

3-1-2004

# A Proposed Solution to Jury Confusion in Patent Infringement Cases Involving Means-Plus-Function Claims

Tony Caliendo

Follow this and additional works at: <https://digitalcommons.law.byu.edu/lawreview>

 Part of the [Civil Procedure Commons](#), [Commercial Law Commons](#), and the [Courts Commons](#)

---

### Recommended Citation

Tony Caliendo, *A Proposed Solution to Jury Confusion in Patent Infringement Cases Involving Means-Plus-Function Claims*, 2004 BYU L. Rev. 209 (2004).

Available at: <https://digitalcommons.law.byu.edu/lawreview/vol2004/iss1/5>

This Comment is brought to you for free and open access by the Brigham Young University Law Review at BYU Law Digital Commons. It has been accepted for inclusion in BYU Law Review by an authorized editor of BYU Law Digital Commons. For more information, please contact [hunterlawlibrary@byu.edu](mailto:hunterlawlibrary@byu.edu).

# A Proposed Solution to Jury Confusion in Patent Infringement Cases Involving Means-Plus-Function Claims

## I. INTRODUCTION

Determining whether a patent is infringed is a question of fact<sup>1</sup> for a jury and frequently a difficult one. Juries are generally asked to determine, first, whether there is literal infringement, and second, whether there is infringement under the doctrine of equivalents. A finding of either type of infringement is sufficient to render the accused party liable. Juries frequently become confused in patent cases involving “means-plus-function” claims. The confusion stems from the fact that under 35 U.S.C. § 112, determining *literal infringement* of a means-plus-function claim requires the jury to determine whether the accused product is *equivalent* to the subject matter disclosed in the patent. The subsequent determination of infringement under the doctrine of equivalents *also* requires the jury to determine whether the accused product is an equivalent. The question that arises, then, is whether an “equivalent” under § 112 is the same thing as an “equivalent” under the doctrine of equivalents. In other words, is there one type of equivalence or two?

According to the Federal Circuit, the expert court in patent law, the general rule is that there is only one type of equivalence. There are, however, two exceptions<sup>2</sup> under which an accused product may be an “equivalent” for doctrine of equivalents purposes (resulting in infringement by equivalence) and yet not be a § 112 “equivalent” (resulting in no literal infringement). In cases involving one of those two exceptions, the accused product *cannot* be equivalent under § 112, but the jury must still determine whether the accused product is nevertheless equivalent under the doctrine of equivalents. In cases involving neither exception, a finding of equivalence requires evidence of *both* literal infringement under § 112 *and* infringement

---

1. See, e.g., *Kraft Foods, Inc. v. Int'l Trading Co.*, 203 F.3d 1362, 1370 (Fed. Cir. 2000) (“The . . . infringement analysis . . . is a question of fact.”).

2. See *infra* notes 25–26 and accompanying text for an explanation of the two exceptions.

under the doctrine of equivalents, while a finding of no equivalence should result in no infringement at all. Outside of the two exceptions, therefore, a jury should never say “no” to literal infringement and “yes” to infringement under the doctrine of equivalents.

And yet, juries return verdicts finding exactly that. Recent verdicts indicate the problem is current and ongoing.<sup>3</sup> These verdicts demonstrate juries’ misunderstanding of the law. Sometimes the erroneous verdict is corrected by the district court, and sometimes the Federal Circuit has to set things right on appeal. Regardless of whether the jury alone was confused, or whether the district court was also mistaken, there exists a common failure to communicate to juries a statement of the law that is both clear and correct. This failure has the potential to seriously harm defendants in patent infringement cases involving means-plus-function claims because, as this Comment will demonstrate, where a jury’s confusion regarding the notion of equivalence leads to simultaneous findings of no literal infringement but infringement under the doctrine of equivalents, that second finding may be incorrect as a matter of law, and the defendant may be wrongly held liable for infringement.

This Comment proposes jury instructions designed to clearly and correctly state the law and lead a jury to reach a correct verdict based on its determinations of fact. The instructions allow a jury the discretion to which it is entitled in determining questions of fact, while at the same time precluding the jury from returning a verdict that is incorrect as a matter of law once the jury has made its factual determinations. Following this Introduction, Part II explains several patent law fundamentals, including the legal standards for finding literal infringement and infringement under the doctrine of equivalents. Part II also explains the meanings of means-plus-function claims and the standards for infringement. Part III demonstrates how jury confusion regarding equivalence can lead to verdicts that are incorrect as a matter of law and harmful to both defendants and plaintiffs. Part III also provides two examples of recent cases in which juries reached incorrect verdicts due to confusion about the term “equivalence” in connection with literal infringement under § 112 and infringement under the doctrine of

---

3. See, e.g., *Hewlett-Packard Co. v. Mustek Sys., Inc.*, 340 F.3d 1314 (Fed. Cir. 2003). *Hewlett-Packard* is discussed in detail *infra* Part III.B.2.

equivalents. Part IV proposes jury instructions designed to channel juries toward correct verdicts and gives an example of how a hypothetical jury would analyze infringement of a means-plus-function claim under the proposed jury instructions. Part IV also demonstrates how the proposed instructions would have avoided the incorrect and inequitable verdicts illustrated in the two cases set forth in Part III. Part V provides a brief conclusion.

## II. PATENT CLAIMS AND PATENT INFRINGEMENT FUNDAMENTALS

### *A. Patent Claims and Literal Infringement*

In order to obtain a patent, an inventor is required to particularly point out and distinctly “claim” the subject matter he regards as his invention.<sup>4</sup> Patent claims delineate the bounds of the property right granted to the patent holder, thereby defining the subject matter the patent holder can legally exclude competitors from making and selling.<sup>5</sup>

For example, suppose Inventor X invents a chair and drafts the following patent claim covering his invention: “An apparatus comprising a round seat; four legs attached to the seat; and a backrest.” Assuming the patent is granted, the claim defines the property right Inventor X receives. He has the legal right to exclude his competitors from making and/or selling subject matter falling within the language of the claim.

Literal infringement occurs when a competitor makes or sells subject matter that is covered by the literal language of the patent.<sup>6</sup> For instance, if Competitor Y, subsequent to Inventor X’s obtaining the patent, begins making chairs having a round seat, four legs, and a

---

4. 35 U.S.C. § 112 para. 2 (2000) (“The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”).

5. *Id.* § 154(a)(1) (“Every patent shall . . . grant to the patentee . . . the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States . . . .”); *see also* *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002) (noting that patent claims allow a patent holder to “know what he owns, and the public [to] know what he does not”).

