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BIFURCATION - A NEW ERA IN PATENT LITIGATION

I. INTRODUCTION

During the 1994-95 term, the United States Court of Appeals for the Federal Circuit (CAFC) attempted to resolve which aspects of patent litigation are a question of law and which are a question of fact.¹ In *Markman v. Westview Instruments, Inc.*,² the CAFC held that patent claim construction is a matter of law for the court to decide.³ In addition, the CAFC stated that any disputes over the meaning of terms used within the patent claim are also matters of law.⁴ A

¹ *Markman v. Westview Instrument, Inc.*, 52 F.3d 967, 970-89 (Fed. Cir. 1995), *cert. granted*, _ U.S. __, 116 S. Ct. 40, 64 U.S.L.W. 3238 (U.S. Sept. 27, 1995) (No. 95-26); *see generally* Martin J. Adelman, *En Banc on Claim Construction and Equivalents*, 396 P.L.I. PAT. 681 (1994) (listing the issues in *Markman*); Richard E. Backus, *En Banc on Claim Construction and Equivalents*, 396 P.L.I. PAT. 775 (1994) (discussing the latest CAFC decisions). The Federal Circuit ordered sua sponte that *Markman* be heard en banc. *Markman*, 52 F.3d at 970 n.1. Originally the Federal Circuit also ordered *Pali Corp. v. Micron Separations, Inc.*, 66 F.3d 1211 (Fed. Cir. 1995) heard en banc, but after deciding similar issues in *Markman*, returned the case to the CAFC's ordinary panel. *Pall Corp.* at 1214 n.1.

The CAFC is the appellate court for all United States District Court cases involving patent infringement. *See* Jeffrey G. Sheldon & Otto Lee, *Impact of Federal Circuit on Patent Litigation*, 376 P.L.I. PAT. 879, 887-910 (1993) (discussing how the Federal Circuit replaced the Court of Customs and Patent Appeals on October 1, 1982 with a goal of national uniformity of patent law).

² 52 F.3d 967 (Fed. Cir. 1995), *cert. granted*, _ U.S. __, 116 S. Ct. 40, 64 U.S.L.W. 3238 (U.S. Sept. 27, 1995) (No. 95-26).

³ *Id.* at 970-71. "Claim interpretation" and "claim construction" are synonymous terms for interpreting the language used in a patent claim. *Id.* at 976 n.6; *cf. id.* at 1000-02 (Newman, J., dissenting). Judge Newman suggests "interpretation" be used to describe the factual dispute over the meaning of a certain term while "construction" describes the legal question of what the entire claim means incorporating the interpreted term. *Id.* at 1000-02 (Newman, J., dissenting). As in *Markman*, this article consistently refers to the task of defining the scope of the patent claim as "construction" and determining the actual meaning of a disputed term as "interpretation." *See infra* part II.A. (discussing what constitutes a claim).

⁴ *Markman*, 52 F.3d at 979. The infringement question, however, remains an issue for the jury to determine. *See* *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1520, *cert. granted*, _ U.S. __, 116 S. Ct. 1014, 64 U.S.L.W. 3574 (U.S. Feb. 26, 1996) (No. 95-728) (finding patent infringement a factual issue for the jury).

unanimous Supreme Court recently affirmed the CAFC decision.⁵

Although the CAFC and the Supreme Court clarified that the judge must construe the meaning of a patent claim, neither the Supreme Court nor the CAFC established a specific procedure for the trial judge to follow in order to analyze this question of law.⁶ Soon after the CAFC ruling, but prior to the Supreme Court decision, the Federal District Court for the District of Delaware conducted a preliminary bench trial to interpret a claim in *Elf Atochem North American, Inc. v. Libbey-Owens-Ford Co.*⁷ The District Court held that the Federal Rules of Civil Procedure allow for a separate trial on the issue of claim construction.⁸

The Federal Rules of Evidence also define when a separate trial regarding a specific issue is appropriate.⁹ Rule 104 of the Federal Rules of Evidence, however, only applies when the trial judge hears proffered evidence outside the presence of the jury to determine a preliminary question of fact.¹⁰ *Markman*, however, explicitly stated that the court's role in claim construction is not to determine issues of fact.¹¹ The *Markman* court determined that because claim construction was a question of law, the *Elf Atochem* court had no obligation to consider whether a preliminary hearing accords with Rule 104 because Rule 104

⁵ *Markman v. Westview Instruments, Inc.*, __ U.S. __, 116 S. Ct. 1384, 1396 (1996) (per curiam). The Supreme Court carefully noted that it considered claim construction a matter for the court and not specifically a question of law. *Id.* at __, 116 S. Ct. at 1393 n.10.

⁶ *Markman*, __ U.S. at __, 116 S. Ct. at 1395-96; *Markman*, 52 F.3d at 981. The CAFC suggested that the trial judge either construe the claim prior to instructing the jury or in a dispositive motion. *Markman*, 52 F.3d at 981.

⁷ 894 F. Supp. 844, 850 (D.Del. 1995); see also *Moll v. Northern Telecom, Inc.*, No. CIV. A. 94-5451, 1995 WL 733389, at *3 (E.D.Pa. Dec. 11, 1995) (citing *Elf Atochem* and ordering a preliminary bench trial to interpret meaning of certain claims). This preliminary bench trial is referred to as a "Markman trial." *Elf Atochem*, 894 F. Supp. at 850.

⁸ *Elf Atochem*, 894 F. Supp. at 857. Rule 42 of the Federal Rules of Civil Procedure allows the trial judge to bifurcate the trial if doing so is judicially efficient. FED. R. CIV. P. 42.

⁹ FED. R. EVID. 104(a). The rules of evidence, as well as procedure, apply to patent cases in which technological disputes arise. *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579, 588-89, 113 S. Ct. 2786, 2794-95 (1993). Disputes as to the meaning of certain technological terms often arise in patent litigation. *Markman*, 52 F.3d at 1000-03 (Newman, J., dissenting).

¹⁰ FED. R. EVID. 104(a). A preliminary question of fact is a factual finding made by the court that is the basis for a legal conclusion. See FED. R. EVID. 104(a) advisory committee's note (indicating that a preliminary question of fact is a factual determination made by the court).

¹¹ See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 981 (1995), cert. granted, __ U.S. __, 116 S. Ct. 40 (1995) (explaining why court fails to credit evidence or make factual findings to interpret claim terms).

only applies to preliminary questions of fact and not questions of law.¹²

In reality, however, trial judges make preliminary factual findings.¹³ In order to properly construe a patent claim, the trial judge often must interpret a term of art.¹⁴ To assist the trial judge with a term of art, opposing parties may introduce expert witnesses to testify as to the meaning of the disputed term.¹⁵ Upon evaluating the expert testimony, the trial judge then weighs the credibility of the witnesses.¹⁶ Therefore, determining the meaning of disputed terms is a factual issue.¹⁷

If claim construction contains a preliminary question of fact, Rule 104 applies and limits the court's discretion to conduct a separate trial.¹⁸ A limited window exists for a court to order a separate trial to determine a preliminary question of fact.¹⁹ This article suggests that, contrary to the CAFC's majority opinion and a unanimous Supreme Court, claim construction requires the judge to make a preliminary determination of fact. Case law interpreting the Federal Rules of Evidence does not provide the trial judge with adequate authority to conduct a separate trial on the issue of claim construction. The Federal Rules of Evidence determine whether to conduct a separate trial and admit expert testimony outside the presence of the jury.

