

Model Patent Jury Instructions

prepared by

The National Jury Instruction Project

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INTRODUCTION

Chief Judge Paul R. Michel of the United States Court of Appeals for the Federal Circuit requested the members of this National Jury Instruction Project to develop a set of model jury instructions for patent infringement cases. The goal was to create a committee, national in scope, with members from both the bench and bar. The underlying idea was to benefit from the collective experience of both judges and attorneys who are interested in creating an easier to understand and streamlined set of model jury instructions.

The following instructions are the result of the project. These instructions will not be endorsed by the Federal Circuit Court of Appeals and are not intended to be “official” jury instructions. Nor is any particular member of this Committee endorsing any particular instruction. These instructions are intended to be helpful models for judges and lawyers. In devising this set of instructions, we have looked to and drawn from the work of others, including the committees for the Northern District of California, The Federal Circuit Bar Association, the AIPLA, and the District of Delaware. We have also benefited tremendously from extensive comments we received during the public comment period from a diverse and large number of contributors. These contributors have included individual federal judges, inventors, attorneys, law firms, corporations, bar groups and trade associations. Special thanks to the American Bar Association Section of Intellectual Property Law, Federal Circuit Bar Association and Intellectual Property Owners Association for their comment sets.

Judges and lawyers who use these instructions will need to supplement them with instructions that speak generally to the trial and the jury’s duties, such as the nature of the evidence and the duty to deliberate. In addition, this set of model instructions, like all model instructions, will have to be tailored to the facts and issues of the particular case. When

particular legal issues are implicated by the circumstances of a particular case, additions to the instructions should be considered and may well be warranted. This set of instructions is intended to be a helpful starting point for the development of a jury charge.

We thank Ed Good, Writer-in-Residence at Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, for comments and suggestions on style and substance.

These instructions will be timely updated to incorporate developments in the law. If you have comments, corrections, or suggested changes, please send them to:

PatentJuryInstructions@gmail.com. The instructions are available for download at: <http://www.nationaljuryinstructions.org/> . Updates to the instructions will also be provided on-line at that address.

PRELIMINARY INSTRUCTIONS

1.1 WHAT A PATENT IS AND HOW ONE IS OBTAINED

This case involves a dispute over a United States patent. Before summarizing the positions of the parties and the legal issues involved in the dispute, I want to explain what a patent is and how one is obtained.

The United States Constitution grants Congress the powers to enact laws “to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.” Using this power, Congress enacted the patent laws.

Patents are granted by the United States Patent and Trademark Office (sometimes called “the PTO”). A valid United States patent gives the patent holder certain rights [for up to 20 years from the date the patent application was filed] [for 17 years from the date the patent issued]. The patent holder may prevent others from making, using, offering to sell, or selling the patented invention within the United States, or from importing it into the United States without the patent holder’s permission. A violation of the patent holder’s rights is called infringement. The patent holder may try to enforce a patent against persons believed to be infringers by a lawsuit filed in federal court.

The process of obtaining a patent is called patent prosecution. To obtain a patent, one must file an application with the PTO. The PTO is an agency of the federal government and employs trained examiners who review applications for patents. The application includes a section called the “specification,” which must contain a written description of the claimed invention telling what the invention is, how it works, and how to make and use it, in such full, clear, concise, and exact terms so that others skilled in the field will know how to make and use

it. The specification concludes with one or more numbered sentences. These are the patent “claims.” If the patent is eventually granted by the PTO, the claims define the boundaries of its protection and give notice to the public of those boundaries. Claims can be independent or dependent. An independent claim is self-contained. A dependent claim refers back to an earlier claim and includes the requirements of the earlier claim.

After the applicant files a patent application, a PTO patent examiner reviews it to determine whether the claims are patentable and whether the specification adequately describes the invention claimed. In examining a patent application, the patent examiner may review “prior art.” Prior art is defined by law, and, at a later time, I will give you specific instructions on what constitutes prior art. In general, though, prior art includes things that existed before the claimed invention, that were publicly known or used in this country, or that were patented or described in a publication in any country. The examiner considers, among other things, whether each claim defines an invention that is new, useful, and not obvious when compared with the prior art. A patent lists the prior art the examiner considered; this list is called the “cited references.” The cited references include the prior art found by the examiner as well as any prior art submitted to the PTO by the applicant.

After the prior art search and examination of the application, the patent examiner then informs the applicant in writing what the examiner has found and whether any claim is patentable, and thus will be “allowed.” This writing from the patent examiner is called an “office action.” If the examiner rejects any of the claims, the applicant then responds and sometimes changes the claims or submits new claims. This process, which takes place only between the examiner and the patent applicant, may go back and forth for some time until the examiner believes that the application and claims meet the requirements for a patent. The papers

generated during this time of communicating back and forth between the patent examiner and the applicant make up what is called the “prosecution history.” All of this material becomes available to the public no later than the date when the PTO grants the patent.

Just because the PTO grants a patent does not necessarily mean that any invention claimed in the patent is, in fact, legally entitled to the protection of a patent. One or more claims may, in fact, not be patentable under the law. A person accused of infringement has the right to argue here in federal court that a claimed invention in the patent is not entitled to patent protection because it does not meet the requirements for a patent. In other words, an accused infringer may defend a suit for patent infringement on the grounds that the patent is invalid.

Committee Note:

Patent Video: We suggest lawyers and judges consider using these instructions in conjunction with the Federal Judicial Center’s video [Introduction to Patents](#).

1.2 THE PATENT INVOLVED IN THIS CASE

Let's take a moment to look at [the patent] [one of the patents] in this case. The cover page of the patent identifies the date the patent was granted and patent number along the top, as well as the inventor's name, the filing date, and a list of the references considered in the PTO.

The specification of the patent begins with an abstract, also found on the cover page. The abstract is a brief statement about the subject matter of the invention. Next come the drawings. The drawings illustrate various aspects or features of the invention. The written description of the invention appears next and is organized into two columns on each page. The specification ends with numbered paragraphs. These are the patent claims.

1.3 THE POSITIONS OF THE PARTIES

To help you follow the evidence, I will now give you a summary of the positions of the parties. The parties in this case are [the patent holder] and [the alleged infringer]. The case involves a patent obtained by [the inventor], and transferred by [the inventor] to [the patent holder]. The patent involved in this case is United States Patent [patent number], which lists [the inventor] as the inventor. For convenience, the parties and I will often refer to this patent as the [‘XXX] patent. [XXX] are the last three digits of the patent number.

[The patent holder] alleges that [the alleged infringer] has infringed claims [] of the [XXX] patent by making [using] a product [method] that includes all of the requirements of those claims. [The alleged infringer] alleges that the asserted claims are not infringed and are also invalid. To fulfill your duties as jurors, you must decide whether claims [] of the [XXX] patent have been infringed and whether those claims are invalid. If you decide that any claim of the [XXX] patent has been infringed and is not invalid, you will then need to decide any money damages to be awarded to [the patent holder] to compensate for that infringement. [You will also need to decide whether the infringement was willful. If you decide that any infringement was willful, that decision should not affect any damage award you give. I will take willfulness into account later in the proceedings.]

It is my job as judge to determine the meaning of any claim language that needs interpretation. You must accept the meanings I give you and use them when you decide whether any claim of the patent has been infringed and whether any claim is invalid. [I have already given you a copy of the meanings I have adopted for certain claim terms.]

1.4 BURDEN OF PROOF—PREPONDERANCE OF THE EVIDENCE

When a party has the burden of proof on any claim or defense by a preponderance of the evidence, it means the evidence must persuade you that the claim or defense is more probable than not.

You should base your decision on all of the evidence, regardless of which party presented it.

Committee Note:

Burden of Proof: In these instructions, for example in instructions 3.2, 3.3, and 3.7, the Committee has adopted “more probable than not” as a statement of the burden of proof. If the instructions are used as proposed, the above instruction on the preponderance of the evidence is not necessary. The above instruction is included for the event that the court and parties chose to use a “preponderance of the evidence” as a statement of the burden of proof.

1.5 BURDEN OF PROOF—CLEAR AND CONVINCING EVIDENCE

When a party has the burden of proving any claim or defense by clear and convincing evidence, it means the evidence has persuaded you that the claim or defense is highly probable.¹ Such evidence requires a higher standard of proof than proof by a preponderance of the evidence.

Again, you should base your decision on all of the evidence, regardless of which party presented it.

Committee Note:

Burden of Proof: In these instructions, for example in instructions 5.2, 5.3, and 5.9, the Committee has adopted “highly probable” as a statement of the burden of proof. If the instructions are used as proposed, the above instruction on clear and convincing evidence is not necessary. The above instruction is included for the event that the court and parties chose to use “clear and convincing” as a statement of the burden of proof.

¹ Colorado v. New Mexico, 453 U.S. 310, 316-317 (1984); Pfizer Inc. v. Apotex, Inc., 480 F.3d 1348, 1360 n. 5 (Fed. Cir. 2007); Intel v. Intern. Trade Comm’n, 946 F.2d 821, 831 (Fed. Cir. 1991).

1.6 GLOSSARY OF PATENT AND TECHNICAL TERMS

To assist you in your deliberations, I have attached a Glossary of Patent and Technical Terms that identifies terms used in patent matters and gives you a definition of those terms.

Committee Note:

Glossary: Where appropriate the court should add to the glossary technical terms that the parties expect will come up at trial.

GLOSSARY OF PATENT TERMS

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

Claims – The numbered sentences appearing at the end of the patent that define the invention. The words of the claims define the scope of the patent holder's exclusive rights during the life of the patent. Claims can be independent or dependent. An independent claim is self-contained. A dependent claim refers back to an earlier claim and includes the requirements of the earlier claim.

File wrapper – Another term for the “prosecution history” defined later.

License – Permission to use or make the patented invention, or perform any of the other exclusive rights granted by the patent, which may be granted by a patent holder (or a prior licensee) in exchange for a fee called a “royalty” or other types of payment.

Office action – Communication from the patent examiner regarding the patent application.

Patent examiners – Personnel employed by the PTO who review (examine) patent applications, each in a specific technical area, to determine whether the claims of a patent application are patentable and whether the specification adequately describes and enables the claimed invention.

Prior art – Prior art is not art as one might generally understand the word art. Rather, prior art is a technical term relating to patents. In general, it includes things that existed before the claimed invention and might typically be a patent or a printed publication. I will give you a more specific definition of prior art later.

Prosecution history – The written record of proceedings between the applicant and the PTO, including the original patent application and later communications between the PTO and applicant.

Specification – The information that appears in the patent and concludes with one or more claims. The specification includes the written text and the drawings (if any). In the specification, the inventor should provide a description telling what the invention is, how it works, and how to make and use it so as to enable others skilled in the art to do so, and what the inventor believed at the time of filing to be the best way of making the invention.

Ordinary skill in the art – The level of experience, education, and/or training that those individuals who worked in the area of the invention ordinarily possessed at the time of the effective filing date of the patent application.

2 FINAL INSTRUCTIONS

2.1 CONTENTIONS OF THE PARTIES

[The patent holder] contends that [the alleged infringer] makes, uses, offers to sell, sells or imports a [product] [method] that infringes claims [] of the [XXX] patent.

[The alleged infringer] denies that it is infringing the claims of the [XXX] patent. [The alleged infringer] also contends that claims [] of the [XXX] patent are invalid [or unenforceable]. [INSERT BRIEF DESCRIPTION OF THE PARTICULAR INVALIDITY DEFENSES BEING ASSERTED].

Invalidity is a defense to infringement. Therefore, even though the PTO examiner has allowed the claims of the [XXX] patent, you, the jury, must decide whether the claims of the [XXX] patent are invalid.

Your job is to decide whether the asserted claims of the [XXX] patent have been infringed and whether any of the asserted claims of the [XXX] patent are invalid. If you decide that any claim of the patent has been infringed and is not invalid, you will then need to decide any money damages to be awarded to [the patent holder] as compensation for the infringement. [You will also need to decide whether the infringement was willful. If you decide that any infringement was willful, that decision should not affect any damage award you make. I will take willfulness into account later.]

Committee Notes:

Infringement Not In Issue: Where infringement is not an issue at trial, but validity is, the Committee recommends that the court give the jury the following instruction:

[The alleged infringer] does not dispute that it infringes claims [] of [the patent holder]'s [XXX] patent, if those claims are valid, by making, using, offering to sell, selling or importing into the United States a [product] [method] that has each of the requirements of claims [] of [the patent holder]'s patent. [The alleged infringer], however, contends that claims [] are invalid.

