

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

MOBILEMEDIA IDEAS, LLC,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civ. No. 10-258-SLR
	)	
APPLE INC.,	)	
	)	
Defendant.	)	

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**FINAL JURY INSTRUCTIONS**

Dated: December 11, 2012

## **GENERAL INSTRUCTIONS**

### **INTRODUCTION**

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. I will explain some rules that you must use in evaluating particular testimony and evidence. I will explain the positions of the parties and the law you will apply in this case. Last, I will explain the rules that you must follow during your deliberations in the jury room. 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 interrogatories, or questions, that you must answer to decide this case.

## **JURORS' DUTIES**

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 that 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 which party should prevail on the issues presented. I will instruct you about the burden of proof shortly. 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.

## **EVIDENCE DEFINED**

You must make your decision based only on the evidence that you saw and heard here in the courtroom. 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, the exhibits that I allowed into evidence, and any facts that the parties agreed to by stipulation.

Nothing else is evidence. The lawyers' statements and arguments are not evidence. Their questions and objections are not evidence. My legal rulings are not evidence. None of my comments or questions are evidence. The notes taken by any juror are not evidence.

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.

During the trial I may not have 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. And sometimes I may have ordered you to disregard things that you saw or heard. You must completely ignore all of these things. 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.

Make your decision based only on the evidence, as I have defined it here, and

nothing else.

## **DIRECT AND CIRCUMSTANTIAL EVIDENCE**

Some of you may have heard the terms "direct evidence" and "circumstantial evidence."

Direct evidence is simply evidence like the testimony of any 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 simply 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.

## **CONSIDERATION OF EVIDENCE**

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.

## **USE OF NOTES**

You may use notes taken during the trial to assist your memory. Remember that your notes are for your personal use. They may not be given or read to anyone else. Do not use your notes, or any other juror's notes, as authority to persuade fellow jurors. Your notes are not evidence, and they are by no means a complete outline of the proceedings or a list of the highlights of the trial. Some testimony that is considered unimportant at the time presented and, thus, not written down, may take on greater importance later on in the trial in light of all the evidence presented. Your notes are valuable only as a way to refresh your memory. Your memory is what you should be relying on when it comes time to deliberate and render your verdict in this case.



## **CREDIBILITY OF WITNESSES**

You, the jurors, are the sole judges of the credibility, or the believability, of the witnesses you have seen during the trial and the weight their testimony deserves.

You should carefully scrutinize all the testimony each witness has given and every matter of evidence that tends to show whether he or she is worthy of belief. Consider each witness's intelligence, motive, and state of mind, as well as his or her demeanor while on the stand. Consider the witness's ability to observe the matters as to which he or she has testified and whether he or she impresses you as having an accurate recollection of these matters. Consider also any relation each witness may bear to each side of the case, the manner in which each witness might be affected by the verdict, the interest any witness may have in the verdict, and the extent to which, if at all, each witness is either supported or contradicted by other evidence in the case.

Discrepancies in the testimony of different witnesses may, or may not, cause you to discredit such testimony. Two or more persons witnessing an incident or transaction may see or hear it differently. Likewise, 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 other time the witness said or did something, or failed to say or do something, that was different, or inconsistent, from the testimony that he or she gave during the trial. It is the province of the jury to determine whether a false statement or a prior inconsistent statement discredits the witness's testimony.

You should remember that a simple mistake by a witness does not 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 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.

## **NUMBER OF WITNESSES**

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.

## **EXPERT WITNESSES**

When knowledge of technical subject matter might be helpful to the jury, a person who has special training or experience in that technical field — he or she is called an expert witness — is permitted to state his or her opinion on those technical matters. However, you are not required to accept that opinion. As with any other witness, it is up to you to judge the credentials and credibility of the expert witness and decide whether to rely upon his or her testimony.

You should consider each expert opinion received in evidence in this case, and give it such weight as you think it deserves. If you decide that the opinion of an expert witness is not based upon sufficient education and experience, or if you conclude that the reasons given in support of the opinion are not sound, or if you feel that the opinion is outweighed by other evidence, you may disregard the opinion in whole or in part.

## **THE PARTIES AND THEIR CONTENTIONS**

I will now review for you the parties in this action and the positions of the parties that you will have to consider in reaching your verdict.

The plaintiff is MobileMedia Ideas LLC, which I will refer to as “MobileMedia.” The defendant is Apple Inc., which I will refer to as “Apple.”

