

EXHIBIT B

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

**EOLAS TECHNOLOGIES
INCORPORATED and
THE REGENTS OF THE
UNIVERSITY OF CALIFORNIA,**

Plaintiff,

v.

**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.,**

Defendants.

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CASE NO. 6:09-CV-00446-LED

JURY TRIAL

**JOINT PROPOSED FINAL JURY INSTRUCTIONS
FOR THE INVALIDITY TRIAL^{1, 2}**

¹Plaintiffs and Defendants reserve the right to modify or amend these proposed instructions prior to the Court's charge conference if so warranted.

²While 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 INSTRUCTIONS³

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 the question from the facts as you find them. Do not decide who you think should win and then answer the question accordingly. Your answer and your verdict must be unanimous.

³From 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 TESTIMONY⁴

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

⁴Verbatim 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 EVIDENCE⁵

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.

⁵From 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 CONTENTIONS⁶

I will first give you a summary of each side's contentions in this case. I will then tell you what must be proved to win on the issues.

[UC and Eolas propose: In this case, as I have told you, the Court has determined to try the issue of invalidity first, and you are not to concern yourselves with the issue of infringement. 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") contend that the Asserted Claims of U.S. Patent No. 5,838,906 (the "906 Patent") and U.S. Patent No. 7,599,985 (the "985 patent") are invalid. 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.

Plaintiffs, Eolas Technologies Incorporated and The Regents of The University of California contend that none of the asserted claims is invalid.]⁷

⁶ Adapted from the Court's Final Jury Instructions in *Fractus S.A. v. Samsung Electronics Co.*, Civil Action No. 6:09-CV-203 (E.D. Tex. May 23, 2011).

⁷ **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.**

[Defendants propose: Plaintiffs, Eolas Technologies Incorporated, referred to as “Eolas,” and The Regents of The University of California, referred to as “The University of California,” (collectively, “Plaintiffs”)⁸ 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”) infringe certain claims of U.S. Patent No. 5,838,906 (“the ’906 patent”) and U.S. Patent No. 7,599,985 (“the ’985 patent”).

Defendants contend that the Asserted Claims of the patents-in-suit are invalid.⁹ Generally, Defendants contend that the ’906 and ’985 patents are invalid because the claimed inventions were “anticipated,” meaning not new, would have been obvious to one of ordinary skill in the art, and fail to have an adequate written description.

Your job is to decide only whether one or more of the asserted claims of the ’906 Patent and the ’985 Patent 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. The issues of infringement will be decided later, if necessary, by a different jury or juries. Because this is a validity trial, you will not consider the issue of infringement at all. The fact that

⁸ **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.**

⁹ **AIPLA’s Model Patent Jury Instructions at § II.**

infringement has not been decided should not affect how you decide whether the patents-in-suit are invalid.]

Your job is to decide whether any of the asserted claims of the '906 and '985 patents are invalid.

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.”

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.

The “clear and convincing” standard means that the evidence produces in your mind a firm belief or conviction as to the matter at issue. 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 heavily toward the party who has the burden of proof.^{10]}

[Defendants propose: Defendants have the burden of proving invalidity of the '906 and '985 patents. Validity determinations are made on a claim-by-claim basis. Defendants must prove invalidity by clear and convincing evidence. Clear and convincing evidence means evidence that convinces you that the claim or defense is highly probable.^{11]}

¹⁰ **Adapted from the Court’s Preliminary 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.**

¹¹ **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—here and throughout the instructions—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.”).**

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.

4. MEANING OF THE CLAIM TERMS¹²

4.1 PATENT CLAIMS

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 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.

¹²Adapted 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 CLAIMS¹³

In deciding whether or not an asserted claim is invalid, 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 invalid. 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.

¹³Adapted 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).

4.3 OPEN-ENDED OR “COMPRISING” CLAIMS¹⁴

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.”

[Defendants propose: 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. 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. If you decide that a prior art reference includes all the requirements or steps in that claim, the claim is invalid as anticipated by that prior art reference. This is true even if the prior art reference includes components or steps in addition to those requirements.¹⁵

For example, a claim to a table comprising a tabletop, legs, and glue would be anticipated by a table that includes a tabletop, legs, and glue, even if the table also includes wheels on the table’s legs.^{16]}

¹⁴Adapted 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).

¹⁵**The Regents of the University of California and Eolas object to the instruction regarding anticipation at this point of the instructions as superfluous and irrelevant for the purpose of the definition of comprising.**

¹⁶**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.

[UC and Eolas propose: To find invalidity, 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.¹⁷ 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.]

