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The Application of Collateral Estoppel to *Markman* Rulings: The Search for Logical and Effective Preclusion of Patent Claim Constructions

*Timothy Le Duc*

INTRODUCTION

In *TM Patents, L.P. v. IBM Corp.*, the Southern District Court of New York had the opportunity to promulgate the appropriate preclusion standard for patent claims interpreted in previous litigation. Numerous district courts have found the creation of an effective and logical set of preclusion standards for prior *Markman* rulings an extremely difficult task. The *TM Patents* decision, which held that collateral estoppel applied to prior patent claim construction, was quickly criticized. For example, in *Graco Children’s Products v. Regalo Int'l LLC*, the Eastern District Court of Pennsylvania refused to follow the reasoning or holding of the *TM Patents* court. The court in *Graco* held that to bind a party to a prior court ruling where that party did not have an opportunity or an incentive to appeal is unjust. This view sharply contrasts with the rationale behind the *TM Patents* decision, which defers to

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1. 72 F. Supp. 2d 370 (S.D.N.Y. 1999). The court held that the earlier resolution of specific patent claims by another court, during a *Markman* hearing in which the patent holder was afforded a full and fair opportunity to litigate the meaning of the claims, was binding on the patent holder in the subsequent litigation. It did not matter that the parties settled during trial. See id. at 375.

2. See id. at 375.

3. See *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). The Supreme Court held that the construction of a patent claim is a question of law to be determined by the judge, not a question of fact to be determined by a jury. See id. at 391. See also *infra* notes 50-52 and accompanying text.


6. See id. at 663-65.

7. See id. at 664-65.
judicial economy and the mitigation of unnecessary litigation.\textsuperscript{8}

The weighing of justice and judicial economy has rendered a divisive split between the lower courts concerning whether collateral estoppel should apply to Markman rulings.\textsuperscript{9}

This Note seeks to support the Eastern District Court of Pennsylvania’s holding in Graco,\textsuperscript{10} along with other recent rulings that support that court’s reasoning and disagree with the TM Patents decision, and urges that the blanket application of collateral estoppel to patent claim construction of previous litigation is unjustified and illogical. Part I establishes the relevant background of issue preclusion and patent claim construction law. Part I also discusses the history and holdings of TM Patents and Graco. Part II analyzes the two holdings with respect to recent decisions. In addition, Part II discusses possible solutions to resolve the current, increasing division of authority.

Although TM Patents does contain significant policy justifications, this Note concludes that the TM Patents court has generated a significant legal controversy by promulgating ineffective and unjust law. If followed, TM Patents will increase rather than reduce litigation, further burdening the judicial system. This is exactly the opposite of that decision’s objective. Accordingly, this Note encourages the adoption of the well-reasoned principles for which the Graco decision stands. The Note concludes that in order to strike an appropriate balance between judicial economy and fundamental fairness, collateral estoppel of Markman rulings should only apply if interlocutory appeals-of-right are available to the parties of the previous litigation.

\textsuperscript{8} See TM Patents, 72 F. Supp. 2d at 376.


\textsuperscript{10} See Graco Children’s Prods., 77 F. Supp. 2d 665 (holding that collateral estoppel will not apply to Markman rulings of prior litigation whose final decision was precluded by settlement).
I. BACKGROUND

A. THE DOCTRINE OF COLLATERAL ESTOPPEL

Issue preclusion, otherwise referred to as collateral estoppel, prevents parties from contesting matters litigated and decided during prior litigation. There are four requirements that must be met before collateral estoppel applies. “First, the issues raised in both proceedings must be identical.” Second, during the prior proceeding, the issue must have been fully litigated and decided. Third, the party against whom estoppel is to be applied must have had a full and fair opportunity to litigate the issue in a previous proceeding. Fourth, resolution of the issue must have been essential to a final and valid judgment on the merits. The doctrine is to promote judicial economy by precluding relitigation of previously decided issues, and the court has some discretion in determining whether issue preclusion is appropriate. However, the application of collateral estoppel is not proper where it would be unfair to either party.

One of the leading patent claim construction cases dealing with collateral estoppel is *A.B. Dick Co. v. Burroughs Corp.* The court in *A.B Dick* declined to give preclusive effect to statements it had made in previous litigation concerning the

11. See *TM Patents*, 72 F. Supp. 2d at 375.
12. Id.
13. See id.
14. See id.
15. See id. (citing Cent. Hudson Gas & Elec. Corp. v. Empresa Naviera Santa, 56 F.3d 359, 368 (2d Cir. 1995)).
18. See id. “For example, offensive use of collateral estoppel, where a plaintiff seeks to estop a defendant from relitigating issues the defendant previously litigated and lost against another plaintiff, should not be allowed where it would be unfair to the defendant.” Id. (citing Parklane Hosiery, 439 U.S. at 331).
19. Id.
It reasoned that those statements were not essential to the previous litigation’s outcome and therefore they should not be given preclusive effect in the subsequent action. The court was also convinced that it would be unfair to give a claim construction ruling, unessential to the final judgment, collateral estoppel effect. After completing a lengthy balancing test of various factors for and against issue preclusion of prior claim construction, the court concluded that judicial statements pertaining to the scope of the patent should be narrowly construed. Additionally, the court stated that statements would be granted preclusive effect in subsequent litigation only if the determination of the breadth of the claims was essential to a final judgment, either on the question of infringement or validity, in that prior litigation. Thus, broad statements regarding the scope of the patent that are inessential to a final judgment do not receive preclusive effect.

B. PATENT CLAIM CONSTRUCTION AND MARKMAN RULINGS

The question of whether the interpretation of a patent claim is a matter of law or fact was decided by the Supreme Court in the landmark decision *Markman v. Westview Instruments, Inc.* Congress is empowered by the Constitution to further the progress of science by granting inventors the exclusive right to economically exploit their innovations for a limited time. Accordingly, Congress exercised this authority...
in 1790 by granting "inventors 'the right to exclude others from making, using, offering for sale, selling, or importing the patented invention' in exchange for full disclosure of an invention." 

In general, a patent must define the exact scope of an invention and its manufacture. This is designed to secure for the inventor all to which he is entitled and to provide the public with notice of what subject matter is still available for the taking. These dual objectives have come to be served by two separate components of a patent document. First, the specification of a patent describes the invention in clear and concise language such that one skilled in the art is able to make the same invention. Second, a patent document includes one or more claims which specifically detail the subject matter that the prospective patentee regards as the innovation. The claims define the scope of the patent grant and forbid the precise copying of an invention. Also forbidden as infringement are products that make trivial changes so that they effectively duplicate the previous invention without copying the literal language of the previous claim. Patent lawsuits normally charge infringement. To obtain relief, the patent holder must prove that his "patent claim covers the alleged infringer's product or process." Thus, in order to prove infringement, it is necessary to first determine the meaning and the scope of the claim language.

