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RECONSIDERING *IN RE TECHNOLOGY LICENSING CORPORATION* AND THE RIGHT TO JURY TRIAL IN PATENT INVALIDITY SUITS

ANDREW W. BATEMAN*

INTRODUCTION

“The right of jury trial in civil cases at common law is a basic and fundamental feature of our system of federal jurisprudence which is protected by the Seventh Amendment. A right so fundamental and sacred to the citizen . . . should be jealously guarded by the courts.”¹ The rights of individuals in patent cases are no less deserving of the stubborn protections of the Seventh Amendment. Although some commentators argue that practical concerns should dictate a greatly reduced—or even nonexistent—jury role in patent cases,² the Seventh Amendment reflects a concern with principles well beyond mere “efficient judicial administration.”³ “The founders of our Nation considered the right of trial by jury in civil cases an important bulwark against tyranny and corruption, a safeguard too precious to be left to the whim of the sovereign, or, it might be added, to that of the judiciary.”⁴

Nevertheless, over the past decade, the Supreme Court and the Federal Circuit have steadily eroded the jury’s role in patent cases by shifting the weight of decision making to the judge. In *Markman v. Westview Instruments*, the Federal Circuit held (in “*Markman I*”) that, although infringement claims generally preserve the right to trial by jury, claim construction⁵

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1. *Jacob v. New York City*, 315 U.S. 752, 752–53 (1942).

2. *See, e.g.*, Kimberly A. Moore, *Judges, Juries, and Patent Cases: An Empirical Peek Inside the Black Box*, 99 MICH. L. REV. 365, 369 (2000) (noting that “increased participation by juries in patent cases . . . has caused a number of scholars and other commentators to question the propriety of jury resolution of patent cases”).

3. *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 343 (1979) (Rehnquist, J., dissenting).

4. *Id.*

5. Claim construction refers to the process of interpreting the meaning of patent claims, which are the most important part of the patent. JANICE M. MUELLER, AN INTRODUCTION TO PATENT LAW 226–27 (2003). Claims define the outer perimeter of the patentee’s right to exclude others, thereby serving to notify the public of how closely one may imitate the invention without infringing. *Id.* at 227.

is a purely legal question for the judge alone.⁶ Granting certiorari, the Supreme Court (in “*Markman I*”) affirmed that the judge, not the jury, should construe patent claims.⁷ Although the Supreme Court did not expressly affirm the *Markman I* holding that claim construction is a purely legal question subject to *de novo* review, the Federal Circuit in *Cybor Corp. v. FAS Technologies, Inc.* read *Markman II* as supporting—or at least not overturning—that conclusion.⁸ By continuing to view claim construction as a purely legal question, the Federal Circuit reaffirmed that juries may not decide any factual issues underlying claim construction.⁹

The practical effect of *Markman I* and *II* and *Cybor* on the role of the jury extends well beyond mere claim construction. A claim’s meaning is often dispositive of whether an accused device literally infringes that claim.¹⁰ Therefore, the jury’s responsibilities in infringement cases have been in large part confined to determining whether infringement exists under the doctrine of equivalents.¹¹ But even in relation to the doctrine of equivalents, the jury’s role is both uncertain and tightly constrained. While the Supreme Court, in *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, remarked that there was “ample support in [its] prior cases” to conclude that equivalence is a question for the jury, it left the door open by

6. *Markman v. Westview Instruments, Inc. (Markman I)*, 52 F.3d 967, 984 (Fed. Cir. 1995). The Federal Circuit compared claim construction to the construction of other legal documents and noted that valid patents should be fully integrated documents, which a person of ordinary skill in the art should be able to interpret without resorting to extrinsic evidence. *Id.* at 984–85. While the court conceded that a judge may need to look at extrinsic evidence (such as dictionaries, treatises, and expert testimony), it maintained that judges only use such evidence as an aid to their understanding of the technology—and the level of ordinary skill within that technology—and not in a traditional evidentiary fact-finding sense. *Id.* at 980–81.

7. See *Markman v. Westview Instruments, Inc. (Markman II)*, 517 U.S. 370, 391 (1996) (holding “that the interpretation of the word ‘inventory’ . . . is an issue for the judge, not the jury”). For a detailed discussion of *Markman II*, see *infra* Part II.

8. See *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1455–56 (Fed. Cir. 1998). The *Cybor* majority concluded that “the Supreme Court’s [*Markman II*] opinion conclusively and repeatedly states that claim construction is purely legal.” *Id.* at 1456. The majority also noted that—even if the Supreme Court did not hold either way on the issue—the Federal Circuit’s own majority opinion in *Markman I* would remain authoritative and dictate treating claim construction as a purely legal question subject to *de novo* review. *Id.*

9. As Judge Newman pointed out, this result tends to “confound” the traditional litigation process. See *id.* at 1480 (Newman, J., dissenting) (“Without doubt, factual disputes arise and must be resolved in order to interpret the claims. Such facts are normally resolved at trial—yet we now deny ourselves the opportunity even to consider the findings of the trial court.”).

10. MUELLER, *supra* note 5, at 226.

11. The doctrine of equivalents allows a patentee to establish infringement even where a device or process does not literally infringe a claim, and serves to prevent others from escaping liability by making minor, insubstantial changes to the invention. *Id.* at 238–40. Infringement under the doctrine of equivalents requires that the accused device or process includes at least an equivalent of each and every limitation of the claim. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29 (1997).

declining to expressly hold on the issue.¹² And even if equivalence remains a jury question, recently established legal limitations on the doctrine have greatly reduced the number of situations in which it might be applied.¹³ As a result, the jury's role in infringement suits—where, ostensibly, “there is no dispute” that the right to jury trial exists¹⁴—has been severely curtailed.

More recently, the Federal Circuit has attacked the patentee's right to jury trial in the context of patent invalidity suits. In 2001, the Federal Circuit held in *Tegal Corp. v. Tokyo Electron America, Inc.* that there is no right to trial by jury where the patentee seeks only the equitable relief of injunction and the defendant raises the affirmative defense of invalidity.¹⁵ Four years later, in *In re Technology Licensing Corporation*, the Federal Circuit expanded *Tegal* by holding that there is no right to trial by jury in a declaratory judgment action seeking a declaration of patent invalidity, where the defendant counterclaims with alleged infringement and seeks an injunction as the sole remedy.¹⁶ The patentee in *Technology Licensing* petitioned the court for a writ of mandamus, arguing that the right to trial

12. *Warner-Jenkinson*, 520 U.S. at 38. In the decision below, the Federal Circuit had noted that equivalence is a jury question. *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1525 (Fed. Cir. 1995).

13. See Judge Paul R. Michel, U.S. Court of Appeals for the Federal Circuit, *Enabling the Jury to Apply Patent Law Rationally*, Address Before the Yale Law and Technology Society (Apr. 14, 1998), *edited transcript in* 1 YALE SYMP. L. & TECH. 1 (1999) (“All of [the limitations on the doctrine of equivalents] are issues of law and therefore are to be decided by the judge, not by the jury Therefore in a significant percentage of cases, there is the possibility that equivalent infringement will disappear entirely as a viable issue long before the case goes to the jury.”). Perhaps the most common limitation on the doctrine of equivalents is “prosecution history estoppel”: almost invariably, applicants find it necessary to amend their patent claims during prosecution, and in *Warner-Jenkinson* the Supreme Court held that, where the prosecution history is silent about the reason for an amendment, the amendment creates the rebuttable presumption that it was made for a reason related to patentability. 520 U.S. at 33. Soon after, the Federal Circuit nearly destroyed the doctrine of equivalents by holding that the failure to rebut the *Warner-Jenkinson* presumption gives rise to a complete bar on a patentee's ability to assert equivalence with respect to the amended elements of a claim. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. (Festo I)*, 234 F.3d 558, 567–68 (Fed. Cir. 2000). While the Supreme Court disagreed and relaxed this limitation on the doctrine of equivalents, the doctrine is still very limited in its applicability. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. (Festo II)*, 535 U.S. 722, 740–41 (2002) (holding that amendments of claim limitations made for reasons related to patentability create a presumption of non-equivalence, but also that the presumption may be rebutted if the “equivalent [was] unforeseeable at the time of the application; the rationale underlying the amendment . . . bear[s] no more than a tangential relation to the equivalent in question; or there [is] some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question”). In addition to prosecution history estoppel, other legal limitations constrain the applicability of the doctrine of equivalents. For example, a patentee cannot establish infringement under the doctrine of equivalents if the prior art would have precluded the patentee from writing the claim more broadly to expressly include the asserted equivalent. *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 683 (Fed. Cir. 1990). As a legal issue subject to *de novo* review, *id.*, this “prior art preclusion” limitation further diminishes the jury's role in infringement suits.

14. *Markman v. Westview Instruments, Inc. (Markman II)*, 517 U.S. 370, 377 (1996).

15. 257 F.3d 1331, 1341 (Fed. Cir. 2001).

16. 423 F.3d 1286, 1288 (Fed. Cir. 2005).

by jury should always attach to a declaratory judgment action to invalidate a patent, regardless of the type of relief the patentee seeks.¹⁷ The Federal Circuit, however, denied the petition,¹⁸ and the Supreme Court denied cert.¹⁹

This Comment argues that *Technology Licensing* was wrongly decided, and should be reconsidered *en banc* if the issue again comes before the Federal Circuit. Part I provides a brief background of the Seventh Amendment right to trial by jury in civil cases, focusing on the historical-analog test laid out in *Tull v. United States*.²⁰ Part II examines the Supreme Court's reasoning in *Markman II* and focuses on how the Court arrived at its holding that claim construction is not a jury issue, despite the lack of clear guidance from either the historical-analog test of *Tull* or precedent. Part III examines the Federal Circuit's reasoning in cases concerning the right to jury trial in suits involving patent invalidity claims and focuses on the majority and dissent opinions in *Technology Licensing*. Finally, Part IV applies the Supreme Court's *Markman II* analysis to *Technology Licensing* and concludes that (1) neither the historical-analog test nor precedent adequately support the court's denial of the right to jury trial in declaratory judgment actions of patent invalidity, and (2) functional considerations and policy concerns favor leaving the resolution of the many factual questions underlying patent invalidity claims in the hands of the jury.

