

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

WI-LAN INC.,

Plaintiff,§

Case No. 6:10-cv-521-LED
Case No. 6:13-CV-00252-LED
CONSOLIDATED CASES

v.

ALCATEL-LUCENT USA INC. *et al.*,

Defendants.

JURY TRIAL DEMANDED

REVISED COMBINED PROPOSED JURY INSTRUCTIONS¹

Legend:

1. Instructions highlighted in yellow are those proposed by Plaintiff only.
2. Instructions highlighted in blue are proposed by Defendants only.
3. Instructions that are not highlighted are agreed.

¹ The parties are filing these revised proposed instructions and interrogatories as part of the matters required to be filed in the Docket Control Order, as amended. The parties reserve the right to request such additional or supplemental instructions and interrogatories as may be necessary. By submitting these requested instructions and interrogatories, the parties are not conceding that there are any fact issues for the jury to resolve or that there is legally sufficient evidence to support the submission of any claims or defenses. The parties expressly reserve their rights to file motions seeking judgment as a matter of law under Rule 50 of the Federal Rules of Civil Procedure. Moreover, by specifically noting some objections to certain proposed instructions, the parties are not waiving their right to assert additional objections to the Court's instructions as provided for by Rule 51 of the Federal Rules of Civil Procedure.

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1 FINAL INSTRUCTIONS AFTER THE CLOSE OF EVIDENCE

1.1 INTRODUCTORY INSTRUCTIONS

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 in the course of 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 the jury in understanding the evidence and the parties' contentions.

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

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

When a party has the burden of proof on any claim or defense by "clear and convincing evidence," it means the evidence **has produced in your mind a firm belief or conviction as to the matter.** Again, you should base your decision on all the evidence, regardless of which party presented it.

You will recall that during the course of this trial I instructed you that certain testimony and certain exhibits were admitted into evidence for a limited purpose and I instructed you that you may consider some documents as evidence against one party but not against another. You may consider such evidence only for the specific limited purposes for which it was admitted.

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 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.

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.

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. By way of example, if you wake up in the morning and see that the sidewalk is wet, you may find from that fact that it rained during the night. However, other evidence, such as a turned on garden hose, may provide a different explanation for the presence of water on the sidewalk. Therefore, before you decide that a fact has been proved by circumstantial evidence, you must consider all the evidence in the light of reason, experience, and common sense.² As a general rule, the law makes no distinction between direct and circumstantial evidence.

When knowledge of technical subject matter may be helpful to the jury, a person who has special training or experience in that technical field—he is called an expert witness—is permitted to state his 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.

In deciding whether to accept or rely upon the opinion of an expert witness, you may consider any bias of the witness, including any bias you may infer from evidence that the expert witness has been or will be paid for reviewing the case and testifying, or from evidence that he testifies regularly as an expert witness and his income from such testimony represents a significant portion of his income.

Certain testimony in this case was presented to you through a deposition. A deposition is the sworn, recorded answers to questions asked a witness in advance of the trial. This deposition

² Wi-LAN objects to this proposed instruction because it is not necessary and improperly suggests that circumstantial proof is subject to different requirements than direct proof. Moreover, this language does not appear in the Fifth Circuit Pattern instructions that are the source for these instructions.

testimony given under oath is entitled to the same consideration and is to be judged by you as to credibility and weight as if the witness had been present and had testified from the witness stand in court.

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.³

1.2 CONTENTIONS OF THE PARTIES

Wi-LAN contends the following eight Defendants make, use, offer to sell, sell, or import products that infringe its patents: Alcatel-Lucent USA Inc.; HTC Corporation; HTC America, Inc.; and Exedea Inc. (I will refer to HTC Corporation; HTC America, Inc.; and Exedea Inc., collectively, as “HTC”); Ericsson Inc. and Telefonaktiebolaget LM Ericsson (I will refer to Ericsson Inc. and Telefonaktiebolaget LM Ericsson, collectively, as “Ericsson”); and Sony Mobile Communications AB and Sony Mobile Communications (USA) Inc. (I will refer to Sony Mobile Communications AB and Sony Mobile Communications (USA) Inc. as “Sony Mobile”).

Wi-LAN contends that Defendants’ base station products that comply with the HSDPA standard necessarily infringe one or more of claims 2, 5 and 9 of the ’326 patent; one or both of claims 11 and 12 of the ’327 patent; and claim 11 of the ’819 patent. Wi-LAN also contends that Defendants’ cellular phone, smartphone, or handset products that comply with the HSDPA standard necessarily infringe one or both of claims 2 and 5 of the ’211 patent.

³ Fifth Circuit Model Instructions 3.1 (as modified)

In particular, Wi-LAN contends that Alcatel-Lucent and Ericsson make, use, offer to sell, sell, or import into the United States certain products—specifically, cell phone base stations—that infringe the following claims of the patents at issue in this case: claims 2, 5, and 9 of U.S. Patent No. 6,088,326 ('326 Patent); claims 11 and 12 of U.S. Patent No. 6,195,327 ('327 Patent); and claim 11 of U.S. Patent No. 6,222,819 ('819 Patent). Wi-LAN contends that several Alcatel-Lucent products, including but not limited to the Alcatel-Lucent 9300 W-CDMA Node B base station products and the Alcatel-Lucent 9360 Small Cell base station products, infringe the patent claims listed above. A full list of Alcatel-Lucent's accused products in this case is attached to my instructions as Exhibit 1. Wi-LAN contends that the following Ericsson products infringe the patent claims listed above: the Ericsson RBS-3000 and Ericsson RBS-6000 products. A full list of Ericsson's accused products in this case is attached to my instructions as Exhibit 2.

Wi-LAN also contends that HTC and Sony Mobile make, use, sell, offer for sale, or import into the United States certain products—specifically, smartphone handsets—that infringe the following claims of the patents at issue in this case: claims 2 and 5 U.S. Patent No. 6,381,211 ('211 Patent). Wi-LAN contends that several HTC smartphones, including but not limited to the HTC Amaze 4G, the HTC myTouch 3G, and the HTC Dash 3G, infringe the patent claims listed above. A full list of HTC's accused products in this case is attached to my instructions as Exhibit 3. Wi-LAN contends that several Sony Mobile smartphones, including but not limited to the Sony Mobile Xperia X10, the Sony Mobile Xperia Play, the Sony Mobile Xperia Ion, and the Sony Mobile Xperia X8, infringe the patent claims listed above. A full list of Sony Mobile's accused products in this case is attached to my instructions as Exhibit 4.

Wi-LAN contends that Alcatel-Lucent and Ericsson infringe the following claims:

- Claims 2, 5, and 9 of the '326 Patent;

- Claims 11 and 12 of the '327 Patent;
- Claim 11 of the '819 Patent.

Wi-LAN contends that HTC and Sony Mobile infringe the following claims:

- Claims 2 and 5 of the '211 Patent.

I will refer, collectively, to all of these claims of the patents in suit as the “Asserted Claims” of those patents. Evidence concerning the '326, '327, and '819 patents should not be considered when evaluating the liability of HTC or Sony Mobile since they are only accused of infringing the '211 patent. Similarly, evidence concerning the '211 patent should not be considered when evaluating the liability of Alcatel-Lucent and Ericsson since they are only accused of infringing the '326, '327, and '819 patents.

Alcatel-Lucent, Ericsson, HTC, and Sony Mobile deny that they infringe the Asserted Claims, and contend that the Asserted Claims of the '326, '819, and '211 patents are invalid for anticipation and obviousness. Although a patent is presumed valid,⁴ invalidity is a defense to infringement. Therefore, even though the PTO examiner has allowed the claims of the patents, you, the jury, must decide whether they are invalid. Your job is to decide whether Wi-LAN has proven by a preponderance of the evidence that Defendants infringe one or more asserted claims of the above four patents, and whether Defendants have proven by clear and convincing evidence that the asserted patent claims are invalid. If you decide that any valid claim of the patent has been infringed, you will then need to decide the money damages to be awarded to Wi-LAN as compensation for the infringement. Conversely, if you decide that any claim of the patents has

⁴ 35 U.S.C. § 282 (“A patent shall be presumed valid...”); *Microsoft Corp. v. i4i Ltd. P’ship*, 131 S.Ct. 2238, 2245 (2011) (“Thus, by its express terms, Section 282 establishes a presumption of patent validity, and it provides that a challenger must overcome that presumption to prevail on an invalidity defense.”).

not been infringed or is invalid, then you do not need to decide any money damages to be awarded to Wi-LAN for that patent claim.⁵

1.3 PATENT CLAIMS

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 are usually divided into parts or steps, called limitations 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 on the tabletop. In this example, the tabletop, legs and glue are each a separate requirement of the claim.⁶

1.4 OPEN-ENDED OR “COMPRISING CLAIMS”

The beginning, or preamble, of a number of the patent claims use the word “comprise” or “comprising.” “Comprising” means “including” or “containing but not limited to.” That is, if you decide that one of Alcatel-Lucent’s, Ericsson’s, HTC’s, or Sony Mobile’s accused products includes all the requirements in a particular claim, the claim is infringed. This is true even if the accused product includes components in addition to those requirements.

For example, a claim to a table comprising a tabletop, legs, and glue would be infringed by a table that includes a tabletop, legs, and glue, even if the table also includes wheels on the table’s legs.⁷

1.5 DEPENDENT CLAIMS

This case involves two types of patent claims: independent claims and dependent claims.

⁵ Wi-LAN objects to this instruction as it is unnecessary and confusing.

⁶ CEATS Charge § 3.1.

⁷ NJIP Model Instructions 3.4.

An “independent claim” sets forth all of the requirements that must be met in order to be covered by that claim. Thus, it is not necessary to look at any other claim to determine what an independent claim covers. In this case, for example, claim 5 of the ’326 Patent; claim 11 of the ’327 Patent; and claim 5 of the ’211 Patent are independent claims.

The rest of the claims being asserted in this case are “dependent claims.” A dependent claim refers to another claim and includes all the requirements or parts of the claim to which it refers. In this way the claim “depends” on another claim. The dependent claim then adds its own, additional requirements. To determine what a dependent claim covers, it is necessary to look at both the dependent claim and any other claim to which it refers. A product or method that meets all of the requirements of both the dependent claim and the claim to which it refers is covered by that dependent claim.⁸

1.6 CONSTRUCTION OF CLAIMS

In deciding whether or not a patent is infringed, the first step is to understand the meaning of the words used in the patent claims. It is my job as Judge to determine what the patent claims mean and to instruct you about that meaning. You must accept the meanings I give you and use those meanings when you decide whether or not the patent claims are infringed, and whether or not they are invalid. I have interpreted the meaning of⁹ some of the language in the patent claims involved in this case. My interpretation of that claim language appears in Exhibit A to this charge, which I will now read to you.