The Court in Markman addressed whether patent claim construction is a question of law or fact. Previously, "issues of claim construction were submitted to a jury." The right of trial by jury, guaranteed by the Seventh Amendment, existed during the colonial era under English common law.
“no exact antecedent” in old English common law for modern patent claim construction, the Court determined that the best eighteenth century analogue was the old practice for the construction of patent specifications. The limited number of patent cases available from that period do not reveal a well-established jury practice of specification interpretation that would allow one to conclude that modern claim construction should be a guaranteed jury issue. A judge, more than a jury that may capriciously construe or refine the patent, is qualified with his legal training and experience to properly construct extremely technical patents. Finally, the Court stressed that the consistent and uniform treatment of a particular patent was significant enough to independently justify claim interpretation as an issue of law. The Court also noted that to encourage such uniformity, Congress established the Federal Circuit Court of Appeals as the sole appellate court trial by jury is the right which existed under the English common law when the Amendment was adopted.” Id. The Court reasoned that the answer to the question of if the issue were one of law or fact depends “on whether the jury must shoulder this responsibility as necessary to preserve the ‘substance of the common-law right of trial by jury.’” Id. at 377 (quoting Colgrove v. Battin, 413 U.S. 149, 157 (1973) (internal citation omitted)).

40. Id. at 378.
41. See id. at 379. The Court compared “the modern practice to earlier ones whose allocation to court or jury we do know” of and sought to draw “the best analogy . . . between an old and . . . new” practice. Id. at 378.
42. See id. at 379-380. The Court found a “mere smattering of patent cases” available from that period. Id.
43. See id. at 383. Also, the judge “is in a better position to ascertain whether an expert’s proposed definition fully comports with the instrument as a whole.” Id. at 371. The patent, “like other written instruments . . . must be interpreted as a whole . . . and the legal deductions drawn therefrom must be conformable with the scope and purpose of the entire document.” Brown v. Huger, 62 U.S. 305, 318 (1858).
44. See id. at 371.
45. See Markman, 517 U.S. at 390. The Court focused on “the importance of uniformity in the treatment of a given patent as an independent reason to allocate all issues of construction to the court.” Id. The Court reasoned that the “limits of a patent must be known for the protection of the patentee, the encouragement of inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public.” Id. (quoting General Elec. Co. v. Wabash Appliance Corp., 304 U.S. 364, 369 (1938)). The Court also noted 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.” Id. (quoting United Carbon Co. v. Binney & Smith Co., 317 U.S. 228, 236 (1942)). Also, the “public [would] be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights.” Id. (quoting Merrill v. Yeomans, 94 U.S. 568, 573 (1877)).
for patent litigation and observed that greater uniformity would strengthen the patent system by fostering industrial innovation and technological growth. Therefore, the Court concluded that the extensive interpretive skill of judges, policy considerations, and existing precedent all supported the allocation of modern claim construction to the court. Thus, the Court held that claim construction is a question of law, solely for the court to determine, while the issue of infringement remains a question of fact.

After the Markman decision, patent claim construction became a question of law to be determined by the court. Normally, the parties litigate the claim interpretation issues before trial, which allows the court, at the outset of the suit, to instruct the jury as to the scope of the patent claims. A court’s decision on the construction of the patent claims is now appropriately known as a Markman ruling or order.

C. TM PATENTS, L.P. V. IBM CORP.

In TM Patents, L.P. v. IBM Corp, the plaintiffs were successors-in-interest to the patent estate of Thinking Machines Corporation (TM), “a developer and manufacturer of computers and peripheral computer equipment.” The plaintiffs brought suit against defendant IBM, alleging infringement of three of TM’s patents by IBM products. Two of the patents related to computer data storage technologies and data error detection and correction. The third patent dealt with a communications routing strategy in parallel

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46. See id.
47. See id. (referring to H.R. Rep. No. 97-312, at 20 (1981)).
48. See id. at 371.
49. See id. at 370-71. The Court held that the “construction of a patent, including terms of art within its claim,” is a question of law, “exclusively within the province of the court.” Id at 370. However, the issue of “whether infringement occurred, is a question of fact for a jury.” Id. at 371.
50. See TM Patents, 72 F. Supp. 2d at 376.
51. See id.
52. See id.
54. Id. at 374
55. See id.
56. See id. (United States Patent No. 4,899,342 (the ’342 patent) and United States Patent No. 5,202,979 (the ’979 patent)).
processors.\textsuperscript{57} The district court recognized that the action against IBM was not the first infringement action pertaining to the patents-in-suit to reach the point of a Markman hearing.\textsuperscript{58} Previously, TM had sued EMC Corporation, a competitor of IBM, in the District Court for the District of Massachusetts, a case heard by Chief Judge William G. Young.\textsuperscript{59} In a Markman hearing, Chief Judge Young construed some, but not all, of the disputed claims.\textsuperscript{60} After a two day hearing, Judge Young issued his ruling.\textsuperscript{61}

IBM asserted in the case against TM that TM was collaterally estopped from relitigating the previous claim interpretation.\textsuperscript{62} TM, on the other hand, argued that the previous Markman ruling, although substantially correct, should not “be accorded former adjudication effect.”\textsuperscript{63} TM reasoned that this was the correct result because a settlement was reached during trial in the prior case, rendering that Markman ruling not “sufficiently final” to be accorded preclusive effect.\textsuperscript{64}

The court in TM Patents concluded that IBM was correct, while also recognizing that the case raised an issue of first impression.\textsuperscript{65} The court held that Judge Young’s Markman ruling, which occurred after the patentee “had a full and fair opportunity to litigate the meaning” of the disputed terms, was binding during the subsequent litigation.\textsuperscript{66} In reaching the conclusion that Markman rulings have preclusive effect, the TM Patents court focused on the fourth and final element of collateral estoppel: that the determination of the issues must

\textsuperscript{57} See id. (United States Patent No. 5,212,773 (the ’773 patent)).  
\textsuperscript{58} See id. at 375.  
\textsuperscript{59} See id. (referring to TM Patents v. EMC Corp., Civil Action No. 98-10206 (D. Mass. Jan. 27, 1999)).  
\textsuperscript{60} See id.  
\textsuperscript{61} See id.  
\textsuperscript{62} See id. IBM argued that TM was “either collaterally or judicially estopped to relitigate the claims that Judge Young construed – with which constructions IBM (a non-party to the EMC action) is in substantial (though not total) agreement.” Id.  
\textsuperscript{63} Id.  
\textsuperscript{64} Id.  
\textsuperscript{65} See id.  
\textsuperscript{66} Id. “Judge Young’s resolution of the meaning of certain disputed patent terms following a Markman hearing, at which TM had a full and fair opportunity to litigate the meaning of those terms, is binding on the Plaintiffs in this action.” Id.
have been essential to support a final and valid judgment. TM argued that the dispute with EMC regarding the claim interpretation was never elevated to final judgment status because the action resulted in a settlement before a jury returned a verdict on the issue of infringement. TM asserted that there was no finality for former adjudication purposes because a final, appealable judgment did not exist. However, the court definitively denied that as being the law in any circuit. The court cited Lummus Co. v. Commonwealth Oil Refining Co. for the proposition that, although a judgment is not final as defined by 28 U.S.C. § 1291, it can still be considered final in the sense that the issues actually litigated should be granted preclusive effect. As the court noted, the question of whether a court will consider a ruling final depends on numerous factors, including the opportunity for review. The court also concurred with the view expressed by the Lummus court that the entire decision may simply boil down to whether the litigation of a particular matter has reached such a point that there remains no compelling reason to litigate it any further.

