IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

PERSONALIZED USER MODEL, L.L.P.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	
	)	
GOOGLE, INC.,	)	
	)	
Defendant.	)	
	)	C.A. No. 09-525 (LPS)
GOOGLE, INC.,	)	
	)	
Counterclaimant,	)	
	)	
v.	)	
	)	
PERSONALIZED USER MODEL, L.L.P. and YOCHAI KONIG,	)	
	)	
Counterclaim-Defendants.	)	

JOINT PROPOSED PRELIMINARY JURY INSTRUCTIONS

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February 21, 2014

INTRODUCTION (JOINTLY SUBMITTED)

Members of the jury: Now that you have been sworn in, I am going to give you some preliminary instructions for guidance on your role as jurors in this case.

These instructions are intended to introduce you to the case and the law that you will apply to the evidence that you will hear. I will give you more detailed instructions on the law at the end of the trial. Also, because this is case involves patents, which will deal with subject matter that is not within the everyday experience of most of us, I will also give you some preliminary instructions regarding patents to assist you in discharging your duties as jurors.

Authority: DePuy Synthes Products, LLC, v. Globus Medical, Inc., No. 1:11-CV-00652-LPS (D. Del. June 3, 2013) Preliminary Jury Instructions § I; Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc., No. 1:08-CV-00309-LPS (D. Del. Apr. 10, 2012) Preliminary Jury Instructions § I; Tarkus Imaging, Inc. v. Adobe Sys., Inc., No. 1:10-cv-063-LPS (D. Del June 18, 2012) Preliminary Jury Instructions at 1; Uniform Jury Instructions for Patent Cases in the United States District Court for the District of Delaware (March 1993) ("Delaware Uniform Patent Jury Instructions") at 3.

THE PARTIES AND THEIR CONTENTIONS (SUBMITTED BY PUM)

Before I begin with those instructions, however, allow me to give you an overview of who the parties are and what each contends.

You may recall that during the process that led to your selection as jurors, I advised you that this is a civil action for patent infringement arising under the patent laws of the United States.

I will now review for you the parties in this action and the positions that you will have to consider in reaching your verdict. The Plaintiff in this case is Personalized User Model or PUM for short. The Defendant in this case is Google.

The two United States Patents at issue in this case are U.S. Patent Numbers 6,981,040, and 7,685,276. For simplicity, I will refer to these patents by their last three numbers, as "the '040 patent" and "the '276 patent." A copy of each of these patents has been given to you along with these preliminary instructions. Collectively, I will refer to these patents as the "Asserted Patents" or the "Patents-in-Suit." Sometimes, patents are referred to by the name of one of the inventors followed by the last three digits of their patent number. So, for example, you may hear the attorneys and witnesses in this case refer to the '040 patent as the Konig '040 patent.

PUM contends that Google products infringe certain claims of the Asserted Patents. Collectively, I and the attorneys will refer during the case to the claims that are asserted as the "Asserted Claims." Each asserted claim must be considered separately to determine infringement and infringement of any one claim constitutes infringement of the patent.

PUM contends that Google infringes the Asserted Claims of the Patents-in-Suit because Google makes, uses, sells or offers for sale the certain products without PUM's authorization. These products, which I will refer to as the "Accused Products," are Google Search, Google's

Search Ads System (Adwords); Google's Content Ads System (Adsense, including advertising on YouTube); and Google's YouTube Video Recommendations.

Google denies that the Accused Products infringe the asserted claims of the Patents-in-Suit. Google also contends that the Patents-in-Suit are invalid because they are anticipated, or rendered obvious by, the prior art. I will define what prior art is and instruct you as to infringement and defenses to a charge of infringement in my instructions to you at the close of evidence.

Google also asserts a breach of contract claim against one of the inventors of the Patents-in-Suit, Dr. Konig based on its assertion that Dr. Konig should have assigned his inventions to his prior employer, SRI. PUM and Dr. Konig deny these claims, and have asserted various defenses, including that SRI did not assign to Google its right to assert a breach of contract claim against Dr. Konig, and that Google's claims are unfounded because the inventions do not fall within the scope of Dr. Konig's employment agreement and are untimely because they are barred by the statute of limitations. PUM also contends that Dr. Konig's inventions were protected from assignment under California law. [1]

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[1] Google proposes that the jury be instructed that Google claims that "because of this breach claim, Google is a rightful owner of the patents-in-suit." First, it is undisputed that ownership is an issue for the Court, not the jury, and there is no dispute that Google is not now "a rightful owner." *See Archnid. Inc. v. Merit Indus., Inc.*, 939 F.2d 1574, 1579 (Fed. Cir. 1991); *Bd. of Trustees of Leland Stanford v. Roche*, 583 F.3d 832, 841-42 (Fed. Cir. 2009). Further, Google must do more than prove breach of contract to be declared an owner. *See, e.g., Motion in limine* (Ex. 12 to the Proposed Final Pretrial Order). It must establish that it has standing to assert SRI's breach claim, that the claim is not barred by the statute of limitations, that Dr. Konig's assignment to Utopy and its assigns does not prevent the Court from declaring Google an owner, and that PUM and its predecessors are not good faith purchasers for value pursuant to 35 U.S.C. § 261.

