

The Right to a Jury Trial in Actions for Patent Infringement and Suits for Declaratory Judgment

Brian D. Coggio
Timothy E. DeMasi*

INTRODUCTION

Whether a case is tried before a jury significantly affects the patentee's (and conversely, the alleged infringer's) likelihood of success.¹ Accordingly, both parties are entitled to know definitively when a Seventh Amendment² right to a jury trial exists.³ Unfortunately, the Court of Appeals for the Federal Circuit has not provided clear guidance on this question, and the few decisions on point, while applying the same constitutional analysis,

* Mr. Coggio is a partner in the New York City office of Orrick, Herrington & Sutcliffe LLP. Mr. DeMasi is a partner in the New York City office of Pennie & Edmonds LLP. The authors wish to thank Kristin Smith, a 2002 summer associate at Pennie & Edmonds, for her assistance in the preparation of this Article. The views expressed herein are solely those of the authors. This Article does not express the views of the firms of Orrick, Herrington & Sutcliffe LLP or Pennie & Edmonds LLP, or any lawyer or client of either firm.

¹ See generally Kimberly A. Moore, *Judges, Juries, and Patent Cases—An Empirical Peek Inside the Black Box*, 99 MICH. L. REV. 365 (2000).

² The Seventh Amendment to the United States Constitution provides for the right to a jury trial in suits at common law. U.S. CONST. amend. VII; see also James Fleming, Jr., *Right to a Jury Trial in Civil Actions*, 72 YALE L.J. 655 (1963); *infra* note 19 and accompanying text.

³ See generally Margaret L. Moses, *What the Jury Must Hear: The Supreme Court's Evolving Seventh Amendment Jurisprudence*, 68 GEO. WASH. L. REV. 183 (2000); Greg J. Michelson, *Did the Markman Court Ignore Fact, Substance, and the Spirit of the Constitution in Its Rush Toward Uniformity?*, 30 LOY. L.A. L. REV. 1749 (1997); Allen N. Littman, *The Jury's Role in Determining Key Issues in Patent Cases: Markman, Hilton Davis and Beyond*, 37 IDEA 207 (1997); Gregory D. Leibold, *In Juries We Do Not Trust: Appellate Review of Patent-Infringement Litigation*, 67 U. COLO. L. REV. 623 (1996).

have reached inconsistent results.⁴ The court first examined the right to a jury trial in *In re Lockwood*⁵ and more recently in *Tegal Corp. v. Tokyo Electron America, Inc.*⁶ In both opinions, the court began by discussing the Supreme Court's test for determining if a right to a jury attaches to an action. According to the Federal Circuit, the Supreme Court concluded that the right to a jury depends on both the nature of the action and the remedy sought.⁷ With respect to statutory patent actions, the court further observed that the analysis has two steps: "First, we compare the statutory action to 18th century actions brought in the courts of England prior to the merger of the courts of law and equity. Second, we examine the remedy sought and determine whether it is legal or equitable in nature."⁸

In eighteenth century England, claims of patent infringement could be raised in actions at law or in suits in equity.⁹ Where a patentee sought only damages, the patentee brought an action at law and the action was tried before a jury.¹⁰ If, on the other hand, a patentee sought only to enjoin acts of infringement, the patentee could only bring a suit in equity.¹¹ In that latter instance, the action would be tried before the bench.¹² The court noted that nineteenth century American practice followed the same basic

⁴ *In re Lockwood*, 50 F.3d 966, 976 (Fed. Cir.), *vacated by sub nom.*, *Am. Airlines v. Lockwood*, 515 U.S. 1182 (1995) (holding plaintiff patentee is entitled to have the issue of validity tried to a jury "as a matter of right"); *Tegal Corp. v. Tokyo Electron Am., Inc.*, 257 F.3d 1331 (Fed. Cir. 2001) (finding no right to jury trial where equitable relief requested and only affirmative defenses raised); *In re SGS-Thomson Microelectronics*, 35 U.S.P.Q.2d (BNA) 1572 (Fed. Cir. 1995) (nonprecedential opinion) (also holding plaintiff patentee is entitled to have the issue of validity tried to a jury "as a matter of right"). See generally Brian D. Coggio & Timothy E. DeMasi, *The Right to a Jury Trial Under The Waxman-Hatch Act: The Question Revisited and Resolved*, 57 FOOD & DRUG L.J. 155 (2002).

⁵ 50 F.3d at 966.

⁶ 257 F.3d at 1331.

⁷ See *id.* at 1339; *Lockwood*, 50 F.3d at 972.

⁸ *Lockwood*, 50 F.3d at 972 (quoting *Chauffeurs Local No. 391 v. Terry*, 494 U.S. 558, 565 (1990) (quoting *Tull v. United States*, 481 U.S. 412, 417-18 (1987))); see also *Tegal*, 257 F.3d at 1339-41.

⁹ *Tegal*, 257 F.3d at 1340; *Lockwood*, 50 F.3d at 976.

¹⁰ *Tegal*, 257 F.3d at 1340; *Lockwood*, 50 F.3d at 976.

¹¹ *Tegal*, 257 F.3d at 1340; *Lockwood*, 50 F.3d at 976.

¹² *Lockwood*, 50 F.3d at 976.

pattern.¹³ Thus, under both English and American practice, it was the patentee who decided whether a jury would be permitted by the nature of the remedy sought.¹⁴

The same result should apply today: The right to a jury trial should be determined by the patentee's choice of remedy. When a patentee sues for infringement and seeks damages, the case may be tried before a jury. However, if a patentee either has no claim for damages or foregoes that claim, no right to a jury exists, even if the defendant interposes counterclaims seeking declarations of invalidity and non-infringement. Lastly, because a declaratory judgment suit is simply an inversion of a patent infringement action,¹⁵ the same result should apply. If a patentee asserts an infringement counterclaim seeking damages, the case may be tried to a jury; if the patentee either cannot or does not seek damages, the case must be heard by a court.¹⁶

This Article addresses various situations that arise in typical patent disputes. Part I briefly examines Seventh Amendment jurisprudence and the historical interpretation of the right to a jury trial. Part II explores patent infringement actions where damages are unavailable and concludes that, in those situations, there is no right to a jury trial.¹⁷ Part III analyzes Seventh Amendment rights

¹³ *Id.*

¹⁴ *See Tegal*, 257 F.3d at 1341 (As for the second step of the analysis, the court observed that an injunction is a purely equitable remedy.).

¹⁵ *Lockwood*, 50 F.3d at 980.

¹⁶ The court, with the consent of both parties, may order a trial with a jury whose verdict will have the same effect as if the trial by jury had been a matter of right. *See* FED. R. CIV. P. 39(c).

¹⁷ *See* *Glaxo Group Ltd. v. Apotex, Inc.*, No. 00-C5791, 2001 WL 1246628, at *5 (N.D. Ill. Oct. 16, 2001) (striking defendant's jury request because an action instituted under the Hatch-Waxman Act is equitable in nature); *Pfizer Inc. v. Novopharm Ltd.*, No. 00-C1475, 2001 WL 477163, at *4 (N.D. Ill. May 3, 2001) (declining to find a Seventh Amendment right to a jury trial in Hatch-Waxman actions). Although certain cases supporting the authors' conclusion were decided under the Hatch-Waxman Act, these decisions are instructive on the right to a jury trial in more typical actions for patent infringement. *See* Drug Price Competition and Patent Term Restoration Act of 1984, Pub. L. No. 98-417, 98 Stat. 1585 (codified at 15 U.S.C. §§ 68b-c, 70b (1994); 21 U.S.C. § 301 note 355, 360cc (1994); 28 U.S.C. § 2201 (1994); 35 U.S.C. §§ 156, 271, 282 (1994)). *See also* *Sanofi-Synthelabo v. Apotex Inc.*, No. 02-C2255, 2002 WL 1917871 (S.D.N.Y. Aug. 20, 2002) (stating that the Federal Circuit has not yet addressed the issue of a right to a jury trial where the counterclaims arise in Hatch-Waxman cases, but

in patent infringement actions where damages are available but not sought, and no counterclaims are asserted, and concludes that the parties are not entitled to a jury absent a claim for damages. Part IV concludes that the assertion of a declaratory judgment counterclaim in a patent infringement action does not affect the right to a jury. Part V analyzes suits for declaratory judgments and concludes that the right to a jury trial is again determined by the patentee's choice of remedy.¹⁸

I. THE SEVENTH AMENDMENT IS LIMITED TO ACTIONS AT LAW

In civil actions, including those involving patents, the right to a jury trial is controlled by the constitutional mandate of the Seventh Amendment.¹⁹ Limiting its application to "suits at common law,"²⁰ the Amendment preserves the right to a jury trial for those

holding that such counterclaims do not give rise to a right to a jury trial.); Brian D. Coggio & Sandra A. Bresnick, *The Right to a Jury Trial Under the Waxman-Hatch Act*, 52 FOOD & DRUG L.J. 259 (1997).

