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MARKMAN: AN INFRINGER'S DELIGHT; AN INVENTOR'S NIGHTMARE

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What's the problem here?

Imagine for a moment a single attorney, working alone and under both time and financial pressures, working closely with an inventor to define a new invention. What words do I use? Are they too limiting? How do I cover future modifications that may still use the guts of the invention? The budget for this patent application is \$15,000. Can I do it?

Now, let's fast-forward six years to the mahogany-walled conference room of a large law firm hired to take on the defense of a new lawsuit brought on that inventor's patent. Eight of the brightest, most creative patent attorneys in the country are sitting around a giant conference room table. Their combined billing rate is \$3,000 per hour and they will likely spend 8 hours at this exercise, nearly twice what it cost to prepare the patent. At the center of the table sits the accused product. Their job is to scrutinize every word of the patent's claims so they can later claim it doesn't literally cover the accused product. In a month, they will tell a district judge that it's her job to define each disputed term — and nearly every word will be disputed — without reference to the accused product. The entire exercise has to be done in a vacuum.

So what is this monster we have created? This *Markman* thing. Doesn't it force an analysis of the trivial, not the whole, and doesn't it do so without the accused product even being considered? Would someone visiting an art gallery to view a painting under a microscope to judge its character and quality or would they step back and look at the whole work of art? Why should inventions be treated differently? Shame on the people that play these word games. They are not protectors of invention, they are destroyers of invention and, in the end, they may represent the worst, not the best, that our profession has to offer.

This article examines the problems with the *Markman* process that has been forced upon unsuspecting (and oftentimes skeptical district judges) and upon the inventors who create the new ideas that fuel our economy.

What was *Markman* about?

The effects of *Markman v. Westview Instruments*, 52 F.3d 967 (Fed. Cir. 1995), aff'd, 517 U.S. 370 (1996) have been controversial and, in the opinion of many, regrettable. As a consequence of this decision, many patent cases are turning into bifurcated proceedings, whether the remainder of the case would or would not justify bifurcation, and even though many reasonable people view bifurcation as a technique that turns one case into

* If there is any credit to be given, it belongs to Joe Hosteny. I'll take any of the blame, for the views expressed are mine — not my law firm's or its partners.'

at least two and a half. Now, thanks to the implementation of *Markman* by the district courts, we have not just one, but two layers of experts: one set for the claim construction hearing, and another for the summary judgment motions and trial. At least one district court, the Northern District of California, has implemented special local rules solely for patent cases. We are spending our clients' money into oblivion.

Markman's patent was for an inventory-control system in a commercial laundry and dry cleaner. Tags were generated for each "article" delivered for cleaning, and each tag had more than one part, each bearing information used to track the article. Markman's independent claim recited a data input device, a data processor with a memory which stored information about the articles, a dot matrix printer and a scanner, so that "spurious" additions and deletions of articles from inventory could be detected. Part of the tag had to be attached to the article, so that the scanner could read the information on the articles' tags.

The jury decided that Westview infringed Markman's independent claim and one dependent claim, but not another dependent claim. The district court then granted a motion for judgment as a matter of law, because the Westview system read only on invoices, not tags on the articles, and stored no information about the articles themselves. Hence, Westview did not employ an "inventory," as the trial judge found that word was used in the claims. The Federal Circuit affirmed the district court's granting of the motion, deciding that claim interpretation was always a pure question of law, to be resolved by a judge and never by a jury.

One dissenting opinion said the decision of the majority:

marks a sea of change in the course of patent law that is nothing short of bizarre. Sadly, this decision represents a secession from the mainstream of the law. It portends turbulence and cynicism in patent litigation.

The same dissent says the court gave "lip service," "spew[ed]" a panoply of cases, and was "hellbent" in its goal of eliminating juries, notwithstanding the constitutional requirement to the contrary. That is fierce criticism, but time has proven it on target. Another dissent in *Markman* said:

By holding that these disputed technologic questions are matters of law, the court holds that issues of patent infringement, previously triable to a jury as of right, will now be decided by the trial judge and then re-decided *de novo* by this court on appeal.