I will also instruct you as on these claims and defenses in my instructions to you at the close of the evidence.

Authority: DePuy Synthes Products, LLC, v. Globus Medical, Inc., No. 1:11-CV-00652-LPS (D. Del. June 3, 2013) Preliminary Jury Instructions §§ II and IV; Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc., No. 1:08-CV-00309-LPS (D. Del. Apr. 10, 2012) Preliminary Jury Instructions § II; Tarkus Imaging, Inc. v. Adobe Sys., Inc., No. 1:10-cv-063-LPS (D. Del June 18, 2012) Preliminary Jury Instructions at 1-3; Uniform Jury Instructions for Patent Cases in the United States District Court for the District of Delaware (March 1993) ("Delaware Uniform Patent Jury Instructions") at 3.

THE PARTIES AND THEIR CONTENTIONS (SUBMITTED BY GOOGLE)[2]

Before I begin with those instructions, however, allow me to give you an overview of who the parties are and what each alleges.

You may recall that during the process that led to your selection as jurors, I advised you that this is a civil action for patent infringement arising under the patent laws of the United States. The parties in this case are the plaintiff Personalized User Model, LLC (whom I will refer to as "Plaintiff" or "PUM") and defendant Google Inc. (whom I will refer to "Defendant" or "Google").

PUM alleges that it owns two (2) patents which it alleges that Google infringes: U.S. Patent Nos. 6,981,040 ("the '040 Patent") and 7,685,276 ("the '276 Patent"). The attorneys and witnesses may sometimes refer to these patents collectively as the "patents-in-suit." For convenience, patents are usually referred to by the last three digits of their patent number. For example, Patent No. 6,981,040 may simply be called "the '040 Patent." You may hear the attorneys and witnesses refer to Patent No. 7,685,276 as "the '276 Patent."

PUM contends that Google infringes 11 claims of the patents-in-suit. These may be referred to as the "asserted claims," and are as follows: claims 1, 11, 22, and 34 of the '040 Patent and claims 1, 3, 5, 6, 7, 21, and 22 of the '276 Patent. Each asserted claim must be considered separately to determine infringement.

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[2] Based on the preliminary jury instructions in *Sunovion Pharmaceuticals Inc. v. Dey Pharama, L.P. et al.*, C.A. No. 06-113 (LPS), District of Delaware, D.I. 540 (Preliminary Jury Instructions) (D. Del. Jan. 27, 2012); The Uniform Jury Instruction for Patent Cases in the United States District Court for the District of Delaware (March 1993); *British Telecommunications PLC v. Google Inc.*, No. 11-1249-LPS, D.I. 401 (Preliminary Jury Instructions) (D. Del. Jan. 31, 2014).

PUM contends that Google infringes the asserted claims of the patents in suit because Google makes, uses, sells or offers for sale certain systems or services without PUM's authorization**.** These systems and services include Google Search; Google's Search Ads; AdSense for Content; and YouTube.

Non-infringement and invalidity are defenses to a charge of infringement. Google denies that it has infringed the patents-in-suit. Google further alleges that the asserted claims of the patents-in-suit are invalid because the patents in suit are anticipated by prior art publications, patents, and products that existed at the time of the invention or were obvious in view of the state of the art at that time. Google also asserts that named inventor of the patents-in-suit Yochai Konig breached his employment agreement with his former employer and that because of this breach, Google is a rightful owner of the patents-in-suit. PUM and Konig deny these claims, and assert that the inventions do not fall within the scope of Konig's employment agreement and that Google's claims are untimely.

I will instruct you as to infringement and defenses to a charge of infringement, and breach of contract, in my instructions to you at the close of the evidence.

DUTIES OF THE JURY (JOINTLY SUBMITTED)

Let me now turn to the general rules that will govern the discharge of your duties as jurors in this case. It will be your duty to find what the facts are based on the evidence as presented at trial. You and you alone will be the judges of the facts. In judging the facts, it will be up to you to decide which witnesses to believe, which witnesses not to believe, and how much of any witness's testimony to accept or reject. I will decide which rules of law apply to this case as I will instruct you both during these preliminary instructions and at the close of the evidence. You must follow that law whether you agree with it or not. In addition to instructing you about the law, I will provide you with instructions as to what the claims of the patents mean. You are bound by your oath as jurors to follow these and all the instructions that I give you, even if you personally disagree with them. All the instructions are important, and you should consider them together as a whole. You will then apply the law to the facts as you find them.