6. *See, e.g., Kraft Foods*, 203 F.3d at 1370 (“A claim is literally infringed when the accused device literally embodies each limitation of the claim.”); *Lantech, Inc. v. Keip Mach. Co.*, 32 F.3d 542, 547 (Fed. Cir. 1994) (“Literal infringement is found where the accused device falls within the scope of the asserted claims as properly interpreted.”).

backrest, Competitor Y's product *literally infringes* Inventor X's patent. This is because each and every limitation of Inventor X's patent claim is present in Competitor Y's chair.<sup>7</sup> If even a single limitation of a patent claim is not present in the accused device, there is no literal infringement.<sup>8</sup> For example, if Competitor Y had made his chairs with a *square* seat, four legs, and a backrest, there would be no literal infringement because one of the limitations of the claim (a *round* seat) is not present in Competitor Y's chair. Even insubstantial differences between the accused product and the language of the patent claim are sufficient to avoid literal infringement.<sup>9</sup>

### B. Infringement Under the Doctrine of Equivalents

Courts have created the doctrine of equivalents to broaden the protection a patent affords its owner.<sup>10</sup> Put simply, the doctrine of equivalents allows a patent holder to exclude competitors from making and selling not only the subject matter *literally* covered by the patent claims, but also subject matter *equivalent* to the literally-claimed subject matter.<sup>11</sup> Thus, "[t]he scope of a patent is not limited to its literal terms but instead embraces all equivalents to the claims described."<sup>12</sup> Therefore, even if a competitor's product does not literally infringe, it might still infringe under the doctrine of equivalents. Returning to the previous example, suppose again that

---

7. See, e.g., *Kraft Foods*, 203 F.3d at 1370; *Lantech*, 32 F.3d at 547 ("For literal infringement, each limitation of the claim must be met by the accused device exactly, any deviation from the claim precluding a finding of infringement.").

8. See, e.g., *Wolverine World Wide, Inc. v. Nike, Inc.*, 38 F.3d 1192, 1199 (Fed. Cir. 1994) ("If an express claim limitation is absent from the accused product, there can be no literal infringement as a matter of law." (citing *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1580 (Fed. Cir. 1989))).

9. See, e.g., *Festo*, 535 U.S. at 731 ("If patents were always interpreted by their literal terms, their value would be greatly diminished. Unimportant and insubstantial substitutes for certain elements could defeat the patent, and its value to inventors could be destroyed by simple acts of copying.").

10. For example, the *Festo* court held,

[P]atent claims must protect the inventor not only from those who produce devices falling within the literal claims of the patent but also from copyists who 'make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law.'

*Id.* at 732-33 (quoting *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 607 (1950)).

11. See, e.g., *id.*

12. *Id.* at 732.

Inventor X's patent claim recites, "An apparatus comprising a round seat; four legs attached to the seat; and a backrest." Competitor Y's chairs, which have a *square* seat, four legs, and a backrest, do not literally infringe. However, if a jury determines that a square seat is *equivalent* to a round seat, Competitor Y's chairs will infringe under the doctrine of equivalents.<sup>13</sup>

Courts generally instruct juries to determine equivalence under one of several different tests. Under the most basic test—the "insubstantial differences" test—an element of an accused device is equivalent to a limitation in a patent claim if the differences between the two are merely insubstantial.<sup>14</sup> The "function-way-result" test provides more guidance. In deciding whether a square seat is equivalent to a round seat under the function-way-result test, a jury would ask whether, in comparison with the round seat, the square seat performed substantially the same *function* in substantially the same *way* to achieve substantially the same *result*.<sup>15</sup> If the answer to

---

13. Whether or not an element of an accused device is equivalent to the subject matter in a patent claim is a question of fact. See, e.g., *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609 (1950) ("A finding of equivalence is a determination of fact."); *Baltimore Therapeutic Equip. Co. v. Loredan Biomedical, Inc.*, 1994 U.S. App. LEXIS 7444, at \*6 (Fed. Cir. Apr. 12, 1994) ("The issue of equivalence . . . is a question of fact . . ."). It is worth noting again that Competitor Y's liability is the same whether his chairs literally infringe or infringe under the doctrine of equivalents. In other words, his liability for literal infringement will be no greater or less than his liability for infringement under the doctrine of equivalents.

14. See, e.g., *Dawn Equip. Co. v. Kentucky Farms Inc.*, 140 F.3d 1009, 1015 (Fed. Cir. 1998) ("To determine equivalence under the doctrine of equivalents, this court applies the 'insubstantial differences' test, recognizing the admitted short-comings of that test."); cf. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40 (1997) ("[T]he insubstantial differences test offers little additional guidance as to what might render any given difference 'insubstantial.'").

15. See *Dawn*, 140 F.3d at 1016 ("Under the function-way-result test, one considers whether the element of the accused device at issue performs substantially the same function, in substantially the same way, to achieve substantially the same result, as the limitation at issue in the claim.").

The Supreme Court has not indicated a real preference for one test of equivalence over the other:

All that remains is to address the debate regarding the linguistic framework under which "equivalence" is determined. Both the parties and the Federal Circuit spend considerable time arguing whether the so-called "triple identity" test—focusing on the *function* served by a particular claim element, the *way* that element serves that function, and the *result* thus obtained by that element—is a suitable method for determining equivalence, or whether an "insubstantial differences" approach is better. There seems to be substantial agreement that, while the triple identity test may be suitable for analyzing mechanical devices, it often provides a

all three parts is “yes,” the jury should find the accused square seat to be equivalent to the claimed round seat, and should therefore find that Competitor Y’s chairs infringe Inventor X’s patent under the doctrine of equivalents.

### C. Section 112 and Infringement of Means-Plus-Function Claims

Means-plus-function claims are claims that do not expressly recite structure. Instead, they usually recite the words “means for” followed by a function to be performed.<sup>16</sup> For example, Inventor X could rewrite his claim in means-plus-function format this way, “An apparatus comprising a round seat; *means for supporting the seat above the ground*; and a backrest.” Construed literally, the language of the claim is broad enough to cover any apparatus having a round seat, a backrest, and *anything* that performs the recited function of supporting the seat above the ground. However, 35 U.S.C. § 112 operates to narrow the literal scope of means-plus-function claims: “An element in a claim . . . may be expressed as a means . . . for performing a specified function without the recital of structure . . . , and such claim shall be [literally] construed to cover the corresponding structure . . . described in the specification and equivalents thereof.”<sup>17</sup>

The *literal* scope of a means-plus-function claim is therefore construed not to mean *anything* that performs the recited function, but instead to mean the “corresponding structure . . . described in

---

poor framework for analyzing other products or processes. On the other hand, the insubstantial differences test offers little additional guidance as to what might render any given difference “insubstantial.”

In our view, the particular linguistic framework used is less important than whether the test is probative of the essential inquiry: Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention? Different linguistic frameworks may be more suitable to different cases, depending on their particular facts.

*Warner-Jenkinson*, 520 U.S. at 39–40.

