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1 details that should be added to particular instructions to address specific issues that will
2 arise in certain cases.

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

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

13 Copies of these model jury instructions are also available on disk. Requests
14 for disks can be directed to:

15 American Intellectual Property Law Association
16 2001 Jefferson Davis Highway
17 Suite 203
18 Arlington, VA 22202
19 Attn: (703) 415-0780

20
21 April 2, 1998

21 Richard S. Florsheim
22 Chairman,
23 Model Jury Instructions Subcommittee
24 Federal Litigation Committee
25 American Intellectual Property Law Association
26

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1 **PRELIMINARY JURY INSTRUCTIONS**

2 Members of the jury:

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

5 **I. THE NATURE OF THE ACTION AND THE PARTIES**

6 This is a patent case. The patents involved in this case relate to [subject
7 matter] technology. [Briefly describe technology involved] During the trial, the parties
8 will offer testimony to familiarize you with this technology. For your convenience, we
9 will distribute a glossary of some of the technical terms to which the parties may refer
10 during the trial.

11
12 The United States Patent and Trademark Office has granted [a/several]
13 patent[s] to [named inventor(s)] for inventions relating to this technology. [Name of
14 party] is the owner [exclusive licensee] of the patent[s], which [is/are] identified by the
15 Patent Office by number: No. X,XXX,XXX (which may be called "the 'XXX
16 patent"); [identify additional patents]. These patents may also collectively be referred
17 to as "the [named inventor(s)] patents." [Identify relationship of any other parties
18 aligned with the patent owner; e.g. exclusive licensee]

19 **A. The United States Patent**

20 A valid United States patent gives its owner the right to exclude others from
21 [practicing the patented process], making using, offering to sell, or selling the patented
22 invention [a product made by the patented process] within [or importing the patented
23 invention into] the United States, its territories, and its possessions. During the trial,

1 the parties will offer testimony to familiarize you with how one obtains a patent from
2 the United States Patent and Trademark Office (sometimes referred to as "the PTO"),
3 as well as with the contents of a patent, including the specification or written
4 description and the claim or claims by which the applicant defines the subject matter of
5 his or her invention.

6 I will briefly describe some of the terms for you so that you have some
7 background in patent terminology. The Patent and Trademark Office, the PTO, is in
8 the Washington, D.C. area and is an agency of the Federal Government. It has more
9 than a thousand technically educated examiners who examine applications for patents.

10 The application is the initial set of papers filed with the PTO by the
11 applicant[s]. In addition to some other papers such as the inventor's oath, the
12 application includes a specification, which must have a written description of the
13 invention telling what the invention is, how it works, and how to make and use it so as
14 to enable others skilled in the art to do so [IF A BEST MODE DEFENSE IS
15 ASSERTED: and what the inventor believed at the time of filing to be the best way of
16 making his or her invention]. The specification concludes with one or more numbered
17 sentences. These are the claims. The purpose of the claims is to particularly point out
18 what the applicant regards as his or her invention. When the patent is eventually issued
19 by the PTO, the claims define the scope of the patent owner's exclusive rights during
20 the life of the patent. In a few minutes, I will describe for you the meaning of the
21 claim[s] of the '___ patent[s].

1 After the applicant files the application, a PTO patent examiner who reviews
2 (or examines) the patent application to determine whether the claims are patentable and
3 whether the specification adequately describes the invention claimed. In examining a
4 patent application, the patent examiner makes a search of the PTO records for prior art
5 to the patent application claims. The examiner considers, among other things, whether
6 each claim defines an invention that is new, useful, and not obvious in view of this
7 prior art. The prior art is defined by statute and I will give specific instructions as to
8 what constitutes prior art to [each/the] patent in suit after the close of the evidence. But
9 generally it is technical information and knowledge that was known to the public either
10 before the invention by the applicant or more than a year before the effective filing date
11 of the application.

12 Following the prior art search and examination of the application, the patent
13 examiner then advises the applicant in writing what the examiner has found and
14 whether he has "allowed" any claim. This writing from the PTO examiner is called an
15 office action. More often than not, the initial office action by the patent examiner
16 rejects the claims. The applicant then responds to this, and sometimes changes the
17 claims or submits new claims. This process may go back and forth between the patent
18 examiner in the PTO and the applicant for several months or even for years until the
19 examiner is satisfied that the application and claims meet the conditions for
20 patentability.

21 The papers generated during this time of corresponding back and forth
22 between the PTO patent examiner and the applicant is what is called the prosecution

1 history. This history of written correspondence is contained in a file in the PTO, and
2 consequently some people over the course of the trial may call this history the file
3 wrapper.

4 5 **B. Patent Litigation**

6 A [person] [company] is said to be infringing on claims of a patent when
7 they, without permission from the patent owner, make, use, import, offer to sell or sell
8 the patented invention, as defined by the claims, within the United States before the
9 term of the patent expires. A patent owner that believes someone is infringing on his or
10 her exclusive rights under a patent may bring a lawsuit like this to stop the alleged
11 infringing acts and recover damages. The patent owner has the burden to prove
12 infringement of the claims of the patent. The patent owner also has the burden to prove
13 damages caused by that infringement, which are adequate to compensate for the
14 infringement.¹ [IF LOST PROFITS WILL BE SOUGHT: Damages may be measured
15 by the patent owner's lost profits caused by the infringement.] Damages may not be
16 less than a reasonable royalty for the use made of the invention.

17 A person sued for allegedly infringing a patent can deny infringement, and
18 can also defend by proving the asserted claim[s] of the patent[s] [is/are] invalid [IF
19 UNENFORCEABILITY IS ASSERTED: or unenforceable]. The accused infringer
20 has the burden to prove invalidity by clear and convincing evidence. In evaluating

¹ If damages are bifurcated, modify this instruction as appropriate to the trial procedures ordered by the Court.

1 infringement or invalidity, each claim is to be evaluated independently. I will now
2 briefly explain the parties' basic contentions in more detail.

3

4

5

1 **II. CONTENTIONS OF THE PARTIES**

2 In this case, the plaintiff, _____, contends that the defendant,
3 _____, makes, uses and sells a [product] that infringes claim XX of the ' ____
4 patent. [The plaintiff] has the burden of proving that [the defendant] infringes the ' ____
5 patent by a preponderance of the evidence. That means that [the plaintiff] must show
6 that it is more likely that [the defendants'] [product] infringes than it does not infringe.

7 There are two ways in which a patent claim can be directly infringed. First,
8 a claim can be literally infringed. Second, a claim can be infringed under what is
9 called the "doctrine of equivalents," which I will address shortly.

10 To determine literal infringement, you must compare the accused product
11 [method] with each claim that [plaintiff] asserts is infringed. It will be my job to tell
12 you what the patent claims mean. You must follow my instructions as to the meaning
13 of the patent claims.

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

19 You may find that [defendant's product or method] infringes a claim of
20 [plaintiff's] patent, even if not every element [step] of that claim is present in
21 [defendant's] [product or method]. However, to do so, you must find that there is an
22 equivalent [component, part or method step] in [defendant's product or method] for

1 each element [step] of the patent claim that is not literally present in [the defendant's]
2 [product or method]. This is called infringement under the doctrine of equivalents.

3 [The plaintiff] has the burden of proving by a preponderance of the evidence
4 that [the defendant's] [product or method] contains the equivalent of each element of the
5 claimed invention that is not literally present in [the defendant's product or method].

6 [The defendant] denies that it is infringing the ' ___ patent. [The defendant]
7 also contends that the ' ___ patent is invalid for several reasons. [INSERT BRIEF
8 DESCRIPTION OF THE PARTICULAR INVALIDITY DEFENSES BEING
9 ASSERTED].

10 Invalidation is a defense to infringement. Therefore, even though the PTO
11 examiner has allowed the claims of the ' ___ patent to issue, you, the jury, have the
12 ultimate responsibility for deciding whether the claims of the ' ___ patent are valid.
13 [The defendant] bears the burden of proving invalidity by clear and convincing
14 evidence. This is a higher burden than a preponderance of the evidence; on the other
15 hand, this does not require proof beyond a reasonable doubt. It will be your job, at the
16 end of this trial, to determine whether the defendant has met its burden of proving the
17 invalidity of the ' ___ patent claims. Clear and convincing evidence is evidence that
18 produces in your mind an abiding conviction that the claims are invalid.

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20
21
22 **III. TRIAL PROCEDURE**

1 We are about to commence the opening statements in the case. Before we
2 do that, I want to explain to you a little bit about the procedures that we will be
3 following during the trial and the format of the trial. This trial, like all jury trials,
4 comes in six stages or phases. We have already been through the first phase, which is
5 to select you as jurors. We are now about to begin the second phase, the opening
6 statements. The opening statements of the lawyers are statements about what each side
7 expects the evidence to show. The opening statements are not evidence in the case.

8 The evidence comes in the next phase, the third phase, when the witnesses
9 will take the witness stand and the documents will actually be offered and admitted into
10 evidence. In the third phase, the plaintiff goes first in calling witnesses to the witness
11 stand. These witnesses will be questioned by the plaintiff's counsel in what is called
12 direct examination. After the direct examination of a witness is completed, the
13 opposing side has an opportunity to cross-examine the witness. After the plaintiff has
14 presented its witnesses, the defendant will call its witnesses, who will also be examined
15 and cross-examined.

16 The evidence often is introduced somewhat piecemeal, so you as jurors need
17 to keep an open mind as the evidence comes in. Wait until all the evidence comes in
18 before you make any decision. In other words, keep an open mind throughout the
19 entire trial.

20 After we conclude the third phase, after the evidence has been presented,
21 then the lawyers again have an opportunity to talk with you in what's called closing
22 argument, which is the fourth phase. Again, what the lawyers say is not evidence. The

1 lawyers' closing arguments to you are for the purpose of helping you in making you
2 determination.

3 After that phase, we reach the fifth phase of the trial, which is when I read
4 you the jury instructions. In that phase, I will instruct you on the law. I have already
5 explained a little bit about the law to you. But later, in this fifth phase of the trial, I
6 will explain the law in much more detail.

7 Finally, in the sixth phase of the trial it will be time for you to deliberate.
8 You can then evaluate the evidence, discuss the evidence among yourselves and make a
9 determination in the case. Remember that it will be your duty to find what the facts are
10 from the evidence as presented at the trial. You, and you alone, are the judges of the
11 facts. You have to apply those facts to the law and the patent claims as I instruct you at
12 the close of the evidence.²

13 You are the judges of the facts. I will explain to you the rules of law which
14 apply to this case, and I will also explain to you the meaning and scope of the patent
15 claims. You must follow that law and claim interpretation whether you agree with it or
16 not. Nothing I say or do during the course of the trial is intended to indicate what your
17 verdict should be.

18
19
20
21 **GLOSSARY OF PATENT TERMS**

² If the Court has ordered bifurcation, consider adding an instruction advising the jury about the procedure the Court has adopted.

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

3 **Claims** - Claims are the numbered sentences appearing at the end of the
4 patent and define the invention. The words of the claims define the scope of the patent
5 owner's exclusive rights during the life of the patent.

6 **File wrapper** - See **prosecution history** below.

7 **License** - Permission to use the patented invention, which may be granted by
8 a patent owner (or a prior licensee) in exchange for a fee called a "royalty" or other
9 consideration.

10 **Office action** - Communication from the patent examiner regarding the
11 specification of the patent application and/or the claims pending in the patent
12 application.

13 **Patent Examiners** - Personnel employed by the PTO who review (examine)
14 patent applications, each in a specific technical area, to determine whether the claims of
15 a patent application are patentable and whether the disclosure adequately describes the
16 invention.

17 **Prior art** - Knowledge that is available to the public either prior to the
18 invention by applicant or more than a year prior to the effective filing date of his/her
19 application. [If § 102(g) prior art that was not publicly available before these dates will
20 be introduced at trial, add to this instruction.]

21 **Prosecution history** - The written record of proceedings in the United States
22 Patent and Trademark Office ("PTO") between the applicant and the PTO. It includes

1 the original patent application and later communications between the PTO and
2 applicant. The prosecution history may also be referred to as the "File wrapper" of the
3 patent during the course of this trial.

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

5 **Specification** - The specification is the information which appears in the
6 patent and concludes with one or more claims. The specification includes the written
7 text, the claims and the drawings. In the specification, the inventor sets forth a
8 description telling what the invention is, how it works, and how to make and use it so
9 as to enable others skilled in the art to do so [and what the inventor believed at the time
10 of filing to be the best way of making his or her invention].

11 **Ordinary Skill In Art** - _____

12

13 **GLOSSARY OF TECHNICAL TERMS**

14

15 [To be agreed upon between the parties]

16

1 **POST TRIAL INSTRUCTIONS**

2 **CLAIM CONSTRUCTION AND LITERAL INFRINGEMENT**

3 **Claim Construction and Infringement No. 1**

4 **Claim Construction and Infringement - Generally**

5 [The plaintiff] has accused [the defendant] of infringing the _____ patent.

6 [The plaintiff] has the burden of proving infringement by a preponderance of the
7 evidence.

8 Before you decide whether or not [the defendant] has infringed the claims of
9 [the plaintiff's] patent or whether or not [the plaintiff's] patent is valid, you will have to
10 understand the patent "claims." The patent claims are numbered paragraphs at the end
11 of the patent. The patent claims involved here are claims _____, beginning at column
12 ____, line ____ of the patent, which is exhibit ____ in evidence. The claims are "word
13 pictures" intended to define, in words, the boundaries of the invention described and
14 illustrated in the patent. Only the claims of the patent can be infringed. Neither the
15 written description, which we have already discussed, nor the drawings of a patent can
16 be infringed. Each of the claims must be considered individually, and not all claims of
17 a patent have to be infringed for the patent to be infringed. To prove patent
18 infringement, [plaintiff] need only establish by a preponderance of the evidence that one
19 claim is infringed.

20 You have heard evidence about both [the plaintiff's] commercial product
21 [process] and [the defendant's] commercial product [process]. However, in deciding
22 the issue of infringement you may not compare [the defendant's] accused product

1 [process] to [the plaintiff's] commercial product [process]. Rather, you must compare
2 [the defendant's] accused product [process] with the claims of the _____ patent when
3 making your decision regarding infringement.

4 35 U.S.C. § 112; *Panduit Corp. v. Dennison Mfg. Co.*, 836 F.2d 1329, 5 USPQ2d
5 1266 (Fed. Cir. 1987); *Smithkline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d
6 878, 8 USPQ2d 1468 (Fed. Cir. 1988); *Amstar Corp. v. Envirotech Corp.*, 823 F.2d
7 1538, 3 USPQ2d 1412 (Fed. Cir. 1987); *Datascope Corp. v. SMEC, Inc.*, 879 F.2d
8 820, 11 USPQ2d 1321 (Fed. Cir. 1989), *cert. denied*, 493 U.S. 1024 (1990).
9

1 **Claim Construction and Infringement No. 2**

2 **Claim Construction**

3 To decide the questions of infringement and validity, you must first
4 understand what the claims of the patent cover, that is, what they prevent anyone else
5 from doing. You must use the same claim meaning for both your decision on
6 infringement and your decision on validity.

7 In this case [the plaintiff] and [the defendant] agree about the meaning of
8 several parts of the claims. [The plaintiff] and [the defendant] do not agree about the
9 meaning of other parts of the claims. It is my duty to interpret these contested words
10 and groups of words for you.

11 I will now tell you the meanings of the following words and groups of words
12 from the patent claims. You must use these meanings in your deliberations concerning
13 both infringement and invalidity.

14 [READ STIPULATIONS AND COURT'S CLAIM CONSTRUCTIONS]

15 *Smithkline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878, 8 USPQ2d 1468
16 (Fed. Cir. 1988); *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707,
17 223 USPQ 1264 (Fed. Cir. 1984); *Markman v. Westview Instruments, Inc.*, 52 F.3d
18 967, 34 USPQ2d 1321 (Fed. Cir. 1995).
19

1 **Claim Construction and Infringement No. 3**

2
3 **Construction of Means-Plus-Function Claims**

4 The following clause used in claim(s) _____ of the _____ patent is in a
5 special form called a "means-plus-function" ["step-plus-function"]:
6 ["_____"] clause. This clause requires a special interpretation under the
7 patent law. The law says that those words shall not cover all means [steps] which
8 perform the recited function of "_____", but shall cover *only* the structure
9 [step] described in the patent specification and drawings that performs the function of
10 "_____" or an equivalent of that structure [step].

11 35 U.S.C. § 112; *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707,
12 223 USPQ 1264 (Fed. Cir. 1984); *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 23
13 USPQ2d 1426 (Fed. Cir. 1992); *Valmont Indus., Inc. v. Reinke Mfg., Inc.*, 983 F.2d
14 1039, 1042-43, 25 USPQ2d 1451, 1454 (Fed. Cir. 1993); *Carroll Touch, Inc. v.*
15 *Electro Mechanical Sys., Inc.*, 15 F.3d 1573 (Fed. Cir. 1993).
16

1 **Claim Construction and Infringement No. 4**

2 **Infringement - Generally**

3 Questions _____ of the Special Verdict read as follows: "[Read text of
4 infringement verdict questions]."

5 I will now instruct you as to the rules you are to follow in arriving at your
6 decisions as to whether [the defendant] has infringed any of the claims of [the
7 plaintiff's] patent.

