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Charles Lee Thomason

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Markman Pro Publico: Friending the Courts on Patent Claim Interpretation Issues

Abstract

In Markman claim term disputes, the paramount interest of the public in patents and in the public domain is unrepresented, even though “patent rights are ‘issues of great moment to the public.’” What delineates the outer bounds of the patent claim interpretation inquiry are the “private interests of the litigants.” The public interest is set aside. Neither the courts nor the litigants are well positioned to address the “underlying policy of the patent system” or to ask pointedly whether the patent claims, unless properly construed, have enough “worth to the public” to “outweigh the restrictive effect of the limited patent monopoly.” The public interest in how inventions are described in issued patents is a precise but flexible construct that confines the granted rights within legal limits, disagrees with claims being read so expansively that information is taken back from the public domain, and urges objective interpretations that favor neither litigants’ infringement nor invalidity strategies. Amicus groups could define zones of interest when certain patent claims are interpreted and move to represent the public interest in the Markman proceedings. A public interest advocacy group consisting of law students who have completed a patent law course could be formed to identify cases that involve patent claims that affect segments of commerce important to the public. Through an admitted attorney and local counsel, such a group would enter an appearance for the limited purpose of participating as amicus in the claim interpretation proceedings. This article argues first that amici could protect the public domain and enforce the public notice function of patent claims. Then it argues in Section Three that having the litigants restrict the range of interpretations a court may consider leaves the public interest aspects out of the decision-making process. Next, Section Four of the article further contrasts the litigation-driven interpretations and the objective rules of construction. The final section examines whether an amicus group representing the public interest might be excluded from claim interpretation proceedings.

Keywords

Markham, Patents, amicus, patent claim

Markman Pro Publico: Friending the Courts on Patent Claim Interpretation Issues

by Charles Lee Thomason¹

I. INTRODUCTION

In *Markman* claim term disputes, the paramount interest of the public in patents and in the public domain is unrepresented, even though “patent rights are ‘issues of great moment to the public.’”² What delineates the outer bounds of the patent claim interpretation inquiry are the “private interests of the litigants.”³ The public interest is set aside.

Neither the courts nor the litigants are well positioned to address the “underlying policy of the patent system” or to ask pointedly whether the patent claims, unless properly construed, have enough “worth to the public” to “outweigh the restrictive effect of the limited patent monopoly.”⁴ The public interest in how inventions are described in issued patents is a precise but flexible construct that confines the granted rights within legal limits, disagrees with claims being read so expansively that information is taken back from the public domain, and urges objective interpretations that favor neither litigants’ infringement nor invalidity strategies.

Amicus groups could define zones of interest when certain patent claims are interpreted and move to represent the public interest in the *Markman* proceedings. A public interest advocacy group consisting of law students who have completed a patent law course could be formed to identify cases that involve patent claims that affect segments of commerce important to the public. Through an admitted attorney and local counsel, such a group would enter an appearance for the limited purpose of participating as *amicus* in the claim interpretation proceedings.

This article argues first that *amici* could protect the public domain and enforce the public notice function of patent claims. Then it argues in Section Three that having the litigants restrict the range of interpretations a court may consider leaves the public interest aspects out of the decision-making process. Next, Section Four of the article further contrasts the

litigation-driven interpretations and the objective rules of construction. The final section examines whether an *amicus* group representing the public interest might be excluded from claim interpretation proceedings.

II. SEEKING PUBLIC NOTICE AND GUARDING THE PUBLIC DOMAIN

The most fundamental policy behind the Patent Clause is enrichment of the public domain.⁵ Neither a Court nor Congress can endow patents with rights that “remove existent knowledge from the public domain.”⁶ The *quid pro quo* for a patent grant is putting “the public in possession of” the invention described and claimed so that “the public is informed, not only of what has been patented, but of what still remains common as before.”⁷

Starting with the Patent Act of 1793, every inventor and patent has been required to employ “such full, clear, and exact terms, as to distinguish the same from all other things before known.”⁸

“Otherwise, a ‘zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field,’ and ‘[t]he public [would] be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights.’”⁹

Thus, clarity, notice, and preservation of the public

1. Patent attorney in private practice, and adjunct IP Professor teaching at the University of Kentucky College of Law. I can be reached at c.leethomason@gmail[dot]com.