The claim language I have not interpreted for you in Exhibit A is to be given its ordinary and accustomed meaning as understood by one of ordinary skill in the art, which is to say, in the

⁸ VirnetX Charge § 4.1.

⁹ *Fractus S.A. v. Samsung Electronics Co.*, Civil Action No. 6:09-CV-203 (Jury Charge Dkt. No. 997).

field of technology of the patent. The meaning of the words in the patent claims must be the same when deciding both infringement and validity.

1.7 INFRINGEMENT—GENERALLY

Any person or business entity that, without the patent owner's permission, makes, uses, sells, or offers to sell a device that is covered by at least one claim of a patent infringes the patent. Wi-LAN has the burden of proving infringement by a preponderance of the evidence. Only the claims of a patent can be infringed. You must consider each claim individually.

You must compare each of the asserted claims, as I have defined them, to each of the Defendants' accused devices, and determine whether or not there is infringement. **In order to prove infringement, Wi-LAN must prove that Defendants' products perform each and every requirement of the asserted claims.**¹⁰

Infringement can be proven in either of two ways: by literal infringement or by the doctrine of equivalents.

I will now instruct you on the specific rules you must follow to determine whether Wi-LAN has proven that Defendants have infringed any of the asserted claims of the patents-in-suit.¹¹

1.8 INFRINGEMENT—LITERAL INFRINGEMENT

You must decide whether Alcatel-Lucent, Ericsson, HTC, and Sony Mobile have made, used, sold, or offered for sale within the United States, or imported into the United States, a product covered by one or more of the asserted claims of the four patents at issue in this case. Literal infringement must be analyzed by taking one product and one claim at a time. You must compare each patent claim to each of the accused products of Alcatel-Lucent, Ericsson, HTC,

¹⁰ Wi-LAN objects to this language because it places undue emphasis on a general instruction and is repeated almost verbatim in the two following instructions.

¹¹ NJIP Model Instructions 3.1.

and Sony Mobile to determine whether each product includes all the requirements of the patent claim you are considering.

To prove literal infringement for a particular patent claim by a specific Defendant, Wi-LAN must prove that it is more probably true than not true that an accused product of that Defendant includes every requirement in that patent claim. If an accused product omits any requirement recited in a patent claim, then that product does not literally infringe that claim. In making your determination, you must consider each Defendant separately, each claim separately, and each accused product separately.¹²

For literal infringement, Wi-LAN is not required to prove the specific Defendant intended to infringe or knew of the patent.¹³

¹² Adapted from the Court's Final Jury Charge in *Bedrock Computer Techs., LLC v. Google, Inc.*, No. 09-CV-269-LED (E.D. Tex. 2011) (Jury Charge Dkt. No. 745).

¹³ Fifth Circuit Model Instructions 9.1; NJIP Model Instructions 3.2; AIPLA 2012 Model Jury Instructions § 3.1; CEATS Charge § 4; VirnetX Charge § 5.1. Defendants object to the inclusion of this language as unnecessary and irrelevant to the issue of literal infringement.

1.9 LITERAL INFRINGEMENT—COMPLIANCE WITH STANDARD

Wi-LAN may also prove literal infringement by showing that (a) all products that practice or comply with the HSDPA standard literally infringe one or more claims of the asserted patents and (b) the Defendant's accused product practices or complies with the HSDPA standard.^{14,15}

1.10 INFRINGEMENT—DOCTRINE OF EQUIVALENTS

In addition to literal infringement, Wi-LAN alleges that Alcatel-Lucent, Ericsson, HTC, and Sony Mobile infringed certain claims of the four patents under the “doctrine of equivalents.” The doctrine of equivalents is an alternative way of showing infringement of a claim. Thus, a claim may be literally infringed, or it may be infringed under the doctrine of equivalents.

To prevail on its allegation of infringement under the doctrine of equivalents, Wi-LAN must prove that it is more probably true than not true that the accused product contains requirements identical or equivalent to each claimed requirement of the patented invention. You must proceed on a requirement-by-requirement basis. Wi-LAN must establish that each element in the claim is present in the accused product, either literally or under the doctrine of equivalents.

A claim element is present in an accused product under the doctrine of equivalents if the difference between the claim requirement and a corresponding aspect of the accused product is

¹⁴ *Fujitsu Limited v. Netgear, Inc.*, 620 F.3d 1321, 1327-28 (Fed. Cir. 2010) (if reach of a patent claim includes any device that practices a standard and the accused product operates in accordance with a standard, then comparing the claims to the standard is the same as comparing the claims to the accused product).

¹⁵ Defendants object to this instruction as an inaccurate statement of the law. As a threshold matter, “[o]nly in the situation where a patent covers every possible implementation of a standard will it be enough to prove infringement by showing standard compliance.” *Fujitsu Limited*, 620 F.3d at 1328. Further, “in many instances, an industry standard does not provide the level of specificity required to establish that practicing that standard would always result in infringement. Or, as with the [patent-in-suit], the relevant section of the standard is optional, and standards compliance alone would not establish that the accused infringer chooses to implement the optional section.” *Id.* at 1327-28.

insubstantial. In making this determination, you may consider whether the corresponding aspect in the accused product performs substantially the same function in substantially the same way to achieve substantially the same result as the element in the claim. You may also consider whether people of ordinary skill in the art believed that the corresponding aspect of the accused product and the element recited in the patent claim were interchangeable at the time of the alleged infringement. The proper time for evaluating equivalency—and thus knowledge of interchangeability between elements—is the time of infringement, not the time the patent was issued. Under the doctrine of equivalents, those of ordinary skill in the art do not have to know of the equivalent when the patent application was filed or when the patent issued. Thus, the inventor need not have foreseen, and the patent need not describe, all potential equivalents to the invention covered by the claims. Also, changes in technique or improvements made possible by technology developed after the patent application is filed may still be equivalent for the purposes of the doctrine of equivalents.

For infringement under the doctrine of equivalents, Wi-LAN is not required to prove the specific Defendant intended to infringe or knew of the patent to prove infringement.¹⁶

If an entity makes, uses, sells, offers to sell within, or imports into the United States a product that does not meet all of the requirements of a claim and thus does not literally infringe that claim, there can still be direct infringement if that product satisfies that claim “under the doctrine of equivalents.”

Under the doctrine of equivalents, a product infringes a claim if it contains elements corresponding to each and every requirement of the claim that is equivalent to, even though not literally met by, the accused product. You may find that an element is equivalent to a

¹⁶ NJIP Model Instructions 3.8 (modified).

requirement of a claim that is not met literally if a person having ordinary skill in the field of technology of the patent would have considered the differences between them to be “insubstantial” or would have found that the element: (1) performs substantially the same function and (2) works in substantially the same way (3) to achieve substantially the same result as the requirement of the claim. In order to prove infringement by “equivalents,” Wi-LAN must prove the equivalency of the element to a claim requirement by a preponderance of the evidence.¹⁷

1.11 COMPLIANCE WITH A STANDARD – DOCTRINE OF EQUIVALENTS

As with literal infringement, Wi-LAN may also prove infringement under the doctrine of equivalents by showing that (a) all products that practice or comply with the HSDPA standard infringe one or more claims of the asserted patents under the doctrine of equivalents and (b) the Defendant’s accused product practices or complies with the HSDPA standard.^{18,19}

1.12 LIMITATIONS ON THE DOCTRINE OF EQUIVALENTS²⁰

In order for an element to be considered equivalent under the doctrine of equivalents, it must not have been foreseeable to the patentee at the time the patent issued. An equivalent is

¹⁷ CEATS Charge § 4; VirnetX Charge § 5.1; FBA Model Instructions B.3.1c.

¹⁸ *Fujitsu Limited v. Netgear, Inc.*, 620 F.3d 1321, 1327-28 (Fed. Cir. 2010) (if reach of a patent claim includes any device that practices a standard and the accused product operates in accordance with a standard, then comparing the claims to the standard is the same as comparing the claims to the accused product).

¹⁹ Defendants object to this instruction for the same reasons as discussed above with respect to section 2.10.

²⁰ Wi-LAN specifically adds to its reservations the contentions that, as to Defendants’ Proposed Instructions 2.13.1 to 2.13.5, Defendants lack sufficient evidence to be entitled to a jury instruction on these issues, that these issues are not properly preserved, and that these instructions add unnecessary complication. Defendants reply that these issues were disclosed in Defendants’ expert reports and discussed during the depositions of Wi-LAN’s expert and Defendants’ experts.

foreseeable if a person of ordinary skill in the art would have known that the alternative existed in the field of art, even if the suitability of the alternative was unknown.²¹

If you find that subject matter alleged to be an equivalent was foreseeable or was available in prior art, then you cannot find infringement under the doctrine of equivalents.

1.12.1 Prior art

You may not find that a component in the accused products is equivalent to a requirement of the patent claim if by doing so the patent would cover products or methods that were already in the prior art.²²

1.12.2 Foreseeability

In order for an element to be considered equivalent under the doctrine of equivalents, it must not have been foreseeable to the patentee at the time the patent issued. An equivalent is foreseeable if a person of ordinary skill in the art would have known that the alternative existed in the field of art, even if the suitability of the alternative was unknown.²³ If you find that subject matter alleged to be an equivalent was foreseeable, then you cannot find infringement under the doctrine of equivalents.²⁴

²¹ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 493 F.3d 1368, 1382 (Fed. Cir. 2007).

²² *DePuy Spine, Inc. v. Medtronic Sofamore Danek, Inc.*, 567 F.3d 1314, 1322 (Fed. Cir. 2009); *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 683, 685 (Fed. Cir. 1990); *Streamfeeder, LLC v. Sure-Feed Sys., Inc.*, 175 F.3d 974, 983 (Fed. Cir. 1999).

²³ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 493 F.3d 1368, 1382 (Fed. Cir. 2007).

