IP Osgoode Speaker Series: Justice Roger Hughes – Advocacy Skills and IP: Observations from the Bench

December 4, 2012 by Philip Poles

On the afternoon of November 29th 2012 IP Osgoode was pleased to host Justice Roger T. Hughes of the Federal Court of Canada as he shared his experiences with us in a lecture entitled "Advocacy Skills and IP: Observations from the Bench".

Professor Giuseppina D'Agostino, founder and Director of IP Osgoode provided the introduction. She highlighted Justice Hughes' notable influence on intellectual property law and policy both before and after his appointment to the bench. To conclude her introduction, Professor D'Agostino read an excerpt from the chapter that Justice Hughes contributed to Common Law of Intellectual Property: Essays in Honour of Professor David Vaver: "Asking how litigation begins is rather like asking how persons fall in love. The answer is that there are all sorts of ways, good, bad and indifferent".

On that note, Justice Hughes proceeded to paint a colourful portrait of the process a judge goes through in arriving at a judgment from soup to nuts: everything from organizing a case pre-trial to sitting down in a quiet office to think and finally write the reasons for judgment.

The process begins in pre-trial, months before a case is to be heard. At this stage a judge is responsible for organizing the case, identifying and reducing the number of contentious issues, and forging agreements on the facts wherever possible.

The organizational responsibilities of the judge continue with the trial. Evidence, exhibits, issues, and witnesses all need organization. Especially important is dealing with expert witnesses. Justice Hughes is a pioneer in this area, using a practice that is known as "hot tubbing", which involves sitting opposing experts in the witness box together to encourage them to arrive on agreed opinions. The judge must also hear the lawyers' oral arguments and read their associated facta. Justice Hughes advised that an effective written submission should be no more than thirty pages.

Once a trial has concluded, the judge's real work begins: reducing the case to reasons for judgment and working to distill those reasons into a written document. Essential to this is process is, as Justice Hughes puts it, considering the "ask": the remedies that are being sought by the parties. To get to the "ask", one must first try to get all of the facts right by considering the evidence according to the appropriate burden where there is a dispute. Most importantly the legal issues in the case must be carefully sorted out, and the applicable law must be clarified. Finally, the law is applied and the remedies considered. Justice Hughes declared that he prefers creative remedies that do the "least harm" while achieving an appropriate result.

Justice Hughes then led us through a typical case for each of patent, trade-mark, and copyright. While going over the most common issues in each type of case, he placed special emphasis on the various legal standard personas that a judge must put himself in the position of to arrive at a conclusion. When assessing a patent, the perspective is that of a person "skilled in the art"; for trade-marks, it is the "average consumer somewhat in a hurry"; for copyright, it is the somewhat more nebulous "beholder" of a work.

Having gone through the process of hearing a case, a judge then sits down in a quiet office to think about the case. Justice Hughes intimated that a decision is written with the conclusion in mind and intended for several audiences: consumers, the parties, their lawyers, the public, and the appeals courts.

As promised, some tips for both new and experienced advocates were then offered based on Justice Hughes' thirty-seven years of experience as a lawyer and seven years on the bench. At the top of the list was to "keep it as simple as possible, but no more simple than possible". Justice Hughes advised

that presenting your three best issues while being polite, pleasant, and “folksy” rather than mechanical, is more persuasive and likely to convince the judge to grant your “ask”. He also explained that knowing your case and organizing it logically is essential, as is “not sweating the small stuff”, which allows for an agreement in principle on as much as possible and helps narrow a case to its essential issue. Justice Hughes, tongue-in-cheek yet practical, also reminded us of “Rule 13”: “don’t piss off the judge”. Last but not least, he wisely advised us to be truthful to the client and respectful to both the opponent and the judge.

The lecture was followed by a lively question and answer period in which questions ranged from queries about the above-mentioned “hot tubbing” of experts to the challenges faced by teachers and students in fine arts programs when it comes to protecting their intellectual property rights. Finally, Justice Hughes offered some advice to law students and recent graduates looking for work in a crowded market: be enthusiastic to set yourself apart.

Philip Poles is a graduate of Osgoode Hall Law School.