Claim Construction Must Be Reexamined - As a Matter of Fact, Pitney Bowes Undermines Markman

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by
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I
Introduction

In *Markman*, the Supreme Court unanimously held that in patent infringement suits, construction of the claims is a matter of law for the judge, and infringement is a factual matter to be determined by the trier of fact.\(^1\) It has been argued that issues involved in claim construction are not solely matters of law, that if they involve disputed claim terms upon which evidence is heard, these issues are inherently and undeniably factual in nature.\(^2\) If claim construction truly presents factual matters, then *Markman* defies the Seventh Amendment by summarily determining that factual questions are matters of law, thereby removing the determination of such questions from the province of the jury.\(^3\)

If there is no dispute as to the construction or scope of a claim, resolution of the issue as a matter of law “could not be otherwise.”\(^4\) In such cases, evidence will likely be unnecessary. However, case law clearly indicates that disputed claim terms become matters of fact in claim construction, and interpretation of such terms properly becomes a task for the jury.\(^5\) These conflicts imminently require the
judge to make credibility determinations, to weigh the evidence presented, and to draw legitimate inferences from these facts, all of which are tasks traditionally relegated to the trier of fact.\(^6\)

The Federal Circuit's *Vitronics* decision, which followed closely on the heels of *Markman*, held that the use of extrinsic evidence was improper unless the patent documents proved to be unclear.\(^7\) Despite *Vitronics*’ placement of substantial limits on the potential use of extrinsic evidence, the court conceded that this evidence could be used to enhance the technical knowledge of the district court judge.\(^8\) However, in a diametric opinion, the Federal Circuit in *Pitney Bowes* set forth an entirely new standard for the use of extrinsic evidence in claim construction.\(^9\) *Pitney Bowes* openly permits the use of extrinsic evidence in any and all cases except to contradict the clear meaning of the intrinsic documents.\(^10\) This opinion has opened the door to the admission of extrinsic evidence in support of possible meanings of disputed claim terms. As a result, it is likely to become increasingly common for judges to engage in making credibility determinations, weighing evidence presented, and drawing legitimate inferences from facts. The increased frequency with which judges will engage in duties traditionally left to the trier of fact will make it increasingly more difficult for the Court to argue that claim construction is truly a matter of law, as *Markman* demands.

In *Markman*, the Court dismissed the fact that trial courts would have extensive opportunities to make factual determinations\(^12\), although under *Pitney Bowes* the admission of extrinsic evidence in association with factual disputes is likely to occur frequently. In *Pitney Bowes*, the Federal Circuit has basically mandated that evidence be taken on disputed issues of fact.\(^13\) Determination of such

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\(^6\) See *Markman*, 52 F.3d at 1005 (Newman, J., dissenting).

\(^7\) *Vitronics v. Conceptronics*, 90 F.3d 1576, 1583 (Fed. Cir. 1996).

\(^8\) *Id.* at 1583-85.

\(^9\) *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309 (Fed. Cir. 1999) (suggesting that “consultation of extrinsic evidence is particularly appropriate ”).

\(^10\) *Id.*

\(^11\) See *Southwall Tech., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1578 (Fed. Cir. 1995) (“Evidence extrinsic to the patent and prosecution history, such as expert testimony, cannot be relied on to change the meaning of the claims when that meaning is made clear by those documents.”).

\(^12\) *Markman*, 517 U.S. at 389 (“[I]n theory there could be a case in which a . . . credibility judgment [would need to be made in choosing] between experts whose testimony was equally consistent with a patent's internal logic. But [we are] doubtful that trial courts will run into many cases like that.”).

\(^13\) *Pitney Bowes*, 182 F.3d at 1309 (noting that it is “perhaps even preferable, for a
factual issues would be more appropriately served by triers of fact, rather than by judges as matters of law. *Markman* has given trial judges the authority to make factual determinations on their own, which "flies in the face" of Seventh Amendment guarantees.\(^\text{14}\) *Markman* may promote inefficiency in the system and effect a denial of rights under the laws of evidence, "create[ing] a procedural quandary, [since] extrinsic evidence can apparently be received, but no jury can weigh it."\(^\text{15}\)

This paper will examine the backdrop against which the Supreme Court in *Markman* deemed claim construction to be a matter of law solely for district court judges, it will explore reasons for which the Federal Circuit's *Vitronics* opinion helped sustain *Markman*, and it will thereafter explore reasons why the Federal Circuit’s recent *Pitney Bowes* decision ultimately undermines the *Markman* holding. Given the ramifications of *Pitney Bowes*, it will become necessary for the Court to reexamine whether claim construction should remain a matter of law or whether the Court should acknowledge its factual nature, which would subsequently compel the Court to reexamine whether or not Seventh Amendment guarantees are being upheld.

II

Background

A. Distinguishing Law and Fact

In defining what "law" is, it has been suggested that "[d]eclarations of law are fact-free general principles that are applicable to all, or at least to many, disputes and not simply to one sub judice."\(^\text{16}\) This means that matters of law, once determined, should have cross-applicability to other factual situations, essentially embodying a "general principle or rule, predicated in advance, awaiting application to particular facts as they may arise."\(^\text{17}\)
On the other hand, "fact" has been defined as:
A thing done; an action performed or an incident transpiring; an event or circumstance; an actual occurrence; an actual happening in time or space or an event mental or physical; that which has taken place.... 'Fact' means reality of events or things the actual occurrence or existence of which is to be determined by evidence.\(^{18}\)

It had been suggested that a fact is something that exists and is true; that "[a]ll inquiries into truth, the reality, the actuality of things are inquiries into the fact about them."\(^{19}\) It has been further suggested "that a controlling distinction between law and fact is whether evidence is needed, for a question of fact usually calls for proof, whereas matters of law are established not by evidentiary showing but by intellectual abstraction."\(^{20}\)

The classification of an issue as law or fact, in addition to being important at the trial court level in determining which matters are appropriately within the province of the judge and which are to go to the jury, will ultimately determine the standard of review that the issue will be afforded upon appeal.\(^{21}\) The level of appellate review has important implications. If a de novo review is to be conducted, the appellate court will have to reconsider issues that have been summarily decided by the trial judge. The appellate court may not have the benefit of consulting a detailed trial record, particularly if the trial judge has benefited from a technology tutorial presented by the parties.\(^{22}\) In patent litigation, the technology can often be complex and arduous, requiring much more than a typical review of the lower court's record.\(^{23}\) The appellate court may need to go to much greater lengths to gain an adequate understanding of the underlying disputed factual issues.\(^{24}\) In *Cybor v. FAS*, the Federal Circuit reaffirmed that claim construction was to be reviewed de novo in all cases, emphasizing its classification as a matter of law.\(^{25}\)

