

EXHIBIT A

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

BRIGHT RESPONSE, LLC

v.

GOOGLE INC., et al.

NO. 2:07-CV-371-CE

JURY

**BRIGTH RESPONSE, LLC'S PROPOSED [POST-TRIAL] JURY INSTRUCTIONS
FILED ON JULY 19, 2010 CONCURRENTLY
WITH JOINT FINAL PRE-TRIAL ORDER**

Plaintiff's Bright Response, LLC files these revised proposed jury instructions on July 19, 2010 in compliance with the Court's Docket Control Order, as amended per Dkt. No. 385 and after exchanging a, earlier draft version of its proposed jury instructions and verdict form with Defendants on July 15, 2010, also pursuant to the Court's Amended Docket Control Order. Bright Response reserves the right to revise, supplement, and amend these instructions as the case progresses through and after the pre-trial conference on July 28, 2010 and as evidence is presented at trial.¹

¹ Plaintiff's submission is based primarily on (i) AIPLA's Model Patent Jury Instructions (2008); (ii) the American Bar Association Model Jury Instructions for Patent Litigation (2005); and the Model Patent Jury Instructions of The National Jury Instruction Project (2009). Where reference to case law is necessary to inform a particular instruction, it is so noted.

MEMBERS OF THE JURY:

You have heard the evidence in this case. I will now instruct you on the law that you must apply. It is your duty to follow the law as I give it to you. As the Judge, I will decide all questions of law and procedure. On the other hand, you the jury are the judges of the facts. Do not consider any statement that I have made during the trial or make in these instructions as an indication that I have any opinion about the facts of this case. After I instruct you on the law, the attorneys will have an opportunity to make their closing arguments. Statements and arguments of the attorneys are not evidence and are not instructions on the law. They are intended only to assist you the jury in understanding the evidence and the parties' contentions.

1. GENERAL INSTRUCTIONS

You will be provided with copies of a verdict form. You must answer each and every question on that form unless the verdict form instructs you to skip a question. Do not decide who you think should win and then answer the questions accordingly. Answer each question from the facts as you find them.

1.1 Considering witness testimony

By the Court allowing testimony or other evidence to be introduced over the objection of an attorney, the Court did not indicate any opinion as to the weight or effect of such evidence. As stated before, you the jurors are the sole judges of the credibility of all witnesses and the weight and effect of all evidence.

When the Court sustained an objection to a question addressed to a witness, the jury must disregard the question entirely, and may draw no inference from the wording of it or speculate as to what the witness would have testified to, if he or she had been permitted to answer the question.

At times during the trial it was necessary for the Court to talk with the lawyers here at the bench out of your hearing, or by calling a recess. We met because often during a trial something comes up that does not involve the jury. You should not speculate on what was discussed during such times.

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 concerning 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 the witness gave before you during the trial.

You should keep in mind, of course, that a simple mistake by a witness does not necessarily mean that the witness was not telling the truth as he or she remembers it, because people may forget some things or remember other things inaccurately. So if a witness has made a misstatement, you need to consider whether that misstatement was an intentional falsehood or simply an innocent lapse of memory; and the significance of that may depend on whether it has to do with an important fact or with only an unimportant detail.

1.2 How to examine the evidence

You must make your decision based only on the evidence in this case. The evidence in this case includes only what the witnesses said while they were testifying under oath, the exhibits that I allowed into evidence, any stipulations that the lawyers may have agreed to, and any facts that I may have instructed you to take as true.

Nothing else is evidence. The lawyers' questions, objections, statements, and arguments are not evidence. My legal rulings are not evidence. Any of my comments and questions are not evidence. You should use your common sense in weighing the evidence. Consider the evidence

in light of your everyday experience and give it whatever weight you believe it deserves. The testimony of a single witness may be sufficient to prove any fact, even if a greater number of witnesses may have testified to the contrary, if after considering all the other evidence you believe that single witness. In determining whether any fact has been proved in this case, you may, unless otherwise instructed, consider the testimony of all witnesses, regardless of who may have called them, and all exhibits received in evidence, regardless of who may have produced them

During the course of this trial, you heard evidence about the nature of Bright Response's business activities and how Bright Response acquired United States Patent No. 6,411,947 (the "Rice patent"), also referred to during the trial as the Rice patent. That evidence is in no way relevant to whether Yahoo, Google and AOL have infringed the patent or whether the patent is valid. A patent is either valid and infringed, or it is not, regardless of who owns it or how it was acquired.

1.3 Witnesses

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

When specialized knowledge or experience about a particular matter may be helpful to the jury, a person who has special training or experience in that technical field—called an expert witness—may state his opinion on those matters. You need not accept the opinion of any of these expert witnesses. As with any other witness, you are free to decide whether to rely upon that testimony.

In deciding whether to accept or rely upon the opinion of an expert witness, you may consider any bias of the witness, including any bias you may infer from evidence that the expert witness has been or will be paid for reviewing the case and testifying.

