Journal of Intellectual Property Law

Volume 3 | Issue 2 Article 7

March 1996

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

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

I. INTRODUCTION

Patent litigation often involves technological data that confuse even the most experienced judges.[1] In addition, patent claims possess both contractual and statutory qualities and thus present a special challenge to adjudication. This challenge primarily stems from uncertainty over how to interpret claim language, who should interpret claim language, and what role, if any, extrinsic evidence should play in claim interpretation.[2]

As a result of such complexities, some commentators believe that the typical jury lacks the ability to provide adequate services in the course of a patent trial.[3]

The constitutional right to trial by jury, however, cautions against attempts to remove the jury completely from patent litigation.[4] The Supreme Court, attempting to walk the tightrope between these two considerations, recently held in *Markman v. Westview Instruments, Inc.*[5] that patent claim construction (or interpretation) is a matter of law, completely out of the jury's hands and thus subject to de novo review on appeal.[6] After reviewing the factual, procedural, and legal history of *Markman*, as well as the analyses of both the Federal Circuit and the Supreme Court, this Recent Development scrutinizes the reasoning behind and ramifications of those opinions and concludes that a specialized rule of patent claim construction allocating a limited, clearly defined task to the jury in the event of genuinely ambiguous claim language

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[1] *See* Victoria Slind-Flor, *Jurists Learn to Cope with the Brave New World*, NAT'L L. J., Oct. 19, 1992 (claiming judges often fail to understand complex technological issues).

[2] *See infra* notes 41-42, 115-118, 130 and accompanying text and note 48.

[3] *See* Symposium, *Abolition of Jury Trials in Patent Cases*, 34 IDEA: J.L. & TECH. 77 (1994) (publishing transcripts from conference discussion of jury in patent cases). *See generally* Roger W. Kirst, *The Jury's Historic Domain in Complex Cases*, 58 WASH. L. REV. 1 (1982) (exploring possible benefits of complexity exception to right to jury trial).

[4] The Seventh Amendment provides "the right of trial by jury shall be preserved." U.S. CONST. amend. VII.

[5] 116 S. Ct. 1384 (1996).

[6] *Id.*

would better serve patent litigation. Such a rule would adhere to the policies underlying the current patent statute and further the objectives of patent law.

II. BACKGROUND

The events leading to the *Markman* litigation began with Herbert Markman's invention of an inventory control system for dry cleaning businesses. The typical dry cleaning business stands particularly susceptible to petty theft by employees.[7] Customers' articles of clothing are usually mixed up during the cleaning process, rendering nearly impossible a determination of who may have taken any single article during the sorting process that takes place after cleaning.[8]

Markman invented and patented an inventory system for dry cleaners that keeps a record of articles of clothing brought in and monitors their progress through multiple phases in the dry cleaning process.[9] The system keeps a record of the customer, the type of

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[7] Markman v. Westview Instruments, Inc., 52 F.3d 967, 34 U.S.P.Q.2d (BNA) 1321 (Fed. Cir. 1995) (en banc), *aff'd*, 116 S. Ct. 1384 (1996). Because of its more detailed recitation of the facts of the case, the Federal Circuit's opinion is cited for the case background. Additionally, this Recent Development will devote nearly equal attention to the Federal Circuit's opinion as to Supreme Court's opinion because attorneys will most likely deal exclusively with the Federal Circuit in the future as to the issue of claim construction.

[8] *Id.*

[9] *Id.* at 971-72. Patent specifications contain the description of the invention; patent claims are the part of the specification that are meant to identify the subject of the patent grant. The claim at issue describes Markman's invention to be an inventory control and reporting system, comprising:

> a data input device for manual operation by an attendant, the input device having switch means operable to encode information relating to sequential transactions, each of the transactions having articles associated therewith, said information including transaction identity and *descriptions of each of said articles* associated with the transactions;
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> a data processor including memory operable to record said information and *means to maintain an inventory total*, said data processor having means to associate sequential transactions with unique sequential indicia and *to generate at least one report of said total* and said transactions, the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another;
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> a dot matrix printer operable under control of the data processor to generate a written record of the indicia associated with sequential transactions, the written record including optically-detectable bar codes

articles to be cleaned, and how the articles will be cleaned.[10] The business owner may record still more information if desired, and the system can generate reports of all entered information.[11] Using this system, a business owner can keep track of every article of clothing during each step of the dry cleaning process and thus detect any removal at the specific point in the process where it occurred.[12] Such information greatly facilitates the discovery of the party or parties responsible for stealing from the business as well as serving as a deterrent to potential thieves.

Westview, the defendant, manufactured a device consisting of two pieces of equipment, the Datamark and the Datascan.[13] The Datamark prints a bar-coded ticket listing information about the customer, clothes to be cleaned, and charges, but keeps in memory only the invoice number, date, and cash total.[14] The Datascan is a portable device that reads the bar codes in order to identify any discrepancies.[15] Unlike Markman's system, the Westview system is incapable of tracking articles of clothing, pinpointing additional or missing articles, and generating reports about the location and status of those articles.[16]

Despite the variations between the two systems, Markman filed suit against Westview for infringement. After a jury verdict for Markman, the district court granted Westview's motion for judgment as a matter of law, holding " 'inventory' as used in the claims meant 'articles of clothing' and not simply transaction totals

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> having a series of contrasting spaced bands, the bar codes being printed only in coincidence with each said transaction and at least part of the written record bearing a portion *to be attached to said articles*; and,
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> at least one optical scanner connected to the data processor and operable to detect said bar codes *on all articles* passing a predetermined station,
>
> whereby said system can detect and *localize spurious additions to inventory* as well as spurious deletions therefrom.

Id. at 972.

[10] *Id.*

[11] *Markman*, 52 F.3d at 972.

[12] *Id.* at 971.

[13] *Id.* at 972.

[14] *Id.*

[15] *Id.* at 973.

