tionality during all advertisements." Dish also agreed not to "record, copy, duplicate and/or authorize the recording, copying, duplication (other than by consumers for private home use) or retransmission" of any part of Fox's signal.

In 2012, Dish offered the Hopper, "a set-top box with digital video recorder (DVR) and video on demand capabilities," to its customers; the Hopper allowed Dish's customers to utilize a software feature called PrimeTime Anytime, through which the customers could "set a single timer to record any and all primetime programming on the four major broadcast networks (including Fox) every night of the week." *Id.* at 1071. A feature of PrimeTime Anytime, called AutoHop, "allows users to automatically skip commercials" for many PrimeTime Anytime shows. *Id.* at 1072. To enable AutoHop, Dish technicians watch each night's prime-time broadcasts and manually insert the parameters for commercial skipping for each show; each night, Dish tests the accuracy of the technicians' parameters on stored copies of the prime-time shows.

Fox sued Dish for copyright infringement and breach of contract and sought a preliminary injunction against Dish's PrimeTime Anytime and AutoHop features, which the U.S. District Court for the Central District of California denied. *Id.* (citing *Fox Broad. Co. v. Dish Network, L.L.C.*, 905 F. Supp. 2d 1088 (C.D. Cal. 2012)). The district court held that Fox failed to demonstrate a likelihood of success on nearly all of its claims, except for the breach of contract claim resting on Dish's use of broadcast copies to test the technicians' commercial-skipping parameters. The district court held, however, that Dish's use of the broadcast copies was not an "irreparable harm" sufficient to support an injunction. *Id.* (As an aside, Dish has been successful in fending off injunctive relief in other courts, as well, even if it may still face liability on the ultimate merits of the copyright infringement claims asserted against it. *See, e.g.*, *In re AutoHop Litig.* No. 12-cv-4155(LTS)(KNF), 2013 WL 5477495 (S.D.N.Y. Oct. 1, 2013) (holding that American Broadcasting Co. is not entitled to a preliminary injunction preventing DISH from offering its PrimeTime Anytime and AutoHop services to DISH subscribers).)

The Ninth Circuit reviewed the district court's rulings under a very deferential abuse of discretion standard and applied a preliminary injunction test that asked whether Fox was likely to succeed on the merits and likely to suffer irreparable harm in the absence of relief. *Id.* at 1073 (citing *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1157 (9th Cir. 2007); *Winter v. Natural Res. Def. Council, Inc.*, 555 U.S. 7, 20 (2008)). The Ninth Circuit held, at each turn, that the district court appropriately exercised its discretion in denying Fox a preliminary injunction.

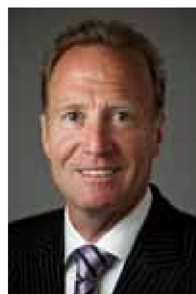
First, the court found that Fox's direct copyright infringement claim failed because a user's enabling PrimeTime Anytime to store copies of Fox's programs did not make Dish a direct infringer of Fox's copyright; the court found, instead, that Dish merely "operat[es] a system used to make copies at the user's command." *Id.* at 1073 (citing *Cartoon Network LP v. CSC Holdings, Inc.*, 536 F.3d 121 (2d Cir. 2008)). Next, the court held that Fox's secondary copyright infringement claim failed because even though Dish's services enabled direct copyright infringement by Dish users, Dish was "likely to succeed on its affirmative defense that its customers' copying was a 'fair use'" under *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984), which analyzed many of the same types of uses of copied programs in the context of Sony's Betamax VCRs. *Fox Broad. Co.*, 723 F.3d at 1074-76. Finally, the court held that even assuming that Fox could establish Dish's breach of contract based on Dish's use of copies of Fox's programs for internal quality control purposes, Fox failed to show that Dish's copying would be an irreparable harm sufficient to support a preliminary injunction. *Id.* at 1076-78. The court held, instead, that any harm done to Fox could easily and appropriately be compensated for with a financial payment. *Id.* at 1079.

Lesson Learned: First, this case reminds us that when reviewing a judgment under the appropriate standard, an appellate court will give significant latitude to a district court's exercise of its discretion in granting or denying a motion for preliminary injunction, and where, as here, the district court's conclusions are reasonable in view of the facts, the appellate court will not substitute its judgment for the lower court's. In addition, this case shows that appropriate guidance from older case law can still provide the framework for analyzing copyright claims in the face of advanced technology: both the lower court and the court of appeals followed the Supreme Court's nearly 30-year-old holding from the *Sony* Betamax case in ruling on the legality of Dish's program time-shifting and commercial-skipping software.

To come in the next issue: the Ninth Circuit addresses an issue of first impression regarding injunctive relief after a claim of trademark infringement.

Trial Presentation Made Easy

Steve Larson and Angel Falconer, Stoll Berne



Steve Larson

Angel Falconer

Jurors, trial judges, and arbitrators have grown to expect technology in the courtroom to assist with the visual communication. As a result, in addition to developing the visual story, the lawyer also has to work out the logistics for presenting the trial exhibits, demonstrative aids and other visuals that will be used at trial.

