

# **EXHIBIT B**

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

**EOLAS TECHNOLOGIES  
INCORPORATED**

**Plaintiff,**

**v.**

**ADOBE SYSTEMS INC., et al.,**

**Defendants.**

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**CIVIL ACTION NO. 6:09-CV-00446-LED**

**JURY TRIAL**

**JOINT PROPOSED FINAL JURY INSTRUCTIONS<sup>1, 2</sup>**

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<sup>1</sup>Plaintiffs and Defendants reserve the right to modify or amend these proposed instructions prior to the Court's charge conference if so warranted. The parties, except CDW, Go Daddy and JCP, agree that for patent exhaustion, any license defense and related issues, proposing meaningfully tailored instructions—in the event all or portions of these issues are tried to a jury—requires further development of the record, including judicial guidance. Accordingly the parties, except for Defendants CDW, Go Daddy and JCP, have not included instructions on such issues here and by agreement reserve all rights to propose or oppose such instructions as the case evolves.

<sup>2</sup>While not every defendant requests every aspect of the proposed set of instructions contained herein, Defendants submit these group instructions at this stage of the case.

## **1. INITIAL INSTRUCTIONS<sup>3</sup>**

### **MEMBERS OF THE JURY:**

You have heard the evidence in this case. I will now instruct you on the law that you must apply. It is your duty to follow the law as I give it to you. On the other hand, you the jury are the judges of the facts. Do not consider any statement that I have made during the trial or make in these instructions as an indication that I have any opinion about the facts of this case.

After I instruct you on the law, the attorneys will have an opportunity to make their closing arguments. Statements and arguments of the attorneys are not evidence and are not instructions on the law. They are intended only to assist you in understanding the evidence and the parties contentions.

### **1.1 GENERAL INSTRUCTIONS**

A verdict form has been prepared for you. You will take this form to the jury room and when you have reached unanimous agreement as to your verdict, you will have your foreperson fill in, date and sign the form. Answer each question from the facts as you find them. Do not decide who you think should win and then answer the questions accordingly. Your answers and your verdict must be unanimous.

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<sup>3</sup>From the Court's Final Jury Instructions in *Alcatel-Lucent USA Inc. v. Amazon.com, Inc.*, No. 6:09-CV-422 (E.D. Tex. Oct. 2011) (Dkt. No. 482); *Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011); *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010); *VirnetX, Inc. v. Microsoft Corp.*, Civil Action No. 6:07-CV-80; *i4i Limited Partnership v. Microsoft Corp.*, Civil Action No. 6:07-CV-113; *Mass Engineered Design, Inc. v. Ergotron, Inc.*, Civil Action No. 2:06-CV-272; *z4 Tech., Inc. v. Microsoft Corp., et al.*, No. 6:06-CV-142.

In determining whether any fact has been proved in this case, you may, unless otherwise instructed, consider the testimony of all witnesses, regardless of who may have called them, and all exhibits received in evidence, regardless of who may have produced them.

## 1.2 CONSIDERING WITNESS TESTIMONY<sup>4</sup>

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

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

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

In determining the weight to give to the testimony of a witness, you should ask yourself whether there was evidence tending to prove that the witness testified falsely concerning some important fact, or whether there was evidence that at some other time the witness said or did something, or failed to say or do something, that was different from the testimony the witness gave before you during the trial.

You should keep in mind, of course, that a simple mistake by a witness does not necessarily mean that the witness was not telling the truth as he or she remembers it, because people may forget some things or remember other things inaccurately. So, if a witness has made a misstatement, you

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<sup>4</sup>Verbatim from the Court's Final Jury Instructions in *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010); *see also Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011).

need to consider whether that misstatement was an intentional falsehood or simply an innocent lapse of memory; and the significance of that may depend on whether it has to do with an important fact or with only an unimportant detail.

### 1.3 HOW TO EXAMINE THE EVIDENCE<sup>5</sup>

Certain testimony in this case has been 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, the 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. This deposition testimony is entitled to the same consideration and is to be judged by you as to credibility and weight and otherwise considered by you insofar as possible the same as if the witness had been present and had testified from the witness stand in court. In addition, neither party is required to call every possible witness to the stand.

While you should consider only the evidence in this case, you are permitted to draw such reasonable inferences from the testimony and exhibits as you feel are justified in the light of common experience. In other words, you may make deductions and reach conclusions that reason and common sense lead you to draw from the facts that have been established by the testimony and evidence in the case.

The testimony of a single witness may be sufficient to prove any fact, even if a greater number of witnesses may have testified to the contrary, if after considering all the other evidence you believe that single witness.

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<sup>5</sup>From the Court's Final Jury Instructions in *Alcatel-Lucent USA Inc. v. Amazon.com, Inc.*, No. 6:09-CV-422 (E.D. Tex. Oct. 2011) (Dkt. No. 482); *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010); *see also Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011).

There are two types of evidence that you may consider in properly finding the truth as to the facts in the case. One is direct evidence such as testimony of an eyewitness. The other is indirect or circumstantial evidence—the proof of a chain of circumstances that indicates the existence or nonexistence of certain other facts. As a general rule, the law makes no distinction between direct and circumstantial evidence, but simply requires that you find the facts from a preponderance of all the evidence, both direct and circumstantial.

The parties have stipulated, or agreed, to some facts in this case. When the lawyers on both sides stipulate to the existence of a fact, you must, unless otherwise instructed, accept the stipulation as evidence, and regard that fact as proved.



## **1.4 EXPERT WITNESSES**

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

## 2. PROPOSED SUMMARY OF CONTENTIONS

I will first give you a summary of each side’s contentions in this case. I will then tell you what each side must prove to win on these issues.

Plaintiffs, The Regents of The University of California, referred to as “The University of California,” and Eolas Technologies Incorporated, referred to as “Eolas,” **[Defendants propose: referred to as Plaintiffs]**<sup>6</sup> contend that the Defendants Adobe Systems Inc. (“Adobe”), Amazon.com, Inc. (“Amazon”), CDW Corp. (“CDW”), Citigroup Inc. (“Citigroup”), The Go Daddy Group, Inc. (“Go Daddy”), Google Inc. (“Google”), YouTube LLC (“YouTube”), J. C. Penney Company, Inc. (“J.C. Penney”), Staples, Inc. (“Staples”) and Yahoo! Inc. (“Yahoo”) (collectively, “Defendants”) have in the past and/or continue to directly and/or indirectly infringe, by way of inducement and/or contributory infringement of certain claims of U.S. Patent No. 5,838,906 (“the ’906 patent”) and U.S. Patent No. 7,599,985 (“the ’985 patent”), by providing the embedded interactive functionalities on their accused websites, listed on Appendix B attached to these instructions.<sup>7,8,9</sup> The Regents of the University of California and Eolas assert also that Adobe’s,

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<sup>6</sup>**Defendants request that for purposes of parity, references to the “University of California and Eolas” throughout be replaced by “Plaintiffs,” as Defendants are referred to collectively throughout.**

<sup>7</sup>**Google objects to the listing of “google.com” as an accused website on Appendix B.**

<sup>8</sup>**CDW objects to the inclusion of “live.netgear.webcollage.net” on Appendix B because it is not a CDW website. CDW further objects to the characterization “providing the embedded interactive functionalities on their accused websites” because this statement presupposes facts that are in dispute.**

<sup>9</sup>**Yahoo! objects to the inclusion of selfcare.hotjobs.yahoo.com on Appendix B because Yahoo! no longer operates a website at selfcare.hotjobs.yahoo.com.**

Amazon's, Citigroup's, Google's and Yahoo's infringement is willful. The University of California and Eolas are seeking damages for Defendants' alleged infringement.

Defendants contend that they do not directly infringe any claim of the patents-in-suit. Defendants also contend that they have not indirectly infringed the patents-in-suit by either inducing others to infringe and/or contributorily infringing the patents-in-suit. Furthermore, Defendants deny that they have willfully infringed. You must determine infringement separately with respect to each Defendant. Defendants also contend that the Asserted Claims of the patents-in-suit are invalid.<sup>10</sup> Invalidity is a defense to infringement. Generally, Defendants contend that the '906 and '985 patents are invalid because the claimed inventions were not new, would have been obvious to one of ordinary skill in the art and fail to have an adequate written description. **[Defendants propose: Defendants also contend that the patent is unenforceable because of inequitable conduct by the patent owner during the Patent Office proceedings.]<sup>11</sup>** As such, Defendants contend that Plaintiffs are not entitled to any damages.]

Your job is to decide whether the asserted claims of the '906 Patent and the '985 Patent have been infringed, by when they have been infringed, and whether any of the asserted claims of those patents are invalid **[Defendants propose: and/or unenforceable<sup>12</sup>]. [UC and Eolas propose: Therefore, even though the United States Patent and Trademark Office or "Patent Office" examiner has allowed the claims of the '906 Patent and the '985 Patent, you, the jury, must**

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<sup>10</sup> AIPLA's Model Patent Jury Instructions at § II.

<sup>11</sup> **The Regents of the University of California and Eolas object because the defense of unenforceability is equitable in nature and should be decided by the Court.**

<sup>12</sup> ***Id.***

**decide whether the claims of the patents are invalid.] [Defendants propose: If you decide that any of the Asserted Claims have been infringed by any Defendant and is also not invalid and not unenforceable, you will then need to decide the amount of money damages to be awarded to Plaintiffs as compensation for the infringement.<sup>13]</sup>**

### **3. INSTRUCTION ON THE BURDENS OF PROOF**

**[UC and Eolas propose: As I told you at the beginning of the trial, in any legal action, facts must be proved by a required amount of evidence, known as the “burden of proof.” In a patent case such as this, there are two different burdens of proof that are used. The first is the “preponderance of the evidence” standard and the second is the “clear and convincing” standard.**

**The “preponderance of the evidence” standard means that the evidence persuades you that a claim is more likely true than not true.**

**The “clear and convincing” standard means that the evidence produces in your mind a firm belief or conviction as to the matter at issue. The clear and convincing evidence standard requires greater proof than is necessary for the preponderance of the evidence standard.**

**The Regents of the University of California and Eolas have the burden of proving infringement by a preponderance of the evidence. If the proof establishes that all essential parts of Plaintiffs’ infringement claims are more likely true than not true, then you should find for Plaintiffs as to these claims.**

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<sup>13</sup> **The Regents of the University of California and Eolas object because the defense of unenforceability is an equitable defense and should be decided by the Court.**

As issued United States patents, the '906 Patent and the '985 Patent are presumed to be valid. Defendants have the burden of overcoming that presumption and proving invalidity by clear and convincing evidence.<sup>14</sup> In determining whether any fact has been proved by clear and convincing evidence, you may, unless otherwise instructed, consider stipulations, the testimony of all witnesses regardless of who may have called them, and all exhibits received in evidence regardless of who may have produced them. The clear and convincing evidence standard requires a greater degree of proof than is necessary for the preponderance of the evidence standard. The proof must establish a firm belief or conviction in your mind that the invalidity claims are correct, for you to find that the '906 Patent and the '985 Patent are invalid.<sup>15</sup>]

[Defendants propose: For Plaintiffs' claims, the burden of proof is on Plaintiffs. Defendants have the burden of proof for their affirmative defenses. Infringement determinations are made on a claim-by-claim basis. Plaintiffs have the burden of proving infringement and damages. Plaintiffs must prove infringement and damages by a preponderance of the evidence. Validity determinations are made on a claim-by-claim basis.