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22. See *Markman*, 52 F.3d at 1021 (Fed. Cir. 1995) (Newman, J., dissenting); *Vitronics*, 90 F.3d at 1585.
24. Id.
25. *Cybor*, 138 F.3d at 1455 ("We conclude that the de novo standard of review as stated in *Markman* [at the Federal Circuit] remains good law.").
B. Inconsistent Precedent in Distinguishing Law and Fact in Federal Circuit Claim Constructions

In 1983, the Federal Circuit held claim construction to be a matter of law requiring determination by the trial judge.\(^{26}\) The court continued to hold claim construction to be a matter of law,\(^ {27}\) although it deviated from its precedent in 1984 with *McGill Inc. v. John Zink Co.*, in which it held claim construction to possibly have "underlying inquiries that must be submitted to a jury."\(^ {28}\) In *McGill*, the court stated 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."\(^ {29}\) Despite this holding, the Federal Circuit in *Markman* suggested that its initial interpretations of claim construction issues as a matter of fact were not authoritatively supported.\(^ {30}\)

1. Claim Construction as a Matter of Fact

Federal Circuit decisions finding claim construction issues to be matters of fact were issued over a period of eight years.\(^ {31}\) These decisions were not called into question until they were cast aside in *Markman*, which implicitly overruled each one and questioned the assertion that factual issues arising in claim construction are properly presented to a jury.\(^ {32}\) In such cases, district courts have submitted disputed issues of fact, upon which extrinsic evidence has been offered, to juries, and the Federal Circuit has thereafter not applied de novo standard of review.\(^ {33}\) In *McGill*, the Federal Circuit said that reversal would only be granted if "[appellant] demonstrate[d] that no reasonable juror could have interpreted the claim in the fashion that support[ed] the infringement finding."\(^ {34}\) The court stated that


\(^{28}\) *McGill*, 736 F.2d at 672, cited in *Markman*, 52 F.3d at 976.

\(^{29}\) Id. at 672, cited in *Markman*, 52 F.3d at 976; see also Hong Kong Export Credit Ins. Co. v. Dun & Bradstreet, 414 F. Supp. 153, 157 (S.D.N.Y. 1975); Butler v. Local Union 823, 514 F.2d 442, 452 (8th Cir. 1975).

\(^{30}\) *Markman*, 52 F.3d at 977, referring to Hong Kong Export, 414 F. Supp. at 157; Butler, 514 F.2d at 452.

\(^{31}\) See *Markman*, 52 F.3d at 1017-20 (Newman, J., dissenting); see also supra n. 5.

\(^{32}\) *Markman*, 52 F.3d at 1017-20 (Newman dissenting); see also supra n. 5.

\(^{33}\) See *Markman*, 52 F.3d at 1017 (Newman, J., dissenting).

\(^{34}\) Id.
“[appellant] must convince [it] that there is no set of facts, consistent with [appellee’s] interpretation, that was supported by substantial evidence.”

In *Bio-Rad Labs*, the Federal Circuit also emphasized that disputed matters of fact should be considered by juries and should not be reviewed de novo, similarly suggesting that such matters were factual in nature, when it set forth that:

> Our task is not to interpret the claims as though no trial occurred. Both parties submitted testimony in support of their interpretation before the jury. Bio-Rad’s interpretation prevailed and was not overturned by the trial judge. On appeal, we consider only whether reasonable jurors could have interpreted the claim in the manner presumed.

In this line of cases, which advocated that disputed matters of fact were to be presented to the trier of fact at trial, the Federal Circuit was clear regarding the propriety of submitting factual matters to juries. The court did recognize, however, that if a term’s meaning was not disputed, it was appropriate for the claim to be construed as a matter of law.

2. Claim Construction as a Matter of Law

There is another line of cases, which holds that claim construction is a matter of law to be determined solely by the judge.

The Federal Circuit based its *Markman* decision upon a perceived tendency by the Supreme Court to hold claim construction to be a matter of law for the judge to decide upon, although reliance on these cases is disputed by the *Markman* dissent. Judge Newman in his dissent noted that although:

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35. *Id.*
36. *Bio-Rad Labs*, 739 F.2d at 614.
37. *See Palumbo*, 762 F.2d at 974.
38. *Palumbo*, 762 F.2d at 974. *See also Tol-O-Matic*, 945 F.2d at 1549-50; *Perini*, 832 F.2d at 584; *H.H. Robertson*, 820 F.2d at 389; *Moeller*, 794 F.2d at 657.
Construction of a patent claim is a matter of law exclusively for the court. . . . [in] deciding the legal effect of a patent claim, and when stating the law to be applied by the trier of fact in interpreting disputed terms. However, it is not correct with respect to findings of disputed factual issues, issues that usually relate to the meaning and scope of the technologic terms and words on technical art that define the invention. Even the majority’s selected authority recognized that such issues are factual, to be found by the jury. Although the majority now equates these factual findings with ‘construction of a patent,’ the Supreme Court did not.42

The majority in Markman places reliance upon the patent being a written instrument, reasoning that the court is better suited to determine the meaning and scope of the claims as a matter of law.43 When concurring and dissenting judges liken the patent to a contract for purposes of construction and interpretation, the majority balks, firmly holding that a patent is not a contract.44 In so stating, the majority is unwilling to credit the concurring and dissenting argument that, although:

Traditionally courts have treated the construction of [contracts, deeds, and wills] as being a legal question for the court, . . . [they] have stated that under certain circumstances the interpretation of an agreement may raise jury triable questions. Thus, by analogy, . . . although claim construction may indeed be a question of law for the court, it also involves (or . . . may involve) triable issues of fact.45

If the majority were to concede that a patent might be likened to a contract, in accordance with its status as a written instrument, they would then have to address the two situations in which factual issues do arise in contractual situations.46 A question of fact may arise in a contract dispute when “the document may not reflect the agreement between, or the intent of, the two parties” in which the parol evidence rule is thereby invoked.47 There is no parol evidence rule in patent law, thus this situation is not relevant.48 A question of fact will also arise in a contract dispute if there is an ambiguous term, which often arises in the patent context.49 If there is an ambiguous term, the parol evidence rule is inapplicable, enabling the parties to introduce extrinsic evidence “to demonstrate what the parties intended when

42. Id. (emphasis added).
43. Markman, 52 F.3d at 978.
44. See id. at 985, n. 14 (“A patent . . . is not a contract.”).
45. Id. at 984.
46. See id. at 985.
47. Id.
48. See id.
49. See id.
they used the term. Thus the factual inquiry for the jury in these cases focuses on the subjective intent of the parties when they entered into the agreement.\footnote{Id.}

