PUTTING IN THE DEFENDANT'S CASE: TACTICAL, PRACTICAL AND STRATEGIC CONSIDERATIONS

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Introduction

When the time comes to put forward the defendant's case at trial, needless to say that preparation should be completed and all issues should be mastered by defendant's lead counsel. A patent trial leaves little room for improvisation and good advocacy often depends on excellent preparation. Deep and complete knowledge of even apparently insignificant details will be beneficial when the inevitable unexpected happens. Therefore, good physical arrangement of the trial "papers" (pleadings, exhibits, expert evidence, case law, factual summaries of witnesses anticipated statements, etc.) is important. Patent trials are long and technical, may involve many issues and the understanding of numerous documents. A patent is by itself difficult to read and understand for layman (patents are meant to be understood by persons knowledgeable in the art). Therefore, even for lawyers working in tandem, lead counsel should always have knowledge of all the facts (know where the stuff is in the boxes).

The following, if well prepared and accomplished with a purpose will provide a good foundation upon which the case can be built:

- The pleadings (Statement of Claim, Rule 400; Statement of Defence, Rule 402; Reply, Rule 403) should provide a precise statement of the material facts on which both parties will rely (Rules 408, 415). An issue which has not been pleaded is not an issue in the case (*J.M. Voight* v. *Beloit Corp.*, (1991), 36 C.P.R. (3d) 322).

- The Affidavit of Documents (Rule 447, ss.) will disclose all documentary evidence relevant to all matters in issue (see also Rule 407).

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Generally, only documents disclosed in an Affidavit of Documents or produced on examination for discovery may be used in evidence at trial (Rule 494.(7)b)).

- The examination for discovery (Rule 455, ss.), when all questions to advance a party's case or damage its opponent's case should have been asked.

- Expert affidavits (Rule 482). In patent cases, where focus in the case often first appears.

Before, final preparation commences, the tools provided by the Rules to narrow the issues should have been used (reference after trial, Rule 480; pre-trial conference, Rule 491).

The above should tell counsel what his party's case is and what is the case of the opposing party.

The opening statement

Before the Federal Court of Canada, pursuant to Rule 494.(1), a counsel, immediately before introducing any evidence, opens his case by making a short statement giving an outline of the facts that the party proposes to prove and the applicable law. The opening statement is important and should not be improvised. Under the Rules, the defendant's opening statement is supposed to be given when the plaintiff closes its evidence. However, if defendant's counsel hope that the court will understand anything as to the direction taken by his cross-examination of plaintiff's witnesses (especially expert witnesses), leave should be asked to make the defendant's opening statement immediately after the plaintiff's opening statement. Usually, leave is so granted by the court. Hereinafter are the essential qualities of a good opening statement:

- Short: Defendant's opening statement should not last more than 30 to 60 minutes. Plaintiff's counsel will probably have in his opening statement given to the court an understanding of the technology to which the patent relates. The opening statement is not the closing argument.

- Mostly factual: Even though a concise outline of the applicable law must be given, remember that the law on issues such as infringement, obviousness and anticipation (most common issues in patent cases) is static and known to the judges (often, both sides rely on the same case law). The applicability of the law will depend on the facts that will be proven.

- To the point: Not every facts likely to be proven should be commented upon. Put forward defendant's two best points for every issue and "advertised" them.

- Positive: Defendant's counsel should comment on the defendant's case in a positive fashion. As a defendant, you must show that your success will at least partly depend on the evidence you will present before you show that the plaintiff's case has weaknesses. As defendant's counsel, you must make sure that the "rotten guy principle" will not apply in your case and that any prejudice towards your client will disappear early on. Try to put the defendant's case in a broader context (for example, advantages of free competition to the public). The defendant is easily laballed as a copier attacking legitimate rights only to get off the hook.

- Interesting: Make promises you can deliver; make the judge aware of two or three key elements that that plaintiff would like to prove but will unlikely be able to prove; set up your closing argument.

Your opening statement should not be the equivalent of your closing argument. Therefore, no single aspect of your case should be over stated and be argued in details.

The defendant's witnesses

The Rules of the Federal Court simply state that witnesses at the trial of any action shall be examined *viva voce* and in open court (Rule 494.(5)). Witnesses in chief can only use documents referred to in the pleadings, the affidavit of documents or documents produced during the discoveries (Rule 494.(7)). Obviously, no particular order of witnesses is imposed by the Rules. Basic logical considerations apply:

- The flow of factual evidence should be, as much as possible, logical (when necessary, it should even be chronological (for example, issues relating to who was first to invent)).

- Have the witnesses under which you have no control testify first, especially those under subpeona. Witnesses will be in a better disposition if they

did not wait for two days in the corridor before giving their testimony.

- Short factual witnesses should be heard first if the logic of the testimony is safeguarded (arrangements can be made in advance with opposing counsels as to the timing of the various witnesses).

