

# LITIGATORS CORNER: *Markman* Eight Years Later



BY JOSEPH N. HOSTENY,  
OF NIRO, SCAVONE,  
HALLER & NIRO

*Regular IP Today columnist Joseph N. Hosteny is an intellectual property litigation attorney with the Chicago*

*law firm of Niro, Scavone, Haller & Niro. A Registered Professional Engineer and former Assistant US Attorney, his articles have also appeared in Corporate Counsel Magazine, The Docket (American Corporate Counsel Association), American Medical News, Inventors' Digest, Litigation Magazine and Assembly Engineering Magazine. Listed in Who's Who, Mr. Hosteny was recently named to the Board of Editors of Patent Strategy & Management (a monthly publication of American Lawyer Media), for which he will also be writing periodic guest columns. Mr. Hosteny can be reached at (312) 236-0733, or by e-mail at [jhosteny@hosteny.com](mailto:jhosteny@hosteny.com), or by visiting his web site at <http://www.hosteny.com>.*

A few weeks ago, I was working on a claim construction brief and quoted from *Markman v. Westview Instruments*, 52 F.3d 967 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996). When lawyers face a deadline for a brief, we read cases quickly. If the case we want to quote from is familiar to us, we may not read it at all, except to find the language we want to quote. After my brief was out the door, I wondered if I was as familiar with *Markman* as I thought I was. I decided it was time to go back and read both the majority and dissenting opinions, slowly and carefully. How would *Markman's* reasoning stand up today? Did its predictions come true? And how will *Markman* fare in the future? Will it be good law decades from now, like *Marbury v. Madison*? Or will it represent a blind alley, a decision left in the dustbin, like the Supreme Court's opinions in *Dred Scott v. Sandford* or *Plessy v. Ferguson*?

Herbert *Markman's* patent claimed an inventory control system for dry-cleaning clothing. Each shirt, dress or suit was tagged and entered into a computer. The defendant, Westview, said that its control system did not store any information about clothing, only invoice numbers, dates and cash totals. The only testimony about how

to interpret the patent came from *Markman* and his expert; Westview offered only legal argument. There was no other extrinsic evidence. The jury found for *Markman*, but the district court tossed the verdict, because Westview's system did not have an inventory of clothing.

The Federal Circuit affirmed, but went much, much farther. It decided that claim construction was, for all cases, for all patents, and for all time, a pure question of law that never involved any factual question. Claim construction therefore never, ever required a jury — that entity which is regarded with so much suspicion by some who believe that a single legally trained mind is a superior decision-maker. Of course, those legally trained minds are the ones whose decisions are getting reversed on claim construction nearly half of the time by the Federal Circuit.

One prediction of the majority opinion in *Markman* was that a decision by a judge on claim construction would enable competitors reliably “to ascertain to a reasonable degree the scope of the patentee's right to exclude.” Of course, that hasn't happened at all. In fact, the opposite has happened. We cannot trust the plain meaning of words in the patent because litigants twist them, arguing, for example (as I mentioned in my last month's column), that “about” means “not less than.” Even if the prediction by the *Markman* majority were correct, it has nothing to do with whether the decision is about law made by a judge, or is a decision about facts made by a jury. All that is necessary is that a decision be made, so that the result may be known. And we don't have even a bit of finality resulting from a decision by a judge, because everyone knows those decisions are not final.

Another prediction of the *Markman* majority opinion was that “arriving at a true and consistent scope of the claims also works to the benefit of the patentee,” because a reliable decision by a judge will enable the inventor “to maintain his privilege as thus interpreted, against all opponents without further controversy in reference to its true limitations.” (An interesting choice of word, **privilege** instead of **right**, don't you think?) Patentees are not benefiting. They are getting tortured. We might as well flip coins, or hire champions to do battle. It would cost less, and be faster, and just as reliable. Claim construction is so

capricious that it reminds me of the bridge scene in Monty Python's *Holy Grail* where, if you cannot answer a nonsensical question, like “What is the speed of an unladen swallow?”, you are hurled into the abyss. In claim construction hearings, though, it isn't funny; we are playing with the dreams and hard work of inventors. That deserves more respect.

Nor, as I wrote last month, is there the slightest scrap of future benefit to a patentee “against all opponents.” Claim constructions get done, then get done again in any succeeding case involving the same patent but a different infringer. No patentee will ever be able to say to a second infringer that the issue of claim construction was settled “without further controversy” in a lawsuit against a first infringer. That can only happen when the claim construction is disadvantageous to the plaintiff.

