

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

NORTHEASTERN UNIVERSITY and  
JARG CORPORATION

Plaintiffs,

v.

GOOGLE INC.

Defendant.

Case No. 2:07-CV-486-CE

JURY TRIAL DEMANDED

**PARTIES' JOINT PROPOSED JURY INSTRUCTIONS**

## PROPOSED PRELIMINARY JURY INSTRUCTIONS

### 1. PRELIMINARY INSTRUCTIONS – PATENT SPECIFIC<sup>12</sup>

#### MEMBERS OF THE JURY:

You have now been sworn as the jury to try this case. As the jury, you will decide the disputed questions of fact.

As the Judge, I will decide all questions of law and procedure. From time to time during the trial and at the end of the trial, I will instruct you on the rules of law that you must follow in making your decision.

Keep an open mind during the trial. Do not decide any fact until you have heard all of the evidence, the closing arguments, and my instructions.

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<sup>1</sup> Adapted from the Model Patent Jury Instructions prepared by The National Jury Instruction Project and published June 17, 2009 (available at <http://www.nationaljuryinstructions.org/>) and the 2006 Fifth Circuit Civil Pattern Jury Instructions (available at <http://www.lb5.uscourts.gov/juryinstructions/>).

<sup>2</sup> These Patent Specific Preliminary Instructions are provided for use in the event the Court instructs the jury that the burden of proof governing one or more of Defendant's invalidity defenses is a preponderance of the evidence, instead of clear and convincing evidence. Should the Court decide to instruct the jury to apply the clear and convincing standard to all of Defendant's invalidity defenses, the parties request that the jury be shown the standard Federal Judicial Center video presentation, *An Introduction to the Patent System*, in lieu of these Patent Specific Preliminary Instructions.

## **1.1. What a Patent is and How One Is Obtained**

This case involves a dispute over a United States patent. Before summarizing the positions of the parties and the legal issues involved in the dispute, I want to explain what a patent is and how one is obtained.

The United States Constitution grants Congress the powers to enact laws “to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.” Using this power, Congress enacted the patent laws.

Patents are granted by the United States Patent and Trademark Office (sometimes called “the PTO”). A valid United States patent gives the patent holder certain rights for up to 20 years from the date the patent application was filed. The patent holder may prevent others from making, using, offering to sell, or selling the patented invention within the United States or from importing it into the United States without the patent holder’s permission. A violation of the patent holder’s rights is called infringement. The patent holder may try to enforce a patent against persons believed to be infringers by a lawsuit filed in federal court.

The process of obtaining a patent is called “patent prosecution.” To obtain a patent, one must file an application with the PTO. The PTO is an agency of the federal government and employs trained examiners who review applications for patents. The application includes a section called the “specification,” which must contain a written description of the claimed invention telling what the invention is, how it works, and how to make and use it, so others skilled in the field will know how to make and use it. The specification concludes with one or more numbered sentences. These are the patent “claims.” When the patent is eventually granted by the PTO, the claims define the boundaries of its protection and give notice to the public of

those boundaries. Claims can be independent or dependent. An independent claim is self-contained. A dependent claim refers back to an earlier claim and includes the requirements of the earlier claim.

After the applicant files a patent application, a PTO patent examiner reviews it to determine whether the claims are patentable and whether the specification adequately describes the invention claimed. In examining a patent application, the patent examiner reviews records available to the PTO for what is referred to as “prior art.” The examiner will also review prior art if it is submitted to the PTO by the applicant. Prior art is defined by law, and, at a later time, I will give you specific instructions on what constitutes prior art. However, in general, prior art includes things that existed before the claimed invention, that were publicly known or used in a publicly accessible way in this country, or that were patented or described in a publication in any country. The examiner considers, among other things, whether each claim defines an invention that is new, useful, and not obvious when compared with the prior art. A patent lists the prior art the examiner considered; this list is called the “cited references.” The cited references include the prior art found by the examiner as well as any prior art submitted to the PTO by the applicant.

After the prior art search and examination of the application, the patent examiner then informs the applicant in writing what the examiner has found and whether any claim is patentable, and thus will be “allowed.” This writing from the patent examiner is called an “office action.” If the examiner rejects the claims, the applicant then responds and sometimes changes the claims or submits new claims. This process, which takes place only between the examiner and the patent applicant, may go back and forth for some time until the examiner is satisfied that the application and claims meet the requirements for a patent. The papers generated during this

time of communicating back and forth between the patent examiner and the applicant make up what is called the “prosecution history.” All of this material becomes available to the public no later than the date when the PTO grants the patent.

Just because the PTO grants a patent does not necessarily mean that any invention claimed in the patent is, in fact, legally entitled to the protection of a patent. [Defendant’s proposed language: For example, the examiner may not have had available all the information that will be presented to you.] [Plaintiffs object to Defendant’s proposed language on the grounds that it is unnecessary and inconsistent with the Model Patent Jury Instructions.] A person accused of infringement has the right to argue here in federal court that a claimed invention in the patent is not entitled to patent protection because it does not meet the requirements for a patent. In other words, an accused infringer may defend a suit for patent infringement on the grounds that the patent is invalid.

## 1.2. The Contents of a Patent

During the trial, you will hear references made to the various sections of the patent. The different parts of a patent follow a standard format. The cover page of a patent identifies the date the patent was granted and the patent number along the top, as well as the inventor's name, the filing date, and a list of the references considered by the PTO during the prosecution of the patent.

The specification of a patent begins with an abstract, also found on the cover page. The abstract is a brief statement about the subject matter of the invention. Next come the drawings. The drawings illustrate various aspects or features of the invention. The written description of the invention appears next and is organized into two columns on each page. The specification ends with numbered sentences. These numbered sentences are the patent claims.

The claims of a patent define the patent owner's rights under the law. That is, the claims define what the patent may exclude others from doing during the term of the patent.

[Defendant's proposed language: The claims of a patent serve two purposes. First, they set out the boundaries of the invention covered by the patent. Second, they provide notice to the public of those boundaries. Thus, when a product is accused of infringing a patent, it is the patent claims that must be compared to the accused product to determine whether or not there is infringement. It is the claims of the patent that are infringed when patent infringement occurs. The claims are at issue as well when the validity of a patent is challenged. In reaching your determinations with respect to infringement and invalidity, you must consider each claim separately.] [Plaintiffs object to Defendant's proposed language on the grounds that it is unnecessary, includes information that is duplicative of information already provided in

Instruction 1.1, likely to confuse the jury, and inconsistent with the Model Patent Jury

Instructions.]

### 1.3. Glossary of Patent Terms

To assist you in your deliberations, we have a Glossary of Patent Terms that identifies terms used in patent matters and gives you a definition of those terms.

#### **GLOSSARY OF PATENT TERMS**

**Application** – The initial papers filed by the applicant with the United States Patent and Trademark Office (also called the Patent Office or PTO).

**Claims** – The numbered sentences appearing at the end of the patent that define the invention. The words of the claims define the scope of the patent holder’s exclusive rights during the life of the patent. Claims can be independent or dependent. An independent claim is self-contained. A dependent claim refers back to an earlier claim and includes the requirements of the earlier claim.

**File wrapper** – Another term for the “prosecution history” defined later.

**License** – Permission to use or make the patented invention, or perform any of the other exclusive rights granted by the patent, which may be granted by a patent holder (or a prior licensee) in exchange for a fee called a “royalty” or other types of payment.

**Office action** – Communication from the patent examiner regarding the patent application.

**Ordinary skill in the art** – The level of experience, education, and/or training that those individuals who worked in the area of the invention ordinarily possessed at the time of the effective filing date of the patent application.

**Patent and Trademark Office (“PTO”)** – The office of the United States Government charged with examining applications for patents and issuing patents.

**Patent examiners** – Personnel employed by the PTO who review (or examine) patent applications to determine whether the claims of a patent application are patentable and whether the specification adequately describes and enables the claimed invention.

**Prior art** – Prior art is not art as one might generally understand the word art. Rather, prior art is a technical term relating to patents. In general, it includes things that existed before the claimed invention and might typically be a patent or a printed publication. I will give you a more specific definition of prior art later.

**Prosecution history** – The written record of proceedings between the applicant and the PTO, including the original patent application and later communications between the PTO and applicant.

**Specification** – The information that appears in the patent and concludes with one or more claims. The specification includes the written text and the drawings or figures. In the specification, the inventor should provide a description telling what the invention is, how it works, and how to make and use it so as to enable others skilled in the art to do so, and what the inventor believed at the time of filing to be the best way of making the invention.

## **2. PRELIMINARY INSTRUCTIONS – CONDUCT OF TRIAL**

### **2.1. The Positions of the Parties**

I will now give you a summary of the positions of the parties. The parties in this case are the plaintiffs, Northeastern University (“Northeastern”) and Jarg Corporation (“Jarg”) (together, “Plaintiffs”), and the defendant, Google Inc. (“Defendant”). The case involves a patent obtained by Dr. Kenneth Baclawski, and transferred from Dr. Baclawski to Northeastern. Northeastern has licensed the patent to Jarg. The patent involved in this case is United States Patent No. 5,694,593. The patent-in-suit relates to a distributed computer database system. For convenience, the parties and I will often refer to this patent as the ‘593 patent. During the trial, the parties will offer testimony to familiarize you with this technology. For your convenience, we have for you a notebook that contains the patent, as well as a glossary of some of the technical terms to which the parties may refer during the trial.

