



MAKING A PITCH FOR EXTENDING A JUDGE'S POWER TO DETERMINE  
OBVIOUSNESS: HOW THE MCGINLEY COURT STRUCK OUT

JOHN PETRAVICH

ABSTRACT

Obviousness is one of the most litigated elements of patent of validity, due primarily to the enormous gray area between the roles of judge and jury. While obviousness is ultimately a legal question, the courts make an effort to leave the underlying factual determinations to the jury, with mixed results. *McGinley v. Franklin Sports, Inc.* illustrates the problems with the Court of Appeals for the Federal Circuit's current approach as to what role juries and district court judges should play in determining obviousness of a patent. Instead of the *McGinley* approach of maintaining a significant role for juries in resolving obviousness, the courts should embrace an expanded role for judges who are better equipped to handle the frequently complex decisions behind the ultimate question of obviousness. Any decisions left to the jury should be specifically laid out in the form of a special verdict to ensure that the jury is making their decisions on solid legal basis.

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MAKING A PITCH FOR EXTENDING A JUDGE'S POWER TO DETERMINE OBVIOUSNESS:  
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JOHN PETRAVICH\*

“[A]lmost routinely, one party or the other strikes from the jury the most educated and experienced persons, so that routinely there is a conscious effort to get an unsophisticated, uninformed jury, [that] one party hoping that jury will unwittingly give the party a windfall”<sup>1</sup>

“I’d rather be hit blindsided by [Lawrence Taylor] than have a Roger Clemens fastball come at my head”<sup>2</sup>

Obviousness is the most unsettled condition of patent validity, when viewed in terms of quantity of litigation.<sup>3</sup> One of the primary purposes of the Court of Appeals for the Federal Circuit (CAFC) is to settle uncertainties and provide a consistent roadmap for district courts to follow when resolving patent issues.<sup>4</sup> The overall success of the CAFC in serving this role is evidenced in the growing strength of intellectual property rights in recent history.<sup>5</sup> The CAFC now needs to provide the district courts with better-defined guidelines to resolve obviousness disputes that will result in fair outcomes for both sides. This task begins with better defining the roles of juries and judges in determining questions of obviousness.

INTRODUCTION

*McGinley v. Franklin Sports, Inc.*<sup>6</sup> illustrates the problems with the CAFC’s current approach to what roles juries and the district courts should play in determining obviousness of a patent. This case also displays the extent in which a district court needs to determine the facts in order to determine obviousness. The inventor in *McGinley* charged Franklin Sports with infringement of his patent for a baseball with markings instructing the user on how to pitch several standard

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<sup>1</sup> Tom Arnold, *Why ADR?*, PATENT LITIGATION 1999, 1013, 1039 (PLI Patents, Copyrights, Trademarks, & Literary Property Course Handbook Series No. 572, 1999), reprinted in Michael A. Fisher, *Going for the Blue Ribbon: The Legality of Expert Juries in Patent Litigation*, 2 COLUM. SCI. & TECH. L. REV. 1, 2 (2000/2001).

<sup>2</sup> Michael Wilbon, *M.J. Goes for a Triple, Double*, WASH. POST, Feb. 9, 1994, at F1.

<sup>3</sup> Bradley G. Lane, *A Proposal to View Patent Claim Nonobviousness From the Policy Perspective of Federal Rule of Civil Procedure 52(a)*, 20 U. MICH. J.L. REFORM 1157, 1159 (1987).

<sup>4</sup> See Chief Judge Glenn L. Archer, *Conflicts and the Federal Circuit*, 29 J. MARSHALL L. REV. 835, 835—36 (1996) (claiming that the CAFC has been successful in resolving disparities between regional circuits).

<sup>5</sup> *Id.*

<sup>6</sup> *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339 (Fed. Cir. 2001).

baseball pitches.<sup>7</sup> McGinley's baseball, the Roger Clemens Instructional Baseball, had tapered, egg-shaped markings that not only were placement indicators for the user's fingers, but they indicated the configuration of the user's hand in relation to the ball.<sup>8</sup>

There are two relevant patents in the prior art:<sup>9</sup> the "Pratt" patent and the "Morgan" patent. The Pratt patent describes a similar baseball with circles instead of tapered eggs.<sup>10</sup> The inventor argued that the Pratt patent did not have as many markings for right and left-handed pitchers, and that the circles did not indicate to the users how the hand should be positioned around the ball.<sup>11</sup> The Morgan patent, describes a plastic replica baseball with more elaborate finger placement markings that demonstrate both finger placement and hand configuration. However, the invention in the Morgan patent is two plastic hemispheres that are connected to each other to replicate a baseball.<sup>12</sup> Therefore, the invention could not serve as a baseball like the McGinley or Pratt baseballs could.<sup>13</sup>

Although obviousness is a question of law,<sup>14</sup> the underlying facts that determine obviousness are still questions of fact for juries to decide.<sup>15</sup> After hearing the testimony, the jury for the *McGinley* case found the patent nonobvious in light of the Pratt and Morgan patents.<sup>16</sup> However, the jury did not identify the facts that were relied upon in their determination of the patent as nonobvious.<sup>17</sup> Thus, the trial judge

<sup>7</sup> *Id.* at 1342.

<sup>8</sup> *Id.* at 1344.

<sup>9</sup> The first patent was issued to William D. Pratt for a "Baseball Training AM." U.S. Patent No. 2,925,273 (issued Feb. 16, 1960). The "Pratt" baseball has colored circles on a normal baseball that indicate different pitching grips. *McGinley*, 262 F.3d at 1344. The second patent was issued to Tom Stephen Morgan for a "Baseball Training Device." U.S. Patent No. 3,110,494 (issued Nov. 12, 1963). The "Morgan" baseball, was not an actual baseball, but rather a grooved sphere to indicate the positioning and orientation of the hand to throw different pitches. *McGinley*, 262 F.3d at 1344.

<sup>10</sup> *McGinley*, 262 F.3d at 1345. The Pratt patent's written description also described three separate sets of markings for three different pitches, but the Pratt patent did not have distinct sets of markings for right and left-handed pitchers. *Id.*

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

<sup>12</sup> *Id.* The plastic hemispheres were lightweight and could be glued together in order to form a sphere. *Id.*

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

<sup>14</sup> *Id.* at 1349. *See also* 2-5 DONALD S. CHISUM, CHISUM ON PATENTS § 5.04 at 3 (clarifying that "if the conclusion is one of law, then the judge, not the jury, would decide the question of obviousness, and any such decision at the trial court level would be freely reviewable on appeal").

<sup>15</sup> *McGinley*, 262 F.3d at 1349. *See also* 3 Chisum on Patents § 5.04 (stating that "[i]f the conclusion is one of fact, then a finding of obviousness or nonobviousness by a trial court would be insulated from appellate review unless 'clearly erroneous'... and the conclusion of obviousness would be appropriately submitted to a jury for resolution").