¹² See *Elf Atochem N. Am., Inc. v. Libbey-Owens-Ford Co.*, 894 F. Supp. 844, 857-58 (D.Del. 1995) (discussing the impact of *Markman*).

¹³ See *infra* text and accompanying notes 104-111.

¹⁴ See *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1216 (Fed. Cir. 1995) (requiring the trial judge to interpret the term "skinless" before defining the scope of the claim).

¹⁵ *United Carbon Co. v. Binney & Smith*, 317 U.S. 228, 233, 63 S. Ct. 165, 168 (1942).

¹⁶ See *Markman v. Westview Instruments, Inc.*, __ U.S. __, 116 S. Ct. 1384, 1395 (1996) (stating that "credibility judgments have to be made about experts who testify in patent cases . . .").

¹⁷ See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 991 (1995) (Meyer, J. Concurring), *cert. granted*, __ U.S. __, 116 S. Ct. 40 (1995) (arguing that extrinsic evidence creates a factual issue); *cf. id.* at 1000 (Newman, J., dissenting) (stating that calling factual issue an issue of law does not make it so); see also *Arachnid Inc. v. Medalist Mktg. Corp.*, 972 F.2d 1300, 1302 (Fed. Cir. 1992) (denying renewed judgment as a matter of law due to sufficient evidence supporting factual finding); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579 (Fed. Cir. 1989) (stating that evidentiary conflict can create factual dispute); *H.H. Robertson Co. v. United Steel Deck Inc.*, 820 F.2d 384, 389 (Fed. Cir. 1987) (recognizing claim interpretation contains factual element if there is evidentiary dispute).

¹⁸ FED. R. EVID. 104.

¹⁹ See CHARLES ALAN WRIGHT & KENNETH W. GRAHAM, JR., *FEDERAL PRACTICE AND PROCEDURE - FEDERAL RULES OF EVIDENCE* § 5056 (1977).

II. BACKGROUND

A. Claim Construction & Patent Infringement

An inventor may exclude others from making, using, or selling his invention without permission for a period of twenty years.²⁰ The United States Patent and Trademark Office (PTO) may grant a patent, creating a limited monopoly, in exchange for the invention's disclosure upon completion of the examination process.²¹ The inventor must file an application containing a detailed description so that a person skilled in the art can duplicate the invention.²²

The application requires the inventor to include one or more claims.²³ The patent claim portion of the application requires the inventor to identify the novelty of the invention.²⁴ Furthermore, the patent claim serves to establish the scope of protection.²⁵ If the PTO grants the patent, any unauthorized manufacturing, utilization, or distribution of the patented invention infringes upon the patent claim.²⁶

An infringement analysis consists of two steps.²⁷ The first step is to determine the meaning of the patent claims.²⁸ The second step is to compare the

²⁰ 35 U.S.C. § 154(a)(2) (1994). Congress' power to exclude comes from the United States Constitution. U.S. CONST. art. I, § 8, cl. 8. Congress recently amended section 154 of the Patent Act which altered the term of protection for a utility patent from seventeen years of protection from the date of issuance to twenty years of protection from the application date. 35 U.S.C. § 154 (1994). A design patent, however, only allows protection for fourteen years from the date the patent is granted. 35 U.S.C. § 173 (1988).

²¹ 35 U.S.C. § 154 (1994); *see also* PETER D. ROSENBERG, PATENT LAW BASICS, § 1.03 (1995) (analogizing the grant of a patent to a monopoly).

²² 35 U.S.C. § 112 (1975).

²³ *Id.*

²⁴ *Id.*; *see also* 37 C.F.R. § 175(a) (1978).

²⁵ *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 339, 81 S. Ct. 599, 601 (1961); *see also* DONALD S. CHISUM & MICHAEL A. JACOBS, UNDERSTANDING INTELLECTUAL PROPERTY LAW, § 2F[1][b][i] (1992).

²⁶ 35 U.S.C. § 271(a) (1952). This statute provides in part "whoever . . . makes, uses or sells any patented invention . . . infringes the patent." *Id.*

²⁷ *See Lifescan, Inc. v. Home Diagnostic, Inc.*, 76 F.3d 358, 359 (Fed. Cir. 1996) (describing two stage approach to patent infringement cases).

²⁸ *See, e.g., Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 304 (Fed. Cir. 1995) (finding claims must first be construed in infringement analysis); *Transmatic, Inc. v. Gulton Industries, Inc.*, 53 F.3d 1270, 1277 (Fed. Cir. 1995) (stating "the claim must be properly construed to determine its scope and meaning" (quoting *Carroll Touch, Inc. v. Electro Mechanical Sys.*, 15 F.3d 1573, 1576 (Fed. Cir. 1995))); *Baxter Healthcare Corp. v. Spectramed, Inc.*, 49 F.3d 1575, 1582 (Fed. Cir. 1995) (realizing that "the claim must

patent claims to the device or process accused of infringing upon the patent.²⁹

Construing the patent claims, however, may require interpretation of certain terms used within the claim.³⁰ Opposing parties' distinct understanding of scientific or technological terms often requires judicial interpretation.³¹ The court often looks beyond the bare language of the patent claim to determine the meaning of contested terms.³² The court initially considers intrinsic evidence when deciding the meaning of a term of art within the patent.³³ Intrinsic evidence includes the claims, the specifications, and the prosecution history.³⁴ All other evidence represents extrinsic evidence.³⁵ The most common form of extrinsic evidence in patent infringement cases consists of expert testimony.³⁶ Courts limit the use of expert testimony to clarify the meaning of disputed

be interpreted . . . to ascertain the proper scope . . .").

²⁹ *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1578 (Fed. Cir. 1996).

³⁰ *Markman v. Westview Instrument, Inc.*, 52 F.3d 967, 999 (Fed. Cir. 1995) (Newman, J., dissenting).

³¹ *See id.* (confirming interpretation of certain terms often occurs prior to construing claim).

³² *See Moeller v. Ionetics, Inc.* 794 F.2d 653, 657 (Fed. Cir. 1986) (suggesting court admit expert testimony to clear dispute over meaning of certain terms).

³³ *See Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 619-20 (Fed. Cir. 1995) (detailing preferred procedure of review for certain types of evidence when determining meaning of claim).

³⁴ *See, e.g., Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1561 (Fed. Cir. 1991); *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 867 (Fed. Cir. 1985); *SRI International v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1118 (Fed. Cir. 1985). The specifications define terms used within the claim and function as a special dictionary. *CHISUM & JACOBS, supra* note 25, § 2F[1][b]. The prosecution history is the dialogue of arguments between the inventor and PTO in support of patentability. *Id.*; *see generally* ROSENBERG, *supra* note 21, ch. 15 (providing a thorough overview of the patent prosecution process).

³⁵ *See Markman*, 52 F.3d at 980 (stating "extrinsic evidence consists of all evidence external to the patent and prosecution history"); *see also id.* at 991 (Mayer, J., concurring) (stating these documents are not extrinsic evidence). *But see* *Moeller*, 794 F.2d at 656 (identifying the specification, prosecution history, and other claims as extrinsic evidence).

