

# AIPLA's Model Patent Jury Instructions

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## **Introduction**

### **1. The 1997 Version**

These model jury instructions were drafted by the Model Patent Jury Instruction Subcommittee of the American Intellectual Property Law Association's Federal Litigation Committee. The substantive drafting process was completed in July, 1997. These model instructions were then approved by the Board of Directors of the AIPLA, subject to some stylistic changes. They were first posted on the AIPLA's website in April, 1998.

One of the subcommittee's fundamental objectives was to draft a set of instructions that would not be biased in favor of either the patent owner or the accused infringer. Another fundamental goal was to accurately reflect the current state of the law on many of the major issues that typically arise in patent infringement cases, as those principles of law had been declared by the Federal Circuit Court of Appeals through July, 1997.

The subcommittee has also attempted to prepare a set of instructions that will be more easily understood by a jury than many prior sets of patent jury instructions.

However, much of the burden of assisting the jury's understanding of the applicable principles of patent law must be carried by the parties and the Court by tailoring these instructions to the facts of each particular case. For example, most cases will not involve all of the issues that are addressed by these model instructions; instructions that are superfluous should not, of course, be given. On the other hand, the subcommittee did not attempt to draft jury instructions that would cover every issue that might possibly arise in a patent infringement jury trial. In addition, there may well be further details that should be added to particular instructions to address specific issues that will arise in certain cases.

Of course, it is also intended that these instructions be used in conjunction with other instructions dealing with “non-patent” issues (e.g., credibility of witnesses).

Finally, it is intended that the trial court “breathe life” into these model instructions by relating the legal principles in the instructions to the particular factual contentions of the parties. In many instances the subcommittee has indicated where such customizing can be accomplished by placing [brackets] in the instructions. See, for example, Anticipation Instruction No. 1. These instructions were drafted with the hope and expectation that the trial court would add further evenhanded comments to explain to the jury how these instructions relate to the particular factual contentions advanced by the parties.

Copies of these model jury instructions are also available on the American Intellectual Property Law Association's web site, <http://www.aipla.org>

April 2, 1998  
Richard S. Florsheim  
Chairman, Model Jury Instructions Subcommittee  
Federal Litigation Committee  
American Intellectual Property Law Association

## **2. The 2005 Version**

In January 2004, the Patent Litigation Committee of the American Intellectual Property Association undertook the task of updating the 1997 version of the association's model jury instructions. A model jury instruction subcommittee of the Patent Litigation Committee was formed to begin working on the project.

One goal of the project was to update the 1997 version of the association's model jury instructions. Researchers were told to limit their examination of the case law through the end of September 2005. Thus, these instructions should only be considered in the context of this timeframe.

Another goal was to simplify and shorten the instructions. In meeting that goal, the subcommittee hoped to produce a set of jury instructions that would be useful for a typical patent case, rather than a set that covered every conceivable situation that might arise. As a result, some of the less-used instructions from the 1997 version were removed. Those removed instructions could be appropriate in a particular case, if they still reflect the current law. Moreover, the subcommittee expects that litigants will include additional instructions and will also modify model instructions to the facts presented in particular cases.

Finally, stylistic changes were made for readability and consistency. For instance, bracketed terminology was made consistent to allow the use of “find and replace” features in today's word processing programs. The instructions now can easily be tailored to a particular case by quickly substituting the bracketed term with the custom term for the case. For example, all instances of the term “[full patent number]” can be replaced with “U.S. Patent No. 4,045,901” using a word processor's “find and replace” feature. This enhancement to the model jury instructions should make them much easier to use during trial. The consistent terms are:

- [subject matter]
- [the patentee]
- [the Plaintiff]
- [the Defendant]
- [full patent number]
- [abbreviated patent number]
- [claims in dispute]
- [allegedly infringing product]
- [invention date]
- [U.S. filing date]
- [critical date]
- [anticipating patent]
- [alleged analogous art]
- [alleged prior publication]
- [alleged device on sale]
- [the pertinent art field]
- [alleged inherent reference]
- [infringement notice date]
- [lawsuit filing date]
- [beginning infringement date]
- [collateral products]
- [the Plaintiff's product]

The revisions to the instructions were completed on October 3, 2005. The Board of Directors approved these model jury instructions on October 29, 2005.

November 22, 2005  
Mark D. Schuman  
George D. Medlock, Jr.  
Chairpersons, Model Jury Instructions Subcommittee  
Patent Litigation Committee  
American Intellectual Property Law Association

### **3. The 2007 Version**

In the Winter of 2007, the Patent Litigation Committee of the American Intellectual Property Law Association once again undertook the task of updating the

AIPLA Model Patent Jury Instructions and a Sub-Committee was formed to review recent case law and make any necessary changes to the Instructions.

These revised instructions reflect case law issued through August 31, 2007 with a few exceptions. Several important cases came out in September 2007, including *In re Seagate Technology, LLC*, -- F3d --, 83 U.S.P.Q.2d 1865 (Fed. Cir. 2007) (en banc) and *BMC Resources v. Paymentech, L.P.*, -- F.3d --, 2007 WL 2728400 (Fed. Cir. Sept. 9, 2007) and an attempt was made to incorporate these cases into Instructions 3.1 – Direct Infringement and 13 – Willful Infringement. Because of the short time period between the time these cases were issued and the deadline for these Instruction, however, not all of the wisdom imparted in these cases could be incorporated into these Instructions and counsel should be sure to update these Instructions with any recent case law interpreting these cases.

In updating these Instructions, we followed the goals set forth by the 2005 Committee, namely to simplify and shorten the Instructions while allowing for maximum customization to fit the needs of a typical patent case. These Instructions are not meant to be a comprehensive set of Instructions that take into account every conceivable issue or permutation in a patent case.

To assist in the customization of these Instructions for a particular case, the Sub-Committee retained the use of bracketed terminology to allow for the use of the “find and replace” feature of most word processing programs. Examples of the consistent terms are:

- [subject matter]
- [the patentee]
- [the Plaintiff]
- [the Defendant]
- [full patent number]
- [abbreviated patent number]
- [claims in dispute]
- [allegedly infringing product]
- [invention date]
- [U.S. filing date]
- [critical date]
- [anticipating patent]
- [alleged analogous art]
- [alleged prior publication]
- [alleged device on sale]
- [infringement notice date]
- [lawsuit filing date]
- [beginning infringement date]
- [collateral products]
- [the Plaintiff's product]

In addition to these “find and replace” terms, brackets were also used to indicate where various terminology could be used to customize the Instructions to a particular case. For example, to take into account the differences between utility and method patents, there will be instructions that include “[product] [method]” and the like. Other examples include “[product][system],” “[importing][selling][offering for sale][using]” and “[method][process].”

The revisions to these instructions were completed on October 10, 2007. The Board of Directors approved these model jury instructions on October 20, 2007.

\_\_\_\_\_, 2007

Scott J. Pivnick

John Schneider

Chairpersons, Model Jury Instructions Subcommittee

Patent Litigation Committee

American Intellectual Property Law Association

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### The 1997 Version

Mark Abate  
Ken R. Adams  
Joseph Z. Allen  
Robert L. Baechtold  
Russell J. Barron  
Christopher R. Benson  
David J. Brezner  
Henry L. Brinks  
Jeffrey N. Costakos  
John F. Delaney  
Bradford J. Duft  
Donald R. Dunner  
Richard D. Fladung  
Floyd A. Gibson  
Eileen M. Herlihy

Roy E. Hofer  
Michael K. Kirschner  
Steven S. Korniczky  
William E. Lahey  
Bradley G. Lane  
Robert C. Laurenson  
Gary H. Levin  
Jeffrey I.D. Lewis  
Brent P. Lorimer  
Don W. Martens  
Alice O. Martin  
Clifton E. McCann  
Gaynell C. Methvin  
Frederick G. Michaud, Jr.  
Jeffrey D. Mills

John B. Pegram  
Michael F. Petock  
Peter H. Priest  
Jerrold B. Reilly  
Daniel M. Riess  
William C. Rooklidge  
Alan J. Ross  
John M. Skenyon  
Allan Sternstein  
Lawrence M. Sung  
Jennifer A. Tegfeldt  
David C. Wright

### The 2005 version

Kley Achterhof  
Stephanie Barbosa  
Kelli Deasy  
Denise DeFranco  
Barbara Fiacco  
Katherine Fick  
Mareesa Frederick  
Stephanie Harris  
Wendell Harris  
Andrew Lagatta  
Christy Lea  
Kalun Lee  
Rashida MacMurray  
Steven Maslowski  
William McGeeveran  
George Medlock  
Mary Beth Noonan  
Matthew Pearson  
Mark Schuman  
Steve Sheldon

Sean Seymour  
John Skenyon  
Stephen Timmins  
Hema Viswanathan  
Aaron Weiss  
Elizabeth Wright  
Jeremy Younkin

The 2007 version

Aaron Barlow  
Dave Bennett  
Elaine Hermann Blais  
Walter Bookhardt  
Scott Breedlove  
Patrick Coyne  
John Crossan  
Elizabeth Day  
Conor Farley  
John Hintz  
Scott Howard  
Kirby Lee  
Gregory Lyons  
Joshua Masur  
Clifton McCann  
Tim Meece  
Heather Mewes  
Joe Miller  
Kenneth Mitchell  
John Moran

Jeff Nichols  
Scott Pivnick  
Mirriam Quinn  
Amber Rovner  
Michael Sacksteder  
John Scheibeler  
John Schneider  
Mark Schuman  
Jeff Sheldon  
John Skenyon  
Steve Swinton  
Tim Teter  
Kurt Van Thomme  
David Todd  
Michael Valek  
Alastair Warr  
Adam Wichman  
Daniel Winston  
Steven Zeller

# Preliminary Jury Instructions

Members of the jury:

Now that you have been sworn, I have the following preliminary instructions for your guidance on the nature of the case and your role as jurors.

## I. The Nature of the Action and the Parties

This is a patent case. The patents involved in this case relate to [subject matter] technology. [BRIEFLY DESCRIBE TECHNOLOGY INVOLVED].

During the trial, the parties will offer testimony to familiarize you with this technology. For your convenience, the parties have also prepared a glossary of some of the technical terms to which they may refer during the trial, which will be distributed to you.

[The Plaintiff] is the owner of the patent, which is identified by the Patent Office number: [full patent number] (which may be called “the [abbreviated patent number] patent”); [IDENTIFY ADDITIONAL PATENTS]. This patent may also be referred to as “[the Plaintiff]’s patent.” [The Defendant] is the other party here.

### A. United States Patents

Patents are granted by the United States Patent and Trademark Office (sometimes called the “PTO”). During the trial, the parties may offer testimony to familiarize you with how one obtains a patent from the PTO, but I will give you a general background here.

To obtain a patent, an application for a patent must be filed with the PTO. The application includes a specification, which must have a written description of the invention telling what the invention is, how it works, and how to make and use it so as to enable others skilled in the art to do so. The specification must also describe what the inventor believed at the time of filing to be the best way of making his or her invention. The specification concludes with one or more numbered sentences. These are the claims. The purpose of the claims is to particularly point out what the applicant regards as the invention.

An application for a patent is reviewed by a trained PTO examiner who is oftentimes educated in the technical area of the patent application. The examiner reviews (or examines) the patent application to determine whether the claims are patentable and whether the specification adequately describes the invention claimed. In examining a patent application, the patent examiner searches records available to the PTO for what is referred to as “prior art,” and he or she also reviews prior art submitted by the applicant. The prior art is defined by statute and, when the parties are done presenting evidence, I will give you specific instructions as to what

constitutes prior art in this case. But generally it is technical information and knowledge that was known to the public either before the invention by the applicant or more than a year before the filing date of the patent application. The patent examiner considers, among other things, whether each claim defines an invention that is new, useful, and not obvious in view of this prior art.

Following the prior art search and examination of the application, the patent examiner advises the applicant in writing what the patent examiner has found and whether he has “allowed” any claim. This writing from the patent examiner is called an “office action.” More often than not, the initial office action by the patent examiner rejects the claims. The applicant then responds to the office action and sometimes changes the claims or submits new claims. This process may go back and forth between the patent examiner and the applicant for several months or even years until the patent examiner is satisfied that the application and claims are patentable.

The collection of papers generated by the patent examiner and the applicant during this time of corresponding back and forth is called the “prosecution history.” This history of written correspondence is contained in a file in the PTO, and consequently some people call this prosecution history the “file history” or the “file wrapper.”

## **B. Patent Litigation**

Someone is said to be infringing on claims of a patent when they, without permission from the patent owner, import, make, use, offer to sell, or sell [[the patented invention] [a product made by the patented process]], as defined by the claims, within the United States before the term of the patent expires. A patent owner who believes someone is infringing on the exclusive rights of the patent may bring a lawsuit like this to stop the alleged infringing acts and recover damages. The patent owner has the burden to prove infringement of the claims of the patent. The patent owner also has the burden to prove damages caused by that infringement, which are adequate to compensate for the infringement.

The fact that the PTO grants a patent does not necessarily mean that any invention claimed in the patent is valid [and enforceable], although the law requires a presumption of validity [and enforceability]. The PTO, for example, may not have considered prior art that will be presented to you. A person sued for allegedly infringing a patent can deny infringement and also can defend by proving the asserted claims of the patent are invalid [or unenforceable]. The accused infringer has the burden to prove invalidity [or unenforceability] by clear and convincing evidence. In evaluating infringement or invalidity, each claim is to be evaluated independently.

I will now briefly explain the parties' basic contentions in more detail.

## **II. Contentions of the Parties**

[The Plaintiff] contends that [the Defendant] makes, uses, offers to sell, or sells a [[product] [method]] that infringes [claim(s) in dispute] of the [abbreviated patent

number] patent. [The Plaintiff] has the burden of proving that [the Defendant] infringes the [abbreviated patent number] patent by a preponderance of the evidence. That means that [the Plaintiff] must show that it is more likely that [the Defendant]'s [allegedly infringing product] infringes than it does not infringe.

There are two ways in which a patent claim can be directly infringed. First, a claim can be literally infringed. Second, a claim can be infringed under what is called the “doctrine of equivalents”. To determine literal infringement, you must compare the accused [[product] [method]] with each claim that [the Plaintiff] asserts is infringed. It will be my job to tell you what the patent claims mean. You must follow my instructions as to the meaning of the patent claims.

A patent claim is literally infringed only if [the Defendant]'s [[product] [method]] includes each and every [[element] [method step]] in that patent claim. If [the Defendant]'s [[product] [method]] does not contain one or more [[elements] [method steps]] in that claim, [the Defendant] does not literally infringe that claim. You must determine literal infringement with respect to each patent claim individually.

Under the doctrine of equivalents, you may find that [the Defendant]'s [[product] [method]] infringes a claim of the [abbreviated patent number] patent even if not every [[element] [step]] of that claim is present in [the Defendant]'s [[product] [method]]. However, to do so, you must find that there is an equivalent [[component] [part] [method step]] in [the Defendant]'s [[product] [method]] for each [[element] [method step]] of the patent claim that is not literally present in [the Defendant]'s [[product] [method]]. [The Plaintiff] has the burden of proving by a preponderance of the evidence that [the Defendant]'s [[product] [method]] contains the equivalent of each element of the claimed invention that is not literally present in the [allegedly infringing product].

[The Defendant] denies that it is infringing the [abbreviated patent number] patent. [The Defendant] also contends that the [abbreviated patent number] patent is invalid [or unenforceable]. [INSERT BRIEF DESCRIPTION OF THE PARTICULAR INVALIDITY DEFENSES BEING ASSERTED].

Invalidity is a defense to infringement. Therefore, even though the PTO examiner has allowed the claims of the [abbreviated patent number] patent, you, the jury, have the ultimate responsibility for deciding whether the claims of the [abbreviated patent number] patent are valid. [The Defendant] bears the burden of proving invalidity by clear and convincing evidence. This is a higher burden than a preponderance of the evidence, but it does not require proof beyond a reasonable doubt. Clear and convincing evidence is evidence that shows it is highly probable that the claims are invalid.

### **III. Trial Procedure**

We are about to commence the opening statements in the case. Before we do that, I want to explain the procedures that we will be following during the trial and the format of the trial. This trial, like all jury trials, comes in six phases. We have completed the first phase, which is to select you as jurors. We are now about to begin the second phase,

the opening statements. The opening statements of the lawyers are statements about what each side expects the evidence to show. The opening statements are not evidence for you to consider in your deliberations.

The evidence comes in the third phase, when the witnesses will take the witness stand and the documents will be offered and admitted into evidence. In the third phase, [the Plaintiff] goes first in calling witnesses to the witness stand. These witnesses will be questioned by [the Plaintiff]'s counsel in what is called direct examination. After the direct examination of a witness is completed, the opposing side has an opportunity to cross-examine the witness. After [the Plaintiff] has presented its witnesses, [the Defendant] will call its witnesses, who will also be examined and cross-examined. The parties may present the testimony of a witness by reading from their deposition transcript or playing a videotape of the witness's deposition testimony. A deposition is the sworn testimony of a witness taken before trial and is entitled to the same consideration as if the witness had testified at trial.

The evidence often is introduced piecemeal, so you need to keep an open mind as the evidence comes in. You are to wait until all the evidence comes in before you make any decisions. In other words, keep an open mind throughout the entire trial.

After we conclude the third phase, the lawyers again have an opportunity to talk to you in what is called “closing argument,” which is the fourth phase. Again, what the lawyers say is not evidence. The lawyers' closing arguments are for the purpose of helping you in making your decisions.

