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DEPENDENT ON THE JURY: ANTICIPATION AND OBVIOUSNESS OF DEPENDENT PATENT CLAIMS AND IRRECONCILABLE JURY VERDICTS

PATRICK BICKLEY

While Schrödinger’s cat may be both alive and dead at any given moment, even in theory, claim limitations cannot be concurrently both met and not met.¹

INTRODUCTION

As the sole appellate court for cases arising under the patent laws, the Court of Appeals for the Federal Circuit has the responsibility for reviewing jury verdicts in patent trials. Juries often must determine the validity of the independent and dependent claims at issue in the suit. Due to the nature of these claims, a dependent claim cannot be invalid because of anticipation or obviousness unless the independent claim from which it depends was also invalid.³ A jury verdict finding an independent claim valid but a related dependent claim either anticipated or obvious is irreconcilable.⁴ However, the Federal Circuit has used the inconsistencies between regional circuits on the issue of jury verdicts to reach different outcomes in similar cases based solely on the region in which the patent case originated.⁵

This note examines the cases in which the Federal Circuit has dealt with irreconcilable jury verdicts based on independent and dependent claims. First, in Section I, this note discusses the problem of irreconcilable verdicts based on independent and dependent claims. Second, in Section II, this note examines the different approaches of the regional circuits to the question of irreconcilable jury verdicts and how the Federal Circuit has

3. See Callaway Golf Co. v. Acushnet Co., 576 F.3d 1331, 1344 (Fed. Cir. 2009) (“A broader independent claim cannot be nonobvious where a dependent claim stemming from that independent claim is invalid for obviousness.”) (citing Ormco Corp. v. Align Tech., Inc., 498 F.3d 1307, 1319 (Fed. Cir. 2007)). Other issues of invalidity, such as failure to provide a written description, failure to enable one of ordinary skill in the art to make and use the invention, or failure to disclose best mode under 35 U.S.C. § 112, present different questions when dealing with independent and dependent claims. As such, they are beyond the scope of this note.
4. See Callaway Golf, 576 F.3d at 1344.
applied these approaches in cases with conflicting independent and dependent verdicts. Finally, in Section III, this note proposes and discusses potential solutions, including the current approaches by the district courts in correcting conflicting verdicts, a proposal to adopt explicit language dealing with the problem in model jury instructions, and an approach under the Federal Circuit's rule of deference for dealing with the problem.

I. IRRECONCILABLE JURY VERDICTS BASED ON INDEPENDENT AND DEPENDENT CLAIMS

Juries play an important role in patent litigation. Patent holders have increasingly sought juries in litigation. Studies published in 2000 by Kimberly Moore showed that juries were more likely than judges to find for patent holders. However, the complexity of the technical and scientific facts that often underlie the patent at issue has led to numerous proposals to reform the patent jury system, including suggestions for a pool of technically competent jurors, the creation of specialized trial courts or juries for patent cases, or giving the U.S. Court of International Trade jurisdiction over patent litigation. The jury often determines whether the patent is valid, whether the patent covers the accused product or process, and whether the patent is enforceable. These three main categories of defenses can generally be thought of as invalidity—what I do is not covered by the patent, non-infringement—what I do is not covered by the patent, and unenforceability—your bad behavior in obtaining the patent negates your patent rights.

Additionally, the number and types of claims at issue further complicate patent litigation. Patent cases often involve multiple claims contained in multiple patents. Some of these claims may be self-contained, called independent claims. Other claims may be dependent upon these indepen-

7. Id. at 386 (finding patent holders more likely to prevail with a jury, 68 percent, than a judge, 51 percent).
11. Because inequitable conduct will render the entire patent unenforceable (see Kingsdown Med. Consultants, Ltd. v. Hollister Inc., 863 F.2d 867, 877 (Fed. Cir. 1988)), and not simply the individual claims, there is no independent/dependent confusion issue for inequitable conduct.
dent claims, called dependent claims. A necessary result of a claim dependent on an independent claim is that it incorporates all of the limitations of any independent claim from which it depends. A dependent claim will thus be narrower, or cover less subject matter, than any independent claim from which it depends because of the additional limitations.

As a result, it is possible to infringe the broader independent claim while not infringing the narrower dependent claim. For example, consider an independent claim, Claim 1, claiming a pencil comprising two elements, a wooden shaft and a graphite core. Additionally, consider dependent Claim 2, which claims the invention of Claim 1, with the additional limitation that the wooden shaft is yellow in color. Claim 2 contains all of the limitations of Claim 1, that the product contains both a wooden shaft and a graphite core, but also the additional limitation that the wooden shaft be yellow. A potential infringer may produce a competing pencil comprising a blue painted wooden shaft and a graphite core. The infringer has infringed Claim 1 because his product contains the wooden shaft and graphite core. However, he has not infringed Claim 2 because the competing pencil does not meet the additional limitation that the wooden shaft be yellow.

One can infringe an independent claim but not a dependent claim that includes additional limitations. However, the reverse is not true. One who infringes a dependent claim must also infringe the independent claim. Going back to the pencil invention with Claim 1 and Claim 2, it is simply not possible to have a pencil that reads on Claim 2—the competing pencil has a yellow wooden shaft and graphite core—without that pencil also reading on Claim 1—that the pencil has a wooden shaft and graphite core. Claim 1 is infringed regardless of the color of the wooden shaft. As stated by the Federal Circuit, "It is axiomatic that dependent claims cannot be found infringed unless the claims from which they depend have been found to have been infringed."

12. 35 U.S.C. § 112 ¶ 4 (2006) ("[A] claim in dependent form shall contain reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.").

13. The Federal Circuit has indicated that "limitation" refers to claim language and "element" refers to the accused device in litigation. See Lockheed Martin Corp. v. Space Systems/Loral, Inc., 324 F.3d 1308, 1315 n.1 (Fed. Cir. 2003). However, in practice the distinction is not rigorously observed.


15. Id. at 1553. But see Wilson Sporting Goods Co. v. David Geoffrey & Assoc., 904 F.2d 677, 685 (Fed. Cir. 1990) (overruled in part on other grounds by Cardinal Chem. Co. v. Morton Int'l., Inc., 508 U.S. 83 (1993) ("While this proposition is no doubt generally correct, it does not apply in the circumstances of this case."). Wilson Sporting Goods is discussed in more detail, infra.
Similar to infringement, a dependent claim cannot be invalid because of anticipation or obviousness unless the independent claim from which it depends was also found invalid. Anticipation occurs when a single prior art reference contains each limitation claimed by the invention. To return to the pencil example above, if another company already sold pencils comprising a green wooden shaft and a graphite core, Claim 1 would be anticipated by the green pencils (and thus invalid) because each of the limitations on Claim 1, that the pencil have a wooden shaft and graphite core, can be found in the competing pencil. However, Claim 2 would not be anticipated by the green pencil because its additional limitation, that the wooden shaft be yellow, is not found in the prior art (in this case, the competing green pencil).

Even if a single prior art reference does not contain each limitation, the differences between the prior art and the claimed invention must be more than obvious for the patent to be valid. If green, blue, red, purple, and many other colors of pencils are disclosed in the prior art, it is likely that Claim 2, a yellow colored pencil, would have been obvious to a person having ordinary skill in the art of pencil making, and Claim 2 would not be valid. If the narrower Claim 2, a yellow pencil, is obvious, then the broader Claim 1, any wooden pencil, must also be obvious.

If at trial the jury concluded that Claim 2 was invalid because of either anticipation or obviousness, then it must also conclude that Claim 1 was invalid. Were the jury to conclude otherwise, the verdicts would be inconsistent with each other and could not be reconciled.

