

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

[See Signature Page for Counsel]

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

ACER, INC., ACER AMERICA CORPORATION and GATEWAY, INC.,

Plaintiffs,

v.

TECHNOLOGY PROPERTIES LIMITED, PATRIOT SCIENTIFIC CORPORATION, and ALLIACENSE LIMITED,

Defendants.

Case No. 5:08-cv-00877 PSG

**JOINT PROPOSED JURY INSTRUCTIONS**

HTC CORPORATION, HTC AMERICA, INC.,

Plaintiffs,

v.

TECHNOLOGY PROPERTIES LIMITED, PATRIOT SCIENTIFIC CORPORATION, and ALLIACENSE LIMITED,

Defendants.

Case No. 5:08-cv-00882 PSG

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**PRELIMINARY INSTRUCTIONS**



1 that were patented or described in a publication in any country. The examiner considers,  
2 among other things, whether each claim defines an invention that is new, useful, and not  
3 obvious in view of the prior art. A patent lists the prior art that the examiner considered; this  
4 list is called the “cited references.”

5 After the prior art search and examination of the application, the patent examiner then  
6 informs the applicant in writing what the examiner has found and whether any claim is  
7 patentable, and thus will be “allowed.” This writing from the patent examiner is called an  
8 “office action.” If the examiner rejects the claims, the applicant then responds and sometimes  
9 changes the claims or submits new claims. This process, which takes place only between the  
10 examiner and the patent applicant, may go back and forth for some time until the examiner is  
11 satisfied that the application and claims meet the requirements for a patent. The papers  
12 generated during this time of communicating back and forth between the patent examiner and  
13 the applicant make up what is called the “prosecution history.” All of this material becomes  
14 available to the public no later than the date when the patent issues.

15 The fact that the PTO grants a patent does not necessarily mean that any invention  
16 claimed in the patent, in fact, deserves the protection of a patent. For example, the PTO may  
17 not have had available to it all the information that will be presented to you. A person accused  
18 of infringement has the right to argue here in federal court that a claimed invention in the  
19 patent is invalid because it does not meet the requirements for a patent.

20  
21 Authorities

22 N.D. Cal. Model Patent Jury Instruction § 1.  
23  
24  
25  
26  
27  
28

## 2. PATENTS AT ISSUE AND OVERVIEW OF THE PARTIES

1  
2 These two cases involve two United States patents, the “asserted patents,” both  
3 obtained by Charles H. Moore and Russell H. Fish, III, and transferred by Mr. Moore and Mr.  
4 Fish to TPL. One of the patents involved in this case is United States Patent Number  
5 5,809,336, which lists Mr. Moore and Mr. Fish as the inventors. The other patent involved in  
6 this case is United States Patent Number 5,530,890, which lists Mr. Moore and Mr. Fish as the  
7 inventors. For convenience, the parties and I will often refer to U.S. Patent Number 5,809,336  
8 as the ’336 patent and U.S. Patent Number 5,530,890 as the ’890 patent, 336 and 890 being the  
9 last three numbers of the patent numbers, respectively.

10 The Plaintiffs in Case No. 5:08-cv-00877 PSG are Acer Inc., Acer America  
11 Corporation and Gateway, Inc. For convenience, the parties and I will often refer to Plaintiffs  
12 together as Acer/Gateway. Gateway, Inc. was a separate company for many years, but in  
13 October 2007 Acer Inc. acquired Gateway and eventually integrated it into Acer’s operations.  
14 Since Gateway was an independent company and sold its own products during much of the  
15 relevant time period, I may refer to Gateway separately from Acer where I think it is important  
16 to distinguish between these entities for the purposes of a specific instruction. However, you  
17 must decide the Acer case as to Acer, Inc., Acer America Corporation, and Gateway, Inc.  
18 separately regardless of whether I refer to them collectively as “Acer/Gateway” or  
19 individually.

20 The Plaintiffs in Case No. 5:08-cv-00882 are HTC Corporation and HTC America. For  
21 convenience, the parties and I will often refer to Plaintiffs as HTC.

22 The Defendants in both cases are Technology Properties Limited, Alliacense Limited,  
23 and Patriot Scientific Corporation. For convenience, the parties and I will often refer to  
24 Defendants as TPL and Patriot.



	<b>ACCUSED BRANDED PRODUCT</b>	<b>ACCUSED COMPONENT</b>	<b>ACCUSED CHIPSET</b>
1			
2	7. Acer Desktop Veriton 3600GT/5600GT/7600GT	Ethernet Controller	Broadcom BCM5705
3			
4	8. Acer Desktop Veriton L410	Hard Disk Controller from a Seagate HDD	LSI100404226
5	9. Acer Notebook Aspire 1690	Ethernet Controller	Broadcom BCM5705
6	10. Acer Notebook Aspire 7520-5823	Hard Disk Controller from a Western Digital HDD	Marvell 88i6745M-TFJ1
7		Bluetooth Processor	Broadcom BCM92045NMD
8	11. Acer Notebook Aspire One (AOA150- 1570)	Hard Disk Controller from a Seagate HDD	LSI B5503A
9	12. Acer Notebook Ferrari 1000	Ethernet Controller	Broadcom BCM5788
10			
11	13. Acer Notebook Ferrari 1004WTMI	Ethernet Controller	Broadcom BCM5788
12	14. Acer Notebook Ferrari 4000	Ethernet Controller	Broadcom BCM5789
13	15. Acer Notebook Ferrari 5000	Ethernet Controller	Broadcom BCM5788
14	16. Acer Notebook TravelMate 3240/3280/3290 Series	Ethernet Controller	Broadcom BCM5789
15			
16	17. Acer Notebook Travelmate 3260	Hard Disk Controller from a Western Digital HDD	Marvell 88i6745
17	18. Acer Notebook TravelMate 4200 Series	Ethernet Controller	Broadcom BCM5789
18			
19	19. Acer Notebook TravelMate 4210/4270/4670 and Aspire 5670	Ethernet Controller	Broadcom BCM5789
20			
21	20. Acer Notebook TravelMate 6292-6700	Bluetooth Processor	Broadcom BCM2045
22	21. Acer Server Altos G330 MK2	Ethernet Controller	Broadcom BCM5721
23			
24	22. Acer Tablet PC TravelMate C210	Ethernet Controller	Broadcom BCM5789
25	23. Acer USB Flash Drive Q80602	USB Card Reader Controller	Silicon Motion SM324
26	24. Gateway Desktop DX441X	USB 2.0 Card Reader Controller	Realtek RTS5111
27		Hard Drive Controller from a Western Digital HDD	Marvell 88i6745
28			

	<b>ACCUSED BRANDED PRODUCT</b>	<b>ACCUSED COMPONENT</b>	<b>ACCUSED CHIPSET</b>
25.	Gateway Desktop FX541X	USB Card Reader Controller Audio Processor Controller Hard Drive Controller from a Western Digital HDD	Alcor Micro AU6375 Creative Technology CA20K1 Marvell 88i6745 –TFJ1
26.	Gateway Desktop GM5664	USB Card Reader Controller	Realtek RTS5111
27.	Gateway Desktop GT5670	USB Card Reader Controller Hard Drive Controller from a Western HDD	Realtek RTS5111 Marvell 88i8845C
28.	Gateway Desktop One ZX190	Hard Disk Drive Controller	Western Digital Hard Drive / Marvell 88i6745 –TFJ1
29.	Gateway LCD Monitor HD2200	Display Monitor Controller	Genesis FLI5968H
30.	Gateway Notebook 3610GZ	Ethernet Controller	Broadcom BCM5789
31.	Gateway Notebook C-141X	Bluetooth Processor Hard Drive Controller from a Fujitsu HDD	Broadcom BCM2045 Marvell 88i6737-TFJ1
32.	Gateway Notebook CX200S	Ethernet Controller	Broadcom BCM5789
33.	Gateway Notebook CX200X	Ethernet Controller	Broadcom BCM5789
34.	Gateway Notebook M-151X	Hard Drive Controller from a Western Digital HDD Bluetooth Processor	Marvell 88i6745 Broadcom BCM2045
35.	Gateway Notebook M-6750	Hard Drive Controller from a Western Digital HDD	Marvell 88i6745M
36.	Gateway Notebook M280	Ethernet Controller	Broadcom BCM5789
37.	Gateway Notebook P-172S FX	Hard Drive Controller from a Seagate HDD	LSI100403183
38.	Gateway Notebook S-7200C-1008588	Ethernet Controller	Broadcom BCM5789
39.	Gateway Notebook T-6321	Hard Drive Controller from a Seagate HDD	ST Microelectronics STV504B

The Acer/Gateway product with the chips and components that are alleged to infringe the '890 patent is as follows:

	<b>ACCUSED BRANDED PRODUCT</b>	<b>ACCUSED COMPONENT</b>	<b>ACCUSED CHIPSET</b>
1.	Gateway Server E-	SCSI Controller	LSI53C1030



	ACCUSED BRANDED PRODUCT	ACCUSED COMPONENT	ACCUSED CHIPSET
1			
2	9515R		

3 Your job will be to decide whether claims 1, 6, 7, 9, 10, 11, 13, 14, 15, and 16 of the  
4 '336 patent and claims 11, 13, 17 and 19 of the '890 patent have been infringed and whether  
5 those claims are invalid. If you decide that any claim of the '336 patent or the '890 patent has  
6 been infringed and is not invalid, you will then need to decide any money damages to be  
7 awarded to TPL and Patriot to compensate it for the infringement.

8 You will also need to make a finding as to whether the infringement was willful. If you  
9 decide that any infringement was willful, that decision should not affect any damage award  
10 you give. I will take willfulness into account later, if needed.

11 You may hear evidence that Acer has its own patent(s) or that TPL improved on the  
12 '336 patent or the '890 patent. While this evidence is relevant to some issues you will be  
13 asked to decide, a party can still infringe even if it has its own patents in the same area. You  
14 will be instructed after trial as to what, if any, relevance these facts have to the particular issues  
15 in this case. Meanwhile, please keep an open mind.

1 Authorities

2 N.D. Cal. Model Patent Jury Instruction § 3.

3

4

5

6

7

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28

1 **DEFENDANTS' OBJECTIONS AND ALTERNATIVE INSTRUCTION<sup>2</sup>:**

2 Defendants propose an instruction that is substantially similar to Acer/Gateway's  
3 proposed instruction. Defendants' proposed changes/objections are as follows:

- 4 • Defendants' object to collectively referring to Defendants as "TPL." Despite their  
5 respective ownership interests in the asserted patents, TPL and Patriot are separate,  
6 unaffiliated companies. Accordingly, Defendants request that they be referred to as  
7 "TPL and Patriot" though the jury instructions. Plaintiffs have indicated that they do  
8 not object to replacing "TPL" with "TPL and Patriot" throughout the instructions.  
9 However, the parties did not have time make this change before the submission  
10 deadline due to their continued meet and confer regarding substantive issues.
- 11 • Defendants object to Acer/Gateway's proposed limitation of Defendants' infringement  
12 claim to "Acer/Gateway products with the chips and components that are alleged to  
13 infringe." Defendants accuse Acer/Gateway products, not merely chips and  
14 components. In addition, as Acer/Gateway confirmed to the Court at the August 13,  
15 2013 hearing, Defendants and Acer/Gateway have stipulated to representative products  
16 with respect to the '336 patent. Acer/Gateway's reference to chips and components  
17 runs counter to the stipulation.

18

19 **2.1 SUMMARY OF CONTENTIONS - FOR ACER/GATEWAY DEFENDANTS'**  
20 **ALTERNATIVE INSTRUCTION**

21 To help you follow the evidence, I will now give you a summary of the positions of the  
22 parties.

23 Acer/Gateway filed suit in this court seeking a declaration that no valid and enforceable

24 \_\_\_\_\_  
25 <sup>2</sup> Defendants proposed an initial set of instructions based closely on the Northern District's model instructions but  
26 agreed to use HTC's proposed instructions as a starting point for the parties' joint submission to the Court and were  
27 able to agree to most of HTC's instructions. Thereafter, Acer and HTC combined their proposed instructions.  
28 Defendants' again agreed to use Plaintiffs' instructions as a starting point for the joint submission, but were unable to  
agree to as many of Plaintiffs' new proposed instructions because they were more divergent from the Northern District  
model instructions. Defendants respectfully submit that, to the extent any disagreement among the parties hinges on  
language that diverges from the Northern District model instructions, adoption of the model instructions would be an  
equitable resolution because the model instructions were designed to be party-neutral, were formulated by a panel of  
experienced practitioners and judges and have been subjected to public comment.

1 claim of the '336 patent and the '890 patent is infringed by Acer/Gateway. Acer/Gateway also  
 2 argues that claims 1, 6, 7, 9, 10, 11, 13, 14, 15, and 16 of the '336 patent and claims 11, 13, 17  
 3 and 19 of the '890 patent are invalid.

4 TPL and Patriot filed a counter complaint alleging that Acer/Gateway infringes the  
 5 '336 and '890 patents by making, importing, using, selling, and offering for sale products that  
 6 TPL and Patriot argue are covered by claims 1, 6, 7, 9, 10, 11, 13, 14, 15, and 16 of the '336  
 7 patent and claims 11, 13, 17 and 19 of the '890 patent. TPL and Patriot seek money damages  
 8 for Acer/Gateway's alleged infringement. TPL and Patriot also deny that the claims of the  
 9 '336 patent and the claims of the '890 patent are invalid.