*Markman* didn't have to decide, and should not have decided, that claim construction is always a question of law. Judge Rader said in his concurring opinion that:

Whether claim construction can involve subsidiary fact issues is not before us. It is our duty not to rule on this question. The court should decline to answer a question better left to a case that truly raises it, and therefore provides an informed basis for its resolution.

*Markman* disobeys a hallmark of judicial restraint — don't decide any more than is necessary to resolve the case before the court — and then unwisely promises us that judges are better decision-makers than jurors.

However well-meant the predictions were in *Markman* about the benefits to the patentee and its competitors in understanding the patent, and the future benefits to the patentee in protecting his “privilege,” those predictions have not come true. These premises of the *Markman* majority opinion, therefore, were incorrect.

Another prediction of the *Markman* majority was that no factual issues would ever have to be decided in claim construction. But as Judge Rader wrote in his concurrence, *Markman* didn't have facts calling for such a decision. There were no factual conflicts in *Markman*. The only issue was the meaning of “inventory,” and testimony about the correct interpretation of that word from only one side of the case. The testimony was not contradicted.

It would have been easy to rule that the meaning of inventory was in this instance a question of law, because the intrinsic evidence was consistent and clear, rendering unnecessary any reference to extrinsic evidence, such as the testimony of

# DOCUMENT DELIVERY IN MANY LANGUAGES.

- File Histories
- Patents
- Prior Art Searches
- PTO Hand Delivery
- Trademarks

\$39

• Instant Japanese  
Patent Translations

- Fully Certified  
Translations



1.800.422.1337 Fax: 1.800.421.5585 email@Reedfax.com

www.Reedfax.com

A service of Reed Technology  
and Information Services, Inc.

Markman's expert. The question whether claim construction ever includes factual issues could and should have been left for another day.

But the majority didn't do that. It pushed aside as erroneous those of its prior decisions that did not support the result the majority sought. The dissents by Judges Mayer and Newman do a much better job of analyzing those cases than does the majority. Not all patent cases are alike. There were no disputed facts in *Markman*. But in other cases, there are. For example, in a claim construction hearing our firm just held, each side presented a witness testifying how parts of a patent for a television control system would be read by a person of ordinary skill in the art. The two witnesses disagreed. If the court decides that the claims cannot be construed based only on intrinsic evidence, then reference to extrinsic evidence becomes necessary. Should that occur in our case, the court will have to decide which expert to believe. That is resolving disputed facts, and is the function of a jury under our Constitution.

Yet the *Markman* majority opinion contains the remarkable statement that a court which uses extrinsic evidence is not engaged in fact-finding when it uses "certain extrinsic evidence that the court finds helpful and reject[s] other evidence as

unhelpful . . ." The opinion continues this fiction by asserting that "the court is not crediting certain evidence over other evidence or making factual evidentiary findings." But a court that selects one piece of evidence as preferable to another, even if it is only choosing which dictionary to read, is certainly crediting some pieces of evidence over others. That choosing is fact-finding.

The *Markman* majority added that extrinsic evidence isn't meant to interpret the claims, but only to "assist" the court in "understanding" the technology and background of the invention. But even then a court confronted with two disagreeing witnesses is going to have to make a choice. No one can reasonably say that such a decision doesn't involve facts, or that it doesn't involve choosing among the facts. A jury is supposed to do that job, unless the parties consent otherwise.

*Markman* is wrong about the superiority or reliability of a judge as a decision-maker. *Markman* is wrong about the benefits, both for the patentee and the patentee's competitors, that were supposed to result from a purely legal and highly reliable analysis of a patent as a question of law. And last, *Markman* wrongly forced the conclusion that no claim construction ever includes questions of fact as well as law. We are no longer in the frying pan; we are now in the flames.

I hope that one day the dissents by Judges Mayer and Newman represent the law, like Justice Harlan's dissent in *Plessy v. Ferguson*. The stakes are important. We are dealing here with two constitutional issues: the protection offered those who make discoveries, and protection of the right to trial by jury. If the right to jury trial gets eroded in patent cases, other civil cases may not be far behind. To be different from England with respect to civil juries was so important that we provided for it in the Bill of Rights.

If *Markman* was a success, why then did a recent AIPLA e-mail report that Congress says there is "broad agreement" that patent law reform is needed? The truth is, we don't need any reform. What we do need is an effective Patent Office with adequate funding. Attempts at reform are doomed unless and until we have a Patent Office that can do a better job. And when we have a Patent Office that is adequately funded, we won't need the so-called reforms. How nice it would be if the statute books were not constantly being revised. Then we would have a real chance at predictability for patentees and their competitors. Lord, please save us from the reformers! **IPT**