

No.

IN THE
Supreme Court of the United States

G. DAVID JANG, M.D.

Petitioner,

v.

BOSTON SCIENTIFIC CORPORATION, AND SCIMED LIFE
SYSTEMS, INC., NKA BOSTON SCIENTIFIC SCIMED, INC.,

Respondents.

**On Petition for a Writ of Certiorari
To the United States Court of Appeals
For the Federal Circuit**

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

After a trial on the merits, a jury found that respondents were liable for infringing petitioner's patent under the doctrine of equivalents, with stipulated damages in excess of \$86 million. But the district court set aside the verdict and entered judgment for respondents under a defense known as "ensnarement"—which was unknown at common law, is not contained in the Patent Act, and has never been recognized by this Court. The Federal Circuit affirmed. The question presented is:

Whether the Federal Circuit's "ensnarement" defense to infringement violates patent holders' Seventh Amendment jury-trial rights.

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PETITION FOR WRIT OF CERTIORARI

Petitioner G. David Jang, M.D., respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The opinion of the court of appeals (App., *infra*, 1a-27a) is reported at 872 F.3d 1275. The opinion of the district court (App., *infra*, 28a-38a) is unreported, but is available at 2015 WL 5822585.

JURISDICTION

The judgment of the court of appeals was entered on September 29, 2017. A timely petition for rehearing was denied on December 21, 2017. App., *infra*, 39a-40a. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The Seventh Amendment to the United States Constitution provides:

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

35 U.S.C. 282 is reproduced in the appendix to this petition. App., *infra*, 41a-43a.

STATEMENT

This case involves the Federal Circuit's "ensnarement" defense, under which a court may set aside a

jury verdict of patent infringement under the doctrine of equivalents based solely on a post-verdict judicial finding that the equivalence found by the jury unduly invades the prior art. Petitioner is a cardiologist who invented and patented a life-saving coronary stent. By contract, respondents agreed to pay petitioner millions of dollars if they commercialized a stent covered by his patent. Respondents did develop such a product, but they refused to pay petitioner. Petitioner sued, and a jury concluded that respondents' stent infringed claims of petitioner's patent under the doctrine of equivalents. But then the court entered judgment for respondents based on the ensnarement defense, and the Federal Circuit affirmed.

1. a. A patent can be infringed if the accused product meets each element of its claims as written—literal infringement—or, alternatively, under the doctrine of equivalents. See *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 23 (1997). Either way, infringement is a question of fact, *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609 (1950), as to which the patent holder is entitled to a jury trial under the Seventh Amendment, *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 377 (1996).

Under the well-established doctrine of equivalents, a product or process infringes a patent if “there is ‘equivalence’ between the elements of the accused product or process and the claimed elements of the patented invention.” *Warner-Jenkinson*, 520 U.S. at 21. In a typical doctrine-of-equivalents case, the jury hears evidence (usually expert testimony) about the claimed invention and the accused product and decides whether the allegedly infringing device “performs substantially the same function in substantially

the same way to obtain the same result” as the asserted patent claim. *Graver Tank*, 339 U.S. at 608 (quoting *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42 (1929)).

This Court has recognized that equivalence is a question of fact. *Graver Tank*, 339 U.S. at 609. Whether a product is equivalent to the patented product is “determined against the context of the patent, the prior art, and the particular circumstances of the case.” *Ibid.* Prior art, in particular, may help establish equivalence, because it may show that two components of the devices are known to be interchangeable and thus equivalent. *Id.* at 611-612. On the other hand, prior art may defeat equivalence, because if the asserted equivalent device was found in the prior art, then it could not be validly patented and is not an appropriate equivalent. *E.g.*, *Brill v. Washington Ry. & Elec. Co.*, 215 U.S. 527, 533 (1910).

b. In a series of cases culminating with this one, the Federal Circuit has made up a new legal defense—known as “ensnarement”—to address the interplay between the doctrine of equivalents and the prior art. This ensnarement defense is not found in the list of defenses to infringement in the Patent Act, see 35 U.S.C. 282(b); it was unknown at common law; and it has never been recognized by this Court.

According to the Federal Circuit, the ensnarement defense defeats a verdict of infringement under the doctrine of equivalents. Even where (as here) patent claims are indisputably infringed under the doctrine of equivalents, the patent holder loses if the court concludes that giving effect to this equivalence would unduly invade, or “ensnare,” the prior art. See *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 684 (Fed. Cir. 1990), overruled on other

grounds by *Cardinal Chem. Co. v. Morton Int'l, Inc.*, 508 U.S. 83, 99 (1993). Once the accused infringer invokes the ensnarement defense and identifies relevant prior art, the Federal Circuit requires the patent holder to (1) come up with a “hypothetical patent claim” that “literally cover[s] the accused product” and then (2) establish that the “hypothetical claim could have been allowed by the PTO over the prior art.” *Ibid.*

Although this Court held that equivalence in light of prior art is a question of fact, see *Graver Tank*, 339 U.S. at 609, the Federal Circuit has made ensnarement a question of law to be decided by the court. See *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1323-1324 (Fed. Cir. 2009). At the Federal Circuit’s direction, courts hold “mini-trials” on ensnarement after a jury verdict, and in those hearings, courts can find facts and overturn jury verdicts of infringement. App., *infra*, 20a-21a. The burden of defending the verdict is on the patent holder; if the patent holder does not craft a suitable hypothetical claim (under complex rules developed by the Federal Circuit, see *Streamfeeder, LLC v. Sure-Feed Sys., Inc.*, 175 F.3d 974, 983 (Fed. Cir. 1999)), then the patent holder loses at that step and forfeits his jury verdict, without any consideration of the prior art or whether the cited references are in fact “prior” art at all. See App., *infra*, 20a-21a. That is precisely what happened in this case.

2. Dr. Jang is a cardiologist and inventor. App., *infra*, 3a. He developed improvements to coronary stents that resulted in the patent at issue here, U.S. Patent No. 5,922,021 (the '021 patent). *Ibid.* Coronary stents act as scaffolding for a person’s arteries, holding blood vessels open to ensure blood flow. C.A.

