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Federal Circuit Upholds a Jury Instruction on Willfulness Despite Erroneous Portions That May Have Improperly Steered the Jury Away from a Willfulness Finding

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In the underlying district court litigation, the jury found that Defendant Adrian Rivera Maynez Enterprises, Inc. (ARM) infringed Eko's U.S. Patent No. 8,707,855 (the "'855 patent"). The jury did not, however, find ARM's infringement willful, thereby foreclosing Eko from obtaining an award of enhanced damages. Eko appealed the jury's finding of no willfulness, along with the district court's denial of enhanced damages based on the jury verdict.

On appeal, Eko argued that the district court's willfulness instruction—which tracked the Federal Circuit Bar Association's National Patent Jury Instruction No. 4.1—misstated the applicable standard, effectively inflating Eko's burden of proof. Specifically, Eko attacked two particular phrases contained in the instruction, which are shown in bold in the excerpted portion below:

. . . Willfulness requires you to determine whether Eko proved that it is more likely than not that the infringement was **especially worthy of punishment**. You may not determine that the infringement was willful just because ARM knew of the Eko 855 patent and infringed it. Instead, **willful infringement is reserved for egregious behavior**, such as where the infringement is malicious, deliberate, consciously wrongful, or done in bad faith. . . .

Eko asserted that these phrases improperly invited the jury not only to determine "the underlying factual question of whether the infringement was willful," but also "to make the legal decision as to whether damages should be enhanced, or whether it is an exceptional case."

Agreeing with Eko on this point, the Federal Circuit observed that under the Supreme Court's decision in *Halo Electronics, Inc. v. Pulse Electronics, Inc.*, 136 S. Ct. 1934 (2016), "the concept of 'willfulness' requires a jury to find no more than deliberate or intentional infringement." The Federal Circuit thus explained that "considerations of egregious behavior and punishment" bear only on the trial judge's assessment of whether to award enhanced damages (i.e., "once an affirmative finding of willfulness has been made") and "are therefore not appropriate for jury consideration."

Yet, despite agreeing that the phrases "reserved for egregious behavior" and "especially worthy of punishment" were erroneous "in isolation," the Federal Circuit upheld the instruction and denied Eko's appeal. The Federal Circuit explained that a party challenging jury instructions must prove that the instructions, when "read in their entirety," are "incorrect or incomplete." In turn, the court held that notwithstanding the two challenged phrases, the instruction "taken as a whole provide[d] reasonable clarity as to the correct test for willful infringement."

The Federal Circuit offered two reasons to support its holding. First, it highlighted other language in the instruction which, in its view, made clear "that willful infringement can simply be 'deliberate' infringement." In other words, the Federal Circuit believed the jury was properly "apprised that 'deliberate' behavior," by itself, can support a finding of willful infringement. Second, the Federal Circuit observed that the instruction included a list of factors for the jury to consider, specifically including "[w]hether or not ARM intentionally copied a product of Eko that is covered by the [] '855 patent," and "[w]hether or not ARM reasonably believed it did not infringe or that the patent was invalid." This "portion of the instruction," the Federal Circuit explained, "reasonably informed" the jury that intentional conduct likewise could support a finding of willfulness, without any heightened showing of "egregiousness."

The Federal Circuit ended its opinion with a cautionary note. The court observed that sustaining Eko's "limited" objection—which exclusively targeted the phrases "reserved for egregious behavior" and "especially worthy of punishment"—"would not have cured the problem that Eko identified," since the instruction still would have contained the terms "malicious," "consciously disregard" and "bad faith." And because the court found the instruction as a whole not legally erroneous, it declined to address whether the instruction harmed Eko. However, the court noted "that a legally erroneous jury instruction can only be harmless error if it could not have changed the result." This raises the possibility that, had Eko

raised a broader objection to the instruction, the court might have, at a minimum, reached the question of harmless error.

Practice Pointer: The *Eko Brands* decision demonstrates how important it is for litigants to carefully examine jury instructions, regardless of the source, and, and make all warranted objections. This is particularly true with respect to instructions on areas of the law—such as willfulness—that have undergone substantive changes or are still evolving. Failing to take such precautions leaves open the possibility of the trial judge giving a potentially erroneous instruction that, despite tipping the jury's deliberations in an adversary's favor, may be upheld on appeal.

Citation: *Eko Brands, LLC v. Adrian Rivera Maynez Enterprises, Inc.*, No. 2018-2215, 2018-2254 (Fed. Cir. Jan. 13, 2019) (Dyk, Reyna, and Hughes; opinion by Dyk)

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