8 The patent law gives the owner of a valid patent the right to exclude others
9 from making, using [offering for sale] [importing] or selling the patented invention
10 during the term of the patent. The patent law provides that any person or business
11 entity which, without the patent owner's permission, makes, uses, [offers for sale] or
12 sells within the United States [or imports into the United States] any product or method
13 that is covered by at least one claim of a patent before the patent expires, infringes the
14 patent. Here, [the plaintiff] alleges that [defendant's] product [method] infringes one or
15 more claims of [plaintiff's] U.S. Patent No. _____.

16 There are three ways to infringe a patent. One can: (1) directly infringe a
17 patent; (2) induce others to infringe a patent; or (3) contribute to the infringement of a
18 patent by another. I will now explain in more detail each type of infringement alleged
19 in this case.

20 35 U.S.C. §§ 281, 271.
21

1 **Claim Construction and Infringement No. 5**

2 **Direct Infringement - Knowledge of Patent or Intent to Infringe is Immaterial.**

3 In this case, [the plaintiff] asserts that [the defendant] has directly infringed
4 the patent. [Defendant] would be liable for directly infringing [plaintiff's] patent if you
5 find that [plaintiff] has proven by a preponderance of the evidence that [defendant] has
6 made, used [offered for sale] [imported] or sold the invention defined in at least one
7 claim of [plaintiff's] patent.

8 A person can directly infringe a patent without knowing that what it is doing
9 is an infringement of the patent. It may also infringe even though in good faith it
10 believes that what it is doing is not an infringement of any patent.

11 35 U.S.C. § 271(a); *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 478, 181 USPQ
12 673, 677 (1974); *Filmways Pictures, Inc. v. Marks Polarized Corp.*, 552 F. Supp. 863,
13 868, 220 USPQ 870, 873 (S.D.N.Y. 1982).
14

1 **Claim Construction and Infringement No. 6**

2
3 **Inducing Patent Infringement**

4
5 [The plaintiff] asserts that [the defendant] has induced infringement. To
6 show inducement, [the plaintiff] must prove by a preponderance of the evidence that
7 someone has directly infringed the patent. If there is no direct infringement by anyone,
8 [the defendant] has not induced infringement. If you find that someone has directly
9 infringed the _____ patent, it is not necessary to show that [the defendant] itself has
10 directly infringed, if [the plaintiff] proves by a preponderance of the evidence that [the
11 defendant] actively and knowingly aided and abetted that direct infringement. [The
12 plaintiff] must show that [the defendant] actually intended to cause the acts that
13 constitute direct infringement and that [the defendant] knew or should have known that
14 its actions would induce actual infringement. [The defendant] cannot be liable for
15 inducing infringement if it had no reason to be aware of the existence of the patent.

16 If you find that someone has directly infringed the _____ patent and that [the
17 defendant] knew or should have known that its actions would induce direct
18 infringement, [you may find that [the defendant] induced another to infringe [plaintiff's]
19 patent if it provided instructions and directions to perform the infringing act through
20 labels, advertising or other sales methods.] [you may find that [the defendant] induced
21 infringement even if there is an express warning against the infringement, if the
22 material containing the warning nonetheless invites the infringing activities under the
23 circumstances.] [you may find that [the defendant] induced infringement by supplying
24 the components or ingredients that are used in an infringing method or apparatus with

1 the knowledge and intent that its customer would directly infringe by using the
2 components or ingredients to make, use or sell the patented invention.]

3 *NOTE: Use those portions, if any, of the final paragraph that are applicable*
4 *to the case. This instruction should be tailored to relate to the facts in a particular*
5 *case. Special verdicts or interrogatories to the jury may be appropriate on the issue of*
6 *inducing infringement.*

7 4 Donald S. Chisum, *Patents* § 17.04 (1992); *Hewlett-Packard Co. v. Bausch & Lomb,*
8 *Inc.*, 909 F.2d 1464, 15 USPQ2d 1525 (Fed. Cir. 1990); *Manville Sales Corp. v.*
9 *Paramount Sys., Inc.*, 917 F.2d 544, 16 USPQ2d 1587 (Fed. Cir. 1990); *CR Bard,*
10 *Inc. v. Advanced Cardiovascular Sys., Inc.*, 911 F.2d 670, 15 USPQ2d 1540 (Fed. Cir.
11 1990).
12

1 **Claim Construction and Infringement No. 7**

2
3 **Contributory Infringement**

4
5 [The plaintiff] [also] asserts that [the defendant] is liable for contributory
6 infringement. [The plaintiff] has the burden to prove contributory infringement by a
7 preponderance of the evidence. To establish contributory infringement by [the
8 defendant], [plaintiff] must first show that someone directly infringed the [____]
9 patent; however, [the plaintiff] does not need to prove that [the defendant] itself directly
10 infringed. If there is no direct infringement by anyone, there can be no contributory
11 infringement.

12 If you find someone has directly infringed the patent, then contributory
13 infringement exists if [plaintiff] proves that:

- 14 (1) [the defendant] sold or supplied;
15 (2) a material component of the patented invention that is
16 not a staple article of commerce capable of substantial
17 noninfringing use;
18 (3) with knowledge that the component was especially
19 made or adopted for use in an infringing product [method].

20 A "staple article of commerce capable of substantial noninfringing use" is
21 something that has uses other than as a part or component of the patented product [other
22 than in the patented method] and that those other uses that are not occasional,
23 farfetched, impractical, experimental or hypothetical.

24 *Preemption Devices, Inc. v. Minnesota Mining & Mfg. Co.*, 630 F. Supp. 463, 229
25 USPQ 255 (E.D. Pa. 1985), *aff'd in part, vacated in part, and remanded*, 803 F.2d

1 1170, 231 USPQ 297 (Fed. Cir. 1986); *In re Certain Molded-In Sandwich Panel*
2 *Inserts*, 218 USPQ 832 (Ct. Int'l. Trade 1982), *aff'd*, 721 F.2d 1305, 219 USPQ 1142
3 (1983); *Oxy Metal Indus. Corp. v. Quin-Tec, Inc.*, 216 USPQ 318, 324 (E.D. Mich.
4 1982); 4 Donald S. Chisum, *Patents* § 17.03[3], at n.6 (1992).
5

1 **Claim Construction and Infringement No. 8**

2
3 **Two Types of Direct Infringement; Literal Infringement**

4
5 There are two ways in which a patent claim can be directly infringed. First,
6 a claim can be literally infringed. Second, a claim can be infringed under what is
7 called the "doctrine of equivalents," which I will address shortly.

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

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

16 You must be certain to compare [defendant's] accused product [method] with
17 each claim it is alleged to infringe. It should be compared to the intentions described in
18 the patent claim, not to [plaintiff's] preferred or commercial embodiment of the claimed
19 invention.

20 *Martin v. Barber*, 755 F.2d 1564, 1567, 225 USPQ 233, 234-35 (Fed. Cir. 1985);
21 *Amstar Corp. v. Envirotech Corp.*, 730 F.2d 1476, 1484, 221 USPQ 649, 655 (Fed.
22 Cir.), *cert. denied*, 469 U.S. 924 (1984); *Mannesmann Demag Corp. v. Engineered*
23 *Metal Prods. Co.*, 793 F.2d 1279, 1281-82, 230 USPQ 45, 46 (Fed. Cir. 1986).
24

1 **Claim Construction and Infringement No. 9**

2 **Infringement of Means-Plus-Function Claims**

3 I have previously instructed you that claims _____ of the patent contain
4 means-plus-function [step-plus-function] clauses. These clauses read as follows:
5 "_____" To determine whether [the plaintiff] has proven infringement of these claims,
6 you must first determine whether or not [plaintiff] has shown that any structure [step] in
7 [defendant's] product [method] performs the function of "_____" If you find that it
8 does, you must then determine whether or not [the plaintiff] has shown that that
9 structure [step] is identical to any structure [step] disclosed in the patent specification
10 for performing the function of _____. If you find that it is, then the means-plus-
11 function [step-plus-function] clause of [plaintiff's] patent is found in [defendant's]
12 product [method]. If you find that the structure of [defendant's] product [step] is not
13 identical to a structure [step] that performs that function in the patent specification, then
14 you must consider whether or not [defendant's] product [method] has a structure [step]
15 that is equivalent to any structure described in the patent specification for performing
16 that function.

17 Comment - The Federal Circuit has not really defined equivalents for 112-6.
18 Until they do, I think we have to leave it alone.

19 To show infringement, it is [the plaintiff's] burden to prove, by a
20 preponderance of the evidence, that the part of [defendant's] product [step in
21 defendant's method] that performs the function of "_____" is identical to, or equivalent

1 to, a structure [step] described in the specification for performing the function of

2 "_____."

3 35 U.S.C. § 112; *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707,
4 223 USPQ 1264 (Fed. Cir. 1984); *Texas Instruments, Inc. v. U.S. Int'l Trade Comm'n*,
5 805 F.2d 1558, 231 USPQ 833 (Fed. Cir. 1986); *Read Corp. v. Portec, Inc.*, 970 F.2d
6 816, 23 USPQ2d 1426 (Fed. Cir. 1992); *Valmont Indus., Inc. v. Reinke Mfg., Inc.*,
7 983 F.2d 1039, 1042-43, 25 USPQ2d 1451, 1454 (Fed. Cir. 1993); *Carroll Touch,*
8 *Inc. v. Electro Mechanical Sys., Inc.*, 15 F.3d 1583 (Fed. Cir. 1993); *Rite-Hite Corp.*
9 *v. Kelley Co.*, 819 F.2d 1120, 1124-25, 2 USPQ2d 1915, 1918 (Fed. Cir. 1987).

10

1 **Claim Construction and Infringement No. 10**

2
3 **Infringement of Dependent Claims**

4
5 There are two different types of claims in the patent. One type of claim is
6 called an independent claim. The other type of claim is called a dependent claim.

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

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

13 For example, Claim 1 is an independent claim and recites several elements.
14 Claim 2 is a dependent claim that refers to Claim 1 and includes an additional element
15 or limitation. [Identify the differences between Claim 1 and Claim 2.] Claim 2
16 requires each of the elements of Claim 1, as well as the additional elements identified in
17 Claim 2 itself.

18 To establish literal infringement of claim 2, [plaintiff] must show by a
19 preponderance of the evidence that [the defendant's] product [method] includes each
20 and every element of claim 2 as I have interpreted it for you.

21 If you find that the independent claim from which claim 2 depends is not
22 literally infringed, then you cannot find that dependent claim 2 is literally infringed.

23 *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 626, 225 USPQ
24 634, 642-43 (Fed. Cir.), *cert. dismissed*, 474 U.S. 976 (1985); *Wilson Sporting Goods*
25 *v. David Geoffrey & Assocs.*, 904 F.2d 677, 14 USPQ2d 1942 (Fed. Cir.); 35 U.S.C.
26 § 112; *cert. denied* 498 U.S. 992 (1990); *Fromson v. Advance Offset Plate, Inc.*, 720

1 F.2d 1565, 219 USPQ 1137 (Fed. Cir. 1983); *SRI Int'l v. Matsushita Elec. Corp.*, 775
2 F.2d 1107, 227 USPQ 577 (Fed. Cir. 1985); *Tandon Corp. v. U.S. Int'l Trade*
3 *Comm'n*, 831 F.2d 1017, 1023-24, 4 USPQ2d 1283, 1288-89 (Fed. Cir. 1987).
4

1 **Claim Construction and Infringement No. 11**

2
3 **Infringement of Open Ended or "Comprising" Claims**

4
5 The preamble to claim(s) _____ use(s) the phrase [recite the preamble]
6 "comprising." The word "comprising" means "including the following but not
7 excluding others." Comprising claims are open-ended.

8 If you find that [defendant's] product [method] includes all of the elements
9 in any one of claims _____, the fact that [defendant's] product [method] might include
10 additional components [method steps] would not avoid literal infringement of such
11 claims.

12 *Amstar Corp. v. Envirotech Corp.*, 730 F.2d 1476, 1484, 221 USPQ 649, 655 (Fed.
13 Cir.), *cert. denied*, 469 U.S. 924 (1984); *AB Dick Co. v. Burroughs Corp.*, 713 F.2d
14 700, 703, 218 USPQ 965, 967_68 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1042
15 (1984); *Mannesmann Demag Corp. v. Engineered Metal Prods. Co.*, 793 F.2d 1279,
16 1283, 230 USPQ 45, 47 (Fed. Cir. 1986); *Moleculon Research Corp. v. CBS, Inc.*, 793
17 F.2d 1261, 1271, 229 USPQ 805, 812 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 1030
18 (1987).
19

1 **Claim Construction and Infringement No. 12**

2
3 **Infringement of "Consisting Essentially of" Claims**

4
5 The preamble to claim(s) _____ use(s) the language [recite the preamble]
6 "consisting essentially of" certain elements [method steps]. The words "consisting
7 essentially of" do not mean the same thing as "including" or "containing." Rather, the
8 words "consisting essentially of" must be interpreted to mean including only the
9 elements specified in the claims and other elements [method steps] that do not
10 materially affect the basic and novel characteristics of the invention defined in those
11 claims. You are instructed that to prove literal infringement of such claim, [the
12 plaintiff] must show by a preponderance of the evidence that [the defendant's] product
13 [method] includes every element recited in the claim and that any additional elements
14 [method steps] in [the defendant's] product but not recited in the claim do not materially
15 affect the basic and novel functional characteristics of the invention defined in that
16 claim.

17 *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (C.C.P.A. 1976).

18

1 **Claim Construction and Infringement No. 13**

2 **Infringement of "Consisting of" Claims**

3 The preamble to claim(s) _____ use(s) the language [recite the preamble]
4 "consisting of" certain elements [method steps]. These words "consisting of" do not
5 mean the same thing as "including" or "containing." Rather, the words "consisting of"
6 must be interpreted to mean only the elements [method steps] recited in the claim and
7 no additional elements [steps]. You are instructed that to prove literal infringement of
8 such a claim, [the plaintiff] must show by a preponderance of the evidence that [the
9 defendant's] product [method] includes every element recited in the claim and no
10 additional elements [method steps].

11 *In re Certain Slide Fastener Stringers & Machs., Etc.*, 216 USPQ 907, 915-16 (Ct.
12 Int'l. Trade 1981); 2 Donald S. Chisum, *Patents* § 8.06[1][b], at 8-75 (1985);
13 _____ Rosenberg, *Patent Law Fundamentals* § 14.05[2], at 14-16.1 -- 14-17
14 (1985).
15

1 **Claim Construction and Infringement No. 14**

2
3 **Reverse Doctrine of Equivalents**

4
5 Question(s) _____ of the Special Verdict reads as follows: "[Read Special
6 Verdict questions regarding reverse doctrine of equivalents]."

7 You are to answer Question(s) _____ of the Special Verdict only if you have
8 answered "Yes" to Question(s) _____ of the Special Verdict [the literal infringement
9 questions].

10 You are instructed that even if you find that the accused product [method]
11 includes all the elements of [plaintiff's] patent claim, if you also find that the accused
12 product [method] is so far changed in principle that although it performs the same or a
13 similar function as that defined by that patent claim, it does so in a substantially
14 different way, you must find that [the defendant] has not infringed that patent claim.

15 *Boyden Power-Brake Co. v. Westinghouse*, 170 U.S. 537, 569 (1898); *Graver Tank &*
16 *Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608, *reh'g denied*, 340 U.S. 845
17 (1950); *Leesona Corp. v. United States*, 530 F.2d 896, 192 USPQ 672 (Ct. Cl. 1976);
18 *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1122-25, 227 USPQ 577,
19 586-88 (Fed. Cir. 1985).

20
21 *NOTE: This instruction should be given only if the accused infringer has established a*
22 *prima facie case of non-infringement under the reverse doctrine of equivalents. SRI*
23 *International, supra, at 1123-24, 227 USPQ at 587-88.*

DOCTRINE OF EQUIVALENTS

You may find that [defendant's product or method] infringes a claim of [plaintiff's] patent, even if not every element [step] of that claim is present in defendant's [product or method]. However, to do so, you must find that there is an equivalent [component, part or method step] in [defendant's product or method] for each element [step] of the patent claim that is not literally present in the defendant's [product or method]. This is called infringement under the doctrine of equivalents.³

The plaintiff has the burden of proving by a preponderance of the evidence that the defendant's [product or method] contains the equivalent of each element [step] of the claimed invention that is not literally present in [the defendant's product or method].⁴ You are to determine whether there is infringement under the doctrine of equivalents based upon the claims of the patent as I have interpreted them for you. If you find that any element [step] of a claim of the patent is simply not present in the [defendant's product or method] either literally or equivalently, then you may not find that the claim is infringed.⁵ You may consider the testimony of the experts or others who testified in this case, and the documents introduced into evidence, including the prior art, and the like.

In deciding whether there is infringement under the doctrine of equivalents, each element [step] contained in a patent claim is important. Therefore, the question is whether the [defendant's product or method] contains an equivalent for each element

³*Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 117 S.Ct. 1040 (1997); *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 607-610 (1950).

⁴*Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1520 (Fed. Cir. 1995), *rev'd on other grounds*, 117 S.Ct. 1040 (1997).