17. Anticipation by the prior art defeats the claimed invention’s novelty. However, because the U.S. is a first-to-invent country, rather than a first-to-file country, some public disclosures are allowed. The statutory requirements for novelty are given in 35 U.S.C. § 102 (2006).
18. The statutory requirements for obviousness are given in 35 U.S.C. § 103. To determine whether a claimed invention is obvious, the court determines the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill of a person in the art. Additionally, the court can consider objective indicia such as commercial success and long-felt but unsolved needs to determine whether an invention is obvious. KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007).
19. Again, it is important to note that the reverse is not true. Claim 2 can still be valid even if Claim 1 is anticipated or infringed. Using the pencil example, if the prior art discloses a pencil with a wooden shaft and graphite core, Claim 1 would be anticipated, but unless the prior art also included the limitation that the shaft be yellow, Claim 2 would not be anticipated. Likewise, if Claim 1 was obvious in light of the prior art—say for example, due to shafts made of paper, steel, cloth, and clay, (which just all happen to be unpainted because no one had ever thought of coloring the exterior of a pencil)—the addition of the yellow covering limitation may be enough to render Claim 2 nonobvious.
II. INVALIDITY AND IRRECONCILABLE JURY VERDICTS IN THE FEDERAL CIRCUIT

The courts, however, have accepted irreconcilable verdicts from juries. Although the statutes relating to independent and dependent claims are specific to patent laws, and thus specific to the Federal Circuit’s exclusive jurisdiction, the Federal Circuit has relied on the procedural rules of each circuit in determining whether the parties had preserved the issue for review on appeal. The inconsistencies between regional circuits on irreconcilable jury verdicts have led to different outcomes at the Federal Circuit in similar cases.

A. The Federal Circuit’s Rule of Deference on Procedural Interpretations

The Federal Circuit occupies a unique place among federal circuit courts because its jurisdiction is defined by subject matter rather than geography. The Federal Circuit hears appeals from all regional circuits, and the court often has to decide when to defer to the regional circuit’s interpretation of Federal law, and when it will apply its own interpretation.

Beginning in In re International Medical Prosthetics Research Associates, the Federal Circuit gave deference to regional circuit rules when interpreting procedural rules. The Federal Court stated:

Dealing daily with such procedural questions in all types of cases, a district court cannot and should not be asked to answer them one way when the appeal on the merits will go to the regional circuit in which the district court is located and in a different way when the appeal will come to this circuit. That potential problem is obviated, however, when this court applies the same guidance previously made available by the circuit . . . having authority over the district court under 28 U.S.C. § 1294.

This concern over the district court being forced to “serve[] two masters or that it should [look], Janus-like, in two directions” has led the Fed-

20. Compare 28 U.S.C. § 1294 and 28 U.S.C. § 1295. Although the Federal Circuit is often thought of solely in patent terms, it is important to note that it also hears appeals from the U.S. Court of Claims, the U.S. Court of International Trade, and the Merit System Promotion Board, among others. See, generally, Adam E. Miller, The Choice of Law Rules and the Use of Precedent in the Federal Circuit: A Unique and Evolving System, 31 OKLA. CITY U. L. REV. 301, 304-11 (2007). For the purposes of this note, however, only the court’s patent jurisdiction is relevant.


23. Id. at 620.

24. Biodex Corp. v. Loredan Biomedical, Inc., 946 F.2d 850, 856 (Fed. Cir. 1991) (internal quotations omitted).
eral Circuit to defer to regional circuit law "with regard to substantive legal issues not within our exclusive subject matter jurisdiction ... when reviewing cases arising under the patent laws." The Federal Circuit has also generally deferred to regional circuit law for interpretation of the Federal Rules of Civil Procedure and local rules of the district court. However, the Federal Circuit has indicated two situations in which it will not defer: "substantive and procedural issues intimately involved in the substance of enforcement of the patent right." Although the question of irreconcilability of independent and dependent claim verdicts implicates substantive law, the question on appeal often hinges on whether the parties properly preserved the question for appellate review, a question on which the Federal Circuit has deferred to the regional circuit interpretation. This has lead to different results depending on the location of the district court which decided the patent case.

B. An Example Case: Callaway v. Acushnet

In Callaway Golf Co. v. Acushnet Co., the U.S. District Court for the District of Delaware had to deal with an inconsistent jury verdict. In Callaway, the court asked the jury to determine whether certain claims of U.S. Patent No. 6,210,293, dealing with a multi-layered golf ball, were invalid due to obviousness. Among the claims the defendant challenged as obvious were Claim 4, an independent claim, and Claim 5, a dependent claim based on independent Claim 4. Because neither party requested a special verdict form under the Federal Rules of Civil Procedure, the jury returned only a multi-part general verdict form with no written findings for each issue of fact. The verdict form, with the jury's responses marked as an "X", was as follows:

25. Id. at 858.
26. Id. at 857 (citing Beckman Instrs., Inc. v. LKB Produkter AB, 892 F.2d 1547, 1550 (Fed. Cir. 1989) and Allen Organ Co. v. Kimball Int'l, Inc., 839 F.2d 1556, 1563 (Fed. Cir. 1988)).
29. Mycogen Plant Sci., Inc. v. Monsanto Co., 243 F.3d 1316, 1325 (Fed. Cir. 2001) ("The issue of inconsistent verdicts is a procedural issue that is not unique to patent law. The Federal Circuit applies the law of the regional circuit ... to the issue of inconsistent verdicts.").
31. Id. at 615.
32. Id. at 605–06.
34. Callaway Golf, 585 F. Supp. 2d at 616.
1. Has Acushnet proven, by clear and convincing evidence, that any of the following claims of U.S. Patent No. 6,210,293 (the '293 patent) is invalid due to obviousness?

"Yes" is a finding for Acushnet. "No" is a finding for Callaway.

(A) Claim 1 Yes No X
(B) Claim 4 Yes No X
(C) Claim 5 Yes X No

Thus, the jury found that independent Claim 4 was not obvious, and therefore valid, but dependent Claim 5 was obvious, and therefore invalid. In other words, the jury indicated it believed that the broader claim was not obvious, but the narrower claim was obvious.

Neither the court nor the parties had explained to the jury that a dependent claim cannot be invalid if the claim on which it depends is valid. In hindsight, the district court identified two factors that led to the lack of such an explanation. First, the parties' joint proposed verdict form contained only the question of invalidity for obviousness, and no specific limitations were included. The form only included an instruction, adopted by the court, that each claim is a "separate statement of the patented invention" to be considered "individually." Second, the court noted that while the Federal Circuit Bar Association's model jury instructions provide an instruction for dependent claims with respect to infringement, no such instruction exists with respect to the validity of dependent claims.

Although the district court recognized the irreconcilable nature of the jury verdict, it allowed the verdicts to stand. The court noted that under Third Circuit law, "inconsistency, alone, is insufficient to warrant a new trial absent an affect on [the] defendant's substantial rights." Citing the seven days of trial following "nearly two years of the parties' preparation and expense," the fact that the defendant had "stipulated that it infringes each of the Sullivan patents; three of which were held valid by the jury without reservation," and because "almost as often as not, the Federal

35. Id. at 615.
36. Id.
37. Id.
38. Id.
39. Id. at 615 n.17. The Federal Circuit Bar Association's model jury instructions are further discussed in Part III, infra.
40. Id. at 617 ("[T]he court will allow the verdict to stand and the appeal to go forward without further delay. Put another way, the court declines to allow the defendant another bite at the apple absent more compelling circumstances.").
41. Id. at 616–17 (citing Williamson v. Consol. Rail Corp., 926 F.2d 1344, 1353 (3d Cir. 1991)).
42. Id. at 617.
43. Id.
Circuit may reverse or remand any of the underpinnings upon which trial in the matter proceeded," the court entered judgment on the verdicts. On appeal, the Federal Circuit agreed with Acushnet that the jury verdicts represented irreconcilable verdicts. The Court found that both parties had preserved their objection to the inconsistency. Because Third Circuit law required a new trial where the verdicts could not be reconciled, the Federal Circuit vacated the judgment of the district court and remanded for a new trial on obviousness.

