

MARKMAN MISSES THE MARK, MISERABLY

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*“When I use a word,” Humpty Dumpty said, in rather a scornful tone, “it means just what I choose it to mean—neither more nor less.”
“The question is,” said Alice, “whether you can make words mean so many different things.”
“The question is,” said Humpty Dumpty, “which is to be master—that’s all.”¹*

I. THE ISSUE

The United States Supreme Court’s decision in *Markman v. Westview Instruments*² has dramatically changed the stage for patent litigation, especially jury trial patent litigation. A patent document filed with the U.S. Patent and Trademark Office (“the PTO”) ends with a series of claims that defines the metes and bounds of the intellectual property right from which other inventors are to be excluded.³ Likening these claims to clauses in a contract, the Court in *Markman* stated that the interpretation of these claims is to be in the exclusive province of the court, not the jury.⁴ As a result, claim interpretation of patents is now normally done in a separate hearing outside the presence of the jury, known as a “*Markman* hearing.”⁵ Most often, the hearing is based only upon briefing and intrinsic evidence, which includes the transactional documents leading up to the issuance of the patent and, occasionally, dictionary or treatise definitions of words.⁶ It is in the discretion of the

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1. LEWIS CARROLL, *ALICE’S ADVENTURES IN WONDERLAND AND THROUGH THE LOOKING GLASS* 219 (George Stode ed., 2004) (1871) (emphasis in original).

2. 517 U.S. 370 (1996).

3. KIMBERLY A. MOORE ET AL., *PATENT LITIGATION & STRATEGY* 226 (2d ed. 2003) [hereinafter *PATENT LITIGATION*].

4. *Markman*, 517 U.S. at 376.

5. *PATENT LITIGATION*, *supra* note 2, at 237–38.

6. *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

trial court whether to accept evidence (i.e., extrinsic evidence in the form of expert testimony) in a *Markman* hearing.⁷ Nearly every patent case now has a *Markman* hearing for claim construction at some point in the proceedings, followed by the usual motion for summary judgment, and, in the end, a trial.⁸ The result is that disputes over claim terminology are now decided by judges, not juries.

The Court of Appeals for the Federal Circuit has held that claim construction is a legal question, reviewable de novo.⁹ However, a trial court's interpretation of claim terms in a *Markman* hearing cannot be placed before the Federal Circuit on an interlocutory basis.¹⁰ Therefore, patent cases often are tried on incorrect claim interpretations, which results in a high percentage of appellate reversals.¹¹ This system is flawed and based upon an erroneous assumption: that courts of general jurisdiction have special expertise in interpreting patent documents. *Markman* also increases the cost and burden of already expensive patent litigation, dramatically changes the scope of and process for deciding patent cases, and could impinge on the Seventh Amendment right to a jury trial. The *Markman* experiment of the last nine years should be declared a failure.

II. THE OLD WAY IS BETTER

Any changes that take patent litigation out of the mainstream of the normal litigation process are detrimental to the legal system. For example, in an ordinary contract case, lawyers, judges, and juries experience minimal evidentiary problems because extrinsic evidence is admissible only when the contract terms are ambiguous.¹² Otherwise, the court simply instructs the jury as to the meaning of the contract term in dispute.¹³ The jury, in turn, decides whether the term has been breached.¹⁴

Why not have the same rule in a patent case? It used to exist.¹⁵ In *McGill v. John Zink & Co.*, an invention related to a chemical process required meaning to be given to the claim phrase "recovered liquid hydrocarbon absorbent."¹⁶ The dispute centered on the meaning of the

7. See, e.g., *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1216 (Fed. Cir. 1995).

8. See PATENT LITIGATION, *supra* note 2, at 237-38.

9. *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1299 (Fed. Cir. 2004).

10. See, e.g., *Flores v. Union Pac. R.R.*, 101 F.3d 715 (Table, Case No. Misc. Docket No. 474) (Fed. Cir. 1996) (full text format available at 1996 U.S. App. LEXIS 31117).

11. Kimberly A. Moore, *Are District Court Judges Equipped to Resolve Patent Cases?*, 15 HARV. J.L. & TECH. 1, 2 (2001) (concluding that 33 percent of cases appealed to Federal Circuit involve improperly construed patent claims).

12. See, e.g., *United Rentals (N. Am.), Inc. v. Keizer*, 355 F.3d 399, 409-10 (6th Cir. 2004).

13. See, e.g., *Coats v. Gen. Motors Corp.*, 39 P.2d 838, 845 (Cal. Ct. App. 1934).

14. *Id.*

15. See *McGill, Inc. v. John Zink & Co.*, 736 F.2d 666 (Fed. Cir. 1984).

16. *Id.* at 668.

term “absorbent.”¹⁷ If it meant one thing, the patent was infringed; another, and it was not. Ordinary tools of claim construction—such as examination of the transactional documents, the patent specification, differentiation of patent claims, and expert witness testimony—were used.¹⁸ In particular, each party called its own technical expert to testify.¹⁹ The jury was allowed to hear all the evidence and then decide what the term “absorbent” meant factually in the context of the invention.²⁰ This was the state of the Federal Circuit in 1984.