1 [step] of the claim. The question is not whether the [defendant's product or method]
2 overall is equivalent to the plaintiff's invention as a whole.⁶ The doctrine of equivalents
3 does not require complete equivalence for every purpose and in every respect. You
4 must consider the purpose of the [ingredient, step or elements], and the function it is
5 intended to perform.⁷ It is not necessary that any single component of [the defendant's
6 product or method] be equivalent to a particular element [step] of the claimed
7 invention; two or more components of [the defendant's product or method] may operate
8 together to be an equivalent of a single element [step] of the claimed invention. What
9 is important is that there must be an equivalent for each element [step] of the claim
10 somewhere in the accused device.⁸

11 You should consider whether the substituted element [step] represents a
12 change that a person of ordinary skill in the art would have considered insubstantial at
13 the time of the infringement. In determining whether the one or more components of
14 [the defendant's product or method] are equivalent to an element of the claimed
15 invention, you should consider whether at the time of infringement persons reasonably
16 skilled in the art would have known of the interchangeability of that component or those
17 components with the element [step] claimed in the patent claim. Although the known
18 interchangeability of the accused and claimed elements [step] is not necessary in order
19 to find infringement, known interchangeability is evidence that one of ordinary skill in

⁵ *Athletic Alternative, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1581 (Fed. Cir. 1996).

⁶ *Warner-Jenkinson*, 117 S.Ct. at 1049.

⁷ *Graver Tank*, 339 U.S. at 609, quoted with approval in *Warner-Jenkinson*, 117 S.Ct. at 1047.

⁸ *Corning Glass Works v. Sumitomo Elec., U.S.A.*, 868 F.2d 1251, 9 U.S.P.Q.2d 1962 (Fed. Cir. 1989).

1 the relevant art would have considered the change insubstantial. Depending on the
2 circumstances, evidence of independent experimentation by the defendant may be
3 considered as evidence that the substituted element [step] was not known to be
4 interchangeable with the element claimed in the patent claim.⁹

5 Another test you may apply to determine equivalence is whether one of
6 ordinary skill in the art would consider that a [component, part or step] of [defendant's
7 product or method] performs substantially the same function in substantially the same
8 way to produce substantially the same result compared to the corresponding element
9 [step] of plaintiff's claimed [product or method].¹⁰ Exact identity of function, way and
10 result is not required; substantial identity is sufficient.¹¹

11 The question of whether a [component, ingredient or method step] of
12 [defendant's product or method] is equivalent to the corresponding element [step] in
13 plaintiff's claims is to be determined based on the knowledge of one of ordinary skill in
14 the art as of the time of the alleged infringement, not when the patent application was
15 filed or when the patent issues.¹²

17 **LIMITATIONS ON THE DOCTRINE OF EQUIVALENTS**

18 **Prior Art**

⁹ *Warner-Jenkinson*, 117 S.Ct. at 1052.

¹⁰ *Graver Tank*, 339 U.S. at 608; *Moeller v. Ionetics, Inc.*, 794 F.2d 1565, 229
U.S.P.Q. 992, 995 (Fed. Cir. 1986).

¹¹Note: Because exact identity of function is required for equivalence under 35 U.S.C.
§ 112, ¶ 6, but is not necessarily required for a finding of equivalence under the
doctrine of equivalents, a plaintiff asserting a means-plus-function claim may be entitled
to an instruction on the doctrine of equivalents even if there is no literal infringement.

1 You may not find that a component in [the defendant's product or method] is
2 equivalent to an element of the patent claim if by doing so you would extend the
3 coverage of the patent to include inventions that were already in the prior art.¹³

4
5 **Separate Patentability**

6 *[Use if defendant has patent covering the feature of the accused device or method in*
7 *question. See Note below.]*¹⁴C was not an obvious change when it decided that the new
8 combination deserves patent protection. Id. In this situation, this instruction should be
9 given.

¹²*Atlas Powder Company v. E.I. duPont de Nemours & Co.*, 750 F.2d 1569, 1579-1580 (Fed. Cir. 1984); *Warner-Jenkinson*, 117 S.Ct. at 1053.

¹³*Wilson Sporting Goods Co. v. David Geoffrey & Assoc.*, 904 F.2d 677 (Fed. Cir. 1990).

¹⁴The Federal Circuit has approved the introduction of the defendant's patent as evidence that the defendant's product does not infringe under the doctrine of equivalents. *Zygo Corp. v. Wyko Corp.*, 79 F.3d 1563, 1570 (Fed. Cir. 1996).

This instruction is not always appropriate, however. Suppose the patent-in-suit covers a combination comprising elements A + B + C. If the defendant obtains a patent on an invention covering A + B + C + D, then the defendant's patent would not be evidence of non-infringement because it would merely reflect the addition of another feature whose presence or absence would be irrelevant in an infringement analysis. *Roton Barrier Inc. v. Stanley Works*, 79 F.3d 1112, 1128 (Fed. Cir. 1996) (Nies, J., concurring). This instruction should not be given in this situation.

If, however, that the defendant obtains a patent on the combination A + B + D (assuming that the plaintiff's patent was before the examiner), the defendant's patent would be evidence of non-infringement because the PTO had to find that substituting D in place of

1 In deciding whether the ____ in the [defendant's method or product] is
2 equivalent to the [claim element] claimed in the ____ patent claims you are entitled to
3 take into account the fact that the defendant has its own patent on this feature of its
4 [product or method]. Evidence that the defendant has its own patent may be relevant to
5 the question of whether there is infringement under the doctrine of equivalents.¹⁵

6 Depending on the circumstances, this may be evidence that the Patent and Trademark
7 Office found that the substitution of _____ in the defendant's [product or method]
8 was a substantial change from the [component, ingredient or step] claimed in the patent
9 claims.¹⁶ The fact that the defendant has a separate patent does not prevent you from
10 finding infringement.¹⁷ But it may be relevant to what the Patent Office did, or did not,
11 consider to be a substantial change.¹⁸

12
13 **Prosecution History Estoppel**

¹⁵Hilton Davis, 62 F.3d at 1520.

¹⁶Roton Barrier, Inc. v. Stanley Works, 79 F.3d 1112, 1128 (Fed. Cir. 1996) (Nies, J., concurring); Zygo Corp. v. Wyko Corp., 79 F.3d 1563, 1570 (Fed. Cir. 1996) (Nies, J.)

¹⁷Atlas Powder Co. v. E.I. duPont de Nemours & Co., 7509 F.2d 1569, 1580-81 (Fed. Cir. 1984).

¹⁸Hoganas AB v. Dresser Indus. Inc., 9 F.3d 948, 954 (Fed. Cir. 1993); Zygo Corp. v. Wyko Corp., 79 F.3d 1563, 1570 (Fed. Cir. 1996).

1 You are instructed that the doctrine of equivalents is limited by what is
2 called "prosecution history estoppel." As you have already heard, during prosecution
3 of the patent, arguments and amendments are often made in an attempt to convince the
4 Patent Examiner and the Patent Office that the claimed invention is entitled to a patent
5 in view of the prior art before the Examiner. The applicant, in other words, may
6 amend his patent claims or submit arguments in order to define or narrow the meaning
7 of the claims so that they are distinguished from the prior art. Once it has done so, it
8 cannot later argue that it is entitled to patent coverage under the doctrine of equivalents
9 that would be so broad that it would cover the same feature the applicant distinguished
10 from his invention during his prosecution of the patent.¹⁹

11 In this case, you are instructed that prosecution history estoppel applies
12 because, in obtaining the patent, plaintiff
13 _____ . Specifically, [insert details as to the
14 amendment or argument].

15 It is up to you to decide whether, in arguing that [defendant's feature] is
16 equivalent to [the claim element], plaintiff is trying to enlarge the coverage of the
17 claims of its patent to cover the same feature that it distinguished from its invention
18 while it was prosecuting its patent.

¹⁹ *Warner-Jenkinson*, 117 S.Ct. at 1050.

1 **ANTICIPATION**

2 **Anticipation No. 1**

3 **Anticipation**

4 One of the requirements for a valid patent is that the invention defined in the claims
5 must be new. This is known as the requirement of novelty. Something that shows that
6 an invention was not new or novel is called an anticipation. There are several
7 categories of events, all defined by the patent laws, that can anticipate and invalidate a
8 patent. In this case, [the defendant] contends that the claims of the _____ patent are
9 anticipated on _____ bases. [DESCRIBE BRIEFLY EACH BASIS FOR [THE
10 DEFENDANT'S] INVALIDITY DEFENSE, FOR EXAMPLE: "FIRST, [THE
11 DEFENDANT] CONTENDS THAT THE INVENTION OF CLAIMS 1, 2 AND 3 OF
12 THE _____ PATENT WAS DESCRIBED IN THE JULY, 1983 ARTICLE
13 PUBLISHED BY JONES IN THE JOURNAL OF ENDOCRINOLOGY."]

14 I will now instruct you as to the rules of law that you must follow in deciding
15 whether or not the claims of the _____ patent were anticipated.

16 First, [defendant] has the burden of proving anticipation by clear and convincing
17 evidence.

1 Second, a [publication] [invention, public use, sale, patent, etc.] anticipates a claim
2 if it discloses the claimed invention sufficiently that a person of ordinary skill in the art
3 could take its teachings together with his own knowledge of the art and be in possession
4 of the claimed invention.²⁰ To establish that anticipation exists, [the defendant] must
5 show that each of the elements recited in the claim was [disclosed] [embodied] in the
6 particular item claimed to be an anticipation. If every element of the claimed invention
7 is shown to be present in the prior [publication] [invention, patent, public use, etc.], the
8 patent claim is anticipated.²¹

²⁰ In re-Graves 69F3d1147,1152

²¹ NOTE: This instruction may be inappropriate in some chemical cases. Compare, *In re Meyer*, 599 F.2d 1026, 202 U.S.P.Q. 175 (C.C.P.A., 1979) and *Ex Parte Greenhalgh*, 148 U.S.P.Q. 89 (Bd. Apps. 1965) with *In re Parameswar Sivaramakrishnan*, 673 F.2d 1383, 213 U.S.P.Q. 441 (C.C.P.A. 1982) and *Ex Parte Allais*, 152 U.S.P.Q. 66 (Bd. Apps. 1965).

1 Third, there is no anticipation unless every one of the elements of the claimed
2 invention is found in a single [prior publication], [prior invention] [prior public use]
3 [prior patent], [prior knowledge] [prior sale]. You may not combine two or more items
4 of prior art to make out an anticipation. You should, however, take into consideration
5 not only what is expressly disclosed or embodied in the particular item of prior
6 [publication] [invention, etc], but also what inherently occurred as a natural result of its
7 practice. A party claiming inherency must prove it by clear and convincing evidence.
8 It must show that the [process] [publication] [etc.] always inherently produces a
9 [product] [process] meeting all of the claim limitations. In determining whether or not
10 every one of the elements of the claimed invention is found in the prior [publication]
11 [etc.] you should take into account what a person of ordinary skill in the art would have
12 understood from his or her examination of the particular [publication] [invention, etc.]

13 You must keep these requirements in mind and apply them to each kind of
14 anticipation you consider in this case. There are additional requirements that apply to
15 the particular categories of anticipation that [the defendant] contends apply in this case.
16 I will now instruct you about those.

1 *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed Cir. 1983); *In*
2 *re Felton*, 484 F.2d 495, 179 USPQ 295 (C.C.P.A. 1973); *Lindemann Maschinenfabrik*
3 *GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir.
4 1984); *In re Marshall*, 578 F.2d 301, 198 USPQ 344 (C.C.P.A. 1978); *Shatterproof*
5 *Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 225 USPQ 634 (Fed. Cir.),
6 *cert. dismissed*, 474 U.S. 976 (1985); *SSIH Equip. S.A. v. U.S. Int'l Trade Comm'n*,
7 718 F.2d 365, 218 USPQ 678 (Fed. Cir. 1983); *Tyler Refrigeration v. Kysor Indus.*
8 *Corp.*, 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1985); *WL Gore & Assocs., Inc. v.*
9 *Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S.
10 851 (1984); *Buildex, Inc. v. Kason Indus., Inc.*, 849 F.2d 1461, 7 USPQ2d 1325 (Fed.
11 Cir. 1988); *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 231 USPQ
12 644, *modified on reh'g*, 1 USPQ2d 1209 (Fed. Cir. 1986); *Constant v. Advanced*
13 *Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir.), *cert. denied*, 488
14 U.S. 892 (1988); *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 20
15 USPQ2d 1746 (Fed. Cir. 1991); *Minnesota Mining & Mfg. Co. v. Johnson & Johnson*
16 *Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Standard*
17 *Havens Prods., Inc. v. Gencor Indus., Inc.*, 953 F.2d 1360, 21 USPQ2d 1321 (Fed.
18 Cir. 1991), *cert. denied* 113 S. Ct. 60 (1992); *Verdegaal Bros., Inc. v. Union Oil Co.*,
19 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987); *Hughes Aircraft Co. v. United States*,
20 8 USPQ2d 1580 (Ct. Cl. 1988); *HK Regar & Sons v. Scott & Williams, Inc.*, 63 F.2d
21 229 (2d Cir. 1933); *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, Inc.*, 45
22 F.3d 1550, 33 USPQ2d 1496 (Fed. Cir. 1995).

1 **Anticipation No. 2**

2 **Prior Public Knowledge**

3 [The defendant] contends that claim[s] _____ of the _____ patent were
4 anticipated because the invention defined in that claim [those claims] was publicly
5 known in the United States before it was invented by _____.¹

6 A patent claim is invalid if the invention recited in that claim was publicly known
7 by others in the United States before the patent applicant invented it. Private or secret
8 knowledge, such as knowledge confidentially disclosed within a small group, is not
9 enough to invalidate a patent claim.² Similarly, if something is only publicly known
10 outside of the United States, then the claims are not invalid.

11 35 U.S.C. § 102; *Trend Prods. Co. v. Metro Indus., Inc.*, 10 USPQ2d 1531 (C.D. Cal.
12 1989); *Rosemount, Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540, 221 USPQ 1
13 (Fed. Cir. 1984).
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¹ 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 claims
____ of the ____ patent was invented on
_____."

² Additional instructions may be required here to give the jury guidance on the specific facts of the case.

1 **Anticipation No. 3**

2 **Prior Public Use**

3 [The defendant] contends that claim[s] _____ of the _____ patent were
4 anticipated because the invention defined in that claim [those claims] was publicly used
5 in the United States [before it was invented by _____] [more than one year before
6 _____ filed his U.S. patent application on _____, 19__].

7 A patent claim is invalid if the invention defined by that claim [was publicly used by
8 someone other than [the patentee] in the United States before it was invented by [the
9 patentee], [was publicly used by anyone in the United States more than one year before
10 [the patentee] filed his patent application], that is before [date].

11 Alternative A - Public Use By A Third Party. Here, [defendant] contends that the
12 claimed invention was in public use by [third party] before _____. Secret use
13 by a third party is not an invalidating public use. Thus, if the particular device,
14 [composition] [process] was used by [third party], under circumstances of secrecy, that
15 does not invalidate the patent. Likewise, sale by [third party] of a product made by the
16 patented process is not a public use of the *process* if the process was practiced in
17 secrecy and the public could not learn the process from the product sold.

18 Alternative B - Public Use By The Patentee. Here, [defendant] contends that the
19 claimed invention was in public use by [patentee] before _____.

20 A public use is shown if [patentee] obtained a commercial benefit from the
21 invention, even if the invention was not disclosed, before _____.¹

¹ Note that this statement does not apply to offers to sell rights in the invention itself or to efforts to raise capital from potential investors. Moleculon Research Corp. v.

1 35 U.S.C. § 102(a), (b); *In re Caveney*, 761 F.2d 671, 226 USPQ 1 (Fed. Cir. 1985);
2 *DL Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 219 USPQ 13 (Fed. Cir.
3 1983); *Honeywell, Inc. v. Sperry Rand Corp.*, 180 USPQ 673 (D. Minn. 1973); *In re*
4 *Smith*, 714 F.2d 1127, 218 USPQ 976 (Fed. Cir. 1983); *TP Lab., Inc. v. Professional*
5 *Positioners, Inc.*, 724 F.2d 965, 220 USPQ 577 (Fed. Cir.), *cert. denied*, 469 U.S.
6 826, 224 USPQ 616 (1984); *WL Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d
7 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *Moleculon*
8 *Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986);
9 *Kinzenbaw v. Deere & Co.*, 741 F.2d 383, 222 USPQ 929 (Fed. Cir. 1984), *cert.*
10 *denied*, 470 U.S. 1004 (1985); *JA LaPorte, Inc. v. Norfolk Dredging Co.*, 787 F.2d
11 1577, 229 USPQ 435 (Fed. Cir.), *cert. denied*, 479 U.S. 884 (1986); *Grain Processing*
12 *Corp. v. American Maize-Prods. Co.*, 840 F.2d 902, 5 USPQ2d 1788 (Fed. Cir. 1988).
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CBS, Inc., 793 F.2d 1261, 1267, 229 U.S.P.Q. 805, 809 (Fed. Cir. 1986); Pre-emption Devices, Inc. v. Minnesota Mining & Mfg. Co., 732 F.2d 903, 906, 221 U.S.P.Q. 841, 843 (Fed. Cir. 1984).

