Georgia State University Law Review

Volume 13
Issue 4 *July 1997*

Article 5

7-1-1997

Markman v. Westview Instruments, Inc.: The Jury's Diminishing Role in Patent Law Cases

Kevin W. King

MARKMAN V. WESTVIEW INSTRUMENTS, INC.: THE JURY'S DIMINISHING ROLE IN PATENT LAW CASES

INTRODUCTION

Are juries composed of lay persons capable of delivering proper verdicts in patent infringement lawsuits, which are often highly technical and complex? Those who believe the answer to this question is "no"[1] have recently found support in the United States Supreme Court. In *Markman v. Westview Instruments, Inc.*,[2] the Court unanimously held "that the construction of a patent, including the terms of art within its claim, is exclusively within the province of the court."[3] Others, however, argue that when a genuine factual dispute exists over the meaning of terms of art in a patent claim, a jury can and should, under the Seventh Amendment,[4] make the interpretation.[5]

This Comment will examine the *Markman* case and the problems associated with lay juries deciding technical and complicated issues, which are especially prevalent in patent infringement cases. Section I provides a brief historical look at the development of patent law as it relates to claim interpretation. Section II outlines the background of the *Markman* case and discusses the opinions of the Court of Appeals

---

1. *See, e.g., Franklin Pierce Law Center's Fifth Biennial Patent System Major Problems Conference*, 36 IDEA: J.L. & TECH. 443, 444-46 (1996) [hereinafter *Franklin Pierce Conference*] (Mr. Gholz: "The worst problem with the patent system in my opinion is juries in the patent system.").

2. 116 S. Ct. 1384 (1996).

3. *Id.* at 1387.

4. The Seventh Amendment provides: ". . . the right of trial by jury shall be preserved, and no fact tried by a jury shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law." U.S. CONST. amend. VII.

5. Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed. Cir. 1995) (en banc) (Mayer, J., concurring; Rader, J., concurring; Newman, J., dissenting); Pall Corp. v. Micron Separations, Inc. *Appeal Nos. 91-1393, -1394, -1409: Brief for* Amicus Curiae *Federal Circuit Bar Association*, 4 FED. CIRCUIT B.J. 1, 8 (1994) [hereinafter *F.C.B.A. Amicus Brief*]; Stanley L. Amberg, *Equivalents and Claim Construction: Critical Issues En Banc in the Federal Circuit, in* PATENT LAW PERSPECTIVES, 1994, at 713 (PLI Pat., Copyrights, Trademarks, & Literary Prop. Course Handbook Series, No. 396, 1994); Donald Zarley, *Jury Trials in Patent Litigation*, 20 DRAKE L. REV. 243, 250 (1971).

for the Federal Circuit and the Supreme Court. Section III discusses the impact of the *Markman* decision, and Section IV highlights some alternatives to address the perceived difficulty with using lay juries (and judges) in patent infringement trials.

I. BRIEF HISTORICAL OVERVIEW OF PATENT LAW JURISPRUDENCE

Jury trials in patent infringement cases were commonplace during the first century of the American patent system.[6] The 1853 Supreme Court decision in *Winans v. Denmead*[7] held that a patent claim language determination was a matter of law.[8] In 1869, the Court held in *Bischoff v. Wethered*[9] that, while documentary evidence was to be construed by the court, patent issues almost always needed extrinsic evidence to be resolved and therefore should be submitted to the jury with proper instructions.[10] However, in 1904, the Court decided *Singer Manufacturing Co. v. Cramer*,[11] holding that when "it is apparent from the face of the [patent] that extrinsic evidence is not needed to explain terms of art therein," infringement is a matter of law for the courts.[12]

The circuit courts did not uniformly apply Supreme Court precedent, although most ruled that patent claim interpretation was a question of law for the courts, as was the issue of infringement when extrinsic evidence was not required.[13] Some

6. Zarley, *supra* note 5, at 243.
7. 56 U.S. (15 How.) 330 (1853).
8. *Id.* at 338.
9. 76 U.S. (9 Wall.) 812 (1869).
10. *Id.* at 814-16.
11. 192 U.S. 265 (1904).
12. *Id.* at 275.
13. Zarley, *supra* note 5, at 249. Zarley's conclusion followed from an examination of pertinent cases from the circuit courts. *Id.* at 246-49 (citing Heide v. Panoulias, 188 F. 914, 916-17 (2d Cir. 1911) (finding that patent validity and infringement issues requiring extrinsic evidence for understanding were properly submitted to the jury); Vurroughs Adding Mach. Co. v. Rockford Milling Mach. Co., 292 F. 550, 554 (7th Cir. 1923) ("[W]here there is no dispute or doubt respecting the prior art the court may, and indeed should, as a matter of law, construe the claims in view of the uncontroverted and plain prior art."); Young v. Ralston-Purina Co., 88 F.2d 97, 101 (8th Cir. 1937) (holding that infringement is a question of law when no extrinsic evidence is needed to explain the patent's terms of art); Baldwin Rubber Co. v. Paine & Williams Co., 99 F.2d 1, 3 (6th Cir. 1938) (holding that patent claim construction was a question of law); New Wrinkle, Inc. v. John L. Armitage & Co., 277 F.2d 409, 412 (3d Cir. 1960) (holding that patent infringement was an issue of fact and that

of the circuits applied the *Singer* exception to issues of construction and not solely to the issue of infringement, holding that when extrinsic evidence is required for claim construction, the issue should be submitted to the jury.[14]

By the 1960s, jury trials in patent infringement cases had become almost nonexistent.[15] The cause of this trend, according to some scholars, appeared to be judicial disfavor of patents and uncertainty over what issues could actually be decided by the jury.[16]

By the 1970s, the nation's industrial leaders had become increasingly concerned that the constitutional goal of the patent system "[t]o promote the Progress of Science and useful Arts"[17] was not being achieved due to "the inconsistencies of judge-made law concerning patent rights and remedies."[18] To improve the patent system, Congress passed the Federal Courts Improvement Act of 1982, which created the U.S. Court of Appeals for the Federal Circuit (Federal Circuit) and gave it exclusive jurisdiction over patent related appeals from all district courts.[19] Since the Federal Circuit's beginning, the Supreme Court essentially has allowed the Federal Circuit to be the court of last resort in patent cases, because the Court has denied certiorari in almost all cases involving patent law.[20] Quite recently, however, the Supreme Court has shown a renewed interest in patent law,

---

construction of a claim was a question of law); Del Francia v. Stanthony Corp., 278 F.2d 745, 747 (9th Cir. 1960) (finding a patent similar to a contract and thus matters of claim construction are questions of law)).

14. *See* Zarley, *supra* note 5, at 246-49.

15. *Id.* at 243.

16. *Id.*

17. U.S. CONST. art. I, § 8, cl. 8.

18. Judge Pauline Newman, *The Federal Circuit: Judicial Stability or Judicial Activism?*, 42 AM. U. L. REV. 683, 685 (1993).

19. *See generally id.* at 684-86. Judge Newman stated that another coextensive purpose of the creation of the Federal Circuit was an experimental one: to test the suggested theory of employing a *national* court at the appellate level. *Id.* at 684.

20. Thomas K. Landry, *Certainty and Discretion in Patent Law: The On Sale Bar, the Doctrine of Equivalents, and Judicial Power in the Federal Circuit*, 67 S. CAL. L. REV. 1151, 1153 (1994). Landry asserted that the Supreme Court had only granted certiorari in patent cases in which patent *doctrine* was not at issue. *Id.* at n.8 (citing Cardinal Chem. Co. v. Morton Int'l, Inc. 508 U.S. 83 (1993) (holding that a non-infringement finding does not alone justify a court's refusal to issue a declaratory judgment on a patent's validity)). In *Cardinal Chemical*, Justices Souter and Scalia refused to join the majority opinion on an issue they characterized as "much less tied to general principles of law, with which [we are] familiar, and much more related to the peculiarities of patent litigation, with which [we] deal only sporadically." *Id.*

as it granted certiorari to the Federal Circuit in three patent cases last term.[21]

The body of Federal Circuit law is generally in accord with the Supreme Court's conclusion that patent claims construction is ultimately a question of law.[22] However, the Federal Circuit recognized the need for extrinsic evidence, such as expert testimony, to resolve reasonably disputed claim language.[23] In *Structural Rubber Products v. Park Rubber Co.*,[24] the Federal Circuit stated that, although claim interpretation was a matter of law for the court, "claim construction, dependent on resolution of a factual dispute, does present a jury question."[25]

II. *MARKMAN V. WESTVIEW INSTRUMENTS, INC.*

In this case, the Supreme Court upheld the en banc decision of the Federal Circuit, rejecting arguments raised in sharply worded dissenting and concurring opinions by two Federal Circuit judges. The Federal Circuit affirmed the district court reversal of a jury verdict finding that Westview Instruments, Inc. (Westview) had infringed claims of a United States patent issued to Herbert Markman (Markman).

