OFFICIAL TRANSCRIPT

PROCEEDINGS BEFORE

THE SUPREME COURT

OF THE

UNITED STATES

CAPTION: HERBERT MARKMAN AND POSITEK, INC.,
Petitioners v. WESTVIEW INSTRUMENTS, INC.
AND ALTHON ENTERPRISES, INC.

CASE NO: No. 95-26

PLACE: Washington, D.C.

DATE: Monday, January 8, 1996

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IN THE SUPREME COURT OF THE UNITED STATES

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HERBERT MARKMAN AND :

POSITEK, INC., :

Petitioners :

v. : No. 95-26

WESTVIEW INSTRUMENTS, INC. :

AND ALTHON ENTERPRISES, INC. :

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Washington, D.C.

Monday, January 8, 1996

The above-entitled matter came on for oral argument before the Supreme Court of the United States at 10:54 a.m.

APPEARANCES:

WILLIAM B. MALLIN, ESQ., Pittsburgh, Pennsylvania; on behalf of the Petitioners.

FRANK H. GRIFFIN, III, ESQ., Philadelphia, Pennsylvania; on behalf of the Respondents.

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P R O C E E D I N G S

(10:54 a.m.)

CHIEF JUSTICE REHNQUIST: We'll hear argument next in No. 95-26, Herbert Markman and Positek v. Westview Instruments, Inc.

Mr. Mallin, you may proceed whenever you're ready.

ORAL ARGUMENT OF WILLIAM B. MALLIN

ON BEHALF OF THE PETITIONERS

MR. MALLIN: Mr. Chief Justice, may it please the Court:

This is a constitutional case. It concerns the Seventh Amendment guarantee of the right to jury trial on infringement issues in patent infringement actions for damages.

It is established that the Seventh Amendment guarantees the constitutional right to jury trial in civil cases as it existed in 1791 in England. Accordingly, we submit that it is decisive here that in England in 1791 the meaning of the terms of patents, the meaning of patent specifications were submitted to the jury.

Consistent with that common law practice, that became the early understanding in the United States and that early understanding was confirmed as the years passed by outstanding judges noted for their efforts in the

patent area, such as Justice Thurey in the mid-19th century and Judge Learned Hand in the mid-20th century.

QUESTION: I had a little trouble finding that confirmation that you seem to have found. I mean, Judge Hand's opinion seemed ambiguous and it also certainly says that in the part that favors you, that it's a question of fact.

MR. MALLIN: Yes.

QUESTION: All right. So, where does that get us?

MR. MALLIN: It -- Judge Hand indicates that the issue is a question of fact.

QUESTION: I have no doubt about that, but where does -- the question of how people in a particular industry see a particular word and interpret it is a linguistic question. It is a factual question as to how they interpret it.

MR. MALLIN: Yes.

QUESTION: That's true, but where does that get us?

MR. MALLIN: That gets us under the Seventh Amendment.

QUESTION: Why? There are dozens and dozens of things -- we just heard a case where there were all kinds of facts which judges decide. There are many, many facts

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that judges decide. We write about segregation. We write about integration. We write about gerrymandering. We write about dozens and dozens of things. We write about antitrust laws which have to do with theories of economics. There are thousands and thousands of facts that judges decide in interpreting statutes and rules of evidence in preliminary matters. Why is this the kind of question of fact that the Seventh Amendment requires to go to a jury?

MR. MALLIN: For two reasons. Because of the common law practice and also --

QUESTION: What is the -- fine. I'm trying to get you to discuss this because I read many of those, not all of the cases, and I couldn't find something that was directly on point, not even Learned Hand, because the earlier part of the opinion you're thinking of seems to go just the other way and the part that you're thinking of seemed to have involved a factual matter that had to do with the word saturation, which they agreed about the meaning of.

MR. MALLIN: Under the understanding -- under the jurisprudence of the Seventh Amendment under decisions of this case, factual issues on the merits of a claim are for the jury. In the case --

QUESTION: I know that's the conclusion. I'm

saying what would you say is the strongest case in your favor in respect to the factual question as to how the industry understands the meaning of a term in a patent application, a term that will give the person who holds it a monopoly under the law to exclude competitors. Now, that's the precise thing. What your opponents say is there is nothing that favors you on that precise point.

MR. MALLIN: On that precise point, we go back to the common law practice where in Liardet v. Johnson, Awkwright v. Nightingale, and other cases at common law the meaning of patent terms were submitted to the jury. Those particular cases involved validity issues.

But it is -- was understood at common law and it is understood in law today that the patent means the same thing for infringement as it does for validity. It wouldn't make any sense otherwise. A patent can't mean one thing at one stage of the trial and another thing at another stage of the trial.

QUESTION: But your opponents argue, if I understand it, that there is an issue today, the issue in this case, that was not a jury issue, in fact was not understood as an independent issue at the time that you refer to as your standard of practice, and that was there was not the modern notion of patent claim, and therefore there was not an issue of construing a patent claim.

Your opponents say that the two kinds of issues that the old juries considered were issues of enablement and I guess issues of just design identity.

MR. MALLIN: Yes, whether there was sufficient disclosure --

QUESTION: Right.

MR. MALLIN: -- whether it was an advancement of novelty in a prior art, and those kind of issues were left to the jury which necessarily involved the jury interpreting what the specifications mean in order to decide whether --

QUESTION: But they say the specifications that you're talking about are simply different kinds of statements from the statement of claim.

And you say in your reply brief, well, the word claim was not used in the 18th and early 19th century as it is used today, but that issue was still there. And I -- you may be right on that, but I just I guess couldn't follow you to your conclusion. How do we know the issue was there?

MR. MALLIN: Yes. First of all, at common law it had a specification that described the invention. It was required at common law that the --

QUESTION: Was that a physical description of the invention?

MR. MALLIN: Yes. A description by words.

QUESTION: You know, this is a box and it has a crank and a door --

MR. MALLIN: And so on --

QUESTION: -- and so on.