10 The Acer/Gateway products that are alleged to infringe the '336 patent are as follows:

	ACCUSED BRANDED PRODUCT	ACCUSED COMPONENT	ACCUSED CHIPSET
11			
12			
13	40. Acer Server Altos G510	Ethernet Controller	Broadcom BCM5702
14	41. Acer Desktop Aspire E380-UD48	USB Card Reader Controller	Realtek RTS5111
15	42. Acer Desktop Aspire E360	USB Card Reader Controller	Cypress CY7C63231A
16	43. Acer Desktop Aspire M3100	Hard Disk Controller from a Seagate HDD	ST Microelectronics ST 100404226
17	44. Acer Desktop Aspire X3200	Hard Disk Controller from a Western Digital HDD	Marvell 88i8845D
18	45. eMachines Desktop W3653	USB Card Reader Controller Hard Disk Controller from a Western Digital HDD	Alcor AU6375 Marvell 88i8845C
19			
20	46. Acer Desktop Veriton 3600GT/5600GT/7600GT	Ethernet Controller	Broadcom BCM5705
21	47. Acer Desktop Veriton L410	Hard Disk Controller from a Seagate HDD	LSI100404226
22			
23	48. Acer Notebook Aspire 1690	Ethernet Controller	Broadcom BCM5705
24	49. Acer Notebook Aspire 7520-5823	Hard Disk Controller from a Western Digital HDD Bluetooth Processor	Marvell 88i6745M-TFJ1 Broadcom BCM92045NMD
25			
26	50. Acer Notebook Aspire One (AOA150- 1570)	Hard Disk Controller from a Seagate HDD	LSI B5503A
27	51. Acer Notebook Ferrari 1000	Ethernet Controller	Broadcom BCM5788
28			

	<b>ACCUSED BRANDED PRODUCT</b>	<b>ACCUSED COMPONENT</b>	<b>ACCUSED CHIPSET</b>
1			
2	52. Acer Notebook Ferrari 1004WTMI	Ethernet Controller	Broadcom BCM5788
3	53. Acer Notebook Ferrari 4000	Ethernet Controller	Broadcom BCM5789
4	54. Acer Notebook Ferrari 5000	Ethernet Controller	Broadcom BCM5788
5	55. Acer Notebook TravelMate 3240/3280/3290 Series	Ethernet Controller	Broadcom BCM5789
6	56. Acer Notebook Travelmate 3260	Hard Disk Controller from a Western Digital HDD	Marvell 88i6745
7	57. Acer Notebook TravelMate 4200 Series	Ethernet Controller	Broadcom BCM5789
8	58. Acer Notebook TravelMate 4210/4270/4670 and Aspire 5670	Ethernet Controller	Broadcom BCM5789
9	59. Acer Notebook TravelMate 6292-6700	Bluetooth Processor	Broadcom BCM2045
10	60. Acer Server Altos G330 MK2	Ethernet Controller	Broadcom BCM5721
11	61. Acer Tablet PC TravelMate C210	Ethernet Controller	Broadcom BCM5789
12	62. Acer USB Flash Drive Q80602	USB Card Reader Controller	Silicon Motion SM324
13	63. Gateway Desktop DX441X	USB 2.0 Card Reader Controller Hard Drive Controller from a Western Digital HDD	Realtek RTS5111 Marvell 88i6745
14	64. Gateway Desktop FX541X	USB Card Reader Controller Audio Processor Controller Hard Drive Controller from a Western Digital HDD	Alcor Micro AU6375 Creative Technology CA20K1 Marvell 88i6745 –TFJ1
15	65. Gateway Desktop GM5664	USB Card Reader Controller	Realtek RTS5111
16	66. Gateway Desktop GT5670	USB Card Reader Controller Hard Drive Controller from a Western HDD	Realtek RTS5111 Marvell 88i8845C
17	67. Gateway Desktop One ZX190	Hard Disk Drive Controller	Western Digital Hard Drive / Marvell 88i6745 –TFJ1
18	68. Gateway LCD Monitor HD2200	Display Monitor Controller	Genesis FLI5968H
19			
20			
21			
22			
23			
24			
25			
26			
27			
28			

	<b>ACCUSED BRANDED PRODUCT</b>	<b>ACCUSED COMPONENT</b>	<b>ACCUSED CHIPSET</b>
69.	Gateway Notebook 3610GZ	Ethernet Controller	Broadcom BCM5789
70.	Gateway Notebook C-141X	Bluetooth Processor Hard Drive Controller from a Fujitsu HDD	Broadcom BCM2045 Marvell 88i6737-TFJ1
71.	Gateway Notebook CX200S	Ethernet Controller	Broadcom BCM5789
72.	Gateway Notebook CX200X	Ethernet Controller	Broadcom BCM5789
73.	Gateway Notebook M-151X	Hard Drive Controller from a Western Digital HDD Bluetooth Processor	Marvell 88i6745 Broadcom BCM2045
74.	Gateway Notebook M-6750	Hard Drive Controller from a Western Digital HDD	Marvell 88i6745M
75.	Gateway Notebook M280	Ethernet Controller	Broadcom BCM5789
76.	Gateway Notebook P-172S FX	Hard Drive Controller from a Seagate HDD	LSI100403183
77.	Gateway Notebook S-7200C-1008588	Ethernet Controller	Broadcom BCM5789
78.	Gateway Notebook T-6321	Hard Drive Controller from a Seagate HDD	ST Microelectronics STV504B

The Acer/Gateway product that is alleged to infringe the '890 patent is as follows:

	<b>ACCUSED BRANDED PRODUCT</b>	<b>ACCUSED COMPONENT</b>	<b>ACCUSED CHIPSET</b>
1.	Gateway Server E-9515R	SCSI Controller	LSI53C1030

Your job will be to decide whether claims 1, 6, 7, 9, 10, 11, 13, 14, 15, and 16 of the '336 patent and claims 11, 13, 17 and 19 of the '890 patent have been infringed and whether those claims are invalid. If you decide that any claim of the '336 patent or the '890 patent has been infringed and is not invalid, you will then need to decide any money damages to be awarded to TPL and Patriot to compensate it for the infringement.

You will also need to make a finding as to 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, if needed.

1           You may hear evidence that Acer has its own patent(s) or that TPL improved on the  
2 '336 patent or the '890 patent. While this evidence is relevant to some issues you will be  
3 asked to decide, a party can still infringe even if it has its own patents in the same area. You  
4 will be instructed after trial as to what, if any, relevance these facts have to the particular issues  
5 in this case. Meanwhile, please keep an open mind.

6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1 Authorities

2 N.D. Cal. Model Patent Jury Instruction § 3.

3

4

5

6

7

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28



1 **PLAINTIFFS’ RESPONSE AND OBJECTIONS TO DEFENDANTS’ ALTERNATIVE**  
2 **INSTRUCTION:**

3 The inclusion of the language “Acer/Gateway products with the chips and components  
4 that are alleged to infringe” is necessary for several reasons. First, it is consistent with the  
5 agreed upon chart showing the accused Acer/Gateway products, components, and chips.

6 Second, TPL mischaracterizes the stipulation between the parties. This is not a  
7 stipulation to a representative product. Rather, the parties merely agreed to a common  
8 functionality in the accused Hard Disk Drives (HDDs) only as applied to the accused  
9 Acer/Gateway products where TPL specifically identified and accused an HDD. The  
10 stipulation between Acer/Gateway does not apply to products where TPL has accused other  
11 chips and components such as Bluetooth and Ethernet controllers. *See* Dkt. No. 507 at  
12 Appendix A (accused product list showing that 23 of the 39 products do not have an accused  
13 HDD) and Appendix C (stipulation). TPL’s characterization of the stipulation violates the  
14 Court’s prior order denying TPL’s attempt to amend its infringement contentions to include  
15 additional products and components not previously accused.

16 Finally, the stipulation also does not apply to damages where TPL still has the burden  
17 to show that the accused products contain an infringing component and to eliminate the ones  
18 that contain non-infringing or licensed from its damages calculations. *See Power Integrations,*  
19 *Inc. v. Fairchild Semiconductor Int’l, Inc.*, 711 F.3d 1348, 1373-74 (Fed. Cir. 2013); *IP*  
20 *Innovation L.L.C. v. Red Hat, Inc.*, 705 F. Supp.2d 687, 689-90 (E.D. Tex. 2010).



No.	Accused Product	'336 patent	'890 patent
10	HTC Smartphone Aria		X
11	HTC Smartphone Desire	X	
12	HTC Smartphone EVO 4G	X	
13	HTC Smartphone EVO Shift 4G	X	
14	HTC Smartphone G2	X	
15	HTC Smartphone HD7	X	
16	HTC Smartphone Inspire 4G	X	
17	HTC Smartphone myTouch 4G	X	
18	HTC Smartphone S640 [Iris]	X	X
19	HTC Smartphone Surround	X	
20	HTC Smartphone ThunderBolt	X	
21	HTC Smartphone Wildfire	X	
22	HTC SPV C500/SMT5600/Ontario [Typhoon]	X	X
23	HTC T-Mobile G1 [Dream]	X	X
24	HTC T-Mobile Shadow [Phoebus]	X	X
25	HTC Touch Diamond [Diamond]	X	X
26	HTC Touch Dual [Neon]	X	X
27	HTC Touch Phone Fuze (AT&T)	X	X
28	Mobile Phone 2125 (aka Faraday, Tornado)	X	X
29	Mobile Phone 3125	X	X
30	Mobile Phone S730	X	X
31	Mobile Phone Tilt (aka TyTN II) [Kaiser]	X	X
32	Mobile Phone XV6800 (aka HTC PDA Phone P4000)	X	X
33	PDA Phone P3600	X	
34	PDA Phone S710	X	X
35	PPC-6800 [Mogul, Titan]	X	X
36	Touch Phone P3450	X	X
37	Touch Phone P3650	X	X

No.	Accused Product	'336 patent	'890 patent
38	HTC Mobile Phone Mteor <sup>4</sup>	X	

1  
 2  
 3 Your job will be to decide whether claims 1, 6, 7, 9, 10, 11, 13, 14, 15, and 16 of the  
 4 '336 patent and claims 11, 12, 13, 17 and 19 of the '890 patent have been infringed and  
 5 whether those claims are invalid. If you decide that any claim of the '336 patent and the '890  
 6 patent has been infringed and is not invalid, you will then need to decide any money damages  
 7 to be awarded to TPL to compensate it for the infringement. You will also need to make a  
 8 finding as to whether the infringement was willful. If you decide that any infringement was  
 9 willful, that decision should not affect any damage award you give. I will take willfulness into  
 10 account later.

11 You may hear evidence that HTC has its own patent(s) or that TPL improved on the  
 12 '336 patent or the '890 patent. While this evidence is relevant to some issues you will be  
 13 asked to decide, a party can still infringe even if it has its own patents in the same area. You  
 14 will be instructed after trial as to what, if any, relevance these facts have to the particular issues  
 15 in this case. Meanwhile, please keep an open mind.

16  
 17  
 18  
 19  
 20  
 21  
 22  
 23  
 24  
 25  
 26 <sup>4</sup> Mteor (and other HTC products) was excluded from this case on September 10, 2010 when the  
 27 Court denied TPL's motion to amend its infringement contentions, which sought to add Mteor  
 28 as infringing the '749 patent. (See Docket No. 184). TPL then tried to add Mteor as infringing  
 the '336 patent in its Supplemental and Amended Infringement Contentions served on June 4,  
 2013, but mistakenly dated January 16, 2013.

1 Authorities

2 N.D. Cal. Model Patent Jury Instruction § 3.

3

4

5

6

7

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28

**DEFENDANTS' OBJECTIONS AND ALTERNATIVE INSTRUCTION:**

Defendants propose an instruction that is substantially similar to HTC's proposed instruction. Defendants' proposed changes/objections are as follows:

- Defendants object to HTC's footnote for accused product 38. The footnote amounts to a preclusion argument made to the jury. Not only is this an argument more appropriately made to the Court, but the argument was waived when HTC failed to raise it by the summary judgment or motion in limine deadlines. Defendants' alternative instruction does not include this footnote.

**2.2 SUMMARY OF CONTENTIONS - FOR HTC DEFENDANTS'****ALTERNATIVE INSTRUCTION**

To help you follow the evidence, I will now give you a summary of the positions of the parties.

HTC filed suit in this court seeking a declaration that no valid and enforceable claim of the '336 patent and the '890 patent is infringed by HTC. HTC also argues that claims 1, 6, 7, 9, 10, 11, 13, 14, 15, and 16 of the '336 patent and claims 11, 12, 13, 17 and 19 of the '890 patent are invalid.

TPL and Patriot filed a counter complaint alleging that HTC infringes the '336 and '890 patents by making, importing, using, selling, and offering for sale products that TPL and Patriot argue are covered by claims 1, 6, 7, 9, 10, 11, 13, 14, 15, and 16 of the '336 patent and claims 11, 13, 17 and 19 of the '890 patent. TPL and Patriot also argue that HTC actively induced infringement of these claims of the '336 patent and the '890 patent by others. TPL and Patriot seek money damages for HTC's alleged infringement. TPL and Patriot also deny that the claims of the '336 patent and the claims of the '890 patent are invalid. The products that are alleged to infringe are:

No.	Accused Product	'336 patent	'890 patent
1	HTC P3470 [Pharos]	X	X

No.	Accused Product	'336 patent	'890 patent
2	HTC PDA PC MDA/8125/9100 [Wizard] (aka HTC PDA Phone P4300)	X	X
3	HTC PDA Phone 8525 [TYTN]	X	
4	HTC PDA Phone P3300 [Artemis]	X	X
5	HTC PDA Phone P4351	X	X
6	HTC PDA Phone S621 (aka Dash) [Excalibur]	X	X
7	HTC PDA Phone S630 [Cava 100 Cavalier]		
8	HTC S720/5800 [Libra]	X	X
9	HTC Shift X9000 [Atlantis]	X	X
10	HTC Smartphone Aria		X
11	HTC Smartphone Desire	X	
12	HTC Smartphone EVO 4G	X	
13	HTC Smartphone EVO Shift 4G	X	
14	HTC Smartphone G2	X	
15	HTC Smartphone HD7	X	
16	HTC Smartphone Inspire 4G	X	
17	HTC Smartphone myTouch 4G	X	
18	HTC Smartphone S640 [Iris]	X	X
19	HTC Smartphone Surround	X	
20	HTC Smartphone ThunderBolt	X	
21	HTC Smartphone Wildfire	X	
22	HTC SPV C500/SMT5600/Ontario [Typhoon]	X	X
23	HTC T-Mobile G1 [Dream]	X	X
24	HTC T-Mobile Shadow [Phoebus]	X	X
25	HTC Touch Diamond [Diamond]	X	X
26	HTC Touch Dual [Neon]	X	X
27	HTC Touch Phone Fuze (AT&T)	X	X
28	Mobile Phone 2125 (aka Faraday, Tornado)	X	X
	Mobile Phone 3125	X	X
	Mobile Phone S730	X	X

No.	Accused Product	'336 patent	'890 patent
31	Mobile Phone Tilt (aka TyTN II) [Kaiser]	X	X
32	Mobile Phone XV6800 (aka HTC PDA Phone P4000)	X	X
33	PDA Phone P3600	X	
34	PDA Phone S710	X	X
35	PPC-6800 [Mogul, Titan]	X	X
36	Touch Phone P3450	X	X
37	Touch Phone P3650	X	X
38	HTC Mobile Phone Mteor	X	

Your job will be to decide whether claims 1, 6, 7, 9, 10, 11, 13, 14, 15, and 16 of the '336 patent and claims 11, 13, 17 and 19 of the '890 patent have been infringed and whether those claims are invalid. You will also need to make a finding as to 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.

