Judges Panel: Practice Pointers for Young Lawyers

Nicholas M. Centrella Jr.
Duane Morris LLP
Philadelphia, PA

The Honorable Roger T. Hughes (Ret.)
Federal Court of Canada
Toronto, ON

The Honorable Maricela Moore
162nd District Court of Dallas County, TX
Dallas, TX

Nicholas M. Centrella, Jr., practices in the area of litigation, representing clients in a wide range of complex commercial matters including contract disputes, business torts, government investigations, election law and healthcare litigation. Mr. Centrella also represents medical device manufacturers nationally in products liability matters in single-plaintiff actions as well as coordinated proceedings.

The Honorable Roger T. Hughes, Ret., served for over a decade on the Federal Court of Canada. A graduate of the University of Toronto Law School, Justice Hughes spent 37 years in private practice as a partner at the firm of Sim, Hughes, Ashton, McKay and McBurney before he was appointed to the Court Martial Appeal Court of Canada. Justice Hughes served on the Court Martial Appeal Court from 2006 to 2016 when he was appointed to the Federal Court of Canada. Justice Hughes currently practices as a neutral with JAMS ADR.

Judge Maricela Moore is the presiding judge of the 162nd Judicial District Court of Dallas County, Texas, and the Local Administrative District Judge. She previously served as the Presiding Judge of the Central Jury Room. In 2019, Judge Moore was named by the American Board of Trial Advocates as the Dallas Judge of the Year. Judge Moore received her Bachelor of Science from Boston College, magna cum laude, and her law degree from the George Washington University National Law Center in Washington, D.C. Prior to her judicial service, Judge Moore practiced commercial litigation with an emphasis on trade secret, breach of contract, and employment litigation. Judge Moore is Board Certified by the Texas Board of Legal Specialization in labor and employment law. Judge Moore is a Fellow of the Dallas Bar Foundation and Dallas Association of Young Lawyers Foundation. She is on the Advisory Board of the Dallas County Dispute Resolution Board and the University of North Texas Law School. Judge Moore is also a member of the College of the State Bar of Texas and a Master in the Mac Taylor Inn of Court. Judge Moore previously served as the President of the Dallas Hispanic Bar Association, Dallas Hispanic Law Foundation, and MABA-Texas, as well as a Board Member of the Dallas Bar Association. Judge Moore also currently serves as the Chairperson of CHRISTUS Health System Board of Directors.

Courtroom advocacy can be one of the greatest adjustments for young lawyers entering and mastering in the practice of law. The panel of Judges will address topics including what it takes to impress Judges both in filings and in courtroom advocacy, how to lose and gain credibility in front of the Judge, common pitfalls for young lawyers and suggestions on how young lawyers can seek out more courtroom experience. The panel will also discuss how a Judge sitting alone decides a case and how advocacy can affect the decision-making process.

DECIDING

By Roger T. Hughes

"Yes, but at the end of it all, how DO you decide?" a student asked. A fair question; one that lawyers ponder when they close their final brief of argument at trial. The same question that their anxious clients ask. How is the judge going to decide?

Let me give you some insights, now that the dust has settled on my judging career. These insights are given in the context of a trial of a patent case, where the issue is whether the claimed invention was obvious. Analogies can easily be made to other sorts of trials. Of course, these observations are based on my personal experience but, from my observation of several of my judicial colleagues, they are reasonably typical.

The Trial

A well-run trial must provide each of the parties an appropriate opportunity to make their case, to present evidence as to facts, to offer the opinions of experts and to make submissions as to the law and as to how the facts and opinions should be received and determined in the context of the relevant law.

Rigorous pre-trial determinations are essential, usually with the assistance of the judge assigned to hear the case or another judge or judicial officer. A trial is not an open-ended opportunity to say and put in everything that may occur to a party or counsel. Nor is it a forum for gamesmanship where one party may spring previously undisclosed facts or opinions on another party. Issues should be narrowed and clearly articulated. Facts that cannot be disputed or are not worth disputing should be agreed upon. Time is the most important commodity that a trial can offer. Limits must be established and allocation of time between the parties settled.