The court pointed to the Georgakis v. Eastern Air Lines, Inc. decision as an illustration of the Lummus principle. That case involved a plaintiff who sued the defendant airline for injuries resulting from an airplane crash. The plaintiff sought summary judgment against the airline’s affirmative

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67. See id.
68. See id.
69. See id.
70. See id. The court strongly asserted “that is not the law in this Circuit (or any other, for that matter).” Id.
71. 297 F.2d 80, 89 (2d Cir. 1961).
72. See TM Patents, 72 F. Supp. 2d at 375-76 (“[I]t has been settled that a judgment that is not ‘final’ in the sense of 28 U.S.C. § 1291 can nonetheless be considered ‘final’ in the sense of precluding further litigation of issues that were actually determined in such a judgment.”). Appellate courts have “jurisdiction of appeals from all final decisions of the district courts.” 28 U.S.C. § 1291 (1994).
73. See id. at 376. “Whether a ruling is sufficiently final turns on ‘such factors as the nature of the decision (i.e., that it was not avowedly tentative), the adequacy of the hearing, and the opportunity for review.’” Id. (quoting Lummus, 297 F.2d at 89).
74. See id.
76. See TM Patents, 72 F. Supp. 2d at 376.
77. See Georgakis, 512 F. Supp. at 330.
defense that plaintiff’s damages were limited to $75,000 by the Warsaw Convention.\textsuperscript{78} However, in prior litigation arising from the same crash, but involving a different passenger, this same court granted summary judgment against the airline on the same affirmative defense.\textsuperscript{79} In the subsequent Georgakis suit, the plaintiff invoked collateral estoppel against the airline.\textsuperscript{80} The airline argued that the interlocutory nature of the previous decision precluded application of collateral estoppel.\textsuperscript{81} However, the Georgakis court took an expansive view of collateral estoppel. It stated “collateral estoppel does not require a judgment ‘which ends the litigation . . . and leaves nothing for the court to do but execute the judgment,’ . . . but includes many dispositions which, though not final in that sense, have nevertheless been fully litigated.”\textsuperscript{82}

The TM Patents court noted that, after the Markman decision, claim construction became a question of law for the court to determine.\textsuperscript{83} Frequently, the Markman hearing occurs before the trial so at the outset of the case the court can instruct the jury on the scope of the patent.\textsuperscript{84} During the Markman hearing, the court will limit itself to construing only portions of the claims that are vital to the determination of the issues of validity and infringement.\textsuperscript{85} Afterward, the jury must adhere to the court’s interpretations of any disputed terms.\textsuperscript{86} Thus, the TM Patents court reasoned that it is “hard to see” how a determination can be much more final than a Markman ruling.\textsuperscript{87}

The court found that TM and EMC were “ably represented” during the previous litigation concerning the Markman hearing.\textsuperscript{88} The litigants identified the claim limitations in dispute. The court heard sufficient evidence to properly

\begin{itemize}
\item \textsuperscript{78} See id. at 330-31.
\item \textsuperscript{79} See id. at 331-33.
\item \textsuperscript{80} See id. at 333.
\item \textsuperscript{81} See id. at 334.
\item \textsuperscript{82} Id. (quoting Zdanok v. Glidden Co., Durkee Famous Foods Div., 327 F.2d 944, 955 (2d Cir. 1964) (internal citations omitted)).
\item \textsuperscript{83} See TM Patents, 72 F. Supp. 2d at 376.
\item \textsuperscript{84} See id.
\item \textsuperscript{85} See id.
\item \textsuperscript{86} See id.
\item \textsuperscript{87} Id.
\item \textsuperscript{88} Id.
\item \textsuperscript{89} See id. (“The parties identified certain claim limitations on whose meaning they could not agree, and Judge Young heard whatever evidence he
construe the disputed limitations and issue a detailed ruling, after which the court permitted reargument and made several modifications to the claim construction. Then, at the beginning of the trial in a preliminary jury instruction, Judge Young read his claim interpretation to the jury. Judge Young also used his construction to guide evidentiary rulings. Additionally, copies of the claim construction were available to the jurors during the course of the trial. The TM Patents court concluded that a verdict would not have altered the previous Markman rulings of Judge Young. The court reasoned that nothing remained between the parties to adjudicate on the question of claim interpretation, as the actual application of the properly construed claim to the accused device was immaterial to the finality of Judge Young's prior Markman ruling. The TM Patents court stated that under Lummus, the timing of the ruling was of no consequence. Therefore, under existing precedent, the court considers Markman rulings sufficiently final such that they are to be accorded preclusive effect.

To support its holding, the TM Patents court noted that one of the Supreme Court's rationales for upholding the Markman decision was to promote uniform claim construction. The

thought necessary to interpret those limitations.

90. See id.
91. See id.
92. See id.
93. See id. at 376-77.
94. See id. at 377.
95. See id.
96. See id. (“Nothing more remained to be adjudicated; nothing more remained to be decided on the issue of claim construction. The application of the claim to the product was immaterial to the finality of Judge Young’s determinations.”).
97. See id. at 378.
98. See id. at 377. The court stated, “under Lummus and its progeny, the results of the Markman hearing in the EMC action were sufficiently ‘final’ to permit application of collateral estoppel – even though the matter to which they were necessary was never reduced to a final judgment after verdict.” Id. The court also cited RESTATEMENT (SECOND) OF JUDGMENTS § 13, cmt. e (1980) (“A judgment may be final in a res judicata sense as to part of an action although the litigation continues as to the rest.”); Sherman v. Jacobson, 247 F. Supp. 261, 268 (S.D.N.Y. 1965) (noting that a judgment “may be final as to some matters, even though the litigation continues as to others”). Id. (italics omitted).
99. See id. (“[O]ne of the Supreme Court’s rationales for upholding the Federal Circuit’s ground-breaking decision in Markman was the promotion of
court additionally recognized that prior to Markman, in Pfaff v. Wells Electronics, Inc., the “Federal Circuit had held that determination of the scope of a patent claim in a prior infringement action could have collateral estoppel effect against the patentee in a subsequent case.” The TM Patents court felt that the Markman decision had swung the pendulum even farther. Therefore, the court concluded that, after Markman, it was inconceivable that a fully litigated Markman ruling would not be accorded collateral estoppel in subsequent suits involving the same disputed claims given that the ultimate goal of a Markman proceeding is finality.

D. Graco Children’s Products v. Regalo Int’l LLC

In Graco Children’s Products v. Regalo Int’l LLC, the plaintiffs claimed infringement of their patent on an invention for an easily transportable child’s playpen. In a previous suit, Graco claimed Century Products Company infringed the same patent by making and selling the Fold ‘N Go. In that suit, the trial judge held a hearing and issued a ruling pursuant to Markman. In the ensuing jury trial, the jury found infringement by the accused device under the doctrine of equivalents. Century appealed to the Federal Circuit Court of Appeals, and Graco filed a cross-appeal to the Federal

uniformity in the meaning to be given to a patent claim.” (citing Markman, 517 U.S. at 390-91)).

100. 5 F.3d 514 (Fed. Cir. 1993).