A. *Background of the Case*

Markman is the inventor and owner of a patent for a computerized inventory control and reporting system for use in the clothes dry cleaning industry.[26] Markman alleged that Westview infringed three claims of his patent by manufacturing and selling a competing device that similarly utilized bar code technology to track invoices through a dry cleaning business.[27]

---

21. *See* Hilton Davis Chem. Co. v. Warner-Jenkinson Co., 62 F.3d 1512 (Fed. Cir. 1995) (en banc), *cert. granted*, 116 S. Ct. 1014 (1996); Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed. Cir.) (en banc), *cert. granted*, 116 S. Ct. 40 (1995); *In re* Lockwood, 50 F.3d 966 (Fed. Cir.), *cert. granted sub nom.* American Airlines, Inc. v. Lockwood, 115 S. Ct. 274 (1995).

22. *F.C.B.A. Amicus Brief, supra* note 5, at 2.

23. *Id.* at 3-7 (citing Moeller v. Ionetics, Inc., 794 F.2d 653, 657 (Fed. Cir. 1986); Fonar Corp. v. Johnson & Johnson, 821 F.2d 627, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1027 (1988) ("Expert testimony, including evidence of how those skilled in the art would interpret the claims, may also be used.")).

24. 749 F.2d 707 (1984).

25. *Id.* at 722 n.17 (citing McGill, Inc. v. John Zink Co., 736 F.2d 666, 672 (Fed. Cir.), *cert. denied*, 469 U.S. 1037 (1984)).

26. *Markman*, 52 F.3d at 971.

27. *Id.* at 971-73.

At the district court trial, Markman and a patent expert (a patent attorney) testified about the patent and explained the meaning of its claims.[28] Westview did not present any evidence regarding the meaning of the patent.[29]

The trial judge instructed the jury to "determine the meaning of the claims . . . using the relevant patent documents including the specifications, the drawings and the file histories."[30] Also, the jury was instructed that the meanings given to terms "must be of an ordinary and of a custom meaning unless it appears from the file history that the inventor used the terms differently."[31] The jury was then charged to compare the interpreted claims with Westview's device and determine whether the device infringed Markman's asserted patent claims.[32] The jury found that Westview's device infringed two of the three asserted patent claims.[33]

Next, the trial court heard argument on and granted Westview's motion for judgment as a matter of law (JMOL).[34] The court stated that patent claim construction was a matter of law for the court.[35] The issue of infringement ultimately depended upon the meaning assigned to the word "inventory" used in Markman's patent claims.[36] Markman asserted that "inventory" meant clothes or invoices or cash.[37] The court, however, interpreted "inventory" to mean only the articles of clothes passing through the dry cleaning establishment.[38] From this construction of the claims, the court concluded that Westview's device indisputably did not infringe.[39]

Markman appealed the district court's decision, arguing that the court erred in ruling that claims construction is exclusively a question of law because the jury should resolve factual disputes

---

28. *Id.* at 973.
29. *See id.*
30. *Id.*
31. Brian M. Martin, *Federal Circuit Limits Jury's Role in Patent Trials*, 77 J. PAT. & TRADEMARK OFF. SOC'Y 641, 642 (1995) (citing Markman Appellate Brief at 5).
32. *Markman*, 52 F.3d at 973.
33. *Id.*
34. *Id.*
35. *Id.*
36. *Id.* at 975.
37. *Id.* at 974.
38. *Id.* at 973.
39. *Id.*

about the meaning of claim terms.[40] Further, Markman contended that the trial court failed to give due deference to the jury and erred by substituting its own interpretation of the patent claims for the jury's interpretation.[41] In the Federal Circuit, an initial panel of three judges ordered *sua sponte* that the appeal be heard en banc after further briefings.[42]

B. The Opinion of the Federal Circuit

After providing the background of the case,[43] Chief Judge Archer, writing the en banc opinion for the Federal Circuit, first explained why patent claim construction is always an issue of law to be decided by the trial judge and reviewed *de novo*.[44] The court then outlined how the trial judge should construe patent claims, finding that the district court below did not err in construing the claim nor in granting the defendant's JMOL motion.[45] Next, the court responded to the concurring and dissenting judges' arguments that disputed (1) the holding as an alleged usurpation of the patentee's constitutional right to a jury trial, (2) the conclusion that statutory construction was a better analogy than contract interpretation in interpreting patent claims, and (3) the reading of Supreme Court decisions cited as authority for the court's holding.[46]

1. Claim Construction As a Question of Law

The *Markman* court stated that the Federal Circuit has historically held that claim construction is a question of law.[47] Acknowledging that some of its prior opinions, including Markman's cited authority, were inconsistent with that rule, the court expressly overruled all cases that deviated from its holding: "We therefore settle inconsistencies in our precedent and hold that in a case tried to a jury, the court has the power and

40. *Id.* at 974.
41. *Id.* at 973-74.
42. *Id.* at 970 n.1.
43. *Id.* at 971-73.
44. *Id.* at 976-79.
45. *Id.* at 979-81.
46. *Id.* at 984-89.
47. *Id.* at 976.

obligation to construe as a matter of law the meaning of language used in the patent claim."[48]

One of the cases Markman relied upon when arguing that the jury should decide the meaning of claim terms was *Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H.*[49] The *Markman* court traced the case law relied on in *Tol-O-Matic* and related authority back to the 1984 Federal Circuit decision *McGill, Inc. v. John Zink Co.*[50] The court then overruled *McGill* (and thus its progeny) because it had no proper authoritative basis, thus eliminating the authority on which Markman's appeal depended.[51]

The majority then listed a series of Supreme Court cases holding that "the construction of a patent claim is a matter of law exclusively for the court."[52] The court did not explain how each of the cited cases applied to *Markman* or other cases in which the meaning of patent claim language is genuinely disputed.

Next, the court reasoned, according to "a fundamental principle," that because a patent is a written instrument, it should be construed the same as other written instruments.[53] The court reasoned that because a patent is statutorily required to provide a clearly written description of the invention that will enable one skilled in the art to make and use it,[54] a patent is

---

48. *Id.* at 979.

49. 945 F.2d 1546, 1550 (Fed. Cir. 1991) (holding that "[i]nterpretation of . . . claim words . . . require[s] that the jury give consideration and weight to several underlying factual questions, including . . . [the patent specification], the intended meaning and usage of the claim terms by the patentee, . . . [the prosecution history], and the technological evidence offered by the expert witnesses").

50. 736 F.2d 666 (Fed. Cir. 1984).

51. *Markman*, 52 F.3d at 976-77. *McGill* held that if a claim term is disputed and extrinsic evidence is needed to explain it, then construction of the claim could be left to a jury. McGill, Inc. v. John Zink Co., 736 F.2d 666, 672 (Fed. Cir.), *cert. denied*, 469 U.S. 1037 (1984) (citing Envirotech Corp. v. Al George, Inc., 730 F.2d 753 (Fed. Cir. 1984)). However, the *Markman* court states that *Envirotech* instead stated that "[t]he patented invention as indicated by the language of the claims must first be defined (*a question of law*), and then the trier must judge whether the claims cover the accused device (a question of fact)." *Markman*, 52 F.3d at 976 (citing *Envirotech*, 730 F.2d at 758).