Perform these duties fairly. Do not let any bias, sympathy, or prejudice that you may feel toward one side or the other influence your decision in any way. Also, do not let anything that I may say or do during the course of the trial influence you. Nothing that I may say or do is intended to indicate, or should be taken by you as indicating, what your verdict should be.

Authority: DePuy Synthes Products, LLC, v. Globus Medical, Inc., No. 1:11-CV-00652-LPS (D. Del. June 3, 2013) Preliminary Jury Instructions § VI; Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc., No. 1:08-CV-00309-LPS (D. Del. Apr. 10, 2012) Preliminary Jury Instructions § III; Tarkus Imaging, Inc. v. Adobe Sys., Inc., No. 1:10-cv-063-LPS (D. Del June 18, 2012) Preliminary Jury Instructions at 3-4; Uniform Jury Instructions for Patent Cases in the United States District Court for the District of Delaware (March 1993) ("Delaware Uniform Patent Jury Instructions") at 7; Sunovion Pharmaceuticals Inc. v. Dey Pharama, L.P. et al., C.A. No. 06-113 (LPS), District of Delaware, D.I. 540 (Preliminary Jury Instructions) (D. Del. Jan. 27, 2012); *British Telecommunications PLC v. Google Inc.*, No. 11-1249-LPS, D.I. 401 (Preliminary Jury Instructions) (D. Del. Jan. 31, 2014)

EVIDENCE (JOINTLY SUBMITTED)

The evidence from which you will find the facts will consist of the testimony of witnesses, documents and other things received into the record as exhibits, and any facts that the lawyers agree to or stipulate to or that I may instruct you to find. The testimony of witnesses consists of the answers of the witnesses to questions posed by the attorneys or the court--you may not ask questions.

Certain things are not evidence and must not be considered by you. I will list them for you now.

1. Statements, arguments, and questions by the attorneys are not evidence.

2. Objections to questions are not evidence. Attorneys have an obligation to their clients to make objections when they believe evidence being offered is improper under the rules of evidence. You should not be influenced by the objection or by the Court's ruling on it. If the objection is sustained, ignore the question. If it is overruled, treat the answer like any other. If you are instructed that some item of evidence is received for a limited purpose only, you must follow that instruction. If I give a limiting instruction during trial, I will try to clarify this for you at that time.

3. Testimony that the court has excluded or told you to disregard is not evidence and must not be considered.

4. During trial, you will be shown charts and animations to help illustrate the testimony of the witnesses. These illustrative exhibits, called "demonstrative exhibits," are not admitted into evidence and should not be considered as evidence.

5. Anything you may have seen or heard outside the courtroom is not evidence and must be disregarded. You are to decide the case solely on the evidence presented here in the courtroom.

There are two kinds of evidence: direct and circumstantial. Direct evidence is direct proof of a fact, such as testimony of an eyewitness. Circumstantial evidence is indirect proof or proof of facts from which you may conclude that other facts exist. If someone walked into the courtroom wearing a raincoat covered with drops of water and carrying a wet umbrella, that would be circumstantial evidence from which you could infer that it was raining outside.

As a general rule, the law makes no distinction between these two types of evidence, but simply requires that you find facts from all the evidence in the case, whether direct, circumstantial, or a combination of the two. In judging the facts, you should consider all the evidence, both direct and circumstantial, and give it whatever weight you believe it deserves. It will be up to you to decide which witnesses to believe, which witnesses not to believe, the weight you believe the testimony deserves, and how much of any witness's testimony to accept or reject.

Authority: DePuy Synthes Products, LLC, v. Globus Medical, Inc., No. 1:11-CV-00652-LPS (D. Del. June 3, 2013) Preliminary Jury Instructions § VII; Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc., No. 1:08-CV-00309-LPS (D. Del. Apr. 10, 2012) Preliminary Jury Instructions § IV; Tarkus Imaging, Inc. v. Adobe Sys., Inc., No. 1:10-cv-063-LPS (D. Del June 18, 2012) Preliminary Jury Instructions at 4-5; Uniform Jury Instructions for Patent Cases in the United States District Court for the District of Delaware (March 1993) ("Delaware Uniform Patent Jury Instructions") at 7-8; Sunovion Pharmaceuticals Inc. v. Dey Pharama, L.P., et al., C.A. No. 06-113 (LPS), District of Delaware, D.I. 540 (Preliminary Jury Instructions) (D. Del. Jan. 27, 2012); *British Telecommunications PLC v. Google Inc.*, No. 11-1249-LPS, D.I. 401 (Preliminary Jury Instructions) (D. Del. Jan. 31, 2014)

CREDIBILITY OF WITNESSES – WEIGHING CONFLICTING TESTIMONY (JOINTLY SUBMITTED)

You are the sole judges of each witness's credibility. You should consider each witness's source of knowledge, reliability of memory and opportunity to observe; how reasonable or unreasonable the testimony is; whether it is consistent or inconsistent; whether it has been contradicted; the witness's biases, prejudices, or interest; the witness's demeanor on the witness stand; and all the circumstances that, according to the evidence, could affect the credibility of the testimony.

