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What the Jury Must Hear: The Supreme Court's Evolving Seventh Amendment Jurisprudence

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Introduction

In the United States, there are two very different views of the value of the civil jury. The first is that the civil jury is a cornerstone of democratic government, a protection against incompetent or oppressive judges, and a way for the people to have an active role in the process of justice.[1] The second is that civil juries are inefficient, unpredictable, swayed by sympathy, and incompetent to decide complex cases.[2] Regardless of the viewpoint held by any particular group, the ability to expand or contract the right to a jury trial has been limited by the constitutional mandate in the Seventh Amendment and in most state constitutions that the right to jury trial must be preserved. Theoretically at least, a constitutionally based mandate cannot be changed by decisions of legislatures or judges. Nonetheless, the parameters of the jury trial right have changed over time, generally, although not exclusively, in the direction of restricting the jury's role. Continuing in that direction, a recent Supreme Court case, *Markman v. Westview Instruments, Inc.*,[3] sets forth a test for determining the jury trial right under the Seventh Amendment which, if followed to its logical conclusion, would dangerously dilute any constitutional guarantee of the right. As this Article discusses, the analysis found in *Markman* differs in substantial respects from the Supreme Court's traditional analysis of the Seventh Amendment guarantee. More recent Supreme Court decisions, however, suggest that *Markman*'s impact may be quite limited.

This Article examines the Supreme Court's evolving Seventh Amendment jurisprudence by focusing on the four strands that have emerged primarily in the twentieth century: first, the historical test of the right to a jury trial, based upon whether the action could have been brought in a court of law in 1791, the time of the Seventh Amendment's ratification; second, the preservation of the "substance" of the jury trial right, as opposed to mere matters of pleading and practice; third, the preservation of the jury right after law and equity courts were merged in 1938; and fourth, the creation of an exception to the Seventh Amendment guarantee for matters which Congress has delegated for decision to non-Article III courts and administrative agencies.

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1 *See* JOHN GUINTHER, THE JURY IN AMERICA xiii-xxviii (1988).

2 See the discussion of jury criticisms in STEPHEN DANIELS & JOANNE MARTIN, CIVIL JURIES AND THE POLITICS OF REFORM 4-17 (1995).

3 517 U.S. 370 (1996).

These four strands provide the background and context for an analysis of recent Supreme Court decisions concerning the jury trial right, in particular the decision of *Markman v. Westview Instruments, Inc.* In *Markman*, the Supreme Court unanimously decided that the construction of patent claims by the judge rather than the jury, including determination of all underlying terms of art, did not violate the Seventh Amendment.[4] The effect of *Markman* was to remove from the jury disputed issues of material fact which may arise in connection with the construction of a patent claim. An important question raised by *Markman* is whether it signals a substantial change in the Court's Seventh Amendment jurisprudence, or whether its impact will merely be limited to the patent law area. It is the thesis of this Article that *Markman* does not foretell a new era in Seventh Amendment jurisprudence. Although the *Markman* analysis differs from traditional Seventh Amendment jurisprudence in a number of critical respects, a comparison with each of the four strands indicates that a partial explanation for the Court's decision may derive from the fourth strand of Seventh Amendment jurisprudence. The Court's deference to congressional goals for the federal patent system, as well as its respect for the expertise of the U.S. Court of Appeals for the Federal Circuit ("Federal Circuit"), which was created by Congress to function, inter alia, as the exclusive appellate court for patent cases, may help explain the Court's willingness to create an exception in *Markman* to the strong federal policy favoring jury trials.[5] As such, the application of Seventh Amendment jurisprudence found in *Markman* will likely have little significance outside the area of patent law. Post-*Markman* decisions of the Court appear to support this thesis.[6]

Part I of this Article describes the background of the Seventh Amendment, including the emergence of the historical test for the right to a jury trial. This historical background sets the stage for the discussion in Part II of the four strands of twentieth-century Seventh Amendment jurisprudence. Part III then outlines the *Markman* decision and compares it with the four strands of Seventh Amendment jurisprudence. Part IV concludes that *Markman* should have little impact upon the Seventh Amendment right to a jury trial outside the area of patent law. Part V discusses the continuing evolution of Seventh Amendment jurisprudence in three post-*Markman* decisions: *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*,[7] *Feltner v. Columbia Pictures Television, Inc.*,[8] and *City of Monterey v. Del Monte Dunes*.[9]

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4 *See id.* at 372. In this Article, for the sake of simplicity, I use the terms "judge" and "court" to mean determiner of law, rather than trier of fact, in a non-jury trial. Such usage is helpful because this Article addresses the proper allocation of an issue between judge and jury, and not between judge as trier of fact and judge as determiner of law.

5 *See infra* Part IV.

6 *See infra* Part V.

7 520 U.S. 17 (1997).

8 523 U.S. 340 (1998).

9 119 S. Ct. 1624 (1999).

I. Constitutional Requirements

Both the Seventh Amendment to the U.S. Constitution and forty-eight state constitutions provide for the right to a civil jury trial.[10] Although the Seventh Amendment has never been applied to the states through the Due Process Clause of the Fourteenth Amendment, in any case based on state law but brought in federal court either because of diversity of citizenship, or as a state claim pendent to a federal claim, the civil jury trial right is determined by the Seventh Amendment.[11]

A. Background of the Seventh Amendment

One objection raised during the Philadelphia Convention regarding the U.S. Constitution as originally drafted was that it did not provide a right to a civil jury trial.[12] That criticism may ultimately have led to the adoption of the entire Bill of Rights.[13] To rally opposition to the Constitution, antifederalists used an *exclusio unius* argument, asserting that the absence of any civil jury trial right in the proposed Constitution meant that the right had been abolished.[14] Federalists responded that the only reason the Constitution did not

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10 The Seventh Amendment provides that "[i]n Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise re-examined in any Court of the United States, than according to the rules of common law." U.S. CONST. amend. VII.

In the two states where the civil jury right is not constitutionally based, it is nonetheless provided either by statute or court rule. The Louisiana Code of Civil Procedure provides a right to a civil jury trial, with certain exceptions such as in suits against a state agency or certain suits to enforce an unconditional obligation for a specific sum of money. *See* LA. CODE CIV. PROC. ANN. arts. 1731, 1732 (West 1990). In Colorado, the right to a civil jury trial is regulated by Rule 38 of the Colorado Rules of Civil Procedure, which is promulgated by the Supreme Court of Colorado pursuant to its state constitutional rulemaking power. *See* COLO. R. CIV. P. 38; Setchell v. Dellacroce, 454 P.2d 804, 806 (Colo. 1969) (en banc).

11 *See* U.S. CONST. amend. XIV, § 1; Curtis v. Loether, 415 U.S. 189, 192 n.6 (1973) (stating that "[t]he Court has not held that the right to jury trial in civil cases is an element of due process applicable to state courts through the Fourteenth Amendment"); Simler v. Conner, 372 U.S. 221, 222 (1962) (holding that "the right to a jury trial in the federal courts is to be determined as a matter of federal law in diversity as well as other actions"); Byrd v. Blue Ridge Elec. Coop., Inc., 356 U.S. 525, 537-40 (1958) (holding that federal policy favoring jury decisions of disputed fact questions should not yield to contrary state rule). For the most part, the traditional common law analysis of whether a particular case is entitled to a jury trial is similar under state or federal law. *See* Bruce D. Greenberg & Gary K. Wolinetz, *The Right to a Civil Jury Trial in New Jersey*, 47 RUTGERS L. REV. 1461, 1501 n.224 (1995).

12 *See* Charles W. Wolfram, *The Constitutional History of the Seventh Amendment*, 57 MINN. L. REV. 639, 657 (1973).

13 Wolfram asserts that "the entire issue of the absence of a bill of rights was precipitated at the Philadelphia Convention by an objection that the document under consideration lacked a specific guarantee of jury trial in civil cases." *Id.* at 657; *see also* Parklane Hosiery Co. v. Shore, 439 U.S. 322, 339-43 (1979) (Rehnquist, J., dissenting) (providing a brief historical background of the Seventh Amendment).

14 *See* Wolfram, *supra* note 12, at 672 n.89; *see also* Colgrove v. Battin, 413 U.S. 149, 152 (1973). The Constitution does provide for the right to a jury trial in a criminal case. *See* U.S. CONST. art. III, § 2, cl. 3.

refer to the right was that the different states had such varied practices with respect to the jury it was impossible to draft language to cover all situations.[15]

The antifederalists who used the absence of a Bill of Rights, including lack of a civil jury trial right, as a basis for opposing the adoption of the Constitution advanced a number of arguments in favor of a civil jury trial right. Antifederalists were deeply concerned about protecting debtor defendants. They believed that new federal court judges would favor creditors, who were more likely to be members of the judges' own class, as opposed to debtors, who were more likely to be members of the lower classes.[16] Antifederalist Judge Samuel Bryan argued that civil juries are crucial because judges are likely to have

> "a bias towards those of their own rank and dignity; for it is not to be expected, that the *few* should be attentive to the rights of the *many*. This [the civil jury trial] therefore preserves in the hands of the people, that share which they ought to have in the administration of justice, and prevents the encroachments of the more powerful and wealthy citizens."[17]

Other arguments advanced by antifederalists in favor of civil jury trials included the need to guard against unwise legislation, presumably by jury nullification, the need to overturn the practices of courts of vice-admiralty, by which the British had imposed non-jury proceedings on the colonists, the protection of the interests of private citizens against the government, and the protection of individuals against "overbearing and oppressive judges."[18]

These arguments had widespread popular appeal and ultimately carried the day. The actual language of the Seventh Amendment, however, is remarkably unspecific, no doubt the result of a political process that would tolerate only broad language in order to obtain approval.[19]

The Founders left the delineation of the scope and content of the Seventh Amendment right to future court decisions.[20] In the intervening two hundred years, judicial decisions have provided increasingly specific interpretations of the right. The courts have not always, however, provided a clear and consistent method of determining the parameters of the Seventh Amendment guarantee. Nonetheless, certain approaches to interpreting the Seventh Amendment guarantee have been developed and repeated over time to form the four distinct strands of jurisprudence discussed below.

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15 *See* Wolfram, *supra* note 12, at 665; *see also* GEORGE ANASTAPLO, THE AMENDMENTS TO THE CONSTITUTION, A COMMENTARY 13-14 (1995).

16 *See* Wolfram, *supra* note 12, at 673.

17 *Id.* at 695-96 (quoting *Letters of Centinel, No. II,* FREEMAN'S J., Oct. 24, 1787, *reprinted in* PENNSYLVANIA AND THE FEDERAL CONSTITUTION, 1787-1788, at 584 (John Bach McMaster & Frederick D. Stone eds., Lancaster, Historical Soc'y of Pa. 1888)).

18 *Id.* at 670-71.

19 Another reason why the Seventh Amendment was drafted in general terms was the significant diversity of practice among the various states. *See* Edith Guild Henderson, *The Background of the Seventh Amendment*, 80 HARV. L. REV. 289, 336 (1966).

20 *See* Wolfram, *supra* note 12, at 730 ("The skeletal nature of the record [of the Seventh Amendment's adoption] hardly affords reassurance in its interpretation.").

B. *Emergence of the Historical Test*

Throughout the last two hundred years, courts have struggled with the simple language given us by the Founders: "In Suits at common law . . . the right of trial by jury shall be preserved."[21] Courts have had to flesh out the meaning of the language of the Seventh Amendment in order to determine its applicability. Did "[s]uits at common law" mean the common law of the United States, the common law of England, or both? Did the phrase mean suits brought at law rather than in equity or admiralty? Did the reference to the common law mean the common law at one point in time, or the common law as it develops over time? In other words, is the right to a jury trial a static concept or is it a dynamic, changing concept? In the declaration that "the right of trial by jury shall be preserved," was the right to be preserved one of form as well as content? One of procedure as well as substance? Answers found in Seventh Amendment jurisprudence have not always been consistent, sometimes contributing to a sense that the Seventh Amendment, and the "historical test" of its applicability, tend to change color and form with each new generation. Thus, the task of trying to distill the essence of the Seventh Amendment is a daunting one. An examination of interpretations of the amendment over two centuries, however, demonstrates that some patterns have emerged and some constants have taken shape.

Because the first clause of the Seventh Amendment provides that the right to jury trial shall be preserved "in suits at common law," courts have had to decide what was meant by "the common law." In *Parsons v. Bedford*,[22] Justice Story determined that the term "suits at common law" in the Seventh Amendment was meant to include all suits which were not in equity or admiralty.[23] Until the early part of the twentieth century, this simple test sufficed to determine when there would be a jury trial right. Nineteenth-century judges had no apparent difficulties in distinguishing actions at law from actions in equity or admiralty.

It was not until the twentieth century that courts developed a more elaborate test of what must be "preserved" under the Seventh Amendment. The "historical test," frequently relied upon by courts in the second half of the

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21 U.S. CONST. amend. VII.

22 28 U.S. (3 Pet.) 433 (1830).

23 Justice Story wrote:

> The phrase "common law," found in this clause [the Right to Jury Trial Clause], is used in contradistinction to equity, and admiralty, and maritime jurisprudence. . . . When, therefore, we find that the amendment requires that the right of trial by jury shall be preserved in suits at common law, the natural conclusion is, that this distinction [between law and equity] was present to the minds of the framers of the amendment. By *common law*, they meant what the constitution denominated in the third article "law;" not merely suits, which the *common* law recognized among its old and settled proceedings, but suits in which *legal* rights were to be ascertained and determined, in contradistinction to those where equitable rights alone were recognized, and equitable remedies were administered . . . . In a just sense, the amendment then may well be construed to embrace all suits which are not of equity and admiralty jurisdiction, whatever may be the peculiar form which they may assume to settle legal rights.

Id. at 446-47.

twentieth century, was first set forth in 1935, in *Baltimore & Carolina Line, Inc. v. Redman*.[24] In that case, the Court declared that "[t]he right of trial by jury thus preserved is the right which existed under the English common law when the Amendment was adopted."[25] There are two parts to the Court's test in *Redman*: (1) the right to jury trial is that right which was provided under English common law, and (2) the date for measuring that right is 1791, the year the Seventh Amendment was adopted.[26] Although these two elements were only first set forth together in 1935, Charles Wolfram describes the historical test as having a much earlier origin:

> For at least the past century and a half, judicial and academic writings on the right to jury trial afforded by the seventh amendment have uniformly agreed on one central proposition: *in determining whether the seventh amendment requires that a jury be called to decide the case the court must be guided by the practice of English courts in 1791.* If a jury would have been impaneled in this kind of case in 1791 English practice, then generally a jury is required by the seventh amendment.[27]

The historical test has certainly been described in this manner, but its establishment did not occur until the twentieth century. The test's development also followed a much less clear and certain path than one might think from reading the above passage. Part of the confusion about the historical test stems from the existence of two separate and distinct clauses in the Seventh Amendment. The first clause, known as the Right to Jury Trial Clause, has a different jurisprudential history and interpretation than the second clause, commonly known as the Re-Examination Clause.[28] The Supreme Court has, on a number of occasions, asserted that the two clauses are distinct and independent, yet the interpretive history of one clause has sometimes been indiscriminately applied to the other.[29] A number of twentieth-

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24 295 U.S. 654 (1935); *see also* Dimick v. Schiedt, 293 U.S. 474, 482 (1935). Decided a few months before *Redman*, *Dimick* referred to practices in England "at the time of the adoption of the Constitution," and also stated that to ascertain the meaning of the Seventh Amendment, "resort must be had to the appropriate rules of the common law established at the time of the adoption of that constitutional provision in 1791." *Dimick*, 293 U.S. at 476, 482. The decision in *Redman*, handed down five months later, provided a clearer statement of the basic formula for the "historical test" which was carried forward, with some modifications, for the rest of the century. *See, e.g.*, Feltner v. Columbia Pictures Television, Inc., 523 U.S. 340, 348 (1998); Wooddell v. International Bhd. of Elec. Workers, Local 71, 502 U.S. 93, 97 (1991); Chauffeurs, Teamsters & Helpers Local No. 391 v. Terry, 494 U.S. 558, 564 (1990); Tull v. United States, 481 U.S. 412, 417-18 (1986). The term "historical test" probably first appeared in 1918. *See* Austin Wakeman Scott, *Trial by Jury and the Reform of Civil Procedure*, 31 HARV. L. REV. 669, 671 (1918).

25 *Redman*, 295 U.S. at 657.

26 *See id.*

27 Wolfram, *supra* note 12, at 639-40 (emphasis added).

28 The Right to Jury Trial Clause guarantees that "[i]n Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved." U.S. CONST. amend. VII. The Re-Examination Clause provides that "no fact tried by a jury, shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law." *Id.*

29 In *Parsons v. Bedford*, Justice Story, after first discussing the Right to Jury Trial Clause, referred to the Re-Examination Clause as follows: "But the other clause of the amendment is

century decisions, discussing the right to a jury trial, have claimed that the right was based solely on English law, citing Justice Story's 1812 decision in *United States v. Wonson*.[30] In *Wonson*, however, Justice Story dealt only with the Re-Examination Clause, and not with the Right to Jury Trial Clause.[31] Nineteenth-century cases discussing the jury trial right and other constitutional issues, on the other hand, either rejected the common law of England as controlling,[32] did not refer to the common law of England at all,[33] or referred to the common law and practice in both countries.[34] The source of the claim that English common law alone determines the scope of the jury trial

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still more important; and we read it as a substantial and independent clause." Parsons v. Bedford, 28 U.S. (3 Pet.) 433, 447 (1830). In *Colgrove v. Battin*, the Court noted that with respect to the Re-Examination Clause,

> [t]he reference to "common law" contained in the second clause of the Seventh Amendment is irrelevant to our present inquiry because it deals exclusively with the prohibition contained in that clause against the indirect impairment of the right of trial by jury through judicial re-examination of factfindings of a jury other than as permitted in 1791.

Colgrove v. Battin, 413 U.S. 149, 152 n.6 (1973). More recently, in *Gasperini v. Center for Humanities, Inc.*, 518 U.S. 415 (1996), the Court, in holding that a New York law controlling compensation awards for excessiveness can be given effect in federal court without offending the Seventh Amendment, noted the separate functions of the two different clauses:

> The Seventh Amendment . . . bears not only on the allocation of trial functions between judge and jury, the issue in *Byrd*; it also controls the allocation of authority to review verdicts, the issue of concern here . . . . *Byrd* involved the first Clause of the Amendment, the "trial by jury" Clause. This case involves the second, the "re-examination" Clause.

Id. at 432. See *Ex parte Peterson*, 253 U.S. 300, 309 (1920), for an example of indiscriminate reference to the two clauses.

30 28 F. Cas. 745, 748 (C.C.D. Mass. 1812) (No. 16,750). Justice Brandeis, for example, in *Peterson*, incorrectly cites *Wonson*, a Re-Examination Clause case, for the proposition that "[t]he right to a jury trial guaranteed in the federal courts is that known to the law of England, not the jury trial as modified by local usage or statute." *Peterson*, 253 U.S. at 309 n.1. The second case Justice Brandeis cited, *Capital Traction Co. v. Hof*, 174 U.S. 1 (1899), deals with both the Right to Jury Trial Clause and the Re-Examination Clause, but does not support Justice Brandeis's statement because it cites both English and American law as authority. *See id.* at 8-22.

31 In *Wonson*, Justice Story, as a circuit justice, had to decide whether an appeal from a judgment on jury verdict below raised only questions of law, or whether the facts were to be submitted to a second jury in the circuit court. *See Wonson*, 28 F. Cas. at 745. Justice Story's dilemma arose from a Massachusetts practice to have a second jury at the appellate level. *See id.* at 748. The United States, as appellant, argued that although the case was in federal court, the government was entitled to another jury trial at the circuit level, because this was the practice in the state courts of Massachusetts. *See id.* It was in this context that Justice Story ruled that the common law referred to in the Re-Examination Clause was the common law of England, rather than the common law of any individual state. *See id.* He noted that the common law probably differed in each individual state, but all based their common law on the law of England. *See id.* Justice Story also noted, however, that the practice of having a second jury on appeal, in Massachusetts and other New England states, is "a privilege existing by statute, and not by common law," and that it appeared to be "a peculiarity in New England." *Id.*

32 *See* Waring v. Clarke, 46 U.S. (5 How.) 441, 458-61 (1847); discussion *infra* notes 47-55 and accompanying text.

33 *See Parsons*, 28 U.S. (3 Pet.) at 441-58.

34 *See Capital Traction*, 174 U.S. at 8, 13, 15, 23 (referring to the common law of England for Re-Examination Clause purposes, but to the common law of both England and the United States for Right to Jury Trial Clause purposes).

right appears to be a 1918 article by Austin Wakeman Scott.[35] In his article, Professor Scott declared that "[i]n determining what is meant by trial by jury under the Seventh Amendment, inasmuch as the practice was different in the different colonies, the federal courts look to the common law of England rather than to the law of any particular colony."[36] Yet the three federal cases cited by Scott as authority for this proposition, *Thompson v. Utah*,[37] *Capital Traction Co. v. Hof*,[38] and *Maxwell v. Dow*,[39] provide no such support. Both *Thompson* and *Maxwell* were criminal cases and do not provide authority for interpreting the civil jury trial right under the Seventh Amendment.[40] Although *Capital Traction* was a civil case, the Court looked not only to the common law of England, but to that of the United States as well.[41]

Two years *after* Professor Scott's article appeared, however, Justice Brandeis, in *Ex parte Peterson*, wrote the first Supreme Court decision asserting the civil jury trial right was that "known to the law of England."[42] Nonetheless, in support of the decision in *Ex parte Peterson*, Justice Brandeis cited practices in both England and the American colonies.[43]

The use of 1791, the time of ratification of the Seventh Amendment, as part of the historical test, was also a twentieth-century development. In the 1898 Supreme Court decision of *Thompson v. Utah*, the Court first referred

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35 *See* Scott, *supra* note 24, at 671.

36 *Id.* (citations omitted).

37 170 U.S. 343 (1898), *overruled on unrelated grounds by* Collins v. Youngblood, 497 U.S. 37, 51-52 (1990).

38 174 U.S. 1 (1899).

39 176 U.S. 581 (1900).

40 *See Maxwell*, 176 U.S. at 582; *Thompson*, 170 U.S. at 344. "Only civil cases can serve as direct evidence of the contemporary understanding of the seventh amendment." Henderson, *supra* note 19, at 320. Henderson discusses criminal cases, however, to show how observations about criminal cases sometimes were erroneously applied to civil cases. *See id.* at 320-35.

41 Although the Court in *Capital Traction* states at one point that the common law means the common law of England, the reference is clearly to the Re-Examination Clause of the Seventh Amendment, and not to the Right to Jury Trial Clause. *See Capital Traction*, 174 U.S. at 22-23. When the Court discusses the right to trial by jury, and "what conditions may be imposed upon the demand of such a trial, consistently with preserving the right to it," the Court concludes that "the judicial decisions and the settled practice in the several States are entitled to great weight, inasmuch as the constitutions of all of them had secured the right of trial by jury in civil actions." *Id.* at 23.

42 *Ex parte* Peterson, 253 U.S. 300, 309 n.1 (1920). Interestingly, Justice Brandeis cites Professor Scott's article in *Peterson*, but for a different point: that new devices may be used to adapt the jury trial to present needs. *See id.* at 309-10 (citing Scott, *supra* note 24, at 669). In support of his conclusion that the jury trial right is determined by the common law of England, Brandeis cites *Wonson*, which only concerned the Re-Examination Clause of the Seventh Amendment, and *Capital Traction*, which relied on both English and American common law. *See* United States v. Wonson, 28 F. Cas. 745, 748 (C.C.D. Mass. 1812) (No. 16,750); *Capital Traction*, 174 U.S. at 23. Brandeis cited no other cases dealing with this point. *See Peterson*, 253 U.S. at 309 n.1.

43 The issue in *Peterson* was whether the appointment of an auditor, whose role was to simplify the issues before the jury, impermissibly interfered with the right to a jury trial. *See Peterson*, 253 U.S. at 304-05. Because Justice Brandeis, in his decision, considered practices in both the American colonies and in England, it is not apparent why he limited the applicable antecedent of the jury trial right to English law. *See id.* at 309-10. Brandeis may have been influenced by Professor Scott's article. *See supra* note 42 and accompanying text.

to a specific date as the appropriate reference point for determining whether a right to a jury trial existed under the Sixth Amendment; but the Court used the date of the Constitution's adoption in 1789 instead of the date of adoption of the amendments.[44] It was not until 1935, and the *Dimick* and *Redman* decisions, that the Supreme Court first declared that the reference point for determining the right to a civil jury trial was 1791, the date of the Seventh Amendment's ratification.[45]

Thus, the historical test of the civil jury trial right, initially set forth in the *Redman* case, appears to be of more recent vintage than has been suggested by some commentators and court decisions.[46] Before the 1930s, courts did not need a specific time reference, or a reference only to English law to understand what constituted a right to a jury trial. For over a century, courts had a reasonably clear idea of the substance and scope of the jury trial right by looking at the distinctions between cases tried at law and cases tried in equity or admiralty. Thus, courts did not need to search for precise historical analogues within English common law in 1791.

In fact, one nineteenth-century Supreme Court decision flatly rejected a proposal to use the law of England at the time of the Constitution's adoption for the purpose of determining the meaning of the admiralty jurisdiction clause in the Constitution. In *Waring v. Clarke*,[47] the issue concerned two steamboats which collided on the Mississippi River.[48] The appellants argued that the case was not within the admiralty jurisdiction of the courts of the United States, and asserted that the grant in the Constitution of "'all cases of admiralty and maritime jurisdiction' was limited to what were cases of admiralty and maritime jurisdiction in England when our Revolutionary war began, or when the constitution was adopted."[49]

The Supreme Court rejected this view, holding unequivocally that "the grant of admiralty power to the courts of the United States was not intended to be limited or to be interpreted by what were cases of admiralty jurisdiction in England when the constitution was adopted."[50] The Court also noted that "[n]o such interpretation has been permitted in respect to any other power in the constitution."[51] Suggesting how ridiculous it would be for the constitutional power to be limited by English law, the Court gave as examples of this absurdity the idea that the judicial power which extended "'to all cases af-

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44 *See Thompson*, 170 U.S. at 350.

45 *See* Baltimore & Carolina Line, Inc. v. Redman, 295 U.S. 654, 657 (1935); Dimick v. Schiedt, 293 U.S. 474, 476 (1935).

46 For example, Justice Souter asserted in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), that "[s]ince Justice Story's day, *United States v. Wonson*, we have understood that '[t]he right of trial by jury thus preserved is the right which existed under the English common law when the Amendment was adopted.'" *Id.* at 376 (citations omitted). As noted earlier, Justice Story did not deal at all with the right to a jury trial in the *Wonson* decision, and the historical test described by Justice Souter was not fully formulated until 1935. *See supra* notes 30-45 and accompanying text.

47 46 U.S. (5 How.) 441 (1847).

48 *See id.* at 442-43.

49 *Id.* at 451-52 (quoting U.S. CONST. art. III, § 2, cl. 1).

50 *Id.* at 459.

51 *Id.* at 458.

fecting ambassadors, other ministers, and consuls'" could be limited by English law, or that the grant to Congress "'to establish uniform laws on the subject of bankruptcies throughout the United States'" could be limited by the "bankrupt[cy] system of England as it existed there when the constitution was adopted."[52] The Court stated quite forcefully: "Such a limitation upon that clause we deny. We think we may very safely say, such interpretations of any grant in the constitution, or limitations upon those grants, according to any English legislation or judicial rule, cannot be permitted."[53]

Waring v. Clarke is perhaps helpful in understanding why nineteenth-century Supreme Court decisions did not refer to the law of England as the sole source for determining the constitutional right to a jury trial.[54] That was to change, however, in the twentieth century.[55]

II. Modern Interpretations of the Jury Trial Right

During the twentieth century, four strands of Seventh Amendment jurisprudence emerged. Part II.A traces the recent refinements to the historical test, the first strand of Seventh Amendment jurisprudence. The historical test determines whether there exists a right to a jury trial in a particular type of action. Once a right to a jury trial is found to exist in an action, the parameters of the right within the cause of action must be determined. Part II.B focuses on the second strand of jurisprudence, the substance of the jury trial right. This part also considers the tension between the need to "preserve"

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52 *Id.* (quoting U.S. CONST. art. I, § 8, cl. 4; *id.* art. III, § 2, cl. 1).

