

***DAUBERT V. MARKMAN: FACT
EXPERTS ON ISSUES THAT ARE
WHOLLY DEVOID OF ANY FACTUAL
COMPONENT***

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I. INTRODUCTION

*Baseball is like church. Many attend, but few understand.*¹

As of 2009, the median cost of litigating a patent with more than \$25 million at risk was estimated at approximately \$5.5 million.² It is now well-established that the first substantive role of any trial court in a patent infringement lawsuit is to construe the patent claims to determine the exact scope of the patent’s subject-matter.³ The claim construction proceeding—emanating from the Supreme Court decision in *Markman v. Westview Instruments, Inc. (Markman II)*⁴ affirming the Federal Circuit decision in *Markman v. Westview Instruments, Inc. (Markman I)*⁵—is designated as a “*Markman* proceeding”⁶ and often determines the outcome of these multi-million-dollar lawsuits.⁷ Given this cor-

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- ¹ Simran Khurana, Baseball Quotes for Inspiration, <http://quotations.about.com/od/moretypes/a/baseball3.htm> (last visited Feb. 25, 2010) (quoting Wesley Noreen “Wes” Westrum (1922–2002), New York Giants catcher). We disclaim any expertise in baseball, other than some very limited experience in imbibing cold beers at tailgating parties.
- ² AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION, 2009 REPORT OF THE ECONOMIC SURVEY 29 (2009), available at http://www.aipla.org/Template.cfm?Section=Publications_available_for_viewing1&Template=/MembersOnly.cfm&ContentFileID=22990.
- ³ See *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1480 (Fed. Cir. 1998) (en banc) (Newman, J., dissenting) (“Patent litigation now often starts with a preliminary hearing to interpret the disputed claim terms . . .”).
- ⁴ 517 U.S. 370 (1996).
- ⁵ 52 F.3d 967 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370 (1996).
- ⁶ To our knowledge, the first district court case to use the term “*Markman* hearing” was *Moll v. N. Telecom, Inc.*, No. 94-5451, 1996 WL 11355, at *1 (E.D. Pa. Jan. 3, 1996) (“The two questions to be answered following the *Markman* hearing were the following . . .”).
- ⁷ *Cybor*, 138 F.3d at 1480 (Newman, J., dissenting) (“This preliminary [*Markman*] ruling can be dispositive of the dispute, for the scope of the claim often decides whether there can be literal infringement.”); *Markman I*, 52 F.3d at 989 (Mayer, J., concurring) (“All these pages and all these words cannot camouflage what the court well knows: to decide what the claims mean is nearly always to decide the case.”); see also Christian A. Chu, *Empirical Analysis of the Federal Circuit’s Claim Construction Trends*, 16 BERKELEY TECH. L.J. 1075, 1078–79, 1099 (2001). It is worthwhile to note that, while Chu provides an excellent review of the Federal Circuit’s patent-related decisions at the appellate court level, Chu does not explicitly provide a correlation between claim construction and infringement at the trial court level. However, close scrutiny of Chu’s statistics reveals that the claim construction is, indeed, outcome determinative. *Id.* at 1099.

relation, practitioners frequently devote considerable time and effort to obtain a favorable *Markman* ruling.⁸ Often, that effort includes retaining an expert witness to testify as to the meaning of one or more claim terms.⁹

Unfortunately, some practitioners and judges misunderstand the role of expert witnesses¹⁰ in the context of *Markman* proceedings. As a result of this misunderstanding, combined with the Supreme Court's decision in *Daubert v. Merrell Dow Pharmaceuticals, Inc.*,¹¹ practitioners often file complicated "*Daubert* motions"¹² under Rule 702 of the Federal Rules of Evidence¹³ to disqualify experts from *Markman* proceedings.¹⁴ In this paper, we analyze the propriety of employing such *Daubert* motions in *Markman* proceedings.

⁸ Phillips v. AWH Corp., 415 F.3d 1303, 1332 (Fed. Cir. 2005) (en banc) (Mayer, J., dissenting):

During so called *Markman* "hearings," which are often longer than jury trials, parties battle over experts offering conflicting evidence regarding who qualifies as one of ordinary skill in the art; the meaning of patent terms to that person; the state of the art at the time of the invention; contradictory dictionary definitions and which would be consulted by the skilled artisan; the scope of specialized terms; the problem a patent was solving; what is related or pertinent art; whether a construction was disallowed during prosecution; how one of skill in the art would understand statements during prosecution; and on and on.

⁹ *Id.*

¹⁰ It should be noted that the Federal Rules of Evidence provide for experts retained by a party as well as those appointed by the court. FED. R. EVID. 702, 706. This paper addresses only the role of a party's expert and not the role of a court-appointed expert. Thus, unless otherwise noted, the term "expert witness" refers to a party's expert rather than a court-appointed expert.

¹¹ 509 U.S. 579 (1993).

¹² Named after *Daubert*, the seminal case that set the threshold for admissibility of expert witnesses. *See id.* (assigning to the trial judge the responsibility of ensuring expert testimony is relevant and reliably based).

¹³ FED. R. EVID. 702:

If scientific, technical, or other specialized knowledge will assist the trier of fact to understand the evidence or to determine a fact in issue, a witness qualified as an expert by knowledge, skill, experience, training, or education, may testify thereto in the form of an opinion or otherwise, if (1) the testimony is based upon sufficient facts or data, (2) the testimony is the product of reliable principles and methods, and (3) the witness has applied the principles and methods reliably to the facts of the case.

¹⁴ See motions filed in *Hitachi Plasma Patent Licensing Co. v. LG Elecs., Inc.*, No. 2:07-CV-155-CE, 2009 WL 1292820 (E.D. Tex. May 7, 2009); *Bright Solutions, Inc. v. Tire Seal, Inc.*, No. 5:06-CV-247-DF, 2008 WL 5428163 (E.D. Tex. July 7, 2008); *C2 Commc'ns Techs., Inc. v. AT&T, Inc.*, No. 2:06-CV-241, 2008 WL 2462951 (E.D. Tex. June 13, 2008);

While there are many interesting facets to patent claim construction, an attempt to address every intricacy is a herculean task that would result in an overload of information and, consequently, an uninteresting and somewhat useless paper. Hence, we identify and disclaim some of those peripherally-related topics at the outset in an attempt to focus the substance of this paper on the specified topic.

Once the scope of the paper has been defined, the first substantive section analyzes *Daubert*, identifying the legal principles that are germane to this paper. Next, we analyze *Markman I* and *Markman II* and their progeny, and discuss *Markman*'s significance in claim construction. Following the review of both *Daubert* and *Markman*, we attempt to explain why the practice of introducing expert witnesses in *Markman* proceedings is so prevalent. We then analyze how litigants have used *Daubert* motions to oppose experts in *Markman* proceedings. Finally, we propose that a complicated *Daubert* motion is an improper mechanism for opposing an expert witness in a *Markman* proceeding and that a simpler Rule 402 motion is more appropriate.

II. PRE-GAME ROUTINE

*Baseball is a simple game. If you have good players and if you keep them in the right frame of mind then the manager is a success.*¹⁵

At the outset, we emphasize that we state no opinion on whether or not *Daubert* was properly decided. Instead, we take the law on expert witnesses as

Voith Paper GmbH & Co. v. Johnsonfoils, Inc., No. 07-226-JJF, 2008 WL 874311 (D. Del. Mar. 31, 2008); *Nidec Corp. v. Victor Co. of Japan*, No. C-05-0686-SBA, 2007 WL 4108092 (N.D. Cal. Nov. 16, 2007); *Flo Healthcare Solutions, LLC v. Rioux Vision, Inc.*, No. 1:06-CV-2600-TWT, 2007 WL 4200678 (N.D. Ga. Nov. 16, 2007); *Romala Stone, Inc. v. Home Depot U.S.A., Inc.*, No. 1:04-CV-2307-RWS, 2007 WL 2904110 (N.D. Ga. Oct. 1, 2007); *Int'l Automated Sys., Inc. v. Digital Persona, Inc.*, 565 F. Supp. 2d 1276 (D. Utah 2008); *Mannatech, Inc. v. Glycobiotics Int'l, Inc.*, 513 F. Supp. 2d 754 (N.D. Tex. 2007); *Highmark, Inc. v. Allcare Health Mgmt. Sys., Inc.*, 4:03-CV-1384-Y, 2007 WL 6457158 (N.D. Tex. Mar. 23, 2007); *Kai U.S.A., Ltd. v. Buck Knives, Inc.*, No. CV 05-446-HA, 2006 WL 314456 (D. Or. Feb. 9, 2006). Several of these cases are discussed in greater detail *infra* Part III.D.1.

