

# MODEL JURY INSTRUCTIONS ON NONOBVIOUSNESS IN THE WAKE OF *KSR*: THE NORTHERN DISTRICT OF CALIFORNIA'S APPROACH

By Tolga S. Gulmen

Following the Supreme Court's decision in *KSR International Co. v. Teleflex Inc.*,<sup>1</sup> the Northern District of California's model patent jury instruction committee revised the jury instructions for nonobviousness.<sup>2</sup> The model jury instructions reflect the Court's reaffirmation that the determination of nonobviousness is a matter of law by recommending that the judge determine the ultimate question of nonobviousness based upon a jury's determination of the underlying facts. Towards that end, the model jury instructions suggest two alternative means. The first charges the jury to decide the factual underpinnings without addressing whether the patent was nonobvious. The second provides for an expanded role for the jury in deciding the issue of nonobviousness. However, under the Northern District's approach, the jury may only make a nonbinding advisory verdict freeing the trial judge to make the ultimate determination of nonobviousness irrespective of the jury's determination on the issue.

The Northern District's model jury instructions also reflect the Court's holding that the teaching-suggestion-motivation (TSM) test need not be satisfied for a determination of obviousness. In fact, the 2007 revision to the advisory verdict jury instructions suggests that the jury may find such a teaching or suggestion to motivate the combination of prior art, but finding a teaching or suggestion is not necessary. However, where the jury only makes factual determinations, all such language is removed from the jury instruction leaving it in the hands of the trial judge to make the necessary determination.

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1. 127 S. Ct. 1727 (2007).

2. Claudia Wilkin, *Model Patent Jury Instructions for the Northern District of California*, in DEVELOPMENTS IN PHARMACEUTICAL AND BIOTECH PATENT LAW 2008, at 335 (PLI Patents, Copyrights, Trademarks, & Literary Prop., Course Handbook Series No. 17180, 2008).