[16] *Markman*, 52 F.3d at 973.

or dollars."[17] Thus, the district court concluded that since Westview's device did not retain information about specific garments, it therefore did not infringe upon Markman's patent.[18] The Federal Circuit affirmed,[19] and the Supreme Court affirmed unanimously.[20]

III. THE FEDERAL CIRCUIT'S ANALYSIS IN *MARKMAN*

In *Markman*, the Federal Circuit held patent claim construction (the process of determining precisely what qualities of an invention a patent protects from infringement) a matter of law and attempted to settle inconsistent circuit opinions on the issue.[21] The court also defended this holding against Seventh Amendment attacks by the dissent and one of the concurring opinions.[22]

On the issue of the jury's role in claim construction, Markman argued that the jury was required to interpret certain contested terms of his patent claim under *Palumbo v. Don-Joy Co.*,[23] which stated that when a disputed claim term arises and extrinsic

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[17] *Id.*

[18] *Id.*

[19] *Markman*, 52 F.3d at 970.

[20] Markman v. Westview Instruments, Inc., 116 S. Ct. 1384 (1996).

[21] The court also held that the term "inventory," as used in Markman's patent claim, necessarily included "articles of clothing." *Markman*, 52 F.3d at 982.

[22] Judge Mayer's concurring opinion argued that while the issue of patent scope is ultimately a legal question, it does not follow that judges should decide every question that comes up during claim construction. *Id.* at 989. Judge Mayer continued in this vein, saying extrinsic evidence may occasionally cause a dispute over the meaning of a term in the claim. *Id.* at 991. Judge Newman's dissent made a distinction between interpretation, which she defined as the determination of the meaning of terms used, and construction, which she defined as the legal effect of the properly understood terms. *Id.* at 1001. Despite the semantics, the gist of Judge Newman's analysis seems nearly identical to that of Judge Mayer; both think disputed terms should go to the jury, but that the court ultimately decides the meaning of the patent claim as a whole. The majority also rejected the contention by the dissent and one concurring opinion that patents are analogous to contracts and thus may present triable issues of fact. *Id.* at 984-87. The majority noted that patents are not contracts per se, and that extrinsic evidence is needed in patent cases only to inform the court about claim language with which it is unfamiliar, because statutory requirements forbid ambiguity. *Markman*, 52 F.3d at 985-86. The court found patent claims more analogous to statutes than contracts and thus subject to interpretation by the courts only. *Id.* at 987.

[23] 762 F.2d 969, 226 U.S.P.Q. (BNA) 5 (Fed. Cir. 1985).

evidence is allowed, claim construction should be left to the jury.[24] In addition, Markman contended that *Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft*[25] mandated deference by the appellate court to the jury's interpretation of the claim.[26] The court in *Tol-O-Matic* reviewed a jury's claim construction only for reasonableness.[27]

Markman then specifically asserted that the district court wrongfully replaced the jury's implied construction of the claim term "inventory" as meaning only "cash" or "inventory totals" with its own construction of the term as necessarily including "articles of clothing."[28] In support of his contention, Markman referred to his own testimony as inventor as well as that of his patent expert.[29] By contrast, Westview focused mainly on the patent language itself and the prosecution history in advocating the district court's holding.[30]

The majority reviewed the history of claim construction in the Federal Circuit and found the cases relied upon by Markman to be based on erroneous authority. The court began by stating that the circuit originally held claim construction to be a matter for the court.[31]

A divergent line of cases stating the possibility of fact issues in patent claim construction developed, however, in the wake of *McGill Inc. v. John Zink Co.*,[32] which stated that a jury may interpret a claim if the meaning of a term is disputed and extrinsic

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[24] *Id.* at 974.

[25] 945 F.2d 1546, 20 U.S.P.Q.2d (BNA) 1332 (Fed. Cir. 1991).

[26] Markman v. Westview Instruments, Inc., 52 F.3d 967, 973-74 (Fed. Cir. 1995) (en banc), *aff'd*, 116 S. Ct. 1384 (1996).

[27] 945 F.2d at 1552.

[28] *Markman*, 52 F.3d at 974.

[29] *Id.*

[30] *Id.*

[31] SSIH Equip. S.A. v. United States Int'l Trade Comm'n, 718 F.2d 365, 218 U.S.P.Q.2d (BNA) 678 (Fed. Cir. 1983) ("The question of 'what is the thing patented' is one of law."). Judge Mayer's concurring opinion notes that many of the cases relied upon by the majority were tried without a jury. *Markman*, 52 F.3d at 990. Indeed, *SSIH Equipment* was a bench trial.

[32] 736 F.2d 666, 221 U.S.P.Q.2d (BNA) 944 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 1037 (1984).

evidence is brought in to clarify the term's meaning.[33] The *Markman* majority pointed out that the main case relied on for this proposition in *McGill, Envirotech Corp. v. Al George, Inc.*[34] in fact stated that claim construction is a matter of law. The court in *Envirotech* expressly held that the "patented invention as indicated by the language of the claims must first be defined (a question of law)."[35] The majority also noted that the other two cases on which *McGill* relied were contract cases.[36] Both cases that Markman used to buttress his assertion that claim construction may present factual issues sprang from the line of cases following *McGill*.[37]

The majority in *Markman* next invoked support for its holding from a line of Supreme Court decisions, including *Hogg v. Emerson*,[38] that the majority believed restricted patent claim construction to the bench.[39] The Court in *Hogg* stated that construction of written words in a patent claim involves a question of law.[40] The *Markman* majority argued that precedents such as *Hogg* reinforced its own position that claim construction involves no factual issues.

In addition to citing authority, the Federal Circuit proffered several advantages to a rule limiting patent claim construction to the court. First, the court noted that construction of written

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[33] *Id.* at 672. Extrinsic evidence in patent cases includes prior art, documentary evidence, and expert testimony, which may include testimony of the inventor, experts in his field, or even patent attorneys. The specifications, claims, and prosecution history (official record of what occurred during examination of the patent application; it is a public record), unlike extrinsic evidence, are always available for consideration by the trial court.

[34] 730 F.2d 753, 221 U.S.P.Q.2d (BNA) 473 (Fed. Cir. 1984).

[35] *Id.* at 758.

[36] Markman v. Westview Instruments, Inc., 52 F.3d 967, 976-77 (Fed. Cir. 1995) (en banc), *aff'd*, 116 S. Ct. 1384 (1996).

