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## Implied Obviousness: Reevaluating the Jury's Role in Nonobviousness after Kinetic Concepts

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# Implied Obviousness: Reevaluating the Jury's Role in Nonobviousness after *Kinetic Concepts*

## ABSTRACT

*Nonobviousness is a central patentability requirement, requiring that a person with ordinary skill would not have found the patented subject matter obvious. Due to its flexibility, obviousness is the most commonly litigated requirement. It is thus crucial that the US judicial system determine obviousness uniformly, predictably, and accurately. However, because nonobviousness is a mixed question of law and fact, it is often unclear how much control the judge and jury have over the ultimate conclusion. In Kinetic Concepts v. Smith & Nephew, the United States Court of Appeals for the Federal Circuit increased the jury's role in the obviousness determination, arguably introducing more uncertainty and inaccuracy. By applying the Supreme Court's framework from Markman v. Westview Instruments, this Note investigates the prudence of this expansion of the jury's influence. Ultimately, this Note proposes that the Federal Circuit require a prescribed special-verdict form that asks the jury to determine the underlying factual questions in the obviousness question while leaving the ultimate legal conclusion to the judge. Such a form addresses many of the concerns with Kinetic Concepts raised under the Markman framework.*

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Patent litigation is sharply on the rise.<sup>1</sup> In 2011, litigants filed a record four-thousand US patent actions—22 percent more than in 2010, and a staggering 400 percent more than in 1991.<sup>2</sup> Damages are growing as well; the three largest US jury verdicts of 2012 were patent infringement cases, each resulting in awards of at least \$1 billion.<sup>3</sup> The burgeoning litigation and rising damages mirror the increasing value of patents in the US economy.<sup>4</sup> As patents gain value and litigation becomes more prevalent, it is increasingly important to have an accurate, predictable, and uniform method of settling patent disputes.<sup>5</sup> A recent decision out of the US Court of Appeals for the Federal Circuit threatens to reduce the efficacy of patent litigation by disrupting the balance of the judge's and jury's roles in resolving such disputes.<sup>6</sup>

The percentage of patent cases that jury trials resolve has increased over the last few decades—from 14 percent in the 1980s to

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1. CHRIS BARRY ET AL., PRICEWATERHOUSECOOPERS, 2012 PATENT LITIGATION STUDY 6 chart1 (2012).

2. *Id.*

3. See Margaret Cronin Fisk, *Patent Trial Awards Soar With Some Big Ones Cut By Judges*, BLOOMBERG TECH. (Jan. 18, 2013, 12:00 AM), <http://www.bloomberg.com/news/2013-01-18/patent-trial-awards-soar-with-some-big-ones-cut-by-judges.html>.

4. *See id.*

5. *See infra* Part I.C.

6. *See infra* Part II.A.

55 percent in the 2000s.<sup>7</sup> As juries became the preferred fact-finder in patent cases, commentators began to question their ability to handle the complex legal and factual issues in high-stakes patent cases.<sup>8</sup>

A defendant in a patent case can escape infringement entirely by proving that the patent's subject matter fails to meet the nonobviousness requirement.<sup>9</sup> "Obviousness" is the most commonly asserted affirmative defense to patent infringement, and it became more powerful after the Supreme Court's decision in *KSR International Co. v. Teleflex, Inc.*, which arguably expanded the scope of obviousness in the patent context.<sup>10</sup> Determining obviousness is a legal question with several underlying factual inquiries.<sup>11</sup> Because of these overlapping factual and legal questions, scholars have heavily disputed the jury's role in resolving this issue.<sup>12</sup> The Federal Circuit's recent case *Kinetic Concepts v. Smith & Nephew* controversially increased the jury's role in the obviousness determination.<sup>13</sup> In that case, the court held that judges must defer to juries' implied findings of fact in determining obviousness.<sup>14</sup>

This Note reevaluates the jury's role in nonobviousness in light of the Federal Circuit's holding and proposes a prescribed special-verdict form for obviousness that appropriately balances the roles of judge and jury.<sup>15</sup> Part I introduces the background of the nonobviousness requirement and discusses the roles of judge and jury in patent law, including the types of questions relegated to the different judicial actors.<sup>16</sup> It explores the Supreme Court's ruling on claim construction in *Markman v. Westview Instruments, Inc.* as a framework for evaluating the jury's role in nonobviousness.<sup>17</sup> It also reviews the recent developments in *Kinetic Concepts*.<sup>18</sup>

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7. BARRY, *supra* note 1, at 9 chart3a.

8. See, e.g., Michael A. Sartori, *An Economic Incentives Analysis of the Jury's Role in Patent Litigation*, 79 J. PAT. & TRADEMARK OFF. SOC'Y 331, 332 (1997); Philippe Signore, *On the Role of Juries in Patent Litigation*, 83 J. PAT. & TRADEMARK OFF. SOC'Y 791, 795–97 (2001).

9. See *infra* Part I.A.

10. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007); see John R. Allison & Mark A. Lemley, *Empirical Evidence on the Validity of Litigated Patents*, 26 AIPLA Q.J. 185, 208–10 (1998).

11. See *infra* Part I.A.

12. See *infra* Part I.E.

13. *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342 (Fed. Cir. 2012); see Dennis Crouch, *Who Decides Obviousness: Judge or Jury?*, PATENTLY-O (Sept. 17, 2012, 12:02 PM), <http://www.patentlyo.com/patent/2012/09/who-decides-obviousness-judge-or-jury.html>; *infra* Part II.

14. See *infra* Part I.F.

15. See *infra* Parts I–IV.

16. See *infra* Part I.

17. See *infra* Part I.D.2.

18. See *infra* Part I.F.

Part II analyzes the Federal Circuit's reasoning in *Kinetic Concepts* and reevaluates the jury's role in nonobviousness in light of the comparative advantages of judges and juries in patent law. Applying the Supreme Court's *Markman* framework, this Note argues that functional and policy concerns render the Federal Circuit's expansion of the jury's role in obviousness imprudent.<sup>19</sup> Part III proposes a prescribed special-verdict form for obviousness that strikes the appropriate balance between the two judicial actors, alleviating the accuracy and predictability concerns inherent in the *Kinetic Concepts* approach.

## I. NONOBVIOUSNESS AND THE TRADITIONAL ROLES OF JUDGE AND JURY IN PATENT LITIGATION

Nonobviousness is a central requirement of patentability, intended to limit the grant of patent rights to inventions that would not arise without the patent incentive.<sup>20</sup> Even if an invention is novel, useful, and meets all other patentability standards, obviousness could render a patent invalid.<sup>21</sup> Because of the relative ease of asserting an obviousness defense, the obviousness question is the most commonly contested validity issue in infringement litigation.<sup>22</sup> Thus, which judicial actor determines the obviousness question plays an important role in the outcome and resulting appellate review of a case.<sup>23</sup>

### A. History of the Nonobviousness Requirement

In 1850 the Supreme Court established a nonobviousness requirement for patents in *Hotchkiss v. Greenwood*, holding that claimed subject matter must require more ingenuity than that of an "ordinary mechanic."<sup>24</sup> Congress codified the requirement in section 103 of the Patent Act of 1952, which states that an inventor may not obtain a patent if the difference between the claimed invention and the state of the art "would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art."<sup>25</sup>

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19. See *infra* Part II.

20. See *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 11 (1966).

21. See COMPLEX LITIG. COMM. OF THE AM. COLL. OF TRIAL LAWYERS, FED. JUDICIAL CTR., ANATOMY OF A PATENT CASE 45 (2009).

22. See Allison & Lemley, *supra* note 10, at 208–09; *infra* Part I.B.

23. See Rishi S. Suthar, Note, *What Jury? A New Approach to Obviousness After KSR v. Teleflex*, 18 J. INTELL. PROP. L. 295, 303–04 (2010).

24. *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248, 252–53 (1850).

25. 35 U.S.C. § 103 (2012).

The Supreme Court addressed the nonobviousness requirement again fourteen years later in *Graham v. John Deere Company of Kansas City*, setting out a framework for the application of section 103 in light of *Hotchkiss*.<sup>26</sup> In *Graham*, the patentee successfully sued John Deere for infringing his patent on an improved plow design, but the Eighth Circuit reversed.<sup>27</sup> Affirming the Eighth Circuit's determination that the patent was obvious, the Supreme Court defined the "*Graham* factors"—a series of inquiries against which obviousness is evaluated—as follows: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations.<sup>28</sup> Secondary considerations are indicia of obviousness that include "commercial success, long felt but unsolved needs, [and] failure of others."<sup>29</sup>

### *B. The Nonobviousness Requirement in Patent Litigation*

In patent litigation, courts presume that issued patents are valid.<sup>30</sup> While an examiner at the US Patent and Trademark Office determines validity during the prosecution process, accused infringers often challenge validity as an affirmative defense during trial.<sup>31</sup> In doing so, defendants can claim a lack of patentable subject matter, novelty, nonobviousness, utility, enablement, and other patentability requirements.<sup>32</sup> For example, if the defendant can prove that the claimed invention lacked novelty (i.e., it was patented or described in "prior art" such as other patents or publications in the field), the patent is invalid.<sup>33</sup>

Out of all of the affirmative defenses available in infringement cases, defendants most commonly assert invalidity due to obviousness.<sup>34</sup> Even if the prior art does not affect the novelty of the claims, the defendant may establish invalidity by showing that a person having ordinary skill in the art (PHOSITA) would have found the claimed invention obvious in view of the prior art.<sup>35</sup> Obviousness

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26. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 15, 17 (1966); *Hotchkiss*, 52 U.S. (11 How.) at 252–53.

27. *Graham*, 383 U.S. at 4.

28. *Id.* at 17–18.

