PERSPECTIVES *on* APPELLATE PRACTICE

How I Became a Patent Appellate Lawyer

By Gregory A. Castanias

Like most of the good things that have happened to me in my life, to the question of how I became a patent appellate lawyer, the answer is: by accident.

When I started practicing law over 20 years ago, there was nothing on my résumé that would have marked me as headed for a career as an appellate advocate in high-tech cases, particularly patent cases. My college majors were English literature and philosophy. My law-school transcript contained no intellectual-property courses; when I once thought out loud about taking a patent-law course, "they"—probably 2L and 3L students who spoke with the authority of elders—told me that there was no point, because I didn't have a science degree. So I took another constitutional law course instead.

My clerkship with Judge George C. Pratt of the Second Circuit—which started after I had been practicing in my home town of Indianapolis for almost a year—had no patent content, because by then, patent appeals had become the exclusive province of what my law professors called a "weird" specialized court in Washington, D.C. That "weird" court, the Federal Circuit, was a court of appeals that heard nothing but patent cases and certain kinds of government cases. My clerkship was blissfully empty of any exposure to patent law, with the singular exception of a box on Judge Pratt's shelf called a "Patent Lawyer Detect-O-Meter" (a joke gift from some of my predecessors who, when Judge Pratt was a district-court judge, had some negative experiences with patent litigators appearing before the judge). The docket of the Second Circuit did, however, provide me my first exposure to some juicy issues of copyright and trademark law.

I arrived at the Washington, D.C., office of my firm in the fall of 1992, as the newest associate in the firm's relatively new "Issues and Appeals" practice, which then numbered about eight lawyers. Then, as now, "I&A" was intended to have the best features of an appellate practice and a trial-court "significant issues" practice. One of the unfortunate by-products of my relocation to D.C. from Indiana via New York, however, was that I was going to have to take another bar exam to be eligible to practice in Washington. So my first few months at the firm were mostly short-term projects—a Supreme Court brief here, a memo there, but nothing that required a long-term time investment, for at the end of January 1993, I would disappear for almost a month to cram for and take the bar exam.

> Patent appeals had become the exclusive province of what my law professors called a "weird" specialized court in Washington, D.C.

That, it turned out, was how patent law was bestowed upon me.

With a couple of weeks to go before my bar-exam-related departure, I went to my boss, Tim Dyk (himself now a judge on the Federal Circuit) and let him know that I had time to take on something that would fill those two weeks. What I got was an assignment to look at some discrete issues in a case that had just arrived at the I&A practice's doorstep, and that eventually became known in the case reporters as *Exxon Chemical Patents v. The Lubrizol Corporation*. "The copper case," as it was often called (the Exxon patent in the case had to do with a motor-oil additive containing small amounts of copper), involved a large adverse verdict suffered by one of the firm's longstanding institutional clients, The Lubrizol Corporation of Wickliffe, Ohio, and it exposed me to a group of lawyers from the firm—and from Pennie & Edmonds, a now defunct patent "boutique," many of whose lawyers I am now proud to count as my partners—who served as my first mentors in the practice of patent appellate litigation: Tim Dyk, John Edwards, and Ken Adamo from my firm, as well as the late Leslie Misrock, Stan Lawrence, and (even though he is more of a peer) Paul Zegger of the Pennie firm.

Through my experiences in the copper case, I learned the critical parts of Title 35 of the United States Code. To my surprise, the statutory provisions of the patent law were pretty short and simple; the devil was in the details of the case law, which applied those deceptively simple provisions to a variety of technologies and factual scenarios. I struggled, for the first time, with the process of patent interpretation. I read a lot—*a lot*—of Federal Circuit opinions. I familiarized myself with the Chisum treatise. When Paul became a Pennie partner, I became the senior associate on the case (never mind that I was also, still, the junior associate).

And we won. A $129 million verdict adverse to our client had been reversed "as a matter of law."

By this time, I had established myself within my firm as "the IP lawyer's I&A lawyer," mostly because I was the one associate in the I&A practice who had really dug into a patent case. And, in a firm of 1,200 lawyers (now twice that size and some), there was a ready base of internal clients. The first post-Lubrizol call was from Joe McEntee and Tom Jackson, partners in our Dallas office, to help brief a case for Texas Instruments (TI). I eventually worked on about half a dozen TI trial-court cases and two appeals for that client.

