

ENABLEMENT: FOR THE JUDGE OR THE
JURY? *MARKMAN V. WESTVIEW
INSTRUMENTS, INC.*'S ANALYSIS APPLIED

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I. INTRODUCTION

Generally, the jury's role in civil cases, including patent cases, is defined in terms of questions of fact or law.¹ The Constitution requires that juries be the final arbiters of factual questions, but makes no such requirement of questions of law.² The historical approach of courts favors juries resolving questions of fact while allowing judges to resolve questions of law.³ The Supreme Court first initiated this approach in 1895 to avoid "confusion and uncertainty in the administration of the . . . law."⁴ The approach has been upheld to the present, with "uniformity, certainty, and predictability" as the justification for the law versus fact distinction.⁵ Generally, a question of fact is one that involves a determination of whether certain acts or events actually occurred, or certain conditions existed, whereas a question of law applies general principles or rules to particular facts.⁶ There is, however, no bright-line rule to divide law and fact, and courts are continually redefining the boundaries.⁷

To complicate the fact versus law dichotomy even more, numerous legal issues are mixed questions of law and fact, patent law issues included.⁸ Because mixed questions of fact and law do not clearly fit into either category, they "must be classified in one category or the other to determine the scope of review."⁹ On appeal, some of those issues are treated as questions of law while others are treated as questions of fact.¹⁰ Before the decision in *Markman v. Westview Instruments, Inc.*,¹¹ (*Markman II*), claim interpretation was a mixed question of law and fact, sometimes submitted

1. Philippe Signore, *On the Role of Juries in Patent Litigation*, 83 J. PAT. & TRADEMARK OFF. SOC'Y 791, 797 (2001).

2. See U.S. CONST. amend. VII (stating that the right to a jury trial "shall be preserved, and no fact tried by a jury, shall be otherwise re-examined") (emphasis added).

3. Signore, *supra* note 1, at 798.

4. *Id.* (quoting *Sparf v. United States*, 156 U.S. 51, 101 (1895)).

5. *Id.* (citing Stephen A. Weiner, *The Civil Jury Trial and the Law-Fact Distinction*, 54 CAL. L. REV. 1867, 1924 (1966)).

6. *Id.* at 799 (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 1009 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996)).

7. *Id.*

8. Kenneth D. Sibley, *Practical Utility: Evolution Suspended?*, 32 IDEA 203, 207 (1992).

9. *Id.* at 208.

10. *Id.* at 207.

11. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996).

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to the jury and sometimes decided by the court.¹² In 1996, however, the Supreme Court held that “judges, not juries, are better suited to find the acquired meaning of patent terms.”¹³ From that point forward, interpretation of patent claims has been removed from the hands of the jury and submitted solely to the trial judge for determination.¹⁴

Under the relevant patent statute, 35 U.S.C. § 112, enablement is also a requirement for patentability.¹⁵ It is often classified as an ultimate question of law, but recognized as having underlying factual issues.¹⁶ Unlike claim interpretation, however, the Supreme Court has not reviewed whether enablement should be submitted to a judge or jury. At the trial level, there is not uniform treatment; the issue is sometimes submitted to a jury and sometimes decided by a judge.¹⁷

This Note will focus on the need for the Federal Circuit to use uniform standards in its classification of patent issues as questions of fact or law for purposes of submission to a final arbiter. In Part II, the evolution of claims interpretation is analyzed from its inception until the *Markman II* decision in 1996. In Part III, the Supreme Court's four-part test for determining whether an issue should be submitted to a judge or jury is broken down and analyzed as the Court applied it to claim interpretation in *Markman II*. In Part IV, post-*Markman* treatment of claims interpretation is briefly discussed. Part V examines the manner in which courts treat enablement issues when faced with them at either the trial level or on appeal. Trial courts have taken no definite position on whether enablement should be submitted to a jury or to a judge, and the issue is treated differently throughout circuit courts.¹⁸ The need for resolution of this issue will be addressed in Part VI, stressing that courts should follow

12. See *id.* at 377-78 (discussing how claim interpretation was previously handled by the Court).

13. *Id.* at 388.

14. *Id.* at 390.

15. 35 U.S.C. § 112 (2000).

16. Signore, *supra* note 1, at 801 (citing *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 954 (1987)); see also *id.* at n.40 (“Although enablement is deemed to be a question of law, it is amenable to resolution by the jury.”) (quoting *Allen Organ Co. v. Kimball Int'l, Inc.*, 839 F.2d 1556, 1566 (Fed. Cir. 1988)).

17. Compare *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571 (Fed. Cir. 1992) (likening the treatment of enablement to that of utility, as a question of fact submitted to the jury), with *Enzo Biochem, Inc. v. Calgene, Inc.*, 188 F.3d 1362, 1376 (Fed. Cir. 1999) (stating that enablement is an ultimate question of law that courts must decide).

18. See *infra* note 123 and accompanying text.

the four-part *Markman II* test. Part VI will also analyze each factor of the four-prong *Markman II* test as it applies to enablement. Part VII, the conclusion, stresses that under the *Markman II* analysis, the Federal Circuit should ultimately determine that enablement must be treated as a question of fact to be decided by the jury.

II. CLAIM INTERPRETATION

A. Background

In the most basic sense, a patent is a governmental grant to an inventor that gives the inventor a right to exclude others from making, using, or selling the invention.¹⁹ A patent itself is comprised of four major sections: the abstract, the drawings, the specifications, and the claims.²⁰ The claims consist of “numbered paragraphs that follow the descriptive portion of the specification,” defining “the metes and bounds of the claimed invention.”²¹ If an action for patent infringement is brought, the court must interpret the boundaries of the claims before determining whether an infringement has actually occurred.²² Claim interpretation ultimately affects the validity of a patent, its enforceability, and whether it has been infringed upon, thus rendering the decision of claim interpretation a very important issue in patent litigation.²³

B. Origins of the Claim Requirement

Provisions for the protection of patentable material were originally set forth in Article I, Section 8, Clause 8 of the United States Constitution.²⁴ The first patent legislation in the United States arose as

19. Greg J. Michelson, *Did the Markman Court Ignore Fact, Substance, and the Spirit of the Constitution in Its Rush Toward Uniformity?*, 30 LOY. L.A. L. REV. 1749, 1751 (1997) (citing 35 U.S.C. § 271(a) (1994)).

20. Cheryl L. Johnson, *Judges Were Tasked with Claim Construction to Bring Necessary Certainty: But Where Is It?*, in HOW TO PREPARE & CONDUCT MARKMAN HEARINGS 2002, at 7, 22 (PLI Intellectual Property Course, Handbook Series No. G-714, 2002).

21. *Id.*

22. *Id.* at 23.