29. *Id.*

30. See 35 U.S.C. § 282(a) (2012).

31. See COMPLEX LITIG. COMM., *supra* note 21, at 2, 43–45.

32. See *id.* at 43–45.

33. See *id.* at 44.

34. See Allison & Lemley, *supra* note 10, at 210.

35. See COMPLEX LITIG. COMM., *supra* note 21, at 45.

is more hotly contested than novelty because it presents more flexibility: whereas an invention lacks novelty only if all of the limitations of a claim are present in a single prior art reference,<sup>36</sup> an invention is unpatentable due to nonobviousness if the limitations of the claim are obvious from a *combination* of prior art references.<sup>37</sup>

Consider a simple example: in order to show that a patent claiming a Swiss army knife including three limitations—a corkscrew, a bottle opener, and a pair of scissors—lacks novelty, a defendant would have to find a single piece of prior art that explicitly or implicitly provides all three elements.<sup>38</sup> In contrast, three separate prior art references—disclosing a Swiss army knife with a corkscrew, a bottle opener, and a pair of scissors, respectively—could be combined to prove the patent is obvious.<sup>39</sup> Subject to certain restrictions, if a PHOSITA would have found the Swiss army knife claim obvious in light of the combined references, the patent is invalid due to obviousness.<sup>40</sup> While such a simplified example makes the nonobviousness requirement seem trivial, it plays an important role.<sup>41</sup>

### C. Policy Goals of the Nonobviousness Requirement

The US Constitution justifies the patent system as “promot[ing] the Progress of Science and useful Arts.”<sup>42</sup> By offering inventors a limited right to exclude others from making, using, or selling their invention, the patent system seeks to promote innovation and public disclosure of new inventions.<sup>43</sup> However, due to the gravity of such a powerful right to exclude, the patentability requirements

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36. See *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000) (“Accordingly, invalidity by anticipation requires that the four corners of a single, prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation.”).

37. See *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416–18 (2007) (discussing obviousness and cases where familiar elements were combined in obvious and nonobvious ways).

38. See *COMPLEX LITIG. COMM.*, *supra* note 21, at 44.

39. See *Teleflex*, 550 U.S. at 415–16.

40. *Id.* at 415–17. The analogous-art doctrine limits the universe of prior art that a PHOSITA would consider references that are in the same field of endeavor, or if not in the same field, that are “reasonably pertinent” to the particular problem the inventor is trying to solve. See *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004) (finding toothbrush art analogous to a hairbrush). Furthermore, there must be an indication that a PHOSITA would consider the references together, although this requirement is less restrictive following the Supreme Court’s recent expansion of the PHOSITA’s creativity in combining prior art in *KSR Int’l Co. v. Teleflex, Inc.* See *Teleflex*, 550 U.S. at 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

41. See *infra* Part I.C.

42. U.S. CONST. art I, § 8, cl. 8.

43. CRAIG ALLEN NARD, *THE LAW OF PATENTS* 3 (2d ed. 2011).

carefully limit the grant of patents.<sup>44</sup> Otherwise, excessive amounts of obvious patents could stifle innovation and create a “thicket” of insignificant patents that are expensive to search and license.<sup>45</sup>

The obviousness requirement serves as a gatekeeping function in patent law, allowing patents only for “those inventions which would not be disclosed or devised but for the inducement of a patent.”<sup>46</sup> Scholars describe it as creating a “patent-free zone” around the state of the art, disallowing inventors to obtain patents by merely substituting materials, streamlining processes, or making small improvements.<sup>47</sup> Furthermore, the requirement serves to prevent patenting of inventions that are within a PHOSITA’s technical grasp.<sup>48</sup> Additional policy goals of uniformity, definiteness, and predictability play an important role in how judges decide cases dealing with nonobviousness.<sup>49</sup>

#### *D. Judges and Juries in Patent Law*

In patent law, as in most legal areas, juries generally resolve issues of fact and judges resolve issues of law.<sup>50</sup> But the line between questions of law and questions of fact is blurry and often shifts.<sup>51</sup> Generally, issues of fact include determining credibility, weighing evidence, or drawing inferences from the evidence.<sup>52</sup> Questions of law involve the application of general principles or rules to facts.<sup>53</sup> In

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44. See 35 U.S.C. §§ 101–103 (2012).

45. See FED. TRADE COMM’N, TO PROMOTE INNOVATION: THE PROPER BALANCE OF COMPETITION AND PATENT LAW AND POLICY 3, 7 (Oct. 2003) [hereinafter FED. TRADE COMM’N, TO PROMOTE INNOVATION], available at <http://www.ftc.gov/sites/default/files/documents/reports/promote-innovation-proper-balance-competition-and-patent-law-and-policy/innovationrpt.pdf>.

46. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 11 (1966).

47. See FED. TRADE COMM’N, TO PROMOTE INNOVATION, *supra* note 45, at 3.

48. See *id.*

49. See *Suthar*, *supra* note 23, at 312; see also *Graham*, 383 U.S. at 18.

50. See *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384 (1996) (describing questions of fact for the jury and questions of law for the judge in patent law). Exceptions to this rule exist. See, e.g., *Gen. Electro Music Corp. v. Samick Music Corp.*, 19 F.3d 1405, 1408 (Fed. Cir. 1994). For example, the inequitable conduct defense involves questions of fact but is an equitable determination reserved for the judge. *Id.* Issues of equity have always been handled by judges, dating back to the pre-Constitution era and the historically separate courts of equity. See Edward E. Erickson, *The Right to a Jury Trial in Equitable Cases*, 69 N.D. L. REV. 559, 560 (1993). Additionally, when neither party requests a jury, judges often hold bench trials, where the judge serves as the fact-finder in addition to his usual roles. See FED. R. CIV. P. 39(b).

51. See *Signore*, *supra* note 8, at 798–99.

52. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986) (“Credibility determinations, the weighing of the evidence, and the drawing of legitimate inferences from the facts are jury functions, not those of a judge, whether he is ruling on a motion for summary judgment or for a directed verdict.”).

53. *Signore*, *supra* note 8, at 798–99.



reality, many issues are a mix of factual and legal inquiries.<sup>54</sup> For example, obviousness is a legal determination with underlying questions of fact.<sup>55</sup>

Juries play an important role in patent law.<sup>56</sup> In a patent jury trial, a jury may decide anything from broad questions of novelty or utility to narrow questions of fact relevant to obviousness, enablement, or prior use.<sup>57</sup> Infringement is nearly always a question of fact for the jury, as is the amount of damages.<sup>58</sup> Even issues that are technically reserved for the judge (such as enablement, obviousness, equivalency, and inequitable conduct) often involve underlying questions of fact for the jury.<sup>59</sup>

The US patent system is unique in its use of juries in patent disputes.<sup>60</sup> The United Kingdom and France have specialized patent courts that never involve juries.<sup>61</sup> Germany and Japan split patent cases between specialized patent courts and regular civil courts, neither of which impanel juries.<sup>62</sup> In fact, Canada, one of the few countries other than the United States to occasionally use juries in civil cases, does not allow them in patent cases.<sup>63</sup>

### 1. Mixed Questions of Law and Fact: Advisory Verdicts, Special Verdicts, and General Verdicts with Interrogatories

Mixed questions of law and fact present an uncomfortable gray area between the established roles of the judge and jury.<sup>64</sup> Courts

54. *Id.*; see *infra* Part I.D.1.

55. Signore, *supra* note 8, at 804.

56. *See id.* at 794.

57. *See id.* at 800–05.

58. *Id.* at 805, 809.

59. *See id.* at 801–08. Judges generally submit underlying questions of fact to the jury through the use of special-verdict forms. *See infra* Part I.D.1.

60. *See* Signore, *supra* note 8, at 794.

61. *See* John B. Pegram, *Should There Be a U.S. Trial Court with a Specialization in Patent Litigation?*, 82 J. PAT. & TRADEMARK OFF. SOC'Y 766, 774 (2000); Signore, *supra* note 8, at 794.

62. *See* Signore, *supra* note 8, at 794–95.

63. *See* *Realsearch Inc. v. Valone Kone Brunette Ltd.*, [2003] 4 F.C. 1012, ¶ 6–7 (Can.) (discussing the jury system in US patent law and applying it to the judge-only system in Canadian patent law); Jason M. Solomon, *The Political Puzzle of the Civil Jury*, 61 EMORY L.J. 1331, 1336 (2012) (“The United States is currently the only country that uses a jury in a large number of civil cases . . .”); *see also* W. A. Bogart, “Guardian of Civil Rights . . . Medieval Relic”: *The Civil Jury in Canada*, 62 LAW & CONTEMP. PROBS. 305, 305 (1999) (discussing the relatively rare use of civil juries in Canada).

64. *See* Signore, *supra* note 8, at 799.

have several tools to navigate this balance, including advisory verdicts, special verdicts, and general verdicts with interrogatories.<sup>65</sup>

Advisory verdicts are nonbinding questions to the jury in the form of a general- or special-verdict form.<sup>66</sup> They provide the judge with advisory findings but reserve the judge's discretion to independently analyze the issue.<sup>67</sup> Federal Rule of Civil Procedure 39(c)(1) limits advisory verdicts to cases not usually triable before a jury, however.<sup>68</sup> The Federal Circuit has authorized the use of advisory verdicts for the ensnarement defense but rejected their use for nonobviousness determinations because it is an issue triable by jury.<sup>69</sup>

Special verdicts allow judges to limit the role of the jury by submitting only specific facts instead of a general verdict—for example, by asking specific questions about the patent, the accused product, and prior art, but not whether the patent is obvious.<sup>70</sup> The judge applies the law to the jury's factual findings and renders a verdict.<sup>71</sup> Courts and scholars have lauded this verdict form as one that compels detailed consideration of the issues while promoting transparency—both to the parties and appellate courts.<sup>72</sup> The Federal Circuit endorsed the special-verdict form in patent law as a particularly useful tool because of the “nuances of patent law combined with the added complications of technology.”<sup>73</sup> In the nonobviousness context, a special-verdict form could limit jury findings to the *Graham* factors and secondary considerations while reserving the ultimate obviousness question for the judge.<sup>74</sup>

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65. *E.g.*, FED. R. CIV. P. 39(c) (allowing for advisory juries); FED. R. CIV. P. 49(a) (allowing for special verdicts); FED. R. CIV. P. 49(b) (allowing for general verdict with special interrogatories).