16. See, e.g., *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus.*, 145 F.3d 1303, 1307 (Fed. Cir. 1998) (“A means-plus-function limitation contemplated by 35 U.S.C. § 112, ¶ 6 . . . recites a function to be performed rather than definite structure or materials for performing that function.”).

17. 35 U.S.C. § 112 para. 6 (2000); see also *Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 1320 (Fed. Cir. 1999) (“[Section] 112 . . . procedures restrict a functional claim element’s broad literal language . . . to those means that are equivalent to the actual means shown in the patent specification.” (internal quotations omitted)).

the specification and equivalents thereof.”<sup>18</sup> The “specification” is the portion of the patent that describes the invention and the manner of making and using it, frequently via drawings and diagrams of the invention.<sup>19</sup> In other words, while the *claims* define the scope of the property right the patent confers, the *specification* is what teaches “a person of ordinary skill . . . how to make and use [the] claimed invention without undue experimentation.”<sup>20</sup> The “corresponding structure” is the structure disclosed in the specification (via language and/or drawings) that performs the function recited in the claims. For example, Inventor X’s claim recites “means for supporting the seat above the ground.” The “corresponding structure” is whatever is disclosed in the specification that “support[s] the seat above the ground.” Perhaps the specification shows a drawing of a chair having four legs. Or perhaps it shows a chair with three legs. It might even show a chair with one very wide “leg.” The “corresponding structure” is whatever structure the specification discloses that performs the function recited in the claims.<sup>21</sup>

According to § 112, the *literal* scope of a means-plus-function claim encompasses the corresponding structure “*and equivalents thereof.*”<sup>22</sup> Therefore, in assessing whether there is *literal* infringement of a means-plus-function claim, the jury must determine whether the accused device contains the “corresponding structure” *or an equivalent thereof*. Returning to our example, Inventor X’s patent claim recites, “a round seat; means for

---

18. 35 U.S.C. § 112 para. 6; *see also Chiuminatta*, 145 F.3d at 1308 (“To determine whether a claim limitation is met *literally*, where expressed as a means for performing a stated function, the court must compare the accused structure with the disclosed structure, and must find equivalent structure as well as identity of claimed function for that structure.” (quoting *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 934 (Fed. Cir. 1987)) (emphasis changed from original)).

19. 35 U.S.C. § 112 para. 1 (“The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.”).

20. ROBERT L. HARMON, *PATENTS AND THE FEDERAL CIRCUIT* § 5.1, at 195 (5th ed. 2001).

21. “Corresponding structure” is a term of art and will be used throughout this Comment to refer to the structure the patent specification discloses that performs the function recited in the means-plus-function claim.

22. 35 U.S.C. § 112 para. 6 (emphasis added).



supporting the seat above the ground; and a backrest.” Suppose the patent specification contains a drawing of the invention in which the seat is supported by four legs representing the “corresponding structure.” Now suppose Competitor Y’s chair has a round seat and a backrest, but only three legs. In determining whether there is literal infringement, the jury would ask whether Competitor Y’s chair contains the “corresponding structure” (four legs) *or an equivalent thereof*. In other words, the question for the jury is whether three legs are *equivalent* to four legs. If they are, Competitor Y’s chair *literally infringes* Inventor X’s patent.

But suppose the jury finds that three legs are not equivalent to four legs and that, therefore, Competitor Y’s chair does *not* literally infringe. After determining there is no literal infringement, juries typically determine whether there is nevertheless infringement under the doctrine of equivalents. At this point in our example, there is some difficulty. Determining infringement under the doctrine of equivalents requires the jury to ask whether Competitor Y’s three legs are *equivalent* to the subject matter literally claimed in the patent. Under § 112, the subject matter literally claimed in the patent is the corresponding structure (four legs) *plus equivalents thereof*. Does this mean, therefore, that when determining infringement under the doctrine of equivalents the jury should ask whether three legs are equivalent to four-legs-plus-equivalents-thereof? In other words, must the jury ask whether something is equivalent to an equivalent of the corresponding structure? An equivalent of an equivalent is an awkward notion.<sup>23</sup> Or, on the other hand, does the determination of infringement under the doctrine of equivalents require the jury to simply ask whether three legs are equivalent to four legs? This seems redundant since the jury just answered that question in the negative in order to find no literal infringement.

The Federal Circuit has, to some extent, clarified these issues. The general rule is that the jury’s determination of equivalence, for § 112 literal infringement purposes, controls the determination of equivalence under the doctrine of equivalents as well. If the jury finds the accused structure is equivalent to the corresponding

---

23. See *Dawn Equip. Co. v. Kentucky Farms Inc.*, 140 F.3d 1009, 1020–21 (Fed. Cir. 1998) (Plager, J., additional views) (“Worse yet, can it be said that B is the equivalent of the (unknown) equivalent of A? Stating a rule of law to permit that manner of thinking is simply an invitation to confused thinking. It certainly invites results that defy understanding.”).

structure, the jury must find both literal infringement *and* infringement under the doctrine of equivalents. Conversely, if the jury finds the accused structure is not equivalent to the corresponding structure, as a matter of law there can be neither literal infringement nor infringement under the doctrine of equivalents.<sup>24</sup> There are, however, two exceptions to this general rule: where the accused structure either (1) does not perform the *identical function* recited in the patent claim,<sup>25</sup> or (2) employs

---

24. See, e.g., *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus.*, 145 F.3d 1303, 1310 (Fed. Cir. 1998) (“Thus, a finding of a lack of literal infringement for lack of equivalent structure under a means-plus-function limitation may preclude a finding of equivalence under the doctrine of equivalents.”). The Federal Circuit held in *Chiuminatta* that the jury’s finding of nonequivalence for § 112 purposes precluded a contrary finding under the doctrine of equivalents. See *id.* at 1311. “There is no policy-based reason why a patentee should get two bites at the apple. . . . [W]hy should the issue of equivalence have to be litigated a second time? . . . An element of a device cannot be ‘not equivalent’ and equivalent to the same structure.” *Id.*

25. See, e.g., *id.* at 1310 (noting that the tests for equivalence under § 112 and the doctrine of equivalents are closely related but with this difference: § 112 literal infringement, unlike the doctrine of equivalents, “requires identical, not equivalent function”); *Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 1320–21 (Fed. Cir. 1999) (“[U]nder § 112, ¶ 6, [literal infringement requires that] the accused device must perform the identical function as recited in the claim element while the doctrine of equivalents may be satisfied when the function performed by the accused device is only substantially the same.”).