C. Situations in Which the Federal Circuit Has Upheld Irreconcilable Verdicts

1. The Issue of Waiver

The Federal Circuit encountered procedural facts similar to those in Callaway in Bradford Co. v. Jefferson Smurfit Corp., in which the court had to apply the law of the Sixth Circuit. In Bradford, the claims of U.S. Patent No. 4,966,280, dealing with an anti-static container, were at issue. Claim 11 was an independent claim, and Claims 12 and 17 were dependent on Claim 11. The jury, using special interrogatories submitted with the general verdict, found independent Claim 11 to be valid, but dependent Claims 12 and 17 to be invalid as both anticipated and obvious. In other words, according to the jury, the broader Claim 11 was novel, but the narrower Claims 12 and 17, which included all of limitations of Claim 11 plus additional limitations, had been found in the prior art. Neither Bradford, the patent holder, nor Jefferson Smurfit Corp. ("JSC"), the accused infringer,

44. Id.
45. Id.
46. Callaway Golf Co. v. Acushnet Co., 576 F.3d 1331, 1344 (Fed. Cir. 2009) ("A broader independent claim cannot be nonobvious where a dependent claim is invalid for obviousness.").
47. Id. at 1343.
48. Id. at 1344-45 ("Under Third Circuit law, in a case where a reading of the verdicts that would solve the apparent inconsistency proves impossible and the evidence might support either of the two inconsistent verdicts, 'the appropriate remedy is ordinarily, not simply to accept one verdict and dismiss the other, but to order an entirely new trial.'" (quoting Mosley v. Wilson, 102 F.3d 85, 90 (3d Cir. 1996)). Faced again with irreconcilable verdicts on the question of obviousness in Comaper Corp. v. Antec, Inc., 596 F.3d 1343, 1349-1350 (Fed. Cir. 2010), the Federal Circuit reiterated that the broader independent claim cannot be nonobvious when a dependent claim stemming from it is obvious. Because the evidence could have supported either verdict, the Federal Circuit remanded for a new trial in accordance with Third Circuit law. Id. at 1354-55.
50. Id. at *1.
51. Id.
52. Id. at *2.
immediately objected to the inconsistency, although the court gave both parties the opportunity to address “anything else” before it dismissed the jury. Following the dismissal, JSC moved for judgment as a matter of law or for a new trial asserting, among other reasons, the inconsistencies between the special interrogatories and general verdict. The district court denied the motion because JSC had failed to object to the inconsistencies before the jury was discharged, as was required under Sixth Circuit law.

The Federal Circuit affirmed the district court’s decision, concluding that JSC had waived its right to object under Sixth Circuit law. The Federal Circuit found the procedural facts of the case to be very similar to Tennessee Consolidated Coal Co. v. United Mine Workers, in which “the [trial judge] inquired: ‘Is there anything further that any counsel wishes to raise before the Court excuses the jury in this case?’ Counsel for both parties replied negatively and the jury was discharged.” The Sixth Circuit concluded that both parties in Tennessee Consolidated had waived the issue of verdict inconsistency by failing to object at this point. The Federal Circuit compared this sequence to what had happened at the district court level in Bradford:

“[A]fter the jury returned its verdict . . . the parties were afforded an opportunity to object to the verdict. Neither did so. The Court also inquired whether the parties had anything else to bring before the Court at that time. Again, [JSC did not raise] the issue of an inconsistent verdict.”

The Federal Circuit enforced the same stringent interpretation of the Sixth Circuit waiver rule in L&W, Inc. v. Shertech, Inc., even though the parties had only limited time to review the verdicts before the jury was dismissed. In L&W, the jury returned a special verdict including a finding that independent Claim 7 was valid, but dependent Claim 10, which was based on Claim 7, was invalid. The return of the jury’s verdict, the poll of the jury, and the court’s discharge of the jury, all occurred within six minutes, during which neither party apparently noticed or objected to the inconsistency. After the court discharged the jury, both parties recognized

53. Id.
54. Id.
55. Id.
56. Id. at *4.
59. Id.
60. Id. (quoting district court decision) (emphasis in original).
62. Id. at 1318.
63. Id. at 1319.
the inconsistencies in the verdicts, but the district court held that both had waivered their objections as to inconsistency because they failed to object before the discharge of the jury.64 This was in spite of the fact that the jury verdict included findings on all ten claims of the patent including two independent claims (Claim 1 and Claim 7) and eight dependent claims (Claims 2–6 dependent on Claim 1 and Claims 8–10 dependent on Claim 7).65 The Federal Circuit applied the waiver rule of the Sixth Circuit and agreed with the district court that the parties had waived their right to object to the inconsistencies.66 The Federal Circuit noted that the very use of a special verdict procedure “should alert lawyers to the possibility that the jury’s responses might be inconsistent.”67

Similarly, in Allen Organ Co. v. Kimball Intern., Inc., the Federal Circuit noted that under Seventh Circuit law, there is an obligation upon counsel to seek return of the jury when the interrogatory answers are inconsistent with each other and the general verdict is inconsistent with at least some of the interrogatory answers.68 Quoting the Seventh Circuit’s decision in Strauss v. Stratojac Corp., the Federal Circuit explained the purpose behind the waiver rule:

If counsel who had submitted the questions saw no inconsistency and raised no objection to the discharge of the jury, we can, at least under the circumstances of this case, see no reason why he should be permitted to try his luck with a second jury. Proper respect for the jury verdict and for the court’s responsibility to manage its caseload fairly and expeditiously militate against such a course.69

Although the Federal Circuit has not yet had the opportunity to determine whether the rule applies to each circuit, other circuits also apply some form of the waiver rule. The Federal Circuit would likely apply the same rule to a case originating in the Second Circuit as it does to cases arising in the Sixth and Seventh Circuits. In Lavoie v. Pacific Press & Shear Co., the Second Circuit held that a party waived the issue of inconsistent verdicts when that party failed to object prior to the discharge of the jury.70 The

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64. Id.
66. L & W, 471 F.3d at 1319.
67. Id. (citing Skillin v. Kimball, 643 F.2d 19 (1st Cir. 1981)).
68. 839 F.2d 1556, 1563 (Fed. Cir. 1988) (citing Strauss v. Stratojac Corp., 810 F.2d 679, 683 (7th Cir. 1987)). The allegedly inconsistent verdicts in Allen Organ were not of the independent/dependent type, but instead involved the on-sale bar and obviousness questions. The Federal Circuit held that the verdicts could be reconciled. Id.
69. Id. (quoting Strauss, 810 F.2d at 683).
First, Third, Fifth, Eighth, Eleventh, and D.C. Circuits have all advocated at least some form of the waiver rule.

