Clash of the Titans: Daubert v. Markman - Fact Experts in Legal Hearings

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TABLE OF CONTENTS

I. INTRODUCTION .................................................2

II. PRE-GAME ROUTINE ...................................................6

III. THE MAIN EVENT .....................................................8

   A. THE DAUBERT PLAYERS ........................................8
      1. Stopping short of admissibility ...............................9
      2. Catching a Frye ball .......................................12
      3. The final score: 7-2 reversal by the Supremes .........12

   B. THE MARKMAN ARENA ............................................15
      1. The opening pitch: Herbert Markman's invention as seen by Judge Katz (Eastern District of Pennsylvania) ..............15
      2. Firestorm of controversy at the Court of Appeals for the Federal Circuit .................................17
      3. Appeal Play: unanimous 9-0 opinion from the Supremes ........................................20
      4. Post-game analyses: Cybor, Phillips, and the state of claim construction .........................................21

   C. PLAY ANALYSIS: DAUBERT MOTIONS .........................24
      1. The umpires: approval by the courts to use experts in Markman proceedings ..........................25
      2. The rule books: Patent Local Rules expressly allowing designation of claim construction experts ...27

   D. HOME RUN (RULE 402) v. TRIPLE (DAUBERT) .............29
      1. Out in left field: the Daubert motion .......................31
      2. Pinch hitter: enter, the Rule 402 motion .................35
      3. Too close to call: right for the wrong reason (Rule 402 motion disguised as a Daubert motion) ....37
      4. Double play: Daubert "plus" ................................39

IV. CONCLUDING REMARKS ............................................43

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I. INTRODUCTION

Baseball is like church. Many attend but few understand.\(^2\)

As of 2009 the median cost of litigating a patent with more than 25 million dollars at risk was estimated at approximately 5.5 million dollars.\(^3\) It is now well-established that the first substantive role for any trial court in a patent infringement lawsuit is to construe the patent claims to determine the exact scope of the subject-matter of the patent.\(^4\) The claim-construction proceeding, designated as a "Markman proceeding,"\(^5\) often determines the outcome of these multi-million-dollar

\(^2\) Wesley Noreen "Wes" Westrum (1922-2002), New York Giants catcher. While we have chosen headings and sayings pilfered from baseball, we expressly disclaim that this paper has any relevance to baseball. We further disclaim any expertise in baseball, other than some very limited experience in imbibing cold beers at tail-gating parties.


\(^4\) Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1480 (Fed. Cir. 1998) (en banc) (Newman, J., dissenting) ("Patent litigation now often starts with a preliminary hearing to interpret the disputed claim terms . . . .").

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

Unfortunately, some practitioners and judges misunderstand the

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6 Markman v. Westview Instruments, Inc., 52 F.3d 967, 989 (en banc) (Mayer, J., concurring) ("All these pages and all these words cannot camouflage what the court well knows: to decide what the claims mean is nearly always to decide the case."); Cybor, 138 F.3d at 1480 (en banc) (Newman, J., dissenting) ("This preliminary [Markman] ruling can be dispositive of the dispute, for the scope of the claim often decides whether there can be literal infringement."); see also Christian A. Chu, Empirical Analysis of the Federal Circuit's Claim Construction Trends, 16 BERKELEY TECH. L.J. 1075 (2001). It is worthwhile to note that, while Chu provides an excellent review of the Federal Circuit's patent-related decisions at the appellate court level, Chu does not explicitly provide a correlation between claim construction and infringement at the trial court level. However, close scrutiny of Chu's statistics reveals that the claim construction is, indeed, outcome determinative.

7 Phillips v. AWH Corp., 415 F.3d 1303, 1332 (Fed. Cir. 2005) (en banc) (Mayer, J., dissenting) ("During so called Markman 'hearings,' which are often longer than jury trials, parties battle over experts offering conflicting evidence regarding who qualifies as one of ordinary skill in the art; the meaning of patent terms to that person, the state of the art at the time of the invention; contradictory dictionary definitions and which would be consulted by the skilled artisan; the scope of specialized terms; the problem a patent was solving; what is related or pertinent art; whether a construction was disallowed during prosecution; how one of skill in the art would understand statements during prosecution; and on and on.").

8 Phillips, 415 F.3d. at 1332 (Mayer, J., dissenting).
role of expert witnesses in the context of Markman proceedings.

As a result, practitioners often file complicated Daubert motions, under Rule 702 of the Federal Rules of Evidence, to disqualify experts from Markman proceedings. In this paper, we

9 It should be noted that the Federal Rules of Evidence provide for (1) experts retained by a party (see, e.g., Fed. R. Evid. 702); and (2) court-appointed experts (see, e.g., Fed. R. Evid. 706). This paper addresses only the role of a party's expert and not the role of a court-appointed expert. Thus, unless otherwise noted, the term "expert witness" refers to a party's expert rather than a court-appointed expert.


11 "If scientific, technical, or other specialized knowledge will assist the trier of fact to understand the evidence or to determine a fact in issue, a witness qualified as an expert by knowledge, skill, experience, training, or education, may testify thereto in the form of an opinion or otherwise, if (1) the testimony is based upon sufficient facts or data, (2) the testimony is the product of reliable principles and methods, and (3) the witness has applied the principles and methods reliably to the facts of the case." Fed. R. Evid. 702.

analyze the propriety of employing such Daubert motions in Markman proceedings.

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

Once the scope of the paper has been defined, the first substantive section of this paper analyzes Daubert, identifying the legal principles that are germane to this paper. Next, we analyze Markman and its progeny, and discuss Markman's significance in claim construction. Following the review of both Daubert and Markman, we attempt to explain why the practice

\begin{footnotesize}
\begin{enumerate}
\item 509 U.S. 579 (1993).
\item 517 U.S. 370 (1996).
\end{enumerate}
\end{footnotesize}
of introducing expert witnesses for Markman proceedings is so prevalent. We then analyze how litigants have used Daubert motions to oppose experts in Markman proceedings. Finally, we propose that a complicated Daubert motion is an improper mechanism for opposing an expert witness for a Markman proceeding, and a simpler Rule 402 motion is more appropriate.