53 *Id.* at 458-59.

54 There is, of course, some limited reference to the law of England as the common law referred to in the Re-Examination Clause, specifically in the *Wonson* decision, as well as in *Capital Traction*, decided at the end of the century. *See* Capital Traction Co. v. Hof, 174 U.S. 1, 8-22 (1899); United States v. Wonson, 28 F. Cas. 745, 748 (C.C.D. Mass. 1812) (No. 16,750); notes 30-31 and accompanying text. *Wonson* was a case decided not by the Supreme Court but by Mr. Justice Story in the federal circuit court. *See Wonson*, 28 F. Cas. at 745. Professor Wolfram believes that there is little basis to assume that the use of the term "common law" in the 1789-91 period necessarily referred to England. He notes that even Mr. Justice Story in his *Wonson* opinion did not deny that the language of the amendment could just as well have been read to refer to the common law in the states as to the common law of England. *See* Wolfram, *supra* note 12, at 734. Interestingly, in *Parsons v. Bedford*, 28 U.S. (3 Pet.) 433 (1830), a number of years later, Mr. Justice Story, writing then for the Supreme Court, did not at any point suggest that the common law of England, as opposed to the common law of the American colonies, should be the reference point for constitutional interpretation of either clause of the Seventh Amendment. *See id.* at 446-49.

55 Whether English or American law controls can make a difference. In *In re Lockwood*, 50 F.3d 966 (Fed. Cir.), *vacated sub nom. American Airlines, Inc. v. Lockwood*, 515 U.S. 1182 (1995), Judge Nies, in dissent, argued that issues of patent validity, including underlying facts, should be determined by the judge rather than the jury. *See id.* at 981 (Nies, C.J., dissenting). In support of her position, Judge Nies noted that a suit to repeal a patent is similar to a writ of *scire facias*. *See id.* at 984 (Nies, C.J., dissenting). "Although writs of *scire facias* issued out of law courts in early American courts, English courts issued such writs in courts of equity. The historical test requires courts to look to English practice in 1791, not American practice." *Id.* at 985 n.7 (Nies, C.J., dissenting) (citations omitted). If one assumes Judge Nies was correct in her description of English and American practices, and in her comparison of a suit to repeal a patent with a writ *of scire facias*, then following English practice in this case would lead to a bench trial, while following American practice would lead to jury trial.

the jury trial right and the need to adapt it to more modern times. Part II.C discusses the development of the third strand of jurisprudence, which concerns the effect of the merger of the courts of law and equity on the jury trial right. Finally, Part II.D considers the fourth strand—the exclusion of the Seventh Amendment jury trial right from matters involving public rights which Congress has assigned to non-Article III courts and administrative adjudication.

A. Refinements to the Historical Test

Since the historical test was first announced in the *Redman* decision in 1935, cases have expanded and refined the test. In *Curtis v. Loether*,[56] a fair housing case in which the respondents sought a jury trial under the Civil Rights Act of 1968, the Supreme Court declared that the Seventh Amendment applies not only to suits based on the common law, but also to statutory causes of action.[57] Citing Justice Story's view in *Parsons v. Bedford* that the Seventh Amendment embraces "'all suits which are not of equity and admiralty jurisdiction,'" the Court emphasized that "the Seventh Amendment . . . appl[ies] to actions enforcing statutory rights, and requires a jury trial upon demand, if the statute creates legal rights and remedies, enforceable in an action for damages in the ordinary courts of law."[58]

Because a statutory action would have a jury trial right if an analogous claim would have been tried in the law courts in 1791, courts soon began to search for historical analogues to modern statutory causes of action. A few months after the *Curtis* decision, in *Pernell v. Southall Realty*,[59] an action to recover possession of real property in the District of Columbia, the Court undertook a review of the history of ejectment actions back to the twelfth century to determine whether these actions were typically heard by juries.[60] The U.S. Court of Appeals for the District of Columbia Circuit had held that the Seventh Amendment did not guarantee the right to a jury trial in the case at bar—a statutory eviction action—because it found no equivalent at common law.[61] The Supreme Court determined, however, that although the statute did not resemble the common law action of ejectment in detail, it served the same essential function by permitting a plaintiff to evict a person wrongfully in possession of property.[62] Because the right to recover possession of real property was a right protected at common law, the Court held that the Seventh Amendment preserved the right to a jury trial in the statutory eviction action.[63] Citing *Curtis v. Loether*, the Court noted that the jury trial right extended beyond the common law forms of action recognized in 1791.[64]

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56 415 U.S. 189 (1974).

57 *See id.* at 193-94.

58 *Id.* (quoting *Parsons*, 28 U.S. (3 Pet.) at 447).

59 416 U.S. 363 (1974).

60 *See id.* at 371-74.

61 *See id.* at 374.

62 *See id.* at 375-76.

63 *See id.* at 376.

64 *See id.* at 374 (citing Curtis v. Loether, 415 U.S. 189, 193 (1974)).

Further, the Court emphasized the lack of importance of finding a close historical analogue:

> Whether or not a close equivalent to [the statutory action] existed in England in 1791 is irrelevant for Seventh Amendment purposes, for that Amendment requires trial by jury in actions unheard of at common law, provided that the action involves rights and remedies of the sort traditionally enforced in an action at law, rather than in an action in equity or admiralty.[65]

In 1987, the Supreme Court, in *Tull v. United States*,[66] again emphasized that finding an exact historical analogue is not required. The Court's task in *Tull* was to decide if the Seventh Amendment guaranteed the right to a jury trial to determine liability in an action brought by the government seeking civil penalties and injunctive relief under the Clean Water Act.[67] The basic test set forth by the Court was one "[t]o determine whether a statutory action is more similar to cases that were tried in courts of law than to suits tried in courts of equity or admiralty."[68] To accomplish this task, the Court determined that it must examine both the nature of the action and the remedy sought.[69]

The government opposed the jury trial right in *Tull*, arguing that the nature of an action to obtain penalties under the Clean Water Act more closely resembled an action to abate a public nuisance than an action in debt.[70] The former action had no jury trial right in eighteenth-century English common law, while the latter action required a jury trial.[71] The Court said it did not need to decide whether the better analogy to the case at bar was a public nuisance or an action in debt.[72] It found both to be appropriate analogies, but cited with approval the statement in *Pernell* that the question of "close equivalents" to eighteenth-century actions "'is irrelevant for Seventh Amendment purposes.'"[73] The Court then stated that it need not rest its conclusion on an "'abstruse historical'" search for the nearest eighteenth-century analogue.[74] The Court emphasized that of the historical test's two prongs, the remedy prong is far more important than the nature of the action prong.[75]

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65 *Id.* at 375.

66 481 U.S. 412 (1987).

67 *See id.* at 414.

68 *Id.* at 417.

69 *See id.* "First, we compare the statutory action to 18th-century actions brought in the courts of England prior to the merger of the courts of law and equity. Second we examine the remedy sought and determine whether it is legal or equitable in nature." *Id.* at 417-18 (citations omitted).

70 *See id.* at 420.

71 *See id.*

72 *See id.*

73 *Id.* (quoting Pernell v. Southall Realty, 416 U.S. 363, 375 (1974)).

74 *Id.* at 421 (quoting Ross v. Bernhard, 396 U.S. 531, 538 n.10 (1970)).

75 *See id.* "We reiterate our previously expressed view that characterizing the relief sought is '[m]ore important' than finding a precisely analogous common-law cause of action in determining whether the Seventh Amendment guarantees a jury trial." *Id.* (quoting Curtis v. Loether, 415 U.S. 189, 196 (1974) (alteration in original)).

Focusing on the relief sought, which was the enforcement of a civil penalty, the Court found that this type of remedy at common law was enforced in courts of law, and not in courts of equity.[76] Thus, there was a right to trial by jury on the issue of liability.[77]

From *Curtis v. Loether* through the *Pernell* and *Tull* decisions, there appeared to be a consensus among the Justices that the search for a close historical analogue should be de-emphasized in determining whether there was a right to a jury trial in a particular case.[78] The Justices' focus, rather, was on whether the kind of action brought would have been brought in a court of law, with the most important factor being the nature of relief sought.[79]

It was somewhat surprising, then, to see this consensus fall apart in 1990, in *Chauffeurs, Teamsters and Helpers, Local No. 391 v. Terry*.[80] The question in *Chauffeurs* was whether employees seeking back pay for a union's alleged breach of its duty of fair representation had a right to a civil jury trial.[81] The case involved two substantive issues: whether the employer's action violated the terms of the collective bargaining agreements, and whether the union breached its duty of fair representation.[82] The split among the Justices nonetheless produced a majority for each part of the decision except Part III-A, which discussed the use of historical analogues.[83] A majority of Justices supported the two-prong test of *Tull*, ruling that there is a need to examine both the nature of the issue and the remedy sought, and that the remedy sought is the more important of the two prongs.[84] Only three Justices, however,

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76 *See id.* at 422.

77 *See id.* at 425. "A civil penalty was a type of remedy at common law that could only be enforced in courts of law." *Id.* at 421. In *Tull*, however, the assessment of the amount of the penalty was ultimately found to be matter for a judge. *See id.* at 427. In a more recent Supreme Court decision, *Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340 (1998), the Court distinguished *Tull*, finding that the jury rather that the judge must determine statutory damages under section 504(c) of the Copyright Act, 17 U.S.C. § 504(c) (1994 & Supp. IV 1999). *See Feltner*, 523 U.S. at 355; *infra* Part V.B.

78 In *Curtis*, the decision was unanimous. *See Curtis*, 415 U.S. at 189. In *Pernell*, two Justices concurred in the result, but did not file separate opinions. *See Pernell*, 416 U.S. at 385. In *Tull*, Justice Scalia, with Justice Stevens, concurred in part, but dissented with respect to the determination of relief. *Tull*, 481 U.S. at 427-28 (Scalia & Stevens, JJ., concurring and dissenting). He believed the amount of the civil penalty should also be determined by a jury. *See id.* (Scalia & Stevens, JJ., concurring and dissenting).

79 *See Tull*, 481 U.S. at 421; *Pernell*, 416 U.S. at 382. "[W]here the action involves rights and remedies recognized at common law, it must preserve to parties their right to a jury trial." *Pernell*, 416 U.S. at 382 (citing *Curtis*, 415 U.S. at 195).

80 494 U.S. 558 (1990). Justice Marshall delivered the opinion of the Court with respect to Parts I, II, III-B and IV, in which Chief Justice Rehnquist, and Justices Brennan, White, Blackmun, and Stevens joined, *see id.* at 561-65, 570-74, and an opinion with respect to Part III-A, in which Chief Justice Rehnquist and Justices White and Blackmun joined, *see id.* at 565-70 (plurality opinion). Justices Brennan and Stevens filed opinions concurring in part and concurring in the judgment. *See id.* at 574-81 (Brennan, J., concurring in part and concurring in judgment); *id.* at 581-84 (Stevens, J., concurring in part and concurring in judgment). Justice Kennedy filed a dissenting opinion, in which Justices O'Connor and Scalia joined. *See id.* at 584-95 (Kennedy, J., dissenting).

81 *See id.* at 561.

82 *See id.* at 562.

83 *See id.* at 565-70 (plurality opinion).

84 *See id.* at 565.

agreed with Justice Marshall's discussion in Part III-A on historical analogues.[85] This Part considered whether in the eighteenth century an analogous cause of action to the duty of fair representation had existed, and if so, whether that would determine if the nature of the suit at bar was legal or equitable.[86] The union argued that there was no right to a jury trial in a duty of fair representation case, because the action resembled either an action to set aside an arbitration award or an action by a trust beneficiary against a trustee for breach of fiduciary duty.[87] The employees, on the other hand, contended that the action was more akin to an attorney malpractice action, which was historically an action at law.[88] Justice Marshall concluded that the action encompassed both equitable and legal issues, and that the first part of the Seventh Amendment inquiry ended "in equipoise as to whether the [employees were] entitled to a jury trial."[89] In the next two parts of the opinion, which garnered majority support, Justice Marshall determined that the second part of the inquiry, which focused on remedies, tipped the balance in favor of recognizing a jury trial right.[90] He concluded that "[a]lthough the search for an adequate 18th-century analog revealed that the claim includes both legal and equitable issues, the money damages respondents seek are the type of relief traditionally awarded by courts of law. Thus, the Seventh Amendment entitles respondents to a jury trial . . . ."[91]

The concurring and dissenting opinions made clear that the consensus formed in earlier cases had dissolved over the question of the significance of finding a close historical analogue. Justices Brennan and Stevens, filing separate concurring opinions, refused to join Part III-A because in their view it overemphasized the historical approach.[92] Justice Brennan stated that using 200-year-old English forms of action to determine the right to a jury trial "needlessly convolutes our Seventh Amendment jurisprudence."[93] Justice Brennan would have decided the Seventh Amendment question solely on the basis of the relief sought in the case.[94] If the relief was of the type historically available in courts of law, Justice Brennan would have held that the parties had "a constitutional right to a trial by jury."[95] Justice Brennan's concern was that:

> [A]ll too often the first prong of the current test requires courts to measure modern statutory actions against 18th-century English actions so remote in form and concept that there is no firm basis for

85 *See id.* at 560, 565-70 (plurality opinion).

86 *See id.* at 566-70 (plurality opinion).

87 *See id.* at 566-68 (plurality opinion).

88 *See id.* at 568-69 (plurality opinion).

89 *Id.* at 570 (plurality opinion).

90 *See id.* at 570-74.

91 *Id.* at 573-74.

92 *See id.* at 574 (Brennan, J., concurring in part and concurring in judgment); *id.* at 581 (Stevens, J., concurring in part and concurring in judgment).

93 *Id.* at 575 (Brennan, J., concurring in part and concurring in judgment).

94 *See id.* at 574 (Brennan, J., concurring in part and concurring in judgment).

95 *Id.* (Brennan, J., concurring in part and concurring in judgment).

comparison. In such cases, the result is less the discovery of a historical analog than the manufacture of a historical fiction.[96]

In Justice Brennan's view, focusing on the relief sought by the parties would produce a test that would be both more manageable and more reliable from an historical perspective.[97]

Like Justice Brennan, Justice Stevens felt that the Court exaggerated the importance of finding a precise common law analogue to the duty of fair representation, concluding that "the relevant historical question is not whether a suit was 'specifically recognized at common law,' but whether 'the nature of the substantive right asserted . . . is analogous to common law rights' and whether the relief sought is 'typical of an action at law.'"[98]

While Justice Brennan contended that the first prong of the historical test should be retired, and Justice Stevens thought the Court exaggerated its importance, the dissenting Justices—O'Connor, Scalia, and Kennedy—disagreed with the majority because they believed the case should have turned on finding the closest historical analogue.[99] In their view, the equitable trust action was an appropriate analogue for the modern duty of fair representation, and this should have been sufficient to decide there was no jury trial right.[100] The dissenting Justices acknowledged the remedy prong of the historical test to be of considerable importance, but emphasized that the Court in *Curtis* had explicitly stated that it did not "'go so far as to say that any award of monetary relief might necessarily be "legal" relief.'"[101] The dissenting Justices further defended adherence to the historical test on the grounds that it was required by the Constitution, concluding that because the Seventh Amendment "'preserves' the right to jury trial in civil cases [and] [w]e cannot preserve a right . . . unless we look to history to identify it."[102]

In *Chauffeurs*, the Court was deeply divided over the importance of using historical analogues to eighteenth-century English actions in determining whether there was a right to a jury trial. Two Justices felt the search for an historical analogue should be de-emphasized or abandoned.[103] Three Justices thought that finding an historical analogue could be determinative, because "'a single historical analog [can take] into consideration the nature of the

96 *Id.* at 579 n.7 (Brennan, J., concurring in part and concurring in judgment).

97 *See id.* (Brennan, J., concurring in part and concurring in judgment). As Justice Brennan noted, "[T]he nature of relief available today corresponds more directly to the nature of relief available in Georgian England. Thus the historical test I propose, focusing on the nature of the relief sought, is not only more manageable than the current test, it is more reliably grounded in history." *Id.* (Brennan, J., concurring in part and concurring in judgment).

98 *Id.* at 583 (Stevens, J., concurring in part and concurring in judgment) (citations omitted).

99 *See id.* at 584 (O'Connor, Scalia, and Kennedy, JJ., dissenting).

100 *See id.* (O'Connor, Scalia, and Kennedy, JJ., dissenting).

101 *Id.* at 591 (O'Connor, Scalia, and Kennedy, JJ., dissenting) (quoting Curtis v. Loether, 415 U.S. 189, 196 (1974)).

102 *Id.* at 592 (O'Connor, Scalia, and Kennedy, JJ., dissenting).

103 *See id.* at 574 (Brennan, J., concurring in part and concurring in judgment); *id.* at 581 (Stevens, J., concurring in part and concurring in judgment).

cause of action and the remedy.'"[104] Finally, four Justices thought that finding an historical analogue was worthy of inquiry, but where the matter was not clearly determined by history, the remedy prong of the historical test should be determinative.[105]

Less than two years after the highly-fractured *Chauffeurs* decision, the Court, *in Wooddell v. International Brotherhood of Electrical Workers, Local 71*, decided unanimously that a union member who sued his local union for money damages under Title I of the Labor-Management Reporting and Disclosure Act of 1959[106] ("LMRDA") had the right to a jury trial.[107] Interestingly, the Court explained the decision in *Chauffeurs* as having turned on the remedy prong of the test and did not mention the historical analogue prong of the test.[108] Moreover, after giving its standard recitation of the historical test, the Court found no need to look for an historical analogue to determine if the petitioner had a right to a jury trial.[109] In a prior LMRDA case, the Court had held, for purposes of establishing the appropriate statute of limitations, that actions under the LMRDA were closely analogous to personal injury actions.[110] The Court thus concluded in *Wooddell* that because "[a] personal injury action is . . . a prototypical example of an action at law, to which the Seventh Amendment applies," the plaintiff was entitled to a jury trial.[111]

The historical analogy, then, would appear to have significance only in cases such as *Chauffeurs* where there is a serious question regarding whether the closest historical analogue of the action is in equity or in law. But even in such cases, as the Court explained in *Wooddell*, the remedy sought will be determinative.[112]

Thus, prior to the *Markman* decision in 1996, the Court appeared in its Seventh Amendment decisions to be de-emphasizing the need to search for an historical analogue, and to be placing primary emphasis on the remedy sought as a means to determine the right to a jury trial.

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104 *Id.* at 592 (O'Connor, Scalia, and Kennedy, JJ., dissenting) (quoting Tull v. United States, 481 U.S. 412, 421 n.6 (1987)).

105 *See id.* at 573-74 (plurality opinion).

106 29 U.S.C. §§ 401-531 (1994).

107 *See* Wooddell v. International Bhd. of Elec. Workers, Local 71, 502 U.S. 93, 98 (1991) (deciding case without the participation of Justice Thomas).

108 *See id.* at 97.

109 *See id.* at 97-98.

> To determine whether a particular action will resolve legal rights, and therefore give rise to a jury trial right, we examine both the nature of the issues involved and the remedy sought. "'First, we compare the statutory action to 18th-century actions brought in the courts of England prior to the merger of the courts of law and equity. Second, we examine the remedy sought and determine whether it is legal or equitable in nature.'" The second inquiry is the more important in our analysis.

Id. at 97 (citations omitted).

110 *See id.* at 98.

111 *Id.*

112 *See id.* at 97. Explaining its decision in *Chauffeurs*, the Court said: "Because we found that the damages sought were neither analogous to equitable restitutionary relief, nor incidental to or intertwined with injunctive relief, we concluded that the remedy had none of the attributes required for an exception to the general rule, and thus found the remedy sought to be legal." *Id.*

B. *Substance of the Right to a Jury Trial*

The historical test is one means of determining whether parties to a particular action have the right to a jury trial. Once that right is established, however, there remains the question of its scope.[113] Courts over the last two hundred years have struggled with defining that scope while adapting the civil jury trial right to the needs of changing times. Although the Supreme Court has repeatedly asserted the need to "preserve" the jury trial right, it has generally not felt constrained to limit what it refers to as the "incidents" of the civil jury trial to procedures or practices which would have been followed in 1791.[114] A necessary question, of course, is whether the permitted changes in these practices have such an impact on the right to a jury trial that they impinge upon the substance of the guarantee itself. To discern this, one must first attempt to understand what the substance of the right is.

Throughout the nineteenth century, the Supreme Court set forth its understanding of the substance of the Seventh Amendment guarantee. One of the most cited early declarations of the substance of the jury trial right is found in *Walker v. New Mexico & Southern Pacific Railroad Co.*,[115] a case decided just before the turn of the century. The Court in *Walker* was asked to determine whether an act of the Territory of New Mexico contravened the Seventh Amendment by providing that a court could grant judgment on a jury's special findings if the jury's general verdict was inconsistent with those special findings.[116] The Court determined that courts could render judgment in accordance with the special findings without offending the Seventh Amendment.[117] According to the Court, the Seventh Amendment

> does not attempt to regulate matters of pleading or practice .... Its aim is not to preserve mere matters of form and procedure but sub-

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113 Eighteenth-century juries, for example, were considered to have the power to decide both the law and the facts. In *Georgia v. Brailsford*, 3 U.S. (3 Dall.) 1 (1794), which involved an action to determine priority between creditors, Chief Justice John Jay charged the jury, "as on the one hand, it is presumed, that juries are the best judges of facts; it is, on the other hand, presumable, that the court [is] the best judge[ ] of law. But still both objects are lawfully, within your power of decision." *Id.* at 4; *see also* Morris S. Arnold, *A Historical Inquiry into the Right to Trial by Jury in Complex Civil Litigation*, 128 U. PA. L. REV. 829, 833 (1980) (stating that "juries in eighteenth-century America had much more power to decide questions both of law and fact than do modern ones"). Professor Scott notes that by the time of the American Revolution, English law already had established that juries decide questions of fact, while judges determine questions of law. *See* Scott, *supra* note 24, at 677. In the American colonies, however, the resentment of Crown judges and the popular enthusiasm for trials by jury tended to result in limitations on powers of American judges, and great latitude for juries. *See id.* Gradually, however, the jury's role shifted in the nineteenth century predominantly to that of fact-finder. *See* WILLIAM E. NELSON, AMERICANIZATION OF THE COMMON LAW: THE IMPACT OF LEGAL CHANGES ON MASSACHUSETTS SOCIETY, 1760-1830, at 165-74 (1975).

114 *See, e.g.*, Galloway v. United States, 319 U.S. 372, 390 (1943) ("The [Seventh] Amendment did not bind the federal courts to the exact procedural incidents or details of jury trial according to the common law in 1791, any more than it tied them to the common-law system of pleading or the specific rules of evidence then prevailing."); Colgrove v. Battin, 413 U.S. 149, 156 (1973) (citing with approval the above language from *Galloway*).

115 165 U.S. 593 (1897).

116 *See id.* at 594.

117 *See id.*

> stance of right. This requires that *questions of fact in common law actions shall be settled by a jury, and that the court shall not assume directly or indirectly to take from the jury or to itself such prerogative.*[118]

The substance that must be preserved, therefore, is the jury's role as finder of fact. Matters of pleading and practice, according to the *Walker* decision, are simply not regulated by the Seventh Amendment. Thus, a judge's grant of judgment on a jury's special findings, when the special findings are inconsistent with the general verdict, does not intrude on the civil jury trial right.[119]

Justice Brandeis cited *Walker* with approval in 1920 in *Ex parte Peterson*, where, writing for the majority, he found that appointing an auditor to make tentative findings of fact does not deprive a party of the right to a jury trial.[120] Justice Brandeis expounded on the necessity of adapting the jury trial right in light of change:

> [The Seventh Amendment] does not prohibit the introduction of new methods for determining what facts are actually in issue, nor does it prohibit the introduction of new rules of evidence. . . . New devices may be used to adapt the ancient institution to present needs and to make of it an efficient instrument in the administration of justice. Indeed, such changes are essential to the preservation of the right. The limitation imposed by the Amendment is merely that enjoyment of the right of trial by jury be not obstructed, and *that the ultimate determination of issues of fact by the jury not be interfered with.*[121]

Consistent with the *Walker* decision, Justice Brandeis viewed changes in jury procedures as necessary and non-violative of Seventh Amendment rights, and concluded that the core of the Amendment's guarantee is the preservation of the jury's fact-finding function.[122]

Later, in *Gasoline Products Co. v. Champlin Refining Co.*,[123] the Court found that the Seventh Amendment did not require following eighteenth-century common law practices with respect to the grant of a partial new trial.[124] Although acknowledging that in similar circumstances Lord Mansfield would have set aside the entire verdict if error was found as to one part, the Court nonetheless held that no new trial was required on the petitioner's claim, although the counterclaim would have to be retried.[125] Justifying a different result from common law practice, the Court explained:

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118 *Id.* at 596 (emphasis added).

119 *See id.* at 598.

120 *Ex parte* Peterson, 253 U.S. 300, 309-12 (1920).

121 *Id.* at 309-10 (emphasis added) (citations omitted).

122 *See id.* at 310 n.1 (citing Scott, *supra* note 24, at 669).

123 283 U.S. 494 (1931).

124 *See id.* at 497-98.

125 *See id.* at 498-500. Although the appellate court had directed a new trial only on the issue of damages on the counterclaim, the Supreme Court held that this question was so interwoven with that of liability that both the counterclaim and damages determination would have to be submitted to the jury in a new trial. The verdict in favor of the petitioner on the claim in chief, however, did not have to be retried. *See id.* at 496, 498-501.

> [W]e are not now concerned with the form of the ancient rule. It is the Constitution which we are to interpret; and the Constitution is concerned, not with form, but with substance. All of vital significance in trial by jury is that issues of fact be submitted for determination with such instructions and guidance by the court as will afford opportunity for that consideration by the jury which was secured by the rules governing trials at common law.[126]

Similarly, the Court in *Galloway v. United States*,[127] in ruling that the directed verdict does not offend the Seventh Amendment, emphasized that 1791 practices are not controlling as long as the fundamental elements of the jury trial right are preserved.[128] The Court traced the directed verdict's historical evolution from the common law nonsuit, noting the importance of flexibility and change in jury trial practice.[129] "The Amendment did not bind the federal courts to the exact procedural incidents or details of jury trial according to the common law in 1791, any more than it tied them to the common-law system of pleading or the specific rules of evidence then prevailing."[130] Rather, the Court found that "the Amendment was designed to preserve the basic institution of jury trial in only its most fundamental elements, not the great mass of procedural forms and details."[131] Although the Court in *Galloway* did not articulate what it thought the fundamental elements of the jury trial were, it cited as authority such cases as *Gasoline Products Co. v. Champlin Refining Co.*, *Ex parte Peterson*, and *Walker v. New Mexico*, all of which defined as fundamental the jury's role as the finder of facts.[132]

Even an element as seemingly fundamental as a jury composed of twelve persons has not survived the adaptation to modern practices and procedures. In *Colgrove v. Battin*,[133] the Court affirmed a lower court's decision that a local district court rule permitting six rather than twelve persons to constitute a jury does not violate the Seventh Amendment.[134] Despite earlier Supreme Court decisions declaring that a twelve person jury is one of the fundamental guarantees of the Seventh Amendment, and despite the common law practice in 1791 of juries of twelve, the Court determined that having twelve members was not a substantive aspect of the right to a jury trial.[135] It noted

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126 *Id.* at 498.

127 319 U.S. 372 (1943).

