

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.2
PRIOR ART

Previously known subject matter in the field of a claimed invention for which a patent is being sought is referred to as "prior art." For example, previous devices, methods, publications or patents are "prior art" if they existed before the invention date. The effective filing date of the application can also determine what is considered prior art. The parties contest this date. Depending on which dates you determine, an alleged "piece of prior art" may or may not effect the validity of the '761 Patent.

I will give you instructions later regarding how to determine these dates.

In this case, Leader contends its invention date is August 19, 1999, which is its date of conception of the invention and its effective filing date is December 11, 2002. Facebook contends the invention date and the effective filing date is December 10, 2003.

If you find that the invention date is August 19, 1999 and the effective filing date is December 11, 2002, then only the following references can be considered prior art:

- (1) European Patent No. EP 1087306 ("Hubert '306")
- (2) U.S. Patent No. 6,236,994 ("Swartz '994")
- (3) iManage DeskSite 6.0 User Reference Manual, July 26, 2001

If you find that the invention date and the effective filing date is December 11, 2002, then only the following references can be considered prior art:

- (1) European Patent No. EP 1087306 ("Hubert '306")
- (2) U.S. Patent No. 6,941,313 ("Seliger '313")
- (3) U.S. Patent No. 6,430,575 ("Dourish '575")
- (4) U.S. Patent No. 6,370,538 ("Lamping '538")
- (5) U.S. Patent No. 6,236,994 ("Swartz '994")

- (6) U.S. Patent No. 6,941,313 (“Seliger ’313”)
- (7) U.S. Patent No. 6,434,403 B1 (“Ausems ’403”)
- (8) iManage DeskSite 6.0 User Reference Manual, July 26, 2001

If you find that the effective filing date is December 10, 2003, then only the following references can be considered prior art:

- (1) European Patent No. EP 1087306 (“Hubert ’306”)
- (2) U.S. Patent No. 6,430,575 (“Dourish ’575”)
- (3) U.S. Patent No. 6,370,538 (“Lamping ’538”)
- (4) U.S. Patent No. 6,236,994 (“Swartz ’994”)
- (5) U.S. Patent No. 6,941,313 (“Seliger ’313”)
- (6) U.S. Patent No. 6,434,403 B1 (“Ausems ’403”)
- (7) iManage DeskSite 6.0 User Reference Manual, July 26, 2001
- (8) Christopher Hess and Roy Campbell, A Context File System for Ubiquitous Computing Environments, Technical Report No. UIUCDCS-R-200202285 UILU-0ENG-2002-1729, Department of Computer Science, University of Illinois at Urbana-Champaign, Urbana, IL, USA, July 2002 (“Hess”)
- (9) Leader’s Leader2Leader product (“Leader2Leader”)

Once you have determined what can be considered prior art, then you must consider whether Facebook has met its burden of proving by clear and convincing evidence that such prior art affects the validity of the ‘761 Patent, which I will instruct you on later.

**FACEBOOK'S OBJECTION TO LEADER'S PROPOSED JURY
INSTRUCTION NO. 4.2**

Facebook objects to Leader's instruction as long and unduly confusing to the jury.

Further, Leader's instruction still contains inaccuracies such that it cannot be brought before jurors. For instance, Leader asserts that only if the jury finds the effective filing date to be December 10, 2003 can they consider Leader2Leader to be prior art. However, if Facebook can show that Leader2Leader was publicly disclosed or offered for sale prior to December 11, 2001, Leader2Leader can still be considered prior art, even if the effective filing date is December 11, 2002.

Finally, Leader's argument that Facebook has not met its obligations under § 282 is without merit. 35 U.S. § 282 requires as follows:

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date and the page numbers of any publication to be relied upon as anticipation of the patent in suit or, except in actions in the United States Court of Federal Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit.

The purpose of the notice required by Section 282 "is to prevent unfair and prejudicial surprise by the production of unexpected and unprepared-for prior art references at trial." *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 551 (Fed. Cir. 1998) (quoting *Eaton Corp. v. Appliance Valves Corp.*, 790 F.2d 874, 879 (Fed. Cir. 1986)) ("The solid entrenchment of the Federal Rules and the principles of orderly discovery weigh heavily against . . . argument that § 282 governs the requirement of notice of prior art despite the elaborate discovery procedures, interrogatories, and explicit directives by which the trial was managed."). Facebook provided notice as required by Section 282, and LTI cannot claim unfair or prejudicial surprise.

Facebook disclosed its invalidity contentions (including the prior art it intends to assert at trial) in writing prior to the close of written discovery in 2009. Moreover, on

April 8, 2010, more than three months before the start of the trial, Facebook served a complete and detailed expert report of Saul Greenberg, Ph.D, on invalidity that disclosed all of the prior art upon which Facebook intends to rely at trial. Dr. Greenberg specifically stated in his report that he intended to testify at trial regarding the invalidity of the patent as discussed in his report. *See* April 8, 2010 Greenberg Expert Report at 13. Leader took Dr. Greenberg's deposition and submitted its own rebuttal expert report setting forth Leader's positions on those same prior art references. There are no therefore "unexpected or unprepared-for prior art references," *ATD Corp.*, 159 F.3d at 551, that will be presented at trial. Leader cannot in good faith deny that it has had notice of Facebook's prior art references long before the 30-day period set forth in Section 282, and that it has had more than a full opportunity to examine them. Moreover, the parties have been exchanging jury instructions on invalidity since May, which included instructions identifying these same references.

There is likewise no basis for Leader's complaint with respect to Facebook's defense based on the offers for sale and public uses of Leader2Leader. As the Court is well-aware, the parties have been continuing to conduct discovery on these issue well until July, a delay that was caused by Leader's belated production of non-disclosure agreements after the close of discovery. These offers for sale and public uses are based on Leader's own conduct in commercializing Leader2Leader, so Leader cannot claim in good faith that it is unable to defend itself at trial.

The basis of Leader's argument appears to be a purely technical one -- that Facebook's disclosures did not come in the form of a pleading invoking the magic words of Section 282. But the statute imposes no such requirement. The plain language of Section 282 merely requires that Facebook give notice to Leader in "the pleadings or otherwise in writing" at least thirty days before the trial. It does not mandate or specify any particular form for such notice, and there is no dispute that such notice was provided to Leader more than three months ago. Leader's technical objection is without basis in

the statute and should therefore be rejected. Nonetheless, if the Court desires and although not required by the statute, Facebook would be willing to file a formalized pleading in the Court file setting forth the prior art references it intends to rely upon at trial (which were identified in Dr. Greenberg's expert report).

FACEBOOK'S PROPOSED JURY INSTRUCTION NO. 4.2
PRIOR ART

Under the patent laws, a person is entitled to a patent only if the invention claims in the patent is new and nonobvious in light of what came before. That which came before is referred to as "prior art." Prior art includes any of the following items received into evidence during trial:

1. any patent that issued more than one year before the effective filing date of the '761 Patent;
2. any printed publication that was published more than one year before the effective filing date of the '761 Patent;
3. any product or method that was in public use or on sale in the United States more than one year before the effective filing date of the '761 Patent;
4. any printed publication that was published prior to the invention date of the '761 Patent;
5. any published United States patent application or issued United States patent with a filing date that predates the invention date of the '761 Patent;
6. any product or method that was known or used by others in the United States prior to the invention date of the '761 Patent.

In this case, Facebook contends that the following items are invalidating prior art:

- (1) European Patent No. EP 1087306 ("Hubert '306"), whose specification is contained within U.S. Patent No. 7,590,934 ("Hubert '034")
- (2) U.S. Patent No. 6,430,575 ("Dourish '575")
- (3) U.S. Patent No. 6,370,538 ("Lamping '538")
- (4) U.S. Patent No. 6,236,994 ("Swartz '994")
- (5) U.S. Patent No. 6,941,313 ("Seliger '313")
- (6) U.S. Patent No. 6,434,403 B1 ("Ausems '403")
- (7) iManage DeskSite 6.0 User Reference Manual, July 26, 2001 or iManage DeskSite 6.0 itself ("iManage")

- (8) Christopher Hess and Roy Campbell, A Context File System for Ubiquitous Computing Environments, Technical Report No. UIUCDCS-R-200202285 UILU-0ENG-2002-1729, Department of Computer Science, University of Illinois at Urbana-Champaign, Urbana, IL., USA, July 2002 (“Hess”)
- (9) Leader’s Leader2Leader product, also known as Digital Leaderboard and Click2Lead (“Leader2Leader”)

AUTHORITY:

Modified AIPLA Model Jury Instructions § 5 (March 2008).

**LEADER'S OBJECTION TO FACEBOOK'S PROPOSED JURY
INSTRUCTIONS NOS. 4.2**

Facebook's instruction is improper because it does not identify or provide any guidance whatsoever about what references can properly be considered prior art based on the factual issues in dispute that the jury has to determine. Thus, Facebook's instruction would confuse the jury because it improperly suggests that all the asserted references can be considered prior art. A patent is presumed to be valid. 35 U.S.C. §282. The presumed date of the invention is the date the patent application is filed. *UCB, Inc., v. KV Pharmaceutical Co.*, 2010 WL 809815 at *4 (D.Del. 2010). In establishing a pre-filing date of invention, a patent holder has the burden of production, but a party challenging the patent has the burden of proof. *Id.*

In this case, Leader produced the patent application and contends that the effective filing date of the '761 Patent is the filing date of the provisional application December 11, 2002. Leader has met its burden of production. Thus, Facebook has the burden of proof of showing that Leader is not entitled to the filing date of the provisional application. Facebook's instruction is prejudicial to Leader as Facebook does not provide the jury with the proper information regarding the effective filing date of the '761 Patent and what references are relevant depending on the effective filing date or the date of invention.

Furthermore, Facebook's proposed language: "[u]nder the patent laws, a person is entitled to a patent only if the invention claims in the patent is new and nonobvious in light of what came before" adds redundant sections regarding the law of validity. Facebook's definition of "prior art" is vague, and will serve to confuse the jury.

Various pieces of alleged prior art listed in Facebook's instruction should not be included. In addition, the '934 patent is not asserted prior art in this case, and should not be included in the instruction. Facebook's expert Dr. Greenberg did not disclose the '934

patent as prior art, but merely states that the '934 patent corresponds to European Patent Application No. EP 1 087 306. In addition, the '934 patent has a filing date of January 27, 2004 and an issue date of September 15, 2009. The '761 Patent was filed prior to both of these dates, and thus the '934 patent is not prior art.

The "iManage DeskSite 6.0" ("iManage software") is also not relevant because Facebook's expert never opined on the software, nor was the software ever produced to Leader during the course of the litigation. In fact, Facebook's expert testified during deposition that he had never even used the iManage software. Deposition of Saul Greenberg, April 30, 2010, at page 192:11-12. Contrary to Facebook's contentions, there is not a working product that was disclosed during discovery that enables the iManage user manual. The disclosure in an asserted anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. MPEP 2121.01; *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003). Therefore, contrary to Facebook's contentions, a reference is not enabled simply because it includes an allegedly "working product." As the MPEP states, merely naming or describing subject matter is insufficient. Finally, Leader2Leader can only be considered prior art if the effective filing date is December 10, 2003. Nothing in Leader's instruction suggests that activities in 2001 are excluded.

Furthermore, Facebook failed to comply with the Patent Act's explicit requirement to disclose prior art it intends to rely upon pursuant to 35 U.S.C. §282, which states in pertinent part :

In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as

anticipation of the patent in suit or, except in actions in the United States Court of Federal Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires.

In all patent cases, this is a statutory requirement that must be fulfilled by providing a Rule 282 disclosure. *See Zymogenetics, Inc. v. Bristol-Myers Squibb Co.*, 1:06-cv-00500-SLR-MPT; *Pharmastem, et al v. Viacell Inc, et al.*, 1:02-cv-00148-GMS; *Finjan Software, Ltd. v. Secure Computing Corp.*, 1:06-cv-00369-GMS. The purpose of Section 282 is to prevent unfair prejudice and surprise by the production of unexpected and unprepared-for prior art references at trial. *Eaton Corp. v. Appliance Valves Corp.*, 790 F.2d 874, 879 (Fed. Cir. 1986). To this date, Facebook has failed to serve any Rule 282 disclosure, which is sufficient grounds for precluding Facebook from presenting an invalidity claim at trial. This issue was not ripe when motions in *limine* were filed, as motions *in limine* were filed before Section 282's 30 day deadline before trial. This failure to give proper disclosure is highly prejudicial to Leader who is left to guess at what will be presented at trial and is troubling given all the purported prior art that is listed on Facebook's exhibit list. Such sandbagging is exactly what the Rule 282 disclosure is intended to prevent.

The Federal Circuit upheld a decision by the Eastern District of Texas to preclude evidence of invalidity because the accused infringer failed to give notice under 35 U.S.C. § 282. *Ferguson Beauregard/Logic Controls v. Mega Systems, LLC*, 350 F.3d 1327 (Fed. Cir. 2003). In that case, the accused infringer argued the patentee was on notice because it participated in discovery, including a deposition and interrogatories, related to the prior art sought to be introduced. *Id.* The Federal Circuit, held that "the district court's

rulings, rather than being contrary to law, followed the letter of 35 U.S.C. § 282 precisely.” *Id.* Like in *Ferguson*, Facebook failed to give any Rule 282 disclosure and should be precluded from providing evidence of invalidity at trial. Simply because Leader participated in discovery does not dispose of Facebook’s duty to give proper notice under 35 U.S.C. § 282.

At the very least, Facebook should be precluded from asserting any invalidity claims beyond what is disclosed in its expert report of Dr. Greenberg and the alleged offers for sale or alleged public demonstrations not **explicitly** identified by name in Facebook’s fourth supplemental interrogatory response to Interrogatory No. 4 dated April 19, 2010.