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<sup>14</sup>Defendants object to this proposed instruction as redundant and potentially confusing. *See National Jury Instruction Project, Model Patent Jury Instructions, Instruction 5.1 (June 17, 2009)* (“The presumption of validity, like all legal presumptions, is a procedural device. In light of the procedural role of the presumption of validity, instructing the jury on the presumption in addition to informing it of the highly probable burden of proof may cause jury confusion as to its role in deciding invalidity.”)

<sup>15</sup>The instructions proposed by the Regents of the University of California and Eolas are adapted from the Court’s Final Jury Instructions in *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010); *VirnetX, Inc. v. Microsoft Corp.*, Civil Action No. 6:07-CV-80; *i4i Limited Partnership v. Microsoft Corp.*, Civil Action No. 6:07-CV-113; *Mass Engineered Design, Inc. v. Ergotron, Inc.*, Civil Action No. 2:06-CV-272; *z4 Tech., Inc. v. Microsoft Corp., et al.*, No. 6:06-CV-142.

**Defendants have the burden of proving invalidity of the '906 and '985 patents. Defendants must prove invalidity by clear and convincing evidence. Inequitable conduct as to one claim renders the entire patent unenforceable. Defendants must prove unenforceability by clear and convincing evidence.<sup>16</sup>**

**When a party has the burden of proof on any claim or defense by a preponderance of the evidence, that means the evidence must persuade you that that claim or defense is more probable than not. Clear and convincing evidence means evidence that convinces you that the claim or defense is highly probable.<sup>17</sup> This is a higher burden of proof than proof by a preponderance of the evidence.]**

In determining whether any fact has been proved, you should, unless otherwise instructed, consider all of the evidence, including the stipulations, the testimony of all witnesses regardless of who may have called them, and all exhibits received in evidence regardless of who may have produced them.

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<sup>16</sup> **The Regents of the University of California and Eolas object to this instruction because the defense of unenforceability is an equitable defense to be tried to the Court.**

<sup>17</sup> **AIPLA Model Patent Jury Instructions § II.**

#### 4. MEANING OF THE CLAIM TERMS<sup>18</sup>

##### 4.1 PATENT CLAIMS

**[UC and Eolas propose: At the beginning of the trial, I gave you some general information about patents and the patent system and a brief overview of the patent laws relevant to this case. I will now give you more detailed instructions about the patent laws that specifically relate to this case. If you would like to review my instructions at any time during your deliberations, they will be available to you in the jury room.]**

As I told you at the beginning of trial, the claims of a patent are the numbered sentences at the end of the patent. The claims describe the invention made by the inventor and describe what the patent owner owns and what the patent owner may prevent others from doing. Claims may describe **[UC and Eolas propose: methods, products, such as machines or chemical compounds, or processes for making or using a product]** **[Defendants propose: products or systems, or methods for using a product or system].**

Claims are usually divided into parts or steps, called “limitations” or “elements” or “requirements.” For example, a claim that covers the invention of a table may recite the tabletop, four legs, and the glue that secures the legs to the tabletop. The tabletop, legs, and glue are each a separate limitation or requirement of the claim.

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<sup>18</sup>Adapted from the Court’s Final Jury Instructions in *Alcatel-Lucent USA Inc. v. Amazon.com, Inc.*, No. 6:09-CV-422 (E.D. Tex. Oct. 2011) (Dkt. No. 482); *Cheetah Omni LLC v. Verizon Services Corp.*, No. 6:09-CV-260 (E.D. Tex. March 2011); *Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011); *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010).

## 4.2 INSTRUCTIONS ON CONSTRUCTION OF THE CLAIMS<sup>19</sup>

In deciding whether or not an accused **[UC and Eolas propose: instrumentality or method of use]** **[Defendants propose: method or product]** infringes a patent, the first step is to understand the meaning of the words used in the patent claims.

It is my job as Judge to determine what the patent claims mean and to instruct you about that meaning. You must accept the meanings I give you and use those meanings when you decide whether or not the patent claims are infringed, and whether or not they are invalid **[Defendants propose: and/or enforceable<sup>20</sup>]**. I have interpreted the meaning of some of the language in the patent claims involved in this case. Before I instruct you about the meaning of the words of the claims, I will explain to you the different types of claims that are at issue in this case. It may be helpful to refer to the copies of the patents that you have been given as I discuss the claims at issue here.

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<sup>19</sup>Adapted from the Court's Final Jury Instructions in *Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011); *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010).

<sup>20</sup>**The Regents of the University of California and Eolas object because the defenses of unenforceability are equitable in nature and should be decided by the Court.**



#### 4.3 OPEN-ENDED OR “COMPRISING” CLAIMS<sup>21</sup>

The beginning, or preamble, of Claims 1 and 6 of the '906 Patent use the word “comprising.” Claims 1, 16, 20, 36, and 40 of the '985 Patent use the words “comprising” or “comprises.” “Comprising” and “comprise” mean “including” or “containing but not limited to.” That is, if you decide that an accused product or the use of an accused product includes all the requirements or steps in that claim, the claim is infringed. This is true even if the accused method includes components or steps in addition to those requirements.

For example, a claim to a table comprising a tabletop, legs, and glue would be infringed by a table that includes a tabletop, legs, and glue, even if the table also includes wheels on the table's legs.<sup>22</sup>

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<sup>21</sup>Adapted from the Court's Final Jury Instructions in *Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011); *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010)

<sup>22</sup>Adapted from the Court's Final Jury Instructions in *Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011); *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010)

#### **4.4 INDEPENDENT AND DEPENDENT CLAIMS**

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

In this case, Claims 1 and 6 of the '906 patent and claims 1, 16, 20, 36, and 40 of the '985 patent are independent claims.

A dependent claim refers to at least one other claim in the patent. A dependent claim includes each of the limitations of the other claim to which it refers, as well as the additional limitations recited in the dependent claim itself. In this way, the claim “depends” on another claim. To determine what a dependent claim covers, it is necessary to look at both the dependent claim and any other claim or claims to which it refers. Claims 3, 10, 18, 22, 38, and 42 of the '985 patent are dependent claims.

In order to find infringement of a dependent claim, you must first determine whether the independent claim to which it refers has been infringed. Thus, you must consider all limitations of both the dependent claim and independent claim from which it depends. If you decide that the independent claim has not been infringed, then the dependent claim cannot have been infringed. If you decide that the independent claim has been infringed, you must then separately determine whether each additional requirement of the dependent claim has also been included in the accused product. If each additional requirement has been included, then the dependent claim has been infringed.

**[Defendants propose: For example, claim 3 of the '906 Patent is a dependent claim of independent claim 1. Because dependent claim 3 includes all of the limitations of claim 1, if claim 1 is not infringed, then claim 3 cannot be infringed either.<sup>23</sup>]**

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<sup>23</sup>Adapted from *Alcatel-Lucent USA Inc. v. Amazon.com, Inc.*, No. 6:09-CV-422 (E.D. Tex. Oct. 2011) (Dkt. No. 482); *Cheetah Omni, LLC v. Verizon Services Corp., et al.*, No. 6:09-CV-260 (E.D. Tex. March 2011) (Dkt. No. 437).

#### 4.5 INTERPRETATION OF CLAIMS<sup>24</sup>

In deciding whether or not the accused technology does or does not infringe a patent claim, or whether the asserted prior art does or does not invalidate a patent claim, the first step is to understand the meaning of the words used in the patent claims. The meaning given to the words in the patent claims must be the same for all issues in the case.

As I stated earlier, it is my job as Judge to determine what the patent claims mean and to instruct you about that meaning. In accordance with that duty, I have interpreted the meaning of some of the language in the patent claims involved in this case. My interpretation of those claims appears in Appendix A<sup>25</sup> to this Charge. You must accept the interpretations contained in Appendix A as correct. The claim language I have not interpreted for you in Appendix A is to be given its ordinary and accustomed meaning as understood by one of ordinary skill in the field of technology.

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<sup>24</sup> Adapted from *Alacatel-Lucent USA Inc. v. Amazon.com, Inc.*, No. 6:09-CV-422 (E.D. Tex. Oct. 2011) (Dkt. No. 482); *Cheetah Omni, LLC v. Verizon Services Corp., et al.*, No. 6:09-CV-260 (E.D. Tex. March 2011) (Dkt. No. 437).

<sup>25</sup> **Defendants object to the inclusion of the claims column in Plaintiffs' proposed Appendix A as confusing and unnecessary; in addition, the chart is incorrect to the extent that Plaintiffs do not list terms as appearing in dependent claims where the claims from which those claims depend include particular terms. By inclusion of the attached chart, Defendants do not waive any rights regarding objections to the Court's claim constructions in this case.**

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

A glossary of patent terms is also contained in Appendix C to this charge.

## 5. INFRINGEMENT

### 5.1 DETERMINING INFRINGEMENT<sup>26</sup>

Any person or business entity that, without the patent owner's permission, makes, uses, sells, or offers to sell **[UC and Eolas propose: an instrumentality or method of use]** **[Defendants propose: a product or method]** that is covered by at least one claim of a patent, before the patent expires, infringes the patent. In this case, The Regents of the University of California and Eolas assert that Defendants have infringed certain claims of the '906 Patent and the '985 Patent. Plaintiffs have the burden of proving infringement by a preponderance of the evidence.

Only the claims of a patent can be infringed. You must consider each claim individually. You must compare each of the asserted claims, as I have defined them, to each of Defendants' accused **[UC and Eolas propose: instrumentalities or methods of use,]** **[Defendants propose: products and methods,]** and determine whether or not there is infringement. There may be infringement as to one claim but no infringement as to another. You must decide infringement as to each Defendant separately, and you must also consider each accused product individually.

In order to prove infringement, Plaintiffs must prove that by a preponderance of the evidence that Defendants' accused **[UC and Eolas propose: instrumentality]** **[Defendants propose: products]** and methods include each and every requirement or limitation of the claims. If Defendants' accused systems or methods omit any requirement recited in the asserted patent claims, then there is no infringement for that claim.

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<sup>26</sup>*Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011).

## 5.2 DIRECT INFRINGEMENT – LITERAL INFRINGEMENT<sup>27</sup>

You must decide whether Defendants have made, used, sold or offered for sale within the United States apparatuses, instrumentalities or methods covered by one or more of the asserted claims of the '906 Patent and the '985 Patent. You must compare each claim to the Defendants' accused **[UC and Eolas propose: instrumentalities or methods of use]** **[Defendants propose: products or methods]** to determine whether every requirement of the claim is included in the accused **[UC and Eolas propose: instrumentality or method of use]** **[Defendants propose: products or methods]**.