MR. MALLIN: -- the way you see in patents.

QUESTION: Okay. And that's something quite different from what we're talking about in the modern sense of claim I take it.

MR. MALLIN: No, I don't think it is.

QUESTION: Okay.

MR. MALLIN: And let me explain.

First, at common law it was necessary that the specifications distinctly enclose what -- disclose what the invention was, the disclosure part of it. Early cases showed that patents in the early part of this century would often end with the words I claim as a way of making it clear as to what the claim was. Eventually in the --

QUESTION: What words did you say they ended with?

MR. MALLIN: Pardon?

QUESTION: What words did you say that they ended with?

MR. MALLIN: I claim.

QUESTION: I claim.

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MR. MALLIN: I claim.

Eventually the statute in 1836 specifically referred to the word claim.

The statute of 1870 had a specific requirement, that is the modern patent practice, that the specification end with the word I claim and then set forth the invention. It was always required to set forth the invention. This is just a particular way in modern practice that you set it forth, and the claim in modern practice is interpreted in light of the specifications. It would be rare for the specification not to include a term that's in the claim.

So, our position, Justice Souter, is that that formal distinction, that rearranging which does not go to the substance of the matter cannot undermine precedent at common law that -- where judges, Lord Mansfield in particular, the name of the judge at common law, submitted the interpretation of the specification to the jury. The formal differences in claim practices cannot eliminate the Seventh Amendment right.

QUESTION: So, the specification of the early cases includes the claim as we understand it today. That's -- is that in a nutshell your position?

MR. MALLIN: Yes. There's no substantive difference and the formalities were not significantly

different --

QUESTION: Well, I take it the specification --

MR. MALLIN: -- but it has no impact --

QUESTION: I'm sorry.

MR. MALLIN: And it has no impact on Seventh Amendment rights. Otherwise, it would be easy to get rid of the Seventh Amendment in any case.

QUESTION: But, Mr. Mallin, you agree I think that the scope of the claim, the construction of the claim is a question of law for the court, but you are distinguishing interpretation of a term from the ultimate question.

Well, why don't those two go together? That is, if the court is charged with making the ultimate determination of the scope of what's encompassed within the claim, then why shouldn't subsidiary matters on the way to that ultimate determination also be made by the court?

MR. MALLIN: Justice Ginsburg, because of the Seventh Amendment. The standard formula that we often hear is that the construction of the claim, the construction of the patent is an ultimate question of law, but until recently it was also said the underlying factual disputes are for the fact finder, a judge when it's a case for the judge or a jury case.

QUESTION: Well, Mr. Mallin, I'm thinking of this kind of question. You were careful to say on the merits, if it's a question on the merits.

MR. MALLIN: Yes.

QUESTION: But in threshold questions, for example, jurisdictional questions like diversity of citizenship -- there's a dispute about where one of the parties resides -- that's -- and it's a fact question. It's a fact question. But the question of is the jurisdictional requirement met is a question for the court, and so we don't have the jury hearing the evidence. There may well be evidence on that question, but it's determined by the court, right, even though it's a fact question.

MR. MALLIN: It's determined by the court and it was determined by the court, as far as I understand, at common law.

I think the judge's decisions on the facts on jurisdiction would be appealable under the clearly erroneous rule.

It's not -- the effort here, Your Honor, is to say this matter of what the claim means is a legal question that -- it's not a factual question at all.

QUESTION: Would it be a legal question if you didn't have any testimony, if all you had was the claim,

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the specification, and the prosecution history?

MR. MALLIN: It's a matter, I think, of terminology there, Justice Ginsburg. I don't think it's a legal question. It was still a factual question.

But judges in all kinds of civil cases take disputes away from the jury as a matter of law because there's no factual support for it, petitioners' particular contention. The judge has that gatekeeper's role in jury cases in that sense, and saying that something doesn't go to the jury because the judge decides it as a matter of law doesn't change the issue from fact to a legal question, it simply says does not --

QUESTION: Suppose the judge looks at that material and says I can see that there's an argument the other way, but this is enough for me. I think that the term means X based on the documentary evidence, and I don't want to hear -- I know the parties are going get -- each one will get an expert and that's not going to help me.

MR. MALLIN: I -- like any factual question in a civil jury case, if the judge is able to determine that it is clear on the face of the documents and there is no genuine dispute of fact, then the judge can determine that question as a matter of law in the sense I indicated --

QUESTION: Well, some of the dissenters in this

very case thought that was the situation here, didn't they?

MR. MALLIN: No. The judge in these cases -- the trial judge first held that this was a legal question, exclusively for the judge in every case.

QUESTION: Wasn't there one or more dissents written or separate opinions written at the appellate court level? Maybe a concurring opinion.

MR. MALLIN: Yes, there was a short concurring opinion where a concurring judge indicated that he didn't think there was sufficient evidence to support our position.

QUESTION: Right.

MR. MALLIN: But that isn't what the majority did. The majority said that the question was a legal question in every case --

QUESTION: And here the question is --

MR. MALLIN: -- exclusively for judges.

QUESTION: The question is whether the inventory referred to the articles of clothing?

MR. MALLIN: Yes.

QUESTION: I mean, it boils down to that.

MR. MALLIN: The particular question in the case was whether the word inventory used in the claim in the specifications was limited only to article of clothing or

could cover a dollar inventory reflected by invoices and dollars associated with the invoices.

QUESTION: Supposing this -- the word inventory appeared in a contract and there was no evidence aliunde, as they say, no evidence of intent, do you think that a judge could interpret that as a -- without submitting it to the jury even though it was quite debatable on either side as to what it meant?

MR. MALLIN: Well, it depends on the particular circumstances, but if the issue is what does the word inventory mean in the particular industry that's involved in a contract, Professor Corbin and Professor Williston would say yes. That meaning of language is a factual question in a jury trial --

QUESTION: So, then if you have a contract that uses the word inventory and there's no testimony as to what people meant, it's simply a documented, written kind of -- that is a factual question that would go to the jury?

