Claim Construction in Patent Cases: A Question of Law?

An Exploration of the Cybor Uncertainty Principle

By Frederick L. Whitmer

Fundamental to an understanding of the operation of the modern laws of physics is the so-called uncertainty principle, attributed to Werner von Heisenberg, a Nobel laureate who pioneered quantum mechanics. Whatever may be the significance of von Heisenberg’s principle to modern physics, I believe there is an analogous principle of uncertainty at work in the adjudicatory process related to the construction of claims and the definition of claim terms in patent infringement actions. The significance of this patent uncertainty principle (which I denominate the Cybor uncertainty principle for the reasons that I set forth in this article) I believe is apparent to both litigants and practitioners alike. I likewise believe that it is one that exercises a detrimental effect on the operation of the patent litigation regime in the United States.

This article proposes to (1) describe this patent law uncertainty principle, (2) discuss its origin and consequence, and (3) recommend a practical, legal solution to replace the current regime—one that I believe is characterized by an unacceptable level of uncertainty with respect to the resolution of claim construction issues in patent cases—with a more predictable adjudicatory process. I believe my proposed solution is in line with other, conventional legal and juridical approaches to the interpretation of terms and phrases that have legal significance and is also fully consistent with prevailing Supreme Court authority. My suggestions should not be taken as criticism either of the Federal Circuit or of any specific decision of that court. Rather, my proposals are intended to constrain the level of uncertainty present in the claim construction process within ranges comparable to those respecting the resolution of other litigation issues generally.

What is this uncertainty principle, as I call it, that influences the determinations respecting patent claim construction? The uncertainty principle affecting claim construction stipulates that no two panels of the Federal Circuit are likely to review a district court’s claim construction ruling in the same way at the same time, so that, precisely because of the de novo standard of review that Federal Circuit authority mandates for claim construction decisions, a district court’s claim construction enjoys no special deference on appeal and is therefore subject to reversal simply because two judges on a given Federal Circuit panel disagree with the district court’s decision. I denominate this as the Cybor uncertainty principle because it was in Cybor Corp. v. FAS Technologies, Inc.1 where the Federal Circuit first held that claim construction was a “matter of law.”2 The practical (and surely unintended) consequence of that ruling has been the widespread perception that a district court’s claim construction ruling should usually be regarded as merely an interim, indeed tentative resolution of claim construction issues in infringement actions. And that conclusion appears true irrespective of the amount of time, effort, expense, and deliberation the parties and the court expended in the district court respecting claim construction.

More troubling is the fact that, despite many Federal Circuit decisions that either address various aspects of the nature of the claim construction process or attempt to be more clear and comprehensive in the explication of the methodology to be employed in claim construction, nothing from the Federal Circuit (or the Supreme Court, for that matter) has allayed the pervasive and preponderant perception that a district court’s claim construction rulings are unworthy of long-term respect, precisely because those rulings are subject to de novo review in the Federal Circuit.3 It cannot be seriously disputed that determinative questions regarding just how patent claim terms and phrases are to be interpreted and enforced remain vital and unanswered, questions that continue to present substantial interpretive difficulties for district courts. These are questions that stubbornly resist comprehensive resolution under the current analytical framework for consideration of claim construction issues. The number of opinions from the Federal Circuit that purport to add or restore clarity to the exercise of claim construction seem instead to confuse or complicate the situation more. In this area of legal exegesis at least, “more” has repeatedly proven to be decidedly “less.”4

Recently, of course, the Federal Circuit’s eagerly awaited en banc decision in Phillips v. AMH Corporation5 had widely been expected finally to answer a number of important questions respecting what appeared to be a split of authority in the court directing the correct methodology with which to construe patent claims in infringement actions. After the decision had at long last been rendered, a battalion of commentators have pored over the majority, concurring, and dissenting opinions to draw inferences from what the court said (or did not say) regarding the invariably crucial issues of claim construction in order to make sense of the structure of claim construction law to restore some greater predictability and certainty to the exercise.

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The critical reaction to the decision has hardly been unanimous, especially given the extremely hopeful anticipa-
tion with which many patent practitioners awaited the ruling. In fairness, it may be said that the high expectations that
many had invested in the ruling have not been rewarded by the actual result. Equally fairly, it may be said that the high
hopes were probably the result of either overenthusiasm or naivété to expect a sweeping decision from the Federal Circuit
that would answer all the perceived questions concerning the state of claim construction law. The disappointment that many
have expressed may accordingly be as much the fault of those expecting the last word in a one-size-fits-all answer to the
claim construction problem in the Phillips decision as it may be of the Federal Circuit in raising the expectations.

The Federal Circuit had unquestionably fueled the bar’s anticipa-
tion of the consequences of Phillips by posing a variety of questions to the litigating parties and to the accom-
panying host of amicus parties in the en banc consideration that appeared to promise a more universal response to many
outstanding issues. Notwithstanding the fact that not all the posed questions were answered (indeed, the most significant
questions for long-term effect were left unanswered), there can be no doubt that the majority’s ruling did settle some
important questions, most prominently what is to be (at least for now) the appropriate hierarchy of interpretive sources to be
considered and applied in determining the “ordinary” meaning of words and phrases for interpretation in patent claims.

Resolving what appeared to be a split in the court’s views on the issue, Phillips directs that “ordinary” meanings of claim
terms now will be determined more immediately and significantly from the language of the patent documents themselves
with less reliance or resort to dictionaries and other, extrinsic definitional tools.

Yet even after Phillips, there remains widespread dissatisfaction with the state of the law concerning claim construction.
What is the source of that dissatisfaction? I believe that the chief source of dissatisfaction stems from the inordinately
high reversal rate in the Federal Circuit of district courts’ claim construction rulings, whether in the context of reviewing
summary judgment decisions that dispose of the action finally or, worse still, reversals of judgments after a trial because
the district court is perceived to have committed an error of law in the construction of a critical claim term. This reversal
rate, which some knowledgeable commentators put at nearly 50%, encourages a cynicism about the adjudicatory process
relating to claim construction. With this reversal rate, roughly equivalent to the probability of a coin flip, parties understand-
ably possess a diminished confidence in the likelihood that a district court judgment will be affirmed. This is both the origin
and consequence of the Cybor uncertainty principle to which I alluded earlier.

The chief practical effects of the Cybor uncertainty principle compromise the predictability that is central to a
progressive adjudicatory process. That is so because a de novo review standard, which the Federal Circuit has mandated for
claim construction decisions, markedly increases uncertainty in the already inherently uncertain process of litigation. This,
in turn, undermines a practical utility frequently employed in the district courts, namely, the ability of trial judges to encour-
age amicable resolution of litigated controversies based upon the leverage intrinsic to the perception that a district court’s
rulings are, more likely than not, to be upheld on appeal. This power of the district court has been substantially eroded with
respect to claim construction precisely because any claim construction rendered by a district court is generally considered—
by both litigants and courts alike—to be but an interim step to the “real” fight over claim construction, i.e., that which takes
place during the appeal in the Federal Circuit. This perception is neither desirable nor progressive; to the contrary, it encour-
gages obdurate litigation and the prolongation of controversy.

