

No. 17-1332

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
Court of Appeals for the Federal Circuit**

BRIEF IN OPPOSITION

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QUESTION PRESENTED

Whether the “ensnarement” defense violates the Seventh Amendment.

CORPORATE DISCLOSURE STATEMENT

Respondent Boston Scientific Corporation is a publicly held company. No parent corporation or publicly held company owns 10 percent or more of Boston Scientific Corporation. Boston Scientific Scimed, Inc. is a wholly-owned subsidiary of Boston Scientific Corporation.

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BRIEF IN OPPOSITION

INTRODUCTION

This Court's review is for cases raising recurring issues of national importance. This is not such a case. The question presented is waived because it was never raised at trial or on appeal. Indeed, throughout this litigation, Petitioner explicitly conceded that the ensnarement defense does not violate the Seventh Amendment. Only now, after his procedural challenges to the district court's judgment have failed, does Petitioner mount an eleventh-hour challenge to the propriety of the doctrine of ensnarement. This Court is not a court of first review and should not decide an issue neither pressed nor passed upon below.

The petition is, moreover, a belated attempt to foment controversy where there is none. The Court

of Appeals for the Federal Circuit has applied the doctrine of ensnarement sparingly but consistently for decades, and—as a consequence—ensnarement is not an issue warranting this Court’s review. The ensnarement defense follows from this Court’s decisions addressing patent infringement under the doctrine of equivalents, which have emphasized that the doctrine of equivalents analysis is always circumscribed by the prior art.

Finally, the decision below does not contravene the Seventh Amendment. Petitioner’s infringement claim failed as a matter of law. Accordingly, the judge set aside the verdict. That sequence of events happens in literally thousands of federal cases each year. The Seventh Amendment has long permitted it.

Certiorari should be denied.

STATEMENT

I. The Ensnarement Defense

In patent law, there are two ways in which a patent claim may be infringed. A claim may be “literal[ly]” infringed, or it may be infringed under the “doctrine of equivalents.” *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 607-09 (1950). To determine literal infringement, the allegedly infringing device is compared against the elements of the patent claim. If the device includes every requirement of the claim, the device “literal[ly]” infringes the claim. *See id.* at 607.

If a device does not literally infringe the asserted claim, it may still infringe under the “doctrine of equivalents.” *Id.* at 607-08. A component of the accused device that does not literally meet the corresponding requirement of the claim may infringe under the doctrine of equivalents if it performs sub-

stantially the same function in substantially the same way to obtain the same result. *Id.* at 608.

But there is an important limitation on the doctrine of equivalents. Just as the prior art limits what an inventor could have obtained in a patent claim in the first place, it also limits the range of permissible equivalents. *See Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 683 (Fed. Cir. 1990). Thus, if the aspect of the device alleged to infringe under the doctrine of equivalents would not have been patentable at the time the patent was sought because it would also cover the prior art, it cannot form the basis for a judgment of infringement under the doctrine of equivalents. *Id.* at 683-84.

A patent may not, through the doctrine of equivalents, unduly invade or “ensnare” the prior art. *Id.* at 685.

II. Factual and Procedural History

Petitioner G. David Jang (“Petitioner”) is the named inventor on U.S. Patent No. 5,922,021 (“the ‘021 patent”), which describes a particular configuration, or geometry, for a coronary stent. App. 3a. Years after he assigned the ‘021 patent (along with his other stent patents) to Boston Scientific Corporation and Scimed Life Systems (“Boston Scientific”), Petitioner sued for breach of contract, claiming that Boston Scientific owed him payments under the agreement for sales of Boston Scientific’s Express stent (which was launched prior to the agreement). App. 7a-8a. Petitioner’s breach of contract claim turned on whether the Express stent would have infringed the ‘021 patent if Boston Scientific had not purchased it.

Before trial, Boston Scientific moved in limine to preclude Petitioner from presenting a doctrine of

equivalents theory to the jury. App. 8a. Boston Scientific argued that Petitioner had not sufficiently disclosed the basis for such a theory in his expert reports, but, if he had, any theory of equivalents that he could advance would ensnare the prior art. App. 8a. The trial judge reserved the question, holding that, if the jury found infringement under the doctrine of equivalents, the court would hold a post-trial “ensnarement” hearing. App. 8a.

