



Summer 2012 Newsletter

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CHEMERINSKY DOES IT AGAIN: SUPREME COURT ROUND-UP OF CRIMINAL CASES

By: JOHANNA S. SCHIAVONI, JACOBS & SCHLESINGER LLP

Before a packed courtroom full of local District and Magistrate Judges, law clerks and attorneys, Erwin Chemerinsky, Dean of the U.C. Irvine School of Law, delivered a captivating analysis of the most recent U.S. Supreme Court term.

Chief Judge Barry Moskowitz introduced Chemerinsky at the FBA's August 8 event. The two met in 1987 at USC Law School. Although Chief Judge Moskowitz did not have Chemerinsky as a professor, he said his lectures were known as the kind you would pay to see. Thankfully for the FBA and audience, Chemerinsky generously donated his time and shared his insights with us again this year.

In a blockbuster term, the Supreme Court addressed many controversial cases implicating federalism, preemption, separation of powers, and including immigration and health care reform legislation. Next term, the court is set to address race-conscious admission decisions in public universities, whether corporations can be sued under the Alien Tort Claims Act, and potentially, the issue of marriage equality. For Chemerinsky, "it is hard to think of a term when the Supreme Court would decide more cases regarding personal or intimate issues."

But back to the just-ended October 2011 term.

The "dramatic" impact of the court's reduced docket. The Supreme Court decided only 65 cases this term—the fewest cases in more than 50 years. For most of the 20th century, the Supreme Court decided more than 200 cases per term.

The shrinking docket has "enormously important" implications, Chemerinsky said. Upwards of 9000 petitions for *certiorari* are filed in the Supreme Court each year. As fewer cases are

decided, fewer circuit splits are addressed and important questions of federal law go unanswered. To the chagrin of practitioners and law students everywhere, however, as the number of cases decided has decreased, the length of the court's opinions has increased, with multiple opinions this term topping 100 pages.

As Justice Byron White famously said, "every time there is a new justice it becomes a new Court." Because of the importance of Justice Kennedy's swing vote in so many cases in recent terms, Chemerinsky previously referred to it as "the Anthony Kennedy court." That changed this term. According to Chemerinsky, after seven years as Chief Justice, this has now become the "John Roberts" court, as he cast the deciding vote in several important cases and authored 11 majority opinions (only Kennedy authored more, with 12) of the 65 cases decided this term.



Dean Chemerinsky

In terms of who was in agreement the most and the least among the justices, Justices Scalia and Thomas agreed on 93.4% of their votes—the highest of the term. On the flip side, Justice Ginsburg disagreed with Scalia and Thomas

50% of the time.

The criminal cases of the term were some of the most important from a practical standpoint and several have the potential to greatly impact the administration of justice.

Fourth Amendment. Beginning his discussion, Chemerinsky observed a "predictive principle" he loosely follows in Fourth Amendment cases: if the justices can imagine it would happen to them, then a search or seizure is unconstitutional, but if the justices cannot imagine it would happen to them, then a search or seizure is constitutional. This term's cases fit the bill.

In *United States v. Jones*, 132 S. Ct. 945 (2012), the Supreme Court held that law enforcement's use of a GPS tracking device on a person's car is a search under the Fourth Amendment. Absent a warrant, the tracking information gathered during a 28-day period when a GPS device was attached to the defendant's car had to be suppressed and his drug trafficking conviction reversed.

At oral argument, the justices expressed their concern with warrantless tracking made possible by such technology. Justice

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INTRODUCTION TO CIVIL LITIGATION IN FEDERAL COURT

MARTHA ANN KNUTSON, HEALTH LAWYER, RANCHO BERNARDO

On July 11 the Chapter welcomed both new and experienced practitioners to an afternoon seminar focused on civil practice in the federal courts and, in particular, the Southern District of California.

FEDERAL JURISDICTION AND VENUE

James T. Wagstaffe of Kerr & Wagstaffe LLP led off with a fast paced and lively review of the fundamentals of federal jurisdiction and venue as well as recent “game changers” in both.

Mr. Wagstaffe described lack of jurisdiction as a potential “delete button” that can be raised by the court *sua sponte* at any point in the proceedings. Federal courts are, he stressed, courts of limited subject matter jurisdiction and attorneys must be prepared to address which of four “doorways” each part of their case is entitled to enter though in order to be heard there: (1) federal law / federal question, (2) complete diversity of the parties plus more than \$75,000 at issue, (3) removal, or (4) supplemental jurisdiction based on the “same transaction or occurrence” as another claim.

While the associated rules for some of these bases for jurisdiction have long been established, the removal statute (28 USC 1446) was recently amended to change certain time limits and the removing party’s burden of proof in diversity cases. Similarly, new rules recently went in into effect on which federal court is the appropriate venue for a particular case. Both sets of changes underline one of the principal themes of Mr. Wagstaffe’s presentation – that counsel have a duty to read the rules, keep learning and be on the lookout for changes even in areas as fundamental as jurisdiction and venue.

THE ROLE OF THE MAGISTRATE JUDGE

Three of the Court’s Magistrate Judges participated in a panel presentation highlighting their roles and responsibilities at the Court.

Early Neutral Evaluation (ENE) – The Honorable Nita L. Stormes described the ENE process as an early settlement conference presided over by a judicial officer – not mediation. The conference is scheduled within 45 days of the filing of the Defendant’s Answer. All attorneys and clients or client representatives with “full settlement authority” are required to appear. Before the ENE proceeding both parties prepare and file short statements of their cases. Judge Stormes keeps those filed in her cases confidential; other Magistrate Judges may require the parties to exchange these statements. Judge Stormes rarely conducts her ENEs by telephone, except in class action cases. She also will usually not assign a value to a case or express a critical evaluation during the ENE, because clients tend to fix on such opinions and she really has only limited information about the case at this point. The specific ENE procedures followed by each Judge are outlined in their “Chambers Rules” which are available on the Court’s website

at <http://www.casd.uscourts.gov>.

Judge Stormes also shared her thoughts on the value of the ENE process, even when the parties feel that there is “no possibility of settlement”. First, the conference is a chance for counsel to “shine” in front of their clients as they present the case – as well as for the client to hear the opposing view. The outcome can sometimes be surprising. At a minimum, the parties and counsel meet and become more “human” to one another. Second, if settlement is truly off the table the ENE presents an opportunity to discuss the issues, establish areas for collaboration and possibly narrow discovery needs.

Rule 26 Events - Although a high proportion of cases settle within a short period of time after the ENE, a schedule is established at the end of the ENE for various events arising under F.R.Civ.P. 26. The Honorable David H. Bartick described the next four events in each civil case: (1) a deadline for counsel to meet and confer about a joint discovery plan; (2) service of the parties’ “initial disclosures”; (3) lodgment of the discovery plan prepared by counsel; and (4) a case management conference. Judge Bartick advised that counsel should meet in person for the “meet and confer,” and that they should consider using Form 15A in *Federal Civil Procedure Before Trial* (of which Mr. Wagstaffe is a co-author) as a model for their discovery plans.

At the case management conference a scheduling order will be issued with dates for certain events up to the case’s pretrial conference. Judge Bartick emphasized that these scheduling orders are very case and judge specific – counsel should not assume similarity from one case or one judge to another. Again, familiarity with the Court’s local rules and each Judge’s chambers rules is critical. Judge Bartick also emphasized the expectation the Magistrate Judges will have a hands on approach to managing the case and that counsel should take advantage of their judge’s expertise.

Lawyers Behaving Badly (aka Discovery Disputes) - The Honorable Mitchell D. Dembin then described why he “loves” discovery disputes, in particular having counsel make personal appearances before him in connection with them. Because the scope of discovery in federal civil matters is broad, according to Judge Dembin the vast majority of the “disputes” are “easy” to resolve and come down to either lawyers behaving badly, clients who have been told that something “won’t have to be turned over” or a failure on the part of both counsel to adequately develop the joint discovery plan.