²⁴ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 493 F.3d 1368, 1382 (Fed. Cir. 2007); *Sage Products, Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1425 (Fed. Cir. 1997) (“If Sage desired broad patent protection for any container that performed a function similar to its claimed container, it could have sought claims with fewer structural encumbrances. Had Sage done so, then the Patent and Trademark Office (PTO) could have fulfilled its statutory role in helping to ensure that exclusive rights issue only to those who have, in fact, contributed something new, useful, and unobvious. Instead, Sage left the PTO with manifestly limited claims that it now seeks to expand through the doctrine of equivalents. However, as between the patentee who had a clear opportunity to negotiate broader claims but did not do so, and the public at large, it is the patentee who must bear the cost of its failure to seek protection for this foreseeable alteration of its claimed structure.”); *see also Honeywell Int’l, Inc. v. Hamilton Sundstrand Corp.*, 523 F.3d

1.12.3 Vitiation²⁵

You may not determine that an alternative aspect of an accused product is equivalent to an unmet requirement of a claim if a finding of infringement under the doctrine of equivalents would effectively eliminate that requirement. Specifically, the alleged equivalent cannot eliminate or ignore a requirement of the claim.²⁶

1.12.4 Subject Matter Dedicated to the Public²⁷

When a patent discloses subject matter but does not claim it, the patentee has dedicated that unclaimed subject matter to the public. If you find that a patent in suit discloses, but does not claim, subject matter alleged to be equivalent to a requirement of the patent claim, then you cannot find that the subject matter alleged to be equivalent in the Defendants' products are equivalent to that requirement of the patent claim. This is true even if the failure to claim the subject matter was wholly unintentional.²⁸

1304, 1312-13 (Fed. Cir. 2008); *Freedman Seating Co. v. Am. Seating Co.*, 420 F.3d 1350, 1362 (Fed. Cir. 2005).

²⁵ Wi-LAN objects on the ground that claim vitiating is a question for the court, not the jury. *DePuy Spine, Inc. v. Medtronic Danek, Inc.*, 469 F.3d 1005, 1018–19 (Fed. Cir. 2006).

²⁶ FBA Model Instructions No. B.3.1d.

²⁷ Wi-LAN objects on the ground that a jury instruction on subject matter dedicated to the public is improper because application of the disclosure-dedication rule is a question of law. *Pfizer, Inc. v. Teva Pharms., USA, Inc.*, 429 F.3d 1364, 1378 (Fed. Cir. 2005); *Toro Co. v. White Consol. Indus., Inc.*, 383 F.3d 1326, 1331 (Fed. Cir. 2004); *Johnson & Johnston Assocs. Inc. v. R.E. Serv. Co.*, 285 F.3d 1046, 1054–55 (Fed. Cir. 2002) (en banc). Additionally, there is no material in defendants' expert reports concerning subject matter dedicated to the public.

²⁸ Adapted from AIPLA Model Patent Jury Instructions §3.13 (March 2008); *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 733-34 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 30-34 (1997); *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359, 1366-67 (Fed. Cir. 2003) (en banc); *Johnson & Johnston Assocs. Inc. v. R.E. Serv. Co.*, 285 F.3d 1046, 1054-55, 1067 (Fed. Cir. 2002) (en banc) (“[W]hen a patent drafter discloses but declines to claim subject matter . . . this action dedicates the unclaimed subject matter to the public. . . . [T]he patentee’s subjective intent is irrelevant in determining whether unclaimed subject matter has been disclosed and is therefore dedicated to the public.”).

1.13 INFRINGEMENT OF DEPENDENT CLAIMS

So far, my instructions on infringement have applied to independent claims. As previously noted, the patents also contain dependent claims. Each dependent claim refers to an independent claim. A dependent claim includes each of the requirements of the independent claim to which it refers and one or more additional requirements. For example, claim 2 of the '326 patent includes all of the requirements of claim 1 of the '326 patent along with several additional requirements.

In the '326 Patent, claims 2 and 9 are dependent claims. The other claim in the '326 Patent (claim 5) is an independent claim.

In the '327 Patent, claim 12 is a dependent claim, and claim 11 is an independent claim.

In the '819 Patent, claim 11 is a dependent claim.

In the '211 Patent, claim 2 is a dependent claim, while claim 5 is an independent claim.

In order to find infringement of a dependent claim, you must first determine whether the independent claim has been infringed. If you decide that the independent claim has not been infringed, then the dependent claim cannot have been infringed. If you decide that the independent claim has been infringed, you must then separately determine whether each additional requirement of the dependent claim has also been included in the accused product. If each additional requirement has been included, then you must find that the dependent claim has been infringed.

Wi-LAN must prove infringement by a preponderance of the evidence.²⁹

1.14 PERSON OF ORDINARY SKILL

²⁹ NJIP Model Instructions 3.7.

Several times in my instructions I have referred to a person of ordinary skill in the field of the invention. It is up to you to decide the level of ordinary skill in the field. You should consider all of the evidence introduced at trial in making this decision, including:

1. the levels of education and experience of persons working in the field;
2. the types of problems encountered in the field; and
3. the sophistication of the technology.³⁰

Wi-LAN contends that the level of ordinary skill in the field of the invention was a four-year degree in Electrical Engineering, Physics, or Computer Science with some experience in wireless communications or associated technologies.

1.15 INVALIDITY—GENERALLY

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 invalid. I will now instruct you on the invalidity issues you should consider. The Defendants must prove by clear and convincing evidence that a claim is invalid.

An issued patent is accorded a presumption of validity based on the presumption that the United States Patent & Trademark Office acted correctly in issuing a patent. 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. Each claim of a patent is presumed valid independently of the validity of the other claims. The presumption of validity remains intact and the burden of proof remains on the parties (here, on the Defendants) who are challenging validity

³⁰ NJIP Model Instructions 5.13 (as modified); *Graham v. John Deere Co.*, 383 U.S. 1 (1966); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000); *SIBIA Neurosciences, Inc. v. Cadus Pharm. Corp.*, 225 F.3d 1349, 1355 (Fed. Cir. 2000); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718-19 (Fed. Cir. 1991).

throughout this litigation. In other words, the burden never shifts to Wi-LAN to prove that its patents are valid.³¹

For a patent to be valid, the invention claimed in the patent must be new, useful, and not obvious. A patent cannot take away the ability to use what was known or would have been obvious before the invention was made.

In making your determinations as to invalidity, you must consider each claim separately. I will now instruct you on the invalidity defenses you must consider.³²

1.16 ANTICIPATION

Defendants claim that all of the asserted claims, except for the asserted claims of the 327 patent, are invalid for being anticipated by prior art. Defendants bear the burden of establishing anticipation by clear and convincing evidence.

A patent claim is invalid if the claimed invention is not new. For a claim to be invalid on the basis of anticipation because it is not new, all of its requirements must be present in a single previous publication or patent. We call these things prior art. Defendants must also prove by clear and convincing evidence that an item is prior art. The description in a reference does not have to be in the same words as the claim, but all the requirements of the claim must be there, either stated expressly or necessarily implied or inherent in the level of ordinary skill in the field of technology of the patent at the time of the invention, so that someone of ordinary skill in the

³¹ VirnetX Charge § 6; *Schumer v. Lab. Computer Sys., Inc.*, 308 F.3d 1304, 1315 (Fed. Cir. 2002); CEATS Charge § 2.1; 35 U.S.C. 282 (“A patent shall be presumed valid...”); *Microsoft Corp. v. i4i Ltd. P’ship*, 131 S.Ct. 2238, 2245 (“Thus, by its express terms, Section 282 establishes a presumption of patent validity, and it provides that a challenger must overcome that presumption to prevail on an invalidity defense.”).

³² VirnetX Charge § 6.0.; NJIP Model Instructions § 5.1; *DMI, Inc. v. Deere & Co.*, 802 F.2d 421, 427 (Fed. Cir. 1986); Jury Instructions at 13, *Alcatel-Lucent USA Inc. v. Overstock.com, Inc.* (No. 6:09-cv-422-LED) (E.D. Tex. Oct. 14, 2011), ECF 482; 35 U.S.C. § 282.

field of technology of the patent looking at that one reference would be able to make and use the claimed invention.

Something is inherent in an item of prior art if it is always present in the prior art or always results from the practice of the prior art and if a skilled person would understand that to be the case. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may coincidentally result from a given set of circumstances is not sufficient. A party claiming anticipation by inherency must show that the elements of the claim are always present in the prior art or always result from the practice of the prior art.

You may not combine two or more items of prior art to make out an anticipation.³³

As I explained, a patent claim is invalid if the claimed invention is not new—that is, because it is “anticipated” by an earlier invention. 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, method, 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. Alcatel-Lucent, Ericsson, HTC, and Sony Mobile bear the burden to prove anticipation of each claim by clear and convincing evidence.

For a claim to be invalid on the basis of anticipation, each and every element must have been described in a single previous publication or patent. We call these things “prior art.” You are not allowed to combine two or more items of prior art to make out anticipation.

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 sufficient detail or inherent in the

³³ VirnetX Charge § 6.1.

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.

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

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

- if the claimed invention was already publicly known or publicly used by others in the United States before the date of invention;
- if the claimed invention was already patented or described in a printed publication anywhere in the world before the date of invention. To qualify as a prior art reference, a “printed publication” must be at least reasonably accessible to those interested in the field, even if it is difficult to find. An electronic publication, including an on-line or internet publication, is a “printed publication” if it is at least reasonably accessible to those interested in the field even if it is difficult to find.³⁴
- 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 date of invention.³⁵

1.17 INVALIDITY—ANTICIPATION BY PRIOR PRINTED PUBLICATION OR PRIOR PATENT

The Defendants contend that some of the asserted claims of the patents-in-suit are anticipated by prior printed publications and prior patents. A patent claim is invalid if the invention defined by that claim was described in a printed publication anywhere in the world before the inventor made the claimed invention or more than one year before the application for the patent was filed in the United States, regardless of when the inventor made his invention. Printed publications may include issued patents as well as articles, treatises, and other written

³⁴ Wi-LAN objects to this addition because the accessibility of printed publications is not in dispute.