To prove literal infringement, Plaintiffs must prove **[UC and Eolas propose: by a preponderance of the evidence]** **[Defendants propose: that it is more probable than not]** that a Defendant's accused **[UC and Eolas propose: instrumentality or method of use]** **[Defendants propose: products or methods]** includes every requirement or step in a single claim of the '906 Patent and the '985 Patent. **[UC and Eolas propose: Technologies that did not exist at the time a patent application was filed or issued may be found to literally infringe if those technologies are captured within the literal scope of the patent claim.<sup>28</sup>]** If a Defendant's **[UC and Eolas propose: instrumentality or method of use]** **[Defendants propose: products or methods]** omit any limitations or requirement in Plaintiffs' patent claims, the Defendant does not infringe that

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<sup>27</sup>Adapted from the Court's Final Jury Instructions in *Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011); *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010); The National Jury Instruction Project, MODEL PATENT JURY INSTRUCTIONS, Instruction 3.2 (June 17, 2009).

<sup>28</sup>***Innogenics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1371-72 (Fed. Cir. 2008).**

claim. In making your determination, you must consider each claim separately, and each accused instrumentality and method of use separately.

For direct infringement, the Plaintiffs are not required to prove that a Defendant intended to infringe or knew of the '906 Patent and '985 Patent.<sup>29</sup>

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<sup>29</sup>In Court's Final Jury Instructions in *Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011); *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010); The National Jury Instruction Project, MODEL PATENT JURY INSTRUCTIONS, Instruction 3.2 (June 17, 2009).



### **5.3 [DEFENDANTS PROPOSE: DIRECT INFRINGEMENT–DIVIDED INFRINGEMENT**

**If a single entity does not itself satisfy every requirement in the patent claim through its own technology or actions, that Defendant cannot be liable for infringement merely because other parties added missing elements, unless that Defendant directed or controlled those parties so as to obligate them to provide the missing elements in an infringing manner. A Defendant does not direct or control someone else’s equipment or actions merely because the Defendant entered into a relationship with that person. Instead, as noted, the Defendant must specifically obligate the other person to perform the missing acts or to supply the missing technology in an infringing manner, so that every step is attributable to the Defendant as the controlling party.<sup>30</sup>**

**Similarly, a person directly infringes a system by using a claimed system. To use a system or a computer-readable medium in a system for purposes of direct infringement, a person must put every element of the invention collectively into service. In order to put the invention into service, the end user must be using all portions of the claimed invention, controlling the system as a whole and obtaining benefit from it. A person need not exercise physical or direct control over each individual element of the system in order for there to be an infringing use. If you find that Defendants only supply software or back-end processing**

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<sup>30</sup>**Sources: Model Patent Jury Instructions for the Northern District of California, at 3.3 (Nov. 3, 2011) (citing *Cross Med. Prods. v. Medtronic Sofamor Danek*, 424 F.3d 1293 (Fed. Cir. 2005); *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373 (Fed. Cir. 2007) and noting that the issue of divided infringement is the subject of two en banc cases currently pending: *Akamai Technologies, Inc. v. Limelight Networks, Inc.*, 629 F.3d 1311, (Fed.Cir. 2010) and *McKesson Techs. v. Epic Sys. Corp.*, 2011 WL 2173401 (Fed. Cir. May 26, 2011).**

elements for their customers to use, then Defendants themselves do not use the claimed system.<sup>31]</sup>

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<sup>31</sup> ***Centillion Data Sys., LLC v. Qwest Comm'ns Int'l***, 631 F.3d 1279, 1284-86 (Fed. Cir. 2011).

## 5.4 INDIRECT INFRINGEMENT

Plaintiffs allege that Defendants indirectly infringed the patent. There are two types of indirect infringement: inducing infringement and contributory infringement. The act of encouraging or inducing others to infringe a patent is called “inducing infringement.” The act of contributing to the infringement of others by, for example, supplying them with components for use in the patented invention, is called “contributory infringement.”<sup>32</sup>

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<sup>32</sup> Sources: THE NATIONAL JURY INSTRUCTION PROJECT’S MODEL PATENT JURY INSTRUCTIONS, at 3.10 (2009) (citing 35 U.S.C. §§ 271(b), (c)).

**5.5 JUC AND EOLAS PROPOSE: INDIRECT INFRINGEMENT – INDUCING INFRINGEMENT<sup>33 34</sup>**

**The Regents of the University of California and Eolas allege that Defendants are also liable for infringement by actively inducing others to directly infringe the '906 and '985 Patents. As with direct infringement, you must determine whether there has been active inducement on a claim-by-claim basis.**

**A person is liable for active inducement of a claim only if:**

- (1) the person takes action during the time the patent is in force which encourages acts by someone else; and**
- (2) the encouraged acts constitute direct infringement of that claim; and**
- (3) the person is aware of the patent, and knows or should have known that the encouraged acts constitute infringement of that patent; and**
- (4) the person has an intent to cause the encouraged acts; and**
- (5) the encouraged acts are actually carried out by someone else.**

**In order to prove active inducement, Plaintiffs must prove that each of the above requirements is met. Further, proof of each element must be by a preponderance of the evidence, i.e., that it is more likely than not that each of the above requirements has been met.**

**In considering whether Defendants have induced infringement by others, you may consider all the circumstances, including whether or not Defendants obtained the advice of a competent lawyer, whether or not Defendants knew of the patents when designing and utilizing**

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<sup>33</sup>Adapted from *VirnetX, Inc. v. Microsoft Corp.*, Civil Action No. 6-07-CV-80 LED (E.D. Tex. March 15, 2010).

<sup>34</sup> The parties will continue to meet and confer to narrow their disagreements with respect to the instruction on inducing infringement.

**their products and methods, and whether or not Defendants removed or diminished the allegedly infringing features. You may not assume that merely because a Defendant did not obtain an opinion of counsel, the opinion would have been unfavorable.**

**Intent to cause the acts that constitute direct infringement may be demonstrated by evidence of active steps taken to encourage direct infringement, such as advertising an infringing use or instructing how to engage in an infringing use. In order to establish active inducement of infringement, it is not sufficient that the Defendant was aware of the act(s) that allegedly constitute the direct infringement. Rather, you must find specifically that the Defendant intended to cause the acts that constitute the direct infringement and must have known or should have known that its action would cause the direct infringement. If you do not find that the Defendant specifically meets these intent requirements, then you must find that the Defendant has not actively induced the alleged infringement.]**

## **5.6 [DEFENDANTS PROPOSE: INDUCING PATENT INFRINGEMENT]**

**A party induces patent infringement if it purposefully encourages another to infringe the claims of a patent. If there is no direct infringement by anyone of that claim, there can be no induced infringement. That means that Plaintiffs must either prove that accused products necessarily infringe the asserted claim or prove specific acts of direct infringement by others that were induced by Defendants. Inducing infringement cannot occur innocently. This is different from direct infringement. To prove that Defendants induced patent infringement, Plaintiffs must prove that it is more probable than not that:**

- 1. Defendants actively encouraged another person on how to use a product or perform a process in a way that infringes at least one Asserted Claim;**
- 2. Defendants knew of the patent at that time;**
- 3. Defendants knew that the induced acts constituted infringement of at least one Asserted Claim of a valid and enforceable patent; and**
- 4. the other person infringed at least that one Asserted Claim.**

**Plaintiffs must prove that Defendants had a specific intent to induce infringement. Plaintiffs must prove that Defendants knowingly induced infringement, not merely that Defendants knowingly induced the acts that constitute infringement. It is not enough that the Defendant was reckless in its treatment of the plaintiff's patent rights. Nor is it enough that a Defendant took a risk that was substantial and unjustified. Knowledge that it was encouraging patent infringement is required.**

**If a Defendant offers legitimate defenses to infringement claims or credible invalidity or unenforceability arguments, then that Defendant cannot have acted with the required knowledge to support a finding of inducement.<sup>35</sup>**

**Plaintiffs must further prove the number of direct acts of infringement of the asserted claims because the amount of damages for induced infringement is limited by the number of specific instances of infringement.<sup>36</sup>**

**A Defendant’s reliance on advice given by their lawyers is one factor you may consider in deciding whether that Defendant believed that it was not encouraging infringement of the patent, or that the patent was invalid.<sup>37</sup> Nevertheless, there is no duty to obtain advice from lawyers and you should not consider the fact that a Defendant did not present evidence of reliance on advice given by their lawyers as a factor to suggest that a Defendant knew it was encouraging infringement of the patent or that the patent was valid and enforceable.<sup>38]</sup>**

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<sup>35</sup> **Source: *See Black & Decker, Inc. v. Robert Bosch Tool Corp.*, 260 Fed. Appx. 284, 291 (Fed. Cir. 2008) (“[L]egitimate defenses to infringement claims and credible invalidity arguments demonstrate the lack of an objectively high likelihood that a party took actions constituting infringement of a valid patent.”).**

<sup>36</sup> **The National Jury Instruction Project, Model Patent Jury Instruction No. 3.11; N.D. Cal. Model Patent Jury Instr. No. 3.10; 35 U.S.C. § 271(b); *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 206, 2068 (2011); *DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293, 1306 (Fed. Cir. 2006).**

<sup>37</sup> **Sources: Model Patent Jury Instructions for the Northern District of California, at 3.9 (Nov. 3, 2011) (citing 35 U.S.C. § 271(b); *Global-Tech Appliances, Inc. et. al. v. SEB S.A.*, 131 S.Ct. 2060 (2011)).**

<sup>38</sup> **Sources: *In re Seagate Technology, LLC*, 497 F.3d 1360, (Fed. Cir. 2007); *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337, 1344-46 (Fed.Cir.2004) (en banc); Model Patent Jury Instructions for the Northern District of California, at 3.10 (Nov. 3, 2011).**

**5.7 UC AND EOLAS PROPOSE: INDIRECT INFRINGEMENT – CONTRIBUTORY INFRINGEMENT<sup>39</sup> <sup>40</sup>**

**The Regents of the University of California and Eolas allege that Defendants are liable for contributory infringement by contributing to the direct infringement on the '906 Patent and the '985 Patent by another. As with direct infringement, you must determine whether there has been contributory infringement on a claim-by-claim basis.**

**It is not necessary to show that the Defendant has directly infringed as long as you find that someone has directly infringed. If there is no direct infringement by anyone, the Defendant cannot have contributed to the infringement of the patent.**

**If you find someone has directly infringed the '906 Patent and the '985 Patent, then contributory infringement exists if Plaintiffs establish by a preponderance of the evidence that:**

- (1) the Defendant sold, offered for sale, or imported;**
- (2) a material component of the product, or material component used in a product or in practicing the patented method, which can be software, that is not a staple article of commerce suitable for substantial non-infringing use;**
- (3) with knowledge that the component was especially made or adapted for use in an infringing manner.**

**A “staple article of commerce suitable for substantial non-infringing use” is something that has uses other than as a component of the product or patented method. A substantial**

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<sup>39</sup>**Adapted from *VirnetX, Inc. v. Microsoft Corp.*, Civil Action No. 6-07-CV-80 LED (E.D. Tex. March 15, 2010).**

<sup>40</sup>The parties will continue to meet and confer to narrow their differences with respect to the instruction on contributory infringement.