The majority discredits the applicability of the situation involving the factual resolution of a disputed term. They insist that patent claim language is interpreted, not based on the subjective intent of the parties, but is objectively based upon “what one of ordinary skill in the art at the time of the invention would have understood the term to mean.”\footnote{Id. at 986.} The court goes on to state that “ideally there should be no ‘ambiguity’ in claim language to one of ordinary skill in the art that would require resort to evidence outside the specification and prosecution history . . . . [W]ritten descriptions of the invention . . . [are] full, clear, concise, and exact.”\footnote{Id.} The court cites the purpose of patent specification requirements as “avoidance of the kind of ambiguity that allows introduction of extrinsic evidence in the contract law analogy.”\footnote{Id. at 987.} The court does not suggest that extrinsic evidence will never come in, as is clearly not the case, although it does state that “unfamiliarity of the court,” and “not ambiguity” of the terms will usually necessitate the use of extrinsic evidence.\footnote{Id. at 979.} The court finds that the more appropriate analogy to patent claims as written documents is found in statutory interpretation where “interpretation is a matter of law strictly for the court.”\footnote{Id. at 978, citing Levy v. Gadsby, 7 U.S. 180, 186 (1805); Eddy v. Prudence Bonds Corp., 165 F.2d 157, 163 (2d Cir. 1947) (‘‘Appellate courts have untrammeled power to interpret written documents.’’); 4 Samuel Williston, Williston on Contracts § 601, at 303 (3d ed. 1961) (‘‘Upon countless occasions, the courts have declared it to be the responsibility of the judge to interpret and construe written instruments, whatever their nature.’’).}

The Federal Circuit has clearly created inconsistent precedent, which it sought to settle in \textit{Markman} by ultimately choosing its line of cases holding claim construction to be a matter of law.\footnote{Id.} The Federal Circuit explained that the reason it would thereafter construe patent claims as a matter of law “as a factual matter is straightforward: It has long been and continues to be a fundamental principle of American law that ‘the construction of a written evidence is exclusively with the court.’”\footnote{Id. at 978.} The Federal Circuit expressed concern for predictability and
accuracy in claim construction, ultimately determining that these factors would be best preserved by excluding the jury from claim construction.\(^{58}\)

C. Markman v. Westview Instruments - Claim Construction is a Matter of Law

The landmark case defining claim construction is *Markman v. Westview Instruments*.\(^{59}\) Markman sued Westview for patent infringement of a machine used in the dry cleaning business.\(^{60}\) At trial, there was a dispute as to the meaning of the term “inventory” as used in Markman’s patent claim, and an expert testified as to the meaning of the term before the jury.\(^{61}\) After comparing the patent to Westview’s machine, the jury found that the patent had been infringed.\(^{62}\) Before jury deliberations, Westview had moved for judgment as a matter of law, upon which the judge had deferred judgment.\(^{63}\) After the jury returned its verdict, presumably Westview renewed their motion, and the judge proceeded to direct entry of judgment as a matter of law.\(^{64}\) In doing so, the district court substituted its own construction of the term “inventory” for that which the jury had given it.\(^{65}\)

Markman appealed the district court’s action and, after the Federal Circuit ruled that the trial judge was entitled to make such determinations, and the Federal Circuit thereafter affirmed en banc, Supreme Court review was sought and certiorari was granted.\(^{66}\) In affirming the Federal Circuit, the Supreme Court unanimously held that “the construction of a patent, including terms of art within its claim, is exclusively within the province of the court.”\(^{67}\)

The Court based its determination of claim construction law on

\(^{58}\) See *Markman*, 52 F.3d at 979 (asserting that to deem claim construction as a matter of fact would “deprive the inventor of the opportunity to obtain a permanent and universal definition of his rights ... [and would] subject him to the danger of false interpretation”); Appellant’s Petition for Writ for Certiorari at 21-22, *Markman v. Westview*, 52 F.3d 967 (Fed. Cir. 1995) (No. 95-26).


\(^{60}\) See *id.* at 374.

\(^{61}\) *Id.* at 375.

\(^{62}\) See *id.*

\(^{63}\) See *id.*

\(^{64}\) See *id.*

\(^{65}\) *Id.* at 376.

\(^{66}\) See *id.*

\(^{67}\) *Id.* at 372.
an historical analysis. The Court concluded that since judges not juries, were construing the meaning of written instruments under English common law, they were likely doing the same in patent litigation. The Court confirmed this by noting that “as soon as the English reports [began] to describe the construction of patent documents, they show judges construing the terms of the specifications.” The Court argued further that its precedent revealed that construction of patent claims had been a matter of law, analogizing the construction of intellectual property patent claims to land patent interpretation, in which judges construe the words.

The Court also argued that “[t]he construction of written instruments is one of those things that judges do often and are likely to do better than jurors.” The Court notes that claim construction:

[I]s a special occupation, requiring, like all others, special training and practice. The judge, from his training and discipline, is more likely to give a proper interpretation to such instruments than a jury; and he is, therefore, more likely to be correct, in performing such a duty, than a jury can be expected to be.

The Court noted that acceptance of appellant’s argument would “trump” the consideration that must be given to the expertise of the judge, thereby leaving the construction of the claims to the jury “simply because the question is a subject of testimony requiring credibility determinations, which are the jury’s forte.” Although, the Court did proceed to acknowledge that credibility determinations would have to be made about testifying experts, they doubted “that trial courts will run into many cases like that,” making the assumption that “any credibility determinations [would] be subsumed within the necessarily sophisticated analysis of the whole document.” The Court concluded its discussion of this matter by giving the jury’s capability to “evaluate demeanor, to sense the ‘mainsprings of human

68. See id. at 378.
69. Id. at 381-82.
70. Id. at 382, citing Boville v. Moore, Dav. Pat. Cas. 361, 399, 404 (C.P. 1816) (involving a judge submitting a question of novelty to the jury only after explaining some of the language and “stating in what terms the specification runs”).
71. See Markman, 517 U.S. at 382 citing Brown v. Huger, 62 U.S. 305 (1859) (holding that the construction of a land patent was “within the exclusive province of the court.”).
72. Markman, 517 U.S. at 388.
73. Parker v. Hulme, 18 F. Cas. at 1140 cited in Markman, 517 U.S. at 388-389.
74. Markman, 517 U.S. at 389.
75. Id. See also Cybor, 138 F.3d at 1463 (“The Supreme Court in Markman stated that it would be a rare case in which claim construction would turn on an issue such as a credibility judgment between two competing expert witnesses.”).
conduct,\textsuperscript{76} or to reflect community standards" less significance than the judges' "trained ability to evaluate the testimony in relation to the overall structure of the patent."\textsuperscript{77}

The Court did not address the argument that claim construction is "subject to a Seventh Amendment guarantee that a jury will determine the meaning of any disputed term of art about which expert testimony is offered."\textsuperscript{78} The Court noted that it:

\begin{quote}
[N]eed not decide either 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.\textsuperscript{79}
\end{quote}

In so concluding, the Court leaves open the question of whether rights guaranteed by the Seventh Amendment might be infringed as a result of its decision. This issue will almost surely have to be revisited.