The core reason for this uncertainty stems from character-
izing the adjudicatory process that leads to a construction of
claims as one purely of law. That characterization strips a
district court’s judgment construing claims of any deference
in the reviewing process, thereby freeing the court of appeals,
which reviews such judgments on a plenary basis, to substitute
its judgment concerning the appropriate claim construction
for what the district court decided—on no greater standard of
review than simple disagreement with the result below. It is
this schema that unsettles predictability.

Phillips does appear, for the moment at least, to resolve one
of the disputed issues respecting the interpretive approach of
claim construction. Ultimately deciding that a patent’s claim
language, its specification, and the relevant prosecution history trump usual dictionary meanings to determine the “ordinary”
meanings to be afforded claim terms, the Federal Circuit held
its judgment concerning the appropriate claim construction
issues as pure questions of law, thereby subject to plenary
appellate review. This view follows a long-standing intellec-
tual development in which the Federal Circuit has developed
an elaborate and complex classification system that categorizes
the issues that affect the enforcement and validity of claims
into pure questions either of fact or of law. The majority’s
long-standing predicate assumption, that claim construction
is purely a matter of law, was, however, directly challenged
in an impassioned dissent by Judge Mayer, joined by Judge
Newman, which opened with the provocative assertion that the
majority’s reiteration that claim construction was a “matter of
law” was, in the dissent’s word a “futility, indeed [an] absurd-
dity . . . in adhering to the falsehood that claim construction is
a matter of law devoid of any factual component.”2

This article examines what the Mayer dissent (hereinafter
“the Dissent”) has labeled a “falsehood,” namely, that claim
construction is a “matter of law.” I argue here that this char-
acterization is, in fact, erroneous and that, until the constituent
factual component of claim construction decision making is
recognized as an unavoidable reality in the adjudicatory pro-
cess, instead of the pervasive legal fiction in which the Federal
Circuit has indulged to assume the exercise to be one “purely”
of law, there will continue to be substantial dissatisfaction
with the whole process.

Much uncertainty could be banished from the process if
only the law were to change the standard of appellate review
of claim construction decisions to accord substantial judicial
defERENCE to a district court’s claim construction ruling. I firmly
believe that until a district court’s claim construction rulings

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are afforded some formal and enhanced level of deference upon appeal, there will continue to be rampant uncertainty and a concomitant (and unfortunate) unpredictability respecting the integrity of a district court’s claim construction rulings. Having now staked that bold claim, I go further: my analysis suggests an alternative doctrinal basis for retaining claim construction as a court function, for which a deferential appellate standard of review would be in place; this, I urge, would yield a system better gauged to ensure uniform and predictable rules of patent law, all while retaining a proper balance between the appropriate and respective roles of the jury, the trial court, and the court of appeals.

**Why the Federal Circuit Says Claim Construction Is a Pure Question of Law and Whether That Is Justified**

At the threshold of any analysis that challenges the legitimacy of the characterization that claim construction is a matter of law is the question what is the intellectual and legal underpinning to that characterization? Only by examining that question may one test the Dissent’s provocative and pejorative conclusion that treating claim construction as a matter of law is indeed a “falsehood.”

First, the Dissent correctly traces the origin of that conclusion to the *en banc* opinion in *Cybor Corp. v. FAS Technologies, Inc.*, which unequivocally declared that claim construction was a pure question of law and that, therefore, all appeals of claim construction decisions would be subject to plenary review.10 The majority in *Cybor* purported to rely on the earlier Supreme Court affirmation of an earlier Federal Circuit opinion in *Markman v. Westview Instruments, Inc.*11 to make its pronouncement. The Federal Circuit had described claim construction as a matter of law in an earlier opinion in the *Markman* matter, but the Supreme Court had granted certiorari in order to consider the question “whether the interpretation of a so-called patent claim . . . is a matter of law reserved entirely for the court, or subject to a Seventh Amendment guarantee that a jury will determine the meaning of any disputed terms of art about which expert testimony is offered.”12 The next sentence of the Supreme Court’s opinion, which described the Court’s inquiry and holding, purports to answer that question. Although it does answer the posed question, it does so in a way that is pregnant with ambiguity. Said a unanimous Supreme Court: “We hold that the construction of a patent including terms of art within its claim, is exclusively within the province of the Court.”13 Though there is no doubt that the Court thereby allocated the claim construction function to courts, as opposed to a fact-finding jury, what the Supreme Court *Markman* opinion never expressly says is that claim construction is allocated to the court precisely because the exercise is purely one of law without any fact-finding jury influence. That omission is significant and justified by the analysis of the Court’s reasoning in allocating claim construction to courts.

It is fair to ask preliminarily: Does the Supreme Court’s own synopsis of its holding equate to a conclusion that the Court held that claim construction was purely a matter of law? I think not. Had that been the essence of the Supreme Court’s holding, that conclusion would have mooted the question of the impact of the Seventh Amendment’s jury trial guarantee, which the Supreme Court went to great pains to analyze. Why? Because the Court’s lengthy analysis of the Seventh Amendment issue would have been academic surplusage to any holding that the claim construction question was purely a matter of law. I think that an informed and better reading of *Markman* compels the answer to that question to be that the Supreme Court did not hold claim construction to be purely a matter of law. Precisely because it did not make that holding necessitated the detailed exploration of the various constitutionally inspired inquiries to determine whether the Seventh Amendment foreclosed an allocation of the claim construction function to the Court alone. The Court was thus impelled to carry out the Seventh Amendment analysis as a direct and constitutionally required inquiry because of the fact-finding component inherent in the construction of patent claims.

I will now demonstrate my support for that reading of *Markman* after first reciting what it was that the Federal Circuit drew from the Supreme Court’s decision to reach the result it did.

How did the Federal Circuit read *Markman* so that patent claim construction was purely a matter of law? The answer is quickly found in *Cybor*. In the second paragraph of the majority opinion, the Federal Circuit observed, “[W]e conclude that the Supreme Court’s unanimous affirmance in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996) . . . of our in banc judgment in that case fully supports our conclusion that claim construction, as a purely legal issue, is subject to *de novo* review on appeal.”14 And further, after the majority had reviewed various parts of the Supreme Court *Markman* opinion, the court observed that “the Supreme Court’s opinion conclusively and repeatedly states that claim construction is purely legal . . . .”15 These statements, however, do not appear to be supported by an informed and dispassionate reading of the Supreme Court’s opinion in *Markman*.

