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THE PATENT LAWYER AND TRIAL BY JURY*

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RIGHT TO TRIAL BY JURY

Whether in a patent case a party has the right to a trial by jury is a question of the nature and form of the remedy sought, the division between law and equity being determinative of that right.[1] In those cases where an equitable remedy, such as an injunction, is requested, the claimant or counterclaimant[2] is not entitled to a jury.[3] On the other hand, if only legal claims are asserted, such as damages, the case may, upon timely request, be tried before a jury.[4]

When both legal and equitable claims are asserted, as is the case in most patent suits, the traditional view was to determine the character of the suit. If the suit was equitable in character, there was no right to a trial by jury. If the suit was essentially at law, a jury trial was available as a matter of right.

The pre-1952 patent laws were consistent with the tradi-

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[1] In suits at common law . . . the right of trial by jury shall be preserved. . . . U. S. CONST. AMEND. VII. In the absence of a statute, only those actions which traditionally required a jury at common law are preserved by the Seventh Amendment. Needless to say, this does not include all actions at law. Nevertheless, the distinction between law and equity can approximately be considered to demarcate jury causes from non-jury causes. *See* 5 MOORE'S FEDERAL PRACTICE ¶38.08 [5] (1) (2nd ed. 1966); James, *Right to a Jury Trial in Civil Actions*, 72 YALE L. J. 655 (1963).

[2] *See* Ryan Distributing Corp. v. Caley, 51 F. Supp. 377 (E.D. Pa. 1943) for the proposition that claimant and counterclaimant have equivalent right to a jury in a patent case.

[3] The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable. 35 U.S.C. §283 (1954).

[4] Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court. When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed. The court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances. 35 U.S.C. §284 (1954).

tional view of the duality of law and equity. Section 67[5] related to the legal remedy of damages and Section 70[6] related to equitable remedies and included concurrent incidential damages. Moreover, rarely did questions arise concerning the right to a jury trial in such cases. It was the accepted view of the courts that ". . . many patent infringement suits seek an injunction and an accounting. Consequently, they are equitable in character and not triable by a jury. . . ."[7]

The case of *Davies* v. *Allied Industrial Products*[8] is typical of the early decisions resolving the issue of the right to jury trial. The plaintiff charged infringement and prayed for an injunction and recovery of damages and profits. Defendant denied the infringement and alleged invalidity. The court held that, "the plaintiff . . . formed his complaint seeking relief under the equitable proceeding provided by the statute [35 U.S.C. 70 (1946)]. The relief he requests is injunctive and consequently there inures to him no right to trial by jury pursuant to the Seventh Amendment to the Constitution."[9]

In 1952 Congress passed a new patent act which repealed Sections 67 and 70 of the prior act and replaced them with similarly worded Sections 283[10] and 284[11]. In addition, a new Section 281 was added as introductory to Sections 283 and 284. Section 281 of the Patent Act of 1952 states that, "a patentee shall have remedy by civil action for infringement of his patent."[12] At first glance, one might think that Section 281 changed the law by calling for a single remedy. However, the consensus was that this was merely a recodification.[13]

Attitudes soon changed. In 1959 the United States Supreme

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[5] Damages for the infringement of any patent may be recovered. . . . And whenever . . . a verdict is rendered for the plaintiff, the court may enter a judgment thereon. . . . , 35 U. S. C. §67 (1946).

[6] [C]ourts vested with jurisdiction . . . shall have power to grant injunctions according to the course and principles of courts of equity . . . and upon a judgment . . . the complainant shall be entitled to recover general damages. . . . , 35 U. S. C. §70 (1946).

[7] BARRON & HOLTZHOFF, FEDERAL PRACTICE AND PROCEDURE WITH FORMS, Sec. 876 (Rules ed. 1960); *see also*, Beaunit Mills, Inc. v. Eday Fabric Sales Corporation, 124 F. 2d 653 (2d Cir. 1942).

[8] 100 F. Supp. 109 (N. D. Ill. 1951).

[9] *Id.* at 110.

[10] Note 3, *supra.*

[11] Note 4, *supra.*

[12] Section 281 attempted to abrogate the duality concept evident from the prior sections 67 and 70. The concept of a single "civil action" embracing law and equity thus brought the patent law in line with the Federal Rules of Civil Procedure promulgated in 1938. Nevertheless, the transition to a single "civil action" was not total as evidenced by Sections 283 and 284 of the Patent Act of 1952.

[13] BARRON & HOLTZHOFF, FEDERAL PRACTICE AND PROCEDURE WITH FORMS, Sec. 876 (Rules ed. 1960).

Court in the case of *Beacon Theatres* v. *Westover*[14] indicated that these traditional concepts diluted the right of trial by jury and would no longer be followed. The Supreme Court held, *inter alia,* that the District Court abused its discretion in ordering a trial of the equitable issues first. The court reasoned that the District Court's decision, in effect, deprived the defendant of a jury trial because facts decided by the judge would act as collateral estoppel on the issues of fact common with the legal cause of action.

