

116 S.Ct. 1384

Supreme Court of the United States

Herbert MARKMAN and Positek, Inc., Petitioners,

v.

WESTVIEW INSTRUMENTS,
INC. and Althon Enterprises, Inc.

No. 95–26. | Argued Jan. 8,
1996. | Decided April 23, 1996.

Holder of patent for inventory control method for use in dry cleaning business brought patent infringement action against competitor. The United States District Court for the Eastern District of Pennsylvania, Marvin Katz, J., entered judgment as matter of law for competitor, despite jury's finding of infringement. The Court of Appeals for the Federal Circuit, 52 F.3d 967, affirmed, ruling that interpretation of patent's claim terms was exclusive province of court. Certiorari was granted. The Supreme Court, Justice Souter, held that: (1) patent infringement actions descended from actions at law, such that Seventh Amendment required trial by jury; (2) common-law practice at time Seventh Amendment was adopted did not require interpretation of claims, or terms of art, by jury rather than judge; and (3) construction of patent, including terms of art within claim, was exclusively within province of court, in view of existing precedent, suitability of interpretation issues for determination by judge, and importance of uniformity in treatment of given patent.

Affirmed.

West Headnotes (14)

[1] **Patents**

🔑 Assertion of Claims

Patents

🔑 Specifications and Drawings; Written Description

Patent must describe exact scope of invention and its manufacture to secure to patentee all to which patentee is entitled, and to apprise public of what is still open to them; these objectives are served by both patent specification, which describes invention in such full, clear, concise, and exact terms as to enable any person skilled

in the art to make and use invention, and patent's claims, which particularly point out and distinctly claim subject matter which applicant regards as invention. 35 U.S.C.A. § 112.

537 Cases that cite this headnote

[2] **Patents**

🔑 Assertion of Claims

Patent claim defines scope of patent grant, and functions to forbid not only exact copies of invention, but products that go to heart of invention yet avoid literal language of claim by making noncritical change.

102 Cases that cite this headnote

[3] **Patents**

🔑 Language of claims in general

Patents

🔑 In general; comparison with patent claims

Victory in patent infringement suit requires finding that patent claim covers alleged infringer's product or process, which in turn necessitates determination of what words in claim mean. 35 U.S.C.A. § 271(a).

654 Cases that cite this headnote

[4] **Jury**

🔑 Nature of Cause of Action or Issue in General

Jury

🔑 Legal or Equitable Actions or Issues

Under "historical test" for determining right to jury trial under Seventh Amendment, court asks first whether it is dealing with cause of action that either was tried at law at time amendment was adopted or was at least analogous to action that was tried at law at that time; if action in question belongs in law category, court then asks whether particular trial decision must fall to jury in order to preserve substance of common-law right as it existed in 1791. U.S.C.A. Const.Amend. 7.

44 Cases that cite this headnote

[5] **Jury**

🔑 Legal or Equitable Actions or Issues

In determining whether party is entitled to jury trial under Seventh Amendment, statutory action is first compared to 18th-century actions brought in courts of England prior to merger of courts of law and equity. U.S.C.A. Const.Amend. 7.

14 Cases that cite this headnote

[6] **Jury**

🔑 Patent and copyright cases

Patents

🔑 In general; nature and grounds

Modern patent infringement action descended from infringement actions tried at law in 18th century; thus, Seventh Amendment requires that patent infringement cases today be tried to jury, as their predecessors were more than two centuries ago. U.S.C.A. Const.Amend. 7.

40 Cases that cite this headnote

[7] **Jury**

🔑 Nature of Cause of Action or Issue in General

Whether Seventh Amendment requires that particular issue in jury trial be determined by jury depends on whether jury must shoulder this responsibility as necessary to preserve substance of common-law right of trial by jury; only those incidents which are regarded as fundamental, as inherent in and of essence of system of trial by jury, are placed beyond reach of legislature. U.S.C.A. Const.Amend. 7.

20 Cases that cite this headnote

[8] **Jury**

🔑 Nature of Cause of Action or Issue in General

In evaluating substance of common-law right, for purpose of determining whether Seventh Amendment requires that particular issue in jury trial be determined by jury, court should use historical method, similar to characterizing suits and actions within which issue arises; where

there is no exact antecedent, best hope lies in comparing modern practice to earlier ones whose allocation to court or jury is known, seeking best analogy that can be drawn between old and new. U.S.C.A. Const.Amend. 7.