<sup>16</sup> *McGinley*, 262 F.3d at 1350. The jury answered three questions in a verdict form:

First, they found that [Franklin Sports] had not proven by clear and convincing evidence that each of the elements of the invention defined in [McGinley's claims] is disclosed in Pratt . . . Second, the jury found that [Franklin Sports Inc.] had not proven by clear and convincing evidence that any of the asserted claims were invalid as being obvious in view of Pratt alone. Finally, the jury found that [Franklin Sports Inc.] had not proven by clear and convincing evidence that any of the asserted claims were invalid as being obvious in view of a combination of Pratt and Morgan.

*Id.* at 1350.

<sup>17</sup> *Id.* at 1359.

granted the defendant's motion for judgment as a matter of law (JMOL) and set aside the verdict.<sup>18</sup> The CAFC reversed the trial judge and reasoned that it was possible based on the facts of the case for a reasonable jury to find infringement.<sup>19</sup> The CAFC declined to extend their legal inquiry any further into the case.<sup>20</sup>

Judge Michel dissented, and remarked that it was a close call as to whether the McGinley baseball was anticipated by the Pratt patent alone. Michel noted that the Pratt patent contained "phantom lines" that were not actually drawn on the ball, but served to indicate how a pitcher should hold the ball in reference to the circles.<sup>21</sup> Thus, the Pratt patent seemingly had all of the elements of McGinley's baseball.<sup>22</sup> Judge Michel was convinced that the combination of the Pratt and Morgan patents rendered the McGinley patent obvious. The only argument against this finding was whether McGinley could shorten the lines on the Morgan device in order to fit them on a Pratt baseball, which is essentially what the McGinley patent did.<sup>23</sup> Michel also argued that the commercial success of the McGinley baseball was more a testament to the endorser, professional baseball pitcher Roger Clemens, than to the question of non-obviousness that was before the jury.<sup>24</sup> Judge Michel voiced concern for the CAFC's inability to overturn the factual determination *de novo* because it would tie the Federal Circuit's hands every time it considered a review of obviousness.<sup>25</sup>

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<sup>18</sup> *McGinley*, 262 F.3d at 1355.

<sup>19</sup> *Id.* The Federal Circuit Court determined that McGinley presented sufficient evidence to prove that the prior art references teach away from his baseball because the Pratt ball had additional features that limited the possibility of extended finger marks. *Id.* The Court reasoned that the Pratt ball had rotational arrows and an equatorial band that helped make it possible for a pitcher to see from his pitch if he had the correct rotation on the ball. *Id.* If the finger placement markings were larger, they would cross the equatorial band and the rotational arrows and therefore would take away from that function of the Pratt ball. *Id.* This issue is the primary reason the Court found sufficient evidence for the jury's findings. *Id.*

<sup>20</sup> *McGinley*, 262 F.3d at 1356. The court addressed the dissent's concern in determining when it would be permissible in an obviousness determination to override the jury's fact-finding, especially when the jury's reasoning is vague. *Id.* Rather than make an attempt to draw a line in the sand, the court restated their belief that the evidence was so strong in McGinley's favor that this was a non-issue in this case. *Id.*

<sup>21</sup> *McGinley*, 262 F.3d at 1361. Judge Michel noted expert testimony which stated that it would be difficult for anyone throwing a baseball to approach the Pratt circles any other way than the correct way as far as hand configuration in relation to the ball. *Id.* A user could grab it from one of two ways if they followed the spots on the Pratt ball. *Id.* One way is the correct way, and the other would be grabbing it from the opposite hemisphere. *Id.* A reasonable user would realize that grabbing the ball by the opposite hemisphere is very awkward and they would be incapable of throwing the ball in a normal fashion. *Id.*

<sup>22</sup> *McGinley*, 262 F.3d at 1361. Judge Michel makes the point that the only real difference between McGinley's ball and Pratt's ball is that Pratt's ball did not orient the hand to the ball. *Id.* But Judge Michel is convinced that the Pratt patent does cover such orientation. *Id.*

<sup>23</sup> *Id.* at 1361. Although Judge Michel believes the Pratt patent alone renders the McGinley baseball obvious, he alternately argues that the Morgan and Pratt patents combine to render the McGinley baseball obvious. *Id.*

<sup>24</sup> *Id.* at 1363. As Judge Michel points out, it is difficult to determine why the jury ended with a verdict for the plaintiff because they did not expressly list their factual findings upon which they based the verdict. *Id.*

<sup>25</sup> *Id.*

Defining the jury's role in patent litigation is becoming increasingly important as the amount of patent trials which go to a jury increase.<sup>26</sup> Patterns in jury verdicts are now becoming apparent. One could argue that the jury weighs factors, such as which party brought the suit, more heavily than the substantive facts brought out at trial.<sup>27</sup> This is especially apparent in cases of patent infringement, where the jury's tendency is to favor patent-holders over the accused infringers.<sup>28</sup> The conventional business standards and morals that juries bring with them into the black box are often contradictory to the policies behind patent law.<sup>29</sup> Critics have proposed several alternatives to traditional juries for patent law, such as hearings through the Patent and Trademark Office,<sup>30</sup> juries comprised of patent attorneys or agents,<sup>31</sup> juries of scientists skilled in the art,<sup>32</sup> or experienced judges.<sup>33</sup> The simplest solution would be to extend a judge's power to determine questions of obviousness, much the same as a judge's authority to decide claim interpretation.

This comment will first analyze the jury's role in determining claim interpretation. The next section will compare the doctrine of obviousness and the doctrines of claim interpretation. Finally, the author will suggest that the jury's role in determining obviousness should be aligned with the current role juries play in claim interpretation, and that special verdicts should be required from the arbiters of fact to ensure that the jury's role is limited.

## I. BACKGROUND

The Patent Act of 1952 lists three conditions for patentability.<sup>34</sup> Section 101 requires a claimed invention to have utility, essentially meaning it must be a useful

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<sup>26</sup> See Kimberly A. Moore, *Judges, Juries, and Patent Cases – An Empirical Peek Inside the Black Box*, 99 MICH. L. REV. 365, 366 (2000) (comparing percentages of patent cases tried by juries over time, Moore notes that in 1940, 2.5% of patent cases in district courts were in front of juries, and this was constant until 1970). From 1997 through 1999, 59% of patent cases were in front of juries. *Id.* at 366.

<sup>27</sup> *Id.* at 368. After extensively studying the differences in the outcomes of cases tried in front of juries rather than judges, Moore notes both similarities and differences. *Id.* Both judges and juries are similar in the rate of finding patents enforceable, and both are affirmed by appellate courts at the same rate. *Id.* But juries are more likely to find patents valid, infringed and willfully infringed, and juries more often decide whole suits rather than answering specific issues. *Id.* Most significantly, juries are often swayed by which party brings suit. *Id.* The patent holder wins 68% of the cases when he brings an infringement suit, but they only win 38% of the time when the other party brings a declaratory judgment suit. *Id.* Judges, by contrast, are uniform along both categories of suits. *Id.*

<sup>28</sup> *Id.*

<sup>29</sup> Jens H. Hillen, *The Court of Appeals for the Federal Circuit: Independent Review of Patent Decisions and the Constitutional Facts Doctrine*, 67 S. CAL. L. REV. 187, 187–88 (1993) (explaining that people tend to favor a free-market system and disfavor monopolies, but the policies behind the patent system are to reward new technology with a monopoly on the newly invented technology).

