

Thirty Years After *Markman*

Steven R. Hansen

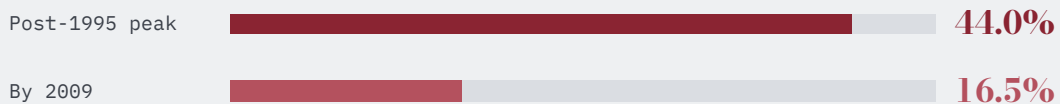
Registered patent attorney · Hansen IP Law PLLC

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Thirty years ago, the U.S. Supreme Court issued its *Markman* opinion, holding that the construction of patent claims is a matter of law for the courts to decide and not a jury issue.¹ The decision seemed to promise more efficiency by resolving cases on summary judgment when the dispute centers on the scope of the patent claims rather than the structure and operation of an accused product.

In the decade after *Markman*, the Federal Circuit's rate of reversing district court claim constructions ran as high as 44%, before dropping sharply to roughly 16.5% by 2009.²

FEDERAL CIRCUIT REVERSAL RATE – DISTRICT COURT CLAIM CONSTRUCTIONS



Bars drawn to a common 0–50% scale. Source: J. Jonas Anderson & Peter S. Menell, *Informal Deference: A Historical, Empirical, and Normative Analysis of Patent Claim Construction*, 108 Nw. U. L. Rev. 1, 40–41 (2014).

Since *Markman*, the claim construction process has become more orderly. Many courts have wisely adopted local patent rules that seek to crystallize the issues by imposing a sequence of infringement and invalidity contentions early in a case so the parties can see how the claims are being

applied, which generally reveals what claim construction disputes exist. After exchanging contentions, the parties identify disputed claim terms, provide their constructions, and then defend them in briefings and in a “*Markman* hearing.” This has been a good development for allowing patent cases to proceed in a more orderly fashion.

Despite these welcome developments, has *Markman* lived up to its promise? Directionally, perhaps more cases are resolved on summary judgment or settle pretrial. However, even if the situation has improved, *Markman* has ultimately fallen somewhat short of expectations in the wake of the decision, at least in cases this author has observed.

§ I THE GAP

Often No Dispute Over Structure and Function of Accused Product, Yet Claim Construction Is Not Dispositive

In a significant number of observed cases, there was no dispute over how the accused product was structured or functioned. The product was fully observable, and the parties could even agree on some common language to describe it. So, the real dispute was whether the patent claim language properly described the product. Under *Markman*, it seemed that such disputes should be resolved by the court. However, what frequently happens is that the court uses the tools of claim construction set forth in *Phillips v. AWH Corp.*³ and *Vitronics Corp. v. Conceptronic, Inc.*⁴ and enters a nondispositive construction that does not really address the ultimate dispute over patent scope.

For example, one case the author litigated concerned airbag covers and whether the accused airbag covers were “homogeneous thermoplastic” covers. Both parties agreed that the covers comprised two layers of different thermoplastics. The disputed issue was whether “homogenous thermoplastic” meant “thermoplastic throughout” or “the same thermoplastic throughout.” The court construed the words “homogeneous” and “thermoplastic” individually, but that did not resolve the dispute.

In another case the author litigated, the subject patent concerned an ultrasonically assisted liposuction device, and there was a dispute over whether the way that fat was processed by the device could properly be

characterized by the claimed requirement of “melting.” There did not seem to be much of a dispute over what the device did, but rather whether it could be properly characterized as “melting” the fat. Again, the *Markman* process did not resolve the issue.

It seems that in many cases, the real infringement dispute is over the language that properly describes the structure and function of an accused product. The law draws a distinction between construing claims and applying claim language to an accused product. However, that distinction is imperfect because whenever you say a claim term describes a feature of a product, you are relying on some implicit definition of that term, and if you say a claim reads on a product, you are necessarily relying on a construction of the claim as a whole. It is simply the nature of language.

One cannot point to something and call it a “car” without some working definition of what a “car” is.

If someone says an airbag cover with two thermoplastic layers is a “homogenous thermoplastic” airbag cover, then they are necessarily saying that “homogeneous thermoplastic” is broader than “the same thermoplastic” throughout and that it is not limited to a single thermoplastic material.

If a claim construction dispute is not expressly identified and adjudicated by the court, it is implicitly adjudicated by the jury in deciding infringement and invalidity. A jury cannot find that a two-thermoplastic-layer airbag cover is infringing without implicitly concluding that “homogeneous thermoplastic” does not require “the same thermoplastic” throughout the cover.