You may hear evidence that HTC has its own patent(s) or that TPL improved on the '336 patent or the '890 patent. While this evidence is relevant to some issues you will be asked to decide, a party can still infringe even if it has its own patents in the same area. You will be instructed after trial as to what, if any, relevance these facts have to the particular issues in this case. Meanwhile, please keep an open mind.



1 Authorities

2 N.D. Cal. Model Patent Jury Instruction § 3.

3

4

5

6

7

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28

1 **PLAINTIFFS' RESPONSE AND OBJECTIONS TO DEFENDANTS' ALTERNATIVE**  
2 **INSTRUCTION:**

3 Mteor is not a timely accused product. Mteor (and other HTC products) was excluded  
4 from this case on September 10, 2010 when the Court denied TPL's motion to amend its  
5 infringement contentions, which sought to add Mteor as infringing the '749 patent. *See* Case  
6 No. 5:08-cv-00882, Dkt. No. 184. TPL then tried to add Mteor as infringing the '336 patent in  
7 its Supplemental and Amended Infringement Contentions served on June 4, 2013, but  
8 mistakenly dated January 16, 2013.

9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1     **2.3     SUMMARY OF CONTENTIONS (CONTINUED)**

2             Before you decide whether Acer, Gateway or HTC has infringed the claims of the  
3 patent or whether the claims are invalid, you will need to understand the patent claims. As I  
4 mentioned, the patent claims are numbered sentences at the end of the patent that describe the  
5 boundaries of the patent’s protection. It is my job as judge to explain to you the meaning of  
6 any language in the claims that needs interpretation.

7             I have already determined the meaning of certain terms of the claims of the ’336 patent  
8 and the ’890 patent. You have been given a document reflecting those meanings. You are to  
9 apply my definitions of these terms throughout this case. However, my interpretation of the  
10 language of the claims should not be taken as an indication that I have a view regarding issues  
11 such as infringement and invalidity. Those issues are yours to decide. I will provide you with  
12 more detailed instructions on the meaning of the claims before you retire to deliberate your  
13 verdict.

14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1 Authorities

2 N.D. Cal. Model Patent Jury Instruction § 3.

3

4

5

6

7

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28

1 **3 OUTLINE OF TRIAL**

2 The trial will now begin. First, each side may make an opening statement. An opening  
3 statement is not evidence. It is simply an outline to help you understand what that party expects  
4 the evidence will show.

5 The presentation of evidence will then begin. Witnesses will take the witness stand and  
6 the documents will be offered and admitted into evidence. There are two standards of proof that  
7 you will apply to the evidence, depending on the issue you are deciding. On some issues, you  
8 must decide whether something is more likely true than not. On other issues you must use a  
9 higher standard and decide whether it is highly probable that something is true.

10 TPL and Patriot will present their evidence on their contentions that some claims of  
11 the '336 and the '890 patents have been infringed by Acer/Gateway and HTC and that the  
12 infringement has been willful. These witnesses will be questioned by TPL and Patriot's counsel  
13 in what is called direct examination. After the direct examination of a witness is completed, the  
14 opposing side has an opportunity to cross-examine the witness. To prove infringement of any  
15 claim, TPL and Patriot must persuade you that it is more likely than not that Acer/Gateway and  
16 HTC have infringed that claim. To persuade you that any infringement was willful, TPL and  
17 Patriot must prove that it is highly probable that the infringement was willful.

18 After TPL and Patriot have presented their witnesses, Acer/Gateway and HTC will call  
19 their witnesses, who will also be examined and cross-examined. Acer/Gateway and HTC will  
20 present their evidence that the claims of the '336 and the '890 patents are invalid. To prove  
21 invalidity of any claim, Acer/Gateway and HTC must persuade you that it is highly probable that  
22 the claim is invalid. In addition to presenting its evidence of invalidity, Acer/Gateway and HTC  
23 will put on evidence responding to TPL and Patriot's infringement and willfulness contentions.

24 TPL and Patriot will then return and will put on evidence responding to Acer/Gateway  
25 and HTC's contention that the claims of the '336 and the '890 patents are invalid. TPL and  
26 Patriot will also have the option to put on what is referred to as "rebuttal" evidence to any  
27 evidence offered by Acer/Gateway and HTC of noninfringement or lack of willfulness.  
28

1           Finally, Acer/Gateway and HTC will have the option to put on “rebuttal” evidence to any  
2 evidence offered by TPL and Patriot on the validity of some claims of the ’336 and the ’890  
3 patents.

4           Because the evidence is introduced piecemeal, you need to keep an open mind as the  
5 evidence comes in and wait for all the evidence before you make any decisions. In other words,  
6 you should keep an open mind throughout the entire trial.

7           The parties may present the testimony of a witness by reading from his or her deposition  
8 transcript or playing a videotape of the witness’s deposition testimony. A deposition is the  
9 sworn testimony of a witness taken before trial and is entitled to the same consideration as if the  
10 witness had testified at trial.

11           After the evidence has been presented, I will give you final instructions on the law that  
12 applies to the case and the attorneys will make closing arguments. Closing arguments are not  
13 evidence. After the instructions and closing arguments, you will then decide the case.

14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**Authorities**

N.D. Cal. Model Patent Jury Instruction § 5.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**FINAL INSTRUCTIONS**



1 **1.1 SUMMARY OF CONTENTIONS - FOR ACER/GATEWAY [CHALLENGED**  
2 **INSTRUCTION]**

3 I will now again summarize for you each party's contentions in this case. I will then  
4 tell you what each party must prove to win on each of its contentions.

5 As I previously explained, Acer/Gateway filed suit in this court seeking a declaration  
6 that no valid and enforceable claim of the '336 patent and the '890 patent is infringed by  
7 Acer/Gateway. Acer/Gateway also argues that claims 1, 6, 7, 9, 10, 11, 13, 14, 15, and 16 of  
8 the '336 patent and claims 11, 13, 17 and 19 of the '890 patent are invalid.

9 TPL and Patriot filed a counter complaint alleging that Acer/Gateway infringes the  
10 '336 and '890 patents by making, importing, using, selling, and offering for sale products that  
11 TPL and Patriot argue are covered by claims 1, 6, 7, 9, 10, 11, 13, 14, 15, and 16 of the '336  
12 patent and claims 11, 13, 17 and 19 of the '890 patent. TPL and Patriot seek money damages  
13 for Acer/Gateway's alleged infringement. TPL and Patriot also deny that the claims of the  
14 '336 patent and the claims of the '890 patent are invalid.

15 The Acer/Gateway products with the chips and components that are alleged to infringe  
16 the '336 patent are as follows:

	<b>ACCUSED BRANDED PRODUCT</b>	<b>ACCUSED COMPONENT</b>	<b>ACCUSED CHIPSET</b>
17			
18			
19	79. Acer Server Altos G510	Ethernet Controller	Broadcom BCM5702
20	80. Acer Desktop Aspire E380-UD48	USB Card Reader Controller	Realtek RTS5111
21	81. Acer Desktop Aspire E360	USB Card Reader Controller	Cypress CY7C63231A
22	82. Acer Desktop Aspire M3100	Hard Disk Controller from a Seagate HDD	ST Microelectronics ST 100404226
23	83. Acer Desktop Aspire X3200	Hard Disk Controller from a Western Digital HDD	Marvell 88i8845D
24	84. eMachines Desktop W3653	USB Card Reader Controller Hard Disk Controller from a Western Digital HDD	Alcor AU6375 Marvell 88i8845C
25			
26	85. Acer Desktop Veriton 3600GT/5600GT/7600GT	Ethernet Controller	Broadcom BCM5705
27	86. Acer Desktop Veriton L410	Hard Disk Controller from a Seagate HDD	LSI100404226
28			

	<b>ACCUSED BRANDED PRODUCT</b>	<b>ACCUSED COMPONENT</b>	<b>ACCUSED CHIPSET</b>
1			
2	87. Acer Notebook Aspire 1690	Ethernet Controller	Broadcom BCM5705
3			
4	88. Acer Notebook Aspire 7520-5823	Hard Disk Controller from a Western Digital HDD Bluetooth Processor	Marvell 88i6745M-TFJ1 Broadcom BCM92045NMD
5			
6	89. Acer Notebook Aspire One (AOA150- 1570)	Hard Disk Controller from a Seagate HDD	LSI B5503A
7	90. Acer Notebook Ferrari 1000	Ethernet Controller	Broadcom BCM5788
8	91. Acer Notebook Ferrari 1004WTMI	Ethernet Controller	Broadcom BCM5788
9	92. Acer Notebook Ferrari 4000	Ethernet Controller	Broadcom BCM5789
10			
11	93. Acer Notebook Ferrari 5000	Ethernet Controller	Broadcom BCM5788
12	94. Acer Notebook TravelMate 3240/3280/3290 Series	Ethernet Controller	Broadcom BCM5789
13			
14	95. Acer Notebook Travelmate 3260	Hard Disk Controller from a Western Digital HDD	Marvell 88i6745
15	96. Acer Notebook TravelMate 4200 Series	Ethernet Controller	Broadcom BCM5789
16	97. Acer Notebook TravelMate 4210/4270/4670 and Aspire 5670	Ethernet Controller	Broadcom BCM5789
17			
18	98. Acer Notebook TravelMate 6292-6700	Bluetooth Processor	Broadcom BCM2045
19			
20	99. Acer Server Altos G330 MK2	Ethernet Controller	Broadcom BCM5721
21	100. Acer Tablet PC TravelMate C210	Ethernet Controller	Broadcom BCM5789
22	101. Acer USB Flash Drive Q80602	USB Card Reader Controller	Silicon Motion SM324
23			
24	102. Gateway Desktop DX441X	USB 2.0 Card Reader Controller Hard Drive Controller from a Western Digital HDD	Realtek RTS5111 Marvell 88i6745
25			
26	103. Gateway Desktop FX541X	USB Card Reader Controller Audio Processor Controller Hard Drive Controller from a Western Digital HDD	Alcor Micro AU6375 Creative Technology CA20K1 Marvell 88i6745 –TFJ1
27			
28			

	<b>ACCUSED BRANDED PRODUCT</b>	<b>ACCUSED COMPONENT</b>	<b>ACCUSED CHIPSET</b>
104.	Gateway Desktop GM5664	USB Card Reader Controller	Realtek RTS5111
105.	Gateway Desktop GT5670	USB Card Reader Controller Hard Drive Controller from a Western HDD	Realtek RTS5111 Marvell 88i8845C
106.	Gateway Desktop One ZX190	Hard Disk Drive Controller	Western Digital Hard Drive / Marvell 88i6745 –TFJ1
107.	Gateway LCD Monitor HD2200	Display Monitor Controller	Genesis FLI5968H
108.	Gateway Notebook 3610GZ	Ethernet Controller	Broadcom BCM5789
109.	Gateway Notebook C-141X	Bluetooth Processor Hard Drive Controller from a Fujitsu HDD	Broadcom BCM2045 Marvell 88i6737-TFJ1
110.	Gateway Notebook CX200S	Ethernet Controller	Broadcom BCM5789
111.	Gateway Notebook CX200X	Ethernet Controller	Broadcom BCM5789
112.	Gateway Notebook M-151X	Hard Drive Controller from a Western Digital HDD Bluetooth Processor	Marvell 88i6745 Broadcom BCM2045
113.	Gateway Notebook M-6750	Hard Drive Controller from a Western Digital HDD	Marvell 88i6745M
114.	Gateway Notebook M280	Ethernet Controller	Broadcom BCM5789
115.	Gateway Notebook P-172S FX	Hard Drive Controller from a Seagate HDD	LSI100403183
116.	Gateway Notebook S-7200C-1008588	Ethernet Controller	Broadcom BCM5789
117.	Gateway Notebook T-6321	Hard Drive Controller from a Seagate HDD	ST Microelectronics STV504B

The Acer/Gateway product with the chips and components that are alleged to infringe the '890 patent is as follows:

	<b>ACCUSED BRANDED PRODUCT</b>	<b>ACCUSED COMPONENT</b>	<b>ACCUSED CHIPSET</b>
1.	Gateway Server E-9515R	SCSI Controller	LSI53C1030

Your job will be to decide whether claims 1, 6, 7, 9, 10, 11, 13, 14, 15, and 16 of the '336 patent and claims 11, 13, 17 and 19 of the '890 patent have been infringed and whether

1 those claims are invalid. If you decide that any claim of the '336 patent or the '890 patent has  
2 been infringed and is not invalid, you will then need to decide any money damages to be  
3 awarded to TPL and Patriot to compensate it for the infringement.

4 You will also need to make a finding as to whether the infringement was willful. If you  
5 decide that any infringement was willful, that decision should not affect any damage award  
6 you give. I will take willfulness into account later, if needed.