- Defendant's expert witnesses should be called when the facts upon which his opinion is sought are already proven. Focus on the case may be lost if too many opinions given by the experts depend on evidence of the underlying facts to be put forward later in the case.

- Usually, the defendant, or defendant's representative, should be heard last to "plug the holes", if any.

If the need arises, defendant's counsel should not hesitate to call the plaintiff or plaintiff's representative as his own witness. The plaintiff is adversed to the defendant's interest and may be cros-examined at will (Article 307, C.P.C., Quebec). Calling the opposing party as your first witness depending on the issues in the case may throw the other side off balance.

In preparing the defendant's witnesses and preparing the cross-examination of the witnesses you anticipate the other side will call, you must remember that your witnesses will have to say substantially what they said before or wrote before. As mentioned above, before trial, lead counsel should have a good knowledge of all prior statements given by any person likely to appear as a witness at trial.

Two to three months before trial, all witnesses should be met to go over the facts. Have them tell their story and avoid telling them what kind of story you would like to hear. Remind them of what they said or wrote before. Discuss all factual aspects of the case which they might have knowledge of. At that first formal meeting, you should not have a list of questions prepared. This should not be a final rehearsal of their testimony. You should rather have an extremely good knowledge of the factual aspects of your case and try to see if spontaniously, the facts given by the witnesses match the facts that you have knowledge of. You should not be afraid to explain to your witnesses, in general terms, what your case is and what you are trying to achieve with their testimony. It may not be necessary to do this with a witness testifying on a very simple question of fact, for example a witness called only to recognize a signature on a document or a witness testifying on a number of items sold to a particular outlet. Show your witnesses all exhibits that will be filed during their testimony.

The week before the trial, meet all your witnesses together and this time, have your questions ready. This should be final rehersal before trial. Ask your questions in the sequence you will ask them at trial. Listen carefully to what your witnesses are saying. Do not concentrate on the questions only since, up to a certain extent, they are not important. The answers are important since you cannot ask leading questions to your witnesses, make sure that the answers you are looking for are coming naturally without undue suggestion.

Your witnesses should be relax and natural. Explain how things are done in court, the various roles played by the people present and how the case will evolve. Tell them in advance that they might be excluded from the court room if the demand is made and that you may yourself make such a demand.

Witnesses are called to help the court, not you or your case. Make them feel the importance of their role, they will perform better.

Tell them in advance that most likely, they will be cross-examined by counsel for the other side. Explain how a cross-examination is conducted and the purpose of it. Witnesses should be told to listen carefully to the questions asked and the suggestions made. Tell them that they do not have to agree automatically with the suggestions made just to please everybody. Explain that when they do not know or remember a fact, "I don't remember" and "I don't know" are acceptable answers when the whole of the testimony is credible. Witnesses, by nature, feel that they must answer every questions asked, because they think it is their duty.

Often, witnesses you do not control must be called. Some will refure to see you before trial. The testimony of these witnesses must be prepared very carefully. Being your own witnesses, leading questions will not be permitted unless the witness is considered hostile to your case by the court. Only essential questions must be asked. Open ended questions are to be avoided. The testimony of these witnesses should be short. Prepare a list of the facts that you want this witness to establish, look for your answer and if you get it, leave the subject. Once you have a satisfactory answer, do not look for more. You may spoil what you have.

Cross-examinations should be prepared before trial and adapted after the evidence is heard in court. Know in advance what you want to achieve, isolate the statements you wish to contradict or of which you wish to diminish the impact. Do not cross-examine on every small points or even on something you know to be untrue if it does not hurt your case, unless you want to attack the credibility of the witness. Generally, you will have a good idea of the identity of the witnesses the other side will call and, as for your own witnesses, you should have statements in various forms concerning the issues on which they will testify.

Even if you do not know the identity of the witness that will testity on a particular issue, prepare a cross-examination on the issue rather than of a witness in particular.

Always be concious of the person you are cross-examining. You do not deal in the same manner with an old lady as you do with a mature business woman. This may seem obvious, but I have seen many lawyers having gone too far with a witness and finding themselves with a crying old lady and a mad judge.

What evidence should be lead in chief and rebuttal

In preparing your witnesses and your case, take into consideration the applicable burden of proof in patent cases. The patentee benefit from a presumption of validity of its patent. All you must prove is infringement. If there is litteral infringement (if defendant's product "reads" on the claims) and if that was established during discovery, the evidence in chief may be very short and counsel for the plaintiff may rest his case before the end of the first day of trial.

If establishing infringement requires interpretation of the patent, evidence might have to be lead by the plaintiff with respect to the significance of certain words or expressions found in the patent and the working of certain parts of the defendant's apparatus. In that case, be attentive. The significance of words and expressions used in the patent, as explained by plaintiff's expert, will remain constant and also applied to your defence of invalidity, where the burden of proof rest squarely on the defendant's shoulders.

Conclusion

Being well prepared enhance your chances of winning the case for your client. Also, and it is of some importance, if you are well prepared, you will be relax and will perform better.