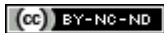


## ARTICLES

### CASTING ASPERSIONS IN PATENT TRIALS

Daniel Harris Brean & Bryan P. Clark

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# ARTICLES

## CASTING ASPERSIONS IN PATENT TRIALS

Daniel Harris Brean\* & Bryan P. Clark\*\*

### ABSTRACT

Bad actors in patent litigation can face serious consequences. Infringers who are found to infringe “willfully” may be subject to treble damages. Patentees who assert weak claims in bad faith can be ordered to pay the defendant’s attorneys’ fees. These remedies are of such importance to the patent system today that the Supreme Court reinvigorated both respective doctrines in back-to-back landmark decisions in 2014 (*Octane Fitness*) and 2016 (*Halo Electronics*).

Those decisions have helped district courts more effectively punish and deter misconduct. But the Supreme Court neglected to address a critical part of these remedies—whether and to what extent they should be tried to a jury. Under current law, willfulness can be tried to a jury but bad-faith enforcement cannot. This means that plaintiffs alone can legitimately cast aspersions at defendants that profoundly color the case and the jury’s views of it.

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It has long been held that willfulness is an issue triable by jury, but courts have reached that conclusion without conducting the proper analysis, which requires delving into the historical treatment of the issue. This article performs that analysis, finding that the Seventh Amendment does not guarantee a right to try willfulness to a jury. Nor does the Seventh Amendment require that questions of bad-faith enforcement be tried to juries. Both issues lack clear historical antecedents or analogues that would suggest juries decided the issues when the Seventh Amendment was ratified.

Whether such issues *should* be tried to juries likely comes out in the negative as well. Juries are ill-equipped to appreciate the proper significance and context of evidence touching on willfulness and bad-faith enforcement, which typically includes matters of claim construction, discovery, legal interpretation, or settlement discussions. And evidence about a party's culpability can easily bleed into the threshold liability and damages determinations, resulting in unsupportable compromise verdicts on those issues.

The best practice would be to try neither issue, but as it is, with willfulness being submitted to juries, a separate question is whether that alone justifies trying bad-faith enforcement to juries as well. This article demonstrates that basic fairness, as well as evidentiary practicalities for how such issues are proven, compels that both issues be tried together, and to the same jury, to ensure that juries hear both sides of the story before they assign moral blame.

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## I. INTRODUCTION

The Patent Act prescribes two formidable remedies in patent litigation, both reserved for culpable bad actors. Section 284 allows for actual damages awarded to a patent owner to be punitively increased up to three times, generally when the infringement is deemed “willful.”<sup>1</sup> Section 285 allows courts to award attorneys’ fees to the prevailing party in exceptional cases, usually involving willful infringement or bad-faith enforcement of the patent.<sup>2</sup> These remedies are of such importance to the patent system today that the Supreme Court reinvigorated both of the respective doctrines in landmark decisions in 2014 (*Octane Fitness*)<sup>3</sup> and 2016 (*Halo Electronics*).<sup>4</sup>

Sections 284 and 285, enacted together in 1952, are parallel counterparts in many respects and have associated lines of case law that inform and rely on each other.<sup>5</sup> Both remedies are justified by the need for punishment and deterrence, when appropriate.<sup>6</sup> Both remedies are generally reserved for situations involving egregious behavior.<sup>7</sup> And both remedies involve factual underpinnings but are ultimately equitable decisions committed to the sound discretion of the district court judge.<sup>8</sup>

A glaring exception to this overlap is in the adjudication of their factual underpinnings. Willfulness currently has a recognized right to trial by jury, while bad-faith enforcement does not.<sup>9</sup> As a practical matter, this means patentees that can raise plausible claims of willfulness have to do little more than overcome the summary judgment standard to present those arguments, along with the associated

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<sup>1</sup> 35 U.S.C. § 284 (2012); *see infra* Part III.

<sup>2</sup> 35 U.S.C. § 285 (2012); *see infra* Part II.

<sup>3</sup> *Octane Fitness, L.L.C. v. I.C.O.N. Health & Fitness, Inc.*, 134 S. Ct. 1749 (2014).

<sup>4</sup> *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S. Ct. 1923 (2016).

<sup>5</sup> *See infra* Parts II and III; *see also* Don Zhe Nan Wang, *End of the Parallel Between Patent Law’s § 284 Willfulness and § 285 Exceptional Case Analysis*, 11 WASH. J.L. TECH. & ARTS 311, 320 (2016) (observing that “the interplay between § 284 willfulness and pre-*Octane* § 285 exceptional case analysis goes beyond formalistic similarities and historical connections”).

<sup>6</sup> *See infra* Parts II and III.

<sup>7</sup> *See infra* Parts II and III.

<sup>8</sup> *See infra* Parts II and III.

<sup>9</sup> *See generally infra* Parts IV.A–IV.B.

negative connotations of the accused infringer that come with them, to a jury.<sup>10</sup> Further, once this plausible claim reaches the jury there is a high likelihood that a jury unfamiliar with the distinction between “willful” and ordinary infringement will side with the patentee. Indeed, our research of post-*Halo* infringement jury verdicts revealed that the infringement was found to be willful two-thirds of the time.<sup>11</sup> This

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<sup>10</sup> See, e.g., *Wis. Alumni Research Found. v. Apple, Inc.*, 135 F. Supp. 3d 865, 879 (W.D. Wis. 2015) (“Notably, Apple did not move on the subjective prong of the willful infringement claim at summary judgment. Assuming WARF’s claim gets past the objective prong, it will be for the jury to determine whether WARF’s evidence creates a reasonable inference that Apple knew about the patent.” Notably, in cases like *WARF v. Apple*, the “objective prong” of the willfulness inquiry was a legal question, not a factual one, that would have potentially limited WARF’s ability to argue willfulness to the jury, but the Supreme Court’s 2016 *Halo* decision did away with that aspect of the willfulness framework.); *P.S.N. Ill., L.L.C. v. Abbott Labs.*, No. 09 C 5879, 2012 U.S. Dist. LEXIS 155637, at \*19 (N.D. Ill. Oct. 31, 2012) (“PSN has pointed to sufficient evidence that it intends to introduce at trial on the issue of willfulness such that the issue should proceed to the jury. For example, PSN contends it will produce evidence showing that Abbott failed to obtain an opinion-of-counsel at any point, and that Abbott did or should have had pertinent knowledge based on Abbott’s alleged interaction with S1P2 suppliers who entered into license agreements and consent decrees with PSN relating to the patents at issue. Abbott has not shown that PSN should be barred from presenting the willfulness issue to the jury. It will be up to the jury to determine whether there is sufficient evidence to show willfulness on the part of Abbott.”); *Liquid Dynamics Corp. v. Vaughan Co.*, No. 01 C 6934, 2004 U.S. Dist. LEXIS 29992, at \*29–30 (N.D. Ill. Sept. 30, 2004) (“[A] willfulness determination typically requires review of the ‘totality of circumstances’ an analysis of the factual record. Vaughan’s motion is an inappropriate attempt to limit the scope of trial issues in a manner more appropriately raised in a motion for summary judgment. The motion *in limine* to exclude evidence of willfulness must be denied.”).

<sup>11</sup> We reviewed jury verdict forms finding infringement that were dated between June 13, 2016 (the date of the *Halo* decision) and August 18, 2017. Of the verdict forms matching these criteria, 15 included a willfulness question. Of those 15, the jury found the infringement willful in 10 instances and found the infringement to not be willful in five instances. Found willfulness: Verdict Form, *Idenix Pharms. LLC et al. v. Gilead Sciences, Inc.*, C.A. No. 14-846-LPS (D. Del. Dec. 15, 2016); Questions to the Jury on Special Verdict, *Brigham & Women’s Hosp., Inc. v. Perrigo Co.*, C.A. No. 1-13-cv-11640 (D. Mass. Dec. 14, 2016); Verdict Form, *Arthrex, Inc. v. Smith & Nephew, Inc.*, Case No. 2:15-cv-01047-RSP (E.D. Tex. Dec. 9, 2016); Verdict Form, *Barry v. Medtronic, Inc.*, Civil Action No. 1:14-cv-104 (E.D. Tex. Nov. 11, 2016); Verdict Form, *Johnstech Int’l Corp. v. JF Microtechnology SDN BHD*, Case No. 14-cv-02864-JD (N.D. Cal. Sept. 27, 2016); Verdict Form, *Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.*, Civil Action No. 2:14-cv-00911-JRG-RSP (E.D. Tex. Sept. 16, 2016); Final Verdict Form, *Cellular Commc’ns Equip. LLC v. Apple, Inc.*, C.A. No. 6:14-cv-251 (E.D. Tex. Sept. 14, 2016); Verdict, *CH2O, Inc. v. Meras Eng’g, Inc.*, Case No. cv-13-8418 JAK (GJSx) (C.D. Cal. Sept. 6, 2016); Special Verdict, *Kahr v. Cole*, Case No. 13-C-1005 (E.D. Wis. Aug. 11, 2016); Redacted Special Verdict, *Polaris Eng’g, Inc. v. Campbell Co.*, Case No. SA cv-13-0007-DFM (C.D. Cal. June 30, 2016). Found no willfulness: Verdict Form, *Elbit Sys. Land & C4I Ltd. v. Hughes Network Sys. LLC*, Civil Action No. 2:15-cv-00037-RWS (E.D. Tex. Aug. 7, 2017); Special Verdict Form: Damages, *Oxbo Int’l Corp. v. H&S Mfg. Co., Inc.*, 15-cv-292-jdp (W.D. Wis. June 21, 2017); Verdict Form, *Evonik Degussa GmbH v. Materia Inc.*, Civ. No. 09-636 (NLH/JS) (D. Del. Jan. 30, 2017); Verdict Form, *Ioengine, LLC v. Interactive Media Corp.*, Civil Action No. 14-1571-GMS (D. Del. Jan. 17, 2017); *Finjan, Inc. v. Sophos Inc.*, Case No. 14-cv-

is unlikely what the Supreme Court envisioned when it stated that willfulness is reserved for “egregious cases beyond typical infringement.”<sup>12</sup>

An accused infringer, on the other hand, has no similar opportunity. For example, defendants who believe a patentee is asserting meritless claims for the bad-faith purpose of coercing litigation settlements (the business model of so-called “patent trolls”), rather than pressing a legitimate infringement dispute, are routinely prevented from casting the patentee’s character in a negative light. Such defendants are precluded from using terms like “patent troll” that have “negative connotations,” from arguing that the lawsuit is a “shakedown” where the patentee is playing the “litigation lottery,” or from otherwise suggesting that the lawsuit is being brought by a bad actor for an improper or immoral purpose.<sup>13</sup> Such defendants are essentially

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01197-WHO (N.D. Cal. Sept. 21, 2016). *See also infra* Part IV.A.4 (discussing other historical data concerning juries’ propensities to find willfulness).

<sup>12</sup> Halo Elecs., Inc. v. Pulse Elecs., Inc., 136 S. Ct. 1923, 1935 (2016).

<sup>13</sup> *See, e.g.*, Mobile Telecomms. Techs., LLC v. LG Elecs. Mobilecomm U.S.A., Inc., Case No. 2:13-cv-947-JRG-RSP, 2016 U.S. Dist. LEXIS 92519, at \*5 (E.D. Tex. Feb. 4, 2016) (“Motion in Limine No. 7: The Court GRANTED-IN-PART this motion in limine as to references, evidence, testimony, or argument describing Plaintiff as a ‘Patent troll, a troll, a toll collector, as being litigious, being in the business of filing lawsuits, or playing the litigation lottery.’ The Court DENIED-IN-PART this motion in limine as to references, evidence, testimony, or argument describing Plaintiff as a ‘non-practicing entity’ or ‘NPE.’”); Dig. Reg of Tex., LLC v. Adobe Sys., No. C 12-1971 CW, 2014 U.S. Dist. LEXIS 115565, at \*37 (N.D. Cal. Aug. 19, 2014) (“Digital Reg seeks to prevent Adobe from using a wide array of terms to describe Digital Reg’s status. Adobe may not use pejorative terms, such as ‘patent troll,’ ‘pirate,’ ‘bounty hunter,’ ‘paper patent,’ ‘playing the lawsuit lottery,’ and ‘shell corporation,’ which have negative connotations. Adobe may, however, describe the nature of Digital Reg’s business with neutral, strictly factual terms, such as ‘patent assertion entity,’ a ‘company that does not make anything,’ a ‘company that does not sell anything,’ or ‘licensing entity.’ Digital Reg’s status as a non-practicing entity is relevant to damages and the Georgia-Pacific factors. A neutral description of Digital Reg’s status is thus permitted.”); Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc., Case No. 2:14-cv-911-JRG-RSP, 2016 U.S. Dist. LEXIS 126811, at \*8–9 (E.D. Tex. July 12, 2016) (motion in limine “GRANTED-IN-PART as to: ‘patent troll,’ ‘troll,’ ‘patent pirate,’ ‘shell company,’ ‘litigation shop,’ ‘lawsuit factory,’ ‘submarine patents,’ ‘litigious,’ ‘shakedown,’ ‘extortionist’ and like terms.”); Wis. Alumni Research Found. v. Apple, Inc., 14-cv-062-wmc, 2015 U.S. Dist. LEXIS 129931, at \*3 (W.D. Wis. Sept. 28, 2015) (“Any reference to WARF as a ‘patent troll’ or similar label is excluded, and any reference to WARF as a ‘non-practicing entity’ or similar label is also excluded from the liability stage, but Apple may offer evidence of WARF’s status as a ‘non-practicing entity’ and argue from that fact during the damages phase of trial.”); Energy Heating, LLC v. Heat On-The-Fly, LLC, Civil Case No. 4:13-cv-10, 2015 U.S. Dist. LEXIS 180149, at \*3–5 (D.N.D. Aug. 13, 2015) (“The court agrees that such terms as bandit and bounty hunter carry negative connotations and, in fact, do not really have much descriptive value. It appears from their response, that the other parties do not intend to use such terms and agree to refrain from using the term ‘patent troll.’ The court agrees that the parties shall avoid all terms that are not only pejorative but, like ‘patent troll,’ actually contain a legal conclusion. The court, however, will not prevent any of the parties from using terminology that accurately describes the other parties’ businesses . . . . There is nothing illegal

only allowed to note that the patentee is a “non-practicing entity” for purposes of determining the amount of damages that should be owed if liability exists.<sup>14</sup>

As another example, defendants accused of willfully infringing may wish to tell the jury that the patentee has dropped a number of claims that were originally asserted at the outset of the lawsuit. Such evidence might show that the patentee was over-aggressive and/or that the defendant had strong defenses against many aspects of the infringement assertions (and that the patentee conceded as much). Courts have precluded such evidence from being offered to rebut willfulness allegations.<sup>15</sup>

Surprisingly, this asymmetrical status quo does not rest on a solid legal foundation. While the Federal Circuit has stated on multiple occasions that patentees have a right to a jury trial on the issue of willfulness, the Federal Circuit has never even performed the requisite Seventh-Amendment analysis.<sup>16</sup> Indeed, we could

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or immoral about protecting patent rights and selling the right to use a patented product or service.”); HTC Corp. v. Tech. Props., Case No.: 5:08-cv-00882-PSG, 2013 U.S. Dist. LEXIS 129263, at \*11 (N.D. Cal. Sept. 6, 2013) (“The court agrees in part with both parties. HTC is precluded from using derogatory characterizations of patent owners including the use of the term patent troll without prior court approval. HTC may refer more generally to a ‘non-practicing entity,’ a ‘patent assertion entity,’ or neutral language to that effect.”).

<sup>14</sup> See, e.g., Mobile Telecomms. Techs., LLC v. LG Elecs. Mobilecomm U.S.A., Inc., Case No. 2:13-cv-947-JRG-RSP, 2016 U.S. Dist. LEXIS 92519, at \*5 (E.D. Tex. Feb. 4, 2016); Wis. Alumni Research Found. v. Apple, Inc., 14-cv-062-wmc, 2015 U.S. Dist. LEXIS 129931, at \*3 (W.D. Wis. Sept. 28, 2015); Finjan, Inc. v. Blue Coat Sys., Case No. 13-cv-03999-BLF, 2015 U.S. Dist. LEXIS 88760, at \*5 (N.D. Cal. July 8, 2015) (“Plaintiff moves to preclude Defendant from using any derogatory or misleading characterizations about Plaintiff’s business. Defendant agrees that it will not refer to Plaintiff as a ‘patent troll.’ Defendant intends, however, to present factual evidence concerning Plaintiff’s business, which is relevant to a damages analysis under the Georgia-Pacific factors.”).

<sup>15</sup> See, e.g., Advanced Tech. Incubator, Inc. v. Sharp Corp., Civil Action No. 5:09-cv-135, 2010 U.S. Dist. LEXIS 145630, at \*7 (E.D. Tex. Mar. 31, 2010) (“On balance, the Court agrees with ATI that permitting ‘sideshow’ litigation about dropped claims and instrumentalities would cause undue prejudice, jury confusion, and waste of time. FED. R. EVID. 403. This *in limine* item is therefore hereby GRANTED in its entirety. For example, Defendants should not argue that ATI’s act of dropping a claim or instrumentality is evidence of non-infringement as to that claim or instrumentality.”); Broadcom Corp. v. Emulex Corp., SACV 09-01058-JVS (ANx), 2011 U.S. Dist. LEXIS 158649, at \*2 (C.D. Cal. Aug. 10, 2011) (“The Court fails see to how elimination of an infringement claim against a patent not now in issue rebuts willfulness with respect to those claims in issue. Such evidence is irrelevant (Federal Rule of Evidence 402), and to the extent there is any probative value, presentation of such evidence would get into the reasons for withdrawing certain counts which would prove confusing and consume an undue amount of time (Federal Rule of Evidence 403). Such evidence could also prove unduly prejudicial.”).

<sup>16</sup> This is not the only area where the Federal Circuit has decided consequential Seventh Amendment issues with a cursory, improper analysis. See generally Eileen M. Herlihy, *The Ripple Effect of Seventh Amendment Decisions on the Development of Substantive Patent Law*, 27 SANTA CLARA COMPUTER & HIGH TECH. L.J. 333 (2011) (criticizing the Federal Circuit for its faulty Seventh Amendment analysis



identify no court that addressed the precise question of whether the Seventh Amendment guarantees a right to try the predicate issue of willfulness to a jury (though one court has held that there is no right to a jury trial on the ultimate question of whether damages should be enhanced).<sup>17</sup>

This article performs the requisite analysis in full as to both willfulness and bad-faith enforcement. The analysis proceeds in four stages: (1) identifying any statutory right to a jury trial; (2) confirming any historical practice of trying the issue to a jury prior to the ratification of the Seventh Amendment; (3) considering any analogous historical precedent that would support a right to a jury trial; and (4) evaluating whether functional considerations or practical concerns justify recognizing a jury-trial right.<sup>18</sup> As demonstrated below, no jury-trial right appears to exist as to either issue due to the lack of a clear statutory directive and the lack of direct historical antecedents or compelling analogous historical practices.

The propriety of allowing juries to hear such matters likely turns on functional considerations, which tend to disfavor juries deciding these issues.<sup>19</sup> Being able to portray one's adversary as a bad actor gives a jury a moral reason to find in one's favor in addition to the legal reasons. This is not necessarily improper. The problem is that casting such aspersions may also improperly prejudice the jury in irreparable ways. A "side show" about a party's culpability has no bearing on the threshold liability or damages issues, which do not depend on intent, but may nonetheless sway a jury to find liability or damages differently than they would in the absence of the "bad actor" evidence.<sup>20</sup> Beyond that, the evidence that is probative of willfulness and bad-faith enforcement can be challenging for juries to properly assess, as it often involves matters of claim construction, discovery disputes, settlement correspondence, legal interpretations, and litigation positions that judges can better understand and contextualize.<sup>21</sup> Arguing these issues to a jury can cause confusion and lead to unsupportable compromise verdicts on the merits.

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surrounding issues of claim construction, the doctrine of equivalents, and prosecution history estoppel); *id.* at 339 ("In determining whether a judge or jury should decide particular issues in these cases, the Federal Circuit has placed too much emphasis on reaching outcomes perceived to be beneficial from a policy perspective and too little emphasis on performing analyses that conform to Supreme Court Seventh Amendment precedent.").

<sup>17</sup> See *infra* Parts IV.A–IV.B.

<sup>18</sup> See *infra* Part IV.

<sup>19</sup> See *infra* Part IV.

<sup>20</sup> 35 U.S.C. § 271(a) (2012); 35 U.S.C. § 284 (2012).

<sup>21</sup> See *infra* Part IV.A.4 and Part IV.B.4.

For these reasons, we conclude that neither willfulness nor bad-faith patent enforcement should be presented to a jury for resolution. Both should be resolved by judges after trial, once the threshold liability and damages determinations have already been made.

But willfulness is currently triable by jury and that disparity gives plaintiffs a unique and powerful advantage over defendants in trial. Unless and until willfulness is removed from the jury's domain, defendants will be systematically disadvantaged because they cannot assert their own allegations of culpability. This raises the question of whether, knowing that willfulness is being tried to a jury, other considerations would compel bad-faith enforcement to be tried as well. We contend that if willfulness is tried, both fairness and evidentiary realities warrant a defendant's assertion of bad-faith patent enforcement to be tried to the jury at the same time.

Part II of this Article explains the current state of the exceptional case fee-shifting doctrine under *Octane Fitness*. Part III explains the current state of the willful patent infringement doctrine under *Halo*. Part IV discusses whether there is, or should be, a right to a jury trial on the questions of willful infringement and bad-faith patent enforcement. Part V discusses how, to the extent willfulness is tried to a jury, fairness compels the question of bad-faith enforcement to be tried along with it. Part VI concludes.