¹⁷**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.**

[Defendants propose: In order to find anticipation of a dependent claim, you must first determine whether the independent claim to which it refers is anticipated. 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 is not anticipated, then the dependent claim is not anticipated. If you decide that the independent claim is anticipated, you must then separately determine whether each additional requirement of the dependent claim has also been included in the prior art reference. If each additional requirement has been included, then the dependent claim is anticipated.]¹⁸

For example, claim 3 of the '906 Patent is not at issue here, but it 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 anticipated, then claim 3 is not anticipated either.

¹⁸**The Regents of the University of California and Eolas object to the failure of Defendants' instruction to address obviousness.**

4.5 INTERPRETATION OF CLAIMS¹⁹

In deciding 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 A²⁰ to this Charge.²¹ 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.

¹⁹ 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).

²⁰ **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 or to its rejection of Defendants' indefiniteness defenses.**

²¹ **Plaintiffs do not waive any rights regarding objections to the Court's claim constructions and specifically reserve the right to appeal.**

4.6 GLOSSARY OF PATENT TERMS

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

5. INVALIDITY

5.1 INVALIDITY GENERALLY

[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.]²²²³ [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. 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. You may consider whether or not the Patent Office examiner considered the prior art being asserted by the Defendants in making your evaluation.]²⁴ Each claim of a patent is presumed valid independently of the validity of the other claims.

²²Adapted from *Bedrock Computer Technologies LLC v. Google, Inc.*, Civil Action No. 6:09-CV-269 LED (E.D. Tex. April 15, 2011); *Fractus S.A. v. Samsung Electronics Co.*, Civil Action No. 6:09-CV-203 (E.D. Tex. May 23, 2011).

²³Defendants object—here and throughout the instructions—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.”).

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

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. 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.²⁵

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.]²⁶

²⁵**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); and *Fractus S.A. v. Samsung Electronics Co.*, Civil Action No. 6:09-CV-203 (E.D. Tex. May 23, 2011).**

²⁶**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. As noted previously, Defendants also object to parallel instruction on the “presumption of validity,” as redundant and potentially confusing. *See n.* [10].**

[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 therefore does not apply to your determination where, on the facts as you have found them, a claimed invention was obvious.²⁷

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.^{28]}²⁹

²⁷ ***Microsoft Corp. v. i4i Ltd. P'ship*, 131 S. Ct. 2238, 2253 (Breyer, J., concurring); *Addington v. Texas*, 441 U.S. 418, 423 (1979).**

²⁸ **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); *Mendenhall v. Cedarapids, Inc.*, 5 F.3d 1557, 1563-64 (Fed. Cir. 1993).**

²⁹ **The Regents of the University of California and Eolas object to the two paragraphs Defendants propose because they are inaccurate and/or incomplete statements of the law and/or improper comments.**

[DEFENDANTS PROPOSE: 5.2 DATE OF INVENTION³⁰

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

In this case, you must determine the date of invention of the asserted claims of the ’906 and ’985 patents. 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 thereafter. Diligence means working continuously, though not necessarily every day. Conception is the mental part of an inventive act, *i.e.*, the formation in the minds of the inventors of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice, even if the inventors 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 inventors’ minds 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 inventors have to have a prototype built, or actually explained their invention to another person. But, there must be some evidence beyond the inventors’ own testimony that confirms the date on which the inventors had the complete idea. Conception may be proven when the invention is shown in its complete form by drawings, disclosure to another person, or similar forms of evidence presented at trial.

³⁰**The proposed instruction of the Regents of the University of California and Eolas regarding date of invention appears within the instruction entitled “Anticipation - Made or Invented By Someone Else,” as provided in the National Jury Instruction Project, MODEL PATENT JURY INSTRUCTION 5.6.**

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 inventors file a patent application in which the invention been fully described.

Defendants have the burden of going forward, that is, of producing evidence and presenting persuasive argument based on new evidence or evidence already presented, of invalidating prior art. Once Defendants have met that burden, Plaintiffs then have the burden of going forward with evidence to the contrary, that is, Plaintiffs must show that the prior art does not actually invalidate the patent or that it is not prior art because the asserted claims are entitled to an earlier date of invention than the effective filing date of October 17, 1994.^{31, 32}

You do not need to determine the date of invention for patents filed or publications made anywhere in the world, or prior public or commercial uses occurring in the United States one year before the effective filing dates of the '906 Patent and the '985 Patent, on October 17, 1994.³³

I will now instruct you on the invalidity issues you should consider.]

³¹ Sources: *Research Corp. Tech., Inc. v. Microsoft Corp.* 627 F.3d 859, 870 (Fed. Cir. 2010); *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1329 (Fed. Cir. 2008).