101. TM Patents, 72 F. Supp. 2d at 377 (citing Pfaff, 5 F.3d at 517-18).

102. See id. “[I]t is inconceivable that a fully-litigated determination after a first Markman hearing would not be preclusive in subsequent actions involving the same disputed claims under the same patent.” (emphasis added). Id.

103. See id.


105. See id. at 661 (the patent-in-suit was United States Patent No. 4,811,437).

106. See id.

107. See id.

108. See id. The “jury also found that the Fold ‘N Go did not literally infringe the ‘437 patent, that the infringement under the doctrine of equivalents was not willful, and [sic] that the ‘437 patent is not invalid for obviousness or lack of specificity.” Id. at 661-62. Also, the “court held that the ‘437 patent was not unenforceable due to inequitable conduct.” Id. at 662.

109. See id. at 662.
However, both the appeal and the cross-appeal were dismissed when the parties reached a settlement.  

In the subsequent Graco litigation, Regalo requested that the court grant preclusive effect to the prior claim construction of the patent-in-suit that resulted from the previous litigation involving Graco. On November 29, 1999, the court concluded that Graco was not bound by the previous claim interpretation. In doing so, the court reasoned that the previous parties lacked an adequate incentive to fully litigate the claim construction because a settlement was reached before the possibility of appellate review. Shortly thereafter, counsel for Graco advised the court of the recent TM Patents decision issued by the United States District Court for the Southern District of New York, which held that a Markman ruling possessed preclusive effect despite a subsequent settlement. Accordingly, Regalo requested that the court reconsider its order in light of the TM Patents decision.

The court in Graco recognized that whether a patentee who is the beneficiary of a favorable verdict in an infringement action should be bound to that court’s claim construction was an issue of first impression. The court began by analyzing Jackson Jordan, Inc. v. Plasser American Corp., in which the district court erred in granting preclusive effect to a decision from a previous infringement case. The Federal Circuit recognized that if a district court construed the claims

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110. See id.  
111. See id.  
112. See id. Regalo requested that the court “find Graco to be bound by issue preclusion to the prior claim interpretation from Graco I of the term ‘unitary central hub member’ found in claim 1 of the ‘437 patent.” Id.  
113. See id.  
114. See id.  
115. See id.  
116. See id.  
117. See id. The court requested that the parties provide “supplemental briefing on the applicability of the first exception to the general rule of issue preclusion, found in § 28 of the Restatement (Second) of Judgments, to the case at hand. In addition, the parties were asked to examine Jackson Jordan, Inc. v. Plasser American Corporation . . . and its effect on the instant action.” Id. at n.3. The court realized that it was ruling on “an issue of first impression regarding whether a party who receives a favorable verdict in a patent infringement suit should be bound by the trial court’s interpretation of a term within the claim of the patent at issue that becomes the subject of a subsequent litigation.” Id.  
118. 747 F.2d 1567 (Fed. Cir. 1984).  
119. See Graco Children’s Prods., 77 F. Supp. 2d at 663.
narrower than the patentee urged, that party could be said to have effectively lost on that issue.\footnote{126} However, in its application of the Restatement (Second) of Judgments § 28(1), the Federal Circuit noted that when a claim is ruled valid and infringed on the basis of a narrow claim interpretation, the patentee cannot appeal that construction.\footnote{121} Hence, in \textit{Jackson Jordan} there was no opportunity for review of the claim construction because the patentee won on both the question of validity and infringement.\footnote{122} Hence, issue preclusion was not applicable.\footnote{123}

The parties in \textit{Graco} agreed that \textit{Jackson Jordan} stands for the proposition that the first exception to the Restatement (Second) of Judgments § 28 is appropriate where a patentee won an infringement action but remains convinced that the claim interpretation was construed too narrowly.\footnote{124} And, having won, the patentee has no incentive to appeal.\footnote{125} However, the parties disputed whether, after \textit{Markman}, \textit{Jackson Jordan} was still good law and specifically identified the \textit{TM Patents} decision as the only court that had previously addressed the topic.\footnote{126}

The court in \textit{Graco} noted that the \textit{TM Patents} court had reviewed the pre-\textit{Markman} Federal Circuit decisions cited by TM and concluded that the analysis of those suits was rendered irrelevant in light of the goal of \textit{Markman} hearings.\footnote{127} The \textit{Graco} court realized the significance of uniform and consistent treatment of a particular patent.\footnote{128} However, it also strongly argued that \textit{Markman} did not stand for the proposition that the application of issue preclusion would be guaranteed in every instance, as the circumstances of a specific case may dictate a

\footnote{120} See \textit{Jackson Jordan, Inc.}, 747 F.2d at 1577.  
\footnote{121} See \textit{id.} at 1578.  
\footnote{122} See \textit{id.} The court concluded that “under the first exception to issue preclusion noted in Restatement § 28(1) (availability of review), Canron could not invoke an estoppel against Plasser since Plasser won on both validity and infringement.” \textit{Id.}  
\footnote{123} See \textit{id.}  
\footnote{124} See \textit{Graco Children’s Prods.}, 77 F. Supp. 2d at 663.  
\footnote{125} See \textit{id.}  
\footnote{126} See \textit{id.}  
\footnote{127} See \textit{id.}  
\footnote{128} See \textit{id.} There is “no question that, by instructing courts to decide issues of claim construction in patent cases, the Court in \textit{Markman} recognized the importance of uniformity in the treatment of a given patent.” \textit{Id.}
different result. Additionally, the court cited Cybor Corp. v. Fas Technologies, Inc. for the proposition that Markman solely addressed the respective trial roles of judge and jury. The court also pointed out that the Restatement (Second) of Judgments § 28 specifically provides:

Although an issue is actually litigated and determined by a valid and final judgment, and the determination is essential to the judgment, relitigation of the issue in a subsequent action between the parties is not precluded in the following circumstances:

(1) The party against whom preclusion is sought could not, as a matter of law have obtained review of the judgment in the initial action.

With respect to Graco’s opportunity or incentive to appeal the initial claim construction, Regalo pointed to the fact that “Century did file an appeal prior to the settlement agreement.” This created an opportunity that would have allowed Graco to file a cross-appeal on the issue of claim construction. However, they chose not to. “The subsequent appeal was dismissed after a settlement was reached.” Still, the court disagreed with Regalo and concluded that collateral estoppel was not applicable to the claim construction issue that Graco lost because that issue could not be appealed by itself as Graco won on its infringement claim.

