Trial Court Procedures in Patent Litigation:

Maximizing Chances of Success on Appeal

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I. Introduction

Appeals begin at trial, and they can be won or lost there. Whether making a strategic decision not to object to a piece of evidence or inadvertently failing to preserve an issue for appeal, countless decisions and oversights made during trial can make or break an appeal. Thus, a wise litigator cannot be single-minded; he or she must always appreciate the potential implications accompanying each choice made at trial. And more fundamentally, he or she must recognize each choice that needs to be made.

This article seeks to provide insight into what issues to look for at trial, as well as how to address them. It highlights many of the most common procedural traps for unwary litigators, including filing interlocutory appeals, notices of appeal, and post-trial motions (including motions for judgment as a matter of law ("JMOL"), motions for new trial, motions to amend a judgment, motions for relief from judgment, motions for stay pending appeal, and motions to reconsider). Before delving into the details, however, this article provides some basic, overarching principles, illustrating them with some fairly uncommon situations and procedures that can snare even the most attentive litigators.

II. Retain Appellate Counsel to Assist During Post-Trial Proceedings

A. Raise and Preserve Issues for Appeal

Appellate courts review the decisions of trial courts based on the factual record developed below and generally do not review issues not first presented during trial. Thus, a party may seriously limit its options available on appeal by failing to raise an issue at trial. Usually there are trade-offs associated with deciding whether to raise an issue. Those should be evaluated carefully. Far too often, however, short-sighted litigators never examine those trade-offs at all. In fact, many fail to recognize that such an issue even exists, allowing it simply to pass unnoticed. By the time the issue finally comes into clear view on appeal, the courts cannot address it. Thus, in a very real sense, preparing for an appeal begins in the district court. A careful practitioner will therefore be sure to consider all options and their associated risks as the trial progresses. Collaborating with an experienced appellate litigator during the district court proceedings is perhaps the best way to ensure that no option goes unexplored. Keeping that in mind, much of this article is devoted to the basics that every trial practitioner should know. And the most basic tenet is that a practitioner should properly raise and preserve issues for appeal.

Note, however, that limited means exist to attempt to raise issues and present evidence *not* initially presented to the trial court. For example, when a trial court renders its decision on summary judgment, the adversely affected party may request reconsideration to provide further evidence or legal arguments.[1] If the trial court denies that request but considers it on the merits, at least one may reasonably argue to the Federal Circuit that it should consider the new evidence and arguments on appeal. On the other hand, the opposing party should argue waiver to avoid waiving the waiver issue.

As another example, the Federal Circuit may take judicial notice of certain adjudicative facts not presented to the trial court.[2] In general, such evidence must be universally known or

[1] *See infra* Section V (discussing Rule 60(b)).
[2] FED. R. EVID. 201.

widely available to the public.[3] For example, the Federal Circuit has taken judicial notice of, *inter alia*, dictionary definitions, the MPEP, court orders, common knowledge, and PTO decisions.[4] Outside of these limited avenues, however, one should not expect the Federal Circuit to consider claims or evidence either waived or not presented in the district court. Wise practitioners should abandon any such claim or evidence before the trial court only for sound, strategic reasons, not oversight.

B. Offer Sufficient Evidence to Support the Trial Court's Factual Findings on Appeal

A party failing to introduce sufficient evidence during trial may suffer the consequences on appeal. Because appellate courts do not review evidence not introduced during trial, the evidentiary record developed at trial must be adequate to sustain the trial court's decision. Yet trials (especially jury trials) typically call for simplified and efficient presentations of evidence. Clearly, a fundamental tension exists between those two objectives. That tension is particularly palpable when the evidence is highly technical or when its presentation is very involved.

Although to some extent such issues may be resolved by effectively using evidence summaries,[5] evidence summaries are not a panacea for diffusing the tension between obtaining an optimal evidentiary record for appeal and winning a jury verdict. Note that an effective advocate must not only introduce favorable evidence *into* the record, but must also attempt to keep unfavorable evidence *out*. Trade-offs are inherent in those latter efforts as well. For example, consider an opposing counsel who makes an evidentiary error that introduces information harmful to your position. Meanwhile, the judge and jurors appear inattentive and anxious for a reprieve from opposing counsel's presentation. They probably did not understand opposing counsel's point anyway. Objecting, particularly if the error was minor, may appear obstructionist. Depending on the severity of the mistake, objecting may or may not be wise. How to resolve the tension is not necessarily obvious.

It is therefore important to note that the Federal Circuit almost never reverses a district court's evidentiary rulings.[6] Not only must a party challenging such a ruling show both abuse of discretion and substantial prejudice,[7] it must do so in light of the trial court's "great latitude in passing on the admissibility of evidence."[8] Similarly, the Federal Circuit is extremely unlikely to interfere with a district court's discovery ruling. Knowing those trends simplifies certain decisions, but it does not eliminate the inherent trade-offs involved. And much to their detriment, many practitioners only recognize one side of the equation. They only think about

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[3] *See id.* 201(b) ("A judicially noticed fact must be one not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.").

[4] *See* Enzo Biochem, Inc. v. Gen-Probe Inc., 323 F.3d 956, 964 (Fed. Cir. 2002) (taking judicial notice of the MPEP); Genentech, Inc. v. Int'l Trade Comm'n, 122 F.3d 1409, 1417 n.7 (Fed. Cir. 1997) (taking judicial notice of a court's order); Hoganas A.B. v. Dresser Indus., 9 F.3d 948, 954 n.27 (Fed. Cir. 1993) (taking judicial notice of a patent not submitted to the trial court); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 897 F.2d 511, 514 n.3 (Fed. Cir. 1990) (taking judicial notice of a PTO correspondence which was part of the public record); BVD Licensing Corp. v. Body Action Design, Inc., 846 F.2d 727, 728 (Fed. Cir. 1988) ("Courts may take judicial notice of facts of universal notoriety, which need not be proved, and of whatever is generally known within their jurisdictions." (quoting Brown v. Piper, 91 U.S. (1 Otto) 37, 42 (1875)); Kimberly-Clark Corp. v. Johnson & Johnson, 745 F.2d 1437, 1447 (Fed. Cir. 1984) ("If necessary, we take judicial notice that a 'pressure sensitive adhesive' is permanently tacky" (footnote omitted)).

[5] *See* FED. R. EVID. 1006.

[6] *See, e.g.*, Chiron Corp. v. Genentech, Inc., 363 F.3d 1247, 1260–61 (Fed. Cir. 2004).

[7] *Id.* at 1260.

[8] United States v. Kearney, 560 F.2d 1358, 1369 (9th Cir. 1977).

what can be gained at trial, not what may be given up on appeal. By the time the other half of the equation comes into view, it is too late to reverse course. The issue will have been permanently waived. Although every detail need not find its way into the record, attentive counsel should always remember to ensure the basic sufficiency of the record.

C. Avoid Waiver

As noted above, appellate courts review the decisions of trial courts based on the factual record developed below. As a corollary to that principle, if a party does not notify the trial judge when it believes that the trial court has erred, that party generally cannot later raise the issue on appeal. Rather, it should give notice to the trial court of any alleged defect so that the court has an opportunity to rectify its own errors in the first instance.[9] Thus, failing to point out an alleged error made by the district court during trial may waive relying on that error on appeal.

Waiver can occur in many ways. For example, a party may fail to object to a jury instruction or to the admission of a certain piece of evidence. Or a party may fail to file a timely motion for JMOL or for a new trial. Avoiding waiver can often mean the difference between success and failure on appeal. The prospect of waiver should therefore be a factor in every decision made while proceeding in the district court. And whenever a party does waive an issue, it should be both voluntary and for a sound strategic purpose.

D. Avoid Mistakes and Raise Issues or Introduce Evidence That Might Otherwise Not Be Raised

1. Mandamus

The All Writs Act,[10] which dates back to the Judiciary Act of 1789, permits a party to approach the Federal Circuit for relief by way of writ at any time during the pendency of its case in the district court. One such writ—the writ of mandamus—can ask the Federal Circuit to compel a district court judge to perform a ministerial act or duty.[11] Of course, mandamus is not referred to as an "extraordinary writ"[12] without reason. "The remedy of mandamus is a drastic one, to be invoked only in extraordinary situations."[13] Accordingly, to qualify for a writ of mandamus, a party must demonstrate that it "lack[s] adequate alternative means to obtain the relief [it] seek[s]" and "that [its] right to issuance of the writ is 'clear and indisputable.'"[14] In other words, a mandamus order is justifiable only in "exceptional circumstances amounting to a judicial 'usurpation of power.'"[15]

Note, however, that several issues frequently arising in patent litigation may, on occasion, merit a mandamus order. One such issue is an order to transfer a case, either by the trial court pursuant to 28 U.S.C. § 1404(a) or by the Judicial Panel on Multi-District Litigation pursuant to

[9] *See* Eli Lilly & Co. v. Aradigm Corp., 376 F.3d 1352, 1361 (Fed. Cir. 2004) ("[O]bjections point out to a district court its alleged error so that the district court has the first opportunity to correct the error." (citing Palmer v. Hoffman, 318 U.S. 109, 119 (1943)).
[10] 28 U.S.C. § 1651(a) (2006).
[11] Marbury v. Madison, 5 U.S. 137, 157 (1803).
[12] Will v. United States, 389 U.S. 90, 98 (1967).
[13] Kerr v. United States Dist. Court, 426 U.S. 394, 402 (1976) ("The remedy of mandamus is a drastic one, to be invoked only in extraordinary situations.").
[14] Mallard v. United States Dist. Court, 490 U.S. 296, 309 (1989).
[15] *Will*, 389 U.S. at 95.

28 U.S.C. § 1407. Because such transfer orders are not appealable, petitions for writ of mandamus are the only way to obtain review. An interesting trend has emerged recently: Despite historically granting very few writs of mandamus on those grounds, the Federal Circuit has targeted the Eastern District of Texas, issuing nine such writs there in the past three years.[16] Meanwhile, it issued no similar writs in other districts. Because the Eastern District of Texas is often regarded as a particularly plaintiff-friendly district,[17] a party accused of infringement in that venue should consider a motion to transfer under § 1404(a), followed if necessary by a petition for writ of mandamus in the Federal Circuit.

A writ of mandamus may also be appropriate when challenging trial court rulings on the disclosure of privileged information. Mandamus is appropriate in such matters when "(1) there is raised an important issue of first impression, (2) the privilege would be lost if review were denied until final judgment, and (3) immediate resolution would avoid the development of doctrine that would undermine the privilege."[18]

A writ of mandamus may also be appropriate to challenge a trial court's decision to grant or deny a motion to disqualify a party's counsel. Like all mandamus orders, these are rare.

