

MODEL JURY INSTRUCTIONS ON NONOBVIOUSNESS IN THE WAKE OF *KSR*: THE NORTHERN DISTRICT OF CALIFORNIA'S APPROACH

By Tolga S. Gulmen

Following the Supreme Court's decision in *KSR International Co. v. Teleflex Inc.*,¹ the Northern District of California's model patent jury instruction committee revised the jury instructions for nonobviousness.² The model jury instructions reflect the Court's reaffirmation that the determination of nonobviousness is a matter of law by recommending that the judge determine the ultimate question of nonobviousness based upon a jury's determination of the underlying facts. Towards that end, the model jury instructions suggest two alternative means. The first charges the jury to decide the factual underpinnings without addressing whether the patent was nonobvious. The second provides for an expanded role for the jury in deciding the issue of nonobviousness. However, under the Northern District's approach, the jury may only make a nonbinding advisory verdict freeing the trial judge to make the ultimate determination of nonobviousness irrespective of the jury's determination on the issue.

The Northern District's model jury instructions also reflect the Court's holding that the teaching-suggestion-motivation (TSM) test need not be satisfied for a determination of obviousness. In fact, the 2007 revision to the advisory verdict jury instructions suggests that the jury may find such a teaching or suggestion to motivate the combination of prior art, but finding a teaching or suggestion is not necessary. However, where the jury only makes factual determinations, all such language is removed from the jury instruction leaving it in the hands of the trial judge to make the necessary determination.

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1. 127 S. Ct. 1727 (2007).

2. Claudia Wilkin, *Model Patent Jury Instructions for the Northern District of California*, in DEVELOPMENTS IN PHARMACEUTICAL AND BIOTECH PATENT LAW 2008, at 335 (PLI Patents, Copyrights, Trademarks, & Literary Prop., Course Handbook Series No. 17180, 2008).

This Note will first provide background in nonobviousness jurisprudence in the wake of *KSR* and case law on the jury verdicts on nonobviousness. The Note will then investigate the Northern District's model jury instructions and compare them to the later-proposed National Jury Instruction Project's model jury instructions. Finally, the Note will conclude by suggesting that neither *KSR*, nor previous precedent, mandates the Northern District's approach to strip the jury of a binding determination on the issue of nonobviousness, and that consequently litigants and trial judges have room to shape the scope of the jury's role in the nonobviousness determination.

I. NONOBVIOUSNESS IN THE WAKE OF *KSR*

The doctrine of nonobviousness has its roots in equity. In 1851 the Supreme Court held in *Hotchkiss v. Greenwood* that a doorknob patent was invalid because it did not require any more "ingenuity and skill" than would be possessed by an "ordinary mechanic" familiar with the industry, thereby expanding the requirements for patentability.³ The patent at issue concerned a doorknob with a porcelain handle connected to a metal shank by a dovetail joint.⁴ Each of the elements was known in the prior art, but the combination of the elements could not be found in the prior art.⁵ The Court for the first time addressed whether the combination of known elements in a new way showed significant "ingenuity and skill" to merit a patent monopoly when viewed through the eyes of the ordinary mechanic familiar with the industry.⁶ The Court used its powers in equity to establish the precedent that not all innovations are worthy of the grant of the patent monopoly.

A century later, Congress codified the judicial requirement of nonobviousness in the 1952 Patent Act.⁷ The statute states that no patent shall be granted where "the differences between 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 to which said subject matter pertains."⁸

3. *Hotchkiss v. Greenwood*, 52 U.S. 248, 267 (1851).

4. *Id.* at 264-67.

5. *Id.* at 264-67.

6. *Id.* at 267.

7. Patent Act of 1952, Pub. L. No. 593, § 103, 66 Stat. 792, 798 (codified as amended at 35 U.S.C. § 103 (2006)).

8. *Id.*

Over a decade later, the Supreme Court in *Graham v. John Deere Co. of Kansas City*⁹ enumerated the factors that needed to be considered for the determination of nonobviousness. Following *Graham*, the Federal Circuit developed the two-pronged test for the legal conclusion on the issue of nonobviousness. The first prong was the TSM test, while the second prong considered whether there was a reasonable expectation of success in combining familiar elements. The Supreme Court in *KSR* held that the TSM test may be sufficient, but was not necessary, for a determination of obviousness. The Supreme Court stressed equitable considerations in contrast to the Federal Circuit's rigid adherence of the TSM test.

A. *Graham*

First, the Supreme Court in *Graham* held that the 1952 Patent Act did not undercut the Court's line of cases on nonobviousness.¹⁰ Rather, the codification of nonobviousness simply continued the line of nonobviousness jurisprudence that had its genesis in 1851 with the Court's *Hotchkiss* decision.¹¹

The Court's second holding outlined the framework by which nonobviousness was to be determined. The Court held that there are three factual inquiries that need to be evaluated. The first inquiry discerns what is the scope and content of the prior art.¹² The second determines the differences between the prior art and the claims at issue.¹³ The third ascertains the level of ordinary skill in the art.¹⁴ Against this backdrop, secondary considerations, such as commercial success or long felt need, may be presented to shed light onto the circumstances surrounding invention.¹⁵

Finally, the Court held that the obviousness determination is a matter of law.¹⁶ While the ultimate conclusion of the issue of validity is legal, the *Graham* framework requires many factual inquiries to be determined. Thus, nonobviousness is a mixed question of law and fact. The tension between the legal and factual nature of the nonobviousness analysis implicates the role of juries. Therefore, one may well be concerned with the best means of utilizing the jury towards that end.

9. 383 U.S. 1 (1966).

10. *Id.* at 17.

11. *Id.* at 12-17.

12. *Id.* at 17.

13. *Id.*

14. *Id.*

15. *Id.* at 17-18.

16. *Id.* at 17.

B. Between *Graham* and *KSR*

While the Supreme Court in *Graham* enumerated the factual inquiries to be considered, the legal determination was not as well settled. Over the years, courts have shaped the legal determination of obviousness with various tests.¹⁷ The Federal Circuit ultimately created a two-part test for the legal conclusion of obviousness: “whether a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and whether there would have been a reasonable expectation of success in doing so.”¹⁸

Federal Circuit case law also had a long history of requiring a teaching or suggestion to motivate the combination of prior art references,¹⁹ which became known as the TSM test. Like the *Graham* framework, the TSM test was itself highly factual. The test was essentially limited to the four corners of the prior art, requiring a prior art reference to explicitly teach, suggest, or motivate a combination of elements in order to support a finding of obviousness.²⁰ Thus the TSM test was essentially devoid of any conception of a person having ordinary skill in the art. In sum, the TSM test relegated the person having ordinary skill in the art to nothing more than a careful reader without any inherent creativity or ability to make either deductive or inductive inferences.

C. *KSR*

Reversing the Federal Circuit, the Supreme Court in *KSR* held that the patent at issue was invalid as obvious.²¹ The Court’s decision in *KSR* reaffirmed its line of nonobviousness jurisprudence while also holding that the factual inquiry required to satisfy the TSM test as a necessary condition to find a patent obvious was in contradiction to Supreme Court jurisprudence.²²

First, the Supreme Court reaffirmed that the conclusion of nonobviousness is a legal determination supported by the factual *Graham* inquiries.²³ However, the majority of the Supreme Court’s decision concerned

17. Justin Lee, Note, *How KSR Broadens (Without Lowering) the Evidentiary Standard of Nonobviousness*, 23 BERKELEY TECH. L.J. 15, 19-23 (2008) (discussing various legal tests employed for the determination of obviousness).

18. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006).

19. Lee, *supra* note 17, at 23-32.

20. *In re Gartside*, 203 F.3d 1305, 1319 (Fed. Cir. 2000).

21. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007).

22. *Id.* at 1739-41.

