

1997

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Markman v. Westview Instruments, Inc.:

Patent Construction Is Within The Exclusive Province Of The Court Under
The Seventh Amendment

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October 1, 1997

Cite as: Sue Ann Mota, *Markman v. Westview Instruments, Inc: Patent Construction Is Within The Exclusive Province Of The Court Under The Seventh Amendment*, 3 RICH. J.L. TECH. 3 (1997)
<<http://www.richmond.edu/~jolt/v3i1/mota.html>>[**].

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I. Introduction

In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law.[1]

{1} The Seventh Amendment to the U.S. Constitution, adopted in 1791, is alluringly simple, yet has presented its share of interpretative difficulties.[2] The subject of the right to a jury trial was raised at the Constitutional Convention, but was probably discussed for less than an hour. The arguments raised against a constitutional guarantee of a civil jury trial included the difficulty in drafting language distinguishing when a jury trial was necessary, the variances among the states of the guarantee of civil jury trial, and the promise that this issue be left to the First Congress.[3] Alexander Hamilton argued in *The Federalist* Number 83 that the mere silence of the Constitution in regard to the right of a jury trial in civil cases did not abolish this right.[4] The Seventh Amendment was included in the Bill of Rights, without discussion in the House.[5]

{2} On April 23, 1996, 205 years after the adoption of the Seventh Amendment, a unanimous U.S. Supreme Court issued a decision written by Justice Souter in *Markman v. Westview Instruments, Inc.*[6] The Justices held that, under the Seventh Amendment, the construction of a patent is exclusively within the province of the court. The Court used the "historical test," comparing patent interpretation in common law England in 1791 with patent interpretation today, and ruled that the court, not the jury, properly interprets patent claims. The *Markman v. Westview Instruments, Inc.* landmark decision and its ramifications will be discussed in this paper.

II. Patent Law

A. History of Patent Law

{3} The Constitution authorizes Congress "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Rights to their respective Writings and Discoveries." [7] Pursuant to this power, Congress enacted the first patent act, the Patent Act of 1790, during the second session of the First Congress. This act allowed one who "invented or discovered any useful art, manufacture, engine, machine, or device, or any improvement not before known or used," to petition the Secretary of State, the Secretary for the Department of War, and the Attorney General to cause Letters Patent to be issued.[8] Thomas Jefferson, as Secretary of State, played an active role in drafting the Patent Act of 1793,[9] which repealed the Act of 1790 and allowed an inventor to obtain Letters Patent for "any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement." [10]

{4} The Act of 1836 "laid the foundation of the modern American system for [the] granting of patents." [11] An applicant was required to file a specification; [12] the term "claim" was first used although a claim was not mandated.[13] The Act required the applicant to particularly specify and identify the part, improvement, or combination claimed as the applicant's own invention.[14] The Patent Act of 1870 completely rewrote the law as promulgated in previous acts of Congress.[15] It stated that an applicant will be required to make a claim that "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery." [16]

{5} The latest revision and codification of patent law is the Patent Act of 1952,^[17] which allows an inventor to obtain a patent for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof."^[18] To be patentable, an invention must be novel,^[19] useful, and nonobvious.^[20]

{6} Under current law, a patent application must contain a specification that describes the invention in such full, clear, concise, and exact terms as to enable any person skilled in the art to make and use the invention.^[21] The specification must precisely set forth the invention for which a patent is solicited in order to distinguish it from other inventions.^[22]

B. Requirements Under the Patent Act

{7} The patent application must now also include one or more claims which particularly point out and distinctly claim the subject matter of the invention.^[23] The Supreme Court stated in 1886 that "[t]he claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."^[24] Claims define the boundaries of a patent, and interpretation depends on the specifications.^[25] "More than one claim may be presented provided that they differ substantially from each other and are not unduly multiplied."^[26]

{8} A U.S. patent grants the inventor the exclusive right to make, use, or sell^[27] the patented item. This right begins the day the Patent and Trademark Office issues the patent and ends exactly twenty years after the inventor files his or her application.^[28] Patent owners may give notice of the patent by placing the word "patent" or its abbreviation "pat." and the number on the article.^[29] If the item was not marked, the patent holder may recover damages for infringement only if the infringer continued the violation after notification.^[30] Remedies for infringement include an injunction,^[31] damages (which may be trebled),^[32] and, in exceptional cases, attorney fees.^[33]

C. The Role of Judge and Jury in Patent Cases

{9} "Prior to 1790 nothing in the nature of a claim had appeared either in British patent practice or in that of the American states."^[34] In this early period, "juries were asked to determine whether the specification described the invention well enough to allow members of the appropriate trade to reproduce it,"^[35] but few cases discussed the proper interpretation of specifications.^[36] The few jury cases from this period show no established jury practice, as juries were new to the field.^[37]

{10} Based on the fundamental principle that the "construction of . . . written evidence is exclusively within the court,"^[38] the Supreme Court, since 1841, has consistently held that "the construction of a patent claim is a matter of law exclusively for the court."^[39] The Court of Appeals for the Federal Circuit also initially held that "claim construction was a matter of law."^[40] The Federal Circuit, however, developed a second group of cases that stated that there may be "jury triable fact issues in claim construction"^[41] although other Federal Circuit opinions held that "claim construction is strictly a question of law for the court."^[42]