Indefiniteness. The Committee has not included instructions on indefiniteness because the Federal Circuit has ruled that this is a matter for the court to decide. LNP Eng'g v. Miller Waste Mills, Inc., 275 F.3d 1347, 1357 (Fed. Cir. 2001).

Inequitable Conduct. The Committee has not included instructions on inequitable conduct as it sees this as normally a matter for the Court rather than the jury. Foster v. Hallco Mfg. Co., 947 F. 2d 469 (Fed. Cir. 1991).

3 INFRINGEMENT

3.1 DIRECT INFRINGEMENT—GENERALLY

A patent claim may be directly infringed in two ways. A claim may be “literally” infringed or it may be infringed under the “doctrine of equivalents.” I will now instruct you on the specific rules you must follow to determine whether [the patent holder] has proven that [the alleged infringer] has infringed one or more of the patent claims involved in this case.

3.2 DIRECT INFRINGEMENT—LITERAL INFRINGEMENT

You must decide whether [the alleged infringer] has made, used, sold, or offered for sale within the United States, or imported into the United States, a product [method] covered by claims [] of the [XXX] patent. You must compare each claim to [the alleged infringer]’s product [method] to determine whether every requirement of the claim is included in the accused product [method].

To prove literal infringement, [the patent holder] must prove that it is more probable than not that [the alleged infringer]’s product [method] includes every requirement [step] in [the patent holder]’s patent claim. If [the alleged infringer]’s product [method] omits any requirement [step] recited in [the patent holder]’s patent claim, [the alleged infringer] does not infringe that claim.

For literal infringement, [the patent holder] is not required to prove that [the alleged infringer] intended to infringe or knew of the patent.

Committee Note:

Requirements. The Committee decided to use the word “requirements” to identify the elements or limitations in a claim. We are aware of the statement in Lockheed Martin Corp. v. Space Systems/Loral, Inc., 324 F. 3d 1308, 1315 n.1 (Fed. Cir. 2003), quoting Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 234 F. 3d 558, 564 n.1 (Fed. Cir. 2000), that “[i]t is preferable to use the term ‘limitation’ when referring to claim language and the term ‘element’ when referring to the accused device.” Nevertheless, we believe the word requirements is more descriptive than the word limitation, and it will communicate more clearly to the jury the concept of claim elements or limitations than does the word limitation.

3.3 THE MEANING OF CLAIM TERMS

I have defined certain words and phrases in the patent claims. During your deliberations you must apply these meanings:

3.4 OPEN-ENDED OR “COMPRISING” CLAIMS

The beginning, or preamble, of claim [] uses the word “comprising.”² “Comprising” means “including” or “containing but not limited to.” That is, if you decide that [the alleged infringer]’s product [method] includes all the requirements [steps] in claim [], the claim is infringed. This is true even if the accused product [method] includes components [steps] in addition to those requirements.³

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

² CIAS, Inc. v. Alliance Gaming Corp., 504 F.3d 1356, 1361 (Fed. Cir. 2007) (holding that “comprised of” has the same open-ended meaning as “comprising.”)

³ Genentech, Inc. v. Chiron Corp., 112 F.3d 495, 501 (Fed. Cir. 1997).

3.5 “CONSISTING ESSENTIALLY OF” CLAIMS

The beginning of claim [] uses the phrase “consisting essentially of.” “Consisting essentially of” means that the claimed invention may include requirements that are not expressly listed in the claim, provided those additional requirements do not significantly⁴ affect the basic and novel properties of the invention. In other words, patent claims that include the language “consisting essentially of” will be infringed only if [the patent holder] proves that any requirements [steps] added by [the alleged infringer] beyond those in the claim(s) do not significantly affect the basic and novel features of the claimed invention.⁵

⁴ The word “materially” here has been replaced with “significantly” to make the instruction more jury-friendly. See Bryan A. Garner, ed., BLACK’S LAW DICTIONARY (8th ed. 2004) (“material[:] Of such a nature that knowledge of the item would affect a person’s decision-making; significant; essential”).

⁵ AK Steel Corp. v. Sollac & Ugine, 344 F.3d 1234, 1239 (Fed. Cir. 2003); CIAS, Inc. v. Alliance Gaming Corp., 504 F.3d 1356, 1361 (Fed. Cir. 2007).

3.6 “CONSISTING OF” CLAIMS

The beginning of claim [] uses the phrase “consisting of.” “Consisting of” means that the claimed invention contains only what is expressly stated in the claim. But it does not limit aspects unrelated to the invention. A patent claim using the phrase “consisting of” will be infringed if you decide that [the alleged infringer]’s product [method] includes all the requirements [steps] stated in the patent claim and does not include any additional requirements [steps] related to the invention.⁶

⁶ Norian Corp. v. Stryker Corp., 363 F.3d 1321, 1331 (Fed. Cir. 2004). Impurities that a person of ordinary skill in the art would ordinarily associate with a requirement on the “consisting of” list do not exclude the accused product or process from infringement. See Conoco, Inc. v. Energy & Environmental Intern., L.C., 460 F.3d 1349, 1360 (Fed. Cir. 2006).

3.7 INFRINGEMENT OF DEPENDENT CLAIMS

So far, my instructions on infringement have applied to what are known as independent claims. The patent also contains dependent claims. Each dependent claim refers to an independent claim. A dependent claim includes each of the requirements of the independent claim to which it refers and one or more additional requirements.

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

[The patent holder] must prove that it is more probable than not that a patent claim has been infringed.

3.8 DIRECT INFRINGEMENT—DOCTRINE OF EQUIVALENTS

[The patent holder] alleges that [the alleged infringer] infringed claim [] of the patent under the “doctrine of equivalents.”

To prevail on its allegation of infringement, [the patent holder] must prove that it is more probable than not that the accused product [method] contains requirements identical or equivalent to each claimed requirement [step] of the patented invention. You must proceed on a requirement-by-requirement [step-by-step] basis. [The patent holder] must establish that each requirement in the claim is present in the accused product, either literally or under the doctrine of equivalents.

A claim requirement is present in an accused product [method] under the doctrine of equivalents if the difference between the claim requirement and a corresponding aspect of the accused product [method] is insubstantial.

In making this determination, you may consider whether the corresponding aspect [step] performs substantially the same function in substantially the same way to achieve substantially the same result as the requirement in the claim. You may also consider whether people of ordinary skill in the art believed that the corresponding aspect [step] of the accused product [method] and the requirement recited in the patent claim were interchangeable at the time of the alleged infringement.⁷ The proper time for evaluating equivalency—and thus knowledge of interchangeability between requirements—is the time of infringement, not the time the patent was issued. Under the doctrine of equivalents, those of ordinary skill in the art do not have to know of the equivalent when the patent application was filed or when the patent issued. Thus,

⁷ Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 520 U.S. 17, 117 S.Ct. 1040, 1053 (1997).

the inventor need not have foreseen, and the patent need not describe, all potential equivalents to the invention covered by the claims. Also, changes in technique or improvements made possible by technology developed after the patent application is filed may still be equivalent for the purposes of the doctrine of equivalents.⁸

⁸ There are certain limitations on the application of the doctrine of equivalents. Most notably, some equivalents are barred by prosecution history estoppel. “A patentee who narrows a claim as a condition for obtaining a patent disavows his claim to the broader subject matter, whether the amendment was made to avoid the prior art or to comply with § 112.” Festo Corp. v. Shoketsu Kinzo Kukogyo Kabushiki Co., 535 U.S. 722, 737, 122 S.Ct. 1840 (2002). Issues of prosecution history estoppel are questions of law resolved by a judge, not a jury. “We have stated on numerous occasions that whether prosecution history estoppel applies, and hence whether the doctrine of equivalents may be available for a particular claim limitation, presents a question of law.” Festo Corp. v. Shoketsu Kinzo Kukogyo Kabushiki Co., 334 F.3d 1359, 1367-1368 (Fed. Cir. 2003) (en banc). The doctrine of equivalents also may not be used in a way that wholly eliminates a claim requirement. For example, if a patent claim includes a requirement that a claimed device must be nonmetallic, a patent holder may not assert the patent claim against a metallic device on the ground that a metallic device is equivalent to a nonmetallic device. Paice LLC v. Toyota Motor Corp., 504 F.3d 1293, 1308-09 (Fed. Cir. 2007). Whether the application of the doctrine of equivalents would vitiate a claim requirement is a question of law. See DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc., 469 F.3d 1005, 1018-19 (Fed. Cir. 2006).

3.9 DIRECT INFRINGEMENT—MEANS-PLUS-FUNCTION CLAIMS

Some patent claim requirements may describe a “means” [step] for performing a function, rather than describing the structure [act] that performs the function.⁹ For example, let’s say that a patent describes a table in which the legs are glued to the tabletop. One way an inventor may claim the table is to require the tabletop, four legs, and glue between the legs and the tabletop. Another way to claim the table is to require the tabletop and the legs, but instead of stating “glue,” the inventor states a “means for securing the legs to the tabletop.” This second type of claim requirement is called a “means-plus-function” requirement. It describes a means for performing the function of securing the legs to the tabletop, rather than requiring the glue.

When a claim requirement is in means-plus-function form, it covers the structures [acts] described in the patent specification for performing the function stated in the claim and also any structure [act] equivalent to the described structures [acts]. In my example, the claim covers a table using glue to secure the legs to the tabletop, as described in the patent, and any equivalent structure to glue that performs the function of securing the legs to the tabletop.

Claims [] of the [XXX] patent include means-plus-function requirements. In instructing you about the meaning of a means-plus-function claim requirement, I will tell you, first, the function that is performed, and second, the structure [act] disclosed in the patent specification that corresponds to that function.¹⁰

⁹ 35 U.S.C. §112, ¶6 provides: “An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.”

¹⁰ See *Allvoice Computing PLC v. Nuance Commc’n, Inc.*, 504 F.3d 1236, 1240-41 (Fed. Cir. 2007) (describing the two-step claim construction of a means-plus-function requirement).

To establish literal infringement of a claim that includes means-plus-function requirements, [the patent holder] must prove two things:

1. the relevant structure [act] in the accused device performs the identical function I identified, and
2. the accused device [process] employs a structure [act] identical or equivalent to the structure [act] described in the patent.

Where the structure [act] in the accused device and the structure [act] disclosed in the patent specification are not identical, [the patent holder] has the burden of proving that it is more probable than not that the relevant structure in the accused device, as I have identified it for you, is equivalent to the disclosed structure [act] in the patent.

Two structures [acts] are equivalent if a person of ordinary skill in the art would consider the differences between them to be insubstantial for performing the required function.¹¹ One way to determine this is to look at whether or not the accused structure [act] performs the identical function in substantially the same way to achieve substantially the same result.¹² Another way is to consider whether people of ordinary skill in the art believed that the structure of the accused product [method] and the structure in the patent were interchangeable at the time the patent was issued by the PTO.¹³

¹¹ WMS Gaming Inc. v. Int'l Game Tech, 184 F.3d 1339, 1351 (Fed. Cir. 1999) (holding that the disputed issue of substantiality is factual and should be resolved by a jury).

¹² Applied Medical Resources Corp. v. United States, 448 F.3d 1324, 1333 (Fed. Cir. 2006).

¹³ See Al-Site Corp. v. VSI Int'l, Inc., 174 F.3d 1308, 1320 (Fed. Cir. 1999) (“An equivalent structure or act under Section 112 cannot embrace technology developed after the issuance of the patent because the literal meaning of a claim is fixed upon issuance.”) However, an “after-arising equivalent” might infringe under the doctrine of equivalents. Id. An equivalence analysis under §112, ¶ 6 and the doctrine of equivalents is not coextensive. For example, §112, ¶6 requires identical, not equivalent function. Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus. Inc., 145 F.3d 1303, 1310-1311 (Fed. Cir. 1998). Moreover, the doctrine of equivalents is determined as of the time of infringement, and equivalence under §112, ¶6 is determined at the time of the issuance of the patent. Nonetheless, the tests for equivalence are closely related. See Warner-Jenkinson, 520 U.S. at 26, 117 S.Ct. at 1048. This is a confusing nook of the law.