## II. EXCEPTIONAL CASES UNDER *OCTANE FITNESS*

A powerfully punitive, deterrent feature of the Patent Act is the provision on fee shifting that may be employed by the district court. Section 285 provides that “[t]he court in exceptional cases may award reasonable attorney fees to the prevailing party.”<sup>22</sup> The Supreme Court in *Octane Fitness, LLC v. ICON Health & Fitness, Inc.* explained that “an ‘exceptional’ case is simply one that stands out from others with respect to the substantive strength of a party’s litigating position (considering both the governing law and the facts of the case) or the unreasonable manner in which the case was litigated.”<sup>23</sup> “District courts may determine whether a case is ‘exceptional’ in the case-by-case exercise of their discretion, considering the totality of the circumstances.”<sup>24</sup>

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<sup>22</sup> 35 U.S.C. § 285 (2012).

<sup>23</sup> *Octane Fitness, L.L.C. v. I.C.O.N. Health & Fitness, Inc.*, 134 S. Ct. 1749, 1756 (2014).

<sup>24</sup> *Id.*

*Octane Fitness* expressly rejected the Federal Circuit’s “inflexible” and “overly rigid”<sup>25</sup> standard of *Brooks Furniture Manufacturing, Inc. v. Dutailier International, Inc.*, which had required proof that a claim was either: (a) objectively baseless and brought in subjective bad faith; or (b) involved serious litigation misconduct.<sup>26</sup> While *Octane Fitness* jettisoned this standard in favor of its totality-of-the-circumstances framework, it recognized that bad faith and baselessness remained relevant, even if proof of both need not be shown—i.e., after *Octane Fitness*, “a case presenting either subjective bad faith or exceptionally meritless claims may sufficiently set itself apart from mine-run cases to warrant a fee award.”<sup>27</sup>

Indeed, when enacting § 285, Congress sought to “codify in patent cases the ‘bad faith’ equitable exception to the American Rule,” which ordinarily requires parties to bear their own attorneys’ fees.<sup>28</sup> If an infringement claim is pursued in bad faith, through § 285 “Congress authorized awards of attorney fees to prevailing defendants ‘to enable the court to prevent a gross injustice to an alleged infringer.’”<sup>29</sup> Along these lines, the Supreme Court observed that § 285 serves as a “safeguard” against abusive patent owners that “use patents as a sword to go after defendants for money, even when their claims are frivolous.”<sup>30</sup>

Bad-faith litigation is certainly not unique to patent law,<sup>31</sup> though the phenomenon of patent assertion entities accused of litigating against scores of

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

<sup>26</sup> *Brooks Furniture Mfg., Inc. v. Dutailier Int’l, Inc.*, 393 F.3d 1378, 1381 (Fed. Cir. 2005).

<sup>27</sup> 134 S. Ct. at 1757.

<sup>28</sup> *Mathis v. Spears*, 857 F.2d 749, 758 (Fed. Cir. 1988) (explaining that “Congress has not been unaware of the distinction between good faith litigation to which the American Rule applies and bad faith litigation to which it does not.”); Jacob Singer, *Bad Faith Fee-Shifting in Federal Courts: What Conduct Qualifies?*, 84 ST. JOHN’S L. REV. 693, 693 (2010) (“Under the so-called ‘American rule’ of attorney fees, each party pays its own attorney fees, regardless of the outcome of the proceeding. Federal courts, however, have always recognized numerous exceptions to the American rule, one of which is the ‘bad faith exception.’ The exception allows courts to order fee-shifting despite the American rule. Specifically, when one of the parties to the action has acted in extreme bad faith, it must pay its opponent’s attorney fees.”).

<sup>29</sup> *Mathis*, 857 F.2d at 758 (quoting S. REP. NO. 1503 (1946), as reprinted in 1946 U.S. CODE CONG. SERV. 1386, 1387).

<sup>30</sup> *Commil USA, L.L.C. v. Cisco Sys., Inc.*, 135 S. Ct. 1920, 1930–31 (2015) (“[D]istrict courts have the authority and responsibility to ensure frivolous cases are dissuaded” via § 285.).

<sup>31</sup> Courts in other contexts have prohibited the bringing of claims without regard to the merits that are filed to perpetuate a sham or other improper purpose. See *U.S.S.-P.O.S.C.O. Indus. v. Contra Costa County Bldg. & Constr. Trades Council*, 31 F.3d 800, 811 (9th Cir. 1994) (explaining that “the filing of a whole series of lawsuits and other legal actions without regard to the merits . . . [is not immunized under

defendants for “nuisance value,” and without regard to the merits, has become notoriously common and sometimes results in fee shifting.<sup>32</sup> Even a single case brought to coerce settlement instead of resolve a legitimate infringement dispute can evidence sufficiently culpable conduct to warrant fee shifting.<sup>33</sup> Other indicia of bad faith might include advancing baseless claim construction positions<sup>34</sup> or failing to

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the Noerr-Pennington doctrine when] the legal filings [were] made, not out of a genuine interest in redressing grievances, but as part of a pattern or practice of successive filings undertaken essentially for purposes of harassment”); *Primitime 24 Joint Venture v. NBC*, 219 F.3d 92, 101 (2d Cir. 2000) (same, emphasizing “it is immaterial that some of the claims might, ‘as a matter of chance,’ have merit”) (quoting *USS-POSCO*, 31 F.3d at 811).

<sup>32</sup> See, e.g., *Eon-Net L.P. v. Flagstar Bancorp*, 653 F.3d 1314, 1327 (Fed. Cir. 2011) (“The record supports the district court’s finding that Eon-Net acted in bad faith by exploiting the high cost to defend complex litigation to extract a nuisance value settlement from Flagstar. At the time that the district court made its exceptional case finding, Eon-Net and its related entities, Millennium and Glory, had filed over 100 lawsuits against a number of diverse defendants alleging infringement. . . . [T]hose low settlement offers—less than ten percent of the cost that Flagstar expended to defend itself effectively ensured that Eon-Net’s baseless infringement allegations remained unexposed, allowing Eon-Net to continue to collect additional nuisance value settlements.”); *eDekka, L.L.C. v. 3Balls.com, Inc.*, No. 2:15-cv-541, 2015 U.S. Dist. LEXIS 168610, at \*13, 16–17 (E.D. Tex. Dec. 17, 2015) (cases involving lawsuits against over 200 defendants involving patent that was “demonstrably weak on its face,” which patent owner defended with “insupportable arguments” while engaging in “an aggressive strategy that avoids testing its case on the merits and instead aims for early settlements falling at or below the cost of defense”). See also Daniel Harris Brean, *Ending Unreasonable Royalties: Why Nominal Damages are Adequate to Compensate Patent Assertion Entities for Infringement*, 39 VT. L. REV. 867, 875 (2015) (“The amounts sought by PAEs are typically in the five-figure or low six-figure range—sums that are substantially less than the cost of litigation defense and thus are often referred to as ‘nuisance value.’ Most retailers and non-tech companies targeted by PAEs find it makes more business sense to pay the PAEs than to endure litigation that distracts and diverts resources away from their businesses’ primary objectives, namely, selling products and services.”); Colleen V. Chien, *Patent Trolls by the Numbers*, PATENTLYO (Mar. 14, 2013), <http://patentlyo.com/patent/2013/03/chien-patent-trolls.html> (“40% of respondents [to PAE litigation survey] said the demand was based on a technology they were using, not making. Such suits seem hard to justify as anything but nuisance-based.”).

<sup>33</sup> See, e.g., *Advanced Ground Info. Sys., Inc. v. Life360, Inc.*, No. 14-cv-80651, 2015 U.S. Dist. LEXIS 185188, at \*3-5 (S.D. Fla. Dec. 1, 2015) (finding, in an “exceptionally weak case” where the threat of an injunction was improperly held over the head of the defendant, that “continued assertion of these claims seemed designed to extract settlement not based upon the merits of the claim but on the high cost of litigation”).

<sup>34</sup> See, e.g., *MarcTec, L.L.C. v. Johnson & Johnson*, 664 F.3d 907, 919 (Fed. Cir. 2012) (“MarcTec’s proposed claim construction was so lacking in any evidentiary support that assertion of this construction was unreasonable and reflects a lack of good faith.”); *Chalumeau Power Sys. L.L.C. v. Alcatel-Lucent*, Civil Action No. 11-1175-RGA, 2014 WL 4675002, at \*2 (D. Del. Sept. 12, 2014) (finding case exceptional in part because plaintiff advanced frivolous claim construction arguments that even a “ cursory inspection of the specification would have shown” to be meritless). Cf. *Raylon, L.L.C. v. Complus Data Innovations, Inc.*, 700 F.3d 1361, 1368 (Fed. Cir. 2012) (finding Rule 11 sanctions appropriate where a

conduct an adequate pre-filing investigation, where such an investigation would have revealed the frivolity of the infringement assertion.<sup>35</sup> Generally, subjective bad faith can be “grounded in or denominated wrongful intent, recklessness, or gross negligence,” and can be inferred where “the patentee is manifestly unreasonable in assessing infringement, while continuing to assert infringement in court.”<sup>36</sup>

While defendants have little control over whether or when they are sued, how expensive it may be to defend a case through judgment, and how long or difficult it may be to obtain a favorable judgment, § 285 at least provides a backstop to ensure that abusive patent litigation will not leave its victims without a remedy.

### III. WILLFUL INFRINGEMENT UNDER *HALO*

There are patent infringers<sup>37</sup> and there are “willful” patent infringers. For the latter cases involving “egregious infringement behavior,”<sup>38</sup> district courts have discretion to increase any damages awarded up to three times the amount that would otherwise be owed under § 284 of the Patent Act. Such enhanced damages serve as a punitive sanction and deterrent when an infringer’s conduct might be characterized as “willful, wanton, malicious, bad-faith, deliberate, consciously wrongful, flagrant, or—indeed—characteristic of a pirate.”<sup>39</sup> Basically, the law allows for special punishment of infringers who infringe with a culpable state of mind.<sup>40</sup>

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party’s claim construction position is “so unreasonable that no reasonable litigant could believe it would succeed”) (quoting *iLor, L.L.C. v. Google, Inc.*, 631 F.3d 1372, 1378 (Fed. Cir. 2011)).

<sup>35</sup> See, e.g., *Lumen View Tech. L.L.C. v. Findthebest.com, Inc.*, 811 F.3d 479, 481–82 (Fed. Cir. 2016) (affirming award of attorneys’ fees where “[t]he [district] court found that the suit was frivolous and objectively unreasonable, because the bilateral matching method of the ’073 patent requires the preference data of two or more parties, and ‘the most basic’ pre-suit investigation would have shown that the accused AssistMe feature only used the preference data of one party . . . . The court further found that Lumen View’s motivation for filing suit was to extract a nuisance settlement from FTB, and that Lumen View’s ‘predatory strategy’ of baseless litigation showed the need for deterrence. The court therefore found that the case was exceptional and granted the motion for fees.”).

<sup>36</sup> *Eltech Sys. Corp. v. PPG Indus.*, 903 F.2d 805, 811 (Fed. Cir. 1990).

<sup>37</sup> 35 U.S.C. § 271 (2012) (describing various actions that constitute patent infringement).

<sup>38</sup> *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S. Ct. 1923, 1932 (2016); 35 U.S.C. § 284 (2012) (“When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.”).

<sup>39</sup> *Halo*, 136 S. Ct. at 1932.

<sup>40</sup> *Id.* (“[S]uch damages are generally reserved for egregious cases of culpable behavior.”).

In *Halo Electronics, Inc. v. Pulse Electronics, Inc.*, the Supreme Court dismissed the notion that willfulness could be negated by a showing that there exists a reasonable defense to infringement liability.<sup>41</sup> The Federal Circuit had held that willfulness required a showing of “objective recklessness,” which the Court rejected in favor of a purely subjective inquiry.<sup>42</sup> The problem, according to *Halo*, was that requiring proof of objective recklessness:

[makes] dispositive the ability of the infringer to muster a reasonable (even though unsuccessful) defense at the infringement trial. The existence of such a defense insulates the infringer from enhanced damages, even if he did not act on the basis of the defense or was even aware of it. Under that standard, someone who plunders a patent—infringing it without any reason to suppose his conduct is arguably defensible—can nevertheless escape any comeuppance under § 284 solely on the strength of his attorney’s ingenuity.<sup>43</sup>

Culpability, the Court explained, is not measured by post hoc rationalizations, but “against the knowledge of the actor at the time of the challenged conduct.”<sup>44</sup> Curiously, despite *Halo*’s emphasis on subjective state of mind, the Federal Circuit subsequently suggested that in this subjective test, “objective reasonableness is one of the relevant factors” for evaluating whether the infringer possessed the requisite culpable mindset.<sup>45</sup>

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<sup>41</sup> *Id.* (“The principal problem with Seagate’s two-part test is that it requires a finding of objective recklessness in every case before district courts may award enhanced damages. Such a threshold requirement excludes from discretionary punishment many of the most culpable offenders, such as the ‘wanton and malicious pirate’ who intentionally infringes another’s patent—with no doubts about its validity or any notion of a defense—for no purpose other than to steal the patentee’s business.”).

<sup>42</sup> *Id.* at 1933 (“The subjective willfulness of a patent infringer, intentional or knowing, may warrant enhanced damages, without regard to whether his infringement was objectively reckless.”).

<sup>43</sup> *Id.*

<sup>44</sup> *Id.*

<sup>45</sup> *WesternGeco L.L.C. v. ION Geophysical Corp.*, 837 F.3d 1358, 1363 (Fed. Cir. 2016). The Federal Circuit reached this somewhat dubious result as follows:

After *Halo*, the objective reasonableness of the accused infringer’s positions can still be relevant for the district court to consider when exercising its discretion. *Halo* looked to *Octane Fitness* for the relevant standard. *Halo*, quoting *Octane Fitness*, held that there is “no precise rule or formula” to determine whether enhanced damages should be awarded and that district courts should generally “exercise[] [their discretion] in light of the considerations’ underlying the grant of that discretion.” *Halo*, 136 S. Ct. at

In any event, through the *Halo* lens, “[§] 284 allows district courts to punish the full range of culpable behavior.”<sup>46</sup> Although district courts are expected to consider each case on its own facts and merits, the Court expected that, “[c]onsistent with nearly two centuries of enhanced damages under patent law, . . . such punishment should generally be reserved for egregious cases typified by willful misconduct.”<sup>47</sup>

As one Federal Circuit judge explained, the kind of evidence that is probative of willfulness is broad:

There are many circumstances that may create an appropriate predicate for a finding of willful infringement, and hence punitive damages, including deliberate copying, concealing infringing activity, infringement where the infringer knows that it is infringing or where it knows it has only frivolous defenses, infringement designed to injure a competitor, etc. We have appropriately held that such activity is reprehensible and that enhanced damages may be awarded in such circumstances.<sup>48</sup>

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1932 (quoting *Octane Fitness*, 134 S. Ct. at 1756). *Octane Fitness* in turn held that, in determining whether to award attorney’s fees under § 285, a district court should “consider[] the totality of the circumstances.” *Octane Fitness*, 134 S. Ct. at 1756. In that connection *Octane Fitness* relied on “the comparable context of the Copyright Act,” *id.* noting that “[i]n *Fogerty v. Fantasy, Inc.*, for example, [the Court] explained that in determining whether to award fees under a similar provision in the Copyright Act, district courts could consider a ‘nonexclusive’ list of ‘factors,’ including ‘frivolousness, motivation, objective unreasonableness (both in the factual and legal components of the case) and the need in particular circumstances to advance considerations of compensation and deterrence,’” *id.* at 1756 n.6 (emphasis added and internal citation omitted). Thus, objective reasonableness is one of the relevant factors. In short, as the Supreme Court itself has said, district courts should exercise their discretion, “tak[ing] into account the particular circumstances of each case,” and consider all relevant factors in determining whether to award enhanced damages. *Halo*, 136 S. Ct. at 1933–34.

*Id.*

<sup>46</sup> *Halo*, 136 S. Ct. at 1933.

<sup>47</sup> *Id.* at 1933–34.

<sup>48</sup> *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337, 1348–49 (Fed. Cir. 2004) (Dyk, J., dissenting) (citing *Hoechst Celanese Corp. v. BP Chems Ltd.*, 78 F.3d 1575, 1583 (Fed. Cir. 1996)) (“Willful infringement is . . . a measure of reasonable commercial behavior in the context of the tort of patent infringement. The extent to which the infringer disregarded the property rights of the

Making false statements or other affirmative misconduct in the litigation can also justify a willfulness finding.<sup>49</sup> An opinion of counsel indicating non-infringement or invalidity of the patent may show good faith, but if that opinion is not competent, it would be less helpful to an accused infringer to defend against willfulness.<sup>50</sup> And while merely continuing one's course of conduct after the infringement accusation is made does not necessarily rise to the level of willfulness, advancing frivolous defenses in bad faith can prove willfulness.<sup>51</sup>

Finally, *Halo* expressly relied on *Octane Fitness* for guidance, recognizing that *Octane Fitness*'s analysis of § 285 "points in the same direction" as the § 284 willfulness context.<sup>52</sup> This was true not only in terms of the two decisions' adoptions of similarly flexible, fact-specific standards that seek to punish wide ranges of

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patentee, the deliberateness of the tortious acts, or other manifestations of unethical or injurious commercial conduct, may provide grounds for a finding of willful infringement and the enhancement of damages."); *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1127 (Fed. Cir. 1993) (reversing the district court's ruling that infringement was not willful because the infringer's "deliberate copying was strong evidence of willful infringement, without any exculpatory evidence to balance the weight"); *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 827 (Fed. Cir. 1992) (including "whether defendant attempted to conceal its misconduct" as a factor to be considered in enhancing damages); *Kaufman Co. v. Lantech, Inc.*, 807 F.2d 970, 978–79 (Fed. Cir. 1986) (affirming the district court's finding of willfulness based on the district court's findings that the infringer "faithfully copied the claimed invention, took an untenable position regarding validity of the patent, and presented a frivolous defense of noninfringement").

<sup>49</sup> See *Knorr-Bremse*, 383 F.3d at 1350.

<sup>50</sup> See *Liquid Dynamics Corp. v. Vaughn Co.*, 449 F.3d 1209 (Fed. Cir. 2006).

<sup>51</sup> See *Gustafson, Inc. v. Intersystems Indus. Prods., Inc.*, 897 F.2d 508, 511 (Fed. Cir. 1990) ("[A] party may continue to manufacture and may present what in good faith it believes to be a legitimate defense without risk of being found on that basis alone a willful infringer. That such a defense proves unsuccessful does not establish that infringement was willful. Presentation in bad faith of a totally unsupported, frivolous defense may in itself provide a basis for attorney fees under [§] 285 and may, in light of all the circumstances, also constitute some evidence that continued infringement was willful.").

<sup>52</sup> *Halo*, 136 S. Ct. at 1922–23 ("Our recent decision in *Octane Fitness* arose in a different context but points in the same direction. In that case we considered § 285 of the Patent Act, which allows district courts to award attorney's fees to prevailing parties in 'exceptional cases.' 35 U.S.C. § 285. The Federal Circuit had adopted a two-part test for determining when a case qualified as exceptional, requiring that the claim asserted be both objectively baseless and brought in subjective bad faith. We rejected that test on the ground that a case presenting 'subjective bad faith' alone could 'sufficiently set itself apart from mine-run cases to warrant a fee award.' So too here. The subjective willfulness of a patent infringer, intentional or knowing, may warrant enhanced damages, without regard to whether his infringement was objectively reckless.") (citations omitted).



culpable misconduct, but even in their adoptions of parallel preponderance burdens of proof<sup>53</sup> and the abuse-of-discretion standards of appellate review.<sup>54</sup>

#### IV. JURY TRIAL RIGHTS ON WILLFULNESS AND BAD FAITH

Whether one has a Seventh Amendment right to a jury trial on any given issue requires an analysis in four stages: (1) parsing any pertinent statutory text to determine if the right to a jury trial has been provided by Congress; (2) if the statutory text is inconclusive, looking to the historical treatment of the issue when the Seventh Amendment was ratified to see if a right to a jury trial on that issue existed at the time (the so-called “Historical Test”); (3) if there is no direct historical antecedent, evaluating analogous precedent; and (4) if all else fails, functional and practical considerations should be considered as to how the issue is best allocated between judge and jury.<sup>55</sup>

##### A. *Willfulness as a Question for the Jury*

Before *Halo*, the question of willfulness ordinarily went to the jury unless it was resolved before trial, for example, upon the district court’s finding that an accused infringer’s defense was objectively reasonable.<sup>56</sup> *Halo*’s abrogation of an objective recklessness requirement, which was often resolved by the court on

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<sup>53</sup> *Id.* at 1934 (“The Seagate test is also inconsistent with § 284 because it requires clear and convincing evidence to prove recklessness. On this point, *Octane Fitness* is again instructive. There too the Federal Circuit had adopted a clear and convincing standard of proof, for awards of attorney’s fees under § 285 of the Patent Act. Because that provision supplied no basis for imposing such a heightened standard of proof, we rejected it. We do so here as well. Like § 285, § 284 ‘imposes no specific evidentiary burden, much less such a high one.’ And the fact that Congress expressly erected a higher standard of proof elsewhere in the Patent Act, see 35 U.S.C. § 273(b), but not in § 284, is telling. Furthermore, nothing in historical practice supports a heightened standard. As we explained in *Octane Fitness*, ‘patent-infringement litigation has always been governed by a preponderance of the evidence standard.’ Enhanced damages are no exception.”) (citations omitted).