The fifth phase of the trial is when I read you the jury instructions. In that phase, I will instruct you on the law. I have already explained to you a little bit about the law. But in the fifth phase of the trial, I will explain the law in much more detail.

Finally, in the sixth phase of the trial it will be time for you to deliberate. You can then evaluate the evidence, discuss the evidence among yourselves and make a decision in the case. You are the judges of the facts, and I decide questions of law. I will explain the rules of law that apply to this case, and I will also explain the meaning of the patent claim language. You must follow my explanation of the law and the patent claim language even if you do not agree with me. Nothing I say or do during the course of the trial is intended to indicate what your verdict should be.

## Glossary of Patent Terms

**Anticipation** – When a single prior art reference shows identically every element of the claimed invention.

**Application** – The initial papers filed by the applicant in the United States Patent and Trademark Office (also called the Patent Office or PTO).

**Claims** – The numbered sentences appearing at the end of the patent that define the invention (s) and therefore the boundary of the patent monopoly. The words of the claims define the scope of the patent owner's exclusive rights during the life of the patent.

**File wrapper** – See “prosecution history” below.

**Infringement** – Where the accused device contains every element of a patent claim as properly interpreted or an equivalent thereof.

**License** – Permission to use the patented invention(s), which may be granted by a patent owner (or a prior licensee) in exchange for a fee called a “royalty” or other compensation.

**Obviousness** – When the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.

**Office action** – Communication from the patent examiner regarding the specification (see definition below) and/or the claims in the patent application.

**Ordinary skill in the art** – The level of experience, education, and/or training possessed by those individuals who work in the area of the invention.

**Patent Examiners** – Personnel employed by the PTO in a specific technical area who review (examine) the patent application to determine (1) whether the claims of a patent application are patentable over the prior art considered by the examiner, and (2) whether the specification/application describes the invention with the required specificity.

**Prior art** – Knowledge that is available to the public either prior to the invention by the applicant or more than one year prior to the filing date of the application. [Insert additional types of prior art if applicable, e.g., nonpublic art.]

**Prosecution history** – The written record of proceedings between the applicant and the PTO, including the original patent application and later communications between the PTO and applicant. The prosecution history may also be referred to as the “file history” or “file wrapper” of the patent during the course of this trial.

**References** – Any item of prior art used to determine patentability.

**Specification** – The information that appears in the patent and concludes with one or more claims. The specification includes the written text, the claims, and the drawings. In the specification, the inventor describes the invention, how it works, and how to make and use it. The specification must describe the invention in sufficient detail to enable others skilled in the art to practice the invention and must describe what the inventor believed at the time of filing to be the best way of making his or her invention.

## **Glossary of Technical Terms**

[To be agreed upon between the parties]

# Post Trial Instructions<sup>1</sup>

## 1. Summary of Patent Issues

I will now summarize the issues that you must decide and for which I will provide instructions to guide your deliberations. You must decide the following [four] main issues:

1. Whether [the Plaintiff] has proved that [the Defendant] infringed Claim[s] [claims in dispute] of the [abbreviated patent number] patent.
2. Whether [the Plaintiff] has proved that [the Defendant] engaged in willful acts of infringement.
3. Whether [the Defendant] has proved that Claim[s] [claims in dispute] of the [abbreviated patent number] patent are invalid.
4. What amount of damages, if any, [the Plaintiff] has proved.

**[LIST ANY OTHER PATENT ISSUES]**

## Claim Construction

### 2.0 Claim Construction – Generally

Before you decide whether [the Defendant] has infringed the claims of [the Plaintiff's] patent or whether [the Plaintiff's] patent is invalid, you will have to understand the patent claims. The patent claims are numbered sentences at the end of the patent. The patent claims involved here are [claims in dispute], beginning at column \_\_\_\_, line \_\_\_\_ of the patent, which is exhibit \_\_\_\_ in evidence. The claims are intended to define, in words, the boundaries of the invention. Only the claims of the patent can be infringed. Neither the written description, nor the drawings of a patent can be infringed. Each of the claims must be considered individually. You must use the same claim meaning for both your decision on infringement and your decision on invalidity.

35 U.S.C. § 112; *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005); *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277 (Fed. Cir. 2002); *Tanabe Seiyaku Co. v. United States Int'l Trade Comm'n*, 109 F.3d 726 (Fed. Cir. 1997); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996); *Datascope Corp. v. SMEC, Inc.*, 879 F.2d 820 (Fed. Cir. 1989); *SmithKline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878 (Fed. Cir. 1988); *Panduit Corp. v. Dennison Mfg. Co.*, 836 F.2d 1329 (Fed. Cir. 1987); *Amstar Corp. v. Envirotech Corp.*, 823 F.2d 1538 (Fed. Cir. 1987).

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<sup>1</sup> AIPLA drafted the model instructions assuming the litigated issues included in the instructions will be submitted to the jury. AIPLA is not suggesting that the parties have a right to a jury trial on all issues included in the instructions.

## 2.1 Claim Construction for the Case

It is my job as judge to provide to you the meaning of any claim language that must be interpreted. You must accept the meanings I give you and use them when you decide whether any claim of the patent has been infringed and whether any claim is invalid. I will now tell you the meanings of the following words and groups of words from the patent claims.

[READ STIPULATIONS AND COURT'S CLAIM CONSTRUCTIONS]

You should give the rest of the words in the claims their ordinary meaning in the context of the patent specification and prosecution history.

*Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (en banc); *SmithKline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878 (Fed. Cir. 1988).

## 2.2 Construction of Means-Plus-Function Claims for the Case

The following clause used in claim(s) \_\_\_\_\_ of the [abbreviated patent number] patent is in a special form called a [[“means-plus-function”] [“step-plus-function”]] clause:

“\_\_\_\_\_”. This clause requires a special interpretation. Those words do not cover all [[means] [steps]] that perform the recited function of “\_\_\_\_\_”, but cover only the [[structure] [step]] described in the patent specification and drawings that performs the function of “\_\_\_\_\_” or an equivalent of that [[structure] [step]]. The court has found that the [[structure] [step]] in the patent specification that performs that function is: “\_\_\_\_\_.” You must use my interpretation of the means-plus-function [[element] [step]] in your deliberations regarding infringement and validity.

35 U.S.C. § 112; *Utah Med. Prods., Inc. v. Graphic Controls Corp.*, 350 F.3d 1376 (Fed. Cir. 2003); *Carroll Touch, Inc. v. Electro Mech. Sys., Inc.*, 15 F.3d 1573, 1578 (Fed. Cir. 1993); *Valmont Indus., Inc. v. Reinke Mfg. Co., Inc.*, 983 F.2d 1039, 1042-43 (Fed. Cir. 1993).

## Infringement

### 3.0 Infringement – Generally

Questions \_\_\_\_\_ through \_\_\_\_\_ of the Verdict Form read as follows: [READ TEXT OF INFRINGEMENT VERDICT QUESTIONS].

I will now instruct you as to the rules you must follow when deciding whether [the Plaintiff] has proven that [the Defendant] infringed any of the claims of the [abbreviated patent number] patent.

Patent law gives the owner of a valid patent the right to exclude others from importing, making, using, offering to sell, or selling [[the patented invention] [a product made by a patented method]] within the United States during the term of the patent. Any person or business entity that has engaged in any of those acts without the patent owner's permission infringes the patent. Here, [the Plaintiff] alleges that [the Defendant]'s [allegedly infringing product] infringes claim[s] [claims in dispute] of [the Plaintiff]'s [abbreviated patent number] patent.

You have heard evidence about both [the Plaintiff]'s commercial [[product] [method]] and [the Defendant]'s accused [[product] [method]]. However, in deciding the issue of infringement you may not compare [the Defendant]'s accused [[product] [method]] to [the Plaintiff]'s commercial [[product] [method]]. Rather, you must compare the [Defendant]'s accused [[product] [method]] to the claims of the [abbreviated patent number] patent when making your decision regarding infringement.

A patent may be infringed directly or indirectly. Direct infringement results if the accused [[product][method]] is covered by at least one claim of the patent. Indirect infringement results if the defendant induces another to infringe a patent or contributes to the infringement of a patent by another.

35 U.S.C. § 271; *Seal-Flex, Inc. v. Athletic Track & Court Constr.*, 172 F.3d 836, 842 (Fed. Cir. 1999); *Andco Envtl. Processes, Inc. v. Niagara Envtl. Assocs., Inc.*, 206 U.S.P.Q. 656, 662 (W.D.N.Y. 1980).

### **3.1 Direct Infringement – Knowledge of Patent or Intent to Infringe is Immaterial**

In this case, [the Plaintiff] asserts that [the Defendant] has directly infringed the patent. [The Defendant] would be liable for directly infringing [the Plaintiff]'s patent if you find that [the Plaintiff] has proven that it is more likely than not that [the Defendant] has made, used, offered to sell, or sold the invention defined in at least one claim of [the Plaintiff]'s patent.

Someone can directly infringe a patent without knowing that what they are doing is an infringement of the patent. They also may directly infringe a patent even though they believe in good faith that what they are doing is not an infringement of any patent.

35 U.S.C. § 271(a); *BMC Resources v. Paymentech, L.P.*, -- F.3d --, 2007 WL 2728400 (Fed. Cir. Sept. 9, 2007); *DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314, 1330 (Fed. Cir. 2001); *Seal-Flex, Inc. v. Athletic Track & Court Constr.*, 172 F.3d 836, 842 (Fed. Cir. 1999); *Intel Corp. v. U.S. Int'l Trade Comm'n*, 946 F.2d 821, 832 (Fed. Cir. 1991); *SmithKline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878, 889 (Fed. Cir. 1988).

### **3.2 Direct Infringement – Literal Infringement**

To determine literal infringement, you must compare the accused [[product] [method]] with each claim that [the Plaintiff] asserts is infringed, using my instructions as to the meaning of the patent claims.

A patent claim is literally infringed only if [the Defendant]'s [[product] [method]] includes each and every [[element] [method step]] in that patent claim. If [the Defendant]'s [[product] [method]] does not contain one or more [[elements] [method steps]] recited in a claim, [the Defendant] does not literally infringe that claim. You must determine literal infringement with respect to each patent claim individually.

The accused [[product] [method]] should be compared to the invention described in each patent claim it is alleged to infringe, not to the [the Plaintiff]'s preferred or commercial

embodiment of the claimed invention. The same [[element] [method step]] of the accused [product] [method] may satisfy more than one element of a claim.

*DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314, 1330-31 (Fed. Cir. 2001); *Wenger Mfg. Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1231 (Fed. Cir. 2001); *Gen. Mills, Inc. v. Hunt-Wesson, Inc.*, 103 F.3d 978, 981 (Fed. Cir. 1997); *Martin v. Barber*, 755 F.2d 1564, 1567 (Fed. Cir. 1985); *Amstar Corp. v. Envirotech Corp.*, 730 F.2d 1476, 1483 (Fed. Cir. 1984).

### **3.3 Inducing Patent Infringement**

[The Plaintiff] asserts that [the Defendant] has actively induced another to infringe the patent. To show induced infringement, [the Plaintiff] must prove that it is more likely than not that someone has directly infringed the [abbreviated patent number] patent and that [the Defendant] has actively and knowingly aided and abetted that direct infringement. [The Plaintiff] must show that [the Defendant] actually intended to cause the acts that constitute direct infringement, that [the Defendant] knew of the patent, and that [the Defendant] knew or should have known that its actions would lead to actual infringement. Intent to cause the acts that constitute direct infringement may be demonstrated by evidence of active steps taken to encourage direct infringement, such as advertising an infringing use or instructing how to engage in an infringing use. It is not necessary to show that [the Defendant] has directly infringed as long as you find that someone has directly infringed. If there is no direct infringement by anyone, [the Defendant] has not induced infringement.

35 U.S.C. § 271(b); *DSU Medical Corp. v. JMS Co.*, 471 F.3d 1293, 1304-05 (Fed. Cir. 2006) (quoting *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 936 (2005)); *Metabolite Labs., Inc. v. Lab. Corp. of Am.*, 370 F.3d 1354, 1365 (Fed. Cir. 2004); *Ferguson Beauregard/Logic Controls, Div. of Dover Res., Inc. v. Mega Sys., LLC*, 350 F.3d 1327, 1342 (Fed. Cir. 2003); *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc.*, 145 F.3d 1303, 1312 (Fed. Cir. 1998); *Manville Sales Corp. v. Paramount Sys., Inc.*, 917 F.2d 544, 553 (Fed. Cir. 1990); *C.R. Bard, Inc. v. Advanced Cardiovascular Sys., Inc.*, 911 F.2d 670, 674 (Fed. Cir. 1990); *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 909 F.2d 1464, 1468-69 (Fed. Cir. 1990); *SmithKline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878, 889 (Fed. Cir. 1988).

### **3.4 Contributory Infringement**

[The Plaintiff] asserts that [the Defendant] has contributed to another's infringement. To show contributory infringement, [the Plaintiff] has the burden to prove that it is more likely than not that there was contributory infringement.

It is not necessary to show that [the Defendant] has directly infringed as long as you find that someone has directly infringed. If there is no direct infringement by anyone, [the Defendant] has not contributed to the infringement of the patent. If you find someone has directly infringed the [abbreviated patent number] patent, then contributory infringement exists if:

- (1) [the Defendant] sold, offered for sale, or imported;

(2) a material component of the patented invention that is not a staple article of commerce capable of substantial non-infringing use;

(3) with knowledge that the component was especially made or adapted for use in an infringing [[product] [method]].

A “staple article of commerce capable of substantial non-infringing use” is something that has uses [[other than as a part or component of the patented product] [other than in the patented method]], and those other uses are not occasional, farfetched, impractical, experimental, or hypothetical.

35 U.S.C. § 271(c); *PharmaStem Therapeutics, Inc. v. ViaCell, Inc. et al.*, 491 F.3d 1342, 1356-58 (Fed. Cir. 2007); *Mentor H/S, Inc. v. Med. Device Alliance, Inc.*, 244 F.3d 1365 (Fed. Cir. 2001); *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 909 F.2d 1464, 1469 (Fed. Cir. 1990); *Preemption Devices, Inc. v. Minn. Mining & Mfg. Co.*, 803 F.2d 1170, 1174 (Fed. Cir. 1986); 4 Donald S. Chisum, *Patents* § 17.03[3], n.6 (2002).

### 3.5 Infringement of Means-Plus-Function Claims

The court has instructed you that claims \_\_\_\_\_ through \_\_\_\_\_ of the [abbreviated patent number] patent contain [[means-plus-function] [step-plus-function]] clauses. To show infringement, it is [the Plaintiff]'s burden to prove that it is more likely than not that the [[part of the Defendant's product] [step in the Defendant's method]] that performs the function of “\_\_\_\_\_” is identical to, or equivalent to, the [[structure] [step]] described in the specification for performing the identical function.

In deciding whether [the Plaintiff] has proven that [the Defendant]'s [[product] [method]] includes structure covered by a [[means-plus-function] [step-plus-function]] requirement, you must first decide whether the [[product] [method]] has any [[structure] [step]] that performs the function I just described to you. If not, the claim containing that means-plus-function requirement is not infringed.

If you find that [the Defendant]'s accused [[product] [method]] does have the [[structure] [step]] that performs the claimed function, you must next identify the [[structure] [step]] in [the Defendant]'s [accused product] that perform[s] this function. After identifying that [[structure] [step]], you must then determine whether [the Plaintiff] has shown that that [[structure] [step]] is either identical to, or equivalent to, any [[structure] [step]] disclosed in the patent specification for performing the function of “\_\_\_\_\_.” If they are the same or equivalent, the [[means-plus-function] [step-plus-function]] requirement is satisfied by that [[structure] [step]] of the [accused product]. If all the other requirements of the claim are satisfied by structures found in the [accused product], the [accused product] infringes the claim.

Whether the [[structure] [step]] of the accused product is equivalent to a [[structure] [step]] described in the patent specification is decided from the perspective of a person of ordinary skill in the art. If a person of ordinary skill in the art would consider the differences between the [[structure] [step]] found in [the Defendant]'s product and a [[structure] [step]] described in the patent specification to be insubstantial, the [[structures] [steps]] are equivalent

35 U.S.C. § 112; *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1113-14 (Fed. Cir. 2002); *Asyst Tech, Inc. v. Empak, Inc.*, 268 F.3d 1364, 1369-70 (Fed. Cir. 2001); *Ishida Co. v. Taylor*, 221 F.3d 1310, 1316-17 (Fed. Cir. 2000); *Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1266-68 (Fed. Cir. 1999); *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1320 (Fed. Cir. 1999); *Seal-Flex, Inc. v. Athletic Track & Court Const.*, 172 F.3d 836, 843-44 (Fed. Cir. 1999); *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc.*, 145 F.3d 1303, 1307-09 (Fed. Cir. 1998); *Carroll Touch, Inc. v. Electro Mech. Sys., Inc.*, 15 F.3d 1573, 1578 (Fed. Cir. 1993); *Rite-Hite Corp. v. Kelley Co.*, 819 F.2d 1120, 1123-25 (Fed. Cir. 1987); *Texas Instruments, Inc. v. U.S. Int'l Trade Comm'n*, 805 F.2d 1558, 1562 (Fed. Cir. 1986).

### **3.6 Infringement of Dependent Claims**

There are two different types of claims in the patent. One type of claim is called an independent claim. The other type of claim is called a dependent claim.

An independent claim is a claim that does not refer to any other claim of the patent. An independent claim must be read separately from the other claims to determine the scope of the claim.