§ II THE ELUSIVE LINE

Limitations of Claim Construction Process

There are several reasons why what is truly an issue of claim scope may not be decided by the court. The first is that the intrinsic record often simply does not resolve a dispute. Compounding this is the tension in various claim construction doctrines without any clear way to determine which doctrine is applicable.

There is a line between properly defining claim terms by implication and improperly importing limitations from the specification into the claims, but determining which side of the line you are on remains elusive. Courts that want to use the specification to adopt a narrowing construction can rely on the canon that “[a] claim term may be clearly redefined without an explicit statement of redefinition,” and that “[e]ven when guidance is not provided in explicit definitional format, the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents.”⁵ Those who want to treat the specification as nonlimiting and adopt a broader construction can rely on the canon that “although the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments.”⁶

The Federal Circuit has “expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment.”⁷ In the “homogeneous thermoplastic” case, there was a single embodiment that was a single-layer thermoplastic airbag cover, so it was both “thermoplastic throughout” and “the same thermoplastic throughout” and not described in a limiting way. The file history was similarly agnostic on the issue.

Vitronics indicated that ambiguities that could not be resolved based on the intrinsic record could be resolved with extrinsic evidence, including expert testimony.⁸ While Phillips seemed to endorse the use of expert testimony to “establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field,” it was also highly critical of the reliability of such testimony for anything other than providing background information or explaining the operation of the technology.⁹ In the author’s experience, no judge has used expert testimony to resolve a claim construction dispute. Many seemed to think that considering expert testimony invited reversal. The limitations of the claim construction process do not simply leave disputes unresolved—they actively shape how parties choose to present, or conceal, their positions.

Strategic “Burying” of Claim Construction Positions in Infringement or Invalidity Arguments

The other, perhaps unavoidable, factor in how well *Markman* addresses claim construction disputes is that courts resolve only those disputes that are expressly raised by the parties. If it looks like a construction that is needed is poorly supported by the intrinsic record, parties may find it strategically beneficial to seek a nondispositive construction and then embed the claim construction issue in their infringement or invalidity arguments. Asking for, and losing, an express construction can foreclose an argument that relies on that construction because the issue will then be out in the open. This motivates parties to “bury” construction issues in their infringement or invalidity arguments. Then they can argue that they are merely “applying” the claims, not construing them.

Of course, the far end of the spectrum with respect to burying constructions is to use “plain and ordinary meaning,” which often means no construction at all. This is perplexing because Federal Circuit case law does not indicate that the phrase “plain and ordinary meaning” means “no construction.” Rather, the adoption of a “plain and ordinary meaning” simply means that whatever that meaning is, there was no disclaimer of scope in the specification or file history. In that case, a jury would still require a construction to understand what the actual “plain and ordinary meaning” is. Yet, in practice, a construction of “plain and ordinary meaning” often means that the jury applies the claim language as is, without any further definition or elucidation. So, parties will sometimes offer “plain and ordinary meaning” when the tools of claim construction do not support their position.

This type of “burying” appears to have been the strategy of the plaintiff in *O2 Micro International Ltd. v. Beyond Innovation Technology Co.*¹⁰ In that case, there was an underlying dispute over the scope of a claim directed to generating a pulse signal to control the state of a group of switches “only if” a feedback signal exceeded a predetermined threshold.¹¹ O2 Micro contended that the “only if” limitation would only apply during the steady-state operation of the circuit. That meant that if the pulse signal were generated other than when the feedback signal exceeded the threshold,

infringement would not be avoided if it occurred during non-steady state operation. However, O2 Micro did not seek a construction that would support that argument and merely argued that the phrase “only if” should be given its plain and ordinary meaning and not be construed. The district court declined to construe the term, and the issue was effectively decided by the jury.¹² The Federal Circuit reversed, holding that the trial court was obligated to construe the term because there was an actual dispute as to the scope of the claim. The court held that a “determination that a claim term ‘needs no construction’ or has the ‘plain and ordinary meaning’ may be inadequate when a term has more than one ‘ordinary’ meaning or when reliance on a term’s ‘ordinary’ meaning does not resolve the parties’ dispute.”¹³

Similarly, in *Omega Patents, LLC v. CalAmp Corp.*, a case that cites O2 Micro, the claims at issue involved communications with a “vehicle device code.”¹⁴ The district court construed “device code” but refused to construe “vehicle device.” CalAmp argued that “vehicle device” was an “electrical or electronic component in a vehicle that can be controlled and/or the status thereof read.”¹⁵ CalAmp’s proof of noninfringement was that the accused product could not be controlled by—or have its status read by—the vehicle’s data communications bus. Omega argued that “vehicle device” should not be construed, but argued that an after-market device that connected to the vehicle data bus but which apparently was not controlled by, and did not have its status read via, the data bus was infringing. The Federal Circuit reversed because the district court failed to construe “vehicle device” when a genuine dispute existed as to its scope.¹⁶