[37] *Id.* at 973-74. *See supra* notes 23-27 and accompanying text.

[38] 47 U.S. (6 How.) 437 (1848). The majority also cited without comment the following Supreme Court decisions as supporting its position: Silsby v. Foote, 55 U.S. (14 How.) 218 (1853); Winans v. New York & Erie R.R., 62 U.S. (21 How.) 88 (1858); Bischoff v. Wethered, 76 U.S. (9 Wall.) 812 (1869); Heald v. Rice, 104 U.S. 737 (1881); Coupe v. Royer, 155 U.S. 565 (1895); Market St. Cable Ry. Co. v. Rowley, 155 U.S. 621 (1895); Singer Mfg. Co. v. Cramer, 192 U.S. 265 (1904).

[39] The majority cited a list of seemingly ancient cases, but as the dissent even pointed out, such old cases are apropos in the question of the right to a jury trial, since those courts likely had a better idea of how that right stood in England and the United States in 1791. *Markman*, 52 F.3d at 995-96.

[40] 47 U.S. (6 How.) at 484.

evidence has been traditionally a matter for the court.[41] Second, the court discussed the special nature of the patent as a grant of governmental rights which should be defined by the court.[42] Additionally, the majority cited consistency of interpretation by judges instead of juries as a beneficial result.[43]

On the issue of the right to trial by jury, the Federal Circuit defended its holding as constitutionally valid. The court asserted that while claim construction rests exclusively in the province of the court, the determination of infringement remains with the jury.[44] The majority then dismissed the two Supreme Court decisions, *Bischoff v. Wethered*[45] and *Silsby v. Foote*,[46] relied on by the dissent and one concurring opinion for their assertion that factual issues may arise in patent claim construction.[47] As for *Bischoff*, the majority dismissed it quickly by pointing out that the case involved not patent infringement, but breach of contract.[48]

The court noted that the main issue in *Silsby* had been made

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[41] *Markman*, 52 F.3d at 978 (citing Levy v. Gadsby, 7 U.S. (Cranch) 180, 186 (1805)).

[42] *Id.* (citing 35 U.S.C. § 154 (1994)).

[43] *Id.* at 978-79. *But see* Howard T. Markey, *On Simplifying Patent Trials*, 116 F.R.D. 369 (1987) (claiming judges are no more likely to reach correct decisions than jurors); *Jury Comprehension in Complex Cases*, 1989 A.B.A. SEC. ON LITIG. (concluding after three year study that in complex cases juries and judges reached similar conclusions); Slind-Flor, *supra* note 1. *See generally* Harry Kalven, Jr., *The Dignity of the Civil Jury*, 50 VA. L. REV. 1055 (1964) (summarizing initial results of massive Chicago Jury Project study of jury performance); Kirst, *supra* note 3; R. Perry Sentell, Jr., *The Georgia Jury and Negligence: The View from the Bench*, 26 GA. L. REV. 85 (1991) (providing results from survey of Georgia trial judges' opinions of juror performance).

[44] *Markman*, 52 F.3d at 984. As the dissent pointed out, however, the district court in *Markman* failed to allow the jury to reconsider infringement in light of that court's construction. *Id.* at 1008. Also, factual disputes over infringement "arise only over the structure or operation of the accused method or device." William F. Lee & Wayne L. Stoner, *The Role of Expert Witnesses on Liability Issues in Patent Litigation in Light of* Markman v. Westview Instruments, *in* WINNING STRATEGIES IN PATENT LITIGATION, at 647 (PLI Pats., Copyrights, Trademarks, & Literary Prop. Course Handbook Series No. G4-3952, 1995).

[45] 76 U.S. (9 Wall.) 812 (1869).

[46] 55 U.S. (14 How.) 218 (1852).

[47] *Markman*, 52 F.3d at 988.

[48] *Id.* at 987-88. The majority also rejected Judge Rader's labeling of much of the majority's discussion of patent claim construction as dictum. *Id.* at 988. The majority additionally rejected the analogy of patents to contracts relied on by the dissent and Judge Mayer's concurrence. According to the majority, patents bear a closer resemblance to statutes, which are interpreted by the court alone. *Id.* at 984-87. The majority's reasoning here seems odd given its own reliance on contract principles to support its holding. *See infra* note 117 and accompanying text and *supra* note 22.

obsolete by statute. In *Silsby*, while the Supreme Court generally considered patent claim construction to be a matter of law,[49] it allowed the jury to intervene when a claim failed to designate protected elements with particularity.[50] The *Markman* majority dismissed this point by noting that while the current statute requires that inventors particularly point out the elements protected by their patents, the statute at the time of *Silsby* required no such particularity.[51] The Federal Circuit went on, however, to list both *Silsby* and *Bischoff* among the Supreme Court cases supporting its holding in *Markman*.[52]

IV. THE SUPREME COURT'S ANALYSIS IN *MARKMAN*

Writing for a unanimous Supreme Court, Justice Souter affirmed the Federal Circuit in a decision that evinced a high degree of deference to the Federal Circuit's patent litigation expertise and added little, if any, substantial analysis to that court's reasoning.[53] Though the Court investigated the history of patent claims and Supreme Court precedent in somewhat greater detail than did the Federal Circuit, it found these resources of little help and based its affirmation primarily on the notion that "judges, not juries, are the better suited to find the acquired meaning of patent terms."[54] While the Supreme Court in advocating judge superiority in interpreting patent claims never expressly referred to the Federal Circuit's opinion, the argument closely echoes one made by the lower court.[55]

The Court first considered the Seventh Amendment right to trial by jury.[56] It found that because 18th-century infringement cases were tried before juries, modern cases likewise require a jury

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[49] *Silsby*, 55 U.S. (14 How.) at 225.

[50] *Id.* at 226.

[51] *Markman*, 52 F.3d at 988. Judge Mayer's concurrence and the dissent, however, noted that the original patent act of 1790 required letters patent to describe the invention clearly. *Id.* at 996, 1016. Thus the majority's contention seems largely a matter of semantics.

[52] *Id.* at 977.

[53] Markman v. Westview Instruments, Inc., 116 S. Ct. 1384 (1996).