1 35 U.S.C. § 102; *Barmag Barmer Maschinenfabrik AG v. Murata Mach. Ltd.*, 731
2 F.2d 831, 221 USPQ 561 (Fed. Cir. 1984); *In re Caveney*, 761 F.2d 671, 226 USPQ 1
3 (Fed. Cir. 1985); *Crane Co. v. Goodyear Tire & Rubber Co.*, 577 F. Supp. 186, 219
4 USPQ 1100 (N.D. Ohio 1983); *DL Auld Co. v. Chroma Graphics Corp.*, 714 F.2d
5 1144, 219 USPQ 13 (Fed. Cir. 1983); *Pennwalt Corp. v. Akzona, Inc.*, 740 F.2d 1573,
6 222 USPQ 833 (Fed. Cir. 1984); *In re Theis*, 610 F.2d 786, 204 USPQ 188 (C.C.P.A.
7 1979); *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 225 USPQ
8 634 (Fed. Cir.), *cert. dismissed*, 474 U.S. 976 (1985); *Buildex, Inc. v. Kason Indus.,*
9 *Inc.*, 849 F.2d 1461, 7 USPQ2d 1325 (Fed. Cir. 1988); *AB Chance Co. v. RTE Corp.*,
10 854 F.2d 1307, 7 USPQ2d 1881 (Fed. Cir. 1988); *RCA Corp. v. Data Gen. Corp.*, 887
11 F.2d 1056, 12 USPQ2d 1449 (Fed. Cir. 1989); *King Instrument Corp. v. Otari Corp.*,
12 767 F.2d 853, 226 USPQ 402 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1016 (1986);
13 *Great N. Corp. v. Davis Core & Pad Co.*, 782 F.2d 159, 228 USPQ 356 (Fed. Cir.
14 1986); *JA LaPorte, Inc. v. Norfolk Dredging Co.*, 787 F.2d 1577, 229 USPQ 435 (Fed.
15 Cir.), *cert. denied*, 479 U.S. 884 (1986); *Sonoscan, Inc. v. Sonotek, Inc.*, 936 F.2d
16 1261, 19 USPQ2d 1156 (Fed. Cir. 1991); *Western Marine Elecs., Inc. v. Furuno Elec.*
17 *Co.*, 764 F.2d 840, 226 USPQ 334 (Fed. Cir. 1985); *Keystone Retaining Wall Sys.,*
18 *Inc. v. Westrock, Inc.*, 997 F.2d 1444, 27 USPQ2d 1297 (Fed. Cir. 1993); *In re*
19 *Brigance*, 792 F.2d 1103, 229 USPQ 988 (Fed. Cir. 1986); *UMC Elecs. Co. v. United*
20 *States*, 816 F.2d 647, 2 USPQ2d 1465 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1025
21 (1988).

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1 The experimentation must relate to the features of the claimed invention, and it must
2 be for the purpose of technological improvement, not commercial exploitation. If any
3 commercial exploitation does occur, it must be merely incidental to the primary
4 purpose of experimentation. A test done primarily for marketing, and only incidentally
5 for technological improvement, is a public use.

6 *In re Corcoran*, 640 F.2d 1331, 208 USPQ 867 (C.C.P.A. 1981); *City of Elizabeth v.*
7 *American Nicholson Pavement Co.*, 97 U.S. 126 (1877); *DL Auld Co. v. Chroma*
8 *Graphics Corp.*, 714 F.2d 1144, 219 USPQ 13 (Fed. Cir. 1983); *TP Lab., Inc. v.*
9 *Professional Positioners, Inc.*, 724 F.2d 965, 220 USPQ 577 (Fed. Cir.), *cert. denied*,
10 469 U.S. 826, 224 USPQ 616 (1984); *Pennwalt Corp. v. Akzona, Inc.*, 740 F.2d 1573,
11 222 USPQ 833 (Fed. Cir. 1984); *In re Smith*, 714 F.2d 1127, 218 USPQ 976 (Fed.
12 Cir. 1983); *In re Theis*, 610 F.2d 786, 204 USPQ 188 (C.C.P.A. 1979); *Manville Sales*
13 *Corp. v. Paramount Sys., Inc.*, 917 F.2d 544, 16 USPQ2d 1587 (Fed. Cir. 1990);
14 *Grain Processing Corp. v. American Maize-Prods. Co.*, 840 F.2d 902, 5 USPQ2d 1788
15 (Fed. Cir. 1988); *U.S. Envtl. Prods., Inc. v. Westall*, 911 F.2d 713, 15 USPQ2d 1898
16 (Fed. Cir. 1990); *Hycor Corp. v. Schlueter Co.*, 740 F.2d 1529, 222 USPQ 553 (Fed.
17 Cir. 1984); *LaBounty Mfg., Inc. v. U.S. Int'l Trade Comm'n*, 958 F.2d 1066, 22
18 USPQ2d 1025 (Fed. Cir. 1992); *In re Hamilton*, 882 F.2d 1576, 11 USPQ2d 1890
19 (Fed. Cir. 1989).
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1 **Anticipation No. 6**

2 **Printed Publication**

3 [The defendant] contends that claim[s] _____ of the _____ patent were
4 anticipated because the invention defined in [that claim] [those claims] was described in
5 a printed publication [more than one year before _____ filed his U.S. patent
6 application on _____, 19__] [before _____ invented his invention.]

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

10 A printed publication must be reasonably accessible to those members of the public
11 who would be interested in its contents. It is not necessary that the printed publication
12 be available to every member of the public.

13 So long as the printed publication was available to the public, the form in which the
14 information was recorded is unimportant. The information must, however, have been
15 maintained in some permanent form, such as [printed or typewritten pages magnetic
16 tape, microfilm, photographs, photocopies]. [Printed publications may include issued
17 patents].

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

10 35 U.S.C. § 102; *In re Coker*, 463 F.2d 1344, 175 USPQ 26 (C.C.P.A. 1972); *In re*
11 *Donohue*, 632 F.2d 123, 207 USPQ 196 (C.C.P.A. 1980); *Deep Welding, Inc. v.*
12 *Sciaky Bros., Inc.*, 417 F.2d 1227, 163 USPQ 144 (7th Cir. 1969), *cert. denied*, 397
13 U.S. 1037, 165 USPQ 290 (1970); *Phillips Petroleum Co. v. Ladd*, 219 F. Supp. 366,
14 138 USPQ 421 (D.D.C. 1963); *In re Samour*, 571 F.2d 559, 197 USPQ 1 (C.C.P.A.
15 1978); *Garrett Corp. v. United States*, 422 F.2d 874, 164 USPQ 521 (Ct. Cl.), *cert.*
16 *denied*, 400 U.S. 951, 167 USPQ 705 (1970); *Honeywell, Inc. v. Sperry Rand Corp.*,
17 180 USPQ 673 (D. Minn. 1973); *Studiengesellschaft Kohle mbH v. Dart Indus., Inc.*,
18 726 F.2d 724, 220 USPQ 841 (Fed. Cir. 1984); *Tyler Refrigeration Corp. v. Kysor*
19 *Indus. Corp.*, 553 F. Supp. 279, 220 USPQ 1033 (D. Del. 1982); *In re Wyer*, 655 F.2d
20 221, 210 USPQ 790 (C.C.P.A. 1981); *Scripps Clinic & Research Found. v.*
21 *Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, *clarif. on recon.*, 18 USPQ2d 1896
22 (Fed. Cir. 1991); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ
23 1057 (Fed. Cir.), *cert. denied*, 488 U.S. 892 (1988); *Akzo N.V. v. U.S. Int'l Trade*
24 *Comm'n*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909
25 (1987); *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986); *In re Donohue*, 766
26 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985); *Glaverbel Societe Anonyme v. Northlake*
27 *Mktg. & Supply, Inc.*, 45 F.3d 1550, 33 USPQ2d 1496 (Fed. Cir. 1995).

1 **Anticipation No. 7**

2 **Prior Invention**¹

3 [The defendant] contends that claim[s] _____ of the _____ patent was
4 anticipated because the invention defined in [that claim] [those claims] was invented by
5 another person [X], before [the patentee] invented his invention.²

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

9 To show anticipation of the [patented] invention, [the defendant] must show by clear
10 and convincing evidence that before [the patentee] invented his invention, [X] actually
11 built a device [practiced a process] [made a composition] that included all of the
12 elements of claim ____ of the ____ patent. In addition, [the defendant] must show that
13 [X]'s device was sufficiently developed that one skilled in the art would have
14 recognized that it would work for its intended purpose. To be an anticipation, all of

¹ 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.

² 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 claims
_____ of the ____ patent was invented on
_____."

1 those acts must have been completed before _____ [the inventor of the patent in
2 suit] invented the invention defined by claim ____ of the ____ patent.

3 [If the prior invention was abandoned, suppressed or concealed, it does not
4 anticipate the ____ patent].³ However, it is not necessary that [the patentee] had
5 knowledge of that prior invention.

6 35 U.S.C. § 102; *General Motors Corp. v. Toyota Motor Co.*, 467 F. Supp. 1142, 205
7 USPQ 158 (S.D. Ohio 1979), *aff'd in part & rev'd in part*, 667 F.2d 504, 212 USPQ
8 659 (6th Cir. 1981), *cert. denied*, 456 U.S. 937, 215 USPQ 95 (1982); *Kimberly-Clark*
9 *Corp. v. Johnson & Johnson*, 745 F.2d 1437, 223 USPQ 603 (Fed. Cir. 1984); *EI du*
10 *Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129
11 (Fed. Cir.), *cert. denied*, 488 U.S. 986 (1988); *RCA Corp. v. Data Gen. Corp.*, 887
12 F.2d 1056, 12 USPQ2d 1449 (Fed. Cir. 1989).

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³ If abandonment, suppression or concealment are at issue in the case, these terms should be defined for the jury. *See Checkpoint Systems* 54 F.3d 756, 35 U.S.P.Q.2d 1042 (Fed. Cir. 1995).

1 **Anticipation No. 8**

2 **Prior Patent**

3 [The defendant] contends that claim[s] _____ of the _____ patent were
4 anticipated because the invention defined in [that claim] [those claims] was patented by
5 _____ [before it was invented by [the patentee] [more than one year before [the
6 patentee] filed his United States patent application on _____, 19____.]

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

10 [IF A FOREIGN PATENT IS RELIED ON].¹

11 What was "patented" in the [foreign] patent is determined by what is defined by [the
12 foreign patent's] claims, interpreted in the light of the general description contained in
13 the [foreign patent].

14 To show anticipation of the [patented] invention, [the defendant] must show by clear
15 and convincing evidence that before _____ the [X patent] patented an
16 invention that included all of the element of claim _____ of the _____ patent.

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18 35 U.S.C. § 102; *Bendix Corp. v. Balax, Inc.*, 421 F.2d 809, 164 USPQ 485 (7th
19 Cir.), *cert. denied*, 399 U.S. 911, 166 USPQ 65 (1970); *In re Ekenstam*, 256 F.2d
20 321, 118 USPQ 349 (C.C.P.A. 1958); *In re Monks*, 588 F.2d 308, 200 USPQ 129
21 (C.C.P.A. 1978); *In re Fuge*, 272 F.2d 954, 124 USPQ 105 (C.C.P.A. 1959).

¹ Note that a foreign patent does not become prior art until both of the filing conditions are met: (i) the owner of the foreign patent had the right to enforce that patent in that foreign country and (ii) the foreign patent was available for inspection by the public. Because both of these are issues of foreign law, the Court will probably be able to instruct the jury as to whether or not a particular foreign patent constitutes prior art against the patent in suit.

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1 **Anticipation No. 9**

2 **Prior U.S. Application**

3 [The defendant] contends that claim[s] _____ of the _____ patent were
4 anticipated because the invention defined in [that claim] [those claims] was described in
5 United States patent _____, and because the application for the _____
6 patent was filed before (the patentee) made his invention.¹

7 A claim of the ___ patent would be invalid if the invention defined by that claim
8 were described in a United States patent issued on a patent application filed by another
9 person before the invention was made by [the inventor of the patent in suit].

10 You are instructed that the effective filing date of the _____ patent application
11 was _____, 19___, [the date on which it was filed in the United States].²

12 To show anticipation of the [patented] invention [the defendant] must show by clear
13 and convincing evidence that the application for the [allegedly anticipating patent]
14 described each and every element of claim _____ of the [patent in suit] and that the
15 application for the [allegedly anticipating patent] was filed before the date of invention
16 of the [patent in suit].
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19 35 U.S.C. § 102(e); *In re Wertheim*, 646 F.2d 527, 209 USPQ 554 (C.C.P.A. 1981);
20 *Sun Studs, Inc. v. ATA Equip. Leasing, Inc.*, 872 F.2d 978, 10 USPQ2d 1338, 11
21 USPQ2d 1479 (Fed. Cir. 1989).
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¹ 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 claims
____ of the ___ patent was invented on
____."

² This instruction should be given only if there is no jury issue as to the effective filing date of the allegedly anticipating U.S. patent.

1 **OBVIOUSNESS**

2
3 *The following instructions recognize the fact that, under controlling Federal*
4 *Circuit precedent, the Court has the option of: (a) asking the jury to decide the question*
5 *of obviousness itself, or (b) asking the jury to decide any disputed factual issues*
6 *underlying the determination of obviousness, and having the Court itself then decide the*
7 *"legal" question of obviousness on the basis of those factual findings. See, e.g., Newell*
8 *Cos. v. Kenney Mfg. Co., 864 F.2d 757, 764, 9 USPQ2d 1417, 1423 (Fed. Cir. 1988),*
9 *cert. denied 493 U.S. 814 (1989) ("it is not error to submit the question of obviousness*
10 *to the jury."); accord Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ*
11 *193 (Fed. Cir. 1983).*

12 *Alternative 1 below is a set of instructions for use in those cases where the*
13 *jury is to decide only the disputed factual questions that underlie the obviousness*
14 *determination, with the determination as to obviousness itself to be made by the Court.*
15 *Alternative 2 may be used when the jury will be asked to decide the question of*
16 *obviousness.*

17 **Alternative 1**

18 **Instructions Where the Judge Will Decide the Issue of Obviousness**

19
20 **Under 35 U.S.C. § 103**

21 **Obvious No. 1**

22 **Graham v. John Deere Test**

23 To be patentable an invention must not have been obvious to a person of
24 ordinary skill in the pertinent art at the time that the invention was made. The issue is

1 not whether the claimed invention would have been obvious to you as a layman, to me
2 as a judge. or to a genius in the art. Rather, the question is whether or not it would
3 have been obvious to one of ordinary skill in _____ [the pertinent field] at
4 the time that it was made.

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6 I must determine whether or not the invention claimed in the patent was
7 obvious. However, in order for me to determine whether [the defendant] has
8 established that the claimed invention was obvious, you must give answers to the
9 following questions:

10 [List factual issues to be resolved by the jury. See
11 Obviousness Instructions 2 through 6 for examples of specific
12 factual issues that the jury might be asked to resolve.]

13 35 U.S.C. § 103; *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966);
14 *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 217 USPQ
15 1281 (Fed. Cir. 1983); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ
16 871 (Fed. Cir. 1983); *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d
17 707, 223 USPQ 1264 (Fed. Cir. 1984).

1 **Obviousness No. 2**

2 **Scope and Content of the Prior Art**

3 *If there are factual disputes regarding the prior art, the Court should select*
4 *appropriate specific jury instruction. For example:*

5
6 **Analogous Art**

7 Question __ of the special verdict asks whether or not the _____ [disputed
8 reference] is analogous prior art. An item of prior art is analogous if it comes from the
9 same field of endeavor in which [the patentee] was working, whether or not it concerns
10 the problem [the patentee] was addressing. An item of prior art is also analogous even
11 if it was not from the same field in which [the patentee] was working, so long as it was
12 reasonably pertinent to the particular problem that [the patentee] was trying to solve.

13 *In re Wood*, 599 F.2d 1032, 202 USPQ 171 (C.C.P.A. 1979); *Wang Lab.,*
14 *Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); *In*
15 *re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992).

16 **Publication**

17 Question __ of the special verdict asks whether or not the _____ reference
18 was published prior to _____ [the critical date]. To determine whether a
19 reference was published, you must determine whether it was reasonably accessible to
20 those who would be interested in its contents. It is not necessary that the reference be
21 available to every member of the public. So long as the _____ reference was
22 available to the public, the form in which the information was recorded is unimportant.

1 The information must, however, have been maintained in some permanent form, such
2 as [printed or typewritten pages, magnetic tape, microfilm, photographs, photocopies].

3 *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed.
4 Cir.), *cert. denied*, 488 U.S. 892 (1988); *In re Hall*, 781 F.2d 897, 228 USPQ 453
5 (Fed. Cir. 1986); *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (C.C.P.A. 1981); *Deep*
6 *Welding, Inc. v. Sciaky Bros., Inc.*, 417 F.2d 1227, 163 USPQ 144 (7th Cir. 1969),
7 *cert. denied*, 397 U.S. 1037, 165 USPQ 290 (1970); *Garrett Corp. v. United States*,
8 422 F.2d 874, 164 USPQ 521 (Ct. Cl.), *cert. denied*, 400 U.S. 951, 167 USPQ 705
9 (1970); *Honeywell, Inc. v. Sperry Rand Corp.*, 180 USPQ 673 (D. Minn. 1973); *Tyler*
10 *Refrigeration Corp. v. Kysor Indus. Corp.*, 553 F. Supp. 279, 220 USPQ 1033 (D.
11 Del. 1982).

