

# Patent Litigation Strategies Handbook

Second Edition

2006 Supplement

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## CHAPTER 21 THE TRIAL

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Intellectual  
Property Law

Section of Intellectual Property Law  
American Bar Association



BNA Books, A Division of BNA, Washington, D.C.

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### **Library of Congress Cataloging-in-Publication Data**

Patent litigation strategies handbook / editors-in-chief, Barry L. Grossman, Gary M. Hoffman.  
p. cm.

“Section of Intellectual Property Law, American Bar Association.”

Includes index.

ISBN-13: 978-1-57018-502-1 (alk. paper)

ISBN-10: 1-57018-502-6 (alk. paper)

1. Patent suits--United States. 2. Patent laws and legislation--United States. I.

Grossman, Barry L. II. Hoffman, Gary M. III. American Bar Association. Section of Intellectual Property Law.

KF3155.P37 2005

346.7304'86--dc22

2005057444

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Published by BNA Books  
1231 25<sup>th</sup> St., NW, Washington, DC 20037  
*bnabooks.com*

ISBN: 1-57018-623-5; 978-1-57018-623-3  
Printed in the United States of America

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THE TRIAL\*

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## II. PREPARATION FOR TRIAL

### B. Know Your Judge and the Local Rules

[Add at the end of the last paragraph of the subsection.]

The Internet has become a particularly useful tool in this regard. Judges in many jurisdictions post their special courtroom rules on district court

*Main volume footnote updates begin on page 149.*

websites<sup>1</sup> and care should be taken to review these resources prior to the first appearance in any judge's courtroom (whether in one's home district or elsewhere).

### C. Planning the Trial Presentation

#### 3. *Persuading the Jury*

[Add the following text at the end of the subsection.]

As in most things, there is a caveat to consider. The reliance on a story model does not mandate the conclusion that the evidence presented to the jury should be elicited as a chronological timeline. Although this may work in a few uncomplicated cases, the simple timeline arrangement is not the best method of presentation in most cases. As discussed in Section VII.A.1, the presentation of evidence must consider the relative merits of each witness and determine—on a purely personal basis—which among them will provide a firm and stable foundation for a good relationship with the jury. The witness who may be first from a chronological perspective may also be one who is nervous or likely to be weak during cross-examination. If so, his testimony should be deferred to a time after other witnesses have laid a solid foundation with the jury.

### D. The Pretrial Statement and Conference

#### 6. *The Final Pretrial Conference*

[Delete the first paragraph of the subsection and replace it with the following text.]

The final pretrial conference is governed by Federal Rule of Civil Procedure 16 which provides that “the participants . . . shall formulate a plan for trial, including a program for facilitating the admission of evidence.”<sup>2</sup> Litigants too often leave the process for admission of exhibits to the court's housekeeping procedures instead of presenting creative methods to the judge for dealing with the host of exhibits for which patent trials are known. Before the final pretrial

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<sup>1</sup> See, e.g., “Specific Requirements” of judges of the Northern District of Texas, <http://www.txnd.uscourts.gov/judges/index.html> (last visited on July 30, 2006); “Individual Practices” of judges of the Southern District of New York, <http://www.nysd.uscourts.gov/judges.htm> (last visited on July 30, 2006); and “Court Practices” of judges of the Western District of Pennsylvania, <http://www.pawd.uscourts.gov/pages/courtpractice.htm> (last visited on July 30, 2006). For example, in the Northern District of Texas at least one judge makes available on line his rules for “courtroom decorum,” including detailed provisions reminding counsel not to express personal knowledge or opinion concerning any matter in issue (i.e., don't say “I think” or “I believe,” etc.) during opening statements and in arguments to the jury, nor to read from trial transcripts or depositions during such statements and arguments. Those rules further require that counsel “admonish all persons at counsel table that gestures, facial expressions, audible comments, or the like, as manifestations of approval or disapproval during the testimony of witnesses, or at any other time, are absolutely prohibited.”

<sup>2</sup> FED. R. CIV. P. 16.

conference, the parties should confer in good faith and make every effort to streamline the presentation by agreeing upon joint exhibits, working out the presentation of depositions and exhibits captured in electronic medium. At the final pretrial conference, witness lists, exhibits, motions in limine, preliminary and final jury instructions, verdict slips, and other pretrial matters will be discussed and objections entertained (although most judges defer any consideration of final jury instructions and verdict slips until the conclusion of the evidence). Other matters may and should be addressed at the final pretrial conference. It is appropriate, for example, for the judge to make determinations regarding final and binding statements of factual and legal issues to be tried. If the parties will be submitting Juror Notebooks that contain stipulations (*see infra* at Section III.C.), the parties should ask the judge to take up the issue of whether a stipulation has been made regarding particular fact.<sup>3</sup>

To expedite the trial, most judges will rule upon objections to exhibits at the final pretrial conference and may take affirmative steps to avoid use of duplicative or redundant exhibits or those that are unclear and potentially prejudicial. If the judge does not do so of her own accord, this is an appropriate time to ask the court to limit or exclude evidence that relates only to uncontested matters or to prevent presentation of evidence that is merely cumulative or unnecessary. If a particular exhibit will be referred to in the opening statement, a specific ruling should be obtained so as to avoid drawing an objection in the middle of the opening statement. The use and admissibility of models that are to be available in the well of the courtroom when the jury first enters should be addressed and rulings thereon entered by the court.