7 You may have heard evidence that Acer/Gateway has its own patent(s) or that TPL  
8 improved on the '336 patent or the '890 patent. While this evidence is relevant to some issues  
9 you will be asked to decide, a party can still infringe even if it has its own patents in the same  
10 area. I will instruct as to what, if any, relevance these facts have to the particular issues in this  
11 case.

12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1 **DEFENDANTS' OBJECTIONS AND ALTERNATIVE INSTRUCTION:**

2 Defendants interpose the same objections and propose the same changes set forth above  
3 with respect to preliminary instruction 2.1.

4

5 **PLAINTIFFS' RESPONSE AND OBJECTIONS TO DEFENDANTS' ALTERNATIVE**  
6 **INSTRUCTION:**

7 Plaintiffs interpose the same response and objections to Defendants' Alternative Instruction  
8 set forth above with respect to preliminary instruction 2.1.

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28

- 1
- 2
- 3
- 4
- 5
- 6
- 7
- 8
- 9
- 10
- 11
- 12
- 13
- 14
- 15
- 16
- 17
- 18
- 19
- 20
- 21
- 22
- 23
- 24
- 25
- 26
- 27
- 28

**1.2 SUMMARY OF CONTENTIONS - FOR HTC [CHALLENGED****INSTRUCTION**

I will now again summarize for you each party's contentions in this case. I will then tell you what each party must prove to win on each of its contentions.

As I previously explained, HTC filed suit in this court seeking a declaration that no valid and enforceable claim of the '336 patent and the '890 patent is infringed by HTC. HTC also argues that claims 1, 6, 7, 9, 10, 11, 13, 14, 15, and 16 of the '336 patent and claims 11, 12, 13, 17 and 19 of the '890 patent are invalid.

TPL filed a counter complaint alleging that HTC infringes the '336 and '890 patents by making, importing, using, selling, and offering for sale products that TPL argues are covered by claims 1, 6, 7, 9, 10, 11, 13, 14, 15, and 16 of the '336 patent and claims 11, 12, 13, 17 and 19 of the '890 patent. TPL also argues that HTC actively induced infringement of these claims of the '336 patent and the '890 patent by others. TPL is seeking money damages. TPL also denies that the claims of the '336 patent and the claims of the '890 patent are invalid. The products that are alleged to infringe are:

No.	Accused Product	'336 patent	'890 patent
1	HTC P3470 [Pharos]	X	X
2	HTC PDA PC MDA/8125/9100 [Wizard] (aka HTC PDA Phone P4300)	X	X
3	HTC PDA Phone 8525 [TYTN]	X	
4	HTC PDA Phone P3300 [Artemis]	X	X
5	HTC PDA Phone P4351	X	X
6	HTC PDA Phone S621 (aka Dash) [Excalibur]	X	X
7	HTC PDA Phone S630 [Cava 100 Cavalier]		
8	HTC S720/5800 [Libra]	X	X
9	HTC Shift X9000 [Atlantis]	X	X
10	HTC Smartphone Aria		X
11	HTC Smartphone Desire	X	

No.	Accused Product	'336 patent	'890 patent
12	HTC Smartphone EVO 4G	X	
13	HTC Smartphone EVO Shift 4G	X	
14	HTC Smartphone G2	X	
15	HTC Smartphone HD7	X	
16	HTC Smartphone Inspire 4G	X	
17	HTC Smartphone myTouch 4G	X	
18	HTC Smartphone S640 [Iris]	X	X
19	HTC Smartphone Surround	X	
20	HTC Smartphone ThunderBolt	X	
21	HTC Smartphone Wildfire	X	
22	HTC SPV C500/SMT5600/Ontario [Typhoon]	X	X
23	HTC T-Mobile G1 [Dream]	X	X
24	HTC T-Mobile Shadow [Phoebus]	X	X
25	HTC Touch Diamond [Diamond]	X	X
26	HTC Touch Dual [Neon]	X	X
27	HTC Touch Phone Fuze (AT&T)	X	X
28	Mobile Phone 2125 (aka Faraday, Tornado)	X	X
29	Mobile Phone 3125	X	X
30	Mobile Phone S730	X	X
31	Mobile Phone Tilt (aka TyTN II) [Kaiser]	X	X
32	Mobile Phone XV6800 (aka HTC PDA Phone P4000)	X	X
33	PDA Phone P3600	X	
34	PDA Phone S710	X	X
35	PPC-6800 [Mogul, Titan]	X	X
36	Touch Phone P3450	X	X
37	Touch Phone P3650	X	X



No.	Accused Product	'336 patent	'890 patent
38	HTC Mobile Phone Mteor <sup>5</sup>	X	

1  
 2  
 3 Your job will be to decide whether claims 1, 6, 7, 9, 10, 11, 13, 14, 15, and 16 of the  
 4 '336 patent and claims 11, 12, 13, 17 and 19 of the '890 patent have been infringed and  
 5 whether those claims are invalid. If you decide that any claim of the '336 patent and the '890  
 6 patent has been infringed and is not invalid, you will then need to decide any money damages  
 7 to be awarded to TPL to compensate it for the infringement. You will also need to make a  
 8 finding as to whether the infringement was willful. If you decide that any infringement was  
 9 willful, that decision should not affect any damage award you give. I will take willfulness into  
 10 account later.

11 You may have heard evidence that HTC has its own patent(s) or that TPL improved on  
 12 the '336 patent or the '890 patent. While this evidence is relevant to some issues you will be  
 13 asked to decide, a party can still infringe even if it has its own patents in the same area. I will  
 14 instruct as to what, if any, relevance these facts have to the particular issues in this case.

15  
 16  
 17  
 18  
 19  
 20  
 21  
 22  
 23  
 24  
 25  
 26 <sup>5</sup> Mteor (and other HTC products) was excluded from this case on September 10, 2010 when the  
 27 Court denied TPL's motion to amend its infringement contentions, which sought to add Mteor  
 28 as infringing the '749 patent. (See Docket No. 184). TPL then tried to add Mteor as infringing  
 the '336 patent in its Supplemental and Amended Infringement Contentions served on June 4,  
 2013, but mistakenly dated January 16, 2013.

1 Authorities

2 N.D. Cal. Model Patent Jury Instruction § 3.

3

4

5

6

7

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28

1 **DEFENDANTS' OBJECTIONS AND ALTERNATIVE INSTRUCTION:**

2 Defendants interpose the same objections and propose the same changes set forth above  
3 with respect to preliminary instruction 2.2.

4

5 **PLAINTIFFS' RESPONSE AND OBJECTIONS TO DEFENDANTS' ALTERNATIVE**  
6 **INSTRUCTION:**

7 Plaintiffs' interpose the same objections and propose the same changes set forth above  
8 with respect to Preliminary Instruction 2.2.

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28

1           **2.        INTERPRETATION OF CLAIMS [CHALLENGED INSTRUCTION]**

2            Before you decide whether the claims of the patent are invalid or whether Acer,  
3 Gateway or HTC has infringed the claims of the patent, you will need to understand the patent  
4 claims. As I mentioned, the patent claims are numbered sentences at the end of the patent that  
5 describe the boundaries of the patent’s protection. It is my job as judge to explain to you the  
6 meaning of any language in the claims that needs interpretation.

7            I have interpreted the meaning of some of the language in the patent claims involved in  
8 this case. You must accept those interpretations as correct. My interpretation of the language  
9 should not be taken as an indication that I have a view regarding the issues of infringement and  
10 invalidity. The decisions regarding infringement and invalidity are yours to make.

11           The Parties have agreed to or the Court has interpreted the following terms in the  
12 claims at issue. Any terms not construed below should be interpreted according to their plain  
13 and ordinary meaning.

14           **U.S. Patent Number 5,809,336**

15           1.        The term “central processing unit” means “an electronic circuit on an integrated  
16 circuit that controls the interpretation and execution of programmed instructions.”

17           2.        The term “a variable frequency dependent upon variation in one or more  
18 fabrication or operational parameters associated with said integrated circuit substrate” means  
19 “[c]apable of operating at different frequencies as a function of changes in at least one  
20 fabrication or operational parameter associated with the integrated circuit substrate.”

21           3.        The term “oscillator” means “[a] circuit capable of maintaining an alternating  
22 output.”

23           4.        The term “on-chip input/output interface” means “[a] circuit having logic for  
24 input/output communications, where that circuit is located on the same semiconductor  
25 substrate as the CPU.”

26           5.        The term “integrated circuit” means “[a] miniature circuit on a single  
27 semiconductor substrate.”

28

1           6.       The term “microprocessor” means “[a]n electronic circuit that interprets and  
2 executes programmed instructions.”

3           7.       The term “variable speed” means “capable of operating at different speeds.”

4           8.       The term “oscillator . . . clocking” means “an oscillator that generates the  
5 signal(s) used for timing the operation of the CPU.”

6           9.       The term “processing frequency” means “[t]he speed at which the CPU  
7 operates.”

8           10.      The terms “varying together; vary together; varying in the same way; varying . .  
9 . in the same way” mean “[i]ncreasing and decreasing proportionally.”

10          11.      The term “second clock independent of said ring oscillator . . . system clock”  
11 means “[a] second clock wherein a change in the frequency of either the second clock or ring  
12 oscillator system clock does not affect the frequency of the other.”

13          12.      The term “external clock is operative at a frequency independent of a clock  
14 frequency of said oscillator” means “an external clock wherein a change in the frequency of  
15 either the external clock or oscillator does not affect the frequency of the other.”

16          13.      The term “external clock is operative at a frequency independent of a clock  
17 frequency of said variable speed clock” means “an external clock wherein a change in the  
18 frequency of either the external clock or on-chip variable speed clock does not affect the  
19 frequency of the other.”

20          14.      The term “external memory bus” means “[a] group of conductors coupled  
21 between the I/O interface and an external storage device.”

22          15.      The term “Off-chip external clock” means “[a] clock not on the integrated  
23 circuit substrate.”

24          16.      The term “system clock” means “[a] circuit that generates the signal(s) used for  
25 timing the operation of the CPU.”

26          17.      The term “external clock is operative at a frequency independent of a clock  
27 frequency of said oscillator” means “[a]n external clock wherein a change in the frequency of  
28

1 either the external clock or oscillator does not affect the frequency of the other.”

2 18. The term “Track” means “[i]ncreasing and decreasing proportionally.”

3 19. The term “variable frequency” means “a frequency capable of varying.”

4 20. The term “processing frequency capability” means “[t]he speeds at which the  
5 CPU can operate.”

6 21. The term “clocking said central processing unit” means “providing a timing  
7 signal to said central processing unit.”

8 22. The term “providing an entire variable speed clock disposed upon said  
9 integrated circuit substrate” means “[p]roviding a variable speed clock that is located entirely  
10 on the same semiconductor substrate as the central processing unit.”

11 23. The term “wherein said central processing unit operates asynchronously to said  
12 input/output interface” means “the timing control of the central processing unit operates  
13 independently of and is not derived from the timing control of the input/output interface such  
14 that there is no readily predictable phase relationship between them.”

15 24. The term “ring oscillator” means “an oscillator having a multiple, odd number  
16 of inversions arranged in a loop, wherein the oscillator is variable based on the temperature,  
17 voltage and process parameters in the environment.”

18 25. The term “supply the multiple sequential instructions” means “provide the  
19 multiple sequential instructions in parallel (as opposed to one-by-one) to said central  
20 processing unit integrated circuit during a single memory cycle.”

21 26. The term “clocking said CPU” means “[p]roviding a timing signal to said  
22 central processing unit.”

23 27. The Court has also found that a person of ordinary skill in the art reading the  
24 patent would understand that the phrase “as a function of” is describing a variable that depends  
25 on and varies with another, though not necessarily in an exact mathematical type functional  
26 relationship.

1 **U.S. Patent Number 5,530,890**

2 1. The term “mode register” means “register that stores mode bits.”

3 2. The term “return stack pointer” means “[a] storage element in the main central  
4 processing unit, separate and distinct from the stack pointer, that stores a value representing a  
5 location in the return push down stack.”

6 3. The term “loop counter” means “[a] counter circuit in the main CPU that stores  
7 a variable value representing a remaining number of times a particular instruction or group of  
8 instructions is to be executed by the main CPU.”

9 4. The term “separate direct memory access central processing unit” means “a  
10 central processing unit that accesses memory and that fetches and executes instructions directly  
11 and separately of the main central processing unit.”

12 5. The term “instruction register” means “[r]egister that receives and holds one or  
13 more instructions for supplying to circuits that interpret the instructions.”

14 6. The term “push down stack” means “a last-in-first-out data storage element.”  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 2.1, which cites *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384-391 (1996); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1324 (Fed. Cir. 2005); *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1304-13 (Fed. Cir. 1999); *Cybor Corp. v. FAS Techs.*, 138 F.3d 1448 (Fed. Cir. 1998) (*en banc*); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 977 (Fed. Cir. 1995) (*en banc*).



1 **DEFENDANTS' OBJECTIONS AND ALTERNATIVE INSTRUCTION:**

2 Defendants propose an instruction that is substantially similar to Plaintiffs' proposed  
3 instruction. Defendants' proposed changes/objections are as follows:

- 4 • Defendants object to the reversal in order of validity and infringement in the first  
5 paragraph of the instruction. As reflected in the joint pre-trial statement, the parties  
6 have agreed to re-order the presentation of evidence so that Defendants' infringement  
7 case is tried first. The jury instructions should reflect the agreed-upon order to avoid  
8 confusion.
- 9 • Construction No. 27 in Plaintiffs' '336 section is incomplete pursuant to the Courts'  
10 June 12, 2012 Markman Order at 18:15-17. It is corrected below.

11 **2. INTERPRETATION OF CLAIMS [DEFENDANTS' ALTERNATIVE**  
12 **INSTRUCTION]**

13 Before you decide whether Acer, Gateway or HTC has infringed the claims of the  
14 patents, or whether the claims of the patents are invalid, you will need to understand the patent  
15 claims. As I mentioned, the patent claims are numbered sentences at the end of the patent that  
16 describe the boundaries of the patent's protection. It is my job as judge to explain to you the  
17 meaning of any language in the claims that needs interpretation.

