

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

XXX,)
)
 Plaintiff,)
)
 v.) Civ. No. 00-000-SLR
)
XXX,)
)
 Defendant.)
_____)

[MODEL] FINAL JURY INSTRUCTIONS
[Infringement and Validity]

Dated:

GENERAL INSTRUCTIONS

INTRODUCTION

Members of the jury, now it is time for me to instruct you about the law that you must follow in deciding this case. I will start by explaining your duties and the general rules that apply in every civil case. I will explain some rules that you must use in evaluating particular testimony and evidence. I will explain the positions of the parties and the law you will apply in this case. Last, I will explain the rules that you must follow during your deliberations in the jury room. Please listen very carefully to everything I say.

You will have a written copy of these instructions with you in the jury room for your reference during your deliberations. You will also have a verdict form, which will list the interrogatories, or questions, that you must answer to decide this case.

JURORS' DUTIES

You have two main duties as jurors. The first one is to decide what the facts are from the evidence that you saw and heard here in court. Deciding what the facts are is your job, not mine, and nothing that I have said or done during this trial was meant to influence your decision about the facts in any way.

Your second duty is to take the law that I give you, apply it to the facts, and decide which party should prevail on the issues presented. I will instruct you about the burden of proof shortly. It is my job to instruct you about the law, and you are bound by the oath that you took at the beginning of the trial to follow the instructions that I give you, even if you personally disagree with them. This includes the instructions that I gave you before and during the trial, and these instructions. All the instructions are important, and you should consider them together as a whole.

Perform these duties fairly. Do not let any bias, sympathy or prejudice that you may feel toward one side or the other influence your decision in any way.

EVIDENCE DEFINED

You must make your decision based only on the evidence that you saw and heard here in the courtroom. Do not let rumors, suspicions, or anything else that you may have seen or heard outside of court influence your decision in any way. The evidence in this case includes only what the witnesses said while they were testifying under oath (including deposition testimony that has been played or read to you), the exhibits that I allowed into evidence, and any facts that the parties agreed to by stipulation.

Nothing else is evidence. The lawyers' statements and arguments are not evidence. Their questions and objections are not evidence. My legal rulings are not evidence. None of my comments or questions are evidence. The notes taken by any juror are not evidence.

Certain charts and graphics have been used to illustrate testimony from witnesses. Unless I have specifically admitted them into evidence, these charts and graphics are not themselves evidence even if they refer to, identify, or summarize evidence.

During the trial I may not have let you hear the answers to some of the questions that the lawyers asked. I also may have ruled that you could not see some of the exhibits that the lawyers wanted you to see. And sometimes I may have ordered you to disregard things that you saw or heard. You must completely ignore all of these things. Do not speculate about what a witness might have said or what an exhibit might have shown. These things are not evidence, and you are bound by your oath not to let them influence your decision in any way.

Make your decision based only on the evidence, as I have defined it here, and nothing else.

DIRECT AND CIRCUMSTANTIAL EVIDENCE

Some of you may have heard the terms “direct evidence” and “circumstantial evidence.”

Direct evidence is simply evidence like the testimony of any eyewitness which, if you believe it, directly proves a fact. If a witness testified that he saw it raining outside, and you believed him, that would be direct evidence that it was raining.

Circumstantial evidence is simply a chain of circumstances that indirectly proves a fact. If someone walked into the courtroom wearing a raincoat covered with drops of water and carrying a wet umbrella, that would be circumstantial evidence from which you could conclude that it was raining.

It is your job to decide how much weight to give the direct and circumstantial evidence. The law makes no distinction between the weights that you should give to either one, nor does it say that one is any better evidence than the other. You should consider all the evidence, both direct and circumstantial, and give it whatever weight you believe it deserves.

CONSIDERATION OF EVIDENCE

You should use your common sense in weighing the evidence. Consider it in light of your everyday experience with people and events, and give it whatever weight you believe it deserves. If your experience tells you that certain evidence reasonably leads to a conclusion, you are free to reach that conclusion.