The jury agreed with Boston Scientific that the Express stent did not literally infringe the ‘021 patent but found infringement under the doctrine of equivalents. App. 9a. In advance of the post-trial hearing on ensnarement, the Petitioner elected to submit a hypothetical claim—*i.e.*, a claim whose scope was expanded to cover the Express stent while taking into account the finding of no literal infringement. App. 9a. In response, Petitioner submitted ten different hypothetical claims, although he ultimately narrowed the list to two for purposes of the hearing. App. 9a. Concluding that neither hypothetical claim was proper because neither had been broadened in scope, the trial court vacated the jury verdict of infringement and entered judgment of non-infringement in favor of Boston Scientific. App. 9a.

Although Petitioner appealed the judgment, he did not press the question presented in either his appeal or his petition for rehearing. Narrowly invoking the Seventh Amendment only three times in his approximately 60-page opening brief on appeal, Brief for Appellant at 3, 27, 48, *Jang v. Boston Sci. Corp.*, 872 F.3d 1275 (Fed. Cir. 2017) (Nos. 16-1275 & 16-1575), 2016 WL 3082194, Petitioner pressed an entirely different argument than the question presented.

In his brief on appeal, Petitioner argued that Boston Scientific had “misuse[d]” the ensnarement defense at trial as a means of attacking the underlying validity of the claims in his patent. *Id.* at 3-4, 26-27, 48. Petitioner argued that the Seventh Amendment permitted only the jury to adjudicate the validity of his patent. *Id.* Petitioner made no attack on the constitutional validity of ensnarement when used as a defense to patent infringement. *See id.* In fact, Petitioner explicitly agreed with Boston Scientific that “*ensnarement does not implicate the Seventh Amendment.*” *Id.* at 48 (emphasis added). As a consequence, the Federal Circuit’s opinion did not even address the issue of whether the doctrine of ensnarement violates the Seventh Amendment. App. 1a-27a.

Nor did Petitioner argue in his petition for rehearing that the ensnarement defense violates the Seventh Amendment. In Petitioner’s approximately 20-page petition for rehearing en banc, he mentioned the Seventh Amendment only once in passing. Petition for Rehearing En Banc at 14, *Jang v. Boston Sci. Corp.*, 872 F.3d 1275 (Fed. Cir. 2017) (Nos. 16-1275 & 16-1575). He did so to support an argument not only different from the question presented here, but also different from the argument he advanced in his opening appellate brief. Petitioner argued that, because Boston Scientific raised its ensnarement defense in a motion in limine rather than in a pre-verdict motion for judgment as a matter of law (“JMOL”), the district court violated the Seventh Amendment by entering a post-verdict JMOL. *See id.* at 13-15. The Federal Circuit denied rehearing en banc without opinion. App. 39a-40a.

REASONS FOR DENYING THE PETITION

I. The Question Presented Is Waived

Petitioner attempts to attack the judgment below through injection of new grounds not pressed or passed on below. But this Court’s “traditional rule” is to deny certiorari “when the question presented was not pressed or passed upon below.” *United States v. Williams*, 504 U.S. 36, 41 (1992) (internal quotation marks omitted); see *Illinois v. Gates*, 462 U.S. 213, 218-20 (1983); see also *Hall Street Assocs. L.L.C. v. Mattel, Inc.*, 552 U.S. 576, 591 (2008) (refusing to consider an issue even where a petitioner had “suggested something along these lines in the Court of Appeals”).

Petitioner never challenged the constitutionality of the ensnarement defense below. For that reason, the Federal Circuit did not pass upon the question. Petitioner now seeks to litigate a novel constitutional claim for the first time in this Court without the benefit of any consideration by any lower court. See *supra* pp.4-5.