I. THE SEVENTH AMENDMENT'S RIGHT TO TRIAL BY JURY

The Seventh Amendment guarantees the right to trial by jury in suits at common law with an amount in controversy exceeding twenty dollars.²¹ The Supreme Court has interpreted the Seventh Amendment's language as guaranteeing the right to jury trial in any action that is analogous to a suit at common law, rather than a case tried in courts of equity or admiralty, as of the time the Seventh Amendment was adopted in 1791.²² To determine which type of suit an action is more analogous to, the Court in *Tull v. United States* used a two-prong test: (1) "compare the statutory action to 18th-century actions brought in the courts of England prior to the merger of

17. *Id.* at 1287–88.

18. *Id.* at 1288.

19. *Tech. Licensing Corp. v. U.S. Dist. Court for the N. Dist. of Cal.*, 126 S. Ct. 2353 (2006).

20. 481 U.S. 412 (1987).

21. U.S. CONST. amend. VII ("In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law.").

22. *Tull*, 481 U.S. at 417.

the courts of law and equity,” and (2) “examine the remedy sought and determine whether it is legal or equitable in nature.”²³

Application of the second prong of the historical-analog test—under which the court must characterize the type of relief sought by the claimant—“is ‘[m]ore important’ than finding a precisely analogous common-law cause of action in determining whether the Seventh Amendment guarantees a jury trial.”²⁴ Moreover, the two prongs of the test must be considered jointly rather than independently. In *Tull*, for example, where the right to jury trial was at issue in a suit involving civil penalties under the Clean Water Act, the Court rejected the Government’s proposal that a public nuisance action be considered the appropriate historical analog under the first prong, while an action for disgorgement be considered the appropriate historical analog under the second prong.²⁵ Instead, the Court sought “a *single* historical analog, taking into consideration the nature of the cause of action and the remedy as two important factors.”²⁶

The Court in *Tull* did note that the Supreme Court has in some cases—even where the historical-analog test might otherwise suggest that the Seventh Amendment guarantees the right to trial by jury—considered the “practical limitations of a jury trial and its functional compatibility with proceedings outside of traditional courts of law” to determine that the Seventh Amendment’s guarantee does not apply.²⁷ Unlike the similarly labeled “functional considerations” addressed by the Supreme Court in *Markman II*,²⁸ however, this particular limitation on the right to jury trial only applies where “public rights” (as opposed to “private rights”) are at issue.²⁹ Cases involving “public rights” are those that involve a statutory cause of action that Congress may assign to a “non-Article III court.”³⁰ Because an action for a declaration of patent invalidity “may properly be brought in an Article III court,” this limitation on the Seventh Amendment protection “does not affect [a court’s] analysis.”³¹

23. *Id.* at 417–18. Legal remedies are “ordinarily an award of money damages,” while equitable remedies are those in which a court, at its discretion, can “adapt the relief to the circumstances of the case” (e.g., by granting injunctive relief). 1 AM. JUR. 2D *Actions* § 6 (2006).

24. *Tull*, 481 U.S. at 421 (quoting *Curtis v. Loether*, 415 U.S. 189, 196 (1974)).

25. *Id.* at 421 n.6.

26. *Id.* (emphasis added).

27. *Id.* at 418 n.4.

28. *See infra* Part II.

29. *See Granfinanciera, S. A. v. Nordberg*, 492 U.S. 33, 53 (1989) (“Unless a legal cause of action involves ‘public rights,’ Congress may not deprive parties litigating over such a right of the Seventh Amendment’s guarantee to a jury trial.”).

30. *Id.*

31. *In re Lockwood*, 50 F.3d 966, 972 n.5 (Fed. Cir. 1995) (quoting *Chauffeurs, Teamsters & Helpers Local No. 391 v. Terry*, 494 U.S. 558, 565 n.4 (1990)), *vacated*, 515 U.S. 1182 (1995).

II. THE RIGHT TO JURY TRIAL IN CLAIM CONSTRUCTION: THE SUPREME COURT'S ANALYSIS

In *Markman II*, the Supreme Court used the first prong of the historical-analog test to determine whether the right to trial by jury extends to the issue of patent claim construction.³² The Court noted that there is no direct antecedent of modern claim construction³³ and that the closest analog was the construction of the patent specifications describing the invention—an issue which, according to the Court's historical survey, appeared to have been the province of judges rather than juries around 1791.³⁴

The Court, however, recognized that the historical analog of specification construction could not provide any clear answers.³⁵ Only a “mere smattering” of patent cases from the period were available and, of those, “[f]ew . . . even touch[ed] upon the proper interpretation of disputed terms in the specifications at issue”³⁶ Although the Court determined that the few sources available “show[ed] no established jury practice sufficient to support an argument by analogy that today's construction of a claim should be a guaranteed jury issue”—and indeed supported the opposite conclusion—it did not base its holding on that determination.³⁷ Rather, the Court held that the historical-analog test was inconclusive.³⁸

Realizing that it “must look elsewhere . . . in order to allocate [claim construction] as between court or jury,” the Court proceeded to look at precedent.³⁹ The Court noted that its own past cases held that construing a patent is a question of law for the court.⁴⁰ *Markman* argued, however, that

32. *Markman v. Westview Instruments, Inc. (Markman II)*, 517 U.S. 370, 376–84 (1996). The Court ignored the second prong of the test, however, which focuses on the remedy sought. This was likely because the Court felt that the remedy was irrelevant where it was only analyzing the right to trial by jury in the limited context of claim construction, rather than the infringement action as a whole.

33. *Id.* at 378–79. Claim practice received no statutory recognition until 1836, and claims were not required by statute until 1870. *Id.* at 379.

34. *Id.* at 379–84.

35. *Id.* at 379–83.

36. *Id.* at 379–80. The Court explained that the “absence of an established practice should not surprise us, given the primitive state of jury patent practice at the end of the 18th century, when juries were still new to the field.” *Id.* at 380. By the end of the eighteenth century, “no more than twenty-two [reported] cases came before the superior courts of London.” *Id.* at 380 n.4 (alterations in original) (quoting H. DUTTON, *THE PATENT SYSTEM AND INVENTIVE ACTIVITY DURING THE INDUSTRIAL REVOLUTION, 1750–1852*, at 71 (1984)).

37. *Markman II*, 517 U.S. at 380. The Court also held that the historical record did not support the patentee's “more modest contention” that juries were at least responsible for construing “terms of art” within a specification. *Id.* at 383–84.

38. *Id.* at 384.

39. *Id.* at 384–88.

40. *See id.* at 384 n.10. The Court noted its much earlier holding that the construction of a patent “is a question of law, to be determined by the court, construing the letters-patent, and the description of the invention and specification of claim annexed to them.” *Id.* at 384 (quoting *Winans v. Denmead*, 56

when the construction of a claim depended on extrinsic evidence, the jury and not the court had construed the patent terms.⁴¹ Primarily, Markman relied on two nineteenth-century Supreme Court cases—*Bischoff v. Wethered*⁴² and *Tucker v. Spalding*⁴³—in support of his contention.⁴⁴ In *Bischoff*, the Court held it was improper for a court to instruct a jury as to whether the inventions described by two patents were identical.⁴⁵ Markman contended that, because the Court in *Bischoff* held that the issue of identity should be determined by the jury and not the judge, the prerequisite step of construing patent terms must also rest with the jury.⁴⁶ The Court in *Markman II*, however, emphasized the critical distinction between issues of identity and issues of patent construction, repeating the observation from *Bischoff* that “[i]t is not the construction of the instrument, but the character of the thing invented, which is sought in questions of identity and diversity of inventions.”⁴⁷ Thus, by leaving the issue of identity to the jury, the Court in *Bischoff* had not gone so far as to support the proposition that the jury should construe patent terms.⁴⁸ *Tucker* likewise failed to support Markman’s argument, as it expressly relied on *Bischoff* and used similar reasoning.⁴⁹

Having found that “history and precedent provide no clear answers,” the Court next turned to “functional considerations” to determine whether the judge or the jury should construe patent claims.⁵⁰ The functional consideration that the Court focused on was, naturally, whether the judge or jury would generally be “better suited” to construe patent claim language.⁵¹ The Court noted that judges have more training and experience than jurors when it comes to the construction of written instruments, and therefore are

U.S. (15 How.) 330, 338 (1854)). The Court also cited *Winans v. New York & Erie R. Co.*, 62 U.S. (21 How.) 88, 100 (1859), and *Parker v. Hulme*, 18 F. Cas. 1138, 1140 (C.C.E.D. Pa. 1849) (No. 10,740), in support of that proposition. *Markman II*, 517 U.S. at 384–85.

41. *Markman II*, 517 U.S. at 385.

42. 76 U.S. (9 Wall.) 812 (1870).

43. 80 U.S. (13 Wall.) 453 (1872).

44. *Markman II*, 517 U.S. at 385.

45. *Bischoff*, 76 U.S. (9 Wall.) at 814–16.

46. *Markman II*, 517 U.S. at 385.

47. *Id.* at 386 (emphasis omitted) (quoting *Bischoff*, 76 U.S. (9 Wall.) at 816).

48. *Id.*

49. *Id.*

50. *Id.* at 388.

51. *Id.* The Court justified its reliance on functional considerations by noting that, when an issue “falls somewhere between a pristine legal standard and a simple historical fact, the fact/law distinction at times has turned on a determination that, as a matter of the sound administration of justice, one judicial actor is better positioned than another to decide the issue in question.” *Id.* (quoting *Miller v. Fenton*, 474 U.S. 104, 114 (1985)).