52. *Markman*, 52 F.3d at 977 (citing Silsby v. Foote, 55 U.S. (14 How.) 218 (1853); Winans v. Denmead, 56 U.S. (15 How.) 330 (1853); and Bischoff v. Wethered, 76 U.S. (9 Wall.) 812 (1870)).

53. *Id.* at 978 (citing Levy v. Gadsby, 7 U.S. (3 Cranch) 180, 186 (1805) ("[T]he construction of a written evidence [a contract] is exclusively with the court.")).

54. 35 U.S.C. § 112, ¶ 1 (1988).

"uniquely suited for having its meaning and scope determined entirely by a court as a matter of law."[55]

The *Markman* court's conclusion does not explain *why* the descriptive requirement mandates that a patent claim be exclusively interpreted by the court. The court appears to believe claims drafted to satisfy the statutory requirements cannot have terms that are subject to reasonably differing interpretations—a factual matter. It seems unlikely that every patent claim is either invalid or interpretable in only one reasonable manner.[56]

In *Markman*, the Federal Circuit reasons that claim construction by judges promotes fairness because it allows competitors to reasonably ascertain the extent to which patent claims exclude others.[57] The court declared that

> competitors should be able to rest assured, if infringement litigation occurs, that a judge, trained in the law, will similarly analyze the text of the patent and its associated public record and apply the established rules of construction, and in that way arrive at the true and consistent scope of the patent owner's rights to be given legal effect.[58]

These assertions of the court are highly questionable. First, when a genuine dispute about the meaning of a claim term exists, litigation will be required for resolution whether a judge or jury interprets the patent claim; a competitor's knowledge of that claim's limits is not enhanced merely because a court interpreted it rather than a jury.[59] Second, the court failed to explain why judge-interpreted claims are more consistent than jury-interpreted ones. The assertion of consistency is, at best, tenuous, if comparing district court judges. Perhaps the court is suggesting that greater consistency in claims interpreted by a court is achieved because such issues are appealable to the Federal Circuit and reviewed *de novo*.[60]

---

55. *Markman*, 52 F.3d at 978 (citing Bates v. Coe, 98 U.S. 31, 38 (1879) ("[T]he claims of the patent, like other provisions in writing, must be reasonably construed. . . .")).

56. *See* Autogiro Co. of America v. United States, 384 F.2d 391, 396 (Ct. Cl. 1967) ("The very nature of words would make a clear and unambiguous [patent] claim a rare occurrence.").

57. *Markman*, 52 F.3d at 978.

58. *Id.* at 979.

59. Amberg, *supra* note 5, at 17.

60. However, that does not eliminate differences of opinion between different panels of the Federal Circuit. *See infra* notes 171-72 and accompanying text. Additionally,

2. *Tools of Construction and the Case Merits*

The *Markman* court reiterated that judges should consult three primary sources to construe claims: the claims, the patent specification, and the prosecution history (the application file at the Patent and Trademark Office).[61] The Federal Circuit, in *Markman*, also reaffirmed the value of expert testimony in proper claim construction.[62] However, the court stated that extrinsic evidence should be used only to enhance the court's understanding of the patent claim terms, not to vary or contradict those terms.[63] This rule of construction has two primary weaknesses. First, expert witness testimony and credibility are traditionally regarded as issues of fact for the jury.[64] Chief Judge Archer attempted to evade this criticism by urging that he was "*not* crediting certain evidence over other evidence or making factual evidentiary findings. Rather, [he was] looking to the extrinsic evidence to assist in [his] construction of the written document . . . ."[65] Second, in order to decide whether extrinsic evidence contradicts a claim term, it is necessary to know what that claim term means. Therefore, when the claim term at issue is reasonably subject to varying interpretations (in light of the claims, the patent specification, and the prosecution history) such an analysis is inherently problematic, because one cannot decide if the claim term conflicts with the extrinsic evidence when the term meaning is unclear.

The court also conducted a *de novo* review of the Markman patent, its prosecution history, and the extrinsic evidence.[66] The court rejected Markman's expert testimony and that of his patent attorney as "no more than legal opinion."[67] It agreed with the district court's interpretation of "inventory," finding that this claim term means only articles of clothing.[68]

---

some scholars have expressed concern over the promotion of judicial certainty in patent law by the concentration of discretion and power in the Federal Circuit. *See* Landry, *supra* note 20; Newman, *supra* note 18.

61. *Markman*, 52 F.3d at 979.
62. *Id.*
63. *Id.* at 980-81.
64. Martin, *supra* note 31, at 645.
65. *Markman*, 52 F.3d at 981.
66. *Id.* at 979-83.
67. *Id.* at 983.
68. *Id.* at 982-83.

It is puzzling that the district court or the Federal Circuit did not reach the non-infringement result through application of Rule 50 of the Federal Rules of Civil Procedure in granting the JMOL motion. Rule 50 states that if "there is no legally sufficient evidentiary basis for a reasonable jury to find for that party on that issue, the court may determine the issue. . . ."[69] It appears that either the district court or Federal Circuit could have easily found the Markman testimony to be legally insufficient for a reasonable jury.[70]

3. *The Court's Response to the Dissent and Concurrence*

Chief Judge Archer addressed the Seventh Amendment arguments presented by the concurring and dissenting opinions.[71] He concluded that "[t]he patentee's right to a jury trial on the application of the properly construed claim to the accused device is preserved as it was in 1791."[72] The majority indicated that the party and amicus briefs, as well as the dissenting and concurring opinions, did not cite any case supporting the argument that patent claim interpretation was a jury triable issue before 1791. This result, however, is probably because the present patent law system is different than the English system of that time.[73]

The court then attempted to explain why arguments analogizing claims construction to the interpretation of contracts, deeds, and wills were misplaced.[74] Those arguments generally assert that the interpretation of patent claims, although a question of law, may involve issues of fact like other written legal instruments and need extrinsic (parol) evidence in order to be resolved.[75] The majority reasoned that the analogy was not useful in a patent infringement trial because the alleged infringer is never a party to the "contract," which is an exchange

69. FED. R. CIV. P. 50.

70. *See* Martin J. Adelman, *En Banc on Claim Construction and Equivalents, in* PATENT LAW PERSPECTIVES, 1994, at 681 (PLI PAT., COPYRIGHTS, TRADEMARKS, & LITERARY PROP. COURSE HANDBOOK SERIES, No. 396, 1994).

71. *Markman*, 52 F.3d at 984-88. The Seventh Amendment, ratified in 1791, states: "In Suits at common law . . . the right of trial by jury shall be preserved . . . ." U.S. CONST. amend. VII.

72. *Id.* at 984.

73. *Id.*

74. *Id.* at 984-85.

75. *Id.* at 985.

between the patentee and the federal government.[76] Also, any extrinsic evidence, which is used to prove a party's intent, is not useful in a patent case because the inventor's subjective intent in using a particular claim term could be different from the intent of the patent attorney who drafted the claim at issue.[77] The court stated that the statutory requirement that claims be drafted in "full, clear, concise, and exact terms" along with the patent examiners' review effectively eliminate any ambiguity that would require the court to resort to extrinsic evidence in order to construe a valid patent claim.[78] Again, the Federal Circuit appears to believe there is no possibility of reasonably differing interpretations of claim terms by those skilled in the art. The court also overlooks the dynamic nature of language: a clear term may develop a different or additional meaning over time.[79]

The *Markman* court also concluded that statutory interpretation was an appropriate analogy to patent claim interpretation.[80] The court reasoned that statutes, like patents, were enforceable against the public, which is presumed to be aware of both.[81] Contracts, on the other hand, are usually only enforceable against the contracting parties.[82] Additionally, the Federal Circuit determined that the court should construe both statutes and patents because they could be construed in light of their respective public records: the legislative history of statutes and the prosecution history of patents.[83] Following this analogy, the court stated that because congressional members do not testify about a particular statutory construction, a patentee's

76. *Id.* A patent is described as a grant of a limited monopoly to the patentee in exchange for public disclosure of the invention. *See id.*

77. *Id.*

78. *Id.* at 986. The court again asserted that extrinsic evidence is allowed for the purpose of informing the court about the particular technical subject matter and language used by those skilled in the art, but not for clarifying ambiguity. *Id. Cf.* Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1584 (Fed. Cir. 1996) ("No doubt there will be instances in which intrinsic evidence is insufficient to enable the court to determine the meaning of the asserted claims, and in those instances, extrinsic evidence . . . may also properly be relied on to understand the technology and to construe the claims.").