Despite the need for zealous advocacy, Judge Dembin cautioned that “cooperation is what makes the system work”

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PATENT DAMAGES LAW: LIFE AFTER *LUCENT*, *RESQNET*, AND *UNILOC*

BY: JOANNA FULLER, ESQ.
FISH & RICHARDSON P.C.

On April 11, the Federal Bar Association hosted a panel discussion on the changing face of patent damages law. The panel was composed of a collection of intellectual property specialists: Hon. Marilyn L. Huff of the Southern District of California, who presided over *Lucent* in the district court and who has since volunteered to participate in the Patent Pilot Project; Hon. Cathy Ann Bencivengo, the Southern District of California’s newest judge who also presided over portions of *Lucent* when she was a magistrate judge and, before that, was a patent litigator in private practice; Roger A. Denning, patent litigator and Principal with Fish & Richardson P.C.; and John L. Hansen, patent damages expert and Vice President of TM Financial Forensics, LLC. As you might expect, this illustrious panel dug right into the nitty-gritty details of patent damages law, including plenty of case citations.

The Federal Circuit’s holdings in *Lucent*, *ResQNet*, and *Uniloc* formed the background of the discussion. The major, if not sole, component of damages in a patent infringement case is a “reasonable royalty,” which precedent defines as the amount the patent holder would have agreed to accept and accused infringer would have agreed to pay for the use of the patented technology in a “hypothetical negotiation” between them immediately before the infringing activity began. The courts have used a collection of 15 factors, which are derived from *Georgia-Pacific Corp. v. U.S. Plywood Co.*, 318 F. Supp. 1116 (S.D.N.Y. 1970), to determine the reasonable royalty that a hypothetical negotiation between the parties would yield. *Lucent*, *ResQNet*, and *Uniloc*, clarify how to apply various aspects of this “*Georgia-Pacific* analysis.”

The panel focused on two aspects of these cases: (1) the relevance of proffered patent licenses, and (2) the applicability of the “entire market value” rule in calculating damages. In *Lucent Technologies, Inc. v. Gateway, Inc.*, 580 F.3d 1301 (Fed. Cir. 2009), the Federal Circuit discussed both these issues in vacating a \$358 million jury verdict. There, the plaintiff’s expert relied on eight licenses in an effort to show the rates historically paid for other patents “comparable” to

the patent in suit (the second *Georgia-Pacific* factor). But, according to *Lucent*, there was insufficient evidence to show that any of the licenses was sufficiently comparable. *Lucent* criticized the “varied” licenses as “radically different” from the hypothetical license at issue and lacking sufficient proof that the subject matter of the patents was comparable. Simply put, *Lucent* adopted a more rigorous standard for establishing the threshold “comparability” of licenses.

The *Lucent* court also found fault with the plaintiff’s method of calculating damages. From the verdict, it appeared that the jury multiplied a royalty percentage times the total sales (*i.e.*, “entire market value”) of Microsoft’s Outlook product. The court explained that reliance on an entire market value is only appropriate where the invention forms the basis of the product’s consumer demand. In *Lucent*, however, the court described the patent (which related to picking an appointment date by way of a mini pop-up calendar) as “but a very small component” in Outlook, leading to the “unmistakable conclusion” that the invention was *not* the reason consumers purchased Outlook. Thus, according to the court, *Lucent* could not rely on the entire market value rule.

ResQNet and *Uniloc* built on these *Lucent* holdings. In *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860 (Fed. Cir. 2010), the Federal Circuit again vacated a damages award and elaborated on the requirement that relied-on licenses be “comparable” to the hypothetical license at issue. The court stated that two of the licenses relied on by the patentee “simply have no place in this case,” because the subject matter of the licenses bore no relationship to the claimed invention and there was no economic link to the hypothetical license at issue. And in *Uniloc USA, Inc. v. Microsoft*, 632 F.3d 1292 (Fed. Cir. 2011), in addition to further discussing license comparability, the Federal Circuit reined in the “entire market value” rule even further. *Uniloc* held that the entire market value rule cannot even be used as a “check” on a reasonable royalty calculation if the invention does not form the basis for consumer demand. With this backdrop in mind, the panel forged ahead.

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JUDGE BENCIVENGO DISCUSSES HER PROCEDURES AND PRACTICES

BY: GREGORY P. GOONAN, ESQ.
THE AFFINITY LAW GROUP APC

Judge Cathy Ann Bencivengo is the Southern District's newest District Judge, having been confirmed by the Senate on February 9, 2012. Judge Bencivengo comes to the District Court bench after serving seven years as a Magistrate Judge, during which time she amassed considerable experience in both civil and criminal cases. Judge Bencivengo kindly took a break from her busy schedule to host a brown bag lunch with members of the Federal Bar Association on March 27 to discuss her new role and some of the procedures she will employ in civil and criminal cases. Given the affection and admiration that her colleagues have for her, it was not surprising that the event was heavily attended and there was not an empty seat in the courtroom.

Prior to becoming a Magistrate Judge in 2005, Judge Bencivengo had a successful career at the DLA Piper firm. Judge Bencivengo started at the firm as an associate in 1988 (when it was still known as Gray Cary Ames & Frye), and became a partner in 1996. Judge Bencivengo specialized in intellectual property transactional and litigation matters, and was a highly experienced patent litigator before ascending to the bench. Among the more interesting matters Judge Bencivengo handled while at Gray Cary/DLA Piper was protection of the Dr. Seuss intellectual property portfolio, so Judge Bencivengo surely knows a thing or two about Green Eggs & Ham!

Judge Bencivengo's new home is Courtroom #2. Like all new district judges, Judge Bencivengo received a large number of civil cases right after her confirmation. More than 200 civil cases (about 18 cases from each district judge) were transferred to Judge Bencivengo, and as of the date of the lunch, she and her staff still were sorting through the cases to get a handle on the status of each case. Judge Bencivengo described the early days following her confirmation as a "very challenging situation" as she and her staff worked to get her chambers organized and address pending matters in her new cases, but in her usual positive way and with good humor she expressed optimism that everything would be squared away in short order.

As is the general practice in the Southern District, no criminal cases were transferred to Judge Bencivengo following her confirmation, so Judge Bencivengo had a welcome opportunity to focus on civil matters and civil trials in her first days on the district court bench. But Judge Bencivengo expected that her criminal caseload would quickly ramp up as new criminal matters were filed. Judge Bencivengo has posted her civil chambers rules and criminal chambers rules on the court's website, which of course are required reading for all attorneys practicing in her court.

Judge Bencivengo expected that she would be bringing on some externs in January 2013. She expected her current law clerks to be with her for a while, and did not anticipate that there would be any law clerk openings for at least three years.

GENERAL PROCEDURES

Judge Bencivengo will use Mondays through Thursdays as trial days. Motion hearings will be on Fridays, with criminal matters heard in the morning and civil matters heard in the afternoon. More complicated

and time-consuming matters, like summary judgment motions, class action certification motions, and patent claim construction hearings will be specially set to allow sufficient time for argument and the court's questions.

Judge Bencivengo explained that it is generally acceptable for counsel to call her court staff to address scheduling matters and routine issues, but she prefers that counsel with knowledge about the case call rather than assistants, paralegals, etc. so as to make the calls as productive as possible. Judge Bencivengo urged counsel to call her chambers if any matter "fell through the cracks" during the case transfer process and she will set a status conference. Judge Bencivengo emphasized that her staff will not provide legal advice in any way.

Judge Bencivengo allows telephone appearances if arranged in advance. Counsel were instructed to use the Court Call service. Judge Bencivengo requires that courtesy chambers copies of all filings in excess of 20 pages (individually or cumulatively) be delivered within two (2) business days of filing. Judge Bencivengo prefers the use of numbers only to identify exhibits, in both civil and criminal matters.

CIVIL MATTERS

Judge Bencivengo is setting hearings for motions in civil cases as soon as possible, and as of the date of the brown bag, motions were being set for hearings in July. A party wishing to set a motion for hearing should call the calendar clerk for a hearing date. Motion papers must be filed within three (3) court days of scheduling the hearing or the hearing date will be forfeited. Judge Bencivengo specifically asked that counsel indicate in their papers whether the previous district judge had made any rulings relevant to a particular motion, and explained that she intended to pay substantial deference to the prior rulings in a case.

