Portfolio Media. Inc. | 860 Broadway, 6th Floor | New York, NY 10003 | www.law360.com
Phone: +1 646 783 7100 | Fax: +1 646 783 7161 | customerservice@law360.com

Appellate MVP: Orrick's Joshua Rosenkranz

By **Dan Packel**

Law360, Philadelphia (December 06, 2013, 3:26 PM ET) -- In a remarkably successful year for Orrick Herrington & Sutcliffe LLP partner Joshua Rosenkranz, persuading theU.S. Supreme Court that copyrighted goods could be imported without the copyright owner's authority was just one of the triumphs that landed him on Law360's list of 2013 Appellate MVPs.

Rosenkranz also won key battles for Morgan Stanley Smith Barney LLC and Apple Inc. in the past year. But his team's victory in front of the high court in the Kirtsaeng v.John Wiley & Sons Inc. case, helping to keep alive a $60 billion market for so-called gray-market goods, came at long odds.

Weighing in on the same issue in a separate case in 2010, the Supreme Court had split 4-4. Rosenkranz concluded, however, that the earlier deadlock arose because counsel had been overly concerned about a previous hypothetical posed by the court.

"We have a choice: Either we read the statute right or we indulge the court's prior statement, but we can't do both. We have to be prepared to tell the court that it was wrong," Rosenkranz said, describing the team's discussions. "What we did was very controversial among the stakeholders."

In Kirtsaeng, which considered whether federal copyright law's first-sale doctrine extended to products made outside the U.S., every circuit court to weigh the issue had already sided against Orrick's position. Additionally, all the major copyright treatises disagreed, as did the federal government.

Just as importantly, when the Supreme Court addressed the matter in the 2010 case, Costco Wholesale Corp. v. Omega SA, it split. Justice Elena Kagan had recused herself because as solicitor general, she had filed a brief arguing the opposite position.

"We had to either persuade Justice Kagan or flip a vote," Rosenkranz said. "Either one of those was very remote. What astounded court watchers was that we did both of these."

For Rosenkranz, the key to the 6-3 triumph was the recognition that pushing the clearest interpretation of the statute was more important than dwelling on a hypothetical raised by the court in the 1998 case Quality King Inc. v. L'Anza Research.

In oral argument in October 2012, he ultimately fielded the pivotal question from Justice Kagan.

"About two-thirds of the way in, she asked, 'You've got language from Quality King that is is a little

unfortunate for your position. Is your basic view of that passage that it was simply ill-considered dicta that we should ignore?'" Rosenkranz said. "'I responded, 'To put it bluntly, yes,' and I went on to explain why we should win the case anyway."

In August, Rosenkranz also won a critical victory for Apple in the multibillion-dollar smartphone wars, when the Federal Circuit ruled that the U.S. International Trade Commission had held erroneously that Apple's touch-screen patents were invalid and not infringed by Motorola Mobility Inc.

Apple had claimed that the Google Inc. unit's smartphones like the Droid and the Backflip infringed two "path-breaking" touch-screen patents it claimed were integral to the success of the iPhone, but the ITC ruled in favor of Motorola.

Rosenkranz also triumphed before the Ninth Circuit in April, when the appeals court affirmed the dismissal of a class action accusing Orrick client Morgan Stanley and two other banks of improperly blocking employees from trading securities using the services of other financial firms.

The financial institutions successfully argued that the federal law requiring brokerage firms to police against insider trading preempted a California statute that sought to prevent employers from requiring their employees to use in-house trading services.

Rosenkranz, who on Wednesday argued in front of the Federal Circuit for Oracle America Inc. in a $6 billion suit against Google Inc. for copyright infringement, emphasized that one of the keys to his success in appellate work is the use of metaphor and analogy.

"One of the things that wins cases where the law is unsettled and there is hard-to-understand technology is the battle of the metaphors," Rosenkranz told Law360. "It's who can come up with metaphor that best captures what the case is about."

A prime example is in the Oracle case — over whether Google's Android mobile operating system infringed Oracle's copyrighted Java software. His brief opens with a hypothetical tale of "Ann Droid," an author that copies much of "Harry Potter and the Order of the Phoenix" in order to create a best seller.

Rosenkranz's adversary Robert Van Nest of Keker & Van Nest LLP was forced to engage with the formulation at the hearing Wednesday.

"Obviously, as the court appreciates, this case concerns the command structure of a computer program, not a novel or a piece of literature." Van Nest told the court.

But the panel followed up with questions on the relationship between software and literature, and Rosenkranz's metaphor may easily reappear when the case is ultimately decided.

--Additional reporting by Scott Flaherty and Brian Mahoney. Editing by Kat Laskowski.
