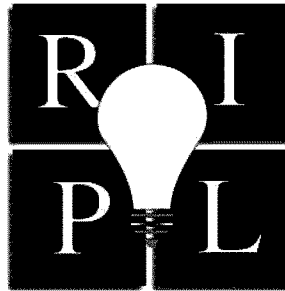


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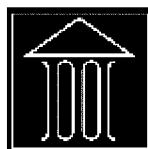
THE ROLE OF JURIES IN MANAGING PATENT ENFORCEMENT: JUDGE
HOWARD MARKEY'S OPINIONS AND WRITINGS

JOHN R. ALISON

ABSTRACT

In the 1970s, a trial by jury was rare in patent cases. By the time Chief Judge Markey left the United States Court of Appeals for the Federal Circuit in 1989, jury trials had become the norm. Throughout Judge Markey's time on the bench he exerted great energy to promote, define, and improve the role of law juries in patent cases. This speech by Judge Markey's former law clerk, John R. Alison, discusses the three Markey Principles. The first principle of Judge Markey is the fundamental right to a jury trial in patent cases. Second, proceedings in jury trials for patent cases should be actively managed just like all other civil trials. Last, the third Markey principle states that a balance should be struck between the right to jury trials in patent cases and the role of the jury.

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*Cite as John R. Alison, The Role of Juries in Managing Patent
Enforcement: Judge Howard Markey's Opinions and Writings, 8 J.
MARSHALL REV. INTELL. PROP. L. (SPECIAL ISSUE) 41 (2009).*

THE ROLE OF JURIES IN MANAGING PATENT ENFORCEMENT: JUDGE HOWARD MARKEY'S OPINIONS AND WRITINGS

JOHN R. ALISON *

Thank you very much, Richard. I greatly appreciate the introduction. We're going to try to do things a little differently in this panel. It's a more interactive format, and we sure hope it's going to work.

To begin—it is a difficult and daunting task to attempt, in a simple 15 minute period, a summary of Chief Judge Markey's efforts to promote, define, and improve the role of lay juries in patent cases. It is a subject on which he frequently wrote and spoke throughout his judicial career—on which he spoke freely, and with deep conviction, with both his judicial colleagues and his clerks. When Chief Judge Markey began working as a United States Judge in the 1970s,¹ he could state from experience—as he did in one of his earliest published speeches, entitled *Special Problems in Patent Cases*²—that “it is rare to have a jury in a patent case.”³ Yet, by the time he left the bench in 1989, jury trials in patent cases had become common, and now are the norm. According to the last Federal Circuit Bench and Bar survey I've read, more than 65% of all patent trials now involve juries.⁴ One might say, “it is rare today *not* to have a jury in a patent case.” This thirty-year evolution in judicial and attorney thinking about juries in patent cases is absolutely remarkable.

The Markey doctrine on jury trials can perhaps be simplified into three basic principles. The first Markey principle—which he believed with deepest conviction—was that the right to a trial by jury in patent cases was fundamental to the patent holder's civil rights—and that such right *shall be preserved* under the 7th Amendment and *should not be rationed* in civil actions. The second Markey principle is that proceedings in patent jury trials *should be actively managed like all other civil trials*, by the judges and the lawyers who participate in them. And the third Markey principle—balancing and complementing the first two—is that the federal courts need to strike a pragmatic balance between the right to jury trial in patent cases, and the corresponding role of the jury in determining the range of issues presented in patent cases, and the need to protect other important Federal interests—such as excepted subject matter (e.g., Hatch-Waxman disputes involving abbreviated new drug applications), the ultimate determination of equitable issues by the district court, and trial judge's legal responsibility to construe claims at issue.

Let's turn to the first of the three Markey principles I've just outlined—that the right to jury shall be preserved and shall not be rationed in civil cases.

To gain insight and a basic appreciation for Chief Judge Markey's views on the

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¹ Sherman L. Cohn, *Howard T. Markey*, 1 J. Fed. Cir. Hist. Soc'y 7, 9 (2007) (“On May 3, 1972, President Nixon nominated Howard T. Markey to be the Chief Judge of the U.S. Court of Customs and Patent Appeals.”).