2. *Precision Instrument Mfg., Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806, 815 (1944).

3. *Id.*

4. *Bilski v. Kappos*, 130 S. Ct. 3218, 3258 (2010) (Breyer, J., concurring) (quoting *Graham v. John Deere Co.*, 383 U.S. 1, 10-11 (1966)).

5. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989) (“The Patent Clause itself reflects a balance between the need to encourage innovation and the avoidance of monopolies which stifle competition without any concomitant advance in the ‘Progress of Science and useful Arts’.”).

6. *Graham*, 383 U.S. at 6 (noting that a patentable invention must “add to the sum of useful knowledge”).

7. *Evans v. Eaton*, 20 U.S. 356, 413, 446 (1822).

8. Patent Act of 1793, §3 Ch. 11, 21 Stat. 318, 321, set out in *Evans*, 20 U.S. at 380-81.

9. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390 (1996) (quoting *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942) and *Merrill v. Yeomans*, 94 U.S. 568, 573 (1876)). See also *Mahm v. Harwood*, 112 U.S. 354, 361 (1884) (“The public has the undoubted right to use, and it is to be presumed to us, what is not specifically claimed in the patent.”).

domain are public interest factors that deserve no less attention than is given to the litigation goals that parties have grounded on pliable passages in the patent application.¹⁰

An *amicus* group could serve the public interest by advocating for patent claim interpretations that take nothing away from the public domain, do not capture the prior art, and do not expand patent claim scope through equivalence.¹¹ Enforcing the requirements of public notice, describing and enabling the invention in “full, clear, concise, and exact terms,” and “particularly pointing out and distinctly claiming” the invention would ensure that the public interest is represented when patent claims are interpreted.¹²

III. LITIGANTS ESTABLISH THE PERIMETER AROUND THE INTERPRETATION ISSUES

In patent claim term disputes, the litigants select which claim limitations they will urge be interpreted and which terms will be strategically avoided. Each litigant’s self-interest becomes the sole determinant for inclusion or exclusion of a claim limitation or term in the *Markman* presentations to the district judge.

Each litigant’s decisions about whether to battle over a particular claim term involve strategic interplay with which interpretations most likely will prove or avoid infringement or sustain validity or invalidity. The strategic goal of the patentee is to dispute just enough of the claim terms to win on infringement without going so far as to risk invalidation. An accused infringer may put all of its resources into invalidating the patent and almost none toward interpretations essential to non-infringement of the claims. Some defendants in patent infringement actions will urge that practically every claim term limitation be construed, while their motive is unconnected to pursuing an interpretation that is outcome determinative of any issue.¹³

Once the litigants have set the bounds for their claims interpretation dispute, all the other claims and limitations are ignored. In districts with local patent rules, only those “asserted” claims designated by the parties will be construed.¹⁴ “[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”¹⁵ An *amicus* group that urges a widened inquiry into the patent claims might be ruled out of bounds by the court or be deemed unwelcome by the litigants.

The common concerns with participation by *amici* are an expansion of the issues framed by the litigants, a lack of stake in the actual controversy, and added work for the judiciary. One can advocate that the overarching public interest in patent claims being construed fairly deserves more weight than the judicial efficiency perceived to result from the dispute being confined to those claim term arguments that the litigants prefer be considered.