MobileMedia manages intellectual property rights originally developed by Sony and Nokia. MobileMedia is the current owner of the following three patents:

- U.S. Patent No. 6,427,078 (“the ’078 patent”);
- U.S. Patent No. 6,253,075 (“the ’075 patent”); and
- U.S. Patent No. 6,070,068 (“the ’068 patent”).

I may refer to these patents collectively as “the patents-in-suit.”

Apple designs, manufactures, and markets mobile communication and media devices, personal computers, and portable digital music players.

MobileMedia contends that certain versions of Apple’s iPhone products infringe the following claims of the patents-in-suit:

- Claim 73 of the ’078 patent;
- Claims 5, 6, and 10 of the ’075 patent; and
- Claims 23 and 24 of the ’068 patent.

These claims may be referred to collectively as the “asserted claims.” Apple contends it does not infringe any of the asserted claims of the patents-in-suit. Apple further contends that each of the asserted claims is invalid due to anticipation and/or obviousness.

You will be asked to determine the issues of infringement and validity according to instructions I will give you in a moment.

## **BURDENS OF PROOF**

In any legal action, facts must be proven by a required standard of evidence, known as the “burden of proof.” In a patent case such as this, there are two different burdens of proof that you must consider.

The first burden of proof is called “preponderance of the evidence.” MobileMedia must prove its claims of patent infringement by a preponderance of the evidence. When a party has the burden of proof by a preponderance of the evidence, it means that you must be persuaded that what the party seeks to prove is more probably true than not true. To put it differently, if you were to put MobileMedia’s evidence of infringement and Apple’s evidence of non-infringement on opposite sides of a scale, the evidence supporting MobileMedia’s assertions would have to make the scale tip somewhat to MobileMedia’s side.

The second burden of proof is called “clear and convincing” evidence. Clear and convincing evidence is a higher burden of proof than a preponderance of the evidence. Apple has the burden of proving that each one of the asserted claims of the patents-in-suit is invalid by clear and convincing evidence. Clear and convincing evidence is evidence that produces an abiding conviction that the truth of a fact is highly probable. You must decide, as to each of the asserted claims, whether Apple has proven, by clear and convincing evidence, that the claim is invalid by reason of anticipation and/or obviousness in light of the prior art and the ordinary skill of one in the art. I will explain these concepts to you further in a moment.

Those of you who are familiar with criminal cases will have heard the term “proof beyond a reasonable doubt.” That burden does not apply in a civil case, such as this

one, and you, therefore, should put it out of your mind in considering whether or not MobileMedia has met its “more likely than not” burden of proof or Apple has met its “clear and convincing” burden of proof.



## **THE PATENT CLAIMS**

### **PATENT CLAIMS GENERALLY**

Before you can decide whether or not any of the asserted claims are infringed or invalid, you will have to understand what patent “claims” are. Patent claims are the numbered paragraphs at the end of a patent.

The purpose of the claims is to provide notice to the public of what a patent covers and does not cover. The claims are “word pictures” intended to define, in words, the boundaries of the invention described and illustrated in the patent.

Claims are usually divided into parts, called “limitations.” For example, a claim that covers the invention of a table may recite the tabletop, four legs, and the glue that secures the legs to the tabletop. The tabletop, legs and glue are each a separate limitation of the claim. A claim covering the invention of a table is called an apparatus claim. A claim describing the steps required to make a table is called a method claim.

## **DEPENDENT AND INDEPENDENT CLAIMS**

There are two different types of claims in a patent. The first type is called an “independent” claim. An independent claim does not refer to any other claim of the patent. An independent claim is read alone to determine its scope.

For example, claim 5 of the '075 patent is an independent claim. You know this because claim 5 does not refer to any other claims. Accordingly, the words of this claim are read by themselves in order to determine what the claim covers.

The second type, a “dependent” claim, refers to at least one other claim in the patent and, thus, incorporates whatever that other claim says. Accordingly, to determine what a dependent claim covers, you must read both the dependent claim and the claim or claims to which it refers.

For example, claim 6 of the '075 patent is a dependent claim. If you look at claim 6, it refers to claim 5. Therefore, to determine what claim 6 covers, you must consider both the words of claims 5 and 6 together.

## **OPEN-ENDED OR "COMPRISING" CLAIMS**

Several claims of the patents-in-suit use the transitional term "comprising." "Comprising" is interpreted the same as "including" or "containing." In patent claims, comprising means that the claims are open-ended, that is, the claims are not limited to products that include only what is in the claim and nothing else.

