FENWICK & WEST LLP

Going to the Videotape: An Introduction to the Patent System

BY HEATHER N. MEWES AND DARREN E. DONNELLY

Patentees enter every jury trial with one distinct advantage: an official, ribboned copy of the patent at issue in the case.

This trial exhibit comes embossed with the seal of the Patent and Trademark Office and signed by the director of that office. It also includes a declaration that "[t]he requirements of law have been complied with, and it has been determined that a patent on the invention shall be granted under the law." The official copy of the patent is a visual and vivid reminder to the jury of the presumption that a patent is valid.

The presumption of validity can appear as an impossible hurdle for a defendant to overcome. A jury is commonly (and often repeatedly) instructed that the defendant must show invalidity by "clear and convincing evidence." See, *e.g.*, AIPLA's Model Patent Jury Instructions (2005); D. Del. Uniform Jury Instructions for Patent Cases (1993).

This burden sounds worse than it is; in plain English, "clear and convincing" simply means that the defendant must show that it is "highly probable" that the patent is invalid. See, *e.g.*, N.D. Cal. Model Patent Jury Instructions (2004) (using "highly probable" in lieu of "clear and convincing"); Federal Circuit Bar Association Model Patent Jury Instructions (same; also instructing that "clear and convincing" is not the same as proof "beyond a reasonable doubt"). However, effectively and convincingly explaining that the patent office is not infallible and that the jury (as non-experts) should second-guess its judgment is an important issue to a defendant asserting invalidity in front of a jury.

Defendants often turn to patent law experts to explain the practices and procedures of the patent office – and to make it clear that the patent office can make mistakes because of limited time and resources. However, such experts are increasingly finding a chilly reception in some district courts. See, *e.g.*, *Mineba Co. v. Papst,* U.S. Dist. LEXIS 11946, (D. D.C. June 21, 2005) (excluding patent law expert from testifying regarding practices and procedures of the patent office); *Syngenta Seeds Inc. v. Monsanto Co.*, U.S. Dist. LEXIS 18712 (D. Del. Sept. 8, 2004) (same).

These district courts are instead turning to a Federal Judicial Center video entitled "Introduction to the Patent System." See www.fjc.gov/public/home.nsf/pages/557. This 17-minute video was released by the Federal Judicial Center in October 2002 and is designed to be shown to jurors in patent trials, for example, during preliminary jury instructions. The Federal Judicial Center claims that "[s]pecial care was taken to ensure that [the video] provides an impartial and objective view of the patent process." However, since its release, this video has attracted criticism from litigants on both sides even while gaining acceptance from district judges.

The video is a combination of narration and dramatization. It contains several segments, generally covering: (1) what patents are; (2) invention and filing of a patent application; (3) parts of a patent application; (4) examination of a patent application in the patent office; (5) enforcement; (6) the defense of invalidity; (7) the jury's role; and (8) the differing burdens of proof for infringement and invalidity. A sample patent used in the video is also available for the jury's reference.

Quantitatively, the video devotes the largest share of its time to patent examination (about 5 ½ minutes). After that, the segments on invention and filing and the parts of a patent application are each given about 2 ½ minutes. The first segment covering what patents are and the "patent bargain" runs slightly longer (about 2 minutes) than the fifth segment about the defense of invalidity (about 1 ½ minutes). The remaining substantive segments are relatively brief (about 30 seconds each).

Qualitatively, the segments on invention and filing and examination are both dramatized via repeating characters — the inventor, her patent attorney and the patent examiner — acting out their respective roles behind descriptive narration. Even the segment on what patents are

is accompanied by stirring imagery: the U.S. Constitution, an official, ribboned copy of a patent and a montage of industrious scientists and archetypal inventions including Edison's light bulb and the Wright Brothers' plane. In contrast, the segments on the defense of invalidity, enforcement, the jury's role and the burdens of proof are primarily just the narrator.