The Supreme Court in *Markman* elaborated a three-part test to determine when a question should be submitted to the jury or decided by the court. First, the court must determine whether the litigation may properly be characterized as a historical matter as traditionally legal or equitable. To do this requires an understanding of the character of analogous litigation in 18th century England. The relevant question to address that issue is whether in 18th century England the common law recognized an action as being “at law” or “in equity.” If the modern litigation under consideration is to be appropriately characterized as being in the “legal” category, the next issue is whether the particular trial decision must be made by the jury in order to preserve the substance of the common law right of trial by jury as it existed in 1791, when the Seventh Amendment came into effect. This inquiry involves further asking whether the particular trial decision was made by a jury in the analogous action at law in 18th century England or by the court.16

If this analysis characterizes the litigation as legal in character and the historical analysis provides no clear answer about the role of a jury in its resolution, then post-Framing precedent, if any, should be considered. If no persuasive precedent is found to answer this question, then functional considerations come into play to determine how to allocate
the function between the court and the jury. Among the functional considerations to be reviewed is whether the task is essentially one of construing documents (a court specialty) or evaluating the credibility of conflicting witnesses (the jury’s reputed forte). Also central to the analysis is whether the factual question is potentially the ultimate issue in the litigation or is merely a fact that contributes to the resolution of the ultimate issue.

The Supreme Court in *Markman* concluded that because written claims were not even a part of an 18th century patent, it could not have been within the jury’s purview of responsibility to determine the meaning of any specific term of art found in a claim, for “claims” did not yet exist. Put another way, the boundaries of the common law right to trial by jury at the time of the Framing define Seventh Amendment rights, so that if, as the Court found, there were no written claims prior to 1791, the jury could have had no fact-finding function at the time of the Framing. Post-Framing precedent, moreover, characterizes the question of construing the patent as a question for the court and determining infringement as a question of fact for the jury. The Supreme Court, however, found no persuasive authority of its own that required a jury trial on the particular issue of how certain terms of art in the patent were to be construed. Because early 19th century issues of patent construction are most similar to the current issues of claim construction, *Markman* found that the post-Framing precedent supported making claim construction an issue for the court, and not the jury. Turning to the functional considerations, the *Markman* Court then noted the importance of the claims being construed in a way that is consistent with the patent as a whole. Once again, the Supreme Court believed a court better able to perform this function than a jury, inasmuch as claim construction is most akin to the construction of legal instruments, traditionally a court function. Therefore, the task of construing the claims, including, specifically, of determining the meaning of any disputed terms, is given to the court, not to the jury, as a practical, jurisprudential matter. The allocation of the claim construction function to the Court, however, does not turn on a constitutional footing.

It overstates *Markman*’s holding to equate its conclusion that an issue is “for the Court” to decide with a characterization that the claim construction exercise is therefore a pure question of law. A mundane and commonplace example proves the point why this equation is both facile and incorrect. It is unquestionably the case that the determination whether an injunction should issue is an equitable decision for the court. In a preliminary injunction application, for example, the court regularly makes extensive fact-finding, all in support of the necessary legal determination whether an injunction should issue. The fact that the legal determination of whether to grant an injunction rests with the court in no way changes the fact that there are a host of subsidiary fact-findings—made by the court—required to support the conclusion. The function of determining whether to grant the injunction, on the basis of the facts as they are found by the court, remains “within the province of the court”—as a legal function, consistent with the Seventh Amendment.

Functional considerations present a similar calculus, which the Supreme Court likewise recognized. The Court conceded the importance of patent claims being construed in a way that is consistent with the patent as a whole. The Court held that courts were in a better position, as a functional matter, to perform this analysis than was a jury, especially because claim construction is more akin to the construction of legal instruments, traditionally a court function, but one that clearly implicates fact-finding. Therefore, the task of construing the claims, including, specifically, determining the meaning of any disputed terms, is allocated more reasonably to the court and not to the jury because the analytical and deliberative functions of claim construction are better accomplished by the court. This provides a way to assure a more consistent and sensible interpretation of the patent. The court’s functional analysis relates to the question whether the function involves fact-finding, but is independent of that determination.

I submit that any analytical framework that equates a function’s being allocated to a court (as opposed to a jury) as meaning that such function is, as a consequence, a pure matter of law misunderstands the nuance of the Supreme Court’s analysis. The Court directed that courts appropriately exercised the obligation to construe patent claims in order to resolve the questions of infringement and validity as a functionally superior allocation of adjudicatory responsibility. The Court did not direct that a court should carry out the claim construction exercise for the benefit of instructing a jury in connection with the resolution of the infringement and validity questions as a consequence of having determined that the claim construction function was exclusively legal devoid of fact-finding elements. Neither the Seventh Amendment protection of jury trial rights nor anything else compelled that a jury resolve the claim construction issues.

The analytical framework and the logic of the Supreme Court’s decision in *Markman* accordingly do not support the Federal Circuit’s oft-repeated conclusion that when the primary evidence is documents and witness’s testimony is directed towards the explanation of the documents, then the trial judge should sit as finder of fact. Indeed, *Markman*, relying on the authority of *Bischoff v. Wethered*, drew a sharp analytical line between the construction of a legal instrument, which was deemed to be the responsibility of the court, and the characterization of an object that is described by a document but that exists outside of the document itself. *Markman* says that a court’s legal function does not extend to the latter.

A brief study of *Bischoff* helps clarify the distinction. *Bischoff* was an action at law for damages. Plaintiffs purchased an interest in a patent that was warranted to be “valid and in all respects unimpeachable” and brought an action to recover the price. Plaintiffs asserted that the patent was in fact not novel in view of an earlier issued patent. The Supreme Court there affirmed the trial court’s refusal to instruct the jury on whether lack of novelty had been shown, stating:

> It is undoubtedly the common practice of the United States Circuit Courts, in actions at law, . . . where a patent under consideration is attempted to be invalidated by a prior patent, to take evidence of experts . . . as to the identity or diversity between them; and to submit all the evidence to the jury.
under general instructions as to the rules by which they are to consider the evidence. . . . [Identity or diversity of invention is a] question of fact for the jury, and not . . . a question of law for the court. . . .

It may be objected to this view that it is the province of the court, and not the jury, to construe the meaning of documentary evidence. This is true. But the specifications of patents for inventions are documents of a peculiar kind. They profess to describe [things] which have their existence in pais, outside of the documents themselves. . . . This outward embodiment of the terms contained in the patent is the thing invented, and is to be properly sought . . . by evidence in pais.23

Bischoff thus seems to require a conclusion that defining objects outside a legal document constitutes a fact-finding exercise. By extension then, employing that assumption surely compels the conclusion that definition of terms found within a patent claim must relate to matters outside the patent because the whole exercise of determining infringement turns on whether exogenous objects or methods fall within or without the scope of the claims intrinsic to the patent. As Bischoff says, the “outward embodiment of the terms contained in the patent is the thing invented, and is to be properly sought, like the explanation of all latent ambiguities arising from the description of external things, by evidence in pais.” All this exquisitely describes a fact-finding exercise. Yet Markman allocates this exercise to the court, not because it has somehow, as if by some magic, transformed itself into a question of law, but rather because the ultimate function of construing claims is better borne by the court, including the subsidiary factual determinations that are constituent of the exercise of construing a patent—as a functional matter.24