128 *See id.* at 373, 392.

129 *See id.* at 388-96.

130 *Id.* at 390.

131 *Id.* at 392.

132 *See id.* at 390-91 n.22 (citing Gasoline Prods. Co. v. Champlin Ref. Co, 283 U.S. 494, 498 (1931); *Ex parte* Peterson, 253 U.S. 300, 309-10 (1920); Walker v. New Mexico & S. Pac. R.R. Co., 165 U.S. 593, 596-98 (1897)). The language from *Galloway* was quoted in *Parklane Hosiery Co. v. Shore*, 439 U.S. 322 (1979), where the Court found that the use of offensive collateral estoppel (with no mutuality of parties) did not violate the petitioner's Seventh Amendment right to a jury trial, even though mutuality of parties was required at common law. *See id.* at 336-37.

133 413 U.S. 149 (1973).

134 *See id.* at 159-60.

135 *See id.* at 158-60. *But see* Capital Traction Co. v. Hof, 174 U.S. 1, 13 (1899) (stating that included in the right to a civil jury trial is the concept that "'[t]rial by jury,' in the primary and usual sense of the term at the common law and in the American constitutions . . . is a trial by a jury of twelve men").

that "the Framers of the Seventh Amendment were concerned with preserving the *right* of trial by jury in civil cases where it existed at common law, rather than the various incidents of trial by jury."[136] The Court referred to its earlier decision in *Williams v. Florida*,[137] a criminal case, where it had rejected the notion that the reliability of a jury as fact finder is a function of its size.[138] In the Court's view, the reduction in the number of jurors would not impact upon the fundamental purpose of the jury trial right in a civil case: "to assure a fair and equitable resolution of factual issues."[139]

These cases demonstrate that when the Court has approved changes to the jury trial right, it has insisted that such changes must not undermine the fundamental role of the jury to find facts. When the Court has *not* approved such changes, its justification has also been that of protecting the role of the jury to find facts. In *Dimick v. Schiedt*,[140] the Court refused to approve the practice of additur, which it said was not an established practice under the common law.[141] A trial court judge in a negligence case had ordered a new trial unless the defendant would agree to an increase in damages.[142] The Court of Appeals reversed on the grounds that the judge's order violated the Seventh Amendment right of trial by jury.[143] The Supreme Court affirmed the decision of the Court of Appeals, based on its view that additur would interfere with the right of jury trial.[144] The Court distinguished the accepted practice of remittitur by noting that reducing an excessive verdict is simply "lopping off an excrescence."[145] But, according to the Court, if a court increases a verdict that is too small, it is doing something that has never been passed upon by the jury, and thereby brings "the constitutional right of the plaintiff to a jury trial to an end in respect of a matter of fact."[146] The Court made clear its respect for the civil jury trial right, noting that Blackstone characterized it as "'the glory of the English law' and 'the most transcendent privilege which any subject can enjoy.'"[147] The Court went on to state, in language that has been frequently quoted by other courts, its view of the

136 *Colgrove*, 413 U.S. at 155-56.

137 399 U.S. 78, 100-01 (1970) (finding a Florida statute that provides for a "six-man" jury for noncapital criminal trials to be constitutional).

138 *See Colgrove*, 413 U.S. at 157-59 (citing *Williams*, 399 U.S. at 100-01).

139 *Id.* at 157.

140 293 U.S. 474 (1935).

141 *See id.* at 484-85.

142 *See id.* at 475-76.

143 *See id.* at 476.

144 *See id.* at 486-88.

145 *Id.* at 486.

146 *Id.* Curiously, the Court in *Parklane Hosiery Co. v. Shore*, 439 U.S. 322 (1978), declared that the holding in *Dimick* was that the use of additur violated the *Re-Examination Clause* of the Seventh Amendment. *See Parklane Hosiery*, 439 U.S. at 336. That was not the *Dimick* Court's view. It specifically affirmed the holding of the court of appeals that the use of additur "violated the Seventh Amendment of the Federal Constitution in respect of the right of trial by jury." *Dimick*, 293 U.S. at 476. The trial court was not viewed as having re-examined a fact tried by a jury. Rather, the trial court was making "a bald addition" of something not included in the verdict, and therefore never passed upon by the jury. *See id.* at 486. Such an act by the lower court violated the right to trial by jury. *See id.* at 486-87.

147 *Dimick*, 293 U.S. at 485 (quoting 3 WILLIAM BLACKSTONE, COMMENTARIES *379).

importance of the jury as fact finder: "Maintenance of the jury as a fact-finding body is of such importance and occupies so firm a place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be scrutinized with the utmost care."[148]

A "seeming curtailment" of the jury trial right nonetheless took place in *Tull v. United States*.[149] In *Tull*, as discussed previously, the Court found that there was a jury trial right for the statutory cause of action by emphasizing the importance of the remedy sought over the historical analogue for the cause of action.[150] But the decision did involve a curtailment of the jury function with respect to the remedy phase of the trial. The Court held that the judge rather than the jury should determine the amount of civil penalties, stating that "[t]he Seventh Amendment is silent on the question whether a jury must determine the remedy in a trial in which it must determine liability."[151] The Court reasoned, therefore, that whether the remedy *must* go to the jury depended "on whether the jury must shoulder this responsibility as necessary to preserve the 'substance of the common-law right of trial by jury.'"[152] Although the Court used language that indicated it was applying the principles of the second strand of Seventh Amendment jurisprudence, there was a major difference. Typically, when the Court has made changes in jury practices or procedures, it has nonetheless noted that any changes are limited by the necessity of preserving the substance of the jury trial right, which it has repeatedly defined as the jury's fact-finding role. In *Tull*, the Court spoke of the "'substance of the common-law right,'"[153] but it never defined what that substance was. Although it cited Professor Scott's classic article, *Trial by Jury and the Reform of Civil Procedure*, for the proposition that "'"[o]nly those incidents which are regarded as fundamental, as inherent in and of the essence of the system of trial by jury, are placed beyond the reach of the legislature,"'"[154] the Court never specified what those fundamental incidents were. Professor Scott did define in his article what he believed to be the essential elements of the jury trial right: (1) having a jury composed of twelve persons, (2) having a unanimous verdict, (3) having a jury that is impartial and competent, and (4) having the jury determine questions of fact.[155] By the time of *Tull*, of course, the Court had already approved of juries composed of fewer than twelve persons, but the other elements of the jury trial right appeared to remain intact. The Court in *Tull*, however, without considering these elements, simply concluded that Congress's ability to set penalties has not been questioned, that British practice

148 *Id.* at 486. This language concerning the importance of the jury has been cited in a number of other Supreme Court cases, *see, e.g.*, Chauffeurs, Teamsters & Helpers Local No. 391 v. Terry, 494 U.S. 558, 565 (1990); *Parklane Hosiery*, 439 U.S. at 346; Colgrove v. Battin, 413 U.S. 149, 187-88 (1973) (Marshall, J., dissenting); Beacon Theatres, Inc. v. Westover, 359 U.S. 500, 501 (1959), as well as in dozens of lower court decisions.

149 481 U.S. 412 (1987).

150 *See id.* at 421.

151 *Id.* at 425-26.

152 *Id.* at 426 (quoting *Colgrove*, 413 U.S. at 157).

153 *Id.* (quoting *Colgrove*, 413 U.S. at 157).

154 *Id.* (quoting *Colgrove*, 413 U.S. at 156 n.11 (quoting Scott, *supra* note 24, at 671)).

155 *See* Scott, *supra* note 24, at 675-78.

was similar, and that therefore "[t]he assessment of a civil penalty is not one of the 'most fundamental elements.'"[156] What the Court disregarded is that determining monetary remedies has long been considered a question of fact for the jury.[157] In *Dimick v. Schiedt*, the Court stated that the parties are entitled "to have a jury properly determine the question of liability and the extent of the injury by an assessment of damages. Both are questions of fact."[158]

The Court's decision in *Tull* to allocate the determination of the amount of civil penalties to the judge was distinguished in a recent case, *Feltner v. Columbia Pictures Television, Inc.* In *Feltner,* discussed below in greater detail, the Court held that the amount of statutory damages in a copyright case must be decided by a jury, despite Congress's allocation of this task to the courts.[159] The Court noted that "there is overwhelming evidence that the consistent practice at common law was for juries to award damages."[160] The Court gave two bases for distinguishing *Tull.* First, it stated that in *Tull*, the Court had not been presented with any evidence that juries had historically determined the amount of civil penalties which must be paid to the government.[161] Second, the Court explained that determining civil penalties could be viewed as analogous to sentencing in a criminal proceeding.[162] Because no similar analogy could be made in *Feltner*, and because there was "clear and direct historical evidence that juries, both as a general matter and in copyright cases, set the amount of damages awarded to a successful plaintiff," the Court in *Feltner* found *Tull* to be inapposite.[163]

Further, the Court appeared to indicate some dissatisfaction with the decision in *Tull* to take the remedy issue away from the jury:

> It should be noted that *Tull* is at least in tension with *Bank of Hamilton v. Dudley's Lessee*, in which the Court held in light of the Seventh Amendment that a jury must determine the amount of compensation for improvements to real estate, and with *Dimick v. Schiedt*, in which the Court held that the Seventh Amendment bars the use of additur.[164]

The Court also observed that denying the jury the right to determine civil penalties in *Tull* was "arguably dicta."[165] Thus, although *Tull* was consistent with the first strand of Seventh Amendment jurisprudence in its use of the historical test to determine whether there is a civil jury trial right, it formed a

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156 *Tull*, 481 U.S. at 426 (quoting Galloway v. United States, 319 U.S. 372, 392 (1943)).

157 *See* Feltner v. Columbia Pictures Television, Inc., 523 U.S. 340, 353 (1998) ("It has long been recognized that 'by the law the jury are judges of the damages.'" (citations omitted)); Bank of Hamilton v. Dudley's Lessee, 27 U.S. (2 Pet.) 492, 525 (1829).

158 Dimick v. Schiedt, 293 U.S. 474, 486 (1935).

159 *See Feltner*, 523 U.S. at 354-55; *infra* Part V.B.

160 *Feltner*, 523 U.S. at 353.

161 *See id.* at 355.

162 *See id.*

163 *Id.*

164 *Id.* at 355 n.9 (citations omitted).

165 *Id.* at 354 n.8.

narrow exception to the second strand with respect to the jury's role in determining the amount of civil penalties.

As described above, as long as the jury's fact-finding role is preserved, the Supreme Court has been willing to approve many kinds of changes to jury trial procedures and practices.[166] While they may directly protect the jury's fact-finding function, the changed procedures may indirectly reduce the role of juries. Justice Rehnquist, dissenting in *Parklane Hosiery Co. v. Shore*, raised this warning:

> To say that the Seventh Amendment does not tie federal courts to the exact procedure of the common law in 1791 does not imply, however, that any nominally "procedural" change can be implemented, regardless of its impact on the functions of the jury. . . . [N]o amount of argument that the device provides for more efficiency or more accuracy or is fairer will save it if the degree of invasion of the jury's province is greater than allowed in 1791. To rule otherwise would effectively permit judicial repeal of the Seventh Amendment because nearly any change in the province of the jury, no matter how drastic the diminution of its functions, can always be denominated "procedural reform."[167]

Justice Rehnquist observed that whatever procedural changes are made, they cannot be allowed to invade the "jury's province," presumably its fact-finding function.[168] Yet, the jury has unquestionably lost much of its fact-finding power indirectly through various "procedural" devices. The courts have, of course, always had a gatekeeping function with respect to evidence admitted at trial. The judge is able to keep matters from the jury without offending the Seventh Amendment when the evidence is cumulative, irrelevant, or prejudicial, or when there are no genuine disputed issues of fact.[169]

To the extent, however, that the gate becomes narrower with respect to ordinary factual issues, the jury's role is reduced and the Seventh Amendment guarantee is weakened. The easing of the requirements for motions for summary judgment and judgment as a matter of law have resulted in fewer cases ever getting to the jury.[170] Because the question of the sufficiency of

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166 *See supra* Part II.B.

167 Parklane Hosiery Co. v. Shore, 439 U.S. 322, 345-46 (1979) (Rehnquist, J., dissenting).

168 *See id.* at 346 (Rehnquist, J., dissenting).

169 Conversely, the judge can also send to the jury, based on rules of evidence, matters which may not have been sent to the jury in 1791. In *Galloway v. United States*, 319 U.S. 372 (1943), the Court noted that

> [t]he rules governing the admissibility of evidence, for example, have a real impact on the jury's function as a trier of facts and the judge's power to impinge on that function. Yet it would hardly be maintained that the broader rules of admissibility now prevalent offend the Seventh Amendment because at the time of its adoption evidence now admitted would have been excluded.

Id. at 391 n.22.

170 *See* Celotex Corp. v. Catrett, 477 U.S. 317, 322-23 (1986) (finding that like directed verdicts, summary judgment decisions are meant to screen out cases due to insufficient evidence as a matter of law, thus eliminating the need for a jury trial); Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 250-51 (1986) (same). In 1991, Rule 50 of the Federal Rules of Civil Procedure was changed so that judgment notwithstanding the verdict and directed verdict were both replaced

the evidence in both instances is viewed as a matter of law, the jury's role as finder of fact has shrunk as the role of the court has expanded.[171]

In some respects, the jury would be much less effective today if its practices and procedures had been frozen in 1791. As Justice Ginsburg noted in *Gasperini v. Center for Humanities*,[172] "[i]f the meaning of the Seventh Amendment were fixed in 1791, our civil juries would remain, as they unquestionably were at common law, 'twelve good men and true.'"[173] Today, of course, the composition of juries is quite different from the typical white male jury of 1791. In *Colgrove v. Battin*, the Court permitted six person juries,[174] and in *Thiel v. Southern Pacific Co.*,[175] the Court held that litigants are entitled to "an impartial jury drawn from a cross section of the community."[176]

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with a single term: judgment as a matter of law. *See* FED. R. CIV. P. 50(a), (b). The basic practice has not changed under the new name, however. *See id.* In *Galloway*, Justice Black in dissent decried the directed verdict as "a long step toward the determination of fact by judges instead of by juries." *Galloway*, 319 U.S. at 401 (Black, J., dissenting). Justice Black noted that in the nineteenth century, a case had to go to the jury unless there was "no evidence whatever" to support a party's contentions. *Id.* at 402 (Black, J., dissenting). By the early twentieth century, the judge had the obligation to weigh the evidence, and if it was overwhelming for either party, he could direct a verdict. *See id.* at 404-05 (Black, J., dissenting) (citing Gunning v. Cooley, 281 U.S. 90, 94 (1930)). The current standard is simply if "there is no legally sufficient evidentiary basis for a reasonable jury to find for that party on that issue," the court can grant judgment as a matter of law. FED. R. CIV. P. 50(a)(1).

171 *See* Baltimore & Carolina Line, Inc. v. Redman, 295 U.S. 654, 659 (1935) ("Whether the evidence [supporting motions to dismiss and for a directed verdict] was sufficient or otherwise was a question of law to be resolved by the court."). Professor Dooley has noted that by characterizing the sufficiency of the evidence as a matter of law, the judge can second-guess the jury without appearing to "re-examine" decided facts or usurp jury power. "By enlarging the domain of 'legal questions,' by recognizing devices that facilitate second-guessing of jury decisions, and by redefining the circumstances under which that interference may occur, the legal system has quietly but unquestionably eroded the power of the jury." Laura Gaston Dooley, *Our Juries, Our Selves: The Power, Perception, and Politics of the Civil Jury*, 80 CORNELL L. REV. 325, 333-35 (1995) (citations omitted).

172 518 U.S. 415 (1995).

173 *Id.* at 436 n.20 (quoting 3 WILLIAM BLACKSTONE, COMMENTARIES *349) (citing Capital Traction Co. v. Hof, 174 U.S. 1, 13 (1899)). *Gasperini* held that "New York's law controlling compensation awards for excessiveness or inadequacy can be given effect, without detriment to the Seventh Amendment, if the review standard set out [in the New York law] is applied by the federal trial court judge, with appellate control of the trial court's ruling limited to review for 'abuse of discretion.'" *Id.* at 419.

174 *See* Colgrove v. Battin, 413 U.S. 149, 159-60 (1973).

175 328 U.S. 217 (1946).

176 *Id.* at 220; *see also* 28 U.S.C. § 1861 (1994) (requiring "grand and petit juries [to be] selected at random from a fair cross section of the community"). Professor Laura Dooley argues that growth of restraints on jury power, as well as disdain for jury "irrationality" have paralleled and possibly been prompted by the increasing inclusion of women and minorities on the jury.

> The story of the civil jury in America is a tale that mixes progress in access for all citizens to this treasured civic duty with progressive decline in the influence associated with that duty. . . .
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> . . . [A] correlation may be drawn between the decline of jury influence and the inevitable post-Civil War change in jury personnel: as the jury became an object of demographic diversification, restraints on its power also were tightening. The very

In sum, the Court has approved numerous changes in judicial procedures that affect whether cases go to a jury, as well as changes in the composition of juries themselves. Until *Markman*, however, with the lone exception of the determination of the amount of civil penalties in *Tull*, the Court had repeatedly held that the substance of the jury trial right—the jury's fact-finding role—must be preserved.

C. *Merger of Law and Equity*

While the sphere of the jury's power has clearly been reduced as a result of the strengthening of devices such as summary judgment and judgment as a matter of law, the Court preserved and even expanded the jury's fact-finding function as a result of the merger of legal and equitable causes of action in federal lawsuits in 1938.[177] This third strand of Seventh Amendment jurisprudence concerns what must be "preserved" of the jury trial right when legal and equitable issues are joined in the same action.

In cases where issues of law and equity were mixed, the Court essentially rejected the application of traditional rules in favor of a practical, yet principled interpretation of the Seventh Amendment guarantee. The result was that more issues in mixed law and equity cases could be tried by juries. In *Beacon Theatres, Inc. v. Westover*,[178] *Dairy Queen, Inc. v. Wood*,[179] and *Ross v. Bernhard*,[180] the Court determined that procedural changes resulting from the merger of law and equity reduced the need for issues to be tried in equity, because adequate remedies were available in one lawsuit before a court that could hear both legal and equitable issues.

In *Beacon Theatres*, Beacon notified Fox West Coast Theaters ("Fox") that it considered Fox's contracts with movie distributors, which gave Fox the exclusive right to show first-run movies in the San Bernardino area, to be in violation of the antitrust laws.[181] Rather than waiting to be sued, however, Fox struck first by seeking a declaration that its contracts did not violate the antitrust laws, and seeking an injunction to prevent Beacon from bringing the antitrust action against Fox.[182] Beacon answered, and, by counterclaim, asserted its antitrust claim against Fox.[183] Fox's complaint was equitable in nature, but Beacon's counterclaim was legal.[184]

The lower courts followed the then-prevailing method of trial order when the plaintiff sought equitable relief and the defendant sought legal relief. That method was to first try the plaintiff's equitable claims to the court

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> institution that was touted by constitutional framers as the bulwark of liberty had become a dangerous vehicle for upsetting the status quo.

Dooley, *supra* note 171, at 349, 354.

177 When the Federal Rules of Civil Procedure were adopted in 1938, they provided for "only one action—a 'civil action'—in which all claims may be joined and all remedies are available." Ross v. Bernhard, 396 U.S. 531, 539 (1970); *see also* FED. R. CIV. P. 1, 2, 18.

178 359 U.S. 500, 509 (1959).

179 369 U.S. 469, 478 (1962).

180 *Ross*, 396 U.S. at 540.

181 *See Beacon Theatres*, 359 U.S. at 502.

182 *See id.* at 502-03.

183 *See id.* at 503.

184 *See id.*

before a jury could hear the defendant's legal counterclaim.[185] Because of the doctrine of collateral estoppel, the judge's findings on the issues of fact common to both the equitable and legal claims would bind the jury in the legal action, thus denying a fact-finding role for the jury on those issues.

The Supreme Court, disagreeing with the lower courts, held that where legal and equitable claims are brought in one action, and where there are factual issues common to both the legal and equitable causes of action, a court cannot, absent exceptional circumstances, deprive a litigant of his right to a jury trial by trying the equitable claim first.[186] Because of the Seventh Amendment guarantee, the trial court's discretion as to the order of trying issues is quite limited: "Since the right to jury trial is a constitutional one, . . . while no similar requirement protects trials by the court, that discretion is very narrowly limited and must, wherever possible, be exercised to preserve jury trial."[187]

Prior to the merger of law and equity, courts of equity sometimes enjoined legal claims to protect fully the rights of the plaintiff in equity. A plaintiff who requested an injunction might suffer irreparable harm if the injunction could not be considered until after legal claims were first resolved. Thus, equitable claims were frequently heard before legal claims.[188] The Court made clear, however, that the merger of legal and equitable causes of action in the same lawsuit ended the need to resolve all equitable issues before proceeding to legal ones: "Inadequacy of remedy and irreparable harm are practical terms . . . . As such their existence today must be determined, not by precedents decided under discarded procedures, but in the light of the remedies now made available by the Declaratory Judgment Act and the Federal Rules."[189] Rather than mandating the determination of equitable causes of action first at the expense of the jury trial right, the Federal Rules of Civil Procedure now permit legal and equitable causes of action to be tried together, so equitable issues needing immediate relief can be dealt with on a temporary basis pending a jury trial on the legal issues.[190] Collateral estoppel would now work in the other direction—the jury's findings on the issues of fact common to both the equitable and legal claims would bind the judge in the equitable action.

Trying Fox's equitable claims first would mean that Beacon would not have been entitled to a jury trial on its antitrust claim with respect to the

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185 *See id.*; John C. McCoid, II, *Procedural Reform and the Right to a Jury Trial: A Study of* Beacon Theatres, Inc. v. Westover, 116 U. PA. L. REV. 1, 5 (1967) (discussing "equity's traditional power to enjoin, pending adjudication in equity, proceedings at law instituted by plaintiff's adversary" (citing 3 JOHN NORTON POMEROY, EQUITY JURISPRUDENCE §§ 1360-1361, 1363 (San Francisco, A.L. Bancroft & Co. 1883))).

186 *See Beacon Theatres*, 359 U.S. at 510-11.

187 *Id.* at 510 (footnote omitted).

188 *See* McCoid, *supra* note 185, at 5-6, 15-17; *see also Beacon Theatres*, 359 U.S. at 507 ("[C]ourts of equity . . . were, in some cases, allowed to enjoin subsequent legal actions between the same parties involving the same controversy . . . because the subsequent legal action . . . might not protect the right of the equity plaintiff to a fair and orderly adjudication of the controversy." (citations omitted)).

189 *Beacon Theatres*, 359 U.S. at 507 (citations omitted).

190 *See id.* at 508.

issues of fact common to both claims. Thus, part of the antitrust claim would be tried to the judge and part to the jury. The Court found such a result impermissible: "Since the issue of violation of the antitrust laws often turns on the reasonableness of a restraint on trade in the light of all the facts, it is particularly undesirable to have some of the relevant considerations tried by one fact finder and some by another."[191] Trying all the issues to a jury in the first instance would better serve the purpose of producing a coherent determination based on all underlying factual issues.

Beacon Theatres marked a kind of watershed in the development of Seventh Amendment jurisprudence. The dissenters—Justices Stewart, Harlan, and Whittaker—maintained that the Court was improperly using the Federal Rules to expand the jury trial right beyond its historical scope of application.[192] These Justices viewed the decision as violating the express prohibition of any such expansion contained in the congressional authorization of the Federal Rules.[193] The majority, however, thought that the procedural obstacles to a jury trial of common issues in actions with both legal and equitable claims had been removed by the merger of the claims in a single action: "Since in the federal courts equity has always acted only when legal remedies were inadequate, the expansion of adequate legal remedies provided by the Declaratory Judgment Act and the Federal Rules necessarily affects the scope of equity."[194] According to the Court, the inadequacy of a legal remedy that had formerly justified deciding equity issues prior to legal issues had now been cured by new procedures.[195]

The Court reaffirmed its *Beacon Theatres* holding three years later in *Dairy Queen, Inc. v. Wood*.[196] The case involved the breach of a franchise contract and trademark infringement. Dairy Queen's complaint sought injunctions against the future use of their trademark and franchise by Wood, an

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191 *Id.* at 508 n.10 (citations omitted).

192 *See id.* at 518-19 (Harlan, Whittaker, and Stewart, JJ., dissenting).

193 *See id.* (Harlan, Whittaker, and Stewart, JJ., dissenting). Both the Federal Rules and the Declaratory Judgment Act, 28 U.S.C. §§ 2201, 2202 (1994), in their view, merely preserve, but do not expand, the right to jury trial "historically cognizable at common law." *See Beacon Theatres*, 359 U.S. at 518-19 (Harlan, Whittaker, and Stewart, JJ., dissenting); *see also* 28 U.S.C. §§ 2201, 2202.

194 *Beacon Theatres*, 359 U.S. at 509 (citations omitted). The Court noted that, in delegating to the Supreme Court the responsibility for drawing up the Federal Rules, Congress declared: "Such rules shall not abridge, enlarge or modify any substantive right and shall preserve the right of trial by jury as at common law and as declared by the Seventh Amendment to the Constitution." *Id.* at 510 n.16 (quoting Act of June 25, 1948, ch. 646, § 2072, 62 Stat. 869, 961 (codified as amended at 28 U.S.C. § 2072)). Section 2072 no longer references the common law or Seventh Amendment. *See* 28 U.S.C. § 2072.

195 *See Beacon Theatres*, 359 U.S. at 509; *see also* McCoid, *supra* note 185, at 6. Professor McCoid stated that *Beacon Theatres* is consistent with the view that the scope of Seventh Amendment protection has always been one of "jurisdictional lines between law on the one hand, and equity and admiralty on the other." McCoid, *supra* note 185, at 23. Because Seventh Amendment protection is based on a jurisdictional principle, the jurisdiction should be determined by present, not past procedure. *See id.* at 23-24. Professor McCoid concluded that "[t]he *Beacon* decision . . . clearly enlarges enjoyment of jury trial as of right and reflects a basic pro-jury bias. That it should do so is quite clear, in view of the pro-jury bias of the Constitution." *Id.* at 24.

196 369 U.S. 469 (1962).

accounting, and an injunction preventing Wood from collecting money from Dairy Queen stores in the territory.[197] Reversing both the trial and appellate courts on the question of the right to a jury trial, the Supreme Court rejected the district court's view that the issues raised were either "'purely equitable'" or that the legal issues were "'incidental' to equitable issues."[198] The Court quickly noted that the district court's characterization of legal issues as "incidental" does not in any way affect the right to a jury trial on legal issues: "'It would make no difference if the equitable cause clearly outweighed the legal cause so that the basic issue of the case taken as a whole is equitable. As long as any legal cause is involved the jury rights it creates control.'"[199]

The respondents had contended that their claim was entirely equitable, based on the fact that the complaint sought an "accounting."[200] The Court, however, held that simply casting the complaint in terms of an "accounting," rather than as an action for debt or damages, could not obscure the fact that there was an adequate remedy at law.[201] According to the Court,

> the constitutional right to trial by jury cannot be made to depend upon the choice of words used in the pleadings. The necessary prerequisite to the right to maintain a suit for an equitable accounting, like all other equitable remedies, is, as we pointed out in *Beacon Theatres*, the absence of an adequate remedy at law.[202]

The Court maintained that for an accounting to be an equitable matter, the plaintiff had to demonstrate "that the 'accounts between the parties' [were] of such a 'complicated nature' that only a court of equity [could] satisfactorily unravel them."[203] The Court noted, however, that *Dairy Queen* was not such a case.[204] The Court observed that it was unlikely that an accounting would be considered equitable in view of the power given the district courts under Rule 53 of the Federal Rules of Civil Procedure to appoint masters.[205] Because the masters would "assist the jury in those exceptional cases where the legal issues are too complicated for the jury adequately to handle alone, the burden of such a showing is considerably increased and it will indeed be a rare case in which it can be met."[206] As in *Beacon Theatres*, the Court found that a change in procedural rules eliminated the need for an equitable proceeding, because there was no need for the accounting to be characterized as equitable.[207] The principle derived from both *Beacon Theatres* and *Dairy Queen* appears to be that where the remedy at law is adequate

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197 *See id.* at 475.

