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Attorneys—Special Appearances

IP Trial Attorney Has Criminal Appeals Side Business

A client list including Bayer, Amazon and DuPont isn't what you might expect from a lawyer appointed to argue a criminal appeal before the U.S. Supreme Court.

But that's just what the high court got Aug. 11 when it appointed intellectual property litigator, Adam Mortara, a partner at Bartlit Beck Herman Palenchar & Scott LLP, Chicago, to argue a sentencing case next term (*Beckles v. United States*, 84 U.S.L.W. 3702, U.S., No. 15-8544, *review granted* 6/27/16).

But despite his high-tech specialization, it's not Mortara's first time around a criminal case.

He's been asked by the U.S. Court of Appeals for the Eleventh Circuit to argue in favor of the decision below in three previous criminal cases.

And his first step in these appointments is checking to see if he actually agrees with the position he's been asked to represent, Mortara told Bloomberg BNA Aug. 19.

''It's hard to be a good advocate unless you think that you're right,'' he said.

Of course, he said he'd still argue the position if he didn't agree with it. But, it's always nice to tell the court not only is this the position you asked me to argue, it is actually *my* position, Mortara said.

Academic Interest. Mortara's law firm biography is chock-full of intellectual property litigation, with notations like: ''Lead trial counsel for Bayer''; ''Lead trial counsel for Amazon.com''; and ''Trial counsel for DuPont.''

But he says he has an ''academic interest'' in criminal procedure and habeas corpus. So much so, that he's been teaching those subjects at the University of Chicago Law School since 2007.

That's how Mortara thinks he got his appointments from the Eleventh Circuit.

A number of his students have gone on to clerk at the appellate court, and it's likely they got his name through them, he said.

Mysterious Appointment? How Mortara got his Supreme Court appointment is a bit more of a mystery.

From time to time, the high court appoints a private attorney to argue in a case when the parties refuse to support the decision below (84 U.S.L.W. 106, 8/4/15).

Most people assume that the presiding circuit justice will appoint one of their former clerks, and Mortara's appointment fits that assumption.

He clerked for Justice Clarence Thomas, who is the circuit justice for the Eleventh Circuit, where the case originates.

But because the court doesn't explain its appointment decisions, we can only guess, Mortara said.

Clearing Conflicts. Regardless of how the appointment came about, Mortara said it was an exciting surprise.

One morning he received a call from the Supreme Court clerk's office, asking if he could clear conflicts for the matter.

That wasn't hard, he said. The parties here are the federal government and a prisoner. Mortara typically represents corporations in IP disputes.

After responding to the clerk's office, an order was released by the court shortly thereafter: ''Adam K. Mortara, Esquire, of Chicago, Illinois, is invited to brief and argue this case, as amicus curiae, in support of the judgment below on Question 2 presented by the petition.''

Breath of Fresh Air. Since then, Mortara said he's been ''blown away'' by the collegiality at the Supreme Court, where adversaries have been known to refer to each other during oral argument as ''my friend on the other side.''

Mortara acknowledged that he's up against some pretty experienced Supreme Court advocates: the U.S. Solicitor General's Office and the Office of the Federal Public Defender.

But he said both have been extremely accommodating.

For example, the parties agreed to allow Mortara to file his brief in late October, the latest possible date to hear the case in the December sitting.

That was despite the fact that the prisoner had already filed his brief.

To be sure, the federal public defenders' office probably would have liked some additional time to work on that brief, he said.

But the inability to do so didn't stop the office from agreeing to the extended briefing schedule for Mortara.

That atmosphere is ''a breath of fresh air from the trenches of district court litigation,'' he said.

When Mortara does eventually file his Supreme Court brief, it will likely have only his name on it.

He said his firm has been extremely supportive of his criminal appellate appointments.

He knew before he even asked the firm if he could accept the Supreme Court appointment that the answer would be a resounding ''yes,'' Mortara said.

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In return, he tries not to put a huge demand on the firm's resources.

In past appointments, every word of the brief has been researched and written by Mortara alone.

Extending *Johnson*? Mortara's current case concerns the application of another recent Supreme Court case, *Johnson v. United States*, 83 U.S.L.W. 4576, 2015 BL 204915 (U.S. 2015) (83 U.S.L.W. 2001, 6/30/15).

There, the Supreme Court struck down the ''residual clause'' of the Armed Career Criminal Act because it was too vague.

The prisoner here wants the court to extend that ruling to an identically worded clause in the U.S. Sentencing Guidelines (84 U.S.L.W. 1945, 6/30/16).

But the Eleventh Circuit below said *Johnson* didn't apply to the guidelines.

The vagueness doctrine used to strike down the clause in *Johnson* only applies ''to laws that prohibit conduct and fix punishments, not advisory guidelines,'' the Eleventh Circuit explained in a similar case, *United States v. Matchett*, 802 F.3d 1185 (11th Cir. 2015).

But not all courts agree—there is a circuit split on the issue.

And in this case, both parties disagree with the decision below.

The U.S. said in its petition opposing high court review that it agreed with the prisoner, that the clause in the guidelines is unconstitutionally vague based on *Johnson*.

So that leaves Mortara to argue that the guidelines aren't unconstitutionally vague when he takes the lectern for the first time at the Supreme Court.

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