Lowers courts, inspired by *Beacon Theatres,* re-evaluated their former interpretations of Sections 281 *et seq.* of the Patent Act of 1952.[15] In the patent infringement case *Inland Steel Products Co.* v. *MPH Corp.*[16] the court for the Northern District of Illinois was confronted with numerous claims and counterclaims, some purely equitable, some mixed law and equity, and some purely legal. In analyzing the applicable remedy provisions of the Patent Act, the court stated:

> " . . . former Section 67 of the Act . . . authorized an action for damages. The other, former Section 70 of the Act, . . . provided for injunctive relief, along with the rewarding of damages by the court . . .
>
> "The 1952 Patent Act has changed the remedy provisions of the former statute, one section now authorizing the recovery of damages (35 U.S.C. §284), and another authorizing the obtaining of an injunction (35 U.S.C. §283). The latter provision contains no authorization for the awarding of damages by the court . . . ."[17]

Citing *Beacon Theaters,* the court concluded that all issues relating to damages should be tried first before a jury.

In 1961 the principle of the *Beacon Theatres* case was applied to a patent infringement case by Judge Wisdom in *Thermo-Stitch, Inc.* v. *Chemi-Cord Processing Corp.*[18] Chemi-Cord, the

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[14] 359 U. S. 500 (1959). The original complaint by the Fox West Coast Theatres, Inc. sought a declaration that it was not in violation of the antitrust laws with respect to the distribution arrangement between it and certain movie distributors. In addition, it sought to enjoin Beacon Theatres from prosecuting antitrust action against it arising from such distribution arrangements. Beacon counterclaimed for treble damages under the Clayton Act [38 STAT. 731 (1914, 15 U.S.C. §15 (1958)] and demanded a trial by jury. The District Court ordered that the equitable issues contained in the primary action be tried first and the remaining legal issues be tried subsequently by a jury. Beacon sought a writ of mandamus against the trial judge to vacate his order of trial. On certiorari to the United States Supreme Court, the Court granted the writ on the ground, *inter alia,* that a prior determination in equity would deprive Beacon of its constitutional right to a trial by jury. The Court reasoned there were issues common to both the equitable and legal causes of action, and that their prior adjudication in equity would act as a bar to their relitigation in the subsequent jury proceedings.

[15] Sections 281-293 are entitled, Remedies for Infringement of Patent, and Other Actions.

[16] 25 F.R.D. 238, 126 U.S.P.Q. 109 (N.D. Ill. 1959).

[17] *Id.* at 245, 246; 126 U.S.P.Q. at 114.

[18] 294 F. 2d 486, 131 U.S.P.Q. 1 (5th Cir. 1961).

alleged infringer, brought suit to enjoin Thermo-Stitch, the patent owner, from harassing its customers by threats of infringement suits. Chemi-Cord also prayed for a declaratory judgment that the patents of Thermo-Stitch were invalid and not infringed. Thermo-Stitch counterclaimed for infringement, fraud, and antitrust violations and asked for a jury on the issues of fact raised by the counterclaims. Chemi-Cord moved for immediate separate trial on the validity and infringement issues and, in addition, moved to strike Thermo-Stitch's motion for a trial by jury on those issues. The court decided that, "it would make no difference if the equitable cause clearly outweighed the legal cause so that the basic issue of the case taken as a whole is equitable. As long as any legal cause is involved, the jury rights it creates control."[19]

The following year, 1962, the Supreme Court decided the case of *Dairy Queen* v. *Wood*.[20] This decision removed all doubt that the holding in *Beacon Theatres* applied to cases seeking an injunction and an accounting. The court stated, citing both *Beacon Theatres and Thermo-Stitch*:

> " . . . where both legal and equitable issues are presented in a single case, 'only under the most imperative circumstances, circumstances which in view of the flexible procedures of the federal rules we cannot now anticipate, can the right to a jury trial of legal issues be lost through prior determination of equitable claims.' "[21]

The "imperative circumstances" requisite for a nonjury trial or for a trial in equity prior to one at law were not defined by the court. However, the court did state that a nonjury trial would be proper where " 'the accounts between the parties' are of such a 'complicated nature' that only a court of equity can satisfactorily unravel them."[22] The court then went on to say,

> "In view of the powers given to District Courts by Federal Rule of Civil Procedure 53(b) to appoint masters to assist the jury in those exceptional cases where the legal issues are too complicated for the jury adequately to handle alone, the burden of such a showing is considerably increased, and it will indeed be a rare case in which it can be met."[23]

In a footnote, the court reaffirmed the statement made in *Beacon Theatres* that the Federal Rules of Civil Procedure have increased the adequacy of a remedy at law and diminished the scope of traditional equitable remedies.[24] The court further

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[19] *Id.* at 491, 131 U.S.P.Q. at 4.