<sup>54</sup> *Id.*

<sup>55</sup> See generally *Feltner v. Columbia Pictures Tel. Inc.*, 523 U.S. 340, 345 (1998); *Markman v. Westview Instruments*, 517 U.S. 370, 376–79, 388 (1996).

<sup>56</sup> See, e.g., *Promega Corp. v. Life Techs. Corp.*, 773 F.3d 1338, 1344 (Fed. Cir. 2014) (“The case proceeded to a jury trial on willfulness and damages.”); *Streck, Inc. v. Research & Diagnostic Sys.*, 665 F.3d 1269, 1278 (Fed. Cir. 2012) (“[T]he court conducted an eight-day jury trial to address priority of invention, enablement, damages, and willfulness.”); *Advanced Fiber Techs. Trust v. J&L Fiber Servs.*, 674 F.3d 1365, 1378 (Fed. Cir. 2012) (“[W]e affirm the court’s grant of summary judgment that AFT failed to raise a genuine factual issue that any infringement by J&L was willful.”); *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contrs. USA, Inc.*, 617 F.3d 1296, 1313 (Fed. Cir. 2010) (“We agree with the district court that, as a matter of law, there is no willfulness.”).

summary judgment,<sup>57</sup> is expected to raise the jury's role in willfulness and sharply curtail the number of cases where willfulness is resolved before trial.<sup>58</sup>

In *WBIP, LLC v. Kohler Co.*,<sup>59</sup> the Federal Circuit interpreted *Halo* as not disturbing “the established law that the factual components of the willfulness question should be resolved by the jury.”<sup>60</sup> *Halo* never explicitly commented on whether juries can or should continue to decide the factual questions of willfulness or culpable intent, but emphasized the role of the judge in the separate, discretionary decision to enhance damages. *Halo* did, however, suggest that willfulness should be reserved for “egregious cases *beyond typical infringement*,” and judges, who preside over many infringement cases (or will at least study other infringement precedent), would have a far better sense of what infringement is “typical” than a jury would.<sup>61</sup> Indeed, in their reading of *Halo*, Michael Feldman and Mark Lemley concluded that “it is not clear whether a jury has any continuing role to play in treble damages,” but that the Court “seems to think that judges, not juries, will decide whether the defendant has engaged in willful and egregious conduct.”<sup>62</sup>

Post-*Halo*, however, district courts have continued to treat willfulness as a fact issue properly resolved by the jury, consistent with *WBIP*. Some judges have

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<sup>57</sup> See *Powell v. Home Depot USA, Inc.*, 663 F.3d 1221, 1236 (Fed. Cir. 2011) (“Should the court determine that the infringer’s reliance on a defense was not objectively reckless, it cannot send the question of willfulness to the jury, since proving the objective prong is a predicate to consideration of the subjective prong.”).

<sup>58</sup> See Patrick M. Arenz & William E. Manske, *The Halo Effect: More Jury Trials on Willfulness*, LAW 360 (Aug. 1, 2016), <https://www.law360.com/articles/823447/the-halo-effect-more-jury-trials-on-willfulness> (“The *Halo* decision has already made a significant impact on willful infringement claims. The initial impact has been a dramatic decline in summary judgment orders of no willful infringement. As a result, patent holders can expect to have the issue of willfulness decided by a jury.”).

<sup>59</sup> *W.B.I.P., L.L.C. v. Kohler Co.*, 829 F.3d 1317 (Fed. Cir. 2016).

<sup>60</sup> *Id.* at 1341 (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1250 (Fed. Cir. 1989) (“Absent sufficient basis for directing the verdict, Richardson has the right of jury determination of this factual question. Willfulness of behavior is a classical jury question of intent. When trial is had to a jury, the issue should be decided by the jury.”) and *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 769 F.3d 1371, 1386 (Fed. Cir. 2014) (O’Malley, J., concurring) (“[W]e have long held that a willfulness determination contains issues of fact that should be submitted to a jury.”)).

<sup>61</sup> *Halo*, 136 S. Ct. at 1935 (2016) (emphasis added).

<sup>62</sup> Michael Feldman & Mark A. Lemley, “*Characteristic of a Pirate*”: *Willfulness and Treble Damages*, STAN., PUB. L. & LEGAL THEORY RES. PAPER SERIES (July 19, 2016), <https://ssrn.com/abstract=2811773> (“Abuse of discretion, after all, is a standard of review for determinations made by judges, not juries. Having done away with Seagate’s ‘clear and convincing’ evidence standard, the power to impose treble damages may now lie exclusively with the judge. But again, the court doesn’t say so expressly.”).

exercised their discretion not to enhance damages despite jury verdicts of willfulness, ruling that the conduct was not sufficiently egregious.<sup>63</sup> Others have deemed a jury's willfulness verdict conclusive on the issue of willfulness, though not dispositive of the separate matter of enhanced damages.<sup>64</sup>

In *WBIP*, the Federal Circuit, in a footnote, suggested that there is some question as to whether there is a Seventh Amendment right to a jury trial on willfulness—an issue raised in *Halo* but not resolved by the Court.<sup>65</sup> And as Judge O'Malley suggested in her concurrence in the Federal Circuit decision that was later vacated by *Halo*, “[t]he mere presence of factual components in a discretionary inquiry does not remove that inquiry from the court to whom congress reposed it.”<sup>66</sup>

Federal Circuit precedent holding that there is a right to a jury trial on willfulness remains binding unless overruled *en banc* or by the Supreme Court.<sup>67</sup> The following discussion examines how fresh analysis of the issue would likely play out if the Federal Circuit or the Court were to take up the issue.

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<sup>63</sup> See, e.g., *Trs. of Boston Univ. v. Everlight Elecs. Co.*, 212 F. Supp. 3d 254 (D. Mass. 2016) (“Assuming without deciding that the jury’s verdict, based on the subjective prong of the now-overruled Seagate test, is sufficient to find subjective willfulness, the Court still finds, in its discretion, that the defendants’ conduct did not rise to the level of egregiousness meriting an award of enhanced damages.”); *Presidio Components, Inc. v. Am. Tech. Ceramics Corp.*, No. 14-cv-02061, 2016 U.S. Dist. LEXIS 110212, at \*36–37 (S.D. Cal. Aug. 17, 2016) (“Moreover, the Court notes that ATC’s motion on this issue is essentially moot because the Court, exercising its sound discretion, ultimately declines to award Presidio enhanced damages despite the jury’s finding of willful infringement.”).

<sup>64</sup> See, e.g., *Sociedad Espanola De Electromedicina Y Calidad SA v. Blue Ridge X-Ray Co.*, No. 1:10-cv-00159 U.S. Dist. LEXIS 115629, at \*2 (W.D.N.C. July 8, 2016) (“[T]he jury was instructed to make a factual determination as to whether the DRGEM Defendants acted willfully, and the jury answered this question in the affirmative. In light of *Halo*, this finding standing alone is sufficient to support a finding of willfulness. . . . The Court does not address the question of an award of enhanced damages in this action in that no motion for such is presently before the Court.”).

<sup>65</sup> *W.B.I.P.*, 829 F.3d at 1341 n.13.

<sup>66</sup> *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 769 F.3d 1371, 1386 (Fed. Cir. 2014) (O’Malley, J., concurring) (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 992 (Fed. Cir. 1995) (“Even within the realm of factual questions, whether a particular question must always go to a jury depends on whether the jury must shoulder this responsibility as necessary to preserve the substance of common law right of trial by jury.”) (internal quotation marks and citations omitted)).

<sup>67</sup> *Id.* (citing *Masias v. Sec’y of Health & Human Servs.*, 634 F.3d 1283, 1288 (Fed. Cir. 2011) and *Barclay v. United States*, 443 F.3d 1368, 1373 (Fed. Cir. 2006)).

## 1. Statutory Analysis

The Supreme Court's analytical framework would first parse the statutory language to avoid a Seventh Amendment issue, if possible, by finding a statutory right to a jury trial.<sup>68</sup>

Section 284 makes no mention of a right to a jury trial on the issue of willfulness—indeed, § 284 does not mention willfulness or any other reason why a court “may increase the damages.”<sup>69</sup> This portion of the statute indicates that “*the court* may increase the damages,” which would typically mean a judge, not a jury.<sup>70</sup> To remove any doubt, “a jury” is referred to elsewhere in § 284 as a possible finder of damages.<sup>71</sup> The only fair reading of § 284 is that the judge, not the jury, makes the decision to enhance damages.<sup>72</sup>

Thus, while a finding of willfulness (by a judge or jury) may properly support the decision to enhance damages, as shown above, the statute itself does not recognize willfulness per se or suggest who determines willfulness.<sup>73</sup> There is no

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<sup>68</sup> *Feltner v. Columbia Pictures Tel.*, 523 U.S. 340, 345 (1998) (“Before inquiring into the applicability of the Seventh Amendment, we must ‘first ascertain whether a construction of the statute is fairly possible by which the [constitutional] question may be avoided.’”).

<sup>69</sup> 35 U.S.C. § 284 (2012) (“Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court. When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.”).

<sup>70</sup> *Id.*; *cf.* *Feltner v. Columbia Pictures Tel.*, 523 U.S. 340, 346 (U.S. 1998) (“In fact, the other remedies provisions of the Copyright Act use the term ‘court’ in contexts generally thought to confer authority on a judge, rather than a jury. *See, e.g.*, § 502 (‘court . . . may . . . grant temporary and final injunctions’); § 503(a) (‘the court may order the impounding . . . of all copies or phonorecords’); § 503(b) (‘as part of a final judgment or decree, the court may order the destruction or other reasonable disposition of all copies or phonorecords’); § 505 (‘the court in its discretion may allow the recovery of full costs’ of litigation and ‘the court may also award a reasonable attorney’s fee’).”).

<sup>71</sup> 35 U.S.C. § 284 (2012) (“When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.”).

<sup>72</sup> *Accord* Alan N. Herda, Note, *Willful Patent Infringement and the Right to a Jury Trial*, 9 TEX. WESLEYAN L. REV. 181, 209–10 (2003) (“In the first sentence of this portion of the statute, the words ‘jury’ and ‘court’ refer to different entities because the court functions in the alternative of the jury function. The second sentence gives the ‘court’ the task of increasing damages, not the ‘jury.’ If the jury does not increase damages, then the ‘court’ must refer to the trial judge. Therefore, it is the function of the trial judge to increase damages.”).

<sup>73</sup> 35 U.S.C. § 284 (2012); *see also* Amicus Brief of Mentor Graphics at 20, *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 769 F.3d 1371 (Fed. Cir. Dec. 14, 2015) (No. 14-1513) [hereinafter *Mentor Graphics Brief*] (“Plainly, there is no statutory right to a jury trial on the issue of willfulness. Section 284 does not mention

other clear signal in the statutory text such as an express mention of a jury finding relating to enhanced damages, or the presence of the word “legal” that might point toward willfulness being a jury issue.<sup>74</sup> Because the statute provides no jury trial right, the Seventh Amendment “historical test” concerning a right to a jury trial must be considered.<sup>75</sup>

## 2. Historical Test

The Supreme Court’s historical test basically asks how the right or remedy at issue would have been adjudicated at common law when the Seventh Amendment was ratified in 1791. As the Court explained in *Markman v. Westview Instruments*:

The Seventh Amendment provides that “in Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved . . .” U.S. CONST., Amdt. 7. Since Justice Story’s day, we have understood that “the right of trial by jury thus preserved is the right which existed under the English common law when the Amendment was adopted.” *Baltimore & Carolina Line, Inc. v. Redman*, 295 U.S. 654, 657 (1935). In keeping with our longstanding adherence to this “historical test,” Wolfram, *The Constitutional History of the Seventh Amendment*, 57 MINN. L. REV. 639, 640–43 (1973), we ask, first, whether we are dealing with a cause of action that either was tried at law at the time of the founding or is at least analogous to one that was, *see, e.g., Tull v. United States*, 481 U.S. 412, 417 (1987). If the action in question belongs in the law category, we then ask whether the particular trial decision must fall to the jury in order to preserve the substance of the common-law right as it existed in 1791.<sup>76</sup>

As for the first portion of this test, “there is no dispute that [patent] infringement cases today must be tried to a jury, as their predecessors were more than two centuries ago.”<sup>77</sup> The second portion of this test, inquiring whether willfulness

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willfulness.”); Janice M. Mueller, *Willful Patent Infringement and the Federal Circuit’s Pending En Banc Decision in Knorr-Bremse v. Dana Corp.*, 3 MARSHALL INTELL. PROP. L. REV. 218, 226 (2004) (“[N]othing in the current text of the 1952 Patent Act mandates that juries determine the question of willfulness. . . . Although the statute provides that ‘damages’ may be found by a jury, the only actor with authority to ‘increase the damages up to three times the amount found or assessed’ is the court.”).

<sup>74</sup> *Feltner*, 523 U.S. at 346.

<sup>75</sup> *Id.* at 346 (“We thus discern no statutory right to a jury trial when a copyright owner elects to recover statutory damages. Accordingly, we must reach the constitutional question.”).

<sup>76</sup> *Markman v. Westview Instruments*, 517 U.S. 370, 376 (1996) (citations omitted).

<sup>77</sup> *Id.* at 377.

specifically has a historical right to a jury trial associated with it, is a more open issue.

To be sure, as noted in *WBIP*, the Federal Circuit has deemed willfulness a proper jury question because it is a “classical . . . question of intent,” and thus a “fact” issue instead of a legal issue.<sup>78</sup> And, according to the Federal Circuit, the punitive nature of the potential enhancement does not make the willfulness issue one of equity, as opposed to law, to be resolved by a judge instead of a jury: “[a]lthough fairness as between patentee and infringer is a consideration in the determination of whether illegal behavior warrants an enhanced penalty, the question does not thereby become ‘equitable.’”<sup>79</sup>

But, as commentators have observed, this longstanding precedent was issued without the court conducting the proper analysis.<sup>80</sup> The Federal Circuit’s discussions on the jury-trial questions are remarkably brief and never actually apply the historical test.<sup>81</sup> This is consistent with deficiencies in how the Federal Circuit has handled other Seventh-Amendment questions involving claim construction, the doctrine of equivalents, and prosecution history estoppel.<sup>82</sup>

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<sup>78</sup> *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1250 (Fed. Cir. 1989) (citing *Hammerquist v. Clarke’s Sheet Metal, Inc.*, 658 F.2d 1319, 1325–26 (9th Cir. 1981)) (“[B]ecause willful infringement involves a mental state peculiarly in the realm of jury judgment, the jury could properly have found on the basis of evidence before it that Clarke willfully infringed Hammerquist’s patent.”); *Nat’l Presto Indus. v. West Bend Co.*, 76 F.3d 1185, 1192 (Fed. Cir. 1996) (“Liability for willfulness of infringement turns on considerations of intent, state of mind, and culpability. We need not belabor that these are questions of fact.”); *Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 822 (Fed. Cir. 1992) (“Whether infringement is willful is a question of fact, and the jury’s determination as to willfulness is therefore reviewable under the substantial evidence standard.”).

<sup>79</sup> *Nat’l Presto Indus.*, 76 F.3d at 1192.

<sup>80</sup> Mentor Graphics Brief, *supra* note 73, at 25 (“For 26 years the Federal Circuit has maintained that there is a right to a jury trial of willfulness—without conducting the historical and functional analyses required by this Court’s Seventh Amendment jurisprudence.”); Janice M. Mueller, *Willful Patent Infringement and the Federal Circuit’s Pending En Banc Decision in Knorr-Bremse v. Dana Corp.*, 3 J. MARSHALL INTELL. PROP. L. REV. 218, 223 (2004) (“The question of judge-versus-jury for determining willfulness is an open one, for the Federal Circuit has never clearly ruled on whether there is a Seventh Amendment right to a jury determination on willfulness.”).

<sup>81</sup> See *Richardson*, 868 F.2d at 1250; *Nat’l Presto Indus.*, 76 F.3d at 1192; *Braun Inc.*, 975 F.2d at 822.

<sup>82</sup> See Herlihy, *supra* note 16, at 401 (“Seventh Amendment issues in patent cases should be analyzed in a principled manner, consistent with Supreme Court precedent. . . .” Further, “[i]n the area of claim scope, flawed Seventh Amendment analyses by the Federal Circuit in its majority opinions in *Markman* and *Hilton Davis*, based principally on a fact versus law approach, have resulted in confusion, tension and conflict in a wide array of substantive law issues related to claim construction, the doctrine of equivalents and prosecution history estoppel.”); see also *id.* at 355 (explaining that the Federal Circuit’s analysis

Whether willfulness is a “classical . . . question of intent” or “a question of fact” is beside the point because, as articulated in *Markman*, the question is “whether a particular issue occurring within a jury trial (here [willfulness]) is itself necessarily a jury issue, the guarantee being essential to preserve the right to a jury’s resolution of the ultimate dispute.”<sup>83</sup> This, in turn, requires one to consider, through the lens of the historical test, “whether the jury must shoulder this responsibility as necessary to preserve the ‘substance of the common-law right of trial by jury.’”<sup>84</sup>

The one and only case we identified that squarely applied any historical test concerning § 284 was the Fifth Circuit’s 1964 decision in *Swofford v. B & W, Inc.*,<sup>85</sup> where the court saw “no authority for the proposition that the parties enjoyed a constitutional right to jury trial on the award and amount of exemplary damages.”<sup>86</sup> *Swofford*, being a Fifth Circuit case, is not binding on the Federal Circuit, though it may be persuasive.<sup>87</sup>

Looking at the damages provisions in the Patent Act over the years, *Swofford* showed how Congress wavered between having juries determine actual damages (1790), to setting damages at “three times the price for which the patentee has usually sold or licensed to other persons the use of said invention” (1793), to setting a damages award at “three times the actual damage sustained” (1800), to the jury determining only “actual damages,” which the court could treble in its discretion

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deeming claim construction a purely legal issue for purposes of appellate review in *Cybor Corp.* “did not follow from the Seventh Amendment analysis employed by the Supreme Court in its *Markman* decision. It followed from the law versus fact approach taken by the majority of the Federal Circuit in its *Markman* decision, an approach which the Supreme Court expressly refused to apply in its *Markman* analysis.”; *id.* at 369 (explaining that “the Federal Circuit majority in *Hilton Davis* completely ignored the Seventh Amendment” when holding that the doctrine of equivalents was a jury issue).

<sup>83</sup> *Markman v. Westview Instruments*, 517 U.S. 370, 377 (1996).

<sup>84</sup> *Id.* at 376 (quoting *Tull v. United States*, 481 U.S. 412, 422 (1987)).

<sup>85</sup> *Swofford v. B & W, Inc.*, 336 F.2d 406 (5th Cir. 1964). At least one other case has relied on *Swofford*’s conclusions without independently assessing them. See *Avia Grp. Int’l v. Nike, Inc.*, CV. No. 91-326-JU 1991 U.S. Dist. LEXIS 20492 \* (D. Or. Sept. 17, 1991) (“After both a detailed analysis of the language of 35 U.S.C. § 284 and prior patent case law, the leading case on this issue held that there is no constitutional right to a jury trial on issues under either § 284 or § 285.”).

<sup>86</sup> *Swofford*, 336 F.2d at 412 (“Quite to the contrary, the cases indicate that Congress has fluctuated, with approval by the Supreme Court, between jury trial and no jury trial on the question of exemplary damages in patent actions.”).

<sup>87</sup> *Amerikohl Mining, Inc. v. United States*, 899 F.2d 1210, 1214 (Fed. Cir. 1990) (“Although decisions from other circuits are not binding on this court, we may look to another circuit for guidance and may be persuaded by its analysis.”).

(1836, 1870) as it does under today's § 284.<sup>88</sup> *Swofford*, though instructive in showing that juries had historically not been asked to enhance actual damages, was seeking to determine whether a right to a jury trial on *enhanced damages* existed, not whether a right to a jury trial only on the predicate *willfulness* determination existed.<sup>89</sup>

As Janice Mueller later concluded from her own historical analysis, given that “juries were ‘still new to the field’ of patent litigation” in 1791, “it is unlikely that English juries [at that time] were being asked to determine first, whether there was infringement, and second, whether that infringement was willful. The early English cases discussed by the *Markman* Court do not suggest that the notion of willfulness even existed in 1791.”<sup>90</sup> Tracing the same statutory history as *Swofford*, Mueller agreed that the Patent Act of 1790 in effect when the Seventh Amendment was ratified provided no power to a jury to award punitive or enhanced damages—only actual damages.<sup>91</sup> The concept of enhanced actual damages in patent litigation first showed up in the Patent Act of 1836, and was expressly to be determined by the trial

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<sup>88</sup> *Swofford*, 336 F.2d at 412–13; *see also* *Seymour v. McCormick*, 57 U.S. 480, 488–89 (1853) (“For there is no good reason why taking a man’s property in an invention should be trebly punished, while the measure of damages as to other property is single and actual damages. It is true, where the injury is wanton or malicious, a jury may inflict vindictive or exemplary damages, not to recompense the plaintiff, but to punish the defendant. In order to obviate this injustice, the Patent Act of 1836 confines the jury to the assessment of ‘actual damages.’ The power to inflict vindictive or punitive damages is committed to the discretion and judgment of the court within the limit of trebling the actual damages found by the jury.”).

<sup>89</sup> *Swofford*, 336 F.2d at 411 (“The plaintiffs contend that they are entitled to a jury trial on the issue of exemplary damages by virtue of 35 U.S.C. § 284 (1958) and the Seventh Amendment to the Constitution. We do not agree.”).