That too is exactly what is happening — more than 50% of patent appeals brought to the Federal Circuit are from summary judgment motions decided on the basis of a *Markman* claim interpretation. Perhaps a new name for the Court would be "The Court for *De Novo* Claims Interpretation." Why not start the whole trial process at the Federal Circuit? Why not send the Court the file history and patent specification and then everyone can begin the lawsuit with a definitive, binding decision on claim interpretation.

Why have a hearing?

The first problem is the use of *Markman* "hearings" at all, which may stem from our failure to read the *Markman* decision. The Federal Circuit said absolutely nothing about "Markman hearings" in its decision. This was a creature of the patent defense bar. In fact, *Markman* does **not** require hearings and did **not** even contemplate such an arid procedure:

“This [claim construction] ordinarily can be accomplished by the court in framing its charge to the jury, but may also be done in the context of dispositive motions such as those seeking judgment as a matter of law.” *Markman*, 52 F.2d at 981. The preferred method of interpreting claims is **not** a hearing held in a vacuum early in a case; it is instead done when the court decides on the instructions to be given to the jury, **after** it has heard the parties’ presentations of evidence, and has had the chance to learn about the technology in context.

Yet, now we have hearings and frequently they are sought early in a case, when the court is not knowledgeable about the technology, the patent, the accused product or the prior art. This leads to the second problem: the construction of claims in a vacuum. A *Markman* hearing early in a case can be useless. The court and a bunch of lawyers get together. Not one of them is a person of ordinary skill, or even mediocre or bad skill in the art. They then read — at least we hope they do — a document intended by statute to be written for people of skill in the art, so that the document need not include what those of skill in the art would already know. This makes as much sense as having an engineering paper interpreted for the class by the “D” student, or someone who hasn’t even finished a year of engineering school. The whole idea is malformed from the outset.

A “hearing” ordinarily means that a disputed question of fact exists, and evidence must be received in order to determine what the fact is: Was the light red or green when the car entered the intersection? Did the defendant intend to distribute the drugs in his possession? Does the defendant’s widget include a plurality of doohickeys as recited in the claim? In *Markman* hearings, however, we have entered what is (to many trial lawyers) a brand new territory. Now a hearing is used to resolve what *Markman* said “is a matter of law exclusively for the court.” 52 F. 3d at 970-71.

Timing

The first effect of the *Markman* decision is, ironically, procedural rather than substantive. By this I mean that the timing of such a hearing is critically important to many patent litigators. Many defendants urge that the hearing be conducted early in a case, and without any discovery. Their strategy is to keep the plaintiff in a discovery “black hole,” and get a claim interpretation that will set up a summary judgment motion for non-infringement or invalidity, leading to a quick exit from the case. The more words that are disputed, the more hurdles the patentee has to clear. And the more hurdles, the more likely the inventor is to fall, to lose. That’s the game.

Plaintiffs, of course, quite often (though not always) want discovery and therefore are usually not eager for early *Markman* hearings. A summary judgment motion following a *Markman* ruling that precedes discovery is difficult to oppose. Most courts have decided that a summary judgment motion granted without providing the non-moving party an opportunity for discovery is unfair. See, for example, *Burnside-Ott Aviation Training Center, Inc. v. United States*, 985 F.2d 1574, 1582 (Fed. Cir. 1993).

The California Rules

Another consequence of *Markman* is the adoption in at least one district of special rules designed to control discovery and briefing leading to a *Markman* hearing. Now the fun starts. The Northern District of California has adopted special local rules solely for patent cases. These Rules are complicated and control numerous details of disclosures and timing of disclosures, resulting in a dramatic effect on discovery in patent cases. My guess is that the drafters of these special rules were dissatisfied with the complexity and duration of

discovery in a typical patent case, with each side maneuvering to prevent any real disclosures until as late in the game as possible. It reminds me of the lament of the Fifth Circuit: "Now rounding out its first decade in this Court, this case, coming to us for the fourth time with two intervening trips to the 6th Circuit and one to the 8th is a tribute to 'the ant-like persistence of [patent] solicitors,' *Lyon v. Boh*, S.D.N.Y., 1924, 1 F.2d 48, 50, and their courtroom advocate counterparts as so much grist is made out of one patent." *Bros Inc. v. Grace Mfg. Co.*, 351 F.2d 208, 209 (5th Cir. 1965).