23. *Id.*

the rejection of the Federal Circuit's "rigid" application of the TSM test.²⁴ The Court held that the patent at issue was obvious even though the Federal Circuit's TSM test had not been satisfied.²⁵ Put differently, the TSM test may be sufficient to show obviousness, but is not necessary to show obviousness. The Court stated, "neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim."²⁶

The Supreme Court cited three flaws in the Federal Circuit's approach. First, the Federal Circuit erroneously concluded "that courts and patent examiners should look only to the problem the patentee was trying to solve."²⁷ Instead, the Court emphasized that obviousness should be objectively evaluated through the eyes of a person having ordinary skill in the art, not from the patentee's perspective.²⁸ Thus, "any need or problem known in the field of endeavor at the time of invention" may provide the requisite motivation to combine.²⁹ The Court effectively opened up the available evidence to be considered in an obviousness determination by explaining that a person having ordinary skill in the art would be more knowledgeable than previous Federal Circuit precedent would allow.³⁰ In sum, when presenting evidence to juries, the alleged infringer may have a wider array of references and prior art that can be presented as evidence of obviousness.

The second flaw was in the Federal Circuit's "assumption that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem."³¹ The Supreme Court explained that by using "common sense" a person having ordinary skill in the art would "be able to fit the teachings of multiple patents together like pieces of a puzzle."³² Further, the person having ordinary skill in the art also has "ordinary creativity" so as not to be bound by rigid rules of where and how to select from teachings in the field.³³ The Court highlights that "[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known

24. *Id.* at 1739.

25. *Id.* at 1734-35.

26. *Id.* at 1741-42.

27. *Id.* at 1742.

28. *Id.*

29. *Id.*

30. Lee, *supra* note 17, at 38-40.

31. *KSR*, 127 S. Ct. at 1742.

32. *Id.*

33. *Id.*

options within his or her technical grasp.”³⁴ The Supreme Court reasoned that this process is not innovation, but “ordinary skill and common sense.”³⁵ The Court effectively expanded a person having ordinary skill in the art’s ability to creatively solve problems. Thus, nonobviousness must be determined from the vantage of a person having ordinary skill in the art.

This expanded creativity and knowledge of a person having ordinary skill in the art may be too easily exploited to combine references through the use of hindsight.³⁶ However, the Court dismissed this worry by concluding that the Federal Circuit’s third error was that it “drew the wrong conclusion from the risk of courts and patent examiners falling prey to hindsight bias.”³⁷ While factfinders should be aware of the potential bias that hindsight may cause, “[r]igid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under [the Court’s] case law nor consistent with it.”³⁸ Thus juries and judges also possess “common sense,” which gives them ever greater flexibility in evaluating nonobviousness.

The Supreme Court in *KSR* appears to be steering lower courts back to the equitable roots of the nonobviousness doctrine, eschewing bright line tests for common sense. The return to common sense not only applies to the legal determination but also to the abilities of the person having ordinary skill in the art. The Court never held that the TSM test has no place in the determination of nonobviousness. However, common sense allows one to look past the four corners of the prior art and consider the context of the situation, similar to how a court might consider context when evaluating the terms of a contract agreement.³⁹

34. *Id.*

35. *Id.*

36. *In re Dembiczak*, 175 F.3d 994, 996 (Fed. Cir. 1999).

37. *KSR*, 127 S. Ct. at 1742.

38. *Id.* at 1742-43.

39. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 998 (Fed. Cir. 1995) (Mayer, J., concurring). Judge Mayer stated:

The principle that documentary interpretation is a matter of law has become a basic tenet of modern contract law. Equally established, however, is the caveat that extrinsic evidence, such as custom and usage of the trade and course of dealing between the parties, akin to prior art, level of skill in the art, and events in the Patent Office, may be introduced to inform the meaning of the terms in the contract. And when such evidence is brought in and creates a real conflict, it results in a question of fact for the jury.

Id.

II. IMPLEMENTING THE DETERMINATION OF NONOBVIOUSNESS AT TRIAL

The admixture of equitable and factual concerns inherent in the doctrine of nonobviousness creates a potential quandary at trial. How does one find the necessary facts as prescribed by *Graham*, while also keeping the equitable approach outlined in *KSR*? While juries are ideally suited to determine facts, judges are ideally suited to determine issues in equity. Thus, the nonobviousness jurisprudence creates a tension between the two.

The following sections examine the historical usage of juries for patent trials, showing that the number of juries utilized for patent cases is much more extensive today than even as recently as when *Graham* was decided in 1966. Even though there is much doubt as to a jury's ability to implement well reasoned verdicts, the Federal Circuit has not gone so far as to mandate the use of any particular type of jury verdict. Finally, a comparison of the possible verdict types will be presented.

A. Patent Trials Before Juries

Historically, there have been very few patent trials in front of juries even though the Patent Act of 1790 provided for damages to be assessed by juries for patent infringement.⁴⁰ The Patent Act of 1870 gave power to the courts of equity to award common law damages.⁴¹ This revision to patent law ushered in an era where patent cases were almost exclusively decided by a judge.⁴² Further amendments permitted courts sitting in equity to use advisory jury verdicts at the court's discretion.⁴³ Even with the union of the common law and equity courts in 1875,⁴⁴ patent trials before juries were rare. In 1940 only 2.5 percent of patent cases were tried before a jury.⁴⁵ By the late 1960's that percentage remained largely unchanged.⁴⁶ Use of a jury rose dramatically by the end of the millennium as the courts witnessed a nearly twentyfold increase to 59 percent of patent trials tried before a jury.⁴⁷ Despite this increase in the use of juries for patent trials, courts remain relatively inexperienced in managing patent trials.⁴⁸ The

40. Kimberly A. Moore, *Judges, Juries, and Patent Cases - An Empirical Peek Inside the Black Box*, 11 FED. CIR. B.J. 209, 210 (2001).

41. *Id.*

42. *Id.*

43. *Id.*

44. *Id.*

45. *Id.*

46. *Id.*

47. *Id.*

48. The inexperience of the courts also arises because few patent suits reach trial. *See id.* at 231. Efforts are underway to help courts gain greater understanding of the is-

increased use of juries also highlights the importance of the proper utilization of juries in patent trials.

Graham was decided in 1966, during the period in which almost all of the patent trials were determined by the bench and not by the jury.⁴⁹ Thus the Supreme Court in *Graham* may have been less concerned with the fact-law distinction. The Federal Circuit, on the other hand, would have routinely faced the issue of the fact-law distinction before juries following its inception in 1982.

B. No Mandate from the Federal Circuit

The Federal Circuit does not mandate the use of a particular set of jury instructions or verdict forms.⁵⁰ Instead the court chooses to bind itself to the regional circuit court precedent, but, naturally, the court is bound by the Federal Rules of Civil Procedure.⁵¹ At best, the Federal Circuit suggests that general jury verdicts should be avoided without mandating the use of more detailed verdict forms.⁵² Thus, the Federal Circuit creates a situation where each district, or even each bench, may utilize substantially different jury instructions and verdict forms.

Further, the Federal Circuit will not prohibit the use of any of the verdict options available under the Federal Rules.⁵³ The Federal Circuit notes that patent cases are not so distinct in their complexity from other types of cases, like antitrust cases, as to warrant a blanket prohibition against a particular type of jury verdict.⁵⁴ However, the Federal Circuit has also stressed that when obviousness is at issue, special verdict forms or interrogatories on the *Graham* factors should be employed.⁵⁵

sues involved in patent litigation. See PETER S. MENELL ET. AL., PATENT CASE MANAGEMENT JUDICIAL GUIDE, (UC Berkeley Public Law Research, Working Paper No. 1328659), available at <http://papers.ssrn.com=1328659> (providing extensive coverage of all aspects of patent case management issues). Further, proposed legislation seeks to direct patent trials to experienced trial courts. S. 299, 111th Cong. (1st Sess. 2009); H.R. 628, 111th Cong. (1st Sess. 2009).