“It is true that, in ordinary private litigation, courts sometimes confine their decisions narrowly, and, if one point is sufficient to support a decision, other points are not discussed. Even if that could be said to be the usual practice, it loses much of its pertinence in patent cases. A patent is a ‘public franchise,’ a legalized monopoly. To allow a patent to remain apparently valid when the issue of invalidity is raised and the court sees that the patent is invalid, is to ignore the paramount public interest. Because no representative of the public may institute a suit to have a patent held invalid, and because the courts have no staff of independent experts to aid them in patent suits, the courts must, in most cases, rely on the litigants....”¹⁶

Rather than have district courts rely on the

10. Proper claim interpretation will limit any patent that “withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

11. See *Howe Mach. Co. v. Nat’l Needle Co.*, 134 U.S. 388, 394 (1890) (quoting *White v. Dunbar*, 119 U.S. 47, 52 (1886) (“The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is, and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms.”)).

12. 35 U.S.C. §112 (2006); *Johnson & Johnston Assocs. Inc. v. R.E. Serv. Co., Inc.*, 285 F.3d 1046 1052, 1052 (Fed. Cir. 2002) (“The claims give notice . . . to the public at large, including potential competitors, after the patent has issued.”).

13. See Peter S. Menell, Matthew D. Powers & Steven C. Carlson, *Patent Claim Construction: A Modern Synthesis and Structured Framework*, 25 BERKELEY TECH. L.J. 711, 731 (2010) (“It

is all too common for the parties to propose differing construction but be unable to articulate why the differences matter.”). See too, Comment to Northern District of Illinois Local Patent Rule 4.1, the “limitation to ten claim terms to be presented for construction is intended to require the parties to focus upon outcome-determinative or otherwise significant disputes.”

14. See, e.g., Local Patent Rules 4-3(c)2, N.D. Ill. available at <http://www.ilnd.uscourts.gov/home/LocalRules.aspx?rtab=patentrules>, Local Patent Rule 4.1, N.D. Cal, available at <http://www.cand.uscourts.gov/filelibrary/184/Local%20Rules%206.2.11%20with%20Cross%20Refs.pdf>; *infra* note 43.

15. *Vivid Tech., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

16. *Aero Spark Plug Co. v. B. G. Corp.*, 130 F.2d 290, 293 (2d Cir. 1942), (Frank, J., concurring) (footnotes omitted).

litigants exclusively in *Markman* proceedings, *amicus* groups could undertake the role of representing “the paramount public interest” in patents being construed properly.¹⁷ It is to be questioned whether the deliberative and litigious adversarial process can accommodate an *amicus* group to represent the public interest and advocate for the patent in suit to be interpreted more objectively.¹⁸

The evaluative and objective process begins with the *amicus* group: (i) identifying ongoing patent suits with terms that, when interpreted, will affect some significant sector of commerce, innovation, or widespread public consumption, and (ii) appearing as *amicus* to aid in claim interpretation. Once an appropriate *Markman* matter is identified, the *amicus* group must move, with or without the consent of the litigants, to appear in the case and brief the claim construction issues.

It is recognized in patent jurisprudence that the “public interest here is not in the fate of these litigants[;] . . . the interest is in the way this judge made law affects technologic innovation and competition.”¹⁹ Even properly construed patents “serve as a barrier to competition for the type of subject matter that is patented.”²⁰ The litigants’ dominant role and self-interest in patent claim interpretation proceedings would be tempered if the public interest were urged as a worthy component of the *Markman* determination. In practice however, the litigants and the district court may prefer that a public interest advocacy group not be permitted to serve the role of *amicus* and present claim interpretation arguments.

17. *Precision Instrument Mfg., Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806, 816 (1944).

18. See *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246, 1257-58 (Fed. Cir. 2011) (Lourie, J., concurring in part, dissenting in part) (“Unfortunately, the nature of our adversary system often causes those patents to be asserted against someone engaged in activity not contemplated by the inventors . . . and litigation counsel attempt to fit a square peg into a round hole, or, in other words, to fit into the claim language what the inventors never contemplated as part of their invention.”). *Amici* have argued claim construction issues to the Federal Circuit, see e.g., *Orion IP, LLC v. Hyundai Motor America*, 605 F.3d 967 (Fed. Cir. 2010) (“The court’s finding of nonobviousness is even more surprising in light of its construction of the claim term ‘a computerized method.’” Brief of Washington Legal Foundation, 2009 WL1900190).

19. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359, 1379 (Fed. Cir. 2003) (Newman, J., concurring in part, dissenting in part).

20. *Bilski v. Kappos*, 130 S.Ct. 3218, 3257 (2010) (Stevens, J., concurring).

IV. EVALUATIVE, OBJECTIVE ADVOCACY FOR THE PUBLIC INTEREST IN PATENT INTERPRETATION

Considerable *dicta* pronounces that patents and the scope of the exclusive patent rights enforceable by law are imbued with the “public interest.”²¹ Such pronouncements attach to patents that are invalid or unenforceable and against overbroad or unbounded patent claims.²² Yet, that “public interest” is of no interest to an accused infringer, and is of minimal concern to a patentee seeking to enforce its rights against infringement.²³

While the representation of the public interest in patent litigation is still actively debated, the discussion ultimately leads to specific case examples, *infra*. However, it is not the purpose of this writer to critique specific patents, litigants, or strategies. With due respect for the exceptional work of litigating patent attorneys and those district courts where most of the cases are venued, some examples are offered for discussion.

Consider cases where the same claim terms were construed more than once and differently by different judges. Might objective advocacy from an *amicus* group representing the public interest have assisted in achieving a more efficient and correct result? Many courts have construed the claim terms “database” or “memory” device, albeit in the context of various patents.²⁴ The results of the separate *Markman*

21. *Blonder-Tongue Labs., Inc. v. Univ. of Ill. Found.*, 402 U.S. 313, 344 (1971) (“The patent is a privilege . . . which is conditioned by a public purpose . . . [and] results from invention and is limited to the invention which it defines.”); *Lear, Inc. v. Adkins*, 395 U.S. 653, 670 (1969) (holding that there is an “important public interest in permitting full and free competition in the use of ideas which are in reality a part of the public domain.”); *Application of Prater*, 415 F.2d 1393, 1405 n.31 (C.C.P.A. 1969) (stating that during prosecution an applicant “may then amend his claims” to make it less likely a patentee will argue the claims should be “interpreted as giving broader coverage than is justified,” because “[t]his thought, in ‘the public interest, is deemed to be paramount to an applicant’s interest.”).

22. See, e.g., *Precision Instrument Mfg., Co.* 324 U.S. 806; One recalls the claim of Samuel F.B. Morse to every “use of the motive power of the electric or galvanic current, which I call electro-magnetism, however developed for marking or printing intelligible characters, signs, or letters, at any distances,” which was ruled invalid. *O’Reilly v. Morse*, 56 U.S. 62, 112 (1853).

23. An exception being when a patentee seeks an injunction. See *Roche Products, Inc. v. Bolar Pharm. Co., Inc.*, 733 F.2d 858, 865-66 (Fed. Cir. 1984) (“the standards of the public interest, not the requirements of private litigation, measure the propriety and need for injunctive relief in these cases”) (quoting *Hecht Co. v. Bowles*, 321 U.S. 321, 331 (1944)) (remanding case “for further proceedings to consider what this interest is”), *cert. den’d*, 469 U.S. 856 (1984).

24. Recent examples of *Markman* proceedings to construe “database” include *Vasudevan Software, Inc. v. IBM Corp.*, No. C 09-05897 RS, 2011 WL 196884, at *2-3 (N.D. Cal. Jan. 20,

rulings regarding those terms ended up at the Federal Circuit, which then a standard for review of conflicting constructions of the same claim term.²⁵