<sup>90</sup> Mueller, *supra* note 80, at 224–25; *see also* *Swofford*, 336 F.2d at 413 (discussing history of Patent Acts of 1790, 1836, and 1870, as interpreted by the Supreme Court, none of which allocated any power to a jury concerning enhanced damages); John B. Pegram, *The Willful Patent Infringement Dilemma and the 7th Amendment*, 86 J. PAT. & TRADEMARK OFF. SOC’Y 271, 280 (2004) (“No [pre-1791] case was found in which a British jury addressed the issue of increased awards or punitive damages in patent infringement cases.”).

<sup>91</sup> *See* Act of Apr. 10, 1790, ch. 7, § 4, 1 Stat. 109, 111 (providing that those found to infringe a patent “shall forfeit and pay to the said patentee or patentees, his, her or their executors, administrators or assigns such damages as shall be assessed by a jury, and moreover shall forfeit to the person aggrieved, the thing or things so devised, made, constructed, used, employed or vended, contrary to the true intent of this act, which may be recovered in an action on the case founded on this act”); *Swofford*, 326 F.2d at 412–13.



judge, not the jury.<sup>92</sup> Other commentators have similarly been unable to identify any instances of willfulness being tried to juries before the Seventh Amendment.<sup>93</sup>

Thus, the historical record does not appear to support a preexisting right to a jury trial on the issue of willfulness. We must look to analogous precedent.

### 3. Analogous Precedent

According to *Markman*, “when, as here, the old practice provides no clear answer, we are forced to make a judgment about the scope of the Seventh Amendment guarantee without the benefit of any foolproof test.”<sup>94</sup> Under this test “[w]here there is no exact antecedent, the best hope lies in comparing the modern

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<sup>92</sup> Mueller, *supra* note 80, at 224–25 (“The Patent Act of 1836 is the first time we see the concept of enhancement of actual damages, and that enhancement determination is assigned exclusively to the judge.”) (quoting Patent Act of 1836, § 14 “[I]t shall be in the power of the Court to render judgement for any sum above the amount found by such verdict as the actual damages sustained by the plaintiff, not exceeding three times the amount thereof, according to the circumstances of the case.”). Mueller further explains that:

[i]n checking a number of the cases from the 1800s that are cited by [Professor William Robinson’s influential 1890 patent law treatise], I did not find any in which the jury was specifically asked to determine if infringement was wanton or willful. Willfulness simply was not part of the jury charge. Rather, the willfulness determination seemed to be inextricably part of the judge’s decision to enhance or not enhance the amount of actual damages.

*Id.*; see also *Swofford*, 336 F.2d at 412–13.

<sup>93</sup> See, e.g., Herda, *supra* note 72, at 192–94 (“The issue of willfulness or willful patent infringement was not addressed in patent infringement cases recorded in the English Reports between 1740 and 1800.”); Howard Wisnia & Thomas Jackman, *Reconsidering The Standard For Enhanced Damages In Patent Cases In View Of Recent Guidance From The Supreme Court*, 31 SANTA CLARA COMPUTER & HIGH TECH. L.J. 461 (2015) (explaining that “[a] review of pre-Seventh Amendment law does not reveal whether a jury was expected to determine if patent infringement was willful,” but that “[t]here is no direct corollary [of willfulness in copyright law] to pre-1791 patent law, which lacks an analogous willfulness provision”); Louis L. Wu, *Enhanced Damages for Willful Patent Infringement—An Issue for Judge or Jury?*, 33 U.S.F. L. REV. 435, 437–39 (1999).

<sup>94</sup> *Markman v. Westview Instruments*, 517 U.S. 370, 377 (1996). Though *Markman* suggests that the historical test can be “foolproof,” history can often be more equivocal than we might like it to be, leaving the historical test inconclusive. See Fleming James, Jr., *Right to a Jury Trial in Civil Actions*, 72 YALE L.J. 655 (1963) (“On the practical level, it appears that history is sometimes equivocal. Moreover, even where history is clear, analogies drawn from the divided procedure [between law and equity] cannot be matched exactly with the situations that arise under a merged procedure, so that the precise application of history is hard or even impossible.”).

practice to earlier ones whose allocation to court or jury we do know, seeking the best analogy we can draw between an old and the new.”<sup>95</sup>

In *Markman*, the issue of claim construction was deemed properly resolved by the court, rather than the jury, in large part because no historical antecedents for claim construction existed—peripheral, sentence-form claiming practice did not even arise until well into the 19th century.<sup>96</sup> Thus, the Court considered analogous precedent and functional considerations of efficiency and capability before allocating claim construction to judges instead of juries.<sup>97</sup>

Here, a high-level comparison can be made between enhanced damages under § 284 and punitive damages at common law, as both are damages awarded to punish bad actors and deter future misconduct, and both go beyond what is required to compensate the plaintiff for any harm caused.<sup>98</sup> Punitive damages have a long history of being awarded in courts of law by juries.<sup>99</sup> But willfulness is one step removed from the “punitive” enhanced damages award because a finding of willfulness does

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<sup>95</sup> *Markman*, 517 U.S. at 378.

<sup>96</sup> *Id.* at 379 (“Claim practice did not achieve statutory recognition until the passage of the Act of 1836, and inclusion of a claim did not become a statutory requirement until 1870. Although, as one historian has observed, as early as 1850 ‘judges were . . . beginning to express more frequently the idea that in seeking to ascertain the invention “claimed” in a patent the inquiry should be limited to interpreting the summary, or “claim,” the idea that the claim is just as important if not more important than the description and drawings did not develop until the Act of 1870 or thereabouts.’”) (citations omitted).

<sup>97</sup> *See id.* at 384 (“Since evidence of common-law practice at the time of the framing does not entail application of the Seventh Amendment’s jury guarantee to the construction of the claim document, we must look elsewhere to characterize this determination of meaning in order to allocate it as between court or jury. We accordingly consult existing precedent to the text of the note and consider both the relative interpretive skills of judges and juries and the statutory policies that ought to be furthered by the allocation.”).

<sup>98</sup> *See Wu*, *supra* note 93, at 442.

<sup>99</sup> *Atl. Sounding Co. v. Townsend*, 557 U.S. 404, 409–10 (2009) (“Punitive damages have long been an available remedy at common law for wanton, willful, or outrageous conduct. . . . Although some States elected not to allow juries to make such awards, the vast majority permitted them. By the middle of the 19th century, ‘punitive damages were undoubtedly an established part of the American common law of torts [and] no particular procedures were deemed necessary to circumscribe a jury’s discretion regarding the award of such damages, or their amount.’”) (citations omitted); Herda, *supra* note 72, at 195–98 (arguing that “[i]ncreased damages under 284 are analogous to punitive damage awards,” and that “[a]lthough there is no direct antecedent to the practice of finding willful patent infringement, a jury determination is necessary because the finding of willfulness is analogous to a jury determining whether to award punitive damages in actions tried at law in 1791”); Wu, *supra* note 93, at 442 (“Considerations relevant for awarding enhanced damages for willful patent infringement are similar to those for awarding common law punitive damages.”).

not itself command any enhanced damages.<sup>100</sup> Thus, an examination of historical punitive damages practices better serves to address whether juries should decide the ultimate enhanced damages question (which we would answer in the negative<sup>101</sup>), rather than only the underpinnings like willfulness. The mere fact that the “punitive” damages of § 284 and its predecessors (1836 ff.) are really enhanced actual damages, and are limited to a trebling, also weakens the analogy to punitive damages at common law, which were essentially unlimited as long as they were awarded for purposes of punishment and deterrence.<sup>102</sup>

Another high-level approach could be to recognize, as the Federal Circuit has, that willfulness is essentially a “classical . . . question of intent,” and thus a question of “fact” for the jury rather than a legal question for the judge.<sup>103</sup> Indeed, willfulness, being a blameworthy act of civil misconduct, has been treated as a factual jury

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<sup>100</sup> See *supra* Part III.

<sup>101</sup> At least one observer has concluded that historical jury awards of punitive damages justifies having juries decide not only willfulness, but the ultimate enhancement of damages as well. See Wu, *supra* note 93, at 437 (concluding, in part based on the analogy to punitive damages, that “there is a constitutional right to a jury determination of the amount of enhanced damages for willful patent infringement”). But see Herda, *supra* note 72, at 217 (“[I]t would be appropriate to hold that there is no right to a jury trial on the amount of the increase even when holding that there is the right to a jury trial on willfulness.”). We find that conclusion difficult to support in light of the lack of any pre-1836 precedent for enhanced actual damages and the clear text of § 284, which distinguishes between the actual damages assessed by the “jury” that may be enhanced by the “court.” See Wu, *supra* note 93, at 442 (explaining how “the court” has the power to enhance damages, but that [§] 284 elsewhere gives permission to “the jury” to find actual damages).

<sup>102</sup> See DAN B. DOBBS, PAUL T. HAYDEN & ELLEN M. BUBLICK, *THE LAW OF TORTS* § 35.4 (2d ed. 2017) (“The traditional common law punitive damage awards are open ended, however, without any particular limit in amount. No objective measure for such damages exists.”).

<sup>103</sup> *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1250 (Fed. Cir. 1989) (citing *Hammerquist v. Clarke’s Sheet Metal, Inc.*, 658 F.2d 1319, 1325 (9th Cir. 1981) (“[B]ecause willful infringement involves a mental state peculiarly in the realm of jury judgment, the jury could properly have found on the basis of evidence before it that Clarke willfully infringed Hammerquist’s patent.”); *National Presto Indus. v. West Bend Co.*, 76 F.3d 1185, 1192 (Fed. Cir. 1996) (“Liability for willfulness of infringement turns on considerations of intent, state of mind, and culpability. We need not belabor that these are questions of fact.”); *Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 822 (Fed. Cir. 1992) (“Whether infringement is willful is a question of fact, and the jury’s determination as to willfulness is therefore reviewable under the substantial evidence standard.”).

question in both copyright cases<sup>104</sup> and trademark cases.<sup>105</sup> This view accords with how intent is generally treated in the criminal context, and for good reason.<sup>106</sup> Where “moral blame,” or culpable mindset, is required to justify some penalty, a jury trial supposedly reflects the will of the community and acts as a check on judicial power that promotes fairness.<sup>107</sup>

However, unlike many situations where moral blame depends on a “reasonable person” standard, willful patent infringement implicates legal decisions most of the time.<sup>108</sup> The quality of one’s counsel’s opinion, the strength of one’s invalidity defenses or claim construction positions, or one’s litigation conduct, for example, can all affect the willfulness determination.<sup>109</sup> The question of willfulness may have more to do with how a reasonable *lawyer* (or patent lawyer) would behave, with one’s conduct (e.g., the tone of licensing discussions) being inextricably intertwined with legal judgments. This is especially true because many of the grounds for willfulness do not even arise until after the possibility of infringement is known (or after litigation has commenced) and lawyers are involved. With such legally-charged

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<sup>104</sup> See 17 U.S.C. § 504(c) (2012) (allowing for increased statutory damages if infringement is found to be “willful”); *Yurman Design, Inc. v. P.A.J., Inc.*, 262 F.3d 101, 112 (2d Cir. 2001) ([W]illfulness amounts to “reckless disregard” in the copyright context, and noting that “[w]e review the jury’s findings of willfulness under the same deferential Rule 50 standard that applies to factual determinations pertinent to liability.”); *Feltner v. Columbia Pictures Tel.*, 523 U.S. 340, 355 (1998) (“[T]he Seventh Amendment provides a right to a jury trial on all issues pertinent to an award of statutory damages under § 504(c) of the Copyright Act, including the amount itself.”).

<sup>105</sup> See, e.g., *Louis Vuitton Malletier, S.A. v. Akanoc Solutions, Inc.*, 658 F.3d 936, 941 (9th Cir. 2011) (“The case went to trial and the jury returned a verdict for Louis Vuitton, holding Akanoc, MSG, and Chen liable for contributory infringement of thirteen of Louis Vuitton’s trademarks, and of two of Louis Vuitton’s copyrights. The jury also found that Defendants acted willfully. The jury awarded \$10,500,000 in statutory damages for willful contributory trademark infringement of the thirteen trademarks against each defendant, for a total of \$31,500,000.”).

<sup>106</sup> See, e.g., *Morrisette v. United States*, 342 U.S. 246, 274 (1952) (“Where intent of the accused is an ingredient of the crime charged, its existence is a question of fact which must be submitted to the jury.”).

<sup>107</sup> Ann Hopkins, Comment, *Mens Rea and the Right to Trial by Jury*, 76 CAL. L. REV. 391, 420 (1988) (quoting *Duncan v. Louisiana*, 391 U.S. 145, 156 (1967) (“[T]he jury trial provisions in the Federal and State Constitutions reflect a fundamental decision about the exercise of official power—a reluctance to entrust plenary powers over the life and liberty of the citizen to one judge or to a group of judges. Fear of unchecked power, so typical of our State and Federal Governments in other respects, found expression in the criminal law in this insistence upon community participation in the determination of guilt or innocence.”)).

<sup>108</sup> See *supra* Part III.

<sup>109</sup> *Id.*

considerations, the question of patent willfulness is arguably more legal than factual.<sup>110</sup>

Further, to the extent § 284 willfulness and damages enhancement is analogous to common-law punitive damages, the Supreme Court has held that “the level of punitive damages is not really a ‘fact’ ‘tried’ by the jury” for purposes of the reexamination clause of the Seventh Amendment.<sup>111</sup> In part because punitive damages, like enhanced damages for willfulness, are based on “deterrence calibration,” appellate courts can revisit such findings in ways that they cannot revisit true “historical facts” like actual damages.<sup>112</sup> But, ultimately, as the Court later held in *Markman*, identifying as an issue of fact versus law does not draw a close enough historical analogy to conclude the Seventh Amendment analysis.<sup>113</sup>

The closest analogous historical precedent on the right to a jury trial for willfulness is arguably that addressed in *Feltner v. Columbia Pictures*, where the Supreme Court found a Seventh Amendment right to a jury trial on enhanced statutory damages for willfulness in copyright cases.<sup>114</sup> *Feltner* “recognized the

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<sup>110</sup> See *infra* Part III (discussing functional considerations for how juries are ill equipped to decide the legal questions implicated in the willfulness analysis).

<sup>111</sup> *Cooper Indus. v. Leatherman Tool Grp., Inc.*, 532 U.S. 424, 437 (2001) (“Because the jury’s award of punitive damages does not constitute a finding of ‘fact,’ appellate review of the District Court’s determination that an award is consistent with due process does not implicate the Seventh Amendment concerns raised by respondent and its amicus.”).

<sup>112</sup> *Id.*; but cf. *Capitol Records, Inc. v. Thomas-Rasset*, 692 F.3d 899, 907–08 (8th Cir. 2012) (suggesting that copyright statutory damages do not raise the same due process questions as punitive damages).

<sup>113</sup> *Markman v. Westview Instruments*, 517 U.S. 370, 378 (“The ‘substance of the common-law right’ is, however, a pretty blunt instrument for drawing distinctions. We have tried to sharpen it, to be sure, by reference to the distinction between substance and procedure. . . . We have also spoken of the line as one between issues of fact and law. . . . But the sounder course, when available, is to classify a mongrel practice (like construing a term of art following receipt of evidence) by using the historical method, much as we do in characterizing the suits and actions within which they arise.”); *id.* at 384 n.10 (“Because we conclude that our precedent supports classifying the question as one for the court, we need not decide either the extent to which the Seventh Amendment can be said to have crystallized a law/fact distinction . . . or whether post-1791 precedent classifying an issue as one of fact would trigger the protections of the Seventh Amendment if (unlike this case) there were no more specific reason for decision.”); accord *Herlihy*, *supra* note 16, at 348 (“[W]hile the Court [in *Markman*] considered factors beyond those falling within the traditional historical test, the Court expressly stated that its Seventh Amendment decision was not based on the application of a fact versus law test.”).

<sup>114</sup> See *Wu*, *supra* note 93, at 452 (“Since copyright law is similar to patent law, the *Feltner* decision is applicable to the issue of whether juries should also determine enhanced damages in willful patent infringement cases.”); *Wisnia & Jackman*, *supra* note 93, at 474 (“Because there is no direct corollary to pre-1791 patent law, which lacks an analogous willfulness provision, a review of the closest 18th-century

‘general rule’ that monetary relief is legal, and an award of statutory damages may serve purposes traditionally associated with legal relief, such as compensation and punishment.”<sup>115</sup> But the Court also found that there was a clear historical background (predating the Constitution and the Seventh Amendment) of juries determining appropriate amounts of statutory damages within prescribed ranges.<sup>116</sup> Although that recounted history does not expressly involve statutory damages thresholds set by findings of willfulness per se, the presence of willfulness in the modern statute has been swept in by the Court’s broad holding that “the Seventh Amendment provides a right to a jury trial on *all issues* pertinent to an award of statutory damages under § 504(c) of the Copyright Act, including the amount itself.”<sup>117</sup>

*Feltner* is arguably instructive on the question of jury-trial rights for patent willfulness because copyright and patent law are parallel bodies, having originated in the same constitutional provision against parallel common law backgrounds, and having similar objectives to promote progress of artistic works and technology, respectively, via exclusive rights.<sup>118</sup> *Feltner*’s precedent is also arguably analogous to the concept of willfulness in patent litigation because both copyright and patent

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analogue is the next step, which in this case appears to be willful copyright infringement [and *Feltner* in particular].”).

<sup>115</sup> *Feltner v. Columbia Pictures Tel.*, 523 U.S. 340, 352 (1998) (first citing *Curtis v. Loether*, 415 U.S. 189, 196 (1974) (Actual damages are a “traditional form of relief offered in the courts of law.”); then quoting *Tull v. United States*, 481 U.S. 412, 422 (1987) (“Remedies intended to punish culpable individuals . . . were issued by courts of law, not courts of equity.”)); *see also Feltner*, 523 U.S. at 352 (“Nor, as we have previously stated, is a monetary remedy rendered equitable simply because it is ‘not’ fixed or readily calculable from a fixed formula.”).

<sup>116</sup> *See Feltner*, 523 U.S. at 349–53 (discussing history of copyright jury trials, noting that some state actions predating the Constitution “specifically authorized an award of damages from a statutory range, just as § 504(c) does today”); *id.* at 355 (“[T]here is clear and direct historical evidence that juries, both as a general matter and in copyright cases, set the amount of damages awarded to a successful plaintiff.”).

<sup>117</sup> *Feltner*, 523 U.S. at 355 (emphasis added). Section 504(c) provides that if infringement is willful, the statutory damages may be increased beyond \$30,000 up to \$150,000. *See also* 5-14 NIMMER ON COPYRIGHT § 14.04 (“Seventh Amendment concerns require that the ‘court’ to make the willfulness determination be the jury. Insofar as the question of willfulness is inextricably bound up with determining the amount of statutory damages, it would seem to lie beyond the judge’s competence to set the amount of such damages; rather, the parties are entitled to a jury verdict on this score.”).

<sup>118</sup> *See* U.S. CONST. art. I, § 8, cl. 8 (“To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”); Wisnia & Jackman, *supra* note 93, at 475; Wu, *supra* note 93, at 447 (“Copyrights, like patents, are forms of intellectual property. Historically, both American copyright and patent law have roots in eighteenth century English common law. Although the two bodies of law differ in nature—copyright law promotes learning whereas patent law promotes technology—many factors tend to favor that they be treated similarly.”).

willfulness increase damages due to similar types of culpable conduct.<sup>119</sup> For some, these parallels all but demand that willfulness in patent litigation go to the jury.<sup>120</sup>

However, § 284 concerns an enhancement of actual damages, which reflect compensation for “pecuniary loss” suffered by the patentee,<sup>121</sup> while statutory damages under the Copyright Act represent prescribed sums of money provided by § 504(c) to be paid for infringement (per copyrighted work) that may or may not reflect the degree of harm suffered by the copyright owner.<sup>122</sup> This fundamental difference is underscored by the fact that the Copyright Act expressly deems statutory damages an alternative to actual damages that copyright owners may elect to recover.<sup>123</sup> Actual damages do not depend on an infringer’s innocence or willfulness.<sup>124</sup> While the amount of statutory damages may be higher for

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<sup>119</sup> Compare *supra* Part III (discussing willfulness in patent cases), with 5-14 NIMMER ON COPYRIGHT § 14.04 (discussing how willfulness in copyright law involves knowledge that one’s conduct constitutes copyright infringement or reckless disregard of that fact, or otherwise wanton conduct).

<sup>120</sup> See, e.g., Wisnia & Jackman, *supra* note 93, at 478 (“Given the strong historical and statutory correlation between patent and copyright law, the Supreme Court’s analysis in *Feltner* does not leave a lot of room for a different conclusion as it relates to the discretionary determination of the damage amount under § 284. Accordingly, the entire § 284 inquiry is likely a matter for the jury.”); Wu, *supra* note 93, at 447–57 (“Since copyright and patent law warrant similar legal analysis, *Feltner* raises a strong inference of a similar constitutional right for a jury determination of enhanced damages for willful patent infringement. . . . [C]ase law indicates that litigants generally have a right to a jury determination of the amount of enhanced damages for patent infringement if the right is timely asserted. As evidenced by *Feltner*, the Supreme Court favors such a right.”).