³⁵ *DMI, Inc. v. Deere & Co.*, 802 F.2d 421, 427 (Fed. Cir. 1986); Jury Instructions at 13, *Alcatel-Lucent USA Inc. v. Overstock.com, Inc.* (No. 6:09-cv-422-LED) (E.D. Tex. Oct. 14, 2011), ECF 482; 35 U.S.C. § 282.

materials. The date that a printed publication becomes prior art is the date that it becomes available to the public. Published patent applications are printed publications as of their publication dates. The patents-in-suit were filed in the United States on November 26, 1997. Therefore, if a printed publication was published more than one year before November 26, 1997, then that publication will be prior art, regardless of the date of the invention for the patent claims. **The date of invention is irrelevant to this category of prior art.**³⁶

Printed publications may include issued patents as well as articles, treatises, and other written materials. A printed publication or patent will not anticipate unless it contains a description of the invention covered by the patent claims that is sufficiently detailed to teach a skilled person how to make and use the invention without undue experimentation. Factors to be considered in determining whether a disclosure would require undue experimentation include: (1) the quantity of experimentation necessary; (2) the amount of direction or guidance disclosed in the printed publication or patent; (3) the presence or absence of working examples in the printed publication or patent; (4) the nature of the invention; (5) the state of the prior art; (6) the relative skill of those in the art; (7) the predictability of the art; and (8) the breadth of the claims.³⁷

1.18 OBVIOUSNESS

In this case, Defendants contend that certain of the Asserted Claims are invalid as obvious.

A patent claim is invalid if the claimed invention, as a whole, would have been obvious to a person of ordinary skill in the field of the invention at the time the application was filed.

³⁶ Virnetx Charge § 7.1.2; Court's Charge § 8.1.2, *Clearvalue, Inc. v. Pearl River Polymers, Inc.*, No. 6:06-cv-197 LED (ECF No. 559) (E.D. Tex. Apr. 20, 2010). **Wi-LAN objects to this addition as confusing given sentence 2 of this proposed instruction.**

³⁷ **Defendants object to the inclusion of this instruction as redundant with the previous section.**

This means that even if all the requirements of the claim cannot be found in a single prior art reference that would anticipate the claim, a person of ordinary skill in the field of the invention who knew about all of the prior art would have come up with the claimed invention.

But a patent claim composed of several requirements is not proved obvious merely by demonstrating that each of its requirements was independently known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of known requirements according to their established functions to produce a predictable result, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the requirements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known. Accordingly, you may evaluate whether there was some teaching, suggestion, or motivation to arrive at the claimed invention, as a whole, 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 inventions were made, and you should not consider what is known today or what is learned from the teaching of the patents.

The ultimate conclusion of whether a claim is obvious should be based on your determination of several factual issues:

1. You must decide the level of ordinary skill in the field of the invention that someone would have had at the time the claimed invention was made.
2. You must decide the scope and content of the prior art. In determining the scope and content of the prior art, you must decide whether a reference is pertinent, or analogous, to the claimed invention. Pertinent, or analogous, prior art includes prior art in the same field of endeavor as the claimed invention, regardless of the problems addressed by the reference, and prior art from different fields reasonably pertinent to the particular problem with which the claimed invention is concerned.
3. You should consider any difference or differences between the prior art and the claim requirements.

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

Factors Tending to Show the Claims are Not Obvious

1. commercial success of a product due to the merits of the claimed invention;

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

To be relevant to your determination of obviousness, any of these additional considerations must have a connection to the claimed invention set forth in the patent claims. You may consider the presence of any of the list factors 1–8 as an indication that the claimed invention would not have been obvious at the time the claimed invention was made.

Factors Tending to Show the Claims are Obvious

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.

Although you should consider any evidence of these factors, the relevance and importance of any of them to your decision on whether the claimed invention would have been obvious is up to you.

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.³⁸

Even though an invention may not have been identically disclosed or described before it was made by an inventor, in order to be patentable, the invention must also not have been obvious to a person of ordinary skill in the field of technology of the patent at the time the invention was made.³⁹

In determining whether a claimed invention is obvious, you must consider the level of ordinary skill in the field of the invention that someone would have had at the time the claimed invention was made, the scope and content of the prior art, and any differences between the prior art and the claimed invention.⁴⁰

Unlike anticipation, which allows consideration of only one item of prior art, obviousness may be shown by considering more than one item of prior art.⁴¹ Furthermore, a prior art reference need not be enabled when being considered for obviousness.⁴² The prior art reference qualifies as prior art for whatever is disclosed therein.⁴³

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

³⁸ CEATS Charge § 5.8.

³⁹ FBP Model Instructions 4.3c.

⁴⁰ *Id.*

⁴¹ American Intellectual Property Law Association, AIPLA's Model Patent Jury Instructions, § 7.0 at *27 (2008).

⁴² *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1357 (Fed. Cir. 2003) (“Under § 103, however, a reference need not be enabled; it qualifies as a prior art, regardless, for whatever is disclosed therein.”).

⁴³ *Id.*

combination of known requirements according to their established functions to produce a predictable result, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the requirements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known. Accordingly, you may evaluate whether there was some teaching, suggestion, or motivation to arrive at the claimed invention before the time of the claimed invention, you may find a patent obvious without relying on teaching, suggesting or motivation. Teaching, suggestion or motivation is one way, but not the only way, of finding obviousness. Teachings, suggestions, and motivations may be found in one or more written references, including the prior art itself.

However, 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, such as:

- whether the claimed invention was merely the predictable result of using prior art requirements according to their known function(s);⁴⁴
- whether the claimed invention provides an obvious solution to a known problem

⁴⁴ *Model Patent Jury Instructions*, The Federal Circuit Bar Association, February 2012 § 4.3c.

in the relevant field;⁴⁵

- whether the prior art teaches or suggests the desirability of combining requirements claimed in the invention;⁴⁶
- whether the prior art teaches away from combining requirements in the claimed invention;⁴⁷
- whether it would have been obvious to try the combinations of requirements, such as when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions; and⁴⁸
- whether the change resulted more from design incentives or other market forces.⁴⁹

You must be careful not to determine obviousness using hindsight; many true inventions can seem obvious after the fact. You need to 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:

- a. You must decide the level of ordinary skill in the field of the invention that someone would have had at the time the claimed invention was made.
- b. You must decide the scope and content of the prior art. In determining the scope and content of the prior art, you must decide whether a reference is pertinent, or analogous, to the claimed invention. Pertinent, or analogous, prior art includes prior art in the same field of endeavor as the claimed invention, regardless of the problems addressed by the reference, and prior art from different fields reasonably pertinent to the particular problem with which the claimed invention is concerned. Remember that prior art is not

⁴⁵ *Id.*

⁴⁶ *Id.*

⁴⁷ *Id.*

⁴⁸ *Id.*

⁴⁹ *Id.*

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.

- c. You must decide what difference, if any, existed between the claimed invention and the prior art.

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

Factors tending to show nonobviousness:

- A. commercial success of a product due to the merits of the claimed invention;
- B. a long-felt, but unsolved, need for the solution provided by the claimed invention;
- C. unsuccessful attempts by others to find the solution provided by the claimed invention;
- D. copying of the claimed invention by others;
- E. unexpected and superior results from the claimed invention;
- F. 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;
- G. 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
- H. other evidence tending to show nonobviousness.

To be relevant to your determination of obviousness, any of these additional considerations must have a connection to the claimed invention set forth in the patent claims.

Factors tending to show obviousness⁵⁰

- A. independent invention of the claimed invention by others before or at about the same time as the named inventor thought of it; and
- B. other evidence tending to show obviousness.

⁵⁰ Ceats Charge § 5.8; NJIP Model Patent Jury Instructions 5.9.

Although you must consider any evidence of these factors, the relevance and importance of any of them to your decision on whether the claimed invention would have been obvious is up to you. Alcatel-Lucent, Ericsson, HTC, and Sony Mobile 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.

1.19 DAMAGES—GENERALLY

I will now instruct you about the measure of damages. By instructing you on damages, I am not suggesting which party should win this case, on any issue. However, for purposes of answering this question, you should assume the patents are valid.

Wi-LAN seeks patent damages in the form of a reasonable royalty. Generally, a reasonable royalty is defined by the patent laws as the reasonable amount that someone wanting to use the patented invention should expect to pay to the patent owner and the owner should expect to receive. A damages award should put the patent owner in approximately the financial position it would have been in had the infringement not occurred. You may not add anything to the amount of damages to punish the infringer, or to set an example.

Wi-LAN has the burden to persuade you by a preponderance of the evidence that it suffered the damages it seeks. While Wi-LAN is not required to prove damages with mathematical precision, it must prove them with reasonable certainty. The patent owner is not entitled to damages that are remote or speculative.^{51,52}

⁵¹ VirnetX Charge § 7.0.

⁵² Defendants object to this instruction as an incomplete and/or inaccurate statement of the law. In order to collect damages a defendant must infringe a valid patent. This instruction also fails to explain that the relevant time period to assess a reasonable royalty is just before the time of first alleged infringement. A reasonable royalty determined using a hypothetical negotiation must focus on the time period just before the time when the allegedly infringing sales first began.

I will now instruct you on damages. If you find that Alcatel-Lucent, Ericsson, HTC, and/or Sony Mobile have infringed one or more valid claims of the asserted patents, you must determine the amount of money damages to compensate Wi-LAN for the infringement, if any. On the other hand, if you find that each of the asserted patent claims is either invalid or is not infringed, then you need not address damages in your deliberations.⁵³ Even though I am instructing you on how you should measure damages, this should not be taken to mean that I believe that any of the Defendants has infringed any claim of the patents-in-suit or that any claim is valid. These are issues for you to resolve under the instructions I have given you. I am instructing you on damages only so that you will have guidance should you decide that Wi-LAN is entitled to recover.⁵⁴

The amount of damages must be adequate to compensate Wi-LAN for the infringement of any claims that you have found to be valid and infringed. It may not be less than a “reasonable royalty.” At the same time, your damages determination must not include additional sums to punish Alcatel-Lucent, Ericsson, HTC, or Sony Mobile, or to set an example. You may award compensatory damages only for the loss that Wi-LAN proves are more probably true than not true caused by Alcatel-Lucent, Ericsson, Sony Mobile or HTC’s infringement. You cannot

LaserDynamics, Inc. v. Quanta Computer, Inc., 694 F.3d 51, 76 (Fed. Cir. 2012) (“Indeed, the basic question posed in a hypothetical negotiation is: if, on the eve of infringement, a willing licensor and licensee had entered into an agreement instead of allowing infringement of the patent to take place, what would that agreement be?”).

⁵³ American Intellectual Property Law Association, AIPLA’s Model Patent Jury Instructions, at *37 (2008).