The next call also came from our Dallas office, from Robert Turner and others, asking for Tim Dyk's and my help in a case for Micro Chemical, Inc., an Amarillo-based

company whose technology portfolio was principally directed at machines and methods for raising livestock—mostly cattle. We got involved in the briefing, Tim argued the case, and we won on appeal, forcing a remand to the district court in Colorado.

That proved to be one of the best accidental opportunities I ever got, because the company's Amarillo lawyer saw enough in me—by then a mid-level associate—to entrust argument of all of the company's future patent appeals to me. I eventually argued four cases for Micro Chemical in the Federal Circuit, winning three. The first one was a loss on an issue of patent-claim construction, but it may be the most memorable of the four, because it was my first Federal Circuit argument ever. Presiding on the panel that morning was Giles Rich, who was then in his 90s. Pretty much everyone knew that Judge Rich had written the 1952 Patent Act, which still is the guts of the modern patent statute, so this was a daunting first patent appellate argument. I feel like I held my own, even though we lost that appeal. The case was later tried to a victory for Micro Chemical, and a few years later I would argue the appeal that upheld the trial verdict in our client's favor, as well as two other successful Federal Circuit appeals out of that Colorado case.

Now, in 2011, I have argued somewhere around 30 cases in the Federal Circuit, and been counsel in way over 100 cases there. I like to say that I am equally experienced in all kinds of technology. Of course, that statement is true because I have no technological background to speak of in any area. But it's also demonstrably true—aside from motor-oil additives, semiconductors, and livestock-feeding equipment and methods, I have had cases involving such diverse technologies as pharmaceuticals, electrical-outlet covers, floor coverings, satellites, satellite TV, flat-panel TVs, stereo speakers, GPS instruments, medical diagnostic methods, spinal implants, computer software, algae-based nutritional additives, portable blood collectors and separators, undersea oil-well drilling, fiber optics, rubber gaskets, tins for holding candles, and stereotactic radiosurgery instruments. (I used to say "patent law isn't rocket science," but then I got a case involving an outer-space communications satellite. So then I said "patent law isn't brain surgery," until I worked on cases involving the "gamma knife" for noninvasive brain surgery.) And one of my big upcoming cases, on which we've just finished the briefing as I write this, involves whether isolated DNA molecules, and methods for determining a person's proclivity to breast and related cancers using those isolated molecules, are eligible for patents under 35 U.S.C. § 101.

Despite that history, I'm not exclusively a "patent appellate lawyer." I've had the good fortune, in my mid-40s, to have argued three non-patent cases in the U.S. Supreme Court, and a number of non-patent cases in the other federal courts of appeals and in state appellate courts. I'm a "jack of all trades, master of a few."

But when it comes to patent cases, I'm proud to call myself "the dumbest guy in the room." I'm not a geneticist or a microbiologist, but I do have a liberal-arts education, which means I can sit down with a book, or, preferably, with one of my extremely smart clients or colleagues, and learn enough about the technology to be conversant about it. I actually think that my lack of a scientific background is the source of my ability to add value, because I have to understand the technology at a basic enough level to write about it clearly, and my audience at the Federal Circuit is also a bunch of generalist judges, even though they sit on a "specialized" court (which, it turns out, isn't nearly as "weird" as my professors led me to believe). Put another way, I don't have to be able to isolate a gene in a laboratory to write about it, or talk with judges about why an isolated gene is in fact a human invention.

But none of those opportunities would have been available to me were it not for the presence of a number of mentors in my career. I've purposely called out a few of them above, because this is the single most important contributing factor to how I got from point A (as a young associate) to point B (as an experienced appellate lawyer known for expertise in a particular subject matter). And by writing about the intellectual-property part of my career, I haven't even mentioned Bob Klonoff, now Dean of the Lewis & Clark School of Law, and the late Erwin Griswold, both former partners of my firm, who were important mentors to me despite not doing patent cases with them. All of these lawyers taught me, spent time with me, shared war stories, graciously opened the doors that provided these opportunities, and helped me see the path to point B, even when it wasn't obvious that I should even want to go there. For better or worse, they made me who I am today. I hope that my younger colleagues will be able to say the same for me.

All successful appellate lawyers, if they are being honest, can tell you the same story about what their mentors meant to them, because there's no such thing as a self-made success in this business. ■

Gregory A. Castanias is a partner with Jones Day in Washington, D.C.