

James Holderman: In His Own Words: IP Litigation Strategy Advice and Insight

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It is not often that a legal master is so well known and respected that we can draw on a Wikipedia entry for his biography. Judge James Holderman is such a master. Judge Holderman served on the bench for the U.S. District Court for the Northern District of Illinois from 1985–2015, and as chief judge from 2006–2013. Among his many honors, he received the Mark T. Banner Award in 2012. He chaired the Litigation Section's Trial Practice Committee from 2012–2014 and the Commission on the American Jury Project from 2010–2012. Judge Holderman is currently a member of the Advisory Council for the United States Court of Appeals for the Federal Circuit. Judge Holderman received the Justice John Paul Stevens Award from the Chicago Bar Association in 2012. He has taught at the University of Illinois College of Law, the University of Chicago Law School, Northern Illinois University College of Law, and The John Marshall Law School, among others. Among many publications, Judge Holderman has been a contributing author of the *Patent Litigation Strategies Handbook* (with updates); *Winning at Trial: Insights from the Bench and Leading Litigators*; and *The Common Law of Intellectual Property*. Judge Holderman, having retired from the bench, is now a mediator with JAMS.

In this article, Judge Holderman provides insights on everything from corn farming to “hot tubbing” (no, not that kind) to help lawyers better their IP litigation practices.

Love of technology informs Judge Holderman's expertise in its intersection with the law. Holderman's enthusiasm arose from his pride in his father: “My father was an inventor. He was a farmer but he was also a tinkerer, and he's credited with coming up with the idea of narrow-row corn. It used to be corn rows were 42 inches apart because that's what you could get oxen down. My dad cut them in half to 21 inches. I always enjoyed the things he could come up with and was excited about it. And when I went to law school and I learned about the protections that were accorded people under the law—accorded people who invented things—that's when I developed my passion.”

The Judge has nimbly melded the fields of law and technology in the courtroom, by giving lawyers new or more effective mechanisms for teaching jurors about technology and guiding them through the process of a trial. Holderman advocates allowing jurors to submit written questions during the evidentiary phase of the case, which is “essential in [his] opinion.” This procedure was recommended by the

ABA Commission on the American Jury. “In this day and age we engage in an interactive world, and jurors, if you allow them to participate in the process by submitting questions that will clarify information in their minds, they will be more engaged. I’ve seen it happen. I saw it happen for 10 years. When I allowed jurors to submit written questions, they would perk up. They would be more engaged. They would listen carefully, and they would do their best to understand what was going on. And if they didn’t understand, they could tell us, ‘I don’t understand,’ and the lawyers could clarify that point. I mean, it’s just logical and reasonable that we would allow people to do that. But we didn’t used to do it.”

Judge Holderman also has employed “interim statements,” where he permitted lawyers to “explain the significance of that last witness and the importance of the next witness, and they—the lawyers—could use a closing argument technique in talking about the last witness or the evidence that’s come in and then opening statement techniques if they were talking about the next witness or future witnesses.”

As another method of easing the jury’s burden in IP cases, Judge Holderman has provided jurors with special interrogatories at the beginning of trial. “Now, sometimes the evidence changes and you have to make adjustments but it’s never a major change, and so I would tell the jurors this is the road map. These are the questions you have to answer at the end of this case, so here they are. Look for the answers in the evidence, and as you listen to the evidence, think about these questions. You’ll have them in front of you and think what evidence is there that supports a yes or a no answer to these questions.”

To assist judges, Holderman suggests that lawyers offer a tutorial. “Sometimes when I was on the bench I had the opportunity to have lawyers present to me videotaped tutorials explaining the technology. . . . You can try to simplify [the case] to the point that it would be understandable to a person who’s not of ordinary skill in the art. And in reality patent cases usually come down to just a few terms and a few concepts, and any conscientious judge with good lawyers can learn the technology that’s necessary to resolve that case. A judge doesn’t have to know everything about biotechnology to understand DNA splicing or to deal with a pharma case. One has to bear in mind, too, that patents are on the cutting edge of science, and so consequently even the scientists have to study and learn that technology. But tutorials and then simplification is the best.”

Judge Holderman also recommends “hot tubbing” with experts. The Judge explains: “[Y]ou get both experts, sit them at a table, and, at least the way I do it, have a court reporter, and the judge then throws out a question.” Each expert is asked to weigh in on each issue. In “hot tubbing,” “you would find more and more agreement than you would disagreement.” This colloquy narrows the issues, says the Judge.

When asked how litigants can more effectively use alternative dispute resolution, the Judge advises that their lawyers “look to the future.” Lawyers should advise clients to carefully consider the disruption to their business created by litigation, as well as to evaluate whether “destroying the other side” is worth the money it will cost. “I always tell people who are mediating before me there’s a cost factor that a lot of people don’t take into account. The first is, of course, and they do take into account, that’s the cost of the lawyers. That’s the cost of the litigation process itself, and that continues to get more expensive. But there’s also the hidden cost of the time that people spend on the litigation they are not spending on some other way for them to improve their business. In addition to that, there’s the emotional cost that

comes from having a litigation hanging over you. I mean, I literally had a businessman say to me in a mediation, 'I don't want to think about this again, and that's worth money to me to not have to think about this again.' And so I'll take that into account when I'm resolving a case. So people should consider those factors when they're considering alternative dispute resolution. When you're litigating, you're going over old ground. I use the phrase 'you're wallowing in the unpleasant when you're litigating.' That's what the businesspeople are doing. Any dispute is unpleasant. I mean, *it is*. It's just unpleasant, and so you're stuck in that. If you can put that behind you and focus your attention on what can we do with this dispute to help us out in the future to make life and our business better, that's when you can get the best alternative dispute resolution in the case. So that's what lawyers need to do. They need to focus on the future."

Judge Holderman's "Top 10 Techniques of Highly Effective IP Trial Counsel"

- 1. Have a clear theory of victory. "Work your way back from that outcome and how you got there."**
- 2. Target your closing argument. "Prepare your closing argument as though your case went in absolutely perfectly, and then use that as the road map of what you want to accomplish during the trial, and use it as a checklist."**
- 3. Anticipate your opponent's arguments. "Sometimes you can get up front and beat them to the punch."**
- 4. Speak in plain language. "When you went to law school you learned how to think like a lawyer. When you become a trial lawyer you have to learn to think like a real person again."**
- 5. Tell a story. "Every case has a human interest story—every case. I don't care if it's a patent case or if it's just a simple, easy to understand case. There's a human story behind it, and you need to tell that story to effectively communicate with a jury."**
- 6. Use visuals. "The multisense impression aids in the understanding and the memory process of juries."**
- 7. Organize exhibits to aid the decision maker. "The jury will go through the list numerically. Don't confuse them."**
- 8. Present a theme of your case up front. "The theme encapsulates a short phrase or slogan we all understand."**
- 9. Don't let your opponent divert you. "They're going to try."**
- 10. Remember you're on stage all the time. "From the moment you walk into the courtroom and the jury comes into the courtroom, they are watching everything you do, every expression, the way you treat your staff, the way you treat the judge. They're watching everything from the standpoint of they're trying to get information to assist them in making a determination, and so you have to remember everything you do is conveying a message."**