**non-infringing use is one that is not occasional, farfetched, impractical, experimental, or hypothetical.**

**In determining whether or not the component is a staple article of commerce suitable for substantial non-infringing use, you should focus on whether the component itself, not the product in which the component is embedded, is or is not suitable for substantial non-infringing use. Whether the product in which the component is embedded is or is not suitable for substantial non-infringing use is not relevant.]**

## **5.7 [DEFENDANTS PROPOSE: CONTRIBUTORY INFRINGEMENT]**

**Contributory infringement occurs when a party with knowledge of the patent sells, offers to sell, or imports within the United States a part, or a component, for another to use in a product, machine, or process that infringes a patent claim. Plaintiffs must prove that it is more probable than not that contributory infringement occurred.**

**In order for there to be contributory infringement by Defendants, someone other than Defendants must directly infringe an asserted claim; if there is no direct infringement of that claim by anyone, there can be no contributory infringement. To prove direct infringement, Plaintiffs must either prove that the accused product necessarily infringes an asserted claim or prove specific acts of direct infringement by others.**

**Contributory infringement arises only if one who received the component infringes a patent claim. The component must also have the following three characteristics.**

- 1. the component must be a significant part of the invention;**
- 2. the component must be especially made or adapted for use in a way that infringes at least one claim of the patent, and the supplier must know that the component was especially made for that use; and**
- 3. the component must not have a significant non-infringing use.**

**A component that has a number of non-infringing uses is often referred to as a staple or commodity article. Providing such a staple or commodity article is not contributory infringement even if the person receiving or buying the article uses it in an infringing way.<sup>41</sup>**

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<sup>41</sup> Sources: The National Jury Instruction Project’s Model Patent Jury Instructions, at 3.11 (2009) (citing 35 U.S.C. §271(c) (2001); *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005); *Ricoh Co., Ltd. v. Quanta Computer Inc.*, 550 F.3d 1325, 1340 (Fed. Cir. 2008); Bryan A. Garner, ed., BLACK’S LAW DICTIONARY (8th ed. 2004) (“material[:] Of such

**If a Defendant offers legitimate defenses to infringement claims or credible invalidity or unenforceability arguments, then that Defendant cannot have acted with the required knowledge to support a finding of inducement.<sup>42</sup> You must also find that Defendants sold or offered for sale the component to that person with knowledge of the asserted patent and knowledge that the component was especially made or adapted for use in an infringing manner. It is not enough that the Defendant was reckless in its treatment of the plaintiff's patent rights. Nor is it enough that a Defendant took a risk that was substantial and unjustified. Knowledge that it was encouraging patent infringement is required.<sup>43</sup>**

**You may not find Defendants liable merely for transferring or supplying accused products to others. Rather, you must find that Defendants sold or offered for sale accused products. A sale requires a transfer of the component for a price. Therefore, if you find that Defendants make accused products available for free, you may not find Defendants liable for contributory infringement.**

**Finally, Defendants can be liable for contributory infringement only if you find that the copies of accused products sold or offered for sale by Defendants were the same actual, tangible copies used by another person to directly infringe. If you find that the other person copies accused products and uses those copies in an infringing product, then you may not find**

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**a nature that knowledge of the item would affect a person's decision-making; significant; essential").**

<sup>42</sup>**Source: *See Black & Decker, Inc. v. Robert Bosch Tool Corp.*, 260 Fed. Appx. 284, 291 (Fed. Cir. 2008) (“[L]egitimate defenses to infringement claims and credible invalidity arguments demonstrate the lack of an objectively high likelihood that a party took actions constituting infringement of a valid patent.”).**

<sup>43</sup>***Global-Tech Appliances, Inc. et. al. v. SEB S.A.*, 131 S.Ct. 2060 (2011).**

**Defendants liable for contributory infringement. Likewise, if you find that Defendants sell or offer to sell only source code, you may not find Defendants liable for contributory infringement because source code cannot be a tangible component.<sup>44]</sup>**

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<sup>44</sup> **The National Jury Instruction Project, Model Patent Jury Instruction No. 3.12; 35 U.S.C. § 271(c); *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060, 2067 (2011); *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437 (2007); *Enercon GmbH v. ITC*, 151 F.3d 1376, 1381-82 (Fed. Cir. 1998); *PharmaStem Therapeutics, Inc. v. Viacell, Inc.*, 491 F.3d 1342, 1356-59 (Fed. Cir. 2007); *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1319 (Fed. Cir. 2005); *Rotec Indus., Inc. v. Mitsubishi Corp.*, 215 F.3d 1246, 1254-55 (Fed. Cir. 2000); *HollyAnne Corp. v. TFT, Inc.*, 199 F.3d 1304, 1308-09 (Fed. Cir. 1999).**

**5.8 [DEFENDANTS PROPOSE: PATENT EXHAUSTION<sup>45 46</sup>**

**Defendants contend that, based upon the doctrine of patent exhaustion, Plaintiffs are not entitled to damages for allegedly infringing products used in conjunction with Microsoft and Apple products. Patent exhaustion means that the initial authorized sale or license of a patented item terminates all rights to that item. The recipient of a licensed product may use the product free of the patent. A patentee therefore cannot recover damages when the accused products are licensed.**

**In this case the parties agree that Microsoft and Apple are licensed under the patents, but they dispute the scope of the licenses. Defendants contend that, as a result of those licenses, Plaintiffs have exhausted its patent rights for accused products used in any way with a Microsoft or Apple product. Plaintiffs contend that the licenses apply only when a Microsoft or Apple product satisfies an element of a patent claim. You must determine whether the Microsoft and Apple licenses apply to any use of Microsoft or Apple products or whether they apply only when a Microsoft or Apple products satisfies a claim element.**

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<sup>45</sup>**The following defendants contend that this issue should be tried to the bench: Adobe Systems Inc., Amazon.com, Inc., Citigroup Inc., Google Inc., Staples, Inc., Yahoo! Inc., and YouTube, LLC. These defendants propose this conditional instruction to be used if the Court submits this issue to the jury for an advisory verdict. Defendants Go Daddy, JCP, and CDW, however, contend that this issue should be decided by the Court on summary judgment. But if the Court denies summary judgment, Go Daddy, JCP, and CDW contend that this issue should be tried to the jury and that the Court should issue this instruction.**

<sup>46</sup>**The Regents of the University of California and Eolas also contend this issue should be tried to the Court.**

**Although you should consider the Microsoft and Apple licenses for the purpose of rendering your verdict as to patent exhaustion, you should not use those licenses for any other purpose.<sup>47]</sup>**

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<sup>47</sup> ***Quanta Computer, Inc. v. LG Elecs., Inc.*, 553 U.S. 617, 625 (2008).**

## 6. WILLFUL INFRINGEMENT<sup>48</sup>

In this case, The Regents of the University of California and Eolas argue that the Defendants Adobe, Amazon, Citigroup, Google and Yahoo willfully infringed the claims of the '906 Patent and the '985 Patent.

The issue of willful infringement relates to the amount of damages Plaintiffs are entitled to recover in this lawsuit. If you decide that a Defendant willfully infringed the claims of an asserted patent, then it is my job to decide whether or not to award increased damages to the Plaintiffs. You should not take this factor into account in assessing the damages, if any, to be awarded to the Plaintiffs.

To prove willful infringement, Plaintiffs must persuade you by clear and convincing evidence that a Defendant acted with **[Defendants propose: intentional]** or reckless disregard of the claims of the '906 Patent or the '985 Patent. To show “reckless disregard,” Plaintiffs must satisfy a two-part test: the first concerns the Defendant’s conduct, the second concerns the Defendant’s state of mind.

When considering the Defendants’ conduct, you must decide whether Plaintiffs have proven by clear and convincing evidence that the Defendant’s conduct was reckless; that is, that the Defendant proceeded with the allegedly infringing conduct with knowledge of the patent, and in the face of an unjustifiably high risk that it was infringing the claims of a valid **[Defendants propose: and enforceable]**<sup>49</sup> patent. Because that is an objective issue, the state of mind of the Defendant is

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<sup>48</sup>Adapted from the National Jury Instruction Project Model Patent Jury Instructions § 4.1 (June 17, 2009).

<sup>49</sup>**The Regents of the University of California and Eolas object because the determination of enforceability is an equitable issue for the Court to decide.**

not relevant to it. Legitimate or credible defenses to infringement, even if ultimately not successful, demonstrate a lack of recklessness.

If you conclude that Plaintiffs have proven that a Defendant's conduct was reckless, then you need to consider the second part of the test. You must determine whether Plaintiffs proved by clear and convincing evidence that the unjustifiably high risk of infringement was known or so obvious that it should have been known to the Defendant. In deciding whether Plaintiffs satisfied the state-of-mind part of the test, you should consider all facts surrounding the alleged infringement including, but not limited to, the following:

**[Plaintiffs propose:**

- 1. whether the Defendant acted in a manner consistent with the standards of commerce for its industry;**
- 2. whether the Defendant intentionally copied without a reasonable basis a product of Plaintiffs covered by one or more claims of the patent, as distinguished from trying to "design around" the patent by designing a product that the Defendant believed did not infringe those claims.**
- 3. whether the Defendant obtained and followed the advice of a competent lawyer with regard to infringement. You may not assume that, merely because a Defendant did not obtain an opinion of counsel, the opinion would have been unfavorable. However, you may consider whether the Defendant sought a legal opinion as one factor in assessing whether, under the totality of the circumstances, any infringement by the Defendant was willful.<sup>50]</sup>**

**[Defendants propose:**

**Factors that may be considered as evidence that a Defendant was not willful include:**

- 1. Whether the Defendant acted in a manner consistent with the standard of commerce for its industry; and**
- 2. Although there is no obligation to obtain an opinion of counsel whether the Defendant relied on a legal opinion that was well-supported and believable and**

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<sup>50</sup> ***Broadcom Corp. v. Qualcomm, Inc.*, 543 F.3d 683, 698 (Fed. Cir. 2008).**



**that advised the Defendant (1) that its products or methods did not infringe the patents-in-suit or (2) that the patent was invalid or unenforceable.<sup>51]</sup>**

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<sup>51</sup>**MODEL PATENT JURY INSTRUCTIONS FOR THE NORTHERN DISTRICT OF CALIFORNIA, at 3.10 (Nov. 3, 2011) (citing *In re Seagate Technology, LLC*, 497 F.3d 1360 (Fed. Cir. 2007)); *Knorr-Bremse Systems Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337, 1344-46 (Fed. Cir. 2004) (en banc).**

## 7. INVALIDITY

### 7.1 INVALIDITY GENERALLY

Patent invalidity is a defense to patent infringement. **[UC and Eolas propose: The granting of a patent by the United States Patent Office carries with it the presumption that the patent is valid. 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.]**<sup>52</sup> **[Defendants propose: Patent invalidity is a defense to patent infringement. 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.]**<sup>53</sup> Claims are construed the same way for the purposes of determining infringement as for determining invalidity.<sup>54</sup> In this case, Defendants contend that the asserted claims of the '906 and '985 patents are invalid as anticipated or obvious, and not supported by the written description in the patent.