[54] *Id.* at 1395.

[55] *See supra* notes 41-43 and accompanying text.

[56] *See supra* note 44 and accompanying text.

trial,[57] and it then searched for an 18th-century issue analogous to that of modern claim construction.[58] Construction of patent specifications appeared to the Court as the closest analogous 18th-century issue,[59] and the Court found that the history of patent specification construction illustrated "no established jury practice sufficient to support an argument by analogy that today's construction of a claim should be a guaranteed jury issue."[60]

The Court then rejected two arguments by Markman which asserted that the state of patent litigation in the 18th-century nevertheless illustrates by implication the construction of patent claims by juries. Markman first contended that juries must have defined patent terms in order to reach the verdicts they did.[61] The Court replied that there is no more reason to believe juries interpreted patent terms than that judges did so, and that "we do know that in other kinds of cases during this period judges, not juries, ordinarily construed written documents."[62]

The Court also summarily rejected Markman's contention that 17th-century juries defined terms of art in patent specifications; Markman cited no 18th-century authority to support his argument.[63]

Having apparently found that history supports no inference of a Seventh Amendment right to have juries interpret patent claims, the Court investigated precedent. It refuted Markman's reliance on two cases, *Bischoff v. Wethered*[64] and *Tucker v. Spalding*,[65] by noting that in those cases the Court distinguished between document interpretation and product identification and only considered the latter capable of presenting fact issues.[66]

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[57] *Markman*, 116 S. Ct. at 1389.

[58] *Id.* at 1390. The patent statute did not require use of patent claims until 1836. *Id.*

[59] The Court noted that in 1791, the specification, like today's claim, "represented the key to the patent." *Id.*

[60] *Id.* at 1391. The Court noted, however, that this lack of an established practice likely stemmed from the fact that juries had been introduced only recently to patent trials in 1791. *Markman*, 116 S. Ct. at 1391.

[61] *Id.*

[62] *Id.* at 1392. The Court discussed land patents as one example. *Id.*

[63] *Markman*, 116 S. Ct. at 1392.

[64] 76 U.S. (9 Wall.) 812 (1869).

[65] 80 U.S. (13 Wall.) 453 (1872).

[66] *Markman*, 116 S. Ct. at 1394.

While the Court had appeared to consider history and precedent as bases for affirming the lower court, at this point in the opinion the Court seemed to lose some of the confidence with which it had thus far rejected Markman's claims. Because "history and precedent provide no clear answers," the Court turned to "functional considerations" in choosing between judge and jury.[67] Judges, the Court concluded, are better qualified for the task because they often construe written instruments.[68]

The Court rejected Markman's claim that juries should answer questions of meaning peculiar to a field because testimony to resolve such questions requires "credibility determinations, which are the jury's forte."[69] While conceding that "in theory there could be a case in which a simple credibility judgment would suffice to choose between experts whose testimony was equally consistent with a patent's internal logic,"[70] the Court replied that such situations almost never occur in reality.[71] This assertion rings of the Federal Circuit's contention that patent claims should never be ambiguous because of statutory requirements as to the procedure that creates claims.[72]

The Court finally invoked the need for uniformity in patent litigation as supporting its holding. Noting that the Federal Circuit Court of Appeals was created to encourage such uniformity, the Court stated its belief that patent claim construction by judges rather than juries would better facilitate that goal.[73]

V. LEGAL HISTORY OF PATENT CLAIM CONSTRUCTION

A. THE PATENT ACT

An examination of the jury's role in patent litigation must begin from the perspective of the Seventh Amendment's preservation of the right to a jury trial as it existed in 1791, and also of the

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[67] *Id.* at 1395.
[68] *Id.*
[69] *Id.*
[70] *Id.*
[71] *Markman*, 116 S. Ct. at 1395.
[72] *See infra* notes 103-106 and accompanying text.
[73] *Markman*, 116 S. Ct. at 1396. *See supra* note 43.

Constitution's grant to Congress of the power to secure for limited times to inventors the exclusive right to their discoveries.[74] Since the Patent Act of 1790, which allowed only "such damages as shall be assessed by a jury," juries have played a role in patent suits at law.[75] That the right to a jury trial in patent cases existed in 1791 by statute instead of common law is simply another factor that renders the issue of the jury's proper role in such cases singularly perplexing to courts wrestling with the problem.[76]

The current patent statute, enacted in 1952, requires that specifications

> contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, [and requires that the patent claim] shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.[77]

Unfortunately, the 1952 Act offers no guidance as to the jury's role in patent litigation.

B. THE CASE LAW

The cases dealing with the issue of patent claim construction fall into two historical groups: early Supreme Court decisions and recent Federal Circuit cases. The issue appears in a number of

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[74] U.S. CONST. art. I, § 8, cl. 8.

[75] Act of April 10, 1790, ch. 7, § 4, 1 Stat. 109, 111 (current version beginning at 35 U.S.C. § 101 (1994)).

[76] The Federal Circuit majority in *Markman* noted that neither of the concurring opinions, nor the dissent, nor any of the submitted briefs cites any cases on the issue of the jury's role in 1791. Markman v. Westview Instruments, Inc., 52 F.3d 967, 984 (Fed. Cir. 1995) (en banc), *aff'd*, 116 S. Ct. 1384 (1996). This fact further emphasizes the lack of clear authority on the present issue.

[77] 35 U.S.C. § 112 (1994).

Supreme Court cases up until 1904, basically disappears, and then resurfaces in the Federal Circuit in 1983. Both groups of cases share an overall fragmented approach in defining the jury's role in patent infringement claims. The case law on this topic as a whole, nonetheless, suggests three basic rules: the issue of patent infringement always goes to the jury; claim construction is ultimately a matter of law; and genuine ambiguity as to specification terms goes to the jury. Courts universally accept the first rule, and the second contention has nearly as wide acceptance.[78] The third rule marks the main point of division within both the Supreme Court and the Federal Circuit.

