

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

PERSONALIZED USER MODEL, L.L.P.,)
)
 Plaintiff,)
)
 v.)
)
GOOGLE, INC.,)
)
 Defendant.)

)
GOOGLE, INC.)
)
 Counterclaimant,)
)
 v.)
)
PERSONALIZED USER MODEL, L.L.P. and)
YOCHAI KONIG,)
)
 Counterclaim-Defendants.)

C.A. No. 09-525 (LPS)

REVISED JOINT PROPOSED FINAL JURY INSTRUCTIONS

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1. GENERAL INSTRUCTIONS¹

1.1 INTRODUCTION² (JOINTLY SUBMITTED)

Members of the jury, now it is time for me to instruct you about the law that you must follow in deciding this case.

I will start by explaining your duties and the general rules that apply in every civil case. Then I will explain some rules that you must use in evaluating particular testimony and evidence.

Then I will explain the positions of the parties and the law you will apply in this case. And last, I will explain the rules that you must follow during your deliberations in the jury room, and the possible verdicts that you may return.

Please listen very carefully to everything I say.

You will have a written copy of these instructions with you in the jury room for your reference during your deliberations. You will also have a verdict form, which will list the questions that you must answer to decide this case.

¹ The parties have identified a number of specific objections to proposed instructions herein. However, anywhere the parties have provided the Court with alternative proposals, the parties necessarily object to one another's instructions and reserve any and all rights to present argument thereon to the Court as permitted.

² *Sunovion Pharmaceuticals Inc. v. Dey Pharma, L.P., et al.*, No. 06-113 (LPS), D.I. 571 (D. Del. Feb. 8, 2012); The Uniform Jury Instruction for Patent Cases in the United States District Court for the District of Delaware (March 1993)

1.2 DUTY OF THE JURY³ (JOINTLY SUBMITTED)

You have two main duties as jurors. The first one is to decide what the facts are from the evidence that you saw and heard here in court. Deciding what the facts are is your job, not mine, and nothing I have said or done during this trial was meant to influence your decision about the facts in any way.

Your second duty is to take the law that I give you, apply it to the facts, and decide, under the appropriate burden of proof, which party should prevail on any given issue. It is my job to instruct you about the law, and you are bound by the oath that you took at the beginning of the trial to follow the instructions that I give you, even if you personally disagree with them. This includes the instructions that I gave you before and during the trial, and these instructions. All the instructions are important, and you should consider them together as a whole.

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.

³ *Sunovion Pharmaceuticals Inc. v. Dey Pharma, L.P., et al.*, No. 06-113 (LPS), D.I. 571 (D. Del. Feb. 8, 2012); The Uniform Jury Instruction for Patent Cases in the United States District Court for the District of Delaware (March 1993)

1.3 BURDENS OF PROOF (JOINTLY SUBMITTED)

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

PUM has the burden of proving patent infringement by what is called a preponderance of the evidence. That means PUM has to produce evidence which, when considered in light of all of the facts, leads you to believe that what PUM claims is more likely true than not. To put it differently, if you were to put the evidence of PUM and Google concerning infringement on opposite sides of a scale, the evidence supporting PUM’s’ claims would have to make the scales tip somewhat on its side in each instance. If the scale should remain equal or tip in favor of Google, you must find for Google.

In this case, in addition to denying that they have infringed, Google asserts that both of PUM’s Patents are invalid. [*PUM’s proposal: The Asserted Patents, however, are presumed to be valid.*] Google has the burden of proving that the Asserted Patents are invalid by clear and convincing evidence.⁴

Clear and convincing evidence is evidence that produces 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.

⁴ Google asked that if the Court precluded Google from introducing evidence that the patents in suit have been rejected by the PTO during the reexamination process, then the Court instruct the jury (here and elsewhere burden is referenced in these instructions) that invalidity must be proven by a preponderance of the evidence. However, the Court precluded evidence of the reexamination proceedings and, in relation to the preliminary jury instructions, instructed the jury that the burden for proving invalidity is by clear and convincing evidence. Google understands that the Court already has ruled on this issue, but maintains its position for purposes of appeal.

Google has the burden of proving by a preponderance of the evidence its breach of contract claims. 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 familiar with criminal cases will have heard the term “proof beyond a reasonable doubt.” That burden does not apply in a civil case and you should, therefore, put it out of your mind in considering whether or not PUM or Google has met its burden of proof.

1.4 EVIDENCE DEFINED⁵ (JOINTLY SUBMITTED)

You must make your decision based only on the evidence that you saw and heard here in Court. Do not let rumors, suspicions, or anything else that you may have seen or heard outside of Court influence your decision in any way.

The evidence in this case includes only what the witnesses said while they were testifying under oath (including deposition testimony that has been played or read to you), the exhibits that I allowed into evidence, the stipulations that the lawyers agreed to.

Certain charts and graphics have been used to illustrate testimony from witnesses. Unless I have specifically admitted them into evidence, these charts and graphics are not themselves evidence, even if they refer to, identify, or summarize evidence, and you will not have these demonstratives in the jury room.

Nothing else is evidence. The lawyers' statements and arguments are not evidence. The arguments of the lawyers are offered solely as an aid to help you in your determination of the facts. Their questions and objections are not evidence. My legal rulings are not evidence. Any of my comments and questions are not evidence. The notes taken by any juror are not evidence.

During the trial I may have not let you hear the answers to some of the questions that the lawyers asked. I also may have ruled that you could not see some of the exhibits that the lawyers wanted you to see. You must completely ignore all of these things. Do not even think about them. Do not speculate about what a witness might have said or what an exhibit might have shown. These things are not evidence, and you are bound by your oath not to let them influence your decision in any way.

⁵ *Sunovion Pharmaceuticals Inc. v. Dey Pharma, L.P., et al.*, No. 06-113 (LPS), D.I. 571 (D. Del. Feb. 8, 2012); The Uniform Jury Instruction for Patent Cases in the United States District Court for the District of Delaware (March 1993)

Make your decision based only on the evidence, as I have defined it here, and nothing else.

1.5 DIRECT AND CIRCUMSTANTIAL EVIDENCE⁶ (JOINTLY SUBMITTED)

Now, some of you may have heard the terms “direct evidence” and “circumstantial evidence.”

Direct evidence is simply evidence like the testimony of an eyewitness which, if you believe it, directly proves a fact. If a witness testified that he saw it raining outside, and you believed him, that would be direct evidence that it was raining.

Circumstantial evidence is a chain of circumstances that indirectly proves a fact. 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 conclude that it was raining.

It is your job to decide how much weight to give the direct and circumstantial evidence. The law makes no distinction between the weight that you should give to either one, nor does it say that one is any better evidence than the other. You should consider all the evidence, both direct and circumstantial, and give it whatever weight you believe it deserves.

⁶ *Sunovion Pharmaceuticals Inc. v. Dey Pharma, L.P., et al.*, No. 06-113 (LPS), D.I. 571 (D. Del. Feb. 8, 2012); The Uniform Jury Instruction for Patent Cases in the United States District Court for the District of Delaware (March 1993)

1.6 CONSIDERATION OF EVIDENCE⁷ (JOINTLY SUBMITTED)

You should use your common sense in weighing the evidence. Consider it in light of your everyday experience with people and events, and give it whatever weight you believe it deserves. If your experience tells you that certain evidence reasonably leads to a conclusion, you are free to reach that conclusion.

⁷ *Sunovion Pharmaceuticals Inc. v. Dey Pharma, L.P., et al.*, No. 06-113 (LPS), D.I. 571 (D. Del. Feb. 8, 2012); The Uniform Jury Instruction for Patent Cases in the United States District Court for the District of Delaware (March 1993)

1.7 STATEMENTS OF COUNSEL⁸ (JOINTLY SUBMITTED)

A further word about statements and arguments of counsel. The attorneys' statements and arguments are not evidence. Instead, their statements and arguments are intended to help you review the evidence presented. If you remember the evidence differently from the attorneys, you should rely on your own recollection.

⁸ *Tarkus Imaging, Inc. v. Adobe Systems, Inc., et al.*, C.A. No. 10-063 (LPS), D.I. 454 (Preliminary Jury Instructions) (D. Del.) June 18, 2012). *See also British Telecommunications PLC v. Google Inc.*, No. 11-1249 (LPS), D.I. 376 (Joint Proposed Final Jury Instructions) (D. Del. Jan. 17, 2014).

1.8 CREDIBILITY OF WITNESSES⁹ (JOINTLY SUBMITTED)

You are the sole judges of each witness's credibility. You should consider each witness's means of knowledge; strength of memory; 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 interests; the witness's manner or demeanor on the witness stand; and all 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.

In determining the weight to give to the testimony of a witness, you should ask yourself whether there is evidence tending to prove that the witness testified falsely about some important fact, or, whether there was evidence that at some other time the witness said or did something, or failed to say or do something, that was different from the testimony he or she gave at trial. You have the right to distrust such witness's testimony in other particulars and you may reject all or some of the testimony of that witness or give it such credibility as you may think it deserves.

You should remember that a simple mistake by a witness does not necessarily mean that the witness was not telling the truth. People may tend to forget some things or remember other things inaccurately. If a witness has made a misstatement, you must consider whether it was

⁹ *Sunovion Pharmaceuticals Inc. v. Dey Pharma, L.P., et al.*, No. 06-113 (LPS), D.I. 571 (D. Del. Feb. 8, 2012); The Uniform Jury Instruction for Patent Cases in the United States District Court for the District of Delaware (March 1993)

simply an innocent lapse of memory or an intentional falsehood, and that may depend upon whether it concerns an important fact or an unimportant detail.

This instruction applies to all witnesses.

1.9 EXPERT WITNESSES¹⁰ (JOINTLY SUBMITTED)

When knowledge of technical subject matter may be helpful to the jury, a person who has special training or experience in that technical field – a person called an expert witness – is permitted to state his or her opinion on those technical matters. 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.

¹⁰ *Sunovion Pharmaceuticals Inc. v. Dey Pharma, L.P., et al.*, No. 06-113 (LPS), D.I. 571 (D. Del. Feb. 8, 2012); The Uniform Jury Instruction for Patent Cases in the United States District Court for the District of Delaware (March 1993)

1.10 DEPOSITION TESTIMONY¹¹ (JOINTLY SUBMITTED)

A deposition is the sworn testimony of a witness taken before trial. The witness is placed under oath and swears to tell the truth, and lawyers for each party may ask questions. A court reporter is present and records the questions and answers. The deposition may also be recorded on videotape.