Committee Note:

Doctrine of Equivalents Applied to a Means-Plus-Function Claim. In some cases a patent holder may contend that a means-plus-function claim is infringed under the doctrine of equivalents. In such a case, the Committee suggests adding the following language at the end of the above instruction:

If the function performed by the relevant structure [act] in the accused device [method] is not identical to the function recited in the means-plus-function requirement, infringement may be proved under the doctrine of equivalents. To prove equivalent infringement in such situation, [the patent holder] must prove that (following the guidelines for establishing equivalence set forth above):

1. the relevant structure [act] in the accused device performs a function equivalent to the function specified in the claim, and
2. the accused device employs a structure [act] identical or equivalent to the structure [act] described in the patent.

3.10 INDIRECT INFRINGEMENT

[The patent holder] alleges that [the alleged infringer] indirectly infringed the patent. There are two types of indirect infringement: inducing infringement and contributory infringement. The act of encouraging or inducing others to infringe a patent is called “inducing infringement.” The act of contributing to the infringement of others by, for example, supplying them with components for use in the patented invention, is called “contributory infringement.”¹⁴

¹⁴ See 35 U.S.C. §§ 271(b), (c).

3.11 INDUCING PATENT INFRINGEMENT¹⁵

A party induces patent infringement if it purposefully causes, urges, or encourages another to infringe the claims of a patent. Inducing infringement cannot occur unintentionally. This is different from direct infringement, which can occur unintentionally.

To prove that [the alleged infringer] induced patent infringement, [the patent holder] must prove that it is more probable than not that:

1. [the alleged infringer] actively encouraged or instructed another person on how to [use a product or perform a process] in a way that infringes at least one patent claim;
2. [the alleged infringer] knew of the patent at that time;
3. [the alleged infringer] knew, or should have known, that the encouragement or instructions would result in infringement of at least one patent claim; and
4. the other person infringed at least that one patent claim.

[The patent holder] must prove that [the alleged infringer] had a specific intent to induce the infringement. [The patent holder] must prove that [the alleged infringer] knowingly induced infringement, not merely that [the alleged infringer] knowingly induced the acts that constitute infringement.¹⁶

¹⁵ 35 U.S.C. §271(b) provides that “[w]hoever actively induces infringement of a patent shall be liable as an infringer.” See generally DSU Medical Corp. v. JMS Co. Ltd., 471 F.3d 1293, 1304 (Fed. Cir. 2006).

¹⁶ There is a difference in view as to whether this instruction should include the following phrase: “Finally, [the patent holder] must prove that there is a direct infringement for each instance of indirect infringement.” Compare DSU Medical Corp. v. JMS Co. Ltd., 471 F.3d 1293, 1304 (Fed. Cir. 2006) with Dynacore Holdings Corp. v. U.S. Philips Corp., 363 F.3d 1263, 1274 (Fed. Cir. 2004); see also Hanson v. Alpine Valley Ski Area, Inc., 718 F.2d 1075 (Fed. Cir. 1983); Zenith Corp v. Hazeltine Research, Inc., 395 U.S. 100, 138 (1969). The Federal Circuit heard argument on this issue in the Lucent Technologies, Inc. v. Gateway, Inc. case, Fed. Cir. docket no. 2008-1485, on June 2, 2009.

3.12 CONTRIBUTORY INFRINGEMENT¹⁷

Contributory infringement occurs when a party with knowledge of the patent supplies a part, or a component, to another for use in a product, machine, or process that infringes a patent claim. [The patent holder] must prove that it is more probable than not that contributory infringement occurred.

Contributory infringement arises only if one who received the component infringes a patent claim. The component must also have three characteristics.

1. the component must be a significant¹⁸ part of the invention;
2. the component must be especially made or adapted for use in a way that infringes at least one claim of the patent, and the supplier must know that the component was especially made for that use; and
3. the component must not have a significant non-infringing use.

A component that has a number of non-infringing uses is often referred to as a staple or commodity article. Providing such a staple or commodity article is not contributory infringement even if the person receiving or buying the article uses it in an infringing way.¹⁹

¹⁷ 35 U.S.C. §271(c) (2001) states that:

Whoever offers to sell or sells within the United States a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial non-infringing use, shall be liable as a contributory infringer.

See generally Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd., 545 U.S. 913 (2005) (holding “where an article is good for nothing else but infringement, there is no legitimate public interest in its unlicensed availability, and there is no injustice in presuming or imputing an intent to infringe”) (internal citations omitted); Ricoh Co., Ltd. v. Quanta Computer Inc., 550 F.3d 1325, 1340 (Fed. Cir. 2008).

¹⁸ The word “material” from the statute 35 U.S.C. §271I has been replaced with “significant” to make the instruction more jury-friendly. See Bryan A. Garner, ed., BLACK’S LAW DICTIONARY (8th ed. 2004) (“material[:] Of such a nature that knowledge of the item would affect a person’s decision-making; significant; essential”).

3.13 JOINT DIRECT INFRINGEMENT²⁰

Direct infringement requires a party to perform or use each and every step of a claimed method, literally or under the doctrine of equivalents. Where no one party performs all of the steps of a claimed method but multiple parties combine to perform every step of the method, that claim will nevertheless be directly infringed if one party exercises control or direction over the entire method so that every step is attributable to the controlling party. Mere arms-length cooperation between the parties is not enough to establish direct infringement. [The patent holder] must prove that it is more probable than not that [the alleged infringer] directly infringed the patent claim.

Committee Note:

Some have raised a question as to whether On Demand Machine Corp. v. Ingram Industries Inc., 442 F.3d 1331 (Fed. Cir. 2006) is to the contrary. As pointed out in BMC Resources Inc. v. Paymentech LP, 498 F.3d 1373, 1379-80 (Fed. Cir. 2007), broad jury instruction language was sustained by the Federal Circuit in On Demand in dictum and without any analysis of the issue presented relating to divided infringement.

¹⁹ There is a difference in view as to whether this instruction should include the following phrase: “Finally, [the patent holder] must prove that there is a direct infringement for each instance of indirect infringement.” Compare DSU Medical Corp. v. JMS Co. Ltd., 471 F.3d 1293, 1304 (Fed. Cir. 2006) with Dynacore Holdings Corp. v. U.S. Philips Corp., 363 F.3d 1263, 1274 (Fed. Cir. 2004) ; see also Hanson v. Alpine Valley Ski Area, Inc., 718 F.2d 1075 (Fed. Cir. 1983); Zenith Corp v. Hazeltine Research, Inc., 395 U.S. 100, 138 (1969). The Federal Circuit heard argument on this issue in the Lucent Technologies, Inc. v. Gateway, Inc. case, Fed. Cir. docket no. 2008-1485, on June 2, 2009.

²⁰ Muniauction Inc. v. Thomson Corp., 532 F.3d 1318, 1329-30 (Fed. Cir. 2008); BMC Resources Inc. v. Paymentech LP, 498 F.3d 1373, 1378-81 (Fed. Cir. 2007).

4 WILLFUL INFRINGEMENT

4.1 WILLFUL INFRINGEMENT

In this case, [the patent holder] argues that [the alleged infringer] willfully infringed the claims of [the patent holder]'s patent.

The issue of willful infringement relates to the amount of damages [the patent holder] is entitled to recover in this lawsuit. If you decide that [the alleged infringer] willfully infringed the claims of [the patent holder]'s patent, then it is my job to decide whether or not to award increased damages to [the patent holder]. You should not take this factor into account in assessing the damages, if any, to be awarded to [the patent holder].

To prove willful infringement, [the patent holder] must persuade you that it is highly probable that [before the filing date of the complaint],²¹ [the alleged infringer] acted with reckless disregard of the claims of [the patent holder]'s patent. To show “reckless disregard,” [the patent holder] must satisfy a two-part test: the first concerns [the alleged infringer]'s conduct, the second concerns [the alleged infringer]'s state of mind.

When considering [the alleged infringer]'s conduct, you must decide whether [the patent holder] has proven it is highly probable that [the alleged infringer]'s conduct was reckless; that is, that [the alleged infringer] proceeded with the allegedly infringing conduct with knowledge of the patent, and in the face of an unjustifiably high risk that it was infringing the claims of a valid

²¹ This bracketed language should ordinarily be included as the Federal Circuit has made clear that, in ordinary circumstances, willfulness will depend on an infringer's prelitigation conduct. *In re Seagate Technology, LLC*, 497 F.3d 1360 (Fed. Cir. 2007). In the limited circumstances where post-complaint activity is legally relevant, the bracketed language would not be appropriate.

and enforceable patent.²² Because this is an objective issue, the state of mind of [the alleged infringer] is not relevant to it. Legitimate or credible defenses to infringement, even if ultimately not successful, demonstrate a lack of recklessness.²³

If you conclude that [the patent holder] has proven that [the alleged infringer]'s conduct was reckless, then you need to consider the second part of the test. You must determine whether [the patent holder] proved it is highly probable that the unjustifiably high risk of infringement was known or so obvious that it should have been known to [the alleged infringer]. In deciding whether [the alleged infringer] satisfied the state-of-mind part of the test, you should consider all facts surrounding the alleged infringement including, but not limited to, the following:

1. whether [the alleged infringer] acted in a manner consistent with the standards of commerce for its industry;
2. whether [the alleged infringer] intentionally copied without a reasonable basis a product [method] of [the patent holder] covered by one or more claims of the patent, as distinguished from trying to “design around” the patent by designing a product [method] that [the alleged infringer] believed did not infringe those claims.²⁴

²² The court may consider replacing “unjustifiably high risk” with “objectively high likelihood” to mirror the Federal Circuit’s language in Seagate. The Committee notes, however, that Seagate cites both formulations and the former might be more understandable to a jury. In re Seagate Tech., LLC, 497 F.3d at 1371 (quoting Safeco Ins. Co. of Am. v. Burr, 127 S.Ct. 2201 (2007)).

²³ Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc., ___ F.3d ___, (Fed. Cir. June 1, 2009); Black & Decker, Inc. v. Robert Bosch Tool Corp., 260 Fed Appx. 284, 291 (Fed. Cir. 2008).

²⁴ 35 U.S.C. § 284: In re Seagate Tech., LLC, 497 F.3d 1360 (Fed. Cir. 2007) (en banc); Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp., 383 F.3d 1337, 1345 (Fed. Cir. 2004) (en banc); Crystal Semiconductor Corp. v. Tritech Microelectronics Int’l, Inc., 246 F.3d 1336, 1346 (Fed. Cir. 2001); WMS Gaming Inc. v. Int’l Game Tech., 184 F.3d 1339, 1354 (Fed. Cir. 1999); Read Corp. v. Portec, Inc., 970 F.2d 816 (Fed. Cir. 1992); Gustafson, Inc. v. Intersystems Indus. Prods., Inc., 897 F.2d 508, 510 (Fed. Cir. 1990).

5 INVALIDITY

5.1 INVALIDITY—GENERALLY

Patent invalidity is a defense to patent infringement. Even though the PTO examiner has allowed the claims of a patent, you have the ultimate responsibility for deciding whether the claims of the patent are valid.

I will now instruct you on the invalidity issues you should consider. As you consider these issues, remember that [the alleged infringer] bears the burden of proving that it is highly probable that the claims are invalid.²⁵

Committee Note:

Presumption of Validity. Patents are entitled to a presumption of validity. The presumption of validity, like all legal presumptions, is a procedural device. In light of the procedural role of the presumption of validity, instructing the jury on the presumption in addition to informing it of the highly probable burden of proof may cause jury confusion as to its role in deciding invalidity. This instruction, therefore, omits any reference to the presumption of validity. Some courts, however, follow the more traditional approach, and instruct the jury on the presumption. Both approaches appear consistent with Federal Circuit law.

²⁵Chiron v. Genentech, 363 F. 3d 1247, 1258-59 (Fed. Cir. 2004); Morton Int'l v. Cardinal Chem. Co., 5 F 3d 1464, 1471-2 (Fed. Cir. 1993); Avia Group Int'l, Inc. v. L.A. Gear Cal., 853 F.2d 1557, 1562 (Fed. Cir. 1988); DMI, Inc. v. Deere & Co., 802 F.2d 421, 427 (Fed. Cir. 1986); 35 U.S.C. § 282.

5.2 WRITTEN DESCRIPTION

[The alleged infringer] contends that claims [] of the [XXX] patent are invalid for failure of the patent to provide an adequate written description of the claimed invention. [The alleged infringer] must prove that it is highly probable these claims lacked an adequate written description.