Accordingly, as I read and harmonize the holdings of Markman and Cybor, the Supreme Court did not hold that claim construction was a matter of law. The Court’s allocation of the responsibility to construe the claims to the province of the court was directed as a functional convenience that was not disturbed or affected by the Seventh Amendment because there was no jury right to claim construction in the first place. The Dissent is accordingly on solid precedential ground to say that any conclusion that rests on the assumption that the Supreme Court held in Markman that claim construction is a matter of law misreads Markman. Yet, another perspective supports that conclusion as well. Were the Supreme Court’s ruling in Markman that claim construction was a matter of law, there would have been no need whatever to explore the implication of the Seventh Amendment or even to canvass the ancient authorities respecting the function of the jury at the time of the Framing because purely legal questions would not provoke the need for such analysis. Indeed, the Dissent correctly observes that nothing in Markman characterizes or transforms the deliberative process to define claim terms to be, somehow, exclusively a legal question. Rather, following very traditional, constitutional analyses into the requirements of the Seventh Amendment, which guarantees the right to a jury in civil cases, the Supreme Court in Markman concluded that the Seventh Amendment did not require a federal court to submit claim construction questions to the jury to resolve.

The holding in Markman, therefore, concludes that there is no constitutional requirement to have juries to resolve the claim construction issues and that questions surrounding claim construction were more appropriately for the court. Markman accordingly represents no more than a policy choice that a court, as opposed to a jury, is the appropriate adjudicatory office to resolve claim construction issues. What Markman decidedly does not hold is that the court, rather than a jury, must decide claim construction issues because that exercise is exclusively a legal question for the court, independent of any fact-finding function.

I am therefore constrained to conclude that the Federal Circuit’s subsequent characterization, in Cybor, that claim construction is a matter of law is a mischaracterization, and one that does not truly rest on any Supreme Court authority, in either holding or dictum. Yet that characterization constitutes the very foundation for the de novo standard of appellate review that is now the norm for claim construction rulings. And it is that de novo standard of review that paves the way for the seemingly ad hoc nature of claim construction rulings that bedevils district court litigants and judges alike, and prompts the exceedingly high reversal rate in the Federal Circuit of claim construction rulings.

I turn next to the Federal Circuit’s morphology of questions relevant to the enforcement and validity of patents to apply the reasoning of these cases to the claim construction issues.

The Federal Circuit’s Classification of Questions: A Black and White Morphology

The Federal Circuit has identified four distinct issues relating to patent validity as being pure questions of law: (1) obviousness;25 (2) enablement;26 (3) compliance with 35 U.S.C. § 112, second paragraph (hereinafter “definiteness”);27 and (4) whether certain activities or publications constitute prior art under 35 U.S.C. § 102(b).28 Without accepting that any of these characterizations is correct, I ask how these decisions (and their logic) compare to the Cybor characterization of claim construction as a matter of law.

It seems to me that the characterization of all these questions as matters of law, as in Cybor relative to claim construction, misses the fundamental issue, and, as a consequence, all involve a flawed analysis. The overarching problem with the Federal Circuit’s general approach appears to be the desire to cleave all questions into being either pure questions of law or pure questions of fact for resolution by, potentially, a jury. This approach attempts to impose a neatness of analysis on a series of questions and issues that do not admit to so tidy a set of characterizations.29 As the Dissent shrewdly notes, the universe of questions presented for decisions in most actions do not neatly fall into either one category or the other.30 Mixed questions of law and fact, where the resolution of constituent factual issues governs the resolution of legal issues, frequently predominate in the decision-making process. These mixed questions often present vexing questions of how to resolve and who should resolve. As important to the resolution of these questions, of course, is the appellate standard of review that is implicated by the methodology and characterizations used.
There exists a range of views concerning what standard of review should be applied when a question on appeal involves both a legal standard and a set of historical facts. The general rule appears to be that the inferences that are drawn from the established historical facts are themselves considered to be “facts” and are subjected to review under the “clear error” standard when found by a trial judge or the “substantial evidence” test when found by a jury.31

Alternative views are frequently expressed but not generally followed. Some exemplary decisions follow to outline the general contours of the various positions taken by courts to illustrate the point of departure for our suggestion respecting the general contours of the various positions taken by courts to ally followed. Some exemplary decisions follow to outline the evidence” test when found by a jury.31

Although possession is a legal concept, whether particular “facts” show possession is itself a “fact” for the purposes of separating the trial judge’s function from our own. Negligence is another such fact. Facts of this sort, which are found by applying a legal standard to a descriptive or historical narrative, are governed by the clearly erroneous rule.

Admittedly, there is much waffling on this point in the cases, which led the Supreme Court to note in Pullman-Standard v. Swint, 102 S. Ct. 1781, 1790 n.19 (1982) . . . that there “is substantial authority in the Circuits on both sides of” “the much-mooted issue of the applicability of the Rule 52(a) standard to mixed issues of law and fact.” . . . But most courts treat legal characterizations . . . as facts to which the clearly erroneous standard applies.33

The same analysis is equally appropriate when a jury trial has been demanded:

In the usual suit on a written contract there is no trial, because the only evidence is the contract itself. When as in this case there is extrinsic evidence of the contractual meaning as well, but that evidence is not disputed in itself although the inferences to be drawn from it are, the only real issue for trial is the ultimate issue of what the contract means. . . . In a jury case that would be a question for the jury, for with immaterial exceptions the jury is the finder of ultimate facts (or as they are sometimes called “mixed questions of fact and law”), such as negligence, as well as primary facts, such as how fast the defendant’s car was going.34

This analysis too is not unanimously followed. Take as one example a case involving the issue of “residence,” usually considered a “fact,” to be sure, but one pregnant with legal significance. As to that issue, the First Circuit once said the following:

Determining residence can present distinctive issues either of law or fact; but quite commonly in the end the question—often called a mixed question of law and fact”—turns on applying a legal label, refracted into a set of legal criteria, to a unique set of facts. That is so here.

“We think that a mixed question of fact and law is presented in this case and that some deference should be afforded to the Tax Court’s ultimate determination.35

That “deference” translated into an appellate standard of review on a “clearly erroneous” standard. As one court has perceptively noted, there are no bright-line distinctions that are in play in all circumstances:

Many cases involve what courts term “mixed” questions—questions which, if they are to be properly resolved, necessitate combining fact finding with an elucidation of the applicable law. The standard of review applicable to mixed questions usually depends upon where they fall along the degree-of-deference continuum: the more fact-dominated the question, the more likely it is that the trier’s resolution of it will be accepted unless shown to be clearly erroneous.36

Whether there is a continuum of standards of review is simply not answered by Supreme Court authority. That Court’s rulings hold firmly to the proposition that ultimate “facts” are to be considered “facts” for the purpose of appellate review, thereby subject to the clearly erroneous standard. The Supreme Court has expressly indicated that Rule 52(a) applies broadly.37 The Court was equally emphatic when it revisited the issue in City of Bessemer City v. Anderson.38

Where there are two permissible views of the evidence, the fact finder’s choice cannot be clearly erroneous.

