

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

PERSONALIZED USER MODEL, L.L.P.,)	
)	
Plaintiff,)	C.A. No. 09-525-LPS
)	
v.)	JURY TRIAL DEMANDED
)	
GOOGLE INC.,)	
)	
Defendant.)	
_____)	
GOOGLE, INC.)	
)	
Counterclaimant,)	
)	
v.)	
)	
PERSONALIZED USER MODEL, LLP and)	
YOCHAI KONIG)	
)	
Counterdefendants.)	

GOOGLE'S OBJECTIONS TO THE COURT'S FINAL JURY INSTRUCTIONS

To preserve its rights under Federal Rule of Civil Procedure 51(c), Defendant and Counterclaimant Google Inc. (“Google”) respectfully objects to the Court’s Final Jury Instructions and Verdict Form as distributed to the parties on March 18, 2014 as detailed below. Additionally, Google incorporates by reference all objections made orally and in prior filings to the Court concerning jury instructions and the verdict form.

I. JURY INSTRUCTIONS

Google objects to **Section 2: The Parties and Their Contentions**, because PUM’s allegation “assert[ing] that SRI did not assign to Google its right to assert a breach of contract claim against Konig” should not be sent to the jury. California law is clear that in the absence of material conflict in the extrinsic evidence surrounding the circumstances of an agreement, all issues of contract interpretation are to be resolved as a matter of law. *F.B.T. Prod’s LLC v.*

Aftermath Records, 827 F. Supp. 2d 1092, 1102 (C.D. Cal. 2011). Therefore, it is not the province of the jury to interpret that Google-SRI Agreement and decide whether it constitutes a valid assignment under California law.

Google objects to the Court's decision not to include Google's proposed instruction **How a Claim Defines What It Covers**. Google's proposal clarifies to the jury the definition of a patent claim and provides additional context not included in the Court's general instruction on infringement, Section 3.1: Infringement of Patent Claims. Not including this proposal risks juror confusion.

Google objects to the title of **Section 3.3: Order of Steps Is Not a Requirement** because the title is a misstatement of the Court's claim construction ruling, as evidenced by the language in the instruction itself. Google proposed replacing the title with "Order of Steps Is Not Necessarily a Requirement," which would have further explained in the instruction and avoided juror confusion. Google maintains its objection to the title of the instruction to the extent that the Court did not make such a change prior to charging the jury.

Google objects to the following instructions to the extent that they alternate between referring to the Accused Products in the singular and in the plural. Specifically, Google objects to the instructions to the extent that such language can confuse the jury and lead jurors to mistakenly believe that showing infringement by one product is sufficient to show infringement by all products. Specifically, on page 27 (**Section 3.6 Direct Infringement – Literal Infringement**), Google requested the following minor change (as bracketed), and Google maintains its objections to any failure by the Court to make such a change prior to charging the jury:

To prove literal infringement [of one of Google's Accused Products], PUM must prove by a preponderance of the evidence that [that Accused Product] include[s] 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. 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.

If you find that an independent claim has been infringed [by one of Google's Accused Products], you must still decide, separately, whether [that Accused Product] 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.

On page 29 (Section 3.7 Direct Infringement – Doctrine of Equivalent), the instructions are again sufficiently vague as to imply that infringement by one product may be sufficient to show infringement by all of them. Google requested the following changes, which again are presented in brackets, and Google maintains its objections to any failure by the Court to make such a change prior to charging the jury:

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 [that Accused Product]. 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 [that Accused Product] contain[s] components or features that are the same or equivalent to each claimed requirement of the patented invention.

Page 30 (**Section 3.7 Direct Infringement – Doctrine of Equivalents**) similarly alternates between the singular and plural in discussing the Accused Products. Google requested the following minor change, and Google maintains its objections to any failure by the Court to make such a change prior to charging the jury:

In addition, the components or features of the [Accused Product] can be part of an integral structure and still be equivalent to a claimed component or feature.