¹⁵ Baseball Almanac, Sparky Anderson Quotes, <http://www.baseball-almanac.com/quotes/quoand.shtml> (last visited Feb. 25, 2010) (quoting George Lee "Sparky" Anderson (b. 1934), who managed the Cincinnati Reds to World Series titles in 1975 and 1976, and managed the Detroit Tigers to a World Series title in 1984).

it currently stands, providing only the necessary background on *Daubert* to shed light on our primary topic.

Also, while the fact-law distinction in claim construction has been controversial ever since the original *Markman* decision,¹⁶ we do not address the merits or demerits of those various positions. Others have written extensively on whether or not claim construction should be devoid of factual inquiries.¹⁷ Thus, the question of whether claim construction should be a question of law, a question of fact, or a mixed question of law and fact is beyond the scope of this paper. Instead, we take the law on claim construction as it currently stands, describing *Markman* and its progeny only to the extent necessary to keep the right frame of mind for our main topic.

In sum, we only address the question of whether *Daubert* motions are the proper vehicles for disqualifying expert witnesses in *Markman* proceedings. For other topics, the reader is directed to other resources.

¹⁶ The *Markman I* decision from the Federal Circuit resulted in four separate opinions. See *Markman v. Westview Instruments, Inc. (Markman I)*, 52 F.3d 967, 970–89 (Fed. Cir. 1995) (en banc) (Archer, C.J., majority opinion), *aff'd*, 517 U.S. 370 (1996); *id.* at 989–98 (Mayer, J., concurring); *id.* at 998–99 (Rader, J., concurring); *id.* at 999–1026 (Newman, J., dissenting).

¹⁷ See, e.g., *Phillips v. AWH Corp.*, 415 F.3d 1303, 1330–34 (Fed. Cir. 2005) (en banc) (Mayer, J., dissenting) (“Now more than ever I am convinced of the futility, indeed the absurdity, of this court’s persistence in adhering to the falsehood that claim construction is a matter of law devoid of any factual component.”); *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1462 (Fed. Cir. 1998) (en banc) (Plager, J., concurring) (“This otherwise unremarkable case was taken in banc for the sole purpose of laying to rest any residual doubts about how, in claim construction, the verbalizations surrounding the familiar ‘fact-law’ dichotomy should be understood. I join the court’s opinion and judgment, eliminating the unnecessary obfuscation that seems to have emerged”); *id.* at 1463 (Bryson, J., concurring) (“While I join the opinion of the court without reservation, I think it important to note that our adoption of the rule that claim construction is an issue of law does not mean that we intend to disregard the work done by district courts in claim construction”); *id.* at 1464 (Mayer, J., concurring) (“So [the Supreme Court] decided as a matter of policy that judges, not juries, are better able to perform this task given the complexity of evidence and documentation. This was a perilous decision of last resort.”); *id.* at 1473–78 (Rader, J., dissenting) (“[T]his case obscures what really is at stake when claim construction is subject to de novo review and appellate revision.”); *id.* at 1478–81 (Newman, J., additional views and dissenting in part) (“In declining to affirm the Federal Circuit’s fact/law theory, the Court opened the door for retreat from this artificial construct. I urge us to do so”). See generally Lauren Maida, Note, *Patent Claim Construction: It’s Not a Pure Matter of Law, So Why Isn’t the Federal Circuit Giving the District Courts the Deference they Deserve?*, 30 CARDOZO L. REV. 1773 (2009) (discussing the consequences, including the high reversal rate of district court claim construction, stemming from the Federal Circuit’s de novo claim construction standard of review).

III. THE MAIN EVENT

*You can observe a lot by just watching.*¹⁸

In order to appreciate why *Daubert* motions are improper for disqualifying expert witnesses in *Markman* hearings, it is necessary to examine the Supreme Court decisions in both *Daubert* and *Markman*, as well as to discuss the progeny of cases that followed in their wake. Insofar as the technologies involved are largely irrelevant to the topic at hand, we concentrate on the legal holdings in these cases rather than flyspecking the technology. The reason for scrutinizing the legal holdings of both *Daubert* and *Markman* will become apparent.

A. *The Daubert Players*

*The most overrated underrated player in baseball.*¹⁹

We start our analysis with a brief overview of the evolution of the law as it pertains to expert witnesses. Namely, we begin by tracing the history of *Daubert*.

1. Stopping Short of Admissibility

Jason Daubert's tale begins before his birth. His mother, Joyce Daubert, ingested Bendectin to treat nausea and vomiting during pregnancy.²⁰ Jason Daubert²¹ was born with limb-reduction birth defects, for which he sued Merrell Dow Pharmaceuticals, Inc. ("Merrell-Dow"), the manufacturer of Bendectin.²²

¹⁸ BrainyQuote, <http://www.brainyquote.com/quotes/quotes/y/yogiberra125285.html> (last visited Feb. 25, 2010) (quoting Lawrence Peter "Yogi" Berra (b. 1925), Major League Baseball player and manager).

¹⁹ Baseball Quotes, http://www.baseball-quotes.com/quotesPage.php?quotes=baseball_quotes"eNumber=70 (last visited Feb. 25, 2010) (quoting Lawrence S. Ritter (1922–2004), American author and baseball historian, on Thomas David "Tommy" Henrich (b. 1913), Major League Baseball player for the New York Yankees).

²⁰ *Daubert v. Merrell Dow Pharms., Inc.*, 727 F. Supp. 570, 571 (S.D. Cal. 1989).

²¹ To avoid ambiguity in this paper, we use Jason Daubert's full name to identify the individual.

²² *Daubert*, 727 F. Supp. at 571.

At trial, Jason Daubert's attorneys introduced eight expert witnesses²³ in an effort to show that Bendectin was the cause of his birth defects. In short, these experts recalculated the data from a previous study to show that there was a significant relationship between Bendectin and birth defects.²⁴ However, no independent experiments were conducted, nor were the experts' recalculations peer-review published.²⁵

Conversely, Merrell-Dow introduced evidence, to which Jason Daubert's experts agreed, that no peer-review published articles had "show[n] a statistically significant association between . . . Bendectin and birth defects."²⁶ Rather, all of the peer-review-published literature showed that there was no statistically significant correlation between Bendectin and birth defects.

Gauging these conflicting testimonies according to Rule 703 of the Federal Rules of Evidence,²⁷ Judge Gilliam held that the testimonies of Jason Daubert's experts were inadmissible.²⁸ Judge Gilliam reasoned that "[a] necessary predicate to the admission of scientific evidence is that the principle upon which it is based 'must be sufficiently established to have general acceptance in the field to which it belongs.'"²⁹ Insofar as the experts' recalculations were not

²³ *Id.* at 574. The expert witnesses were: (1) Dr. Adrian Gross, a licensed and accredited veterinarian with experience in pathology and toxicology; (2) Dr. Stuart Newman, a specialist in developmental biology; (3) Dr. Alan Done, a medical doctor with specialties in pediatrics, clinical pharmacology, and toxicology; (4) Dr. Shanna Swan, an epidemiologist and biostatistician practicing in the field of reproductive epidemiology; (5) Dr. Jay Glasser, a specialist in biostatistics, epidemiology, and biometry; (6) Dr. Wayne Snodgrass, an associate professor of pediatrics, and pharmacology and toxicology; (7) Dr. Johannes Thiersch, a specialist in pathology and pharmacology; and (8) Dr. John Palmer, a professor of pharmacology. *Id.*

²⁴ *Id.* at 575.

²⁵ *Id.*

²⁶ *Daubert v. Merrell Dow Pharms., Inc.*, 727 F. Supp. 570, 575 (S.D. Cal. 1989).