A dependent claim is a claim that refers to at least one other claim in the patent. A dependent claim incorporates all of the elements of the claim to which the dependent claim refers, as well as the elements recited in the dependent claim itself.

For example, [Independent Claim] is an independent claim and recites several elements. [Dependent Claim] is a dependent claim that refers to [Independent Claim] and includes an additional element or limitation. [IDENTIFY THE DIFFERENCES BETWEEN [Independent Claim] AND [Dependent Claim]]. [Dependent Claim] requires each of the elements of [Independent Claim], as well as the additional elements identified in [Dependent Claim] itself.

To establish literal infringement of [Dependent Claim], [the Plaintiff] must show that it is more likely than not that the [the Defendant]'s [[product] [method]] includes each and every element of [Dependent Claim].

If you find that the [Independent Claim] from which [Dependent Claim] depends is not literally infringed, then you cannot find that [Dependent Claim] is literally infringed.

*Wolverine World Wide v. Nike Inc.*, 38 F.3d 1192, 1199 (Fed. Cir. 1994); *Wilson Sporting Goods v. David Geoffrey & Assocs.*, 904 F.2d 677 (Fed. Cir. 1990); *Wahpeton Canvas Co., Inc. v. Frontier, Inc.*, 870 F.2d 1546, 1553 nn.9&10 (Fed. Cir. 1989); *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 626 (Fed. Cir. 1985).

### **3.7 Infringement of Open Ended or “Comprising” Claims**

The preamble to claim \_\_\_\_\_ uses the phrase [RECITE THE PREAMBLE “\_\_\_\_\_ comprising”]. The word “comprising” means “including the following but not excluding others.”

If you find that [the Defendant]'s [[product] [method]] includes all of the elements in claim \_\_\_\_\_, the fact that [the Defendant]'s [[product] [method]] might include additional [[components] [method steps]] would not avoid literal infringement of a claim that uses “comprising” language.

*Invitrogen Corp. v. Biocrest Mfg. LP*, 327 F.3d 1364, 1368 (Fed. Cir. 2003); *AFG Indus. v. Cardinal IG Co.*, 239 F.3d 1239, 1244 (Fed. Cir. 2001); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1271 (Fed. Cir. 1986); *AB Dick Co. v. Burroughs Corp.*, 713 F.2d 700, 703 (Fed. Cir. 1983).

### **3.8 Infringement by supply of components to another country (inducement under 271(f)(1)) – System or apparatus claims**

[Plaintiff] asserts that [Defendant] infringed the [abbreviated patent number] patent by supplying [or causing to be supplied] all or a substantial portion of the components of the patented [product] [system] from the United States to another country and actively inducing the assembly of those components into a [product] [system] that would infringe the [abbreviated patent number] patent if they had been assembled in the United States.

You should find that [Defendant] infringed the [abbreviated patent number] patent by supplying the components and inducing them to be assembled if you find that (1) the [product] [system], as it was [intended to be] assembled outside the United States, [included][would have included] all limitations of at least one of claims \_\_\_\_\_ of the [-abbreviated patent number] patent, (2) [Defendant] supplied [or caused to be supplied] components from the United States that made up all or a substantial portion of the invention of any one of claims \_\_\_\_\_ of the [abbreviated patent number] patent, and (3) [Defendant] specifically intended to induce the combination of the components into a [product][system] that would infringe the [abbreviated patent number] patent if the components had been combined in the United States.

[In considering whether or not the components supplied by [Defendant] constitute a substantial portion of the claimed invention, you should keep in mind that this question does not necessarily depend solely on the number of elements supplied by defendants and does not necessarily mean substantially all elements.]

You should find specific intent to induce the combination of the components into an infringing [product] [system] only if you find that [Defendant's] actions induced the combination of the components and [Defendant] knew or should have known that an assembled [product][system] would infringe if it were in the United States. For this requirement, it is not enough for the [Defendant] only to know the manner in which the [product][system] was to be assembled; the [Defendant] also must have known or should have known that it would be an infringement if assembled in that way. In deciding whether this requirement is satisfied, you may consider both direct evidence and circumstantial evidence of the Defendant's intentions as well as whether the Defendant reasonably believed that the resulting assembly would not be an infringement. Relevant evidence to consider may include whether [Defendant] knew of the existence of the [abbreviated patent number] patent, any acts that [Defendant] engaged in to induce the combination of the components, and whether [Defendant] had a reasonable basis to

believe that the resulting combination would not practice any claim of the [abbreviated patent number] patent.

35 U.S.C. § 271(f)(1); *DSU Med. Corp. v. JMS Co. Ltd.*, 471 F.3d 1293, 1304 (Fed. Cir. 2006); *Golden Blount, Inc. v. Robert H. Peterson Co.*, 438 F.3d 1354, 1364 n. 4 (Fed. Cir. 2006); *MEMC Elec. Materials, Inc. v. Mitsubishi Materials Silicon Corp.*, 420 F.3d 1369, 1378 (Fed. Cir. 2005); *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1365 (Fed. Cir. 2004); *3M v. Chemque, Inc.*, 303 F.3d 1294, 1304-05 (Fed. Cir. 2002); *Manville Sales Corp. v. Paramount Sys., Inc.*, 917 F.2d 544, 554 (Fed. Cir. 1990); *Water Techs. Corp. v. Calco, Ltd.*, 850 F.2d 660, 669 (Fed. Cir. 1988); *Moore U.S.A., Inc. v. The Standard Register Co.*, 144 F. Supp. 2d 188 (W.D.N.Y. 2001); *T.D. Williamson, Inc. v. Laymon, Inc.*, 723 F. Supp. 587 (N.D. Okla. 1989).

### **3.9 Infringement by supply of components to another country (inducement under 271(f)(1)) – Method claims**

[Plaintiff] asserts that [Defendant] infringed the [abbreviated patent number] patent by supplying [or causing to be supplied] all or a substantial portion of the components used in practicing a method covered by [abbreviated patent number] patent from the United States to another country and actively inducing the performance of a [method][process] that would infringe if performed in the United States.

You should find that [Defendant] infringed the [abbreviated patent number] patent by supplying the components and inducing them to be assembled into a [product][system] that would permit the patented [method][process] to be performed if you find that (1) [Defendant's] [product] [system] assembled outside the United States would permit a [method][process] that includes all of the limitations of at least one of claims \_\_\_\_ of the [abbreviated patent number] patent to be practiced outside the United States, (2) [Defendant] supplied components from the United States that made up all or a substantial portion of a [product][system] that permitted all limitations of any one of claims \_\_\_\_\_ of the [abbreviated patent number] patent to be practiced, and (3) [Defendant] specifically intended to induce the combination of the exported components to permit the practice of a [method][process] that would infringe the [abbreviated patent number] patent if the [method][process] had been practiced in the United States.

[In considering whether or not the components supplied by [Defendant] constitute a substantial portion, you should keep in mind that this question does not necessarily depend solely on the number of elements supplied by defendants and does not necessarily mean substantially all elements.]

You should find specific intent to induce the combination of the components to practice an infringing [method][process] only if you find that [Defendant's] actions induced the combination of the components and [Defendant] knew or should have known that the assembled components would permit a [method][process] to be practiced that would infringe the [abbreviated patent number] patent if it were in the United States. For this requirement, it is not enough for the [Defendant] only to know the manner in which the components were to be assembled; the [Defendant] also must have known or should have known that they would have permitted an infringement if assembled in that way. In deciding whether this requirement is satisfied, you may consider both direct evidence and circumstantial evidence of the Defendant's intentions as well as whether the Defendant reasonably believed that the resulting assembly

would not permit a infringing [method][process] to be practiced. Relevant evidence to consider may include whether [Defendant] knew of the existence of the [abbreviated patent number] patent, any acts that [Defendant] engaged in to induce the combination of the components, and whether [Defendant] had a reasonable basis to believe that the resulting combination would not practice any claim of the [abbreviated patent number] patent.

35 U.S.C. § 271(f)(1); *DSU Med. Corp. v. JMS Co. Ltd.*, 471 F.3d 1293 (Fed. Cir. 2006); *Golden Blount, Inc. v. Robert H. Peterson Co.*, 438 F.3d 1354 (Fed. Cir. 2006); *Union Carbide Chems. & Plastics Tech. Corp. v. Shell Oil Co.*, 425 F.3d (Fed. Cir. 2005); *MEMC Elec. Materials, Inc. v. Mitsubishi Materials Silicon Corp.*, 420 F.3d 1369 (Fed. Cir. 2005); *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354 (Fed. Cir. 2004); *3M v. Chemque, Inc.*, 303 F.3d 1294 (Fed. Cir. 2002); *Manville Sales Corp. v. Paramount Sys., Inc.*, 917 F.2d 544 (Fed. Cir. 1990); *Water Techs. Corp. v. Calco, Ltd.*, 850 F.2d 660 (Fed. Cir. 1988); *Moore U.S.A., Inc. v. The Standard Register Co.*, 144 F. Supp. 2d 188, 195 (W.D.N.Y. 2001); *T.D. Williamson, Inc. v. Laymon, Inc.*, 723 F. Supp. 587, 592-93 (N.D. Okla. 1989); *see also Microsoft Corp. v. AT&T Corp.*, 550 U.S. \_\_, \_\_, 127 S.Ct. 1746, 167 L.Ed.2d 737 n.13 (2007).

### **3.10 Infringement by supply of components to another country (infringement under 271(f)(2)) – Product or system claims**

[Plaintiff] asserts that [Defendant] infringed the [abbreviated patent number] patent by supplying [or causing to be supplied] [a component][components] of an invention covered by at least one claim of the [abbreviated patent number] patent from the United States to a foreign country, where the exported component[s] [was][were] especially made or especially adapted for use in an invention covered by the [abbreviated patent number] patent and [has][have] no substantial non-infringing use, and where [Defendant] knew the component[s] [was][were] especially made or adapted for use in the patented invention and intended for the component[s] to be combined in a way that would have infringed the [abbreviated patent number] patent if the combination had occurred in the United States.

You should find that [Defendant's] acts of supplying [or causing the supply of] components infringed the [abbreviated patent number] patent if you find that (1) [Defendant] actually supplied the components from the United States to a foreign country or caused them to be supplied from the United States to a foreign country, (2) [Defendant] knew or should have known that the components were especially made or adapted for use in a [product] [system] that infringes the [abbreviated patent number] patent, (3) those components have no substantial non-infringing use, and (4) [Defendant] intended for the components to be combined into that [product] [system]. It is not necessary for you to find that the components actually were combined into an infringing [product] [system], as long as you find that [Defendant] intended the components to be combined in to a [product][system] that would have infringed the [abbreviated patent number] patent if they had been combined in the United States.

35 U.S.C. § 271(f)(2); *Waymark Corp. v. Porta Systems Corp.*, 245 F.3d 1364 (Fed. Cir. 2001); *Rotec Indus., Inc. v. Mitsubishi Corp.*, 215 F.3d 1246 (Fed. Cir. 2000).

### **3.11 Infringement by supply of components to another country (infringement under 271(f)(2)) – Method claims**

[Plaintiff] asserts that [Defendant] infringed the [abbreviated patent number] patent by supplying [or causing to be supplied] [a component] [components] from the United States to a foreign country, where the component[s] [was] [were] especially made or especially adapted for use in practicing a method covered by the [abbreviated patent number] patent and [has][have] no substantial non-infringing use, and where [Defendant] knew the component[s] [was][were] especially made or adapted for use in practicing the patented method and intended for the component[s] to be combined and used in a way that would have infringed the [abbreviated patent number] patent if the combination and use had occurred in the United States.

You should find that [Defendant's] acts of supplying [or causing the supply] of components infringed the [abbreviated patent number] patent if you find that (1) [Defendant] actually supplied the components from the United States to a foreign country or caused them to be supplied from the United States to a foreign country, (2) [Defendant] knew or should have known that the components it supplied [or caused to be supplied] were especially made or adapted for use in practicing a method that infringes the [abbreviated patent number] patent, (3) those components have no substantial non-infringing use, and (4) [Defendant] intended for the components to be combined into a [product] [system] that would practice that method. It is not necessary for you to find that the components actually were combined into an infringing [product] [system], as long as you find that [Defendant] intended the components to be combined in to a [product][system] that would have practiced a method that infringed the [abbreviated patent number] patent if they had been combined and used in the United States.

35 U.S.C. § 271(f)(2); *Union Carbide Chems. & Plastics Tech. Corp. v. Shell Oil Co.*, 425 F.3d 1366 (Fed. Cir. 2005); *Waymark Corp. v. Porta Systems Corp.*, 245 F.3d 1364 (Fed. Cir. 2001); *Rotec Indus., Inc. v. Mitsubishi Corp.*, 215 F.3d 1246 (Fed. Cir. 2000); *see also Microsoft Corp. v. AT&T Corp.*, 550 U.S. \_\_, \_\_, 127 S.Ct. 1746, 167 L.Ed.2d 737 n.13 (2007).

### **3.12 Infringement by Import, Sale, Offer for Sale or Use of Product Made Outside United States by Patented Process (infringement under 271(g))**

[Plaintiff] asserts that [Defendant] infringed the [abbreviated patent number] patent by [importing][selling][offering for sale][using] a product that was made outside the United States by a process covered by one or more claims of the [abbreviated patent number] patent.<sup>2</sup>

You should find that [Defendant] infringed the [abbreviated patent number] patent in this way if you find that (1) [Defendant] [imported][sold][offered for sale][used] a product that was made outside the United States by a process that includes all steps of at least one claim of the [abbreviated patent number] patent, (2) the product was made between [issue date of patent] and [expiration date of patent][date of trial], (3) [Defendant] [imported][sold][offered for sale][used] the product between [issue date of patent] and [expiration date of patent][date of trial].

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<sup>2</sup> Some District Courts have also applied section 271(g) to products made by processes inside the United States.

It is up to you to use your own judgment, based on the evidence presented at trial, to decide whether the product was “made by” the patented process. However, I am instructing you that you should find that the product was not “made by” by the patented process if you find that either (a) the product was materially changed by later processes, or (b) the product is only a trivial or non-essential part of another product.<sup>3</sup>

35 U.S.C. § 271(g); *Mycogen Plant Sci., Inc. v. Monsanto Co.*, 252 F.3d 1306 (Fed. Cir. 2001); *Biotec Biologische Naturvenpackungen GmbH v. Biocorp, Inc.*, 249 F.3d 1341 (Fed. Cir. 2001); *Eli Lilly & Co. v. American Cyanamid Co.*, 82 F.3d 1568 (Fed. Cir. 1996); *Bio-Technology Gen. Corp. v. Genentech, Inc.*, 80 F.3d 1553 (Fed. Cir. 1996).

### **3.13 Direct Infringement – Infringement Under the Doctrine of Equivalents**

If you decide that [the Defendant]’s [[product] [method]] does not literally infringe an asserted patent claim, you must then decide whether that [[product] [method]] infringes the asserted claim under what is called the “doctrine of equivalents.” Under the doctrine of equivalents, the [[product] [method]] can infringe an asserted patent claim if it includes [[parts] [steps]] that are identical or equivalent to the requirements of the claim. If the [[product] [method]] is missing an identical or equivalent [[part] [step]] to even one [[part] [step]] of the asserted patent claim, the [[product] [method]] cannot infringe the claim under the doctrine of equivalents. Thus, in making your decision under the doctrine of equivalents, you must look at each individual requirement of the asserted patent claim and decide whether the [[product] [method]] has an identical or equivalent [[part] [step]] to that individual claim requirement.

A [[part] [step]] of a [[product] [method]] is equivalent to a requirement of an asserted claim if a person of ordinary skill in the field would think that the differences between the [[part] [step]] and the requirement were not substantial as of the time of the alleged infringement. One way to decide whether any difference between a requirement of an asserted claim and a [[part] [step]] of the [[product] [method]] is not substantial is to consider whether, as of the time of the alleged infringement, the [[part] [step]] of the [[product] [method]] performed substantially the same function, in substantially the same way, to achieve substantially the same result as the requirement in the patent claim.

In deciding whether any difference between a claim requirement and the [[product] [method]] is not substantial, you may consider whether, at the time of the alleged infringement, persons of ordinary skill in the field would have known of the interchangeability of the [[part] [step]] with the claimed requirement. The known interchangeability between the claim requirement and the [[part] [step]] of the [[product] [method]] is not necessary to find infringement under the doctrine of equivalents. The same [[element] [method step]] of the accused [[product] [method]] may satisfy more than one element of a claim.

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<sup>3</sup> In cases where the patentee is unable to determine the process by which the product at issue is made, and the prerequisites of 35 U.S.C. § 295 are satisfied, the presumption of Section 295 may also need to be included in this instruction, requiring the accused infringer to rebut a presumption that the product was made by the patented process.

*Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17 (1997); *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609 (1950); *Johnson & Johnson Assoc. v. R.E. Service Co.*, 285 F.3d 1046 (Fed. Cir. 2002) (en banc); *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1480 (Fed. Cir. 1998); *Dolly, Inc. v. Spalding & Evenflo Cos.*, 16 F.3d 394, 397 (Fed. Cir. 1994).

### **3.14 Limitations on the Doctrine of Equivalents – Prior Art**

You may not find that a component in [the Defendant]'s [[product] [method]] is equivalent to an element of the patent claim if by doing so the patent claim would cover [[products] [methods]] that were already in the prior art.

*Conroy v. Reebok Int'l, Ltd.*, 14 F.3d 1570, 1576-77 (Fed. Cir. 1994); *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677 (Fed. Cir. 1990).