II. PRE-GAME ROUTINE

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

At the outset, we emphasize that we state no opinion on whether or not Daubert was properly decided. Instead, we take the law on expert witnesses as it currently stands, providing only the necessary background on Daubert to shed light on our primary topic.

Also, while the fact-law distinction in claim construction has been controversial ever since the original Markman decision,\textsuperscript{16} we

\textsuperscript{15} George Lee "Sparky" Anderson (b. 1934), Major League Baseball manager.

\textsuperscript{16} The original Markman decision from the Federal Circuit resulted in four separate opinions. See, Markman, 52 F.3d 967 (Fed. Cir. 1995) (en banc) (Archer, C.J., joined by Rich, Nies, Michel, Plager, Lourie, Clevenger, and Schall, JJ.); id.
do not address the merits or demerits of those various positions. Others have written extensively on whether or not claim construction should be devoid of factual inquiries.\textsuperscript{17} Thus, the question of whether claim construction should be a question of law, a question of fact, or a mixed question of law and fact is beyond the scope of this paper. Instead, we take the law on claim construction as it currently stands, describing Markman and its progeny only to the extent necessary to keep the right frame of mind for our main topic.

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

\textsuperscript{17} See, \textit{e.g.}, \textit{Cybor}, 138 F.3d at 1462 (en banc) (Plager, J., concurring); id. at 1463 (Bryson, J., concurring); id. (Mayer, J., concurring); id. at 1473 (Rader, J., dissenting); id. at 1478 (Newman, J., dissenting); \textit{Phillips}, 415 F.3d at 1328 (Fed. Cir. 2005) (en banc) (Lourie, J., dissenting); id. at 1330 (Mayer, J., dissenting); Lauren Maida, Patent Claim Construction: It’s Not a Pure Matter of Law, So Why Isn’t the Federal Circuit Giving the District Courts the Deference they Deserve?, 30 \textit{Cardozo} L. Rev. 1773 (March 2009).
III. THE MAIN EVENT

You can observe a lot by watchin’.

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

A. THE DAUBERT PLAYERS

The most overrated underrated player in baseball.

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

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18 Lawrence Peter "Yogi" Berra (b. 1925), Major League Baseball player and manager.

1. Stopping short of admissibility

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

At trial, Jason Daubert's attorneys introduced eight expert witnesses in an effort to show that Bendectin was the cause of

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22 To avoid ambiguity in this paper, we use Jason Daubert's full name to identify the individual, and we simply use the last name, Daubert, to identify the case.

23 Daubert, 727 F. Supp. at 571.

24 The expert witnesses were: (1) Dr. Adrian Gross, a licensed and accredited veterinarian with experience in pathology and toxicology; (2) Dr. Stuart Newman, a specialist in developmental biology; (3) Dr. Alan Done, a medical doctor with specialties in pediatrics, clinical pharmacology, and toxicology; (4) Dr. Shanna Swan, an epidemiologist and biostatistician practicing in the field of reproductive epidemiology; (5) Dr. Jay Glasser, a specialist in biostatistics, epidemiology, and biometry; (6) Dr. Wayne Snodgrass, an associate professor of pediatrics, and pharmacology and toxicology; (7) Dr. Johannes Thiersch, a specialist in pathology and pharmacology; and (8) Dr. John
his birth defects. In short, these experts recalculated the data from a previous study to show that there was a significant relationship between Bendectin and birth defects.\footnote{Daubert, 727 F. Supp. at 575.} However, no independent experiments were conducted,\footnote{Id.} nor were the experts' recalculations peer-review published.\footnote{Id.}

Conversely, Merrell-Dow introduced evidence, to which Jason Daubert's experts agreed, that no peer-review-published articles had shown a statistically-significant association between Bendectin and birth defects.\footnote{Id.} Rather, all of the peer-review-published literature showed that there was no statistically-significant correlation between Bendectin and birth defects. Gauging these conflicting testimonies according to Rule 703 of the Federal Rules of Evidence,\footnote{"The facts or data in the particular case upon which an expert bases an opinion or inference may be those perceived by or made known to the expert at or before the hearing. If of a type reasonably relied upon by experts in the particular field in forming opinions or inferences upon the subject, the facts are relevant, Rule 703 does not require that they be admissible in a court of law."
Daubert, 727 F. Supp. at 574.} Judge Gilliam held that the

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\footnote{Daubert, 727 F. Supp. at 575.}

\footnote{Id.}

\footnote{Id.}

\footnote{Id.}
testimonies of Jason Daubert's experts were inadmissible.\textsuperscript{30} Judge Gilliam reasoned that "[a] necessary predicate to the admission of scientific evidence is that the principle upon which it is based must be sufficiently established to have general acceptance in the field to which it belongs."\textsuperscript{31} Insofar as the experts' recalculationst were not peer-review published, those recalculationst had not gained general acceptance and were therefore inadmissible.\textsuperscript{32}

Judge Gilliam's grant of summary judgment for Merrell-Dow was appealed to the Ninth Circuit Court of Appeals.\textsuperscript{33}

\textsuperscript{30} Daubert, 727 F. Supp. at 572 ("Unfortunately for the plaintiffs, the prevailing school of thought warrants summary judgment in this case.").

\textsuperscript{31} Id. at 572 (citing United States v. Kilgus, 571 F.2d 508, 510 (9th Cir. 1978)).

\textsuperscript{32} Id.