The court relied on Hartley v. Mentor Corp. for the proposition that, where a “party wins on claim, but loses on issue, no issue preclusion attaches to [the] lost issue which could not by itself be appealed.” Moreover, the court cited In re Freeman to argue that former adjudication effect should only be granted to

129. See id. The Markman decision “did not guarantee that collateral estoppel would apply in every case, and this Court will not extend the Supreme Court ruling to mean as much, especially where, as here, the circumstances of the instant action require that a different result be reached.” Id.
130. 138 F.3d 1448 (Fed. Cir. 1998).
131. See Graco Children’s Prods., 77 F. Supp. 2d at 663.
132. Id. at 663-64 (citing RESTATEMENT (SECOND) OF JUDGMENTS § 28(1) (1980)).
133. Id. at 664.
134. See id.
135. Id.
136. See id.
137. 869 F.2d 1469, 1472 (Fed. Cir. 1989).
139. 30 F.3d 1459 (Fed. Cir. 1994).
prior claim constructions if the interpretation was the reason for losing on the question of infringement in the previous action.\textsuperscript{140} The court stated, “Graco did not lose the previous litigation, but, instead, obtained a jury verdict in its favor based on the doctrine of equivalents, making the court’s interpretation of the term within the patent claim not essential to the final judgment.”\textsuperscript{141} For further support of that proposition, the court cited \textit{A.B. Dick Co. v. Burroughs Corp.},\textsuperscript{142} finding that the court would give preclusive effect to judicial statements pertaining to the scope of the claims only if the resolution of the scope was essential to a final judgment.\textsuperscript{143} Furthermore, Graco’s argument convinced the court that granting collateral estoppel effect to claim constructions would discourage settlements and encourage appeals.\textsuperscript{144} This would result because a plaintiff who obtained a favorable outcome would remain compelled to appeal an unacceptable, narrow claim interpretation rather than be content with a winning verdict or a profitable settlement.\textsuperscript{145} The court dismissed the defendant’s contention that those concerns give way to the larger policy considerations behind the \textit{Markman} decision. Primarily, the public is entitled to know the scope of a patent claim, and secondly, the relitigation of previously decided issues results in an unnecessary burden on the judicial system.\textsuperscript{146} The court reasoned that such countervailing considerations were absent in the case at hand. The prior action involved only the interpretation of a single term in a single claim and the previous litigants did not dispute the broader meaning of any claim in its entirety.\textsuperscript{147} Furthermore, the court cited \textit{In re Freeman} for the proposition that a court

\textsuperscript{140} See \textit{id}. at 1466. The court stated, “to apply issue preclusion to a claim interpretation issue decided in a prior infringement adjudication, the interpretation of the claim had to be the reason for the loss [in the prior case] on the issue of infringement.” Id. (quoting Jackson Jordan, Inc. v. Plasser Amer. Corp., 747 F.2d 1567, 1577).

\textsuperscript{141} \textit{Graco Children’s Prods.}, 77 F. Supp. 2d at 664.

\textsuperscript{142} 713 F.2d 700 (Fed. Cir. 1983).

\textsuperscript{143} See \textit{id}. at 704. The court stated that “[j]udicial statements regarding the scope of patent claims are entitled to collateral estoppel effect in a subsequent infringement suit only to the extent that determination of scope was essential to a final judgment on the question of validity or infringement.” Id.

\textsuperscript{144} See \textit{Graco Children’s Prods.}, 77 F. Supp. 2d at 664.

\textsuperscript{145} See \textit{id}.

\textsuperscript{146} See \textit{id}.

\textsuperscript{147} See \textit{id}.
has some discretion to decide whether a particular case is appropriate for the application of issue preclusion because the doctrine is premised on the principle of fairness. Consequently, the court held that regardless of the importance of uniform claim construction, the given circumstances of the case at hand prevented preclusive effect from being applied to the Markman ruling of the previous court.

II. AN APPROPRIATE PROCEDURAL SOLUTION TO RESOLVE THE SPLIT OF AUTHORITY

Because of the drastically different holdings of TM Patents and Graco, the lower federal courts have split on the issue of the preclusive effect of prior claim constructions. While more courts have begun to cite the two cases, there are two recent cases from other districts squarely on point. The United States District Court for the Western District of Kentucky wholeheartedly supported the TM Patents decision in Louisville Bedding Co. v. Perfect Fit Industries. However, the United States District Court for the Western District of Virginia firmly asserted that Graco embodied the correct analysis and result in Kollmorgen Corp. v. Yaskawa Electric Corp. In these more recent cases, the patent holders had settled previous litigation after a Markman ruling was issued. The Louisville Bedding court gave preclusive effect to the prior ruling, while the

148. See id.
149. See Graco Children’s Prods., 77 F. Supp. 2d at 665. The court stated that despite the “importance of uniformity in the treatment of a given patent, circumstances may exist where, as here, despite a previous court having held a hearing on the claim construction of a patent pursuant to Markman, collateral estoppel will not apply to such decisions.” Id.
151. 2001 U.S. Dist. LEXIS 9599 (W.D. Ky. June 25, 2001). That court stated that “[i]t is not for this court to judge the correctness of a previous judge’s claim interpretation in determining its preclusive effect.” Id. at *7.
154. See Louisville Bedding Co., 2001 U.S. Dist. LEXIS 9599 at *14 (stating that the “application of collateral estoppel is an issue to be determined on a case-by-case basis. This court has applied the law regarding issue preclusion to the circumstances of this case and finds it appropriate.”).
Kollmorgen court did not.\textsuperscript{155}

A. THE POLICY BEHIND MARKMAN AND PATENT CLAIM CONSISTENCY

One of the central issues in dispute in this debate is whether a Markman ruling is "essential" to the final judgment when the alleged "final judgment" is actually a consensual settlement between the litigants. The policy behind the Markman decision supports the proposition that a Markman ruling followed by a settlement should not be accorded preclusive effect where an actual final judgment is not reached.\textsuperscript{156} TM Patents correctly noted that the uniform treatment of specific patent claims was one of the foundations of the Court's reasoning in Markman.\textsuperscript{157} Indeed, there is no question that a desire to provide the public with consistent claim interpretations significantly factored into the Court's decision.\textsuperscript{158} Those who promote the application of collateral estoppel to Markman rulings support the notion that the preclusion will advance the goal of uniform and consistent patent claim constructions. Yet, it is "extremely ironic"\textsuperscript{159} that in the cases mentioned above, the plaintiff patent holder had no realistic opportunity, nor incentive, to have the Markman ruling reviewed. After a settlement, the Federal Circuit is deprived of jurisdiction over the matter and lacks the power to review the Markman ruling, unless an interlocutory appeal is certified.\textsuperscript{160} However, even if a district court judge certifies an interlocutory appeal, the Federal Circuit consistently declines review of claim interpretations.\textsuperscript{161} Despite the Federal Circuit's strong inclination to refuse to entertain interlocutory appeals, when the Federal Circuit does review a district court claim construction, almost forty percent of the rulings are either

\textsuperscript{155} See Kollmorgen Corp., 147 F. Supp. 2d at 470. The court concluded that "[c]ourts need not blindly apply the doctrine of collateral estoppel to a prior Markman ruling that construes a patent's scope and claim." \textit{Id.}

\textsuperscript{156} See \textit{id.} at 467.


\textsuperscript{158} See Kollmorgen Corp., 147 F. Supp. 2d at 467.

\textsuperscript{159} \textit{Id.}

\textsuperscript{160} See \textit{id.}

\textsuperscript{161} See \textit{id.}
changed or overturned.\textsuperscript{162} Given the fact that nearly half of the claim constructions reviewed by the Federal Circuit are either changed or overturned, it is extremely difficult to explain why the Federal Circuit generally declines to entertain interlocutory appeals pertaining to patent claim construction.