The written description requirement is satisfied if a person of ordinary skill in the field, reading the patent application as originally filed, would recognize that the patent application described the invention of these claims, even though the description might not use the exact words found in the claim. The written description is adequate if it shows that the inventor was in possession of each claim of the invention at the time the application for the patent was filed, even though the claim may have been changed or new claims added during the prosecution of the application. It is not necessary that each and every aspect of the claim be explicitly discussed, as long as a person of ordinary skill would understand that any aspect not expressly discussed is implicit in the patent application as originally filed. If you find that one or more of the claims challenged by [the alleged infringer] lacked an adequate written description, you must find each such claim invalid.²⁶

²⁶ Univ. of Rochester v. G.D. Searle & Co., 358 F.3d 916 (Fed. Cir. 2004); Turbocare Div. of Demag Delaval Turbomach. Corp., v. Gen. Elec. Co., 264 F.3d 1111, 1118 (Fed. Cir. 2002); Enzo Biochem, Inc. v. Gen-Probe Inc., 323 F.3d 956 (Fed. Cir. 2002) (en banc); Purdue Pharma L.P. v. Faulding Inc., 230 F.3d 1320 (Fed. Cir. 2000); Union Oil Co. of Cal. v. Atl. Richfield Co., 208 F.3d 989, 996-1001 (Fed. Cir. 2000); Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473, 1478-90 (Fed. Cir. 1998); Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555 (Fed. Cir. 1991).

5.3 ENABLEMENT

[The alleged infringer] contends that claims [] of the [XXX] patent are invalid because the patent does not disclose sufficient information to enable one skilled in the field of the invention, at the time the application was filed (or its effective filing date), to make and use the claimed invention. This requirement is known as the enablement requirement. If a patent claim is not enabled, it is invalid. Each claim must be analyzed for compliance with the enablement requirement. [The alleged infringer] must prove that it is highly probable that the claim was not enabled.

In considering whether a patent claim satisfies the enablement requirement, you must keep in mind that patents are written for persons of skill in the field of the invention. Thus, a patent need not expressly state information that skilled persons would be likely to know or could obtain. [The alleged infringer] bears the burden of establishing lack of enablement by showing that it is highly probable that a person skilled in the art, upon reading the patent document, would not be able to make the invention work without undue experimentation. The fact that some experimentation may be required for a skilled person to make or use the claimed invention does not mean that a patent's written description fails to meet the enablement requirement. Factors you may consider in determining whether making the invention would require undue experimentation include:

1. the quantity of experimentation necessary;
2. the amount of direction or guidance disclosed in the patent;
3. the presence or absence of working examples in the patent;
4. the nature of the invention;
5. the state of the prior art;
6. the relative skill of those in the art;

7. the predictability of the art; and
8. the breadth of the claims.

If you find that one or more of these claims did not comply with the enablement requirement, you must find each such claim invalid.²⁷

²⁷ AK Steel Corp. v. Sollac & Ugine, 344 F.3d 1234, 1244 (Fed. Cir. 2003); Durel Corp. v. Osram Sylvania Inc., 256 F.3d 1298, 1306 (Fed. Cir. 2001); Union Pac. Res. Co. v. Chesapeake Energy Corp., 236 F.3d 684, 690-92 (Fed. Cir. 2001); Ajinomoto Co. v. Archer-Daniels-Midland Co., 228 F.3d 1338, 1345-46 (Fed. Cir. 2000); Nat'l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc., 166 F.3d 1190, 1195-98 (Fed. Cir. 1999); Enzo Biochem, Inc. v. Calgene, Inc., 188 F.3d 1362, 1371 (Fed. Cir. 1999); In re Wands, 858 F.2d 731, 737 (Fed. Cir. 1988); Spectra-Physics, Inc. v. Coherent, Inc., 827 F.2d 1524, 1533 (Fed. Cir. 1987); White Consol. Indus., Inc. v. Vega Servo Control, Inc., 713 F.2d 788, 791 (Fed. Cir. 1983).

5.4 BEST MODE

[The alleged infringer] alleges that claims [] are invalid because the inventor (or any one of the inventors) believed there was a best way of making or using the invention defined by claims [] but failed to disclose that best way in the patent. The obligation to disclose the best way of making or using an invention is referred to as the “best mode” requirement and the failure to disclose what the inventor believed was the best mode for making or using the invention defined by a claim renders that claim of the patent invalid. [The alleged infringer] must prove that it is highly probable that the inventor had a best mode and failed to disclose it.

Determining whether or not an inventor failed to disclose the best mode involves answering two questions. First, at the time the application was filed, did the inventor know of a way, or mode, of making or using the invention claimed in the patent which the inventor considered to be better than any other way? Second, if the inventor did consider one mode to be preferable to all others, does the disclosure made in the patent specification enable a person skilled in the art to carry out that best mode? If the inventor did not actually prefer one way of making or using the invention over other ways, there can be no violation of the best mode requirement. If the inventor did believe there was a best way to make or use the invention, the inventor must have disclosed that best mode of making or using the invention in sufficient detail to enable a person of ordinary skill in the field of the invention to carry out that best mode without excessive experimentation.²⁸

²⁸ Bayer AG v. Schein Pharms., Inc., 301 F.3d 1306 (Fed. Cir. 2002); Mentor H/S Inc. v. Med. Device Alliance, Inc., 244 F.3d 1365 (Fed. Cir. 2001); Eli Lilly & Co. v. Barr Labs., Inc., 251 F.3d 955, 963 (Fed. Cir. 2001); N. Telecom Ltd. v. Samsung Elec. Co., 215 F.3d 1281,1286 (Fed.Cir. 2000); Applied Materials, Inc. v. Advanced Semiconductor Am. Materials, Inc., 98 F.3d 1563, 1581 (Fed. Cir. 1996); U.S. Gypsum Co. v. Nat'l Gypsum Co., 74 F.3d 1209, 1212 (Fed. Cir. 1996); Transco Prods. Inc. v. Performance Contracting, Inc., 38 F.3d 551, 558 (Fed. Cir. 1994); Wahl Instruments, Inc. v. Acvious, Inc., 950 F.2d 1575, 1581 (Fed.Cir. 1991); Amgen, Inc. v. Chugai Pharm. Co., 927 F.2d 1200, 1209-10 (Fed. Cir. 1991); Chemcast Corp. v. Arco Indus. Corp., 913 F.2d 923, 928 (Fed. Cir. 1990); Spectra-Physics, Inc. v. Coherent,

(continued...)

If you find that one or more of these claims failed to satisfy the best mode requirement, you must find each such claim invalid.

Inc., 827 F.2d 1524, 1535 (Fed. Cir. 1987); DeGeorge v. Bernier, 768 F.2d 1318, 1324 (Fed.Cir. 1985); In re Gay, 309 F.2d 769, 772 (C.C.P.A. 1962).

5.5 ANTICIPATION—PUBLICLY USED OR KNOWN, OR PREVIOUSLY PUBLISHED

[The alleged infringer] contends that claims [] of the [XXX] patent are invalid because the claimed invention is not new. For a claim to be invalid because it is not new, all of its requirements must have existed in a single device or method that predates the claimed invention, or must have been described in a single previous publication or patent that predates the claimed invention. In patent law, such previous device, method, publication or patent is called a “prior art reference.” If a patent claim is not new we say it is “anticipated” by a prior art reference. [The alleged infringer] must prove that it is highly probable that the claim was anticipated.

The disclosure in the prior art reference does not have to be in the same words as the claim, but all of the requirements of the claim must be there, either stated or necessarily implied, so that someone of ordinary skill in the field of [identify field] looking at that one reference would be able to make and use at least one embodiment of the claimed invention.

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

Here is a list of the ways that [the alleged infringer] can show that a patent claim was not new:

Note: *Use only those that apply to this case.*

- [if the claimed invention was already publicly known or publicly used by others in the United States before [insert date of invention unless at issue];]
- [if the claimed invention was already patented or described in a printed publication anywhere in the world before [insert date of invention unless at issue]. [To qualify as a prior art reference, a “printed publication” must be at least reasonably accessible to

those interested in the field, even if it is difficult to find. [An electronic publication, including an on-line or internet publication, is a “printed publication” if it is at least reasonably accessible to those interested in the field even if it is difficult to find.];]

- [if the claimed invention was already described in another published U.S. patent application or issued U.S. patent that was based on a patent application filed before [insert date of the patent holder’s application filing date] [or] [insert date of invention unless at issue];]

[Since it is in dispute, you must determine a date of invention for the [claimed invention].]²⁹

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

²⁹ 35 U.S.C. § 102(a), (c), (e), (f) and (g); Apotex U.S.A., Inc. v. Merck & Co., 254 F.3d 1031, 1035 (Fed. Cir. 2001); Mycogen Plant Science, Inc. v. Monsanto Co., 243 F.3d 1316, 1330 (Fed. Cir. 2001); Ecolchem, Inc. v. S. Cal. Edison Co., 227 F.3d 1361, 1367-70 (Fed. Cir. 2000); Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1576-78 (Fed. Cir. 1997); In re Bartfeld, 925 F.2d 1450 (Fed. Cir. 1985); Ralston Purina Co. v. Far-Mar-Co, Inc., 772 F.2d 1570, 1574 (Fed. Cir. 1985); American Stock Exch., LLC v. Mopies, 250 F. Supp. 2d 323 (S.D.N.Y. 2003); In re Wyer, 655 F.2d 221, 226 (C.C.P.A. 1981).

5.6 ANTICIPATION—MADE OR INVENTED BY SOMEONE ELSE

The alleged infringer contends that claims [] of the [XXX] patent are invalid as anticipated because the invention was first made or invented by someone else. If someone other than [the named inventor] made or invented the invention described in one or more such patent claims involved in this lawsuit, then each such claim was “anticipated” by the other invention, and each such claim is invalid. [The alleged infringer] must prove that it is highly probable that each such claim was anticipated by the other invention.

Here is a list of the ways that [the alleged infringer] can show that a patent claim was not new because the invention described in such claim was first made or invented by someone else:

Note: *Use only those that apply to this case.*

- [if the claimed invention was already made by someone else in the United States before [insert date of invention unless in issue], if that other person had not abandoned the invention or kept it secret;]
- [if [the named inventor] did not invent the claimed invention but instead learned of it from someone else;]
- [if [the patent holder] and [the alleged infringer] dispute who is a first inventor, the person who first conceived of the claimed invention and first reduced it to practice is the first inventor; if one person conceived of the claimed invention first, but reduced it to practice second, that person is the first inventor only if that person (a) began to reduce the claimed invention to practice before the other party conceived of it and (b) continued to work with reasonable diligence to reduce it to practice from a time just before the other party’s conception.]

Note: *Use the remaining paragraphs only if priority of invention is in dispute.*

Since priority of invention is in dispute in this case, you must determine a date of conception and reduction to practice for the [claimed invention] [and/or] [prior invention] and whether [the named inventor] [and/or] [the prior inventor] was reasonably diligent in reducing the invention to practice. Conception is the formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is to be applied in practice.

Reduction to practice occurs either as of the filing of the patent application or when the invention was actually made and was shown to work for its intended purpose. Reasonable diligence means that the inventor worked continuously on reducing the invention to practice. Interruptions necessitated by the everyday problems and obligations of the inventor or others working with him or her do not prevent a finding of reasonable diligence.³⁰

[In order to prove prior invention in this case, [the alleged infringer] is required to present additional evidence beyond the testimony of the prior inventor. However, you must evaluate all pertinent evidence, including that testimony, and make a sound determination that the evidence credibly establishes prior invention. Ultimately, [the alleged infringer] bears the burden of proving that it is highly probable that the patent claims are invalid.]³¹

If the invention of a patent claim was first made or invented by someone else as explained above, you must find the patent claim invalid.