\textsuperscript{33} Daubert v. Merrell Dow Pharm., Inc., 951 F.2d 1128 (9th Cir. 1991).
2. Catching a Frye\textsuperscript{34} ball

The Ninth Circuit Court of Appeals affirmed Judge Gilliam's summary judgment ruling, and held that expert evidence must meet the test set forth in Frye v. United States,\textsuperscript{35} namely, that expert evidence must be "generally accepted as a reliable technique among the scientific community."\textsuperscript{36}

Using language that would be a harbinger of the Supreme Court decision to follow, the Ninth Circuit expressly declined to follow conflicting Third Circuit standards, insofar as the Third circuit rejected the Frye "generally accepted" standard and "left open the possibility that expert testimony based on the reanalysis of epidemiological studies may be admissible if it can be shown to be reliable and not too likely to overwhelm, confuse or mislead the jury."\textsuperscript{37}

3. The final score: 7–2 reversal by the Supremes

Having lost at the Ninth Circuit, Jason Daubert petitioned for

\textsuperscript{34} Frye v. United States, 293 F. 1013 (D.C. Cir. 1923).

\textsuperscript{35} 293 F. 1013 (D.C. Cir. 1923).

\textsuperscript{36} Daubert, 951 F.2d at 1129.

\textsuperscript{37} Daubert, 951 F.2d at 1130 n.2.
certiorari to the Supreme Court of the United States, which the Supreme Court granted.\(^\text{38}\) In setting the standard for admitting expert testimony, the Supreme Court held that the Federal Rules of Evidence superseded, rather than codified, the Frye "general acceptance" test.\(^\text{39}\) This, the Supreme Court did, being cognizant of the sharp division among the courts and commentators.\(^\text{40}\)

Relevant to this paper, in construing Rules 702 and 703 of the Federal Rules of Evidence, the majority opinion recited no less than twenty-two (22) times that these rules related to "facts."\(^\text{41}\)

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\(^{39}\) Daubert, 509 U.S. at 587 ("Petitioners' primary attack, however, is not on the content but on the continuing authority of the rule. They contend that the Frye test was superseded by the adoption of the Federal Rules of Evidence. We agree."); id. at 589 n.6 ("we hold that Frye has been superseded . . .").

\(^{40}\) Id. at 587 n.5 (1993) (acknowledging the different positions: "Frye is superseded by the Rules of Evidence"; "Frye and the Rules coexist"; "Frye is dead"; and "Frye lives.").

\(^{41}\) Id. at 587 ("to make the existence of any fact that is of consequence"); id. at 588 ("assist the trier of fact"); id. ("to determine a fact in issue"); id. at 589 ("sensible triers of fact to evaluate conflicts"); id. ("assist the trier of fact"), emphasis in original; id. ("determine a fact in issue"); id. at 590 ("applies to any body of known facts"); id. ("any body of ideas inferred from such facts"); id. at fn. 9 ("a witness who testifies to a fact which can be perceived"); id. at 591 ("assist the trier of fact"); id. ("determine a fact in issue"); id. ("expert testimony proffered in the case is sufficiently tied to the facts of the case"); id. ("aid the jury in resolving a factual dispute");
Never once did the Supreme Court indicate, either expressly or inerenterially, that expert testimony under Rule 702 applied to purely legal issues. Indeed, the dissenting opinion expressly acknowledged that such "scientific knowledge, scientific method, scientific validity, and peer review" were "matters far afield from the expertise of judges." Since Rule 702 extended to "technical, or other specialized knowledge," there was little doubt that "technical, or other specialized knowledge" would also be factual inquiries.

Thus, it was clear that the sole purpose of a Daubert expert, under the Federal Rules of Evidence, was to "assist the trier of fact to understand the evidence or to determine a fact in

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\text{\textit{id.} ("is a fact in issue"); id. ("knowledge will assist the trier of fact"); id. ("will not assist the trier of fact"); id. at 592 ("will assist the trier of fact"); id. ("understand or determine a fact in issue"); id. at 593 ("whether that reasoning or methodology properly can be applied to the facts"); id. ("assist the trier of fact"); id. at 595 ("admitted only if the facts or data are of a type reasonably relied upon by experts"); and id. at fn. 13 ("adjudicative fact-finding").

\text{\textsuperscript{42} Daubert, 509 U.S. at 599.}

\text{\textsuperscript{43} Id.}

\text{\textsuperscript{44} Id. at 590 n.8 ("Rule 702 also applies to 'technical, or other specialized knowledge.'").}
issue."\(^{45}\)

**B. THE MARKMAN ARENA**

In baseball, my theory is to strive for consistency, not to worry about the numbers. If you dwell on statistics you get shortsighted, if you aim for consistency, the numbers will be there at the end.\(^{46}\)

Having established that *Daubert* relates to Rule 702 and 703 of the Federal Rules of Evidence, and that Rules 702 and 703 are directed solely to experts who "assist the trier of fact to understand the evidence or to determine a fact in issue,"\(^ {47}\) we now turn to the specific patent arena in which experts are called to testify: the *Markman* proceeding.

1. **The opening pitch: Herbert Markman's invention as seen by Judge Katz (Eastern District of Pennsylvania)**

We find ourselves part-way through Herbert Markman's saga,\(^ {48}\) his

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\(^{45}\) Fed. R. Evid. 702 (emphasis supplied).

\(^{46}\) George Thomas "Tom" Seaver (b. 1944), Major League Baseball pitcher.

\(^{47}\) Fed. R. Evid. 702, 703.

\(^{48}\) To avoid confusion, we use Herbert Markman's full name to refer to the individual. By contrast, when referring to the cases, we use the italicized last name, Markman, along with the required short cite to distinguish between the district
invention having traveled, not once but twice, through the United States Patent and Trademark Office ("USPTO"), eventually maturing into United States Reissue Patent Number 33,054 ("the '054 patent").