Although the foregoing highlights the three primary uses for mandamus petitions in patent litigation, others certainly exist. Again, a petition for a writ of mandamus can ask the Federal Circuit to compel a district court judge to perform a ministerial act or duty.[19] Thus, any time a district court clearly fails to perform its duties, a writ of mandamus may be appropriate.

For example, following judgment, a judge once ordered that "no party in this case [may] file anything further before this Court."[20] That placed the aggrieved party in a precarious position. It could either file post-trial motions to preserve its right to appeal, risking a contempt charge, or it could comply with the judge's order and sacrifice its ability to appeal. Instead of making that impossible choice, the aggrieved party petitioned for a writ of mandamus with the Federal Circuit, requesting that the prohibitive part of the judge's order be vacated. The Federal Circuit granted the petition, freeing the aggrieved party to file post-trial motions without any danger of a contempt charge.

Recently, the Federal Circuit issued a writ of mandamus ordering the district court to dismiss a plaintiff's complaint under the False Markings Statute[21] with leave to amend.[22] The district court had applied the heightened pleading standards of Rule 9(b) to the complaint, but it denied the defendant's motion to dismiss the claim for insufficiency under those standards. The Federal Circuit first addressed the issue of whether Rule 9(b) applied. After deciding that it did, the court agreed with the petitioner that the plaintiff's complaint was inadequate under Rule 9(b).

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[16] *See In re* Stanley, Nos. 2011-m962, -m964, -m967 (Fed. Cir. Apr. 6, 2011) (per curiam) (nonprecedential); *In Re* Verizon Bus. Network Servs., Inc., No. 2011-m956, 2011 WL 1026623 (Fed. Cir. Mar. 23, 2011); *In re* Acer America Corp., 626 F.3d 1252 (Fed. Cir. 2010); *In re* Microsoft Corp., 630 F.3d 1361 (Fed. Cir. 2010) (per curiam); *In re* Zimmer Holdings, Inc., 609 F.3d 1378 (Fed. Cir. 2010); *In re* Nintendo Co., 589 F.3d 1194 (Fed. Cir. 2009); *In re* Hoffmann-La Roche, Inc., 587 F.3d 1333 (Fed. Cir. 2009); *In re* Genentech, Inc., 566 F.3d 1338 (Fed. Cir. 2009); *In re* TS Tech USA Corp., 551 F.3d 1315 (Fed. Cir. 2008).

[17] *See* Julie Creswell, *So Small a Town, So Many Patent Suits*, N.Y. TIMES, Sept. 24, 2006 § 3, at 1 ("Among the weightier issues behind the mushrooming of [the Eastern District of Texas's] patent docket is whether the elements that have made it expand—hungry plaintiffs' lawyers, speedy judges and plaintiff-friendly juries—are encouraging an excess of expensive litigation that is actually stifling innovation.").

[18] *In re* Regents of Univ. of California, 101 F.3d 1386, 1388 (Fed. Cir. 1996) (citing Schlagenhauf v. Holder, 379 U.S. 104, 110 (1964)); *see also generally In re* EchoStar Commc'ns Corp., 448 F.3d 1294 (Fed. Cir. 2006); *In re* Pioneer Hi-Bred Int'l, Inc., 238 F.3d 1370 (Fed. Cir. 2001); *In re* Spalding Sports Worldwide, Inc., 203 F.3d 800 (Fed. Cir. 2000).

[19] *Supra* note 11.

[20] Order, *In re* Halliburton Co., Misc. No. 371, 1993 WL 118929, at *1 (Fed. Cir. Mar. 12, 1999).

[21] 35 U.S.C. § 292 (2006).

[22] *In re* BP Lubricants USA, Inc., Misc. No. 960, slip op. at 11 (Fed. Cir. Mar. 15, 2011).

The court emphasized two primary reasons for issuing the writ. First, "trial courts ha[d] been in considerable disagreement on th[e] issue [of the applicability of Rule 9(b) to false marking allegations], resulting in inconsistent results across the country."[23] Second, it was a "basic and undecided" question in the Federal Circuit.[24] Under analogous circumstances, a writ of mandamus may also be appropriate.

2. Spectator Evidence of Jury Prejudice

Sometimes critical issues and evidence may not be clear from the record. The intangibles of the courtroom atmosphere will seldom appear in the record unless an attorney makes sure that they are documented and entered into evidence. An example illustrates this point.[25] During one jury trial, an attorney erroneously included in his question the wrong month for a date of disclosure. While seated at the counsel's table, Halliburton's corporate counsel (and a key witness) shook his head several times, gestured, and mouthed protests regarding the erroneous date. The trial judge (the same trial judge compelled by mandamus to permit post-trial motions) believed corporate counsel was coaching the witness and admonished him, although unintentionally, within hearing of the jury, banishing him from the trial and from Galveston, TX.[26] In truth, a large exhibit blocked the view between the witness and Halliburton's corporate counsel so that they could not see one another at all. Yet the jury saw and heard the judge's admonition and subsequently found that Halliburton had willfully infringed the plaintiff's patent. Without proper corroboration from spectators, those prejudicial events would have gone undocumented on the record, or at least the record would have appeared very one-sided. To remedy the situation, Halliburton's trial team obtained sworn affidavits from courtroom spectators and entered them into the evidentiary record. They later used that evidence to move for a new trial during post-trial briefing. The Federal Circuit reversed the jury verdict, ruling that no reasonable jury could have found infringement.[27] Atmospheric evidence of this sort that may help to demonstrate jury prejudice can be vital, and it should not be overlooked when appropriate.

3. Motion for Reconsideration May Be Too Late

Rule 59(e) permits a party to request that the trial court reconsider and amend its judgment. However, a party has only twenty-eight days from the entry of an adverse judgment to file a Rule 59(e) motion,[28] and extensions are unavailable.[29] It is therefore critical to file a motion to reconsider within the allotted time frame and before stripping the district court of jurisdiction by filing a notice of appeal. In one example, a small company was a declaratory judgment defendant that responded to a motion both for attorney fees and to dismiss its infringement counterclaim by opposing only the motion to dismiss. The court then entered a

[23] *Id.*
[24] *Id.*
[25] *See generally* Brief for Appellant Halliburton Co., Wardlaw v. Halliburton Co., 1994 WL 592561 (Fed. Cir. Aug. 9, 1993) (No. 93-1322).
[26] *See id.* at 23 ("I won't have anybody in my courtroom flagging answers to a witness on my stand. That is subordination of perjury, and I will have you indicted for that kind of thing. You're going to get the hell out of my courtroom now. You will vacate these premises. You are not going to be in this trial again. Do you understand me?").
[27] Wardlaw v. Halliburton Co., No. 93-1322, 1994 WL 592561, at *6 (Fed. Cir. Oct. 31, 1994).
[28] FED. R. CIV. P. 59(e).
[29] *Id.* 6(b)(2).

judgment dismissing the infringement counterclaim and awarding attorney fees against it in the district court.[30] The company immediately filed a notice of appeal, but the Federal Circuit stayed the appeal pending the district court's determination of the amount of attorney fees owed. After the district court ruled on the amount—$537,541,60 against a defendant with only $1M in annual sales—the plaintiff filed a motion to enter the judgment. At the end of the period for response, the court granted the plaintiff's motion. Although the defendant's attorneys then responded by filing a motion to amend the judgment, arguing for the first time that awarding attorney fees was erroneous, it was too late. As the district court noted, the company essentially made "an overdue motion for reconsideration and ask[ed] the Court to overrule its prior decision."[31] The Federal Circuit agreed, ruling that the first appeal "divested the district court of jurisdiction over the fee award."[32]

4. Avoid Waiving Waiver

Waiver occurs when a party fails to preserve or raise an issue in the trial court within the proper time frame. One must be careful not to miss an opportunity to point out when the opposition is trying to revive an issue it has already waived. Missing such an opportunity can lead to a waiver of the waiver. For example, consider an opponent that states during trial that it has no objection to a particular jury instruction. Later, during post-trial motions, that opponent changes its mind and alleges that the instruction was erroneous. If one fails to point out the opponent's prior waiver in a response, the trial court may grant the opponent's motion, either failing to spot the issue or simply refusing to raise it *sua sponte*. As another example, consider that to move for judgment as a matter of law after a jury verdict a party must have moved on the same grounds before the case was presented to the jury. If an adversely affected party files a post-verdict motion without having filed the corresponding prerequisite motion, the nonmoving party can waive the defect by failing to point out the movant's prior waiver. Moreover, because the waiver will not have been raised before the district court, one can be precluded from raising the waiver on appeal. Although fairly infrequent, this issue can—and certainly does—arise.[33] Thus, in addition to paying attention to one's own potential waivers, a careful practitioner will also keep a watchful eye out for an opponent's waivers.

III. Motions for JMOL

Rule 50 governs motions for judgment as a matter of law. There are two basic types of Rule 50 motions: pre-verdict motions for JMOL under Rule 50(a) and *renewed* (post-verdict) motions for JMOL under Rule 50(b). A pre-verdict motion for JMOL under Rule 50(a) asks a

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[30] *See generally* L.E.A. Dynatech, Inc. v. Allina, 49 F.3d 1527 (Fed. Cir. 1995) (affirming the district court); Order Denying Defendants/Counter-Plaintiffs' Motion to Amend April 30, 1993 Order Granting Dismissal and Fees, L.E.A. Dynatech, Inc. v. Allina, No. 91-219-CIV-T-17B (M.D. Fla. Apr. 14, 1994); Defendants/CounterPlaintiffs' Motion to Amend April 30, 1993 Order Granting Dismissal and Fees, L.E.A. Dynatech, Inc. v. Allina, 91-219-CIV-T-17B (M.D. Fla. March 8, 1994).

[31] Order Denying Defendants/Counter-Plaintiffs' Motion, *supra* note 30, at 3.

[32] *L.E.A. Dynatech*, 49 F.3d at 1531.