[20] Dairy Queen v. Wood, 369 U.S. 469, 472 (1962).

[21] *Id.* at 472, 473.

[22] *Id.* at 478.

[23] *Id.* at 478.

[24] *Id.* at 478, footnote 19.

noted that this pertains only to final adjudications and not to interlocutory relief.

Thus, the line between law and equity seems to have shifted to the point where few patent cases are now characterized as purely equitable. In *Shubin* v. *United States District Court*,[25] the Court of Appeals for the Ninth Circuit attempted to define the line. There, the complaint did not specifically request damages, although an accounting was requested. The failure to specifically request damages was the basis of the court's holding that a jury trial would not be granted. While this holding is probably limited to its facts, it does indicate that pleadings should be drafted to clearly specify damages, however insignificant, if a jury trial is to be requested.

Many issues remain for which there is no right to a trial by jury; for example, those issues which are purely equitable such as estoppel,[26] quiet title in a patent,[27] or a defense predicated upon the doctrine of unclean hands,[28] and those issues which are based on purely statutory remedies such as the right to exemplary damages pursuant to 35 U.S.C. § 284[29] or attorney fees pursuant to 35 U.S.C. § 285.[30]

Although the right to a jury trial in a patent case is now very liberally construed, new issues spawned by this right have appeared. *Swofford* v. *B & W, Inc.*[31] concerns the problem of a separate trial on the issues of liability and damages in a patent case. The Court of Appeals for the Fifth Circuit upheld the District Court's[32] holding that, pursuant to Rule 42(b)[33] of the Federal Rules of Civil Procedure, separate trials before separate

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[25] 313 F. 2d 250, 136 U.S.P.Q. 405 (9th Cir. 1963), *cert. denied*, 373 U.S. 936 (1963).

[26] Englehard Industries, Inc. v. Research Instrument Corp., 196 F. Supp. 138 (S.D. Calif. 1961), *modified*, 324 F. 2d 347 (9th Cir. 1962).

[27] Note 16, *supra.*

[28] Note 16, *supra.*

[29] Note 4, *supra; see also* Swofford v. B & W, Incorporated, 336 F. 2d 406, 142 U.S.P.Q. 291 (5th Cir. 1964), *cert. denied*, 379 U.S. 962 (1965).

[30] The court in exceptional cases may award reasonable attorney fees to the prevailing party, 35 U.S.C. §285; *see also* Swofford v. B & W, Incorporated, 336 F. 2d 406, 142 U.S.P.Q. 291 (5th Cir. 1964), *cert. denied*, 379 U.S. 962 (1965).

[31] 336 F. 2d 406, 142 U.S.P.Q. 291 (5th Cir. 1964), *cert. denied*, 379 U.S. 962 (1965).

[32] 34 F.R.D. 15, 139 U.S.P.Q. 92 (S.D. Tex. 1963).

[33] The court, in furtherance of convenience or to avoid prejudice, or when separate trials will be conducive to expedition and economy, may order a separate trial on any claim . . . , or of any separate issue or of any number of claims . . . or issues, always preserving . . . the right of trial by jury. . . . , FED. R. CIV. P. 42(b).

juries were appropriate on the issues of liability (validity and infringement)[34] and damages.

The court explained that the issue of damages is often prolonged and expensive and is easily severed from the issue of liability. Therefore, a prior jury determination of non-liability would obviate any further inquiry into the question of damages and would result in a substantial saving of time, effort and expense.[35] Moreover, even if the jury returned a verdict of liability, the parties would have an opportunity to engage in settlement negotiations before proceeding with the trial on damages. The separation of the issues of liability and damages for trial pursuant to 42(b) seems especially well suited to patent cases, and will probably become the adopted practice in the majority of patent jury cases.

The courts, however, are reluctant to permit separation of the issues of validity and infringement in the determination of liability for the reasons stated in *Sinclair Co.* v. *Interchemical Corp.*[36]

> "There has been a tendency among the lower federal courts in infringement suits to dispose of them where possible on the ground of non-infringement without going into the question of validily of the patent . . . It has come to be recognized, however, that of the two questions, validity has the greater public importance . . . , and the District Court in this case followed what will usually be the better practice by inquiring fully into the validity of this patent."[37]

This policy against the piecemeal disposition of the issues of validity and infringement was recognized in the recent case of *Reynolds-Southwestern Corporation* v. *Dresser Industries, Incorporated.*[38] In that case, tried before a jury, the trial court granted defendant's motion for a directed verdict on the grounds that the plaintiff failed to establish a prima facie case of infringement. The Court of Appeals for the Fifth Circuit reversed the judgment of the trial court stating that "[t]here should be full inquiry into the validity of the patent involved rather than disposing of suits on the ground of non-infringement alone."[39]

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[34] *See* U.S. v. Ensault-Pelterie, 299 U.S. 201 (1936); Hanson v. Safeway Stores, 238 F. 2d 336 (9th Cir. 1956); and McRoskey v. Braun Mattress Co., 107 F. 2d 143 (9th Cir. 1939) for the proposition that validity and infringement are jury questions.