The \textit{TM Patents} proposition, that it is \textit{inconceivable} not to accord preclusive effect to a fully-litigated prior \textit{Markman} ruling,\textsuperscript{163} “contradicts logic.”\textsuperscript{164} It is obvious that the desired need for uniformity of patent claims and scope provided the basis for the Supreme Court’s reasoning in \textit{Markman}.\textsuperscript{165} However, the Court’s analysis presumes that a district court’s claim interpretation is accurate.\textsuperscript{166} It is highly unlikely that the Court’s keen interest in consistency and uniformity outweighs the greater interest in obtaining proper claim interpretation.\textsuperscript{167} Furthermore, the Supreme Court took an extreme interest in patent uniformity in noting that the Federal Circuit Court of Appeals was created to be the exclusive avenue for review of patent suits.\textsuperscript{168} Clearly, with the Federal Circuit acting as the ultimate interpreter on the issue of claim construction, the desired uniformity was more realistically obtainable.\textsuperscript{169} Additionally, although the \textit{TM Patents} court correctly stated that the Federal Circuit, even before \textit{Markman}, had held that collateral estoppel could apply to claim constructions of previous infringement actions,\textsuperscript{170} it neglected to recognize that the determinative word is “could,” not “should” or “will,” have collateral estoppel effect. Furthermore, while \textit{Markman} strongly and unquestionably supports the promotion of uniformity in patent claim interpretation, it should not be viewed to stand for the proposition that patent interpretations will be blindly adopted as complete and accurate without the opportunity to undergo the rigorous review of the Federal

\begin{itemize}
\item \textsuperscript{162} See \textit{TM Patents}, 72 F. Supp. 2d at 378.
\item \textsuperscript{163} See supra note 102 and accompanying text.
\item \textsuperscript{165} See supra note 99 and accompanying text.
\item \textsuperscript{166} See Kollmorgen Corp., 147 F. Supp. 2d at 468.
\item \textsuperscript{167} See id. The court stated that “[s]urely no judicial scholar would argue the Supreme Court’s interests in uniformity is mutually exclusive to an interest in a proper patent claim construction.” \textit{Id}.
\item \textsuperscript{169} See Kollmorgen Corp., 147 F. Supp 2d at 468.
\item \textsuperscript{170} See supra text accompanying note 101.
\end{itemize}
This is the only sensible approach in light of the disturbing fact that nearly half of all the patent claim constructions the Federal Circuit reviews are either revised or overturned.\textsuperscript{172}

\section*{B. \textit{Markman} Ruling Not Essential to a Final Judgment of Patent Infringement}

The \textit{Markman} ruling must be essential to final judgment for collateral estoppel to be applicable.\textsuperscript{173} In \textit{TM Patents}, the court held that the claim constructions of the prior case were sufficiently "final" to be granted preclusive effect even though they were not reduced to a final judgment by way of a jury verdict.\textsuperscript{174} The court admitted that it is not insignificant that the Federal Circuit never reviewed the previous claim constructions.\textsuperscript{175} However, that court also concluded that the fact that the case settled was the sole reason that the \textit{Markman} ruling was not reviewed on appeal.\textsuperscript{176} It continued to definitively state that a "party who cuts off his right to review by settling a disputed matter cannot complain that the question was never reviewed on appeal."\textsuperscript{177} Finally, that court held that the \textit{Markman} rulings possessed preclusive effect for two reasons.\textsuperscript{178} First, the settlement did not vacate the rulings.\textsuperscript{179} Second, a \textit{Markman} ruling possessed a unique finality.\textsuperscript{180}

Admittedly, the \textit{Markman} decision ushered in a new standard for patent claim interpretation.\textsuperscript{181} However, it did not obliterate the fact that all of the appeals originating from patent litigation are heard by the United States Court of Appeals for the Federal Circuit.\textsuperscript{182} The court in \textit{TM Patents}

\begin{footnotesize}
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\item 171. \textit{See Kollmorgen Corp.}, 147 F. Supp. 2d at 468.
\item 172. \textit{See supra} text accompanying note 162.
\item 173. \textit{See supra} text accompanying note 15.
\item 174. \textit{See supra} text accompanying note 1.
\item 176. \textit{See id.}
\item 177. \textit{Id.}
\item 178. \textit{See id.}
\item 179. \textit{See id.}
\item 180. \textit{See id.} at n.2.
\item 181. \textit{See supra} text accompanying note 46.
\item 182. \textit{See supra} text accompanying note 46.
\end{itemize}
\end{footnotesize}
misinterpreted the *Markman* decision as nullifying Federal Circuit precedent regarding issue preclusion.\(^{183}\) Although *Markman* clearly specified that patent claim interpretation is a question of law to be determined by a judge, and not a question of fact to be determined by a jury, “it did not single-handedly redefine ‘finality’ for collateral estoppel purposes.”\(^{184}\) The rule set forth in *Jackson Jordan*, that before preclusive effect would be given to a prior claim construction, claim interpretation “had to be the reason for the loss [in the prior case] on the issue of infringement,”\(^{185}\) remains good law and should be followed. A settlement cannot be blindly classified as a “loss.” At the very least, an extensive balancing test of the items gained versus conceded would have to be performed. Also, in at least one sense, both sides actually win from a settlement as the time and expense of further litigation are no longer expended.

The *TM Patents* court argued that a party who agrees to a settlement cannot complain that the opportunity for appellate review is lost.\(^{186}\) This concept does not withstand scrutiny. There are numerous reasons why parties have an incentive to negotiate and reach a settlement, many of which have nothing to do with the validity or the strength of an opponent’s cause of action. For example, the goal of a settlement may simply be to avoid the time and expense intertwined with further litigation. Other reasons include prevention of a negative public image and the accompanying economic ramifications of such an image, and the desire to create or maintain a mutually beneficial business relationship with the opponent. Numerous other practical economic goals of a settlement also exist. Yet, the *TM Patents* court failed to consider the possibility of their existence. Because of the above pragmatic analysis, a “consensual settlement”\(^{187}\) should not be considered a final judgment because a settlement cannot be classified as a “loss” of previous litigation. Therefore, the doctrine of collateral estoppel is inappropriate.\(^{188}\)

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184. Id.
185. In re Freeman, 30 F.3d 1459, 1466 (Fed. Cir. 1994) (quoting Jackson Jordan, Inc. v. Plasser Amer. Corp., 747 F.2d 1567, 1577); see also supra text accompanying note 140.
186. See *TM Patents*, 72 F. Supp. 2d at 378.
188. See id.
C. **The Negative Effect Preclusion Would Cast Over Possible Future Settlements**