“likely to do better” at it.⁵² The technical complexity of patents, exacerbated by the specialized legal doctrines developed in the courts and the Patent & Trademark Office, only reinforced the Court’s conclusion.⁵³

Like the Federal Circuit majority in *Markman I*, the Supreme Court acknowledged the importance of extrinsic evidence (such as expert testimony) in claim construction.⁵⁴ But although the Court recognized that “in theory there could be a case in which a simple credibility judgment would suffice to choose between experts whose testimony was equally consistent with a patent’s internal logic,” it believed that such cases would be rare and that credibility determinations would “be subsumed within the necessarily sophisticated analysis of the whole document.”⁵⁵ Therefore, even though credibility determinations are normally considered the jury’s forte, the Court stated that “a jury’s capabilities to evaluate demeanor . . . are much less significant [to claim construction] than [the judge’s] trained ability to evaluate the testimony in relation to the overall structure of the patent.”⁵⁶

Finally, the *Markman II* Court looked at a policy concern: the importance of uniformity in the interpretation of a given patent.⁵⁷ There can be little doubt that a robust patent system requires some uniformity in the interpretation of a patent’s claims. The claims, after all, delimit the scope of the invention and inform both the patentee and the public of the precise outer bounds of the patentee’s property interest.⁵⁸ While collateral estoppel might provide some uniformity of interpretation even if claim construction were left to the jury, it would not apply where the patentee litigates against a new and independent defendant.⁵⁹ The Court noted that if claim construction were instead held to be a legal issue for the court, the principle of *stare decisis* would operate to provide broader uniformity.⁶⁰ Given the impor-

52. *Id.* at 388–89.

53. *Id.* at 389.

54. *See id.* (“It is, of course, true that credibility judgments have to be made about the experts who testify in patent cases . . .”).

55. *Id.*; *see also* *Markman v. Westview Instruments, Inc. (Markman I)*, 52 F.3d 967, 981 (Fed. Cir. 1995) (“[In using extrinsic evidence for claim construction], the court is *not* crediting certain evidence over other evidence or making factual evidentiary findings. Rather, the court is looking to the extrinsic evidence to assist in its construction of the written document, a task it is required to perform.”).

56. *Markman II*, 517 U.S. at 389–90.

57. *See id.* at 390 (“[W]e see the importance of uniformity in the treatment of a given patent as an independent reason to allocate all issues of construction to the court.”).

58. *See* MUELLER, *supra* note 5, at 38–39 (analogizing the claim to a fence defining the borders of real property); *see also* *Gen. Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938) (“The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public.”).

59. *Markman II*, 517 U.S. at 391.

60. *Id.*

tance of uniformity, and given that functional considerations counseled against leaving claim construction to the jury, the Court held that the judge alone should construe patent claims.⁶¹

III. THE RIGHT TO JURY TRIAL IN INVALIDITY SUITS: THE FEDERAL CIRCUIT'S ANALYSIS

The Federal Circuit developed its approach to the right to jury trial in patent invalidity suits over the course of three cases: *In re Lockwood*,⁶² *Tegal Corp. v. Tokyo Electron America, Inc.*,⁶³ and, most recently, *In re Technology Licensing Corp.*⁶⁴ In each case, the issue of invalidity arose in a different procedural setting, and the court used the historical-analog test to determine whether the right to jury trial should attach. But while the court's approach in *Lockwood* reflected its concern for preserving the patentee's right to jury trial,⁶⁵ that same method of analysis would later, in *Tegal* and *Technology Licensing*, result in a denial of that right.

In *Lockwood*, the patentee (Lockwood) alleged that American Airlines, Inc., had infringed claims in two of his patents, and sought both damages and injunctive relief.⁶⁶ American asserted multiple defenses, including invalidity, and also counterclaimed for a declaratory judgment of noninfringement or, alternatively, a declaratory judgment of invalidity and unenforceability.⁶⁷ Pursuant to a motion for summary judgment, the district court dismissed Lockwood's infringement claim, leaving only American's claim for a declaratory judgment of invalidity.⁶⁸ The district court then proceeded to consider the remaining invalidity action, without allowing Lockwood an interlocutory appeal on the infringement judgment.⁶⁹ Lockwood demanded a jury trial on the issue of invalidity, but the court, viewing the nature of the remaining declaratory judgment action as equitable,

61. *Id.*

62. 50 F.3d 966 (Fed. Cir. 1995), *vacated*, 515 U.S. 1182 (1995).

63. 257 F.3d 1331 (Fed. Cir. 2001).

64. 423 F.3d 1286 (Fed. Cir. 2005).

65. *See Lockwood*, 50 F.3d at 976 ("We cannot, consistent with the Seventh Amendment, deny Lockwood [the option of jury trial] merely because the validity of his patents comes before the court in a declaratory judgment action for invalidity rather than as a defense in an infringement suit. Lockwood is entitled to have the factual questions relating to validity in this case tried to a jury as a matter of right.").

66. *Id.* at 968.

67. *Id.*

68. *Id.*

69. *Id.*

struck the demand.⁷⁰ Lockwood petitioned the Federal Circuit for a writ of mandamus directing the district court to reinstate his jury demand.⁷¹

The Federal Circuit in *Lockwood* applied the two-pronged historical-analog test of *Tull*, first comparing the action to eighteenth-century actions brought in England prior to the merger of the courts of law and equity, then examining the remedy sought and determining whether it was more legal or equitable in nature.⁷² “Thus,” the court noted, “if a particular action entails either the adjudication of legal rights, or, alternatively, the implementation of legal remedies, the district court must honor a jury demand to the extent that disputed issues of fact concerning those rights and remedies require a trial.”⁷³ Recognizing that declaratory judgment actions were not known at common law at the turn of the eighteenth century,⁷⁴ the court concluded that the nearest historical analog was an “inverted” form of the declaratory judgment action: “American’s action resembles nothing so much as a suit for patent infringement in which the affirmative defense of invalidity has been pled, and Lockwood’s right to a jury trial must be determined accordingly.”⁷⁵ Because the patentee in a typical infringement suit in 1791 could have brought the suit in either law or equity, Lockwood’s right to trial by jury on the factual issues relating to patent validity was preserved.⁷⁶ Although *Lockwood* was vacated (without explanation) by the Supreme Court, the Federal Circuit subsequently stated that its reasoning in *Lockwood* was “neither supplanted nor questioned.”⁷⁷

Six years later, in *Tegal*, the Federal Circuit held that where a plaintiff-patentee seeks only the equitable remedy of injunction and the defendant asserts only the affirmative defense of invalidity with no counterclaims, the defendant is not entitled to trial by jury.⁷⁸ In *Tegal*, the patentee (Tegal Corporation) had initially requested a jury trial for its pat-

70. *Id.* at 969.

71. *Id.*

72. *Id.* at 972.

73. *Id.* (citations omitted).

74. *See id.* at 973 (noting that Congress passed the Declaratory Judgment Act in 1934).

75. *Id.* at 974.

76. *Id.* at 976. Interestingly, the court used this reasoning even though the alleged infringer had already won summary judgment of non-infringement, leaving only the invalidity claim. *Id.* at 968. Moreover, although the patentee had not yet exhausted his right of appeal on the infringement issue, the court made it clear that “the particulars of [the patentee’s] dismissed claim can play no part in our determination whether he enjoys a Seventh Amendment right to a jury trial as to validity.” *Id.* at 969. Therefore, it appears that the court was not placing any weight on the particular remedy sought by the patentee.

77. *Tegal Corp. v. Tokyo Electron Am., Inc.*, 257 F.3d 1331, 1340 (Fed. Cir. 2001).

78. *Id.* at 1341.

ent infringement suit against Tokyo Electron America, Inc. (“TEA”).⁷⁹ Tegal sought both injunctive relief and damages, and TEA asserted affirmative defenses, including the defense of invalidity.⁸⁰ Tegal later withdrew its claim for damages, causing the district court judge to order the trial to proceed without a jury.⁸¹ TEA, however, desired a jury trial on the issues raised in the pleadings and filed a motion for reconsideration of the order.⁸² The district court denied the motion to reconsider and eventually found the asserted claims to be enforceable, not invalid, and willfully infringed by TEA.⁸³

On appeal, the Federal Circuit agreed that TEA was not entitled to a jury trial.⁸⁴ The court again applied the historical-analog test of *Tull*, but this time stressed the importance of the second prong—whether the remedy is legal or equitable in nature—over the first.⁸⁵ For the first prong, the court concluded that the patentee’s decision to seek only the remedy of injunction meant that an analogous action in eighteenth-century England could only have been brought in a court of equity.⁸⁶ In a somewhat redundant application of the second prong, the court noted that injunction is clearly an equitable remedy.⁸⁷ Therefore, under the court’s analysis, both prongs supported a denial of the right to trial by jury.⁸⁸

In *Technology Licensing*, the Federal Circuit majority synthesized and expanded *Lockwood* and *Tegal* to hold that there is no right to trial by jury where the plaintiff seeks a declaratory judgment of patent invalidity, and the defendant-patentee raises a counterclaim of infringement seeking only an injunction.⁸⁹ The *Technology Licensing* case began when Technology Licensing Corporation (“TLC”) sued Videotek, Inc. in the United States District Court for the Northern District of California, alleging infringement of claims in four of its patents.⁹⁰ Videotek then filed a third-party complaint against its supplier, Gennum Corporation, seeking to establish a right

79. *Id.* at 1338.

80. *Id.*

81. *Id.*

82. *Id.*

83. *Id.*

84. *Id.* at 1341.

85. *See id.* at 1339 (“[T]he Supreme Court has repeatedly taught that courts must examine both the nature of the action involved and the remedy sought, and that the nature of the remedy is more important than that of the action.”).

86. *Id.* at 1340–41.

