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

BRIGHT RESPONSE, LLC	**NO. 2:07-CV-371-CE**
v.	**JURY**
GOOGLE INC., et al.	

BRIGHT RESPONSE REQUEST FOR REVISED JURY INSTRUCTIONS

Bright Response, LLC requests that the Court revise its reexamination question as follows:

You have heard evidence that the '947 patent was reexamined in a proceeding conducted by the United States Patent & Trademark office. During the first reexamination, claims 30, 31, and 33 were confirmed. Claims 30, 31, and 33 were found to have not raised substantial new questions of patentability. During reexamination the Patent and Trademark Office evaluates the validity of the patent claims in light of prior art patents and printed publications. The jury is not bound by any determinations in the reexamination proceedings. As you have been previously instructed, patents issued by the United States Patent and Trademark Office are entitled to a presumption of validity. That presumption continues to exists once the United States Patent & Trademark office concludes a reexamination proceeding.

_____Refused_____Modified _____Granted

8/7/10

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

BRIGHT RESPONSE, LLC F/K/A POLARIS IP, LLC v. GOOGLE INC., et al.	NO. 2:07CV-371-TJW-CE

GOOGLE AND YAHOO!'S REQUEST FOR A JURY INSTRUCTION REGARDING CLAIM CONSTRUCTION

Google and Yahoo! respectfully request that the Court charge the jury using Defendants' proposed claim constructions on the disputed claim terms briefed and argued during the *Markman* hearing in this matter for all of the reasons in Defendants' *Markman* briefs and argument at the *Markman* hearing. (*See* Dkt. 272, 275, 295.)

Approved
8/7/10

The Hon. Charles Everingham

DATED: August 7, 2010

Respectfully submitted,

By */s/ Brian A. E. Smith*

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Attorneys for Defendant Google Inc.

CERTIFICATE OF CONFERENCE

I hereby certify that a meet-and-confer took place on August ___, 2010 between at least _____. Plaintiff opposes Google's request.

/s/ Mansi H. Shah
Mansi H. Shah

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing document was filed electronically in compliance with Local Rule CV-5(a). As such, this motion was served on all counsel who are deemed to have consented to electronic service. Local Rule CV-5(a)(3)(A).

/s/ Mansi H. Shah
Mansi H. Shah

IN THE UNITED STATES DISTRICT COURT
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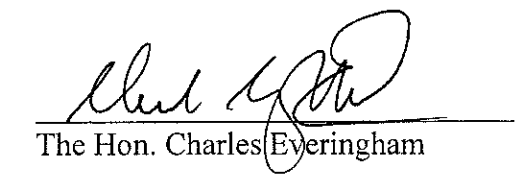
BRIGHT RESPONSE, LLC F/K/A POLARIS IP, LLC v. GOOGLE INC., et al.	NO. 2:07CV-371-TJW-CE

GOOGLE AND YAHOO'S REQUEST FOR A JURY INSTRUCTION ON THE BURDEN OF PERSUASION FOR INVALIDITY

Google and Yahoo! respectfully request that the Court charge the jury using Defendants' proposed jury instructions as to the burden of persuasion for invalidity as submitted to the Court on July 19, 2010. (*See* Dkt. 433.) Specifically, Defendants request that the Court instruct the jury to apply the preponderance of evidence standard to the question of invalidity, not the clear and convincing evidence standard.



The Hon. Charles Everingham

Refused
8/7/10

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

BRIGHT RESPONSE, LLC F/K/A POLARIS IP, LLC v. GOOGLE INC., et al.	NO. 2:07CV-371-TJW-CE

GOOGLE AND YAHOO'S REQUEST FOR A JURY INSTRUCTION ON GEORGIA-PACIFIC FACTORS

In determining the reasonable royalty, you should consider all the facts known and available to the parties at the time the infringement began. Some of the kinds of factors that you may consider in making your determination are:

(1) The royalties received by the patentee for the licensing of the patent in suit, proving or tending to prove an established royalty;
(2) The rates paid by the licensee for the use of other patents comparable to the patent in suit;
(3) The nature and scope of the license, as exclusive or non-exclusive; or as restricted or non-restricted in terms of territory or with respect to whom the manufactured product may be sold;
(4) The licensor's established policy and marketing program to maintain his patent monopoly by not licensing others to use the invention or by granting licenses under special conditions designed to preserve that monopoly;
(5) The commercial relationship between the licensor and licensee, such as, whether they are competitors in the same territory in the same line of business; or whether they are inventor and promoter;
(6) The effect of selling the patented specialty in promoting sales of other products of the licensee; that existing value of the invention to the licensor as a generator of sales of his non-patented items; and the extent of such derivative or convoyed sales;
(7) The duration of the patent and the term of the license;
(8) The established profitability of the product made under the patent; its commercial success; and its current popularity;
(9) The utility and advantages of the patent property over the old modes or devices, if any, that had been used for working out similar results;
(10) The nature of the patented invention; the character of the commercial embodiment of it as owned and produced by the licensor; and the benefits to those who have used the invention;
(11) The extent to which the infringer has made use of the invention; and any evidence probative of the value of that use;
(12) 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;

(13) 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;
(14) The opinion testimony of qualified experts; and
(15) The amount that a licensor (such as the patentee) and a licensee (such as the infringer) would have agreed upon (at the time the infringement began) if both had been reasonably and voluntarily trying to reach an agreement; that is, the amount which a prudent licensee- who desired, as a business proposition, to obtain a license to manufacture and sell a particular article embodying the patented invention- would have been willing to pay as a royalty and yet be able to make a reasonable profit and which amount would have been acceptable by a prudent patentee who was willing to grant a license.