² Howard T. Markey, *Special Problems in Patent Cases*, 66 F.R.D. 529 (1975).

³ *Id.* at 545.

⁴ Cf. Kimberly A. Moore, *Judges, Juries, and Patent Cases—An Empirical Peek Inside the Black Box*, 11 FED. CIR. B.J. 209, 210 (2001) (stating that “from 1997 to 1999, 59% of all patent trials were tried to juries”).

necessary role of juries in patent cases, we can look first at two basic teaching cases, *Connell v. Sears, Roebuck & Co.*,⁵ which was the first patent jury case reviewed by the United States Court of Appeals for the Federal Circuit, and Chief Judge Markey's additional views in *SRI International v. Matsushita Electric Corp.*,⁶ an in banc decision that issued during an interesting period in the Federal Circuit's evolution in the mid-1980s.

In *Connell*, Chief Judge Markey, writing for a three judge panel, affirmed the trial court's grant of judgment as a matter of law that overturned a jury verdict in favor of plaintiff-patentee Connell.⁷ The trial court had submitted a jury form for a general verdict, supported by fifteen special written interrogatories under Federal Rule of Civil Procedure 49(a).⁸ The jury found for Connell, both as to validity and infringement of claims to a hair "teasing and unsnarling implement."⁹ The trial court overturned the jury verdict on both grounds.¹⁰ On appeal, Connell had argued that the trial court's judgment as a matter of law order, in effect, substituted the trial court's view of the evidence for the facts found by the jury and had deprived him of the right to a jury trial.¹¹

Although Chief Judge Markey disagreed with Connell's ultimate argument, his opinion agreed with (and expressly found for) Connell on a series of underlying issues, vigorously reaffirming Connell's fundamental right to a jury trial.¹² The key insight provided by Judge Markey's opinion emerges from his balancing of the Constitutional jury rights—which clearly assumes primacy—with judicial procedures intended both to protect those rights while avoiding an unjust outcome.¹³

Chief Judge Markey's organized his affirmance of the trial court's order in the form of an Aristotelian dialectic.¹⁴ As his thesis, he acknowledged that "[t]he Seventh Amendment to the Constitution preserves the right to trial by jury in suits at common law and also provides that United States Courts shall not re-examine facts tried by jury except under the rules of common law."¹⁵ He further emphasized, moreover, that following the merger of law and equity under the Federal Rules, the judicial practice of "[p]ermitting the jury to draw legal conclusions based on the jury's fact findings and reached in light of instructions on the law" also "*has been preserved as part of the right.*"¹⁶ Note, however, Judge Markey's stealth insertion of a judicial management component ("in light of the instructions") into his broad affirmation of the constitutional right to jury trials in patent cases. This is vintage Markey

⁵ 722 F.2d 1542 (Fed. Cir. 1983) (Markey, C.J.).

⁶ 775 F.2d 1107 (Fed. Cir. 1985) (in banc) (Market, C.J.).

⁷ *Connell*, 722 F.2d at 1555.

⁸ *Id.* at 1545.

⁹ *Connell v. Sears, Roebuck & Co.*, 559 F. Supp. 229, 232 (N.D. Ala. 1983), *aff'd in part*, 722 F.2d 1542 (Fed. Cir. 1983); *see Connell*, 722 F.2d at 1545.

¹⁰ *Connell*, 559 F. Supp. at 250; *see Connell*, 722 F.2d at 1545.

¹¹ *Connell*, 722 F.2d at 1553–54.

¹² *Id.* at 1546.

¹³ *Id.* at 1546–47.

¹⁴ ROBIN SMITH, ARISTOTLE'S LOGIC (Stanford Encyclopedia of Philosophy 2007) (2000) (stating that "a view of dialectic as argument directed at another person by question and answer and consequently taking as premises that other person's concessions"), *available at* <http://plato.stanford.edu/entries/aristotle-logic/>.

¹⁵ *Connell*, 722 F.2d at 1546.