If the Sixth Circuit’s waiver rule is the most stringent, the Fourth Circuit’s seems to be the most lenient. The Fourth Circuit, in Figg v. Schroeder, concluded that a party did not waive its objection to inconsistent verdicts by failing to move to resubmit the findings to the jury for reconsideration. In its decision, the Fourth Circuit cast the conflict as a constitutional question, quoting an earlier case for the proposition that “the legal error resulting from entry of a judgment based on inconsistent special interrogatories may be an error of constitutional magnitude, infringing the seventh amendment right to jury trial by allowing the District Court to usurp the jury’s function.” Thus, the Federal Circuit, in adherence to its rule of deference, would automatically order a new trial for irreconcilable verdicts when applying Fourth Circuit law.

Somewhere between the Sixth Circuit’s approach of absolute waiver after the dismissal of the jury and the Fourth Circuit’s approach of never waiving the inconsistency lies an intermediate approach. In Arachnid, Inc. v. Medalist Marketing Corp., the Federal Circuit discussed the Ninth Circuit’s approach to allegedly inconsistent jury verdicts, although it ultimately...
ly found that the verdicts could be reconciled.\textsuperscript{80} Under Ninth Circuit law, a party does not need to challenge the consistency of the verdict prior to the dismissal of the jury, but can make the challenge for the first time in a post-trial motion.\textsuperscript{81} If, however, there is no post-trial motion, appellate review is very limited, and the parties cannot raise a challenge to verdict consistency for the first time on appeal.\textsuperscript{82}

Thus, the Federal Circuit’s willingness to consider an inconsistent verdict varies based on the regional circuit in which the case originated. In appeals from most district courts in most circuits, if a party has not recognized and objected to the inconsistencies before the discharge of jury, the Federal Circuit will conclude that the party has waived its right to contest the inconsistency of the jury verdict. The Federal Circuit will apply this rule even where the time given the parties to review the verdict may be as little as six minutes.\textsuperscript{83} If, however, the case originates in a district court located in either the Fourth or Tenth Circuit, the Federal Circuit will conclude that a party who has not raised the issue of inconsistency at trial, or even in post-trial motions, has not waived the issue of inconsistent verdicts, and the Federal Circuit will vacate the judgment if the verdicts are indeed inconsistent.\textsuperscript{84} If the case arises in a district court located in the Ninth Circuit, the party does not need to raise the issue before the discharge of the jury, but must raise it at some point in post-trial motions for the Federal Circuit to conclude that the party did not waive the right to appeal the inconsistency in the jury verdicts.\textsuperscript{85} As a result, the Federal Circuit will allow inconsistent verdicts to stand in some cases where the party has failed to object prior to the discharge of the jury, but not others.

2. An Exception Under the Doctrine of Equivalents

The case of \textit{Wilson Sporting Goods Co. v. David Geoffrey \& Associates} presented a very narrow set of circumstances under the doctrine of equivalents in which the Federal Circuit indicated it might uphold seemingly inconsistent verdicts of independent and dependent claims.\textsuperscript{86} Although

\textsuperscript{80} Arachnid, Inc. v. Medalist Mktg. Corp., 972 F.2d 1300, 1304 (Fed. Cir. 1992). \textit{Arachnid} dealt with allegedly inconsistent jury verdicts between a state consumer protection law and a trade dress claim. The court found that these verdicts could be reconciled.

\textsuperscript{81} Id. (citing L.A. Nut House v. Holiday Hardware Corp., 825 F.2d 1351, 1356 (9th Cir. 1987)).

\textsuperscript{82} Id.

\textsuperscript{83} See L \& W, 471 F.3d at 1319 (Fed. Cir. 2006).

\textsuperscript{84} See Figg v. Schroeder, 312 F.3d 625, 643 (4th Cir. 2002) \textit{and} Johnson, 412 F.3d at 1141.

\textsuperscript{85} See Arachnid, 972 F.2d at 1304 (citing L.A. Nut House, 825 F.2d at 1356).

\textsuperscript{86} Wilson Sporting Goods Co. v. David Geoffrey \& Assoc., 904 F.2d 677, 685 (Fed. Cir. 1990). Although the court did not find the claims at issue to fall within this exception, it did note the possibility
the court ultimately determined that the accused products at issue did not infringe the claims either literally or under the doctrine of equivalents, it did indicate that it might be possible under the doctrine of equivalents to infringe the dependent claims without infringing the independent claims.87

Under the doctrine of equivalents, "a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is 'equivalence' between the elements of the accused products or process and the claimed elements of the patented invention."88 The purpose of this doctrine is to protect the patent holder from unscrupulous competitors who could make "unimportant and insubstantial changes and substitutions" that would not change the operation of the invention, but would remove it from the literal language of the claims.89 Under the doctrine of equivalents, infringement may occur if the accused product "performs substantially the same overall function or works in substantially the same way, to obtain substantially the same overall result as the claimed invention."90 However, the doctrine of equivalents cannot be used where the asserted scope of equivalency encompasses the prior art.91 This is because the patent holder cannot use the doctrine to cover subject matter she could not have obtained from the Patent and Trademark Office ("PTO") through literal claims.92

In Wilson Sporting Goods, the plaintiff claimed infringement of independent Claim 1 and several dependent claims of U.S. Patent No. 4,560,168, dealing with the pattern of dimples on a golf ball.93 The patent described a method for creating a more symmetrical distribution of dimples on the golf ball, with the shape and the width of the dimples being mostly immaterial.94 To describe the location of the dimples, the patent described the ball in terms of six circles and twenty triangles, and specified that the dimples were arranged as to not intersect the sides of the circles or triangles.95 The remaining claims were all dependent on Claim 1, and each fur-

of an exception under the doctrine of equivalents. However, for reasons discussed infra, claims meeting the exception would not actually be irreconcilable.

87. See id. at 685–86.
89. Graver Tank, 339 U.S. at 607.
90. Wilson Sporting Goods, 904 F.2d at 683 (quoting Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 934 (Fed. Cir. 1987) (en banc)).
91. Id.
92. Id. at 684.
93. Id. at 679.
94. Id.
95. Id. at 680.
ther limited the number and location of dimples with respect to the circles and triangles.  

The location of the dimples was critical in the litigation. The closest prior art to Wilson’s patent was manufactured by Uniroyal. The Uniroyal ball, when viewed in terms of the circles and triangles, had thirty or more dimples intersecting the circles by twelve to fifteen thousandths of an inch. The allegedly infringing balls, made by Dunlop and Slazenger, had dimples slightly intersecting the circles, the intersection ranging between four and nine thousandths of an inch. This meant that the allegedly infringing balls could not literally infringe the claims of Wilson’s patent, which required no overlap between the dimples and circles. However, Wilson argued for infringement under the doctrine of equivalents, and the jury agreed.

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Table 1: Summary of Products in Wilson Sporting Goods Co.

The Federal Circuit, however, reversed the jury’s finding of infringement on Claim 1. Using a “hypothetical patent claim, sufficient in scope to literally cover the accused product,” the Federal Circuit found that any hypothetical claim covering both Claim 1 and the accused products would have been obvious in light of the Uniroyal prior art. In other words, had Wilson sought to claim dimples not intersecting the circles and triangles through dimples intersecting the circles up to nine thousandths of an inch, the claim would have been rejected as obvious in light of the Uniroyal prior art. Therefore, the Dunlop and Slazenger balls did not infringe Claim 1 under the doctrine of equivalents.

