

Solving the riddle



Who is “OOSITA”?

Meredith Martin Addy and Artem N. Solokov analyse the “one of ordinary skill in the art” test in US patent cases

In the United States, patent cases may be tried to a jury. However, the jury does not decide every issue. Many issues are resolved by the judge before, and throughout, the trial. As a general rule, legal issues are decided by the judge, and factual issues are left for the jury to decide after trial. The jury resolves the factual issues and applies the law, as provided by the judge, to the facts.

Patent infringement is a question of fact, usually for the jury to determine. The analysis of whether an accused device or process infringes a patent is a two step inquiry¹. First, the patent claims at issue are construed to determine their meaning. Second, the claims, as construed, are applied to the accused device or method².

The first step in the infringement process, claim construction, is a pure question of law³. Indeed, it has no underlying factual components⁴. According to the United States Court of Appeals for the Federal Circuit

(“Federal Circuit”)⁵, a judge construes patent claim terms based 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.”⁶ After the Federal Circuit’s *en banc* decision in *Markman*, affirmed by the United States Supreme Court,⁷ claim construction may take place at a separate hearing (a “*Markman* hearing”) and should be done before trial. The *Markman* hearing occurs in front of a judge; no jury is present. That judge then construes the claims as they would be understood by the hypothetical person: one of ordinary skill in the art (“OOSITA”).

But, who determines the standard for this hypothetical OOSITA? And, if a judge construes the claims as they would be understood by OOSITA, then shouldn’t we know who OOSITA is *before* ruling on claim construction? Therein lies the riddle.

Case law remains unclear on whether the determination of OOSITA should be done by a judge or a jury. While the majority of precedent supports the determination of OOSITA as a factual question, surprisingly few cases have analysed the issue.⁸ A few analogous cases, discussing patent validity, have held that the *level* of ordinary skill in the art is a factual question.⁹ Determination of *who* satisfies OOSITA presupposes that one knows the level of ordinary skill in the appropriate art, which implies that the determination of OOSITA at least includes underlying factual considerations. However, a factual OOSITA creates problems and tensions with a purely legal claim construction, especially when that claim construction is done by the judge prior to trial but the determination of the level of ordinary skill in the art is made by a jury at a later date.¹⁰

As a pure matter of law, claim construction generally should be resolved by looking at the intrinsic evidence: “It is well-settled that, in interpreting an asserted claim, the court should look first to the intrinsic evidence of record, i.e., the patent itself, including the claims, the specification and, if in evidence, the prosecution history.”¹¹ The intrinsic evidence was considered by the United States Patent and Trademark Office (“PTO”) during examination of the patent application. Such intrinsic evidence is the most significant source of the proper meaning of disputed claim language.¹² In most situations, an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term. An analysis of the intrinsic evidence, however, does not specifically involve a determination of OOSITA.

Extrinsic evidence, on the other hand, includes things that were not previously considered by the PTO but may help determine the meaning of a claim term. Extrinsic evidence may include, for example, expert testimony, technical treatises, and dictionaries. When the intrinsic evidence is clear, the Federal Circuit has held that reliance on extrinsic evidence to interpret a claim term is improper.¹³ In those cases, extrinsic evidence may be heard as background information or to educate the court, but the court cannot rely on such evidence if it contradicts the unambiguous meaning of a claim term as determined by the intrinsic evidence.¹⁴

Hence, in ruling on claim construction, the court reviews the intrinsic evidence as presented by the parties. The court may rule based on the briefs of the parties or may order a *Markman* hearing at which the parties present argument on what the patent claim terms should mean. Because extrinsic evidence in most cases should not be necessary, the court usually does not hear from experts on the meaning of claim terms. The claim

In summary

- ⊗ As a general rule, in US patent cases legal issues are decided by the judge and factual issues by the jury
- ⊗ Claim construction is a question of law, and a judge construes patent claim terms based on the objective test of what “one of ordinary skill in the art” (OOSITA) at the time of the invention would have understood the term to mean
- ⊗ However, case law remains unclear on whether the determination of OOSITA itself should be done by a judge or a jury

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construction process, as refined by the Federal Circuit, does not provide for an explicit determination of OOSITA, yet precedent mandates that the court construe the claims as OOSITA would understand them before trial and before a jury is empanelled.

