No. 17-

IN THE

Supreme Court of the United States

PROMEGA CORPORATION,

Petitioner,

v.

LIFE TECHNOLOGIES CORPORATION, INVITROGEN IP HOLDINGS, INC., and APPLIED BIOSYSTEMS, LLC,

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

Federal Rule of Civil Procedure 50(d) provides that "a party against whom judgment as a matter of law is rendered" may move for a new trial within "28 days *after* the entry of the judgment." Fed. R. Civ. P. 50(d) (emphasis added). The advisory committee notes make clear that, under this subdivision (formerly, Rule 50(c)(2)), "the verdict-winner is entitled, *even after entry of judgment n.o.v. against him*, to move for a new trial in the usual course." Rule 50 Advisory Committee's Note (1963) (emphasis added). This Court has likewise recognized that "[w]here a defendant moves for *n.o.v.* in the trial court, the plaintiff may present, in connection with that motion or with a separate motion *after n.o.v. is granted*, his grounds for a new trial." *Neely* v. *Martin K. Eby Constr. Co.*, 386 U.S. 317, 325 (1967) (second emphasis added).

The question presented is:

Whether the Federal Circuit erred in holding that, notwithstanding Federal Rule of Civil Procedure 50(d), a verdict winner must raise new-trial arguments in its opposition to a motion for judgment as a matter of law in order to raise those arguments in a timely motion for a new trial after entry of judgment.

PARTIES TO THE PROCEEDING

Petitioner Promega Corporation was the plaintiff-cross-appellant below.

Respondents Life Technologies Corporation, Invitrogen IP Holdings, Inc., and Applied Biosystems (collectively "LifeTech") were the defendants-appellants below.

Max-Planck-Gesellschaft zur Forderung der Wissenschaften E.V. was the owner of U.S. Patent No. RE37,984 and was an involuntary plaintiff below.

CORPORATE DISCLOSURE STATEMENT

Petitioner Promega Corporation has no parent corporation, and no publicly held company owns 10% or more of its stock.

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PETITION FOR A WRIT OF CERTIORARI

Promega Corporation 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 Federal Circuit's opinion affirming the judgment of the district court (App. 1a-28a) is reported at 875 F.3d 651. The Federal Circuit's opinion denying panel rehearing and rehearing en banc (App. 65a-66a) is unreported. The district court's opinion granting Life Technologies judgment as a matter of law (App. 29a-50a) is unreported but is available at 2012 WL 12862829. The district court's opinion denying

Promega's motion for amendment of judgment or for a new trial (App. 51a-63a) is unreported but is available at 2013 WL 12234115. The district court's amended judgment (App. 67a-68a) is unreported.

JURISDICTION

The Federal Circuit entered judgment on November 13, 2017, and denied a timely rehearing petition on February 14, 2018. App. 1a-28a, 65a-66a. On April 18, 2018, Justice Kennedy extended the time to file a petition for a writ of certiorari to June 14, 2018. No. 17A1171. This Court has jurisdiction under 28 U.S.C. § 1254(1).

FEDERAL RULE INVOLVED

Federal Rule of Civil Procedure 50(d) provides: "**Time for a Losing Party's New-Trial Motion.** Any motion for a new trial under Rule 59 by a party against whom judgment as a matter of law is rendered must be filed no later than 28 days after the entry of the judgment."

INTRODUCTION

There is no dispute that the patent Promega asserted in this suit is valid, that LifeTech was aware of the patent, that LifeTech knew each of its DNA test kits practiced the patent, and that LifeTech made infringing sales in the United States. The Federal Circuit nevertheless held that Promega waived its right to a new trial on damages for LifeTech's admitted infringement because Promega's brief opposing LifeTech's motion for judgment as a matter of law (JMOL) defended the jury's verdict without presenting an alternative request for a new trial on damages in the event the district court found inadequate support for

the $52 million in damages awarded by the jury. That ruling contradicts Federal Rule of Civil Procedure 50(d) and this Court's precedent, which permit a verdict winner like Promega to assert grounds for a new trial *after* JMOL is granted.

The policy behind Rule 50(d) is clear: It is wasteful and awkward for the party who won at trial and is defending its verdict to raise alternative new-trial arguments when it is unclear whether or why JMOL might be granted. Rule 50(d) instead lets the verdict winner wait until the jury's verdict is disturbed before requesting a new trial. The Federal Circuit's affirmance of a waiver finding for doing precisely what Rule 50(d) permits guts that principle.

Rule 50 contemplates a two-staged approach in which a party challenging the sufficiency of support for the jury's verdict must move for JMOL before the case goes to the jury and renew that motion—while making any alternative request for a new trial—within 28 days after the entry of judgment against it. If JMOL is granted and the verdict is set aside, Rule 50(d) then affords the party who won at trial—Promega in this case—a new 28-day period after the entry of JMOL to make its own motion for a new trial. That two-staged approach enables the parties to focus their respective JMOL briefs on attacking and defending the jury's verdict while permitting the verdict winner to reserve potential grounds for a new trial until support for the verdict is found to be legally insufficient in some specific way.

In lieu of Rule 50's rational and orderly approach to resolving JMOL and new-trial motions, the Federal Circuit's decision creates a waiver rule that forces the party that won at trial to raise new-trial arguments

that may never matter even while that party is still in the process of defending the jury's verdict. That decision leaves verdict winners no choice but to brief in opposition to JMOL every conceivable theory that could support a new trial in case a given theory supporting the jury's verdict fails. And because the decision involves a fundamental procedural question, it will have far-reaching consequences beyond the windfall judgment of zero damages for a self-confessed infringer in this case. The Federal Circuit's decision accordingly merits this Court's review.

STATEMENT

A. Promega's Patent Infringement Claims And Pre-Trial Proceedings

Promega is a global leader in developing and producing technologies for use by scientists in academic, medical, law enforcement, and industrial settings. Among its many products are DNA test kits that amplify short tandem repeat ("STR") loci in DNA samples.

In 2006, Promega licensed LifeTech to practice certain patents covering STR kits that are held or exclusively licensed by Promega. *Promega Corp.* v. *Life Techs. Corp.*, 773 F.3d 1338, 1344 (Fed. Cir. 2014), *rev'd*, 137 S. Ct. 734 (2017). The license permitted LifeTech to sell STR kits incorporating the patented technology only for use in forensic or paternity testing. C.A.J.A. 815-816; *Promega*, 773 F.3d at 1344. Despite these limitations, LifeTech embarked on a concerted campaign to expand its sales beyond the licensed fields. *Life Techs. Corp.* v. *Promega Corp.*, 137 S. Ct. 734, 738 (2017).