J.A. 467. Before Dr. Jang's invention, stents lacked the optimal balance between the flexibility needed to navigate the stent through a person's blood vessels toward its eventual home, and the radial strength needed to keep the blood vessel propped open once the stent is placed. *Ibid.* Dr. Jang's stent design solved this problem by placing connecting struts with a particular geometry in "connecting strut columns," interspersed between columns of scaffolding, called "expansion columns," to strike the necessary balance between flexibility and strength. App., *infra*, at 3a-5a. Dr. Jang's innovation is represented in red in the figure below (*id.* at 3a):

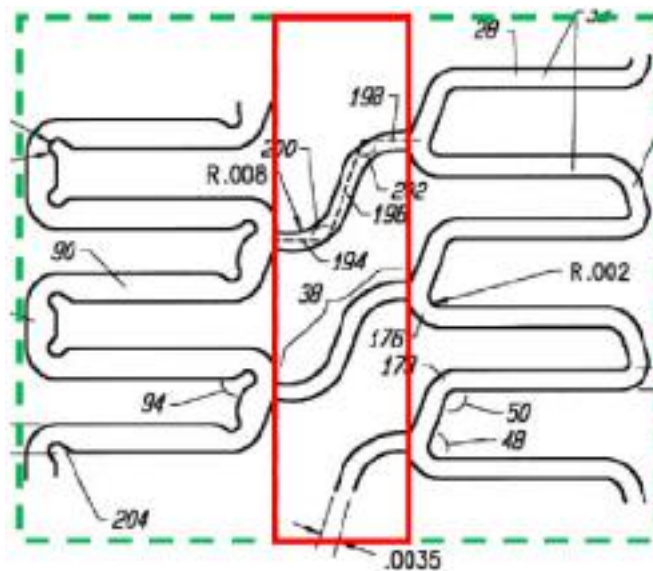


FIG. 90

Dr. Jang's patented invention was sufficiently groundbreaking to catch the attention of respondents, which are leading participants in the coronary stent market. See C.A. J.A. 41-42, 8054-8055. In 2002, Dr.

Jang entered into an agreement with respondents. App., *infra*, 6a. Dr. Jang assigned the '021 patent (and a portfolio of related patents) to respondents. *Ibid.* In return, respondents agreed to pay Dr. Jang \$50 million up front and additional royalty payments of up to \$110 million if respondents developed and sold a stent that was covered by (*i.e.*, but for the assignment, would infringe) Dr. Jang's patent. *Id.* at 6a-7a.

Respondents developed a stent—called the “Express stent”—that is covered by Dr. Jang's patent. App., *infra*, 6a. By May 2005, respondents' net sales of the Express stent already exceeded \$2.5 billion. See C.A. J.A. 9921. Respondents also used Dr. Jang's patent to exclude competitors from the market and defended the patent's validity in court. See *Cordis Corp. v. Boston Sci. Corp.*, 561 F.3d 1319, 1322 (Fed. Cir. 2009).

But respondents refused to pay Dr. Jang the money they owed him under the contract. For the past 13 years, Dr. Jang has been trying to get respondents to live up to their contractual obligations.

3. In 2005, Dr. Jang filed this lawsuit, alleging that respondents owe him millions of dollars under the contract because respondents' Express stent is covered by the '021 patent. App., *infra*, 7a.

Respondents have tried to avoid liability at every turn. They litigated this lawsuit asserting non-infringement for many years. They then changed tack and decided to try to invalidate the '021 patent, which Dr. Jang had assigned to them. App., *infra*, 7a. They petitioned the Patent and Trademark Office (PTO) for *ex parte* reexamination of the patent—but only the claims being asserted against them in this lawsuit—and also sought to raise a belated invalidity defense

in this lawsuit. *Ibid.* Although the PTO cancelled the challenged claims, the district court determined that it did not affect this lawsuit, because respondents already owed Dr. Jang the money under the contract as of 2005, so long as their stent practices the '021 patent. *Id.* at 5a n.1, 7a-8a; see C.A. J.A. 53, 6091.

This case proceeded to a jury trial on infringement. Respondents did not raise the defense of ensnarement in their motion for summary judgment, in the pre-trial order, or in their pre-verdict motion for judgment under Federal Rule of Civil Procedure 50(a). See App., *infra*, 21a-22a. Instead, near the end of trial respondents informed the court that, if the jury found infringement under the doctrine of equivalents, they would like to have a “mini[-]trial” where the court would consider the ensnarement defense and could potentially set aside the jury verdict. C.A. J.A. 9859. Dr. Jang argued that respondents had waived the ensnarement defense, but the district court disagreed. App., *infra*, 30a-33a.

The jury found infringement under the doctrine of equivalents. App., *infra*, 44a-46a. The jury was not instructed on ensnarement, C.A. J.A. 10371, and the special verdict form included no finding regarding this defense. App., *infra*, 44a-46a. As a result of the verdict, it is undisputed that Dr. Jang is entitled to \$86 million in stipulated royalty damages plus interest—for a total of more than \$200 million. C.A. J.A. 7559 & 7208 n.2.

4. After the verdict, the district court held a mini-trial on ensnarement. App., *infra*, 28a-29a. It placed the burden on Dr. Jang to craft a hypothetical claim that would satisfy the Federal Circuit’s test. *Id.* at 30a. Dr. Jang proposed several different hypothetical claims and ultimately proceeded on two of them; he

provided expert testimony about why the references on which respondents relied were not “prior” art and why there was no ensnarement. *Id.* at 34a-37a; see Jang C.A. Br. 45-46.

Based solely on perceived deficiencies in Dr. Jang’s hypothetical claims, the district court overturned the jury’s verdict and entered judgment in favor of respondents. App., *infra*, 28a-38a. Applying the Federal Circuit’s Byzantine rules for preparation of hypothetical claims, the district court found Dr. Jang’s first hypothetical claim insufficient because it impermissibly narrowed the claim in his patent and found his second claim insufficient because it failed to broaden the claim in the patent. *Id.* at 34a-37a. The court never considered whether any equivalent hypothetical claims actually invaded the prior art, or whether the asserted references were in fact prior art, instead overriding the jury verdict simply because it found Dr. Jang’s hypothetical claims insufficient. See *id.* at 35a-38a. The result was a windfall for respondents: Although a jury found that their stent had infringed Dr. Jang’s patent, and respondents had made billions of dollars using Dr. Jang’s technology, respondents were completely off the hook because of the ensnarement defense.

5. The Federal Circuit affirmed. App., *infra*, 1a-27a. Dr. Jang had argued that the Federal Circuit’s ensnarement defense was fundamentally flawed in numerous respects, including because it overrides a patent holder’s Seventh Amendment right to a jury trial. Jang C.A. Br. 43-51. The court of appeals rejected those arguments and upheld the decision to overturn the jury verdict on the basis of the ensnarement defense. The Federal Circuit also dismissed respondents’ cross-appeal as improper. App., *infra*, 26a.