If the court makes the legal determination of claim construction from the perspective of OOSITA, how does the court perform this purely legal analysis prior to trial when the factual determinations underlying OOSITA have not been made? Or, stated another way, does the court not inherently determine OOSITA in order to properly construe the claims? And, if so, does determination of OOSITA then become a question of law? After all, the Federal Circuit was clear in *Cybor* that claim construction is solely a question of law with no factual underpinnings.¹⁵ So, if the patent itself, or its intrinsic evidence, does not state who OOSITA is, and most do not, then how does the judge determine OOSITA?

Using extrinsic evidence

The Federal Circuit in *Phillips v. AWH Corp.* recently reaffirmed that:

*“extrinsic evidence in the form of expert testimony can be useful to a court for a variety of purposes, such as to provide background on the technology at issue, to explain how an invention works, to ensure that the court’s understanding of the technical aspects of the patent is consistent with that of a person of skill in the art, or to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field.”*¹⁶

So, the court could hear expert testimony at the *Markman* stage of the case to aid in making the determination of OOSITA. For claim construction, expert testimony traditionally has attempted to explain *how* OOSITA would interpret the language of the claim(s), rather than who is OOSITA. Experts may have differing opinions on who is OOSITA. While such expert testimony may be biased or simply wrong, judges have wide discretion as to how much deference they will accord expert opinions.¹⁷ Under current precedent, courts are not required to set forth a determination of OOSITA prior to interpreting the claims, but it appears experts could be used to aid the court in coming to a proper determination of OOSITA. Keep in mind, however, that in using expert evidence for any matter related to claim construction, the court may not rely on factual evidence that contradicts the intrinsic evidence, as such reliance may be at odds with *Cybor*. As the Federal Circuit stated in *Phillips*, “extrinsic evidence in the form of expert testimony can be useful to a court for a variety of purposes”. One purpose should be to help the court understand OOSITA.

Finality of claim construction

Making the determination of OOSITA as a prerequisite to rendering claim construction makes sense for other reasons as well. For one thing, it is not unusual for a judge’s claim construction to be outcome determinative of an entire litigation.¹⁸ As such, once the judge interprets the claims “through the eyes of OOSITA,” the resulting claim construction may force the parties to settle. In that scenario, the jury never makes any factual determinations to support OOSITA. Hence, OOSITA inherently becomes a question of law decided by the court. The problem, as Judge Rader stated in *Cybor*, is that “[w]hat seems clear to a judge may read otherwise to [one skilled in the art]”.¹⁹ Concerned about the ramifications of construing claims entirely as a matter of law, Judge Rader further commented: “[i]n effect, the en banc opinion has sub silentio redefined the claim construction inquiry as ‘how a lawyer or judge would interpret the term’”.²⁰ Judge Rader’s concern is justified, as Federal Circuit precedent does not provide for a determination of OOSITA prior to rendering claim construction. However, with proper guidance, there is no reason that a district court judge could not make a proper determination of OOSITA prior to ruling on claim construction, and in fact, district court judges are likely already doing so inherently.

Moreover, even if the parties do not settle the case after a *Markman* ruling, the court’s claim construction may become the basis of a summary judgment motion prior to trial. If the court grants summary judgment of non infringement or invalidity based on the claim construction, the court again sidesteps any underlying fact-finding purportedly necessary to the determination of OOSITA. On appeal, the grant of summary judgment will receive *de novo* review because it allegedly contains no disputed facts.²¹ Only if the Federal Circuit finds an overlooked disputed fact, will the case be remanded for trial and will the jury possibly get to determine the level of ordinary skill in the art.²² If the outcome-determinative district court claim construction is affirmed on appeal, as with the previous hypothetical, the case concludes based on a claim construction that did not have the benefit of any factual determination of the level of ordinary skill to support OOSITA.

Therefore, because precedent requires the court to construe the claims pursuant to what OOSITA would have understood them to mean, and that construction is a purely legal question, practically, the court inherently determines OOSITA as a matter of law. Hence, it makes more sense under Federal Circuit precedent for OOSITA to be considered a question of law rather than, arguably, a question with factual

underpinnings. The judge may have a clearer understanding of the importance and purpose of determining OOSITA during the claim construction process than a jury does during the trial. Thus, allowing the judge to rule on OOSITA during claim construction would save judicial resources by eliminating time consuming expert testimony and other evidence during trial that may be repetitive of previous evidence provided to the judge, for example at a technical tutorial or at the *Markman* hearing.