During the trial, certain testimony was presented to you from the playing of video excerpts or the reading of written excerpts from depositions. Deposition testimony is out of court testimony given under oath and is entitled to the same consideration you would give it had the witness testified in person here in the courtroom.

¹¹ *British Telecommunications PLC v. Google Inc.*, No. 11-1249 (LPS), D.I. 376 (Joint Proposed Final Jury Instructions) (D. Del. Jan. 17, 2014).

1.11 DEMONSTRATIVE EXHIBITS (JOINTLY SUBMITTED)

During the course of the trial, you have seen many exhibits. Many of these exhibits were admitted as evidence. You will have these admitted exhibits in the jury room for your deliberations. During the course of this case you have seen some exhibits (including charts and animations) that the parties used to help illustrate the testimony of the various witnesses. These illustrative exhibits, called “demonstrative exhibits,” may not have been offered and admitted as evidence in this case. If they have not been admitted, they should not be considered as evidence.

Rather, it is the underlying testimony of the witness that you heard or the exhibits that have been entered into evidence when you saw the demonstrative exhibits that is the evidence in this case.

1.12 USE OF NOTES (JOINTLY SUBMITTED)

You may use notes taken during trial to assist your memory. However, you should use caution in consulting your notes. There is always a tendency to attach undue importance to matters that you have written down. Some testimony that is considered unimportant at the time presented, and thus not written down, takes on greater importance later on 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 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. You should not be overly influenced by your notes or those of your fellow jurors.

Above all, your memory should be the greatest asset when it comes time to deliberate and render a decision in this case.

This instruction applies both to notes you have taken on the blank paper the Court has given you, as well as any notes you may have taken on any exhibits given to you by the attorneys.

1.13 NUMBER OF WITNESSES¹² (JOINTLY SUBMITTED)

One more point about the witnesses. Sometimes jurors wonder if the number of witnesses who testified makes any difference.

Do not make any decisions based only on the number of witnesses who testified. What is more important is how believable the witnesses were, and how much weight you think their testimony deserves. Concentrate on that, not the numbers.

¹² *Sunovion Pharmaceuticals Inc. v. Dey Pharma, L.P., et al.*, No. 06-113 (LPS), D.I. 571 (D. Del. Feb. 8, 2012); The Uniform Jury Instruction for Patent Cases in the United States District Court for the District of Delaware (March 1993)

1.14 IMPEACHMENT

GOOGLE'S PROPOSAL:

In determining the weight to give to the testimony of a witness, you should ask yourself whether there was evidence tending to prove that the witness testified falsely about some important fact, or, whether there was evidence that at some time the witness said or did something, or failed to say or do something, that was different from the testimony the witness gave at the trial.

2. THE PARTIES AND THEIR CONTENTIONS (JOINTLY PROPOSED)

As I previously 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 infringes six claims of the patents-in-suit. These may be referred to as the "asserted claims," and are as follows: claims 1 and 22 of the '040 Patent and claims 1, 3, 7, and 21 of the '276 Patent. Each asserted claim must be considered separately to determine infringement.

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, and Google's Content Ads (including YouTube).

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. 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 and patents 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. PUM and Konig deny these claims, and assert that [***PUM's Proposal: SRI did not assign to Google its right to assert a breach of contract claim against Konig***], that the inventions do not fall within the scope of Konig's employment agreement, and that Google's claims are untimely.¹³

¹³ Google objects to PUM's addition to this instruction as confusing and to the extent that PUM did not previously disclose this defense.

2.1 SUMMARY OF ISSUES (JOINTLY PROPOSED)

I will now summarize the issues that you must decide and for which I will provide instructions to guide your deliberations. You must decide the following issues:

1. Whether PUM has proven by a preponderance of the evidence that Google's Accused Products infringe or have infringed 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 from assignment by California law.

The Google products and services accused by PUM of infringement are those versions of the products and services as they existed June 2011. There may or may not have been changes to these products after that date. You will not be hearing evidence of any such changes that occurred after that date.

2.2 THE PATENT LAWS (JOINTLY SUBMITTED)

At the beginning of the trial, I gave you some general information about patents and the patent system and a brief overview of the patent laws relevant to this case. I will now give you more detailed instructions about the patent laws that specifically relate to this case. If you would like to review my instructions at any time during your deliberations, you will have your copy available to you in the jury room.

3. PATENT INFRINGEMENT

3.1 INFRINGEMENT OF PATENT CLAIMS

PUM'S PROPOSAL:

I will now instruct you on the rules you must follow when deciding whether PUM has proven by a preponderance of the evidence that Google infringes the Asserted Claims of the Patents in Suit.

Patent law gives the owner of a valid patent the right to keep others from using a patented product or method within the United States during the term of the patent. Before you can decide many of the issues in this case, you will need to understand the role of patent “claims.”

The claims of a patent are the numbered paragraphs at the end of the patent. The claims are important because it is the words of the claims that define what a patent covers. The text in the rest of the patent provides a description and/or examples of the invention and provides a context for the claims, but it is the claims that define the breadth of the patent’s coverage. The claims are intended to define, in words, the boundaries of the invention that constitute the patent owner’s property rights. Infringement is the act of trespassing on those rights.

Each claim is effectively treated as if it were a separate patent, and each claim may cover more or less than another claim. To show patent infringement by Google, PUM need only establish that one claim of either the ’040 or ’276 patents has been infringed by Google.

In patent law, the requirements of a claim are often referred to as “claim elements” or “claim limitations.” When a thing (such as a product) meets each and every requirement of a claim, the claim is said to “cover” that thing, and that thing is said to “fall” within the scope of that claim.

The law says that it is my role to define the terms of the claims and it is your role to apply my definitions to the issues that you are asked to decide in this case. Therefore, I will 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 and you must accept my definition of these words in the claims as correct.

It is your job to take these definitions and apply them to the issues you are deciding, such as infringement and validity.¹⁴

¹⁴ *Tarkus*, ¶¶ 3.1, 3.5; *Power Integration*, § 3.1; *Leader Technologies*, ¶ 3.2.

GOOGLE’S PROPOSAL:¹⁵ [THE ASSERTED CLAIMS]¹⁶

Before you can decide many of the issues in this case, you will need to understand the role of patent “claims.” The patent claims are the numbered sentences at the end of each patent.

The patent claims involved here are claims 1 and 22 of the ‘040 patent and claims 1, 3, 7, and 21 of the ‘276 patent. I will refer to these claims collectively as the “asserted claims.” The claims are intended to define, in words, the boundaries of the invention. The claims define the patent owner’s property rights. Infringement is the act of trespassing on those rights.

Only the claims of the patents can be infringed. Neither the specification, which is the written description of the invention, nor the drawings of a patent can be infringed. Each of the claims must be considered individually. You must use the same claim meaning for both your decision on infringement and your decision on invalidity.

You will first need to understand what each claim covers in order to decide whether or not there is infringement of the claim and to decide whether or not the claim is invalid. The law says that it is my role to define the terms of the claims and it is your role to apply my definitions to the issues that you are asked to decide in this case. Therefore, as I mentioned to you at the start of the case, I have determined the meaning of certain terms in the claims, and I will provide to you my definitions of those claim terms. You must accept my definitions of these words in the claims as being correct. It is your

¹⁵ Google objects to the following language in PUM’s proposed instruction because it is irrelevant to this instruction and prejudicial to Google: (1) “Patent law gives the owner of a valid patent the right to keep others from using a patented product or method within the United States during the term of the patent.”; (2) “Infringement is the act of trespassing on those rights.”; and (3) “To show patent infringement by Google, PUM need only establish that one claim of either the ’040 or ’276 patents has been infringed by Google.”

¹⁶ *Sunovion Pharmaceuticals Inc. v. Dey Pharama, L.P. et al.*, No. 06-113 (LPS), D.I. 571 (D. Del. Feb. 8, 2012). See also *British Telecommunications PLC v. Google Inc.*, No. 11- 1249-LPS, D.I. 376 (Joint Proposed Final Jury Instructions) (D. Del. Jan. 17, 2014).

job to take these definitions and apply them to the issues that you are deciding, including the issues of infringement and validity.

Infringement must be assessed on a product-by-product and claim-by-claim basis. Each of the accused systems and services must be individually compared with each and every claim being asserted against that product. You should not compare the accused systems and services to either the patent specification or any figures in the patent. In making the comparison for any given claim, each of the limitations of that claim must be compared to the product to determine whether each of the limitations of that claim are present in the product.

GOOGLE’S PROPOSAL: [HOW A CLAIM DEFINES WHAT IT COVERS]¹⁷

I will now explain how a claim defines what it covers.

A claim sets forth, in words, a set of requirements. Each claim sets forth its requirements in a single sentence. If a method satisfies each of these requirements, then it is covered by the claim.

There can be several claims in a patent. Each claim may be narrower or broader than another claim by setting forth more or fewer requirements. The coverage of a patent is assessed on a claim-by-claim basis. In patent law, the requirements of a claim are often referred to as “claim elements” or “claim limitations.” When a use meets all of the requirements of a claim, the claim is said to “cover” that use, and that use is said to “fall” within the scope of that claim. In other words, a claim covers a use where each of the claim elements or limitations is present in that use. Sometimes the words in a patent claim are difficult to understand, and therefore it is difficult to understand what requirements these words impose. It is my job to explain to you the meaning of the words in the claims and the requirements these words impose.

As I just instructed you, there are certain specific terms that I have defined and you are to apply the definitions that I provide to you.

By understanding the meaning of the words in a claim and by understanding that the words in a claim set forth the requirements that a use must meet in order to be covered by that claim, you will be able to understand the scope of coverage for each claim. Once you understand what each claim covers then you are prepared to decide the issues that you will be asked to decide, such as infringement and invalidity.

¹⁷ *Sunovion Pharmaceuticals Inc. v. Dey Pharama, L.P. et al.*, No. 06-113 (LPS), D.I. 571 (D. Del. Feb. 8, 2012).

3.2 CLAIM CONSTRUCTION FOR THE CASE (JOINTLY SUBMITTED)

It is the Court’s duty under the law to define what the patent claims mean. I have made my determinations, and I will now instruct you on the meaning of the words of the claims in this case. As I have previously instructed you, you must accept my definition of these words in the claims as correct. You must use the definitions that I give you for each patent claim to make your decisions as to whether the claim is infringed or invalid. You must ignore any different definitions used or suggested by the witnesses or the attorneys. 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 will now read to you certain asserted claims that possess a term that I have construed and provide you with my constructions of certain terms in those claims.