[35] *See* Zeisel & Callahan, *Split Trials and Time Saving: A Statistical Analysis*, 76 HARV. L. REV. 1606 (1963) for a discussion of the economics of split trials.

[36] 325 U.S. 327 (1945).

[37] *Id.* at 330.

[38] 372 F. 2d 592, 152 U.S.P.Q. 530 (5th Cir. 1967).

[39] *Id.* at 594, 152 U.S.P.Q. at 531.

MOTION MUST BE TIMELY

The Seventh Amendment guarantees that the right to a trial by jury is "preserved."[40] This does not mean that a jury trial is mandatory. The right may be invoked only at the initiative of the parties in compliance with the applicable Federal Rules of Procedure. A demand for a jury under Federal Rule 38(b) must be made not later than ten days after service of the last pleading directed to the jury triable issue.[41] Failure to serve a demand is a waiver of the right to a jury trial.[42] On the other hand, once a demand has been properly made, it cannot be withdrawn without the consent of all the parties.[43]

The timeliness of a jury demand was at issue in *General Tire & Rubber Company* v. *Watkins*,[44] a patent infringement suit. In this case Firestone Tire and Rubber Company, the plaintiff, sought a declaratory judgment of patent invalidity and noninfringement against General Tire, the defendant. The suit was filed in March, 1961. Discovery was taken, motions filed and argued, and other preliminary matters settled. Then, on January 15, 1964, two days after Firestone filed a "notice pursuant to 35 U.S.C. 282"[45] setting forth references relied upon to contest validity, General Tire filed a demand for a jury trial as a matter of right pursuant to Rule 38(b).[46] The judge denied the demand as untimely since it was made more than ten days after the "last pleading."[47]

General Tire sought to obtain the jury trial by instituting a mandamus action against Judge Watkins. The Court of Appeals denied the mandamus stating that the demand was untimely since "a 'notice' under 35 U.S.C. § 282 is excluded from

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[40] Note 1, *supra*.

[41] Any party may demand a trial by jury of any issue triable of right by a jury by serving upon the other parties a demand therefor in writing at any time after the commencement of the action and not later than 10 days after the service of the last pleading directed to such issue, FED. R. CIV. P. 38(b).

[42] The failure of a party to serve a demand as required by this rule and to file it as required by Rule 5(d) constitutes a waiver by him of trial by jury. A demand for trial by jury made as herein provided may not be withdrawn without the consent of the parties. FED. R. CIV. P. 38(d). *See also* Gasifier Mfg. Co. v. General Motors Corp., 138 F. 2d 197 (8th Cir. 1943).

[43] Gasifier Mfg. Co. v. General Motors Corp., 138 F. 2d 197 (8th Cir. 1943).

[44] 331 F. 2d 192, 141 U.S.P.Q. 264 (4th Cir. 1964).

[45] In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date and page numbers of any publication to be relied upon as anticipation of the patent in suit. . . . , 35 U.S.C. §282.

[46] Note 41, *supra*.

[47] FED. R. CIV. P. 38(b).

the definition of pleadings Rule 7(a)."[48] Thus, the court equated the definition of "pleadings" in Rule 38(b) with that of Rule 7(a).

General Tire also sought to invoke the court's discretionary power to grant a jury trial under Rule 39(b).[49] This too was denied. The Court of Appeals pointed out that under Rule 39(b) a jury trial would be granted only in exceptional circumstances and that the circumstances of the particular patent case militated against, rather than in favor of granting a jury trial under Rule 39(b), stating as its reasons:

> ". . . the mass of depositions and documents, the technicalities involved in determining the issues of patent validity and infringement, the experience of the court in patent cases, the difficulties to be encountered in instructing a jury, and the doubtful ability of jurors with only ordinary experience to comprehend the complex issues and to reach a correct conclusion."[50]

If the equities are favorable, failure to grant a discretionary jury trial is reversible error. In *AMF Tuboscope, Inc.* v. *Cunningham,*[51] the Court of Appeals for the Tenth Circuit, relying on *Dairy Queen,* upheld a Rule 39(b)[52] jury request. The opposing parties had jointly requested a jury trial although their request was made subsequent to the period allowed to request a jury as a matter of right.[53] The District Court judge had at first impliedly granted the motion by entering an order setting the case on the jury docket. He then reversed his position by denying a jury trial on his own motion. The Court of Appeals reversed, stating that the District Court judge had "abused his discretion, if discretion he had under the existing circumstances."[54]

Nevertheless, it may be conjectured that since most patent cases involve the considerations set forth in *General Tire,* failure to make a timely jury demand pursuant to 38 (b) will pre-

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[48] General Tire & Rubber Company v. Watkins, 331 F. 2d 192, 196; 141 U.S.P.Q. 264, 266 (4th Cir. 1964). There shall be a complaint and an answer; a reply to a counterclaim denominated as such; an answer to a cross-claim, if the answer contains a cross-claim; a third-party complaint, if a person who was not an original party is summoned under the provisions of Rule 14; and a third-party answer, if a third-party complaint is served. No other pleading shall be allowed, except that the court may order a reply to an answer or a third-party answer, FED. R. CIV. P. 7(a).

