



## CAUTIONARY TALES: LESSONS LITIGATORS LEARNED THE HARD WAY

Jennifer Fitzgerald  
Freeborn & Peters (Chicago, IL)  
312.360.6585 | [jfitzgerald@freeborn.com](mailto:jfitzgerald@freeborn.com)

### Cautionary Tales: Lessons Litigators Learned the Hard Way

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“Those who cannot remember the past are condemned to repeat it.” - George Santayana

As trial lawyers, we’ve all been there, and thought to ourselves, “I’ll never make that mistake again.” This is your opportunity to come and discuss your life lessons and to learn from others as well. We will discuss tricks of the trade ranging from approaching a difficult judge to training associates and interacting with clients.

In 1728 The Attorneys and Solicitors Act in England established that if a person wanted to become a solicitor in England, that person was obligated to spend five years as a “Clerk Under Articles” where they would train directly with established lawyers. Trainees were called “articled clerks” (even as late as 1990). Somewhere along the line, however, it was decided that more could be taught in a classroom than in practice and hence the rise of law schools. Now, with increasing dissatisfaction with law-school graduates and with burgeoning college and law school debt, England is ushering in a new dawn of the apprentice. So long as the potential apprentice has completed his or her high school equivalent, they can begin working in a firm – first as a paralegal and then have the option to progress to the solicitor path in about the same amount of time that a solicitor trainee would – without all the debt. England is providing a path to restore what we all know – we can learn more by doing than we can through classroom study.

Think about it. Whether or not we loved or hated, excelled

in or merely survived law school, when we graduated we were called Juris Doctors. That alone, however, did not fully prepare us for our careers as practicing lawyers either in-house or at a law firm. Law school did not teach the art of answering discovery or culling data from voluminous sets of ESI. Instead, we learned that on the job. Truly, whether entitled apprenticeship or not, our jobs actually are apprenticeships whether we are first year associates or are learning a new skill as we close in on the end of our career. That’s part of why we call it the “practice” of law. We can and must continue to learn new things whether it be new mandatory discovery procedures, new areas of law, or judges’ quirks.

In our quest to be lifelong learners, some lessons are learned the hard way and some we get to learn by watching our opposing counsel. There is no shortage of lessons that we can all benefit from. The following is just the tip of the iceberg:

#### Client Relationships

Communication is key to establishing a strong attorney-client relationship. Communication runs both ways. Outside counsel is often hired because of their expertise in a particular area. However, when looking for the most skilled attorney in a particular field, in-house counsel often assumes a high-quality lawyer is also a high-quality communicator. Not so. If communication matters to you, it is imperative to make that clear upfront, demand a free, timely flow of up-to-date information, and to formalize expectations about the frequency of communications. How often do we, as outside counsel, walk out of court and call our client with the great news of the victory on a motion? Do we provide that same service when we lose?

Sometimes, no. Instead, we tell ourselves that we will deliver the bad news when we are back in the office. The client deserves the news – good or bad – in the same format and with the same expectations as to timing.

Billing and budgeting is often an issue clients identify as frustrating their relationships with their outside attorneys. That probably comes as no surprise. While our Juris Doctorate may be hanging on the wall, only a small percentage of attorneys have any business or accounting acumen. When a client asks for a budget it is unlikely only for the in-house counsel's use. Generally it is for someone else within the client's company or organization. The attorney-client relationship will be strengthened as soon as outside counsel recognizes that their direct in-house contact often has their own internal "clients" with expectations about efficiency and cost control. If budgeting and billing is difficult, find someone who can assist you, take a class – there are a lot of on line courses available – or delegate the job to someone else. No matter how much one prefers to avoid budgeting and billing, it can't avoid it. It is imperative that outside counsel practice financial hygiene and that they do it well. Outside counsel also needs to timely deliver their bills to the client. A bill of any size, but particularly one that is over-budget, does not look any better a month or two after the charges were incurred.