18 I have interpreted the meaning of some of the language in the patent claims involved in  
19 this case. You must accept those interpretations as correct. My interpretation of the language  
20 should not be taken as an indication that I have a view regarding the issues of infringement and  
21 invalidity. The decisions regarding infringement and invalidity are yours to make.

22 The Parties have agreed to or the Court has interpreted the following terms in the  
23 claims at issue. Any terms not construed below should be interpreted according to their plain  
24 and ordinary meaning.

25 **U.S. Patent Number 5,809,336**

26 1. The term "central processing unit" means "an electronic circuit on an integrated  
27 circuit that controls the interpretation and execution of programmed instructions."  
28

1           2.       The term “a variable frequency dependent upon variation in one or more  
2 fabrication or operational parameters associated with said integrated circuit substrate” means  
3 “[c]apable of operating at different frequencies as a function of changes in at least one  
4 fabrication or operational parameter associated with the integrated circuit substrate.”

5           3.       The term “oscillator” means “[a] circuit capable of maintaining an alternating  
6 output.”

7           4.       The term “on-chip input/output interface” means “[a] circuit having logic for  
8 input/output communications, where that circuit is located on the same semiconductor  
9 substrate as the CPU.”

10          5.       The term “integrated circuit” means “[a] miniature circuit on a single  
11 semiconductor substrate.”

12          6.       The term “microprocessor” means “[a]n electronic circuit that interprets and  
13 executes programmed instructions.”

14          7.       The term “variable speed” means “capable of operating at different speeds.”

15          8.       The term “oscillator . . . clocking” means “an oscillator that generates the  
16 signal(s) used for timing the operation of the CPU.”

17          9.       The term “processing frequency” means “[t]he speed at which the CPU  
18 operates.”

19          10.       The terms “varying together; vary together; varying in the same way; varying . .  
20 . in the same way” mean “[i]ncreasing and decreasing proportionally.”

21          11.       The term “second clock independent of said ring oscillator . . . system clock”  
22 means “[a] second clock wherein a change in the frequency of either the second clock or ring  
23 oscillator system clock does not affect the frequency of the other.”

24          12.       The term “external clock is operative at a frequency independent of a clock  
25 frequency of said oscillator” means “an external clock wherein a change in the frequency of  
26 either the external clock or oscillator does not affect the frequency of the other.”  
27  
28

1           13.    The term “external clock is operative at a frequency independent of a clock  
2 frequency of said variable speed clock” means “an external clock wherein a change in the  
3 frequency of either the external clock or on-chip variable speed clock does not affect the  
4 frequency of the other.”

5           14.    The term “external memory bus” means “[a] group of conductors coupled  
6 between the I/O interface and an external storage device.”

7           15.    The term “Off-chip external clock” means “[a] clock not on the integrated  
8 circuit substrate.”

9           16.    The term “system clock” means “[a] circuit that generates the signal(s) used for  
10 timing the operation of the CPU.”

11          17.    The term “external clock is operative at a frequency independent of a clock  
12 frequency of said oscillator” means “[a]n external clock wherein a change in the frequency of  
13 either the external clock or oscillator does not affect the frequency of the other.”

14          18.    The term “Track” means “[i]ncreasing and decreasing proportionally.”

15          19.    The term “variable frequency” means “a frequency capable of varying.”

16          20.    The term “processing frequency capability” means “[t]he speeds at which the  
17 CPU can operate.”

18          21.    The term “clocking said central processing unit” means “providing a timing  
19 signal to said central processing unit.”

20          22.    The term “providing an entire variable speed clock disposed upon said  
21 integrated circuit substrate” means “[p]roviding a variable speed clock that is located entirely  
22 on the same semiconductor substrate as the central processing unit.”

23          23.    The term “wherein said central processing unit operates asynchronously to said  
24 input/output interface” means “the timing control of the central processing unit operates  
25 independently of and is not derived from the timing control of the input/output interface such  
26 that there is no readily predictable phase relationship between them.”

27          24.    The term “ring oscillator” means “an oscillator having a multiple, odd number  
28

1 of inversions arranged in a loop, wherein the oscillator is variable based on the temperature,  
2 voltage and process parameters in the environment.”

3 25. The term “supply the multiple sequential instructions” means “provide the  
4 multiple sequential instructions in parallel (as opposed to one-by-one) to said central  
5 processing unit integrated circuit during a single memory cycle.”

6 26. The term “clocking said CPU” means “[p]roviding a timing signal to said  
7 central processing unit.”

8 27. The Court has also found that a person of ordinary skill in the art reading the  
9 patent would understand that the phrase “as a function of” is describing a variable that depends  
10 on and varies with another. The term should not be limited to a narrower definition of an exact  
11 mathematical type functional relationship.

12 **U.S. Patent Number 5,530,890**

13 1. The term “mode register” means “register that stores mode bits.”

14 2. The term “return stack pointer” means “[a] storage element in the main central  
15 processing unit, separate and distinct from the stack pointer, that stores a value representing a  
16 location in the return push down stack.”

17 3. The term “loop counter” means “[a] counter circuit in the main CPU that stores  
18 a variable value representing a remaining number of times a particular instruction or group of  
19 instructions is to be executed by the main CPU.”

20 4. The term “separate direct memory access central processing unit” means “a  
21 central processing unit that accesses memory and that fetches and executes instructions directly  
22 and separately of the main central processing unit.”

23 5. The term “instruction register” means “[r]egister that receives and holds one or  
24 more instructions for supplying to circuits that interpret the instructions.”

25 6. The term “push down stack” means “a last-in-first-out data storage element.”  
26  
27  
28

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 2.1, which cites *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384-391 (1996); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1324 (Fed. Cir. 2005); *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1304-13 (Fed. Cir. 1999); *Cybor Corp. v. FAS Techs.*, 138 F.3d 1448 (Fed. Cir. 1998) (*en banc*); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 977 (Fed. Cir. 1995) (*en banc*).

1 **PLAINTIFFS’ RESPONSE AND OBJECTIONS TO DEFENDANTS’ ALTERNATIVE**  
2 **INSTRUCTION:**

3 Defendants’ objections have no merit.

4 **Construction No. 27: “as a function of”**

5 Defendants provide lines 12 to 18 of the Court’s June 12, 2012 Markman Order  
6 regarding the “as a function of” construction for context:

7 The disputed issue is whether the phrase requires a mathematical type  
8 predetermined functional relationship. Upon review, the Court finds that a person  
9 of ordinary skill in the art reading the patent would understand that the phrase “as  
10 a function of” is describing a variable that depends on and varies with another.  
11 Because neither the written description nor the prosecution history provide a basis  
12 for concluding that the phrase should be limited to a narrower definition of an  
13 exact mathematical type functional relationship, the Court declines to do so.  
14 Having resolved the only dispute tendered with respect to this phrase, the Court  
15 declines to construe it further.

16 *See id.*, Dkt. No. 367, at 18.

1       **3.       INFRINGEMENT – BURDEN OF PROOF [CHALLENGED INSTRUCTION]**

2           I will now instruct you on the rules you must follow in deciding whether TPL has  
3 proven that Acer, Gateway and/or HTC has infringed one or more of the asserted claims of the  
4 '336 patent, and one or more of the asserted claims of the '890 patent. To prove infringement  
5 of any claim, TPL must persuade you that it is more likely than not that Acer, Gateway and  
6 HTC have infringed that claim. In other words, TPL has the burden of proving patent  
7 infringement by what is called a preponderance of the evidence. That means TPL has to  
8 produce evidence which, when considered in light of all of the facts, leads you to believe that  
9 what TPL claims is more likely true than not.

10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 3.1, which cites *Warner-Lambert Co. v. Teva Pharm. USA, Inc.*, 418 F.3d 1326, 1341 n.15 (Fed. Cir. 2005); *Seal-Flex, Inc. v. Athletic Track and Court Constr.*, 172 F.3d 836, 842 (Fed. Cir. 1999); *Morton Int’l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1468-69 (Fed. Cir. 1993).



1 **DEFENDANTS' OBJECTIONS AND ALTERNATIVE INSTRUCTION:**

2 Plaintiffs' proposed instruction departs significantly from the Northern District model  
3 instruction. By addressing Defendants' burden of proof multiple times in the same instruction,  
4 Plaintiff's proposed instruction would create confusion in the minds of the jurors regarding the  
5 correct standard. This evidenced by the fact that Plaintiffs to not address their own burden of  
6 proof on invalidity multiple times. In addition, with Plaintiffs' additions, the instruction would  
7 be duplicative of and/or contradictory to the Court's standard closing instruction, which  
8 presumably address the meaning of the various standards of proof at issue in the case.

9 Defendants' propose using the Northern District's model instruction.

10 **3. INFRINGEMENT – BURDEN OF PROOF DEFENDANTS' ALTERNATIVE**  
11 **INSTRUCTION**

12 I will now instruct you on the rules you must follow in deciding whether TPL and Patriot  
13 have proven that Acer, Gateway and/or HTC have infringed one or more of the asserted claims 1,  
14 6, 7, 9, 10, 11, 13, 14, 15, and 16 of the '336 patent, and claims 11, 12, 13, 17 and 19 of the '890  
15 patent (Acer/Gateway is not accused of infringing claim 12 of the '890 patent). To prove  
16 infringement of any claim, TPL and Patriot must persuade you that it is more likely than not that  
17 Acer/Gateway and/or HTC has infringed that claim.  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**Authorities**

N.D. Cal. Model Patent Jury Instruction § 3.1, which cites *Warner-Lambert Co. v. Teva Pharm. USA, Inc.*, 418 F.3d 1326, 1341 n.15 (Fed. Cir. 2005); *Seal-Flex, Inc. v. Athletic Track and Court Constr.*, 172 F.3d 836, 842 (Fed. Cir. 1999); *Morton Int’l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1468-69 (Fed. Cir. 1993).

1 **PLAINTIFFS' RESPONSE AND OBJECTIONS TO DEFENDANTS' ALTERNATIVE**  
2 **INSTRUCTION:**

3 Defendant's alternative instruction is misleading and incorrect. First, TPL fails to  
4 separate Acer and Gateway. Since Defendants have accused products that were sold by  
5 Gateway prior to its merger with Acer, Defendants must prove infringement separately.  
6 Second, this instruction incorrectly suggests that Acer and Gateway are being accused of  
7 infringing claim 12 of the '890 patent. This is reflected in other instructions. As a result  
8 TPL's alternative instruction will create jury confusion.

9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1           **4.       DIRECT INFRINGEMENT [CHALLENGED INSTRUCTION]**

2           A patent’s claims define what is covered by the patent. A product directly infringes a  
3 patent if it is covered by at least one claim of the patent.

4           Deciding whether a claim has been directly infringed is a two-step process. The first  
5 step is to decide the meaning of the patent claim. I have already made this decision, and I have  
6 already instructed you as to the meaning of the asserted patent claims. The second step is to  
7 decide whether Acer, Gateway or HTC have made, used, sold, offered for sale or imported  
8 within the United States a product, or as in this case, a product containing an accused chip that  
9 is covered by a claim of the ’336 patent or the ’890 patent. If either has, it infringes. You, the  
10 jury, make this decision.

11           With one exception, you must consider each of the asserted claims of the patent  
12 individually, and decide whether the accused Acer, Gateway and HTC products infringe that  
13 claim. The one exception to considering claims individually concerns dependent claims. A  
14 dependent claim includes all of the requirements of a particular independent claim, plus  
15 additional requirements of its own. As a result, if you find that an independent claim is not  
16 infringed, you must also find that its dependent claims are not infringed. On the other hand, if  
17 you find that an independent claim has been infringed, you must still separately decide whether  
18 the additional requirements of its dependent claims have also been infringed.

19           Whether Acer, Gateway and HTC knew their respective products infringed or even  
20 knew of the patent does not matter in determining direct infringement. The following  
21 instructions will provide more detail on direct infringement. You should note, however, that  
22 what are called “means-plus-function” requirements in a claim are subject to different rules for  
23 deciding direct infringement. These separate rules apply to claim 12 of the ’890 patent with  
24 respect to HTC, and 13 of the ’890 patent with respect to both Acer/Gateway and HTC. I will  
25 describe these separate rules shortly.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 3.2, which cites 35 U.S.C. § 271; *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17 (1997); *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1310-11 (Fed. Cir. 2005); *DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314, 1330-34 (Fed. Cir. 2001); *Seal-Flex, Inc. v. Athletic Track and Court Constr.*, 172 F.3d 836, 842 (Fed. Cir. 1999); *Carroll Touch, Inc. v. Electro Mech. Sys., Inc.*, 15 F.3d 1573, 1576 (Fed. Cir. 1993).

1 **DEFENDANTS' OBJECTIONS AND ALTERNATIVE INSTRUCTION:**

2 Defendants propose an instruction that is substantially similar to Plaintiffs' proposed  
3 instruction. The only difference is that Defendants' alternative instruction omits the words "or  
4 as in this case, a product containing an accused chip." Defendants object to this language  
5 because it is inaccurate. Defendants accuse Acer/Gateway and HTC products, not merely  
6 chips. In addition, as Acer/Gateway confirmed to the Court at the August 13, 2013 hearing,  
7 Defendants and Acer/Gateway have stipulated to representative products with respect to the  
8 '336 patent. Acer/Gateway's reference to chips runs counter to the stipulation.

9  
10 **4. DIRECT INFRINGEMENT [DEFENDANTS' ALTERNATIVE INSTRUCTION]**

11 A patent's claims define what is covered by the patent. A product directly infringes a  
12 patent if it is covered by at least one claim of the patent.

13 Deciding whether a claim has been directly infringed is a two-step process. The first  
14 step is to decide the meaning of the patent claim. I have already made this decision, and I have  
15 already instructed you as to the meaning of the asserted patent claims. The second step is to  
16 decide whether Acer, Gateway or HTC have made, used, sold, offered for sale or imported  
17 within the United States a product that is covered by a claim of the '336 patent or the '890  
18 patent. If either has, it infringes. You, the jury, make this decision.

