EXHIBIT A

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
TYLER DIVISION

Eolas Technologies Incorporated and The Regents of the University of California,	
Plaintiffs and Counterdefendants,	
vs.	**Civil Action No. 6:09-CV-446-LED**
Adobe Systems Inc.; Amazon.com, Inc.; CDW Corporation; Citigroup Inc.; The Go Daddy Group, Inc.; Google Inc.; J.C. Penney Corporation, Inc.; Staples, Inc.; Yahoo! Inc.; and YouTube, LLC,	**JURY TRIAL DEMANDED**
***Defendants and Counterclaimants*.**	

JOINT PROPOSED PRELIMINARY JURY INSTRUCTIONS
FOR THE INVALIDITY TRIAL[1],[2]

[1] The Parties reserve the right to amend, supplement, or modify these proposed Jury Instructions as the case proceeds. Additionally, the Parties do not waive any objection to instructions on issues that are currently the subject of pending or resolved motions. Such objections are hereby reasserted.

[2] While not every defendant requests every aspect of the proposed set of instructions contained herein, Defendants submit these instructions at this stage of the case as a basis for the parties' meet and confer process.

I. PRELIMINARY INSTRUCTIONS[3]

Duty of the Jury and Issues to be Decided

MEMBERS OF THE JURY:

I am now giving you some preliminary instructions. Your role as the jury is going to be to decide all disputed questions of fact. And it is my role as the Judge to decide all questions of law and procedure. I will provide you with instructions on the rules of law and procedure that you must follow in making your decision in this case. At the end of the trial, I will give you more detailed, final instructions on the law and procedure you must follow in reaching a verdict in this case.

Today, we are beginning the actual trial of the case. After I have completed my preliminary instructions, you will then hear the attorneys' opening statements. An opening statement is an overview of what each side expects the evidence will show, but, remember, what the attorneys say is not evidence. It is only intended as a roadmap to help you understand the evidence as you hear it during the course of the trial.

The evidence that you will actually decide the case on is not what the attorneys say in opening statement or closing argument but the testimony you hear from that witness stand and the exhibits that are admitted into evidence.

[3] Source: Adapted from the Joint Proposed Preliminary Instructions in *Alacatel-Lucent USA Inc. v. Amazon.com, Inc.*, No. 6:09-CV-422 (E.D. Tex. Oct. 2011) (Dkt. No. 466); transcript of the Court's Preliminary Jury Instructions in *Cheetah Omni LLC v. Verizon Services Corp., et al*, No. 6:09-CV-260 (E.D. Tex. March 2011) (Dkt. No. 447).

[UC and Eolas propose: After the opening statements, Plaintiffs will present a witness to introduce the patents at issue in this case. The Defendants will then present evidence. Plaintiffs will then present their evidence; then the Defendants will present what we call any rebuttal evidence.] **[Defendants propose: After the opening statements, Eolas and the Regents of the University of California ("Plaintiffs") will present a witness to introduce the patents at issue in this case. 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"), J.C. Penney Company, Inc. ("J.C. Penney"), Staples, Inc. ("Staples"), Yahoo! Inc. ("Yahoo!"), and YouTube, LLC ("YouTube") ("Defendants"), will then present their evidence setting forth why they believe the patents at issue are invalid. Then the Plaintiffs will present their evidence in response; and finally, the Defendants will present what we call any rebuttal evidence.]**

Once all of the evidence is in, I will then give you my final instructions, after which time both sides will present their closing arguments. And, finally and only then will you retire to the jury room and for the first time begin to discuss the case among yourselves, and in your collective wisdom, reach a verdict in this case.

During the course of the trial, you should keep an open mind until you have heard all of the evidence, my final instructions, which is called the Court's Charge, and the attorneys' closing arguments. Be sure to pay close attention to all of the testimony and evidence. To help

you, you may take notes during the trial, if you wish. A juror notebook has been provided for your convenience.

If you would, write your name on the front cover of your juror notebook. On the left, you will see a steno notebook. Take that notebook out, if you would, and write your name on the front cover of the notebook. That will be your notebook to keep during the course of the trial. You can keep it on the inside of the black juror notebook, which has the copy of the patents in it.

These will be turned in each day and then will be returned to you the following day. Everything you write in your notebook will be kept confidential and will be shredded at the end of the case.