198 *Id.* at 470 (quoting McCullough v. Dairy Queen, Inc., 194 F. Supp. 686, 687 (E.D. Pa. 1961), *rev'd sub nom.* Dairy Queen, Inc. v. Wood, 369 U.S. 469 (1962)). The Third Circuit had denied mandamus without opinion. *See id.*

199 *Id.* at 473 n.8 (quoting Thermo-Stitch, Inc. v. Chemi-Cord Processing Corp., 294 F.2d 486, 491 (5th Cir. 1961)).

200 *See id.* at 477.

201 *See id.* at 477-78.

202 *Id.* (citing Beacon Theatres, Inc. v. Westover, 359 U.S. 500, 506-10 (1959)).

203 *Id.* at 478 (quoting Kirby v. Lake Shore & Mich. S. R.R. Co., 120 U.S. 130, 134 (1887)).

204 *See id.* at 478-79.

205 *See id.* at 478; *see also* FED. R. CIV. P. 53.

206 *Dairy Queen*, 369 U.S. at 478 (footnote omitted).

207 Although similar procedures antedate the federal rules, appointing masters is a proce-

as a result of modified procedures, equity no longer has jurisdiction, even though such jurisdiction may well have existed under earlier forms of procedure.[208]

The Court found that changed procedures also supported a jury trial right in a shareholder's derivative action, which, pre-merger, had sounded in equity. In *Ross v. Bernhard*,[209] shareholders of the Lehman Corporation brought an action derivatively against the directors of the corporation and the corporation's brokers, Lehman Brothers, contending that Lehman Brothers illegally controlled the corporation, and used this control to exact excessive brokerage fees.[210] The court of appeals had ruled that a derivative action was entirely equitable in nature.[211]

Referring to *Beacon Theatres* and *Dairy Queen*, the Supreme Court held that:

> [t]he heart of the action is the corporate claim. If it presents a legal issue, one entitling the corporation to a jury trial under the Seventh Amendment, the right to a jury is not forfeited merely because the stockholder's right to sue must first be adjudicated as an equitable issue triable to the court.[212]

Here again the merger of legal and equitable claims in one lawsuit had removed procedural impediments to trial by jury. The shareholders' claims were essentially claims at law, although brought in an equitable action:

> The historical rule preventing a court of law from entertaining a shareholder's suit on behalf of the corporation is obsolete; it is no longer tenable for a district court, administering both law and equity in the same action, to deny legal remedies to a corporation, merely because the corporation's spokesmen are its shareholders rather than its directors. Under the rules, law and equity are procedurally combined; nothing turns now upon the form of the action or the procedural devices by which the parties happen to come before the court. The "expansion of adequate legal remedies provided by . . . the Federal Rules necessarily affects the scope of equity."[213]

Although the dissenters in *Ross* objected strongly to what they considered to be the majority's rejection of "history, logic, and over 100 years of firm precedent,"[214] the majority's decision appears to be quite consistent with

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dural innovation when compared with rules of 1791. *See Ex parte* Peterson, 253 U.S. 300, 307-09 (1920); *see also* McCoid, *supra* note 185, at 8.

208 *See* McCoid, *supra* note 185, at 12-13.

209 396 U.S. 531 (1970).

210 *See id.* at 531.

211 *See* Ross v. Bernhard, 403 F.2d 909, 912 (2d Cir. 1968), *rev'd*, 396 U.S. at 543. The district court had held that the shareholders had a jury trial right, because the cause of action they were asserting on behalf of the corporation was legal in nature. *See* Ross v. Bernhard, 275 F. Supp. 569, 570-71 (S.D.N.Y. 1967), *rev'd*, 403 F.2d at 910, *rev'd*, 396 U.S. at 543.

212 *Ross*, 396 U.S. at 539.

213 *Id.* at 540 (quoting Beacon Theatres, Inc. v. Westover, 359 U.S. 500, 509 (1959)).

214 *Id.* at 544 (Burger, C.J., Harlan & Stewart, JJ., dissenting). Two of the three dissenters, Justices Harlan and Stewart, had also dissented in *Beacon Theatres*. *See Beacon Theatres*, 359 U.S. at 511 (Stewart, Harlan, and Whittaker, JJ., dissenting).

the Seventh Amendment. Just as it did in *Beacon Theatres* and *Dairy Queen*, the Court in *Ross* followed the rule that equity is only available when irreparable harm is threatened and there is no adequate remedy at law.[215] Before law and equity courts had merged, the need for quick action sometimes justified equity claims being heard first at the cost of the jury trial right on the legal claims. After the merger of the law and equity courts, however, a court could act quickly to provide temporary equitable relief, while fully protecting the jury trial right for the claims at law. The Court's approach in this area is consistent with modern constitutional interpretation, which views the Constitution "as a living, growing entity," and "'as a durable document providing continuingly useful standards for an evolving society.'"[216]

In sum, this third strand of Seventh Amendment jurisprudence demonstrates that when the merger of law and equity courts removed the practical impediment to trying legal issues prior to determining issues in equity, the Court expanded the application of the jury trial right, but preserved the principle that equity will not decide issues which have an adequate remedy at law.

D. Deference to Congressional Statutory Scheme

While the Court preserved and even expanded the jury trial right in cases involving both legal and equitable issues, it also delineated an entire area which it found to be outside the Seventh Amendment guarantee. In a series of decisions, the Court determined that the Seventh Amendment did not apply to new statutory areas involving "public rights," where Congress had established administrative bodies and non-Article III courts as fact finders.[217]

The development of this doctrine is illustrated by *Katchen v. Landry*,[218] a bankruptcy case in which the trustee sought return of a preference.[219]

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215 *See Ross*, 369 U.S. at 539-40. From 1789 until 1938, the judicial code forbade courts of equity from accepting jurisdiction of any suit for which there was an adequate remedy at law. *See id.* at 539. The Judicial Code of 1911, ch. 231, § 267, 36 Stat. 1087, 1163, re-enacting the Act of Sept. 24, 1789, ch. 20, § 16, 1 Stat. 73, 82, provided: "Suits in equity shall not be sustained in any court of the United States in any case where a plain, adequate, and complete remedy may be had at law." Judicial Code of 1911, ch. 231, § 267, *quoted in Ross*, 396 U.S. at 539 n.12.

216 Martin H. Redish & Daniel J. La Fave, *Seventh Amendment Right to Jury Trial in Non-Article III Proceedings: A Study in Dysfunctional Constitutional Theory*, 4 WM. & MARY BILL OF RTS. J. 407, 415 & n.36 (1995) (quoting McCoid, *supra* note 185, at 11).

217 Some early cases stating that Congress could provide for determinations involving public rights outside the judicial sphere include *Murray's Lessee v. Hoboken Land & Improvement Co.*, 59 U.S. (18 How.) 272, 280-81 (1855) (asserting that Congress is not required to bring certain matters, involving public rights, which may be susceptible to judicial determination, within the cognizance of the courts), and *Crowell v. Benson*, 285 U.S. 22, 50 (1932) (distinguishing between private rights and rights involving government's authority to perform constitutional functions of the executive or legislative departments).

218 382 U.S. 323 (1966).

219 *See id.* at 325. A "preference" occurs when an insolvent debtor distributes or pays to one or more of its creditors a larger amount than they would have been entitled to receive on a pro rata distribution among creditors. *See* MICHAEL J. HERBERT, UNDERSTANDING BANKRUPTCY 247, 250 (1995).

Bankruptcy courts are sometimes referred to as non-Article III courts, because they are not

Although some courts have viewed bankruptcy proceedings as inherently equitable, some actions brought by trustees in bankruptcy in federal court have traditionally had a jury trial right.[220] In *Katchen*, a creditor had filed a claim in a bankruptcy proceeding, and the trustee in turn sought the return of a preference from the creditor.[221] Although seeking a return of the preference would normally require a plenary action in the federal courts where the creditor would have a jury trial right, the Court in *Katchen* upheld the summary jurisdiction of the bankruptcy court to decide all issues.[222] The Court distinguished this case from *Beacon Theatres* and *Dairy Queen* on the ground that this case "involved a specific statutory scheme contemplating the prompt trial of a disputed claim without the intervention of a jury."[223]

Deference to a congressional statutory scheme also undergirded the Court's decision in *Atlas Roofing Co. v. Occupational Safety & Health Review Commission*,[224] which affirmed findings that two employers had violated safety standards promulgated under the Occupational Safety and Health Act of 1970 ("OSHA").[225] The employers challenged the administrative procedures under OSHA as contravening the Seventh Amendment by denying them a right to a jury trial.[226] The Court held that the Seventh Amendment "does not prohibit Congress from assigning the factfinding function and initial adjudication to an administrative forum with which the jury would be incompatible."[227] A further limitation set forth by the Court, however, was

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explicitly authorized by Article III of the U.S. Constitution. In this sense, they resemble the non-Article III fora created by Congress to resolve issues administratively.

220 *Compare* Pepper v. Litton, 308 U.S. 295, 304 (1939) (stating that "for many purposes 'courts of bankruptcy are essentially courts of equity'" (quoting Local Loan Co. v. Hunt, 292 U.S. 234, 240 (1934))), *and* Nordberg v. Granfinanciera, S.A., 835 F.2d 1341, 1349 (11th Cir. 1988), *rev'd*, 492 U.S. 33 (1989) (holding that "bankruptcy . . . is equitable in nature and thus bankruptcy proceedings are inherently equitable"), *with* Schoenthal v. Irving Trust Co., 287 U.S. 92, 95 (1932) (finding that after an equitable suit seeking a preference had been filed against them, defendants were entitled to a transfer to a court of law because plaintiff "'had a plain, adequate, and complete remedy at law'" (citations omitted)).

221 *See Katchen*, 382 U.S. at 325.

222 *See id.* at 340. A "plenary action" is a complete and formal hearing or trial on the merits, as opposed to a summary hearing which is generally more informal. *See* May v. Henderson, 268 U.S. 111, 115 (1925). Some preferences may be recovered only by a plenary action in federal court, and in such an action, the creditor could demand a jury trial. *See Schoenthal*, 287 U.S. at 95-96.

Eleven years after *Katchen*, in *Atlas Roofing Co. v. Occupational Safety & Health Review Commission*, 430 U.S. 442 (1977), the Court explained its decision in *Katchen* as being based upon the bankruptcy court's status as a "specialized court of equity" which "constituted a forum before which a jury would be out of place and would go far to dismantle the statutory scheme." *Atlas Roofing*, 430 U.S. at 454 n.11.

223 *Katchen*, 382 U.S. at 339.

224 430 U.S. 442 (1977).

225 29 U.S.C. §§ 651-678 (1994 & Supp. III 1998); *see Atlas Roofing*, 430 U.S. at 461.

226 *See Atlas Roofing*, 430 U.S. at 448-49.

227 *Id.* at 450. The Court's deference to Congress in *Atlas Roofing* was severely criticized by Martin Redish and Daniel La Fave:

> [T]he fact that enforcement of a constitutional right would severely disrupt a congressional scheme must be deemed irrelevant, lest our essential constitutional structure be turned on its head. By way of contrast, few constitutional theorists today would suggest that the First Amendment right of free expression must give

that Congress could reserve fact-finding functions in administrative agencies only in cases in which "public rights" were being litigated, "cases in which the Government sues in its sovereign capacity to enforce public rights created by statutes within the power of Congress to enact."[228] The Court's justification for this deference to Congress was that juries have not been the exclusive fact finders in all cases, because admiralty and equity actions were always decided without a jury.[229] The Court determined that "there is little or no basis for concluding that the Amendment should now be interpreted to provide an impenetrable barrier to administrative factfinding under otherwise valid federal regulatory statutes."[230] The Court then announced an additional prong for its test of Seventh Amendment applicability: "Thus, history and our cases support the proposition that the right to a jury trial turns not solely on the nature of the issue to be resolved but also on the forum in which it is to be resolved."[231]

In its decision in *Atlas Roofing*, the Court proclaimed that an entire area of law was beyond the scope of the Seventh Amendment: new statutory actions created by Congress and assigned for adjudication to an administrative agency, as long as the actions involved public rights.[232] A little over a decade later, in 1989, the Court in *Granfinanciera, S.A. v. Nordberg*[233] enlarged the definition of public rights by no longer requiring that the government be one of the parties involved.[234] At the same time, the Court refined its view of the command of the Seventh Amendment, acknowledging limitations on the scope of Congress's ability to withdraw a matter completely from the jury.[235]

The Court returned to the bankruptcy arena in *Granfinanciera*. In the Bankruptcy Amendments and Federal Judgeship Act of 1984,[236] Congress designated fraudulent conveyance actions as "core proceedings" which could be adjudicated by non-Article III bankruptcy judges.[237] The trustee in

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> way merely because its enforcement would be "incompatible" with a congressional scheme. Certainly, such an approach would be inconsistent with current free speech doctrine. Congress could not, for example, constitutionally prohibit criticism of one of its legislative programs because such criticism could have the effect of undermining achievement of the program's social goals. A greater departure from our constitutional scheme would result from total judicial deference to a congressional determination concerning that incompatibility. The Court has provided absolutely no principled basis on which to distinguish, for these purposes, the Seventh Amendment right to jury trial from the First Amendment right of free expression.

Redish & La Fave, *supra* note 216, at 450 (footnotes omitted).

228 *Atlas Roofing*, 430 U.S. at 450. The Court also noted that "[w]holly private tort, contract, and property cases, as well as a vast range of other cases, are not at all implicated." *Id.* at 458.

229 *See id.* at 450 & n.7.

230 *Id.* at 460.

231 *Id.* at 460-61.

232 *See id.* at 455.

233 492 U.S. 33 (1989).

234 *See id.* at 54.

235 *See id.* at 51-52.

236 Pub. L. No. 98-353, § 104(a), 98 Stat. 333, 340 (codified at 28 U.S.C. § 157 (1994)).

237 *See* 28 U.S.C. § 157(b)(2)(H). Section 157(b)(1) provides:

> Bankruptcy judges may hear and determine all cases under title 11 and all core

Granfinanciera sued two foreign corporations in federal court to recover allegedly fraudulent transfers.[238] The corporations, which had not filed claims as creditors in the bankruptcy case, sought but were denied a jury trial.[239] Despite the congressional determination that fraudulent conveyances were core proceedings adjudicable by bankruptcy judges, the Court determined that fraudulent conveyance actions, which "'constitute no part of the proceedings in bankruptcy but concern controversies arising out of it'—are quintessentially suits at common law. . . . They therefore appear matters of private rather than public right."[240] In such a case, the Court held, the Seventh Amendment guarantees the right to a jury trial: "Congress cannot eliminate a party's Seventh Amendment right to a jury trial merely by relabeling the cause of action to which it attaches and placing exclusive jurisdiction in an administrative agency or a specialized court of equity."[241]

In *Granfinanciera*, the Court no longer defined "public right" to include matters arising only between the government and others. Reiterating a definition it first proposed four years earlier in *Thomas v. Union Carbide Agricultural Products Co.*,[242] the Court stated that a public right is one "involving statutory rights that are integral parts of a public regulatory scheme and whose adjudication Congress has assigned to an administrative agency or specialized court of equity."[243] The Court did not go so far as to hold that "the restructuring of the debtor-creditor relations is in fact a public right," although it noted that the plurality in an earlier case had suggested that it

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proceedings arising under title 11, or arising in a case under title 11, referred under subsection (a) of this section, and may enter appropriate orders and judgments, subject to review under section 158 of this title.

Id. § 157(b)(1). Section 157(b)(2) then provides a non-exclusive list of core proceedings.

238 *See Granfinanciera*, 492 U.S. at 36.

239 *See id.* at 37.

240 *Id.* at 56 (quoting Schoenthal v. Irving Trust Co., 287 U.S. 92, 94-95 (1932)). The Court noted that the plurality decision in *Northern Pipeline Construction Co. v. Marathon Pipe Line Co.* stated that the debtor creditor relations in bankruptcy "may well be a 'public right,'" but "that state-law causes of action for breach of contract or warranty are paradigmatic private rights, even when asserted by an insolvent corporation in the midst of Chapter 11 reorganization proceedings." *Id.* (quoting Northern Pipeline Constr. Co. v. Marathon Pipe Line Co., 458 U.S. 50, 71 (1982)).

241 *Id.* at 61. The Court distinguished *Katchen* by noting that the creditor in that case had filed a claim in the bankruptcy proceeding, unlike the creditors in *Granfinanciera*. *See id.* at 57. The Court asserted that its decision in *Katchen* turned on "the bankruptcy court's having 'actual or constructive possession' of the bankruptcy estate." *Id.* (quoting Katchen v. Landry, 382 U.S. 323, 327 (1966)). The Court noted further: "[B]y submitting a claim against the bankruptcy estate, creditors subject themselves to the court's equitable power to disallow those claims, even though the debtor's opposing counterclaims are legal in nature and the Seventh Amendment would have entitled creditors to a jury trial had they not tendered claims against the estate." *Id.* at 59 n.13.

242 473 U.S. 568 (1985). In rejecting a challenge to an Environmental Protection Agency proceeding, the *Thomas* Court found the proceeding involved a public right: "Congress, acting for a valid legislative purpose pursuant to its constitutional powers under Article I, may create a seemingly 'private' right that is so closely integrated into a public regulatory scheme as to be a matter appropriate for agency resolution with limited involvement by the Article III judiciary." *Id.* at 593-94.

243 *Granfinanciera*, 492 U.S. at 55 n.10.

might well be.[244] The point the Court made was that even if the restructuring process did involve a public right, the defendants in this case were involved in a controversy involving private rights and therefore were entitled to a jury trial.

The Court acknowledged that requiring a jury trial could "impede swift resolution of bankruptcy proceedings and increase the expense of Chapter 11 reorganizations."[245] Although it had used an "efficiency" argument in *Atlas Roofing* as part of its justification for administrative fact-finding in the context of OSHA, the Court in *Granfinanciera* made clear that considerations of efficiency did not overcome the Seventh Amendment's clear command: "'"[T]he fact that a given law or procedure is efficient, convenient, and useful in facilitating functions of government, standing alone, will not save it if it is contrary to the Constitution."'"[246]

In sum, the Supreme Court, while deferring to the power of Congress to create administrative adjudication systems and non-Article III courts in specialized areas, has placed limits on the scope of these tribunals. Parties to traditional common law actions, not clearly within the scope of authority of such "legislative courts," still have jury trial rights. Moreover, the Court continues to acknowledge that arguments of efficiency and convenience do not support derogation of the guarantee of a jury trial.

Thus, by the last decade of the twentieth century, there were four parallel strands in the Court's Seventh Amendment jurisprudence. The existence of the right to a jury trial is determined by a historical test of whether the action was more likely to have been tried in the courts of law or equity in 1791. The Court uses a two-pronged approach to make this determination, examining the nature of the action and the remedy sought.[247] The scope of the jury trial right appears to be flexible, not limited to the same procedures and practices found in 1791, as long as the heart of the guarantee—the jury's fact-finding role—is preserved.[248] Although reduced in scope by certain pro-

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244 *Id.* at 56 n.11 (citing *Northern Pipeline*, 458 U.S. at 71).

245 *Id.* at 63.

246 *Id.* (quoting Bowsher v. Synar, 478 U.S. 714, 736 (1986) (quoting INS v. Chadha, 462 U.S. 919, 944 (1983))); *see also* Pernell v. Southall Realty, 416 U.S. 363, 384 (1974) (discounting arguments that jury trials would be unduly burdensome and rejecting "the notion that there is some necessary inconsistency between the desire for speedy justice and the right to jury trial").

The Court's *Atlas Roofing* argument stated: "Congress is not required by the Seventh Amendment to choke the already crowded federal courts with new types of litigation or prevented from committing some new types of litigation to administrative agencies with special competence in the relevant field." Atlas Roofing Co. v. Occupational Safety & Health Review Comm'n, 430 U.S. 442, 455 (1977).

247 *See* Wooddell v. International Bhd. of Elec. Workers, Local 71, 502 U.S. 93, 97 (1991). "'"First, we compare the statutory action to 18th-century actions brought in the courts of England prior to the merger of the courts of law and equity. Second, we examine the remedy sought and determine whether it is legal or equitable in nature."' The second inquiry is the more important in our analysis." *Id.* (quoting Chauffeurs, Teamsters & Helpers Local No. 391 v. Terry, 494 U.S. 558, 565 (1990) (quoting Tull v. United States, 481 U.S. 412, 417-18 (1987))). The "historical test" has been severely criticized. *See, e.g.*, *Chauffeurs*, 494 U.S. at 574-81 (Brennan, J., concurring); Kenneth S. Klein, *The Myth of How to Interpret the Seventh Amendment Right to a Civil Jury Trial*, 53 OHIO ST. L.J. 1005, 1006 (1992); Wolfram, *supra* note 12, at 731-47.

248 With respect to the "substance" of the Seventh Amendment—the jury's fact-finding

cedural devices which allow fewer cases to reach the jury, the right has expanded vis a vis equity's ability to restrict its application. When legal and equitable claims are combined in one case with common factual issues, the jury trial right cannot be denied by trying equitable issues first. The major exception to the jury trial right—that Congress can assign resolution of a claim to a non-Article III adjudicative body that does not use a jury as fact finder—appears limited to new public rights created by Congress, and does not impact traditional private rights in areas such as contract, tort, or property.[249]

III. Markman *and Its Effect on Seventh Amendment Jurisprudence*

Discussion of the four strands of Seventh Amendment jurisprudence sets the stage for consideration of the Supreme Court's 1996 decision in *Markman v. Westview Instruments*. This part discusses how *Markman*, viewed in light of these four strands, creates a narrow exception to the Seventh Amendment guarantee. *Markman* is also examined to determine whether the decision, which reduces the role of juries in the area of patent law, indicates that similar changes are likely when applying the Seventh Amendment right in other contexts. This part concludes that although the reasoning in *Markman* may to some extent be applied outside the patent law area, the decision does not generally offer a basis for restricting the jury trial right in questions of fact in other areas of the law.[250]

Markman was an action for patent infringement. Every patent document includes two distinct elements: (1) the specification and (2) one or more claims.[251] The specification explains how the invention works.[252] It contains a description so detailed that a person skilled in the art could make

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role—the Supreme Court has consistently defined this jury function to include determining credibility, weighing contradictory evidence, and drawing inferences from the facts. *See* Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 255 (1986) (stating that "[c]redibility determinations, the weighing of the evidence, and the drawing of legitimate inferences from the facts are jury functions, not those of a judge").

In *Tennant v. Peoria & Pekin Union Ry. Co.*, 321 U.S. 29 (1944), the Court said:

> It is the jury, not the court, which is the fact-finding body. It weighs the contradictory evidence and inferences, judges the credibility of witnesses, receives expert instructions, and draws the ultimate conclusion as to the facts. The very essence of its function is to select from among conflicting inferences and conclusions that which it considers most reasonable. That conclusion, whether it relates to negligence, causation or any other factual matter, cannot be ignored. Courts are not free to reweigh the evidence and set aside the jury verdict merely because the jury could have drawn different inferences or conclusions or because judges feel that other results are more reasonable.

Id. at 35 (citations omitted).

249 *See Granfinanciera*, 492 U.S. at 51.

250 *But see* Harbor Software, Inc. v. Applied Sys., Inc., 925 F. Supp. 1042 (S.D.N.Y. 1996), where the district court in a copyright case determined which elements of a computer program were protectable as a matter of law, citing *Markman*'s holding that interpretation of patent claims is a matter of law. *See id.* at 1046.

251 *See* Markman v. Westview Instruments, Inc., 517 U.S. 370, 373 (1996).

252 *See id.*

the item described.[253] A claim, on the other hand, defines the scope of the patent, and functions to forbid both identical and similar copies of the invention.[254] The claims define the inventor's legal rights; however, all other materials in the patent and the prosecution are used as a context to help interpret the meaning of the claims.[255]

Proving patent infringement is a two-step process. First, the meaning of the patent claims must be determined. Second, the claims must be compared with the accused device to determine if all the elements or limitations in the claims are found, either literally or equivalently, in the accused device. Traditionally, the first step of construing the meaning of the patent claim has been considered a matter of law for the court. As discussed below, however, underlying disputed factual issues about the meaning of the claim have been considered issues for the jury.[256] The second step, determining whether there is infringement, has always been a matter of fact reserved for the jury.[257]

Claim construction has traditionally been considered a matter of law for the court because it involves the interpretation of written documents.[258] Since the eighteenth century, interpreting written documents has been allocated to the court largely because in the eighteenth century most jurors were illiterate.[259] But patent claim construction can be a complex affair, requiring judges, who are not necessarily familiar with the technological usages and meanings of particular "terms of art" in a given area, to hear extrinsic evidence in order to comprehend the invention and its scope.[260] Because the claims are not written for the general public, but for those skilled in the particular art, expert testimony is frequently sought to explain what the claims would mean to those skilled in the art.[261] The disputes involving the meaning of these underlying terms of art have traditionally been decided by a jury.[262] Frequently, the determination of the meaning of disputed terms of art within

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253 *See* 35 U.S.C. § 112 (1994). A person "skilled in the art" is one who is skilled in the area of science in which the invention is classified.

254 *See* HERBERT F. SCHWARTZ, FEDERAL JUDICIAL CTR., PATENT LAW & PRACTICE 11-12 (2d ed. 1995).

255 "Claim language does not exist in a vacuum; it must be understood by reference to the documents annexed to the patent grant, including the specification, of which the claims are a part, and any drawings." Markman v. Westview Instruments, Inc., 52 F.3d 967, 990 (Fed. Cir. 1995) (Mayer, J., concurring), *aff'd*, 517 U.S. 370 (1996).

256 *See infra* Part III.A.

257 *See Markman*, 517 U.S. at 377; *see also* SSIH Equip. S.A. v. United States Int'l Trade Comm'n, 718 F.2d 365, 376 (Fed. Cir. 1983).

258 *See Markman*, 52 F.3d at 978.

259 *See* Patrick Devlin, *Jury Trial of Complex Cases: English Practice at the Time of the Seventh Amendment*, 80 COLUM. L. REV. 43, 75-76 (1980); Stephen A. Weiner, *The Civil Jury Trial and the Law-Fact Distinction*, 54 CAL. L. REV. 1867, 1932 (1966).

260 A "term of art" includes one or more words having a specific meaning in an industry or field which may not be the same as the ordinary meaning of the words. *See* Argus Chem. Corp. v. Fibre Glass-Evercoat Co., 759 F.2d 10, 14 n.5 (Fed Cir. 1985).

261 *Markman*, 52 F.3d at 991 (Mayer, J., concurring).

262 *See supra* text accompanying notes 256-257; *see also* ALBERT H. WALKER, TEXTBOOK OF THE PATENT LAWS OF THE UNITED STATES OF AMERICA § 536 (4th ed. 1904) ("[W]here the question of infringement depends upon the construction of the patent, and that construction depends upon a doubtful question in the prior art, the . . . question of infringement should also be left for the jury to decide.").

the patent claim will also determine whether or not infringement has occurred.[263]

In *Markman*, the Supreme Court decided the narrow question of whether, in construing a patent claim as a matter of law, a court must send the underlying disputed issues of the meaning of terms of art to the jury, or whether these issues could or must be determined by the court.[264] The Federal Circuit,[265] in an en banc decision, had held that patent claims should be construed solely by the judge as a matter of law.[266] The Supreme Court affirmed, holding that "the construction of a patent, including terms of art within its claim, is exclusively within the province of the court."[267] The willingness of both the Federal Circuit and the Supreme Court to allow these underlying factual issues to be decided by a judge rather than a jury seems at odds with the core Seventh Amendment guarantee that the jury will decide disputed facts. To understand the background and scope of this issue, a closer look at the doctrine of construction of written documents is warranted.