The O2 Micro case was a step forward in pursuing the goals of *Markman*. That opinion would have been useful during the homogeneous thermoplastic airbag covers case. First, the court acknowledged the problem of trial courts adopting plain and ordinary meaning “nonconstructions” that do not resolve underlying claim construction disputes.¹⁷ The court also acknowledged that it may not be enough for the trial court to simply define the words of disputed claim phrases when those definitions alone do not resolve a dispute over claim scope.¹⁸

Despite that advancement, when the intrinsic record is not on your side, the incentive to bury a claim construction argument in “plain and ordinary

meaning” remains, and O2 Micro makes clear that it is only “[w]hen the parties raise an actual dispute regarding the proper scope of these claims” that “the court, not the jury, must resolve that dispute.”¹⁹ The reality is that claim construction disputes often unfold as the parties develop their infringement and invalidity positions. The full scope of the disputes may not be apparent until expert reports are served or summary judgment motions are filed, and courts are not necessarily inclined to revisit claim construction at that stage of a case. A party may be deemed to have “waived” a dispute simply because the dispute was not clear based on the record that existed at the time of claim construction proceedings, which are typically after infringement and invalidity contentions are served but well before expert reports are served. Thus, you may not see the need to challenge your opponent’s “plain and ordinary meaning” proposal. As a result, many claim construction issues have undoubtedly been effectively decided by the jury even after O2 Micro.

§ IV THE BACKFIRE

Recent Cautionary Tale About Using Plain and Ordinary Meaning

A recent case suggests that the strategy of burying claim construction disputes in “plain and ordinary meaning” can backfire. In *WhereverTV, Inc. v. Comcast Cable Communications, LLC*, the claim at issue was for a “content manager device,” and the claim required that “the application allow[] for . . . adding or deleting channels.”²⁰ Plaintiff WhereverTV (WTV) argued that subscribing or unsubscribing to a channel satisfied the limitation. However, WTV did not request construction of the term, but rather requested that it be given its “plain and ordinary meaning,” which meant no construction at all. The court held that in order to show infringement, WTV had to show that a user could actually delete the app from the interactive program guide.²¹ It seems clear, but apparently not to the trial court, that the court effectively construing “adding or deleting channels” so that subscribing or unsubscribing was not within its scope was an act of implicit claim construction.

Remarkably, the Federal Circuit reversed and entered its own unsolicited claim construction under which the subject claim limitation did read on the

accused Comcast system. The Federal Circuit held that the “district court purported to use the plain and ordinary meaning of the limitation, which in its view excluded the broader understanding that WhereverTV asserted,” and then said, “[w]e adopt WhereverTV’s broader construction.”²² Instead of acknowledging that both WTV and the district court applied implicit claim constructions in purporting to apply the “plain and ordinary meaning” in their infringement analyses, the Federal Circuit acted as if WTV explicitly requested an express construction commensurate with its infringement argument. The Federal Circuit opinion does not even mention that WTV requested “plain and ordinary meaning.” None too happy about it, Comcast petitioned the Supreme Court for certiorari, but that petition was denied.²³ Comcast’s petition contended that the WTV claim construction was a waived, nonjurisdictional issue that was improperly decided by the Federal Circuit.

The terms at issue

FIVE DISPUTED PHRASES

CLAIM PHRASE / MATTER	COMPETING READINGS	DISPOSITION
“homogeneous thermoplastic” Airbag covers · author’s case	Thermoplastic <i>throughout</i> vs. the <i>same</i> thermoplastic throughout.	UNRESOLVED Court construed “homogeneous” and “thermoplastic” word by word; the scope dispute survived.
“melting” Ultrasonic liposuction · author’s case	Whether the device’s processing of fat is properly characterized as melting it.	UNRESOLVED Little dispute about what the device did; the <i>Markman</i> process still did not resolve the issue.
“only if” <i>O2 Micro</i> , 521 F.3d 1351 (Fed. Cir. 2008)	Plain and ordinary meaning vs. limited to steady-state operation.	REVERSED A “nonconstruction” is inadequate where it does not resolve the parties’ dispute.
“vehicle device” <i>Omega v. CalAmp</i> , 920 F.3d 1337 (Fed. Cir. 2019)	No construction vs. a component that can be controlled or have its status read.	REVERSED Failure to construe where a genuine dispute existed as to scope.
“adding or deleting channels” <i>WhereverTV v. Comcast</i> (Fed. Cir. 2025)	Subscribing or unsubscribing vs. actually deleting from the program guide.	VACATED Federal Circuit entered its own unsolicited broader construction; certiorari denied.