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.4

INVENTION DATE: CONCEPTION AND REDUCTION TO PRACTICE

I will now explain to you how you will determine the invention date that I mentioned earlier.

The date of invention is either when the invention was reduced to practice or when it was conceived, provided the inventor was diligent in reducing the invention to practice. Diligence means working continuously, though not necessarily every day. Conception is the mental part of an inventive act, i.e., the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice, even if the inventor did not know at the time that the invention would work. Conception of an invention is complete when the idea is so clearly defined in the inventor's mind that, if the idea were communicated to a person having ordinary skill in the field of the technology, he or she would be able to reduce the invention to practice without undue research or experimentation. This requirement does not mean that the inventor has to have a prototype built, or have actually explained the invention to another person. But, there must be some evidence beyond the inventor's own testimony that confirms the date on which the inventor had the complete idea. Conception may be proven when the invention is shown in its complete form by drawings, disclosure to another person, or other forms of evidence presented at trial.

A claimed invention is "reduced to practice" when it has been constructed/used/ tested sufficiently to show that it will work for its intended purpose or when the inventor files a patent application. An invention may also be reduced to practice even if the inventor has not made or tested a prototype of the invention if it has been fully described in a filed patent application.

If you find that Leader has proven a conception date of August 19, 1999 and that Leader was diligent in reducing the invention to practice, then the invention date is

August 19, 1999. If you do not find that Leader has proven conception and reduction to practice, then the invention date is the same date as the effective filing date.

AUTHORITY:

Modified The Federal Circuit Bar Association Model Patent Jury Instructions § 4.3a (February 2010) which cites 35 U.S.C. § 102.

**FACEBOOK’S OBJECTIONS TO LEADER’S PROPOSED JURY
INSTRUCTION NO. 4.4**

Facebook objects to the inclusion of this instruction, as Leader has not set forth substantial evidence of conception date or diligence and reduction to practice.

Facebook further objects to this instruction on the ground that it does not emphasize an important point: “Conception must include every feature or limitation of the claims invention.” *Slip Track Sys., Inc. v. Metal-Lite, Inc.*, 304 F.3d 1256, 1262-63 (Fed. Cir. 2002). This point is important in the present case because there is a dispute between the parties as to whether Leader can show that what it allegedly conceived contained every element of the asserted claims.

In Leader’s objection, it states that “circumstantial evidence may corroborate the inventor’s testimony.” However, Leader has not set forth any “circumstantial evidence” in support of an August 1999 invention date and it is too late for them to proffer any now.

FACEBOOK'S PROPOSED JURY INSTRUCTION NO. 4.4
DATE OF INVENTION, CONCEPTION AND REDUCTION TO PRACTICE

The date of invention for a claim of a patent is presumed to be the effective filing date of the patent. A patent owner may attempt to claim an earlier date of invention if it establishes, by a preponderance of the evidence, that the invention (1) was conceived prior to the filing date of the patent application and (2) the inventor was diligent in reducing the invention to practice.

Conception is the mental part of an inventive act, i.e., the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice, even if the inventor did not know at the time that the invention would work. Conception must include every feature or limitation of the claimed invention. Conception of an invention is complete only when the idea is so clearly defined in the inventor's mind that, if the idea were communicated to a person having ordinary skill in the field of the technology, he or she would be able to reduce the entire invention to practice without undue research or experimentation. There must also be documentary evidence beyond the inventor's own testimony that independently corroborates the date on which the inventor claims to have conceived of the invention. Conception may be proven when the invention is shown in its complete form by drawings, disclosure to another person, or other forms of evidence presented at trial.

If an inventor attempts to rely on an earlier date of conception, it must show that it exercised reasonable diligence throughout the entire period between the date of conception and the date the invention was reduced to practice. This requires the inventor to show that it took specific and affirmative acts during this entire period that were directly related to the reduction to practice of the invention at issue, and that acceptable excuses be provided for any periods of inactivity. Voluntarily setting aside development of the alleged invention, or taking time to commercially exploit an invention, or a separate product or invention, do not constitute acceptable excuses.

AUTHORITY:

Stern v. Trustees of Columbia Univ. in the City of New York, 434 F.3d 1375, 1378 (Fed. Cir. 2006); *Singh v. Brake*, 222 F.3d 1362, 1367 (Fed. Cir. 2000); MPEP § 2138.06 (“Reasonable Diligence”).

LEADER'S OBJECTIONS TO FACEBOOK'S PROPOSED JURY

INSTRUCTION NO. 4.4

Leader objects to this instruction, as the date of invention is a disputed fact issue in the case and thus it is improper and prejudicial to state that the invention date is presumed to be the filing date of the patent. Facebook's objection that Leader has not put forth any evidence of conception and reduction to practice is incorrect. Leader has identified substantial evidence of conception and reduction to practice. *See* Expert Report of Dr. Herbsleb at page 9 ("It is my understanding that the inventors of the '761 Patent claim that they conceived of the invention of the '761 Patent by no later than August 19, 1999. An example of corroborating evidence that I have reviewed is the document titled "LEADER Project Functional Specification" and corresponding email dated August 19, 1999 (LTI_012960-88). After reviewing these documents, it is my opinion that these documents corroborate that the inventors of the '761 Patent had a permanent idea of the complete and operative invention by August 19, 1999.").

Facebook's instruction is not based on the law or a model jury instruction. An example of a misstatement of law is Facebook's statement that the date of invention is the filing date, as opposed to the effective filing date of the patent. *See e.g., Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000) ("[T]he date of the invention is presumed to be the filing date of the *parent* application.") (italics added).

Facebook also attempts to shift the burden of proof to Leader in their instruction 4.4 by stating, "a patent owner may attempt to claim an earlier date of invention if it establishes, by a preponderance of the evidence" In establishing a pre-filing date of invention, a patent holder has the burden of production, but a party challenging the patent

has the burden of proof. *UCB, Inc. v. KV Pharmaceutical Company*, 2010 WL 809815 (D. Del. 2010). In *Power Oasis, Inc. v. T-Mobile USA, Inc.*, a case regarding the priority date of a continuation-in-part application (CIP), the district court concluded that, “when a dispute arises concerning whether a CIP patent is entitled to priority to the date of the original application and the Patent Office has not addressed the issue, the burden of proof ordinarily should rest with the party claiming priority to the date of the original application.” 2007 WL 962937 at *8 (D.N.H. 2007). The Federal Circuit, on appeal held there was no presumption that claims in a CIP are all entitled to the earliest effective filing date absent an interference or determination of priority during prosecution incident to a rejection. *Power Oasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299 (Fed. Cir. 2008). While the ‘761 Patent does not have this added burden of showing entitlement of claims to the parent application because it is not a CIP application, the examiner did make a determination as to the priority of the ‘761 Patent in an office action. See June 3, 2005 Office Action at 2 (“The disclosure is objected to because of the following informalities: Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date claim priority to the provisional application. . . . The specification should be completely checked for missing information and corrected. Appropriate action is required.”). This shows the examiner considered the provisional application and Leader properly claimed priority to the provisional overcoming the examiner’s objection, as evidenced by the issuance of the ‘761 Patent.

The Federal Circuit in *Technology Licensing Corp. v. Videotek, Inc. and Gennum Corp.* outlined the events that occur when an accused infringer attacks the validity of a patent. 545 F.3d 1316, 1328 (Fed. Cir. 2008). First, the accused infringer has the initial

burden of production by coming forward with evidence of anticipatory prior art. *Id.* at 1327. Second, the patentee must “come forward with evidence to prove entitlement to claim priority to an earlier filing date.” *Id.* Because Leader has identified the basis for why it is entitled to the provisional application as its filing date, the effective filing date is December 11, 2002. Facebook has the ultimate burden of showing by clear and convincing evidence that the contrary is true. *Technology Licensing Corp. v. Videotek, Inc. and Gennum Corp.*, 545 F.3d 1316, 1328 (“It is a long-standing rule of patent law that, because an issued patent is by statute presumed valid, a challenger has the burden of persuasion to show by clear and convincing evidence that the contrary is true.”).

In addition, Facebook improperly states the law by claiming that “there must also be documentary evidence beyond the inventor’s own testimony that independently corroborates the date” This will confuse the jury because any circumstantial evidence may corroborate the inventor’s testimony, not only documentary evidence. *See P&G v. Teva Pharms. USA, Inc.*, 536 F. Supp.2d 476, 491 (D. Del. 2008).

In addition, the language used by Facebook that “Conception must include every feature or limitation of the claimed invention,” is language from a case involving an interference proceedings, and will confuse the jury. The evidentiary standard for antedating a reference is not the same as the Patent Office requirement for establishing priority in an interference contest. *Loral Fairchild Corp. v. Matsushita Elec. Indus. Co.*, 266 F.3d 1358, 1366 (Fed. Cir. 2001)(standing for the proposition that “[t]he rule requires an evaluation of *all* pertinent evidence when determining the credibility of an inventor's testimony.”). Inventors' affidavits have always been admissible to antedate a reference. *Id.* Leader has presented corroborating evidence of an August 19, 1999

invention date, and Facebook's assertion to the contrary is not a proper objection to proposed jury instructions. "Conception is defined as the `formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice,'" is the proper legal standard to use when examining conception in a district court. *See Stern v. Trustees of Columbia University, New York*, 434 F. 3d 1375,1378 (Fed. Cir. 2006).

Further, this instruction is incomplete as it omits a definition of reduction to practice. Leader's instruction follows the model jury instruction informing the jury that "A claimed invention is "reduced to practice" when it has been constructed/used/ tested sufficiently to show that it will work for its intended purpose or when the inventor files a patent application. An invention may also be reduced to practice even if the inventor has not made or tested a prototype of the invention if it has been fully described in a filed patent application."

Facebook's modified quotations of law and failure to rely on any model jury instruction evidences the unbalanced and prejudicial nature of Facebook's proposed instruction. Federal Rules of Evidence 403.

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.4A
PRIOR ART – EFFECTIVE FILING DATE

Leader filed a “provisional” patent application on December 11, 2002. You must determine whether the asserted claims of the '761 Patent are sufficiently supported by the provisional application. If they are, this date is the effective filing date. Leader is entitled to rely on the filing date of its provisional application to establish the effective filing date if the application teaches one of skill in the art how to make the claimed invention of the '761 Patent.

If the Patent Office has considered the provisional application, then the effective filing date is the filing date of the provisional application. If the Patent Office did not consider the provisional application, then Leader must prove by preponderance of evidence that the provisional application supports the asserted claims of the '761 Patent in order to establish that the effective filing date is December 11, 2002.

If you determine that Leader has shown by a preponderance of the evidence that the effective filing date is December 11, 2002, then Facebook must prove by clear and convincing evidence that this is not the correct effective filing date.

If you find that Leader is entitled to an effective filing date that is the same date as the filing date of the provisional application, then December 11, 2002 is the effective filing date of the '761 Patent for purposes of validity and the prior art.

AUTHORITY:

PowerOasis, Inc. v. T-Mobile USA, Inc., 522 F.3d 1299 (Fed. Cir. 2008); *Technology Licensing Corp. v. Videotek, Inc. and Gennum Corp.*, 545 F.3d 1316, 1328 (Fed. Cir. 2008).

**FACEBOOK’S OBJECTIONS TO LEADER’S PROPOSED JURY
INSTRUCTION NO. 4.4A**

Facebook objects to this proposed instruction on the ground that it misstates the law by glossing over or entirely ignoring multiple requirements. Under 35 U.S.C. 119, a patent is entitled to the filing date of the provisional application only if it discloses the alleged invention “in the manner provided by the first paragraph of section 112 of this title [35 U.S.C. 112(1)]...” 35 U.S.C. 119(e)(1). The Federal Circuit has recently confirmed that 35 U.S.C. 112(1) contains separate written description and enablement requirements. *See Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1345 (Fed. Cir. 2010) (en banc). “Every patent must describe an invention. It is part of the *quid pro quo* of a patent; one describes an invention, and, if the law's other requirements are met, one obtains a patent. The specification must then, of course, describe how to make and use the invention (i.e., enable it), but that is a different task.” *Id.*

Contrary to this controlling precedent, Leader’s instruction omits the written description requirement, which requires that the application disclose each and every element of the claimed invention. *See id.* at 1353 (“Requiring a written description of the invention limits patent protection to those who actually perform the difficult work of ‘invention’-that is, conceive of the complete and final invention with all its claimed limitations-and disclose the fruits of that effort to the public.”) (emphasis added). Because Leader’s instruction ignores this critical requirement, it should be rejected.

Worse, Leader has compounded this flaw by misstating the standard for enablement, the only requirement addressed by Leader's instruction. It ignores, for example, that the requirement that the application teach one of ordinary skill in the art to make and use the claimed invention, and do to so without undue experimentation." *Id.* at 1361 (quoting *Martek Biosciences Corp. v. Nutrinova, Inc.*, 579 F.3d 1363, 1378 (Fed. Cir. 2009)) ("To meet the enablement requirement, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation."). Under Leader's instruction, even if it took one of ordinary skill in the art 30 years of nonstop and excessive experimentation to convert the sparse provisional into a system that met the claim limitations, Leader would nonetheless be entitled to "rely" on the provisional application filing date. That is clearly not the law.