With all of the new apps available for the iPad and other tablets, a lawyer can do much more visual advocacy on his or her own. However, for cases with a large number of trial exhibits, or cases with fact patterns that involve hard to grasp issues that are going to need a little more sophisticated demonstrative aids to explain the complex concepts, or cases with videotaped testimony, an assistant that can rapidly find and show trial exhibits on the fact-finder's monitors, connect a piece of testimony to a demonstrative exhibit and present it to the fact-finder, and pull up videotaped deposi-

tion testimony to impeach a witness will be very valuable.

There are many very capable independent third parties offering their services to assist trial lawyers with trial presentation. However, we have found that having an in-house paralegal who is savvy with the current trial presentation computer software can provide a number of advantages over using an outside third-party trial presentation consultant.

First, an internal paralegal may be as familiar with the documents in the case as the lawyer, if not more so. Familiarity with the documents makes the process of directing a paralegal to a specific section of a document to call out or highlight for the fact-finder much less cumbersome than working with someone who doesn't have any knowledge about the case. That also makes it easier to communicate on the fly about what you are trying to do when you suddenly decide there is something the fact-finder is not getting that you need to emphasize.

Second, the internal paralegal will have had a more hands on role in getting the case ready for trial, so he or she will be familiar with the witnesses, themes of the case, and the points demonstrative aids are intended to emphasize. We frequently have paralegals suggest that we consider using a certain trial exhibit as we are doing cross-examinations. After your paralegal gets more experienced, he or she may also be able to provide you with feedback from a lay person's perspective. An outside independent contractor may be reluctant to tell the trial lawyer that an argument is missing the boat, where an internal employee, who may have had a longer relationship with the lawyer, may feel more comfortable offering advice.

Third, it is much easier to practice opening statements and closing arguments when you are working with someone in-house. Since our paralegals are in the office with us every day, we can practice different approaches days or even weeks before the trial. It is also easier to make last-minute changes to demonstrative aids and the order that visuals will be presented during opening statements and closing arguments if you are working with someone in-house. This repeated exposure to working together should make your presentation smoother than it might be with an outside third party. Jurors, judges, and arbitrators notice how well you work with your paralegal. A number of jurors have told us after trials that they were impressed how our attorney and paralegal team worked together, and how they appreciated the fact that the paralegal could display evidence on the monitors promptly. We have even had arbitrators (who were also practicing trial lawyers), opposing counsel, and third-party consultants approach our paralegals to ask about using the computers and software for the visual presentations.

Having a paralegal learn to use the computers and software for visual presentations may seem like a big project, but a few simple steps can make a computer savvy paralegal ready to be a top-notch trial presentation assistant.

The two trial presentation programs we have used are TrialDirector and Sanction. Both offer customized training solutions, including on-site training for lawyers and staff and thorough written materials. But practice is the real key to success. Starting as early as possible with building the trial database and practicing with case evidence in the database will

EXECUTIVE COMMITTEE OFFICERS

Chairperson
Melinda Thomas
Bryant Lovlien & Jarvis PC

Chair-Elect
Yael A. Livny
Oregon Department of Justice

Secretary
John R. Bachofner
Jordan Ramis PC

Treasurer
Renee E. Rothauge
Markowitz Herbold Glade & Mehlhaf PC

Past Chair
Kimberly D'Aquila
The Confederated Tribes of the Grand Ronde Community of Oregon

OSB Representative
Karen D. Lee
Oregon State Bar

BOG Representative
Timothy L. Williams
Dwyer Williams Potter Attorneys LLP

EXECUTIVE BOARD MEMBERS AT LARGE

Peter L. Barnhisel
Barnhisel Willis Barlow & Stephens PC

Eric L. Dahlin
Davis Wright Tremaine LLP

Jeanne F. Loftis
Bullivant Houser Bailey PC

Steven T. Lovett
Stoel Rives LLP

Scott C. Lucas
Johnson Johnson Larson & Schaller PC

Honorable Josephine H. Mooney
Lane County Circuit Court

Kim Sugawa-Fujinaga
McEwen Gisvold LLP

Jennifer S. Wagner
Stoll Berne

Kate A. Wilkinson
C&K Market, Inc.

ADVISORY BOARD MEMBERS AT LARGE

Lindsey H. Hughes
Keating Jones Hughes PC

Simeon D. Rapoport
iBridge LLC

Litigation Journal
Dennis P. Rawlinson, Managing Editor
Miller Nash LLP

This publication is designed to help attorneys maintain their professional competence. Although articles and features are reviewed prior to publication, in dealing with specific legal matters attorneys should conduct their own independent research of original sources of authority. Neither the Oregon State Bar/Litigation Section nor the contributors to this publication make either express or implied warranties regarding the use of the information contained in this Journal.

give the paralegal the opportunity to see what's working well, what's not working at all (including technical problems), make corrections and adjustments, or seek out more training well in advance of trial.