Northern District Local Rules 16-6 through 16-11 apply solely to patent cases. Rule 16-7 requires initial disclosures of the asserted claims, identification of the accused products by name or model number, and disclosure of dates for conception of the invention and its reduction to practice. Documents concerning statutory bars and research and development activities are required at the same time. All of this must be done within 45 days after any pleading with a claim of patent infringement has been filed. 55 days after receiving the initial disclosure, the defendant must specifically identify prior art, and how it applies to each claim. Documents concerning each accused product or method must also be produced.

Local Rule 16-9 requires that, 70 days later, the plaintiff must provide claim charts identifying the claim, the accused product, whether the infringement is literal or under the doctrine of equivalents, where each element of an asserted claim is found in an accused product or method, and how the claim applies to the patentee's own products if commercial success is asserted. 60 days after receipt of the claim chart, the defendant must specifically identify prior art again, how each item of prior art affects a claim, where in the reference an element is found, the details of best mode or enablement defenses, and any opinions relied upon with respect to willful infringement.

Seventy days after service of the first disclosure of prior art, the plaintiff is required by Rule 16-10 to identify its claim construction, and the defendant must reply 60 days later. Under Rule 16-11, the parties then meet within 21 days, and submit a joint statement within 15 days after the meeting. The court then sets a date for a claim construction hearing, and the parties have an automatic schedule for submission of briefs.

I had a case in the Northern District of California in which experts were required to file detailed "claim construction" reports before the *Markman* hearing. Depositions were taken of the experts. A one-day hearing was held and a decision reached on the proper interpretation. Then, summary judgment motions were filed, a court-appointed expert (I call him a "mini-judge") appointed (without notice to the parties). And after all that expense, the expert ignored the *Markman* decision and interpreted the claims his own way, recommending the motion for summary judgment of non-infringement be granted.

There are no comparable rules to those of the Northern District of California for other types of cases, e.g., RICO, securities, and the like. In fact, in one or two instances, these special rules create the possibility of conflict with cases or other rules. For example, Rule 16-7(b)(3) says that dates of conception must be disclosed by the patent owner. But there are a number of cases that hold that conception dates should be exchanged simultaneously, and there is a provision of the Federal Rules of Civil Procedure, Rule 26(c)(8), that provides for a simultaneous exchange. A Federal Circuit decision last year, *Woodland Trust v. Flowertree Nursery, Inc.*, 138 F.3d 1369, 1371-73 (Fed. Cir. 1998) quotes from the *Barbed Wire Patent Case*, 143 U.S. 275 (1892), that a "temptation to actual perjury" can arise when a party is trying to prove that it made use of an invention earlier than the patentee's date of invention. Rule 26(c)(8) protects against abuse by requiring each

party to identify its alleged date of conception without knowledge of the adversary's date. It, thus, avoids the temptation for a witness to testify about an earlier and potentially false date of conception after seeing the adversary's date. Local Rule 16-7, by requiring a unilateral disclosure of a conception date, creates the very temptation that the case law has sought to avoid. And this is just one example.

Back to the case I mentioned above. The technical jargon was difficult: some of the terms bandied about during the hearing were "indirect registers," "emulation," "microinstruction," "macroinstruction," "core engine," "target instruction," "host instruction," "opcode," "microcode," "RAM," "ROM," "decoder," "RISC," "CISC," and lots more. Even for an experienced district judge — and the one in that case was very experienced — listening to lawyers and experts fling these terms around for several hours is disconcerting to someone who never has heard them before, and who is being asked to construe claims after a few hours exposure to complex technology. We are demanding too much.

To make matters more complicated in this particular case, each side put on an expert witness and cross-examined the other side's witness. Each side orally argued its view of the claims, and how they should be construed. The arguments were lengthy, technical, and difficult. Were I in the judge's shoes, after a day of this I would be reaching for my bottle of Excedrin.