1 **Obviousness No. 3**

2 **On Sale**

3 Question __ of the special verdict asks whether or not the __ device was on
4 sale prior to _____ [the critical date]. A device was "on sale," if that device was
5 embodied in the thing sold or offered for sale. It is not required that a sale was actually
6 made. An offer of sale, solicitation of orders, promotional activities or advertisements
7 can constitute being "on sale," even though no actual sale takes place. The essential
8 question is whether or not there was an attempt to obtain commercial benefit.¹
9

10 *Barmag Barmer Maschinenfabrik AG v. Murata Mach. Ltd.*, 731 F.2d 831, 221 USPQ
11 561 (Fed. Cir. 1984); *In re Caveney*, 761 F.2d 671, 226 USPQ 1 (Fed. Cir. 1985); *DL*
12 *Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 210 USPQ 13 (Fed. Cir. 1983);
13 *Pennwalt Corp. v. Akzona, Inc.*, 740 F.2d 1573, 222 USPQ 833 (Fed. Cir. 1984);
14 *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 225 USPQ 634
15 (Fed. Cir.), *cert. dismissed*, 474 U.S. 976 (1985); *In re Theis*, 610 F.2d 786, 204
16 USPQ 188 (C.C.P.A. 1979); *Buildex, Inc. v. Kason Indus., Inc.*, 849 F.2d 1461, 7
17 USPQ2d 1325 (Fed. Cir. 1988); *AB Chance Co. v. RTE Corp.*, 854 F.2d 1307, 7
18 USPQ2d 1881 (Fed. Cir. 1988); *RCA Corp. v. Data Gen. Corp.*, 887 F.2d 1056, 12
19 USPQ2d 1449 (Fed. Cir. 1989); *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853,
20 226 USPQ 402 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1016 (1986); *Keystone*
21 *Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 27 USPQ2d 1297 (Fed.
22 Cir. 1993).

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¹ Note: 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.

1 **Obviousness No. 4**

2 **Differences Over the Prior Art**

3 *The jury will be called upon to decide this factual issue only when there is*
4 *some factual dispute about the differences between the prior art and the claimed*
5 *invention, for example, when the parties dispute what one of ordinary skill in the art*
6 *would understand a particular reference to mean. In these instances, specific special*
7 *verdicts and accompanying instructions should be used to assist the court in resolving*
8 *the disputed issue.*

9 **Level of Ordinary Skill**

10 Next you must determine the level of ordinary skill in the pertinent art.
11 When determining the level of ordinary skill in the pertinent art, consider all of the
12 evidence submitted by plaintiff and defendant to show:

- 13 (1) the levels of education and experience of persons
14 working in the field;
- 15 (2) the types of problems encountered in the art;
- 16 (3) the prior art patents and publications;
- 17 (4) the activities of others;
- 18 (5) prior art solutions to the problems encountered by the
19 inventor; and
- 20 (6) the sophistication of the technology.

1 Question __ of the special verdict asks: "What was the level of ordinary skill
2 in _____ [the pertinent field] at the time of _____'s invention."
3 [The plaintiff] contends that the level of ordinary skill in _____ was
4 _____. [The defendant] contends that the level of ordinary skill in
5 _____ was _____. Based on the factors that I have just listed, and the
6 evidence presented, you must determine what was the level of ordinary skill in [the
7 pertinent art], and provide this information to me in your answer to question ____.

8
9 *Graham v. John Deere Co.*, 383 U.S. 1 (1966); *Orthopedic Equip. Co. v. United*
10 *States*, 702 F.2d 1005, 217 USPQ 193 (Fed. Cir. 1983); *Environmental Designs Ltd. v.*
11 *Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert. denied*, 464 U.S.
12 1043, 224 USPQ 520 (1984).

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* It is suggested that the verdict question itself offer the jury three alternative answers: (1) the plaintiff's contention; (2) the defendant's contention; or (3) a blank to be filled in by the jury if they do not adopt either (1) or (2).

1 **Obviousness No. 5**

2 **Factors Indicating Nonobviousness** *(Use only those instructions that are appropriate)*

3 **Commercial Success**

4 Question ___ of the special verdict asks whether or not [the plaintiff]
5 has shown any commercial success of products covered by the patent in suit
6 due to the merits of the claimed invention. To answer this question "yes,"
7 you must be satisfied that there is a causal connection between the evidence
8 showing the commercial success and the claimed invention. For example, if
9 you conclude that commercial success is due to advertising, promotion,
10 salesmanship or the like, or to features of the product other than those
11 claimed in the patent in suit, rather than to the claimed invention, then it is
12 not established that commercial success has a relation to the invention itself.

13 **Long-Felt Need**

1 Question ___ of the special verdict asks whether or not [the plaintiff]
2 has shown a long-felt need in the art that was satisfied by the invention of
3 the ___ patent. You should answer this questions "Yes" if the evidence
4 shows that the merits of the claimed invention satisfied a long-felt need.
5 You should answer this question "No" if the evidence fails to show a long-
6 felt need or if you conclude that the long-felt need was satisfied due to
7 advances in unrelated technology.

8 **Failure of Others**

9 Question ___ of the special verdict asks whether or not [the plaintiff]
10 has shown that others had tried, but failed to solve the problem solved by the
11 invention of the [patent in suit]. To answer this question "yes," you must be
12 satisfied that others had tried and failed and that it was the merits of the
13 claimed invention that allowed the inventors of the _____ patent to succeed
14 where others had failed. For example, if advances in unrelated technology
15 allowed the inventor to succeed where others had failed, then it may not be
16 established that the inventor's success is related to the merits of his
17 invention.

18 **Copying**

19 Question __ of the special verdict asks whether or not [the plaintiff]
20 has shown that others have copied the invention claimed in the ___ patent.

21 **Unexpected Results**

1 Question __ of the special verdict asks whether or not [the plaintiff]
2 has shown unexpected superior results achieved by the invention claimed in
3 the ___ patent. To answer this question "yes," you must be satisfied that it
4 was the claimed invention that caused the unexpected results. For example,
5 if the unexpected results were due to a feature unrelated to the claimed
6 invention, then it would not be established that the unexpected results were
7 achieved by the invention itself.

8 **Acceptance of Licenses**

9 Question __ of the special verdict asks whether or not [the plaintiff]
10 has shown that others have accepted licenses under the patent in suit. To
11 answer this question "yes," you must be satisfied that others agreed to
12 licenses because of the merits of the claimed invention. For example, if the
13 others accepted licenses due to factors such as [the cost of litigation, or the
14 low cost of the license], then it would not be established that the acceptance
15 of licenses was due to the merits of the claimed invention itself.

16

1 *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); *Stratoflex, Inc. v.*
2 *Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Perkin_Elmer Corp.*
3 *v. Computervision Corp.*, 732 F.2d 888, 221 USPQ 669 (Fed. Cir.), *cert. denied*, 469
4 U.S. 857, 225 USPQ 792 (1984); *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ
5 479, 483-84 (Ct. Cl. 1966); *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d
6 693, 697, 218 USPQ 865, 869 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043, 224
7 USPQ 520 (1984); *WL Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220
8 USPQ 303 (Fed.Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

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1 **Obviousness No. 6**

2 **Independent Invention by Others**

3 Question ____ of the special verdict asks whether or not the claimed invention
4 was invented independently by other persons, either before it was invented by [the
5 inventor of the patent in suit] or at about the same time.

6 *In re Farrenkopf*, 713 F.2d 714, 219 USPQ 1 (Fed. Cir. 1983); *Orthopedic Equip. Co.*
7 *v. United States*, 702 F.2d 1005, 217 USPQ 193 (Fed. Cir. 1983); *Stewart_Warner*
8 *Corp. v. City of Pontiac, Inc. v. United States*, 153 USPQ 465 (Ct. Cl. 1967);
9 *Simmonds Precision Prods., Inc. v. United States*, 153 USPQ 465 (Ct. Cl. 1967);
10 *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452,
11 221 USPQ 481 (Fed. Cir. 1984).
12

1 **Alternative 2**

2 **Instructions Where the Jury Will Decide the Issue of Obviousness**

3 **Obviousness Under 35 U.S.C. § 103**

4 **Obviousness No. 7**

5 **Graham v. John Deere Test**

6 [Defendant] contends that the claims of the ____ patent are invalid because
7 the claimed invention was obvious to one of ordinary skill in the art [at the time the
8 invention was made]. [Defendant] bears the burden of proving this defense by clear
9 and convincing evidence.

10 To be patentable an invention must not have been obvious to a person of
11 ordinary skill in the pertinent art at the time the invention was made. The issue is not
12 whether the claimed invention would have been obvious to you as a layman, to me as a
13 judge, or to a genius in the art, but whether it would have been obvious to one of
14 ordinary skill in _____ [the pertinent field] at the time it was made.

15
16 You should conclude that the patent in suit is invalid, even though not
17 identically disclosed in a single prior art device or reference, if [the defendant] has
18 established by clear and convincing evidence of facts which show that the claimed
19 invention as a whole would have been obvious to a person of ordinary skill in [the
20 pertinent art] at the time the invention was made.

1 Before determining whether or not [the defendant] has established
2 obviousness of the claimed invention, you must determine the following factual matters,
3 each of which must be established by clear and convincing evidence:

- 4 1. The scope and content of the prior art relied upon by
5 [defendant];
- 6 2. The difference or differences, if any, between each
7 claim of the _____ patent and the prior art; and
- 8 3. The level of ordinary skill in the art at the time the
9 invention of the _____ patent was made.

10 4. [*List secondary considerations from*
11 *instructions 13 and/or 14 that are pertinent to the*
12 *particular case*].

13 Against this background of facts you will then make your conclusion
14 whether or not the claimed subject matter would have been obvious to a person of
15 ordinary skill in the art of _____ at the time the invention was made.

16
17 *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); *Orthopedic Equip. Co.*
18 *v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 217 USPQ 1281 (Fed. Cir. 1983);
19 *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983);
20 *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 223 USPQ 1264
21 (Fed. Cir. 1984); *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 764, 9 USPQ2d
22 1417, 1423 (Fed. Cir. 1988); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 716, 21

1 USPQ2d 1053 (Fed. Cir. 1991); Nutrition 21 v. United States, 930 F.2d 867, 871 n.2,

2 18 USPQ2d 1347 (Fed. Cir. 1991).

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1 **Obviousness No. 8**

2 **Scope and Content of the Prior Art**

3 The prior art includes the following items received into evidence during the
4 trial: [list prior art stipulated to by the parties].

5
6 *If there are factual disputes regarding the prior art, the court may select an*
7 *appropriate specific jury instruction. For example:*

8
9 **Analogous Art**

10 [The plaintiff] and [defendant] disagree as to
11 whether the ___ [disputed reference] is analogous prior art.
12 An item of prior art is analogous if it comes from the same
13 field in which [the patentee] was working, whether or not it
14 concerns the problem [the patentee] was addressing. An item
15 of prior art is also analogous even if it was not from the same
16 field in which [the patentee] was working, so long as it was
17 reasonably pertinent to the particular problem that [the
18 patentee] was trying to solve.

19 If you determine that the _____ reference
20 is not analogous art, then you should ignore it in deciding
21 whether the patent in suit would have been obvious.

1 *In re Wood*, 599 F.2d 1032, 202 USPQ 171 (C.C.P.A. 1979); *Wang Lab.,*
2 *Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); *In*
3 *re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992)

4
5 **Publication**

6 [Plaintiff] and [defendant] dispute whether the
7 _____ [disputed reference] was published before
8 _____ [the critical date]. To determine whether
9 this reference was published before _____, you must
10 determine whether it was reasonably accessible to those who
11 would be interested in its contents. It is not necessary that the
12 reference be available to every member of the public. So
13 long as it was available to the public, the form in which the
14 information was recorded is unimportant. The information
15 must, however, have been maintained in some permanent
16 form, such as [printed or typewritten pages, magnetic tape,
17 microfilm, photographs, photocopies].

18 If you decide that the _____ reference was
19 not published prior to _____ [the critical
20 date], then you may not consider it in deciding the issue of
21 obviousness.

22
23
24 *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d
25 1560, 7 USPQ2d 1057 (Fed. Cir.), *cert. denied*, 488 U.S.
26 892 (1988); *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed.

1 Cir. 1986); *In re Wyer*, 655 F.2d 221, 210 USPQ 790
2 (C.C.P.A. 1981); *Deep Welding, Inc. v. Sciaky Bros., Inc.*,
3 417 F.2d 1227, 163 USPQ 144 (7th Cir. 1969), *cert. denied*,
4 397 U.S. 1037, 165 USPQ 290 (1970); *Garrett Corp. v.*
5 *United States*, 422 F.2d 874, 164 USPQ 521 (Ct. Cl.), *cert.*
6 *denied*, 400 U.S. 951, 167 USPQ 705 (1970); *Honeywell,*
7 *Inc. v. Sperry Rand Corp.*, 180 USPQ 673 (D. Minn. 1973);
8 *Tyler Refrigeration Corp. v. Kysor Indus. Corp.*, 553 F.
9 Supp. 279, 220 USPQ 1033 (D. Del. 1982).

10

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1 **Obviousness No. 9**

2 **On Sale**

3 [Plaintiff] and [defendant] dispute whether the ___ device was on sale prior
4 to _____ [the critical date]. A device was "on sale," if that device was embodied in
5 the thing sold or offered for sale. It is not required that a sale was actually made. An
6 offer of sale, solicitation of orders, promotional activities or advertisements can
7 constitute being "on sale", even though no actual sale takes place. The essential
8 question is whether or not there was an attempt to obtain commercial benefit.¹

¹ Note: 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.

1 If you decide the _____ device was not on sale prior to _____, then
2 you may not consider it in deciding the issue of obviousness.

3 *Barmag Barmer Maschinenfabrik AG v. Murata Mach. Ltd.*, 731 F.2d 831, 221 USPQ
4 561 (Fed. Cir. 1984); *In re Caveney*, 761 F.2d 671, 226 USPQ 1 (Fed. Cir. 1985); *DL*
5 *Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 210 USPQ 13 (Fed. Cir. 1983);
6 *Pennwalt Corp. v. Akzona, Inc.*, 740 F.2d 1573, 222 USPQ 833 (Fed. Cir. 1984);
7 *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 225 USPQ 634
8 (Fed. Cir.), *cert. dismissed*, 474 U.S. 976 (1985); *In re Theis*, 610 F.2d 786, 204
9 USPQ 188 (C.C.P.A. 1979); *Buildex, Inc. v. Kason Indus., Inc.*, 849 F.2d 1461, 7
10 USPQ2d 1325 (Fed. Cir. 1988); *AB Chance Co. v. RTE Corp.*, 854 F.2d 1307, 7
11 USPQ2d 1881 (Fed. Cir. 1988); *RCA Corp. v. Data Gen. Corp.*, 887 F.2d 1056, 12
12 USPQ2d 1449 (Fed. Cir. 1989); *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853,
13 226 USPQ 402 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1016 (1986); *Keystone*
14 *Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 27 USPQ2d 1297 (Fed.
15 Cir. 1993).

16

1 **Obviousness No. 10**

2 **Differences Over the Prior Art**

3 In reaching your conclusion as to whether or not the claimed invention was
4 obvious, you should consider any difference or differences between the prior art and
5 the claimed invention. When doing so, each claim must be considered in its entirety
6 and separately from the other claims.

7 Although it is proper for you to note any differences between the claimed
8 invention and the prior art, you must still determine the obviousness or nonobviousness
9 of the invention as a whole.

10
11 *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); *Stratoflex, Inc. v.*
12 *Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Medtronic, Inc. v.*
13 *Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 220 USPQ 97 (Fed. Cir. 1983).

1 **Obviousness No. 11**

2 **Level of Ordinary Skill**

3 In reaching your determination as to whether or not the claimed invention
4 was obvious, you should consider the level of ordinary skill in the art of
5 _____ . When determining the level of ordinary skill in [the pertinent art],
6 consider all the evidence submitted by plaintiff and defendant to show:

- 7 (1) the levels of education and experience of persons skill
8 working in the field;
- 9 (2) the types of problems encountered in the art;
- 10 (3) the prior art patents and publications;
- 11 (4) the activities of others;
- 12 (5) prior art solutions to the problems encountered by the
13 inventor; and
- 14 (6) the sophistication of the technology.

15

16 [The plaintiff] contends that the level of ordinary skill in _____
17 was _____. [The defendant] contends that the level of ordinary skill in
18 _____ was _____. Based on the factors I have just listed, and the
19 evidence presented, you must determine what was the level of ordinary skill in the
20 pertinent art.

1 When you decide the issue of obviousness, you must decide whether or not
2 the invention would have been obvious to one having this ordinary level of skill in [the
3 pertinent art].

4 *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); *Orthopedic Equip. Co.*
5 *v. United States*, 702 F.2d 1005, 217 USPQ 193 (Fed. Cir. 1983); *Environmental*
6 *Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert.*
7 *denied*, 464 U.S. 1043, 224 USPQ 520 (1984).