**[UC and Eolas propose: The issuance of a patent by the Patent Office provides a presumption that the patent is valid. From the issuance of the patent, it is presumed that a claimed invention is “novel,” “useful,” “not obvious,” and satisfies the other legal requirements for a valid U.S. patent. When a party asserting patent invalidity relies on prior art references**

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<sup>52</sup> **Defendants object to this proposed instruction as redundant and potentially confusing. See National Jury Instruction Project, MODEL PATENT JURY INSTRUCTIONS, Instruction 5.1 (June 17, 2009) (“The presumption of validity, like all legal presumptions, is a procedural device. In light of the procedural role of the presumption of validity, instructing the jury on the presumption in addition to informing it of the highly probable burden of proof may cause jury confusion as to its role in deciding invalidity.”)**

<sup>53</sup> **National Jury Instruction Project, MODEL PATENT JURY INSTRUCTIONS, Instruction 5.1 (June 17, 2009).**

<sup>54</sup> AIPLA's Model Patent Jury Instructions at § II.

that were considered during examination or reexamination, that party bears the added burden of overcoming the deference that is due to a qualified government agency presumed to have done its job.<sup>55</sup> Each claim of a patent is presumed valid independently of the validity of the other claims.

In making your determination as to whether a patent claim is valid or invalid, you must consider each patent and each of the claims of a patent separately and individually, as you did when you considered whether the claim was infringed or not. If the evidence is clear and convincing that a claim in a given patent fails to meet the essential requirements of the patent laws, then that patent is invalid. However, if you find that one or more claims of a patent fails to meet the requirements of the patent laws, it does not necessarily mean that the remaining claims of that patent are also deficient or invalid.

Likewise, if you find that one or more claims of one patent is invalid, that does not necessarily mean that any claim of any other patent is similarly invalid.

The presumption of validity remains intact and the burden of proof remains on the party challenging validity, throughout this litigation. In other words, the clear and convincing standard does not weaken, and the burden of proof never shifts to the patent owner to prove that its patents are valid.<sup>56</sup>

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<sup>55</sup>This statement is taken verbatim from *Pharmastem Therapeutics, Inc. v. Viacell, Inc.*, 491 F.3d 1342, 1366 (Fed. Cir. 2007); *Polaroid Corp. v. Eastman Kodak Co.*, 789 F.2d 1556, 1560 (Fed. Cir. 1986).

<sup>56</sup>This statement is taken verbatim from the Court's Final Jury Instructions in *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010).

**I will now instruct you on the invalidity issues you should consider. As you consider these issues, remember the Defendants bear the burden of proving with clear and convincing evidence that the asserted claims are invalid.]**

**[Defendants propose: To prove invalidity of any patent claim, Defendants must establish factual matters concerning invalidity by clear and convincing evidence. The clear-and-convincing-evidence standard applies only to questions of fact and not to questions of law. Obviousness, for example, is a question of law. Thus, you should apply the clear-and-convincing standard when finding facts, but not when deciding whether the facts as you find them show that the patented inventions were obvious.]**

**Defendants' burden may be easier to sustain if all material facts were not before the PTO when it issued a patent. Thus, you should consider whether you have heard evidence that the Patent Office had no opportunity to evaluate. You should determine whether the evidence you have heard is materially new and was not considered by the Patent Office as part of its decision to grant the patents. You should consider the fact that the Patent Office was unaware of this evidence in determining whether Defendants have met their burden of proof.<sup>57]</sup><sup>58</sup>**

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<sup>57</sup> **Jury Instr. No. 6.1 in *Bedrock Computer Techs. LLC v. Google Inc.*, No. 6:09-CV-269-LED (E.D. Tex. Apr. 15, 2011) (D.I. 745); 35 U.S.C. § 282; *Microsoft Corp. v. i4i Ltd. P'ship*, 131 S. Ct. 2238, 2251 (2011); *id.* at 2253 (Breyer, J., concurring); *Addington v. Texas*, 441 U.S. 418, 423 (1979); *Mendenhall v. Cedarapids, Inc.*, 5 F.3d 1557, 1563-64 (Fed. Cir. 1993).**

<sup>58</sup> **The Regents of the University of California and Eolas object to this paragraph as an improper statement of law and fact and an improper comment.**

## 7.2 [DEFENDANTS PROPOSE: DATE OF INVENTION<sup>59</sup>

Many of the different categories of prior art refer to the date at which the inventor made the invention. This is called the “date of invention.”

I will now explain to you how to determine this date. The date of invention is either when the invention was reduced to practice or when conceived, provided the inventor(s) were diligent in reducing the invention to practice. Diligence means working continuously, though not necessarily every day. Conception is the mental part of an inventive act, *i.e.*, the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice, even if the inventor did not know at the time that the invention would work. Conception of an invention is complete when the idea is so clearly defined in the inventor’s mind that, if the idea were communicated to a person having ordinary skill in the field of the technology, he or she would be able to reduce the invention to practice without undue research or experimentation. This requirement does not mean that the inventor has to have a prototype built, or actually explained her or his invention to another person. But, there must be some evidence beyond the inventor’s own testimony that confirms the date on which the inventor had the complete idea. Conception may be proven when the invention is shown in its complete form by drawings, disclosure to another person, or other forms of evidence presented at trial.

A claimed invention is “reduced to practice” when it has been constructed/used/tested sufficiently to show that it will work for its intended purpose or when the inventor files a patent

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<sup>59</sup>The proposed instruction of the Regents of the University of California and Eolas regarding date of invention appears within the instruction titled “Anticipation–Made or Invented By Someone Else.”

**application. An invention may also be reduced to practice even if the inventor has not made or tested a prototype of the invention if it has been fully described in a filed patent application.**

**I will now instruct you on the invalidity issues you should consider. As you consider these issues, remember that Defendants must prove clear and convincing that the claims of the '906 and '985 patents are invalid.]**

### 7.3 ANTICIPATION—PUBLICLY USED OR KNOWN, OR PREVIOUSLY PUBLISHED<sup>60</sup>

Defendants contend that the asserted claims of the '906 Patent and the '985 Patent are invalid because the claimed inventions are not new.

For a claim to be invalid because it is not new, all of its requirements must have existed in a single device or method that predates the claimed invention, or must have been described in a single previous publication or patent that predates the claimed invention. **[UC and Eolas propose: Material not explicitly contained in the single prior art document may be considered for purposes of anticipation, but only if that material is incorporated by reference and the host document identifies with detailed particularity what specific material it incorporates and clearly indicates where that material is found in the document.<sup>61</sup>]**

In patent law, such previous device, publication or patent is called a “prior art reference.” If a patent claim is not new we say it is “anticipated” by a prior art reference. The Defendants must prove by clear and convincing evidence that the claim was anticipated.

The disclosure in the prior art reference does not have to be in the same words as the claim, but all of the requirements of the claim must be there, either stated or necessarily implied, so that someone of ordinary skill in the relevant field looking at that one reference would be able to make and use at least one embodiment of the claimed invention.

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<sup>60</sup> **Adapted from the Court’s Final Jury Instructions in *Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011); *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010); The National Jury Instruction Project, MODEL PATENT JURY INSTRUCTIONS, Instruction 5.6 (June 17, 2009).**

<sup>61</sup> ***Adv. Display Systems, Inc. v. Kent St. Ohio*, 212 F.3d 1272, 1282 (Fed. Cir. 2000).**



Anticipation also occurs when the claimed invention inherently (necessarily) results from the practice of what is disclosed in the written reference, even if the inherent disclosure was unrecognized or unappreciated by one of ordinary skill in the field of the invention.

Here is a list of the ways that the alleged infringer can show that a patent claim was not new:

- **[Defendants propose: if the claimed invention was known or used by others in the United States, or patented or described in a printed publication in this or a foreign country, before the date it invented by the patent applicant.<sup>62</sup>]**
- if the claimed invention were already publicly known or publicly used by others in the United States before the date of invention of the '906 Patent or the '985 Patent.
- if the claimed invention was already patented or described in a printed publication anywhere in the world **[Defendants propose: or in public use or on sale in the United States more than one year prior to the date of the application for the patent in the United States. In this case the application dates for the patents-in-suit are October 17, 1994.<sup>63</sup>]** **[UC and Eolas propose: before the date of invention. To qualify as a prior art reference, a “printed publication” must be at least reasonably accessible to those interested in the field, even if it is difficult to find. An electronic publication, including an on-line or internet publication, is a “printed publication” if it is at least reasonably accessible to those interested in the field even if it is difficult to find.]**

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<sup>62</sup> **35 U.S.C. § 102(a).**

<sup>63</sup> **35 U.S.C. § 102(a).**

- if the claimed invention was already described in another published U.S. patent application or issued U.S. patent that was based on a patent application filed before **[UC and Eolas propose: the patent holder's filing or]** the date of invention.
- **[Defendants propose: if the claimed invention was already made by someone else in the United States before the date of invention if that other person had not abandoned the invention or kept it secret.<sup>64</sup>]**

If a patent claim is not new as explained above, you must find that claim invalid.

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<sup>64</sup> **Adapted from Model Patent Jury Instructions June 17, 2009, at 41l.**

**7.4 [DEFENDANTS PROPOSE: ANTICIPATION BY PUBLIC KNOWLEDGE OR USE OR SALE<sup>65</sup>]**

**A prior public use may anticipate a patent claim, even if the use was accidental or was not appreciated by the other person. Thus, a prior public use may anticipate an invention even if the user did not intend to use the invention, or even realize he or she had done so.**

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<sup>65</sup> Adapted from *Clear with Computers, LLC v. Hyundai Motor America, Inc.*, Case No. 6:09-CV-479 (E.D. Tex. June 2011) (Dkt. No. 352).

## 7.5 ANTICIPATION—MADE OR INVENTED BY SOMEONE ELSE<sup>66</sup>

Defendants contend that all asserted claims of the '906 Patent and the '985 Patent are invalid as anticipated because the invention was first made or invented by someone else.

If someone other than the named inventor made or invented the invention described in one or more such patent claims involved in this lawsuit, then each such claim was “anticipated” by the other invention, and each such claim is invalid. The Defendants must prove by clear and convincing evidence that each such claim was anticipated by the other invention.

Here are two ways that the Defendants can show that a patent claim was not new because the invention described in such claim was first made by someone else:

*First*, if the claimed invention was already made by someone else in the United States before the date of invention of the '906 Patent and the '985 Patent unless that other person had abandoned the invention or kept it secret; and

*Second*, **[UC and Eolas propose: Plaintiffs and the Defendants dispute who is a first inventor.]** The person who first conceived of the claimed invention and who first reduced it to practice is the first inventor; if one person conceived of the claimed invention first, but reduced it to practice second, that person is the first inventor if that person (a) began to reduce the claimed invention to practice before the other party conceived of it and (b) continued to work with reasonable diligence to reduce it to practice from a time just before the other party's conception.