1.4 Burdens of Proof

Bright Response has the burden of proving infringement and damages regarding the Rice patent by what is called “preponderance of the evidence.” That means Bright Response has to produce evidence which, when considered in light of all the facts, leads you to believe that what Bright Response claims is more likely true than not. To put it differently, if you were to put Bright Response’s evidence on one side of a scale, and Google’s evidence or Yahoo’s evidence or AOL’s evidence on the opposite side of a scale, the evidence supporting Bright Response’s claims would have to make the scales tip on Bright Response’s side. If you believe that Bright Response has met its burden of proving patent infringement and damages by a preponderance of the evidence, you must find in favor of Bright Response for the Rice patent. If you believe that Bright Response has not met its burden of proof for the Rice patent as to Google, Yahoo, or AOL, you must find in favor of Google, Yahoo, or AOL.

Bright Response must prove willful infringement by “clear and convincing evidence.” Clear and convincing evidence is a higher standard of proof and 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 of proof than proof by a preponderance of the evidence.

A patent is presumed to be valid. In this case, the Defendants, Google, Yahoo, and AOL contends that the asserted claims of the Rice patent are invalid. Accordingly, Defendants have the burden of proving that each of the asserted claims of the Rice patent are invalid by clear and

convincing evidence. Therefore, for Defendants, you must be persuaded that it is highly probable that what Google, Yahoo, and AOL seek to prove is true. If you believe that Google, Yahoo, and AOL have met their burden of proving patent invalidity by clear and convincing evidence, you must find in favor of Google, Yahoo, or AOL. If you believe that Google, Yahoo or AOL have not met their burden of proof by producing clear and convincing evidence, you must find in favor of Bright Response on the issue of validity.

Those of you who are familiar with the law in 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 Bright Response, or Google, Yahoo, or AOL has met its burden of proof.

2. CONTENTIONS OF THE PARTIES

Bright Response contends that Google makes, uses, offers to sell, sells, or imports a product—the AdWords system—that infringes claims 28, 30, 31, 33 and 38 of the Rice patent. Bright Response asks you to award damages for the infringement. I may in these instructions refer to Google’s AdWords system as “the Google Accused Product” or “Google’s Accused Product.”

Bright Response contends that Yahoo! makes, uses, offers to sell, sells, or imports a product—Sponsored Search—that infringes claims 28, 30, 31, 33 and 38 of the Rice patent. Bright Response asks you to award damages for the infringement. I may in these instructions refer to Yahoo! Sponsored Search as “the Yahoo Accused Product” or “Yahoo’s Accused Product.”

Bright Response contends that AOL makes, uses, offers to sell, sells, or imports a product—referred to in this case as Search Marketplace/Sponsored Links—that infringes claims

28, 30, 31, 33 and 38 of the Rice patent. Bright Response asks you to award damages for the infringement. I may in these instructions refer to AOL's "Search Marketplace/Sponsored Links" as "the AOL Accused Product" or "AOL's Accused Product."

Defendants Google, Yahoo, and AOL denies that they are infringing the claims of the Rice patent. Google, Yahoo, and AOL contends that claims 28, 30, 31, 33 and 38 of the Rice patent are invalid.

Your job is to decide whether the asserted claims of the Rice patent have been infringed and whether any of the asserted claims of the Rice patent are invalid. If you decide that any claim of the patent has been infringed and is not invalid, you will then need to decide any money damages to be awarded to Bright Response as compensation for the infringement.

3. CLAIMS OF THE PATENT IN SUIT

3.1 Claim Construction Generally

Before you decide whether the Google, or Yahoo, or AOL have infringed the claims of Bright Response's patent or whether the claims of Bright Response's patent are invalid, you will have to understand the patent claims. The patent claims are numbered sentences at the end of the patent. The patent claims involved here are 28, 30, 31, 33, and 38. The claims are intended to define, in words, the boundaries of the invention. Only the claims of the patent can be infringed. You must use the same claim meaning for your decision on infringement and for your decision on invalidity.

Patent claims may exist in two forms, referred to as independent claims and dependent claims. An independent claim does not refer to any other claim of the patent. Thus, it is not necessary to look at any other claim to determine what an independent claim covers. Claim 26 of the Rice patent, for example, is an independent claim.

3.2 Construction of the Claims for this Case

In deciding whether or not an accused product infringes a patent, the first step is to understand the meaning of the words used in the patent claims. As I stated earlier, it is my job as judge to provide to you the meaning of any claim language that must be interpreted. You must accept as correct the meanings I give you and use them when you decide when any claims of the patent has been infringed and whether any claim is invalid. The following chart includes the meanings that you must give to these words or groups of word of the Rice patent in determining both infringement and invalidity. The words that I have interpreted or that have been agreed upon by the parties—and which you must use in determining both infringement and invalidity—are in bold type on the left-hand column, with the construction in the right-hand column.