<sup>121</sup> *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476, 507 (1965) (“[Damages] have been defined by this Court as ‘compensation for the pecuniary loss he [the patentee] has suffered from the infringement, without regard to the question whether the defendant has gained or lost by his unlawful acts.’ *Coupe v. Royer*, 155 U.S. 565, 582 (1895). They have been said to constitute ‘the difference between his pecuniary condition after the infringement, and what his condition would have been if the infringement had not occurred.’ *Yale Lock Mfg. Co. v. Sargent*, 117 U.S. 536, 552 (1886). The question to be asked in determining damages is ‘how much had the Patent Holder and Licensee suffered by the infringement. And that question [is] primarily: had the Infringer not infringed, what would Patent Holder-Licensee have made?’ *Livesay Window Co. v. Livesay Industries, Inc.*, 251 F.2d 469, 471 (5th Cir. 1958).”).

<sup>122</sup> 17 U.S.C. § 504(c) (2012).

<sup>123</sup> 17 U.S.C. § 504(c) (2012) (“[T]he copyright owner may elect, at any time before final judgment is rendered, to recover, instead of actual damages and profits, an award of statutory damages for all infringements involved in the action.”); 5-14 NIMMER ON COPYRIGHT § 14.02 (“Actual damages represent the extent to which infringement has injured or destroyed the market value of the copyrighted work at the time of infringement.”).

<sup>124</sup> See 5-14 NIMMER ON COPYRIGHT § 14.02 [A] (“Actual damages represent the extent to which infringement has injured or destroyed the market value of the copyrighted work at the time of

infringement deemed willful under § 504, this is not the same as enhancing a determination of actual damages that was first calculated to reflect actual harm.

Even if juries historically assessed both statutory copyright damages and actual patent damages at the time of the Seventh Amendment,<sup>125</sup> the 1790 Copyright Act made no mention of willfulness-based calculations or ranges of statutory damages (thus neither does *Feltner*),<sup>126</sup> and the very different concept of a willfulness-based enhancement of actual damages in patent cases did not arise until 1836.<sup>127</sup> Thus, historical evidence that juries set statutory damages in copyright (which so happens to now have a willfulness component to it) does not support the notion that juries would also assess willfulness in other contexts, such as enhancement of actual patent damages—again, a concept that did not exist until 1836 and has never been within the purview of the jury. Had the modern § 284 been more like the Patent Act of 1793, for example, where the patentee’s recovery was statutorily set at “three times the price for which the patentee has usually sold or licensed to other persons the use of said invention,” such recovery is less tethered to actual damages and would be more analogous to *Feltner* and copyright’s statutory damages.<sup>128</sup>

Because of these substantive distinctions, copyright statutory damages (even those in the willfulness range) also differ procedurally from patent enhanced damages. While the former involves one determination of an amount within an appropriate range of permissible damages,<sup>129</sup> the latter involves two determinations—a finding of actual damages, then a discretionary enhancement of those actual damages.<sup>130</sup> This distinction makes damages and willfulness/

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infringement.”); *id.* n.8 (“It would seem that injury to plaintiff in the marketplace does not hinge on defendant’s innocence or willfulness.”).

<sup>125</sup> See Act of Apr. 10, 1790, ch. 7, § 4, 1 Stat. 109, 111.

<sup>126</sup> See Act of May 31, 1790, ch. 15, §§ 2, 6, 1 Stat. 124, 125; *Feltner v. Columbia Pictures TV*, 523 U.S. 340, 351 (1998).

<sup>127</sup> Mueller, *supra* note 80, at 224–25.

<sup>128</sup> *Swofford v. B & W, Inc.*, 336 F.2d 406, 412–13 (5th Cir. 1964).

<sup>129</sup> See 17 U.S.C. § 504(c) (2012) (providing for a single discretionary determination of statutory damages, where the damages amount may be increased if the infringement is willful or decreased if innocent).

<sup>130</sup> See 35 U.S.C. § 284 (2012) (“Upon finding for the claimant the court shall award the claimant *damages adequate to compensate for the infringement* . . . . In either event the court may increase *the damages* up to three times the amount found or assessed.”) (emphasis added). A similar distinction can be made with respect to punitive damages, which do not necessarily depend on a first determination of actual damages. See Wu, *supra* note 93, at 443 (“Despite these similarities, an award of enhanced damages for willful infringement differs procedurally from an award of punitive damages. For example, the statutory language



enhancement more easily separable in patent cases than copyright cases. And, significantly, the statute in *Feltner* referred only to the “court” making the statutory damages determination, which arguably can refer to a judge or jury,<sup>131</sup> while § 284 expressly distinguishes between the “court” and the “jury,” referring only to the court for purposes of enhancing damages.

Because analogies to *Feltner* and other precedent are not particularly apt, it is appropriate to consider other functional and practical considerations of whether the question of willfulness is better posed to the judge or jury.

#### 4. Functional Considerations

As explained in *Markman*, “[w]here history and precedent provide no clear answers, functional considerations also play their part in the choice between judge and jury to define terms of art.”<sup>132</sup> This sub-part lays out the various implications of having juries decide willfulness.

As a threshold matter, recall that a finding of willfulness in a patent case does not, by itself, compel any enhanced damages.<sup>133</sup> The district court, in its sole discretion, decides whether a case is sufficiently egregious to warrant enhanced damages.<sup>134</sup> Willfulness is not legally relevant to the jury’s infringement or damages verdict,<sup>135</sup> but only to this separate judicial act of enhancing those actual damages.

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of 284 provides that the court may award enhanced damages but is silent on the role of the jury. In contrast, punitive damages at common law are within the discretion of the jury.”)

<sup>131</sup> *Feltner*, 523 U.S. at 357 (Scalia, J., concurring) (“The text of § 504(c) lacks such clear indications that ‘court’ is being used in its broader sense. But their absence hardly demonstrates that the broader reading is not ‘fairly possible.’”). One commentator, following Justice Scalia’s reasoning, suggests that this broad reading of “court” indicates that juries can properly decide to enhance damages under § 284. Wu, *supra* note 93, at 453 (“If ‘judge or jury’ were substituted for ‘court’ in the second sentence of the second paragraph of 284, the sentence would read: ‘In either event the judge or jury may increase the damages up to three times the amount assessed.’”). This reading of § 284 is problematic because interpreting “court” to mean “judge or jury” would make the preceding sentence include a redundancy: “When the damages are not found by a jury, the [judge or jury] shall assess them.”

<sup>132</sup> *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388 (1996).

<sup>133</sup> *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1342 (Fed. Cir. 2016).

<sup>134</sup> *Id.* (“The district court has the discretion to decide whether the case is sufficiently egregious to warrant enhancing damages and to decide the amount of enhancement that is warranted (up to the statutory limit of treble damages). And the Court explained, ‘none of this is to say that enhanced damages must follow a finding of egregious misconduct.’ *Halo*, 136 S. Ct. at 1933.”).

<sup>135</sup> *See* 35 U.S.C. § 271(a) (2012) (defining infringement: “Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United

This two-step procedure immediately signals that there is no reason that the same entity *must* decide both willfulness and enhanced damages. But there appear to be important reasons why juries may be ill-suited to make willfulness determinations, and that the policies behind § 284 are better served by reserving willfulness issues for the court to decide.

First, allowing juries to even consider willfulness may “taint the jury’s finding on the threshold question of liability.”<sup>136</sup> As one prominent patent litigator explained, “[t]he state of mind of the alleged infringer is not relevant to the underlying issues of infringement and invalidity. Such evidence, however, can be used to confuse the issues at trial and to discredit the alleged infringer in the eyes of the jury.”<sup>137</sup> Put another way, casting a bad light on the defendant might make non-infringing conduct seem like infringement<sup>138</sup> or make an invalid patent seem valid. Juries might also

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States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.”).

<sup>136</sup> Mueller, *supra* note 80, at 227.

<sup>137</sup> Matthew D. Powers & Steven C. Carlson, *The Evolution and Impact of the Doctrine of Willful Patent Infringement*, 51 SYRACUSE L. REV. 53, 111 (2001); *see also* Samuel Chase Means, Note, *The Trouble with Treble Damages: Ditching Patent Law’s Willful Infringement Doctrine and Enhanced Damages*, 2013 U. ILL. L. REV. 1999, 2024–25 (2013) (“If the jury no longer decided willfulness, there is no longer a need to present evidence related to willfulness to the jury, so issues at trial can be restricted to infringement and actual damages. This could also reduce prejudice, because willfulness evidence has the potential to confuse other issues and discredit an alleged infringer. Even more benefits can be derived from this approach if willfulness is decided by the judge after the trial, and the issue may even be decided after liability for infringement is conclusively determined on appeal.”).

<sup>138</sup> Curiously, trademark law allows evidence of bad faith to be probative essentially for this purpose. “Most circuits find that where a defendant adopted its mark intending to copy the plaintiff’s mark and benefit from the plaintiff’s reputation, the court may infer that there is in fact confusing similarity between the marks.” 1 ANNE GILSON LALONDE, GILSON ON TRADEMARKS § 5.09 (Matthew Bender ed., 2017) (“The Seventh Circuit has simply held that a court will be ‘more inclined’ to find confusing similarity where a defendant ‘willfully appropriates the mark of another.’ The Ninth Circuit has alternated between declaring that intent to confuse is entitled to ‘great weight’ and stating that such an intent leads to a presumption of likely confusion. The Tenth Circuit has held that ‘[e]vidence of intent to copy does not create a rebuttable presumption of likelihood of confusion’ but is instead just one of the factors in the confusion analysis. The court interpreted its precedent as creating a ‘permissive’ inference of likely confusion, though that inference may be strong. Where proof of intentional infringement is introduced, the burden shifts to the defendant to rebut the presumption with an affirmative showing of lack of confusion.”). The logic of this approach is questionable. *See* 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:110 (4th ed. 2017) (“The issue in determining trademark infringement is whether there is a likelihood of confusion. This focuses upon the state of mind of the target group of customers, not upon the state of mind of the junior user. As Professor Perlman has observed: ‘What the defendant was thinking is poor evidence of what consumers were likely to have been thinking.’ Casagrande proposed that ‘intent should be excised from the confusion analysis’ altogether. He argued that the junior user’s intent has no bearing on what consumers perceive and including it unduly raises the

reach improper compromises, such as “trad[ing] a finding of ‘no willfulness’ for a doubling of the damages award”<sup>139</sup> or tipping a close case from “non-infringement” to “infringement” by taking willfulness off of the table.

Evidence suggests that juries may be too easily swayed to find willfulness. From 1983 to 2000, when willfulness was decided juries found willfulness 68.1% of the time, while judges found willfulness in bench trials only 53.7% of the time.<sup>140</sup> Janice Mueller interpreted this disparity as suggesting “either that juries are more easily swayed by ‘bad actor’ portrayals of accused infringers or perhaps simply that the standard for willfulness is amorphous enough to permit juries to be swayed so frequently.”<sup>141</sup> But, because judges still make the ultimate determinations of enhancing damages, they can operate as a “check” on improper jury propensity to find willfulness by declining to enhance damages.<sup>142</sup>

Second, judges are better able to appreciate the legal and practical context surrounding certain willfulness allegations in the first instance. Facts relevant to willfulness often relate to conduct by the defendant during the litigation, such as the

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duration and expense of litigation because litigators spend substantial time and effort on discovery into facts that could support an inference of intent to confuse.”). The rationale assumes that an intent to confuse is likely to successfully cause confusion because “the defendant ought to know at least as much about the likelihood of confusion as the trier of fact.” *Id.* (quoting Sixth Circuit). But the patent context is concerned not with perception but with technical identity between the patent claims and the accused product. To the extent it is probative at all, a subjective belief of trademark confusion is far more indicative of consumer confusion than willfulness is of technical identity. After all, a wide range of behavior can result in a “willfulness” finding under *Halo* that falls short of a specific intent to infringe. *See McCarthy, supra* Part III (noting, e.g., the competency of an opinion of counsel, litigation misconduct, and the quality of one’s invalidity defenses as potential grounds for willfulness).

<sup>139</sup> Mentor Graphics Brief, *supra* note 73, at 25.

<sup>140</sup> Mueller, *supra* note 80, at 227 (citing study by then Professor Kimberly Moore, who is now a Federal Circuit judge).

<sup>141</sup> *Id.*

<sup>142</sup> *Id.*; *see, e.g.*, Trustees of Boston Univ. v. Everlight Elecs. Co., Nos. 12-11935, 12-12326, 12-12330, 2016 U.S. Dist. LEXIS 96045, at \*11–12 (D. Mass. July 22, 2016) (“Assuming without deciding that the jury’s verdict, based on the subjective prong of the now-overruled Seagate test, is sufficient to find subjective willfulness, the Court still finds, in its discretion, that the defendants’ conduct did not rise to the level of egregiousness meriting an award of enhanced damages.”); Presidio Components, Inc. v. Am. Tech. Ceramics Corp., No. 14-cv-02061, 2016 U.S. Dist. LEXIS 110212, at \*36–37 (S.D. Cal. Aug. 17, 2016) (“Moreover, the Court notes that ATC’s motion on this issue is essentially moot because the Court, exercising its sound discretion, ultimately declines to award Presidio enhanced damages despite the jury’s finding of willful infringement.”).

strength of a defendant's losing claim construction position or related defenses.<sup>143</sup> A judge, having presided over multiple cases, is better positioned to appreciate that merely losing on an issue is not tantamount to misconduct.<sup>144</sup> Judges are also more capable of understanding the significance of a defendant's partial victories pre-trial (e.g., invalidating some, but not all, claims on summary judgment), as well as ambiguities or changes in the governing law.<sup>145</sup> Moreover, to avoid confusion, juries are generally shielded from such matters that are not strictly relevant to the facts they are asked to find concerning infringement and validity, including claim construction.

Willfulness claims may also be asserted based on a defendant's mere prior knowledge of a patent—e.g., from the patent being cited during the defendant's own patent prosecution effort or the consideration of a patent for research purposes—that have no necessary connection to whether infringement, if any, was willful.<sup>146</sup> Such assertions may actually cut against willfulness if the defendant's patent was deemed patentably distinct or if the defendant looked to the plaintiff's patent to design around it. Judges will better appreciate these practical realities and the balancing of patent

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<sup>143</sup> Mentor Graphics Brief, *supra* note 73, at 23 (“[J]uries necessarily are shielded from many of the circumstances relevant to willfulness. For example, they learn little or nothing about pre-trial motion practice, such as the strength of an infringer's unsuccessful claim construction positions or its defenses based on those positions. Trial judges naturally are reluctant to allow defendants to present to the jury why the judge's pre-trial rulings were wrong. Juries do not learn of the infringer's success in invalidating and/or narrowing multiple claims of the patent pre-trial. An infringer might, for example, successfully invalidate a dozen broad claims pre-trial, or in post-issuance Patent Office proceedings, but the jury sees only the surviving asserted claims.”).

<sup>144</sup> *Cf. Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-cv-1047-WCB, 2015 U.S. Dist. LEXIS 107733, at \*15 (E.D. Tex. Aug. 17, 2015) (“Such push-and-pull over the scope of claim language is common in patent litigation. The fact that plaintiffs lost that battle in this case does not by itself render their conduct sanctionable.”). *See SFA Sys., LLC v. Newegg, Inc.*, 793 F.3d 1344, 1348 (Fed. Cir. 2015) (the “correctness or eventual success” of a party's litigation position is not determinative of the attorney fee issue; “[a] party's position on issues of law ultimately need not be correct for them not to ‘stand[] out,’ or be found reasonable” (alteration in original)); *Gaymar Indus., Inc. v. Cincinnati Sub-Zero Prods., Inc.*, 790 F.3d 1369, 1373 (Fed. Cir. 2015) (“fees are not awarded solely because one party's position did not prevail”).

<sup>145</sup> Mentor Graphics Brief, *supra* note 73, at 23.

<sup>146</sup> *Id.* at 24 (“[I]t is common today for a charge of willfulness to be based on the mere citation of the asserted patent as prior art during Patent Office examination of one of the defendant's own patents. A trial judge is much better suited than a jury to appreciate the practical realities, and public policies, of our patent system when evaluating such a dubious basis for a claim of willfulness. . . . A trial judge will [also] better appreciate that there are legitimate reasons to look at a competitor's patents, and even to copy ideas described but not claimed in a patent.”).

policies that seek to punish willful infringement but encourage design-around innovation.

Further, as a willfulness determination centers on whether a defendant's conduct was "egregious . . . *beyond typical infringement*,"<sup>147</sup> presumably only judges can know whether a party's conduct significantly stands out from the norm in light of other patent infringement lawsuits. Juries would be hard pressed to have the relevant background knowledge to make an informed decision of what "typical infringement" means.

Ultimately, deferring any findings on the issue of willfulness until after liability and damages have been established (i.e., upon a post-trial hearing or motion) avoids the risk of unfair prejudice, confusion, and compromise verdicts.<sup>148</sup> Such deferral may even avoid the need to address willfulness at all if there is no infringement liability found at trial. To be sure, a second jury trial could be convened on the issue of willfulness once infringement is established, and would similarly avoid the prejudice and confusion during the liability trial.<sup>149</sup> Such bifurcation does nothing to help the jury better assess the patent law questions and lawyers' behavior involved, however, so those problems would remain. But, even if juries were equally able to assess willfulness issues as judges are, it is doubtful many judges would find it efficient and prudent to ask the jurors for this additional commitment where the right to a jury trial on willfulness is tenuous, at best.<sup>150</sup>

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<sup>147</sup> *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S. Ct. 1923, 1935 (2016) (emphasis added).

<sup>148</sup> Mueller, *supra* note 80, at 228; *Swofford v. B & W, Inc.*, 336 F.2d 406, 413 (5th Cir. 1964) ("Such a practice [of not trying enhanced damages to a jury] is commensurate with our previous direction that the questions of willfulness, deliberateness, and increased damages should properly await final judgment. More specifically, we think the better practice in all infringement cases is to delay such finding (of willful and deliberate infringement) until final judgment, and after an accounting has been had, since only then can the full nature and extent of the infringement be disclosed and a fully enlightened determination made as to whether a punitive award is justified.") (citations and internal quotation marks omitted).

<sup>149</sup> Bifurcation is permitted by Federal Rule of Civil Procedure 42, and can be an effective way to avoid unfair prejudice and boost jury comprehension. See *Weddingchannel.com, Inc. v. The Knot, Inc.*, No. 03 CIV. 7369 (RWS), 2004 U.S. Dist. LEXIS 25749, 2004 WL 2984305, at \*1 (S.D.N.Y. Dec. 23, 2004) ("To determine whether bifurcation is warranted, courts generally consider the following three factors: '1) whether significant resources would be saved by bifurcation, 2) whether bifurcation will increase juror comprehension, and 3) whether bifurcation will lead to repeat presentations of the same evidence and witnesses.'"). The Federal Circuit has emphasized that "district courts, in their discretion, may bifurcate willfulness and damages issues from liability issues in any given case." *Robert Bosch, LLC v. Pylon Mfg. Corp.*, 719 F.3d 1305, 1319 (Fed. Cir. 2013).

<sup>150</sup> Many courts find bifurcation of jury trials presumptively inefficient, holding that "[b]ifurcation in patent cases, as in others, is the exception, not the rule . . ." See, e.g., *Plew v. Limited Brands, Inc.*, 2012

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With no specific statutory guidance, no direct historical antecedent, and no compelling analogous precedent, whether willfulness should be tried to a jury likely comes down to functional considerations. Given the high probability of jury confusion and distraction from the threshold legal question of infringement, we conclude that willfulness is best tried to a judge.

The question overall turns on “whether a particular issue occurring within a jury trial is itself necessarily a jury issue, the guarantee being essential to preserve the right to a jury’s resolution of the ultimate dispute.”<sup>151</sup> Our view is that willfulness need not be tried to a jury to preserve the right to a jury trial in a patent infringement case.

### B. *Bad-Faith Enforcement as a Question for the Jury*

We have found no precedent holding that any factual underpinnings for § 285 fee-shifting are considered legal matters resolved by jury trial, including the question of whether a patent owner has enforced a patent in bad faith. We identified only two cases—the Fifth Circuit’s 1964 *Swofford* decision noted above and a very recent Federal Circuit decision—that have decided whether fee-shifting under § 285 is, as a whole, a jury question and concluded that it is not.<sup>152</sup> *Swofford* conducted no

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U.S. Dist. LEXIS 14966, at \*25 (S.D.N.Y. Feb. 6, 2012). As willfulness will sometimes involve overlapping questions about claim scope and the strength of one’s noninfringement or invalidity defenses, bifurcation may lead to some repetitive evidence being presented in a second trial. *See* Computer Assocs. Int’l, Inc. v. Simple.com., Inc., 247 F.R.D. 63, 67 (E.D.N.Y. 2007) (“The overlap of evidence on the issues of liability and willfulness in this case, heavily disfavors . . . bifurcation.”). At least two Federal Circuit judges believe that in specific cases this overlap can lead to a violation of Seventh Amendment rights if willfulness and liability were tried to two *different* juries. *See* Robert Bosch, LLC v. Pylon Mfg. Corp., 719 F.3d 1305, 1345 (Fed. Cir. 2013) (O’Malley, J., dissenting, joined by Wallach, J.) (“A bifurcation order which requires that two *different* juries visit the interwoven issues and overlapping facts involving infringement and validity on the one hand and willfulness on the other would violate the defendant’s Seventh Amendment right to a jury trial.”). We do not propose a result of trying willfulness to a fact finder that did not hear the original evidence and argument concerning liability, as the judge who decides willfulness post-trial has presided over the jury portion of the trial and heard all the evidence and argument along with the jury.

<sup>151</sup> *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 377 (1996).