This is so even when the district court’s findings do not rest on credibility determinations, but are based instead on physical or documentary evidence or inferences from other facts. To be sure various Courts of Appeal have on occasion asserted the theory that the appellate court may exercise de novo review over findings not based on credibility determinations. This theory has an impressive genealogy, . . . . but it is impossible to trace the theory’s lineage back to the text of Rule 52(a), . . . . That the rule goes on to emphasize the special deference to be paid to credibility determinations does not alter its clear command: . . . . Duplication of the trial judge’s efforts in the court of appeal would very likely contribute only negligibly to the
accuracy of fact determination at a huge cost in the diversion of judicial resources.99

The wisdom of the Supreme Court’s pronouncement respecting duplication of a trial judge’s efforts and the consequent waste is amply demonstrated by the frequent and rigorous re-arguments of claim construction rulings that comprise the Federal Circuit’s usual reviews of district court opinions respecting claim construction. An approach that endeavors to discriminate between true factual findings and true legal constructions based on those factual findings is consistent with the purpose of Rule 52(a) and follows a worthy lineage of authority in appellate review in areas outside the patent field.

The Supreme Court also has spoken on the extent of the Seventh Amendment relating to a jury’s role as the resolver of the ultimate dispute. An example is City of Monterey v. Del Monte Dunes:40

In actions at law predominantly factual issues are in most cases allocated to the jury. The allocation rests on firm historical footing and serves “to preserve the right to the jury’s resolution of the ultimate dispute.”41

This quotation itself quotes Markman,42 showing the close link between the analysis in Markman and this line of cases.

The Supreme Court also has advanced, albeit in a plurality opinion, the general proposition that in an action for damages questions that are “predominately factual” are properly submitted to the jury.43 Specifically the Court found that the issues of whether a landowner had been denied all economically viable use of his property and whether a city’s rejection of a particular development plan bore a reasonable relationship to proffered justifications were questions of fact to be submitted to a jury.44 Yet their facts were of determinative significance to the outcome of the action.

There are, however, in other settings, constitutional imperatives that dictate the extent of a jury’s involvement with facts and the fact-finding function. For example, the First Amendment’s restraint on both federal and state governments’ ability to “abridge” free speech is given effect in the libel context, by the requirement that a plaintiff in a libel action who is a so-called public figure prove that the defendant acted with “actual malice.” Defamation was known to be a common law cause of action that, like patent infringement, originated prior to the adoption of the Constitution. “Actual malice” must nevertheless be established by clear and convincing evidence to show that when the allegedly defamatory falsehood was published, the publisher either knew it to be false or evidenced to the adoption of the Constitution. “Actual malice” must nevertheless be established by clear and convincing evidence to show that when the allegedly defamatory falsehood was published, the publisher either knew it to be false or evidenced a reckless disregard for its truth or falsity.45 That statement, however, begs the question: is “actual malice” a “fact” that has legal significance, or is it a question of law? Obviously, the characterization affects the scope of appellate review of any decision related to the conclusion as to whether “actual malice” has been established.

The Supreme Court answered that question related to the level of deference an appellate court was obligated to give a finding of actual malice in Bose v. Consumers Union.46 Guided by parallels in obscenity law, the Court rejected the contention that a jury finding of actual malice “vel non would be insulated from review so long as the jury was properly instructed and there is some evidence to support its findings . . . “47 to conclude that “[j]udges, as expositors of the Constitution, must independently decide whether the evidence in the record is sufficient to cross the constitutional threshold that bars the entry of any judgment that is not supported by clear and convincing proof of ‘actual malice.’”48 More specifically, the Court held that an appellate court’s review of a trial court finding of fact was not subject to the clearly erroneous standard of Rule 52(a).49 Even this holding, subjecting a fact-finding relative to core values of First Amendment protection, to judicial review as a matter of constitutional law, to determine whether a traditional fact-finding exercise could be countenanced under the Constitution provoked several dissents. Though shaping their opinions from different perspectives, the dissents balked at altering the traditional “clearly erroneous” standard for the factual determination of whether “actual malice” had been proven at trial. So whatever else the decision means, even in the context of the dissents, it certainly underscores the central function of fact-finding in the adjudicatory process to determine the legal consequence of words.50

As a further example, in Harte-Hanks v. Connaughton,51 the court of appeals had affirmed a jury verdict, observing that its function was to review the jury findings of “operative” or “subsidiary” facts under the clearly erroneous standard. Having satisfied itself that the findings were not “clearly erroneous,” the court determined that it must independently decide whether those findings were of convincing clarity to establish actual malice.52 Though affirming the judgment, the Supreme Court did not endorse the court of appeals’ description of the reviewing process:

In determining whether the constitutional standard has been satisfied, the reviewing court must consider the factual record in full. Although credibility determinations are reviewable under the clearly erroneous standard . . . the reviewing court must examine for itself the statements at issue and circumstances . . . . Based on our review of the entire record, we agree with the Court of Appeals that the evidence did in fact support a finding of actual malice. Our approach, however, differs somewhat from that taken by the Court of Appeals.

In considering the actual malice issue the Court of Appeals identified 11 subsidiary facts that the jury could have found [, which were not clearly erroneous and would have supported the conclusion of actual malice.] We agree the jury may have found each of those facts, but conclude the case should be decided on less speculative grounds.53

The “less speculative grounds” that satisfied the Supreme Court required a finding of what evidence the jury must have rejected as incredible, and, excluding that evidence, then determine whether the resulting uncontroversial facts established the finding of actual malice.54 The analysis, pared to its essentials, again looks at “actual malice” as a “fact.”

More recently the Supreme Court has revisited this issue in a freedom-of-speech case in which the Court overturned a trial
court’s finding that the Massachusetts public accommodation law prohibited exclusion of the Irish-American Gay, Lesbian and Bisexual Group (IAGLBG) of Boston from a St. Patrick’s Day parade.55 Said the Court:

[O]ur review of petitioners’ claim that their activity is in the nature of protected speech carries with it a constitutional duty to conduct an independent examination of the record as a whole, without deference to the trial court. [Bose] The requirement of independent appellate review is a rule of federal constitutional law, which does not limit our deference to a trial court on matters of witness credibility. [Hanks-Harte]. . . .

Put less eloquently, the constitutional dimension to the fact-finding of “actual malice” trumped the ordinary Rule 52 analysis to determine whether the facts found were “clearly erroneous.” As I expressed in an earlier footnote, there appears no jurisprudential, constitutional, or other public policy reason to disallow fact-finding in the context of patent claim construction from the deference ordinarily afforded such activity.

In Eastwood v. National Enquirer, the Ninth Circuit expanded this concept:

In conducting our review it is not enough for us to determine that a reasonable jury could have found for the plaintiff . . . permitting us to affirm even though we would have reached a different conclusion . . . . We ourselves must be convinced that the defendant acted with malice.