III. *Markman v. Westview Instruments, Incorporated*

A. Factual Background

{11} Markman is the named inventor and the owner of a patent for an "Inventory Control and Reporting System for Dry-cleaning Stores."^[43] The patent describes a system which includes a keyboard and a data

processor. The system generates written records and monitors and reports the status, location, and movement of clothing in a dry-cleaning business. Markman's specification describes the invention in detail and states that this inventory control system is "capable of monitoring and reporting (upon) the status, location, and throughput of inventory," [44] whereby "the progress of articles through the system can be completely monitored." [45] This invention solves inventory-related problems in the dry-cleaning business, such as loss of clothing. Even a small loss of inventory generates great consumer dissatisfaction. [46] The specification states that the business owner can reconcile the inventory at any point in the sequence and can detect and localize spurious additions and deletions to inventory. [47] Since the system ensures that no article of clothing can go through the cleaning process without generating a written transaction, the system detects theft by employees. The log created by the system can be compared with the cash register tape to detect theft when the employee returns the clothing to the customer, pockets the proceeds and destroys the paperwork. [48]

{12} Markman sued Westview Instruments, Inc. (Westview) and Althonon for patent infringement of claims 1, 10, and 14 of his U.S. Reissue Patent Number 33,054. Westview produced the system accused of violating Markman's patent, and Althonon used the device in one of its dry cleaning shops. [49] Westview responded that it did not infringe upon Markman's patent because Westview's system merely records an inventory of receivables, rather than recording and tracking an inventory of articles of clothing. The alleged infringing device consisted of two pieces of equipment, the DATAMARK and the DATASCAN. [50]

{13} The case was tried before a jury to determine whether Westview's system infringed claims 1, 10, and 14 of Markman's patent. To find literal infringement, the jury had to find the accused device violated every element of the claims as properly interpreted. [51] The jury found that Westview infringed independent claim 1 and dependent claim 10 but found no infringement on independent claim 14.

{14} Markman's first independent claim 1 states that the Markman system can describe articles, maintain inventory totals, generate reports including optically-detectable bar codes attachable to articles of clothing, scan for codes along the cleaning process, and detect additions to inventory. [52] Markman's dependent claim 10 states that the input device of claim 1 is an alpha-numeric keyboard where single keys may be used to enter attributes of items. [53]

{15} The district court granted Westview's deferred motion for judgment as a matter of law concerning claims 1 and 10. The court found that the term "inventory" in claim 1 encompasses "both cash inventory and the actual physical inventory of articles of clothing" and that Westview's system lacked this dual capacity. [54] Therefore, the system did not infringe this claim. [55] Further, claims 1 and 10 define a data processor or computer which has sufficient memory to record information for later use. Judge Katz reasoned since the defendant's system does not have any memory capacity, it therefore does not infringe. [56] The district court found that to infringe Markman's patent, a system must be able to track articles of clothing and generate reports identifying the article's status and location. Since Westview's system did not track items throughout the entire cleaning process, the district court directed a verdict on claims 1 and 10, overturning the jury's findings, and found that Westview's system did not infringe. In concluding that the construction of patent claims is a matter of law for the court, the district court focused on the plaintiff's patent claims for a sophisticated inventory control system. These claims were found to differ from the defendant's rudimentary device, which did not involve every element of the plaintiff's claims or perform the same function as the claimed invention. [57] Thus, there was no literal or equivalent infringement. [58]

B. The Appeal

{16} Markman appealed the grant of judgment as a matter of law of noninfringement with regard to claims 1 and 10 and argued that the district court should not have substituted its construction of the claim for the jury's. Oral argument was held before a panel of the Federal Circuit in May of 1992. In November of 1993, the Federal Circuit, *sua sponte*, ordered that the appeal be reheard *en banc*. The Federal Circuit affirmed the

lower court decision, finding that it was undisputed that the Westview system did not and could not track articles of clothing. Thus, they held there was no substantial evidence to support the jury's finding of infringement.[59]

{17} In reaching its decisions, the Federal Circuit applied the two-step patent infringement analysis whereby the meaning and scope of the patent claims allegedly infringed are determined. The first step, claim construction, is at issue here. The second step is comparing the properly construed claims to the device accused of infringing.[60] Since its inception in 1981, the Federal Circuit has held claim construction was a matter of law.[61] Although a significant line of cases have stated there may be jury-triable fact issues in a claim construction, the courts have rarely based their holdings on this theory.[62] Notwithstanding, the Supreme Court has repeatedly held that patent claim construction is a matter of law exclusively for the court.[63]

{18} The Federal Circuit stated that a patent is uniquely suited for having its meaning and scope determined by a court as a matter of law.[64] The Federal Circuit in *Markman* held that "[w]e therefore settle inconsistencies in our precedent and hold that in a case tried to a jury, the court has the power and obligation to construe as a matter of law the meaning of language used in the patent claim." [65] This holding does not deprive the parties of their Seventh Amendment right to a jury trial in patent infringement cases. Rather, "part of the infringement inquiry, construing and determining the scope of the claims, is strictly a legal question for the court." [66]

{19} One concurring opinion stated that while "the ultimate issue of patent scope, which depends on the legal effect of the words of the claim, is a question of law," it does not "necessarily follow that the judge is to decide every question arising during the course of claim construction as a matter of law." [67] The dissent concluded that the Federal Circuit's decision in *Markman* denies the critical values of the trial and moves the Federal Circuit out of the judicial mainstream.[68]