¹⁶ *Id.* (emphasis added).

reasoning: first, affirm the primacy of individual rights; second, impose systemic judicial checks upon the exercise and interpretation of those rights; and third, find balance to avoid unjust results. And, indeed, by way of illustration, immediately after acknowledging the jury's right to draw legal conclusions based on the facts *and* the trial court's instructions, Judge Markey reaffirms that although the trial court "remains ultimately responsible for upholding the law applicable to the facts," the trial court is not authorized to "substitute its view for that of the jury when to do so would be an effective denial of the right to trial by jury."¹⁷

In *SRI*, Chief Judge Markey wrote separately to address whether the constitutional right to a jury trial in patent cases was subject to a "complexity exception."¹⁸ The underlying case arose on appeal from a grant of summary judgment of noninfringement to the accused infringer Matsushita.¹⁹ Although plaintiff/patentee *SRI* had timely filed a jury demand, the trial court had discontinued preparations for jury proceeding and then converted those preparations into the preparations for a bench trial.²⁰ At the bench trial, he granted summary judgment to the defendant in the case.²¹ During the process, the judge stated that had he didn't "see any factual issues that would be proper for a jury" and that, in the absence of an evidentiary conflict, he did not "see a jury issue in a patent case."²² Those two statements captured Chief Judge Markey's entire attention when reviewing the case.²³

At the outset of his "Additional Views," Chief Judge Markey rejected the suggestion (which he detected in the trial court's summary judgment) that the Federal Circuit had in any way changed the course of the patent law such that special rules and procedures applied to the management of patent cases.²⁴ He saw, moreover, in the district court's management of the evidence relating to "factual issues" a strong suggestion that, for efficiency's sake, complex evidentiary matters were better off being resolved by the Court than by a jury.²⁵ He therefore wrote his "Additional Views," to reaffirm, at length, the primacy of the Seventh Amendment right to a jury trial in patent cases on all issues of fact and law.

He observed, in particular, that one federal appellate court and three federal district courts had either remanded or struck jury demands in "complex" civil actions.²⁶ The basic tenant of that view was the perception (both before bench and bar) that legally or economically complex issues had become too complex for decision by lay jurors and should therefore be tried to a single judge.²⁷ That precept, he said, ignored the fact that lay juries were routinely called on to decide highly complex

¹⁷ *Id.*

¹⁸ *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1127 (Fed. Cir. 1985) (Markey, C.J., additional views).

¹⁹ *Id.* at 1111 (majority opinion).

²⁰ *Id.* at 1112-14.

²¹ *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 591 F. Supp. 464, 474 (N.D. Cal. 1984), *rev'd*, 775 F.2d 1107 (Fed. Cir. 1985).

²² *SRI Int'l*, 775 F.2d at 1113-14.

²³ *See id.* at 1126 (Markey, C.J., additional views).

²⁴ *Id.*

²⁵ *Id.* at 1126-27.

²⁶ *Id.* at 1127.

²⁷ *See, e.g.*, Patrick Devlin, *Jury Trial of Complex Cases: English Practice at the Time of the Seventh Amendment*, 80 COLUM. L. REV. 43, 51-53 (1980).

factual and economic cases, in both civil and criminal cases, and were in most cases rigorously reviewed and upheld upon subsequent judicial review.²⁸

Although not explained in his opinion, Chief Judge Markey's focus on the strength of jury verdicts was based on solid empirical footing. Before his appointment to the United States Court of Customs and Patent Appeals ("CCPA"), Howard Markey actively litigated patent cases in the federal courts, bringing to his judgeship a wealth of direct personal experience.²⁹ During his years as Chief Judge of the CCPA, he frequently sat by designation as a panel member of the eleven regional circuit courts of appeals.³⁰ Indeed, by 1984 he could confidently claim to have sat with every sitting appeals court judge in the United States.³¹ He also had been designated to try intellectual property cases in several circuits, and therefore could claim personal familiarity with the appellate scrutiny given to trial judges, with whom he felt a particularly strong bond.³²

During his early years on the bench, Chief Judge Markey said that he routinely sent an informal "survey letter" to all sitting trial judges asking the following four questions (which I recreate from memory, with a view to recapturing the substance of our discussions): (1) How many civil and criminal jury trials have you presided over during the past year? (2) In what percentage of the verdicts rendered by the jury, would you have voted in the same manner arrived at by the jury? (3) In those instances where you would have voted differently from the jury, in what percentage did you believe that the jury's decision was plainly reasonable? (4) In those instances where you did not believe that the jury's decision was plainly reasonable, in what percentage did you grant a motion for JNOV or a new trial?