That case demonstrates an important point: *Markman* hearings are not supposed to make much use of experts, and especially not court-appointed experts who operate *ex parte*. But these hearings perversely cause the retention of experts, just in case they are needed. This, in turn, leads to discovery of experts, and to testimony by experts. Another Federal Circuit opinion, *Pitney-Bowes, Inc. v. Hewlett-Packard Company*, ___ F.3d ___ (Fed. Cir. 1999), says that a judge may consider extrinsic evidence "even if the patent document is itself clear." In our case in California, we slid down this slope, and we may be confronted with a second phase of expert discovery, too. To me, the purported efficiency is an illusion.

Why are early hearings held in a vacuum a potential problem? Well, for one thing, no one has had the benefit of a jury trial with opening statements, arguments, and witnesses, perhaps preceded by some motions or other pretrial proceedings that might offer a more gradual introduction to complicated modern technology. These terms may pose no problem for a computer scientist, but they do for those who are not technically trained. The immersion in this kind of technology is sudden and total when the *Markman* hearing is held early in a case. The risk of an erroneous decision is therefore high. This situation may be the source of Judge Rader's comment in *Cybor Corp. v. Fas Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998) that we have a reversal rate of about fifty percent when the Federal Circuit addresses questions of claim construction. Where is the certainty in having coin-flips on appeal?

Were I a trial judge, I would refuse to decide any claim construction issue until I was at the point in the case where I felt more comfortable with the technology involved. The best district judges I have found are those that know exactly when they have enough information to make a decision, and then they decide it without further delay or ado. It is an art, and like Irving Younger's comment that Joe DiMaggio played center field as though God created him to do that and nothing else, it is much harder than it looks.

Unexplained contradictions between a *Markman* claim interpretation and a motion for summary judgment leads me to wonder why we bother with a *Markman* hearing in the first place. In my California case, the parties wrote briefs, exchanged claim constructions,

took discovery, retained experts, traded expert reports, deposed experts, and offered testimony and argument at the hearing. The entire course of discovery was split into two phases and aimed at a *Markman* hearing. This expensive and time-consuming exercise was largely for naught because the *Markman* ruling was not followed.

Is there now more certainty?

The dissent in *Cybor* noted that one of the purported benefits of *Markman* hearings was to “supply certainty about the meaning of a patent claim.” That, in turn, was supposed to encourage “early settlement of many, if not most, patent suits.” But what kind of certainty do we have when the district court rules one way after a *Markman* hearing, and another way in a summary judgment motion, and all without saying why? No certainty at all. And the lack of any certainty (or predictability on appeal) encourages appealing, particularly given the *de novo* standard of review. The *Cybor* dissent stated:

In practical terms, this implementation record has other perverse effects. Trial attorneys must devote much of their trial strategy to positioning themselves for the “endgame” - claim construction on appeal. As the focus shifts from litigating for the correct claim construction to preserving ways to compel reversal on appeal, the uncertainty, cost, and duration of patent litigation only increase. Thus, the en banc court’s *de novo* regime belies the purpose and promise of *Markman I*.

Amen.

I have had lawyers tell me a settlement cannot be achieved until after a claim construction and after appeal of the claim construction, which means after a trial or grant of summary judgment. So where is the judicial economy in that?

We recently had another *Markman* hearing in Chicago in a lawsuit relating to instruments used to install artificial knees. Our client was a physician and lawyer. The patents involved were a method and apparatus for installing an artificial knee. One of the problems faced by surgeons is that the leg’s physical axis is not the same as its mechanical axis; your thigh bone, or femur, angles out and then bends sharply toward the hip joint. This angle varies from one person to another. An imaginary straight line drawn through the ankle, knee and hip joints would lie over the shin bone (the tibia), but not over the thigh bone.

A knee joint is installed by sawing the end of the femur off to make a flat surface. This surface has to be perpendicular to the mechanical axis, and is therefore slightly tilted from the physical axis by an angle, usually called the valgus angle. Other cuts or resections, as physicians call them are made on the tibia and the front and back of the femur. A lot of the terminology is strange: condyles, medial, collateral, resect, etc. One must learn a new language, and it is a bad idea to attempt to understand the language and technology while at the same time trying to interpret the patent.