{20} In reaching the conclusion that the "interpretation and construction of patent claims" is a "matter of law exclusively for the court," [69] the Court of Appeals for the Federal Circuit settled inconsistencies in its precedent.[70] The Federal Circuit stated that there is wisdom to this rule. Infringement may carry serious consequences, and a competitor should be able to ascertain with reasonable certainty the ability of patent holders to exclude others from their exclusive rights.[71]

C. U. S. Supreme Court

{21} On appeal the U. S. Supreme Court unanimously affirmed this decision.[72] Justice Souter's majority opinion held that the construction of a patent, including terms of art within its claim, is within the exclusive province of the court.[73] The Court stated that the right of trial by jury existed under the English common law when the Seventh Amendment was adopted.[74] Justice Story, in the 1812 case of *United States v. Wonson*, set the standard for Seventh Amendment jurisprudence as the right preserved under English common law when the amendment was adopted.[75] What is to be considered under the Seventh Amendment "is not the common law of any individual state (for it probably differs in all), but is the common law of England, that great reservoir of all our jurisprudence." [76] The Court cited its decision in *Baltimore and Carolina Line, Inc. v. Redman*. [77] That case stated that the aim of the Seventh Amendment is to retain the common-law distinction between the province of the court and that of the jury; "issues of law are to be resolved by the court, and issues of fact are to be determined by the jury." [78]

{22} The Supreme Court first asked whether the cause of action in *Markman* was either tried at law, or analogous to an action tried at law, at the time of the Founding.[79] The Court's analysis involved comparing the "statutory action to 18th-century actions brought in the courts of England prior to the merger of the courts of law and equity." [80] Patent infringement actions were tried at law in 18th-century England, so the Court

then asked whether the particular decision must fall to the jury to preserve the substance of the common-law right as it existed in 1791. The Court concluded that patent infringement cases must be tried to a jury, as their predecessors were more than two centuries ago.^[81]

{23} The second question asked by the Court was whether a particular issue occurring within a jury trial, here the construction of a patent claim, is itself necessarily a jury issue that is essential to a jury's resolution of the ultimate dispute.^[82] Citing its decision in *Tull v. United States*,^[83] the Court said that it has repeatedly stated that the answer to this second question depends on whether the jury must shoulder the necessary responsibility to preserve the "substance of the common-law right of trial by jury."^[84] Here there is no clear answer, so the Court used the historical method of comparing the modern practice to earlier ones whose allocation to court or jury is known.^[85] At the time of the Seventh Amendment, the specification and not the claim was the key to the patent.^[86] The court found the closest 18th century analogy to modern claim construction was specification construction. Claim practice did not achieve statutory recognition until the Patent Act of 1836,^[87] and inclusion of a claim did not become a statutory requirement until 1870.^[88] The first English reports show that judges construed patent specifications,^[89] and the first cases from the Supreme Court revealed that judges construed the patent.^[90]

{24} The evidence of common law at the time of the Framing does not allow the application of the Seventh Amendment's jury guarantee to the construction of a claim under the historical method. Therefore, the Court examined precedent^[91] and then considered both the interpretative skills of judges and juries and the statutory policies.^[92] Examining the precedent, Markman argued that two cases, *Bischoff v. Wethered*^[93] and *Tucker v. Spalding*,^[94] show that evidence of the meaning of patent terms was offered to 19th-century juries. Markman argued that these cases imply that the meaning of a documentary term was a jury issue whenever it was subject to evidentiary proof. The Supreme Court, however, disagreed and found in accordance with *Bischoff* the use of expert testimony on a question of construction does not require a judge to submit the question to the jury. The Court has repeatedly drawn this fine line in patent cases between the role of judge and jury.^[95] The Court stated that the first issue of a simple patent case, construing the patent, is an issue for the court, whereas the second issue, determining whether infringement occurred, is an issue for the jury.^[96]

{25} Where history and precedent provide no clear answers, functional considerations play a part in the choice between judge and jury. The Court next considered the relative interpretative skills of judges and juries, and found that the fact/law distinction has, at times, turned on a determination that "one judicial actor is better positioned than another to decide the issue in question."^[97] Souter, writing for a unanimous Court, noted that this principle is true in patent cases, where judges are better suited to construct patent terms than juries.^[98]

{26} Markman argued that a jury should decide a question of meaning peculiar to a trade or profession because such questions require credibility determinations. The Court, however, ruled that any credibility determinations will be subsumed within the court's sophisticated analysis of the instrument as a whole.^[99] Thus, "[t]he decision maker vested with the task of construing the patent is in the better position to ascertain whether an expert's proposed definition fully comports with the specification and claims and so will preserve the patent's internal coherence."^[100]

{27} The last issue addressed was uniformity. While Markman's brief to the Court argued that having judges interpret patent claims will not promote predictability or accuracy because different courts may arrive at contradictory conclusions even if confronted with identical patent claims,^[101] the Court held that "uniformity in the treatment of a given patent is an independent reason to allocate all issues of construction to the court."^[102] Otherwise, a 'zone of uncertainty' may arise, and it was just for the sake of uniformity that Congress in 1981 "created the Court of Appeals for the Federal Circuit as an exclusive appellate court for patent cases."^[103] The Court stated that uniformity would "be ill served by submitting issues of

documentary construction to juries." The Court therefore held that the "interpretation of the word 'inventory'" was "an issue for the judge, not the jury."^[104]