Google objects to **Instruction 4.2: Presumption of Validity** as misleading and prejudicial. Prior to trial, the Court granted Plaintiff's motion *in limine* to exclude of the fact that the PTO has issued final rejections of both of the patents-in-suit. (D.I. 606, 6.) Google requested that the Court either instruct the jury that the burden of proof for proving invalidity is a preponderance of the evidence or that it not instruct the jury as to the presumption of validity

because such an instruction would be prejudicial against Google in light of the Court's preclusion of the evidence concerning the reexamination. (*See* D.I. 597, 4-5 n.5.) The Court denied Google's request and instructed the jury on the presumption of validity in a single sentence of the preliminary jury instructions, while stating that the burden to prove invalidity is clear and convincing evidence. (D.I. 635.)

In relation to the final jury instructions, Google against asked the Court either to instruct the jury that the burden of proof for invalidity is the preponderance of the evidence or not to instruct the jury on the presumption of validity because of the PTO's final rejection of both patents. The Court denied this request and included not just a single line concerning the presumption, like it did in the preliminary instructions, but a full three-paragraph instruction on the presumption.

Google maintains that the inclusion of any mention of the presumption of validity is misleading and prejudicial in this case because the Court precluded Google from introducing any evidence that the PTO has issued final rejections of both patents-in-suit. Google further objects to the inclusion of a multi-paragraph instruction highlighting the presumption of validity. *Oracle Am. v. Google Inc.*, No. 10-03561, 2012 WL 1189898, *3 (N.D. Cal. Jan. 4, 2012), which addressed a similar situation, is instructive:

The presumption of validity is based on the expertise of the examiner, but now the examiner has come out in favor of rejection on two patents in suit . . . it would be misleading to instruct the jury on the presumption of validity while concealing from the jury the fact that the rationale for the presumption—PTO examiner expertise—has been drawn into question by more recent examiner rejections based in part on prior art previously not disclosed to the PTO.

Id.

Google objects to **Instruction 4.3: Anticipation** in so far as it contains the sentence, "It must have been available, without restriction, to that segment of the public most likely to avail

itself of the prior art's contents.” This sentence is a misstatement of the law likely to confuse the jury. To represent an anticipatory reference, prior art need not be available without restriction to every individual with skill in the art or to every member of the public likely to avail itself of the prior art's contents. Rather, prior art must simply be “disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.” *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981); *see also* MPEP § 2128 (quoting same).

Google objects to **Instruction 4.4.1: Obviousness – Scope and Content of the Prior Art** as a misstatement of the law. Prior art is not limited to patents issued more than a year before the effective filing date of the patents-in-suit or publications dated more than one year before the effective filing date. Rather, 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. Accordingly, Google maintains that the Court's failure to adopt its instruction concerning prior art constituted legal error and resulted in juror confusion. (D.I. 651, 53 (Adapted from the Federal Circuit Bar Association Model Patent Jury Instructions Section 4.3a (2012 ed.)).)

Google objects to **Section 5: Google's Breach of Contract Counterclaim**, as the first issue it asks the jury to consider, “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,” asks the jury to weigh affirmative defenses to the claim before proceeding to the merits of the claim. Google maintains that the jury should first decide the merits of the breach of contract claim, and subsequently decide any affirmative defenses, including statute of limitations. Google further objects to the second issue that this instruction asks the jury to

consider, the sufficiency of SRI's contractual assignment to Google, as this contract-interpretation question is a question of law. *F.B.T. Prod's*, 827 F. Supp. 2d at 1102. Additionally, and consistent with its objection to the Court's special verdict form, Google maintains that the jury should decide the merits of Google's breach of contract claim to avoid the need for an entirely new trial should it be found, whether in this Court or on appeal, that PUM's defenses fail as a matter of law.

Google objects to **Section 5.1: Statute of Limitations**, as to the portion of the instruction stating that "The statute begins to run at the time of the breach, even if SRI did not know if its claim." This sentence, without qualifying language, is overbroad and misleading to the jury given that tolling, by definition, precludes the statute from running at the time of the breach. Google further objects to the instruction's description that 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." Google respectfully submits that this statement of the law omits relevant language in *Wal-Mart Stores Inc. v. AIG Life Ins. Co.*, 860 A.2d 312, 319 (Del. 2004), which states that the statute begins "to run upon the discovery of facts *constituting the basis of the cause of action* or the existence of facts sufficient to put a person of ordinary intelligence and prudence on inquiry, which, if pursued, would lead to the discovery of such facts." (emphasis added, internal citations and quotations omitted). Google maintains that the omitted "constituting the basis of the cause of action" clause is necessary to accurately state the tolling standard.