A guide is used for the power saw that makes the cuts. When cutting the end of the femur, the guide has to be tilted so that the valgus angle is taken into account. In the early years of knee replacements, surgeons would “eyeball” the angle and then make the cut. The invention used a rod, called in a claim an “L-shaped guide rod having a first elongated portion adapted to be inserted into the medullary canal of the femur and a second portion disposed at a right angle to the first portion.” The medullary canal is the core of the thigh bone, and a rod can be pushed into it. The guide is attached to the rod, and forms the proper angle for the cut. No “eyeballing” is required.

The *Markman* hearing was the first matter of any substance that our court had handled in the case. It was not far up the “learning curve” referred to by the *Cybor* dissent. The defendants, in a rush to set up a summary judgment motion at any cost, argued that the L-shaped rod had to be round, had to be slender, and had to be made of one piece. That meant that the claim was interpreted to be an exact duplicate of the drawing which of course isn’t the law. None of these words or phrases — round, slender, or one piece — appears in the claim.

The district court bit on part of the argument. It decided that the “L-shaped rod” recited in the claim had to be a “one-piece L-shaped rod.” That decision is at odds with many decisions of the Federal Circuit that forbid adding elements, that forbid narrowing a claim element by adding modifiers to it, and that allow a claimed structure to be non-integral or made of multiple pieces. On the last point, just two cases are *Advanced Cardiovascular Systems, Inc. v. Scimed Life Systems, Inc.*, 887 F.2d 1070, 1072 (Fed. Cir. 1989) and *In re Hotte*, 475 F.2d 644, 647 (CCPA 1973).

The up-shot is exactly what the dissents in *Markman* and *Cybor* have predicted would occur: obscurity rather than clarity, appeals rather than settlements, and more litigation, not less. Both of the instances I have described reaffirm my view: *Markman* hearings are not contributing to the just, speedy, and inexpensive determinations of patent cases. They are a tactic used by the brightest defense lawyers to create more hurdles to the effective enforcement of patents. That’s their job. I don’t fault them for that. But let’s call it for what it is. I recall my grandson asking me where I was going as I headed for a *Markman* hearing in Virginia. My response: “I’m going to a one-day hearing before a judge so he can decide what an “opening” is.” My grandson’s response: “I could tell him: it’s at the top of a bottle or glass or cup.” Amen, again. But, we debated for a day with experts and inventors and charts and arguments, only to learn in the 27-page opinion that followed that my grandson was right all along.

This is all anecdotal evidence, of course, but it still is evidence and these experiences give us at least a glimpse of how well *Markman* hearings work in real life and whether they produce the benefits that were envisioned. All three of these *Markman* hearings increased expense. In two of the three cases, they did not contribute to a correct end result (at least as I see it). All three posed a considerable burden on the decision-maker, and enhanced the risk of error. Early *Markman* hearings simply aren’t worth it.

Why early?

Markman hearings also do not make much sense when the claims at issue haven’t been identified. A plaintiff who starts a lawsuit with a few asserted claims often adds more claims after having discovery. In one of our cases in the Northern District of Illinois, a defendant moved for an early *Markman* hearing. The district judge stated:

Well, I have never understood the necessity of a *Markman* hearing. . . . [I]f claim construction is requested, I would do it in the form of, certainly, dispositive motions. I have had a number of cases where the parties filed dispositive motions on specific issues within the case which required construction of the claims in order to resolve those particular issues. I would rather do it in that context because, otherwise I mean why construe claims that may not even be relevant?