66. *See* FED. R. CIV. P. 39(c); *see also* *Frostie Co. v. Dr. Pepper Co.*, 361 F.2d 124, 126 (5th Cir. 1966) (“An advisory jury does no more than advise the judge; the ultimate responsibility for finding the facts remains with the court.”).

67. *See Frostie*, 361 F.2d at 126; *Mitchell v. Visser*, 529 F. Supp. 1034, 1036 (D. Kan. 1981) (“When an advisory jury is used, the ultimate responsibility for findings of fact and conclusions of law remains with the district court.”); *cf.* *Suthar*, *supra* note 23, at 320 (proposing that “juries remain in patent cases but render opinions on certain matters, particularly obviousness, in a solely advisory capacity”).

68. FED. R. CIV. P. 39(c)(1).

69. *See Suthar*, *supra* note 23, at 301–02, 321–22. The ensnarement defense “bars a patentee from asserting a scope of equivalency that would encompass . . . the prior art.” *See id.* at 321 (quoting *Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1322 (Fed. Cir. 2009)).

70. *See Signore*, *supra* note 8, at 815–16.

71. *See* FED. R. CIV. P. 49(a); *Signore*, *supra* note 8, at 815.

72. *See Richardson-Vicks Inc. v. Upjohn Co.*, 122 F.3d 1476, 1485 (Fed. Cir. 1997) (citing *Edson R. Sunderland, Verdicts, General and Special*, 29 YALE L.J. 253, 259 (1920)).

73. *Id.*

74. *See Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966).

The third approach available to courts is a general verdict accompanied by interrogatories—questions on specific issues of fact.<sup>75</sup> Considering nonobviousness, a jury could render a general verdict on whether the claimed invention was obvious and additionally answer interrogatories related to the *Graham* factors.<sup>76</sup> If the jury's factual determinations are consistent with the general verdict, the judge must approve the verdict, but if the jury's verdict is inconsistent with the answers or the answers are inconsistent with each other, the judge may (1) enter a judgment based on the interrogatories, (2) direct the jury to further consider the answers or verdict, or (3) order a new trial.<sup>77</sup>

The choice of verdict form not only affects the balance between the judge and jury, but also the standard of review on appeal.<sup>78</sup> Appellate courts review juries' findings of fact for "substantial evidence."<sup>79</sup> Under this highly deferential standard, a judge must affirm a jury's conclusion if "such relevant evidence as a reasonable mind might accept as adequate" supports it.<sup>80</sup> In contrast, appellate courts review judges' findings of fact under the less deferential "clearly erroneous" standard—upholding findings when "the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed."<sup>81</sup>

## 2. Claim Construction and *Markman*

Congress created the Federal Circuit in 1982 with the purported goal of creating "nationwide uniformity" in patent law.<sup>82</sup> Accordingly, it has sought to define the role of the judge and jury in patent cases.<sup>83</sup> So far, the Federal Circuit has labeled many of the most important issues in patent litigation as questions of law for the judge, including claim interpretation and the ultimate determination

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75. See FED. R. CIV. P. 49(b).

76. See *Graham*, 383 U.S. at 17–18.

77. See FED. R. CIV. P. 49(b).

78. *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 719 (Fed. Cir. 1984).

79. *Id.*

80. *Consol. Edison Co. of New York v. NLRB.*, 305 U.S. 197, 229 (1938).

81. *SSIH Equip. S.A. v. U.S. Int'l Trade Comm'n*, 718 F.2d 365, 381 (Fed. Cir. 1983) (quoting *United States v. United States Gypsum Co.*, 333 U.S. 364, 395 (1948)); see FED. R. CIV. P. 52(a)(6).

82. Larry D. Thompson, Jr., *Adrift on a Sea of Uncertainty: Preserving Uniformity in Patent Law Post-Vornado Through Deference to the Federal Circuit*, 92 GEO. L.J. 523, 529–30 (2004).

83. See Signore, *supra* note 8, at 799.

of validity.<sup>84</sup> At first glance, this may seem to conflict with the Seventh Amendment right to a jury trial.<sup>85</sup> Yet the complexity exception, despite its controversy, justifies the reduced role of the jury in patent litigation.<sup>86</sup>

The complexity exception denies parties the opportunity to have a jury trial when a jury would be ineffective because of the length of the trial, the complexity of the facts, or the complexity of the legal issues.<sup>87</sup> The exception originated in a footnote to *Ross v. Bernhard*, in which the Supreme Court suggested that the “practical abilities and limitations of juries” should be considered in order to determine whether an issue warrants a Seventh Amendment right to a jury trial.<sup>88</sup> While some argue that the Supreme Court has since limited that language, the Court appeared to confirm its applicability to patent law in the landmark case, *Markman v. Westview Industries, Inc.*<sup>89</sup>

In *Markman*, petitioner Markman sued Westview Instruments for infringement of his patent for a system that tracks clothing through a dry-cleaning process.<sup>90</sup> Although the jury found that Westview infringed, the district court directed a verdict for Westview based on the legal construction of the term “inventory.”<sup>91</sup> Affirming the Federal Circuit, the Supreme Court confirmed the right to a jury trial in patent infringement cases but noted that particular issues within a jury trial may be more appropriate for the judge.<sup>92</sup> To

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84. See, e.g., *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390–91 (1996); Signore, *supra* note 8, at 811.

85. See U.S. CONST. amend. VII.

86. See Jennifer F. Miller, Note, *Should Juries Hear Complex Patent Cases?*, 2004 DUKE L. & TECH. REV. 4, 10 (2004).

87. See *id.*

88. *Ross v. Bernhard*, 396 U.S. 531, 538 n.10 (1970).

89. See *Markman v. Westview Indus., Inc.*, 517 U.S. 370, 388–90 (1996). *But see* *Tull v. United States*, 481 U.S. 412, 417–18 n.4 (1987) (noting that the Court has considered the practical limitations of a jury in administrative proceedings, but “has not used these considerations as an independent basis for extending the right to a jury trial under the Seventh Amendment”); Deborah M. Altman, Comment, *Defining the Role of the Jury in Patent Litigation: The Court Takes Inventory*, 35 DUQ. L. REV. 699, 706 (1997) (“In *Tull v. United States*, the Court noted that an inquiry into the ‘practical abilities and limitations of juries’ should be made only when considering the applicability of the Seventh Amendment to administrative law courts.”).

90. See *Markman*, 517 U.S. at 374.

91. See *id.* at 375. The issue in *Markman* concerned whether a patent for a dry cleaning “Inventory Control and Reporting System” was infringed by Westview’s system that only recorded invoices and transactions, not physical articles of clothing. *Id.* at 374–75. Under the district court’s construction of “inventory” as “both cash inventory and the actual *physical inventory of articles of clothing*,” Westview’s system did not infringe because it was not capable of tracking particular articles of clothing throughout the dry cleaning process. *Id.* at 375 (emphasis added).

92. See *id.* at 377, 388–89.

determine whether a particular issue is committed to the province of a jury by the Seventh Amendment, the Court first endorsed a “historical method” test, asking whether the issue “was tried at law at the time of the founding or is at least analogous to one that was.”<sup>93</sup> Finding no evidence of an analogue to claim construction in historical sources, the Court turned to functional and policy considerations.<sup>94</sup>

In determining which judicial actor is “better positioned than another” to decide an issue, the *Markman* Court considered the relative skills of judges and juries.<sup>95</sup> Evaluating claim construction, the Court reasoned that judges often construe written documents and are therefore well-equipped to interpret claim language.<sup>96</sup> It noted the highly technical nature of patent claims and reasoned that a judge’s training and discipline makes her better suited than a jury to address these issues.<sup>97</sup> Thus, notwithstanding the factual underpinnings, the Court found that judges are the preferred judicial actor to construe claims.<sup>98</sup>

Finally, the Court turned to the policy implications of assigning claim construction to the different judicial actors.<sup>99</sup> It stressed the importance of uniformity and consistency in order to avoid a “zone of uncertainty,” which would discourage innovation and deprive the public of rights without clear boundaries.<sup>100</sup> Uniformity would be ill-served by allowing juries to construe documents; in contrast, *stare decisis* would promote intrajurisdictional certainty by requiring conformity with judges’ prior interpretive efforts.<sup>101</sup> Applying functional and policy considerations, the Court affirmed the Federal Circuit’s holding that claim construction is an issue for a judge, not a jury.<sup>102</sup>

The Supreme Court’s holding in *Markman* profoundly affected patent law, giving rise to “*Markman* hearings”—proceedings in which judges construe the patent claims at issue.<sup>103</sup> Because infringement

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93. *Id.* at 376; see also U.S. CONST. amend. VII, (“In suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any court of the United States, than according to the rules of the common law.”).

94. *Id.* at 388–90.

95. See *id.* at 384, 388.

96. See *id.* at 388–89.

97. See *id.*

98. See *id.* at 390.

99. See *id.* at 390–91.

100. *Id.* at 390.

101. See *id.* at 391.

102. *Id.* at 388–91.