USE OF NOTES

You may use notes taken during the trial to assist your memory. Remember that your notes are for your personal use. They may not be given or read to anyone else. Do not use your notes, or any other juror's notes, as authority to persuade fellow jurors. Your notes are not evidence, and they are by no means a complete outline of the proceedings or a list of the highlights of the trial. Some testimony that is considered unimportant at the time presented and, thus, not written down, may take on greater importance later on in the trial in light of all the evidence presented. Your notes are valuable only as a way to refresh your memory. Your memory is what you should be relying on when it comes time to deliberate and render your verdict in this case.

CREDIBILITY OF WITNESSES

You, the jurors, are the sole judges of the credibility, or the believability, of the witnesses you have seen during the trial and the weight their testimony deserves.

You should carefully scrutinize all the testimony each witness has given and every matter of evidence that tends to show whether he or she is worthy of belief. Consider each witness's intelligence, motive, and state of mind, as well as his or her demeanor while on the stand. Consider the witness's ability to observe the matters as to which he or she has testified and whether he or she impresses you as having an accurate recollection of these matters. Consider also any relation each witness may bear to each side of the case, the manner in which each witness might be affected by the verdict, the interest any witness may have in the verdict, and the extent to which, if at all, each witness is either supported or contradicted by other evidence in the case.

Discrepancies in the testimony of different witnesses may, or may not, cause you to discredit such testimony. Two or more persons witnessing an incident or transaction may see or hear it differently. Likewise, 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 about 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, or inconsistent, from the testimony that he or she gave during the trial. It is the province of the jury to determine whether a false statement or a prior inconsistent statement discredits the witness's testimony.

You should remember that a simple mistake by a witness does not mean that the witness was not telling the truth. People may tend to forget some things or remember

other things inaccurately. If a witness has made a misstatement, you must consider whether it was simply an innocent lapse of memory or an intentional falsehood, and that may depend upon whether it concerns an important fact or an unimportant detail.

NUMBER OF WITNESSES

One more point about the witnesses. Sometimes jurors wonder if the number of witnesses who testified makes any difference. Do not make any decisions based only on the number of witnesses who testified. What is more important is how believable the witnesses were, and how much weight you think their testimony deserves. Concentrate on that, not the numbers.

EXPERT WITNESSES

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

You should consider each expert opinion received in evidence in this case, and give it such weight as you think it deserves. If you decide that the opinion of an expert witness is not based upon sufficient education and experience, or if you conclude that the reasons given in support of the opinion are not sound, or if you feel that the opinion is outweighed by other evidence, you may disregard the opinion in whole or in part.

DEPOSITION TESTIMONY

During the trial, certain testimony was presented to you through depositions that were read into evidence or electronically played. This testimony must be given the same consideration you would give it had the witness personally appeared in court. Like the testimony of a live witness, the statements made in a deposition are made under oath and are considered evidence that may be used to prove particular facts.

THE PARTIES AND THEIR CONTENTIONS

I will now review for you the parties in this action and the positions of the parties that you will have to consider in reaching your verdict.

Plaintiff[s] [is/are] _____.

Defendant[s] [is/are] _____.

Plaintiff is the [owner/assignee] of U.S. Patent No. 1,234,XXX, which I will refer to as “the ‘XXX patent.” Plaintiff has made, marketed, used and/or sold **[accused product or method]**. [I may refer to these products collectively as _____.]

Defendant is the [owner/assignee] of U.S. Patent No. 5,678,XXX, which I will refer to as “the ‘XXX patent.” Defendant has made, marketed, used and/or sold **[accused product or method]**. [I may refer to these products collectively as _____.]

Plaintiff contends that defendant’s **[accused product or method]** infringes claims 1, 2 and 3 of the ‘XXX patent. These claims may be referred to as the “asserted claims” of the ‘XXX patent. Defendant contends it does not infringe the asserted claims of the ‘XXX patent. Defendant further contends that the asserted claims are invalid due to anticipation and obviousness.

Defendant contends that plaintiff’s **[accused product or method]** infringes claims 1, 2 and 3 of the ‘XXX patent. These claims may be referred to as the “asserted claims” of the ‘XXX patent. Plaintiff contends it does not infringe the asserted claims of the ‘XXX patent. Plaintiff further contends that the asserted claims are invalid due to anticipation and obviousness.