Plaintiffs contend that Defendant has infringed claims 8 and 9 of the ‘593 patent by making and using a system that includes all of the requirements of those claims. Plaintiffs also contend that Defendant’s infringement of asserted claims has been willful. Defendant denies Plaintiffs’ allegations of infringement, and contends that the ‘593 patent is invalid.

You have two main duties as jurors. First, you must decide what the facts are from the evidence that you will see and hear in court. Second, you must take the law that I give you, apply it to the facts, and answer the questions in the verdict form. To fulfill your duties as jurors, you must decide whether claims 8 and 9 of the ‘593 patent have been infringed and whether those claims are invalid.

[Plaintiff’s proposed language: If you decide that any claim of the ‘593 patent has been infringed and is not invalid, you will then need to decide any money damages to be awarded to

Plaintiffs to compensate for that infringement.] [Defendant's proposed language: Only if you decide that any claim of the '593 patent has been infringed and is not invalid, you will then need to decide any money damages to be awarded to Plaintiffs to compensate for that infringement.]

You will also need to decide whether the infringement was willful. If you decide that any infringement was willful, that decision should not affect any damage award you give. I will take willfulness into account later in the proceedings.

It is my job as judge to determine the meaning of any claim language that needs interpretation. You must accept the meanings I give you and use them when you decide whether any claim of the patent has been infringed and whether any claim is invalid.

## **2.2. [Defendant’s Proposed Instruction: Burden of Proof – Preponderance of the Evidence Standard**

Plaintiffs have the burden of proving infringement and damages regarding the ’593 patent by what is called “preponderance of the evidence.” That means Northeastern and Jarg have to produce evidence which, when considered in light of all the facts, leads you to believe that what they claim is more likely true than not. To put it differently, if you were to put Plaintiffs’ and Defendant’s evidence on the opposite sides of a scale, the evidence supporting Plaintiffs’ claims would have to make the scales tip on Plaintiffs’ side.

You should base your decision on all of the evidence, regardless of which party presented it. If you believe that Northeastern and Jarg have met their burden of proving patent infringement and damages by a preponderance of the evidence, you must find in favor of Plaintiffs for the ’593 patent. If you believe that Northeastern and Jarg have not met their burden of proof for the ’593 patent, you must find in favor of Google.

A patent is presumed to be valid. In this case, Google is urging that the asserted claims of the ’593 patent are invalid. Accordingly, Google has the burden of proving that each of the asserted claims of the ’593 patent are invalid by a preponderance of the evidence.<sup>3</sup> Therefore,

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<sup>3</sup> On November 29, 2010, the United States Supreme Court granted Microsoft Corporation’s writ of certiorari in *Microsoft Corp. v. i4i Limited Partnership*, 598 F.3d 841 (Fed. Cir. 2010), and agreed to hear the question of whether the Federal Circuit erred in requiring Microsoft to prove its invalidity defense under 35 U.S.C. § 102(b) by clear and convincing evidence. 2010 WL 3392402 (Nov. 29, 2010). Defendant proposes that the Court instruct the jury to consider all of its invalidity defenses under the preponderance of the evidence standard in light of the Supreme Court’s decision to grant Microsoft’s petition. However, Google intends to preserve its rights to appeal and does not waive any such rights by offering this proposed instruction. Plaintiffs propose that the Court instruct the jury to consider Defendant’s invalidity defense of obviousness under the preponderance of the evidence standard in view of the Supreme Court’s decision to grant Microsoft’s petition. Plaintiffs object to instructing the jury under the preponderance of the evidence standard for any defense under 35 U.S.C. § 112, as that issue is

for Google to prevail, you must be persuaded that it is more probable than not that what Google seeks to prove is true.

If you believe that Google has met its burden of proving patent invalidity by a preponderance of the evidence, you must find in favor of Google. Again, you should base your decision on all of the evidence, regardless of which party presented it. If you believe that Google has not met its burden of proof, you must find in favor of Northeastern and Jarg on the issue of validity]

[Plaintiffs object to including an instruction regarding burden in the Preliminary Instructions because instructing the jury on burden prior to the parties' presentations of their respective cases and outside the context of instructions regarding the specific elements of the parties' respective claims and defenses is likely to confuse the jury. It is also unnecessary to instruct the jury on burden at the start of trial because the jury will be properly instructed on burden in the final instructions at the close of the trial. Plaintiffs also object that Defendant's proposed instruction includes unnecessary language, is inconsistent with the Model Patent Jury Instructions, and incorrectly states that the burden of proof for all of its invalidity defenses should be the preponderance of the evidence standard. (See fn. 3 above.) Thus, to the extent that the Court decides to give a preliminary instruction regarding burden, Plaintiffs believe that the following language adapted from Model Patent Jury Instruction 1.4 would be more appropriate:

Plaintiffs have the burden of proving infringement and damages regarding the '593 patent by what is called "a preponderance of the evidence." In this case, Defendant contends that

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not before the Supreme Court and it is well established that invalidity for failing to meet one of the requirements of 35 U.S.C. § 112 must be shown by clear and convincing evidence.

claims 8 and 9 of the '593 patent are invalid as obvious. Defendant has the burden of proving that each of the asserted claims of the '593 patent is invalid as obvious by a preponderance of the evidence.

When a party has the burden of proof on any claim or defense by a preponderance of the evidence, it means the evidence must persuade you that the claim or defense is more probable than not. You should base your decision on all of the evidence, regardless of which party presented it.]

### **2.3. [Defendant's Proposed Instruction: Burden of Proof – Clear and Convincing**

#### **Evidence Standard**

In this case, Plaintiffs are also alleging that Google willfully infringed claims 8 and 9 of the '593 patent. Accordingly, Plaintiffs have the burden of proving that infringement of the '593 patent was willful by "clear and convincing evidence." This standard is stricter and higher than the "preponderance of the evidence" standard. Therefore, for Northeastern and Jarg to prevail on willful infringement, you must be persuaded that it is highly probable that what Northeastern and Jarg seek to prove is true.

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 and you should, therefore, put it out of your mind in considering whether or not Northeastern, Jarg or Google has met its burden of proof.]

[Plaintiffs object to including an instruction regarding burden in the Preliminary Instructions because instructing the jury on burden prior to the parties' presentations of their respective cases and outside the context of instructions regarding the specific elements of the parties' respective claims and defenses is likely to confuse the jury. It is also unnecessary to instruct the jury on burden at the start of trial because the jury will be properly instructed on burden in the final instructions at the close of the trial. Plaintiffs also object that Defendant's proposed instruction includes unnecessary language and is inconsistent with the Model Patent Jury Instructions. Thus, to the extent that the Court decides to give a preliminary instruction regarding burden, Plaintiffs believe that the following language adapted from Model Patent Jury Instruction 1.5 would be more appropriate:

In this case, Plaintiffs are also alleging that Defendant's infringement of claims 8 and 9 of the '593 patent has been willful. Plaintiffs have the burden of proving that Defendant's infringement of the '593 patent has been willful by "clear and convincing evidence." In this case, Defendant is alleging that claims 8 and 9 are invalid because the inventor believed there was a best way of making or using the invention defined by those claims but failed to disclose that best way in the patent. This is known as the "best mode" requirement. Defendant has the burden of proving that claims 8 and 9 are invalid for failure to satisfy the "best mode" requirement by "clear and convincing" evidence.

When a party has the burden of proving any claim or defense by clear and convincing evidence, it means the evidence has persuaded you that the claim or defense is highly probable. You should base your decision on all of the evidence, regardless of which party presented it.]

## **2.4. Conduct of the Trial**

In a few moments, the trial will begin. The lawyers for each of the parties will make what is called an opening statement. Opening statements are intended to assist you in understanding the evidence. What the lawyers say is not evidence. After the opening statements, Plaintiffs will call witnesses and present evidence. Then, Defendant will have an opportunity to call witnesses and present evidence. After the parties' main case is completed, Plaintiffs may be permitted to present rebuttal evidence. After all the evidence is completed, I will instruct you on the applicable law. Then the lawyers will again address you to make closing statements. You will then retire to deliberate on a verdict.

## **2.5. Evidence**

The evidence in this case includes only what the witnesses say while they are testifying under oath, the exhibits that I allow into evidence, the stipulations that the lawyers agree to, and the facts that I will instruct 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.

In making your decision, you must consider only the evidence in this case. However, you should use your common sense in weighing the evidence. Consider it in light of your everyday experience and give it whatever weight you believe it deserves.

## **2.6. 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.

## **2.7. Depositions**

Certain testimony may be presented to you through a deposition. A deposition is the sworn, recorded answers to questions asked a witness in advance of the trial. Under some circumstances, if a witness cannot be present to testify from the witness stand, that witness' testimony may be presented, under oath, in the form of a deposition. Some time before this trial, attorneys representing the parties in this case questioned this witness under oath. A court reporter was present and recorded the testimony. The questions and answers will be read or shown to you. This deposition testimony is entitled to the same consideration as if the witness had been present and had testified from the witness stand in court.

## **2.8. Interrogatories**

Evidence also may be presented to you in the form of a party's written answers to written questions, called "interrogatories," submitted by the other side. These answers were given under oath before trial began, and they are entitled to the same consideration by you as if they had been given from the witness stand.