The court of appeals first acknowledged that respondents did not challenge the “jury’s finding that the Express stent satisfies each claim element of the asserted claims [in the ’021 patent] under the doctrine of equivalents”—instead, the judgment for respondents rested entirely on ensnarement. App., *infra*, 15a. The court concluded that respondents had not waived the ensnarement defense, even though they had not raised it in a motion for summary judgment, in the pre-trial order, or in a motion for judgment as a matter of law under Rule 50(a), because they had mentioned the prior art in a motion *in limine* and a footnote in a trial brief. *Id.* at 22a, 32a-33a & n.4. And the court affirmed the post-trial finding of ensnarement solely because, in its view, Dr. Jang “as a threshold matter” had “failed to submit a proper hypothetical claim,” and thus failed to meet his burden to prove lack of ensnarement. *Id.* at 20a-21a.

The Federal Circuit expressly rejected the argument that “ensnarement is a factual question that must be tried to the jury.” App., *infra*, 21a-22a. The court stated that “ensnarement is a legal question for the district court to decide” and saw “nothing legally unsound” in a court “conduct[ing] a separate ensnarement proceeding after a jury verdict of infringement.” *Id.* at 22a; see *id.* at 16a. Solely on the basis of the ensnarement defense, the Federal Circuit concluded that the district court “appropriately vacated the jury verdict of infringement” and “entered judgment of non-infringement for [respondents].” *Id.* at 25a.

REASONS FOR GRANTING THE PETITION

After fighting this battle for more than a decade, Dr. Jang established, to the satisfaction of a jury, that respondents had infringed his patent and owe him hundreds of millions of dollars as a result. The district court set aside the jury's verdict based solely on the Federal Circuit's made-up "ensnarement" defense, and the Federal Circuit affirmed. This case vividly illustrates that it is time for this Court to review the ensnarement defense.

The most fundamental problem with the Federal Circuit's ensnarement defense is that it violates a patent holder's Seventh Amendment right to a jury trial on infringement. This Court's precedents establish that infringement is a factual question as to which the patent holder is constitutionally entitled to a jury trial and verdict. That is true whether the patent holder claims literal infringement or infringement under the doctrine of equivalents. In a doctrine-of-equivalents case, this Court has held that the prior art bears on equivalence, and the fact-finder therefore should consider the prior art when it decides infringement. But the Federal Circuit's ensnarement defense treats the interplay between equivalence and the prior art as a question of law for the court. And worse yet, it allows a court to set aside a jury verdict of infringement—not because the verdict lacked support in the evidence, but simply because the patent holder who successfully proved infringement to the jury fails to articulate a "hypothetical claim" that meets a series of arbitrary rules crafted by the Federal Circuit.

This case illustrates the pernicious effects of the ensnarement defense: The district court set aside the jury verdict of infringement, even though respondents *did not challenge* the jury's finding that their stent

was equivalent to the patented invention. In so doing, the court violated both clauses of the Seventh Amendment. Petitioner had the right to have a jury decide all aspects of his claim for infringement, including the impact of prior art, and the right not to have a district court reexamine the jury's finding of equivalence.

This Court's review is warranted. Patent holders regularly claim infringement based on the doctrine of equivalents. The ensnarement defense injects instability and uncertainty into every such case. Further, the ensnarement defense gives proven infringers a second bite at the apple—an opportunity to escape liability *after* a verdict of infringement by arguing that the equivalence found by the jury ensnares the prior art. The Federal Circuit has compounded these problems by shifting the burden to the patent holder to propose a hypothetical claim that the court will find sufficient. The very real threat that courts will erase verdicts of infringement by post-trial invocation of ensnarement will discourage patent holders from enforcing their full spectrum of rights. Review and reversal of the Federal Circuit's decision is necessary to restore certainty to the scope of intellectual property owners' rights and the patent system generally.

I. THE ENSNAREMENT DEFENSE VIOLATES THE SEVENTH AMENDMENT

The Federal Circuit's ensnarement defense violates a patent holder's right to a jury trial on infringement, and allows the district court to reexamine the jury's verdict of infringement, in violation of the Seventh Amendment. Because the Federal Circuit's decision conflicts with decisions of this Court on this important constitutional issue, certiorari is warranted. See Sup. Ct. R. 10.

A. Patent Holders Have a Constitutional Right to a Jury Trial on Infringement, Including Equivalence

1. The Seventh Amendment “preserve[s]” the “right of trial by jury” in “Suits at common law.” U.S. Const. amend. VII. The “thrust of the Amendment was to preserve the right to jury trial as it existed in 1791.” *Curtis v. Loether*, 415 U.S. 189, 193 (1974). Because the modern cause of action for patent infringement descended from “infringement actions tried at law in the 18th century,” “infringement cases today must be tried to a jury, as their predecessors were more than two centuries ago.” *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 377 (1996).

This Court has long recognized that a patent holder may establish infringement either literally or through the doctrine of equivalents. See, e.g., *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 414-415 (1908); *McCormick v. Talcott*, 61 U.S. 402, 405 (1857). “[T]he essential predicate of the doctrine of equivalents is the notion of identity between a patented invention and its equivalent,” and thus “there is no basis for treating an infringing equivalent any differently from a device that infringes the express terms of the patent.” *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 35 (1997).

Infringement under the doctrine of equivalents, like literal infringement, is a question of fact. *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609 (1950). In *Winans v. Denmead*, the case most often credited as a progenitor of the doctrine of equivalents, this Court remanded for jury consideration of equivalence, noting that equivalence is “a question of fact, which it belonged to the jury to determine.” 56 U.S. (15 How.) 330, 333, 338 (1854). This Court has

emphasized that a court should “seldom or never” “undertake to determine without a jury whether a particular ingredient substituted in a reissued patent was or was not known . . . as a proper substitute”—that is, decide equivalence. *Gill v. Wells*, 89 U.S. (22 Wall.) 1, 29-30, 31-32 (1874). Most recently, in *Warner-Jenkinson*, the Court noted the “ample support in [its] prior cases” for the conclusion that equivalence is a jury issue. 520 U.S. at 38.

2. Equivalence almost invariably depends in part on the prior art. The patent holder’s theory in a doctrine-of-equivalents case is that the challenged device infringes not the literal patent claim but an insubstantially different (equivalent) claim. *Graver Tank*, 339 U.S. at 608-609. If the asserted equivalent claim was known in the prior art, then it could not have been patented, and it therefore is not an appropriate equivalent. See, e.g., *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 684 (Fed. Cir. 1990) (“since prior art always limits what an inventor could have claimed, it limits the range of permissible equivalents of a claim”), overruled on other grounds by *Cardinal Chem. Co. v. Morton Int’l, Inc.*, 508 U.S. 83, 99 (1993).