### III. THE JURY

#### G. Post-trial Instructions

[Add the following text after the fifth paragraph.]

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<sup>3</sup>In fact, the *Civil Litigation Management Manual* developed by the Committee on Court Administration and Case Management of The Judicial Conference of the United States, advises judges to do just this. CIVIL LITIGATION MANAGEMENT MANUAL 80 (2001). Although the *Civil Litigation Management Manual* specifically states that it is not to be cited as authority and “provides no rights or duties,” it does make detailed suggestions to judges on how to manage cases and operate courtrooms. Regarding Final Pretrial Conferences, the *Manual* provides the following suggestions, among others:

- that the judge consider admonishing the parties that late filed motions in limine will be considered waived without a strong showing that counsel could not have “known about the matter in advance”;
- that exhibits should be received into the record to the extent possible before testimony is elicited;
- matters related to the order of proof should be resolved (including, for example, whether a declaratory judgment plaintiff seeking a determination of invalidity should proceed first, or only in response to the patentee’s case on infringement);
- that the court should consider bifurcation of potentially dispositive motions;
- consideration should be given to requiring narrative statements for presenting—subject to cross-examination—certain witnesses in bench trial and all expert witnesses in jury trials;
- the use of deposition transcripts should be avoided and replaced instead with joint statements by counsel as to what a particular witness would say under oath;
- ruling on the qualification of expert witnesses, the admissibility of particular evidence related to

Particular care should be given when submitting (or objecting to) jury instructions on claim construction. If a jury instruction as to the construction of a claim element is improperly drafted, it has the potential to skew the jurors' deliberations. It may be grounds for a new trial if the Federal Circuit finds that it removed from the jury a basis on which the jury could reasonably have rendered a different verdict.<sup>4</sup>

[Delete the last paragraph and replace it with the following text.]

There are pattern or standard jury instructions that have been developed for patent cases, including the recent Model Jury Instructions Patent Litigation published by the American Bar Association's Section of Litigation.<sup>5</sup> However, patent law is not static; it is constantly and sometimes rapidly evolving. Care should be taken to confirm that the pattern instructions reflect the current state of the law. Instructions that are only a month old may already be out of date.

## H. Special Verdicts

[Add the following text after the second indented paragraph on page 799.]

Using obviousness as an exemplar, if the determination of obviousness has been sent to the jury by consent of the parties, the special verdict form should address individually, as suggested by *Railroad Dynamics*, each of the *Graham* factors<sup>6</sup> by asking the juror to make findings, at minimum, regarding:

1. defining the pertinent art;
2. the level of skill of one of ordinary skill in the pertinent art;
3. the content and scope of the relevant prior art, i.e., what specific references inform their deliberations;

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expert testimony, use of hypothetical questions, and the necessary evidentiary foundations that must be presented before testimony may be elicited; and

- evaluation of whether an expert's testimony is or will be at variance with prior deposition testimony, written report or other statement and thus subject to being barred altogether.

*Id.* at 80–82.

<sup>4</sup>*Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 381 F.3d 1371, 1383, 72 USPQ2d 1333, 1341 (Fed. Cir. 2004) (“It is well established that when an incorrect jury instruction—such as an incorrect claim construction—removes from the jury a basis on which the jury could reasonably have reached a different verdict, the verdict should not stand.”) (*citing* *Texas Digital Sys. v. Telegenix, Inc.*, 308 F.3d 1193, 1201, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002)); *Ecolab Inc. v. Paraclypse, Inc.*, 285 F.3d 1362, 1373, 62 USPQ2d 1349, 1356 (Fed. Cir. 2002).

<sup>5</sup>SECTION OF LITIGATION, AMERICAN BAR ASSOCIATION, THE MODEL JURY INSTRUCTIONS SERIES, PATENT LITIGATION (2005). Other sources of “form” instructions are those adopted by the United States District Court for the Northern District of California in 2004, the American Intellectual Property Law Association in 1998, and the Model Jury Instructions for the District of Delaware in 1993. (Note: some of the instructions from these older versions are no longer applicable in light of more recent changes in the laws.) As this Supplement goes to press, the Federal Circuit Bar Association is preparing to issue its new “Model Patent Jury Instructions” (prepared by its Patent Litigation Committee of which this author is a member) to replace its old model instructions.

<sup>6</sup>*See Graham v. John Deere Co.*, 383 U.S. 1, 86 S.Ct. 684, 148 USPQ 459 (1966).

*Main volume footnote updates begin on page 149.*

4. the differences between the prior art and the claims at issue;
5. reasons that one of ordinary skill would have been motivated to combine references;
6. whether a reference or references relate to the same purpose as the claimed invention; and
7. whether the references relate to the same general problem faced by the inventor.<sup>7</sup>

Relying upon the factual determinations made in response to special interrogatories on these matters, the court (or jury if the parties have consented) may more easily determine whether the “the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. . . .”<sup>8</sup> Whether the court makes the ultimate determination regarding obviousness or the jury does so, providing these guideposts will greatly simplify the considerations to be made by the jurors and will pinpoint for appeal any obvious errors in the facts found by the jury as well as, if applicable, an analysis of the proper legal standards applied by the jury.

#### IV. SELECTION AND PREPARATION OF WITNESSES

##### B. Selection of Fact Witnesses

[Delete the second full paragraph and replace with the following text.]