103. See Frank M. Gasparo, Comment, *Markman v. Westview Instruments, Inc. and its Procedural Shock Wave: The Markman Hearing*, 5 J.L. & POL’Y 723, 723–25 (1997) (“[M]any

depends on the scope of the claims, many cases are won or lost at *Markman* hearings.<sup>104</sup> These hearings often lead to summary judgment motions, interlocutory appeals, or settlement.<sup>105</sup>

### *E. The Jury's Role in Determining Nonobviousness*

Jurists have long disputed the jury's role in determining nonobviousness.<sup>106</sup> Before the Federal Circuit was formed, circuit courts split on whether the jury could decide the ultimate question of nonobviousness.<sup>107</sup> For example, the United States Court of Appeals for the Ninth Circuit considered a jury's obviousness determination advisory.<sup>108</sup> The United States Court of Appeals for the Tenth Circuit considered obviousness a complete question of fact for the jury.<sup>109</sup> Explicitly rejecting a general obviousness verdict for the jury, the United States Court of Appeals for the Seventh Circuit mandated that the jury must decide the *Graham* factors and reserved the final determination of obviousness for the judge.<sup>110</sup>

The Federal Circuit has since adopted a hybrid approach, considering the nonobviousness determination a mixed question of law and fact.<sup>111</sup> Accordingly, where district courts used the jury in an advisory capacity, the Federal Circuit held that the jury may make the final obviousness determination.<sup>112</sup> As judges have broad discretion over the jury form, no universal approach has surfaced for submitting

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district courts have employed a new procedural step which has become known as a 'Markman Trial.'").

104. See Colman B. Ragan, *Saving the Lives of Drugs: Why Procedural Amendments in Hatch-Waxman Litigation and Certification of Markman Hearings for Interlocutory Appeal Will Help Lower Drug Prices*, 13 FED. CIR. B.J. 411, 414 (2004); see also NARD, *supra* note 43, at 448 ("Given the determinative nature of claim construction, most courts opt to hold a pre-trial *Markman* hearing, typically followed by the 'winning' party filing summary judgment motions on validity and/or infringement.").

105. See Gasparo, *supra* note 103, at 726.

106. See Suthar, *supra* note 23, at 303.

107. See *id.* at 300–01.

108. See *Sarkisian v. Winn-Proof Corp.*, 688 F.2d 647, 651 (9th Cir. 1982) (en banc).

109. See *Norfin Inc. v. Int'l Bus. Machs. Corp.*, 625 F.2d 357, 365 (10th Cir. 1980).

110. See *Roberts v. Sears, Roebuck & Co.*, 723 F.2d 1324, 1343 (7th Cir. 1983).

111. See John Guo, Comment, *Special Verdicts: An Obvious Trial Procedure for Determining Obviousness in Patent Litigation*, 40 SW. L. REV. 513, 521 (2011).

112. See *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1547 (Fed. Cir. 1983) ("We hold that it is not error to submit the question of obviousness to the jury."); see also *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1237–38 (Fed. Cir. 1989) (upholding a jury's obviousness decision even though the judge mistakenly presented the obviousness issue to the jury in an advisory capacity).

obviousness to the jury.<sup>113</sup> Despite a few strong dissents in the Federal Circuit, the Supreme Court has yet to definitively rule on the implications of submitting the obviousness question to the jury.<sup>114</sup>

#### F. Kinetic Concepts: *Recent Developments in Nonobviousness*

The most recent development in the jury's role in nonobviousness is the Federal Circuit case *Kinetic Concepts v. Smith & Nephew*.<sup>115</sup> The suit involved two patents for methods and apparatuses for closing gaping wounds by applying "Negative Pressure Wound Therapy," i.e., suction.<sup>116</sup> Wake Forest University (the owner of the asserted patents) and Kinetic Concepts, Inc. (the exclusive licensee) brought an infringement suit against Smith & Nephew (S&N), alleging that S&N's upcoming product infringed.<sup>117</sup>

The primary issue in *Kinetic Concepts* was obviousness.<sup>118</sup> After the district court conducted a *Markman* hearing, the case proceeded to a jury trial.<sup>119</sup> S&N claimed invalidity as a defense, asserting that the inventions were obvious in light of prior art disclosing suction-based healing of fistulae and pus pockets.<sup>120</sup> At the end of trial, a dispute arose about the form and content of the jury instructions.<sup>121</sup> S&N wanted to submit a special-verdict form, asking the jury to make findings regarding the *Graham* factors but reserving the obviousness determination for the judge.<sup>122</sup> Kinetic Concepts colorfully claimed this was "one of the worst ideas of all time."<sup>123</sup> After

113. *R.R. Dynamics v. A. Stucki Co.*, 727 F.2d 1506, 1515 (Fed. Cir. 1984) (holding in the context of nonobviousness that district courts have broad authority and discretion in determining the form by which juries return verdicts).

114. *See McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1358 (Fed. Cir. 2001) (Michel, J., dissenting) (lamenting the common practice of allowing juries to render general verdicts on nonobviousness); Guo, *supra* note 111, at 517 ("Since the Supreme Court has not ruled on this issue, the jury's role in determining obviousness remains a highly contentious issue."). Furthermore, the Supreme Court has had a penchant for patent cases recently, and has reversed the Federal Circuit several times on a number of important issues. *See, e.g.*, *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060, 2070–71 (2011) (rejecting the Federal Circuit's standard for the knowledge requirement of induced infringement); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 407, 414–422 (2007) (rejecting the Federal Circuit's test for combining prior art references for nonobviousness).

115. *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342 (Fed. Cir. 2012).

116. *See id.* at 1351. The patented therapy was aimed at a problem inherent in stitches and other common wound treatments: tissue tears due to localized tension. *Id.* at 1346.

117. *See id.*

118. *See id.*

119. *Id.* at 1352.

120. *See id.* at 1351–52.

121. *See id.* at 1352.

122. *See id.*; *supra* Part I.D.1.

123. *Kinetic Concepts*, 688 F.3d at 1353.

extensive discussions, the judge crafted a final-verdict form, consisting of yes-or-no questions regarding some of the *Graham* factors, a chart pertaining to whether secondary considerations were present, and the ultimate question of obviousness.<sup>124</sup> Despite submitting the obviousness question to the jury, the judge stressed that the jury's final determination would be "advisory."<sup>125</sup>

After deliberation, the jury determined that (1) there were other differences between the claims and the prior art in addition to those listed, (2) most of the objective considerations favoring nonobvious were present, (3) infringement was proven, and (4) the patents were nonobvious.<sup>126</sup> S&N moved for judgment as a matter of law (JMOL), arguing that substantial evidence did not support the jury's finding of nonobviousness.<sup>127</sup> In granting the motion, the district court gave the jury's nonobviousness determination no deference.<sup>128</sup>

Wake Forest timely appealed to the Federal Circuit, which reversed the JMOL.<sup>129</sup> It first noted that in reviewing obviousness, the appellate court must presume that the jury resolved the underlying factual disputes in favor of the verdict, "leave those presumed findings undisturbed if . . . supported by substantial evidence," and then examine the district court's legal conclusion of obviousness de novo.<sup>130</sup> The appellate court then rejected S&N's claim that the "advisory" status of the jury affected the presumed factual findings, holding instead that "advisory" simply meant that the jury resolved a legal issue for the court.<sup>131</sup> It reasoned that this is a permissible expansion of the jury's role because the judge remains the ultimate arbiter of obviousness through the jury's legal instructions and the consideration of motions for a judgment notwithstanding the verdict or new trial.<sup>132</sup>

The Federal Circuit then applied the jury's obviousness conclusion to the *Graham* framework to determine whether the jury's explicit and implicit findings of fact with respect to each factor were supported by substantial evidence.<sup>133</sup> For the first factor—scope and content of the prior art—the court considered the three prior art

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124. See *id.* at 1354.

125. See *id.* at 1357.

126. See *id.* at 1354.

127. See *id.* at 1355.

128. See *id.* at 1356.

129. *Id.* at 1356, 1371.

130. See *id.* at 1356–57 (citing *Jurgens v. McKasy*, 927 F.2d 1552, 1557 (Fed. Cir. 1991)).

131. See *id.* at 1357–59.

132. See *id.* at 1358–59.

133. See *id.* at 1360–71; *supra* Part I.A (discussing the *Graham* factors).



references presented to the jury and substantial amounts of conflicting expert testimony.<sup>134</sup> Based on the jury's determination that S&N failed to prove obviousness, the court inferred that the jury must have found Wake Forest's experts more credible and persuasive on each reference.<sup>135</sup> The court concluded that this constituted substantial evidence that each reference's scope should be construed in Wake Forest's favor.<sup>136</sup>

Regarding the second factor—the level of ordinary skill in the art—the court assumed that the jury must have adopted a PHOSITA with a lower level of skill because a “less sophisticated level of skill generally favors a determination of nonobviousness.”<sup>137</sup> Again, this specific inference was based solely on the jury's ultimate conclusion of nonobviousness.<sup>138</sup> Considering the third factor—the differences between the claimed invention and the prior art—the court upheld the jury's specific findings and implied that they found no reason to combine the prior art references.<sup>139</sup> Finally, it determined that no implied findings of fact were necessary for secondary considerations, as the jury's specific findings were supported by substantial evidence.<sup>140</sup>

Having gathered the jury's explicit and implicit findings, the court reexamined the ultimate nonobviousness conclusion *de novo*.<sup>141</sup> Based on the implied and explicit findings, the court held that district court erred in granting the JMOL because S&N did not prove that the claims were obvious.<sup>142</sup> Accordingly, it reversed and remanded the case to the lower court.<sup>143</sup>

## II. THE JURY'S ROLE IN NONOBVIOUSNESS AFTER *KINETIC CONCEPTS*

The Federal Circuit's ruling in *Kinetic Concepts* restricted the judge's role in the obviousness determination by requiring reliance on

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134. See *Kinetic Concepts*, 688 F.3d at 1360–66.

135. See *id.* at 1360–66.

136. See *id.*

137. *Id.* at 1366 (citing *Innovention Toys, LLC v. MGA Entm't, Inc.*, 637 F.3d 1314, 1323 (Fed. Cir. 2011)). A less sophisticated PHOSITA favors a nonobviousness determination because a less educated or experienced PHOSITA would be less likely to find a particular technology obvious, and less likely to combine prior art references to solve the particular problem at hand. See *supra* Part I.B (describing an example of an obviousness inquiry).