Where the accused structure does not perform the identical function recited in the claims, the accused structure cannot literally infringe. It may infringe, if at all, only under the doctrine of equivalents. One test for determining whether the accused structure is equivalent for doctrine of equivalents purposes is the function-way-result test. See *supra* note 15 and accompanying text. If the accused structure

- (1) performs substantially the same *function* as the claimed device,
- (2) in substantially the same *way* as the claimed device,
- (3) to achieve substantially the same *result* as the claimed device,

then the accused structure is equivalent under the doctrine of equivalents. This same test cannot be used to determine equivalence under § 112 because to be a § 112 equivalent, the accused structure must perform the *identical* function recited in the claims, not just substantially the same function. Therefore, the test for determining equivalence under § 112 could be thought of as the “way-result” test instead of the “function-way-result” test. See *IMS Tech., Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1435 (Fed. Cir. 2000). Where the accused structure *does* perform the identical function recited in the claims, the “function” part of the function-way-result test is automatically met and the tests for equivalence under § 112 and the doctrine of equivalents are identical. In those cases, a finding of equivalence should lead to a finding of both literal infringement and infringement under the doctrine of equivalents.

For example, suppose the accused structure performs substantially the same function (but not the identical function) in substantially the same way to achieve substantially the same result. There could be no infringement under § 112 because the function is not identical to the

technology arising after the issuance of the patent,<sup>26</sup> the accused structure *cannot* be an equivalent under § 112 (meaning it cannot literally infringe), but may still be an equivalent (and therefore infringe) under the doctrine of equivalents. Therefore, only in cases involving one of the two exceptions may a jury correctly say “no” to literal infringement but “yes” to infringement under the doctrine of equivalents. In cases not involving either of the two exceptions (i.e., in cases where the accused device performs the identical function recited in the patent claim and does not constitute after-arising technology), there must be both § 112 literal infringement *and* infringement under the doctrine of equivalents *or else no infringement at all*—a jury should never find only one type of infringement. In fact, as will now be demonstrated, in cases not involving either exception, a finding of only one type of infringement may mean that the defendant has been seriously harmed.

### III. JURY CONFUSION REGARDING EQUIVALENCE RESULTS IN ERRONEOUS VERDICTS

#### *A. How Defendants Are Harmed*

In cases not involving either of the two exceptions mentioned in Part II.C, the problem with a jury’s simultaneously saying “no” to § 112 literal infringement and “yes” to infringement under the doctrine of equivalents is that exactly one of those findings *must* be correct and exactly one *must* be wrong. If the “no” finding is wrong

---

function recited in the claims. The accused structure would, however, infringe under the doctrine of equivalents because it meets the function-way-result test.

Now suppose the accused structure performs the identical function recited in the claims. If the accused structure performs that function in substantially the same way to achieve substantially the same result, it must be an equivalent under § 112 as well as under the doctrine of equivalents. This means there is literal infringement *and* infringement under the doctrine of equivalents. Under these circumstances, i.e., where neither of the two exceptions applies, a jury should never say “no” to literal infringement and “yes” to infringement under the doctrine of equivalents, but juries sometimes do. A main purpose of this Comment is to point out this error and propose jury instructions that should help a jury to avoid making this mistake.

26. See, e.g., *Al-Site Corp.*, 174 F.3d at 1320 (“An equivalent structure or act under § 112 cannot embrace technology developed after the issuance of the patent because the literal meaning of a claim is fixed upon its issuance. An ‘after-arising equivalent’ infringes, if at all, under the doctrine of equivalents.”).

(meaning the jury should have said “yes” to literal infringement), neither the defendant nor the plaintiff is typically harmed—the plaintiff is not hurt by the finding of no literal infringement because the defendant is still liable to him for infringement under the doctrine of equivalents.<sup>27</sup> The defendant is not hurt either; he is properly held liable for infringement just as he should be. However, if the “yes” finding is wrong (meaning the jury should have said “no” to infringement under the doctrine of equivalents), then the plaintiff has won when he should have lost and the defendant has been held liable for infringement when he should not have been.

For example, suppose again that Inventor X’s patent claim recites, “a round seat; means for supporting the seat above the ground; and a backrest.” The “corresponding structure” disclosed in the patent specification is four legs. Competitor Y’s chair has a round seat and a backrest, but only three legs. Since the accused structure (three legs) performs the identical function recited in the claim (supporting the seat above the ground) and does not constitute after-arising technology, neither of the two exceptions apply. Suppose now that the jury finds that Competitor Y’s chair does not literally infringe Inventor X’s patent, but that it *does* infringe under the doctrine of equivalents. This verdict, if allowed to stand, could seriously injure Competitor Y by making him liable for infringement when he should not be.

The jury’s finding of no literal infringement must mean that the jury found that Competitor Y’s three legs *were not* equivalent to the claimed four legs. That finding, by itself, is acceptable. But the jury’s finding of infringement under the doctrine of equivalents must mean that the jury found that Competitor Y’s three legs *were* equivalent to the claimed four legs. These findings are inconsistent. Competitor Y’s three legs cannot simultaneously be *equivalent* and *not equivalent* to the claimed four legs. The jury must have (incorrectly) applied two different standards of equivalence in order to have reached the “no”/“yes” result. Either the jury correctly understood equivalence when it said “no” to literal infringement (meaning the finding of “yes” to infringement under the doctrine of equivalents is wrong), or the jury correctly understood equivalence when it said “yes” to

---

27. A finding of either type of infringement is sufficient to render the defendant liable to the plaintiff. The plaintiff is not advantaged by being able to prove both types of infringement. Accordingly, he is not disadvantaged if only one type of infringement is found.

infringement under the doctrine of equivalents (meaning the finding of “no” to literal infringement is wrong). Had the jury correctly applied a single standard of equivalence, the result would have been either “yes”/“yes,” or “no”/“no.”

This is not merely a semantic problem.<sup>28</sup> One of the jury’s two findings is actually incorrect as a matter of law. If the “yes” finding is incorrect, then Competitor Y has been seriously injured because he is now liable for patent infringement when he should not be. This sort of verdict could be avoided through improved jury instructions that would require the jury to reach a legally correct verdict based on its factual findings regarding equivalence. The cases that follow provide examples in which improved jury instructions would have eliminated the erroneous verdicts as well as the accompanying inequitable results.

### *B. Case Examples*

#### *1. Dawn Equipment Co. v. Kentucky Farms Inc.*<sup>29</sup>

In *Dawn*, a case involving neither of the two exceptions, inadequate jury instructions injured the defendant. Dawn sued Kentucky Farms for infringement of a patent covering a device for adjusting the height of farm equipment such as a row cleaning device.<sup>30</sup> One of Dawn’s patent claims recited “means for *locking* . . . and . . . *releasing* the connecting means.”<sup>31</sup> The specification disclosed a rotatable shaft, a pin, and a slot as the structure that performed the recited functions of “locking” and “releasing.” The trial judge accordingly identified the rotatable shaft, pin, and slot combination as the “corresponding structure.” Kentucky Farms’s accused device had a “loose pin and holes combination” that accomplished the same functions of locking and releasing.<sup>32</sup>

The trial judge submitted two special interrogatories to the jury, asking the jury to compare the accused structure (loose pin and holes

---

28. See *Dawn*, 140 F.3d at 1020 (Plager, J., additional views) (“These are not simply matters of semantics. They go to the very act of deliberative decision making, decision making based on a meaningful rule of law.”).