Obviously, the inventor should be called by the patentee to testify, particularly if the inventor is still employed by or associated with the patent owner. The jury will not only want but expect to hear the story of the invention, and this can come in successfully only through the inventor. His story will have emotional allure if presented properly. If the inventor has a particularly appealing story and was assisted in his undertakings by others who likewise have attractive attributes, consideration should be given to calling a co-inventor who can testify to the shared struggle of creation.

If, as the patent owner, a choice is made not to call at least one inventor during a trial, a justification for this failure should be explained to the jury (e.g., another witness who is called at trial should mention that the inventor is dead, too sick to testify, has left the company and gone with a competitor, or is otherwise unavailable to attend the trial and testify). If one, but not all, of the named co-inventors is called at trial, she should explain the nonattendance

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<sup>7</sup>In making a determination as to obviousness, the issue of the “problem” faced by the inventor relates to the general problem faced by the inventor during the creative process and not the specific problem that eventually was solved by the invention. *See Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323, 76 USPQ2d 1662, 1685 (Fed. Cir. 2005). The distinction is difficult for jurors to comprehend and properly drafted special verdict forms can enlighten their deliberations sufficiently well enough to have confidence that the verdict will be properly based on the applicable law.

<sup>8</sup>35 U.S.C. §103(a).



of the other inventors. This undercuts any argument from opposing counsel that the patent owner did not have the courage to call the inventor(s). Even if opposing counsel does not affirmatively raise the issue, the absence of the inventor will be raised in jury deliberation, and the jurors will be left to draw their own conclusions. In fact, in some jurisdictions, the fact finder *may* draw an inference that testimony by a “missing witness” would have been adverse.<sup>9</sup> As a general matter, there are two criteria that must be applied to permit the adverse inference. First, the uncalled witness must be important and must have relevant information.<sup>10</sup> This element would clearly be met as to any inventor in any patent case. Second, the uncalled witness must be peculiarly within the control of one party; that is, must be both physically and practically available to only one party.<sup>11</sup> In circumstances in which the witness’ deposition testimony is actually used at trial (usually by the party seeking the adverse interest), the justification for the adverse inference becomes less compelling.<sup>12</sup>

Finally, it should be noted that both the Fifth and Eighth Circuits have questioned the so-called “missing witness rule” but neither circuit has abandoned it.<sup>13</sup>

## VII. PRESENTATION OF PROOF

### A. Examination of Witnesses

#### 1. *Order of Witnesses*

[Delete the first paragraph and replace it with the following text.]

The jury must be able to grasp the significance of each fact—preferably at the time it is presented—and understand its relationship to all other facts. If at all possible, the order in which witnesses are called to the stand must be dictated by this reality and not the convenience of the witnesses.<sup>14</sup> If a story model has been adopted for the presentation, the evidence ideally should unfold with each fact acting as a building block or foundation for the next. Even so, the presentation for proof must be logical and must account for the personal

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<sup>9</sup> See J.P. McCahey, *The Missing Witness Rule: Its Application at Civil Trials*, TRIAL EVIDENCE JOURNAL, 12 (Summer/Fall 2005), and cases cited therein.

<sup>10</sup> *Id.* at 13.

<sup>11</sup> *Id.*

<sup>12</sup> *Bogosian v. Woloohojian Realty Corp.*, 323 F.3d 55, 68 (1st Cir. 2003) (*citing* *Cameo Convalescent Ctr., Inc. v. Senn*, 738 F.2d 836, 844 (7th Cir. 1984)).

<sup>13</sup> See McCahey at 13–14.

<sup>14</sup> Bench trials should be handled no differently. A judge, like a juror, processes information more effectively if presented chronologically. The presentation of witnesses in a bench trial still must be designed to tell the story of the case and the technology in the most effective and persuasive fashion. A judge without a technical background, not versed in the law of patent infringement, is no better positioned than a juror to piece together a puzzle of evidence that is not presented in a logical fashion.

idiosyncrasies of the witnesses being presented. The reality is that some witnesses will perform better than others on the stand. It is critical that the presentation of testimony begin with a witness capable of relating well to the jury so as to lay the foundation for a solid relationship. Infringement may well be the focus of the legal aspect of the trial but the jurors want to know the players. The best approach to use in unfolding the story of the case is to begin by introducing the personalities involved. This should be done before the jurors hear the more difficult, and likely somewhat scary, evidence regarding the technology and patents. The urge to start the presentation with the foundation for the ultimate scientific or legal conclusion desired of the jury should be repressed. Instead, begin the presentation with a business person who is well-suited to describe the company, its products, its goals, and its people. This permits the jurors the opportunity to become comfortable in their role before being inundated with the details of the science. At the beginning of the average patent infringement trial, neither the judge nor the jury will have even a minimal level of comprehension of the science or the legal or factual issues. But as discussed above, they understand people. If provided with a solid grounding in who the people are and whether they are likeable and trustworthy, the jurors will be more open and trusting as the technical evidence is presented.

It is critical to the presentation of the case to have good witnesses at the beginning and end of the presentation of proof. The first impression made with the jurors is as important as the last impression. These witnesses should be well-dressed, well-mannered, comfortable in their own skin, and lively yet unlikely to be emotional. When the case is properly tried, the level of comprehension of the jurors increases rapidly in the middle and later stages of trial. The usual patent case should start slowly but move rapidly at the end when the jury has become familiar with the terminology and scientific concepts.