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

50. *R.R. Dynamics, Inc. v. A. Stucki Co.*, 727 F.2d 1506 (Fed. Cir. 1984).

51. *Id.* at 1516-17.

52. See generally, *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707 (Fed. Cir. 1984).

53. *R.R. Dynamics*, 727 F.2d at 1514-25.

54. *Id.* at 1514-15.

55. *Id.* at 1516-17.

The Federal Circuit has stated that the form of the jury verdict is a matter of discretion for the trial court.⁵⁶ However, the Federal Circuit suggests the use of detailed verdicts by specifically noting that the jury's factual findings are beneficial.⁵⁷ The Federal Circuit further notes that "failure to utilize [a verdict form detailing factual findings] in a patent case places a heavy burden of convincing the reviewing court that the trial judge did not abuse his discretion."⁵⁸

The Federal Circuit also defers to the regional circuit's precedent on procedural matters.⁵⁹ The Federal Circuit adopted this position in an effort to minimize confusion between the district courts.⁶⁰ The Federal Circuit also held that it does not have supervisory power over the general business of the trial court.⁶¹ However, the Federal Circuit does reserve the ability to decide procedural issues in relation to substantive matters when those matters are "unique" to patent law.⁶²

The Supreme Court, while reviewing a doctrine of equivalents appeal, has signaled that the Federal Circuit may be able to "implement procedural improvements to promote certainty, consistency, and reviewability" at least in certain cases.⁶³ It is unclear if the Supreme Court was distinguishing the determination of the doctrine of equivalents as particularly unique to patent law. However, the Supreme Court has also stated that it lacks "the benefit of the Federal Circuit's informed opinion on the complex issue of the degree to which the obviousness determination is one of fact."⁶⁴

56. *Am. Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1361 (Fed. Cir. 1984).

57. *Id.*

58. *Id.* (quoting *A.B. Baumstimler v. Rankin*, 677 F.2d 1061, 1071-72 (5th Cir. 1982)).

59. *Panduit Corp. v. All States Plastic Mfg. Co.*, 744 F.2d 1564, 1574-75 (Fed. Cir. 1984).

60. *Id.*

61. *In re Innotron Diagnostics*, 800 F.2d 1077, 1082 (Fed. Cir. 1986).

62. *Panduit*, 744 F.2d at 1574-75.

63. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 39 n.8 (1997).

The Court explained:

With regard to the concern over unreviewability due to black-box jury verdicts, we offer only guidance, not a specific mandate Finally, in cases that reach the jury, a special verdict and/or interrogatories on each claim element could be very useful in facilitating review, uniformity, and possibly postverdict judgments as a matter of law. We leave it to the Federal Circuit how best to implement procedural improvements to promote certainty, consistency, and reviewability to this area of law.

Id.

64. *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809, 811 (1986).

Therefore, the Federal Circuit may be able to do more than merely suggest that detailed jury verdicts be used.⁶⁵ Indirectly, the Federal Circuit could repeatedly hold that failure to use a detailed verdict form with all factual determinations made by the jury clearly laid out is an abuse of discretion by the trial court.⁶⁶ Directly, the Federal Circuit could hold that the substance of the verdict form is a matter “unique” to patent law and, thereby, demand that a certain type of jury verdict be used.⁶⁷

C. Comparison of Verdict Types

The Federal Rules of Civil Procedure provide for a number of ways of obtaining a jury verdict. Notably there are four possible types of verdict forms: (1) general verdict, (2) general verdict with interrogatories,⁶⁸ (3) special verdict,⁶⁹ and (4) advisory verdict.⁷⁰ Each type of verdict has its own particular strengths and weaknesses. The first and second options would charge the jury with the ultimate conclusion of nonobviousness, which would be binding on the court. The third option, the special verdict, would charge the jury to determine only the factual inquiries relevant to the *Graham* analysis. Finally, the advisory verdict would charge the jury with making a determination of the ultimate question of nonobviousness. However, the advisory opinion would not be binding on the court.

1. Naked General Verdicts

General verdicts are the quintessential black box; they ask merely for a legal conclusion without any concern for stating the underpinnings of the conclusion.⁷¹ Their simplicity is their greatest strength. However, these verdicts are virtually unreviewable. Since there is no record of jury deliberation beyond the ultimate conclusion, a reviewing court assumes all necessary findings were in favor of the verdict unless there was substantial evidence to the contrary.⁷² In practice general jury verdicts are infrequent, which mitigates the risk of faulty jury decisions on the issue of obviousness.⁷³

65. See Kimberly A. Moore, *Juries, Patent Cases, & a Lack of Transparency*, 39 HOUS. L. REV. 779 (2002).

66. *Id.* 797-98.

67. *Id.* 798-99.

68. FED. R. CIV. P. 49(b).

69. FED. R. CIV. P. 49(a).

70. FED. R. CIV. P. 39(c).

71. Moore, *supra* note 40, at 213.

72. See *Am. Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1361 (Fed. Cir. 1984).

73. Moore, *supra* note 65, at 783.

While infrequent in practice, the Federal Circuit stated in *Connell v. Sears, Roebuck & Co.* that a jury may return a “naked general verdict” just like in any other civil suit.⁷⁴ However, the Federal Circuit disfavors this approach by noting that general verdicts “leav[e] a wide area of uncertainty on review.”⁷⁵ The court lists other procedural safeguards to defend against an “unruly or ‘rogue elephant’ jury”:⁷⁶ general verdict with interrogatories,⁷⁷ special verdicts,⁷⁸ directed verdicts,⁷⁹ judgment as a matter of law,⁸⁰ jury instructions to guide the legal conclusions,⁸¹ advisory juries,⁸² and grant of new trial.⁸³

The court suggests that the following elements be present when the court submits the question of obviousness to the jury: (1) detailed special interrogatories designed to determine the factual underpinnings of the *Graham* framework; and (2) appropriate instructions on the law that, at a minimum, the jury must consider the invention as a whole through the eyes of one having ordinary skill in the art at the time the invention was made.⁸⁴ Thus, the Federal Circuit has not mandated the use of other types of verdict options. The Federal Rules of Civil Procedure bind the court, and as long as the general verdicts are contained within the rules, there can be no prohibition against them.⁸⁵ The Federal Circuit refuses to accept the notion that patent cases substantially differ from other types of cases.⁸⁶

However, in *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, the Federal Circuit criticized the trial court for submitting the question of obviousness as a general verdict.⁸⁷ The verdict asked for a check if the following was true: “The subject matter of claim 7 would have been obvious to one of ordinary skill in the art at the time the claimed invention was made.”⁸⁸ The court recognized that the form of the jury verdict was nor-

74. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1546 (Fed. Cir. 1983).

75. *Id.*

76. *Id.*

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

78. FED. R. CIV. P. 49(a).

79. FED. R. CIV. P. 50(a).

80. FED. R. CIV. P. 50(b).

81. FED. R. CIV. P. 51.

82. FED. R. CIV. P. 52.

83. FED. R. CIV. P. 59.

84. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1547 (Fed. Cir. 1983).

85. *See R.R. Dynamics, Inc. v. A Stucki Co.*, 727 F.2d 1506, 1514-15 (Fed. Cir. 1984).

86. *Id.* at 1515.

87. *Am. Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1361 (Fed. Cir. 1984).