The Supreme Court thereafter sets forth that claim construction is a matter of law to be determined by district court judges because "uniformity in the treatment of a given patent" is important.\textsuperscript{80} The Court opines that without uniformity, the uncertainty of patentees in their patent rights would ultimately discourage invention,\textsuperscript{81} and states that:

\begin{quote}
Uniformity would... be ill served by submitting issues of document construction to juries. Making them jury issues would not, to be sure, necessarily leave evidentiary questions of meaning wide open in every new court in which a patent might be litigated, for principles of issue preclusion would ordinarily foster uniformity.\textsuperscript{82}
\end{quote}

Despite the Court's embracing of this "uniformity" concept, it goes on to realize that:

\begin{quote}
[I]ssue preclusion could not be asserted against new and independent infringement defendants even within a given jurisdiction, treating interpretive issues as purely legal will promote (though it will not guarantee) intrajurisdictional certainty through the application of stare decisis on those questions not yet subject to interjurisdictional uniformity under the authority of the single
\end{quote}

\textsuperscript{77} Markman, 517 U.S. at 389-90.
\textsuperscript{78} Id. at 372.
\textsuperscript{79} Id. at 384, n. 10.
\textsuperscript{80} Id. at 390.
\textsuperscript{82} Markman, 517 U.S. at 391.
appeals court. The Court’s realization indicates that issue preclusion may not carry the sense of uniformity it had noted, raising doubt as to the strength of this argument.

As the current law on claim construction, Markman has forced District courts to develop procedures by which they will construe patent claims, and accordingly the Northern District of California has addressed the matter in its Civil Local Rules. Markman has also placed the burden of de novo review on the Federal Circuit for all patent cases appealed on the basis of claim construction, which could prove to be a daunting task.

D. Extrinsic Evidence in Claim Construction

1. Vitronics v. Conceptronics

The same year as the Supreme Court’s unanimous Markman decision, the Federal Circuit in Vitronics set the standard for the use of extrinsic evidence in claim construction. After Markman there was no question that extrinsic evidence may sometimes be presented to educate judges on the technical aspects involved in litigation, although there was some question as to the degree to which extrinsic evidence would need to be used to construe claim terms and their scope. The Federal Circuit indicated that “ideally” the claims would not be ambiguous, so they did not envision extensive use of extrinsic evidence for the purpose of construing claims. However, case law indicates that there are often disputes as to the meaning of claim terms and their scope.

The Federal Circuit in Vitronics was clear that “in interpreting an asserted claim, the court should look first to the intrinsic evidence of record, i.e. the patent itself, including the claims, the specification and, if in evidence, the prosecution history.” The court deemed “[s]uch intrinsic evidence [to be] the most significant source of the

83. Id.
85. Markman, 52 F.3d at 1021, n. 11 (Newman, J., dissenting); Cybor, 138 F.3d at 1455.
86. Markman, 517 U.S. at 370; Vitronics, 90 F.3d at 1576.
87. Markman, 52 F.3d at 986.
88. See id.
89. See supra n. 5.
90. Vitronics, 90 F.3d at 1582, cited in Markman, 52 F.3d at 979.
legally operative meaning of *disputed* claim language. In so stating, the Federal Circuit basically admitted that claims would not be as clear as they propose. The court concedes that disputes will arise, but they designate the intrinsic patent evidence to be most valuable in resolving such disputes, indeed as being "the single best guide to the meaning of a disputed term." The court ultimately resolves that "[i]n those cases where the public record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper." Despite the apparent prohibition on the use of extrinsic evidence if the patent documents are unambiguous, the Federal Circuit does reserve that such evidence is permissible to provide a background in the relevant technology for the court.

2. *Pitney Bowes v. Hewlett-Packard*

The Federal Circuit's most recent decision regarding the use of extrinsic evidence in claim construction turned *Vitronics* on its head. *Vitronics* clearly set forth that the use of extrinsic evidence was to be limited. *Pitney Bowes* provided an entirely new standard for the admission of extrinsic evidence in claim construction, and for all intents and purposes repudiated *Vitronics*. It is notable that the majority opinions in *Vitronics* and *Pitney Bowes* were both written by Judge Michel, yet they are in direct contradiction to one another.

In *Pitney Bowes*, Judge Michel stated that, "*Vitronics* does not prohibit courts from examining extrinsic evidence, even when the patent document is itself clear." He further asserted that, "*Vitronics* does not set forth any rules regarding the admissibility of expert testimony into evidence. Certainly, there are no prohibitions in *Vitronics* on courts hearing evidence from experts." Ultimately resolving that "under *Vitronics*, it is entirely appropriate, perhaps even preferable, for a court to consult trustworthy extrinsic evidence to ensure that the claim construction it is tending to from the patent file is not inconsistent with clearly expressed, plainly apposite, and

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91. *Vitronics*, 90 F.3d at 1582 (emphasis added).
92. *Id.*
93. *Id.* at 1583. Also note that although the court may not think there is any ambiguity in the claim terms, the parties may dispute the meaning of those terms and that in and of itself would cause the term to become a disputed fact.
94. *See Vitronics*, 90 F.3d at 1585.
95. *Pitney Bowes*, 182 F.3d at 1298.
96. *Vitronics*, 90 F.3d at 1583.
97. *Pitney Bowes*, 182 F.3d at 1308.
98. *Id.*
widely held understandings in the pertinent technical field.”

Judges Rader and Plager concurred in the *Pitney Bowes* opinion and suggested that, “[a]ppellate courts can err by giving too much guidance.” Although Judge Michel opined that *Vitronics* “[did] not set forth any rules regarding the admissibility of expert testimony into evidence,” it is abundantly clear that judges and practitioners alike interpreted *Vitronics* as setting forth a standard of limited admissibility of extrinsic evidence in claim construction. The concurring judges realized that “[i]n assessing the reliability of evidence, . . . rarely can distant appellate hindsight improve upon the immediate and informed judgment of the trial judge.”

The concurring judges also suggested that “no strict, uniform rules can anticipate every variable in assessing complex technical evidence. ‘Too much depends upon the particular circumstances of the particular case at issue.’” In *Kumho Tire*, the Supreme Court asserted that “the trial judge must have considerable leeway in deciding how to go about determining whether particular expert testimony is reliable.” This suggests that a district court judge, in hearing the testimony of experts, may not merely be gathering technical information, but most likely is engaging in credibility determinations and weighing of evidence.