### **3.15 Limitations on the Doctrine of Equivalents – Prosecution History Estoppel**

You are instructed that the doctrine of equivalents is limited by what is called “prosecution history estoppel.” As you have already heard, during prosecution of the patent, the patent applicant often makes arguments and amendments in an attempt to convince the PTO examiner to grant the patent. The party seeking to obtain a patent may amend his patent claims or submit arguments in order to define or narrow the meaning of the claims to obtain the patent. Once it has done so, it is not entitled to patent coverage under the doctrine of equivalents that would be so broad that it would cover the same feature that was used to distinguish the invention during the prosecution of the patent.

In this case, you are instructed that prosecution history estoppel applies and the doctrine of equivalents analysis cannot be applied to the following elements of the asserted claims:

[LIST ELEMENTS ON A CLAIM BY CLAIM BASIS]

Unless each of these elements is literally present within [the Defendant's] [[product] [method]], there can be no infringement of the claim.

[THE ABOVE INSTRUCTION ASSUMES PROSECUTION HISTORY ESTOPPEL APPLIES, THAT THE AMENDMENT WAS MADE FOR REASONS RELATED TO PATENTABILITY, AND THAT THE COURT HAS DETERMINED THAT THE PRESUMPTION OF SURRENDER OF EQUIVALENTS HAS NOT BEEN REBUTTED]. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 152 L. Ed. 2d 944, 122 S. Ct. 1831 (2002); *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 334 F.3d 1359 (Fed. Cir. 2003) (en banc). *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17 (1997).

### **3.16 Limitations on the Doctrine of Equivalents – Subject Matter Dedicated to the Public**

When a patent discloses subject matter but does not claim it, the patent has dedicated that unclaimed subject matter to the public. If you find that [the patent] discloses, but does not claim, subject matter alleged to be equivalent to an element of the patent claim, then you cannot find

that the [[component] [step]] alleged to be equivalent in [the Defendant's] [[product] [method]] is equivalent to that element of the patent claim. This is true even if the failure to claim the subject matter was wholly unintentional. The subject matter disclosed and not claimed must be of such specificity that one of ordinary skill in the art could identify the subject matter that had been disclosed and not claimed.

*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 (Fed. Cir. 2004); *Johnson & Johnston Assocs. Inc. v. R.E. Serv. Co.*, 285 F.3d 1046, 1054-55 (Fed. Cir. 2002) (en banc).

#### **4. Summary of Invalidity Defense**

[The Defendant] contends that the asserted claim[s] of the patent[s]-in-suit are invalid. [The Defendant] has the burden of proving by clear and convincing evidence that each claim is invalid.

Claims of an issued patent may be found to be invalid. Thus, you must determine whether each of [the Plaintiff's] claims is invalid.

[The Defendant] contends that all of the asserted patent claims are invalid for the following reasons:

[Insert invalidity contentions]

I will now instruct you in more detail why [the Defendant] alleges that the asserted claim[s] of the [abbreviated patent numbers] is/are invalid.

#### **5. Prior Art Defined**

Prior art includes any of the following items received into evidence during trial:

1. any [product] [method] that was publicly known or used in the United States by a person other than the inventor of the patent in suit before [the patented invention - was made];
2. patents or printed publications by anyone that issued or were published before [one year before the effective filing date];
3. patents, published patent applications, or printed publications by a person other than the inventor of the patent in suit that issued or published before [the patented invention was made];
4. any [product] [method] that was in public use or on sale in the United States more than-one year before [effective filing date];
5. patents filed by a person other than the inventor of the patent before [the date of invention] regardless of when the patent issued;

6. any [product] [method] that was made by a person other than the inventor of the patent before the named inventors created the patented [product] [method] where the [product] [method] was not abandoned, suppressed, or concealed.

[ADD ANY ADDITIONAL TYPES OF PRIOR ART]

In this case, [the Defendant] contends that the following items are prior art: [identify prior art by name]

35 U.S.C. § 102.

## **Anticipation**

### **6.0 Anticipation**

A person cannot obtain a patent if someone else already has made an identical invention. Simply put, the invention must be new. An invention that is not new or novel is said to be “anticipated by the prior art.” Under the U.S. patent laws, an invention that is “anticipated” is not entitled to patent protection. To prove anticipation, [the Defendant] must show that the claimed invention is not new.

In this case, [the Defendant] contends that the claims of the [abbreviated patent number] patent are anticipated. [DESCRIBE BRIEFLY EACH BASIS FOR THE DEFENDANT'S INVALIDITY DEFENSE, FOR EXAMPLE: “First, [the Defendant] contends that the invention of claims 1, 2, and 3 of the \_\_\_\_ patent was described in the July, 1983 article published by Jones in THE JOURNAL OF ENDOCRINOLOGY.”]

To anticipate a claim, each and every element in the claim must be present in a single item of prior art. You may not combine two or more items of prior art to prove anticipation. In determining whether every one of the elements of the claimed invention is found in the prior [[publication] [patent] [etc.]], you should take into account what a person of ordinary skill in the art would have understood from his or her examination of the particular [[publication] [patent] [etc.]].

In determining whether the single item of prior art anticipates a patent claim, you should take into consideration not only what is expressly disclosed in the particular item of prior [[publication] [invention] [etc.]], but also what inherently featured in or resulted from a natural result of its practice. This is called “inherency.” A party claiming inherency must prove it by clear and convincing evidence. To establish inherency, the evidence must make clear that prior art either necessarily featured or resulted in the missing descriptive matter and that it would be so recognized by persons of ordinary skill in the art. Inherent anticipation, however, does not require that a person of ordinary skill in the art at the time the patent application was filed would have recognized the inherent disclosure. Thus, the prior use of the patented invention that was accidental, or unrecognized and unappreciated can still be an invalidating anticipation.

You must keep these requirements in mind and apply them to each kind of anticipation you consider in this case. There are additional requirements that apply to the particular

categories of anticipation that [the Defendant] contends apply in this case. I will now instruct you about those.

*In re Omeprazole Patent Litigation*, 483 F.3d 1364 (Fed. Cir. 2007); *Abbott Labs. v. Baxter Pharm. Prods., Inc.*, 471 F.3d 1363 (Fed. Cir. 2006); *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368 (Fed. Cir. 2005); *Toro Co. v. Deere & Co.*, 355 F.3d 1313 (Fed. Cir. 2004); *Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373 (Fed. Cir. 2003); *Mycogen Plant Sci., Inc. v. Monsanto Co.*, 243 F.3d 1316 (Fed. Cir. 2001); *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999); *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342 (Fed. Cir. 1999); *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550 (Fed. Cir. 1995); *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559 (Fed. Cir. 1992); *Standard Havens Prods., Inc. v. Gencor Indus., Inc.*, 953 F.2d 1360 (Fed. Cir. 1991); *Cont'l Can Co. USA v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560 (Fed. Cir. 1988); *Buildex, Inc. v. Kason Indus., Inc.*, 849 F.2d 1461 (Fed. Cir. 1988); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628 (Fed. Cir. 1987); *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, *modified on reh'g*, 804 F.2d 135 (Fed. Cir. 1986); *Tyler Refrigeration v. Kysor Indus. Corp.*, 777 F.2d 687 (Fed. Cir. 1985); *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613 (Fed. Cir. 1985); *Lindemann Maschinenfabrik GmbH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983); *WL Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983); *SSIH Equip. S.A. v. U.S. Int'l Trade Comm'n*, 718 F.2d 365 (Fed. Cir. 1983); *In re Marshall*, 578 F.2d 301 (C.C.P.A. 1978); *In re Felton*, 484 F.2d 495 (C.C.P.A. 1973); *HK Regar & Sons v. Scott & Williams, Inc.*, 63 F.2d 229 (2d Cir. 1933); *Hughes Aircraft Co. v. United States*, 8 U.S.P.Q.2d 1580 (Ct. Cl. 1988).

## **6.1 Date of Invention**

### ***(Alternate A)***

Several of the particular categories of anticipation that [the Defendant] contends apply in this refer to the date the patentee made the invention. This is called the “date of invention.”

In this case, the date of invention is \_\_\_\_\_.

### ***(Alternate B)***

In this case, there is a dispute between the parties regarding when the patentee made the invention. You must decide the date the invention was made by a preponderance of the evidence. There are two basic concepts that underlie your decision on this question.

### ***(continuing)***

First, I will address the concept of “conception.” Conception is the mental part of an inventive act, i.e., the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice. Conception of an invention is complete when the idea is so clearly defined in then inventor's mind that a person of ordinary skill in the field of the technology would be able to reduce the invention to practice without extensive research or experimentation. Conception may be proven when the invention is

shown in its complete form by drawings, disclosure to another person, or other forms of evidence presented at trial.

Second, a claimed invention is “reduced to practice” when it has been tested sufficiently to show that it will work for its intended purpose. An invention may be reduced to practice even if the inventor has not made or tested a prototype of the invention. The invention may be reduced to practice by being fully described in a filed patent application.

In order for an invention to have been made, it must have been conceived and reduced to practice. In this case, you must determine a date of [conception] [and/or] [reduction to practice] for the [claimed invention] [and/or] [prior invention] in order to decide whether or not the [alleged infringer] has shown that a patent claim was not new. In addition to conception and reduction to practice, the inventor must exercise diligence in moving his invention toward the filing of a patent application. If you do not find that the invention was conceived and reduced to practice before the filing date of the application, or if you find that it was but that the inventor failed to file the patent application diligently, then you must find that the date of invention is the date that the application for patent was filed.

## 6.2 Prior Public Knowledge

[The Defendant] contends that claim \_\_\_\_\_ of the [abbreviated patent number] patent was anticipated because the invention defined in that claim was publicly known by others in the United States before it was invented by the inventor(s).

[IF THERE IS A FACTUAL ISSUE TO BE RESOLVED BY THE JURY AS TO THE DATE OF INVENTION OF THE PATENT CLAIMS IN SUIT, THE JURY SHOULD BE INSTRUCTED HERE AS TO HOW THEY SHOULD DETERMINE THAT DATE OF INVENTION. OTHERWISE, THE COURT SHOULD INSTRUCT THE JURY AS FOLLOWS: “You are instructed that the invention defined by claim \_\_\_\_ of the [abbreviated patent number] patent was invented on [invention date].”]

A patent claim is invalid if the invention defined in that claim was publicly known by a person other than [the patentee] in the United States before it was invented by [the patentee]. Public knowledge by a third party is not public.

Oral testimony of prior public knowledge must be corroborated in order to invalidate a patent. The most reliable evidence of corroboration comes from documentary or physical evidence that was made contemporaneously with the alleged prior public knowledge.

35 U.S.C. § 102(a); *Ormco Corp. v. Allesee Orthodontic Appliances, Inc.*, 463 F.3d 1299 (Fed. Cir. 2006); *Juicy Whip, Inc. v. Orange Bang, Inc.*, 292 F.3d 728 (Fed. Cir. 2004); *Vulcan Eng'g Co. v. FATA Aluminum, Inc.*, 278 F.3d 1366, 1372-73 (Fed. Cir. 2002); *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1371 (Fed. Cir. 1998); *Rosemount, Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540 (Fed. Cir. 1984); *Trend Prods. Co. v. Metro Indus., Inc.*, 10 U.S.P.Q. 2d 1531 (C.D. Cal. 1989).

### 6.3 Prior Public Use

[The Defendant] contends that claim \_\_\_\_\_ of the [abbreviated patent number] patent was anticipated because the invention defined in that claim [was publicly used by others in the United States before it was invented by [the patentee]] [was publicly used in the United States more than one year before [the patentee] filed his patent application on [effective filing date]].

[IF THERE IS A FACTUAL ISSUE TO BE RESOLVED BY THE JURY AS TO THE DATE OF INVENTION OF THE PATENT CLAIMS IN SUIT, THE JURY SHOULD BE INSTRUCTED HERE AS TO HOW THEY SHOULD DETERMINE THAT DATE OF INVENTION. OTHERWISE, THE COURT SHOULD INSTRUCT THE JURY AS FOLLOWS: “You are instructed that the invention defined by claim \_\_\_\_ of the [abbreviated patent number] patent was invented on [invention date].”]

A patent claim is invalid if the invention defined in that claim [was publicly used by a person other than [the patentee] in the United States before it was invented by [the patentee]] [was publicly used by anyone in the United States more than one year before the effective filing date of [the patentee's] patent application]. An invention is publicly used if it is used by the inventor or by a person who is not under any limitation, restriction, or obligation of secrecy to the inventor. Public use means the absence of affirmative steps to conceal. However, secret use by a third party is not public. If the public use was an experimental use performed in order to bring the invention to perfection or to determine if the invention was capable of performing its intended purpose then such a use does not invalidate the claim.

Oral testimony of prior public use must be corroborated in order to invalidate a patent. The most reliable evidence of corroboration comes from documentary or physical evidence that was made contemporaneously with the alleged prior public use.

35 U.S.C. § 102(a), (b); *Ormco Corp. v. Allesee Orthodontic Appliances, Inc.*, 463 F.3d 1299 (Fed. Cir. 2006); *SmithKline Beecham Corp. v. Apotex Corp.*, 365 F.3d 1306 (Fed. Cir. 2004); *Netscape Commc'ns Corp. v. Konrad*, 295 F.3d 1315 (Fed. Cir. 2002); *Juicy Whip, Inc. v. Orange Bang, Inc.*, 292 F.3d 728 (Fed. Cir. 2004); *EZ Dock, Inc. v. Schafer Sys. Inc.*, 276 F.3d 1347 (Fed. Cir. 2002); *Grain Processing Corp. v. Am. Maize-Prods. Co.*, 840 F.2d 902 (Fed. Cir. 1988); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261 (Fed. Cir. 1986); *JA LaPorte, Inc. v. Norfolk Dredging Co.*, 787 F.2d 1577 (Fed. Cir. 1986); *In re Caveney*, 761 F.2d 671 (Fed. Cir. 1985); *Kinzenbaw v. Deere & Co.*, 741 F.2d 383 (Fed. Cir. 1984); *TP Lab., Inc. v. Prof'l Positioners, Inc.*, 724 F.2d 965 (Fed. Cir. 1984); *WL Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983); *DL Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144 (Fed. Cir. 1983); *In re Smith*, 714 F.2d 1127 (Fed. Cir. 1983); *Honeywell, Inc. v. Sperry Rand Corp.*, 180 U.S.P.Q. 673 (D. Minn. 1973).

### 6.4 On Sale Bar

[The Defendant] contends that claim \_\_\_\_\_ of the [abbreviated patent number] patent was anticipated because the invention defined in that claim was on sale in the United

States more than one year before [the patentee] filed his U.S. patent application on [U.S. filing date].

A patent claim is invalid if an embodiment of the claimed invention was both (1) subject to commercial offer for sale in the United States; and (2) ready for patenting more than one year before the patent application date.

An invention was “on sale” if the claimed invention was embodied in the thing sold or commercially offered for sale. It is not required that a sale was actually made. The essential question is whether or not there was an attempt to obtain commercial benefit from the invention.

In order to be on sale, the invention must have been ready for patenting at the time of the alleged offer for sale is made. An invention is ready for patenting either when it is reduced to practice or when the inventor has prepared drawings or other descriptions of the invention sufficient to allow a person of ordinary skill in the art to make or use the invention. The claimed invention is reduced to practice when there is reason to believe it would work for its intended purpose.

In certain circumstances, the sale or offer for sale of the claimed invention more than one year before the filing date of a patent may not invalidate a patent claim. This occurs when the sale or offer for sale was for experimental rather than commercial purposes.

To be considered experimental, the sale or offer for sale must be by the patentee or patent owner, must relate to the claimed features of the invention and must be for the purpose of further development of the invention.

However, the experimental use exception does not apply if the invention has been reduced to practice.

In this case, [patent owner] asserts that its [sale/offer for sale] of \_\_\_\_\_ was experimental use and, therefore, does not invalidate the [claims] of the [abbreviated patent number] patent.

35 U.S.C. § 102; *Pfaff v. Wells Elecs.*, 525 U.S. 55 (1998); *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336 (Fed. Cir. 2002); *Linear Tech. Corp. v. Micrel, Inc.*, 275 F.3d 1040 (Fed. Cir. 2001); *Group One, Ltd. v. Hallmark Cards, Inc.*, 254 F.3d 1041 (Fed. Cir. 2001); *Keystone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444 (Fed. Cir. 1993); *Sonoscan, Inc. v. Sonotek, Inc.*, 936 F.2d 1261 (Fed. Cir. 1991); *Buildex, Inc. v. Kason Indus., Inc.*, 849 F.2d 1461 (Fed. Cir. 1988); *AB Chance Co. v. RTE Corp.*, 854 F.2d 1307 (Fed. Cir. 1988); *Great N. Corp. v. Davis Core & Pad Co.*, 782 F.2d 159 (Fed. Cir. 1986); *JA LaPorte, Inc. v. Norfolk Dredging Co.*, 787 F.2d 1577 (Fed. Cir. 1986); *DL Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144 (Fed. Cir. 1983); *In re Brigance*, 792 F.2d 1103 (Fed. Cir. 1986); *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853 (Fed. Cir. 1985); *In re Caveney*, 761 F.2d 671 (Fed. Cir. 1985); *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613 (Fed. Cir. 1985); *W. Marine Elecs., Inc. v. Furuno Elec. Co.*, 764 F.2d 840 (Fed. Cir. 1985); *Barmag Barmer Maschinenfabrik AG v. Murata Mach. Ltd.*, 731 F.2d 831 (Fed. Cir. 1984); *Pennwalt Corp. v. Akzona, Inc.*, 740 F.2d 1573 (Fed. Cir. 1984); *Crane Co. v. Goodyear Tire & Rubber Co.*, 577 F. Supp. 186 (N.D. Ohio 1983).