“user” and “user u”	“a person operating a computer or the associated representation of the user”
“user specific data files”	“the monitored user interactions with the data and a set of documents associated with the user”
“monitored user interactions with the data”	“the collected information about the user’s interactions with the data”
“parameters”	“values or weights”
“estimating parameters of a learning machine”	“estimating values or weights of the variables of a learning machine”
“learning machine”	“mathematical function and/or model used to make a prediction, that attempts to improve its predictive ability over time by altering the values/weights given to its variables, depending on a variety of knowledge sources, including monitored user interactions with data and a set of documents associated with the user”

“User Model specific to the user”	“an implementation of a learning machine updated in part by data specific to the user”
“user-specific learning machine”	“a learning machine [as construed] specific to the user”
“document”	“an electronic file including text or any type of media”
“estimating”	“approximating or roughly calculating”
“probability”	“numerical degree of belief or likelihood”
“unseen document”	“document not previously seen by the user”
“estimating a probability $P(u/d)$ that an unseen document d is of interest to the user u ”	“approximating or roughly calculating a numerical degree of belief or likelihood that an unseen document d is of interest to the user u given the information that is known about the unseen document approximating or roughly calculating a numerical degree of belief or likelihood that a document d is of interest to the user u given the information that is known about the document, and given a query q ”
“estimating a posterior probability $P(u/d,q)$ that a document d is of interest to the user u given a query q submitted by the user”	“approximating or roughly calculating a numerical degree of belief or likelihood that a document d is of interest to the user u given the information that is known about the document, and given a query q ”
“present” and “presenting”	“to provide or make available”
“documents of interest to the user”	“documents [i.e., electronic files (including text or any type of media)] for which the user has a positive response”
“documents not of interest to the user”	documents [i.e., electronic files (including text or any type of media)] for which the user has a negative response or has ignored
“user interest information derived from the User Model”	“interests or other information inferred from the User Model”
“set”	“group or collection”
“set of documents associated with the user”	“group or collection of documents associated with the user”
“automatic”	“without human intervention”

“central computer”	“computer on the server side of a client-server relationship”
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For any words in the claim for which I have not provided you with a definition, you should apply their common meaning.¹⁸

¹⁸ PUM reserves the right to seek construction of the terms "electronic file" as necessitated by trial testimony.

3.3 ORDER OF STEPS IS NOT A REQUIREMENT (JOINTLY SUBMITTED)¹⁹

The steps of each claim do not need to be performed in the order in which they are listed in the claim unless the language of the claim so specifies. If the claim does not explicitly or implicitly require that the steps be performed in a certain order, then the steps may be performed in any order.

¹⁹ *Interactive Gift Express v. Compuserve, Inc.*, 256 F.3d 1323, 1342 (Fed. Cir. 2001); *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1369 (Fed. Cir. 2003).

3.4 INDEPENDENT AND DEPENDENT CLAIMS (JOINTLY SUBMITTED)

This case involves two types of patent claims: independent claims and dependent claims. An independent claim sets forth all of the requirements that must be met in order to be covered by that claim. Thus, it is not necessary to look at any other claim to determine what an independent claim covers. In this case, the independent claims are claim 1 of the '040 patent and claim 1 of the '276 patent. The remaining Asserted Claims in both patents are dependent claims.

A dependent claim does not itself recite all of the requirements of the claim but refers to another claim or claims for some of its requirements. In this way, the claim “depends” on another claim or claims. A dependent claim incorporates all of the requirements of the claims to which it refers. The dependent claim then adds its own additional requirements. To determine what a dependent claim covers, it is necessary to look at both the dependent claim and any other claims to which it refers.

[Google’s proposal: Here, for example, claim 11 of the ‘040 patent is a dependent claim. It depends on claim 1. For a system to infringe dependent claim 11 of the ‘040 patent, the use must have all the elements of both claim 1 and claim 11.]

As another example, Claim 3 of the ‘276 patent is another dependent claim. It depends on claim 1. For a system to infringe dependent claim 3 of the ‘276 patent, the use must have all the elements of both claim 1 and claim 3.]

An accused product or process is only covered by a dependent claim if the accused product or process meets all of the requirements of both the dependent claim and the claims to which the dependent claims refers.²⁰

²⁰ Adapted from the Federal Circuit Bar Association Model Patent Jury Instructions Section 2.2a (2013 ed.).

3.5 OPEN ENDED OR “COMPRISING” CLAIMS (JOINTLY SUBMITTED)

The beginning portion, or preamble, of several of the Asserted Claims has the word “comprising.” The word “comprising” means “including the following but not excluding others.” A claim that uses the word “comprising” or “including” is not limited to products having only the elements that are recited in the claim, but also covers products that have additional elements.

[PUM’s Proposal: If you find, for example, that Google Search includes all of the elements of a particular claim, the fact that Google Search might include additional elements does not avoid infringement of a claim that uses “comprising” language.]

3.6 PATENT INFRINGEMENT GENERALLY

PUM'S PROPOSAL:

I will now instruct you on the rules you must follow when deciding whether Google has infringed the Asserted Claims. As I said before, infringement is assessed on a claim-by-claim basis. Patent law gives the owner of a valid patent the right to keep others from making, using, selling, or offering to sell a patented product within the United States during the term of the patent. Any business entity that has made, used, sold, or offered to sell a patented product without the patent owner's permission, infringes the patent. And this is so whether the infringer saw or knew about the patent, or even if the defendant later made the same invention.

To prove infringement, PUM must meet its burden of proof by a preponderance of the evidence, i.e., that it is more likely than not that all of the requirements for infringement have been proven.

GOOGLE’S PROPOSAL: [INFRINGEMENT]; [INFRINGEMENT GENERALLY]²¹

I will now instruct you how to decide whether or not PUM has proven by a preponderance of the evidence that Google has infringed the asserted claims of the patents in suit. Infringement is assessed on a claim-by-claim and product-by-product basis. Therefore, there may be infringement as to one claim but no infringement as to another or infringement by one product and not by another. A patent claim may be directly infringed in two ways. One may directly infringe a patent, either literally or under the doctrine of equivalents. I will explain each of these types of infringement in more detail shortly.

Each of the accused systems and services must be individually compared with each and every one of the requirements of a claim to determine whether all of the requirements of that claim are met by the system or service. The asserted claims cover methods. Offering a system or service does not itself infringe a method claim. In order for a method claim to be infringed, PUM must prove that each step of the claimed method is actually performed, not merely that a system or service has been offered that is capable of performing the claimed method.²²

In order to prove infringement, PUM must prove infringement by a preponderance of the evidence, i.e., that it is more likely than not that infringement has occurred.

I will now explain each of the relevant types of infringement in more detail.

²¹ Adapted from the Federal Circuit Bar Association Model Patent Jury Instructions Section 3.1 (2013 ed.).

²² Adapted from the Federal Circuit Bar Association Model Patent Jury Instructions Section 3.1a (2013 ed.). *See also NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1317-18 (Fed. Cir. 2005) (the use of a process necessarily involves doing or performing each of the steps recited); *Joy Techs., Inc. v. Flakt, Inc.*, 6 F.3d 770, 773 (Fed. Cir. 1993) (“The law is unequivocal that the sale of equipment to perform a process is not a sale of the process within the meaning of section 271(a).”

3.7 DIRECT INFRINGEMENT – KNOWLEDGE OF PATENT OR INTENT TO INFRINGE IS IMMATERIAL²³

PUM’S PROPOSAL:

Google will be liable for directly infringing an Asserted Patent if you find that PUM has proven by a preponderance of the evidence that Google has made, used, sold or offered for sale, or imported the invention defined in at least one claim of a patent.

One may directly infringe a patent without knowledge that what one is doing is an infringement of the patent. One may also infringe while believing in good faith that a particular action is not an infringement of any patent.²⁴

²³ Google objects to this instruction because knowledge of the patents-in-suit is not at issue in this case, and, furthermore, the first sentence of the instruction is unrelated to the issue of knowledge and repetitive of other proposed instructions.

²⁴ *Power Integration*, ¶ 4.1.2.

3.8 DIRECT INFRINGEMENT – LITERAL INFRINGEMENT

PUM’S PROPOSAL:

There are two ways in which a patent claim may be directly infringed. First, a claim may be literally infringed. Second, a claim may be infringed under what is called the “doctrine of equivalents,” which I will address shortly.

To prove literal infringement, PUM must prove by a preponderance of the evidence that one of Google’s Accused Products include every element or requirement in at least one of the Asserted Claims. The presence of other elements beyond those claimed does not avoid infringement, as long as each and every claimed element is present in the Accused Product. However, if an Accused Product omits a requirement recited in one of the Asserted Claims, then that product does not literally infringe that claim.²⁵

²⁵ *DePuy*, ¶ 3.6

GOOGLE’S PROPOSAL: [DIRECT INFRINGEMENT BY “LITERAL INFRINGEMENT]’^{26 27}

In order to prove direct infringement by literal infringement, PUM must prove by a preponderance of the evidence, i.e., that it is more likely than not, that Google, without PUM’s authorization, made, used, sold, offered for sale within, or imported into the United States systems or services which meet all of the requirements of the asserted claims of the patents in suit. You must compare the accused systems and services with each and every one of the requirements of the asserted claims to determine whether all of the requirements are met.

You must determine, separately for each asserted claim, whether or not there is infringement. There is one exception to this rule. If you find that a claim on which other claims depend is not infringed, there cannot be infringement of any dependent claim that refers directly or indirectly to that independent claim. On the other hand, if you find that an independent claim has been infringed, you must still decide, separately, whether Google’s accused systems and services or methods meets additional requirements of any claims that depend from the independent claim, thus whether those claim have also been infringed. A dependent claim includes all the requirements of any of the claims to which it refers plus additional requirements of its own.

PUM contends that the following Google systems and services directly infringe the following asserted claims of each of the patents in suit:

²⁶ Adapted from the Federal Circuit Bar Association Model Patent Jury Instructions Section 3.1a (2013 ed.). See *British Telecommunications PLC v. Google Inc.*, No. 11-1249-LPS, D.I. 376 (Proposed Final Jury Instructions) (D. Del. Jan. 17, 2014); *Leader Technologies, Inc. v. Facebook, Inc.*, C.A. No. 08-862-LPS, D.I. 580 (Preliminary Jury Instructions) (D. Del. July 5, 2010).