³⁶ *See Tandon Corp. v. U.S. Int'l Trade Comm.*, 831 F.2d 1017, 1021 (Fed. Cir. 1987) (categorizing expert testimony as extrinsic evidence); *Polumbo v. Don-Joy Co.*, 762 F.2d 969, 975 (Fed. Cir. 1985) (allowing introduction of expert testimony in addition to specifications and prosecution history to construe claim).

terms.³⁷ In addition, expert testimony cannot contradict unambiguous terms of the claim.³⁸

It has long been settled that in the second step of the infringement analysis, the jury decides if the accused device infringes upon a valid patent.³⁹ The jury determines infringement, whether literal or by the doctrine of equivalents, by comparing the accused device with the properly construed claims.⁴⁰ To find

³⁷ See *Vieau v. Japax, Inc.*, 823 F.2d 1510, 1516 (Fed. Cir. 1987) (allowing introduction of extrinsic evidence to decipher meaning of "assembly"); *Autogiro Co. of America v. United States*, 384 F.2d 391, 397-98 (Ct. Cl. 1967) (listing and examining all documents useful to construe claims).

³⁸ See *Tandon*, 831 F.2d at 1021 (stating interpretation may not be contrary to claims).

³⁹ *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 821 (Fed. Cir. 1992); see also *Winans v. Denmead*, 56 U.S. (15 How.) 330, 338 (1853) (determining infringement "is a question of fact, to be submitted to a jury"). Patent infringement is a question of fact whether the plaintiff decides to file literal infringement or infringement under the doctrine of equivalents as the cause of action. *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1520, *cert. granted*, ___ U.S. ___, 116 S. Ct. 1014, 64 U.S.L.W. 3574 (U.S. Feb. 26, 1996) (No. 95-728). Congress has not passed legislation suggesting unique procedures for the two possible approaches to patent litigation because legislation merely provides that "[e]xcept as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefore, infringes the patent." 35 U.S.C. § 271(a) (1952); see also *Graver Tank & Mfg. Co. v. Linde Air Prod. Co.*, 339 U.S. 605, 609, 70 S. Ct. 854, 857 (1950) (holding that "equivalence is a determination of fact"); *SRI International v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1125 (determining both literal and doctrine of equivalents infringement are factual).

⁴⁰ See, e.g., *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 419, 28 S. Ct. 748, 751 (1908) ("[t]he claims measure the invention"); *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 935 (Fed. Cir. 1987) (en banc), *cert. denied*, 485 U.S. 961, 108 S. Ct. 1226, *cert. denied*, 485 U.S. 1009, 108 S. Ct. 1474 (stating trier cannot ignore the claims); *SRI Int'l.*, 775 F.2d at 1121 (Fed. Cir. 1985) (comparing accused product to claims).

Even if the holder of a patent cannot substantiate a cause of action for literal infringement, infringement under the doctrine of equivalents may nonetheless exist. *Becton Dickinson and Co. v. C.R. Bard, Inc.*, 922 F.2d 792, 797 (Fed. Cir. 1990). The trial judge, however, cannot arbitrarily apply the doctrine of equivalents absent a showing of literal infringement. *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1522, *cert. granted*, ___ U.S. ___, 116 S. Ct. 1014, 64 U.S.L.W. 3574 (U.S. Feb. 26, 1996) (No. 95-728). Under the doctrine of equivalents, infringement exists if the accused device "performs substantially the same function in substantially the same way to obtain the same result." *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42, 50 S. Ct. 9, 13 (1929); see also *Hilton Davis Chemical*, 62 F.3d at 1529 (reaffirming *Graver Tank & Mfg. Co. v. Linde Air Prod. Co.*, 339 U.S. 605, 70 S. Ct. 854 (1950)); *Graver Tank & Mfg. Co.*, 339 U.S. at 608, 70 S. Ct. at 856 citing *Sanitary Refrigerator Co.*, 280 U.S. at 42, 50 S. Ct. at 13. The doctrine of equivalents, arguably, expands the scope of patent protection by preventing fraud

literal infringement, the accused device or process must contain every element of the claim.⁴¹ The "[o]mission of any claim element avoids literal infringement."⁴² If the accused device parallels the claim of the patented device, infringement exists and the jury should find for the patent holder.⁴³

B. Markman v. Westview Instruments, Inc.

The PTO issued Markman a patent for a dry-cleaning inventory control system which had the capability to automatically report the completed steps of the processes performed on an item of clothing.⁴⁴ The device accused of infringing the Markman patent, manufactured by Westview, did not have the capability to automatically locate a piece of clothing within the cleaning

and insuring the inventor the benefit of her invention. *Graver Tank & Mfg. Co.*, 339 U.S. at 607-08, 70 S. Ct. at 856 (explaining the origin of the doctrine of equivalents); *see also* CHISUM & JACOBS, *supra* note 25, § 2F[2][b] (referring to the doctrine of equivalents as extending the scope of literal infringement).

The focus of this article only concerns itself with literal infringement because *Markman* is a literal infringement case. The United States Supreme Court is scheduled to decide *Hilton Davis Chemical*, a doctrine of equivalents case, during the 1996-97 term. 62 F.3d 1512, *cert. granted*, __ U.S. __, 116 S. Ct. 1014, 64 U.S.L.W. 3574 (U.S. Feb. 26, 1996) (No. 95-728).

⁴¹ *See Builders Concrete, Inc. v. Bremerton Concrete Prods. Co.*, 757 F.2d 255, 257 (Fed. Cir. 1985) (*citing* *Fay v. Corderman*, 109 U.S. 408 (1883)).

An element is one of several steps that substantiate a claim. 35 U.S.C. § 112. Specifically, an element is one of numerous characteristics that differentiate a new patent from an existing patent. CHISUM & JACOBS, *supra* note 25, § 2F[2][a]. Although not every element of the original invention must be described, a sufficient number of elements must be described so that one skilled in the art can make or use the invention. ROSENBERG, *supra*, note 21, § 13.05[5] (describing the requirements of 35 U.S.C. § 112 and 37 C.F.R. § 1.71.)

⁴² CHISUM & JACOBS, *supra* note 25, § 2F[2][a]; *see also* *Winner Int'l Corp. v. Walo Mfg. Corp.*, 905 F.2d 375, 376 (Fed. Cir. 1990) (focusing on differences between accused product and claim); *Johnston v. Ivac Corp.*, 885 F.2d 1574, 1577-78 (Fed. Cir. 1989) (allowing summary judgment for failure to bring forth evidence of an element of the claim); *Lemelson v. United States*, 752 F.2d 1538, 1551 (Fed. Cir. 1985) (requiring presence of every element or equivalent).

⁴³ *See Jurgens v. McKasy*, 927 F.2d 1552, 1560 (Fed. Cir. 1991) (stating that a finding of all elements of claim against an accused device constitutes literal infringement).