If you find that the accused products include all of the limitations in any of the asserted claims that use the term "comprising," the fact that the accused products may also include additional elements or features is irrelevant. The presence of additional elements or features in an accused product does not mean that the product does not infringe a patent claim.

Similarly, if you find that the prior art includes all of the limitations in any of the asserted claims that use the word "comprising," the fact that it may also include additional elements or features is irrelevant. The presence of additional elements or features does not mean that the prior art does not invalidate a patent claim.

## CLAIM CONSTRUCTION

It is my duty under the law to define what the patent claims mean and to instruct you about that meaning. You must accept the meanings I give you and use the meaning of each claim for your decisions on infringement and validity.

You must ignore any different interpretation given to these terms by the witnesses or by attorneys.

I instruct you that the following claim terms have the following definitions:

Term	Definition	Patent and Claim(s) Where Term Appears
camera unit	<b>Definition:</b> a data collection apparatus for obtaining image information.	'078 Patent, claim 73
means . . . for transmitting image information processed by said microprocessor to another location using a radio frequency channel	<b>Definition:</b> The function is to transmit a picture captured by the camera and processed by the processing unit to another location using a radio frequency channel. The structure is cellular mobile phone unit or equivalents thereof.	'078 Patent, claim 73
means for processing and for storing at least a portion of the image information obtained by the camera unit for later recall and processing	<b>Definition:</b> The function is to process an image captured by the camera unit and to store at least a portion of the processed image information in said at least one memory unit of said camera unit for later recall. The structure is the image processing unit and memory unit or equivalents thereof.	'078 Patent, claim 73

<b>Term</b>	<b>Definition</b>	<b>Patent and Claim(s) Where Term Appears</b>
rejection message	<b>Definition:</b> a single communication sufficient to cause the base station to “immediately release the incoming call.”	‘075 Patent, claims 5, 6 and 10
the wireless system is to immediately release the incoming call on the communication channel between the mobile phone and the remote transceiver	<b>Definition:</b> the wireless system must, without requiring any additional action by or communication from the mobile phone, “release the incoming call on the communication channel between the mobile phone and remote transceiver.”	‘075 Patent, claims 5, 6 and 10
actuator	<b>Definition:</b> functional element that controls the flow of energy.	‘075 Patent, claim 6
processing items available to the user	<b>Definition:</b> actions available to the user for controlling a call into a desired connecting state.	‘068 Patent, claims 23 and 24
listing said processing items	<b>Definition:</b> the processing items are grouped together in an orderly fashion.	‘068 Patent, claims 23 and 24
displaying said processing items on said display when	<b>Definition:</b> processing items are displayed in response to	‘068 Patent, claims 23 and 24

If I have not provided a specific definition for a given term, you are to use the ordinary meaning of that term.

## **MEANS-PLUS-FUNCTION CLAIM LIMITATIONS**

Claim 73 of the '078 patent uses the phrase “means for . . . .” This “means for” phrase has a special meaning in patent law. It is called a “means-plus-function” limitation. It does not cover all of the structures that could perform the function set forth in the claim. Instead, it covers a structure or set of structures that performs the function and that is either identical or “equivalent” to at least one of the structures described in the patent for performing that function.

When I read you my definitions for certain claim terms a few moments ago, I identified the structures described in the '078 patent for performing the corresponding functions. You should apply my definition of the functions and the structures described in the '078 patent as you would apply my definition of any other claim term.

## **PATENT INFRINGEMENT**

### **OVERVIEW**

A patent owner has the right to stop others from using the invention covered by its patent claims during the life of the patent. If any person makes, uses, sells (within the United States), offers to sell (within the United States), or imports what is covered by the patent claims without the patent owner's permission, that person is said to infringe the patent.

In this case, MobileMedia alleges that Apple's accused products directly infringe the asserted claims. MobileMedia also asserts that Apple induces its customers to infringe the asserted claims.

You must decide whether or not MobileMedia has proven, by a preponderance of the evidence, that Apple has made, used, sold (within the United States), or offered for sale (within the United States) a product covered by any of the claims at issue in this case. If Apple infringes one claim of any patent-in-suit, then Apple infringes that patent. Apple's knowledge or intent to infringe is not relevant to whether Apple directly infringes the asserted claims, but is relevant to whether Apple indirectly infringes by inducing customers to infringe.