⁵⁴ Fifth Circuit Pattern Jury Instructions – Civil § 9.7 (2006) (as modified).

base your damages award on any evidence that is unrelated to the claimed inventions of the patents-in-suit.⁵⁵

There are different types of damages that Wi-LAN may be entitled to recover. In this case, Wi-LAN seeks a reasonable royalty. A reasonable royalty is defined as the money amount the patent holder and the Defendants would have agreed upon as a fee for use of the invention at the time prior to when infringement began.⁵⁶

1.20 DAMAGES—BURDEN OF PROOF

Where the parties dispute a matter concerning damages, it is Wi-LAN's burden to prove by a preponderance of the evidence (in other words, that it is more probably true than not true) that Wi-LAN's version is correct. Wi-LAN must prove the amount of damages with reasonable certainty, but need not prove the amount of damages with mathematical precision. However, Wi-LAN is not entitled to damages that are remote or speculative. The Defendants are not obligated to put on any evidence regarding what the amount of damages should be, if any.⁵⁷ ⁵⁸

⁵⁵ *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F. 3d 860, 866 (Fed. Cir. 2010) (“Any evidence unrelated to the claimed invention does not support compensation for infringement but punishes beyond the reach of the statute.”).

⁵⁶ *Model Patent Jury Instructions*, The Federal Circuit Bar Association, February 2012 § 6.1.

⁵⁷ NJIP Model Instructions 6.2; *Union Carbide Chems. & Plastics Tech. Corp. v. Shell Oil Co.*, 425 F.3d 1366, 1372–73 (Fed. Cir. 2005), *overruled on other grounds by Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 576 F.3d 1348 (Fed. Cir. 2009); *SmithKline Diagnostics, Inc. v. Helena Labs. Corp.*, 926 F.2d 1161, 1164 (Fed. Cir. 1991); *ResQNet. com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 872 (Fed. Cir. 2010) (“The district court seems to have been heavily influenced by Lansa’s decision to offer no expert testimony to counter Dr. David’s [the plaintiff’s expert’s] opinion. But it was ResQNet’s burden, not Lansa’s, to persuade the court with legally sufficient evidence regarding an appropriate reasonable royalty. . . . As a matter of simple procedure, Lansa had no obligation to rebut until ResQNet met its burden with reliable and sufficient evidence.”).

⁵⁸ Wi-LAN objects because Defendants’ proposed instruction is already included in proposed instruction 2.26, *infra*.

1.21 DAMAGES—WHEN DAMAGES BEGIN

The amount of damages, **if any**, that Wi-LAN can recover from each Defendant is limited to the acts of infringement by that Defendant that occurred after October 5, 2010.

1.22 DAMAGES—MULTIPLE DEFENDANTS

You must not award compensatory damages more than once for the same injury. For example, if Wi-LAN prevails on two patents and establishes a dollar amount for its injuries, you must not award Wi-LAN any additional compensatory damages on each patent. Wi-LAN is only entitled to be made whole once, and may not recover more than it has lost.⁵⁹

You **should**⁶⁰ **may** impose damages for infringement of a claim solely upon the Defendant or Defendants that you find are liable on that claim. Although there are four Defendants in this case, it does not necessarily follow that if one is liable, all or any of the others also are liable. Each Defendant is entitled to fair, separate and individual consideration of his case without regard to your decision as to the other Defendants. If you find that only one Defendant is responsible for infringement, then you must award damages for that infringement only against that Defendant.⁶¹

⁵⁹ Wi-LAN objects that defendants' proposed instruction is unnecessarily confusing.

⁶⁰ Defendants object to this instruction as an incomplete and/or inaccurate statement of the law. *Minco, Inc. v. Combustion Eng'g, Inc.*, 95 F.3d 1109, 1121 (Fed. Cir. 1996) (“Minco has the burden of proving the amount, if any, of its entitlement.”); *Lindemann Maschinenfabrik GmbH v. Am. Hoist & Derrick Co., Harris Press & Shear Div.*, 895 F.2d 1403, 1407 (Fed. Cir. 1990) (“As above indicated, the statute obviates the need to show the fact of damage when infringement is admitted or proven, but that does not mean that a patentee who puts on little or no satisfactory evidence of a reasonable royalty can successfully appeal on the ground that the amount awarded by the court is not ‘reasonable’ and therefore contravenes section 284.”); *Devex Corp. v. Gen. Motors Corp.*, 667 F.2d 347, 363 (3d Cir. 1981) *aff'd*, 461 U.S. 648, 103 S. Ct. 2058, 76 L. Ed. 2d 211 (1983) (“The statute requires the award of a reasonable royalty, but to argue that this requirement exists even in the absence of any evidence from which a court may derive a reasonable royalty goes beyond the possible meaning of the statute.”).

⁶¹ Adapted from Fifth Circuit Model Instruction 15.14.

1.23 REASONABLE ROYALTY—DEFINITION

A royalty is a payment made to a patent holder in exchange for rights to make, use, offer to sell, sell, or import the claimed invention. A reasonable royalty is the payment that would have resulted from a negotiation between a patent holder and the infringer taking place just before the time when the infringing sales first began. In this case, for Alcatel-Lucent, Ericsson, and HTC, the patent holder at that time was Airspan Networks, Inc., so the hypothetical negotiation is between those Defendants and Airspan Networks, Inc. The parties agree that the hypothetical negotiation takes place in 2005 for Alcatel-Lucent and Ericsson and in 2008 for HTC. The patent holder at the time Sony Mobile's first allegedly infringing sales began in 2009 was Wi-LAN. Accordingly, Sony Mobile's hypothetical negotiation took place in 2009 between Wi-LAN and Sony Mobile. In considering the nature of these this negotiations, the focus is on what the expectations of the patent holder and infringer would have been had they entered into an agreement at that time and acted reasonably in their negotiations. However, only for purposes of this hypothetical negotiation, you must assume that both parties believed the patent was valid and infringed. In addition, you must assume that patent holder and infringer were willing to enter into an agreement; your role in arriving at a reasonable royalty is to determine what that agreement would have been. The test for damages is what royalty would have resulted from the hypothetical negotiation and not simply what either party would have preferred.

In this trial you have heard evidence of things that happened after the infringement began. That evidence can be considered to the extent that the evidence aids in your assessing what royalty would have resulted from a hypothetical negotiation. Such evidence that you may consider in assessing a reasonable royalty resulting from a hypothetical negotiation includes the negotiators' knowledge at the time of the hypothetical negotiation, based on their knowledge and experience, as well as certain future events, such as the extent to which any Defendant made use

of the invention after the patent that was infringed issued, that the negotiators would have found relevant to their negotiation.⁶²⁶³

The list below includes factors that you may consider. This list does not include every possible factor, but it will give you an idea of the kinds of things that normally prudent business people would consider in negotiating the hypothetical license:

- Licenses or offers to license the patent at issue in this case;
- Licenses involving comparable patents;
- The licensing history of the parties;
- Licensing practices in the relevant industry;
- Whether the patent owner had an established policy of refusing to license the patent at issue;
- The relationship between the patent owner and alleged infringer, including whether or not they are competitors;
- The significance of the patented technology in promoting sales of the alleged infringer's products and earning it profit;
- Alternatives to the patented technology and advantages provided by the patented technology relative to the alternatives;
- The portion of the alleged infringer's profit that should be credited to the invention as distinguished from nonpatented features, improvements or contributions;

⁶² CEATS Charge § 6.4; VirnetX Charge § 7.1; FBA Model Instructions 6.6; AIPLA 2012 Model Instructions § 11.1 (as modified).

⁶³ Defendants object to this instruction as an incomplete and/or inaccurate statement of the law. This instruction is not found in the NJIP Model Instructions cited by Wi-LAN. That instruction properly focuses on the time period "just before the time when the infringing sales first began." NJIP Model Instruction 6.6. *LaserDynamics, Inc. v. Quanta Computer, Inc.*, 694 F.3d 51, 76 (Fed. Cir. 2012) ("Indeed, the basic question posed in a hypothetical negotiation is: if, on the eve of infringement, a willing licensor and licensee had entered into an agreement instead of allowing infringement of the patent to take place, what would that agreement be?").

- Any other economic factor that a normally prudent businessperson would, under similar circumstances, take into consideration in negotiating the hypothetical license.

In considering the opinion testimony of qualified experts and other evidence of a reasonable royalty, you are not required to accept one specific figure or another for the reasonable royalty. You are entitled to determine what you consider to be a reasonable royalty based upon your consideration of all of the evidence presented by the parties, whether that evidence is of a specific figure or a range of figures.^{64,65}

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

(1) The royalties received by the patentee for the licensing of the patents-in-suit, proving or tending to prove an established royalty. Note, however, that the licenses a party relies on in proving damages must be sufficiently technically and economically comparable to the hypothetical license at issue here.⁶⁶ A party cannot rely on license agreements that are radically

⁶⁴ CEATS Charge § 6.4; VirnetX Charge § 7.1; FBA Model Instructions 6.6; AIPLA 2012 Model Instructions § 11.1 (as modified).

⁶⁵ Defendants object to this instruction as an incomplete and/or inaccurate statement of the law. This instruction is not found in the NJIP Model Instructions cited by Wi-LAN. Moreover, it is Wi-LAN's burden to prove damages by a preponderance of the evidence.

⁶⁶ *Uniloc USA, Inc. v. Microsoft Corp.*, 632 F.3d 1292, 1316 (Fed. Cir. 2011) (“The court noted that the ‘licenses relied on by the patentee in proving damages [must be] sufficiently comparable to the hypothetical license at issue in suit.’”) (quoting *Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1325 (Fed. Cir. 2009)). *see also*, *LaserDynamics, Inc. v. Quanta Computer, Inc.*, 694 F.3d 51, 77, 80 (Fed. Cir. 2012); *Uniloc USA, Inc. v. Microsoft Corp.*, 632 F.3d 1292, 1316–17 (Fed. Cir. 2011), *reh'g denied* (Mar. 22, 2011); *Wordtech Sys., Inc v. Integrated Networks Solutions, Inc.*, 609 F.3d 1308, 1319–20 (Fed. Cir. 2010) (“We concluded that four of the eight licenses, though lump-sum agreements, were not ‘sufficiently comparable’ because they arose from divergent circumstances and covered different material. We rejected the remaining four licenses, which contained running royalties, because the patentee provided no basis for comparing those running royalties to the jury's lump-sum award. Similarly, in *ResQNet.com, Inc. v. Lansa, Inc.* (decided after argument in this case), we overturned a running royalty verdict based on seven licenses, ‘five of which had no relation to the claimed invention,’ and the other

different from the hypothetical agreement under consideration to determine a reasonable royalty.⁶⁷

(2) The rates paid by the licensee for the use of other patents comparable to the patent-in-suit.

(3) The nature and scope of the license, as exclusive or nonexclusive, or as restricted or nonrestricted in terms of territory or with respect to whom the manufactured product may be sold.