³⁰ 35 U.S.C. § 102(a), (c), (e), (f) and (g); Lacks Industries, Inc. v. McKechnie Vehicle Components USA, Inc., 322 F.3d 1335 (Fed. Cir. 2003); Apotex U.S.A., Inc. v. Merck & Co., 254 F.3d 1031, 1035 (Fed. Cir. 2001); Mycogen Plant Science, Inc. v. Monsanto Co., 243 F.3d 1316, 1330 (Fed. Cir. 2001); Ecolchem, Inc. v. S. Cal. Edison Co., 227 F.3d 1361, 1367-70 (Fed. Cir. 2000); Singh v. Brake, 222 F.3d 1362, 1366-70 (Fed. Cir. 2000); Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1576-78 (Fed. Cir. 1997); Lamb-Weston, Inc. v. McCain Foods, Ltd., 78 F.3d 540, 545 (Fed. Cir. 1996); Ralston Purina Co. v. Far-Mar-Co, Inc., 772 F.2d 1570, 1574 (Fed. Cir. 1985); American Stock Exch., LLC v. Mopies, 250 F. Supp. 2d 323 (S.D.N.Y. 2003); In re Wyer, 655 F.2d 221, 226 (C.C.P.A. 1981).

³¹ This instruction may be given unless the court determines that the alleged infringer's evidence of prior inventorship does not require corroboration. Federal Circuit cases show that the necessity of presenting corroborating evidence is a question of law for the court, while the sufficiency of the corroborating evidence is a question of fact for the jury. Adenta GmbH v. Orthoarm, Inc., 501 F.3d 1364, 1371-72 (Fed. Cir. 2007); Typertight Keyboard Corp. v. Microsoft Corp., 374 F.3d 1151, 1159 (Fed. Cir. 2004); Woodland Trust v. Flowertree Nursery, Inc., 148 F.3d 1368, 1371, 47 USPQ2d 1363, 1366 (Fed. Cir. 1998); see also Spectralytics, Inc. v. Cordis Corp., 576 F. Supp. 2d 1030, 1045-50 (D. Minn. 2008). Corroborating evidence may take many forms and is evaluated under a rule of reason analysis. The court should tailor instructions to the specific facts of the case. See Linear Tech. Corp. v. Impala Linear Corp., 379 F.3d 1311 (Fed. Cir. 2004); Univ. of Colo. Found., Inc. v. Am. Cyanimid Co., 342 F.3d 1298 (Fed. Cir. 2003); Finnigan Corp. v. International Trade Comm'n, 180 F.3d 1354, 1366 (Fed. Cir. 1999); Woodland Trust, 148 F.3d at 1371.

5.7 ANTICIPATION—STATUTORY BARS

[The alleged infringer] may prove that claims [] of the [XXX] patent are invalid by showing that it is highly probable that each such claim failed to meet one of several statutory provisions in the patent laws. These provisions are called “statutory bars.” For a patent claim to be invalid because of a statutory bar, all of its requirements must have been present in one prior art reference dated more than one year before the effective filing date of the patent application.

Here is a list of ways [the alleged infringer] can show that the patent application was not timely filed, that is, filed within one year of the occurrence of any of the following events:

Note: *Use only those that apply to this case.*

- [if the claimed invention was already patented or described in a printed publication anywhere in the world before [insert date that is one year before the effective filing date of patent application]. [A reference is a “printed publication” if it is reasonably accessible to those interested in the field, even if it is difficult to find. [An electronic publication, including an on-line or internet publication, is a “printed publication” if it is at least reasonably accessible to those interested in the field, even if it is difficult to find.];]
- [if the claimed invention was already being publicly or commercially used in the United States before [insert date that is one year before the effective filing date of the patent application] and that use was not primarily an experimental use controlled by the inventor to test whether the invention worked for its intended purpose;]
- [if a device or method using the claimed invention was sold or offered for sale in the United States, and that claimed invention was ready for patenting, before [insert date that is one year before application filing date]. [The claimed invention is not being [sold] [or] [offered for sale] if [the patent holder] shows that the [sale] [or] [offer for sale] was primarily experimental.] [The claimed invention is ready for patenting if it was actually built, or if the inventor had prepared drawings or other descriptions of the claimed invention that were sufficiently detailed to enable a person of ordinary skill in the field of the invention to make and use the invention based on them.];]
- [if [the patent holder] had already obtained a patent on the claimed invention in a foreign country before filing the original U.S. application, and the foreign application was filed more than one year before the effective filing date of the U.S. application.]

For a claim to be invalid because of a statutory bar, all of the claimed requirements must have been either (1) disclosed in a single prior art reference or (2) implicitly disclosed in a single prior art reference as viewed by one of ordinary skill in [the field of the invention]. The disclosure in a reference does not have to be in the same words as the claim, but all of the requirements of the claim must be described in enough detail, or necessarily implied by or inherent in the reference, to enable someone of ordinary skill in the field of the invention looking at the reference to make and use at least one embodiment of the claimed invention.

A prior art reference also invalidates a patent claim when the claimed invention necessarily results from practice of the subject of the prior art reference, even if the result was unrecognized and unappreciated by one of ordinary skill in the field of the invention.³²

If you find a patent claim failed to meet a statutory bar, you must find the patent claim invalid.

³² 35 U.S.C. § 102(b) and (d); Pfaff v. Wells Elec. Inc., 525 U.S. 55 (1998); Schering Corp. v. Geneva Pharms., 339 F.2d 1373 (Fed. Cir. 2003); Helifix Ltd. v. Blok-Lok, Ltd., 208 F.3d 1339, 1346 (Fed. Cir. 2000); Abbot Labs. v. Geneva Pharms., Inc., 182 F.3d 1315, 1318 (Fed. Cir. 1999); Finnigan Corp. v. Int'l Trade Comm'n, 180 F.3d 1354 (Fed. Cir. 1999); J.A. LaPorte, Inc. v. Norfolk Dredging Co., 787 F.2d 1577, 1581 (Fed. Cir. 1986); In re Hall, 781 F.2d 897, 898-99 (Fed. Cir. 1986); D.L. Auld Co. v. Chroma Graphics Corp., 714 F.2d 1144, 1150 (Fed. Cir. 1983).

5.8 IMPROPER INVENTORSHIP³³

In this case, [the alleged infringer] contends that the claims of the [XXX] patent are invalid because of improper inventorship. To prove invalidity because of improper inventorship, [the alleged infringer] must show that it is highly probable that the patent fails to meet the requirement that all of the actual inventors, and only the actual inventors, be named as inventors in the patent. This is known as the “inventorship” requirement. In determining whether the inventorship requirement has been satisfied here, you should be guided by the following principles.

To be an inventor, one must make a significant contribution to the conception of one or more of the claims of the patent. Whether the contribution is significant is measured against the scope of the full invention.

Conception is the mental formulation and disclosure by the inventor(s) of a complete idea of the inventive solution. An inventive solution is considered to be a complete idea when disclosure of the idea would enable anyone with ordinary skill in the pertinent art to reduce the invention to practice.

Persons may be inventors even if they do not physically work together, make the same type or amount of contribution, or contribute to the subject matter of every claim of the patent. While persons may be joint or co-inventors even though they do not physically work together, they must have some open line of communication during or at approximately the time of their inventive effort.

³³ 35 U.S.C. § 116 and 35 U.S.C. § 256; Eli Lilly & Co. v. Aradigm, 376 F.3d 1352, 1358-59 (Fed. Cir. 2004); Slip Track Sys., Inc. v. Metal-Lite, Inc., 304 F.3d 1256, 1262-63 (Fed. Cir. 2002); Hess v. Advanced Cardiovascular Sys., Inc., 106 F.3d 976, 980 (Fed. Cir. 1997); Burroughs Wellcome Co. v. Barr Labs., Inc., 40 F.3d 1223, 1227-28 (Fed. Cir. 1994); Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 624 (Fed. Cir. 1985).

Explaining to the actual inventors well-known concepts or the current state of the art does not make someone an inventor. Likewise, merely helping with experimentation, by carrying out the inventor's instructions, does not make someone an inventor.

5.9 OBVIOUSNESS³⁴

In this case, [the alleged infringer] contends claims [] of the [XXX] patent are invalid as obvious. A patent claim is invalid if the claimed invention would have been obvious to a person of ordinary skill in the field of the invention [at the time the application was filed] [as of [insert date]]. This means that even if all the requirements of the claim cannot be found in a single prior art reference that would anticipate the claim or constitute a statutory bar to that claim, a person of ordinary skill in the field of the invention who knew about all of the prior art would have come up with the claimed invention.

But a patent claim composed of several requirements is not proved obvious merely by demonstrating that each of its requirements was independently known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of known requirements according to their established functions to produce a predictable result, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the requirements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known. Accordingly, you may evaluate whether there was some teaching, suggestion, or motivation to arrive at the claimed invention before the time of the claimed invention, although proof of this is not a requirement to prove obviousness. Teachings, suggestions, and motivations may be found in written references including the prior art itself. However, teachings, suggestions, and motivations may also be found within the knowledge of a

³⁴ KSR Intern. Co. v. Teleflex, Inc., 550 U.S. 398 (2007).

person with ordinary skill in the art including inferences and creative steps that a person of ordinary skill in the art would employ. Additionally, teachings, suggestions, and motivations may be found in the nature of the problem solved by the claimed invention, or any need or problem known in the field of the invention at the time of and addressed by the invention.

Therefore, in evaluating whether such a claim would have been obvious, you should consider a variety of factors:

1. Whether [the alleged infringer] has identified a reason that would have prompted a person of ordinary skill in the field of the invention to combine the requirements or concepts from the prior art in the same way as in the claimed invention. There is no single way to define the line between true inventiveness on one hand (which is patentable) and the application of common sense and ordinary skill to solve a problem on the other hand (which is not patentable). For example, market forces or other design incentives may be what produced a change, rather than true inventiveness.
2. Whether the claimed invention applies a known technique that had been used to improve a similar device or method in a similar way.
3. Whether the claimed invention would have been obvious to try, meaning that the claimed innovation was one of a relatively small number of possible approaches to the problem with a reasonable expectation of success by those skilled in the art.

But you must be careful not to determine obviousness using hindsight; many true inventions can seem obvious after the fact. You should put yourself in the position of a person of ordinary skill in the field of the invention at the time the claimed invention was made, and you should not consider what is known today or what is learned from the teaching of the patent.

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

1. You must decide the level of ordinary skill in the field of the invention that someone would have had at the time the claimed invention was made.
2. You must decide the scope and content of the prior art. In determining the scope and content of the prior art, you must decide whether a reference is pertinent, or analogous, to the claimed invention. Pertinent, or analogous,

prior art includes prior art in the same field of endeavor as the claimed invention, regardless of the problems addressed by the reference, and prior art from different fields reasonably pertinent to the particular problem with which the claimed invention is concerned. Remember that prior art is not limited to patents and published materials, but includes the general knowledge that would have been available to one of ordinary skill in the field of the invention.

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

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

A. Factors tending to show nonobviousness:

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

B. Factors tending to show obviousness

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

[You may consider the presence of any of the [list factors A.1-8 as appropriate] as an indication that the claimed invention would not have been obvious at the time the claimed invention was made. And you may consider the presence of the [list factors B.1-2 as appropriate] as an indication that the claimed invention would have been obvious at such time. Although you should consider any evidence of these factors, the relevance and importance of any of them to your decision on whether the claimed invention would have been obvious is up to you.]³⁵

[The alleged infringer] must prove that it is highly probable that a claimed invention was obvious. If you find that a claimed invention was obvious as explained above, you must find that claim invalid.

³⁵ 35 U.S.C. § 103; KSR Int'l Co. v. Teleflex, Inc., 550 U.S. 398, 425-28 (2007); Graham v. John Deere Co., 383 U.S. 1 (1966); In re Fulton, 391 F.3d 1195, 1201 (Fed. Cir. 2004); Ruiz v. A.B. Chance Co., 234 F.3d 654 (Fed. Cir. 2000); Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 957 (Fed. Cir. 1997); Lamb-Weston, Inc. v. McCain Foods, Ltd., 78 F.3d 540, 545 (Fed. Cir. 1996); Ryco Mfg. Co. v. Nu-Star, Inc., 950 F.2d 714, 716 (Fed. Cir. 1991); Windsurfing Int'l, Inc. v. AMF, Inc., 782 F.2d 995, 1000 (Fed. Cir. 1986); Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 313 (Fed. Cir. 1985); In re Wood, 599 F.2d 1032, 1036 (CCPA 1979).