⁴⁴ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 971-72 (Fed. Cir. 1995). Upon entering the information into a computer, a printer would output a bar code ticket that would be attached to each piece of clothing. *Id.* The ticket would be scanned at each stage of the cleaning process and information stored in the computer. *Id.* The system could total cash received or expected, print out receipts and instantaneously provide an up-to-date list of completed stages in order to locate a particular piece of clothing. *Id.*

process.⁴⁵ The issue was whether the term "inventory," as used in the Markman patent, included clothing.⁴⁶ If "inventory" included clothing, the Westview device would not infringe the Markman patent because the product did not contain an element of the patent, namely, the ability to locate an article of clothing.⁴⁷

Relying mostly on intrinsic evidence such as the patent claim, specifications, and prosecution history, Westview argued that "inventory" included clothing.⁴⁸ Markman, alternatively, relied primarily on expert testimony to argue that "inventory" excluded clothing.⁴⁹ Markman introduced a patent expert who testified to both the meaning of the claims and how Westview's device infringed on the patent claim.⁵⁰ After both parties rested, the trial judge instructed the jury to interpret the meaning of the word "inventory," construe the claim, and determine the issue of literal infringement.⁵¹ Consequently, the jury returned a verdict in favor of Markman indicating that "inventory" did not include clothing within its meaning.⁵²

In response to the jury verdict, the court granted Westview's motion for judgment as a matter of law.⁵³ The trial judge determined that "inventory" did

⁴⁵ *Markman*, 52 F.3d at 973. The Westview device was limited to merely determining cash value of services completed and printing receipts. *Id.*

⁴⁶ *Id.* at 999 (Newman, J., dissenting); see also Bryan Medlock, Jr., The Role Of The Fact Finder In Patent Litigation, Address Before the American Intellectual Property Law Association Plenary Session (Oct. 28, 1995), in *AIPLA BULL.*, Oct.-Nov.-Dec. 1995, at 95 [hereinafter MEDLOCK] (explaining the importance of *Markman*).

⁴⁷ *Markman*, 52 F.3d at 999 (Newman, J., dissenting).

⁴⁸ *Id.* at 973. Westview decided not to introduce any other extrinsic evidence besides its president's testimony as to meaning of "inventory" *Id.*

⁴⁹ *Id.* Markman introduced the following witnesses: a bar code technology expert; Markman, the inventor; a patent expert; and an accountant. *Markman*, 52 F.3d at 973. Markman, the inventor, acted as his own lexicographer and testified about his patent and the meaning of its claims. *Id.* A 'lexicographer' is someone who explains the meaning of certain terms by acting as a source of reference. *THE NEW LEXICON WEBSTER'S DICTIONARY OF THE ENGLISH LANGUAGE* 569 (1990). In patent cases, the term lexicographer refers to someone who testifies as to the meaning of certain terms used within the patent. *CHISUM & JACOBS*, *supra* note 25, § 2F[1][b].

⁵⁰ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 973 (1995), *cert. granted*, U.S. ___, 116 S. Ct. 40 (1995); see also Adelman, *supra* note 1, at 681 (describing the type of expert testimony Markman introduced).

⁵¹ *Markman*, 52 F.3d at 973.

⁵² See *id.* (finding that the Westview device infringed the Markman patent).

⁵³ *Id.*

include clothing.⁵⁴ In overturning the jury verdict, the trial judge reasoned that claim construction is purely a matter of law.⁵⁵

The Federal Rules of Civil Procedure allow the court to make a judgment as a matter of law if the evidence presented to the jury can not reasonably substantiate its verdict.⁵⁶ The trial judge did not overturn the jury verdict based on procedural reasoning.⁵⁷ Rather, the trial judge relied on precedent and declared that claim construction is a matter of law for the court to decide.⁵⁸

The Supreme Court has consistently held that patent claim construction is a matter of law.⁵⁹ Unlike previous Supreme Court decisions, the CAFC decisions contain inconsistencies as "to what extent claim construction is a legal issue or a factual issue, or a mixed issue."⁶⁰ The CAFC in *Markman*, realized that these inconsistencies arose from the continuing debate within the CAFC

⁵⁴ *Id.*

⁵⁵ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 973 (1995), *cert. granted*, _ U.S. __, 116 S. Ct. 40 (1995).

⁵⁶ FED. R. CIV. P. 50. Rule 50 states in pertinent part that if "there is no legally sufficient evidentiary basis for a reasonable jury to find for a party on that issue, the court may determine the issue" *Id.*; *see generally* JACK H. FRIEDENTHAL ET AL., CIVIL PROCEDURE § 12.3 (2nd ed. 1993) (providing a thorough history and presentation of the formalities to judgment as a matter of law).

⁵⁷ *Markman*, 52 F.3d at 973 (stating that claim construction is a matter for the trial judge). Judge Rader, in a concurring opinion, stated that the district court appropriately granted a judgment as a matter of law due to the lack of evidence to substantiate the jury's verdict. *Id.* at 998-99 (Rader, J., concurring).

Although the trial judge granted the judgment as a matter of law and reversed the verdict based on the idea that claim construction is a question of law, the CAFC noted that the Westview device indisputably did not have the same capabilities as the *Markman* patent. *Markman*, 52 F.3d at 973.

⁵⁸ *Markman*, 52 F.3d at 973.

⁵⁹ *See, e.g.*, *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275, 24 S. Ct. 291, 295 (1904) (stating without a dispute over a term, infringement is matter of law); *Bates v. Coe*, 98 U.S. (8 Otto) 31, 38-39 (1878) (finding it is province of the court to construe patents); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 338 (1854) (construing specifications and claims as questions of law).

⁶⁰ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (1995), *cert. granted*, _ U.S. __, 116 S. Ct. 40 (1995); *see also* Brief for Petitioner at 17, *Markman v. Westview Instruments, Inc.*, No. 95-26, 1996 WL 12585 (S. Ct. 1995) (listing numerous CAFC cases which have stated that interpretation of certain terms is a factual inquiry); CHISUM & JACOBS, *supra* note 25, § 2F[1][c] (providing detailed history and analysis of cases in which Federal Circuit attempted to determine law/factual issue).

regarding the respective roles of a judge and jury.⁶¹ Specifically, the court focussed on who should interpret the meaning of disputed terms within the patent claim.⁶² In reaching its decision the CAFC sought to clarify the roles of a judge and jury on the issues of term interpretation and claim construction.⁶³

The CAFC had three options in settling the debate: 1) whether the judge must interpret the meaning of the term and construe the claim; 2) whether the jury should interpret both the meaning of the term and construe the claim; or 3) whether the jury must first interpret the meaning of the disputed term within the claim and then have the judge construe the claim.⁶⁴ The CAFC selected the first option.⁶⁵ Therefore, the trial judge's role is to interpret the disputed terms and construe the claim.⁶⁶

In order to construe the claim, Justice Newman envisioned the trial judge holding a "mini-trial" or evidentiary hearing outside the presence of the jury.⁶⁷ The CAFC majority did not establish such an approach, rather, it stated that the trial court must as a matter of law determine the meaning of the claim and instruct the jury accordingly.⁶⁸ The Supreme Court affirmed the CAFC,

⁶¹ *Markman*, 52 F.3d at 976 (admitting the CAFC's first inconsistent decision concerning this question, *McGill, Inc. v. John Zink Co.*, 736 F.2d 666 (Fed. Cir. 1984), contained no precedent or authority).

⁶² *Compare* *Perini America, Inc. v. Paper Converting Machine Co.*, 832 F.2d 581, 584 (Fed. Cir. 1987) (determining disputed terms within the claim is a question of fact) with *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579-80 (Fed. Cir. 1989) (allowing claim construction as matter of law absent factual term interpretation dispute).