You do not have to take notes; but if you do, don't get so involved in your note-taking that you become distracted and miss part of the testimony. Your notes are to be used as an aid to your memory, and if your memory should later be different than your notes, then you should rely on your memory and not your notes. Just because something gets written down on the notepad doesn't make it anymore important than your recollection or another juror's recollection. So don't be unduly influenced by the notes that others may take.

Until this trial is over, do not discuss this case with anyone and do not permit anyone to discuss this case in your presence. This includes your family, friends, and even your fellow jurors. So when you take a break or when we break for lunch or when you're walking to the car, there might be a natural tendency, if you're walking and chatting with one of your fellow jurors, to say something about the case. Again, please don't. The reason for that is, as the jury, you're

working as a unit, and it would be improper and could jeopardize the case if two or three of you started discussing the case among yourselves. You shouldn't discuss it at all until the end of the case when you begin your deliberations, and then you should only discuss it with all eight of you present.

So, for example, if someone has to go to the bathroom during your final deliberations, you should stop discussing the case until that person comes back. The reason for that is simple: So that all of you will hear everything that is said in reaching your collective decision as to the verdict in this case.

If anyone should attempt to discuss this case with you or approach you concerning this case, you should inform me immediately through my court staff.

During this trial, you should hold yourself completely apart from the people involved in the case; the parties, the witnesses, and the attorneys and the persons associated with them. It is important not only that you be fair and impartial but also that you appear to be fair and impartial. And that is why you should not have any contact with any of the persons involved in the case.

And they understand that. They're not going to be talking to you in the hallway or elevators. They're not being rude, and they know you're not being rude by not chatting with them as well.

Also, if any of you happen to use a social networking internet site or tool, such as Facebook, MySpace, or Twitter, you should not discuss, mention, or post updates in any manner

about this trial or your involvement in it or the case. Likewise, do not send or receive text messages about the case.

You should also not make any independent investigation of any fact or matter in this case. Do not learn anything about the case from any other outside source. Do not watch television or read the newspaper about this case. Do not use the internet or Google to find out more information about the case, the parties, or the attorneys in this case.

For example, if you have a home computer, during this case, do not go home and start trying to figure things out on your own. You are to be guided solely by the evidence in this case, only by what you see and hear here in this courtroom, not by anything outside the courtroom. Again, that's why that would be improper to do any searches or investigation. It would not be legally admissible evidence. So please refrain from that.

During trial it may be necessary for me to confer with the lawyers out of your hearing or to conduct a part of the trial out of your presence. I will handle these matters as briefly and as conveniently for you as I can, but you should remember that they are a necessary part of any trial.

The Parties and Nature of the Case

This is a patent case that involves two patents. Plaintiffs, Eolas Technologies, Inc. and the Regents of the University of California, have asserted that Defendants infringe certain claims of two patents. Those patents are U.S. Patent No. 5,838,906 and U.S. Patent No. 7,599,985.

Patents are often referred to by their last three digits, such as the '906 Patent and the '985 Patent. These patents will also be collectively referred to as the "patents-in-suit."

[UC and Eolas propose: The "Defendants" in this case are: Adobe Systems Inc. ("Adobe"), Amazon.com, Inc. ("Amazon"), CDW Corp. ("CDW"), Citigroup Inc. ("Citigroup"), The Go Daddy Group, Inc. ("Go Daddy"), Google Inc. ("Google"), J. C. Penney Company, Inc. ("J.C. Penney"), Staples, Inc. ("Staples"), Yahoo! Inc. ("Yahoo!"), and YouTube LLC ("YouTube"). Defendants deny such infringement and allege that the '906 and'985 Patents are invalid as being either anticipated by or obvious in light of what is called prior art and not supported by written description in the patent.