In 1853, the Supreme Court in *Hogg v. Emerson*[79] stated that an unclear claim involves a legal question "so far as regards the construction of the written words used."[80] Forty-two years later, however, the Court intimated a different view when it called a question of construction without any extrinsic evidence a "matter of law for the court, without any auxiliary fact to be passed upon by the jury."[81] This language suggests the possibility of factual issues in patent claim construction. In 1904, the Court seemed to reaffirm this notion by implication in *Singer Manufacturing Co. v. Cramer*,[82] which remarked that because several claims were perfectly comprehensible on their faces, the infringement question stood only for the Court's consideration.[83] Since *Singer*, the Supreme Court has not again addressed the issue of patent claim construction.

The Federal Circuit has consistently exhibited a similarly confused view as to the existence of factual issues in patent claim construction. As the majority in *Markman* noted, the Federal Circuit, like the Supreme Court, held at its inception that while the question of infringement is factual, "the question of 'what is the

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[78] For examples of the few cases that do not follow the second rule, *see* McGill Inc. v. John Zink Co., 736 F.2d 666, 672, 221 U.S.P.Q. (BNA) 944 (Fed. Cir. 1984), (stating jury could construe claims if extrinsic evidence is brought in to explain term's meaning); Palumbo v. Don-Joy Co., 762 F.2d 969, 974, 226 U.S.P.Q. (BNA) 5 (Fed. Cir. 1985) (stating similar proposition).

[79] 47 U.S. (6 How.) 436 (1848).

[80] *Id.* at 483.

[81] Market St. Cable Ry. Co. v. Rowley, 155 U.S. 621, 625 (1895).

[82] 192 U.S. 265 (1904).

[83] *Id.* at 275.

thing patented' is one of law . . . ."[84] While some cases have followed this rule,[85] the court in *McGill Inc. v. John Zink Co.*[86] asserted that if "the meaning of a term of art in the claims is disputed and extrinsic evidence is needed to explain the meaning, construction of the claims could be left to a jury."[87] Several other cases have adhered to the rule in *McGill*, including *Perini America, Inc. v. Paper Converting Machine Co.*[88] The court in *Perini* stated that a dispute in the meaning of terms in the claim presents a question of fact.[89]

To make matters even more troublesome, the courts purporting to follow *McGill* have failed to adhere to a single rule.[90] At least one decision in addition to *McGill* appears to have left the task of patent construction entirely to the jury in the presence of a disputed term.[91] The court in *Moeller v. Ionetics, Inc.*,[92] in a cryptic pronouncement, stated that though claim construction is a matter of law, "underlying fact disputes may arise pertaining to extrinsic evidence that might preclude summary judgment treatment of claim construction."[93]

Despite the mass confusion on this topic, two 1987 decisions involving bench trials offer a third option in the *McGill* line of holdings that synthesizes the three rules set down by the case law as a whole. As mentioned above, the court in *Perini*, reviewing under the clearly erroneous standard, found a dispute concerning the meaning of terms in the patent claim to present a question of

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[84] SSIH Equip. S.A. v. United States Int'l Trade Comm'n, 718 F.2d 365, 376, 218 U.S.P.Q. (BNA) 678 (Fed. Cir. 1983).

[85] *See, e.g.*, Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771, 218 U.S.P.Q.2d (BNA) 781, 788 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984) ("construction is a matter of law for the court"); Fromson v. Advance Offset Plate, Inc., 720 F.2d 1565, 1569, 219 U.S.P.Q.2d (BNA) 1137, 1140 (Fed. Cir. 1983) ("what is patented . . . is a question of law").

[86] 736 F.2d 666 (Fed. Cir. 1984).

[87] *Id.* at 672.

[88] 832 F.2d 581, 4 U.S.P.Q.2d (BNA) 1621 (Fed. Cir. 1987). Other such cases include Palumbo v. Don-Joy Co., 762 F.2d 969, 974 (Fed. Cir. 1985); Moeller v. Ionetics, Inc., 794 F.2d 653, 657, 229 U.S.P.Q. (BNA) 992, 995 (Fed. Cir. 1986); H.H. Robertson, Co. v. United Steel Deck, Inc., 820 F.2d 384, 389, 2 U.S.P.Q.2d (BNA) 1926, 1929 (Fed. Cir. 1987).

[89] Perini Am., Inc. v. Paper Converting Mach. Co., 832 F.2d 581, 584 (Fed. Cir. 1987).

[90] Cases supposedly holding claim construction completely a matter of law also exhibit such subfragmentation. *See infra* notes 119-126 and accompanying text.

[91] Palumbo v. Don-Joy Co., 762 F.2d 969, 974 (Fed. Cir. 1985).

[92] 794 F.2d 653 (Fed. Cir. 1986).

[93] *Id.* at 657.

fact.[94] The *Perini* court, however, also suggested a limited role for the fact-finder in this event; after the resolution of factual disputes, the trial was to return to the task of claim construction, a matter of law.[95] Likewise, the Federal Circuit in *H.H. Robertson, Co. v. United Steel Deck, Inc.*[96] held claim construction to be a matter of law and acknowledged factual issues only in the event of a dispute over claim terms.[97] Although neither case involved a jury, the holdings of these two decisions provide formidable guidance in dealing with the problems created by the majority's holding in *Markman*.[98]

VI. ANALYSIS

The peculiar circumstances of the *Markman* case provide a unique context for analysis. Since the designation of the Federal Circuit as the sole circuit court to hear patent appeals, the typical route of an issue to the Supreme Court, via conflict among the circuit courts, has been closed to patent issues. As a result, any patent litigation that reaches the Supreme Court must pose an issue of singular novelty.

The *Markman* holdings present an even more anomalous situation. The Federal Circuit's majority opinion, itself more than twice as long as Justice Souter's decision, combined with concurring opinions by Judges Mayer and Rader as well as Judge Newman's dissent, provides a fairly detailed analysis of the question presented. By contrast, the Supreme Court's unanimous decision disposed of the issue fairly quickly by essentially reiterating the Federal Circuit's concerns about uniformity and jury competence.

In response to this combination of the Federal Circuit's plenary authority in patent litigation and the Supreme Court's apparent inclination to defer to the Federal Circuit on the issue presented in *Markman*, this Recent Development analyzes the two courts' opinions as two parts of one basic holding, with greater emphasis on the reasoning of the Federal Circuit.