¹⁸ In analyzing the right to a jury trial, the authors recognize that the Supreme Court in *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500 (1959) and *Dairy Queen, Inc. v. Wood*, 369 U.S. 469 (1962) reversed the earlier rule that an action that sought both monetary damages and equitable relief was predominantly equitable and therefore was not tried to a jury. See also 5 MARTIN L. ADELMAN, PATENT LAW PERSPECTIVES § 7.6[2.-1] (1996). See generally *Lockwood*, 50 F.3d at 980-90 (Nies, J., dissenting); *Tights Inc. v. Stanley*, 441 F.2d 336, 341-44 (4th Cir. 1971); *Kennedy v. Lakso Co.*, 414 F.2d 1249, 1252-53 (3d Cir. 1969). Moreover, the present analysis intentionally avoids discussion of the writ of *scire facis* as well as the public rights and the issue of law exceptions to the Seventh Amendment as unnecessary to the authors' ultimate conclusions.

¹⁹ Specifically, the Seventh Amendment provides: "In suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of common law." U.S. CONST. amend. VII.

²⁰ *Id.*

The phrase "common law," found in [the Seventh Amendment], is used in contradistinction to equity, and admiralty, and maritime jurisprudence By *common law*, [the Seventh Amendment's framers] meant what the constitution denominated in the third article "law"; not merely suits, which the *common law* recognized among its old and settled proceedings, but suits in which *legal* rights were to be ascertained and determined, in contradistinction to those where equitable rights alone were recognized, and equitable remedies were administered In a just sense, the amendment then may well be construed to embrace all suits which are not of equity and admiralty jurisdiction,

actions that in 1971 created legal rights and remedies enforceable in a court of law.²¹ The Federal Rules of Civil Procedure echo the Seventh Amendment's instruction, reiterating the parties' right to a jury trial of all issues unless the court "finds that a right of trial by jury of some or all of those issues does not exist under the Constitution or statutes of the United States."²² In short, the scope of the Seventh Amendment extends only to the adjudication of legal, not equitable, rights.²³ As a result, parties to patent infringement actions cannot insist upon a trial by jury absent a claim that seeks legal relief.²⁴

Given that the Seventh Amendment embraces only actions based on legal rights and remedies, issues must be characterized as either legal or equitable before a jury trial is allowed. To determine whether a claim presents legal rights for a jury's determination or equitable rights for the court's review, two specific factors are evaluated.²⁵ First, the pending action is

whatever may be the peculiar form which they may assume to settle legal rights.

Parsons v. Bedford, 28 U.S. (3 Pet.) 433, 446–47 (1830) (emphasis added).

²¹ Curtis v. Loether, 415 U.S. 189, 193–95 (1974) (holding that a court must honor a party's jury demand where factual issues concerning legal rights and remedies require a trial). See also Pernel v. Southall Realty, 416 U.S. 363, 382–83 (1974) (holding that where an action involves rights and remedies recognized at common law, the parties' right to a jury trial must be preserved).

²² FED. R. CIV. P. 39(a)(2).

²³ See Tull v. United States, 481 U.S. 412, 417 (1987).

²⁴ But see 28 U.S.C. §§ 211–216 (repealed 1982) (trial of issues of fact in equity in patent causes). By way of illustration, the use of juries in patent-related claims has developed significantly since this statute, quoted below, was applicable:

District courts, when sitting in equity for the trial of patent causes, may impanel a jury of not less than five and not more than twelve persons, subject to such general rules in the premises as may, from time to time, be made by the Supreme Court, and submit to them such questions of fact arising in such cause as such district court shall deem expedient and the verdict of such jury shall be treated and proceeded upon in the same manner and with the same effect as in the case of issues sent from chancery to a court of law and returned with such findings.

Act of Feb. 18, 1875, ch. 77, § 2, 18 Stat. 316.

²⁵ The Court blurred the dual nature of this historical test in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), and overlooked all references to the test's remedy prong. Nevertheless, the *Markman* Court's analysis specifically noted a prior decision that properly cited both factors of the historical test. *Id.* at 377 (citing *Tull*, 481 U.S. at 426).

equated to its closest eighteenth century analog brought in courts of England²⁶ prior to the merger of law and equity.²⁷ Second, the requested relief is analyzed and classified as either legal or equitable.²⁸ The nature of the requested relief is widely viewed as the more important of the two criteria.²⁹ In addition, where neither a precise historical analog can be ascertained nor the available precedent be applied to the claims at issue, the limited abilities of juries may also be scrutinized.³⁰

Despite its seemingly straightforward inquiry, application of this two-part test has proven more difficult than one might have envisioned. For example, the merger of courts of law and equity in the early 1930s complicated the analysis considerably. After the merger, courts were presented with cases combining related claims for legal and equitable relief, creating confusion as to where legal and equitable claims diverged, if at all. In an attempt to clarify the mandate of the historical test, the Supreme Court opined that the nature of the issues controlled the nature of the underlying action and if both legal and equitable issues were present, a jury trial, was

²⁶ Much like today, in eighteenth century England, a plaintiff patentee was the master of both the choice of forum and nature of the remedy in patent infringement actions. Specifically, depending on the remedy requested, allegations of patent infringement could be raised either in actions at law or in suits in equity. Thus, if the patentee sought only monetary relief, the patentee would bring an action at law. Then, where requested, affirmative defenses of invalidity were assessed by a jury. *See Battin v. Taggart*, 58 U.S. 75 (17 How.) 74 (1854). Conversely, where a plaintiff patentee, faced with only past acts of infringement, sought to enjoin future infringement, the patentee could only bring suit in equity. Under these circumstances, the affirmative defense of invalidity was traditionally tried to the bench. *See Root v. Railway Co.*, 105 U.S. 189, 205–06 (1881).

²⁷ *See Curtis v. Loether*, 415 U.S. 189, 193–94 (1974).

²⁸ *See id.*

²⁹ *See Chauffeurs Local No. 391 v. Terry*, 494 U.S. 558, 565 (1990); *Tull*, 481 U.S. at 421 (characterizing the requested relief as “[m]ore important’ than finding a precisely analogous common-law cause of action in determining whether the Seventh Amendment guarantees a jury trial.” (quoting *Curtis*, 415 U.S. at 196)).