The Court recognized as much in *Graver Tank*. It reiterated that “[a] finding of equivalence is a determination of fact,” then explained that equivalence should be determined “against the context of the patent, the prior art, and the particular circumstances of the case.” 339 U.S. at 609. The Court noted that proof of equivalence can be made “in any form,” including by “testimony of experts or others versed in the technology”; “by documents, including texts and treatises”; and “by the disclosures of the prior art.” *Id.* at 609-610. As with “any other issue of fact,” the

equivalence determination depends on “a balancing of credibility, persuasiveness and weight of evidence,” and that determination “should not be disturbed” on appeal unless the determination is “clearly erroneous.” *Ibid.*

Accordingly, in a case where the patent holder argues infringement under the doctrine of equivalents, and the alleged infringer invokes the prior art, the prior art is to be considered by the finder of fact for its relevance to the ultimate question of infringement. That is precisely what this Court instructed in *Graver Tank*. In upholding a judgment of infringement under the doctrine of equivalents, the Court observed that the prior art was one “[p]articularly important” fact considered by the finder of fact (there, the court) in determining equivalence. 339 U.S. at 611. Where, as here, infringement is tried to a jury, the prior art must be considered by the jury, and its verdict is entitled to deference on post-verdict judicial review.

B. The Federal Circuit’s Ensnarement Defense Makes Equivalence a Question of Law for the Court

This Court’s cases set out a straightforward way to account for prior art in a doctrine-of-equivalents case: The jury considers the prior art in deciding whether an allegedly infringing device is an equivalent to a patented claim. But rather than follow this Court’s precedents, the Federal Circuit has invented a new approach—the ensnarement defense—which allows a district court to nullify an unchallenged jury verdict of infringement, as a matter of law, without ever considering the prior art at all.

1. Building on prior decisions that recognized that prior art can limit the scope of equivalents, the Federal Circuit set out the framework for the ensnarement defense in *Wilson Sporting Goods*. In that case, the Federal Circuit found no doctrine-of-equivalents infringement because “the [golf] balls which the jury found to infringe” were known in “the prior art.” 904 F.2d at 683. The court correctly recognized that “there can be no infringement” under the doctrine of equivalents “if the asserted scope of equivalency of what is literally claimed would encompass the prior art.” *Ibid.* But rather than have the jury consider the prior art as part of deciding infringement, the Federal Circuit announced that the ensnarement defense could be decided by the court as an “issue . . . of law.” *Id.* at 684; see *id.* at 687.

The Federal Circuit then set out a complicated test for assessing ensnarement. It requires the patent holder to

conceptualize the limitation on the scope of equivalents by visualizing a hypothetical patent claim, sufficient in scope to literally cover the accused product. The pertinent question then becomes whether that hypothetical claim could have been allowed by the PTO over the prior art. If not, then it would be improper to permit the patentee to obtain that coverage in an infringement suit under the doctrine of equivalents.

Wilson Sporting Goods, 904 F.2d at 684. Even though this sounds like a classic invalidity-type analysis, see *Microsoft Corp. v. i4i Ltd. P’ship*, 564 U.S. 91, 96-97 (2011), in which the burden of proof to demonstrate invalidity is on the accused infringer, the Federal Circuit placed the burden on the patent holder to satisfy

its newly invented test. *Wilson*, 904 F.2d at 685. (The Federal Circuit has said that its hypothetical claim test is not the exclusive method for deciding ensnarement, *Conroy v. Reebok Int'l, Ltd.*, 14 F.3d 1570, 1576-1577 (Fed. Cir. 1994), but it never has offered an alternative approach.) Over time, the Federal Circuit has further complicated its test, explaining that the hypothetical claim must slightly “broaden[]” the patent’s claims but cannot “narrow[]” them in any way. *Streamfeeder*, 175 F.3d at 983.

District courts have invoked the ensnarement defense to enter judgments of non-infringement in several cases, and the Federal Circuit has approved that approach. See, e.g., *Gemalto S.A. v. HTC Corp.*, 754 F.3d 1364, 1374 (Fed. Cir. 2014); *Ultra-Tex Surfaces, Inc. v. Hill Bros. Chem. Co.*, 204 F.3d 1360, 1364 (Fed. Cir. 2000); *Marquip, Inc. v. Fosber Am., Inc.*, 198 F.3d 1363, 1367-1368 (Fed. Cir. 1999); *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1368 (Fed. Cir. 1999).

2. In 2009, the Federal Circuit went even further, expressly rejecting the argument that a patent holder’s constitutional right to a jury trial on infringement also includes the defense of ensnarement. The court of appeals acknowledged “the jury’s proper fact-finding role in assessing the equivalence of each limitation of a claim,” but held that ensnarement is a “policy oriented” “legal limitation[]” on the doctrine of equivalents that should be decided by a court. *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1322-1323 (Fed. Cir. 2009) (emphasis added; internal quotation marks omitted). And it made clear that the court can use ensnarement to take away a jury verdict of infringement. *Id.* at 1323 (“This limitation is imposed even if

a jury has found equivalence as to each claim element”).

The Federal Circuit drew a false analogy between the ensnarement defense and prosecution history estoppel, an *equitable* doctrine that in certain circumstances precludes the patent holder from broadening claims that he has previously narrowed during patent prosecution. *DePuy*, 567 F.3d at 1323-1324; see *Warner-Jenkinson*, 520 U.S. at 30. The court “s[aw] no reason” to treat ensnarement and prosecution history estoppel differently, announcing that both are “questions of law” that limit the doctrine of equivalents. *DePuy*, 567 F.3d at 1324. The court therefore concluded that “ensnarement is a question of law for the court, not the jury, to decide.” *Ibid.* The court instructed district courts to address ensnarement “either on a pre[-]trial motion for partial summary judgment or on a motion for judgment as a matter of law at the close of the evidence and after the jury verdict.” *Ibid.* (quoting *Warner-Jenkinson*, 520 U.S. at 39 n.8).

3. In this case, the ensnarement defense passed its breaking point. Here, as in the prior cases, the Federal Circuit held that ensnarement is “a legal question for the district court to decide” and that “the burden of proving patentability of the hypothetical claim rests with the patentee” (*i.e.*, the patent holder who already had obtained a jury verdict of infringement). App., *infra*, 17a, 22a (internal quotation marks omitted). But in this case, the court concluded that the patent holder loses his jury verdict if the court does not approve his “hypothetical claim”—even before the court considers whether there is any prior art or whether the prior art actually is “ensnared.” *Id.* at 20a-21a. The court relied on Dr. Jang’s “troubles in

drafting a proper hypothetical claim that encompassed the Express stent yet was also patentable in the face of seemingly crowded prior art.” *Id.* at 20a. Those “troubles” existed only because ensnarement was not asserted at trial, and so the verdict form did not ask the jury to find which claim element was infringed by equivalence rather than literally—or to consider the prior art. There would have been no such “troubles” had the district court submitted all issues relevant to infringement to the jury.