Herbert Markman asserted his patent against Westview Instruments, Inc., and Athlon Enterprises, Inc. (collectively, "Westview"), in the Eastern District of Pennsylvania. At the end of Herbert Markman's case-in-chief, Westview moved for a directed verdict of non-infringement. Judge Katz deferred his ruling on Westview's motion, and the jury eventually found that Westview infringed claims 1 and 10 of the '054 patent. Judge Katz, in a relatively-unremarkable three-page order, granted Westview's motion for a directed verdict, holding that the "question of claim construction is a matter of law for the court order, the various opinions from the Court of Appeals for the Federal Circuit, and the Supreme Court opinion.


50 Markman v. Westview Instruments, Inc., 52 F.3d 967, 973 (Fed. Cir. 1995).

51 Id.

52 Id.
From this ruling, Herbert Markman appealed.

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

Rather than assigning a panel to review Judge Katz' three-page order, the Court of Appeals for the Federal Circuit sua sponte granted en banc review. Judge Katz' three-page order spawned almost sixty pages of sharply-divided opinions from the Court of Appeals for the Federal Circuit, including the majority opinion, two concurring opinions, and a lone dissent.

Looking solely to the issue of claim construction, Chief Judge Archer, writing for the majority, held that "claim construction is properly viewed solely as a question of law[.]" As such,

53 Markman, 772 F. Supp. at 1536.
54 Markman, 52 F.3d 967.
56 Id. at 989-998 (Mayer, J., concurring); id. at 998-999 (Rader, J., concurring).
57 Id. at 999-1026 (Newman, J., dissenting).
58 Id. at 983-984.
"construing and determining the scope of the claims in a patent, is strictly a legal question for the court."\textsuperscript{59} In short, the majority held that claim construction was devoid of any factual inquiry.

On the other hand, according to Judge Mayer, "this court (including the judges in the majority) has always held that claim interpretation is a matter of law depending on underlying factual inquiries."\textsuperscript{60} As such, claim construction is a legal inquiry, "except when they contain technical words, or terms of art, or when the instrument is introduced in evidence collaterally, and where its effect depends not merely on the construction and meaning of the instrument, but upon extrinsic facts and circumstances, in which case the inference to be drawn from it must be left to the jury."\textsuperscript{61}

Almost as unremarkable as Judge Katz' district-court order was Judge Rader's concurrence, which noted that the fact-law issue was not before the court. Thus, the "court should decline to answer a question better left to a case that truly raises it,

\textsuperscript{59} Id. at 984.

\textsuperscript{60} Markman, 52 F.3d at 989.

\textsuperscript{61} Id. at 997 (citing Goddard v. Foster, 84 U.S. (17 Wall.) 123 (1873)).
and therefore provides an informed basis for its resolution.”

In a loquacious dissent, Judge Newman examined the history of patent law, the policy reasons supporting her dissent, and the constitutional basis for why claim interpretation "requires finding the factual meaning and scope of the terms of scientific art and technology and usage by which the patentee described and claimed the invention.” In her dissent, Judge Newman expressly criticized the majority for holding "that this is a matter of law, devoid of any factual component; and subject to de novo appellate determination.” As a harbinger of the topic of this paper, Judge Newman asked:

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

As one can readily discern from the split within the Federal

62 Id. at 998.
63 Id. at 999.
64 Markman, 52 F.3d at 999.
65 Id. at 1005.
Circuit, whether claim construction is a pure question of law, pure question of fact, or a mixed question of law and fact was thoroughly vetted by the varying opinions that were generated in Markman.

To address this split, the Supreme Court of the United States granted certiorari. 66

3. Appeal Play: unanimous 9-0 opinion from the Supremes

In conjunction with the grant of certiorari, 67 the Supreme Court permitted the filing of a host of amicus briefs. 68 Predictably, the amicus briefs reflected the majority, concurrence, and dissent from the Federal Circuit.

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67 Id.
68 In addition to the brief for Petitioners and Respondents, briefs by amicus curiae were filed by Intellectual Property Owners; United States Surgical Corporation; Douglas W. Wyatt; American Intellectual Property Law Association; the Federal Circuit Bar Association; Airtouch Communications, Inc.; Honeywell, Inc.; the American Automobile Manufacturers Association; Matsushita Electric Corporation and Matsushita Electric Industrial Co., Ltd.; the Dallas-Fort Worth Intellectual Property Law Association; John T. Roberts; Exxon Corporation, Exxon Chemical Patents, Inc., and Exxon Research and Engineering Company; the Association of Trial Lawyers of America; and Litton Systems, Inc.
Despite this sharp division from the Federal Circuit as well as the patent legal community, the Supreme Court's decision was a unanimous 9-0 holding "that the construction of a patent, including terms of art within its claims, is exclusively within the province of the court." Thus, it became undisputed that the role of claim construction fell to the judge, and not to the jury. While it may be splitting hairs, the Supreme Court laid to rest the question of who construes the claims, but, arguably, the question of whether claim construction was a pure question of law was still unresolved.

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

4. Post-game analyses: Cybor, Phillips, and the state of claim construction

In 1998, shortly after the Supreme Court's ruling, in another en banc ruling the majority of the Federal Circuit held that claim

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70 Id.

71 Cybor, 138 F.3d 1448 (Fed. Cir. 1998) (en banc).

72 Phillips, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).
construction was purely a legal issue subject to de novo review on appeal. 73 Similar to Markman, 74 a highly divided Federal Circuit in Cybor Corp. v. FAS Technologies, Inc., 75 produced no less than six opinions, including a majority opinion, 76 three concurring opinions, 77 and two dissenting opinions. 78 Suffice it to say, with all of the issues thoroughly addressed en banc by the Federal Circuit, it was clear that claim construction was purely an issue of law, devoid of any factual component, to be reviewed de novo on appeal.