This Court is “a court of review, not of first view.” *Cutter v. Wilkinson*, 544 U.S. 709, 718 n.7 (2005). Absent “exceptional” circumstances, *Duignan v. United States*, 274 U.S. 195, 200 (1927), this Court will not consider a question “without the benefit of thorough lower court opinions to guide [its] analysis of the merits,” *Zivotofsky v. Clinton*, 566 U.S. 189, 201 (2012). Because the Seventh Amendment argument was not “pressed or passed upon below,” this Court should not consider it. *Williams*, 504 U.S. at 41 ; see also, e.g., *Sprietsma v. Mercury Marine*, 537 U.S. 51, 56 n.4 (2002); *Pennell v. City of San Jose*, 485 U.S. 1, 11 n.5 (1988). “[T]riple so when,” as here, “the new

issue is a constitutional matter.” *Turner v. Rogers*, 564 U.S. 431, 457 (2011).

II. The Ensnarement Defense Is a Longstanding and Uncontroversial Doctrine in Patent Law

The ensnarement defense is not novel, nor is it a creation of the Federal Circuit. Petitioner claims this Court has “never” recognized the ensnarement defense to infringement and the defense “was unknown at common law.” Pet. i, 3. Both claims are false. This Court has long held that the scope of the doctrine of equivalents is limited by prior art. *See, e.g., Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 39-40 (1929) (noting that “[a] patent [that] came into a prior art crowded with various latch devices for holding a door in closed position when it was shut ... was not a pioneer patent entitled to a broad range of equivalents”); *Duff v. Sterling Pump Co.*, 107 U.S. 636, 639 (1883) (“The case is one where, in view of the state of the art, the invention must be restricted to the form shown and described by the patentee.”).

Indeed, only four years after the Supreme Court fashioned the doctrine of equivalents in *Winans v. Denmead*, 56 U.S. 330, 343 (1853); Pet. 12, it held in *McCormick v. Talcott*, 61 U.S. 402, 405-07 (1857), that prior art limits the range of permissible equivalents of a claim. It has held to that view ever since. *See, e.g., Chicago & N.W. Ry. Co. v. Sayles*, 97 U.S. 554, 562-63 (1878); *Zane v. Soffe*, 110 U.S. 200, 202-04 (1884); *Blake v. City & Cty. of San Francisco*, 113 U.S. 679, 681 (1885). As this Court has said, “equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case.” *Graver Tank*, 339 U.S. at 609 (emphasis added); *accord Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 30-31 (1997). “En-

ensnarement” is merely how the lower courts refer to this Court’s established doctrine that the scope of equivalents available to a patentee is circumscribed by the prior art.¹

The method by which the Federal Circuit resolves the ensnarement defense is also eminently sensible. Petitioner criticizes the Federal Circuit’s method, accusing the Federal Circuit of unfairly “shifting the burden” of proof to the plaintiff to prove the absence of ensnarement and “smuggl[ing] invalidity concepts” into the doctrine by requiring that the hypothetical equivalent claim be patentable. *See, e.g.*, Pet. 11, 15, 17-18, 23-24. Putting aside that Petitioner’s criticisms have nothing to do with whether ensnarement violates the Seventh Amendment, they are unwarranted.

One need only read *Wilson Sporting Goods* to understand the logic of the Federal Circuit’s method of resolving ensnarement. 904 F.2d at 683-85. In sum, because the plaintiff bears the burden of proving patent infringement, the burden of showing that there could exist a patentable equivalent to a claim also falls on the plaintiff. *Id.* There is no “burden shifting.” The burden remains on the plaintiff. Nor is there any “smuggl[ing]” of “invalidity concepts” into infringement. There is simply the requirement

¹ Petitioner tacitly concedes that the ensnarement defense is longstanding, acknowledging that the case that gave rise to the term “ensnarement”—*Wilson Sporting Goods*, 904 F.2d 677— “[b]uil[t] on prior decisions that recognized that prior art can limit the scope of equivalents.” Pet. 15. Indeed, one can trace the citations supporting the ensnarement defense in *Wilson* directly to *McCormick*, by looking to the cases cited in *Wilson*, the cases those cases cite, and so forth, all the way back to *McCormick*.

that the patentee show that the hypothetical “equivalent[]” claim he seeks to use could have been patented in the first place. *Wilson Sporting Goods*, 904 F.2d at 684.