87. *Id.* at 1341.

88. *Id.*

89. *In re Tech. Licensing Corp.*, 423 F.3d 1286, 1288–91 (Fed. Cir. 2005).

90. *Id.* at 1286.

to indemnification should Videotek be found liable for infringement.⁹¹ Gennum, in turn, filed a declaratory judgment action against TLC, seeking a declaration that the asserted patent claims were invalid, unenforceable, and not infringed.⁹² TLC counterclaimed that Gennum was liable for direct and contributory infringement of the asserted patent claims.⁹³ TLC and Videotek subsequently settled, leaving only the action between TLC and Gennum, consisting of Gennum's declaratory judgment claim and TLC's infringement counterclaim.⁹⁴

Following a district court order that greatly reduced the amount of damages that TLC might be able to obtain for infringement, TLC withdrew its claim for damages and decided to seek only an injunction.⁹⁵ Gennum initially requested a jury trial, then later withdrew that request; TLC, however, contended that it was still entitled to a jury trial.⁹⁶ Specifically, TLC argued that the patentee's right to trial by jury always attaches to a declaratory judgment action to invalidate a patent, regardless of what type of relief the patentee seeks in a counterclaim.⁹⁷ After the magistrate judge concluded that TLC was not entitled to a jury trial, TLC petitioned the Federal Circuit for a writ of mandamus ordering the district court to grant the request for a jury trial.⁹⁸ The Federal Circuit majority, however, denied the petition and endorsed the analysis of the magistrate judge, which had in turn relied heavily on both *Lockwood* and *Tegal*.⁹⁹

In his analysis, the magistrate judge had applied the two-pronged historical-analog test of *Tull*.¹⁰⁰ Proceeding in reverse order, the magistrate had first considered the second prong, concerning the nature of the remedy sought.¹⁰¹ Claiming the outcome to be "relatively straightforward," the magistrate stated that once TLC had withdrawn its request for damages, the remedy sought by the patentee was "indisputably equitable in nature."¹⁰² The magistrate judge then analyzed the action under the first prong.¹⁰³ The magistrate relied on *Lockwood*'s determination that the closest eighteenth-

91. *Id.*

92. *Id.*

93. *Id.* at 1286-87.

94. *Id.* at 1287.

95. *Id.*

96. *Id.* at 1286-87.

97. *Id.* at 1287.

98. *Id.* at 1288.

99. *Id.* at 1287-88.

100. *Id.* at 1287.

101. *Id.*

102. *Id.*

103. *Id.* at 1287-88.

century analog of a declaratory judgment action for invalidity with a counterclaim of infringement would be the inverted form: an infringement action with a defense of invalidity.¹⁰⁴ Although the Federal Circuit majority considered the issue to be a close one, it affirmed the magistrate judge's decision and agreed with his reasoning.¹⁰⁵

In her dissent, Judge Newman applied the historical-analog test to argue that the right to trial by jury always attaches to an invalidity claim.¹⁰⁶ She argued that the closest eighteenth-century analog was not the inverted form of the declaratory judgment action, but rather the common law writ of *scire facias*.¹⁰⁷ The writ of *scire facias* is

a writ necessarily founded on some matter of record, and must issue out of the court where that record is. . . . [It] is a warning given to the defendant . . . to appear in court and plead in bar of the execution, or show any cause if he can by release or otherwise, why execution should not issue on the judgment or record against him.¹⁰⁸

Among its many applications, the writ of *scire facias* had been issued in the king's name to repeal or revoke (i.e., invalidate) patents,¹⁰⁹ making it an obvious candidate for the closest historical analog to a patent invalidity suit. The *Technology Licensing* majority, however, deferred to the reasoning of the *Lockwood* majority, where the court had concluded that the writ of *scire facias* only applied to fraudulently obtained patents—and that the writ was therefore more analogous to a modern declaratory judgment action seeking unenforceability due to inequitable conduct, rather than one seeking invalidity.¹¹⁰

Although not expressly analyzing the second prong of the *Tull* test, Judge Newman also seemed to view the remedy very differently than the majority: while the majority focused exclusively on the injunctive remedy sought by the patentee, Judge Newman focused on the declaration of inva-

104. *Id.*

105. *Id.* at 1288.

106. *Id.* at 1292–93 (Newman, J., dissenting).

107. *Id.*

108. THOMAS CAMPBELL FOSTER, TREATISE ON THE WRIT OF SCIRE FACIAS, WITH AN APPENDIX OF REFERENCES TO FORMS 2 (London, V. & R. Stevens & G. S. Norton 1851) (footnotes omitted). Black's Law Dictionary defines *scire facias* as "[a] writ requiring the person against whom it is issued to appear and show cause why some matter of record should not be annulled or vacated, or why a dormant judgment against that person should not be revived." BLACK'S LAW DICTIONARY 1081 (7th ed. 2000).

109. See *United States v. Am. Bell Tel. Co.*, 128 U.S. 315, 360 (1888).

110. *In re Lockwood*, 50 F.3d 966, 974 n.9 (Fed. Cir. 1995), *vacated*, 515 U.S. 1182 (1995). Nevertheless, the *Lockwood* court concluded that a writ of *scire facias* was tried at law, and would therefore support the right to trial by jury if it had been the closest eighteenth-century analog under the historical test. *Id.*

lidity sought by Gennum.¹¹¹ Noting that a determination of invalidity inherently requires an “adjudication of legal rights,” she concluded that an invalidity declaratory judgment action¹¹² supported the right to trial by jury.¹¹³

Both the majority and Judge Newman also looked at precedent.¹¹⁴ The majority only identified three district court cases and one Ninth Circuit case supporting its conclusion.¹¹⁵ Conversely, Judge Newman presented nearly twenty cases showing that “jury trials of issues of patent validity appear from the early days of the nation’s jurisprudence,” and that, contrary to the majority’s conclusion, “the reported cases rais[ed] no issue of entitlement to a jury depending on the remedy for infringement.”¹¹⁶ Although Judge Newman conceded that “most but not all cases mention[ed] damages as a remedy,”¹¹⁷ the majority noted that *all* of the cases she actually did cite involved infringement actions seeking damages.¹¹⁸

IV. APPLYING THE *MARKMAN* ANALYSIS TO *TECHNOLOGY LICENSING*

Although the Federal Circuit majority properly began its analysis by employing the two-pronged historical-analog test of *Tull* and looking at precedent, it arrived at the wrong conclusion. The historical record strongly suggests that a proper application of the historical-analog test would guarantee the right to jury trial in invalidity suits. At a minimum, the historical-analog test fails to show with sufficient clarity that invalidity suits do *not* support the right to jury trial, as was the case when the Supreme Court applied the test to claim construction in *Markman II*. Moreover, precedent

111. See *Technology Licensing*, 423 F.3d at 1292 (Newman, J., dissenting) (“Jury trial of Gennum’s claim of invalidity is available as of right, whatever the requested remedy for infringement.”).

112. Judge Newman also seems to support the view that a *counterclaim* of invalidity would support the right to trial by jury. See *id.* at 1296 (distinguishing *Tegal* by noting that “invalidity was raised as a defense, not as a claim or counterclaim” (emphasis added)).

113. *Id.* at 1292. The Supreme Court established that the “adjudication of legal rights” gives rise to the right to jury trial in *Parsons v. Bedford*. See 28 U.S. (3 Pet.) 433, 447 (1830) (explaining that for purposes of the Seventh Amendment, “suits at common law” refers to “suits in which legal rights were to be ascertained and determined, in contradistinction to those where equitable rights alone were recognized, and equitable remedies were administered”). The legal rights to be adjudicated in a patent invalidity suit include, of course, the patentee’s property rights in the patent.

114. See *Technology Licensing*, 423 F.3d at 1291; *id.* at 1293–94 (Newman, J., dissenting).

115. See *id.* at 1291 (majority opinion) (citing *Shubin v. U.S. Dist. Court*, 313 F.2d 250 (9th Cir. 1963); *Kao Corp. v. Unilever U.S., Inc.*, No. 01-680-SLR, 2003 U.S. Dist. LEXIS 6677 (D. Del. Apr. 17, 2003); *Glaxo Group Ltd. v. Apotex, Inc.*, No. 00 C 5791, 2001 U.S. Dist. LEXIS 16873 (N.D. Ill. Oct. 12, 2001); *Pfizer Inc. v. Novopharm Ltd.*, No. 00 C 1475, 2001 U.S. Dist. LEXIS 7171 (N.D. Ill. May 2, 2001)).

116. *Id.* at 1293–94 (Newman, J., dissenting).

117. *Id.* at 1294.

118. *Id.* at 1290 n.2 (majority opinion).

provides even less guidance on the right to jury trial for invalidity claims than it did on the right to jury trial in the context of claim construction. Therefore, the Federal Circuit should have either (a) held that, based on the historical-analog test, the right to jury trial attaches to declaratory judgment actions for patent invalidity; or (b) declared the historical-analog test and precedent inconclusive, and followed the lead of the Supreme Court in *Markman II* by analyzing functional considerations and policy concerns. Whereas functional considerations may indicate that claim construction is better left to the judge, the determination of patent invalidity is almost invariably highly fact-intensive and should be the province of the jury. Moreover, the policy concerns of uniformity and certainty invoked in *Markman II* do not control where patent validity is at stake. Rather, efficiency and fairness concerns suggest that the right to jury trial should be maintained in all declaratory judgment actions for patent invalidity, regardless of the type of remedy sought by the patentee.

A. Historical-Analog Test and Precedent

The historical record strongly suggests that, under the *Tull* test, the most appropriate historical analog of a declaratory judgment action for patent invalidity is the writ of *scire facias*, rather than the inverted form of the declaratory judgment action endorsed by most members of the Federal Circuit. Moreover, case law fails to provide significant support for the majority's conclusion in *Technology Licensing*.