(4) The licensor's established policy and marketing program to maintain his or her patent monopoly by not licensing others to use the invention or by granting licenses under special conditions designed to preserve that monopoly.

two of which arose from litigation. 594 F.3d 860, 870 (Fed. Cir. 2010). We stressed that comparisons of past patent licenses to the infringement must account for ‘the technological and economic differences’ between them.”); *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 869, 871–72 (Fed. Cir. 2010) (“By its terms, this factor considers only past and present licenses to the actual patent and the actual claims in litigation. This court has long required district courts performing reasonable royalty calculations to exercise vigilance when considering past licenses to technologies other than the patent in suit. . . . The first Georgia–Pacific factor, which Dr. David found to be controlling and which the district court in turn adopted, must consider licenses that are commensurate with what the defendant has appropriated. If not, a prevailing plaintiff would be free to inflate the reasonable royalty analysis with conveniently selected licenses without an economic or other link to the technology in question.”); *Lucent Technologies, Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1326–31 (Fed. Cir. 2009) (“Lucent had the burden to prove that the licenses were sufficiently comparable to support the lump-sum damages award. The law does not require an expert to convey all his knowledge to the jury about each license agreement in evidence, but a lump-sum damages award cannot stand solely on evidence which amounts to little more than a recitation of royalty numbers, one of which is arguably in the ballpark of the jury's award, particularly when it is doubtful that the technology of those license agreements is in any way similar to the technology being litigated here.”).

⁶⁷ *Uniloc USA, Inc. v. Microsoft Corp.*, 632 F.3d 1292, 1316 (Fed. Cir. 2011) (“[T]his court determined that a patentee could not rely on license agreements that were radically different from the hypothetical agreement under consideration to determine a reasonable royalty.” (internal quotation marks and citation omitted)).

(5) The commercial relationship between the licensor and licensee, such as whether they are competitors in the same territory in the same line of business, or whether they are inventor and promoter.

(6) The effect of selling the patented specialty in promoting sales of other products of the licensee, the existing value of the invention to the licensor as a generator of sales of his nonpatented items, and the extent of such derivative or conveyed sales.

(7) The duration of the patent and the term of the license.

(8) The established profitability of the product made under the patents, its commercial success, and its current popularity.

(9) The utility and advantages of the patented property over the old modes or devices, if any, that had been used for working out similar results.

(10) The nature of the patented invention, the character of the commercial embodiment of it as owned and produced by the licensor, and the benefits to those who have used the invention.

(11) The extent to which the infringer has made use of the invention and any evidence probative of the value of that use.

(12) The portion of the profit or of the selling price that may be customary in the particular business or in comparable business to allow for the use of the invention or analogous inventions.

(13) The portion of the realizable profits that should be credited to the invention as distinguished from nonpatented elements, the manufacturing process, business risks, or significant features or improvements added by the infringer.

(14) The opinion and testimony of qualified experts.

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

No one factor is dispositive and you can and should consider the evidence that has been presented to you in this case on each of these factors. You may also consider any other factors which in your mind would have increased or decreased the royalty the infringer would have been willing to pay and the patent holder would have been willing to accept, acting as normally prudent business people. The final factor establishes the framework which you should use in determining a reasonable royalty, that is, the payment that would have resulted from a negotiation between the patent holder and the infringer taking place at a time prior to when the infringement began.

If you have found that one or more Defendant has infringed a valid patent, you must determine the reasonable royalty for that Defendant or Defendants separately.⁶⁸

1.24 HYPOTHETICAL NEGOTIATION—LICENSE COMPARABILITY⁶⁹

In order to consider any a license to patents other than the patents-in-suit⁷⁰ as the basis for a reasonable royalty that would have been considered by the parties to a hypothetical negotiation

⁶⁸ *Model Patent Jury Instructions*, The Federal Circuit Bar Association, February 2012 § 6.7 (as modified).

⁶⁹ Alcatel-Lucent and HTC propose including this instruction on License Comparability; Wi-LAN, Sony Mobile, and Ericsson object. Should the court choose to instruct the jury on license comparability, Wi-LAN contends that its additions render the instruction a more correct and complete statement of the law.

agreed upon at the hypothetical negotiation, the license must be comparable to the license that a Defendant and the patent holder would have agreed to at the time of the hypothetical negotiation. The party seeking to use the such a license bears the burden of proving comparability. Factors you may use to determine if a license is comparable include: (1) whether the technology covered by the patent(s) in the license agreement is comparable to the technology claimed by the patents-in-suit, (2) whether the structure of the license is comparable to the structure of the hypothetical negotiation license agreement, (3) whether the scope of the license—including timing, geography, and the number of patents—is comparable to the scope of the license that would result from the hypothetical negotiation, (4) whether the license was between two parties with a relationship similar to the relationship between the patent holder and the Defendant at the time of the hypothetical negotiation, and (5) the time period when the license was entered into relative to the timing of the hypothetical negotiation.⁷¹

⁷⁰ Defendants object to this modification as an inaccurate and incomplete statement of the law. An agreement must still be comparable even if it includes a license to the patents-in-suit. *See, e.g., Wordtech Sys., Inc v. Integrated Networks Solutions, Inc.*, 609 F.3d 1308, 1319-20 (Fed. Cir. 2010) (noting that licenses that included the patents-in-suit were not comparable for use in the hypothetical negotiation).

⁷¹ *LaserDynamics, Inc. v. Quanta Computer, Inc.*, 694 F.3d 51, 77, 80 (Fed. Cir. 2012); *Uniloc USA, Inc. v. Microsoft Corp.*, 632 F.3d 1292, 1316–17 (Fed. Cir. 2011), *reh'g denied* (Mar. 22, 2011); *Wordtech Sys., Inc v. Integrated Networks Solutions, Inc.*, 609 F.3d 1308, 1319–20 (Fed. Cir. 2010) (“We concluded that four of the eight licenses, though lump-sum agreements, were not ‘sufficiently comparable’ because they arose from divergent circumstances and covered different material. We rejected the remaining four licenses, which contained running royalties, because the patentee provided no basis for comparing those running royalties to the jury’s lump-sum award. Similarly, in *ResQNet.com, Inc. v. Lansa, Inc.* (decided after argument in this case), we overturned a running royalty verdict based on seven licenses, ‘five of which had no relation to the claimed invention,’ and the other two of which arose from litigation. 594 F.3d 860, 870 (Fed. Cir. 2010). We stressed that comparisons of past patent licenses to the infringement must account for ‘the technological and economic differences’ between them.”); *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 869, 871–72 (Fed. Cir. 2010) (“By its terms, this factor considers only past and present licenses to the actual patent and the actual claims in litigation. This court has long required district courts performing reasonable royalty calculations to exercise vigilance when considering past licenses to technologies other than the patent in suit. . . . The first

1.25 ENTIRE MARKET VALUE OR ROYALTY BASE⁷²

In determining a royalty base, you should not use the value of an entire apparatus or product unless: (1) the patented feature creates the basis for customers' demand for the product, or the patented feature substantially creates the value of the other component parts of the product; (2) the product in question constitutes the smallest saleable unit containing the patented feature;⁷³ or (3) where it is “economically justified.”⁷⁴

Use of the entire apparatus or base may be “economically justified” where the evidence shows that the licensing practices of the parties is to award a royalty based upon either the sales price or number of units sold of the licensed product.^{75 76}

Georgia–Pacific factor, which Dr. David found to be controlling and which the district court in turn adopted, must consider licenses that are commensurate with what the defendant has appropriated. If not, a prevailing plaintiff would be free to inflate the reasonable royalty analysis with conveniently selected licenses without an economic or other link to the technology in question.”); *Lucent Technologies, Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1326–31 (Fed. Cir. 2009) (“Lucent had the burden to prove that the licenses were sufficiently comparable to support the lump-sum damages award. The law does not require an expert to convey all his knowledge to the jury about each license agreement in evidence, but a lump-sum damages award cannot stand solely on evidence which amounts to little more than a recitation of royalty numbers, one of which is arguably in the ballpark of the jury's award, particularly when it is doubtful that the technology of those license agreements is in any way similar to the technology being litigated here.”)

⁷² In light of the Court’s *Daubert* ruling, Wi-LAN proposes this instruction for preservation of the issue.

⁷³ VirnetX Charge § 7.3

⁷⁴ *Mondis Tech., Ltd. v. LG Elect., Inc.*, Nos. 2:07-CV-565-TJW-CE & 2:08-CV-4789-TJW, 2011 WL2417367, at *3 (E.D.Tex. June 14, 2011).

⁷⁵ *Id.*

⁷⁶ Defendants object to this instruction as an inaccurate statement of the law. Defendants are aware of no Federal Circuit case law allegedly recognizing an “exception” to the requirements of the entire market value rule based on “standard industry licensing practices,” nor does Plaintiff cite any such authority. Indeed, Federal Circuit case law sets forth a stringent test for meeting EMVR and provides no exception to that test.” *LaserDynamics, Inc. v. Quanta Computer, Inc.*, 694 F.3d 51, 70 (Fed. Cir. 2012); *see also Uniloc USA, Inc. v. Microsoft Corp.*, 632 F.3d 1292, 1321 (Fed. Cir. 2011), *reh'g denied* (Mar. 22, 2011).

The general rule is that a reasonable royalty must be based not on the value of the entire product, but instead on the smallest salable patent-practicing unit in the product. A narrow exception to this general rule is called the entire market value rule. In order to apply the entire market value rule and consider the overall revenues associated with an accused product, Wi-LAN must prove that the patented feature constitutes the basis for customer demand for the entire product. That is, the entire value of the whole product as a marketable article must be properly and legally attributable to the patented feature in order to base damages on the value of the entire product. It is not enough to merely show that the patented feature is viewed as valuable, important, or even essential to the product. Nor is it enough to show that product without the patented feature would be commercially unviable. Instead, Wi-LAN must prove that the patented feature constitutes the basis for customer demand for the entire product. If Wi-LAN cannot meet this test, you may not award damages as a percentage of revenues or profits attributable to the entire product.