²⁷ Google objects to PUM’s proposed instruction as incomplete.

Patent	Accused Google System or Service	Asserted Claims
'040 patent	Google Search	claims 1 and 22
'276 patent	Google Search	claims 1, 3, and 21
'040 patent	Search Ads System	claims 1 and 22
'276 patent	Search Ads System	claims 1, 3, 7, and 21
'040 patent	AdSense for Content	claims 1 and 22
'276 patent	AdSense for Content	claims 1, 3, and 7
'040 patent	YouTube Ads	claims 1 and 22
'276 patent	YouTube Ads	claims 1, 3, and 7

3.9 DIRECT INFRINGEMENT – DOCTRINE OF EQUIVALENTS

PUM’S PROPOSAL:

If you do not find literal infringement, you may consider infringement under the “doctrine of equivalents.” I have referred to the “doctrine of equivalents” before. Now it is time to explain this term.

You may find that Google’s Accused Products infringe one or more of the Asserted Claims, even if not all of the requirements of the claim are literally present in the Accused Products. You may find infringement in such circumstances if the components or features of the Accused Products are equivalent to those claimed in at least one of the Asserted Claims. This is called the doctrine of equivalents. To prevail on this allegation of infringement, PUM must prove that it is more probable than not that the Accused Products contain components or features that are the same or equivalent to each claimed requirement of the patented invention.

A claim element is present in an Accused Product under the doctrine of equivalents if the differences between the claim element and a corresponding aspect of the Accused Product are insubstantial. One way to determine this is to look at whether or not the corresponding aspect of the Accused Product performs substantially the same function, in substantially the same way, to achieve substantially the same result as the element in the claimed invention. An Accused Product may infringe under the doctrine of equivalents even if the component or feature of the Accused Product has additional components or features or if the Accused Product also has additional ways of performing those functions.

Application of the doctrine of equivalents is on an element-by-element basis, meaning that for a product or the use of a product to infringe an asserted claim under the doctrine of equivalents, the element of the asserted claim which is not literally found in the Accused Product must be present by equivalence. Therefore, the question is whether the Accused Product contains

an equivalent for each element of the claim that is not literally present in the Accused Product. The question is not whether the Accused Product as a whole is equivalent to the claimed invention as a whole.

There does not need to be a one-to-one correlation between a structure in the Accused Product and a corresponding claim requirement for there to be infringement under the doctrine of equivalents. For example, one structure in the Accused Product may satisfy two claim requirements under the doctrine of equivalents so long as the claim language does not specifically require more than one structure. In addition, the components or features of the Accused Products can be part of an integral structure and still be equivalent to a claimed component or feature.

It is not a requirement under doctrine of equivalents infringement that those of ordinary skill in the art knew of the equivalent when the patent application was filed or when the patent issued. The question of whether a product and its components are equivalent to what is defined in an asserted patent claim is to be determined as of the time of the alleged infringement.²⁸

²⁸ *DePuy*, ¶ 3.7.

GOOGLE’S PROPOSAL:²⁹

PUM alleges that Google infringed certain claims of the patents-in-suit under the “doctrine of equivalents.” If a person or company makes, uses, sells, offers to sell within, or imports into the United States a product that does not meet all of the requirements of a claim and thus does not literally infringe that claim, there can still be direct infringement if that product satisfies that claim “under the doctrine of equivalents.”

Under the doctrine of equivalents, Google can only infringe an asserted patent claim if the accused product includes parts or steps that are identical or equivalent to the requirements of the claim. If an identical or equivalent part or step for even one part or step of the asserted patent claim is missing in an accused product, Google cannot infringe the claim under the doctrine of equivalents. Thus, in making your decision under the doctrine of equivalents, you must first look at each individual requirement of the asserted patent claim and decide whether Google’s accused product has an identical or equivalent part or step to that individual claim requirement.

You may find that an element or step is equivalent to a requirement of a claim that is not met literally if a person having ordinary skill in the field of technology of the patent would have considered the differences between them to be “insubstantial” or would have found that the structure or action: (1) performs substantially the same function and (2) works in substantially the same way (3) to achieve substantially the same result as the requirement of the claim. In order for the structure or action to be considered interchangeable, the structure or action must have been known at the time of the alleged infringement to a person having ordinary skill in the field of technology of the patent. Interchangeability at the present time is not sufficient. In order to prove

²⁹ Federal Circuit Bar Association Model Patent Jury Instructions Section 3.1c (2013 ed.)

infringement by “equivalents,” PUM must prove the equivalency of the structure or action to a claim element by a preponderance of the evidence.

PUM contends only certain claim limitations are met under the doctrine of equivalents by certain accused Google systems or services. Specifically, PUM contends that the following claim limitations are met under the doctrine of equivalents for the systems and services listed below. Accordingly, you should not apply the doctrine of equivalents analysis to any other claim limitations or to any other systems or services:

Patent	Accused Google System or Service	Asserted Claims
‘040 patent	Google Search	claims 1 and 22
‘276 patent	Google Search	claims 1, 3, and 21
‘040 patent	Search Ads System	claims 1 and 22
‘276 patent	Search Ads System	claims 1, 3, 7, and 21
‘040 patent	AdSense for Content	claims 1 and 22
‘276 patent	AdSense for Content	claims 1, 3, and 7
‘040 patent	YouTube Ads	claims 1 and 22
‘276 patent	YouTube Ads	claims 1, 3, and 7

4. INVALIDITY

4.1 INVALIDITY—GENERALLY

PUM’S PROPOSAL:

Patent invalidity is a defense to patent infringement. Even though the Patent Office allowed the claims of a patent, you have the ultimate responsibility for deciding whether or not the claims of the Asserted Patents are proven to be invalid.³⁰

³⁰ *Power Integration*, ¶ 5; *Tarkus*, ¶ 4.1.

GOOGLE’S PROPOSAL:^{31 32}

Patent invalidity is a defense to patent infringement. Even though the Patent Office examiner has allowed the claims of a patent, an accused infringer has the right to argue here in Federal Court that the claims of the patent are invalid, and you have the ultimate responsibility for deciding whether the claims of the patent are invalid. The Patent Office may not have had available to it all of the prior art that has been presented to you. Therefore, in making your decision whether Google has met its burden as to a particular patent claim, you may consider whether you have heard prior art references that the Patent Office had no opportunity to evaluate before granting the patents. It is your job to consider the evidence presented by the parties and determine independently whether or not Google has proven that the claims of the patents in suit are invalid.

I will now instruct you in more detail on the invalidity issues you should consider.

³¹ Adapted from *Sunovion Pharmaceuticals Inc. v. Dey Pharama, L.P. et al.*, No. 06-113 (LPS), D.I. 571 (D. Del. Feb. 8, 2012).

³² Google objects to PUM’s proposed instruction as incomplete.

4.2 PRESUMPTION OF VALIDITY³³

PUM'S PROPOSAL:

The granting of a patent by the Patent Office carries with it the presumption that the patent's subject matter is new, useful, and constitutes an advance that was not, at the time the invention was made, obvious to one of ordinary skill in the art. The law presumes that the Patent Office acted correctly in issuing the patent.

This presumption of validity puts the burden of proving invalidity on the challenger. While this presumption can be rebutted, the burden is on the challenger to do so. This burden requires that Google prove by clear and convincing evidence that in this case, each of the asserted claims is invalid. This burden always remains with Google and never shifts to PUM. Clear and convincing evidence is evidence that produces an abiding conviction that the truth of the factual contention is highly probable.

Each of the asserted claims is presumed valid independently of the validity of each other claim, and you must determine validity separately for each Asserted Claim. Therefore, even if you find one claim of a patent invalid, other claims of the same patent may still be valid.³⁴

³³ Google objects to the inclusion of this instruction because Google does not believe it is appropriate to instruct the jury on the presumption of validity when the PTO has issued final rejections of both patents-in-suit. Further, to the extent that the Court instructs the jury as to the presumption of validity, Google believes that any such instruction should be limited to a single sentence to avoid the prejudice that would occur were that issue given undue weight in the jury instructions.

³⁴ *Power Integration*, ¶ 5.1; *B. Braun*, ¶ 5.1; Google's proposed instruction that it need only prove invalidity by a preponderance of the evidence is contrary to law. See *Microsoft Corp. v. i4i P'ship*, --- U.S. ---, 131 S. Ct. 2238, 2250-51 (2011)

4.3 ANTICIPATION

PUM'S PROPOSAL:

A person cannot obtain a patent on an invention if someone else has already made the same invention. If the invention is not new, we say that it was “anticipated” by prior art. Prior art is the legal term used to describe what others had done in the field before the invention was made. Prior art is the general body of knowledge in the public domain, such as articles or other patents before the invention was made. It is not necessary that the prior art has been available to every member of the public. It must have been available, without restriction, to that segment of the public most likely to avail itself of the prior art’s contents.

An invention that is “anticipated” by the prior art is not entitled to patent protection. In order to prove that an invention is “anticipated,” a party must prove by clear and convincing evidence that a single piece of prior art describes or discloses each and every element of an Asserted Patent. A single prior art reference must also disclose those elements as arranged in the claim.

For purposes of anticipation, you should consider that which is expressly stated or present in the item of prior art, and also that which is inherently present. Anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.³⁵

Google asserts in this action that the following references anticipate the Asserted Claims:

³⁵ *Research Foundation of State University of New York v. Mylan Pharmaceuticals Inc.*, 809 F. Supp. 2d 296, 329 (D. Del. 2011) (Stark, J.), PUM includes an instruction on inherent disclosure because Google included such an instruction despite that it never disclosed this theory or indicated it intended to prove inherent disclosure at trial. PUM objects to the inclusion of such an instruction.

1. “Personal WebWatcher: design and implementation” by Dunja Mladenic (“Mladenic”);
2. “Collecting User Access Patterns for Building User Profiles and Collaborative Filtering” by Ahmad M. Ahmad Wasfi (“Wasfi”);
3. “A Personal Evolvable Advisor for WWW Knowledge-Based Systems” by M. Montebello, W.A. Gray, and S. Hurley (“Montebello”);
4. Autonomy Agentware (“Autonomy”);
5. U.S. Patent No. 7,631,032 to Refuah (“Refuah”);
6. “WebWatcher: A Tour Guide for the World Wide Web” by Joachims, Freitag, and Mitchell (“Joachims”);

You must determine whether Google has proven anticipation by clear and convincing evidence for each reference and each Asserted Claim.³⁶

³⁶ *Power Integration*, ¶ 5.2; *Leader*, ¶ 4.5; *Laboratory Skin*, ¶ 3.4.