In 2010, Promega sued LifeTech in the Western District of Wisconsin for infringing five patents.

Promega, 773 F.3d at 1344. The only patent still at issue, the "Tautz patent" (U.S. Reissue Patent No. RE37,984), claimed kits for analyzing STR loci in DNA. *Id.* at 1343-1344; C.A.J.A. 408. Tautz was the first patent application to describe STR loci and is considered a foundational patent in STR technology. C.A.J.A. 1928-1929, 2004. LifeTech has never challenged the validity of the Tautz patent or denied that claim 42 of the Tautz patent reads on all of LifeTech's accused kits. The Tautz patent has now expired, but Promega is still entitled to damages for LifeTech's infringing use during the patent's term. *Life Techs.*, 137 S. Ct. at 738 n.1.

In September 2011, the parties cross-moved for summary judgment. *Promega*, 773 F.3d at 1344. Promega sought summary judgment of infringement of the Tautz patent based on evidence that LifeTech "made, used, sold, or offered for sale" STR test kits using the patented technology for purposes not permitted under its license. C.A.J.A. 688-689. Among other support, Promega provided a detailed comparison of the accused products to the asserted patent claims, C.A.J.A. 879-888, and extensive evidence showing that LifeTech sold each accused product to U.S. institutions for unlicensed purposes, C.A.J.A. 694-702, 1288-1300, 1307-1309. LifeTech opposed summary judgment solely on the ground that its sales were licensed. LifeTech never disputed that it sold the accused products in the United States. C.A.J.A. 9192-9197, 1443-1463, 1541-1544.

The district court granted Promega's "motion for summary judgment with respect to direct infringement" on several of Promega's claims. C.A.J.A. 3. The court found that LifeTech's unlicensed sales of certain STR test kits directly infringed claim 42 of the Tautz patent and many of the asserted claims in the other

four asserted patents. *Promega*, 773 F.3d at 1344. The court also upheld Promega's interpretation of the license, concluding that LifeTech's kits were licensed only for forensic and paternity uses, not for clinical or research applications. *Id.*

The parties later entered into a stipulation extending the district court's infringement ruling to additional kits. C.A.J.A. 44-45, 1667-1668, 9237-9239. By the time trial began, therefore, the court had already established that all kits at issue infringed the Tautz patent.

B. Jury Trial

The parties proceeded to a jury trial to determine damages and LifeTech's willfulness in infringing the asserted patents. *Promega*, 773 F.3d at 1344. Given the district court's grant of summary judgment of direct infringement, the question *whether* LifeTech had infringed was not tried; infringement was discussed only to the extent necessary to calculate the *amount* of damages and to determine whether LifeTech's infringement had been *willful*. LifeTech conceded in its opening statement that there "was technically an infringement" and "[t]he law says [Promega is] entitled to be compensated for that infringement." C.A.J.A. 5127:14-19.

On the first day of trial, the parties stipulated that LifeTech had made $707,618,247 in "total worldwide sales of STR kits" during the damages period. C.A.J.A. 9240. Promega cited this stipulation at trial because it believed that *all* unlicensed sales infringed under either § 271(a) or § 271(f)(1). Specifically, Promega argued that many of the STR kits were sold within the United States in violation of § 271(a) and that all of the kits contained at least one component (*Taq* polymerase)

supplied from the United States in violation of § 271(f)(1). App. 7a.

Promega also introduced evidence of damages for different subsets of LifeTech's sales in the event the jury disagreed.[1] This included extensive evidence of infringing sales within the United States. For example, Promega introduced several spreadsheets from LifeTech's own records quantifying thousands of sales to U.S. customers. LifeTech's record of its STR kit sales from 2005 to 2007 contained a worksheet showing over 3000 rows of U.S. sales between the fourth quarter of 2006 and the fourth quarter of 2007. C.A.J.A. 7051-7170; *see* C.A.J.A. 6249-6258. Another worksheet broke down LifeTech's sales by country for those years, clearly showing total U.S. sales. C.A.J.A. 7033-7050; *see* C.A.J.A. 6259-6263. LifeTech's record of its STR kit sales from 2009 to 2011 likewise showed thousands of U.S. sales of the accused kits. C.A.J.A. 7362-7473, 7632-7744, 7906-8002. And Promega elicited testimony from

[1] Citing the "stipulation as to the total amount of sales of STR kits," LifeTech initially objected to Promega's attempt to introduce "underlying sales data" as "not relevant to any issue before the jury." C.A.J.A. 5572. This statement, along with others, created the impression that the only damages issue left to resolve was the percentage of sales that were licensed. C.A.J.A. 5065-5073, 6127-6130, 6184-6191. Accordingly, Promega initially objected when LifeTech reversed course and asked a witness to quantify the amount of U.S. sales. C.A.J.A. 6126-6127. The district court likewise expressed surprise that there was an "open question about what percentage was attributable to the United States" because "when there was an effort to get into that, the agreement was that we didn't need to." C.A.J.A. 6187. The court added: "I think there's miscommunication between counsel, and that included me." C.A.J.A. 6190. It then allowed Promega to reopen its case and present detailed evidence of LifeTech's sales in the United States, including spreadsheets documenting LifeTech's sales. *E.g.*, C.A.J.A. 6249-6270.

a LifeTech employee explaining how to read LifeTech's records "to tell the location of the sale as well as the amount of the sale." C.A.J.A. 6261; *see also* C.A.J.A. 6249-6267.

In addition, the trial record contained sales reports and testimony from some of LifeTech's U.S. sales representatives. For example, sales representative Robert Rossi quantified specific sales to U.S. entities using the kits for unlicensed purposes. C.A.J.A. 6620-6621, 6624-6625. Philip Czar, LifeTech's sales representative for Texas, Oklahoma, New Mexico, Arkansas, Kansas, and Arizona, testified that LifeTech sold $30 million of STR kits in his region during the infringement period, including many for unlicensed uses. C.A.J.A. 5978:24-25, 5986:20-23, 5987:8-13, 5989:6-18. Other sales representatives and sales reports confirmed additional U.S. sales of STR kits for unlicensed uses. *See* Promega C.A. Reply Br. 6-10, Dkt. 49.