This does not mean we give jury findings no weight; on questions of credibility, which the jury is uniquely qualified to answer, we defer . . . . Put another way, we must figure out, as best we can from the cold record, which evidence the jury accepted as credible, and which it discarded. Then we must determine whether the believed evidence establishes actual malice.

This is no doubt a difficult business. Without a transcript of the jury’s deliberations, we can only guess which facts (aside from those necessary to support its verdict) it must have believed. In another case, this task may prove impossible, forcing us to rethink our deferential-yet-de-novo approach. Here, however, enough key facts are undisputed that we can reach a conclusion without interviewing—or ignoring—the jury.57

Other circuits are in substantial agreement. See, for example, Levan v. Capital Cities/ABC:

Our standard of review in libel cases in which the actual malice standard forms part of the jury charge is higher than in other cases. We are required to make an independent examination of the entire record to determine whether the evidence offered at trial supports a finding of actual malice. There is some confusion on how this review relates to factual findings made by the jury. The Supreme Court reiterated in [Harte-Hanks] that credibility determinations are reviewed under a clearly erroneous standard . . . . Most courts show less deference when fact finding relies on weighing evidence and drawing inferences.58

What do these cases and their logic mean in the context of patent claim construction? First, there is no doubt that the Supreme Court and other courts of appeals have recognized that the tension between the constitutional limits of governments’ power on speech that is defined in reference to the facts demands less deference for jury verdicts than the ordinary Rule 52 analysis. An appellate court grants a jury’s determination of credibility the highest deference. An appellate court is nevertheless to weigh the facts accepted by the jury independently and draw inferences therefrom. The verdict on the ultimate fact of actual malice is not reviewed for substantial evidence, but on a less deferential standard, one that shows proper regard for the constitutional values at risk.

Turning to the role of juries in patent cases, can it be said that there is any substantial, constitutionally driven reason to afford fact-finding respecting claim construction less deference than in other cases? Is there some supervening legal imperative to rob fact-finding of its privileged status on appeal in patent cases, and especially related to the core questions of claim construction? The answers to each of these questions appear to me to be no.

**Patent Jury Trials, the Constitutional Imperative**

I have chosen a series of three decisions to trace broadly the evolution of the Federal Circuit’s position on whether the Seventh Amendment requires a jury trial respecting resolution of material facts relevant to issues of patent validity, even when nonlegal remedy could be sought.

In the first, In re Lockwood,59 the district court had granted defendant’s motion of summary judgment of noninfringement where a declaratory judgment counterclaim of invalidity had been made. The defendant’s motion to strike the patentee’s demand for a jury trial had likewise been granted. The Federal Circuit granted Lockwood’s mandamus motion and reversed, saying:

In eighteenth century England allegations of patent infringement could be raised in both actions at law and suits in equity. . . . The choice of forum and remedy and thus method of trial, was left to the patentee. . . . Under both English and American practice, then it was the patentee who decided in the first instance whether a jury trial on the factual questions relating to validity would be compelled.

We cannot, consistent with the Seventh Amendment, deny Lockwood the same choice merely because the validity of his patents comes before the court in a declaratory judgment action for invalidity rather than as a defense in an infringement suit. Lockwood is entitled to have the factual questions related to validity in this case tried to a jury as a matter of right.60

Rehearing en banc was denied.61 Although the Supreme Court had granted certiorari, the parties’ subsequent actions eventually rendered the case moot. The Federal Circuit...
subsequently vacated its earlier decision and opinion in light of the mootness of the issue.62

In the second, once more a nonprecedential opinion, In re SGS-Thomson,63 the accused infringer demanded a jury trial on its declaratory judgment counterclaims of non-infringement and invalidity. Citing Lockwood the Federal Circuit granted the defendant a jury trial.64

Finally, in Tegal v. Tokyo Electron America,65 the appeal was from a bench trial, in which the plaintiff had previously demanded a jury. Six days before trial, however, the plaintiff-patentee Tegal moved to dismiss its damage claim with prejudice in favor of seeking only an injunctive remedy. Concomitantly, Tegal moved to strike its demand for a jury trial. The district court granted the motions and proceeded to trial without a jury. Defendant Tokyo Electron America (TEA) appealed, claiming a right to a jury trial on its legal defenses; TEA had asserted no declaratory judgment counterclaims. The Federal Circuit affirmed the trial court’s decision to conduct a bench trial on the grounds that only injunctive relief was sought and that, therefore, there was no Seventh Amendment requirement to proceed before a jury. The opinion in Tegal also makes clear that the result was independent of the fact that TEA had not itself made a demand for a jury trial; unquestionably TEA had a right under the Federal Rules of Civil Procedure to rely on the previously filed demand by the plaintiff.66

It is difficult to harmonize these three cases in the context of prevailing law generally. They can be harmonized, of course, by creating what I believe to be rule resting on a doubtful proposition, namely, that a jury trial can be demanded in a counterclaim for a declaratory judgment of invalidity, when no damages are sought, but not if invalidity were merely pled as a defense, when no damages are sought. I am unaware of a case that endorses such a rule of law.67 Plainly, the right of a litigant to avail itself of the constitutional guarantee of a jury in the fact-finding function is independent of the fact that the litigant sought an injunctive remedy. This ambivalence reflects, in my view, an institutional distrust of the fact-finding function that leads to claim construction. It defies the ordinary understanding of the concept of fact-finding to say that the review of a patent’s claim language, in the context of the asserted patent’s prosecution history, in light of whatever expert evidence is adduced and the meaning of whatever extrinsic evidence, even if admitted only as confirmatory of the intrinsic evidence, in order to construe terms in a single patent has no fact-finding component. Indeed, denying the existence of a factual component to this exercise compromises the credibility of any holding that purports to describe an appropriate claim construction calculus.68

Second, the true mischief of the mischaracterization of the claim construction process as a matter of law is not the characterization itself, but rather its logical and legal consequence on the litigation process as a whole, namely, the de novo appellate review that the Federal Circuit imposes on such rulings. It is this consequence, which permits random panels of the courts of appeals to substitute their opinions and judgments on the slimmest (and least institutionally sound) grounds—mere disagreement with the result—that typifies what I have called the Cybor uncertainty principle.

There is unquestionably a factual component to the analysis that leads to claim construction. It defies the ordinary understanding of the concept of fact-finding to say that the review of a patent’s claim language, in the context of the asserted patent’s prosecution history, in light of whatever expert evidence is adduced and the meaning of whatever extrinsic evidence, even if admitted only as confirmatory of the intrinsic evidence, in order to construe terms in a single patent has no fact-finding component. Indeed, denying the existence of a factual component to this exercise compromises the credibility of any holding that purports to describe an appropriate claim construction calculus.68

Conclusions and Proposals

I now summarize my conclusions respecting the Federal Circuit’s holding that claim construction is pure matter of law and its consequence, together with proposals respecting that view.

