

# Judge versus jury: key tips for success

**The decision on whether to try a case before a judge or a jury is a vital part of US trademark litigation strategy. Picking the wrong option can prove damaging**

The US litigation system is perhaps among the most complex in the world. There are various options available and choosing the wrong path could have a devastating impact on the outcome of the case. At the outset, even before filing a complaint, a plaintiff rights holder must determine whether a judge or jury will decide the case. Trying an action before a jury introduces an element of uncertainty not present in a bench trial before the judge alone. This means that the more straightforward and less complicated the case, the more likely it is that you would want to put it in the hands of a judge. Nonetheless, if the plaintiff is strongly considering a bench trial it is vital to research the judge carefully (see “Judging the judge”).

## Jury pros and cons

If the defendant asserts a counterclaim seeking monetary damages, it is entitled to a jury trial (see eg, *Sears Roebuck & Co v Sears Realty Co* (30 USPQ 2d 1219 (NDNY 1993))). In deciding whether to demand a jury in a trademark counterfeiting case, a defendant may consider factors such as the jurors’ likely attraction to the type of goods that the defendant sells as an inexpensive alternative to the plaintiff’s version of the same goods. Jurors might, for instance, want to purchase the defendant’s imitations for a few dollars rather than pay hundreds or thousands of dollars for the real thing.

The more complex or difficult the case, the more attractive a jury may seem, especially to the defendant. A notable example is the case of *Marshak v Treadwell* (240 F3d 184 (3d Cir 2001)), which involved issues of fraudulent procurement, abandonment and infringement of the defendant’s common law rights in the mark THE DRIFTERS for a popular music group. The US Court of Appeals for the Third Circuit affirmed a jury’s finding that:

- the plaintiff fraudulently procured a registration from the US Patent and Trademark Office (USPTO);
- the plaintiff’s registration should be cancelled; and
- the plaintiff was infringing the defendant’s earlier common law rights.

Jury trials, however, have their drawbacks. They are typically much more expensive than bench trials. They also require the parties to put on an elaborate show for the decision makers, educating them about the case from square one and making preparations (eg, *voir dire* and jury instructions) not necessary otherwise. Moreover, common sense dictates that there are fewer US lawyers – at least proportionally – experienced in, and capable of handling, jury trials than bench trials. In part, this is because so many lawyers graduating from US law schools disappear into large law firms, where they may spend several years toiling on document production instead of gaining valuable in-court experience.

## The discovery phase

The ‘paper discovery phase’ of a case (interrogatories, document requests and requests to admit) does not differ appreciably in a jury trial and a bench trial. Always follow the obvious steps. Check local and other relevant regulations (and the judge’s individual rules) to make sure you are not exceeding the permissible number of interrogatories and requests to admit. Both parties should be careful to follow new e-discovery rules.

A plaintiff asserting trademark infringement or unfair competition claims should serve discovery covering the likelihood

## Judging the judge

When researching the judge, the rights holder and its legal advisers should examine, among others, the following factors:

- Does he/she have a strong record of deciding trademark cases in favour of the trademark owner?
- Is he/she especially sympathetic to large companies (eg, manufacturers) or small companies/individuals who may appear as defendants in trademark cases?
- Does he/she refer every case to mediation? Is this attractive for cost reasons? Investigate the mediator’s track record on trademark cases.
- Assess the complexity of the case. For example, if your case involves not only the trade dress of a product but also patents, it may be more suited to a judge than a jury.
- Are grey market imports involved, making the defendant’s culpability less obvious?
- The defendant may prefer a jury, on the theory that the judge can hold up the verdict unilaterally.

Trying an action before a jury introduces an element of uncertainty not present in a bench trial before the judge alone



of confusion factors set forth in the age-old *Polaroid Case* (*Polaroid Corp v Polarad Elects Corp* (287 F2d 492, 495 (2d Cir 1961))). For example, the plaintiff should seek identification of individuals with knowledge of, and documents illustrating, the defendant's creation of its mark. It should also seek out any individuals acquainted with the defendant's channels of trade. The plaintiff should inquire about:

- the defendant's intent in adopting its mark;
- any alternatives considered but not chosen and the reasons why they were not adopted; and
- any known instances of actual confusion.