1. Writ of Scire Facias

To determine the outcome of the historical-analog test as it relates to the writ of *scire facias*, two issues must be resolved. First, one must determine whether the writ was broadly used to invalidate patents in 1791 or was instead only used more narrowly to invalidate patents for fraud. If the writ was used more broadly to invalidate patents, then it clearly provides a close historical analog to declaratory judgment actions for patent invalidity;¹¹⁹ conversely, if the writ was only used to invalidate patents for fraud, then it is perhaps more analogous to a declaratory judgment for unenforceability due to inequitable conduct.¹²⁰ Second, if the writ of *scire facias* is

119. Note that, if the writ of *scire facias* was used more broadly to invalidate patents, it would satisfy both prongs of the historical-analog test because it would (1) closely resemble the form of the invalidity declaratory judgment action, and (2) provide the same remedy as the invalidity declaratory judgment action (i.e., invalidate the patent).

120. See *In re Lockwood*, 50 F.3d 966, 974 n.9 (Fed. Cir. 1995) (concluding that the writ of *scire facias* "was used to attack fraudulently obtained patents," and that "[t]he contemporary analog of the writ is thus an action for a declaration of unenforceability due to inequitable conduct, not due to invalid-

indeed the closest historical analog, one must also determine whether the *scire facias* action was a suit at common law, or was tried in courts of equity, in 1791. If one concludes that it was a suit at common law, then the first prong of the historical-analog test dictates that the right to jury trial should attach to declaratory judgment actions for patent invalidity.¹²¹

The majority in *Lockwood*, in an analysis endorsed by the majority in *Technology Licensing*, found dispositive case law suggesting that the writ of *scire facias* had been used only to invalidate patents obtained by fraud.¹²² The *Lockwood* majority had largely relied on *Ex parte Wood & Brundage*, where the Supreme Court had stated that the writ of *scire facias* was issued at common law in order “to repeal patents which have been obtained surreptitiously, or upon false suggestion.”¹²³ But although the *Lockwood* majority concluded that *scire facias* was not the appropriate historical analog, it also concluded that the writ “was, with respect to the factual issues raised therein, a legal, rather than an equitable, affair, thereby entitling the parties to a jury as of right.”¹²⁴

In her dissent from an order in *Lockwood* denying rehearing *en banc*, Judge Nies (joined by Judges Archer and Plager) drew the exact opposite conclusion.¹²⁵ Judge Nies noted that “fraud” was “only one of the three situations in which a writ of *scire facias* was grantable,” with the other two situations being where “[a] previous patent had issued on the invention,” and where there was an “[u]nlawful grant” of the patent.¹²⁶ Therefore, unlike the majority, Judge Nies determined that the writ of *scire facias* was indeed the closest historical analog to a declaratory judgment action for patent invalidity. But Judge Nies also disagreed with the majority’s conclusion that the writ of *scire facias* was tried in courts of law, stating that the

ity”), *vacated*, 515 U.S. 1182 (1995). More recently, however, a Federal Circuit panel (with Judges Rader and Lourie in the majority and Judge Newman dissenting) declined to hold that the writ was the appropriate historical analog even where a party seeks a declaration of unenforceability due to inequitable conduct. See *Agfa Corp. v. Creo Prods., Inc.*, 451 F.3d 1366 (Fed. Cir. 2006). In *Agfa*, Judge Rader rather strangely concluded that while *Lockwood* “is easy to misread for the proposition that a writ of *scire facias* is the historic analog of inequitable conduct,” the *Lockwood* court had merely been observing that inequitable conduct might provide an example of a modern action that is similar to the writ. *Id.* at 1373–74.

121. Arguably, this reasoning could also support the right to jury trial in cases with counterclaims, or possibly even defenses, of patent invalidity, rather than just declaratory judgment actions.

122. *Lockwood*, 50 F.3d at 974 n.9.

123. *Id.* (quoting *Ex parte Wood & Brundage*, 22 U.S. (9 Wheat.) 603, 609 (1824)).

124. *Id.* at 975 n.9. The court noted that the writ was tried in the court of chancery, which “exercised both legal and equitable powers,” and that “in a *scire facias* raising genuine issues of material fact, the proceeding in chancery was suspended pending a determination by a jury summoned in the Court of King’s Bench, the main law court.” *Id.* at 974–75 n.9.

125. *Id.* at 985 (Nies, J., dissenting).

126. *Id.*

action was instead tried in courts of equity which “[f]requently . . . decided the facts respecting validity themselves or treated juries as advisory, merely to inform the conscience of the court.”¹²⁷ Accordingly, Judge Nies concluded that the historical-analog test did not support the right to trial by jury.¹²⁸

In her dissent in *Technology Licensing*, Judge Newman arrived at yet a different conclusion. Like Judges Nies, Archer, and Plager, Judge Newman determined that the writ of *scire facias* was the closest historical analog to patent invalidity claims.¹²⁹ But unlike Judges Nies, Archer, and Plager—and in agreement with the *Lockwood* majority—Judge Newman determined that the *scire facias* action was legal rather than equitable in nature.¹³⁰ Having found that the writ of *scire facias* applied to invalidity suits beyond mere fraud and that the action was legal in nature, Judge Newman concluded that the historical-analog test supported the right to jury trial in patent invalidity suits.¹³¹

The historical record largely supports Judge Newman’s analysis. In her lengthy dissent in *Markman I*, Judge Newman identified early English case law indicating that the writ of *scire facias* was used to invalidate patents on grounds beyond mere fraud.¹³² For example, writs of *scire facias* were filed to revoke patents based on lack of novelty in both *Rex v. Arkwright*¹³³ and *Rex v. Else*.¹³⁴ Moreover, numerous early- to mid-nineteenth-century English treatises cite other examples of seventeenth- and eighteenth-century case law that established the broader scope of the writ.¹³⁵

127. *Id.*

128. *Id.*

129. *In re Tech. Licensing Corp.*, 423 F.3d 1286, 1292 (Fed. Cir. 2005) (Newman, J., dissenting).

130. *Id.* (“Patent validity was a common law action tried to a jury in Eighteenth Century England.”).

131. *See id.* at 1296 (“The panel majority’s conclusion—that a suit to revoke or invalidate a patent on grounds other than fraud could not be brought in England and was not triable to a jury—is directly contrary to English and succeeding American precedent applying Seventh Amendment principles.”). The *Technology Licensing* majority argues that Judge Newman’s dissent ignores “*Lockwood*’s clear ruling that the writ of *scire facias* . . . is not analogous to the modern-day action to invalidate a patent.” *Id.* at 1290 n.2 (majority opinion). But given that *Lockwood* was vacated by the Supreme Court in *American Airlines, Inc. v. Lockwood*, 515 U.S. 1182 (1995), its “ruling” can hardly be treated as binding precedent.

132. *Markman v. Westview Instruments, Inc. (Markman I)*, 52 F.3d 967, 1013–15 (Fed. Cir. 1995) (Newman, J., dissenting).

133. 1 Carp. P.C. 53, 101 (K.B. 1785) (“[I]f . . . you are satisfied none of [the machine’s components] were inventions unknown at the time this patent was granted, or that they were not invented by the defendant; upon either of these points the prosecutor is entitled to your verdict.”).

134. 1 Carp. P.C. 103 (K.B. 1785) (involving a writ of *scire facias* filed to repeal patent where there was no new invention).

135. *See, e.g.*, JOSEPH CHITTY, A TREATISE ON THE LAW OF THE PREROGATIVES OF THE CROWN; AND THE RELATIVE DUTIES AND RIGHTS OF THE SUBJECT 331 (London, Joseph Butterworth & Son 1820) (“[I]n such case the party prejudiced may . . . have a *scire facias* to repeal [the patent], as well as

Why then, one might ask, do many sources—such as those identified by the majority in *Lockwood*¹³⁶—state that the writ of *scire facias* was only used to invalidate patents based on fraud? The likely answer to this question becomes apparent when considering the process by which inventors had obtained their patents in England:

The Attorney-general, or officer who advises the Crown, must in every case in which the grant of a patent is not opposed, rely solely on the statements of the person petitioning for the patent, and no one can be present on behalf of the public to controvert any of the statements he may make in support of his claim for a patent. Even in opposed cases the party opposing can obtain no information respecting the nature of the invention for which a patent is sought, except what he may acquire from the title of the invention inserted in the petition

. . . .

. . . The law, therefore, takes especial care to protect the Crown against false petitions and representations. It is accordingly laid down that it is the duty of every one obtaining a grant from the Queen, to see that she is correctly informed respecting the grant. . . . And *when facts are recited in a patent respecting the subject-matter of the grant, it will be presumed that the statements contained in the recital were represented or suggested to the Queen by the patentee.*

The material particulars respecting an alleged invention for which a party seeks to obtain a patent, must . . . be stated in the petition for the patent. *The petition must therefore state, that the petitioner is the inven-*

the King; as in the instance of an unfounded patent for an invention, or where the specification is incorrect." (footnotes omitted)); FOSTER, *supra* note 108, at 242, 245–46 ("Every such grant by letters patent of the sole right to make, use, exercise, and vend any invention, is void, if the invention was 'not invented or found out' by the grantee, or first introduced into the kingdom by him; and also if the invention is not new, and useful to the public. It is also void for uncertainty, or for being too general; for misrecitals; for false suggestions, by which the Queen has been deceived or misinformed in her grant, or where she has granted more than she lawfully may, or what may be to the prejudice of the commonwealth, or to the general injury of the people; or where she has granted the same thing to two persons. . . . If a patent be void for any of the reasons which have been briefly assigned, as sufficient to invalidate the grant, the Queen . . . may have a *scire facias* to repeal her own grant. A *scire facias* is the only means which the law provides for the repealing of letters patent The subject also who is prejudiced by a grant may of right petition the Queen for leave to use her name in a writ of *scire facias* for its repeal." (footnotes omitted)); RICHARD GODSON, A PRACTICAL TREATISE ON THE LAW OF PATENTS FOR INVENTIONS AND OF COPYRIGHT; WITH AN INTRODUCTORY BOOK ON MONOPOLIES; ILLUSTRATED WITH NOTES OF THE PRINCIPAL CASES 195–96 (London, Joseph Butterworth & Son 1823) ("[T]he grant is invalid when the patentee is not the *inventor*, when its *object* is not a manufacture, and when the *specification* is not sufficiently correct Upon these grounds letters patent are voidable in themselves, but cannot be treated as of no effect in law until they are cancelled by the legal process of a writ of *scire facias* . . ." (footnotes omitted)); W.M. HINDMARCH, A TREATISE ON THE LAW RELATING TO PATENT PRIVILEGES FOR THE SOLE USE OF INVENTIONS; AND THE PRACTICE OF OBTAINING LETTERS PATENTS FOR INVENTIONS; WITH AN APPENDIX OF STATUTES, RULES, FORMS 378 (London, V. & R. Stevens & G. S. Norton & W. Benning & Co. 1846) ("[T]he law provides a remedy for the public by action of *scire facias*, . . . and if *any* valid objection is sustained, the result is, that the patent is repealed or annulled, and ordered to be cancelled." (emphasis added)).