³⁰ *See Markman*, 517 U.S. at 388–90; *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 42 n.4 (1989) (listing practical abilities and limitations of juries as an additional factor to be consulted in determining whether the Seventh Amendment conveys a right to a jury trial); *Ross v. Bernhard*, 396 U.S. 531, 538 n.10 (1970) (including the practical abilities and limitations of juries among the factors of consideration when applying the historical test).

if requested, mandatory.³¹ Soon after, the Court further extended the right to a jury trial for legal issues once considered merely incidental to equitable claims and held that the jury trial must precede a trial of related issues to the bench.³²

The development of civil actions unknown at common law and thus considered neither legal nor equitable in nature only added to the complexities (and confusion) concerning the right to a jury trial. The advent of the declaratory judgment action, for example, provided accused infringers with a procedural defense to a patentee's charge of infringement and provided courts with yet another type of action to classify under the legal-equitable rubric. Ultimately, courts concluded that the filing of a declaratory judgment action seeking an equitable remedy prior to the assertion of legal counterclaims does not eliminate the Seventh Amendment right to have legal claims tried by a jury.³³ The difficult question remained, however: What are "legal" claims that can be tried to a jury? The following sections address typical scenarios that arise in patent disputes, providing a simple, straightforward solution to this complex problem.

II. WHERE A PATENTEE HAS A RIGHT ONLY TO EQUITABLE RELIEF, THERE IS NO RIGHT TO A JURY TRIAL

An action in which an accused infringer sought a declaratory judgment of invalidity and the patentee counterclaimed for only a permanent injunction against threatened infringement, *Shubin v. United States District Court*,³⁴ necessitated the Ninth Circuit's review of the right to a jury trial in a patent case lacking a request

³¹ See *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 504 (1959) (reasoning that in cases requesting both legal and equitable relief in addition to a jury trial on legal claims, all issues common to both types of claims were first to be tried to a jury).

³² See *Dairy Queen, Inc. v. Wood*, 369 U.S. 469, 473 n.8 (1962) ("As long as any legal cause is involved the jury rights it creates control.").

³³ See Barry S. Wilson, *Patent Invalidity and the Seventh Amendment: Is the Jury Out?*, 34 SAN DIEGO L. REV. 1787, 1800 (1997) ("Filing a declaratory judgment for an equitable action prior to filing legal counterclaims does not eliminate the . . . right to have a jury decide the legal claims." (citing *Beacon Theatres*, 359 U.S. at 504)).

³⁴ 313 F.2d 250 (9th Cir. 1963).

for monetary damages.³⁵ After examining the pleadings, the court emphasized that the patentee neither specified a damages amount nor suffered any actual infringement upon which damages could have been based.³⁶ With only threatened infringement asserted, the court found that “no possibility [existed] that damages could be awarded, or that an accounting could become necessary or possible.”³⁷ Consequently, absent a claim for damages, the action was equitable and only afforded the patentee the possibility of an equitable remedy.³⁸ As a result, the *Shubin* court held that the patentee, presenting a “purely equitable claim,”³⁹ was not entitled to a jury trial on either the accused infringer’s or the patentee’s declaratory judgment claims.⁴⁰

The Ninth Circuit’s analysis of the patentee’s claim underlines the authors’ ultimate conclusion that the right to a jury trial in

³⁵ See *id.* at 250.

³⁶ See *id.* at 251. The *Shubin* court did not fail to recognize that a legal issue triable before a jury could very well exist in an action in which a patentee claimed damages for infringement, noting that “[i]f we examine the pleadings before us alone, they indicate that there *could* exist an issue at law, i.e., damage for infringement.” *Id.* (emphasis added). The case, however, as emphasized by the *Shubin* court, differed in that “[n]o amount of damage [was] specified,” and “no prayer for damages in any amount” was asserted. *Id.* See also *Beaunit Mills, Inc. v. Eday Fabric Sales Corp.*, 124 F.2d 563 (2d Cir. 1942) (reiterating that “on issues of patent infringement, a jury trial may be had under a claim for damages only, as distinguished from a claim for injunction and accounting of profits”) (citations omitted).

³⁷ *Shubin*, 313 F.2d at 251. In short, because the parties stipulated that infringement had yet to occur, the patentee could not have sought damages. However, if instances of actual infringement were to occur during the course of the proceedings, the patentee could later assert a claim for damages, thus entitling him or her to a trial by jury. For example, in *Beaunit Mills*, the Second Circuit opined that where an equitable action later develops legal issues, “the question of jury trial will have to be determined in the light of the then status of the case.” 124 F.2d at 566. See also *infra* Part III (discussing the evolving legal and equitable claims in *Tegal Corp. v. Tokyo Electron America, Inc.*, 257 F.3d 1331 (Fed. Cir. 2001) and their effect on the parties’ right to a jury trial).

³⁸ The court succinctly illustrated this position, and clearly characterized the patentee’s cause of action, explaining: “[D]efendants seek only a permanent injunction against *threatened* infringement. This is not a legal issue. Defendants’ only remedy would be in equity.” *Shubin*, 313 F.2d at 251 (emphasis added). See also *Beaunit Mills*, 124 F.2d at 565 (approving the trial judge’s denial of a jury trial where the claim “is framed along equitable lines looking to injunctive relief” and “presenting equitable issues only”).

³⁹ *Shubin*, 313 F.2d at 252.

⁴⁰ See *id.* The *Shubin* decision also supports the authors’ opinion that the right to a jury trial in declaratory judgment actions depends solely on the nature of the relief requested by the patentee. See also *infra* Part V.

typical patent disputes lies within the sole control of the patentee. For example, the *Shubin* court analyzed the “sort of action the defendant patentee could have brought at common law”⁴¹ to determine the right to a jury trial and found that the patentee’s claims were firmly rooted in equity. Because the patentee did not and, in fact, could not seek monetary damages, the action was purely equitable, and the patentee therefore was not entitled to jury.⁴²

Following the reasoning of *Shubin*, the Federal Circuit in *Lockwood*, discussed below, similarly concentrated on the type of action the patentee could have brought at common law.⁴³ The *Lockwood* court specifically noted that both parties in *Shubin* stipulated that no infringement had occurred, significantly limiting the patentee’s possible relief.⁴⁴ Indeed, the Federal Circuit insisted that *Shubin* was easily distinguished from *Lockwood* because “no claim for damages *could have been* brought” by the patentee in *Shubin*.⁴⁵

The previous statement shows the Federal Circuit’s endorsement of the conclusion that where a patentee has no right to monetary damages, it is not entitled to a jury. Accordingly, the decisions of other circuit courts that equitable claims do not provide a right to trial by jury, coupled with the imprimatur of the Federal Circuit, support the authors’ conclusion. Indeed, various district courts have held that the lack of damages in actions instituted under the Hatch-Waxman Act negates the possibility of a

⁴¹ *Shubin*, 313 F.2d at 250.

⁴² *See Shubin*, 313 F.2d at 251–52; *Filmon Process Corp. v. Sirica*, 379 F.2d 449, 451 (D.C. Cir. 1967).

⁴³ *See In re Lockwood*, 50 F.3d 966, 977 (Fed. Cir.), *vacated by sub nom.*, *Am. Airlines v. Lockwood*, 515 U.S. 1182 (1995).

⁴⁴ *Id.* In *Lockwood*, the Federal Circuit emphasized that, in *Shubin*, the “patentee’s counterclaim for a permanent injunction against future infringement, paired with its stipulation to the absence of any claim for infringement damages, convinced the court that the issues in the case were purely equitable ones.” *Id.* (discussing *Shubin*, 313 F.2d at 250).

⁴⁵ *Id.* (emphasis added). In contrast, the *Lockwood* patentee could have sought (and did seek) both monetary and equitable relief. *See id.* at 968. Thus, *Lockwood* instituted a legal action and requested a jury trial.

jury trial.⁴⁶ In sum, where a patentee is only entitled to equitable relief, that patentee (or its adversary) is not entitled to a jury.