19 With one exception, you must consider each of the asserted claims of the patent  
20 individually, and decide whether the accused Acer, Gateway and HTC products infringe that  
21 claim. The one exception to considering claims individually concerns dependent claims. A  
22 dependent claim includes all of the requirements of a particular independent claim, plus  
23 additional requirements of its own. As a result, if you find that an independent claim is not  
24 infringed, you must also find that its dependent claims are not infringed. On the other hand, if  
25 you find that an independent claim has been infringed, you must still separately decide whether  
26 the additional requirements of its dependent claims have also been infringed.

27 Whether Acer, Gateway and HTC knew their respective products infringed or even  
28

1 knew of the patent does not matter in determining direct infringement. The following  
2 instructions will provide more detail on direct infringement. You should note, however, that  
3 what are called “means-plus-function” requirements in a claim are subject to different rules for  
4 deciding direct infringement. These separate rules apply to claim 12 of the ‘890 patent with  
5 respect to HTC, and 13 of the ‘890 patent with respect to both Acer/Gateway and HTC. I will  
6 describe these separate rules shortly.

7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 3.2, which cites 35 U.S.C. § 271; *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17 (1997); *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1310-11 (Fed. Cir. 2005); *DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314, 1330-34 (Fed. Cir. 2001); *Seal-Flex, Inc. v. Athletic Track and Court Constr.*, 172 F.3d 836, 842 (Fed. Cir. 1999); *Carroll Touch, Inc. v. Electro Mech. Sys., Inc.*, 15 F.3d 1573, 1576 (Fed. Cir. 1993).



1 **PLAINTIFFS' RESPONSE AND OBJECTIONS TO DEFENDANTS' ALTERNATIVE**  
2 **INSTRUCTION:**

3 The inclusion of the language "or as in this case, a product containing an accused chip"  
4 is necessary for several reasons. First, it is consistent with the agreed upon chart showing the  
5 accused Acer/Gateway products, components, and chips.

6 Second, as detailed in Plaintiffs' *Daubert* motions, TPL improperly seeks to rely upon  
7 the entire market value rule without showing that the smallest saleable unit, the accused chips,  
8 primarily drives consumer demand for the entire end-products. As there is no dispute that the  
9 accused products contain multiple non-accused features and components, the teachings of  
10 *LaserDynamics, Inc. v. Quanta Computer, Inc.*, 694 F.3d 51 (Fed. Cir. 2012) are applicable  
11 here and should be incorporated in this instruction.

12 Third, TPL mischaracterizes the stipulation between the parties. This is not a  
13 stipulation to a representative product. Rather, the parties merely agreed to a common  
14 functionality in the accused Hard Disk Drives (HDDs) *only as applied to the accused*  
15 *Acer/Gateway products where TPL specifically identified and accused an HDD*. The  
16 stipulation between Acer/Gateway does not apply to products where TPL has accused other  
17 chips and components such as Bluetooth and Ethernet controllers. *See* Dkt. No. 507 at  
18 Appendix A (accused product list showing that 23 of the 39 products do not have an accused  
19 HDD) and Appendix C (stipulation). TPL's characterization of the stipulation violates the  
20 Court's prior order denying TPL's attempt to amend its infringement contentions to include  
21 additional products and components not previously accused.

22 Finally, the stipulation also does not apply to damages where TPL still has the burden  
23 to show that the accused products contain an infringing component and to eliminate the ones  
24 that contain non-infringing or licensed from its damages calculations. *See Power Integrations,*  
25 *Inc. v. Fairchild Semiconductor Int'l, Inc.*, 711 F.3d 1348, 1373-74 (Fed. Cir. 2013); *IP*  
26 *Innovation L.L.C. v. Red Hat, Inc.*, 705 F. Supp.2d 687, 689-90 (E.D. Tex. 2010).

1           **5.       LITERAL INFRINGEMENT [CHALLENGED INSTRUCTION]**

2           To decide whether an Acer, Gateway or HTC product, or as in this case, a product  
3 containing an accused chip literally infringes a claim of the '336 patent or the '890 patent, you  
4 must compare that product with the patent claim and determine whether every requirement of  
5 the claim is included in that product. If so, that product literally infringes that claim. If,  
6 however, that product does not have every requirement or element of the patent claim, the  
7 product does not literally infringe that claim. You must decide literal infringement for each  
8 asserted claim separately and each of the accused Acer, Gateway and HTC products should be  
9 separately compared to the invention described in each patent claim they are alleged to  
10 infringe.

11           If the patent claim uses the term “comprising,” that patent claim is to be understood as  
12 an open claim. An open claim is infringed as long as every requirement in the claim is present  
13 in an accused Acer, Gateway or HTC product. The fact that an Acer or Gateway computer  
14 product or HTC mobile phone also includes other parts will not avoid infringement, as long as  
15 it has every requirement in the patent claim.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 3.3, which cites, *MicroStrategy Inc. v. Business Objects, S.A.*, 429 F.3d 1344, 1352-53 (Fed. Cir. 2005); *Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1353 (Fed. Cir. 2001); *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 532 (Fed. Cir. 1996); *Ecolab, Inc. v. FMC Corp.*, 535 F.3d 1369 (Fed. Cir. 2009); *Cross Med. Prods. v. Medtronic Sofamor Danek*, 424 F.3d 1293 (Fed. Cir. 2005); *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373 (Fed. Cir. 2007).

1 **DEFENDANTS' OBJECTIONS AND ALTERNATIVE INSTRUCTION:**

2 Defendants propose an instruction that is substantially similar to Plaintiffs' proposed  
3 instruction. The only difference is that Defendants' alternative instruction omits the words "or  
4 as in this case, a product containing an accused chip." Defendants object to this language  
5 because it is inaccurate. Defendants accuse Acer/Gateway and HTC products, not merely  
6 chips. In addition, as Acer/Gateway confirmed to the Court at the August 13, 2013 hearing,  
7 Defendants and Acer/Gateway have stipulated to representative products with respect to the  
8 '336 patent. Acer/Gateway's reference to chips runs counter to the stipulation.

9  
10 **5. LITERAL INFRINGEMENT DEFENDANTS' ALTERNATIVE**  
11 **INSTRUCTION**

12 To decide whether an Acer, Gateway or HTC product literally infringes a claim of the  
13 '336 patent or the '890 patent, you must compare that product with the patent claim and  
14 determine whether every requirement of the claim is included in that product. If so, that  
15 product literally infringes that claim. If, however, that product does not have every  
16 requirement or element of the patent claim, the product does not literally infringe that claim.  
17 You must decide literal infringement for each asserted claim separately and each of the  
18 accused Acer, Gateway and HTC products should be separately compared to the invention  
19 described in each patent claim they are alleged to infringe.

20 If the patent claim uses the term "comprising," that patent claim is to be understood as  
21 an open claim. An open claim is infringed as long as every requirement in the claim is present  
22 in an accused Acer, Gateway or HTC product. The fact that an Acer or Gateway computer  
23 product or HTC mobile phone also includes other parts will not avoid infringement, as long as  
24 it has every requirement in the patent claim.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 3.3, which cites, *MicroStrategy Inc. v. Business Objects, S.A.*, 429 F.3d 1344, 1352-53 (Fed. Cir. 2005); *Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1353 (Fed. Cir. 2001); *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 532 (Fed. Cir. 1996); *Ecolab, Inc. v. FMC Corp.*, 535 F.3d 1369 (Fed. Cir. 2009); *Cross Med. Prods. v. Medtronic Sofamor Danek*, 424 F.3d 1293 (Fed. Cir. 2005); *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373 (Fed. Cir. 2007).

1 **PLAINTIFFS' RESPONSE AND OBJECTIONS TO DEFENDANTS' ALTERNATIVE**  
2 **INSTRUCTION:**

3 The inclusion of the language "or as in this case, a product containing an accused chip"  
4 is necessary for several reasons. First, it is consistent with the agreed upon chart showing the  
5 accused Acer/Gateway products, components, and chips.

6 Second, as detailed in Plaintiffs' *Daubert* motions, TPL improperly seeks to rely upon  
7 the entire market value rule without showing that the smallest saleable unit, the accused chips,  
8 primarily drives consumer demand for the entire end-products. As there is no dispute that the  
9 accused products contain multiple non-accused features and components, the teachings of  
10 *LaserDynamics, Inc. v. Quanta Computer, Inc.*, 694 F.3d 51 (Fed. Cir. 2012) are applicable  
11 here and should be incorporated in this instruction.

12 Third, TPL mischaracterizes the stipulation between the parties. This is not a  
13 stipulation to a representative product. Rather, the parties merely agreed to a common  
14 functionality in the accused Hard Disk Drives (HDDs) *only as applied to the accused*  
15 *Acer/Gateway products where TPL specifically identified and accused an HDD*. The  
16 stipulation between Acer/Gateway does not apply to products where TPL has accused other  
17 chips and components such as Bluetooth and Ethernet controllers. *See* Dkt. No. 507 at  
18 Appendix A (accused product list showing that 23 of the 39 products do not have an accused  
19 HDD) and Appendix C (stipulation). TPL's characterization of the stipulation violates the  
20 Court's prior order denying TPL's attempt to amend its infringement contentions to include  
21 additional products and components not previously accused.

22 Finally, the stipulation also does not apply to damages where TPL still has the burden  
23 to show that the accused products contain an infringing component and to eliminate the ones  
24 that contain non-infringing or licensed from its damages calculations. *See Power Integrations,*  
25 *Inc. v. Fairchild Semiconductor Int'l, Inc.*, 711 F.3d 1348, 1373-74 (Fed. Cir. 2013); *IP*  
26 *Innovation L.L.C. v. Red Hat, Inc.*, 705 F. Supp.2d 687, 689-90 (E.D. Tex. 2010).

**6. MEANS-PLUS-FUNCTION CLAIMS – LITERAL INFRINGEMENT****[CHALLENGED INSTRUCTION]**

I will now describe the separate rules that apply to “means-plus-function” requirements that are used in some claims. Claims 12 and 13 of the ’890 patent contain “means-plus-function” requirements. A means-plus-function requirement only covers the specific structures disclosed in a patent specification for performing the claimed function and the equivalents of those specific structures that perform the claimed function. A means-plus-function requirement does not cover all possible structures that could be used to perform the claimed function.

As an example, the term “means for processing data” might be understood to encompass a variety of different ways of making a calculation, including not only a computer or calculator but a pencil and paper or even the human brain. But because the phrase is a means-plus-function requirement, we interpret that phrase not to cover every possible means for processing data, but instead to cover the actual means disclosed in the patent for processing data and other means that are equivalent to it.

For purposes of this trial, I have interpreted each means-plus-function requirement for you and identified the structure in the patent specification that corresponds to these means-plus-function requirements. Specifically, I have determined that:

**[If for HTC]****Claim 12 (Only as to HTC)**

The function is “being connected and configured to provide row addresses, column addresses and data on said address/data bus.”

The structure is:

(1) MUX 378 connected to MUX 382 through MUXED ADDRESS BUS 380;

(2) MUX 378 connected to the unnumbered MUX between MUX 378 and MUX 382 via the two unnumbered MUXED ADDRESS BUSES (labelled “A23 – A13” and “A12 – A2,” respectively) between MUX 378 and such unnumbered MUX;

(3) MUX 382 connected to the unnumbered MUX between MUX 378 and MUX 382 via

1 the two unnumbered MUXED ADDRESS BUSES (labelled “A23 – A13” and “A12 – A2,”  
2 respectively) between MUX 382 and such unnumbered MUX.

3 **[If for TPL]**

4 Claim 12 (Only as to HTC)

5 The function is “being connected and configured to provide row addresses, column  
6 addresses and data on said address/data bus.”

7 The structure is:

8 A MUX (multiplexer), such as those shown in Figure 12 of the ’890 patent.

9 **[If for Acer/Gateway and HTC]**

10 Claim 13 (As to Acer, Gateway and HTC)

11 The function is “being configured to fetch multiple sequential instructions in a single  
12 memory cycle.”

13 The structure is “Memory controller 118 connected to instruction register 108 through  
14 internal data bus 90 and, to program counter 130 through internal address bus 136, and to  
15 Request Instruction Fetch-Ahead 192 via line 196, and Request Instruction Fetch-Ahead 192 is  
16 connected to instruction register 108 via lines 194.”

17 **[If for TPL]**

18 Claim 13 (As to Acer, Gateway and HTC)

19 The function is “fetching instructions for said central processing unit on said address/data  
20 bus.”

21 The structure is MUX 382, as shown in Figure 12.

22 In deciding if TPL has proven that an Acer, Gateway or HTC product includes structure  
23 covered by a means-plus-function requirement, you must first decide whether the product has any  
24 structure that performs the function I just described to you. If not, the claim containing that  
25 means-plus-function requirement is not infringed.

26 If you find that an Acer, Gateway or HTC accused product does have structures that  
27 perform the claimed function, you must then determine whether that structure is the same as or  
28



1 equivalent to the structure I have identified in the specification. If they are the same or  
2 equivalent, the means-plus-function requirement is satisfied by that structure of the accused  
3 products. If all the other requirements of the claim are satisfied, the accused products infringe  
4 the claim.

5 In order to prove that a structure in the accused products is equivalent to the structure in  
6 the '890 patent, TPL must show that a person of ordinary skill in the field would have considered  
7 that the differences between the structure described in the '890 patent and the structure in the  
8 accused products are not substantial. TPL must also show that the structure was available on the  
9 date the '890 patent was granted.

10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

35 U.S.C. § 112(6); *Frank's Casing Crew & Rental Tools, Inc. v. Weatherford Intern., Inc.*, 389 F.3d 1370, 1378 (Fed. Cir. 2004); *Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1266 (Fed. Cir. 1999); *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc.*, 145 F.3d 1303, 1307 (Fed. Cir. 1998); *Micro Chem., Inc. v. Great Plains Chem. Co., Inc.*, 103 F.3d 1538, 1547 (Fed. Cir. 1997); *Valmont Indus., Inc. v. Reinke Mfg. Co., Inc.*, 983 F.2d 1039, 1042 (Fed. Cir. 1993).