## **DIRECT INFRINGEMENT BY LITERAL INFRINGEMENT**

In order to prove direct infringement, MobileMedia must prove that each limitation of the asserted claims is present in the accused product. A claim limitation may be present in an accused product in one of two ways: either literally or under the “doctrine of equivalents.” In this case, the only issue is whether the limitations of the asserted claims are literally in the accused products.

A claim limitation is literally present if it exists in the accused product just as it is described in the claim language, either as I have explained that language to you or, if I did not explain it, as you understand its plain and ordinary meaning.

Literal infringement must be determined with respect to each asserted claim individually by comparing the elements or features of the accused product to each of that claim’s limitations. For an apparatus claim, MobileMedia must prove that each and every component is present in the accused product. For a method claim, MobileMedia must prove that Apple practices each and every step of the claimed method. If the accused product omits any single limitation recited in a given claim, then you must find that Apple has not infringed that claim. You must determine infringement with respect to each asserted claim and each accused product individually.

In determining whether any accused product literally infringes any asserted claim, you should take the following steps:

First, you should determine the meaning of the asserted claim by reading the claim language, limitation by limitation, as those limitations have been construed by the court or, if they have not been specifically construed by the Court, according to their ordinary meaning; and



Second, you should compare the accused product, element by element or feature by feature, to each of the limitations of the asserted claim.

If you find each and every limitation of the asserted claim in the accused product, you must return a verdict of literal infringement as to that claim.

If you did not find each and every limitation of the asserted claim in the accused product, you must not return a verdict of literal infringement as to that claim.

You must repeat the above analysis with every asserted claim. There is one exception to this rule. If you find that an independent claim 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 the product or method meets the additional requirements of any claims that depend from the independent claim, thus, whether those dependent claims have also been infringed.

## **DIRECT INFRINGEMENT BY LITERAL INFRINGEMENT OF MEANS-PLUS-FUNCTION CLAIMS**

As I have previously explained, claim 73 of the '078 patent includes requirements that are written in means-plus-function form.

In order to prove direct infringement of a means-plus-function limitation of an asserted claim, MobileMedia must prove that: (1) the accused product has a structure or a set of structures that performs the identical function recited in the claim; and (2) consistent with the court's claim constructions, that structure or set of structures is identical or equivalent to the described structure that I defined as performing the functional limitation.

If the accused product does not perform the specific function recited in the claim, the "means-plus-function" requirement is not met, and the product does not literally infringe the claim.

## **INDIRECT INFRINGEMENT – INDUCING PATENT INFRINGEMENT**

In addition to direct infringement, MobileMedia asserts that Apple induces the infringement of certain asserted claims.

Apple induces patent infringement if it purposefully causes, urges or encourages another to infringe a patent. Inducing infringement cannot occur unintentionally. This is different from direct infringement which, as I have told you, can occur unintentionally. To have a specific intent to infringe, Apple must know that the acts it encourages constitute patent infringement. In order to prove inducement, MobileMedia must prove four things by a preponderance of the evidence:

First, that Apple encouraged or instructed one or more of its customers on how to use the accused products in a manner that you, the jury, find infringes the asserted claims.

Second, that Apple knew of the patents-in-suit at that time.

Third, that Apple knew at that time that its encouragement or instructions would result in its customers infringing the patents-in-suit.

Fourth, that at least one of Apple's customers infringed the patents-in-suit.

You may find that Apple induced patent infringement only if you are persuaded that each of these four factors is met.

## **VALIDITY**

### **INTRODUCTION**

As I stated previously, Apple contends that the asserted claims are invalid. I will now explain to you each of the grounds for invalidity that were presented by Apple at trial. Apple must meet its burden of proof on only one ground in order to invalidate a claim. In making your determination as to invalidity, you should consider each claim separately.

## **AFFIRMATIVE DEFENSE OF INVALIDITY GENERALLY**

For a patent to be valid, the invention claimed in the patent must be new, useful, and nonobvious. The terms "new," "useful," and "nonobvious" have special meanings under the patent laws. I will explain these terms to you as we discuss Apple's grounds for asserting invalidity.

Apple has challenged the validity of the asserted claims on a number of grounds. The patents-in-suit were granted by the Patent and Trademark Office or "PTO," and Apple bears the burden of overcoming the assumption that the PTO has correctly done its job. In this regard, you may consider such factors as whether the prior art references relied on by Apple for its invalidity defenses were considered by the PTO and whether the patent claim was reexamined by the PTO. Keep in mind, however, that you have an independent duty to examine the evidence presented at trial to determine whether Apple has met its burden of proving, by clear and convincing evidence, that the legal requirements for patentability were not met.