<sup>152</sup> *Swofford*, 336 F.2d at 413 (“[T]he plaintiffs urge that *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 79 S. Ct. 948, 3 L. Ed. 2d 988 (1959), *Dairy Queen, Inc. v. Wood*, 369 U.S. 469, 82 S. Ct. 894, 8 L. Ed. 2d 44 (1962), and *Thermo-Stitch, Inc. v. Chemi-Cord Processing Corp.*, 294 F.2d 486 (5th Cir. 1961), logically point to the conclusion that ‘increased damages’ and attorneys’ fees are ‘elements of the general damage issue’ to be submitted to the jury for determination. We do not agree that a reading of these cases

historical analysis, only a doctrinal one, which we discuss below.<sup>153</sup> The Federal Circuit found that attorneys' fees were neither historically tried to juries nor the kind of "legal" relief that needs to be.<sup>154</sup> The Federal Circuit also found no precedent for the proposition that there could nonetheless be a right to a jury trial as to the underlying questions, such as state of mind.<sup>155</sup>

But the Federal Circuit still failed to go through the entire four-stage analysis.<sup>156</sup> As a fresh and complete inquiry, the following sub-parts perform the four-part analysis as is done above regarding willfulness to determine if the question of bad-faith enforcement is a matter for the jury to decide.

### 1. Statutory Analysis

Section 285 indicates that "[t]he court in exceptional cases may award reasonable attorney fees to the prevailing part," which typically means a judge, not a jury would ultimately decide whether to shift fees.<sup>157</sup> The fact that "[a] jury" is referred to as distinct from "the court" in the preceding § 284 supports this view.<sup>158</sup>

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leads to the conclusion that exemplary damages and attorneys' fees are jury questions as of right."); *AIA Am., Inc. v. Avid Radiopharma.*, 866 F.3d 1369 (Fed. Cir. 2017).

<sup>153</sup> *Swofford*, 336 F.2d at 413.

<sup>154</sup> *AIA Am., Inc.*, 866 F.3d at 1372–73.

<sup>155</sup> *Id.* at 1373–74 ("AIA argues that if a decision on attorney's fees involves considerations of a party's state of mind, intent, and culpability, then those questions must be presented to a jury under the Seventh Amendment. AIA, however, has pointed to no cases finding that once an issue is deemed equitable, a Seventh Amendment right to a jury trial may still attach to certain underlying determinations."); *see also id.* at 1373 ("[W]hen attorney's fees are awarded pursuant to a statutory prevailing party provision, they are regarded as an 'equitable' remedy because they raise 'issues collateral to and separate from the decision on the merits.' *Budinich v. Becton Dickinson & Co.*, 486 U.S. 196, 200 (1988).").

<sup>156</sup> *AIA Am., Inc.*, 866 F.3d at 1372–74.

<sup>157</sup> 35 U.S.C. § 285 (2012) (emphasis added); *cf.* *Feltner v. Columbia Pictures TV*, 523 U.S. 340, 346 (1998) ("In fact, the other remedies provisions of the Copyright Act use the term 'court' in contexts generally thought to confer authority on a judge, rather than a jury. *See, e.g.*, § 502 ('court . . . may . . . grant temporary and final injunctions'); § 503(a) ('the court may order the impounding . . . of all copies or phonorecords'); § 503(b) ('as part of a final judgment or decree, the court may order the destruction or other reasonable disposition of all copies or phonorecords'); § 505 ('the court in its discretion may allow the recovery of full costs' of litigation and 'the court may also award a reasonable attorney's fee'."); *Swofford*, 336 F.2d at 413 ("This section places the allowance of counsel fees within the statutory discretion of the trial judge.").

<sup>158</sup> 35 U.S.C. § 284 (2012) ("When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.").

Although “the court” makes the ultimate decision to shift fees, the “exceptional case” determination is written as a prerequisite finding or condition for the judge’s use of that power.<sup>159</sup> The statute is silent as to who decides whether a case is exceptional, but *Octane Fitness*’s “stands out from other [cases]” test strongly suggests that only the judge, who presides over many cases, is capable of making that determination.<sup>160</sup> Presumably only judges are capable of knowing whether a party’s conduct significantly stands out from that in other patent infringement lawsuits.

Bad faith, being only one component of the totality-of-the-circumstances exceptional case determination under *Octane Fitness*,<sup>161</sup> is a matter where a judge is not necessarily the only capable fact finder. But just as § 284 is silent on willfulness, § 285 is silent on bad faith, and both statutes lack any express or clear language referring to a jury trial right on the respective issues.<sup>162</sup> Ultimately, the statutory text is inconclusive and we must apply the Seventh Amendment historical test.<sup>163</sup>

## 2. Historical Test

Here, as in *Markman*, “there is no dispute that infringement cases today must be tried to a jury, as their predecessors were more than two centuries ago.”<sup>164</sup> The first part of the Court’s historical test would thus presumptively put issues in a patent case into the “legal” jury trial camp. Under the second part of the historical test, the more precise question is “whether the particular trial decision must fall to the jury in order to preserve the substance of the common-law right as it existed in 1791.”<sup>165</sup>

The so-called “English rule,” which requires a non-prevailing party to pay the attorneys’ fees of the prevailing party, “never took root in American courts” when

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<sup>159</sup> 35 U.S.C. § 285 (2012).

<sup>160</sup> *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 134 S. Ct. 1749, 1756 (2014).

<sup>161</sup> *Id.* at 1756–57.

<sup>162</sup> *Felmer*, 523 U.S. at 346.

<sup>163</sup> *Id.* at 347 (“We thus discern no statutory right to a jury trial when a copyright owner elects to recover statutory damages. Accordingly, we must reach the constitutional question.”).

<sup>164</sup> *Markman v. Westview Instruments*, 517 U.S. 370, 377 (1996).

<sup>165</sup> *Id.* at 376 (citations omitted).



the United States was founded.<sup>166</sup> Instead the United States adhered to an “American rule” where each party paid its own attorneys’ fees.<sup>167</sup>

To the extent there has been fee-shifting, it was “part of the historic equity jurisdiction of the federal courts,” tending to put the issue to a judge for resolution instead of a jury.<sup>168</sup> The Federal Circuit recently held as much, explaining that “since either a judge in the court of law or an equity court would determine attorney’s fees, this implies that attorney’s fees generally do not involve legal rights.”<sup>169</sup> But, again, the question is whether “the particular trial decision”—here, a finding of bad faith as a reason to shift fees—has a historical jury trial right associated with it predating the Seventh Amendment. On that more specific question, the Federal Circuit rejected as unprecedented the practice of trying such underlying facts to a jury for issues that are otherwise non-legal.<sup>170</sup>

Because the American rule of bearing one’s own attorneys’ fees was first deemed the law of the land in 1796,<sup>171</sup> any exceptions thereto for bad-faith litigation

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<sup>166</sup> Singer, *supra* note 28, at 695. Although called the English rule, the rule dates back to ancient Roman law. *Id.*

<sup>167</sup> *Id.*

<sup>168</sup> *Vaughan v. Atkinson*, 369 U.S. 527, 530 (1962) (quoting *Sprague v. Ticonic Bank*, 307 U.S. 161, 164 (1939)). As explained in Singer, *supra* note 28, at 702 n.54, the equity jurisdiction of the federal courts originated in the English Court of Chancery, which was empowered to allocate “the entire expenses of the litigation of one of the parties as fair justice to the other party will permit . . .” (citing *Sprague*, 307 U.S. at 164–65 & n.1).

<sup>169</sup> *AIA Am., Inc.*, 866 F.3d 1369, 1373.

<sup>170</sup> *Id.* at 1373–74 (“AIA argues that if a decision on attorney’s fees involves considerations of a party’s state of mind, intent, and culpability, then those questions must be presented to a jury under the Seventh Amendment. AIA, however, has pointed to no cases finding that once an issue is deemed equitable, a Seventh Amendment right to a jury trial may still attach to certain underlying determinations, or does AIA’s argument fit within the Supreme Court’s framework of when the right to a jury trial attaches to a claim. In 18th-century England, if a claim was in the court of equity, the equity court had the discretion to submit a claim to a jury but was never required to submit any issue to a jury, regardless of whether it was deciding issues of state of mind, intent, and culpability.”).

<sup>171</sup> Singer, *supra* note 28, at 695 (citing *Arcambel v. Wiseman*, 3 U.S. 306, 306 (1796) (“We do not think that this charge [of \$1600 in attorneys’ fees] ought to be allowed. The general practice of the United States is in opposition to it; and even if that practice were not strictly correct in principle, it is entitled to the respect of the court, till it is changed, or modified, by statute.”); see also John Leubsdorf, *Toward a History of the American Rule on Attorney Fee Recovery*, 47 L. & CONTEMP. PROBS. 9, 15 (1984). As Leubsdorf explains in his thorough history of the American Rule,

[t]he essence of the American rule is that prevailing parties pay more in attorney’s fees than they recover in costs from the defeated party . . . . Once [] limits [on what lawyers were allowed to charge their clients] were evaded or

necessarily could not have pre-dated the Seventh Amendment in 1791.<sup>172</sup> Indeed, it was not until the late 1800s that “federal and state statutes attempted to remedy the [American] rule’s harshness by allowing fee-shifting in limited circumstances.”<sup>173</sup> And it was not until the early 1900s that shifting fees because of bad faith litigation was recognized as a general power of the federal courts.<sup>174</sup>

Thus, any pertinent common law treatment of bad-faith exceptions to the American Rule arose too late to be probative under the historical test.<sup>175</sup> We must look to analogous precedent.

### 3. Analogous Precedent

Absent a clear historical antecedent, “the best hope lies in comparing the modern practice to earlier ones whose allocation to court or jury we do know, seeking the best analogy we can draw between an old and the new.”<sup>176</sup> There are analogies that may be drawn to wrongful civil proceedings claims and willfulness claims, suggesting that juries might properly play a role in deciding questions of bad-faith enforcement as they relate to fee-shifting. But other on-point precedent cuts against that conclusion.

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repealed, the American rule became institutionalized because attorneys no longer had to push to recover their fees from the defeated party . . . . The American Rule thus emerged from a rough compromise. Lawyers gained the right to collect large fees from their clients, while restrictions on cost recovery remained as a symbolic vestige of the old regulatory approach.

Leubsdorf, *supra* at 13–16.

<sup>172</sup> Notably, the first Patent Act was not even enacted until 1792.

<sup>173</sup> Singer, *supra* note 28, at 696; Leubsdorf, *supra* note 171, at 25–26; *see also* Leubsdorf, *supra* note 171, at 23–24 (noting that in courts in the late 19th century, “albeit with some hesitation,” some plaintiffs also successfully recovered fees under contracts that provided for such relief).

<sup>174</sup> Leubsdorf, *supra* note 171, at 29 (“[O]nly during this century did federal courts—at first, only courts of equity—assert any general power to tax attorney fees against obstructive litigants.”).

<sup>175</sup> *See* Markman v. Westview Instruments, Inc., 517 U.S. 370, 378–84 (1996) (“Prior to 1790 nothing in the nature of a claim had appeared either in British patent practice or in that of the American states,” Lutz, *Evolution of the Claims of U.S. Patents*, 20 J. PAT. OFF. SOC. 134 (1938), and we have accordingly found no direct antecedent of modern claim construction in the historical sources. . . . Since evidence of common-law practice at the time of the framing does not entail application of the Seventh Amendment’s jury guarantee to the construction of the claim document, we must look elsewhere to characterize this determination of meaning in order to allocate it as between court or jury.”).

<sup>176</sup> *Id.* at 378.

Perhaps the closest analogue to exceptional-case fee shifting is the tort claim of wrongful civil proceedings, sometimes called “malicious prosecution.”<sup>177</sup> If a lawsuit is brought against a defendant and the suit is terminated in the defendant’s favor, the enforcement of that lawsuit is actionable against the plaintiff if it was brought “without probable cause, and primarily for a purpose other than that of securing the proper adjudication of the claim.”<sup>178</sup> Such improper purpose might exist, for example, if the plaintiff based the lawsuit on “knowing or reckless falsehoods,” had a “complete lack of evidence in support of a claims,” or possessed “a calculated desire to extort a settlement by a suitor who knows that the facts do not support his claim.”<sup>179</sup> Alternatively, “malice may be inferred from a want of probable cause.”<sup>180</sup> A successful wrongful civil proceedings claim would entitle the claimant to recover, among other damages, the reasonable legal expenses and attorneys’ fees incurred in defending the prior lawsuit.<sup>181</sup> Altogether, this closely parallels § 285 and the

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<sup>177</sup> Although the term “malicious prosecution” is often referring to criminal prosecutors’ misconduct, the civil counterpart is its own well-established tort. *See* DOBBS, *supra* note 102, § 592 (“Wrongful institution of a civil action is actionable under rules similar to those for malicious prosecution of a criminal proceeding. Where it is necessary to draw a distinction between the two, the claim based upon a wrongful civil action may be called malicious prosecution of a civil suit, or ‘malicious use of process,’ wrongful civil litigation or the like.”).

<sup>178</sup> RESTATEMENT (SECOND) OF TORTS § 674 (AM. LAW INST. 1975). Abuse of process is a similar claim in that it compensates defendants for enduring a plaintiff’s use of legal process, “primarily to accomplish a purpose for which it is not designed,” such as filing a lawsuit to obtain a collateral advantage in another matter or suit. *Id.* § 682. However, abuse of process is a poorer analogy to § 285 because one need not show that the lawsuit was meritless or that the defendant prevailed in the lawsuit to seek recovery for abuse of process. *Id.* (Reporter’s Note to § 682).

<sup>179</sup> DOBBS, *supra* note 102, § 592.

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

<sup>181</sup> RESTATEMENT (SECOND) OF TORTS § 681 (“When the essential elements of a cause of action for wrongful civil proceedings have been established, the plaintiff is entitled to recover for: (a) the harm normally resulting from any arrest or imprisonment, or any dispossession or interference with the advantageous use of his land, chattels or other things, suffered by him during the course of the proceedings, and (b) the harm to his reputation by any defamatory matter alleged as the basis of the proceedings, and (c) the expense that he has reasonably incurred in defending himself against the proceedings, and (d) any specific pecuniary loss that has resulted from the proceedings, and (e) any emotional distress that is caused by the proceedings.”). While some courts have required proof of “special injury” beyond ordinary expense and distress caused by the lawsuit, such as an arrest or seizure of property, to recover for wrongful civil proceedings, the majority do not. DOBBS, *supra* note 102, § 593 (“According to most courts, a majority of American courts allow the plaintiff to pursue the wrongful civil litigation claim without showing any special kind of injury. A substantial number of courts, however, permit the action for wrongful civil proceedings only when the plaintiff has suffered ‘special injury’ or ‘special grievance’ as a result of the wrongful litigation.”); *id.* § 596 (“Compensatory damages for tangible

flexible *Octane Fitness* analytical framework, which will shift fees to a prevailing party in the event that the plaintiff brought a meritless lawsuit for an improper purpose.<sup>182</sup>

If a claim of wrongful civil proceedings is asserted, the question of whether the original lawsuit was brought without probable cause would be decided by a judge as long as the facts are not disputed.<sup>183</sup> Whether the original lawsuit was brought for an improper purpose, and the resulting measure of damages, is decided by a jury.<sup>184</sup> Historically, malicious prosecution of civil cases was “a well recognized form of action at common law” having an associated Seventh Amendment right to a jury trial.<sup>185</sup> This analogous tort would therefore suggest that parties have a right to demand that juries decide the bad-faith underpinning of fee-shifting, notwithstanding that fee-shifting per se is historically an equitable determination made by judges.<sup>186</sup>

Alternatively, punitive enhanced damages for willfulness may also serve as an effective comparison to exceptional-case fee shifting, as both are designed to deter culpable misconduct in patent litigation. Like willfulness, a finding of bad-faith enforcement may result in a monetary penalty against the culpable party. To be sure, fee-shifting sounds more in compensation than punishment because it is intended to

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losses or harm normally include reasonable attorney fees and other expenses incurred in defending the wrongful criminal or civil litigation.”).

<sup>182</sup> See *supra* Part II.

<sup>183</sup> RESTATEMENT (SECOND) OF TORTS § 681B (Reporter’s note: “If the facts are established, the court determines whether probable cause existed; if the facts are in dispute, they are determined by the jury.”).

<sup>184</sup> RESTATEMENT (SECOND) OF TORTS § 681B; see *Peoples Bank & Tr. Co. v. Stock*, 392 N.E.2d 505, 510 (Ind. Ct. App. 1979) (“[M]alice is a question of fact for the jury.”); *Ellman v. McCarty*, 420 N.Y.S.2d 237, 241–42 (N.Y. App. Div. 1979) (“Whether malice is to be inferred from evidence showing lack of probable cause is a question of fact for a jury.”).

<sup>185</sup> 8-38 MOORE’S FEDERAL PRACTICE—CIVIL § 38.30 (2015) (“Historically, malicious prosecution came under the heading of trespass on the case, a well recognized form of action at common law. The parties to such an action are entitled to a jury trial under the Federal Rules.”); *Smoot v. Fox*, 353 F.2d 830, 833 (6th Cir. 1965) (holding, in civil case: “The Seventh Amendment to the United States Constitution preserves the right to a jury trial in all suits at common law where the value in controversy exceeds twenty dollars. Rule 38 of the Federal Rules of Civil Procedure also preserves this right. An action for malicious prosecution falls well within the recognized forms of action at common law.”).

<sup>186</sup> *Vaughan v. Atkinson*, 369 U.S. 527, 530 (1962) (quoting *Sprague v. Ticonic Bank*, 307 U.S. 161, 164 (1939)). As explained in *Singer*, *supra* note 28, at 702 n.54, the equity jurisdiction of the federal courts originated in the English Court of Chancery, which was empowered to allocate “the entire expenses of the litigation of one of the parties as fair justice to the other party will permit . . . .” (citing *Sprague*, 307 U.S. at 164–65 & n.1).

make the aggrieved party whole.<sup>187</sup> But the general rule is that “monetary relief is legal” both for “compensation and punishment,” and implicates the right to a jury trial.<sup>188</sup> Whether a patent owner enforces his or her patent in bad faith is also, like willfulness, intensely factual, and generally such “issues of fact are to be determined by the jury under appropriate instructions by the court.”<sup>189</sup> This perspective suggests that juries should be deciding the legal (as opposed to equitable), factual issue of bad-faith enforcement.

*Swofford*, on the other hand, rejected any broad jury-trial right under § 285. There, the patentee’s argument (and the court’s judgment) relied on the Supreme Court’s *Beacon Theatres, Inc. v. Westover*<sup>190</sup> and *Dairy Queen, Inc. v. Wood*<sup>191</sup> cases, as well as the Fifth Circuit’s *Thermo-Stitch, Inc. v. Chemi-Cord Processing Corp.*<sup>192</sup> case.<sup>193</sup> Those cases all raise the question of what to do where a legal claim (e.g., damages for infringement) and an equitable claim (e.g., fee shifting) are being asserted in the same case, where only the legal claim has a clear jury trial right

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<sup>187</sup> *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337, 1347 (Fed. Cir. 2004) (“That there were not actual damages does not render the award of attorney fees punitive. Attorney fees are compensatory, and may provide a fair remedy in appropriate cases.”).

<sup>188</sup> *Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340, 352 (1998) (citing *Curtis v. Loether*, 415 U.S. 189, 196 (1974) (actual damages are a “traditional form of relief offered in the courts of law”) and *Tull v. United States*, 481 U.S. 412, 422 (1987) (“Remedies intended to punish culpable individuals . . . were issued by courts of law, not courts of equity.”)). As the court observed in *Feltner*, there is “overwhelming evidence that the consistent practice at common law was for juries to award damages.” *Id.* The same is true for punitive damages. See *Atlantic Sounding Co. v. Townsend*, 557 U.S. 404, 409–10 (2009) (“Punitive damages have long been an available remedy at common law for wanton, willful, or outrageous conduct. . . . Although some States elected not to allow juries to make such awards, the vast majority permitted them. By the middle of the 19th century, ‘punitive damages were undoubtedly an established part of the American common law of torts [and] no particular procedures were deemed necessary to circumscribe a jury’s discretion regarding the award of such damages, or their amount.’”) (citations omitted).

<sup>189</sup> *Baltimore & Carolina Line, Inc. v. Redman*, 295 U.S. 654, 657 (1935); *but see Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 769 F.3d 1371, 1386 (Fed. Cir. 2014) (O’Malley, J., concurring) (“Even within the realm of factual questions, whether a particular question must always go to a jury depends on whether the jury must shoulder this responsibility as necessary to preserve the substance of common law right of trial by jury.”) (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 992 (Fed. Cir. 1995) (internal quotation marks and citations omitted)).

<sup>190</sup> *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500 (1959).

<sup>191</sup> *Dairy Queen, Inc. v. Wood*, 369 U.S. 469 (1962).

<sup>192</sup> *Thermo-Stitch, Inc. v. Chemi-Cord Processing Corp.*, 294 F.2d 486 (5th Cir. 1961).

<sup>193</sup> *Swofford v. B & W, Inc.*, 336 F.2d 406, 413 (5th Cir. 1964).

associated with it. Those cases, read together, do not support the idea of exceptional-case underpinnings being tried to juries.