⁶³ *See Markman*, 52 F.3d at 976 (noting jury always determines the infringement issue regardless of who interprets the claim).

⁶⁴ *See id.* (describing a question of law, fact, and mixed issue); *cf. Markman*, 52 F.3d at 989 (Rader, J., concurring) (presenting issue as only whether claim construction is purely legal matter or mixed issue).

⁶⁵ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970-71 (1995), *cert. granted*, ___ U.S. ___, 116 S. Ct. 40 (1995).

⁶⁶ *Id.* at 979 (following the Supreme Court approach); *cf. Markman*, 52 F.3d at 1021-25 (Newman, J., dissenting) (arguing majority opinion misinterpreted Supreme Court precedent).

⁶⁷ *Markman*, 52 F.3d at 1000 (Newman, J., dissenting). Judge Newman suggested that this procedure would create havoc in the litigation process. *See id.* at 999 (Newman, J., dissenting) (speculating that the majority decision is unworkable).

⁶⁸ *Markman*, 52 F.3d at 981. In deciding that the trial judge determines claim construction as a matter of law, the CAFC cited to an 1881 patent case. *Id.* (citing *Loom Co. v. Higgins*, 105 U.S. 580, 586 (1881)). In 1881, English courts decided patent infringement cases in a bench trial within a court of equity. *Markman*, 52 F.3d at 992 (Mayer, J., concurring) (stating patent infringement "would have been heard in the law courts"). Therefore a theory exists that the CAFC was suggesting that trial judges conduct

recognized that conflicts regarding evidentiary issues existed, but failed to address any procedural issues.⁶⁹

C. The Markman Trial

Shortly after the CAFC decided *Markman*, the Federal District Court for the District of Delaware wrestled with the challenge of interpreting the meaning of a disputed term within the patent claim in *Elf Atochem*.⁷⁰ To abide by the CAFC's decision in *Markman*, the *Elf Atochem* court recognized that the trial judge must interpret the meaning of a disputed term used within the claim and instruct the jury as to that meaning.⁷¹ To perform this judicial task, the *Elf Atochem* court had to analyze three procedural options.⁷² The first option allows the court to determine the issue of claim construction upon a summary judgment motion.⁷³ Second, the court may conduct a preliminary bench trial on the sole issue of claim construction.⁷⁴ Finally, the trial judge may admit all evidence relevant to both claim construction and patent infringement during a full jury trial and instruct the jury as to the meaning of the claims.⁷⁵

It is well settled that if no dispute exists as to the meaning of the terms of the claim, the court may grant a motion for summary judgment on the issue of

mini-trials before the jury trial. See MEDLOCK, *supra* note 46, at 93-99 (indicating we must inquire how English common law courts handled patent litigation). In a concurring opinion, Judge Mayer illustrated that patent infringement has always been a jury question in the United States, which contradicts English law. *Markman*, 52 F.3d at 992-93 (Mayer, J., concurring); cf. *Markman*, __ U.S. at __, 116 S. Ct. at 1391-92 (investigating British patent law cases to solve issue).

⁶⁹ *Markman*, __ U.S. at __, 116 S. Ct. at 1395-96 (holding "there is sufficient reason to treat construction of terms of art like many other responsibilities that we cede to a judge in the normal course of trial, notwithstanding its evidentiary underpinnings").

⁷⁰ *Elf Atochem N. Am., Inc. v. Libbey-Owens-Ford Co.* 894 F. Supp. 844, 851-52 (D.Del. 1995) (conflicting discovery evidence regarding meaning of "coating solution" prevented summary judgment on issue).

⁷¹ *Id.*

⁷² *Id.*; see also MEDLOCK, *supra* note 46, at 97 (discussing the options presented to the trial judge and action taken to date); cf. Joseph R. Re & Joseph F. Jennings, *Answers and Questions Raised by the Federal Circuits Markman and Hilton Davis Decisions*, 423 P.L.I. PAT. 877 (1995) (adding items to the list of available procedural options).

⁷³ See *Elf Atochem*, 894 F. Supp. at 850 (stating trial judge can "attempt to resolve these disputes on paper record"); *Markman*, 52 F.3d at 981 (suggesting the issue be decided upon a party making a motion).

⁷⁴ *Elf Atochem*, 894 F. Supp. at 850.

⁷⁵ *Id.*

claim construction.⁷⁶ When disputes over the meaning of terms occur, courts are reluctant to grant summary judgment based on a paper record generated from discovery which may include affidavits from expert witnesses.⁷⁷ The *Elf Atochem* court chose to conduct a preliminary bench trial.⁷⁸ In deciding to hold a "Markman trial," the *Elf Atochem* court considered this approach practical and in accordance with the Federal Rules of Civil Procedure.⁷⁹

III. ANALYSIS

Although the *Elf Atochem* court chose to conduct a "Markman trial," the court realized that bifurcating the proceeding could produce serious practical litigation problems.⁸⁰ The dissent in *Markman* specifically warned that holding both term interpretation and claim construction as questions of law could harm the patent litigation process.⁸¹ Two arguments exist, however, in support of a

⁷⁶ FED. R. CIV. P. 56(c) provides in pertinent part, "The judgment sought shall be rendered if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." *Id. see, e.g.,* Anderson v. Liberty Lobby, 477 U.S. 242, 248, 106 S. Ct. 2505, 2510 (1986) (setting the standard for summary judgment in civil cases); Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 585-87, 106 S. Ct. 1348, 1355-56 (1986) (applying summary judgment to patent case); Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 72 F.3d 857, 860 (Fed. Cir. 1995) (affirming summary judgment in patent case).

⁷⁷ See *Elf Atochem N. Am., Inc. v. Libbey-Owens-Ford Co.*, 894 F. Supp. 844, 849 (relying on Judge Easterbrook's comment in *In re Mahurkar Double Lumen Hemodialysis Catheter Patent Litig.*, 831 F. Supp. 1354, 1359 (N.D. Ill. 1993) (Easterbrook, J., sitting by designation)); *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 656 (Fed. Cir. 1986) (denying summary judgment and suggesting further inquiry with expert testimony).

⁷⁸ *Elf Atochem*, 894 F. Supp. at 850. In the only other case to date that presented the same issue, the CAFC for the Eastern District of Pennsylvania followed the *Elf Atochem* approach, choosing to conduct a *Markman* trial. *Moll v. Northern Telecom, Inc.*, No.CIV.A.95-5451, 1995 WL 733389, at *6 (E.D. Pa. Dec. 11, 1995).

⁷⁹ *ELF Atochem*, 894 F. Supp. at 857. FED. R. CIV. P. 42(b) states in pertinent part, "The court, in furtherance of convenience as to avoid prejudice, or when separate trials will be conducive to expedition and economy, may order a separate trial . . . always preserving inviolate the right of trial by jury as declared by the Seventh Amendment to the Constitution . . ."

⁸⁰ *Elf Atochem*, 895 F. Supp. at 857.

⁸¹ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 1003 (Newman, J., dissenting) (1995), *cert. granted*, __ U.S. __, 116 S. Ct. 40 (1995). Judge Newman speculated that the majority decision could result in a "great cost to efficiency of the trial/appellate process." *Id.*; see also *Markman*, 52 F.3d at 989 (Mayer, J., concurring) (surmising majority decision "portends turbulence and cynicism in patent litigation").