Judge Bencivengo holds oral argument on civil motions when the court deems argument is warranted or appropriate. If a party desires oral argument, counsel are instructed to place the legend "Oral Argument Requested Subject To Court Approval" on the moving or opposition papers underneath the hearing date. In all other cases, counsel should place the legend "No Oral Argument Unless Requested By The Court" underneath the hearing date. Judge Bencivengo expected that counsel would learn no later than two (2) court days prior to the scheduled hearing whether oral argument would be held, and in many cases the court will notify counsel if there will be oral argument shortly after the opposition is filed. The one exception to this rule is motions to dismiss. In almost all cases, the court will decide motions to dismiss based on the papers alone, without oral argument, because leave to amend usually is granted. Judge Bencivengo may consider oral argument in certain cases where a case may be dismissed without leave to amend.

Judge Bencivengo urged counsel to proofread their papers very carefully before filing. She does not like string cites, and wants counsel to cite to controlling Ninth Circuit precedent where available. Westlaw citations should be given for cases not published in an official reporter, and courtesy copies of cases not available in Westlaw or Lexis

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BROWN BAG LUNCHEON WITH MAGISTRATE JUDGES BARTICK AND CRAWFORD

BY SARAH R. BOOT, ASSISTANT UNITED STATES ATTORNEY, CRIMINAL DIVISION, AND PRESIDENT OF LAWYERS CLUB OF SAN DIEGO

On June 7, 2012, the Southern District's newest Magistrate Judges, Hon. Karen Crawford and Hon. David Bartick, met with members of the Federal Bar Association to discuss their chambers rules and procedures over a brown bag lunch at the federal courthouse. Both were sworn in during the spring of 2012 and will serve eight-year terms.

BACKGROUND

Both judges welcomed the packed courtroom, introduced themselves and their staff, and began by discussing their backgrounds. Both judges have extensive previous experience in federal court, although Judge Crawford described their nearly simultaneous appointments as akin to "yin and yang" because she has extensive experience on the civil side while Judge Bartick has extensive experience on the criminal side.

Judge Crawford began her career working as a trial attorney with the U.S. Department of Justice and as an Assistant U.S. Attorney in the Civil Division here in the Southern District. Judge Crawford then spent over 20 years in private practice in the area of complex commercial litigation, handling a wide range of disputes involving contracts, intellectual property, and products liability. Judge Crawford was an active member of Lawyers Club, acting as co-chair of the Fund for Justice, which awards grants to community organizations that further Lawyers Club's mission of advancing the status of women in law and in society. She has also served on the National Board of Trustees for the American Inns of Court.

Judge Bartick practiced criminal defense in both state and federal court for over 26 years. He has handled multiple, complex and high profile criminal cases, including the largest money laundering case in the United States, the largest maritime drug seizure in the United States, and the largest bank robbery case in the Southern District. He has also litigated high profile death penalty cases. Judge Bartick served as a part time judge with the San Diego County Superior Court for more than 15 years, and has served as an elected member of the Carmel Valley Community Planning Board.

CHAMBERS RULES

Judge Crawford recently attended Phase I magistrate judge training with other newly appointed magistrate judges from across the nation. There, she was interested to learn how greatly the role of magistrate judge varies in different districts. For example, magistrate judges in some districts do not conduct settlement conferences or trials and handle only habeas corpus petitions and social security disputes. According to Judge Crawford, the procedures here and in every district are fine-tuned to meet the needs of its district judges and legal community. Judge Crawford stated, "each magistrate judge has its own set of chamber rules based on that particular magistrate judge's perception of how to best assist district court judges." Given that, Judge Crawford advised attorneys to read the chambers rules because "there are nuances."

EARLY NEUTRAL EVALUATIONS

Both Judge Crawford and Judge Bartick believe the principle role of a magistrate judge in the Southern District is to settle cases. They

emphasized the importance of Early Neutral Evaluation ("ENE") settlement discussions and the value a magistrate judge can bring to them. Judge Crawford is sensitive to cost issues in preparing for trial and stated, "If parties can settle early on, they will incur far lower fees and costs in the long run." Judge Bartick pointed out that other districts do not offer the same level of face time with magistrate judges, which can help attorneys to work with their clients to resolve a case. For example, Bartick stated, "Sometimes clients just want their day in court and if they get to talk to a judge, they may feel that someone is listening to them; sometimes that is all they want." Crawford added that an ENE is more than just a settlement conference, "It can help your client to see the strengths and weaknesses of various aspects of the case."

Judge Bartick has found ENE briefs to be extremely helpful, stating "It focuses me and counsel on settlement, and I really feel it's productive for the court." Judge Bartick described his process for ENEs. He starts with both parties in chambers, explains the confidential nature of the proceedings, and emphasizes that he is not the ultimate trier of fact. He then breaks the parties into caucuses so they may begin to address issues in contention. He views his role as a mediator and not an arbitrator.

Both Judge Bartick and Judge Crawford take ENEs seriously, and ask that counsel take them seriously as well and be as prepared as possible. Given the main goal of an ENE, to identify big issues and potentially resolve the case, Judge Crawford instructed that the *parties* must actually be present, meaning, people with "true negotiating authority." At a minimum, as Judge Bartick put it, "there must be someone present who can settle the case in principle."

Both Judges understand that it may not always be possible to settle cases at such an early phase of the litigation. Though, Judge Bartick noted that he has been able to settle a number of cases early on. Judge Crawford mentioned that if the parties believe preliminary discovery would be helpful and an ENE two months down the line would be more beneficial, "We're receptive to that." She advised attorneys taking this position to schedule a status conference to discuss.

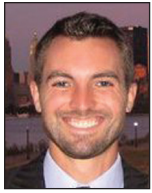
ELECTRONICALLY STORED INFORMATION

Both Judge Crawford and Judge Bartick ask that parties meet and confer regarding Electronically Stored Information ("ESI") at an early stage. Judge Crawford believes ESI issues "need to be addressed immediately, certainly before initial disclosures." Both judges request that the parties address ESI in a joint discovery plan and that they figure out what is most cost-effective. According to Judge Crawford, "Meet and confer does not mean sending a 'nastigram' to opposing counsel. It means picking up the phone, identifying issues, and discussing how to resolve them." She cautions counsel that "Tit for tat tactics won't get you to the finish line." Magistrate Judges are only to get involved after the parties have put forth a "face to face" or "conscientious" effort.

OTHER PREFERENCES

During the brief discussion, the judges touched on a few other issues. Judge Crawford mentioned the importance of protective orders,

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THE SAN DIEGO CHAPTER OF THE FEDERAL BAR ASSOCIATION HOSTS A CLE ON THE IMPONDERABLES AND INTANGIBLES: WHAT THE BOOKS DON'T TELL YOU ABOUT THE PRACTICE OF IMMIGRATION LAW

BY: BRIAN JOHNSON, ESQ., GUERRA AND JOHNSON, P.C.

“With only a small degree of hyperbole, immigration laws have been termed second only to the Internal Revenue Code in complexity. A lawyer is often the only person who could thread the labyrinth.” *Castro-O’Ryan v. INS*, 821 F.2d 1415, 1419 (9th Cir. 1987)

On May 9, 2012, the San Diego Chapter of the Federal Bar Association invited the Honorable Rico J. Bartolomei, U.S. Immigration Judge, Martin D. Soblick, Chief Counsel, U.S. Immigration and Customs Enforcement (ICE), and Cheri Attix, Law Offices of Cheri Attix to discuss topics and issues in the practice of immigration law that cannot be found in the books. The panel offered differing perspectives and was perfectly balanced as Judge Bartolomei was positioned in the middle seat between the government and private counsel. Various topics were covered, including the cancellation of removal cap, prosecutorial discretion, and the conflict between the Immigration Court Practice Manual and individual Immigration Judge’s rules.