Term	Construction
“rule base . . . knowledge engine”	“a knowledge engine that tests whether one or more conditions are met and, if so, applies specified actions”
“a case model of the electronic message” / “the case model”	“text and attributes derived from the electronic message”
“wherein each score is normalized by dividing the score by a maximum possible score for the stored case model”	“wherein each match score is divided by the maximum possible score for the stored case model”
“fixed data”	“data in a predetermined arrangement”
“variable data”	“data in any arrangement”
Order of steps in claim 26	The steps must be performed in order, i.e., step (a) before step (b) and step (b) before step (c)
“non-interactive electronic message”	“an electronic message in which the sender does not provide any additional information after the message has been received”

“case base knowledge engine”:	“a knowledge engine that processes electronic messages by comparing them to a stored set of exemplar cases”
“predetermined response”	“responses prepared prior to the receipt of the electronic message. The responses may be modified and/or altered based on the interpretation of the electronic message”
“repository”	“a place where data is stored”
“requiring assistance from a human operator”	“requiring that a manual reviewer review the electronic message or information derived from the electronic message, or review, revise or compose the response to be delivered to the source”
“predetermined match weight” / “predetermined mismatch weight”	“a predetermined factor which arithmetically decreases a stored case model’s match score when a feature from the stored case model does not match text and attributes from the presented case model”

You should give the rest of the words in the claims, the ones that are not interpreted above, their plain English, ordinary meaning in the context of the patent specification and prosecution history. A copy of this table also is included as Appendix A at the end of these instructions.

4. INFRINGEMENT

The verdict form that you have been given asks you to find whether Google infringed claims 28, 30, 31, 33, and 38 of the Rice patent; whether Yahoo infringed claims 28, 30, 31, 33, and 38 of the Rice patent; and whether AOL infringes claims 28, 30, 31, 33, and 38 of the Rice patent. Patent law gives the owner of a valid patent the right to exclude and stop others from importing, making using, offering to sell, or selling the patented invention with the United States during the term of the patent. A patent is infringed when a person or business entity makes, uses,

offers for sale, or sells within the United States any product or system that is covered by at least one claim of the patent.

4.1 Direct Infringement - Generally

The type of infringement that Bright Response is asserting against Google, Yahoo and AOL is direct infringement. A patent claim may be directly infringed in two ways. A claim may be “literally” infringed or it may be infringed under the “doctrine of equivalents.” I will now instruct you as to the rules you must follow to determine whether Bright Response has proven that Google, or Yahoo, or AOL directly infringed any of the claims of the Rice patent.

4.2 Direct Infringement – Knowledge of Patent or Intent to Infringe is Immaterial

As I have instructed you above, Bright Response is asserting that Google, Yahoo and AOL directly infringed the asserted claim of the Rice patent. Bright Response must prove this direct infringement claim by a preponderance of the evidence—that it is more likely than not that Google, or Yahoo, or AOL infringed any of the asserted claims of the Rice patent. Someone can directly infringe a patent without knowing that what they are doing is an infringement of the patent. They also may directly infringe a patent even though they believe in good faith that what they are doing is not an infringement of any patent. Thus, it is irrelevant that Google, or Yahoo, or AOL did not know that they were infringing a claim of the Rice patent, or that Google, or Yahoo, or AOL believed in good faith that what they were doing was not infringement of any patent.

4.3 Direct Infringement – Literal Infringement

Only the claims of a patent can be infringed. You must compare each of the asserted patent claims, as I have defined them, to the Yahoo Accused Product, to the Accused Google Products, and to the AOL Accused Product to determine whether or not there is infringement.

You should not compare Yahoo's Accused Product or Google's Accused Product or AOL's Accused Product with any specific example set out in the patent. The only correct comparison is with the language of the claim itself, with the meaning I have given you.

You must consider each claim individually and must reach your decision as to each assertion of infringement based on my instructions about the meaning and scope of the claims, the legal requirements for infringement, and the evidence presented to you by the parties.

Thus, to determine infringement as to Yahoo, you must compare Yahoo's Accused Product with each claim that Bright Response asserts is infringed, using my instructions as to the meaning of the patent claims. To determine infringement as to Google, you must compare Google's Accused Product with each claim that Bright Response asserts is infringed, using my instructions as to the meaning of the patent claims. To determine infringement as to AOL, you must compare AOL's Accused Product with each claim that Bright Response asserts is infringed, using my instructions as to the meaning of the patent claims.

A patent claim is infringed by Yahoo if Yahoo's Accused Product includes each and every element in that patent claim. If Yahoo's Accused Product does not contain one or more of the limitations recited in a claim, Yahoo does not literally infringe that claim. If you find that Yahoo's Accused Product includes each element or step of the claim, Yahoo infringes the claim even if Yahoo performs additional elements or steps that are not recited in the claim. Yahoo's Accused Product should be compared to the limitations recited in the patent claim, not to any preferred or commercial embodiment of the claimed invention. Likewise, a patent claim is infringed by Google if Google's Accused Products include each and every element in that patent claim. If one of Google's Accused Products does not contain one or more of the limitations recited in a claim, Google does not literally infringe that claim. If you find that Google's

Accused Product includes each element or step of the claim, then Google infringes the claim even if Google performs additional elements or steps that are not recited in the claim. Google's Accused Product should be compared to the limitations recited in the patent claim, not to any preferred or commercial embodiment of the claimed invention. Additionally, a patent claim is infringed by AOL if AOL's Accused Product includes each and every element in that patent claim. If AOL's Accused Product does not contain one or more of the limitations recited in a claim, then AOL does not literally infringe that claim. If you find AOL's Accused Product includes each element or step of the claim, then AOL infringes the claim even if AOL performs additional elements or steps that are not recited in the claim. AOL's Accused Product should be compared to the limitations recited in the patent claim, not to any preferred or commercial embodiment of the claimed invention.