If arguably Cybor 79 did not create certainty that claim construction was devoid of any factual inquiry, then Phillips v. AWH Corp. 80 certainly did. It is evident from the opening line

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73 Cybor, 138 F.3d 1448 (Fed. Cir. 1998) (en banc).
74 Markman, 52 F.3d at 973.
75 138 F.3d 1448 (Fed. Cir. 1998) (en banc).
76 Cybor, 138 F.3d at 1451-1462 (en banc) (Archer J., joined by Rich, Michel, Plager, Lourie, Clevenger, Schall, Bryson, and Gajarsa, JJ.).
77 Cybor, 138 F.3d at 1462-1463 (Plager, J., concurring); id. at 1463 (Bryson, J., concurring); id. at 1463-1472 (Mayer, C.J., and Newman, J., concurring).
78 Cybor, 138 F.3d at 1473-1478 (Rader, J., dissenting); id. at 1479-1481 (Newman, J., and Mayer, C.J., dissenting).
79 138 F.3d 1448 (Fed. Cir. 1998) (en banc).
80 415 F.3d 1303 (Fed. Cir. 2005) (en banc).
of Judge Mayer's scathing dissent that the en banc appellate court thoroughly examined the issue of whether or not claim construction involved any factual inquiry:

Now more than ever I am convinced of the futility, indeed the absurdity, of this court's persistence in adhering to the false-hood that claim construction is a matter of law devoid of any factual component.\textsuperscript{81}

Hence, in view of Markman,\textsuperscript{82} Cybor,\textsuperscript{83} and Phillips,\textsuperscript{84} and given the thorough analysis of the issues by the Federal Circuit, it is now settled, whether for better or for worse, that claim construction is purely a legal issue, devoid of any factual component.

\textsuperscript{81} Phillips, 415 F.3d at 1330 (Mayer, J., dissenting).

\textsuperscript{82} Markman, 517 U.S. 370 (1996); Markman, 52 F.3d 967, 989 (Fed. Cir. 1995) (en banc) (Archer, C.J., majority); id. at 989-998 (Mayer, J., concurring); id. at 998-999 (Rader, J., concurring); id. at 999-1026 (Newman, J., dissenting).

\textsuperscript{83} Cybor, 138 F.3d 1448, 1462 (Fed. Cir. 1998) (en banc) (Plager, J., concurring); id. at 1463 (Bryson, J., concurring); id. (Mayer, J., concurring); id. at 1473 (Rader, J., dissenting); id. at 1478 (Newman, J., dissenting).

\textsuperscript{84} Phillips, 415 F.3d at 1328 (Fed. Cir. 2005) (en banc) (Lourie, J., dissenting); id. at 1330 (Mayer, J., dissenting).
C. PLAY ANALYSIS: DAUBERT MOTIONS

Swing hard, in case they throw the ball where you're swinging. \(^85\)

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

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

\(^85\) Edwin Donald "Duke" Snider (b. 1926), American baseball player.
1. The umpires: approval by the courts to use experts in Markman proceedings

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

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

We have also held that extrinsic evidence in

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86 Markman, 517 U.S. at 389 ("It is, of course, true that credibility judgments have to be made about the experts who testify in patent cases, and in theory there could be a case in which a simple credibility judgment would suffice to choose between experts whose testimony was equally consistent with a patent's internal logic.").

87 Cybor, 138 F.3d at 1455 n.5 (internal brackets omitted).

88 Id. (internal quotations omitted).
the form of expert testimony can be useful to a court for a variety of purposes, such as to provide background on the technology at issue, to explain how an invention works, to ensure that the court’s understanding of the technical aspects of the patent is consistent with that of a person of skill in the art, or to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field.  

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

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

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89 Phillips, 415 F.3d at 1318.

90 Id.

91 Cybor, 138 F.3d at 1455.

92 Cybor, 138 F.3d at 1455.
Insofar as the Supreme Court and the Federal Circuit have apparently approved of claim construction experts, it is understandable how litigants would take up the Courts' invitation to engage experts for *Markman* proceedings. Additionally, since experts, in general, are addressed by Rule 702 of the Federal Rules of Evidence, one can see how *Daubert* becomes the default vehicle for litigants to oppose claim construction experts.

2. The rule books: Patent Local Rules expressly allowing designation of claim construction experts

In addition to the cases that permit expert witnesses in *Markman* proceedings, various Patent Local Rules\(^{93}\) provide procedural guidelines for claim construction experts.\(^{94}\) These Patent Local Rules provide a mechanism by which parties must identify expert witnesses, describe the substance of their experts' testimonies,

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\(^{93}\) While some jurisdictions refer to the patent rules as "Local Patent Rules," other jurisdictions refer to them as "Patent Local Rules." For this paper, we will use "Patent Local Rules" with the understanding that the only difference in the title is stylistic and not substantive.

\(^{94}\) As of 2009 July, there were ten federal district courts that had adopted local patent rules (N.D. Cal.; S.D. Cal.; N.D. Ga.; D. Mass.; E.D.N.C.; D.N.J.; W.D. Pa.; E.D. Tex.; S.D. Tex.; and W.D. Wash.); one district court that had proposed Local Patent Rules (N.D. Ill.); and one sitting judge, the
or introduce live testimony during Markman hearings.\textsuperscript{95}

Interestingly, some of the Patent Local Rules distinguish between claim-construction experts and non-claim-construction experts.\textsuperscript{96} As such, while it appears that these Patent Local Rules treat non-claim-construction experts as those that are