## **2.9. No Transcript Available to Jurors**

Even though the court reporter is making stenographic notes of everything that is said, a typewritten copy of the testimony will not be available for your use during deliberations. On the other hand, any exhibits introduced during the trial will be available to you during your deliberations.

## **2.10. Taking Notes**

If you would like to take notes during the trial, you may do so. If you do take notes, be careful not to get so involved in note taking that you become distracted and miss part of the testimony. Your notes are to be used only as an aid to your memory, and if your memory should later be different from your notes, you should rely on your memory and not on your notes. If you do not take notes, rely on your own independent memory of the testimony. Do not be unduly influenced by the notes of other jurors. A juror's notes are not entitled to any greater weight than the recollection of each juror concerning the testimony.

## **2.11. Conduct of the Jury During Trial**

Until this trial is over, do not discuss this case with anyone and do not permit anyone to discuss this case in your presence. Do not discuss the case even with the other jurors until all of the jurors are in the jury room actually deliberating at the end of the case. If anyone should attempt to discuss this case or to approach you concerning the case, you should inform the Court immediately. Hold yourself completely apart from the people involved in the case—the parties, the witnesses, the attorneys and persons associated with them. It is important not only that you be fair and impartial but that you also appear to be fair and impartial. Do not make any independent investigation of any fact or matter in this case. You are to be guided solely by what you see and hear in this trial.

## PROPOSED POST-TRIAL JURY INSTRUCTIONS

### I. INTRODUCTORY INSTRUCTIONS<sup>4</sup>

Ladies and Gentlemen of the Jury, you have heard the evidence presented by the parties to this suit and the argument of the respective attorneys in support of their positions.

It is now my duty to give you the charge in this case. It will be an oral charge and is given in an effort to assist you in your deliberations in deciding the issues which you must decide in order to reach a fair and impartial verdict in this case. Perhaps this function of the Court is the most important one that the Court performs in the trial of a case, so I ask you to pay close attention to my remarks.

You will remember that at the beginning of the trial, I gave you some general instructions and definitions. Rather than repeat them, I ask you to recall them now in deciding the facts and issues which you are to decide. As I instructed you at the beginning of the trial, you are the exclusive judges of the facts, the credibility of the evidence, and the weight to be given the testimony of the witnesses. You are to perform your duty without bias or prejudice to any party. The law does not permit jurors to be governed by sympathy or prejudice. A corporation and all other persons, including the Plaintiffs and Defendant in this case, are equal before the law and must be treated as equals in a court of justice. The law is no respecter of persons. The Court and the parties expect that you will carefully and impartially consider all of the evidence, follow the law, as I will give it to you, and reach a just verdict.

I will now briefly review the contentions of the parties and give you some additional instructions and definitions that will guide you in deciding the issues or facts that you must

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<sup>4</sup> Adapted from this Court's instructions as given in *Function Media, L.L.C. v. Google Inc.*, Civil Action No. 2:07-cv-279.

resolve in this case.

## II. THE PARTIES, THEIR CONTENTIONS AND BURDENS OF PROOF<sup>5</sup>

The Plaintiffs in this case are Northeastern University and Jarg Corporation. I will refer to them in these instructions as Plaintiffs. The Defendant in this case is Google Inc. I will refer to it in these instructions as Defendant.

Plaintiffs contend that Defendant infringes claims 8 and 9 of United States Patent No. 5,694,593. I will refer to this patent in these instructions as “the ’593 patent.” I will refer to claims 8 and 9 of this patent as “Plaintiffs’ asserted claims” or as “the asserted claims.”

Plaintiffs contend that Defendant infringes claims 8 and 9 of the ’593 patent by making and using the Teragoogle web search system. Plaintiffs also contend that Defendant’s infringement of the asserted claims is willful. Plaintiffs are seeking damages in the form of a reasonable royalty to compensate them for Defendant’s alleged use of the patented invention.

Defendant denies Plaintiffs’ contentions. Defendant denies that TeraGoogle infringes claims 8 and 9 of the ’593 patent. Defendant also denies that it has willfully infringed the asserted claims. Defendant also contends that the asserted claims 8 and 9 of the ’593 patent are invalid. [Plaintiffs’ proposed language: Specifically, Defendant contends that the asserted claims of the ’593 patent are invalid as obvious, and invalid for failure to satisfy the “best mode” requirement. I will tell you more a little later about the “best mode” requirement and what it means for a patent to be “obvious.”] [Defendant’s proposed language: Specifically, Defendant contends that the asserted claims of the ’593 patent are invalid as obvious, and invalid for failure to satisfy the “best mode” and “written description” requirements. I will tell you more a little

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<sup>5</sup> Adapted from this Court’s instructions as given in *Function Media, L.L.C. v. Google Inc.*, Civil Action No. 2:07-cv-279, and the Model Patent Jury Instructions prepared by The National Jury Instruction Project and published June 17, 2009 (available at <http://www.nationaljuryinstructions.org/>).

later about the “best mode” and “written description” requirements and what it means for a patent to be “obvious.”<sup>6]</sup>

Invalidity is a defense to infringement. Therefore, even though the PTO examiner has allowed the claims of the '593 patent, you, the jury, must decide whether the claims of the '593 patent are invalid.

Your job is to decide whether the asserted claims of the '593 patent have been infringed and whether any of the asserted claims of the '593 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 Plaintiffs as compensation for the infringement. You will also need to decide whether the infringement was willful. If you decide that any infringement was willful, that decision should not affect any damage award you make. I will take willfulness into account later.

I will now review for you the burdens of proof for the parties' claims and defenses.

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<sup>6</sup> Plaintiffs object to Defendant's inclusion of any instructions regarding written description because Defendant dropped that defense with respect to claims 8 and 9 in its final Invalidity Contentions, served on December 29, 2010. *See Cummins-Allison Corp. v. SBM Co., Ltd.*, No. 9:07-CV-196, 2009 WL 763926, \*4-\*8 (E.D. Tex. Mar. 19, 2009).

### III. THE BURDENS OF PROOF<sup>7</sup>

As I explained in my preliminary instructions before the trial began, Plaintiffs bear the burden of proving by a preponderance of the evidence that Defendant has infringed the asserted claims of the patent-in-suit. In other words, the evidence must persuade you that it is more probable than not that Defendant has infringed the asserted claims. Plaintiffs also bear the burden of proving by clear and convincing evidence that the Defendant's alleged infringement was willful. In other words, the evidence must persuade you that it is highly probable that any infringement was willful. Plaintiffs also bear the burden of proving by a preponderance of the evidence the amount of damages caused by Defendant's infringement.

Defendant bears the burden of proving by a preponderance of the evidence that the asserted claims of the patent-in-suit are invalid as obvious. In other words, the evidence must persuade you that it is more probable than not that claims 8 and 9 of the '593 patent are obvious.

[Plaintiffs' proposed instruction: Defendant also bears the burden of proving by clear and convincing evidence that the asserted claims of the '593 patent are invalid for failure to disclose the "best mode," or best way of making or using the invention. In other words, the evidence must persuade you that it is highly probable that the asserted claims fail to disclose the "best mode."<sup>8</sup>] [Defendant's proposed instruction: Defendant also bears the burden of proving by

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<sup>7</sup> Adapted from the Model Patent Jury Instructions prepared by The National Jury Instruction Project and published June 17, 2009 (available at <http://www.nationaljuryinstructions.org/>).

<sup>8</sup> On November 29, 2010, the United States Supreme Court granted Microsoft Corporation's writ of certiorari in *Microsoft Corp. v. i4i Limited Partnership*, 598 F.3d 841 (Fed. Cir. 2010), and agreed to hear the question of whether the Federal Circuit erred in requiring Microsoft to prove its invalidity defense under 35 U.S.C. § 102(b) by clear and convincing evidence. 2010 WL 3392402 (Nov. 29, 2010). Plaintiffs propose that the Court instruct the jury to consider Defendant's invalidity defense of obviousness under the preponderance of the evidence standard in view of the Supreme Court's decision to grant Microsoft's petition. Plaintiffs object to instructing the jury under the preponderance of the evidence standard for any defense under 35

preponderance of the evidence that the asserted claims of the '593 patent are invalid for failure to disclose the "best mode," or best way of making or using the invention. In other words, the evidence must persuade you that it is more probable than not that the asserted claims fail to disclose the "best mode." Defendant also bears the burden of proving by a preponderance of the evidence that the asserted claims of the '593 patent are invalid for failure to satisfy the "written description" requirement. In other words, the evidence must persuade you that it is more probable than not that the patent does not describe the invention as claimed in claims 8 and 9 of the '593 patent.<sup>9</sup>]

I will now give you some instructions and definitions to help you in answering the questions to follow.

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U.S.C. § 112, as that issue is not before the Supreme Court and it is well established that invalidity for failing to meet one of the requirements of 35 U.S.C. § 112 must be shown by clear and convincing evidence. Defendant proposes that the Court instruct the jury to consider all of its invalidity defenses under the preponderance of the evidence standard in light of the Supreme Court's decision to grant Microsoft's petition. However, Google intends to preserve its rights to appeal and does not waive any such rights by offering this proposed instruction.