A. Construing a Written Document When Underlying Facts Are Disputed

In holding that judges should construe patent claims exclusively, including the underlying factual issues pertinent to understanding the claim and meaning of terms of art used in the claim, the Federal Circuit relied on the "fundamental principle of American law" that courts construe written documents.[268] The corollary to that principle, however, is that where there are disputed underlying facts, they should be sent to the jury in a jury-tried case:

> Where the controversy over the [written instrument] arises in a case which is being tried before a jury, the decision of the question of fact is left to the jury, with instructions from the court as to how the document shall be construed, if the jury finds that the alleged peculiar meaning or usage is established.[269]

The Supreme Court has repeatedly affirmed this practice, both in a commercial context[270] and for cases where technical words or phrases are used.[271] Patent claim construction fits well within this doctrine, because extrinsic evi-

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263 "Deciding the meaning of the words used in the patent is often dispositive of the question of infringement." *Markman*, 52 F.3d at 999 (Newman, J., dissenting). Judge Mayer, in his opinion concurring in the judgment, but strongly disagreeing with the reasoning of the Federal Circuit, put it even more strongly: "[T]his is not just about claim language, it is about ejecting juries from infringement cases. 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." *Id.* at 989 (Mayer, J., concurring).

264 Markman v. Westview Instruments, Inc., 517 U.S. 370, 372 (1996).

265 Congress created the Federal Circuit as, inter alia, an exclusive appellate court for patent cases. *See* H.R. REP. No. 97-312, at 20-23 (1981).

266 *See Markman*, 52 F.3d at 977.

267 *Markman*, 517 U.S. at 372.

268 *See Markman*, 52 F.3d at 978.

269 Great N. Ry. Co. v. Merchants Elevator Co., 259 U.S. 285, 291-92 (1922).

270 *See* Rankin v. Fidelity Ins. Trust & Safe Deposit Co., 189 U.S. 242, 252-53 (1903) (holding that although "the construction of written instruments is one for the court, where the case turns upon the proper conclusions to be drawn from a series of letters, particularly of a commercial character, taken in connection with other facts and circumstances, it is one which is properly

dence frequently must be brought in to explain technological terms and terms of art within the claim.[272]

Sending to the jury disputed issues of fact underlying the construction of a written document has been widely accepted in contract law.[273] To distinguish the application of this doctrine, the Federal Circuit asserted that a patent was more like a statute than a contract.[274] In drawing this distinction, the Federal Circuit claimed that the underlying factual issues in a contract frequently concern the subjective meaning of the terms in the minds of the parties to the contract.[275] For a patent, on the other hand, the test of meaning is an objective one of what "one of ordinary skill in the art at the time of the invention would have understood the term to mean."[276] This distinction,

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referred to a jury" (citing Brown v. McGran, 39 U.S. (14 Pet.) 479, 493 (1840))). In a decision by Mr. Justice Story, the Court stated that

> there certainly are cases, in which, from the different senses of the words used, or their obscure and indeterminate reference to unexplained circumstances, the true interpretation of the language may be left to the consideration of the jury for the purpose of carrying into effect the real intention of the parties.

Brown, 39 U.S. (14 Pet.) at 493.

271 In *Great Northern Railway*, the Court stated:

> When the words of a written instrument are used in their ordinary meaning, their construction presents a question solely of law. But words are used sometimes in a peculiar meaning. Then extrinsic evidence may be necessary to determine the meaning of words appearing in the document. This is true where technical words or phrases not commonly understood are employed. Or extrinsic evidence may be necessary to establish a usage of trade or locality which attaches to provisions not expressed in the language of the instrument. Where such a situation arises, and the peculiar meaning of words, or the existence of a usage, is proved by evidence, the function of construction is necessarily preceded by the determination of the matter of fact. Where the controversy over the writing arises in a case which is being tried before a jury, the decision of the question of fact is left to the jury, with instructions from the court as to how the document shall be construed, if the jury finds that the alleged peculiar meaning or usage is established.

Great Northern Railway, 259 U.S. at 291-92.

272 *See* Moeller v. Ionetics, Inc., 794 F.2d 653, 657 (Fed. Cir. 1986) ("[A]lthough claim construction is a legal question, underlying fact disputes may arise pertaining to extrinsic evidence that might preclude summary judgment treatment of claim construction."), *overruled by Markman*, 52 F.3d at 977, 979; Palumbo v. Don-Joy Co., 762 F.2d 969, 974 (Fed. Cir. 1985) (when meaning of a claim term is disputed, "then an underlying factual question arises, and construction of the claim should be left to the trier or jury under appropriate instruction"), *overruled by Markman*, 52 F.3d at 977, 979; McGill, Inc. v. John Zink Co., 736 F.2d 666, 672 (Fed. Cir. 1984) (when meaning of a term in the claim is disputed, and extrinsic evidence needed to explain it, construction of claim is left to the jury, and the jury "cannot be directed to the disputed meaning"), *overruled by Markman*, 52 F.3d at 976, 979. These and similar cases were disapproved by the Federal Circuit in its holding in *Markman*. *See Markman*, 52 F.3d at 979.

273 *See* 3 ARTHUR LINTON CORBIN, CORBIN ON CONTRACTS § 554 (1960); 4 SAMUEL WILLISTON & WALTER H.E. JAEGER, A TREATISE ON THE LAW OF CONTRACTS: WILLISTON ON CONTRACTS § 616 (3d ed. 1961); *see also* RESTATEMENT (SECOND) OF CONTRACTS § 212(2). "A question of interpretation of an integrated agreement is to be determined by the trier of fact if it depends on the credibility of extrinsic evidence or on a choice among reasonable inferences to be drawn from extrinsic evidence." RESTATEMENT (SECOND) OF CONTRACTS § 212(2).

274 *See Markman*, 52 F.3d at 987. This argument was never discussed in the Supreme Court's decision. *See* Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996).

275 *See Markman*, 52 F.3d at 985.

276 *Id.* at 986.

however, seems questionable. In commercial documents, meaning may well need to be determined not just by the subjective intent of the parties, but in accordance with an objective view of meaning as determined by usage of trade or course of dealing.[277] Establishing that a particular word or expression in a contract had a meaning that was the common usage in a particular trade would not be subjective, and would appear to be very similar to the process of determining in a patent claim construction case what a particular term meant to one skilled in the art. In both instances, expert witnesses would probably be utilized to explain the meaning in terms of usage in a particular trade or industry.

Not only does there exist a similarity between patents and contracts with respect to determining objective meaning—there also appears to be a similarity with respect to determining subjective meaning. Although the Federal Circuit asserted in *Markman* that claim interpretation did not depend upon the intent of the patentee, the court has not always taken that position. In *Tol-O-Matic, Inc. v. Proma Produkt-Und Marketing Gesellschaft*,[278] the Federal Circuit stated that

> [i]nterpretation of the claim words "provide for lateral support" required that the jury give consideration and weight to several underlying factual questions, including in this case the description of the claimed element in the specification, *the intended meaning and usage of the claim terms by the patentee*, what transpired during the prosecution of the patent application, and the technological evidence offered by the expert witnesses.[279]

Thus, the court's attempt to distinguish patents from contracts by contrasting objective interpretations of meaning with subjective ones does not appear persuasive.

In addition, the Federal Circuit has, since its creation in 1982, followed the practice of sending underlying factual disputes on matters of claim construction to the jury. There is significant precedent to this effect, set forth quite persuasively in the concurring opinion of Judge Mayer and the dissenting opinion of Judge Newman.[280] The majority in *Markman* acknowledged "some inconsistent statements" about whether underlying issues should go to the jury in patent claim construction.[281] The court asserted, however, that there were actually two lines of cases—one which recognized that disputes over the meaning of claim language may raise factual questions for the jury,

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277 Section 1-205(2) of the Uniform Commercial Code provides that "[t]he existence and scope of . . . [trade] usage are to be proved as facts." U.C.C. § 1-205(2) (1999); *see also* Frigaliment Importing Co. v. B.N.S. Int'l Sales Corp., 190 F. Supp. 116, 119 (S.D.N Y. 1960) (considering evidence of trade usage in attempt to explain meaning of contract); Hurst v. W.J. Lake & Co., Inc. 16 P.2d 627, 629-31 (Or. 1932) (reversing trial court's grant of motion for judgment on pleadings; holding plaintiff should have been permitted to use trade usage evidence to establish meaning of contract).

278 945 F.2d 1546 (Fed. Cir. 1991), *overruled by Markman*, 52 F.3d at 979.

279 *Id.* at 1550 (emphasis added).

280 *See Markman*, 52 F.3d at 989 (Mayer, J., concurring); *id.* at 999 (Newman, J., dissenting).

281 *See id.* at 976.

and a second line of cases which said that "claim construction is strictly a question of law of the court."[282] In fact, however, there is no second line of cases. Of the five cases cited by the Federal Circuit for this proposition, only one lends even minimal support.[283] Thus, Judge Mayer was not exaggerating in his concurring opinion when he stated: "Contrary to what it says today, this court (including the judges in the majority) has always held that claim interpretation is a matter of law depending on underlying factual inquiries."[284] In a sharply worded footnote, Judge Mayer commented:

> The court pretends there is a line of contrary authority. But most of its cases arrived at this court after bench trials—a puzzling source for guidance on the commands of the Seventh Amendment; others actually implicating the right to a jury trial sprang from facts simply inadequate to support a reasonable jury verdict. Indeed, the one case that pays lip service to this novel rule, *Read Corp. v. Portec, Inc.*, like this case, did not require excursion beyond the patent documents themselves. There may be a reason why the court is hell-bent for its result, but it does not emanate from the cases.[285]

Given the doctrine requiring underlying disputed facts to go to the jury when the court construes written documents, the strong precedent in the Federal Circuit for sending these issues to the jury in appropriate cases prior to *Markman*, and the strong federal policy favoring jury trials, the Supreme Court did not have a lot to work with that would support affirming the Fed-

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282 *Id.* at 977.

283 *See id.* (citing Read Corp. v. Portec, Inc., 970 F.2d 816, 822-23 (Fed. Cir. 1992); Intellicall, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1387-88 (Fed. Cir. 1992); Unique Concepts, Inc. v. Brown, 939 F.2d 1558, 1561-63 (Fed. Cir. 1991); Senmed, Inc. v. Richard-Allan Med. Indus., Inc., 888 F.2d 815, 818-20 (Fed. Cir. 1989); Specialty Composites v. Cabot Corp., 845 F.2d 981, 986 (Fed. Cir. 1988)).

284 *Id.* at 989 (Mayer, J., concurring). Judge Mayer cited several cases as authority for this proposition. *See id.* at 989-90 (Mayer, J., concurring) (citing Arachnid Inc. v. Medalist Mktg. Corp., 972 F.2d 1300, 1302 (Fed. Cir. 1992) (stating that although claim construction is an issue of law for the court, it "may require the factfinder to resolve certain factual issues such as what occurred during the prosecution history"); Lemelson v. General Mills, Inc., 968 F.2d 1202, 1206 (Fed. Cir. 1992) (similarly noting that "underlying factual issues in dispute become the jury's province to resolve in the course of rendering its verdict on infringement"); Johnston v. IVAC Corp., 885 F.2d 1574, 1579-80 (Fed. Cir. 1989) ("A disputed issue of fact may, of course, arise in connection with interpretation of a term in a claim if there is a genuine evidentiary conflict created by the underlying probative evidence pertinent to the claim's interpretation. However, without such evidentiary conflict, claim interpretation may be resolved as an issue of law by the court . . . ." (citations omitted))).

285 *Id.* at 990 n.2 (Mayer, J., concurring) (citing *Portec*, 970 F.2d at 822-23) (additional citations omitted). The Federal Circuit also asserted that "[t]he Supreme Court has repeatedly held that the construction of a patent claim is a matter of law exclusively for the court." *Id.* at 977. Both Judge Mayer and Judge Newman pointed out the inaccuracy of this statement. Judge Mayer commented: "Close examination of these cases, however, reveals that, like the one before us today, interpretation of the claims at issue before the deciding court presented no real factual question." *Id.* at 993 (Mayer, J., concurring). Judge Newman observed that while the statement is correct when referring to the court's responsibility to decide the legal effect of a patent claim, "it is not correct with respect to findings of disputed factual issues, issues that usually relate to the meaning and scope of the technologic terms and words of technical art that define the invention." *Id.* at 1021 (Newman, J., dissenting).

eral Circuit's decision in *Markman*.[286] Nonetheless, the Supreme Court affirmed unanimously, removing from the jury disputed factual issues in claim construction, and asserting that this did not offend the Seventh Amendment.[287] To explain what might have motivated the Supreme Court to allow this reduction in the role of the jury, the next part of this Article analyzes the reasoning of the *Markman* decision in the context of the four strands of traditional Seventh Amendment jurisprudence.

B. Markman *and the Four Strands of Seventh Amendment Jurisprudence.*

Markman, the inventor of a system for monitoring and reporting upon the status, location, and movement of clothing in a dry-cleaning business, brought an infringement action against Westview Instruments, Inc. ("Westview").[288] Westview asserted that its product did not infringe Markman's patent because it recorded an inventory of receivables by tracking invoices and transaction totals, but could not track articles of clothing.[289] Markman attempted to prove infringement by showing that the term "inventory" as used in his claim could refer to cash and invoices as well as articles of clothing.[290] The U.S. District Court for the Eastern District of Pennsylvania first sent the issue of claim construction to the jury, which found in Markman's favor on two of the claims.[291] Nonetheless, the district court granted Westview judgment as a matter of law.[292] Under the district court's construction of the patent claim, Westview's system did not infringe the patent because it could not track articles of clothing through the process and generate reports about their status and location.[293] In essence, the district court interpreted the meaning of "inventory" differently than the jury. In affirming the district court's decision, the Federal Circuit held en banc that the interpretation of the terms of a patent claim was a matter exclusively for the court, and that this conclusion was consistent with the Seventh Amendment.[294]

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286 *See* Parklane Hosiery Co. v. Shore, 439 U.S. 322, 351 (1979) (Rehnquist, J., dissenting). Justice Rehnquist, in his dissent, stated that "use of offensive collateral estoppel in this case runs counter to the strong federal policy favoring jury trials," and noted that the Court's decision in *Beacon Theatres* "exemplifies that policy." *Id.* (Rehnquist, J., dissenting). Justice Rehnquist also recalled:

> "The right of jury trial in civil cases at common law is a basic and fundamental feature of our system of federal jurisprudence which is protected by the Seventh Amendment. A right so fundamental and sacred to the citizen, whether guaranteed by the Constitution or provided by statute, should be jealously guarded by the courts."

Id. at 352 (Rehnquist, J., dissenting) (quoting Jacob v. New York, 315 U.S. 752, 752-53 (1942)); *see* Byrd v. Blue Ridge Rural Elec. Coop., Inc., 356 U.S. 525, 537-39 (1958).

287 *See* Markman v. Westview Instruments, Inc., 517 U.S. 370, 391 (1996).

288 *See id.* at 374-75.

289 *See id.* at 375.

290 *See id.*

291 *See* Markman v. Westview Instruments, Inc., 52 F.3d 967, 973 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. at 391.

292 *See id.* at 971.

293 *See* Markman v. Westview Instruments, Inc., 772 F. Supp. 1535, 1537 (E.D. Pa. 1991), *aff'd*, 52 F.3d at 989, *aff'd*, 517 U.S. at 391.

294 *See Markman*, 52 F.3d at 984.

The Supreme Court, affirming the Federal Circuit's decision, discussed both the applicability of the Seventh Amendment and the policy reasons for allocating the determination of meaning of disputed terms of art in a patent claim to the judge rather than to the jury. While the facts of *Markman* are rather straightforward, the Supreme Court's reasoning is somewhat less so. The following parts examine how the Supreme Court's decision in *Markman* compares with each of the four strands of Seventh Amendment jurisprudence.

1. The Historical Test

In beginning the analysis of the Seventh Amendment's applicability to patent claim construction, Justice Souter asserted that the Court was following the long established practice, dating back to the *Wonson* decision in 1812, of determining the right to a jury trial in accordance with "'the right which existed under the English common law when the Amendment was adopted.'"[295] After asserting that the Court's decision was "[i]n keeping with [its] long-standing adherence to this 'historical test,'" Justice Souter then set forth a new and unfamiliar version of that test.[296] The test had two prongs: the first was the same as the first prong of the accepted historical test, which looked to whether the action was tried at law in 1791.[297] The second prong, however, did not look to the remedy sought, but instead contained a concept new to Seventh Amendment jurisprudence:

> In keeping with our longstanding adherence to this "historical test," we ask, first, whether we are dealing with a cause of action that either was tried at law at the time of the founding or is at least analogous to one that was. If the action in question belongs in the law category, we then ask whether the particular trial decision must fall to the jury in order to preserve the substance of the common-law right as it existed in 1791.[298]

Prior to *Markman*, the Court had never extracted a subsidiary issue from within a cause of action to determine if it alone had an historical analogue. This approach could greatly enlarge what the Court has previously referred to as an "abstruse historical inquiry,"[299] and lead to a narrowing of the right to a jury trial.

In applying the first prong of the traditional historical test—examining the nature of the action—Justice Souter easily determined that a patent infringement action was an action at law: "[T]here is no dispute that infringement cases today must be tried to a jury, as their predecessors were more

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295 *Markman*, 517 U.S. at 376 (quoting Baltimore & Carolina Line, Inc. v. Redman, 295 U.S. 654, 657 (1935)). As discussed *supra* notes 24-46 and accompanying text, the historical test described by Justice Souter is actually of more recent vintage, having first been fully formulated in 1935. The *Wonson* decision dealt only with the Re-Examination Clause of the Seventh Amendment, and not with the Right to Jury Trial Clause. *See supra* note 31 and accompanying text.

296 *Markman*, 517 U.S. at 376.

297 *See id.*

298 *Id.* (citations omitted).

299 Ross v. Bernhard, 396 U.S. 531, 538 n.10 (1970).

than two centuries ago."[300] The Court did not consider the second prong of the historical test—the more important remedy prong—apparently because the first prong had already answered the question that an infringement action was entitled to a jury trial. Thus, the first part of the analysis in *Markman* appears reasonably consistent with the first strand of traditional Seventh Amendment jurisprudence—the question of whether a cause of action is entitled to a jury trial is determined by whether it was "tried at law at the time of the founding," or is analogous to an action tried at law at that time.[301]

In the typical application of the historical test, if the right to a jury trial is so clear that the remedy prong of the historical test need not even be considered, this would end the inquiry. Once the Court has determined that the case is one that has a jury trial right, all disputed factual issues are determined by the jury.[302] The only time the Court has engaged in parsing issues is when equitable and legal issues have been joined in the same action,[303] or when a claim consists of two discrete issues that would normally be brought as two claims.[304] None of these cases involved subsidiary issues important to the ultimate determination of an action at law.

Justice Souter, however, did not conclude his analysis with the determination that the infringement action brought by Markman had a jury trial right. Instead, he proceeded to the novel prong of his test, discussed below—"whether a particular issue occurring within a jury trial (here the construction of a patent claim) is itself necessarily a jury issue."[305]

2. *The Substance of the Right to a Jury Trial*

The *Markman* analysis stands at odds with the second strand of Seventh Amendment jurisprudence, which requires the maintenance of the substance of the jury trial right even though changes may occur in procedures and practices. Justice Souter attempted to fit his analysis within existing Seventh Amendment jurisprudence by framing the second prong of his test as "whether the particular trial decision must fall to the jury in order to preserve

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300 *Markman*, 517 U.S. at 377; *see* Tull v. United States, 481 U.S. 412, 417 (1987) ("To determine whether a statutory action is more similar to cases that were tried in courts of law than to suits tried in courts of equity or admiralty, the Court must examine both the nature of the action and of the remedy sought. First, we compare the statutory action to 18th-century actions brought in the courts of England prior to the merger of the courts of law and equity.").

301 *Markman*, 517 U.S. at 376.

302 There are some exceptions, of course. For example, in addition to the general rule that courts alone construe written documents, courts also construe statutes, determine foreign law, and decide jurisdictional questions. For discussions of the fact/law distinction, see generally Francis H. Bohlen, *Mixed Questions of Law and Fact*, 72 U. PA. L. REV. 111 (1924), James B. Thayer, *"Law and Fact" in Jury Trials*, 4 HARV. L. REV. 147 (1890), and Weiner, *supra* note 259.

303 *See* Dairy Queen, Inc. v. Wood, 369 U.S. 469, 470-73 (1962); Beacon Theatres, Inc. v. Westover, 359 U.S. 500, 506-11 (1958).

304 *See* Chauffeurs, Teamsters & Helpers Local No. 391 v. Terry, 494 U.S. 558, 569 n.6 (1990) ("The question whether the Seventh Amendment analysis requires an examination of the nature of each element of a typical claim is not presented by this case. The claim we confront here is not typical; instead, it is a claim consisting of discrete issues that would normally be brought as two claims, one against the employer and one against the union.").

305 *Markman*, 517 U.S. at 377.

the substance of the common-law right as it existed in 1791."[306] The words—"preserve the substance of the common-law right"—tend to suggest that this test fits within the second strand of traditional Seventh Amendment jurisprudence. The limitation—"as it existed in 1791"—is, however, a complete turnabout from the traditional approach used for the last century to preserve the substance of the common law right. As discussed earlier in Part II, the Supreme Court has frequently maintained that the aim of the Seventh Amendment is not to preserve those matters of form and procedure that existed in 1791, but only the substance of the right, which it has repeatedly defined as the jury's fact-finding function.[307]

In *Markman*, Justice Souter turned this traditional analysis on its head by declaring that the substance to be preserved was only what existed in 1791.[308] Instead of taking the position that practices that have an effect on the jury could be freely changed and adapted as long as the jury's fact-finding role is preserved, Justice Souter returned to a highly formalistic approach. He said that unless a specific subsidiary issue within a cause of action (or its analogue) was decided by the jury in 1791, there was no Seventh Amendment guarantee of a jury trial on that subsidiary issue.[309] In other words, instead of adapting jury practices to present times while preserving the substance, Justice Souter stated that 1791 practices will determine if sending a particular subsidiary issue to the jury was part of "the substance" of the jury trial right. According to Justice Souter, if proof of the subsidiary issue going to the jury in 1791 is not found, then there is no Seventh Amendment guarantee of a jury trial for that issue.[310] This is at odds with prior cases which have considered modern practices and procedures as *not* limited by 1791 practices and procedures, as long as the jury's fact-finding role is preserved.[311]

An examination of the difference between the traditional view of the substance of the jury trial right and the *Markman* view follows. This difference goes to the core of the Seventh Amendment guarantee: how do we define the substance of the right which must be preserved?

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306 *Id.* at 376.

307 A good summary of this position is found in the four Justice dissent in *Dimick v. Schiedt*:

> [T]his Court has often refused to construe [the Seventh Amendment] as intended to perpetuate in changeless form the *minutiae* of trial practice as it existed in the English courts in 1791. . . . [T]he Seventh Amendment guarantees that suitors in actions at law shall have the benefits of trial of issues of fact by a jury, but it does not prescribe any particular procedure by which these benefits shall be obtained, *or forbid any which does not curtail the function of the jury to decide questions of fact*
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> . . . .

Dimick v. Schiedt, 293 U.S. 474, 490-91 (1935) (Hughes, Brandeis, Stone, and Cardozo, JJ., dissenting) (emphasis added). Justice Stone then listed a number of novel jury practices, not known to the common law, which had been approved by the Court, and concluded: "[b]ut this Court has found in the Seventh Amendment no bar to the adoption by the federal courts of these novel methods . . . *for they left unimpaired the function of the jury, to decide issues of fact.*" *Id.* at 492 (Hughes, Brandeis, Stone, and Cardozo, JJ., dissenting) (emphasis added).

308 *See Markman*, 517 U.S. at 377-78.

309 *See id.*

310 *See id.*

311 *See supra* Parts II.C and II.D.

a. Difference Between Issues and Practices

In the previously cited line of cases which deal with preserving the "substance" of the jury trial guarantee,[312] the changes approved by the Court with regard to the jury trial were changes in practices or procedures, including, for example, changes related to directed verdicts,[313] summary judgment,[314] the number of jurors,[315] the use of auditors,[316] partial new trials,[317] and setting aside general verdicts and directing verdicts for a defendant on facts specially found.[318] None of these cases dealt with a subsidiary trial issue within a cause of action where a jury trial right was guaranteed. With respect to subsidiary trial issues, judges were expected to be able to tell the difference between issues of fact and law, and send the disputed factual issues to the jury.[319]

In *Markman*, Justice Souter referred to "construing a term of art following receipt of evidence" as a "mongrel practice."[320] By "mongrel," Justice Souter appeared to mean "mixed," such as a mixed breed instead of a pure breed. The reference could mean mixed in the sense of mixed issues of law and fact, because the interpretation of patent claims is generally considered a matter of law for the court, while the underlying factual issues have traditionally been decided by the jury when they are disputed and extrinsic evidence is introduced to explain meaning. Thus, although Justice Souter refers to a "mongrel *practice*," the focus is on a specific subsidiary trial issue, not on a general trial practice such as a granting of summary judgment or judgment as a matter of law.

Justice Souter noted that the question in *Markman* was "whether a particular issue occurring within a jury trial (here the construction of a patent claim) is itself necessarily a jury issue."[321] By framing the issue in this manner, Justice Souter has changed the analysis. A traditional analysis would have sorted out the factual issues from the legal issues in a "mongrel practice," so that the factual issues could be sent to the jury. As discussed below, however, the Court in *Markman* held that even though the issue was a factual one, and was a subsidiary issue within a cause of action that carried a jury trial right, the issue nonetheless was to be viewed through the prism of his-

312 *See supra* note 248.

313 *See* Galloway v. United States, 319 U.S. 372, 395-96 (1943).

314 *See* Fidelity & Deposit Co. v. United States, 187 U.S. 315, 319-21 (1902).

315 *See* Colgrove v. Battin, 413 U.S. 149, 158-60 (1973).

316 *See Ex parte* Peterson, 253 U.S. 300, 309-10 (1920).

317 *See* Gasoline Prods. Co. v. Champlin Ref. Co., 283 U.S. 494, 498-99 (1931).

318 *See* Walker v. New Mexico & S. Pac. R.R. Co., 165 U.S. 593, 596-98 (1897).

319 This is not to say that fact/law distinctions are always clear and certain. Numerous sources have discussed this subject. *See* Douglas G. Baird, *Bankruptcy Procedure and State-Created Rights: The Lesson of* Gibbons *and* Marathon, 1982 SUP. CT. REV. 25, 44; David P. Currie, *Bankruptcy Judges and the Independent Judiciary*, 16 CREIGHTON L. REV. 441, 452 (1983); S. Elizabeth Gibson, *Jury Trials in Bankruptcy: Obeying the Commands of Article III and the Seventh Amendment*, 72 MINN. L. REV. 967, 1041 n.347 (1988). In most cases, however, judges have a fairly good sense of what issues should go to the jury. Prior to *Markman*, judges in patent cases regularly sent issues of disputed terms of art in patent claims to the jury. *See supra* notes 272, 280-285 and accompanying text.

320 Markman v. Westview Instruments, Inc., 517 U.S. 370, 378 (1996).

321 *Id.* at 377.

tory to determine if it *must* be heard by the jury.[322] This represents a substantial departure from traditional Seventh Amendment jurisprudence, and raises a number of problems discussed below.

b. Historical Analogy for Subsidiary Issue

Having framed the question as one requiring a determination of whether the individual issue within a cause of action *must* be heard by the jury in order to preserve the substance of the common law right, Justice Souter then asserted that the "'substance of the common-law right' is . . . a pretty blunt instrument for drawing distinctions."[323] He also stated that the Court has tried to "sharpen" this instrument by referring to distinctions of substance and procedure, or issues of fact and law.[324] Justice Souter then declared that "the sounder course, when available, is to classify a mongrel practice (like construing a term of art following receipt of evidence) by using the historical method, much as we do in characterizing the suits and actions within which they arise."[325] Thus, at least for a "mongrel practice," the definition of the "substance" of the jury trial right appears to have changed. According to Justice Souter's analysis, this "substance" now consists of whether the subsidiary issue had a jury trial right in 1791, or whether an analogous issue had such a right.