### 5. *Examining the Expert Witness*

[Add the following text after the fourth paragraph.]

In the unusual circumstance in which the district court has not interpreted the claims prior to the close of the evidence, care should be taken to elicit from any expert testifying on infringement issues, invalidity, or enforceability, the precise claim construction upon which his opinion is based. This creates a subtle problem, however, because it is improper for experts to provide testimony before a jury as to the proper construction of the claims themselves, even in the absence of a prior court construction.<sup>15</sup> Thus the testimony of the expert must be limited in these circumstances only to advising the jury as to the

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<sup>15</sup> See e.g., *CytoLogix Corp. v. Ventana Medical Sys. Inc.*, 424 F.3d 1168, 1172, 76 USPQ2d 1592, 1596 (Fed. Cir. 2005) (“The risk of confusing the jury is high when experts opine on claim construction before the jury even when, as here, the district court makes it clear to the jury that the district court’s claim constructions control.”).

construction he has adopted and not include his explanation as to why he believes that construction to be correct.

[Add at the end of the last paragraph.]

## **B. Evidentiary Issues**

### *1. The Inventor Notebooks*

[Add the following text at the end of the subsection.]

Even if an inventor's notebook is admitted into evidence, the value of the notebook for purposes of corroborating testimony elicited at trial may be questionable.<sup>16</sup> A rule of reason analysis is applied to determine whether an alleged inventor's testimony is corroborated by the so-called inventor's notebook.<sup>17</sup> The Federal Circuit has laid out a fairly neat test to determine the value of such a notebook within the context of a rule of reason analysis.<sup>18</sup> The court considers four factors when evaluating the corroborative value of an inventor's notebook: first, whether the author testified to the document's authenticity at trial; second, whether the author otherwise attested to the authenticity of the document; third, whether the notebook been signed or witnessed; and finally, whether the notebook has been maintained in reasonable accordance with good laboratory practices sufficient to reasonably ensure its genuineness under the circumstances.<sup>19</sup> If these requirements are not met, the value of the notebook as corroborative evidence will be minimal.<sup>20</sup>

## VIII. RULE 50 AND 52 MOTIONS

[Add the following text after main heading.]

Federal Rules of Civil Procedure 50 and 52 provide a means to shorten trial, or (in Rule 50 alone) set aside a jury verdict, in the event that a party with the burden of proof has utterly failed to meet its burden. Rule 50 applies in jury trials; Rule 52 is applicable in bench trials. Both rules only come into play after the party with the burden of proof on a particular issue has been fully heard. As discussed below, timing is critical in either of these motions, and failure to timely assert the appropriate motion will result in a failure to preserve issues for appeal.

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<sup>16</sup>Medichem, S.A. v. Rolabo, S.L., 437 F.3d 1157, 1173, 77 USPQ2d 1865, 1876 (Fed. Cir. 2006).

<sup>17</sup>Chen v. Bouchard, 347 F.3d 1299, 1309, 68 USPQ2d 1705, 1711 (Fed. Cir. 2003) (*citing* Price v. Symsek, 988 F.2d 1187, 1195, 26 USPQ2d 1031, 1037 (Fed. Cir. 1993)) ("A 'rule of reason' analysis is applied . . . . An evaluation of *all* pertinent evidence must be made so that a sound determination of the credibility of the inventor's story may be reached." (citations omitted)).

<sup>18</sup>Medichem, 437 F.3d at 1164–65, 77 USPQ2d at 1876.

<sup>19</sup>*Id.* at 1173, 77 USPQ2d at 1876.

<sup>20</sup>*Id.*

### A. Rule 50 Motion for Judgment as a Matter of Law

[Replace the first two paragraphs of the subsection with the following:]

#### 1. Rule 50(a) Judgment as a Matter of Law [NEW SECTION]

In a Rule 50(a) motion, a party seeks to have the court enter judgment as a matter of law (JMOL) against the nonmoving party before the jury has deliberated. The rule itself contains the standard to be applied in considering the motion: whether there is a legally sufficient evidentiary basis upon which a jury could find for the nonmoving party on the particular issue raised. Older practitioners will remember that the motion formerly was known as a Motion for Directed Verdict. This was changed by the 1991 Amendments to Rule 50; a change made specifically to adopt the language of Federal Rule of Civil Procedure 56(c) governing summary judgments “as a matter of law.” It is not surprisingly, then, that the standard applied in a Rule 50 motion is the same as the standard for a Rule 56 motion: the facts must be accepted as established, and all reasonable inferences from those facts must be drawn in the nonmovant’s favor.<sup>21</sup> In pressing a Rule 50(a) motion, the moving party must recite facts sufficiently specific regarding its factual basis to inform the non-moving party of the purported deficiencies in its evidence, thus providing the nonmoving party an opportunity to cure these deficiencies and to inform the trial court of the precise issues it must decide in ruling on the Motion.<sup>22</sup>

In the typical patent jury trial, the patentee will present proof first as to infringement and, if the trial is not bifurcated, on damages. The accused infringer typically will move for JMOL after the close of the patentee’s case-in-chief. If not granted, the motion must be renewed at the close of all evidence<sup>23</sup> and again after the jury renders its verdict if the verdict is against the patentee. The defenses asserted by the infringer will likely include both noninfringement and invalidity, if not others. Once the case-in-chief of the accused infringer has closed, the patentee must move for JMOL on these issues, or it will fail to preserve the right to renew the motion JMOL after the jury’s verdict is rendered, thus effectively defeating the right to raise issues on appeal.