If the entire market value rule is not met, a royalty must be based on the smallest salable patent-practicing unit, and Wi-LAN must provide evidence tending to separate or apportion the Defendants' profits and Wi-LAN's damages between the patented feature and unpatented features, and such evidence must be reliable and tangible, and not conjectural or speculative. Any evidence of a reasonable royalty must carefully tie proof of damages to the claimed invention's footprint in the market place.⁷⁷

⁷⁷ *LaserDynamics, Inc. v. Quanta Computer, Inc.*, 694 F.3d 51, 67–68 (Fed. Cir. 2012); *Uniloc USA, Inc. v. Microsoft Corp.*, 632 F.3d 1292, 1318–21 (Fed. Cir. 2011), *reh'g denied* (Mar. 22, 2011); *Lucent Technologies, Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1336–37 (Fed. Cir. 2009); *Mirror Worlds, LLC v. Apple, Inc.*, 784 F. Supp. 2d 703, 724, 726–27 (E.D. Tex. 2011), *aff'd sub*

1.26 NON-INFRINGEMENT ALTERNATIVES

In determining a reasonable royalty, you may consider whether or not the Defendants found to infringe had commercially acceptable non-infringing alternatives to taking a license from Wi-LAN that were available at or before the time of the hypothetical negotiation and whether that would have affected the reasonable royalty the parties would have agreed upon.⁷⁸

A noninfringing substitute is available if Alcatel-Lucent, Ericsson, HTC, and/or Sony Mobile had all the necessary equipment, materials, know-how, and experience to design and manufacture the substitute and sell the substitute instead of its infringing product at the time the infringing product was sold. The substitute also must be acceptable to the specific purchasers of the infringing products, not the public in general.

The test is whether buyers of the accused products bought the infringing products because of the patented features. If so, non-infringing products without those patented features would not be “acceptable non-infringing substitutes,” even if they could compete in the marketplace with the patented products.⁷⁹

nom. Mirror Worlds, LLC v. Apple Inc., 692 F.3d 1351 (Fed. Cir. 2012), and appeal dismissed in part, 439 F. App'x 908 (Fed. Cir. 2011); *IP Innovation L.L.C. v. Red Hat, Inc.*, 705 F. Supp. 2d 687, 689–91 (E.D. Tex. 2010) (C.J. Rader sitting by designation); *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 869 (Fed. Cir. 2010) (“the trial court must carefully tie proof of damages to the claimed invention’s footprint in the market place”).

⁷⁸ *Bedrock Computer Techs., LLC v. Google, Inc.*, Civil Action No. 09-CV-269-LED (E.D. Tex. April 15, 2011) (Jury Charge Dkt. No. 745); see also *Riles v. Shell Exploration and Production Co.*, 298 F.3d 1302, 1312 (Fed. Cir. 2002) (“Thus, under the constraints of the hypothetical negotiation, the market could not award Riles a royalty for his method divorced of all relation to a potential non-infringing alternative method. The economic relationship between the patented method and non-infringing alternative methods, of necessity, would limit the hypothetical negotiation.”); *Zygo Corp. v. Wyko Corp.*, 79 F.3d 1563, 1571–72 (Fed. Cir. 1996) (“Wyko would have been in a stronger position to negotiate for a lower royalty rate knowing it had a competitive noninfringing device ‘in the wings.’”). If this paragraph is included without the two following paragraphs proposed by Wi-LAN, Wi-LAN objects that this paragraph, taken alone, is an incomplete and/or inaccurate statement of the law.

⁷⁹ FBA Model Instructions 6.2; *Am. Seating Co. v. USSC Grp.*, 514 F.3d 1262, 1270 (Fed. Cir. 2008) (“[A] non-infringing replacement product is not considered a substitute unless it is

1.27 NATURE OF THE MARKET

Proof of patent damages requires sound economic proof on the nature of the market and likely outcomes with infringement factored out of the economic picture. Any evidence unrelated to the claimed invention does not support compensation for infringement but punishes beyond the reach of the patent statute. Any damages analysis requires sound economic and factual predicates.^{80 81}

1.28 INSTRUCTIONS FOR DELIBERATIONS

acceptable to all purchasers of the infringing product. . . . [B]uyers must view the substitute as equivalent to the patented device.”) (internal citations omitted); *Standard Havens Prods., Inc. v. Gencor Indus.*, 953 F.2d 1360, 1373 (Fed. Cir. 1991); *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 926 F.2d 1161, 1166 (Fed. Cir. 1991). Defendants object to this instruction as an inaccurate and/or incomplete statement of the law. An accused infringer may present evidence of its “next best alternative” to the patented technology. *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 926 F.2d 1161, 1166 (Fed. Cir. 1991) (“SKD argues in effect that the noninfringing products lacked one or more features of the patented invention and, therefore, would not be deemed part of the market. However, by definition, noninfringing products do not represent an embodiment of the invention. Thus, the district court properly considered the realities of the marketplace in connection with an assertion that ‘but for’ the infringing activities, the patent owner would have made the sales.”); *Grain Processing Corp. v. Am. Maize-Products Co.*, 185 F.3d 1341, 1351 (Fed. Cir. 1999) (“Thus, an accurate reconstruction of the hypothetical ‘but for’ market takes into account any alternatives available to the infringer.”).

⁸⁰ *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 869 (Fed. Cir. 2010) (“Thus, the trial court must carefully tie proof of damages to the claimed invention’s footprint in the market place. . . . Any evidence unrelated to the claimed invention does not support compensation for infringement but punishes beyond the reach of the statute.”); *Grain Processing Corp. v. American Maize-Products Co.*, 185 F.3d 1341, 1350 (Fed. Cir. 1999) (“To prevent the hypothetical from lapsing into pure speculation, this court requires sound economic proof of the nature of the market and likely outcomes with infringement factored out of the economic picture.”); *Riles v. Shell Exploration & Prod. Co.*, 298 F.3d 1302, 1312 (Fed. Cir. 2002) (“[T]he market would pay [the patentee] only for his product.... [The patentee’s damages] model [does not support the award because it] does not associate [the] proposed royalty with the value of the patented method at all, but with the unrelated cost of the entire Spirit platform.”); *Riles v. Shell Exploration & Prod. Co.*, 298 F.3d 1302, 1311 (Fed. Cir. 2002) (“This analysis, in turn, requires sound economic and factual predicates.”).

⁸¹ Wi-LAN objects because this instruction is vague and unnecessarily confusing.

You must perform your duties as jurors without bias or prejudice as 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 jurors 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 are 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 think differently, or merely because you want 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, and provide a just and fair verdict. You should consider and decide this case as a dispute between persons of equal standing in the 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 and are to be treated as equals.

Now, when you retire to the jury room to deliberate, you will take with you this charge document that I have been referring to, the exhibits that the Court has admitted into evidence, and the verdict form that you must answer. You should select your Foreperson and conduct your deliberations. Your answers to the questions, and your verdict, must be unanimous. If you recess during your deliberations, follow all of the instructions that I have given you before concerning your conduct during the trial.

After you have reached your unanimous verdict, your Foreperson must fill in your answers to the written questions and sign and date the verdict form. Return this charge document, together with your written answers to the questions. Unless I direct you otherwise, do not reveal your answers until such time as you are discharged. You must never disclose to anyone, not even to me, your numerical division on any question.

If you want to communicate with me at any time, please give a written message to the bailiff, who will bring it to me. I will then respond as promptly as possible, either in writing or by meeting with you in the courtroom. I will always first show the attorneys your question and my response before I answer your question.

After you have reached a verdict, you are not obligated to talk with anyone about the case unless I order you to do so.

You may now retire to the jury room to conduct your deliberations.⁸²

2 PROPOSED EXHIBITS

2.1 Wi-LAN'S PROPOSED EXHIBIT 1

Wi-LAN contends that the products made, used, sold, offered for sale, or imported into the United States by Alcatel-Lucent infringe the patent claims listed above: Alcatel-Lucent 9300 W-CDMA Node B Products, Alcatel-Lucent 9311 Macro Node B, Alcatel-Lucent 9326 Digital 2U Base Band Unit, Alcatel-Lucent 9360 Small Cell, Alcatel-Lucent 9361 Home Cell, Alcatel-Lucent 9362 Enterprise Cell, Alcatel-Lucent 9362 Enterprise Cell 2100, Alcatel-Lucent 9363 Metro Cell Indoor, Alcatel-Lucent 9364 Metro Cell Outdoor, and Alcatel-Lucent 9926 Digital 2U Node B.

2.2 Wi-LAN'S PROPOSED EXHIBIT 2

⁸² *Fractus S.A. v. Samsung Electronics Co.*, Civil Action No. 6:09-CV-203 (Jury Charge Dkt. No. 997); Fifth Circuit Pattern Instructions 2.11, 2.12, 3.1.

Wi-LAN contends that the following products made, used, sold, offered for sale, or imported into the United States by Ericsson infringe the patent claims listed above: RBS 3000 and RBS 6000 base station products.

2.3 Wi-LAN'S PROPOSED EXHIBIT 3

Wi-LAN contends that the following products made, used, sold, offered for sale, or imported into the United States by HTC infringe the patent claims listed above: HTC Amaze 4G, HTC Aria, HTC Dash 3G, HTC Desire, HTC Evo Design 4G, HTC Freestyle, HTC G1, HTC G2, HTC HD2, HTC HD7, HTC HD7 S, HTC Hero S, HTC Imagio, HTC Inspire 4G, HTC Jetstream, HTC Legend, HTC myTouch 3G, HTC myTouch 3G Slide, HTC myTouch 4G, HTC myTouch 4G Slide, HTC One S, HTC One X, HTC Pure, HTC Radar, HTC Radar 4G, HTC Sensation, HTC Sensation 4G, HTC Shift, HTC Status, HTC Surround, HTC Tilt2, HTC Titan, HTC Titan II, HTC Touch Cruise, HTC Touch Diamond2, HTC Touch Pro2, HTC Vivid, and HTC Wildfire S.

2.4 Wi-LAN'S PROPOSED EXHIBIT 4

Wi-LAN contends that the following products made, used, sold, offered for sale, or imported into the United States by Sony Mobile infringe the patent claims listed above: Sony Mobile Aino, Sony Mobile Aspen, Sony Mobile Cedar, Sony Mobile Equinox, Sony Mobile G705a, Sony Mobile Live with Walkman, Sony Mobile Naite, Sony Mobile Satio, Sony Mobile T707, Sony Mobile Vivaz, Sony Mobile Vivaz Pro, Sony Mobile W508, Sony Mobile W518a, Sony Mobile Xperia active, Sony Mobile Xperia arc, Sony Mobile Xperia arc S, Sony Mobile Xperia ion, Sony Mobile Xperia mini, Sony Mobile Xperia mini pro, Sony Mobile Xperia neo, Sony Mobile Xperia neo V, Sony Mobile Xperia Play, Sony Mobile Xperia Play 4G, Sony Mobile Xperia pro, Sony Mobile Xperia Pureness, Sony Mobile Xperia ray, Sony Mobile Xperia

X2a, Sony Mobile Xperia X8, Sony Mobile Xperia X10, Sony Mobile Xperia X10 mini, and Sony Mobile Yari.