The concurrence ultimately concluded that although *Vitronics* condemned reliance upon expert testimony, “this . . . discounted the relevance and helpfulness of testimony from experts skilled in the art to determine the meaning of the claims.” Judges Rader and Plager “applaud” the Federal Circuit’s “restate[ment of] the role of expert testimony” and the trust that they place in district court judges’

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99. *Id.* at 1309.
100. *Id.* at 1314 (Rader and Plager, JJ.; concurring).
101. *Id.* at 1308.
102. *See Bell & Howell Doc. Mgt. Prods. Co. v. Altek Sys.*, 132 F.3d 701, 706 (Fed. Cir. 1997) (“Use of Expert testimony to explain an invention may be useful. But reliance on extrinsic evidence to interpret claims is proper only when the claim language remains genuinely ambiguous after consideration of the intrinsic evidence”); *see also* James B. Altman et al., *The Law of Patent Claim Interpretation: The Revolution Isn’t Finished*, 8 Fed. Cir. B.J. 93, 103 (1998) (“Vitronics has been read to encourage judges to ignore [the understanding of experts skilled in the art at the time the invention was patented] so long as the court thinks that the patent documents are clear.”).
103. *Pitney Bowes*, 182 F.3d at 1314 (Rader and Plager, JJ., concurring).
104. *Id.* (Rader and Plager, JJ., concurring), citing *Kumho Tire Co. v. Carmichael*, 526 U.S. 137, 150 (1999).
105. *Kumho*, 526 U.S. at 152.
106. *Pitney Bowes*, 182 F.3d at 1314 (Rader and Plager, JJ., concurring).
abilities to "[assess] the reliability of expert testimony." Pitney Bowes ultimately condoned the admission of expert testimony to:
(1) supply a proper technological context to understand the claims (words often have meaning only in context), (2) explain the meaning of claim terms as understood by one of skill in the art (the ultimate standard for claim meaning), and (3) help the trial court understand the patent process itself (complex prosecution histories – not to mention specifications – are not familiar to most trial courts).

Under Pitney Bowes, it is proper for expert testimony to be considered, even if the internal patent documents appear clear, in order to assist the judge in gaining a better understanding of the underlying technology and to aid in construction of disputed claim terms.

III
Discussion

A. Claim Construction is More Properly a Matter of Fact

1. Federal Circuit Precedent Supports Claim Construction as a Matter of Fact

Before the Federal Circuit arrived at its conclusion in Markman, its precedent was extremely inconsistent. With this in mind, the court could have argued for application of either its line of precedent classifying claim construction as law or as fact. The court strongly held in many cases that disputed claim terms, calling for further explanation through the use of extrinsic evidence, were properly within the province of the jury. Alternatively, the court held, consistently with Markman, that claim construction was a matter of law to be determined in all cases by the district court judge. The court based its decision to consider claim construction as a matter of law on a historical analysis, in addition to the fact that patents are

107. Id. at 1315.
108. Id. at 1314.
109. Id. at 1309, 1314.
110. Markman, 51 F.3d at 979.
111. See supra n. 5.
written instruments,\textsuperscript{113} although the court’s reasoning appears to be somewhat tenuous.

The Federal Circuit refused to admit that a patent is similar to a contract, although they have some difficulty distinguishing the two. The court asserts that “contracts . . . contain promises that must be performed” and patents contain promises that “[have] been fully executed” once the patent is issued.\textsuperscript{114} Although the majority seeks to base its entire argument on the fact that a patent is written, the mere fact that a patent does not invoke additional promises from the government, is not persuasive in distinguishing it from a contract. The argument is not strengthened by the court’s further assertion that “patent infringement suits have never been viewed as breach of contract actions.”\textsuperscript{115} A patent infringement suit is typically brought against a private party, not the government, from which the patentee has received the patent rights. In this scenario, the accused infringer is not a party to the contract between the patentee and the government. The court asserts that a “competitor does not breach this contract between the government and the inventor by making, using, or selling the accused devices.”\textsuperscript{116} Once again, the competitor is not a party to the contract between the government and the patentee, and would be incapable of breaching the contract.

The court set forth no further reasons for which a patent should not be considered a contract, and by summarily dismissing this argument, avoids the circumstance under which an ambiguous term would raise a question of fact under contract analysis.\textsuperscript{117} The court avoids confrontation of the opposing argument’s truism, which would thrust the issue of claim construction into the realm of fact, rightfully demanding presentation to the jury for determination.

2. \textit{Factual Matters Should Not be Relabeled as Matters of Law}

Issues that are clearly factual, compelling an inquiry into the truth about them,\textsuperscript{118} should not be reclassified as issues of law. It has been suggested that “the appellate assertion of power to treat fact as law [is] ‘drastic in that it amounts to a direct judicial assault on the

\textsuperscript{113} Markman, 52 F.3d at 978.
\textsuperscript{114} \textit{Id.} at 985.
\textsuperscript{115} \textit{Id.}
\textsuperscript{116} \textit{Id.}
\textsuperscript{117} See \textit{id.}
\textsuperscript{118} See James B. Thayer, “\textit{Law and Fact}” in \textit{Jury Trials}, 4 Harv. L. Rev. 147, 153 (1890) \textit{cited in Markman}, 52 F.3d at 1009 (Newman, J., dissenting).
prerogatives of fact finders.'" 119

Common sense dictates that by allowing experts to testify as to the meaning of disputed claim terms, the court will inherently have to weigh evidence and make credibility determinations regarding testimony. In weighing this evidence district court judges will naturally engage in drawing logical inferences from the testimony presented, in an attempt to align it with the internal documents. The Federal Circuit and the Supreme Court maintain that these tasks can be accomplished by the judge as a matter of law, although this seems to defy the role of the jury in patent cases. Triable issues of fact typically go to the jury for their determinations as to credibility of the evidence, weight to be given to the evidence, and logical inferences to be drawn in determining the truth or falsity of the evidence presented. These tasks are equivalent to those being undertaken by the judge in claim construction, which suggests that the court is overstepping its procedural bounds.

In petitioning the Court for certiorari, Petitioner asserted that the district court judge, in directing the verdict, "weighed the evidence [and] evaluated [its] credibility." 120 The Federal Circuit conceded this and determined that the judge would be allowed to engage in such activities, despite their typical reservation for the trier of fact. 121 In determining claim construction to be a matter of law in all cases, the Federal Circuit clarified that its holding would stand "even if 'extrinsic' evidence" - including live 'expert and inventor testimony' - is necessary to determine the meaning of the patent." 122 In other words:

[Whether formula is used to describe the consideration of this evidence, the district court judge actually will decide the weight of the evidence and credibility and demeanor of witnesses in resolving this supposed issue of law. . . . This result flows from a change of labels divorced from substance: the factual dispute merely is relabelled [sic] a question of law."