The insistence upon an early *Markman* hearing, a popular tactic for defendants who view it as a route to a dispositive summary judgment of non-infringement (all with little or no discovery), leads to the third problem: the prevention of discovery altogether, or the distortion and duplication of discovery, with the artificial and absurd creation of discovery disputes that the Federal Rules of Civil Procedure were written and amended to avoid. In one of our cases, we began fighting even before discovery had begun. The court wanted a joint status report. The defendants turned their portion of the report into a legal brief arguing that a *Markman* hearing should be held before any discovery was allowed, or that discovery should be trifurcated into phases: one for a *Markman* hearing, another for discovery on other liability issues and a third for discovery into damages. Of course, limitations on the subjects for discovery are almost certain to allow a party to instruct witnesses not to answer, so that the parties have to fight out the instruction and then re-depose the witness. That, of course, is contrary to Federal Rule of Civil Procedure 30(d)(1), which precludes instructions not to answer except in limited circumstances. It is also contrary to Rule 3(a)(2)(B), which forbids a second deposition of the same person. The spirit of those provisions was to get discovery done and done efficiently. But in patent cases, these rules are in jeopardy.

Patent infringement cases almost always involve witnesses who overlap on issues. For example, it is quite common to have a witness who will have knowledge relevant to both infringement and willful infringement. Another common combination is knowledge of facts relevant to commercial success, which bears upon both liability (since the defendants who admit validity are almost non-existent) and damages. Phased discovery is a needless burden.

The experts

A fourth problem flows from the tendency to allow the use of experts in *Markman* hearings whether they are needed or not. Under *Markman* and cases following it, experts are “extrinsic” evidence, and preferably the claims should be construed from the record available to the public, the “intrinsic” evidence. There is an irresistible tendency, however, to gather and use extrinsic evidence, thus layering ourselves with two periods of expert discovery. A judge at the beginning of a case has no feel for the facts — the patent, the accused products, the positions of the parties and so forth. If confronted with the need to construe the claims early on, many (if not most) courts are going to allow the parties to gather “extrinsic” evidence because the judge will not know whether such evidence will ultimately be used. Each side, therefore, hires experts and each side wants to depose the other side’s experts. Arm yourselves to the teeth, everyone.

In one of our cases, we now have two phases of expert discovery: one for the construction of claims and another for everything else. Experts will, therefore, prepare their reports twice. Experts will be prepared and deposed twice. Attorneys will depose them twice. An article appearing in the May 24, 1999 issue of the *National Law Journal* says that “[t]he preparation for a ‘*Markman*’ hearing should be as extensive as for trial, particularly if it is conducted early in the case.” Patent litigation is expensive enough. We needn’t double the cost.

Whatever we are doing, thanks to *Markman*, greater economy and speed do not appear to be selections on the menu. We are taking all this discovery so that a summary judgment motion can be decided. The idea of taking testimony to decide a summary judgment motion (which is not supposed to involve disputed questions of fact) doesn’t register with me. If there are disputed issues, then a summary judgment motion should be denied. Why not just have a trial?

Is there certainty?

The fifth problem, of course, is the uncertainty in any *Markman* decision. Decisions in patent cases about what claims mean are a crapshoot and subject to second-guessing upstairs. Since claim interpretation has become a pure question of law in every instance, the Federal Circuit can be a court of first impression and decide whatever it wishes. No more deferring to the district judge who heard some evidence, or read a summary judgment motion, or instructed a jury. You might as well ship the patent and the prosecution history to the Federal Circuit and ask for an opinion before you ever file suit, because the Federal Circuit is going to do it at the end of the case anyway. Then you and the district judge can have the pleasure of repeating yourselves. The same *Markman* dissent I quoted above said:

Indeed, the effect of this case is to make of the judicial process a charade, for notwithstanding any trial level activity, this court will do pretty much what it wants under its *de novo* retrial.

That is precisely what has happened. Perhaps we could save money and time in the trial court by flipping a coin.

We are overdoing it. *Pall Corp. v. Hemasure, Inc.*, ___ F.3d ___, 50 U.S.P.Q. 2d (BNA) 1947 (Fed. Cir., 1999) said:

Analysis of patent infringement starts with “construction” of the claim, whereby the court establishes the scope and limits of the claim, interprets any technical or other terms whose meaning is at issue, and thereby defines the claim with greater precision than had the patentee.