88. *Id.* at 1357.

mally within the discretion of the trial court.⁸⁹ The court, however, stated that special interrogatories should have been made.⁹⁰ The court suggested that it might be possible to find an abuse of the trial court's discretion to submit the obviousness question to a jury as a general verdict because "failure to utilize [special interrogatories] in a patent case places a heavy burden of convincing the reviewing court that the trial judge did not abuse his discretion."⁹¹

2. *General Verdicts with Interrogatories*

Interrogatories are designed to provide an understanding of how the jury arrived at its final verdict. When submitting interrogatories to the jury, the judge must provide instruction so that the jury can both answer to the interrogatories and render a general verdict.⁹²

The Supreme Court echoes praise for non-general verdict forms. "[I]n cases that reach the jury, a special verdict and/or interrogatories on each claim element could be very useful in facilitating review, uniformity, and possibly postverdict judgments as a matter of law."⁹³

The Federal Circuit speaks with similar appreciation for non-general jury verdicts. The Federal Circuit has suggested, but not mandated, that general verdicts "should . . . be accompanied by detailed special interrogatories designed to elicit responses to at least all of the factual inquires enumerated in *Graham*."⁹⁴ The court also notes that special interrogatories facilitate appellate and trial review for judgment as a matter of law.⁹⁵ Additionally, interrogatories make review less onerous for the reviewing court because the reviewing court does not have to consider every possible basis for the jury's decision.⁹⁶

Others echo these beneficial traits, claiming that devices such as general verdicts with interrogatories and special verdicts are superior to general verdicts because they check the jury, facilitate judicial review, depreciate bias in decision-making, and simplify jury instructions.⁹⁷ "By compelling a jury to consider factual issues individually, special verdicts and

89. *Id.* at 1361.

90. *Id.*

91. *Id.* (quoting *Baumstimler v. Rankin*, 677 F.2d 1061, 1071-72 (5th Cir. 1982)).

92. FED. R. CIV. P. 49(b)(1).

93. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 39 n.8 (1997).

94. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1547 (Fed. Cir. 1983).

95. *Am. Hoist & Derrick*, 725 F.2d at 1361.

96. *Id.*

97. Moore, *supra* note 65, at 783.

interrogatories may improve the consistency of jury verdicts as well as the underlying decision-making processes that produce them.”⁹⁸

However, the use of interrogatories has potential problems. First, the Federal Circuit notes that the “precise language in which [interrogatories] are couched can have an untoward effect on a verdict.”⁹⁹ The court warns about elements of the trial or evidence that may be over emphasized in the juror’s minds, thus tainting the verdict.

Another problem with general verdicts with special interrogatories lies in the possibility that the interrogatories will be inconsistent with each other or with the final verdict. If the answers are consistent with each other but inconsistent with the verdict, the judge may enter judgment in line with the answers, direct the jury to further deliberation, or order a new trial.¹⁰⁰ However, when the answers are inconsistent with each other and the verdict, the judge shall not enter a verdict.¹⁰¹ The judge has two options: order the jury to continue deliberation or order a new trial.¹⁰²

In resolving inconsistencies between answers to interrogatories, the Federal Circuit follows the regional circuit’s case law on procedural matters.¹⁰³ However, the Federal Circuit evaluates inconsistent verdicts by the Supreme Court’s standard that appellate courts have a duty to attempt to resolve potentially inconsistent jury verdicts.¹⁰⁴ To that end, the Federal Circuit has held that if there is a view of a case that makes the jury’s answers to the interrogatories consistent, a court must resolve them in that way.¹⁰⁵

A third problem with a general verdict with special interrogatories lies in the fact that the judge still has to instruct the jury on how to make the legal conclusion on the issue of obviousness.¹⁰⁶ Otherwise, a general ver-

98. Paul J. Zegger & Peter Lee, *The Paper Side of Patent Jury Trials: Jury Instructions, Special Verdict Forms, and Post-Trial Motions*, in PATENT LITIGATION 2007, at 701, 716 (PLI Patents, Copyrights, Trademarks, and Literary Prop. Course Handbook Series 2007), cited with approval in *Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 1343 n.3 (Fed. Cir. 2008).

99. *Weinar v. Rollform Inc.*, 744 F.2d 797, 809 (Fed. Cir. 1984).

100. FED. R. CIV. P. 49(b)(3)(C).

101. FED. R. CIV. P. 49(b)(4).

102. *Id.*

103. *Bradford Co. v. Jefferson Smurfit Corp.*, No. 00-1511, 2001 U.S. App. LEXIS 25205, at *10 (Fed. Cir. Oct. 30, 2001).

104. *Gallick v. Baltimore & Ohio R.R.*, 372 U.S. 108, 119 (1963).

105. *Mycogen Plant Sci., Inc. v. Monsanto Co.*, 243 F.3d 1316, 1326 (Fed. Cir. 2001).

106. See *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 724 (Fed. Cir. 1984) (noting that special verdict forms have a particular advantage of not having to

dict by the jury cannot be obtained with any reliability. However, one may be able to essentially direct a jury to its conclusion of nonobviousness. For example, Judge Nies stated that it was error to instruct a jury on the defendant's burden to show invalidity by clear and convincing evidence.¹⁰⁷ Nies defends this statement, citing the proposition that the determination of obviousness is a matter of law.¹⁰⁸ When a general verdict with interrogatories is used, the jury should be instructed that if it finds facts in a particular way then it must find for one of the parties.¹⁰⁹ Otherwise, the jury should find for the other party. By this rigid construction, Judge Nies would effectively, but not formally, strip the jury of its ability to decide the issue of obviousness.

While the problem of inconsistency haunts the use of general verdicts with interrogatories, the advantage of transparency is preserved. By requiring that the jury submit answers to the special interrogatories, the decisions may be reviewed and anomalies corrected.

3. *Special Verdict*

Special verdicts relieve the jury of the duty to determine the ultimate legal question. Thus, the jury in its capacity of factfinder merely answers questions about the factual underpinnings of the obviousness question. If the court proceeds under this device, the court "must give the instructions and explanations necessary to enable the jury to make its findings on each submitted issue."¹¹⁰

On the one hand, using special verdicts "greatly simplifies the instructions which must be given and clearly separates the respective functions of judge and jury."¹¹¹ Moreover, the use of special verdict forms is a "particularly useful tool in conserving judicial resources and in effectuating the Congressional policy expressed in patent laws."¹¹² Special verdicts have the same advantage of transparency as the general verdict with special interrogatories since the jury's findings are explicitly stated. However, they do not suffer from the potential inconsistency in the jury's application of the facts to the legal standards of nonobviousness. Any potential inconsis-

instruct the jury on the legal issues unlike where the jury has to deliver a verdict with or without interrogatories).

107. *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1556-58 (Fed. Cir. 1995) (en banc) (Nies, J., dissenting), *rev'd*, 520 U.S. 17 (1997).

108. *Id.*

109. *Id.*

110. FED. R. CIV. P. 49(a)(2).

111. *Structural Rubber*, 749 F.2d at 724.

112. *Id.*

tency would lie with the trial judge's legal application of the jury-determined facts.

However, special verdicts remove the ability of the jury to decide the legal outcome. Special verdicts also place an increasing burden on the trial judge to issue a holding on the legal question of obviousness after the jury returns its answers to the court. That said, nonobviousness is a legal determination,¹¹³ and it may be more logical to ask the jury to submit a special verdict form instead of a general verdict with interrogatories.

4. *Advisory Verdict*

Rule 39(c) allows for the court to use an advisory verdict, at the court's discretion or upon motion by the parties, for suits not triable as a matter of right by a jury.¹¹⁴ The advisory verdict is not binding on either the trial court or reviewing court. In practice, however, the trial bench may overly rely on the jury's advisory verdict.

Support exists for the notion that nonobviousness falls outside of a suit triable by right of jury. Where the court has only the legal issue of obviousness before it, a jury is not required as a matter of right.¹¹⁵ If the facts have been established, the judge must resolve the nonobviousness issue.¹¹⁶

The Ninth Circuit, one month before the formation of the Federal Circuit, sanctioned the use of advisory verdicts.¹¹⁷ The court held that a trial court must determine obviousness as a matter of law based upon the findings required by *Graham*, but may submit the question of obviousness to an advisory jury for guidance.¹¹⁸ The Ninth Circuit's decision held that the court has the duty to determine obviousness independent of the jury's conclusion.¹¹⁹ The en banc panel specifically disapproved of a comment in a previous opinion that appeared to approve leaving the ultimate question of obviousness to the jury.¹²⁰

The Federal Circuit reviewed the Ninth Circuit's holding allowing for advisory juries and refused to follow the suggestion about utilization of advisory juries.¹²¹ Where the Federal Circuit was faced with a trial judge's

113. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1745 (2007).