IMMIGRATION COURT PRACTICE MANUAL

The Immigration Court Practice Manual, published in February 2008, is a comprehensive guide that sets forth uniform procedures for practice before the Immigration Courts. Prior to its publication, each Immigration Court had its own rules, which resulted in a need for greater uniformity in Immigration Court procedures and a call for the Immigration Courts to implement their “best practices” nationwide. However, some Immigration Judges have retained their own unwritten rules and, unfortunately, this may lead to inconsistent rulings and a lack of written guidance for practitioners and aliens appearing before them. If an Immigration Judge fails to comply with the guidelines set forth in the Practice Manual, their non-compliance may be raised on appeal. However, there currently appears to be no other way to enforce compliance with an Immigration Judge that strays from guidelines in the Practice Manual.

CANCELLATION OF REMOVAL CAP

Cancellation of Removal is a form of immigration relief available to individuals that have been placed in removal proceedings. To be considered eligible for this relief, a non-permanent resident alien must demonstrate continuous residence in the United States for at least 10 years, good moral character throughout that time, and that the alien’s removal would cause “exceptional and extremely unusual” hardship to the alien’s spouse, parent, or child who is a United States citizen or legal permanent resident. Each fiscal year, there is an annual cap of 4,000 grants for Cancellation of Removal that may be issued. Once this annual cap has been reached, an Immigration Judge is precluded from issuing a decision until the next fiscal year. “When grants are no longer available in a fiscal year, further decisions to grant or deny such relief shall be reserved until such time as a grant becomes available under the annual limitation in a subsequent fiscal year.” 8

CFR §240.21(c)(1) Once an Immigration Judge informs an alien that the cap has been reached, the alien has the option of being placed in “the queue,” which may or may not benefit the alien depending on their needs. Because hardship factors tend to build over time, another option is to request that your individual hearing be continued until the beginning of the next fiscal year.

PROSECUTORIAL DISCRETION AND ADMINISTRATIVE CLOSURE

ICE Officers can exercise prosecutorial discretion in individual cases by declining to put people in removal proceedings, terminating proceedings, or delaying removals in cases where people have long standing ties to the community, U.S. citizen family members, or other characteristics that merit a favorable exercise of discretion. San Diego acted as a “pilot city” to test whether prosecutorial discretion would help ICE focus its limited resources on high priority cases. Panelist Judge Bartolomei was instrumental in implementing this pilot program which turned out to be very successful.

Because prosecutorial discretion is a relatively new form of relief, there is little guidance on how it should be requested or how the determination to grant it is made. Therefore, ICE Chief Counsel Martin Soblick provided some guidance on ICE’s internal operating procedures. Mr. Soblick explained that ICE will consider prosecutorial discretion whether it is requested or not, but that the best practice is to submit a written request. Mr. Soblick suggested that the alien prepare a comprehensive package that presents all relevant evidence, rather than submit each document in a piecemeal fashion in order to provide ICE with all of the information and evidence it needs to make an informed decision. Once prosecutorial discretion is requested, ICE will check to determine whether the alien is a threat to the public safety or national security. If ICE denies the request, the alien may make a subsequent request with additional evidence.

Administrative closure is a procedural tool used to temporarily remove a case from the Immigration Judge’s calendar or the Board of Immigration Appeals docket. Administrative closure does not finally resolve a case. Rather, when a case is administratively closed, it is removed from the docket but remains pending. Administrative closure is thus not the same as termination of removal proceedings. The alien remains under the jurisdiction of the Immigration Judge and removal proceedings can be reopened at any time.

If ICE exercises its prosecutorial discretion to offer an alien administrative closure, the alien must decide on whether to accept it. There are advantages and disadvantages to having a case administratively closed. When administrative closure is accepted, removal proceedings are suspended, but the alien is unable to travel outside the United States or obtain authorization to work. These disadvantages may outweigh the advantages, particularly where the alien has other forms of relief available.

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PAST FBA NATIONAL PRESIDENT LAWRENCE BACA RECEIVES ABA THURGOOD MARSHALL AWARD FOR HIS WORK CHAMPIONING AMERICAN INDIAN RIGHTS

BY RACHEL RESNECK

UNIVERSITY OF SAN DIEGO SCHOOL OF LAW J.D. CANDIDATE 2013

Lawrence Baca is a retired attorney who spent 32 years in the Civil Rights Division of the Department of Justice. A Pawnee Indian and a San Diego native, Baca spent his distinguished legal career championing the civil rights of American Indians. On August 4, 2012, the American Bar Association presented Baca with the Thurgood Marshall Award. This prestigious award recognizes a legal professional who has contributed to the advancement of civil rights, civil liberties, and human rights in the United States. Since the award's creation by the ABA's Section of Individual Rights and Responsibilities in 1992, many celebrated attorneys and judges have received the award, including its twenty-first recipient, Lawrence Baca.

Growing up as an American Indian in southern California, Baca immersed himself in his culture and frequently attended pow-wows with local tribes. Despite the large number of American Indian tribes in California, Baca noticed the lack of attention paid to American Indian history and culture during his primary and high school education. From an early age, Baca was passionate about American Indians rights, and he devoted his adult life to advancing that cause.

In 1973, Baca received his Bachelor of Arts in American Indian History and Culture from the University of California, Santa Barbara (UCSB). He was the first person in his family to earn a college degree. While at UCSB, Baca became a member and later the co-chair of the Native American Awareness Group. As part of this group, Baca and a friend, Liz Schoofs, started a class for American Indian inmates at the Lompoc Federal Correctional Institution. The class sought to help American Indian inmates better express themselves to the parole board in order to successfully achieve parole. Baca taught them basic public speaking skills and demonstrated how to address an audience with confidence. When Baca started teaching at Lompoc, the parole rate for American Indian inmates was the lowest in the prison. By the time he finished, the parole rate rose to the highest in the prison. During the three years that Baca taught at Lompoc, none of the paroled American Indian inmates returned. Baca attributed this success to his ability to relate to the inmates as fellow American Indians. While other

college students spent their time on the beach, Baca was "giving men the opportunity to succeed later." The Lompoc program was a catalyst to Baca's notable career in the fight for American Indian rights. His alma mater noticed his accomplishments as well, and in 1988, the UCSB Alumni Association presented Baca with the Distinguished Alumni Award.

Immediately after graduating from UCSB, Baca enrolled at Harvard Law School. After his second year of law school, he returned to California to work for the Indian Legal Services in Escondido. As an intern, Baca provided support for the tribes that he grew up with in San Diego. After receiving his J.D. in 1976, Baca started working for the Department of Justice in the Civil Rights Division.

Baca brought significant change to the Department when he began his legal career with the Office of Indian Rights in 1976. He was the first American Indian hired through the Attorney General's Honor Law Program, the first American Indian attorney in the history of the Civil Rights Division, and only the second American Indian ever hired by the Department of Justice. Between 1954 and 1973, the Civil Rights Division filed many cases on behalf of African American victims and only two on behalf of American Indian victims. The Office of Indian Rights changed these statistics dramatically, and sought to remedy the civil rights injustices that American Indians faced.

When the Office of Indian Rights was disbanded in 1980, the number of cases brought on behalf of American Indians fell, and Baca took it upon himself to continue to fight for American Indian civil rights. From 1980 to 1990, Baca brought approximately 75% of the cases in the Civil Rights Division on behalf of American Indians. Although Baca's vigorous advocacy on behalf of American Indians was not always popular, he never became discouraged and continued filing and investigating cases for the next 22 years.

Baca was involved in all five of the enforcement actions ever filed by the Education Section of the Civil Rights Division on behalf of American Indians. Most significantly, in *Myers & United States v. San Juan County School District*, 905 F. Supp.

Continued on Page 15

Kennedy asked counsel for the government: “Well, under that rationale, could you put a beeper surreptitiously on the man’s overcoat or sport coat?” Chief Justice Roberts followed up, asking: “You think there would also not be a search if you put a GPS device on all of our cars, monitored our movements for a month? You think you’re entitled to do that under your theory?” This did not bode well for the government’s argument.