IV. Impact of *Markman v. Westview Instruments, Inc.*

{28} What, then, is the importance of the *Markman* case aside from its being a scholarly and historical discussion of the Seventh Amendment right to a trial by jury as applied to current patent claims? *Markman* clarifies that patent claim construction is a matter of law for the court. This grants judges leeway in patent cases to interpret claims, thus relegating the jury's role to other issues, such as infringement. The *Markman* decision thus clarifies the judge's role in patent cases. Judges may, as in *Markman*, deal with issues of claim construction in motion form. The *Markman* decision will grant uniformity and expediency in patent claim interpretations and will force inventors to write patent claims clearly to exactly describe the invention.

V. Conclusion

{29} Looking beyond patent cases, the Court used the historical method in its analysis of the *Markman* case, comparing the modern practice to earlier ones whose allocation to court or jury we do know.^[105] This "historical test" states that in determining whether the Seventh Amendment requires that a jury be called to decide a case, the court must be guided by the practice of English courts in 1791. This test has been uniformly agreed upon over the last century and a half^[106] and was adopted by Justice Story in *U.S. v. Wonson* in 1812.^[107] After *Markman*, Seventh Amendment litigants should continue to research the historical record and argue it to the Court who, in *Markman*, found this method useful. At English common law, judges were unsurprisingly charged with the general duty of interpreting documents because when the Seventh Amendment was passed, English juries were often illiterate.^[108] In the second half of the 18th century, it has been reported that approximately twenty-two patent cases came before the courts of London, with eight tried in the 1790's.^[109] The Court in *Markman* held that the historical test stands to determine the Seventh Amendment right to trial by jury versus construction left to the court.

Footnotes

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Sue Ann Mota, *Markman v. Westview Instruments, Inc: Patent Construction Is Within The Exclusive Province Of The Court Under The Seventh Amendment*, 3 RICH. J.L. TECH. 3 (1997), at <http://www.richmond.edu/~jolt/v3i1/mota.html>.

1. U.S. CONST. amend. VII.

2. See Charles W. Wolfram, *The Constitutional History of the Seventh Amendment*, 57 MINN. L. REV. 639

(1969).

3. *Id.* at 660, 662-66, 715, 725.

4. THE FEDERALIST No. 83 (Alexander Hamilton). Hamilton argued that there was such diversity of trial by jury in civil cases in the several states that no general rule could be fixed in the Constitution. *Id.* Nonetheless, the Seventh Amendment was adopted in 1791.

5. See Wolfram, *supra* note 2, at 729-30.

6. 116 S.Ct. 1384 (1996).

7. U. S. CONST. art. I, § 8, cl.8.

8. Act of April 10, 1790, ch. 7, § 1. The Secretary of State (then Thomas Jefferson), the Secretary for the Department of War, and the Attorney General, or any two, could issue Letters Patent if the invention or discovery was "sufficiently useful and important." The three officials constituted a Patent Board. *Id.* The specification had to contain a description so particular as to distinguish the invention or discovery from other things before known and used. *Id.*

9. See 3 ERNEST BAINBRIDGE LIPSCOMB, LIPSCOMB'S WALKER ON PATENTS 5-6 (1985).

10. 1 Statutes at Large § 318 (1793). The Act of 1793 required an oath or affirmation. This Act substituted a new registration system for the examination system, and the Patent Office was granted a distinct division within the Department of State.

11. LIPSCOMB, *supra* note 9, at § 6.

12. See *id.* at 5-6.

13. See *id.* at 6.

14. Act of July 4, 1836, ch. 357, 5 Stat. 117 (1836). The term of a patent was fourteen years under this Act, subject to a seven year extension if approved by the Board of Appeals.

15. LIPSCOMB, *supra* note 9, at § 9:8.

16. Act of July 8, 1870, ch. 230, 16 Stat. 198 (1870).

17. The current Patent Act is found at 35 U.S.C. §§ 1-376 (1952). The Patent Act has been amended or revised over 50 times since 1790. Only the major revisions have been discussed herein. The Patent and Trademark Office is now housed in the Department of Commerce.

18. 35 U.S.C. § 101 (1995) states, "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent thereof, subject to the conditions and requirements of this title." Design patents are granted for new, original, and ornamental designs for an article of manufacture. 35 U.S.C. § (1995).

19. See 35 U.S.C. § 102 (1995) states:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1),(2), and (4) of section 371(c) of this title [35 U.S.C. § 371 (c)(1),(2),(4)] before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

20. See 35 U.S.C. § 103 (1995) states:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section of this title [35 U.S.C. § 102], if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section of this title [35 U.S.C. § 102], shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

In 1952, nonobviousness as a requirement was codified to put the common law judicial precedents into statutory form. The first two requirements of novelty and utility had been the sole statutory test since the Patent Act of 1793. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

21. 35 U.S.C. § 112 (1995) states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, precise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as basis for any other multiple claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Paragraph six of the statute discusses "means-plus-function" claims. *See also* S. Mota, Current Legal Issues Involving Computer-Related Patents, 22 WEST. STATE L. REV. 295 (1995).