## 6.5 Experimental Use

[The Plaintiff] contends that \_\_\_\_\_ should not be considered [[a prior public use of the invention] [placing the invention on sale]] because that [[use] [sale]] was experimental. The law recognizes that the inventor must be given the opportunity to develop the invention through experimentation. Certain activities are experimental if they are a legitimate effort to perfect the invention or to determine if the invention will work for its intended purpose. So long as the primary purpose is experimentation, it does not matter that the public used the invention or that the inventor incidentally derived profit from it. If you find that [the Defendant] has shown a [[prior public use] [prior sale]] by clear and convincing evidence, then the burden is on [the Plaintiff] to come forward with evidence showing that the purpose of [[the prior public use] [prior sale]] was experimental.

Only experimentation by or under the control of the inventor of the patent [or his assignee] qualifies for this exception. Experimentation by [third party], for its own purposes, does not. The experimentation must relate to the features of the claimed invention, and it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is not an experimental use, but a public use.

*City of Elizabeth v. American Nicholson Pavement Co.*, 97 U.S. 126 (1877); *DL Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 219 U.S.P.Q. 13 (Fed. Cir. 1983); *TP Lab., Inc. v. Professional Positioners, Inc.*, 724 F.2d 965, 220 U.S.P.Q. 577 (Fed. Cir.), *cert. denied*, 469 U.S. 826, 224 U.S.P.Q. 616 (1984); *Pennwalt Corp. v. Akzona, Inc.*, 740 F.2d 1573, 222 U.S.P.Q. 833 (Fed. Cir. 1984); *In re Smith*, 714 F.2d 1127, 218 U.S.P.Q. 976 (Fed. Cir. 1983); *In re Theis*, 610 F.2d 786, 204 U.S.P.Q. 188 (C.C.P.A. 1979); *Manville Sales Corp. v. Paramount Sys., Inc.*, 917 F.2d 544, 16 U.S.P.Q.2d 1587 (Fed. Cir. 1990); *Grain Processing Corp. v. American Maize- Prods. Co.*, 840 F.2d 902, 5 U.S.P.Q.2d 1788 (Fed. Cir. 1988); *U.S. Envtl. Prods., Inc. v. Westall*, 911 F.2d 713, 15 U.S.P.Q.2d 1898 (Fed. Cir. 1990); *Hycor Corp. v. Schlueter Co.*, 740 F.2d 1529, 222 U.S.P.Q. 553 (Fed. Cir. 1984); *LaBounty Mfg., Inc. v. U.S. Int'l Trade Comm'n*, 958 F.2d 1066, 22 U.S.P.Q.2d 1025 (Fed. Cir. 1992); *In re Hamilton*, 882 F.2d 1576, 11 U.S.P.Q.2d 1890 (Fed. Cir. 1989); *Allen Eng'g Corp. v. Bartell Indus.*, 299 F.3d 1336, 63 U.S.P.Q.2d 1769 (Fed. Cir. 2002).

## 6.6 Printed Publication

[The Defendant] contends that claim \_\_\_\_\_ of the [abbreviated patent number] patent was anticipated because the invention defined in that claim was described in a printed publication [more than one year before [[[the patentee] filed the U.S. patent application on [U.S. filing date]]] [[the patentee] invented the invention]].

A patent claim is invalid if the invention defined by that claim was described in a printed publication [[before it was invented by [the patentee]] [more than one year prior to the filing date of the U.S. application]].

A printed publication must be reasonably accessible to those members of the public who would be interested in its contents. It is not necessary that the printed publication be available to every member of the public. The information must, however, have been maintained in some form, such as [[printed pages] [typewritten pages] [magnetic tape] [microfilm] [photographs] [photocopies]]. An issued patent is a printed publication. A published patent application is a printed publication as of its publication date.

For a printed publication to anticipate a patent claim, it must, when read by a person of ordinary skill in the art, expressly or inherently disclose each element of the claimed invention to the reader. The disclosure must be complete enough to enable one of ordinary skill in the art to practice the invention without undue experimentation. In determining whether the disclosure is enabling, you should take into account what would have been within the knowledge of a person of ordinary skill in the art [[one year before the application for the [abbreviated patent number] patent was filed] [at the time the invention of the [abbreviated patent number] patent was made]], and you may consider evidence that sheds light on the knowledge such a person would have had.

35 U.S.C. § 102; *In re Carol F. Klopfenstein*, 380 F.3d 1345, 1352 (Fed. Cir. 2004); *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550 (Fed. Cir. 1995); *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. ), *clarif. on recon.*, 927 F.2d 1565 (Fed. Cir. 1991); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560 (Fed. Cir. 1988); *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471 (Fed. Cir. 1986); *In re Hall*, 781 F.2d 897 (Fed. Cir. 1986); *In re Donohue*, 766 F.2d 531 (Fed. Cir. 1985); *Studiengesellschaft Kohle mbH v. Dart Indus., Inc.*, 726 F.2d 724 (Fed. Cir. 1984); *In re Wyer*, 655 F.2d 221 (C.C.P.A. 1981); *In re Donohue*, 632 F.2d 123 (C.C.P.A. 1980); *In re Samour*, 571 F.2d 559 (C.C.P.A. 1978); *In re Coker*, 463 F.2d 1344 (C.C.P.A. 1972); *Deep Welding, Inc. v. Sciaky Bros., Inc.*, 417 F.2d 1227 (7th Cir. 1969); *Phillips Petroleum Co. v. Ladd*, 219 F. Supp. 366 (D.D.C. 1963); *Garrett Corp. v. United States*, 422 F.2d 874 (Ct. Cl. 1970); *Honeywell, Inc. v. Sperry Rand Corp.*, 180 U.S.P.Q. 673 (D. Minn. 1973); *Tyler Refrigeration Corp. v. Kysor Indus. Corp.*, 553 F. Supp. 279 (D. Del. 1982).

## 6.7 Prior Invention<sup>4</sup>

[The Defendant] contends that claim \_\_\_\_\_ of the [abbreviated patent number] patent was anticipated because the invention defined in that claim was invented by another person, [third party], before [the patentee] invented his invention.

A patent claim is invalid if the invention defined by that claim was invented by another person in the United States before it was invented by the patentee[, and that other person did not abandon, suppress, or conceal the invention].

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<sup>4</sup> In cases where priority of invention is an issue to be submitted to the jury, further instructions will be required. For example, the jury will need to consider not only the dates when the respective inventions were conceived, but also when the inventions were reduced to practice. An inventor who claims to be the first to conceive of a prior invention but was the last to reduce to practice must also show reasonable diligence from a time just before the other party entered the field until his own reduction to practice in order for the "prior invention" to anticipate the claimed invention in suit.

[The Defendant] must show by clear and convincing evidence *either* that before [the patentee] invented his invention, [third party] reduced to practice a [[product] [method]] that included all of the elements of claim \_\_\_\_ of the [abbreviated patent number] patent or that [third party] was first to conceive the invention and that he exercised reasonable diligence in later reducing the invention to practice. In addition, [the Defendant] must show that [third party]'s device was sufficiently developed that one skilled in the art would have recognized that it would work for its intended purpose.

[If the prior invention was abandoned, suppressed, or concealed, it does not anticipate the [abbreviated patent number] patent. However, it is not necessary that [the patentee] had knowledge of that prior invention.<sup>5</sup>

Generally, an invention was not abandoned, suppressed, or concealed if the invention was made public, sold, or offered for sale, or otherwise used for a commercial purpose. A period of delay does not constitute abandonment, suppression, or concealment if the prior inventor was engaged in reasonable efforts to bring the invention to market.]

35 U.S.C. § 102; *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373 (Fed. Cir. 2002); *Monsanto Co. v. Mycogen Plant Sci., Inc.*, 261 F.3d 1356 (Fed. Cir. 2001); *Apotex USA, Inc. v. Merck & Co.*, 254 F.3d 1031 (Fed. Cir. 2001); *RCA Corp. v. Data Gen. Corp.*, 887 F.2d 1056 (Fed. Cir. 1989); *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430 (Fed. Cir. 1988); *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437 (Fed. Cir. 1984); *Gen. Motors Corp. v. Toyota Motor Co.*, 467 F. Supp. 1142 (S.D. Ohio 1979), *aff'd in part & rev'd in part*, 667 F.2d 504 (6th Cir. 1981).

## 6.8 Prior Patent

[The Defendant] contends that claim \_\_\_\_\_ of the [abbreviated patent number] patent was anticipated because the invention defined in that claim was patented by [third party] [[before it was invented by [the patentee]] [more than one year before [the patentee] filed his United States patent application on [U.S. filing date]].

A patent claim is invalid if the invention defined by that claim was patented in the United States or a foreign country [[before it was invented by [the patentee]] [more than one year before [the patentee] filed his United States patent application]].

To show anticipation of the patented invention, [the Defendant] must show by clear and convincing evidence that before [critical date], [third party] patented an invention that included all of the elements of claim \_\_\_\_\_ of the [abbreviated patent number] patent.

35 U.S.C. § 102; *In re Monks*, 588 F.2d 308 (C.C.P.A. 1978); *In re Fuge*, 272 F.2d 954 (C.C.P.A. 1959); *In re Ekenstam*, 256 F.2d 321 (C.C.P.A. 1958); *Bendix Corp. v. Balax, Inc.*, 421 F.2d 809 (7th Cir. 1970).

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<sup>5</sup> If abandonment, suppression or concealment are at issue in the case, these terms should be defined for the jury. See *Checkpoint Sys., Inc. v. United States Int'l Trade Comm'n*, 54 F.3d 756 (Fed. Cir. 1995); *Dow Chem. Co. v. Astro-Valcour Inc.*, 267 F.3d 1334 (Fed. Cir. 2001).

## 6.9 Prior U.S. Application

[The Defendant] contends that claim \_\_\_\_\_ of the [abbreviated patent number] patent was anticipated because the invention defined in that claim was described in United States patent [anticipating patent number], and because the application for the [anticipating patent] was filed before [the patentee] made his invention.

A claim of the [abbreviated patent number] patent would be invalid if the invention defined by that claim was described in a United States patent issued on a patent application filed by another person before the invention was made by [the patentee].

To show anticipation of the patented invention, [the Defendant] must show by clear and convincing evidence that the application for the [anticipating patent number] patent described each and every element of claim \_\_\_\_\_ of the [abbreviated patent number] patent and that the specification, claims, and/or drawings of the application for the [anticipating patent number] patent was filed before the date of invention of the [abbreviated patent number] patent.

35 U.S.C. § 102(e); *Sun Studs, Inc. v. ATA Equip. Leasing, Inc.*, 872 F.2d 978 (Fed. Cir. 1989); *In re Wertheim*, 646 F.2d 527 (C.C.P.A. 1981).

## Obviousness

### 7.0 Obviousness

[The Defendant] contends that claim(s) [numbers] of the [abbreviated patent number] patent are invalid because the claimed invention(s) were “obvious.”

A claimed invention is invalid as “obvious” if it would have been obvious to a person of ordinary skill in the art of the claimed invention at the time the invention was made. 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.

The following factors must be evaluated to determine whether [the Defendant] has established that the claimed inventions are obvious:

1. the scope and content of the prior art relied upon by [the Defendant];
2. the difference or differences, if any, between each claim of the [abbreviated patent number] patent that [the Defendant] contends is obvious and the prior art;
3. the level of ordinary skill in the art at the time the invention of the [abbreviated patent number] patent was made; and
4. additional considerations, if any, that indicate that the invention was obvious or not obvious.

Each of these factors must be evaluated, although they may be analyzed in any order, and you must perform a separate analysis for each of the claims.

[The Defendant] bears the burden of proving obviousness by clear and convincing evidence.

I will now explain each of the four factors in more detail.

*KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 694 (1966); *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161-62 (Fed. Cir. 2007); *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 662-63 (Fed. Cir. 2000); *Arkies Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 955 (Fed. Cir. 1997); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 716 (Fed. Cir. 1991); *Nutrition 21 v. U.S.*, 930 F.2d 867, 871 n.2 (Fed. Cir. 1991); *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 764 (Fed. Cir. 1988); *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 718-19 (Fed. Cir. 1984); *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1382-83 (Fed. Cir. 1983); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-40 (Fed. Cir. 1983).

### **7.1 Scope and Content of the Prior Art**

The prior art that you considered previously for anticipation purposes is also prior art for obviousness purposes. The prior art includes the following items received into evidence during the trial:

[LIST PRIOR ART STIPULATED TO BY THE PARTIES].

[IF PARTIES DISPUTE THE PRIOR ART, USE THE FOLLOWING]. You must determine what is the prior art that may be considered in determining whether the [abbreviated patent number] patent is obvious. A prior art reference may be considered if it discloses information designed to solve the same problem(s) faced by the inventor(s) or if the reference discloses information that has obvious uses beyond its main purpose that a person of ordinary skill in the art would reasonably examine to solve the same problem(s) faced by the inventor(s).

*KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742 (2007); *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664-65 (Fed. Cir. 2000); *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 864 (Fed. Cir. 1993); *In re Clay*, 966 F.2d 656, 658-59 (Fed. Cir. 1992); *In re Wood*, 599 F.2d 1032, 1036-37 (C.C.P.A. 1979).

### **7.2 Analogous Art**

[The Plaintiff] and [the Defendant] disagree as to whether the [alleged analogous art] is analogous prior art.

An item of prior art is analogous if it comes from the same field in which [the patentee] was working, even if it does not concern the problem [the patentee] was addressing. An item of prior art is also analogous even if it was not from the same field in which [the patentee] was working, so long as it was reasonably pertinent to the particular problem that [the patentee] was trying to solve.

If you determine that the [disputed reference] is not analogous art, then you should ignore it in deciding whether the claimed invention would have been obvious.

*In re Wood*, 599 F.2d 1032, 202 U.S.P.Q. 171 (C.C.P.A. 1979); *Wang Lab., Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 U.S.P.Q.2d 1767 (Fed. Cir. 1993); *In re Clay*, 966 F.2d 656, 23 U.S.P.Q.2d 1058 (Fed. Cir. 1992); *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 57 U.S.P.Q.2d 1161 (Fed. Cir. 2000).

### **7.3 Publication**

[The Plaintiff] and [the Defendant] dispute whether the [alleged prior publication] was published before [priority/critical date].

To determine whether this reference was published before [priority/critical date], you must determine whether it was reasonably accessible to those who would be interested in its contents. It is not necessary that the reference be available to every member of the public. So long as it was reasonably accessible to those of ordinary skill in the art, the form in which the information was recorded is unimportant. The information must, however, have been maintained in some permanent form, such as [[printed pages] [typewritten pages] [magnetic tape] [microfilm] [photographs] [photocopies]].

If you decide that the [alleged prior publication] was not published prior to [priority/critical date], then you may not consider it in deciding the issue of obviousness.

*In re Carol F. Klopfenstein*, 380 F.3d 1345, 1352 (Fed. Cir. 2004); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 U.S.P.Q.2d 1057 (Fed. Cir.), *cert. denied*, 488 U.S. 892 (1988); *In re Hall*, 781 F.2d 897, 228 U.S.P.Q. 453 (Fed. Cir. 1986); *In re Wyer*, 655 F.2d 221, 210 U.S.P.Q. 790 (C.C.P.A. 1981); *Deep Welding, Inc. v. Sciaky Bros., Inc.*, 417 F.2d 1227, 163 U.S.P.Q. 144 (7th Cir. 1969), *cert. denied*, 397 U.S. 1037 (1970); *Garrett Corp. v. United States*, 422 F.2d 874, 164 U.S.P.Q. 521 (Ct. Cl.), *cert. denied*, 400 U.S. 951 (1970); *Honeywell, Inc. v. Sperry Rand Corp.*, 180 U.S.P.Q. 673 (D. Minn. 1973); *Tyler Refrigeration Corp. v. Kysor Indus. Corp.*, 553 F. Supp. 279, 220 U.S.P.Q. 1033 (D. Del. 1982).

### **7.4 On Sale Bar**

[The Plaintiff] and [the Defendant] dispute whether the [alleged device on sale] was on sale prior to [critical date].

The on-sale bar applies if (1) an embodiment of the patent is the subject of a commercial offer for sale more than one year before the patent application date; and (2) the invention was ready for patenting at that time. A device was "on sale," if that device was embodied in the thing sold or commercially offered for sale. It is not required that a sale was actually made. The essential question is whether or not there was an attempt to obtain commercial benefit.

In order to be on sale, at the time of the offer for sale the invention must have been ready for patenting. The claimed invention is ready for patenting when it has been reduced to practice or the inventor has prepared drawings or other descriptions of the invention that are sufficiently specific to enable a person skilled in the art to practice the invention.

[IF INSTRUCTIONS AS TO PRIOR PUBLIC KNOWLEDGE OR PRIOR PUBLIC USE ARE REQUIRED FOR CONSIDERATION OF AN OBVIOUSNESS DEFENSE, ANTICIPATION INSTRUCTIONS NOS. 2 AND 3 CAN BE USED FOR THESE PURPOSES.]

If you decide the [alleged device on sale] was not on sale prior to [critical date], then you may not consider it in deciding the issue of obviousness.

*Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55 (1998); *Barmag Barmer Maschinenfabrik AG v. Murata Mach. Ltd.*, 731 F.2d 831, 221 U.S.P.Q. 561 (Fed. Cir. 1984); *In re Caveney*, 761 F.2d 671, 226 U.S.P.Q. 1 (Fed. Cir. 1985); *DL Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 210 U.S.P.Q. 13 (Fed. Cir. 1983); *Pennwalt Corp. v. Akzona, Inc.*, 740 F.2d 1573, 222 U.S.P.Q. 833 (Fed. Cir. 1984); *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 225 U.S.P.Q. 634 (Fed. Cir.); *In re Theis*, 610 F.2d 786, 204 U.S.P.Q. 188 (C.C.P.A. 1979); *Buildex, Inc. v. Kason Indus., Inc.*, 849 F.2d 1461, 7 U.S.P.Q.2d 1325 (Fed. Cir. 1988); *AB Chance Co. v. RTE Corp.*, 854 F.2d 1307, 7 U.S.P.Q.2d 1881 (Fed. Cir. 1988); *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 226 U.S.P.Q. 402 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1016 (1986); *Keystone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 27 U.S.P.Q.2d 1297 (Fed. Cir. 1993); *Special Devices, Inc. v. OEA, Inc.*, 270 F.3d 1353, 60 U.S.P.Q.2d 1537 (Fed. Cir. 2001); *Group One, Ltd. v. Hallmark Cards, Inc.*, 254 F.3d 1041, 59 U.S.P.Q.2d 1121 (Fed. Cir. 2001).

## **7.5 Differences Between the Claimed Invention and the Prior Art**

You should analyze whether there are any relevant differences between the prior art and the claimed invention from the view of a person of ordinary skill in the art at the time of the invention. Your analysis must determine the impact, if any, of any such differences on the obviousness or nonobviousness of the invention as a whole, and not merely some portion of it.

In analyzing the relevance of the differences between the claimed invention and the prior art, you do not need to look for precise teaching in the prior art directed to the subject matter of the claimed invention. You may take into account the inferences and creative steps that a person of ordinary skill in the art would have employed in reviewing the prior art at the time of the invention. For example, if the claimed invention combined elements known in the prior art and the combination yielded results that were predictable to a person of ordinary skill in the art at the time of the invention, then this evidence would make it more likely that the claim was obvious. On the other hand, if the combination of known elements yielded unexpected or unpredictable results, or if the prior art teaches away from combining the known elements, then this evidence would make it more likely that the claim that successfully combined those elements was not obvious.

Importantly, a claim is not proved obvious merely by demonstrating that each of the elements was independently known in the prior art. Most, if not all, inventions rely on building blocks long since uncovered, and claimed discoveries almost of necessity will likely be combinations of what is already known. Therefore, you should consider whether a reason existed at the time of the invention that would have prompted a person of ordinary skill in the art in the relevant field to combine the known elements in the way the claimed invention does. The reason could come from the prior art, the background knowledge of one of ordinary skill in the art, the nature of the problem to be solved, market demand, or common sense.

If you find that a reason existed at the time of the invention to combine the elements of the prior art to arrive at the claimed invention, this evidence would make it more likely that the claimed invention was obvious.

Again, you must undertake this analysis separately for each claim that [the Defendant] contends is obvious.

*KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742-43 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 694 (1966); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1536-37 (Fed. Cir. 1983); *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567-68 (Fed. Cir. 1983).

## **7.6 Level of Ordinary Skill**

The determination of whether a claimed invention is obvious is based on the perspective of a person of ordinary skill in the [pertinent art field]. The person of ordinary skill is presumed to know all prior art that you have determined to be reasonably relevant. The person of ordinary skill is also a person of ordinary creativity that can use common sense to solve problems.

[IF THE PARTIES HAVE AGREED TO THE LEVEL OF ORDINARY SKILL IN THE ART, THEN THE INSTRUCTION SHOULD INCLUDE: “[The Plaintiff] and [the Defendant] contend that the level of ordinary skill in the art is [insert proposal].”]

[IF THE PARTIES HAVE NOT AGREED TO THE LEVEL OF ORDINARY SKILL IN THE ART, THEN THE INSTRUCTION SHOULD CONTINUE AS FOLLOWS].

When determining the level of ordinary skill in the art, you should consider all the evidence submitted by the parties, including evidence of:

- the level of education and experience of persons actively working in the field at the time of the invention, including the inventor;
- the types of problems encountered in the art at the time of the invention; and
- the sophistication of the technology in the art at the time of the invention, including the rapidity with which innovations were made in the art at the time of the invention

*KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742-43 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 694 (1966); *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 666-67 (Fed. Cir. 2000); *Env'tl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696-97 (Fed. Cir. 1983).

## 7.7 Factors Indicating Nonobviousness

Before deciding the issue of obviousness, you must also consider certain factors which, if established, may indicate that the invention would not have been obvious. No factor alone is dispositive, and you must consider the obviousness or nonobviousness of the invention as a whole.

[USE ONLY THOSE INSTRUCTIONS THAT ARE APPROPRIATE.]

1. Were products covered by the claim commercially successful due to the merits of the claimed invention rather than due to advertising, promotion, salesmanship, or features of the product other than those found in the claim?
2. Was there long felt need for a solution to the problem facing the inventors which was satisfied by the claimed invention?
3. Did others try, but fail, to solve the problem solved by the claimed invention?
4. Did others copy the claimed invention?
5. Did the claimed invention achieve unexpectedly superior results over the closest prior art?
6. Did others in the field, or [the Defendant] praise the claimed invention or express surprise at the making of the claimed invention?
7. Did others accept licenses under [abbreviated patent number] patent because of the merits of the claimed invention?

Answering any, or all, of these questions “yes” may suggest that the claim was not obvious.

*Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 694 (1966); *United States v. Adams*, 383 U.S. 39, 52, 86 S.Ct. 708, 714-15 (1966); *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894-95 (Fed. Cir. 1984); *Env'tl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 697 (Fed. Cir. 1983); *WL Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1555-56 (Fed. Cir. 1983); *Stratoflex, Inc., v. Aeroquip Corp.*, 713 F.2d 1530, 1538-39 (Fed. Cir. 1983).

## 8. Enablement

The written description set forth in a patent must disclose sufficient information to enable or teach one skilled in the field of the invention to make and use the claimed invention. This requirement is known as the enablement requirement. If a patent claim is not enabled, it is invalid.

A patent is enabling if its disclosure is sufficient to enable a person of ordinary skill in the art to make and use the claimed invention without undue experimentation. In considering whether the written description of a patent satisfies the enablement requirement, you must keep in mind that patents are written for persons of skill in the field of the invention. Thus, a patent need not expressly state information that skilled persons would be likely to know or could obtain. [The defendant] bears the burden of establishing lack of enablement by clear and convincing evidence.

[The defendant] contends that claim[s] \_\_\_\_ of the [abbreviated patent number] patent [is][are] invalid for lack of enablement. The fact that some experimentation may be required for a skilled person to practice the claimed invention does not mean that a patent's written description does not meet the enablement requirement. Factors that you may consider in determining whether the written description would require undue experimentation include: (1) the quantity of experimentation necessary; (2) the amount of direction or guidance disclosed in the patent; (3) the presence or absence of working examples in the 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.

*Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371 (Fed. Cir. 2007); *AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1244 (Fed. Cir. 2003); *Durel Corp. v. Osram Sylvania Inc.*, 256 F.3d 1298, 1306 (2001); *Union Pac. Resources Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 690-92 (Fed. Cir. 2001); *Ajinomoto Co. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 1345-46 (Fed. Cir. 2000); *Nat'l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc.*, 166 F.3d 1190, 1195-98 (Fed. Cir. 1999); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); *Ralston Purina Co. v. Far-Mar Co.*, 772 F.2d 1570, 1573-74 (Fed. Cir. 1985); *White Consolidated Indus., Inc. v. Vega Servo Control, Inc.*, 713 F.2d 788, 791 (Fed. Cir. 1983); *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533 (Fed. Cir.), *cert. denied*, 484 U.S. 954 (1987); *Lindmann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463 (Fed. Cir. 1984); *Enzo Biochem, Inc. v. Calgene, Inc.*, 188 F.3d 1362, 1371 (Fed. Cir. 1999); *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

## 9. Written Description Requirement

A patent must contain a written description of the [product or process] claimed in the patent. The written description requirement helps to ensure that the patent applicant actually invented the claimed subject matter and was in possession of the invention. To satisfy the written description requirement, the patent must describe each and every limitation of a patent claim, in sufficient detail, although the exact words found in the claim need not be used. The

written description requirement is satisfied if a person of ordinary skill in the field reading the patent application as originally filed would recognize that the patent application described the invention as finally claimed in the patent. It is unnecessary to spell out every detail of the invention in the specification; only enough must be included to convince a person of skill in the art that the inventor possessed the invention.

The [Defendant] contends that the claim[s] of the [abbreviated patent number] patent [is] [are] invalid for failure to satisfy the written description requirement. [The defendant] bears the burden of establishing lack of written description by clear and convincing evidence.

If you find that [the defendant] has proved that it is highly probable that the [abbreviated patent number] patent does not contain a written description of the invention covered by any of these claims, then you must find that the claim is invalid.

*Falko-Gunter Faulkner v. Inglis*, 448 F.3d 1357, 1366 (Fed. Cir. 2006); *Kao Corp. v. Unilever U.S., Inc.*, 441 F.3d 963, 968 (Fed. Cir. 2006); *Monsanto Co. v. Scruggs*, 459 F.3d 1328, 1336 (Fed. Cir. 2006); *Turbocare Div. of Demag Delaval Turbomachinery Corp., v. General Elect. Co.*, 264 F.3d 1111, 1118 (Fed. Cir. 2002); *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916 (Fed. Cir. 2004); *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956 (Fed. Cir. 2002) (en banc); *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320 (Fed. Cir. 2000); *Reiffin v. Microsoft, Corp.*, 214 F.3d 1342, 1345-46 (Fed. Cir.2000); *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1478-90 (Fed. Cir. 1998); *Union Oil Co. of Cal. v. Atl. Richfield Co.*, 20 F.3d 989, 996-1001 (Fed. Cir. 2000); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991).

## 10. Best Mode

The purpose of the best mode requirement is to ensure that the public obtains a full disclosure on how to practice the invention claimed in the patent. The inventor must disclose the best mode he or she knew at the time of filing for carrying out the invention as described in the claims. If an inventor knows of a best way or mode of making and using the claimed invention at the time the patent application was filed, then the written description must contain a description of that mode.

[The Defendant] has asserted that [the Plaintiff]'s patent is invalid for failure to satisfy the best mode requirement. [The Defendant] bears the burden of establishing failure to satisfy the best mode requirement by clear and convincing evidence.

To determine whether the inventor complied with the best mode requirements, two questions must be answered:

1. At the time the patent application was filed, did [the patentee] consider a particular mode for practicing his invention superior to all other modes?
2. If so, did [the patentee] adequately disclose the superior mode in the [abbreviated patent number] patent?

The first prong of the best mode inquiry focuses on the state of mind of the particular inventor and the knowledge he possessed at the time the application was filed. The first question is subjective.

For instance, a selection made for commercial expediency (such as the availability of certain materials, prior relationships with certain suppliers, and other routine manufacturing choices) may be the “best” decision in a manufacturing circumstance but may have been chosen by someone other than the inventor or may not be considered by the inventor to be the best mode of carrying out the invention. If the inventor contemplated a best mode before he filed the patent application and left it out of the application, an amendment after the filing will not cure an original omission of the best mode disclosure.

The one exception to the best mode requirement is that an inventor need not set forth “routine details” that would be apparent to one skilled in the art.

If the answer to the first question is “yes,” the second question of the analysis should be addressed. The second question, an objective inquiry, focuses on the scope of the patented invention and the level of skill in the field of the invention. The disclosure in the specification must be adequate to allow one of ordinary skill in the art to make and use the best mode of the invention. Those skilled in the field of the invention should not have to look to the commercial embodiment in order to practice the best mode.

35 U.S.C. § 112, ¶1; *Liquid Dynamics Corp. v. Vaughan Co., Inc.*, 449 F.3d 1209, 1223 (Fed. Cir. 2006); *Bayer AG v. Schein Pharms., Inc.*, 301 F.3d 1306 (Fed. Cir. 2002); *Mentor H/S Inc., v. Med. Device Alliance, Inc.*, 244 F.3d 1365 (Fed. Cir. 2001); *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 963 (Fed. Cir. 2001); *N. Telecom Ltd. v. Samsung Elec. Co.*, 215 F.3d 1281, 1286 (Fed. Cir. 2000); *Applied Materials, Inc. v. Advanced Semiconductor Am. Materials, Inc.*, 98 F.3d 1563, 1581 (Fed. Cir. 1996); *U.S. Gypsum Co. v. Nat’l Gypsum Co.*, 74 F.3d 1209, 1212 (Fed. Cir. 1996); *Transco Prods. Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 558 (Fed. Cir. 1994); *Shearing v. Iolab Corp.*, 975 F.2d 1541 (Fed. Cir. 1992); *Wahl Instruments, Inc. v. Acvious, Inc.*, 950 F.2d 1575, 1581 (Fed. Cir. 1991); *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209-10 (Fed. Cir. 1991); *Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923, 928 (Fed. Cir. 1990); *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1535 (Fed. Cir. 1987); *DeGeorge v. Bernier*, 768 F.2d 1318, 1324 (Fed. Cir. 1985); *In re Gay*, 309 F.2d 769, 772 (C.C.P.A. 1962).

[THIS INSTRUCTION WILL NEED TO BE MODIFIED IF A CONTINUATION-IN-PART APPLICATION IS INVOLVED TO EXPLAIN THAT THE BEST MODE MUST BE DESCRIBED IN A CONTINUATION-IN-PART APPLICATION].

*Glaxo Inc. v. Navopharm Ltd.*, 52 F.3d 1043, 1049 (Fed. Cir. 1995); *Engel Indus., Inc. v. Lockformer Co.*, 946 F.2d 1528, 1531 (Fed. Cir. 1991); *Dana Corp. v. IPC Ltd. Partnership*, 860 F.2d 415, 419 (Fed. Cir. 1988); *Randomex Inc. v. Scopus Corp.*, 849 F.2d 585, 587 (Fed. Cir.

1988); *In re Bundy*, 642 F.2d 430, 434 (C.C.P.A. 1981); *In re Sherwood*, 613 F.2d 809 (C.C.P.A. 1980); *In re Hay*, 534 F.2d 917 (C.C.P.A. 1976).

### **Unenforceability (Inequitable Conduct)**

[INTRODUCTORY NOTE: “Inequitable conduct is an equitable issue committed to the discretion of the trial court and reviewed by [the Federal Circuit] under an abuse of discretion standard.” *Flex-Rest, LLC v. Steelcase, Inc.*, 455 F.3d 1351, 1357 (Fed. Cir. 2006). That discretion includes the determination to seek an advisory determination on the factual predicates underlying inequitable conduct or on the issue as a whole. The court should consider whether to charge the jury in detail, to charge the jury solely on materiality, or to retain the issue solely for itself, and should consider using a verdict form that breaks out materiality, intent, and/or balancing.]

#### **11.0 Inequitable Conduct – Generally**

[The Defendant] contends that [the Plaintiff] may not enforce the [abbreviated patent number] patent against [the Defendant] because [the Plaintiff] engaged in inequitable conduct before the Patent and Trademark Office during prosecution of the [abbreviated patent number] patent.

Applicants for a patent have a duty to prosecute patent applications in the Patent and Trademark Office with candor, good faith, and honesty. This duty of candor and good faith extends to all inventors named on a patent application, all patent attorneys and patent agents involved in preparing and prosecuting the application, and every other person involved in a substantial way with the prosecution of the patent application. An intentional failure to meet this duty of candor and good faith is referred to as “inequitable conduct.”

[In this case, [the Defendant] asserts that [DESCRIBE BRIEFLY EACH BASIS FOR [THE DEFENDANT]'S UNENFORCEABILITY DEFENSE].]

[The Defendant] bears the burden of establishing inequitable conduct by clear and convincing evidence. To determine whether the [abbreviated patent number] patent was obtained through inequitable conduct, you must determine whether a person having this duty of candor and good faith withheld or misrepresented information, or submitted false information, that was material to the examination of the patent application, and that this individual or individuals acted with an intent to deceive or mislead the PTO.

*Digital Control Inc. v. Charles Machine Works*, 437 F. 3d 1309 (Fed. Cir. 2006); *Cargill Inc. v. Canbra Foods, Ltd.*, 476 F. 3d 1359 (Fed. Cir. 2007); *eSpeed, Inc. v. BrokerTec USA, L.L.C.*, 480 F.3d 1129 (Fed. Cir. 2007); *Purdue Pharma L.P. v. Endo Pharm. Inc.*, 438 F. 3d 1123 (Fed. Cir. 2006); *Bristol-Myers Squibb Co. v. Phone-Poulenc Rorer, Inc.*, 326 F.3d 1226 (Fed. Cir. 2003); *GFI, Inc. v. Franklin Corp.*, 265 F.3d 1268 (Fed. Cir. 2001); *Critikon, Inc. v. Becton Dickinson Vascular Access, Inc.*, 120 F.3d 1253 (Fed. Cir. 1997).

## 11.1 Materiality

[Defendant] contends that \_\_\_\_\_ was information known to a person with this duty of good faith and candor that was [withheld from] [or] [misrepresented to]] [or] [falsely submitted to] the Patent and Trademark Office during the prosecution of the [abbreviated patent number] patent. If you find that a person with this duty of good faith and candor [[withheld] [or] [misrepresented]] [or] [submitted false] information when applying for the [abbreviated patent number] patent, you must determine whether that information was material information.