[33] *See, e.g.*, United States v. Delgado-Garcia, 374 F.3d 1337, 1340 (D.C. Cir. 2004) ("[T]hese pleas waived all of appellants' claims. However, the government does not advance the argument that the unconditional pleas waived appellants' claim . . . . The government has thus waived its waiver argument on that point."); United States v. Hollingsworth, 27 F.3d 1196, 1203 (7th Cir. 1994) (en banc) ("If Hollingsworth waived entrapment by putting all his eggs in the 'fundamental fairness' basket—and maybe he did waive it—the government bailed him out by waiving waiver."); United States v. Malin, 908 F.2d 163, 167 (7th Cir.) (finding that the government had waived waiver to objections involving evidence and jury instruction), *cert. denied*, 498 U.S. 991 (1990).

court to rule that "a reasonable jury would not have a legally sufficient evidentiary basis to find for the [non-moving] party on that issue."[34] Because the Seventh Amendment prevents a court from re-examining factual determinations made by a jury, Rule 50(a) motions may be filed only *before* the case has been submitted to a jury.[35] Moreover, a Rule 50(a) motion may be made only *after* a party has been fully heard on an issue.[36] Thus, a movant may properly request JMOL under Rule 50(a) at only two points during trial: (1) immediately following the close of the plaintiff's case and (2) immediately after the close of all evidence.[37] As indicated above, filing a proper Rule 50(a) motion during trial is critical because failing to do so will eliminate the option of filing a renewed motion for JMOL under Rule 50(b) after trial, absent a waiver by the nonmoving party. And filing a renewed Rule 50(b) motion is what enables the trial court's denial of a motion for JMOL to serve as the basis for an appeal.

Following an adverse jury decision, one should promptly consider filing a renewed motion for JMOL under Rule 50(b). A Rule 50(b) motion is appropriate where no reasonable jury could have reached its conclusion based on a proper application of the law to the facts in evidence. Once a party has filed a proper Rule 50(b) renewed motion for JMOL, the trial court may simply let the prior judgment stand, or it may direct entry of judgment as a matter of law.[38] If the trial court lets the prior judgment stand, the movant may appeal. The trial courts and the Federal Circuit all apply the same standards of review to Rule 50(b) motions.[39] Both review the jury's factual determinations for substantial evidence, and the Federal Circuit does so *de novo*.[40] Substantial evidence exists when reasonable minds can come to the conclusion at issue after examining evidence taken from the record as a whole.[41] Only when a court is convinced that reasonable persons could not have reached a verdict for the non-moving party should it grant a motion for JMOL.[42] In conducting that inquiry, "the trial court must consider all the evidence in a light most favorable to the non-mover, must draw reasonable inferences favorable to the non-mover, must not determine the credibility of witnesses, and must not substitute its choice for that of the jury."[43] If a minimum quantum of evidence exists from which a jury might reasonably have reached its conclusion, a motion for JMOL based on jury error must be denied.[44]

When filing motions for JMOL, the prudent practitioner must take care to avoid several traps for the unwary. For example, a post-trial motion for JMOL under Rule 50(b) is improper unless the movant initially filed a Rule 50(a) motion during trial. Because a Rule 50(b) motion is

[34] FED. R. CIV. P. 50(a)(1).
[35] *See, e.g.*, Duro-Last, Inc. v. Custom Seal, Inc., 321 F.3d 1098, 1107 (Fed. Cir. 2003) ("In view of a litigant's Seventh Amendment rights, it would be constitutionally impermissible for the district court to re-examine the jury's verdict and to enter JMOL on grounds not raised in the pre-verdict JMOL.").
[36] FED. R. CIV. P. 50(a)(1).
[37] *Cf. id.*; Echeverria v. Chevron USA, Inc., 931 F.3d 607, 612 (Fed. Cir 2004) ("Because the purpose of Rule 50 is, in part, to weigh the sufficiency of the evidence before the case is submitted to the jury, it is essential that the nonmoving party be permitted to present all of its evidence.").
[38] FED. R. CIV. P. 50(b).
[39] DSU Med. Corp. v. JMS Co., 471 F.3d 1293, 1309 (Fed. Cir. 2006) ("[The Federal Circuit] reviews a trial court's JMOL rulings after a jury verdict by reapplying the district court's own standard.").
[40] Jurgens v. McKasy, 927 F.2d 1552, 1557 (Fed. Cir. 1991) ("We first presume that the jury resolved the underlying factual disputes in favor of the verdict winner and leave those presumed findings undisturbed if they are supported by substantial evidence. Then we examine the legal conclusion *de novo* to see whether it is correct in light of the presumed jury fact findings." (internal citations omitted)).
[41] Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 893 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 857 (1984).
[42] *Id.*
[43] *Id.*
[44] Odetics, Inc. v. Storage Techs. Corp., 185 F.3d 1259, 1269 (Fed. Cir. 1999).

technically just a renewal of its a Rule 50(a) motion,[45] the former cannot exist without the latter. For the same reason, the Rule 50(b) motion cannot contain any issues not raised in the initial Rule 50(a) motion.[46] Accordingly, a party must file a new Rule 50(a) motion at the close of all evidence if it has introduced any new evidence subsequent to filing an earlier Rule 50(a) motion.[47] The new evidence cannot be re-examined on review otherwise. A Rule 50(a) motion must also be specific enough to allow the non-moving party an opportunity to cure any defects in proof that might otherwise preclude it from taking the case to the jury.[48] The motion should specify the judgment sought, as well as both the law and the facts that entitle the movant to the judgment.[49] And finally, a party must actually remember to renew its pre-verdict motion for JMOL on time. The Rules set the deadline at twenty-eight days from verdict entry,[50] and extensions are not permitted.[51] If a party files a Rule 50(b) motion outside of that time frame, the trial court's denial of the earlier Rule 50(a) motion cannot form the basis of an appeal.[52] All related issues would be considered waived.

Thus, if contemplating an appeal, best practices dictate that one should: (1) always file a Rule 50(a) motion for JMOL following the close of all evidence, even if one filed an earlier Rule 50(a) motion; (2) be specific regarding the judgment sought, as well as the facts and law that entitle the movant to JMOL; (3) be sure to include in the Rule 50(a) motion all issues that may warrant consideration on appeal; and (4) make sure to file the Rule 50(b) motion within twenty-eight days of the verdict.

IV. Motions for New Trial

When renewing a motion for JMOL, one should also move, in the alternative, for a new trial under Rule 59. If a court grants a renewed motion for JMOL under Rule 50(b), it must also conditionally rule on any motion for a new trial.[53] The trial court may grant a new trial motion at its discretion if the judge believes that the verdict clearly contradicted the evidence in the case[54] or if a prejudicial error affected the outcome of the case.[55] But note that a conditional new trial order does not affect the finality of the judgment;[56] it simply serves as a fallback option—an

[45] *See* FED. R. CIV. P. 50(b) ("If the court does not grant a motion for judgment as a matter of law made under Rule 50(a), the court is considered to have submitted the action to the jury subject to the court's later deciding the legal questions raised by the motion."); *supra* note 35 and accompanying text.
[46] *See generally* Duro-Last, Inc. v. Custom Seal, Inc., 321 F.3d 1098 (Fed. Cir. 2003) (refusing to review an obviousness issue because the appellant did not raise the issue in its Rule 50(a) motion).
[47] *See* Johnson v. Bekins Van Lines Co., 808 F. Supp. 545, 547 (E.D. Tex. 1992) ("[A] motion [for JMOL] may be made at the close of the evidence offered by the movant's opponent, but if the movant later introduces evidence, then the motion must be renewed at the close of all evidence."), *aff'd mem.*, 995 F.2d 221 (5th Cir. 1993), *cert. denied*, 510 U.S. 977 (1993).
[48] *Duro-Last*, 321 F.3d at 1105.
[49] FED. R. CIV. P. 50(a)(2).
[50] *Id.* 50(b).
[51] *Id.* 6(b)(2). Rule 50(b) motions are tied to Fed. R. App. P. 4, thereby implicating the appellate timeline. That is why extensions are not permitted.
[52] *See* Unitherm Food Sys., Inc. v. Swift-Eckrich, Inc., 546 U.S. 394, 401 (2006) ("[T]he 'requirement of a timely application for judgment after verdict is not an idle motion' because it 'is . . . an essential part of the rule, firmly grounded in principles of fairness.'" (quoting Johnson v. New York, New Haven & Hartford R.R. Co., 344 U.S. 48, 52 (1952))).
[53] FED. R. CIV. P. 50(c)(1).
[54] Gasperini v. Center for Humanities, Inc., 518 U.S. 415, 433 (1996) ("'The trial judge in the federal system,' we have reaffirmed, 'has . . . discretion to grant a new trial if the verdict appears to [the judge] to be against the weight of the evidence.'" (alterations in original) (quoting Byrd v. Blue Ridge Rural Elec. Coop., 356 U.S. 525, 540 (1958))).
[55] R.R. Dynamics, Inc. v. A. Stucki Co., 727 F.2d 1506, 1511 (1984) ("[Under the circumstances of this case], review for sufficiency of evidence is extremely limited or non-existent, [and] prejudicial legal error must be shown to have occurred in the conduct of the trial.").
[56] FED. R. CIV. P. 50(c)(2).

insurance policy of sorts. If an appellate court reverses the JMOL without a conditional new trial order in place, the original verdict will be left intact. On the other hand, if a conditional new trial order is in place, the remedy is a new trial. Thus, filing an alternative Rule 59 motion for a new trial is wise when filing a Rule 50(b) motion.

Although conditional new trial motions should be filed in conjunction with Rule 50(b) motions, new trial motions are themselves more widely applicable. In particular, they can be quite useful when new evidence is discovered, or when challenging erroneous jury instructions or excessive damages. Following an action tried without a jury, Rule 59 enables the trial court to "open the judgment if one has been entered, take additional testimony, amend findings of fact and conclusions of law or make new ones, and direct entry of a new judgment."[57] Analogously, following an action tried before a jury, a court may grant a new trial motion "where the verdict is against the weight of the evidence, damages are excessive, or the trial was not fair to the moving party for some other reason."[58] Moreover, a court may order a new trial, *sua sponte*, "for any reason that would justify granting one on a party's motion."[59] Like Rule 50(b) motions, new trial motions under Rule 59 must be filed within twenty-eight days of judgment,[60] and extensions are not available.[61]

Like most matters discussed in this article, new trial motions do not involve matters unique to patent law. They are therefore governed by the law of the regional circuit in which the trial court resides.[62] Nevertheless, the relevant laws "appear[] to be common to all circuits."[63] For example, a party challenging a jury instruction must show that the instruction was prejudicial.[64] In the Federal Circuit, a party must show that "(1) it made a proper and timely objection to the jury instructions, (2) those instructions were legally erroneous, (3) the errors had prejudicial effect, and (4) it requested alternative instructions that would have remedied the error."[65]

As the foregoing implies, one must be careful to preserve grounds for a new trial. For example, if a party forgets to make proper objections to jury instructions under Rule 51, it will be precluded from seeking a new trial on the basis of those instructions.[66] Thus, a careful practitioner will be sure to preserve all grounds that may potentially warrant a new trial.