I will now explain to you Apple's grounds for invalidity in detail.

## **PRIOR ART**

As I stated previously, under the patent laws, a person can be granted a patent only if the invention claimed in the patent is new and not obvious in light of what came before. That which came before is referred to as the “prior art.”

Apple must prove, by clear and convincing evidence, that these items are prior art. In order to do so, Apple must prove that the items fall within the categories of prior art recognized by the patent laws, which include anything that was publicly known or used in the United States by someone other than the inventor before the inventor made the invention, or anything that was described in a printed publication anywhere in the world before the inventor made the invention, or more than one year before the application for the patent was filed.

Each patent in suit was filed on a different date. Therefore, you must decide whether the asserted claims are invalid in view of the prior art and the ordinary skill in the art as it existed as of a certain time. The parties agree to the following priority dates for the following patents

- May 19, 1994 for the '078 patent;
- May 19, 1998 for the '075 patent; and
- March 19, 1996 for the '068 patent.

The prior art relevant to each of Apple’s claims will be listed for you in connection with the instructions relating to that claim.

## INVALIDITY - ANTICIPATION

In order for someone to be granted a patent, the invention must actually be “new.” In general, inventions are new when they have not been made, used, or disclosed before. In this case, Apple contends that each of the following asserted claims is not new because it was anticipated by:

- Claims 23 and 24 of the '068 patent:
  - U.S. Patent No. 5,754,636 (“Bayless”) (Exhibit DTX 26).
- Claim 73 of the '078 patent:
  - Japanese Patent Publication No. H6-133081 (“Kyocera” or “Morita '081”) (Exhibits DTX 37 and DTX 70).

Invalidity by anticipation requires the presence in a single prior art reference of each and every limitation of the claim, either expressly or inherently, and that a person having ordinary skill in the art at the time of the invention could make and use the invention without undue experimentation based on the prior art reference. You should consider that which is expressly stated or present in the item of prior art, and also that which is inherently present. Further, anticipation requires that the prior art limitations themselves be arranged as in the claim; the claims cannot be treated as mere catalogs of separate elements, in disregard of the element-to-element relationships set forth in the claims. However, anticipation does not require the prior art reference to use the same language or terminology as the patent claim.

To prevail on its defense of invalidity by anticipatory art, Apple must prove, by clear and convincing evidence, that the asserted claims are anticipated by the prior art identified above.

## INVALIDITY – OBVIOUSNESS

Apple contends that the asserted claims are invalid because they are obvious.

Apple contends that each of the asserted claims is obvious in view of combinations of the following prior art with each other and/or with the knowledge of a person of ordinary skill in the art:

- Claims 5, 6, and 10 of the '075 patent:
  - European Telecommunication Standard - ETS 300 557: European Digital Cellular Telecommunications System (Phase 2); Mobile Radio Interface Layer 3 Specification, February 1995 (GSM 04.08) (Exhibit DTX 40);
  - European Telecommunication Standard - ETS 300 567: European Digital Cellular Telecommunications System (Phase 2); Call Waiting (CW) and Call Hold (HOLD) Supplementary Services - Stage 3, February 1995 (GSM 04.83) (Exhibit DTX 41); or
  - U.S. Patent No. 6,070,068 ("068 patent") (Exhibit JTX 5).
- Claims 23 and 24 of the '068 patent:
  - Bayless (Exhibit DTX 26).
- Claim 73 of the '078 patent:
  - Kyocera or Morita '081 (Exhibits DTX 37 and DTX 70); or
  - U.S. Patent No. 5,550,646 ("Lucent") (Exhibit DTX 209).

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. This is because granting patent protection to advances that would occur in the ordinary course, without real innovation, retards progress and may deprive prior inventions of their value or utility.



The issue is not whether the claimed invention would be obvious to you as a 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 the invention was made.

In arriving at your decision on the issue of whether or not the asserted claims would have been obvious to a person of ordinary skill in the art and, therefore, are invalid, you should first determine, the scope and content of the prior art. This means that you should determine what prior art was reasonably pertinent to the particular problems the inventor faced.

Prior art must be “analogous art” to be relevant to your consideration of obviousness. Analogous art may be art from the same field of endeavor. If the reference is not within the field of the inventors’ endeavor, it may still be considered if the reference is reasonably pertinent to the particular problem that the inventors faced.