Even though the Federal Circuit had found the independent claim was infringed, it went on to determine whether the dependent claims had been infringed. The court distinguished the case from cases involving literal

96. Id.
97. Id. at 680–81.
98. David Geoffrey & Assoc. does business as Slazenger. Id. at 677.
99. Id. at 681.
100. Id. at 678.
101. Id. at 685.
102. Id. at 684–85.
In cases of literal infringement, the claims do not involve potentially equivalent prior art. However, in cases of infringement by the doctrine of equivalents, the prior art may not lead to the same result with the dependent claims. But, in Wilson Sporting Goods, the Federal Circuit considered each dependent claim and concluded that, “none could be given a range of equivalents broad enough to encompass [the allegedly infringing balls] because that would extend Wilson’s patent protection beyond the hypothetical claims it could lawfully have obtained from the PTO.” Thus, the Dunlop and Salzenger balls did not infringe Wilson’s independent or dependent claims.

Using this analysis, however, a jury or court could determine that dependent claims are infringed under the doctrine of equivalents even when the independent claim on which they are based is not. For example, imagine the prior art included pencils consisting of a wooden shaft and graphite core where the wooden shaft was at least seven inches long, and none of the pencils were painted. Next consider two patent claims: Claim 1 on a pencil comprising a wooden shaft between six and six and one half inches in length and a graphite core; Claim 2 comprising the pencil of Claim 1 with the additional limitation that the wooden shaft is yellow. Finally, consider an allegedly infringing pencil comprising a wooden shaft six and three quarters inches in length, painted yellow, with a graphite core.

<table>
<thead>
<tr>
<th>Element</th>
<th>Prior Art</th>
<th>Patent Claim 1</th>
<th>Patent Claim 2</th>
<th>Alleged Infringer</th>
</tr>
</thead>
<tbody>
<tr>
<td>Graphite Core:</td>
<td>Yes</td>
<td>Yes</td>
<td>Yes</td>
<td>Yes</td>
</tr>
<tr>
<td>Wooden Shaft:</td>
<td>7” and longer</td>
<td>6–6.5”</td>
<td>6–6.5”</td>
<td>6.75”</td>
</tr>
<tr>
<td>Color:</td>
<td>None</td>
<td>-</td>
<td>Yellow</td>
<td>Yellow</td>
</tr>
</tbody>
</table>

Table 2: Summary of Products in Pencil Example

First, the alleged infringer does not literally infringe either Claim 1 or Claim 2. Next, the alleged infringer does not infringe Claim 1 under the doctrine of equivalents because the prior art limits the reach of the equivalents allowed under Claim 1. However, the prior art cannot be asserted against Claim 2 to limit the scope of the doctrine of equivalents. This is

103. Id. at 686.
104. Id.
105. Id.
106. Id.
107. See id. at 685–86.
because the prior art does not have the additional limitation of Claim 2, that the shaft be yellow. Because the equivalents of Claim 2 are not limited by the prior art, it is possible that the accused device infringes Claim 2, the dependent claim, under the doctrine of equivalents, even though it would not infringe Claim 1, the independent claim.\(^{108}\)

3. Other Circumstances

Apart from the issue of waiver and doctrine of equivalents, the Federal Circuit has upheld or indicated it would uphold irreconcilable jury verdicts in several other situations. In Minnesota Mining and Manufacturing Co. v. Chemque, the Federal Circuit applied Fifth Circuit law and held that if defendants argue to a district court that a verdict is reconcilable, then the party would be estopped from asserting that the verdicts are irreconcilable on appeal.\(^{109}\) In Minnesota Mining and Manufacturing ("3M"), the jury returned a special verdict, in which it had found independent Claim 1 not infringed, but dependent Claim 9 infringed.\(^{110}\) 3M raised the issue of irreconcilability to the district court and moved for a new trial.\(^{111}\) Chemque opposed this motion, arguing that the verdicts were not inconsistent.\(^{112}\) The district court ultimately agreed with Chemque and denied 3M's motion for a new trial.\(^{113}\) 3M did not appeal this ruling, but Chemque appealed the jury's findings with respect to Claim 9.\(^{114}\) The Federal Circuit held that Chemque was judicially estopped from raising the inconsistency issue because, "not only did [Chemque] not raise this inconsistency before the district court, they expressly argued against a finding of inconsistency."\(^{115}\) Therefore, the Federal Circuit reviewed the case "under the premise that the verdict is reconcilable," and refused to consider the substantive issue of irreconcilability.

The Federal Circuit has also indicated in dicta that it would uphold under Third Circuit law an irreconcilable verdict where the "verdict ap-

\(^{108}\) Such a situation could therefore give an independent claim that was not infringed while the dependent claim was found to be infringed under the doctrine of equivalents. However, because of the prior art limitations, these verdicts are not actually irreconcilable.

\(^{109}\) 303 F.3d 1294, 1302 (Fed. Cir. 2002).

\(^{110}\) Id. at 1299.

\(^{111}\) Id.

\(^{112}\) Id. (Defendants stated "This is not a situation in which the jury’s findings on essential issues are in irreconcilable conflict," such as might be the case where a jury finds, on the basis of a single factual allegation that a particular proposition is 'true' and, at the same time, that its corollary is 'not true'.").

\(^{113}\) Id. at 1300.

\(^{114}\) Id. at 1298.

\(^{115}\) Id. at 1302.
pears to be the result of compromise [by the parties] as opposed to jury confusion." 116 In these situations, policy concerns of enforcing the compromise agreed to by the parties support the legal fiction that such claims could be reconciled.

III. SOLUTIONS

As the cases already discussed have shown, despite clear instructions from the Federal Circuit that a dependent claim cannot be infringed or invalid as anticipated or obvious unless the independent claim on which it is based is also found infringed or invalid, irreconcilable verdicts are returned by juries and upheld by courts. Parties have lost their opportunity to object to the inconsistencies by not realizing the inconsistencies until it is too late under the specific procedural rules of the circuit.

These problems must be placed in the context of the complexity of patent litigation. 117 For example, consider the complex series of jury verdicts at issue in Wahpeton Canvas Co., Inc. v. Frontier, Inc.. 118 The plaintiff, Wahpeton Canvas, had sued two defendants, Frontier, Inc. and Agri Cover for infringement of its patent on roll-up truck bed covers. 119 The Federal Circuit provided the following description of the case:

The present is another appeal following a trial process plagued with a plethora of pusillanimous presentations. Thirty claims were asserted against one defendant’s product and 29 against the other differing product; two claims against only the first; one claim against only the second; and one claim against neither. 120

The jury returned a verdict by checking “yes” or “no” alongside a series of questions dealing with infringement for each claim number, but the questions did not identify each claim as either independent or dependent. 121 The jury was “properly instructed that a dependent claim includes all the limitations of the claim from which it depends.” 122 The Federal Circuit summarized the jury’s responses:

(1) Agri Cover had not infringed [independent] claims 1 or 11;

116. Callaway Golf Co. v. Acushnet Co., 576 F.3d 1331, 1345 n.10 (Fed. Cir. 2009) (“There is no contention that the verdict here could plausibly be considered such a compromise.”).
117. Kimberly A. Moore, Juries, Patent Cases, & A Lack of Transparency, 39 Hous. L. Rev. 779, 784 n.27 (2002) Professor Moore cites a National Academies Committee report that the Administrative Office of the Courts considers patent cases 1.7 times more complex than the average civil case.
119. Id. at 1547-48.
120. Id. at 1551.
121. Id. at 1547.
122. Id. at 1553.
(2) Agri Cover had not infringed [dependent] claims 2–4, 6, 9, 10, 12, 13, 16–19, 22–25, or 27–31;
(3) it could not answer on whether Agri Cover had infringed [independent] claims 14 or 21;
(4) it could not answer on whether Agri Cover had infringed [dependent] claims 7, 15, 20, 26, or 32. . . .