The Federal Circuit went even further, abandoning its previously announced rule that ensnarement must be raised in a summary judgment motion or a motion for judgment as a matter of law. *App.*, *infra*, 22a. Instead, it held that ensnarement can be raised and decided by the district court at any time, even after trial, subject only to a loose (and apparently easily satisfied) requirement of “notice.” *Id.* at 22a-23a.

The combined effect of these decisions is that in a doctrine-of-equivalents case, the court holds its own mini-trial, after the verdict, whenever the alleged infringer contends that the adjudicated equivalence ensnares the prior art. The burden of defending the jury verdict and proving no ensnarement is on the patent holder. And the patent holder can lose the case, even after an unchallenged jury verdict in his favor, based merely on a technical deficiency in his hypothetical claims without regard to whether any pertinent prior art even existed, let alone was “ensnared.”

C. The Ensnarement Defense Violates Both the Jury Trial Clause and the Reexamination Clause of the Seventh Amendment

1. The ultimate question for the jury in a case like this one is whether there was infringement based on

the doctrine of equivalents. As this Court explained in *Graver Tank*, both the general question of equivalence and the specific question of the interplay of prior art with the asserted equivalents are fact questions. 339 U.S. at 609, 611. Because a patent holder indisputably has a right to a jury trial on infringement, see *Markman*, 517 U.S. at 377, and equivalence is the way to determine infringement in a doctrine-of-equivalents case, a patent holder has a right to a jury trial on equivalence. Accordingly, the prior art should be considered by the jury in deciding infringement, and not by the court through a post-verdict mini-trial on the ensnarement defense. Because the Federal Circuit’s ensnarement defense takes the issue of equivalence in light of the prior art out of the hands of the jury, *DePuy*, 567 F.3d at 1323-1324, it squarely conflicts with this Court’s decisions in *Markman* and *Graver Tank*.

More fundamentally, the ensnarement defense violates patent holders’ right to a jury trial on infringement. It prevents the jury from deciding an issue critical to infringement—the impact of prior art—and then permits the court to override the jury’s finding on the infringement issue it *was* allowed to decide—not based on insufficiency of the evidence, but based on the perceived deficiencies in hypothetical claims that were never even considered by the jury. The jury’s verdict may be cast aside even where—as here—the infringer *does not challenge the verdict of infringement*. App., *infra*, 15a (respondents did not challenge the “jury’s finding that the Express stent satisfies each claim element of the asserted claims [in the ’021 patent] under the doctrine of equivalents”). It is difficult to imagine an approach more inimical to the Seventh Amendment jury-trial right.

Courts ordinarily, and appropriately, give great deference to jury verdicts. A jury verdict of infringement under the doctrine of equivalents, as with other factual issues, can only be overturned if it is not supported by substantial record evidence. See App., *infra*, 11a (citing cases). But because the Federal Circuit’s “hypothetical claim” approach to analyzing ensnarement is decided as a matter of law by the court and places the burden on the patent-holder, an unchallenged jury verdict of infringement can be extinguished based solely on an imperfectly formed hypothetical claim proffered after trial where neither the jury nor the court looked at the prior art. That is just what happened here: The Federal Circuit affirmed a court’s decision to throw out an undisputed jury verdict of infringement based on equivalence solely because Dr. Jang’s proposed hypothetical claims were deemed inadequate. And even though Dr. Jang challenged both whether the references qualified as prior art and the merits of ensnarement, there was no consideration of the (supposed) prior art *at all*.

Although the Federal Circuit has analogized the ensnarement defense to prosecution history estoppel, they have nothing in common. Prosecution history estoppel is based on the patent holder’s conscious decision to narrow a claim’s scope during patent prosecution in order to obtain a patent from the PTO. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 727 (2002). It is an equitable doctrine that constrains the patent holder’s ability to enforce the resulting patent. *Ibid.* Ensnarement, in contrast, is a stand-alone legal defense to infringement that has nothing to do with how the patent was prosecuted. It is based on prior art evidence that, if accepted, defeats the claim entirely rather than constraining the patent holder’s ability to enforce its patent rights, as estoppel

does. The prior art is relevant to whether there is infringement, and whether there is infringement is a jury question—as are all legal defenses to infringement. The Federal Circuit therefore was wrong to treat consideration of whether an equivalent ensnares the prior art as a question of law.

2. The district court here also impermissibly reexamined a jury finding of equivalence after trial without a Rule 50(a) motion. The Reexamination Clause provides that, in lawsuits for which there is a Seventh Amendment jury trial, “no fact tried by a jury, shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law.” U.S. Const. amend. VII.

The Federal Circuit has previously and correctly recognized that it is “constitutionally impermissible for the district court to re-examine the jury’s verdict and to enter JMOL [judgment as a matter of law] on grounds not raised in the pre-verdict [motion for] JMOL.” *Duro-Last, Inc. v. Custom Seal, Inc.*, 321 F.3d 1098, 1107 (Fed. Cir. 2003). This Court also has categorically rejected post-trial judgments notwithstanding the verdict as expressly forbidden by the Seventh Amendment. See *Slocum v. New York Life Ins. Co.*, 228 U.S. 364, 399 (1913). Accordingly, in order to avoid a Seventh Amendment violation, a party must first make a pre-verdict motion for judgment under Federal Rule of Civil Procedure 50(a) and then renew it in a post-verdict motion under Rule 50(b). See *Unitherm Food Sys., Inc. v. Swift-Eckrich, Inc.*, 546 U.S. 394, 401-402 & n.4 (2006); *Neely v. Martin K. Eby Constr. Co.*, 386 U.S. 317, 321 (1967); *Baltimore & Carolina Line v. Redman*, 295 U.S. 654, 658-661 (1935).

This Court has recognized the same interplay between the Seventh Amendment and the Federal Rules in the infringement context. In *Warner-Jenkinson*, this Court specifically provided that prosecution history estoppel should be decided “on a pre[-]trial motion for partial summary judgment [Rule 56] or on a motion for judgment as a matter of law at the close of the evidence [Rule 50(a)] and after the jury verdict [Rule 50(b)].” 520 U.S. at 39 n.8. The Court’s guidance is consistent with the stated purpose behind Rule 50—to prevent violation of the Seventh Amendment’s Reexamination Clause. See Fed. R. Civ. P. 50 advisory committee’s note (1991 amendment).