If not limited, this revised definition of the "substance" of the common law right which is preserved by the Seventh Amendment could have an enormous impact on the role of juries. The broadest interpretation of this definition would permit any subsidiary issue to be decided by the judge as a matter of law in any case in which parties could not establish that such issue went to the jury in 1791. Such an interpretation could greatly expand litigation over whether particular issues had a jury trial right in 1791. As discussed in Part IV, however, this result does not appear to be the intent of the Court.

c. Problems with the Markman *Definition of the "Substance of the Common Law Right"*

Markman's revised definition of "substance of the common-law right"[326] is contrary to the second strand of Seventh Amendment jurisprudence. Essentially, Justice Souter said the substance of the common law right consisted of preserving for the jury only those subsidiary issues that were jury issues in 1791. The strand of Seventh Amendment jurisprudence dealing with the substance of the common law right, however, has never held that the practices and procedures of 1791 provide the substance of the jury trial right. To the contrary, the Court has noted the importance of *changing* and *adapting* such practices to present times. It is difficult to reconcile the Court's traditional jurisprudence holding that practices and procedures from 1791 should not

322 *See id.* at 378.

323 *Id.* (quoting Tull v. United States, 481 U.S. 412, 426 (1987) (quoting Colgrove v. Battin, 413 U.S. 149, 157 (1973))).

324 *See id.*

325 *Id.*

326 *See id.*

limit current practices and procedures, as long as the fact-finding function of the jury is not impeded, with the *Markman* view that 1791 jury issues will determine whether a subsidiary issue *must* go to the jury.

A second problem with the analysis in *Markman* is that it places a heavy burden on the party who seeks a jury trial, because that party must prove that the issue went to the jury in 1791. In some instances, including certain patent claims constructions, once the court decides the subsidiary issue, the case will effectively be decided, thereby essentially removing the case from the jury.[327] In contrast, the traditional historical test for determining if a *cause of action* was entitled to a jury trial imposed a much lighter burden. A party who asserted a jury trial right yet could not locate an appropriate 1791 analogue, could nonetheless assert on the basis of the *remedy* sought that the action was one which carried a jury trial right. Unlike the case-in-chief, the subsidiary issue is divorced from the question of remedy and has no such safe harbor. A judge using the *Markman* analysis, if not satisfied that the subsidiary issue or any analogous issue went to the jury in 1791, could take the issue from the jury and decide it as a matter of law, regardless of its factual nature.

This raises the third major problem with the *Markman* analysis. Not only is the historical determination of a jury right for a subsidiary issue divorced from the all-important remedy prong of the traditional historical test, but also the "substance of the common-law right" appears in *Markman* to be divorced from the all-important requirement of preserving the jury's fact-finding role. To the extent that this primary function of the jury loses significance, the effectiveness of the Seventh Amendment's guarantee will similarly decline. If judges are not limited by a fact/law distinction, they will be able to allocate to themselves factual issues for whatever reason they choose, if it cannot be proved that a particular issue (or its analogue) went to the jury in 1791.

The above discussion is based on the broadest possible interpretation of the *Markman* decision. In fact, however, there are strong indications that the Court did not intend to radically change its traditional Seventh Amendment jurisprudence. First, the *Markman* analysis only discussed using the historical test for a subsidiary issue when it was a "mongrel practice," that is, a subsidiary issue which has elements of both fact and law. Presumably, if the subsidiary issue was clearly a fact issue or a legal issue, it would be allocated to the jury or the judge respectively, without the need to engage in a separate historical inquiry. Second, as discussed in Part IV, the reasoning in *Markman* appears in large measure to be limited to the patent area. Third, the recent Supreme Court decision of *City of Monterey v. Del Monte Dunes*,[328] discussed in Part V, appears to reaffirm the primacy of the jury's fact-finding role.

The Court in *Markman* clearly decided *not* to preserve the jury's role in patent claim construction. The Court's unwillingness to do so is contrasted in the next part with its protection and enlargement of the jury's role under the

327 *See supra* note 263 and accompanying text.

328 119 S. Ct. 1624 (1999).

third strand of Seventh Amendment jurisprudence, which dealt with the jury trial right after the merger of law and equity.

3. Merger of Law and Equity

No one argues that any issue in *Markman* is an equitable one. The reason for considering the third strand of Seventh Amendment jurisprudence is simply to compare the Court's concern for preserving the jury trial right for factual issues common to both legal and equitable claims raised in the same action, with its lack of concern for preserving the right in *Markman.* The reasons for the Court's willingness to take factual issues from the jury is then examined in connection with the fourth strand, deference to a congressional statutory scheme involving public rights.

In terms of a comparison, it is clear that if the Court *were* dealing with both an equitable issue and a legal issue in *Markman*, the right to a jury trial would be preserved for all factual issues common to both claims.[329] In *Markman,* however, the Court determined to take from the jury and allocate exclusively to the trial judge a subsidiary issue that was part of an action at law. Thus, the judge may determine as a matter of law disputed factual issues concerning the meaning of a term of art in a patent claim, including weighing evidence and determining the credibility of experts skilled in the art. In many cases, the determination of these issues will effectively decide the ultimate issue of whether infringement has occurred, thereby completely denying a jury trial.[330] This runs counter to the principled interpretation the Court used when legal and equitable issues were joined in the same action: when there is an adequate remedy at law, so that equitable issues do not need to be tried first, the jury trial right for common issues of fact must be preserved.[331]

What seems missing in *Markman* is a concern for the preservation of the jury trial right. In *Beacon Theatres*, the Court preserved the jury trial right for "legal" issues by measuring adequacy of remedy in light of modern conditions, not those of 1791.[332] The *Beacon Theatres* Court also observed that "'any seeming curtailment of the right to a jury trial should be scrutinized with the utmost care.'"[333] In *Markman*, on the other hand, it was the right itself that was being scrutinized, not the curtailment of the right.

The Court's willingness to eliminate the jury's role in patent claims construction, while appearing inconsistent with its strong protection of the jury's role vis a vis issues common to both legal and equitable claims, can perhaps be explained in part by other concerns raised by the Court in *Markman.*[334] The apparent change in the Court's attitude toward the jury in *Markman* may also be explained by considering the Court's deference to a congressional

329 *See supra* notes 181-195 and accompanying text discussing *Beacon Theatres, Inc. v. Westover.*

330 In many cases, deciding the meaning of the claim will also determine the ultimate issue of infringement. *See supra* note 263 and accompanying text.

331 *See* Beacon Theatres, Inc. v. Westover, 359 U.S. 501, 508-11 (1959).

332 *See id.* at 506-07.

333 *Id.* at 501 (quoting Dimick v. Schiedt, 293 U.S. 474, 486 (1935)).

334 *See supra* Part III.B.2.c.

statutory scheme involving public rights, and by its deference to the Federal Circuit.

4. Deference to a Congressional Statutory Scheme

The fourth strand of Seventh Amendment jurisprudence developed by the Court, that Congress can create a new statutory scheme involving public rights and provide for adjudication without juries in a non-Article III forum, does not appear, at least at first blush, to be pertinent to the *Markman* decision.[335] In some ways, however, it is highly relevant to understanding the result reached in *Markman*.

After *Atlas Roofing* and *Granfinanciera*, the Court's "historical" test took on a third prong, which looked to the forum in which the dispute would be resolved:

> If, on balance, these two factors [historical analogue and remedy] indicate that a party is entitled to a jury trial under the Seventh Amendment, we must decide whether Congress may assign and has assigned resolution of the relevant claim to a non-Article III adjudicative body that does not use a jury as factfinder.[336]

The federal district and appellate courts are, of course, Article III courts. On that ground alone the exception the Court has carved out for removing juries from a non-Article III forum does not appear to apply. The Court's lack of concern for preserving the jury trial right in *Markman*, however, may be related to the fact that the patent law area appears to share certain characteristics with some of Congress's other statutory schemes involving public rights. The Constitution specifically delegates to Congress the right to establish and regulate patents, and Congress has in fact created an elaborate regulatory scheme to govern patents.[337] Patent law is entirely federal, and Congress created the Federal Circuit as a specialized forum to hear, inter alia, all patent appeals from district courts.[338] A high degree of federal regulation is also evidenced by the fact that to practice before the United States Patent and Trademark Office ("PTO"), all patent attorneys and patent

335 The Court made clear in *Granfinanciera* that an action that involved a private, pre-existing common law right could not be denied a jury trial right. *See* Granfinanciera, S.A. v. Nordberg, 492 U.S. 33, 54-55 (1989).

336 *Id.* at 42.

337 *See* U.S. CONST. art. I, § 8, cl. 8. This provision grants Congress the right "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." *Id.*; *see also* 35 U.S.C. §§ 1-375 (1994 & Supp. III 1998).

338 Congress created the Federal Circuit in 1982 through the merger of the Court of Claims and the Court of Customs and Patent Appeals. *See* Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, §§ 127, 163, 1982 U.S.C.C.A.N. (96 Stat.) 25, 37, 49 (codified at 28 U.S.C. § 1295 (1994), and 35 U.S.C. § 141 (1994)); H.R. REP. No. 97-312, at 16-17 (1981). Patent appeals from all district court decisions are heard by the Federal Circuit. The Federal Circuit also has jurisdiction over appeals in a number of other areas, including trademark decisions of the Patent and Trademark Office, and final decisions of the Court of International Trade. *See* Rochelle Cooper Dreyfuss, *The Federal Circuit: A Case Study in Specialized Courts*, 64 N.Y.U. L. REV. 1, 4 (1989) (discussing the first five years of the Federal Circuit's operation, and whether it has achieved greater unity and coherence in patent law).

agents must pass an examination regarding the patent system, and be registered with the PTO.[339] Thus, patent law, having a number of unique, federally imposed features, more closely resembles federally regulated areas like bankruptcy or OSHA, than essentially private rights areas such as contracts, torts, or property.[340] As discussed below, the Court's deference to the congressional statutory scheme involving patents, and particularly to Congress's goal of seeking uniformity in patent interpretation, may have influenced the decision in *Markman*.

In the Federal Circuit's decision in *Markman*, Judge Mayer, concurring, suggested that certain Federal Circuit judges were engaged in a movement to eliminate all juries in patent cases, and to remove patent disputes to non-Article III courts:

> [T]oday's action is of a piece with a broader bid afoot to essentially banish juries from patent cases altogether. . . . Indeed, this movement would vest authority over patent disputes in legislative courts, unconstrained by Article III and the Seventh Amendment. *See In re Lockwood*, 50 F.3d 966, 970 (Fed. Cir. 1995) (opinion dissenting from order denying rehearing in banc) ("A constitutional jury right to determine validity of a patent does not attach to this public grant. Congress could place the issue of validity entirely in the hands of an Article I trial court with particular expertise if it chose to do so."). . . . [S]everal judges of the court have already advised that they are aboard this campaign.[341]

Judge Mayer referred to a dissent by Judge Nies, in which two other judges joined, opposing the Federal Circuit's denial of a rehearing en banc on the grant of a mandamus petition directing the district court to reinstate plaintiff Lockwood's jury demand.[342] Lockwood had brought an infringement action against American Airlines's computerized reservation system, for violating two of Lockwood's patents.[343] American raised patent invalidity as a defense, and counterclaimed for a declaration that its activities were non-infringing, and alternatively, that Lockwood's patents were invalid.[344] The

339 *See* 35 U.S.C. § 31 (1994); 37 C.F.R. § 10.1—10.170 (1999).

340 The Occupational Safety and Health Act of 1970, 29 U.S.C. §§ 651-678 (1994 & Supp. III 1998), is a federal statute which created a statutory duty to rid the workplace of unhealthy or unsafe working conditions. It permitted the federal government, proceeding before an administrative agency, to obtain abatement orders and impose civil penalties on any employer maintaining unsafe working conditions. In *Atlas Roofing Co. v. Occupational Safety and Health Review Commission*, 430 U.S. 442 (1977), the Supreme Court found the Seventh Amendment was not violated by the denial of a jury trial in these enforcement proceedings. *Id.* at 460-61.

341 Markman v. Westview Instruments, Inc., 52 F.3d 967, 989 (Fed. Cir. 1995) (Mayer, J., concurring) (quoting *In re* Lockwood, 50 F.3d 966, 983 (Fed. Cir. 1995) (Archer, C.J., Nies & Plager, JJ., dissenting), *vacated sub nom.* American Airlines, Inc. v. Lockwood, 515 U.S. 1182 (1995)), *aff'd*, 517 U.S. 370 (1996). Judge Mayer concurred in the judgment, but objected to the Federal Circuit's view that patent claims should be construed exclusively by the court. *See id.* at 989-90.

342 *See In re Lockwood*, 50 F.3d at 980-81 (Archer, C.J., Nies & Plager, JJ., dissenting).

343 *See id.* at 968. Because Lockwood ultimately withdrew his demand for a jury trial, the Supreme Court's decision to vacate the Federal Circuit order was probably a result of finding the issue moot.

344 *See id.*

district court granted summary judgment to American on its claim of non-infringement, refused Lockwood an interlocutory appeal, and struck Lockwood's demand that the issue of validity of his patents be tried to a jury.[345] In granting a rehearing on the prior grant of Lockwood's mandamus petition, the Federal Circuit determined that even though the question of patent validity was a matter of law for the court, there was a right to a jury trial on the underlying factual questions relating to patent validity.[346]

It is in this context that Judge Nies strongly asserted that patents were public rights,[347] and that "[a] constitutional jury right to determine validity of a patent does not attach to this public grant."[348] Although Judge Nies's discussion was focused on the issue of patent validity, her argument, taken to its logical conclusion, could virtually eliminate jury trials in patent cases. Because in her view, the patent grant involves a public right, and "Supreme Court precedent holds that the Seventh Amendment does not apply to public rights determinations,"[349] then Congress arguably could assign patent infringement and validity cases to a specialized Article I forum and eliminate jury trials altogether.[350]

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345 *See id.* at 968-69.

346 *See id.* at 972, 976, 980.

347 "This court has held that the issue of validity of a patent involves *public rights*, not merely *private rights*. '[T]he grant of a valid patent is primarily a public concern.'" *Id.* at 981 (Archer, C.J., Nies & Plager, JJ., dissenting) (quoting Patlex Corp. v. Mossinghoff, 758 F.2d 594, 604 (Fed. Cir. 1985)). It is not altogether clear, however, that a patent involves primarily a public right rather than a private one, because the rights granted in the patent are to a private patent holder. Nor is it clear that Congress could simply relabel a patent infringement action as one for a non-jury administrative adjudication without running afoul of the Seventh Amendment. In *Granfinanciera* the Court said, "Congress cannot eliminate a party's Seventh Amendment right to a jury trial merely by relabeling the cause of action to which it attaches and placing exclusive jurisdiction in an administrative agency or a specialized court of equity." Granfinanciera, S.A. v. Nordberg, 492 U.S. 33, 61 (1988). The question is whether Congress created "'a new cause of action, and remedies therefor, unknown to the common law,' because traditional rights and remedies were inadequate to cope with a manifest public problem." *Id.* (quoting Atlas Roofing Co. v. Occupational Safety & Health Review Comm'n, 430 U.S. 442, 461 (1977)). While patent law has long been a creature of statute, the jury trial right in a patent case derives from common law and the guarantee of the Seventh Amendment. *See* Gregory D. Leibold, Comment, *In Juries We Do Not Trust: Appellate Review of Patent-Infringement Litigation*, 67 U. COLO. L. REV. 623, 628 (1996); Greg J. Michelson, Note, *Did the* Markman *Court Ignore Fact, Substance, and the Spirit of the Constitution in its Rush Toward Uniformity?*, 30 LOY. L.A. L. REV. 1707, 1714 (1997).

348 *In re Lockwood*, 50 F.3d at 983 (Archer, C.J., Nies & Plager, JJ., dissenting). In addition, in a foreshadowing of the *Markman* decision, Judge Nies declared that when an issue is an issue of law, the underlying factual issues should be decided by the court. *See id.* at 987-89 (Archer, C.J., Nies & Plager, JJ., dissenting). In *Lockwood* the legal issue was patent validity; in *Markman* it was claim construction. Each had underlying factual issues. Judge Nies asserted that validity was a matter which affected the public, and for policy reasons favoring reasoned and uniform decisions, the identification and resolution of underlying facts should be made by the judge. *See id.* (Archer, C.J., Nies & Plager, JJ., dissenting).

349 *Id.* (Archer, C.J., Nies & Plager, JJ., dissenting).

350 Leibold suggests that in light of the tremendous power entrusted to a trial judge since *Markman*, specialized Article I courts for patent infringement cases might be a good idea. "[I]t would be wise to follow the lead of the bankruptcy courts and ensure that a trial judge who is well versed in the law and subject matter of patents conducts the trial." Leibold, *supra* note 347, at 648. Leibold suggests that an even more effective solution, however, would be for Congress to

Although the Supreme Court in *Markman* did not explicitly mention "public rights" as a reason for not applying the Seventh Amendment guarantee, the decision did note that Congress has created a special forum for patent appeals out of concern for increasing the uniformity necessary to promote public interest in growth and industrial innovation.[351] This desire for uniformity in the patent area appeared to be quite important to some of the Justices during the oral argument in *Markman*.[352] Moreover, Justice Souter explained that "the importance of uniformity in the treatment of a given patent [is] an independent reason to allocate all issues of construction to the court."[353] He noted three reasons why the limits of a patent must be known: "'for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public.'"[354] Otherwise, Justice Souter declared, "'a zone of uncertainty . . . would discourage invention'"[355] and the "'public [would] be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights.'"[356] The underlying assumption, of course, is that there will be greater uniformity if judges rather than juries construe patent claims, and if the Federal Circuit has de novo review of all such constructions.

The Supreme Court's deference to the federally established patent system is particularly evident in its deference towards the Federal Circuit. Commentators have asserted that until recently, the Supreme Court was loath to hear patent cases unless the cases focused upon issues other than patent doctrine.[357] The Court particularly preferred to leave issues involving technology to Federal Circuit judges, who had a high level of skill in this area as well as the assistance of a staff of individuals specially trained in science and technology.[358] As a court having specialized subject matter jurisdiction, the Federal Circuit possesses concentrated power, augmented by the Supreme Court's reluctance to grant certiorari in patent cases.[359] In many instances,

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override the Supreme Court's decision in *Markman*, and then authorize the use of "special juries" of highly educated individuals to decide factual issues in patent cases. *See id.* at 648-49.

351 *See* Markman v. Westview Instruments, Inc., 517 U.S. 370, 390-91 (1996); *see also* Dreyfuss, *supra* note 338, at 7 ("According to proponents of the legislation, channeling patent cases into a single appellate forum would create a stable, uniform law and would eliminate forum shopping.").

352 *See* Official Transcript of the Supreme Court of the United States at 33, Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996) (No. 95-26).

353 *Markman*, 517 U.S. at 390.

354 *Id.* (quoting General Elec. Co. v. Wabash Appliance Corp., 304 U.S. 364, 369 (1938)).

355 *Id.* (quoting United Carbon Co. v. Binney & Smith Co., 317 U.S. 228, 236 (1942)).

356 *Id.* (quoting Merrill v. Yeomans, 94 U.S. 568, 573 (1877)).

357 *See* Thomas K. Landry, *Certainty and Discretion in Patent Law: The On Sale Bar, the Doctrine of Equivalents, and Judicial Power in the Federal Circuit*, 67 S. CAL. L. REV. 1151, 1153 n.8 (1994).

358 In *Cardinal Chemical Co. v. Morton International, Inc.*, 508 U.S. 83, 105 (1993), Justices Scalia and Souter made known their preference for deferring to the Federal Circuit's expertise. They declined to join in a part of the majority opinion which concerned "practicalities of the Federal Circuit's specialized patent jurisdiction," preferring instead to accept the views of "the experienced judges on the Federal Circuit." *Id.* at 105 (Scalia & Souter, JJ., concurring).

359 *See* Landry, *supra* note 357, at 1204.

therefore, the Federal Circuit has become the court of last resort in patent cases.[360]

While the Supreme Court is clearly deferential to the technical expertise and credentials of the Federal Circuit, there is doubtless also a tendency to defer to its administrative expertise in managing the patent system.[361] Thus, although the issue the Court decided in *Markman* was primarily a Seventh Amendment issue, the Court may well have viewed it as affecting the Federal Circuit's ability to manage the patent system, and been willing to defer to the Federal Circuit on that basis.[362] Thomas Landry asserts that "[t]he Supreme Court's laissez-faire attitude has allowed the [Federal Circuit] to act like an independent agency within the judicial branch," and that "[j]ust as independent agencies perform specialized executive functions with only marginal accountability to the seat of executive power (the President), the [Federal Circuit] performs specialized judicial functions with only marginal accountability to the seat of judicial power (the Supreme Court)."[363]

In *Markman*, the Supreme Court gave the eight-judge majority in the Federal Circuit decision exactly what it wanted: de novo review over patent claims construed exclusively by judges. De novo review is the proper standard of review for questions of law. Since construction of patent claims was determined to be entirely a matter of law, which therefore excluded underlying factual claims from the jury, any patent claim construed by any district court in the country could be construed again by a Federal Circuit panel without any deference to either the jury or the trial judge as finder of fact.[364] Providing that the trial judge would construe claims in their entirety as a matter of law (with de novo review by the Federal Circuit) would, according

360 *See* David Silverstein, *Patents, Science and Innovation: Historical Linkages and Implications for Global Technological Competitiveness*, 17 RUTGERS COMPUTER & TECH. L.J. 261, 310 (1991) ("An overburdened Supreme Court, routinely refusing to review patent cases, made it inevitable that the [Federal Circuit] would wield far more power than many supporters of this change had anticipated. For all practical purposes, the [Federal Circuit] has become the 'court of last resort' in patent cases, and its holdings the 'law of the land.'").

361 *See* Landry, *supra* note 357, at 1208-10.

362 There has been a substantial increase in the number of jury trials in patent cases. *See* Allan N. Littman, *The Jury's Role in Determining Key Issues in Patent Cases:* Markman, Hilton Davis, *and Beyond*, 37 IDEA 207, 209 (1997) (noting that juries were used in about 21% of patent cases in 1981, increasing to 70% of patent cases by 1994 (citing ADMINISTRATIVE OFFICE OF THE U.S. COURTS, REPORTS OF THE PROCEEDINGS OF THE JUDICIAL CONFERENCE OF THE UNITED STATES A1-79 tbl.C-4 (1994) (finding juries used in 71% of patent cases in 1994))). This trend is expected to be reversed after *Markman*. Predictions have been made that *Markman* may cause "'"[a]s many as 90 percent of [patent] cases [to] be decided on a motion for summary judgment."'" Steve D. Glazer & Steven J. Rizzi, Markman: *The Supreme Court Takes Aim at Patent Juries*, J. PROPRIETARY RTS., May 1996, at 5 n.2 (quoting Victoria Slind-Flor, *Ruling Boosts Judges' Role in Patents*, NAT'L L.J., May 6, 1996, at B1 (quoting Jack C. Goldstein, former head of the American Bar Association's intellectual property law section)).

363 Landry, *supra* note 357, at 1211.

364 The standard of review for a jury verdict is whether it is supported by substantial evidence, and for a trial judge, whether the findings are clearly erroneous. *See infra* note 402 and accompanying text.

to the Federal Circuit, permit determination of "a true and consistent scope of the claims," which would benefit both patentees and competitors.[365]

Excluding juries from construing patent claims was a result that the Federal Circuit clearly sought. *Markman* could have been decided on much narrower grounds. The evidence presented did not provide much support for the interpretation Markman sought (that the term "inventory" could mean either dollars or cash or invoices or articles of clothing).[366] Interestingly, while the district court judge in *Markman* granted judgment as a matter of law to Westview on claims 1 and 10, which the jury had decided in favor of the plaintiff Markman, he did not disturb the jury's finding in favor of the defendants on claim 14.[367] The judge did not decide that the matter should never have gone to the jury. Rather, he believed that claims 1 and 10 should be decided by the court as a matter of law because the testimony did not raise genuine issues of material fact.[368]

Judge Rader focused on this last point in his concurring opinion in the Federal Circuit's decision in *Markman*. To decide *Markman*, according to Judge Rader, the Federal Circuit did not need to decide that all subsidiary issues in all patent claims should be determined by the court as a matter of law.[369] Instead, Judge Rader asserted that the decision should be limited to finding that judgment as a matter of law was properly granted to Westview because no substantial evidence supported Markman's position.[370] He commented emphatically that "[t]his court's extensive examination of subsidiary fact issues is dicta. . . . [W]hether claim construction can involve subsidiary fact issues is *not* before us. It is our duty *not* to rule on this question."[371]

The Federal Circuit was overreaching when it decided that all underlying disputed issues of fact *could* be properly determined by a court alone—but it went still further to state that a court *must* decide claim construction exclusively.[372] The Federal Circuit held that "in a case tried to a jury, the court has the power *and obligation* to construe as a matter of law the meaning of language used in the patent claim."[373] In other words, the Federal Circuit did not want a district court judge to have any discretion to permit a jury to decide disputed terms of art if it seemed more appropriate to the district judge under the circumstances to send the issue to the jury. According to the Federal Circuit, the interpretation of such disputed underlying terms by the court is not only permissible, but *obligatory*. This conclusion was necessary in order for the Federal Circuit to retain de novo review in all litigation of patent claims. In affirming the Federal Circuit's decision, the Supreme Court granted the Federal Circuit's wishes, holding that "the construction of a pat-

365 Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996).

366 *See id.* at 974.

367 Markman v. Westview Instruments, Inc., 772 F. Supp. 1535, 1536 (E.D. Pa. 1991), *aff'd*, 52 F.3d at 989, *aff'd*, 517 U.S. at 391.

368 *See id.*

369 *See Markman*, 52 F.3d at 998 (Rader, J., concurring).

370 *See id.* (Rader, J., concurring).

371 *Id.* (Rader, J., concurring).

372 *See id.* at 970-71.

373 *Id.* at 979 (emphasis added).

ent, including terms of art within its claim, is exclusively within the province of the court."[374]

The Supreme Court's deference to the Federal Circuit and to the goals of Congress in creating a statutory scheme for patent and patent administration, although not an exact fit within the "public rights" strand of the Court's Seventh Amendment jurisprudence, nonetheless offers a more logical explanation of the Court's conclusion in *Markman* than any of the other jurisprudential approaches.[375] The Court's unspoken rationale appeared to be that because the Federal Circuit wanted de novo review of all patent claims construction, which could be accomplished only if claims were construed solely as a matter of law, de novo review was undoubtedly important to the Federal Circuit's effective administration of the patent system. In addition, the Court reasoned that because patent law is a highly specialized area, and consistency in patent interpretation is necessary to the public interest, judges rather than jurors should construe the patent claim in its entirety.[376]

In sum, while the *Markman* decision appears to be consistent with the first strand of Seventh Amendment jurisprudence, or at least with the first prong of the historical test—considering whether the nature of the action is one which would have had a jury trial right in 1791—the decision is inconsistent with the second and third strands because of the Court's willingness to withdraw factual issues from the jury. Neither does *Markman* fit neatly within the fourth strand—upholding congressional action creating non-Article III courts and administrative agencies that resolve matters of public right without a jury—because patent jurisdiction remains in Article III courts. Nevertheless, it may well be that the Court in *Markman* was willing to support a novel Seventh Amendment interpretation because its application was limited to a specialized forum that dealt with a specialized subject matter affecting public rights and entirely regulated by federal law.[377]

C. *Beyond the Seventh Amendment*

At the beginning of Part III of the *Markman* decision, the Supreme Court stated that the Seventh Amendment did not apply to claim construction because common law practice in 1791 did not require jury participation.[378] The Court then stated that it must "look elsewhere to characterize this determination of meaning in order to allocate it as between court or jury."[379] The three areas the Court determined to look at included the fol-

374 Markman v. Westview Instruments, Inc., 517 U.S. 370, 372 (1996).

375 Curiously, although the Supreme Court was entirely deferential to the Federal Circuit by giving it exactly the result it sought, the Court was not deferential to the reasoning of the Federal Circuit. The Supreme Court did not mention the Federal Circuit's analogy of a patent to a statute, or the second line of authority of cases which the Federal Circuit claimed supported its position.