²⁷ FED. R. EVID. 703:

The facts or data in the particular case upon which an expert bases an opinion or inference may be those perceived by or made known to the expert at or before the hearing. If of a type reasonably relied upon by experts in the particular field in forming opinions or inferences upon the subject, the facts or data need not be admissible in evidence in order for the opinion or inference to be admitted. Facts or data that are otherwise inadmissible shall not be disclosed to the jury by the proponent of the opinion or inference unless the court determines that their probative value in assisting the jury to evaluate the expert's opinion substantially outweighs their prejudicial effect.

²⁸ *See Daubert*, 727 F. Supp. at 572 ("Unfortunately for the plaintiffs, the prevailing school of thought warrants summary judgment in this case.").

²⁹ *Id.* (citing *United States v. Kilgus*, 571 F.2d 508, 510 (9th Cir. 1978)).

peer-review published, those recalculations had not gained general acceptance and were therefore inadmissible.³⁰

Judge Gilliam's grant of summary judgment for Merrell-Dow was appealed to the Court of Appeals for the Ninth Circuit.³¹

2. Catching a *Frye* Ball

The Ninth Circuit affirmed Judge Gilliam's summary judgment ruling and held that expert evidence must meet the test set forth in *Frye v. United States*,³² namely, that expert evidence must be "generally accepted as a reliable technique among the scientific community."³³

Using language that would be a harbinger of the Supreme Court decision to follow, the Ninth Circuit expressly declined to follow conflicting Third Circuit standards insofar as the Third Circuit rejected the *Frye* "generally accepted" standard and "left open the possibility that expert testimony based on the reanalysis of epidemiological studies may be admissible if it can be shown to be reliable and not too likely to overwhelm, confuse or mislead the jury."³⁴

3. The Final Score: 7-2 Reversal by the Supremes

Having lost at the Ninth Circuit, Jason Daubert petitioned for certiorari to the Supreme Court of the United States, which the Court granted.³⁵ In setting the standard for admitting expert testimony, the Supreme Court held that the Federal Rules of Evidence superseded, rather than codified, the *Frye* "general acceptance" test.³⁶ This, the Supreme Court ruled while being cognizant of the sharp division among the courts and commentators.³⁷

³⁰ *Id.*

³¹ *Daubert v. Merrell Dow Pharms., Inc.*, 951 F.2d 1128 (9th Cir. 1991).

³² 293 F. 1013 (D.C. Cir. 1923).

³³ *Daubert*, 951 F.2d at 1129 (quoting *United States v. Solomon*, 753 F.2d 1522, 1526 (9th Cir. 1985) (citing *Frye*, 293 F. at 1014)).

³⁴ *Id.* at 1130 n.2.

³⁵ *Daubert v. Merrell Dow Pharms., Inc.*, 506 U.S. 914 (1992).

³⁶ *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 587 (1993) ("Petitioners' primary attack, however, is not on the content but on the continuing authority of the rule. They contend that the *Frye* test was superseded by the adoption of the Federal Rules of Evidence. We agree."); *id.* at 589 n.6 ("[W]e hold that *Frye* has been superseded . . .").

³⁷ *Id.* at 587 n.5 (acknowledging different positions: "*Frye* is superseded by the Rules of Evidence"; "*Frye* and the Rules coexist"; "*Frye* is dead"; and "*Frye* lives") (citations omitted).

Relevant to this paper, in construing Rules 702 and 703 of the Federal Rules of Evidence, the majority opinion recited no less than twenty-two times that these rules related to “facts.”³⁸ Never once did the Supreme Court indicate, either expressly or inferentially, that expert testimony under Rule 702 applied to purely legal issues. Indeed, the dissenting opinion expressly acknowledged that such “scientific knowledge, scientific method, scientific validity, and peer review [were] matters far afield from the expertise of judges.”³⁹

Because Rule 702 extended to “technical, or other specialized knowledge,”⁴⁰ there was little doubt that “technical, or other specialized knowledge” would also be the subject of factual inquiries.

Thus, it was clear that the sole purpose of a *Daubert* expert, under the Federal Rules of Evidence, was to “assist the trier of *fact* to understand the evidence or to determine a *fact* in issue.”⁴¹

B. The Markman Arena

*In baseball, my theory is to strive for consistency, not to worry about the numbers. If you dwell on statistics you get shortsighted, if you aim for consistency, the numbers will be there at the end.*⁴²

³⁸ The recitations can be found *id.* at 587 (“to make the existence of any fact that is of consequence”); *id.* at 588 (“assist the trier of fact”); *id.* (“to determine a fact in issue”); *id.* at 589 (“sensible triers of fact to evaluate conflicts”); *id.* (“assist the trier of fact”); *id.* (“determine a fact in issue”); *id.* at 590 (“applies to any body of known facts”); *id.* (“any body of ideas inferred from such facts”); *id.* at n.9 (“a witness who testifies to a fact which can be perceived”); *id.* at 591 (“assist the trier of fact”); *id.* (“determine a fact in issue”); *id.* (“expert testimony proffered in the case is sufficiently tied to the facts of the case”); *id.* (“aid the jury in resolving a factual dispute”); *id.* (“is a fact in issue”); *id.* (“knowledge will assist the trier of fact”); *id.* (“will not assist the trier of fact”); *id.* at 592 (“will assist the trier of fact”); *id.* (“understand or determine a fact in issue”); *id.* at 593 (“whether that reasoning or methodology properly can be applied to the facts”); *id.* (“assist the trier of fact”); *id.* at 595 (“admitted only if the facts or data are ‘of a type reasonably relied upon by experts’”); *id.* at 597 n.13 (“adjudicative factfinding”) (internal citations omitted).

³⁹ *Id.* at 599.

⁴⁰ FED. R. EVID. 702; *Daubert*, 509 U.S. at 590 n.8.

⁴¹ FED. R. EVID. 702 (emphasis added).

⁴² Baseball Almanac, Tom Seaver Quotes, http://www.baseball-almanac.com/quotes/tom_seaver_quotes.shtml (last visited Feb. 25, 2010) (quoting George Thomas “Tom” Seaver (b. 1944), World Series and Cy Young Award winning pitcher for the New York Mets).

Having established that *Daubert* relates to Rule 702 and 703 of the Federal Rules of Evidence, and that Rules 702 and 703 are directed solely to experts who “assist the trier of fact to understand the evidence or to determine a fact in issue,”⁴³ we now turn to the specific patent arena in which experts are called to testify: the *Markman* proceeding.

1. The Opening Pitch: Herbert Markman’s Invention as Seen by Judge Katz (Eastern District of Pennsylvania)

We find ourselves part way through Herbert Markman’s saga,⁴⁴ his invention having traveled, not once, but twice, through the United States Patent and Trademark Office (“USPTO”), eventually maturing into United States Reissue Patent Number 33,054 (“the ’054 patent”).⁴⁵

Herbert Markman asserted his patent against Westview Instruments, Inc. and Athlon Enterprises, Inc. (collectively, “Westview”), in the Eastern District of Pennsylvania.⁴⁶ Westview moved for a directed verdict of non-infringement following the conclusion of Herbert Markman’s case-in-chief.⁴⁷ Judge Katz deferred his ruling on Westview’s motion, and the jury eventually found that Westview infringed claims 1 and 10 of the ’054 patent.⁴⁸

Judge Katz, in a relatively unremarkable three-page order, granted Westview’s motion for a directed verdict, holding that “[t]he question of claim construction is a matter of law for the court.”⁴⁹

From this ruling, Herbert Markman appealed.

2. Firestorm of Controversy at the Court of Appeals for the Federal Circuit

Rather than assigning a panel to review Judge Katz’s three-page order, the Court of Appeals for the Federal Circuit sua sponte granted en banc review.⁵⁰

⁴³ FED. R. EVID. 702; *see also id.* R. 703 (establishing the allowable bases of experts’ opinion testimony).

⁴⁴ To avoid confusion, we use Herbert Markman’s full name to refer to the individual.

⁴⁵ *Markman v. Westview Instruments, Inc. (Markman I)*, 52 F.3d 967, 971 (Fed. Cir. 1995) (en banc), *aff’d*, 517 U.S. 370 (1996).