At the trial itself, counsel for the parties usually give a relatively brief opening statement. Agreed-upon evidence, including documents are entered into the record. Witnesses are examined, cross-examined, and examined in reply. Counsel make final submissions, following which the judge almost always takes the matter under reserve. The decision-making process begins in the judge's office and continues at a desk at home.

As a judge hearing a trial lasting several days, I made a habit, at the end of each day, of writing a synopsis of what went on at trial that day. I would note the essential points of counsel's opening

statement, of the facts agreed upon, of the facts established, or not, by each witness, of the opinions offered by each expert, and of the points made by counsel in final argument. These synopses would prove invaluable in writing my final decision. In addition, I would make notes of the evidence and opinions of each witness and place these in binders with tabs for quick reference.

Long trials of a technical nature, such as a patent trial, invariably result in the accumulation of masses of documents including reports and affidavits of experts, reference papers and documents, experimental data and so forth. The argument of counsel inevitably means that masses of legal authorities are referred to. I try to minimize much of this: give me only the most relevant documents and legal authorities; highlight the important passages. In providing expert opinion, provide a paragraph as to the field of expertise of the witness, another paragraph about the issues addressed by the witness and a summary of the witness's opinion. In argument, counsel should prove a skeleton brief of the points to be addressed and a compendium containing only the most relevant pages of the documents, transcript of evidence and legal authority. A compendium is meant to be thin.

In this day of electronic data storage, the court should be provided with a USB thumb drive or similar device containing the evidence, argument and legal authorities. A judge can then, with the aid of a computer, readily look up, where needed, all of the materials in evidence and legal authorities referred to. The days of boxes and boxes of paper are over.

Back at the Office

The trial is over. Back at the office I am armed with the evidence, argument, and authorities in electronic form, as well as the exhibits entered into evidence and against the wall are stacked documents, reports, affidavits, transcripts, and so forth. I have my notes, made each day, and my notes as to each witness.

Each judge of the Federal Court has the assistance of a law clerk, who is either a recently-graduated law student serving a period of articles or a lawyer recently called to the bar. The clerk's function is *not* to decide the case. The clerk may be asked to research points of law and to look through the evidence to find pertinent passages. Usually a clerk has been present in the courtroom for most of the trial and can act as a sounding board for discussion as to what went on and for developing ideas.

Other judges can also serve as sounding boards and providers of sober second thoughts.

The First Look

The first task is to define the issues for determination. During the course of final submissions counsel should state what those issues are. Often all counsel are in agreement as to the issues; some counsel may submit further issues. It may be that some issues need not be determined depending how other issues have been determined. It can be that some issues, such as quantification of damages or profits, have been deferred to a later time since, if the patent at issue is invalid or not infringed, there is no need to consider damages or profits.

It can be helpful, at the end of submissions by counsel, but before the close of trial, for a judge to set out to counsel what the judge believes are the issues to be decided. If there is any error or misunderstanding that can be cleared up at the time; counsel cannot say later to an appellate court that the trial judge failed to address an issue or failed to address the proper issue.

Assessing the evidence

I have found considerable comfort in a series of essays and speeches by Tom Bingham, Britain's former senior Law Lord, collected in a book entitled *The Business of Judging*[1]. In his foreword he says:

> *The judge's job at a civil trial, it is often said, is first of all to decide what happened (in legal jargon, "find the facts"), then to identify the relevant rules or principles of law, and then to apply the law to the facts as he has found them.*

To this must be added, as Bingham discusses in his first essay in this book, "The Judge as Juror," that a judge must turn from witnesses of primary fact to witnesses expressing expert opinions. As to expert witnesses, he writes, at page 18:

> *Expert witnesses may be and often are partisan, argumentative, and lacking in objectivity but they are not dishonest…How is a judge, faced with conflicting opinions of two or more experts to choose between them?*

Many times, the facts established by factual witnesses are not seriously disputed. As a judge, I sometimes wondered why they were called at all. Could not the facts have been simply agreed? Was there some mere quibble in dispute? Was a counsel simply being awkward? Or hoping that something would fall into his or her lap? It can be irritating to a judge when these matters should have been the subject of agreement.