You will be asked to determine the issues of infringement and validity according

to instructions I will give you in a moment. The asserted claims of the patents in suit are:

[claim listing]

BURDENS OF PROOF

In any legal action, facts must be proven by a required standard of evidence, known as the “burden of proof.” In a patent case such as this, there are two different burdens of proof that are used. The first is called “preponderance of the evidence.” The second is called “clear and convincing” evidence.

Plaintiff must prove its claims of patent infringement by a preponderance of the evidence. When a party has the burden of proof by a preponderance of the evidence, it means that you must be persuaded that what the party seeks to prove is more probably true than not true. To put it differently, if you were to put plaintiff’s and defendant’s evidence of infringement on opposite sides of a scale, the evidence supporting plaintiff’s assertions would have to make the scale tip somewhat to plaintiff’s side.

Clear and convincing evidence is a higher burden of proof than a preponderance of the evidence. Defendant has the burden of proving that each one of the asserted claims of the ‘XXX patent is invalid by clear and convincing evidence. Clear and convincing evidence is evidence that produces an abiding conviction that the truth of a fact is highly probable. You must decide, as to each of the asserted claims, whether defendant has proven, by clear and convincing evidence, that the claim is invalid by reason of anticipation and/or obviousness in light of the prior art and the ordinary skill of one in the art in [year]. I will explain these concepts to you further in a moment.

Those of you who are familiar with criminal cases will have heard the term “proof beyond a reasonable doubt.” That burden does not apply in a civil case and you, therefore, should put it out of your mind in considering whether or not plaintiff has met

its “more likely than not” burden of proof or defendant has met its “clear and convincing” burden of proof.

THE PATENT CLAIMS

PATENT CLAIMS GENERALLY

Before you can decide whether or not any of the asserted claims are infringed or invalid, you will have to understand what patent “claims” are. Patent claims are the numbered paragraphs at the end of a patent.

The purpose of the claims is to provide notice to the public of what a patent covers and does not cover. The claims are “word pictures” intended to define, in words, the boundaries of the invention described and illustrated in the patent.

Claims are usually divided into parts, called “limitations.” For example, a claim that covers the invention of a table may recite the tabletop, four legs, and the glue that secures the legs to the tabletop. The tabletop, legs and glue are each a separate limitation of the claim. A claim covering the invention of a table is called an apparatus claim. A claim describing the steps required to make a table is called a method claim.

DEPENDENT AND INDEPENDENT CLAIMS

There are two different types of claims in a patent. The first type is called an “independent” claim. An independent claim does not refer to any other claim of the patent. An independent claim is read alone to determine its scope.

For example, claim [#] of the ‘XXX patent is an independent claim. You know this because claim [#] does not refer to any other claims. Accordingly, the words of this claim are read by themselves in order to determine what the claim covers.

The second type, a “dependent” claim, refers to at least one other claim in the patent and, thus, incorporates whatever that other claim says. Accordingly, to determine what a dependent claim covers, you must read both the dependent claim and the claim or claims to which it refers.

For example, claim [#] of the ‘XXX patent is a dependent claim. If you look at claim [#], it refers to claim [#]. Therefore, to determine what claim [#] covers, you must consider both the words of claims [#] and [#] together.

OPEN-ENDED OR “COMPRISING” CLAIMS

Several claims of the ‘XXX patent use the transitional term “comprising.” “Comprising” is interpreted the same as “including” or “containing.” In patent claims, comprising means that the claims are open-ended, that is, the claims are not limited to products that include only what is in the claim and nothing else.

If you find that the accused product or method includes all of the limitations in any of the asserted claims that use the term “comprising,” the fact that it may also include additional elements or components is irrelevant. The presence of additional elements or components does not mean that the method or product does not infringe a patent claim.

Similarly, if you find that the prior art includes all of the limitations in any of the asserted claims that use the word “comprising,” the fact that it may also include additional elements is irrelevant. The presence of additional elements or components does not mean that the prior art does not invalidate a patent claim.

CLAIM CONSTRUCTION

It is my duty under the law to define what the patent claims mean and to instruct you about that meaning. You must accept the meanings I give you and use the meaning of each claim for your decision on validity.