Following the trial, Wahpeton moved for judgment notwithstanding the verdict for infringement and for judgment that Agri Cover and Frontier infringed on the claims that the jury did not decide. Agri Cover and Frontier filed motions for judgment that they had not infringed the claims that the jury did not decide. The district court granted the motions of Agri Cover and Frontier, and Wahpeton appealed, alleging “jury confusion.”

The Federal Circuit attempted to salvage any “good part of [the] trial.” The Federal Circuit affirmed as to Claims 1–4, 6, 7, 9–13, and 22–32 and remanded for a new trial on infringement for Claims 14, 15, 20, and 21. This included the two independent claims on which the jury had not decided, 14 and 21, as well as the claims dependent on those claims that the jury had not answered, 15 and 20. Additionally, the Federal Circuit affirmed the trial court’s judgment of no infringement for dependent Claims 7, 26, and 32, that the jury had not answered, but which were dependent on claims that the jury had found no infringement on. In other words, the Federal Circuit affirmed those results for which the jury had found no infringement of the independent claims and all of the dependent claims based on those independent claims, regardless of how the jury answered on the independent claims. Then, the Federal Circuit remanded for a decision on the independent claims that the jury had not answered on, as well as the dependent claims based on these independent claims. All of these results are consistent with the Federal Circuit’s view that “It is axiomatic that dependent claims cannot be found infringed unless the claims from which they depend have been found to have been infringed . . . .”

123. Id. at 1547 (bracketed insertions in original). The same jury also found that (5) Frontier had not infringed three independent claims, (6) Frontier had not infringed twenty dependent claims, (7) it could not answer on whether Frontier infringed one claim (8) the patent was not inequitably procured, (9) Claims 1–4, 6–13, and 15–32 were not invalid, and (10) it could not answer on whether Claim 14 was not invalid. A separate trial on Frontier’s counterclaims immediately following the infringement trial. However, only the claims against Agri Cover will be considered here.
124. Id. at 1548.
125. Id. at 1548, 1553.
126. Id. at 1551.
127. Id. at 1556.
128. Id. at 1552–53.
129. Id. at 1553.
Several options exist for correcting the problem of irreconcilable jury verdicts. First, the district courts have the opportunity to correct irreconcilable jury verdicts through the use of special and general interrogatories. Second, model jury instructions for invalidity of independent and dependent claims, similar to those already in place for infringement, should be adopted. Finally, the Federal Circuit could choose to view irreconcilable verdicts on independent and dependent claims as an issue unique to patent law and not defer to regional circuit procedural rules.

A. District Courts' Opportunity to Correct Through Rule 49(b)

First, the district courts have the opportunity to correct any irreconcilable jury verdicts through the use of special and general interrogatories. Currently, if a jury does return an irreconcilable verdict, and either the court or one of the parties realizes the inconsistency, the court has the opportunity to correct the verdict through the use of Rule 49(b). In relevant part, Rule 49(b) provides:

When the answers [to special interrogatories] are consistent with each other but one or more is inconsistent with the general verdict, the court may: (A) approve, for entry under Rule 58, an appropriate judgment according to the answers, notwithstanding the general verdict; (B) direct the jury to further consider its answers and verdict; or (C) order a new trial.

As with the issue of waiver, the Federal Circuit defers to the rules of the regional circuits in determining to when a court may use each option. The issue of inconsistent jury verdicts under Seventh Circuit rules occurred in Intermatic, Inc. v. The Lamson & Sessions Co. The jury had found independent Claim 1 to be valid, but dependent Claims 6, 9, and 11 to be invalid due to obviousness. In other words, a person having ordinary skill in the art would have thought that Claim 1 was not obvious, but that by further narrowing the claim it was obvious. Both Intermatic and Lamson moved for a judgment as a matter of law based on the inconsistent obviousness verdict. Rather than order a new trial, the court decided to

131. Id.
132. For an examination of the issues surrounding the problems with resubmitting inconsistent findings back to the jury, see Donald Olander, Resolving Inconsistencies in Federal Special Verdicts, 53 FORDHAM L. REV. 1089 (1985).
133. 273 F.3d 1355 (Fed. Cir. 2001), vac'd on other grounds, 537 U.S. 1016 (2002).
134. Id. at 1368.
135. Id. at 1362.
grant Intermatic's motion based on the jury's responses to other special interrogatories.136

Before the Federal Circuit, Lamson argued that under Seventh Circuit law it was entitled to a new trial because the verdicts were inconsistent.137 Additionally, Lamson pointed to the fact that the jury had "scribbled-out and changed 'yes' answers" in the special interrogatory questions as evidence that the jury was confused.138 Intermatic responded that the changed answers showed that the jury had carefully deliberated its answers.139 Intermatic argued the district court was correct in using the jury's answers to the special interrogatories to resolve the conflict in the general verdicts.140 Intermatic pointed to Rule 49(b) of the Federal Rules of Civil Procedure for the proposition that when answers to jury interrogatories are consistent with each other, but not with the general verdict, the court may enter judgment in accordance with the answers to the interrogatories, notwithstanding the general verdict.141

The Federal Circuit agreed that Rule 49(b) allowed the district court to enter judgment pursuant to the jury's answers to the special interrogatories.142 The Federal Circuit determined that Seventh Circuit law only granted that a new trial where the verdicts were "logically incompatible to the extent that they cannot be reconciled by reference to the evidence supporting them."143 According to the Federal Circuit, the district court had three options, "(1) order the jury to consider its answers further; (2) order a new trial; or (3) harmonize the verdict with the answers." Because the jury's answers to the special interrogatories were consistent with a finding of nonobviousness on any of the claims, the district court did not err in resolving the conflicting jury findings and granting Intermatic's motion for judgment as a matter of law.144

136. *Id.*
137. *Id.* at 1368.
139. *Id.* at *47.
140. *Intermatic*, 273 F.3d at 1368.
141. *Id.* (citing Fed. R. Civ. P. 49(b)).
142. *Id.* at 1369.
143. *Id.* (citing Stone v. City of Chicago, 738 F.2d 896 (7th Cir. 1984) (internal quotation marks omitted)). This seems to be the general approach of the circuits. See e.g. Mazloum v. D.C. Metro. Police Dep't., 576 F. Supp. 2d 25, 40 (D.C. Cir. 2008) (citing with approval Third Circuit law that proper to grant new trial, not enter judgment for one side, when verdicts are "irreconcilably inconsistent").
144. *Intermatic*, 273 F.3d at 1369 (Fed. Cir. 2001).
B. Adoption of a Model Jury Instruction for Invalidity

Second, the problem of irreconcilable jury verdicts with respect to independent and dependent claims could be reduced by the adoption of an appropriate model jury instruction. As illustrated above in the Wahpeton Canvas case, merely stating that dependent claims contain the limitations of the independent claims on which they depend is not sufficient to give the jury guidance in determining the validity and infringement of the related claims. By properly instructing the jury as to the relationship between the claims, two benefits are realized. First, including language specifically stating that if the jury finds an independent claim is not infringed or invalid because of anticipation or obviousness, then it must find any claims dependent upon that claim not infringed or invalid will give the jury better instructions as to the law in this area. Such language currently exists for infringement.\(^{145}\) Second, including this language will alert the court and the parties of the potential for the sort of independent/dependent irreconcilable verdicts discussed in this note. This is especially important where the court may quickly dismiss the jury following the return of the verdict, such as in L & W discussed previously.