4.4 Infringement of Dependent Claims

As I mentioned earlier, there are two different types of claims in the Rice patent. One type of claim is called an independent claim. The other type of claim is called a dependent claim. A dependent claim refers to at least one other claim in the patent. A dependent claim includes each element of the other claim or claims to which it refers as well as the additional elements recited in the dependent claim itself. Therefore, to determine what a dependent claim covers, it is necessary to look at both the dependent claim and the other claim or claims to which it refers. In other words, a dependent claim includes each of the requirements of the independent claim to which it refers, and one or more additional requirements. All of the claims asserted in this case, claims 28, 30, 31, 33 and 38 are dependent claims. They each depend on claim 26. In order to find infringement then of a dependent claim, you must first determine whether independent claim 26 of the Rice patent has been infringed. If you decide that the independent

claim has not been infringed, then the depend claim cannot have been infringed. If you decide that the independent claim has been infringed, you must then separately determine whether each additional requirement of the dependent claim is also included in the accused product. If each additional requirement has been included, then the dependent claim has been infringed.

4.5 Direct Infringement – Infringement under the Doctrine of Equivalents

If you decide that Google’s Accused Product (the AdWords system), or Yahoo’s Accused Product (Sponsored Search), or AOL’s Accused Product (Search Marketplace/Sponsored Links) do not literally infringe an asserted patent claim, you must then decide whether those Accused Products infringe any of the asserted claims under what is called the “doctrine of equivalents.”

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

A claim requirement is present in an Accused Product under the doctrine of equivalents if the difference between the claim requirement and a corresponding aspect of the accused product is insubstantial.

In making this determination of whether any difference between a claim requirement and each of the Accused Products is insubstantial, you may consider whether, as of the time of infringement the part of the Accused Product performed substantially the same function, in

substantially the same way, to achieve substantially the same result as the requirement in the patent claim. You may also consider whether, at the time of the alleged infringement, persons of ordinary skill in the art would have known of the interchangeability of the part of the Accused Product with the claimed requirement in the patent claim. It is not necessary in finding infringement under the doctrine of equivalents that those of ordinary skill in the art knew of the equivalent, or interchangeability at the time the patent application was filed or when the patent was issued. The proper time for determining equivalency—and thus knowledge of interchangeability between requirements—is the time of infringement, not the time the patent issued. Thus, the inventor need not have foreseen, and the patent need not describe, all potential equivalents to the invention covered by the claims. Additionally, changes in technique or improvements made possible by technology developed after the patent application is filed may still be the equivalent for purposes of the doctrine of equivalents.

5. INVALIDITY

An issued patent is presumed to be valid based on the presumption that the United States Patent and Trademark Office acted correctly in issuing a patent. Defendants contends that the asserted claims of the Rice patent are invalid. Defendants must prove their contentions of invalidity by clear and convincing evidence. Defendants contend that all of the asserted patent claims are invalid because the claimed invention is not “new,” is “obvious,” or lacks an adequate written description as those terms are understood under patent law. I will now instruct you in more detail on these reasons that Defendants contend the asserted claims are invalid, including the concept of “prior art,” which is part of Defendants’ contentions for why the asserted claims of the Rice patent are invalid.

5.1 Prior Art Defined²

A person cannot obtain a patent if someone else already has made an identical invention. Simply put, the invention must be new and unobvious in light of what came before. That which came before is referred to as “prior art.” Defendants are relying on various items of prior art. Defendants must prove that the items they contend are prior art fall within one or more of the different categories recognized under the patent laws. These categories include:

First, anything that was publicly known or used in the United States by someone other than the inventor before the inventor made the invention;

Second, anything that was in public use or on sale in this country more than one year before the application for the patent was filed;

Third, anything that was patented or 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;

Fourth, anything that was invented by another person in this country before the inventor made the invention, if the other person did not abandon, suppress or conceal his or her prior invention;

Fifth, anything that was described in a patent that issued from a patent application filed in the United States or certain foreign countries before the inventor made the invention.

5.2 Prior Art – Prior Public Use or Knowledge

The prior public use of a claimed invention may be prior art to the patent claims under two different circumstances. The first is where the invention was publicly known or used by someone other than the inventor before the date of invention by the inventor on the patent. The

² AIPLA Model Patent Jury Instructions (2008) 5.0 at p. 20.

second is where the inventor, the patent owner, or anyone else publicly used the invention more than one year before the application was filed.

In both circumstances, the public use must have been in the United States. Prior public use or knowledge of the claimed inventions outside the United States is not prior art to a patent claim.

Use or knowledge by someone other than the inventor may be prior art if it was before the date of invention by the inventor on the patent, or more than one year before the filing of the application for the patent. In either case, a prior use by someone other than the inventor or the patent owner will not be prior art unless it was public. Private or secret knowledge or use by another is not prior art.

A prior use more than one year before the application filing date by the inventor or the patent owner will be prior art if it was for commercial purposes, even if it was done in secret.