If you find the testimony to be contradictory, you must try to reconcile it, if reasonably possible, so as to make one harmonious story of it all. But if you can't do this, then it is your duty and privilege to believe the testimony that, in your judgment, is most believable and disregard any testimony that, in your judgment, is not believable. This instruction applies to the testimony of all witnesses, including expert witnesses.

EXPERT TESTIMONY

Expert testimony is testimony from a person who has a special skill or knowledge in some science, profession, or business. This skill or knowledge is not common to the average person but has been acquired by the expert through special study or experience. In weighing expert testimony, you may consider the expert's qualifications, the reasons for the expert's opinions, and the reliability of the information supporting the expert's opinions, as well as the factors I have previously mentioned for weighing testimony of any other witness. Expert testimony should receive whatever weight and credit you think appropriate, given all the other evidence in the case. You are free to accept or reject the testimony of experts, just as with any other witness.

Authority: DePuy Synthes Products, LLC, v. Globus Medical, Inc., No. 1:11-CV-00652-LPS (D. Del. June 3, 2013) Preliminary Jury Instructions § VIII; Tarkus Imaging, Inc. v. Adobe Sys., Inc., No. 1:10-cv-063-LPS (D. Del June 18, 2012) Preliminary Jury Instructions at 5-6.

BURDEN OF PROOF (SUBMITTED BY PUM)

In any legal action, facts must be proven by a required standard of evidence, known as the "burden of proof." In a patent case such as this, there are two different burdens of proof that are used. The first is called "preponderance of the evidence." The second is called "clear and convincing evidence."

As I have already told you, in this case, PUM alleges that Google infringes the Patents-in-Suit. PUM, therefore, has the burden of proving infringement by what is called a preponderance of the evidence. That means PUM has to produce evidence which, considered in the light of all the facts, leads you to believe that what PUM alleges is more likely true than not.

To put it differently, if you were to put PUM's and Google's evidence on opposite sides of a scale, the evidence supporting PUM's allegations would have to make the scale tip somewhat towards PUM's side. If PUM fails to meet this burden, your verdict must be for Google.

As I noted earlier, Google asserts that PUM's patents are invalid. A patent, however, is presumed to be valid. Accordingly, Google has the burden of proving by clear and convincing evidence that the patents are invalid. [3] Clear and convincing evidence is evidence that produces

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[3] Google requests that if the Court precludes evidence of the reexamination proceedings, the Court should instruct the jury that Google need only prove invalidity by a preponderance of the evidence. This is contrary to law. *See Microsoft Corp. v. i4i P'ship*, --- U.S. ---, 131 S.Ct. 2238, 2250-51 (2011) (holding presumption of validity and clear and convincing evidence standard apply even where defendant presents evidence of prior art the PTO did not review). This is because "[n]othing in §282's text suggests that Congress meant to . . . enact a standard of proof that would rise and fall with the facts of each case." *Id.* at 2250. "Any re-calibration of the standard of proof remains in [Congress'] hands," *id.* at 2252, and while "Congress has often amended § 282" in the last 30 years, "not once . . . has it even considered a proposal to lower the standard of proof." *Id.*

an abiding conviction that the truth of a factual contention is highly probable. Proof by clear and convincing evidence is thus a higher burden than proof by a preponderance of the evidence.

Google also has to prove its breach of contract claim by a preponderance of the evidence. PUM in turn must prove by a preponderance of the evidence its defenses to that claim, namely that the claim is time-barred, and that the inventions are protected from assignment under California law.

Those of you who have sat on criminal cases will have heard the term proof beyond a reasonable doubt. That requirement does not apply to a civil case; therefore, you should put it out of your mind.

Authority: DePuy Synthes Products, LLC, v. Globus Medical, Inc., No. 1:11-CV-00652-LPS (D. Del. June 3, 2013) Preliminary Jury Instructions § V; Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc., No. 1:08-CV-00309-LPS (D. Del. Apr. 10, 2012) Preliminary Jury Instructions § V; Tarkus Imaging, Inc. v. Adobe Sys., Inc., No. 1:10-cv-063-LPS (D. Del June 18, 2012) Preliminary Jury Instructions at 6-7; Uniform Jury Instructions for Patent Cases in the United States District Court for the District of Delaware (March 1993) ("Delaware Uniform Patent Jury Instructions") at 8-9.

BURDEN OF PROOF (SUBMITTED BY GOOGLE)[4]

In any legal action, facts must be proven by a required standard of evidence, known as the "burden of proof."