⁴⁶ *Markman v. Westview Instruments, Inc.*, 772 F. Supp. 1535 (E.D. Pa. 1991).

⁴⁷ *Markman I*, 52 F.3d at 973.

⁴⁸ *Id.*

⁴⁹ *Markman*, 772 F. Supp. at 1536.

⁵⁰ *Markman I*, 52 F.3d at 971 n.1.

Judge Katz's three-page order spawned almost sixty pages of sharply divided opinions from the Court of Appeals for the Federal Circuit, including the majority opinion,⁵¹ two concurring opinions,⁵² and a lone dissent.⁵³

Looking solely to the issue of claim construction, Chief Judge Archer, writing for the majority, held that "claim construction is properly viewed solely as a question of law."⁵⁴ As such, "construing and determining the scope of the claims in a patent, is strictly a legal question for the court."⁵⁵ In short, the majority held that claim construction was devoid of any factual inquiry.⁵⁶

On the other hand, according to Judge Mayer, "this court (including the judges in the majority) has always held that claim interpretation is a matter of law depending on underlying factual inquiries."⁵⁷ As such, claim construction is a legal inquiry,

except when they contain technical words, or terms of art, or when the instrument is introduced in evidence collaterally, and where its effect depends not merely on the construction and meaning of the instrument, but upon extrinsic facts and circumstances, in which case the inference to be drawn from it must be left to the jury.⁵⁸

Almost as unremarkable as Judge Katz's district court order was Judge Rader's concurrence, which noted that the fact-law issue was not before the court.⁵⁹ Thus, "[t]he court should decline to answer a question better left to a case that truly raises it, and therefore provides an informed basis for its resolution."⁶⁰

In her dissent, Judge Newman examined the history of patent law, the policy reasons supporting her dissent, and the constitutional basis for why claim interpretation "requires finding the factual meaning and scope of the terms of scientific art and technology and usage by which the patentee described and claimed the invention."⁶¹ Judge Newman expressly criticized the majority for

⁵¹ *Id.* at 970–89 (Archer, C.J., majority opinion).

⁵² *Id.* at 989–98 (Mayer, J., concurring); *id.* at 998–99 (Rader, J., concurring).

⁵³ *Markman v. Westview Instruments, Inc. (Markman I)*, 52 F.3d 967, 999–1026 (Fed. Cir. 1995) (en banc) (Newman, J., dissenting).

⁵⁴ *Id.* at 983–84 (Archer, C.J., majority opinion).

⁵⁵ *Id.* at 984.

⁵⁶ *Id.* at 987; *see also id.* at 999 (Newman, J., dissenting).

⁵⁷ *Id.* at 989 (Mayer, J., concurring).

⁵⁸ *Id.* at 997 (Archer, C.J., majority opinion) (quoting *Goddard v. Foster*, 84 U.S. 123, 142 (1872)).

⁵⁹ *Markman v. Westview Instruments, Inc. (Markman I)*, 52 F.3d 967, 998 (Fed. Cir. 1995) (en banc) (Rader, J., concurring).

⁶⁰ *Id.*

⁶¹ *Id.* at 999 (Newman, J., dissenting).

holding “that this is a matter of law, devoid of any factual component; and subject to de novo appellate determination.”⁶² As a harbinger of the topic of this paper, Judge Newman asked:

Now that the Federal Circuit holds that resolution of disputes as to the meaning and scope of technologic terms and words of art as used in a particular patent is law, not fact, removing the jury from this issue, is the trial judge excused from determining the admissibility and relevance of technologic evidence?⁶³

As one can readily discern from the split within the Federal Circuit, whether claim construction is a pure question of law, pure question of fact, or a mixed question of law and fact was thoroughly vetted by the varying opinions that were generated in *Markman I*.

To address this split, the Supreme Court of the United States granted certiorari.⁶⁴

3. Appeal Play: Unanimous 9-0 Opinion From the Supremes

In conjunction with the grant of certiorari, the Supreme Court permitted the filing of a host of amicus briefs.⁶⁵ Predictably, the amicus briefs reflected the majority, concurrence, and dissent from the Federal Circuit.

Despite this sharp division in both the Federal Circuit and the patent legal community, the Supreme Court’s decision was a unanimous 9-0 holding “that the construction of a patent, including terms of art within its claim, is exclusively within the province of the court.”⁶⁶ Thus, it became undisputed that the role of claim construction fell to the judge, and not to the jury. While it may be splitting hairs, the Supreme Court laid to rest the question of *who* construes

⁶² *Id.*

⁶³ *Id.* at 1005.

⁶⁴ *Markman v. Westview Instruments, Inc.*, 515 U.S. 1192 (1995).

⁶⁵ *Id.* In addition to the brief for Petitioners and Respondents, briefs by amicus curiae were filed by Intellectual Property Owners; United States Surgical Corporation; Douglas W. Wyatt; American Intellectual Property Law Association; the Federal Circuit Bar Association; Airtouch Communications, Inc.; Honeywell, Inc.; the American Automobile Manufacturers Association; Matsushita Electric Corp. of America and Matsushita Electric Industrial Co., Ltd.; the Dallas-Fort Worth Intellectual Property Law Association; John T. Roberts; Exxon Corp., Exxon Chemical Patents, Inc. and Exxon Research and Engineering Co.; the Association of Trial Lawyers of America; and Litton Systems, Inc. *Id.*

⁶⁶ *Markman v. Westview Instruments, Inc. (Markman II)*, 517 U.S. 370, 372 (1996).

the claims, but, arguably, the question of *whether* claim construction was a pure question of law was still unresolved.⁶⁷

This arguable ambiguity would soon be resolved by the Federal Circuit, again generating vehement dissents on the fact-law distinction.

4. Post-Game Analyses: *Cybor*, *Phillips*, and the State of Claim Construction

In 1998, shortly after the Supreme Court's ruling in *Markman II*, in another en banc ruling the majority of the Federal Circuit held that claim construction was purely a legal issue subject to de novo review on appeal.⁶⁸ Similar to *Markman I*, a highly divided Federal Circuit in *Cybor Corp. v. FAS Technologies, Inc.*⁶⁹ produced no less than six opinions, including a majority opinion,⁷⁰ two concurring opinions,⁷¹ two opinions concurring in the judgment (one of which, Judge Rader's, dissents in part), and one opinion stating "additional views" including a dissent from the majority opinion.⁷² Suffice it to say, with all of the issues thoroughly addressed en banc by the Federal Circuit, it was clear that claim construction was purely an issue of law, devoid of any factual component, to be reviewed de novo on appeal.

If *Cybor* did not create certainty that claim construction was devoid of any factual inquiry, then *Phillips v. AWH Corp.*⁷³ undoubtedly did. It is evident from the opening line of Judge Mayer's scathing dissent that the en banc appellate court thoroughly examined the issue of whether or not claim construction involved any factual inquiry: "Now more than ever I am convinced of the futility, indeed the absurdity, of this court's persistence in adhering to the falsehood that claim construction is a matter of law devoid of any factual component."⁷⁴ Hence, in view of *Markman I* and *Markman II*,⁷⁵ *Cybor*,⁷⁶ and *Phillips*,⁷⁷ and

⁶⁷ *Id.*; *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454 (Fed. Cir. 1998) (en banc) ("claim construction is purely a matter of law").

⁶⁸ *Cybor*, 138 F.3d at 1451.

⁶⁹ 138 F.3d 1448 (Fed. Cir. 1998) (en banc).

⁷⁰ *See id.* at 1451–62 (Archer, J., majority opinion).

⁷¹ *See id.* at 1462–63 (Plager, J., concurring); *id.* at 1463 (Bryson, J., concurring).

⁷² *Id.* at 1478–81 (Newman, J., additional views and dissenting in part).

⁷³ 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

⁷⁴ *Id.* at 1330 (Mayer, J., dissenting).

⁷⁵ *Markman v. Westview Instruments, Inc. (Markman II)*, 517 U.S. 370 (1996); *Markman v. Westview Instruments, Inc. (Markman I)*, 52 F.3d 967, 989 (Fed. Cir. 1995) (en banc) (Archer, C.J., majority); *id.* at 989–98 (Mayer, J., concurring); *id.* at 998–99 (Rader, J., concurring); *id.* at 999–1026 (Newman, J., dissenting).

given the thorough analysis of the issues by the Federal Circuit, it is now settled, whether for better or for worse, that claim construction is purely a legal issue, devoid of any factual component.

