Trial Pros: Marshall Gerstein's Tom Ross

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Thomas I. Ross, a partner at Marshall Gerstein & Borun LLP, has litigated in district courts throughout the United States and in the International Trade Commission on matters involving patents, trademarks, copyrights and trade secrets. He has been first chair on numerous trials, both bench and jury, and has been the lead attorney on a number of appeals before the Court of Appeals for the Federal Circuit and other circuit courts. He has training in mechanical engineering and done work as an examiner at the U.S. Patent and Trademark Office. He has been engaged for expert testimony on patent law and patent office practices.

Ross has received numerous professional honors throughout his career such as being a fellow of the Litigation Counsel of America, a member of the Barristers of the Patent Law, named an Illinois Super Lawyer, and has been listed in Leading Lawyers Illinois, Who's Who in American Law and Martindale-Hubbell.

Q: What's the most interesting trial you've worked on and why?

A: My most interesting trial was one in which there was a battle of credibility on cross-examination.

It was a patent infringement case directed to a cryogenically refrigerated rail car. The patent application was based on an experimental prototype. The prototype construction had been funded by a trade association, under the authority of the named inventor who headed the association. Validity of the patent turned on whether the prototype design had been provided by the named inventor or was the inspiration of the assemblers for which the named inventor took credit and filed for the patent. Both the named inventor and the assemblers were versed in refrigeration technology and had independently been contemplating a cryogenically cooled rail car. They both prepared concept drawings of such a cryogenic system, but dated the drawings after the two sides first met to discuss the project.

Both sides claimed to have given the patented design to the other. The question of inventorship came down to their credibility; so the goal for the lawyers was impeachment. The efforts at impeachment focused mostly on inconsistencies in the retelling of their

stories. The patentee lost the credibility contest at the preliminary injunction hearing primarily because the named inventor claimed that the assemblers were not even invited when the prototype was showcased to the industry. We were able to confront him on the stand with an amateur video showing the assemblers in attendance. At trial, we thought we got the better of the named inventor again when he suddenly claimed to have discussed his idea for the cryogenic rail car with an industry official prior to meeting with the assemblers. On cross, we made him go over in detail his meeting with this official, including having him describe the official's physical appearance. We noted that this official had never been listed as a corroborating witness and was not being called to testify, and finally that a confirmed photograph of the official proved he looked very different than how the named inventor described him on the stand.

Alas, the credibility contest at trial resulted in a draw, and the patent was held not invalid and infringed. On the one hand, the named inventor embellished his invention story at trial when compared to his deposition testimony; but on the other hand the assemblers could not prove that the named inventor had not shared his idea with them at their first meeting. On appeal, the trial verdict was reversed and the patent held not infringed, such that all this testimony on inventorship became moot.

Q: What's the most unexpected or amusing thing you've experienced while working on a trial?

A: We had an unconventional procedure instituted by the U.S. magistrate judge in the Eastern District of New York for a patent infringement trial involving dental prophylaxis. The parties agreed to proceed to trial before the magistrate since the judge was occupied conducting the John Gotti trial. The magistrate judge insisted upon sitting behind a table at floor level such that he could look directly at the witnesses who were required to sit in a chair facing him in giving their testimony. Counsel were seated at tables on opposite sides of the witness chair and from there, while seated, conducted the questioning. The exhibits and visual demonstratives were shown on a screen to one side of the magistrate's table. The magistrate judge was intent on determining the credibility of the witnesses by scrutinizing them physically while testifying. We hired a psychologist to help our witnesses with facial expressions and body postures.

Q: What does your trial prep routine consist of?

A: Generally speaking, there are two critical steps toward trial prep that are taken before the close of fact discovery. First, guided by the case law, we start formulating how we want to tailor/tweak the jury instructions to favor our positions. For example, the model instructions on obviousness overlook nuances supported in the case law that can trip up jurors inclined to find obviousness, such as by inserting the requirement that they must be able to articulate a logical reason to modify or combine the prior art. Second, the team makes an objective dissection of our case arguments. We need to identify their true strength before the expert reports, since we wish to avoid tarnishing the expert's credibility with lackluster points. But also we want our arguments to align with how we wish the jury instructions to read, because that history will confirm to the judge that our nuances are nothing new or arbitrary when the time comes for jury instructions.

As trial gets closer, and putting aside preparation of the pretrial order and motions in limine, we rehearse the witnesses with scripts containing just proposed questions. This prepares the witness and enables us to refine the questions to elicit the best responses. We incorporate the presentation technology in this process and program how we wish to display key aspects of the exhibits. This is also when the analogies the witnesses will use at trial get developed. And ideas for demonstratives to be used at trial typically come out of these rehearsals. At the same time, we also are preparing the cross-exam scripts. These scripts may even include confronting the opposing expert with an analogy to get it validated. And from that preparation comes plans for at-trial evidentiary objections, requiring the advance preparation of bench memos.

With the expected testimony established, the opening statement is prepared. It goes through stages of being written out and having slides prepared showing key documents and displaying key points. Finally, the opening is practiced and its written form reduced to a list of the slides and a few key statements, so that it will be delivered essentially without ever losing eye contact with the jury. Lastly, whether working with a jury consultant or not, we consider the traits we expect would make an ideal foreperson for our case and prioritize them so that, if we are allowed to do some voir dire, we can pose questions intended to reveal those traits and use a rating system based on those traits to guide our selection strategy.

Q: If you could give just one piece of advice to a lawyer on the eve of their first trial, what would it be?

A: My advice would be: stay true to your case. The adversarial process means there are going to be twists and turns during the course of trial that will weaken your confidence. But the positions and arguments the team has spent hours thinking through deserve your commitment. It is likely that those positions are so interwoven into your trial case that a significant change will break the seamless web necessary to establish credibility with the decision maker.

Besides, it is not unusual that what we perceive as harmful to our case is itself viewed with suspicion, ignored or rationalized away by the decision maker. One example of this occurred in a pacemaker patent trial held in Florida when the party representatives on behalf ofSiemens AG became concerned for our case because the opposing expert unexpectedly delved into the time he spent in a German prisoner-of-war camp. When the trial was over, the judge let us talk with the jurors and, to a person; they said they simply ignored his remarks about World War II.

Perhaps the patron saint of trial should be Ho Chi Minh, who after the Vietnam War ended was challenged by a U.S. diplomat to agree that the North lost almost every battle with U.S. troops. “Yes,” he said, “instead we won the war.”

Q: Name a trial attorney, outside your own firm, who has impressed you and tell us why.

A: I have observed an aura of patience with experienced trial attorneys that impresses me as very professional. Coupled with that, I am always grateful when my opponent remains civil and is courteous.

One trial attorney who was all of that was James Donohue, formerly with Heller Ehrman LLP and now a U.S. magistrate judge. I worked across the aisle from Jim on two patent infringement cases, one of which we tried. I will never forget the time when I, representing the patent owner, was deposing the defense expert in a multiple defendants case in which Jim represented one defendant. I wished to represent to the expert that some arcane event had occurred rather than have to demonstrate it through a series of papers. The other defense counsel were inclined to make me undertake the time and trouble to confirm it to the expert; but Jim told them no (he was that respected), if I said the papers confirm it then the expert should assume it to be true. Basically, he followed the Golden Rule: “Do unto others as you would have them do unto you.”