114. FED. R. CIV. P. 39(c).

115. *Newell Co. v. Kenney Mfg. Co.*, 864 F.2d 757, 763 (Fed. Cir. 1988).

116. *Id.*

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

118. *Id.* at 650.

119. *Id.*

120. *Id.* at 650-51 (criticizing *Hammerquist v. Clarke's Sheet, Inc.*, 658 F.2d 1319 (9th Cir. 1981)).

121. *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 895 n.5 (Fed. Cir. 1984).

use of an advisory verdict, the court characterized such use as a “discredited procedure.”¹²² The court ultimately treated the advisory verdict as an ordinary verdict and upheld it under the substantial evidence standard.¹²³

III. THE NORTHERN DISTRICT’S MODEL PATENT JURY INSTRUCTIONS

The Northern District of California issued a revised set of model patent jury instructions on October 9, 2007. While the model jury instructions are revised every couple of years,¹²⁴ the newest revision took into account the *KSR* decision, which had been decided approximately five months beforehand. The working committee’s¹²⁵ revisions to the model jury instructions were dramatically influenced by the *KSR* decision and they repeatedly emphasized that the determination of nonobviousness is a legal one.

The committee discarded both the general verdict and the general verdict with interrogatories.¹²⁶ Instead, the committee opted to provide, in the alternative, either instructions for a special verdict where the jury only determines the underlying factual *Graham* inquiries, or instructions for an advisory verdict where the jury makes the determination of nonobviousness but that determination has no binding effect on the trial judge.¹²⁷ There are also minor changes to the scope and content of the prior art *Graham* factors and the secondary considerations to be considered.¹²⁸ The differences between the prior art and the patent¹²⁹ and the level of skill in the art¹³⁰ *Graham* factors are unchanged.

A. Verdict Options

The Northern District’s model jury instructions provide for either an advisory verdict or a special verdict. The comments to both instructions emphasize that nonobviousness is a legal conclusion that should be rendered by the court.¹³¹ The advisory verdict charges the jury with answer-

122. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1234 (Fed. Cir. 1989).

123. *Id.* at 1240.

124. The two previous editions were in 2004 and 2002.

125. The working committee consisted of Judge Ronald Whyte of the Northern District of California, Professor Mark Lemley, and practitioners Martin Fliesler, David McIntyre, James Pooley, Matthew Powers, and James Yoon. Wilkin, *supra* note 2, at 337.

126. *Id.* at 374-77.

127. *Id.*

128. *Id.* at 374-78.

129. *Id.* at 379.

130. *Id.* at 380.

131. *Id.* at 374-76 nn.9 & 10.

ing special interrogatories about the underlying factual inquires and to make a nonbinding determination on the conclusion of obviousness. The special verdict charges the jury only with answering interrogatories to the factual inquires.

One revision to the instructions is common to both of the alternatives. The revised model jury instructions start by saying: “Not all innovations are patentable.”¹³² Starting the instructions with that sentence should grab a juror’s attention. On one hand, such a statement may seem to undercut the presumption of patent validity that requires clear and convincing evidence for invalidation.¹³³ But on the other hand, such a statement may be seen as a way to ameliorate a perceived pro-plaintiff bias of jurors.¹³⁴

1. *Advisory Verdict*

The first alternative provides for an advisory verdict and determination of the *Graham* factual inquiries by the jury. The first paragraph has three components: (1) not all innovations are patentable, (2) a paraphrase of language from 35 U.S.C. § 103(a), and (3) distinguishing between the use of prior art in the context of nonobviousness from anticipation and statutory bars by stating that not all of the requirements of the claim need to be found in a single piece of prior art.¹³⁵ Except for the statement that not all innovations are patentable, this language is almost identical to the beginning of the 2004 model jury instructions.¹³⁶

The second paragraph discusses nonobviousness. There is additional discussion of the use of prior art by pointing out that a claim is not held obvious merely because all of the limitations are known in the prior art.¹³⁷ Rather, the jury “may consider” whether there is some “reason” for a person having ordinary skill in the art to combine the “elements or concepts” to form the claimed invention.¹³⁸ The 2007 model jury instructions state that a patent is not obvious “*unless* there was something in the prior art or within the understanding of a person of ordinary skill in the field that would *suggest* the claimed invention.”¹³⁹

132. *Id.* at 374, 376.

133. 35 U.S.C. § 282 (2006).

134. Moore, *supra* note 40, at 231-32.

135. Wilkin, *supra* note 2, at 374-77.

136. Martin Fliesler et al., *Model Patent Jury Instructions for the Northern District of California*, in TRIAL OF A PATENT CASE 2004, at 357, 392 (Amer. Law Inst.-Amer. Bar Assoc. Continuing Legal Educ., Course Handbook, 2004).

137. Wilkin, *supra* note 2, at 376-77.

138. *Id.*

139. *Id.* (emphasis added).

First, the language of the 2007 model jury instructions makes finding a “reason” to combine permissive since the jury “may consider” whether there was a reason to combine.¹⁴⁰ This may actually be reading too much into *KSR*, which, if read narrowly, only rejected the notion that the TSM test as applied by the Federal Circuit had to be satisfied for a patent to be deemed obvious.¹⁴¹ The Supreme Court in *KSR* actually went to great lengths to provide a reason for the components of the patent at issue to be combined.¹⁴² This permissiveness may be in contradiction with Federal Circuit precedent that requires a reason to combine for a finding of obviousness after *KSR*.¹⁴³ Second, the revision to the 2007 model jury instructions strikes the requirement that there needs to be something to “suggest” the claimed invention within the prior art, which is more in line with the language of *KSR*.¹⁴⁴

However, several sentences later, the model jury instructions state that it is permissible to consider whether there is some “teaching or suggestion” in the prior art to motivate the “modification or combination of elements claimed in the patent.”¹⁴⁵ This part of the instruction not only touches upon combination of elements, but also modification. Nowhere in the 2004 model jury instructions is there any mention of modification of elements, but it certainly harkens back to *Hotchkiss* and the modification of the material for the doorknob.¹⁴⁶

The intervening sentences of the second paragraph continue by distinguishing “true inventiveness . . . (which is patentable)” from the “application of common sense and ordinary skill to solve a problem . . . (which is not patentable).”¹⁴⁷ The instruction also tries to distinguish between “innovation” as recited in the first sentence of the instruction and “invention,”

140. *Id.*

141. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007) (“There is no necessary inconsistency between the idea underlying the TSM test and the *Graham* analysis.”).

142. *See id.* at 1735-37.

143. *PharmaStem Therapeutics, Inc. v. Viacell, Inc.*, 491 F.3d 1342, 1360 (Fed. Cir. 2007) (stating that the defendant must show by clear and convincing evidence “[1] that a person of ordinary skill in the art would have had reason to attempt to make the composition or device, or carry out the claimed process, and [2] would have had a reasonable expectation of success in doing so.”).

144. *See KSR*, 127 S.Ct. at 1741 (“[T]he analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”).

145. Wilkin, *supra* note 2, at 376.

146. *Hotchkiss v. Greenwood*, 52 U.S. 248, 266 (1851).

147. Wilkin, *supra* note 2, at 376-77.

but states that “[t]here is no single way to define the line between” the two.¹⁴⁸ “Common sense” comes directly from the language of *KSR*,¹⁴⁹ and the instruction continues to recite more of *KSR* by giving the examples that “market forces or other design incentives may be what produced a change, rather than true inventiveness.”¹⁵⁰ There is no corresponding language in the 2004 version of the model jury instructions that approximates this language.