You must next consider the differences, if any, between the prior art and each asserted claim. Although it is proper for you to consider differences between the claimed invention and the prior art, you should not focus on only the differences, because the test is whether the claimed invention as a whole would have been obvious over all of the asserted prior art.

Next, you are to determine the level of ordinary skill in the art to which the claimed invention pertained at the time the claimed invention was made. Factors to be considered in determining the level of ordinary skill in the pertinent art include:

- (1) The educational level of the inventor and of others working in the field;
- (2) The types of problems encountered in the art at the time of the invention;
- (3) The prior art patents and publications;

- (4) The activities of others;
- (5) Prior art solutions to the problems encountered by the inventor; and
- (6) The sophistication of the technology.

A person of ordinary skill in the art is presumed to have knowledge of the relevant prior art at the time of the claimed invention. If you find that the available prior art shows each of the limitations of the asserted claims, you must determine whether it then would have been obvious to a person of ordinary skill in the art to combine or coordinate these limitations in the same manner as the asserted claims. This is often referred to as “motivation to combine.” You may consider whether a person of ordinary skill in the art would have had motivation to combine the prior art references in the same manner as the asserted claims and would have had a reasonable expectation of success in doing so. A teaching, motivation, or suggestion to combine references may be a helpful insight, but it is not a requirement for demonstrating obviousness.

In determining whether the asserted claims would have been obvious to a person of ordinary skill in the art and, therefore, are invalid, you should not apply any rigid test or formula. Rather, you should use your common sense to determine whether the claimed invention was truly innovative, or merely a combination of known limitations to achieve predictable results.

In your analysis, you must be aware of the distortion caused by hindsight bias, that is, of relying upon a hindsight combination of the prior art. Rather, you must cast your mind back to the time of the invention and consider whether the invention as a whole would have been obvious to a person of ordinary skill in the art, taking into consideration any interrelated teachings of the prior art, the effects of demands known

to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine any known elements in the fashion claimed by the patents-in-suit.

To prevail on its defense of invalidity by obviousness to a person of ordinary skill in the art at the time the inventions of the patents-in-suit were made, Apple must prove, by clear and convincing evidence, that the asserted claims of the patents-in-suit were obvious in view of the prior art identified above.

## **DELIBERATION AND VERDICT**

### **INTRODUCTION**

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 will 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 the juror seated in the first seat, first row.

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

## **UNANIMOUS VERDICT**

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

Your verdict must be unanimous.

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

A form of verdict has been prepared for you. The verdict form asks you a series of questions about the parties' claims. Unless you are directed otherwise in the form of the verdict, you must answer all of the questions posed, and you all must agree on each answer. When you have reached a unanimous agreement as to your verdict, you will return your verdict to the courtroom 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 what verdict I think you should find. What the verdict shall be is the sole and exclusive duty and responsibility of the jury.

## **DUTY TO DELIBERATE**

Now that all the evidence is in and the arguments are completed, you are free to talk about the case in the jury room. In fact, it is your duty to talk with each other about the evidence and to make every reasonable effort you can to reach a 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 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.

If any member of the jury took notes, let me remind you that notes are not given any greater weight than the memory or impression of each juror as to what the testimony may have been. Whether you took notes or not, each of you must form and express your own opinion as to the facts of the case.

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.

We generally end our business day at 4:30 p.m. If we do not hear from you by 4:30, I will be sending you a note to see whether you are close enough to a verdict to want to deliberate after 4:30 or whether you are going to recess for the evening and resume your deliberations on the next business day. You will need to respond in writing

to that question.

I am going to remind you now, if you go home this evening and resume your deliberations on the next business day, you are not to talk about the case among yourselves or with anyone else during the evening recess. You may not read or listen to any news about the case in a newspaper, online or on television during the evening recess.

You may talk about the case only while you are in the jury room and everyone on the jury is present. Unless I hear from you that you have a different schedule in mind, I will expect you all to come back the next business day at 9:30. You are not to start deliberating until you are all present in the jury room and participating together.

Because the lawyers have to make themselves available to respond to questions or receive the verdict, I generally give them between 12:30 and 1:30 to step away from the phone. So whenever you are deliberating over the lunch hour, let me remind you, if you ask a question during this time, you probably will not get an answer right away because we are all going to be stepping away from our phones.

### **COURT HAS NO OPINION**

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.

Finally, if I have read any of these instructions inconsistently with the written text, you are to rely on the written instructions in your deliberations.