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<sup>21</sup> *Allied Colloids Inc. v. American Cyanamid Co.*, 64 F.3d 1570, 1572, 35 USPQ2d 1840, 1841 (Fed. Cir. 1995). *Cf.* *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1546, 220 USPQ2d 193, 196 (Fed. Cir. 1983). However, the *Connell* court also noted that:

[d]eference due a jury’s fact findings in a civil case is not so great, however, as to require acceptance of findings where . . . those findings are clearly and unquestionably not supported by the substantial evidence. To so hold would be to render a trial and the submission of evidence a farce.

*Id.*

<sup>22</sup> *Junker v. Eddings*, 396 F.3d 1359, 1363, 73 USPQ2d 1850, 1853 (Fed. Cir. 2005) (citations omitted).

<sup>23</sup> Rule 50 uses slightly inconsistent language. In stating the earliest time at which the motion may be made, it provides that it “may be made at any time before submission of the case to the jury.” FED. R. CIV. P. 50(b)(2). Rule 50(b) also makes reference to “motion[s] for judgment as a matter of law made at the close of *all* the evidence . . .” (emphasis added). This language confirms the risks attendant with failure to restate the motion JMOL at the close of all the evidence: that a motion made only at the close of the plaintiff’s case in chief (or the defendant’s) but not renewed at the close of *all* evidence will be treated as if it had not been made at all.

The timing for filing a Rule 50(a) motion JMOL is critical and specific. The motion may be raised once a party has been fully heard on an issue but must be raised, in any event, before the jury commences its deliberations.<sup>24</sup> The requirement that a party be “fully heard,” however, does not preclude consideration of a motion before the close of the nonmovant’s case. The commentary to the Rules makes this plain. The court may perform its duty to enter judgment as a matter of law “at any time during the trial, as soon as it is apparent that either party is unable to carry a burden of proof that is essential to that party’s case.”<sup>25</sup> Although not typical, it is conceivable that a party’s proof is so defective as to obviate the need to defer the motion until the close of the evidence. The ability for the court to take early action to end the trial and enter judgment for the defendant is necessary where “economy and expedition will be served.”<sup>26</sup> Yet the court may not enter judgment before apprising the party against whom judgment will be entered of the materiality of the dispositive fact and providing an opportunity to present any additional evidence bearing on that material fact.<sup>27</sup>

It might be assumed that a party, having survived a motion for summary judgment (having the same standard) may survive a motion JMOL. But this is not necessarily the case, particularly if the record on summary judgment has been muddled. Although not a patent infringement action, in *Hi Limited Partnership v. Winghouse of Florida, Inc.*, an action directed to whether Hooters’ Restaurant had a protectible trade dress, the court granted JMOL before the close of all evidence at the trial despite having permitted the plaintiff to survive summary judgment. Hi Limited survived summary judgment only because “[p]resented with these differing interpretations of Hooters’ trade dress, the Court is unable to meaningfully assess questions of distinctiveness, secondary meaning and functionality. On the other hand, there obviously *is* a trade dress associated with Hooters, a prominent component of which is the Hooters Girl.”<sup>28</sup> Later, at trial and during argument on the motion JMOL, the court finally was able to “pin down” plaintiff’s counsel regarding the factors Hi Limited was contending constituted protectible trade dress. In concluding that these elements could not constitute protectible trade dress, the court granted JMOL before the close of all the evidence.<sup>29</sup>

The rationale adopted by the *Hi Limited* court is equally applicable in a patent infringement action. A patentee may well survive summary disposition

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<sup>24</sup>FED. R. CIV. P. 50(a)(1).

<sup>25</sup>FED. R. CIV. P. 50(a), Advisory Committee Notes, 1991 Amendment.

<sup>26</sup>FED. R. CIV. P. 50(a), Advisory Committee Notes, 1991 Amendment:

The revision authorizes the court to perform its duty to enter judgment as a matter of law at any time during the trial, as soon as it is apparent that either party is unable to carry a burden of proof that is essential to that party’s case. Thus, the second sentence of paragraph (a)(1) authorizes the court to consider a motion for judgment as a matter of law as soon as a party has completed a presentation of a fact essential to that party’s case. Such early action is appropriate when economy and expedition will be served.

<sup>27</sup>*Id.*

<sup>28</sup>347 F. Supp. 2d 1256, 1258 (M.D. Fla. 2004).

<sup>29</sup>*Id.* at 1257–58.

of an infringement claim only because it is unwilling or unable to articulate the specifics of its infringement analysis with sufficient degree to permit entry of summary judgment by the court. At trial, however, a Rule 50 motion will require a detailed argument to the court and will require the patentee to choose between multiple theories of its case. This done, JMOL then may be appropriate.