23. Signore, *supra* note 1, at 799.

24. U.S. CONST. art. I, § 8, cl. 8. This Clause gives Congress the power to “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” *Id.* Both syntax and the colonial usage of the clause demonstrate that the “Science” language actually referred to the works of authors, while the “useful

part of the Patent Act of 1790.²⁵ This original Act did not require any type of claims disclosure.²⁶ Similarly, the Patent Act of 1793 only required a “written description . . . in such full, clear and exact terms, as to . . . enable any person skilled in the art or science, of which it is a branch, . . . to make, compound, and use the same.”²⁷ To interpret patents in this era, courts read the written description and decided whether the accused invention infringed upon the spirit of the original invention.²⁸

The first mention of claims as a requirement for patent applications occurred in 1836.²⁹ The purpose of the requirement was so that the “part, improvement, or combination which he claims as his own” was more specifically identified by the inventor.³⁰ Thus, patent claims became the primary measure of a patent’s scope.³¹ Patent applications began to define the essence of the invention, as well as the outer boundaries of the patented invention or process, in precise detail.³² The Patent Act of 1952 is the present statute.³³ It requires a specification that contains both a written description and a set of claims.³⁴ The claims section, however, still defines the scope of the rights created by the grant of the patent.³⁵ The purpose of the claims requirement is twofold: to give notice to others of that which

Arts” language referred to the work of inventors. PAUL GOLDSTEIN, COPYRIGHT, PATENT, TRADEMARK AND RELATED STATE DOCTRINES 1-2 (Robert C. Clark et al. eds., 5th ed. 2002).

25. An Act to Promote the Progress of Useful Arts (Patent Act of 1790), ch. 7, 1 Stat. 109 (1790) (repealed 1793).

26. Dave A. Ghatt & Timothy B. Kang, *Claim Interpretation: A Regression to Uncertain Times*, 84 J. PAT. & TRADEMARK OFF. SOC’Y 456, 458 (2002) (citing An Act to Promote the Progress of Useful Arts, ch. 7, 1 Stat. 109).

27. *Id.* (quoting An Act to Promote the Progress of Useful Arts and to Repeal the Act Heretofore Made for that Purpose (Patent Act of 1793), ch. 11, § 3, 1 Stat. 318, 321 (1793) (repealed 1836)).

28. *Id.* (citing *Evans v. Eaton*, 16 U.S. (3 Wheat.) 454, 454-61 (1818)).

29. *Id.*; see also An Act in Addition to the Act to Promote the Progress of Useful Arts, ch. 45, § 7, 5 Stat. 191, 193 (1837) (current version at 35 U.S.C. §§ 1-293) (stating that “whenever any patentee shall have . . . made his specification of claim too broad, claiming more than that of which he was the original or first inventor,” he must disclaim that part and state the extent of his interest in writing).

30. Ghatt & Kang, *supra* note 26, at 458 (quoting An Act to Promote the Progress of Useful Arts and to Repeal All Acts and Parts of Act Heretofore Made for that Purpose (Patent Act of 1836), ch. 357, 5 Stat. 117, 119 (1836) (repealed 1870)).

31. Michelson, *supra* note 19, at 1752.

32. *Id.* at 1753.

33. *Id.*

34. 35 U.S.C. § 112 (2000).

35. Michelson, *supra* note 19, at 1753.

the patent encompasses so as to prevent infringement, and to allow others to use the patented invention or process after the patent expires.³⁶

C. Claim Interpretation—Question of Law or Fact?

1. The Federal Court Decisions Prior to *Markman*

Prior to *Markman*, there were two separate situations that determined whether the issue of claim interpretation was submitted to the judge or the jury.³⁷ In the first situation, neither the claim terminology nor the underlying facts were in dispute.³⁸ In that situation, claim interpretation was treated as a question of law, solely reserved for the court.³⁹ In the second situation, however, terminology or facts or both were in dispute.⁴⁰ In the situation when the parties presented conflicting evidence at trial, a majority of Federal Circuit cases held claim construction to be an issue of fact for the jury's determination.⁴¹

The Federal Circuit acknowledged the inconsistencies in its treatment of claim interpretation in its opinion in *Markman I*.⁴² The court cited several Federal Circuit cases as holding claim construction to be a factual or mixed issue.⁴³ The Federal Circuit decisions, however, contain inconsistencies as “to what extent claim construction is a legal issue or a factual issue, or a mixed issue.”⁴⁴ The court attempted to clarify these inconsistencies by stating that the Federal Circuit had originally held claim construction to be a question of law and that *McGill Inc. v. John Zink*

36. *Id.* at 1754.

37. Brief of Amicus Curiae Association of Trial Lawyers of America at 4, *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996) (No. 95-26) (citing *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 656-58 (Fed. Cir. 1986)).

38. *Id.* (citing *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579 (Fed. Cir. 1989)).

39. *Id.*

40. *Id.*

41. *Id.* (citing, *inter alia*, *Delta-X Corp. v. Baker Hughes Prod. Tools, Inc.*, 984 F.2d 410, 415 (Fed. Cir. 1993)).

42. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996).

43. *Id.* (citing *Tol-O-Matic, Inc., v. Proma Produkt-Und Mktg. Gesellschaft m.b.H.*, 945 F.2d 1546, 1550-52 (Fed. Cir. 1983); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed. Cir. 1985)); *see also* *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 657 (Fed. Cir. 1986) (holding that claim construction is a legal question with underlying factual disputes).

44. Brian D. LeFort, *Bifurcation—New Era in Patent Litigation*, 2 SUFFOLK J. TRIAL & APP. ADVOC. 175, 183 (1997) (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d at 976).

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Co.,⁴⁵ in 1984, was the first Federal Circuit case to deviate from that standard.⁴⁶

In *McGill*, the court held that a determination of the scope of the claims was an issue of law, but that a judge could only resolve the issue if the language of the claims was undisputed.⁴⁷ If the language was disputed and extrinsic evidence was necessary to discern the meaning of a term, a jury would be left to determine its meaning.⁴⁸ The court clearly pointed out that a jury could not be instructed as to the meaning of the term when its meaning was at issue.⁴⁹

Similarly, in 1985, the Federal Circuit decided *Palumbo v. Don-Joy Co.*,⁵⁰ which held that whether the meaning of a term is disputed determines whether the issue is submitted to the judge or to the jury.⁵¹ If the term's meaning is disputed and extrinsic evidence is necessary to make a determination of its meaning, an underlying factual question arises, and interpretation of that claim should be submitted to the jury.⁵²

In 1991, the Federal Circuit issued an opinion in *Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft m.b.H.*⁵³ that held that claim interpretation is defined as a matter of law based on underlying factual issues.⁵⁴ The court found that a jury should decide the meaning of a term when the meaning is "unclear, subject to varying interpretations, or ambiguous."⁵⁵ Because the court found that claim interpretation was a matter of law based on underlying factual issues in *Tol-O-Matic, Inc.*, the court was left with a mixed question of fact and law.⁵⁶ In this situation, the Federal Circuit suggested that the jury be given instructions as to the principles of law to be applied to the facts, but that the jury should make

45. McGill Inc. v. John Zink Co., 736 F.2d 666 (Fed. Cir. 1984).

46. Markman v. Westview Instruments, Inc., 52 F.3d at 976 (citing McGill Inc. v. John Zink Co., 736 F.2d at 671).

47. McGill Inc. v. John Zink Co., 736 F.2d at 671.

48. *Id.* at 672.

49. *Id.*

50. Palumbo v. Don-Joy Co., 762 F.2d 969 (Fed. Cir. 1985).

51. *Id.* at 974.

52. *Id.*

53. Tol-O-Matic, Inc. v. Proma Produkt-Und Mktg. Gesellschaft m.b.H., 945 F.2d 1546 (Fed. Cir. 1991).

54. *Id.* at 1549.

55. *Id.* at 1550.