GOOGLE’S PROPOSAL:³⁷

The patent laws of the United States require that an invention must be new for a person to be entitled to a patent. In general, inventions are new when the product has not been made, used, or disclosed before. Google contends that claims 1 and 22 of the ‘040 patent and claims 1, 3, 7, and 21 of the ‘276 patent are invalid because they were not new or lacked novelty. For a claim to be invalid because it is not new, all of its requirements must have existed in a single device or method that predates the claimed invention, or must have been described in a single previous publication or patent that predates the claimed invention. If a patent claim is not new, we say it is “anticipated” by a prior art reference.

The disclosure in the prior art reference does not have to be in the same words as the claim, but all of the requirements of the claim must be there, either stated or necessarily implied so that someone of ordinary skill in the relevant field looking at that one reference would be able to make and use at least one embodiment of the claimed invention.

Anticipation also occurs when the claimed invention inherently or necessarily results from the practice of what is disclosed in the written reference, even if the inherent disclosure was unrecognized or unappreciated by one of ordinary skill in the field of the invention.

In order for someone to be entitled to a patent, the invention must actually be “new” and the inventor must not have lost her or his rights by delaying the filing of an application claiming the invention. In general, inventions are new when the identical product or process has not been made, used, or disclosed before. Anticipation must be determined on a claim-by-claim basis.

Here is a list of ways that Google can show that a patent claim was not new or that the patentee lost the right to patent the claims:

³⁷ Federal Circuit Bar Association Model Patent Jury Instructions Section 4.3b (2012 ed.).

(1) An invention is not new if it was known to or used by others in the United States before the inventors' invention. An invention is known when the information about it was reasonably accessible to the public on that date.

(2) An invention is not new if it was already patented or described in a printed publication, anywhere in the world before the inventors' invention.

(3) PUM has lost its rights if the claimed invention was already patented or described in a printed publication, anywhere in the world by the inventors or anyone else, more than a year before December 28, 1999, which is the effective filing date of the application for the '040 patent. An invention was patented by another if the other patent describes the same invention claimed by PUM to a person having ordinary skill in the technology.

(4) PUM has lost its rights if the claimed invention was publicly used, sold, or offered for sale in the United States more than one year before December 28, 1999, which is the effective filing date of the application for the '040 patent. An invention was publicly used when it was either accessible to the public or commercially exploited. An invention was sold or offered for sale when it was offered commercially and what was offered was ready to be patented, i.e., a description to one having ordinary skill in the field of the technology could have made and used the claimed invention, even if it was not yet reduced to practice.

(5) An invention is not new if it was described in a published patent application filed by another in the United States before the effective filing date of the patent, in this case December 28, 1999.

(6) An invention is not new if the claimed invention was described in a patent granted on an application for patent by another filed in the United States and the application was filed before the effective filing date of the patent, in this case December 28, 1999.

If a patent claim is not new, as explained above, you must find that claim to be invalid.

4.4 OBVIOUSNESS

PUM'S PROPOSAL:

In order to be patentable, an invention must not have been obvious to a person of ordinary skill in the art at the time the invention was made. A claimed invention is invalid as obvious if it would have been obvious to a person of ordinary skill in the field of the invention at the time the invention was made. In this case, it is undisputed that the invention in the '040 patent was invented in 1999.

Obviousness must be shown by clear and convincing evidence considering one or more items of prior art. Obviousness is determined from the perspective of a person of ordinary skill in the field of the invention. The issue is not whether the claimed invention would be obvious to you as layman, to me as a judge, or to a genius in the art, but whether it would have been obvious to one of ordinary skill in the art at the time it was made. Thus, the question is, would it have been obvious for a skilled person who knew of the prior art to make the claimed invention? If the answer to that question is yes, then the patent claims are invalid. Google has the burden of proving obviousness by the clear and convincing evidence standard.

Google contends that the Asserted Claims are invalid because the claimed inventions are obvious.

Keep in mind that although Google must prove the existence of each and every element of the claimed invention in the prior art, this alone does not itself prove obviousness. Most, if not all, inventions rely on building blocks of prior art. Accordingly, you must be careful not to determine obviousness using hindsight to reconstruct or piece together the invention; many true inventions can be seen as obvious after the fact. You should not consider what is known today or what was learned from the teachings of the patent. You should not use the patent as a road map

for selecting and combining items of prior art. You must put yourself in the place of a person of ordinary skill at the time the invention was made.

You must also keep in mind that the test for obviousness is not whether or not it would have been obvious to try to make the invention, but rather, whether or not the invention would have been obvious to a person of ordinary skill in the inventor's field at the time the invention was made. In determining whether or not these claims would have been obvious, you should make the following determinations:

First, what is the scope and content of the prior art?

Second, what differences, if any, are there between each asserted claim and the prior art?

Third, what was the level of ordinary skill in the art at the time the invention of the patent was made?

Fourth, are there any objective indications of non-obviousness?

In addition, you may consider whether there was an apparent reason to combine or modify the prior art references in the fashion claimed by the patent at issue, but in doing so, you must guard against slipping into the use of hindsight.

I will explain each of these factors in more detail in a moment. Against this background, you will then decide whether the subject matter of each asserted claim would have been obvious or non-obvious to a person of ordinary skill in the pertinent art.³⁸

³⁸ *DePuy*, ¶ 4.3; *Power Integration*, ¶ 5.3; *Tarkus*, ¶ 4.5.

GOOGLE’S PROPOSAL: [PRIOR ART]³⁹

Prior art may include items that were publicly known or that have been used or offered for sale, publications, or patents that disclose the claimed invention or elements of the claimed invention. These items may be referred to as prior art references. To be prior art, the item or reference must have been made, known, used, published, or patented either before the invention was made or more than one year before the filing date of the patent application. However, prior art does not include a publication that describes the inventor of the patent-in-suit’s own work and was published less than one year before the date of invention.

For the claim to be invalid because it is not new, Google must show that all of the requirements of that claim were present in a single previous device or method that was known of, used, or described in a single previous printed publication or patent. We call these things “anticipating prior art.” To anticipate, the prior art does not have to use the same words as the claim, but all of the requirements of the claim must have been disclosed, either stated expressly or implied to a person having ordinary skill in the art in the technology of the invention, so that looking at that one reference, that person could make and use the claimed invention.

³⁹ Federal Circuit Bar Association Model Patent Jury Instructions Section 4.3a (2012 ed.)

GOOGLE’S PROPOSAL: [OBVIOUSNESS]⁴⁰

Even though an invention may not have been identically disclosed or described in the prior art 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 art to which the claimed invention pertains at the time the invention was made.

Google contends that the asserted claims are invalid for obviousness. A patent claim is invalid if the claimed invention, as a whole, would have been obvious to a person of ordinary skill in the field of the invention at the time the application was filed. This means that even if all the requirements of the claim cannot be found in a single prior art reference that would anticipate the claim, a person of ordinary skill in the field of the invention who knew about all of the prior art would have come up with the claimed invention.

The ultimate conclusion of whether a claim is obvious should be based on your determination of several factual issues:

1. You must decide the level of ordinary skill in the field of the invention that someone would have had at the time the claimed invention was made.
2. You must decide the scope and content of the prior art. In determining the scope and content of the prior art, you must decide whether a reference is pertinent, or analogous, to the claimed invention. Pertinent, or analogous, prior art includes prior art in the same field of endeavor as the claimed invention, regardless of the problems addressed by the reference, and prior art from different fields reasonably pertinent to the particular problem with which the claimed invention is concerned.
3. You should consider any difference or differences between the prior art and the claim requirements.

⁴⁰ Google requests that the Court use its instruction on obviousness because the instruction is more comprehensive. PUM’s instruction as to obviousness and its other instructions on invalidity are incomplete.

You should also consider any of the following factors that you find have been shown by the evidence:

- A. Factors tending to show non-obviousness:
1. commercial success of a product due to the merits of the claimed invention;
 2. a long-felt, but unsolved, need for the solution provided by the claimed invention;
 3. unsuccessful attempts by others to find the solution provided by the claimed invention;
 4. copying of the claimed invention by others;
 5. unexpected and superior results from the claimed invention;
 6. Acceptance by others of the claimed invention as shown by praise from others in the field of the invention or from the licensing of the claimed invention;
 7. disclosures in the prior art that criticize, discredit, or otherwise discourage the claimed invention and would therefore tend to show that the invention was not obvious;
 8. other evidence tending to show non-obviousness.

You may consider the presence of any of the list factors A.1-8 as an indication that the claimed invention would not have been obvious at the time the claimed invention was made. There must be a nexus, or connection, between the evidence showing any of these factors and the claimed invention if this evidence is to be given weight by you in arriving at your conclusion on the obviousness issue. For example, if commercial success is due to advertising, promotion, salesmanship or the like, or is due to features of the product other than those claimed in the patents in suit, then any commercial success may have no relation to the issue of obviousness.⁴¹

- B. Factors tending to show obviousness

⁴¹ The Uniform Jury Instruction for Patent Cases in the United States District Court for the District of Delaware (March 1993).

1. independent invention of the claimed invention by others before or at about the same time as the named inventor thought of it;
2. other evidence tending to show obviousness.

You may consider the presence of the list factors B.1-2 as an indication that the claimed invention would have been obvious at such time.

Although you should consider any evidence of these factors, the relevance and importance of them to your decision on whether the claimed invention would have been obvious is up to you.

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 the invention 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 functions; (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. Obvious to try is not sufficient in unpredictable technologies.⁴²

But you must be careful not to determine obviousness using hindsight; many true inventions can seem obvious after the fact. You should put yourself in the position of a person of ordinary skill in the field of the invention at the time the claimed invention was made, and you should not consider what is known today or what is learned from the teaching of the patent.

If you find that a claimed invention was obvious as explained above, you must find that claim invalid.

⁴² See Patent Jury Instructions prepared by the Federal Circuit Bar Association.