The Court has determined to separate the infringement issues from the invalidity issues and to try the invalidity issues first. In this trial, you will decide whether or not the patents are invalid. You should not concern yourself with infringement in this phase of the case. There is only one question you will be called upon to answer at the end of this case:

Have Defendants proven that any of the claims of the patents are invalid?][4]

[Defendants propose: Defendants allege that the '906 and '985 Patents are invalid as being either anticipated by or obvious in light of what is called prior art and not

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[4]**Defendants object to Plaintiffs' proposed instruction insofar as it fails to advise the jury explicitly that the issue of infringement has not been decided. Particularly in light of the Courts' Order in Limine (Dkt. No. 1315), in the absence of an instruction as to the fact that infringement has not yet been determined, there is an unduly high risk that the jury will assume that Defendants infringe, resulting in undue prejudice to Defendants. Accordingly, Defendants respectfully request that the Court instruct the jury, in a manner that is neutral and not prejudicial to either side, that infringement has not yet been determined, as set forth in Defendants' proposed instructions.**

supported by written description in the patent. Whether or not a patent is valid is viewed from the point of view of someone of ordinary skill in the field, not necessarily from the viewpoint of you or me, so please keep that in mind.[5] Your job as the jury is to decide only whether one or more of the asserted claims of the '906 and '986 Patents are invalid. Defendants have not been found to infringe the '906 and '985 Patents and contend they do not infringe any claim of those patents.[6] The issues of infringement will be decided later, if necessary, by a different jury or juries.[7] Because this is a validity trial, you will not consider the issue of infringement at all. The fact that infringement has not been decided should not affect how you decide whether the patents-in-suit are invalid.

As I mentioned, this case involves two patents. Please keep in mind that you will be asked to decide certain questions about each individual claim of each individual patent rather than the patents collectively. For example, you may decide that some of the claims of some of the patents are valid while others are not.[8]]

Patent Protection

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[5]**Source: Adapted from the Joint Proposed Preliminary Instructions in *Alcatel-Lucent USA Inc. v. Amazon.com, Inc.*, No. 6:09-CV-422 (E.D. Tex. Oct. 2011) (Dkt. No. 466).**

[6]**The Regents of the University of California and Eolas object to Defendants' instruction because it is a prejudicial comment that is unnecessary in light of the fact that the jury will be advised that the infringement trial will take place later.**

[7]**The Regents of the University of California and Eolas object to Defendants' instruction because it is a prejudicial comment unduly emphasizing the effect of the jury's decision in the invalidity case.**

[8]**Source: Adapted from the Joint Proposed Preliminary Instructions in *Alcatel-Lucent USA Inc. v. Amazon.com, Inc.*, No. 6:09-CV-422 (E.D. Tex. Oct. 2011) (Dkt. No. 466).**

Now, let me visit with you about our patent system. You've seen the video. You saw that prior to jury selection about how the U.S. patent system works.

The United States Constitution empowers the United States Congress to enact patent laws and issue patents to protect inventions. The purpose of the patent system is to help advance science and technology.

The patent system achieves this purpose by granting to the owner of a patent the right, for the life of the patent, to exclude any other person from making, using, offering for sale, or selling anywhere in the United States the invention covered by the patent.

[UC and Eolas propose: A patent has a life for a limited amount of time, which, for the patents involved in this case, will end in November 2015.

Once a patent expires, the invention then becomes part of what we call the public domain, which means that anyone is then free to use it and the patent owner may no longer exclude anyone from making use of the invention claimed in the patent.[9]][10]

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[9] **Adapted from the preliminary instructions in *Acqis, LLC v. Appro International*, Case No. 6:09-CV-148 (E.D. Tex.) (Dkt. No. 686); *VirnetX v. Microsoft Corp.*, Case No. 6:07-CV-80 (E.D. Tex.) (Dkt. No. 388); *Fractus v. Samsung Electronics Co.*, Case No. 6:09-CV-203 (E.D. Tex.) (Dkt. No. 1014); *Clear With Computers, LLC v. Hyundai Motor America, Inc.*, Case No. 6:09-CV-479 (E.D. Tex.) (Dkt. No. 362).**

[10] **Defendants object to this instruction regarding the duration of ownership and the particulars of the exclusionary rights as irrelevant to the invalidity trial, confusing to the jury, and inconsistent with the position that infringement issues should not be raised in the invalidity trial.**

Everyone, however, has the right to use existing knowledge and principles. A patent cannot remove from the public the ability to use what was known or obvious before the invention was made or patent protection was sought.

Thus, to be entitled to patent protection, an invention must be new, useful, and non-obvious and the patent must include a proper written description of the invention.