V. Motions to Amend Findings

Rule 52 motions are post-judgment motions regarding findings and conclusions made by a court, as opposed to by a jury.[67] They often accompany Rule 59 motions for new trial[68]

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[57] *Id.* 59(a)(2).
[58] Oscar Mayer Foods Corp. v. Conagra, Inc., 869 F. Supp. 656, 660 (W.D. Wis. 1994), *aff'd on other grounds*, 45 F.3d 443 (Fed. Cir. 1994), *cert. denied*, 516 U.S. 812 (1995).
[59] FED. R. CIV. P. 59(d).
[60] *Id.* 59(b), (d), (e).
[61] *Id.* 6(b)(2). Rule 59(b), (d), and (e) motions are tied to Fed. R. App. P. 4, thereby implicating the appellate timeline. That is why extensions are not permitted.
[62] Mentor H/S, Inc. v. Med. Device Alliance, Inc., 244 F.3d 1365, 1374 (Fed. Cir. 2001).
[63] Vulvan Eng'g Co. v. Fata Aluminum Co., 278 F.3d 1366, 1379 (Fed. Cir. 2002).
[64] Biodex Corp. v. Loredan Biomed., Inc., 946 F.2d 850, 853–54 (Fed. Cir. 1991) ("There is no dispute among the circuits, nor in our own jurisprudence, that a judgment should be altered 'because of a mistake in jury instructions only if the error was prejudicial' and that we must 'look to the entire jury charge . . . to determine whether the instructions fairly stated the legal principles to be applied by the jury.'" (quoting Smiddy v. Varney, 665 F.2d 261, 265 (9th Cir. 1981), *cert. denied*, 459 U.S. 829 (1982))).
[65] Advanced Display Sys., Inc. v. Kent State Univ., 212 F.3d 1272, 1281 (Fed. Cir. 2000) (internal citations omitted).
[66] *See Advanced Display*, 212 F.3d at 1281–82.
[67] FED. R. CIV. P. 52(a), (b).

because the moving party is, in both cases, essentially asking the trial court to re-open the case, albeit through alternative means. In general, a trial court overseeing an action tried without a jury or with an advisory jury "must find the facts specially and state its conclusions of law separately."[69] Those findings and conclusions may be stated on the record after the close of evidence or in a written opinion filed by the court.[70] A Rule 52 motion is proper when the trial court's factual findings lack the specificity necessary for an appellate court to understand the basis for the trial court's conclusions.[71] A Rule 52 motion is not, however, a mechanism one may use simply to re-litigate old matters or to advance new legal theories.[72]

Like other post-trial motions, not filing a Rule 52 motion in the appropriate circumstances can have consequences. For example, although party can always attack a trial court's finding as being "clearly erroneous" on appeal,[73] it cannot necessarily argue that those findings lack specificity unless it first filed a Rule 52 motion.[74] Consider two situations. In the first, the challenger does not suggest that the trial court's findings are too incomplete to support its conclusion, only that those findings are clearly wrong. In the second, the challenger does not necessarily suggest that the trial court's findings are wrong, only that those findings are too incomplete to support the court's decision. An appealing party in the first situation may always make its argument, but an appealing party in the second situation may not make its argument without first filing a Rule 52 motion.[75] And if successful on appeal, the result will be a remand for further findings.[76] Thus, a Rule 52 motion should certainly be used when a party wishes to challenge a court's findings for lack of specificity or completeness. As several courts have noted, "It would seem that if a party is not willing to give a trial judge the benefit of suggested findings and conclusions, he is not in the best of positions to complain that the findings made and conclusions stated are incomplete."[77]

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[68] 9A CHARLES A. WRIGHT & ARTHUR R. MILLER, FEDERAL PRACTICE AND PROCEDURE § 2582 (2d ed. 1994); *see also* FED. R. CIV. P. 52(b) ("The motion may accompany a motion for new trial under Rule 59.").
[69] FED. R. CIV. P. 52(a)(1).
[70] *Id.*
[71] *See* Gechter v. Davidson, 116 F.3d 1454, 1458 (Fed. Cir. 1997) ("Rule 52(a)'s purpose is, *inter alia*, to provide the appellate court with an adequate basis for review.").
[72] *See* Consolidated Aluminum Corp. v. Foseco Int'l, Ltd., 910 F.2d 804, 814 (Fed. Cir. 1990) ("A remand, with its accompanying expenditure of additional judicial resources in a case thought to be completed, is a step not lightly taken and one that should be limited to cases in which further action *must* be taken by the district court or in which the appellate court has no way open to it to affirm or reverse the district court's action under review." (emphasis added)).
[73] FED. R. CIV. P. 52(a)(6).
[74] *See* Evans v. Suntreat Growers & Shippers, Inc., 531 F.2d 568, 570 (Temp. Emer. Ct. App. 1976) ("Appellants rightly contend that [their failure to file a proper Rule 52 motion] does not prevent them from attacking a finding which is erroneous. But . . . they cannot complain of lack of specificity in the findings, when they proposed nothing to this effect.").
[75] *See id.*; United States v. Tosca, 18 F.3d 1352, 1355 (6th Cir. 1994) ("It is a general principle of appellate jurisprudence that a party desiring more particularized findings at the trial court level must request them from the trial court."); Hollinger v. United States, 651 F.2d 636, 640–41 (9th Cir. 1981) ("[T]he government failed to move the district court to amend its findings or make additional findings. Thus the government cannot now complain of the lack of specificity in the finding. The government can, however, raise the question of sufficiency of the evidence to support the finding of total disability whether or not the government objected to the finding.").
[76] *See* Icicle Seafoods, Inc. v. Worthington, 475 U.S. 709, 714 (1986) ("If the Court of Appeals believed that the District Court had failed to make findings of fact essential to a proper resolution of the legal question, it should have remanded to the District Court to make those findings.").
[77] Sonken-Galamba Corp. v. Atchison, T. & S. F. Ry., 34 F. Supp. 15, 16 (W.D. Mo. 1940), *aff'd*, 124 F.2d 952 (8th Cir. 1942), *cert. denied*, 315 U.S. 822 (1942); *accord Tosca*, 18 F.3d at 1355; Reliance Finance Corp. v. Miller, 557 F.2d 674, 681–82 (9th Cir. 1977); *see also* Glaverbel Société Anonyme v. Northlake Mktg. & Supply Co., 45 F.3d 1550, 1555 (Fed. Cir. 1995) ("When a party remains silent after full trial and decision and then complains about incomplete findings, the appellate tribunal should ascertain whether any absent findings not only were essential to resolution of the issue, but were not made by the trial judge." (citing *Consolidated Aluminum*, *Evans*, and *Tosca* favorably)); *Consolidated Aluminum*, 910 F.2d at 814 n.9 ("Rule 52(b) . . .

Note that the challenging party bears the burden of pointing out any of the trial court's findings or conclusions that warrant further consideration.[78] Moreover, a proper Rule 52 motion includes a reasonable basis showing that the trial court's findings were incomplete.[79] As with motions for new trial and renewed motions for JMOL, motions to amend filings must be filed within twenty-eight days of the trial court's judgment,[80] and extensions are unavailable.[81]

Like Rule 52, Rule 59(e) permits a court to amend its determinations.[82] According to the Supreme Court, the draftsmen of Rule 59(e) "had a clear and narrow aim" to permit district courts to rectify their own mistakes during the period immediately following the entry of judgment.[83] It "is not a vehicle for reopening judgments to present information that was long possessed by the movant and that was directly relevant to the litigation."[84] Rather, a motion to alter or amend judgment "must rely on one of three major grounds: '(1) an intervening change in controlling law; (2) the availability of new evidence [not available previously]; [or] (3) the need to correct clear error [of law] or prevent manifest injustice.'"[85] Thus, Rule 59(e) motions are typically appropriate only when a court has misunderstood the facts, a party's position, or the controlling law.[86]

VI. Motions for Relief from Judgment

Motions for relief from judgment are governed by Rule 60. They are intended as a mechanism by which the appellate courts can maintain "the delicate balance between the sanctity of final judgments . . . and the incessant command of a court's conscience that justice be done in light of all the facts."[87] Put another way, "[Rule 60] is intended 'to prevent the judgment from becoming a vehicle of injustice.'"[88] Thus, it "is to be construed liberally to do substantial justice."[89] Like many other procedural matters, because denial of a Rule 60 motion is generally a procedural issue not unique to patent law, the Federal Circuit applies the law of the regional circuit in which the district court resides.[90] However, if review of a movant's Rule 60 motion turns on substantive matters unique to patent law, Federal Circuit law applies.[91] The decision of

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provides for post-judgment motions for findings not made. Counsel should not simply ignore that rule and head off to the appellate court to seek a remand for the making of those same findings.").

[78] *See Glaverbel*, 45 F.3d at 1556 ("It was not the trial judge's burden, but that of [the defendant], to point out any aspects requiring particular attention.").

[79] *See id.* ("[A]n assertion that findings were incomplete must include a reasonable basis . . . .").

[80] FED. R. CIV. P. 52(b).

[81] *Id.* 6(b)(2). Rule 52(b) motions are tied to Fed. R. App. P. 4, thereby implicating the appellate timeline. That is why extensions are not permitted.

[82] *See supra* Section II.D.3.

[83] White v. New Hampshire Dep't of Emp't Sec., 455 U.S. 445, 450 (1982).

[84] Ajinomoto Co., Inc. v. Archer-Daniels-Midland Co., 228 F.3d 1338, 1350 (Fed. Cir. 2000).

[85] N. River Ins. Co. v. CIGNA Reinsurance Co., 52 F.3d 1194, 1218 (3d Cir. 1995) (alterations in original) (quoting Natural Res. Def. Council v. EPA, 705 F. Supp. 698, 702 (D.D.C. 1989)); *accord* Servants of Paraclete v. Does, 204 F.3d 1005, 1012 (10th Cir. 2000); 389 Orange St. Partners v. Arnold, 179 F.3d 656, 665 (9th Cir. 1999); GenCorp, Inc. v. Am. Int'l Underwriters, 178 F.3d 804, 834 (6th Cir. 1999); Collison v. Int'l Chem. Workers Union, Local 217, 34 F.3d 233 (4th Cir. 1994).

[86] *Servants of Paraclete*, 204 F.3d at 1012.

[87] Good Luck Nursing Home, Inc. v. Harris, 636 F.2d 572, 577 (D.C. Cir. 1980) (quoting Bankers Mortgage Co. v. United States, 423 F.2d 73, 77 (5th Cir. 1970), *cert. denied*, 399 U.S. 927 (1970)).