22. MANUAL OF PATENT EXAMINING PROCEDURE § 608.01 (1995) [hereinafter EXAMINING PROCEDURE]; Detailed Description and Specification of the Invention, 37 C.F.R. § 1.71(b)(1989).

23. 35 U.S.C. § 112, & 2 (1995). *See supra* note 20. The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery. EXAMINING PROCEDURE, *supra* note 22, at § 608.01(i); 37 C.F.R. § 1.75(a).

24. White v. Dunbar, 119 U.S. 47, 52 (1886).

25. *See* LIPSCOMB, *supra* note 9, at § 11:2.

26. EXAMINING PROCEDURE, *supra* note 22, at § 608.01(i); 37 C.F.R. § 1.75(b). Subsection (c) states that one or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application.

27. *See* 35 U.S.C. § 271 (1995). *See infra* note 31.

28. See 35 U.S.C. § 154(a)(2) (1995) states in part: "Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States." This term is subject to an extension of up to five years. 35 U.S.C. § 154(b)(4), § 155. Design patents are granted for a fourteen year term. 35 U.S.C. § 173 (1995).

29. See 35 U.S.C. § 287(a) (1995). If it is not possible to fix this on the article itself, it is permissible to fix to it, or to the package, a label containing the notice.

30. See 35 U.S.C. § 271 (1995) states in part:

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer .

...

A claim, not a patent, is infringed. "Infringement of a patent is an erroneous phrase; what is infringed is a claim, which is the definition of invention, and it is the claim which is the cause of action." *Fulton Co. v. Powers Regulation Co.*, 263 F. 578 (2d Cir. 1920). The infringer is then only liable for infringement after the notice. *Id.*

31. See 35 U.S.C. § 283 (1995) states, "[t]he several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable." *Id.*

32. See 35 U.S.C. § 284 (1995) states:

Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.

The court may allow expert testimony to aid in the determination of damages or what royalty would be reasonable under the circumstances.

33. See 35 U.S.C. § 285 (1995) states, "The court in exceptional cases may award reasonable attorney fees to the prevailing party."

34. *Markman v. Westview Instruments, Inc.*, 116 S.Ct. 1384, 1390 (1996), *citing* Lutz, *Evolution of the Claims of U.S. Patents*, 20 Pat. Off. Soc. 134 (1938). See *supra* notes 13-16 and accompanying text.

35. See *Markman*, 116 S.Ct. at 1391, *citing* *Arkwright v. Nightengale*, Dav. Pat. Cas. 37, 60 (C.P. 1785). Patent litigation at this time was also typified by novelty actions, to determine if any "essential part of [the patent had been] disclosed to the public before." *Markman*, 116 S.Ct. at 1390, *citing* *Huddart v. Grimshaw*, Dav. Pat. Cas. 265, 298 (F.B. 1803).

36. See *Markman*, 116 S. Ct. at 1391.

37. See *id.* Few of the cases discuss the interpretation of patent specifications. *Id.*, citing *Bramah v. Hardcastle*, 1 Carp. P.C. 168 (K.B. 1789); *King v. Else*, 1 Carp. P.C. 103 (K.B. 1785); *Dolland's Case*, 1 Eng. Rep. 966 (K.B. 1676). None of these cases show that the definition of a term in a specification was determined by the jury. *Markman*, 116 S. Ct. at 1391.

38. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 978, citing *Levy v. Gadsby*, 7 U.S. (3 Cranch) 180, 186 (1805) (Marshall, C.J.).

39. See *Markman* 52 F.3d at 977, citing *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848); *Silby v. Foote*, 55 U.S. (14 How.) 218, 225 (1853); *Winans v. Denmead*, 56 U.S. (15 How.) 330, 338 (1853); *Winans v. New York and Erie R.R. Co.*, 62 U.S. (21 How.) 88, 100 (1859); *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 816 (1870); *Heald v. Rice*, 104 U.S. 737, 749 (1882); *Coupe v. Royer*, 155 U.S. 565, 579-80 (1895); *Market St. Cable Ry. Co. v. Rowley*, 155 U.S. 621, 625 (1895); *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1904).

40. See *Markman*, 52 F.3d at 976, citing *SSIH Equip S.A. v. U.S. Int'l Trade Comm'n.*, 718 F.2d 365, 376 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 770-71 (Fed. Cir. 1983); *Fromsan v. Advance Offset Plate, Inc.*, 720 F.2d 1565, 1569-71 (Fed. Cir. 1983); *SRI Int'l. v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1118-22, 1138-40 (Fed. Cir. 1985) (en banc).

41. See *Markman*, 52 F.3d at 976-77, citing *McGill Inc. v. John Zink Co.*, 736 F.2d 666 (Fed. Cir. 1984); *Bio-Rad Labs, Inc. v. Nicolet Instrument Corp.*, 739 F.2d 604, 614 (Fed. Cir. 1984); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985); *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 657 (Fed. Cir. 1986); *H.H. Robinson Co. v. United Steel Deck, Inc.*, 820 F.2d 384, 389 (Fed. Cir. 1987); *Perini America, Inc. v. Paper Converting Machine Co.*, 832 F.2d 581, 584 (Fed. Cir. 1987).