Promega similarly presented evidence quantifying LifeTech's sales of the three "Identifiler" kits for which LifeTech supplied multiple components from the United States. App. 36a-37a; C.A.J.A. 2303 (for the "Identifiler, Identifiler Direct and Identifiler Plus" kits, "two components … (primers and PCR enzyme) were supplied from the U.S."); C.A.J.A. 6284:24-6285:8. Thus, even if LifeTech was not liable under § 271(f)(1) for worldwide sales of the kits for which LifeTech supplied only one component from the United States, 35 U.S.C. § 271(f)(1), Promega presented evidence that would have allowed an alternative calculation of § 271(f)(1) damages for the Identifiler kits, which accounted for almost half of LifeTech's total sales. C.A.J.A. 6259-6263, 7033-7050, 7180-7186, 7188-7192, 7196-7204.

At the end of a two-week trial, the district court instructed the jury to determine the combined amount of LifeTech's sales that infringed under 35 U.S.C. § 271(a) or (f)(1). The jury returned a verdict of willful infringement and found that *all* of LifeTech's worldwide sales infringed under § 271(a) or § 271(f)(1). App. 8a; C.A.J.A. 6512:1-6514:22. The jury then determined that 10 percent of those sales were for unlicensed uses and that Promega was entitled to $52 million in lost profits. App. 8a; C.A.J.A. 202-203. The district court entered judgment accordingly. C.A.J.A. 9242-9243.

C. Post-Trial Proceedings In The District Court

LifeTech's principal motion for JMOL focused on damages. LifeTech argued, among other things, that no damages were proper under § 271(f)(1) because, for some of its kits, it had supplied only a single component from the United States. App. 36a-37a. With respect to U.S. sales, LifeTech conceded that there had been infringement under § 271(a) and that "some portion of the stipulated sales figure represents sales of STR kits in the United States." C.A.J.A. 2313. LifeTech also admitted that "[a] number of witnesses testified about sales to particular U.S. customers and within certain U.S. regions," and cited testimony quantifying some of those U.S. sales. *Id.* But LifeTech argued that "absent presentation to the jury of the *total* amount of U.S. sales, Promega failed to meet its burden of establishing the quantum of unlicensed sales subject to § 271(a) liability." *Id.* (emphasis added).

Promega's opposition to LifeTech's JMOL motion focused on defending the verdict rendered by the jury. It did not argue, in the alternative, that Promega was entitled to a new damages trial in the event the court set aside the jury's combined verdict on damages.

In September 2012, the district court granted LifeTech's motion for JMOL on damages. App. 50a. The court held that there was insufficient evidence to find that all of LifeTech's worldwide sales had the requisite connection to the United States under § 271(a) or § 271(f)(1). On § 271(f)(1), the court held, as relevant here, that supplying a single component from the United States can never give rise to liability. App. 38a-43a. On § 271(a), the district court did not dispute that *some* of LifeTech's infringing products were sold in the United States, but it found that Promega's evidence did not establish that *all* of the accused kits were sold in or imported into the United States. App. 48a-49a. The court then stated without explanation, and without considering the extensive evidence of record, that Promega had not "adduce[d] evidence regarding defendants' sales of any subset of products" that infringed. App. 49a. And because the trial evidence could not support the *entire* damages verdict under the court's interpretation of § 271(f)(1), the court concluded that Promega was entitled to *no* damages *at all*. The court also held that Promega had waived its right to a new trial—at which the jury could have been instructed in line with the court's new legal ruling—by failing to request a new trial in its JMOL opposition. App. 49a.

The court issued an amended judgment reflecting its JMOL ruling. App. 67a-68a. Pursuant to Rules 59 and 50(d), Promega timely moved for reconsideration or, in the alternative, a remittitur or new trial. Promega argued, as relevant here, that the evidence at trial of infringing U.S. sales—many of which were quantified—was more than sufficient to permit a jury to award Promega damages under § 271(a), even if Promega were not entitled to a verdict based on worldwide sales. Promega also pointed out that, be-

cause it had prevailed at trial, Federal Rule of Civil Procedure 50(d) and other authority permitted it to raise new-trial arguments after JMOL was entered against it. C.A.J.A. 9313-9314, 9336-9343.

Without hearing argument, the district court denied Promega's motions. App. 51a-63a. As relevant here, the court adhered to its view that Promega had waived its right to a remittitur or new trial on damages by not requesting them in its JMOL opposition. App. 58a-59a. The court did not address Federal Rule of Civil Procedure 50(d) or the extensive record evidence of damages.

D. Federal Circuit And Supreme Court Proceedings Regarding The Scope Of § 271(f)(1)

In its first ruling in this case, the Federal Circuit rejected the district court's interpretation of § 271(f)(1) and held that a company can infringe under § 271(f)(1) even if it only supplies from the United States a single component of a patented invention for combination outside the United States. *Promega*, 773 F.3d. at 1353-1356. Accordingly, the court of appeals concluded that there was sufficient evidence to support the jury's finding that LifeTech was liable for infringement under § 271(a) and § 271(f)(1) for its worldwide sales of all unlicensed STR kits. *Id.* at 1356. Because it found the jury's verdict supported by substantial evidence, the Federal Circuit did not consider whether Promega had introduced sufficient evidence to sustain a damages verdict based on some subset of sales, such as those made within the United States.[2]

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[2] Although the Federal Circuit rejected the district court's interpretation of § 271(f)(1), a new trial was necessary because it held that four of the asserted patents were invalid for lack of ena-

This Court granted review of the Federal Circuit's interpretation of § 271(f)(1), reversed, and remanded for further proceedings. *Life Techs. Corp.* v. *Promega Corp.*, 137 S. Ct. 734 (2017). On the narrow question before it, the Court held that "a single component does not constitute a substantial portion of the components that can give rise to liability under § 271(f)(1)." *Id.* at 737.

The Court expressly declined to address "any of the Federal Circuit's conclusions regarding Life[Tech's] liability under § 271(a)." 137 S. Ct. at 739 n.4. Nor did it address whether LifeTech could be liable under § 271(f)(1) for unlicensed sales of the Identifiler kits, for which LifeTech supplied more than one component from the United States.

E. Remand To The Federal Circuit

On remand to the Federal Circuit, LifeTech did not dispute that this Court's decision did not address, let alone disturb, the court of appeals' prior conclusion that LifeTech's unlicensed sales of STR kits within the United States amounted to direct infringement under § 271(a). App. 20a; *see Promega*, 773 F.3d at 1357. Nor did it argue that this Court's decision cast any doubt on LifeTech's liability under § 271(f)(1) as to the accused Identifiler kits. Nevertheless, LifeTech argued that Promega's failure to quantify *all* sales that could give rise to liability under the remaining theories of infringement meant that Promega was not entitled to *any* damages at all. LifeTech C.A. Remand Br. 5-6, Dkt. 108. In other words, because this Court's inter-

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blement. 773 F.3d at 1341. Promega is not seeking this Court's review of the invalidity decision and is now only asserting liability for infringement of the Tautz patent.

pretation of § 271(f)(1) meant that the trial evidence could not support the entire jury verdict, LifeTech argued that it was entitled to judgment of *no* damages at all. LifeTech further argued that Promega had waived its right to a new trial to establish damages on the remaining theories of liability—U.S. sales and worldwide sales of Identifiler kits—by requesting a general verdict form at trial and by not requesting a new trial in its JMOL opposition. *Id.* 9-10.