[88] Rosebud Sioux Tribe v. A & P Steel, Inc., 733 F.2d 509, 515 (8th Cir. 1984) (quoting United States v. Walus, 616 F.2d 283, 288 (7th Cir. 1980)).

[89] Johnson Waste Materials v. Marshall, 611 F.2d 593, 600 (5th Cir. 1980) (quoting, Laguna Royalty Co. v. Marsh, 350 F.2d 817, 823 (5th Cir. 1965)).

[90] Amstar Corp. v. Envirotech Corp., 823 F.2d 1538, 1550 (Fed. Cir. 1987).

[91] *See* Fiskars, Inc. v. Hunt Mfg. Co., 279 F.3d 1378, 1381 (Fed. Cir. 2002) ("[W]hen a district court's Rule 60(b) ruling turns on substantive matters that pertain to patent law, we review the ruling under Federal Circuit law because 'we perceive a clear need

whether to grant a Rule 60 motion ultimately lies within the court's discretion and will therefore be reviewed on appeal for abuse of discretion.[92]

Rule 60(a) governs relief from a judgment based on clerical mistakes, oversights, or omissions by the trial court. It is designed "to permit the district court to reconsider and correct its own errors, particularly if they are of an obvious nature amounting to little more than clerical errors."[93] Thus, Rule 60(a) motions are proper when a party discovers a glaring clerical or typographical error, especially when the judgment does not accurately reflect the decision as rendered.[94] They may be filed at any time. Moreover, even if no party files a Rule 60(a) motion, the court may, *sua sponte*, "correct a clerical mistake or a mistake arising from oversight or omission whenever one is found in a judgment, order, or other part of the record."[95] After an appeal has been docketed, however, such mistakes may only be corrected with the leave of the appellate court.[96]

Rule 60(b) governs relief from final judgment on "just terms."[97] It gives a court "broad discretion regarding the type of relief it might grant."[98] Accordingly, a Rule 60(b) motion is appropriate for any of the following reasons:

> (1) mistake, inadvertence, surprise, or excusable neglect;
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> (2) newly discovered evidence that, with reasonable diligence, could not have been discovered in time to move for a new trial under Rule 59(b);
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> (3) fraud (whether previously called intrinsic or extrinsic), misrepresentation, or misconduct by an opposing party;
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> (4) the judgment is void;
>
> (5) the judgment has been satisfied, released, or discharged; it is based on an earlier judgment that has been reversed or vacated; or applying it prospectively is no longer equitable; or
>
> (6) any other reason that justifies relief.[99]

Rule 60(b) motions "must be made within a reasonable time—and for reasons (1), (2), and (3) no more than a year."[100]

The Rule 60(b)(1) provision for relief because of "excusable neglect" often arises in cases of default judgment. The courts clearly disfavor default judgment, preferring instead a trial

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for uniformity and certainty in the way the district courts treat [the] issue.'" (alteration in original) (quoting Broyhill Furniture Indus., Inc. v. Craftmaster Furniture Corp., 12 F.3d 1080, 1083 (Fed. Cir. 1993)).

[92] *See* Info. Sys. & Networks Corp. v. United States, 994 F.2d 792, 794 (Fed. Cir. 1993) ("We review a trial court's denial of a motion for relief under Rule 60(b) for abuse of discretion.").

[93] Fackelman v. Bell, 564 F.2d 734, 736 (5th Cir. 1977).

[94] *See* Paddington Partners v. Bouchard, 34 F.3d 1132, 1140 (2d Cir. 1994) ("An error in a judgment that accurately reflects the decision of the court or jury as rendered is not 'clerical' within the terms of Rule 60(a).").

[95] FED. R. CIV. P. 60(a).

[96] *Id.*

[97] *Id.* 60(b).

[98] Conerly v. Flower, 410 F.2d 941, 944 (8th Cir. 1969).

[99] FED. R. CIV. P. 60(b).

[100] *Id.* 60(c)(1).

on the merits of the case.[101] Thus, Rule 60(b)(1) motions do not require a showing of "extraordinary circumstances."[102] Rather, any time the Federal Circuit addresses the issue of "excusable neglect" under Rule 60(b)(1), it examines three factors: "(1) whether the non-defaulting party will be prejudiced; (2) whether the defaulting party has a meritorious defense; and (3) whether culpable conduct of the defaulting party led to the default."[103] Not all factors must be present, however; it is a balancing test.[104]

Rule 60(b)(2) provides for relief from final judgment when newly discovered evidence could not have been discovered through reasonable diligence in time to file a Rule 59 motion. The "reasonable diligence" limitation "provid[es] finality to judicial decisions and orders by preventing belated attempts to reopen judgment on the basis of facts that the moving party could have discovered at the time of trial."[105] Although the law varies between regional circuits, to prevail on a Rule 60(b)(2) motion a party must generally show the following or some slight variation thereof:

> (1) The evidence must be discovered following the trial;
>
> (2) Facts must be alleged from which the court may infer diligence on the part of the movant to discover the new evidence;
>
> (3) The evidence must not be merely cumulative or impeaching;
>
> (4)The evidence must be material; and
>
> (5) The evidence must be such that a new trial would probably produce a new result.[106]

Rule 60(b)(3) permits relief to a party when a court discovers fraud, misrepresentation, or misconduct by an opposing party. A successful Rule 60(b)(3) motion "requires rigorous proof . . . lest the finality established by Rule 60(b) be overwhelmed by continuing attacks on the judgment."[107] In general, a court contemplating whether to grant a Rule 60(b)(3) motion will look for two basic elements: (1) whether an opponent committed fraud or engaged in some other form of misconduct and (2) whether the alleged misconduct prevented the movant from making a full and fair presentation of its case.[108] To show that it was precluded from making a full and fair presentation of its case, a movant need not demonstrate that the trial court's prior decision would

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[101] *See* Info. Sys. & Networks Corp. v. United States, 994 F.2d 792, 795 (Fed. Cir. 1993) ("Our review is guided by the well-established principles that a trial on the merits is favored over default judgment and that close cases should be resolved in favor of the party seeking to set aside default judgment.").
[102] *See id.* at 795–76 (referring to an assertion that Rule 60(b)(1) requires a showing of "extraordinary circumstances" as "misplaced").
[103] *Id.* at 795.
[104] *See id.* at 796 ("We adopt the balancing approach since it best enables a court to weigh the facts and use its discretion to determine whether a party is deserving of the harsh sanction of default judgment.").
[105] Smith Int'l, Inc. v. Hughes Tool Co., 759 F.2d 1572, 1579 (Fed. Cir. 1985), *cert. denied*, 474 U.S. 827 (1985).
[106] Ledet v. United States, 297 F.2d 737, 739 (5th Cir. 1962). In addition to the 5th Circuit, this standard has been widely applied elsewhere. *See* United States v. Jasin, 280 F.3d 355, 361 (3d Cir. 2002); United States v. Liebo, 923 F.2d 1308, 1313 (8th Cir. 1991); United States v. Benavente Gomez, 921 F.2d 378, 382 (1st Cir. 1990); United States v. DiBernardo, 880 F.2d 1216, 1224 (11th Cir. 1989).
[107] Apotex Corp. v. Merck & Co., 507 F.3d 1357, 1360–61 (Fed. Cir. 2007).
[108] Harduvel v. Gen. Dynamics Corp., 801 F. Supp. 597, 607 (M.D. Fla. 1992).

have been different.[109] It suffices that the misconduct materially altered a party's approach to the trial.[110] Although a movant typically must file a motion for relief under Rule 60(b)(3) within one year after judgment, a court may grant relief outside of that one-year period in cases of newly discovered misconduct if the movant files within a reasonable time.[111] Such misconduct must have occurred during the litigation proceedings, and it must amount to "a material subversion of the legal process such as could not have been exposed within the one-year window."[112] Misconduct falling within this exception is generally limited to "egregious events . . . affecting the integrity of the court and its ability to function impartially."[113] It must be "directed to the judicial machinery itself" and "involve[] circumstances where the impartial functions of the court have been directly corrupted."[114]

Rule 60(b)(4) permits relief from void judgments. As the Federal Circuit has noted, "[I]t is well established that a judgment is void for purposes of 60(b)(4) only when the court that rendered the judgment lacked jurisdiction or failed to act in accordance with due process of law."[115] A court may fail to act in accordance with due process of law, for example, if it improperly enters a default judgment.[116] A judgment is not void merely because it is erroneous, or because it is based on precedent that has been altered or overruled.[117] However, "if the underlying judgment is void, it is a *per se* abuse of discretion for a district court to deny a movant's motion to vacate the judgment under Rule 60(b)(4)."[118]

Rule 60(b)(5) provides for relief from judgment when a prospective application of the court's judgment is no longer equitable. Thus, to succeed on a Rule 60(b)(5) motion, the movant must show that "continued operation of the judgment will result in inequity."[119] One should consider such a motion "when the party seeking relief from an injunction or consent decree can show 'a significant change either in factual conditions or in law'"[120]—i.e. when the law on which the trial court's decision was based is no longer good law. Whether the subsequent change in the law was statutory or decisional is irrelevant.[121]

Rule 60(b)(6) is a catch-all provision. It gives federal courts broad authority to relieve a party from final judgment "'upon such terms as are just,' provided that the motion is made within a reasonable time and is not premised on one of the grounds for relief enumerated in clauses (b)(1) through (b)(5)."[122] Thus, Rule 60(b)(6) cannot be used to circumvent the other

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[109] *See, e.g.*, Wilson v. Thompson, 638 F.2d 801, 804 (5th Cir. 1981) ("The court did not err in concluding that such evidence would have failed to alter the outcome of that trial.").
[110] *See* Seaboldt v. Pa. R.R. Co., 290 F.2d 296, 299 (3d Cir. 1961) ("[W]e cannot say for a certainty that previous knowledge of [these facts] would have changed the [judgment of the case]. But [they] would have made a difference in . . . counsel's approach to the testimony of several witnesses.").
[111] *Apotex*, 507 F.3d at 1360 ("Rule 60(b)(3) provides that a judgment can be set aside for fraud or misrepresentation only when the motion is made within a year after the judgment, unless there was 'fraud upon the court' or other egregious act not previously uncovered."); *see also* FED. R. CIV. P. 60(d)(3) ("This rule does not limit a court's power to: . . . set aside judgment for fraud on the court.").
[112] *Apotex*, 507 F.3d at 1360.
[113] *Id.* at 1361.
[114] *In re* Whitney-Forbes, Inc., 770 F.2d 692, 698 (7th Cir. 1985) (citing Bulloch v. United States, 721 F.2d 713, 718 (10th Cir. 1983)).
[115] Broyhill Furniture Indus. v. Craftmaster Furniture Corp., 12 F.3d 1080, 1084 (Fed. Cir. 1993).
[116] State Street Bank & Trust Co. v. Inversiones Errazuriz Limitada, 374 F.3d 158, 178 (2d Cir. 2004).
[117] *Broyhill*, 12 F.3d at 1084 (quoting United States v. Boch Oldsmobile, Inc., 909 F.2d 657, 661 (1st Cir. 1990)).
[118] *State Street Bank*, 374 F.3d at 178.
[119] Ashland Oil, Inc. v. Delta Oil Prods. Corp., 806 F.2d 1031, 1033 (Fed. Cir. 1986) (applying 7th Circuit law).
[120] Agostini v. Felton, 521 U.S. 203, 215 (1997) (quoting Rufo v. Inmates of Suffolk Cnty. Jail, 502 U.S. 367, 388 (1992)).
[121] *Id.*
[122] Amado v. Microsoft Corp., 517 F.3d 1353, 1363 (Fed. Cir. 2008) (quoting Liljeberg v. Health Servs. Acquisition Corp., 486 U.S. 847, 863 (1988)).