79. *See generally* Frank H. Easterbrook, *Text, History, and Structure in Statutory Interpretation*, 17 HARV. J.L. & PUB. POL'Y 61 (1994) (observing that the meaning and purpose of words change with their context and over time).

80. *Markman*, 52 F.3d at 987.

81. *Id.*

82. *Id.*

83. *Id.*

ascribed meaning of the claim language is similarly not determinative.[84]

Lastly, the court distinguished the two Supreme Court cases, *Silsby v. Foote*[85] and *Bischoff v. Wethered*,[86] upon which the dissenting and concurring opinions relied for authority that questions of fact may occur in the determination of a patent claim's scope.[87] The majority urged that *Silsby* was no longer applicable law because "[t]he only jury-triable issue described in *Silsby* on the question of claim scope is now statutorily foreclosed."[88] The court distinguished *Bischoff* by stating that it "did not even involve an infringement issue."[89] The Federal Circuit further observed that the case did not entail claim interpretation;[90] instead it involved distinguishing between the patent in suit and a prior art patent to determine if the patent in suit was valid.[91]

C. *Judge Mayer's Concurring Opinion*

Judge Mayer strongly expressed his disagreement with the majority, stating that "the court jettisons more than two hundred years of jurisprudence and eviscerates the role of the jury preserved by the Seventh Amendment. . . ."[92] He characterized the majority opinion as part of the quest of several Federal Circuit judges to "free patent litigation from the unpredictability of jury verdicts, and generalist judges, result[ing] from insular dogmatism inspired by unwarranted elitism."[93]

Contrary to the majority, Judge Mayer observed that many Federal Circuit cases support allowing the jury to determine "underlying factual issues" in connection with interpreting a term

---

84. *Id.*

85. 55 U.S. (14 How.) 218 (1852).

86. 76 U.S. (9 Wall.) 812 (1869).

87. *Markman*, 52 F.3d at 987-88.

88. *Id.* at 988. The Court in *Silsby* held that a jury was to determine the "essential" element, which was required to produce the desired result, in a combination patent claim. 35 U.S.C. § 112 now requires that all material elements of a patent be disclosed in the claim. Thus, a patent is not valid unless the essential elements are described—a threshold issue to be resolved before claim construction. *Id.*

89. *Id.*

90. *Id.* "It is not the *construction of the instrument*, but the *character of the thing invented*, which is sought . . . ." *Bischoff*, 76 U.S. at 816 (emphasis in original).

91. *Markman*, 52 F.3d at 988.

92. *Id.* at 989.

93. *Id.* (internal quotation omitted).

of a patent claim.[94] Judge Mayer cited a string of cases in which the Federal Circuit had recognized jury-triable factual inquiries underlying the interpretation of patent claim language,[95] and he stated that the majority "pretends there is a line of contrary authority."[96]

Next, Judge Mayer stressed that the majority's opinion is contrary to the Seventh Amendment right to jury determination of factual issues, and creates a "complexity exception" to the Seventh Amendment's guarantee.[97] In rebuttal to the majority's statement about the lack of pre-1791 precedent supporting jury determination of patent claims, Judge Mayer argued that the Seventh Amendment right is not limited to jury rights as in 1791 common law cases, but "extends as well to statutory actions subsequently created by Congress if they are analogous to actions decided in the law courts of eighteenth century England."[98] According to Mayer, because "the ultimate question of infringement, indisputably a matter for the jury, is effectively dictated by the construction given the patent claims," the court should be particularly suspicious of this curtailment of the right to a jury trial.[99] Judge Mayer criticized the majority for subverting "the Seventh Amendment by the ruse of reclassifying factual questions as legal ones."[100]

Judge Mayer subsequently urged that the Supreme Court has "unmistakably left it to the jury" to interpret the meaning of patent claims.[101] He claimed that the Supreme Court cases

---

94. *Id.* at 990 (citing Arachnid, Inc. v. Medalist Mktg. Corp., 972 F.2d 1300, 1302 (Fed. Cir. 1992); Lemelson v. General Mills, Inc., 968 F.2d 1202, 1206 (Fed. Cir. 1992); Tol-O-Matic, Inc. v. Proma Produkt-Und Mktg., 945 F.2d 1546, 1552 (Fed. Cir. 1991); Johnston v. IVAC Corp., 885 F.2d 1574, 1579 (Fed. Cir. 1992); Moeller v. Ionetics Inc., 794 F.2d 653 (Fed. Cir. 1986); McGill, Inc. v. John Zink Co., 736 F.2d 666, 675 (Fed. Cir. 1984)).

95. *Id.* "A disputed issue of fact may, of course, arise in connection with interpretation of a term in a claim if there is a genuine evidentiary conflict created by the underlying probative evidence pertinent to the claim's interpretation. However, without such evidentiary conflict, claim interpretation may be resolved as an issue of law by the court . . . ." *Id.* at 990 (quoting *Johnston*, 885 F.2d at 1579).

96. *Id.* at 990 n.2. Mayer argues that those cases cited by the majority did not involve genuine factual disputes and were merely examples of claims suitable for interpretation by the court using only the patent documents. *Id.*

97. *Id.* at 992-93.

98. *Id.* at 992 (citing Tull v. United States, 481 U.S. 412, 417 (1987)).

99. *Id.* at 993.

100. *Id.*

101. *Id.* at 995 (citing Winans v. Denmead, 56 U.S. (15 How.) 330 (1853)).

cited by the majority "simply d[id] not address the effect of extrinsic evidence giving rise to a legitimate fact question. They are cases [in which] the documentary record alone was wholly adequate to derive the patent's proper construction."[102]

Mayer concurred in the *Markman* result because this was a case that "presented no real factual question."[103] Judge Mayer cited *Singer Manufacturing Co. v. Cramer*[104] for Supreme Court authority holding "that where extrinsic evidence is required and raises a real factual dispute, the question is no longer one of 'pure construction,' so that the jury must play its role in the construction of the claims."[105] He believed that *Markman* did not present such a situation.

Judge Mayer reasoned that while the ultimate interpretation of patent claims is, like that of a contract or deed, a matter of law, uncertain terms are to be left to the jury to construe in light of extrinsic evidence.[106] Judge Mayer offered *Bischoff v. Wethered*[107] as additional authority holding that although construction of documentary evidence was normally the province of the court, patents often involve terms of art outside the court's understanding, and accordingly require resort to extrinsic evidence evaluated by the jury for resolution.[108]

D. Judge Rader's Concurring Opinion

Judge Rader concurred in the result because "the claims, specification, and prosecution history irrefutably show that cash transaction totals are 'not inventory.' "[109] Moreover, the record "lack[ed] substantial evidence supporting Markman's asserted claim interpretation."[110] Judge Rader reasoned that the district court therefore correctly granted the JMOL motion.[111]

---

102. *Id.* at 994 (referring to Winans v. New York & Erie R.R. Co., 62 U.S. (21 How.) 88, 100 (1858); Brown v. Piper, 91 U.S. 37, 41 (1875)).
103. *Id.*
104. 192 U.S. 265 (1904).
105. *Markman*, 52 F.3d at 994. Mayer also cited Market St. Cable Ry. v. Rowley, 155 U.S. 621, 625 (1894), and Heald v. Rice, 104 U.S. 737, 749 (1881), as support. *Id.*
106. *Id.* at 997-98.
107. 76 U.S. (9 Wall.) 812 (1869).
108. *Markman*, 52 F.3d at 996-97 (citing *Bischoff*, 76 U.S. (9 Wall.) at 815-16).
109. *Id.* at 998.
110. *Id.*
111. *Id.*