Since *Markman* in 1996, juries are no longer allowed to determine the meaning of a patent claim. To illustrate, a trial court may hold a separate and distinct *Markman* hearing on a claim at a point in the litigation that it sees fit. The court hears arguments from counsel, invites briefs from counsel, and, if it so chooses, listens to extrinsic evidence; against this background, the court then decides what the disputed claim means. This might imply that the defendant is virtually certain of prevailing on summary judgment if its claim construction is accepted. If not, it may mean the patent case will go to a jury since infringement is a question of fact.²¹

Thus, *Markman* shifts one of the defining decisions of a patent case from the jury to the judge. Judge Mayer of the Federal Circuit has long recognized this. Beginning with the *Markman* decision itself, he consistently has failed to join majority Federal Circuit decisions that take this infringement issue away from the jury.²² He characterizes it as an impingement on the Seventh Amendment right to a jury trial, which it is.²³

III. MARKMAN AFTER NINE YEARS

Markman has been law for nine years, resulting in specific local rules on patent cases being adapted to include *Markman* hearings.²⁴ Defendants ask the court to define almost every word in the patent claims at issue.²⁵ In effect, *Markman* has encouraged defendants to rewrite patent claims to the point where the construed claim hardly resembles the claim allowed by the PTO during prosecution. No such rewrites should be allowed. Instead, patent claims should be like the Ten

17. *Id.* at 672–73.

18. *See id.* at 673–76.

19. *Id.* at 675.

20. *Id.* at 671.

21. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384 (1996).

22. *E.g.*, *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 989 (Fed. Cir. 1995) (Mayer, J., concurring).

23. *See id.*

24. PATENT LITIGATION, *supra* note 2, at 240 (citing the Northern District of California’s Local Rules of Practice in Patent Cases, which “specifically address claim construction procedures and hearings in patent cases”).

25. *See Exxon Chem. Patents v. Lubrizol Corp.*, 64 F.3d 1553 (Fed. Cir. 1995) (using strong language that encourages defining as many words as possible).

Commandments—cast in stone, unalterable. How did the law change? What has gone so wrong? Why has the right to a jury trial on an admitted factual question of infringement been so diluted? The majority of the blame falls on the Supreme Court's *Markman* decision. It represents an experiment which time has proven a failure.

Most important, yet often forgotten, are the individual rights of inventors. The Constitution specifically protects those rights,²⁶ and remains silent on patent claims. Inventors do not invent patent claims; instead, they invent tangible things—machines, processes, plants, etc.—created to better the useful arts. Claims are but symbols that represent those inventions. To the extent courts focus on the symbols, rather than on the merits of the invention, they frustrate the constitutional purpose of patents.

Patent litigation has become notoriously expensive. A recent American Intellectual Property Law Association survey shows that the garden-variety patent case incurs attorneys' fees of at least one million dollars.²⁷ A case of any substance or size normally has larger fees, typically within the range of one to two million dollars.²⁸ These ever-escalating costs are, in part, a result of requiring a separate *Markman* hearing, followed by discovery, the inevitable summary judgment motions, and, finally, a trial. Plaintiffs must prevail twice before they ever have a chance for a judgment! Also, as previously discussed, claim construction is not normally a matter available for interlocutory appeal. The trial court cannot be certain about its *Markman* hearing decisions until the entire case is tried and appealed. Moreover, while many quibble about the statistics, somewhere between 40 and 60 percent of the district courts' claim construction decisions via *Markman* hearings are reversed by the Federal Circuit.²⁹ Trial courts, therefore, do not find *Markman* particularly helpful, but rather one more burden on their very busy dockets.

IV. SKILLFUL TRIAL JUDGES

Skillful trial judges can simply avoid *Markman* by correctly hiding behind the Seventh Amendment right to a jury trial. This point can be illustrated by one of my cases heard in the Northern District of Illinois. Under the facts, the patent concerned defibrillator pads requiring that stannous chloride be "affixed to the tin." These pads are used to give an

26. U.S. CONST. art. I, § 8, cl. 8.

27. AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION, AIPLA REPORT OF THE ECONOMIC SURVEY 2003 1, 19 (2003).

28. *Id.*

29. Robert H. Resis, *Reducing the Need for Markman Determinations*, 4 J. MARSHALL REV. INTELL. PROP. L. 53, 53 (2004) (citing statistics from 2003, when the Federal Circuit reversed 53 percent of cases where the district court's claim construction was at issue, changing the ultimate result in 45 percent of those cases), available at <http://www.bannerwitcoff.com/articles/markmanresis.pdf>.