[49] Issues not demanded for trial by jury as provided in Rule 38 shall be tried by the court; but, notwithstanding the failure of a party to demand a jury in an action in which such a demand might have been made of right, the court in its discretion upon motion may order a trial by a jury on any or all issues. FED. R. CIV. P. 39(b).

[50] 331 F. 2d at 197, 141 U.S.P.Q. at 268.

[51] 352 F. 2d 150, 147 U.S.P.Q. 132 (10th Cir. 1965).

[52] Note 49, *supra.*

[53] Note 41, *supra.*

[54] Note 51, *supra* at 155, 147 U.S.P.Q. at 136.

clude a jury trial, and the courts cannot be expected to favor granting a jury trial under a 39(b) motion in patent cases.[55]

FACTORS WHICH DETERMINE DESIRABILITY OF A JURY TRIAL

A jury might be made to order in cases that turn up on difficult and close questions of fact. For example, if the question is whether the invention is abandoned, or whether the claim is supported by the specification, or whether elements of a claim are found in the accused device, or whether the differences between the prior art and the invention claimed would have been obvious to one skilled in the art, a jury determination on such factual issues would be difficult to overturn on appeal.

A patent owner may also consider a jury trial to be beneficial where he has reason to believe that his position would be more apt to invoke the sympathy of a layman than a judge. This is especially true where the plaintiff is an independent inventor and the defendant is a large corporation. There is some doubt, however, whether this reasoning works in practice.[56]

Another advantage of using a jury is the saving in time and money. In most jurisdictions, jury cases reach trial ahead of non-jury matters. Furthermore, in a jury matter, the verdict is rendered within a few hours after the trial, and judgment is entered within a reasonable time thereafter. By contrast, in bench trials there is usually a considerable delay while the court takes the matter under advisement. In addition to the delays engendered by the usual requirements for submission of briefs it is not uncommon to wait for many months until the court has rendered its decision.

A jury may be valuable in cases where it is advantageous to obtain strict adherence to the rules of admissibility of evidence. A trial judge tends to relax the rules of admissibility in the absence of a jury. In such instances he may allow an objectionable matter into evidence for "what it is worth" and defer his ruling on its admissibility until the conclusion of the trial. It is not likely that an experienced trial judge would ever knowingly be swayed by inadmissible evidence, but the fact remains that evidence of this nature may subconsciously prejudice the judge in favor of one party.

For example, it is not uncommon in bench trials for the judge to admit into evidence both, a sample of the plaintiff's

[55] But *see* Swofford v. B & W, Inc., note 23, *supra.*

[56] *See, e.g.*, Thurber Corp. v. Fairchild Motor Corp., 269 F. 2d 841, 122 U.S.P.Q. 305 (5th Cir. 1959); Howe v. General Motors Corp., 167 F. Supp. 330, 119 U.S.P.Q. 216 (N.D. Ill. 1958); 252 F. Supp. 924, 149 U.S.P.Q. 808 (N.D. Ill. 1966).

product and a sample of the defendant's product. The determinative issue in a patent infringement suit is whether the defendant's product is covered by the plaintiff's patent claims, not whether plaintiff's patented product and the defendant's product are equivalents. Samples of the plaintiff's product should therefore be inadmissible.[57] A comparison of products may tend to mislead the judge prejudicially, especially where both appear substantially identical.

SOME DISADVANTAGES OF A JURY

The availability of a jury trial is, perhaps, a mixed blessing. For example, if a judge in a jury trial should admit evidence erroneously, and if such error results in a reversal on appeal, instead of ending up with a victory, you must start all over again. By contrast, in a bench trial the judge may reconsider the issue of admissibility of questionable evidence after the close of the trial and omit such errors from his ultimate findings and opinion. Consequently, in such cases there are no specific grounds for reversal to bring to the attention of the Court of Appeals.

Consider, for example, the case of *Thurber Corporation* v. *Fairchild Motor Corporation*.[58] Thurber sued Ford Motor Co. and Fairchild for infringement of certain patents on automatic transmissions. Although Ford was selling cars with transmissions alleged to infringe Thurber's patents, the transmissions were made by Borg-Warner Corporation for Ford. The jury decided that there was no infringement by Ford.