56. *See id.* (holding that the trial court submitted a mixed question to the jury in this case).

the ultimate determination.⁵⁷

2. *The Federal Circuit Decision in Markman*

Despite this line of cases, the Federal Circuit pointed out in *Markman I* that there was an equally significant line of cases holding that claim construction is a matter of law to be heard exclusively by a judge.⁵⁸ The court ultimately held patent construction to be an issue properly construed by judges because there is a historically fundamental principle that written evidence is within the exclusive jurisdiction of the court.⁵⁹ The *Markman I* court stated that the interpretation of claims was very important because that construction essentially becomes part of the specification of the invention, thus defining the rights of the inventor.⁶⁰ For reasons of fairness and predictability of a patentee's rights, patent claims should be construed by judges.⁶¹ The danger of false interpretation of a patentee's claims by a jury could not be escaped on appeal because the claims would be reviewed only for clear error by an appellate court.⁶² If the claims were interpreted by a judge, however, the invention "becomes reviewable to the same extent as any other legal question," reflecting a more accurate and true interpretation of the patentee's claims.⁶³

III. THE SUPREME COURT'S FOUR-FACTOR TEST IN *MARKMAN*

In the Supreme Court's review of *Markman II*, the issue on appeal was whether the interpretation of a patent claim, which defines the scope of the patentee's rights, was a matter of law or fact.⁶⁴ If it was determined to be a question of law, it would be reserved entirely for the court; if it was a question of fact, it would be subject to the Seventh Amendment's guarantee that a jury would determine the meaning of disputed terms of art.⁶⁵ Because the interpretation of a patent claim "falls somewhere

57. *Id.*

58. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 977 (Fed. Cir. 1995) (citing, *inter alia*, *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 986 (Fed. Cir. 1988), *aff'd*, 517 U.S. 370 (1996)).

59. *Id.* at 978.

60. *Id.*

61. *Id.*

62. *Id.* at 979.

63. *Id.* (quoting 2 WILLIAM C. ROBINSON, *THE LAW OF PATENTS FOR USEFUL INVENTIONS* § 733 (Boston, Little, Brown & Co. 1890)).

64. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996).

65. *Id.*; *see also* U.S. CONST. amend. VII (stating that the right to a jury trial "shall be preserved, and no *fact* tried by a jury, shall be otherwise re-examined")

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between a pristine legal standard and a simple historical fact,” the fact versus law distinction was not clear.⁶⁶ In making this determination, Justice Souter, writing for the Court, first looked at the history of patent law.⁶⁷

A. *The Historical Test*

The Court's analysis began with a brief application of the Seventh Amendment, which provides that “[i]n Suits at common law . . . the right of trial by jury shall be preserved”⁶⁸ The Seventh Amendment does not actually create a right to a jury trial, but instead preserves any pre-existing jury trial rights that were already in place in 1791.⁶⁹ Because the Seventh Amendment was based on a right originally existing under English common law, the Court commonly applies the “historical test” to determine if the right has been preserved.⁷⁰ The historical test used in *Markman II* is not a new form of analysis and has been utilized many times to determine if a party is entitled to a jury trial.⁷¹ It was originally set forth in *Baltimore & Carolina Line, Inc. v. Redman*⁷² in 1935.⁷³ The Court held that “[t]he right of trial by jury thus preserved is the right which existed under the English common law when the Amendment was adopted.”⁷⁴

The historical test uses a two-part analysis to evaluate whether the cause of action was tried at law or equity at the time of adoption of the Seventh Amendment or is analogous to a cause that was.⁷⁵ If it was tried at law, the Court then determines whether the particular issue at trial must go to the jury in order to “preserve the substance of the common-law right as

(emphasis added).

66. Markman v. Westview Instruments, Inc., 517 U.S. at 388 (quoting Miller v. Fenton, 474 U.S. 104, 114 (1985)).

67. *Id.* at 373.

68. *Id.* at 376 (quoting U.S. CONST. amend. VII).

69. The Supreme Court, 1995 Term—Leading Cases, 110 HARV. L. REV. 135, 267 (1996).

70. Markman v. Westview Instruments, Inc., 517 U.S. at 376.

71. See, e.g., Grafinciera v. Nordberg, 492 U.S. 33, 42 (1989) (comparing the statutory action to actions brought in the courts of eighteenth-century England to determine if a party is entitled to a Seventh Amendment jury trial).

72. Balt. & Carolina Line, Inc. v. Redman, 295 U.S. 654 (1935).

73. *Id.* at 657.

74. Margaret L. Moses, *What the Jury Must Hear: The Supreme Court's Evolving Seventh Amendment Jurisprudence*, 68 GEO. WASH. L. REV. 183, 187-88 (2000) (quoting Balt. & Carolina Line, Inc. v. Redman, 295 U.S. at 657).

75. Markman v. Westview Instruments, Inc., 517 U.S. at 376 (citing Tull v. United States, 481 U.S. 412, 417 (1987)).

it existed in 1791.”⁷⁶

As to the first portion of the test, the Court held there was no question that patent infringement actions in the eighteenth century were tried at law and therefore must generally be tried to a jury today, just as they were then.⁷⁷ However, the more important issue: to the *Markman II* Court was the second issue: whether a particular issue within a jury trial, such as claim construction, must be left to the jury.⁷⁸ The Court concluded that claim construction in particular had no clear history under English common law, therefore making its determination as a question of fact or law a determination of the scope of the Seventh Amendment.⁷⁹

The second part of the “historical test” depends on “whether the jury must shoulder this responsibility *as necessary to preserve the substance of the common-law right of trial by jury.*”⁸⁰ Because there is no exact predecessor to claim construction per se, the Court found it necessary to compare the “mongrel practice” with the most appropriate analogy that has a known submission to court or jury in the English common law.⁸¹ Because claim practice was not recognized by statute within patent law until 1836 and was not a formal requirement until 1870, the best analogy that could be drawn was found in the specifications contained within a patent application.⁸² The Court examined a “smattering” of patent cases involving issues of specification and found “no established jury practice sufficient to support an argument by analogy that today’s construction of a claim should be a guaranteed jury issue.”⁸³ In fact, the Court found no case showing that a jury ever determined the definition of a term within a specification.⁸⁴ Conversely, the Court found several cases suggesting that judges did indeed interpret terminology of specifications before submission

76. *Id.*

77. *Id.* at 377 (citation omitted).

78. *Id.*

79. *Id.*

80. *Id.* (quoting *Tull v. United States*, 481 U.S. at 426) (second internal quotation omitted).

81. *Id.* at 378 (citations omitted).

82. *Id.* at 379; *see supra* note 29 and accompanying text; *see also* An Act to Revise, Consolidate, and Amend the Statutes Relating to Patents and Copyrights, ch. 230, § 26, 16 Stat. 198, 201 (1870) (current version at 35 U.S.C. §§ 1-293) (stating that an inventor “shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery”).

83. *Markman v. Westview Instruments, Inc.*, 517 U.S. at 379-80.

84. *Id.* at 380.