Patent Prosecution

To obtain a patent, the applicant must file a patent application with the United States Patent Office. **[UC and Eolas propose: The Patent Office is an agency of the federal government and employs trained examiners who review applications for patents.[11]]** After the applicant files a patent application, a Patent Examiner examines the application to determine whether the invention described in the patent application meets the requirements of the patent laws for patentable inventions.

In examining a patent application, the Patent Examiner makes a search in the Patent Office records for prior art pertinent to the claims of the patent application. The Patent Office records may or may not contain all of the prior art pertinent to the claims of the patent application.

The prior art is defined by statute, and I will give specific instructions, after the close of evidence, as to what constitutes prior art. But, generally, prior art is technical information, such as journals, publications and patents, products and knowledge that was already publicly known

[11] ***i4i v. Microsoft*, C.A. No. 6:07-CV-113-LED (E.D. Tex.) at Dkt. No. 329.**

or available to the public prior to the time the person named as the inventor on the patent came up with his or her invention.

[UC and Eolas propose: The Patent Examiner advises the applicant of his or her findings in a communication called an office action. The Examiner may reject the claims if he or she believes that they do not meet the requirements for patentable inventions.

The applicant may then respond to the rejection with arguments to support the claims and may sometimes make changes or amend the claims or submit new claims.[12]]

If the Patent Examiner concludes that the legal requirements for a patent have all been satisfied, then the Patent Examiner allows the claims, and the application then issues as a United States patent.

This process, from the filing of the patent application to the issuance of the patent, is what is called the patent's prosecution.

The record of papers relating to the patent prosecution is referred to as the prosecution history, or the file history. In other words, it is the written history of what happened during the prosecution of the patent before the Patent Office.

[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. From the issuance of a patent, it is presumed that its subject matter is new, useful, and constitutes an advance that was not at the time the invention was made obvious to one of ordinary skill in the art. However, that

[12] ***i4i v. Microsoft*, C.A. No. 6:07-CV-113-LED (E.D. Tex. at Dkt. No. 329.**

presumption may be rebutted at trial. Therefore, even though the patent was granted by the United States Patent Office, you the jury may find the patent to be invalid.[13]]

[Defendants propose: Patent invalidity is a defense to patent infringement. Even though the Patent Examiner has allowed the claims of a patent, you have the ultimate responsibility for deciding whether the claims of the patent are valid.[14]]

Parts of a Patent

You have been provided with copies of the two patents-in-suit in your notebook. As an example, please refer to the '906 patent in your binder. It's at Tab ____.

Look at the first page of the '906 patent. It provides identifying information. You'll notice up in the right-hand corner, you'll see Patent Number 5,838,906. That is the patent number for the '906 patent, which is identified by the last three digits.

Next, you'll see the date of the patent, November 17, 1998. That's the date that the patent issued.

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[13] **Adapted from the preliminary instructions in *Acqis, LLC v. Appro International*, Case No. 6:09-CV-148 (E.D. Tex.) (Dkt. No. 686); *VirnetX v. Microsoft Corp.*, Case No. 6:07-CV-80 (E.D. Tex.) (Dkt. No. 388); *Clear With Computers, LLC v. Hyundai Motor America, Inc.*, Case No. 6:09-CV-479 9E.D. Tex.) (Dkt. No. 362).**

[14] **National Jury Instruction Project, Model Patent Jury Instructions, Instruction 5.1 (June 17, 2009). Defendants object to Plaintiffs repeated instructions on the "presumption of validity" 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 o the presumption of validity, instructing the jury on the presumption in addition to informing it of the highly probable burden of proof ,ay cause jury confusion as to its role in deciding invalidity.").**

In the left-hand column, you'll see the inventors' names. And then you'll see the next line, Assignee – that's who the patent was assigned to – The Regents of the University of California, one of the Plaintiffs in this case.

You will then see down near the bottom, prior art publication data. And you will see several references of prior art publications that were considered by the Patent Office when deciding to issue the patent.

Next, you will see the abstract. On the right-hand column near the middle, you will see a paragraph titled abstract. The abstract is a brief statement about the subject matter of the invention.

On the next several pages are drawings, which appear as Figures 1 through 10. The drawings depict various aspects or features of the invention. They are described in words later in the patent.

So flip on over past the drawings. Then you'll see a typewritten page with two columns, a Column 1 and 2. This begins what's called the written description. In this portion of the patent, each page is divided into two columns, which are numbered at the top.