Other facts may be in dispute or simply need to be proven. Factual witnesses are as you find them. Many have never given evidence before or even been near a courtroom. They are understandably nervous and uncertain, even if prepared by counsel beforehand. Leeway will be given by the court; a judge is interested in the facts to be established. Is the evidence credible? Is it corroborated? Does it make sense? Rarely does a court find two or more witnesses who flat out disagree as to facts. More often a court must determine whether a witness was in a good position to observe the relevant facts, does the witness's memory appear to be good, are there other facts or documents that support the evidence? In the absence of evidence to the contrary, is the evidence provided sufficiently plausible to be accepted? Is there any reason why the witness might misstate or embellish the evidence? In a civil trial, such as a patent trial, evidence as to the facts is accepted on a balance of probabilities. It does not need to be absolutely corroborated; the test is, on balance, is it probable?

Expert witnesses are a different story. In theory, an expert witness is there to assist the court; such a witness usually signs a statement to that effect. In reality, counsel for a party has selected a particular expert because such expert is prepared to provide opinions helpful to that party's case. Several potential experts may have been approached and their views canvassed before a particular expert is chosen. Rarely have I seen an expert who has not provided opinions helpful to the case of the party hiring him or her. Some experts, particularly the more learned ones, may be cautious I expressing certain views; they may concede that other views are possible. The "hired gun" expert usually digs in his or her heels and will not be moved.

With respect to expert witnesses, a judge must decide what opinions are most plausible. What opinions find support in the relevant scientific papers on the subject? What opinions appear to be supported by the majority of the relevant scientific or other appropriate community? I have found

[1] Oxford University Press, 2008.

that some evidence, particularly in economic forecasting, simply defies common sense and cannot be accepted.

Determining the Law

Our society is governed by the Rule of Law, a term often attributed to Professor A.V. Dicey, an Oxford professor of English Law, who wrote about the Rule of Law:

> *We mean, in the first place, that no man is punishable or can lawfully be made to suffer in body or goods except for a distinct breach of law established in the ordinary legal manner before the ordinary courts of the land.*[2]

A judge's task is to determine the law applicable to each of the issues before the Court, apply that law to the relevant facts and opinions, as determined by the judge, and thus arrive at the resolution of each of those issues. Often the answer is clear; if not, the judge will consider which party has the burden to prove the matter. If the judge has sufficient doubt then the party having the burden must bear the loss.

The law is established in several ways. One is by legislation, that is statutes and regulations. Legislation may be sufficiently clear on its face; however, a history of judicial interpretation and clever legal argument can make even the clearest rather murkier. The validity of legislation may be challenged on constitutional and other grounds. No cornerstone of legislation can be so solid that it cannot be moved, or at least shaken.

The other source of law in a common law system is that of precedent. As Lord Tennyson wrote, "Where freedom slowly broadens down, from precedent to precedent."[3] On the other hand, he also wrote, "Mastering the lawless science of our law, That codeless myriad of precedent, That wilderness of single instances."[4] And so it would seem to many that precedent is a wilderness of single instances or, to those struggling to make sense of it all, a broadening down from precedent to precedent to a firm body of law.

Fortunately, with respect to law established by precedent, much of it has broadened down to principles that can be safely stated and relied upon by a court. That is not to say that counsel will not lead a court through the thicket of precedents to instances said to define a hitherto unrecognized path in the law. The ingenuity of clever counsel will see to that. What a trial judge cannot do is deviate from established law as pronounced by higher courts. The judge may comment that the law, as it appears to have been established, is not applicable in the circumstances of the case or no longer makes sense, but it must be followed. In those rare instances where there is no established law, a judge should express his or her best view as to what the law should be and follow that, leaving to a higher court to express its views on the matter.