³² The Regents of the University of California and Eolas object to this paragraph as an inaccurate and/or incomplete statement of law and an improper comment at this location of the instructions.

³³ The Regents of the University of California and Eolas object to this paragraph and the preceding paragraph as an inaccurate and/or incomplete statement of law and an improper comment.

5.3 ANTICIPATION—PUBLICLY USED OR KNOWN, OR PREVIOUSLY PUBLISHED³⁴

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.]^{35]}³⁶**

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. **[UC and Eolas propose: The Defendants must prove by clear and convincing evidence that the claim was anticipated.]³⁷**

³⁴Adapted 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***Adv. Display Systems, Inc. v. Kent St. Ohio*, 212 F.3d 1272, 1282 (Fed. Cir. 2000).**

³⁶**Defendants object to this instruction as an inaccurate and/or incomplete statement of law and an improper comment.**

³⁷**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 singly burden of proof in this invalidity trial. The Court only needs to state and explain that burden once in these instructions.**

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.

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 Defendants can show that a patent claim was not new:

[UC and Eolas propose:

- **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 before the date of the 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.**

- **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 the patent holder’s filing date or the date of invention.³⁸**

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

[Defendants propose:

- 1. 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 was invented by the patent applicants.^{39, 40}**
- 2. 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.⁴¹**
- 3. 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 the patent holder’s filing or the date of invention.**

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

³⁸ **These instructions are verbatim from The National Jury Instruction Project, MODEL PATENT JURY INSTRUCTIONS, Instruction 5.5 (June 17, 2009).**

³⁹ **35 U.S.C. § 102(a).**

⁴⁰ **The Regents of the University of California and Eolas object to the omission of the word “publicly” to modify “known” or “used.” The knowledge and use required by 35 U.S.C. § 102(a) has long been interpreted as public knowledge or use. See *In re Ward*, 376 F.2d 982 (C.C.P.A. 1967).**

⁴¹ **The Regents of the University of California and Eolas object to this instruction because the substance of this instruction is merely a repetition of the substance of the immediately preceding instruction proposed by Defendants.**

[DEFENDANTS PROPOSE:

5.4 ANTICIPATION BY PUBLIC KNOWLEDGE OR USE OR SALE⁴²

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.]

⁴²Adapted from *Clear with Computers, LLC v. Hyundai Motor America, Inc.*, Case No. 6:09-CV-479 (E.D. Tex. June 2011) (Dkt. No. 352).

5.5 ANTICIPATION—MADE OR INVENTED BY SOMEONE ELSE⁴³

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 **[Defendants propose: , suppressed or concealed]** the invention **[UC and Eolas propose: or kept it secret];⁴⁴** and

[UC and Eolas propose: *Second*, 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

⁴³Adapted 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).

⁴⁴**Verbatim from The National Jury Instruction Project, MODEL PATENT JURY INSTRUCTIONS, Instruction 5.6 (June 17, 2009).**

work with reasonable diligence to reduce it to practice from a time just before the other party's conception.

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 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 attendant 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 alleged 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.^{45]}⁴⁶

[Defendants propose: *Second*, 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.]

⁴⁵ **Adapted from The National Jury Instruction Project, MODEL PATENT JURY INSTRUCTIONS, Instruction 5.6 (June 17, 2009).**

⁴⁶ **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.**

5.6 ANTICIPATION–STATUTORY BARS⁴⁷

Defendants may prove that the asserted claims of the '906 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 filing 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:

1. 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, which effective filing dates are both 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.

2. 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, **[UC and Eolas propose: and that use was not primarily an experimental use controlled by the inventor to test whether the invention worked for its intended purpose;⁴⁸] [Defendants propose: In this case, the May 7, 1993 demonstration of Viola to two Sun Microsystems employees without confidentiality agreements qualifies as a potentially**

⁴⁷Adapted 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 5.7 (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).

⁴⁸**This sentence is verbatim from The National Jury Instruction Project, MODEL PATENT JURY INSTRUCTIONS, Instruction 5.7 (June 17, 2009).**

invalidating public use. It is your job to determine whether that public use anticipates one or more claims of the patents-in-suit.⁴⁹⁵⁰

3. 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.⁵¹]**

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.