<sup>30</sup> David B. Pieper, *The Appropriate Judicial Actor for Patent Interpretation: A Commentary on the Supreme Court's Decision in Markman v. Westview Instruments, Inc.*, 51 ARK. L. REV. 159, 179–81 (1998) (suggesting alternatives to traditional juries for Markman hearings).

<sup>31</sup> *Id.* at 179–80.

<sup>32</sup> *Id.* at 180.

<sup>33</sup> *Id.*

<sup>34</sup> 35 U.S.C. §§ 101–103 (2003).

invention.<sup>35</sup> Section 102 requires the patented invention to be novel.<sup>36</sup> Both utility and novelty were statutory requirements prior to the 1952 Act.<sup>37</sup> Section 103 of the 1952 Act added the requirement for non-obviousness as a third condition for patentability.<sup>38</sup> An invention is obvious if the collective prior art would have made the invention apparent to a person of ordinary skill in the art.<sup>39</sup> In 1966, the Supreme Court in *Graham v. Deere* held that Section 103 was a codification of a court-made condition of obviousness that was first announced in 1851 by *Hotchkiss v. Greenwood*.<sup>40</sup> In *Hotchkiss*, the court determined that a new patent for porcelain doorknobs would not be valid in light of similar prior art of metal doorknobs.<sup>41</sup> The *Graham* Court formulated a new test for the obviousness requirement. It defined four factors for determining obviousness: 1) the scope and content of the prior art; 2) the differences between the prior art and the subject invention; 3) the level of ordinary skill in the art; and 4) secondary considerations, such as commercial success and failure of others.<sup>42</sup>

The *Graham* decision did not explicitly declare that obviousness was a question of law,<sup>43</sup> and hence reviewable *de novo* by appellate courts. However, the cases that followed assumed that the *Graham* holding made it a question of law.<sup>44</sup> In *Panduit*

<sup>35</sup> 35 U.S.C. § 101 (2003) (stating: “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new or useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.”).

<sup>36</sup> Sections 102(a), 102(e) and 102(g) are the sections of 35 U.S.C. § 102 (2003) that refer to novelty. Section 102(a) prohibits a patent on any invention “known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.” 35 U.S.C. § 102(a) (2003). Section 102(e) prohibits a patent on any invention “described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent.” 35 U.S.C. § 102(e) (2003). Section 102(g) prohibits a patent on any invention that “before the applicant’s invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it.” 35 U.S.C. § 102(g) (2003).

<sup>37</sup> *Graham v. Deere*, 383 U.S. 1, 12 (1966).

<sup>38</sup> 35 U.S.C. § 103 (2003) states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

<sup>39</sup> *Id.*

<sup>40</sup> *Graham*, 383 U.S. at 17, citing *Hotchkiss v. Greenwood*, 52 U.S. 248 (1851). The *Graham* court cites the legislative history to support their conclusion that there was no change in the level of patentability when section 103 was passed by the legislature. *Id.*

<sup>41</sup> *Hotchkiss*, 52 U.S. 248 (1851).

<sup>42</sup> *Graham*, 383 U.S. at 17-18. *See also* Hillen *supra* note 29, at 200. (generalizing all secondary factors as primarily economic factors and includes: “acquiescence by competitors who seek licenses instead of challenging the patent, simultaneous solution by diverse inventors, and approval by experts in the field”).

<sup>43</sup> Lane, *supra* note 3, at 1164.

<sup>44</sup> In 1985, in *Panduit Corp. v. Dennison Mfg.*, the CAFC declared that the question of obviousness ultimately was a legal question. *Panduit Corp. v. Dennison Mfg.*, 774 F.2d 1082 (Fed. Cir. 1985), *vacated*, 475 U.S. 809 (1986), *on remand*, 810 F.2d 1561 (Fed. Cir.), *cert denied*, 481 U.S. 1052 (1987). However, the underlying facts, such as what is actually disclosed in the prior art and

*Corp. v. Dennison Mfg.*, the CAFC made the legal and factual demarcation after the Supreme Court requested the CAFC elaborate on what determinations in the question of obviousness would be subject to Federal Rule of Civil Procedure 52(a).<sup>45</sup> The CAFC determined that they could review a district court's legal conclusion without regard to Rule 52(a).<sup>46</sup>

Rule 52(a)<sup>47</sup> can be traced to the United States Constitution's Seventh Amendment requirement which guarantees a party a trial of one's peers if that right existed in a court of law prior to 1791.<sup>48</sup> Although patent cases were tried before 1791, many of the issues that are involved in today's patent litigation were non-existent 200 years ago.<sup>49</sup> Today's courts have a duty to decide whether a 1791 court would have allowed a jury to sit for such modern issues.<sup>50</sup>

Normally, the Supreme Court is the court of last resort for Seventh Amendment issues.<sup>51</sup> However, in *Panduit*, the Supreme Court allowed the CAFC to determine how far a jury should be allowed to determine the facts regarding issues of obviousness.<sup>52</sup> The CAFC was formed to receive patent cases and relieve the Supreme Court of their case load on these kinds of issues.<sup>53</sup> One of the CAFC's purposes is to

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what invention is being claimed, are questions of fact to be determined by the jury. *Panduit*, 810 F.2d at 1566. The jury's determination will only be overturned on appeal if found to be clearly erroneous. *Id.*

<sup>45</sup> *Panduit*, 475 U.S. at 811. The Supreme Court in *Panduit*, deferring to the underlying policy, allowed the CAFC to mark both the jury's and judge's boundaries when determining questions of obviousness. See also Hillen, *supra* note 29, at 190–93. Congress created the CAFC in 1982 to specialize in only a few areas of law, one area being patent law. *Id.* The policy reason for the specialization of the CAFC was to make the country's patent laws more consistent. *Id.*

<sup>46</sup> *Panduit*, 810 F.2d at 1568.

<sup>47</sup> Rule 52(a) states that the district courts are responsible for deciding the facts of a case, and the circuit courts will not overturn the district court's factual determinations unless the findings are clearly erroneous. FED. R. CIV. P. 52(a).

<sup>48</sup> Pieper, *supra* note 30, at 170. A court will look at the action at issue and find the closest comparison to a pre-1791 action. *Id.* As mentioned in the *Graham* case, the *Hotchkiss* decision in 1851 was the first obviousness decision in patent law, and would therefore have to be analogized to a similar pre-1791 action. *Id.*

<sup>49</sup> *Id.* at 187–88. Pieper provides a list of patent issues that are a factually tried by a jury, and another list tried by a judge:

[J]uries have been used to determine the factual issues surrounding: enforceability, licensing, invalidity, invalidity for obviousness, invalidity for nondisclosure, infringement, ownership, willful infringement, tortious interference with contract, damages, inequitable conduct, and advisory opinions on inequitable conduct, equitable estoppel, laches, patent misuse, and unclean hands, which are equitable issues that are typically decided by the judge. In contrast, judges have determined as a matter of law the issues of: enablement, public use, infringement, infringement without issues of material fact, patent validity, and inducement to infringe.

*Id.*

<sup>50</sup> *Id.*

<sup>51</sup> Hillen, *supra* note 29, at 213–14.

