TECHNOLOGY LAW UPDATE

CytoLogix Corp. v. Ventana Med. Sys., Inc.

No. 04-1446

Federal Circuit
Sept. 21, 2005

[It is improper to present expert witnesses who testify before the jury regarding claim construction, and for counsel to argue conflicting claim constructions to the jury]. [T]he district court should have refused to allow such testimony despite the agreement of the parties.

On September 21, 2005, the Federal Circuit vacated-in-part, reversed-in-part, affirmed-in-part, and remanded the district court's injunction from a jury verdict that Ventana infringed U.S. Patents No. 6,180,061 and No. 6,183,693, which related to the automated microscope slide fixed tissue sample staining. The Federal Circuit stated:

> [I]n this case the parties agreed, contrary to the district court's wishes, not to have a Markman hearing, and that the claims were not construed until the close of evidence. This was not erroneous [because] the district court has considerable latitude in determining when to resolve issues of claim construction. [B]y agreement the parties also presented expert witnesses who testified before the jury regarding claim construction, and counsel argued conflicting claim constructions to the jury. This was improper, and the district court should have refused to allow such testimony despite the agreement of the parties. The risk of confusing the jury is high when experts opine on claim construction before the jury even when, as here, the district court makes it clear to the jury that the district court's claim constructions control.
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> Although in this case there is no ground for reversal since there was no objection to the expert testimony as to claim construction, it appears that the conflicting expert views as to claim construction created confusion and may have led to a verdict of infringement with respect to the asserted claims of the '061 patent that was not supported by substantial evidence under the district court's claim construction. We nonetheless conclude that the verdict should be sustained as to these claims because, although the district court's claim construction was in error, the evidence requires a verdict of infringement under the correct claim construction.
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> Claims 1-3, 5-7, and 15 of the '061 patent include a "heating station" limitation. [T]he claim term "heating station" is not limited to a device that holds and heats a number of slides. The term "heating station" is properly construed to mean "a slide support and heating element capable of directly heating at least one microscope slide by conductive heating, e.g., direct contact of a heating surface to a portion of the microscope slide to be heated."
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> Although the district court erroneously construed "heating station," a new trial is not required because the district court's instruction to the jury did not constitute prejudicial error. "[T]o warrant a new trial . . . the erroneous jury instruction [must have been] in fact prejudicial. When the error in a jury instruction could not have changed the result, the erroneous instruction is harmless." Prejudicial error only exists if "there was sufficient evidence at trial to support a finding of [non-]infringement under a correct instruction." Although infringement under the district court's erroneous claim construction was debatable, infringement under the proper construction was not. This was so because there was no dispute that the heating stations of the accused devices supported and heated at least one slide. We sustain the jury's verdict of infringement concluding that the "heating station" limitation of claims 1-3, 5-7, and 15 of the '061 patent is satisfied.
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> Where arguments with respect to infringement or invalidity have been presented but rendered moot by the claim construction adopted by the district court, a new trial may in some circumstances be appropriate. Here we conclude that issues of written description and anticipation do not warrant a new trial, but that a new trial may be appropriate on obviousness.

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