4.4.1 OBVIOUSNESS – SCOPE AND CONTENT OF THE PRIOR ART

PUM’S PROPOSAL:

As I have just instructed you, in arriving at your decision on the issue of whether or not the claimed inventions were obvious to one of ordinary skill in the art, you must first determine the scope and content of the prior art. This means that you must determine what prior art is reasonably pertinent to the particular problem that the inventors faced. Prior art is reasonably pertinent if it is in the same field as the claimed invention or is from another field that a person of ordinary skill would look to in trying to solve the problem the claimed invention was trying to solve. The prior art may include any of the following items if received into evidence:

1. patents that issued more than one year before the earliest effective filing date of the patents, which is December 28, 1999 for the ‘040 patent, and January 8, 2008 for the ‘276 patent;
2. publications having a date more than one year before the earliest effective filing date of the patent;

Google has asserted that the following prior art combinations allegedly render the Asserted Patents obvious in this action:

1. Mladenic and Wasfi and Montebello
2. Mladenic and Wasfi and Montebello and Joachims
3. Mladenic and Wasfi and Montebello and Refuah
4. Mladenic and Wasfi and Montebello and Joachims and Refuah
5. Mladenic and Wasfi and Montebello and Autonomy
6. Mladenic and Wasfi and Montebello and Joachims and Autonomy
7. Mladenic and Refuah
8. Mladenic and Montebello

9. Mladenic and Autonomy
10. Montebello and Refuah
11. Montebello and Autonomy
12. Wasfi and Montebello
13. Wasfi and Refuah
14. Wasfi and Autonomy

Google has the burden of proving by clear and convincing evidence that each such combination contains each and every element of the Asserted Patents.⁴³

⁴³ *DePuy*, ¶ 4.3.1; *Power Integration*, ¶ 5.4; *Tarkus*, ¶ 4.5.1

4.4.2 OBVIOUSNESS – DIFFERENCES OVER THE PRIOR ART⁴⁴

PUM’S PROPOSAL:

You must next consider the differences, if any, between the prior art and the claimed invention from the view of a person of ordinary skill in the art as of the filing date of the applications for the Asserted Patents. Your analysis must determine the impact, if any, of such differences on the obviousness or non-obviousness of the invention as a whole and not merely some portion of it.

In analyzing the differences between the claimed invention and the prior art, you do not need to look for a 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. Most, if not all, inventions rely on building blocks long since uncovered, and claimed discoveries almost of necessity will likely be combinations of what is already known. 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

⁴⁴ Google objects to this instruction as redundant and unnecessary in light of other instructions proposed by both parties.

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. Accordingly, you may evaluate whether there was some teaching, suggestion, or motivation to arrive at the claimed invention before the time of the claimed invention, although proof of this is not a requirement to prove obviousness.

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, this evidence would make it more likely that the claimed invention was obvious.

Again, you must undertake this analysis separately for each claim that Google contends is obvious and for each obviousness combination that Google asserts.⁴⁵

⁴⁵ *DePuy*, ¶ 4.3.2; *Tarkus*, ¶ 4.5.2.

4.4.3 OBVIOUSNESS – RELIANCE ON HINDSIGHT IMPROPER⁴⁶

PUM'S PROPOSAL:

The question of obviousness is simple to ask but difficult to answer. A person of ordinary skill in the art is presumed to have knowledge of the relevant prior art at the time of the patentee's invention. If you find the available prior art shows each of the elements of the claims in suit, you must determine whether it would then have been obvious to a person of ordinary skill in the art to combine or modify these elements in the same manner as the Asserted Claims.

The difficulty that attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Rather, you must cast your mind back to the time of the invention and consider only the thinking of one of ordinary skill in the art, guided only by the prior art and what was known in the field.⁴⁷

⁴⁶ Google objects to this instruction as redundant and unnecessary in light of both parties' proposed instructions on obviousness.

⁴⁷ *Power Integration*, ¶ 5.6

4.4.4 OBVIOUSNESS - LEVEL OF ORDINARY SKILL (JOINTLY SUBMITTED)

Obviousness is determined from the perspective of a person of ordinary skill in the art to which the claimed invention pertains at the time the claimed invention was made. This person is presumed to know all the prior art that you have determined to be reasonably relevant. When faced with a problem, this ordinary skilled person is able to apply his or her experience and ability to the problem and also look to any available prior art to help solve the problem.

It is up to you to decide the level of ordinary skill in the field of the invention. In deciding what the level of ordinary skill in the field of the invention is, you should consider all the evidence introduced at trial, including but not limited to: (1) the educational level and experience of people working in the field; (2) the types of problems faced by workers in the art at the time of the invention; (3) the solutions found to those problems; (4) the prior art patents, products or devices, and publications; and (5) the sophistication of the technology in the field at the time of the invention, including how rapid innovations were made in the art at the time of the invention.⁴⁸

⁴⁸ DePuy, ¶ 4.3.2; Tarkus, ¶ 4.5.3

4.4.5 OBVIOUSNESS – SECONDARY CONSIDERATIONS CONCERNING OBVIOUSNESS

PUM’S PROPOSAL:

In evaluating the issue of obviousness, you must also consider certain factors which, if established by PUM, may indicate that the invention would not have been obvious. No factor alone is dispositive, and you must consider the obviousness or non-obviousness of the invention as a whole. Some of these indications are:

1. Commercial success of products that practice the claims of the Asserted Patents;
2. A long-felt need in the art that was satisfied by the inventions claimed in the Asserted Patents;
3. Failed attempts by others to make the invention;
4. Copying of the invention by others in the field;
5. Praise of the invention by the infringer or others in the field;
6. Unexpected results achieved by the invention;
7. The taking of licenses under the patents by others;
8. Expressions of surprise by experts and those skilled in the art at the making of the invention; and
9. That the patentee proceeded contrary to accepted wisdom of the prior art.

There must be a connection between the evidence showing any of these factors and either the claimed invention, or the advantages that result from practicing the claimed invention, if this evidence is to be given weight by you in arriving at your conclusion on the obviousness issue.

For example, if commercial success of products that practice the Asserted Patents is due to brand name recognition, company goodwill, advertising, promotion, salesmanship or the like,

or is due to features of the product other than those claimed in the Asserted Patents, then commercial success may have no relation to the issue of obviousness. However, a relationship between commercial success and the claimed invention is presumed to exist if the product that is commercially successful is the invention disclosed and claimed.⁴⁹

When a patentee such as PUM comes forward with evidence of secondary considerations, the burden of proof that the claims were obvious in light of all the evidence remains on the defendant such as Google by clear and convincing evidence.

⁴⁹ *DePuy*, ¶ 4.3.4; *Tarkus*, ¶ 4.5.4

5. GOOGLE'S BREACH OF CONTRACT COUNTERCLAIM

PUM'S PROPOSAL:

In order to decide whether Google has proven its breach of contract claim against Dr. Konig by a preponderance of the evidence, you need to address two issues.

First, you must decide whether PUM has proven by a preponderance of the evidence that Google's breach of contract counterclaim is barred by the statute of limitations.

Second, if not barred by the statute of limitations, you must decide whether Google has proven by a preponderance of the evidence that SRI assigned its rights to assert a breach of contract claim against Dr. Konig to Google.

Third, if you find such assignment, you must then decide whether Google has shown by a preponderance of the evidence that Dr. Konig breached his employment agreement with SRI by assigning his rights in the patents-in-suit to Utopy rather than SRI.

Fourth, if you find that Dr. Konig violated the employment agreement by assigning his rights to Utopy rather than SRI, you must then decide whether PUM has shown by a preponderance of the evidence that Dr. Konig's inventions were covered by Section 2870 of the California Labor Law which protects certain inventions from assignment to employers.⁵⁰

I will now instruct you on the law that governs these issues.

⁵⁰ California Civil Jury Instruction 300 (Breach of Contract - Introduction); 35 U.S.C. § 261; *Filmtec Corp. v. Allied-Signal Inc.*, 939 F.2d 1568, 1574 (Fed. Cir. 1991); *Rhone-Poulenc Agro S.A. v. Dekalb Genetics Corp.*, 284 F.3d 1323 (Fed. Cir.2002).

GOOGLE’S PROPOSAL: [BREACH OF CONTRACT];⁵¹ [BREACH OF CONTRACT – GENERALLY]⁵²

Google asserts that Yochai Konig entered into an employment contract with SRI on or about April 8, 1996 that obliged him to assign to SRI any inventions conceived during his employment with SRI. Google asserts that Konig conceived the inventions in the patents-in-suit during his employment with SRI and that Konig breached his employment contract because he failed to assign the inventions in the patents-in-suit to SRI as required by his employment contract. Google asserts that Konig’s breach of his employment contract causes Google harm by denying it acknowledgement as a rightful co-owner of the patents-in-suit.

⁵¹ PUM includes a proposed construction on “Conception.” PUM’s lengthy instruction on the patent-law definition of conception is improper for several reasons. First, as stated elsewhere, Google disputes that there is any *conflicting* evidence on the meaning of “conceived” from the Employment Agreement. Thus, it is improper to task the jury with deciding whether this word tracks the patent-law definition of conception. Second, even if the jury is tasked with resolving this issue, it is PUM’s burden to prove to the jury what “conception” means. That is, if it is PUM’s position that the parties to the Konig-SRI agreement intended for the term “conceived” in the agreement to mean patent law conception, PUM must show that “conceived” has a patent law meaning and what that means. In proposing a jury instruction defining patent law conception, PUM is improperly putting its arguments on the merits into the instruction. Finally, even if “conceived” did track the patent-law definition of conception, PUM’s instruction deviates radically from other instructions that the Federal Circuit has approved in similar situations. For example, in *Arachnid Inc. v. Industrial Design Elecs. Assoc., Inc.*, 837 F.2d 1097 (Fed. Cir. 1987) (table), the dispute (as here) was whether plaintiff owned a patent based on its contractual right to all inventions “conceived” during the duration of a contract between the parties. The patent-law definition of conception applied to that dispute, yet the Federal Circuit explicitly approved a jury instruction on conception that was radically different in scope and content from the type of jury instruction that PUM proposes here. The approved instruction in *Arachnid* stated: “To conceive an invention means to complete the mental act of formulating the invention. It does not mean putting the invention into practice or building a working model. If you find that [Arachnid] has proven by a preponderance of the evidence that defendant IDEA had determined before January 26, 1982, that using two microcomputers as opposed to one would eliminate scoring problems on electronically scored dart games, then you should answer yes to question number 2 [Was the patented dual microcomputer invention conceived by IDEA before January 26, 1982?].” *Id.* at *1-2 (brackets in original). Any jury instruction on the patent-law definition of conception, as applied to this dispute, should track the approved instruction in *Arachnid*, though obviously substituting a very brief overview of *these* patented inventions for the very brief overview of the patented inventions in *Arachnid*.