<sup>52</sup> *Id.* Hillen compares the CAFC's domain over patent law to the Supreme Court's domain over First Amendment issues. The Supreme Court is the last resort for First Amendment issues, and therefore they handle inconsistent rulings between the lower courts. *Id.* Since the CAFC is the only court that hears appeals of patent law from the Federal District Courts, there will be no inconsistencies for the Supreme Court to settle. *Id.*

<sup>53</sup> *Id.* The CAFC's jurisdiction is based on subject matter rather than geography, but it still is a circuit court. *Id.* Like other circuit courts, the CAFC is not a fact-finding body. *Id.* Hillen says:



oversee and resolve the inconsistencies born out of the nature of patent litigation.<sup>54</sup> Thus, the CAFC is often the last resort for legal conclusions concerning patents.<sup>55</sup>

The nature of patent law is doubly complex to a trial court. In addition to the normally intricate legal determinations required,<sup>56</sup> there is also the need for coherent understanding of the technology involved in the suit.<sup>57</sup> This dual burden on the jury has worried some critics who do not trust a typical jurist to understand the technology behind the patents.<sup>58</sup> Even the technical expertise of trial judges normally pales in comparison to that of a typical CAFC judge.<sup>59</sup> The CAFC has recognized this limitation of juries in the area of claim interpretation and ruled in *Markman v. Westview* that the court should interpret the facts to determine claim construction.<sup>60</sup> The portion of the litigation where the judge weighs evidence to interpret the claims, called “Markman hearings,” is now a standard procedure in patent litigation.<sup>61</sup>

Interpreting claims is a significant part of a patent trial. A great deal of patent litigation is settled after claim interpretation is completed.<sup>62</sup> Although the *Markman*

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But because the CAFC, like the rest of the circuit courts, is conceptually limited in its ability to reconsider factual issues already decided below, the CAFC has had to liberally reinterpret certain facets of the patent law in those cases where a more thorough understanding of the technical issues might – or would – have led to a different result.

*Id.* at 190.

<sup>54</sup> Commission on Revision of the Federal Court Appellate System, *Structure and Internal Procedures: Recommendation for Change*, 67 F.R.D. 195 (1975). The commission’s patent consultants testified that “the lack of uniformity in decisions on patent-related issues has been widespread” and that parties spend an inordinate amount of time and money forum shopping. *Id.* at 370.

<sup>55</sup> Hillen, *supra* note 29, at 214.

<sup>56</sup> *Id.*

<sup>57</sup> *Id.* at 194 (commenting that patent law is the least favorite of a judge’s duties due to the highly technical, dry nature of issues).

<sup>58</sup> *Id.* at 193.

<sup>59</sup> The U.S. court’s adversarial system relieves some of this burden to bring the judge and jury in line with the technology because it is in the client’s best interests for counsel to make the judge and jury understand. *Id.* at 187. This leads to two additional problems. First, how likely is it that an attorney can educate a judge who is looking for ways to lighten their caseload rather than spend considerable time to learn new technologies? *Id.* at 193. Judges sitting in the CAFC generally have technical backgrounds or have resided over more patent cases, so the ability of the judge to handle highly technical issues is already assured. *Id.* at 219-20. Second, how can counsel bring a lay juror with no science or math since high school to par with the education required to understand the nuances of the current technology? *Id.* at 193.

<sup>60</sup> *Markman v. Westview*, 52 F.3d 967 (Fed. Cir. 1995).

<sup>61</sup> See generally William F. Lee and Anita K. Krug, *Still Adjusting to Markman: A Prescription for the Timing of Claim Construction Hearings*, 13 HARV. J.L. & TECH 55 (1999) (finding that “Markman” hearings are now standard procedure in claim construction proceedings and the arguments center primarily on the timing of the hearings and the CAFC’s refusal to grant interlocutory appeals of the judge’s claim interpretations).

<sup>62</sup> *Markman*, 52 F.3d at 989. In concurring with the majority in *Markman*, Justice Mayer felt that the decision was:

not just about claim language, it [was] about ejecting juries from infringement cases. For this is not just about claim language, it is about ejecting juries from infringement cases. All these pages and all these words cannot camouflage what the court well knows: to decide what the claims mean is nearly always to decide the case.

*Id.*

decision has been met with criticism, the critics are usually only concerned with the inconsistency in timing of the Markman hearings.<sup>63</sup> Some critics would like the CAFC to also review a district judge's interpretation prior to the completion of the trial.<sup>64</sup> However, the shift of the burden of interpreting the claims from the jury to the judge is still good law.

## II. ANALYSIS

Section A analyzes the current role juries play in claim interpretation. Section B compares claim interpretation reasoning with the current role of the jury in determining questions of obviousness. Section C analyzes the importance of special verdicts in patent cases, particularly as to questions of obviousness. Finally, Section D predicts future methods of determining obviousness using the court's reasoning in *McGinley*.

### A. *The Jury's Role in Determining Claim Interpretation*

In *Markman*, the inventor patented a method for a bar code computer system to continually track the inventory of a dry cleaning business.<sup>65</sup> The alleged infringer also used a computer bar-code system for maintaining inventory for dry cleaning. However, the alleged infringer's method was more limited than the inventor's method because the alleged infringer's method could only track invoices and not specific items of clothing.<sup>66</sup> The district court deemed claim construction to be a question of law, and therefore vacated the jury's finding of infringement and granted the defendant's motion for judgment as a matter of law.<sup>67</sup> The plaintiff used the term "inventory" in the claims at issue, and the court decisively limited the term to mean "articles of clothing."<sup>68</sup> Since the defendant's system was only capable of tracking invoices, the defendant's device did not infringe Markman's claims.<sup>69</sup> The CAFC and the Supreme Court agreed with the district court.<sup>70</sup>

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<sup>63</sup> See Pieper, *supra* note 30, at 184:

Claim interpretation can now occur at five different stages of a lawsuit: 1) before trial in a 'Markman hearing' or with other pretrial motions; 2) in combination with other motions filed during trial; 3) at the end of trial before the issues are presented to the jury; 4) after trial in overruling the jury's verdict; or 5) on appeal for a de novo interpretation of the claims

*Id.*

<sup>64</sup> *Id.*

<sup>65</sup> *Markman*, 52 F.3d at 971.

<sup>66</sup> *Id.* at 972. The Markman invention's superiority to Westview's invention was a disadvantage to Markman in his suit of infringement. The court read the advantages that Markman's invention had over the defendant's device into the claims. *Id.* at 973. The claim interpretation required a device that could track articles of clothing throughout the dry-cleaning, and the device could detect and report missing or additional articles of clothing. *Id.* The Westview device could not perform these functions. *Id.*

<sup>67</sup> *Id.* at 973.