2.5 WI-LAN'S PROPOSED EXHIBIT A⁸³

Claim Term	Court's Construction
orthogonal codes	codes that cross-correlate to zero with respect to each other
orthogonal channels	a set of channels created using orthogonal codes
overlay code	an additional code that subdivides an orthogonal channel
time division multiplexing (TDM) techniques	techniques for allocating an interval of time within a predetermined frame period to a data item, based on one or more characteristics associated with the data item
TDM encoder	hardware and/or software for applying TDM techniques
TDM decoder	hardware and/or software for extracting a data item from a channel that has been encoded using TDM techniques
time slot	an interval of time
wireless link	a radio connection between a central terminal and a particular subscriber terminal for communicating data items therebetween

2.6 DEFENDANTS' PROPOSED EXHIBIT A

Claim Term	Court's Construction
"orthogonal codes"	"codes that cross-correlate to zero with respect to each other"
"orthogonal channel"	"a set of channels created using orthogonal codes"
"time division multiplexing (TDM) techniques"	"techniques for allocating an interval of time within a predetermined frame period to a data item, based on one or more characteristics"

⁸³ Wi-LAN's Proposed Exhibit A is the same form as the jury notebook sheet.

	associated with the data item”
“time slot”	“an interval of time”
“TDM encoder”	“hardware and/or software for applying TDM techniques”
“TDM decoder”	“hardware and/or software for extracting a data item from a channel that has been encoded using TDM techniques”
“overlay code”	“an additional code that subdivides an orthogonal channel”
“selectively designate one or more of said traffic channels as locked channels”	“make one or more data channels unavailable for transmission”
“wireless link”	“a radio connection between a central terminal and a particular subscriber terminal for communicating data items therebetween”
“subscriber terminal”	The Court has not interpreted this term, so you must give it its ordinary and accustomed meaning as understood by one of ordinary skill in the art. You are instructed, however, that claim 2 of the ’326 Patent and claims 11 and 12 of the ’327 Patent include a limitation requiring a subscriber terminal.

3 WI-LAN'S PROPOSED VERDICT FORM

3.1 QUESTION NO. 1—INFRINGEMENT

QUESTION NO. 1

Did Wi-LAN prove by a preponderance of the evidence (in other words, that it is more probably true than not true) that the accused products of Defendants Alcatel-Lucent, Ericsson, HTC, and Sony Mobile infringed the following claims of the patents in issue?

Answer "Yes" or "No" in each box. "Yes" is a finding that the claim is infringed. "No" is a finding that the claim is not infringed.

'326 Patent Claims	Alcatel-Lucent	Ericsson
2		
5		
9		

'327 Patent Claims	Alcatel-Lucent	Ericsson
11		
12		

'819 Patent Claim	Alcatel-Lucent	Ericsson
11		

'211 Patent Claims	HTC	Sony Mobile
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2		
5		

3.2 QUESTION NO. 2—INVALIDITY

Have the Defendants (Alcatel-Lucent, Ericsson, HTC, and Sony Mobile) proven by clear and convincing evidence (in other words, has the evidence produced in your mind a firm belief or conviction on the matter) that the following claims are invalid because the claimed inventions were either anticipated or obvious?

Answer “Yes” or “No” as to each patent claim. “Yes” is a finding that the claim is invalid. “No” is a finding that the claim is valid.

‘326 Patent Claims	Anticipated?	Obvious?
2		
5		
9		

‘819 Patent Claim	Anticipated?	Obvious?
11		

‘211 Patent Claims	Anticipated?	Obvious?
2		
5		

3.3 QUESTION NO. 3—REASONABLE ROYALTY

3.3.1 Alcatel

QUESTION NO. 3A

Answer Question No. 3A only if you answered “Yes” to one or more of the parts of Question No. 1, finding that Alcatel-Lucent infringed one or more of the claims of the patents in issue. If you answered “No” for Alcatel-Lucent as to every claim in Question No. 1, do not answer Question No. 3A.

What damages, stated in terms of a reasonable royalty, do you find Wi-LAN has proven by a preponderance of the evidence (in other words, that it is more probably true than not true) were suffered as a result of Alcatel-Lucent’s infringement as found by you in answer to Question No. 1?

Total Royalty Owed by Alcatel-Lucent: _____

3.3.2 Ericsson

QUESTION NO. 3B

Answer Question No. 3B only if you answered “Yes” to one or more of the parts of Question No. 1, finding that Ericsson infringed one or more of the claims of the patents in issue. If you answered “No” for Ericsson as to every claim in Question No. 1, do not answer Question No. 3B.

What damages, stated in terms of a reasonable royalty, do you find Wi-LAN has proven by a preponderance of the evidence (in other words, that it is more probably true than not true) were suffered as a result of Ericsson’s infringement as found by you in answer to Question No. 1?

Total Royalty Owed by Ericsson: _____

3.3.3 HTC

QUESTION 3C

Answer Question No. 3C only if you answered “Yes” to one or more of the parts of Question No. 1, finding that HTC infringed one or more of the claims of the patents in issue. If you answered “No” for HTC as to every claim in Question No. 1, do not answer Question No. 3C.

What damages, stated in terms of a reasonable royalty, do you find Wi-LAN has proven by a preponderance of the evidence (in other words, that it is more probably true than not true) were suffered as a result of HTC’s infringement as found by you in answer to Question No. 1?

Total Royalty Owed by HTC: _____

3.3.4 Sony Mobile

QUESTION 3D

Answer Question No. 3D only if you answered “Yes” to one or more of the parts of Question No. 1, finding that Sony Mobile infringed one or more of the claims of the patents in issue. If you answered “No” for Sony Mobile as to every claim in Question No. 1, do not answer Question No. 3D.

What damages, stated in terms of a reasonable royalty, do you find Wi-LAN has proven by a preponderance of the evidence (in other words, that it is more probably true than not true) were suffered as a result of Sony Mobile’s infringement as found by you in answer to Question No. 1?

Total Royalty Owed by Sony Mobile: _____

3.4 SIGNATURE OF THE FOREPERSON

You have now reached the end of the Verdict Form and should review it to ensure it accurately reflects your unanimous deliberations. The Foreperson should then sign and date the Verdict Form in the spaces below and notify the marshal that you have reached a verdict. The Foreperson should retain possession of the Verdict Form and bring it when the jury is brought back into the courtroom.

DATE

FOREPERSON

3.5 DEFENDANTS' PROPOSED VERDICT FORM

FINDINGS ON INFRINGEMENT CLAIMS

1 Did Wi-LAN prove by a preponderance of the evidence that Alcatel-Lucent infringed any of the following claims of the '326, '327, or '819 Patents?

Answer “Yes” or “No” for each of the listed claims in the spaces provided below. For this question, “Yes” is a finding for Wi-LAN and “No” is a finding for Alcatel-Lucent.

'326 Patent:

Claim 2: _____

Claim 5: _____

Claim 9: _____

'327 Patent:

Claim 11: _____

Claim 12: _____

'819 Patent:

Claim 11: _____

2 Did Wi-LAN prove by a preponderance of the evidence that Ericsson infringed any of the following claims of the '326, '327, or '819 Patents?

Answer “Yes” or “No” for each of the listed claims in the spaces provided below. For this question, “Yes” is a finding for Wi-LAN and “No” is a finding for Ericsson.

'326 Patent:

Claim 2: _____

Claim 5: _____

Claim 9: _____

'327 Patent:

Claim 11: _____

Claim 12: _____

'819 Patent:

Claim 11: _____

3 Did Wi-LAN prove by a preponderance of the evidence that HTC infringed any of the following claims of the '211 Patent?

Answer “Yes” or “No” for each of the listed claims in the spaces provided below. For this question, “Yes” is a finding for Wi-LAN and “No” is a finding for HTC.

'211 Patent

Claim 2: _____

Claim 5: _____

4 Did Wi-LAN prove by a preponderance of the evidence that Sony Mobile infringed any of the following claims of the '211 Patent?

Answer “Yes” or “No” for each of the listed claims in the spaces provided below. For this question, “Yes” is a finding for Wi-LAN and “No” is a finding for Sony Mobile.

'211 Patent

Claim 2: _____

Claim 5: _____

FINDINGS ON INVALIDITY DEFENSES

5 Did any of the Defendants prove by clear and convincing evidence that any of the claims of the patents-in-suit are invalid?

Answer “Yes” in the space provided beside the particular claim if you find that claim to be invalid. Answer “No” in the space provided beside the particular claim if you find that claim not to be invalid. Answer for all asserted claims regardless of whether you have found those claims infringed. For this question, “Yes” is a finding for the Defendants and “No” is a finding for Wi-LAN.

‘326 Patent:

Claim 2: _____

Claim 5: _____

Claim 9: _____

‘211 Patent

Claim 2: _____

Claim 5: _____

‘819 Patent:

Claim 11: _____

FINDINGS ON DAMAGES (IF APPLICABLE)

If you have found any claim infringed and valid, answer question 6; otherwise, do not answer question 6.

6 For each Defendant listed below, what amount did Wi-LAN prove based on a preponderance of the evidence it is entitled to as a reasonable royalty to compensate it for the valid patent claims you have found to be infringed, if any?

Any amount should be written in dollars and cents.

Alcatel-Lucent: _____

If you wrote an amount above, how is that amount attributed among the patents-in-suit?

'326 Patent _____

'327 Patent _____

'819 Patent _____

If an amount was found, did you apply a royalty rate to a royalty base? Answer "Yes" or "No." _____

If you used a royalty rate, what rate did you apply? _____

Ericsson: _____

HTC: **'211 patent** _____

If an amount was found, did you apply a royalty rate to a royalty base? Answer "Yes" or "No." _____

If you used a royalty rate, what rate did you apply? _____

Sony Mobile: **'211 patent** _____

The foreperson must sign and date this verdict form:

DATE

FOREPERSON

Dated: July 12, 2013

By: /s/Akshay S. Deoras

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing document was filed electronically on July 12, 2013 with the clerk of the court for the U.S. District Court, Eastern District of Texas pursuant to Local Rule CV-5(a)(3) and served on all counsel who have consented to electronic service.

/s/ Eric H. Findlay
Eric H. Findlay