The second paragraph concludes by warning against hindsight bias by instructing the jurors to place themselves into the shoes of a person having ordinary skill in the art at the time the invention was made.¹⁵¹ The instructions specifically state that the juror should not consider “what is known today or what is learned from the teaching of the patent.”¹⁵² This language is nearly verbatim to the 2004 model jury instructions.¹⁵³ However, the 2007 version adds that “many true inventions might seem obvious after the fact.”¹⁵⁴

The third paragraph of the 2007 model jury instructions states: “The ultimate conclusion of whether a claim is obvious *should* be based upon your determination of several factual decisions.”¹⁵⁵ This language seems innocuous, yet when compared to the 2004 model jury instructions it reveals its true nature as an advisory verdict. The 2004 model jury instruction, in contrast, states: “Your ultimate conclusion about the question whether a claim is obvious *must* be based on several factual decisions that you must make.”¹⁵⁶ The distinction between the 2007 and 2004 instructions is subtle, but the distinction reveals the fundamental difference as to who makes the ultimate conclusion of nonobviousness. The 2007 model jury instruction takes away the jury’s power to make the ultimate conclusion. The 2007 model jury instruction also makes a determination of non-obviousness permissibly dependent on the factual inquires, i.e. the *Graham* factors. In contrast, the 2004 model jury instructions require use of the *Graham* factors. The permissive nature of the 2007 model jury instructions is curious since *KSR* never challenged the use of *Graham*.¹⁵⁷ Instead,

148. *See id.*

149. *KSR*, 127 S. Ct. at 1742.

150. Wilkin, *supra* note 2, at 376; *KSR*, 127 S. Ct. at 1742.

151. Wilkin, *supra* note 2, at 376.

152. *Id.*

153. Fliesler, *supra* note 136, at 392.

154. Wilkin, *supra* note 2, at 376-77.

155. *Id.* (emphasis added).

156. Fliesler, *supra* note 136, at 392 (emphasis added).

157. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

the Court in *KSR* specifically reaffirmed the use of the *Graham* inquiries.¹⁵⁸

The third paragraph concludes by listing the *Graham* factors and secondary considerations.¹⁵⁹ The 2004 model jury instructions conclude in the same way.¹⁶⁰ The 2007 model jury instructions include all of the secondary considerations of the 2004 version: commercial success, long-felt need, unsuccessful attempts by others, copying, unexpected superior results, acceptance by others, and independent invention.¹⁶¹ The 2007 model jury instructions, however, include two catchall secondary considerations for “other evidence tending to show” obviousness and nonobviousness.¹⁶² Simply put, the new instructions considerably expand what parties may be allowed to introduce into evidence to determine the circumstances surrounding the time of invention.

2. *Special Verdict*

The alternative jury instruction charges the jury to make specific findings but no determination of nonobviousness.¹⁶³ Because the jury needs only to make factual findings, these instructions tend to be simpler than the advisory verdict. The special verdict instruction tracks the beginning and end of the advisory verdict essentially by using the first and last sentences of the advisory verdict.

The special verdict instructions state that “not all innovations are patentable.”¹⁶⁴ The model jury instructions paraphrase the language of 35 U.S.C. § 103(a).¹⁶⁵ The third sentence is the only one that deviates from the advisory verdict instructions; here the advisory verdict instructions expressly state that the judge is charged with the ultimate conclusion of obviousness based upon the jury’s factual finding.¹⁶⁶ The model jury instructions conclude by listing the *Graham* factors and secondary considerations.¹⁶⁷

158. *Id.*

159. Wilkin, *supra* note 2, at 376-77.

160. Fliesler, *supra* note 136, at 392.

161. Wilkin, *supra* note 2, at 377; Fliesler, *supra* note 136, at 392.

162. Wilkin, *supra* note 2, at 377.

163. *Id.* at 376 n.10.

164. *Id.* at 376.

165. *Id.* (“A patent claim is invalid if the claimed invention would have been obvious to a person of ordinary skill in the field at the time the application was filed . . .”).

166. *Id.* at 374.

167. *Id.* at 374, 376-77.

The main distinguishing feature of the special verdict instruction comes from the comment.¹⁶⁸ Since the jury is only determining facts, the instruction should be curtailed to only seek answers to factual issues in dispute at trial.¹⁶⁹ For example, if the only contested factual issue is whether a reference qualifies as prior art, then that is the only *Graham* factor for which the jury should receive instruction.¹⁷⁰

B. The *Graham* Factors

In the model jury instructions, the *Graham* factors are listed separately and are used with either the advisory or the special verdict where needed.¹⁷¹

1. *Scope and Content of the Art*

The instructions for the scope and content of the prior art are largely unchanged between the 2004 and 2007 revisions.¹⁷² Both instructions state that the prior art reference needs to be “reasonably related to the claimed invention of [the] patent.”¹⁷³ Both sets also provide a two pronged test that determines whether the prior art reference is “reasonably related”: the prior art either needs to be from the same field or from another field to which a person having ordinary skill in the art would look to solve a known problem.¹⁷⁴ The one change between 2004 and 2007 occurs in the second prong of the reasonably related test. The 2004 wording “the problem the named inventor was trying to solve”¹⁷⁵ has been replaced with “a known problem.”¹⁷⁶ This language is taken from *KSR* where the Court noted that it was error by the Federal Circuit to require that the only combinable prior art was art specifically intended to solve the patentee’s problem.¹⁷⁷

168. Compare *id.* at 374 n.9 (“This instruction provides the jury with an instruction on the underlying factual questions it must answer to enable the court to make the ultimate legal determination of the obviousness question.”), with *id.* at 374 n.10 (“This instruction provides the jury with an instruction on how to analyze the obviousness question and reach a conclusion on it in the event that the Court decides to allow the jury to render an advisory verdict on the ultimate question of obviousness.”).

169. *Id.*

170. *Id.*

171. *Id.* at 374, 376.

172. Compare *id.* at 378, with Fliesler, *supra* note 136, at 394.

173. Wilkin, *supra* note 2, at 378; Fliesler, *supra* note 136, at 394.

174. Wilkin, *supra* note 2, at 378; Fliesler, *supra* note 136, at 394.

175. Fliesler, *supra* note 136, at 394.

176. Wilkin, *supra* note 2, at 378.

177. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007).

2. *Differences Over the Prior Art*

The model jury instructions for analyzing differences between the prior art and the claimed invention simply instruct the jury to “consider any difference or differences between the [prior art] and the claimed requirements.”¹⁷⁸ There are no changes between the 2007 and 2004 versions of the model jury instructions,¹⁷⁹ and the authorities listed do not reference *KSR*.¹⁸⁰

3. *Level of Ordinary Skill in the Art*

As with the prior art factor, there are no changes from the 2004 model jury instructions for determining the skill level of ordinary skill in the art.¹⁸¹ The instruction tells the jury that they should “consider all the evidence introduced at trial” including the level of ordinary skill and experience, the types of problems encountered in the field, and the sophistication of the technology.¹⁸² While *KSR* was silent regarding the determination of the level of skill in the art, it did offer guidance on how a person having ordinary skill in the art may apply their knowledge, creativity, and common sense.¹⁸³ This language from *KSR* has been incorporated into the advisory verdict instruction.¹⁸⁴ However, it was unnecessary to incorporate the Supreme Court’s language within the special verdict since the jury does not determine obviousness.

C. **Verdict Forms**

The 2007 model jury instructions provide two sets of sample verdict forms for the alternate advisory and special verdict.¹⁸⁵ The comment to the sample verdict form instructs that the issues presented to the jury should be as specific as possible.¹⁸⁶ Both sample verdict forms are “designed to focus the parties and the court on the factual disputes on the obviousness

178. Wilkin, *supra* note 2, at 379.

179. *Compare id.*, with Fliesler, *supra* note 136, at 395.