136. See, e.g., *Ex parte Wood & Brundage*, 22 U.S. (9 Wheat.) 603, 609 (1824) (stating *scire facias* is used "to repeal patents which have been obtained surreptitiously, or upon false suggestions").

tor or importer of the invention, and that the invention possesses the qualities of novelty, utility, & c., so as to be the proper subject of a grant by patent. The substance of the petition for a patent is always recited in the patent itself, and therefore the patent itself shows upon what representations of the patentee it has been granted; and if the patentee has represented any thing which was untrue in any material particular, or has induced the Crown to make an illegal grant, the patent is entirely void.¹³⁷

Clearly, then, the concept of “fraud” could have an extremely broad meaning with respect to patent validity. Because patentability requirements such as novelty and utility were satisfied solely by the patentee’s representations to the Queen or King, any later finding of a lack of novelty or utility would have to be construed as a misrepresentation—or fraud—perpetrated by the patentee on the Crown. “Fraud,” therefore, could refer to invalidity based on virtually any grounds. As a result, the writ of *scire facias* provides a close historical analog to all modern invalidity actions, rather than just actions for unenforceability due to inequitable conduct.

The historical record also supports Judge Newman’s conclusion (shared by the *Lockwood* majority) that the writ of *scire facias* was legal rather than equitable in nature. The writ of *scire facias* issued out of the Petty Bag Office of Chancery, where “all the common-law proceedings of the Court are carried on.”¹³⁸ Moreover, while legal issues arising from demurrer may have been tried in Chancery in the late eighteenth century, remaining issues of fact were sent to the Court of King’s Bench to be tried by a jury.¹³⁹ Therefore, the writ of *scire facias* was at least partly legal rather than equitable in nature, with the factual issues of invalidity tried by

137. HINDMARCH, *supra* note 135, at 377–78 (emphasis added) (footnotes omitted).

138. FOSTER, *supra* note 108, at 248. “In the chancery are two courts, one ordinary, . . . [a]nother extraordinary according to the rule of equity . . .” EDUARDO COKE, *THE FOURTH PART OF THE INSTITUTES OF THE LAWS OF ENGLAND; CONCERNING THE JURISDICTION OF COURTS* 79 (London, W. Clark & Sons 1817). “The process[] in [the ordinary] court is under the great seal according to the court[] of the common law.” *Id.* at 82.

139. See COKE, *supra* note 138, at 79 (stating that if, in a *scire facias* action, “the parties descend to issue, [Chancery] cannot try it by jury, but the lord chancelour or lord keeper delivereth the record by his proper hands into the kings bench to be tried there . . .”); FOSTER, *supra* note 108, at 262 (“[I]f there were a demurrer to part, and issue on facts as to the residue, the demurrer might be determined in Chancery, a transcript of the record containing the issue in fact, being sent into the Court of Queen’s Bench to be tried. . . . Formerly, the practice was, if there were a demurrer to part and an issue on the residue, for the Chancellor to deliver . . . a transcript of the whole record to the Court of Queen’s Bench, and judgment was given there, upon the demurrer as well as upon the issue . . .” (footnotes omitted)); HINDMARCH, *supra* note 135, at 401–03 (“When there are any issues to be tried, except those which must be tried by a jury, the trial may take place in the Court of Chancery. Thus, an issue in law raised by a demurrer may be decided by the Lord Chancellor An issue cannot be tried by a jury in Chancery, for that Court has no authority to call a jury to its bar. But when there is any issue joined in an action in that Court, which must be tried by a jury, the Court awards a *venire facias* to the sheriff returnable in the Queen’s Bench The record is then to be taken into the Queen’s Bench in order that the issues may be there tried.” (footnotes omitted)).

a jury. Accordingly, the historical-analog test dictates that the right to jury trial should attach to declaratory judgment actions for patent invalidity.

2. Inverted Form of Declaratory Judgment Action

Even if one were to conclude that, despite the weight of historical evidence, the writ of *scire facias* does not provide a sufficiently close historical analog to a declaratory judgment action for patent invalidity, the “inverted form” of the declaratory judgment action would hardly provide a satisfying candidate either. By viewing the inverted form as the appropriate analog, the court considers only the remedy sought by the patentee while completely ignoring the remedy sought by the claimant, and therefore disregards the nature of the action as a whole.

The Federal Circuit first held that the inverted form of the declaratory judgment action for invalidity constitutes the appropriate historical analog in *Lockwood*.¹⁴⁰ The *Lockwood* majority cited a host of law review articles advocating the “inverted lawsuit” approach when applying the historical-analog test to declaratory judgment actions in general,¹⁴¹ and also cited two treatises meant to support the more specific proposition that the inverted lawsuit approach should be used for declaratory judgment actions for patent invalidity.¹⁴² The law review articles, however, lack any strong persuasive value because they do not specifically address patent invalidity actions. Moreover, neither of the cited treatises expressly advocates the inverted lawsuit analysis for patent invalidity suits; instead, they primarily point out only that the issues to be tried in a patent invalidity declaratory judgment action are the same as the issues that would arise when an infringement suit is brought and the defendant raises a defense or counterclaim of invalidity.¹⁴³

The *Lockwood* majority also attempted to support its conclusion by citing several cases in which the court used the inverted lawsuit approach

140. See *In re Lockwood*, 50 F.3d 966, 974 n.9 (Fed. Cir. 1995) (“In other words, ‘our search . . . for a single historical analog, taking into consideration the nature of the cause and the remedy as two important factors,’ has produced one satisfactory analog—namely, a suit for patent infringement in which the affirmative defense of invalidity has been pled.” (quoting *Tull v. United States*, 481 U.S. 412, 422 n.6 (1987))), *vacated*, 515 U.S. 1182 (1995).

141. *Id.* at 975 n.11.

142. *Id.* at 975 n.10.

143. See *id.* (quoting Donald S. Chisum’s *Patents* treatise for the proposition that a “suit for declaratory judgment of invalidity ‘is in substance an infringement suit with the parties initially reversed,’” and *Moore’s Federal Practice* treatise for the proposition that “[a] declaratory action brought by the accused infringer is for the purpose of securing a judicial determination of plaintiff’s immunity from the operation of the patent laws—not to assert rights provided by those laws,” and that “[t]he issues sought to be adjudicated are precisely the same as in an infringement suit[.]” (alteration in original)).

to determine whether the right to jury trial attached to declaratory judgment actions.¹⁴⁴ None of the cited cases, however, dealt specifically with actions seeking declarations of patent invalidity, and they did not broadly hold that the inverted form of the action should *always* dictate the availability of the right to jury trial. Rather, the cases support the narrower proposition that the inverted form is the appropriate analog *if* the declaratory judgment action is “merely an inverted lawsuit.”¹⁴⁵

The Supreme Court, however, clearly established that a declaratory judgment action for patent invalidity is *not* merely an inverted lawsuit. In *Cardinal Chemical Co. v. Morton International, Inc.*, the Court reviewed and rejected the Federal Circuit’s “practice of routinely vacating declaratory judgments regarding patent validity following a determination of non-infringement.”¹⁴⁶ The Federal Circuit had justified this practice under the constitutional justiciability doctrine of mootness: if the party seeking a declaratory judgment of invalidity could not “illustrate . . . the continued existence of a case or controversy should a decision of noninfringement be made,” then the declaratory judgment action *must* be vacated.¹⁴⁷ The Supreme Court, however, held that it is instead the burden of the party suggesting mootness to “com[e] forward with the subsequent events” that suggest there is no longer a case or controversy.¹⁴⁸ If no party comes forward to advise the appellate court “of a material change in circumstances that entirely terminate[s] the party’s controversy,” then the court retains jurisdiction over the declaratory judgment action.¹⁴⁹

In addition to concluding that the Federal Circuit was not constitutionally *required* to vacate judgments of validity or invalidity in all cases where judgments of noninfringement were affirmed, the Supreme Court in *Cardinal* identified policy concerns suggesting that the Federal Circuit should not continue its practice even as a prudential matter.¹⁵⁰ Those policy concerns included “the importance to the public at large of resolving questions of patent validity[,] . . . the wasteful consequences of relitigating the valid-

144. See *id.* at 975 (citing *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 504 (1959); *Owens-Illinois, Inc. v. Lake Shore Land Co.*, 610 F.2d 1185, 1189 (3d Cir. 1979); *James v. Pennsylvania Gen. Ins. Co.*, 349 F.2d 228, 230 (D.C. Cir. 1965); *Johnson v. Fid. & Cas. Co.*, 238 F.2d 322, 324–25 (8th Cir. 1956); *Hargrove v. Am. Cent. Ins. Co.*, 125 F.2d 225, 228 (10th Cir. 1942); *Pacific Indem. Co. v. McDonald*, 107 F.2d 446, 448 (9th Cir. 1939)).