Petitioner’s observation that the ensnarement defense is not contained in the Patent Act is no basis for finding a violation of the Seventh Amendment. Pet. 22-24. A host of other defenses to patent infringement and limitations on its application similarly do not appear in the Patent Act. Indeed, the doctrine of equivalents itself was not expressly adopted in the Patent Act, and yet this Court recognized its continued vitality in *Warner-Jenkinson*, 520 U.S. at 30-31. Moreover, as the principal technical drafter of the Patent Act stated (in a commentary upon which this Court has previously relied, *see, e.g., Warner-Jenkinson*, 520 U.S. at 28; *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 342 n.8 (1961)), the Patent Act was meant to codify traditional “equitable defenses” to infringement “such as laches, estoppel and unclean hands.” P.J. Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. 1, 55 (West 1954). Ensnarement is one such defense.

The ensnarement defense is thus not a subject of judicial or scholarly controversy. It is not, for example, controversial among judges. Research discloses no opinion by any judge calling into question ensnarement’s consistency with the Seventh Amendment. Nor is it controversial among scholars. In an era when professors are publishing more than 10,000 law review articles a year, only 105 in history have ever even mentioned ensnarement and the doctrine of equivalents, and only 15 articles do more than

mention that the doctrine exists.² Scholars have said almost nothing about ensnarement, let alone any supposed tension between ensnarement and the Seventh Amendment.

And ensnarement rarely arises. Since 1988, the Federal Circuit has mentioned ensnarement and the doctrine of equivalents in only 23 decisions.³ That means ensnarement has been an issue in at most 1 in every 2000 Federal Circuit appeals.⁴ Since 1993 district courts nationwide have mentioned ensnarement and the doctrine of equivalents in 112 orders.⁵ Even taking the most generous view, that means ensnarement arises in fewer than 1 in every 50,000 federal civil cases.⁶

² To arrive at 105, the following WestlawNext search was run on the law reviews and journals database: adv: “ensnar!” & “doctrine of equivalents”. To arrive at 15, the following WestlawNext search was run on the law reviews and journals database: adv: ATLEAST3(“ensnare!”) & “doctrine of equivalents”.

³ To arrive at 23, the following WestlawNext search was run on the Federal Circuit database: adv: “ensnar!” & “doctrine of equivalents”.

⁴ The Federal Circuit hears roughly 1500 appeals annually. Court of Appeals for the Federal Circuit, *Historical Caseload*, http://www.ca9c.uscourts.gov/sites/default/files/the-court/statistics/Historical_Caseload_Graph_83-17.pdf.

⁵ To arrive at 112, the following WestlawNext search was run on the federal district courts database: adv: “ensnar!” & “doctrine of equivalents”.

⁶ Federal district courts hear roughly 250,000 civil cases annually. See Federal Judicial Center, *Judicial Caseload Indicators – Federal Judicial Caseload Statistics 2017*, <http://www.uscourts.gov/judicial-caseload-indicators-federal-judicial-caseload-statistics-2017>.

As Petitioner acknowledges, even the Federal Circuit only mentioned the doctrine of equivalents—of which the ensnarement is a subset—in 5.6% of its patent infringement cases in 2017. Pet. 32. Petitioner hints that the ensnarement defense has somehow caused a decline in doctrine of equivalents cases. *Id.* But given how infrequently ensnarement arises in patent infringement cases that contention is highly implausible.

III. The Ensnarement Defense Raises No Seventh Amendment Concerns

Finally, the petition is meritless. Petitioner makes two arguments as to why the ensnarement defense violates the Seventh Amendment. Neither withstands scrutiny.

1. Petitioner argues that the ensnarement defense withdraws a fact question from the jury. Pet. 12-18. It does not. The “ensnarement defense” is just one of a number of legal limitations on the doctrine of equivalents. As the Federal Circuit has explained, “[t]he doctrine of equivalents exists to prevent a fraud on a patent ... *not* to give a patentee something which he could not lawfully have obtained from the PTO had he tried.” *Wilson Sporting Goods*, 904 F.2d at 684. Hence, “[i]f 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.” Pet. 13; *see also* App. 17a n.5. In conducting an ensnarement analysis, the court’s role is merely to decide whether the patentee could have drafted a literal claim of the same breadth as required for the jury’s finding of infringement under the doctrine of equivalents without covering the prior art. *See DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1323 (Fed. Cir. 2009).