⁵² *Abdelhamid v. Fire Ins. Exch.*, 182 Cal.App.4th 990, 999 (3d Dist. 2010) (“The standard elements of a claim for breach of contract are (1) a contract, (2) plaintiff’s performance or excuse for nonperformance, (3) defendant’s breach, and (4) damage to plaintiff therefrom.”).

5.1 STATUTE OF LIMITATIONS

PUM'S PROPOSAL:

The law requires a party to timely file an action to pursue its alleged rights. This is called a statute of limitations. Statutes of limitations afford plaintiffs a reasonable time to present their claims, but protect defendants and the courts from having stale claims brought to the Court.⁵³ If a party does not file an action within the time period set by the statute of limitations, it is time-barred.

As assignee under the agreement between SRI and Google, Google stands in shoes of the assignor, SRI, such that if SRI's right to bring a claim against Dr. Konig is barred by the statute of limitations, Google's claim is barred as well.⁵⁴

The statute of limitations that applies to this case requires a party such as SRI and Google to file a breach of contract action within three years after the breach allegedly occurred. The statute begins to run at the time of the breach, even if SRI did not know of its claim.⁵⁵ Google contends that the statute should be tolled, or stopped from running for a period of time, under an exception that the injury was inherently unknowable. This exception is not lightly invoked, because equitable exceptions to statutes of limitations are narrow and designed to prevent injustice.⁵⁶ It is Google's burden to demonstrate by a preponderance of evidence this exception applies such that the statute of limitations should be tolled.

⁵³ *United States v. Kubrick*, 444 U.S. 111, 117 (1979).

⁵⁴ *Madison Fund, Inc. v. Midland Glass Co.*, No. 394-1974, 1980 WL 332958 (Del. Super. Ct. Aug. 11, 1980)

⁵⁵ *Medtronic Vascular, Inc. v. Advanced Cardiovascular Sys., Inc.*, Civ. A. No. 98-80-SLR, 2005 WL 46553, at *4 (D. Del. Jan. 5, 2005).

⁵⁶ *Central Mortg. Co. v. Morgan Stanley Mortg. Capital Holdings LLC*, 2012 WL 3201139, at *23 (Del. Ch. Aug. 7, 2012).

In determining whether tolling applies, it is important to keep in mind that the law requires a claimant such as SRI to exercise reasonable diligence to inquire into facts, which if pursued, would put it on notice of a potential claim.⁵⁷ Thus, the statute begins to run again as soon as facts exist which would put a person of ordinary intelligence and prudence on inquiry notice such that, if pursued, they would lead to the discovery of such facts.⁵⁸

⁵⁷ *Wright*, 2022 WL 31357891, at *2 (citing *Giordano v. Czerwinski*, 216 A.2d 874, 876 (Del. 1966)); *Wal-Mart Stores, Inc. v. AIG Life Ins. Co.*, 860 A. 2d 312, 319 (Del. Supr. 2004) (internal quotation marks and citations omitted).

⁵⁸ *Lecates v. Hertrich Pontiac Buick Co.*, 515 A.2d 163, 176 (Del. Super. Ct. 1986); *Wal-Mart Stores, Inc. v. AIG Life Inc. Co.*, 860 A.2d 312, 319 (Del. 2004); *Wright v. Dumizio*, No. 08-292, 2002 WL 31357891, at *3 (Del. Super. Ct. Oct. 31, 2002); *Medtronic Vascular, Inc. v. Advanced Cardiovascular Sys., Inc.*, No. Civ. 98-80-SLR , 2005 WL 46553, at *4 (D. Del. Jan. 5, 2005), *aff'd*, 182 F. App'x 994 (Fed. Cir. May 26, 2006).

GOOGLE'S PROPOSAL:⁵⁹

PUM and Konig assert that Google's claims for breach of contract, ownership, and conversion were not filed within the time set by law. To succeed on this defense, PUM and Konig must prove that Google's claimed harm occurred more than 3 years before the date of filing of Google's claims for breach of contract, ownership, and conversion.

However, Google maintains that the statute of limitations was tolled and did not begin to run until after this lawsuit was filed and PUM provided confidential discovery concerning the conception date of the patented inventions. The statute of limitations must be tolled if the injury was inherently unknowable and Google and SRI were blamelessly ignorant of the wrongful act and the injury they suffered. You must find that the statute of limitations was tolled if, before PUM produced confidential discovery in this case, it was inherently unknowable to Google and SRI that the inventions were conceived during Konig's SRI employment, and Google and SRI were blamelessly ignorant of this fact. You must consider whether Google or SRI were aware of the conception date before this lawsuit was filed, whether any facts available to Google or SRI would have caused a person of ordinary intelligence and prudence to conduct an inquiry into the conception date, and whether such an inquiry would have led to the discovery of the conception date. If you find that Google and SRI were unaware of the conception date before this lawsuit and that no inquiry they reasonably should have conducted before this lawsuit would have caused them to discover the conception date, you must find that the statute of limitations was tolled until PUM produced confidential discovery in this lawsuit concerning the conception date.

⁵⁹ CACI 338; *Wal-Mart Stores, Inc. v. AIG Life Ins. Co.*, 860 A.2d 312, 319 (Del. 2004).

5.2 BREACH OF CONTRACT

5.2.1 ASSIGNMENT OF CONTRACT RIGHTS

PUM'S PROPOSAL:

You must determine whether Google has proven by a preponderance of the evidence that, under the Google/SRI Purchase Agreement, SRI assigned its right to bring a breach of contract claim against Dr. Konig to Google. Google contends that it acquired SRI's right to assert SRI's breach of contract claim against Dr. Konig.⁶⁰ PUM contends that, pursuant to § 4 of the SRI/Google Purchase Agreement, no such transfer took place.

GOOGLE'S PROPOSAL:^{61 62}

Google was not a party to the original employment contract between SRI and Konig. However, Google may bring a claim for breach of contract because SRI transferred its rights under the contract to Google. This transfer is referred to as an "assignment."

⁶⁰ Google incorrectly states that the parties do not contest whether SRI assigned to Google a right to bring a breach of contract claim against Dr. Konig. Google Proposed Final Jury Instructions at § 3.1. This is a contested issue.

⁶¹ CACI 327

⁶² Google objects to PUM's proposed instruction because PUM did not disclose a specific defense dependent on § 4 of the SRI/Google Purchase Agreement.

5.2.2 BREACH OF CONTRACT ELEMENTS

PUM'S PROPOSAL:

If you decide that the statute of limitations does not bar the breach of contract claim, and that Google acquired SRI's right to assert a breach of contract claim against Dr. Konig, to find Dr. Konig liable for breach of contract, Google must prove all of the following by a preponderance of the evidence:

1. That Dr. Konig and SRI entered into a contract;
2. That SRI did all, or substantially all, of the significant things that the contract required it to do or that it was excused from doing those things;
3. That Dr. Konig materially breached the contract; and
4. That SRI was injured by that failure.

As I will now explain, in determining whether Dr. Konig materially breached his employment agreement, you must decide whether Dr. Konig conceived of the inventions while he was employed at SRI and, if so, whether the inventions fall within the scope of the agreement or are otherwise protected under section 2870 of the California Labor Code. [3]

I will address each of these in turn.

5.3 CONCEPTION⁶³

PUM'S PROPOSAL:

As I just mentioned, in determining whether Dr. Konig breached his employment agreement, you must first determine whether he conceived of the inventions while he was employed by SRI. To do this, you must determine the meaning of the word “conception” as used in Dr. Konig’s employment agreement. Once you decide the meaning that was intended, you must then decide whether Dr. Konig conceived of the inventions while he was employed at SRI. If you find that Dr. Konig conceived of the inventions after he left SRI, then the invention cannot be subject to the employment agreement.

Google claims that the term “conceived” under the Employment Agreement was intended by the parties to mean in the “layman’s sense,” such that Dr. Konig had to assign all inventions he got the idea for while employed at SRI. PUM claims that the term “conceived” relates to the technical definition of “conception” according to patent law, which I will explain to you. Google must prove by a preponderance of the evidence that its interpretation of what the parties intended is correct.

I will now explain the patent law definition of conception. Under the law, conception is the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention, such 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 make the invention without undue research or experimentation or the exercise of inventive skill.

⁶³ Google objects to this instruction. It is for the jury to decide the meaning of conception under the Konig/SRI agreement. The Court should not instruct the jury on what a possible meaning might be. The jury must decide based on the evidence what the parties to that contract—Konig and SRI—intended for it to mean.

The rules about when conception occurs ensure that an inventor can claim rights to an invention only when an idea is so far developed that the inventor can point to a definite, particular invention.⁶⁴

⁶⁴ *Id.*

GOOGLE’S PROPOSAL: [INTERPRETATION-DISPUTED TERM]⁶⁵

[Google’s Comment: Google believes that the meaning of the word “conceived” in Yochai Konig’s employment agreement with SRI is an issue of law to be decided by the Court and that there is no conflicting extrinsic evidence such that this issue could be decided by the jury. Nevertheless, to the extent that this issue is given to the jury to decide, Google proposes instructions 5.4 and 5.5 herein. If this issue is not given to the jury, then these two instructions should not be read to the jury.]

Google, and PUM and Konig dispute the meaning of the following term contained in Konig’s employment agreement with SRI: conceived. Google claims that the term has a layperson’s meaning. PUM and Konig contend that it has a patent law meaning.

In deciding what the terms of a contract mean, you must decide what the parties intended at the time the contract was entered into. You may consider the usual and ordinary meaning of the language used in the contract as well as positions of the parties and the circumstances surrounding the making of the contract.

⁶⁵ CACI 314

5.4 CONTRACT INTERPRETATION (JOINTLY SUBMITTED)

In deciding the meaning of the term “conception,” you must determine the usage that was intended in the context of the employment agreement at the time the contract was created. In making this determination, you must consider the objective intent of the parties as evidenced by the words of the contract, and the surrounding circumstances, rather than the subjective intent of one of the parties.

A party’s undisclosed intent or understanding is irrelevant to contract interpretation.⁶⁶ What is relevant is the outward manifestation of that party’s intent whether in written or spoken words, or deeds, or from the surrounding circumstances.

In deciding what the words of a contract objectively mean, you should consider the whole contract, not just isolated parts. You should use each part to help you interpret the others, so that all the parts make sense when taken together. You should also consider the circumstances surrounding the signing of the agreement.