145. *James*, 349 F.2d at 230.

146. 508 U.S. 83, 89 (1993). According to the Court in *Cardinal*, this practice began in 1987 when the Federal Circuit decided *Vieau v. Japax, Inc.*, 823 F.2d 1510 (Fed. Cir. 1987). *Cardinal*, 508 U.S. at 89.

147. *Vieau*, 823 F.2d at 1520.

148. *Cardinal*, 508 U.S. at 98.

149. See *id.*

150. See *id.* at 99–102.

ity of a patent after it has once been held invalid in a fair trial, . . . the danger that the opportunity to relitigate might, as a practical matter, grant monopoly privileges to the holders of invalid patents,” and the unfairness of “depriv[ing] the patentee . . . of the appellate review that is a component of the one full and fair opportunity to have the validity issue adjudicated correctly.”¹⁵¹

In terms of its relevance to the historical-analog test, the crux of the Supreme Court’s holding in *Cardinal* is that “[a] party seeking a declaratory judgment of invalidity presents a claim independent of the patentee’s charge of infringement.”¹⁵² This directly refutes the notion that a declaratory judgment action seeking invalidity is nothing more than an inverted form of an infringement lawsuit. Judge Nies recognized this as well in her *Lockwood* dissent, where she noted that the inverse of an infringement suit would not be a declaratory judgment action for *invalidity*, but rather for *noninfringement*.¹⁵³

By merely looking at the inverted form of the action, the Federal Circuit in *Technology Licensing* disregarded the much broader scope of the invalidity claim.¹⁵⁴ The inverted form of the action reduces the analog to a simple infringement action, where the only remedy considered is that sought by the patentee: a judgment for damages or injunction. Completely lost in such an analysis is the remedy sought by the party bringing the declaratory judgment action: a judgment of patent invalidity. As noted by Judge Newman, this latter remedy clearly requires an “adjudication of legal rights,”¹⁵⁵ which the Supreme Court has long held to be grounds for the right to trial by jury.¹⁵⁶

151. *Id.* at 100–02.

152. *Id.* at 96.

153. *In re Lockwood*, 50 F.3d 966, 986 n.12 (Fed. Cir. 1995) (Nies, J., dissenting), *vacated*, 515 U.S. 1182 (1995). Conversely, the inverse of a declaratory judgment action for invalidity would be a patentee’s suit for a declaration of patent validity—a type of action which does not exist.

154. The court in *Lockwood* did, however, address the Supreme Court’s *Cardinal* decision. *See id.* at 975 n.10 (majority opinion). The court attempted to defend its conclusion that an invalidity declaratory judgment action is merely the inverted form of an infringement action by quoting language in *Cardinal* that acknowledged the relationship between the two: “If . . . a party has actually been charged with infringement of the patent, there is, *necessarily*, a case or controversy adequate to support jurisdiction of a complaint, or a counterclaim, under the [Declaratory Judgments] Act.” *Id.* (quoting *Cardinal*, 508 U.S. at 96) (alteration in original). That relationship, however, hardly establishes that the invalidity declaratory judgment action is nothing more than an inversion of an infringement suit.

155. *In re Tech. Licensing Corp.*, 423 F.3d 1286, 1292 (Fed. Cir. 2005) (Newman, J., dissenting).

156. *See supra* note 113.

3. Precedent

Even if one disputes the notion that the historical-analog test conclusively supports the right to jury trial in declaratory judgment actions for patent invalidity, the results should, at a minimum, be declared uncertain—less certain, surely, than the results of the same test as applied in *Markman II*. In *Markman II*, after all, the Supreme Court did not seem to doubt that the construction of specifications was the closest historical analog; nonetheless, the Court declared the test inconclusive and proceeded to look at precedent.¹⁵⁷ But as in *Markman II*, precedent also fails to provide sufficient guidance. The case law set forth by the *Technology Licensing* majority is far less authoritative than the precedent considered by the Court in *Markman II*. As noted earlier, the majority in *Technology Licensing* only offers three district court cases and one Ninth Circuit case supporting its application of the historical-analog test.¹⁵⁸ Conversely, in *Markman II*, earlier Supreme Court case law was identified supporting the view that specification construction was the province of the judge and not the jury.¹⁵⁹

Despite having built a relatively strong case for holding that the historical-analog test and precedent were dispositive, however, the Court in *Markman II* merely concluded that they “provide[d] no clear answers” as to whether the right to jury trial should attach to claim construction.¹⁶⁰ In refusing to deny the right to trial by jury based solely on its application of the historical-analog test and precedent, the Supreme Court seems to have recognized that the presumption should not be *against* trial by jury where the answer is not exceptionally clear. Instead, the Court held true to the principle that the right to jury trial in civil cases should be “jealously guarded.”¹⁶¹ The Federal Circuit in *Technology Licensing*—given its highly questionable conclusion that the writ of *scire facias* is not the appropriate historical analog to the declaratory judgment action for patent invalidity—should have at least followed the Supreme Court’s example by proceeding to look at functional considerations and policy concerns.

157. *Markman v. Westview Instruments, Inc. (Markman II)*, 517 U.S. 370, 384 (1996).

158. See *supra* note 115.

159. See *supra* note 40. Admittedly, the case law cited by Judge Newman in *Technology Licensing* also fails to provide any clear answers, because, as the majority noted, none of the cited cases involved invalidity claims where the patentee sought only equitable relief. *Technology Licensing*, 423 F.3d at 1290 n.2. Unlike the historical-analog test, then, precedent provides no strong support for either position.

160. *Markman II*, 517 U.S. at 388.

161. *Jacob v. New York City*, 315 U.S. 752, 752–53 (1942).

B. Functional Considerations

Patent claims can be found invalid for a variety of reasons, including lack of novelty (anticipation), obviousness, inadequate disclosure (i.e., failure to meet the written description, enablement, best mode, or definiteness requirements), ineligible subject matter, or lack of utility.¹⁶² Most of these grounds for invalidity are very likely to involve issues that are highly fact-intensive, and many are likely to require credibility assessments—judgments of the sort traditionally considered to be squarely within the jury's forte.¹⁶³

Anticipation, for example, requires the fact-finder to identify the relevant prior art as defined by 35 U.S.C. § 102.¹⁶⁴ Identifying the prior art requires geographical determinations, such as whether an activity took place in the United States,¹⁶⁵ and temporal determinations, such as which person was the first to invent¹⁶⁶ or what date an invention first became publicly accessible.¹⁶⁷ Some examples of the many other potential fact questions involved in identifying the prior art can include whether the use of an invention was secret or public;¹⁶⁸ whether an invention was abandoned, suppressed, or concealed;¹⁶⁹ and whether a commercial offer for sale was made.¹⁷⁰ Credibility judgments can be very important for each of these issues, and, unlike the construction of legal documents, the issues require no special legal expertise on the part of jurors.

162. MUELLER, *supra* note 5, at 297–98.

163. See *Markman II*, 517 U.S. at 389–90 (recognizing the “jury’s capabilities to evaluate demeanor, to sense the ‘mainsprings of human conduct,’ or to reflect community standards” (citations omitted)). Even some who are rather cynical of jurors’ competence in patent cases recognize that the jury does have strengths that may be utilized. For example, although Judge Michel of the Federal Circuit remarked that jurors have “too hard a job, one which they cannot do very well,” he also advocated defining a role for juries in areas where they “can do . . . things best—things like assessing credibility.” Michel, *supra* note 13.

164. See MUELLER, *supra* note 5, at 94 (“If a patent, journal article, or other document [does not] qualify under some subsection of 35 U.S.C. § 102. . . . then [it] is not legally available for use as prior art to negate the presumed novelty of the applicant’s claimed invention.”).

165. See, e.g., 35 U.S.C. § 102(a) (2000) (invalidating a patent claim if invalidating knowledge or use occurred “in this country”).

166. See, e.g., *id.* § 102(g)(2) (invalidating a patent claim if “before [the patentee’s] invention . . . the invention was made in this country by another inventor”).

167. See, e.g., *id.* § 102(a) (invalidating a patent claim if the “invention was known or used by others . . . before the invention thereof by the applicant for patent”).

168. See, e.g., *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983) (holding that a secret, non-informing use by a third party cannot invalidate a patent claim under 35 U.S.C. § 102(b)).

169. See 35 U.S.C. § 102(g)(2) (preventing the invalidation of a patent claim if another’s otherwise invalidating invention was “abandoned, suppressed, or concealed”).

170. See *id.* § 102(b) (invalidating a patent claim if “invention was . . . on sale in this country, more than one year prior” to the U.S. application date).

Moreover, after ascertaining the prior art's content and scope, the fact-finder must decide whether there is identity between any single piece of prior art and the claimed invention.¹⁷¹ Identity is—and has long been—a question of fact for the jury. In *Bischoff v. Wethered*, for example, “the [Supreme] Court drew a line between issues of document interpretation and product identification, and held that expert testimony was properly presented to the jury on the latter, ultimate issue”¹⁷² Similarly, in *Keyes v. Grant*, the Court stated that identity between an asserted patent and a prior-art publication “was a question of fact properly to be left for determination to the jury.”¹⁷³

Nonobviousness raises many of the same factual issues as anticipation when determining the scope and content of the prior art.¹⁷⁴ Other factual issues inherent in the ultimate question of obviousness include whether prior art qualifies as “analogous art,”¹⁷⁵ determining the differences between the prior art and the invention (similar to the task of determining identity),¹⁷⁶ and determining whether “secondary indicia” indicate that the changes made by the patentee over the prior art were obvious.¹⁷⁷ The secondary indicia alone involve a large number of factual considerations.¹⁷⁸

Some of the disclosure requirements can also be very fact-intensive. For example, a patent specification must “enable any person skilled in the art to which it pertains . . . to make and use” the invention.¹⁷⁹ Although

171. See MUELLER, *supra* note 5, at 97 (“[I]n order to evidence anticipation of a claimed invention under 35 U.S.C. § 102, a single prior art reference must disclose every element of that invention, arranged as in the claim.”).