Thurber appealed, alleging error in exclusion of evidence that Thurber had previously contacted Borg-Warner in an effort to license the patents in suit, and that two of the expert witnesses for Ford were associated with Borg-Warner and that Borg-Warner had agreed to indemnify Ford for one-half of the expenses of the litigation.

The Court of Appeals agreed with Thurber and reversed, stating that the evidence of license negotiations between Thurber and Borg-Warner "reflected the relationship out of which Ford got the benefit of Thurber's disclosures."[59] In addition, the court stated that the credibility of the two experts was of critical concern since the jury might have placed considerable reliance upon their expert testimony. Failure to disclose to the jury the relationship of the experts and of Borg-Warner with Ford prevented the jury from properly evaluating the expert testimony.

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[57] American Technical Machinery Corp. v. Caparotta, 339 F. 2d 557, 144 U.S.P.Q. 115 (2nd Cir. 1964), *cert. denied*, 382 U.S. 842 (1966).

[58] 269 F. 2d 841, 122 U.S.P.Q. 305 (5th Cir. 1959).

[59] *Id.* at 847, 122 U.S.P.Q. at 309.

Thurber also illustrates an error which will probably be alleged as a matter of course in patent jury cases; namely, that the trial judge failed to explain the patent claims to the jury. The Court of Appeals did not miss the opportunity to point out that: " . . . the claims are complex and drafted with language and in a style that makes them difficult, if not impossible, for laymen — and indeed for most lawyers and judges — to understand."[60]

The court concluded that it would be impossible for the trial judge to explain the "weird" patent language to the jury. For lawyers who may be considering jury trials, the court had this to say: " . . . If this leaves the matter somewhat less than satisfactory, it is the unavoidable consequence of seeking a jury trial on a matter which traditionally is left to the judge."[61]

The prospect of being compelled to try the same lawsuit twice is not very heartening. The prospect of three trials is ominous. But this can readily happen when a jury determination is sought. Such was the case in *Howe* v. *General Motors Corporation*.[62] The first trial in 1960 ended in a hung jury. In 1961 a second jury decided for General Motors, but the judge awarded plaintiff a new trial because he thought the patent was valid and that the jury was confused. Finally, in 1966 Judge Robson of the District Court, Northern District of Illinois decided the case for General Motors on stipulated facts.[63]

A favorable jury verdict may be lost by a judgment notwithstanding the verdict under Rule 50(b)[64] of the Federal Rules of Civil Procedure. If the court is of the opinion the jury's decision is contrary to the preponderance of the evidence and that reasonable men could not have reached that verdict as a conclusion, it may reverse. Although courts are generally reluctant to

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[60] *Id.* at 850, 122 U.S.P.Q. at 312.

[61] *Id.* at 851, 122 U.S.P.Q. at 313.

[62] 167 F. Supp. 330, 119 U.S.P.Q. 216 (N.D. Ill. 1958).

[63] 252 F. Supp. 924, 149 U.S.P.Q. 808 (N.D. Ill. 1966).

[64] Whenever a motion for a directed verdict made at the close of all the evidence is denied or for any reason is not granted, the court is deemed to have submitted the action to the jury subject to a later determination of the legal questions raised by the motion. Not later than 10 days after entry of judgment, a party who has moved for a directed verdict may move to have the verdict and any judgment entered thereon set aside and to have judgment entered in accordance with his motion for a directed verdict; or if a verdict was not returned such party, within 10 days after the jury has been discharged, may move for judgment in accordance with his motion for a directed verdict. A motion for a new trial may be joined with this motion, or a new trial may be prayed for in the alternative. If a verdict was returned the court may allow the judgment to stand or may reopen the judgment and either order a new trial or direct the entry of judgment as if the requested verdict had been directed. If no verdict was returned the court may direct the entry of judgment as if the requested verdict had been directed or may order a new trial. FED. R. CIV. P. 50(b).

do this, in patent cases it seems to be done quite frequently. For example, in *Packwood* v. *Briggs and Stratton Corporation*[65] the District Court judge candidly stated that the patent was invalid, but that he did not want to substitute his judgment for that of the jury. The Court of Appeals held the finding of validity clearly wrong as inconsistent with the standards of invention laid down by the Supreme Court. The opinion warns district judges that it is their responsibility to keep the jury findings within reasoned rules and standards. The court summarizes by stating:

> "A jury in a patent case is not free to treat invention as a concept broad enough to include whatever discovery or novelty may impress the jurors favorably. Over the years the courts of the United States, and particularly the Supreme Court have found meaning implicit in the scheme and purpose of the patent laws which aids in the construction of their general language. In this process, rules and standards have been developed for use as guides to the systematic and orderly definition and application of such a conception as invention in accordance with what the courts understand to be the true meaning of the Constitution and the patent laws. Once such standards and rules are authoritatively announced, any finding of "invention" whether by a court or by a jury must be consistent with them."[66]

Although *Packwood* is a 1952 case decided before the full effect of the Patent Act of 1952 was known, the admonition of the Court of Appeals is still sound. Many courts have reiterated the logic of *Packwood*.[67]

A jury verdict may also be partially overruled by a judgment n.o.v. In *Reachi* v. *Edmond*[68] the trial judge refused to enter judgment n.o.v. on the verdict of validity of a design patent. However, the judge did partially grant such judgment with respect to the issue of infringement. Upon review, the appellate court determined that the trial court did not err by holding as a matter of law that there was no infringement.