376 *See Markman*, 517 U.S. at 387-90.

377 The Supreme Court, however, does not appear to believe that juries have no role in patent litigation. *See infra* notes 421-431 and accompanying text.

378 *See Markman*, 517 U.S. at 384. "[E]vidence of common-law practice at the time of the framing does not entail application of the Seventh Amendment's jury guarantee to the construction of the claim document . . . ." *Id.*

379 *Id.*

lowing: "existing precedent, . . . the relative interpretive skills of judges and juries and the statutory policies that ought to be furthered by the allocation."[380]

The question these statements raise is whether the Court's Seventh Amendment analysis ended with Part II, so that Part III is simply a discussion of other potential bases for allocation of issues between judge and jury, or whether Part III is a continuation of its interpretation of the Seventh Amendment.[381] If the Seventh Amendment inquiry ended in Part II, with the conclusion that there was no guarantee of a jury trial for a disputed issue of fact in a patent case, then it would not appear necessary for the Court to proceed further. If there is no jury trial right, the issue is left for the judge's consideration. Because Justice Souter continued the inquiry in Part III, there is at least the suggestion that he was continuing to analyze the applicability of the Seventh Amendment jury trial right to the issue of claim construction.

There are a number of indications that this is not the case, however, and that after deciding that the Seventh Amendment does not require a jury trial on this particular issue, the Court simply turned to alternative means of determining the proper allocation between judge and jury. First, the language itself at the end of Part II of the decision appears to categorically state that the Seventh Amendment does not apply.[382] The first paragraph of Part III then indicates that other ways of deciding this issue will be considered.[383] Second, with the exception of the first paragraph of Part III, Justice Souter never again mentions the Seventh Amendment in his discussion in Part III of the various methods proposed for allocating an issue between judge and jury: precedent, relative skills of judges and juries, and statutory policies that would be furthered by the allocation.[384]

The Court's discussion of precedent concerned how earlier cases handled patent claims and what commentators have said about questions of construction, but did not discuss the constitutional aspect of the question.[385] The Court's conclusion about the value of precedent seems rather confused, because it made two statements which appear somewhat contradictory. Initially, the Court concluded: "[O]ur precedent supports classifying the

380 *Id.*

381 Commentators have taken different views. Michelson says the policy arguments were simply used to support the Federal Circuit's holding that claim construction is a matter of law. *See* Michelson, *supra* note 347, at 1763. The author of an unsigned *Harvard Law Review* Note seemed to believe *Markman*'s discussion of functional considerations was part of the Seventh Amendment analysis, but stated, "[u]nder one possible reading, the Court simply ended its Seventh Amendment analysis in Part II of the opinion, finding the constitutional guarantee to be inapplicable." *The Supreme Court 1995 Term—Leading Case*, 110 HARV. L. REV. 135, 276 n.81 (1996) (citations omitted).

382 "[O]ur conclusion [is] that the Seventh Amendment does not require terms of art in patent claims to be submitted to the jury . . . ." *Markman*, 517 U.S. at 384 n.9.

383 "Since evidence of common-law practice at the time of the framing does not entail application of the Seventh Amendment's jury guarantee to the construction of the claim document, we must look elsewhere to characterize this determination of meaning in order to allocate it as between court or jury." *Id.* at 384.

384 *See id.*

385 *See id.* at 384-91.

question as one for the court."[386] Yet, later in the opinion the Court remarked that when "precedent provide[s] no clear answers, functional considerations also play their part in the choice between judge and jury to define terms of art."[387] Thus, if one tried to reconcile these two conflicting statements, it would appear that the Court's view is that although precedent provided some support for judges to decide patent claims, it did not provide a clear answer to the question of proper allocation between judge and jury. The Court therefore turned to functional considerations to answer the allocation question.

Justice Souter determined that "judges, not juries, are the better suited to find the acquired meaning of patent terms."[388] He noted further that "[t]he construction of written instruments is one of those things that judges often do and are likely to do better than jurors unburdened by training in exegesis" and that judges can better perform with respect to "the claims of patents [which] have become highly technical in many respects."[389]

Functional considerations have never, of course, been a part of Seventh Amendment jurisprudence. The reasons are steeped in history. The Seventh Amendment was adopted by the Founders in part to protect against oppressive and corrupt judges.[390] Permitting a judge to determine that an issue should be decided by the court rather than the jury brings to mind the proverbial fox guarding the chicken coop. Giving the court the power to determine on a functional basis if an issue should go to the jury would essentially abrogate the constitutional guarantee of the right to a jury trial.[391]

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386 *Id.* at 384 n.10.

387 *Id.* at 388.

388 *Id.*

389 *Id.* at 388, 389 (quoting William Redin Woodward, *Definiteness and Particularity in Patent Claims*, 46 MICH. L. REV. 755, 765 (1948)). There is empirical evidence which does not support the Court's assumption that the jury is an inferior fact finder to the judge in scientific matters. *See* Michael S. Jacobs, *Testing the Assumptions Underlying the Debate About Scientific Evidence: A Closer Look at Juror "Incompetence" and Scientific "Objectivity,"* 25 CONN. L. REV. 1083, 1094-98 (1993) (stating that empirical evidence does not support the view of juror incompetence, rather, increasingly, evidence indicates jurors competently decide complex issues); Kenneth R. Kreiling, *Scientific Evidence: Toward Providing the Lay Trier with the Comprehensible and Reliable Evidence Necessary to Meet the Goals of the Rules of Evidence*, 32 ARIZ. L. REV. 915, 930-35 (1990) (citing a number of studies that give jurors credit for good recall, comprehension, evaluation of expert testimony, and application of law to facts).

390 Thomas Jefferson described the jury as "the only anchor ever yet imagined . . . by which a government can be held to the principles of its constitution." Letter from Thomas Jefferson to Thomas Paine (July 11, 1789), *in* MARTIN A. LARSON, JEFFERSON: MAGNIFICENT POPULIST 134 (1981); *see also* Wolfram, *supra* note 12, at 644 ("[I]t seems clear that one of the purposes of the right of jury trial in civil cases is to place limitations upon judges."). Wolfram also concluded,

> it is clear that the amendment was meant by its proponents to do more than protect an occasional civil litigant against an oppressive and corrupt federal judge—although it certainly was to perform this function as well. . . . The effort was quite clearly to require juries to sit in civil cases as a check on what the popular mind might regard as legislative as well as judicial excesses.

Wolfram, *supra* note 12, at 653.

391 In discussing the functional argument, Justice Souter cited *Miller v. Fenton*, 474 U.S. 104 (1985), for the proposition that when an issue "'falls somewhere between a pristine legal standard and a simple historical fact, the fact/law distinction at times has turned on a determination that, as a matter of the sound administration of justice, one judicial actor is better positioned

The only indication that the Court might be willing to consider a functional approach to the allocation of matters between judge and jury appears in dicta in a footnote in *Ross v. Bernhard.* There, the Court said "the 'legal' nature of an issue is determined by considering, first, the pre-merger custom with reference to such questions; second, the remedy sought; and, third, the practical abilities and limitations of juries."[392] The Court never developed in any other case, however, a functional approach to Seventh Amendment interpretation which considered "the practical abilities and limitations of juries," except with respect to administrative proceedings.[393] In *Tull v. United States*, the Court referred to this understanding in a footnote, stating that "[t]he Court has also considered the practical limitations of a jury trial and its functional compatibility with proceedings outside of traditional courts of law in holding that the Seventh Amendment is not applicable to administrative proceedings."[394] Furthermore, in a footnote in *Granfinanciera*, the Court put to rest any indication that it might apply a functional test to determine Seventh Amendment applicability. The Court specifically explained that the reference in *Ross* to "the practical abilities and limitations of juries" was a contemplation of "whether Congress has permissibly entrusted the resolution of certain disputes to an administrative agency or specialized court of equity, and whether jury trials would impair the functioning of the legislative scheme."[395] In *Chauffeurs*, a year after *Granfinanciera*, the Court, quoting the language in *Granfinanciera*, reaffirmed that functional considerations have never been relied upon by the Court as a basis for Seventh Amendment applicability, referring to the above language in *Granfinanciera.*[396]

It is unlikely that the Court, in the face of this clear precedent, would then assert in *Markman* that the Seventh Amendment permitted the allocation of issues between judge and jury to be determined on a functional basis. Rather, Justice Souter appeared to set forth the functionality argument as a policy rationale for allocating an issue to the jury, only *after* having determined there was no constitutional requirement to be considered. If this is

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than another to decide the issue in question.'" *Markman*, 517 U.S. at 388 (quoting *Miller*, 474 U.S. at 114). The reference to the fact/law distinction made in *Miller* seems inappropriate in *Markman.* First, *Miller* was a criminal case, dealing with a writ of habeas corpus to review the question of voluntariness of a confession and whether the confession met the due process standards of the Fourteenth Amendment. *See Miller*, 474 U.S. at 105-08. There was no issue of allocation between judge and jury, but rather a question of standard of review by the appellate court of the trial court's findings. *See id.* at 109. The "judicial actors" referred to were the appellate court and the trial court. *See id.* at 114. The Court determined that the standard was one of independent review for legal questions rather than "presumed correctness" for factual findings. *See id.* at 115.

392 Ross v. Bernhard, 396 U.S. 531, 538 n.10 (1970).

393 *See* Atlas Roofing Co. v. Occupational Safety & Health Review Comm'n, 430 U.S. 442, 454 (1977); Pernell v. Southall Realty, 416 U.S. 363, 383 (1974).

394 Tull v. United States, 481 U.S. 412, 418 n.4 (1987) (citing *Atlas Roofing*, 430 U.S. at 454).

395 Granfinanciera, S.A. v. Nordberg, 492 U.S. 33, 42 n.4 (1989).

396 *See* Chauffeurs, Teamsters & Helpers Local No. 391 v. Terry, 494 U.S. 558, 565 n.4 (1990) ("We recently noted that this [functional] consideration is relevant only to the determination 'whether Congress has permissibly entrusted the resolution of certain disputes to an administrative agency or specialized court of equity, and whether jury trials would impair the functioning of the legislative scheme.'" (quoting *Granfinanciera*, 492 U.S. at 42 n.4)).

indeed the case, any arguments that *Markman* has created a complexity exception to the Seventh Amendment are without merit, because the question of whether judges or jurors are better suited to decide certain issues only occurs after a court determines that the Seventh Amendment does not apply.[397]

Finally, the Court in *Markman* discussed the statutory policies that would be furthered by the allocation of patent claim construction to the judge. As noted above, the Court focused on the federal statutory scheme designed to ensure uniformity in the treatment of patents, in order to "'strengthen the United States patent system in such a way as to foster technological growth and industrial innovation.'"[398] The Court's stated policy reasons are consistent with its jurisprudential approach to non-Article III courts that deal with "public rights," where it has deferred to a congressional statutory scheme that does not provide for the right to a jury trial. The Court did not, however, discuss Seventh Amendment applicability or non-applicability in this part of *Markman*. It framed its arguments instead as policy-based, grounded in the congressional goal of uniformity in the treatment of patents.[399]

A better reading of Part III of the *Markman* opinion is that it does *not* interpret the Seventh Amendment, but rather, attempts to bolster on policy grounds the Seventh Amendment decision reached in Part II.[400] The need for bolstering its decision to allocate claim interpretation to the judge is apparent in light of the fact that it is based on a novel application of Seventh Amendment jurisprudence. Seventh Amendment jurisprudence has for over a century imposed no impediment to developing modern jury practices and procedures unrestricted by particular practices that were or were not followed in 1791. Until *Markman*, the Court repeatedly held that such changes in practices and procedures were permitted, as long as they did not interfere with the critical element which must be preserved—the jury's fact-finding role in a common law suit. In *Markman*, however, the Court took a different

397 It would be ironic if *Markman* was determined to have created a complexity exception to the Seventh Amendment. While undoubtedly some patent decisions involve complex issues, the *Markman* question of what "inventory" means is not complex.

398 Markman v. Westview Instruments, Inc., 517 U.S. 370, 390 (1996) (quoting H.R. REP. No. 97-312, at 20 (1981)).

399 A number of commentators are not persuaded that the *Markman* decision will increase uniformity. *See* Kevin W. King, Note, Markman v. Westview Instruments, Inc.: *The Jury's Diminishing Role in Patent Law Cases*, 13 GA. ST. U. L. REV. 1127, 1150 (1997) (stating that different district courts may reach contrary conclusions when construing a single patent in separate infringement lawsuits, and "[d]ifferent panels of the Federal Circuit may disagree, creating an intracircuit conflict which may or may not be resolved en banc or by the Supreme Court"); Leibold, *supra* note 347, at 644 ("Except where the same precise issue arises in subsequent litigation against another infringer, . . . piecemeal, 'define-as-you-go' construction leaves patentees in essentially the same position" as when juries decided claim construction); Michelson, *supra* note 347, at 1735 (stating that because other issues are still decided by the jury, claim construction by a judge will not necessarily produce uniformity).

400 This is supported by the last sentence of footnote 9 in Part II of *Markman*, in which the Court states unequivocally, before even considering the issues raised in Part III, "that the Seventh Amendment does not require terms of art in patent claims to be submitted to the jury." *Markman*, 517 U.S. at 384 n.9.

approach, resulting in the withdrawal of facts from the jury in patent claims construction. In Part III of its decision, therefore, policy reasons appear to be offered in support of a decision that seems otherwise inconsistent with the strong federal policy favoring jury trials.

There may have been an additional reason why the Court bolstered its decision with policy rationales. The Court's holding was that "the construction of a patent, including terms of art within its claim, is *exclusively* within the province of the court."[401] If the decision had simply been that the Seventh Amendment does not *require* disputed terms of art in a claim to go to the jury, a judge could still send the issues to the jury if it seemed appropriate to do so. In *Markman*, however, the Court imposed on trial judges an obligation *not* to send these kinds of issues to the jury. The Court decided not only that it was *proper* for a trial court to decide this issue, but that doing so was mandatory. That result is not compelled, nor even supported by a finding that the Seventh Amendment does not require a jury decision. It was, however, the result sought by the Federal Circuit. Imposing a requirement on lower courts that goes beyond simply determining that the Seventh Amendment does not mandate a jury trial right on a particular issue represents an activist stance by the Court. It is therefore not very surprising that the Court would set forth policy rationales in support of its activist decision.

The reason the Federal Circuit wanted to have the claim construed solely by the court was to permit it to have de novo review in each case. Federal appellate courts use different standards to review appeals that come before them, depending upon whether they are reviewing a finding of fact or a finding of law. If reviewing a finding of fact, the court's standard may also differ depending upon whether the fact finder below was the judge or the jury. As Judge Mayer explained:

> When a question of claim construction arrives here on appeal, this court reviews the ultimate construction given the claims under the de novo standard applicable to all legal conclusions. But any facts found in the course of interpreting the claims must be subject to the same standard by which we review any other factual determinations: for clear error in facts found by a court; for substantial evidence to support a jury's verdict.[402]

Thus, in order for the Federal Circuit to have the complete de novo review it sought over patent claim construction, the trial judge would have to decide any underlying disputed issues of fact as a matter of law. As a result, the appellate judges of the Federal Circuit would then have de novo review of factual issues, such as credibility determinations, traditionally considered solely within the jury's province.[403] The Court acknowledged in *Markman* that credibility determinations "are the jury's forte," but stated:

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401 *Id.* at 372 (emphasis added). The Court made clear it was "treating interpretive issues as purely legal." *Id.* at 391.

402 Markman v. Westview Instruments, Inc., 52 F.3d 967, 991 (Fed. Cir. 1995) (Mayer, J., concurring), *aff'd*, 517 U.S. at 391.

403 In discussing the functional argument, Justice Souter quoted *Miller v. Fenton* for the proposition that when an issue "'falls somewhere between a pristine legal standard and a simple

> 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. But our own experience with document construction leaves us doubtful that trial courts will run into many cases like that.[404]

This justification for requiring judges to make credibility judgments as a matter of law—that it will not happen very often—is not a very satisfactory reason for taking a factual issue from the jury.[405]

To summarize, the Court did the following in *Markman*. First, it asked whether the subsidiary issue of claim construction went to a jury in 1791. Second, the Court determined that because there were no "claims" as such in 1791, the closest analogy was the specification. Because there was no established jury practice in 1791 for construing specifications, there was no constitutionally mandated jury trial right on the issue.[406] Third, the Court

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historical fact, the fact/law distinction at times has turned on a determination that, as a matter of the sound administration of justice, one judicial actor is better positioned than another to decide the issue in question.'" *Markman*, 517 U.S. at 388 (quoting Miller v. Fenton, 474 U.S. 104, 114 (1985)). However, Justice Souter did not cite one of the examples given by the *Miller* Court as to when an appellate court should treat a trial court's finding as fact rather than law:

> other considerations often suggest the appropriateness of resolving close questions concerning the status of an issue as one of "law" or "fact" in favor of extending deference to the trial court. When, for example, the issue involves the credibility of witnesses and therefore turns largely on an evaluation of demeanor, there are compelling and familiar justifications for leaving the process of applying law to fact to the trial court [as trier of fact] and according its determinations presumptive weight.

Miller, 474 U.S. at 114.

404 *Markman*, 517 U.S. at 389. Of course, credibility determinations are not the only factual issues which now have to be determined by the court. Judge Newman outlined five major areas in which disputed factual issues are likely to arise in connection with construing a patent claim: (1) the specification ("[t]he . . . specification contains the description of the invention, including the claims"); (2) the prior art (prior art is "what was known to persons in the field of invention at the time the invention was made"); (3) the prosecution history (the public record in the PTO of "what transpired during examination of the patent application"); (4) technologic/scientific facts (questions of patent infringement may turn on findings of technologic or scientific facts); and (5) the testimony of experts. *Markman*, 52 F.3d at 1002-05 (Newman, J., dissenting). Judge Newman also expressed concern as to how the Federal Circuit was to find technological facts:

> Are we to read the entire record of the trial, re-create the demonstrations, decipher the literature of the science and art; are we to seek our own expert advice; must the parties be told the technical training of our law clerks and staff attorneys? No *amicus* explained how improved technological correctness—that is, truth—would be more likely to be achieved during the appellate process of page-limited briefs and fifteen minutes per side of argument.

Id. at 1021 n.11 (Newman, J., dissenting).

405 At oral argument in *Markman*, the Court asked counsel for Westview how often conflicting expert testimony was presented in a patent case on the meaning of the patent. Counsel responded that conflicting expert testimony is presented "in virtually every case." Official Transcript of the Supreme Court of the United States at 33, Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996) (No. 95-26).

406 *See Markman*, 517 U.S. at 380.

concluded that because the Seventh Amendment did not require a jury trial on the issue of claim construction, the Court must therefore determine on other grounds whether underlying disputed issues of claim construction should be decided by the judge or by the jury.[407] After finding no clear answer in precedent, the Court turned to functional considerations and policy reasons for allowing the issue to be exclusively decided by the judge as a matter of law.[408]

This is a dangerous approach to the Seventh Amendment if applied outside the patent area. If no subsidiary factual issue *had* to be heard by a jury unless an analogous issue was also heard by a jury in 1791, we would soon have a significantly reduced jury trial right.[409] Although we know generally which causes of action went to a jury in 1791, it could be difficult if not impossible to establish whether each subsidiary issue within a particular cause of action went to the jury in 1791. Under *Markman*, unless there is proof that the subsidiary issue went to the jury in 1791, the court would be free to apply a functional, policy-based analysis to determine whether the judge or jury should decide the issue. For a number of reasons, however, it appears as though the Court did not intend the reasoning in *Markman* to be applied outside the patent area.

IV. Markman*'s Inapplicability Outside of the Patent Area*

The *Markman* decision has generated a large amount of scholarly comment, much of it critical.[410] Most commentators have discussed the impact of *Markman* on patent law, and at least one commentator has analyzed the impact of *Markman* on other areas of the law.[411] Although *Markman* has had a major impact on patent litigation, there are three main reasons why it is unlikely to have significant precedential value outside of the patent law area: (1) the specific limiting language of the decision, (2) inconsistency with the Court's Seventh Amendment jurisprudence outside the patent area, and (3)

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407 *See id.* at 384.

408 *See id.* at 388-91.

409 At oral argument in the *Markman* case, one of the Justices noted that, "[a] patent infringement is an action at law. And then you're going to take the issues one by one and take them away from the jury, and pretty soon you'll have nothing triable to a jury." Official Transcript of the Supreme Court of the United States at 45, Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996) (No. 95-26).

410 *See* Leibold, *supra* note 347, at 671 (arguing that "the Supreme Court appropriated the most important question in a patent-infringement suit for judges by recharacterizing claim construction as a matter of law, subject to *de novo* review," making the *Markman* decision "constitutionally troubling"); Michelson, *supra* note 347, at 1735 (stating that the "right to a jury trial . . . should not [be diminished] . . . because the court believes itself better suited to find technological facts"); Louis S. Silvestri, Note, *A Statutory Solution to the Mischiefs of* Markman v. Westview Instruments, Inc., 63 BROOK. L. REV. 279, 316 (1997) (stating that the Supreme Court in *Markman* "wrongfully eliminat[ed] the well-established, defined differences between trial judge and jury"); *The Supreme Court 1995 Term—Leading Case*, *supra* note 381, at 272-73 (stating that the Supreme Court in *Markman*, although reaching sound result, used flawed analysis).

411 *See, e.g.*, Joseph A. Miron, Jr., Note, *The Constitutionality of a Complexity Exception to the Seventh Amendment*, 73 CHI.-KENT L. REV. 865, 866 (1998).

the unanimity of the decision, which suggests the Court viewed the decision as quite narrow in its applicability.

A. *The Limiting Language of the* Markman *Decision*

The Court observed that the *Markman* decision was limited to the patent area, saying, "[w]e need not in any event consider here whether our conclusion that the Seventh Amendment does not require terms of art in patent claims to be submitted to the jury supports a similar result in other types of cases."[412] The Court also noted, in rather convoluted language, that it was *not* deciding "the extent to which the Seventh Amendment can be said to have crystallized a fact/law distinction, or whether post-1791 precedent classifying an issue as one of fact would trigger the protections of the Seventh Amendment if (unlike this case) there were no more specific reason for decision."[413]

In announcing what it was *not* deciding, the Court left for future decisions whether the fact/law distinction in 1791 is the only distinction that should be recognized, or whether fact/law distinctions made after 1791 can also trigger Seventh Amendment protections. Thus, while the Court did not clarify the exact extent to which the Seventh Amendment mandates that certain issues be decided by the jury, by limiting its decision to the very narrow patent law area, the Court intimated that a large remaining area is protected by the Seventh Amendment. Moreover, it seems unlikely that the Court would attempt to limit a fact/law distinction to one that existed in 1791, in light of its consistent prior jurisprudence holding that the substance of the Seventh Amendment must be preserved, not the forms existing in 1791.[414] This ability to adapt and change, however, should not permit the relabeling of issues of fact as issues of law for "functional" purposes, because doing so would interfere with the jury's fact-finding function.[415] That fact-finding function has consistently been found by the Court, outside the patent area, to

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412 *Markman*, 517 U.S. at 383-84 n.9.

413 *Id.* at 384 n.10 (citations omitted).

414 *See* Galloway v. United States, 319 U.S. 372, 390-91 (1943), where the Court stated:

> The Amendment did not bind the federal courts to the exact procedural incidents or details of jury trial according to the common law in 1791, any more than it tied them to the common-law system of pleading or the specific rules of evidence then prevailing. Nor were "the rules of the common law" then prevalent, including those relating to the procedure by which the judge regulated the jury's role on questions of fact, crystallized in a fixed and immutable system. On the contrary, they were constantly changing and developing during the late eighteenth and early nineteenth centuries.

Id. (footnotes omitted).

415 The Seventh Amendment requires "that questions of fact in common law actions shall be settled by a jury, and that the court shall not assume directly or indirectly to take from the jury or to itself such prerogative." Walker v. New Mexico & S. Pac. R.R. Co., 165 U.S. 593, 596 (1897). Even within the fourth strand of Seventh Amendment jurisprudence, deference to a congressional statutory scheme, there are limitations on simply relabeling an issue of fact as one of law. "Congress cannot eliminate a party's Seventh Amendment right to a jury trial merely by relabeling the cause of action to which it attaches and placing exclusive jurisdiction in an administrative agency or a specialized court of equity." Granfinanciera, S.A. v. Nordberg, 492 U.S. 33, 61 (1989).

be the substance of the Seventh Amendment right which must be preserved.[416]

B. Inconsistency with the Court's Traditional Seventh Amendment Jurisprudence

As noted above, the *Markman* decision is inconsistent with the second and third strands of Seventh Amendment jurisprudence developed by the Court outside the patent area, and does not neatly fit within the fourth strand. The second prong of the *Markman* test—determining if a subsidiary issue in a cause of action went to the jury in 1791—is a much more limiting approach than the traditional second strand of the Court's jurisprudence which focuses on preserving the jury's role as fact finder. The fact/law distinction, which has traditionally been the critical element preserved by the Court, was ignored in *Markman* in favor of a formalistic search for a nonexistent historical analogue.

Markman is also inconsistent with the underlying principles of the third strand of Seventh Amendment jurisprudence involving the merger of law and equity. In cases in which both equitable and legal issues are involved, the Court's decisions have protected and expanded the right to a jury trial of the issues common to both claims.[417] While there were no equitable issues in *Markman*, rather subsidiary factual issues underlying a legal cause of action, the Court was far less protective of the jury trial right for subsidiary issues in an action at law than of legal issues combined with equitable issues.

It is the fourth strand of Seventh Amendment jurisprudence which appears most able to explain the result in *Markman*. This strand describes the Court's deference to a congressional statutory scheme affecting public rights. The limitation on the jury trial right created by this strand suggests an explanation for the result obtained in *Markman*. The Court appeared to view the specialized forum of the Federal Circuit, which will have the power of de novo review for decisions made by trial courts on patent construction claims, as well as the congressional desire for uniformity in patent law, as justifications for requiring judges rather than juries to decide disputed factual issues underlying patent claims.

Because of these special circumstances, however, it is highly unlikely that the Court would be as willing to withdraw factual issues from the jury in areas outside of patent law. As the Court noted in *Atlas Roofing* and *Granfinanciera*, public rights do not typically include common law rights such as torts, contracts, and property.[418] Thus, it seems unlikely that the Court would apply its reasoning in *Markman* to issues in these other areas which mainly involve private rights.

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416 "Maintenance of the jury as a fact-finding body is of such importance and occupies so firm a place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be scrutinized with the utmost care." Dimick v. Schiedt, 293 U.S. 474, 486 (1935).

417 *See supra* notes 181-195 and accompanying text.

418 *See supra* notes 228, 249 and accompanying text.

C. *Unanimity of the Decision*

The unanimity of the *Markman* decision also suggests that the Court intended its approach to be limited mainly to the patent area. The fact that no Justice felt compelled to dissent or even to concur separately indicates that the Court did not believe anything very significant was changed by *Markman* regarding the Court's general approach to Seventh Amendment jurisprudence. Rather, the Court had simply decided that in construing patent claims, trial courts and the Federal Circuit should have more power to decide underlying disputed factual issues.

