Markman: Hearings Required, Or Not?
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Markman v. Westview[(1)] is a watershed, an advance in the practice akin to *Graham v. John Deere*[(2)] and similar cases that add quantums to the advance of our patent law. With its companion, *Hilton Davis*,[(3)] *Markman* importantly clarifies for the foreseeable future the relationship of the judge and the jury in jury-tried patent infringement cases.

The existence of *Markman* is now widely known, throughout the country. In the past two years, numerous continuing legal education courses and periodical articles have been addressed to the effect of *Markman*.[(4)] By all evidence, *Markman* is widely understood to exist by the judiciary, and widely appreciated to require of the judiciary that judges interpret patent claims. In the author's experience, in some districts, judges have recently anticipated with eagerness their first *Markman* hearings. The contrast from past patent practice is marked. Because of the widespread knowledge of *Markman,* judges are routinely making claim interpretation decisions, and not leaving them to juries.

The rapid move to *Markman* hearings in numerous cases is an important aspect of *Markman.* A significant question, however, is whether a hearing is even required. The convention among many practitioners and judges is to speak of Markman as if it requires a hearing in each patent case, specifically directed to claim construction. At least one court, the U.S. District Court for the Central District of California, has expressly stated a pretrial *Markman* hearing is required by *Markman*.[(5)] At least one court, the U.S. District Court for the Northern District of California, has created local court rules to provide procedures for such hearings.[(6)] The need for specific hearings is a consistent underlying assumption of the patent trial bench and bar.

To determine if a hearing is required, the holding of *Markman* itself must be revisited:

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.

Markman, 116 S. Ct. at 1387.

From the words of *Markman* itself, *Markman* holds that the interpretation of patent claims, including disputed technical and non-technical terms of the claims, is exclusively for judges, and not for juries. Consistently, then, juries are to have no part in interpretation of patent claims, often the most important issue is resolving disputes of patent infringement.[(7)] However, *Markman* does not expressly require the so-called A Markman hearing, a hearing at which nothing but claim interpretation is at issue. Reviewing the Markman case history in advance of the Supreme Court decision, the Federal Circuit's decision, 52 F.3d at 971, states that the District Court under review in *Markman* A properly discharged its obligation to delineate the scope of the claim on motion for judgment as a matter of law when the jury had rendered a verdict. This is pointedly a statement that the Federal Circuit considered the District Court to have satisfied the needs of the law in allowing a case to go to a jury without a claim interpretation from the judge. Following this statement, then, district courts, by *Markman* to instruct juries on claim interpretation. The courts may properly discharge their *Markman* obligation by decision on a motion for judgment as a matter of law, after jury verdict. Summarized, judges can interpret claims in post-trial motions and thereby satisfy *Markman*.

Resolution seems clear, then, that *Markman* hearings are not required in patent cases, subject to local rule or local case law. Further, in the larger context, the trend in the processing of cases by courts is one of fewer live appearances by advocates and witnesses. The trend is toward decisions on paper records. While in patent cases, the talk and trend in the near term have been toward *Markman* hearings, given the larger context, the talk and trend toward *Markman* hearings may be a short term phenomenon. Nothing in *Markman* requires a hearing in the formal sense of a set date, oral argument, and witnesses, and the larger trend is away from hearings. Further, as district courts become aware that the Federal Circuit considers the *Markman* obligation met even by decision on post-trial motion, they may move to that handling of *Markman.* In a typical case, each side in a patent infringement dispute could present a claim interpretation and consistent evidence to a jury. Neither side would present evidence inconsistent with their interpretation. The jury could reach a verdict, choosing an interpretation and the consistent evidence. The judge could then decide claim interpretation post-trial. If the preceding verdict was based on the same interpretation, the judge would deny the post-trial motion. If the verdict was based on a different interpretation, the judge would grant the motion.

In the short term, the assumption of the bench and bar that claim construction hearings are necessary is probably not either beneficial or detrimental to the patent law, court efficiency, or specific litigants. To the extent that judges require or prefer hearings to arrive at rulings, consistent with the routines of their work processes, then having claim interpretation hearings is advisable and perhaps laudable. To be better than juries in deciding claim interpretation issues, judges in part should provide themselves time periods within which they can at least hear arguments of advocates on interpretation in the same deliberative pace and atmosphere as found in most trial proceedings. Judges may also need to hear highly technical testimony in some cases, again in an atmosphere as in trial.

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In the author's experience, Markman hearings are frequently extended oral arguments by advocates, and not more. As judges become more familiar with Markman hearings as oral advocacy, they are likely to rely less on oral hearings for their Markman decisions, and turn more to written submissions and selective or abbreviated oral arguments. Thus, Markman hearings as events separate from, and in advance of, trial, may in fact be a short-term phenomenon, and may soon pass from patent litigation practice.

1. *Markman v. Westview Instruments, Inc.,* 116 S.Ct. (1996).

2. *Graham v. John Deere*, 383 U.S. 1 (1966).

3. *Warner-Jenkinson Co. v. Hilton Davis Chemical*, 117 S.Ct. 1040 (1997).

4. E.g., Craig Reilly, Intellectual Property Litigation: Special Issues, Alexandria Bar Association, February 10, 1998; Donald Knebel, et al., Sage Advice: Set It Out Clearly in the Public Record, The National Law Journal, January 26, 1998.

5. *Huang v. Auto-Shade Inc.,* 945 F.Supp. 1307 (C.D.Cal. 1996).

6. Civil L.R. 16-10, 16-11, United States District Court for the Northern District of California.

7. *See Eastman Kodak Co. v. The Goodyear Tire & Rubber Co.,* 114 F.3d 1547 (Fed.Cir. 1997).