III. WHERE A PATENTEE DOES NOT SEEK MONETARY DAMAGES AND COUNTERCLAIMS OF INVALIDITY OR NON-INFRINGEMENT ARE NOT ASSERTED, THERE IS NO RIGHT TO A JURY TRIAL

In *Tegal Corp. v. Tokyo Electron America, Inc.*,⁴⁷ the Federal Circuit held that where the patentee sought only injunctive relief (although damages were available) and the defendant did not assert counterclaims, neither party had a right to a jury trial.⁴⁸ There, the patentee, Tegal, sued Tokyo Electron American, Inc. (TEA) for patent infringement, sought both damages and an injunction, and requested a jury.⁴⁹ TEA asserted affirmative defenses of invalidity and non-infringement, but did not counterclaim.⁵⁰ Six days before trial, Tegal dropped its request for damages with the understanding that “by withdrawing its damages claim, it would lose its right to a trial by jury.”⁵¹ Tegal then moved to withdraw its request for a jury trial, which TEA opposed. The district court agreed with Tegal, holding that a right to a jury trial no longer existed.⁵²

⁴⁶ See, e.g., *Pfizer Inc. v. Novopharm Ltd.*, No. 00 C 1475, 2001 WL 477163, at *1 (N.D. Ill. May 3, 2001); *Bayer AG v. Schein Pharm., Inc.*, No. 99-2181, 2000 U.S. Dist. LEXIS 20718, at *7 (D.N.J. Feb. 23, 2000); *Glaxo Wellcome Inc. v. Geneva Pharm. Inc.*, 45 U.S.P.Q.2d (BNA) 1702, 1703 (D.N.J. 1997). See generally Brian D. Coggio & Timothy E. DeMasi, *The Right to a Jury Trial Under The Waxman-Hatch Act: The Question Revisited and Resolved*, 57 FOOD & DRUG L.J. 155 (2002).

⁴⁷ 257 F.3d 1331 (Fed. Cir. 2001).

⁴⁸ The authors submit that *Tegal* casts doubt on the continuing validity of *Lockwood*. Accord 5 ADELMAN, *supra* note 18, § 7.6[2.-1]18, at 7-218.35 (noting that “[*Tegal*] is squarely contrary to the Federal Circuit’s holding in *Lockwood*”).

⁴⁹ See *Tegal*, 257 F.3d at 1338.

⁵⁰ The defendant’s failure to assert any counterclaims was apparently significant to the Federal Circuit in that this fact is repeated throughout the *Tegal* opinion. The court’s emphasis of the lack of counterclaims made it possible, at least implicitly, to distinguish *Lockwood*.

⁵¹ *Tegal*, 257 F.3d at 1338.

⁵² *Id.* The Federal Rules of Civil Procedure state that “[a] demand for trial by jury made as herein provided may not be withdrawn without the consent of the parties.” FED. R. CIV. P. 38(d). Thus, TEA argued that Tegal could not withdraw its request. The Federal Circuit recognized, however, that Tegal did not merely withdraw its request for a jury trial, but, by withdrawing its claim for monetary damages, Tegal destroyed the constitutional basis for the right of either party to request a jury. *Tegal*, 257 F.3d at 1338.

On appeal, the Federal Circuit affirmed and held that a defendant that asserts only affirmative defenses does not have a right to a jury trial where the patentee seeks only an injunction.⁵³ The opinion is significant for various reasons. First, it would appear that in *Tegal*, the plaintiff, unlike the cases discussed in the prior section, *had* a right to damages, but voluntarily waived that right. Thus, the court's decision implicitly recognized that the patentee's choice of remedy controlled both parties' right to a jury trial (at least where no counterclaims were asserted). Second, the wording of the Federal Circuit's opinion suggests that *Tegal* withdrew its damages claim to avoid a jury trial. Again, this emphasizes that the patentee, regardless of its motives, dictates the ultimate trier of fact. Third, the court recognized that the issue of patent validity, although classified as "legal," did not necessarily require a jury trial.⁵⁴

The Federal Circuit based its analysis on *Lockwood*, finding that even though that opinion had been vacated by the Supreme Court⁵⁵ its reasoning was still pertinent. Relevant to the issue in *Tegal* was *Lockwood*'s explanation that "[i]n eighteenth century England, allegations of patent infringement could be raised in both actions at law and suits in equity," and that the choice of forum depended on the type of remedy sought by the patentee.⁵⁶ This, in turn, controlled the right to a jury trial. If an injunction were sought, the patentee filed suit in a court of equity; conversely, if the patentee sought damages, the action was filed in a court of law. Applying that framework to the facts in *Tegal*, the Federal Circuit concluded that because *Tegal* sought only an injunction, in eighteenth century England, it would have been required to bring its suit in equity. Thus, neither party had a right to a jury.⁵⁷

⁵³ *Tegal*, 257 F.3d at 1341.

⁵⁴ *Contra In re SGS-Thomson Microelectronics*, 35 U.S.P.Q.2d (BNA) 1572 (Fed. Cir. 1995) (nonprecedential opinion). See 5 ADELMAN, *supra* note 18, § 7.6[2.-1], at 7-218.34.

⁵⁵ Since *Lockwood* was vacated, its precedential value had been eliminated. See *L.A. County v. Davis*, 440 U.S. 625, 634 n.6 (1979); *O'Connor v. Donaldson*, 422 U.S. 563, 577-78 n.12 (1975); *W.Y. Moberly, Inc. v. United States*, 924 F.2d 232, 236 (Fed. Cir. 1991).

⁵⁶ *Tegal*, 257 F.3d at 1340 (quoting *Lockwood*, 50 F.3d at 976).

⁵⁷ *Id.* at 1341.

In *Tegal*, the Federal Circuit repeatedly distinguished affirmative defenses of invalidity and non-infringement from counterclaims seeking the same relief.⁵⁸ The authors do not discern any difference between the two for purposes of a Seventh Amendment right to a jury trial.⁵⁹ Nor does *Tegal* articulate any such difference.⁶⁰ In fact, in its original (but later vacated) *Lockwood* decision, the Federal Circuit held that a right to a jury trial existed because the action sought damages for patent infringement, a legal remedy based on legal rights.⁶¹ More significantly, however, the court stated that “the existence of a counterclaim for a declaratory judgment of invalidity *does not alter* the nature of the issues, rights or the remedy sought in the infringement suit brought by *Lockwood*.”⁶² In its second *Lockwood* decision, the Federal Circuit altered its views and concluded that the existence of a counterclaim for invalidity does alter the nature of the case and the right to a jury trial.⁶³ The authors respectfully disagree.

⁵⁸ See *id.* at 1339, 1341. Interestingly, in its original decision in *In re Lockwood*, 30 U.S.P.Q.2d (BNA) 1292, 1293 n.1 (Fed. Cir. 1995) (unpublished), the Federal Circuit noted that the defendant’s declaratory judgment counterclaim “adopted all of the grounds for invalidity pled as defenses to *Lockwood*’s infringement suit.” This would indicate that the “nature” of the case to be adjudicated did not change by denoting affirmative defenses as counterclaims.

⁵⁹ See *Glaxo Group Ltd. v. Apotex, Inc.*, No. 00 C 5791, 2001 WL 1246628, at *5 (N.D. Ill. Oct. 12, 2001) (“The mere fact that invalidity has been raised in a counterclaim rather than in an affirmative defense does nothing to change this characterization.”). For further analysis of declaratory judgment actions, see *infra* Part V.

⁶⁰ The *Tegal* court’s emphasis on the remedy sought by the patentee supports the authors views, discussed in Part V, *infra*, regarding declaratory judgment actions. Indeed, it would have been instructive had the Federal Circuit articulated even one reason why the presence or absence of counterclaims for declarations of invalidity or non-infringement (which did not exist at common law) dramatically changed the analysis and, in fact, changed the result in *Tegal* from that in *Lockwood*.

⁶¹ *Lockwood*, 30 U.S.P.Q.2d (BNA) at 1294.

⁶² *Id.* (emphasis added).

⁶³ *In re Lockwood*, 50 F.3d 966, 976 (Fed. Cir.), *vacated by sub nom.*, *Am. Airlines v. Lockwood*, 515 U.S. 1182 (1995).