Petitioner suggests that district court judges are interpreting claim terms, which are properly within the realm of the jury, and that

120. Appellant’s Petition for Writ for Certiorari at 5, Markman v. Westview, 52 F.3d 967 (Fed. Cir. 1995).
121. See id. at 6.
122. Id.
123. Id.
these disputed issues of fact cannot simply be redefined as matters of law.\textsuperscript{124} Consideration of factual matters as law has been referred to as an exercise in "semantics, [where] our choice of words does not always reflect the magic we would prefer to ascribe to them."\textsuperscript{125}

Judge Newman, in dissent of the Federal Circuit's \textit{Markman} decision, strongly urges that "[t]he subject matter that the majority now designates as 'law' – the disputed meaning and scope of technologic terms and words of art as used in particular inventions – is not law, but fact." Judge Newman argues that there can be no question as to the factual nature of the determination being made regarding the term "inventory" in \textit{Markman}.\textsuperscript{126} The meaning of "inventory" is clearly not a matter of law, but an issue of fact, as its meaning is "specific to this invention, this patent, this claim, this system, this defendant. Its determination is for the trier of fact."\textsuperscript{127} In this case, it seems clear that a factual matter has been arbitrarily reclassified as a matter of law, essentially removing the jury from determination of facts that are essential to the final outcomes of patent infringement actions.\textsuperscript{128}

The role of the jury should be respected. Factual matters should not be removed from the province of the jury.\textsuperscript{129} In the past, it has rarely been questioned that determinations regarding the weight and credibility of the evidence "are for the jury, whether the issues are technologic, scientific, or otherwise."\textsuperscript{130} The jury is presumed to be well suited to determine the weight and credibility of testimony because of their "natural intelligence and their practical knowledge of man and the ways of man; and so long as we have jury trials they should not be disturbed in their possession of it, except in a case of manifest and extreme abuse of their function."\textsuperscript{131} Additionally, it has been argued that the Supreme Court's conclusion in \textit{Markman}, designating judges as better suited to construing claims in patent litigation due to the complexity of the evidence, "was a perilous

\textsuperscript{124} See id.

\textsuperscript{125} \textit{Markman}, 52 F.3d at 1009 (Newman, J., dissenting).

\textsuperscript{126} Id.

\textsuperscript{127} Id. at 1010.

\textsuperscript{128} See Appellant's Petition for Writ of Certiorari at 6, \textit{Markman v. Westview}, 52 F.3d 967 (Fed. Cir. 1995) (emphasis in Judge Mayer's Dissent that "infringement often turns on how the patent is interpreted").


\textsuperscript{130} Id.

\textsuperscript{131} \textit{Aetna Life Ins. Co. v. Ward}, 140 U.S. 76, 88 (1891), cited in \textit{Markman}, 52 F.3d at 1007.
decision of last resort.” Furthermore, it is improper to discredit the capability of juries:

For juries regularly render verdicts in civil cases based on complex forensic and documentary evidence of equal or greater difficulty than seen in patent cases. And the implications under Article III and the Sixth Amendment are even more profound. Increasingly complex cases involving scientific and complicated documentary evidence are presented to criminal juries which, of course, decide matters of life and liberty, not merely money.133

The importance of the jury’s role in factual determinations necessitates that such issues remain as matters of fact and should not be reclassified as matters of law.134 This concept has been described in the following way: “In the concert hall of justice, each musician has a part to play. When one on whim plays not his own part, but another’s part, discord is certain.”135 This description seems to capture the very essence of a properly functioning judicial system, in which factual issues remain as such, escaping reclassification as matters of law.

Additionally, in making its decision, it appears that the Federal Circuit did not fully explore the method by which they would obtain the necessary technological facts for appellate review.136 In dissent, Judge Newman asked:

Are we to read the entire record of the trial, re-create the demonstrations, decipher the literature of the science and art; are we to seek our own expert advice; must the parties be told the technical training of our law clerks and staff attorneys? No amicus explained how improved technological correctness—that is, truth—would be more likely to be achieved during the appellate process of page-limited briefs and fifteen minutes per side of argument.137

When triable issues of fact arise, the parties as well as the court would benefit from these issues being properly classified as factual matters, deserving of determination by the trier of fact.

B. *Vitronics’* Perceived Prohibition of Experts Provided Sustenance for Markman

In effect, *Vitronics* helped sustain the Supreme Court’s assertion in *Markman* that claim construction was purely a legal matter to be

133. *Id.*
136. *See* *Markman*, 52 F.3d at 1021, n. 11.
137. *Id.*
determined by the judge. Leaving aside for the moment the central argument that disputed claim terms are more properly issues of fact rather than law and conceding that claim construction is held to be a matter of law, Vitronics was vital to the sustenance of this holding.

In setting forth limitations on the admission of expert testimony and other extrinsic evidence, Vitronics made it appear as though there would be few occasions on which judges would actually be called upon to make factual determinations in the process of claim construction. In indicating that “ideally” the claims would not be ambiguous, the Federal Circuit questioned that disputes requiring extrinsic evidence would be prevalent. Vitronics supported the Markman holding since the Court assumed that district court judges would primarily be dealing with matters of law in claim construction.

C. Pitney Bowes Calls the Markman Holding into Question

1. Admitting Extrinsic Evidence Will Inevitably Lead to Factual Determinations

Judge Michel's turnabout from Vitronics to Pitney Bowes conceivably undermines the Markman holding. Vitronics' limitation on the admissibility of extrinsic evidence theoretically had the effect of excluding matters of fact from claim construction. Under Pitney Bowes, district courts have much more freedom to assess extrinsic evidence in construing patent claims.

The practical effects of the Pitney Bowes standard for admission of extrinsic evidence is not yet apparent, although it seems as though the ease with which such evidence may now be admitted will result in a significant increase in the use of extrinsic evidence in claim constructions. The potential increase in extrinsic evidence will undoubtedly lead to more factual disputes, which will in turn lead to rampant commandeering of factual determinations as matters of law. These determinations are more appropriately within the province of the jury as finders of fact.