C. *Play Analysis: Daubert Motions*

*Swing hard, in case they throw the ball where you're swinging.*⁷⁸

In previous sections of this paper, we showed that: (a) the *Daubert* expert, under Rules 702 and 703 of the Federal Rules of Evidence, exists solely for the purpose of assisting a trier of fact to determine a fact in issue; and (b) the *Markman* proceeding involves pure questions of law and are wholly devoid of factual components. Thus, it seems axiomatic that *Daubert* experts have no role in *Markman* hearings, since experts that assist triers of fact to determine facts in issue have no role in proceedings that have no factual component.

Despite this, in patent infringement actions, parties regularly introduce expert witnesses during claim construction. Consequently, parties regularly file *Daubert* motions in attempts to disqualify their opponents' experts. Here, we digress for a moment to provide possible explanations for why litigants engage in such practices.

1. The Umpires: Approval by the Courts to Use Experts in *Markman* Proceedings

While the courts have held that claim construction is purely a matter of law, devoid of factual inquiries, they have also approved the use of experts during claim construction. For example, the Supreme Court recognized the use of experts in claim construction proceedings when it commented about “experts who testify in patent cases.”⁷⁹

⁷⁶ *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1462 (Fed. Cir. 1998) (en banc) (Plager, J., concurring); *id.* at 1463 (Bryson, J., concurring); *id.* (Mayer, J., concurring); *id.* at 1473 (Rader, J., dissenting); *id.* at 1478 (Newman, J., dissenting).

⁷⁷ *Phillips v. AWH Corp.*, 415 F.3d 1303, 1328 (Fed. Cir. 2005) (en banc) (Lourie, J., dissenting); *id.* at 1330 (Mayer, J., dissenting).

⁷⁸ QuotationsBook, <http://quotationsbook.com/quote/12120/> (last visited Feb. 26, 2010) (quoting Edwin Donald “Duke” Snider (b. 1926), Major League Baseball player).

⁷⁹ *Markman II*, 517 U.S. at 389 (“It is, of course, true that credibility judgments have to be made about the experts who testify in patent cases, and in theory there could be a case in

Having gained apparent approval from the Supreme Court, the Federal Circuit also allowed the use of “‘extraneous evidence [such as . . . expert testimony] . . . for the court’s understanding of the patent,’”⁸⁰ noting that “credibility determinations among experts ‘will be subsumed within the necessarily sophisticated analysis of the whole document.’”⁸¹ The Federal Circuit further bolstered its position by stating:

We have also held 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.⁸²

Thus, the Federal Circuit simultaneously held that “expert testimony can be useful to a court for a variety of purposes, such as . . . to establish that a particular term in the patent . . . has a particular meaning in the pertinent field,”⁸³ but “[n]othing in the Supreme Court’s opinion supports the view . . . that claim construction may involve subsidiary or underlying questions of fact.”⁸⁴

Therefore, it appears that, according to the courts, although experts may be employed in claim construction proceedings, those experts are not considered *fact* experts since claim construction does not “involve subsidiary or underlying questions of fact.”⁸⁵

Insofar as the Supreme Court and the Federal Circuit have apparently approved of claim construction experts, it is understandable how litigants would take up the courts’ invitations to engage experts for *Markman* proceedings. Additionally, since experts, in general, are addressed by Rule 702 of the Federal Rules of Evidence, one can see how *Daubert* becomes the default vehicle for litigants to oppose claim construction experts.

which a simple credibility judgment would suffice to choose between experts whose testimony was equally consistent with a patent’s internal logic.”)

⁸⁰ *Cybor*, 138 F.3d at 1455 n.3 (quoting *Markman I*, 52 F.3d at 981).

⁸¹ *Id.* at 1455 n.5 (quoting *Markman v. Westview Instruments, Inc. (Markman II)*, 517 U.S. 370, 389 (1996)).

⁸² *Phillips v. AWH Corp.*, 415 F.3d 1303, 1318 (Fed. Cir. 2005) (en banc).

⁸³ *Id.*

⁸⁴ *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1455 (Fed. Cir. 1998) (en banc).

⁸⁵ *Id.*

2. The Rule Books: Patent Local Rules Expressly Allowing Designation of Claim Construction Experts

In addition to the cases that permit expert witnesses in *Markman* proceedings, various Patent Local Rules⁸⁶ provide procedural guidelines for claim construction experts.⁸⁷ These Patent Local Rules provide a mechanism by which

⁸⁶ While some jurisdictions refer to the patent rules as “Local Patent Rules,” *see, e.g.*, N.D. ILL. LPR pmb1. (“These Local Patent Rules provide a standard structure for patent cases . . .”), other jurisdictions refer to them as “Patent Local Rules,” *see, e.g.*, E.D. TEX. P. R. 1-3 (“[A]pplying these Patent Local Rules to any pending case . . .”). For this paper, we will use “Patent Local Rules” with the understanding that the only difference in the title is stylistic and not substantive.

⁸⁷ As of March 2010, several federal district courts had adopted local patent rules, including district courts for the following districts:

- Northern District of California, *available at* [http://www.cand.uscourts.gov/CAND/LocalRul.nsf/fec20e529a5572f0882569b6006607e0/5e313c0b7e4cd680882573e20062dbcf/\\$FILE/Pat12-09.pdf](http://www.cand.uscourts.gov/CAND/LocalRul.nsf/fec20e529a5572f0882569b6006607e0/5e313c0b7e4cd680882573e20062dbcf/$FILE/Pat12-09.pdf);
- Southern District of California, *available at* <http://www.casd.uscourts.gov/uploads/Rules/Local%20Rules/LocalRules.pdf>;
- Northern District of Georgia, *available at* <http://www.gand.uscourts.gov/pdf/NDGARulesPatent.pdf>;
- Northern District of Illinois, *available at* http://www.ilnd.uscourts.gov/home/_assets/_documents/Rules/localpatentrules-preamble.pdf;
- District of Massachusetts, *available at* <http://www.mad.uscourts.gov/general/pdf/PubNotice-NewPatent-LR16.6.pdf>;
- District of Minnesota, *available at* http://www.mnd.uscourts.gov/local_rules/pdfdoc/local_rules.pdf;
- District of New Jersey, *available at* <http://www.njd.uscourts.gov/rules/BarOrd9.3.pdf>;
- Eastern District of North Carolina, *available at* <http://www.nced.uscourts.gov/Applications/FlashHelp/LocalRules.htm>;
- Southern District of Ohio, *available at* <http://www.ohsd.uscourts.gov/localrules/ohsdpatentrules.pdf>;
- Western District of Pennsylvania, *available at* <http://www.pawd.uscourts.gov/Documents/Forms/lrmanual.pdf>;
- Eastern District of Texas, *available at* <http://www.txed.uscourts.gov/Rules/LocalRules/Documents/Appendix%20M.pdf>;
- Northern District of Texas (Dallas division), *available at*

parties must identify expert witnesses, describe the substance of their experts' testimonies, and introduce live testimony during *Markman* hearings.⁸⁸

Interestingly, some of the Patent Local Rules distinguish between claim construction experts and non-claim construction experts.⁸⁹ As such, while it appears that these Patent Local Rules treat non-claim construction experts as guided by the *Daubert* standard, it is unclear whether that same standard applies to claim construction experts.

In any event, given that such a mechanism exists in the Patent Local Rules to introduce expert testimony in *Markman* proceedings, it is not surprising that litigants exploit this opportunity. Also, since some of the Patent Local Rules do not distinguish between claim construction experts and other experts, it

http://www.txnd.uscourts.gov/pdf/misc_orders/misc62_11-17-09.pdf;

- Southern District of Texas, *available at* <http://www.txs.uscourts.gov/district/rulesproc/patent/rules.pdf>;
- Western District of Washington, *available at* <http://www.wawd.uscourts.gov/documents/HomePageAnnouncements/2009%20Local%20Rules/Patent%20Rules%20-%20final.pdf>.