We have found that a good way for both the lawyer and the paralegal to practice is to run through opening statement several times before trial. Going through it together multiple times will help the lawyer and paralegal learn the best ways to communicate with each other and the jury will appreciate a well rehearsed and seamless presentation. A paralegal who is familiar with the case may also be able to offer suggestions to help the lawyer refine the message. We often invite others to sit in on a practice run as well.

Courtroom logistics are also a very important part of the trial presentation that should not be overlooked. Coordinating with courtroom personnel in advance to make sure that equipment and additional furniture can be accommodated is critical (there might not be room at counsel's table for your paralegal). Go as early as possible to visit the courtroom to get a feel for the layout, including where to access electrical outlets, where to set up a projector or monitors, the best location for any demonstrative aids, and even map out where the attorney can best engage the jury while still communicating well with the paralegal. In federal court, the courtrooms have much more technology available for the parties to use, but in state courts you will often need to make arrangements with opposing counsel to share some of the technology – like monitors. If possible, set up and test all equipment the day before trial to prevent disasters from happening in the first place.

Of course, there is no replacement for experience, but the more you practice together and the sooner you both get in the courtroom, the more confident both of you will be in each other's abilities. A little extra planning can help settle a lot of nerves.

In summary, given the potential for better performance, increased satisfaction from the fact-finder, more peace of mind for the trial lawyer, and lower costs for the client, using an in-house paralegal for trial presentation is an alternative that should be considered.

Steve Larson is a Shareholder at Stoll Berne who specializes in complex litigation. Angel Falconer is the Litigation Support Manager at Stoll Berne.

Pro Hac Vice: Procedure and Practice in Oregon

By Mark J. Fucile, Fucile & Reising LLP

With many kinds of litigation becoming increasingly "national" in scope, Oregon plaintiffs and defense lawyers alike are being asked more frequently to serve as "local" counsel for out-of-state "lead" counsel who are admitted *pro hac vice*. This article looks at two primary aspects of serving as local counsel. First, it surveys the process to obtain *pro hac vice* admission for out-of-state lawyers in Oregon state and federal court.[1] Second, it examines the role of local counsel in Oregon practice. With both, the focus is on trial courts—although similar procedures and considerations apply with equal measure to appellate courts.[2]

Procedures

Pro hac vice procedures in Oregon's state and federal courts share many common aspects but also have some marked differences. After surveying the process for admission, revocation of *pro hac vice* admission is also noted briefly.

State Court. *Pro hac vice* admission in Oregon state court is governed by ORS 9.241 and UTCR 3.170. The former confirms the Supreme Court's authority to regulate the temporary practice of law by out-of-state lawyers in both courts and administrative proceedings. The latter outlines the specific requirements for *pro hac vice* admission. ORS 9.241 and UTCR 3.170 create a two-tier approval process.

First, the out-of-state lawyer, typically through local counsel, must obtain a "certificate of compliance" from the Oregon State Bar. The required form is available on the Bar's web site.[3] Tracking the language of UTCR 3.170, the out-of-state lawyer must certify that the lawyer: is a member in good standing in the lawyer's "home" state bar; has no regulatory discipline pending (or, if there is, explain it); will associate with Oregon counsel; and, if the lawyer will engage in private practice, has professional liability insurance "substantially equivalent" to the Professional Liability Fund plan. The out-of-state lawyer's application must be accompanied by a certificate of good standing from the lawyer's "home" jurisdiction and a certificate reflecting the lawyer's malpractice coverage. When the required information and the accompanying fee are provided, the Bar then countersigns the certificate with an "acknowledgement of receipt" and notes any possible deficiencies for the consideration of the court in which the out-of-state lawyer wishes to appear. There are no "firm" admissions. Rather, each out-of-state lawyer must be admitted individually for the particular case concerned. The out-of-state lawyer's certificate must be renewed (again, through a form on the Bar's web site and accompanied by a renewal fee) every twelve months. The certification process requires the out-of-state lawyer to submit to both the regulatory jurisdiction of the Oregon Supreme Court and personal jurisdiction in Oregon for any legal malpractice claims arising out of the case involved.

Second, the local counsel files a motion for admission with the court concerned attaching the certificate with the acknowledgement from the Bar. The court then makes its own determination about whether the lawyer has met the criteria of UTCR 3.170 and should be admitted. Although many such motions are granted routinely, courts can and do hold hearings on the adequacy of applications—especially when the Bar has highlighted apparent deficiencies. Other parties must be served with the motion and have standing to object. In particular, out-of-state lawyers are often surprised when the Bar notes that their insurance does not conform to the PLF because Oregon's basic coverage, in contrast to most commercial policies, does not have a deductible. Usually, this will not put the application at risk. But, *pro hac vice* motions have been denied on several