In the majority opinion, authored by Justice Scalia, the court held that the GPS tracking constituted a search. The decision also alters the court’s previous expectation of privacy case law and is likely to broadly impact other techniques of electronic data collection by law enforcement.

By contrast, in *Florence v. Board of Chosen Freeholders of County of Burlington*, 132 S.Ct. 1510 (2012), the Court upheld a jail’s policy of conducting suspicionless strip searches of every arrestee, regardless of whether they are suspected of hiding contraband, even if the arrestee is being held for a minor offense and no matter the circumstances. In this 5-4 decision split along ideological lines, Justice Kennedy wrote for the majority and relied largely on the need for judicial deference to prison officials in matters of prison security. In dissent, Justice Breyer detailed the invasive strip search procedures utilized, and he catalogued a litany of minor offenses for which a person can be subjected to these procedures (driving with a noisy muffler, driving with an inoperable headlight, failing to use a turn signal, riding a bicycle without an audible bell, etc.). He also cited a New York study revealing that, in 23,000 strip searches over a four-year period, 5 items of contraband were revealed.

Ineffective assistance of counsel. In two much-discussed cases, *Missouri v. Frye*, 132 S.Ct. 1399 (2012) and *Lafler v. Cooper*, 132 S.Ct. 1376 (2012), the court applied the requirements of effective assistance of counsel in the plea bargain phase of criminal cases. This pair of cases likely will have the broadest impact in criminal matters, given that the vast majority of criminal convictions are based on a guilty plea – 97% in federal court, and 94% in state court.

In *Frye*, the court recognized that the Sixth Amendment right to effective assistance of counsel applied to consideration of a criminal plea offer that lapses or is rejected, even though no formal court proceedings are involved. Counsel’s failure to present his client with the prosecution’s plea offers was ineffective assistance under the familiar test of *Strickland v. Washington*, 466 U.S. 668 (1984), where the client was convicted at trial and received a more severe sentence than in the plea offers, though the court remanded for a determination as to prejudice.

In *Lafler*, a defendant was charged with attempted murder. The defendant rejected a plea offer based on his attorney’s (legally erroneous) advice that he could not be convicted of attempted murder because he shot the victim below the waist. The state argued that there was no prejudice because the defendant

received a fair trial. The court held that a defendant’s rejection of a plea offer based upon ineffective legal advice met the first prong of *Strickland*. As to the second prong, the prejudice claimed was actually going to trial. In such case, the court held the defendant must show that “but for the ineffective advice of counsel there is a reasonable probability that the plea offer would have been presented to the court..., that the court would have accepted its terms, and that the conviction or sentence, or both, under the offer’s terms would have been less severe than under the judgment and sentence that in fact were imposed.”

Reiterating the importance of these cases, Chemerinsky noted that the next question is whether they will be retroactively applied. He believes there is a strong argument for retroactivity, as *Lafler* was litigated under the Anti-Terrorism and Effective Death Penalty Act (AEDPA), which requires that a *habeas* petitioner show that the state law is contrary to clearly established federal law as determined by the U.S. Supreme Court. Concluding that counsel provided ineffective assistance, the court recognized that the law was clearly established, and thus the standards should be applied retroactively.

Eighth Amendment as applied to minors. In a continuation of cases from previous terms, the court held in *Miller v. Alabama*, 132 S.Ct. 2455 (2012) that it is cruel and unusual punishment to mandate a sentence of life without the possibility of parole (LWOP) for homicide crimes committed by juveniles. This follows the court’s holdings in *Roper v. Simmons*, 543 U.S. 551 (2005), that the death penalty is unconstitutional as applied to juveniles, and *Graham v. Florida*, 130 S.Ct. 2011 (2010) that an LWOP life without parole sentence is unconstitutional for juveniles in non-homicide cases. While not precluding an LWOP life without parole sentence for homicide crimes, the *Miller* court held that the factfinder must consider sentencing factors such as the heinousness of the crime, the diminished culpability of juveniles, and the likely rehabilitation of the juvenile offender. Chemerinsky observed that this is likely to result in bifurcated proceedings, with a jury separately considering sentencing factors; this would be a major procedural change and give rise to the only non-death penalty cases where a sentencing phase is applied.

Chemerinsky also addressed a case on the Sixth Amendment’s confrontation clause, *Williams v. Illinois*, 132 S.Ct. 2221 (2012) and a challenge to eye witness testimony under the due process clause. *Perry v. New Hampshire*, 132 S.Ct. 716 (2012). Finally, he noted two important *habeas* cases that expanded the circumstances in which a procedural default may be excused. See *Maples v. Thomas*, 132 S.Ct. 912 (2012) and *Martinez v. Ryan*, 132 S.Ct. 1309 (2012).

All in all, it was a highly informative and entertaining discussion and left each of us anxious for next year’s Supreme Court term, and of course, hopefully, the chance to hear Chemerinsky’s insightful “roundup” once again.



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September 20–22
Manchester Grand Hyatt

Participate in this year's schedule featuring CLE sessions on current trends in civil, criminal, and bankruptcy law with prominent speakers including Ninth Circuit Judges J. Clifford Wallace, Mary M. Schroeder, and Michael Daly Hawkins, Dean Erwin Chemerinsky, and Judy Clarke. Show your support at the Foundation of the FBA Fellows Luncheon, the Younger Federal Lawyer Awards Luncheon, and the FBA Awards Luncheon. Enjoy a reception and tour at the U.S.S. Midway Museum and an Open Air Fiesta by the San Diego Bay! And top it all off at the Reception and Presidential Installation Banquet.

SCHEDULE AT A GLANCE

Wednesday, Sept. 19

2:00–5:00 p.m. Registration Desk Open

Thursday, Sept. 20

7:30 a.m.–5:00 p.m. Registration Desk Open

8:00 a.m.–5:00 p.m. Exhibits Open

8:00–8:30 a.m. Welcome and Remarks

8:30–9:30 a.m. Session 1A: Legal Standards and Effective Advocacy: How to Use the Law to Persuade

Session 1B: Veterans in Criminal Court: Resources for Change
Sponsor: Veterans Law and Criminal Law Sections

9:45–11:00 a.m. Session 2: Supreme Court Review of the 2011–2012 Term and Preview of the Upcoming Term

11:15 a.m.–12:15 p.m. Session 3A: Hot Topics in International Environmental Law
Sponsor: Energy, Environment, and Natural Resources Law Section

11:15 a.m.–12:15 p.m. Session 3B: Professional Liability and Legal Malpractice (Ethics)
Sponsor: Professional Ethics Committee

12:30–2:00 p.m. Foundation of the FBA Fellows Luncheon

2:15–3:45 p.m. Session 4A: The Supreme Court's 2011 Class Action Revolution—A One Year Retrospective
Sponsor: Federal Litigation Section

Session 4B: The Tribal Law and Order Act and Its Effect on California
Sponsor: Indian Law Section

4:00–5:00 p.m. Session 5A: Immigrant Rights Under the Constitution
Sponsors: Civil Rights and State and Local Government Relations Sections

4:00–5:00 p.m. Session 5B: Confirm or Ignore? Social Media Technologies Offer a Wealth of Evidence for Litigators

5:00–6:00 p.m. Federal Litigation Section Happy Hour

6:30–9:30 p.m. Reception at the U.S.S. Midway Museum

SCHEDULE CONTINUED ON NEXT PAGE



For more information, please visit www.sandiegofbaconvention.com today!