\textsuperscript{95} Patent L.R. 4-2(b), 4-3(b), and 4-3(d) (N.D. Cal.); Patent L.R. 4.1b, 4.1d, 4.2a, 4.2c1, and 4.3 (S.D. Cal.); Patent L.R. 6.2(b), 6.3(b)(2), and 6.3(b)(4) (N.D. Ga.); LR 16.6(A)(3)(a) (D. Mass.); LR 16.6(B), Appendix - Sample Scheduling Order for Patent Infringement Cases, ¶¶(B)(4)(a), (B)(4)(b) (D. Mass.); Local Patent Rules 304.2(b), 304.3(b), and 304.3(d), EDNC (E.D.N.C.); L. Pat. R. 4.2(b), 4.3(b), 4.3(e), and 4.5(c) (D.N.J.); LPR 4.3(b) and 4.3(d) (W.D. Pa.); P.R. 4-2(b), 4-3(b), and 4-3(d) (E.D. Tex.); P.R. 4-2(b), 4-3(a)(2), 4-3(a)(4), and 4-3(b) (S.D. Tex.); Rule 131(b) and 132(f), Local Patent Rules (W.D. Wash.).

\textsuperscript{96} Patent L.R. 7.1(a) (N.D. Ga.) ("For issues other than claim construction to which expert testimony shall be directed, expert witness disclosures and depositions shall be governed by this rule."); LR 16.6(B), Appendix - Sample Scheduling Order for Patent Infringement Cases, ¶ E(2) (D. Mass.) ("If expert discovery has been substantially conducted before a claim construction ruling, then the Court may grant additional time for supplemental expert discovery. Such additional discovery shall be limited to issues of infringement, invalidity, or unenforceability dependent on the claim construction."); Local Patent Rules 305.1(a), EDNC (E.D.N.C.) ("For issues other than claim construction to which expert testimony shall be directed, expert witness disclosures and depositions shall be governed by this rule."); LPR 5.1 (W.D. Pa.) ("For issues other than claim construction to which expert testimony shall be directed, expert witness disclosures and depositions shall be governed by this Rule.").
guided by the Daubert standard, it is unclear whether that same standard applies to claim-construction experts.

In any event, given that such a mechanism exists in the Patent Local Rules to introduce expert testimony in Markman proceedings, it is not surprising that the litigants exploit this opportunity. Also, since some of the Patent Local Rules do not distinguish between claim-construction experts and other experts, it is understandable why litigants ubiquitously employ Daubert motions for both claim-construction experts and non-claim-construction experts.

D. HOME RUN (RULE 402) v. TRIPLE (DAUBERT)

I don't know why people like the home run so much. A home run is over as soon as it starts. The triple is the most exciting play of the game. A triple is like meeting a woman who excites you, spending the evening talking and getting more excited, then taking her home. It drags on and on. You're never sure how it's going to turn out.\textsuperscript{97}

Having conjectured on why parties employ claim construction experts, we now turn to several examples of how litigants have used Daubert motions in their attempts to disqualify claim construction experts. Before doing so, we note that this paper

\textsuperscript{97} George Arthur Foster (b. 1948), Major League Baseball left fielder.
is not intended to provide an exhaustive analysis of all cases where Daubert motions have been filed in Markman hearings.\textsuperscript{98} As such, we select only a handful of cases to illustrate our point.

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

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

\textsuperscript{98} Several cases are recited in fn. 12, supra. However, only a handful of those cases are analyzed in this paper because a similar analysis can be applied to those above-cited-but-not-specifically-analyzed cases.
1. Out in left field: the Daubert motion

The first set of cases exemplifies the typical Daubert attack based on: (a) reliability of an expert's testimony;99 (b) the "fit" between the expert's testimony and the issue at hand;100 or (c) both reliability and "fit."

In Flo Healthcare Solutions, LLC v. Rioux Vision, Inc.,101 the plaintiff used the first prong of Daubert, namely, the reliability prong. Flo opposed the defendant's expert by attacking the methodology used by the expert to construe the claims. In particular, the plaintiff argued that, since claim construction requires consultation of the specification to determine the true meaning of the claims, "failing to consider the teachings of the specification render[ed] any proposed claim construction inherently flawed."102 In short, "[d]espite the

99 Daubert, 509 U.S. at 589-590 (noting that expert testimony must be reliable).

100 Daubert, 509 U.S. at 591-592 (noting that expert testimony must assist the trier of fact, i.e., it must be helpful).


clarity with which the Federal Circuit has outlined the claim construction process, Morrow [the defendant's expert] did not follow it."\textsuperscript{103} As such, "Morrow's claim construction methodology [wa]s contrary to law and, therefore unreliable[,]"\textsuperscript{104} according to the plaintiff.

The defendant in \textit{Mannatech, Inc. v. Glycobiotics International, Inc.}\textsuperscript{105} also used the reliability prong of \textit{Daubert} to attack the expert's methodology. In doing so, the defendant first erected the legal standard for expert testimony by noting:

\begin{quote}
\textit{Daubert} and \textit{Kumho} make it clear the Court must insure that any expert follows an acceptable methodology in arriving at his opinion. In the case of claim construction in patent infringement cases, the Federal Circuit's opinion in \textit{Phillips} provides that methodology, a conclusion that is supported by the Plaintiff's arguments in opposition to the Defendant's \textit{Markman} construction.\textsuperscript{106}
\end{quote}

\textsuperscript{103} Flo Healthcare Mem. at 28.  
\textsuperscript{104} Flo Healthcare Mem. at 31. 
\textsuperscript{105} No. 3:06-CV-00471, 513 F. Supp. 2d 754 (N.D. Tex. 2007). 
From there, the defendant moved to strike all four of the plaintiff's experts because each respective expert had "not relied on any part of the prosecution history of the patent to obtain his opinion; a step in the methodology step clearly required by *Phillips*,"\(^{107}\) "ignore[d] the prosecution history of the patent and jump[ed] directly to extrinsic evidence, all in violation of the teachings of *Phillips*,"\(^{108}\) "fail[ed] to arrive at his own independent opinion,"\(^{109}\) and "fail[ed] to follow [Phillips'] methodology."\(^{110}\)

In *Nidec Corp. v. Victor Co. of Japan, Ltd., et al.*,\(^{111}\) defendant JVC moved to exclude the plaintiff's expert, Dr. Bogy, based on the second prong of *Daubert*, namely, lack of helpfulness or "fit."\(^{112}\) JVC did so by first fashioning a denominator problem (i.e., defining the technical area of the patent, defining Dr.