You should assume that the parties intended the words in their contract to have their usual and ordinary meaning unless you decide that the parties intended the words to have a special meaning.

You should assume that the parties intended technical words used in the contract to have the meaning that is usually given to them by people who work in that technical field, unless you decide that the parties clearly used the words in a different sense.

In determining the meaning of a term of the contract, you must first consider all of the other instructions that I have given you. If, after considering these instructions, you still cannot

⁶⁶ *Founding Members of the Newport Beach Country Club v. Newport Beach Country Club, Inc.*, 135 Cal. Rptr. 2d 505, 514 (Cal. Ct. App. 2003) (internal quotation marks, alterations and citations omitted); see also *Progressive Int’l Corp. v. E.I. du Pont de Nemours & Co.*, 2002 WL 1558382, at *7 (Del. Ch. July 9, 2002).

agree on the meaning of the term, then you should interpret the contract term against the party that drafted the term. [*PUM's Proposal*:⁶⁷ **Ambiguities also should be construed against the employer in a contract to assign inventions.**]⁶⁸

⁶⁷ Google objects to PUM's addition to this instruction as redundant in light of the prior sentence, biased toward PUM's position, and contrary to California law. California law makes clear that construing ambiguities against the drafter – such as the employer in the typical case of form employment contracts – is a canon of last resort that should only be invoked if all other principles of California contract interpretation have failed to resolve the contract ambiguity. *See* Cal. Civ. Code § 1654.

⁶⁸ California Civil Jury Instructions 303 (Breach of Contract - Essential Factual Elements), 314 (Interpretation - Disputed Term), 316 (Interpretation - Meaning of Technical Words), 317 (Interpretation - Construction of Contract as a Whole), and 320 (Interpretation - Construction Against Drafter) and Cal Civil Code section 1654; *Hercules Glue Co. v. Littooy*, 25 Cal. App. 2d 182, 186 (Cal. Ct. App. 1938).

5.5 EXCEPTION TO EMPLOYMENT AGREEMENT UNDER SECTION 2870 OF THE CALIFORNIA LABOR CODE

PUM'S PROPOSAL:

PUM and Dr. Konig maintain that even if you were to find that Dr. Konig “conceived” the inventions at issue while employed at SRI, Dr. Konig did not breach the agreement because Section 2870 of the California Labor Code protected those inventions from assignment to SRI.

Section 2870 prohibits an employer from requiring that an employee assign his invention rights to the employer unless certain conditions are met, and it specifically exempts from assignment inventions that an employee develops entirely on his or her own time without using the employer's equipment, supplies, facilities, or trade secret information. There is no dispute that Dr. Konig did this.

The inventions will not be exempted from an employment agreement, however, if they either: (1) relate at the time of conception or reduction to practice of the invention to the employer's business, or actual or demonstrably anticipated research or development of the employer; or (2) result from any work performed by the employee for the employer.⁶⁹

⁶⁹ California caselaw and the restrictive language of § 2870 do not support instructing the jury to interpret the phrase “related to” broadly. Google quotes dicta in *Cadence Design*, 2007 WL 3343085, at *5, that courts “have construed the ‘related to’ phrase broadly,” citing *Cubic Corp. v. Marty*, 229 Cal. Rptr. 438 (Cal. Ct. App. 1986). But *Cubic* merely states that agreements can encompass inventions coming within the scope of the employer's business or expected business. *Id.* The court did not actually interpret the phrase broadly in either *Cubic* or *Cadence Design*. See *Cubic*, 229 Cal. Rptr. at 453 (finding invention “related” where employee obtained “company funding” for invention and presented it as “something which would enhance [the employer's] capabilities”); *Cadence Design*, 2007 WL 3343085, at *2 (finding invention “related” where employee developed product to “accelerate [employer's] product development”). Further, in *Applera-Applied Biosys. Grp. Corp. v. Illumina, Inc.*, Civ. A. No. 07-2845, 2008 WL 170597, at *4-5 (N.D. Cal. Jan. 17, 2008), the court found the invention was *not* related to employment, despite “similarity between patents and the employer's business,” in part because the employer had notice of the inventions and did nothing about it, *see id.*, and because the inventor's interest in the field pre-dated his employment.” *Applera-Applied Biosys. Grp. Corp. v. Illumina, Inc.*, 375 F. App'x 12, 16, 18 (Fed. Cir. 2010).

The purpose of this provision is to limit an employee's duty to assign his or her inventions under an employment agreement to those inventions that are within the subject matter of the employment relationship.⁷⁰ Any employment agreement provision which purports to apply to an invention that is not covered by the exceptions of Section 2870 is against the public policy of the State of California and is void and unenforceable.

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If you find that Google has proven by a preponderance of the evidence that Dr. Konig conceived of the inventions while he was also employed by SRI, then you must decide whether PUM has established by a preponderance of the evidence that section 2870 protects Dr. Konig's inventions.

⁷⁰ Cal. Labor Code. § 2870; *Applera Corp.--Applied Bios. Grp. v. Illumina, Inc.*, 375 F. App'x 12, 17 (Fed. Cir. 2010).

⁷¹ *Applera-Applied Biosys. Grp. Corp. v. Illumina, Inc.*, Civ. A. No. 07-2845, 2008 WL 170597, at *1-2, 4 (N. D. Cal. Jan. 17, 2008), *Applera-Applied Biosys. Grp. Corp. v. Illumina, Inc.*, 375 F. App'x 12 (Fed. Cir. 2010).

GOOGLE'S PROPOSAL:

Konig asserts that even if his inventions are found to have been conceived during his employment with SRI, he did not have a duty to transfer these inventions to SRI because they are exempt from his transfer obligations under Section 2870 of the California Labor Code. Konig bears the burden of proving by a preponderance of the evidence that the inventions are exempt from his transfer obligations under Section 2870.

To prove that the inventions are exempt from his transfer obligations, Konig must prove each of the following three things: (1) The inventions were not related to SRI's business or actual or demonstrably anticipated research or development when the inventions were conceived or reduced to practice; (2) The inventions did not result from any work performed by Konig for SRI; and (3) Konig developed the inventions entirely on his own time without using SRI's equipment, supplies, facilities, or trade secret information.⁷² If you find that Konig cannot prove each of these three criteria, you must find that the inventions are not exempt from Konig's transfer obligations under Section 2870. You must interpret the phrase "related to" broadly.⁷³

⁷² Cal. Labor Code § 2870; *Cadence Design Sys., Inc. v. Bhandari*, 2007 WL 3343085, *5 (N.D. Cal. Nov. 8, 2007) ("[T]here are three independent scenarios in which an agreement assigning an invention to an employer is enforceable under section 2870: (1) The invention was developed using the employer's time or resources; or (2) The invention relates to the employer's business or actual or demonstrably anticipated research or development; or (3) The invention resulted from work performed by the employee for the employer."); *Cubic Corp. v. Marty*, 185 Cal. App. 3d 438, 451 (4th App. Dist. 1986); CACI 300.

⁷³ *Cadence Design*, 2007 WL 3343085 at *5.

6. DELIBERATION AND VERDICT

6.1 INTRODUCTION⁷⁴ (JOINTLY SUBMITTED)

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 5-3 or 7-1, or whatever your vote happens to be. That should stay secret until you are finished.

⁷⁴ *Sunovion Pharmaceuticals Inc. v. Dey Pharma, L.P. et al.*, No. 06-113 (LPS), D.I. 571 (D. Del. Feb. 8, 2012); The Uniform Jury Instruction for Patent Cases in the United States District Court for the District of Delaware (March 1993).

6.2 UNANIMOUS VERDICT⁷⁵ (JOINTLY SUBMITTED)

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 you become convinced it is erroneous. But do not surrender your honest conviction as to the weight or effect of evidence solely because of the opinion of your fellow jurors, or for the purpose of returning a verdict. Remember at all times that you are not partisans. You are judges — judges of the facts. 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. Then each of you will sign and date the form. You will then return to the courtroom and your verdict will be read in open Court by my deputy.

It is proper to add the caution that nothing said in these instructions and nothing in the form of 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 the sole and exclusive duty and responsibility of the jury.

⁷⁵ *Sunovion Pharmaceuticals Inc. v. Dey Pharma, L.P. et al.*, No. 06-113 (LPS), D.I. 571 (D. Del. Feb. 8, 2012); The Uniform Jury Instruction for Patent Cases in the United States District Court for the District of Delaware (March 1993).

6.3 DUTY TO DELIBERATE⁷⁶ (JOINTLY SUBMITTED)

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.

You might have questions about the schedule for deliberations. Generally speaking, your deliberations will run until ___ p.m., unless you unanimously decide you wish to deliberate until a later time. If you do not complete your deliberations today, you will return to continue deliberating tomorrow beginning at ___ a.m.

⁷⁶ *Sunovion Pharmaceuticals Inc. v. Dey Pharma, L.P. et al.*, No. 06-113 (LPS), D.I. 571 (D. Del. Feb. 8, 2012); The Uniform Jury Instruction for Patent Cases in the United States District Court for the District of Delaware (March 1993).

6.4 SOCIAL MEDIA⁷⁷ (JOINTLY SUBMITTED)

During your deliberations, you must not communicate with or provide any information to anyone by any means about this case. You may not use any electronic device or media, such as the telephone, a cell phone, smart phone, iPhone, blackberry or computer, the internet, any internet service, any text or instant messaging service, any internet chat room, blog, or website such as Face book, MySpace, LinkedIn, YouTube or Twitter, to communicate to anyone any information about this case or to conduct any research about this case until I accept your verdict. In other words, you cannot talk to anyone on the phone, correspond with anyone, or electronically communicate with anyone about this case [***PUM proposal: or perform any research***]. You can only discuss the case in the jury room with your fellow jurors during deliberations.

⁷⁷ *Sunovion Pharmaceuticals Inc. v. Dey Pharma, L.P. et al.*, No. 06-113 (LPS), D.I. 571 (D. Del. Feb. 8, 2012)

6.5 COURT HAS NO OPINION⁷⁸ (JOINTLY SUBMITTED)

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

⁷⁸ *Sunovion Pharmaceuticals Inc. v. Dey Pharma, L.P. et al.*, No. 06-113 (LPS), D.I. 571 (D. Del. Feb. 8, 2012); The Uniform Jury Instruction for Patent Cases in the United States District Court for the District of Delaware (March 1993).