Here, respondents never raised ensnarement in a Rule 50 motion. (They filed a Rule 50(a) motion, but it did not mention ensnarement.) The Federal Circuit nevertheless found that respondents had preserved the ensnarement argument because they had mentioned the prior art in a pre-trial motion *in limine* and in a footnote in a trial brief. App., *infra*, 22a. The Federal Circuit decided that it was acceptable for the court to consider the ensnarement defense because Dr. Jang had “sufficient notice.” *Ibid*. But the problem is not notice—it is the court’s intrusion on the role of the jury. Abandoning the requirement that ensnarement be raised on summary judgment or Rule 50 not only conflicts with *Warner-Jenkinson*, it violates the Seventh Amendment by keeping an issue from the jury and then allowing a court to second-guess the jury’s fact finding. This is precisely what the Reexamination Clause was adopted to prevent.

3. In addition to violating patent holders’ Seventh Amendment rights, the ensnarement defense makes little sense on its own terms. The ensnarement de-

fense is not among the defenses to infringement enumerated in the Patent Act. See 35 U.S.C. 282. That alone is sufficient reason to reject it. See, e.g., *Aristocrat Techs. Austral. Pty. Ltd. v. Int’l Game Tech.*, 543 F.3d 657, 661-664 (Fed. Cir. 2008). As the district court recognized in this case, ensnarement is not a “legal limitation” ever recognized by this Court. App., *infra*, 29a n.1. Instead, it was invented by the Federal Circuit. But making up new defenses to patent infringement is a job for Congress. Cf. *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 137 S. Ct. 954, 960 (2017) (where Congress has spoken directly to statute-of-limitations issue, courts may not make up additional limitations); see also Br. in Opp. at 3, *Cordis Corp. v. Boston Scientific Corp.*, 558 U.S. 1049 (Oct. 29, 2009) (No. 09-365), 2009 WL 3614464 (respondents’ recognition that the Supreme Court has “repeatedly, and explicitly, deferred to Congress for any fundamental modifications of the doctrine of equivalents”).

Further, the ensnarement defense confuses basic concepts of patent law. The Federal Circuit created this new defense by mixing and matching components from separate parts of the Patent Act. Ensnarement is supposed to be a defense to infringement, but the court decided that a patent holder should prove lack of ensnarement by comparing prior art to “hypothetical” claims—a classic invalidity analysis, but with the burden of proof reversed. See *DePuy*, 567 F.3d at 1324-1339. The ensnarement defense thus breaks down the division between invalidity and infringement that this Court recently reaffirmed in *Commil USA, LLC v. Cisco Sys., Inc.*, 135 S. Ct. 1920, 1928 (2015) (holding that a defendant’s belief regarding patent validity is not a defense to a claim of induced in-

fringement). It ignores the “long accepted truth—perhaps the axiom—that infringement and invalidity are separate matters under patent law.” *Ibid.*

Although the Federal Circuit smuggled invalidity concepts into its made-up ensnarement defense, it adopted the burden and evidentiary standard for infringement (patent holder proves by a preponderance of the evidence, see *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S. Ct. 1923, 1934 (2016)), rather than invalidity (alleged infringer proves by clear and convincing evidence, see *Microsoft*, 564 U.S. at 100-103). As a result, the ensnarement defense essentially allows an infringer to defeat liability through a back-door invalidity analysis, without overcoming the patent’s statutory presumption of validity. See 35 U.S.C. 282.

The Federal Circuit has also constructed elaborate procedural hurdles that the patent-holder must meet to preserve a jury verdict of equivalent infringement, and those hurdles improperly knock out unchallenged verdicts of equivalence. Federal Circuit precedent requires that the hypothetical claim must “contain[] both the literal claim scope and the accused device.” *Intendis GMBH v. Glenmark Pharm. Inc.*, 822 F.3d 1355, 1363 (Fed. Cir. 2016). The hypothetical claim must be broader than the original claim, but not narrower in any way or for any reason. *Streamfeeder*, 175 F.3d at 983.

The ensnarement defense has no analogue in ordinary commercial litigation. It was made up by the Federal Circuit, is exempt from the normal rules of civil procedure, and applies only in cases in which patent infringement is premised on the doctrine of equivalents. Yet, for all its complexity and doctrinal confusion, the ensnarement defense is entirely unnecessary.

4. The correct approach to proving (or disproving) infringement under the doctrine of equivalents is much simpler—the prior art should be submitted to the jury, typically with expert testimony, as part of the equivalence inquiry. That approach also has the virtues of being true to this Court’s precedents and complying with the Seventh Amendment.

The question of infringement is a question of fact on which the patent holder has the right to a jury trial. See *Markman*, 517 U.S. at 377. When a patent holder alleges infringement based on the doctrine of equivalents, prior art can help establish equivalence (*Graver Tank*, 339 U.S. at 611) or disestablish equivalence (*Brill v. Washington Ry. & Elec. Co.*, 215 U.S. 527, 533 (1910)), but, in either case, it remains part and parcel of the equivalence analysis related to infringement. Accordingly, prior art should be considered by the jury as part of the infringement question. If the prior-art evidence is so clear as to preclude infringement as a matter of law, the court can decide that on a motion for summary judgment, see Fed. R. Civ. P. 56, or a pre-verdict motion for judgment as a matter of law, see Fed. R. Civ. P. 50. Otherwise, the impact of the prior art is for the jury to decide.

At the end of the day, the Federal Circuit’s ensnarement defense is ill-conceived and unnecessary. Infringement by equivalence is infringement. Prior art is just evidence relevant to infringement. Just as there is no special rule based on the prior art for setting aside a jury verdict of literal infringement, see *In re Omeprazole Patent Litig.*, 536 F.3d 1361, 1377 (Fed. Cir. 2008); *Tate Access Floors, Inc. v. Interface Architectural Res., Inc.*, 279 F.3d 1357, 1367 (Fed. Cir.

2002), there should be no special rule for setting aside a jury verdict of doctrine-of-equivalents infringement.

II. THIS COURT'S REVIEW IS WARRANTED NOW

As noted above, the ensnarement defense finds no purchase in this Court's several decisions addressing infringement under the doctrine of equivalents. Rather, it has been invented and expanded by the Federal Circuit in a series of decisions, each of which has added another layer of complexity like barnacles on the hull of a ship. Those decisions culminated in this one, in which the Federal Circuit approved the setting aside of an unchallenged jury verdict of infringement on the sole ground of ensnarement, without even considering the prior art.