Promega, for its part, did not dispute that the foreign sale of certain of the accused STR kits did not infringe under this Court's interpretation of § 271(f)(1). App. 16a. But Promega argued that, in light of its timely request for a new trial, the Federal Circuit should remand for a new trial to establish damages for LifeTech's undisputed and extensive infringement under § 271(a) for unlicensed U.S. sales and under § 271(f)(1) for the sale of Identifiler kits. Promega C.A. Remand Br. 9-10, 16-20, Dkt. 112. Promega explained that, where a general damages verdict covers multiple grounds of liability and one of those grounds is later found to be unsupported by the evidence, a plaintiff is entitled to a remittitur or a new trial unless no rational jury could have found *any* damages on the remaining grounds of liability. *Id.* 14-16. And because the jury in this case had been presented with extensive evidence quantifying at least some of LifeTech's infringing sales in the United States and sales of Identifiler kits, a reasonable jury could have awarded some damages. Thus, Promega explained, LifeTech is not entitled to a windfall judgment of no damages for its conceded infringement. Promega also explained that its request for a new trial was timely under Rule 50(d), which permits a verdict winner to bring a new-trial motion for the first time after JMOL is entered against it. *Id.* 11-14.

The Federal Circuit affirmed the district court's grant of JMOL in favor of LifeTech and its denial of Promega's new-trial motion. App. 3a. Like the parties, the Federal Circuit recognized that LifeTech had admitted infringement under § 271(a) for its U.S. sales of STR kits and that Promega may be able to establish infringement under § 271(f)(1) as to the accused Identifiler kits. App. 7a, 20a, 23a. But the Federal Circuit refused to give Promega an opportunity to prove damages for those acts of infringement in a new trial. The Federal Circuit emphasized that "the linchpin of the district court's rulings" was its finding—with which the panel agreed—that Promega waived its right to a new trial by failing to ask for one in its response to LifeTech's JMOL motion. App. 15a-17a. Although the Federal Circuit acknowledged that Rule 50(d) permits a verdict winner to seek a new trial after the entry of JMOL, the panel interpreted this as "merely a 'procedural mechanism'" that does not require "retrial … on a waived theory." App. 24a. Thus, the court held that Rule 50(d) permits a party to wait to raise a non-waived argument for a new trial until *after* JMOL, but that failing to raise an argument for a new trial *at* JMOL waives the argument. The Federal Circuit did not confront this contradiction, but simply held that Promega "should have raised" its arguments for a new trial on a lesser damages award "in response to Life[Tech]'s [JMOL] motion." App. 24a-25a.

The Federal Circuit remarked that its waiver finding was "consistent with" what it perceived to be an "all-or-nothing damages strategy." App. 17a. By this the court meant that, although Promega had introduced "exhibits and lay testimony" including "financial spreadsheets showing sales of the accused products," Promega had presented "no expert testimony on dam-

ages" to add up the evidence quantifying U.S. sales or sales of the Identifiler kits for the jury, instead arguing primarily for a verdict based on total worldwide sales. App. 18a. The panel also faulted Promega—and implicitly the district court—for asking the jury to provide a combined damages award for infringement under § 271(a) and § 271(f)(1). *Id.* The Federal Circuit found that these decisions were consistent with its core conclusion that "Promega abandoned any alternative damages base" when it did not request a new trial in its opposition to LifeTech's motion for JMOL. App. 20a.

Promega timely petitioned for panel rehearing or rehearing en banc. After calling for a response, the Federal Circuit denied Promega's petition. App. 65a-66a.

REASONS FOR GRANTING THE PETITION

I. THE FEDERAL CIRCUIT'S DECISION CONFLICTS WITH RULE 50(d) AND THIS COURT'S PRECEDENT

Rule 50(d)'s plain text gives a verdict winner like Promega the right to bring a subsequent new-trial motion if JMOL is entered against it:

> **Time for a Losing Party's New-Trial Motion.** Any motion for a new trial under Rule 59 *by a party against whom judgment as a matter of law is rendered* must be filed no later than 28 days *after the entry of the judgment.*

Fed. R. Civ. P. 50(d) (emphasis added). The Advisory Committee elaborated:

> [T]he verdict-winner may apply to the trial court for a new trial pursuant to Rule 59 *after* the judgment n.o.v. has been entered against him. In arguing to the trial court in opposition

> to the motion for judgment n.o.v., the verdict-winner may, and often will, contend that he is entitled, at the least, to a new trial.... Subdivision (c)(2) [now (d)] is a reminder that the verdict-winner *is entitled, even after entry of judgment n.o.v. against him*, to move for a new trial in the usual course.

Rule 50 Advisory Committee's Note (1963) (emphasis added). This Court has likewise recognized that "[w]here a defendant moves for *n.o.v.* in the trial court, the plaintiff may present, in connection with that motion *or with a separate motion after n.o.v. is granted*, his grounds for a new trial." *Neely* v. *Martin K. Eby Constr. Co.*, 386 U.S. 317, 325 (1967) (second emphasis added). Rule 50(d) and *Neely* thus entitle a verdict winner like Promega to wait, if it chooses, until *after* the entry of JMOL to argue for a new trial. The Federal Circuit's decision nullifies this right and merits this Court's review for several reasons.

A. The Federal Circuit's Decision Is Contrary To The Plain Text And Purpose Of Rule 50(d)

Rule 50(d) expressly authorizes what Promega did by requesting a new trial with a Rule 59 motion filed within "28 days after the entry of" JMOL. Rule 50 sets forth a staggered timeline for orderly resolution of JMOL and new-trial motions. The party challenging the sufficiency of the evidence—here, LifeTech—is required to move for JMOL "before the case is submitted to the jury," and to renew that motion and make any "alternative or joint request for a new trial under Rule 59" within "28 days after" the entry of judgment against it. Fed. R. Civ. P. 50(a)(2), (b). Rule 50(d) then affords the party who won at trial—Promega in this case—a new 28-day period after the entry of JMOL to

make its own "motion for a new trial under Rule 59." Promega's decision to defend the jury verdict wholeheartedly in opposing LifeTech's JMOL motion, and not to raise its own alternative arguments in support of a new trial at that time, was thus entirely consistent with the timing contemplated by Rule 50(d) for a new-trial request by the verdict winner.