Leader's arguments regarding the priority date to which the '761 patent is entitled are based on a fundamentally unsupported factual assertion -- that the U.S. Patent Office actually determined that the '761 patent was entitled to the benefit of the December 11, 2002 filing date. But there is no evidence that the USPTO even glanced at the provisional patent application, let alone determined that the claims of the '761 patent should receive the benefit of the priority date of that application. Leader's sole basis for claiming that the USPTO "considered" the priority date issue is a statement in the June 3, 2005 Office Action, the first Office Action issued during the examination of the '761 application. The beginning of that Office Action merely noted that the first paragraph of the specification of Leader's *non-provisional* December 2003 patent application did not comply with the filing formalities and ministerial technicalities for identifying related applications. That first paragraph stated:

CROSS-REFERENCE TO RELATED APPLICATIONS

This application claims priority under 35 U.S.C. (section symbol) 119(e) from U.S. Provisional Patent Application Serial No. 60/432,255 entitled "METHOD FOR DYNAMIC ASSOCIATION OF ELECTRONICALLY STORED INFORMATION WITH ITERATIVE WORKFLOW CHANGES", filed December 11, 2002; and is related to co-pending U.S. Patent Application Ser. No. ____ (Atty Dkt. No. LEADP101USA) entitled "CONTEXT INSTANTIATED APPLICATION PROTOCOL" filed on December 10, 2003.

See Specification for '761 patent, filed December 10, 2003, at 1, lines 5-12.

The initial Office Action dated June 3, 2005 objected to the fact that Leader had improperly left a "blank" where the second application number was referenced, and required that the actual number be filled in:

The disclosure is objected to because of the following informalities: Application has not complied with one or more of the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. as follows: there is missing information such as application number and filing date for the following (see specification) for example, page 1, lines 5-12. The specification should be completely checked for missing information and corrected. Appropriate action is required.

June 3, 2005 Office Action, at page 2.

The Examiner's objection mistakenly stated that the provisional patent application number was missing, but it was actually provided in the original specification. The missing application number was actually for another non-provisional application filed on the same day as the non-provisional application for the '761 patent, an application that is totally irrelevant to the priority date issue. Six months later, the applicants filed an amendment to the specification that changed the "blank" to the correct patent application number and made other non-substantive changes to that paragraph, and that was the end of the matter. See November 3, 2005 Amendment. This non-event simply does not support Leader's speculation that the USPTO considered the priority date issues, for

several reasons.

First, provisional patent applications are generally not examined by the USPTO. *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1367 n. 7 (Fed. Cir. 2008) (noting that provisional patent applications are not examined by the Patent Office.). There is no evidence that the application was ever reviewed in any way, let alone to determine whether the application disclosed all elements of the issued claims. The only reference to the provisional application in the entire prosecution history was the technical objection to the ministerial failure of the applicants to "fill in the blank" to include patent application number that was not even related to the provisional patent application. Moreover, even if one indulged the notion that the USPTO looked at the provisional patent application in preparing the June 3, 2005 Office Action, it still would not support Leader's speculation that the USPTO made a determination as to priority date issues. This is because the claims of the '761 patent underwent massive changes and amendments during the year that followed the June 3 Office Action. At the time the June 3 Office Action was issued, the claims of the '761 patent application did not yet include a requirement that context information be stored in "metadata," nor the requirement of dynamically updating the metadata upon the user's movement to a second context, user workspace or user environment. Thus, Leader has no basis to speculate that the USPTO "considered" whether the provisional application disclosed claim limitations that did not even exist in the claims under consideration at that time.

Second, Leader misstates the law. The law cited by Leader is clear that an applicant is entitled to a presumption of priority to the earlier-filed application only if the USPTO made an actual determination as to the priority date. See *Technology Licensing*

Corp. v. Videotek, Inc., 545 F.3d 1316, 1330-31 (Fed. Cir. 2008) (“However, if the Patent Office has made a determination as to the priority date, the patent is presumed entitled to the priority date of the parent application.”). Leader does not even argue that the USPTO made any such determination. Leader instead attempts to dance around this requirement by asserting that the USPTO in some manner “addressed” or “considered” the priority date issue through the June 3, 2005 Office Action, but law requires an actual determination as to priority date issues. Not only is there is no evidence that this ever happened, but as noted above, it would have been impossible given the status of the claims at that time.

The prosecution record is clear and undisputed, and contains no evidence that the USPTO gave any attention to the provisional application, let alone determined any priority date issue. Leader's jury instruction, which improperly assumes the opposite, should be rejected.

Finally, Leader contends that if Facebook disputes what “happened” at the PTO, this is an issue of fact for the jury to decide. However, Leader’s instruction informs the jury on the *law*, which does not state that if the PTO ever glanced at the provisional—which Facebook contends it did not—Leader is automatically entitled to the provisional date and Facebook has no ability to contest this. Leader’s instruction tells the jury this is the law, and thus, cannot be used to instruct the jury.

FACEBOOK'S PROPOSED JURY INSTRUCTION NO. 4.4A
PRIOR ART – PATENT PRIORITY DATE

As I mentioned above, Facebook contends that certain offers for sale and public uses invalidate the '761 patent because they occurred more than one year prior to the filing of Leader's patent application on December 10, 2003. Facebook also contends that certain prior art references invalidate the '761 patent because they were published more than one year before December 10, 2003.

Leader filed a "provisional" patent application on December 11, 2002. You must determine whether the asserted claims of the '761 patent are entitled to the benefit of the filing date of the provisional application. Leader contends that the asserted claims of the '761 patent are entitled to the filing date of the provisional application, while Facebook contends that the asserted claims are not.

A provisional application is an inexpensive technique whereby an inventor can file a document with the U.S. Patent and Trademark Office providing a description of its alleged invention. The provisional application is not examined by the U.S. Patent and Trademark Office, and the inventor has one year from its filing date to file a placeholder while an inventor determines whether or not to spend the money required for full examination of a patent. A provisional application cannot support later filed claims unless it contains each and every element of the asserted claims in the issued patent. Here, in order for Leader to be entitled to use its provisional filing date, December 11, 2002, Leader must prove that the provisional included each and every element of the asserted claims of the '761 patent.

AUTHORITY:

New Railhead Mfg., LLC v. Vermeer Mfg. Co., 298 F.3d 1290, 1294 (Fed. Cir. 2002); *Eli Lilly & Co. v. Barr Labs.*, 251 F.3d 955, 974 (Fed. Cir. 2001); *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299 (Fed. Cir. 2008).
See Provisional Application for Patent, available at <http://www.uspto.gov/patents/resources/types/provapp.jsp> (Nov. 2, 2005).

**LEADER’S OBJECTIONS TO FACEBOOK’S PROPOSED JURY
INSTRUCTION NO. 4.4A**

Leader objects to this instruction, as Leader is entitled to the effective filing date of the provisional application, as explained below. Leader further objects to this instruction because Facebook has not relied on a model jury instruction, but relies solely on self-serving modified quotations from case law and unnecessarily repeats Facebook’s purported allegations against Leader. In addition, Facebook’s proposed instruction does not instruct the jury on how to determine whether the asserted claims are entitled to the provisional application’s filing date. In *Technology Licensing Corp. v. Videotek, Inc. and Gennum Corp.*, the Federal Circuit outlined the events that occur when an accused infringer attacks the validity of a patent. 545 F.3d 1316, 1328 (Fed. Cir. 2008). First, the accused infringer has the initial burden of production by coming forward with evidence of anticipatory prior art. *Id.* at 1327. Second, the patentee must “come forward with evidence to prove entitlement to claim priority to an earlier filing date.” If a patent has not been considered by the Patent Office, the patentee must only provide “sufficient evidence and argument to show that an ancestor to the [] patent . . . contains a written description that supports all the limitations of . . . the claim being asserted.” *Id.* at 1328 (Fed. Cir. 2008). However, if the Patent Office has made a determination as to the priority date, the patent is presumed entitled to the priority date of the parent application. *See id.* at 1330-31.

In Leader’s case, the Patent Office did make a determination as to the priority of the ‘761 Patent in a rejection. *See* June 3, 2005 Office Action at 2 (“The disclosure is objected to because of the following informalities: Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date claim priority to the provisional application. . . . The specification should be completely checked for missing information and corrected. Appropriate action is required.”). This shows the examiner considered the provisional application and Leader properly claimed priority to the

provisional overcoming the examiner's objection, evidenced by the issuance of the '761 Patent. This is sufficient evidence that the Patent Office addressed the issue of the effective filing date and therefore, Leader is entitled to the effective filing date of December 11, 2002. To the extent that Facebook disputes what the Patent Office did, then it is a question of fact for the jury to decide after receiving the evidence. Facebook is attempting to prevent a proper instruction on the law because it disputes a factual issue for the jury to decide, namely whether the Patent Office considered the provisional application. The failure to instruct a jury on this law renders Facebook's instruction unbalanced and prejudicial.

Furthermore, Leader has an expert who will testify regarding the provisional application's support of the claimed invention of the '761 Patent. Thus, the burden of going forward is on Facebook to prove by clear and convincing evidence that the '761 Patent is not entitled to the earlier filing date of the provisional application. *See id.* Facebook, however, fails to provide any instruction regarding its burden of proof on the issue, despite the fact that this is an issue that Facebook is raising with respect to the validity of the '761 Patent and falls squarely on Facebook to prove. In addition, Facebook mischaracterizes the law in its last sentence of jury instruction 4.4A by stating that "Leader must prove that the provisional included each and every element of the asserted claims of the '761 Patent." The Federal Circuit has held that to satisfy the written description requirement, the disclosure of the earlier filed application must describe the later claimed invention "in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought." *Id.* at 1331. In addition, "while the earlier application need not describe the claimed subject matter in precisely the same terms as found in the claims at issue, the prior application must 'convey with reasonable clarity to those skilled in the art that, as of the filing date sought [the inventor] was in possession of the invention.'" *Id.* at 1331-1332. Thus Facebook's instruction misleads the jury into thinking the provisional must have supported the claims in precisely the same terms.

Facebook's characterization of a provisional application is also not proper for a jury instruction. *See e.g.*, "A provisional application is an inexpensive technique . . ."; "an inventors determines whether or not to spend the money . . .". Facebook's proposal also is argumentative and prejudicial. Federal Rules of Evidence 403.

DISPUTED PROPOSED JURY INSTRUCTION NO. 4.5
ANTICIPATION

A person cannot obtain a patent if someone else already has made an identical invention. Simply put, the invention must be new. An invention that is not new or novel is said to be “anticipated by the prior art.” Under the U.S. patent laws, an invention that is “anticipated” is not entitled to patent protection. To prove anticipation, Facebook must prove with clear and convincing evidence that the claimed invention is not new.

[In determining whether the single item of prior art anticipates a patent claim, you should take into consideration not only what is expressly disclosed in the particular item of prior art, but also what inherently resulted from its practice. This is called “inherency.” To establish inherency, the evidence must make clear that the prior art either necessarily resulted in the missing descriptive matter and that it would be so recognized by a person of ordinary skill of the art at the time the patent application was filed. It is not required, however, that the person of ordinary skill would have recognized the inherent disclosure. Thus, the prior use of the patented invention that was unrecognized and unappreciated can still be an invalidating anticipation.]

In this case, Facebook contends that Claims 1, 4, 7, 9, 11, 16, 21, 23, 25, 31 and 32 of the ‘761 Patent are anticipated. To anticipate a claim, each and every element in the claim must be present in a single item of prior art [that is dated at least one year prior to the effective filing date]. You may not combine two or more items of prior art to prove anticipation. In determining whether every one of the elements of the claimed invention is found in the prior art you should take into account what a person of ordinary skill in the art would have understood from his or her examination of the particular prior art.

You must keep these requirements in mind and apply them to each piece of prior art you consider in this case. There are additional requirements that apply to the particular categories of anticipation that Facebook contends apply in this case. I will now instruct you about those.

AUTHORITY:

Modified AIPLA Model Jury Instructions § 6 (March 2008) which cites *Toro Co. v. Deere & Co.*, 355 F.3d 1313, 1320-1321 (Fed. Cir. 2004); *Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1377-1378 (Fed. Cir. 2003); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1346-1347 (Fed. Cir. 1999); *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed. Cir. 1995); *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992); *Cont'l Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1267-1269 (Fed. Cir. 1991); *Buildex, Inc. v. Kason Indus., Inc.*, 849 F.2d 1461, 1463 (Fed. Cir. 1988).

**LEADER'S SUPPORT FOR DISPUTED PROPOSED JURY
INSTRUCTION NO. 4.5**

Leader objects to Facebook's proposed language in brackets in paragraph 2 regarding inherency. None of Facebook's experts have disclosed an opinion regarding inherency. Thus, inherency is not an issue in the case and an instruction is unnecessary, prejudicial and likely to confuse the jury.

**FACEBOOK'S SUPPORT FOR DISPUTED PROPOSED JURY
INSTRUCTION NO. 4.5**

Facebook objects to Leader's proposed instruction as it eliminates the section of AIPLA Model Jury Instructions § 6 that discusses inherency. Facebook also objects to the phrase "that is dated at least one year prior to the effective filing date" as this does not describe all types of prior art at issue in this case. As earlier instructions explain the date requirements for anticipatory prior art references, this phrase is unnecessary in this instruction.

DISPUTED PROPOSED JURY INSTRUCTION NO. 4.5A
ANTICIPATION – INCORPORATION BY REFERENCE

As I mentioned earlier, in order to show that a claim is anticipated, each and every element in the claim must be present in a single piece of prior art. However, material that is not explicitly contained in the single, prior art document may still be considered for purposes of anticipation if that material is incorporated by reference into the document.

Facebook contends that U.S. Patent No. 6,370,538 (“Lamping ’538”) and U.S. Patent No. 6,941,313 (“Seliger ’313”) are prior art references that anticipate certain asserted claims of the ’761 patent. Lamping ’538 incorporates by reference the disclosures of U.S. Patent No. 6,380,179 to Karin Petersen (“Petersen ’179”), which has been entered into evidence as Exhibit ___. Seliger ’313 incorporates by reference U.S. Patent No. 7,346,648 (“Seliger ’648”), which has been entered into evidence as Exhibit _

[Leader contends that the ’538 and the ’313 patents are not prior art should the jury determine that the effective filing date is December 11, 2002 and/or that the invention date is August 19, 1999.]