172. *Markman v. Westview Instruments, Inc. (Markman II)*, 517 U.S. 370, 386 (1996) (discussing *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812 (1870)).

173. 118 U.S. 25, 37 (1886).

174. See MUELLER, *supra* note 5, at 140 (“[Case law and legislative history] sources make clear that 35 U.S.C. § 102, the statutory provision that governs novelty and loss of right, is key to determining the scope of the prior art available in [an obviousness] analysis under § 103.” (footnote omitted)).

175. In an obviousness analysis, a court cannot consider references in fields of art that are “too remote to be treated as prior art.” *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992) (quoting *In re Sovish*, 769 F.2d 738, 741 (Fed. Cir. 1985)). An art is “too remote” (i.e., non-analogous) if it is neither (1) “within the field of the inventor’s endeavor”; nor (2) “reasonably pertinent to the particular problem with which the inventor was involved.” *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986) (quoting *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979)).

176. MUELLER, *supra* note 5, at 146–47.

177. See *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966) (“[S]econdary considerations . . . might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.”).

178. Some secondary indicia of nonobviousness include considerations such as commercial success, long-felt but unsolved needs, failure of others, and unexpected results. *Id.* at 17; *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1380 (Fed. Cir. 1986).

179. 35 U.S.C. § 112 (2000).

enablement is ultimately a question of law,¹⁸⁰ it can depend on many underlying facts, such as the factual issues raised by the requirement that a person skilled in the art be able to make and use the described invention without “undue experimentation”:

Factors to be considered in determining whether a disclosure would require undue experimentation . . . include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.¹⁸¹

Moreover, a patent specification must “set forth the best mode contemplated by the inventor of carrying out his invention.”¹⁸² As with enablement, the “best mode” requirement is fact-intensive:

Determining whether a patent complies with the best mode requirement involves two underlying factual inquiries. First, it must be determined whether, at the time the patent application was filed, the inventor had a best mode of practicing the claimed invention. This inquiry is wholly subjective and addresses whether the inventor must disclose any facts in addition to those sufficient for enablement. Second, if the inventor had a best mode of practicing the claimed invention, it must be determined whether the specification adequately disclosed what the inventor contemplated as the best mode so that those having ordinary skill in the art could practice it.¹⁸³

For the first part of that analysis, a fact-finder would need to determine the inventor’s subjective knowledge. Because “[t]he state of a person’s mind is rarely susceptible to proof by direct evidence, and usually must be inferred from evidence of his or her acts,” the inquiry is “one especially suited for resolution by a trial jury.”¹⁸⁴

Unlike the issue of claim construction that the Supreme Court considered in *Markman II*, then, many of the issues inherent in determinations of patent validity are entirely factual. Whereas claim construction requires the interpretation of a legal document, common validity issues such as novelty and nonobviousness require an assessment of whether a patented invention already existed historically. While the former has traditionally been considered to be, for the most part, a matter of law,¹⁸⁵ the latter constitutes a quin-

180. *In re Wands*, 858 F.2d 731, 735 (Fed. Cir. 1988).

181. *Id.* at 737.

182. 35 U.S.C. § 112.

183. *U.S. Gypsum Co. v. Nat’l Gypsum Co.*, 74 F.3d 1209, 1212 (Fed. Cir. 1996) (citations omitted).

184. *United States v. Crowley*, 318 F.3d 401, 409 (2d Cir. 2003).

185. *See Markman v. Westview Instruments, Inc. (Markman I)*, 52 F.3d 967, 984 (Fed. Cir. 1995) (“Traditionally courts have treated the construction of [documents such as contracts, deeds, and wills]

tessential fact question. Therefore, unlike in *Markman II*, functional considerations strongly support the preservation of patent validity as a jury question.¹⁸⁶

C. Policy Concerns

The Supreme Court in *Markman II* saw “the importance in uniformity” as an additional, independent reason to assign the issue of claim construction to the judge rather than the jury.¹⁸⁷ The Court’s emphasis on uniformity reflected its broader concern with certainty: “[T]he limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public.”¹⁸⁸ The Court’s logic, however, does not extend to the issue of patent validity.

The public’s certainty regarding the validity of a patent claim is, of course, at least as important as the precise meaning of the claim’s language. Patent law, however, already provides a great deal of certainty in this area: once a patent claim has been adjudicated and held invalid, collateral estoppel bars the patentee from asserting that patent claim against anyone in the future.¹⁸⁹ Thus, the public can rest assured that, with rare exceptions,¹⁹⁰ an invalidated patent claim will remain invalid. The policy concerns supporting the Court’s decision in *Markman II* therefore play no significant role with regard to the right to jury trial in invalidity claims.

Other concerns, implicating fairness to the patentee and judicial efficiency, weigh in favor of preserving the patentee’s right to jury trial in

as being a legal question for the court, but have stated that under certain circumstances the interpretation of an agreement may raise jury triable questions.”).

186. Of course, some argue that, due to the complexity of the subject matter in many patent disputes, the role of the jury should be minimized or eliminated in *all* patent cases. See *supra* note 2. That much broader argument is not addressed here, however, other than to repeat the Federal Circuit’s statement that, “[s]o long as the Seventh Amendment stands, the right to a jury trial should not be rationed, nor should particular issues in particular types of cases be treated differently from similar issues in other types of cases.” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1547 (Fed. Cir. 1983). The court in *Connell* also noted that any complications arising from the requirement that jurors put themselves “in the shoes of one ‘skilled in the art’ at the time the invention was made” are little different than the complications arising in a negligence suit, where jurors are required to put themselves “in the shoes of a ‘reasonable person’ at the time of the events giving rise to the suit.” *Id.*

187. *Markman v. Westview Instruments, Inc. (Markman II)*, 517 U.S. 370, 390 (1996).

188. *Id.* (quoting *Gen. Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938)).

189. See *Blonder-Tongue Labs., Inc. v. Univ. of Ill. Found.*, 402 U.S. 313, 350 (1971) (overruling *Triplett v. Lowell*, 297 U.S. 638 (1936), “to the extent it forecloses a plea of estoppel by one facing a charge of infringement of a patent that has once been declared invalid”).

190. For collateral estoppel to apply, the patentee must have had a “full and fair opportunity” to litigate the patent claim’s validity. See *id.* at 329 (“Although neither judges, the parties, nor the adversary system performs perfectly in all cases, the requirement of determining whether the party against whom an estoppel is asserted had a full and fair opportunity to litigate is a most significant safeguard.”).

declaratory judgment actions for invalidity. In *Technology Licensing*, for example, the patentee TLC could have retained the right to jury trial, but only by holding on to its damages claim.¹⁹¹ Gennum, the alleged infringer, had initially sought a jury trial itself.¹⁹² After learning that only a small amount of monetary damages would be recoverable, therefore, TLC perhaps thought it was “safe” to drop the request for damages without losing the right to jury trial. Once TLC dropped its damages claim, however, the decision whether validity would be tried before a jury was left solely to Gennum. By the time Gennum decided not to try its case to a jury, TLC could not reinstate its damages claim and therefore had no control over the matter.

While this course of events may appear to be little more than poor maneuvering on the part of TLC, it does raise concerns of fairness and judicial efficiency. Under the holding of *Technology Licensing*, any patentee wanting to guarantee its right to jury trial in all procedural settings must always seek monetary damages, even if those damages would be trivial. The value in requiring a patentee to seek damages, with the additional time and cost that a claim for damages would entail, is at best questionable—particularly when the validity issue may greatly outweigh the issue of damages.

The efficiency and fairness concerns addressed here may not be especially compelling given the rarity with which situations similar to those in *Technology Licensing* may arise.¹⁹³ Nonetheless, no policy concerns weigh *against* the right to jury trial in invalidity actions. Therefore, the conclusion dictated by functional considerations should prevail, and the right to jury trial should attach to all declaratory judgment actions for patent invalidity.

CONCLUSION

The Federal Circuit wrongly decided *In re Technology Licensing*. If the issue presents itself in the future, the Federal Circuit should reconsider it *en banc* and overrule the holding of the *Technology Licensing* majority. Application of the historical-analog test should have led to the conclusion that the writ of *scire facias* provides the appropriate historical analog to a

191. A patentee whose patent claims were infringed is always entitled to damages that are “in no event less than a reasonable royalty.” 35 U.S.C. § 284 (2000).

192. *In re Tech. Licensing Corp.*, 423 F.3d 1286, 1286 (Fed. Cir. 2005).

193. The sequence of events in *Technology Licensing* that resulted in TLC losing its right to jury trial (described in Part III, *supra*) was rather unusual. As noted by the court, “the problem faced by TLC is not likely to recur with frequency in conventional infringement actions.” *Id.* at 1291.

declaratory judgment action¹⁹⁴ for patent invalidity, and that the right to jury trial therefore attaches. Moreover, the court should have focused on the nature of the action as a whole, including the remedy sought by the party seeking invalidity, rather than just the remedy sought by the patentee. At the very least, given the judiciary's traditional concern with preserving the right to jury trial even in civil actions, the Federal Circuit should have followed the lead of the Supreme Court in *Markman II* and looked at functional considerations and policy concerns. Under that analysis, the highly fact-intensive nature of invalidity issues would have dictated that the right to jury trial be preserved.

194. In addition to declaratory judgment actions for patent invalidity, the conclusions suggested here would likely also be appropriate for counterclaims of patent invalidity, because they likewise constitute claims independent of the infringement claim. Such a holding, however, may be broader than the facts of *Technology Licensing* would require.