I will provide an illustration taken from patent law. The Canadian *Patent Act* defies "invention" to mean "any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter."[5] On reading this definition, one might conclude that an "invention" is something "new

---

[2] Dicey, A.V., *An Introduction to the Study of the Law of the Constitution* (1885; 9th edn., Macmillan, 1945) p. 188.
[3] Tennyson, Alfred, "You Ask Me, Why, Tho' Ill at Ease," 1842.
[4] Tennyson, Alfred, "Aylmer's Field," 1864.
[5] RSC 1985, c. P-4, s. 2 "invention."

and useful." However, in 1964 the Supreme Court of Canada in *Hoechst*[6] has held that inventive ingenuity is also a requirement for the obtaining of a valid patent. Another way of expressing the matter is that what is claimed in the patent as being the invention should not be "obvious." Thus, in addition to "new" (or novelty) and "useful" (utility), the claimed invention shall not be "obvious," even though the statute, at the time, said nothing about being "obvious" or not. As of 1983, section 28.3 has been added to the Canadian *Patent Act*, saying that the subject matter of a patent claim must "not have been obvious" having regard to "information [previously] disclosed." Not a very helpful definition, as "obvious" is still not defined.

Where does a court comprised of a judge or judges, most of whom have had little higher scientific learning, and particularly learning in the esoteric scientific fields now to be addressed in a particular case involving a patent, determine, on the facts and opinions presented, whether the claimed invention is "obvious"?

The courts have floundered on the matter. Various "tests" have been propose, each succeeding the last, which are intended to "clarify" or "simplify" the exercise. Does "obvious" mean something that a skilled person in the relevant art would consider "worth a try," or is it something that such person, upon considering the matter, including relevant prior disclosures, would find to be "more or less self-evident." Should motivation and effort required be considered in determining whether a claimed invention was obvious? The claim itself must be examined to determine what is the "essence" of the invention as claimed and, therefore, was that essence "more or less self-evident."

The court will be faced with competing opinions from experts. Those opinions will be couched so as to incorporate or align with the current phrases used in the jurisprudence, such as "motivation," "self-evident" and "worth a try." If many solutions were self-evident, does one obtain a valid patent by picking one of them?

If a judge cannot find a clear answer, having regard to all the relevant facts and opinions considered, the judge must fall back on the burden of proof. The Canadian *Patent Act*, sub-section 43(2), states that a patent shall "…in the absence of any evidence to the contrary, be valid." The court will understand that "any evidence" means taking all of the evidence into consideration and if it finds the evidence to be evenly balanced, the patent remains valid.

Thus, in a patent case, where the issue is validity and, in particular, whether the claimed invention was "obvious," a judge will determine the relevant facts, in particular what was previously disclosed in the field to a person skilled in the art, and consider the opinions of the experts as to whether what is claimed in the patent was "obvious," that is, more or less self-evident. Only if the judge remains undecided will the presumption of validity come into play.

Is It All Cut and Dried? Are Judges Human?

Tom Bingham, whom I have previously quoted and obviously admire, wrote as to the public's perception of judges:

> *As for the judges, the pubic entertains a range of views, not all consistent (one minute they are senile and out of touch, the next the very people to conduct a detailed and searching inquiry; one minute port-gorged dinosaurs imposing savage sentences on*

[6] Commissioner of Patents v. Farbwerke Hoechst A/G, [1964] SCR 49 at 53.

> *hapless miscreants, the next wishy-washy liberals unwilling to punish anyone properly for anything), although often unfavourable.*[7]

On a recent trip to Europe I met a woman who had grown up in Eastern Europe in the Soviet era. She asked me: Have you ever been offered a bribe? Have the politicians ever tried to influence your decisions? My answer to each of her questions was no. Her questions were not idle ones. She told me that her father was a judge in her native country. He was offered bribes, which he refused, and, when he would not make decisions that the politicians preferred, he was removed as a judge and sent to work at a hard and dirty job in an iron foundry, where he died.

These thoughts are not new. The Old Testament/Tanakh reports that the Prophet Micah, in the 8th century BCE said about his country: "Its rulers give judgment for a bribe, its priests teach for a price, its prophets give oracles for money."

It is easy, and probably part of human nature, for a party who has lost a trial, or even an issue, to say that the judge was biased against them or their witnesses or their counsel. They may point to instances during the hearing or in the reasons for judgment that, they will argue, bear out their suspicions. Unfortunately, judges are vulnerable to such attacks but are constrained from rebutting them.