You must ignore any different interpretation given to these terms by the witnesses or by attorneys.

I instruct you that the following claim terms have the following definitions:

* * *

If I have not provided a specific definition for a given term, you are to use the ordinary meaning of that term.

PATENT INFRINGEMENT

OVERVIEW

A patent owner has the right to stop others from using the invention covered by its patent claims during the life of the patent. If any person makes, uses, sells (within the United States), offers to sell (from within the United States), or imports what is covered by the patent claims without the patent owner's permission, that person is said to infringe the patent.

In this case, plaintiff alleges that defendant's product or method directly infringes the asserted claims either literally or under the doctrine of equivalents. Plaintiff also asserts that defendant contributes to or induces the infringement of claim [#] of the 'XXX patent.

You must decide whether or not plaintiff has proven, by a preponderance of the evidence, that defendant has made, used, sold (within the United States), or offered for sale (from within the United States) a product or method covered by any of the claims at issue in this case. If defendant infringes one claim of the 'XXX patent, then defendant infringes that patent, even if, in good faith, defendant believed that it did not infringe. Defendant's knowledge or intent to infringe is not relevant.

DIRECT INFRINGEMENT BY LITERAL INFRINGEMENT

In order to prove direct infringement, plaintiff must prove that each limitation of the asserted claims is present in the accused product or method. A claim limitation may be present in an accused product or method in one of two ways: either literally or under the “doctrine of equivalents.” I will explain the doctrine of equivalents to you momentarily.

A claim limitation is literally present if it exists in the accused product or method just as it is described in the claim language, either as I have explained that language to you or, if I did not explain it, as you understand its ordinary meaning.

Literal infringement must be determined with respect to each asserted claim individually by comparing the elements of the accused product or method to each of that claim’s limitations. If the accused product or method omits any single limitation recited in a given claim, then you must find that defendant has not infringed that claim. You must determine infringement with respect to each asserted claim and each accused product or method individually.

In determining whether any accused product or method literally infringes any asserted claim, you should take the following steps:

First, you should determine the scope of the asserted claim by reading the claim language, limitation by limitation, as those limitations have been construed by the court or, if they have not been specifically construed, according to their ordinary meaning; and

Second, you should compare the accused product or method, element by element, to each of the limitations of the asserted claim.

If you find each and every limitation of the asserted claim in the accused product or method, you must return a verdict of literal infringement as to that claim.

If you did not find each and every limitation of the asserted claim in the accused product or method, you may not return a verdict of literal infringement as to that claim.

You must repeat the above analysis with every asserted claim. There is one exception to this rule. If you find that an independent claim is not infringed, there cannot be infringement of any dependent claim that refers directly or indirectly to that independent claim. On the other hand, if you find that an independent claim has been infringed, you must still decide, separately, whether the product or method meets the additional requirements of any claims that depend from the independent claim, thus, whether those dependent claims have also been infringed.

Remember the question is whether the accused product or method infringes any of the asserted claims, and not whether the accused product or method is similar or even identical to a product or method of plaintiff. Accordingly, you must be certain to compare the accused product or method only with the claims it is alleged to infringe and not with any product or method of plaintiff.

INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS

Under the doctrine of equivalents, a product or method can infringe an asserted claim if it includes parts that are identical or equivalent to the limitations of the claim.

Under the patent law, an infringing equivalent is not treated any differently than a product or method that literally infringes the claim limitations of the patent.

You may find that a claim limitation is present in an accused product or method under the doctrine of equivalents if a person having ordinary skill in the art would have considered the differences between that claim limitation and a comparable element to be “insubstantial” or would have found that the structure or step: (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 for the structure or step to be considered interchangeable, the structure or step must have been known at the time of the alleged infringement to a person having ordinary skill in the art. Interchangeability at the present time is not sufficient. In order to prove infringement by “equivalents,” plaintiff must prove the equivalency of the structure or steps to a claim limitation by a preponderance of the evidence.

INDIRECT INFRINGEMENT – INDUCING PATENT INFRINGEMENT

In addition to direct infringement, there are two types of indirect infringement: inducing infringement and contributory infringement. Plaintiff asserts that defendant contributes to and/or induces the infringement of the asserted claims by supplying a [_____] to customers. I will explain contributory infringement to you momentarily.