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to the jury.⁸⁵ One historian cited by the *Markman II* Court observed that judges of the late eighteenth century consistently “[kept] the . . . writings *out of the jury’s hands* and reserve[d] it for themselves” as a “safeguard” against the possibility that the jury might “construe or refine upon it at pleasure.”⁸⁶

Based on this absence of jury activism in determinations of specification construction, the Court sought a different “anchor for analogy.”⁸⁷ It then looked at whether juries were actually equipped to define the terms of art within a specification.⁸⁸ The Court cited an 1841 case that held that patent construction was a determination made by the court, but that juries should decide questions of words of art.⁸⁹ Because this case was decided nearly fifty years after the Seventh Amendment was adopted and there appeared to be no earlier cases, the *Markman II* Court found it more likely that courts had been both construing specification construction and defining terms of art in 1791 and that this decision was merely the exception to the rule.⁹⁰ Finding no evidence of jury participation in either specification construction or defining terms of art, the Court’s history did not necessitate the application of the Seventh Amendment’s jury guarantee to the claims.⁹¹

B. *Current Precedent*

The Court then looked to existing precedent to consider the “relative interpretive skills of judges and juries.”⁹² The Court quickly distinguished the two cases relied upon by *Markman* as not dealing with the jury’s role in disputed terms within the patent, but instead as allowing the jury to hear expert testimony on whether the physical objects of the patent were identical.⁹³ In those cases, the Court expressly attempted to avoid affecting

85. *Id.* at 382 (citing *Bovill v. Moore*, Dav. Pat. Cas. 361, 399, 404 (C.P. 1816)). In *Bovill*, the court held that a judge submits a question of novelty to the jury only after explaining the language and stating the terms of the specification. *Bovill v. Moore*, Dav. Pat. Cas. 361, 399, 404.

86. *Markman v. Westview Instruments, Inc.*, 517 U.S. at 382 n.7 (quoting 9 JOHN HENRY WIGMORE, EVIDENCE IN TRIALS AT COMMON LAW § 2461 (James H. Chadbourn rev. ed. 1981)).

87. *Id.* at 383.

88. *Id.* at 384.

89. *Id.* at 383 (citing *Neilson v. Harford*, Webs. Pat. Cas. 328 (Exch. 1841)).

90. *Id.* at 383-84.

91. *Id.* at 384.

92. *Id.*

93. *Id.* at 385-86 (citing *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814-15

the doctrine that allows the judge to construe patent claims.⁹⁴ In an attempt to examine current precedent, the Court looked to contemporary treatises and respected commentators, stating that in the context of extrinsic evidence, “[q]uestions of construction are questions of law for the judge, not questions of fact for the jury.”⁹⁵

C. Functional Considerations

After exhausting both historical treatment and current precedent and finding no submission of claim construction to juries, the Court reflected on whether there were any functional considerations that might weigh in favor of judge or jury.⁹⁶ Judges often construe written instruments, and because of their special training and discipline, the Court decided that they are more likely to give the proper interpretation to the already confusing patents that they examine.⁹⁷ Because judges have interpreted claims for almost 150 years, and patent claims of today have such a high level of technicality, the *Markman II* Court determined that judges would be better suited to interpret those claims.⁹⁸ Markman argued that juries should interpret claims because those claims usually turn on the credibility of two different experts, and judges cannot consider credibility in their decisions.⁹⁹ The Court dismissed Markman’s argument as being a rare situation.¹⁰⁰ Instead, “any credibility determinations will be subsumed within the necessarily sophisticated analysis of the whole document” and are much less significant than the evaluation of the testimony in regard to the overall patent.¹⁰¹

D. Uniformity of Treatment

Finally, the *Markman II* Court considered uniformity of treatment as an independent reason to allocate all construction issues to judges.¹⁰² The Court discussed the importance of the public knowing the limits of a patent

(1869); *Tucker v. Spalding*, 80 U.S. (13 Wall.) 453, 456 (1871)).

94. *See id.* at 386 (citing *Bischoff v. Wethered*, 76 U.S. at 816).

95. *Id.* at 387 (quoting ALBERT H. WALKER, TEXT-BOOK OF THE PATENT LAWS OF THE UNITED STATES OF AMERICA § 75 (3d ed. 1895)).

96. *Id.* at 388.

97. *Id.* at 388-89 (citing *Parker v. Hulme*, 18 F. Cas. 1138, 1140 (C.C.E.D. Pa. 1849) (No. 10,740)).

98. *Id.* at 388.

99. *Id.* at 389.

100. *Id.*

101. *Id.* at 389-90 (citations omitted).

102. *Id.* at 390.

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to avoid the “zone of uncertainty,”¹⁰³ the same reasoning used to create “the Court of Appeals for the Federal Circuit as an exclusive appellate court for patent cases.”¹⁰⁴ For reasons of issue preclusion and intrajurisdictional certainty via stare decisis, the Court held that interpretive issues such as claim construction should be purely a legal question for the court.¹⁰⁵

IV. POST-MARKMAN TREATMENT

Procedurally, following *Markman II*, it has been unambiguous that a judge decides any claim interpretation issues whether or not there are underlying factual questions.¹⁰⁶ The jury does not even decide the issue if extrinsic evidence, such as expert witness testimony, is necessary to construe the claims.¹⁰⁷ Judges decide construction issues at varying points within the litigation process, both before and during trial.¹⁰⁸ The Federal Circuit may have suggested in *Markman I* that the claims should be interpreted at the close of evidence and “accomplished by the court in framing its charge to the jury,” but some judges prefer to do claim construction directly before or after discovery.¹⁰⁹ In the majority of cases following *Markman II*, some form of hearing on claim construction has been held, with presentation of expert testimony.¹¹⁰ Theoretically, the judge’s decision in a *Markman* hearing should be immediately available as an interlocutory appeal to the Federal Circuit, but unfortunately, the Federal Circuit has not accepted a single interlocutory appeal based on a *Markman* hearing.¹¹¹

103. *Id.* (quoting *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942)).

104. *Id.* (citing H.R. REP. NO. 97-312, at 20-23 (1981)).

105. *Id.* at 391.

106. Ted D. Lee & Michelle Evans, *The Charade: Trying a Patent Case to All “Three” Juries*, 8 TEX. INTELL. PROP. L.J. 1, 16 (1999) (citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370 (1996)).

107. *Id.*

108. Edward V. Filardi & Douglas R. Nemec, *The Effect of Markman on Patent Litigation: Practical Considerations*, in HOW TO PREPARE & CONDUCT MARKMAN HEARINGS 2002, at 225, 234 (PLI Intellectual Property Course, Handbook Series No. G-714, 2002).

109. *Id.* at 236 (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d at 981).

110. *Id.* at 248-49 (footnote omitted).

111. *Id.* at 258 n.58 (“[T]o date [,] the Federal Circuit has declined interlocutory review of claim construction decisions in all certified questions before it.”) (quoting *Schering Corp. v. Amgen, Inc.*, 35 F. Supp. 2d 375, 377 (D. Del. 1999),

V. ENABLEMENT: FOR THE JUDGE OR JURY?

A. Background

One of the four major sections of the patent application is the specification.¹¹² The first paragraph of 35 U.S.C. § 112 contains the statutory disclosure requirements for patents and requires that the patent specification contain a written description of both the invention itself and “the manner and process of making” it in terms so clear, concise, and exact that any person skilled in the art would be able to create and use the invention by following the description.¹¹³ This is known as the enablement requirement: the specification must enable others skilled in the art to make and use the invention without undue experimentation.¹¹⁴ Courts will generally apply a series of factors, originally established in *In re Wands*,¹¹⁵ to determine whether the experimentation required is undue and whether the invention is therefore not enabled.¹¹⁶

At trial, enablement is frequently used as a defense to an action for infringement of a patent.¹¹⁷ If the defendant claims non-enablement of the plaintiff's patent, the defendant is required to prove by clear and convincing evidence that the specifications of the plaintiff's patent were not enabling.¹¹⁸ An inventor is only required to make known the information available to him at the time the patent is filed.¹¹⁹ Any later-discovered

aff'd, 222 F.3d 1347 (Fed. Cir. 2000)).

112. Johnson, *supra* note 20, at 22.

113. 35 U.S.C. § 112 (2000).