<sup>68</sup> *Id.*

<sup>69</sup> *Id.* Claim 1, the independent claim at issue in *Markman*, reads as follows:

1. The inventory control and reporting system, comprising:

The Supreme Court's clarification of the jury's role in claim interpretation in *Markman* significantly impacted patent law.<sup>71</sup> The Supreme Court clarified that claim interpretation is a question of law, and the jury can use the judge's interpretation to render a verdict.<sup>72</sup> The decision affects both the way patent law is litigated and the way claims are drafted.<sup>73</sup> Although the Court recognized that the impact of its decision would be profound, the Court nevertheless deemed its decision critical to maintaining uniformity and predictability.<sup>74</sup>

The Court's support for allowing the judge to interpret claims lies in the traditional role of a judge to interpret written evidence.<sup>75</sup> The Court reasoned that patents are written instruments, and therefore the judge has sole discretion to interpret them.<sup>76</sup> In 1877, the Supreme Court in *Merrill v. Yeomans* settled the issue

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a data input device for manual operation by an attendant, the input device having switch means operable to encode information relating to sequential transactions, each of the transactions having articles associated therewith, said information including transaction identity and descriptions of each of said articles associated with the transactions:

a data processor including memory operable to record said information and means to maintain an inventory total, said data processor having means to associate sequential transactions with unique sequential indicia and to generate at least one report of said total and said transactions, the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another;

a dot matrix printer operable under control of the data processor to generate a written record of the indicia associated with sequential transactions, the written record including optically-detectable bar codes having a series of contrasting spaced bands, the bar codes being printed only in coincidence with each said transaction and at least part of the written record bearing a portion to be attached to said articles; and,

at least one optical scanner connected to the data processor and operable to detect said bar codes on all articles passing a predetermined station, whereby said system can detect and localize spurious additions to inventory as well as spurious deletions therefrom.

*Id.* at 972.

<sup>70</sup> *Markman v. Westview*, 116 S. Ct. 1384 (1996).

<sup>71</sup> See Pieper, *supra* note 30, at 181 (suggesting that in response to the *Markman* decision, attorneys should now alter their strategies to take into account the interpretational methods used by judges, the timing of claim interpretation, the methods used to educate the judge, and issues remaining for the jury to decide).

<sup>72</sup> The *Markman* court splits infringement into a two-step process:

The first step is determining the meaning and scope of the patent claims asserted to be infringed. [citation omitted] The second step is comparing the properly construed claims to the device accused of infringing. [citation omitted] It is the first step, commonly known as claim construction or interpretation that is at issue in this appeal.

*Markman*, 52 F.3d at 976.

<sup>73</sup> Pieper, *supra* note 30, at 181.

<sup>74</sup> See *Markman*, 52 F.3d at 979. The court explained that a judge can better follow established rules to interpret the prosecution history and the text of the patent than a jury. *Id.* Also, determining claim interpretation to be a question of law allows for a permanent definition of rights that are as reviewable as any other legal question. *Id.*

<sup>75</sup> *Id.* at 978.

<sup>76</sup> *Id.* The Court attempts to narrow its argument for the judge interpreting written evidence by restating that this is constitutionally allowable because claim construction was not a question of fact prior to 1791. *Id.* at 984. The *Markman* Court also sets forth the argument that patents should

of whether the judge or the jury interprets patents.<sup>77</sup> While interpreting a claim for a process of deodorizing heavy hydrocarbon oils in the plaintiff's patent, the Court stated that the patent must be interpreted using the "well-settled rules of construing all instruments."<sup>78</sup> However, until *Markman*, the jury played a larger role because of the factual underpinnings of the doctrine.<sup>79</sup> This pre-*Markman* rationale is the current rationale for determining obviousness, and the CAFC has yet to align the obviousness issue with claim construction.

### B. Using the Logic of *Markman* to Reexamine the *McGinley* Decision

The interpretation of written instruments, especially patents, is central to determining obviousness. The *McGinley* case is an ideal example of this point. *McGinley*, in simple terms, was one written instrument, McGinley's patent, compared with two written instruments in the prior art, the Pratt and Morgan patents.<sup>80</sup> The trial judge determined that, as a matter of law, the McGinley patent was obvious when compared to the other two patents.<sup>81</sup> The majority opinion of the CAFC reexamined the jury's findings and the district court's JMOL ruling by recreating the facts as they may have been presented at the trial.<sup>82</sup> The majority concluded, based on the evidence presented at trial, that a reasonable jury could find nonobviousness between McGinley's invention and the prior art.<sup>83</sup>

There are two parts to the issue of obviousness in *McGinley*. The first issue is whether the Pratt ball itself would have been an obvious choice for combination with the Morgan invention.<sup>84</sup> The second issue is whether such a combination would render the McGinley invention obvious.<sup>85</sup> The first issue, comparing the physical embodiments of the inventions at issue, is a question of fact, but the second issue,

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not be considered analogous to contracts, deeds or wills because patents are statutory grants to exclude others from the patented material. *Id.* at 984-85. These arguments by the *Markman* Court also support the argument that judges should solely determine the written evidence in questions of obviousness.

<sup>77</sup> *Merrill v. Yeomans*, 94 U.S. 568 (1877).

<sup>78</sup> *Id.* at 571. *See also* *Bates v. Coe*, 98 U.S. 31, 38 (1878) (construing the claims in a patent the same as any other writing provision).

<sup>79</sup> *See* Piper, *supra* note 30, at 167. "A patent is not just a written work, however, because it embodies the factual aspects surrounding the invention. Thus, [the *Markman*] decision was a departure from the traditional roles of the jury as the finder of fact and the judge as the interpreter of law." *Id.*

<sup>80</sup> *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1345 (Fed. Cir. 2001).

<sup>81</sup> *Id.* at 1347.

<sup>82</sup> *Id.* at 1350-51. The *McGinley* Federal Circuit Court initially stated that the defendant had presented enough evidence from which a jury could have determined obviousness. *Id.* at 1352. Unsure of which specific evidence convinced the jury of non-obviousness, the court ran through a list of evidence that could be found favorable to the plaintiff. *Id.* This included the testimonies of several experts, the presumed validity of the patent, the prosecution history of the patent, and the likelihood that the jury found the prior art to teach away from McGinley's device. *Id.* at 1352-54.

<sup>83</sup> *Id.* at 1351-52.

<sup>84</sup> *Id.* at 1351.

<sup>85</sup> *Id.*

comparing the patents, is a question of law because it requires interpretation of a written instrument, the Pratt patent.<sup>86</sup>

Using this reasoning, the majority's re-creation of facts would be limited. For example, the majority describes how Franklin Sport's vice president of marketing conceded that the circular markings on the Pratt invention could not indicate orientation, and that the phantom lines shown in the Pratt drawings were not actually on the ball.<sup>87</sup> The vice-president's concession about the circles on the Pratt baseball is a fact that the jury interprets while the vice-president's testimony concerning the phantom lines is an interpretation of written evidence to be weighed by the judge.

If the *McGinley* court followed the logic from the *Markman* decision, the trial judge could interpret the three patents and find from the written evidence alone that the McGinley patent was obvious.<sup>88</sup> This reasoning is what led the district court judge to find for Franklin Sports as a matter of law, but the CAFC overturned the decision.<sup>89</sup> The CAFC notes that the district court granted the JMOL motion because the secondary considerations were outweighed by the district court's conclusion that the combination of the Pratt and Morgan patents rendered the McGinley patent obvious as a matter of law.<sup>90</sup>

The CAFC's approach to the standard of review in *McGinley* is a retreat from the bright line drawn in *Markman* where written evidence is determined by the judge.<sup>91</sup> Instead, the CAFC's decision aligns itself with the murky *Panduit* reasoning that although obviousness is a question of law, the evidence leading to answering the question is broadly labeled as facts decided by the jury.<sup>92</sup> The court errs on the side of the Seventh Amendment in *McGinley*, but the court would not encounter a Seventh Amendment issue at all if a special verdict was required that separated facts from law.<sup>93</sup> If trial courts require special verdicts, the roles of the jury and judge can be clearly defined.