⁴⁹***Eolas Techs, Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1335 (Fed. Cir. 2005).**

⁵⁰**The Regents of the University of California and Eolas object to this instruction as an inaccurate statement of law and an improper comment.**

⁵¹**Verbatim from The National Jury Instruction Project, MODEL PATENT JURY INSTRUCTIONS, Instruction 5.7 (June 17, 2009).**

5.7 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.]^{52, 53} 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.⁵⁴

⁵² **Adapted from the Court's Final Jury Instructions in *Fractus S.A. v. Samsung Electronics Co.*, Civil Action No. 6:09-CV-203 (E.D. Tex. May 23, 2011) (Dkt. No. 997); *i4i Limited Partnership v. Microsoft Corp.*, Civil Action No. 6:07-CV-113 (E.D. Tex. May 19, 2009) (Dkt. No. 323).**

⁵³ **Defendants object to this instruction as an incorrect and incomplete statement of the law.**

⁵⁴ 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).

[UC and Eolas propose: If evidence is presented for purposes of attempting to corroborate oral testimony, then you must determine whether this evidence does, in fact, properly corroborate the oral testimony. In making this determination, you should consider the following factors:

- (1) The relationship between the corroborating witness and the alleged prior user;**
- (2) The time period between the event and this trial;**
- (3) The interest of the corroborating witness in the subject matter of this suit;**
- (4) Contradiction or impeachment of the witness's testimony;**
- (5) Extent and detail of the corroborating witness's testimony;**
- (6) The witness's familiarity with the subject matter of the patented invention and the alleged prior use;**
- (7) Probability that a prior use could occur considering the state of the art at the time; and**
- (8) Impact of the invention on the industry, and the commercial value of its practice.^{55]}**

⁵⁵**From the Court's Final Jury Instructions in *Fractus, S.A. v. Samsung Electronics Co.*, Civil Action No. 6:09-CV-203 (E.D. Tex. May 23, 2011) (Dkt. No. 997); *i4i Limited Partnership v. Microsoft Corp.*, Civil Action No. 6:07-CV-113 (E.D. Tex. May 19, 2009) (Dkt. No. 323).**

5.8 OBVIOUSNESS⁵⁶

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 **[Defendants propose: which includes patents, publications, devices, and prior uses, knowledge, or invention, as I explained before,]** 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

⁵⁶Adapted 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 5.9 (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).

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 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 scope and content of the prior art. In determining the scope and content of the prior art, **[Defendants propose: which includes patents, publications, devices, and prior uses, knowledge or inventions, as I explained before]** 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.
2. 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. a long-felt, but unsolved, need for the solution provided by the claimed invention;
 2. unsuccessful attempts by others to find the solution provided by the claimed invention;
 3. unexpected and superior results from the claimed invention;
 - 4. [UC and Eolas propose: 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;]**

5. 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; and
6. other evidence tending to show non-obviousness.

You may consider the present of any of the list factors A.1-6 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.
2. other evidence tending to show obviousness.

[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.^{57]}⁵⁸

You may consider the presence of the factor B.1 and 2 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

⁵⁷Source: *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416-21 (2007).

⁵⁸**The Regents of the University of California and Eolas object to the Defendants' additional three paragraphs of instructions on obviousness as redundant and unnecessary for the jury's understanding of the defense of obviousness. These instructions do not appear in the National Jury Instructions Project, MODEL PATENT JURY INSTRUCTIONS, nor do they appear to have ever been given by the Court.**

invention would have been obvious is up to you. The Defendants must prove by clear and convincing evidence that a claimed invention was obvious.

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

5.8 LEVEL OF ORDINARY SKILL

Several times in my instructions I have referred to a person of ordinary skill in the field of the invention.⁵⁹

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.**

⁵⁹Adapted 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).

5.9 WRITTEN DESCRIPTION⁶⁰

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. **[UC and Eolas propose: Defendants must prove by clear and convincing evidence that these claims lacked an adequate written description.]⁶¹⁶²**

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.

⁶⁰Adapted from THE NATIONAL JURY INSTRUCTION PROJECT MODEL PATENT JURY INSTRUCTIONS § 7.10 (June 17, 2009); *Fractus, S.A. v. Samsung Electronics Co.*, Civil Action No. 6:09-CV-203 LED (E.D. Tex. May 23, 2011).

⁶¹**Verbatim from The National Jury Instruction Project, MODEL PATENT JURY INSTRUCTIONS, Instruction 7.10 (June 17, 2009).**

⁶²**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.**

[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.⁶³]⁶⁴

⁶³ ***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).**

⁶⁴ **The Regents of the University of California and Eolas object to the instructions as repetitive and redundant. These instructions do not appear in the National Jury Instructions Project, MODEL PATENT JURY INSTRUCTIONS, nor do they appear to have ever been give by the Court.**

6. INSTRUCTIONS FOR DELIBERATIONS⁶⁵

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.⁶⁶

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

⁶⁵FIFTH CIRCUIT PATTERN JURY INSTRUCTIONS – CIVIL, § 3.1 General Instruction for Charge

⁶⁶Adapted 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.