8

1 **Obviousness No. 12**

2 **Obviousness**

3 In determining whether the invention of the patent in suit would have been
4 obvious to a person of ordinary skill in the art, you must presume that person would
5 have known about all of the relevant prior art. A combination of prior art cannot
6 render an invention obvious unless every one of the elements of the claimed invention is
7 disclosed in at least one of those items of prior art. In examining the [prior
8 publications, inventions, etc.] you should take into account not only what they expressly
9 disclose [embody], but also anything that inherently occurred as a result of practicing
10 what was expressly disclosed in that prior art. In this case [the defendant] contends that
11 the [prior art] inherently disclosed _____. To show that that was
12 inherently disclosed, [the defendant] must show by clear and convincing evidence that
13 process [product] disclosed in the [prior art] always inherently produced [possessed]
14 _____.

15 If you find that a combination of items of the prior art showed each of the
16 elements of the claims in suit, you must determine whether or not it would then have
17 been obvious to a person of ordinary skill in the art of _____ to combine or
18 coordinate these elements in the same manner as the claims of the _____ patent.
19 You must not use hindsight in answering this question. In other words, it is wrong to
20 use the _____ patent as a guide through the prior art references, combining the right
21 references in the right way so as to achieve the result of the claims of the _____
22 patent. Rather, you must determine whether or not, at the time the invention was

1 made, the invention of the _____ patent would have been obvious to one of ordinary
2 skill in the art having knowledge of all the prior art.

3 If you conclude that the prior art discloses all the elements of the claimed
4 invention, but those elements are in separate prior art references, you must then
5 consider whether or not it would have been obvious to combine the elements. To
6 answer this question "yes," you must determine that there was some suggestion in the
7 prior art to combine the elements. The suggestion can be expressly stated in a
8 particular reference or it can be within the knowledge that was generally available to
9 one of ordinary skill in [the relevant art].

10 *Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 217 USPQ 193 (Fed. Cir.
11 1983).

1 **Obviousness No. 13**

2 **Obvious to Try**

3 In deciding whether the prior art suggests the combination [composition,
4 etc.] recited in the claims of the _____ patent, you are instructed that if the prior art
5 merely discloses numerous possible combinations but gives no direction as to which of
6 those of many choices is likely to be successful, this does not constitute a suggestion of
7 the claimed combination [composition, etc.] Similarly, if the prior art merely discloses
8 that it would be obvious to explore a new technology or general approach that seemed
9 to be a promising field of experimentation, this would not constitute a suggestion of the
10 claimed combination [composition, etc.].

11 On the other hand, for the prior art to "suggest" the claimed invention, it is
12 not necessary that one of ordinary skill in the _____ art, looking at the prior art,
13 could predict with certainty that the claimed invention would be successful. Rather, it
14 is sufficient that a person of ordinary skill in the _____ art, looking at the prior art,
15 would have a reasonable expectation that the claimed invention would achieve the
16 desired result.

17 *Mandel Bros., Inc. v. Wallace*, 335 U.S. 291, 295, 79 USPQ 220, 221 (1948); *In re*
18 *Kulling*, 897 F.2d 1147, 1149, 14 USPQ2d 1056, 1057-58 (Fed. Cir. 1990); *Merck &*
19 *Co. v. Biocraft Lab., Inc.*, 874 F.2d 804, 807, 809, 10 USPQ2d 1843, 1846, 1847-48
20 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989); *In re O'Farrell*, 853 F.2d 894, 903-04,
21 7 USPQ2d 1673, 1681 (Fed. Cir. 1988); *Novo Industri A/S v. Travenol Lab., Inc.*, 677
22 F.2d 1202, 215 USPQ 412 (7th Cir. 1982); *In re Yates*, 663 F.2d 1054, 211 USPQ

1 1149 (C.C.P.A. 1981); *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 366-67
2 (C.C.P.A. 1976); and *Carter-Wallace, Inc. v. Otte*, 474 F.2d 529, 543, 176 USPQ 2,
3 11-12 (2d Cir. 1972), *cert. denied*, 412 U.S. 929 (1973)

4

1 **Obviousness No. 14**

2 **Factors Indicating Nonobviousness**

3 Before deciding the issue of obviousness, you must consider certain factors
4 which, if established, weigh in favor of finding that the invention was not obvious.

5
6 (Use only those instructions which are appropriate)

7 **Commercial Success**

1 To prove this [the plaintiff] must show that it was the merits
2 of the claimed invention that satisfied a long-felt need. For
3 example, if you were to conclude that there was no long-felt
4 need or that the long-felt need was satisfied due to advances
5 in unrelated technology, then [the plaintiff] would not have
6 carried its burden of proof on this issue. If, however, you
7 were to find that the merits of the invention solved a long-felt
8 need, this would tend to indicate that the invention was not
9 obvious.

10 **Failure of Others**

11 Another factor you should consider is whether
12 or not [the plaintiff] has shown that others had tried, but
13 failed to solve the problem solved by the invention of the
14 [patent in suit]. To prove this [the plaintiff] must show that
15 others had tried and failed and that it was the merits of the
16 claimed invention that allowed the inventors of the _____
17 patent to succeed where others had failed. For example, if
18 advances in unrelated technology allowed the inventor of the
19 _____ patent to succeed where others had failed, then [the
20 plaintiff] would not have carried his burden of proof on this
21 issue. If, however, you were to find that the merits of the
22 invention allowed the inventor to succeed where others had

1 failed, this would tend to indicate that the invention was not
2 obvious.

3 **Copying**

4 Another factor you should consider is whether
5 or not [the plaintiff] has shown copying by others of the
6 invention claimed in the [patent in suit]. If you were to find
7 that others copied the invention because of its merits this
8 would tend to indicate that the invention was not obvious.

9 **Unexpected Results**

1 Another factor you should consider is whether
2 or not [the plaintiff] has shown unexpected superior results
3 achieved by the invention claimed in the [patent in suit]. To
4 prove this [the plaintiff] must show that it was the claimed
5 invention that caused the unexpected results. For example, if
6 there were not unexpected superior results or the unexpected
7 results were due to a feature unrelated to the claimed
8 invention, then [the plaintiff] would not have carried its
9 burden of proof on this issue. If, however, you were to find
10 that there were unexpected superior results which were
11 related to the claimed invention, this would tend to indicate
12 that the invention was not obvious.

13 **Acceptance of Licenses**

1 Another factor you should consider is whether
2 or not [the plaintiff] has shown that others have accepted
3 licenses under [the patent in suit]. To prove this [the
4 plaintiff] must show that others agreed to licenses because of
5 the merits of the claimed invention. For example, if the
6 others accepted licenses due to factors such as [the cost of
7 litigation, or the low cost of the license], then it has not been
8 established that the acceptance of licenses was due to the
9 merits of the invention itself. If, however, you were to find
10 that others took licenses as a result of the merits of the
11 claimed invention, this would tend to indicate that the
12 invention was not obvious.

13 *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); *Stratoflex Inc. v.*
14 *Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Perkin_Elmer Corp.*
15 *v. Computervision Corp.*, 732 F.2d 888, 221 USPQ 669 (Fed. Cir.), *cert. denied*, 469
16 U.S. 857, 225 USPQ 792 (1984); *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ
17 479, 483-84 (Ct. Cl. 1966); *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d
18 693, 697, 218 USPQ 865, 869 (Fed.Cir. 1983), *cert. denied*, 464 U.S. 1043, 224
19 USPQ 520 (1984); *WL Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220
20 USPQ 303 (Fed.Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

1 **Obviousness No. 15**

2 **Independent Invention by Others**

3 In reaching your determination on the issue of obviousness, you should also
4 consider whether or not the claimed invention was invented independently by other
5 persons, either before it was invented by [the inventor of the patent in suit] or at about
6 the same time. Just as the failure of others to make the invention may be evidence that
7 an invention was not obvious, independent making of the invention by persons other
8 than the inventor about the same time may be evidence that the invention was obvious.

9 The simultaneous or near simultaneous invention by two or more persons
10 working independently may or may not be an indication of obviousness when
11 considered in light of all the circumstances.

12
13 *In re Farrenkopf*, 713 F.2d 714, 219 USPQ 1 (Fed. Cir. 1983); *Orthopedic Equip. Co.*
14 *v. United States*, 702 F.2d 1005, 217 USPQ 193 (Fed. Cir. 1983); *Stewart_Warner*
15 *Corp. v. City of Pontiac*, 767 F.2d 1563, 226 USPQ 676 (Fed. Cir. 1985); *Simmonds*
16 *Precision Prods., Inc. v. United States*, 153 USPQ 465 (Ct. Cl. 1967); *Lindemann*
17 *Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ
18 481 (Fed. Cir. 1984).
19

1 **ENABLEMENT**

2 Under the U.S. patent laws, a patent must disclose sufficient information to
3 enable those skilled in the art to make and use the claimed invention.² This requirement
4 is known as the enablement requirement.

5 The defendant in this case has asserted that the plaintiff's patent is invalid
6 for failure to satisfy the enablement requirement. As with assertions of patent invalidity
7 on other grounds, the defendant bears the burden of establishing nonenablement by
8 clear and convincing evidence.³

9 To determine whether a patent is enabling, one must look to the time the
10 application for that patent was filed.⁴ A patent is enabling if its disclosure is sufficient to
11 enable a person of ordinary skill in the art to make and use the claimed invention.⁵ A
12 patent need not disclose what is well known in the art.⁶

13 A patent is enabling even if some experimentation would be required to
14 achieve the claimed invention, so long as that amount of experimentation is routine and
15 would not be considered undue by those skilled in the art.⁷ Factors to be considered in
16 determining whether a disclosure would require undue experimentation include: (1) the
17 quantity of experimentation necessary; (2) the amount of direction or guidance

² *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

³ *Ralston Purina Co. v. Far-Mar Co.*, 772 F.2d 1570, 1573-74, 227 USPQ 177, 178 (Fed.Cir. 1985).

⁴ *White Consolidated Indus., Inc. v. Vega Servo Control, Inc.*, 713 F.2d 788, 791, 218 USPQ 961, 964 (Fed.Cir. 1983).

⁵ *Spectra-Physics, Inc. v. Coherent, Inc.*, 827, 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir.), cert. denied, 108 S.Ct. 346 (1987).2

⁶ *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

1 disclosed in the patent; (3) the presence or absence of working examples in the patent;
2 (4) the nature of the invention; (5) the state of the prior art; (6) the relative skill of
3 those in the art; (7) the predictability of the art; and (8) the breadth of the claims.⁸
4
5

⁷ *Hybritech*, 802 F.2d at 1384, 231 USPQ at 94.

⁸ *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed.Cir. 1988).

1 **BEST MODE**

2 You must determine whether the inventor disclosed the "best mode" of
3 practicing the claimed invention to the U.S. Patent and Trademark Office within the
4 contents of the patent application. The law requires that "the specification shall set
5 forth the best mode contemplated by the inventor of carrying out his invention."⁹ If the
6 inventor had specific processes, techniques, compositions, material or conditions that
7 he or she recognized **at the time of filing** as the best way of carrying out the invention,
8 then he or she must include that information in the patent disclosure.¹⁰

9 The purpose of this requirement is to ensure that a patent applicant "plays
10 fair and square"¹¹ with the patent system by restraining inventors "from applying for
11 patents while at the same time concealing from the public preferred embodiments of
12 their invention which they have in fact conceived."¹² An inventor must disclose his or
13 her best mode to the public in exchange for patent protection. The law does not give an
14 inventor the right to exclude others from practicing the invention unless he or she has
15 provided an adequate disclosure of the best way known to him or her at the time of

⁹ 35 U.S.C. §112, first paragraph.

¹⁰ *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1535, 3 U.S.P.Q.2d (Fed.Cir. 1987). Cases involving multiple inventors may pose special issues.

See _____.

¹¹ *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1209-10, 18 U.S.P.Q.2d at 1016, 1024 (Fed.Cir. 1991).

¹² *In re Gay*, 309 F.2d 769, 772, 135 U.S.P.Q.2d 311, 315 (CCPA 1962).

1 filing of the application of carrying out the invention.¹³ To determine whether the
2 inventor complied with the best mode requirements you must answer two questions.¹⁴

3 1. At the time the patent application was filed, did
4 the patentee have a best mode for practicing his or her
5 invention; and

6 2. If so, did the patentee adequately disclose the best mode in the
7 patent specification?
8

9 **PART 1**

10 **Question ____ of the Special Verdict form reads:**

11 Did the Defendant prove by clear and
12 convincing evidence that the inventor
13 was aware of a best mode for practicing
14 the claimed invention when he filed his
15 patent application?
16

17 Answer yes or no:

18
19 To answer this question you must determine whether **the inventor** knew of a
20 way to practice the claimed invention which he or she considered to be better than any
21 other **at the time the application was filed.**¹⁵ The best mode inquiry focuses on the
22 state of mind of the particular inventor and the knowledge he or she possessed at the
23 time the application was filed. There is no objective standard for determining whether

¹³ *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1209-10, 18 U.S.P.Q.2d 1016, 1024 (Fed. Cir. 1991).

¹⁴ *U.S. Gypsum Co. v. National Gypsum Co.*, 74 F.3d 1209, 1212, 37 U.S.P.Q.2d 1388, 1290 (Fed.Cir. 1996); *Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923, 928, 12 U.S.P.Q.2d 1033, 1036 (Fed.Cir. 1990).

1 the inventor contemplated a best mode.¹⁶ This inquiry is wholly subjective. You must
2 determine the inventor's state of mind based on the evidence provided.¹⁷

3 Keep in mind that the commercial embodiment adopted by the patentee is not
4 necessarily the best mode contemplated by the inventor at the time the patent
5 application was filed.¹⁸ For example, a selection made for commercial expediency (such
6 as the availability of certain materials, prior relationships with certain suppliers, and
7 other routine manufacturing choices) may be the "best" decision in a manufacturing
8 circumstance but may have been chosen by someone other than the inventor or may not
9 be considered by the inventor to be the best mode of carrying out the invention.¹⁹ Any
10 manufacturing process requires the selection of specific processes and materials, but
11 only those selections which the inventor believes are important to obtaining the best
12 results from the invention are considered to be part of the best mode disclosure.²⁰

13 If the inventor realizes after the patent application is filed that a better way
14 exists to practice the invention, he or she is not required to update the "best mode."²¹ In
15 addition, if the inventor contemplated a best mode before he or she filed the patent

¹⁵ *U.S. Gypsum*, 74 F.3d at 1212, 37 U.S.P.Q.2d at 1390; *Chemcast*, 913 F.2d at 927-28, 16 U.S.P.Q. at 1036.

¹⁶ *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 3 U.S.P.Q.2d 1737 (Fed.Cir. 1987), cert. denied, 108 S.Ct. 346 (1987); *DeGeorge v. Bernier*, 768 F.2d 1318, 1324, 226 U.S.P.Q. 758, 763 (Fed.Cir. 1985).

¹⁷ See e.g., *U.S. Gypsum*, 74 F.3d at 1212-13, 37 U.S.P.Q.2d at 1390-91; *Shering v. Iolab Corp.*, 975 F.2d 1541, 24 U.S.P.Q.2d 1133 (Fed.Cir. 1992).

¹⁸ *U.S. Gypsum*, 74 F.3d 1209 at 1213, 37 U.S.P.Q.2d at 1391; *Wahl Instruments, Inc. v. Acvious, Inc.*, 950 F.2d 1575, 1581, 21 U.S.P.Q.2d 1123, 1128 (Fed.Cir. 1991).

¹⁹ *Id.*

²⁰ *Id.*

²¹ *Transco Prods.*, 38 F.3d at 558, 32 U.S.P.Q.2d at 1082. This instruction will need to be modified if a continuation-in-part application is involved.

1 application and left it out of the application, an amendment after the filing will not cure
2 an original omission of the best mode disclosure.²²

3 Finally, if the inventor is an employee of a corporation or other entity, the
4 inventor is not presumed to know or be aware of that entity's collective knowledge
5 regarding the best mode.²³ Nor is the inventor required to search for the actual best
6 mode.²⁴

²² *In re Hay*, 534 F.2d 917, 189 U.S.P.Q. 790 (CCPA), cert. denied, 429 U.S. 977, 192 U.S.P.Q. 64 (1976).

²³ *Glaxo Inc. v. Navopharm Ltd.* 52 F.3d 1043, 1049 (Fed.Cir. 1995).

²⁴ *In re Bundy*, 204 U.S.P.Q. 48, 52 (CCPA 1981).

1 **PART 2**

2 **Question ____ of the Special Verdict reads:**

3 If a best mode was known to the inventor
4 at the time of filing, did the specification
5 adequately disclose what the inventor
6 contemplated as the best mode so that those
7 skilled in the art can practice the invention?
8

9 Answer yes or no:

10 (Answer this question only if you answered YES to question ____)

11
12 To answer this question you must determine whether the inventor adequately
13 disclosed his or her best mode in the patent specification. To make this determination,
14 you must compare what was in the mind of the inventor (as determined in Question 1)
15 with what appeared in the specification when the patent was filed. The disclosure in the
16 specification must be adequate to allow one of ordinary skill in the art to make and use
17 the best mode of the invention contemplated by the inventor.²⁵

18 In determining whether the patentee's disclosure is adequate, you should
19 consider the scope of the claimed invention and the level of skill in the art.²⁶

20 Merely because a technique was known in the art does not relieve a patentee
21 of his or her duty to identify it as a best mode. An inventor cannot assume that those
22 skilled in the art would know the **necessary** components that enable him or her to
23 practice the best mode of the invention.²⁷ of those skilled in the art may only be used to

²⁵ *Chemcast*, 913 F.2d 923, 16 U.S.P.Q.2d 1033.

