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SPECIAL
REPORT

U.S. SUPREME COURT DECISION IN THE "MARKMAN" CASE

July 1, 1996

On April 23, 1996, the U.S. Supreme Court issued its decision in the "Markman" case - Herbert Markman and Positek, Inc. v. Westview Instruments, Inc. and Althon Enterprises, Inc.,

No. 95-26. In a unanimous opinion authored by Justice Souter, the Supreme Court held that construction of a patent, including terms of art within its claims, is exclusively within the province of the court. Thus, the Supreme Court affirmed the U.S. Court of Appeals for the Federal Circuit's finding that claim construction is an issue for the judge to determine as a matter of law, not a question of fact for a jury to decide. This is an important decision in terms of patent infringement litigation.

The Supreme Court based its decision on several grounds. The Court disagreed with Markman's position that patent owners would be denied their Constitutionally guaranteed right to a trial by jury as provided by the Seventh Amendment if the decision on claim construction was left to the judge. The Court looked back over 200 years of practice and precedent and determined that under the common law around 1791, when the Seventh Amendment was framed, there was no authority for Markman's position that the issue of claim construction, separate from the overall issue of infringement, was a question of fact for a jury to decide. The Court also determined that construction of patents and terms therein was more analogous to construction of other types of written documents. The Court found that precedent and practice over the last 200 years in those types of cases supported the proposition that judges, not juries, should be the arbiters of what terms in a document mean. Finally, the Court found that judges were often in a better position to make determinations on the meaning of terms in a claim based on training, experience and discipline, and that allowing judges to make decisions on claim construction would promote a more uniform treatment of the issue.

In an interesting sidenote relating to the doctrine of equivalents, Justice Souter noted, in dicta, that potential infringers cannot avoid infringement by making "noncritical" changes from the claims. The Federal Circuit has maintained that an "insubstantial" difference from a claim will not avoid infringement under the doctrine of equivalents. The Supreme Court is presently deciding issues relating to the doctrine of equivalents in the Hilton-Davis case, to be decided later this year or early next year.

Based on the Supreme Court's Markman decision, some courts will likely continue the practice of holding "Markman" minitrials or hearings on the issue of claim construction prior to trial. The Supreme Court decision, like the Federal Circuit decision, assumes that expert testimony will be used in some cases to aid the court in its decision on claim construction, but considers the issue of claim construction to be a matter of law strictly for the judge to determine.

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