“Markman trial.”

The first argument in support of a “Markman trial” stems primarily from the belief that it is more efficient to use the court’s time for a separate trial on the claim construction issue rather than conduct one trial to resolve both the claim construction issue and the infringement question.⁸² Separating the legal from the factual issues allows closure to the claim construction issue before proceeding to a jury trial.⁸³ Claim construction is a question of law and is reviewed *de novo* on appeal.⁸⁴ The appellate court can interpret the meaning of disputed terms and construe the patent claim without regard to the district court’s findings.⁸⁵ This method of review invites immediate appeal by the dissatisfied party in the patent litigation.⁸⁶ Accordingly, supporters of a “Markman trial” argue that judicial efficiency requires resolution of the claim construction issue before proceeding onto the factual issue of infringement. This approach ensures finality regarding the legal issue of claim construction.

The potential for an immediate interlocutory appeal, however, would add “significant time and expense to the ultimate resolution of the litigation.”⁸⁷ The question is whether the time potentially added to the overall litigation process is offset by the trial time saved. The *Elf Atochem* court did not reference any study on this issue before deciding to conduct a “Markman trial.” The mounting increase in patent litigation magnifies the issue of whether a “Markman trial” is practical or judicially efficient.⁸⁸ Whether a “Markman trial” is judicially

⁸² See *Elf Atochem N. Am., Inc. v. Libbey-Owens-Ford Co.*, 895 F. Supp. 844, 857 (D.Del. 1995) (increasing judicial efficiency by not wasting juror’s time); see also *MEDLOCK*, *supra* note 46, at 97 (discussing advantage to jurors of “Markman trial”).

⁸³ See *Elf Atochem*, 895 F. Supp. at 857 (allowing appeals process concerning issue of law to finalize before proceeding).

⁸⁴ *Markman*, 52 F.3d at 979.

⁸⁵ See *Exxon Chemical Patent, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1558 (Fed. Cir. 1995), *reh’g denied*, 77 F.3d 450 (Fed. Cir. 1996) (recognizing certain judges interpreted claim dissimilar to either party’s suggestion); *Markman*, 52 F.3d at 993 (Mayer, J., concurring) (noting appellate “court will do pretty much what it wants to under its *de novo* trial”).

⁸⁶ *MEDLOCK*, *supra* note 46, at 97.

⁸⁷ *Elf Atochem N. Am., Inc. v. Libbey-Ford-Owens Co.*, 894 F. Supp. 844, 857 (D.Del. 1995).

⁸⁸ Timothy S. Swabb, *Federal Circuit Cannot Stop Runaway Jury Awards in Patent Suits; Companies Should Insure Themselves Against This Risk*, in *Intellectual Property* 1995, at 20 (Mealy’s Litig. Rep. No. 23 1995). “During 1974 patent holders tried only 7 percent [six of 89] patent suits to a jury. During 1994, patent holders tried 70 percent [63 of 90] patent suits to a jury. Jury verdicts have increased more than tenfold in the past twenty years.” *Id.*

efficient remains, at best, unproven.

The second argument in support of a "Markman trial" stems from the belief that trial judges are better equipped to interpret the meaning of disputed terms of art used within the patent claim.⁸⁹ Some judicial authorities believe jurors have limitations, including a lack of technical knowledge.⁹⁰ Specifically, commentators suggest that the complexity of the subject matter coupled with jurors' lack of technical knowledge often prevents them from properly deciding a patent infringement issue.⁹¹ Since its inception in 1982, however, the CAFC has adamantly rejected the complexity argument when a party moves to withhold a case from a jury.⁹²

Regardless of the underlying judicial reasoning, any bifurcation of patent litigation must accord with the Federal Rules.⁹³ Rule 42 of the Federal Rules of Civil Procedure, which *Elf Atochem* relied upon in granting a "Markman trial," allows separate trials if judicially efficient.⁹⁴ Where the same evidence is used

⁸⁹ *Markman v. Westview Instruments, Inc.*, __ U.S. at __, 116 S. Ct. 1384, 1395 (1996) (per curiam) (discussing how trained trial judge can evaluate demeanor of expert witness better than lay juror).

⁹⁰ See *Ross v. Bernard*, 396 U.S. 531, 538, 90 S. Ct. 733 n.10 (1970) (determining whether nature of the issue depends upon practical ability of jury). Chief Justice Warren Burger also rejected the idea of lay jurors in complex litigation. See Nicholas M. Cannella & Timothy J. Kelly, *Jury Trials and Mock Jury Trials*, 375 P.L.I. PAT. 731 (1993) (highlighting Chief Justice Burger's remarks at a 1979 conference).

⁹¹ See Cannella & Kelly, *supra* note 90, at 734 (listing arguments against jury trial).

⁹² See *SRI Int'l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1127-31 (Fed. Cir. 1985) (Markey, C.J., concurring) (stating complexity in patent case does not offer compelling need to forego a jury trial). By rejecting a bench trial, the Federal Circuit overruled a minority of rulings where a jury trial was found improper due to complexity. See generally *General Tire and Rubber Co. v. Watkins*, 331 F.2d 192, 197 (4th Cir. 1964) (upholding judicial discretion in refusing jury trial); *Ashland Oil, Inc. v. Delta Oil Products Corp.*, 209 U.S.P.Q. 247, 248 (E.D. Wis. 1979) (discussing exercise of judicial discretion to avoid jury trial).

⁹³ The Federal Rules of Evidence apply to all Federal Courts created under Article III of the United States Constitution. FED. R. EVID. 101. Federal Courts have original jurisdiction over patent cases. 28 U.S.C. § 1338 (1996). The CAFC has consistently held that the Federal Rules of Evidence apply to patent infringement cases. See generally *Markman*, 52 F.3d at 993 (Mayer, J., concurring in judgment); *Id.* at 1000 (Newman, J., dissenting); *Mainland Industries, Inc. v. Standal's Patent's Ltd.*, 799 F.2d 746, 750 (Fed. Cir. 1996) (applying FED. R. EVID. 403); *Symbol Technologies, Inc. v. Optican, Inc.*, 935 F.2d 1569, 1574-75 (Fed. Cir. 1991) (applying FED. R. EVID. 705); *Jacuzzi, Inc. v. Kohler Co.*, 835 F.2d 870, 1987 WL 4634, at *2 (Fed. Cir.(Cal.) 1987) (utilizing FED. R. EVID. 403).

⁹⁴ FED. R. CIV. P. 42.

repeatedly, however, courts are reluctant to conduct separate trials.⁹⁵ Before *Markman*, the evidence introduced to determine infringement would also be introduced to construe the claim and interpret the disputed terms.⁹⁶ If the trial judge orders a "Markman trial," the same experts would have to testify at both the preliminary hearing and at the jury trial.⁹⁷ Introducing similar evidence in the form of expert testimony increases both the duration and cost of litigation.