provisions of Rule 60.[123] In general, the party seeking relief under Rule 60(b)(6) must demonstrate "that circumstances surrounding the judgment created a substantial danger of an unjust result."[124] Indeed, the circumstances must be "extraordinary."[125]

VII. Interlocutory Appeal

A. Rule 54(b)

Rule 54(b) is relevant when a trial court's judgment involves multiple claims or multiple parties. It was adopted to "relax[] the restrictions upon what should be treated as a judicial unit for the purposes of appellate jurisdiction."[126] In practice, Rule 54(b) allows a district court to make an individual claim final and to sever it from the rest of the claims for purposes of appeal.[127] It acknowledges the basic fact that "some final decisions, on less than all of the claims, should be appealable without waiting for a final decision on *all* of the claims."[128] In general, a judgment that does not dispose of all claims relating to all parties is considered interlocutory and is not appealable. If such a judgment is made final under Rule 54(b), however, it *is* appealable. Thus, Rule 54(b) motions should be considered when a judgment becomes final, and "additional claims, counterclaims, or third-party claims are left unadjudicated."[129]

"The function of the district court under [Rule 54(b)] is to act as a 'dispatcher.'"[130] A court judging whether Rule 54(b) applies must focus not only on the finality of the judgment, but also on the separateness of the claims for relief.[131] Moreover, a trial court will grant a Rule 54(b) motion only when it "expressly determines that there is no just reason for delay" before appeal.[132] While the presence or absence of just reason for delay is a question left to the trial court's discretion, the question of whether the decision is final is not.[133] Rather, finality is "a statutory mandate."[134] A judgment is final for Rule 54(b) purposes when it is "an *ultimate* disposition of an *individual* claim entered in the course of a multiple claims action."[135]

B. 28 U.S.C. § 1292(b)

Some interlocutory appeals may be had because of their very nature. For example, any order granting or refusing to grant injunctive relief is immediately appealable as a matter of right.[136] Most actions do not fall into that category, however. Patent claim constructions, for example, do not dispose of a complete legal claim in a case and therefore are not generally

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[123] *Id.*
[124] *Ashland Oil*, 806 F.2d at 1033 (applying 7th Circuit law and citing Merit Ins. Co. v. Leatherby Ins. Co., 714 F.2d 673, 682–83 (7th Cir. 1983), *cert. denied*, 464 U.S. 1009 (1984)).
[125] Pioneer Inv. Servs. Co. v. Brunswick Assocs., Ltd., 507 U.S. 380, 393 (1993); *Liljeberg*, 486 U.S. at 864.
[126] Sears, Roebuck & Co. v. Mackey, 351 U.S. 427, 432 (1956).
[127] W.L. Gore & Assocs., Inc. v. Int'l Med. Prosthetics Research Assocs., Inc., 975 F.2d 858, 861 (Fed. Cir. 1992).
[128] *Id.* (emphasis in original) (quoting *Sears & Roebuck*, 351 U.S. at 432).
[129] *Id.* at 862.
[130] Curtiss-Wright Corp. v. Gen. Elec. Co., 446 U.S. 1, 8 (1980) (quoting *Sears & Roebuck*, 351 U.S. at 435).
[131] *W.L. Gore*, 975 F.2d at 862.
[132] FED. R. CIV. P. 54(b).
[133] *W.L. Gore*, 975 F.2d at 862.
[134] *Id.*
[135] *Sears & Roebuck*, 351 U.S. at 436 (emphasis in original).
[136] 28 U.S.C. § 1292(a)(1) (2006).

candidates for interlocutory appeal.[137] When a ruling of the latter sort eliminates all rational prospects for success on the merits, the adversely affected party may consider requesting entry of a final judgment against it on the associated claims. It can then file a Rule 54(b) motion and immediately seek an appeal.

Alternatively, section 1292(b) gives courts the power to grant permissive interlocutory appeals of decisions not entitled to such appeal as a matter of right. These are often referred to as "certified questions." Unlike Rule 54(b) motions, certified questions involve decisions that do not render a claim final. Courts rarely grant interlocutory appeals under § 1292(b) because the provision was intended for use only in "exceptional cases where a decision on appeal would avoid protracted and expensive litigation."[138] To be eligible for a permissive interlocutory appeal, the district court must certify its order pursuant to § 1292(b). A party generally requests certification by filing a motion, arguing that the three basic requirements for certification are present in the court's order. First, the decision must "involve[] a controlling question of law."[139] Moreover, the relevant issues must contain "substantial ground for difference of opinion."[140] And finally, the judge must believe that "an immediate appeal from the order may materially advance the ultimate termination of the litigation."[141]

In deciding whether to certify an order, the trial judge will "carefully consider[] the competing equities" and decide whether "the need for an immediate appeal . . . clearly outweigh[s] . . . the policy against piecemeal adjudication."[142] Although there may be instances in which an appellate court is justified in ordering a district court to certify a question, the Federal Circuit generally will not interfere in the district court's decision.[143] If the district court judge certifies the order, the adversely affected party has ten days to seek an interlocutory appeal in the Federal Circuit. The Federal Circuit may then choose, at its own discretion, whether to entertain the appeal. Note, however, that seeking an interlocutory appeal under § 1292(b) will not stay proceedings in the district court unless the district court judge or a Federal Circuit judge specifically grants a stay.[144]

Even if the district court certifies an appeal under section 1292(b), the Federal Circuit rarely takes such interlocutory appeals.[145] Permissive interlocutory appeals would clearly have value when a party wishes to challenge a district court judge's claim construction before trying the ultimate question of infringement. However, the Federal Circuit refuses to grant interlocutory appeals of that type.[146] The same remains true even when the district court adopts a claim construction not proffered by either party.

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[137] *But see* Regents of Univ. of Cal. v. Dakocytomation Cal., Inc., 517 F.3d 1364, 1371 (Fed. Cir. 2008) ("While we have not generally certified motions for interlocutory appeal of claim construction, we determined that it was especially desirable in this case in view of the pendency of the related appeal on the denial of the preliminary injunction based on some of the same issues.").
[138] S. REP. NO. 85-2434, at 7 (1958), *reprinted in* 1958 U.S.C.C.A.N. 5255, 5260.
[139] 28 U.S.C. § 1292(b) (2006).
[140] *Id.*
[141] *Id.*
[142] Chaparral Commc'ns, Inc. v. Boman Indus., 798 F.2d 456, 459 (Fed. Cir. 1986); *accord* Jeannette Sheet Glass Corp. v. United States, 803 F.2d 1576, 1580 (Fed. Cir. 1986).
[143] *Jeanette Sheet Glass*, 803 F.2d at 1581 ("Though 'there may be exceptional cases where an appellate court is justified in mandamusing the district court to execute the certificate, . . . as a general proposition a refusal to execute . . . will not be interfered with by an appellate court.'" (quoting 6 JAMES WM. MOORE ET AL., MOORE'S FEDERAL PRACTICE ¶ 54.41[3])).
[144] 28 U.S.C. § 1292(b).
[145] *See, e.g.*, Symbol Techs., Inc. v. Lemelson Med., Educ. & Research Found., L.P., 422 F.3d 1378, 1381 (Fed. Cir. 2005) (noting that the court had granted an interlocutory appeal to decide whether prosecution laches was a viable defense).
[146] *See, e.g.*, Nystrom v. TREX Co., 339 F.3d 1347, 1350 (Fed. Cir. 2003) ("Because claim construction is subject to *de novo* review as a matter of law, immediate appeal of an interlocutory claim construction ruling without a resolution of all of the factual

C. Denial or Grant of Injunction

As noted earlier, interlocutory appeals of injunctive orders are available as a matter of right.[147] Section 283 of the Patent Act gives district courts the power to grant injunctive relief for patent infringement. Specifically, a district court may "grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by a patent, on such terms as the court deems reasonable."[148] As the terms of the statute make clear, "the district court's grant or denial of an injunction is within its discretion depending on the facts of each case."[149] When deciding whether to issue a preliminary injunction, a court must consider the traditional principles of equity by evaluating: "(1) the likelihood of the patentee's success on the merits; (2) irreparable harm if the injunction is not granted; (3) the balance of hardships between the parties; and (4) the public interest.[150] Note, however, that a court should not issue a preliminary injunction if there is "a substantial question concerning infringement or validity, meaning that [the adversely affected party] asserts a defense that [the party seeking the injunction] cannot prove lacks substantial merit."[151]

The four preliminary injunction factors are not dispositive as examined individually. Rather, "the district court must weigh and measure each factor against the other factors and against the form and magnitude of the relief requested."[152] Yet, logically, both of the first two factors—likelihood of success and irreparable harm—must be present.[153] To show a likelihood of success on the merits, a plaintiff must show that, given the presumptions and burdens that will govern a trial on the merits, (1) it will likely prove that the defendant infringed its patent, and (2) the patent will likely survive any invalidity and unenforceability challenges.[154] Those two questions are judged on a claim-by-claim basis.[155] The Federal Circuit used to apply a presumption that "[a] strong showing of likelihood of success on the merits coupled with continuing infringement raises a presumption of irreparable harm to the patentee."[156] Although still an open question after the Supreme Court's *eBay*[157] decision, that presumption is probably no longer valid.[158] Thus, irreparable harm likely requires independent proof of harm.[159] Under

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issues of infringement or validity dependent thereon is often desired by one or both of the parties for strategic or other reasons. But, other than the accommodation for deferred accounting in 28 U.S.C. § 1292(c)(2), the rules of finality that define the jurisdiction of this court do not contain special provisions for patent cases or admit to exceptions for strategic reasons or otherwise, short of meeting the conditions specified in Rule 54(b) or 28 U.S.C. § 1292(b), (c)(1).").