180. Wilkin, *supra* note 2, at 379.

181. *Compare id.* at 380, with Fliesler, *supra* note 136, at 396.

182. Wilkin, *supra* note 2, at 380.

183. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007).

184. *Compare id.* (“Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.”), with Wilkin, *supra* note 2, at 380 (“You may consider whether the change was merely the predictable result of using prior art elements according to their known functions, or whether it was the result of true inventiveness.”).

185. Wilkin, *supra* note 2, at 399-401.

186. *Id.* at 394.

question.”¹⁸⁷ The sample verdict form utilized at trial “should require the jury’s finding on each factual issue so that the trial judge may make the final determination on the obviousness question.”¹⁸⁸ The use of general verdicts is not recommended, and the court should not defer to the jury for the ultimate question of nonobviousness.¹⁸⁹ While not expressly stated, the model jury instructions impliedly recommend against the use of a general verdict with interrogatories.

The two sample verdict forms are nearly identical. They both include detailed questions of the three *Graham* factors and the secondary considerations.¹⁹⁰ The sample verdict forms ask the jury to determine the level of ordinary skill in the art. There are three check boxes: one corresponds to the patentee’s contention, the second to the defendant’s contention, and the third is a catch-all “other” requiring that the jury describe the level of ordinary skill in the art.¹⁹¹ Similarly, there are three check boxes for choosing the differences over the prior art that correspond to the parties’ contentions and another “other” catch-all that requires the jury to write out the differences they find.¹⁹² The secondary considerations section on both verdict forms simply lists each consideration letting the jury check off all that apply.¹⁹³ The catch-all “other” secondary considerations tending to show obviousness or nonobviousness require the jury to describe the “other factors” that they found relevant.¹⁹⁴

While both the advisory and special sample verdict forms specifically ask the jury to find the scope and content of the art, the two sample verdict forms do so in different ways. For the advisory verdict, each disputed prior art reference is listed separately and the jury can check off those that they find are reasonably related.¹⁹⁵ However, the special verdict uses a form similar to the level of ordinary skill form and difference over the prior art form. Namely, each party’s contention is listed and a third “other” category is also supplied.¹⁹⁶ Thus, each party groups what they contend to be the combination of prior art that includes both prior art references, e.g. pa-

187. *Id.*

188. *Id.*

189. *Id.* at 394-95.

190. *See id.* at 399-401.

191. *Id.*

192. *Id.*

193. *Id.*

194. *Id.*

195. *Id.* at 400-01.

196. *Id.* at 399.

tents, but also general knowledge in the field and common knowledge of a layperson.¹⁹⁷

The only other distinction between the two sample verdict forms is that the advisory verdict asks the jury to make the ultimate conclusion on nonobviousness.¹⁹⁸

D. Comparison to the National Jury Instruction Project

Like the Northern District of California, the National Jury Instruction Project (NJIP) also suggests the use of two different verdict options: a special verdict and a general verdict.¹⁹⁹ Unlike the Northern District, the NJIP does not provide for an advisory verdict.²⁰⁰ Instead, the NJIP provides for a sample verdict form where the conclusion of obviousness may be made a general verdict.²⁰¹ The NJIP sample verdict form goes further by suggesting that all issues of validity be lumped into a single question,²⁰² which is in stark contradiction to the Northern District's approach.

At the request of Federal Circuit Judge Michel, a committee was convened to draft a set of patent model jury instructions, which were published on December 5, 2008.²⁰³ The model jury instructions put forth are neither endorsed by the Federal Circuit nor are they official instructions.²⁰⁴ But the goal was to collect the wisdom from members of the bench and bar to create an easier-to-understand and streamlined set of instructions.²⁰⁵

The committee suggests that the "best approach" is for the parties and judge to tailor the jury instructions and form to the particular facts of the case.²⁰⁶ The committee further suggests that where the parties and judge desire to submit the underlying factual question to the jury, they should look to the Northern District's model jury instructions and sample verdict form that asks the jury to determine each *Graham* factor as well as the

197. *Id.*

198. *Id.* at 401.

199. MODEL PATENT JURY INSTRUCTIONS 42-47 (Nat'l Jury Instruction Project, Draft for Comment 2008), available at <http://www.patentlyo.com/patentjuryinst.pdf>.

200. *Id.*

201. *Id.* at 62-67.

202. *See id.* at 62-63.

203. *Id.* at 1. Committee members include: Judges Patti Saris, T. John Ward and Ronald Whyte, and attorneys Kenneth Bass III, Donald Dunner, Pamela Krupka, Roderick McKelvie, Teresa Rea, and Edward Reines. *Id.* Judge Whyte was also a committee member of the Northern District of California's model jury instructions committee.

204. *Id.*

205. *Id.*

206. *Id.* at 48.

secondary considerations.²⁰⁷ However, the NJIP committee departs from the Northern District's approach since it has reservations about the use of special interrogatories because of the burden of proof problem.²⁰⁸

The NJIP committee explains why they have provided the nonobviousness instructions for both a general verdict and a special verdict; the committee was "unable to reach a consensus on an instruction and a verdict form for those cases where the court submits the underlying factual issues to the jury and reserves for itself the determination of obviousness."²⁰⁹ The committee explains that there exists no "case law that provides guidance on how to implement the burdens of proof a party has with regard to either the statutory factors or the secondary considerations."²¹⁰

The committee provides an example when considering the differences between the scope and content of the art and the claimed invention. The jury is charged with determining "what difference, if any, existed between the claimed invention and the prior art."²¹¹ The committee found it difficult to craft instructions and verdict-form questions with an evidentiary standard for the individual findings required by a jury in the *Graham* analysis.²¹² Similarly, the committee "ha[s] not been able to agree on the patent owner's burden of proof in establishing commercial success or agree on a form by which the jury reports its finding on commercial success."²¹³

Issued patents have the presumption of validity.²¹⁴ Therefore, the burden of proof that an alleged infringer needs to establish must be that of clear and convincing evidence.²¹⁵ The Northern District's and the NJIP's jury instructions translate the clear and convincing evidentiary standard into "highly probable."²¹⁶

207. *Id.*

208. *Id.*

209. *Id.*

210. *Id.*

211. *Id.*

212. *Id.* ("[The committee] find[s] it difficult to translate that instruction into a finding an alleged infringer must establish is 'highly probable' and then into a question or questions a jury answers on a verdict form.")

213. *Id.*

214. 35 U.S.C. § 282 (2006).

215. *Buildex Inc. v. Kason Indus., Inc.* 849 F.2d 1461, 1463 (Fed. Cir. 1988) ("[A]n attack on [the patent's] validity requires proof of facts by 'clear and convincing evidence' The 'clear and convincing' standard of proof of facts is an intermediate standard which lies somewhere between 'beyond a reasonable doubt' and a 'preponderance of the evidence.'") (citations omitted).

216. *Wilkin*, *supra* note 2, at 366; Nat'l Jury Instruction Project, *supra* note 199 at 30. In contrast, the preponderance of evidence standard is described in the Northern District's instructions as "more likely than not." *Wilkin*, *supra* note 2, at 352.