MR. MALLIN: Well, in order for it to be a factual question to go to the jury, someone must offer evidence on it as to its meaning to the industry involved.

QUESTION: Well, okay. Supposing that I am -- that we have this contract with the word inventory in it and someone comes in and says, I offer X who will testify

what the parties meant when they used the word inventory in the contract.

MR. MALLIN: No. Your Honor, I would suggest that the analogy is in the particular contract, if this is the relevant question, what does inventory mean in a particular industry or to one skilled in that.

And the patent analogy to contract is made sometimes, but we have to remember what a patent and its term is talking about. In a patent case, the question is what the term means to one skilled in the art. That is a factual question of what it means to one skilled in the art. If there's no real factual dispute, like any other case the judge can decide it, but if there's factual evidence --

QUESTION: But ordinarily I understood the law to be that the terms of a written contract are interpreted as a matter of law. It isn't a question of fact.

MR. MALLIN: Williston and Corbin, as we cite in our brief, in some cases make the distinction that is similar to the distinction in patent law, that the construction of the patent -- of the contract in your hypothetical is for the court, its legal effect, but if there's a question about the meaning of language, that's a factual dispute to be resolved as a factual matter.

QUESTION: Suppose that a statute used the word

inventory, say, in an income tax refund case tried before a jury. Would the meaning of the term inventory in the statute be for the court, would it not?

MR. MALLIN: The interpretation of statutes as a matter -- as a legal matter is for the court.

QUESTION: So, do you think it's an appropriate way for us to begin looking at this case to ask whether or not the patent is more like a statute or a contract? That's what the briefs discussed. Do you think that's an appropriate way for us to --

MR. MALLIN: I think that that's a --

QUESTION: -- look at this case?

MR. MALLIN: -- very collateral way because of the direct authority from the common law --

QUESTION: Well, if we find that -- if we disagree with you on how persuasive and clear that direct authority is, then do you think that we can legitimately decide this case by asking whether or not the patent is more like a contract on one hand or a statute on the other?

MR. MALLIN: That would be a factor, and on that issue, Justice Kennedy, I would respectfully suggest that a patent is not like a statute. It's not analogous to a statute. Of course, it's not a statute. A patent is not a publicly piece -- a publicly enacted piece of

legislation from the political process.

QUESTION: Well, but it does seem to me more like a statute than a contract in this respect. There is an interest. Maybe you'll disagree, but I should think there is an interest in a uniform interpretation of the meaning of a particular patent, just as there is with a statute.

And it seems to me that if the interpretation of the patent is a question for the court, a question of law, or at least a question of interpretation makes a question of law in fact -- there may be even evidence on the point -- that it's a question properly reserved to the court in order to have uniformity in its interpretation.

MR. MALLIN: I think to assert the uniformity is misdirected and contrary to the Seventh Amendment.

QUESTION: It's not important to have uniformity in the patent, the construction of a particular patent?

MR. MALLIN: It would be nice to have it, but it's the practicality of it. It's agreed by everybody, including the majority, that in order to interpret the terms of a patent to one skilled in the art, that it's appropriate to take evidence, and whether the judge is deciding that or the jury is deciding it, the evidence has to be looked at.

QUESTION: Well, I would have thought that under

a patent scheme where the applicant for a patent has to set forth very clearly what's covered and how it can be made so that everyone is put on notice of what is patented and what is claimed and how it can be produced. And I would think the Patent Office wouldn't want to accept something about which there might be wildly different views of what's claimed.

I mean, the whole scheme seems to me one that is designed to make it as clear and simple as possible to put people on notice, and what you are arguing seems to be at some divergence of that approach.

Would there be many cases today where the question of the meaning of a term in the patent would have to go to a jury?

MR. MALLIN: I really don't know quantitatively whether there would be many, but there are many cases in the books and it's settled law at the Federal circuit level that in order to interpret the patent, that it is appropriate to look at what they call extrinsic evidence: what happened before the Patent Office, what expert testified, the state of the prior art.

QUESTION: It seems like most of the cases you rely on resulted in some kind of general verdict where the patent ends up having to be compared to something quite different, and it's hard to tell from those cases whether

there's this separate factual issue on the meaning --

MR. MALLIN: It --

QUESTION: -- of the patent construction.

MR. MALLIN: Pardon me.

It seems to me that they're intertwined together and you cannot separate the one from the other.

I would like to return to the statute analogy. I think it is very important to understand that in 200 years of litigation over patents in this country and at the common law, as far as we can find or has been cited, the analogy to a statute has never been used before this case before it was --

QUESTION: What about the analogy in one of the briefs to patents for land and also scope of copyright? This is in the Surgical Corporation brief. It gave those two analogies as being perhaps closer.

MR. MALLIN: I think a copyright is far different than a patent. A patent is not a land grant. I have difficulty going off to the analogies when we have clear Seventh Amendment rules and we have the English common law practice that has been cited.

QUESTION: If -- the reason -- I don't find them determinative yet. That is to say, if they're not determinative, then -- and I'm assuming they're not -- what is the right analogy?

There are so many instances where judges do take evidence, where they do decide factual matters which don't have to go to a jury, and that's why I'm looking for the analogy. What about agency rules where technical terms are used, where what you want, if you're a judge reviewing that agency rule, is you want to know what the agency really had in mind? You might want to refer to the industry. It might come in in a tort case, for example, you see, a jury case, and I would be surprised if you had to leave up to the jury the determination of interpreting the agency rule that used a technical term.

I mean, maybe it's such a good analogy that it has never come up and therefore it's a bad analogy.

MR. MALLIN: I don't know that it has.

QUESTION: But do you see --

MR. MALLIN: I --

QUESTION: Here you have your jury and the agency is up there talking about dioxin, SO4, ishkabibble, whatever, something very, very hard to understand, and the agency interpretation is relevant. And the parties say to the judge, judge, will you instruct the jury as to what that agency rule means? I don't think you'd have to have the jury decide it even though you might take evidence on it.