In our conversations during his preparation of materials used in his Additional Views, Chief Judge Markey recalled that—year upon year—the trial judges who responded to his letter reaffirmed that they would have "voted with the jury" more than 90 percent of the time. In those instances where the presiding judge stated that he or she would have voted differently from the jury, Chief Judge Markey said the presiding judge found the jury's verdict plainly reasonable in more than 50 percent of the cases in question. And in those instances where the presiding judge did not find the jury's verdict plainly reasonable, Chief Judge Markey said the presiding judge granted judgment as a matter of law or a new trial about 50 percent of the time. He remarked during our discussions that his informal survey was consistent with federal judicial workload statistics reflecting both trial and appellate review of jury cases.³³

In sum, Chief Judge Markey's real life experience—as a lawyer litigating patent cases, as a district court judge, and as an appellate judge—firmly convinced him that the American jury system provided a strong vehicle for deciding complex civil and

²⁸ *SRI Int'l*, 775 F.2d at 1130–31.

²⁹ See Cohn, *supra* note 1, at 9.

³⁰ See *id.* at 10.

³¹ *Id.*

³² See *Poole v. Mossinghoff*, 214 U.S.P.Q. (BNA) 506 (D.D.C. 1982) (Markey, C.J.) (sitting by designation); *Potter v. Dann*, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) (Markey, C.J.) (sitting by designation).

³³ See JAMES C. DUFF, ADMIN. OFFICE OF THE U.S. COURTS, JUDICIAL BUSINESS OF THE UNITED STATES COURTS: 2007 ANNUAL REPORT OF THE DIRECTOR 13 (2007), available at <http://www.uscourts.gov/judbus2007/JudicialBusinesspdfversion.pdf>.

criminal cases. Moreover, where the presiding judge was convinced that the jury had made a mistake, procedural vehicles clearly existed to avoid an unjust result.³⁴

Judge Markey's "Additional Views" in *SRI* forcefully rejected the Seventh Amendment right to jury trial "was never 'intended' to extend to certain 'complex cases' of today," and that a "better system" would focus social resources upon experts.³⁵ Judge Markey believed that "[t]he call for injection of 'expertise' into our jurisprudence can be as alluring, and as fatal, as the sirens' song" and rejected reliance on what he called "juriscience" and the expertise of specialized courts (which, theoretically, also might exclude lay judges as triers of patent cases).³⁶ Moreover, whatever the academic merits of the discussion, the plain language of the Seventh Amendment clearly trumped contemporary concerns regarding "the practical abilities and limitations of juries."³⁷ Judge Markey's "Additional Views" also rejected the suggestion then advanced in the academic literature³⁸ that a conflict may exist between the Seventh Amendment, on the one hand, and the due process provisions of the Fifth and Fourteenth Amendments, on the other hand.³⁹ In response, he stated that "[t]he argument confuses the route with the destination, for 'due process' is just that, a process. It is an important and constitutionally required process. It is not a result."⁴⁰ Moreover, he clearly viewed a decisional approach that caused portions of the Constitution to cancel one another as a path to anarchy: "judges are nowhere authorized to exercise their personal predilection by revising or repealing the Seventh Amendment. . . . To permit a judicial interpretation of a constitutional provision that destroys another constitutional provision is to place at risk the entire Constitution."⁴¹

The real problem in requiring lay jurors to decide technical issues in patent cases, in Chief Judge Markey's view, was not to be found in the technical complexity of patent matters. Rather, the challenge lay in promoting the effective management of patent trials to simplify and appropriately present evidence to the jury.⁴² The academic issue of complexity, in his view, was secondary to the need for pretrial and trial proceedings identifying and focusing key issues for the jury, and also developing a clear record for eventual review on appeal (if any were required).⁴³ If the Seventh Amendment lays the foundation stone for Chief Judge Markey's approach to jury trials in patent cases, strong principles of trial management—along the lines discussed above—clearly forms ground floor. We now turn to this second of the three

³⁴ See, e.g., FED. R. CIV. P. 50.