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[94] *Perini*, 832 F.2d at 584.
[95] *Id.*
[96] 820 F.2d 384 (Fed. Cir. 1987).
[97] *Id.* at 389.
[98] *See infra* note 128.

A. SIGNIFICANCE OF *MARKMAN*, ITS LIMITATIONS AND SHORTCOMINGS

Markman v. Westview Instruments, Inc. is significant in that it apparently eliminates the jury from the determination of just what qualities of an invention a patent protects. Although the issue of actual infringement remains with the jury, the holding clearly delegates the responsibility of claim construction to the court.[99] Perhaps more significantly, the Federal Circuit in reviewing patent cases no longer needs to defer to the district court's findings on the meaning of claim terms, as they are now subject to de novo review. As Judge Mayer's concurrence pointed out, the Federal Circuit basically gave itself carte blanche on review,[100] and the Supreme Court apparently does not mind this result. Indeed, the Federal Circuit's failure to remand the case precluded the type of jury determination of infringement that the majority promised its holding would preserve.[101]

Despite this broad holding, *Markman* is possibly limited by the fact that neither the Federal Circuit nor the Supreme Court addressed the roles a court and jury would play should a genuine ambiguity arise in the course of claim construction. The Supreme Court expressly refused to decide the extent to which the Seventh Amendment can be said to have crystallized a law/fact distinction, or whether post-1791 precedent classifying an issue as one of fact would trigger the protections of the Seventh Amendment if [unlike this case] there were no more specific reason for decision.[102] The Federal Circuit similarly failed to address such a situation because it believed that the statutory mandate that claim language be clear, coupled with the supervision of the Patent Office, precludes the possibility of any ambiguity in patent claim language.[103] As a result, the holdings fall short of expressly forbidding a jury's consideration of extrinsic evidence to resolve any specific ambigu-

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[99] Markman v. Westview Instruments, Inc., 116 S. Ct. 1384, 1387 (1996).

[100] Markman v. Westview Instruments, Inc., 52 F.3d 967, 993 (Fed. Cir. 1995) (en banc), *aff'd*, 116 S. Ct. 1384 (1996).

[101] *Id.* at 984.

[102] *Markman*, 116 S. Ct. at 1393 n.10. The Court went on to dismiss the possibility of genuine factual issues in patent claim construction, such as questions of expert testimony credibility, as purely theoretical. *Id.* at 1395.

[103] *Markman*, 52 F.3d at 986 (citing 35 U.S.C. § 112).

ities, such as the definition of a particular word, in the event of conflicting, equally plausible possibilities supported by substantial evidence.

As shown from the above, the flaw in the Federal Circuit's reasoning stems from its idealistic conviction that, because of statutory requirements and administrative supervision, patent claims could never be ambiguous.[104] If such a conviction has a solid foundation in actual practice, then both courts correctly restricted the fact-finder's role. Unfortunately, the reality is such that language often fails in its intended purpose, and the *Markman* holding offers no guidance for trial courts when a genuine ambiguity exists in a patent claim term.[105] Indeed, one district court grappling with the Federal Circuit's holding lamented that court's "wish to rely on a cold written record" and accused the court of "sophistry."[106]

An examination of the reasons offered by the Federal Circuit and the Supreme Court in support of their holdings reveals the shortcomings of a rule restricting jury participation solely to a determination of infringement. One reason the courts cited is the in-

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[104] *Id.* at 986. Specifically, the court contends if "the patent's claims are sufficiently unambiguous for the PTO [Patent and Trademark Office], there should exist no factual ambiguity." *Id.* at 986. One article has noted that "[i]n essence, the Federal Circuit judicially pronounced all patent claims as without ambiguity. This may come as a surprise to many practitioners who sometimes are puzzled over the meaning of a claim term." Joseph R. Re & Joseph F. Jennings, *Answers and Questions Raised by the Federal Circuit's* Markman *and* Hilton Davis *Decisions, in* WINNING STRATEGIES IN PATENT LITIGATION, at 877 (PLI Pats., Copyrights, Trademarks, & Literary Prop. Course Handbook Series No. G4-3952, 1995). The Supreme Court's affirmation solidifies this result.

[105] Judge Newman's dissent criticized the majority for creating:

> [A] procedural quandary, for extrinsic evidence can apparently be received, but no jury can weigh it. When the extrinsic evidence is in conflict—as it invariably is—what then? Will the Federal Circuit itself weigh the evidence of expert witnesses? Will we receive a collection of self-serving affidavits, without examination and cross-examination? Such a procedure surely is not optimal for cases that may require decision of complex . . . processes.

Markman, 52 F.3d at 1006.

[106] Lucas Aerospace, Ltd. v. Unicon Indus., 890 F. Supp. 329, 333 n.7, 36 U.S.P.Q.2d (BNA) 1235 (D. Del. 1995).

creased consistency of interpretation by judges in patent cases.[107] The first problem with this rationale lies in the fact that most patent cases are already tried before judges, not juries.[108] Indeed, the Federal Circuit relied mainly on bench trials in support of its holding.[109] As such, the Federal Circuit and the Supreme Court, instead of questioning jury dependability, might better be understood to claim that the Federal Circuit alone may be depended upon to interpret patent claims with accuracy and consistency (a stunning proposition given the multiple opinions in the Federal Circuit), since a trial judge's interpretation is now subject to de novo review even when the judge believes a patent claim presents factual questions.

The courts' refusals to provide district judges any guidance concerning disputed terms supports the above conclusion.[110] Whatever the motivation, such a situation benefits neither party in a patent case, who now can plan on the extra expense of an appeal any time a dispute arises as to a claim term.[111] Patent cases might as well be allowed to circumvent the trial stage completely.[112]

The reliance on judicial consistency suffers from another weakness. While the opinions of many plaintiffs' attorneys may

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[107] *Markman*, 116 S. Ct. at 1396; 52 F.3d at 978-79. Judge Mayer's concurring opinion attacked the majority for attempting to create a "complexity exception" to the Seventh Amendment. *Markman*, 52 F.3d at 993. On the idea of a "complexity exception," *see* Kirst, *supra* note 3 (providing detailed account of modern movement for complexity exception to right to trial by jury and historical underpinnings of movement).