MR. MALLIN: It would have to be looked at, the

common law action to which the Seventh Amendment attached.

QUESTION: Well, it's a tort action.

MR. MALLIN: It's a tort action.

QUESTION: But I don't think they'd ever say that the jury has to decide the meaning of a statute, and by that I would say the jury would never have to decide the meaning of an agency rule even though it could use technical terms on which experts could differ.

MR. MALLIN: And we're not here contending that juries ought to decide meanings of statutes.

QUESTION: Or agency rules. And now what about patents? Where it is --

MR. MALLIN: Patents we say, on the authority that we cite, that when there's a genuine dispute -- and the analogy that has been referred to at common law and by this Court has been an analogy to contracts not statute.

Take a malpractice case where the issue is what a medical term means to physicians. I would suggest to you that under the Seventh Amendment jurisprudence, the question of what that medical term means to physicians would go to the jury.

QUESTION: But that's a tort action. You're not talking about some sort of a relatively integrated written instrument which I think in different branches of the law has been treated differently than just ordinary oral

testimony.

MR. MALLIN: In the malpractice case, my hypothetical could include wherever that medical term happened to be used. It might be in the complete instrument or not.

QUESTION: What about a question of foreign law which, as I understand it, judges decide as an issue of law even though they hear expert testimony from those skilled in what the foreign law might be?

MR. MALLIN: Yes. The rule seems to be there that the material, the legal material, is proved as a fact and then the judges look at the statute --

QUESTION: But we don't submit that to the jury, do we?

MR. MALLIN: No.

QUESTION: No.

MR. MALLIN: You do not. That -- according to the new Federal rules that have been changed. And I don't know that that has ever been dealt with --

QUESTION: But we never did --

MR. MALLIN: -- as a constitutional --

QUESTION: -- submit it to the jury, did we?

MR. MALLIN: I would like to --

QUESTION: It's not proved as a fact. It's just that oral testimony is heard. Experts say what they think

the foreign law means. It doesn't change -- the fact that there's evidence, that there's testimony doesn't determine whether something is a question of fact or law.

MR. MALLIN: Your Honor, in that situation it's clear it's foreign law, and that is a legal point.

But this Court in the validity area, for example, has made it clear that the way you look to see that something is factual when you're looking at determinations based upon weighing evidence, persuasiveness, and credibility, those are factual issues. And in the validity context, the ultimate question of validity is a question of law, but nonetheless, the underlying factual issues like the state of the art that go to the determination of non-obviousness are submitted to the jury or the fact finder.

QUESTION: How many English cases do you have supporting this? Because, you know, I'm a little skeptical of the certainty, or perhaps indeed even the existence, of the English law. As you know, one of the amicus says from 1750 to 1791 -- 99, there were only 18 patent decisions at common law in England. There was no coherent body of English patent law to be known by the enactors of the Seventh Amendment. How many English cases do you rely on?

MR. MALLIN: Well, reported cases that we rely

upon are one, two, three, four, five, six, if I count them --

QUESTION: Six. And how many of them involve the definiteness issue rather than the nature of the claim?

MR. MALLIN: I can't just --

QUESTION: Some of them anyway. Some of them anyway, maybe most of them.

MR. MALLIN: -- novelty issue, some whether there was an adequate disclosure so that one skilled in the art could make the machine.

I'd like to reserve the rest of my time for rebuttal.

QUESTION: Very well, Mr. Mallin.

Mr. Griffin, we'll hear from you.

ORAL ARGUMENT OF FRANK H. GRIFFIN, III

ON BEHALF OF THE RESPONDENTS

MR. GRIFFIN: Mr. Chief Justice, and may it please the Court:

Contrary to the petitioners' position, Seventh Amendment policy, precedent, and reason support the conclusion which was reached by the Federal circuit in this case that in a patent infringement action tried to a jury, it is the province of the court to determine the meaning of the words used in the claim language as a

matter of law.

QUESTION: Do we have to decide this case on as global a basis as the Federal circuit decided to say that it's always thus or it's never thus?

MR. GRIFFIN: No, Mr. Chief Justice, because in this case there was no question about the meaning of the language in the patent -- no real question about the meaning of the language used in the patent. And that was the conclusion by the trial judge, by the eight judges writing in the majority, by the two judges concurring, and Judge Newman who dissented did not disagree with the interpretation of the patent.

QUESTION: But if that were going to be our basis for decision, we wouldn't be deciding very much, would we? Because we would simply be saying that in a patent case, as in any other case, if there is no dispute of fact as to which there could be reasonable disagreement as a matter of law, the court must declare the conclusion. And that wouldn't really decide very much, would it?

MR. GRIFFIN: That is correct, Your Honor.

QUESTION: So, if we don't decide on that extremely narrow ground, do we have to decide as globally as the circuit did?

MR. GRIFFIN: No, you don't because I think it is taking it -- looking at the interpretation of the

claim. One here could conclude that there was just no substantial evidence to support the jury verdict below, but if you go --

QUESTION: No. If you're to decide something broader than that, can we decide it on a basis less globally than -- less global than the basis that the circuit employed?

MR. GRIFFIN: I don't --

QUESTION: I understood your argument to be -- I understood you to be arguing two things in your brief. Let me put it this way.

One was that as a matter of law, no reasonable jury could come to any other conclusion anyway. That's the narrow ground.

I also understood you to be arguing that even if there were factual disputes, evidentiary questions, as to which reasonable jury or reasonable fact finders might come to differing conclusions, it was still an issue for the court.

MR. GRIFFIN: That is correct.

QUESTION: The latter is your position, isn't it?

MR. GRIFFIN: That's correct.

QUESTION: And that's the global position.

MR. GRIFFIN: That's the global position.