Model jury instructions of this sort are already available for independent and dependent claim infringement. Currently, the Federal Circuit Bar Association ("FCBA"), American Intellectual Property Law Association ("AIPLA"), and American Bar Association ("ABA") all have model jury instructions relating to infringement of independent and dependent claims.

The FCBA's instruction explicitly states the problems associated with independent and dependent claim infringement, and directs the jury on what it can and cannot do. The FCBA’s model jury instruction 3.1a states in part:

You must determine, separately for each asserted claim, whether or not there is infringement. There is one exception to this rule. If you find that a claim on which other claims depend is not infringed, there cannot be infringement of any dependent claim that refers directly or indirectly to that independent claim. On the other hand, if you find that an independent claim has been infringed, you must still decide, separately, whether the additional requirements of any claims that depend from the independent claim are present in the [product or process] and thus, whether those claims have also been infringed. A dependent claim includes all the re-

requirements of any of the claims to which it refers plus additional requirements of its own. 146

This instruction tells the jury that if it finds an independent claim not infringed then it cannot find any claim dependent on that claim infringed.

AIPLA’s model jury instruction is less complicated, but still captures the problem and instructs the jury to avoid the independent and dependent problem in the context of infringement. AIPLA’s model jury instruction 3.6, Infringement of Dependent Claims, states in part:

If you find that the [Independent Claim] from which [Dependent Claim] depends is not literally infringed, then you cannot find that [Dependent Claim] is literally infringed. 147

Unlike the FCBA and AIPLA instructions, the National Patent Jury Instructions only discuss independent and dependent claims generally, and do not provide specific guidance in the infringement context. NPJI’s model jury instruction 3.7 deals with infringement of dependent claims:

So far, my instructions on infringement have applied to what are known as independent claims. The patent also contains dependent claims. Each dependent claim refers to an independent claim. A dependent claim includes each of the requirements of the independent claim to which it refers and one or more additional requirements.

In order to find infringement of dependent claim [ ] of the [XXX] patent, you must first determine whether independent claim [ ] of the patent has been infringed. If you decide that the independent claim has not been infringed, then the dependent claim cannot have been infringed. If you decide that the independent claim has been infringed, you must then separately determine whether each additional requirement of the dependent claim has also been included in the accused product [method]. If each additional requirement has been included, then the dependent claim has been infringed. 148

None of the instructions, however, instruct the jury as to invalidity due to anticipation or obviousness. Even though the FCBA and AIPLA instructions explicitly state that a dependent claim cannot be infringed unless the independent claim on which it is based is also infringed, none of the model jury instructions make a similar statement with regard to validity. The addition of an explicit statement regarding dependent claims in the context of validity would address this issue. The proposed instruction states:


A dependent claim includes all of the requirements of any of the claims to which it refers, plus additional requirements of its own. Therefore, if you find that an independent claim is not anticipated or nonobvious, then you must also find that any claim that depends from it is not anticipated or nonobvious.

To show how such an instruction would work, consider *Callaway Golf*, supra, in which the district court specifically pointed to the lack of such a model jury instruction.149 In *Callaway Golf*, the jury returned a verdict finding independent Claim 4 not obvious, but dependent Claim 5 obvious. Under the proposed model jury instruction, Claim 4 was found to be nonobvious, so the jury would be instructed to find any claim that depends from it, Claim 5 in this case, to also be nonobvious.

In *TAP Pharmaceutical Products, Inc. v. Atrix Laboratories, Inc.*, a jury returned irreconcilable verdicts, finding independent Claim 1 to be valid, but dependent Claim 2 to be both anticipated and obvious.150 Both parties had agreed to the special verdict form, and the jury was instructed as to the meaning of independent and dependent claims.151 The defendants moved for a mistrial, but the court re instructed the jury and submitted a new verdict form.152 The new verdict form indicated that if the jury found claim 1 invalid, then it should not render a verdict as to Claim 2.153 The jury found Claim 1 invalid, did not give a finding on Claim 2, and the court entered the judgment.154 On appeal, the defendants argued that the jury was confused, and that the court erred when it did not order a new trial.155 The parties settled after briefing, but prior to the Federal Circuit ruling on the case.156 However, if the proposed jury instruction had been used, the jury would not have returned with the original verdict, thus not needing to be instructed a second time.

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151. Id.
152. Id.
153. Id.
154. Id.
155. Id.
C. Changing the Federal Circuit’s Approach Under the Rule of Defe-
rence

Finally, the Federal Circuit could choose not to defer to regional circuit law for irreconcilable jury verdicts from independent and dependent claims. As discussed in Section I, supra, the Federal Circuit generally defers to regional circuit law for issues of procedure.\textsuperscript{157} However, the Federal Circuit has made clear that it does not defer to regional circuit rules in all procedural cases.\textsuperscript{158} “[W]hen the question on appeal is one involving substantive matters unique to the Federal Circuit . . . we apply to [sic] related procedural issues the law of this circuit.”\textsuperscript{159}

Professor Schaffner has categorized the legal issues confronting the Federal Circuit into five categories:

1. Substantive issues within its exclusive jurisdiction, 2. procedural issues which implicate or pertain to the substantive patent law, 3. procedural matters relating to the court’s own appellate jurisdiction, 4. procedural matters not unique to the patent law, and 5. substantive issues not within its exclusive jurisdiction.\textsuperscript{160}

Professor Schaffner indicates that the court exercises independent judgment for categories one through three and defers to regional circuits for categories four and five.\textsuperscript{161} Therefore, the question of whose law to apply with respect to irreconcilable independent and dependent verdicts on appeal, would seem to turn on whether the issue was unique to patent law.

However, the court’s application of this rule has not always led to expected results.\textsuperscript{162} In \textit{Beverly Hills Fan Co.}, the Federal Circuit declined to

\textsuperscript{157} Biodyex Corp. v. Loredan Biomedical, Inc., 946 F.2d 850, 857 (Fed. Cir. 1991).
\textsuperscript{158} Id. at 858.
\textsuperscript{159} Id (quoting Chrysler Motor Corp. v. Auto Body Panels of Ohio, Inc., 908 F.2d 951, 953 (Fed. Cir. 1990)) (emphasis in original).
\textsuperscript{161} Id. at 1181–82.
\textsuperscript{162} See Id. at 1186–89 (1996) (noting that “the requirement that the issue be ‘unique to’ the patent laws is not always necessary for the Federal Circuit to exercise independent judgment over a procedural issue”). This inconsistency has led to calls for reforming or abandoning the rule of deference. See e.g. Peter J. Karol, \textit{Who’s at the Helm? The Federal Circuit’s Rule of Deference and the Systemic Absence of Controlling Precedent in Matters of Patent Litigation Procedure}, 37 AIPLA Q.J. 1, 43 (2009) (“The many factors that point against keeping the Rule of Deference clearly outweigh the limited benefits that point in favor of maintaining it.”); Adam E. Miller, \textit{The Choice of Law Rules and the Use of Precedent in the Federal Circuit: A Unique and Evolving System}, 31 Okla. City U. L. Rev. 301, 330 (2006) (considering a shift towards either more deference or more independent review would decrease the level of confusion); Kimberly A. Moore, \textit{Juries, Patent Cases, & A Lack of Transparency}, 39 Hous. L. Rev. 779, 800 (2002) (“Perhaps the Federal Circuit should apply its own law to all procedural issues arising in patent cases.”); Schaffner, supra note 160, at 1206 (“[T]he Federal Circuit should exercise independent judgment unless deference to regional circuit law serves a significant interest.”); Sean M. McEldowney, Comment, \textit{The ‘Essential Relationship’ Spectrum: A Framework for Addressing Choice of
defer in evaluating personal jurisdiction, an area that would not seem to be unique to patent law. In Manildra Milling Corp. v. Ogilvie Mills, Inc., the court declined to defer to the Tenth Circuit’s definition of “prevailing party” and its appellate standard of review. In Manildra Milling, the Federal Circuit noted that the trial court would not be burdened by having to apply Federal Circuit law because the issue would not arise until after the completion of the trial.