The *Finisar* appeal panel consulted two separate district courts' interpretations of "information database" from the same patent.²⁶ The Eastern District of Texas construed "information database" to mean "a collection of computerized information which can be accessed."²⁷ The Northern District of California construed it as "a dynamic, structured collection of digitized data capable of being held in computer storage."²⁸ Neither reading of "information database" by these courts was adopted on appeal, even though the same objective rules of claim interpretation were applied. The Federal Circuit construed "information database" as used in the patent to be "a collection of computerized information which can be accessed and searched, and from which selected information can be retrieved, and where the search and retrieval capabilities are at least as specific as those of the hierarchically arranged set of indices."²⁹

In all three proceedings the interpretations urged were a product of the litigants' self-interest and, to an extent, how the "information database" was construed had an impact on the public domain. The Eastern District of Texas' definition is the broadest, and would capture most any database in the public domain. When the Federal Circuit found that access, search, and retrieval capabilities were defining limitations, the claimed information database was narrowed to correspond more to the specific invention, distinct from the broader domain of prior art databases. Reading a claim term broadly tends to increase the likelihood that infringement can be proven, but at the risk that the broad definition also will read on invalidating prior art. Litigants try to drive the *Markman* process into the definitional confines outlined by their commercial interests. An *amicus* group that advocates the public interest would urge an objective reading of patent claims and that the definitional process be driven by

2011), *MySpace, Inc. v. Graphon Corp.*, 756 F. Supp. 2d 1218, 1227 (N.D. Cal. 2010), *Civix-DDI v. Hotels.Com*, No. 05 C 06869, 2010 WL 4386475, at *7-8 (N.D. Ill. Oct. 25, 2010), and *Jardin v. Datallegro, Inc.*, No. 08-CV-1462-IEG (RBB), 2010 WL 3910481, at *3-4 (S.D. Cal. Oct. 4, 2010).

25. *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1329 (Fed. Cir. 2008) ("In the interest of uniformity and correctness, this court consults the claim analysis of different district courts on the identical terms in the context of the same patent.").

26. See U.S. Patent No. 5,404,505 claim 16 (filed Nov. 1, 1991).

27. *Finisar*, 416 F. Supp. 2d at 517 (E.D. Tex. 2006).

28. *Comcast Cable Commc'ns Corp. v. Finisar Corp.*, No. C 06-04206 WHA, 2007 WL 1052821, at *6 (N.D. Cal. April 6, 2007).

29. *Finisar*, 523 F.3d at 1331.

clarity, conformity with the disclosure in the public record, and protection of the public domain.

In selected cases, *amici* representing the public interest could offer a wholly objective construction of the claim terms based on the intrinsic record that gave notice to the public.³⁰ The claims would be "construed objectively and without reference to the accused device."³¹ An objective interpretation by public interest *amici* would be uninfluenced by whether it captures features in the accused device or in the prior art.

Interpreting a claim to have greater breadth may take more away from the public domain, but that added breadth will also make the claim read on more prior art.³² The corollary is that broadly construed claim terms are more likely to be infringed.³³ Indeed, adding breadth to claims will expand what might infringe by equivalence.³⁴ This suggests that the public interest is antithetical to overbroad or invalid claims that may result in undeserved monopolies, and further that the public interest may tend to favor construing claims narrowly and interpreting art in the public domain broadly.³⁵

The zones of interest to be represented by *amici* who advocate for the public interest would include adherence to the intrinsic evidence and

30. See *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996) (a "patent must describe the exact scope of an invention . . . to 'secure to [the patentee] all to which he is entitled, [and] to apprise the public of what is still open to them.") (quoting *McClain v. Ortmyer*, 141 U.S. 419, 424 (1891)).

31. *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

32. In *Finisar*, the disclosure in the prior art was read broadly, which protected the available public domain of technology. 523 F.3d at 1336 ("Thus, one of skill would interpret the passage broadly to present many varied options for each of the tiers under consideration.").

33. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1384 (Fed. Cir. 2001) ("The jurisprudence of claim construction reflects the difficult balance between a patentee's exhortation that courts should read the claims broadly and unlimited to the specific embodiments shown in the specification . . . [and in] counterpoint, an accused infringer often argues, as in this case, that if the claims are read sufficiently broadly as to reach the accused device, the claims also read on the prior art and are invalid.").