<sup>9</sup> Plaintiffs object to Defendant's inclusion of any instructions regarding written description because Defendant dropped that defense with respect to claims 8 and 9 in its final Invalidity Contentions, served on December 29, 2010. *See Cummins-Allison Corp. v. SBM Co., Ltd.*, No. 9:07-CV-196, 2009 WL 763926, \*4-\*8 (E.D. Tex. Mar. 19, 2009). To the extent the Court allows Defendant to re-assert its withdrawn written description defense, Plaintiffs believe that the jury should be instructed that the Defendant has the burden to prove its written description invalidity defense by clear and convincing evidence because that is the law. *See, e.g., Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1354 (Fed. Cir. 2010)(en banc).

#### IV. CLAIM INTERPRETATION<sup>10,11</sup>

Plaintiffs contend that Defendant committed patent infringement. To decide the question of infringement, you must first understand what the asserted claims cover, that is, what they prevent anyone else from doing. This is called “claim interpretation.”

It is my duty under the law to interpret what the words used in the patent’s claims mean. I have made my determinations, and I will instruct you accordingly. You must apply the meanings I have given the words in the asserted patent claims in reaching your decisions on infringement and invalidity.

I will now instruct you how the words in the asserted claims are to be construed and understood when deciding the issues of infringement and invalidity. You have been provided with a written copy of the ’593 patent and the claim term definitions that I am about to give you. You may use them in your deliberations. Here are my constructions:

The term “non-relational, distributed database system” means “a database not using a relational model.” “Relational model” means “a database model wherein the data stored in the database is accessed by algebraic queries that uniquely identify each data entry sought, information stored across multiple computers is stored in non-overlapping sub-databases called fragments, queries to the entire database are factored into non-overlapping sub-queries using the database’s relational algebra and sub-queries are then sent to fragments, the queries and sub-queries are not hashed, and the data stored in the database lacks object identity.”

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<sup>10</sup> Adapted from this Court’s instructions as given in *Function Media, L.L.C. v. Google Inc.*, Civil Action No. 2:07-cv-279.

<sup>11</sup> The constructions provided in this section were issued by this Court in its November 9, 2010 Memorandum Opinion and Order (Dkt. No. 101).

The term “query fragment” means “a part or piece of a request for information from a database.”

The term “hashes” means “applies a hash function to.” The term “hash function” means “a mathematical function that converts inputs into a value within a predetermined range.”

The term “a first portion and a second portion” means “a first portion and a second portion, the first portion distinct from the second portion. The portions may overlap, but neither portion may encompass the entire hashed query fragment.”

[Defendant’s proposed instruction: A “hashed query fragment” is “a number.”<sup>12</sup>]

[Plaintiffs object to Defendant’s proposed instruction. “Hashed query fragment” was not a term that the parties had presented to the Court for construction and therefore was not a term that the parties proposed constructions for or briefed in their respective claim construction briefs. (Dkt. 71 & 78.) In addition, Defendant’s proposed instruction does not reflect the parties’ and the Court’s constructions of “hashing” and “local hash table,” which were claim terms that the parties did present to the Court for construction. (Dkt. 101 at 14-16.) As to those terms, the parties agreed that hash *values* result from hashing. (Dkt. 71 at 16-19; Dkt. 78 at 14-15 & 17-18.) Similarly, in its claim construction order, the Court “construe[d] ‘hashing’ to mean ‘applying a hash function to’ and ... define[d] ‘hash function’ to mean ‘a mathematical function that converts inputs into a *value* within a predetermined range.’” (Dkt. 101 at 15 (emphasis added).) The Court also “construe[d] ‘hash table’ to mean ‘a table that associates hash *values* with other data’ and ‘local hash table’ to mean ‘a hash table containing at least the hash *values*

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<sup>12</sup> Defendant disputes that its offered meaning of “hashed query fragment” is improper. The parties offered claims for construction containing the “hashed query fragment” element and the Court construed “hashed query fragment” as part of its Markman Order. D.I. 101 at 12, fn. 3, 20-23.

and data associated with said first portion of said hashed query fragment.” (Id. at 16 (emphasis added).)]

The term “hash table” means “a table that associates hash values with other data.” The term “local hash table” means “a hash table containing at least the hash values and data associated with said first portion of said hashed query fragment.”

The term “predetermined” means “determined prior to the receipt of the query by the home node.”

All of the other terms in the '593 patent should be given their ordinary meaning as they would be understood by a person of ordinary skill in the field.

## V. INFRINGEMENT<sup>13</sup>

Once a patent is issued, the owner of a patent has a right to exclude others from making, using, offering to sell, or selling the patented invention throughout the United States or importing the patented invention into the United States for a period of 20 years. Infringement occurs when a person, without the owner's permission, makes, uses, offers to sell, or sells the patented invention anywhere in the United States or imports the patented invention into the United States while the patent is in force.

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<sup>13</sup> Adapted from this Court's instructions as given in *Function Media, L.L.C. v. Google Inc.*, Civil Action No. 2:07-cv-279, and the Model Patent Jury Instructions prepared by The National Jury Instruction Project and published June 17, 2009 (available at <http://www.nationaljuryinstructions.org/>).

**A. Literal Infringement**

In this case, you must decide whether Defendant has made, used, sold, or offered for sale within the United States, or imported into the United States, a product covered by claims 8 or 9 of the '593 patent. To determine whether there is infringement, you must compare each claim to the allegedly infringing system, Defendant's TeraGoogle web search system, to determine whether every requirement of the claim is included in the TeraGoogle system. In doing so, you must apply the patent claims as I have defined them for you. You must consider each of the patent claims separately.

In determining whether Defendant infringes the asserted claims of the '593 patent, you must determine whether Defendant's Teragoogle system contains each limitation recited in the claims, either literally or, as I will explain in a moment, under the doctrine of equivalents. To prove literal infringement, Plaintiffs must prove that it is more probable than not that Defendant's accused TeraGoogle system includes every requirement in the patent claim. If the TeraGoogle system omits any requirement recited in the patent claim, Defendant does not infringe that claim.

## **B. Comprising Claims**

The asserted claims use the word “comprising.” When a claim uses the word “comprising,” “comprising” means “including” or “containing.” A claim that uses the word “comprising” or “comprises” is not limited to systems having only the elements that are recited in the claims.<sup>14</sup> They also cover systems that add additional elements. To illustrate the point I am making, consider the example of a claim that covers a table. If the claim recites a table “comprising” a tabletop and legs, the claim will cover any table that contains these structures, even if the table also contains other structures, such as wheels on the legs. In other words, the Teragoogle system does not have to be identical to what is claimed in claims 8 and 9 in order for you to find infringement. On the other hand, if any of the claim limitations is not met, there can be no infringement.

Whether Defendant knew that its Teragoogle system infringed the asserted claims does not matter for infringement. A person may be found to be an infringer of a patent even if he or she believed in good faith that what he or she was doing was not an infringement of any patent, and even if he or she did not even know of the patent. However, as I will explain in a few moments, Defendant’s knowledge of and beliefs about the ’593 patent may be relevant to determining whether Defendant’s infringement was willful.

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<sup>14</sup>CIAS, Inc. v. Alliance gaming Corp., 504 F.3d 1356, 1360-61 (Fed. Cir. 2007).

### **C. Infringement Under the Doctrine of Equivalents**

In addition to literal infringement, Plaintiffs allege that Defendant has infringed claims 8 and 9 of the '593 patent under the "doctrine of equivalents."

To prevail on their allegations of infringement, Plaintiffs must prove that it is more probable than not that the accused Teragoogole system contains elements identical or equivalent to each claimed limitation of the patented invention. You must proceed through each asserted claim on a limitation-by-limitation basis.

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

In making this determination, you may consider whether the corresponding aspect of the accused system performs substantially the same function in substantially the same way to achieve substantially the same result as the limitation in the claim. You may also consider whether people of ordinary skill in the field believed that the corresponding aspect of the accused system and the limitation recited in the patent claim were interchangeable at the time of the alleged infringement.<sup>15</sup> The proper time for evaluating equivalency, and thus knowledge of interchangeability between limitations, is at the time of the alleged infringement, not the time the patent was issued.

Under the doctrine of equivalents, those of ordinary skill in the field do not have to know of the equivalent when the patent application is filed or when the patent issues. Thus, the inventor need not have foreseen, and the patent need not describe, all potential equivalents to the

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<sup>15</sup>Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 520 U.S. 17, 117 S.Ct. 1040, 1053 (1997).

invention covered by the claims. Also, changes in technique or improvements made possible by technology developed after the patent application is filed may still be equivalent for the purposes of the doctrine of equivalents.

#### **D. Independent and Dependent Claims**

My instructions on infringement so far have related to independent claims. Patent claims may exist in two forms that are 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 for you to look at any other claim to determine what an independent claim covers. Claim 8 of the '593 patent is an independent claim.

A dependent claim refers to at least one other claim in the patent. A dependent claim includes each of the limitations of the independent claim to which it refers, plus the additional limitations recited in the dependent claim itself.

Claim 9 of the '593 patent is a dependent claim. It depends on claim 8. In order to find claim 9 infringed, you must first find that claim 8 is infringed. To find claim 9 infringed, you must also find the additional limitations of claim 9 are present in the accused TeraGoogle system, either literally or under the doctrine of equivalents. If you find that independent claim 8 of the '593 patent is not infringed, you must also find that dependent claim 9 is not infringed. However, you may find that claim 8 is infringed without finding that claim 9 is infringed.

