

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

CIENA CORPORATION and CIENA :
PROPERTIES, INC., :
 : Civil Action No. 00-662-JJF
Plaintiffs, :
 :
v. :
 :
CORVIS CORPORATION, :
 :
Defendant. :

William J. Marsden, Jr., Esquire and John T. Meli, Jr., Esquire
of FISH & RICHARDSON P.C., Wilmington, Delaware.
Of Counsel: Ruffin B. Cordell, Esquire, Michael J. McKeon,
Esquire, Joseph V. Colaianni, Jr., Esquire, and Lauren A. Degnan,
Esquire of FISH & RICHARDSON P.C., Washington, District of
Columbia.
Attorneys for Plaintiffs CIENA Corporation and CIENA Properties,
Inc.

Neal C. Belgam, Esquire and Dale R. Dube, Esquire of BLANK ROME
LLP, Wilmington, Delaware.
Of Counsel: George M. Sirilla, Esquire, Robert A. Gutkin,
Esquire, and Blair M. Jacobs, Esquire of PILLSBURY WINTHROP LLP,
McLean, Virginia.
Attorneys for Defendant Corvis Corporation.

OPINION

February 6, 2004

Wilmington, Delaware

Farnan, District Judge

Presently before the Court is the dispute of CIENA Corporation and CIENA Properties, Inc. (collectively "Ciena") and Corvis Corporation ("Corvis") over whether the Seventh Amendment guarantee of the right to a jury applies to Corvis's defense of the reverse doctrine of equivalents. For the reasons discussed, the Court concludes that it does not.

BACKGROUND

In 2001, Ciena filed a lawsuit alleging that Corvis infringed United States Patent Nos. 5,784,184 (the "'184 Patent"), 5,938,309 (the "'309 Patent"), 5,504,609 ("the '609 patent"), and 5,557,439 ("the '439 patent"). Corvis contested infringement of Ciena's patents and one of Corvis's defenses to infringement was the reverse doctrine of equivalents.

During trial on infringement, Ciena moved to have the reverse doctrine of equivalents issue resolved by the Court and not the jury. Corvis opposed removing the issue from the jury's province and contended that it had a Seventh Amendment right to have its reverse doctrine of equivalents defense decided by a jury. The Court concluded it had discretion as to whether the reverse doctrine of equivalents defense had to be tried to the jury or whether the Court could decide the issue. The jury rendered a verdict of infringement of the '309 patent, verdicts of non-infringement of the '184 patent and '439 patent, and was unable to come to a decision on the '609 patent.

The '609 patent was scheduled for a second trial. Before the commencement of the second trial, Ciena again moved to preclude jury consideration of Corvis's reverse doctrine of equivalents defense. The Court again removed the reverse doctrine of equivalents defense issues from jury consideration to be decided by the Court post trial. The jury in the second trial returned a partial verdict of literal infringement.

DISCUSSION

I. The Legal Standard for the Right to a Trial by Jury in Civil Cases

Under the Seventh Amendment of the Constitution, "[i]n Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved...." This right to a jury trial is a fundamental right governed by federal law. Simler v. Conner, 372 U.S. 221, 221-222 (1963).

Whether the guarantee of trial by jury extends to a particular issue depends on whether, historically, the issue would be tried in a court of law or equity. Newfound Management Corp. v. Lewis, 131 F.3d 108, 114 (3d Cir. 1997) (citing Parsons v. Bedford, Breedlove & Robeson, 28 U.S. 433, 446-7 (1830)). To make this determination, "[f]irst, [a court] compare[s] 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, [a court] examine[s] the remedy sought and determine[s] whether it is legal or equitable in nature." Tull v. United

States, 481 U.S. 412, 417-418 (1987) (citations omitted). "The second inquiry is the more important [] analysis." Chauffeurs, Teamsters and Helpers, Local No. 391 v. Terry, 494 U.S. 558, 565 (1990) (citing Granfinanciera, S.A. v. Nordberg, 492 U.S. 33, 42 (1989)).

II. Decision and Rational

While actions for patent infringement generally fall within the purview of the Seventh Amendment, not all issues related to infringement are guaranteed a jury determination. See Markman v. Westview Instruments, Inc., 517 U.S. 370, 377 (1996). An examination of the reverse doctrine of equivalents reveals that it is an issue that is not subject to the guarantees of the Seventh Amendment.

The reverse doctrine of equivalents can prevent infringement "where a device is so far changed in principle from a patented article that it performs the same or a similar function in a substantially different way, but nevertheless falls within the literal words of the claim." Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U.S. 605, 608-609 (1950). The reverse doctrine of equivalents is "an equitable doctrine" that was judicially created "to prevent unwarranted extension of the claims [of a patent] beyond a fair scope of the patentee's invention." Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1581 (Fed. Cir. 1991); see also Amgen Inc. v. Hoechst

Marion Roussel, Inc., 314 F.3d 1313, 1351 (Fed. Cir. 2003)

(stating that the reverse doctrine of equivalents “is equitably applied based upon underlying questions of fact”). Further, “[a]pplication of the doctrine requires that facts specific to the accused device be determined and weighed against the equitable scope of the claims, which in turn is determined in light of the specification, the prosecution history, and the prior art.” Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1581 (Fed. Cir. 1991).

It is clear to the Court that the reverse doctrine of equivalents seeks a remedy that is equitable in nature, and therefore, the Court concludes that a reverse doctrine of equivalents defense is grounded in the rules of equity and is not required to be submitted to a jury for decision. Thus, the issue of the applicability of the reverse doctrine of equivalents in this case can be decided by the Court and does not require trial to a jury.

An appropriate order will be entered.

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

CIENA CORPORATION and CIENA :
PROPERTIES, INC., :
 : Civil Action No. 00-662-JJF
Plaintiffs, :
 :
v. :
 :
CORVIS CORPORATION, :
 :
Defendant. :

O R D E R

At Wilmington, this 6 day of February 2004, for the reasons
discussed in the Opinion issued this date;

IT IS HEREBY ORDERED that:

- 1) Corvis Corporation's ("Corvis") application for a trial
by jury on its defense of the reverse doctrine of
equivalents is **DENIED**.
- 2) Corvis shall file its Opening Brief on the application
of the reverse doctrine of equivalents to relevant
issues in this case on February 17, 2004. CIENA
Corporation and CIENA Properties, Inc. (collectively
"Ciena") shall file its Answer Brief on February 24,
2004. No reply is permitted.

JOSEPH J. FARNAN, JR.
UNITED STATES DISTRICT JUDGE