IV. WHERE A PATENTEE DOES NOT SEEK MONETARY DAMAGES,
THERE IS NO RIGHT TO A JURY TRIAL, EVEN WHERE
COUNTERCLAIMS SEEKING DECLARATIONS OF INVALIDITY AND
NON-INFRINGEMENT ARE ASSERTED

The authors realize that their conclusion on this issue is contradicted by the Federal Circuit's decisions in *Lockwood* and *SGS-Thomson*.⁶⁴ The authors respectfully submit that both opinions are incorrect. While a brief summary of both decisions is helpful, it is instructive to begin by reviewing the role of declaratory judgment counterclaims in patent infringement litigation, a key to a proper understanding of *Lockwood*.

To some extent, the benefits of declaratory judgment *counterclaims* mirror the benefits of the declaratory judgment procedure. Professor Borchard acknowledged the utility of such counterclaims in a section of his treatise entitled "Counterclaims":

Reference has been made to one of the great evils that had clustered around the patent monopoly in the form of the opportunity afforded to the patentee to harass competitors, alleged infringers and their customers by threatening to sue or actually suing and then moving to dismiss any time before trial, leaving his claims under the patent unadjudicated. Yet the infringer had no opportunity to insist on adjudication until 1934, when the action for a declaratory judgment of invalidity or non-infringement afforded him a remedy. Patentees actually commencing an infringement suit can furthermore now be prevented from arbitrarily discontinuing, provided the defendant files a petition for a counterclaim of invalidity or non-infringement, a pleading which insures an adjudication even should the plaintiff patentee move to dismiss.⁶⁵

Thus, a patentee's threat of suit could be redressed by instituting an action for a declaratory judgment of invalidity or non-infringement. Moreover, if a patentee commences an infringement

⁶⁴ *But see Glaxo Group*, 2001 WL 1246628, at *5 ("The mere fact that invalidity has been raised in a counterclaim rather than in an affirmative defense does nothing to change this characterization [of the right to a jury trial].").

⁶⁵ EDWIN BORCHARD, *DECLARATORY JUDGMENTS* 812 (2d ed. 1941).

action, the assertion of a counterclaim, as opposed to mere affirmative defenses, would prevent the patentee from dismissing the case and reinstating the action at a later date.⁶⁶ Despite the protections of Federal Rule of Civil Procedure 41(a) regarding voluntary dismissals,⁶⁷ declaratory judgment counterclaims still protect the accused infringer from abuses by the patentee.⁶⁸ Yet, it has been recognized that counterclaims seeking “only a declaratory judgment that the patent is invalid and un infringed . . . would not, of itself, entitle either party to a jury trial of the issues.”⁶⁹

As such, a counterclaim for invalidity or non-infringement does not affect the nature of the action in any way except to prevent the matter from remaining undecided if a plaintiff-patentee withdraws the suit.⁷⁰ The counterclaim, in this context, does not contribute a new or additional issue to be tried to a jury.⁷¹ This result is not altered by the Supreme Court’s decision in *Cardinal Chemical Co. v. Morton International Inc.*,⁷² in which the Court criticized the practice of the Federal Circuit in failing to review lower court holdings of invalidity if, on appeal, the patent were held not to be infringed.⁷³ Indeed, the Federal Circuit has confirmed that *Cardinal* is irrelevant to the present discussion.⁷⁴

⁶⁶ Professor Borchard explores this in vivid detail. *See id.* at 812–17. *See also* Van Alen v. Aluminum Co. of Am., 43 F. Supp. 833, 835 (S.D.N.Y. 1942).

⁶⁷ The dismissal by the patentee is without prejudice “except that a notice of dismissal operates as an adjudication upon the merits when filed by a plaintiff who has once dismissed in any court of the United States or of any state an action based on or including the same claim.” FED. R. CIV. P. 41(a).

⁶⁸ *See* BORCHARD, *supra* note 65, at 814–15.

⁶⁹ Protexol Corp. v. Koppers Co., 12 F.R.D. 7, 9 (S.D.N.Y. 1951).

⁷⁰ *See id.*

⁷¹ *See Van Alen*, 43 F. Supp. at 835.

⁷² 508 U.S. 83 (1993).

⁷³ *See id.* at 83.

⁷⁴ *See Super Sack Mfg. Corp. v. Chase Packaging Corp.*, 57 F.3d 1054, 1060 (Fed. Cir. 1995), *cert. denied*, 516 U.S. 1093 (1996).

In other words, according to *Cardinal*, a claim for a declaratory judgment of invalidity is independent of patentee’s charge of infringement in the following—and only the following—way: an affirmed finding of noninfringement does not, without more, justify a reviewing court’s refusal to reach the trial court’s conclusion on invalidity.

Id.

The leading Federal Circuit decision addressing the right to a jury in situations where counterclaims for declaratory judgment of invalidity or non-infringement are asserted is *Lockwood*.⁷⁵ There, the patentee, Lockwood, instituted a patent infringement action against American Airlines (American), alleging that the defendant infringed two patents. Lockwood sought damages, an injunction, and a jury. American asserted affirmative defenses and counterclaims for declaratory judgments of non-infringement and invalidity. After discovery, the district court granted American's motion for summary judgment of non-infringement and ordered that the case proceed solely on American's counterclaim for a declaratory judgment of invalidity. On American's motion, the district court struck Lockwood's demand that invalidity be tried to a jury.

The Federal Circuit granted Lockwood's petition for a writ of mandamus and directed the district court to reinstate Lockwood's jury demand.⁷⁶ The court began its analysis by observing that the Seventh Amendment guarantees the right to a jury in the adjudication of legal as opposed to equitable rights. To determine whether a particular statutory action resolves legal or equitable rights, courts must compare the statutory action to eighteenth century actions brought in the courts of England prior to the merger of law and equity, as well as the nature of the remedy sought. The court confirmed that in eighteenth century England, as previously noted, allegations of patent infringement could be raised in both actions at law and suits in equity, depending on the patentee's choice of remedy. If the patentee sought damages, the patentee brought an action at law and the issue of validity would be tried to a jury. The Federal Circuit reasoned that it could not, consistent with the Seventh Amendment, deny Lockwood that same choice merely because the validity of his patents was raised in a declaratory judgment counterclaim rather than as an

⁷⁵ In its original decision in *In re Lockwood*, 30 U.S.P.Q.2d (BNA) 1292, 1293 n.1 (Fed. Cir. 1995) (unpublished), the court apparently believed that Lockwood's claim for damages was still viable. In large measure, this was the basis of the Federal Circuit's decision holding that a right to a jury trial existed.

⁷⁶ See *In re Lockwood*, 50 F.3d 966, 980 (Fed. Cir.), *vacated by sub nom.*, *Am. Airlines v. Lockwood*, 515 U.S. 1182 (1995).

affirmative defense to infringement. The court, therefore, concluded that Lockwood was entitled to have the factual issues relating to validity tried to a jury.⁷⁷

In *Lockwood*, the court correctly recognized that declaratory judgment actions (and apparently counterclaims for declaratory judgment) are neither legal nor equitable. To decide the jury issue, therefore, courts must determine how patent validity was adjudicated prior to the merger of law and equity.⁷⁸ In its search for a historical analog, the Federal Circuit stated that “[i]nsofar as the validity of the patents is adjudicated, American’s action resembles nothing so much as a suit for patent infringement in which the *affirmative defense* of invalidity has been pled, and Lockwood’s right to a jury trial must be determined accordingly.”⁷⁹ The *Lockwood* court continued that the “primary difference between American’s action and the infringement suit that would formerly have been required for an adjudication of validity is that the parties’ positions here have been inverted, and such an inversion cannot operate to frustrate Lockwood’s Seventh Amendment rights.”⁸⁰ Because Lockwood’s infringement claim had been dismissed, the authors submit that the closer eighteenth century analog would have been an action for patent infringement in which damages were not sought, but invalidity was raised—by necessity—as an affirmative defense rather than as a counterclaim. In that situation, *Tegal* holds that a right to a jury trial does not exist.⁸¹

The *Lockwood* court recognized that under both English and American practice, it was the patentee who decided “in the first

⁷⁷ *In re Lockwood*, 50 F.3d at 980.