²⁶ *U.S. Gypsum*, 74 F.3d at 1212, 37 U.S.P.Q.2d at 1084; *Spectra-Physics*, 827 F.2d at 1536, 3 U.S.P.Q.2d at 1745; *Randomex Inc. v. Scopis Corp.*, 849 F.2d 585, 587, 7 U.S.P.Q.2d 1050, 1052 (Fed.Cir. 1988).

²⁷ *Dana Corp. v. IPC Ltd. Partnership*, 860 F.2d 415, 419 (Fed.Cir. 1988), *cert. denied*, 490 US 1067 (1989).

1 fill in gaps or provide details that are helpful and may not be used for those that are
2 **necessary** to practicing the invention.²⁸, merely because the invention is available
3 commercially does not relieve the inventor of his or her obligation to include the best
4 mode in the specification.²⁹skilled in the art should not have to look to the commercial
5 embodiment in order to practice the best mode.³⁰

6 It is not necessary for you to find that the patentee intentionally concealed
7 the best mode in order to find a best mode violation. An intent to conceal is not
8 required. In other words, you may find that the disclosure does not comply with the
9 best mode requirement if it is so objectively inadequate as to effectively conceal the
10 best mode from the public.³¹ Further, supplier and trade name information must be
11 provided when a skilled artisan could not practice the best mode of the claimed
12 invention without this information.³²

13 Information necessary to practice the best mode must be disclosed even if it
14 is a trade secret.³³ Failure to disclose the nature of a trade secret may only be excused if
15 the component is available to the public by disclosing information sufficient for the
16 public to obtain the item.³⁴

²⁸ *U.S. Gypsum*, 74 F.3d at 1213, 37 U.S.P.Q.2d at 1391; *Wahl Instruments*, 950 F.2d at 5181, 21 U.S.P.Q. at 1128; *In re Sherwood*, 613 F.2d 809, 204 U.S.P.Q. 537 (CCPA 1980), *cert. denied*, 450 U.S. 994 (1981).

²⁹ *U.S. Gypsum*, 74 F.3d at 1215, 37 U.S.P.Q. at 1392-93.

³⁰ *Id.*

³¹ *Transco Prods.*, 38 F.3d at 560, 32 U.S.P.Q.2d at 1084; *Spectra-Physics*, 827 F.2d at 1536, 3 U.S.P.Q.2d at 1745; *Randomex*, 849 F.2d at 587, 7 U.S.P.Q.2d at 1052.

³² *U.S. Gypsum*, 74 F.3d at 1214, 37 U.S.P.Q.2d at 1392.

³³ *Id.*; *Chemcast*, 913 F.2d at 930, 16 U.S.P.Q.2d at 1038.

³⁴ *Randomex, Inc. v. Scopus Corp.*, 849 F.2d 585, 589 (Fed.Cir. 1988).

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1 **DAMAGES**

2 **Patent Damages No. 1**

3 **General**

4
5
6 If you find that [the accused device or method] infringes at least one of the
7 claims of the patent in suit, and if you also find that [the accused infringer] has not
8 proven each infringed claim to be invalid, you must determine the amount of damages
9 to be awarded [the patentee] for the infringement. The amount of those damages must
10 be adequate to compensate [the patentee] for the infringement. Your damage award
11 should put [the patentee] in approximately the financial position it would have been in
12 had the infringement not occurred; but in no event may the damage award be less than
13 a reasonable royalty.

14 I will now explain how you should determine an appropriate damage award.
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18 **Authority:**

19
20 35 U.S.C. § 284; *Fromson v. Western Litho Plate & Supply Co.*, 853 F.2d 1568,
21 1574, 7 USPQ2d 1606, 1612 (Fed. Cir. 1988); *Milgo Elec. Corp. v. United Business*
22 *Communications, Inc.*, 623 F.2d 645, 664, 206 USPQ 481, 496 (10th Cir.), *cert.*
23 *denied*, 449 U.S. 1066, 208 USPQ 376 (1980); *Aro Mfg. Co. v. Convertible Top*
24 *Replacement Co.*, 377 U.S. 476, 507, 141 USPQ 681, 694 (1964); *Del Mar Avionics,*
25 *Inc. v. Quinton Instrument Co.*, 836 F.2d 1320, 1326, 5 USPQ2d 1255, 1259-60 (Fed.
26 Cir. 1987).
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Patent Damages No. 2

Burden of Proof

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

1 **Patent Damages No. 3**

2 **Date Damages Begin**

3
4 **Where the patentee sells a product covered by the patent in suit but has**
5 **not marked the products pursuant to 35 U.S.C. § 287(a):***
6

7
8 **Alternate 1:**

9 The date that [the patentee] first gave notice to [the accused infringer] of its
10 claim of patent infringement is the date at which patent damages begin to be calculated.
11 That date has been agreed to by the parties to be _____.

12
13 **Alternate 2:**

14 The date that [the patentee] first gave notice to [the accused infringer] of its
15 claim of patent infringement is the date at which patent damages begin to be calculated.
16 That date is in dispute here, and it is up to you to determine what that date is. [Read or
17 refer to specific verdict question] The date notice was given is the date on which [the
18 patentee] communicated to [the accused infringer] a specific charge that [the allegedly
19 infringing product] infringed [the patent-in-suit]. In any event, the date is no later than
20 , which is the filing date for this suit.

21
22 **When the patentee [and its licensees] marks the patented product or**
23 **does not sell a product covered by the patent in suit:***
24

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* Note: If there is an issue of fact as to the adequacy of the patentee's marking, additional instructions will be required.

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Alternate 3: When the patent issues before infringement begins.

You are instructed that you should begin calculating damages as of [date that the infringement began].

Alternate 4: When the patent issues after the infringing activity begins.

You are instructed that you should begin calculating damages as of [date that the patent in suit issued].

Authority:

35 U.S.C. §287(a); *Amsted Industries, Inc. v. Buckeye Steel Castings Co.*, 24 F.3d 178, 30 USPQ2d 1462 (Fed. Cir. 1994); *Devices for Medicine, Inc. v. Boehl*, 822 F.2d 1062, 3 USPQ2d 1288 (Fed. Cir. 1987).

1 **Patent Damages No. 4**

2 **Lost Profits ("But-For" Test)**

3 Here, [the patentee] is seeking its lost profits as [its or part of its] patent
4 damages. [The patentee] must prove the amount of its lost profits. Your determination
5 of that amount must not be based on speculation or guess. However, the law does not
6 require mathematical precision in this proof of loss, but only proof to a reasonable,
7 although not absolute, certainty. To recover lost profits for some or all of the
8 infringing sales, [the patentee] must show that if defendant had not infringed, [the
9 patentee] would have made those sales [or a portion of them] that the [accused
10 infringer] made with the infringing product. You must determine what the customers
11 who purchased the infringing product would have done if the infringement had not
12 occurred. [The patentee] need not present absolute proof that purchasers of the [the
13 infringing] product would have bought [the patentee's] product instead. [The patentee]
14 need not eliminate every possibility that purchasers might not have bought another
15 product or might not have bought any comparable product at all. Rather, [the patentee]
16 must show that there is a reasonable probability that [the patentee] would have made
17 [some or all of] the sales that [the accused infringer] made of the infringing
18 product. Authority: *Rite Hite Corp. v. Kelley Co.*, 56 F.3d 1538, 35 U.S.P.Q.2d 1065

* Note: If the patentee is seeking to recover lost profits damages on sales of products that competed with the infringing product, but the patentee's product was not covered by the patent in suit, add the following instruction:

In this case, [the patentee] contends that [the defendant's] sales of its [accused product] caused [the patentee] to lose sales of its [product not

covered by the patent in suit]. In order to recover lost profits for lost sales of the [product not covered by the patent in suit], [the patentee] must show that [the defendant] foresaw or should have reasonably foreseen that its sales of [the accused product] would cause [the plaintiff] to lose some sales of its [product not covered by the patent in suit].

1 **Authority:**

2 *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 863-64, 226 USPQ
3 402, 409-10 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1016 (1986); *Trans-World Mfg.*
4 *Corp. v. Al Nyman & Sons, Inc.*, 633 F. Supp. 1047, 229 USPQ 873 (D. Del. 1986);
5 *Cashman v. Allied Prods. Corp.*, 761 F.2d 1250, 1253 (8th Cir. 1985); *Leoni v. Bemis*
6 *Co.*, 255 N.W.2d 824 (Minn. 1977); *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418,
7 1428, 8 USPQ2d 1323, 1331-32 (Fed. Cir. 1988); *Paper Converting Mach. Co. v.*
8 *Magna-Graphics Corp.*, 785 F.2d 1013, 228 USPQ 938 (Fed. Cir. 1986); *American*
9 *Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1365, 220 USPQ 763, 774-
10 75 (Fed. Cir.), *cert. denied* 469 U.S. 821 (1984); *Central Soya Co. v. Geo A Hormel*
11 *& Co.*, 723 F.2d 1573, 220 USPQ 490 (Fed. Cir. 1983); *Milgo Elec. Corp. v. United*
12 *Business Communications, Inc.*, 623 F.2d 645, 663, 206 USPQ 481, 495 (10th Cir.),
13 *cert. denied*, 449 U.S. 1066, 208 USPQ 376 (1980); *Photo Elecs. Corp. v. England*,
14 581 F.2d 772, 784, 199 USPQ 710, 721 (9th Cir. 1978).

1 **Patent Damages No. 5**

2 **Lost Profits (Panduit Factors)**

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

6 (1) that there was a demand for the
7 patented product,

8
9 (2) that there were no acceptable
10 noninfringing substitutes,

11
12 (3) that [the patentee] had the
13 manufacturing and marketing capacity to make the
14 infringing sales [or a portion thereof] actually made by
15 the [the accused infringer], and

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17 (4) the amount of profit that [the patentee]
18 would have made had [the accused infringer] not
19 infringed.
20

21 I will now explain each of these factors.
22

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27 **Authority:**

28 *State Indus., Inc. v. Mor-Flo Indus., Inc.*, 883 F.2d 1573, 1577-78, 12
29 USPQ2d 1026, 1029-30 (Fed. Cir. 1989), *cert. denied*, 493 U.S. 1022 (1990); *Yarway*
30 *Corp. v. Eur-Control USA, Inc.*, 775 F.2d 268, 275-77, 227 USPQ 352, 357-58 (Fed.
31 Cir. 1985).
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Patent Damages No. 6

Lost Profits (Panduit Factors — Demand)

Demand for the patented product can be proven by significant sales of [the patentee's] patented product or by significant sales of [the accused infringer's] infringing product.

Authority:

Gyromat Corp. v. Champion Spark Plug Co., 735 F.2d 549, 552, 222 USPQ 4, 6 (Fed. Cir. 1984).

1 **Patent Damages No. 7**
2 **Lost Profits (Panduit Factors —**
3 **Acceptable Substitutes)**
4

5 In order to be an acceptable substitute, the product must have the advantages
6 of the patented invention that were important to customers. A product that does not
7 have those advantages would not be an acceptable substitute to the customer who
8 wanted those advantages. If, however, the realities of the marketplace are that
9 competitors other than the patentee would likely have captured the sales made by the
10 infringer, even despite a difference in the products, then the [patentee] is not entitled to
11 lost profits.
12
13

14 **Authority:**

15 *TWM Mfg. Co. v. Dura Corp.*, 789 F.2d 895, 901, 229 USPQ 525, 528-29
16 (Fed. Cir. 1986) (quoting *Panduit Corp. v. Stahlin Bros. Fibre Works, Inc.*, 575 F.2d
17 1152, 1162, 197 USPQ 726, 734-35 (6th Cir. 1978), *cert. denied*, 439 U.S. 856
18 (1986)); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 939 F.2d 1540, 1545-46, 19 USPQ2d
19 1432, 1437-38 (Fed. Cir. 1991); *Standard Havens Prods., Inc. v. Gencor Indus.*, 953
20 F.2d 1360, 1373, 21 USPQ2d 1321, 1331 (Fed. Cir. 1991), *cert. denied* 113 S. Ct. 60
21 (1992); *Kaufman Co. v. Lantech, Inc.*, 926 F.2d 1136, 1142-43, 17 USPQ2d 1828,
22 1832-33 (Fed. Cir. 1991); *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 926
23 F.2d 1161, 17 USPQ2d 1922 (Fed. Cir. 1991).
24

1 **Patent Damages No. 8**

2 **Lost Profits (Panduit Factors —**

3 **Acceptable Substitutes — Relevant Customer)**

4 In order to prove the absence of acceptable noninfringing substitutes, [the
5 patentee] need not prove that there were no non-infringing substitutes acceptable to
6 purchasers of [the patented/infringing products] generally, but rather that there were no
7 non-infringing substitutes acceptable to the actual purchasers of [the accused
8 infringer's] infringing products.

9 The test is whether or not purchasers of [the infringing product] were
10 motivated to make their purchase by features available only from [the infringing
11 product] (and the patented product). If so, non-infringing products without those
12 features would not be "acceptable noninfringing substitutes," even if they otherwise
13 competed in the marketplace with the patented and infringing products.

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18 **Authority:**

19 *Standard Havens Prods., Inc. v. Gencor Indus.*, 953 F.2d 1360, 1373, 21
20 USPQ2d 1321, 1331 (Fed. Cir. 1991), *cert. denied* 113 S. Ct. 60 (1992), citing with
21 approval *Kaufman Co. v. Lantech, Inc.*, 926 F.2d 1136, 1143, n.17, 17 USPQ2d 1828,
22 1833 n.17 (Fed. Cir. 1991); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 939 F.2d 1540,
23 1546, 19 USPQ2d 1432, 1438 (Fed. Cir. 1991).
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Patent Damages No. 9
Lost Profits (Panduit Factors —
Acceptable Substitutes — Niche Market

In determining whether or not [the patentee] has proved that it suffered lost profits as a result of the alleged infringement, you may consider whether there exists a market niche within the total market, which niche is the relevant market for purposes of determining lost profits and in which only the [patented products], the infringing products [and possibly some other product] would be acceptable to purchasers.

Authority:

Yarway Corp. v. Eur-Control USA, Inc., 775 F.2d 268, 276, 227 USPQ 352, 357-58 (Fed. Cir. 1985).

1 **Patent Damages No. 10**

2 **Lost Profits (Panduit Factors — Market)**

3
4 It is not necessary for [the patentee] to prove that [the patentee] and [the
5 accused infringer] were the only two suppliers in the market in order for [the patentee]
6 to demonstrate entitlement to lost profits. If the realities of the marketplace are such
7 that "non-infringing substitutes" were available from suppliers who would have made
8 only some, but not all, of the sales that were made by [the infringer], then [the
9 patentee] may be entitled to lost profits on a percentage of the infringing sales. The
10 burden is on [the patentee], however, to show to a reasonable probability that it would
11 have sold that percentage if the [infringing product] had never existed. By the same
12 token, even if you find that [the patentee] and [the infringer] were the only two
13 suppliers of products having the advantages of the patented product, it does not
14 necessarily mean that [the patentee] would have made all [the infringer]'s sales. The
15 burden is on [the patentee] to show that its product competed in the same market with
16 the [the infringing product] and that it would have made those sale if the infringement
17 had not occurred.

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19 **Authority:**

20 *State Indus., Inc. v. Mor-Flo Indus., Inc.*, 883 F.2d 1573, 1577-78, 12
21 USPQ2d 1026, 1029 (Fed. Cir. 1989), *cert. denied*, 493 U.S. 1022 (1990); *Bic Leisure*
22 *Prods., Inc. v. Windsurfing Int'l, Inc.*, 1 F.3d 1214, 27 USPQ2d 1671 (Fed. Cir.
23 1993).
24

1 **Patent Damages No. 11**

2 **Lost Profits (Panduit Factors — Capacity)**

3
4 [The patentee] is only entitled to lost profits for sales it could have made.

5 [The patentee] must prove that it would have had the ability to manufacture or
6 otherwise obtain its product and the capability to sell the amount of product for which
7 [the patentee] is now claiming lost profits.

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17 **Authority:**

18 *Bio-Rad Lab., Inc. v. Nicolet Instrument Corp.*, 739 F.2d 604, 616, 222
19 USPQ 654, 663-64 (Fed. Cir.), *cert. denied*, 469 U.S. 1038 (1984); *Gyromat Corp. v.*
20 *Champion Spark Plug Co.*, 735 F.2d 549, 554, 222 USPQ 4, 7-8 (Fed. Cir. 1984).
21

1 **Patent Damages No. 12**

2 **Lost Profits (Panduit Factors — Amount of Profit**

3 **Incremental Income Approach)**

4

5 The patentee may calculate its lost profits on lost sales by computing the lost
6 net sales for its patented product and deducting from that figure the amount of
7 additional costs that it would have incurred in making those sales. Certain fixed costs
8 such as property taxes, insurance, rent and administrative overhead, may not vary with
9 increases in production or sale. Any such costs which do not vary with increased
10 production or sale should not be considered when determining damages. Thus, in
11 determining [the patentee's] lost profits, you are not to subtract from its damages the
12 amount of such fixed costs.