Additionally, individual sitting judges have also implemented their own Patent Local Rules, including:

- The Hon. Charles A. Shaw (Eastern District of Missouri), *available at* <http://www.moed.uscourts.gov/judges/cas.html>;
- The Hon. C. Lynwood Smith, Jr. (Northern District of Alabama), *available at* <http://www.alnd.uscourts.gov/Smith/7-28-06%20Patent%20Rules.pdf>.

⁸⁸ N.D. CAL. PATENT L.R. 4-2(b), -3(b), -3(e); S.D. CAL. PATENT L.R. 4.1.b, .1.d, .2.a, .2.c.2 (proposed 2006); N.D. GA. PATENT L.R. 6.2(b), 6.3(b)(2), (b)(4); N.D. ILL. LPR 4.2(a), (c); D. MASS. L.R. 16.6(A)(3)(a), 16.6 app. (B)(4)(a),(b); LOCAL PATENT RULES 304.2(b), 304.3(b), (d), EDNC; D.N.J. L. Pat. R. 4.2(b), 4.3(b), (e), 4.5(c); W.D. PA. LPR 4.3 ¶¶ 2, 4; E.D. TEX. P. R. 4-2(b), 4-3(b), (d); N.D. TEX. P. R. 4-2(b), 4-3(b), (d); S.D. TEX. P. R. 4-2(b), 4-3(a)(2), (a)(4), (b); W.D. WASH. LOCAL PATENT RULES 131(b), 132(f).

⁸⁹ See N.D. GA. PATENT L.R. 7.1(a) (“For issues other than claim construction to which expert testimony shall be directed, expert witness disclosures and depositions shall be governed by this rule.”); D. MASS. LOCAL RULE 16.6 app. (E)(2) (“If expert discovery has been substantially conducted before a claim construction ruling, then the Court may grant additional time for supplemental expert discovery. Such additional discovery shall be limited to issues of infringement, invalidity, or unenforceability dependent on the claim construction.”); LOCAL PATENT RULE 305.1(a), EDNC (“For issues other than claim construction to which expert testimony shall be directed, expert witness disclosures and depositions shall be governed by this rule.”); W.D. PA. LPR 5.1 ¶ 1 (“For issues other than claim construction to which expert testimony shall be directed, expert witness disclosures and depositions shall be governed by this Rule.”).

is understandable why litigants ubiquitously employ *Daubert* motions for both claim construction experts and non-claim construction experts.

D. Home Run (Rule 402) v. Triple (Daubert)

*I don't know why people like the home run so much. A home run is over as soon as it starts. The triple is the most exciting play of the game. A triple is like meeting a woman who excites you, spending the evening talking and getting more excited, then taking her home. It drags on and on. You're never sure how it's going to turn out.*⁹⁰

Having conjectured on why parties employ claim construction experts, we now turn to several examples of how litigants have used *Daubert* motions in their attempts to disqualify claim construction experts. Before doing so, we note that this paper is not intended to provide an exhaustive analysis of all cases where *Daubert* motions have been filed in *Markman* hearings.⁹¹ As such, we select only a handful of cases to illustrate our point.

Also, in many of these cases, the motions to strike included more than substantive *Daubert* analyses. Many times, these motions also included procedural reasons to strike expert witnesses, such as timing issues, notice issues, and other violations of the Federal Rules of Civil Procedure, Patent Local Rules, or scheduling orders. Insofar as this paper relates to *Daubert* issues in *Markman* hearings, we do not address any of the procedural arguments that are advanced by the litigants in these cases.

After reviewing examples of existing *Daubert* practice, we examine how a Rule 402 motion may be a more appropriate vehicle to oppose a *Daubert* expert in *Markman* proceedings. With this said, we now turn to several examples in which *Daubert* motions were used in the context of *Markman* proceedings.

⁹⁰ Baseball Almanac, George Foster World Series Stats, <http://www.baseball-almanac.com/players/playerpost.php?p=fostege01&ps=> (last visited Feb. 26, 2010) (quoting George Arthur Foster (b. 1948), Major League Baseball player).

⁹¹ But see cases cited *supra* note 14 for an extensive list. However, only a handful of those cases are analyzed in this paper because a similar analysis can be applied to those above-cited-but-not-specifically-analyzed cases.

1. Out in Left Field: The *Daubert* Motion

The first set of cases examined exemplifies the typical *Daubert* attack based on: (a) the reliability of an expert's testimony;⁹² (b) the "fit" between the expert's testimony and the issue at hand;⁹³ or (c) both reliability and "fit."

In *Flo Healthcare Solutions, LLC v. Rioux Vision, Inc.*,⁹⁴ the plaintiff Flo used the first prong of *Daubert*, namely, the reliability prong, in its memorandum arguments against the defendant's expert witness, John Morrow.⁹⁵ Flo opposed the defendant's expert by attacking the expert's methodology to construe the claims.⁹⁶ In particular, the plaintiff argued that, since claim construction requires consultation of the specification to determine the true meaning of the claims, "failing to consider the teachings of the specification render[ed] any proposed claim constructions inherently flawed."⁹⁷ In short, "[d]espite the clarity with which the Federal Circuit has outlined the claim construction process, [the defendant's expert] did not follow it."⁹⁸ As such, according to the plaintiff, "[the expert's] claim construction methodology [wa]s contrary to law and, therefore, unreliable."⁹⁹

The defendant in *Mannatech, Inc. v. Glycobiotics International, Inc.*¹⁰⁰ also used the reliability prong of *Daubert* to attack the expert's methodology. In doing so, the defendant first identified the proper legal standard for expert testimony by noting:

Daubert and *Kumho* make it clear the Court must insure that any expert follows an acceptable methodology in arriving at his opinion. In the case of claim construction in patent infringement cases, the Federal Circuit's opinion in *Phillips* provides that methodology, a conclusion that is supported by the

⁹² See *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 589–90 (1993) (requiring expert testimony to be based on scientific methods and procedures supporting knowledge beyond "subjective belief or unsupported speculation").

⁹³ *Id.* at 591–92 (noting that expert testimony must assist the trier of fact, i.e., it must be helpful).

⁹⁴ No. 1:06-CV-2600-TWT, 2007 WL 4200678 (N.D. Ga. Nov. 16, 2007).

⁹⁵ Memorandum in Support of Plaintiff Flo Healthcare Solutions, LLC's Motion in Limine to Strike the Reports and Testimony of Defendant Rioux Vision Inc.'s Technical Expert, John L. Morrow at 18, *Flo Healthcare Solutions, LLC v. Rioux Vision, Inc.*, No. 1:06-vc-2600-TWT (N.D. Ga. Aug. 14, 2008), 2008 WL 5371824.

⁹⁶ *Id.*

⁹⁷ *Id.* at 21.

⁹⁸ *Id.* at 22.

⁹⁹ *Id.* at 25.

¹⁰⁰ 513 F. Supp. 2d 754 (N.D. Tex. 2007).

Plaintiff's arguments in opposition to the Defendant's *Markman* construction.¹⁰¹

From there, the defendant moved to strike all four of the plaintiff's experts because each respective expert had "not relied on any part of the prosecution history of the patent to obtain his opinion; a step in the methodology step clearly required by *Phillips*,"¹⁰² "ignore[d] the prosecution history of the patent and jump[ed] directly to extrinsic evidence, all in violation of the teachings of *Phillips*,"¹⁰³ "failed to arrive at his own independent opinion,"¹⁰⁴ and "filed [sic] to follow [*Phillips*'s] methodology."¹⁰⁵

In *Nidec Corp. v. Victor Co. of Japan, Ltd.*,¹⁰⁶ defendant JVC Components Co., Ltd. ("JVC") moved to exclude the plaintiff's expert, Dr. Bogy, based on the second prong of *Daubert*, namely for lack of helpfulness or "fit."¹⁰⁷ JVC did so by first fashioning a denominator problem (i.e., defining the technical area of the patent, defining Dr. Bogy's background, and showing that the two did not overlap).¹⁰⁸ From this, JVC argued that "the portions of the Bogy Report outside Dr. Bogy's qualifications should be stricken"¹⁰⁹ because Dr. Bogy did

¹⁰¹ Defendant's Motion to Strike the Expert Reports and Testimony of Plaintiff's Expert Witness Garold S. Yost, Mark Tengler, Robert P. Blackburn and Bill McAnalley and Brief In Support at 7, *Mannatech, Inc. v. Glycobiotics Int'l, Inc.*, 513 F. Supp. 2d 754 (N.D. Tex. May 16, 2007) (No. 3-06-CV-0471-BD), 2007 WL 5263166.