Committee Note:

Alternative Instruction Reserving for the Court the Determination of Obviousness. The Committee has been unable to reach a consensus on an instruction and a verdict form for those cases where obviousness is an issue and one or more of the parties seeks to have the jury make specific underlying factual determinations but have the ultimate legal question of obviousness made by the court. One complication the Committee has considered is that there is no existing case law that provides guidance on how to implement the burdens of proof a party has with regard to either the statutory factors or the secondary considerations. For example, in the alternative Instruction 5.10, we tell the jury “you must decide what difference, if any, existed between the claimed invention and the prior art.” We find it difficult to translate that instruction into a finding an alleged infringer must establish is “highly probable” and then into a question or questions a jury answers on a verdict form. Similarly, in this alternative instruction we identify “commercial success” as a secondary consideration. We have not been able to agree on the patent owner’s burden of proof in establishing commercial success or agree on a form which the jury reports its finding on commercial success.

The model verdict form attached as an appendix requires the jury to make underlying factual determinations and make the ultimate determination on the obviousness question. The court can then accept the jury’s verdict on the ultimate issue of obviousness or consider it as advisory only. In any event, we suggest that the parties and the court develop an instruction and verdict form in the context of the fact pattern in the specific case.

Applying the Burden of Proof to Underlying Factual Findings. It has been suggested that the burden of proof applies only to underlying factual findings, but not to claims and defenses as a whole. While there might be some support for this suggestion, see, e.g., Colorado v. New Mexico, 467 U.S. 310, 316 (1984); Pfizer, Inc. v. Apotex, Inc., 480 F.3d 1348, 1360 n.5 (Fed. Cir. 2007) (quoting Colorado, 467 U.S. at 316), the Committee has not adopted it for the following reasons. The relied upon cases describe the “clear and convincing” burden as applying to “factual conclusions.” This language appears to be the source of the issue. Interpreting Colorado as rejecting the idea that burdens can apply to claims or defenses, however, is questionable in light of Colorado’s reliance on In re Winship, 397 U.S. 358, 370 (1970), and Addington v. Texas, 441 U.S. 418, 423 (1979). In those cases, the “factual conclusions” discussed were determinative facts of the “guilt of a criminal charge,” e.g., In re Winship, 397 U.S. 358, 361, 370, 374, and not underlying evidentiary facts. As Colorado itself states, the burden of proof allocates the risk of an erroneous “ultimate decision,” Colorado, 467 U.S. at 315-16, which may not be determined by specific underlying findings.

In the context of obviousness specifically, it has similarly been suggested that the burden of proof applies only to underlying factual findings, and not to the ultimate conclusion of obviousness. There again appears to be some support for this suggestion. See, e.g., Washburn & Moen Mfg. Co. v. Beat ‘Em All Barbed-Wire Co., 143 U.S. 275 (1892); SSIH Equipment S.A. v. U.S. Intern. Trade Comm., 718 F.2d 365, 375 (Fed. Cir. 1983); Newell Cos. v. Kenney Mfg., 864 F.2d 757, 767 (Fed. Cir. 1988). However, a jury instruction applying a highly probable burden to factual findings underlying obviousness would raise a number of practical complications. As an example, the patentee bears a burden of production with respect to almost

all secondary considerations of obviousness. See, e.g., Demaco Corp. v. F. von Langsdorff Licensing Ltd., 851 F.2d 1387, 1392 (Fed. Cir. 1988) (patentee bears a burden to produce evidence establishing a nexus between commercial success and the patented invention). Instructing the jury that the alleged infringer must prove that it is highly probable that the patented invention was not commercially successful would be impractical and ignore the patentee's burden on that issue. As another example, the level of ordinary skill in the art must be determined during claim construction, during an infringement analysis under the doctrine of equivalents, and during an analysis of obviousness. See Phillips v. AWH Corp., 415 F.3d 1303, 1313 (Fed. Cir. 2005) (claim construction); Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 520 U.S. 17, 36-37 (1997) (doctrine of equivalents). Applying a burden of proof to the level of ordinary skill in the art raises the possibility of inconsistent findings on that issue depending on which analysis is being performed.

In light of the standard practice of applying the burden of proof to obviousness as a whole, the impracticality of applying the burden of proof to underlying factual findings, and the questionable nature of case law offered to support a contrary position, the Committee has applied the burden of proof to claims and defenses as a whole in these instructions.

5.10 OBVIOUSNESS—(Alternative)

In this case, [the alleged infringer] contends claims [] of the [XXX] patent are invalid as obvious. A patent claim is invalid if the claimed invention would have been obvious to a person of ordinary skill in the field of the invention [at the time the application was filed] [as of [insert date]]. The court, however, has the responsibility of determining whether a patent claim was obvious based on your determination of several factual questions.³⁶

First, you must decide the level of ordinary skill in the field of the invention that someone would have had at the time the claimed invention was made.

Second, you must decide the scope and content of the prior art. In determining the scope and content of the prior art, you must decide whether a reference is pertinent, or analogous, to the claimed invention. Pertinent, or analogous, prior art is defined by the nature of the problem solved by the invention. It includes prior art in the same field of endeavor as the claimed invention, regardless of the problem addressed by the reference, and prior art from different fields reasonably pertinent to the particular problem with which the claimed invention is concerned. Remember that prior art is not limited to patents and published materials, but includes the general knowledge that would have been available to one of ordinary skill in the field of the invention.

Third, you must decide what difference, if any, existed between the claimed invention and the prior art.

³⁶ This instruction provides the jury with an instruction on the underlying factual questions it must answer to enable the court to make the ultimate legal determination of the obviousness question. *KSR Intern. Co. v. Teleflex, Inc.*, 550 U.S. 398, 425-28 (2007) (“The ultimate judgment of obviousness is a legal determination.”); *see Dippin' Dots, Inc. v. Mosey*, 476 F.3d 1337, 1343 (Fed. Cir. 2007).

Finally, you must determine which, if any, of the following factors have been established by the evidence:

A. Factors tending to show nonobviousness:

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

B. Factors tending to show obviousness

- [1. independent invention of the claimed invention by others before or at about the same time as the named inventor thought of it]; and
- [2. other evidence tending to show obviousness].³⁷

[The alleged infringer] must prove that it is highly probable that a claimed invention was obvious.

³⁷35 U.S.C. § 103; KSR Int'l Co. v. Teleflex, Inc., 550 U.S. 398, 425-28 (2007); Graham v. John Deere Co., 383 U.S. 1 (1966); In re Fulton, 391 F.3d 1195, 1201 (Fed. Cir. 2004); Ruiz v. A.B. Chance Co., 234 F.3d 654 (Fed. Cir. 2000); Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 957 (Fed. Cir. 1997); Lamb-Weston, Inc. v. McCain Foods, Ltd., 78 F.3d 540, 545 (Fed. Cir. 1996); Ryco Mfg. Co. v. Nu-Star, Inc., 950 F.2d 714, 716 (Fed. Cir. 1991); Windsurfing Int'l, Inc. v. AMF, Inc., 782 F.2d 995, 1000 (Fed. Cir. 1986); Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 313 (Fed. Cir. 1985); In re Wood, 599 F.2d 1032, 1036 (CCPA 1979).

5.11 SCOPE AND CONTENT OF PRIOR ART

[The patent holder] and [the alleged infringer] disagree on whether [identify prior art reference(s)] should be included in the prior art you use to decide the validity of claims [] of the [XXX] patent. To qualify as prior art relevant to the [XXX] patent, these references must be reasonably related to the claimed invention of that patent. A reference is reasonably related if it is in the same field as the claimed invention or is from another field to which a person of ordinary skill in the field would look to solve a known problem.³⁸ Remember that prior art is not limited to patents and published materials, but also includes the general knowledge that would have been available to one of ordinary skill in the field of the invention.

³⁸ Graham v. John Deere Co., 383 U.S. 1 (1966); KSR Int'l Co. v. Teleflex, Inc., 550 U.S. 398, 417 (2007); Ruiz v. A.B. Chance Co., 234 F.3d 654, 664-65 (Fed. Cir. 2000); Wang Labs. v. Toshiba Corp., 993 F.2d 858, 864 (Fed. Cir. 1993).

5.12 DIFFERENCES OVER THE PRIOR ART

In reaching your conclusion about whether or not claims [] would have been obvious at the time the claimed invention was made, you should consider any difference or differences between the [identify prior art reference(s)] and the claimed requirements.³⁹

³⁹ Graham v. John Deere Co., 383 U.S. 1 (1966); Yamanouchi Pharm. Co. v. Danbury Pharmacal, Inc., 231 F.3d 1339, 1343-45 (Fed. Cir. 2000); In re Kotzab, 217 F.3d 1365, 1369 (Fed. Cir. 2000); Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 935 (Fed. Cir. 1990).

5.13 LEVEL OF ORDINARY SKILL

Several times in my instructions I have referred to a person of ordinary skill in the field of the invention. It is up to you to decide the level of ordinary skill in the field of the invention.

You should consider all of the evidence introduced at trial in making this decision, including:

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

[The patent holder] contends that the level of ordinary skill in the field of the invention was []. [The alleged infringer] contends that the level of ordinary skill in the field was [].⁴⁰

⁴⁰ Graham v. John Deere Co., 383 U.S. 1 (1966); Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1125 (Fed. Cir. 2000); SIBIA Neurosciences, Inc. v. Cadus Pharm. Corp., 225 F.3d 1349, 1355 (Fed. Cir. 2000); Ryko Mfg. Co. v. Nu-Star, Inc., 950 F.2d 714, 718-19 (Fed. Cir. 1991).

6 DAMAGES

6.1 DAMAGES—GENERALLY

I will now instruct you on damages. If you find that [the alleged infringer] has infringed one or more valid claims of the [XXX] patent you must determine the amount of money damages to which [the patent holder] is entitled. By instructing you on damages, I do not suggest that one or the other party should prevail. These instructions are provided to guide you on the calculation of damages in the event you find infringement of a valid patent claim and thus must address the damages issue.

The amount of damages must be adequate to compensate [the patent holder] for the infringement, but it may not be less than a “reasonable royalty.” At the same time, your damages determination must not include additional sums to punish [the alleged infringer] or to set an example. You may award compensatory damages only for the loss that [the patent holder] proves was more likely than not caused by [the alleged infringer]’s infringement.

6.2 DAMAGES—BURDEN OF PROOF

Where the parties dispute a matter concerning damages, it is [the patent holder]’s burden to prove that it is more probable than not that [the patent holder]’s version is correct. [The patent holder] must prove the amount of damages with reasonable certainty, but need not prove the amount of damages with mathematical precision. However, [the patent holder] is not entitled to damages that are remote or speculative.⁴¹

⁴¹ Wechsler v. Macke Intern. Trade, Inc., 486 F.3d 1286, 1293-94 (Fed. Cir. 2007); Union Carbide Chems. & Plastics Tech. Corp. v. Shell Oil Co., 425 F.3d 1366, 1372-73 (Fed. Cir. 2005); State Contracting & Eng’g Corp. v. Condotte Am., Inc., 346 F.3d 1057, 1072 (Fed. Cir. 2003); SmithKline Diagnostics, Inc. v. Helena Labs. Corp., 926 F.2d 1161, 1164 (Fed. Cir. 1991); Lam, Inc. v. Johns-Mansville Corp., 718 F.2d 1056, 1065 (Fed. Cir. 1983).

As the facts warrant, the Court may also instruct the jury that “When the amount of damages cannot be ascertained with precision due to poor record keeping by [the alleged infringer], any doubts regarding the amount should be resolved against [the alleged infringer].”

6.3 DAMAGES—WHEN DAMAGES BEGIN

Note: *This instruction should be given in the event the parties agree on the date for commencement of damages.*

In this case, you should assess damages beginning on [insert date]. [The patent holder] and [the alleged infringer] have agreed upon this date.

Note: *This instruction should be given in the event the parties agree that the marking requirement was satisfied or does not apply.*

In this case, if you find that the [patent in suit] was granted before the infringing activity began, you should calculate damages as of the date you determine that the infringement began. If you find that the [XXX] patent was granted after the infringing activity began, damages should be calculated as of [date patent issued].

Note: *This instruction should be given if marking is at issue.*⁴²

The amount of damages [the patent holder] can recover is limited to those acts of infringement by [the alleged infringer] that occurred after [the patent holder] gave [the alleged infringer] notice that it infringed the [XXX] patent. Notice of infringement can be actual or constructive, and I will explain in a moment what that means.