8/7/10

The Hon. Charles Everingham

IN THE UNITED STATES DISTRICT COURT
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MARSHALL DIVISION

BRIGHT RESPONSE, LLC
F/K/A POLARIS IP, LLC

v.

GOOGLE INC., et al.

NO. 2:07CV-371-TJW-CE

GOOGLE AND YAHOO'S REQUEST FOR A JURY INSTRUCTION ON LICENSES INVOLVING STANFORD UNIVERSITY AND OVERTURE

You have heard testimony about a license agreement between Google and Stanford University. The Google-Stanford license agreement was discussed only with regard to Bright Response's claims against Google and not with regard to Bright Response's claims against Yahoo!. Therefore, if you find that the '947 patent is valid and that Yahoo! infringes the '947 patent, you must decide what reasonable royalty would have resulted from a hypothetical negotiation between Bright Response and Yahoo! without consideration of the Google-Stanford license agreement. In addition, you may not consider the Google-Stanford license when deciding whether Dr. Becker's damages opinion with respect to Yahoo! is well enough supported for you to accept it.

You have heard testimony about several license agreements between either Overture or Yahoo! and other entities who are not parties to this lawsuit regarding Overture's '361 patent and related patents. I will refer to those agreements as the Overture-Yahoo! '361 patent licenses. Those Overture-Yahoo! '361 patent licenses were discussed only with regard to Bright Response's claims against Yahoo!, and not with regard to Bright Response's claims against Google. Therefore, if you find that the '947 patent is valid and that Google infringes the '947 patent, you must decide what reasonable royalty would have resulted from a hypothetical negotiation between Bright Response and Google without consideration of the Overture-Yahoo! '361 patent licenses. In addition, you may not consider the Overture-Yahoo! '361 patent licenses when deciding whether Dr. Becker's damages opinion with respect to Google is well enough supported for you to accept it.

The Hon. Charles Everingham

refused 8/2/10

IN THE UNITED STATES DISTRICT COURT
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BRIGHT RESPONSE, LLC
F/K/A POLARIS IP, LLC

v.

GOOGLE INC., et al.

NO. 2:07CV-371-TJW-CE

GOOGLE AND YAHOO'S REQUEST FOR A JURY INSTRUCTION THAT THE PTO DOES NOT CONSIDER PRIOR PUBLIC USE OR WRITTEN DESCRIPTION DURING RE-EXAMINATION PROCEEDINGS

You, the jury, have responsibility for deciding whether claims 30, 31 and 33 of the '947 patent are valid even though the United States Patent and Trademark Office has allowed the claims. During reexamination the Patent Office does not address evidence of invalidity other than patents or printed publications. For example, the Patent Office does not address evidence relating to public use or sale, inventorship, or conduct issues. The Patent Office also does not consider whether the original patent claims provide an adequate written description. Further, the Patent Office must apply the broadest reasonable interpretation of the claims, not the interpretation provided by the Court to be applied in this case. The reexamination proceeding did not resolve the issues of validity in this litigation.

The Hon. Charles Everingham

Refused 8/7/10

IN THE UNITED STATES DISTRICT COURT
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BRIGHT RESPONSE, LLC F/K/A POLARIS IP, LLC v. GOOGLE INC., et al.	NO. 2:07CV-371-TJW-CE

GOOGLE AND YAHOO'S REQUEST FOR A JURY INSTRUCTION ON PURCHASE PRICE AND REASONABLE ROYALTY

In determining the reasonable royalty, you may consider the price(s) paid to purchase the '947 patent.

Rejected
8/7/10

The Hon. Charles Everingham

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

BRIGHT RESPONSE, LLC F/K/A POLARIS IP, LLC v. GOOGLE INC., et al.	NO. 2:07CV-371-TJW-CE

GOOGLE AND YAHOO'S REQUEST FOR MODIFICATIONS TO THE COURT'S INSTRUCTION ON PUBLIC USE

Google and Yahoo! request the following modifications to the Court's instruction on public use as found on page 12 of the jury instructions circulated to the parties on the evening of August 6, 2010:

The public use of a product or process of a patent claim in the United States more than one year before the filing date of the application for the patent ~~may be~~is prior art to the patent claim.

~~First~~To invalidate the patent claim, the use must occur in the United States more than one year before the patent
application was filed. In this case, the '947 patent was filed on April 3, 1997, so that date is April 3, 1996. The date of the invention is irrelevant to this category of prior art. If the public use is more than one year before the patent application was filed, then that public use ~~may be~~is prior art,
regardless of the date of invention.

~~Second, t~~The use may be by anyone, including the inventor or patent owner.

~~Third, i~~If the use was by someone other than the inventor, the use must have been accessible to the public in order to be prior art.

~~Fourth, c~~Commercial exploitation of the product or process constitutes public use, even if there was a confidentiality agreement, or circumstances existed creating a similar expectation of privacy or secrecy. Commercial exploitation includes sale of the invention or a charge for use of the invention to generate commercial benefits.

~~Fifth, i~~In order for a public use to be prior art the invention must have been ready for patenting when it was used. An invention is ready for patenting if the product offered for sale has been developed to the point where there was reason to expect it would work for its intended purpose. The product may be ready for patenting even if it is not ready for commercial production, or has not been technically perfected. ~~The sale or offer for sale in the United States of a product is prior art to a patent claim covering the product or a method of making the product if the product was sold or offered for sale in the United States more than one year before the~~

~~application for the patent was filed. The date of invention for the patent claims is irrelevant to this category of prior art. If the sale or offer for sale of a product is more than one year before the patent application was filed, then the product or method of making it is prior art, regardless of the date of invention.~~

The Hon. Charles Everingham

Refused 8/7/10