In contrast, Rule 104 of the Federal Rules of Evidence grants the trial judge discretion to conduct preliminary hearings only when justice requires.⁹⁸ Rule 104, however, only applies to preliminary questions of fact.⁹⁹ Both the CAFC and the Supreme Court expressly held that the trial judge is not making factual evidentiary findings when interpreting claims.¹⁰⁰ Specifically, the CAFC held that determining the meaning of disputed terms used in the patent claim is as much a question of law as claim construction itself.¹⁰¹ The Supreme Court in *Markman*, however, carefully stated that claim construction and interpretation

⁹⁵ See *United States v. Ciampaglia*, 628 F.2d 632, 643-44 (1st Cir. 1980), *cert. denied*, 101 S. Ct. 365, 449 U.S. 956 (1980) (holding court did not abuse its discretion in denying severance).

⁹⁶ See *Markman v. Westview Instrument Inc.*, 52 F.3d 967, 1002 (Fed. Cir. 1995) (Newman, J., dissenting), *cert. granted*, ___ U.S. ___, 116 S. Ct. 40 (discussing how the same evidence is helpful to both trier of fact and court); Edward V. Filardi, *An Overview of Pretrial and Trial Format for Patent Infringement Litigation*, 223 P.L.I. PAT. 408-11 (1986) (suggesting appropriate order to introduce different experts during patent litigation).

⁹⁷ See *MEDLOCK*, *supra* note 46, at 96 (inquiring into current role of patent expert during litigation).

⁹⁸ FED. R. EVID. 104(c) states in pertinent part that "Hearings on other preliminary matters shall be conducted when the interests of justice require" FED. R. EVID. 104(c).

⁹⁹ *Id.*

¹⁰⁰ *Markman*, 52 F.3d at 981. The *Markman* court stated in part that :
Through this process of construing claims by . . . using certain extrinsic evidence that the court finds helpful and rejecting other evidence as unhelpful, and resolving disputes en route to pronouncing the meaning of claim language as a matter of law based on the patent documents themselves, the court is not crediting certain evidence over other evidence or making factual findings. Rather, the court is looking to the extrinsic evidence to assist in its construction of the written document, a task it is required to perform.

Id.

¹⁰¹ *Markman v. Westview Instrument Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995), *cert. granted*, ___ U.S. ___, 116 S. Ct. 40 (calling entire claim construction process an obligation of the court).

of disputed terms are judicial tasks, but not specifically questions of law.¹⁰²

In reality, trial judges make preliminary factual determinations while construing claims.¹⁰³ Although claim construction remains a question of law, the trial judge must make a number of underlying factual inquiries, including term interpretation.¹⁰⁴ Patent litigation often necessitates interpretation of certain terms before construing the patent claims.¹⁰⁵ To interpret the meaning of disputed terms, the court must weigh extrinsic evidence.¹⁰⁶ Weighing expert testimony constitutes a factual determination.¹⁰⁷ Whether a trial judge or jury interprets the meaning of disputed terms, this remains a factual inquiry.¹⁰⁸ If the trial judge interprets the disputed term, the judge must resolve the meaning of the term as a preliminary question of fact.¹⁰⁹

To interpret the patent claim, the trial judge may admit extrinsic

¹⁰² See *Markman v. Westview Instrument Inc.*, __ U.S. at __, 116 S. Ct. 1384, 1393 n.10 (1996) (per curium) (delineating common law history of term interpretation).

¹⁰³ See *Lucas Aerospace, Ltd. v. Unison Industries, L.P.*, 890 F. Supp. 329, 333 n.7 (D.Del. 1995) (arguing firmly that courts assign credibility to expert testimony); see also *Markman*, 52 F.3d at 999 (Newman, J., dissenting) (stating majority opinion called factual disputes a question of law); RE & JENNINGS, *supra* note 72, (discussing footnote 7 in *Lucas Aerospace*).

¹⁰⁴ *Markman*, 52 F.3d at 997 (Mayer, J., concurring) (referring to argument over meaning of certain terms as factual dispute).

¹⁰⁵ *Pall Corporation v. Micron Separations, Inc.*, 66 F.3d 1211, 1216 (Fed. Cir. 1995) (requiring court to interpret "skinless" before determining scope of entire claim).

¹⁰⁶ See *Markman*, __ U.S. at __, 116 S.Ct. at 1395 (realizing "credibility judgments have to be made about the experts who testify in patent cases").

¹⁰⁷ See *Markman v. Westview Instrument Inc.*, 52 F.3d 967, 997 (Fed. Cir. 1995) (Mayer, J., concurring), *cert granted*, __ U.S. __, 116 S. Ct. 40 (referring to argument over meaning of certain terms as a factual dispute).

¹⁰⁸ See, e.g., *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1223 (Fed. Cir. 1992) (stating that a question of law is based on fact); *Tol-O-Matic Inc. v. ProMa Produkt-Und Mktg.*, 945 F.2d 1546, 1550 (Fed. Cir. 1991) (weighing evidence is a factual question); *Perini America, Inc. v. Paper Converting Mach. Co.*, 832 F.2d 581, 586 (Fed. Cir. 1987) (basing its reasoning on premise that infringement is a question of fact); see also *Markman*, 52 F.3d at 1000 (Newman, J., dissenting) (stating "applying law to facts does not convert the finding of fact into a matter of law").

¹⁰⁹ *Markman v. Westview Instruments, Inc.*, __ U.S. at __, 116 S. Ct. 1384, 1395 (1996) (per curium) (admitting that a witness's credibility must be weighed); Brief for Amicus Curiae at 1, *Pall Corporation v. Micron Separations, Inc.*, 66 F.3d 1211 (Fed. Cir. 1995) (Nos. 91-1393, - 1394, - 1409) (referring to disputes concerning meaning of certain terms as factual disputes).

evidence.¹¹⁰ For example, in order to assist the trier of fact in construing certain terms within the patent claim, the trial judge must decide whether to introduce extrinsic evidence, such as expert testimony.¹¹¹ In exercising its discretion to admit expert testimony, the trial judge must determine "whether the probative value of the proffered evidence is substantially outweighed by the danger of unfair prejudice, confusion on the issue, or misleading the jury."¹¹²

Although courts attempt to admit all relevant evidence, Rule 104 allows the trial judge to hear certain preliminary matters outside the presence of the jury.¹¹³ In essence, the underlying argument in support of bifurcating the proceeding with a "Markman trial" is that the prejudicial effect of an expert witness' testimony substantially outweighs its probative value.¹¹⁴ The probative value of the expert witness' testimony lies in explaining what constitutes infringement.¹¹⁵ Expert testimony, however, also carries with it the prejudicial effect of misleading the jury.¹¹⁶ In addition, requiring the expert witness to testify about the meaning of the claim as well as what constitutes infringement further

¹¹⁰ See *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 233, 63 S. Ct. 165, 168 (1942) (allowing judges not skilled in the art to use expert testimony to assist in interpreting claims).

¹¹¹ FED. R. EVID. 702. Rule 702 provides: "If scientific, technical, or other specialized knowledge will assist the trier of fact to understand the evidence or to determine a fact in issue, a witness qualified as an expert by knowledge, skill, experience, training, or education, may testify thereto in the form of an opinion or otherwise." *Id.*; see also *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579, 590, 113 S. Ct. 2786, 2795 n.8 (1993) (pointing out that "Rule 702 also applies to technical, or other specialized knowledge").