138. See *Kinetic Concepts*, 688 F.3d at 1366.

139. See *id.* at 1366–67.

140. See *id.* at 1368.

141. *Id.*

142. See *id.* at 1371.

143. *Id.*

the jury's implied findings of fact.<sup>144</sup> Evaluating the jury's role in nonobviousness under the *Markman* framework illuminates whether such expansion is appropriate.<sup>145</sup> When viewed in light of the practical and policy considerations surrounding juries in patent law disputes, it is clear that the jury's role should be limited to the underlying factual issues and the judge should decide the obviousness question.<sup>146</sup>

### A. *The Problem with Kinetic Concepts*

Although the *Kinetic Concepts* ruling is consistent with the Federal Circuit's precedent regarding the jury's role in nonobviousness, it exacerbates problems that were already inherent in courts' approaches.<sup>147</sup> In *Connell v. Sears*, the Federal Circuit held that it was not error to submit the question of obviousness to a jury, but it made no mention of implied findings of fact.<sup>148</sup> In that case, however, the court suggested in dicta that because of the complexity of the obviousness framework, special-verdict forms should be "designed to elicit responses to at least all the factual inquiries enumerated in *Graham*."<sup>149</sup> As discussed below in Part III.B, this more granular approach to the *Graham* analysis would reduce the amount of implied findings of fact and decrease the likelihood of jury errors remaining hidden.<sup>150</sup> Thus, it would keep the final obviousness determination squarely in the hands of the judge.<sup>151</sup> Yet, nearly thirty years later in *Kinetic Concepts*, the special-verdict form sent to the jury still did not include all the *Graham* factors.<sup>152</sup>

The dissent in *In re Lockwood* illustrates this problem with the prevailing Federal Circuit practice.<sup>153</sup> Judge Nies, joined by Judges Archer and Plager, argued that denominating an issue as a question of law is essentially a policy determination that a judge is better suited

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144. See *infra* Part II.A.

145. See *infra* Part II.B.

146. See *infra* Part II.B.

147. See, e.g., *Trans-World Mfg. Corp. v. Al Nyman & Sons, Inc.*, 750 F.2d 1552, 1558–59 (Fed. Cir. 1984) (demonstrating the difficulty of overcoming the jury's presumption of correctness as to the obviousness standard and implicit findings); *Connell v. Sears, Roebuck, & Co.*, 722 F.2d 1542, 1547 (Fed. Cir. 1983) (acknowledging the potential complexity of obviousness determinations).

148. See *Connell*, 722 F.2d at 1547–48.

149. *Id.* at 1547.

150. See *infra* Part III.B.

151. See *infra* Part III.B.

152. See *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1354 (Fed. Cir. 2012).

153. See *In re Lockwood*, 50 F.3d 966, 990 (Fed. Cir. 1995) (Nies, J., dissenting).

to make the decision.<sup>154</sup> Addressing obviousness specifically, Judge Nies reasoned that the inference that the jury answered all the *Graham* factors in favor of the general verdict would lead to a skewed judgment.<sup>155</sup>

*Kinetic Concepts* raises the precise issue that concerned the dissenting judges in *In re Lockwood*, an issue that is difficult to justify given the concerns about juries in patent law.<sup>156</sup> The appellate court now requires lower courts to assume that the jury successfully navigated convoluted technical and legal issues, applied the nonobviousness framework correctly, and resolved each evidentiary issue in favor of the general verdict.<sup>157</sup> For example, in *Kinetic Concepts*, from a single yes-or-no answer, the district court had to infer that the jury properly assessed expert testimony on three highly technical references, determined the level of ordinary skill in the art of negative-pressure wound therapy, and applied the appropriate legal standard to find no reason to combine prior art references.<sup>158</sup> Thus, despite the Federal Circuit denoting the ultimate obviousness determination as a question of law, little of the decision making remains for the judge.<sup>159</sup> As a result, the question is effectively removed from the judge's purview entirely.<sup>160</sup>

### B. Reevaluating the Jury's Role in Nonobviousness

Evaluating juries' expanded roles in nonobviousness determinations first requires a discussion of the competing strengths and weaknesses of juries and judges as patent law arbiters.<sup>161</sup> Juries appear well-suited to address some issues in patent law; perhaps they are similarly well-suited to determine whether patented subject matter is obvious.<sup>162</sup>

To determine the appropriate judicial actor for the obviousness question, it is illustrative to apply the *Markman* framework.<sup>163</sup> The

154. See *id.*

155. See *id.*

156. See *Kinetic Concepts*, 688 F.3d at 1356–57; *infra* Part II.B.2.

157. See *Kinetic Concepts*, 688 F.3d at 1356–57.

158. See *id.* at 1360–71; *supra* Parts I.A, I.B.

159. See *Kinetic Concepts*, 688 F.3d at 1357; see also Guo, *supra* note 111, at 521–24 (discussing the ambiguity resulting from the Federal Circuit's treatment of obviousness as a "mixed matter of law and fact"). A jury's findings get more deference than a judge's. See *supra* notes 79–81 and accompanying text; *infra* notes 197–200 and accompanying text.

160. See *Kinetic Concepts*, 688 F.3d at 1356–57.

161. See *supra* Part II.B.1.

162. See *supra* Part II.B.1.a. (analogizing the reasonable person to the PHOSITA and listing the advantages of juries).

163. See *supra* Part I.D.2.

first step of the *Markman* analysis is the historical-method test—asking whether the nonobviousness determination was tried at law when the Seventh Amendment was enacted in 1791, or is analogous to an issue that was.<sup>164</sup> The nonobviousness question did not exist in 1791, and there was no analogous issue.<sup>165</sup> Where the historical method is inconclusive, *Markman* directs the analysis toward functional and policy considerations.<sup>166</sup>

### 1. Functional Analysis under *Markman*

Applying the functional considerations of judges and juries to nonobviousness under the *Markman* framework helps elucidate whether it is prudent to expand the jury's influence in this area of patent law.<sup>167</sup>

#### *a. Jury Competency in Patent Law*

Juries are a cornerstone of the US judicial system, and the Supreme Court has affirmed the right to a jury trial in patent cases.<sup>168</sup> Proponents of juries in patent law list several distinct advantages that juries offer over judges, including improved credibility determinations, the cumulative effects of a group, a fresh and focused attitude toward the case, faster verdicts, and reduced exposure to inadmissible evidence.<sup>169</sup>

Credibility determinations alone are almost always questions of fact for the jury.<sup>170</sup> Juries may be better equipped than judges to evaluate credibility because such determinations are akin to everyday judgments.<sup>171</sup> Other questions of fact also seem appropriate for juries; for example, negligence claims require consideration of the reasonably

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164. See *supra* Part I.D.2.

165. The doctrine didn't emerge until *Hotchkiss* in 1850. See *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248, 252–53 (1850). Most patent litigation of that period dealt with simple novelty and enablement cases. See *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 379 (1996).

166. See *id.* at 384.

167. See *supra* Part I.D.2.

168. See *Markman*, 517 U.S. at 377.

169. See Joseph N. Hosteny, *The Wisdom of Juries*, INTELL. PROP. TODAY, Aug. 2002, at 12, available at <http://www.hosteny.com/archive/Hosteny%2008-02.pdf>.

170. See *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986) (“Credibility determinations, the weighing of the evidence, and the drawing of legitimate inferences from the facts are jury functions, not those of a judge, whether he is ruling on a motion for summary judgment or for a directed verdict.”).

171. See Hosteny, *supra* note 169, at 12.

prudent person's level of care.<sup>172</sup> The Federal Circuit suggested that this is analogous to patent law's requirement that fact-finders consider evidence or circumstances from the view of a "person having ordinary skill in the art."<sup>173</sup>

Juries may also have a number of potential advantages over judges simply by virtue of being a group.<sup>174</sup> First, considering the complexity and longevity of most patent trials, cumulative powers allow the jury to absorb and remember more evidence and testimony than a judge.<sup>175</sup> Additionally, an ideal jury is a cross section of society—providing a variety of backgrounds and viewpoints.<sup>176</sup> Such a representative panel guards against the possibility of bias and eccentricities that individual judges might otherwise reflect.<sup>177</sup> Finally, by discussing their viewpoints during deliberation, jurors have the opportunity to check each other's reasoning and correct outrageous or incorrect opinions, assumptions, or conclusions.<sup>178</sup>

Juries also present some practical advantages in trial.<sup>179</sup> Although jury trials may last longer, juries often render verdicts within days, whereas a judge's decision may not come for months.<sup>180</sup> Additionally, juries may provide a fresh, focused perspective devoted to the decision at hand.<sup>181</sup> Finally, whereas juries are shielded from inadmissible exhibits and testimony, judges themselves are

172. See e.g., Henry T. Terry, *Negligence*, 29 HARV. L. REV. 40, 41 (1915) (“[N]egligence is doing what a reasonable and prudent man would not have done or not doing what such a man would have done.”).

173. See *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987) (reasoning that “a person having ordinary skill in the art[] [is] not unlike the ‘reasonable man’ and other ghosts in the law”). But this analogy is dubious; while a juror can easily put himself in the shoes of a reasonable person, the view of a PHOSITA requires jurors to view evidence from the perspective of someone with specific skills in a scientific or technical field. See Jonathan J. Darrow, *The Neglected Dimension of Patent Law’s PHOSITA Standard*, 23 HARV. J.L. & TECH. 227, 233 (2009). Depending on the case, the PHOSITA may be anyone from an ordinary mechanic to a medical researcher. See *id.* at 239. Depending on the patent, the hypothetical PHOSITA could be as advanced as a Ph.D. with years of experience. See *Polaroid Corp. v. Eastman Kodak Co.*, 641 F. Supp. 828, 852 (D. Mass. 1985).

174. See Hosteny, *supra* note 169, at 12.

175. See *id.*

176. See 28 U.S.C. § 1861 (2012) (“It is the policy of the United States that all litigants in Federal courts entitled to trial by jury shall have the right to grand and petit juries selected at random from a fair cross section of the community in the district or division wherein the court convenes.”).