[147] 28 U.S.C. § 1292(a)(1).

[148] 35 U.S.C. § 283 (2006).

[149] Windsurfing Int'l, Inc. v. AMF, Inc., 782 F.2d 995, 1002 (Fed. Cir. 1986) (citing Roche Prods., Inc. v. Bolar Pharm. Co., 733 F.2d 858, 865–66 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 856 (1984)).

[150] Oakley, Inc. v. Sunglass Hut Int'l, 316 F.3d 1331, 1338–39 (Fed. Cir. 2003).

[151] Tate Access Floors, Inc. v. Interface Architectural Res., Inc., 279 F.3d 1357, 1365 (Fed. Cir. 2002).

[152] Hybritech, Inc. v. Abbott Labs., 849 F.2d 1446, 1451 (Fed. Cir. 1988).

[153] Amazon. com, Inc. v. Barnes & Noble. com, Inc., 239 F.3d 1343, 1350 (Fed. Cir. 2001).

[154] *Id.*

[155] *Id.* at 1351.

[156] Reebok Int'l, Ltd. v. J. Baker, Inc., 32 F.3d 1552, 1556 (Fed. Cir. 1994).

[157] eBay, Inc. v. MercExchange, L.L.C., 547 U.S. 388 (2006).

[158] *See* MercExchange, L.L.C. v. eBay, Inc., 500 F. Supp. 2d 556, 568 (E.D. Va. 2007) ("Prior to applying the facts of the instant matter to the four-factor test, the court must consider whether a presumption of irreparable harm upon a finding of validity and infringement survives the Supreme Court's opinion remanding this case. Although the parties did not perform extensive briefing on such issue and the Supreme Court's opinion does not squarely address it, a review of relevant caselaw, as well as the language of the Supreme Court's decision, supports defendants' position that such presumption no longer exists." (citing z4 Techs., Inc. v. Microsoft Corp., 434 F. Supp. 2d 437, 440 (E.D. Tex. 2006)). *But see* Broadcom Corp. v. Qualcomm, Inc., 543 F.3d 683, 702 (Fed. Cir. 2008) ("It remains an open question 'whether there remains a rebuttable presumption of irreparable harm following eBay.'" (quoting Amado v. Microsoft Corp., 517 F.3d 1353, 1359 n.1 (Fed. Cir. 2008)).

the third factor, a district court must also weigh the harm that the moving party will suffer from the denial of a preliminary injunction against the harm that the non-moving party will suffer if an injunction is granted.[160] Lastly, the public interest factor refers not only to the public's interest in protecting valid patent rights, but also to "whether there exists some critical public interest that would be injured by the grant of preliminary relief."[161] The significance of all relevant public interests must then be balanced.[162]

The Federal Circuit reviews the district court's decision to grant or deny an injunction under an abuse of discretion standard.[163] Under that standard, the Federal Circuit will set aside a district court's order to grant or deny injunctive relief only if the district court "abused its discretion, committed an error of law, or seriously misjudged the evidence."[164] However, to the extent the district court's decision depends upon an issue of law, the Federal Circuit will review that issue *de novo*.[165] Moreover, "[a]lthough the standard of review for the issuance and scope of an injunction is abuse of discretion, whether the terms of the injunction fulfill the mandates of [Rule] 65(d) is a question of law that [the Federal Circuit] reviews *de novo*."[166]

Rule 65(d) governs the contents and scope of injunction orders. It requires specificity: "Every order granting an injunction . . . must: (A) state the reasons why it issued; (B) state its terms specifically; and (C) describe in reasonable detail—and not by referring to the complaint or other document—the act or acts restrained or required."[167] A terse injunction order will not suffice. For example, the Supreme Court has condemned broad injunctions that simply instruct the enjoined party not to violate a statute.[168] "Such injunctions increase the likelihood of unwarranted contempt proceedings for acts unlike or unrelated to those originally judged unlawful."[169] In the context of patent infringement, the Federal Circuit will reject injunctions that simply prohibit future infringement of a patent.[170] To satisfy Rule 65(d), an order must "use specific terms or describe in reasonable detail the acts sought to be restrained."[171] Accordingly, an injunction for patent infringement should note which acts constitute infringement. Alternatively, a court may expressly limit the injunction to the manufacture, use, or sale of the specific device found to infringe, or devices no more than colorably different from the infringing device.[172]

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[159] *Cf.* Hybritech, Inc. v. Abbott Labs., 849 F.2d 1446, 1456 (Fed. Cir. 1988) (detailing nine factors tending to show irreparable harm applicable to the case under consideration).
[160] *Id.* at 1457.
[161] *Id.* at 1458.
[162] *See id.* (finding that "with respect to most of [the defendant's] products involved in this proceeding, . . . the public interest in enforcing valid patents outweigh[s] any other public interest considerations," but that "the public interest is served best by the availability of these [accused cancer and hepatitis test] kits")
[163] *Id.* at 1451.
[164] Curtiss-Wright Flow Control Corp. v. Velan, Inc., 438 F.3d 1374, 1378 (Fed. Cir. 2006) (quoting We Care, Inc. v. Ultra-Mark Int'l Corp., 930 F.2d 1567, 1570 (Fed. Cir. 1991)); *accord Hybritech*, 849 F.2d at 1449.
[165] Oakley, Inc. v. Sunglass Hut Int'l, 316 F.3d 1331, 1339 (Fed. Cir. 2003).
[166] Signtech USA, Ltd. v. Vutek, Inc., 174 F.3d 1352, 1356 (Fed. Cir. 1999).
[167] FED. R. CIV. P. 65(d)(1).
[168] *See* NLRB v. Express Publ'g Co., 312 U.S. 426, 435–36 (1941) ("[T]he mere fact that a court has found that a defendant has committed an act in violation of a statute does not justify an injunction broadly to obey the statute and thus subject the defendant to contempt proceedings if he shall at any time in the future commit some new violation unlike and unrelated to that with which he was originally charged.").
[169] Int'l Rectifier Corp. v. IXYS Corp., 383 F.3d 1312, 1316 (Fed. Cir. 2004).
[170] *Id.*; *see also* Additive Controls & Measurement Sys., Inc. v. Flowdata, Inc., 986 F.2d 476, 479 (Fed. Cir. 1993).
[171] *Additive Controls*, 986 F.2d at 479.
[172] *See id.* at 479–80 ("The terse order does not state which acts of Adcon constitute infringement of the '318 patent. The order does not limit its prohibition to the manufacture, use, or sale of the specific infringing device, or to infringing devices no more than colorably different from the infringing device.").

D. Collateral Order Doctrine

The collateral order doctrine is a rarely used mechanism, but it can be very effective when appropriate. It permits an appellate court to review a trial court's decision that (1) conclusively determines an important and disputed question; (2) that is completely separate from the merits of the action; and (3) that would be effectively unreviewable on appeal from a final judgment.[173] To appeal under the collateral order doctrine, an appellant must also identify what right will be lost if the decision is not reviewed immediately.[174] For example, the Federal Circuit has used the collateral order doctrine to review a motion to quash a subpoena granted in an ancillary proceeding by a court other than the one in which the litigation was pending.[175] On the other hand, "routine discretionary decision[s] of the district court concerning trial management" are not reviewable under the collateral order doctrine.[176] Indeed, the Supreme Court expressly limited the scope of reviewability to a "small class" of cases.[177] Otherwise, "a flood of piecemeal appeals would undoubtedly ensue."[178] Falling squarely outside of the collateral order doctrine, therefore, are almost all orders issued by the district courts, including orders involving trial bifurcation, run-of-the-mill discovery disputes, and most stay orders.

VIII. Motions for Stay Pending Appeal

Rule 62 governs stays of execution. When a party appeals, "a judgment or order that directs an accounting in an action for patent infringement" cannot be stayed after entry unless the court orders otherwise.[179] The same restriction also applies to "an interlocutory or final judgment in an action for an injunction or a receivership."[180] Thus, a stay of execution pending appeal is not automatic in a patent infringement case. Nonetheless, one should consider moving for a stay of execution when the order or judgment to be appealed includes a preliminary or permanent injunction, or an assessment of monetary relief. It is important to note that whether the trial court orders injunctive or monetary relief makes a difference. Rule 62(d) generally permits the stay of an order requiring the payment of money by posting a supersedeas bond; the stay of an injunctive order is much more difficult to obtain, however.

Rule 62(c) addresses injunctions pending appeal. They are judged according to a four-part test. A reviewing court will weigh: "(1) whether the stay applicant has made a strong showing that he is likely to succeed on the merits; (2) whether the applicant will be irreparably injured absent a stay; (3) whether issuance of the stay will substantially injure the other parties interested in the proceeding; and (4) where the public interest lies."[181] Each factor does not necessarily receive equal weight, however, and likelihood of success on the merits is a flexible

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[173] Coopers & Lybrand v. Livesay, 437 U.S. 463, 468 (1978); *see also* Cohen v. Beneficial Indus. Loan Corp., 337 U.S. 541, 546 (1949); Cabot Corp. v. United States, 788 F.2d 1539, 1543–44 (Fed. Cir. 1986); Quantum Corp. v. Tandon Corp., 940 F.2d 642, 644 n.2 (Fed. Cir. 1991).
[174] Micro Motion, Inc. v. Kane Steel Co., 894 F.2d 1318, 1320 (Fed. Cir. 1990); Baker Perkins, Inc. v. Werner & Pfleiderer Corp., 710 F.2d 1561, 1564 (Fed. Cir. 1983).
[175] Heat & Control, Inc. v. Hester Indus., Inc., 785 F.2d 1017 (Fed. Cir. 1986).
[176] *Quantum*, 940 F.2d at 644 n.2.
[177] *Cohen*, 337 U.S. at 546.
[178] *Quantum*, 940 F.2d at 644 n.2.
[179] FED. R. CIV. P. 62(a)(2).
[180] *Id.* 62(a)(1).
[181] Standard Havens Prods., Inc. v. Gencor Indus., Inc., 897 F.2d 511, 512 (Fed. Cir. 1990) (quoting Hilton v. Braunskill, 481 U.S. 770, 776 (1987)).