Judge Rader concluded by calling the majority's "extensive examination of subsidiary fact issues . . . dicta."[112] He stated that "[w]hether claim construction can involve subsidiary fact issues" was not before the court because it did not matter whether the issue was fact or law.[113]

E. Judge Newman's Dissenting Opinion

Judge Newman criticized the full court for its decision: "the majority . . . denies 200 years of jury trial of patent cases in the United States . . . by simply calling a question of fact a question of law. The Seventh Amendment is not so readily circumvented."[114] She asserted that the decision is clearly contrary to past Federal Circuit decisions and that in the overruled cases, claim interpretation could not reasonably be conducted by the court as a matter of law.[115]

1. Questions of Fact and Law in Patent Cases

Judge Newman began her analysis by distinguishing between legal "construction" and factual "interpretation" of written evidence.[116] She acknowledged that in the legal construction of a patent, the court is to "establish the metes and bounds of the patent right to exclude" as a matter of law.[117] Judge Newman asserted, however, that the interpretation of the patent's underlying facts—found in, for example, the patent specification, prior art, the prosecution history, and expert testimony—is a question of fact for the jury.[118] She supported these rules of patent construction and interpretation by analogizing them to the treatment of other written instruments, such as wills, deeds,

---

112. *Id.*
113. *Id.*
114. *Id.* at 1000.
115. *Id.* at 1017-20 (analyzing McGill, Inc. v. John Zink Co., 736 F.2d 666 (Fed. Cir. 1984); Moeller v. Ionetics, Inc., 794 F.2d 653 (Fed. Cir. 1986); Tol-O-Matic, Inc. v. Proma Produkt-Und Mktg. Gesellschaft m.b.H., 945 F.2d 1546 (Fed. Cir. 1991)).
116. *Id.* at 1000-01. Judge Newman stated that "the words 'construction' and 'interpretation' have been loosely used, [but] the distinction between the concepts has been recognized when it mattered." *Id.* at 1001. She also found support in the Restatement (Second) of Contracts: "Interpretation of a promise or agreement or a term thereof is the ascertainment of its meaning. Interpretation is not a determination of the legal effect of words or other conduct." *Id.* at 1000-01 (quoting RESTATEMENT (SECOND) OF CONTRACTS § 200 & cmt. c (1981)).
117. *Id.* at 1000.
118. *Id.*

contracts, and insurance policies.[119] The dissenting judge found no reason to treat factual disputes in patent cases differently than in other contexts.[120]

Judge Newman elaborated on the evidence that was relevant to claim interpretation.[121] She stated that the *Markman* dispute about the meaning of "inventory" should have been resolved by the jury using such evidence as the patent specification and expert testimony.[122] She reasoned that because these sources of evidence often produce questions of fact traditionally resolved by juries, the majority was wrong to hold that evaluation of claim interpretation evidence is reserved exclusively to the court.[123]

Judge Newman reasoned that the meaning of "inventory" in the *Markman* case was a fact, not a law, in the true, legal definition of the terms "fact" and "law."[124] She stated that "[t]he law is a general proposition, while the fact is a case specific inquiry."[125] In *Markman*, Judge Newman asserted, "the meaning of 'inventory' is specific to this invention, this patent,

---

119. *Id.* at 1000-01.

> In the law of contracts . . . a proper distinction exists between the "interpretation" of written instruments and their "construction." "Interpretation" refers to the process of determining the meaning of the words used; that process is traditionally thought to be a function of the jury. On the other hand, the process of determining the legal effect of the words used—once we know their meaning—is properly labeled "construction;" it is peculiarly a function of the court.

Williams v. Humble Oil & Ref. Co., 432 F.2d 165, 179 (5th Cir. 1970), *cert. denied*, 402 U.S. 934 (1971).

120. *Markman*, 52 F.3d 967, 1001 (Fed. Cir. 1995).

121. *Id.* at 1002-08.

122. *Id.* Judge Newman addressed the patent specification, prior art, the prosecution history, technologic/scientific facts, and the testimony of experts. *Id.* She cited cases in which the Federal Circuit or Supreme Court held that a jury was to resolve a dispute involving those types of evidence. *Id.* (citing Perini America, Inc. v. Paper Converting Mach. Co., 832 F.2d 581 (Fed. Cir. 1987) (the specification); Graham v. John Deere Co., 383 U.S. 1 (1966) (prior art); Smithkline Diagnostics, Inc. v. Helena Lab. Corp. 859 F.2d 878 (Fed. Cir. 1988) (prosecution history); Moeller v. Ionetics, Inc., 794 F.2d 653 (Fed. Cir. 1986) (expert testimony)).

123. *Id.* at 1007 (citing Sartor v. Arkansas Natural Gas Corp., 321 U.S. 620, 628 (1944) (stating the weight and credibility of a witness' testimony "belongs to the jury. . . .") (quoting Aetna Life Ins. Co. v. Ward, 140 U.S. 76 (1891)).

124. *Id.* at 1008-10 (extrapolating from Francis H. Bohlen, *Mixed Questions of Law and Fact*, 72 U. PA. L. REV. 111 (1924)); Martin B. Louis, *Allocating Adjudicative Decision Making Authority Between the Trial and Appellate Levels: A Unified View of the Scope of Review, the Judge/Jury Question, and Procedural Discretion*, 64 N.C. L. REV. 993 (1986); Clarence Morris, *Law and Fact*, 55 HARV. L. REV. 1303 (1942); BLACK'S LAW DICTIONARY 591-92 (6th ed. 1990)).

125. *Id.* at 1009.

this claim, this system, this defendant. [Thus, i]ts determination is for the trier of fact."[126]

2. *The Seventh Amendment Jury Right*

Judge Newman stated that the *Markman* majority opinion was contrary to the Seventh Amendment's guarantee of the right to a jury trial.[127] She reasoned that it was the Federal Circuit's duty to uphold this right in patent cases as in all others, regardless of the perceived "relative capabilities of a jury and the Federal Circuit in finding technologic facts in patent cases. . . ."[128]

After reviewing the English law and that country's use of juries in patent cases prior to the adoption of the Seventh Amendment, Judge Newman concluded that patent actions at law were invariably tried to a jury.[129] Newman stated that the United States has continued to preserve the jury trial right up to the present.[130] The Supreme Court has not, she emphasized, limited the jury right to its 1791 scope: "Although the thrust of the [Seventh] Amendment was to preserve the right to jury trial as it existed in 1791, it has long been settled that the right extends beyond the common-law forms of action recognized at that time."[131] The express purpose of Judge Newman's historical review was to demonstrate the *Markman* court's striking departure from precedent, in holding that "the Seventh Amendment no longer applies because there are now 'claims' in United States patents, whereas the old English patents did not have claims as we know them."[132]

---

126. *Id.* at 1010.

127. *Id.* at 1010-17.

128. *Id.* at 1010-11 (citing Walker v. New Mexico & S. Pac. R.R., 165 U.S. 593, 596 (1897) ("The Seventh Amendment . . . requires that questions of fact in common law actions shall be settled by a jury, and that the court shall not assume directly or indirectly to take from the jury or to itself such prerogative."); Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1547 (Fed. Cir. 1983) ("So long as the Seventh Amendment stands, the right to a jury trial should not be rationed, nor should particular issues in particular types of cases be treated differently from similar issues in other types of cases.").

129. *Id.* at 1011-15.

130. *Id.* at 1015.

131. *Id.* (quoting Curtis v. Loether, 415 U.S. 189, 193 (1974)).

132. *Id.* at 1016. Judge Newman added that the old English patent required that inventions be "particularly described," similar to current United States requirements that patent specifications "conclude with . . . claims particularly pointing out and distinctly claiming the subject matter" of the invention. *Id.* at 1016-17 (quoting 35 U.S.C. § 112, ¶ 2 (1995)). Thus, according to Judge Newman, the majority's argument

3. *Precedent Contrary to the Majority's Holding*

Judge Newman analyzed each of the Federal Circuit cases expressly overruled by the majority, highlighting the disputed technical terms, which, if decided under the *Markman* rule, a district court or the Federal Circuit (under *de novo* review) would have to construe as a matter of law.[133] For example, in *McGill, Inc. v. John Zink Co.*,[134] the disputed patent claim term was "recovered liquid hydrocarbon absorbent."[135] The meaning attributed to that term by the parties essentially determined whether there was infringement.[136] Judge Newman appears to point out the dubious nature of calling such interpretations questions of law, as the majority implicitly does.