¹⁰² *Id.* at 9 (arguing to disqualify expert Yost).

¹⁰³ *Id.* (arguing to disqualify expert Tengler).

¹⁰⁴ *Id.* at 10 (arguing to disqualify expert Blackburn).

¹⁰⁵ *Id.* at 12 (arguing to disqualify expert McAnalley).

¹⁰⁶ No. C-05-0686 SBA (N.D. Cal. Nov. 16, 2007).

¹⁰⁷ See Notice of Motion, Motion, and Memorandum of Points and Authorities in Support of JVC's Motion to Strike Portions of the Declaration of David B. Bogy, Ph.D. at 7, *Nidec Corp. v. Victor Co. of Japan*, No. 4:05-cv-00686 SBA (N.D. Cal. June 2, 2006), 2006 WL 5646070 [hereinafter *Nidec Corp.*, Motion to Strike] (juxtaposing the technical area of the patent and the expert's area of expertise); see also *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 591–92 ("Rule 702's 'helpfulness' standard requires a valid scientific connection to the pertinent inquiry as a precondition to admissibility.").

¹⁰⁸ *Nidec Corp.*, Motion to Strike, *supra* note 107, at 7. The motion asserted:

While Dr. Bogy may be an experienced scholar with an impressive background in the fields of data storage systems, tribology (i.e., the science of interacting surfaces moving in relation to each other), and the head-disc interface of a hard disc drive, his knowledge, skill, experience, training, or education does not extend into the spindle motor of a hard disc drive and the fluid dynamic bearing within.

Id.

¹⁰⁹ *Id.* at 9.

not “provid[e] any independent reasoned explanation or even cit[e] supporting evidence, including the ’476 Patent.”¹¹⁰ Those statements, argued JVC, were “precisely the sort of conclusory, unsupported assertions that the *Phillips* Court cautioned would not be helpful to a court.”¹¹¹

In all of these cases, the litigants: (a) properly cited *Daubert*’s requirement that the expert testimony must assist the trier of *fact* to determine a *fact* in issue; and, also, (b) properly cited *Markman* for the proposition that claim construction is *purely a matter of law*. Oddly, the litigants nevertheless employed *Daubert* motions—to exclude experts that assist the trier of *fact*—when the arbiter in the *Markman* context is not a trier of fact.

2. Pinch Hitter: Enter, the Rule 402 Motion

Given this distinction between fact and law, it seems evident that *Daubert* motions are improper mechanisms by which to oppose claim construction experts. Indeed, experts who assist triers of fact cannot have a role in proceedings that are wholly devoid of factual inquiries. Thus, should a litigant seek to introduce a Rule 702 expert during *Markman* proceedings, we suggest that a more appropriate vehicle for challenging the expert is a Rule 402 motion for irrelevance, rather than a *Daubert* motion.

Rule 402 of the Federal Rules of Evidence recites: “All relevant evidence is admissible, except as otherwise provided by the Constitution of the United States, by Act of Congress, by these rules, or by other rules prescribed by the Supreme Court pursuant to statutory authority. *Evidence which is not relevant is not admissible.*”¹¹²

As previously established, the *Markman* proceeding requires the court—not the jury—to determine a purely *legal* issue, devoid of any factual component.¹¹³ *Daubert*, on the other hand, addresses experts that “assist the trier of *fact* . . . to determine a *fact* in issue.”¹¹⁴ Thus, if an expert is testifying to facts during a *Markman* proceeding, then that testimony is irrelevant and, consequently, inadmissible under Rule 402.¹¹⁵

By way of example, a Rule 402 motion argument could be structured as follows:

¹¹⁰ *Id.* at 10.

¹¹¹ *Id.*

¹¹² FED. R. EVID. 402 (emphasis added).

¹¹³ *See supra* Part III.B.

¹¹⁴ FED. R. EVID. 702 (emphasis added).

¹¹⁵ FED. R. EVID. 402 (“Evidence which is not relevant is not admissible.”).

- (a) PARTY designates EXPERT as an expert witness under Rule 702 to assist a trier of fact to determine a fact in issue;
- (b) Claim construction is purely a legal issue, devoid of any factual component;
- (c) Insofar as EXPERT's role is to assist a trier of fact, and insofar as claim construction is wholly devoid of factual issues, EXPERT's testimony is irrelevant;
- (d) Since EXPERT's testimony is irrelevant, it must be stricken as required by Fed. R. Evid. 402.

The Rule 402 motion for relevance *vel non* is simpler and more elegant than the cumbersome *Daubert* motion. Additionally, due to the non-overlapping fact-law arenas, the Rule 402 motion is a more appropriate vehicle than a *Daubert* motion to oppose a fact expert in *Markman* proceedings.

3. Too Close to Call: Right for the Wrong Reason (Rule 402 Motion Disguised as a *Daubert* Motion)

Having reviewed some of the conventional *Daubert* motions, we now turn to one case where the movant used a Rule 402 motion masquerading as a *Daubert* motion.

Defendant LG Electronics, Inc. ("LGE"), in *Hitachi Plasma Patent Licensing Co. v. LG Electronics, Inc.*,¹¹⁶ moved to disqualify Hitachi's expert, Dr. Silzars, noting that "*Daubert* requires that an expert's testimony assist the trier of fact to understand a fact at issue."¹¹⁷ LGE continued, "[d]eclaring that LGE's constructions are right or wrong is a legal conclusion Dr. Silzars is not qualified to make, and is not helpful to the Court."¹¹⁸ Hence, LGE concluded, "under Fed. R. Evid. 702 and *Daubert* Dr. Silzars's declaration should be stricken."¹¹⁹

This simple argument advanced by LGE is, in substance, a Rule 402 motion. Rearranging LGE's argument, we have the following:

¹¹⁶ No. 2:07-CV-155 (CE), 2009 WL 1292820 (E.D. Tex. May 7, 2009).

¹¹⁷ Defendants LG Electronics, Inc. and LG Electronics U.S.A., Inc.'s Motion to Strike and Objection to HPPL's Second Declaration of Aris Silzars at 6, *Hitachi Plasma Patent Licensing Co. v. LG Elecs., Inc.*, No. 2:07-CV-155-CE (E.D. Tex. Feb. 10, 2009), 2009 WL 412359 [hereinafter *Hitachi*, Motion to Strike] (citing *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 591 (1993); FED. R. EVID. 702).

¹¹⁸ *Id.*

¹¹⁹ *Id.*

- (a) The meaning of a claim term is a legal conclusion;¹²⁰
- (b) Dr. Silzar is not qualified to make this legal conclusion;¹²¹
- (c) Hence, Dr. Silzar's declaration should be stricken.¹²²

As one can see, the structure and substance of LGE's argument mimics that of the Rule 402 argument set forth above. The only difference between the Rule 402 motion and LGE's motion is that LGE cited to *Daubert*, rather than to Rule 402.

Compared to conventional *Daubert* motions,¹²³ LGE's "disguised" 402 motion obviates the need for any technical analysis, thereby simplifying the argument.

4. Double Play: *Daubert* "Plus"

LGE is not the only litigant to have used a disguised Rule 402 motion. In *Kai U.S.A., Ltd. v. Buck Knives, Inc.*,¹²⁴ both parties used traditional *Daubert* arguments in addition to arguments sounding like Rule 402 arguments. However, similar to LGE, neither Kai nor Buck cited Rule 402. Instead, their arguments were advanced under Rule 701.

In this hotly contested case dealing with cutting-edge knife technology, the plaintiff Kai filed its motion first.¹²⁵ In advancing its argument, Kai initially attacked the reliability of the opinion of Buck's expert, Professor Dornfeld. Specifically, Kai noted that, "Prof. Dornfeld's opinion makes no effort to ascertain the level of ordinary skill in the art of knife design and manufacture according to any of the relevant considerations listed by the Federal Circuit. Thus, it is

¹²⁰ See *id.* ("Declaring that LGE's constructions are right or wrong is a legal conclusion . . .").