34. *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1323 (Fed. Cir. 1999) (the "jury found infringement under the doctrine of equivalents . . . [and] because the jury found infringement under the trial court's more restricted reading of the claims, this court need not remand for a[literal] infringement determination according to this court's broader claim interpretation.").

35. *Edward Katzinger Co. v. Chicago Metallic Mfg. Co.*, 329 U.S. 394, 401 (1947) ("[Court's] solicitude for the interest of the public fostered by freedom from invalid patents . . . has been manifest by the line of decisions . . ."); *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29 (1997) ("There can be no denying that the doctrine of equivalents, when applied broadly, conflicts with the definitional and public-notice functions of the statutory claiming requirement.").

objective interpretation of claim limitations, without undue regard for the accused subject matter, but with an appropriate regard for relevant art in the public domain. Review of the case law indicates how often the Circuit court changes the claim term definitions presented by litigants in district court *Markman* hearings. On balance, public interest representation in *Markman* proceedings would aid district courts in reaching an objective result, with the claims of the patent defined more objectively and the process driven less by choices grounded upon the litigants' commercial objectives.

V. THE INTERESTS OF THE PUBLIC WILL NOT BE INVITED IN *MARKMAN* PROCEEDINGS

Amici could validate the “objective test” on which the rules for patent claim interpretation are grounded.³⁶ The pursuit of uniformity in how claims are interpreted should accommodate the public interest in patents. Indeed, the standards for claim construction redound to the public “notice” function and to how “persons of skill,” *i.e.*, an informed public, would understand the claim terms and the prior art.³⁷ Moreover, *Markman* spawned a formulaic set of rules intended to be applied objectively and to produce uniform results.³⁸ The rules for patent claim interpretation and those for construing contract terms objectively share many tenets.³⁹ However, all patents and few contracts implicate the public interest. *Amici* are as able as the litigants and the courts to divine meaning from the art and specification and to apply well-established rules to interpret the claims.

In *Markman* proceedings, *amici* could advocate for the rule of law, the intrinsic record, the public domain, and the public interest.⁴⁰

36. *Markman, v. Westview Instruments, Inc.*, 52 F.3d 967, 986 (Fed. Cir. 1995).

37. See generally, *Gen. Elec. Co. v. Wabash Appl. Corp.*, 304 U.S. 364, 369 (1938) (“The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others, and the assurance that the subject of the patent will be dedicated ultimately to the public.”).

38. “[W]e see the importance of uniformity in the treatment of a given patent as an independent reason to allocate all issues of construction to the court.” *Markman*, 517 U.S. 370 at 390 (1996) (*affg* 52 F.3d 967, 986 (Fed. Cir. 1995) (en banc) (“[T]he objective test [is] what one of ordinary skill in the art at the time of the invention would have understood the term to mean.”).

39. See *Markman*, 52 F.3d at 986 (“[T]he focus in construing disputed terms in claim language is not the subjective intent of the parties to the patent contract when they used a particular term [but] rather is on the objective test of what one of ordinary skill in the art at the time of the invention would have understood the term to mean”); *id.* at 987 (“[T]he more appropriate analogy for interpreting patent claims is the statutory interpretation analogy.”).

40. See *Markman*, 517 U.S. at 390 (quoting Merrill v. Yeomans, 94 U.S. 568, 573 (1877) ([Absent clarity, t]he public

“Historically, then, an amicus curiae is an impartial individual who suggests the interpretation and status of the law, gives information concerning it, and whose function is to advise in order that justice may be done, rather than to advocate a point of view so that a cause may be won by one party or another.”⁴¹

On *Markman* issues, *amici* can serve that historic role by representing the public interest impartially and without regard to whether one litigant’s strategy or another is served.

Amici representing the public interest may urge that claims be interpreted in ways that favor neither litigant. When the district court considers the arguments for interpreting claims one way or the other, amici can present an objective view more consonant with the rules of construction that the reviewing court will apply.