GENERAL VS. SPECIAL VERDICTS

If one does decide to try a case before a jury, it is important to consider the form of verdict, i.e. whether to be satisfied with a general verdict — or whether to request a form of special

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[65] 195 F. 2d 971, 93 U.S.P.Q. 274 (3d Cir. 1952), *cert. denied*, 344 U.S. 844 (1952).

[66] *Id.* at 973, 93 U.S.P.Q. at 275.

[67] Griffith Rubber Mills v. Hoffar, 313 F. 2d 1, 136 U.S.P.Q. 334 (9th Cir. 1963); National Sponge Cushion Co. v. Rubber Corp. of California, 286 F. 2d 731 (9th Cir. 1961), *cert. denied*, 362 U.S. 976 (1961); Stallman v. Casey Bearing Co., 244 F. 2d 905, 114 U.S.P.Q. 36 (9th Cir. 1957), *cert. denied*, 355 U.S. 864 (1957); Klein v. Burns Mfg. Co., 245 F. 2d 269, 113 U.S.P.Q. 422 (2d Cir. 1957); Berkeley Pump Co. v. Jacuzzi Bros., 214 F. 2d 785 (9th Cir. 1954); McIlvaine Patent Corp. v. Walgreen Co., 138 F. 2d 177 (7th Cir. 1943).

[68] 277 F. 2d 850, 125 U.S.P.Q. 265 (9th Cir. 1960).

verdict. Rule 49(a)[69] of the Federal Rules of Civil Procedure provides that the court may require the jury to submit in writing findings (special verdicts) on each important fact or issue. The court will then render a general verdict consistent with the special verdicts. Another variation is available under Rule 49 (b)[70] which provides for the jury to submit a general verdict together with answers to written interrogatories. In either event the special verdict or interrogatory is submitted to the jury at the complete discretion of the judge.

There has been a long standing controversy among legal scholars about the merits of general versus special verdicts. Professor Sunderland has said that the general verdict is "as inscrutable and essentially mysterious as the judgment which issued from the ancient oracle of Delphi."[71] Judge Jerome Frank discusses this question in some detail and is outspoken in favor of special verdicts in his opinion in *Skidmore* v. *Baltimore & Ohio Co.*[72] Professor Moore, on the other hand, is inclined to trust the jury more implicitly and permit them to make up their own mind whether or not they correctly apply the law given them by the judge.[73]

Needless to say, the worth of these procedures is dependent

[69] The court may require a jury to return only a special verdict in the form of a special written finding upon each issue of fact. In that event the court may submit to the jury written questions susceptible of categorical or other brief answer or may submit written forms of the several special findings which might properly be made under the pleadings and evidence; or it may use such other method of submitting the issues and requiring the written findings thereon as it deems most appropriate. The court shall give to the jury such explanation and instruction concerning the matter thus submitted as may be necessary to enable the jury to make its findings upon each issue. If in so doing the court omits any issue of fact raised by the pleadings or by the evidence, each party waives his right to a trial by jury of the issue omitted unless before the jury retires he demands its submission to the jury. As to an issue omitted without such demand the court may make a finding; or, if it fails to do so, it shall be deemed to have made a finding in accord with the judgment on the special verdict. FED. R. CIV. P. 49(a).

[70] The court may submit to the jury, together with appropriate forms for a general verdict, written interrogatories upon one or more issues of fact the decision of which is necessary to a verdict. The court shall give such explanation or instruction as may be necessary to enable the jury both to make answers to the interrogatories and to render a general verdict, and the court shall direct the jury both to make written answers and to render a general verdict. When the general verdict and the answers are harmonious, the appropriate judgment upon the verdict and answers shall be entered pursuant to Rule 58. When the answers are consistent with each other but one or more is inconsistent with the general verdict, judgment may be entered pursuant to Rule 58 in accordance with the answers, notwithstanding the general verdict, or the court may return the jury for further consideration of its answers and verdict or may order a new trial. When the answers are inconsistent with each other and one or more is likewise inconsistent with the general verdict, judgment shall not be entered, but the court shall return the jury for further consideration of its answers and verdict or shall order a new trial. FED. R. CIV. P. 49(b).

[71] Sunderland, *Verdicts. General and Special*, 29 YALE L. J. 253 (1920).

[72] 167 F. 2d 34 (2d Cir. 1948).