The application of the doctrine of collateral estoppel to an unappealable order would certainly have a negative and dramatic effect on settlements. The reasoning of *TM Patents* was that since a settlement precludes review, a party to that settlement should not be allowed to argue that the issue never appealed. However, as the court in *Graco* noted, appeals would be encouraged and settlements discouraged by the blind application of collateral estoppel to *Markman* rulings. The court correctly reasoned that despite the existence of a favorable verdict, a patentee would remain compelled to appeal the narrow claim interpretation rather than be satisfied with the result of the lawsuit. It is unquestionably unfair to deny a party an opportunity to appeal a potentially preclusive *Markman* ruling. The court in *TM Patents* disregarded the fact that the Federal Circuit consistently refuses to entertain the review of claim interpretations on interlocutory appeal. The Federal Circuit revises or overturns more than forty percent of all *Markman* rulings. It follows, then, that nearly half of the district courts err while constructing patent claims. Logically, before claim constructions can be accorded preclusive effect, the Federal Circuit should grant the litigants the opportunity to seek its review and the litigants should be given the opportunity to seek the review of the Federal Circuit to correct erroneous rulings and promote justice. The application of collateral estoppel will significantly hinder, if not completely eliminate, settlements during patent litigation as the party on the receiving end of a damaging *Markman* ruling has little incentive to settle, if it knows that the district court’s patent

189. *See id.* at 468.
190. *See supra* text accompanying note 177.
192. *See id.* The court concluded that “[u]nder such circumstances, a plaintiff who obtains a favorable verdict would still be compelled to file an appeal rather than be content with winning the lawsuit or settling the case in order to correct what they perceive as unduly narrow claim construction.” *Id.*
193. *See supra* text accompanying note 162. The TM Patents decision seems to “ignore the reality that the Federal Circuit consistently refuses to review lower court’s patent claim constructions on interlocutory appeal.” *Graco Children’s Prods.*, 147 F. Supp. 2d at 468.
194. *See id.*
195. *See id.*
claim construction will become “final” and hence unappealable. Thus, there is little incentive for parties to settle if Markman rulings are granted preclusive effect in future litigation as the rulings would become virtually unreviewable as a result of a settlement before a truly final judgment.\textsuperscript{196}

D. \textbf{THE APPROPRIATE WEIGHT TO BE AFFORDED PRECEDENCE REGARDING CLAIM CONSTRUCTION AND COLLATERAL ESTOPPEL}

The \textit{TM Patents} decision seemed to ignore any precedence before Markman pertaining to collateral estoppel as it considered the decisions inapplicable after taking into account the rationale of Markman rulings.\textsuperscript{197} Yet, the Kollmorgen court reached the opposite conclusion and afforded pre-Markman decisions precedential weight as their analysis of patent disputes were quite relevant.\textsuperscript{198} In both \textit{TM Patents} and \textit{Graco}, the central question was whether, under the doctrine of collateral estoppel, the determination of the issue in the previous litigation was essential to a final judgment.\textsuperscript{199} In \textit{Pfaff v. Wells Electronics}, the Federal Circuit held that where a previous case determined the scope of the patent’s claims and that decision was essential to resolving the question of infringement, there is preclusive effect\textsuperscript{200} for the claim interpretations in subsequent litigation. Additionally, in \textit{A.B. Dick Co. v. Burroughs Corp.}, the Federal Circuit stated that judicial comments concerning the breadth of the patent claims are accorded former adjudication effect only if the resolution of the scope was necessary to obtain a final judgment with respect to either infringement or validity.\textsuperscript{201} Thus, the application of collateral estoppel is only appropriate if the Markman ruling was essential to a final judgment.\textsuperscript{202} Also, in \textit{Comair Rotron, Inc. v. Nippon Densan Corp.},\textsuperscript{203} the Federal Circuit stated that a court may examine the particular circumstances of a given case.

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\item[196.] See id.
\item[197.] See \textit{Graco Children’s Prods.}, 77 F. Supp. 2d at 663.
\item[199.] See \textit{A.B. Dick Co.}, 713 F. 2d at 702.
\item[200.] See \textit{Pfaff}, 5 F.3d at 517.
\item[201.] See supra note 143 and accompanying text.
\item[202.] See \textit{Kollmorgen Corp.}, 147 F. Supp. 2d at 469.
\item[203.] 49 F.3d 1535 (Fed. Cir. 1995).
\end{enumerate}
\end{footnotesize}
before concluding whether “justice, expediency, and the public interest are served” by the application of collateral estoppel. Therefore, even when all the elements of collateral estoppel are present in a given scenario, it is still within the court’s power to decline to apply the doctrine.

After a settlement, the litigation between the parties ends. In patent cases, a settlement means that neither a court nor a jury ever determined whether a defendant infringed upon the patent holder’s patent. Thus, it is fair to say that the court never reached a final judgment on the issue of infringement or validity. TM Patents cites Lummus Co. for the proposition that whether a decision is considered “final” depends upon such factors as the adequacy of the hearing, the availability of appellate review, and the nature of the decision. However, as the court in Kollmorgen succinctly and accurately described the situation, the absence of “any realistic opportunity for Federal Circuit review greatly outweighs the adequacy of the hearing and the nature of the Markman Order.” The fact that any claim construction remains highly uncertain until the Federal Circuit reviews it seriously reduces the incentive to settle. Although Markman desired claim interpretation uniformity and consistency, the almost absolute inability to have the Markman ruling reviewed after settlement should be fatal to the application of issue preclusion.

E. POSSIBLE REMEDIES TO THE CURRENT SPLIT OF AUTHORITY

Obviously, there is more than one solution to the current dilemma of whether or not to give preclusive effect to Markman rulings in suits that conclude with a settlement agreement. One could follow the holding of TM Patents and always give

204. Id. at 1538.
207. See Lummus Co. v. Commonwealth Oil Refining Co., 297 F.2d 80, 90 (2d Cir. 1961).
210. See Kollmorgen Corp., 147 F. Supp. 2d at 469.
preclusion effect to *Markman* rulings in the name of finality and judicial economy, even if there is no true “final” judgment due to a settlement. Yet, in cases similar to *TM Patents*, injustice would result despite the court claiming that it had reviewed the particular circumstances of the case and found no good reasons for relitigation. However, the court’s review in *TM Patents* was rather cursory, and the rationale for affording preclusive effect is, at the very least, unpersuasive.

One could follow the extreme opposite route. The *Graco* decision would have us conclude that preclusive effect should almost never be granted to *Markman* rulings followed by a settlement agreement. The reasoning, of course, would be that due process outweighs the negative impact on the scarce available judicial resources. Additionally, while such waste may seem apparent on the face of the matter, as having numerous *Markman* rulings on the same patent at the district court level is inefficient, a more in-depth analysis leads one to the inevitable conclusion that following the *TM Patents* approach would result in an even larger drain of judicial resources. The drain on judicial resources would occur as the incentives to reach settlement agreements were overcome by the realization that an unfavorable, unreviewable *Markman* ruling would be given preclusive effect.

However, a middle ground would appease both sides in their quests for judicial economy and due process, respectively. After a *Markman* ruling is given, it should immediately become appealable as-of-right. This would create the much-needed due process for either side in the patent dispute that felt that the claim construction was erroneous. It is particularly true in this situation, given the astonishing fact that nearly forty percent of all patent claim constructions are either revised or reversed by the Federal Circuit after review.\(^{211}\) The immediate appeal would allow the Federal Circuit to rule on the claim construction such that it would indeed become the final and ultimate determination of the claims. Given the final patent claim construction and the significant impact it has on patent litigation, each party can make a fresh assessment of the legal strengths and weaknesses of their respective positions. The probability of success or failure in the litigation will appropriately affect each party’s motivation to settle and the concessions gained or given in any possible agreement. With

\(^{211}\) See supra text accompanying note 162.
the claim construction known, each party’s likelihood of success during the impeding trial becomes significantly more clear. Accused infringers facing broad constructions are more likely to settle. Additionally, patent holders receiving narrow constructions are also more inclined to settle or, at the extreme, no longer pursue the suit. In either scenario, the chance of further litigation decreases.

