reuters researched a field of 17,000 practitioners, identified a group of 75 who “have stood out – most for their success at getting cases before the high court,” and who “giv[e] their clients a disproportionate chance to influence the law of the land.”

As a member of the Appellate Staff of the Civil Division at the U.S. Department of Justice, Mark represented the U.S. Patent and Trademark Office, the Copyright Office, the International Trade Commission and other federal agencies before the Federal Circuit, other U.S. Courts of Appeals, and the U.S. Supreme Court.

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