## VI. WILLFUL INFRINGEMENT<sup>16</sup>

Plaintiffs contend that Defendant has willfully infringed the asserted claims of the '593 patent. [Plaintiffs' proposed language: If you decide that any infringement was willful, that decision should not affect any damage award you give. I will take willfulness into account later in the proceedings.] [Defendant's proposed language: The issue of willful infringement relates to the amount of damages Northeastern and Jarg are entitled to recover in this lawsuit. If you decide that Google willfully infringed the claims of the '593 patent, then it is my job to decide whether or not to award increased damages to Northeastern and Jarg. You should not take this factor into account in assessing the damages, if any, to be awarded to Plaintiffs.]

To prove willful infringement, the Plaintiffs must first prove that the Defendant infringed a claim of the '593 patent. The requirements for proving infringement were discussed earlier in my instructions.

However, the fact that you may find that Defendant infringed the '593 patent does not necessarily mean that Defendant's infringement was willful. To prove willful infringement, Plaintiffs must prove that it is highly probable that before this lawsuit was filed on November 6, 2007, Defendant acted with reckless disregard of the claims of the '593 patent.<sup>17</sup>

To show "reckless disregard," the Plaintiffs must satisfy a two-part test: the first part concerns Defendant's conduct, and the second concerns Defendant's state of mind.

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<sup>16</sup> Adapted from this Court's instructions as given in *Agere Sys., Inc. v. Sony Corp.*, Civil Action No. 2:06-CV-079. Adapted from the Model Patent Jury Instructions prepared by The National Jury Instruction Project and published June 17, 2009 (available at <http://www.nationaljuryinstructions.org/>).

<sup>17</sup> *In re Seagate Tech., LLC*, 497 F.3d 1360, 1371 (Fed. Cir. 2007)

The first part of the test is objective. When considering Defendant's conduct, you must decide whether Plaintiffs have proven it is highly probable that Defendant's conduct was reckless; that is, that Defendant proceeded with the allegedly infringing conduct with knowledge of the patent, and despite an objectively high likelihood that it was infringing the claims of a valid patent. Defendant's state of mind is not relevant to this inquiry. [Defendant's proposed instruction: Legitimate or credible defenses to infringement, even if ultimately not successful, demonstrate a lack of recklessness.<sup>18</sup>] [Plaintiffs object to Defendant's proposed language on the grounds that it misstates applicable law, including the cited *Depuy* decision, and does not reflect the language found in the Model Patent Jury Instructions.] You should focus on whether a reasonable person in Defendant's position, after learning of the '593 patent, could have reasonably believed that they did not infringe, or that the patent was invalid. If a reasonable person in Defendant's position could not have reasonably believed that they did not infringe, or that the '593 patent was invalid then you need to consider the second part of the test.

The second part of the test looks to the defendant's state of mind. If you find that Defendant proceeded in the face of an objectively high likelihood of infringement, then you must determine whether Plaintiffs proved it is highly probable that the objectively high likelihood of infringement of a valid patent was known or so obvious that it should have been known to Defendant.

In deciding whether Defendant meets the state-of-mind part of the test, you should consider all of the facts surrounding the alleged infringement, including, but not limited to, the following:

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<sup>18</sup>*Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1337 (Fed. Cir. 2009); *Black & Decker, Inc. v. Robert Bosch Tool Corp.*, 260 Fed Appx. 284, 291 (Fed. Cir. 2008).

- (1) Whether Defendant, when it learned of the patent, acted in a manner consistent with the standards of commerce for its industry;
- (2) Whether Defendant had a substantial defense to infringement (i.e., that it did not infringe or that the '593 patent was invalid) and reasonably believed that the defense would be successful, if litigated;
- (3) Whether Defendant tried to cover up its infringement; and
- (4) Whether Defendant intentionally copied without a reasonable basis a system covered by one or more claims of the '593 patent, as distinguished from trying to “design around” the patent by designing a system that Defendant believed did not infringe those claims.<sup>19</sup>

Now, none of these factors is determinative. And the list of factors I have given you is not an exhaustive list of things that you should consider. Your determination of willfulness should incorporate the totality of the circumstances.

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<sup>19</sup>35 U.S.C. § 284; *In re Seagate Tech., LLC*, 497 F.3d 1360 (Fed. Cir. 2007) (en banc); *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337, 1345 (Fed. Cir. 2004) (en banc); *Crystal Semiconductor Corp. v. Tritech Microelectronics Int'l, Inc.*, 246 F.3d 1336, 1346 (Fed. Cir. 2001); *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1354 (Fed. Cir. 1999); *Read Corp. v. Portec, Inc.*, 970 F.2d 816 (Fed. Cir. 1992); *Gustafson, Inc. v. Intersystems Indus. Prods., Inc.*, 897 F.2d 508, 510 (Fed. Cir. 1990).

## VII. INVALIDITY<sup>20</sup>

### A. Invalidity Generally

Defendant contends that the asserted claims of the '593 patent are invalid. Patent invalidity is a defense to patent infringement. [Plaintiffs' proposed instruction: A patent issued by the United States Patent and Trademark Office is presumed to be valid, but the Defendant can rebut this presumption if it shows by a preponderance of the evidence that the patent is invalid as obvious or if it shows by clear and convincing evidence that the patent does not satisfy the "best mode" requirement.<sup>21</sup>] [Defendant's proposed instruction: A patent issued by the United States Patent and Trademark Office is presumed to be valid, but the Defendant can rebut this presumption if it shows by a preponderance of the evidence that the patent is invalid. So even though the PTO examiner has allowed the claims of a patent, you have the ultimate responsibility for deciding whether the claims of the patent are valid. I will now instruct you on the invalidity

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<sup>20</sup> Adapted from this Court's instructions as given in *Function Media, L.L.C. v. Google Inc.*, Civil Action No. 2:07-cv-279, *Axelsam, Inc. v. IDT Corp.*, Civil Action No. 2:07-CV-420, and the Model Patent Jury Instructions prepared by The National Jury Instruction Project and published June 17, 2009 (available at <http://www.nationaljuryinstructions.org/>).

<sup>21</sup> On November 29, 2010, the United States Supreme Court granted Microsoft Corporation's writ of certiorari in *Microsoft Corp. v. i4i Limited Partnership*, 598 F.3d 841 (Fed. Cir. 2010), and agreed to hear the question of whether the Federal Circuit erred in requiring Microsoft to prove its invalidity defense under 35 U.S.C. § 102(b) by clear and convincing evidence. 2010 WL 3392402 (Nov. 29, 2010). Plaintiffs propose that the Court instruct the jury to consider Defendant's invalidity defense of obviousness under the preponderance of the evidence standard in view of the Supreme Court's decision to grant Microsoft's petition. Plaintiffs object to instructing the jury under the preponderance of the evidence standard for any defense under 35 U.S.C. § 112, as that issue is not before the Supreme Court and it is well established that invalidity for failing to meet one of the requirements of 35 U.S.C. § 112 must be shown by clear and convincing evidence. Defendant proposes that the Court instruct the jury to consider all of its invalidity defenses under the preponderance of the evidence standard in light of the Supreme Court's decision to grant Microsoft's petition. However, Google intends to preserve its rights to appeal and does not waive any such rights by offering this proposed instruction.

issues you should consider. As you consider these issues, remember that Defendant bears the burden of proving that it is more probable than not that the claims are invalid.]

Defendant contends that the asserted claims of the '593 patent are invalid because they are rendered obvious by the prior art. Plaintiffs deny that the asserted claims are obvious. If you find by a preponderance of the evidence that an asserted claim is obvious, then you should find that claim invalid and render a verdict for Defendant on that claim.

Defendant also contends that the asserted claims of the '593 patent are invalid because the specification does not disclose what the inventor, Dr. Baclawski, believed was the “best mode” of practicing the claimed invention. Plaintiffs deny that Dr. Baclawski had a best mode that was not disclosed. [Plaintiffs’ proposed instruction: Defendant has the burden of proving by clear and convincing evidence that Dr. Baclawski failed to disclose the best mode of his invention.] [Defendant’s proposed instruction: Defendant has the burden of proving by a preponderance of the evidence that Dr. Baclawski failed to disclose the best mode of his invention.]

[Defendant’s proposed instruction: Defendant also contends that claims 8 and 9 of the '593 patent are invalid because they lack an adequate description in the specification and thus do not satisfy the “written description” requirement. Plaintiffs deny that claims 8 and 9 lack an adequate written description. Defendant bears the burden of proving by a preponderance of the evidence that claims 8 and 9 lack an adequate written description.<sup>22</sup>] [Plaintiffs object to Defendant’s inclusion of any instructions regarding written description because Defendant dropped that defense with respect to claims 8 and 9 in its final Invalidation Contentions, served on

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<sup>22</sup> Defendant disputes that it waived its written description defense. Defendant filed a Motion for summary judgment and included the defense in the pretrial order. D.I. 152 at 4-6, D.I. 177 at 7, 11.

December 29, 2010. *See Cummins-Allison Corp. v. SBM Co., Ltd.*, No. 9:07-CV-196, 2009 WL 763926, \*4-\*8 (E.D. Tex. Mar. 19, 2009). To the extent the Court allows Defendant to re-assert its withdrawn written description defense, Plaintiffs believe that the jury should be instructed that the Defendant has the burden to prove its written description invalidity defense by clear and convincing evidence because that is the law. *See, e.g., Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1354 (Fed. Cir. 2010)(en banc).]