**[UC and Eolas propose: Since priority of invention is in dispute in this case, you must determine a date of conception and reduction to practice for the claimed inventions in the '906**

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<sup>66</sup>Adapted from *Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011); The National Jury Instruction Project, MODEL PATENT JURY INSTRUCTIONS, Instruction 5.6 (June 17, 2009).

**Patent and '985 Patent and whether the named inventors were reasonably diligent in reducing the claimed inventions to practice. Conception is the formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is to be applied in practice. Reduction to practice occurs either as of the filing of the patent application or when the invention was actually made and was shown to work for its intended purpose. Reasonable diligence means that the inventor worked continuously on reducing the invention to practice. Reasonable diligence in reducing to practice exists when there is a continuous course of activity, carried on without significant interruption and accomplished in a reasonably prompt manner, considered in light of all the attend circumstances. Interruptions necessitated by the everyday problems and obligations of the inventor or others working with him or her do not prevent a finding of reasonable diligence.**

**In order to prove prior invention in this case, the Defendants are required to present additional evidence beyond the testimony of the prior inventor. However, you must evaluate all pertinent evidence, including that testimony, and make a sound determination that the evidence credibly establishes prior invention. Ultimately, the Defendants bear the burden of proving by clear and convincing evidence that the patent claims are invalid.**

**If the invention of a patent claim was first made or invented by someone else as explained above, you must find the patent claim invalid.]**

## 7.6 ANTICIPATION–STATUTORY BARS<sup>67</sup>

Defendants may prove that the asserted claims of the '960 Patent and the '985 Patent are invalid by showing by clear and convincing evidence that each such claim failed to meet one of several statutory provisions in the patent laws. These provisions are called “statutory bars.” For a patent claim to be invalid because of a statutory bar, all of its requirements must have been present in one prior art reference dated more than one year before the effective date of the patent application.

Here is a list of ways Defendants can show that a particular patent application was not timely filed, that is, filed within one year of the occurrence of any of the following events:

- if the asserted claims were already patented or described in a printed publication anywhere in the world one year before the effective filing dates of the '906 Patent and the '985 Patent, on October 17, 1994.

A reference is a “printed publication” if it is reasonably accessible to those interested in the field, even if it is difficult to find. An electronic publication, including an on-line or internet publication, is a “printed publication” if it is at least reasonably accessible to those interested in the field, even if it is difficult to find.

- if the asserted claims were already being publicly or commercially used in the United States one year before the effective filing dates of the '906 Patent application and the '985 Patent application, October 17, 1994, and that use was not primarily an experimental use controlled by the inventor to test whether the invention worked for its intended purpose; **Defendants propose: In this case, Pei Wei’s May 7, 1993 demonstration of Viola to two Sun Microsystems employees without confidentiality agreements qualifies as potentially invalidating public use. It is**

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<sup>67</sup>Adapted from the Court’s Final Jury Instructions in *Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011); *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010); The National Jury Instruction Project, MODEL PATENT JURY INSTRUCTIONS, Instruction 5.6 (June 17, 2009); 35 U.S.C. § 102(b) and (d); *Pfaff v. Wells Elec. Inc.*, 525 U.S. 55 (1998); *Schering Corp. v. Geneva Pharms.*, 339 F.2d 1373 (Fed. Cir. 2003).

**your job to determine whether that public use anticipates one or more claims of the patents-in-suit.<sup>68</sup><sup>69</sup>**

- if a device or method using the claimed invention was sold or offered for sale in the United States, and that claimed invention was ready for patenting one year before October 17, 1994 **[UC and Eolas propose: The claimed invention is not being sold or offered for sale if the patent holder shows that the sale or offer for sale was primarily experimental. The claimed invention is ready for patenting if it was actually built, or if the inventor had prepared drawings or other descriptions of the claimed invention that were sufficiently detailed to enable a person of ordinary skill in the field of the invention to make and use the invention based on them].**

For a claim to be invalid because of a statutory bar, all of the claimed requirements must have been either (1) disclosed in a single prior art reference or (2) implicitly disclosed in a single prior art reference as viewed by one of ordinary skill in the field of the invention. The disclosure in a reference does not have to be in the same words as the claim, but all of the requirements of the claim must be described in enough detail, or necessarily implied by or inherent in the reference, to enable someone of ordinary skill in the field of the invention looking at the reference to make and use at least one embodiment of the claimed invention.

A prior art reference also invalidates a patent claim when the claimed invention necessarily results from practice of the subject of the prior art reference, even if the result was unrecognized and unappreciated by one of ordinary skill in the field of the invention.

If you find a patent claim failed to meet a statutory bar, you must find the patent claim invalid.

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<sup>68</sup>***Eolas Techs, Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1335 (Fed. Cir. 2005).**

<sup>69</sup>**The Regents of the University of California and Eolas object to this instruction as an inaccurate statement of law and an improper comment.**

## **7.7 CORROBORATION OF ORAL TESTIMONY**

**[UC and Eolas propose: Oral testimony alone is insufficient to prove prior invention or that something is prior art or that a particular event or reference occurred before the filing date of the patents-in-suit.]** A party seeking to prove prior invention or that something is prior art or that a particular event or reference occurred before the filing date of the patents-in-suit must provide evidence that corroborates a witness’s oral testimony, especially where the oral testimony comes from an interested witness, or a witness testifying on behalf of an interested party. This includes any individual or company testifying that his or its invention predates the patents-in-suit, and also includes a patent owner seeking to prove an earlier date of invention than the effective filing date stated on the face of the patent. Documentary or physical evidence that is made contemporaneously with the inventive process provides the most reliable proof that the testimony has been corroborated, but corroborating evidence may also consist of testimony of a witness, other than an inventor, to the actual reduction to practice or it may consist of evidence of surrounding facts and circumstances independent of information received from the inventor. If you find that the party has not corroborated a witness’s oral testimony with other evidence, you are not permitted to find that the subject of that oral testimony qualifies as prior art or supports a prior date of invention.<sup>70</sup>

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<sup>70</sup>Adapted from the Court’s Final Jury Instructions in *VirnetX, Inc. v. Microsoft Corp.*, Civil Action No. 6:07-CV-80; *i4i Limited Partnership v. Microsoft Corp.*, Civil Action No. 6:07-CV-113; *Mass Engineered Design, Inc. v. Ergotron, Inc.*, Civil Action No. 2:06-CV-272; *Trovan, Ltd. v. Sokymat SA, Irori*, 299 F.3d 1292, 1303 (Fed. Cir. 2002) (“[O]ral testimony of someone other than the alleged inventor may corroborate.”) (citing *Price v. Symsek*, 988 F.2d 1187, 1195-96 (Fed. cir. 1993).



## 7.8 OBVIOUSNESS<sup>71</sup>

In this case, Defendants contend that the asserted claims of the '906 Patent and the '985 Patent are invalid as 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 application was filed. This means that even if all the requirements of the claim cannot be found in a single prior art reference that would anticipate the claim or constitute a statutory bar to that claim, 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.

But a patent claim composed of several requirements is not proved obvious merely by demonstrating that each of its requirements 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 requirements 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 there was some teaching, suggestion, or motivation to arrive at the claimed invention before the time of the claimed invention, although proof of this is not a requirement to prove obviousness. Teachings, suggestions, and motivations may also be found

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<sup>71</sup>Adapted from the Court's Final Jury Instructions in *Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011); *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010); The National Jury Instruction Project, MODEL PATENT JURY INSTRUCTIONS, Instruction 5.6 (June 17, 2009); 35 U.S.C. § 103; *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 425-28 (2007); *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

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. Additionally, teachings, suggestions, and motivations may 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.

Therefore, in evaluating whether such a claim would have been obvious, you should consider a variety of factors:

1. Whether Defendants have identified a reason that would have prompted a person of ordinary skill in the field of the invention to combine the requirements or concepts from the prior art in the same way as in the claimed invention. There is no single way to define the line between true inventiveness on 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.
2. Whether the claimed invention applies a known technique that had been used to improve a similar device or method in a similar way.
3. 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.

But you must be careful not to determine obviousness using hindsight; many true inventions can 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:

1. 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.
2. 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.

3. You should consider any difference or differences between the prior art and the claim requirements.

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

A. Factors tending to show non-obviousness:

1. commercial success of a product due to the merits of the claimed invention;
2. a long-felt, but unsolved, 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 the claimed invention and would therefore tend to show that the invention was not obvious.

**[Defendants propose:**

**8. Other evidence tending to show non-obviousness.]**

You may consider the presence of any of the list factors A.1-8 as an indication that the claimed invention would not have been obvious at the time the claimed invention was made.

B. 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.

**[Defendants propose:**

**2. Other evidence tending to show obviousness]**

You may consider the presence of the factor B.1 as an indication that the claimed invention would have been obvious at such time. Although you should consider any evidence of these factors, the relevance and importance of any of them to your decision on whether the claimed invention would have been obvious is up to you. The Defendants must prove by clear and convincing evidence that a claimed invention was obvious.

**[Defendants propose: In considering whether a claimed combination of prior art elements is obvious, you must consider whether the improvement is more than the predictable use of prior art elements according to their established functions. When a patent simply arranges old elements, with each performing the same function it had been known to perform, and yields no more than what one of ordinary skill in the art would expect from such an arrangement, the combination is obvious.]**

**It is common sense that familiar items may have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle. Multiple references in the prior art can be combined to show that a claim is obvious. Any need or problem known in the field and addressed by the patent can provide a reason for combining the elements in the manner claimed. To determine whether there was an apparent reason to combine the known elements in the way a patent claims, you can look to interrelated teachings of multiple patents, to the effects of demands known to the design community or present in the marketplace, and to the background knowledge possessed by a person of ordinary skill in the art. Neither the particular motivation nor the alleged**

**purpose of the patentee controls. One of ordinary skill in the art is not confined only to prior art that attempts to solve the same problem as the patent claim. Teachings, suggestions, and motivations 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. Additionally, teachings, suggestions, and motivations may be found in the nature of the problem(s) solved by the claimed invention.**

**The fact that a combination was obvious to try may demonstrate that the combination itself was obvious. When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance, the fact that a combination was obvious to try might show that it was obvious.<sup>72]</sup>**

If you find that a claimed invention was obvious as explained above, you must find that claim invalid.

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<sup>72</sup>**Source: *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416-21 (2007).**

## **7.9 LEVEL OF ORDINARY SKILL**

Several times in my instructions I have referred to a person of ordinary skill in the field of the invention.<sup>73</sup>

The parties agree that a person of ordinary skill in the art of the '906 Patent and the '985 Patent would have had a Bachelor of Science degree, or its equivalent, in computer science **or engineering or the equivalent skills acquired through experience in the field.**

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<sup>73</sup>Adapted from the Court's Final Jury Instructions in *Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011); *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010).