**DEFENDANTS' OBJECTIONS AND ALTERNATIVE INSTRUCTION:**

Defendants object to Plaintiffs' recitation of corresponding structure for claims 12 and 13. Defendants also object to Plaintiffs' recitation of the function with respect to claim 13.

With respect to claim 12, Plaintiffs' recitation of structure is too narrow. They identify three separate MUXes. However, both the specification and Figure 12 in no way suggest that more than one MUX is required to provide row addresses, column addresses and data on the address/data bus. This would run counter to the understanding of a person of ordinary skill in the art, who would understand that the very purpose of a MUX is what claimed function. Specifically, it is clear from Figure 12 and column 14, lines 28-49, that each of the MUXes in Figure 12 provide row addresses, column addresses and data on the address/data bus. Stated differently, there is no disclosure of, for example, row addresses being provided by one MUX, column addresses by another and data by another. The arrows in Figure 12 show that each of the three MUXes Plaintiffs have identified provide row address, column addresses *and* data. Thus, the corresponding structure may be a single MUX, like those shown in Figure 12, and should not be limited to all three MUXes.

With respect to claim 13, rather than recite the function itself, Plaintiffs recite the clause following the function, which is descriptive of the function. This omission fails reads significant limitations out of the claim, including that the fetching is "for said central processing unit" and that the fetching is "on said address/data bus." Further, it is unnecessary to recite the clause following the function in claim 13, because the jury can understand its plain meaning.

Plaintiffs simply recite the wrong structure with respect to claim 13. They claim memory controller 118, shown in Figure 2, is the corresponding structure. However, discussion of Figure 2 at the level of memory controller 118 in the specification says nothing about fetching instructions for the CPU. *See* '890 at 6:29-46. Rather, it is Figure 12, which "shows the details of the microprocessor memory controller 118" that reveals the component that actually performs the claimed fetching function. *See id.* at 14:28-29. Figure 12 shows that

1 it is MUX 382, connected to address bus 136 (the same address bus shown in Figure 2) that  
2 performs the claimed fetching function. The specification, confirms that it is MUX 382 that  
3 receives “address and data inputs, respectively.” *See id.* at 14:38-40.

4 Defendants’ alternative instruction differs from Plaintiffs’ only with respect to the  
5 disputed issues of function and corresponding structure discussed above.

## 6 **6. MEANS-PLUS-FUNCTION CLAIMS – LITERAL INFRINGEMENT**

### 7 **DEFENDANTS’ ALTERNATIVE INSTRUCTION**

8 I will now describe the separate rules that apply to “means-plus-function” requirements  
9 that are used in some claims. Claims 12 and 13 of the ’890 patent contain “means-plus-function”  
10 requirements. A means-plus-function requirement only covers the specific structures disclosed  
11 in a patent specification for performing the claimed function and the equivalents of those specific  
12 structures that perform the claimed function. A means-plus-function requirement does not cover  
13 all possible structures that could be used to perform the claimed function.  
14

15 As an example, the term “means for processing data” might be understood to encompass  
16 a variety of different ways of making a calculation, including not only a computer or calculator  
17 but a pencil and paper or even the human brain. But because the phrase is a means-plus-function  
18 requirement, we interpret that phrase not to cover every possible means for processing data, but  
19 instead to cover the actual means disclosed in the patent for processing data and other means that  
20 are equivalent to it.

21 For purposes of this trial, I have interpreted each means-plus-function requirement for  
22 you and identified the structure in the patent specification that corresponds to these means-plus-  
23 function requirements. Specifically, I have determined that:

#### 24 Claim 12 (Only as to HTC)

25 The function is “being connected and configured to provide row addresses, column  
26 addresses and data on said address/data bus.”

27 The structure is:

28 A MUX (multiplexer), such as those shown in Figure 12 of the ’890 patent.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Claim 13 (As to Acer, Gateway and HTC)

The function is “fetching instructions for said central processing unit on said address/data bus.”

The structure is MUX 382, as shown in Figure 12.

In deciding if TPL and Patriot have proven that an Acer, Gateway or HTC product includes structure covered by a means-plus-function requirement, you must first decide whether the product has any structure that performs the function I just described to you. If not, the claim containing that means-plus-function requirement is not infringed.

If you find that an Acer, Gateway or HTC accused product does have structures that perform the claimed function, you must then determine whether that structure is the same as or equivalent to the structure I have identified in the specification. If they are the same or equivalent, the means-plus-function requirement is satisfied by that structure of the accused products. If all the other requirements of the claim are satisfied, the accused products infringe the claim.

In order to prove that a structure in the accused products is equivalent to the structure in the '890 patent, TPL and Patriot must show that a person of ordinary skill in the field would have considered that the differences between the structure described in the '890 patent and the structure in the accused products are not substantial. TPL and Patriot must also show that the structure was available on the date the '890 patent was granted.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

Model Patent Jury Instruction § 3.5; 35 U.S.C. § 112(6); *Frank’s Casing Crew & Rental Tools, Inc. v. Weatherford Intern., Inc.*, 389 F.3d 1370, 1378 (Fed. Cir. 2004); *Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1266 (Fed. Cir. 1999); *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc.*, 145 F.3d 1303, 1307 (Fed. Cir. 1998); *Micro Chem., Inc. v. Great Plains Chem. Co., Inc.*, 103 F.3d 1538, 1547 (Fed. Cir. 1997); *Valmont Indus., Inc. v. Reinke Mfg. Co., Inc.*, 983 F.2d 1039, 1042 (Fed. Cir. 1993).

1 **PLAINTIFFS’ RESPONSE AND OBJECTIONS TO DEFENDANTS’ ALTERNATIVE**  
2 **INSTRUCTION:**

3 Plaintiffs’ disagree with Defendants’ proposed structures and functions for claims 12  
4 and 13 of the ’890 patent. The means-plus-function terms in dependent claims 12 and 13 of  
5 the ’890 patent are disputed terms that have not been construed by the Court. Plaintiffs reserve  
6 all rights to provide briefing on this issue.

7 *[Plaintiffs will agree to withdraw this objection if TPL agrees with Plaintiffs’ revised*  
8 *proposed instruction and withdraws its alternative instruction and objections]*

9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1           **7.       INDUCING PATENT INFRINGEMENT [CHALLENGED INSTRUCTION]**

2           TPL argues that HTC actively induced their customers to infringe the '336 patent and  
3 '890 patent. In order for there to be inducement of infringement by HTC, someone else must  
4 directly infringe a claim of the '336 patent and '890 patent; if there is no direct infringement by  
5 anyone, there can be no induced infringement. In order to be liable for inducement of  
6 infringement, HTC must:

- 7           1. have intentionally taken action that actually induced direct infringement by a third  
8 party;
- 9           2. have been aware of the '336 patent and '890 patent when it intended to cause the  
10 infringing acts by such a third party that directly infringes; and
- 11           3. knew that the actions, if taken, would cause infringement of the '336 patent and '890  
12 patent.

13           The “knowledge” and “awareness” requirements for inducement can be satisfied by  
14 showing that a party was willfully blind. If HTC did not know of the existence of the patent in  
15 question or that the acts it was inducing were infringing, it can be liable for inducement only if  
16 it actually believed that it was highly probable its actions would encourage infringement of a  
17 patent and it took intentional acts to avoid learning the truth.

18           In order to establish active inducement of infringement, however, it is not sufficient that  
19 third parties directly infringed the claim. Nor is it sufficient that HTC were aware of the act or  
20 acts by third parties that allegedly constitute the direct infringement. It is also not enough that  
21 HTC was merely indifferent to the possibility that it might encourage infringement of a patent.  
22 Nor is it enough that HTC took a risk that was substantial and unjustified.

23           If you find that HTC were aware of the patent, but believed that the acts it encouraged  
24 did not infringe that patent, or that the patent was invalid, it cannot be liable for inducement.



1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 3.9, which cites, 35 U.S.C. § 271(b); *Global-Tech Appliances, Inc. v. SEB S.A.*, \_\_\_ U.S. \_\_\_, \_\_\_; 131 S.Ct. 2060, 2068-2071 (2011); *DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293, 1304-06 (Fed. Cir. 2006) (*en banc*) (quoting *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 936 (2005)); *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S.Ct. 2060 (2011); *Broadcom Corp. v. Qualcomm, Inc.*, 543 F.3d 683 (Fed. Cir. 2008); *Apple, Inc. v. Samsung Elecs. Co., Ltd.*, Case No. 11-01846-LHK (N.D. Cal., Aug. 21, 2012).

1 **DEFENDANTS' OBJECTIONS AND ALTERNATIVE INSTRUCTION:**

2 Defendants and HTC originally proposed instructions that followed the model  
3 instruction. Plaintiffs' now propose an instruction that departs from the model instruction by  
4 reformulating the legal standard for inducing infringement. Defendants' object to the new  
5 instruction because it misstates the standard. Defendants' alternative instruction follows the  
6 model instruction.

7  
8 **7. INDUCING PATENT INFRINGEMENT DEFENDANTS' ALTERNATIVE**  
9 **INSTRUCTION**

10 TPL and Patriot argue that HTC has actively induced another to infringe the '336 and  
11 the '890 patents. In order for there to be inducement of infringement by HTC, someone else must  
12 directly infringe a claim of the '336 or the '890 patents; if there is no direct infringement by  
13 anyone, there can be no induced infringement. In order to be liable for inducement of  
14 infringement, HTC must:

- 15 have intentionally taken action that actually induced direct infringement by another;  
16 have been aware of the '336 or the '890 patents; and  
17 have known that the acts it was causing would be infringing.

18 If HTC did not know of the existence of the patent or that the acts it was inducing were  
19 infringing, it cannot be liable for inducement unless it actually believed that it was highly probable its  
20 actions would encourage infringement of a patent and it took intentional acts to avoid learning the  
21 truth. It is not enough that HTC was merely indifferent to the possibility that it might encourage  
22 infringement of a patent. Nor is it enough that HTC took a risk that was substantial and unjustified.

23 If you find that HTC was aware of the patent, but believed that the acts it encouraged did  
24 not infringe that patent, or that the patent was invalid, HTC cannot be liable for inducement.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 3.9, which cites, 35 U.S.C. § 271(b); *Global-Tech Appliances, Inc. v. SEB S.A.*, \_\_\_ U.S. \_\_\_, \_\_\_; 131 S.Ct. 2060, 2068-2071 (2011); *DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293, 1304-06 (Fed. Cir. 2006) (*en banc*) (quoting *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913, 936 (2005)); *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S.Ct. 2060 (2011); *Broadcom Corp. v. Qualcomm, Inc.*, 543 F.3d 683 (Fed. Cir. 2008).

1 **PLAINTIFFS’ RESPONSE AND OBJECTIONS TO DEFENDANTS’ ALTERNATIVE**  
2 **INSTRUCTION:**

3 TPL’s claim that this instruction was not initially proposed is inaccurate as a similar  
4 instruction was included in Acer/Gateway’s proposed instructions served on August 15, 2013.  
5 Plaintiffs’ proposed instruction is based off of this District’s model instruction, with  
6 modifications drawn from the Inducement Instruction used in *Apple, Inc. v. Samsung Elecs.*  
7 *Co., Ltd.*, Case No. 11-01846-LHK (N.D. Cal., Aug. 21, 2012). TPL’s assertion that this  
8 instruction misstates the law is simply untrue. In fact, Plaintiffs’ instruction provides more  
9 guidance to the jury and will reduce the likelihood of jury confusion.

10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1           **8.       WILLFUL INFRINGEMENT [CHALLENGED INSTRUCTION]**

2           In this case, TPL argues that Acer, Gateway and HTC willfully infringed the '336  
3 patent and the '890 patent. The issue of willful infringement is not relevant to your decision of  
4 whether or not there is infringement. If you decide that Acer, Gateway and/or HTC willfully  
5 infringed any of the claims of the '336 patent or the '890 patent, then it is my job to decide  
6 whether or not that willfulness warrants an award of increased damages to TPL. In other  
7 words, you may not consider your determination of willfulness when calculating any damages  
8 you award to TPL.

9           To prove willful infringement, TPL must first persuade you that Acer, Gateway and  
10 HTC infringed a valid and enforceable claim of a patent. The requirements for proving such  
11 infringement were discussed in my prior instructions.

12           In addition, to prove willful infringement of the '336 patent by Acer and Gateway, TPL  
13 must persuade you that it is highly probable that prior to February 8, 2008, Acer and Gateway  
14 acted with reckless disregard of the claims of the '336 patent. To prove willful infringement of  
15 the '890 patent by Acer and Gateway, TPL must persuade you that it is highly probable that  
16 prior to June 4, 2009, Acer and Gateway acted with reckless disregard of the claims of the '890  
17 patent.

18           Similarly, to prove willful infringement, if any, by HTC, TPL must persuade you that it  
19 is highly probable that prior to February 8, 2008, HTC acted with reckless disregard of the  
20 claims of the '336 patent or the '890 patent.

21           To demonstrate such "reckless disregard," TPL must satisfy a two-part test. The first  
22 part of the test is objective. TPL must persuade you with clear and convincing evidence that  
23 Acer, Gateway or HTC actually knew, or it was so obvious that it should have known, that its  
24 actions constituted an unjustifiably high risk of infringement of the patent without a good faith  
25 belief that the patent was invalid, unenforceable, or not infringed. The state of mind of the  
26 Acer, Gateway and HTC is not relevant to this inquiry. Rather, the appropriate inquiry is  
27 whether the defenses put forth by Acer, Gateway and HTC fail to raise any substantial question  
28

1 with regard to infringement or validity or enforceability. Legitimate or credible defenses to  
2 infringement, even if not ultimately successful, demonstrate a lack of recklessness. Only if you  
3 conclude that the defenses fail to raise any substantial question with regard to infringement or  
4 validity or enforceability, do you need to consider the second part of the test.