PUM has the burden of proving that Google infringes the asserted patents by what is called a preponderance of the evidence. That means PUM has to produce evidence which, when considered in the light of all the facts, leads you to believe that what PUM alleges is more likely true than not. To put it differently, if you were to put PUM's and Google's evidence on opposite sides of a scale, the evidence supporting PUM's allegations would have to make the scale tip somewhat on its side. If PUM fails to meet this burden, the verdict must be for Google.

[**Google Proposal 1**: As I noted earlier, Google contends that the patents-in-suit are invalid. Google, as the party challenging the patents, has the burden of proving by a preponderance of the evidence that the patents-in-suit are invalid.][5]

[**Google Proposal 2**: As I noted earlier, Google contends that the patents-in-suit are invalid. Google, as the party challenging the patents, has the burden of proving by clear and convincing evidence that the patents-in-suit are invalid. Clear and convincing evidence is

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[4] Based on the preliminary jury instructions in *Sunovion Pharmaceuticals Inc. v. Dey Pharama, L.P. et al.*, C.A. No. 06-113 (LPS), District of Delaware, D.I. 540 (Preliminary Jury Instructions) (D. Del. Jan. 27, 2012); The Uniform Jury Instruction for Patent Cases in the United States District Court for the District of Delaware (March 1993); *British Telecommunications PLC v. Google Inc.*, No. 11-1249-LPS, D.I. 401 (Preliminary Jury Instructions) (D. Del. Jan. 31, 2014).

[5] As detailed in Google's Opposition to PUM's Motion *In Limine* to Exclude Evidence of Reexamination Proceedings at Trial, the final PTO rejections of both patents in suit are relevant information for the jury to consider and should not be excluded. (*See* Final Pretrial Order, Ex.13.) In the event that the Court precludes Google from introducing evidence that the patents in suit have been rejected by the PTO during the reexamination process, though, Google requests that the Court read the first alternative instruction. Because the PTO issued final rejections of both patents, the presumption of validity should no longer apply, and Google should not have to meet a higher burden of proof to demonstrate invalidity.

evidence that produces an abiding conviction that the truth of a factual contention is highly probable.]

Google also contends that one of the named inventors of the patents-in-suit, Yochai Konig, breached his employment agreement with a former employer, and by virtue of that breach, Google is the rightful owner of the patents-in-suit. Google has the burden of proving breach of contract by a preponderance of the evidence. Google also asserts that Konig and PUM unlawfully converted SRI's and Google's interest in the patents-in-suit by failing to assign the patents to SRI and must prove this by a preponderance of the evidence. PUM in turn must prove by a preponderance of the evidence its defenses to Google's breach of contract claim.

Those of you who have sat on criminal cases will have heard of proof beyond a reasonable doubt. That is a strict standard of proof and it only applies to criminal cases. That requirement does not apply to a civil case; therefore, you should put it out of your mind.

PATENT VIDEO (JOINTLY SUBMITTED)

At this time, we are going to show a 17-minute video as an introduction to the patent system. It contains background information to help you understand what patents are, why they are needed, the role of the Patent Office, and why disputes over patents arise. This video was prepared by the government, not by the parties. In addition, many of the terms you will hear during this trial are contained in the "Glossary of Patent Terms," which you can find at the end of these preliminary instructions. Feel free to refer to the Glossary throughout the trial.

Authority: DePuy Synthes Products, LLC, v. Globus Medical, Inc., No. 1:11-CV-00652-LPS (D. Del. June 3, 2013) Preliminary Jury Instructions § III; Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc., No. 1:08-CV-00309-LPS (D. Del. Apr. 10, 2012) Preliminary Jury Instructions § VI; Tarkus Imaging, Inc. v. Adobe Sys., Inc., No. 1:10-cv-063-LPS (D. Del June 18, 2012) Preliminary Jury Instructions at 7.

SUMMARY OF ISSUES (SUBMITTED BY PUM)

In this case, you must decide several things according to the instructions that I shall give you at the end of the trial. Those instructions will repeat this summary and will provide more detail. One thing you will not need to decide is the meaning of the patent claims. That is one of my jobs - to decide what the patent claims mean. In essence, you must decide:

1. Whether PUM has proven by a preponderance of the evidence that Google's Accused Products infringed or that Google actively induced infringement with respect to any or all of the asserted claims of the Patents-in-Suit.

2. Whether Google has proven by clear and convincing evidence that the Asserted Claims are invalid as anticipated or obvious by prior art.

3. Whether Google has proven by a preponderance of the evidence that Dr. Konig breached his employment agreement.

4. Whether PUM has proven by a preponderance of the evidence that Google's breach of contract claim is time-barred, and that Dr. Konig's invention is protected by California law.