See the Column 1 and Column 2. You'll also see down the margin between the two columns in the middle of the page are numbers. These are line numbers: 5, 10, 15, 20, and so forth. And the reason for this is it's for ease of reference. The written description includes a background section, a summary of the invention and a detailed description of the invention including some specific examples. For example, if you wanted to look at Column 1, Line 18,

you would find what's called the background of the invention. So at any point in the testimony, if someone's testifying about the specification or you see a reference to the specification in some of the documents, it will be referred to by Column and Line numbers. If you'll notice on the next page, it continues with Columns 3, 4, et cetera.

Now, let me step through the written description with you. You will see a number of paragraphs beginning in Column 1. As I mentioned, you will see the background of the invention. Then in Column 6, there's a summary of the invention in column 7, a brief description of the drawings, and in Column 8 a detailed description of example embodiments of the invention.

Then flipping all the way over to Column 16, you'll find that the written description in the patent ends with numbered paragraphs that are called claims.

If you'll look in Column 16, Line 62, it says:

What is claimed is; and then No. 1, A method for running an application program in a computer network environment … And then it lists a number of elements of that claim.

You'll see that the claims continue on through the next page through Column 18, Claim No. 10 at the end. So this patent has 10 different claims in it. Not all of those claims are asserted in this case, and the attorneys will visit with you about which claims are.

Significance of Patent Claims

Let me visit with you about the significance of the patent claims. The claims of a patent are a main focus of a patent case, because the claims are what define the patent owner's rights

under the law; that is, the claims define what the patent owner may exclude others from doing during the term of the patent.

The claims of a patent serve two purposes. First, they set the boundaries of the invention covered by the patent.

Second, they provide notice to the public of those boundaries. The claims define what the patent is. The claims are at issue when the validity of a patent is challenged.

The patent claims are compared to the prior art to determine whether the claims are invalid.

And you'll see this in the testimony. You'll hear experts from both sides that will take each of the claims that are asserted in this case; they will list the elements of each of the claims; and they will have testimony about whether each of these elements is or is not met by the prior art.

In reaching your determination with respect to validity, you must consider each claim separately.

Independent and Dependent Patent Claims

Patent claims 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. In other words, it's 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.

[UC and Eolas propose: To find invalidity of the patent claims, you must consider the limitations of the independent claim and the dependent claim separately. If you decide that the independent claim is invalid, that does not mean that the dependent claim is invalid. You must then separately determine if the limitations of the dependent claim have also been included in the alleged invalidating prior art. The dependent claim is invalid only if the limitations of the dependent claim, including the limitations of the independent claim, are disclosed in one item of alleged invalidating prior art or are obvious in light of the alleged invalidating prior art.][15]

[Defendants propose: To find invalidity by anticipation, you must consider the limitations of the independent claim and the dependent claim separately. If you decide that the independent claim is anticipated, that does not mean that the dependent claim is

[15] **Defendants object to this instruction as incomplete and an incorrect statement of the law regarding invalidity, particularly with respect to the written description requirement of 35 U.S.C. § 112.**

anticipated. You must then separately determine whether the additional limitation or limitations of the dependent claim are met by the prior art.][16],[17]

I know that all sounds complicated. There's complicated terminology. You're going to have a lot of good experts in helping you understand all of this as we work through it.

Meaning of Patent Claims

While the claims define the inventions, sometimes there is a disagreement between the parties as to what certain words or terms in the claims mean. When this happens, the parties ask the Court to interpret these terms in light of the patent as a whole. This is to help resolve their disagreement and to give you, the jury, guidance in applying the claims to the facts of the case.

This happened in this case, and at some point prior to trial, we had a hearing where both sides came in and said: Your Honor, we have a disagreement as to what these words in the claim mean. Plaintiffs would say we think it means X. Defendants would say we think it means Y. And they would submit it to me, and I would then interpret those words in light of the specification, and gave them a claim construction of those terms.

And they and you are bound by the construction that I have given to those terms.

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[16] **Defendants propose this anticipation instruction as the appropriate analog in an invalidity trial for the infringement instruction normally given on this issue.**

[17] **The Regents of the University of California object to the failure of Defendants' instruction to address obviousness.**

You, the attorneys, the parties, and the experts will all be guided by the construction I have given to these terms. The claims constructions appear in your notebook at Tab ___.[18] You must use these meanings when you decide the issues of invalidity in the case.