concept.[182] As the Supreme Court put it, "[T]he traditional stay factors contemplate individualized judgments in each case[;] the formula cannot be reduced to a set of rigid rules."[183] For example, a court will not require a particularly strong showing that the applicant will likely succeed on the merits if the harm to applicant is great enough.[184] Indeed, the essential nature of the test is just to "assess[the] movant's chances for success on appeal," balancing "the equities as they affect the parties and the public."[185] Although surely more apt to find a likelihood of success on the merits than a trial court having just issued the injunction, the Federal Circuit does not frequently grant stays that have been denied by the trial court. The movant bears the "heavy burden" of demonstrating that the trial court "abused its discretion, committed an error of law, or seriously misjudged the evidence."[186] And as far as trial courts are concerned, "[o]nce a plaintiff has met its burden in showing that an injunction is necessary, no delay in the issuance of that injunction is appropriate absent extraordinary circumstances."[187]

Under Rule 62(b), a district court may also stay the execution of a judgment pending the disposition of other post-judgment motions—in particular, those filed pursuant to Rules 50, 52(b), 59, and 60.[188] Rule 62(b) motions can be very important. Consider a party that, while awaiting decision on its other post-judgment motions, continues to engage in activities that violate the trial court's judgment. Unless that party files a Rule 62(b) motion as well, it may be held in contempt for failure to comply with the trial court's judgment.[189] Also note that a Rule 62(b) motion becomes moot once the court rules on the associated post-judgment motions.[190]

The appellate courts have powers similar to the district court regarding stays of execution. Rule 62(g) preserves the appellate courts' authority "to stay proceedings—or suspend, modify, restore, or grant an injunction—while an appeal is pending" or "to issue an order to preserve the status quo or the effectiveness of the judgment to be entered."[191] Note, however, that a party must ordinarily move for such relief first in the district court.[192] Asking the appellate court to afford such relief is only appropriate when "moving first in the district court would be impracticable" or "the district court denied the motion or failed to afford the relief requested and state any reasons given by the district court for its action."[193]

IX. Notice of Appeal

A. Timing

Rule 4(a) of the Federal Rules of Appellate Procedure sets forth the timing requirements for filing an appeal in the Federal Circuit. In general, a party must file a notice of appeal with

[182] *Id.*
[183] *Hilton*, 481 U.S. at 777.
[184] *Id.* at 776.
[185] E.I. DuPont de Nemours & Co. v. Phillips Petroleum Co., 835 F.2d 277, 278 (Fed. Cir. 1987).
[186] Smith Int'l, Inc. v. Hughes Tool Co., 718 F.2d 1573, 1579 (Fed. Cir. 1983).
[187] TiVo, Inc. v. Echostar Commc'ns Corp., 446 F. Supp. 2d 664, 666 (E.D. Tex. 2006) (quoting Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp., 106 F. Supp. 2d 696, 708 (D.N.J. 2000)).
[188] FED. R. CIV. P. 62(b).
[189] *See* Brinn v. Tidewater Transp. Dist. Comm'n, 113 F. Supp. 2d 935, 940 n.3 (E.D. Va. 2000) ("[T]he defendant did not seek a stay of the court's judgment under Rule 62(b) pending the disposition of its Rule 59 Motion to Amend, thereby currently being in clear violation of the court's order . . . , and subject to an order to show cause why it should not be held in contempt for failure to comply.").
[190] Allied Maritime, Inc. v. The Rice Corp., 361 F. Supp. 2d 148, 150 (S.D.N.Y. 2004).
[191] FED. R. CIV. P. 62(g).
[192] FED. R. APP. P. 8(a)(1).
[193] *Id.* 8(a)(2)(A).

the district clerk within thirty days after entry of the judgment or order to be appealed.[194] If the United States is a party to the action, that time is extended to sixty days.[195] Note also that when a party has filed post-judgment motions under Rule 50(b), Rule 52(b), Rule 59, or Rule 60, the critical period for filing the notice of appeal does not begin upon entry of the judgment or order to be appealed. Rather, it begins from the date of the order disposing of the last such remaining motion.[196] Similarly, if a party files a notice of appeal while the disposition of a Rule 50(b), Rule 52(b), Rule 59, or Rule 60 post-judgment motion is pending, the notice of appeal becomes effective upon the disposition of the last such motion.[197] Cross-appeals may be filed within fourteen days of the date that the first notice of appeal was filed, or within any of the aforementioned time periods, whichever ends later.[198]

An appealing party may generally file for an extension if two conditions are satisfied.[199] First, the party must file its motion for extension no more than thirty days after the normal period for filing an appeal have expired. Second, the party must be able to demonstrate excusable neglect or good cause. In limited circumstances, the district court may also reopen the time to file an appeal.[200]

The Federal Circuit Rules require that the district court clerk convey to the Federal Circuit the notice of appeal, the docket entries, an appeal information sheet, and a copy of any opinion accompanying the judgment or order being appealed.[201] Because many district court clerks are in the habit of forwarding notices of appeal to their geographic circuit court, notices of appeal to the Federal Circuit are often misdirected. That can lead to delays in processing appeals. A practitioners should follow up with the Federal Circuit clerk's office to make sure that the notice of appeal was properly forwarded to the correct court. Once received at the Federal Circuit, the court will "docket" the appeal—meaning that it assigns the case a docket number, makes a docket card available to the public, and records the names of the parties in the court's publicly available party index. The clerk is required to notify all parties of the date on which the appeal was docketed.[202]

The party successful in the district court may want to consider filing a cross-appeal. However, as a practical matter, it may seem risky to do so. After all, arguing that the district court was correct in its resolution of issues in favor of a client, yet wrong in its resolution of issues less favorable to the client, can be an inherently uncomfortable prospect. On the other hand, it may be important at least to preserve the option of cross-appealing. For example, the threat of a cross-appeal may encourage the other party to settle if it prefers not to revisit a particular issue. Or the issue to be cross-appealed may simply be an important one. Fortunately, a party does not actually need to decide whether to cross-appeal when it files its notice of cross-appeal. Instead, a party can file the notice, then defer judgment regarding whether to raise the issue until the time at which the appellee's brief is due. If it chooses to argue the issue, the party can include it in its brief; if not, the party can simply leave it out. If an appellee only wishes to present alternative theories for relief to the appellate court, a cross-appeal is unnecessary as long as those issues were raised in the district court. In fact, filing a cross-appeal to raise arguments

[194] *Id.* 4(a)(1)(A).
[195] *Id.* 4(a)(1)(B).
[196] *Id.* 4(a)(4)(A).
[197] *Id.* 4(a)(4)(B).
[198] *Id.* 4(c).
[199] *Id.* 4(a)(5)(A).
[200] *Id.* 4(a)(6).
[201] FED. CIR. R. 3(a).
[202] *Id.* 12.

in support of the trial court's decision may be "worse than unnecessary."[203] As the Federal Circuit has noted, "[a] cross-appeal is only proper if 'a party seeks to enlarge its own rights under the judgment or to lessen the rights of its adversary under the judgment.'"[204]

B. Content

Rule 3(c)(1) of the Federal Rules of Appellate Practice specifies the content required for a proper notice of appeal. Form 1 in the Appendix of Forms accompanying the Federal Rules of Appellate Practice is a suggested form of a proper notice of appeal.[205] A proper notice of appeal must "(A) specify the party or parties taking the appeal . . . ; (B) designate the judgment, order, or part thereof being appealed; and (C) name the court to which the appeal is taken."[206] Note that the Federal Circuit will not dismiss an appeal for informality or for failure to name a party whose intent to appeal is otherwise clear from the notice.[207] Rather, "the proper focus is on the record as a whole."[208] Yet although the rule will be interpreted liberally, the filing party cannot expand the scope of a notice of appeal that was specifically limited.[209]

C. Fees

Upon filing a notice of appeal, an appellant must pay the district court clerk all required fees, including the appellate docketing fee.[210] However, appealing parties must pay docketing fees to the Federal Circuit's clerk upon filing for any other proceeding, including an appeal or petition for review from the Patent and Trademark Office, and including extraordinary writs.[211] Federal Circuit Rule 52 prescribes the relevant fee schedule, which nearly equates with the Court of Appeals Miscellaneous Fee Schedule, issued in accordance with 28 U.S.C. § 1913. The Federal Circuit charges a $450 docketing fee whenever it adds an appeal or any other proceeding to its docket.[212] Each party filing a notice of appeal must pay a separate docketing fee, except that parties filing a joint notice of appeal need only pay one fee. However, note that when a party applies for a permissive interlocutory appeal under 28 U.S.C. 1292(b), the court only charges a docketing fee if it certifies the appeal. In addition to the docketing fee, any party that files a separate or joint notice of appeal must also pay $5 to the district court upon filing.[213]

The clerk does not have to docket any proceeding or perform any other service until the party pays all fees owed, unless a party has been granted leave to proceed in forma pauperis.[214] If a proceeding is docketed without prepayment of the docketing fee, the filing party must pay it within fourteen days of docketing. Otherwise, the clerk is authorized to dismiss the appeal for failure to prosecute, and all pending motions will be rendered moot. Thus, a practitioner must

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[203] Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp., 320 F.3d 1339, 1348 n.1 (Fed. Cir. 2003) (quoting Jordan v. Duff & Phelps, Inc., 815 F.2d 429, 439 (7th Cir. 1987) (internal quotation marks omitted)).
[204] Chiron Corp. v. Genentech, Inc., 363 F.3d 1247, 1252 (Fed. Cir. 2004) (quoting Bailey v. Dart Container Corp. of Mich., 292 F.3d 1360, 1362 (Fed. Cir. 2002)).
[205] FED. R. APP. P. 3(c)(5).
[206] *Id.* 3(c)(1).
[207] *Id.* 3(c)(4).
[208] Beverly Hills Fan Co. v. Royal Sovereign Corp., 21 F.3d 1558, 1561 (Fed. Cir. 1994).
[209] Durango Assocs., Inc. v. Reflange, Inc., 912 F.2d 1423, 1425 (Fed. Cir. 1990).
[210] FED. R. APP. P. 3(e).
[211] FED. CIR. R. 52(a)(2).
[212] *Id.* 52(a)(3)(A).
[213] 28 U.S.C. § 1917 (2006).
[214] FED. CIR. R. 52(c).

make sure to pay the docketing fee on time. When appropriate, however, the Federal Circuit will grant an extension of time to pay the docketing fee.

X. Conclusion

As the foregoing makes clear, appeals and district court cases are not independent. Although perhaps conceptually distinct in many ways, the two are closely coupled, each capable of affecting the other in significant ways. To be truly effective, a trial court litigator must therefore recognize how appellate and district court proceedings can shape one another and then make informed choices accordingly. Counsel should raise and preserve important issues for appeal, develop an optimal record at trial, and be mindful of all of the procedures and issues discussed in this article. A trial court litigator must appreciate the broader landscape his or her case inhabits to be a truly effective advocate for his or her client.