42. See *Markman* 52 F.3d at 977, citing *Speciality Composites v. Cabot Corp.*, 845 F.2d 981, 986 (Fed. Cir. 1988); *Senmed, Inc. v. Richard-Allan Medical Indus., Inc.*, 888 F.2d 815, 818-820 (Fed. Cir. 1989); *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1561-63 (Fed. Cir. 1991); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88 (Fed. Cir. 1992); *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 822-23 (Fed. Cir. 1992).

43. *Markman's* initial patent application was rejected for obviousness. When amended claims were submitted to distinguish *Markman's* claims over prior art, patent no. 4,550,246 was issued. *Markman* applied for a reissue patent which added two claims. The reissue application was rejected; upon reconsideration the patent examiner issued U.S. Reissue Patent No. 33,054.

44. *Markman* 52 F.3d at 971.

45. *Id.*

46. See *id.*

47. According to the specification, the dry cleaning employee enters information about the customer and the clothing using a keyboard. A data processor connected to a printer stores the information and a written record is generated. Bar codes are generated, which are read by an optical scanner.

48. See *id.*

49. See *Markman*, 52 F.3d at 971-2 .

50. See *id.* at 972. The Court of Appeals described the two units comprising defendant's system:

The DATAMARK is a stationary unit comprising a keyboard, electronic display, processor, and printer. When a customer brings articles of clothing in for cleaning, an attendant enters on a keypad information about the customer, articles to be cleaned, and the charges for the cleaning. The DATAMARK then prints a bar-coded ticket or invoice listing the information about the customer, the clothes to be cleaned and the charges for cleaning. The DATAMARK retains permanently in memory only the invoice number, date, and cash total. The DATAMARK is thus used to print bar-coded tickets for the articles and to retain an invoice list.

The DATASCAN is a portable unit comprising a microprocessor and an optical detector for reading bar-coded tickets or invoices at any location in the dry-cleaning establishment. To use the DATASCAN, first the invoice list is transferred from the DATAMARK to the DATASCAN. Then the DATASCAN is carried about to read the bar-codes on tickets or invoices in the establishment. As it does this, it can report any discrepancy between the particular invoice read (or not read) and the invoice list. In this way the DATASCAN identifies extra or missing invoices.

Id.

51. *Markman v. Westview Instruments, Inc.*, 772 F. Supp. 1535, 1527 (E.D. Pa. 1991), *citing* *Texas Instruments, Inc. v. I.T.C.*, 805 F.2d. 1558, 1562 (Fed. Cir. 1986).

52. *See Markman v. Westview Instruments, Inc.*, 116 S.Ct. 1384, 1388, 134 L.Ed.2d. 577, 581, (1996). The full text of claim 1, states the device is a system for inventory control and reporting comprising:

a data input device for manual operation by an attendant, the input device having switch means operable to encode information relating to sequential transactions, each of the transactions having articles associated therewith, said information including transaction identity and descriptions of each said articles associated with the transaction;

a data processor including memory operable to record said information and means to maintain an inventory total, said data processor having means to associate sequential transactions with unique sequential indicia and to generate at least one report of said total and said transactions, the unique sequential indicia and the descriptions of articles in the sequential transactions being reconcilable against one another;

a dot matrix printer operable under control of the data processor to generate a written record of the indicia associated with sequential transactions, the written record including optically-detectable bar codes having a series of contrasting spaced bands, the bar codes being printed only in coincidence with each said transaction and at least part of the written record bearing a portion to be attached to said articles; and,

at least one optical scanner connected to the data processor and operable to detect said bar codes on all articles passing a predetermined station, whereby said system can detect and localize spurious additions to inventory as well as spurious deleting therefrom.

Markman, 772 F. Supp. at 1536.

53. See *Markman*, 116 S.Ct. at 1388. Markman's dependent claim 10 states: "The system of claim 1, wherein the input device is a keyboard having alpha-numeric keys, and also having keys specific to a plurality of common attributes of the articles and common optical attributes of the sequential transactions, said common attributes being recorded single key strokes." *Markman*, 772 F. Supp. at 1536.

54. See *Markman* 772 F. Supp. at 1538.

55. See *id.*

56. See *id.*

57. See *id.* at 1538. The district court also stated that while it may be true that the defendant exaggerated its system's capabilities in advertisements, this does not rise to a patent infringement.

58. See *id.* Under the "doctrine of equivalents," a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is "equivalence" between the claimed elements of the patented invention and the elements of the allegedly infringing product or process. *Grover Tank and Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 603 (1950). The U.S. Supreme Court unanimously held that the Court adheres to the doctrine of equivalents in *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 65 U.S.L.W. 4162 (U.S. Mar. 3, 1997) (No. 95-728).

59. See *Markman* 52 F.3d at 988-89. See generally, Jason Scully, Note, *Markman and Hilton Davis, The Federal Circuit Strikes an Awkward Balance: The Role of the Judge and Jury in Patent Infringement Suits*, 18 HASTINGS COMM. & ENT. L. J. 631 (1996).

60. See *Markman*, 52 F.3d at 976, citing *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 821 (Fed. Cir. 1992).

61. See *supra* note 40.

62. See *Markman*, 52 F.3d at 976-71. This second line of cases relied on *McGill Inc. v. John Zink Co.*, 736 F.2d 666 (Fed. Cir. 1984) and its erroneous interpretation of *Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753 (Fed. Cir. 1984). See *supra* note 41.