You are hereby instructed that Lamping ’538 and Petersen ’179 are to be treated as a single prior art reference for determining whether they anticipate the asserted claims of the ’761 patent. You are further instructed that Seliger ’313 and Seliger ’648 are to be treated as a single prior art reference for determining whether they anticipate the asserted claims of the ’761 patent.

AUTHORITY:

Advanced Display Systems, Inc. v. Kent State University, 212 F.3d 1272, 1283 (Fed. Cir. 2000); *Harari v. Hollmer*, ___ F.3d ___, 2010 WL 1540911, at *2-3 (Fed. Cir. Apr. 19, 2010).

**LEADER'S SUPPORT FOR DISPUTED PROPOSED JURY
INSTRUCTION NO. 4.5A**

Leader has provided the language in brackets to make clear to the jury that the references that Facebook is attempting to claim are incorporated by reference should only be considered if the jury determines that the invention date and effective filing date is December 10, 2003. Since there is an affirmative jury instruction that there is incorporation by reference, this sentence is necessary to clarify that incorporation by reference does not apply in the event the jury makes certain findings regarding the invention date and effective filing date.

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.6

ANTICIPATION: PRIOR PUBLIC USE

A patent claim is invalid in this case by anticipation if the invention defined in that particular claim was publically used more than one year before the effective filing date. To prove public use of a particular claim, Facebook must prove by clear and convincing evidence that (1) Leader disclosed a product that meets all the elements of that claim to the public more than one year before the effective filing date and (2) the invention disclosed in that claim was ready for patenting when alleged public use occurred.

An invention is publicly used if it is used by the inventor or by a person who is not under any limitation, restriction, non-disclosure agreement or obligation of secrecy to the inventor. That is, the absence of affirmative steps to conceal the invention can be evidence of a public use. However, secret use by a third party is not considered public use. Mere knowledge of the invention by the public is not sufficient. Experimental use, which I will instruct you on later, is not public use.

An invention is ready for patenting either when it is reduced to practice or when the inventor has enabled the invention by preparing drawings or other descriptions of the invention sufficient to allow a person of ordinary skill in the art to make or use the invention.

Facebook contends that Claims 1, 4, 7, 9, 11, 16, 21, 23, 25, 31 and 32 of the '761 Patent are invalid because the Leader invention was publicly used in the United States more than one year before the effective filing date. As noted above, your

determination of what the effective filing date is will effect whether or not you find that public use has occurred.

AUTHORITY:

Modified AIPLA Model Jury Instructions § 6.2 (March 2008) which cites 35 U.S.C. § 102(a), (b); *SmithKline Beecham Corp. v. Apotex Corp.*, 365 F.3d 1306, 1316-20 (Fed. Cir. 2004); *Netscape Commc'ns Corp. v. Konrad*, 295 F.3d 1315, 1320-23 (Fed. Cir. 2002); *Grain Processing Corp. v. Am. Maize-Prods. Co.*, 840 F.2d 902, 906 (Fed. Cir. 1988); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1265-67 (Fed. Cir. 1986); *Kinzenbaw v. Deere & Co.*, 741 F.2d 383, 390-91 (Fed. Cir. 1984); *TP Lab., Inc. v. Prof'l Positioners, Inc.*, 724 F.2d 965, 970-72 (Fed. Cir. 1984); *WL Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1549-50 (Fed. Cir. 1983); *In re Smith*, 714 F.2d 1127, 1134-37 (Fed. Cir. 1983); *See also Invitrogen Corp. v. Biocrest Mfg., L.P.*, 424 F.3d 1374, 1380 (Fed. Cir. 2005).

**FACEBOOK'S OBJECTIONS TO LEADER'S PROPOSED JURY
INSTRUCTION NO. 4.6**

Facebook objects to Leader's instruction, as it reiterates portions of the experimental use instruction that Leader has included as a separate Instruction No. 4.8. This unnecessary repetition is prejudicial to Facebook. In particular, Leader includes certain aspects of the experimental use doctrine, but does not mention that "a test done primarily for marketing, and only incidentally for technological improvement, is not an experimental use, but a public use." Rather than include the entire doctrine in this instruction, it should be left to Instruction No. 4.8.

Leader also fails to mention that commercial use by Leader, even if secret, could still be considered public use.

Facebook contends that *Invitrogen* finds that the entire inquiry of public use is not determined by the totality of the circumstances; however, it cites to various factors that may affect the analysis of whether the use is sufficiently public. This is what Facebook's instruction conveys. However, if the court wishes to avoid the use of the language of "totality of the circumstances," Facebook proposes the following alternative instruction:

Facebook contends that claims 1, 4, 7, 9, 11, 16, 21, 23, 25, 31 and 32 of the '761 Patent are invalid because the alleged invention described in those claims was in "public use" more than one year before the effective filing date of the patent.

Any use of the alleged invention of a patent by any person who is under no limitation, restriction or obligation of secrecy to the inventor may constitute a "public use" that invalidates the patent if the use occurred more than one year prior to the effective filing date of the patent. For example, a demonstration of a product that embodies the alleged invention of a patent claim may constitute a "public use" that renders the claim

invalid if the person who received the demonstration was under no legal obligation to the inventor to maintain its secrecy. The absence of affirmative steps to maintain the secrecy of a prior use of the alleged invention is evidence of a public use.

The law does not require a prior use of an alleged invention be widely disseminated in order to qualify as a "public" use. The disclosure of the invention to even a single third party may qualify as a "public" use provided that the third party was under no legal obligation to the inventor to maintain its secrecy.

In addition, commercial use of the alleged invention by the inventor, even if the use is secret, may also be considered a "public use."

AUTHORITY:

Final Jury Instruction No. IV.4, *Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc.*, 04-cv-1371-JJF (D. Del. Sept. 21, 2007).

Modified AIPLA Model Jury Instructions § 6.2 (March 2008) which cites 35 U.S.C. § 102(a), (b); *SmithKline Beecham Corp. v. Apotex Corp.*, 365 F.3d 1306, 1316-20 (Fed. Cir. 2004); *Netscape Commc'ns Corp. v. Konrad*, 295 F.3d 1315, 1320-23 (Fed. Cir. 2002); *Grain Processing Corp. v. Am. Maize-Prods. Co.*, 840 F.2d 902, 906 (Fed. Cir. 1988); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1265-67 (Fed. Cir. 1986); *Kinzenbaw v. Deere & Co.*, 741 F.2d 383, 390-91 (Fed. Cir. 1984); *TP Lab., Inc. v. Prof'l Positioners, Inc.*, 724 F.2d 965, 970-72 (Fed. Cir. 1984); *WL Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1549-50 (Fed. Cir. 1983); *In re Smith*, 714 F.2d 1127, 1134-37 (Fed. Cir. 1983).

Eolas Techs. Inc. v. Microsoft Corp., 399 F.3d 1325 (Fed. Cir. 2005).

FACEBOOK'S PROPOSED JURY INSTRUCTION NO. 4.6
PRIOR PUBLIC USE

Facebook contends that 1, 4, 7, 9, 11, 16, 21, 23, 25, 31 and 32 of the '761 Patent are anticipated because the invention defined in those claims was publicly used more than one year before the filing date of the patent.

A public use by any person, including Leader or any Leader inventor may invalidate the patents-in-suit if it occurred one year or more prior to the effective filing date of the '761 patent. Demonstrations of a product embodying an invention may constitute "public uses" that bar patentability. Further, commercial use by Leader, even if secret, may also be considered a "public use."

Whether or not a use is sufficiently public is determined by looking at the totality of the circumstances, including the following factors: whether the inventor secured a pledge of secrecy to whom the invention was disclosed or before whom a product embodying the invention was used; the extent to which the inventor retained control over the invention and dissemination of information concerning the invention during the period of its use; the number of people to whom the invention or a product embodying the invention was disclosed; whether, if the inventor is relying on a claim of experimental use, records were kept of the progress of the experiment; whether the use of a product embodying the invention inured to the benefit of any member of the public; whether the product embodying the invention was still in the development stage; and whether the person to whom the invention was disclosed or for whose benefit a product embodying the invention was used was charged a fee.

If you determine that the totality of the circumstances shows that a public use by any person occurred prior one year or more prior to the effective filing date, then you must find the '761 patent is invalid.

AUTHORITY:

Netscape Comm'ns. Corp. v. Konrad, 295 F.3d 1315 (Fed. Cir. 2002).
Sys. Mgmt. Arts. Inc. v. Avesta Techs., Inc., 87 F. Supp. 2d 258 (S.D.N.Y. 2000) (citing *Baxter Int'l v. COBE Labs., Inc.*, 88 F.3d 1054 (Fed. Cir. 1996); *Beachcombers v. WildeWood Creative Prods.*, 31 F.3d 1154 (Fed. Cir. 1994); *Harrington Mfg. Co. v. Powell Mfg. Co.*, 815 F.2d 1478 (Fed. Cir. 1986); *In re Kaslow*, 707 F.2d 1366 (Fed. Cir. 1983); *Faulkner v. Baldwin Piano & Organ Co.*, 561 F.2d 677 (7th Cir. 1977)).

Articulate Sys., Inc. v. Apple Computer, Inc., 53 F. Supp. 2d 62 (D. Mass. 1999) (citing *In re Smith*, 714 F.2d 1127 (Fed. Cir. 1983); *Tone Bros., Inc. v. Sysco Corp.*, 28 F.3d 1192 (Fed. Cir. 1994); *Lough v. Brunswick Corp.*, 86 F.3d 1113 (Fed. Cir. 1996); *Baker Oil Tools, Inc. v. Geo Vann, Inc.*, 828 F.2d 1558 (Fed. Cir. 1987); *Sinskey v. Pharmacia Ophthalmics, Inc.*, 982 F.2d 494 (Fed. Cir. 1992)).

Final Jury Instruction No. IV.4, *Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc.*, 04-cv-1371-JJF (D. Del. Sept. 21, 2007).

Modified AIPLA Model Jury Instructions § 6.2 (March 2008) which cites 35 U.S.C. § 102(a), (b); *SmithKline Beecham Corp. v. Apotex Corp.*, 365 F.3d 1306, 1316-20 (Fed. Cir. 2004); *Netscape Comm'ns Corp. v. Konrad*, 295 F.3d 1315, 1320-23 (Fed. Cir. 2002); *Grain Processing Corp. v. Am. Maize-Prods. Co.*, 840 F.2d 902, 906 (Fed. Cir. 1988); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1265-67 (Fed. Cir. 1986); *Kinzenbaw v. Deere & Co.*, 741 F.2d 383, 390-91 (Fed. Cir. 1984); *TP Lab., Inc. v. Prof'l Positioners, Inc.*, 724 F.2d 965, 970-72 (Fed. Cir. 1984); *WL Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1549-50 (Fed. Cir. 1983); *In re Smith*, 714 F.2d 1127, 1134-37 (Fed. Cir. 1983).

**LEADER'S OBJECTIONS TO FACEBOOK'S PROPOSED JURY
INSTRUCTION NO. 4.6**

Unlike Facebook's proposed instruction, Leader's instruction fairly describes the effective filing date as being the key date for the jury to decide. Leader also objects to this instruction because Facebook's instruction entirely fails to provide the requisite element of "ready for patenting." *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 424 F.3d 1374, 1380 (Fed. Cir. 2005).

In fact, Facebook has omitted portions of the model instruction that properly define anticipation, such that Facebook's instruction does not provide the jury the test for public use which includes the "consideration of evidence relevant to experimentation, as well as, inter alia, the nature of the activity that occurred in public; public access to the use; confidentiality obligations imposed on members of the public who observed the use; and commercial exploitation." *Invitrogen*, 424 F.3d at 1380. Facebook's proposal omits the following from the model instruction:

[u]se by a third party is not public. If the public use was an experimental use performed in order to bring the invention to perfection or to determine if the invention was capable of performing its intended purpose then such a use does not invalidate the claim.

The omission of any reference to the experimental use element is prejudicial to Leader because experimental use means there was no public use. Indeed, this is an issue in this case to the extent Leader is not entitled to rely on the filing of its provisional patent application as the effective filing date. Omission of this factor also makes the instruction incomplete and unbalanced.

In addition, the totality of the circumstances test cited by Facebook for determining public use has been explicitly rejected by the Federal Circuit. *See Invitrogen*

Corp. v. Biocrest Mfg., L.P., 424 F.3d 1374, 1380 (Fed. Cir. 2005) (“The language in *Netscape* and *Bernhardt* should not be construed to resurrect a totality of the circumstances test for determining whether an “invention was ... in public use ... more than one year prior to the date” of the patent application.”). The Federal Circuit in *Invitrogen* stated that, “the proper test for the public use prong of the § 102(b) statutory bar is whether the purported use: (1) was accessible to the public; or (2) was commercially exploited” **and** the invention must also have been “ready for patenting” before a public use could occur. *See id.* Facebook’s modified model jury instruction evidences the unbalanced and argumentative nature of Facebook’s proposed instruction.

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.7

ON SALE BAR

A patent claim is invalid if it can be shown by clear and convincing evidence that an embodiment that contains all the elements of that claim was both (1) subject to commercial offer for sale in the United States; and (2) ready for patenting more than one year before the patent application date. In this case, Facebook must prove by clear and convincing evidence that a product that met all the limitations of the asserted claims was ready for patenting and was offered for sale more than a year prior to the effective filing date. Once again, your determination of what the effective filing date will effect whether or not you find a commercial offer for sale of the Leader invention occurred more than a year from the effective filing date.

Facebook contends that Claims 1, 4, 7, 9, 11, 16, 21, 23, 25, 31 and 32 of the '761 Patent are anticipated because the invention was on sale in the United States more than one year before the effective filing date.

It is not required that a sale was actually made. The product offered for sale must meet each of the limitations of the asserted claims to be an embodiment of the claimed invention. In order to be on sale, the invention must have been ready for patenting at the time of the alleged offer for sale is made. An invention is ready for patenting either when it is reduced to practice or when the inventor has enabled the invention by preparing drawings or other descriptions of the invention sufficient to allow a person of ordinary skill in the art to make or use the invention. The claimed invention is ready for patenting when there is reason to believe it would work for its intended purpose.