29. 140 F.3d 1009 (Fed. Cir. 1998).

30. *Id.* at 1010.

31. *Id.* at 1012 (emphasis added to highlight the two recited functions).

32. *Id.* at 1016.

combination) with the corresponding structure (shaft, pin, and slot combination) and answer a simple “yes” or “no” as to whether there was § 112 literal infringement and whether there was infringement under the doctrine of equivalents.<sup>33</sup> Despite the fact that the accused structure performed the identical function recited in the patent and did not constitute after-arising technology, “[t]he jury returned its verdict, answering ‘no’ to literal infringement and ‘yes’ to infringement under the doctrine of equivalents.”<sup>34</sup> Kentucky Farms then filed a motion for judgment as a matter of law on the doctrine of equivalents infringement verdict.<sup>35</sup> When the trial court denied the motion, Kentucky Farms appealed to the Federal Circuit.<sup>36</sup>

The Federal Circuit three-judge panel reversed. Applying the function-way-result test, the panel held that “no reasonable jury could have found infringement under the doctrine of equivalents.”<sup>37</sup> While Kentucky Farms’s accused structure performed the identical function recited in the patent claim, it did so in a way that was not substantially the same and accomplished a result that was not substantially the same—in other words, the accused structure was not equivalent to the corresponding structure.<sup>38</sup>

Judge Plager, the author of the panel’s opinion, expressed his additional views because he found “the law in this area confused and confusing.”<sup>39</sup> He was troubled by the fact that the jury apparently found the accused structure simultaneously equivalent and not equivalent to the corresponding structure:

[The jury first answered “No” to literal infringement, but] was further charged to answer whether the claim at issue was infringed under the doctrine of equivalents. To this question the jury answered “Yes.” What could that mean? The jury, by its vote on literal infringement, had already ruled out infringement based on equivalent structure, . . . because that also would have been properly classified as “literal” infringement.

---

33. *Id.* at 1010.

34. *Id.*

35. *Id.*

36. *Id.*

37. *Id.* at 1016.

38. *Id.*

39. *Id.* at 1018 (Plager, J., additional views).

Given that, a finding of infringement under the doctrine of equivalents could only mean that there is something perceivably different between an equivalent under the doctrine [of equivalents] and [an] equivalent . . . under [§ 112]. What this could possibly be escapes me.<sup>40</sup>

Judge Plager concluded that the jury in this case never should have reached the question of equivalence/infringement under the doctrine of equivalents once it determined that the accused structure was not equivalent for § 112 literal infringement purposes.<sup>41</sup> Judge Newman expressed her additional view that the “no-yes” verdict Judge Plager found so troubling “could have been easily avoided by presenting more explicit special verdicts.”<sup>42</sup> She did not, however, suggest what sort of “more explicit special verdicts” the trial court should have provided to the jury.

The *Dawn* case illustrates how inadequate jury instructions may harm a defendant in a patent infringement suit. The instructions simply asked the jury to answer “yes” or “no” to both literal infringement and infringement under the doctrine of equivalents. According to the Federal Circuit panel, the jury correctly found that the accused structure was not equivalent to the corresponding structure disclosed in the patent specification. Based on that finding, the jury correctly found no literal infringement. At that point, because the case was one in which neither exception to the general rule was present, the jury’s finding of no equivalence for § 112 literal infringement purposes also required a finding of no infringement under the doctrine of equivalents. Adequate jury instructions would have required the jury to reach that verdict. Instead, however, the instructions actually given allowed the jury to incorrectly apply some other standard of “equivalence” and find infringement under the doctrine of equivalents. Fortunately, the defendant was ultimately held not liable for infringement because the Federal Circuit set things right on appeal. But the parties (especially the defendant) and the court would have been spared time and money if the jury instructions had been structured to require the jury to reach a legally correct verdict based on its initial (correct) finding of no equivalence.

---

40. *Id.* at 1020 (Plager, J., additional views).

41. *Id.* at 1022 (Plager, J., additional views).

42. *Id.* (Newman, J., additional views).

2. Hewlett-Packard Co. v. Mustek Systems, Inc.<sup>43</sup>

In *Hewlett-Packard*, a case involving the “lack-of-identical-function” exception to the general rule, faulty jury instructions harmed the plaintiff, not the defendant. Hewlett-Packard sued Mustek for infringement of its patent relating to scanners.<sup>44</sup> One of the claims recited “means for [selecting] a scan speed.”<sup>45</sup> Mustek’s accused scanners did not have a means allowing users to select scanning *speed*. Users could, however, select scanning *resolution*.<sup>46</sup> Unlike the *Dawn* case, *Hewlett-Packard* therefore dealt with one of the two exceptions because the accused structure did not perform the identical function as that recited in the claim (selecting scan *speed*). Nonidentity of function automatically precludes a finding of equivalence for § 112 literal infringement purposes. It does not, however, preclude a finding of equivalence/infringement under the doctrine of equivalents.

The district court submitted the question of infringement to the jury and instructed the jury to return *only one* of three possible verdicts: (1) no infringement, (2) literal infringement under § 112, or (3) infringement under the doctrine of equivalents.<sup>47</sup> The jury found literal infringement, and consequently, “did not reach the question of infringement under the doctrine of equivalents.”<sup>48</sup> Mustek moved to set aside the jury verdict of literal infringement. The district court declined and then went even further: the court granted JMOL of infringement under the doctrine of equivalents, even though the jury had not addressed the question of infringement under the doctrine of equivalents and Hewlett-Packard had not timely moved for JMOL.<sup>49</sup>

The court finds that even if the evidence did not support [§ 112] literal infringement, JMOL of infringement under the doctrine of equivalents is appropriate. Specifically, the Court finds that the function of selecting “resolution” on the accused products is equivalent to the function of selecting “scan speed” referred to in

---

43. 340 F.3d 1314 (Fed. Cir. 2003).

44. *Id.* at 1317.

45. *Id.* at 1319.

46. *Id.* at 1320.

47. *Id.* at 1321–22.

48. *Id.* at 1321.

49. *Id.* at 1318.



the patent. Therefore, even if the jury verdict of literal infringement cannot be supported by the evidence, the Court grants HP's Motion for JMOL of Infringement [under the doctrine of equivalents].<sup>50</sup>

On appeal, the Federal Circuit reversed, holding that (1) the jury verdict of § 112 literal infringement had to be set aside for lack of identity of function, (2) the district court's JMOL of infringement under the doctrine of equivalents had to be reversed because Hewlett-Packard did not timely move for JMOL, and (3) "[a] new trial on the issue of infringement under the doctrine of equivalents . . . [was] unwarranted."<sup>51</sup> The district court's inadequate jury instructions irreparably harmed Hewlett-Packard by causing it to lose the suit when it should have won, with no opportunity for a new trial.