electrical shock to a person suffering a heart attack. The plaintiff contended that stannous chloride “affixed to the tin” could mean physically bonded, whereas defendant contended that it must be chemically bonded to infringe. A *Markman* hearing was dutifully held. The trial court, crafting its conclusion after a one-week *Markman* hearing, determined that “affixed” had no special meaning and that it was for the jury to determine whether the stannous chloride of defendant’s structure was, in fact, “affixed to the tin.” The jury was so instructed. The case was never appealed, but consider that jury instruction if it had been. The court held that “affixed” is a question of fact. Was the trial court correct that the issue was not a question of law or claim construction at all, but one of fact to be answered in the context in which the word was used in the patent? Do the trial court’s actions not make perfect sense? Was the trial court likely to be affirmed on appeal, knowing that everybody agrees infringement is a jury question? Why did this judge stick his neck out? Most will not. The result of most *Markman* hearings is wasted effort and expense, as well as generalist judges opining on the meaning of words in scientific disciplines with which they have no familiarity. As Judge Learned Hand said, in the context of generalist judges deciding the mixed fact/law question of obviousness of inventions, “We do not see how such a standard can be applied at all except by recourse to the earlier work in the art To judge on our own . . . is to substitute our ignorance for the acquaintance with the subject of those who are familiar with it.”³⁰ His straightforward argument persuades that the meaning of scientific-based words should be determined in the context of their use in the art, not in the vacuum of judicial chambers.

Why has *Markman* caused so much trouble? I was first confronted with *Markman* at the beginning of a trial set to start days after the hearing. Nine years later, in 2004, I appeared in front of the same judge for another *Markman* hearing. To quote him (anonymously), “*Markman* is of no help to me.” Why is it that a federal judge would say *Markman* is of no help? It is because *Markman* is based on the false premise that judges have more expertise in interpreting patent claims than experts in the art. In fact, they have less. Almost all judges would say they would benefit from knowing what the words mean in the context of the art in which they are spoken. For example, everyone knows the word “battle” means one thing in defining a chess match and another in war. Yet the Federal Circuit tells these judges that, in most cases, the intrinsic evidence is enough to decide what words mean, leaving them to do so in that vacuum. Judges easily are able to interpret words in ordinary commercial contracts because they are familiar with them. Their law school education and life experiences make them familiar with those words. However, the word “affixed,” such as a seal affixed to a

30. *Reiner v. I. Leon Co.*, 285 F.2d 501, 504 (2d Cir. 1960).

document, has a meaning in everyday language that may be totally different from the meaning of “affixed” in the context of a chemical patent relating to defibrillation electrodes! Therein lies another false premise of *Markman*: words have just one true meaning. Words simply have no meaning except in the context of their use.³¹ Distinguished jurist Justice Roger Traynor of the California Supreme Court recognized these essential points in the context of contract interpretation long ago. He declared that the plain meaning rule is “a remnant of a primitive faith in the inherent potency and inherent meaning of words.”³²

Consider, for example, the exclamatory declaration “Oh!”. Depending upon inflection and context of use, it can be an expression of surprise, cynicism, or doubt. Is it any wonder that patent lawyers find common words of everyday language to fight about in every patent claim? Even in *Markman* itself, the word of dispute was hardly sophisticated. One side said “inventory” in the context of a dry cleaner’s system referred to clothing inventory, and the other side urged invoice inventory.³³ This is a classic example of why *Markman* simply does not, cannot, and will not ever work. Who better than a jury, after hearing experts explain the word in the context of the art, to decide? They will have heard a direct examination and cross-examination, observed witness demeanor, and applied their own common sense.

The Federal Circuit is now in the process of deciding en banc another case, *Philips v. AWH Corp.*,³⁴ that will allow it to revisit some of the claim construction rules spawned by the 1996 *Markman* decision. The court should take advantage of this opportunity to provide a strict limit to *Markman* in order to uphold the sanctity of the Seventh Amendment right to a jury trial. Anything less will jeopardize the constitutional rights of inventors and will perpetuate the current mindless and endless litigation over the meaning of words. An enlightened new Federal Circuit ruling would promote the point of Lewis Carroll’s Humpty Dumpty: “When I use a word, it means just what I choose it to mean, neither more nor less.”

31. LUDWIG WITTGENSTEIN, PHILOSOPHICAL INVESTIGATIONS §§ 134–142 (G.E.M. Anscombe trans., 2d ed. 1958) (1945) (emphasizing significance of the way words are used in linguistic interactions within a relevant community).

32. *Pac. Gas & Elec. Co. v. G.W. Thomas Drayage & Rigging Co.*, 442 P.2d 641, 643–44 (Cal. 1968).

33. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 375 (1996).

34. 376 F.3d 1382 (Fed. Cir. 2004).