AUTHORITY:

Modified AIPLA Model Jury Instructions § 6.3 (March 2008) which cites 35 U.S.C. § 102; *Pfaff v. Wells Elecs.*, 525 U.S. 55, 67-68 (1998); *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1352-55 (Fed. Cir. 2002); *Linear Tech. Corp. v. Micrel, Inc.*, 275 F.3d 1040, 1047-54 (Fed. Cir. 2001); *Group One, Ltd. v. Hallmark Cards, Inc.*, 254 F.3d 1041, 1045-49 (Fed. Cir. 2001); *See also UCB, Inc. v. KV Pharmaceutical Co.*, 2010 WL 809815 (D. Del. 2010); *Netscape Commc'ns. Corp. v. Konrad*, 295 F.3d 1315, 1323 (Fed. Cir. 2002).

**FACEBOOK'S OBJECTIONS TO LEADER'S PROPOSED JURY
INSTRUCTION NO. 4.7**

Facebook relies on primarily on Final Jury Instruction No. IV.7, used in this Court's case, *Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc.*, 04-cv-1371-JJF (D. Del. Sept. 21, 2007). The jury should also be informed that it is irrelevant whether or not the offer for sale was secret or non-secret, as Leader has claimed that non-disclosure agreements as reasons that communications with, for instance, The Limited, would have an effect on whether the communication was an offer to sell. *See Special Devices, Inc. v. OEA, Inc.*, 270 F.3d 1353, 1357 (Fed. Cir. 2001) (“[T]he on-sale bar would apply even if a patentee’s commercial activities took place in secret.”) (*citing Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1370 (Fed. Cir. 1998)); *Mfg. Research Corp. v. Graybar Elec. Co.*, 679 F.2d 1355, 1362 (11th Cir. 1982) (“[I]t is well established that any sale or offer, whether public or private, is enough to implicate the statutory bar.”).

Facebook objects to Leader’s language that “The offer for sale must meet each of the limitations of the claim, and thus be an embodiment of the claimed invention.” This language implies that the offer for sale itself must include language discussing each of the limitations of the claim. Rather, the offer for sale must be for a product that meets each of the limitations of the claim, and thus be an embodiment of the claimed invention.

Facebook notes that it does not need any expert testimony regarding whether or not Leader2Leader practices the claimed patent, as Leader has repeatedly stated that it does so, and Mr. McKibben, the inventor, has sworn under oath to this effect. Facebook is entitled to rely on Leader’s admissions. *See Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 1280 (Fed. Cir. 2005). Facebook’s instruction explains that an embodiment of the invention must be offered for sale; this is sufficient for the jury to be informed that Leader must have sold a product that met the claims of the patent.

FACEBOOK'S PROPOSED JURY INSTRUCTION NO. 4.7
ON SALE BAR

Facebook contends that claims 1, 4, 7, 9, 11, 16, 21, 23, 25, 31 and 32 of the '761 Patent are invalid because the alleged invention of these claims was offered for sale more than one year before the effective filing date of the '761 patent. It is against public policy to allow an inventor to commercially exploit his invention by selling or offering it for sale more than one year before the effective filing date of the patent, because this would have the effect of extending the term of the patent as fixed by Congress. The date one year prior to the filing of the patent application is called the "critical date."

A patent claim is invalid if an embodiment of the claimed invention was both (1) subject to commercial offer for sale in the United States; and (2) ready for patenting more than one year before the patent application date.

An invention was "on sale" if the claimed invention was embodied in the thing commercially offered for sale. An offer for sale need not be accepted to trigger the on-sale bar. That the offer, even if accepted, might not have ultimately led to an actual sale of the invention is also not relevant. It is not required that a sale has actually been made. The essential question is whether or not there was an attempt to obtain commercial benefit from the invention. An offer to sell can invalidate a patent even if the offer was secret, such as under the protection of a non-disclosure agreement, or publicly known.

An invention is ready for patenting either through a reduction to practice (for example, by building a product that embodies the claimed invention) or by proof that the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.

AUTHORITY:

Modified Final Jury Instruction No. IV.7, *Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc.*, 04-cv-1371-JJF (D. Del. Sept. 21, 2007); *Scaltech, Inc. v. Retec/Tetra, L.L.C.*, 269 F.3d 1321, 1328-29 (Fed. Cir. 2001).

Modified AIPLA Model Jury Instructions § 6.3 (March 2008) which cites 35 U.S.C. § 102; *Pfaff v. Wells Elecs.*, 525 U.S. 55, 67-68 (1998); *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1352-55 (Fed. Cir. 2002); *Linear Tech. Corp. v. Micrel, Inc.*, 275 F.3d 1040, 1047-54 (Fed. Cir. 2001); *Group One, Ltd. v. Hallmark Cards, Inc.*, 254 F.3d 1041, 1045-49 (Fed. Cir. 2001).

Special Devices, Inc. v. OEA, Inc., 270 F.3d 1353, 1357 (Fed. Cir. 2001); *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1370 (Fed. Cir. 1998); *Mfg. Research Corp. v. Graybar Elec. Co.*, 679 F.2d 1355, 1362 (11th Cir. 1982).

LEADER'S OBJECTIONS TO FACEBOOK'S PROPOSED JURY

INSTRUCTION NO. 4.7

Facebook's proposed instructions fails to specifically set forth that the product allegedly being offered for sale must satisfy all the claimed elements of a claim for that claim to be invalid. This is a fundamental burden of proof that Facebook has. Since Facebook does not have a single expert to testify on the subject, Facebook does not want to include this requirement into its jury instructions.

Facebook's proposed instruction will confuse the jury a discussing the public policy behind the law. Leader further objects to the addition of language from the *Scaltech v. Retec* case as confusing because it omits language that describes whether a "communication or series of communications rises to the level of a commercial offer for sale." Leader further objects to Facebook's inclusion of the following argumentative statement: "An offer to sell can invalidate a patent even if the offer was secret, such as under the protection of a non-disclosure agreement, or publicly known." Discussion of non-disclosure agreements is unnecessary and prejudicial to Leader because it modifies the model jury instruction to add unnecessary language regarding non-disclosure agreements. Facebook has no basis for claiming that Leader is asserting that a non-disclosure agreement have a part in any alleged offers for sale. To the extent this additional language is conveying the same law already provided in the instruction, it is unnecessary and redundant.

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.8

EXPERIMENTAL USE

Leader contends that there were no public demonstrations or offers for sale of the invention more than a year prior to the effective filing date. The law recognizes the defense of experimental use to claims of public use and offer for sale, because an inventor must be given the opportunity to develop the invention. Certain activities are experimental if they are a legitimate effort to perfect the invention or to determine if the invention will work for its intended purpose. So long as the primary purpose is experimentation, it does not matter that the public used the invention or that the inventor incidentally derived profit from it. If you find that Facebook has shown a prior public use or offer for sale of an invention that meets all the elements of the asserted claim at issue by clear and convincing evidence, then Leader must prove by a preponderance of the evidence that the purpose of the prior public use or alleged offer for sale was experimental.

Only experimentation by or under the control of the inventor of the patent qualifies for this exception. Experimentation by a third party, for its own purposes, does not. The experimentation must relate to the features of the claimed invention, and it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation.

AUTHORITY:

Modified APLA Model Jury Instructions § 6.4 (March 2008) which cites *City of Elizabeth v. Am. Nicholson Pavement Co.*, 97 U.S. 126, 134-35 (1877); *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1353-55 (Fed. Cir. 2002); *LaBounty Mfg., Inc. v. U.S. Int'l Trade Comm'n*, 958 F.2d 1066, 1071-72 (Fed. Cir. 1992); *Manville Sales*

Corp. v. Paramount Sys., Inc., 917 F.2d 544, 549-51 (Fed. Cir. 1990); *U.S. Envtl. Prods. Inc. v. Westall*, 911 F.2d 713, 716 (Fed. Cir. 1990); *In re Hamilton*, 882 F.2d 1576, 1580-83 (Fed. Cir. 1989); *Grain Processing Corp. v. Am. Maize-Prods. Co.*, 840 F.2d 902, 906 (Fed. Cir. 1988); *Hycor Corp. v. Schlueter Co.*, 740 F.2d 1529, 1535-37 (Fed. Cir. 1984); *Pennwalt Corp. v. Akzona Inc.*, 740 F.2d 1573, 1580-81 (Fed. Cir. 1984); *TP Labs., Inc. v. Prof'l Positioners, Inc.*, 724 F.2d 965, 972-73 (Fed. Cir.), *cert. denied*, 469 U.S. 826 (1984); *DL Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 1149-50 (Fed. Cir. 1983); *In re Smith*, 714 F.2d 1127, 1134-37 (Fed. Cir. 1983); *In re Theis*, 610 F.2d 786, 792-93 (C.C.P.A. 1979); *See also Manville Sales Corp. v. Paramount Sys. Inc.*, 917 F.2d 544, 550 (Fed. Cir. 1990).

**FACEBOOK'S OBJECTIONS TO LEADER'S PROPOSED JURY
INSTRUCTION NO. 4.8**

Leader has set forth no evidence that any offers to sell were for experimental purposes; rather Leader's main retort to Facebook's on-sale has always been that Leader was seeking investment or just engaged in long term discussions rather than actually offering to sell Leader2Leader. Further, every single offer for sale of Leader2Leader was requesting a large amount of money in exchange for Leader2Leader, ignoring the requirement that an "experimental" sale must have only incidental monetary gain.

Leader's instruction that if the jury finds an intent to "beta test" Leader2Leader this would be sufficient to meet the threshold of experimental use, is improper as well. Leader has not shown that this beta testing was done primarily for experimental purposes, as documents, including those produced by third party Zacks Law Group within the past month, show the following: (1) getting "marquee" beta testers was part of a long term business plan to turn those beta testers into Leader customers, and (2) Leader expected to obtain substantial revenue from many of its potential beta testers. Leader deleted the sentence that sets forth the standard it must actually meet: "A test done primarily for marketing, and only incidentally for technological improvement, is not an experimental use, but a public use."

Leader does not cite to any authority that demonstrating products to potential investors or customers is "experimental use," and demonstrations for the purpose of obtaining investment or customers are the type of public uses Facebook contends are invalidating. Further, although Leader cites to a single case in which a *sale* was found to be for experimental purposes, Leader does not set forth any case law that shows that offering to sell a product, in which the offer purely touts the benefits the offeree will receive from the product and specifies a price for the goods, would be experimental. Further, Leader fails to explain what the jury must look to in order to find a *sale* to be commercial, as opposed to for experimental purposes. As Leader's own instruction

explains, “[a] test done primarily for marketing, and only incidentally for technological improvement, is not an experimental use, but a public use.” Thus, this instruction will merely confuse the issues for the jury.

FACEBOOK'S PROPOSED JURY INSTRUCTION NO. 4.8
EXPERIMENTAL USE

Leader contends that any demonstrations or offers for sale of its Leader2Leader product should not be considered a prior public use or offer for sale of the invention because that use was experimental.

However, only experimentation by or under the control of the inventor of the patent qualifies for this exception. Experimentation by a third party, for its own purposes, does not. The experimentation must relate to the features of the claimed invention, and it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is not an experimental use, but a public use.

If you find that Facebook has shown a prior public use by clear and convincing evidence, then Leader must prove by a preponderance of the evidence that the purpose of the prior public use was experimental.

AUTHORITY:

Modified AIPLA Model Jury Instructions § 6.4 (March 2008) which cites *City of Elizabeth v. Am. Nicholson Pavement Co.*, 97 U.S. 126, 134-35 (1877); *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1353-55 (Fed. Cir. 2002); *LaBounty Mfg., Inc. v. U.S. Int'l Trade Comm'n*, 958 F.2d 1066, 1071-72 (Fed. Cir. 1992); *Manville Sales Corp. v. Paramount Sys., Inc.*, 917 F.2d 544, 549-51 (Fed. Cir. 1990); *U.S. Envtl. Prods. Inc. v. Westall*, 911 F.2d 713, 716 (Fed. Cir. 1990); *In re Hamilton*, 882 F.2d 1576, 1580-83 (Fed. Cir. 1989); *Grain Processing Corp. v. Am. Maize-Prods. Co.*, 840 F.2d 902, 906 (Fed. Cir. 1988); *Hycor Corp. v. Schlueter Co.*, 740 F.2d 1529, 1535-37 (Fed. Cir. 1984); *Pennwalt Corp. v. Akzona Inc.*, 740 F.2d 1573, 1580-81 (Fed. Cir. 1984); *TP Labs., Inc. v. Prof'l Positioners, Inc.*, 724 F.2d 965, 972-73 (Fed. Cir.), *cert. denied*, 469 U.S. 826 (1984); *DL Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 1149-50 (Fed. Cir. 1983); *In re Smith*, 714 F.2d 1127, 1134-37 (Fed. Cir. 1983); *In re Theis*, 610 F.2d 786, 792-93 (C.C.P.A. 1979).

**LEADER'S OBJECTIONS TO FACEBOOK'S PROPOSED JURY
INSTRUCTION NO. 4.8**

Leader objects to this instruction because, contrary to the very first sentence of Facebook's proposed instruction, Leader does not contend that it conducted any demonstrations or offers for sale of Leader2Leader that would constitute a public use or offer for sale. Stating that Leader contends that it did in fact conduct demonstrations or offers for sale and that Leader is contending that such activities were experimental is biased and unduly prejudicial because it instructs the jury to determine that Leader has made demonstrations or offers for sale of a product that is covered by the asserted claims. This is an issue in dispute for the jury to decide and the issue is not limited to whether any alleged activities were experimental in nature.