The litigants are expected to press for claim interpretations that embody the wording needed to win, or to not lose their case. However, when a patentee and the accused infringer fail to get claims interpreted broadly enough to prove infringement or invalidity, the result is a wash-out. That too may be an outcome that results from the advocacy of *amici* for the public interest.

In practice, neither party may desire for *amici* to participate, and the court may decline to consider claim interpretation issues beyond those presented by the litigants. Exclusion of *amici* representing the public interest might be based on limits in Article III to actual controversies between litigants, or on a theory that *amici* lack standing or that when *amici* are not excluded, they must not go beyond the issues framed by the litigants. “Amici are allowed to participate . . . to assist the court in achieving a just resolution of issues raised by the parties [but not] to interject into a case issues which the litigants, whatever their reasons might be, have chosen to ignore.”⁴² Still, case management orders typically can accommodate complexities that may arise from the participation of *amicus* or nominal parties.⁴³ Those tools, joined with

[would] be deprived of rights supposed to belong to it . . .”).

41. *Leigh v. Engle*, 535 F. Supp. 2d 418, 420 (N.D. Ill. 1982).

42. *Lane v. First Nat. Bank of Boston*, 871 F.2d 166, 175 (1st Cir. 1989); See also *San Juan Cnty., Utah v. United States*, 503 F.3d 1163, 1210 (10th Cir. 2007) (Kelly, J., concurring) (“The principal difference between party and amicus status is that only parties ordinarily have the right to raise new issues . . .”). The better view is that of Judge Frank. *Aero Spark Plug Co. v. B.G. Corp.*, 130 F.2d 290, 293 (2d Cir. 1942) (Frank, J., concurring).

43. Review of local rules databases did not disclose district courts having rules governing the participation of *amici* in civil cases, and so, it is presumed that case management orders serve that

the typical timetables in Local Patent Rules, provide more than adequate means to permit *amici* to appear and represent the public interest.⁴⁴

The appropriate instance for *amici* to represent the public interest would not have the issue of infringement or validity turn upon how a single term in the claims was interpreted. Instead, the preferable case would entail a broader examination of interrelated claim terms, some of which are commonly used in many patents, and a claimed invention that affects the public interest. Examples may be cases that could affect access to the internet or to generic drugs, or cases regarding emerging, still-developing technologies.⁴⁵ The public interest concerns regarding notice, possession of the invention, the public domain, and restrictions on further innovation are more readily identified by *amici* in such cases.

VI. CONCLUSION

In conclusion, *amici* can serve a useful purpose in *Markman* claim interpretation proceedings by representing the public interest factors identified in numerous, important decisions about patents and in the policies that the Patent Clause should advance. A patent, and are specifically its claims to a disclosed invention, grants exclusive rights as against the public. Invoking judicial power to ascertain the breadth or limits of patent claims is as much a public interest proceeding as a First Amendment case where prior restraints affect public speech. The record supporting the patent is public, and the rules of claim construction work in service of the public's understanding of which exclusive rights were granted and what knowledge remains in the public domain.

Fifteen years later, the *Markman* procedures are still works in progress. An opportunity is presented for *amicus* groups to elevate the public interests in patents from mere *dicta*, and to advocate that public interest concerns with the fair interpretation of patent claims should be a decisional element worthy of consideration in *Markman* briefs and hearings.

purpose.

44. Local district court rules and best practices permit the threshold claim terms to be interpreted earlier than those that may be non-dispositive. See, e.g., N.D. Cal. Patent L.R. Local Rules 4-3(c) (requiring parties to identify claim "terms whose construction will be most significant to the resolution of the case.").

45. *Evans v. Eaton*, 20 U.S. 356, 438 (1822) (it([It] is enough, and the public interest is sufficiently guarded, if care be taken that it [the patent] shall not be extended to create a monopoly in any other machine, which may or may not be mentioned in the patent . . .").