[108] Gary M. Ropski, *Constitutional and Procedural Aspects of the Use of Juries in Patent Litigation*, 58 J. PAT. OFF. SOC'Y 609, 610-11 (1976).

[109] The following cases cited by that court were tried without a jury: SSIH Equip. S.A. v. United States Int'l Trade Comm'n, 718 F.2d 365 (Fed. Cir. 1983); Kalman v. Kimberly-Clark Corp., 713 F.2d 760 (Fed. Cir. 1983); Fromson v. Advance Offset Plate, Inc., 720 F.2d 1565 (Fed. Cir. 1983); Specialty Composites v. Cabot Corp., 845 F.2d 981, 6 U.S.P.Q.2d (BNA) 1601 (Fed. Cir. 1988); Unique Concepts, Inc. v. Brown, 939 F.2d 1558, 19 U.S.P.Q.2d (BNA) 1500 (Fed. Cir. 1991).

[110] Judge Newman's dissent lamented the imposition on trial judges of "uncertain procedures." *Markman*, 52 F.3d at 999.

[111] Expenses will even mount at trial, as demonstrated by one district court that held a two-day "Markman trial" after the Federal Circuit's holding in order to resolve disputed claim language. ELF Autochem N. Am. v. Libbey-Owens-Ford Co., 894 F. Supp. 844, 850, 37 U.S.P.Q.2d (BNA) 1065 (D. Del. 1995).

[112] Judge Newman's dissent wondered "how a record will be developed for the Federal Circuit's de novo decision" under the majority's holding. *Markman*, 52 F.3d at 1005.

weigh in for the proposition that judges are more reliable than juries, no empirical evidence shows that "each of the more than 500 trial judges can be guaranteed to reach more 'correct' judgments than those entered on jury verdicts."[113] In fact, "judges are often at a loss to comprehend complex science and technology issues,"[114] so the court's ostensible reliance on judges may well be misplaced.

As an explanation for its own holding, the Federal Circuit syllogized that because written evidence is a matter for the court and patents are written evidence, interpretation of patent language should be reserved for the court.[115] The court also opined that the special nature of the patent as a governmental grant of rights further requires that those rights be defined by the court.[116] Ironically, though the court later rejected the analogization of patents to contracts, it cited a treatise on contracts to support its argument.[117] In refuting the analogization of patents to contracts, the court even went so far as to compare patents to statutes.[118] In attempting to analogize patents to (or distinguish them from) contracts and statutes, the majority, Judge Mayer's concurrence, and Judge Newman's dissent all failed to consider the option of treating patents as a third category of written evidence with likenesses to, and differences from, both contracts and statutes. Such a failure ignores both the general statutory nature of patents as governmental grants of rights and their contractual nature as individual documents protecting specific, bargained-for

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[113] Markey, *supra* note 43, at 372. Judge Mayer's concurring opinion stated "there is simply no reason to believe that judges are any more qualified than juries to resolve the complex technical issues often present in patent cases." *Markman*, 52 F.3d at 993. The dissent likewise doubted "that an appellate court's de novo finding of technologic facts is more likely to attain accuracy, than the decision of a jury or judge before whom a full trial was had." *Id.* at 1005. *See generally* Anderson v. City of Bessemer City, 470 U.S. 564, 574-75 (1985) ("Duplication of the trial judge's efforts in the court of appeals would very likely contribute only negligibly to the accuracy of fact determination . . .").

[114] Stephen B. Judlowe & Lee A. Goldberg, *Jury Trials*, *in* PATENT LITIGATION 1994, at 173 (PLI Pats., Copyrights, Trademarks, & Literary Prop. Course Handbook Series No. G4-3929, 1994).

[115] *Markman*, 52 F.3d at 978. The Supreme Court made similar noises. *Markman*, 116 S. Ct. at 1395-96.

[116] *Markman*, 52 F.3d at 978.

[117] *Id.*

[118] *Id.* at 987.

rights of individual entities. These characteristics require the clearly delineated collaboration of judge and jury.

Two Federal Circuit opinions and two Supreme Court decisions relied on by the Federal Circuit subtly suggest that the jury should play a role in the event of ambiguous patent claim language. The Federal Circuit in *Senmed v. Richard-Allan Medical Industries*[119] spoke of "facts on which the claim interpretation must rest,"[120] implying the possibility of jury questions in claim construction. Similarly, the suggestion in *Intellicall, Inc. v. Phonometrics, Inc.*[121] that "disagreement over the meaning of a term within a claim does not *necessarily* create a genuine issue of material fact"[122] implies that such a factual issue could occur.

Surprisingly, some Supreme Court opinions relied on by the Federal Circuit also intimate the existence of factual issues in patent claim construction. The Court in *Market Street Cable Railway v. Rowley*[123] noted that because a question involved no evidentiary issues, it required no facts to be considered by the jury.[124] In *Singer Manufacturing v. Cramer*,[125] the Court likewise considered an issue of claim construction to be a matter of law because the inventions described in the patents were comprehensible.[126] By distinguishing their own facts from a situation with ambiguous claim language, the Court in both cases assumed the possibility of factual disputes underlying patent claim construction.

B. PROPOSAL FOR BETTER INCORPORATION OF THE JURY INTO PATENT LITIGATION

As many of the cases suggest, including some relied on by the Federal Circuit, the jury should play a role in patent litigation beyond mere determination of infringement. Judge Newman's dissent noted that determination of the meaning of terms "is often

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[119] 888 F.2d 815, 12 U.S.P.Q.2d (BNA) 1508 (Fed. Cir. 1991).
[120] *Id.* at 818 n.7.
[121] 952 F.2d 1384, 21 U.S.P.Q.2d (BNA) 1383 (Fed. Cir. 1992).
[122] *Id.* at 1387 (emphasis added).
[123] 155 U.S. 621 (1895).
[124] *Id.* at 625.
[125] 192 U.S. 265 (1904).
[126] *Id.* at 275.

dispositive of the question of infringement."[127] Thus the courts' purported preservation of the jury in patent cases seems only a pretense. A better method of dealing with the issue of the jury's role in patent claim construction than that employed by the courts is to keep the jury out of the process as long as the claim language is clear, because in that case no dispute as to facts exists. Should a linguistic ambiguity arise, however, the trial judge could instruct the jury to decide that single narrow issue of fact.[128] Such factual findings would be reviewable under a clearly erroneous standard, while the ultimate legal question of the meaning of the properly interpreted claim would remain subject to de novo review. As Judge Mayer's concurrence suggested, the trial judge could additionally instruct the jury to give extrinsic evidence little weight compared to the specifications, claims, and patent history.[129] Thus, this approach avoids the type of blurring or ignoring of the distinction between factual and legal issues in patent claim construction that currently permeates much of the case law.