## 2. Rule 50(b) Renewing Motion JMOL After Trial [NEW SECTION]

A motion JMOL must be renewed under Rule 50(b) within 10 days after entry of the judgment if a party has any hope of preserving the right to contest the sufficiency of the evidence underlying the jury's verdict.<sup>30</sup> No new issue may be raised under Rule 50(b) that was not first raised in the Rule 50(a) motion. Here again, timing is critical because a party's "renewed" motion can be "renewed" only if a motion JMOL was timely made at the close of the evidence.<sup>31</sup> A post-trial motion JMOL can be granted only on grounds advanced in the pre-verdict motion.<sup>32</sup> In the circumstance in which a party moves for JMOL under Rule 50(a) but fails to renew that motion under Rule 50(b), it will be foreclosed from seeking the relief sought under Rule 50(a).<sup>33</sup>

## IX. THE CHARGE CONFERENCE

[Add the following text after footnote 184]

To be fair, the opinions of the Federal Circuit are not devoid of guidance regarding jury instructions. For example, in *United States Surgical Corp. v. Ethicon, Inc.*,<sup>34</sup> the court put its imprimatur on several instructions relating to the level of ordinary skill in the art, obviousness, and secondary considerations of non-obviousness. As to the level of ordinary skill in the art, it found sufficient an instruction that the jury should consider evidence submitted by the parties to show:

- One, the educational level of active workers in the field;
- Two, the types of problems encountered in the art;
- Three, the nature of the prior art solutions to those problems;
- Four, the activities of others;
- Five, the rapidity with which innovations are made in the art;
- And six, the sophistication of the technology involved.<sup>35</sup>

<sup>30</sup>FED. R. CIV. P. 50(b).

<sup>31</sup>*Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1281, 54 USPQ2d 1673, 1678 (Fed. Cir. 2000).

<sup>32</sup>FED. R. CIV. P. 50(b), Advisory Committee Notes, 1999 Amendment.

<sup>33</sup>The United States Supreme Court recently addressed the interplay of a Rule 50(b) motion for new trial with the requirements of Rule 50(a). It noted that "[I]f . . . a litigant that has failed to file a Rule 50(b) is foreclosed from seeking the relief it sought in its Rule 50(a) motion—i.e., the entry of judgment—then surely respondent is foreclosed from seeking a new trial, relief it did not and could not seek in its preverdict motion." *Unitherm Food Sys., Inc. v. Swift-Eckrich, Inc.*, 126 S. Ct. 980, 987, 77 USPQ2d 1961, 1966 (2006).

<sup>34</sup>103 F.3d 1554, 41 USPQ2d 1225 (Fed. Cir. 1997).

<sup>35</sup>103 F.3d at 1564, 41 USPQ2d at 1233.

*Main volume footnote updates begin on page 149.*

The jury instructions included explanation of the principles to be applied in determining obviousness when the invention is a combination of prior art components. The Federal Circuit approved the district court instruction that the prior art must show not only all of the elements of the claimed combination, but must contain some “teaching, suggestion or incentive” to a person of ordinary skill to combine the known elements in the way that U.S. Surgical combined them. Its instruction provided that:

In order to prove obviousness, the defendants must prove, again by clear and convincing evidence, that one of ordinary skill in the art would have found in the prior art references some teaching, suggestion or incentive to combine the prior art references in the way that U.S. Surgical did in its invention.<sup>36</sup>

The Federal Circuit also found acceptable an instruction to the jury that stressed that the prior art, to be invalidating, must sufficiently teach or direct a person of ordinary skill how to obtain the result reached by the patentee:

Additionally, if you do find a teaching in the prior art that would motivate one of ordinary skill in the prior art to make the clip applier claimed in the ‘057 and ‘420 patents, you must also determine whether there was sufficient teaching or direction in the prior art of how to obtain or build the claimed clip applier such that a person of ordinary skill in the art would have a reasonable likelihood of success in making the invention. In other words, in order to find obviousness, you must find not only that the prior art would teach one of ordinary skill to try the combination of known elements, but also that the prior art would sufficiently teach or direct one of ordinary skill how to obtain the desired result.<sup>37</sup>

Finally, the jury was given an instruction, thereafter approved by the Federal Circuit, that in determining obviousness, it was to consider the claim as a whole and that the claim may not suffice if the individual elements of the invention were known in the prior art:

The reason you must consider the claim as a whole is because there is no dispute that U.S. Surgical’s invention is comprised of individual elements which were known in the prior art. The fact that U.S. Surgical’s inventions incorporate or combine elements already known in the prior art does not render its patents invalid. Patents can be granted on devices that contain a combination of various elements that are well known in the prior art. U.S. Surgical’s claim is that it invented the combination of those elements for the first time in the endoscopic multiple clip applier claimed in the patents in suit.<sup>38</sup>

[Add the following text after the first full paragraph on page 859.]

A particularly delicate situation arises when the district court has failed to construe the claims until after the close of all the evidence. In this circumstance, the jurors likely will have heard evidence of infringement from experts based upon alternative claim constructions. In such an event, it is important

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<sup>36</sup> *Id.*

<sup>37</sup> *Id.*

<sup>38</sup> 103 F.3d at 1564-65, 41 USPQ2d at 1233.

to consider objections to the substance of the instructions regarding the construction of the claims themselves. Equally important is the consideration of whether instructions pertaining to infringement, invalidity or unenforceability are properly supported by the evidence. This is particularly important where an expert's opinion is elicited based on alternative claim constructions. Proposed instructions, and appropriate objections, may vary widely in light of the construction ultimately adopted by the court.<sup>39</sup> Testifying experts must make clear the claim construction upon which their opinions of infringement are based. A witness' failure to do so may be grounds to assert an objection to a particular instruction.