QUESTION: So, if we're not going to decide this as simply a case about the particular evidence going to this dry cleaning patent, then your position is we do have to decide it as globally as the circuit did.

MR. GRIFFIN: Yes, sir.

QUESTION: Is that -- suppose I thought this hypothetically. This is -- do you remember the Learned Hand case? Are you pretty familiar with that?

MR. GRIFFIN: I'm not completely familiar with it, but I understand it.

QUESTION: All right. At the end of -- suppose I thought this. In the end of the opinion, they're talking about the word saturation, and they say it means that after a certain point there won't be a lot of variation in electrons. Then the question is, what's that point? And they call in some experts, and they say plus or minus 6 percent. That's a question of fact? He says, that's right.

At the beginning of the opinion, he's talking about the length of a beam. Do the words in this document mean you have a long beam, or does it mean long in relation to the width? Now, he says there, assuming experts would say it meant the latter, I still think it means the former. You see? All right.

Suppose you thought, as a result of that,

sometimes you should send it to a jury and sometimes you shouldn't, and let's leave it up to the judges to decide because they understand electron saturation and things 50 times better than I do after they have heard 4 days of testimony on it. Suppose that was your belief of what the law should be.

Now, how would you get there in this case?

MR. GRIFFIN: If that were my belief as to what the law would be, I would get there in this case by exactly the same route that the district judge did here.

QUESTION: The circuit seems to say it's never a question for the jury. It's always a question for the judge. So, if you thought sometimes it should be the one, sometimes it should be the other, and the district -- how would you get there?

MR. GRIFFIN: It's difficult for me to consider because I -- that's not my view of what the law is or ought to be, and it's a tough question for me to stand here and come up with an answer for you because I think that under this Court's decisions and under a proper Seventh Amendment analysis, this issue of what is the meaning of words, what's the definition of a term is a question of law for the court. And it is in all instances, even when the court has to go outside of the patent documents to get information about the meaning of

the term.

QUESTION: Mr. Griffin, do I understand correctly that the division in the Federal circuit -- they took this case en banc because they were internally divided.

MR. GRIFFIN: That's what I understand, Your Honor.

QUESTION: And one took the position that it's always for the jury, and one took the position that it's always for the court. But I didn't see in the division within the circuit anything in between.

MR. GRIFFIN: I did not see anything in between either, Your Honor.

QUESTION: No discretion left to the district judge. At least of the division within the Federal circuit panels, Judge Newman would leave it to the jury in all cases and Judge Archer, Chief Judge Archer, in none.

MR. GRIFFIN: In none, and it would appear that the concurring judges would in some instances.

It's very difficult to say. When I -- when the case was before the Federal circuit, one of the issues and one of the questions was, can you think of any time when there would be an underlying fact issue which would be appropriate to go to the jury? And I could not think of one. And as -- and I tried to think of one today and I

can't think of one because a patent is a -- a patent claim is by statute required to be definite. The patent claim is in context of the specification and the prosecution history.

QUESTION: Then why do you ever hear evidence about it?

MR. GRIFFIN: Because sometimes, Your Honor, the court needs to go outside of those documents to learn about the meaning of terms. But when the court does that, it's hearing that information in the context of what the claim says and in the context of the specification and the prosecution history, and it is learning yet how the words are used.

QUESTION: Well, why couldn't a fairly narrow instruction be submitted to the jury as to which of the -- if there are two experts, as to which of the two experts you credit?

MR. GRIFFIN: I don't think it should get down to that, Your Honor, and I don't believe that it does get down to that because the question isn't one which is a typical issue of credibility of experts on the stand. It's not a question where you're judging --

QUESTION: Well, suppose in a particular case it is. Supposing the judge says to himself, I know both these experts are qualified, but I think B is making up

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his story. Had it been submitted to the jury, it would have been just the opposite; the jury thought A was making up his story. Now, why should the judge's view prevail over the jury on a question of credibility like that?

MR. GRIFFIN: If there were such an instance, that would be a difficult question, sir, but I don't believe that when you look at the meaning of the term within the context of the patent, the claim, the prosecution history, and the information that's received, that you will get to a point where credibility determinations are going to be what a word means to a specific --

QUESTION: You know, they say figures don't lie, but liars do figure, and occasionally you do get experts whose credibility may be in doubt.

MR. GRIFFIN: I think that that is something that happens quite often.

QUESTION: Why shouldn't a question like that go to the jury?

MR. GRIFFIN: Because the issue is not -- is one which is peculiarly for the judge. It's not going to be an issue of credibility as far as the in-court testimony goes. It's going to be the question of the logic of the testimony and the information --

QUESTION: But why shouldn't it be a question of

credibility of in-court testimony if the finder of fact, whether it's a judge or a jury, decides that one of the experts is simply lying?

MR. GRIFFIN: That would be the same instance in a question of foreign law, sir, if there was one expert who was telling the court that the law of France meant one thing and another saying it meant the other.

QUESTION: So, you see this as simply taken out of the normal factual review by a jury. It's the same sort of issue as foreign law or jurisdiction, diversity.

MR. GRIFFIN: Yes, sir.

QUESTION: Mr. Griffin, I was surprised to hear you say that, you know, there were really significant -- didn't you say earlier if there were a significant credibility problem, it would go to the jury?

MR. GRIFFIN: I said -- I was asked to assume that there might be. I cannot believe that there can be a situation, Your Honor, when there can be a significant -- in defining the terms used in a patent claim, as they are framed within the patent claim itself, illuminated by the specification, illustrated by the prosecution history, that credibility determinations among experts are going to determine what a term means to a relatively skilled community.

QUESTION: You -- so -- but were that the case,

you'd be willing to entertain the notion that a jury would decide it.

MR. GRIFFIN: No. I don't think it was necessary for a jury to decide that.

QUESTION: I thought that was your position, and I thought one of the reasons you said it has to be left to the judge is that if you leave it to a jury, you can get divergent results as to the meaning of one patent all around the country and no court would be able to reverse it because it could be a reasonable determination either way, and so you would have to affirm the jury finding.