16 Cases that cite this headnote

[9] **Jury**

🔑 Patent and copyright cases

Seventh Amendment did not require that jury, rather than judge, construe claims in patent and, particularly, terms of art, as common-law practice at time Seventh Amendment was adopted did not support patentee's assertion that jury interpreted patent claims at that time; closest historical analogy was to construction of specifications for which there was no established jury practice, and judges, not jury, ordinarily construed written documents. U.S.C.A. Const.Amend. 7.

169 Cases that cite this headnote

[10] **Patents**

🔑 Questions of law or fact

Construction of patent, including terms of art within claim, is exclusively within province of court, not jury, in view of existing precedent, suitability of interpretation issues for determination by judge, and importance of uniformity in treatment of given patent.

1309 Cases that cite this headnote

[11] **Patents**

🔑 Questions of law or fact

Patent construction is special occupation, requiring, like all others, special training and practice; judge, from training and discipline, is more likely to give proper interpretation to such instruments than jury, and judge is, therefore, more likely to be right, in performing such duty, than jury can be expected to be.

57 Cases that cite this headnote

[12] **Patents**

🔑 Questions of law or fact

Although question of meaning of term of art in patent claim is subject of testimony requiring credibility determinations, such meaning is more properly determined by judge than jury, as any credibility determinations will be subsumed within necessarily sophisticated analysis of whole document, required by standard construction rule that term can be defined only in way that comports with instrument as whole; jury's capabilities to evaluate demeanor, to sense mainsprings of human conduct, or to reflect community standards, are much less significant than trained ability to evaluate testimony in relation to overall structure of patent.

597 Cases that cite this headnote

[13] Patents

🔑 Questions of law or fact

Importance of uniformity in treatment of given patent supported allocation of all issues of patent claim construction, including construction of terms of art, to court rather than jury; whereas issue preclusion could not be asserted against new and independent infringement defendants, treating interpretive issues as purely legal would promote intrajurisdictional certainty through application of stare decisis.

1021 Cases that cite this headnote

[14] Patents

🔑 Reissue

US Patent RE33,054. Reissue Patent Cited.

11 Cases that cite this headnote

****1386 *370 Syllabus***

Petitioner Markman owns the patent to a system that tracks clothing through the dry-cleaning process using a keyboard and data processor to generate transaction records, including a bar code readable by optical detectors. According to the patent's claim, the portion of the patent document

that defines the patentee's rights, Markman's product can "maintain an inventory total" and "detect and localize spurious additions to inventory." The product of respondent Westview Instruments, Inc., also uses a keyboard and processor and lists dry-cleaning charges on bar-coded tickets that can be read by optical detectors. In this infringement suit, after hearing an expert witness testify about the meaning of the claim's language, the jury found that Westview's product had infringed Markman's patent. The District Court nevertheless directed a verdict for Westview on the ground that its device is unable to track "inventory" as that term is used in the claim. The Court of Appeals affirmed, holding the interpretation of claim terms to be the exclusive province of the court and the Seventh Amendment to be consistent with that conclusion.

Held: The construction of a patent, including terms of art within its claim, is exclusively within the province of the court. Pp. 1389–1396.

(a) The Seventh Amendment right of trial by jury is the right which existed under the English common law when the Amendment was adopted. *Baltimore & Carolina Line, Inc. v. Redman*, 295 U.S. 654, 657, 55 S.Ct. 890, 891, 79 L.Ed. 1636. Thus, the Court asks, first, whether infringement cases either were tried at law at the time of the founding or are at least analogous to a cause of action that was. There is no dispute that infringement cases today must be tried before a jury, as their predecessors were more than two centuries ago. This conclusion raises a second question: whether the particular trial issue (here a patent claim's construction) is necessarily a jury issue. This question is answered by comparing the modern practice to historical sources. Where there is no exact antecedent in the common law, the modern practice should be compared to earlier practices whose allocation to court or jury is known, and the ***371** best analogy that can be drawn between an old and the new must be sought. Pp. 1389–1390.