This method offers several advantages over the *Markman* holdings. First, it recognizes the special nature of patents as something between contracts and statutes, both of which sometimes require extrinsic evidence in resolving ambiguities. Though Judge Mayer's concurrence offers the same basic notion, that notion is premised on the faulty analogy of patents solely to contracts.[130]

Second, the Federal Circuit was created to encourage uniformity in patent law.[131] The proposal presented here gives a clear rule and will perpetuate the Federal Circuit's mandate to provide uniformity not by granting the court power essentially to retry

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[127] Markman v. Westview Instruments, Inc., 52 F.3d 967, 999 (Fed. Cir. 1995) (en banc), *aff'd*, 116 S. Ct. 1384 (1996). The dissent further noted that in *Markman* itself, the trial judge's definition of "inventory" decided the question of infringement for all practical purposes. *Id.*

[128] Judge Mayer's concurrence offered nearly the same resolution. *Id.* at 997. Although *Perini* and *Robertson* involved bench trials, the Federal Circuit announced an analogous rule in those cases. *See supra* notes 94-98 and accompanying text. This rule differs from the rules in either *McGill* or *Palumbo*, which did not clearly limit the jury's role in the event of ambiguity. Instead, those cases left room to infer that the jury could interpret the entire claim in the event of an ambiguous term. *See supra* notes 87, 91 and accompanying text.

[129] *Markman*, 52 F.3d at 991.

[130] *Id.* at 997.

[131] *Markman*, 116 S. Ct. at 1396.

every case, but by helping the district courts to properly allocate factual and legal issues and thus to ensure that few cases require appellate review solely over a disputed claim.[132] Such a result is also economically efficient.

Finally, the proposed rule preserves the important role of the jury as fact-finder.[133] After an instruction to take extrinsic evidence lightly, the rule narrowly allows the jury to interpret the meaning of disputed terms. By not allowing the jury to interpret the remainder of the claim, the rule preserves the historical role of the jury as fact-finder while recognizing the special dual nature of patent claims.

The proposed rule would have worked well in *Markman* itself. Had the district court in *Markman* adhered to this method of analysis, the judge would not have instructed the jury to "determine the meaning of the claims."[134] The court would have retained the ultimate responsibility for that undertaking. Nor would the district judge simply have charged that "[a]lso relevant are other considerations that show how the terms of a claim would normally be understood by those of ordinary skill in the art."[135] In contrast, under the proposed rule, the judge, while in the process of construing the claim, would have allowed the jury to resolve the dispute over the term "articles." The judge would have instructed the jury to give any evidence other than the patent specifications, claims, and prosecution history little weight. After a determination by the jury on that term, the judge would have finished the process of claim construction and then would have allowed the jury to determine whether Westview's invention infringed upon the

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[132] Conversely, the rule will not allow district courts to manipulate the standard of review that might be applied on appeal. *See generally* Rochelle C. Dreyfuss, *The Federal Circuit: A Case Study in Specialized Courts*, 64 N.Y.U. L. REV. 1, 49 (1989) (expressing concern that district courts can use current "indeterminacy of the fact/law distinction to insulate their findings from review").

[133] One commentator has stated, "[w]e didn't have jury trials back in the 50's or the 60's. We have them now because that was the only way that a patentee could get a favorable decision. I think we should not be too fast to change things. . . ." Symposium, *Abolition of Jury Trials in Patent Cases*, 34 IDEA: J.L. & TECH. 77, 84 (1994) (publishing transcript of conference discussion of jury in patent cases) (commentary by Prof. Robert Shaw). *See generally* Kirst, *supra* note 3, at 38 (discussing jury's value).

[134] Markman v. Westview Instruments, Inc., 52 F.3d 967, 973 (Fed. Cir. 1995) (en banc), *aff'd*, 116 S. Ct. 1384 (1996).

[135] *Id.*

properly interpreted claim.

As a result of these considerations, the jury's interpretation of the disputed term "articles," instead of having to be inferred from the verdict, would have been carefully elicited under proper instructions that would have precluded the jury from giving Markman's testimony (as well as that of three other witnesses) the importance that the jury apparently gave it. Additionally, the duty of determining infringement, which even the majority in *Markman* agrees belongs to the fact-finder, would not have been usurped by summary judgment before the jury had a chance to determine infringement of properly interpreted claims.

VII. CONCLUSION

Patent claims, similar to contracts in some ways and to statutes in others, hold a strange position in the realm of written instruments. The *Markman* decisions, in grappling with this peculiarity of patent claims, alert patent attorneys to changes in the way district courts will try patent cases. Unfortunately, instead of clarifying the boundaries between judge and jury in patent cases, the Federal Circuit and Supreme Court have refused to address the problem of genuine ambiguity in patent claims. They have instead characterized the facts of *Markman* as falling outside of such a category and dismissed the possibility of such a genuine ambiguity as extremely marginal.

In the event the Federal Circuit encounters a situation that it is willing to characterize as presenting a genuine ambiguity in a patent claim, a sui generis rule allocating duties to judge and jury such as the one proposed here offers a viable means to achieve a balance among the policies of providing jury trials as required by the Seventh Amendment, ensuring a proper allocation of duties between judge and jury, and encouraging uniformity in patent litigation. Absent such a rule, however, attorneys who confront real ambiguities in patent claims may find themselves facing de novo scrutiny of what seems to them a factual question.

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