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<sup>39</sup>Quite obviously, in this event, the failure by an expert to specify the claim construction on which his opinion is based should give rise to a motion JMOL as well.



## MAIN VOLUME FOOTNOTE UPDATES

<sup>5</sup>[Add to the end of footnote 5.] Other jurisdictions (or individual judges) have adopted local rules for patent cases. *See e.g.*, “Proposed Local Rules of Practice for Patent Cases” of the U.S. District Court for the Southern District of California, <http://www.casd.uscourts.gov/> (last visited on July 30, 2006); the United States District Court for the District of Minnesota, <http://www.mnd.uscourts.gov/>; “Patent Rules” of Judge Charles A. Shaw of the Eastern District of Missouri, <http://www.moed.uscourts.gov/Judge/chambers.asp?Judge=12> (last visited on July 30, 2006).

<sup>14</sup>[Add to the end of footnote 14.] The *Civil Litigation Management Manual*, published by the Committee on Court Administration and Case Management of the Judicial Conference of the United States, encourages judges to adopt the use of interim summations or supplemental opening statements by counsel as a means of enhancing juror comprehension during trial. CIVIL LITIGATION MANAGEMENT MANUAL 87 (2001).

<sup>22</sup>[Add to the end of footnote 22.] A comparison of the properly construed claims to the accused product or process is strictly a factual determination. *Invitrogen Corp. v. Clontech Labs., Inc.* 429 F.3d 1052, 1075, 77 USPQ2d 1161, 1177 (Fed. Cir. 2005).

<sup>25</sup>[Add to the end of footnote 25.] ; *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1164–65, 77 USPQ2d 1865, 1870 (Fed. Cir. 2006) (whether a skilled artisan would have perceived a “reasonable expectation of success” in making an invention based upon a given combination of prior art elements is a question of fact); *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348–49, 53 USPQ2d 1580, 1586 (Fed. Cir. 2000) (whether a motivation to combine prior art references has been demonstrated and what a reference teaches and whether it teaches away or toward the claimed invention are questions of fact). Note, however, that “the ultimate determination of whether an invention would have been obvious is a legal conclusion based on underlying findings of fact.” *See In re Kahn*, 78 USPQ2d 1329, 1334 (Fed. Cir. 2006). As with obviousness, the question of whether a given prior art reference anticipates a claimed invention is a question of fact in the patent context. *Seachange, Int’l v. C-COR Inc.*, 413 F.3d 1361, 1379 (Fed. Cir. 2005). Enablement and conception, like obviousness, are questions of law based upon factual findings determined by the jury (if the trial is to a jury). *See Liquid Dynamics Corp. v. Vaughan Co., Inc.*, 449 F.3d 1209, 1224 (Fed. Cir. 2006); *Invitrogen Corp.*, 429 F.3d at 1063, 1070.

Of particular interest is the question of whether a determination of the equivalents to the “means” in a means-plus-function element is to be determined by a jury at trial or by the court during claim construction. Clearly, what constitutes equivalents to the means (of the means-plus-function element) is a purely factual determination. *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1317–18, 76 USPQ2d 1662, 1669 (Fed. Cir. 2005). Yet the Federal Circuit recently has indicated that it will not find error in instructions to the jury that define the “possible equivalents” to the means in

a means-plus-function element as long as the instruction is not “incorrect factually.” *See On Demand Machine Corp. v. Ingram Indus., Inc.*, 442 F.3d 1331, 1341, 78 USPQ2d 1428, 1435 (Fed. Cir. 2006) (“Although equivalents do not lose their factual identity in a means-plus-function context, in the uncertain boundary between law and fact in claim construction, the giving of an instruction that is not incorrect factually is not reversible error.”).

<sup>30</sup>[**Add to the end of footnote 30.**] It has long been true that a trial judge may not properly hold a bench trial on equitable declaratory relief claims, without consent of both parties, if resolution of those claims would resolve “common” issues to those for which a jury trial demand had been made. *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 503-04 (1959). However, where the equitable issues are not “common” to those subject to jury resolution, a bench trial is appropriate as the Federal Circuit recently noted in *Agfa Corp. v. Creo Prods., Inc.* 451 F.3d 1366, 1372 (Fed. Cir. 2006) (“[a] judge has the discretion to conduct a bench trial on the equitable issue of unenforceability in the same case where invalidity is to be tried to a jury.”)

<sup>48</sup>[**Add to the end of footnote 48.**] The Judicial Conference of the United States recommended that judges adopt the use of juror notebooks to “improve jurors’ performance, promote juror satisfaction with their service, and enhance the court’s public image.” CIVIL LITIGATION MANAGEMENT MANUAL 87 (2001).

<sup>176</sup>[**Add to the end of footnote 176.**] Like Rule 50, Rule 52 is not unique to patent law and regional circuit law is applied to determine whether a district court properly granted a Rule 52(b) motion. *Golden Blount, Inc. v. Robert H. Peterson Co.*, 438 F.3d 1354, 1358, 78 USPQ2d 1004, 1007–08 (Fed. Cir. 2006).