138. See Markman, 52 F.3d at 986.
139. Id.
140. Id.
141. Pitney Bowes, 182 F.3d at 1309 (finding that “it is entirely appropriate, perhaps even preferable, for a court to consult . . . extrinsic evidence”).
2. The Distinction between Educational and Evidentiary Expert Testimony is Illusory

Vitronics distinguished between the use of expert testimony to merely educate the district court judge and its use in actual construction of the claims.\(^{142}\) In practice, the evidence presented by experts during claim construction is not evidence of record if concealed within a tutorial session.\(^{143}\) The evidence, although often not claimed to be such, is frequently presented to the judge by way of an educational presentation, which can be jointly created by the parties.\(^{144}\) This is done in an attempt to give the judge a better general understanding of the technology underlying the patent in suit. Undoubtedly, although the parties work together in preparing the presentation for the court, one party is not going to allow information to be presented that may be perceived as biased, thus the information is likely to be balanced. Although the tutorials are not supposed to provide an additional forum for argument of any disputed claim terms, discussion of such terms in some regard may be unavoidable in providing a general technological background.

Experts and inventors are sometimes used to help explain the underlying technology to the court. Through this process, it is possible that district court judges will be simultaneously aided in interpretation of the claims, as this seems unavoidable.\(^{145}\) \("As a matter of logic, [the sole use of the testimony for educational purposes] is difficult to grasp.\) Federal Circuit Judges Mayer and Newman have inquired:

What is the distinction between a trial judge’s understanding of the claims and a trial judge’s interpretation of the claims to the jury? Don’t judges instruct the jury in accordance with their understanding of the claims? In practice, how does this court’s lofty appellate logic work? As this court acknowledges, a trial court must often resort to experts to learn complex new technologies. What happens when the learning influences a trial judge’s interpretation of the claim terms? Are trial judges supposed to disguise the real

\(^{142}\) Vitronics, 90 F.3d at 1585 (“Had the district court relied on the expert testimony and other extrinsic evidence solely to help it understand the underlying technology, we could not say the district court was in error.”).  
\(^{143}\) Id.  
\(^{144}\) The information presented in tutorials is typically general background of the underlying technology of the patent in suit. However, it appears that this neutral presentation, may inadvertently present information to the judge which, in combination with the information previously gained through the parties’ briefs, may incline the judge to begin to preliminarily weigh evidence and make inferences (associated with the any disputed claims) which may properly be gleaned from the tutorial session’s content.  
\(^{145}\) See Cybor, 138 F.3d at 1474 (Mayer and Newman, JJ., dissenting).  
\(^{146}\) Id.
reasons for their interpretation? How will this perverse incentive to 'hide the ball' improve appellate review?\textsuperscript{147}

Testimony presented in a technology tutorial may too frequently leave the judge in a position of determining credibility, weighing evidence, and drawing logical inferences from evidence presented. Arguably, even under \textit{Vitronics}, the Court's holding in \textit{Markman} is precarious. The extensive use of technology tutorials, as well as evidence permitted to explain disputed claim terms, clearly sets the stage for district court judges to make a multitude of factual determinations.\textsuperscript{148}

\section*{D. Construing Claims as a Matter of Law Fails to Recognize Seventh Amendment Guarantees}

Classifying issues arising under claim construction as matters of law, essentially usurps patent litigants' Seventh Amendment guaranteed rights and "trivializes" the United States' heritage of preservation of the right to trial by jury.\textsuperscript{149} For two hundred years, patent infringement suits have been tried to juries in the United States.\textsuperscript{150} Judge Newman, in dissent of the Federal Circuit's opinion in \textit{Markman}, argues that, "[w]hatever version of 'law/fact' this court now chooses to adopt, it can not redact the history of jury trials. The judicial obligation to safeguard the constitutional right is not defeasible by calling a patent a 'statute,' or otherwise diminishing the vitality of the Seventh Amendment."\textsuperscript{151} The Seventh Amendment assures that:

\begin{quote}
In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall otherwise be re-examined in any Court of the United Stated, than according to the rules of the common law.\textsuperscript{152}
\end{quote}

In fashioning the Seventh Amendment, the framers felt that it set forth an important right that was not to be taken lightly.\textsuperscript{153} Alexander

\begin{footnotesize}
\begin{enumerate}
\item[147.] \textit{Id.} at 1474-75.
\item[148.] \textit{See Cybor}, 138 F.3d at 1464 (Mayer and Newman, JJ., dissenting) ("The Supreme Court recognized that in some cases there will be conflicting evidence that has to be resolved – where there are factual determinations that are more than just incident to claim construction – such as the understanding of one skilled in the art at the time the patent application was filed. In these cases, all that \textit{Markman} stands for is that the judge will do the resolving, not the jury.").
\item[149.] \textit{Markman}, 52 F.3d at 1011 (Newman, J., dissenting).
\item[150.] \textit{See id.} at 1010.
\item[151.] \textit{Id.}
\item[152.] U.S. Const. amend. VII.
\item[153.] \textit{See The Federalist No. 83, at 499} (Clinton Rossiter ed., 1961) \textit{cited in Markman},
\end{enumerate}
\end{footnotesize}
Hamilton regarded the right to trial by jury in civil cases "as a valuable safeguard to liberty" and "as the very palladium of free government." Hamilton's statements were emphasized in Dimick v. Schiedt when the Supreme Court set forth that "[m]aintenence of the jury as a fact-finding body is of such importance and occupies so firm a place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be scrutinized with the utmost care."

It has become generally accepted that "the court shall not assume directly or indirectly to take from the jury [issues properly determined by the trier of fact]" and that "[s]o long as the Seventh Amendment stands, the right to a jury trial shall not be rationed." "When two experts testify differently as to the meaning of a technical term, and the court embraces the view of one, the other, or neither while construing the patent claim as a matter of law, the court has engaged in weighing evidence and makingcredibility determinations." In such an instance, the court is clearly impinging upon duties that are properly left to the trier of fact.

Additionally, there seems to be no reason to treat patent cases separately from other civil cases arising under the law and the applicable rules of procedure, despite the Markman majority's holding to the contrary. Ultimately, attempts to segregate patent cases from the guarantees of the Seventh Amendment have been characterized as "egregious" in their disregard of "the jury right in patent cases." In petitioning the Supreme Court for certiorari, appellants in Markman argued that:

The Seventh Amendment does not permit abridging the right to jury trial because of some perceived advantage of decision by the judge rather than the jury. ... [C]onsiderations [of predictability and accuracy] reflect a lack of confidence in juries not shared by the framers of the Constitution. Even on their own terms, however, they are without merit.