A. This Court's Guidance Is Necessary

1. The Federal Circuit started down the wrong path with ensnarement more than two decades ago, and it has followed that road rather than correcting course ever since. Although the underlying premise—that a device cannot infringe under the doctrine of equivalents “if the asserted scope of equivalency of what is literally claimed would encompass the prior art,” *Wilson Sporting Goods*, 904 F.2d at 683—is unexceptional, the Federal Circuit ignored this Court's guidance that the finder of fact is fully capable of making this determination as part of the equivalence analysis. *Graver Tank*, 339 U.S. at 609-611. And once this link was broken, the defense quickly grew out of control, with hypothetical claim requirements, shifting burdens, and open invasion of the jury-trial right.

As the defense has spiralled out of control, the Federal Circuit has introduced inconsistencies that

create uncertainty in doctrine-of-equivalents cases. For example, in *Wilson Sporting Goods*, the Federal Circuit placed the burden of establishing the relationship between the prior art and the claimed range of equivalents on the patent holder, 904 F.2d at 684-686, but in other decisions, the Federal Circuit placed that burden on the infringer, e.g., *National Presto Indus., Inc. v. West Bend Co.*, 76 F.3d 1185, 1192 (Fed. Cir. 1996). There are also decisions describing a complex procedure where the burden continually shifts back and forth between the patent holder and infringer. See, e.g., *Interactive Pictures Corp. v. Infinite Pictures, Inc.*, 274 F.3d 1371, 1380 (Fed. Cir. 2001); *Streamfeeder*, 175 F.3d at 983.

The Federal Circuit's treatment of ensnarement has continued to evolve and expand. Even though this Court made clear that the prior art raises a fact question, the Federal Circuit in *Wilson Sporting Goods* treated the issue as one of law. 904 F.2d at 684. The Federal Circuit conceived of the hypothetical claim approach as a way to "simplify [the] analysis," *ibid.*, but this case proves that coming up with an acceptable hypothetical claim post-verdict—*i.e.*, one that is both "broadening" and "not narrowing"—is anything but simple. Moreover, in *DePuy*, the Federal Circuit followed *Warner-Jenkinson* in holding that ensnarement must be decided by the court on a motion for summary judgment or on a motion for judgment as a matter of law, 567 F.3d at 1324, but then in this case, the Federal Circuit removed that limitation, raising serious Reexamination Clause concerns. App., *infra*, 22a.

2. The Federal Circuit's approach takes the focus away from the claims issued by the PTO and forces the litigants, and the courts, to address hypothetical

claims that the PTO never examined and then to speculate as to whether those claims would be patentable as a basis for determining liability. This thought experiment is so procedurally complex, divorced from the actual claims and prior art, and mired with traps (regarding what is broadening or narrowing) that it renders the doctrine of equivalents unrecognizable.

This case demonstrates that the Federal Circuit's ensnarement defense has crossed the constitutional line. It was used here, and (absent this Court's intervention) will be available in the future in *any* doctrine-of-equivalents case, to overturn a jury verdict of infringement, for a commercially viable and valuable patent, based solely on perceived deficiencies with *hypothetical* claims. This approach literally negates the property rights that inhere in an issued U.S. patent.

This Court has not hesitated to step in when the Federal Circuit has created unworkable and unnecessary patent doctrines. See, e.g., *SCA Hygiene Prods. Aktiebolag*, 137 S. Ct. at 962-966 (rejecting Federal Circuit's special laches rule for patent claims); *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2130 (2014) (rejecting the "insolubly ambiguous" test for indefiniteness); *Limelight Networks, Inc. v. Akamai Techs., Inc.*, 134 S. Ct. 2111, 2117-2118 (2014) (rejecting the Federal Circuit's divided infringement test); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 415 (2007) (rejecting the "rigid" teaching-suggestion-motivation test for obviousness); *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 392-393 (2006) (rejecting automatic injunctions); *Festo*, 535 U.S. at 739 (rejecting Federal Circuit's *per se* rule that a narrowing amendment surrenders the full range of equivalence). The Court's guidance is similarly necessary here.

B. The Question Presented Is Important

1. The doctrine of equivalents is a well-established way to prove patent infringement. It has been recognized by this Court in many cases over a period of more than 150 years. See, e.g., *Festo*, 535 U.S. at 732; *Warner-Jenkinson*, 520 U.S. at 28; *Graver Tank*, 339 U.S. at 608-609; *Brill*, 215 U.S. at 533; *Continental Paper Bag Co.*, 210 U.S. at 414-415; *Thompson v. Boisselier*, 114 U.S. 1, 14 (1885); *Blake v. City & Cty. of S.F.*, 113 U.S. 679, 681 (1885); *Zane v. Soffe*, 110 U.S. 200, 203-204 (1884); *Duff v. Sterling Pump Co.*, 107 U.S. 636, 639 (1883); *Imhaeuser v. Buerk*, 101 U.S. 647, 655-656 (1879); *Chicago & N.W. Ry. Co. v. Sayles*, 97 U.S. 554, 562-563 (1878); *Union Paper-Bag Mach. Co. v. Murphy*, 97 U.S. 120, 125 (1877); *Gill*, 89 U.S. (22 Wall.) at 14-15; *Winans*, 56 U.S. (15 How.) at 338. And it is a commonly raised issue in patent infringement litigation where the accused device only differs in insubstantial ways from the patent claims.

The ensnarement defense, by contrast, has never been mentioned—much less approved—in any of this Court’s decisions. One could read every version of the Patent Act and each volume of the United States Reports and find nary a reference to “ensnarement.” As far as the *law* is concerned, this defense does not exist.

Yet, as this case illustrates, the Federal Circuit’s continued application of its made-up defense has profound implications for every doctrine-of-equivalents case. An accused infringer can go through an entire trial, keeping the ensnarement defense in its back pocket to use if the jury returns a verdict of infringement. The defense allows the infringer to nullify the jury verdict, essentially giving that party a bench trial after it loses in front of a jury. And the second trial is

even better for the infringer than the first one, because the burden of proof is on the patent holder, and the court can nullify the verdict based merely on the technical wording of hypotheticals.

The verdict-eliminating effect of the decision below has garnered widespread attention in the patent community. See, e.g., James E. Lowe, Jr., *Raising an Ensnarement Defense Defeats the Doctrine of Equivalents*, Nat'l L. Rev. (Feb. 1, 2018), <https://www.natlawreview.com/article/raising-ensnarement-defense-defeats-doctrine-equivalents>; Ryan Davis, *Ensnarement 101: Anatomy Of An Uncommon Patent Defense*, Law360 (Oct. 24, 2017), <https://www.law360.com/articles/976807/ensnarement-101-anatomy-of-an-uncommon-patent-defense>; Joseph R. Mencher, *Infringement Under Doctrine of Equivalents Remains Difficult to Win*, Lexology (Oct. 9, 2017), <https://www.lexology.com/library/detail.aspx?g=c957f55e-4ef3-465f-99dc-2d6bf554f0a3>.