In this case Defendants rely on [insert] as a prior public use or knowledge before the inventor's date of invention, and Defendants rely on [insert] as a prior public use more than one year before the filing date of the application for the Rice patent.

For purposes of these instructions, the filing date for the application for the Rice patent is April 3, 1997.

5.2 Anticipation

A person cannot obtain a patent on an invention if someone else has already made the same invention. In other words, the invention must be new. If an invention is not new, it is "anticipated." An invention that is "anticipated" by the prior art is not entitled to patent protection. Defendants must prove with clear and convincing evidence that the claimed invention is not new.

In order for a patent claim to be anticipated by the prior art, each and every limitation of the claim must be present within a single item of prior art—whether that prior art is a publication, a prior patent, a prior invention, a prior public use or sale, or some other item of prior art. I have given you instructions on the different types and categories of prior art on which Defendants are relying.³ You may not find that the prior art anticipates by combining two or more items of prior art. In determining whether every one of the elements of the claimed invention is found in the single item of prior art, you should take into account what a person of ordinary skill in the art would have understood from his or her examination of that single item of prior art.

A printed publication or patent will not be an anticipation unless it contains a description of the invention covered by the patent claims that is sufficiently detailed to teach a skilled person how to make and use the invention without undue experimentation. That means that a person skilled in the field of the invention reading the printed publication or patent would be able to make and use the invention using only an amount of experimentation that is appropriate for the complexity of the field of the invention and for the level of expertise and knowledge of persons skilled in that field.

In determining whether the single item of prior art anticipates a patent claim, you should consider that which is expressly stated or present in the item of prior art, and also that which is inherently present. Something is inherent in an item of prior art if it is always present in the prior art or always results from the practice of the prior art. You should also consider whether a person of ordinary skill in the art at the time would understand that to be the case.

³ Bright Response reserves the right, based on how the Court rules on pending motions and how the case develops at trial, to request in greater detail the instructions necessary to properly instruct the jury as to specific categories of anticipatory prior art under 35 U.S.C. § 102.

5.2.5 Experimental Use

Bright Response contends that certain items of prior art on which Defendants rely cannot be considered prior art as a prior public use that anticipates because that prior public use of the invention was experimental. The law recognizes that the inventor must be given the opportunity to develop the invention through experimentation. Certain activities are experimental if they are a legitimate effort to perfect the invention or to determine if the invention will work for its intended purposes. So long as the primary purpose is experimentation, it does not matter that the public used the invention or that the inventor incidentally derived profit from it. If you find that Defendants have shown a prior public use by clear and convincing evidence, then the burden is on Bright Response to come forward with evidence showing that the purpose of the prior public use was experimental.

5.3 Invalidity - Obviousness

Under the patent laws, a person is entitled to a patent only if the invention claimed in the patent is not obvious to a person of ordinary skill in the field of the invention at the time it was made. The issue is not whether the claimed invention would have been 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. Defendants bear the burden of proving their obviousness defense by clear and convincing evidence. In determining whether or not Defendants have proven obviousness of a claim of the Rice patent, you must consider the following:

- (1) The scope and content of the prior art put into evidence in this case;
- (2) The differences, if any, between each claim of the patent and that prior art;
- (3) The level of ordinary skill in the art at the time the invention was made; and

- (4) Any objective indications of non-obviousness including certain secondary considerations, described below, which may give light to the circumstances surrounding the origination of the subject matter of the patent-in-suit.

You must not use hindsight when comparing the prior art to the invention for obviousness. In making a determination of obviousness or non-obviousness, you must consider only what was known before the invention was made. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. You may not judge the invention in light of present day knowledge or by what you learned from or about the patents during trial.

5.3.1 Scope and Content of the Prior Art

The first question you must answer in determining whether or not the invention was obvious is the scope and content of the prior art at the time the invention was made. The prior art includes the following items entered into evidence during the trial:

[Defendants to propose]

You must determine whether these specific references relied on by Yahoo, Google, and AOL in this case are prior art to the invention described in the asserted claims of the Rice patent. Once you decide whether or not those specific references are prior art, you also must decide what those references would have disclosed or taught to one having ordinary skill in the field of technology of the patent at the time the invention was made.

In order for a reference to be relevant for you to consider in deciding whether or not the claims of the Rice patent would have been obvious, the reference must be within the field of the inventors' endeavor or if it is from another field of endeavor, the reference must be reasonably

related to the particular problem or issue the inventors faced or addressed when making the inventions described in the asserted claims.

5.3.2 Differences Over the Prior Art

The second question you must answer in determining whether or not the invention was obvious at the time it was made is what differences there are between the prior art and the patented invention. In determining the differences between the invention covered by the patent claims and the prior art, you should not focus solely on the differences between the prior art and the invention because the test is not whether there are differences. You must consider the claimed invention as a whole and determine whether or not it would have been obvious to one having ordinary skill in view of the prior art at the time the invention was made.

In analyzing the relevance of the differences between the claimed invention and the prior art, you do not need to look for 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 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.

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 Defendants contend is obvious.