Judge Newman stated that other Federal Circuit cases besides those explicitly overturned in *Markman* supported allowing the jury to determine the meaning of patent claims limiting Federal Circuit review of those disputes to the clearly erroneous standard.[137] In discussing the *de novo* review of disputed facts, she noted that "[a]lthough some *amici curiae* encouraged the Federal Circuit to find technological facts [itself], none explained the procedure by which [the Federal Circuit is] to do so[,]"[138] especially with page-limited briefs and fifteen minutes of argument per side.[139]

---

that changes in patent specificity requirements over time is not sufficient to warrant the removal of juries from patent infringement cases. *Id.* at 1017.

133. *Id.* at 1017-20 (discussing Tol-O-Matic, Inc. v. Proma Produkt-Und Mktg. Gesellschaft m.b.H., 945 F.2d 1546 (Fed. Cir. 1991); Perini America, Inc. v. Paper Converting Mach. Co., 832 F.2d 581 (Fed. Cir. 1987); H.H. Robertson Co. v. United Steel Deck, Inc., 820 F.2d 384 (Fed. Cir. 1987); Moeller v. Ionetics, Inc., 794 F.2d 653 (Fed. Cir. 1986); Palumbo v. Don-Joy Co., 762 F.2d 969 (Fed. Cir. 1985); Bio-Rad Labs, Inc. v. Nicolet Instrument Corp., 739 F.2d 604 (Fed. Cir. 1984); McGill, Inc. v. John Zink Co., 736 F.2d 666 (Fed. Cir. 1984)).

134. 736 F.2d 666 (Fed. Cir. 1984).

135. *Markman*, 52 F.3d at 1017.

136. *Id.* at 1017-18.

137. *Id.* at 1020-21 (citing Snellman v. Ricoh Co., 862 F.2d 283 (Fed. Cir. 1988), *cert. denied*, 491 U.S. 910 (1989); Tandon Corp. v. United States Int'l Trade Comm'n, 831 F.2d 1017 (Fed. Cir. 1987); Data Line Corp. v. Micro Tech., Inc., 813 F.2d 1196 (Fed. Cir. 1987)).

138. *Id.* at 1021 n.11.

139. *Id.*

4. *The Majority's Erroneous Use of Supreme Court Authority*

Judge Newman examined the Supreme Court authority cited by the majority and discussed how the majority misreads the cases.[140] She asserted that most of those cases do not mean that courts *always* interpret patent claims as a matter of law; instead the cases preclude jury construction *only* when no factual issue is reasonably in dispute.[141] Judge Newman's reading of the cases appears to be more persuasive. For example, she quoted a greater portion of the *Bischoff v. Wethered* opinion than the *Markman* majority, and therefore revealed *Bischoff* more fully and showed that the *Bischoff* Court's language contradicted the majority's reading of that Supreme Court case.[142] The *Bischoff* Court definitely appears to hold that disputed terms of art in a patent are questions of fact for the jury.[143] Judge Newman also noted that some of the majority's cited cases were bills in equity, not actions at law, and clearly did not involve the issue of the jury right.[144]

5. *The Merits of the* Markman *Case*

Judge Newman stated that the "district court did not apply the proper standards on post trial motions."[145] She concluded that the case should have been remanded for determination as to

---

140. *Id.* at 1021-24.

141. *Id.* (citing Coupe v. Royer, 155 U.S. 565 (1895); Bischoff v. Wethered, 76 U.S. (9 Wall.) 812 (1870); Winans v. Denmead, 56 U.S. (15 How.) 330 (1854); Silsby v. Foote, 55 U.S. (14 How.) (1853); Levy v. Gadsby, 7 U.S. (3 Cranch) 180 (1805)).

142. *Id.* at 1022-23.

> A case may sometimes be so clear that the court may feel no need of an expert to explain the terms of art or the descriptions contained in the respective patents, and may, therefore, feel authorized to leave the question of identity to the jury, under such general instructions as the nature of the documents seems to require. And in such plain cases the court would probably feel authorized to set aside a verdict unsatisfactory to itself, as against the [greater] weight of the evidence. But in all such cases *the question would still be treated as question of fact for the jury, and not as question of law for the court.*

Id. (quoting *Bischoff*, 76 U.S. (9 Wall.) at 814 (emphasis added by Newman)).

143. *Id.* at 1022. Newman also cited Tucker v. Spalding, 80 U.S. (13 Wall.) 453 (1872), in which the Court described the issue of patent identity as "a mixed question of law and fact" that was required to be submitted to the jury with instructions from the court to guide them. *Id.* at 1023 (quoting *Tucker*, 80 U.S. at 455).

144. *Id.* at 1024 (citing, e.g., Exhibit Supply Co. v. Ace Patents Corp., 315 U.S. 126 (1942) (involving no dispute of technical terms)).

145. *Id.* at 1026.

whether there was "substantial credible evidence [from which] a reasonable jury could have reached the verdict."[146]

F. The Supreme Court Opinion

Justice Souter wrote the unanimous opinion for the Court.[147] The Court first analyzed whether the Federal Circuit's decision was proper under the Seventh Amendment and concluded that it did not require a jury to decide the meaning of claim terms.[148] The Court then found that its own precedent did not compel a contrary conclusion.[149] Finally, the Court turned to so-called "functional considerations" to address the specific issue, because history and precedent provided no clear answer.[150]

1. The Seventh Amendment Analysis

The Court relied on a "historical test," which asks (1) whether the cause of action in question was either "tried at law at the time of the Founding or is at least analogous to one that was," and if so, then (2) "whether the particular trial decision must fall to the jury in order to preserve the substance of the common-law right as it existed in 1791."[151] First, the Court quickly concluded that "there is no dispute that infringement cases today must be tried to a jury, as their predecessors were more than two centuries ago."[152]

Next, the Court sought to find an appropriate analogy between modern claim construction and historical patent practice, since "prior to 1790 nothing in the nature of a claim had appeared either in British patent practice or in that of the American states."[153] The closest analogy, according to the Court, is the patent specification.[154] After a detailed review of several cases from the relevant time period, the Court found that judges construed patent specifications, much as they did other written

146. *Id.*
147. Markman v. Westview Instruments, Inc., 116 S. Ct. 1384 (1996).
148. *Id.* at 1389-93.
149. *Id.* at 1393-95.
150. *Id.* at 1395-96.
151. *Id.* at 1389.
152. *Id.* This point was not disputed, but the Court may have meant to dissuade efforts to totally remove juries from patent cases.
153. *Id.* at 1390 (quoting Lutz, *Evolution of the Claims of U.S. Patents*, 20 J. PAT. OFF. SOC'Y 134 (1938)).
154. *Id.* at 1390-91.

instruments.[155] The Court therefore concluded that "evidence of common law practice at the time of the Framing does not entail application of the Seventh Amendment's jury guarantee to the construction of the claim document. . . ."[156]

2. *Supreme Court Precedent*

The Court next looked to precedent for the proper allocation of responsibility for patent claim construction.[157] The Court began by relying on *Winans v. Denmead* for its recitation of the roles of judge and jury in patent cases.[158] Discussing the two elements of (1) construing the patent and (2) determining whether infringement occurred, the *Winans* Court held that "the first is a question of law, to be determined by the court, construing the letters-patent, and the description of the invention and specification of claim annexed to the them. The second is a question of fact, to be submitted to [the] jury."[159] The Court then reviewed the later cases of *Bischoff v. Wethered*[160] and *Tucker v. Spalding*,[161] which the *Markman* court relied upon as authority for jury determination of the meaning of terms "whenever it was subject to evidentiary proof."[162] The Court characterized *Bischoff* as "a case in which the Court drew a line between issues of document interpretation and product identification, and held that expert testimony was properly presented to the jury on the latter, ultimate issue, whether the physical objects produced by the patent were identical."[163] Therefore, the Court concluded that neither *Bischoff* nor *Tucker*

---

155. *Id.* at 1391-92. The Court dismissed an 1841 case relied upon by Markman as "an exception to what probably had been occurring earlier." *Id.* at 1392.