[73] 5 MOORE'S FEDERAL PRACTICE, ¶38.02 (2nd ed. 1966).

upon the skill of the judge forming the questions. Where a judge neglects to submit a question on a disputed point of fact[74] unless counsel makes a timely objection to the omission, the right to trial by jury on that issue is waived. In the event of such an omission the judge may enter a finding as to that issue or it is assumed to be consistent with the other special verdicts.[75] The constitutionality of this particular provision of the rule is open to serious question since under this rule a judicial error is imputed to the parties as a waiver on their part of their right to a jury trial, even where the omission is crucial.[76]

Trial tactics, however, may determine the choice of whether one uses a special interrogatory.[77] If a special interrogatory is inconsistent with the general verdict, the former controls and judgment must be entered on it. If the special interrogatory is consistent with the general verdict, then, of course, the judgment is entered on the general verdict.[78] A special finding may be overturned on motion of the party by the court, only (1) if the finding is not supported by a scintilla of evidence, in which case the special finding must be set aside and judgment entered on the verdict, or (2) if the finding is against the manifest weight of the evidence, in which case a new trial must be granted. Thus, if the party has one strong element of a cause of action or defense in an otherwise weak case, a special interrogatory should be seriously considered. However, if the party has a strong case a special interrogatory should *not* be considered since one may bind oneself by an unfavorable finding.

In cases not triable by a jury as a matter of right, the judge in his discretion may invoke an advisory jury whose verdict will not be binding on him.[79] Failure to follow an advisory verdict is not tantamount to a judgment n.o.v. The case of *Reachi* v. *Edmund*[80] involved the issues of validity, infringement, and unfair competition. Interrogatories were submitted to the jury relating to each issue; however, the verdict on the unfair competition issue

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[74] MATHES & DEVITT, FEDERAL JURY PRACTICE AND INSTRUCTIONS, ¶86.01 *et seq.* (1965) give sample jury instructions for patent cases; *see especially* ¶86.42 regarding special verdicts and interrogatories.

[75] Note 68, *supra.*

[76] *See* R. H. Baker & Co. v. Smith-Blair, Inc., F. 2d 506, 141 U.S.P.Q. 369 (9th Cir. 1962).

[77] *Cf.* Beatty Safway Scaffold Co. v. Up-Right Inc., 306 F. 2d 626, 134 U.S.P.Q. 379 (9th Cir. 1962), *cert. denied,* 372 U.S. 934 (1962).

[78] *See* 5 MOORE'S FEDERAL PRACTICE ¶49.04 *et seq.* (2nd ed. 1966).

[79] In all actions not triable of right by a jury the court upon motion or of its own initiative may try any issue with an advisory jury or, except in actions against the United States when a statute of the United States provides for trial without a jury, the court, with the consent of both parties, may order a trial with a jury whose verdict has the same effect as if trial by jury had been a matter of right. FED. R. CIV. P. 39(c).

[80] Note 68, *supra.*

was to be advisory only. The validity and infringement issues were, of course, triable of right by a jury. The judge in *Reachi* did not follow the advisory verdict of the jury. Moreover, it is still necessary for the judge to make Findings of Fact and Conclusions of Law with an advisory jury.

It should also be noted that the parties to the litigation may stipulate a majority verdict or a jury composed of fewer than 12 jurors.[81] Majority verdicts would avoid the probability of a hung jury.[82]

Finally, Rule 53(b)[83] which provides for the appointment of a master to assist the jury, should also be considered during a jury trial, especially where the case is strong and the patent is complicated. The extra expense of a master is a factor which may, however, discourage their use. In addition, the appointment of a master is to be the "exception and not the rule."[84]

CONCLUSION

Although a patent owner has an increasingly recognized right to a jury trial, there are many pitfalls along the way. If the determination of a clearly defined but disputable factual issue is important to the case, if the equities are favorable and a quick decision is required, serious consideration should be given to making a jury demand. But one should not resort to a jury trial in an attempt to sustain a weak patent claim that one fears would not be upheld by the judge alone. It is still the obligation of the court to set aside the jury verdict if it is not consistent with reasoned rules and standards. Finally, there are numerous methods of utilizing a jury, most of which are seldom used. Some of these methods may expedite patent litigation yet preserve equitable results within the framework of the patent law.

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[81] The parties may stipulate that the jury shall consist of any number less than twelve or that a verdict or a finding of a stated majority of the jurors shall be taken as the verdict or finding of the jury. FED. R. CIV. P. 48.

[82] Note 62, *supra*.

[83] A reference to a master shall be the exception and not the rule. In actions to be tried by a jury, a reference shall be made only when the issues are complicated; in actions to be tried without a jury, save in matters of account and of difficult computation of damages, a reference shall be made only upon a showing that some exceptional condition requires it. FED. R. CIV. P. 53(b).

[84] Note 20, *supra*.