Information is material if there is a substantial likelihood that a reasonable patent examiner would consider it important in deciding whether or not to allow the application to issue as a patent. For example, information is material if it establishes, either alone or in combination with other information, that a claim of the patent application would more likely than not meet one of the requirements for a patents. Information is also material if it refutes or is inconsistent with the information provided to the Patent and Trademark Office or arguments made by the applicant to persuade the Patent and Trademark Office that the invention is entitled to patent protection. Information that is “cumulative” of, or adds little to, other information the examiner already had is not material.

37 C.F.R. § 1.56 (2007); *Purdue Pharma L.P. v. Endo Pharmaceuticals Inc.*, 438 F.3d 1123, 1129 n. 6 (Fed. Cir. 2006) (“new [1992] standard was not intended to constitute a significant substantive break with the pre-1992 standard”); *Cargill Inc. v. Canbra Foods, Ltd.*, 476 F. 3d 1359 (Fed. Cir. 2007); *eSpeed, Inc. v. BrokerTec USA, L.L.C.*, 480 F.3d 1129 (Fed. Cir. 2007); *Flex-Rest, LLC v. Steelcase, Inc.*, 455 F.3d 1351 (Fed. Cir. 2006); *Digital Control Inc. v. Charles Machine Works*, 437 F. 3d 1309 (Fed. Cir. 2006); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.*, 326 F.3d 1226 (Fed. Cir. 2003); *PerSeptive Biosystems, Inc. v. Pharmacia Biotech, Inc.*, 225 F.3d 1315 (Fed. Cir. 2000); *Baxter Int’l, Inc. v. McGaw, Inc.*, 149 F.3d 1321 (Fed. Cir. 1998); *Critikon, Inc. v. Becton Dickinson Vascular Access, Inc.*, 120 F.3d 1253 (Fed. Cir. 1997).

## 11.2 Intent to Deceive or Mislead

If you determine that material information was [withheld from] [or] [misrepresented to] [or] [falsely submitted to] the Patent and Trademark Office, you must next determine whether this was done with an intent to deceive or mislead the Patent and Trademark Office. Intent to deceive the Patent and Trademark Office may be found from direct evidence. Such direct evidence is rare, however, and as a result, the law allows deceptive intent to be inferred from the facts and surrounding circumstances.

[When a patentee has knowingly misrepresented a material fact or submitted false material information, and when the natural consequence of those intentional acts would be that to deceive the Patent and Trademark Office, an inference that the patentee intended to deceive may be appropriate.] [Simple negligence is insufficient for a holding of inequitable conduct.]

In determining whether or not there was intent to deceive or mislead the Patent and Trademark Office, you should consider the totality of the circumstances, including the nature of the conduct and evidence of the absence or presence of good faith.

*Cargill Inc. v. Canbra Foods, Ltd.*, 476 F. 3d 1359 (Fed. Cir. 2007); *eSpeed, Inc. v. BrokerTec USA, L.L.C.*, 480 F.3d 1129 (Fed. Cir. 2007); *Purdue Pharma L.P. v. Endo Pharm. Inc.*, 438 F. 3d 1123 (Fed. Cir. 2006); *Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.*, 326 F.3d 1226 (Fed. Cir. 2003); *GFI, Inc. v. Franklin Corp.*, 265 F.3d 1268 (Fed. Cir. 2001); *PerSeptive Biosystems, Inc. v. Pharmacia Biotech, Inc.*, 225 F.3d 1315 (Fed. Cir. 2000); *Semiconductor Energy Laboratory Co., Ltd. v. Samsung Electronics Co., Ltd.*, 204 F.3d 1368, 1374-75 (Fed. Cir. 2000); *Critikon, Inc. v. Becton Dickinson Vascular Access, Inc.*, 120 F.3d 1253 (Fed. Cir. 1997); *LaBounty Mfg., Inc. v. United States Int'l Trade Comm'n*, 958 F.2d 1066 (Fed. Cir. 1992).

### **11.3 Balancing of Materiality and Intent**

If [the Defendant] has proven by clear and convincing evidence that information was [withheld] [or] [misrepresented] [or] [falsely submitted] by a person with the duty of good faith and candor, you must then balance the degree of materiality and the degree of intent to deceive or mislead the Patent and Trademark Office to determine whether or not the evidence is sufficient to establish clearly and convincingly that there was inequitable conduct committed in the prosecution of the [abbreviated patent number] patent. Where the materiality of the [withheld] [or] [misrepresented] [or] [false] information is high, the showing of intent needed to establish inequitable conduct is proportionally less. Likewise, when the showing of intent is high, the showing of materiality may be proportionally less.

*eSpeed, Inc. v. BrokerTec USA, L.L.C.*, 480 F.3d 1129, 1135 (Fed. Cir. 2007) (“Once a district court has found a threshold level of both materiality and intent to deceive, the district court must balance the evidence to determine if equity should render the patent unenforceable”); *Cargill Inc. v. Canbra Foods, Ltd.*, 476 F. 3d 1359 (Fed. Cir. 2007); *Purdue Pharma L.P. v. Endo Pharm. Inc.*, 438 F. 3d 1123 (Fed. Cir. 2006); *Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.*, 326 F.3d 1226 (Fed. Cir. 2003); *GFI, Inc. v. Franklin Corp.*, 265 F.3d 1268 (Fed. Cir. 2001); *Union Pac. Res. Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 693 (Fed. Cir. 2001); *PerSeptive Biosystems, Inc. v. Pharmacia Biotech, Inc.*, 225 F.3d 1315 (Fed. Cir. 2000); *Baxter Int'l, Inc. v. McGaw, Inc.*, 149 F.3d 1321 (Fed. Cir. 1998); *Critikon, Inc. v. Becton Dickinson Vascular Access, Inc.*, 120 F.3d 1253 (Fed. Cir. 1997).

## **Damages**

### **12.0 Damages – Generally**

If you find that the accused [[device] [method]] infringes any of the claims of the [abbreviated patent number] patent, and that those claims are not invalid, you must determine the amount of damages to be awarded [the Plaintiff] for the infringement. 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.

If you need to determine damages, the amount of those damages must be adequate to compensate [the Plaintiff] for the infringement. Your damage award should put [the Plaintiff] in approximately the financial position it would have been in had the infringement not occurred; but, in no event may the damage award be less than a reasonable royalty. You may not add anything to the amount of damages to punish the accused infringer or to set an example.

[The Plaintiff] has the burden of proving each element of its damages by a preponderance of the evidence.

The fact that I am instructing you as to the proper measure of damages should not be construed as intimating any view of the Court as to which party is entitled to prevail in this case. Instructions as to the measure of damages are given for your guidance in the event you find the evidence in favor of [the Plaintiff].

35 U.S.C. § 284 (2004); *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476, 507 (1964); *Dow Chem. Co. v. Mee Indus., Inc.*, 341 F.3d 1370, 1381-82 (Fed. Cir. 2003); *Vulcan Eng'g Co. v. FATA Aluminum, Inc.*, 278 F.3d 1366, 1376 (Fed. Cir. 2002); *Grain Processing Corp. v. Am. Maize-Prods. Co.*, 185 F.3d 1341, 1349 (Fed. Cir. 1999); *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1108-1109 (Fed. Cir. 1996); *Hebert v. Lisle Corp.*, 99 F.3d 1109, 1119 (Fed. Cir. 1996); *Rite-Hite Corp. v. Kelley Co.*, 56 F.3d 1538, 1544-45 (Fed. Cir. 1995); *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 870 (Fed. Cir. 1993); *Fromson v. W. Litho Plate & Supply Co.*, 853 F.2d 1568, 1574 (Fed. Cir. 1988); *Del Mar Avionics, Inc. v. Quinton Instrument Co.*, 836 F.2d 1320, 1326 (Fed. Cir. 1987).

## **12.1 Date Damages Begin**

### ***(Alternate A)***

[WHEN THE DATE OF THE NOTICE OF INFRINGEMENT IS STIPULATED]:

The date that [the Plaintiff] first gave notice to [the Defendant] of its claim of patent infringement is the date at which patent damages begin to be calculated. That date has been agreed to by the parties to be [infringement notice date].

### ***(Alternate B)***

[WHEN THE DATE OF THE NOTICE OF INFRINGEMENT IS DISPUTED – Product claims]:

The date that [the Plaintiff] first gave notice to [the Defendant] of its claim of patent infringement is the date at which patent damages begin to be calculated. That date is in dispute here, and it is up to you to determine what that date is. [The Plaintiff] has the burden to prove by a preponderance of the evidence the date it gave notice.

[The Plaintiff] can give notice in two ways. The first way is to give notice to the public in general. [The Plaintiff] can do this by placing the word “patent” or the abbreviation

“PAT” with the number of the patent on substantially all the products it sold that included the patent invention. [Licensees of the [abbreviated patent number] patent who use the patented invention must also mark substantially all of their products that include the patented invention with the patent number.] This type of notice is effective from the date [the Plaintiff] [and its licensees] began to mark substantially all of their products that use the patented invention with the patent number. If [the Plaintiff] [and its licensees] did not mark substantially all of their products that use the patented invention with the patent number, then [the Plaintiff] did not provide notice in this way.

A second way [the Plaintiff] can provide notice of its patent[s] is to communicate to [the Defendant] a specific charge that the [allegedly infringing product] infringed the [abbreviated patent number] patent. This type of notice is effective from the time it is given. If you find that [the Plaintiff], before filing this lawsuit, did not properly mark its products and did not notify [the Defendant] by communicating a specific charge that the [allegedly infringing product] infringed, then [the Plaintiff] can only recover damages for infringement that occurred after it sued [the Defendant] on [lawsuit filing date].

[IF THERE IS AN ISSUE OF FACT AS TO THE ADEQUACY OF THE PATENTEE’S MARKING, ADDITIONAL INSTRUCTIONS WILL BE REQUIRED].

*(Alternate C)*

[WHEN THE DATE DAMAGES BEGIN IS THE DATE THE LAWSUIT WAS FILED]:

The date that damages begin to be calculated in this case is the date this lawsuit was filed, which is [date complaint was filed].

35 U.S.C. § 287(a); *Gart v. Logitech, Inc.*, 254 F.3d 1334, 1345 (Fed. Cir. 2001); *Lans v. Digital Equip. Corp.*, 252 F.3d 1320, 1327-28 (Fed. Cir. 2001); *Crystal Semiconductor Corp. v. TriTech Microelects. Int’l, Inc.*, 246 F.3d 1336, 1353 (Fed. Cir. 2001); *Amsted Indus., Inc. v. Buckeye Steel Castings Co.*, 24 F.3d 178, 184-87 (Fed. Cir. 1994); *Devices for Med., Inc. v. Boehl*, 822 F.2d 1062-1066 (Fed. Cir. 1987).

## **12.2 Two Types of Damages – Lost Profits and Reasonable Royalty**

There are two types of damages for patent infringement. The first type of patent damages is lost profits. Briefly, lost profits damages compensate the patent owner for the additional profits that it would have made if the accused infringer had not infringed. You may hear this referred to as the “but for” test. The second type of patent damages is called reasonable royalty. Generally, the patent laws define a reasonable royalty 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 reasonable royalty is the minimum amount of damages that a patent owner may recover for infringement.

### 12.3 Lost Profits – “But-For” Test

[The Plaintiff] is seeking its lost profits as its patent damages.

[The Plaintiff] must prove the amount of its lost profits. To recover lost profits for some or all of the infringing sales, [the Plaintiff] must show by a preponderance of evidence that, but for the infringement, [the Plaintiff] would have made profits. The lost profits may be profits that would have resulted from Plaintiff's sales or a portion of them that [the Defendant] made of [allegedly infringing product]. Thus, part of your job is to determine what the customers who purchased the [allegedly infringing product] [from the Defendant] would have done if the [alleged] infringement had not occurred. The profits I have been referring to are the profits allegedly lost by [the Plaintiff], not the profits, if any, made by [the Defendant].

*Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476, 507 (1964); *Micro Chem. v. Lextron, Inc.*, 318 F.3d 1119, 1122-1125 (Fed. Cir. 2003); *Ferguson Beauregard/Logic Controls v. Mega Sys., L.L.C.*, 350 F.3d 1327, 1345-46 (Fed. Cir. 2003); *Ericsson, Inc. v. Harris Corp.*, 352 F.3d 1369, 1377 (Fed. Cir. 2003); *Tate Access Floors, Inc. v. Maxcess Techs., Inc.*, 222 F.3d 958, 971 (Fed. Cir. 2000); *Grain Processing Corp. v. Am. Maize-Prods. Co.*, 185 F.3d 1341, 1349 (Fed. Cir. 1999); *King Instruments Corp. v. Perego*, 65 F.3d 941, 952 (Fed. Cir. 1995); *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 1428 (Fed. Cir. 1988); *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 863-64 (Fed. Cir. 1985); *Paper Converting Mach. Co. v. Magna-Graphics Corp.* 745 F.2d 11, 21 (Fed. Cir. 1984); *Am. Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1365 (Fed. Cir. 1984); *Central Soya Co. v. Geo A Hormel & Co.*, 723 F.2d 1573, 1578-79 (Fed. Cir. 1983).

### 12.4 Lost Profits – Panduit Factors

You may infer that [the Plaintiff] has proven its lost profits if you find that [the Plaintiff] has proven each of the following factors by a preponderance of the evidence:

1. the demand for the patented [[product] [method]],
2. absence of acceptable non-infringing substitutes,
3. that [the Plaintiff] had the manufacturing and marketing capacity to make the infringing sales [or a portion thereof] actually made by [the Defendant], and
4. the amount of profit that [the Plaintiff] would have made but for [the Defendant]'s sales.

I will now explain each of these factors.

*Tate Access Floors, Inc. v. Maxcess Techs., Inc.*, 222 F.3d 958, 971 (Fed. Cir. 2000); *Gargoyles, Inc. v. United States*, 113 F.3d 1572, 1577-79 (Fed. Cir. 1997); *Stryker Corp. v. Intermedics Orthopedics, Inc.*, 96 F.3d 1409, 1417-18 (Fed. Cir. 1996); *Rite-Hite Corp. v. Kelley Co.*, 56 F.3d 1538, 1545 (Fed. Cir. 1995); *State Indus., Inc. v. Mor-Flo Indus., Inc.*, 883 F.2d 1573, 1577

(Fed. Cir. 1989); *Yarway Corp. v. Eur-Control USA, Inc.*, 775 F.2d 268, 275 (Fed. Cir. 1985); *Panduit Corp. v. Stahl Bros. Fibre Works, Inc.*, 575 F.2d 1152, 1156 (6th Cir. 1978).

### **12.5 Lost Profits – Panduit Factors – Demand**

Demand for the patented product can be proven by significant sales of [the Plaintiff]'s patented product. Demand for the patented product can also be proven by significant sales of [the Defendant's] product containing the patented features. However, if you find that [the Defendant] generated new or different markets by sales or marketing efforts because of features other than those claimed by [the Plaintiff], the sales of [the Defendant's] product cannot establish a demand for the patented product.

*BIC Leisure Prods, Inc. v. Windsurfing Int'l, Inc.*, 1 F.3d 1214, 1218-19 (Fed. Cir. 1993); *SmithKline Diagnostics, Inc. v. Helena Labs. Corp.*, 926 F.2d 1161, 1165 n.3 (Fed. Cir. 1991); *Gyromat Corp. v. Champion Spark Plug Co.*, 735 F.2d 549, 552 (Fed. Cir. 1984).

### **12.6 Lost Profits – Panduit Factors – Acceptable Non-Infringing Substitutes**

In order to be an acceptable substitute, the product must have one or more of the advantages of the patented invention that were important to customers. If, however, the realities of the marketplace are that competitors other than [the Plaintiff] would likely have captured some or all of the sales made by the infringer, even despite a difference in the products, then [the Plaintiff] is not entitled to lost profits on those sales. An acceptable non-infringing substitute must be a product that does not infringe the patent. A product does not infringe a patent when it either (a) is sold based on a license under that patent or (b) does not include all the features required by the patent. An acceptable non-infringing substitute is available if, during the damages period, a competitor or [the Defendant] had all the necessary equipment, materials, know-how, and experience to design and manufacture the substitute and sell such substitute instead of its infringing sales at the time those infringing sales were made. If you determine that [the Defendant]'s customers would just as likely have purchased a non-infringing acceptable product, then [the Plaintiff] has not shown it lost that sale but for [Defendant]'s sales

In order to assess whether there is an absence of acceptable non-infringing substitutes, you must consider whether non-infringing substitutes existed that were acceptable to the *specific* purchasers of the infringing products, not “purchasers” generally. The test is whether purchasers of [the Defendant]'s product were motivated to make their purchase by features of [the Defendant]'s product that were attributable to the claimed invention. If so, non-infringing products without those features would not be “acceptable non-infringing substitutes,” even if they otherwise competed in the marketplace with the patented and [the Defendant]'s products.