5.3.3 Level of Ordinary Skill in the Art

The third question for determining obviousness requires you to consider the perspective of a person of ordinary skill in the art. The ordinary skilled person is a person of average education and training in the field of the invention and is presumed to be aware of all relevant prior art. The actual inventor's skill is irrelevant to this inquiry.

5.3.4 Additional Considerations

[Bright Response reserves the right, as trial preparation continues and through trial, to adjust the factors that should be submitted for the jury's consideration.]

The fourth question you must answer in determining whether or not the invention was obvious at the time it was made is what evidence there is, if any, of additional considerations relating to the obviousness or non-obviousness of the invention. You may consider in your

analysis the presence or absence of the following factors in deciding whether or not the invention would have been obvious at the time it was made:

- (1) Whether or not the invention proceeded in a direction contrary to accepted wisdom in the field;
- (2) Whether or not there was long felt but unresolved need in the art that was satisfied by the invention;
- (3) Whether or not others had tried but failed to make the invention;
- (4) Whether or not others copied the invention;
- (5) Whether or not the invention achieved any unexpected results;
- (6) Whether or not the invention was praised by others;
- (7) Whether or not others have taken licenses to use the invention;
- (8) Whether or not experts or those skilled in the art at the making of the invention expressed surprise or disbelief regarding the invention;
- (9) Whether or not products incorporating the invention have achieved commercial success; and
- (10) Whether or not others having ordinary skill in the field of the invention independently made the claimed invention at about the same time the inventors made the invention.

5.4 Invalidity – Written Description

A patent must contain a written description of the process claimed in the patent. The written description requirement helps to ensure that the patent applicant actually invented the claimed subject matter. To satisfy the written description requirement, the patent must describe each and every limitation of a patent claim, in sufficient detail, although the exact words found in

the claim need not be used. The written description requirement is satisfied if a person or ordinary skill in the field reading the patent application as originally filed would recognize that the patent application described the invention as finally claimed in the patent. It is unnecessary to spell out every detail of the invention in the specification; only enough must be included to convince a person of skill in the art that the inventor possessed the full scope of the invention.

Defendants contend that the claims of the Rice patent are invalid for failure to satisfy the written description requirement. Defendants bear the burden of establishing lack of written description by clear and convincing evidence.

If you find that Defendants have proved by clear and convincing evidence that the Rice patent does not contain a written description of the invention covered by any of the claims, then you must find that the claim is invalid.⁴

6. DAMAGES

I have now instructed you as to the law governing Bright Response's claims of patent infringement and Yahoo's, Google's, and AOL's claims of invalidity. If you find that Yahoo has infringed a valid claim of the Rice patent, then you must determine what damages Yahoo must pay to Bright Response for that infringement. If, on the other hand, you find that Yahoo has not infringed any valid claim of the Rice patent, then Bright Response is not entitled to any damages from Yahoo, and you should not make any findings about damages for that claim as to Yahoo. Likewise, if you find that Google has infringed a valid claim of the Rice patent, then you must determine what damages Google must pay to Bright Response for that infringement. If, on the other hand, you find that Google has not infringed any valid claim of the Rice patent, then Bright Response is not entitled to any damages from Google, and you should not make any findings about damages for that claim as to Google. Similarly, if you find that AOL has infringed a valid

⁴ AIPLA Model Patent Jury Instructions, 9.0 (2008).

claim of the Rice patent, then you must determine what damages AOL must pay to Bright Response for that infringement. If, on the other hand, you find that AOL has not infringed any valid claim of the Rice patent, then Bright Response is not entitled to any damages from AOL, and you should not make any findings about damages for that claim as to AOL.

The fact that I am instructing you about damages does not mean that Bright Response is or is not entitled to recover damages. You should not interpret the fact that I have given instructions about Bright Response's damages as an indication in any way that I believe that Bright Response should, or should not, win this case. I am instructing you on damages only so that you will have guidance in the event you decide that Yahoo, Google, and AOL are liable and that Bright Response is entitled to recover money from Yahoo, Google and AOL.

6.1 Damages - Generally

The type of patent damages Bright Response is seeking in this case is called a reasonable royalty. I will discuss reasonable royalty later in more detail. Generally, a reasonable royalty is defined by the patent laws as the reasonable amount that someone wanting to use the patented invention should expect to pay to the patent owner and the owner should expect to receive.

If you find that any claim of the Rice patent is infringed and not proven to be invalid, then Bright Response is entitled to damages adequate to compensate for the infringement of that claim. Your damages award, if you reach this issue, should put the patent holder, Bright Response, in approximately the same financial position that it would have been in had the infringement not occurred, but in no event may the damages be less than a reasonable royalty for the use made of the invention. You may not add anything to the amount of damages to punish Yahoo and Google and AOL or to set an example.

It is Bright Response's burden to persuade by a preponderance of the evidence that it suffered the damages it seeks. Bright Response must prove the amount of damages with reasonable certainty, but mathematical precision is not required. Although Bright Response is not entitled to damages that are remote or speculative, any uncertainty in the amount of damages, for example due to inaccurate or incomplete records, must be resolved against Yahoo, Google and AOL.

In this case, you should assess damages against Google beginning in July 2004. You should assess damages against Yahoo beginning in April 2004. And to assess damages against AOL, you should assess damages beginning in March 2006.