Actual notice means that [the patent holder] communicated to [the alleged infringer] a specific charge of infringement of the [XXX] patent by [the accused product or device]. This notice is effective as of the date given. [The patent holder] has the burden of establishing that it is more probable than not that [the alleged infringer] received notice of infringement on [date].⁴³

⁴² The marking statute does not apply to patents containing only method claims or if only method claims are asserted. 35 U.S.C. § 287; Crown Packaging Tech., Inc. v. Rexam Beverage Can Co., 559 F.3d 1308, 1316-17 (Fed. Cir. 2009).

⁴³ Service of a complaint alleging patent infringement normally effects notice, and as the facts of the case warrant, the court can note that in the instructions.

Constructive notice means that [the patent holder] complied with the marking requirement of the patent law. “Marking” means that substantially all of the products made, offered for sale, or sold under the [XXX] patent are marked to display the word ‘patent’ or the abbreviation ‘pat.’, together with the number of the patent. [The patent holder] has the burden of establishing substantial compliance with the marking requirement. To do so, [the patent holder] must show it is more probable than not that substantially all of the products it made, offered for sale, or sold under the [XXX] patent were marked, and that [the patent holder] made reasonable efforts to ensure that its licensees who made, offered for sale, or sold products under the [XXX] patent marked substantially all of their products.

Your job is to calculate damages from the date [the alleged infringer] received either actual or constructive notice, whichever was first. You should not award damages for any infringement by [the alleged infringer] occurring before it first received notice of the [XXX] patent.⁴⁴

⁴⁴ 35 U.S.C. § 287; Crown Packaging Tech., Inc. v. Rexam Beverage Can Co., 559 F.3d 1308, 1316-17 (Fed. Cir. 2009); State Contracting & Eng’g Corp. v. Condotte Am., Inc., 346 F.3d 1057, 1073 (Fed. Cir. 2003); Crystal Semiconductor Corp. v. Trittech Microelectronics Int’l, Inc., 246 F.3d 1336, 1343 (Fed. Cir. 2001); Gart v. Logitech, 254 F.3d 1334, 1345 (Fed. Cir. 2001); Maxwell v. J. Baker, 86 F.3d 1098, 1111 (Fed. Cir. 1996); Amsted Indus. Inc. v. Buckeye Steel Castings Co., 24 F.3d 178, 187 (Fed. Cir. 1984).

6.4 DAMAGES—LOST PROFITS

Note: *This instruction should be given only in the event the patent holder is seeking lost profits damages.*

In this case, [the patent holder] seeks to recover lost profits resulting from [the alleged infringer]'s infringement. One way [the patent holder] may establish lost profits is by proving it is more probable than not that:

1. there was demand for the patented [product][method][product produced by the method];
2. there were no acceptable noninfringing alternatives, or, if there were, that [the patent holder] lost some sales as a result of the infringing activity;
3. [the patent holder] had the manufacturing and marketing capacity to make any infringing sales actually made by [the alleged infringer]; and
4. the amount of profit [the patent holder] would have made if [the alleged infringer] had not infringed.

[Insert instructions on collateral products and price erosion here, if applicable (*see infra*).]

For those infringing sales where [the patent holder] does not seek, or does not prove, lost profits damages, the law requires that you award [the patent holder] a reasonable royalty. I will now instruct you on how to calculate reasonable royalty damages.⁴⁵

⁴⁵ 35 U.S.C. § 284; Ferguson Beauregard/Logic Controls, Div. of Dover Resources, Inc. v. Mega Sys., LLC, 350 F.3d 1327, 1345-46 (Fed. Cir. 2003); Ericsson, Inc. v. Harris Corp., 352 F.3d 1369, 1377-79 (Fed. Cir. 2003); Micro Chem, Inc. v. Lextron, Inc., 318 F.3d 1119, 1123 (Fed. Cir. 2003); Rite-Hite Corp. v. Kelley Co., 56 F.3d 1538, 1545 (Fed. Cir. 1995) (en banc); State Industries, Inc. v. Mor-Flo Industries, Inc., 883 F.2d 1573, 1576-80 (Fed. Cir. 1989); Central Soya Co. v. George A. Hormel & Co., 723 F.2d 1573, 1579 (Fed. Cir. 1983); Lam, Inc. v. Johns-Mansville Corp., 718 F.2d 1056, 1065 (Fed. Cir. 1983); Panduit Corp. v. Stahl Bros. Fibre Works, Inc., 575 F.2d 1152, 1156 (6th Cir. 1978); Aro Mfg. Co. v. Convertible Top Co., 377 U.S. 476, 502-07 (1964)

Collateral Products. *This part of the instruction should be given only in the event the patent holder is seeking damages for lost profits on collateral products.*

In this case, [the patent holder] is seeking profits from sales of [x], which it contends it would have sold along with [y]. These products are called collateral products. To recover lost profits on sales of such collateral products, [the patent holder] must prove three things:

1. [the patent holder] would have sold the collateral products if [the alleged infringer] had not infringed the patent,
2. the collateral products and the patented product together are like components of a single assembly or parts of a complete machine, or constitute a functional unit,
3. the amount of the profit [the patent holder] would have made on sales of [x].⁴⁶

Price Erosion. *This part of the instruction should be given only in the event the patent holder is seeking damages for lost profits due to price erosion.*

In this case, [the patent holder] contends that if [the alleged infringer] had not infringed the patent, [the patent holder] would have been able to charge higher prices for the patented [product] [method] [product produced by the method] and seeks as damages the profits it lost as a result of selling the patented [product] [method] [product produced by the method] at lower prices. This type of damages is referred to as price erosion.⁴⁷

Committee Note:

Design Patents. In a design patent case 35 U.S.C. § 289(2) provides that the patentee can recover the defendant's profits as damages. In design patent cases an appropriate instruction should be given if requested.

⁴⁶ *Rite-Hite Corp v Kelley Co.*, 56 F 3d 1538, 1550 (Fed Cir 1995) (en banc); *Panduit Corp v. Stahl Bros. Fibre Works, Inc.*, 575 F 2d 1152, 1157-58 (6th Cir 1978)

⁴⁷ *Wechsler v Macke Intern Trade, Inc.*, 486 F 3d 1286, 1293-94 (Fed Cir 2007); *Ericsson, Inc v Harris Corp.*, 352 F 3d 1369, 1377-79 (Fed Cir 2003); *Crystal Semiconductor Corp v Tritech Microelectronics Int'l*, 246 F 3d 1336, 1357-61 (Fed Cir 2001)

6.5 REASONABLE ROYALTY—ENTITLEMENT⁴⁸

If [the patent holder] has not proved its claim for lost profits, or has proved its claim for lost profits for only a portion of the infringing sales, then [the patent holder] should be awarded a reasonable royalty for all infringing sales for which it has not been awarded lost profits damages.

⁴⁸ 35 U.S.C. § 284; Crystal Semiconductor Corp. v. Tritech Microelectronics Int'l, Inc., 246 F.3d 1336, 1354 (Fed. Cir. 2001); Fromson v. Western Litho Plate & Supply Co., 853 F.2d 1568, 1574 (Fed. Cir. 1998) (overruled on other grounds); Minco, Inc. v. Combustion Eng'g, Inc., 95 F.3d 1109, 1119-20 (Fed. Cir. 1996); Mahurkar v. C.R. Bard, Inc., 79 F.3d 1572, 1579 (Fed. Cir. 1996); Rite-Hite Corp. v. Kelley Co., 56 F.3d 1538, 1554 (Fed. Cir. 1995) (en banc).

6.6 REASONABLE ROYALTY—DEFINITION⁴⁹

A royalty is a payment made to a patent holder in exchange for rights to make, use or sell the claimed invention. A reasonable royalty is the payment that would have resulted from a negotiation between a patent holder and the infringer taking place just before the time when the infringing sales first began. In considering the nature of this negotiation, the focus is on what the expectations of the patent holder and infringer would have been had they entered into an agreement at that time and acted reasonably in their negotiations. However, you must assume that both parties believed the patent was valid and infringed. In addition, you must assume that patent holder and infringer were willing to enter into an agreement; your role is to determine what that agreement would have been. The test for damages is what royalty would have resulted from the hypothetical negotiation and not simply what either party would have preferred.

⁴⁹ Golight, Inc., v. Wal-Mart Stores, Inc., 355 F.3d 1327, 1338 (Fed. Cir. 2004); Maxwell v. J. Baker, Inc., 86 F.3d 1098, 1108-10 (Fed. Cir. 1996); Mahurkar v. C.R. Bard, Inc., 79 F.3d 1572, 1579-81 (Fed. Cir. 1996); Rite-Hite Corp. v. Kelley Co., 56 F.3d 1538, 1554 (Fed. Cir. 1995) (*en banc*). The court in Georgia-Pacific Corp. v. United States Plywood Corp., 318 F. Supp. 1116, 1120 (S.D.N.Y. 1970) identified the following factors that may be considered in determining a reasonable royalty: 1) the royalties received by the patent holder for the licensing of the patent, which proves or tends to prove an established royalty; 2) the rates paid by the alleged infringer for the use of other patents comparable to the patent; 3) the nature and scope of the license, as exclusive or nonexclusive; or as restricted or unrestricted in terms of territory or identity of buyers of the manufactured product; 4) the patent holder's established policy and marketing program to maintain their patent monopoly by not licensing others to use the invention or by granting licenses under special conditions designed to preserve that monopoly; 5) the commercial relationship between the patent holder and the alleged infringer, such as, whether they are competitors in the same territory in the same line of business; or whether they are inventor or promoter; 6) the effect of selling the patented specialty in promoting sales of other products of the alleged infringer; the existing value of the invention to the patent holder as a generator of sales of its nonpatented items; and the extent of such derivative or convoyed sales; 7) the duration of the patent and the term of the licenses; 8) the established profitability of the product made under the patent; its commercial success; and its current popularity; 9) the utility and advantages of the patent property over old modes or devices, if any, that had been used for working out similar results; 10) the nature of the patented invention; the character of the commercial embodiment of it as owned and produced by the patent holder; and the benefits to those who have used the invention; 11) the extent to which the alleged infringer has made use of the invention; and any evidence tending to prove the value of that use; 12) the portion of the profit or of the selling price that may be customary in the particular business or in comparable businesses to allow for the use of the invention or similar inventions; 13) the portion of the realizable profit that should be credited to the invention as distinguished from nonpatented elements, the manufacturing process, business risks, or significant features or improvements added by the infringer; 14) the opinion and testimony of qualified experts; and 15) any other economic factor that a normally prudent businessperson would, under similar circumstances, take into consideration in negotiating the hypothetical license. Applied Medical Resources Corp. v. U.S. Surgical Corp., 435 F.3d 1356, 1361-64 (Fed. Cir. 2006); Trans-World Manufacturing Corp. v. All Nyman & Sons, Inc., 750 F.2d 1552, 1568 (Fed. Cir. 1984).

In determining the royalty that would have resulted from the hypothetical negotiation you may consider real world facts including the following to the extent they are helpful to you:

- Licenses or offers to license the patent at issue in this case
- Licenses involving comparable patents
- The licensing history of the parties
- Licensing practices in the relevant industry
- Whether the patent owner had an established policy of refusing to license the patent at issue.
- The relationship between the patent owner and alleged infringer, including whether or not they were competitors
- The significance of the patented technology in promoting sales of the alleged infringer's products and earning it profit
- Alternatives to the patented technology and advantages provided by the patented technology relative to the alternatives.
- The portion of the alleged infringer's profit that should be credited to the invention as distinguished from nonpatented features, improvements or contributions.
- Any other economic factor that a normally prudent businessperson would, under similar circumstances, take into consideration in negotiating the hypothetical license.

APPENDICES

MODEL VERDICT FORMS

The Model Verdict Forms are offered for the convenience of the court and parties. They can be a starting point for preparing a form in a particular case. Form A serves as a simple form. Form B serves as a form in a case where there are a greater number of issues.

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF _____

PATENT HOLDER,

Plaintiff,

vs.

Civil Action No.

ALLEGED INFRINGER,

Defendant.