Engagement letters should not be treated as something a managing partner or in house counsel requires. Instead, outside counsel and in-house counsel need to carefully review any standard engagement letter to ensure it properly reflects the scope of the actual engagement. First, it should clearly identify who the client is – also is outside counsel also representing the company's subsidiaries that are parties to the suit? Next, clearly define the scope of the services to be provided. This may help avoid any issues down the road for work that was not performed. Further, defining the scope is important for identifying potential conflicts of interest. Additionally, it is important to set expectations – on both sides of the relationship. Clients should expect to see and outside counsel should expect to include in the engagement letter a requirement that the client will be truthful, helpful and available to assist in the litigation of the matter. Similarly, the client should be able to set requirements for counsel. Of course, events of termination should also be outlined in the engagement letter. This may include the right of the lawyer to withdraw for any reason including the unusual instance where a client fails to pay, or any other reason that could be envisioned at the outset of the attorney-client relationship. It is also useful to address when the engagement ends. Finally, it is important to cover unique aspects of the engagement. If, for example, your new matter is a contingency case, you must consider what

happens if: (1) the client and outside counsel do not agree on settlement and/or (2) what happens if the client wants to change counsel. Similarly, if outside counsel is replacing a previous counsel, the engagement letter should address the rights and position of the previous counsel vis a via your engagement.

### **Court**

If a judge has a specific quirk – observe it. For example, in California state court, there is a judge that refuses to allow any attorney to move from the podium once their case has been called. Quirky, yes, but the court is the judge's domain. Follow the rules.

Do not make faces, roll your eyes, nod your head or click a pen. From the judge's vantage point, these mannerisms are not only noticeable, but distracting. One judge was quoted as saying: "Many counsel would do well to receive Botox injections to their face. I say that because an overly expressive face is a distracting liability to one's courtroom conduct." He then footnoted this statement with: "For long trials, I am prepared to personally fund these treatments." (A Judge's View). Not surprisingly, this same judge believes that nodding of the head belongs on "the dashboard of one of those motor vehicles with oversized tires and a loud muffler."

Never ask a judge if he or she has read the materials. Assume the judge has not read anything and proceed. Asking only invites embarrassment of the judge. If the judge is familiar with the matter, or wants to speed things along, the judge will so advise.

Use only one descriptor for the parties in briefs and use the same one consistently – particularly in reply briefs or other related pleadings. If the court has to translate who the parties are, it builds irritation and can lead to mistakes.

Do not lie, or misstate facts or law. Judges see thousands of attorneys each year. They are likely not to remember a particular attorney, the specific facts of a prior case, or in whose favor he previously ruled. However, if counsel has seriously misstated the facts or law – and the judge relies upon this misstatement - the judge will be embarrassed and will remember that attorney forever. That attorney will have lost the court's confidence. Conversely, should an attorney candidly concede an issue, the judge is likely to consider that attorney more trustworthy.

Read the rules. The number of cases that make reference to attorney's not reading the court's rules is staggering. The court writes rules, it publishes the rules, it references its rules in the first order in the case and yet attorneys

do not read the rules. Why are judges frustrated with attorneys? This is pretty obvious.

Listen to local counsel. Different judges do things differently. The purpose in hiring local counsel is to become advised of these differences. If local counsel provides advice, the attorney is well advised to listen – if you are not going to listen to the local counsel you engaged, you clearly do not trust your local counsel and it may be time to select a different one.

### **Opposing counsel**

Make sure there are teeth to any protective order. Many of the court-suggested protective orders do not include penalties for intentional breaches (or undisclosed breaches). That said, most courts will permit suggested protective orders to be modified. In the Northern District of Illinois there is precedent for awarding damages for an intentional breach of a protective order. Those damages can be set at the amount of attorneys' fees incurred in filing the motion for breach of the protective order. When dealing with highly sensitive information this is not very reassuring to a client, but it helps them deal with the pain.

When negotiating a settlement agreement, do not lose your perspective as a trial attorney. Do not assume the other side is making the same assumptions you are. For example, often a matter is settled and a term sheet is prepared. One of the terms often used is that "the parties will sign a standard release." It's not surprising that very few people agree what the terms are to a standard release. Negotiate them up front.