The opportunity for gamesmanship is heightened in contract cases like this one, where for many years respondents did not challenge the validity of the patent, but instead defended validity and aggressively asserted the patent against their competitors. See *Cordis Corp. v. Boston Sci. Corp.*, 561 F.3d 1319, 1331-1332 (Fed. Cir. 2009). Indeed, respondents even relied on the doctrine of equivalents to their advantage with respect to this very same patent. Br. in Opp. at 1-3, *Cordis Corp.*, 558 U.S. 1049 (Oct. 29, 2009) (No. 09-365), 2009 WL 3614464.

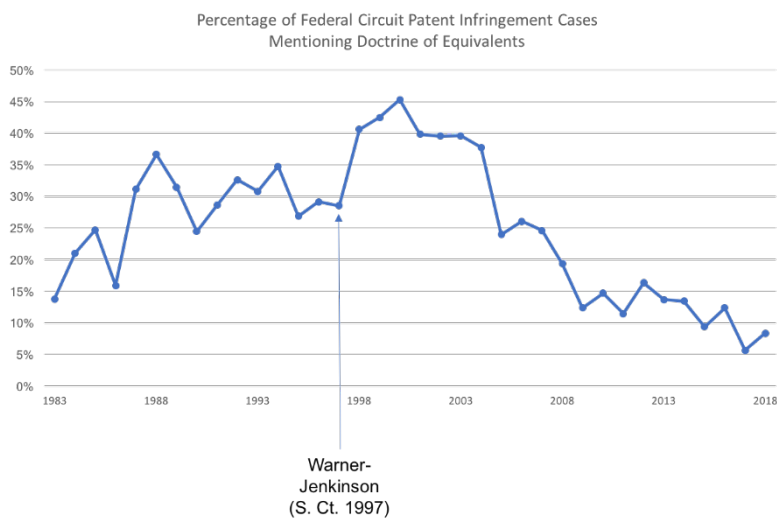
2. In *Warner-Jenkinson*, this Court reaffirmed the doctrine of equivalents, but expressed “concern . . . that the doctrine of equivalents, as it has come to be applied since *Graver Tank*, has taken on a life of its own, unbounded by the patent claims.” 520 U.S. at

28-29. The Court struck a balance in *Warner-Jenkinson*, explaining that two existing doctrines—prosecution history estoppel and vitiation of a claim element—can be used to limit equivalence, but only if they are presented in a “pre[-]trial motion for partial summary judgment or on a motion for judgment as a matter of law at the close of the evidence and after the jury verdict.” *Id.* at 39 n.8 (citing Fed. R. Civ. P. 50 and 56). The Court then left it to the Federal Circuit to decide “how best to implement procedural improvements to promote certainty, consistency, and reviewability” to the doctrine of equivalents. *Ibid.*

The Federal Circuit has upset that balance, going well beyond the bounds established by this Court’s precedents to recognize ensnarement as a new “legal” limitation on equivalents and permitting courts to address that limitation after trial without a pre-verdict motion for judgment as a matter of law. Unlike prosecution history estoppel, which is an equitable doctrine uniquely within the power of federal courts to revise and apply, the Federal Circuit has no authority to adopt a legal defense to patent infringement, see 35 U.S.C. 282(b), or to remove such a defense from consideration by the jury. See *Warner-Jenkinson*, 520 U.S. at 38. The Federal Circuit’s ensnarement defense has “taken on a life of its own” and should be addressed by this Court.

3. The doctrine of equivalents is commonly asserted in patent cases, and modifications to the doctrine of equivalents have real consequences for intellectual property rights. The chart below shows the percentage of Federal Circuit patent infringement cases each year that mention the doctrine of equivalents. It shows that while the Federal Circuit has con-

sidered a substantial number of doctrine-of-equivalents cases each year for the past 35 years, the number of such cases has dropped precipitously in recent years. Although the doctrine of equivalents appeared in 45% of the Federal Circuit's patent infringement cases in 2000, that declined to only 5.6% in 2017:



Although the *Warner-Jenkinson* Court encouraged the Federal Circuit to adopt appropriate procedures to regulate the doctrine of equivalents, see 520 U.S. at 28-29, 39 n.8, it never suggested that the Federal Circuit should do away with the doctrine altogether. The pendulum has now swung too far in the other direction. There has been a precipitous drop in the number of doctrine-of-equivalents cases since *Warner-Jenkinson*. While the data do not necessarily indicate a causal relationship between this decline and the Federal Circuit's expansion of the ensnarement defense, the correlation is remarkable.

The Federal Circuit has failed to heed this Court's guidance that "courts must be cautious before adopting changes that disrupt the settled expectations of

the inventing community.” *Festo*, 535 U.S. at 739. The doctrine of equivalents is a long-recognized means of proving infringement; yet as this case illustrates, the ensnarement defense renders it vaporous. The Court should bring clarity to this area so that parties can have certainty about the scope of patent rights and be able to make financial decisions based on those rights.

C. This Case Is an Ideal Vehicle for Tackling the Ensnarement Defense

This case presents an ideal vehicle for deciding whether infringers can assert the ensnarement defense after trial to nullify a jury’s verdict of infringement under the doctrine of equivalents. Dr. Jang’s coronary stent patent is indisputably important. This inventive stent was a next-generation innovation in a market for life-saving technology. Commercializing the invention made respondents over \$2.5 billion in its first five years alone. C.A. J.A. 42, 9921.

Ensnarement was the dispositive issue in this case. “[A] duly-empaneled jury in this case delivered its special verdict” of infringement, App., *infra*, 28a, and then the district court took the verdict away based solely on ensnarement. *Id.* at 9a. Dr. Jang objected to the ensnarement holding on numerous grounds, including that it violated his Seventh Amendment right to a jury trial. Jang C.A. Br. 43-51. The court of appeals considered, and rejected, those arguments. App., *infra*, 20a-25a. And the Federal Circuit’s decision in this case is not an outlier in that court—it is the culmination of decades of cases.

The impact of the ensnarement defense here is particularly unconscionable. The court set aside a

verdict for infringement of a lifesaving patent, entitling the patent owner to more than \$200 million with interest, based on the court's after-the-fact conjecture. If ever there were a case where this Court should step in to fix (or, at minimum, to address) the ensnarement defense, this is the case.

Dr. Jang represents every ideal of the American intellectual property system. As a practicing cardiologist, he recognized a problem in his field and used his knowledge, creativity, and hard work to create a solution. Respondents recognized the value in Dr. Jang's invention and contracted to pay him millions of dollars for commercializing it. As the jury found, Dr. Jang deserves to reap the benefits of his ingenuity.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted.

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