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# TECHNOLOGY LAW UPDATE

A report of the latest Federal Circuit updates brought to you by Preston Gates.

## Sulzer Textil A.G. v. Picanol N.V.

Nos. 02-1410, -1441 (Fed. Cir. Dec. 9, 2003).

***“[T]he district court must instruct the jury on the meanings to be attributed to all disputed terms used in the claims in suit so that the jury will be able to ‘intelligently determine the questions presented.’”***

On December 9, 2003, the Federal Circuit, *inter alia*, affirmed the district court’s order denying Sulzer’s motion for a new trial based on erroneous jury instructions, following a jury verdict that Picanol did not infringe U.S. Patents No. 4,446,893 and No. 4,450,876, which related to air-jet weaving machines for weaving threads or yarns into fabric. The Federal Circuit stated:

[T]he district court did not read the court’s claim constructions to the jury or instruct the jury that the claims, as construed, were to be applied against the alleged infringing machines. . . . Picanol argues that the district court is not required to recite every claim construction or engage in an “exercise in redundancy.” Picanol argues that the claim constructions rendered by the district court before the trial began shaped the testimony throughout trial. According to Picanol, any confusion by the jury as to the appropriate meaning of the claim terms was invited by Sulzer. . . . We conclude that the district court erred in omitting from its jury charge any instructions on claim construction, but we find that such error, in this case, was harmless.

This court has long joined other circuits in holding that one “duty of a trial court in any jury trial is to give instructions which are meaningful, not in terms of some abstract case, but which can be understood and given effect by the jury once it resolves the issues of fact which are in dispute.” Jury instructions are reviewed not only for accuracy, but for clarity, objectivity, and adequacy, taken as a whole. The meaning and scope of patent claim terms, as determined by a district court’s claim construction rulings, are legal issues central to most patent cases. Thus, the district court normally will need to provide the jury in a patent case with instructions adequate to ensure that the jury fully understands the court’s claim construction rulings and what the patentee covered by the claims.

The Markman decisions, in ruling that claim construction is a matter of law for the court, do not hold that the trial judge in a patent case must repeat or restate every claim term in the court’s jury instructions. The district court simply must give the jury guidance that “can be understood and given effect by the jury once it resolves the issues of fact which are in dispute.” This means that, as to claim coverage, the district court must instruct the jury on the meanings to be attributed to all disputed terms used in the claims in suit so that the jury will be able to “intelligently determine the questions presented.”

Although the particular form and precise nature of jury instructions are matters within the sound discretion of the district court, the trial court in a patent case must at minimum take steps to assure that the jury understands that it is not free to consider its own meanings for disputed claim terms and that the district court’s claim construction, determined as a matter of law, is adopted and applied by the jury in its deliberation of the facts. It is not enough that the testimony and argument at trial is consistent with the district court’s construction of disputed claim terms. The jury must be told that the court has made a claim construction ruling that the jury must follow and cannot be left free to apply its own reading of disputed terms to the facts of the case. “An instruction should be given to the jury on every material issue.” Accordingly, we hold that it is the duty of trial courts in patent cases in which claim construction rulings on disputed claim terms are made prior to trial and followed by the parties during the course of the trial to inform jurors both of the court’s claim construction rulings on all disputed claim terms and of the jury’s obligation to adopt and apply the court’s determined meanings of disputed claim terms to the jury’s deliberations of the facts.