*Grain Processing Corp. v. Am. Maize-Prods. Co.*, 185 F.3d 1341, 1349 (Fed. Cir. 1999); *Gargoyles, Inc. v. United States*, 113 F.3d 1572, 1577-1578 (Fed. Cir. 1997); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 939 F.2d 1540, 1545-46 (Fed. Cir. 1991); *Standard Havens Prods., Inc. v. Gencor Indus.*, 953 F.2d 1360, 1373 (Fed. Cir. 1991); *Kaufman Co. v. Lantech, Inc.*, 926 F.2d 1136, 1142-43, 1143 n.17, (Fed. Cir. 1991); *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*,

926 F.2d 1161, 1166 (Fed. Cir. 1991); *TWM Mfg. Co. v. Dura Corp.*, 789 F.2d 895, 901-902 (Fed. Cir. 1986).

### **12.7 Lost Profits – Panduit Factors – Capacity**

[The Plaintiff] is only entitled to lost profits for sales it could have actually made. You should consider whether [the Plaintiff] has proven that it had the manufacturing capacity and the marketing capability to make the sales it says it lost. [The Plaintiff] must prove that it was more probable than not that it could have made, or could have had someone else make for it, the additional products it says it could have sold but for the infringement. [The Plaintiff] also must prove that it had the capability to market and sell the additional patented products.

*Gargoyles, Inc. v. United States*, 113 F.3d 1572, 1577-1578 (Fed. Cir. 1997); *Fonar Corp. v. Gen. Elec. Co.*, 107 F.3d 1543, 1553 (Fed. Cir. 1997); *Kearns v. Chrysler Corp.*, 32 F.3d 1541, 1551 (Fed. Cir. 1994); *Datascope Corp. v. SMEC, Inc.*, 879 F.2d 820, 825 (Fed. Cir. 1989); *Gyromat Corp. v. Champion Spark Plug Co.*, 735 F.2d 549, 554 (Fed. Cir. 1984).

### **12.8 Lost Profits – Panduit Factors – Amount of Profit Incremental Income Approach**

[The Plaintiff] may calculate its lost profits on lost sales by computing the lost revenue for its patented product and subtracting from that figure the amount of additional costs or expenses that it would have incurred in making those lost sales, including but not limited to cost of goods, sales costs, packaging, shipping, etc. Certain fixed costs such as taxes, insurance, rent and administrative overhead may not vary with increases in production or scale. These are called fixed costs. Any costs which do not vary with increased production or scale should not be subtracted from the lost revenue when determining damages. Thus, in determining [the Plaintiff's] lost profits, you are not to subtract from its lost revenue the amount of any fixed costs. The amount of lost profits cannot be speculative but it need not be proved with unerring certainty.

*Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1572 (Fed. Cir. 1996); *Oiness v. Walgreen Co.*, 88 F.3d 1025, 1030 (Fed. Cir. 1996); *Beatrice Foods Co. v. New England Printing & Lithographing Co.*, 923 F.2d 1576, 1579 (Fed. Cir. 1991); *Kalman v. Berlyn Corp.*, 914 F.2d 1473, 1482-1483 (Fed. Cir. 1990); *State Indus., Inc. v. Mor-Flo Indus., Inc.*, 883 F.2d 1573, 1579-1580 (Fed. Cir. 1989); *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 1428 (Fed. Cir. 1988); *Del Mar Avionics, Inc. v. Quinton Instrument Co.*, 836 F.2d 1320, 1327 (Fed. Cir. 1987); *King Instrument Corp. v. Otari*, 767 F.2d 853, 863-864 (Fed. Cir. 1985); *Gyromat Corp. v. Champion Spark Plug Co.*, 735 F.2d 549, 554-555 (Fed. Cir. 1984); *Paper Converting Mach. Co. v. Magna-Graphics Corp.*, 745 F.2d 11, 22 (Fed. Cir. 1984); *Bio-Rad Labs, Inc. v. Nicolet Inst. Corp.*, 739 F.2d 604 (Fed. Cir. 1984); *Lam, Inc. v. Johns-Manville Corp.*, 718 F.2d 1056, 1065 (Fed. Cir. 1983).

## **12.9 Lost Profits – Market Share**

It is not necessary for [the Plaintiff] to prove that [the Plaintiff] and [the Defendant] were the only two suppliers in the market for [the Plaintiff] to demonstrate entitlement to lost profits. If the realities of the marketplace are such that “acceptable non-infringing substitutes” were available from suppliers who would have made only some, but not all, of the sales that were made by [the Defendant], then [the Plaintiff] may be entitled to lost profits on a portion of the infringing sales. The burden is on [the Plaintiff], however, to show to a reasonable probability that it would have sold that portion if [the Defendant]'s product had never existed. By the same token, even if you find that [the Plaintiff] and [the Defendant] were the only two suppliers of products having the advantages of the patented product, it does not necessarily mean that [the Plaintiff] would have made all [the Defendant]'s sales. The burden is on [the Plaintiff] to show that its product competed in the same market with the [the Defendant]'s product and that it would have made those sales if the infringement had not occurred.

*Crystal Semiconductor Corp. v. Tritech Microelects. Int'l, Inc.*, 246 F.3d 1336, 1353-1357 (Fed. Cir. 2001); *BIC Leisure Prods., Inc. v. Windsurfing Int'l, Inc.*, 1 F.3d 1214 (Fed. Cir. 1993); *State Indus., Inc. v. Mor-Flo Indus., Inc.*, 883 F.2d 1573, 1577-78 (Fed. Cir. 1989).

## **12.10 Lost Profits – Price Erosion**

[The Plaintiff] is entitled to recover additional damages if it can show to a reasonable probability that, if there had been no infringement, [the Plaintiff] [[would have been able to charge higher prices for its patented products] [would not have had to lower its prices]]. In that case, you may also award as additional damages the amount represented by the difference between the amount of profits that [the Plaintiff] would have made by selling its product at the higher price and the amount of profits [the Plaintiff] actually made by selling its product at the lower price that [the Plaintiff] actually charged for its patented product. This type of damage is referred to as price erosion damage. If you find that [the Plaintiff] suffered price erosion damages, you may also use the higher price in determining [the Plaintiff]'s lost profits from sales lost because of the infringement. In calculating [the Plaintiff]'s total losses from price erosion, you must take into account any decrease in sales that might have occurred if [the Plaintiff] charged a higher price than it did. This is called price elasticity. In order to award lost profits based on price erosion, it is not required that [the Plaintiff] knew that the competing product infringed the patent, if [the Plaintiff] reduced its price to meet [the Defendant]'s competition.

*Ericsson, Inc. v. Harris Corp.*, 352 F.3d 1369, 1378-1379 (Fed. Cir. 2003); *Vulcan Eng'g Co. v. FATA Aluminum, Inc.*, 278 F.3d 1366, 1377 (Fed. Cir. 2002); *Minn. Mining & Mfg. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1578-1579 (Fed. Cir. 1992); *Amstar Corp. v. Envirotech Corp.*, 823 F.2d 1538, 1543 (Fed. Cir. 1987); *Lam, Inc. v. Johns-Manville Corp.*, 718 F.2d 1056, 1065 (Fed. Cir. 1983).

## **12.11 Lost Profits – Cost Escalation**

[The Plaintiff] can recover additional damages if it can show that it also lost profits because its costs – such as additional marketing costs – went up as a result of [the Defendant]'s

actions. [The Plaintiff] must prove that it was more probable than not that its costs went up because of [the Defendant]'s actions, and not for some other reason.

*Fiskars, Inc. v. Hunt Mfg. Co.*, 221 F.3d 1318, 1324-1325, 55 U.S.P.Q.2d 1569, 1574-1575 (Fed. Cir. 2000); *Minco, Inc. v. Combustion Eng'g, Inc.*, 95 F.3d 1109, 1120, 40 U.S.P.Q.2d 1001, 1009 (Fed. Cir. 1996); *Roton Barrier, Inc. v. Stanley Works*, 79 F.3d 1112, 1120, 37 U.S.P.Q.2d 1816, 1822 (Fed. Cir. 1996).

### **12.12 Lost Profits – Collateral Sales**

In this case, [the Plaintiff] contends that the patented product is ordinarily sold along with [collateral products]. To recover lost profits on sales of such collateral products, [the Plaintiff] must prove two things. First, that it is more likely than not that [the Plaintiff] would have sold the collateral products but for the infringement. Second, a collateral product and the patented product together must be analogous to components of a single assembly or parts of a complete machine, or they must constitute a functional unit. Damages for lost profits on lost collateral sales, if any, are calculated in the same manner as I just described for calculating lost profits on the patented product.

*Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476, 507 (1964); *Rite-Hite Corp. v. Kelley Co.*, 56 F.3d 1538, 1549-1551 (Fed. Cir. 1995); *State Indus., Inc. v. Mor-Flo Indus., Inc.*, 883 F.2d 1573, 1580 (Fed. Cir. 1989); *Kori Corp. v. Wilco Marsh Buggies & Draglines, Inc.*, 761 F.2d 649, 656 (Fed. Cir. 1985); *Paper Converting Mach. Co. v. Magna-Graphics Corp.*, 745 F.2d 11, 22-23 (Fed. Cir. 1984).

### **12.13 Lost Profits – Doubts Resolved Against Infringer**

All doubts resulting from [the Defendant]'s failure to keep proper records are to be resolved in favor of [the Plaintiff]. Any incorrectness or confusion in [the Defendant]'s records should be held against [the Defendant], not [the Plaintiff].

*Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1572-73 (Fed. Cir. 1996); *Lam, Inc. v. Johns-Manville Corp.*, 718 F.2d 1056, 1065 (Fed. Cir. 1983).

### **12.14 Reasonable Royalty - Generally**

If you find that [the Plaintiff] has not proven its claim for lost profits, or if you find that [the Plaintiff] has proven its claim for lost profits for only a portion of the infringing sales, you must then determine what a reasonable royalty would be for that portion of [the Plaintiff]'s sales for which you have not awarded lost profit damages. The patent law specifically provides that the amount of damages that [the Defendant] must pay [the Plaintiff] for infringing [the Plaintiff]'s patent may not be less than a reasonable royalty for the use that [the Defendant] made of [the Plaintiff]'s invention. A reasonable royalty is not necessarily the actual measure of damages, but is merely the floor below which damages should not fall. [The Plaintiff] is entitled to a reasonable royalty for all infringing sales for which it is not entitled to lost profits damages.

35 U.S.C. § 284; *Crystal Semiconductor Corp. v. Tritech Microelects. Int'l, Inc.*, 246 F.3d 1336, 1354 (Fed. Cir. 2001); *Fromson v. W. Litho Plate & Supply Co.*, 853 F.2d 1568, 1574 (Fed. Cir. 1998); *Minco, Inc. v. Combustion Eng'g, Inc.*, 95 F.3d 1109, 1119 (Fed. Cir. 1996); *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1579 (Fed. Cir. 1996); *Rite-Hite Corp. v. Kelley Co.*, 56 F.3d 1538, 1554 (Fed. Cir. 1995) (en banc); *State Indus., Inc. v. Mor-Flo Indus., Inc.*, 883 F.2d 1573, 1579 (Fed. Cir. 1989).

### **12.15 Reasonable Royalty – Definition**

A royalty is a payment made to the owner of a patent by a non-owner in exchange for rights to make, use, or sell the claimed invention. A reasonable royalty is the royalty that would have resulted from a hypothetical negotiation between the patent owner and a [[person] [company]] in the position of [the Defendant] taking place just before the infringement began. You should also assume that both parties to that negotiation understood the patent to be valid and infringed and were willing to enter into a license.

*Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1579-81 (Fed. Cir. 1996); *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1108-10 (Fed. Cir. 1996); *Rite-Hite Corp. v. Kelley Co.*, 56 F.3d 1538, 1554 (Fed. Cir. 1995) (en banc); *State Indus., Inc. v. Mor-Flo Indus., Inc.*, 883 F.2d 1573, 1580 (Fed. Cir. 1989); *Georgia-Pacific Corp. v. United States Plywood Corp.*, 318 F. Supp. 1116, 1121 (S.D.N.Y. 1970), *modified and aff'd sub nom., Georgia-Pacific Corp. v. United States Plywood Champion Papers, Inc.*, 446 F.2d 295 (2d Cir. 1971).

### **12.16 Reasonable Royalty – Relevant Factors**

In determining the value of a reasonable royalty, you may consider evidence on any of the following factors:

1. Any royalties received by the licensor for the licensing of the patent-in-suit, proving or tending to prove an established royalty.
2. The rates paid by [the Defendant] to license other patents comparable to the [abbreviated patent number] patent.
3. The nature and scope of the license, as exclusive or non-exclusive, or as restricted or non-restricted in terms of its territory or with respect to whom the manufactured product may be sold.
4. The licensor's established policy and marketing program to maintain its right to exclude others from using the patented invention by not licensing others to use the invention, or by granting licenses under special conditions designed to preserve that exclusivity.
5. The commercial relationship between the licensor and the licensee, such as whether or not they are competitors in the same territory in the same line of business.

6. The effect of selling the patented product in promoting sales of other products of the licensee; the existing value of the invention to the licensor as a generator of sales of its non-patented items; and the extent of such collateral sales.
7. The duration of the [abbreviated patent number] patent and the term of the license.
8. The established profitability of the product made under the [abbreviated patent number] patent; its commercial success; and its current popularity.
9. The utility and advantages of the patented invention over the old modes or devices, if any, that had been used for achieving 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 Defendant] has made use of the invention; and any evidence that shows 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 businesses to allow for the use of the invention or analogous inventions.
13. The portion of the profit that arises from the patented invention itself as opposed to profit arising from unpatented features, such as the manufacturing process, business risks, or significant features or improvements added by the accused infringer.
14. The opinion testimony of qualified experts.
15. The amount that a licensor and a licensee (such as [the Defendant]) would have agreed upon (at the time the infringement began) if both sides 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 patentee who was willing to grant a license.
16. Any other economic factor that a normally prudent business person would, under similar circumstances, take into consideration in negotiating the hypothetical license.

*Monsanto Co. v. McFarling*, 488 F.3d 973 (Fed. Cir. 2007); *Tec Air, Inc. v. Denso Mfg. Mich., Inc.*, 192 F.3d 1353, 1362 (Fed. Cir. 1999); *Fonar Corp. v. Gen. Elec. Co.*, 107 F.3d 1543, 1552-53 (Fed. Cir. 1997); *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1579-81 (Fed. Cir. 1996); *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1108-10 (Fed. Cir. 1996); *Rite-Hite Corp. v. Kelley Co.*,

56 F.3d 1538, 1554 (Fed. Cir. 1995) (en banc); *State Indus., Inc. v. Mor-Flo Indus., Inc.*, 883 F.2d 1573, 1580 (Fed. Cir. 1989); *TWM Mfg. Co. v. Dura Corp.*, 789 F.2d 895, 898-900 (Fed. Cir. 1986); *Hanson v. Alpine Valley Ski Area, Inc.*, 718 F.2d 1075, 1079 (Fed. Cir. 1983); *Georgia-Pacific Corp. v. United States Plywood Corp.*, 318 F. Supp. 1116 (S.D.N.Y. 1970), *modified and aff'd sub nom., Georgia Pacific Corp. v. United States Plywood Champion Papers, Inc.*, 446 F.2d 295 (2d Cir. 1971).

### **12.17 Reasonable Royalty – Timing**

Although the relevant date for the hypothetical reasonable royalty negotiation is just before the infringement began, you may consider in your determination of reasonable royalty damages any actual profits by [the Defendant] after that time and any commercial success of the patented invention in the form of sales of the patented or infringing products after that time. You may only consider this information, however, if it was foreseeable at the time that the infringement began.

*Trell v. Marlee Elecs. Corp.*, 912 F.2d 1443, 1446, 1448 (Fed. Cir. 1990); *State Indus., Inc. v. Mor-Flo Indus., Inc.*, 883 F.2d 1573, 1581 (Fed. Cir. 1989); *Fromson v. W. Litho Plate & Supply Co.*, 853 F.2d 1568, 1575-76 (Fed. Cir. 1988); *Studiengesellschaft Kohle, mbH v. Dart Indus., Inc.*, 862 F.2d 1564, 1571-72 (Fed. Cir. 1988).

## **13. Willful Infringement**

If you find by a preponderance of the evidence that [the Defendant] infringed [the Plaintiff]'s patent, either literally or under the doctrine of equivalents, then you must further determine if this infringement was willful. Willfulness must be proven by clear and convincing evidence showing that:

1. [The Defendant] had actual knowledge of [the Plaintiff]'s patent,
2. A reasonable person, with knowledge of [the Plaintiff]'s patent, would have concluded that: (a) [the Defendant's] actions were highly likely to infringe [the Plaintiff]'s patent, and (b) [the Plaintiff]'s patent was highly likely to be valid, and
3. [The Defendant] acted even though the [the Defendant] knew, or it was so obvious that [the Defendant] should have known, that [the Defendant's] actions were highly likely to infringe a valid patent.

In making the determination as to willfulness, you must consider the totality of the circumstances. The totality of the circumstances comprises a number of factors, which include, but are not limited to whether [the Defendant] intentionally copied the claimed invention or a product covered by [the Plaintiff]'s patent, [whether [the Defendant] relied on competent legal advice<sup>6</sup>,] and whether [the Defendant] presented a substantial defense to infringement, including the defense that the patent is invalid [or unenforceable].

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<sup>6</sup> This factor, “whether the Defendant relied on competent legal advice,” should only be included if the alleged infringer relies on a legal opinion as a defense to an allegation of willful infringement. “[I]t is inappropriate to

*In re Seagate Technology, LLC*, -- F3d --, 83 U.S.P.Q.2d 1865 (Fed. Cir. 2007) (en banc); *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337, 1347 (Fed. Cir. 2004) (en banc).

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draw an adverse inference that undisclosed legal advice for which attorney-client privilege is claimed was unfavorable . . . [and] it is [also] inappropriate to draw a similar adverse inference from failure to consult counsel.” *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337, 1347 (Fed. Cir. 2004) (en banc).