MR. GRIFFIN: That's correct.

QUESTION: And you have a patent that has different meanings throughout the country.

MR. GRIFFIN: Well, you would end up with a patent --

QUESTION: Whereas if the judge decides it, ultimately if it's a question of law for the judge, it can be established as the rule nationwide.

MR. GRIFFIN: Be established as a rule and would be reviewed de novo, and that is --

QUESTION: Well, that is a very important factor it seems to me.

MR. GRIFFIN: That is a policy reason -- very much, sir. It's a policy reason why this ought to be a

matter of law for the court.

QUESTION: What other cases are there in which you have experts with conflicting opinions called by both parties where the judge makes the decision? The case is a difficult one because we're searching for analogies.

MR. GRIFFIN: Well, the best --

QUESTION: In the malpractice case, I think we all would agree that it goes to the jury.

MR. GRIFFIN: The best analogies that I can think of -- and I don't believe that analogies really control in Seventh Amendment analysis, Justice. The best analogies I can think of are foreign law --

QUESTION: Which often can turn on credibility because the judge may not be able to read the language of the law. So, he is informed by what each expert says and may make the judgment on the basis of demeanor, but that doesn't change the issue from one of law to one of fact.

MR. GRIFFIN: That's correct, Justice Ginsburg.

I can also think of determination of the meaning of agency regulations, which was referred to earlier --

QUESTION: Well, let's put it this way. If you were to prevail, then in the patent area we would have more expert testimony being considered by the judge than in any other case that we know.

MR. GRIFFIN: That is, Justice, if those who

draft patents don't comply with the requirements of section 112 to make them definite and to define the terms which they use.

QUESTION: Can you give me some idea of how often conflicting expert testimony is presented in a patent case on the issue of the meaning of the patent?

MR. GRIFFIN: I cannot from my own experience, although I can tell you from the suggestions that have been made by the petitioner that it is an issue in virtually every case.

QUESTION: That's what I would have thought.

MR. GRIFFIN: The --

QUESTION: So, your -- I want to make sure I understand your argument. I understood your reply to Justice Scalia in effect to be it should be an issue of law for the court because that's the only way we're going to get national uniformity.

MR. GRIFFIN: Well, it should be an issue --

QUESTION: Is that a fair summary of what you said?

MR. GRIFFIN: That's one of the reasons why it should be an issue.

QUESTION: All right.

Now, there was -- at one point in your brief -- and in fact a couple of times this morning -- I thought

you were making a different argument, and that is the very fact that patent specifications must be made or ideally should be made in unambiguous terms somehow means or results that you don't have the problems of construction in patent documents that you may have in contract documents. Patent documents are somehow less likely to be ambiguous, less likely to be messy, and for that reason it makes sense to say there should be no jury questions in their construction.

I'll be candid to say that I didn't understand why that should be so, but I thought at one point you were arguing that. Do you argue that?

MR. GRIFFIN: We argue that the distinction between patents and contracts is that the patent document is required by statute to be definite.

QUESTION: Well, it's supposed to be.

MR. GRIFFIN: It's supposed to.

QUESTION: You know, statutes are supposed to be definite too, and they're frequently not.

The fact that it -- in an ideal world the patent documents would not be in any way ambiguous doesn't seem to me to address the question in the real world that we've got, and that is, how do you determine what they mean when you can't figure it out?

MR. GRIFFIN: The real world question of how do

you determine what they mean when you can't figure it out is exactly what the patent statute is supposed to guard against, which is that it should be a definite claim, that it should be concise, that it should enable one skilled in the art to understand the metes and bounds of the invention so the public can stay away from that monopoly if the public chooses or the public can license that --

QUESTION: Well, I understand that, but we get into court because there is a dispute about what a phrase means or a sentence means or a word means, or at least there is a claim of a dispute about that. And when there is such a claim, why is it the case that patent documents are somehow different from contract documents or more like statutory documents?

MR. GRIFFIN: Because a contract -- with a contract, the question is the subjective intent of the parties, and with a patent document, we're not dealing with a question of subjective intent. We're dealing with the objective --

QUESTION: Isn't the claim a matter of subjective intent?

MR. GRIFFIN: Not as far as the public is concerned. The public has --

QUESTION: Are you saying because it's the PTO's job before it accepts the statement? At least you have a

Government officer whose job it is to see that the claim is as definite as it's supposed to be. Now, that Government officer can err and, as you said, often does because you said this question comes up in almost every case.

MR. GRIFFIN: Yes. If it becomes a question of definiteness, Justice Ginsburg, that is a question of law for the court.

QUESTION: So, it seems to me that your second reason, if you will, is basically a variant on the first reason. Your second -- if I understand what you're saying now, you're saying, look, patent documents are supposed to be written in a way that would not raise questions of subjective intent, that would be perfectly clear to people who read them, and so on.

And because that's the way they're supposed to be written, we should not treat them as if they were written in other ways, e.g., to involve questions of subjective intent.

And, therefore, in order to get the definiteness that patent law requires, we must treat this as a matter of law for judges only so that we can ultimately get uniformity. Is that correct?

MR. GRIFFIN: That is correct.

QUESTION: In other words, your -- so, your

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first argument for uniformity is buttressed by, in effect, what you say is the intent of the patent statute and that is to provide some uniformity. And this is the only way you can get it, and this is, therefore, the only way you ought to read the statute.

MR. GRIFFIN: That is correct.

QUESTION: Yes, okay.

QUESTION: But that's somewhat contrary to the intuition one would get from the fact that apparently it's agreed that expert witnesses are necessary in almost every patent case.

MR. GRIFFIN: I think that is a result of patent practice, Mr. Chief Justice, and I don't think it should be the practice.

QUESTION: How do you distinguish the questions of non-obviousness, enablement? Are those also questions for the court rather than for the jury?