### C. The Role of Special Verdicts in the Determination of Obviousness

The *McGinley* court maintained that special verdicts are not a legal requirement in obviousness cases, but the whole case turned on the review of factual determinations made by the jury.<sup>94</sup> The jury only had to answer whether they

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<sup>86</sup> See *id.* at 1356 (admitting the difficulty in determining what evidence the jury relied upon for their resolution of the questions of fact).

<sup>87</sup> *Id.* at 1352.

<sup>88</sup> See *id.* at 1359. The dissent agrees with the trial judge that after comparing the Pratt and Morgan patents to the McGinley patent, there is obviousness as a matter of law. *Id.*

<sup>89</sup> *Id.* The trial judge also found anticipation from the written evidence. *Id.*

<sup>90</sup> *Id.* at 1350.

<sup>91</sup> *Markman v. Westview*, 52 F.3d 967, 978 (Fed. Cir. 1995).

<sup>92</sup> See *Panduit Corp. v. Dennison Mfg.*, 810 F.2d 1561 (Fed. Cir. 1997).

<sup>93</sup> See *McGinley*, 262 F.3d at 1358. In his dissent, Judge Michel does not take the position that special verdicts are required, but he notes that the issue on appeal in *McGinley* was the result of a general verdict on the ultimate legal conclusion of obviousness. *Id.*

<sup>94</sup> *Id.* at 1356. The Court's analysis is rife with hypothetical language such as "a reasonable jury could have determined . . .", "[t]he jury could have certainly concluded . . .", "a reasonable jury

believed that the McGinley patent was anticipated in the light of the Pratt patent alone or obvious in light of a combination of the Pratt and Morgan patents.<sup>95</sup> The questions the jury answered did not include the elements of obviousness. Rather, the jury questions merely allowed the jury to make a broad and unpredictable decision about the question of obviousness.

In a prior decision, *Richardson-Vicks v. Upjohn Company*, the CAFC strongly advocated special verdicts, particularly for determining obviousness, in light of the interplay between questions of fact and law.<sup>96</sup> In *Richardson-Vicks*, the court emphasized that the record evidence may be viewed in the light most favorable to the verdict winner, but the ultimate decision on the question of obviousness must still be made by the court.<sup>97</sup>

The inventor in *Richardson-Vicks* patented a cold medicine, claiming varying ratios of the combination of an analgesic ingredient and a decongestant ingredient in the cold medicine.<sup>98</sup> Similar to the *McGinley* case, the alleged infringer in *Richardson-Vicks* moved for summary judgment on grounds of obviousness, and the court denied the motion and the case went to trial.<sup>99</sup> The jury held that the alleged infringer failed to prove obviousness and awarded the inventor royalties from the infringing product.<sup>100</sup> Like *McGinley*, the trial judge granted the alleged infringer's motion for judgment as a matter of law.<sup>101</sup> The appellate court proceeded to reexamine all the facts de novo because they had no idea what the jury had concluded as to the specific factual findings of the case.<sup>102</sup> The court listed the facts,

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could have considered . . ." and "[t]he jury could have also concluded . . ." because they did not have any idea which facts were actually considered by the jury as dispositive of the verdict. *Id.* at 1354.

<sup>95</sup> *Id.* at 1356. The majority addresses the dissent's concerns and acknowledges that the outcome could have been reversed if the jury's determinations were in the form of a special verdict that clearly separated questions of fact from law. *Id.* However, the majority was comforted that the parties to the litigation did not object to the three questions the jury answered to reach their verdict. *Id.* The answers to the questions were:

First, the jury found that FSI had not proven by clear and convincing evidence that each of the elements of the invention defined in claims 1, 2, 6 and 7 of the [McGinley] patent is disclosed in Pratt. This was a factual finding. Second, the jury found that FSI had not proven by clear and convincing evidence that any of the asserted claims were invalid as being obvious in view of Pratt alone. Finally, the jury found that FSI had not proven by clear and convincing evidence that any of the asserted claims were invalid as being obvious in view of a combination of Pratt and Morgan.

*Id.*

<sup>96</sup> *Richardson-Vicks Inc. v. Upjohn Co.*, 122 F.3d 1476, 1485 (Fed. Cir. 1997). The *Richardson-Vicks* court underwent a similar analysis to determine an obviousness issue, and the court concluded that special verdicts would be particularly useful in patent law. *Id.*

<sup>97</sup> *Id.* at 1479.

<sup>98</sup> *Id.* at 1477.

<sup>99</sup> *Id.* at 1478.

<sup>100</sup> *Id.*

<sup>101</sup> *Id.*

<sup>102</sup> *Id.* at 1479. "Determining the facts and how they bore on the jury's view of the case is made considerably more problematic when, as in the case before us, the only information we have about the jury's views are contained in a general verdict." *Id.*

described the evidence favorably for the alleged infringer, and concluded that they agreed with the trial court.<sup>103</sup>

There is a fine but crucial distinction between the *Richardson-Vicks* analysis and the *McGinley* analysis. For both courts, the factual analysis was put in terms of whether it was possible for a reasonable jury to reach their decision based on the record.<sup>104</sup> However, the *Richardson-Vicks* court realized that legal analysis begins when the court starts to compare the factual differences between the prior art and the claimed invention.<sup>105</sup> Perhaps the *McGinley* court believed the patent owner had the stronger legal and factual argument, and therefore did not distinguish between the two. In either event, the analysis the *McGinley* court used only succeeded in clouding the obviousness issue for future arbiters.<sup>106</sup> Patent law's rapid ascendance<sup>107</sup> is hindered when the court misunderstands the case at bar and delivers an undesirable outcome. But even worse, the law regresses when a court sets a new precedent for factual analysis that is illogical and unwarranted.<sup>108</sup>

#### D. Future Concerns Stemming from the *McGinley* Decision

Obviousness is a popular area of patent litigation.<sup>109</sup> It serves as an alternative defense for parties who have already raised the defense of anticipation.<sup>110</sup> In addition, there are so many factors that contribute to the final obviousness determination that this defense is also the most appealed issue concerning patent validity.<sup>111</sup> The *McGinley* reasoning will only extend obviousness litigation because it will be more difficult for parties to predict the outcome of their cases based on precedent.

Critics debate whether the *Markman* standard of review for claim interpretation increases or decreases the amount of litigation.<sup>112</sup> But, one certainty of that standard

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<sup>103</sup> *Id.* at 1480—84. In addition to the legal issues, the fact pattern of *Richardson-Vicks* also closely parallels *McGinley*. The *Richardson-Vicks* court reduces the issue to “whether one of ordinary skill in the art would have combined the two ingredients into a single form.” *Id.* at 1480. *McGinley* was also about two items of prior art combining into one. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1339 (Fed. Cir. 2001). In *Richardson-Vicks*, however, the court is not satisfied that substantial evidence exists concerning unexpected results and commercial success, and they rule as a matter of law that the evidence as a whole is clear and convincing that the claims are obvious. *Richardson-Vicks*, 122 F.3d at 1484.