⁷⁸ *Id.* at 973.

⁷⁹ *Id.* at 974 (emphasis added).

⁸⁰ *Id.* at 974–75 (footnote omitted).

⁸¹ *Tegal* holds that the right to a jury trial where an “affirmative defense of invalidity” is raised depends on the nature of the remedy the patentee seeks. *Tegal Corp. v. Tokyo Electron Am., Inc.*, 257 F.3d 1331, 1341 (Fed. Cir. 2001). The *Lockwood* court distinguished *Shubin v. United States Dist. Court*, 313 F.2d 250 (9th Cir. 1963), because the plaintiff in *Shubin* could not have sought monetary damages, whereas Lockwood could have and, in fact, did. *Lockwood*, 50 F.3d at 977. The court did not, however, explain why this made a difference since Lockwood’s infringement claim had been dismissed. In *Tegal*, the plaintiff still had a right to damages, which it intentionally waived.

instance” whether a jury trial on validity would be compelled.⁸² The authors do not fully understand the reference to “in the first instance.” At common law, if the patentee chose to forego damages and institute a suit in equity, no jury trial was possible—regardless of the infringer’s defenses. However, where the patentee sought damages, an action at law would follow and a jury would decide the validity of the patent. The result would not have been altered because of declaratory judgment counterclaims—they did not exist at common law. This “in the first instance” language becomes more troubling since it appears to open the door for the right to a jury trial to be dictated not by the nature of the patentee’s action and the requested remedy, but by the alleged infringer’s choice to assert invalidity by a counterclaim in addition to an affirmative defense. Thus, the authors submit that the crux of the Federal Circuit’s error stems from the following statement:

We cannot, consistent with the Seventh Amendment, deny Lockwood that same *choice* merely because the validity of his patents comes before the court in a declaratory judgment action for invalidity rather than as a defense in an infringement suit. Lockwood is entitled to have the factual questions relating to validity in this case tried to a jury as a matter of right.⁸³

The authors submit that Lockwood had no choice because his infringement claim had already been dismissed. If Lockwood did not have a right to a jury trial in the “non-inverted” action, the “inversion” occasioned by the declaratory judgment action could *not* create such a right.⁸⁴ Indeed, earlier in its *Lockwood* opinion,

⁸² See *Lockwood*, 50 F.3d at 976 (“[I]f the patentee facing past acts of infringement nevertheless sought *only* to enjoin future acts of infringement, the patentee could *only* bring a suit in equity, and the defense of invalidity ordinarily would be tried to the bench.” (second emphasis added)); *Filmon Process Corp. v. Sirica*, 379 F.2d 449, 451 (D.C. Cir. 1967) (holding that when no damages were sought, no right to a jury trial existed).

⁸³ *Lockwood*, 50 F.3d at 976. Accord *Warner-Lambert Co. v. Purepac Pharm. Co.*, No. CIV.A.98-2749, 2001 WL 883232, at *2 (D.N.J. Mar. 30, 2001); *Hoechst Marion Roussel, Inc. v. Par Pharm., Inc.*, 39 U.S.P.Q.2d (BNA) 1363 (D.N.J. 1996).

⁸⁴ In this Article, the authors do not assert, as did the alleged infringer in *Lockwood*, that declaratory judgment actions are “invariably equitable,” and thus tried to the court. *Id.* at 978.

the Federal Circuit stated that if damages were not sought, the patentee had no right to a jury. To the extent the court took the view that because Lockwood had initially sought damages, later developments could not affect his right to a jury, that reasoning is contradicted by *Tegal*, where subsequent changes in the requested remedy directly affected the right to a jury. Moreover, to the extent the court implied that Lockwood would have had a choice if the validity issue had been raised only as an affirmative defense, it is further inconsistent with *Tegal*.

The authors submit that the court's emphasis on declaratory judgment counterclaims in *Lockwood* is misplaced, especially in view of the court's recognition that American's action resembled "nothing so much as" an action for patent infringement where the affirmative defense of invalidity had been pled.⁸⁵ The court's reliance on the declaratory judgment counterclaims necessitated the carefully constructed opinion in *Tegal*, which distinguished *Lockwood* on this very point.

The dissent by Judge Nies in *Lockwood* (in which then Chief Judge Archer and Judge Plager joined) explored in some detail the right to a jury trial in patent litigation. While Judge Nies disagreed with the majority for various reasons,⁸⁶ only her views regarding the historical test and the nature of declaratory judgment actions are pertinent to the present discussion.⁸⁷ In her dissent, Judge Nies focused on the lack of monetary damages as the key to determining the right to a jury. "Thus, all that remains at this stage are the declaratory judgment counterclaim[s] for invalidity and unenforceability. Neither remaining claim carries any right to

⁸⁵ See *Lockwood*, 50 F.3d at 974. In its discussion, the court apparently distinguishes *Shubin*, because "no claim for damages could have been brought." *Id.* at 977. This, the authors submit, is a distinction without a difference, especially in light of *Tegal*.

⁸⁶ See *id.* at 980–90 (Nies, J., dissenting). Judge Nies's discussion of the public rights and issue of law exceptions to a Seventh Amendment right is not addressed in this Article.

⁸⁷ Although the majority recognized the applicable two-part test (eighteenth century analog *and* remedy), Judge Nies criticized the majority for changing the "and" to "or." See *id.* at 984 (Nies, J., dissenting). The authors submit that this change—at least in emphasis—allowed the majority to de-emphasize the lack of monetary damages and focus almost entirely on the purported "legal" nature of the invalidity defense. Although this shift in emphasis may not have directly affected the majority's decision, it made the ruling easier to justify.

damages. The panel decision relies solely on the challenge to validity as the basis for the jury right.”⁸⁸ Because the remedy sought in that case was equitable, no jury trial was required. The dissent then reviewed numerous decisions supporting the view that the failure to seek monetary damages renders the case equitable, as opposed to legal.

Judge Nies further noted that the Supreme Court has held that the second part of the constitutional test, i.e., the requested remedy, is the more important part. However, according to Judge Nies, the majority nonetheless (and apparently surprisingly) found that a right to a jury trial existed. Thus, Judge Nies insisted that the majority’s analysis overlooked the fact that the patentee’s claim for infringement had been dismissed. She then stated that a declaratory judgment action for invalidity is not the “flip side” of an infringement claim, because a patentee has no possibility of suing for a declaration of validity.⁸⁹ Judge Nies’ views fully comport with those of the authors.

After *Lockwood*, the Federal Circuit next addressed the right to a jury trial in the unpublished, non-precedential opinion, *In re SGS-Thomson Microelectronics Inc.*⁹⁰ There, the patentee, International Rectifier (IR), sued SGS-Thomson and sought only an injunction to prohibit future infringement. SGS-Thomson asserted affirmative defenses and counterclaimed for declaratory judgments of non-infringement and invalidity. SGS-Thomson demanded a jury trial on its counterclaims, which the district court denied. On SGS-Thomson’s petition for a writ of mandamus, the Federal Circuit reversed.⁹¹ Relying on its decision in *Lockwood*, the court reasoned that if SGS-Thomson had brought an action seeking declaratory judgments of non-infringement or invalidity, either SGS-Thomson or IR would have had a right to a jury trial.⁹² The court observed that IR’s request for injunctive relief not only

⁸⁸ *Id.* at 985 (Nies, J., dissenting) (footnotes omitted). There is no dispute that the unenforceability claim is equitable. See generally *Gardco Mfg., Inc. v. Herst Lighting Co.*, 820 F.2d 1209 (Fed. Cir. 1987).

⁸⁹ *Lockwood*, 50 F.3d at 986 (Nies, J., dissenting).

⁹⁰ *In re SGS-Thomson Microelectronics Inc.*, 35 U.S.P.Q.2d (BNA) 1572 (Fed. Cir. 1995) (nonprecedential opinion).