177. See Signore, *supra* note 8, at 825.

178. See Hosteny *supra* note 169, at 12.

179. See *id.*; Signore, *supra* note 8, at 825–26.

180. See Signore, *supra* note 8, at 825.

181. See Hosteny, *supra* note 169, at 12.

necessarily exposed to the inadmissible evidence in determining its admissibility.<sup>182</sup>

Although juries present numerous advantages, they also raise significant concerns in patent litigation.<sup>183</sup> The inherent complexity of patented subject matter and legal rules, the “black-box” effect of nonspecific jury forms, and the lack of uniformity diminish the reliability and accuracy of jury verdicts.<sup>184</sup> In contrast, a judge handling the same issues would provide a more detailed record and receive less deference on appeal.<sup>185</sup>

In order to render a verdict in patent cases, juries must be able to understand the technology at issue.<sup>186</sup> According to recent census data less than 30 percent of US citizens have a bachelor’s degree.<sup>187</sup> Thus, assuming that juries are a perfect cross section of society, less than 30 percent of a typical patent jury is college educated.<sup>188</sup> Furthermore, patents span a wide range of fields, and many of the claimed inventions involve cutting-edge technologies.<sup>189</sup> Many of the most hotly contested patent cases deal with highly technical pharmaceutical claims, such as those in the Lipitor patent.<sup>190</sup> The first claim of that heavily litigated patent reads:

[R-(R\*,R\*)]-2-(4-fluorophenyl)-8,8-dihydroxy-5-(1-methylethyl)-3-phenyl-4-[(phenylamino)-carbonyl]-1H-pyrrole-1-heptanoic acid or (2R-trans)-5-(4-fluorophenyl)-2-(1-methylethyl)-N,4-diphenyl-1-[2-(tetrahydro-4-hydroxy-6-oxo-2H-pyran-2-yl)ethyl]-1H-pyrrole-3-carboxamide; or pharmaceutically acceptable salts thereof.<sup>191</sup>

Even with experts and trial attorneys to assist, it is often challenging for a jury to grasp the technical subject matter.<sup>192</sup>

182. See *Signore*, *supra* note 8, at 826.

183. See *id.* at 826–29.

184. See *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1538–39, 1557 (Fed. Cir. 1995) (Plager, J., dissenting); see also *Signore*, *supra* note 8, at 826–29 (discussing the disadvantages of jury trials in patent litigation).

185. See FED. R. CIV. P. 52(a)(6) (defining the legal standard for review of a judge’s findings of fact as clear error on appeal).

186. See *Warner-Jenkinson*, 62 F.3d at 1538 (“In our review we must assume that the jury understood the technology . . .”).

187. See U.S. CENSUS BUREAU, STATISTICAL ABSTRACT OF THE UNITED STATES: 2012, at 153 tbl.233 (2012), available at <http://www.census.gov/compendia/statab/2012/tables/12s0233.pdf>.

188. *Cf. id.* However, juries may not present a perfect cross-section of society for reasons beyond the scope of this Note.

189. See *supra* Part I.C. Patentable subject matter is broad, including any “process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101 (2012).

190. See, e.g., *Roche Palo Alto LLC v. Apotex, Inc.*, 531 F.3d 1372 (Fed. Cir. 2008); *Pfizer, Inc. v. Apotex, Inc.*, 488 F.3d 1377 (Fed. Cir. 2007); *Am. Standard Inc. v. Pfizer Inc.*, 828 F.2d 734 (Fed. Cir. 1987); *infra* note 191 and accompanying text.

191. U.S. Patent No. 5,273,995 (filed Feb. 26, 1991).

192. See *Sartori*, *supra* note 8, at 332–33. However, judges also struggle with the complexities of patent law and patent subject matter. See *infra* Part II.B.1.b.

Juries must also understand the complicated legal rules applicable to patent cases.<sup>193</sup> Scholars recognize patent law as one of the most complex areas of the law.<sup>194</sup> Additionally, the lack of pattern jury instructions in this area has resulted in instructions so convoluted that they seem “spoken in a foreign language.”<sup>195</sup> In a single trial, jurors must apply legal concepts that law students take years to master.<sup>196</sup>

Another cause for concern is the “black-box” effect of a jury verdict.<sup>197</sup> Unless the verdict form includes many specific factual findings, it is difficult to determine on appeal what sort of analysis the jury performed.<sup>198</sup> Thus, an appellate court cannot review the jury’s reasoning and must presume the jury followed the jury instructions to make their findings.<sup>199</sup> While judges also make mistakes, their reasoning is transparent and their errors reviewable on appeal.<sup>200</sup>

Anecdotal evidence suggests that the voluminous and complex legal issues are overwhelming, and jurors may take shortcuts or ignore vital requirements to reach a speedy verdict.<sup>201</sup> Juries may

193. See Gerald J. Mossinghoff & Donald R. Dunner, *Increasing Certainty in Patent Litigation: The Need for Federal Circuit Approved Pattern Jury Instructions*, 83 J. PAT. & TRADEMARK OFF. SOC’Y 431, 432–33 (2001).

194. See *id.* at 432.

195. See *id.* at 433. For example, jurors may be expected to consider legal concepts such as prior art references, printed publications, prosecution history estoppel, date of invention, date of filing, the person having ordinary skill in the art, *Graham* factors, presumption of validity, and more. See Signore, *supra* note 8, at 829.

196. See generally NARD, *supra* note 43 (covering the basics of patent law for a year-long patent law course).

197. See Suthar, *supra* note 23, at 303.

198. See *id.* at 304.

199. See *id.*; see, e.g., *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1356–57 (Fed. Cir. 2012) (presuming the jury’s implicit findings). The Federal Rules of Evidence prohibit testimony regarding a jury’s deliberations and analysis, creating a “black box” around the jury’s decisionmaking process. FED. R. EVID. 606(b)(1) (excluding juror testimony about jury deliberations).

200. See FED. R. CIV. P. 52(a)(1) (“The findings and conclusions may be stated on the record after the close of the evidence or may appear in an opinion or a memorandum of decision filed by the court.”).

201. See, e.g., Bruce Carton, *Jury Confusion About Verdict Form Costs Plaintiff Over \$200,000 in Damages*, LEGAL BLOG WATCH (Sept. 23, 2011, 12:00 PM), [http://legalblogwatch.typepad.com/legal\\_blog\\_watch/2011/09/earlier-this-month-the-court-of-appeals-of-indianaruled-in-an-interesting-case-that-involved-a-jury-deciding-that-a-plaintiff.html](http://legalblogwatch.typepad.com/legal_blog_watch/2011/09/earlier-this-month-the-court-of-appeals-of-indianaruled-in-an-interesting-case-that-involved-a-jury-deciding-that-a-plaintiff.html); Steve Hansen, *Are We Kidding Ourselves with Patent Jury Trials? Lessons from Apple v. Samsung*, HANSEIPLAW.COM (Sept. 5, 2012), <http://hanseniplaw.com/are-we-kidding-ourselves-with-patent-jury-trials-lessons-from-apple-v-samsung>; Pamela Jones, *Jury in Apple v. Samsung Goofed, Damages Reduced—Uh Oh. What’s Wrong With this Picture?*, GROKLAW (Aug. 25, 2012, 11:30 AM), <http://www.groklaw.net/article.php?story=2012082510525390>; Dan Levine, *Jury Didn’t Want to Let Samsung Off Easy in Apple Trial: Foreman*, REUTERS, Aug. 26, 2012, <http://in.reuters.com/article/2012/08/25/us-apple-samsung-juror-idINBRE87O09U20120825>; Mike Masnick, *Apple/Samsung Jurors Admit They Finished Quickly by Ignoring Prior Art & Other Key Factors*,

provide these faster verdicts at the expense of accuracy—perhaps there is a good reason judges take so long to render a decision.<sup>202</sup> Because of the opacity of jury verdicts and a deferential standard on appeal, even egregious injustices would typically be undetectable and uncorrectable.<sup>203</sup> Further anecdotal evidence suggests that group effects can actually be detrimental—jurors may simply defer to their most persuasive member, negating any collective memory or reasoning.<sup>204</sup>

Juries also suffer from a lack of uniformity and predictability.<sup>205</sup> These concerns are not new or unique to patent law.<sup>206</sup> In 1835, Justice Story expressed his fear that “if juries were to decide purely legal questions, it would lead to a lack of uniformity and predictability in the law.”<sup>207</sup> This need for uniformity is especially great in patent law because the value of a patent depends on the patent owner’s ability to predictably enforce its claims.<sup>208</sup> In fact, the inconsistent and unpredictable nature of juries was the justification for limiting the jury’s role to fact-finding.<sup>209</sup> Without certainty over validity and claim scope, patentees’ collective ability to pursue infringers decreases, as does the value of patents.<sup>210</sup> As patents play an increasingly important role in our economy, the need for predictability in patent verdicts likewise grows.<sup>211</sup>

### *b. Judge Competency in Patent Law*

Compared to juries, judges provide a more detailed record and receive less deference on appeal.<sup>212</sup> Accordingly, when judges make mistakes, their reasoning is often transparent and reviewable by

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TECHDIRT (Aug. 27, 2012, 9:30AM), <http://www.techdirt.com/articles/20120826/23534320161/applesamsung-jurors-admit-they-finished-quickly-ignoring-prior-art-other-key-factors.shtml> (“[T]hey decided that prior art was ‘bogging us down’ and they might as well ‘skip’ it.”).

202. See Signore, *supra* note 8, at 825.

203. See *supra* Part II.B.1.a.

204. See Masnick, *supra* note 201.

205. See Miller, *supra* note 86, at 32.

206. See Jon P. McClanahan, *The ‘True’ Right to a Trial by Jury: The Founders’ Formulation and Its Demise*, 111 W. VA. L. REV. 791, 820 (2009) (citing *United States v. Battiste*, 24 F. Cas. 1042 (C.C. Mass. 1835) (No. 14,545)).

207. *Id.*; see *Battiste*, 24 F. Cas. at 1043.