Authority: Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc., No. 1:08-CV-00309-LPS (D. Del. Apr. 10, 2012) Preliminary Jury Instructions § VIII; Tarkus Imaging, Inc. v. Adobe Sys., Inc., No. 1:10-cv-063-LPS (D. Del June 18, 2012) Preliminary Jury Instructions at 10-11.

SUMMARY OF ISSUES (SUBMITTED BY GOOGLE)[6]

In this case, you must decide several things according to the instructions that I will give you at the end of the trial. Those instructions will repeat this summary and will provide more detail. One thing you will not need to decide is the meaning of the patent claims. That is one of my jobs — to explain to you what the patent claims mean. Meanwhile, you will find a definition in the glossary attached to these preliminary instructions. In essence, you must decide:

(1) whether PUM has proven by a preponderance of the evidence that one or more of the accused systems or services infringes one or more of the asserted claims of the patents-in-suit;

(2) whether Google has proven [Google Alternative 1: by a preponderance of the evidence] [Google Alternative 2: by clear and convincing evidence] that one or more of the asserted claims of the patents-in-suit is invalid;

(3) whether Google has proven by a preponderance of the evidence that Yochai Konig breached his employment contract with SRI;

(4) whether Google has proven by a preponderance of the evidence that it is a rightful owner of the patents-in-suit because Konig and PUM unlawfully converted SRI's and Google's interest in the patents-in-suit by failing to assign the patents to SRI; and

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[6] Based on the preliminary jury instructions in *Sunovion Pharmaceuticals Inc. v. Dey Pharama, L.P. et al.*, C.A. No. 06-113 (LPS), District of Delaware, D.I. 540 (Preliminary Jury Instructions) (D. Del. Jan. 27, 2012); The Uniform Jury Instruction for Patent Cases in the United States District Court for the District of Delaware (March 1993); *British Telecommunications PLC v. Google Inc.*, No. 11-1249-LPS, D.I. 401 (Preliminary Jury Instructions) (D. Del. Jan. 31, 2014).

(5) whether PUM has proven by a preponderance of the evidence that Google's breach of contract claim is time-barred, and that Yochai Konig's invention is protected from assignment by California law.

CONDUCT OF THE JURY (JOINTLY SUBMITTED)

Now, a few words about your conduct as jurors.

First, I instruct you that during the trial you are not to discuss the case with anyone or permit anyone to discuss it with you. Until you retire to the jury room at the end of the case to deliberate on your verdict, you simply are not to talk about this case. If any lawyer, party, or witness does not speak to you when you pass in the hall, ride the elevator, or the like, remember it is because they are not supposed to talk with you nor you with them. In this way, any unwarranted and unnecessary suspicion about your fairness can be avoided. If anyone should try to talk to you about this case, bring it to the Court's attention promptly.

Second, I know that many of you use cell phones, the Internet and other tools of technology to communicate. You must not use these tools to communicate electronically with anyone about the case. This includes your family and friends. Just to reiterate, you may not communicate with anyone about the case on your cell phone, through e-mail, text messaging, through any blog, through any Internet chat room, or by way of any other social networking website, including Twitter, Facebook, Myspace, LinkedIn, and YouTube.

Third, except in the courtroom during trial, do not read or listen to anything touching on this case in any way. By that I mean, if there may be a newspaper article or radio or television report relating to this case, do not read the article or watch or listen to the report.

Fourth, do not try to do any research or make any investigation about the case on your own.

Let me elaborate. During the course of the trial, you must not conduct any independent research about the case, the matters in the case, and the individuals or entities involved in the case. In other words, you should not consult dictionaries or reference materials, search the internet, websites, blogs, or any other electronic means. Also, should there happen to be a

newspaper article or radio or television report relating to this case, do not read the article or listen to the report. It is important that you decide this case based solely on the evidence presented in the courtroom. Please do not try to find out information from any other sources.

Finally, do not form any opinion until all the evidence is in. Keep an open mind until you start your deliberations at the end of the case.

During the trial, you may, but are not required to, take notes regarding testimony; for example, exhibit numbers, impressions of witnesses or other things related to the proceedings. A word of caution is in order. There is generally a tendency to attach undue importance to matters which one has written down. Some testimony which is considered unimportant at the time presented, and thus not written down, takes on greater importance later in the trial in light of all the evidence presented. Therefore, you are instructed that your notes are only a tool to aid your own individual memory and you should not compare your notes with other jurors in determining the content of any testimony or in evaluating the importance of any evidence. Your notes are not evidence, and are by no means a complete outline of the proceedings or a list of the highlights of the trial. Also, keep in mind that you will not have a transcript of the testimony to review. So, above all, your memory will be your greatest asset when it comes time to deliberate and render a decision in this case.

If you do take notes, you must leave them in the jury deliberation room which is secured at the end of each day. And, remember that they are for your own personal use.

I will give you detailed instructions on the law at the end of the case, and those instructions will control your deliberations and decision.