While acknowledging that Rule 50(d) permits a verdict winner to seek a new trial "'even after entry of judgment n.o.v.,'" the Federal Circuit swept the rule aside as "merely a 'procedural mechanism'" that does not require "retrial … on a waived theory." App. 24a. This reasoning was circular, however, because the supposed basis for finding waiver in this case was the *timing* of Promega's request. The district court held that Promega waived its right to a new trial by choosing to defend the full amount of its verdict in opposing JMOL and not making new-trial arguments in the alternative until after JMOL was entered. App. 59a ("If plaintiff believed that the evidence at trial could support a lesser damages award, it could have and should have raised that issue in response to defendants' Rule 50 motion."). The Federal Circuit likewise ruled that Promega "should have raised" its arguments for a new damages trial "in response to Life[Tech]'s Rule 50(b) motion," App. 24a-25a, and it deemed Promega's Seventh Amendment, statutory, and remittitur rights all waived on the basis that Promega failed to raise its arguments for a new trial earlier—in opposition to JMOL, rather than after JMOL was granted as Rule 50(d) permits, App. 26a.

The Federal Circuit's decision thereby forecloses what Rule 50(d) expressly allows. The Federal Circuit, however, did not confront this contradiction between requiring the verdict winner to raise all new-trial ar-

guments in opposition to JMOL—on pain of waiver—and permitting the party "against whom [JMOL] is rendered" to request a new trial after the entry of JMOL. Fed. R. Civ. P. 50(d). If a finding of waiver may be *based*, as here, upon the verdict winner's decision to act in accordance with Rule 50(d) and to wait to assert grounds for a new trial until after JMOL, then Rule 50(d)'s protection of verdict winners is a dead letter.

Finding waiver *because* a verdict winner has defended its judgment and waited to present alternative new-trial arguments until after JMOL also conflicts with the fundamental purpose of Rule 50(d). The reason for allowing a verdict winner to reserve its new-trial request until after JMOL is clear: Most jury verdicts, including "'[m]ost jury damages awards,'" survive JMOL because they are "'supported by substantial evidence.'" *Whitserve, LLC* v. *Computer Packages, Inc.*, 694 F.3d 10, 26 (Fed. Cir. 2012). When that happens, the verdict winner's alternative arguments for a new trial become moot, and time spent on them is wasted.

Moreover, by "expressly" granting the party who won at trial a "right" to assert new-trial arguments *after* the verdict is set aside, Rule 50(d) relieves the party of the "embarrassment in arguing for a new trial … while seeking to defend [its] verdict." Kaplan, *Amendments of the Federal Rules of Civil Procedure, 1961–1963 (II)*, 77 Harv. L. Rev. 801, 819 (1964); *accord Weisgram* v. *Marley Co.*, 528 U.S. 440, 455 n.11 (2000) ("[I]t is awkward for [the verdict winner], who is wholeheartedly urging the correctness of the verdict, to point out, in the alternative, grounds for a new trial." (citing Kaplan)). The verdict loser in moving for JMOL will itself often seek a new trial in the alternative, as LifeTech did here. Fed. R. Civ. P. 50(b). And the dis-

trict court is required to rule on any such new-trial request even in granting JMOL. Fed. R. Civ. P. 50(c). The party opposing JMOL is therefore customarily tasked with defending the verdict against both JMOL and the movant's alternative arguments for a new trial—all in a page-limited opposition brief. While the verdict winner could simultaneously try to raise its own alternative arguments for a new trial, such arguments are "not … urgent" before JMOL is granted, and Rule 50 does not expressly require a conditional ruling on any new-trial request by the verdict winner in the typical event that JMOL is denied; indeed, ruling on such hypothetical requests would impose a "serious" "burden of foresight … on the trial court." Kaplan, 77 Harv. L. Rev. at 820.

Rule 50(d) by design permits a verdict winner to do what Promega did in this case and defer proceedings related to its own entitlement to a new trial until the necessity for such proceedings arises—after the entry of JMOL. The Federal Circuit's finding of waiver based on Promega's adherence to the course of conduct prescribed by Rule 50(d) is contrary to the rule's plain text and wholly undermines the rule's purpose.

B. The Federal Circuit's Decision Contravenes Longstanding Precedent Of This Court

This Court has long recognized that "[w]here a defendant moves for *n.o.v.* in the trial court, the plaintiff may present, in connection with that motion *or with a separate motion after n.o.v. is granted*, his grounds for a new trial." *Neely*, 386 U.S. at 325 (second emphasis added). This Court's "concern has been to protect the rights of the party whose jury verdict has been set aside … and who may have valid grounds for a new trial." *Id.* This Court has accordingly advised that JMOL

is inappropriate "where the record reveals a new trial issue" and should be vacated on appeal if "an alternative theory of liability … not ... passed upon by the jury … might justify the grant of a new trial." *Id.* (citing *Weade* v. *Dichmann, Wright & Pugh, Inc.*, 337 U.S. 801, 808-809 (1949)); *see Weisgram*, 528 U.S. at 457 (affirming *Neely*'s holding and rationale). Indeed, a court "has the power and duty to order a new trial whenever, in its judgment, this action is required in order to prevent injustice." 11 Wright et al., *Federal Practice & Procedure* § 2805 (3d ed. 2018); *see Cone* v. *West Va. Pulp & Paper Co.*, 330 U.S. 212, 215 (1947).

This Court's decisions in *Neely* and its progeny confirm Rule 50's special solicitude for verdict winners. Whereas a verdict loser forfeits its right to JMOL or a new trial if it "'fail[s] strictly to comply'" with the requirements for presenting these arguments, *Unitherm Food Sys., Inc.* v. *Swift-Eckrich, Inc.*, 546 U.S. 394, 402-403 & n.4 (2006), the verdict winner may wait until after JMOL to assert its grounds for a new trial, *Neely*, 386 U.S. at 325. Indeed, it "may bring these very grounds directly to the court of appeals without moving for a new trial in the district court." *Id.* at 328; *see* Rule 50 Advisory Committee's Note (1963).