Furthermore, there is a dispute as to whether or not Leader demonstrated or offered for sale the Leader2Leader® product before the effective filing date. Facebook's proposed instruction assumes a demonstration or offer for sale that could be considered a public use or offer for sale has occurred, and such a assumption will confuse the jury and is prejudicial to Leader.

Facebook provides no law regarding what constitutes "experimental use" by omitting an entire section of the APLA Model Jury Instruction on what constitutes experimental use. Just a few examples of Facebook's deletions are as follows: "activities are only experimental if they are a legitimate effort to perfect the invention or to determine if the invention will work for its intended purpose," "so long as the primary purpose is experimentation, it does not matter that the public used the invention or the inventor incidentally derived profit from it," and "an invention must be given the opportunity to develop the invention."

To the extent that Facebook claims that there was an offer for sale, Leader's instruction informs the jury that the alleged offer or demonstration should be considered an experimental use. To prevail on its on-sale bar claim, Facebook must establish by clear and convincing evidence that before the critical date (1) the product was the subject of a commercial offer for sale, and (2) that the invention was ready for patenting. *See e.g., Honeywell International, Inc. v. Nikon Corp.*, 672 F.Supp.2d 638, 641 (D.Del. 2009).

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.9

PRINTED PUBLICATION

For a printed publication to anticipate a patent claim, it must, when read by a person of ordinary skill in the art, expressly disclose each element of the claimed invention to the reader. The disclosure must be complete enough to enable one of ordinary skill in the art to practice the invention without undue experimentation.

To prove anticipation of the patented invention, Facebook must show by clear and convincing evidence that before the effective filing date, a third party disclosed in a printed publication or that the third party patented an invention which included all of the elements of the asserted claims of the '761 Patent.

In addition, a printed publication must be reasonably accessible to those members of the public who would be interested in its contents. It is not necessary that the printed publication be available to every member of the public. The information must, however, have been maintained in some form, such as printed pages, microfilm, or photocopies. An issued patent is a printed publication. A published patent application is a printed publication as of its publication date.

AUTHORITY:

Modified AIPLA Model Jury Instructions §§ 6.5 and 6.7 (March 2008) which cites 35 U.S.C. § 102; *In re Carol F. Klopfenstein*, 380 F.3d 1345, 1352 (Fed. Cir. 2004); *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554-55 (Fed. Cir. 1995); *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568-69 (Fed. Cir. 1988); *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1479 (Fed. Cir. 1986); *In re Hall*, 781 F.2d 897, 898-899 (Fed. Cir. 1986); *In re Donohue*, 766 F.2d 531, 533-34 (Fed. Cir. 1985); *Studiengesellschaft Kohle mbH v. Dart Indus., Inc.*, 726 F.2d 724, 727 (Fed. Cir. 1984); *In re Wyer*, 655 F.2d 221, 227 (C.C.P.A. 1981); *In re Donohue*, 632 F.2d 123, 125-126 (C.C.P.A. 1980); *In re Samour*, 571 F.2d 559, 562 (C.C.P.A. 1978); *In re Coker*, 463 F.2d 1344, 1348 (C.C.P.A. 1972); *Deep Welding, Inc. v. Sciaky Bros., Inc.*, 417 F.2d 1227, 1235 (7th Cir. 1969); *In re Foster*, 343 F.2d 980,

984-985 (C.C.P.A. 1965); *In re Monks*, 588 F.2d 308, 309 (C.C.P.A. 1978); *In re Fuge*, 272 F.2d 954, 956 (C.C.P.A. 1959); *In re Ekenstam*, 256 F.2d 321, 323-24 (C.C.P.A. 1958); *Bendix Corp. v. Balax, Inc.*, 421 F.2d 809, 811-12 (7th Cir. 1970).

**FACEBOOK'S OBJECTIONS TO LEADER'S PROPOSED JURY
INSTRUCTION NO. 4.9**

Facebook's instruction closely follows the AIPLA model jury instruction and Facebook believes this provides a balanced explanation of what constitutes a printed publication. Facebook adds additional language from *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1355 (Fed. Cir. 2003), to explain that a U.S. patent used as prior art is presumed enabled as to what it discloses.

FACEBOOK'S PROPOSED JURY INSTRUCTION NO. 4.9
PRINTED PUBLICATION/PRIOR PATENT

Facebook contends that claims 1, 4, 7, 9, 11, 16, 21, 23, 25, 31 and 32 of the '761 Patent are anticipated because the invention defined in that claim was described in a printed publication or a patent more than one year before the effective filing date of the '761 patent application.

A patent claim is invalid if the invention defined by that claim was described in a printed publication more than one year prior to the filing date of the U.S. application.

A printed publication must be reasonably accessible to those members of the public who would be interested in its contents. It is not necessary that the printed publication be available to every member of the public. The information must, however, have been maintained in some form, such as printed pages, microfilm, or photocopies. An issued patent is a printed publication. A published patent application is a printed publication as of its publication date.

For a printed publication to anticipate a patent claim, it must, when read by a person of ordinary skill in the art, expressly or inherently disclose each element of the claimed invention to the reader. The disclosure must be complete enough to enable one of ordinary skill in the art to practice the invention without undue experimentation. However, when the printed publication is an issued U.S. Patent, that patent is presumed to be enabling. In determining whether the disclosure of other printed publications is enabling, you should take into account what would have been within the knowledge of a person of ordinary skill in the art one year before the application for the '761 Patent was filed and you may consider evidence that sheds light on the knowledge such a person would have had, including whether or not the disclosures were embodied in working products.

AUTHORITY:

Modified AIPLA Model Jury Instructions §§ 6.5 and 6.7 (March 2008) which cites 35 U.S.C. § 102; *In re Carol F. Klopfenstein*, 380 F.3d 1345, 1352 (Fed. Cir. 2004); *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554-55 (Fed. Cir. 1995); *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568-69 (Fed. Cir. 1988); *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1479 (Fed. Cir. 1986); *In re Hall*, 781 F.2d 897, 898-899 (Fed. Cir. 1986); *In re Donohue*, 766 F.2d 531, 533-34 (Fed. Cir. 1985); *Studiengesellschaft Kohle mbH v. Dart Indus., Inc.*, 726 F.2d 724, 727 (Fed. Cir. 1984); *In re Wyer*, 655 F.2d 221, 227 (C.C.P.A. 1981); *In re Donohue*, 632 F.2d 123, 125-126 (C.C.P.A. 1980); *In re Samour*, 571 F.2d 559, 562 (C.C.P.A. 1978); *In re Coker*, 463 F.2d 1344, 1348 (C.C.P.A. 1972); *Deep Welding, Inc. v. Sciaky Bros., Inc.*, 417 F.2d 1227, 1235 (7th Cir. 1969); *In re Foster*, 343 F.2d 980, 984-985 (C.C.P.A. 1965); *In re Monks*, 588 F.2d 308, 309 (C.C.P.A. 1978); *In re Fuge*, 272 F.2d 954, 956 (C.C.P.A. 1959); *In re Ekenstam*, 256 F.2d 321, 323-24 (C.C.P.A. 1958); *Bendix Corp. v. Balax, Inc.*, 421 F.2d 809, 811-12 (7th Cir. 1970).

Amgen Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1355 (Fed. Cir. 2003).

**LEADER'S OBJECTIONS TO FACEBOOK'S PROPOSED JURY
INSTRUCTION NO. 4.9**

Leader objects to Facebook's proposed jury instruction as it confuses the issues of anticipation and enablement and the instruction is argumentative. Facebook cites to *Amgen* for the proposition that U.S. Patents are presumed enabled. However, this is unnecessary and confusing as Leader is not asserting that any of the U.S. Patents that Facebook is relying upon for prior art are not enabled. Leader asserts that the iManage product manual is not enabled. Unlike Facebook's proposal, Leader's proposed instruction closely follows the Federal Circuit's model jury instruction.

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.10
OBVIOUSNESS – GENERALLY

Even though an invention may not have been identically disclosed or described before it was made by an inventor, in order to be patentable, the invention must also not have been obvious to a person of ordinary skill in the field of technology of the patent at the time the invention was made.

Facebook may establish that a patent claim is invalid by showing, by clear and convincing evidence, that the claimed invention would have been obvious to persons having ordinary skill in the art at the time the invention was made in the field of computer science.

In determining whether a claimed invention is obvious, you must consider the level of ordinary skill in the field of computer science that someone would have had at the time the claimed invention was made, the scope and content of the prior art, and any differences between the prior art and the claimed invention.

Keep in mind that the existence of each and every element of the claimed invention in the prior art does not necessarily prove obviousness. Most, if not all, inventions rely on building blocks of prior art. In considering whether a claimed invention is obvious, you may, but are not required, to find obviousness if you find that at the time of the claimed invention there was a reason that would have prompted a person having ordinary skill in the field of computer science to combine the known elements in a way the claimed invention does, taking into account such factors as (1) whether the claimed invention was merely the predictable result of using prior art elements according to their known function(s); (2) whether the claimed invention provides an obvious solution to a known problem in the relevant field; (3) whether the prior art teaches or

suggests the desirability of combining elements claimed in the invention; (4) whether the prior art teaches away from combining elements in the claimed invention; (5) whether it would have been obvious to try the combinations of elements, such as when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions; and (6) whether the change resulted more from design incentives or other market forces. To find it rendered the invention obvious, you must find that the prior art provided a reasonable expectation of success.

AUTHORITY:

Modified The Federal Circuit Bar Association Model Patent Jury Instructions § 4.3c (February 2010) which cites *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 407, 425-28 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161-62 (Fed. Cir. 2007); *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 662-63 (Fed. Cir. 2000); *Arkies Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 955 (Fed. Cir. 1997); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 716 (Fed. Cir. 1991); *Nutrition 21 v. U.S.*, 930 F.2d 867, 871 n.2 (Fed. Cir. 1991); *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 764 (Fed. Cir. 1988); *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 718-19 (Fed. Cir. 1984); *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1382-83 (Fed. Cir. 1983); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-40 (Fed. Cir. 1983).

**FACEBOOK'S OBJECTIONS TO LEADER'S PROPOSED JURY
INSTRUCTION NO. 4.10**

Facebook objects to this instruction as it divides up what was one obviousness instruction into individual instructions. Facebook also notes that the bracketed portion of its standard shows that the Court has the option of selecting either standard, based on the Court's determination of which is the correct standard. Facebook does not contend that the jury should see both standards in brackets, contrary to Leader's objection.

Facebook notes that its discussion of secondary considerations is nearly identical to Leader's proposed instruction No. 4.15. Facebook did not diminish their importance by not including them as a separate jury instruction or by refusing to agree to Leader's additional statement, not found in the original model instruction, that "Answering any, or all, of the above questions 'yes' may suggest that the claim was not obvious." Leader's attempt to claim that answering *one* of these answers "yes" may "suggest" the claim is non-obvious is contrary to law and prejudicial to Facebook. *See Newell Companies, Inc. v. Kenney Manufacturing Co.*, 864 F.2d 757, 768-69 (Fed. Cir. 1988) ("[A]lthough these [secondary] factors must be considered, they do not control the obviousness conclusion."); *Richardson-Vicks Inc. v. Upjohn Co.*, 122 F.3d 1476, 1483 (Fed. Cir. 1997) ("The existence of such evidence [of secondary considerations], however, does not control the obviousness determination.); *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 809 (Fed. Cir. 1989), cert. denied, 493 U.S. 975 (1989) ("Commercial success is an indication of nonobviousness that must be considered in a patentability analysis . . . but in the circumstances of this case, where it is the only such indication, it is insufficient to render [the patentee's] claimed invention nonobvious.")

The case law Leader cites merely emphasizes that secondary considerations are an important part of the obviousness analysis, but do not support this specific jury instruction.

Further, Facebook specifically objects to Leader's argument that "Leader has

circumstantial evidence of copying of the invention.” The only “evidence” to which Leader could be alluding is its unsupported allegations regarding Mark Zuckerberg. Leader’s persistence in attempting to introduce these theories into the case is in disregard of the Court’s determination at the pretrial conference that “[i]t’s the court’s view that there’s no place in this trial that’s forthcoming for those types of allegations to be part of this case.” Tr. at 13:12-14. This statement from the Court was in response to a suggestion by Leader’s counsel that such “evidence” could be relevant to secondary considerations of non-obviousness.

FACEBOOK'S PROPOSED JURY INSTRUCTION NO. 4.10
OBVIOUSNESS – GENERALLY

Even though an invention may not have been identically disclosed or described before it was made by an inventor, in order to be patentable, the invention must also not have been obvious to a person of ordinary skill in the field of technology of the patent at the time the patent was filed.

Facebook may establish that the patent claims are invalid by showing that the claimed invention would have been obvious to persons of ordinary skill in the art at the time the patent filed.

In determining whether a claimed invention is obvious, you must consider the level of ordinary skill in the field of computer science that someone would have had at the time the claimed invention was made, the scope and content of the prior art, and any differences between the prior art and the claimed invention.

[A person of ordinary skill in the art is someone with a bachelor's degree or higher in computer science and/or several years of experience in the computer industry.]

[A person of ordinary skill in the art is someone with a bachelor's degree or the equivalent in computer science and several years of experience in the computer industry.]

Keep in mind that the existence of each and every element of the claimed invention in the prior art does not necessarily prove obviousness. Most, if not all, inventions rely on building blocks of prior art. In considering whether a claimed invention is obvious, you may find obviousness if you find that at the time of the claimed invention there was a reason that would have prompted a person having ordinary skill in the field of computer science to combine the known elements in a way the claimed invention does, taking into account such factors as (1) whether the claimed invention was merely the predictable result of using prior art elements according to their known function(s); (2) whether the claimed invention provides an obvious solution to a known problem in the relevant field; (3) whether the prior art teaches or suggests the desirability

of combining elements claimed in the invention; (4) whether the prior art teaches away from combining elements in the claimed invention; (5) whether it would have been obvious to try the combinations of elements, such as when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions; and (6) whether the change resulted more from design incentives or other market forces. To find it rendered the invention obvious, you must find that the prior art provided a reasonable expectation of success.