The Northern District's advisory opinion asks the jury whether "it is highly probable that the claim of the Patent Holder's patent would have been obvious."²¹⁷ The NJIP verdict form similarly asks whether the alleged infringer has "proven that it is highly probable that the following claim is invalid as obvious."²¹⁸ For the factual inquiries required by *Graham*, the Northern District's sample verdict form does not possess language concerning a particular type of evidentiary standard. For example, the sample verdict form asks: "What was the level of ordinary skill in the field that someone would have had at the time the claimed invention was made?"²¹⁹

The lack of evidentiary standard for the underlying factual inquiries in the Northern District's instructions is mirrored in the sample verdict form's questioning on whether the patent was invalid because of anticipation or a statutory bar.²²⁰ In both inquiries there must be a showing that it is highly probable that the patent is invalid.²²¹ Where the jury determines that invalidity is highly probable because of anticipation or a statutory bar, the jury is charged with checking the reason for such a finding.²²² However, the list of reasons that may anticipate the patent have no evidentiary standard.²²³ For example, the sample verdict provides a possible reason for anticipation: "The named inventor was not the first inventor of the claimed invention."²²⁴ Perhaps when the question of anticipation is read in conjunction with the reason for anticipation it can be assumed that it was highly probable that the named inventor was not the first inventor, since anticipation is found from only a single anticipating event.

However, obviousness is more complicated than anticipation, requiring the three *Graham* factors and the secondary considerations to be evaluated individually and collectively. While the Northern District's sample verdict form is silent on the evidentiary standard for the individual *Graham* factors, the instructions do imply a burden of proof for *Graham*'s secondary considerations. The sample verdict form asks "[w]hich of the following [secondary considerations] has been *established by the evidence*

217. *Id.* at 401.

218. Nat'l Jury Instruction Project, *supra* note, 199 at 66.

219. Wilkin, *supra* note 2, at 399-400.

220. *Id.*

221. *Id.*

222. *Id.*

223. *See, e.g., id.* at 399 ("The claimed invention was already publicly known or publicly used by others in the United States before the date of conception of the claimed invention.").

224. *Id.* at 398.

with respect to the claimed invention.”²²⁵ This language also appears in the special verdict jury instruction.²²⁶ However, the advisory verdict instruction contains slightly different language; the language is “shown by the evidence” rather than “established by the evidence.”²²⁷ Nowhere, however, is “established by the evidence” or “shown by the evidence” defined in the instructions. There is some measure of ambiguity in what must be established to meet this standard or whether a standard was even intended by the drafters.

IV. CHOOSING BETWEEN VERDICT OPTIONS

The Northern District clearly intends for the model jury instructions to restrict the jury’s role exclusively to that of a factfinder and to take the ultimate conclusion on nonobviousness away from the jury.²²⁸ The NJIP’s model jury instructions similarly allow for the parties and the judge to limit the jury to factfinding. But the NJIP instructions also allow for the parties and judge to opt for a naked general verdict.²²⁹ As the Federal Circuit seems unwilling to mandate the use of a particular type of jury verdict,²³⁰ litigants and judges are still free to use their discretion. That said, the Federal Circuit has taken a dim view of general verdicts and advisory verdicts.²³¹

A. Differences Between Judges and Juries

The Northern District’s approach to take the nonobviousness determination away from the jury makes pragmatic sense. Juries may be incapable of rendering reliable verdicts on the issue of nonobviousness. The common usage of the word and the legal usage of the word as a term of art require complicated instructions because there is no single test that captures obviousness in innovation.²³² Moreover, as implied in *KSR*, the doctrine of nonobviousness is equitable.²³³ Judges excel at this inquiry, and this is

225. *Id.* (emphasis added).

226. *Id.* at 376-77.

227. *Id.* at 374-75.

228. *See id.* at 374 n.9, 376 n.10.

229. Nat’l Jury Instruction Project, *supra* note 199, at 42-48.

230. *See R.R. Dynamics, Inc. v. A Stucki Co.*, 727 F.2d 1506, 1514-25 (Fed. Cir. 1984).

231. *See* Part II, *supra*.

232. Moore, *supra* note 40, at 213-14; Lee, *supra* note 17, at 19-23.

233. *See KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007) (“*Graham* recognized the need for ‘uniformity and definiteness.’ Yet the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*.”). (citation omitted).

perhaps the best reason to take the determination of nonobviousness away from juries.

There is also the fear of invalidating patents through the use of hindsight.²³⁴ One may question whether a juror can really view the world through the eyes of a person having ordinary skill in the art at the time that the invention was made. Jurors may be unable to comprehend the technology or understand the legal standards.²³⁵ However, judges may be no better at evaluating the patent through the eyes of a person having ordinary skill in the art because they also lack the requisite scientific background.²³⁶

Moreover, juries possess a demonstrable propatentee bias,²³⁷ suggesting that juries find too many patents valid. While the stakes of the individual patent litigation are probably quite high, the paucity of trials that reach a jury verdict mitigates the damage to the system as a whole. But a propatentee bias may suggest that the jury collectively deems the terms of the bargain acceptable; juries may require a lesser standard for nonobviousness in consideration for a patent monopoly for a limited term.

Whether *KSR* has a demonstrably disproportionate affect on nonobviousness decisions by judges as compared to juries remains an open question that may take some time to adequately sample. Assuming that *KSR* will increase the number of invalidity findings, one may consider the possible effect on the perceived propatentee bias. In the absence of any disproportionate reaction to *KSR*, the propatentee bias will remain in effect with a similar difference as currently observed, but with a net vertical shift downward. If the downward change in judges' validity findings is greater than that for juries, the propatentee bias will become magnified. Only if the downward change in juries' validity findings is greater than that for judges will the evidence of a propatentee bias decrease. Since it has been suggested that part of the reason that juries side with patentees is the image of the noble inventor,²³⁸ a disproportionately greater increase in jury invalidity findings following the case law seems dubious. Thus, the last scenario may be the least likely, further suggesting that the propatentee bias will persist.

234. See *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 36 (1966).

235. Moore, *supra* note 40, at 213-14.

236. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 993 (Fed. Cir. 1995) (Mayer, J., concurring).

237. See Moore, *supra* note 40, at 239.

238. *Id.* at 217-18.

B. Party Interests

Since there is still discretion, litigants will seek jury instructions that favor their side. Patent owners will likely opt for jury verdicts in order to take advantage of the pro-patentee bias. Defendants, conversely, will likely opt for the judge to determine the ultimate conclusion of nonobviousness. A judge's interest may be more particularized. Judges may opt to embrace their expanded role or conserve their judicial resources and grant wider authority to juries.

Forum shopping could become even more important if the judges in a particular district were more likely to extensively follow one approach over the other.²³⁹ Patentees would tend to submit complaints in districts where the jury makes the conclusion, and alleged infringers would have greater incentive to seek declaratory relief in districts where judges make the ultimate conclusion. Were the Federal Circuit to mandate a particular type of jury verdict, uniformity would remove this potential incentive to forum shop.

If the Federal Circuit were to mandate the use a particular type of verdict form, the court would likely adopt either the general verdict with special interrogatories or a special verdict where the jury's sole role consists of factfinding; the Federal Circuit has already suggested that the factual underpinnings should be enumerated by the jury.²⁴⁰ Conversely, the Federal Circuit has criticized the use of naked general verdicts as bordering on an abuse of discretion by the trial court²⁴¹ and considers advisory verdicts discredited,²⁴² making it unlikely that the Federal Circuit would mandate either of these options.

V. CONCLUSION

While the Supreme Court's decision in *KSR* was a rejection of the Federal Circuit's rigid application of the TSM test, the decision cannot be cited as a rejection of the use of juries for the determination of obviousness. Furthermore, no case law exists that would indicate that any of the Federal Rules of Civil Procedure sanctioned verdict forms are barred from use. Thus, the Northern District's rejection of both general verdicts and

239. See generally Kimberly A. Moore, *Forum Shopping in Patent Cases: Does Geographic Choice Affect Innovation?*, 79 N.C. L. REV. 889 (2001).

240. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1547 (Fed. Cir. 1983).

241. *Am. Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1361 (Fed. Cir. 1984).

242. *Richardson v. Suzuki Motor Corp.*, 868 F.2d 1226, 1234 (Fed. Cir. 1989).

general verdicts with special interrogatories is merely a suggestion of preferred trial practice that is in contrast to the general interests of patentees.