SCHEDULE CONTINUED FROM PREVIOUS PAGE

Friday, Sept. 21

- 7:30 a.m.–4:00 p.m. Registration Desk Open
- 8:00 a.m.–4:00 p.m. Exhibits Open
- 8:00–8:40 a.m. **Ninth Circuit Swearing In Ceremony**
- 8:45–9:45 a.m. **Session 6A: Padilla v. Kentucky: Vacating Criminal Convictions—A Practitioner’s Guide**
Sponsor: Immigration Law Section
- 8:45–9:45 a.m. **Session 6B: Trends in Labor and Employment Law: A Panel Discussion**
Sponsor: Labor and Employment Law Section
- 10:00–11:00 a.m. **Session 7A: The Expansion of Federal Criminal Jurisdiction**
Sponsor: Criminal Law Section
- Session 7B: Patent Litigation Under the AIA—Strategic Use of New USPTO Post-Grant Oppositions**
- 11:15 a.m.–12:15 p.m. **Session 8A: The 10 Bankruptcy Cases From the Past Year That Will Affect Your Law Practice**
Sponsor: Bankruptcy Law Section
- 11:15 a.m.–12:15 p.m. **Session 8B: How Big Data Affects eDiscovery**
- 12:30–2:00 p.m. **Younger Federal Lawyer Awards Luncheon**

- 2:15–3:30 p.m. **Session 9: Survive and Thrive: Perspectives for a Younger Lawyer**
Sponsor: Younger Lawyers Division
- 2:15–3:45 p.m. **Vice Presidents for the Circuits Training**
- 2:15–4:15 p.m. **Federal Bar Building Corporation Board Meeting**
- 4:30–6:00 p.m. **Sections and Divisions Happy Hour**
- 6:00–9:00 p.m. **Open Air Fiesta by the San Diego Bay**

Saturday, Sept. 22

- 7:30 a.m.–5:00 p.m. Registration Desk Open
- 8:30–9:45 a.m. **Vice Presidents for the Circuits Meeting**
- 8:30–11:00 a.m. **Section and Division Chairs Meeting**
- 9:30–11:30 a.m. **Foundation of the FBA Board Meeting**
- 10:00–11:30 a.m. **Chapter Education Program Presented by the Vice Presidents of the Circuits**
- 11:45 a.m.–1:45 p.m. **FBA Awards Luncheon**
- 2:00–5:00 p.m. **National Council Meeting**
- 6:30–10:30 p.m. **Reception and Presidential Installation Banquet**

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and the Court takes its responsibility under FRCP 1 to “administer” the “just, speedy, and inexpensive determination of every action and proceeding” seriously. Since much of discovery these days involves electronically stored information and the related costs of producing it, Judge Dembin particularly looks at the proportionality of the burden imposed by a particular request to the likely relevance of the ESI being sought.

VIEWS FROM THE DISTRICT COURT JUDGES

Three of the District Court Judges also spoke about practice in the Court, particularly with regard to motions.

The Honorable Barry Ted Moskowitz – Speaking in his role as Chief Judge of the Court, Judge Moskowitz said the Court prides itself on being “user friendly”. Calls to chambers on matters of form, scheduling of motions, etc. are welcome – so long as they come from counsel. He also shared his “secret weapon” for success in federal court. First read the rules and the statutes involved in the case. Then read them a second time.

Each case is assigned to a Magistrate Judge and a District Court Judge. Motions on procedural matters, like discovery, are addressed by the Magistrate Judge; dispositive motions must come before the District Judge. If counsel are unsure which Judge will address a particular motion, that is an example of a question that can be addressed by a call to chambers. Both Judges follow the Court’s local rules, but each also have their own chambers rules. For that reason, it would not be a good idea to be unsure which judge will address a particular motion. Judge Moskowitz has even seen counsel who have downloaded and stored the different sets of rules on their cell phones to have them available for reference.

The Honorable Anthony J. Battaglia shared “Ways to Survive and Succeed” in motions practice. Echoing many of the speakers, Judge Battaglia emphasized the value of knowing the rules and avoiding personal attacks on other counsel or their arguments. A winning brief succinctly states what the moving party wants, the applicable burden of persuasion and why s/he is entitled to the relief sought. Jargon, footnotes, block quotes, inaccurate citations, poor spelling and grammar, voluminous exhibits – all of these detract; addressing the other side’s arguments, being succinct and knowing your audience are all rewarded with attention from the reader. The best brief is one that succeeds even without oral argument.

The Honorable Marilyn Huff then shared her “Top 10” tips in the event that oral argument of a motion is granted. She encouraged counsel to be (1) Early – on time is late; (2) Prepared – this improves performance; (3) Professional – in their dress and knowledge of the formalities; (4) Confident – even if this requires some memorization; (5) Flexible – so they answer the Court’s questions; (6) Brief; (7) Interesting – for example, is there one exhibit that tells the “story”; (8) Truthful; and (9) Themselves. Last of all Judge Huff said each advocate should remember to:

Stand up – so the judge can see you
Speak up – so the judge can hear you and
Sit Down – so the judge will love you

Attendees then enjoyed the opportunity to meet the speakers and other local judges at a reception following the event.

WELCOME NEW MEMBERS TO THE SAN DIEGO CHAPTER OF THE FEDERAL BAR ASSOCIATION

Ruth R. Ryan-Cruz

Amy M. Krakower

Vikram S. Monder

Kurt D. Hermansen

Leah Strickland

Gary B. Rudolph

Charles Berwanger

Paul F. Prather

Matthew Mueller

Robert Marasco

Marie M. Stockton

Danielle Blackhall

Licia Vaughn

Jodi Cleasattle

Congratulations to Kurt D. Hermansen, the winner of the membership drive iPad!

GENERAL METHODOLOGIES FOR CALCULATING DAMAGES

Judge Huff began by stating that, although *Lucent* and its progeny certainly constrain the *Georgia-Pacific* methodology, it still “reigns” as the technique for calculating damages due to the lack of any other clearly-defined approach. The only other approach discussed by the panel was the analytical “business realities” approach, such as that presented in *Riles v. Shell Exploration & Proc. Co.*, 298 F.3d 1302 (Fed. Cir. 2002). In *Riles*, the defendant argued that the damages amount must be capped at the cost savings between the best non-infringing alternative and the patented invention. According to the defendant, it would not have entered into a license for more than it could have paid to simply choose a non-infringing alternative instead. Instead of exploring this argument, the court remanded that question. And although Chief Judge Randall R. Rader of the Federal Circuit has apparently indicated that he expects the Federal Circuit will soon revisit the business realities approach, Judge Huff expressed that, in the meantime, district courts are unsure of its limits. Practically speaking, Judge Bencivengo described the business realities approach as “the defendant’s approach,” although Mr. Denning noted that in the *Uniloc* retrial, the *plaintiff* based its case on that approach.

DAMAGES EXPERTS

Judge Bencivengo stated that damages experts should build their entire model from scratch, explaining that any analysis that tries to fit around a client-chosen number will necessarily be unsound. Judge Huff added that a lesson from *Lucent* and its progeny is that parties should hire their damages experts early in a case. Mr. Hansen echoed that sentiment, stating that, for example, an expert can assist in determining the fact discovery necessary to prove license comparability. The panel agreed that the heightened standard of license comparability means more discovery, more expert analysis, and, ideally, more trial time devoted to testimony from damages experts.

LICENSE COMPARABILITY

Both judges agreed that comparable licenses are nearly essential for a damages case. As Judge Bencivengo stated, “You should try to tie your case to something.” And although they agreed that the licenses must be comparable, they acknowledged that there is an unavoidable “continuum” of comparability. According to Judge Bencivengo, the question is: “How comparable is it?” Building on this point, Mr. Hansen analogized to the real estate context and suggested that courts move toward allowing in more licenses so long as the weight given to each license is properly adjusted according to its comparability. The judges agreed that less comparable licenses might have some relevance in certain situations. Judge Bencivengo surmised that otherwise-unrelated licenses might be relevant to show the structure of a license, such as a long history of licensing on a lump sum basis.

Judge Huff noted that the Southern District has specifically adopted the rule that both economic and technological comparability must be assessed. See *DataQuill Ltd. v. High Tech Computer Corp.*, slip op., 2011 WL 6013022, at *18-22 (S.D. Cal. Dec. 1, 2011) (Gonzalez, J.); see also *Lucent Techs., Inc. v. Microsoft Corp.*, __ F.Supp.2d __, 2011 WL 5513225 (S.D. Cal., Nov. 10, 2011) (Huff, J.), and prior *in limine* orders. Considering the technological comparability requirement, the panel agreed that testimony of a technical expert may now be beneficial in establishing license comparability. Indeed, Judge Huff indicated that such testimony might be necessary.