⁹¹ *Id.* at 1572.

⁹² As discussed *infra* Part V, this proposition is not correct.

removed these issues from the jury, but stated that while *Lockwood* mentioned the patentee's choice of remedy in its decision, the *SGS-Thomson* court "based its decision on the legal nature of the declaratory judgment action, not the nature of the patentee's claim."⁹³ To the extent *SGS-Thomson* expands *Lockwood* to stand for the sweeping proposition that the issues of invalidity and non-infringement are always "legal," regardless of the patentee's claim, it is wrong.⁹⁴

In fact, the Federal Circuit's emphasis on the nature of the issue as legal or equitable is not helpful. Professor Moore put it best:

As Justice Stewart pointed out in his dissenting opinion in *Ross [v. Borchard]*, fact issues are not basically legal or equitable. They take on that coloration by the circumstances in which they arise. Thus, in an action for patent infringement where the plaintiff seeks no relief but an injunction, the issue of whether the patent is valid and infringed is no more nor less an issue that a jury could manage than the same issue would be had the plaintiff sought damages. The reason that in one case it would be tried to the court and in the other to the jury lies, then, not in the nature of the issue but in the historical development of separate jurisdictions.⁹⁵

⁹³ *SGS-Thomson*, 35 U.S.P.Q.2d (BNA) at 1573 (emphasis added). This ruling is apparently inconsistent with *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1127 n.4 (Fed. Cir. 1985) (A "patentee seeking only an injunction is not entitled to a trial by jury."). See also *Nike, Inc. v. "Just Did It" Enters.*, 32 U.S.P.Q.2d (BNA) 1059, 1061 (N.D. Ill. 1994).

⁹⁴ See *Lockwood*, 50 F.3d at 973 ("[D]eclaratory judgment actions are, for Seventh Amendment purposes, only as legal or equitable in nature as the controversies on which they are founded."); BORCHARD, *supra* note 65, at 239 (stating that an action for declaratory judgment "is as much legal as equitable.").

⁹⁵ 8 JAMES WM. MOORE ET AL., MOORE'S FEDERAL PRACTICE, § 38App.106[4], at 38App.-30 (3d ed. 2002). No prohibition ever prevented a court of equity from deciding questions of validity and infringement. See, e.g., *Silby v. Foote*, 61 U.S. (20 How.) 378 (1858); *Goodyear v. Day*, 10 F. Cas. 678 (C.C.D.N.J. 1852) (Case No. 5,566); *Fuller & Johnson Mfg. Co. v. Stephens*, 59 F. 157 (C.C.N.D.N.Y. 1893). See generally *Cochrane v. Deener*, 94 U.S. 780, 783 (1876). Only in actions at law were these issues necessarily tried to a jury. See, e.g., *United States v. Esnault-Pelterie*, 299 U.S. 201, 205 (1936); *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453, 455 (1871).

Put simply, “[a]n ‘issue’ does not exist in a vacuum and its characterization . . . may be determined only by reference to the ‘claim’ to which it is pertinent. If there are no legal claims in a suit then there are no legal issues warranting a right to a jury trial.”⁹⁶ Thus, if legal relief is not requested, a right to a jury trial does not exist, regardless of counterclaims for invalidity or non-infringement.

V. IN A DECLARATORY JUDGMENT ACTION FOR INVALIDITY OR NON-INFRINGEMENT, THE RIGHT TO A JURY TRIAL IS DICTATED BY THE PATENTEE’S CHOICE OF REMEDY

Declaratory judgment actions, unknown at common law, are a recent procedural development that facilitate the adjudication of controversies.⁹⁷ As explained by Professor Borchart, patentees could threaten alleged infringers with infringement actions but never institute suit, thereby denying the accused infringer its day in court.⁹⁸ The Declaratory Judgment Act (hereinafter the “Act”),⁹⁹ passed in 1934, changed this practice and provided the alleged infringer with a procedure to test the validity and infringement of the asserted patent.¹⁰⁰ Indeed, the Act is entitled “Creation of remedy.”¹⁰¹ As such, it is clear that the Act did not extend the jurisdiction of the federal courts. Instead it simply provided a procedure for, inter alia, the accused infringer to institute suit.

⁹⁶ *Owens-Ill., Inc. v. Lake Shore Land Co.*, 610 F.2d 1185, 1190 (3d Cir. 1979). *See also Gardo Mfg. Inc. v. Herst Lighting Co.*, 820 F.2d 1209, 1212 (Fed. Cir. 1987) (factual disputes arising in an equitable claim are not decided by a jury).

⁹⁷ Part of the difficulty in analyzing suits under the Declaratory Judgment Act, 28 U.S.C. § 2201, versus possible historical analogs in eighteenth century England is that a mere four years after the Act was passed, the merger of law and equity occurred. Thus, case law under the Act regarding actions at law and suits in equity was still developing when the merger took place, further compounding an already confusing area of law. It has been observed that in that four-year period every reported action for a declaration of patent invalidity was instituted in a court of equity. *See Coggio & Bresnick, supra* note 17, at 271 n.100.

⁹⁸ *See BORCHARD, supra* note 65, at 803; *see also Zenie Bros. v. Miskend*, 10 F. Supp. 779, 781 (S.D.N.Y. 1935).

⁹⁹ 28 U.S.C. § 2201 (2000).

¹⁰⁰ *See BORCHARD, supra* note 65, at 804–06.

¹⁰¹ 28 U.S.C. § 2201.

In *Lockwood*, the Federal Circuit suggested that a declaratory judgment action is merely the “inversion” of an action for patent infringement and that “such an inversion cannot operate to frustrate Lockwood’s Seventh Amendment rights.”¹⁰²

Under Rule 57 of the Federal Rules of Civil Procedure, a right to a jury trial exists if that right would have existed in the kind of action in which the pertinent issue would have been decided if a declaratory judgment procedure did not exist. As such, “declaratory judgment actions are, for Seventh Amendment purposes, only as legal or equitable as the controversies on which they are founded.”¹⁰³ The same is true in patent infringement actions. As a result, reference to the questions of patent validity or infringement as “legal” or “equitable” is not helpful in identifying “the decision maker.”

Because the issues of validity and infringement in declaratory judgment actions are neither legal nor equitable, the declaratory judgment plaintiff must await the defendant’s answer and counterclaims before knowing whether a right to a jury trial exists.¹⁰⁴ The leading treatises concur; for example, Professors Wright and Miller state:

An action for a declaratory judgment with regard to patents or copyrights will give rise to a right to a trial by jury if there would have been such a right in the coercive action that otherwise would have been required. Although there may be no right to a jury in the rare cases in which all that is sought is a declaration that the defendant’s patent is invalid or not infringed, if the defendant counterclaims and asks for damages for infringement of the patent, either

¹⁰² *In re Lockwood*, 50 F.3d 966, 976 (Fed. Cir.), *vacated by sub nom.*, *Am. Airlines v. Lockwood*, 515 U.S. 1182 (1995).

¹⁰³ *Lockwood*, 50 F.3d at 973. *See also* 8 MOORE, *supra* note 95, § 38App.106[1], at 38App.–24.

