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Q&A With Perkins Coie's Dan Bagatell

Law360, New York (October 01, 2009) -- Dan L. Bagatell is a partner with Perkins Coie LLP in the firm's Phoenix office and co-chair of the firm's appellate litigation group. His practice focuses on patent and other intellectual property litigation and on a wide array of civil appeals.

Q: What is the most challenging case you've worked on, and why?

A: Pfaff v. Wells Electronics Inc., 525 U.S. 55 (1998). It involved the "on sale bar" of section 102(b) of the Patent Act, which says a patent is invalid if the invention was on sale over a year before the inventor applied for the patent.

The Federal Circuit invalidated Pfaff's patent, holding that an invention may be "on sale" if it is "substantially complete" when offered for sale. Pfaff then petitioned for certiorari, arguing for a bright-line rule that an invention must be fully complete — reduced to practice — before it can be on sale. The Supreme Court granted review.

When Wells retained us, we looked at the case and concluded that the court intended to reverse, as "substantially complete" appeared nowhere in the statute and the test was hopelessly vague. Desperation led to audacity: we abandoned the decision below and retreated to first principles, arguing that the one-year clock should trigger if the invention was "ready for patenting" at the time of the offer. It paid off: the court unanimously agreed and affirmed.

Q: What do you do to prepare for oral argument?

A: I start by reviewing the record and the authorities cited in the briefs. Then I put together an oral argument "bible" consisting of an outline of key points I want to make, a "Q&A" with my answers to the toughest questions, and a list of the key dates, documents and record citations.

I also like to have moot courts with extended hostile questioning by lawyers who know the case and by lawyers with fresh perspectives. I don't try to memorize the whole argument, but I do prepare an introduction and get down my basic points, transitions and exit strategies.

Q: What are some of the biggest problems with the U.S. appeals process?

A: Too many appeals are decided without oral argument and with only cursory memorandum opinions (or, worse, one-line affirmances). Unless an appeal is frivolous, litigants deserve oral argument or a thorough, reasoned written decision.

Last year, the federal circuits granted argument in only 30 percent of their cases. Some circuits heard argument only half as often. Memorandum decisions are now the norm and many are perfunctory. Amazingly, the Eighth Circuit summarily affirmed without any substantive opinion over 30 percent of the time. That's disturbing, and the problem may get worse now that unpublished opinions can be cited.

Judges will be tempted to issue more judgment order affirmances and ever-thinner memorandum decisions, which will only reduce the public's trust. On the state court side, I think the biggest problem remains judicial elections that create appearances of partiality. The recent Caperton case was just the tip of the iceberg.

Q: Aside from your own cases, which cases currently on appeal are you following closely, and why?

A: I handle many patent appeals, so I follow key cases before the Federal Circuit. One right now (Ariad Pharmaceuticals v. Eli Lilly) involves the written description requirement. I also follow civil cases in the U.S. Supreme Court and the California and Arizona Supreme Courts, especially those involving antitrust issues, deceptive trade practice issues and class actions and civil procedure more generally.

Q: Outside your own firm, name one lawyer who's impressed you and tell us why.

A: Tom Goldstein [a partner with Akin Gump Strauss Hauer & Feld LLP] has won my admiration. He did not come from a classic appellate lawyer background (he didn't go to a fancy law school, do a Supreme Court clerkship, take an assistantship at the Solicitor General's Office, etc.), yet he has broken into the elite ranks of the Supreme Court bar. It's great to see that skill, hard work, and gumption can still lead to success.

Q: What advice would you give to a young lawyer interested in getting into your practice area?

A: To succeed as an appellate lawyer, you need a broad grasp of the law — like the judges you will be facing. Our industry has been trending toward ever-greater specialization, but the best appellate lawyers are generalists and need to stay on top of developments in many areas. I recommend reading U.S. Law Week to follow the leading federal and state appellate decisions. The daily appellate page of Law360 has useful articles and features too.

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