Defendant induces patent infringement if it purposefully causes, urges or encourages another to infringe a patent. Inducing infringement cannot occur unintentionally. This is different from direct infringement which, as I have told you, can occur unintentionally. In order to prove inducement, plaintiff must prove that it is more probable than not that defendant knew of the 'XXX patent and encouraged or instructed customers to **[use a product or perform a method]** in an infringing manner. Plaintiff must also prove that it is more probable than not that defendant's customers, in using **[a product or performing a method]**, infringed the 'XXX patent. Defendant can be an inducer of infringement even if it believed that the encouraged and instructed-for uses of **[product]** were noninfringing.

To prove that defendant induced patent infringement, plaintiff must prove four things by a preponderance of the evidence:

First, that defendant encouraged or instructed its customers on how to use **[product]** in a manner that you, the jury, find infringes the asserted claims.

Second, that defendant knew of the 'XXX patent.

Third, that defendant knew or should have known that its encouragement or instructions would likely result in the customers infringing the 'XXX patent, in other

words, using a patented product or performing the patented method.

Fourth, that defendant's customers infringed the 'XXX patent.

You may find that defendant induced patent infringement only if you are persuaded that each of these four factors are met.

INDIRECT INFRINGEMENT – CONTRIBUTORY INFRINGEMENT

Plaintiff also asserts that defendant's selling or supplying [**accused product or method**] is contributing to the infringement of the asserted claims.

Contributory infringement can occur when a supplier provides a part or a component to another for use in a patented method. In order to establish that defendant has contributorily infringed this claim, plaintiff must prove five things by a preponderance of the evidence:

First, that defendant knew of the 'XXX patent.

Second, that [_____] is a material [component of the claimed product/apparatus for use in practicing the patented method] and defendant sold or supplied that [component/apparatus]. In other words, the [component/apparatus] is especially made or adapted for use in a manner that infringes the patent.

Third, that defendant knew that their [_____] would be used in a manner infringing the 'XXX patent.

Fourth, that [_____] is not a staple or commodity article, in other words, [a component/an apparatus] that has a substantial non-infringing use or, alternatively, a number of noninfringing uses. Providing a staple or commodity article is not contributory infringement.

Fifth, [_____] was actually used in a manner that you, the jury, find infringes the asserted claims.

VALIDITY

INTRODUCTION

As I stated previously, defendant contends that the asserted claims are invalid. I will now explain to you each of the grounds for invalidity that were presented by defendant at trial. A party must meet its burden of proof on only one ground in order to invalidate a claim. In making your determination as to invalidity, you should consider each claim separately.

AFFIRMATIVE DEFENSE OF INVALIDITY GENERALLY

For a patent to be valid, the invention claimed in the patent must be new, useful and nonobvious. The terms “new,” “useful” and “nonobvious” have special meanings under the patent laws. I will explain these terms to you as we discuss defendant’s grounds for asserting invalidity.

Defendant has challenged the validity of the asserted claims on a number of grounds. Although the patent was granted by the Patent and Trademark Office, it is your job to determine whether defendants have proven, by clear and convincing evidence, that the legal requirements for patentability were not met.

I will now explain to you defendant’s grounds for invalidity in detail. In making your determination as to invalidity, you should consider each claim separately.

PRIOR ART

As I stated previously, under the patent laws, a person is granted a patent only if the invention claimed in the patent is new and not obvious in light of what came before. That which came before is referred to as the “prior art.” Defendant must prove, by clear and convincing evidence, that these items are prior art. In order to do so, defendant must prove that the items fall within one or more of the different categories of prior art recognized by the patent laws. These categories include:

First, anything that was publicly known or used in the United States by someone other than the inventor before the inventor made the invention.

Second, anything that was in public use or on sale in the United States more than one year before the application for the patent was filed. In this case, that means anything that was in public use or on sale in the United States before [**critical date**].

Third, anything that was described in a printed publication anywhere in the world before the inventor made the invention, or more than one year before the application for the patent was filed.

Fourth, anything that was invented by another person in this country before the inventor made the invention, if the other person did not abandon, suppress or conceal his or her prior invention.