In determining whether the claimed invention was obvious, consider each claim separately. Consider only what was known at the time of the invention; do not use hindsight.

In making these assessments, you should take into account any objective evidence (sometimes called “secondary considerations”) that may have existed at the time of the invention and afterwards that may shed light on the obviousness or not of the claimed invention, such as:

- a. Whether the invention was commercially successful as a result of the merits of the claimed invention (rather than the result of design needs or market-pressure advertising or similar activities)?
- b. Whether there was a long felt need for a solution to the problem facing the inventors, which was satisfied by the claimed invention?
- c. Whether others had tried and failed to make the invention?
- d. Whether others invented the invention at roughly the same time?
- e. Whether others copied the invention?
- f. Whether there were changes or related technologies or market needs contemporaneous with the invention?
- g. Whether the invention achieved unexpected results?
- h. Whether others in the field praised the invention?

- i. Whether persons having ordinary skill in the art of the invention expressed surprise or disbelief regarding the invention?
- j. Whether others sought or obtained rights to the patent from the patent holder?
- k. Whether the inventor proceeded contrary to accepted wisdom in the field?

AUTHORITY:

Modified The Federal Circuit Bar Association Model Patent Jury Instructions § 4.3c (February 2010) which cites *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 407, 425-28 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161-62 (Fed. Cir. 2007); *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 662-63 (Fed. Cir. 2000); *Arkies Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 955 (Fed. Cir. 1997); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 716 (Fed. Cir. 1991); *Nutrition 21 v. U.S.*, 930 F.2d 867, 871 n.2 (Fed. Cir. 1991); *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 764 (Fed. Cir. 1988); *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 718-19 (Fed. Cir. 1984); *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1382-83 (Fed. Cir. 1983); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-40 (Fed. Cir. 1983).

**LEADER'S OBJECTIONS TO FACEBOOK'S PROPOSED JURY
INSTRUCTION NO. 4.10**

Leader objects to Facebook's proposed instruction as overly lengthy and likely to confuse the jury by not clearly setting forth concisely all of the elements that Facebook must prove to succeed on its obviousness claim. Leader has instead proposed breaking up the jury instruction into separate instructions to make it less confusing for the jury. For example, Facebook's instruction fails to explain the importance of or how to assess secondary considerations. Secondary considerations of non-obviousness are Leader's rebuttal to Facebook's claim of obviousness. For example, Leader has circumstantial evidence of copying of the invention, one of the many factors to be considered by the jury. Facebook's instruction suggests that secondary considerations relate to Facebook's burden of proof by including them in a single jury instruction. The importance of secondary consideration is well settled law. The Federal Circuit in, *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, stated:

Just as it is legal error for a district court to fail to consider relevant evidence going to secondary considerations, it may be legal error for a district court to presuppose that all evidence relating to secondary considerations, when considered with the other Graham indicia relating to the obviousness/nonobviousness issue, cannot be of sufficient probative value to elevate the subject matter of the claimed invention to the level of patentable invention.

776 F.2d 281, 306 (Fed. Cir. 1985) (citations omitted); *see also Simmons Fastener Corp. v. Ill. Tool Works, Inc.*, 739 F.2d 1573, 1575 (Fed. Cir. 1984) (“Only after all evidence of nonobviousness has been considered can a conclusion on obviousness be reached. The trial court’s error lies in its exclusion of such evidence in arriving at a conclusion on the obviousness of the claimed invention.”); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1461 (Fed. Cir. 1984) (“All evidence must be considered before a conclusion on obviousness is reached.”); *Ruiz v. AB Chance Co.*, 234 F.3d 654, 667 (Fed. Cir. 2000) (“Our precedents clearly hold that secondary considerations, when present, must be considered in determining obviousness.”); *Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1365 (Fed. Cir. 2008) (Court stating secondary considerations often provide some of the best “independent evidence of obviousness.”); *Sud-Chemie, Inc. v. Multisorb Techs., Inc.*, 554 F.3d 1001, 1008 (Fed. Cir. 2009) (“The district court should therefore attend carefully to any evidence of these secondary considerations of nonobviousness on remand.”).

Furthermore, Facebook’s proposed instruction also incorrectly refers to the level of ordinary skill for obviousness determination by placing two standards in brackets, which is likely to confuse the jury. Facebook’s instruction incorrectly states that the Court has the option of choosing the level of one of ordinary skill, when this is a question of fact for the jury to decide. Leader has properly proposed separate Jury Instruction No. 4.14 for the jury to determine what is the appropriate level of one of ordinary skill in the art.

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.11
OBVIOUSNESS – HINDSIGHT

In determining whether the claimed invention was obvious, consider each claim separately. Do not use hindsight, i.e., consider only what was known at the time of the invention.

AUTHORITY:

The Federal Circuit Bar Association Model Patent Jury Instructions § 4.3c (February 2010) which cites *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007).

LEADER'S SUPPORT FOR LEADER'S PROPOSED JURY INSTRUCTION NO.
4.11

As the Federal model jury instructions, state, obviousness should be assessed at the time of the invention. Fact-finders should be made aware “of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). The Supreme Court in *KSR*, confirmed the holding in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) that “commercial success, long felt but unsolved needs, failure of others, etc., ‘are an integral part of the obviousness analysis, and serve as a check against the use of hindsight.’” 550 U.S. 398, 421 (2007) (quoting *Graham*, 383 U.S. at 36). The Federal Circuit, in *Iron Grip Barbell Co. v. USA Sports, Inc.*, stated, “we are mindful of the repeated warnings of the Supreme Court and this court as to the danger of hindsight bias.” 2005 U.S. App. LEXIS 3821 at *6 (Fed. Cir. 2004); see 383 U.S. at 36 (consideration of secondary factors “serves to guard against slipping into use of hindsight and to resist the temptation to read into the prior art the teachings of the invention in issue” (internal quotations omitted)); *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000) (“The very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.” (internal quotations omitted)). A separate instruction is necessary to ensure that the jury refrains from using hindsight in its analysis.

**FACEBOOK’S OBJECTION TO LEADER’S PROPOSED JURY
INSTRUCTION NO. 4.11**

Facebook objects to this instruction, as this information should be included, if at all, in the Obviousness – Generally instruction, as it is in the Federal Circuit Bar Association Model Instruction § 4.3c. For Facebook’s proposed instruction regarding hindsight, see Facebook’s Proposed Jury Instruction No. 4.10, Obviousness – Generally. Leader is attempting to focus the jurors purely on “hindsight” separate from the rest of the obviousness requirements for confusion’s sake. Leader provides no support that a *separate* instruction regarding hindsight is necessary, merely cases that supports the statement that hindsight should not be used. This law is reflected in Facebook’s proposed instruction No. 4.10.

DISPUTED PROPOSED JURY INSTRUCTION NO. 4.12
SCOPE AND CONTENT OF THE PRIOR ART

In considering whether the claimed invention was obvious, you must first determine the scope and content of the prior art.

The scope and content of prior art for deciding whether the invention was obvious includes prior art in the same field as the claimed invention, regardless of the problem addressed by the item or reference, and prior art from different fields that a person of ordinary skill in the art using common sense might combine if familiar so as to solve the problem, like fitting together the pieces of a puzzle. [When a party attacking the validity of a patent relies on prior art which was specifically considered by the Examiner during the prosecution of the application leading to the issuance of the patent, that party bears the burden of overcoming the deference due a qualified government agency official presumed to have performed his or her job.]

AUTHORITY:

The Federal Circuit Bar Association Model Patent Jury Instructions § 4.3c(ii) (February 2010) which cites *KSR*, 550 U.S. at 420; *In re Icon Health & Fitness, Inc.*, 496 F.3d 1374, 1379-80 (Fed. Cir. 2007); *Princeton Biochems., Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1339 (Fed. Cir. 2005).

**LEADER'S SUPPORT FOR DISPUTED PROPOSED JURY
INSTRUCTION NO. 4.12**

Leader proposed the bracketed language because it makes the instruction complete. Without it, the instruction is biased in Facebook's favor. The entire instruction should be provided in light of Facebook's positions in this case, namely that the Patent Office has not reviewed the references that Facebook is asserting regarding the validity of the '761 Patent. Leader has rebutted this claim with expert testimony regarding validity that the references relied upon by Facebook are merely cumulative to those references examined during the examinations of the '761 Patent. Thus, this is an issue that the jury can be instructed on which goes to the weight of Facebook's claims regarding what the Patent Office reviewed. Furthermore, the last sentence is properly included in the jury instruction which comes directly from the Federal Circuit model jury instructions.

Leader objects to Facebook's omission of the last sentence of the instruction which is Leader's proposed bracketed language. Without it, the instruction is biased in Facebook's favor because it fails to address law that is relevant to arguments that Facebook intends to make, but which favors Leader.

**FACEBOOK'S SUPPORT FOR DISPUTED PROPOSED JURY
INSTRUCTION NO. 4.12**

Facebook objects to the sentence “When a party attacking the validity of a patent relies on prior art which was specifically considered by the Examiner during the prosecution of the application leading to the issuance of the patent, that party bears the burden of overcoming the deference due a qualified government agency official presumed to have performed his or her job” because Facebook is not relying on any prior art that was before the patent office in presenting its obviousness case. This sentence is prejudicial, misleading, confusing, and irrelevant.

Whether prior art is cumulative is not relevant to the invalidity claims at issue in the current phase of the trial. Prior art asserted for the purpose of establishing invalidity must be compared to the claims of the patent, regardless of whether it was considered by the patent office during prosecution. *See Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1373 (Fed.Cir.2001) (“[A] claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference.”); *see also IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1381 (Fed. Cir. 2005) (“... a patent may be found to be anticipated on the basis of a reference that had properly been before the patent examiner in the United States Patent and Trademark Office (“PTO”) at the time of issuance”). Therefore, even prior art that is cumulative of that considered by the patent office must be subject to the same invalidity analysis, regardless of the cumulative nature.

Further, Leader’s own instruction refers only to prior art “which was specifically considered” by the PTO. However, Leader does not provide any evidence that any of Facebook’s prior art references were *specifically* considered by the patent office, nor could it. The PTO has already stated that none of the prior art upon which Facebook relies was reviewed by the Examiner during the prosecution of the ’761 patent in the orders granted the *ex parte* and *inter partes* reexaminations of the ’761 patent. Thus,

Leader's proposed evidence regarding "cumulateness" would not satisfy its own proposed jury instruction, evidencing why this section should not be included.

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.13
DIFFERENCES BETWEEN THE INVENTION OF THE CLAIMS AND THE
PRIOR ART

You should analyze whether there are any relevant differences between the prior art and the claimed invention from the view of a person of ordinary skill in the art at the time of the invention. Your analysis must determine the impact, if any, of any such differences on the obviousness or nonobviousness of the invention as a whole, and not merely some portion of it. In analyzing the relevance of the differences between the claimed invention and the prior art, you do not need to look for precise teaching in the prior art directed to the subject matter of the claimed invention. You may take into account the inferences and creative steps that a person of ordinary skill in the art would have employed in reviewing the prior art at the time of the invention. For example, if the claimed invention combined elements known in the prior art and the combination yielded results that were predictable to a person of ordinary skill in the art at the time of the invention, then this evidence would make it more likely that the claim was obvious. On the other hand, if the combination of known elements yielded unexpected or unpredictable results, or if the prior art teaches away from combining the known elements, then this evidence would make it more likely that the claim that successfully combined those elements was not obvious.

Importantly, a claim is not proved obvious merely by demonstrating that each of the elements was independently known in the prior art. Therefore, you should consider whether a reason existed at the time of the invention that would have prompted a person of ordinary skill in the art in the relevant field to combine the known elements in the way the claimed invention does. The reason could come from the prior art, the background knowledge of one of ordinary skill in the art, the nature of the problem to be solved, market demand, or common sense.

If you find that a reason existed at the time of the invention to combine the

elements of the prior art to arrive at the claimed invention, the evidence would make it more likely that the claimed invention was obvious.

Again, you must undertake this analysis separately for each claim that Facebook contends is obvious.

AUTHORITY:

Modified AIPLA's Model Patent Jury Instructions § 7.2 (March 2008) which cites *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742-43 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1536-37 (Fed. Cir. 1983); *Medtronic, Inc., v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567-68 (Fed. Cir. 1983).

LEADER'S SUPPORT FOR LEADER'S PROPOSED JURY INSTRUCTION NO.

4.13

The Supreme Court in *KSR International Co. v. Teleflex Inc.*, considered the question of obviousness as applied to an invention that consists of a combination of elements, all of which are found in prior art references. 127 S. Ct. 1727 (2007).

While the ultimate question of patent validity is a question of law, the proper resolution of that ultimate question typically turns on underlying factual inquiries, including the scope and content of the prior art and the differences between the prior art and the claims at issue. *See Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Leader's obviousness instruction is broken up into separate instructions in a clear and concise manner to allow an understanding of the obviousness analysis and prevent confusion to the jury.

**FACEBOOK'S OBJECTIONS TO LEADER'S PROPOSED JURY
INSTRUCTION NO. 4.13**

Facebook does not believe this instruction is necessary, as it is duplicative of other instructions. For the “Obviousness – General,” “Obviousness – Hindsight,” and “Obviousness – Objective Considerations Concerning Non-obviousness” instructions, Leader relies on the Federal Circuit Bar Association’s “Obviousness” Instruction No. 4.3c. Leader then attempts to add in a redundant instruction from the AIPLA Model Instructions. This is unnecessary and is just an attempt to confuse the jury with “additional,” although redundant, requirements for finding obviousness. For instance, note the redundancies between the following two sections of Leader’s proposed instructions:

From Leader’s Proposed Instruction No. 4.13:

“Importantly, a claim is not proved obvious merely by demonstrating that each of the elements was independently known in the prior art. Therefore, you should consider whether a reason existed at the time of the invention that would have prompted a person of ordinary skill in the art in the relevant field to combine the known elements in the way the claimed invention does.”