## 7.10 WRITTEN DESCRIPTION<sup>74</sup>

Defendants contend that the Asserted Claims of the '906 Patent and '985 Patent are invalid for failure of the patent to provide an adequate written description of the claimed invention. Defendants must prove by clear and convincing evidence that 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 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 Defendants lacked an adequate written description, you must find each such claim invalid.

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<sup>74</sup>Adapted from THE NATIONAL JURY INSTRUCTION PROJECT MODEL PATENT JURY INSTRUCTIONS § 5.2 (June 17, 2009); *Fractus, S.A. v. Samsung Electronics Co.*, Civil Action No. 6:09-CV-203 LED (E.D. Tex. May 23, 2011).

**[Defendants propose: Thus, the description must show that the alleged inventor actually invented the claimed invention. But merely showing invention is not sufficient; the ultimate question is whether the specification describes in full, clear, and exact terms the nature and extent of the claimed invention.<sup>75]</sup><sup>76</sup>**

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<sup>75</sup> **Jury Instr. No. 5.6 in *Fractus, S.A. v. Samsung Elecs. Co.*, No. 6:09-CV-203 (E.D. Tex. May 23, 2011) (D.I. 997); 35 U.S.C. § 112, ¶¶ 1, 2; *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47 (1938); *Permutit Co. v. Graver Corp.*, 284 U.S. 52 (1931); *O'Reilly v. Morse*, 56 U.S. (15 How.) 62 (1853); *Evans v. Eaton*, 20 U.S. 356, 435 (1822); *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336 (Fed. Cir. 2010) (en banc).**

<sup>76</sup> **The Regents of the University of California and Eolas object to this instruction. It does not appear in *Fractus* or THE NATIONAL JURY INSTRUCTION PROJECT MODEL PATENT JURY INSTRUCTIONS.**



**8. [DEFENDANTS PROPOSE: INEQUITABLE CONDUCT – GENERALLY<sup>77</sup> <sup>78</sup>**

**Every applicant for a patent has a duty of candor and good faith in its dealing with the United States Patent and Trademark Office and with the Examiner handling the application. This duty of candor is important because the examiner has limited resources. The examiner may have less information available to him than an applicant may have from which to determine whether an invention is sufficiently different from that which already exists to warrant a patent. The examiner also has a limited amount of time to spend determining whether the invention claimed in any particular application meets the requirements for a patent. To prevent patents from issuing on inventions that are not sufficiently different from that which already exists, anyone involved in a substantial way in the examination of an application is required to be truthful and honest in all of their dealings with the Patent and Trademark Office and to disclose all information in their possession which a reasonable examiner may consider to be material to the examination of the application.**

**When a person involved in the prosecution of an application fails to comply with the duty of candor and good faith, and does so with an intent to deceive the Patent and Trademark Office, he or she may commit what is called “inequitable conduct.” When inequitable conduct occurs during the examination of an application, any patent that issues from that application may be rendered unenforceable as a matter of fairness. This means that despite the existence of the patent, the patent holder may not prevent others from using the invention covered by the**

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<sup>77</sup> Adapted from *Computer Acceleration Corp. v. Microsoft Corp.*, No. 9:06-CV-140 (E.D. Tex. Nov. 2007) (Dkt. No. 294).

<sup>78</sup> The Regents of the University of California and Eolas object to this instruction because inequitable conduct is an equitable defense to be tried to the Court.

**patent and may not collect damages from those who use the invention that is covered by the patent.**

**Because a finding of inequitable conduct completely extinguishes a patent holder's right to prevent others from using an invention, the burden of proving inequitable conduct is high. An alleged infringer must establish conduct occurred during the examination of a patent by clear and convincing evidence.**

**In this case, Defendants contend that the inventors for the '906 Patent and the '985 Patent failed to disclose material information to the Patent and Trademark Office during the examination and reexamination of the '906 patent and the examination of the '985 Patent, and did so with an intent to deceive the examiner into issuing and reissuing the '906 Patent and issuing the '985 Patent.**

**I will now explain to you what “materiality” and “intent to mislead” mean. I will then explain to you how any materiality and intent that you may find must be balanced in order to determine whether, given all the facts and circumstances, inequitable conduct occurred in this case as Microsoft contends.**

## **8.1 [DEFENDANTS PROPOSE: INEQUITABLE CONDUCT – MATERIALITY<sup>79</sup>**

**In considering materiality, you first must determine whether or not information was withheld from the Patent and Trademark Office during the examination of the '906 Patent and the '985 Patent. If you find that the applicant, the applicant's representatives, or others involved in a substantial way with the examination of the application withheld information from the Patent and Trademark Office during examination and reexamination of the '906 patent and the examination of the '985 Patent, you must then determine whether or not the withheld information was material.<sup>80</sup>**

**The materiality required to establish inequitable conduct is but-for materiality. When an applicant fails to disclose prior art to the Patent and Trademark Office, that prior art is but-for material if the Patent and Trademark Office would not have allowed a claim had it been aware of the undisclosed prior art. So in assessing the materiality of a withheld reference, you must determine whether the Patent and Trademark Office would have allowed the claim if it had been aware of the undisclosed reference. In making this patentability determination, you should apply the preponderance of the evidence standard and give claims their broadest reasonable construction.<sup>81]</sup>**

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<sup>79</sup>**The Regents of the University of California and Eolas object to this instruction because inequitable conduct is an equitable defense to be tried to the Court.**

<sup>80</sup>**Adapted from *Computer Acceleration Corp. v. Microsoft Corp.*, No. 9:06-CV-140 (E.D. Tex. Nov. 2007) (Dkt. No. 294).**

<sup>81</sup>***TheraSense, Inc. v. Becton, Dickinson and Co.*, F.3d , , 98 USPQ2d , 2011 WL 2028255, \*11 & \*15 (Fed. Cir. 2011) (*en banc*).**

## **8.2 [DEFENDANTS PROPOSE: INEQUITABLE CONDUCT – INTENT TO MISLEAD<sup>82</sup>**

**To prove that inequitable conduct occurred, Defendants must establish that any failure to disclose material information was done with an intent to deceive the examiner. If the failure to disclose material information occurred through negligence, oversight, carelessness, or an error in judgment, even if it was grossly negligent, then there was no intent to deceive and there is no inequitable conduct.**

**Intent may be shown through direct evidence, such as documents or testimony about one's intent to deceive. Intent also may be shown through indirect evidence, or in other words, it may be inferred from conduct. For example, you may infer an intent to mislead from acts substantially certain to accomplish a result, or a combination of conduct and statements. However, you are not required to infer intent. Any inference of intent will necessarily depend upon the totality of the circumstances as you find them to have been, including the nature and level of any culpable conduct you may find and the absence or presence of affirmative evidence of good faith on the inventors' part.<sup>83</sup> The inference of intent to deceive must not only be based on sufficient evidence and be reasonable in light of that evidence, but it must also be the single most reasonable inference able to be drawn from the evidence to meet the clear and convincing standard.<sup>84</sup> ]**

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<sup>82</sup>**The Regents of the University of California and Eolas object to this instruction because inequitable conduct is an equitable defense to be tried to the Court.**

<sup>83</sup>**Adapted from *Computer Acceleration Corp. v. Microsoft Corp.*, No. 9:06-CV-140 (E.D. Tex. Nov. 2007) (Dkt. No. 294).**

<sup>84</sup>**Source: *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1366-67 (Fed. Cir. 2008).**

### **8.3 [DEFENDANTS PROPOSE: REEXAMINATION<sup>85</sup>**

**Now, you've heard evidence that one of Plaintiffs' two patents (the '906 patent) was reexamined in proceedings conducted by the Patent and Trademark Office. During reexamination, the Patent and Trademark Office evaluates the validity of the patent claims in light of prior art patents and printed publications asserted to raise substantial new questions of patentability. The reexaminations of the '906 patent in this case were proceedings between the Patent Office and Eolas. None of the defendants, the defendants' lawyers, or the inventors named on the prior art the Patent Office considered in the reexaminations, participated in the reexaminations. The Patent Office did not have or use the Court's interpretation of the claims of the '906 patent when reexamining the '906 patent, and the Patent Office used a different standard to assess the patentability of the '906 patent in the reexamination than you are to use when assessing invalidity of the '906 patent in this case. You are not bound by any determination in the reexamination proceedings.]**

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<sup>85</sup>**The Regents of the University of California and Eolas object to this instruction as an inaccurate statement of fact and/or law, surplusage, and improper comment.**

**9. ICDW, GO DADDY AND JCP PROPOSE: CONTRACTUAL AUTHORIZATION DEFENSE<sup>86 87</sup>**

**Plaintiff previously entered into an agreement with Microsoft under which Plaintiffs agreed not to sue Microsoft's customers for infringement of the '906 or '985 patents. You must decide whether Plaintiffs' covenant not to sue Microsoft customers applies to the Defendants' conduct at issue in this case.**

**Plaintiffs do not dispute that Defendants CDW, JCP, and Go Daddy are Microsoft customers and are, therefore, entitled to the benefits of Plaintiffs' agreement and may enforce the Plaintiffs' covenant not to sue in this case. Plaintiffs, however, contend that their covenant not to sue does not apply to their allegations against Defendants' in this case.**

**According to section 2.4 of its agreement with Microsoft (JDX \_\_\_), Plaintiffs agreed not to sue any of Microsoft's customers under either the '906 or '985 patents "for their making, using, selling, offering for sale, licensing, leasing, importing or otherwise disposing or distributing [Microsoft] products or practicing any method in connection with their making, using, selling, offering for sale, licensing, leasing, importing or otherwise disposing or distributing [Microsoft] products." The agreement defines Microsoft products to include any Microsoft "software product, software development tool, service, publication or Web content marketed and licensed using" a Microsoft trademark.**

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<sup>86</sup> **Defendants CDW, Go Daddy, and JCP contend that this issue should be decided by the Court on summary judgment. But if the Court denies summary judgment, CDW, Go Daddy, and JCP contend that those issues should be tried to the jury and that the Court should issue this instruction.**

<sup>87</sup> **The Regents of the University of California and Eolas object to this instruction because it is a matter for the Court and it is an inaccurate and/or incomplete statement of the facts and law.**

**You must decide whether the Defendants’ conduct that Plaintiffs accuse of infringing the patents results from the Defendants “making, using, selling, offering for sale, licensing, leasing, importing or otherwise disposing or distributing [Microsoft] products” or whether that conduct results from Defendants “practicing any method in connection with their making, using, selling, offering for sale, licensing, leasing, importing or otherwise disposing or distributing [Microsoft] products.”**

## 9.1 IMPLIED LICENSE<sup>88 89</sup>

Defendants also contend that they are entitled to an implied license under the Microsoft agreement. A covenant not to sue has the same effect as a non-exclusive patent license.<sup>90</sup> It is not necessary for the agreement to expressly provide for the right to use the patented invention; under certain circumstances, such a right is implied. The doctrine of implied license recognizes that “a licensor . . . [may not] license (or assign) a definable property right for valuable consideration, and then . . . derogate or detract from that right.”<sup>91</sup> You may find that Defendants are not liable for infringement of the ’906 and ’985 patents on the basis of an implied license if you find that Plaintiffs licensed “a definable property right for valuable consideration, and then has attempted . . . [to take] back in any extent that for which [they have] already received consideration.”<sup>92</sup>

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<sup>88</sup> Defendants CDW, Go Daddy, and JCP contend that this issue should be decided by the Court on summary judgment. But if the Court denies summary judgment, CDW, Go Daddy, and JCP contend that those issues should be tried to the jury and that the Court should issue this instruction.