208. See Altman, *supra* note 89, at 724–25.

209. See Signore, *supra* note 8, at 798 (citing Stephen A. Weiner, *The Civil Jury Trial and the Law-Fact Distinction*, 54 CALIF. L. REV. 1867, 1924 (1966)).

210. See Altman, *supra* note 89, at 725.

211. See *id.* at 699.

212. See FED. R. CIV. P. 52(a)(6) (defining the legal standard for review of a judge’s decision as clear error on appeal).



appellate courts.<sup>213</sup> Further, a judge's training and discipline may make her better suited than a jury to handle the complexities of patent litigation.<sup>214</sup>

However, scholars argue that judges suffer from their own set of disadvantages.<sup>215</sup> As sole arbiters, they may be susceptible to bias, prejudice, eccentricities, or unfairness.<sup>216</sup> Furthermore, courts are busy—judges must manage a demanding docket.<sup>217</sup> A high caseload may divide their attention and prevent them from focusing completely on a single case like jurors do.<sup>218</sup> Additionally, there are no specific trial judges for patent cases.<sup>219</sup> There is no reason to believe that legal training would allow a judge to understand the Lipitor patent any better than a juror.<sup>220</sup> Though this is a concern, federal judges see more patent cases than the average juror, and their experience and knowledge of the law allow them to focus on the factual complexities of the case.<sup>221</sup>

### *c. Relative Competencies of Judge and Jury for Nonobviousness*

Functional considerations suggest that juries should not determine the ultimate obviousness question,<sup>222</sup> but they should decide issues of fact.<sup>223</sup> The *Graham* factors and secondary considerations contain many questions of fact that involve credibility determinations, such as evaluating expert testimony.<sup>224</sup> Furthermore, collective memories and powers of observation aid juries in analyzing fact-heavy patent cases.<sup>225</sup> And admissibility proceedings, which are

213. See FED. R. CIV. P. 52(a)(1) (“The findings and conclusions may be stated on the record after the close of the evidence or may appear in an opinion or a memorandum of decision filed by the court.”).

214. Cf. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388–89 (1996).

215. See *infra* notes 216–219 and accompanying text.

216. See *Signore*, *supra* note 8, at 825.

217. See *id.*

218. See *Hosteny*, *supra* note 171, at 12.

219. See *Pegram*, *supra* note 61, at 768 (“The United States district courts have exclusive, original jurisdiction ‘of any civil action arising under any Act of Congress relating to patents.’”).

220. See *supra* Part II.B.1.a.

221. See *Miller*, *supra* note 86, at 36 (suggesting judges are better equipped to wade through the complex legal and factual issues than a jury).

222. See *supra* Parts II.B.1.a–b.

223. See *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384 (1996) (describing questions of fact as an inquiry for the jury in patent law).

224. See *supra* Part I.A (discussing the *Graham* factors).

225. See *supra* Part II.B.1.a.

held outside the presence of jurors, shield the jury from potentially inadmissible evidence.<sup>226</sup>

While these advantages certainly support the jury's role as the fact-finder for obviousness, they do little to justify removing the ultimate obviousness determination from the judge.<sup>227</sup> The ultimate determination, which requires balancing the *Graham* factors and weighing them against secondary considerations, is far from an "everyday judgment."<sup>228</sup> Furthermore, protection from inadmissible evidence is not as likely to cause unfair prejudice as in other legal contexts, such as criminal trials.<sup>229</sup> Finally, a jury may not necessarily render a faster verdict because the judge must still enter the final determination.<sup>230</sup>

Understanding the technology at issue is even more critical to the obviousness inquiry than it is to claim construction.<sup>231</sup> Claim construction requires giving meaning to the claims from the perspective of a PHOSITA; determining obviousness requires evaluating the claims, the prior art, and the PHOSITA's technical knowledge.<sup>232</sup> A jury bewildered by legal complexities and incomprehensible jury charges is unlikely to effectively assess these elements.<sup>233</sup> Even if the jurors parse their instructions, they face the daunting task of determining whether technical claims (written in ambiguous patent legalese) are obvious in light of equally technical prior art.<sup>234</sup> Thus, while juries are appropriate judicial actors for underlying factual determinations, functional considerations dictate that they are ill-suited for the legal question of obviousness.<sup>235</sup>

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226. See FED. R. EVID. 104(a), (c) (requiring hearings on preliminary questions, like admissibility of evidence, to be conducted so that the jury cannot hear it).

227. See *infra* notes 228–230 and accompanying text.

228. See *supra* Part II.B.1.a.

229. Whereas the character of the experts may be at issue in patent cases, evidence of prior convictions, sexual abuse, and past acts are less likely to arise in patent law as they are in other civil or criminal cases. Cf. FED. R. EVID. 403, 404, 413, 608, 609 (limiting the admissibility of evidence based on unfair prejudice, probative value, character and past acts).

230. See, e.g., *supra* notes 56–59 and accompanying text. Even if the question of obviousness is effectively removed from the judge, like in *Kinetic Concepts*, the judge must still write an opinion. FED. R. CIV. P. 58(a)–(c).

231. See *infra* notes 232–234 and accompanying text.

232. See Darrow, *supra* note 173, at 236 (“The PHOSITA standard is also relevant to claim construction, where it is applied to determine what one of ordinary skill in the art would have understood the claim to mean.”); *supra* Part I.A.

233. See *supra* Part II.B.1.a.

234. See Kristen Osenga, *The Shape of Things to Come: What We Can Learn from Patent Claim Length*, 28 SANTA CLARA COMPUTER & HIGH TECH. L.J. 617, 653 (2012) (discussing patent legalese); *supra* Part I.A.

235. See *supra* Part I.D.2. Like claim construction, the complexity exceptions justifies keeping the nonobviousness determination from the jury because of the “practical abilities and limitations of juries.” See *supra* Part I.D.2.

## 2. Policy Analysis under *Markman*

Policy implications such as uniformity, public interest, and standards of review also weigh against the jury determining nonobviousness.<sup>236</sup> The same policy goals present in *Markman* exist here: promoting uniformity and consistency to combat uncertainty that discourages innovation.<sup>237</sup> Uncertainty as to what is obvious would stifle innovation by making the scope of the “patent-free zone” unclear—that is, how much substitution, minor improvements, or streamlining is permissible without infringing.<sup>238</sup> Additionally, the lack of predictability reduces the value of all issued patents, as the patentee’s confidence in their ability to pursue infringers wanes.<sup>239</sup> This is especially pressing for obviousness because it is often a central issue in trial.<sup>240</sup>

Furthermore, courts must carefully set the “obvious” bar to promote public interest and balance the competing concerns of the US patent system.<sup>241</sup> If too few inventions qualify as obvious, then patents would issue for inventions that a PHOSITA would have found obvious and thus devised without the patent incentive.<sup>242</sup> Consequently, this low bar would lead to a “thicket” of insignificant patents, frustrating the goals of the patent system.<sup>243</sup> On the other hand, if too many inventions qualify as obvious—that is, overestimating what a PHOSITA would find obvious—then the result would deny protection to inventions that would not arise without the patent incentive.<sup>244</sup> These public-interest considerations go beyond the facts of a single case, and thus exceed the jury’s province.<sup>245</sup>

Additionally, the highly deferential standard of review afforded to juries is problematic for the obviousness determination.<sup>246</sup> If a jury follows the *Graham* framework, an appellate court has no opportunity to review the analysis and determine whether the reasoning is

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236. See *infra* notes 237–240 and accompanying text.

237. See *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996).

238. See *Markman*, 517 U.S. at 390; FED. TRADE COMM’N, TO PROMOTE INNOVATION, *supra* note 45, at 3.

239. See *supra* notes 208–211 and accompany text.

240. See *Allison & Lemley*, *supra* note 10, at 208–10.

241. See *infra* notes 242–244 and accompanying text.

242. See *supra* Part I.C.

243. See FED. TRADE COMM’N, TO PROMOTE INNOVATION, *supra* note 45, at 7; see also U.S. CONST. art. I, § 8, cl. 8 (describing the goals of the patent system to “promote the Progress of Science and useful Arts”); *supra* Part I.C.

244. See *supra* Part I.C.

245. See *supra* notes 241–244 and accompanying text.

246. See *supra* notes 79–81 and accompanying text.

sound.<sup>247</sup> Each *Graham* factor is a necessary part of the nonobviousness determination; thus, if one of the appellate court's inferences in *Kinetic Concepts* was inconsistent with the jury's underlying and hidden factual determinations, the jury's ultimate conclusion may not have been supported by substantial evidence.<sup>248</sup> While judges may also make mistakes or apply the law incorrectly, their reasoning is transparent and their legal conclusions reviewable *de novo*.<sup>249</sup>

This is not to say that judges are perfectly suited for the obviousness question.<sup>250</sup> Yet, their reasoning will be reviewable *de novo* on appeal.<sup>251</sup> Thus, for functional and policy reasons, it is imprudent to expand the jury's role in determining nonobviousness to the point of effectively removing the judge from the legal determination.

### III. PRESCRIBED SPECIAL-VERDICT FORMS FOR NONOBVIOUSNESS RESTORE THE BALANCE BETWEEN JUDGE AND JURY

In *Kinetic Concepts*, the Federal Circuit attempted to address the ambiguity surrounding the jury's role in the obviousness question.<sup>252</sup> However, its holding effectively tied judges' hands and forced them to accept implied factual findings that overestimate the quality of the jury's analysis.<sup>253</sup> And the lower court's approach in that case, where the jury's ultimate determination was advisory and created no implied findings of fact, is neither desirable nor

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247. See *supra* notes 133–142 and accompanying text; see also FED. R. EVID. 606(b)(1) (excluding juror testimony about jury deliberations); *supra* notes 197–199 and accompanying text. There is significant evidence that juries often fail to follow judges' instructions, especially when faced with intricate technical and legal issues. See Mossinghoff & Dunner, *supra* note 193, at 433. While deference to the venerated jury verdict plays an important role in the US legal system, blind faith that patent juries accurately carry out the obviousness analysis is too optimistic. See *supra* Part II.B.1.a.