Such evidence may be fertile ground for demonstrative exhibits designed to retain the jury's attention.

If the defendant raises a fair-use defence, the plaintiff should ask the defendant to identify the types of use that it has made, specimens showing each use and the witnesses who can describe the reason for adopting each such use.

The defendant may also actively take discovery. For example, the defendant may consider posing the following questions if it has claimed abandonment, either as a counterclaim or affirmative defence:

- Has the plaintiff really stopped using the mark and, if so, for how long?
- Does the non-use amount to the requisite three years?
- Does the plaintiff have no intent to resume use?

If the plaintiff has made filings with the USPTO under Sections 8, 9 (renewal) and 15 of the Lanham Act, the defendant should take discovery of the specimens underlying those filings and should ask who handled the filings.

If the plaintiff asserts a dilution claim, the defendant should seek to determine whether the plaintiff can establish the fame of its mark under Section 43(c) of the Lanham Act. The defendant should inquire as to:

- the duration and geographic reach of advertising;
- the amount, volume and geographic extent of sales of products under the mark;
- actual recognition of the mark; and
- whether the mark is federally registered.

In general, the parties should schedule a deposition after completing at least one round of paper discovery. This does not vary appreciably whether the proceeding is a bench or a jury trial.

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Although videotaped depositions are not very useful in a bench trial, they may be more so in a jury trial. They can be used to illustrate points to the jury in an engaging way.

### Jury proceedings

The first step in actually selecting the jury is the '*voir dire*', which means the examination of the potential jurors. This procedure varies considerably from jurisdiction to jurisdiction. According to Rule 47(a) of the Federal Rules of Civil Procedure, the court has discretion over conducting the *voir dire* process. Although Article 47(a) states that the court may "permit the parties or their attorneys to examine prospective jurors", it is more common for the court to do so. At the time that *voir dire* begins, counsel will have limited information about the potential jurors – their names, addresses and usually their occupations. The court may allow the parties to submit questions to the court.

### Questions for the jury

What types of questions should you suggest posing to the potential jurors? Most fundamentally, you could ask if the potential juror has ever heard of your client (or the opposing party). You could also ask the potential juror whether he or she is aware of the types of merchandise that each party sells. Another key question to pose is whether the juror, in rendering a verdict, would have a problem treating a corporation in the same way as an individual.

*Voir dire* questions filed earlier this year by Louis Vuitton in an internet service provider liability case (assuming they were accepted by the court) provide a good model to follow (*Louis Vuitton Malletier SA v Akanoc Solutions Inc* (Case C 07 3952 JW (ND Cal filed August 18 2009))). The questions included the following:

### Building a case for the jury

Once the plaintiff elects to go down the jury route a number of other related decisions will need to be made. These include the following:

- Choosing the venue: the forum for the case can be critical and must be researched carefully. A list of possible venues is provided in 28 USC §1391.
- Determine how each venue would affect your case: what are the jury pools like – well educated or not? In a trademark infringement case, this might not make so much of a difference; 'average' consumers would probably be the right demographic to seat on a jury about general consumer products, unless the case involves luxury goods.
- Naming the parties: the plaintiff should name any possible defendants in their individual capacities, as well as naming the corporate defendants. This is especially important in counterfeiting cases, in which the funds of the business and the defendant are often commingled, and the businesses may be 'dry holes', with the individual proprietors draining them of all of their assets (see eg, *Chloé v Designersimports.com USA Inc* (07-CV-1791, 2009 WL 1227927 (SDNY April 30 2009)) and *Burberry Ltd v Barakat* (8:07-cv-00431 (MD Fla June 29 2007))).
- Consider retaining a 'jury focus group' to listen to counsel's presentations and then discuss them under observation.
- Think about investing in market research to determine how consumers in the geographic area view the relevant products and any advertising in which the parties engage.
- Obtain demographic information from the plaintiff about consumers for the relevant product (eg, age range, sex and ethnicity).