<sup>104</sup> *McGinley*, 262 F.3d at 1351; *Richardson-Vicks*, 122 F.3d at 1478.

<sup>105</sup> *Richardson-Vicks*, 122 F.3d at 1479.

<sup>106</sup> See *McGinley*, 262 F.3d at 1363. The dissenting opinion foresees additional situations where general verdicts will make it difficult for appellate courts to make legal determinations on the overall question of obviousness. *Id.*

<sup>107</sup> Mark D. Janis, *Patent Law in the Age of the Invisible Supreme Court*, 2001 U. ILL. L. REV. 387, 405 (2001) (noting the record volume of patent cases now before the federal judiciary).

<sup>108</sup> *McGinley*, 262 F.3d at 1363.

<sup>109</sup> See Lane, *supra* note 3, at 1159 (stating that obviousness is more litigated than the other two fundamental conditions for patent validity, utility and novelty).

<sup>110</sup> See *In re C. Steven McDaniel*, 293 F.3d 1379, 1385 (2002) (stating that “it is well settled that ‘anticipation is the epitome of obviousness’”).

<sup>111</sup> See Lane, *supra* note 3, at 1159.

<sup>112</sup> Part of the policy behind the Court's decision in *Markman* is to bring consistency and predictability to patent law. *Markman*, 52 F.3d at 978—79. Litigation will increase because parties

is that a judge will be your audience for any claim interpretation argument, and attorneys can construct their arguments with the judge in mind.<sup>113</sup> Furthermore, if a judge reviews the case, they are more likely to relay to the parties involved the specific reasoning behind their decision.<sup>114</sup> Juries, on the other hand, do not respond well to special verdicts.<sup>115</sup> In addition, if a party can get past summary judgment and reach the jury, then that party could feed the jury anything within the rules of evidence or civil procedure. Consequently, no one would be able to determine which crucial evidence the jury decided to hang their decision upon.

### III. PROPOSAL: JUDGES SHOULD RESOLVE QUESTIONS OF OBVIOUSNESS ARISING FROM WRITTEN EVIDENCE, AND OTHER EVIDENCE LEFT TO JURIES SHOULD BE SUMMARIZED IN SPECIAL VERDICTS

Section A proposes to extend a district judge's authority to interpret written evidence. Section B proposes a requirement for special verdicts from juries who are responsible for resolving questions of fact.

#### *A. A Brighter Line to Determine What Evidence Should Reside With the Judge as a Question of Law*

The first step in defining the parties' roles in resolving litigation is forming a bright line for attorneys to follow during their preparation. Attorneys would better calculate the costs of proceeding with patent litigation if they knew who their audience would be for each item of evidence, and how such evidence would be interpreted.<sup>116</sup> If the role for judges and juries in resolving questions of obviousness is similar to the roles they perform in questions of claim interpretation, the attorneys could consolidate their strategies for both arguments.

The standard, in specific terms, would require the judge to interpret the written evidence the same way a judge now reviews and interprets the claims. The judge could review the evidence during the *Markman* hearings if applicable. The

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will undoubtedly appeal for a de novo interpretation, and trial judges will delay *Markman* hearings rather than risk a reversal by an appellate court. Pieper, *supra* note 30, at 177.

<sup>113</sup> *Id.* at 182.

A judge, although highly skilled in the interpretation of legal documents, is not a person who normally reads or writes in the technical style associated with patent claims. Therefore, a party wishing to claim a new invention will be in a better position when arguing a particular claim interpretation before a judge if the specification is short, clearly written, and easy to understand for someone with little skill in the relevant art.

*Id.*

<sup>114</sup> See Moore, *supra* note 26, at 368 (stating that, “[t]o a greater degree than judges, juries tend to decide whole suits rather than delineate individual issues, even when separate issues are presented to them via special verdict forms or interrogatories”).

<sup>115</sup> *Id.*

<sup>116</sup> See Archer, *supra* note 4, at 835 (comparing patent attorneys to athletes by stating, “[f]or all of them to perform well, they need the referees and umpires to be consistent, and they need the rules of the game to be predictable”).



determination process that judges use to resolve obviousness would be similar to the claim interpretation determination, but instead of interpreting the scope of the claim, the judge would determine the scope of a prior art's disclosure.<sup>117</sup> From this decision, the question of fact may begin and the jury can weigh the judge's findings with the other evidence presented.

There is a disadvantage of the proposed system because an extensive amount of evidence could fall under the umbrella of "written instruments".<sup>118</sup> Parties to litigation already deal with this problem when it applies to claim interpretation. This would simply extend the rule to obviousness.<sup>119</sup> At the same time, all disputes over claim interpretation and obviousness would be resolved during a Markman hearing. This would provide the court with another reason to handle Markman hearings early in the litigation process to avoid tiresome legal battles.<sup>120</sup> Adding an additional issue such as obviousness at this phase would only strengthen the court's ability to render a summary judgment and forego a trial.

Parties will also have an opportunity for their most complicated evidence, such as convoluted patents and related material, to be reviewed by a judge who is generally better educated than the average juror.<sup>121</sup> This argument is made frequently against juries in general, where instances of injustice can be traced to juries that clearly missed the mark. Though these blanket statements about juries

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<sup>117</sup> See Kimberly A. Moore, *Are District Court Judges Equipped to Resolve Patent Cases?*, 15 HARV. J.L. & TECH 1, 5–7 (2001). Moore describes the current process that district court judges use to interpret patent claims. *Id.* First, the judge will consider intrinsic evidence, which includes "the claims, the specification, and the patents prosecution history." *Id.* at 5. The judge may also look at intrinsic evidence in order to better understand the technology, and the extrinsic evidence includes "dictionary definitions, learned treatises, expert testimony, or anything else the court deems helpful to its task." *Id.* at 7.

<sup>118</sup> See American Intellectual Property Law Association, *Guide to Jury Instructions in Patent Cases* 25–29 (1990) (reprinted in George M. Sirilla, 35 U.S.C. § 103: From Hotchkiss to Hand to Rich, The Obvious Patent Law Hall-Of-Famers, 32 J. MARSHALL L. REV. 437, 575 (1999)). The jury instructions listed the evidence that should be viewed to determine the scope and content of the prior art, including:

1. Patents that issued more than one year before the filing date of the patent or before the date of invention;
2. Publications having a date more than one year before the filing date of the patent or before the date of invention;
3. U.S. patents that have a filing date prior to the date of invention of the claimed subject matter in the patent;
4. Anything in public use or on sale in the U.S. more than one year before the filing date of the patent in suit;
5. Anything that was publicly known or used by others in this country before the date of invention of the claimed subject matter in the patent; and
6. Anything that was made or built in this country by another person before the date of invention of the claimed subject matter in the patent where the thing made or built was not abandoned, suppressed or concealed.