Markman's unanimity contrasts sharply with some prior Seventh Amendment decisions, in which Justices have passionately dissented whenever the Court has either expanded or contracted the Seventh Amendment jury trial right.[419] That the Justices care strongly about the Seventh Amendment right to a jury trial can be seen in these dissents. Thus, the failure of any Justice to raise a dissenting voice supports the view that the Justices did not regard their decision as bringing about any substantial changes in Seventh Amendment jurisprudence.

V. *Post*-Markman *Cases*

Since *Markman*, the Supreme Court has decided three cases affecting the jury trial right: *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, *Feltner v. Columbia Pictures Television, Inc.*, and *City of Monterey v. Del Monte Dunes*.[420] These three cases appear to confirm that any change in Seventh Amendment jurisprudence caused by the *Markman* decision did not have major significance outside of the narrow area of patent claim construction.

A. Warner-Jenkinson Co. v. Hilton Davis Chemical Co.

In *Warner-Jenkinson*, a patent infringement suit, the Court considered the doctrine of equivalents.[421] This doctrine permits a finding of infringement even in the absence of literal infringement "if there is 'equivalence' between the elements of the accused product or process and the claimed elements of the patented invention."[422] The patent holder in *Warner-Jenkinson* was a dye manufacturing company which had a patent for a purification pro-

419 *See* Parklane Hosiery Co. v. Shore, 439 U.S. 322, 337 (1979) (Rehnquist, J., dissenting) (dissenting from majority holding that use of offensive collateral estoppel did not violate petitioners' Seventh Amendment right to a jury trial); Colgrove v. Battin, 413 U.S. 149, 166 (1973) (Marshall & Stewart, JJ., dissenting) (rejecting majority view upholding six person jury in civil case); Beacon Theatres, Inc. v. Westover, 359 U.S. 500, 511 (1959) (Harlan, Whittaker, and Stewart, JJ., dissenting) (protesting Court's holding that Seventh Amendment required jury trial for legal rights tried with equitable rights); *Galloway*, 319 U.S. at 396 (Black, Douglas, and Murphy, JJ., dissenting) (objecting to majority's sanctioning the expanded use of directed verdicts).

420 A fourth case, *Hetzel v. Prince William County*, 523 U.S. 208 (1998) (per curiam), was decided per curiam under the Re-Examination Clause of the Seventh Amendment. The Court reversed a decision of the U.S. Court of Appeals for the Fourth Circuit to reduce a damage award without granting plaintiff a new trial. The *Hetzel* decision was consistent with the Court's traditional view of remittitur.

421 *See* Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 21 (1997).

422 *Id.*

cess involving "ultrafiltration."[423] The process operated at pH levels between approximately 6.0 to 9.0.[424] When a second company developed an ultrafiltration process which operated at a pH of 5.0, the patent holder asserted infringement under the doctrine of equivalents, while acknowledging that there was no literal infringement.[425]

Justice Thomas, writing for the Court, determined that the doctrine of equivalents was alive and well, having survived the various revisions of the Patent Act of 1952,[426] and that the doctrine must be applied to each individual element of the claim as opposed to the invention as a whole.[427] One issue before the Court was whether the judge or the jury should apply the doctrine of equivalents. The Federal Circuit, sitting en banc, had held that applying the doctrine was a task for the jury: "Infringement, whether literal or under the doctrine of equivalents, is a question of fact."[428] The Supreme Court asserted that it was not necessary to decide the jury issue in order to resolve the question before the Court.[429] Nonetheless, the Court acknowledged that there was "ample support in [its] prior cases" to support the Federal Circuit's holding, and concluded that "[n]othing in our recent decision in *Markman v. Westview Instruments, Inc.* necessitates a different result than that reached by the Federal Circuit."[430]

The fact that the Court, while asserting that it was not deciding the issue, nonetheless indicated its approval of the Federal Circuit's allocation of this task to the jury, indicates either its support for the jury, or its deference to the Federal Circuit. The Court left open, however, the possibility that it might reach a different conclusion if the issue were squarely presented to it.[431] This decision suggests at the very least, however, that for the foreseeable future, disputed infringement issues, including equivalence issues, will remain within the province of the jury.

B. Feltner v. Columbia Pictures Television, Inc.

In *Feltner*, Justice Thomas, writing for the Court, determined that the petitioner in a copyright case had a Seventh Amendment right to a jury trial on the amount of statutory damages, despite language in the statute indicating that Congress had assigned this task to the court.[432] The copyright violation occurred after Feltner's three television stations, to which Columbia

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423 *See id.*

424 *See id.* at 22.

425 *See id.* at 23.

426 35 U.S.C. §§ 1-357 (1994 & Supp. III 1998).

427 *See Warner-Jenkinson Co.*, 520 U.S. at 25-29.

428 Hilton Davis Chem. Co. v. Warner-Jenkinson Co., 62 F.3d 1512, 1520 (Fed. Cir. 1995) (en banc) (per curiam), *rev'd*, 520 U.S. at 41.

429 *See Warner-Jenkinson*, 520 U.S. at 38-39.

430 *Id.* at 38.

431 *See id.* at 39.

432 *See* Feltner v. Columbia Pictures Television, Inc., 523 U.S. 340, 342 (1998). Section 504(c) of the Copyright Act of 1976, 17 U.S.C. §§ 101-1101 (1994 & Supp. IV 1999), provides that a copyright owner can recover "instead of actual damages . . . , an award of statutory damages . . . in a sum of not less than $500 or more than $20,000 as the court considers just." 17 U.S.C. § 504(c)(1).

Pictures Television ("Columbia") had licensed the rights to several television series, failed to pay royalty fees.[433] Columbia terminated the license agreements, but Feltner's stations continued to run the series.[434] The trial court entered summary judgment for Columbia on the copyright claims, and Columbia then exercised the option provided by section 504(c) of the Copyright Act of 1976[435] to recover statutory damages in lieu of actual damages.[436] The trial court denied Feltner's request for a jury trial on the issue of statutory damages, and determined after a two-day bench trial that (1) each airing by each station of each show was a separate violation, (2) there were 440 acts of infringement, and (3) the acts were willful.[437] The judge therefore fixed the damages at $20,000 per infringement, for a total statutory damage amount of $8,800,000.[438] The U.S. Court of Appeals for the Ninth Circuit ("Ninth Circuit") affirmed, concluding that "the Seventh Amendment does not provide a right to a jury trial on the issue of statutory damages because an award of such damages is equitable in nature."[439]

The Supreme Court reversed the Ninth Circuit, holding that the Seventh Amendment required a jury trial on the amount of statutory damages. The Court determined that the Seventh Amendment's command overrode the language of section 504(c), which provided that statutory damages were to be assessed in an amount that "'the court considers just.'"[440]

In *Feltner*, the Supreme Court appeared to once again reaffirm its traditional Seventh Amendment jurisprudence. It began its analysis by setting forth the traditional historical test: "To determine whether a statutory action is more analogous to cases tried in courts of law than to suits tried in courts of equity or admiralty, we examine both the nature of the statutory action and the remedy sought."[441] In examining the historical background of copyrights, the Court noted that there were close analogues in 1791, because prior to the adoption of the Seventh Amendment "the common law and statutes in England and this country granted copyright owners causes of action for infringement. More importantly, copyright suits for monetary damages were tried in courts of law, and thus before juries."[442] Rejecting Columbia's assertion that statutory damages were equitable in nature, the Court found that an award of statutory damages served "purposes traditionally associated with legal relief, such as compensation and punishment."[443] The Court also noted the overwhelming evidence indicating that the consistent practice at common law was for juries to award damages.[444] As discussed earlier, the Court dis-

433 *See Feltner*, 523 U.S. at 342.

434 *See id.* at 342-43.

435 17 U.S.C. §§ 101-1101.

436 *See Feltner*, 523 U.S. at 343.

437 *See id.* at 344.

438 *See id.*

439 *Id.* at 345 (quoting Columbia Pictures Television v. Krypton Broad., 106 F.3d 284, 293 (9th Cir. 1997), *rev'd sub nom.* Feltner v. Columbia Pictures Television, Inc., 523 U.S. at 355.

440 *Id.* (quoting 17 U.S.C. § 504(c)(1)).

441 *Id.* at 348.

442 *Id.* at 348-49.

443 *Id.* at 352.

444 *See id.*

tinguished the part of *Tull* which had held that the amount of civil penalties should be determined by the court, and found this allocation to be in tension with other Supreme Court decisions, and also arguably dicta.[445]

The Court's decision in *Feltner* reflected its traditional Seventh Amendment jurisprudence. The Court applied the historical test in a manner consistent with the first strand of Seventh Amendment jurisprudence, looking at both the nature of the action and the remedy sought to determine if there was a right to a jury trial. The decision was also consistent with the second strand, which emphasizes the importance of preserving the jury's fact-finding role. The *Feltner* Court cited with approval its view from *Dimick v. Schiedt* that the determination of damages is a factual question "'peculiarly within the province of the jury.'"[446] Finally, *Feltner* was consistent with the fourth strand of Seventh Amendment jurisprudence, in that it was not unduly deferential to Congress, because this was *not* a situation involving administrative proceedings or matters of public rights. In *Feltner*, Congress's attempt to require a court to decide a matter traditionally within the province of the jury was found to violate the Seventh Amendment right to a jury trial.

C. City of Monterey v. Del Monte Dunes

Unlike *Markman* and *Warner-Jenkinson*, which were decided unanimously, and *Feltner*, in which Justice Scalia concurred in the judgment, *City of Monterey v. Del Monte Dunes* was a highly fractured decision. Four Justices dissented and one Justice concurred with the plurality in all but one part of the opinion.[447] The dispute concerned whether a party in an inverse condemnation case, brought under 42 U.S.C. § 1983, had a right to a jury trial.[448]

Del Monte Dunes ("Del Monte") owned beachfront property in the city of Monterey, where it wanted to develop housing units.[449] Each time Del Monte or its predecessor in interest had submitted plans to the city, the plans had been rejected.[450] Each new plan submitted by Del Monte was prepared in light of the city's prior objections, which changed from plan to plan and which always became more rigorous.[451] Finally, "[a]fter five years, five formal decisions, and nineteen different site plans," Del Monte concluded that the city would not permit it to develop the property under any circumstances.[452] Del Monte then brought suit against the city under 42 U.S.C. § 1983, alleging, inter alia, a violation of the Due Process and Equal Protection Clauses of the Fourteenth Amendment, and an uncompensated and therefore unconstitutional regulatory taking.[453]

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445 *See supra* notes 159-165 and accompanying text.

446 *Feltner*, 523 U.S. at 353 (quoting Dimick v. Schiedt, 293 U.S. 474, 486 (1935)).

447 *See* City of Monterey v. Del Monte Dunes, 119 S. Ct. 1624 (1999). The Court was unanimous as to Parts I and II of Justice Kennedy's opinion, but Justices O'Connor, Souter, Ginsburg, and Breyer dissented from Parts III and IV, and Justice Scalia, who concurred generally, did not join in Part IV-A-2.

448 *See id.* at 1631; *see also* 42 U.S.C. § 1983 (1994 & Supp. III 1998).

449 *Del Monte Dunes*, 119 S. Ct. at 1631.

450 *See id.*

451 *See id.* at 1632.

452 *Id.* at 1633.

453 *See id.* The Fifth Amendment provides that private property shall not be taken for

The district court submitted the takings and equal protection claims to the jury, but reserved for itself the decision on the substantive due process claim.[454] The jury found in favor of Del Monte on both the takings and equal protection claims, and awarded damages in the amount of $1.45 million.[455] The district court then found in favor of the city on the substantive due process claim, and stated that this ruling was not inconsistent with the jury verdict.[456] The court denied the city's motions for new trial and for judgment as a matter of law.[457] The Ninth Circuit affirmed, addressing only the takings claim, because upholding the verdict on that claim was sufficient to support the award of damages.[458]

The Supreme Court affirmed in a plurality decision in which Justice Scalia concurred to make a majority, except as to Part IV-A-2. One of the three questions presented by the city in its petition for certiorari was "whether issues of liability were properly submitted to the jury on [Del Monte's] regulatory takings claim."[459] The Supreme Court found that the issues were properly submitted to the jury, holding that "a § 1983 suit seeking legal relief is an action at law within the meaning of the Seventh Amendment."[460] The Court found that since section 1983 provided relief for invasions of a right protected under federal law, it essentially created a kind of tort liability.[461] Moreover, the damages Del Monte sought for the unconstitutional denial of compensation for a regulatory taking constituted legal relief.[462] Because Del Monte's "suit sounded in tort and sought legal relief, it was an action at law."[463]

Part IV-A-2 of Justice Kennedy's opinion failed to gain the support of Justice Scalia. Justice Kennedy, writing for the plurality, stated that the city was asking the Court to create an exception for takings claims brought via a section 1983 action.[464] The city had argued that because it was well settled that eminent domain claims had no jury trial right, and because there was no significant difference between an eminent domain claim and Del Monte's section 1983 takings claim, there should be no jury trial right on Del Monte's section 1983 takings claim.[465] The plurality distinguished eminent domain

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public use without just compensation. *See* U.S. CONST. amend. V. The Takings Clause of the Fifth Amendment has been applied to the states as part of the meaning of the Due Process Clause of the Fourteenth Amendment. *See id.* amend. XIV, § 1. Therefore an uncompensated takings claim is brought under the Fourteenth Amendment Due Process Clause.

454 *See Del Monte Dunes*, 119 S. Ct. at 1633.

455 *See id.* at 1634.

456 *See id.*

457 *See id.*

458 *See id.*

459 *Id.* at 1635. The other two questions were "(2) whether the Court of Appeals impermissibly based its decision on a standard that allowed the jury to reweigh the reasonableness of the city's land-use decision, and (3) whether the Court of Appeals erred in assuming that the rough-proportionality standard . . . applied to this case." *Id.*

460 *Id.* at 1638.

461 *See id.*

462 *See id.* at 1638-39.

463 *Id.* at 1639.

464 *See id.*

465 *See id.* The Court noted that the U.S. Court of Appeals for the Eleventh Circuit had

proceedings (condemnation proceedings) from the instant case on two grounds. First, when the government initiates condemnation proceedings, the question of liability is admitted; the only issue is the amount of damages. Thus, such proceedings do not determine legal rights.[466] On the other hand, in an inverse condemnation case like the one before the Court, there is a legal right in controversy.[467] Further, according to the plurality, in an inverse condemnation suit the landowner has the greater burden because it must "'discover the encroachment and . . . take affirmative action to recover just compensation.'"[468]

A second fundamental difference, according to the plurality, is that in a condemnation proceeding, when the government has taken property for a public use, it is acting in a lawful manner because it is providing the landowner with a forum to obtain just compensation, as required by the Constitution.[469] In the instant case, however, according to the plurality, Del Monte "was denied not only its property but also just compensation or even an adequate forum for seeking it."[470] For this reason, the plurality concluded that the action was analogous to common law tort actions to recover damages for interference with property interests.[471]

Justice Scalia refused to join the plurality in Part IV-A-2 of the opinion because he viewed the jury trial right issue as being solely determined by the section 1983 action, as long as money damages were sought.[472] Thus, he saw no purpose in distinguishing condemnation actions from inverse condemnation actions because, for him, the underlying actions were irrelevant. Justice Scalia described a section 1983 action as a prism through which many different lights may pass. In analyzing the cause of action for Seventh Amendment purposes, his view was that "the proper focus is on the prism itself, not on the particular ray that happens to be passing through in the present case."[473]

Justice Souter, writing a dissent joined by three other Justices, concluded that there was no right to a jury trial.[474] In the dissent's view, an inverse condemnation action was not significantly different from a direct condemnation action.[475] The dissenters found well-settled law that there is no right to a jury trial in a direct condemnation action, even though it is characterized as an action at law.[476] Justice Souter also disagreed that a takings action is analogous to a common law tort action.[477] He concluded that damages are not awarded in an inverse condemnation action for tortious conduct, but

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found there was no right to a jury trial on a takings claim brought under section 1983. *See id.* (citing New Port Largo, Inc. v. Monroe County, 95 F.3d 1084, 1091 (11th Cir. 1996)).

466 *See id.* at 1639-40.

467 *See id.* at 1638-39.

468 *Id.* at 1640 (quoting United States v. Clarke, 445 U.S. 253, 257 (1980)).

469 *See id.* at 1641.

470 *Id.*

471 *See id.*

472 *See id.* at 1645 (Scalia, J., concurring).

473 *Id.* (Scalia, J., concurring).

474 *See id.* at 1650 (O'Connor, Souter, Ginsburg, and Breyer, JJ., dissenting).

475 *See id.* at 1650-51 (O'Connor, Souter, Ginsburg, and Breyer, JJ., dissenting).

476 *See id.* at 1650-52 (O'Connor, Souter, Ginsburg, and Breyer, JJ., dissenting).

477 *See id.* at 1655 (O'Connor, Souter, Ginsburg, and Breyer, JJ., dissenting).

rather as "'just compensation' required by the Constitution for payment of an obligation lawfully incurred."[478]

The above summary is a simplified synopsis of a lengthy and complex decision. It is background for a discussion of the plurality's analysis and application of the Seventh Amendment in Parts IV-A-1 and IV-B, in which Justice Scalia joined, creating a majority. The analysis, which at a superficial level appears to follow *Markman*, in fact deviates substantially from the *Markman* approach and more closely resembles traditional Seventh Amendment jurisprudence.

In the introductory paragraphs of Part IV, Justice Kennedy, writing for the majority, determined that the statutory language of section 1983 did not require a jury trial, and that therefore the Court must reach the Seventh Amendment issue.[479] He then quoted verbatim the *Markman* test of Seventh Amendment applicability:

> [W]e ask, first, whether we are dealing with a cause of action that either was tried at law at the time of the founding or is at least analogous to one that was. If the action in question belongs in the law category, we then ask whether the particular trial decision must fall to the jury in order to preserve the substance of the common-law right as it existed in 1791.[480]

Although the first prong of *Markman*'s test did not include the remedy prong of the traditional historical test, Justice Kennedy considered the remedy as an important element in analogizing a section 1983 action seeking legal relief to a common law tort action. He stated that "[o]ur settled understanding of § 1983 and the Seventh Amendment thus compel the conclusion that a suit for legal relief brought under the statute is an action at law."[481] Justice Kennedy concluded that because Del Monte's suit was analogous to a common law action and sought legal relief, it was an action at law.[482] Thus, although he quoted the *Markman* version of the historical test, Justice Kennedy applied traditional Seventh Amendment jurisprudence by considering both the nature of the action and the remedy sought.

In Part IV-B, Justice Kennedy moved to the second prong of the *Markman* test, but used a phrasing somewhat different than the *Markman* language. Rather than asking "whether the particular trial decision must fall to the jury in order to preserve the substance of the common-law right as it existed in 1791,"[483] Justice Kennedy asked "whether the particular issues of liability were proper for determination by the jury."[484] He further noted that "[i]n actions at law, issues that are proper for the jury must be submitted to it 'to preserve the right to a jury's resolution of the ultimate dispute,' as guaran-

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478 *Id.* at 1657 (O'Connor, Souter, Ginsburg, and Breyer, JJ., dissenting).

479 *See id.* at 1637-38.

480 *Id.* at 1638 (citations and internal quotation marks omitted) (quoting Markman v. Westview Instruments, Inc., 517 U.S. 370, 376 (1996)).

481 *Id.*

482 *See id.*

483 *Markman*, 517 U.S. at 376.

484 *Del Monte Dunes*, 119 S. Ct. at 1642 (citing to the entire *Markman* decision generally).

teed by the Seventh Amendment."[485] This is quite different from the narrower *Markman* formulation. In the *Markman* test, the substance of the jury trial right depended upon what existed in 1791. If the "trial decision," or an analogue, did not go to the jury in 1791, it was not a part of that substance, and thus the jury trial right need not be preserved by the Seventh Amendment. Justice Kennedy's formulation appears more generic: if the issue is of the kind that is proper for jury resolution, then it must go to the jury to preserve the jury trial right. This sounds more like the traditional second strand of Seventh Amendment jurisprudence, where the court has repeatedly held that factual issues must go to the jury to preserve the substance of the jury trial guarantee.

Just as in *Markman*, no precise historical analogue was found in *Del Monte Dunes* for the specific test of liability submitted to the jury. Justice Kennedy noted, however, that in common law suits for money damages sounding in tort, questions of liability were determined by the jury.[486] He concluded, "[t]his allocation preserved the jury's role in resolving what was often the heart of the dispute between plaintiff and defendant."[487] While this conclusion might seem to be final, Justice Kennedy and the majority did not find it to be so, concluding that "these general observations" provided only "some guidance on the proper allocation between judge and jury."[488]

Next, Justice Kennedy considered precedents, finding these also were not definitive.[489] He then turned to "considerations of process and function."[490] This discussion focused on the firm historical foundation of allocating predominantly factual issues to the jury. Justice Kennedy concluded that this allocation served "'to preserve the right to a jury's resolution of the ultimate dispute.'"[491] He noted that the Court had previously described determinations of liability in regulatory takings cases as "'"essentially ad hoc, factual inquiries."'"[492] Justice Kennedy then discussed the two specific issues of liability under consideration, and found that both were factual issues proper for the jury.[493] The first issue was the easier to determine: "whether a landowner has been deprived of all economically viable use of his property is a predominantly factual question"[494] and therefore proper for the jury. The second issue dealt with "whether a land-use decision substantially advances legitimate public interests within the meaning of [the Court's] regulatory takings doctrine."[495] Justice Kennedy found this issue to be a mixed question of fact and law, and thus presented a more difficult question for the Court.[496]

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485 *Id.* (quoting *Markman*, 517 U.S. at 377).

486 *See id.* at 1643.

487 *Id.*

488 *Id.*

489 *See id.*

490 *Id.* at 1643-44.

491 *Id.* (quoting Markman v. Westview Instruments, Inc., 517 U.S. 370, 377 (1996)).

492 *Id.* at 1644 (quoting Lucas v. South Carolina Coastal Council, 505 U.S. 1003, 1015 (1992) (quoting Penn Cent. Transp. Co. v. New York City, 438 U.S. 104, 124 (1978))).

493 *See id.*

494 *Id.*

495 *Id.*

496 *See id.*

Justice Kennedy refined the second issue to the narrower question actually presented to the jury, "whether . . . the city's decision to reject a particular development plan bore a reasonable relationship to its proffered justifications."[497] Ultimately, the majority agreed with the Ninth Circuit that this narrower question was "'essentially fact-bound [in] nature,'" and held it was properly submitted to the jury.[498]

Although the majority did not make clear exactly what it meant by "process and function," it stated in that regard that "[i]n actions at law predominantly factual issues are in most cases allocated to the jury."[499] In comparing the Seventh Amendment analysis used in *Markman* and in *Del Monte Dunes*, perhaps the most interesting difference lies in the use of "function" in each case. In *Markman*, the Court described "functional considerations" as the basis for determining whether judges or juries were better qualified to construe patent claims.[500] Judges won. In *Del Monte Dunes*, at the same stage of its analysis, the majority turned to "process and function" and determined that because factual issues are in most cases allocated to juries, and because the issues in question were predominantly factual, the issues should go to the jury.[501] In *Markman*, the use of precedent, function, and statutory policies for determining the allocation of an issue between judge and jury seemed to be separate from the Seventh Amendment analysis, because the discussion of those considerations occurred only after an unequivocal finding that "the Seventh Amendment does not require terms of art in patent claims to be submitted to the jury."[502] In *Del Monte Dunes*, although not entirely clear, it appears that the discussion of precedent, function, and process was *part of* the Seventh Amendment analysis itself. The majority found that while history gave some guidance on whether pertinent issues should go to the jury, that guidance was not definitive. It was therefore necessary to consider precedent, function, and process. Yet the "function" considered in *Del Monte Dunes* was nothing like the "functional considerations" discussed in *Markman*. The majority in *Del Monte Dunes* made no effort to determine if judges or juries were better suited to determine particular issues. Rather, the majority noted that because the issues were factual, they should properly be submitted to the jury.[503]

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497 *Id.*

498 *Id.* (quoting Del Monte Dunes v. City of Monterey, 95 F.3d 1422, 1430 (9th Cir. 1996), *aff'd*, 119 S. Ct. at 1645).

499 *Id.* at 1643 (citing Baltimore & Carolina Line, Inc. v. Redman, 295 U.S. 654, 657 (1935)).

500 *See supra* notes 388-397 and accompanying text.

501 *See Del Monte Dunes*, 119 S. Ct. at 1643.

502 Markman v. Westview Instruments, Inc., 517 U.S. 370, 384 n.9 (1996).

503 It is not surprising that Justice Souter, the author of both the *Markman* decision and the *Del Monte Dunes* dissent, continued to assert that functional considerations regarding whether judge or jury is better suited to make a decision, should be used and should weigh in favor of the judge. Asserting that a takings case was essentially an issue for the court, Justice Souter stated: "Scrutinizing the legal basis for governmental action is 'one of those things that judges often do and are likely to do better than juries unburdened by training in exegesis.'" *Del Monte Dunes*, 119 S. Ct. at 1660 (O'Connor, Souter, Ginsburg, and Breyer, JJ., dissenting) (quoting *Markman*, 517 U.S. at 388).

Justice Scalia's concurring opinion adopted a view of Seventh Amendment applicability compatible with traditional jurisprudence. He stated: "I agree with the court's methodology, which, in the absence of a precise historical analogue, recognizes the historical preference for juries to make primarily factual determinations and for judges to resolve legal questions."[504]

Thus, the majority in *Del Monte Dunes*, while paying lip service to *Markman*, in fact applied a much more traditional approach to the Seventh Amendment. The recognition of a jury trial right in a section 1983 takings action was based in large measure on the historical importance of the fact/law distinction as a fundamental basis for allocation of issues to the jury.

Conclusion

While *Markman* appears to contain a rather different approach to the Seventh Amendment than that traditionally used by the Supreme Court, subsequent cases do not suggest that any radical change has taken place. Yet, it is a bit disturbing when comparing *Markman* with the recent case of *Del Monte Dunes* to find that the application of two different Seventh Amendment methodologies appears to have been necessary to produce two different results. In other words, if the Seventh Amendment methodology applied in *Del Monte Dunes* had been applied in *Markman*, with a similar emphasis on the fact/law distinction and the importance of sending factual issues to the jury, *Markman* would have turned out differently. The Court in *Markman* did not deny that there were factual issues associated with patent claim construction; it simply declared that any pertinent facts would be decided by the court as a matter of law. Conversely, if the Seventh Amendment methodology expounded in *Markman* had been applied in *Del Monte Dunes*, the result also would have been different. There would have been no emphasis on the fact/law distinction, and Justice Souter's view that judges are better equipped than juries to decide these issues would have resulted in an allocation of these issues to the court.

This inevitably suggests the possibility that the current Seventh Amendment methodology is simply result oriented—that the Justices determine the result they want to reach and devise a methodology for arriving at that result. If true, this would be unfortunate. If the Seventh Amendment guarantee is so malleable that any desired result can be obtained by changing methodology, then the Amendment's usefulness is diminished. On the other hand, although the *Markman* analysis, which removes facts from the jury, seems like a step in the wrong direction, it may not be applicable beyond areas such as patent claims construction, in which concerns about uniformity predominate. Cases such as *Feltner*, *Warner-Jenkinson*, and even *Del Monte Dunes* suggest that the Court has not moved far from the four strands of traditional Seventh Amendment jurisprudence developed since the 1930s. That jurisprudence reflects the efforts of the Supreme Court to preserve the substance of the common law civil jury trial right, while at the same time adapting practices and procedures to meet modern needs. If the Seventh Amendment is to continue to provide a valuable guarantee, then the Court's

504 *Id.* at 1649 (citations omitted).

evolving jurisprudence must strike a balance between preservation and change, a balance measured against two centuries' worth of efforts to preserve the jury's critical function—achieving a fair resolution of disputed facts in an action at law.