Judges are humans, with all the faults and virtues that this entails. Judges, as a result of their experiences, come to the bench with certain dispositions: conservative, liberal, solemn, humorous, patient, short-tempered, kind, brusque, and the list goes on. The point is that most judges will try to rise above these dispositions; they will put them aside. They really do want to do the right thing! The judges' Oath of Office means something:

> *I will do right to all manner of people after the laws and usages of this Realm without favour, affection or ill will.*

I have experienced many instances where my prejudices were challenged. For instance, some counsel are inexperienced or simply inept; some are arrogant or saucy. There have been examinations and cross-examinations that I have admired, others left me in despair. Some parties have taken positions that are untenable; others are amazingly conciliatory. Witnesses can be evasive or forthcoming. Opinions of experts can be farfetched, even for a layman, or make perfect sense. Arguments can be obtuse or clear and logical. All of this must be received at trial and taken into consideration when returning to my office and home at the end of the day.

Then, when deciding, I have to clear my head and conscience and try to determine, the best I can, with prejudices put to one side, what are the facts, what are the most reasonable opinions and what are the most appropriate arguments made by each party. This can mean that a few days are needed just to clear the air. Drafts of reasons are written and re-written. Sometimes I have written drafts of reasons in which I have decided one way and in another draft the other way before determining which is the right way to go. One judge once remarked that the bottom drawer of your desk can be your best friend. Put your draft in there and take it out a few days later. Does it still look right?

[7] Bingham, Tom, *The Rule of Law*, Allen Lane, 2010, p. 9.

Writing It Up

A judge's decision consists of two parts. The first is the Judgment or Order, which is an instruction to the parties or, if needed, a sheriff or law enforcement officer, as to what must be done. For instance, a party may be enjoined from doing certain things or ordered to pay a certain amount of money. Costs will be awarded, and so forth. Often this part is not included in published law reports.

The other part of the decision is the reasons, which serve to explain why the judge came to the decision. This is the part studied by lawyers and scholars and often the subject of legal debate. For whom are the reasons written? Primarily for the parties. They should be able to understand that the relevant issues were addressed, that the evidence was considered, that the expert opinions were understood, and that the legal arguments were appreciated. They should know what facts were determined, what opinions accepted, and what arguments were found persuasive. Reasons are given particularly in areas where the law was previously uncertain, so that lawyers and scholars can obtain guidance.

And then there are the appellate courts. Some judges are very aware that their decisions may be reviewed by an appellate court. Others don't care. The point is, in respect of any appeal, to ensure that all relevant issues, findings of fact, preferences as to opinions, and consideration of arguments are covered.

Judges are given lessons about how to write reasons. They are told to put the main issues concisely up front and to provide, up front, a brief summary of their determination. It is not a mystery novel; one should not have to read through to the last page to see how it turns out. Judges are told that brevity is preferred, but that personal style should not be unduly constrained. Any student examining the reasons given by different judges knows how different these styles can be.

One thing to remember is that in writing reasons a judge already knows how the matter will turn out. It is a question of setting out how and why.

Appellate Courts

Appellate courts serve a particular function, different from a trial judge. They are, by and large, required to accept the factual findings of a trial judge and the preferences as to opinion evidence. Their function is to correct errors in law, to clarify controversial questions of law, and to determine what the law is in previously uncharted areas.

Sadly, this is not always the case. Counsel arguing a case in an appellate court is challenged to find the cracks and seams in the findings of a trial judge, to characterise the lenses through which a trial judge received the evidence and opinions as errors of law. They argue that, had the trial judge looked at the matter through this legal lens rather than that, their client would have prevailed.

One American trial judge once remarked that, once the dust of battle at trial had settled, and the cold light of dawn on appeal has risen, the court of appeal arrives to shoot the wounded.

Appellate courts have fewer judges than trial courts and one is less likely to find a judge or panel of judges in any appellate court that has a particular expertise in respect of the matter at hand. This is particularly so in patent matters, where we find appellate courts straying from the relevant

statutes and regulations into so-called common law principles of the “inventive concept” and “promise of the patent,” much to the puzzlement of the profession.

It is a different game in the appellate levels. One admires those appellate judges who can keep their attention fixed on the real issues and points of law.

And So

Have I clarified things? Probably not. But there is no magic bullet, no secret technique in arriving at a decision. It is a matter of a human being trying to be fair and do the right thing.