*Id.* The first three items listed are "written evidence" in the context of this article.

<sup>119</sup> See Moore, *supra* note 117, at 5–7.

<sup>120</sup> See generally Lee, *supra* note 61. The current problems with *Markman* hearings are the inconsistency of the timing of the hearings during the litigation, and the CAFC's refusal to review the district court's rulings on claim construction on interlocutory appeal. *Id.* The author proposes that *Markman* hearings should generally occur after discovery but before trial to maximize the judge's knowledge of the subject matter while still minimizing the costs of a trial. *Id.* at 81–85.

<sup>121</sup> See Moore, *supra* note 26, at 369–74 (comparing competency levels of jurors and judges).

may or may not be fair or correct,<sup>122</sup> with patent law, there is more than anecdotal evidence that indicates differences in the outcomes of litigation between a judge and a jury trial.<sup>123</sup>

Patent litigation is known for being very technical and difficult to follow compared to other types of law.<sup>124</sup> Yet the outcomes can mean significant windfalls or hardships for companies.<sup>125</sup> When a juror looks to resolve a patent issue, the natural tendency will be to overlook evidence that is over their heads and to concentrate on the delivery of counsel, comments by the witnesses, and external facts about the backgrounds of the parties.<sup>126</sup> When a jury delivers a flawed verdict, a great burden of proof is placed on the wronged party in the subsequent appeal.<sup>127</sup> However, if the verdict on the more complicated written instruments comes from a judge, it not only may be more reliable, but the standard of review will be lower on appeal.<sup>128</sup>

Opponents of Markman hearings argue that when a judge interprets the facts, and therefore leaves the determination reviewable *de novo*, there will be increased litigation since many parties are more likely to challenge a verdict, which has a standard of review.<sup>129</sup> However, the door to *de novo* review has already been opened with *Markman's* ruling that allows judges to interpret claims.<sup>130</sup> Parties under the proposed system will now appeal any judge interpretations in the same manner they would appeal claim interpretations in Markman proceedings. Increased costs of litigation would be counterbalanced by the consistency of the proposed uniform standard of review. The new standard would also work in tandem with a proposed requirement for special verdicts that would decrease the uncertainty of the issues to be resolved upon appeal.

### *B. Requiring Special Verdicts from Juries in Patent Litigation*

Most of the problems besetting the resolution of obviousness claims could be avoided by requiring juries to issue their findings through special verdicts. Regardless of whether a bright line such as the one suggested above would ever come

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<sup>122</sup> *Id.* at 374 (acknowledging that other areas of law are also as complex as patent litigation and therefore patent law is not alone in potential for unjust verdicts that stem from the jurors' lack of knowledge).

<sup>123</sup> *Id.* at 368. The evidence is in the form of a study of all patent cases that went to trial between 1983 through 1999. *Id.* at 367. The study found that juries tend to decide cases more often than judges by general verdict. *Id.* at 368. The study also showed that juries more so than judges favor the patentee when they bring suit while favoring the infringer who initiates a declaratory judgment. *Id.*

<sup>124</sup> Gregory D. Leibold, *In Juries We Do Not Trust: Appellate Review of Patent Infringement Litigation*, 67 U. COLO. L. REV. 623, 623 (1996).

<sup>125</sup> See Bernard Wysocki Jr., *Intellectual Property Trade Surplus Growing: Royalty and Licensing Exports at \$37 Billion*, CHI. TRIB., April 17, 2000, at C2; Pg. 2; ZONE: C (detailing that U.S. exports in royalties and licensing alone were a \$37 billion business in 1999).

<sup>126</sup> See Moore, *supra* note 26, at 369.

<sup>127</sup> See Lane, *supra* note 3, at 1159.

<sup>128</sup> *Id.*

<sup>129</sup> See Pieper, *supra* note 30, at 177.

<sup>130</sup> *Markman v. Westview*, 52 F.3d 967, 967 (Fed. Cir. 1995).

to fruition, any system that limits a jury's determination of the overall dispute would logically necessitate an open system that guarantees that the judge's domain is retained. Without an open system, the division of responsibilities between the adjudicators is only differentiated by name.

Often juries will struggle in conforming their opinions to a special verdict,<sup>131</sup> but this is a problem with the drafting of the special verdict form, not one inherent to the jury.<sup>132</sup> With the special verdict, there is no need for appellate courts to recreate the facts and determine how each fact may have played a part in the jury's overall decision.<sup>133</sup> Judges are currently more agreeable to special verdicts than juries, perhaps because they understand the need for a detailed record on appeal.<sup>134</sup>

Special verdicts could potentially decrease the amount of appeals for several reasons. Obviously, special verdicts could take away most appellate arguments concerning standard of review and division of roles between the arbiters. Special verdicts would also simplify and limit the arguments available on appeal because often the jury's newly defined role would be harder to overturn and attorneys would have to restrict their arguments to overturning a judge's ruling regarding claim interpretation issues.<sup>135</sup> In addition, the added level of certainty would render some potential appeals unnecessary. The inconvenience of parties to agree on a special verdict, and the difficulty of jurors to struggle through filling out a special verdict, are far outweighed by the certainty of the verdicts and their limiting of appeals.

#### IV. CONCLUSION

The limits of a constitutionally guaranteed right of a trial by a jury of one's peers should always be carefully defined. The right to a jury to determine questions of fact in obviousness issues has never been considered part of this constitutional guarantee. When legal issues dictate a more just outcome by relieving juries of this obligation, the relief should be granted. For patent issues of obviousness, the judge should be the sole arbiter of questions of law, which include interpretation of written instruments. To ensure that a judge's right to this determination is exclusive, courts should require special verdicts from the arbiters of fact. The *McGinley* court missed an opportunity to clarify the roles of the judge and jury when they decided to overlook the discrepancies in these respective roles, but the murkiness of these ground rules

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<sup>131</sup> See Moore, *supra* note 26, at 368.

<sup>132</sup> See generally Mark S. Brodin, *Accuracy, Efficiency, and Accountability in the Litigation Process – The Case for the Fact Verdict*, 59 U. CIN. L. REV. 15 (1990) (arguing for special verdicts and cautioning that special verdicts are only effective when they are written to avoid encompassing questions of law and written in a clear and concise manner).

<sup>133</sup> *Richardson-Vicks v. The Upjohn Co.*, 122 F.3d 1476, 1485 (Fed. Cir. 1997). “The utilization of Rule 49(a) [special verdicts] appears to us as a particularly useful tool in conserving judicial resources and in effectuating the Congressional policy expressed in the patent laws.” *Id.*

<sup>134</sup> See Moore, *supra* note 26, at 368.

<sup>135</sup> See generally Lane, *supra* note 3. Lane proposes following the policy behind Rule 52(A) when determining obviousness claims on appeal. *Id.* Lane's reasoning is to foster consistency and reliability in obviousness appeals because there is no current bright line for determining what evidence should be reviewed under Rule 52(A). *Id.* Lane's proposed solution is for the same problem of inconsistencies in the review process, but the proposal is far more sweeping when trying to define the review process. *Id.*

ensures that the CAFC will have another opportunity to resolve the issue in the future.