*Hewlett-Packard* illustrates how inadequate jury instructions may injure a plaintiff in a patent infringement suit. Mustek's accused structure did not perform the identical function recited in the claim and therefore could not be equivalent under § 112.<sup>52</sup> Consequently, there could be no literal infringement under § 112, and the Federal Circuit was correct in setting the jury verdict aside.<sup>53</sup> This is a perfect example of a situation in which the accused structure might still be an equivalent for doctrine of equivalents purposes. While a § 112 equivalent must perform the identical function, an equivalent under the doctrine of equivalents need only perform *substantially the same* function.<sup>54</sup> The district court was probably correct in holding that selecting scan *resolution* was substantially the same function as selecting scan *speed*.<sup>55</sup> If so, Mustek's accused structure was an infringing equivalent under the doctrine of equivalents because it met the other two prongs (way-result) of the function-way-result test

---

50. *Id.* at 1322.

51. *Id.* at 1323.

52. Lack of identical function automatically precludes a finding of equivalence under § 112 (and therefore automatically precludes a finding of literal infringement as well). *See supra* note 25.

53. *Hewlett-Packard*, 340 F.3d at 1321.

54. *Id.* at 1321–22.

55. Scanning speed and scanning resolution are closely related. The higher the scanning speed, the lower the scanning resolution, and vice versa. By selecting a scanning resolution, a user is effectively selecting a scanning speed. *Id.* at 1320.

for equivalency.<sup>56</sup> In other words, Hewlett-Packard should have won the suit. The problem was that the district court's jury instructions prevented the jury from reaching the right question (whether there was infringement under the doctrine of equivalents) once it had answered the wrong question (whether there was literal infringement).<sup>57</sup> The court failed to realize that because the accused structure did not perform the identical function, literal infringement under § 112 was impossible, and the real question the jury should have answered was whether there was infringement under the doctrine of equivalents. Unlike the *Dawn* case, where the Federal Circuit was able to correct for the consequences of inadequate jury instructions on appeal, the inadequate jury instructions here cost Hewlett-Packard its entire infringement suit.<sup>58</sup>

#### IV. PROPOSED JURY INSTRUCTIONS TO ELIMINATE CONFUSION REGARDING INFRINGEMENT OF MEANS-PLUS-FUNCTION CLAIMS

The same example previously used throughout this Comment will serve as a hypothetical factual background for the proposed jury instructions. The instructions are only applicable to infringement cases involving means-plus-function claims and are intended to model a method for leading a jury to a verdict that is correct as a matter of law by asking the jury appropriate questions of fact and then requiring the jury to reach correct legal results based on its answers to the questions of fact.

---

56. This is evidenced by the fact that the district court *sua sponte* entered JMOL of infringement under the doctrine of equivalents after determining the functions, though not identical, were similar. Though the court did not expressly state that it found the "way" and "result" to be substantially the same, it must have so determined in order to enter JMOL of infringement under the doctrine of equivalents. *See id.* at 1322.

57. The jury was instructed to find *either* literal infringement *or* infringement under the doctrine of equivalents (or neither), but not both. *Id.* at 1321–22.

58. The Federal Circuit had to reverse the district court's grant of JMOL on the issue of infringement under the doctrine of equivalents because Hewlett-Packard did not timely move for JMOL. *Id.* at 1322. The Federal Circuit also ruled that "[a] new trial on the issue of infringement under the doctrine of equivalents . . . is unwarranted." *Id.* at 1323. Had Hewlett-Packard moved for JMOL on the issue of infringement under the doctrine of equivalents, the result might have been different. Therefore, Hewlett-Packard is at least partially to blame for its own loss. Even so, had the jury instructions been adequate, it seems likely that Hewlett-Packard would have prevailed in its suit in spite of its own oversights because the jury probably would have found infringement under the doctrine of equivalents. Here, the jury was not even permitted to reach that question.

### *A. Hypothetical Factual Background*

Inventor X has a patent containing a single claim. The claim recites, “An apparatus comprising a round seat; means for supporting the seat above the ground; and a backrest.” The patent specification describes and illustrates the invention. Specifically, a diagram discloses four vertical legs attached to and supporting the seat. Competitor Y begins making and selling a chair similar to what is claimed in Inventor X’s patent. Competitor Y’s chairs have round seats and backrests, but have *three* legs, not four. When Inventor X sees Competitor Y’s chairs on the market, he sues for patent infringement.

The district judge first construes the patent claim before asking the jury to answer the factual questions of infringement.<sup>59</sup> The “means for supporting” language indicates that the judge should construe the claim according to § 112 by first determining the “corresponding structure.” The recited function is “supporting the seat above the ground,” so the judge looks to the specification to see what structure disclosed therein performs that function. The four vertical legs “support[] the seat above the ground” and are, therefore, the “corresponding structure.” Accordingly, the judge instructs the jury that under § 112, the claim must be interpreted to *literally* cover the corresponding structure (four legs) “and equivalents thereof.”<sup>60</sup>

The jury must now decide the factual question of whether or not Competitor Y’s accused chairs infringe Inventor X’s patent. The judge gives the jury instructions included in the next section.

---

59. Determining infringement is a two-step analysis. First, the *court* properly construes the claim, i.e., determines what the terms in the claim language mean, and second, the jury determines whether the accused structure infringes the properly construed claim. *See, e.g.,* Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1581–82 (Fed. Cir. 1996).

60. 35 U.S.C. § 112 para. 6 (2000) (“[S]uch claim shall be construed to cover the corresponding structure . . . described in the specification and equivalents thereof.”).

*B. Proposed Jury Instructions*<sup>61</sup>

You, members of the jury, are asked to determine whether or not the chair made and sold by Competitor Y infringes Inventor X's patent. The questions that follow will enable you to first determine whether there is literal infringement under § 112 and then to determine whether there is infringement under the doctrine of equivalents.

(1) Does the accused structure (the three legs on Competitor Y's chair) employ technology arising after the issuance of the patent?<sup>62</sup> If your answer is "no," you should proceed to question (2). If your answer is "yes," you must find that Competitor Y's chair does not literally infringe and skip to question (4).<sup>63</sup>

---

61. I consider the jury instructions proposed in this section (Part IV.B) to be the main contribution this Comment makes. Part III.B sets forth two cases in which juries reached incorrect results as a direct consequence of inadequate jury instructions. This section sets forth the proposed jury instructions. Part IV.D applies the proposed instructions to the same two cases mentioned in Part III.B and demonstrates how the incorrect results reached in those cases would have been avoided had the proposed jury instructions been used.