LICENSES ARISING FROM SETTLEMENT OF LITIGATION

The panel next discussed the ongoing debate of whether royalty rates from litigation settlement agreements should be admissible as part of a *Georgia-Pacific* analysis to show the reasonable royalty that would result at the hypothetical negotiation. According to Judge Bencivengo, there is no reason to treat settlement agreements differently than any other license: “All licenses are effectively settlement agreements.” This echoes the language of *ResQNet*, which has been interpreted by most courts to permit reliance on settlement agreements in a reasonable royalty analysis. See *ResQNet*, 594 F.3d at 872 (stating, “the most reliable license in this record arose out of litigation”); see also *In re MSTG, Inc.*, 675 F.3d 1337, 1348 (Fed. Cir. Apr. 9, 2012) (holding that “settlement negotiations related to reasonable royalties and damages calculations are not protected by a settlement negotiation privilege”); but see *In re MSTG*, 675 F.3d at 1346 n.4 (stating that “we have not yet decided the extent to which evidence of settlement negotiations would be admissible”). Judge Huff suggested that this increased reliance on settlement agreements may make plaintiffs more cautious about entering into settlements and defendants more critical of their co-defendants’ settlements. Judge Bencivengo suggested, however, that increased access to settlement agreements might facilitate settlement negotiations by ensuring fairness across licensees. See also *Caluori v. One World Techs., Inc.*, 2012 WL 630246, at *4-5 (C.D. Cal. Feb. 27, 2012) (admitting settlement agreement); *ReedHycalog UK Ltd. v. Diamond Innovations, Inc.*, 2010 WL 3021550, at *2-3 (E.D. Tex. Aug. 2, 2010) (Davis, J.) (same); and *Datatrans Corp. v. Wells Fargo & Co.*, 2010 WL 903259, at *1-2 (E.D. Tex. Mar. 4, 2010) (Folsom, J.) (same); *Small v. Nobel Biocare USA, LLC*, 808 F. Supp. 2d 584, 590-92 (S.D.N.Y. 2011) (granting motion to compel settlement agreement with co-defendant); *Volumetrics Med. Imaging, LLC v. Toshiba America Med. Sys., Inc.*, 2011 WL 2470460, at *14 (M.D.N.C. June 20, 2011) (same); but see *Fenner Invs., Ltd. v. Hewlett-Packard Co.*, 2010 U.S. Dist. LEXIS 41514, at *4-5 (E.D. Tex. Apr. 28, 2010) (refusing to admit settlement agreements because “the potential for prejudice and jury confusion substantially outweigh any probative value,” and *ResQNet* “does not compel the admission” of settlement agreements).

ENTIRE MARKET VALUE RULE

The panel generally agreed that the entire market value approach is currently in decline. Although it may still have traction in pharmaceutical cases, Mr. Hansen stated that high tech cases just don’t use it anymore. Judge Huff acknowledged that many litigants should give up on the entire market value rule and opt instead for apportionment. Judge Bencivengo seconded that point, especially where the invention is embodied in a small component that is incorporated into the larger accused product.

The panel also agreed that it is hard to come by sound evidence that an invention is the basis for consumer demand. According to Judge Huff, customer surveys cannot adequately answer the question, because they are simply too malleable. And Judge Bencivengo said that, although internal marketing materials may constitute persuasive qualitative evidence, the import of that evidence is questionable. She maintained, however, that to the extent a litigant seeks to rely on the entire market value rule, the best showing would have the quantitative and qualitative evidence corroborating each other.

“Judge Bencivengo Discusses Her Procedures and Practices” (continued from page 4)

should be provided. Counsel should cite to matters already in the record by the Docket Number, and counsel do not have to provide additional copies of such materials as exhibits.

Judge Bencivengo generally does not issue written tentative rulings before a motion hearing because she likes to remain open-minded as she listens to argument. She usually will announce an oral tentative at the start of the hearing, or ask some initial questions to try to focus the oral argument. Judge Bencivengo emphasized that it is critical for counsel to listen carefully to the court’s questions, and answer the question directly.

All applications for temporary restraining orders must be briefed. While Judge Bencivengo may handle a TRO application on a true *ex parte* basis (i.e. with no notice to the opposing party) in an extraordinary case, she almost always requires notice to the opposing party and an opportunity for the opposing party to file an opposition. She may use a limited TRO in the appropriate case to preserve the status quo to allow for the filing of an opposition.

Judge Bencivengo generally has oral argument on TRO applications and preliminary injunction motions, and may conduct evidentiary hearings on preliminary injunction motions if appropriate. *Ex parte* applications generally will be decided on the papers but there may be oral argument depending on the nature of the application.

Bringing knowing smiles and chuckles from the attendees, Judge Bencivengo reminded counsel of the three most important rules of oral argument: “Know when to stand up, speak up and then shut up!!”

Not surprising given her extensive patent litigation background, Judge Bencivengo spent a lot of time at the lunch discussing her procedures for claim construction hearings. Judge Bencivengo explained that the procedures to be followed in a particular claim construction hearing are tailored to the needs of a particular case. In some cases, she may have a telephone conference with counsel prior to the conference to informally discuss the number of claims involved and ways to streamline the hearing and make it more productive.

Judge Bencivengo stressed that the goal of the claim construction hearing is to make the complex as simple as possible – as she explained, a good claim construction hearing will make the claims “as simple

as a shoe.” Judge Bencivengo indicated that she is willing to have a non-argumentative “tutorial” in the appropriate case, either before or at the claim construction hearing. She generally allows the lawyers to be present during the tutorial. She may allow expert participation during the claim construction hearing, but emphasized that the proper role of the expert is to teach rather than be an advocate.

Judge Bencivengo does not require separate statements for summary judgment motions. She does not plan to have conversations with the magistrate judges regarding settlement, but explained that she will work with the magistrate judges on scheduling issues and plans to be as flexible as possible regarding scheduling matters.

CRIMINAL MATTERS

Judge Bencivengo of course has substantial experience taking pleas in criminal cases so she explained that she is not opposed to taking a plea herself in a case that already is before the court. All pretrial motions are to be scheduled with the assigned magistrate judge. She requires that all counsel strictly adhere to Local Criminal Rule 32.1(a) (9) regarding sentencing charts.

Judge Bencivengo explained that the first continuance in a criminal case may be arranged by telephone, and usually will be granted as a matter of course. Additional requests for continuances may require a written filing and a showing of good cause.

Judge Bencivengo’s Chambers Rules for Criminal Cases have detailed procedures for criminal trials and pre-trial matters.

TRIAL

Judge Bencivengo generally will allow attorney *voir dire* in civil cases, and will usually give counsel 15-20 minutes to question the jury in a non-complex case. She may be willing to allow additional time in more complex cases. She also allows the parties to submit written *voir dire* questions to be asked by the court. Judge Bencivengo handles challenges to prospective jurors outside the presence of the venire. Otherwise, she expressed that she always works with trial counsel to make the trial process a positive and fair experience.

“Brown Bag Luncheon with Magistrates Bartick and Crawford” (continued from page 5)

and stated “If counsel is going to object to a protective order, they must explain why it’s not appropriate in a given case.” Crawford also encouraged litigants to use magistrate judges for trials, noting that trials can typically begin more quickly with a magistrate judge than in district court.

Judge Bartick cautioned that he is sensitive to *ex parte* communications. He also reminded the audience that the magistrate judge’s calendar is often set based on the district court judge’s calendar. According to Bartick, “The cases belong to the district court judges and the magistrate judges are there to manage them.” In the context of criminal proceedings, Judge Bartick requires 24 hours of notice for all bond modification hearings. Also, he mentioned he does not mind if defense counsel need to get certain documents signed while court

is in session, but stated that counsel must at least have the documents available.