<sup>178</sup>[**Replace the citation to *NTP, Inc. v. Research in Motion, Ltd.* with the following citation in footnote 178.**] *NTP Inc. v. Research in Motion, Ltd.*, 392 F.3d 1336, 1365–66, 73 USPQ2d 1231, 1257 (Fed. Cir. 2004) (remanding the erroneous jury instruction claim to the district court for proper resolution in a patent infringement case brought by an owner of several patents for a method of sending e-mail over wireless networks), *opinion withdrawn and superceded on reh’g in part by*, 418 F.3d 1282, 1312, 75 USPQ2d 1763, 1785 (Fed. Cir. 2005).

<sup>178</sup>[**Add to the end of footnote 178.**] Prejudicial error in a jury instruction exists only if there is sufficient evidence adduced at trial to support a finding contrary to that found by the jury had a correct jury instruction been given. “[T]o warrant a new trial [or reversal] . . . the erroneous jury instruction [must have been] in fact prejudicial. When the error in a jury instruction could not have changed the result, the erroneous instruction is harmless.” *CytoLogix Corp. v. Ventana Medical Sys., Inc.* 424 F.3d 1168, 1175, 76 USPQ2d 1592, 1597 (Fed. Cir. 2005) (*citing Ecolab Inc. v. Paraclipse, Inc.*, 285 F.3d 1362, 1374, 62 USPQ2d 1349, 1356 (Fed. Cir. 2002)); *see NTP, Inc. v. Research in Motion, LTD.*, 418 F.3d 1282, 1311, 75 USPQ2d 1763, 1785 (Fed. Cir. 2005).

<sup>179</sup>[**Add to the end of footnote 179.**] In fact, the Federal Circuit recently reiterated the standard for setting aside a jury verdict based upon erroneous jury instructions as requiring the party challenging the verdict to establish:

(1) it made a proper and timely objection to the jury instruction; (2) those instructions were legally erroneous; (3) the errors had prejudicial effect; and (4) the party seeking to set aside the verdict requested alternative instructions that would have remedied the error. *NTP, Inc. v. Research in Motion, LTD.*, 418 F.3d 1282, 1311, 75 USPQ2d 1763, 1785 (Fed. Cir. 2005) (*citing* *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1281 (Fed. Cir. 2000)); *see also*, *Seachange, Int'l v. C-COR Inc.*, 413 F.3d 1361, 1381, 75 USPQ2d 1385, 1399 (Fed. Cir. 2005).

<sup>186</sup>**[Add after the citation to Rule 51 near the beginning of footnote 186.]**

Objections must be specific in nature. An objection that asserts an instruction to be generally confusing or containing paraphrasing will lack the necessary specificity to establish a viable Rule 51 objection. *See e.g.*, *Eli Lilly v. Aradigm Corp.*, 376 F.3d 1352, 1361, 71 USPQ2d 1787, 1793 (Fed. Cir. 2004). The purpose of Rule 51 is “to ensure that objections point out to a district court its alleged error so that the district court has the first opportunity to correct the error.” *Id.* (*citing* *Palmer v. Hoffman*, 318 U.S. 109 (1943)).

<sup>186</sup>**[Add to the end of footnote 186.]** *See also* *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282, 54 USPQ2d 1673, 1679 (Fed. Cir. 2000). The futility exception was recognized by the Federal Circuit in *Ecolab Inc. v. Paraclipse Inc.*, 285 F.3d 1362, 1369–70, 62 USPQ2d 1349, 1354 (Fed. Cir. 2002) (*citing* 9 JAMES WM. MOORE, ET AL., *MOORE’S FEDERAL PRACTICE* §51.12[2][a] (3d ed. 1997)).

<sup>203</sup>**[Add to the end of footnote 203.]** *See also* the recent Supreme Court decision regarding the standard for issuance of a permanent injunction, *eBay Inc. v. MercExchange, L.L.C.*, 126 S. Ct. 1837, 78 USPQ2d 1577 (U.S. 2006). The *eBay* court unanimously declined to adopt a general rule that injunctions should issue once infringement and validity have been established. Instead, the court relied upon traditional rules of equity that:

a plaintiff seeking a permanent injunction must satisfy a four-factor test before a court may grant such relief. A plaintiff must demonstrate: (1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction.

*Id.* at 1839, 78 USPQ2d at 1578. The court also recognized that the Patent Statute, like the Copyright Act, uses permissive language when referring to the grant of an injunction, i.e., “may grant an injunction” rather than “shall grant an injunction.”

The issuance of an injunction is by statute permissive and governed by the rules of equity. Section 283 of the patent statute clearly provides only that a court “may grant injunctions in accordance with the principles of equity.” Nevertheless, the Federal Circuit previously looked upon the grant of an injunction where a valid patent is infringed as being the “general rule.” *MercExchange, L.L.C. v. eBay Inc.*, 401 F.3d 1323, 1338, 74 USPQ2d 1225, 1237 (Fed. Cir. 2005), *rev'd by* 126 S. Ct. 1837, 78 USPQ2d 1577 (U.S. 2006). It advocated

a position that a district court may decline to enter an injunction when a patentee's failure to practice the patented invention frustrates an important public need for the invention, such as the need to use an invention to protect public health. Although it is unclear at this time just how the Supreme Court's ruling in the *eBay* case will change a district court's consideration of injunctions, it is essential at trial to be prepared, whether as a patentee or accused infringer, to present evidence relevant to the four equitable factors that traditionally govern the issuance of injunctions.