The jury has three basic factual questions to answer: (1) does the accused structure employ after-arising technology; (2) does the accused structure perform the identical function recited in the patent claim; and (3) is the accused structure equivalent to the corresponding structure? The jury can return one of three possible verdicts: (1) no infringement of either kind; (2) literal infringement *and* infringement under the doctrine of equivalents; or (3) no literal infringement but infringement under the doctrine of equivalents. The important point is that the jury has discretion to answer the factual questions as it sees fit. But once the jury has answered those factual questions, it is *not* free to pick a verdict—the verdict follows as a matter of law. The contribution the proposed jury instructions make is that they channel a jury to the correct verdict based on the jury's answers to the factual questions. In other words, the instructions give the jury the discretion to which it is entitled, while at the same time avoiding giving the jury too much discretion—like the discretion to return a verdict that, as a matter of law, *cannot* follow from the determinations of fact.

62. After-arising technology is one of the two exceptions to the general rule that a finding of equivalence requires findings of both literal infringement and infringement under the doctrine of equivalents. *See supra* note 26 and accompanying text. If after-arising technology is present, there can be no literal infringement, and the jury is directed to proceed to question (4), which only gives the jury the opportunity to find infringement under the doctrine of equivalents, if at all.

The ordering of questions (1) and (2) is not important—question (2) could just as appropriately be asked before question (1). What is important, however, is that both questions are asked before proceeding to the remaining questions. Questions (1) and (2) represent the exceptions discussed *supra* notes 25–26 and accompanying text. If either exception is present (which would result in a "yes" answer to question (1) or a "no" answer to question (2)), there can be no equivalence or literal infringement under 35 U.S.C. § 112 para. 6. *See supra* notes 25–26.

63. A "yes" answer to question (1) means the after-arising technology exception discussed *supra* note 26 is present. The effect is that there can be no equivalence or literal

(2) Does the accused structure perform the identical function recited in the patent claim, i.e., does the accused structure “support[] the seat above the ground”?<sup>64</sup> If your answer is “no,” you must find that Competitor Y’s chair does not literally infringe<sup>65</sup> and skip to question (4). If your answer is “yes,” you should proceed to question (3). You should answer either question (3) or (4) as appropriate—you should not answer both.<sup>66</sup>

(3) Is the accused structure the same as or equivalent to the corresponding structure, i.e., does the accused structure perform the same function<sup>67</sup> as the corresponding structure in substantially the same way to achieve substantially the same result? If your answer is “yes,” you must find that Competitor Y’s chair literally infringes *and* infringes under the doctrine of equivalents.<sup>68</sup> If your answer is “no,” you must find that Competitor Y’s chair does *not* literally infringe

---

infringement under 35 U.S.C. § 112 para. 6. See *Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). The jury is therefore directed to skip questions (2) and (3), and go directly to question (4), thus precluding the jury from incorrectly finding literal infringement.

64. Nonidentity of function is one of the two exceptions to the general rule that a finding of equivalence requires findings of both literal infringement and infringement under the doctrine of equivalents. See *supra* note 25 and accompanying text. If the accused structure does not perform the identical function recited in the patent claim, there can be no literal infringement under § 112, and the jury is directed to proceed to question (4), which gives the jury the opportunity to find infringement only under the doctrine of equivalents, if at all.

65. See *supra* note 64. A “yes” answer to question (2) means neither exception is present and the general rule that a finding of equivalence requires findings of both literal infringement and infringement under the doctrine of equivalents applies. Accordingly, the jury is directed to answer question (3).

66. It is appropriate to require the jury to answer *either* question (3) or question (4) *but not both*. Question (3) applies to cases in which neither of the two exceptions discussed *supra* notes 25–26 is present, i.e., cases in which a finding of equivalence for § 112 purposes requires a finding of equivalence for doctrine of equivalents purposes. Question (4) applies to cases in which at least one of the two exceptions is *present*, i.e., cases in which infringement may be found, if at all, only under the doctrine of equivalents.

67. Compare questions (3) and (4). Question (3) says “same function,” while question (4) says “substantially the same function.” The difference is due to the fact that an affirmative answer to question (3) necessitates a finding of both literal infringement and infringement under the doctrine of equivalents. *Literal infringement* of a means-plus-function claim requires identity of function. Therefore, question (3) requires identical function. Question (4), on the other hand, deals with cases in which literal infringement cannot exist—due to lack of identity of function—and infringement may be found, if at all, under the doctrine of equivalents. Accordingly, question (4) appropriately inquires whether the accused structure performs “substantially the same function.”

68. In order to reach question (3), the jury must have decided that neither exception discussed *supra* notes 25–26 is present. Accordingly, the general rule that a finding of equivalence requires findings of both literal infringement and infringement under the doctrine of equivalents applies.

and does *not* infringe under the doctrine of equivalents.<sup>69</sup> After answering this question, your inquiry into infringement is done. Do not proceed to question (4).<sup>70</sup>

(4) Is the accused structure equivalent to the corresponding structure, i.e., does it perform substantially the same function<sup>71</sup> in substantially the same way to achieve substantially the same result?<sup>72</sup> If your answer is “no,” you must find that Competitor Y’s chair does not infringe under the doctrine of equivalents. If your answer is “yes,” you must find that Competitor Y’s chair infringes Inventor X’s patent under the doctrine of equivalents.

### *C. Hypothetical Jury’s Responses to Jury Instructions*

The jury first determines, in answer to question (1), that the accused structure in Competitor Y’s chair (the three legs) does *not* employ technology arising after the issuance of the patent. The jury therefore proceeds to question (2) and determines that the accused structure in Competitor Y’s chair does indeed perform the identical function recited in the patent claim. That is, the three legs “support[] the seat above the ground.” The jury therefore answers “yes” to question (2). Accordingly, as directed, the jury proceeds to question (3), noting that because of its response to question (2), it will not be answering question (4) at all.

Addressing question (3), the jury determines that the three legs are equivalent to the corresponding structure because they perform the same function in substantially the same way (by attaching to the seat and extending downward to the ground) to achieve substantially the same result (holding the seat some distance above the ground). Therefore, the jury answers “yes” to question (3). Based on that answer, the jury instructions require the jury to return a verdict finding both § 112 literal infringement and infringement under the

---

69. Question (3) deals with cases where neither exception discussed *supra* notes 25–26 is present. Therefore, a finding of no equivalence requires a finding of no infringement of any kind.