Where Do We Go from Here?

A fundamental problem with claim construction that has never been resolved is how to resolve a dispute over whether a claim covers a particular product when that dispute cannot be resolved using the intrinsic record. What should the default rule be?

In theory, when the scope of a claim cannot be ascertained, the claim could be held indefinite. In order to survive an indefiniteness challenge, “a patent’s claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty.”²⁴ However, courts have seemed disinclined to treat every question of claim scope that is not resolvable on the intrinsic record as demonstrating indefiniteness. In general, it seems that claims are held indefinite when there is a facial ambiguity that is apparent apart from applying the claim to any particular product. The unavoidable fact of writing patents is that there will be unforeseeable variations of an inventive concept that will arise and that whether those variations are encompassed by otherwise facially clear claim language may not be apparent. Given that reality, it seems unfair to hold the claims indefinite and foreclose their future enforcement against products that would fall indisputably within their scope.

Indefiniteness aside, in whose favor should an unresolvable issue of scope be decided? Given the notice function of patent claims, some might say that the claims should be construed narrowly in favor of the accused infringer. Others might say, if there is no clear disclaimer in the specification or file history, the claims should be construed broadly.

Beyond resolving that problem, to the extent courts can scrutinize the parties’ positions and adjudicate the claim constructions on which they are predicated, they should do so. Admittedly, it can be difficult for a court with a full docket to scrutinize a party’s positions for hidden definitions in that manner. Interestingly, the district court in *WhereverTV* seemed to have done that sort of policing even though the Federal Circuit disagreed with its view on the correct implicit construction. For now, *Markman*—when coupled with O2 Micro and patent local rules—has made patent litigation more

orderly and more predictable, but more could be done to achieve the allocation of responsibilities between the judge and jury that *Markman* seemed to call for.

Steven R. Hansen is a registered patent attorney and chemical engineer with over 25 years of experience procuring and enforcing patents in a variety of industries, including 3D printing, automotive parts, medical devices, and consumer electronics. He can be reached at srh@hanseniplaw.com.

Endnotes

1. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995).
2. J. Jonas Anderson & Peter S. Menell, *Informal Deference: A Historical, Empirical, and Normative Analysis of Patent Claim Construction*, 108 Nw. U. L. Rev. 1, 40–41 (2014).
3. 415 F.3d 1303 (Fed. Cir. 2005).
4. 90 F.3d 1576 (Fed. Cir. 1996).
5. *Phillips*, 415 F.3d at 1320–21.
6. *Id.* at 1323.
7. *Id.*
8. *Vitronics*, 90 F.3d at 1584.
9. *Phillips*, 415 F.3d at 1318–19.
10. 521 F.3d 1351 (Fed. Cir. 2008).
11. *Id.* at 1360–61.
12. *Id.* at 1362.
13. *Id.* at 1361.
14. 920 F.3d 1337 (Fed. Cir. 2019).
15. *Id.* at 1346.
16. *Id.* at 1346–47. Other cases involving this sort of “burying” of a claim construction by seeking a “plain and ordinary meaning” nonconstruction include *Apple, Inc. v. Samsung Electronics Co., Ltd.*, 67 F. Supp. 3d 1100 (N.D. Cal. 2014); *Nomura v. YouTube, LLC*, Nos. C-11-01208 HRL, C-11-01210 HRL, 2013 U.S. Dist. LEXIS 18292 (N.D. Cal. Feb. 8, 2013) (unpublished); and *NobelBiz, Inc. v. Global Connect, LLC*, 701 F. App’x 994 (Fed. Cir. 2017) (unpublished).
17. *O2 Micro*, 521 F.3d at 1361.
18. *Id.* at 1311.
19. *Id.* at 1360 (emphasis added).
20. No. 2:18-cv-529-WFJ-NPM, 2023 U.S. Dist. LEXIS 97507, at *4 (M.D. Fla. June 5, 2023), vacated and remanded, Nos. 2023-2098, 2023-2150, 2025 U.S. App. LEXIS 18680 (Fed. Cir. July 28, 2025) (unpublished).
21. *Id.* at *16.
22. *WhereverTV*, 2025 U.S. App. LEXIS 18680, at *17–18.
23. *Comcast Cable Commc’ns, LLC v. WhereverTV, Inc.*, 146 S. Ct. 1671 (2026).

24. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014).