You must consider the validity of each asserted claim separately. Each claim of a patent is presumed valid regardless of the status of any other claim in the patent. Accordingly, you cannot presume that any claim is invalid merely because you might find another claim invalid.<sup>23</sup>

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<sup>23</sup>*Sandt Tech. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344, 1356 (Fed. Cir. 2001)

## B. PRIOR ART<sup>24</sup>

Some of these instructions will refer to prior art. Prior art means technology and information that was publicly available before the date of the invention. In considering prior art, you should consider prior art that is relevant to the particular problem the inventor faced.

Prior art includes:

- (1) patents issued more than one year before the filing of the patent or before the date of the invention;
- (2) publications having a date more than one year before the filing date of the patent or before the date of the invention;
- (3) United States patents having a filing date prior to the date of the invention of the subject matter in the patent;
- (4) any process or apparatus in public use or on sale in the United States more than one year before the filing date of the patent in issue;
- (5) any process or apparatus that was publicly known or used by others in the country before the date of the invention of the claimed subject matter in the patent; and
- (6) any process or apparatus that was made or built in this country by another person before the date of the invention of the claimed subject matter in the patent and not abandoned, suppressed, or concealed.

These instructions have sometimes referred to the date of invention. In this regard, you are instructed that there are two parts to the making of an invention. The inventor has the idea of the invention. This is referred to as conception of the invention. A conception of an invention is complete when the inventor has formed the idea of how to make and use every aspect of the claimed invention and all that is required is that it be made without the need for any further inventive effort. The actual making of the invention is referred to as reduction to practice. An

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<sup>24</sup> Adapted from this Court's instructions as given in *Function Media, L.L.C. v. Google Inc.*, Civil Action No. 2:07-cv-279.

invention is said to be reduced to practice when it is made and shown to work for its intended purpose.

Under the patent laws, the latest date of invention is generally the date that the patent application was filed. This is also referred to as constructive reduction to practice. In this case, the parties agree that the date of invention is October 5, 1994.

### C. CORROBORATION<sup>25</sup>

Any witness whose testimony is asserted to invalidate a patent must be corroborated or confirmed by other evidence. Both physical evidence, such as documents and things, and oral testimony of another witness can serve to satisfy the corroboration requirement. In determining whether a witness's testimony is corroborated, you should consider the following factors:

- (1) the relationship between the witness and the corroborating witness;
- (2) the time period between the event and trial;
- (3) the interest of the corroborating witness in the subject matter in suit;
- (4) contradiction or impeachment of the witness' testimony;
- (5) the extent and details of the corroborating testimony, documents or things;  
and
- (6) the witness' familiarity with the subject matter of the patented invention and the prior use.

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<sup>25</sup> Adapted from this Court's instructions as given in *Function Media, L.L.C. v. Google Inc.*, Civil Action No. 2:07-cv-279.

#### **D. OBVIOUSNESS<sup>26</sup>**

Defendant contends that the asserted claims of the '593 patent are invalid because the invention was obvious. A patent claim is invalid if the claimed invention would have been obvious to a person of ordinary skill in the field of the invention at the time the invention was made. This means that even if all the requirements of the claim cannot be found in a single prior art reference, a person of ordinary skill in the field of the invention who knew about all of the prior art would have come up with the claimed invention at the time the invention was made.

A patent claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of known elements according to their established functions to produce a predictable result, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the requirements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known. Accordingly, you may evaluate whether such a claim would have been obvious, you may consider whether the defendant has identified a reason that would have prompted a person of ordinary skill in the field to combine the elements or concepts from the prior art in the same way as in the claimed invention, although proof of this is not a requirement to prove obviousness. Reasons that would have prompted one of ordinary skill in the field to

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<sup>26</sup> Adapted from this Court's instructions as given in *Function Media, L.L.C. v. Google Inc.*, Civil Action No. 2:07-cv-279, and the Model Patent Jury Instructions prepared by The National Jury Instruction Project and published June 17, 2009 (available at <http://www.nationaljuryinstructions.org/>).

combine the elements of the prior art in the same way as the claimed invention may be found in written references, including the prior art itself, but they may also be found within the knowledge of a person with ordinary skill in the art, including inferences and creative steps that a person of ordinary skill in the art would employ. Reasons that would have prompted a person of ordinary skill in the field to combine elements from the prior art may also be found in the nature of the problem solved by the claimed invention, or any need or problem known in the field of the invention at the time of and addressed by the invention. You may also consider whether the prior art discourages or teaches away from combining the elements. Therefore, in evaluating whether such a claim would have been obvious, you should consider a variety of factors, which I'll explain to you now.

There is no single way to define the line between true inventiveness, on the one hand, which is patentable, and the application of common sense and ordinary skill to solve a problem, on the other hand, which is not patentable. For example, market forces or other design incentives may be what produced a change rather than true inventiveness.

You may consider whether the change was merely the predictable result of using prior art elements according to their known functions or whether it was the result of true inventiveness. You may also consider whether there is some teaching or suggestion in the prior art to make the modification or combination of elements claimed in the patent. Also, you should consider whether the innovation applies a known technique that had been used to improve a similar design in a similar way. You may also consider whether the claimed invention would have been obvious to try, meaning that the claimed innovation was one of a relatively small number of possible approaches to the problem with a reasonable expectation of success by those skilled in the art.

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

The ultimate conclusion of whether a claim is obvious should be based on your determination of several factual issues. First, you must decide the level of ordinary skill in the field of the invention that someone would have had at the time the claimed invention was made. Second, you must decide the scope and content of the prior art. In determining the scope and content of the prior art, you must decide whether a reference is pertinent, or analogous, to the claimed invention. Pertinent, or analogous, prior art includes prior art in the same field of endeavor as the claimed invention, regardless of the problems addressed by the reference, and prior art from different fields reasonably pertinent to the particular problem with which the claimed invention is concerned. Remember that prior art is not limited to patents and published materials, but includes the general knowledge that would have been available to one of ordinary skill in the field of the invention. Third, you must decide what difference, if any, existed between the claimed invention and the prior art. Where these matters are in dispute, the party asserting invalidity, in this case Defendant, has the burden to establish by a preponderance of the evidence that its version of the facts is correct.

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

Factors Tending to Show Nonobviousness:

- (1) commercial success of a product due to the merits of the claimed invention;

- (2) a long-felt, but unresolved, need for the solution provided by the claimed invention;
- (3) unsuccessful attempts by others to find the solution provided by the claimed invention;
- (4) copying of the claimed invention by others;
- (5) unexpected and superior results from the claimed invention;
- (6) acceptance by others of the claimed invention, as shown by praise from others in the field of the invention or from the licensing of the claimed invention;
- (7) disclosures in the prior art that criticize, discredit, or otherwise discourage making the claimed invention and would therefore tend to show that the invention was not obvious; and
- (8) other evidence tending to show nonobviousness.

Factors Tending to Show Obviousness:

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

You may consider the presence of any of the above factors that tend to show nonobviousness as an indication that the claimed invention would not have been obvious at the time the claimed invention was made. And you may consider the presence of any of the above factors that tend to show obviousness as an indication that the claimed invention would have been obvious at such time. Although you should consider any evidence of these factors, it is up to you to decide the relevance and importance of any of them to your decision on whether the claimed invention would have been obvious.

If you find that the Defendant has proved that a claim is obvious by a preponderance of the evidence, then you must find that the claim is invalid. You must consider each asserted claim separately to determine whether it is obvious.

## E. BEST MODE<sup>27</sup>

As I have mentioned, Defendant alleges that claims 8 and 9 of the '593 patent are invalid because the inventor, Dr. Baclawski, believed there was a best way of making or using the invention defined by claims 8 and 9, but failed to disclose that best way in the patent. The obligation to disclose the best way of making or using an invention is referred to as the “best mode” requirement, and the failure to disclose what the inventor believed was the best mode for making or using the invention defined by a claim renders that claim of the patent invalid.

[Plaintiffs’ proposed instruction: Defendant must prove by clear and convincing evidence that Dr. Baclawski had a best mode and failed to disclose it.<sup>28</sup>] [Defendant’s proposed instruction: Defendant must prove by a preponderance of the evidence that Dr. Baclawski had a best mode and failed to disclose it.]

Determining whether or not an inventor failed to disclose the best mode involves answering two questions. First, you must determine if at the time the application was filed, Dr. Baclawski knew of a way, or mode, of making or using the claimed invention which he

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<sup>27</sup> Adapted from the National Patent Jury Instructions, June 17, 2009.