156. *Id.* at 1393.

157. *Id.*

158. *Id.* The Court implies that *Winans* has increased precedential value by expressly noting that it was authored by the "former patent practitioner, Justice Curtis." *See id.*

159. *Id.* (quoting Winans v. Denmead, 56 U.S. (15 How.) 330, 338 (1854)).

160. 76 U.S. (9 Wall.) 812 (1870).

161. 80 U.S. (13 Wall.) 453 (1872).

162. *Markman*, 116 S. Ct. at 1393-95.

163. *Id.* at 1394. The Court bolstered its conclusion with reference to two early treatises, A. WALKER, PATENT LAWS § 75, at 68 (3d ed. 1895) ("Questions of construction are questions of law for the judge, not questions of fact for the jury."), and 2 W. ROBINSON, LAW OF PATENTS § 732, at 481-83 (1890) ("The duty of interpreting letters-patent has been committed to the courts. A patent is a legal instrument, to be construed, like other legal instruments, according to its tenor. . . ."). *Id.* at 1394-95. .

(which expressly relied upon *Bischoff*) undercut *Winans'* rule that claim construction is a function of the court.[164]

3. *"Functional Considerations"*

The Court reasoned that, because history and precedent failed to answer the question of whether the judge or jury should determine the meaning of claim terms, it was necessary to "consider both the relative interpretive skills of judges and juries and the statutory policies that ought to be furthered by the allocation."[165] These "functional considerations," the Court held, supported allocating the duty to the judge, "like many other responsibilities that we cede to a judge in the normal course of trial, notwithstanding its evidentiary underpinnings."[166]

Initially, the Court held that judges rather than juries are "better suited to find the acquired meaning of patent terms," based on their training, discipline, and experience in document construction.[167] The Court rejected the argument that juries should assess witness credibility when conflicting testimony is presented.[168] It doubted that such cases commonly occur, and held that "any credibility determination will be subsumed within the necessarily sophisticated analysis of the whole document, required by the standard construction rule that a term can be defined only in a way that comports with the instrument as a whole."[169]

Lastly, the Court held that court determination of the meaning of claims enhances the basic policy goals of the patent system, which are to "foster technological growth and industrial innovation."[170] According to the Court, "treating interpretive

---

164. *Id.*

165. *Id.* at 1393.

166. *Id.* at 1395-96.

167. *Id.* at 1395. Some commentators dispute the contention that judges are better able than jurors to understand the complex subject matter of patents. *See* Eugene C. Rzucidlo & Dorothy R. Auth, *What Markman Should Mean to You*, 14 NATURE BIOTECH. 888, 890 (July 1996) ("It may be equally dangerous to assume that judges have a higher level of scientific skill than a typical juror.").

168. *Markman*, 116 S. Ct. at 1395. The Court stated that in patent cases, "a jury's capability to evaluate demeanor, . . . to sense the 'mainsprings of human conduct,' or to reflect community standards, are much less significant than a trained ability to evaluate the testimony in relation to the overall structure of the patent." *Id.* (citations omitted).

169. *Id.*

170. *Id.* at 1396 (quoting H.R. Rep. No. 97-312, at 20 (1981)).

issues as purely legal will promote (though it will not guarantee) intrajurisdictional certainty through the application of *stare decisis* on those questions not yet subject to interjurisdictional uniformity under the authority of the single appeals court."[171] Consequently, this uniform interpretation is said to frame clearly the limits of the patent, thus allowing other inventors and businesses to build upon the patented invention without the uncertain, deterrent fear of infringing the patent.[172] The Court stated that "uniformity would, however, be ill served by submitting issues of document construction to juries."[173] The Court does not fully explain this conclusion. In particular, the Court does not state why a jury could not reach a proper or uniform construction of a claim if it is given detailed instructions from the court and has heard testimony concerning the disputed term meanings.

III. EFFECTS OF THE *MARKMAN* DECISION

The *Markman* decision undoubtedly has impacted how patent infringement cases are carried out in the United States.[174] Also, there is at least one indication that the rationale underlying *Markman* may be extended to limit the role of the jury in other areas of intellectual property law.[175] Additionally, the *Markman* decision arguably fails to further the policies underlying creation of the Federal Circuit's exclusive jurisdiction over patent appeals.

A. *Congruence with Congressional Goals in Creating the Federal Circuit*

It is highly questionable whether the *Markman* decision furthers judicial efficiency, uniformity of decisions, and legal certainty, as Congress intended in creating the Federal Circuit. Judicial efficiency is likely no better off after *Markman*. First, the education of the jury through expert testimony during trial will

171. *Id.; see infra* notes 178-80 and accompanying text.
172. *Markman*, 116 S. Ct. at 1396.
173. *Id.*
174. *See* Elf Atochem North Am., Inc. v. Libbey-Owens-Ford Co., 894 F. Supp. 844, 857 (D. Del. 1995) ("The Federal Circuit's decision in *Markman* will undoubtedly change the face of patent litigation as it clearly did in this case. A number of procedural issues flow from this decision.").
175. *See* Harbor Software Inc. v. Applied Sys., Inc., 925 F. Supp. 1042 (S.D.N.Y. 1996).

be replaced by lengthy pre-trial hearings necessary for the judge to understand the claims to be interpreted.[176] Second, some commentators believe that judges' workloads will increase "by requiring them to write detailed opinions sufficient for *de novo* review."[177]

It is also quite questionable whether uniformity is enhanced by *Markman*. Some commentators predict enhanced uniformity because *de novo* review should eliminate the possibility of a patent being interpreted in varying ways.[178] However, there is nothing to prevent different district courts from reaching contrary conclusions as to the meaning of claim terms when construing a single patent in separate infringement lawsuits.[179] Moreover, there is no guarantee that an appeal to the Federal Circuit will resolve such a conflict. Different panels of the Federal Circuit may disagree, creating an intracircuit conflict which may or may not be resolved en banc or by the Supreme Court.[180]

Legal certainty and stability may or may not be enhanced by the *Markman* decision. On one hand, the Federal Circuit decision, by ignoring its own precedent, appears to undermine legal stability and certainty. As Judge Newman stated in counseling the Federal Circuit to temper its potentially detrimental activism, "[i]t is policy choices that lead to departure from precedent, into judicial activism that weighs against legal stability."[181] On the other hand, the Supreme Court's affirmance of *Markman* tends to endorse the direction in which

176. Richard C. Reuben, *Ruling Cuts Jury's Role in Patent Cases*, A.B.A. J., July 1995, at 24, 25.

177. *Id.* at 25 (quoting Donald W. Banner of the Banner & Allegretti law firm in Washington D.C.).

178. *Id.* at 24-25 (quoting Westview's attorney, Frank H. Terry Griffin III); John B. Pegram, Markman *and Its Implications*, 78 J. PAT. & TRADEMARK OFF. SOC'Y 560, 565 (1996) ("[T]he claims will not be interpreted in a different way because of expert testimony or confusion of a jury.").

179. *See* Ramos v. Boehringer Mannheim Corp., 66 F.3d 346 (Fed. Cir. 1995) (unpublished disposition) (holding that comity is not required between district courts with respect to their construction of claim terms of an identical patent).

180. *See* Helen W. Nies, *Dissents at the Federal Circuit and Supreme Court Review*, 45 AM. U. L. REV. 1519 (1996) (supporting the use of dissenting opinions and disputing the notion that the Federal Circuit should only speak with one voice).

181. Newman, *supra* note 18, at 688. Some scholars have suggested that the Supreme Court should more closely scrutinize the judicial decisions of the Federal Circuit in the future in order to tame the apparently activist court. Landry, *supra* note 20, at 1208-13.

the Federal Circuit appears to be moving, arguably furthering legal certainty and stability.