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16 **Authority:**

17 *Paper Converting Mach. Co. v. Magna-Graphics Corp.*, 745 F.2d 11, 22,
18 223 USPQ 591, 599 (Fed. Cir. 1984); *Saf-Gard Prods., Inc. v. Service Parts, Inc.*, 491
19 F. Supp. 996, 1008 (D. Ariz. 1980).
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1 **Patent Damages No. 13**

2 **Lost Profits (Panduit Factors —**
3 **Computation of Lost Profits)**

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5 Calculation of lost profits is by its nature imprecise. Doubts concerning the
6 computation of [the patentee's] lost profits should be construed against [the accused
7 infringer]. [The accused infringer] bears the risk of uncertainty.
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12 **Authority:**

13 *King Instrument Corp. v. Otari*, 767 F.2d 853, 226 USPQ 402 (Fed. Cir.
14 1985); *Gyromat Corp. v. Champion Spark Plug Co.*, 735 F.2d 549, 555, 222 USPQ 4,
15 8-9 (Fed. Cir. 1984); *Central Soya Co. v. Geo A Hormel & Co.*, 581 F. Supp. 54, 219
16 USPQ 878 (W.D. Okla. 1983), *aff'd*, 723 F.2d 1573, 220 USPQ 490 (Fed. Cir. 1983);
17 *Lam, Inc. v. Johns-Manville Corp.*, 718 F.2d 1056, 219 USPQ 670 (Fed. Cir. 1983);
18 *Milgo Elec. Corp. v. United Business Communications, Inc.*, 623 F.2d 645, 664, 206
19 USPQ 481, 495-96 (10th Cir.), *cert. denied*, 449 U.S. 1066, 208 USPQ 376 (1980);
20 *Del Mar Avionics, Inc. v. Quinton Instrument Co.*, 836 F.2d 1320, 1327, 5 USPQ2d
21 1255, 1260-61 (Fed. Cir. 1987); *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 1428, 8
22 USPQ2d 1323, 1331-32 (Fed. Cir. 1988).
23

1 **Patent Damages No. 14**

2 **Lost Profits (Panduit Factors —**

3 **Doubts Resolved Against Infringer — Records)**

4

5 All doubts resulting from [the accused infringer's] failure to keep proper records are

6 to be resolved in favor of [the patentee]. Any incorrectness or confusion in [the

7 accused infringer's] records should be held against [the accused infringer], not [the

8 patentee].

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17 **Authority:**

18 *Milgo Elec. Corp. v. United Business Communications, Inc.*, 623 F.2d 645,

19 662 (10th Cir.), *cert. denied*, 449 U.S. 1066, 208 USPQ 376 (1980); *Lam, Inc. v.*

20 *Johns-Manville Corp.*, 718 F.2d 1056, 1065, 219 USPQ 670, 675 (Fed. Cir. 1983).

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1 **Patent Damages No. 15**

2 **Lost Profits (Price Erosion)**

3
4 [The patentee] is entitled to recover additional damages if it can show to a
5 reasonable probability that, if there had been no infringement, [the patentee] would
6 have been able to charge higher prices for its patented products. In that case, you may
7 also award as additional damages the amount represented by the difference between the
8 amount of profits that the patentee would have made by selling its product at the higher
9 price and the amount of profits the patentee actually made by selling its product at the
10 lower price that [the patentee] charged for its patented product. This type of damage is
11 referred to as price erosion damage.

12 If you find that [patentee] suffered price erosion, you may also use the
13 higher price in determining [patentee's] lost profits from sales lost because of the
14 infringement.

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20 **Authority:**

21 *Lam, Inc. v. Johns - Manville Corp.*, 718 F.2d 1056, 1065, 1067, 219
22 USPQ 670, 675-77 (Fed. Cir. 1983); *Minnesota Mining & Mfg. v. Johnson & Johnson*
23 *Orthopaedics, Inc.*, 976 F.2d 1559, 1578-79, 24 USPQ2d 1321, 1337-38 (Fed. Cir.

1 1992); *Micro Motion, Inc. v. Exac Corp.*, 761 F. Supp. 1420, 1430, 19 USPQ2d 1001,
2 1009-10 (N.D. Cal. 1991).
3

1 **Patent Damages No. 16**

2 **Lost Profits (Collateral Sales)**

3
4 In this case, [the patentee] contends that the patented product is ordinarily
5 sold along with [additional collateral products]. If you find that [the patentee] lost sales
6 of its patented product because of [the infringer's] infringement you should then
7 consider whether the infringement also resulted in [the patentee] losing sales of [its
8 collateral products]. Under some circumstances a patent owner may recover lost profits
9 for lost sales of products that it would normally expect to sell along with its patented
10 product. Hence, [the patentee] contends that it would have sold [collateral products]
11 along with its [patented product].

12 To recover lost profits on sales of [collateral products], [the patentee] must
13 prove two things. First [the patentee] must show that [the patentee] probably would
14 have sold [the collateral products] but for the infringement. Second [the patentee] must
15 show that [the collateral products] functioned together with [the patented product] in
16 some way to produce a desired end product or result. In other words, [the patentee]
17 must show that [the collateral product] and [the patented product] together must be
18 analogous to components of a single assembly or parts of a complete machine, or they
19 must constitute a functional unit. If you were to find that [the patentee] has proven
20 these facts, then the profit that [the patentee] would have made from those collateral
21 sales should be part of any damages awarded [the patentee]. Damages for lost profits

1 on lost collateral sales, if any, are calculated in the same manner as I just described for
2 calculating lost profits on the patented product.

3 **Authority:**

4 *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476, 507, 141
5 USPQ 681, 694 (1964); *Livesay Window Co. v. Livesay Indus., Inc.*, 251 F.2d 469,
6 471-72, 116 USPQ 167, 169 (5th Cir. 1958); *Kori Corp. v. Wilco Marsh Buggies &*
7 *Draglines, Inc.*, 761 F.2d 649, 653, 225 USPQ 985, 986-87 (Fed. Cir.), *cert. denied*,
8 474 U.S. 902 (1985); *Paper Converting Mach. Co. v. Magna-Graphics Corp.*, 745
9 F.2d 11, 21, 223 USPQ 591, 598 (Fed. Cir. 1984); *Rite Hite Corp. v. Kelley Co.*, 56
10 F.3d 1538, 35 USPQ2d 1065 (Fed. Cir. 1995).
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1 **Patent Damages No. 17**

2 **Reasonable Royalty**

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4 The patent law specifically provides that the amount of damages that [the
5 accused infringer] must pay [the patentee] for infringing [the patentee's] patent may not
6 be less than a reasonable royalty for the use that [the accused infringer] made of [the
7 patentee's] invention.
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17 **Authority:**

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19 35 U.S.C. § 284; *Hickory Springs Mfg. Co. v. Fredman Bros. Furniture*
20 *Co.*, 509 F.2d 55, 184 USPQ 459 (7th Cir. 1975), cited in _____ Burton, *Jury*
21 *Instructions in Intellectual Property Cases* § 20:84:01 (1988).
22

1 **Patent Damages No. 18**

2 **Reasonable Royalty**

3

4 If you find that [the patentee] has not proved its claim for lost profits, or if

5 you find that [the patentee] has proved its claim for lost profits for only a portion of the

6 infringing sales, you must then determine what a reasonable royalty would be for that

7 portion of the infringer's sales for which you have not awarded lost profit damages.

8 [The patentee] is entitled to a reasonable royalty for all infringing sales for which it is

9 not entitled to lost profits damages.

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16 **Authority:**

17 *Saf-Gard Prods., Inc. v. Service Parts, Inc.*, 491 F. Supp. 996, 1006, 206

18 USPQ 976, 984 (D. Ariz. 1980); *State Indus., Inc. v. Mor-Flo Indus., Inc.*, 883 F.2d

19 1573, 1577, 12 USPQ2d 1026, 1028-29 (Fed. Cir. 1989), *cert. denied*, 493 U.S. 1022,

20 17 USPQ2d 1706 (1990); *Orthman Mfg. v. Chromalloy Am. Corp.*, 512 F. Supp. 1284,

21 210 USPQ 364 (C.D. Ill. 1981); *Bio-Rad Lab. v. Nicolet Instrument Corp.*, 739 F.2d

22 604, 616, 222 USPQ 654, 663 (Fed. Cir. 1984).

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1 **Patent Damages No. 19**

2 **Definition of Reasonable Royalty**

3
4 A royalty is a payment made to the owner of a patent by a non-owner in
5 exchange for rights to make, use or sell the claimed invention. A reasonable royalty is
6 the royalty that would have resulted from a hypothetical negotiation between [patentee]
7 and a person [company] in the position of [defendant] taking place at the time that the
8 infringement began. You should also assume that both parties to that negotiation
9 understood the patent to be valid and infringed and that the licensee would respect the
10 patent.

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15 **Authority:**

16 *State Indus., Inc. v. Mor-Flo Indus., Inc.*, 883 F.2d 1573, 1579, 12
17 USPQ2d 1026, 1030 (Fed. Cir. 1989), *cert. denied*, 493 U.S. 1022, 17 USPQ2d 1706
18 (1990); *Georgia-Pacific Corp. v. United States Plywood Corp.*, 318 F. Supp. 1116,
19 166 USPQ 235 (S.D.N.Y. 1970), *modified and aff'd sub nom.*, *Georgia-Pacific Corp.*
20 *v. United States Plywood Champion Papers, Inc.*, 446 F.2d 295, 170 USPQ 369 (2d
21 Cir.), *cert. denied*, 404 U.S. 870, 171 USPQ 322 (1971); *Trio Process Corp. v. L*
22 *Goldstein's Sons, Inc.*, 533 F.2d 126, 129, 189 USPQ 561, 563-64 (3d Cir. 1976).
23

1 **Patent Damages No. 20**

2 **Reasonable Royalty (Relevant Factors)⁴**

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

6 1. Any royalties received by [the patentee]
7 for the licensing of the patent in suit, proving or
8 tending to prove an established royalty.

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10 2. The rates paid by [the accused
11 infringer] to license other patents comparable to the
12 [patent in suit].

13
14 3. [The patentee's] established policy and
15 marketing program to maintain his right to exclude
16 others from using the patented invention by not
17 licensing others to use the invention, or by granting
18 licenses under special conditions designed to preserve
19 that exclusivity.

20
21 4. The commercial relationship between
22 the licensor and the licensee, such as whether or not
23 they are competitors in the same territory in the same
24 line of business.

25
26 5. The effect of selling the patented
27 product in promoting sales of other products of the
28 licensee; the existing value of the invention to the
29 licensor as a generator of sales of his non-patented
30 items; and the extent of such collateral sales.

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32 6. The duration of the patent.

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34 7. The established profitability of the
35 product made under the patent; its commercial
36 success; and its current popularity.

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⁴ N.B The court should not, of course, instruct as to factors that are not supported by any substantial evidence in the particular case.

1 8. The utility and advantages of the
2 patented invention over the old modes or devices, if
3 any, that had been used for achieving similar results.
4

5 9. The nature of the patented invention;
6 the character of the commercial embodiment of it as
7 owned and produced by the licensor; and the benefits
8 to those who have used the invention.
9

10 10. The extent to which the accused
11 infringer has made use of the invention; and any
12 evidence that shows the value of that use.
13

14 11. The portion of the profit or of the
15 selling price that may be customary in the particular
16 business or in comparable businesses to allow for the
17 use of the invention or analogous inventions.
18

19 12. The portion of the profit that arises
20 from the patented invention itself as opposed to profit
21 arising from features unrelated to the patented
22 invention, such as the manufacturing process, business
23 risks, or significant features or improvements added
24 by the accused infringer.
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37 **Authority:**

38 *Georgia-Pacific Corp. v. United States Plywood Corp.*, 318 F. Supp. 1116,
39 166 USPQ 235 (S.D.N.Y. 1970), *modified and aff'd sub. nom.*, *Georgia-Pacific Corp.*
40 *v. United States Plywood Champion Papers, Inc.*, 446 F.2d 295, 170 USPQ 369 (2d
41 Cir.), *cert. denied*, 404 U.S. 870, 171 USPQ 322 (1971); *TWM Mfg. Co. v. Dura*
42 *Corp.*, 789 F.2d 895, 898-900, 229 USPQ 525, 526-28 (Fed. Cir. 1986).
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1 **Patent Damages No. 21**

2 **Reasonable Royalty (Expert Opinion)**

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4 You may consider expert opinions as to what the amount of a reasonable
5 royalty should be.
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20 **Authority:**

21 *Hanson v. Alpine Valley Ski Area, Inc.*, 718 F.2d 1075, 1079, 219 USPQ
22 679, 682-83 (Fed. Cir. 1983).
23

1 **Patent Damages No. 22**

2 **Reasonable Royalty (Timing)**

3
4 Although the relevant date for the hypothetical reasonable royalty
5 negotiation is the date that the infringement began, you may consider in your
6 determination of reasonable royalty damages any actual profits by [the accused
7 infringer] after that time and any commercial success of the patented invention in the
8 form of sales of the patented or infringing products after that time. You may only
9 consider this information, however, if it was foreseeable at the time that the
10 infringement began.

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17 **Authority:**

18 *Fromson v. Western Litho Plate & Supply Co.*, 853 F.2d 1568, 1575-76, 7
19 USPQ2d 1606, 1613-14 (Fed. Cir. 1988), quoting with approval *Sinclair Refining Co.*
20 *v. Jenkins Petroleum Process Co.*, 289 U.S. 689, 698-99 (1933); accord *Trans-World*
21 *Mfg. Corp. v. Al Nyman & Sons, Inc.*, 750 F.2d 1552, 1556-58, 224 USPQ 259, 261-
22 62 (Fed. Cir. 1984); *Studiengesellschaft Kohle, mbH v. Dart Indus., Inc.*, 862 F.2d
23 1564, 1571-72, 9 USPQ2d 1273, 1280-81 (Fed. Cir. 1988); *Trell v. Marlee Elecs.*
24 *Corp.*, 912 F.2d 1443, 1446, 1448, 16 USPQ2d 1059, 1061, 1063 (Fed. Cir. 1990)
25 (remanding with instructions to follow *Fromson* methodology and stating that district
26 court may consider the infringer's anticipated profits, as indicated by evidence of *actual*
27 profits); *State Indus., Inc. v. Mor-Flo Indus., Inc.*, 883 F.2d 1573, 1581, 12 USPQ2d

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1026, 1031-32 (Fed. Cir. 1989), *cert. denied*, 493 U.S. 1022, 17 USPQ2d 1706 (1990) (holding district court could properly consider infringer's actual net profits during the period of infringement); and *Honeywell, Inc. v. Minolta Camera Co., Ltd.*, Civil Action Nos. 87-4847 and 88-1624 (D.N.J. Jan 28, 1992) (p. 71, ¶ 13 of charge to the jury).

1 **WILLFUL INFRINGEMENT**

2
3 You are instructed that where a potential infringer has actual notice of
4 another's patent rights, he has an affirmative duty of due care not to infringe. Thus if
5 you find by a preponderance of the evidence that [the defendant] infringed the
6 plaintiff's patent, either literally or under the doctrine of equivalents¹, then you must
7 further determine if this infringement was willful. Willfulness must be proven by clear
8 and convincing evidence² showing that:

9 A. [The defendant] had actual knowledge of [the plaintiff's] patent³, and

10 B. [The defendant] had no reasonable basis for believing (a) that [the
11 defendant's] [product] [process] [apparatus] [composition] did not infringe [the
12 plaintiff's] patent or (b) that [the plaintiff's] patent was invalid.

13 In making the determination as to willfulness, you must consider the totality
14 of the circumstances⁴. The totality of the circumstances comprises a number of factors,
15 which include, but are not limited to whether [the defendant] intentionally copied the
16 product covered by the plaintiff's patent⁵, whether the defendant exercised due care to
17 avoid infringing the patent⁶, whether the defendant relied on competent legal advice⁷,
18 and the defendant's behavior as a party to the litigation⁸.

¹ *Hoechst Celanese Corp. v. BP Chemicals Ltd.*, 78 F.3d 1575, 1583 (Fed.Cir. 1996).

² *Hoechst Celanese*, 78 F.3d at 1583.

³ See, *Gustafson, Inc. v. Intersystems Industrial Products, Inc.*, 897 F.2d 508, 510-11 (Fed.Cir. 1990); *Ortho Pharmaceutical Corporation v. Smith*, 959 F.2d 936, 944 (Fed.Cir. 1992); But see, *State Industries, Inc. v. Mor-Flo Industries, Inc.*, 883 F.2d 1573, 1581 (Fed.Cir. 1989).

⁴ *Gustafson*, 897 F.2d at 510.

⁵ *In re Hayes Microcomputer Products, Inc.*, 982 F.2d 1527, 1543 (Fed.Cir. 1992).

⁶ *Jurgens v. CBK, Ltd.*, 80 F.3d 1566, 1571 (Fed.Cir. 1996).

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⁷ *Ryco, Inc. v. Ag-Bag Corporation*, 857 F.2d 1418, 1428 (Fed.Cir. 1988); Ortho, 959 F.2d at 944.

⁸ *In re Hayes Microcomputer*, 982 F.2d at 1543.

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