The verdict winner is similarly protected when JMOL is granted for the first time on appeal. "[T]he appellate court … may order a new trial at the verdict winner's request or on its own motion." *Weisgram*, 528 U.S. at 451. Even where it is not "an undue burden" to make new-trial arguments "in the course of" defending the judgment, "the appellee can choose for his own convenience when to make his case for a new trial" and does not have to "bring his grounds for new trial to the trial judge's attention when defendant first makes an

n.o.v. motion." *Neely*, 386 U.S. at 328-329.[3] This Court in fact *rejected* a proposed amendment to Rule 50 that would have imposed waiver on verdict winners and losers alike, and thus improperly "elided" these critical "differen[ces]" between an "alternative motion for a new trial made by the verdict loser" and a "new-trial motion by the verdict winner after judgment *n.o.v.* has gone against him." Kaplan, 77 Harv. L. Rev. at 819 n.227.

The court of appeals did not acknowledge *Neely* and its progeny, and the cases it did cite are inapposite. The Federal Circuit relied, in particular, on *Wallace* v. *McGlothan*, 606 F.3d 410 (7th Cir. 2010), for the proposition that a "party waive[s] an argument by failing to raise it in opposition to [a JMOL] motion." App. 16a. But *Wallace* dealt specifically with whether a verdict *loser's* failure to comply with Rule 50(a) and (b) is a waivable defect that cannot be challenged on appeal without first being objected to below. 606 F.3d at 418-419. It did not deal with whether a verdict *winner* waives its right to a new trial by waiting to request one until after JMOL is entered, as expressly contemplated by Rule 50(d). The only other case the Federal Circuit

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[3] The question in *Neely* was whether a court of appeals may order JMOL to be entered in the first instance. This Court, in granting review, specifically directed the parties to address whether "this disposition" would conflict with the provision under Rule 50(d) (then (c)(2)) for the verdict winner to request a new trial in the district court after JMOL is awarded. 386 U.S. at 321. The Court declined to adopt "an ironclad rule" barring such dispositions, *id.* at 326, but in so doing emphasized the strict limits on a verdict loser's entitlement to JMOL and the numerous opportunities a verdict winner has—and must have—to raise new-trial arguments at later stages, including for the first time on appeal, *see id.* at 325-329.

cited for this proposition—*United States* v. *47 W. 644 Route 38, Maple Park, Ill.*, 190 F.3d 781 (7th Cir. 1999)—is even farther afield and deals with waiver of summary-judgment arguments. *Id.* at 783. Neither case speaks to this Court's special "concern" with entering JMOL against a verdict winner who may have a right, at a minimum, to a new trial if its verdict is set aside. *Neely*, 386 U.S. at 325.

Moreover, although the Federal Circuit purported to be interpreting the regional court of appeals' law on this fundamental procedural issue, its interpretation of Seventh Circuit precedent is manifestly wrong. The Seventh Circuit, unlike the Federal Circuit, has not created a waiver rule with respect to new-trial arguments not raised by a verdict winner in opposition to JMOL. To the contrary, the Seventh Circuit has granted a new trial where the verdict winner, after losing JMOL, first sought a new trial *at oral argument on appeal*. *Erwin* v. *County of Manitowoc*, 872 F.2d 1292, 1300 (7th Cir. 1989). The Federal Circuit's decision thus breaks with rather than follows Seventh Circuit precedent.

C. The Federal Circuit's Decision Is Significant And Will Have Deleterious Consequences For Trial Practice

Beyond eviscerating Rule 50(d)'s protection of the rights of verdict winners, the Federal Circuit's decision will lead to costly and complex post-trial briefing that combines the losing party's attacks on the verdict with the verdict winner's myriad potential grounds for a new trial or remittitur in the rare event that the verdict is set aside. In contrast, Rule 50 anticipates an orderly two-staged approach that enables the parties to focus their respective JMOL briefs on attacking and

defending the jury's verdict while permitting the verdict winner to reserve potential grounds for a new trial until support for the verdict is found to be "legally [in]sufficient" in some specific way. Fed. R. Civ. P. 50(a)(1). The Federal Circuit has thus replaced Rule 50(d)'s rational and efficient system for adjudicating JMOL and new-trial motions—a system that recognizes general support for jury awards and specially protects verdict winners—with a disorderly process that forces the party that won at trial to raise all sorts of new-trial arguments that may never matter even while it is still defending the jury's verdict.

The immediate effect will be extensive ex-post adjudication of waiver in similar cases. The Federal Circuit's own subsequent reliance on the decision in this case unequivocally makes waiver central to determining "whether to order a new trial on damages" when a verdict is first set aside based on insufficient "support." *Finjan, Inc.* v. *Blue Coat Sys., Inc.*, 879 F.3d 1299, 1312 (Fed. Cir. 2018) (remanding case to district court to determine "whether [verdict winner] waived the right to establish reasonable royalty damages under a new theory"). Indeed, while the patent statute requires courts to award "damages adequate to compensate for … infringement," 35 U.S.C. § 284, under the Federal Circuit's decision, the right to compensation for even conceded infringement like LifeTech's now depends on whether the verdict winner's JMOL opposition "waived the right to damages based on alternate theories," *Finjan*, 879 F.3d at 1312 (citing App. 15a). In the long run, verdict winners will have no choice but to brief in opposition to JMOL every conceivable theory that could support a new trial in case a given theory supporting the jury's verdict fails.

It is no answer to say that LifeTech's JMOL motion "specifically attacked" Promega's entitlement to any lesser damages award "based on anything other than worldwide sales." App. 24a-25a. As an initial matter, that statement rests on an obvious misapprehension regarding the argument LifeTech made.[4]

In any event, the specificity with which a JMOL motion attempts to preclude a new trial has no bearing on the proper application of Rule 50(d). Imagine a JMOL motion that made its main points and then con-

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[4] The Federal Circuit quoted LifeTech's JMOL brief as arguing that "'with only an aggregate sales number for all kits combined, the jury had no evidence upon which it could partition that sales number up among any smaller collection of kits.'" App. 16a. But the Federal Circuit overlooked that this statement appeared in the *§ 271(f)(1) portion* of LifeTech's JMOL brief and was directed to whether Promega had quantified damages *under § 271(f)(1)* for the three kits for which LifeTech had supplied more than one component from the United States. LifeTech JMOL Br. 11, Dist. Ct. Dkt. 581.

