IN THE UNITED STATES COURT

FOR THE DISTRICT OF DELAWARE

LEADER TECHNOLOGIES, INC., a Delaware corporation,	**CIVIL ACTION**
Plaintiff and Counterdefendant,	**No. 1:08-cv-00862-LPS**
v.	**CONFIDENTIAL FILED UNDER SEAL**
FACEBOOK, INC., a Delaware corporation,	
Defendant and Counterclaimant.	

FACEBOOK'S PROPOSED AMENDED JURY INSTRUCTIONS REGARDING CLAIM CONSTRUCTION AND PRIOR ART

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FACEBOOK'S PROPOSED AMENDED JURY INSTRUCTION NO. 3.4
CLAIM CONSTRUCTION FOR THE CASE

I will now explain to you the meaning of some of the words of the claims in this case. In doing so, I will explain some of the requirements of the claims. You must accept my definition of these words in the claims as correct. You should not take my definition of the language of the claims as an indication that I have a view regarding how you should decide the issues that you are being asked to decide, such as infringement and invalidity. These issues are yours to decide. I instruct you that the following claim terms have the following definitions:

1. The term "context" means "environment." The term "context" appears in claims 1, 4, 7, 23, and 25 of the '761 Patent.
2. The term "component" means "a computer-related entity, either hardware, a combination of hardware and software, software, or software in execution." The term "component" appears in claims 1, 4, 7, 23, 25, 31 and 32 of the '761 Patent.
3. The term "many-to-many functionality" means "two or more users able to access two or more data files." The term "many-to-many functionality" appears in claim 32 of the '761 Patent.
4. The term "dynamically" means "automatically and in response to the preceding event." The term "dynamically" appears in claims 1, 9, 21 and 23 of the '761 Patent.
5. The term "wherein" means "in which," not "when."

You must not take into consideration any argument that the prosecution history of the patent or the specification of the patent or any other materials that may suggest a different definition of the terms set forth in this instruction. You are not permitted to use any alternative or modified definition in your determination of the infringement and invalidity issues in this case.

AUTHORITY:

Modified The Federal Circuit Bar Association Model Patent Jury Instructions, § 2.3 (February 2010) which cites *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996); *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1360-63 (Fed. Cir. 2008); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005) (en banc); *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1304 (Fed. Cir. 1999); *Cybor Corp. v. FAS Techs.*, 138 F.3d 1448, 1456 (Fed. Cir. 1998); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 977 (Fed. Cir. 1995); Court's March 9, 2010 Claim Construction Order.

Black's Legal Dictionary (8th ed. 2004).

O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co., 521 F.3d 1351 (Fed. Cir. 2008).

FACEBOOK'S SUPPORT FOR ITS AMENDED JURY INSTRUCTION NO. 3.4

Facebook respectfully submits this revised jury instruction regarding claim construction in response to Leader's opening statement and Dr. Vigna's direct testimony, both of which improperly purport to construe the claim term "wherein" to mean "when."[1] For instance, in Leader's opening statement, they improperly argued to the jury:

> You talk about tracking movement of a user from the user environment of the web-based system and then on the second element, you dynamically update the metadata ***when*** you access the files from the second page. That is the ***claim interpretation*** that is in the actual claim itself.

Tr. at 232:13-19 (emphasis added). *Compare* Trial Tr. July 19, 2010 at 228:21-229:1 ("The second component, the tracking component, this calls for tracking a user's movement from one page to another, and then updating that metadata ***when*** a user accesses data from his previous page.") *with* U.S. Pat. No. 7,139,761 cl. 1 ("a computer-implemented tracking component of the network-based system for tracking a change of the user from the first context to a second context of the network-based system and dynamically updating the stored metadata based on the change, ***wherein*** the user accesses the data from the second context") (emphasis added). *See also* Tr. at 668:12-17, 669:13-17, 669:13-17, 687:24-688:5, 708:16-21, 746:19-24 (Dr. Vigna using "when" instead of "wherein" in his discussion of claim language).

This Court did not construe this term during claim construction, as it is a non-technical term to which the term's common meaning should be applied. As claim construction in this case has concluded, the term "wherein" should be given its plain and ordinary meaning, which Facebook proffers to be "in which" in the context of the claim language. *See, e.g.*, Black's Legal Dictionary (8th ed. 2004).