- Do you own any Louis Vuitton products? If so, where did you buy them?
- Do you ever shop online?
- What do you think of the cost of Louis Vuitton products?
- How does the profitability of a company affect your decision on whether that company should be awarded damages?
- How often are you using your computer? For what purposes?
- Have you ever worked for eBay or Google?
- Are you familiar with the term 'knock-off'?
- Have you purchased a 'knock-off' or 'replica' item?

#### Jury challenges

Each party has three 'peremptory challenges' to strike jurors under Article 47(b) of the Federal Rules of Civil Procedure. Peremptory challenges, however, must be supported by a reason if the opposing party makes a *prima facie* showing that the challenge was used to discriminate on the basis of race, ethnicity or sex.

What should you look for when making peremptory challenges? In general, strike the potential jurors who seem likely to pay close attention to the case and might also be inclined to rule against your client. As a plaintiff in a trademark infringement case involving consumer goods, you might look for potential jurors who do not make the purchasing decisions (eg, husbands in the average household or persons who can afford to employ someone to make household purchases for them). More importantly, keep jurors who 'look like you', (ie, those with whom you can identify and build a rapport).

#### Start, middle and end

The opening statement in a trial is key. Practitioners generally agree that around 90% of their cases are won or lost at this time. The opening statement should:

- show a clear picture of the case;
- pique the jurors' interest;
- build a relationship with the jurors; and
- (for the defence) indicate there are two sides of the case.

Demonstrative examples are also important. These can include exhibits (slides, charts and bulletin boards) illustrating your points or even videos showing the parties' goods. They are often the most effective way (especially for a plaintiff) to highlight a potential likelihood of confusion or a counterfeiting problem. The general procedure in using a demonstrative is to mark it as an exhibit, establish its relevancy through your witness, show the demonstrative to opposing counsel, and then formally offer it into evidence. Once a demonstrative is allowed into evidence, you may want to give copies to the jurors. Also consider placing a large diagram showing the demonstrative where the jurors can see it during your direct examination. For example, if you represent a defendant in a trade dress infringement case involving blue candy of a shade completely different from the plaintiff's, create a poster showing both parties' candies.

Another effective tool is a split screen showing each parties' marks. This is not unique to a jury case, but may be much more useful in one. For instance, *Tools USA and Equipment Co v Champ Frame Straightening Equipment Inc* (87 F3d 654 (4th Cir 1996)) would have been tailor-made for this type of demonstrative. This trade dress case involved two similar covers for tool catalogues, both displaying a stars and stripes theme. The screen could have shown both parties' marks, which would have allowed the witness to point to the marks and explain their similarities.

Although it is difficult to perform cross examination effectively, attempt to do so by using selective questions. Pick your shots: you need not cover every point in the case. You may also use exhibits, including those you have not used before.

Under Rule 51(a) of the Federal Rules of Civil Procedure, at or near the close of the evidentiary process, the parties may file and exchange jury instructions on the law. Many jurisdictions have specific 'pattern' instructions for use in trademark cases (eg, Chapter 15 (Trademarks) of the Ninth Circuit's *Manual of Model Civil Jury Instructions*). In setting forth your jury instructions, you may want to cite a manual and supportive case law. For example, in the *Akanoc Solutions Case*, Louis Vuitton cited the Ninth Circuit manual, and case law in the Ninth Circuit and other circuit and district courts. It included an elaborate 'table of contents' up front before the individual instructions.

In their closing arguments, the parties should use visual aids to help make their points. The plaintiff should stress again the strength of its mark, any evidence of actual confusion, the similarities of trade channels, evidence of the defendant's intent and damages suffered by the plaintiff. The defendant, of course, should respond to as many of these points as it can and should emphasize the burden of proof that the plaintiff carries. Both parties should attempt to arm the jurors with as much ammunition as possible to vote in their favour. [WTR](#)

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