First, I believe that the Federal Circuit’s repeated insistence and reaffirmation that the process of claim construction is purely a question of law, which the Federal Circuit bases on the Supreme Court’s affirmation of the Federal Circuit’s earlier Markman opinion, is unjustified.68 Whether the Federal Circuit’s holding qualifies for the extreme characterization employed by the Dissent as a “falsehood” does not concern me, and I do not join so charged a criticism. What is needed for this situation is more light and less heat. Although the Dissent’s rhetoric is both stirring and provocative, the belligerence of the Dissent’s tone does not encourage the cooperation necessary to achieve what I regard as the desirable result of correcting the consequences of the Cybor uncertainty principle.

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Third, given the fact that it is the standard of review, not the characterization, that is the problem, I believe that the proper course is to reaffirm that the construction of patent claims, as well as the construction of their constituent terms, is, as Markman manifestly directs, appropriately allocated to a function within the province of the court, not a jury. At the same time, it should be forthrightly conceded that claim construction does indeed involve the resolution of mixed questions of both law and fact, with an inherent fact-finding process that is integral to the adjudication. The standard of review for claim construction opinions should accordingly embrace a higher level of deference for the trial court’s claim construction precisely because those determinations do involve subsidiary and constituent fact-finding.

To that end, I propose that the correct standard of review for claim construction decisions should afford deference to the district court’s findings of fact on a clearly erroneous standard,
and to afford plenary review to the legal conclusions that rest upon those facts. For example, should the district court conclude that the prosecution history contains evidence that the applicant had intentionally disclaimed a particular embodiment of the proposed invention for what the applicant sought to be subject to patent, that finding would be subject to the clearly erroneous standard. But the district court’s conclusion respecting the legal consequence of intention, such as whether that intention constituted an estoppel, would be subject to plenary review as a legal conclusion.

I believe that such an appellate review regime would be fully consistent with the true teaching of Markman, would restore a greater and (I believe) a deserved respect for the integrity of a district court’s decision, and, if administered as I presume it would be—with dispassion and respect for the process—should sharply reduce the percentage of reversals in the claim construction area.70

This suggestion hardly requires a wholesale retreat from past Federal Circuit precedent. To be sure, the Federal Circuit would have to renounce its flat-footed statements in Cybor (and its considerable progeny) that emphatically declare the purlity of the legal question that the majority asserts for the claim construction process. So be it; for I regard such a concession but a small price to pay for what I perceive to be the substantial, institutional benefits that would flow from the recognition of the true reality of the claim construction process and the adjustment to the reviewing process as a consequence.

Finally, whether the drama and emotion of the Dissent are warranted by the state of the law, I express no view.71 But I fear that without some serious and imminent correction of the appellate standard for claim construction rulings, there will continue to be an unsatisfactory regime where the Cybor uncertainty principle will intervene to roil results and shake the confidence of district judges concerning the durability and legitimacy of their claim construction rulings, thereby encouraging a belief in the trial bench that its labors in construing patents have little purpose other than to fulfill the jurisdictional requirements of finality in order to permit the parties to get down to the real business of claim construction: the litigation in the court of appeals. Such a perception is neither healthy for the operation of the judicial process nor encouraging to litigants for whom predictability and reasonable certainty of result are paramount values.

In light of the seriousness of the issue and problem the current regime presents, mine is a modest proposal to be sure.72 I accordingly urge its consideration and adoption to increase the fairness, efficiency, and predictability of the adjudicatory process. Can there be any doubt that uncertainty favors no one but the rapaciously litigious? For the good of the entire system of rational patent enforcement, I urge that the Federal Circuit modify its characterization of the claim construction process to achieve the intended goal of Markman: stability and predictability of result.

Endnotes

1. 138 F.3d 1448 (Fed. Cir. 1998) (en banc).

2. It is worth noting that Judge Newman’s dissent in Cybor, there joined by Judge Mayer, which envisioned the majority ruling as creating opportunities of uncertainty, has proven remarkably prophetic about the creation and development of uncertainty in the claim construction process as a result of the decision in Cybor. See id. at 1478. The author accordingly recognizes that the intellectual underpinnings of the arguments made here are constituent of the positions Judges Mayer and Newman advanced in their dissent in Cybor as well as their views, again expressed in dissent, most recently in Phillips v. AMH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (en banc).


4. As this article was being prepared for publication, the Federal Circuit rendered a decision in which soon-to-be Chief Judge Rader expressed misgivings about the current de novo standard of review for claim construction appeals. His was a concurring opinion joined by Judge Ron Clark, a district judge from the Eastern District of Texas, sitting by designation. See Trading Techs. Int’t, Inc. v. Espeed, Inc., 595 F.3d 1340, 1363–64 (Lourie, J., concurring). That concurrence, particularly, makes practical observations that support my views expressed in this article. Perhaps Trading Technologies represents a premonitory indication of a possible change along the lines suggested in this article.

5. 415 F.3d 1303.

6. The Federal Circuit raised expectations in the bar by having posed a series of questions for argument in the en banc reconsideration, one of which was the level of deference, if any, that should be given a district court’s claim construction ruling. Id. at 1334. The final decision, however, elides most of these questions, including the appropriateness of any deference to be given the district court’s construction.

7. And this is a rate of reversal that Judge Newman presaged in her dissent in Cybor as a potential for unsettling the process of patent litigation. What Judge Newman said there about this uncertainty bears repeating here: “[If] the Federal Circuit’s reading of the very same claim can vary from one appeal to the next, every patent litigant has an incentive to appeal every action to the Federal Circuit in hopes that the statistics will hold up and eventually the appellate court will reverse.” Cybor, 138 F.3d at 1477 (Newman, J., dissenting). Judge Newman’s prediction of the litigant’s perception is an accurate one in my experience and promotes more litigation, not less, and more uncertainty, to be sure, not less. These are indisputably not positive developments and frustrate achievement of unanimously recognized values of predictability and stable closure.

8. The absence of deference to a district court’s claim construction ruling also has the practical effect of making most appeals merely extensions or continuations of Markman hearings, but to a different audience. The practical consequence is that the district court becomes merely the out-of-town try-out for the “real” action: in the Federal Circuit appeal.


10. 138 F.3d 1448, 1456 (Fed. Cir. 1998) (en banc).
17. Id. at 1470. While acknowledging that the Seventh Amendment has been deemed to protect the jury’s function as the finder of facts, id. at 1465 (citing In re Petersen, 40 S. Ct. 543, 546 (1920) (J. Brandeis) (“The limitation imposed by the [Seventh] amendment is merely . . . that the ultimate determination of issues of fact by the jury not be interfered with.”)), Markman expressly declined to consider whether post-Framing precedent classifying an issue as a question of fact would trigger a Seventh Amendment right to a jury trial on that issue. Id. at 1468 n.10.

18. Id. at 1468.

19. Id. at 1468 (citing Winans v. Denmead, 15 How. 330, 338 (1859)).

20. Id. at 1471.

21. It is also clear that the standard of appellate review for the grant or denial of a preliminary injunction is an abuse of discretion/clearly erroneous standard, thereby affording substantial deference to the decision reached by the district court.