114. Mycogen Plant Sci., Inc. v. Monsanto Co., 61 F. Supp. 2d 199, 257-58 (D. Del. 1999) (citations omitted).

115. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

116. *See id.* (setting forth factors used to determine if experimentation is undue). The factors include:

- (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

Id.

117. Lawrence R. LaPorte et al. *Less Is More: Succeeding with an Enablement Defense*, in PATENT LITIGATION 2002, at 909, 915 (PLI Intellectual Prop. Course, Handbook Series No. G-721, 2002).

118. Mycogen Plant Sci., Inc., v. Monsanto Co., 61 F. Supp. 2d at 258 (citing Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1375 (Fed. Cir. 1986)).

119. Gerald Sobel, *Developments in Patent Law at the Federal Circuit*, in

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technology cannot supplement an earlier application in order to make it enabling.¹²⁰ Similarly, the specification does not need to teach what is already known to those skilled in the art, "including old, common, and well known matters."¹²¹ Enablement must meet only a level of disclosure that is sufficiently detailed so that those skilled in the relevant art can make and use the invention without undue experimentation.¹²²

B. *The Confusion: Judge or Jury?*

There appears to be no consensus at the trial court level as to whether the issue of enablement should be submitted to a jury or decided independently by a judge.¹²³ At the appellate level, the Federal Circuit has not made a determination of whether enablement is a pure question of fact or law.¹²⁴ Instead, the court focuses on the level of deference given during appellate review, holding that de novo review should apply to enablement decisions, whether made by a judge or a jury.¹²⁵ The Federal Circuit often employs a dual level of appellate review, in which it reviews de novo enablement as a matter of law and any factual underpinnings on which it is based for clear error.¹²⁶

A recent decision by the Federal Circuit initially set out its standard of review for enablement as a question of law reviewed de novo, which is based on underlying factual inquiries that are reviewed for clear error.¹²⁷ In the same decision, however, the court unambiguously held that

TECHNOLOGY LICENSING AND LITIGATION 1998, at 437, 488 (PLI Patents, Copyrights, Trademarks & Literary Prop. Course, Handbook Series No. G-514, 1998).

120. *Id.*

121. *Id.* at 489 (citing *In re Wands*, 858 F.2d at 735).

122. Jerry R. Selinger, *In Defense of "Best Mode": Preserving the Benefit of the Bargain for the Public*, 43 CATH. U. L. REV. 1071, 1097 (1994).

123. *Compare* *Enzo Biochem, Inc. v. Calgene, Inc.*, 188 F.3d 1362, 1376 (Fed. Cir. 1999) (holding that "enablement is a question of law that the courts *must* decide") (emphasis added), *with* *Allen Organ Co. v. Kimball Int'l, Inc.*, 839 F.2d 1556, 1566 (Fed. Cir. 1988) (finding that, although enablement is a question of law, "it is amenable to resolution by the jury").

124. Arti K. Rai, *Specialized Trial Courts: Concentrating Expertise on Fact*, 17 BERKELEY TECH. L.J. 877, 885 (2002).

125. *See, e.g.*, *N. Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 941-43 (Fed. Cir. 1990) (noting that the district court's determination of nonenablement should only be overturned for clear error, yet reversing the trial court's findings after considering all of the evidence presented at trial).

126. *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993) (citations omitted).

127. *Enzo Biochem, Inc. v. Calgene, Inc.*, 188 F.3d at 1369-70 (citing *Johns Hopkins Univ. v. Cellpro, Inc.*, 152 F.3d 1342, 1354 (Fed. Cir. 1998)).

enablement is ultimately “a question of law that the *courts must* decide.”¹²⁸

In many district court cases, the presiding judge determines issues of enablement without assistance from a jury.¹²⁹ Conversely, many district courts submit issues of enablement to a jury for determination.¹³⁰ In *Allen Organ Co. v. Kimball International, Inc.*,¹³¹ the Federal Circuit held that although it agreed that enablement is a question of law, “it is amenable to resolution by the jury.”¹³² In a district court case, *Lucent Technologies Inc. v. Newbridge Networks Corp.*,¹³³ the court held that because “[a]s is often true of legal questions . . . the ultimate legal conclusion of enablement rests on factual underpinnings,” the court could not conclude that it was error to submit the issue to the jury.¹³⁴ Another district court held that because enablement is based on disputed facts, the issue should be resolved by a jury and not by summary judgment.¹³⁵ In *Newell Companies, Inc. v. Kenney Manufacturing Co.*,¹³⁶ the Federal Circuit highlighted its endorsement of the right to a jury trial on issues such as enablement even though the defense is recognized as a question of law.¹³⁷

In *Spectra-Physics, Inc. v. Coherent, Inc.*,¹³⁸ a case that illustrates the

128. *Id.* at 1376 (emphasis added).

129. *See, e.g.*, *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 955 (Fed. Cir. 1983) (noting that the district court declared the patent invalid because of the absence of enabling disclosure).

130. *See, e.g.*, *Union Carbide Chem. & Plastics Tech. Corp. v. Shell Oil Co.*, 308 F.3d 1167, 1175 (Fed. Cir. 2002) (stating that the jury found the patent was invalid for lack of enablement); *Bio-Tech. Gen. Corp. v. Genentech Inc.*, 267 F.3d 1325, 1329 (Fed. Cir. 2001) (noting that a special interrogatory was submitted to the jury on the issue of enablement); *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1573 (Fed. Cir. 1992) (stating that the jury found the patent was enabled and valid); *CVI/Beta Ventures, Inc. v. Tura LP*, 905 F. Supp. 1171, 1194 (E.D.N.Y. 1995) (“Although the issue of enablement may be one of law, it is dependent on several factual questions which were appropriately submitted to the jury.”).

131. *Allen Organ Co. v. Kimball Int’l, Inc.*, 839 F.2d 1556 (Fed. Cir. 1988).

132. *Id.* at 1566 (citations omitted).

133. *Lucent Techs., Inc. v. Newbridge Networks Corp.*, 168 F. Supp. 2d 181 (D. Del. 2001).

134. *Id.* at 243-44 (quoting *Union Pac. Res. Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 690 (Fed. Cir. 2001)).

135. *DeKalb Genetics Corp. v. Pioneer Hi-Bred Int’l, Inc.*, No. 96 C 50112, 2001 WL 92122, at *2 (N.D. Ill. Jan. 5, 2001).

136. *Newell Co., v. Kenney Mfg. Co.*, 864 F.2d 757 (Fed. Cir. 1988).

137. *See id.* at 775 n.3 (pointing out that the use of jury trials has been regularly affirmed by the court) (citing *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533 (Fed. Cir. 1987)).

138. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524 (Fed. Cir. 1987).