248. See *supra* Part I.A.

249. See FED. R. CIV. P. 52(a)(1) (“The findings and conclusions may be stated on the record after the close of the evidence or may appear in an opinion or a memorandum of decision filed by the court.”); *Pierce v. Underwood*, 487 U.S. 552, 558 (1988) (stating that questions of law are reviewed *de novo*).

250. See Signore, *supra* note 8, at 825 (describing the advantages of a jury trial, which mirror some disadvantages of a bench trial). They are still subject to bias, prejudice, and the distractions of managing a docket. See *id.* They may also struggle with the factual and legal complexities inherent in patent litigation. See *supra* Part II.B.1.b. But their legal experience and knowledge of the law makes them more likely to apply the *Graham* framework accurately, predictably, and in a manner consistent with precedent. See *supra* Part I.A.

251. See *supra* note 249 and accompanying text.

252. See *supra* Part I.F.

253. See *supra* Part II.A.

permissible.<sup>254</sup> A nonbinding verdict on an issue of law adds little value, and on appeal in *Kinetic Concepts*, the Federal Circuit appeared to explicitly condemn such a limited verdict.<sup>255</sup>

The Federal Circuit should instead create a prescribed special-verdict form for nonobviousness—requiring the submission of the *Graham* factors and secondary considerations to the jury, but not the ultimate legal question of obviousness.<sup>256</sup> The jury should determine the scope and content of the prior art references, the level of ordinary skill in the art, the differences between the claimed invention and the prior art, and list any secondary considerations.<sup>257</sup> Armed with the jury's explicit factual findings, the judge should review them for substantial evidence and use them to make a final obviousness conclusion.<sup>258</sup> This prescribed special-verdict form for nonobviousness would alleviate many of the functional and policy concerns of the Federal Circuit's approach in *Kinetic Concepts*.<sup>259</sup>

Such a form addresses many of the functional concerns raised under the *Markman* framework.<sup>260</sup> It appropriately balances the strengths of the two judicial actors by ensuring that the jury makes the necessary factual determinations but retaining the legal question for the judge.<sup>261</sup> The jury's strength in making credibility determinations is optimally applied to expert testimony, and potential judicial bias on those issues is avoided.<sup>262</sup> Under this approach, jurors avoid many of the legal questions surrounding obviousness, allowing

254. See *supra* Part I.F.

255. See *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1357 (Fed. Cir. 2012) (rejecting the purely advisory status of the jury's findings); see also FED. R. CIV. P. 39(c)(1) (permitting the court to try an issue with an advisory jury if the action is not otherwise triable of right by a jury).

256. See *supra* Part II.B. A pattern jury instruction, as seen in many torts cases, is undesirable because the jury instruction for the *Graham* factors may differ greatly based on the number and type of prior art references available in the case. See Patrick J. Kelley & Laurel A. Wendt, *What Judges Tell Juries About Negligence: A Review of Pattern Jury Instructions*, 77 CHI.-KENT L. REV. 587, 594 (2002) ("Our research indicates that forty-eight of the fifty states now have pattern or recommended jury instructions [for negligence] . . ."). But a prescribed standard procedure for obviousness is certainly possible. The standard procedure would require that the district court submit the *Graham* factors to the jury as a special verdict, but leave the precise wording of the instructions up to the judge's discretion. See *supra* Part I.D.1.

257. See *supra* Part I.A (listing *Graham* factors); Part II.B.1.a (evaluating jury competency).

258. See *supra* notes 75–77 and accompanying text.

259. See *Kinetic Concepts*, 688 F.3d 1342; *supra* Part II.B.

260. See *supra* Part II.B.

261. See *supra* Part II.B.

262. See *supra* Parts II.B.1.a–b.

them to focus on the factual issues.<sup>263</sup> Furthermore, this method enables judges to independently apply the law to the facts.<sup>264</sup>

This special-verdict form also addresses the policy concerns the Federal Circuit raised in *Kinetic Concepts*.<sup>265</sup> The prescribed verdict will increase uniformity and predictability because the judge will be able to correct errant jury determinations and other missteps. And the increased review on appeal will allow the Federal Circuit to maintain a consistent and predictable definition of obviousness.<sup>266</sup> The value of patents will become more stable as patent owners become more confident of their rights.<sup>267</sup> Finally, the judge's increased control over the final decision increases the likelihood that the obviousness determination will appropriately account for the public interest.<sup>268</sup>

A prescribed special-verdict form would also make the jury's reasoning more transparent.<sup>269</sup> Whereas implied findings of fact would hide a jury's mistake under *Kinetic Concepts*, the granular character of the prescribed special-verdict form would expose any error and make it reversible as a distinct factual finding.<sup>270</sup> Thus, this solution would eliminate the flawed assumption that juries correctly apply the law to the *Graham* factors and secondary considerations.<sup>271</sup> It would also shift control of the legal question back to the court, giving the judge a check on the jury's reasoning and truly making her the "ultimate arbiter" of the obviousness determination.<sup>272</sup>

Concerns with special-verdict forms most commonly arise in criminal cases, where the special verdict limits the jury's ability to independently reach a verdict.<sup>273</sup> For obviousness, however, where the jury is required to follow the structured *Graham* factor analysis, a special verdict is entirely appropriate.<sup>274</sup> In some cases, litigants may simply prefer a general obviousness verdict. Consider a party that thinks that the jury is more likely than the judge to rule in their favor

263. See *supra* Part II.B.1.

264. Without the jury's general verdict on the legal question of obviousness, the judge can independently apply the law. See, e.g., *supra* notes 256–258 and accompanying text.

265. See *infra* notes 266–268 and accompany text.

266. See *supra* notes 246–249 and accompanying text.

267. See *supra* notes 239–240 and accompanying text.

268. See *supra* notes 241–245 and accompanying text.

269. See *supra* Part II.B.1.a.; see also Part I.A (listing the *Graham* factors).

270. See *supra* Part I.D.1.

271. See *supra* Part I.F (describing the Federal Circuit's analysis in *Kinetic Concepts* of the jury's application of the *Graham* factors).

272. See *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1358–59 (Fed. Cir. 2012).

273. See Kate H. Nepveu, Note, *Beyond "Guilty" Or "Not Guilty": Giving Special Verdicts in Criminal Jury Trials*, 21 YALE L. & POL'Y REV. 263, 263 (2003).

274. See *supra* Part I.A (describing the *Graham* factors).

on obviousness. They may prefer a general obviousness verdict or a general verdict with special interrogatories, as both of these forms limit the judge's discretion.<sup>275</sup> Alternatively, litigants may simply wish to avoid the lengthy process of drafting and negotiating the content of jury instructions. However, the functional and policy concerns of providing accurate and consistent obviousness verdicts outweigh these practical concerns.<sup>276</sup>

While the Federal Circuit held that submitting the ultimate obviousness determination to the jury is not clear error, it has not specifically endorsed the practice.<sup>277</sup> The Federal Circuit could require a prescribed special verdict for nonobviousness just as the Seventh Circuit did in the past.<sup>278</sup> In fact, this is precisely the approach the Federal Circuit called for in *Connell*.<sup>279</sup> The current hybrid approach of a general verdict plus a special verdict will continue to give rise to the issues that the implied factual findings create.<sup>280</sup> Instead, the Federal Circuit should mandate a special verdict without a general verdict, submitting all the factual questions at issue in the *Graham* framework to the jury, including secondary considerations.<sup>281</sup>

#### IV. CONCLUSION

As patent litigation becomes more prevalent and damages soar, it is increasingly important to ensure that patent trials adhere to the patent system's lofty goals. The nonobviousness requirement is one of the most important and heavily litigated patentability requirements. The Federal Circuit's recent *Kinetic Concepts* decision effectively removed the question of obviousness from the judge by tying the ultimate legal determination to implied findings of fact that overestimate the quality of the jury's analysis and understanding. Applying the Supreme Court's *Markman* framework to

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275. See *supra* Part I.D.1.

276. See *supra* Parts II.A–B.

277. See *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1359–60 (Fed. Cir. 2012); *In re Lockwood*, 50 F.3d 966, 988 (Fed. Cir. 1995) (Nies, J., dissenting) (“It was not entirely clear from *Connell* (even in a suit for damages) whether our precedent actually required the validity issue to go to the jury or merely held that it was not reversible error per se to ask the jury for a validity/invalidity verdict.”); Guo *supra* note 112, at 523–24. *But see* *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1547 (Fed. Cir. 1983) (suggesting that obviousness should be submitted to the jury because of underlying questions of fact, much like the question of negligence in other types of cases).

278. See *Roberts v. Sears, Roebuck & Co.*, 723 F.2d 1324, 1343 (7th Cir. 1983); *supra* Part I.E.

279. See *Connell*, 722 F.2d at 1547–48.

280. See *supra* Parts I.E, II.A.

281. See *supra* notes 260–272 and accompanying text (discussing the benefits of this solution).

nonobviousness makes it clear that expanding the jury's role raises significant functional and policy concerns. Thus, a solution is needed that will appropriately balance the relative strengths and weaknesses of the two judicial actors in resolving the question of obviousness.

A prescribed special-verdict form for nonobviousness would alleviate the functional and policy concerns of *Kinetic Concepts*. It should require that the judge submit the underlying factual issues—but not the ultimate question of obviousness—to the jury. This solution would resolve functional concerns by ensuring that the jury explicitly determines all of the factual questions and avoiding the optimistic assumption that the jury correctly carries out the complex legal analysis. Furthermore, the special-verdict form advances the patent system's goals of predictability and uniformity by increasing transparency on appeal. Thus, in order to appropriately balance the role of judge and jury in nonobviousness, the Federal Circuit should prescribe a special-verdict form that includes the *Graham* factors and the secondary considerations but not the ultimate question of obviousness.

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