63. See *Markman*, 52 F.3d at 977, citing *Hogg v. Emerson*, 47 U.S. 437, 484, (1848); *Silby v. Foote*, 55 U.S. 218, 225 (1853); *Winans v. Denmead*, 56 U.S. 338 (1854); *Winans v. New York & Erie R.R. Co.*, 62 U.S. 88, 100 (1859); *Bischoff v. Wethered*, 76 U.S. 812, 816 (1870); *Heald v. Rice*, 104 U.S. 737 (1882); *Coupe v. Royer*, 155 U.S. 565, 579-80 (1895); *Market St. Cable R.R. Co. v. Rowley*, 155 U.S. 621, 625 (1895); *Singer Mfg. Co. v. Cramer*, 192 U.S. 265, 275 (1904).

64. See *Markman*, 52 F.3d at 978. Since matters of law must be reviewed *de novo* and matters of fact must be given substantial deference, the court stated that this distinction is critical. *Id.* at 976. The court stated that Markman contends that the jury's claim construction is supported by substantial evidence, but the evidence that Markman cites is his own testimony and the testimony of his expert, and not the language of the patent specification or the prosecution history. *Id.* at 974.

65. *Id.* at 979. Three sources should be considered to ascertain the meaning of claims: the claims, the specification, and the prosecution history. "Claims must be read in view of the specification of which they are a part." *Id.*

66. *Id.* at 984. Chief Judge Archer wrote the opinion, and Judges Rich, Nies, Michel, Plager, Lourie, Clevenger, and Schall joined. Judges Mayer and Rader filed concurring opinions. Judge Newman dissented.

67. See *Markman*, 52 F.3d at 998 (Judge Mayer concurring). Judge Radar's concurring opinion states that the result in the case "is the same whether or not claim construction may sometimes involve subsidiary fact issues." *Id.* In *Markman*, "the claims, specification, and prosecution history irrefutably show that cash transaction totals are not inventory." *Id.* Since *Westview* "infringes only if transaction totals are inventory", the district court was correct in its ruling granting *Westview* judgment as a matter of law. *Id.*
68. See *id.* at 999-1026 (Newman, P., dissenting). Judge Newman stated that the majority decision resolved the issue of the role of the jury in patent infringement cases by designating factual disputes about the meaning and scope of terms as law.
69. See *id.* at 970-1.
70. See *id.* at 979. See *supra* notes 40-42 and accompanying text.
71. See *id.* at 978.
72. See *Markman*, 116 S.Ct. 1384, 1385.
73. See *id.* at 4263.
74. See *id.* at 4265.
75. 28 F. Cas. 745, 750 (No. 16,750) (C.C. Mass. 1812).
76. *Id.*
77. 295 U.S. 654 (1935). The Seventh Amendment not only preserves the right to trial by jury but discloses a purpose to protect it from indirect impairment by enlargements of the power of reexamination existing under the common law. The common law also had a practice of reserving for the judge questions of law arising during jury trials, because this practice gave better opportunity for considered rulings, made new trials less frequent, and commanded general approval of the litigants. This practice was well-established when the Seventh Amendment was adopted, and is part of the common-law rules preserved and protected by the amendment. *Id.* at 660.
78. *Id.*
79. *Markman*, 116 S.Ct. at 1389.
80. *Markman*, 116 S.Ct. at 1389 citing *Granfinanciera, S.A. v. Wordberg*, 492 U.S. 33, 42 (1989).
81. *Markman*, 116 S.Ct. at 1389, citing *Bramah v. Hardcastle*, 1 Carp. P.C. 168 (K.B. 1789). The court therefore disagreed with *Markman*'s argument which stated, in its brief, that the historical record is clear that in England in 1791, disputes regarding the meaning of patents, including specifications, were decided by juries. Brief for Petitioners at 15; *Markman*, 116 S.Ct. at 1389. The Court considered the historical record in England in 1791, but disagreed with *Markman*'s conclusions. *Markman*'s brief to the Court argued that the Federal Circuit did not even cite or consider the historical record. Brief for Petitioners at 14, 23.
82. *Markman*, 116 S.Ct. at 1389.
83. *Tull v. United States*, 481 U.S. 412, 426 (1987). The Court in *Tull* quoted *Colgrave v. Battin*, 413 U.S. 149, 156-57 (1973), stating, "[o]nly those incidents which are regarded as fundamental, as inherent in and of the essence of the system of trial by jury, are placed beyond the reach of the legislature." The Court in *Tull*

concluded that the Seventh Amendment required that a jury trial be granted to determine liability in actions by the government seeking civil penalties for dumping fill on wetlands, but the Seventh Amendment does not require a jury trial to assess the penalties. Rather, the trial court should determine the amount of penalty, if any.

84. *Markman* 116 S.Ct. at 1390.

85. *Id.* The Court stated that this historical method was a sounder course than the substance versus procedure distinction or the fact versus law distinction. The trial court, the majority in the Federal Circuit and Justice Newman's dissent, and *Markman's* and *Westview's* briefs to the Supreme Court discussed the law/fact distinction. The district court held that the question of claim construction is a matter of law for the court. *Markman*, 772 F. Supp. at 1536. The majority in the Federal Circuit agreed. *Markman*, 52 F.3d at 968. Justice Newman's dissent pointed out that there is a temptation of appellate courts to redefine questions of fact as questions of law. *Id.* at 1008. *Markman's* brief also discussed the law/fact distinction, and stated that the majority in the Federal Circuit sought to sidestep the Seventh Amendment by characterizing patent interpretation questions as legal. *Westview's* brief stated that the trial judge properly construed the claims as a matter of law. Brief for Respondent at 18.