[In this case, the parties agree that the references asserted by defendant are prior art to certain of the patents in suit.] Each patent in suit was filed on a different date. Therefore, you must decide whether the asserted claims are invalid in view of the prior art and the ordinary skill in the art as it existed as of a certain time.

Specifically, you must determine whether the 'XXX patent is invalid in view of the prior art and the ordinary skill in the art in [year].

The prior art relevant to each of defendant's claims will be listed for you in connection with the instructions relating to that claim.

ANTICIPATION

GENERALLY

In order for someone to be granted a patent, the invention must actually be “new.” In general, inventions are new when they have not been made, used, or disclosed before. In this case, defendant contends that each of the asserted claims is not new as anticipated by:

[list claims, prior art references and exhibit numbers].

Invalidity by anticipation requires the presence in a single prior art disclosure of all requirements, or limitations, of a claimed invention arranged as in the claim. For a claim to be anticipated, each claim limitation must be disclosed, either expressly or inherently, in a single prior art reference, and the claimed arrangement or combination of those limitations must also be disclosed, either expressly or inherently, in that same prior art reference.

The requirement that the prior art limitations themselves be “arranged as in the claim” means that claims cannot be treated as mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning.

You should consider that which is expressly stated or present in the item of prior art, and also that which is inherently present. Anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of

circumstances is not sufficient.

The description provided in the prior art must be such that a person of ordinary skill in the art in the field of invention could, based on the reference, practice the invention without undue experimentation.

To prevail on its defense of invalidity by anticipatory prior art, defendant must prove, by clear and convincing evidence, that the asserted claims of the patents in suit are anticipated by the prior art identified above and in the verdict sheet, questions [#] to [#].

OBVIOUSNESS

Defendant contends that the asserted claims are invalid as being obvious.

Defendant contends that each of the asserted claims is obvious in view of the following prior art:

[list claims, prior art references and exhibit numbers].

In order to be patentable, an invention must not have been obvious to a person of ordinary skill in the art at the time the invention was made. This is because granting patent protection to advances that would occur in the ordinary course, without real innovation, retards progress and may deprive prior inventions of their value or utility.

In this case, defendant contends that each of the asserted claims is obvious in view of the following prior art:

[list claims, prior art references and exhibit numbers].

The issue is not whether the claimed invention would be obvious to you as a layman, to me as a judge, or to a genius in the art, but whether it would have been obvious to one of ordinary skill in the art at the time the invention was made.

In arriving at your decision on the issue of whether or not the asserted claims would have been obvious to a person of ordinary skill in the art and, therefore, are invalid, you should first determine the scope and content of the prior art. This means that you should determine what prior art was reasonably pertinent to the particular problems the inventor faced.

Prior art must be “analogous art” to be relevant to your consideration of obviousness. Analogous art may be art from the same field of endeavor. If the reference is not within the field of the inventors’ endeavor, it may still be considered if

the reference is reasonably pertinent to the particular problem that the inventors faced.

You must next consider the differences, if any, between the prior art and each asserted claim. Although it is proper for you to consider differences between the claimed invention and the prior art, you should not focus on only the differences, because the test is whether the claimed invention as a whole would have been obvious over all of the prior art.

Next, you are to determine the level of ordinary skill in the art to which the claimed invention pertained at the time the claimed invention was made. Factors to be considered in determining the level of ordinary skill in the pertinent art include:

- (1) The educational level of the inventor and of others working in the field;
- (2) The types of problems encountered in the art at the time of the invention;
- (3) The prior art patents and publications;
- (4) The activities of others;
- (5) Prior art solutions to the problems encountered by the inventor; and
- (6) The sophistication of the technology.

A person of ordinary skill in the art is presumed to have knowledge of the relevant prior art at the time of the claimed invention. If you find that the available prior art shows each of the limitations of the asserted claims, you must determine whether it then would have been obvious to a person of ordinary skill in the art to combine or coordinate these limitations in the same manner as the asserted claims. This is often referred to as “motivation to combine.” Defendant must show that a person of ordinary skill in the art would have had motivation to combine the prior art references in the same manner as the asserted claims and would have had a reasonable expectation of

success in doing so.