¹⁰⁴ As Professor Moore emphasizes: “The basic nature of the issue in patent litigation was also dependent upon the patentee’s choice of remedy: an action by the patentee under . . . former 35 U.S.C. § 70 for an injunction and damages presented equitable issues.” 8 MOORE, *supra* note 95, § 38App.106[1], at 38App.–22. The nature of the issue, e.g., whether the patent-in-suit is valid or invalid, does not change depending on the relief sought.

alone or in addition to other relief, there is a right to jury trial on the legal demands in the counterclaim.¹⁰⁵

Thus, the right to a jury trial rests with the patentee. In addition, the issues of validity and infringement raised in the declaratory judgment complaint are no more “legal” or “equitable” than the same issues when raised by an infringer as an affirmative defense in an action for patent infringement. In both instances, the trier of fact is dictated by the patentee’s choice of remedy. As Professor Moore explains:

These general principles applied where the alleged infringer took the initiative and sought declaratory relief against the patentee, and the patentee counterclaimed. *The nature of the patentee’s counterclaim, whether legal or equitable, would determine the basic nature of the issue in the case.*¹⁰⁶

The case law agrees. For example, *General Motors Corp. v. California Research Corp.*¹⁰⁷ was a declaratory judgment action for invalidity and non-infringement. Defendant interposed a counterclaim for infringement, sought damages and requested a jury trial. Plaintiff moved to strike, which was denied. The court noted that prior to the Act, infringement actions could only be litigated “at the instance of the patentee and, *at his option*, could be by legal action or in equity.”¹⁰⁸ Because the patentee had sought damages, a right to jury trial existed. In contrast, where no counterclaim for damages is interposed, the case must be tried to the court.¹⁰⁹

¹⁰⁵ CHARLES ALAN WRIGHT & ARTHUR R. MILLER, FEDERAL PRACTICE AND PROCEDURE: CIVIL 2D § 2312, at 107 (1994) (citations omitted).

¹⁰⁶ See 8 MOORE, *supra* note 95, § 38App.106[1] at App. 22 (emphasis added). See also GENE R. SHREVE & PETER RAVEN-HASEN, UNDERSTANDING CIVIL PROCEDURE, § 105, at 457 (2d ed. 1994) (footnotes omitted) (“In the usual reversed parties case, this [jury trial] inquiry would require application of the modified historical test for the right to jury trial to the action that the declaratory judgment defendant would have brought had not the declaratory judgment plaintiff filed first.”).

¹⁰⁷ 9 F.R.D. 565 (D. Del. 1949).

¹⁰⁸ *Id.* at 566 (emphasis added).

¹⁰⁹ See *Inland Steel Prods. Co. v. MPH Mfg. Corp.*, 25 F.R.D. 238, 245 (N.D. Ill. 1959) (“[P]rior to the enactment of the Declaratory Judgment Act . . . , the patentee had the choice of suing at law or in equity; his choice of remedy still controls the nature of his

Quite possibly, however, the most informative decision did not involve patents at all. In *Beacon Theatres v. Westover*,¹¹⁰ plaintiff instituted suit seeking a declaration that its conduct did not violate the antitrust laws and an injunction preventing defendant Beacon from instituting an antitrust action. Beacon filed a counterclaim for treble damages and demanded a jury trial.¹¹¹ The Court held that since the counterclaim for treble damages would have entitled Beacon to a jury trial if it had brought the action at law, Beacon “cannot be deprived of that right merely because [plaintiff] took advantage of the availability of declaratory relief to sue Beacon first.”¹¹² As Justice Stewart stated in his dissent, “[i]f the complaint had been answered simply by a general denial, therefore, the issues would under traditional principles have been triable as a proceeding in equity.”¹¹³ Indeed, in essentially the last sentence of the dissenting opinion, Justice Stewart specifically addressed the right to a jury in patent declaratory judgment actions. He instructed:

Determination of whether a claim stated by the complaint is triable by the court or by a jury will normally not be dependent upon the “legal” or “equitable” character of the counterclaim. There are situations, however, such as a case

action.”); *Hall v. Kish*, 11 F.R.D. 292, 293 (N.D. Ohio 1951); *Brody v. Kafka*, 73 U.S.P.Q. (BNA) 469 (S.D.N.Y. 1947); *Ryan Distrib. Corp. v. Caley*, 51 F. Supp. 377, 379 (E.D. Pa. 1943) (“There are numerous cases holding that the patent holder has his election as to the form of action and therefore the right to a jury trial.”). *But see* *Minnesota Auto., Inc. v. Stromberg Hydraulic Brake & Coupling Co.*, 167 U.S.P.Q. (BNA) 165, 166 (D. Minn. 1970) (ordering a jury trial in a patent declaratory judgment action even though no claim for damages was asserted; according to the court, the factual issues required a jury trial, even though the basic issues were “equitable”).

¹¹⁰ 359 U.S. 500 (1959). For further discussion of the *Beacon Theatre* decision, see John C. McCoid II, *Procedural Reform and the Right to Jury Trial: A Study of Beacon Theatres, Inc. v. Westover*, 116 U. PA. L. REV. 1 (1967); Martin H. Redish, *Seventh Amendment Right to Jury Trial: A Study in the Irrationality of Rational Decision Making*, 70 NW. U. L. REV. 486 (1975).

¹¹¹ *Beacon Theaters*, 359 U.S. at 503.

¹¹² *Id.* at 504. See also Gary M. Ropski, *Constitutional and Procedural Aspects of the Use of Juries in Patent Litigation (Part I)*, 58 J. PAT. OFF. SOC’Y 609, 618 (1976) (Under *Beacon Theatres*, the “right to jury trial depends upon the legal or equitable nature of the counterclaim.”). Ropski notes that *Beacon Theaters* was foreshadowed by *Ryan Distrib. Corp. v. Caley*, 51 F. Supp. 377 (E.D. Pa. 1943), a declaratory judgment action in which the defendant-patentee counterclaimed for damages. There, a right to a jury trial existed.

¹¹³ *Beacon Theatres*, 359 U.S. at 512 (Stewart, J., dissenting).

in which the plaintiff seeks a declaration of invalidity or noninfringement of a patent, *in which the relief sought by the counterclaim will determine the nature of the entire case.*¹¹⁴

The authors fully agree with Justice Stewart's observations, which were not affected by the majority opinion. So does Chief Judge Robinson of the District of Delaware. In *Rhenalu v. Alcoa, Inc.*,¹¹⁵ plaintiff Rhenalu filed a declaratory judgment action seeking rulings of invalidity and non-infringement of defendant Alcoa's patent, as well as a claim for tortious interference. Alcoa filed a counterclaim for infringement and requested both damages and an injunction.¹¹⁶ The parties later stipulated that all requests for monetary damages were withdrawn and that "no monetary relief (including damages) will be sought in this litigation."¹¹⁷ The case was tried to a jury and the patent was held valid and infringed. Based upon the then recently-decided *Tegal* case, plaintiff moved to vacate the judgment based on the jury verdict. In a one-page order the court granted the motion stating: "Pursuant to the Federal Circuit's decision in *Tegal Corp. v. Tokyo Electron America, Inc.*, given that defendant-patentee voluntarily withdrew its claim for damages it also waived its right to a jury trial."¹¹⁸ The court rested the right to a jury trial on the patentee's counterclaim. Lacking a counterclaim for damages, the patentee had no right to have the infringement or validity of the patent decided by a jury. Thus, even in a declaratory judgment action the right to a jury trial depends on the remedy selected by the patentee.

While this conclusion is consistent with *Tegal*, it conflicts with *Lockwood*. The declaratory judgment action in *Rhenalu*, which seeks a ruling of invalidity, is the functional equivalent of the counterclaim for invalidity in *Lockwood*. If *Tegal*, at least according to the Delaware court, dictates that the patentee in *Rhenalu* had no right to a jury trial, then the patentee in *Lockwood* equally had no such right.

¹¹⁴ *Id.* at 519 n.13 (citations omitted) (emphasis added).

¹¹⁵ No. Civ. A. 99-301, 2000 WL 1868178 (D. Del. Dec. 14, 2000).

¹¹⁶ *Id.* at *1.

¹¹⁷ *Id.* at *1 n.1.

¹¹⁸ Order, September 28, 2001 (citation omitted) (unpublished).

CONCLUSION

In light of the Federal Circuit's decision in *Tegal*, its earlier decisions in *Lockwood* and *SGS-Thomson* should, at a minimum, be revisited. Whether the reader agrees or disagrees with the views expressed by the authors, hopefully this Article will spur discussion that will lead to that reevaluation.