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confusion in this area of law, the district court judge entered a judgment on the jury verdict, then later withdrew the judgment and independently decided the issue of enablement.¹³⁹ On appeal, the Federal Circuit first considered whether the district court was free to decide enablement in this manner.¹⁴⁰ The district court opined that it was justified in its determination because enablement was a question of law that had not been specifically addressed by the jury verdict.¹⁴¹ The Federal Circuit held that although enablement was a question of law, there may be underlying factual issues involved.¹⁴² The Federal Circuit continued, stating that “the [district] court *may* submit legal issues such as enablement to the jury, . . . but *if it does*, the court may not make subsequent findings which overrule an implicit and inherent finding of the jury.”¹⁴³ This language suggests that submission of enablement issues to either the judge or jury is permissible.¹⁴⁴

VI. THE NEED FOR RESOLUTION

Currently, the Federal Circuit treats enablement in the same manner that it treated claim interpretation before the *Markman* holdings in 1995 and 1996.¹⁴⁵ When there are facts in dispute, the Federal Circuit has said that it is appropriate to treat enablement as a question of fact and submit it to the jury.¹⁴⁶ If there are no facts in dispute, however, the Federal Circuit has endorsed the practice of allowing the court to decide enablement issues alone.¹⁴⁷ The same inconsistencies exist for enablement questions as did for claim interpretation prior to *Markman*.¹⁴⁸

A. *The Markman Four-Factor Test Applied to Enablement Issues*

In laying out its four-factor test in *Markman II*, the Supreme Court has set a precedent for the manner of determining whether an issue should be considered a question of law or of fact, and thus whether the jury or the

139. *Id.* at 1531.

140. *Id.* at 1532-33.

141. *Id.* at 1533.

142. *Id.* (citations omitted).

143. *Id.* (citations omitted) (emphasis added).

144. *See id.* (using ambiguous language such as “may” and “if it does”).

145. *See supra* Part II.C.1; *see also supra* note 126 and accompanying text (stating that the Federal Circuit employs a dual level of review for enablement issues: de novo for enablement and clear error for any factual underpinnings).

146. *See supra* notes 126-33 and accompanying text.

147. *See supra* notes 121-25 and accompanying text.

148. *See supra* text accompanying note 42.

judge should decide the issue.¹⁴⁹ Enablement should be analyzed in the same manner to determine both its proper standard of review and which adjudicative body should make relevant judicial decisions. If enablement is found to be a question of law under the four *Markman II* factors, it should be determined exclusively by the court, much like claim construction is handled today.¹⁵⁰ Likewise, if enablement is determined to be a question of fact, it should be decided by the jurors in each case.¹⁵¹

1. *The Historical Test*

The two-part “historical test” employed in *Markman II* was used to evaluate whether the cause of action at issue was tried at law or in equity at the time of the adoption of the Seventh Amendment or is analogous to a cause that was tried at law.¹⁵² If it was tried at law, the second part of the test analyzes whether the particular issue at trial must go to the jury in order to “preserve the substance of the common-law right as it existed in 1791.”¹⁵³

The Federal Circuit explained the first prong of the test in *Markman I*, stating that “if an action could be tried to a jury in 1791, the right to a jury trial is preserved.”¹⁵⁴ The court also noted that the Seventh Amendment had been interpreted to extend the right to a jury trial to contemporary statutory causes of action analogous to common law causes of action tried in 1791.¹⁵⁵

The Supreme Court found the first prong of the historical test to be quite familiar.¹⁵⁶ The Court determined there was no question that today’s patent infringement cases must be tried to a jury, just “as their predecessors were more than two centuries ago.”¹⁵⁷ The more difficult part of the inquiry is whether, according to the second prong of the historical test, the particular issue of enablement must go to the jury in order to

149. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996).

150. *Cf. id.* at 372 (holding that if it is a question of law, claim interpretation should be reserved for the court).

151. *Cf. id.* (holding that if it is a question of fact, claim interpretation would be subject to a Seventh Amendment jury trial).

152. *Id.* at 376 (citing *Tull v. United States*, 481 U.S. 412, 417 (1987)).

153. *Id.*

154. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 984 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370 (1996).

155. *Id.* (citing *Tull v. United States*, 481 U.S. at 417).

156. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 377 (1996).

157. *Id.* (citing *Bramah v. Hardcastle*, 1 Carp. P.C. 168, 172 (K.B. 1789)).

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“preserve the substance of the common-law right as it existed in 1791.”¹⁵⁸

The Court noted that the answer to this question is easy when “clear historical evidence” exists, such as historical proof of having a jury decide the particular issue under English practice.¹⁵⁹ Although the Court found that claim interpretation was not such an issue,¹⁶⁰ it implied that enablement was.¹⁶¹ In contrast to patent claims, which did not exist in either British or American patent practice in or around 1791,¹⁶² evidence of a requirement enabling a patented invention to be reproduced exists in the United States’ initial patent legislation.¹⁶³ As early as 1790, a statutory defense to patent infringement existed for those patents that were not described in sufficient detail to enable a person skilled in the art to produce the invention after the patent expired.¹⁶⁴ The enablement requirement was amended by the Patent Act of 1793 to actually require the patent ““to enable any person skilled in the art or science . . . to make, compound, and use [it],”” implementing the enablement language for the first time.¹⁶⁵

Because it is clear that the statutory defense of enablement existed during the time that the Seventh Amendment was enacted by statute, the next step is to examine whether it was tried to a jury or decided by the court at the time. *Arkwright v. Nightingale*,¹⁶⁶ a 1785 case cited by the *Markman II* Court,¹⁶⁷ is a British enablement case that was tried to a jury years before the Seventh Amendment was adopted.¹⁶⁸ The jury in that case found that the patent specification was enabling in that it sufficiently taught those skilled in the art how to make and use the invention.¹⁶⁹

158. *Id.* at 376.

159. *Id.* at 377.

160. *See id.* (holding that the old English practice provides no clear answer to whether claim interpretation was tried to a jury or judge).

161. *See id.* at 379 (citing *Arkwright v. Nightingale*, Dav. Pat. Cas. 37, 60 (C.P. 1785) (noting that patent litigation in that period was typified by enablement cases)).

162. *Id.* at 378-79.

163. Selinger, *supra* note 122, at 1072-73.

164. *Id.* at 1073 (citing Patent Act of 1790, ch. 7, § 2, 1 Stat. 109, 110 (repealed 1793)).

165. *Id.* (quoting Patent Act of 1793, ch. 11, § 3, 1 Stat. 318, 321 (repealed 1836)). The Patent Act of 1836 left the 1793 enablement requirement largely intact. *Id.* at 1075 (citing Patent Act of 1836, ch. 357, § 6, 5 Stat. 117, 119 (repealed 1870)).

166. *Arkwright v. Nightingale*, Dav. Pat. Cas. 37 (C.P. 1785).

167. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 379 (1996).

168. Edward C. Walterscheid, *The Early Evolution of the United States Patent Law: Antecedents (Part 4)*, 78 J. PAT. & TRADEMARK OFF. SOC'Y 77, 101-02 n.132 (1996) (citing *Arkwright v. Nightingale*, Dav. Pat. Cas. 37, 60 (C.P. 1785)).

169. *Id.* (citing *Arkwright v. Nightingale*, Dav. Pat. Cas. 37, 60 (C.P. 1785)).

Early American cases followed suit by trying enablement issues exclusively to juries. In 1854, the Supreme Court decided *Batton v. Taggart*,¹⁷⁰ which held that the jury had the right to determine whether the specifications were precise enough to enable any person skilled in the art to make the invention.¹⁷¹ The Court held that not only did the jury have that right, but the Patent Act actually *required* juries to determine enablement issues.¹⁷² Thus, historically, both in pre-1791 England and later American cases, enablement was tried to the jury.¹⁷³ The historical test unequivocally leans toward enablement being a question of fact for jury determination.