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\(^{107}\) Mannatech Mot. at 12 (arguing to disqualify expert Yost).

\(^{108}\) Id. (arguing to disqualify expert Tengler).

\(^{109}\) Id. (arguing to disqualify expert Blackburn).

\(^{110}\) Id.

\(^{111}\) No. 4:05-CV-00686 , 2007 WL 4108092 (N.D. Cal. Nov. 16, 2007).

\(^{112}\) *Daubert*, 509 U.S. at 591-592 (noting that expert testimony must assist the trier of fact, i.e., it must be helpful).
Bogy's background, and showing that the two did not overlap).\textsuperscript{113} From this, JVC argued that "the portions of the Bogy Report outside Dr. Bogy's qualifications should be stricken"\textsuperscript{114} because Dr. Bogy did not provide "any independent reasoned explanation or even cit[e] supporting evidence, including the '476 Patent[,]"\textsuperscript{115} and those "statements [we]re precisely the sort of conclusory, unsupported assertions that the Phillips Court cautioned would not be helpful to a court."\textsuperscript{116}

In all of these cases, the litigants: (a) properly cited Daubert's requirement that the expert testimony must assist the trier of fact to determine a fact in issue; and, also, (b) properly cited Markman for the proposition that claim construction is purely a matter of law. Oddly, the litigants

\textsuperscript{113} Notice of Mot., Mot., and Mem. of P. & A. in Supp. of JVC's Mot. to Strike Portions of the Decl. of David B. Bogy, Ph.D. at 7, filed on June 2, 2006, 2006 WL 5646070, Nidec Corp. v. Victor Co. of Japan, Ltd., No. 4:05-CV-00686, 2007 WL 4108092 (N.D. Cal. Nov. 16, 2007) ("While Dr. Bogy may be an experienced scholar with an impressive background in the fields of data storage systems, tribology (i.e., the science of interacting surfaces moving in relation to each other), and the head-disc interface of a hard disc drive, his knowledge, skill, experienced, training, or education does not extend into the spindle motor of a hard disc drive and the fluid dynamic bearing within.").

\textsuperscript{114} Nidec Mot. at 9.

\textsuperscript{115} Nidec Mot. at 10.
nevertheless employed Daubert motions (to exclude experts that assist the trier of fact), when the arbiter in the Markman context is not a trier of fact.

2. Pinch hitter: enter, the Rule 402 motion

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

Rule 402 of the Federal Rules of Evidence recites:

All relevant evidence is admissible, except as otherwise provided by the Constitution of the United States, by Act of Congress, by these rules, or by other rules prescribed by the Supreme Court pursuant to statutory authority. Evidence which is not relevant is not admissible.\(^{117}\)

\(^{116}\) Nidec Mot. at 10.

\(^{117}\) Fed. R. Evid 402 (emphasis supplied).
As previously established, the Markman proceeding requires the court (and not the jury) to determine a purely legal issue, devoid of any factual component. Daubert, on the other hand, addresses experts that ""assist the trier of fact . . . to determine a fact in issue." Thus, if an expert is testifying to facts during a Markman proceeding, then that testimony is irrelevant and, consequently, inadmissible under Rule 402.

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

(a) PARTY designates EXPERT as an expert witness under Rule 702 to assist a trier of fact to determine a fact in issue;

(b) Claim construction is purely a legal issue, devoid of any factual component;

(c) Insofar as EXPERT's role is to assist a trier of fact, and insofar as claim construction is wholly devoid of factual issues, EXPERT's testimony is irrelevant;

(d) Since EXPERT's testimony is irrelevant, it must be stricken as required by Fed. R. Evid. 402.

Section III.B., supra.
Fed. R. Evid. 702 (emphasis supplied).
Fed. R. Evid. 402 ("Evidence which is not relevant is not admissible.").
The Rule 402 motion for relevance vel non is simpler and more elegant than the cumbersome Daubert motion. Additionally, due to the non-overlapping fact-law arenas, the Rule 402 motion is a more appropriate vehicle than a Daubert motion to oppose a fact expert in Markman proceedings.

3. Too close to call: right for the wrong reason (Rule 402 motion disguised as a Daubert motion)

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

Defendant LGE, in Hitachi Plasma Patent Licensing Co., Ltd. v. LG Electronics, Inc., et al., moved to disqualify Hitachi's expert, Dr. Silzars, noting that "Daubert requires that an expert's testimony assist the trier of fact to understand a fact at issue." LGE continued that "[d]eclaring that LGE's constructions are right or wrong is a legal conclusion Dr. Silzars is not qualified to make, and is not helpful to the

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Hence, LGE concluded, "under Fed. R. Evid. 702 and Daubert Dr. Silzars's declaration should be stricken."\textsuperscript{124}

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

(a) The meaning of a claim term is a legal conclusion;\textsuperscript{125}

(b) Dr. Silzar is not qualified to make this legal conclusion;\textsuperscript{126}

(c) Hence, Dr. Silzar's declaration should be stricken.\textsuperscript{127}

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

Compared to conventional Daubert motions,\textsuperscript{128} LGE's "disguised"

\begin{footnotesize}
\textsuperscript{123} Hitachi Mot. at 6.
\textsuperscript{124} Id.
\textsuperscript{125} Id. ("Declaring that LGE's constructions are right or wrong is a legal conclusion . . . ").
\textsuperscript{126} Id. (" . . . a legal conclusion Dr. Silzars is not qualified to make.").
\textsuperscript{127} Id. ("Dr. Silzars's declaration should be stricken.").
\textsuperscript{128} Discussed supra.
\end{footnotesize}
402 motion obviates the need for any technical analysis, thereby simplifying the argument.