B. "Markman *Hearings*"

The *Markman* decision is likely "to accelerate the trend in trial courts to holding so-called '*Markman* hearings' on claim interpretation."[182] For example, in *Elf Atochem North America, Inc. v. Libbey-Owens-Ford Co.*,[183] the court conducted a two-day bench trial to resolve the dispute over the meaning of claim terms before the jury trial.[184] The court stated that normally courts should attempt to manage cases in such a way as to resolve all issues in one trial.[185] However, the court acknowledged that *Markman* encouraged litigants to try the claims construction issues earlier, via an immediate interlocutory appeal, so that the Federal Circuit can review the court's claim construction before the case goes to a jury trial.[186] The court noted that this procedure "could add significant time and expense to the ultimate resolution of the litigation."[187] Interestingly, the court stated that "it remains to be seen what the impact of the court's new role as arbiter of the meaning of disputed words in the claims of patents will have on a party's right to a jury trial on validity issues."[188]

C. *Disposal of Cases on Summary Judgment*

The *Markman* decision is likely "to reduce the number of patent litigations that reach trial by substantially increasing the number of such cases decided on pre-trial motions."[189] One authority speculates that as a result of *Markman*, "[a]s many as

---

182. *A Strategic Approach to* "Markman *Hearings*" *on Claim Construction*, 11 INTELL. PROP. LAWCAST (no. 9), at 4, (week of May 13, 1996); *see* Gary M. Hoffman & John A. Wasleff, *A Tale of Two Court Cases:* Markman *and* Hilton-Davis, 13 COMPUTER LAW. 18, 19 (June 1996).

183. 894 F. Supp. 844 (D. Del. 1995).

184. *Id.* at 850.

185. *Id.* at 857.

186. *Id.* at 857-58.

187. *Id.* at 857.

188. *Id.* at 858.

189. Steve D. Glazer & Steven J. Rizzi, Markman*: The Supreme Court Takes Aim at Patent Juries*, 8 J. PROPRIETARY RTS. 2 (May 1996); Martin, *supra* note 31, at 648 ("Clearly, with the jury's role in interpreting patent claims eliminated, summary judgment will be the preferred procedural mechanism to determine the scope of the claims of a patent and, . . . ultimately to determine infringement.").

90 percent of [patent] cases will be decided on a motion for summary judgment."[190] Whether this shift is desirable probably depends on one's vantage point and how one views the shift of decision-making power from juries to federal judges.

D. Extension of Markman *to Other Areas of the Law*

The rationale underlying the *Markman* decision by the Supreme Court has been applied by at least one district court to the law of copyrights. In *Harbor Software Inc. v. Applied Systems*,[191] the district court held that in applying the abstraction-filtration-comparison test for determining copyright protectibility, the filtration analysis is a matter of law for the court, rather than for the jury.[192] The court analogized filtration with patent claims, stating that "[j]ust as patent claims determine the boundaries of an inventor's monopoly, filtration serves the purpose of defining the scope of plaintiff's copyright."[193] The court relied on *Markman* for the rule that such determinations are a question of law, and for the policy reasons that judges are better suited than juries to determine the meaning of claim terms and to foster uniformity of document construction.[194] This case may forebode a growing sphere in civil litigation from which juries are excluded.

IV. ALTERNATIVE FACT-FINDING IN PATENT INFRINGEMENT CASES

Some commentators, as well as Judges Mayer and Newman, believe the *Markman* decision inevitably flowed from a growing concern that traditional juries cannot be depended on to render proper decisions in complicated cases, such as patent infringement trials.[195] The problem is exacerbated because

190. Glazer & Rizzi, *supra* note 189, at 2 n.2 (quoting Jack C. Goldstein, former head of the American Bar Association's Intellectual Property Law Section).
191. 925 F. Supp. 1042 (S.D.N.Y. 1996).
192. *Id.* at 1046.
193. *Id.* (internal quotations omitted) (quoting Computer Assocs. Int'l, Inc. v. Altai, Inc., 982 F.2d 693, at 707 (2d Cir. 1992) (quoting Brown Bag Software v. Symantec Corp., 960 F.2d 1465, 1475 (9th Cir.), *cert. denied*, 506 U.S. 869 (1992)).
194. *Id.*
195. *Addressing the Problems of Complex and Scientific Evidence* [hereinafter *Scientific Evidence*], 108 HARV. L. REV. 1583, 1584-89 (1995); *The Case for Special Juries in Complex Civil Litigation* [hereinafter *Special Juries*], 89 YALE L.J. 1155, 1155 (1980); Reuben *supra* note 176, at 24 ("There is a substantial discussion going

"courts often discourage the selection of technically competent and highly educated individuals for jury service."[196] Some scholars have urged alternatives to the traditional jury or judge as trier of fact in complicated civil trials, especially in light of the increasing number of complicated trials involving scientific and complex evidence.[197]

One alternative is a special, or blue-ribbon, jury composed of experts in the subject matter at issue.[198] By providing a fact-finder of greater technical expertise and appropriate educational background, a blue-ribbon jury "directly remedies the problem of jurors' technical incompetence."[199] Currently, such juries are rarely utilized because they can only be used with the consent of both parties, due to the lack of codified federal authority for courts to appoint them *sua sponte*.[200]

Another alternative to the traditional fact-finder is the special master, who possesses technical expertise in the area at issue in the litigation.[201] Unlike blue-ribbon juries, the use of special masters is codified[202] to allow appointment by judges when complicated trial issues are beyond the understanding of the jury or judge.[203] However, there is concern that the use of special masters to achieve satisfactory results "may come at the expense of invading the judge's or jury's traditional fact-finding responsibility."[204]

---

on in the patent bar over the ability of juries . . . to make sensible decisions in [patent] cases."); Martin, *supra* note 31, at 641 ("Companies on the receiving end of [] verdicts [granting huge damage awards in infringement jury trials] and those who feared [those verdicts] began to suggest that juries were ill-equipped to handle the complex technological issues often presented in patent infringement litigation.").

196. *Scientific Evidence, supra* note 193, at 1585 n.13 ("Courts, for example, routinely excuse doctors, dentists, lawyers, and other professionals from jury duty.") (citing Ruiz v. Norris, 868 F. Supp. 1471, 1508 n.7 (E.D. Ark. 1994); United States v. Osorio, 801 F. Supp. 966, 984 app. A (D. Conn. 1992))).

197. *Special Juries, supra* note 195, at 1155-56 n.9. *See generally Scientific Evidence, supra* note 195.

198. *Scientific Evidence, supra* note 195, at 1596-97; *Special Juries, supra* note 195.

199. *Scientific Evidence, supra* note 195, at 1596.

200. *Id.*

201. *Id.* at 1593.

202. FED. R. CIV. P. 53

203. FED. R. CIV. P. 53(b) ("In actions to be tried by a jury, a reference [to a master] shall be made only when the issues are complicated; in actions to be tried without a jury . . . a reference shall be made only upon a showing that some exceptional condition requires it.")

204. *Scientific Evidence, supra* note 195, at 1595.

Lastly, China's special intellectual property courts, which do not have juries, also suggest an alternative fact-finding mechanism, which is worth exploring. In cases before those courts, two "highly specialized technicians" are appointed "to sit together with the judge."[205] Together, the three persons hear the case and vote—without the judge having veto power over the votes of the technicians.[206]

CONCLUSION

The immediate effect of *Markman* is to eliminate juries from determining the meaning of patent claim terms, generally a crucial issue in patent infringement cases. It remains to be seen whether this decision is a stepping stone toward the creation of a complexity exception, eliminating lay juries in complex civil trials.

The often highly technical and complex subject matter of patent infringement lawsuits may warrant altering the balance of judge, jury, and appellate court from that normally found in other federal civil lawsuits. However, the curtailment of juries should be undertaken cautiously. Due to reasonable concerns about lay juries—and generalist judges—being able to comprehend fully the subject matter of some patent cases, alternative fact finding methods should be examined, tested, and further utilized.

Kevin W. King

205. *Franklin Pierce Conference, supra* note 1, at 450 (Mr. Sun).
206. *Id.*