Should the Federal Circuit Be Its Own Lexicographer In Matters Concerning the Seventh Amendment?

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In recent years, the United States Supreme Court has considered and decided a record number of patent cases, and has reversed a number of holdings of the United States Court of Appeals for the Federal Circuit. In a number of these cases, the Supreme Court held that the Federal Circuit had established special rules for patent cases that needed to be changed to bring them in line with more general principles of law. Despite the Supreme Court's increased willingness to review issues arising in patent cases, however, there is an important area into which the Court has rarely ventured: the proper allocation of issues between judge and jury in patent cases. In *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), its only major decision in this area, the Supreme Court held that the construction of a claim in a patent is an issue to be decided by the court rather than a jury. While the holding is absolute and clear, the precise legal basis for the holding has generated controversy among the judges of the Federal Circuit, practitioners and legal scholars. Moreover, since its *Markman* decision in 1997, the Supreme Court has avoided deciding any further judge or jury allocation issues in patent cases, expressly declining the opportunity to do so in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.,* 520 U.S. 17, 38-39 (1997).

Decisions in the area of the Seventh Amendment and the proper allocation of issues between judge and jury in patent cases have largely been left to the Federal Circuit. Resolution of issues under the doctrine of equivalents has been allowed to go to juries based upon the Federal Circuit's analysis. In the area of claim construction, the Federal Circuit announced in its *en banc* decision in *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998), that the proper construction of patent claims is "a purely legal issue" and is therefore subject to *de novo* review on appeal. In the *Cybor* case, the majority of the Federal Circuit judges chose to view all the subsidiary questions involved in the construction of patent claims as matters of "law."

This paper examines the Federal Circuit's view of the Seventh Amendment as applied to claim construction, whether the view of the Federal Circuit is supported by the Supreme Court's *Markman* analysis, and whether the Federal Circuit should have latitude to act, in effect, as its own lexicographer with respect to the Seventh Amendment. It is the author's belief that the *Cybor* standard of *de novo* review of claim construction issues should not stand because it is unprincipled. It is the author's further belief that the Supreme Court should accept *certiorari* in patent cases in which the application of the Seventh Amendment and the proper allocation of

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issues between judge and jury are at issue. Finally, it is the author's belief that some of the positions that have been taken by the Federal Circuit with respect to the proper allocation of issues between judge and jury have had a detrimental impact on the development of substantive patent law and are in large part responsible for creating areas of "crisis" in patent law. Principled decisions in the area of the Seventh Amendment and jury rights would go a long way towards resolving some of the areas that are currently viewed as in crisis.