Burden of Proof

[UC and Eolas propose: Now, the issues to be decided by you, as I mentioned earlier, there is really one question or issue that you will be asked to resolve by the verdict you return in this case. That issue is invalidity.

Defendants have the burden of proof on the issue of invalidity.]

In any legal action, facts must be proved by a required standard of evidence known as the burden of proof. You have probably heard of the "beyond a reasonable doubt" burden of proof required in criminal cases. This is the very highest burden of proof. It is not involved in this case.

[UC and Eolas propose: Defendants' burden of proof for invalidity is clear and convincing evidence. By law, because the Patent and Trademark Office issued the asserted patents, the asserted patent claims carry with them a presumption that they are valid. When a party has a burden of proof by clear and convincing evidence, it means that the

[18] **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, Defendant do not waive any rights regarding objections to the Court's claim constructions in this case or to its rejection of Defendants' indefiniteness defenses.**

evidence must produce in your minds a firm belief or conviction as to the matters sought to be established.

In other words, if you were to put the evidence for and against the party who must prove the fact on the opposite sides of a scale, clear and convincing evidence requires that the scale tip more heavily toward the party who has the burden of proof.[19]]

[Defendants propose: In this case, Defendants have the burden of proving invalidity by "clear and convincing evidence." Clear and convincing evidence means evidence that convinces you that it is highly probable that the particular proposition is true.[20]

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[19]**This paragraph and the previous paragraph submitted by The Regents of the University of California and Eolas are taken directly from the preliminary instructions in *i4i LP v. Microsoft Corp.*, No. 6:07-CV-113 (E.D. Tex. May 2009).**

[20]**Defendants' requested language is based on AIPLA's Model Patent Jury Instructions, which states that "clear and convincing" evidence regarding validity means that the evidence "shows it is highly probable that the claims are invalid." AIPLA's Model Patent Jury Instructions at § II. Defendants object to a parallel instruction on the "presumption of validity," 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.").**

Even though the PTO examiner has allowed the claims of the patent you have the ultimate responsibility for deciding whether the claims of the patent are valid. Furthermore, you can consider the fact of whether or not the PTO examiner considered the prior art being asserted by Defendants in making your evaluation.[21]][22]

[21] **Source: Defendants' requested language is based on the Supreme Court's recent decision in *Microsoft Corp. v. i4i Ltd. P'ship*, 131 S.Ct. 2238, 2251 (2011) ("Simply put, if the PTO did not have all material facts before it, its considered judgment may lose significant force. And, concomitantly, the challenger's burden to persuade the jury of its invalidity defense by clear and convincing evidence may be easier to sustain. In this respect, although we have no occasion to endorse any particular formulation, we note that a jury instruction on the effect of new evidence can, and when requested, most often should be given.") (citations omitted).**

[22] **Plaintiffs propose that this instruction from *i4i v. Microsoft* be given in context with the description of the invalidity claims appearing later in the instructions.**

[UC and Eolas propose:

Invalidity

Now let me explain the defense of invalidity. Defendants contend that the asserted claims of the Asserted Patents are invalid. The Regents of the University of California and Eolas deny that the asserted patent claims are invalid. A Defendant has the right to assert that the claimed invention in a patent did not meet the requirements for patentability and, therefore, that the issued patent claim is invalid. However, the granting of a patent by the Patent and Trademark Office carries with it the presumption that the patent is valid. The presumption of validity applies to each invalidity defense asserted by Defendants. The presumption of patent validity imposes the burden on Defendants to prove invalidity by clear and convincing evidence.[23] You may consider whether or not the Patent Office examiner considered the prior art being asserted by the Defendants in making your evaluation of Defendants' invalidity claims.[24],[25]

I will now explain to you briefly the legal requirements for each of the grounds on which the Defendants rely to contend that the asserted patent claims are invalid. I will provide more details for each ground in my final instructions at the end of the case. The

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[23] **From the preliminary instructions in *VirnetX v. Microsoft Corp.*, Case No. 6:07-CV-80 (E.D. Tex.) (Dkt. No. 388).**

[24] ***Microsoft Corp. v. i4i Limited Partnership*, 131 S.Ct. 2238, 2251 (2011).**