MR. GRIFFIN: If I can recall the question of -- non-obviousness I believe is a question -- my mind is -- I don't know the answers.

QUESTION: Because that's -- one of the concerns is if you could narrow what the Federal circuit has done to the question of how do you read a term of the fact -- of the claim when the overall scope of the claim is for the court, that's one thing. It perhaps could be

isolated, but then there are other questions of a similar nature, are there not?

MR. GRIFFIN: If we got to a question of what is the patent anticipated by prior art, that would be a question of fact. If -- there are questions of fact where what the focus is --

QUESTION: But if the question is what does the term mean to someone ordinarily skilled in the art, okay, why shouldn't the obviousness question go the same way? Would this invention be non-obvious to a person ordinarily skilled?

MR. GRIFFIN: The issue would be what does the patent claim mean, and then with the other evidence of obviousness it becomes a question then of what -- would it have been obvious to one skilled in the art.

What the Federal circuit did in this case was --

QUESTION: Excuse me. The one -- so, you're saying the one is a matter of claim construction. That's always a matter of law. The other isn't a matter of claim construction, so maybe that would be open to jury findings?

MR. GRIFFIN: That's correct.

QUESTION: However, if you do leave it open to jury findings, what happens to uniformity? The jury on

the west coast says, gee, it seems perfectly obvious to us. Why should he be protected? A jury on the east coast says quite the opposite. What happens to uniformity if you allow that exception?

Haven't you got to go the whole hog here and say all of the issues that go ultimately to the enforceability of the patent have got to be treated as issues of law because otherwise you lose your uniformity?

MR. GRIFFIN: If the only argument is the uniformity argument, that is correct.

QUESTION: But can you distinguish this question of what does the term in the claim mean from non-obviousness as one? Another one is enablement. Could a person skilled in the art look at this patent and build a machine?

MR. GRIFFIN: Well, enablement I believe today is treated as a question of law. It was at common law treated as a question of fact. So, I think --

QUESTION: What is the precedent that tells us that today it's treated as a question of law?

MR. GRIFFIN: I believe that that is the holding of the cases, and I don't have them with me --

QUESTION: How is that consistent with the Seventh Amendment?

QUESTION: How does the Seventh -- I think

Justice Kennedy and I are asking the same --

MR. GRIFFIN: That would get me back to the -- the Seventh Amendment analysis here, that is -- is one of whether -- we start with the proposition that this is a case which is tried to a jury, and so this Court's historic analysis and the cases, the so-called law equity cases, that the Court has dealt with in determining whether a jury trial itself is applicable is not necessarily determinative in a case where there is a jury trial of what issues will be eventually given to the jury and what issues will be reserved for the judge. It is an indication of how one might project things, but it does not fix -- this Court's precedent does not fix in time in 19 -- 1791 all of the incidents of the jury trial.

The Seventh Amendment requires that you preserve the essentials of it, which is that the jury decide those things which will be characterized as fact and that the -- also preserves the role of the judge to decide those things which are characterized as law and --

QUESTION: That sounds like a very strange interpretation of the Seventh Amendment to me. Are you saying that Congress could not confide more things to the jury as opposed to the judge than was done at common law in 1791?

MR. GRIFFIN: Congress could and Congress in the

patent setting could enact a statute which says that the -- all questions of patent infringement or validity are to be tried by an Article I court and that would not violate the Seventh Amendment.

QUESTION: Didn't the Seventh -- I mean, if you go back to the English practice, my impression in reading this -- but you know it better and will correct me -- is that questions like originality or non-obviousness, et cetera, were quite close if they weren't directly the kinds of things that they did leave to a jury.

MR. GRIFFIN: That's correct.

QUESTION: Is that right?

So, then the question would be if that's so, then they have to be left to a jury I guess for present purposes. Is that right?

MR. GRIFFIN: I do not believe so.

QUESTION: But is it the case that for you to win this case, we also have to decide the question of whether originality, et cetera, or non-obviousness is for a judge or a jury?

MR. GRIFFIN: No.

QUESTION: Why not?

MR. GRIFFIN: Because the issue that's presented in this case is the question of whether the interpretation of the meaning of the words used in the patent claim --

QUESTION: Yes.

MR. GRIFFIN: -- is appropriately --

QUESTION: And how do you distinguish it from all those other issues which probably were sent to the jury?

MR. GRIFFIN: Because, well, in the first instance the juries in common law England were not asked to interpret the words of a patent, and that was for practical reasons as well as legal reasons. Juries in common law England were often illiterate. The courts reserved to themselves the interpretation of the written word.

What juries were asked to do in common law England, to the extent that you can discern it from the few cases that there are, is to decide whether this specification was the appropriate recipe for how you made this particular type of stuff up or whether it was able to teach somebody how to make the widget, whatever it may be. And the testimony which was heard was not of anyone other than the artisan coming in and said I followed the recipe. I did --

QUESTION: So, what we'd like to find is someone who once went to an English judge in 1780 and said, judge, you're supposed to decide whether this document before you is non-obvious. To do that, you have to know two things:

what the document means and what the future world was like -- previous world was like. The second part is factual. The first part is purely legal. Judge, instruct the jury as to that first part. No one ever said that.

MR. GRIFFIN: I did not see anything like that.

QUESTION: Could you give a sensible reason why you would put these things on different sides of the line?

MR. GRIFFIN: No.

QUESTION: Wasn't that a major concern here that you've got something that is an action at law? A patent infringement is an action at law. And then you're going to take the issues one by one and take them away from the jury, and pretty soon you'll have nothing triable to a jury.

MR. GRIFFIN: I don't believe that that is a valid concern because the Federal circuit has taught us that there are a number of issues that are to be left to the jury. But what it does raise the ultimate question, which isn't in this case, is whether there is a Seventh Amendment right to a jury trial in a patent case, and that's the other issue and that's not here.

QUESTION: I thought that at least everybody in the Federal circuit agreed that there is. Now, if Congress wants to concoct some entirely other regime like it can make what were once tort cases into workers'

compensation cases, that's one thing.