¹¹² Brief for Amicus Curiae at 6, *Pall Corporation v. Micron Separations, Inc.*, 66 F.3d 1211 (Fed. Cir. 1995) (Nos. 91-1393, -1394, -1409). FED. R. EVID. 403 provides in pertinent part: "Although relevant, evidence may be excluded if its probative value is substantially outweighed by the danger of unfair prejudice, confusion of the issues, or misleading the jury, or by consideration . . ." *Id.*; see also *Daubert*, 509 U.S. at 588, 113 S. Ct. at 2798 (recognizing expert testimony can be misleading).

¹¹³ FED. R. EVID. 104(c); see also *Luce v. United States*, 469 U.S. 38, 41 n.4 (1984) (broadening court's inherent powers to include motion in limine). Rule 104 (c) also applies to civil proceedings. FED. R. EVID. 104(c) advisory committee's note.

¹¹⁴ See *Markman v. Westview Instruments, Inc.*, __ U.S. __, 116 S.Ct. 1384, 1395-96 (1996) (per curiam) (realizing judge is in better position to make credibility determination).

¹¹⁵ Donald R. Dunner, *The Use and Abuse of Patent Experts*, 222 P.L.I. PAT. 649 (1986).

¹¹⁶ *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579, 588, 113 S. Ct. 2786, 2798 (1993).

increases the likelihood of misleading the jury.¹¹⁷

To conduct a “Markman trial” based upon Rule 403, the court must deem the prejudicial effect of expert testimony analogous to the danger posed by a confession or a co-conspirator’s statement. The only mandatory preliminary hearing regarding prejudicial issues, however, concerns the admissibility of confessions.¹¹⁸ Although not mandatory, many courts also decide questions of admissibility of co-conspirator’s statements outside the presence of the jury because the relevant testimony against one defendant may not be relevant against the other.¹¹⁹ When justice requires, courts may conduct a preliminary hearing.¹²⁰

The CAFC in *Markman* concluded that justice requires a separate hearing to decide the legal issue of claim construction.¹²¹ In so holding, the CAFC suggested that it is unjust for jurors to hear patent cases because lay jurors are incapable of the task.¹²² Furthermore, in affirming the CAFC, the Supreme

¹¹⁷ See MEDLOCK, *supra* note 46, at 98 (illustrating how useless expert testimony is to jury if “Markman trial” is held); SHELDON & LEE, *supra* note 1, at 891 (suggesting types of evidence to introduce to persuade trier of fact); James R. Myers, *Winning Complex Trials With Simple Themes*, VENABLE, BAETJER, HOWARD & CIVILETTI, LLP, ¶ 8 (Jan. 23, 1996) <<http://venable.com/govern/myersart.htm>>.

¹¹⁸ FED. R. EVID. 104(c); see FED. R. EVID. 104(c) advisory committee’s note (adopting Supreme Court decision in *Jackson v. Denno*, 378 U.S. 368 (1964)).

¹¹⁹ See *United States v. Young*, 634 F.2d 1136, 1137-38 (9th Cir. 1980) (citing procedure to determine admissibility of co-conspirator’s statement); *United States v. James*, 576 F.2d 1121, 1132 (5th Cir. 1978) (determining admissibility of co-conspirator’s statement outside the presence of jury). But see *United States v. Wood*, 851 F.2d 185, 187-88 (8th Cir. 1988) (finding no error in disallowing a pre-trial hearing on admission of co-conspirator’s statement); *United States v. Ricks*, 639 F.2d 1305, 1309-10 (5th Cir. 1981) (finding no error on failure to conduct a pre-trial hearing on admission of co-conspirator’s statement).

¹²⁰ See, e.g., *United States v. Holmquist*, 36 F.3d 154, 163 (1st Cir. 1994) (recognizing trial judge’s authority to conduct a motion in limine); *United States v. Bertoli*, 854 F. Supp. 975, 1028 (D.N.J. 1994) (conducting preliminary hearing on admissibility of evidence in interest of justice); *United States v. Ball*, 547 F. Supp. 929, 933-34 (E.D. Tenn. 1981) (resolving certain issues prior to trial).

¹²¹ See *Markman v. Westview Instrument Inc.*, 52 F.3d 967, 989 (Fed. Cir. 1995) (Mayer, J., concurring), *cert granted*, ___ U.S. ___, 116 S. Ct. 40 (concluding majority’s decision relegates jury function to “rubber stamping” court’s findings).

¹²² See *id.* (claiming several judges feel jurors are incapable of reasoned decision making); see also SWABB, *supra* note 88 (suggesting CAFC considered taking patent cases away from jurors); MEDLOCK, *supra* note 46, at 94 (speculating that motivation of *Markman* decision is to eject jurors from patent cases).

Court accepted the premise that hearing expert testimony will prejudice jurors.¹²³

In drafting Rule 104(c) the United States Congress recognized the possibility that a jury may hear irrelevant evidence during trial.¹²⁴ Congress noted, however, that irrelevant evidence can be admitted during a trial without affecting the jurors factual decision.¹²⁵ Conducting a "Markman trial," in order to prevent the jury from hearing expert testimony relevant to claim construction, contradicts the intention of Rule 104 as well as CAFC precedent.¹²⁶

IV. CONCLUSION

Whether intentional or not, the CAFC and the United States Supreme Court provided trial judges with the ability to disregard the Federal Rules of Evidence when deciding whether to conduct a "Markman trial." Trial judges are permitted this luxury because claim construction, which includes term interpretation, is purely a question of law and not a mixed issue. Had the Supreme Court overruled the CAFC decision and labeled claim construction a mixed issue, the disputed term within the patent claim would have been interpreted as a question of fact. In turn, this question of fact would require an answer before responding to the legal issue of claim construction. Regardless of whether term interpretation is referred to as a question of law or fact, it requires a factual inquiry. Assuming that the trial judge maintained the responsibility of interpreting the meaning of a disputed term, term interpretation would be a preliminary question of fact.

In order to conduct a preliminary trial and admit expert testimony to assist the trier of fact in interpreting the meaning of a disputed term, the Federal Rules of Evidence must be followed. *Markman*, however, contradicts the Federal Rules. In *Markman*, the Supreme Court realized that its holding contained evidentiary ramifications but neglected to suggest a practical approach for a trial judge to resolve a dispute over a term within a patent claim. Rather, the Supreme Court merely stated that claim construction and term interpretation are questions for the court and not specifically questions of fact or law. In doing so

¹²³ See *Markman v. Westview Instruments, Inc.*, __ U.S. at __, 116 S. Ct. 1384, 1395 (1996) (per curiam) (discussing how trained trial judge can evaluate demeanor of expert witness better than lay juror); see also *Markman*, 52 F.3d at 1006 (Newman, J., dissenting) (illustrating procedural effect of majority decision deprives jury from weighing extrinsic evidence).

¹²⁴ FED. R. EVID. 104(c) advisory committee's note. The advisory committee's note states in pertinent part: "Much evidence on preliminary questions, though not relevant to jury issues, may be heard by the jury with no adverse effect." *Id.*

¹²⁵ *Id.*

¹²⁶ See *supra* text and accompanying notes 111-27.

the Supreme Court conveniently avoided the difficult issue of whether a "Markman trial" accords with the Federal Rules of Evidence. Had the Supreme Court held term interpretation a question of fact, a trial judge would have to abide by the Federal Rules of Evidence when deciding whether to conduct a "Markman trial." Rule 104 would prevent such a proceeding.

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