Authority: DePuy Synthes Products, LLC, v. Globus Medical, Inc., No. 1:11-CV-00652-LPS (D. Del. June 3, 2013) Preliminary Jury Instructions § IX; Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc., No. 1:08-CV-00309-LPS (D. Del. Apr. 10, 2012) Preliminary Jury Instructions § IX; Tarkus Imaging, Inc. v. Adobe Sys., Inc., No. 1:10-cv-063-LPS (D. Del

June 18, 2012) Preliminary Jury Instructions at 11-13; Uniform Jury Instructions for Patent Cases in the United States District Court for the District of Delaware (March 1993) ("Delaware Uniform Patent Jury Instructions") at 9-10.

COURSE OF THE TRIAL (JOINTLY SUBMITTED)

The trial will now begin.

First, each side may make an opening statement outlining its case. The opening statements are not evidence. They are intended to explain to you what each side intends to prove and are offered to help you follow the evidence. It will be up to you to determine whether the evidence - the testimony of the witnesses and the admitted documents - supports what the attorneys say in their opening statements.

After the opening statements, PUM will present its witnesses, and Google may cross-examine them. Then Google will present its witnesses, and PUM may cross-examine them.

Lawyers are permitted to make transition statements whenever they call a witness to the stand, to introduce the witness and to briefly explain the relevance of the witness's anticipated testimony. I have already instructed you that what the attorneys say is not evidence. These transition statements may be given only to help you follow along.

After all the evidence is presented, the attorneys will make their closing arguments. The closing arguments are not evidence. Their purpose is to summarize and interpret the evidence for you. I will then give you final instructions on the law and describe for you the matters you must resolve. You will then retire to the jury room to deliberate on your verdict.

[Google's Proposal: At the end of this trial and before you begin your deliberations, I will read and give you a copy of written instructions on the law.

Please keep in mind that evidence is often introduced somewhat piecemeal. So, as the evidence comes in, you as jurors need to keep an open mind.

We will begin shortly, but first I want to outline the anticipated schedule of the trial.]

Authority: DePuy Synthes Products, LLC, v. Globus Medical, Inc., No. 1:11-CV-00652-LPS (D. Del. June 3, 2013) Preliminary Jury Instructions § X; Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc., No. 1:08-CV-00309-LPS (D. Del. Apr. 10, 2012) Preliminary Jury Instructions § X; Uniform Jury Instructions for Patent Cases in the United States District Court for the District of Delaware (March 1993) ("Delaware Uniform Patent Jury Instructions") at 10.

TRIAL SCHEDULE (JOINTLY SUBMITTED)

Though you have heard me say this during jury selection, I want to again outline the schedule I expect to maintain during the course of this trial.

This case is expected to take __ days to try. We will normally begin the day at ___ A.M. promptly. We will go until ___ P.M. and, after a ___ break for lunch, continue from ___ P.M. to ___ P.M. There will be a fifteen minute break around ___ A.M. and another fifteen minute break at ___ P.M. The only significant exception to this schedule may occur when the case is submitted to you for your deliberations. On that day, the proceedings might last beyond 5:00 P.M.

Authority: Sunovion Pharmaceuticals Inc. v. Dey Pharama, L.P. et al., C.A. No. 06-113 (LPS), District of Delaware, D.I. 540 (Preliminary Jury Instructions) (D. Del. Jan. 27, 2012).

GLOSSARY OF PATENT TERMS (SUBMITTED BY PUM)

Applicants: The named inventors who are applying for the patent.

Assignment: Transfer of ownership rights in a patent or patent application from one person or company to another.

Claims: That part of a patent that defines the invention. These are found at the end of the patent specification in the form of numbered paragraphs.

Disclosure of Invention: That part of the patent specification that explains how the invention works and usually includes a drawing.

File Wrapper, File History, or Prosecution History: The written record of proceedings in the United States Patent and Trademark Office ("Patent Office" or "PTO"), including the original patent application and later rejections, responses to the rejections and other communications between the Patent Office and the applicant.

Limitation: A required part of an invention set forth in a patent claim. A limitation is a requirement of the invention. The word "limitation" is often used interchangeably with the word "requirement." The phrase "claim limitation" is often used interchangeably with the phrase "claim element."

Patent Application: The initial papers filed in the Patent Office by an applicant. These typically include a specification, drawings, claims, and the oath (Declaration) of the applicant.

Patent Examiners: Personnel employed by the Patent Office having expertise in various technical areas who review (examine) patent applications to determine whether the claims of a patent application are patentable and whether the disclosure adequately describes the invention.

Prior Art: Any information that is used to describe public, technical knowledge prior to the invention by the applicant or more than a year prior to the filing of his/her application.

Prior Art References: Any item of prior art (publication patent, or product) used to determine patentability.