<sup>28</sup> On November 29, 2010, the United States Supreme Court granted Microsoft Corporation’s writ of certiorari in *Microsoft Corp. v. i4i Limited Partnership*, 598 F.3d 841 (Fed. Cir. 2010), and agreed to hear the question of whether the Federal Circuit erred in requiring Microsoft to prove its invalidity defense under 35 U.S.C. § 102(b) by clear and convincing evidence. 2010 WL 3392402 (Nov. 29, 2010). Plaintiffs propose that the Court instruct the jury to consider Defendant’s invalidity defense of obviousness under the preponderance of the evidence standard in view of the Supreme Court’s decision to grant Microsoft’s petition. Plaintiffs object to instructing the jury under the preponderance of the evidence standard for any defense under 35 U.S.C. § 112, as that issue is not before the Supreme Court and it is well established that invalidity for failing to meet one of the requirements of 35 U.S.C. § 112 must be shown by clear and convincing evidence. Defendant proposes that the Court instruct the jury to consider all of its invalidity defenses under the preponderance of the evidence standard in light of the Supreme Court’s decision to grant Microsoft’s petition. However, Google intends to preserve its rights to appeal and does not waive any such rights by offering this proposed instruction.

considered to be better than any other way. Second, if Dr. Baclawski considered one mode to be preferable to all others, you must decide whether the disclosure in the patent specification would enable a person skilled in the art to carry out that best mode.

[Defendant’s proposed instruction: An inventor’s testimony of subjective intent is not determinative of whether or not the best mode requirement has been satisfied, and you must consider all of the evidence, including reasonable inferences that can be drawn from that evidence, in deciding whether the patent is invalid for failure to satisfy the best mode requirement.] [Plaintiffs object to Defendant’s proposed language because it is contrary to the law and invites the jury to apply an incorrect standard to the extent it suggests that the Defendant need not prove that the named inventor (and no one else) “*subjectively*” believed at the time he filed his patent that there was a particular mode of practicing the invention that was superior to all others. This is the law. *See, e.g., Go Medical Indus. Pty., Ltd. v. Inmed Corp.*, 471 F.3d 1264, 1271 (Fed. Cir. 2006) (“[W]e first determine whether [named inventor] Dr. O’Neil subjectively considered a particular mode of practicing the invention to be superior to all other embodiments at the time the 1979 application was filed.”); *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, (Fed. Cir. 2002) (holding that best-mode inquiry requires determination of “whether the inventor considered a particular mode of practicing the invention to be superior to all other modes at the time of filing”). Defendant’s proposal is not found in the Model Patent Jury instructions and they point to no support for adding this misleading instruction.]

If Dr. Baclawski did not actually prefer one way of making or using the invention over other ways, there can be no violation of the best mode requirement. If Dr. Baclawski did believe there was a best way to make or use the invention, he was required to disclose that best mode of

making or using the invention in sufficient detail to enable a person of ordinary skill in the field of the invention to carry out that best mode without excessive experimentation.<sup>29</sup>

If you find that one or more of these claims failed to satisfy the best mode requirement, you must find each such claim invalid.

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<sup>29</sup>*Bayer AG v. Schein Pharms., Inc.*, 301 F.3d 1306 (Fed. Cir. 2002); *Mentor H/S Inc., v. Med. Device Alliance, Inc.*, 244 F.3d 1365 (Fed. Cir. 2001); *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 963 (Fed. Cir. 2001); *N. Telecom Ltd. v. Samsung Elec. Co.*, 215 F.3d 1281, 1286 (Fed. Cir. 2000); *Applied Materials, Inc. v. Advanced Semiconductor Am. Materials, Inc.*, 98 F.3d 1563, 1581 (Fed. Cir. 1996); *U.S. Gypsum Co. v. Nat'l Gypsum Co.*, 74 F.3d 1209, 1212 (Fed. Cir. 1996); *Transco Prods. Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 558 (Fed. Cir. 1994); *Wahl Instruments, Inc. v. Acvious, Inc.*, 950 F.2d 1575, 1581 (Fed. Cir. 1991); *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209-10 (Fed. Cir. 1991); *Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923, 928 (Fed. Cir. 1990); *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1535 (Fed. Cir. 1987); *DeGeorge v. Bernier*, 768 F.2d 1318, 1324 (Fed. Cir. 1985); *In re Gay*, 309 F.2d 769, 772 (C.C.P.A. 1962).

**F. [Defendant’s proposed instruction: WRITTEN DESCRIPTION<sup>30</sup>**

Defendant contends that claims 8 and 9 of the ’593 patent are invalid because the patent lacks an adequate written description of the claimed invention. Defendant must prove by a preponderance of the evidence that the asserted claims lacked an adequate written description.

Patent law requires that a patent application contain an adequate written description of the invention to ensure that the inventor was in possession of the invention at the time the patent application was filed. The written description requirement is satisfied if a person of ordinary skill in the field, reading the patent application as originally filed, would recognize that the patent application described the invention as it was finally claimed in the issued patent, even though the description might not use the exact words found in the issued claims. The written description is adequate if it shows that with reasonable clarity that the inventor was in possession of each claim of the invention at the time the application for the patent was filed, even though the claim may have been changed or new claims added during the prosecution of the application. If you find that one or more of the claims challenged by Defendant lacked an adequate written description, you must find each such claim invalid.<sup>31]</sup>

[Plaintiffs object to Defendant’s inclusion of any instructions regarding written description because Defendant dropped that defense with respect to claims 8 and 9 in its final

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<sup>30</sup> Adapted from the Model Patent Jury Instructions prepared by The National Jury Instruction Project and published June 17, 2009 (available at <http://www.nationaljuryinstructions.org/>).

<sup>31</sup> *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916 (Fed. Cir. 2004); *Turbocare Div. of Demag Delaval Turbomach. Corp., v. Gen. Elec. Co.*, 264 F.3d 1111, 1118 (Fed. Cir. 2002); *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956 (Fed. Cir. 2002) (*en banc*); *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320 (Fed. Cir. 2000); *Union Oil Co. of Cal. v. Atl. Richfield Co.*, 208 F.3d 989, 996-1001 (Fed. Cir. 2000); *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1478-90 (Fed. Cir. 1998); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991).

Invalidity Contentions, served on December 29, 2010. *See Cummins-Allison Corp. v. SBM Co., Ltd.*, No. 9:07-CV-196, 2009 WL 763926, \*4-\*8 (E.D. Tex. Mar. 19, 2009). To the extent the Court allows Defendant to re-assert its withdrawn written description defense, Plaintiffs believe that the jury should be instructed that the Defendant has the burden to prove its written description invalidity defense by clear and convincing evidence because that is the law. *See, e.g., Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1354 (Fed. Cir. 2010)(en banc). To the extent that the Court allows Google to re-assert its withdrawn written description defense, Plaintiffs believe that the Court should instruct the jury using Model Patent Jury Instruction 5.2, which is set forth below:

Defendant contends that claims 8 and 9 of the '593 patent are invalid for failure of the patent to provide an adequate written description of the claimed invention. Defendant must prove that it is highly probable these claims lacked an adequate written description.

The written description requirement is satisfied if a person of ordinary skill in the field, reading the patent application as originally filed, would recognize that the patent application described the invention of these claims, even though the description might not use the exact words found in the claim. The written description is adequate if it shows that the inventor was in possession of each claim of the invention at the time the application for the patent was filed, even though the claim may have been changed or new claims added during the prosecution of the application. It is not necessary that each and every aspect of the claim be explicitly discussed, as long as a person of ordinary skill would understand that any aspect not expressly discussed is implicit in the patent application as originally filed. If you find that one or more of the claims challenged by Defendant lacked an adequate written description, you must find each such claim invalid]



## VIII. DAMAGES<sup>32</sup>

### A. Damages Generally

I will now instruct you how you are to calculate damages in the event that you find that Plaintiffs have met their burden of proving that Defendant has infringed either or both of the asserted claims. If you find that Defendant has infringed either of the asserted claims of the '593 patent and that these claims are not invalid, then you should consider the amount of money Plaintiffs should receive as damages. Plaintiffs have the burden of proving by a preponderance of the evidence the amount of damages caused by Defendant's unlawful conduct.

Even though I am instructing you on how you should measure damages, this should not be taken to mean that I believe that Defendant has infringed the asserted claims or that the asserted claims are valid. Those are issues for you to resolve under the instructions that I have given you. I am instructing you on damages only so that you will have guidance should you decide that the Plaintiffs are entitled to recover.

If you find that there has been an infringement of a valid claim, Plaintiffs are entitled to an award of damages adequate to compensate them for the infringement, but in no event less than a reasonable royalty for the use the Defendant made of the invention. At the same time, your damages determination must not include additional sums to punish Defendant or to set an example. You may award compensatory damages only for the loss that Plaintiffs prove was more likely than not caused by Defendant's infringement.

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<sup>32</sup> Adapted from this Court's instructions as given in *Function Media, L.L.C. v. Google Inc.*, Civil Action No. 2:07-cv-279 and the Model Patent Jury Instructions prepared by The National Jury Instruction Project and published June 17, 2009 (available at <http://www.nationaljuryinstructions.org/>).

## **B. Damages – Burden of Proof**

Where the parties dispute a matter concerning damages, it is Plaintiffs' burden to prove that it is more probable than not that Plaintiffs' version is correct. Plaintiffs must prove the amount of damages with reasonable certainty, but need not prove the amount of damages with mathematical precision. However, Plaintiffs are not entitled to damages that are remote or speculative.<sup>33</sup>

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<sup>33</sup>*Wechsler v. Macke Intern. Trade, Inc.*, 486 F.3d 1286, 1293-94 (Fed. Cir. 2007); *Union Carbide Chems. & Plastics Tech. Corp. v. Shell Oil Co.*, 425 F.3d 1366, 1372-73 (Fed. Cir. 2005); *State Contracting & Eng'g Corp. v. Condotte Am., Inc.*, 346 F.3d 1057, 1072 (Fed. Cir. 2003); *SmithKline Diagnostics, Inc. v. Helena Labs. Corp.*, 926 F.2d 1161, 1164 (Fed. Cir. 1991); *Lam, Inc. v. Johns-Mansville Corp.*, 718 F.2d 1056, 1065 (Fed. Cir. 1983).