From Leader’s Proposed Instruction No. 4.10:

“Keep in mind that the existence of each and every element of the claimed invention in the prior art does not necessarily prove obviousness. . . . In considering whether a claimed invention is obvious, you may, but are not required, to find obviousness if you find that at the time of the claimed invention there was a reason that would have prompted a person having ordinary skill in the art of computer science to combine the known elements in a way the claimed invention does . . .”

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.14
LEVEL OF ORDINARY SKILL

In deciding what the level of ordinary skill for the '761 Patent is, you should consider all the evidence introduced at trial, including but not limited to: (1) the levels of education and experience of the inventor and other persons actively working in the field; (2) the types of problems encountered in the field; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; and (5) the sophistication of the technology.

AUTHORITY:

Modified The Federal Circuit Bar Association Model Patent Jury Instructions § 4.3(c)(i) (February 2010) which cites *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007); *Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007); *Graham v. John Deere Co.*, 383 U.S. 1, 27-28 (1966); *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 666-67 (Fed. Cir. 2000).

LEADER'S SUPPORT FOR LEADER'S PROPOSED JURY

INSTRUCTION NO. 4.14

Since, the parties cannot agree to the level of ordinary skill, Leader's proposed instruction follows the model instruction providing the jury instructions on determining the ordinary skill of one in the art.

**FACEBOOK'S OBJECTIONS TO LEADER'S PROPOSED JURY
INSTRUCTION NO. 4.14**

This should not be a separate instruction or an issue decided by the jury. The Court's finding regarding the level of skill in the art should be incorporated into Proposed Jury Instruction No. 4.10, as Facebook has done. Facebook disagrees that a person skilled in the art could include one without a bachelor's degree or equivalent in computer science but who has several years of experience in "the computer industry," as this could include many individuals who are not, in fact, skilled in the art of computer programming, including someone who sells computers at an electronics store.

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.15
OBJECTIVE INDICATIONS CONCERNING NON-OBVIOUSNESS

In making these assessments, you should take into account any objective evidence (sometimes called “secondary considerations”) that may have existed at the time of the invention and afterwards that may shed light on the obviousness or not of the claimed invention, such as:

- a. Whether the invention was commercially successful as a result of the merits of the claimed invention (rather than the result of design needs or market-pressure advertising or similar activities)?
- b. Whether there was a long felt need for a solution to the problem facing the inventors, which was satisfied by the claimed invention?
- c. Whether others had tried and failed to make the invention?
- d. Whether others invented the invention at roughly the same time?
- e. Whether others copied the invention?
- f.. Whether there were changes or related technologies or market needs contemporaneous with the invention?
- g. Whether the invention achieved unexpected results?
- h. Whether others in the field praised the invention?
- i.. Whether persons having ordinary skill in the art of the invention expressed surprise or disbelief regarding the invention?
- j. Whether others sought or obtained rights to the patent from the patent holder?
- k. Whether the inventor proceeded contrary to accepted wisdom in the field?

Answering any, or all, of the above questions “yes” may suggest that the claim was not obvious.

AUTHORITY:

Modified The Federal Circuit Bar Association Model Patent Jury Instructions § 4.3c (February 2010) which cites *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1380 (Fed. Cir. 2007); *AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1244 (Fed. Cir. 2003); *Durel Corp. v. Osram Sylvania Inc.*, 256 F.3d 1298, 1306 (Fed. Cir. 2001).

**LEADER'S SUPPORT FOR LEADER'S PROPOSED JURY INSTRUCTION NO.
4.15**

The Federal Circuit continues to emphasize the factual nature of the issues underlying a determination of obviousness. *See, e.g., Commonwealth Scientific & Indus. Research Org. v. Buffalo Tech. (USA), Inc.*, 542 F.3d 1363, 1375 (Fed. Cir. 2008) (“The secondary consideration evidence, like the evidence with regard to the primary considerations, thus presents factual issues for a trier of fact.”). Leader’s instruction provides the jury the secondary considerations that must be evaluated in an obviousness allegation. Leader’s sentence “answering any, or all, of the above questions ‘yes’ may *suggest* that the claim was not obvious,” explains the reasons why secondary considerations are relevant to an obviousness analysis. As stated previously, the importance of secondary consideration is well settled law. The Federal Circuit in, *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, stated:

Just as it is legal error for a district court to fail to consider relevant evidence going to secondary considerations, it may be legal error for a district court to presuppose that all evidence relating to secondary considerations, when considered with the other Graham indicia relating to the obviousness/nonobviousness issue, cannot be of sufficient probative value to elevate the subject matter of the claimed invention to the level of patentable invention.

776 F.2d 281, 306 (Fed. Cir. 1985) (citations omitted). *See also Simmons Fastener Corp. v. Ill. Tool Works, Inc.*, 739 F.2d 1573, 1575 (Fed. Cir. 1984) (“Only after all evidence of nonobviousness has been considered can a conclusion on obviousness be reached. The trial court’s error lies in its exclusion of such evidence in arriving at a conclusion on the obviousness of the claimed invention.”); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1461 (Fed. Cir. 1984) (“All evidence must be considered before a conclusion on obviousness is reached.”); *Ruiz v. AB Chance Co.*, 234 F.3d 654, 667 (Fed. Cir. 2000) (“Our precedents clearly hold that secondary

considerations, when present, must be considered in determining obviousness.”); *Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1365 (Fed. Cir. 2008)(Court stating secondary considerations often provide some of the best “independent evidence of obviousness.”); *Sud-Chemie, Inc. v. Multisorb Techs., Inc.*, 554 F.3d 1001, 1008 (Fed. Cir. 2009) (“The district court should therefore attend carefully to any evidence of these secondary considerations of nonobviousness on remand.”).

**FACEBOOK'S OBJECTIONS TO LEADER'S PROPOSED JURY
INSTRUCTION NO. 4.15**

Facebook objects to this instruction as it divides up several obviousness instructions into separate instructions. Facebook includes its proposed instructions regarding secondary considerations of non-obviousness in its Proposed Instruction No. 4.10. Facebook notes that its discussion of secondary considerations is nearly identical to Leader's proposed instruction No. 4.15. Facebook did not diminish their importance by not including them as a separate jury instruction or by refusing to agree to Leader's additional statement, not found in the original model instruction, that "Answering any, or all, of the above questions 'yes' may suggest that the claim was not obvious."

Leader's attempt to claim that answering *one* of these answers "yes" may "suggest" the claim is non-obvious is contrary to law and prejudicial to Facebook, and will likely "suggest" to the jury that any showing of secondary considerations is sufficient to rebut Facebook's obviousness defense. *See Newell Companies, Inc. v. Kenney Manufacturing Co.*, 864 F.2d 757, 768-69 (Fed. Cir. 1988) ("[A]lthough these [secondary] factors must be considered, they do not control the obviousness conclusion."); *Richardson-Vicks Inc. v. Upjohn Co.*, 122 F.3d 1476, 1483 (Fed. Cir. 1997) ("The existence of such evidence [of secondary considerations], however, does not control the obviousness determination."); *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 809 (Fed. Cir. 1989) ("Commercial success is an indication of nonobviousness that must be considered in a patentability analysis . . . but in the circumstances of this case, where it is the only such indication, it is insufficient to render [the patentee's] claimed invention nonobvious.")

Meanwhile, the case law Leader cites merely emphasizes that secondary considerations are an important part of the obviousness analysis, but do not support this specific jury instruction.

Further, Facebook specifically objects to any attempt by Leader to introduce its unsupported allegations regarding Mark Zuckerberg, which Leader apparently believes are relevant to secondary considerations. Leader's persistence in attempting to introduce these theories into the case is in disregard of the Court's determination at the pretrial conference that "[i]t's the court's view that there's no place in this trial that's forthcoming for those types of allegations to be part of this case." Tr. at 13:12-14. This statement from the Court was in response to a suggestion by Leader's counsel that such "evidence" could be relevant to secondary considerations of non-obviousness.

LEADER'S PROPOSED JURY INSTRUCTION NO. 4.16
TEACHING AWAY

If the patentee proceeds contrary to accepted wisdom of prior art, this is strong evidence of non-obviousness. Thus, in evaluating the content of the prior art, you must consider the nature of the teaching of the prior art, both what the art teaches one should do, as well as what it teaches one should not do.

AUTHORITY:

Uniform Jury Instructions for Patent Cases in the United States Court for the District of Delaware § 4.8.7 (March 1993); Final Jury Instruction, *Robert Bosch, LLC v. Pylon Manufacturing Corp.*, Case 08-cv-00542-SLR(D. Del. April 23, 2010).

LEADER'S SUPPORT FOR LEADER'S PROPOSED JURY

INSTRUCTION NO. 4.16

Leader's instruction follows the District of Delaware's model jury instruction and cites *Robert Bosch, LLC v. Pylon Manufacturing Corp.*, Case 08-cv-00542-SLR(D. Del. April 23, 2010) which used the same instruction. As the Court in *KSR* stated,

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

**FACEBOOK'S OBJECTIONS TO LEADER'S PROPOSED JURY
INSTRUCTION NO. 4.16**

Facebook objects to this instruction as improper. "Teaching away" is discussed in both Leader and Facebook's Proposed Jury Instruction Nos. 4.10. Also, the phrase "accepted wisdom" of the prior art is vague and confusing, as a *reference* can teach away but "the wisdom" of the prior art cannot. This may allow the jury to believe that because Leader argues that any prior art reference allegedly taught away from the '761 patent, Facebook cannot prove its obviousness case.

Leader has provided no reason that this statement merits its own instruction. Further, Leader has provided no evidence of "teaching away."

5.0 DELIBERATIONS AND VERDICT

STIPULATED PROPOSED JURY INSTRUCTION NO. 5.1 DELIBERATION AND VERDICT

That concludes the part of my instructions explaining the rules for considering some of the testimony and evidence. Now let me finish up by explaining some things about your deliberations in the jury room, and your possible verdicts.

Once you start deliberating, do not talk to the jury officer, or to me, or to anyone else except each other about the case. If you have any questions or messages, you must write them down on a piece of paper, sign them, and then give them to the jury officer. The officer will give them to me, and I will respond as soon as I can. I may have to talk to the lawyers about what you have asked, so it may take me some time to get back to you. Any questions or messages normally should be sent to me through your foreperson, who by custom of this Court is juror No. 1.

One more thing about messages. Do not ever write down or tell anyone how you stand on your votes. For example, do not write down or tell anyone that you are split 4-4, or 6-2, or whatever your vote happens to be. That should stay secret until you are finished.

AUTHORITY:

Uniform Jury Instructions for Patent Cases in the United States Court for the District of Delaware § 7.1 (March 1993).

STIPULATED PROPOSED JURY INSTRUCTION NO. 5.2
UNANIMOUS VERDICT

Your verdict must represent the considered judgment of each juror. In order for you as a jury to return a verdict, it is necessary that each juror agree to the verdict. Your verdict must be unanimous.

It is your duty, as jurors, to consult with one another and to deliberate with a view towards reaching an agreement, if you can do so without violence to your individual judgment. Each of you must decide the case for yourself, but do so only after an impartial consideration of the evidence with your fellow jurors. In the course of your deliberations, do not hesitate to reexamine your own views and change your opinion, if convinced it is erroneous. But do not surrender your honest conviction as to the weight or effect of evidence solely because the opinion of your fellow jurors, or for the purpose of returning a verdict. Remember at all times that you are not partisans. Remember at all times that you are judges of the facts, not me. Your sole interest is to seek the truth from the evidence in the case.

A form of verdict has been prepared for you. You will take this form to the jury room and when you have reached unanimous agreement as to your verdict, you will have your foreperson fill in, date and sign the form. You will then return to the courtroom and your foreperson will give your verdict.

It is proper to add the caution that nothing said in these instructions, and nothing in the form of a verdict, is meant to suggest or convey in any way or manner any intimation as to what verdict I think you should find. What the verdict shall be is your sole and exclusive duty and responsibility.

AUTHORITY:

Uniform Jury Instructions for Patent Cases in the United States Court for the District of Delaware § 7.2 (March 1993).

STIPULATED PROPOSED JURY INSTRUCTION NO. 5.3
DUTY TO DELIBERATE

Now that all the evidence is in and the arguments are completed, you are free to talk about the case in the jury room. In fact, it is your duty to talk with each other about the evidence, and to make every reasonable effort you can to reach unanimous agreement. Talk with each other, listen carefully and respectfully to each other's views, and keep an open mind as you listen to what your fellow jurors have to say. Try your best to work out your differences. Do not hesitate to change your mind if you are convinced that other jurors are right and that your original position was wrong.

But do not ever change your mind just because other jurors see things differently, or just to get the case over with. In the end, your vote must be exactly that – your own vote. It is important for you to reach unanimous agreement, but only if you can do so honestly and in good conscience.

No one will be allowed to hear your discussions in the jury room, and no record will be made of what you say. So you should all feel free to speak your minds.

Listen carefully to what the other jurors have to say, and then decide for yourself.

AUTHORITY:

Uniform Jury Instructions for Patent Cases in the United States Court for the District of Delaware § 7.3 (March 1993).

STIPULATED PROPOSED JURY INSTRUCTION NO. 5.4
COURT HAS NO OPINION

Let me finish by repeating something I said to you earlier. Nothing that I have said or done during this trial was meant to influence your decision in favor of either party. You must decide the case yourselves based on the evidence presented.

AUTHORITY:

Uniform Jury Instructions for Patent Cases in the United States Court for the District of Delaware § 7.4 (March 1993).