³⁵ *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1127–28 (Fed. Cir. 1985) (Markey, C.J., additional views).

³⁶ *Id.* at 1129.

³⁷ *Id.* (quoting *Ross v. Bernhard*, 396 U.S. 531, 538 n.10 (1970)); cf. *Ross*, 396 U.S. at 538 ("The Seventh Amendment . . . depends on the nature of the issue to be tried rather than the character of the overall action.").

³⁸ Jeffrey Oaks, Comment, *The Right to Strike the Jury Trial Demand in Complex Litigation*, 34 U. MIAMI L. REV. 243, 289 (1980); Douglas W. Ell, Comment, *The Right to an Incompetent Jury: Protracted Commercial Litigation and the Seventh Amendment*, 10 CONN. L. REV. 775 (1978); see in re Japanese Elec. Prods. Antitrust Litig., 631 F.2d 1069, 1086 (3d Cir. 1980).

³⁹ *SRI Int'l*, 775 F.2d at 1127–28 (Markey, C.J., additional views).

⁴⁰ *Id.* at 1128.

⁴¹ *Id.* at 1128–29.

⁴² *Id.* at 1131–32.

⁴³ *Id.*

Markey principles for a more detailed exploration of his thinking.

Chief Judge Markey's judicial philosophy on promoting the effective management of patent jury trials clearly predates the Constitutional doctrines explored in *SRI* and later cases. An excellent teaching case in *E.I. du Pont de Nemours & Co. v. Berkley & Co.*,⁴⁴ is found in an opinion authored by Chief Judge Markey while sitting by designation in the Eighth Circuit.⁴⁵

Ironically, as in *Connell*, Judge Markey's judicial support for patent jury trials in *du Pont* arises in the context of a decision vacating and remanding a jury verdict.⁴⁶ Plaintiff patentee, du Pont, accused Berkley of infringing claims to a fishing line containing a fluorescent dye.⁴⁷ At trial, the district court had summarily denied du Pont's request that the jury render special verdicts identifying each of the issues regarding the patentability and infringement of the accused line.⁴⁸ Instead, the trial court submitted a form calling for a naked general verdict supported by three special interrogatories relating solely to certain fraud issues.⁴⁹ The form of the verdict plainly frustrated Chief Judge Markey: although the panel opinion politely held that denial of du Pont's request for special verdicts and detailed interrogatories was not, in itself, reversible error, it observed that use of these mechanisms might very well have avoided a retrial (perhaps as an incentive for trial courts in future cases).⁵⁰

In *du Pont*, Chief Judge Markey remarked that, whatever the considerations and concerns that might be involved in current discussions of juries in complex litigations, the use of interrogatories and special verdicts "from which the parties and an appellate court may glean the basis for the verdict, would appear to alleviate at least some of those concerns in some cases."⁵¹ In point of fact, Chief Judge Markey bemoaned the fact that the appellate court in *du Pont* had been called upon to review "an entire 4000 page record" to resolve "over 25 issues and subissues," encompassing eleven allegations of reversible error, "[c]louched in accusatory and turgid terminology" supported by "numerous bits and pieces of conflicting testimony and documentary evidence," from which appellate court was expected to "draw a plethora of factual inferences."⁵² Chief Judge Markey's frustration (and perhaps, well concealed delight) in the mismanagement of the case by both the trial court and counsel for both parties could not have been clearer.

Chief Judge Markey's decision in *du Pont* clearly "talked softly" to avoid encroaching upon Eighth Circuit precedent. Yet, his subsequent opinion in the Federal Circuit's *Connell* exhibited less restraint and greater scope on the issue of "naked general verdicts."⁵³ This time, having assumed nationwide jurisdiction over all patent cases, Chief Judge Markey could observe that "[such] practice leav[es] a wide area of uncertainty on review," and that "appellate judges have expressed grave

⁴⁴ 620 F.2d 1247 (8th Cir. 1980) (Markey, C.J.).