*Beacon Theaters* involved a plaintiff seeking a declaratory judgment of no antitrust liability and an injunction against an antitrust suit, while the defendant raised an antitrust counterclaim and sought treble damages.<sup>194</sup> Although the injunctive relief being sought by the plaintiff was a traditionally equitable claim, the Court held that this did not justify treating the entire antitrust issue as one of equity to be decided by a judge: “if [the defendant] would have been entitled to a jury trial in a treble damage suit against [the plaintiff] it cannot be deprived of that right merely because [the plaintiff] took advantage of the availability of declaratory relief to sue Beacon first.”<sup>195</sup>

*Dairy Queen* involved a plaintiff seeking an accounting and injunctive relief stemming from a breach of contract and related trademark infringement, and the district court denied the plaintiff’s demand for a jury trial by finding that the issues presented were all “purely equitable” or “incidental” to equitable issues.<sup>196</sup> The Court held that even though the complaint purported to seek an “accounting” instead of “damages,” because it “requests a money judgment it presents a claim which is unquestionably legal.”<sup>197</sup> Citing *Beacon Theaters*, the Court explained that “any legal issues for which a trial by jury is timely and properly demanded be submitted to a jury,” and that the common issues surrounding the alleged contract breach and resulting infringement must be decided by a jury before any specifically equitable remedies may be taken up by the judge.<sup>198</sup>

*Thermo-Stitch* involved a patentee, Thermo-Stitch, suing customers of Chemi-Cord, and Chemi-Cord filing an action to enjoin Thermo-Stitch from further business

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<sup>194</sup> *Beacon Theatres, Inc.*, 359 U.S. at 501.

<sup>195</sup> *Id.* at 503–04.

<sup>196</sup> *Dairy Queen, Inc.*, 369 U.S. at 470, 475 (“The complaint then prayed for both temporary and permanent relief, including: (1) temporary and permanent injunctions to restrain petitioner from any future use of or dealing in the franchise and the trademark; (2) an accounting to determine the exact amount of money owing by petitioner and a judgment for that amount; and (3) an injunction pending accounting to prevent petitioner from collecting any money from ‘Dairy Queen’ stores in the territory.”).

<sup>197</sup> *Id.* at 476.

<sup>198</sup> *Id.* at 479 (“We conclude therefore that the district judge erred in refusing to grant petitioner’s demand for a trial by jury on the factual issues related to the question of whether there has been a breach of contract. Since these issues are common with those upon which respondents’ claim to equitable relief is based, the legal claims involved in the action must be determined prior to any final court determination of respondents’ equitable claims.”).

interferences and threats of lawsuits, and seeking a declaratory judgment of invalidity and noninfringement.<sup>199</sup> Thermo-Stitch counterclaimed for infringement, fraud, and antitrust, seeking damages and demanding a jury trial.<sup>200</sup> Even though the injunction sought by Chemi-Cord was more independent than that in *Beacon Theaters*, the court strictly construed *Beacon Theaters* to require that all the other patent issues in the case (i.e., validity and infringement) proceed to a jury trial before the equitable matter was handled by the judge.<sup>201</sup>

*Swofford* recognized that none of these cases require a jury trial on issues of enhanced damages or fee shifting.<sup>202</sup> Rather, they “requir[e] the factual issues common to the ‘legal’ claims, or remedies, and the ‘equitable’ claims, or remedies, to be tried by a jury. This is not to say, however, that they have converted typical non-jury claims, or remedies, into jury ones.”<sup>203</sup> We find this to be a fair reading of the precedent, as the cases prohibit the denial of a jury trial on legal claims merely due to the presence of an equitable claim, but do not insist that the equitable claims be tried to a jury unless they raise common issues with the legal claims. The cases can be read to imply that a truly independent equitable claim need not have its underlying factual issues tried to a jury.<sup>204</sup>

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<sup>199</sup> *Thermo-Stitch, Inc. v. Chemi-Cord Processing Corp.*, 294 F.2d 486, 488 (5th Cir. 1961).

<sup>200</sup> *Id.* at 488.

<sup>201</sup> *Id.* at 490–91.

<sup>202</sup> *Swofford v. B & W, Inc.*, 336 F.2d 406, 414 (5th Cir. 1964).

<sup>203</sup> *Id.* at 414 (“[W]e reject a view that the trio of *Beacon Theatres*, *Dairy Queen*, and *Thermo-Stitch* is a catalyst which suddenly converts any money request into a money claim triable by jury.”).

<sup>204</sup> But any doubt should be resolved in favor of a jury trial. *Thermo-Stitch* was right to strictly construe *Beacon Theater*, which emphasized that courts should heavily presume that an equitable claim present alongside a legal claim does not defeat the right to a jury trial on the common factual issues:

If there should be cases where the availability of declaratory judgment or joinder in one suit of legal and equitable causes would not in all respects protect the plaintiff seeking equitable relief from irreparable harm while affording a jury trial in the legal cause, the trial court will necessarily have to use its discretion in deciding whether the legal or equitable cause should be tried first. Since the right to jury trial is a constitutional one, however, while no similar requirement protects trials by the court, that discretion is very narrowly limited and must, wherever possible, be exercised to preserve jury trial.

*Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 501 (1959).

Here, whether an act of infringement was willful or an assertion of a patent was in bad faith may often have little evidentiary overlap with the underlying claims concerning infringement, validity, and damages to which the jury-trial right is much clearer.<sup>205</sup> *Swofford*'s conclusion that enhanced damages is not a jury issue finds some tension with the history of punitive damages being awarded at law, not equity, as noted above.<sup>206</sup> But *Swofford*'s conclusion as to fee shifting, which has a better historical tie to courts of equity, is much more defensible.

Because analogous precedent leads to no clear conclusion, functional considerations should be taken into account.

#### 4. Functional Considerations

The functional concerns about having juries consider bad-faith enforcement largely overlap with those concerning willfulness discussed above.

First, both willfulness and bad faith are only of contingent relevance until one of the parties prevails at trial—willfulness cannot be found unless the patent is found valid and infringed,<sup>207</sup> while an exceptional case is not determined unless the patent is either invalid or not infringed.<sup>208</sup> The significance of the willfulness and bad-faith findings would be assessed by the judge only after trial, in the determinations of whether to enhance damages or shift fees. Yet having the jury consider such matters alongside questions of infringement and validity will tend to taint the deliberations and confuse the issues, potentially leading to unfair prejudice and legally unsupportable compromise verdicts.

Second, many grounds for alleging bad faith also implicate specialized legal knowledge and experience that jurors will not have. For example, whether a pre-filing investigation was inadequate is something that judges can better assess. Whether a pre-trial argument or position was frivolous or merely wrong, considering the governing law, is something that judges can better determine. Whether settlement efforts between the parties reveal a nuisance purpose or a sincere effort to settle a

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<sup>205</sup> See *Voda v. Cordis Corp.*, 536 F.3d 1311, 1329 (Fed. Cir. 2008) (“[W]e reject Cordis’s argument that, under the Seventh Amendment, a new trial on willfulness would require a new trial on infringement.”).

<sup>206</sup> See *Swofford*, 336 F.2d at 412 (“Courts of equity did not award damages which were penal in character.”).

<sup>207</sup> 35 U.S.C. § 284 (2012) (enhanced damages are only available “[u]pon finding for the claimant”).

<sup>208</sup> § 285 (fee shifting for exceptional cases only occurs for the “prevailing party”).



legitimate dispute is something judges can better discern from their experience presiding over many cases.

On the other hand, unlike claim construction, which judges decide not only because of their superior legal training and the resulting uniformity and certainty (via issue preclusion),<sup>209</sup> willfulness and bad-faith assertions are not akin to legal acts like contract interpretation, nor are they issues that would be repeatedly litigated in different jurisdictions without preclusive effect (because they are unique findings as to a party's conduct with respect to the other party, not findings touching on the scope of the patent). Further, matters of willfulness and bad faith are essentially "moral blame" findings which, if taken away from judges, have the potential to avoid abuses of judicial power.<sup>210</sup> One judge's view of when conduct is blameworthy may or may not reflect that of the community and a jury of a party's peers, and can result in legal standards that cause systemic injustice.<sup>211</sup> While these considerations might

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<sup>209</sup> *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996) ("We accordingly think there is sufficient reason to treat construction of terms of art like many other responsibilities that we cede to a judge in the normal course of trial, notwithstanding its evidentiary underpinnings."); *id.* at 391 ("Uniformity would, however, be ill served by submitting issues of document construction to juries. Making them jury issues would not, to be sure, necessarily leave evidentiary questions of meaning wide open in every new court in which a patent might be litigated, for principles of issue preclusion would ordinarily foster uniformity. *Cf.* *Blonder-Tongue Labs., Inc. v. University of Ill. Found.*, 402 U.S. 313 (1971). But whereas issue preclusion could not be asserted against new and independent infringement defendants even within a given jurisdiction, treating interpretive issues as purely legal will promote (though it will not guarantee) intrajurisdictional certainty through the application of *stare decisis* on those questions not yet subject to interjurisdictional uniformity under the authority of the single appeals court.").

<sup>210</sup> *Hopkins*, *supra* note 107 (quoting *Duncan v. Louisiana*, 391 U.S. 145, 156 (1967)) ("[T]he jury trial provisions in the Federal and State Constitutions reflect a fundamental decision about the exercise of official power—a reluctance to entrust plenary powers over the life and liberty of the citizen to one judge or to a group of judges. Fear of unchecked power, so typical of our State and Federal Governments in other respects, found expression in the criminal law in this insistence upon community participation in the determination of guilt or innocence.").

<sup>211</sup> *See* *Petition for Writ of Certiorari at 4–5, Newegg, Inc. v. MacroSolve, Inc.*, 136 S. Ct. 2475 (2016) (No. 15-1359), <http://patentlyo.com/media/2016/05/NewEggPetition.pdf> ("Courts in the Eastern District of Texas, including the court below in this case, have repeatedly and blatantly chosen to deviate from *Octane*. They have created and apply a rule that conflicts with *Octane* in spirit and letter. If the plaintiff has abandoned its case before a ruling on the merits, for example because no one would pay a cost-of-defense settlement, Eastern District judges have refused to investigate the meritlessness of the case for purposes of a fee motion unless the truncated litigation has itself exposed the exceptional nature of the case . . . . Mechanically, the rule absolves the district court of any duty to conduct an examination of the merits sufficient to determine whether the case is exceptional. This hurdle is virtually impossible to overcome given the absence of a decision on the merits. It creates a loophole permitting abusive plaintiffs to avoid any negative consequences for their bad acts merely by dismissing their cases. Principled defendants are unjustly left without the recourse [§] 285 and this Court, through *Octane*, sought to provide."). Although fee-shifting after *Octane Fitness* sharply rose around the country, the Eastern District

counsel in favor of juries deciding matters of bad-faith enforcement, the potential for jury confusion and improper compromise verdicts likely outweighs these other practical concerns.

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As with willfulness, there is no specific statutory guidance, no direct historical antecedent, and no compelling analogous precedent that would suggest that bad-faith enforcement should be tried to a jury. Looking at the functional considerations involved, judges appear to be better equipped to contextualize the arguments made and reach a fair conclusion, without tainting the threshold liability decisions. As with willfulness, having a jury trial on matters of bad faith does not appear necessary to preserve a defendant's right to have a jury decide if it is liable for infringement.<sup>212</sup>

## V. FAIRNESS WHEN CASTING ASPERSIONS

The foregoing discussion considers whether willfulness and bad-faith enforcement are proper jury questions, concluding that neither presents a compelling case for a jury trial right, and that both issues would be better resolved post-trial by judges. The status quo is to allow juries to consider willfulness but not bad-faith enforcement. This Part considers the normative issue of whether those issues should be tried together, if at all.

One immediate complication follows from allowing juries to consider willfulness but not bad-faith enforcement: willfulness findings can be used not only to enhance damages under § 284, but also to justify fee shifting against defendants under § 285.<sup>213</sup> To prohibit juries from considering similar culpable conduct by the plaintiff a predicate for fee-shifting would be one-sided and unfair.

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of Texas has been a clear outlier where almost no fees have been shifted. See Hannah Jiam, *Patent Law: Fee-Shifting and Octane Fitness: An Empirical Approach Toward Understanding "Exceptional,"* 30 BERKELEY TECH L.J. 611, 624 (2015) (explaining that "[a]fter Octane Fitness, the proportion of fee awards granted under § 285 has more than doubled"); Scott Graham, *New Rules Mean It's Payback Time in Patent Cases*, THE RECORDER (Apr. 30, 2016), <http://www.therecorder.com/printerfriendly/id=1202756439123>.

<sup>212</sup> *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 377 (1996) ("[W]hether a particular issue occurring within a jury trial is itself necessarily a jury issue, the guarantee being essential to preserve the right to a jury's resolution of the ultimate dispute.").

<sup>213</sup> See, e.g., *Revolution Eyewear, Inc. v. Aspex Eyewear, Inc.*, 563 F.3d 1358, 1372 (Fed. Cir. 2009) ("Exceptional cases usually feature some material, inappropriate conduct related to the matter in litigation, such as willful infringement."); *Golden Blount, Inc. v. Robert H. Peterson Co.*, 438 F.3d 1354, 1373 (Fed. Cir. 2006) ("Based on the finding of willfulness, the district court found the case exceptional and awarded Golden Blount attorney fees in the amount of \$ 622,015."); *Georgetown Rail Equip. Co. v. Holland L.P.*,

But the more fundamental problem with trying willfulness alone is that the potential for jury confusion and unfair prejudice goes only one way and can be opportunistically wielded to cast aspersions at the defendant, encouraging the jury to find infringement and damages *because* the defendant is an alleged bad actor. If both parties have reasons to contend that the other party is a bad actor, however, the jury should be able to hear both sides of the story. And if the jury is hearing such evidence, then as a practical matter the jury should weigh in on whether the patentee acted in bad faith or the defendant infringed willfully, each of which is a “classical jury question” of intent.<sup>214</sup>

The remainder of this Part will examine whether there is a constitutional right to try matters of bad-faith enforcement if willfulness is asserted, look to other legal contexts where juries are asked to allocate moral blame between parties, and consider practical realities of how the pertinent evidence will likely be admitted as to both issues anyway if willfulness is tried.

#### A. *The Constitutional Right to a Fair Trial*

While “[t]here is a constitutional right to a fair trial in a civil case,”<sup>215</sup> considering willfulness and bad faith separately does not likely rise to the level of a constitutional fair-trial violation.

Generally, “[t]rying issues separately is appropriate where separate trials would not constitute a clear and indisputable infringement of the constitutional right to a fair trial.”<sup>216</sup> Infringement and validity, for example, are properly bifurcated into separate trials—even though a defendant’s invalidity case can shape the jury’s view of claim scope and infringement by contextualizing the patent, the two issues are not

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No. 6:13-cv-366, 2016 WL 3346084, at \*22 (E.D. Tex. June 16, 2016), *aff’d*, 867 F.3d 1229 (Fed. Cir. 2017); *AAT Bioquest, Inc. v. Tex. Fluorescence Labs., Inc.*, No. 14-cv-03909-DMR, 2015 WL 7708332, at \*15–16 (N.D. Cal. Nov. 30, 2015); *Ultimate Combustion Co. v. Fuecotech, Inc.*, No. 12-60545-CIV, 2014 U.S. Dist. LEXIS 193335, at \*3–4 (S.D. Fla. June 4, 2014).

<sup>214</sup> *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1341 (Fed. Cir. 2016) (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1250 (Fed. Cir. 1989)).

<sup>215</sup> *Latiolais v. Whitley*, 93 F.3d 205, 207 (5th Cir. 1996) (quoting *Lemons v. Skidmore*, 985 F.2d 354, 357 (7th Cir. 1993) and citing *Bailey v. Sys. Innovation, Inc.*, 852 F.2d 93, 98 (3d Cir. 1988) (holding that “fairness in a jury trial, whether criminal or civil in nature, is a vital constitutional right”).

<sup>216</sup> *Commil USA, LLC v. Cisco Sys., Inc.*, 720 F.3d 1361, 1371 (Fed. Cir. 2013), *vacated in part*, 135 S. Ct. 1920, (2015), and *adhered to in part*, 813 F.3d 994 (Fed. Cir. 2015) (quoting *In re Innotron Diagnostics*, 800 F.2d 1077, 1086 (Fed. Cir. 1986)).

closely interwoven to implicate the same essential legal questions.<sup>217</sup> Under this standard, the Federal Circuit has also rejected the notions that willfulness and infringement must be tried together,<sup>218</sup> and that invalidity must be tried along with active inducement of infringement.<sup>219</sup>

These kinds of questions often come up when a new trial is sought on a specific issue. In that situation, “[w]here the practice permits a partial new trial, it may not properly be resorted to unless it clearly appears that the issue to be retried is so distinct and separable from the others that a trial of it alone may be had without injustice.”<sup>220</sup>

While willfulness and bad-faith enforcement are not “so interwoven” as to require the jury to decide the “same essential issues,” assertions of culpability or “moral blame” are issues that juries traditionally resolve.<sup>221</sup> From that perspective,

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<sup>217</sup> See, e.g., *Commil USA, LLC*, 720 F.3d at 1371 (“We note at the outset that ‘patent infringement and invalidity are separate and distinct issues.’ Indeed, this court routinely orders a partial new trial on infringement, while upholding an earlier verdict on validity.”) (citing *Pandrol USA, LP v. Airboss Ry. Prods.*, 320 F.3d 1354, 1364–65 (Fed. Cir. 2003); *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 381 F.3d 1371, 1374 (Fed. Cir. 2004); *Comaper Corp. v. Antec, Inc.*, 596 F.3d 1343, 1354–55 (Fed. Cir. 2010)).

<sup>218</sup> *Voda v. Cordis Corp.*, 536 F.3d 1311, 1329 (Fed. Cir. 2008) (“[W]e reject Cordis’s argument that, under the Seventh Amendment, a new trial on willfulness would require a new trial on infringement.”). At least two Federal Circuit judges believe that this conclusion is ill-supported by a proper Seventh Amendment analysis, and that submitting willfulness to a different jury than the jury determining liability would violate the Seventh Amendment. See *Robert Bosch, LLC v. Pylon Mfg. Corp.*, 719 F.3d 1305, 1346 n.10 (Fed. Cir. 2013) (O’Malley, J., dissenting, joined by Wallach, J.) (“The entirety of the constitutional analysis in *Voda* is set out in one sentence . . . . To the extent *Voda* purported to answer the Seventh Amendment question for all cases and in all circumstances in that one sentence, as the majority implies, it should be revisited. The question of whether issues are sufficiently separable and distinct to permit trial to different juries is to be determined on a case by case basis considering the totality of circumstances. See *Witco Chem. Corp.*, 787 F.2d at 1549, and cases collected therein (determining that a partial new trial is inappropriate ‘after considering the totality of the circumstances’). Where the circumstances confirm that the issues to be addressed in the separate trials are as interwoven as they are whenever willful infringement allegations are bifurcated, a separate trial of that claim alone would rarely, if ever, pass constitutional muster under such an analysis.”).

<sup>219</sup> *Commil USA, LLC*, 720 F.3d at 1372 (“[W]e find that holding separate trials on the issues of invalidity and induced infringement does not violate the Seventh Amendment.”).

<sup>220</sup> *Id.* at 1371 (quoting *Gasoline Prods. Co. v. Champlin Ref. Co.*, 283 U.S. 494, 500 (1931)).

<sup>221</sup> *Hopkins*, *supra* note 107, at 420 (quoting *Duncan v. Louisiana*, 391 U.S. 145, 156 (1967)) (“[T]he jury trial provisions in the Federal and State Constitutions reflect a fundamental decision about the exercise of official power—a reluctance to entrust plenary powers over the life and liberty of the citizen to one judge or to a group of judges. Fear of unchecked power, so typical of our State and Federal Governments in other respects, found expression in the criminal law in this insistence upon community participation in the determination of guilt or innocence.”).

these kinds of moral judgments as to patent plaintiffs and defendants may be more intertwined than at first glance. Juries are more comfortable knowing that their verdicts reflect not only the correct legal answer, but the correct moral answer as well.<sup>222</sup> Though perhaps not rising to the level of a constitutional requirement, from a normative perspective this reality does suggest that a complete picture of alleged moral blame by both parties should be presented to a jury.

The following sub-Part explores analogous legal contexts where juries are asked to allocate moral blame between the parties.

### *B. Examples of Two-Way Blame Allegations*

The law already recognizes at least two contexts where juries can consider culpability on both sides of a dispute to decide on moral blame: criminal character evidence and tort cases of contributory negligence. Both are rooted in concepts of fairness.

In the criminal context, the Federal Rules of Evidence contemplate that juries should be able to consider the “character” of the defendant if the victim’s character is put in issue.<sup>223</sup> While evidence of a person’s character is generally “not admissible to prove that on a particular occasion the person acted in accordance with the character or trait,” this important exception ensures a fair trial: if the criminal defendant casts aspersions at the victim, the victim may do the same so that the jury can determine if the defendant was truly the culpable one.<sup>224</sup>

Long before the Federal Rules were amended in 2000 to the form discussed above,<sup>225</sup> some states “already had evidentiary schemes that precluded the defendant

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<sup>222</sup> See Ken Broda-Bahm, *Treat Your Jury Not Just Legal, but Political and Moral as Well*, LEXOLOGY: PERSUASIVE LITIGATOR (May 16, 2016), <http://www.lexology.com/library/detail.aspx?g=46be59cb-2e19-492f-985a-09ca71443106> (“[E]xperienced litigators know that success lies in not just reaching the jury at a legal level, but in reaching them at a broadly human level as well.”).

<sup>223</sup> FED. R. EVID. 404(a)(2)(B) (“[A] defendant may offer evidence of an alleged victim’s pertinent trait, and if the evidence is admitted, the prosecutor may: (i) offer evidence to rebut it; and (ii) offer evidence of the defendant’s same trait . . .”).

<sup>224</sup> FED. R. EVID. 404.