¹²¹ See *id.* ("[Claim construction] is a legal conclusion Dr. Silzars is not qualified to make . . .").

¹²² See *id.* ("Dr. Silzars's declaration should be stricken.").

¹²³ See *supra* Part III.C.

¹²⁴ No. CV 05-446-HA, 2006 WL 314456 (D. Or. Feb. 9, 2006).

¹²⁵ Plaintiff and Counterdefendant Kai U.S.A. Ltd., dba Kershaw Knives' Memorandum in Support of Motion to Strike Dornfeld Declaration Filed in Support of Defendant Buck Claim Construction, *Kai U.S.A., Ltd. v. Buck Knives, Inc.*, No. CV 05-446-HA, 2006 WL 314456 (D. Or. Feb. 9, 2006), 2005 WL 6159110 [hereinafter *Kai*, Motion to Strike Declaration in Support of Buck Claim Construction].

conclusory, speculative and unreliable, and should be stricken on this basis as well.”¹²⁶

After advancing this traditional unreliability argument under the first prong of *Daubert*, Kai proceeded with its irrelevance argument. Similar to LGE, Kai did not cite Rule 402, but instead cited Rule 701, arguing: “Prof. Dornfeld’s declaration and curriculum vitae contain no education or experience in patent law. Nevertheless, Prof. Dornfeld offers testimony in his declaration which opines on conclusions of patent law. Prof. Dornfeld’s declaration is filled with statements that opine on the correct claim construction.”¹²⁷

Having argued that Prof. Dornfeld was not an expert on patent law, Kai continued:

Legal conclusions regarding claim construction are not within the personal knowledge or experience of Prof. Dornfeld. The Federal Circuit has decisively held that such testimony is entitled to no weight, as claim construction is an issue of law solely in the province of the court. As such, his testimony on such issues cannot be used to support Buck’s claim construction arguments and should be stricken.¹²⁸

When condensed into its essence, Kai’s Rule 701 argument is:

- (a) Professor Dornfeld is not an expert on patent law;¹²⁹
- (b) The meaning of a claim term is a legal conclusion;¹³⁰

¹²⁶ *Id.* at 8–9. It is worthwhile to note that, in addition to making this argument in its opening brief, Kai regurgitated, verbatim, this same argument with reference to Buck’s opposition to Kai’s claim construction. Plaintiff and Counterdefendant Kai U.S.A. Ltd., dba Kershaw Knives’ Memorandum in Support of Motion to Strike Dornfeld Declaration Filed in Support of Defendant Buck’ Opposition to Kershaw Claim Construction at 1, Kai U.S.A., Ltd. v. Buck Knives, Inc., No. CV 05-446-HA, 2006 WL 314456 (D. Or. Feb. 9, 2006), 2005 WL 6157641 [hereinafter, *Kai*, Motion to Strike Declaration in Support of Opposition to Kershaw Claim Constuction].

¹²⁷ *Kai*, Motion to Strike Declaration in Support of Buck Claim Construction, *supra* note 125, at 14. This same argument was, again, made by Kai with reference to Buck’s opposition. *See Kai*, Motion to Strike Declaration in Support of Opposition to Kershaw Claim Constuction, *supra* note 126, at 1.

¹²⁸ *Kai*, Motion to Strike Declaration in Support of Buck Claim Construction, *supra* note 125, at 16 (internal citation omitted); *see also Hitachi*, Motion to Strike, *supra* note 117, at 6 (“Declaring that LGE’s constructions are right or wrong is a legal conclusion Dr. Silzars is not qualified to make, and . . . [it] should be stricken.”).

¹²⁹ *Kai*, Motion to Strike Declaration in Support of Buck Claim Construction, *supra* note 125, at 14 (“Prof. Dornfeld’s declaration and curriculum vitae contain no education or experience in patent law.”).

¹³⁰ *Id.* at 16 (“[C]laim construction is an issue of law solely in the province of the court.”).

- (c) Professor Dornfeld is not qualified to make this legal conclusion;¹³¹
- (d) Hence, Professor Dornfeld's declaration should be stricken.¹³²

Ignoring Kai's *Daubert* unreliability argument for a moment, it is evident that Kai's irrelevance argument falls under Rule 402 more so than it does under Rule 701.

Not to be outdone by Kai, Buck also moved to disqualify Kai's expert witnesses.¹³³ However, Buck proceeded with a traditional *Daubert* analysis, without advancing any irrelevance arguments. As such, we refrain from commenting on Buck's motion here.

Having seen both LGE and Kai's irrelevance analyses, even though neither cited Rule 402, one can readily appreciate that the irrelevance arguments are appealing for their simplicity and their lack of technical jargon. As such, we submit that the Rule 402 motion, rather than a complicated and unnecessary *Daubert* motion, is the proper mechanism for disqualifying Rule 702 fact witnesses¹³⁴ from *Markman* proceedings which are devoid of any factual component.¹³⁵

IV. CONCLUDING REMARKS

*Why does everybody stand up and sing "Take Me Out to the Ballgame" when they're already there?*¹³⁶

¹³¹ *Id.* ("Legal conclusions regarding claim construction are not within the personal knowledge or experience of Prof. Dornfeld.")

¹³² *Id.* ("As such, his testimony on such issues cannot be used to support Buck's claim construction arguments and should be stricken.")

¹³³ Defendant Buck Knives Inc.'s Memorandum in Support of Motion to Strike Declaration of Louis Sal Glessner at 3–4, *Kai U.S.A., Ltd. v. Buck Knives, Inc.*, No. CV 05-446-HA, 2006 WL 314456 (D. Or. Feb. 9, 2006), 2005 WL 6159138.

¹³⁴ *See* FED. R. EVID. 702 (predicating the admissibility of expert testimony on its ability to "assist the trier of fact").

¹³⁵ *See* *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1455 (Fed. Cir. 1998) ("Nothing in the Supreme Court's opinion supports the view that . . . claim construction may involve subsidiary or underlying questions of fact.")

¹³⁶ Welcome to The Quote Garden, World Series Quotations, <http://www.quote-garden.com/world-series.html> (last visited Feb. 26, 2010) (quoting Larry Eugene Andersen (b. 1953), Major League Baseball player).

In this paper, we have reviewed both the history and progeny of the Supreme Court's decision in *Markman v. Westview Instruments, Inc.* Irrespective of whether or not the judiciary reached the right decision, the clear holding from *Markman I* and *II* and its progeny is that claim construction is purely a legal exercise, devoid of any factual inquiry.

We have also analyzed the history of the Supreme Court's decision in *Daubert v. Merrell Dow Pharmaceuticals, Inc.* The unambiguous language of Rule 702, and the clear holding in *Daubert*, leads us to the conclusion that a *Daubert* expert exists to "assist the trier of *fact* to understand the evidence or to determine a *fact* in issue."¹³⁷

Since *Markman* hearings are purely legal hearings, which are devoid of any factual component, it seems axiomatic that opinions on factual matters by experts have no place in *Markman* proceedings. Yet, contrary to this axiom, patent litigants routinely challenge claim construction experts through *Daubert* motions.

We posit in this paper that, since *Markman* proceedings are wholly devoid of factual inquiries, fact experts are wholly irrelevant to *Markman* proceedings. As such, *Daubert* motions, which deal with experts that "assist the trier of *fact* to understand the evidence or to determine a *fact* in issue,"¹³⁸ are the improper vehicle for opposing claim construction experts.

If the purpose of a litigant's expert witness is to assist a trier of fact, then filing a *Daubert* motion in a *Markman* hearing—when the *Daubert* expert should be inadmissible under Rule 402—is akin to fans singing "Take Me Out to the Ballgame" when the fans are already there.

Predictably, tradition will dictate that fans continue to sing "Take Me Out to the Ballgame" when they are already at the ballgame. Similarly, habit will dictate that patent litigants continue to use *Daubert* motions to oppose experts in *Markman* proceedings.

¹³⁷ FED. R. EVID. 702 (emphasis added).

¹³⁸ *Id.* (emphasis added).