A patent composed of several limitations is not proved obvious merely by demonstrating that each of its limitations was independently known in the prior art. You must determine whether a person of ordinary skill in the art has simply implemented a predictable variation of prior art elements or, conversely, whether he or she has made an improvement that is more than the predictable use of prior art elements according to their established functions. When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product, not of innovation, but of ordinary skill and common sense. In that instance, the fact that a combination was obvious to try might show that it was obvious. Any need or problem known in the field of endeavor at the time of the invention and addressed by the patent can provide a reason for combining the elements in the manner claimed. A person of ordinary skill in the art, however, is also a person of ordinary creativity. In many cases, a person of ordinary skill in the art will be able to fit the teachings of multiple patents together like pieces of a puzzle. However, where the art is unpredictable, a focus on known elements may still present a difficult hurdle for one of skill in the art because the results of potential solutions may be unknown or unexpected.

In determining whether the asserted claims would have been obvious to a person of ordinary skill in the art and, therefore, are invalid, you should not apply any rigid test or formula. Rather, you should use your common sense to determine whether the claimed invention is truly innovative, or merely a combination of known limitations to

achieve predictable results.

In your analysis, you must be aware of the distortion caused by hindsight bias, that is, of relying upon a hindsight combination of the prior art. Rather, you must cast your mind back to the time of the invention and consider whether the invention as a whole would have been obvious to a person of ordinary skill in the art, taking into consideration any interrelated teachings of the prior art, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine any known elements in the fashion claimed by the patents at issue.

To prevail on its defense of invalidity by obviousness to a person of ordinary skill in the art at the time the inventions of the patents in suit were made, defendant must prove, by clear and convincing evidence, that the asserted claims of the patents in suit were obvious in view of the prior art identified above and in the verdict sheet, questions [#] to [#].

OBJECTIVE CRITERIA CONCERNING NON-OBVIOUSNESS
(SECONDARY CONSIDERATIONS)

In making your decision **only** as to the obviousness or non-obviousness of the asserted claims, you should consider the objective evidence which may tend to show non-obviousness of the claims at issue, including the following:

(1) Commercial success or lack of commercial success of products covered by the asserted claims;^[1]

(2) A long-felt need in the art that was satisfied by the invention of the asserted claims;

(3) The failure of others to make the invention;

(4) Copying of the invention by others in the field;

(5) Unexpected results achieved by the invention;

(6) Praise of the invention by defendant or others in the field;

(7) The taking of licenses under the patent by others;

(8) Expressions of surprise or disbelief regarding the invention by those having ordinary skill in the art; and

(9) Whether the inventor proceeded contrary to the accepted wisdom in the field.

In your determination of obviousness, then, you must consider whether plaintiff has demonstrated not only that such secondary considerations exist, but also whether plaintiff has proven that there is a sufficient nexus between the considerations and the

¹Any factor(s) not relevant to the validity defense may be omitted.

claimed invention. In other words, plaintiff must show that the claimed inventions of the 'XXX patent contributed to these secondary considerations, rather than the considerations being due to other features of something else, such as other features of plaintiff's **[product or method]**, the general status of plaintiff as a manufacturer, or any other actions taken by plaintiff in producing and marketing **[product or method]**.

For example, if commercial success is due to market position, advertising, promotion, salesmanship of the like, or is due to features of the products other than those described in the asserted claims, then any commercial success may have no relation to the issue of obviousness.

In this case, plaintiff has the burden of proving any secondary consideration issues by a preponderance of the evidence. Should plaintiff not meet this burden, you must make your obviousness determination based only on the scope and content of the prior art, any differences between the claimed invention and the prior art, and the level of ordinary skill in the art. Should plaintiff demonstrate that there are secondary considerations of nonobviousness, these may also be considered. Ultimately, as I stated earlier, it is at all times defendant's burden to demonstrate obviousness by clear and convincing evidence.

DELIBERATION AND VERDICT

INTRODUCTION

Let me finish up by explaining some things about your deliberations in the jury room, and your possible verdicts.