In Biodex Corp. v. Loredan Biomedical, Inc., the Federal Circuit determined that whether a post-verdict motion is necessary to appeal the sufficiency of the evidence underlying a jury verdict was not subject to regional circuit law deference. In coming to this conclusion, the court determined that there would be no concern with district courts having to apply two sets of procedural laws during trial because whether an underlying factual issue can be reviewed is one that can “only arise after all the evidence is submitted and the verdict returned,” and the availability of appellate review does not affect either procedural or substantive issues during the trial. In addition, the Federal Circuit had declined to defer to regional circuit law in cases involving the issuance of preliminary injunctions, whether a claim should have been previously asserted as a compulsory counterclaim, whether materials are relevant—and thus discoverable—in patent litigation, and the application of attorney-client privilege to an invention record submitted to in-house counsel.

In contrast, the Federal Circuit deferred to regional circuit courts in determining the pleading requirements of a pro se plaintiff in a patent suit in McZeal v. Sprint Nextel Corp. Because pleading standards were not unique to patent law, the Federal Circuit looked to Fifth Circuit law for the circuit’s general standards and more lenient standard for pro se plaintiffs.


165. Id. at 1182.
166. 946 F.2d 850, 855, 859 (Fed. Cir. 1991).
167. Id. at 859.
169. Polymer Indus. Prod. Co. v. Bridgestone/Firestone, Inc., 347 F.3d 935, 938 (Fed. Cir. 2003). Although the suit involved in Polymer was a patent infringement suit, whether it was a compulsory counterclaim would seem not to be unique to patent laws and instead to be much more related to Fed. R. Civ. P. 13(a).
173. Id.
Because the Supreme Court had recently articulated pleading standards in antitrust cases in *Bell Atlantic Corp. v. Twombly*, the Federal Circuit used an earlier case it had decided under Eleventh Circuit law, *Phonometrics, Inc. v. Hospitality Franchise Systems*, and concluded that the plaintiff’s sparse pleadings identifying the patent and accused patent were sufficient for a pro se plaintiff.\(^{174}\) The result of the Federal Circuit using Eleventh Circuit precedent to predict what the Fifth Circuit would do has resulted in an inconsistent approach by district courts attempting to apply *McZeal*.\(^{175}\) The Northern District of Georgia cited *McZeal* in a 2007 case for the “interesting[] proposition that Eleventh Circuit law governed the issue”, but approached the issue with its own thorough analysis rather than follow the Federal Circuit’s decision.\(^{176}\) However, the Eastern District of Virginia and District of Minnesota decided to use the *McZeal* analysis when they found no local controlling authority.\(^{177}\) The minimum pleading requirements for initiating a patent suit, an area that seems to involve very substantive factors, will be viewed by the Federal Circuit on appeal through deferring to regional circuit law.

Any rule allowing for appellate review of irreconcilable jury verdicts regardless of whether the party raised the issue to the district court would function much the same way as the rules in *Manildra Milling* and *Biodex*, in that a rule change would not interfere with the trial court’s management of the trial. Instead, the rule would only have effect after the verdict was rendered. Much of the language the court used in coming to its decision in *Biodex* for appellate review of a jury verdict for sufficiency of the evidence would apply equally to allowing appellate review of an inconsistent jury verdict:

Uniformity in the review of patent trial is enhanced, rather than hindered, by our adoption of a single position. . . . Indeed, an opposite rule would be confusion, as the same patent . . . might have the same dispositive factual finding reviewed or not depending upon which of differing regional circuit laws was applicable.\(^{178}\)

\(^{174}\) *Id.* at 1357 (Fed. Cir. 2007) (citing Phonometrics, Inc. v. Hospitality Franchise Sys., 203 F.3d 790 (Fed. Cir. 2000)).

\(^{175}\) Karol, *supra* note 162, at 9.

\(^{176}\) *Id.* (discussing CBT Flint Partners, LLC v. Goodmail Sys, Inc., 529 F. Supp. 2d 1376 (N.D. Ga. 2007)).


\(^{178}\) *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 859 (Fed. Cir. 1991). To the extent that anticipation is considered a factual question, a party with an irreconcilable verdict could attempt to argue that the evidence was insufficient—and indeed could never be sufficient—to uphold such a verdict. In light of the Federal Circuit’s application of the Sixth Circuit’s waiver rule, however, a party is unlikely to win this argument at the current time.
However, even the adoption of a more modest proposal that the motion could be made as a post-trial motion would advance the goal of eliminating irreconcilable verdicts. The finding of fact, either the invalidity or infringement of an independent claim and related dependent claim, has a substantial relationship to patent law. Dependent claims only exist because they are specifically allowed in 35 U.S.C. § 112, a vital component of the Patent Act. The same uniformity concerns that prompted the Manildra Milling and Biodex courts to decline deference to regional circuit rules seems at least as strong in issues of logical invalidity or infringement. The availability of such review would not change any procedural or substantive rule up until the point the jury returns with the verdict. Additionally, the fairness concerns with requiring counsel to recognize an independent/dependent inconsistency within a time as short as six minutes seem valid.

Concern that setting out special procedural requirements for patent litigation would cause problems in the administration of such trials by district courts is over-estimated. First, consider that many districts have established local patent rules or individual rules specific to patent litigation, and most patent litigation practitioners tend to practice nationally. Second, the Federal Circuit’s decisions, discussed supra, about what procedural rules are essentially related to substantive patent law also indicate that district courts are already dealing with these issues.

Should the Federal Circuit establish such a rule, there would be concern that a party might intentionally fail to object to an irreconcilable verdict in order to force a second trial and hope for a more favorable result. However, the burden to point out the irreconcilable nature of the verdict would fall on the opposing party to point out the problem to the court. A party presented with irreconcilable verdicts may not wish to give the jury a second chance for fear that the jury may return a less favorable result. However, the adoption of the model jury instruction, as proposed above, would serve to alert both parties and the court of the possibility of such conflicts.

181. Karol, supra note 162, at 29 n.142 (discussing a number of districts having adopted such rules, including the Northern District of California and the Eastern District of Texas, and others, such as the District of Massachusetts, that provide recommended schedules for patent cases).
CONCLUSION

Despite clear rules from the Federal Circuit regarding the validity and infringement relationships of independent and dependent claims, juries have returned irreconcilable verdicts. In some cases, these have been corrected either by the trial court or the Federal Circuit on appeal. However, because of the way in which the Federal Circuit has applied its rule of deference, regional circuit rules have allowed these irreconcilable verdicts to stand.

Three solutions are proposed in an attempt to solve these problems. First, the district courts should regularly use special and general interrogatories to allow for the opportunity to correct any irreconcilable jury verdicts. Second, the adoption of a more explicit jury instruction with regard to invalidity of independent and dependent claims would help to guide the jury to consistent verdicts, as well as alert the court and parties to the existence of a potential problem immediately when the verdicts were returned. Finally, the Federal Circuit should modify its rule of deference to consider irreconcilable verdicts of independent and dependent claims under its own independent analysis. An approach allowing for appellate review regardless of post-verdict motions is advocated, although a more modest position of requiring a post-verdict motion would promote many of the goals.