The appeal in *Pall* occurred after the district court had ruled on summary judgment motions. The underlined language is startling. What about the statutory requirements for claims that are clear and definite? What about the requirement for a specification that enables one of skill in the art to make and use the invention? The underlined language suggests to me that the appellate court can second-guess the patentee, the Patent Office and the district court. This means that all the work by the district court was useless. Its claim interpretation was found to be too broad and the lower court’s judgment in favor of the patentee was reversed. The district court did not rule on infringement under the doctrine of equivalents, but the Federal Circuit ruled on that, too. The outcome was exactly as if the parties had filed their summary judgment motions in the Court of Appeals. A district judge in one of our cases lamented the wasted work of district judges, and characterized *Markman* hearings as “asinine” and the “silliest rules” he had ever heard of.

In *Augustine Medical, Inc. v. Gaymar Industries, Inc.*, ___ F.3d ___, 50 U.S.P.Q. 2d (BNA) 1901 (Fed. Cir., 1999), the Court of Appeals approved of the district court’s claim construction, delivered in the instructions to the jury. The jury decided that there was no literal infringement, but that there was infringement under the doctrine of equivalents. The Federal Circuit reversed and did not discuss any other evidence presented to the jury beyond the prosecution history. It ruled that the district court should have granted the accused infringer’s motion for judgment as a matter of law. Again, the result is as if the prosecution history, patent and description of the accused product had been forwarded directly to the Federal Circuit.

Other district courts have been critical of *Markman* hearings. Judge Young of the District of Massachusetts analyzed dozens of writings on *Markman* hearings and wrote:

Only through the use of traditional dispositive motions will the Court remain moored to familiar procedures and standards of decision, and focus on the application of legal rules to discrete factual circumstances. Otherwise, the Court risks crafting elegant, but ultimately useless, statements of claim construction that fail to address the particular controversy before it. Free standing *Markman* hearings are of little use in actual litigation and may, indeed, run afoul of the “case and controversy” limitation on judicial power expressed in the Constitution. U.S. Const. art. III, ‘ 2.

Mediacom Corp. v. Rates Technology, Inc., 4 F. Supp. 2d 17, 22 (D. Mass. 1998).

Another district court complained:

This somewhat startling conclusion that the trial judge “does not make credibility assessments” apparently derives from the in banc court’s more general holding that no issue of claim construction presents a question of fact for the jury. As I understand *Markman*, because claim construction presents a purely legal question, trial judges must ignore all non-transcribable courtroom occurrences . . . If those possessed of a higher commission wish to rely on a cold written record and engage in *de novo* review of all claim constructions, that is their privilege. But when the Federal Circuit Court of Appeals states that the trial court does not do something that the trial court does and must do to perform the judicial function, that court knowingly enters a land of sophistry and fiction. Cf. James Finn Garner, *The Emperor’s New Clothes*, in POLITICALLY CORRECT BEDTIME STORIES 5 (1994).

One district judge in Texas reportedly referred to the judges on the Federal Circuit as little green men in propellor hats who don’t know Tuesday from Philadelphia District judges are, I believe, discouraged. And rightly so. Let’s give the inventor (and his attorney who wrote the patent application in the first instance) a fighting chance.

Conclusion

In sum, the criticisms expressed in the dissents in *Markman* have proven accurate. The idea that juries can be trusted with RICO cases, or environmental cases, or securities cases, or copyright or trade secret cases, or even death penalty cases — but not with patent cases — is absurd. Nor do the decisions of judges appear to be faring any better in the Federal Circuit than would a jury’s decision. We have layered ourselves and our courts with additional disputes, with fractured discovery, with additional expense, with additional delays, and with far less certainty in the final result than we have ever had before. That is no improvement. On the contrary, we have simply made patent litigation more difficult, more disputatious, more expensive, more protracted, and less certain of achieving the result required by Fed.R.Civ.P. 1, the “just, speedy, and inexpensive determination of every action.” And, by the way, some corporations are telling everyone that the patent system has no place for the individual inventor. Only those with the money for even more expensive litigation need apply. That spells trouble for our nation’s creativity. Some of the greatest inventions of our time came from individual inventors, funding themselves, whose names now grace the giant corporations their inventions created: Westinghouse, Gillette, Ford and John Deere to name a few.