Specification: That part of the patent application or patent that describes the invention, and may include drawings. The specification does not define the invention; only the claims do.

Written Description: That part of the patent specification which explains how the invention works and usually includes a drawing.

Authority: Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc., No. 1:08-CV-00309-LPS (D. Del. Apr. 10, 2012) Preliminary Jury Instructions Glossary; Tarkus Imaging, Inc. v. Adobe Sys., Inc., No. 1:10-cv-063-LPS (D. Del June 18, 2012) Preliminary Jury Instructions

Glossary; Uniform Jury Instructions for Patent Cases in the United States District Court for the District of Delaware (March 1993) ("Delaware Uniform Patent Jury Instructions") at 12.

GLOSSARY OF PATENT TERMS (SUBMITTED BY GOOGLE)[7]

Some of the terms in this glossary will be defined in more detail in the legal instructions you are given. The definitions in the instructions must be followed and must control your deliberations.

Amendment: A patent applicant's change to one or more claims or to the specification either in response to an office action taken by an Examiner or independently by the patent applicant during the patent application examination process.

Anticipation: A situation in which each element of a claimed invention is described in a single prior art reference and, therefore, is not considered new and is not entitled to be patented.

Applicants: The named inventors who are applying for the patent.

Assignment: A transfer of patent rights to another called an "assignee" who, upon transfer, becomes the owner of the rights assigned.

Claim: Each claim of a patent is a concise, formal definition of an invention and appears at the end of the specification in a separately numbered paragraph. In concept, a patent claim marks the boundaries of the patent in the same way that a legal description in a deed specifies the boundaries of land, i.e., similar to a landowner who can prevent others from trespassing on the bounded property, the inventor can prevent others from using what is claimed. Claims may be independent or dependent. An independent claim stands alone. A dependent claim does not

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[7] Based on the preliminary jury instructions in *Sunovion Pharmaceuticals Inc. v. Dey Pharama, L.P. et al.*, C.A. No. 06-113 (LPS), District of Delaware, D.I. 540 (Preliminary Jury Instructions) (D. Del. Jan. 27, 2012); The Uniform Jury Instruction for Patent Cases in the United States District Court for the District of Delaware (March 1993); *British Telecommunications PLC v. Google Inc.*, No. 11-1249-LPS, D.I. 401 (Preliminary Jury Instructions) (D. Del. Jan. 31, 2014).

stand alone and refers to one or more other claims. A dependent claim incorporates whatever the other referenced claim or claims say.

Elements: The required steps of a method claim. A use infringes a method patent if it contains each and every requirement of a patent claim.

Embodiment: A method that is an example of the claimed invention.

Examination: Procedure before the U.S. Patent and Trademark Office whereby an Examiner reviews the filed patent application to determine if the claimed invention is patentable.

Filing Date: Date a patent application, with all the required sections, has been submitted to the U.S. Patent and Trademark Office.

Infringement: Violation of a patent occurring when someone makes, uses, or sells a patented invention, without permission of the patent holder, within the United States during the term of the patent. Direct infringement is making, using, or selling the patented invention without permission

Limitation: A required part of an invention set forth in a patent claim, A limitation is a requirement of the invention. The word "limitation" is often used interchangeably with the word "requirement."

Nonobviousness: One of the requirements for securing a patent. To be valid, the subject matter of the invention must not have been obvious to a person of ordinary skill in the field at the time of the filing date of the patent application.

Office Action: A written communication from the Examiner to the patent applicant in the course of the application examination process.

Patent: A patent is an exclusive right granted by the U.S. Patent and Trademark Office to an inventor to prevent others from making, using, or selling an invention for a term of 20 years

from the date the patent application was filed (or 17 years from the date the patent issued). When the patent expires, the right to make, use, or sell the invention is dedicated to the public. The patent has three parts, which are a specification, drawings and claims. The patent is granted after examination by the U.S. Patent and Trademark Office of a patent application filed by the inventor which has these parts, and this examination is called the prosecution history.

Patent and Trademark Office (PTO): An administrative branch of the U.S. Department of Commerce that is charged with overseeing and implementing the federal laws of patents and trademarks. It is responsible for examining all patent applications and issuing all patents in the United States.

Prior Art: Any information that is used to describe public, technical knowledge prior to the invention by the applicant or more than a year prior to the filing of his/her application.

Prosecution History: The prosecution history is the complete written record of the proceedings in the PTO from the initial application to the issued patent. The prosecution history includes the office actions taken by the PTO and the amendments to the patent application filed by the applicant during the examination process.

Reads On: A patent claim "reads on" a device or method when each required part (requirement) of the claim is found in the method.

Requirement: A required part or step of an invention set forth in a patent claim. The word "requirement" is often used interchangeably with the word "limitation."

Specification: The specification is a required part of a patent application and an issued patent. It is a written description of the invention and of the manner and process of making and using the claimed invention.