52 F.3d at 1010 (Newman, J., dissenting).
154. Id.
157. Markman, 52 F.3d at 1011(Newman, J., dissenting).
158. Cybor, 138 F.3d at 1475 (Rader, J., dissenting).
159. See Markman, 517 U.S. at 391.
160. Markman, 52 F.3d at 1010; see also Appellant's Petition for Writ for Certiorari at 8-9, Markman v. Westview, 52 F.3d 967 (Fed. Cir. 1995).
161. Appellant's Petition for Writ for Certiorari at 21, Markman v. Westview, 52 F.3d
Petitioners questioned the Federal Circuit's findings that judicial determinations would enhance predictability and that there is a "complexity" exception to the Seventh Amendment. In refusing 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," the Supreme Court has failed to answer the question of whether Seventh Amendment guarantees may actually be infringed as a result of their decision.

The Supreme Court has given district court judges the authority to make voluminous factual determinations, even though the trier of fact typically resolves such questions. The propriety of this authority needs to be reconsidered in light of the ease and frequency with which factual disputes will arise under the Pitney Bowes standard for admissibility of extrinsic evidence. Additionally, patent cases are indistinguishable from other civil actions acquiring the right to trial by jury on all triable issue of fact, and Markman's denial of jury interpretation of disputed claims directly defies the Seventh Amendment.

IV
Proposal

Although contradictory to the position taken by the Supreme Court, claim construction undeniably presents issues of fact when claim terms are disputed. Even if the Court chooses to reclassify these issues as matters of law, the fact remains that evidence will be presented in support of the respective sides' arguments as to the true meaning of the terms at the time an invention was patented. District court judges will therefore be in a position to determine the credibility of extrinsic evidence presented, to weigh the evidence, and to draw logical inferences from the presentations in an attempt to logically fit the explanations within the actual claim language and the associated patent documents. In carrying out these tasks, the district court judges will be engaging in activities typically reserved for the trier of fact.

Admittedly, if a judge is conducting a bench trial, there does not

967 (Fed. Cir. 1995).
162. Id. at 21-22 referring to Slocum v. New York Life Ins. Co., 228 U.S. 364, 388 (1913) (holding that complexity of the facts does not determine the applicability of the Seventh Amendment).
163. Markman, 517 U.S. at 384, n. 10.
seem to be any harm in treating the disputed issues of fact as matters of law. The judge will be making the final decision as to the outcome of the infringement action and is best served by having a complete understanding of the claims and the technology, which will be gained through claim construction proceedings. Since the judge is the trier of fact at a bench trial, triable issues of fact may properly be determined at the claim construction or the trial phase.

If however, the trial will be held before a jury, issues of fact should be presented to and determined by the jury. The jury should ideally be educated through a joint technology tutorial. Ideally, the tutorial could be incorporated into the claim construction and/or the trial phase at which the jury is present. The jury should make the final determination as to what meaning the disputed terms shall be given, as these decisions are appropriately within their province as jurors. Juries are capable of comprehending technological information, and furthermore, some jurors may even have more technological experience than presiding judges. Juries are relied upon to make highly technical determinations in criminal cases and in other types of civil litigation, and their abilities should not be questioned simply because the issues presented revolve around patents.

It may also be acceptable, and not in violation of the right to a jury trial, for one jury to determine the meaning of claim terms and for another jury to sit at trial to determine whether the patent has been infringed. The triable issues of fact raised in claim construction may be just as properly determined by one trier of fact as another. This option may not be in the interest of judicial economy, given the time required for jury selection. However, the desire of many attorneys to have claims construed before trial may make a dual jury preferable. It would, however, be inappropriate for the judge to be the trier of fact for purposes of claim construction, which would be equivalent to the judge making determinations as matters of law.

If a jury trial has been requested, a jury, as a single or dual entity, should be responsible for assessing the extrinsic evidence. The jury should also have the opportunity to review the intrinsic evidence associated with the patent, so that their construction does not conflict with the patent documents.
V

Conclusion

The Supreme Court's Markman decision demands reexamination in light of the Federal Circuit's Pitney Bowes decision regarding the admissibility of extrinsic evidence in claim construction proceedings. It is questionable whether disputed issues of fact arising in claim construction can properly be classified as matters of law, or whether they are undeniably and indisputably issues of fact at their very core.\(^{164}\) Claim construction intricately involves factual questions, which must be presented to a jury in order to avoid a direct contradiction with the Seventh Amendment guarantee to a jury trial for resolution of such matters. On this basis, it is conceivable that Markman erroneously removes the determination of such questions from the province of the jury.\(^{165}\)

By placing the judge in a position to make credibility determinations, to weigh the evidence presented, and to draw legitimate inferences from the facts, Markman extracts legitimate factual determinations from the province of the jury.\(^{166}\)

It is notable that the Supreme Court, in certain instances, admits that they authorize district court judges to take on tasks traditionally reserved for the trier of fact. The Court plainly states that the expertise of the judges, outweighs construction of the claims by the jury "simply because the question is a subject of testimony requiring credibility determinations, which are the jury's forte."\(^{167}\) The Court honestly doubts "that trial courts will run into many cases [in which credibility determinations would have to be made about testifying experts]" and assumes that "any credibility determinations [will] be subsumed within the necessarily sophisticated analysis of the whole document."\(^{168}\) However, the district court judge in Markman, in directing the verdict, "weighed the evidence [and] evaluated [its] credibility."\(^{169}\) Nevertheless, the Court places the judges' "trained ability to evaluate the testimony in relation to the overall structure of

\(^{164}\) Markman, 52 F.3d at 1010 (Newman, J., dissenting).
\(^{165}\) Id. at 1002-1011.
\(^{166}\) Id. at 1005 (Newman, J., dissenting).
\(^{167}\) Markman, 517 U.S. at 389.
\(^{168}\) Id. See also Cybor, 138 F.3d at 1463 ("The Supreme Court in Markman stated that it would be a rare case in which claim construction would turn on an issue such as a credibility judgment between two competing expert witnesses.").
\(^{169}\) Appellant's Petition for Writ for Certiorari at 5, Markman v. Westview, 52 F.3d 967 (Fed. Cir. 1995).
the patent” above all else. The jury’s capability to “evaluate demeanor, to sense the ‘mainsprings of human conduct,’ or to reflect community standards” is not considered to be nearly as important.

To further complicate matters, whereas Vitronics limited the potential use of extrinsic evidence, Pitney Bowes’ standard for the use of extrinsic evidence in claim construction has thrust district court judges into the role of the trier of fact in cases where a jury has been requested. Pitney Bowes will make it increasingly more common for judges to determine the credibility and weight to be given to extrinsic evidence. Ultimately, Pitney Bowes will make it very difficult for the Court to continue to argue that claim construction is a matter of law, as judges are plainly engaging in extensive factual determinations. The Supreme Court may not be able to escape reevaluation of Markman and the extent to which its holding affects the guarantees that the Seventh Amendment so generously, yet possibly vainly, provides to civil litigants.

172. Pitney Bowes, 182 F.3d at 1309.
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