PET PEEVES

Finally, the Magistrate Judges were asked about their pet peeves, though neither judge had many to share. Judge Crawford asked attorneys to submit their filings on time and to refrain from asking for a continuance the day before a hearing. She warned counsel that “Obstreperous behavior does not help your clients and the court does not appreciate it.” What bothers Judge Bartick the most is when counsel are not prepared to go forward, though both he and Judge Crawford have already been impressed with the preparation of counsel in this district to date.

DEFERRED ACTION FOR CHILDHOOD ARRIVALS

Deferred action is an administrative relief from deportation. It does not provide lawful status or a pathway to permanent residence or citizenship. Individuals whose cases are deferred as part of this process will not be removed from the United States for a two-year period, subject to renewal, and may also apply for employment authorization.

Individuals who receive deferred action will not be placed into removal proceedings or removed from the U.S. for the duration of the grant. Individuals in removal proceedings, those with final orders or a voluntary departure order, and those who have never been in removal proceedings can affirmatively request deferred action from USCIS.

This temporary relief can be revoked at any time upon decision from the Department of Homeland Security, but allows Congress enough time to craft a bipartisan solution to immigration reform. This action, as an administrative act, is not subject to review by administrative or federal courts.

Deferred Action is not a new policy, as it has been given to many people before, such as international students affected by Hurricane Katrina, medical cases and special marriage cases. However, the recent policy is an umbrella action which affects the largest number of people ever allowed to petition for deferred action.

The recent policy affects immigrants who came to the United States as children under the age of 16, have completed or are currently in school, and who are below age 30. This program allows the Department of Homeland Security to exercise its discretion and not deport “low-priority individuals.”

Assessments hold that there will be roughly 1.8 million people who are eligible for deferred action consideration. There are estimated to be roughly 67,000 potential applicants in the immediate San Diego area, and over 412,000 in California alone, nearly half of the total applicants.

MANDATORY DETENTION

On October 9, 1998, INA §236(c), 8 U.S.C. §1226(c), mandatory detention became effective for all non-citizen, including legal residents, charged under specified crime-related grounds of inadmissibility and deportability. INA §236(c), 8 U.S.C. §1226(c), is triggered by a broad set of criminal offenses, and mandates detention without regard to the individual’s term of residence in the United States, ties to this country and efforts to rehabilitate. The statute includes a long list of crime-related grounds of inadmissibility or deportability which activate the mandatory detention rules.

In *Demore v. Kim*, 538 U.S. 510 (2003) – the U.S. Supreme Court upheld mandatory detention under INA § 236(c) for the “brief period” necessary for removal proceedings. Since that ruling some lower courts have set limits on the government’s authority to detain a person without a bond hearing. According to *Diop v. ICE/Homeland Sec.*, 656 F.3d 221, 223 (3d Cir. 2011), INA §236(c) must be construed as authorizing detention for only a brief and “reasonable period of time.” *Tijani v. Willis*, 430 F.3d 1241, 1249 (9th Cir. 2005) (holding that the mandatory detention statute only authorizes detention for “expeditious” removal proceedings, not for those that exceed the brief period of time set forth in *Demore*).

Recent immigration court case law has found that if mandatory detention is unreasonably long, an Immigration Judge can review the detention and release the detainee on bond. *In re --*, Immigration Court, Arlington, VA, August 21, 2012. Mandatory detention can be deemed unreasonable on the basis of violation of due process. The Immigration Judge may assume jurisdiction over bond despite INA §236(c). If the Immigration Judge determines the length unreasonable, the burden shifts to the government to address bond factors, such as flight risk and danger to the community.

As a result of recent case law, executive orders’, long standing immigration policy and federal court review, mandatory detention is no longer mandatory without exceptions.

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1544, (D. Utah, 1995), a federal court ruled for the first time that American Indians were citizens of the states in which they lived, and therefore, had the right to equal educational opportunities. When the decision came down, the attorney for the private plaintiffs declared, “This is the *Brown v. Board* of Indian education.”

During the year of the 50th anniversary of *Brown v. Board of Education* in 2004, Baca received many invitations to deliver speeches all over the country about American Indian rights, equal educational opportunities, and the importance of diversity in education. He never turned down a chance to speak on behalf of American Indians’ civil rights or to emphasize the importance of equality in education.

Other cases that Baca worked on involved allotting funds for the bilingual education of American Indians, credit discrimination against American Indians, and securing voting rights for those with unwritten languages. Under Baca’s charge, a federal court handed down another huge victory for civil rights. The court ruled that American Indians had a right to receive voting information orally comparable to that of English speakers, and that American Indians had an absolute right to effective translation of a voting ballot.

Baca’s groundbreaking career drew widespread recognition. In 2008, Baca retired, receiving three distinguished awards. First, the Attorney General presented him with the Attorney General’s Medallion, the highest award a retiring employee can receive. Second, the Federal Bar Association named him the first recipient of the eponymously-named Lawrence R. Baca Lifetime Achievement Award for Excellence in Federal Indian Law. Finally, Baca was recognized with the ABA Spirit of Excellence Award, which honors the efforts and accomplishments of attorneys who work to promote a more racially and ethnically diverse legal profession.

In addition to receiving numerous awards, Baca has been involved with several bar associations and American Indian groups. Baca has been a member of the Federal Bar Association since 1982. He is a former Secretary, Treasurer, and in 2009, Baca became the first American Indian to be President of the Federal Bar Association. He has served on numerous committees, including the Governance Review Committee, Committee on Minority Membership, National Membership Committee, Continuing

Legal Education Committee and the Nomination and Elections Committee. Baca also served as the first Chairman of the Federal Bar Association’s newly created Indian Law Section from 1989 to 2004. He is a past member of the ABA, and from 2002 to 2005 he was the Chairman of the Commission on Racial and Ethnic Diversity in the Profession. Additionally, Baca has been a member of the National Native American Bar Association (NNABA) since 1979, and is the only person to have been elected President of the NNABA for three separate terms. Baca still serves as Treasurer for the NNABA today.

Baca has lectured on the topic of American Indian law and diversity and has been a guest speaker at numerous universities, law schools, and bar association conferences all over the United States. In 2008, he was an Adjunct Professor at Howard University School of Law where he taught a course in Federal Indian Law. Additionally, Baca taught another course on Federal Indian Law at American University Washington College of Law for two years.

Beyond his prominent career championing American Indian rights, Baca authored articles for several publications, including *The Public Lawyer*, *Howard Law Journal*, *University of Illinois Law Review*, *The Federal Lawyer*, *The Federal Bar News & Journal*, *The Indian Civil Rights Act at Forty*, and the Smithsonian Institution’s *Handbook of North American Indians*.

Although Baca has been honored for his work over the years, receiving the ABA Thurgood Marshall Award was especially humbling to him. He described feeling “overwhelmed” that his peers placed him in the company of such distinguished past recipients of the award, such as the Honorable Frank M. Johnson, Jr., Oliver W. Hill, and of course, Justice Thurgood Marshall. As an attorney for the Department of Justice, Baca lamented the anonymity that comes with being a government lawyer. Receiving the ABA Thurgood Marshall Award made him feel “very gratified” to be recognized for his efforts.

It is undeniable that Baca was a pioneer for American Indians. Among all his accomplishments, Baca believes his most important achievement was recruiting other American Indians into the Department of Justice, to continue the fight for American Indians’ civil rights.

UPCOMING FEDERAL BAR ASSOCIATION – SAN DIEGO CHAPTER EVENTS

- 8th Annual Judith N. Keep Federal Civil Practice Seminar, September 13, 2012, 1:00-5:00 pm, Jury Lounge, 880 Front Street, San Diego
- National Federal Bar Association Meeting and Convention, September 20-22, 2012, Manchester Grand Hyatt, San Diego
- eDiscovery 101
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U.S. District Court, Courtroom 1
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- Annual State of the District Luncheon, November 14, 2012, 12 noon, Westin Gaslamp Quarter, San Diego
- Annual Holiday Reception, December 12, 2012, 5:00-7:00 pm, Mary Pappas' Athens Market, San Diego

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