⁴⁵ *Id.* at 1255.

⁴⁶ *Id.* at 1276.

⁴⁷ *Id.* at 1255–56.

⁴⁸ *Id.* at 1256 n.5.

⁴⁹ *E.I. du Pont de Nemours & Co. v. Berkley & Co.*, 204 U.S.P.Q. 594, 596 (N.D. Iowa 1979), *vacated in part*, 620 F.2d 1247 (8th Cir. 1980).

⁵⁰ *See du Pont*, 620 F.2d at 1256 n.5.

⁵¹ *Id.*

⁵² *Id.* at 1256–57.

⁵³ *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1546 (Fed. Cir. 1983).

concern over the use of the general verdict in civil cases.”⁵⁴ Indeed, in *Connell*, the Federal Circuit (having by then superseded the Eighth Circuit’s review of trial procedures in patent cases) held that “[s]ubmission of the obviousness question to the jury should . . . be accompanied by detailed special interrogatories designed to elicit responses to at least all the factual inquiries enumerated in *Graham* [*v. John Deere Co.*, 383 U.S. 1 (1966)], and based on the presentations made in the particular trial.”⁵⁵

In *Connell*, Chief Judge Markey emphasized that while great deference was due to a jury’s fact findings in a civil case, that rule came with the proviso that such deference, both the trial and on appeal, was not so great as to require the acceptance of findings that were not supported by substantial evidence.⁵⁶ To avoid an unjust outcome, the Federal Rules of Civil Procedure provided both safeguards and alternatives to manage and, if necessary, correct the jury’s task of trying patent cases.⁵⁷ *Connell* actively promoted, for instance, the use of special verdicts under Federal Rule 49(a),⁵⁸ and the complementary use of special verdicts accompanied by answers to interrogatories under Rule 49(b), in managing patent jury trials.⁵⁹ It paid particular attention to the role of Rule 51(a) instructions as a “guide” to the jury’s deliberations.⁶⁰ Indeed, Chief Judge Markey’s panel opinion in *Connell* expressly “recommended” to trial courts (on pain of facing retrial) that the trial court’s submission of special interrogatories to the jury also be accompanied “at a minimum” by instructions making clear that the jury “must consider the invention as a whole” and that each member of the jury “must walk in the shoes of one skilled in the art.”⁶¹ Finally, he pointed to the curative power of Rule 50(a) directed verdicts,⁶² the authority to grant Rule 50(b) judgments as a matter of law,⁶³ and further to grant Rule 59(a) grants of new trials.⁶⁴ These procedural safeguards, he observed, insured both the parties and the judicial system against an improper outcome that might occur from a “rogue elephant” jury that disregarded the rules.⁶⁵

In a March 24, 1987 speech, *On Simplifying Patent Trials*,⁶⁶ Chief Judge Markey again restated his views on the effective management in patent jury cases. Key to his judicial approach was the belief that patent cases (whether tried to the bench or to a jury) should be actively managed “like all other civil trials,” in which he again reiterated the universal applicability of the Federal Rules and the broad power of the

⁵⁴ *Id.*

⁵⁵ *Id.* at 1547.

⁵⁶ *Id.* at 1546 (“Deference due a jury’s fact findings in a civil case is not so great . . . as to require acceptance of findings where . . . those findings are clearly and unquestionably not supported by substantial evidence. To so hold would be to render a trial and the submission of evidence a farce.”).

⁵⁷ See *Connell*, 722 F.2d at 1546.

⁵⁸ FED. R. CIV. P. 49(a); *Connell*, 722 F.2d at 1546.

⁵⁹ FED. R. CIV. P. 49(b); *Connell*, 722 F.2d at 1546.

⁶⁰ FED. R. CIV. P. 51(a); *Connell*, 722 F.2d at 1546.

⁶¹ *Connell*, 722 F.2d at 1547.

⁶² FED. R. CIV. P. 50(a); *Connell*, 722 F.2d at 1546.

⁶³ FED. R. CIV. P. 50(b); *Connell*, 722 F.2d at 1546.