However, beginning with Dr. Vigna's expert report and deposition, *see* Vigna Expert Report at ¶¶ 92, 120, 183, 318 and Vigna Depo. at 167:19-23, and culminating in Leader's opening statement and Dr. Vigna's testimony, Leader has taken the position that "wherein"

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[1] Facebook has repeatedly raised this issue in the time between Leader's submission of Dr. Vigna's report and this amended jury instruction. *See* Facebook Daubert Brief, D.I. 416 at 5-6; *see generally* Facebook's Brief ISO Its Motion for Summary Judgment No. 3, D.I. 391.

means "when." This construction of the word "wherein" is not the plain and ordinary meaning of the word, and Leader has provided no support for its construction. Further, Leader is improperly attempting to argue claim construction to the jury, which, if allowed to continue without intervention from the Court, is cause for reversible error. In *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351 (Fed. Cir. 2008), the Federal Circuit vacated a jury verdict when the Court failed to construe a term in dispute between the parties and submitted the dispute to the jury. In *O2 Micro*, the Federal Circuit stated:

> When the district court failed to adjudicate the parties' dispute regarding the proper scope of 'only if,' the parties presented their arguments to the jury. By failing to construe this term, the district court left the jury free to consider these arguments. . . . [T]he parties' arguments regarding the meaning and legal significance of the "only if" limitation were improperly submitted to the jury.

Id. at 1362. Similarly, in *American Patent Development Corp. v. Movielink, LLC*, 637 F. Supp. 2d 224, 230 (D. Del. 2009) (Farnan J.), the Court found that as a dispute between the parties regarding claim construction had "sharpened" since the Markman hearing, it could not allow the parties to submit expert testimony regarding such claim construction to the jury. Where as here it is clear that the parties dispute the construction of the term "wherein," the dispute is a legal issue for the Court to decide. Submitting this case to the jury without construing the claim term "wherein" would be submission of claim construction to the jury, and would constitute reversible error. *See O2 Micro*, 521 F.3d at 1362.

Finally, Leader is attempting to use the prosecution history and specification of the '761 patent, as well as inventor testimony, to reargue the definition of "dynamically." For example, Leader insisted on counter-designating testimony from Mr. Lamb to the following:

> Q. The term "dynamic association",
> what does that mean to you?
> MS. KOBIALKA: Objection. Form.
> THE WITNESS: Now?
> BY MR. WEINSTEIN:
> Q. Sure.
> A. Now, those two words together
> would mean -- "dynamic" would be an automatic

> and nonpredetermined step; and "association"
> would be the creation of a relationship.

See Lamb Depo. at 159:19-160:3. Leader's apparent motive of insisting on the presentation of this testimony to the jury is to argue that the jury should adopt Mr. Lamb's definition of the term "dynamically" as opposed to the one they are required to apply by virtue of the Court's claim construction order. In addition, Leader asked questions about the prosecution history to and solicited testimony regarding claim construction from Dr. Kearns, and incorporated arguments regarding the prosecution history into its opening statement. *See* Tr. at 230:18-232:8, 1085-1096. This is improper argument of claim construction to the jury, particularly as the Court has already construed the term "dynamically." Thus, Facebook proposes a limiting instruction to the jury that they are to ignore these arguments.

FACEBOOK'S PROPOSED AMENDED 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 published United States patent application or issued United States patent with a filing date that predates the invention date of the '761 Patent.

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

(1) European Patent Application No. EP 1087306 ("Hubert '306") and U.S. Patent No. 7,590,934 ("Hubert '934") (which contains the same disclosures)

(2) U.S. Patent No. 6,236,994 ("Swartz '994")

(3) U.S. Patent No. 6,434,403 B1 ("Ausems '403")

(4) The iManage DeskSite 6.0 User Reference Manual, July 26, 2001 ("iManage Manual")

(5) iManage 6.0, based on the disclosures of the iManage Manual

(6) Leader's product, Leader2Leader powered by Digital Leaderboard ("Leader2Leader")

AUTHORITY:

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