LifeTech's argument with respect to *§ 271(a)* was different: There, LifeTech argued that, although the record contained evidence quantifying *some* U.S. sales, Promega needed to present the jury with "the *total amount* of U.S. sales." C.A.J.A. 2313 (emphasis added). As explained below, the argument that Promega failed to support *all* the damages it could have received under § 271(a) did not foreclose Promega from receiving *any* damages in a new trial. *See infra* p. 29. LifeTech would have needed to show that Promega had quantified *no* U.S. sales at all—something LifeTech did not and could not show given that the same paragraph of its JMOL brief cited testimony quantifying such sales. C.A.J.A. 2313 (citing C.A.J.A. 5989, 6014-6015). Because the only JMOL argument requiring a response here was that the evidence of § 271(a) damages was insufficient to sustain the entire amount of the jury's verdict, Promega's focus on defending the verdict in response could not logically waive a contingent right to a new trial under § 271(a).

cluded, "For all these reasons, and because there is no reason for a new trial, JMOL should be granted." By the Federal Circuit's logic, every alternative new-trial argument must be raised in response, or it is waived. Indeed, because the absence of a basis for a new trial on an alternative theory of liability is fairly implied in any JMOL motion, the same would presumably be true whenever a JMOL motion is filed.

The panel's ruling will therefore swallow Rule 50(d) and force verdict winners to raise all their new-trial arguments in opposing JMOL before it is clear whether the verdict will be disturbed. What the Federal Circuit described as an "unusual" case of waiver (App. 27a) is in fact the mine-run case involving a verdict loser's challenge to a damages verdict. *See, e.g.*, Br. for Appellee Micro 38-39, *Universal Instruments Corp.* v. *Micro Sys. Eng'g, Inc.*, No. 17-2748 (2d Cir. Mar. 14, 2018), 2018 WL 1449211 (arguing that plaintiff's "all-or-nothing damages strategy" precluded a new trial on remand); Defs.' Renewed Mot. for JMOL 12-13, *Ericsson Inc.* v. *TCL Comm'n Tech. Jury Trial Holdings, Ltd.*, 2:15-cv-11-RSP (E.D. Tex. Jan. 10, 2018), 2018 WL 501615 (urging JMOL of "no damages" where plaintiff "presented only legally flawed evidence in support of damages"). Verdict winners, faced with now-routine allegations that defense of the whole verdict amount constitutes an all-or-nothing strategy, will be forced to offer new-trial arguments designed solely to preserve theories that could support alternative, lesser damages amounts. Post-trial briefing on whether the verdict is "'supported by substantial evidence,'" as "'[m]ost jury damages awards'" are, *Whitserve*, 694 F.3d at 26, will therefore be bound up with all manner of sideshows on potential new-trial grounds that the verdict winner

would seek to pursue in the atypical case of an unsupported verdict.

None of this is to say that a verdict winner cannot waive its right to a new trial in appropriate circumstances not present here. A party that fails to object to an evidentiary ruling at trial, for example, could not rely on Rule 50(d) to excuse the waiver. But what a court cannot do under Rule 50(d) is find waiver based on the fact that a verdict winner focused *its JMOL opposition* on defending its verdict and reserved an otherwise available new-trial argument until a timely post-JMOL motion under Rules 50(d) and 59. Yet that is exactly what the district court did here. C.A.J.A. 2353, 2365-2366; *see also supra* pp. 9-11. The court of appeals' affirmance of that ruling not only grants a windfall to a self-confessed infringer, but conflicts with Rule 50(d) and this Court's precedent and, if uncorrected, will lead to premature, wasteful new-trial arguments by verdict winners.

II. THE FEDERAL CIRCUIT'S ATTEMPTS TO BOLSTER ITS WAIVER HOLDING CREATE ADDITIONAL LEGAL ERRORS THAT WOULD UNNECESSARILY COMPLICATE TRIALS

As discussed above, the "linchpin" of the Federal Circuit's and district court's rulings was their finding that Promega waived new-trial arguments by failing to raise them in its JMOL opposition. App. 15a-17a. After agreeing with the district court's finding of waiver on this basis, however, the Federal Circuit went on to state that Promega's trial strategy was "consistent with" that waiver at JMOL. App. 17a. In doing so, the Federal Circuit introduced additional errors, which threaten to complicate trials unnecessarily. The Fed-

eral Circuit's attempts to bolster its waiver finding only heighten the need for review.

1. First, the Federal Circuit suggested that Promega was required to elicit "expert testimony on damages" to be entitled to an award based on any subset of worldwide sales. App. 18a. In doing so, however, the Federal Circuit disregarded Promega's extensive evidence demonstrating the fact and quantity of sales in the United States and sales of Identifiler kits, all of which the jury could have interpreted without the aid of an expert. The Federal Circuit's ruling would require the use of expert witnesses far beyond what is necessary or proper.

As explained above, Promega introduced spreadsheets showing thousands of rows of U.S. sales. *E.g.*, C.A.J.A. 7051-7170, 7362-7473, 7632-7744, 7906-8002. Promega also introduced exhibits and testimony so that the jury would not have to add up all of those sales itself. "Pivot" worksheets showed total sales by country and, for each country, by kit. C.A.J.A. 7050, 7170.3, 6261:16-20. The record also included testimony from some of LifeTech's U.S. sales representatives about total sales in their regions. C.A.J.A. 5978:24-25, 5989:6-18, 6013:6, 6014:23-6015:6. This provided the jury more than enough evidence to calculate some amount of damages based on sales to U.S. customers and of Identifiler kits.

Contrary to the Federal Circuit's suggestion, Promega did not need to introduce expert testimony to summarize the evidence. "[E]xpert testimony not only is unnecessary but indeed may properly be excluded … 'if all the primary facts can be accurately and intelligibly described to the jury, and if they, as [people] of common understanding, are as capable of comprehend-

ing the primary facts and of drawing correct conclusions from them'" as an expert. *Salem* v. *United States Lines Co.*, 370 U.S. 31, 35 (1962). The calculation of damages in this case is not a "matter[] beyond the comprehension of laypersons." *Centricut, LLC* v. *Esab Grp., Inc.*, 390 F.3d 1361, 1369 & n.5 (Fed. Cir. 2004). Promega elicited testimony from a LifeTech employee about how to read LifeTech's spreadsheets to determine the location and amount of LifeTech's sales. C.A.J.A. 6249-6267. The jury was capable of understanding the sales spreadsheets and testimony of LifeTech's sales representatives and drawing correct conclusions from them. Reading and adding numbers are tasks well within the comprehension of lay jurors, especially where, as here, they have heard testimony about how to read the relevant sales records "to tell the location of the sale as well as the amount of the sale." C.A.J.A. 6261, 6249-6267.