MR. GRIFFIN: That's correct. And as long as Congress has provided that patent infringement actions for damages are to be tried to a jury and the statute provides for that, there is a role for the jury in patent cases from the determination of issues of damages, as the Hilton Davis case says in the question of equivalence. There are a number of issues which are appropriate for the jury.

And especially the jury deals with the ultimate question of infringement. Does the accused device invade the metes and bounds of the patent? That is the jury's ultimate job.

It's the court's job to tell the jury what the patent means, and this Court has said that on numerous occasions. It's the court's job to tell the jury what the patent means and in the infringement case it's the job of the jury to find out whether that accused devise invades that monopoly, whether the patent reads on the accused device. That is -- that's the essence and that's the jury trial which we are entitled to in patent cases.

QUESTION: Let me ask you another analogy question, and I should have done it before but I didn't think of it.

On the one hand, we've got the case of statutory construction, construction of agency regs, and so on. We

say that's always a matter of law. It never goes to the jury. The kind of -- the limits of meaning, the rules by which we find meaning, the process by which we look for, quote, evidence, unquote, of meaning, those are all things for -- that courts alone can do. Easy case.

At the other extreme, you've got the question of contract construction, and as you pointed out, one of the issues in contract construction may well be an issue of subjective intent. What did these people or one of them have in mind? So, that makes it a classic kind of evidentiary question.

And you said, well, here in a patent claim, we don't have an issue of subjective intent simply because the objects of stating patent claims rule out that as a legitimate consideration, and I will accept that.

But isn't -- and here is where I get to my question. Isn't it also the case that the terms that are supposed to be used in these claims are terms which have meaning within the art in question? So, therefore, the matter of meaning is something for which we can legitimately look outside the document. And isn't there a strong analogy between looking for the understanding of the art or the trade, something outside the document, and looking for the subjective intent of parties, which is also outside the document? The evidence bearing on them

may be different.

But isn't the fact finder engaging in essentially the same kind fact finding? In one case he's saying contracts, what did they specifically have in mind here? In the other case, he's saying, what does this whole body of people mean by this term? Isn't the analogy between those two questions a strong analogy?

MR. GRIFFIN: No. I think it's a very weak analogy, Justice, in my --

QUESTION: Would you explain that?

(Laughter.)

QUESTION: You may explain briefly.

MR. GRIFFIN: I think it is a weak analogy because the question of what a specific term used in a contract to the requisite community which is skilled in that is something which does not exist except for the patent documents themselves which frame the --

QUESTION: Yes, you wouldn't use the term if you weren't writing a patent.

MR. GRIFFIN: And it frames the inquiry. And when you are hearing outside the patent documents from somebody, you have the documents themselves which are written in an objectively directed fashion to judge what that meaning is.

The parties can mean anything that they wish

with their contracts as between only two sides, and the question of the subjective intent of the parties in a contract only gets decided by the jury in many jurisdictions if the judge concludes initially, after reviewing the contract, that he's not going to interpret it as a matter of law, or she's not going to interpret it as a matter of law --

QUESTION: Well --

MR. GRIFFIN: -- from the four corners.

QUESTION: Thank you, Mr. Griffin.

Mr. Mallin, you have 2 minutes remaining.

REBUTTAL ARGUMENT OF WILLIAM B. MALLIN

ON BEHALF OF THE PETITIONERS

MR. MALLIN: Quickly then.

The majority decided only the general issue. That's the reason Mr. Markman lost his infringement verdict. The court never reached the sufficiency of the evidence point. It's not up.

There are all kinds of validity issues where the jurisprudence of this Court is clear that the underlying facts go to the jury. And I don't have time to rattle them off, but it seems to me completely inconsistent with that that we would pick out this one term analysis which is very much the same and say it doesn't go to the jury.

And when you're dealing with credibility, it's

artificial to say that you're not finding facts. There have been Markman trials, so-called, after majority opinion. We cite some of them in our brief where they talk about the professor, how much he's getting paid, how much he's getting in royalties for himself, all the typical things about whether he's to be believed or not, and what those judges say about whether they're deciding credibility and whether the witness is believable or not.

And as Judge Mayer pointed out before, when you decide the meaning of the term in an infringement case, most of the time you've decided the infringement. The jury is essentially ejected out of the infringement analysis if they are not allowed to decide genuine issues of fact regarding the meaning of the term.

If the term is so vague that the patent ought to be invalid, that's another question.

QUESTION: Well, surely --

MR. MALLIN: It would be held invalid.

QUESTION: Surely there's a separate issue of whether there has been an infringement or not. I mean, there's not just the definition of the patent. There's also whether the competing instrument was an infringement. That's still left entirely to the jury, isn't it?

MR. MALLIN: That still could be the case but it's more theoretical than real. Once you know what the

term means -- there is the accused device sitting there -- you know whether it's common. And that's all that -- as judges on the Federal circuit --

QUESTION: It seems to me a big question. It seems to me a big question, indeed. I don't think there's nothing left for the jury.

MR. MALLIN: In most cases, I would suggest, Your Honor, that there is very little left.

QUESTION: That's just like saying the contracts case is over once the court tells the jury what the contract means, and thereafter there's nothing left. Of course, there's plenty left. The jury has to decide whether the contract was complied with or not.

MR. MALLIN: There's a lot more left in a contract case, Your Honor, but it isn't the same thing in a jury case where the term analysis, what does that cover? When that's determined, what is a genuine issue of fact, by the judge, there's really nothing significant left for the jury, as Judge Mayer pointed out.

CHIEF JUSTICE REHNQUIST: Thank you, Mr. Mallin.

The case is submitted.

(Whereupon, at 11:55 a.m., the case in the above-entitled matter was submitted.)

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CASE NO.: 95-26

and that these attached pages constitutes the original transcript of the proceedings for the records of the court.

BY: Ilona M. May
(REPORTER)