Professor Craig Allen Nard of the University of Illinois has noted that the Federal Circuit serves a unique role in the promotion of patent certainty and uniformity. However, he argues the Federal Circuit is trying to have it “both ways” by refusing to entertain interlocutory appeals solely regarding claim construction, while simultaneously employing a de novo standard of review for all final judgments. Furthermore, the acceptance of interlocutory appeals would promote early certainty and foster settlement negotiations. Professor Nard recommended that, with respect to their sister courts’ claim constructions, the district courts apply the doctrine of collateral estoppel when the circumstances warrant its use. The application of collateral estoppel would “promote uniformity at the district court level, and couple with interlocutory review, would [also] promote early certainty.” Both of these concepts are “modern patent law mantras” because of their effect on claim construction and ultimately the scope of the patent.

To promote early certainty, the Federal Circuit has a procedural choice. The court can continue to utilize a de novo standard of review after final judgment and commence entertaining interlocutory appeals or change to significantly narrower standard of review. However, as Professor Nard pointed out, the Federal Circuit could not employ both effectively. Additionally, Professor Nard concluded that the

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213. Id.
214. See id.
215. See id.
216. See id.
217. Id. at 356.
219. See id.
220. See id. at 376.
221. See id.
222. See id.
Federal Circuit is not about to alter the narrow standard of review of final judgments, because, after the Cybor decision, de novo review is the unquestionable standard the Federal Circuit intends to apply. Therefore, Professor Nard proposed that the Court, pursuant to the Rules Enabling Act, should promulgate a new procedure pertaining to Markman rulings. The rule would make Markman decisions appealable either as a-matter-of-discretion or as a-matter-of-right.

The first option, to make Markman rulings appealable as a-matter-of-discretion, envisioned a rule allowing the Federal Circuit to entertain an interlocutory appeal specifically on the issue of claim construction. The rule would be different from the current § 1292(b) in that it would only apply to Markman rulings. However, even Professor Nard admitted that this proposition might appear to be a questionable solution to the problem. Yet, he maintained that the proposal would exert pressure on the Federal Circuit to actually entertain the appeal because of the specific language of such a rule. The proposed rule would apply only to claim constructions and its creation was in direct response to the unwillingness of the Federal Circuit to entertain interlocutory appeals solely dealing with Markman rulings. Finally, Professor Nard strongly asserted that the continuing persistence of the Federal Circuit in refusing to grant interlocutory appeals provided reformers with firmer ammunition upon which to debate that the court’s discretion with respect to this issue should be limited or even removed.

Professor Nard’s stronger and more justifiable position is that Markman rulings should be made appealable as-of-right. This proposal would be an “exception to the final judgment rule in patent law,” which held that a patent infringement

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223. See id.
225. See id.
226. See id. at 378.
228. See Intellectual Property Challenges, supra note 212, at 378.
229. See id. at 379. Professor Nard stated it “may seem like a wishy-washy response.” Id.
230. See id.
231. See id.
232. See id.
233. See id. at 377.
decision is final only after an accounting takes place.\textsuperscript{235} On its face, the as-of-right proposal might appear to be a "radical" solution.\textsuperscript{236} However, as Professor Nard pointed out, an exception to the final judgment rule already exists in § 1292(c)(2),\textsuperscript{237} which allows, before the completion of an accounting, judgment on the issues of patent validity and infringement to be appealed as-of-right.\textsuperscript{238} The rationale for this exception is the avoidance of economic waste, as the expenditures associated with accountings was immense and if the determination of liability were reversed, the resources spent to resolve the issue would be irretrievable.\textsuperscript{239} Promoting the as-a-matter-of-discretion interlocutory appeals, versus initially lobbying for as-of-right interlocutory appeals, may actually prompt the appropriate rulemaking authorities to establish such a novel rule in the first place.\textsuperscript{240} This result may occur because the judges belonging to the various committees, which possess the power to enact procedural change, would not be limiting or removing the discretion currently enjoyed by their colleagues.\textsuperscript{241} However, eventually the as-of-right interlocutory appeals may be required due to the reluctance of the Federal Circuit to entertain claim construction interlocutory appeals.\textsuperscript{242}

CONCLUSION

The controversial TM Patents decision started this ongoing discussion as to whether or not collateral estoppel should apply to Markman rulings subsequently followed by a settlement agreement. Some federal district courts have followed that decision, agreeing that the Court's finality goal expressed in Markman and judicial economy outweigh any possible appearance of unfairness to the litigants, as they previously have had their day in court to litigate the matter fully and fairly.\textsuperscript{243} However, the court in Graco and others have strongly

\begin{itemize}
  \item \textsuperscript{235} See id.
  \item \textsuperscript{236} Id.
  \item \textsuperscript{237} See 28 U.S.C. § 1292(c)(2) (1992).
  \item \textsuperscript{238} See Intellectual Property Challenges, supra note 212, at 377.
  \item \textsuperscript{239} See id.
  \item \textsuperscript{240} See id. at 378.
  \item \textsuperscript{241} See id.
  \item \textsuperscript{242} See id.
  \item \textsuperscript{243} See e.g., Louisville Bedding Co. v. Perfect Fit Industries, 2001 U.S.
asserted their disapproval of that reasoning. These courts believe that giving preclusive effect to prior Markman rulings subsequently followed by settlement results in a violation of due process. They pointed out that the litigants in the previous suit did not have an opportunity, and in some situations lacked an incentive, to appeal the prior Markman ruling. Over forty percent of Markman rulings are revised or reversed on appeal. Hence, in theory, the application of collateral estoppel to an unappealable Markman ruling would give preclusive effect to an erroneous decision in almost half of the cases. This qualifies as a “really good reason” to relitigate the claim construction.

Additionally, the preclusive effect to Markman rulings in this situation would decrease the number of settlements and increase the average length of litigation. The result would be a larger negative impact on judicial resources than the advantage gained from the application of collateral estoppel to start with. Furthermore, the Court in Markman did not abolish all prior precedent on the application of collateral estoppel to claim constructions. A settlement is not a final decision on the question of validity or infringement. Thus, it should not be viewed as such for collateral estoppel purposes. Opponents of the application of collateral estoppel have more well-reasoned arguments to support their conclusion. Therefore, until a procedural change occurs, preclusive effect should not be afforded.

The procedural change that would correctly solve the problem is to make Markman rulings appealable as-of-right. This would satisfy the primary concern of both sides in this debate. The collateral estoppel supporters would receive their finality of the Markman ruling before trial and in subsequent trials, and thus achieve their much desired elimination of the wasteful use of limited judicial resources. The opponents' primary concern of a violation of due process would also be alleviated, as every Markman ruling would be subject to the Federal Circuit's rigorous review. Therefore, collateral estoppel effect should not be granted to Markman rulings subsequently followed by a settlement agreement unless the rulings become


subject to interlocutory appeals as-of-right.