22. 76 U.S. 812 (1869).

23. Id. at 814–15.

24. Prior to Markman, the Federal Circuit had concluded that certain other issues in a patent litigation for damages were not subject to the right of a trial by jury. For example, the unenforceability of a patent due to the patentee’s failure to disclose material information to the Patent Office with an intention to deceive could be concluded by the court without the assistance of a jury. Gardeco Mfg. v. Herst Lighting Co., 820 F.2d 1209, 1211–13 (Fed. Cir. 1987).


29. Put somewhat more prosaically, the pigeonholes between questions and law and fact are not hermetically impervious from one another. There is a substantial amount of ideational osmosis between and among them.

30. The Federal Circuit’s apparent proclivity to discern and establish bright-line rules for the enforcement of patent rights in litigation also appears to me to underlay the numerous rulings in the Festo litigation odyssey respecting the effect of amendments during prosecution on the reach of the Doctrine of Equivalents. See Festo Corp. v. Shoketsu Kinzoku Kagyo Kabushiki Co., Ltd., 493 F.3d 1368 (Fed. Cir. 2007) (collecting prior decisions); see also Festo Corp. v. Shoketsu Kinzoku Kagyo Kabushiki Co., Ltd., 535 U.S. 722 (2002). One way to look at the progressive evolution of rulings in that protracted litigation is that the litigation path reflects the Federal Circuit’s repeated efforts to establish absolute rules of decision in patent cases, only to be reversed by the Supreme Court in favor of more nuanced, subject approaches that require more deliberative judgments. This dynamic of the Federal Circuit establishing an apparent bright-line rule, only to be erased by a subsequent Supreme Court decision, continues as the Supreme Court’s recent opinion in Bilski v. Kappos (Slip Op. June 28, 2010) rejects the exclusivity of a test for the patentability of a business method.


32. 762 F.2d 602, 604–05 (7th Cir. 1986).

33. Id. In the omitted portions Judge Posner summarizes the many exceptions, which include certain findings of fact of constitutional significance, see Miller v. Fenton, 106 S. Ct. 445 (1986) (voluntariness of a confession), and the finding of negligence in the Second Circuit, see Manto Bros. v. Barber S.S., 360 F.2d 774 (1966). See, also, Ching Sheng Fishery v. U.S., 124 F.3d 152, 157 (2d Cir. 1997) (following Manto).
56. Id. at 567.
57. 123 F.3d 1249, 1252 (9th Cir. 1997) (emphasis in original; citations and quotations deleted).
58. 190 F.3d 1230, 1239 (11th Cir. 1999).
60. Id., 33 U.S.P.Q.2d at 1414.
63. 35 U.S.P.Q.2d 1572 (BNA) (Fed. Cir. 1995).
64. Id. at 1573 (“[I]t would be clear under our order in Lockwood that either SGS-Thomson or [the patentee] would have a right to a jury trial.”).
66. Id. at 1393. Fed. R. Civ. P. 38(d) prohibits a party’s withdrawal of its demand for a jury without consent of the other party. Tegal accordingly reaffirms that, absent a claim of damages, there is no right to a jury trial and under Fed. R. Civ. P. 39(a), none should have been provided, whether or not the demand had been made by one or both parties. This result derives from the law of the applicable regional circuit because it is a matter of procedural law, not one deriving from the Federal Circuit’s specific jurisdictional grant of appellate authority under the patent law. Francis v. Dietrick, 682 F.2d 485, 486–87 (4th Cir. 1982).
67. Consider the following circumstance: under 35 U.S.C. § 271(e)(2), the filing of an ANDA in the FDA is an act of infringement of any patent listed by the license holder of the related NDA. Relief for such infringement is merely injunctive. Nonetheless two courts have followed Lockwood and held that despite the equitable nature of the relief sought, the defendant may properly demand a jury trial because a declaratory judgment action could have initiated the litigation. Hoechst v. Parr Pharm., 1996 WL 468593 (D.R.I. 1996); Warner Lambert v. PurePac Pharm., 2001 WL 883232 (D.N.J. Mar. 30, 2001) (prior to Tegal). Two courts have observed that Lockwood states that the litigation for declaratory judgment is only as equitable or legal as the controversies on which they are founded and, therefore, no right of jury trial is available in litigation under § 271(e)(2) where no damage claim is possible. Pfizer v. Novopharm, 2001 WL 477163 (N.D. Ill. 2001) (prior to Tegal); Glaxo v. Apotex, 2001 WL 1246628 (N.D. Ill. 2001) (citing Tegal). This is an area of developing complexity that needs resolution and clarity. The constitutional guarantees of the Seventh Amendment should not depend upon the evanescent procedural niceties as appear to distinguish these Federal Circuit decisions.

68. In this respect, especially, I agree with the views expressed in dissent by Judges Mayer and Newman in both Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448 (Fed. Cir. 1998), and, most recently, Phillips v. AM Corp., 415 F.3d 1303 (Fed. Cir. 2005). The importance of the issue respecting the appropriate appellate standard of review is too significant to rest its supposed basis on an interpretation of what was meant by the Supreme Court. Had the Supreme Court wished to say that claim construction was a pure matter of law, it would have been simple enough to say directly. The fact that it did not persuades me that the Federal Circuit’s inference in Cybor is unjustified. Admittedly, the Supreme Court opinion in Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996), contains some loose language about what are questions of law, and some could be read to imply that claim construction is a question of law, but the clear brunt of the unanimous opinion banishes any reasonable doubt that the allocation by the Supreme Court of the claim construction function to a judge, rather than a jury, rests on functional grounds, which necessitated the analysis that concluded that the Seventh Amendment did not require a different result.

69. Another credible, and far simpler, way of coming to this conclusion is the fact that the same word or phrase in any given patent does not have a universal meaning for all patents. Words in patents simply do not have universal meanings “as a matter of patent law”; they have specific meaning within the relevant context of the patent that contains those words.

70. This approach is likewise consistent with appellate practice in the review of, say, contract interpretations. Wassenaar v. Panos, 331 N.W.2d 357 (Wis. 1983) (trial court’s decision that contract clause is or is not valid involves determinations of fact and law). If other courts of appeals are capable of making these nuanced decisions to reach a fair and just result, I have full confidence that this can be accomplished in the Federal Circuit for patent cases.

71. The image of the court heading for Davy Jones’ locker, which concludes the Dissent (or is it Descent?) for all its rhetorical flourish, is surely hyperbole as is the image of arranging the deck chairs on the Titanic. There is a more profound lesson to be drawn from those metaphors. That a circuit judge of respected standing felt so strongly about the state of the law to resort to such images says more about the depth of the schism in the approach to the law than it does about the future of the court. But such sentiments sound a sober tocsin that should be heeded. Change is needed, for the betterment of the adjudicatory process in patent cases.

72. À la Jonathan Swift.