(b) There is no direct antecedent of modern claim construction in the historical sources. The closest 18th-century analogue ****1387** to modern claim construction seems to have been the construction of patent specifications describing the invention. Early patent cases from England and this Court show that judges, not juries, construed specification terms. No authority from this period supports Markman's contention that even if judges were charged with construing most patent terms, the art of defining terms of art in a specification fell within the jury's province. Pp. 1390–1393.

(c) Since evidence of common-law practice at the time of the framing does not entail application of the Seventh Amendment's jury guarantee to the construction of the claim document, this Court must look elsewhere to characterize this determination of meaning in order to allocate it as between judge or jury. Existing precedent, the relative interpretive skills of judges and juries, and statutory policy considerations all favor allocating construction issues to the court. As the former patent practitioner, Justice Curtis, explained, the first issue in a patent case, construing the patent, is a question of law, to be determined by the court. The second issue, whether infringement occurred, is a question of fact for a jury. *Winans v. Denmead*, 15 How. 330, 338, 14 L.Ed. 717. Contrary to Markman's contention, *Bischoff v. Wethered*, 9 Wall. 812, 19 L.Ed. 829, and *Tucker v. Spalding*, 13 Wall. 453, 20 L.Ed. 515, neither indicate that 19th-century juries resolved the meaning of patent terms of art nor undercut Justice Curtis's authority. Functional considerations also favor having judges define patent terms of art. A judge, from his training and discipline, is more likely to give proper interpretation to highly technical patents than a jury and is in a better position to ascertain whether an expert's proposed definition fully comports with the instrument as a whole. Finally, the need for uniformity in the treatment of a given patent favors allocation of construction issues to the court. Pp. 1393–1396.

52 F.3d 967 (C.A.Fed.1995) , affirmed.

SOUTER, J., delivered the opinion for a unanimous Court.

Attorneys and Law Firms

William B. Mallen, for petitioners.

*372 Frank H. Griffin, III, Media, PA, for respondents.

Opinion

Justice SOUTER delivered the opinion of the Court.

The question here is whether the interpretation of a so-called patent claim, the portion of the patent document that defines the scope of the patentee's rights, is a matter of law reserved entirely for the court, or subject to a Seventh Amendment guarantee that a jury will determine the meaning of any disputed term of art about which expert testimony is offered. We hold that the construction of a patent, including terms of art within its claim, is exclusively within the province of the court.

*373 I

[1] [2] The Constitution empowers Congress “[t]o 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.” Art. I, § 8, cl. 8. Congress first exercised this authority in 1790, when it provided for the issuance of “letters patent,” Act of Apr. 10, 1790, ch. 7, § 1, 1 Stat. 109, which, like their modern counterparts, granted inventors “the right to exclude others from making, using, offering for sale, selling, or importing the patented invention,” in exchange for full disclosure of an invention. H. Schwartz, *Patent Law and Practice* 1, 33 (2d ed.1995). It has long been understood that a patent must describe the exact scope of an invention and its manufacture to “secure to [the patentee] all to which he is entitled, [and] to apprise the public of what is still open to them.” *McClain v. Ortmayer*, 141 U.S. 419, 424, 12 S.Ct. 76, 77, 35 L.Ed. 800 (1891). Under the modern American system, these objectives are served by two distinct elements of a patent document. First, it contains a specification describing the invention “in such full, clear, concise, and exact ****1388** terms as to enable any person skilled in the art ... to make and use the same.” 35 U.S.C. § 112; see also 3 E. Lipscomb, *Walker on Patents* § 10:1, pp. 183–184 (3d ed. 1985) (Lipscomb) (listing the requirements for a specification). Second, a patent includes one or more “claims,” which “particularly poin[t] out and distinctly clai[m] the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112. “A claim covers and secures a process, a machine, a manufacture, a composition of matter, or a design, but never the function or result of either, nor the scientific explanation of their operation.” 6 Lipscomb § 21:17, at 315–316. The claim “define[s] the scope of a patent grant,” 3 *id.*, § 11:1, at 280, and functions to forbid not only exact copies of an invention, but products that go to “the heart of an invention but avoids the literal language of the claim by making a ***374** noncritical change,” Schwartz, *supra*, at 82.¹ In this opinion, the word “claim” is used only in this sense peculiar to patent law.