Google objects to **Section 5.2.1: Assignment of Contract Rights** because it omits the contractual definition of assignment, based on California Civil Jury Instructions § 327.¹ Google

¹ In relevant part, California Civil Jury Instructions § 327 reads "[Party] may bring a claim for breach of contract because [name of assignor] transferred the rights under the contract to [party].

further objects to the instruction because PUM did not disclose a specific defense dependent on § 4 of the SRI/Google Purchase Agreement, and thus should not be allowed to present an argument based on this section to the jury. Google also renews its objection that the jury should not decide the sufficiency or insufficiency of the assignment, since California law is clear that in the absence of material conflict in the extrinsic evidence surrounding the circumstances of an agreement, all issues of contract interpretation are to be resolved as a matter of law. *F.B.T. Prod's*, 827 F. Supp. 2d at 1102.

Google objects to **Section 5.2.2: Breach of Contract Elements**, as the first sentence of this instruction, “If you decide that the statute of limitations does not bar the breach of contract claim . . .” insofar as it asks the jury to weigh affirmative defenses to the claim before proceeding to the merits of the claim. Google maintains that the jury should first decide the merits of the breach of contract claim, and subsequently decide any affirmative defenses, including statute of limitations.

Google objects to **Section 5.3: Conception** because, as described in complete detail in its March 18, 2014 letter to the court (*Dkt.* 659), the term “conceived” should be given its ordinary layman’s meaning in this particular case, to be consistent with the rest of the terms in the contract.

II. VERDICT FORM

Google first objects to the verdict form as confusing because of the format used in the Sections I-II. Specifically, Google objects to the use of charts in the form rather than individual

This transfer is referred to as an ‘assignment.’”

questions for each issue, as proposed by Google in its initial Proposed Verdict Form, (D.I. 590), and its Revised Proposed Verdict Form. (D.I. 660.)

In addition, Google objects to the Court's failure to include the identifying short-hand name and the full citation for each of the prior art references at issue in Section I.A: Invalidity - Anticipation. The Court identified each prior art reference only by the short-hand name used by Plaintiff's invalidity expert. For example, the Court included "Mladenic" as one of the three anticipating references listed in Section II.A despite the fact that Google's invalidity expert consistently referred to this reference as "Personal WebWatcher." (*See, e.g.*, Trial Tr. 1224:21-23, 1226:5-11, 1228:10-12.) The failure to include both the identifying short-hand name and the full citation for each of the prior art references is likely to mislead the jury and, to the extent that the Court included only Plaintiff's short-hand name for a reference on the verdict form, to prejudice Google.

Google objects to **Section III: Google's Breach of Contract Counterclaim**, because the first question of this instruction, "Has Google proven by a preponderance of the evidence that the three-year statute of limitations that applies to the breach of contract claim against Dr. Konig was tolled," asks the jury to weigh affirmative defenses of the claim before proceeding to the merits of the claim. Google maintains that the jury should first decide the merits of the breach of contract claim, and subsequently decide any affirmative defenses, including statute of limitations.

Google objects to **Section III: Google's Breach of Contract Counterclaim**, as the second question of the instruction, "Has Google proven by a preponderance of the evidence that it acquired from SRI the right to assert SRI's breach of employment contract claim against Dr. Konig," should not be sent to the jury. California law is clear that in the absence of conflicting

extrinsic evidence, all issues of contract interpretation are to be resolved as a matter of law. *F.B.T. Prod's*, 827 F. Supp. 2d at 1102. Additionally, Google objects to the instructions in Section III that the jury should not reach Questions 2, 3, and/or 4 depending on its answers to previous questions. This instruction is improper and inefficient, particularly for purposes of this Court's review and appellate review. The jury should answer *all* questions relating to the breach-of-contract claim, not stop depending on its answers to certain questions. That way, if this Court or the Federal Circuit reverses one or more jury findings, the remainder of Section III would be answered and those portions of the jury verdict may be sustained.

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Respectfully submitted,

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