70. See *supra* note 66.

71. See *supra* note 67.

72. The test for equivalence employed here is the function-way-result test. See *supra* note 15 and accompanying text. Had the insubstantial differences test for equivalence been employed here, the jury instructions would say something like the following: “Is the accused structure equivalent to the corresponding structure, i.e., does the accused structure differ from the corresponding structure only in ways that are merely insubstantial?”

doctrine of equivalents. But suppose the jury had answered “no” to question (3) because it found the accused structure was *not* equivalent to the corresponding structure. The instructions would then direct the jury to find *no* literal infringement and *no* infringement under the doctrine of equivalents. That would be the correct legal result given the jury’s answers to the factual questions. In this way, the jury instructions avoid the incorrect result of finding infringement under the doctrine of equivalents after finding no literal infringement *where neither of the two exceptions apply*.

*D. Applying the Proposed Jury Instructions to  
Dawn and Hewlett-Packard*

*I. Dawn Equipment Co. v. Kentucky Farms Inc.*<sup>73</sup>

The proposed jury instructions would have avoided the incorrect verdict in the *Dawn* case.<sup>74</sup> In *Dawn*, neither of the two exceptions was present,<sup>75</sup> but the jury nevertheless answered “no” to literal infringement (based on a correct finding of no equivalence) and “yes” to infringement under the doctrine of equivalents.<sup>76</sup> The Federal Circuit had to reverse the “yes” portion of the verdict on appeal. Had the district court given the jury instructions proposed herein, the jury almost certainly would have returned a correct verdict. The jury would have answered “no” to question (1) because there was no after-arising technology, and “yes” to question (2) because the accused structure performed the identical function recited in the patent. The jury would therefore have been directed to answer question (3) and not question (4). Question (3) would have directed the jury to determine whether the accused structure was equivalent to the corresponding structure. The jury likely would have answered question (3) in the negative,<sup>77</sup> and the jury instructions

---

73. 140 F.3d 1009 (Fed. Cir. 1998).

74. See discussion of *Dawn supra* Part III.B.1.

75. *Dawn*, 140 F.3d at 1016 (noting that “the functions of the two mechanisms are the same”). The accused structure consisted of a “loose pin and holes combination” that accomplished the functions of locking and releasing. *Id.* Pin and holes combinations for locking and releasing constituted well-known technology at the time the *Dawn* patent issued. *Id.* at 1017.

76. *Id.* at 1010.

77. The *Dawn* jury returned a verdict of no literal infringement, *id.*, meaning the jury must have found that the accused structure was not equivalent to the corresponding structure.

would then require the jury to return the correct verdict of no literal infringement *and* no infringement under the doctrine of equivalents.<sup>78</sup> In other words, the defendant likely would have won at the trial level, thereby eliminating the wasteful necessity of an appeal to the Federal Circuit.

## 2. Hewlett-Packard Co. v. Mustek Systems, Inc.<sup>79</sup>

The proposed jury instructions would also have avoided the incorrect result in the *Hewlett-Packard* case.<sup>80</sup> There, the patent holder was harmed because the jury instructions did not permit the jury to address the question of infringement under the doctrine of equivalents after it (incorrectly) found literal infringement under § 112—a finding which was subsequently overturned on appeal. The proposed instructions would require a jury in every case to answer the question of infringement under the doctrine of equivalents. The jury may be bound to answer the question a certain way because of its prior answer to the question of literal infringement, but it answers the question nevertheless.

Suppose the jury in *Hewlett-Packard* had been presented with the proposed instructions. The accused structure did not perform the identical function recited in the patent claim,<sup>81</sup> so the jury would have answered question (2) in the negative; specifically, it would have found no identity of function.<sup>82</sup> Based on that answer, the jury instructions would then require the jury to find no literal infringement and proceed to question (4). The jury would almost certainly have found that selecting scanning *speed* and selecting scanning *resolution* were substantially similar functions, and therefore

---

On appeal, the Federal Circuit likewise held that “no reasonable jury could have found [equivalency].” *Id.* at 1016. It therefore seems likely that the *Dawn* jury, if presented with question (3) of the proposed jury instructions, would have found no equivalency. Of course, it is true that the *Dawn* jury also inexplicably found infringement under the doctrine of equivalents, which would have required a finding of equivalence. On balance, however, because the *Dawn* jury apparently simultaneously found no equivalency *and* equivalency, and because the Federal Circuit emphatically held no equivalency, it seems likely that the jury would have answered question (3) in the negative.

78. See question (3) of proposed jury instructions *supra* Part IV.B.

79. 340 F.3d 1314 (Fed. Cir. 2003).

80. See discussion of *Hewlett-Packard* *supra* Part III.B.2.

81. *Hewlett-Packard*, 340 F.3d at 1321.

82. The jury would have answered question (1) in the negative because *Hewlett-Packard* involved the lack-of-identical-function exception, not the after-arising technology exception.



answered “yes” to question (4) and found infringement under the doctrine of equivalents.<sup>83</sup> Even if the jury had incorrectly answered question (2) in the affirmative, it would have been directed to proceed to question (3) and it would have answered “yes.” Based on that answer, the instructions would have required the jury to find both literal infringement *and* infringement under the doctrine of equivalents. In other words, the jury would have determined infringement under the doctrine of equivalents regardless of whether or not it incorrectly found literal infringement. As a result, under the proposed instructions, Hewlett-Packard would not have lost its infringement suit.

## V. CONCLUSION

The confusion regarding the infringement of means-plus-function claims, as well as the incorrect verdicts that frequently result, could be eliminated by improved jury instructions. This area of law is not terribly complicated, and juries are certainly capable of correctly deciding questions of fact. The problem has been inadequate jury instructions—instructions that do not help juries reach verdicts that are correct as a matter of law based on their determinations of fact.

The jury instructions proposed in this Comment would alleviate the problem by assisting juries in reaching correct verdicts. The instructions would give the jury the discretion to which it is entitled in determining questions of fact, such as whether after-arising technology is present, whether there is identity of function, and whether the accused structure is equivalent to the corresponding structure. But once the jury has answered those questions of fact, the proposed instructions do *not* allow the jury to pick its verdict. Instead the instructions require the jury to return the verdict that follows as a matter of law from the determinations of fact. That is the contribution the proposed jury instructions make—they require the jury to return the correct verdict based on the jury’s determinations of fact, while allowing the jury to retain discretion over those factual determinations.

---

83. The district court felt strongly that the two functions were substantially similar—so strongly that it *san sponte* granted JMOL of infringement under the doctrine of equivalents. *Id.* at 1318. The fact that the court granted JMOL indicates the court viewed the other two parts of the function-way-result test for equivalency as also being met. *See supra* note 56.

Eliminating the risk of improper jury verdicts saves all parties (as well as the courts) from wasting resources in litigation. More importantly, avoiding improper verdicts reduces the risk that innocent parties will be wrongfully held liable for infringement or that infringing guilty parties will go unpunished. The jury instructions proposed herein would produce more verdicts that are correct as a matter of law, and district courts could and should implement them in patent infringement cases involving means-plus-function claims.

*Tony Caliendo*