[25] **Defendants object to discussion of the burden of proof here–and in the numerous other places Plaintiffs repeat it throughout the instructions–as inappropriate and cumulative of the one section where it ought to be addressed: the instruction regarding burden of proof. There is only a single burden of proof in this invalidity trial. The Court only needs to state and explain that burden once in these instructions.**

first ground the Defendants rely upon is what is called anticipation. To prove that a claim is anticipated by prior art, a party must prove by a clear and convincing evidence that each and every limitation of the claim was present in a single item of prior art.[26]

Defendants also contend that the asserted claims of the patents-in-suit are invalid for obviousness. To prove invalidity of a patent based on obviousness, a party must prove by clear and convincing evidence that the invention defined by the claim would have been obvious to a hypothetical person of ordinary skill in the art at the time the invention was made.[27]

Defendants also contend that certain patent claims are invalid for failure of the patent to provide an adequate written description of the claimed invention. 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 the claim, even though the description might not use the exact words found in the claim. Defendants must prove by clear and convincing evidence that each patent claim does not provide an adequate written description.]

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[26] **From the preliminary instructions in *VirnetX v. Microsoft Corp.*, Case No. 6:07-CV-80 (E.D. Tex.) (Dkt. No. 388).**

[27] **From the preliminary instructions in *VirnetX v. Microsoft Corp.*, Case No. 6:07-CV-80 (E.D. Tex.) (Dkt. No. 388).**

[Defendants propose:

Overview of Applicable Law

I will now explain to you briefly the legal requirements for each of the grounds on which the Defendants rely to contend that the asserted patent claims are invalid. I will provide more details for each ground in my final instructions at the end of the case. The first ground is what is called anticipation, which means that a claim is not new or novel. To prove that a claim is anticipated a party must prove that each and every limitation of the claim was present in a single previous device or method, or sufficiently described in a single previous printed publication or patent. We call these "prior art."[28]

Another way that a claim may be invalid is that it may have been obvious. Even though every element of a claim is not shown or sufficiently described in a single piece of "prior art," the claim may still be invalid if it would have been obvious to a person of ordinary skill in the art at the time the invention was made. You will need to consider a number of questions in deciding whether the inventions claimed in the '906 and '985 Patents are obvious. I will provide you detailed instructions on these questions at the conclusion of the case.[29]

A patent may also be invalid if its description in the specification does not meet certain requirements. The written description is satisfied if a person of ordinary skill in

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[28]Adapted from the preliminary instructions in *VirnetX v. Microsoft Corp.*, Case No. 6:07-CV-80 (E.D. Tex.) (Dkt. No. 388); Federal Circuit Bar Association, Model Jury Instructions, § A.4 Overview of Applicable Law (Oct.. 2001).

[29]Adapted from the preliminary instructions in *VirnetX v. Microsoft Corp.*, Case No. 6:07-CV-80 (E.D. Tex.) (Dkt. No. 388); Federal Circuit Bar Association, Model Jury Instructions, § A.4 Overview of Applicable Law (Oct.. 2001).

the field, reading the patent application as originally filed, would recognize that the patent application described the invention of the claim, even though the description might not use the exact words found in the claim.]

Duty of the Jury

I want to discuss your duties as jurors. Really, you have two duties. Your first duty is to decide the facts from the evidence in this case. That is your job and yours alone. Your second duty is to apply the law that I give you to the facts. You must follow the instructions I give you even if you disagree with them.

This just about concludes my preliminary instructions. Do not be concerned if you feel a little bit lost at this point.

I will be giving you much more detailed, written final instructions at the end of the case that will have all of these instructions in much greater detail, accompanied by a verdict form **[UC and Eolas propose: that will ask you a very simple question dealing with the issue of invalidity]**.

By the time you get to that question, you will have a much greater understanding and confidence in answering them than you probably do today before you have heard any of the evidence.

Also, let me reassure you, you do not have to be an expert on patent law or the field of the invention. We have very fine attorneys on both sides who will do a good job of simplifying and explaining all of this to you, and they will call very capable experts who will help you to understand the issues and facts of this case.

I have tried many of these cases, and almost always by the end of the case, the jury feels very comfortable and confident in deciding the issues in the case. I'm sure your experience will be no different.

It is now time for opening statements and the Court will recognize counsel for purposes of opening statements.