Other agencies and tribunals

Patent examiners in the United States Patent and Trademark Office (the “PTO”) routinely determine OOSITA as a matter of course during examination, and their determination is not questioned in litigation. For example, in order to reject a patent application under 35 U.S.C. § 103, the examiner presents evidence that OOSITA would find the disclosed invention obvious over the prior art.²³ However, the examiner is not OOSITA,²⁴ and therefore, in order to complete his obviousness rejection, he must make some determination of OOSITA based on the disclosures in the application.²⁵ In the U.S., patent examiners also are generally not attorneys.²⁶ If the examiner makes this determination based on prior art disclosures, shouldn’t a federal judge, after reviewing the same disclosures and possibly other evidence, be able to make the same determination?

Allowing the determination of OOSITA to be a legal question also accords with the procedure already used by the PTO Board of Patent Appeals and Interferences (“BPAI”). The Administrative Judges of the BPAI are not considered OOSITA, yet, they review patentability determinations.²⁷ The Federal Circuit on appeal reviews the BPAI’s decision for substantial evidence but does not review the technical qualifications of the BPAI judges deciding the appeal.²⁸ Similarly, federal judges are also not considered OOSITA but are no less qualified to make these decisions than the BPAI judges.

If patent examiners determine OOSITA and the BPAI determines OOSITA, a properly educated U.S. district court judge also should be able to determine OOSITA. In fact, he is probably inherently already doing so when he makes his claim construction ruling. If the decision already is being made, shouldn’t the parties provide the district court judge with the tools he needs to better make that decision?

Such OOSITA evidence could be presented prior to claim construction or during the claim construction presentations. Increasingly, these days, and as further supported by *Phillips*, district courts are ordering a tutorial on the technology.²⁹ This tutorial is designed to educate the court on the technology at issue, and it occurs at some point prior to the court’s decision



on the claim terms. The technology tutorial may include expert testimony on the technology itself, as distinct from the claim terms at issue. This technology tutorial is designed to equip the court to make a better claim construction decision. After the technology tutorial, and after the court has been presented with the parties' arguments as to the meaning of the claim terms, the court renders its claim construction decision. Perhaps the technology tutorial is an appropriate place for presentation of additional evidence to help determine OOSITA. Even cases that do not lend themselves to technology tutorials may allow for presentation of evidence on OOSITA within the claim construction process.

Recognizing that the district court needs guidance when determining OOSITA and providing the court with that guidance will help the court with its ultimate claim construction decision that may also be the most important determination of the case.

Solving the riddle

So, wouldn't it be nice if the determination of OOSITA was a question of law? It would relieve the inherent tension present when a court rules on claim construction as it would be understood by OOSITA. As it stands now, juries often are not asked to determine either the level of ordinary skill in the art or OOSITA. Many times, the court inherently resolves the question of OOSITA at a *Markman* hearing, on summary judgment, or the parties stipulate to it beforehand. Making the determination of OOSITA a question of law would align the court's analysis with the procedures and standards employed by the PTO and the BPAI. Once the court had determined OOSITA and construed the claim, the jury would receive the appropriate infringement instruction to apply the claim construction to the accused device through the eyes of OOSITA. In reality, this approach would likely have little effect on the outcome of trials, but it would reduce litigant's expenses, save judicial resources, and somewhat ease the already heavy burdens carried by a patent jury. ☺

Notes

- 1 See *Vitronics, Corp. v. Conceptor Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).
- 2 *Id.*
- 3 See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 981 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996); *Cybor Corp. v. FAS Techs.*, 138 F.3d 1448, 1456 (Fed. Cir. 1998) (*en banc*).
- 4 *Cybor Corp.*, 138 F.3d at 1456.
- 5 The U.S. Court of Appeals for the Federal Circuit is the exclusive court that hears patent appeals from the federal district courts and from the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences. 28