<sup>225</sup> See FED. R. EVID. 404, Committee Notes on Rules—2000 Amendment (“Rule 404(a)(1) has been amended to provide that when the accused attacks the character of an alleged victim under subdivision (a)(2) of this Rule, the door is opened to an attack on the same character trait of the accused.”).

from attacking an alleged crime victim's character with impunity."<sup>226</sup> Missouri was one such state. The Supreme Court of Missouri indicated that this ensures a "fair trial" for both the accused and the state, and explained that "[i]mpartial justice cannot be dispensed by allowing one litigant to present a given type of evidence bearing upon an ultimate factual issue while at the same time denying to his adversary the right to present his version of said issue by evidence of equal inherent quality."<sup>227</sup>

So is it with willfulness and bad-faith enforcement. If the patentee casts aspersions at the defendant for being culpable, the defendant should be able to fire right back. Having only half the story precludes a jury from seeing the whole picture and reaching the correct result. Just as evidence of willfulness may color the jury's belief of whether infringement occurred or whether the patent is valid, evidence of bad-faith assertions may do the same. Sorting out such "credibility determinations . . . [is] the jury's forte."<sup>228</sup>

Another situation where juries can consider two sides of a story to allocate the moral blame is in tort cases of comparative negligence. In those cases, a plaintiff's recovery on a claim of negligence may be offset or diminished by the plaintiff's own negligent conduct.<sup>229</sup> Just as the willfulness and exceptional case doctrines impose expectations of good faith and nonfrivolous positions on both parties,<sup>230</sup> comparative negligence requires due or reasonable care to be exercised by both parties, and any departure from that standard may give rise to liability or limit recovery,

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<sup>226</sup> Christopher W. Behan, *When Turnabout is Fair Play: Character Evidence and Self-Defense in Homicide and Assault Cases*, 86 OR. L. REV. 733, 772 (2007) (discussing laws in Missouri, California, and Massachusetts).

<sup>227</sup> *State v. Robinson*, 130 S.W.2d 530, 531 (Mo. 1939).

<sup>228</sup> *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996).

<sup>229</sup> *See, e.g., Li v. Yellow Cab Co.*, 532 P.2d 1226, 1243 (Cal. 1975) ("[I]n all actions for negligence resulting in injury to person or property, the contributory negligence of the person injured in person or property shall not bar recovery, but the damages awarded shall be diminished in proportion to the amount of negligence attributable to the person recovering.").

<sup>230</sup> *See supra*, Part II (discussing how frivolous and unreasonable positions made in bad faith can evidence willfulness or give rise to an exceptional case); *cf. Medtronic Navigation, Inc. v. BrainLAB Medizinische Computersysteme GmbH*, 603 F.3d 943, 954 (Fed. Cir. 2010) ("[T]here is a presumption that an assertion of infringement of a duly granted patent is made in good faith.").

respectively.<sup>231</sup> This concept is best justified by notions of fairness.<sup>232</sup> Ignoring the plaintiff's fault altogether, or allowing any fault on the plaintiff's part to preclude recovery outright, is "inequitable in its operation because it fails to distribute responsibility in proportion to fault."<sup>233</sup>

### C. *Practical Evidentiary Symmetry*

Beyond fairness considerations are a number of practical evidentiary realities that might further justify trying willfulness and bad faith together. As discussed above, the kinds of evidence and argument relevant to willfulness will often be relevant to bad-faith enforcement as well, and in many instances the evidence itself may overlap. For example, the parties' pre-suit communications, settlement negotiations, claim construction positions, and discovery tactics may be probative of both willfulness and bad-faith enforcement. If evidence relevant to both sides' arguments is admitted, it would be difficult and inefficient to have an empaneled jury consider the evidence only for a single purpose.

Even if a judge attempted to allow only the plaintiff to offer such evidence for its willfulness case, evidentiary rules and doctrines would likely bring the counterpoint evidence along with it. Specifically, the doctrines of completeness, impeachment, and curative admissibility will typically "open the door"<sup>234</sup> to allow

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<sup>231</sup> *Li*, 532 P.2d at 1243.

<sup>232</sup> See Gary T. Schwartz, *Contributory and Comparative Negligence: A Reappraisal*, 87 YALE L.J. 697, 727 (1978) ("The most persuasive justification for a contributory negligence defense is to be found in notions of fairness.").

<sup>233</sup> *Li*, 532 P.2d at 1230–31 ("It is unnecessary for us to catalogue the enormous amount of critical comment that has been directed over the years against the 'all-or-nothing' approach of the doctrine of contributory negligence. The essence of that criticism has been constant and clear: the doctrine is inequitable in its operation because it fails to distribute responsibility in proportion to fault . . . . The basic objection to the doctrine—grounded in the primal concept that in a system in which liability is based on fault, the extent of fault should govern the extent of liability—remains irresistible to reason and all intelligent notions of fairness.").

<sup>234</sup> Although the doctrines of completeness, specific contradiction impeachment, and curative admissibility might all be considered ways that one party's evidence "opens the door" and allows the other party to offer responsive evidence, the phrase "open the door" is often used imprecisely to refer to one or more of these distinct doctrines that each have specific requirements. See Francis A. Gilligan & Edward J. Imwinkelried, *Bringing the Opening the Door Theory to a Close: The Tendency to Overlook the Specific Contradiction Doctrine in Evidence Law*, 41 SANTA CLARA L. REV. 807, 836 (2001) ("It is a common complaint that the prose in most judicial opinions is legalistic and boring. It is therefore understandable that judges are tempted to resort to lively language such as 'opening the door' and 'fighting fire with fire' to make an opinion more enjoyable to read. However, there is a downside to the use of such vague expressions. They certainly do not conduce to precise analysis. As we have seen, their use can generate confusion. Some courts treat the expressions as synonyms for specific contradiction, others equate the

the defendant to cast its own aspersions at the plaintiff. All three of these evidentiary doctrines are rooted in fundamental fairness, which suggests that having juries hear such responsive evidence to evaluate a defendant's counter-assertions is a relatively modest proposal and is less disruptive of the status quo than it might seem at first glance.

Suppose a plaintiff presents the jury with the plaintiff's pre-suit demand letter, laying out why the plaintiff believes the defendant is clearly infringing, as proof that the defendant was reckless in its assessment of infringement or was unreasonably refusing to license the patent. The doctrine of completeness will allow the defendant to respond with appropriate rebuttals.<sup>235</sup> Federal Rule of Evidence 106 codifies the completeness doctrine as follows: "[i]f a party introduces all or part of a writing or recorded statement, an adverse party may require the introduction, at that time, of any other part—or any other writing or recorded statement—that in fairness ought to be considered at the same time."<sup>236</sup> Under this rule, the defendant will be able, for example, to point to other portions of the plaintiff's demand letter showing that the plaintiff's positions were unreasonable or lacking evidentiary support. But the rule allows for much more. The defendant can also point to "*any other writing or recorded statement* that in fairness ought to be considered at the same time."<sup>237</sup> This broad inclusionary provision "constitutes the most direct way that the law of evidence manifests a commitment to override adversarial partiality in the presentation of evidence."<sup>238</sup>

Returning to our example, under Rule 106 the defendant accused of willfulness could point to its response to the plaintiff's original demand letter, other subsequent correspondence, or even a later *Markman* ruling rejecting the plaintiff's construction(s) to show that the plaintiff took an unreasonable view of its own

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expressions with curative admissibility, and still others employ the expressions as overarching umbrellas covering both specific contradiction and curative admissibility."). Because the legal concepts might be muddled otherwise, in this article we therefore refrain from using the term "open the door" as referring to any particular doctrine and will discuss each doctrine separately by its proper name.

<sup>235</sup> FED. R. EVID. 106.

<sup>236</sup> *Id.*

<sup>237</sup> *Id.* (emphasis added).

<sup>238</sup> Dale A. Nance, *A Theory of Verbal Completeness*, 80 IOWA L. REV. 825, 826 (1995) ("Whereas most admissibility rules are exclusionary, operating against a background preference for the admissibility of relevant evidence, the completeness rule is explicitly inclusionary."). A notable limitation is that the completeness rule expressed in Rule 106 does not extend to "the enormous category of incomplete testimonial recountings of conversations, statements, or documentary contents." *Id.* at 898.



claims. The defendant may also point to other documentation showing that the infringement claim is dubious, including instances where the plaintiff was unsuccessful in enforcing the patent, licensed the patent for exceptionally low amounts,<sup>239</sup> or took inconsistent positions on the patent's scope. This kind of counterpoint evidence, which is especially prevalent in litigation involving patent assertion entities, not only rebuts the willfulness assertion, but affirmatively introduces the facts alleged to show bad-faith enforcement.

The doctrine of specific contradiction impeachment would similarly allow evidence that directly rebuts a plaintiff's assertion to be admitted. As Francis Gilligan and Edward Imwinkelreid explained, the doctrine is deeply rooted in fairness to preserve an accused party's right to challenge the evidence mounted against it:

Given the adversarial nature of litigation, it should come as no surprise that our evidence law has long recognized specific contradiction as a method of impeachment. If an opposing party calls a witness who testifies to fact A that the traffic light was red, a party may impeach the former witness by calling another witness to give contradictory testimony about non-A that the light was green. If the jury believes the second witness, they have inferred that the opponent's witness "has erred about or falsified [the] facts." Understood in this sense, recognizing the entitlement to specific contradiction impeachment is essential to the proper functioning of an effective adversary system of litigation. In the final analysis, the entitlement is a corollary of the party's fundamental right in an adversary system to attack false or misleading unfavorable evidence presented by the opponent.<sup>240</sup>

This doctrine is somewhat broader than the completeness doctrine in the sense it is not limited to documents or recorded statements that should, for fairness reasons, be considered alongside other evidence.<sup>241</sup> The doctrine of direct contradiction impeachment allows for any form of evidence—written or oral—to be introduced to rebut an alleged factual assertion.<sup>242</sup> Thus, returning to our example, the defendant accused of willfulness could call a witness to testify that certain facts alleged in the

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<sup>239</sup> At least one court has questioned whether knowledge of low-value settlements has any relevance to willfulness. *See, e.g., PerDiemCo, LLC v. IndusTrack LLC*, No. 2:15-cv-00726-JGR-RSP, 2016 WL 6611488 (E.D. Tex. Nov. 9, 2016). However, in our view, knowledge that a certain patent has been licensed for "nuisance value" suggests that the patent is not particularly strong and, additionally, provides necessary context to a patentee's claim that the patent has been widely licensed.

<sup>240</sup> *See Gilligan & Imwinkelreid, supra* note 234, at 836.

<sup>241</sup> *See* FED. R. EVID. 106.

<sup>242</sup> *See Gilligan & Imwinkelreid, supra* note 234, at 836.

plaintiff's demand letter (e.g., patent scope and licensing history) were false and reflected unreasonable assumptions. If a demand letter contended that many companies had licensed the plaintiff's patent because the patent was believed to be of great technological value, the defendant can specifically rebut that assertion by offering evidence that the plaintiff was a "patent troll" with a history of asserting specious infringement claims and collecting nuisance sums from targets who, in or out of court, denied any infringement. Again, this would not only rebut a willfulness allegation but would be probative of bad faith on the part of the plaintiff.

The doctrine of curative admissibility is yet another way to level the playing field and admit counterpoint evidence for fairness purposes. Under this doctrine, any evidence improperly presented at trial because it was inadmissible may be cured by allowing the other party to introduce commensurate inadmissible evidence that is responsive or touching on the same subject.<sup>243</sup> This doctrine limits the responding party to introducing "only as much otherwise inadmissible evidence as needed to counteract the opponent's inadmissible evidence" to cure the unfair prejudice resulting from the initial violation.<sup>244</sup> In applying this "tit for tat" approach, however, the responsive evidence need not be necessary for completeness or directly contradictory to the initial objectionable evidence, as under those other doctrines.<sup>245</sup>

Under the curative admissibility doctrine, suppose a plaintiff offered into evidence a letter from the defendant stating that the defendant denied infringing, but had not consulted with an attorney. Section 298 of the Patent Act expressly prohibits offering the fact that a party failed to obtain an opinion of counsel,<sup>246</sup> making it legally irrelevant and inadmissible.<sup>247</sup> Once such evidence was presented, the judge may allow the defendant a commensurate curative response, such as a similar letter where the plaintiff denied having consulted an attorney before deciding to bring the

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<sup>243</sup> *See id.* at 824–25, 829.

<sup>244</sup> *Id.* at 829–30 (citing *United States v. Brown*, 921 F.2d 1304, 1307 (D.C. Cir. 1990) ("Opening the door is one thing. What comes through the door is another. 'Introduction of otherwise inadmissible evidence under [the] shield of [curative admissibility] is permitted only to the extent necessary to remove any unfair prejudice which might otherwise have ensued from the original evidence.'")).

<sup>245</sup> *Id.* at 830.

<sup>246</sup> 35 U.S.C. § 298 (2012) ("The failure of an infringer to obtain the advice of counsel with respect to any allegedly infringed patent, or the failure of the infringer to present such advice to the court or jury, may not be used to prove that the accused infringer willfully infringed the patent or that the infringer intended to induce infringement of the patent.").

<sup>247</sup> FED. R. EVID. 402 ("Relevant evidence is admissible unless any of the following provides otherwise: . . . a federal statute . . .").

lawsuit. Such a letter would likewise be inadmissible as hearsay<sup>248</sup> and unfairly confusing and misleading for the jury,<sup>249</sup> but would at least allow both sides to take roughly equivalent unfair shots at each other. A wide variety of similar discovery-centric disputes could be improperly presented and then properly cured in this fashion, such as cross-allegations concerning documents withheld, interrogatories not answered, or witnesses being evasive or uncooperative in depositions, most of which is likely inadmissible under Rule 403 for its high potential to be misleading and confusing for the jury.<sup>250</sup>

Taken together, the doctrines of completeness, direct contradiction impeachment, and curative admissibility may cooperate to allow defendants broad room to respond to willfulness assertions with evidence that both rebuts willfulness and affirmatively argues bad faith.<sup>251</sup> The vast majority of evidence that might be offered to prove willfulness likely has a counterpart that can be properly employed by the defendant for such purposes. In effect, the factual matters concerning bad faith assertions will be tried alongside willfulness, so it would make sense to ask the jury to reach decisions on that matter while they are considering all the evidence. And, if the substance of the trial will encompass both parties' aspersions anyway, that may tip the scales in favor of formal recognition by judges and in jury instructions that both issues are properly before the jury if willfulness is put in issue.

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<sup>248</sup> FED. R. EVID. 801(c) ("Hearsay. 'Hearsay' means a statement that: (1) the declarant does not make while testifying at the current trial or hearing; and (2) a party offers in evidence to prove the truth of the matter asserted in the statement.").

<sup>249</sup> FED. R. EVID. 403 ("The court may exclude relevant evidence if its probative value is substantially outweighed by a danger of one or more of the following: unfair prejudice, confusing the issues, misleading the jury . . .").

<sup>250</sup> *See id.*

<sup>251</sup> A similar argument can be made for responses to other patent assertions where culpability comes into play, such as active inducement or infringement or contributory infringement. *See* 35 U.S.C. § 271(b)–(c) (2012). Unlike direct infringement, such indirect infringement allegations require proof of the intent to cause infringement, which includes both knowledge of the patent and knowledge that the third party direct infringer's conduct was, in fact, infringing. *See* *Global-Tech Appliances, Inc. v. SEB S.A.*, 563 U.S. 754, 764–66 (2011); *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476, 488 (1964). These indirect infringement theories do not directly implicate any equitable relief or non-jury determinations, but merely establish liability. *Id.* As they also first arose well after the Seventh Amendment, they are not helpful to establish analogous precedent for purposes of identifying jury-trial rights for willfulness or bad faith. 5-17 DONALD S. CHISUM, CHISUM ON PATENTS § 17.02 (Matthew Bender 2017) ("*Wallace v. Holmes* (1871) is the first case clearly recognizing that a person can be held to infringe by making or selling an unpatented element for use in a patented combination or process.").

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There appears to be no Constitutional requirement that bad-faith enforcement be tried alongside willfulness. However, juries in analogous criminal and tort contexts are, for fairness reasons, asked to allocate moral blame between two parties. That kind of weighing of culpability is firmly in the jury's wheelhouse and would similarly justify trying willfulness and bad-faith enforcement together. Moreover, evidentiary rules and doctrines—again, rooted in fairness—would likely open the door to bad-faith enforcement evidence whenever willfulness is tried anyway, so we might as well have juries consider that evidence for its probative value and reach a verdict on both questions.

A final matter is whether the jury verdicts on these issues must be binding. We think not. Even if there is no right to a jury trial on one or both of willfulness and bad-faith enforcement, district courts often ask for advisory verdicts on similar equitable issues in patent cases, and we see no reason that could not occur in this context. For example, district courts often have juries render advisory verdicts for inequitable conduct or its factual underpinnings, where there is clearly no right to a jury trial, and may rely on those advisory verdicts to help justify their own conclusions.<sup>252</sup> Moreover, findings of willfulness and bad-faith enforcement, even if characterized as binding and entitled to deference, have no direct legal effect in that they do not actually compel courts to enhance damages or shift fees anyway.<sup>253</sup> Regardless of how a verdict might be characterized, given the status quo of trying willfulness to the jury, our concern is that there be an equally meaningful opportunity to try bad-faith enforcement simultaneously to the same jury. It would be optimally

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<sup>252</sup> See *TransWeb, LLC v. 3M Innovative Props. Co.*, 812 F.3d 1295, 1299 (Fed. Cir. 2016); *American Calcar, Inc. v. American Honda Motor Co.*, 651 F.3d 1318, 1333 (Fed. Cir. 2011) (“Inequitable conduct is equitable in nature, with no right to a jury, and the trial court has the obligation to resolve the underlying facts of materiality and intent.”); see also *In re Dippin’ Dots, Inc. Patent Litigation*, No. 3:96-cv-01959, ECF No. 836 (N.D. Tex. Oct. 20, 2003) (verdict form asking “Did Curt Jones make a misrepresentation or omission that violated the duty of candor to the Patent Office?”; “Were the misrepresentations or omissions material to the issuance of the patent?”; and “Were the misrepresentations or omissions made with the intent to deceive the Patent Office?”).

<sup>253</sup> See, e.g., *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 134 S. Ct. 1749, 1757 (2014) (describing bad faith as one part of a totality of the circumstances analysis); *Trustees of Boston Univ. v. Everlight Elecs. Co.*, 212 F. Supp. 3d 254, 258 (D. Mass. 2016) (“Assuming without deciding that the jury’s verdict, based on the subjective prong of the now-overruled *Seagate* test, is sufficient to find subjective willfulness, the Court still finds, in its discretion, that the defendants’ conduct did not rise to the level of egregiousness meriting an award of enhanced damages.”); *Presidio Components, Inc. v. American Tech. Ceramics Corp.*, No. 14-cv-02061-H-BGS, 2016 U.S. Dist. LEXIS 110212, at \*36 (S.D. Cal. Aug. 17, 2016) (“[T]he Court, exercising its sound discretion, ultimately declines to award Presidio enhanced damages despite the jury’s finding of willful infringement.”).

fair for both issues to be handled via binding verdicts (as willfulness is<sup>254</sup>) so that both issues can equally influence the ultimate decisions of enhanced damages or fee-shifting. However, the mere presentation of the issue to the jury creates most of the critical fairness benefits discussed above by ensuring that the jury hears both side of the parties' stories before reaching its verdict. If framing a bad-faith enforcement verdict as advisory is an easier sell to a judge and helps to allow more defendants to level the playing field, that is still far better than the status quo.

## VI. CONCLUSION

Neither willfulness nor bad-faith enforcement have clear jury-trial rights in statutes, direct historical antecedents, or analogous historical contexts. Juries are generally well-suited to decide matters of culpability, but these specific culpability issues are probably better resolved by judges. Willfulness and bad-faith enforcement tend to center around evidence concerning discovery misconduct, the relative strength of litigation positions, patent prosecution, and licensing/settlement communications. Such evidence is better understood and contextualized by judges who can draw from their own normative experiences, having presided over many lawsuits. Moreover, trying such culpability questions to a jury creates a "side show" that confuses the issues, extends the length of trials, and may incentivize improper compromise verdicts.

For these reasons, both willfulness and bad-faith enforcement should be resolved by judges after trial when matters of liability and damages have already been established, and when the risk of "bad actor" arguments tainting the liability and damages verdicts is gone. But, as long as the status quo of trying willfulness to juries persists, the more immediate question is what to do about defendants who allege the patentee is asserting its patent in bad faith. It is fundamentally unfair to require defendants to endure aspersions cast by a patentee at trial but be unable to demonstrate how the patentee is itself engaged in culpable misconduct. We conclude that, to the extent willfulness is tried to a jury, fairness and evidentiary practicalities should compel bad-faith enforcement to be considered and decided by the same jury. Perhaps this result itself will encourage courts to end to the unwise practice of trying willfulness to juries.

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<sup>254</sup> 7-20 CHISUM, *supra* note 251, § 20.03 (explaining that, while earlier courts had "deemed the jury's function to be to determine actual damages only, and its determination of willfulness was only advisory to the trial judge," the Federal Circuit later held that "all fact findings of a jury are non-advisory, unless made in an area expressly removed from jury verdict") (quoting *Shiley, Inc. v. Bentley Laboratories, Inc.*, 794 F.2d 1561, 1568 (Fed. Cir. 1986)). While district courts need not enhance damages as a result of a willfulness finding, they cannot re-weigh that evidence. *Id.* (citing *Jurgens v. CBK, Ltd.*, 80 F.3d 1566, 1572 (Fed. Cir. 1996)).