4. **Double play: Daubert "plus"**

LGE is not the only litigant to have used a "disguised" Rule 402 motion. In *Kai U.S.A., Ltd. v. Buck Knives, Inc.*,¹²⁹ both parties used traditional *Daubert* arguments in addition to arguments sounding in Rule 402. However, similar to LGE, neither Kai nor Buck cited to Rule 402. Instead, their arguments were advanced under Rule 701.

In this hotly contested case dealing with cutting-edge knife technology, the plaintiff Kai filed its motion first.¹³⁰ In advancing its argument, Kai initially attacked the reliability of Prof. Dornfeld's opinion. Specifically, Kai noted that:

> Prof. Dornfeld's opinion makes no effort to ascertain the level of ordinary skill in the art of knife design and manufacture according to any relevant considerations listed by the Federal Circuit. Thus, it is

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conclusory, speculative and unreliable, and should be stricken on this basis as well.\textsuperscript{131}

After advancing this traditional unreliability argument under the first prong of \textit{Daubert}, Kai proceeded with its irrelevance argument. Similar to LGE, Kai did not cite Rule 402. Instead, Kai cited Rule 701, arguing:

Prof. Dornfeld's declaration and \textit{curriculum vitae} contain no education or experience in patent law. Nevertheless, Prof. Dornfeld offers testimony in his declaration which opines on conclusions of patent law. Prof. Dornfeld's declaration is filled with statements that opine on the correct claim construction.\textsuperscript{132}

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


Legal conclusions regarding claim construction are not within the personal knowledge or experience of Prof. Dornfeld. The Federal Circuit has decisively held that such testimony is entitled to no weight, as claim construction is an issue of law solely in the province of the court. As such, his testimony on such issues cannot be used to support Buck's claim construction arguments and should be stricken.\textsuperscript{133}

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

(a) Prof. Dornfeld is not an expert on patent law;\textsuperscript{134}

(b) The meaning of a claim term is a legal conclusion;\textsuperscript{135}

(c) Prof. Dornfeld is not qualified to make this legal conclusion;\textsuperscript{136}

(d) Hence, Prof. Dornfeld's declaration should be stricken.\textsuperscript{137}

Ignoring Kai's \textit{Daubert} unreliability argument for a moment, it

\textsuperscript{133} Kai Mem. at 17; see also fn. 127, \textit{supra}.

\textsuperscript{134} Kai Mem. at 15 ("Prof. Dornfeld's declaration and curriculum vitae contain no education or experience in patent law.").

\textsuperscript{135} Kai Mem. at 17 ("... claim construction is an issue of law solely in the province of the court.").

\textsuperscript{136} \textit{Id.} ("Legal conclusions regarding claim construction are not within the personal knowledge or experience of Prof. Dornfeld.").

\textsuperscript{137} \textit{Id.} ("As such, his testimony on such issues cannot be used to support Buck's claim construction arguments and should be stricken.").
is evident that Kai's irrelevance argument falls under Rule 402, more so than it does under Rule 701.

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

Having seen both LGE and Kai's irrelevance analyses, even though neither cite to Rule 402, one can readily appreciate that the irrelevance arguments are appealing for their simplicity and their lack of technical jargon. As such, we submit that the Rule 402 motion, rather than a complicated and unnecessary Daubert motion, is the proper mechanism for disqualifying Rule 702 witnesses (who assist the trier of fact to determine a fact in issue) from Markman proceedings (which are devoid of any factual component).

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139 See Fed. R. Evid. 702.

140 Cybor, 138 F.3d at 1455 ("Nothing in the Supreme Court's opinion supports the view that . . . claim construction may involve subsidiary or underlying questions of fact.").
IV. CONCLUDING REMARKS

Why does everybody stand up and sing "Take Me Out to the Ballgame" when they're already there?^{141}

In this paper, we have reviewed both the history and progeny of the Supreme Court's decision in Markman v. Westview Instruments, Inc.^{142} Irrespective of whether or not the judiciary reached the right decision, the clear holding from Markman and its progeny is that claim construction is purely a legal exercise, devoid of any factual inquiry.

We have also analyzed the history of the Supreme Court's decision in Daubert v. Merrell Dow Pharmaceuticals, Inc.^{143} The unambiguous language of Rule 702, and the clear holding in Daubert,^{144} leads us to the conclusion that a Daubert expert exists to "assist the trier of fact to understand the evidence or to determine a fact in issue."^{145}

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^{141} Lawrence Dennis "Larry" Anderson (b. 1952), Major League Baseball pitcher.


^{144} Id.

^{145} Fed. R. Evid. 702 (emphasis supplied).
Since Markman hearings are purely legal hearings, which are devoid of any factual component, it seems axiomatic that opinions on factual matters by experts have no place in Markman proceedings. Yet, contrary to this axiom, patent litigants routinely challenge claim-construction experts through Daubert motions.

We posit in this paper that, since Markman proceedings are wholly devoid of factual inquiries, fact experts are wholly irrelevant to Markman proceedings. As such, Daubert motions, which deal with experts that "assist the trier of fact to understand the evidence or to determine a fact in issue[,]"\textsuperscript{146} are the improper vehicle for opposing claim-construction experts.

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

Predictably, tradition will dictate that fans continue to sing

\textsuperscript{146} Id. (emphasis supplied).
"Take Me Out to the Ballgame" when they are already at the ballgame. Similarly, habit will dictate that patent litigants continue to use Daubert motions to oppose experts in Markman proceedings.