<sup>89</sup> The Regents of the University of California and Eolas object to this instruction because it is a matter for the Court and it is an inaccurate and/or incomplete statement of the facts and law.

<sup>90</sup> *Transcore, LP v. Elec. Transaction Consultants Corp.*, 563 F.3d 1271, 1276 (Fed. Cir. 2009).

<sup>91</sup> *AMP Inc. v. United States*, 389 F.2d 448, 452 (Ct. Cl. 1968); *TransCore, LP v. Electronic Transaction Consultants Corp.*, 563 F.3d 1271, 1279 (Fed. Cir. 2009).

<sup>92</sup> *Transcore, LP v. Elec. Transaction Consultants Corp.*, 563 F.3d 1271, 1279 (Fed. Cir. 2009) (quoting *AMP Inc. v. United States*, 389 F.2d 448, 452 (Ct. Cl. 1968)).



## **9.2 PATENT EXHAUSTION<sup>93</sup> <sup>94</sup>**

**Plaintiffs previously entered into agreements with Microsoft Corporation and Apple Incorporated in which Plaintiffs granted Microsoft and Apple licenses to the claimed inventions of the '906 and '985 patents. Defendants contend that, based upon those licenses to Microsoft and Apple, the doctrine of patent exhaustion also bars Plaintiffs' patent infringement claims against Defendants in this case. Plaintiffs contend that this doctrine does not apply in this case.**

**Under the doctrine of patent exhaustion, the initial authorized sale or license of a patented item terminates all patent rights to that item. “[W]hen a patented item is once lawfully made and sold, there is no restriction on [its] use to be implied for the benefit of the patentee.”<sup>95</sup> A user of a licensed product may use the product free of the patent.**

**You may find that Defendants are not liable for patent infringement because of patent exhaustion if you find that the accused acts are a use of licensed Microsoft or Apple software.]**

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<sup>93</sup>**Defendants CDW, Go Daddy, and JCP contend that this issue should be decided by the Court on summary judgment. But if the Court denies summary judgment, CDW, Go Daddy, and JCP contend that those issues should be tried to the jury and that the Court should issue this instruction.**

<sup>94</sup>**The Regents of the University of California and Eolas object to this instruction because it is a matter for the Court and it is an inaccurate and/or incomplete statement of the facts and law.**

<sup>95</sup>***Quanta*, 553 U.S. at 630 (internal quotations and citations omitted).**

## 10. DAMAGES

### 10.1 DAMAGES<sup>96</sup>

I will now instruct you on damages. If you find that Defendants have infringed one or more valid claims of the '906 Patent or the '985 Patent, you must determine the amount of money damages to which Plaintiffs are entitled. By instructing you on damages, I do not suggest that one or the other party should prevail. These instructions are provided to guide you on the calculation of damages in the event you find infringement of a valid patent claim and thus must address the damages issue.

The amount of damages must be adequate to compensate the patent holder for the infringement, but it may not be less than a reasonable royalty. Your damages determination must not include additional sums to punish the 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 a Defendant's infringement by a preponderance of the evidence. **[Defendants propose: Plaintiffs do not seek damages for lost profits, only a reasonable royalty as explained below.]**

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<sup>96</sup>Adapted from the Court's Final Jury Instructions in *Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011); *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010); The National Jury Instruction Project, MODEL PATENT JURY INSTRUCTIONS, Instruction 6.1 (June 17, 2009); 35 U.S.C. § 284.

## 10.2 DAMAGES–BURDEN OF PROOF<sup>97</sup>

Plaintiffs have the burden to prove its damages by a preponderance of the evidence. Plaintiff is entitled to all damages that can be proven with reasonable certainty. Reasonable certainty does not require proof of damages with mathematical precision. However, no party is entitled to damages that are remote or speculative.

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<sup>97</sup>Adapted from the Court’s Final Jury Instructions in *Alcatel-Lucent USA Inc. v. Amazon.com, Inc.*, No. 6:09-CV-422 (E.D. Tex. Oct. 2011) (Dkt. No. 482); *Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011); *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010); The National Jury Instruction Project, MODEL PATENT JURY INSTRUCTIONS, Instruction 6.1 (June 17, 2009); 35 U.S.C. § 284; *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).

**10.3 [DEFENDANTS PROPOSE: DAMAGES–WHEN DAMAGES BEGIN<sup>98</sup>**

**In this case, you should assess damages beginning on October 6, 2009. Plaintiffs and Defendants have agreed upon this date.]**

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<sup>98</sup> **Source: Model Patent Jury Instructions, prepared by the National Jury Instruction Project at 60 (June 17, 2009).**

## 12.1 REASONABLE ROYALTY–DEFINITION<sup>99</sup>

A royalty is a payment made to a patent holder in exchange for rights to make, use, or sell the claimed invention. A reasonable royalty is the **[Defendants propose: amount of royalty]** payment that would have resulted from a negotiation between a patent holder and the infringer taking place just before the time when the infringing sales first began. **[Defendants propose: A lump-sum royalty is a royalty payment where the patent owner receives a single, upfront payment. You may award a fully-paid up, lump-sum royalty for the life of the patents-in-suit.<sup>100</sup>** In considering the nature of this negotiation, the focus is on what the expectations of the patent holder and infringer would have been had they entered into an agreement at that time and had they 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 patent holder and infringer 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. **[Defendants propose: The royalty may not be limited or increased based on the actual profits an infringer made after the hypothetical negotiation.<sup>101</sup>**

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<sup>99</sup>Adapted from the Court’s Final Jury Instructions in *Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011); *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010); the National Jury Instruction Project, MODEL PATENT JURY INSTRUCTIONS, Instruction 6.6 (June 17, 2009); 35 U.S.C. § 284; *Georgia-Pacific Corp. v. U.S. Plywood Corp.*, 318 F. Supp. 1116 (S.D.N.Y. 1970).

<sup>100</sup>**Sources: Final Jury Instructions, *Personal Audio, LLC v. Apple, Inc.*, Case No. 9:09-cv-00111-RC (Dkt. No. 469) (July 2011); *Lucent Techs, Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1325-27 (Fed. Cir. 2009); *Snellman v. Ricoh Co. Ltd.*, 862 F.2d 283, 289 (Fed. Cir. 1988).**

<sup>101</sup> **Fed. Cir. Bar Ass’n Model Patent Jury Instr. No. B.6.6.**

In determining the 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:

- Licenses or offers to license the patent at issue in this case
- Licenses involving comparable patents
- The licensing history of the parties
- Licensing practices in the relevant industry
- Whether the patent owner had an established policy of refusing to license the patent at issue
- The relationship between the patent owner and alleged infringer, including whether or not they were competitors
- The significance of the patented technology in promoting sales of the alleged infringer's products and earning it profit
- Alternatives to the patented technology and advantages provided by the patented technology relative to the alternatives
- The portion of the alleged infringer's profit that should be credited to the invention as distinguished from nonpatented features, improvements or contributions
- Any other economic factor that a normally prudent businessperson would, under similar circumstances, take into consideration in negotiating the hypothetical license.]

**[Defendants propose: These factors are only relevant to the extent they shed light on the result of the hypothetical negotiation under the principles described in this instruction.]**

**12.3 [DEFENDANTS PROPOSE: VALUE ATTRIBUTABLE TO INFRINGING FEATURE<sup>102</sup>**

**Upon a finding of infringement, a plaintiff is entitled to compensation only for the infringer's use of the patented technology. That means that, in determining a reasonable royalty, you may not award damages based on Defendants' entire revenue from an accused product unless you find that the patented technology drove consumer demand for the product as a whole. Absent such a finding, you may award damages based only on the revenue that is attributable to any infringing feature(s) of a product.**

**In addition, you must consider whether those features derive value only from their use of the patented invention, or whether they would still have value if they did not use that invention. You may award damages based only on the portion of an infringing feature's value that is attributable to its use of the patented invention.<sup>103]</sup>**

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<sup>102</sup>**The Regents of the University of California and Eolas object to this instruction as an inaccurate and/or incomplete statement of law.**

<sup>103</sup>***Garretson v. Clark*, 111 U.S. 120, 121 (1884); *Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1337-38 (Fed. Cir. 2009); *Imonex Services, Inc. v. W.H. Munzprufer Dietmar Trenner GmbH*, 408 F.3d 1374, 1380 (Fed. Cir. 2005); *Rite-Hite Corp. v. Kelley Co.*, 56 F.3d 1538, 1549-50 (Fed. Cir. 1995) (en banc); *Uniloc USA, Inc. v. Microsoft Corp.*, 640 F. Supp. 2d 150, 185 (D.R.I. 2009).**

### 13. INSTRUCTIONS FOR DELIBERATIONS<sup>104</sup>

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

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

Remember that in a very real way you are the judges—judges of the facts. Your only interest is to seek the truth from the evidence in the case. You should consider and decide this case as a dispute between persons of equal standing in community, of equal worth, and holding the same or similar stations in life. A corporation is entitled to the same fair trial as a private individual. All persons, including corporations, and other organizations stand equal before the law, regardless of size or who owns them, and are to be treated as equals.<sup>105</sup>

When you retire to the jury room to deliberate on your verdict, you may take this charge with you as well as exhibits which the Court as admitted into evidence. Select your Foreperson and

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<sup>104</sup>FIFTH CIRCUIT PATTERN JURY INSTRUCTIONS – CIVIL, § 3.1 General Instruction for Charge

<sup>105</sup>Adapted from the Court’s Final Jury Instructions in *Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011); *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 LED (E.D. Tex. Oct. 1, 2010).



conduct your deliberations. If you recess during your deliberations, follow all of the instructions that the Court has given you about/on your conduct during the trial. After you have reached your unanimous verdict, your Foreperson is to fill in on the form your answers to the questions. Do not reveal your answers until such time as you are discharged, unless otherwise directed by me. You must never disclose to anyone, not even to me, your numerical division on any question.

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

If you want to communicate with me at any time, please give a written message or question to the bailiff, who will bring it to me. I will then respond as promptly as possible either in writing or by having you brought into the courtroom so that I can address you orally. I will always first disclose to the attorneys your question and my response before I answer your question. After you have reached a verdict, you are not required to talk with anyone about the case unless the Court orders otherwise. You may now retire to the jury room to conduct your deliberations.