### **C. Reasonable Royalty -- Definition**

Plaintiffs are asking for damages in the amount of a reasonable royalty. A royalty is a payment made to a patent owner in exchange for rights to make, use or sell the claimed invention. A reasonable royalty is the payment that would have resulted from a negotiation between Plaintiffs and Defendant taking place just before the time when the first alleged infringement began. The parties in this case have agreed that the form of royalty the parties would have agreed upon during his hypothetical negotiation is a lump sum payment.

In considering the nature of this negotiation, the focus is on what the expectations of Plaintiffs and Defendant would have been had they entered into an agreement in April 2006 and acted reasonably in their negotiations. However, you must assume that both parties believed the patent was valid and infringed. In addition, you must assume that Plaintiffs and Defendant were willing to enter into an agreement; your role is to determine what that agreement would have been. The test for damages is what royalty would have resulted from the hypothetical negotiation and not simply what either party would have preferred.

In making your determination of the amount of a reasonable royalty in this case, it is important that you focus on the time period when the infringer first infringed the patent and the facts that existed at that time. In this case, the parties have agreed that the time period is April, 2006.

In determining the reasonable royalty that would have resulted from the hypothetical negotiation, you may consider real world facts including the following to the extent they are helpful to you:

- (1) Licenses or offers to license the patent at issue in this case;
- (2) Licenses involving comparable patents;

- (3) The licensing history of the parties;
- (4) Licensing practices in the relevant industry;
- (5) The relationship between Plaintiffs and Defendant, including whether or not they were competitors or whether their relationship was that of an inventor and a promoter;
- (6) [Defendant's proposed language: The established profitability of the patented product, its commercial success, and its popularity at the time] [Plaintiffs object to Defendant's proposed language on the grounds that it is unnecessary, potentially confusing, and not set forth in the Model Patent Jury Instructions];
- (7) Whether the patent owner had an established policy of refusing to license the patent at issue;
- (8) [Defendant's proposed language: Whether Jarg had an established policy of granting licenses or retaining the patented invention as its exclusive right or whether Jarg had a policy of granting licenses under special conditions designed to preserve his monopoly] [Plaintiffs object to Defendant's proposed language on the grounds that it is unnecessary because it is subsumed within Factor No. 1, set forth above, and it is potentially confusing];
- (9) [Plaintiffs' proposed language: The significance of the patented technology in promoting sales of the alleged infringer's products and earning it profit] [Defendant objects to Plaintiffs' proposed language.];
- (10) The size of the anticipated market for the invention at the time the infringement began;
- (11) The duration of the patent and of the license, as well as the terms and scope of the license, such as whether it is exclusive or nonexclusive or subject to territorial restrictions;
- (12) Whether Defendant's sales of the patented invention promote sales of its other products and whether the invention generates sales by Defendant of nonpatented items;
- (13) The utility and advantages of the patent over the old modes or devices, if any, that had been used for working out similar results;
- (14) The extent to which the infringer used the invention and any evidence probative of the value of such use;

- (15) [Plaintiffs' proposed language: The portion of the profits or cost-savings that should be credited to the invention as distinguished from nonpatented features, improvements or contributions] [Defendant's proposed language: The portion of the profits that should be credited to the invention as distinguished from nonpatented features, the manufacturing process, business risks, or significant features or improvements added by the infringer]; and
- (16) Any other economic factors which, in your mind, would have increased or decreased the royalty the infringer would have been willing to pay and the patent owner would have been willing to accept acting as normally prudent business people. [Defendant's proposed language: You may also consider evidence from after the time infringement began, for example, the amount or frequency of use of the patented invention.<sup>34</sup>] [Plaintiffs object to Defendant's proposed language on the grounds that it is unnecessary because it is duplicative of Factor No. 14, set forth above, and it is potentially confusing.]

In addition to all of these other factors, you may also consider the existence of noninfringing alternatives as one factor in determining the reasonable royalty. By definition, a noninfringing alternative must not infringe. Therefore, if you find that a proposed alternative would infringe claims 8 or 9 of the '593 patent, then it is not a non-infringing alternative and you should not consider it in determining the reasonable royalty. In addition to not infringing, a non-infringing alternative must possess all the beneficial characteristics of the patented system and have been available to the Defendant at the time the alleged infringement began. The mere existence of a competing system does not make that system an acceptable substitute. If the noninfringing alternative was not on the market at the time infringement began, the Defendant must prove that the alternative was available to it. To determine whether the alternative was available to the Defendant you must consider whether the Defendant had the necessary

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<sup>34</sup>Lucent Techs., Inc. v. Gateway, Inc., 580 F.3d 1301, 1334 (Fed. Cir. 2009).

equipment, know-how and experience to implement the noninfringing alternative at the time of the hypothetical negotiation, and not merely whether the alternative was theoretically possible.<sup>35</sup>

[Defendant's proposed instruction: You may not award damages based on the entire market value of Google's accused TeraGoogle system unless you first determine that it was the patented invention, as distinct from other non-infringing elements or features of the TeraGoogle system, that caused the consumer demand for the TeraGoogle system as a whole. In addition, the non-infringing elements or features of the accused TeraGoogle system must function together with the infringing features of the accused systems in some manner so as to produce a desired end product or result. All of the components together must be analogous to components of a single assembly or be parts of a complete machine, or they must constitute a functional unit in order for you to determine a royalty based on the entire value of the TeraGoogle system.<sup>36</sup> If you do not find that these requirements have been shown by Plaintiffs to be met, you may only award damages based on the portion of the value of the TeraGoogle system that you find has been shown by Plaintiffs to be directly attributable to the use of the patented invention.]

[Plaintiffs object to Defendant's proposed instruction regarding entire market value. Defendant's proposed instruction does not reflect the language of the Model Patent Jury Instructions. In addition, Plaintiffs dispute that entire market value is applicable to their damages model. Defendant's proposed language regarding apportionment is also redundant in light of Factor No. 14 above, which already instructs the jury on the concept of apportionment.]

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<sup>35</sup>LaserDynamics, Inc. v. Quanta Computer, Inc., 2011 WL 197869 \*2-\*3 (E.D. Tex. January 20, 2011) (citing Grain Processing Corp. v. Am. Maize Prods. Co., 185 F.3d 1341, 1354 (Fed. Cir. 1999)).

<sup>36</sup>Uniloc USA, Inc. v. Microsoft Corp., --- F.3d ---, 2011 WL 9738, at \*22 (Fed. Cir. Jan. 4, 2011).

## VIII. JUROR'S DUTIES AND DELIBERATIONS<sup>37</sup>

Nothing that I may have said or done during the course of this trial is intended to indicate any view of mine as to which party should or should not win this case. As I instructed you previously, the jury is the sole judge of the credibility of the testimony and the weight to be given the evidence. These instructions are given to you as a whole, and you are not to single out one instruction alone as stating the law, but must consider the instructions as a whole.

You have heard all of the evidence in the case, and you have heard the argument of counsel. The Court has given you the charge in this case. In a few moments, you will retire to the jury room, select one of your members to act as a foreperson, and begin performing the function for which you have been chosen and for which you have been impaneled in accordance with the oath you took as jurors.

You will remember that at the beginning of the trial and throughout the trial, the Court admonished you not to discuss with each other until it was submitted to you. Now is the time for you to begin your discussion, and you certainly may express an opinion from the evidence that you have heard and use any reasonable means to persuade other members of the jury to your convictions and to your honest opinion.

You are to reach a verdict which speaks the truth and which does justice to all parties without favor, bias, or prejudice in any particular way either for or against any party to this lawsuit.

In the course of your deliberations, do not hesitate to re-examine your own views and change your opinion, if convinced it is erroneous. But do not surrender your honest conviction as

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<sup>37</sup> Adapted from this Court's instructions as given in *Function Media, L.L.C. v. Google Inc.*, Civil Action No. 2:07-cv-279.

to the weight or effect of the evidence solely because of the opinions of your fellow jurors or for the mere purpose of returning a verdict. The verdict must represent the considered judgment of each juror. In order to return a verdict, it is necessary that each juror agree thereto. Your verdict must be unanimous. As soon as you have reached a verdict, you will let this fact be known to the officer who will be waiting upon you, and he will report to the Court.

Your verdict will be in the form of questions for you to answer. You'll take these questions to the jury room, and when you've reached unanimous agreement as to your verdict, you'll have your foreperson fill in, date, and sign the form, and then advise the court's security officer that you have reached a verdict.

During your deliberations, you will have access to all of the exhibits that have been offered in evidence. If you desire further instructions, your foreperson may make this known in writing, and the Court will try to comply with your wishes. All communications with the Court must be in writing. At no time should you indicate to the Court or to anyone else how the jury is divided in answering any particular question.

Any notes that you have taken during this trial are only aids to your 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 concerning the testimony.

I will hand the questions to the court security officer, and you will follow him into the jury room, select one of your members as foreperson, and begin your deliberations.