2. *Current Precedent*

As the second step in its determination of whether claim interpretation was a question for the jury or judge, the Supreme Court in *Markman II* examined current existing precedent and considered “the relative interpretive skills of judges and juries and the statutory policies that ought to be furthered by the allocation.”¹⁷⁴

The *Markman II* Court considered the teachings of contemporary treatises and respected commentators to be indicative of the current state of the law on claim construction as a question of law or fact.¹⁷⁵ A similar examination of treatises and commentators’ writings confirms that before the creation of the Federal Circuit, enablement was treated as a question of fact.¹⁷⁶ Since 1982, when the Federal Circuit was created, enablement has been termed a question of law, noting that the legal inquiry is based on underlying facts.¹⁷⁷ Thus, current precedent does not tip the scales in favor of enablement being a question of law or fact.

3. *Functional Considerations*

Because the *Markman II* Court found no clear answers in either history or current precedent, it considered factors such as “sound

170. *Batton v. Taggart*, 58 U.S. 74 (1854).

171. *Id.* at 85.

172. *Id.*

173. *See, e.g., id.*; *Arkwright v. Nightingale*, Dav. Pat. Cas. 37, 60 (C.P. 1785).

174. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384 (1996).

175. *Id.* at 387.

176. *See* 3 DONALD S. CHISUM, CHISUM ON PATENTS § 7.03(8)(b) (Matthew Bender & Co. 2002) (footnotes omitted).

177. *Id.* (footnotes omitted); *see also* MICHAEL A. EPSTEIN, EPSTEIN ON INTELLECTUAL PROPERTY § 5.02[E] (3d ed. 1999) (“Enablement is a question of law based on underlying factual inquiries.”).

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administration of justice” to determine whether the judge or the jury was better suited to resolve claim construction issues.¹⁷⁸ Specifically, the Court considered whether one body was better suited than the other to decipher patent claims.¹⁷⁹ The Court determined that judges were better equipped to define the meaning of patent terms because they have been trained *in exegesis* and are accustomed to interpreting written instruments.¹⁸⁰

When deciding whether a patent has enabled a person to make or use the invention, however, the judge is in no better position than the jury. The jury is actually in a better position to decide the issue of enablement than it is to interpret claims because there are fewer pure legal issues involved with a determination of enablement than with claim interpretation.¹⁸¹ Moreover, there are many factual determinations involved in the resolution of enablement issues, including “the scope of the teachings of the disclosure, the level of one of ordinary skill in the art, or whether a document incorporated by reference provides adequate disclosure.”¹⁸² Additionally, enablement decisions, in contrast to claim construction decisions, often turn on the credibility of witnesses regarding whether the patent effectively enabled the invention.¹⁸³

There are some arguments that claim construction is instead very similar to statutory construction, merely defining the meaning of terms in a legal document by examining related documents, something a judge does quite often.¹⁸⁴ Enablement “appears to be much closer to what juries normally do than is the case with claim interpretation.”¹⁸⁵ Comparing the factual issues involved in claim construction versus enablement, it is logically and functionally sound that claim construction be termed a question of law, while enablement, being more fact-based, be deemed a

178. Markman v. Westview Instruments, Inc., 517 U.S. at 388 (quoting Miller v. Fenton, 474 U.S. 104, 114 (1985)).

179. *Id.* (citing Miller v. Fenton, 474 U.S. at 114).

180. *Id.*

181. See Allen N. Littman, *The Jury's Role in Determining Key Issues in Patent Cases: Markman, Hilton Davis, and Beyond*, 37 J.L. & Tech. 207, 247 (1997) (“[T]he legal constraints on enablement seem to be less pervasive than those applicable to interpretation.”).

182. Signore, *supra* note 1, at 801.

183. See, e.g., ALM Surgical Equip., Inc. v. Kirschner Med. Corp., No. CIV.A.6:89-1622-3, 1990 WL 123996, at *10 (D.S.C. Apr. 25, 1990) (“The issue of enablement at trial turned upon the credibility of the witnesses to be determined by the jury.”).

184. Paul R. Michel, *The Challenge Ahead: Increasing Predictability in Federal Circuit Jurisprudence for the New Century*, 43 AM. U. L. REV. 1231, 1239 (1994).

185. Littman, *supra* note 181, at 247.

question of fact for the jury.¹⁸⁶

4. *Uniformity of Treatment*

The *Markman II* Court cited uniformity of treatment as an independent reason to allocate claim construction issues to the judge.¹⁸⁷ Both a patentee and a potential infringer must know the limits of a patent to further the goals of patent law¹⁸⁸ and to avoid a “zone of uncertainty” that would inevitably discourage invention in the particular field.¹⁸⁹ The *Markman II* Court found that “uniformity would . . . be ill served” by allowing juries to decide issues of patent construction.¹⁹⁰

If there were a great need for uniformity in classifying a particular mixed question as a question of law or fact, that need would undoubtedly weigh in favor of classification of the issue as a question of law.¹⁹¹ One reason for this is that the language of the applicable statute is often very broad or vague, and classification as a question of fact would result in varied outcomes from different juries.¹⁹² In the context of enablement issues, however, one must consider whether a need for uniformity of treatment or predictability even exists.¹⁹³ This depends on whether an incorrect determination in one case will affect the outcome of another case or affect the conduct of parties that were not involved in the litigation.¹⁹⁴

Although a decision on an enablement issue may have some effect on later litigation or private parties, the degree to which other parties will be affected is minimal when compared to claims construction. Although the Federal Circuit has not expressly ruled on *Markman II*'s effect on issue

186. See Michel, *supra* note 184, at 1239 (identifying the issues and considerations involved in claim construction); Signore, *supra* note 1, at 801-02 (identifying the factual issues underlying enablement).

187. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996).

188. See *id.* (citing *Gen. Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938)) (holding that the limits must be known “for the protection of the patentee, the encouragement of the inventive genius of others, and the assurance that the subject of the patent will be dedicated ultimately to the public”).

189. *Id.* (citing *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942)).

190. *Id.* at 391.

191. Sibley, *supra* note 8, at 212.

192. *Id.*

193. *Id.*

194. *Id.* (citing Stephen A. Weiner, *The Civil Nonjury Trial and the Law-Fact Distinction*, 55 CAL. L. REV. 1020, 1033-34 (1967)).

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preclusion of claims, several district courts have addressed the issue.¹⁹⁵ District courts have not allowed the doctrine of issue preclusion per se to be applied to claim interpretation, but some courts have held that the interpretation of a claim from an earlier case may be controlling over current litigants that were not party to or privy to the previous action.¹⁹⁶

Prior to *Markman I*, collateral estoppel could be applied to claim interpretation, but not until there was a final judgment.¹⁹⁷ Because the issue was submitted to a jury, there was no finality until after a jury verdict was rendered.¹⁹⁸ *Markman II* made claim interpretation a separate legal issue, to be determined by a judge often before the trial even begins.¹⁹⁹ Because *Markman* hearings can be held separately by a judge, several post-*Markman II* courts have suggested that collateral estoppel of a claim interpretation could be binding on a litigant when the claims in the prior case have been interpreted by a judge, but the case has settled before final judgment.²⁰⁰ This creates the possibility that collateral estoppel will be

195. Rachel Marie Clark, Note, *Collateral Estoppel of Claim Interpretation After Markman*, 86 MINN. L. REV. 1581, 1582 (2002) (citing, *inter alia*, Kollmorgen Corp. v. Yaskawa Elec. Corp., 147 F. Supp. 2d 464, 469-70 (W.D. Va. 2001); Edberg v. CPI-The Alternative Supplier, Inc., 156 F. Supp. 2d 190, 195-96 (D. Conn. 2001); Abbott Labs. v. Dey L.P., 110 F. Supp. 2d 667, 671-72 (N.D. Ill. 2000)). At a minimum, there are four requirements that must be met in order to apply collateral estoppel to claim construction:

- (1) the issue must be identical to one previously decided; (2) the issue must have been actually litigated; (3) the issue must have been essential to a final judgment in the prior litigation; and (4) the plaintiff must have had a "full and fair opportunity" to litigate the issue in the prior action.