⁶⁴ FED. R. CIV. P. 59(a); *Connell*, 722 F.2d at 1546.

⁶⁵ *Connell*, 722 F.2d at 1546.

⁶⁶ Howard T. Markey, *On Simplifying Patent Trials*, 116 F.R.D. 369 (1987).

jury to decide questions of law and fact.⁶⁷ Chief Judge Markey's increased focus on jury issues in *On Simplifying Patent Trials* reflects, in itself, the increased importance of jury trials in patent cases—an evolution caused, in no small part, by his own decisions and writings promoting the role of juries in complex cases.⁶⁸

Finally, Chief Judge Markey also recognized limitations upon the types of issues that were appropriate for consideration by a jury. This element of his judicial philosophy illustrates his strong sense of a need to balance between the right to a jury trial and other important Federal interests at play within the U.S. patent system.

In *Gardco Manufacturing, Inc. v. Herst Lighting Co.*,⁶⁹ which Joe Re will discuss in greater detail during the next session, Chief Judge Markey authored a panel opinion approving the trial court's separation (under Federal Rule 42(b)) of inequitable conduct for "pre-trial" by the district court before a scheduled jury trial on the liability and patent validity issues.⁷⁰ In affirming the district court's decision, the panel rejected defendant Peerless's claim that the trial court's decision on inequitable conduct effectively deprived it of a jury trial on the facts underlying the purely equitable issue of inequitable conduct.⁷¹

Similarly, in *Senmed, Inc. v. Richard-Allan Medical Industries, Inc.*⁷²—a decision foreshadowing the Federal Circuit's decision in *Markman v. Westview Instruments, Inc.*⁷³—Chief Judge Markey authored a divided panel opinion vacating and reversing a jury's infringement verdict, holding that the grounds for reversal (the legal issue of claim construction) was not preempted by the jury's verdict.⁷⁴ In a dissenting opinion, Circuit Judge Newman argued, with considerable force, that the jury's infringement finding implied a verdict on an issue of law requiring deference.⁷⁵ Writing for the panel majority, however, Chief Judge Markey adhered to the viewpoint—now universally accepted—that claim construction raised a question of law for decision by the trial judge on a motion for judgment as a matter of law (and on appeal).⁷⁶ Thus, even though the jury verdict answered a legal question, "that circumstance," in itself, could not relieve the trial judge or the Federal Circuit "of the judicial duty to insure that the law [was] correctly [decided]."⁷⁷ Here, Chief Judge Markey concluded that acceptance of the jury verdict necessarily would sanction in the patentee's recapture of subject matter forfeited when obtaining the patent.⁷⁸

I thank you for your patience, and I yield to my colleagues on the panel and to

⁶⁷ *Id.* at 371–72, 376. This speech also advocates for the increased, creative use of Rule 42(b) of the Federal Rules of Civil Procedure to separate issues in patent trials for incremental decision, urging the bench and bar to "try infringement separately." *Id.* at 377–78.

⁶⁸ *See, e.g.,* *Weinar v. Rollform Inc.*, 744 F.2d 797 (Fed. Cir. 1984) (Markey, C.J.); *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888 (Fed. Cir. 1984) (Markey, C.J.); *R.R. Dynamics, Inc. v. A. Stucki Co.*, 727 F.2d 1506 (Fed. Cir. 1984) (Markey, C.J.).

⁶⁹ 820 F.2d 1209 (Fed. Cir. 1987) (Markey, C.J.).

⁷⁰ *Id.* at 1210–12.

⁷¹ *Id.* at 1211–13.

⁷² 888 F.2d 815 (Fed. Cir. 1989) (Markey, C.J.).

⁷³ 52 F.3d 967 (Fed. Cir. 1995) (in banc), *aff'd*, 517 U.S. 370 (1996).

⁷⁴ *Senmed*, 888 F.2d at 818, 821.

⁷⁵ *Id.* at 821–24 (Newman, J., dissenting).

⁷⁶ *Id.* at 818 (Markey, C.J.).

⁷⁷ *Id.*

⁷⁸ *Id.* at 818 n.6.

your questions from the floor.