Furthermore, expert testimony may not even have been permitted: Addition is not "scientific, technical, or other specialized knowledge." Fed. R. Evid. 702; *see United States* v. *Sepulveda-Hernandez*, 752 F.3d 22, 34 (1st Cir. 2014) ("Simple arithmetic, such as ordinary multiplication, is a paradigmatic example of the type of everyday activity that goes on in the normal course of human existence. One does not need a graduate degree in chemistry to master multiplication: in this country, that subject is universally taught in elementary schools."); *Master-Halco, Inc.* v. *Scillia, Dowling & Natarelli, LLC*, 2010 WL 2978289, at *3, *5-6 (D. Conn. Apr. 9, 2010) (excluding an expert's testimony where he did nothing more than "summariz[e]" numbers and simple addition and multiplication); *see also* 35 U.S.C. § 284 ("[t]he court *may* receive expert testimony as an aid to the determination of damages" in a patent case

(emphasis added)). The Federal Circuit's contrary holding—that expert testimony is needed to add various elements of a damages claim—would vastly expand the number of cases in which expert testimony is not only permitted but required, often complicating those proceedings and permitting plaintiffs to put the imprimatur of an expert on a damages claim when all the expert has done is simple arithmetic.

The Federal Circuit also erred to the extent that it suggested that there was insufficient evidence for a jury to award damages because the jury was not presented with evidence from which it could determine the *total amount* of U.S. and Identifiler sales. To justify an award of *zero* damages, it was not enough for the Federal Circuit to conclude that Promega failed to introduce sufficient evidence to calculate *all* damages for U.S. infringement. Rather, it needed to conclude that Promega had failed to introduce testimony that could support a finding of *any* damages for U.S. infringement. Thus, even if Promega did not adduce summary sales testimony from salespersons in every U.S. region, or introduce pivot worksheets showing U.S. sales in every year of the damages period, the jury could have awarded (and Promega was entitled to) damages for those regions and those years for which Promega did present evidence. A reasonable jury certainly could have awarded at least some damages for sales to U.S. customers under § 271(a) or for the sale of Identifiler kits under § 271(f)(1). Indeed, LifeTech's own JMOL motion admitted infringement and cited testimony quantifying some U.S. sales. C.A.J.A. 2313. Because there was sufficient evidence to support a verdict of some amount of damages, an award of zero damages was inappropriate, and a new trial was required.

2. Second, the Federal Circuit erroneously concluded that Promega had abandoned compensation for infringement under § 271(a) by asking for a jury verdict of *aggregate* damages under § 271(a) and § 271(f)(1). The well-settled precedent and practice of this Court dictate that when the full amount of a damages award is not adequately supported, the court should order a new trial or allow the plaintiff the option of agreeing to a remittitur. *Hetzel* v. *Prince William Cnty.*, 523 U.S. 208, 210-211 (1998) (per curiam). Where the evidence supports some lesser amount of damages, a court should not simply enter judgment in favor of the defendant.

In *Memphis Community School District* v. *Stachura*, 477 U.S. 299 (1986), for example, the plaintiff pursued three types of damages for the violation of his constitutional rights: traditional compensatory damages, punitive damages, and "additional compensatory damages for violations of constitutional rights." *Id.* at 304-305 (internal quotation marks and brackets omitted). On review of a verdict in the plaintiff's favor, this Court held that the third category of damages—based on the abstract value of constitutional rights—is not a permissible element of compensatory damages. *Id.* at 310. The jury's verdict had specified an amount for punitive damages, but did not specify how much of the remaining damages was designed to compensate the plaintiff for his injury and how much reflected the jury's valuation of the constitutional rights. *Id.* at 312. Rather than direct judgment of zero damages in favor of the defendants, this Court remanded for a new trial to determine the proper amount of compensatory damages. *Id.* at 312-313.

Numerous decisions of the courts of appeals confirm this standard practice of remand for a remitted

award or new trial on damages. *E.g.*, *Lattimore* v. *Polaroid Corp.*, 99 F.3d 456, 468 (1st Cir. 1996) (remanding for new trial where the defendant was entitled to JMOL on three of the plaintiff's four claims and the general verdict did not permit the court to determine what, if any, damages the jury would have returned on the remaining claim); *Rose Confections, Inc.* v. *Ambrosia Chocolate Co.*, 816 F.2d 381, 393-396 (8th Cir. 1987) (where a damages award is reversed because of "erroneous evidence," the proper remedy is a new trial on damages, rather than JMOL, if there was "sufficient untainted evidence to support an award of damages").

That Promega sought a single verdict for damages under § 271(a) and § 271(f)(1) was no reason for the Federal Circuit to depart from established precedent and practice here. It is common for plaintiffs to pursue multiple damages theories at trial and to seek a single award of damages under all of those theories. If the verdict cannot stand because one of those theories fails, remand on the remaining theories is the prescribed course. Thus, where a jury determines that the accused product infringes multiple patents and awards a general damages verdict—part of which cannot stand because infringement of one patent is later reversed—the plaintiff is entitled to a new damages trial, not zero damages. *Verizon Servs. Corp.* v. *Vonage Holdings Corp.*, 503 F.3d 1295, 1310 (Fed. Cir. 2007).

To hold otherwise would require plaintiffs to request special verdict forms separating out each theory of damages in case the evidence on one theory is later held to be insufficient. While special verdicts make sense in some cases, in others they are "infeasible or otherwise undesirable" because of the "multiple levels of detail" they force juries to decide and the heightened risk of juror confusion and inconsistent verdicts. *Gil-*

lespie v. *Sears, Roebuck & Co.*, 386 F.3d 21, 31 (1st Cir. 2004). Asking the jury to award separate damages verdicts under § 271(a) and § 271(f)(1), for example, would have required extra measures to avoid double-counting kits that infringed under both provisions.[5] The Federal Circuit's decision now mandates that complexity on pain of waiver.

The Federal Circuit's contorted reasoning cannot justify refusing to apply Rule 50(d) as written. Even if Promega was not entitled to the full amount of damages the jury awarded, LifeTech's admitted and adjudicated infringement required an award of some damages, and Promega's new-trial motion was timely under Rule 50(d) and should have been granted. The Federal Circuit's contrary ruling was wrong, conflicts with the rule and this Court's precedent, and will needlessly complicate post-trial briefing in numerous cases.

CONCLUSION

The petition for a writ of certiorari should be granted.

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[5] In fact, to fully avoid the threat of waiver under the Federal Circuit's decision, Promega would have been required to ask for a special verdict form with additional levels of detail, asking the jury to separate out damages under § 271(a) and § 271(f)(1) *for each type of kit* so that the court of appeals could affirm damages under § 271(a) and § 271(f)(1) for the Identifiler kits but only § 271(a) for the remaining kits. Of course, Promega would have had to request this special verdict form before knowing how the district court, the court of appeals, and this Court would ultimately interpret the statute.

Respectfully submitted.

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JUNE 2018