6.2 Reasonable Royalty

A royalty is a payment made to a patent holder in exchange for the right to make, use or sell, or offer to sell, the claimed invention. A reasonable royalty is the amount of money that a patent holder and the infringer would have agreed to in a hypothetical negotiation taking place at the time when the infringement first began. In considering this hypothetical negotiation, you should focus on what the expectations of the patent holder and the infringer would have been had they entered into an agreement at that time, and had they acted reasonably in their negotiations.

You must also assume that, unlike a real world negotiation, in this hypothetical negotiation, the patent holder and the infringer are presumed to know that the patent is infringed and valid. In addition, you must assume that patent holder and the infringer were willing to enter into an agreement. Your role is to determine what that agreement would have been. The measure of damages is what royalty would have resulted from the parties' hypothetical negotiation, and not simply what royalty either party would have preferred.

In this trial you have heard evidence of things that happened after the infringement began. That evidence can be considered to the extent that the evidence aids in your assessing what royalty would have resulted from a hypothetical negotiation. Such evidence that you may consider in assessing a reasonable royalty resulting from a hypothetical negotiation includes the negotiators' knowledge at the time of the hypothetical negotiation, based on their knowledge and experience, as well as future events, including future potential sales of the product and what those future sales actually were, that the negotiators would have found relevant to their negotiation.⁵

In making your determination of the amount of a reasonable royalty, it is important that you focus on the time period when Yahoo, Google, and AOL each first infringed the patent. Your determination does not depend on the actual willingness of the parties to this lawsuit to engage in such negotiations. The relevant parties for purposes of these hypothetical negotiations are, for purposes of determining a reasonable royalty for Yahoo's infringement or Google's infringement, a company called Orion IP, LLC ("Orion")—the company that owned the Rice patent at the time of the hypothetical negotiation. For purposes of determining a reasonable royalty for AOL's infringement of the Rice patent, the relevant parties are AOL and Polaris IP, LLC—which, as you have been instructed, is the previous name for the company, Bright Response, that currently owns all rights in the Rice patent. You must therefore assume for purposes of this question that (i) Orion and Yahoo were willing to enter into an agreement to license the Rice patent; (ii) that Orion and Google were willing to enter an agreement to license the Rice patent, and (iii) that Polaris IP, LLC and AOL were willing to enter into an agreement to

⁵ See *Fromson v. Western Litho Plate & Supply Co.*, 853 F.2d 1568, 1575-76 (Fed. Cir. 1988) (noting propriety of looking at post-infringement events for the reasonable royalty calculations—a concept often referred to as the "book of wisdom," a term that appears in *Sinclair Ref. Co. v. Jenkins Petroleum Process Co.*, 289 U.S. 689, 698-999 (1933)).

license the Rice patent. It is your role then to determine what that agreement would have been as between Orion and each of those parties, Google, Yahoo, and AOL.

Although evidence of the actual profits that Google, and Yahoo, and AOL made on their respective Accused Products may aid you in determining the anticipated profits at the time of the hypothetical negotiations, you may not limit or increase the royalty based on the actual profits that Google made on its AdWords system, or the actual profits that Yahoo made on its Sponsored Search, or the actual profits that AOL made with its Search Marketplace/Sponsored Links.

In determining the reasonable royalty, you should consider all the facts known and available to the parties at the time the infringement began. I will list for you a number of factors that you may consider. This list does not include every possible factor, but it will give you an idea of the kinds of things that normally prudent business people would consider in negotiating the hypothetical license.

- The royalties received by the patent-holder for the licensing of the patent in suit, proving or tending to prove an established royalty.
- Royalty rates paid by the licensee or others for the use of other patents comparable to the Rice patent.
- The portion of the profit or of the selling price that may be customary in the particular business or in comparable businesses to allow for the use of the invention or analogous inventions, or the portion of the realizable profit that should be credited to the invention as distinguished from non-patented elements, the manufacturing process, business risks, or significant features or improvements added by the infringer;

- The established profitability of the product made under the patent, its commercial success, and its current popularity; the utility and advantages of the patented property over the old modes or devices, if any, that had been used for working out similar results;
- The effect of selling the patented product in promoting sales of other products of the licensee, the existing value of the invention to the licensor as a generator of sales of its non-patented items; and the extent of such collateral sales.
- the nature of the patented invention; and the benefits to those who have used the invention;
- the extent to which the infringer has made use of the invention; and any evidence probative of the value of that use;
- any other factors which in your mind would have increased or decreased the royalty the infringer would have been willing to pay and the patent holder would have been willing to accept, acting as normally prudent business people;
- the opinion testimony of qualified experts as to what would be a reasonable royalty.

6.3 Laches

Defendants contend that Bright Response should be prevented from collecting certain damages in this suit because Bright Response unreasonably delayed in filing suit. The doctrine of “laches” may bar certain damages if: (1) Bright Response delayed filing suit for an unreasonable period of time, without any explanation for that delay, from the time Bright

Response knew or reasonably should have known of its claims against Google, AOL, or Yahoo; and (2) that the delay, if any, prejudiced Google, AOL or Yahoo.