James P. Bradley & Kelly J. Kubasta, *Issue Preclusion as Applied to Claim Interpretation*, 10 TEX. INTELL. PROP. L.J. 323, 347 (2002) (quoting *Pharmacia & Upjohn v. Mylin Pharm.*, 170 F.3d 1373, 1380 (Fed. Cir. 1999)).

196. See, e.g., *Burke, Inc. v. Bruno Indep. Living Aids, Inc.*, 183 F.3d 1334, 1337-39, 1341-42 (Fed. Cir. 1999) (holding that in order to preserve consistency in the interpretation of patent claims, an interpretation from a previous Federal Circuit opinion may be asserted against a different defendant in subsequent litigation); *Tate Access Floors, Inc. v. Interface Architectural Res., Inc.*, 185 F. Supp. 2d 588, 595 n.4 (D. Md. 2002) ("Prior claim constructions, when on point, are given deference under the doctrine of stare decisis in the interest of uniformity and consistency in claim interpretation.") (citation omitted).

197. C. Joël Van Over, *Collateral Estoppel and Markman Rulings: The Call for Uniformity*, 45 ST. LOUIS U. L.J. 1151, 1153 (2001) (citing *T.M. Patents L.P. v. Int'l Bus. Machs. Corp.*, 72 F. Supp. 2d 370, 376 (S.D.N.Y. 1999)).

198. *Id.*

199. *T.M. Patents L.P. v. Int'l Bus. Machs. Corp.*, 72 F. Supp. 2d at 376.

200. *Filardi & Nemec*, *supra* note 108, at 261.

applied far more frequently than it was before *Markman II*, because the decision now becomes final immediately following the *Markman* hearing.²⁰¹

Because enablement has not been termed a separate legal issue and there are no separate hearings to determine enablement issues, collateral estoppel will be applied to enablement as it always has been: only after a final judgment.²⁰² It is only possible to apply collateral estoppel to enablement cases that have reached a final verdict.²⁰³ Thus, claim construction has a greater need for uniformity than does enablement because collateral estoppel will be applied to claim construction more often than it will be applied to enablement.

The *Markman II* Court emphasized that making district court judges arbiters of claim construction questions was necessary because their decisions would ultimately bring a greater uniformity to the way claims were interpreted.²⁰⁴ Since the *Markman II* decision, however, this uniformity of treatment at the district court level has not been achieved.²⁰⁵ The Federal Circuit has found that district court claim interpretations were wrong twenty-eight percent of the time.²⁰⁶ This high reversal rate has actually created a greater uncertainty for litigants with claim construction issues.²⁰⁷ Similarly, the high reversal rate has actually increased litigation because litigants that might be likely to settle after the district court construes their claims may opt to risk losing at the trial level so that they can appeal to the Federal Circuit in hopes of a reversal on the interpretation of a claim.²⁰⁸ Instead of *Markman II*'s goal of uniformity being achieved, the Federal Circuit's frequent reversal rate has actually increased uncertainty among litigants and perpetuated patent litigation because parties prefer to hold out for appellate review.²⁰⁹

201. T.M. Patents L.P. v. Int'l Bus. Machs. Corp., 72 F. Supp. 2d at 376.

202. See *supra* note 197 and accompanying text.

203. Van Over, *supra* note 197, at 1153.

204. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996).

205. See generally Kimberly A. Moore, *Are District Court Judges Equipped to Resolve Patent Cases?*, 15 HARV. J.L. & TECH. 1, 2 (2001) (citing an empirical study finding that the Federal Circuit has found the district courts' interpretation of patent claim terms to be wrong almost one-third of the time).

206. *Id.* at 11. The study included 323 claim construction cases appealed between April 23, 1996 (the day after the *Markman II* decision) and December 31, 2000. *Id.* at 9. "In these 323 cases, 496 separate claim construction issues were appealed." *Id.* These data include all cases appealed in that time period, not merely a representative selection of cases. *Id.*

207. *Id.* at 27.

208. *Id.* at 27-28.

209. *Id.* at 28.

VII. CONCLUSION

Using the four-factor test set forth in *Markman II*, it is clear that enablement should be deemed a question of fact for the jury to decide. It is apparent under the historical test that enablement existed when the Seventh Amendment was enacted.²¹⁰ It was tried to English juries during that period and to American juries thereafter.²¹¹ Under the test, then, enablement must go to the jury in order to “preserve the substance of the common-law right as it existed in 1791.”²¹² The historical test alone is an independent reason to assign enablement issues to the jury, but because the *Markman II* Court found no answers in the historical test, it considered other factors, which are also considered here.²¹³

The second prong of the *Markman II* analysis, current precedent, does not lean toward enablement being a question of law *or* fact, considering its mixed review.²¹⁴ Many current cases, however, do point toward the application of enablement questions to juries, even though it is termed a question of law with underlying factual inquiries.²¹⁵ The Supreme Court in *Markman II* specifically declined to decide whether current precedent alone would trigger the protections of the Seventh Amendment if there were no other reason to classify it as a question of fact.²¹⁶ In the case of enablement, however, the other factors set out by the Court support a finding of enablement being a question of fact for the jury.²¹⁷

Functional considerations lean toward submission of enablement to the jury because of the numerous factual inquiries and credibility determinations involved in enablement decisions.²¹⁸ Lastly, the great need for uniformity of treatment of enablement issues does not exist as it did with claim interpretation.²¹⁹ There is less danger of collateral estoppel being employed with enablement issues.²²⁰ The danger in applying collateral estoppel to claim interpretation is in the fact that any claim

210. See *supra* notes 152-65 and accompanying text.

211. See *supra* notes 166-73 and accompanying text.

212. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 376 (1996).

213. See *supra* Parts III.B–C (examining current precedent and functional considerations).

214. See *supra* Part VI.A.2.

215. See *supra* Part VI.A.2.

216. *Markman v. Westview Instruments, Inc.*, 517 U.S. at 384.

217. *Id.* at 384-85.

218. See *supra* notes 178-86 and accompanying text.

219. See *supra* Part VI.A.4.

220. See *supra* Part VI.A.4.

construction issues can receive a final judgment during a *Markman* hearing and be immediately available to collaterally estop subsequent litigants.²²¹ The same danger is not present for enablement because it has no separate hearing or legal determination.²²² Likewise, the uniformity among the district court judges that was sought through the *Markman II* decision has not been achieved, as almost one-third of district court decisions are reversed on appeal to the Federal Circuit.²²³ Enablement decisions by the court would achieve no greater uniformity.

Any of these reasons alone might be sufficient justification for classifying enablement as an issue to be decided by the jury. In combination, it is evident that if enablement is analyzed under the test that was utilized in *Markman II*, it becomes a pure factual question. Labeling enablement as a question of fact would be more consistent with Federal Circuit precedent and with the court's rulings on related patent issues. The Federal Circuit must attempt to apply the Supreme Court's *Markman II* test and try enablement issues solely to a jury.

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221. *See supra* Part VI.A.4.

222. *See supra* Part VI.A.4.

223. *See supra* Part VI.A.4.

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