- U.S.C. § 1295 (2000).
- 6 *Markman*, 52 F.3d at 986.
- 7 *Id.* at 967, *aff'd*, 517 U.S. 370 (1996).
- 8 *Graham v. John Deere*, 383 U.S. 1, 17 (1966).
- 9 In *Graham*, the Supreme Court held that patent validity is a question of law with underlying factual inquires, listing a determination of the level of ordinary skill in the art as one of the factual questions. *Id.*; see also *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991) ("[T]he level of ordinary skill in the art is a factual question that must be resolved and considered.").
- 10 See *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998) ("It is the person of ordinary skill in the field of the invention through whose eyes the claims are construed."). A factual OOSITA also creates tensions with mixed questions of law and fact such as obviousness and enablement, but we leave those for another day.
- 11 See *Markman*, 52 F.3d at 979; *Vitronics*, 90 F.3d at 1582.
- 12 See *Vitronics*, 90 F.3d at 1582.
- 13 *Id.*
- 14 *Id.* at 1583.
- 15 *Cybor Corp. v. FAS Techs.*, 138 F.3d 1448, 1455 (Fed. Cir. 1998) (*en banc*) (disavowing that "while construction is a legal question for the judge, there may also be underlying fact questions.").
- 16 *Phillips v. AWH Corp.*, 415 F.3d 1303, 1318 (Fed. Cir. 2005) (emphasis added); see also *Vitronics Corp.*, 90 F.3d at 1585.
- 17 See *Phillips*, 415 F.3d at 1319. (holding that it is "permissible for the district court in its sound discretion to admit and use such evidence ..." but that "... the court should keep in mind the flaws inherent in each type of evidence and assess that evidence accordingly.").
- 18 *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568 (Fed. Cir. 1987)
- 19 *Cybor Corp.*, 138 F.3d at 1475.
- 20 *Id.*
- 21 Questions of law are reviewed under the de novo standard, while findings of fact are reviewed under the clearly erroneous standard. *McMonagle v. Ne. Women's Ctr., Inc.*, 493 U.S. 901, 904 (1989).
- 22 See FED. R. CIV. P. 52(a) (findings of fact in a bench trial overturned only if clearly erroneous).
- 23 *In re Swartz*, 232 F.3d 862, 864 (Fed. Cir. 2000). Examiners also wear the hat of OOSITA for section 112 considerations. *Id.* at 863.
- 24 See *Markman*, 52 F.3d at 979, *aff'd*, 517 U.S. 370 (1996) ("Examiners [are] presumed to have experience in interpreting references and to be familiar from their work with the level of ordinary skill in the art."); During oral argument in *Phillips v. AWH Corp.*, the solicitor would not go so far as to admit that examiners were skilled in the art, but implied that they are somewhat skilled. See Audio tape: Oral Argument, *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (No. 03-1269) (Feb. 06, 2005) (on file with authors).
- 25 *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000) (upholding the examiners finding that "it would have been obvious for one of ordinary skill in the art to utilize only one temperature measurement to control the coolant pulses in light of the Evans disclosure.").
- 26 In fact, patent examiners cannot be compelled to testify regarding the mental process used in processing a patent application or the level of technical knowledge in the particular art. ROBERT L. HARMON, *PATENTS AND THE FEDERAL CIRCUIT 770-71* (7th ed. 2005).
- 27 *In re Nilssen*, 851 F.2d 1401, 1402 (Fed. Cir. 1988) (finding that "the correctness of a board's decision depends on whether the decision is supported by the record, not on the technical background of the Examiners-in-Chief who decided the appeal.").
- 28 *Id.* at 1402-03; *In re Gartside*, 203 F.3d 1305, 1315 (Fed. Cir. 2000) (Federal Circuit reviews findings of fact of the BPAI for substantial evidence.)
- 29 *Intel Corp. v. Broadcom Corp.*, 172 F. Supp. 2d 516, 520 (D. Del. 2001) (using a technology tutorial to provide a background on digital video patents); *Semitool, Inc. v. Dynamic Micro Sys. Semiconductor Equip. GmbH*, 2002 U.S. Dist. LEXIS 23050 (D. Cal. 2002); see also *Altera Corp. v. Clear Logic, Inc.*, 424 F.3d 1079, 1093 (9th Cir. 2005) (praising the lower court for employing the technology tutorial and suggesting that the tutorials be taped so as to provide the same educational benefit to the appellate court).

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