In considering whether Bright Response's delay in filing suit was unreasonable, the period of time in question begins when Bright Response knew or should have known of the infringement and ends when Bright Response filed this lawsuit on August 27, 2007. You may consider any explanation for the delay, as a determination of what is reasonable is based on the facts and circumstances of this case.⁶

Google, Yahoo and AOL also must prove that any delay was prejudicial to them. Prejudice may be economic or evidentiary. Regardless of the type of prejudice, the prejudice must be material. Economic prejudice may arise if Google, Yahoo, or AOL proves it has suffered the loss of monetary investments or incurred damages that likely would have been prevented had Bright Response's lawsuit been filed earlier. It is not enough that Google, Yahoo, or AOL invested in their products or technology concerning their respective Accused Products. Any such investment or other change in their position, for example, in the marketplace must be because of and a result of the delay. Evidentiary prejudice also must be a material prejudice. It consist of some separate disadvantage resulting from the delay, such as loss of records or the unavailability of evidence, that prevents Google, Yahoo, or AOL from proving a defense.⁷

7. INSTRUCTIONS FOR DELIBERATIONS

You must perform your duties as jurors without bias or prejudice as to any party. The law does not permit you to be controlled by sympathy, prejudice, or public opinion. All parties expect that you will carefully and impartially consider all the evidence, follow the law as it is now being given to you, and reach a just verdict, regardless of the consequences.

⁶ *Gasser Chair Co., Inc. v. Infanti Chair Mfg. Corp.*, 60 F.3d 770, 773-74 (Fed. Cir. 1995).

⁷ *Hearing Components, Inc. v. Shure Inc.*, 600 F.3d 1357, 1376 (Fed. Cir. 2010).

It is your sworn duty as jurors to discuss the case with one another in an effort to reach agreement if you can do so. Each of you must decide the case for yourself, but only after full consideration of the evidence with the other members of the jury. While you are discussing the case, do not hesitate to re-examine your own opinion and change your mind if you become convinced that you are wrong. However, do not give up your honest beliefs solely because the others think differently, or merely to finish the case.

You should consider and decide this case as a dispute between persons of equal standing in the community, of equal worth, and holding the same or similar stations in life. A corporation or similar entity is entitled to the same fair trial as a private individual. All persons, including corporations, and other organizations stand equal before the law and are to be treated as equals. This is true in patent cases between corporations, partnerships, or individuals. A patent owner is entitled to protect its patent rights under the United States Constitution. This includes bringing suit in a United States District Court for money damages for infringement. This may be done regardless of whether the owner of the patent is an individual, a partnership, a limited liability company, a bank, a small company or a large company. The law recognizes no distinction among types of patent owners.

When you retire to the jury room to deliberate on your verdict, you may take this charge with you as well as exhibits which the Court has admitted into evidence. Select your Foreperson and conduct your deliberations. If you recess during your deliberations, follow all of the instructions that the Court has given you about your conduct during the trial. After you have reached your unanimous verdict, your Foreperson is to fill in on the form your answers to the questions. Do not reveal your answers until such time as you are discharged, unless otherwise

directed by me. You must never disclose to anyone, not even to me, your numerical division on any question.

Any notes that you have taken during this trial are only aids to memory. If your memory should differ from your notes, then you should rely on your memory and not on the notes. The notes are not evidence. A juror who has not taken notes should rely on his or her independent recollection of the evidence and should not be unduly influenced by the notes of other jurors. Notes are not entitled to any greater weight than the recollection or impression of each juror about the testimony.

If you want to communicate with me at any time, please give a written message or question to the bailiff, who will bring it to me. I will then respond as promptly as possible either in writing or by having you brought into the courtroom so that I can address you orally. I will always first disclose to the attorneys your question and my response before I answer your question.

After you have reached a verdict, you are not required to talk with anyone about the case unless the Court orders otherwise. You may now retire to the jury room to deliberate.

Exhibit A

Term	Construction
“rule base . . . knowledge engine”	“a knowledge engine that tests whether one or more conditions are met and, if so, applies specified actions”
“a case model of the electronic message” / “the case model”	“text and attributes derived from the electronic message”
“wherein each score is normalized by dividing the score by a maximum possible score for the stored case model”	“wherein each match score is divided by the maximum possible score for the stored case model”
“fixed data”	“data in a predetermined arrangement”
“variable data”	“data in any arrangement”
Order of steps in claim 26	The steps must be performed in order, i.e., step (a) before step (b) and step (b) before step (c)
“non-interactive electronic message”	“an electronic message in which the sender does not provide any additional information after the message has been received”
“case base knowledge engine”:	“a knowledge engine that processes electronic messages by comparing them to a stored set of exemplar cases”
“predetermined response”	“responses prepared prior to the receipt of the electronic message. The responses may be modified and/or altered based on the interpretation of the electronic message”
“repository”	“a place where data is stored”
“requiring assistance from a human operator”	“requiring that a manual reviewer review the electronic message or information derived from the electronic message, or review, revise or compose the response to be delivered to the source” ”

“predetermined match weight” / “predetermined mismatch weight”	“a predetermined factor which arithmetically decreases a stored case model’s match score when a feature from the stored case model does not match text and attributes from the presented case model”
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