During settlement discussions, many attorneys rely on FRE 408 to bar the admission of statements made during settlement talks "when offered to prove liability for, invalidity of or amount of a claim that was disputed as to validity or amount, or to impeach through a prior inconsistent statement or contradiction." However, the rule does not necessarily stop a party from having to disclose relevant data discovered during settlement negotiations, particularly with other parties in other cases. Therefore, consider entering into a confidentiality agreement or nondisclosure agreement before entering into settlement discussions.

### **Within The Firm or Office**

Ask questions, keep your door open, and be a mentor.

Know and remember people's names.

Keep an eye on new attorneys. Malpractice claims arising from work performed by new attorneys are increasingly due to inadequate training and conflicts of interest.

Learn how to change the toner in the copier and printer – and remain current on this technology. Just because an attorney could change the toner in last year's model does not mean the same technology applies to the newest model. Similarly, know how to load paper into the printer, fax, copier and scanner.

Learn how to file papers with your local courts on your own – both electronically and by making a journey to the clerk's office. You'll find this an invaluable skill when you have that last-minute filing due on the Friday after Thanksgiving.

### **Areas of Law**

There are of course an unlimited number of areas where there are tips and tricks of the trade. One of the goals of this panel discussion is to discuss your experiences. What led to appeals, what was that "a-ha" or "duh" moment. To start the conversation on this point, here are a few tricks I've uncovered:

- If you have a trade secret case and you want to disclose the trade secret in your opening argument, seal the courtroom. In theory, once the trade secret is revealed it is lost.
- Watch for claim splitting *res judicata* arguments. Sure, when you go in for that TRO you are trying to get immediate relief. However, you are potentially setting yourself up for a claim splitting argument from your opponent. You may only get one bite at the apple. A TRO need not cover all of your claims, but all your claims should be in your complaint when you file.
- In a patent case, if you grant a license to a minor user, you may lose your opportunity to gain lost profits from other infringers because you no longer have exclusivity. Potentially void this by granting a limited license to the minor user in a specific field of use. Remember too that established royalty rates can be used by other infringers to establish the "going rate." Therefore, be sure to include a nonmonetary component in your settlement agreement.



## **JENNIFER L. FITZGERALD**

**Partner**

**FREEBORN & PETERS (Chicago, IL)**

**312.360.6585 | [jfitzgerald@freeborn.com](mailto:jfitzgerald@freeborn.com)**

Jennifer Fitzgerald is a Partner in the Litigation Practice Group and has extensive business litigation experience in matters involving intellectual property, securities, antitrust and general commercial litigation throughout the United States. Her legal experience includes trial and appellate work on behalf of both plaintiffs and defendants in a wide range of complex litigation matters.

As a registered patent attorney, Jennifer has the ability to discuss inventions at their most scientific level but she also is skilled in the art of explaining technical issues to lay persons. She has advised clients and litigated patents throughout the U.S. on topics as varied as golf clubs, windshield wipers, diet modification software, visual skills enhancement, package design, medical products, acoustic echo cancellation technology, RFID technology and wireless communications.

Jennifer has represented multiple clients before the International Trade Commission, both as respondent and complainant. With first chair trial experience in the infamous Wiper Wars, Jennifer appeared in no less than 7 Section 337 cases, several of which were tried to determination.

She assists clients with prosecution and protection of trademarks and copyrights worldwide. She has organized raids against counterfeiters in China, actively assisted a client in the "reclamation" of trademarks in Europe and recovered U.S. domain names from cybersquatters. She maintains contacts with a worldwide set of foreign counsel to serve the international needs of her clients.

### **Practice Areas**

- Litigation
- Intellectual Property
- Patent Litigation and Counseling
- Trademark Protection, Enforcement and Counseling
- Intellectual Property Litigation
- Trade Secret Protection and Enforcement
- Copyright Protection and Enforcement
- Restrictive Covenants and Trade Secrets
- IP Licensing and Transaction Counseling
- Antitrust
- Purchasing and Supply Chain Management

### **Honors and Awards**

- Illinois Leading Lawyers - 2019 (cited in multiple years)

### **Education**

- J.D., Loyola University Chicago School of Law - Case reporter for the Consumer Law Reporter and participated in the London Advocacy Program in 1994-1995
- B.S., University of Southern California