In this regard, the ensnarement defense closely resembles the doctrine of prosecution history estoppel, which this Court has long recognized as “a legal limitation on the doctrine of equivalents,” and has never held to raise Seventh Amendment concerns. *Warner-Jenkinson*, 520 U.S. at 30-31. The doctrine holds that a patentee may not obtain a judgment of patent infringement under the doctrine of equivalents by broadening a claim that the patentee narrowed during prosecution to obtain the patent in the first place (e.g., to avoid prior art). *See id.* Like ensnarement, prosecution history estoppel allows a judge to set aside a jury’s verdict of infringement under the doctrine of equivalents. *DePuy Spine*, 567 F.3d at 1323-24.

Petitioner accepts the legitimacy of prosecution history estoppel but rejects the legitimacy of ensnarement. Pet. 30-31. But the two are conceptually indistinguishable. Both implement the same underlying idea: that a patentee may not obtain a judgment of infringement on an “equivalent” patent when that patent would never have been granted. And both are resolved as questions of law by the judge because they are legal limitations on the scope of the doctrine of equivalents.

2. Petitioner also takes issue with the post-trial hearing the trial court used to resolve the ensnarement defense in this case. Pet. 21-22. Petitioner argues that, because Boston Scientific raised its ensnarement defense in a motion in limine, rather than a pre-verdict JMOL, the trial court’s post-verdict resolution of Boston Scientific’s ensnarement defense violated the Seventh Amendment’s Reexamination Clause. Pet. 21-22. 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 reexamined in any Court of the United States, than according to the rules of the common law.” U.S. Const. amend. VII.

But post-trial hearings to resolve dispositive questions of law do not violate the Seventh Amendment. In holding a post-trial hearing, the court merely did what courts do on renewed motions for JMOL every day. This Court has long held that such motions comport with the Seventh Amendment. *Neely v. Martin K. Eby Const. Co., Inc.*, 386 U.S. 317, 321 (1967). Moreover, whether a court may determine a question of law following a jury verdict has never turned on the form by which the issue was raised during trial. “At common law there was a well-established practice of reserving questions of law arising during trials by jury and of taking verdicts subject to the ultimate ruling on the questions reserved.” *Baltimore & Carolina Line v. Redman*, 295 U.S. 654, 659 (1935); *see Colgrove v. Battin*, 413 U.S. 149, 156 (1973) (noting that the Seventh Amendment preserves substance of the jury trial right not “mere matters of form or procedure”).

In this case, both the district court and the court of appeals held that, by raising the ensnarement issue in advance of the jury verdict, Boston Scientific preserved its right to a post-verdict ensnarement hearing. App. 22a. The Seventh Amendment does not demand more. *See Baltimore & Carolina*, 295 U.S. at 659-60; *see also, e.g., Chinoweth v. Haskell’s Lessee*, 28 U.S. 92, 94-95, 98 (1830) (Marshall, C.J.) (setting aside verdict for plaintiffs based on defendants’ demurrer to plaintiffs’ testimony).

And as practical matter, Petitioner’s argument makes no sense. When the case went to the jury, there had been no evidence submitted on the issue of

ensnarement, precisely because the judge had decided to reserve the issue for a separate evidentiary hearing. Petitioner's suggestion that Boston Scientific was required to move for JMOL on an issue as to which no evidence had yet been presented is bizarre.

The district court did exactly what other district courts have done in the context of inequitable conduct, another legal defense to patent infringement claims: it conducted a separate evidentiary hearing, or bench trial, after the jury's verdict to resolve the issue, which is one of law for the Court, not one of fact for the jury. *See, e.g., Cordis Corp. v. Boston Sci. Corp.*, 658 F.3d 1347, 1353 (Fed. Cir. 2011); *Orion IP, LLC v. Hyundai Motor Am.*, 605 F.3d 967, 978 (Fed. Cir. 2010); *Trading Techs. Int'l, Inc. v. eSpeed, Inc.*, 595 F.3d 1340, 1349 (Fed. Cir. 2010); *see also Powell v. Home Depot U.S.A., Inc.*, 663 F.3d 1221, 1227 (Fed. Cir. 2011) (affirming district court's findings on inequitable conduct, even where JMOL that preceded inequitable conduct bench trial did not address the issue).

Petitioner's Seventh Amendment claims are therefore without merit.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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