Once you start deliberating, do not talk to the jury officer, or to me, or to anyone else except each other about the case. If you have any questions or messages, you must write them down on a piece of paper, sign them, and then give them to the jury officer. The officer will give them to me, and I will respond as soon as I can. I will have to talk to the lawyers about what you have asked, so it may take me some time to get back to you. Any questions or messages normally should be sent to me through your foreperson, who by custom of this Court is the juror seated in the first seat, first row.

One more thing about messages. Do not ever write down or tell anyone how you stand on your votes. For example, do not write down or tell anyone that you are split 4-4, or 6-2, or whatever your vote happens to be. That should stay secret until you are finished.

UNANIMOUS VERDICT

Your verdict must represent the considered judgment of each juror. In order for you as a jury to return a verdict, it is necessary that each juror agree to the verdict.

Your verdict must be unanimous.

It is your duty, as jurors, to consult with one another and to deliberate with a view towards reaching an agreement, if you can do so without violence to your individual judgment. Each of you must decide the case for yourself, but do so only after an impartial consideration of the evidence with your fellow jurors. In the course of your deliberations, do not hesitate to reexamine your own views and change your opinion, if convinced it is erroneous. But do not surrender your honest conviction as to the weight or effect of evidence solely because of the opinion of your fellow jurors, or for the purpose of returning a verdict. Remember at all times that you are judges – judges of the facts. Your sole interest is to seek the truth from the evidence in the case.

A form of verdict has been prepared for you. The verdict form asks you a series of questions about the parties' claims. Unless you are directed otherwise in the form of the verdict, you must answer all of the questions posed, and you all must agree on each answer. When you have reached a unanimous agreement as to your verdict, you will return your verdict to the courtroom deputy.

It is proper to add the caution that nothing said in these instructions and nothing in the form of verdict is meant to suggest or convey in any way or manner what verdict I think you should find. What the verdict shall be is the sole and exclusive duty and responsibility of the jury.

DUTY TO DELIBERATE

Now that all the evidence is in and the arguments are completed, you are free to talk about the case in the jury room. In fact, it is your duty to talk with each other about the evidence and to make every reasonable effort you can to reach a unanimous agreement. Talk with each other, listen carefully and respectfully to each other's views and keep an open mind as you listen to what your fellow jurors have to say.

Try your best to work out your differences. Do not hesitate to change your mind if you are convinced that other jurors are right and your original position was wrong. But do not ever change your mind just because other jurors see things differently, or just to get the case over with. In the end, your vote must be exactly that – your own vote. It is important for you to reach unanimous agreement, but only if you can do so honestly and in good conscience.

If any member of the jury took notes, let me remind you that notes are not given any greater weight than the memory or impression of each juror as to what the testimony may have been. Whether you took notes or not, each of you must form and express your own opinion as to the facts of the case.

No one will be allowed to hear your discussions in the jury room, and no record will be made of what you say. So you should all feel free to speak your minds.

Listen carefully to what the other jurors have to say, and then decide for yourself.

We generally end our business day at 4:30 p.m. If we do not hear from you by 4:30, I will be sending you a note to see whether you are close enough to a verdict to want to deliberate after 4:30 or whether you are going to recess for the evening and resume your deliberations on the next business day. You will need to respond in writing

to that question.

I am going to remind you now, if you go home this evening and resume your deliberations on the next business day, you are not to talk about the case among yourselves or with anyone else during the evening recess. You may not read or listen to any news about the case in a newspaper, online or on television during the evening recess.

You may talk about the case only while you are in the jury room and everyone on the jury is present. Unless I hear from you that you have a different schedule in mind, I will expect you all to come back the next business day at 9:30. You are not to start deliberating until you are all present in the jury room and participating together.

Because the lawyers have to make themselves available to respond to questions or receive the verdict, I generally give them between 12:30 and 1:30 to step away from the phone. So whenever you are deliberating over the lunch hour, let me remind you, if you ask a question during this time, you probably will not get an answer right away because we are all going to be stepping away from our phones.

COURT HAS NO OPINION

Let me finish up by repeating something that I said to you earlier. Nothing that I have said or done during this trial was meant to influence your decision in any way. You must decide the case yourselves based on the evidence presented.

Finally, if I have read any of these instructions inconsistently with the written text, you are to rely on the written instructions in your deliberations.