



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

***Novo Nordisk
A/S
v.
Becton
Dickinson &
Co.***

Nos. 01-1095
-1114
Federal Circuit
Sept. 19, 2002

*“[A]ppellate
tribunals are
not prohibited
from taking
remedial action
when it is
apparent that
prejudice or
unfairness
entered the
trial [but
counsel may
not wait until]
after a verdict
[to argue] for
the first time
. . . that the
comments to
the jury were
prejudicial.”*

On September 19, 2002, the Federal Circuit affirmed the district court’s judgment entering the jury verdict that all of the claims of U.S. Patents No. 5,462,535 and No. 5,999,323 are invalid on the ground of obviousness, and that U.S. Patent No. 5,984,906 is invalid based on same-invention double patenting and obviousness. The patented technology related to a pen-shaped insulin delivery system for use by diabetic patients. The Federal Circuit stated:

The jury concluded that the ‘535 and ‘323 patents are invalid on the ground of obviousness At the trial there were no significant disputes as to the facts of the scope and content of the prior art, the level of ordinary skill, and the nature of the claimed invention. The only question, argued to the jury, was that of motivation to combine the teachings of the references in order to produce the claimed device. . . . There was substantial evidence whereby a reasonable jury could have found that the known pain reduction provided the requisite motivation to narrow the needle. The jury verdict of obviousness is not vulnerable on this ground.

Novo seeks a new trial based on the district court’s refusal to include a jury instruction that “obvious to try” is not the correct legal standard for determination of obviousness. . . . While “obvious to try” is not a correct obviousness standard, there was extensive argument on the issue. We do not discern a “miscarriage of justice.” Taken as a whole, there was substantial evidence to support the jury verdict.

Novo states that Becton presented unduly prejudicial arguments, referring during its opening statement to patents as “monopolies” that raise the price to the public. Becton also told the jury that patent examiners are prone to error because they are overworked and inexperienced, and presented testimony to this effect. Novo states that these prejudicial statements require a new trial. Becton responds that Novo failed to object to these arguments during the trial, did not present neutralizing testimony, and did not request a curative instruction from the judge. In addition, the district court instructed the jury that Novo’s patents carried a presumption of validity, and that clear and convincing evidence of invalidity was needed to overcome that presumption.

Inflammatory insinuations and incorrect statements are improper, and their presentation to prejudice the jury is not condoned. The nature and context of prejudicial remarks warrant careful scrutiny. [O]n balance, we conclude that a new trial is not warranted in the circumstances that here prevailed, for the issues of examiner competence and of “monopoly” were not raised by post-trial motion; this inaction by Novo suggests that in the overall context of the two-week trial, these aspects were less inflammatory than Novo now maintains. Novo failed to object to any of the statements at trial, failed to ask for corrective jury instructions, and failed to raise the issue in post-trial motions. Although appellate tribunals are not prohibited from taking remedial action when it is apparent that prejudice or unfairness entered the trial and the interest of justice requires, “counsel for the defense cannot as a rule remain silent, interpose no objections, and after a verdict has been returned seize for the first time on the point that the comments to the jury were prejudicial.”