86. See, Patrick Devlin, *Jury Trial of Complex Cases: English Practice at the Time of the Seventh Amendment*, 80 COLUM. L. REV. 43, 75 (1980).

87. Act of July 4, 1836, ch 357, § 6, 5 Stat. 119 (repealed 1870).

88. Patent Act of July 8, 1870, ch. 230, § 26, 16 Stat. 201 (repealed 1952).

89. *Borill v. Moore*, Dav. Pat. Cas. 361 (C.P. 1816); *Russell v. Cowley and Dixon*, Webs. Pat. Cas. 457, (Exch. 1834); *Haworth v. Hardcastle*, Webs. Pat. Cas. 480 (1834).

90. *Winans v. New York & Erie R.R. Co.*, 21 How. 88 (1859); *Winans v. Denmead*, 15 How. 330 (1854); *Hogg v. Emerson*, 6 How. 437 (1848); *Parker v. Hulme*, 18 F. Cas. 1138 (E.D. Pa. 1849).

91. See *Markman*, 116 S.Ct. at 1393, n.10. Since the Court concluded that precedent supports classifying the question as one for the court, the Court did not decide either the extent to which the Seventh Amendment draws a law/fact distinction or whether post-1791 precedent classifying an issue as fact would trigger Seventh Amendment protections if, unlike this case, there were no more specific reasons for decision. *Id.*

92. See *id.* at 1393.

93. 78 U.S. (9 Wall.) 812 (1870), 72.80 U.S. (13 Wall.) 453 (1872).

94. 13 Wall. 453 (1872).

95. *Markman*, 116 S.Ct. at 1394, n.13 (listing a number of Supreme Court cases such as *Coupe v. Royer*, 155 U.S. 565, 579-580 (1895); *Silby v. Foote*, 55 U.S. (14 How.) 218, 226 (1853); *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848); *Brown v. Piper*, 91 U.S. 37, 41 (1875); *Winans v. New York & Erie R.R. Co.*, 62 U.S. (21 How.) 88, 100 (1859); *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, 678 (1942)).

96. *Markman*, 116 S.Ct. at 1393, citing B. CURTIS, 1 A MEMOIR OF BENJAMIN ROBBINS CURTIS, L.L.D., 84 (1879). Justice Curtis, a former patent practitioner, was a Supreme Court justice from 1851-57 when he resigned from the Court over the *Dred Scott* decision.

97. *Markman*, 116 S.Ct. at 1395, *citing* *Miller v. Fenton*, 474 U.S. 104, 114 (1985).

98. *See Markman*, 116 S.Ct. at 1394, *citing* *Parker v. Hulme*, 18 F. Cas. 1138, 1140 (E.D. Pa. 1849), (noting that patent construction "is a special occupation, requiring, like all others, special training and practice. The judge, from his training and discipline, is more likely to give a proper interpretation to such instruments than a jury; and he is, therefore, more likely to be right, in performing such a duty, than a jury can be expected to be.").

99. *See Markman*, 116 S.Ct. at 1395.

100. *Id.*

101. *See* Brief for Petitioners at 37-39, *Markman*, 116 S.Ct. at 1384.

102. *Markman*, 116 S.Ct. at 1396. The Court, therefore, agreed with Respondents Westview who argued that the construction of patent claims as a matter of law promotes specific and clear claims and consistent interpretation. Brief for Respondents at 43, *Markman*, 116 S.Ct. at 1384.

103. *Id.* The House of Representatives report stated that:

The new Court of Appeals for the Federal Circuit will provide nationwide uniformity in patent law, will make the rules applied in patent litigation more predictable and will eliminate the expensive, time-consuming and unseemly forum-shopping that characterizes litigation in the field.

Patent litigation long has been identified as a problem area, characterized by undue forum-shopping and unsettling inconsistency in adjudications.

The infrequency of Supreme Court review of patent cases leaves the present judicial system without any effective means of assuring even-handedness nationwide in the administration of the patent laws. The proposed new court will fill this void.

H.R. Rep. No. 97-312, 20, 22 (1981).

104. *Markman*, 116 S.Ct. at 1396.

105. *See id.* at 1386.

106. *See* Wolfram, *supra* note 2, at 639.

107. *U.S. v. Wonson*, 28 F. Cas. 745, 750 (No. 16, 750) (C.C.D. Mass. 1812). *See*, Charles Wolfram, *The Constitutional History of the Seventh Amendment*, 57 MINN. L. REV. 639-42, 720-21 (1973).

108. Devlin, *supra* note 86, at 75.

109. *See* Edward Waltersheid, *The Early Evolution of the United States Patent Law: Antecedents (Part 3)*, 77 J. PAT. & TRADEMARK OFF. SOC'Y 771, 775 (1995), *citing* H.I. DUTTON, *THE PATENT SYSTEM AND INVENTIVE ACTIVITY DURING THE INDUSTRIAL REVOLUTION* 71 (1984). The scarcity of cases during this time could be because patent holders "were reluctant to bring infringement actions when there was a very good chance that such action could result in the invalidation of their patents." Waltersheid at 75-76.