[3] Characteristically, patent lawsuits charge what is known as infringement, Schwartz, *supra*, at 75, and rest on allegations that the defendant “without authority ma[de], use[d] or [sold the] patented invention, within the United States during the term of the patent therefor....” 35 U.S.C. § 271(a). Victory in an infringement suit requires a finding that the patent claim “covers the alleged infringer's product or

process,” which in turn necessitates a determination of “what the words in the claim mean.” Schwartz, *supra*, at 80; see also 3 Lipscomb § 11:2, at 288–290.

Petitioner in this infringement suit, Markman, owns United States Reissue Patent No. 33,054 for his “Inventory Control and Reporting System for Drycleaning Stores.” The patent describes a system that can monitor and report the status, location, and movement of clothing in a dry-cleaning establishment. The Markman system consists of a keyboard and data processor to generate written records for each transaction, including a bar code readable by optical detectors operated by employees, who log the progress of clothing through the dry-cleaning process. Respondent Westview's product also includes a keyboard and processor, and it lists charges for the dry-cleaning services on bar-coded tickets that can be read by portable optical detectors.

Markman brought an infringement suit against Westview and Althon Enterprises, an operator of dry-cleaning establishments *375 using Westview's products (collectively, Westview). Westview responded that Markman's patent is not infringed by its system because the latter functions merely to record an inventory of receivables by tracking invoices and transaction totals, rather than to record and track an inventory of articles of clothing. Part of the dispute hinged upon the meaning of the word “inventory,” a term found in Markman's independent claim 1, which states that Markman's product can “maintain an inventory total” and “detect and localize spurious additions to inventory.” The case was tried before a jury, which heard, among others, a witness produced by Markman who testified about the meaning of the claim language.

After the jury compared the patent to Westview's device, it found an infringement of Markman's independent claim 1 and dependent claim 10.² The District Court nevertheless granted Westview's deferred motion for judgment as a matter of law, one of its reasons being that the term “inventory” in Markman's patent encompasses “both cash inventory and the actual physical inventory of articles of clothing.” 772 F.Supp. 1535, 1537–1538 (E.D.Pa.1991). Under the trial court's construction of the patent, the production, **1389 sale, or use of a tracking system for dry cleaners would not infringe Markman's patent unless the product was capable of tracking articles of clothing throughout the cleaning process and generating reports about their status and location. Since Westview's system cannot do these things, the District Court directed a verdict on the ground that Westview's device does

not have the “means to maintain an inventory total” and thus cannot “ ‘detect and localize spurious additions to inventory as well as spurious deletions therefrom,’ ” as required by claim 1. *Id.*, at 1537.

*376 Markman appealed, arguing it was error for the District Court to substitute its construction of the disputed claim term ‘inventory’ for the construction the jury had presumably given it. The United States Court of Appeals for the Federal Circuit affirmed, holding the interpretation of claim terms to be the exclusive province of the court and the Seventh Amendment to be consistent with that conclusion. 52 F.3d 967 (1995). Markman sought our review on each point, and we granted certiorari. 515 U.S. 1192, 116 S.Ct. 40, 132 L.Ed.2d 921 (1995). We now affirm.

II

[4] The Seventh Amendment provides that “[i]n Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved....” U.S. Const., Amdt. 7. Since Justice Story's day, *United States v. Wonson*, 28 F. Cas. 745, 750 (No. 16,750) (CC Mass. 1812), we have understood 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.” *Baltimore & Carolina Line, Inc. v. Redman*, 295 U.S. 654, 657, 55 S.Ct. 890, 891, 79 L.Ed. 1636 (1935). In keeping with our longstanding adherence to this “historical test,” Wolfram, *The Constitutional History of the Seventh Amendment*, 57 Minn. L.Rev. 639, 640–643 (1973), we ask, first, whether we are dealing with a cause of action that either was tried at law at the time of the founding or is at least analogous to one that was, see, e.g., *Tull v. United States*, 481 U.S. 412, 417, 107 S.Ct. 1831, 1835, 95 L.Ed.2d 365 (1987). If the action in question belongs in the law category, we then ask whether the particular trial decision must fall to the jury in order to preserve the substance of the common-law right as it existed in 1791. See *infra*, at 1389–1390.³

*377 A

[5] [6] As to the first issue, going to the character of the cause of action, “[t]he form of our analysis is familiar. ‘First we compare the statutory action to 18th-century actions brought in the courts of England prior to the merger of the courts of law and equity.’ ” *Granfinanciera, S.A. v. Nordberg*,

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