Verdict Form A

Based on the evidence admitted at trial and in accordance with the instructions as given by the Court, we, the jury, unanimously agree to the answers to the following questions:

I. Infringement

Has [the patent holder] proven it is more probable than not that [the alleged infringer] infringed the following claim?

a. Claim 1 of the '123 patent Yes_____ No_____

II. Validity

Has [the alleged infringer] proven it is highly probable that the following claim is invalid as obvious?

a. Claim 1 of the '123 patent Yes_____ No_____

III. Damages

If you have found claim 1 of the '123 patent is infringed and is not invalid, what damages do you find [the alleged infringer] has proven it is more probable than not it has suffered as a result of that infringement?

i. Lost Profits: _____

ii. Reasonable Royalty

rate: _____

total royalty damages: _____

Total Damages: _____

For the Jury:

By: _____
Foreperson

Date: _____

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF _____**

PATENT HOLDER,

Plaintiff,

vs.

Civil Action No.

ALLEGED INFRINGER

Defendant.

Verdict Form B

USE OF MODEL SPECIAL VERDICT FORM

The following model special verdict form is provided for guidance in preparing an appropriate special verdict form tailored for your specific case. The model form assumes the patent holder alleges direct and indirect infringement of a single claim of one patent and seeks a combination of lost profits and a reasonable royalty for allegedly infringing sales. The alleged infringer asserts a number of invalidity defenses. The form requires the jury to record its underlying factual findings on the defenses of anticipation, statutory bar and obviousness. If the parties do not request that the jury record its factual findings, the form may be modified to only ask the ultimate question of whether each defense has been proven. The names of the parties should be substituted for “[the patent holder]” and “[the alleged infringer]” on the form. Other language that is bracketed is language that should be carefully reviewed and only included if the evidence raises an issue covered by the language. Additional tailoring and supplementation of the form will, of course, be required depending on the issues raised in your specific case.

SAMPLE VERDICT FORM

Instructions: When answering the following questions and filling out this Verdict Form, please follow the directions provided throughout the form. Your answer to each question must be unanimous. Please refer to the Jury Instructions for guidance on the law applicable to the subject matter covered by each question.

QUESTIONS AND ANSWERS

We, the jury, unanimously agree to the answers to the following questions and return them under the instructions of this court as our verdict in this case.

I. FINDINGS ON INFRINGEMENT CLAIMS

(The questions regarding infringement should be answered regardless of your findings with respect to the validity or invalidity of the patent.)

A. Direct Infringement—Literal Infringement

1. Has [the patent holder] proven that it is more likely than not that every requirement of claim 1 of its patent is included in [the alleged infringer]'s accused product [method]?

Yes _____ No _____

If your answer to question 1 is “yes,” go to question 3. If your answer to question 1 is “no,” go to question 2.

B. Direct Infringement Under the Doctrine of Equivalents

2. Has [the patent holder] proven that it is more likely than not that the accused product [method] includes parts [steps] that are identical or equivalent to every requirement of claim 1 of [the patent holder]'s patent? In other words, for any requirement that is not literally found in the [the alleged infringer]'s accused product [method], does the accused product [method] have an equivalent part [step] to that requirement?

Yes _____ No _____

C. Indirect Infringement—Inducing Infringement

3. Has [the patent holder] proven that it is more likely than not that: (a) [the alleged infringer] actively encouraged or instructed another person on how to use a product in a way that infringes claim 1 of [the patent holder]'s patent; (b) [the alleged infringer] knew of the patent at that time; (c) [the alleged infringer] knew, or should have known, that the encouragement or instructions would result in infringement; and (d) the other person infringed claim 1?

Yes_____ No _____

D. Indirect Infringement—Contributory Infringement

4. Has [the patent holder] proven that it is more likely than not that: (a) [the alleged infringer] supplied a part, or a component, to another for use in a product that infringes claim 1 of [the patent holder]’s patent; (b) the component was a material part of the infringing product; (c) [the alleged infringer] supplied the component with knowledge of the patent and knowledge that the component was especially made or adapted for use in an infringing manner; and (d) the component did not have a substantial non-infringing use?

Yes_____ No _____

E. Willful Infringement

5a. Has the [the patent holder] proven that it is highly probable that [the alleged infringer]’s conduct was objectively reckless, that is, that [the alleged infringer] proceeded with the allegedly infringing conduct despite an objectively high likelihood that it was infringing a valid [and enforceable] patent?

Yes_____ No _____

If the answer to question 5a is “yes,” answer question 5b. If your answer to question 5a is “no,” go to question 6.]

5b. Has the [the patent holder] proven that it is highly probable that the [the alleged infringer] actually knew, or it was so obvious that [the alleged infringer] should have known, that its actions constituted infringement of a valid [and enforceable] patent?

Yes _____ No _____

II. FINDINGS ON INVALIDITY DEFENSES

(The questions regarding invalidity should be answered regardless of your findings with respect to infringement.)

A. Written Description Requirement

6. Has [the alleged infringer] proven that it is highly probable that a person of ordinary skill in the field who read [the patent holder]’s patent application as originally filed [at the time of the effective filing date of the application] would not recognize that the patent application described the invention as claimed?

Yes_____ No_____

B. Enablement

7. Has [the alleged infringer] proven that it is highly probable that the [the patent holder]’s patent does not disclose sufficient information to enable a person of ordinary skill in the field at the time the application was filed [at the time of the effective filing date of the application] to make and use the claimed invention?

Yes_____ No_____

C. Best Mode

8. Has [the alleged infringer] proven that it is highly probable that: (a) the inventor knew at the time the patent application was filed [at the time of the effective filing date of the application] of a way to make the invention that the inventor thought was better than any other way; and (b) the patent does not contain a description of that best way sufficient to enable a person of ordinary skill in the art to carry out that best way?

Yes _____ No _____

D. Anticipation

9. Has [the alleged infringer] proven that it is highly probable that claim 1 of [the patent holder]'s patent was "anticipated," or, in other words, not new?

Yes _____ No _____

If the answer is "yes," check any reason below that is applicable:

The claimed invention was already publicly known or publicly used by others in the United States before the date of conception of the claimed invention.]

The claimed invention was already patented or described in a printed publication somewhere in the world before the date of conception.]

The claimed invention was already described in another issued U.S. patent or published U.S. patent application that was based on a patent application filed before the date of conception.]

The claimed invention was already made by someone else in the United States before the date of conception and that other person had not abandoned the invention or kept it secret.]

The named inventor did not invent the claimed invention but instead learned of the claimed invention from someone else.]

The named inventor was not the first inventor of the claimed invention.]

E. Statutory Bar

10. Has [the alleged infringer] proven that it is highly probable that claim 1 of [the patent holder]'s patent was not filed within the time required by law?

Yes _____ No _____

If the answer is "yes," check any reason below that is applicable:

The claimed invention was already patented or described in a printed publication somewhere in the world more than one year before the effective filing date of the patent application.]

The claimed invention was already being publicly or commercially used in the United States more than one year before the effective filing date of the patent application and that use was not primarily an experimental use controlled by the inventor to test whether the invention worked for its intended purpose.]

[_____] A device or method using the claimed invention was sold or offered for sale in the United States and the claimed invention was ready for patenting more than one year before the filing date of the patent application and that offer or sale was not primarily for experimental purposes controlled by the inventor to test whether the invention worked for its intended purpose.]

[_____] [the patent holder] had already obtained a patent on the claimed invention in a foreign country before the original U.S. application, and the foreign application was filed more than one year before the effective filing date of the U.S. application.]

F. Obviousness⁵⁰

11. The ultimate conclusion that must be reached on the obviousness question is whether [the alleged infringer] has proven that it is highly probable that the claimed invention would have been obvious to a person of ordinary skill in the field at the time the patent application was filed [at the time of the effective filing date of the application]. In order to properly reach a conclusion the following preliminary questions must be answered:

a. What was the level of ordinary skill in the field that someone would have had at the time the claimed invention was made?⁵¹ Check the applicable answer:

_____ [the patent holder's contention]

_____ [the alleged infringer's contention]

⁵⁰ This instruction allows the ultimate legal opinion on obviousness to go to the jury but requires the jury to make appropriate underlying factual findings. Although trial courts have often permitted the jury to reach the final conclusion of obviousness without specifying its underlying factual determinations, such an approach is not recommended if either party requests that the jury make the underlying factual findings. The verdict form should require the jury's finding on each factual issue so that the trial judge may make the final determination on the obviousness question. The jury's verdict on the legal question of obviousness is advisory only because the ultimate question of obviousness is a question of law for the court. *KSR Intern. Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1745 (2007) ("The ultimate judgment of obviousness is a legal determination."); see *Dippin' Dots, Inc. v. Mosey*, 476 F.3d 1337, 1343 (Fed. Cir. 2007). Judge Michel pointed out in his dissent in *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339 (Fed. Cir. 2001):

The issue presented in this appeal derives from the common, if unfortunate, practice of allowing the jury to render a general verdict on the ultimate legal conclusion of obviousness without requiring express findings on the underlying factual issues through a special verdict or special interrogatories under Fed. R. Civ. P. 49. Nevertheless, since the inception of our court, we have recognized that a court may submit this legal question to a jury and that doing so by general verdict rather than by Rule 49 is not ordinarily an abuse of discretion. We have emphasized, however, that there is no question that the judge must remain the ultimate arbiter on the question of obviousness.

See also *Richardson-Vicks Inc. v. Upjohn Co.*, 122 F.3d 1476, 1485 (Fed. Cir. 1997) (stating that "Sorting through the record in a case such as this when the issue is the correctness of a jury verdict is made considerably more difficult by the absence of specific findings by the jury. . . . The preferred route would have been to submit the underlying factual issues to the jury in the form of a special verdict under rule 49(a).").

⁵¹ In many cases there will be little dispute concerning the *Graham* factors. The instruction should be tailored to require the jury to decide only disputed issues of fact. For example, the relevant portion of the instruction might read: a. What was the level of ordinary skill in the field that someone would have had at the time the claimed invention was made? The parties agree that the level of ordinary skill would have had 5 years of experience in furniture making and taken at least one course in furniture design.

b. Was [disputed reference] within the scope and content of the prior art at the time of the claimed invention? Check the reference only if was within the scope and content of the prior art)

_____ [Reference a]

_____ [Reference b]

c. What difference, if any, existed between the claimed invention and the prior art at the time of the claimed invention? Check only the answer that correctly identifies the difference, if any

_____ [the patent holder's contention]

_____ [the alleged infringer's contention or no difference]

d. Which of the following factors that tend to indicate nonobviousness, if any, has been established by the evidence with respect to the claimed invention—check any that apply:

_____ commercial success of a product due to the merits of the claimed invention

_____ a long felt need for the solution that is provided by the claimed invention

_____ unsuccessful attempts by others to find the solution that is provided by the claimed invention

_____ copying of the claimed invention by others

_____ unexpected and superior results from the claimed invention

_____ acceptance by others of the claimed invention as shown by praise from others in the field or from the licensing of the claimed invention

_____ [other factor(s) indicating nonobviousness]

e. Which of the following factors that tend to indicate obviousness, if any, has been established by the evidence with respect to the claimed invention—check those that apply:

_____ independent invention of the claimed invention by others before or at about the same time as the named inventor thought of it

_____ [other factor(s) indicating nonobviousness]

After considering your answers to the preliminary factual questions above, do you find that [the alleged infringer] has proven that it is highly probable that claim 1 of [the patent holder]'s patent would have been obvious to a person of ordinary skill in the field at the time the patent application was filed [at the time of the effective filing date of the application]?

Yes _____ No _____

G. Inventorship

12. Has [the alleged infringer] proven that it is highly probable that [the patent holder]'s patent fails to meet the requirement to name all actual inventors and only the actual inventors?

Yes _____ No _____

III. FINDINGS ON DAMAGES (IF APPLICABLE)

If you answered question 1, 2, 3 or 4 “yes” and questions 6, 7, 8, 9, 10, 11 and 12 “no,” proceed to answer the remaining questions. If you did not so answer, do not answer the remaining questions and proceed to check and sign the verdict form.

A. Lost Profits on Sales of Patented Product

13. What lost profits, if any, did [the patent holder] show it more likely than not suffered, including any from price erosion, as a result of sales of the patented product which it would with reasonable probability have made but for [the alleged infringer]’s infringement?

\$ _____

B. Loss of Collateral Sales

14. What lost profits on collateral sales, if any, did [the patent holder] show it more likely than not suffered as a result of [the alleged infringer]’s infringement?

\$ _____

C. Reasonable Royalty

15. For those infringing sales for which [the patent holder] has not proved its entitlement to lost profits, what amount has it proved it is entitled to as a reasonable royalty?

\$ _____

Rate: _____

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

DATED: _____, 20____ By: _____ Presiding Juror