Thus, criticism of the Federal Judicial Center video has focused largely on the imagery rather than the narration. Indeed, the actual narration is relatively non-controversial and similar explanations are found in patent-specific jury instructions. See, *e.g.*, N.D. Cal. Model Patent Jury Instruction A.1 (2004) ("What a patent is and how one is obtained"). For example, on the burden of proof segment, the video takes a middle road – it does not use the "clear and convincing" language that many patentees favor (rather it uses "highly probable"). However, it does explain that this higher burden is due to the fact that the patent office is presumed to have done its job correctly.

The imagery is more controversial. Both patentees and defendants can point to imagery in the video that is favorable to their position. For example, patentees can point to repeated shots showing conscientious, hard-working examiners and emphasize the extensive examination process illustrated in the video. Patentees can also point to the many favorable associations in the video to well-known inventors and inventions and other positive imagery.

Defendants, on the other hand, can point to the mounting piles of applications in the examiner's office and the scene of endless rows of files at the patent office (think "Raiders of the Lost Ark") with an implication that examiners are overwhelmed and overworked. The video even explains in showing this imagery that one of the reasons that the jury is asked to decide invalidity is that the patent office may make mistakes.

Some, nonetheless, perceive the video as creating a disadvantage for defendants through an extended and relatively favorable portrayal of patent office examination and only fleeting images of piles of files (there being no vivid imagery of the public being freed from improvidently granted patent monopolies). The video does devote substantial time to the process of examination – more than any other segment.

To be fair, the purpose of this extended segment is to explain a complicated process that many in the jury have no experience with – but which may be very relevant to the issues in dispute. However, the video's extended illustration on patent office examination can convey the impression that this process is more extensive than it was in a given case. Moreover, scenes showing the examiner carefully reviewing the specification and claims and searching prior art databases have the impact of visual dramatization. Qualifying information — for example, that an examiner may not have access to all the prior art or may only have limited time to spend on any one application — is often only narrated. While the video balances this with other content, a defendant confronts the relative cognitive impacts of narration versus actors' portrayals.

Finally, there is also some criticism surrounding what the video does not cover. As it is only intended as an introduction, the video does not comprehensively cover all defenses that can arise in a patent case. The jury would presumably be separately instructed on these defenses (and even on the defenses covered in the video). However, a defendant must overcome any implication in the jury's minds that omission from the video means that a defense lacks merit or requires more convincing proof.

Without explanation, the use of different media for instructing the jury on the background of the patent system could have the unintended effect of demoting the importance of other instructions. This is particularly of concern where a long (and often boring) list of jury instructions is delivered orally to the jury – jurors may not retain this information as well as they retain the video presentation, resulting in undue weight being given to the video.

Further, there is no guarantee that either a patentee or a defendant will be able to supplement the information in the video with testimony from a patent law expert - even though the video does not cover everything about the practices and procedures of the patent office. For example, in Minebea, the court found that testimony from a patent law expert on this topic would be irrelevant or cumulative. See *Minebea*; see also *Syngenta Seeds* ("I have determined that this video is a sufficient basis for instructing jurors").

This can have the effect of preventing a patentee or defendant from making an additional point about the examination process not covered in the video. For example, many defendants want the jury to understand how much time an examiner typically spends examining an application, a fact the video alludes to but does not address explicitly.

While courts are naturally drawn to neutral, approved sources for instructing juries on complex and contentious matters, finding ones that allow advocates to fairly present

the messages important to their cases can be challenging. The Federal Judicial Center video is a unique experiment in that the patent litigation bar played an important role in developing it and thus could recognize such issues. As experience with it increases, the patent system evolves, and issues with the Federal Judicial Center video or other sources come to light, courts and litigants will have to weigh their options carefully in choosing how to introduce the jury to the patent system.

Heather N. Mewes is an associate and **Darren E. Donnelly** is a partner in the litigation group at Fenwick & West in Mountain View.

If you have questions please contact:

Heather N. Mewes, Associate, Litigation Group
hmewes@fenwick.com, 415-875-2302

Darren E. Donnelly, Partner, Litigation Group
ddonnelly@fenwick.com, 650-335-7624