5 The second part of the test does depend on the state of mind of Acer, Gateway and  
6 HTC. TPL must persuade you by clear and convincing evidence that Acer, Gateway and HTC  
7 actually knew, or it was so obvious that Acer, Gateway and HTC should have known, that their  
8 actions constituted an unjustifiably high risk of infringement of a valid and enforceable patent.

9 To determine whether Acer, Gateway and HTC had this state of mind, you should  
10 consider all of the facts surrounding the alleged infringement including, but not limited to, the  
11 following factors:

- 12 (1) Whether Acer and Gateway and HTC acted in a manner consistent with the  
13 standards of commerce for its industry;
- 14 (2) Whether Acer and Gateway and HTC intentionally copied a product of TPL  
15 covered by the '336 patent or the '890 patent;
- 16 (3) Whether Acer and Gateway and HTC made a good-faith effort to avoid  
17 infringing the '336 patent or the '890 patent, for example, whether Acer  
18 attempted to design around the '336 patent or the '890 patent;
- 19 (4) Whether Acer and Gateway and HTC tried to cover up their infringement; and
- 20 (5) Whether there is a reasonable basis to believe that Acer/Gateway and HTC did  
21 not infringe or had a reasonable defense to infringement.

### 22 23 Authorities

24 Fed. Cir. Bar Association Model Instruction § 3.8; N.D. Cal. Model Patent Jury Instruction §  
25 3.10, which cites 35 U.S.C. § 284; *In re Seagate Tech., LLC*, 497 F.3d 1360 (Fed. Cir. 2007);  
26 *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337, 1345 (Fed.  
27 Cir. 2004) (*en banc*); *Crystal Semiconductor Corp. v. Tritech Microelectronics Int'l, Inc.*, 246  
28 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).

1 **DEFENDANTS' OBJECTIONS AND ALTERNATIVE INSTRUCTION:**

2 Plaintiffs' instruction departs significantly from the model instruction. Plaintiffs'  
3 instruction confuses the reckless disregard standard by repeating it multiple times and in  
4 different inconsistent formulations that—when taken out of context as here—result in an  
5 improper statement of law. Further, Plaintiffs' proposed instruction includes the objective  
6 standard, which is for the Court to decide. Because recent case law focuses on the Court  
7 deciding the objective standard and the model instruction properly describes the subjective  
8 standard that is within the province of the jury, Defendants respectfully request that the Court  
9 adopt the model instruction, minus the portion on the objective standard.

10  
11 **8. WILLFUL INFRINGEMENT DEFENDANTS' ALTERNATIVE**  
12 **INSTRUCTION**

13 In this case, TPL and Patriot argue that Acer/Gateway and HTC willfully infringed the  
14 '336 and '890 patents.

15 To prove willful infringement, TPL and Patriot must first persuade you that the  
16 Acer/Gateway and/or HTC infringed a valid claim of the '336 and/or '890 patents patent. The  
17 requirements for proving such infringement were discussed in my prior instructions.

18 In addition, to prove willful infringement, the TPL and Patriot must persuade you that it  
19 is highly probable that prior to February 8, 2008, Acer/Gateway and/or HTC acted with  
20 reckless disregard of the claims of the '336 and '890 patents.

21 To demonstrate such "reckless disregard," TPL and Patriot must persuade you that  
22 Acer/Gateway and/or HTC actually knew, or it was so obvious that Acer/Gateway and/or HTC  
23 should have known, that its actions constituted infringement of a valid patent. This test  
24 depends on the state of mind of the Acer/Gateway and/or HTC.

25 In deciding whether Acer/Gateway and/or HTC acted with reckless disregard for TPL  
26 and Patriot's patents, you should consider all of the facts surrounding the alleged infringement  
27 including, but not limited to, the following factors.

1 Factors that may be considered as evidence that Acer/Gateway and/or HTC was not  
2 willful include:

3 (1) Whether Acer/Gateway and/or HTC acted in a manner consistent with the standards  
4 of commerce for its industry.

5 Factors that may be considered as evidence that Acer/Gateway and/or HTC was willful  
6 include:

7 (1) Whether Acer/Gateway and/or HTC intentionally copied a product covered by the  
8 patent.

9 Authorities

10 N.D. Cal. Model Patent Jury Instruction §3.10; 35 U.S.C. § 284; *In re Seagate Tech., LLC*, 497  
11 F.3d 1360 (Fed. Cir. 2007); *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*,  
12 383 F.3d 1337, 1345 (Fed. Cir. 2004) (*en banc*); *Crystal Semiconductor Corp. v. Tritech*  
13 *Microelectronics Int'l, Inc.*, 246 F.3d 1336, 1346 (Fed. Cir. 2001); *WMS Gaming Inc. v. Int'l*  
14 *Game Tech.*, 184 F.3d 1339, 1354 (Fed. Cir. 1999); *Read Corp. v. Portec, Inc.*, 970 F.2d 816  
15 (Fed. Cir. 1992); *Gustafson, Inc. v. Intersystems Indus. Prods., Inc.*, 897 F.2d 508, 510 (Fed.  
16 Cir. 1990).

17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28



1 **PLAINTIFFS' RESPONSE AND OBJECTIONS TO DEFENDANTS' ALTERNATIVE**  
2 **INSTRUCTION:**

3 Plaintiffs' proposed instruction is based on this District's model instruction and the  
4 Federal Circuit Bar Association Model Instruction § 3.8, which Plaintiffs believe more  
5 accurately reflects the state of the law concerning willfulness. Plaintiffs' instruction is also  
6 consistent with the briefing presented in Plaintiffs' dispositive motion briefing regarding  
7 willfulness.

8 TPL's alternative instruction is not only misleading, but incorrect. In particular, TPL  
9 does not recognize the different dates on which the '336 and the '890 patents were asserted  
10 against Acer/Gateway. As discussed in detail in Acer's pending motion for summary judgment  
11 on damages, neither Acer/Gateway's nor TPL's initial pleadings included claims relating to the  
12 '890 patent. As previously recognized by this Court, it was not until June 4, 2008 when it filed  
13 its complaint in the Eastern District of Texas that Acer received notice of TPL's claims of  
14 infringement of the '890 patent. *See* Case No. 5:08-CV-00877, Dkt. No. 97.

1           **9.       INVALIDITY – BURDEN OF PROOF [CHALLENGED INSTRUCTION]**

2           Patent invalidity is a defense to patent infringement. Even though the United States  
3 Patent Office has allowed the claims of a patent, you have the ultimate responsibility for  
4 deciding whether or not the claims of the '336 patent and the '890 patent are valid.

5           I will now instruct you on the rules you must follow in deciding whether Acer/Gateway  
6 and/or HTC have proven that the asserted claims of the '336 patent and the asserted claims of  
7 the '890 patent are invalid. Before discussing the specific rules, I want to remind you about the  
8 standard of proof that applies to this defense. To prove invalidity of any patent claim,  
9 Acer/Gateway and/or HTC must persuade you that it is highly probable that the claim is  
10 invalid.

11           The granting of a patent by the Patent Office carries with it the presumption that the  
12 patent's subject matter is new, useful and constitutes an advance that was not, at the time the  
13 invention was made, obvious to one of ordinary skill in the art. Nevertheless, that presumption  
14 may be rebutted, and once the validity of a patent has been put at issue, it is the responsibility  
15 of the jury to review what the Patent Office has done consistent with these instructions on the  
16 law.

17           In deciding the issue of invalidity, you may take into account the fact that the prior art  
18 was not considered by the Patent Office when it issued the '336 patent and the '890 patent.  
19 Prior art that differs from the prior art considered by the Patent Office may carry more weight  
20 than the prior art that was considered and may make Acer/Gateway's and HTC's burden of  
21 showing that it is highly probable that a patent claim is invalid easier to sustain.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction §4.1, which cites *Microsoft Corp. v. i4i LTD Partnership*, 131 S.Ct. 2238, 2242, 2251, 564 U.S. \_\_\_\_ (2011); *Buildex, Inc. v. Kason Indus., Inc.*, 849 F.2d 1461, 1463 (Fed. Cir. 1988); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1375 (Fed. Cir. 1986); *Central Soya Co., Inc. v. Geo. A. Hormel & Co.*, 723 F. 2d 1573, 1577 (Fed. Cir. 1983) (burden to overcome presumption of validity “is most formidable when the party asserting invalidity relies upon prior art considered by the Patent and Trademark Office”).

1 **DEFENDANTS' OBJECTIONS AND ALTERNATIVE INSTRUCTION:**

2 Plaintiffs' instruction adds material to the model instruction, with the result being a  
3 misstatement of law. Specifically, Plaintiffs' addition of the first and third paragraphs  
4 misstates the presumption of validity and seal of institutional competence due to the PTO's  
5 grant of the patents. For this reason, Defendants object and propose the alternative instruction  
6 below, which follows the model instruction.

7  
8 **9. INVALIDITY – BURDEN OF PROOF DEFENDANTS' ALTERNATIVE**  
9 **INSTRUCTION**

10 I will now instruct you on the rules you must follow in deciding whether Acer/Gateway  
11 and HTC have proven that claims 1, 6, 7, 9, 10, 11, 13, 14, 15, and 16 of the '336 patent and  
12 claims 11, 12, 13, 17 and 19 of the '890 patent are invalid. Before discussing the specific rules, I  
13 want to remind you about the standard of proof that applies to this defense. To prove invalidity of  
14 any patent claim, Acer/Gateway and HTC must persuade you that it is highly probable that the  
15 claim is invalid.

16 During this case, Acer/Gateway and HTC have submitted prior art that was not  
17 considered by the PTO during the prosecution of the '336 patent and of the '890 patent.  
18 Acer/Gateway and HTC contend that such prior art invalidates certain claims of the '336 patent  
19 and the '890 patent. In deciding the issue of invalidity, you may take into account the fact that  
20 the prior art was not considered by the PTO when it issued the '336 patent and the '890 patent.  
21 Prior art that differs from the prior art considered by the PTO may carry more weight than the  
22 prior art that was considered and may make HTC's burden of showing that it is highly probable  
23 that a patent claim is invalid easier to sustain.

1 Authorities

2 N.D. Cal. Model Patent Jury Instruction §4.1, which cites *Microsoft Corp. v. i4i LTD Partnership*,  
3 131 S.Ct. 2238, 2242, 2251, 564 U.S. \_\_\_\_ (2011); *Buildex, Inc. v. Kason Indus., Inc.*, 849 F.2d 1461,  
4 1463 (Fed. Cir. 1988); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1375 (Fed. Cir.  
5 1986).

6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1 **PLAINTIFFS' RESPONSE AND OBJECTIONS TO DEFENDANTS' ALTERNATIVE**  
2 **INSTRUCTION:**

3           Plaintiffs' proposed instruction is based on this District's model instruction, with  
4 modifications that Plaintiffs believe will assist the jury and reduce the likelihood of jury  
5 confusion regarding the types of prior art Plaintiffs may rely upon at trial.

6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**10. WRITTEN DESCRIPTION REQUIREMENT**

A patent claim is invalid if the patent does not contain an adequate written description of the claimed invention. The purpose of this written description requirement is to demonstrate that the inventor was in possession of the invention at the time the application for the patent was filed, even though the claims may have been changed or new claims added since that time. The written description requirement is satisfied if a person of ordinary skill in the field reading the original patent application at the time it was filed would have recognized that the patent application described the invention as claimed, even though the description may not use the exact words found in the claim. A requirement in a claim need not be specifically disclosed in the patent application as originally filed if a person of ordinary skill would understand that the missing requirement is necessarily implied in the patent application as originally filed.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 4.2a, which cites 35 U.S.C. § 112(1) and (2); *In Re Skvorecz*, 580 F.3d 1262, 1269 (Fed. Cir. 2009); *Kao Corp. v. Unilever U.S., Inc.*, 441 F.3d 963, 968 (Fed. Cir. 2006); *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247 (Fed. Cir. 2004); *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000); *Lampi Corp. v. Am. Power Prods., Inc.*, 228 F.3d 1365, 1377-78 (Fed. Cir. 2000); *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1478-80 (Fed. Cir. 1998); *In re Alton*, 76 F.3d 1168, 1172 (Fed. Cir. 1996); *University of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 926-928 (Fed. Cir. 2004).



1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**11. ENABLEMENT**

A patent claim is invalid if the patent at the time it was originally filed did not contain a description of the claimed invention that is sufficiently full and clear to enable a person of ordinary skill in the field at the time to make and use the full scope of the invention. This is known as the “enablement” requirement.

The patent may be enabling even though it does not expressly state some information if a person of ordinary skill in the field could make and use the invention without having to do excessive experimentation. In determining whether excessive experimentation is required, you may consider the following factors:

1. the scope of the claimed invention;
2. the amount of guidance presented in the patent;
3. the amount of experimentation necessary;
4. the time and cost of any necessary experimentation;
5. how routine any necessary experimentation is in the field of microprocessor architecture and design;
6. whether the patent discloses specific working examples of the claimed invention;
7. the nature and predictability of the field; and
8. the level of ordinary skill in the field of microprocessor architecture and design.

The question of whether a patent is enabling the date the original application for the patent was first filed.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 4.2b, which cites 35 U.S.C. § 112(1); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 999 (Fed. Cir. 2008); *Auto. Techs. Int'l, Inc. v. BMW of N. Am., Inc.*, 501 F.3d 1274, 1285 (Fed. Cir. 2007); *AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1244 (Fed. Cir. 2003); *Union Pac. Resources Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 690-92 (Fed. Cir. 2001); *Ajinomoto Co. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 1345-46 (Fed. Cir. 2000); *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

**12. BEST MODE**

1  
2 A patent claim is invalid if the patent does not disclose what the inventor believed was  
3 the best way to carry out the claimed invention at the time the patent application was filed.  
4 This is known as the “best mode” requirement. It ensures that the public obtains a full  
5 disclosure of the best way to carry out the claimed invention known to the inventor at the time  
6 the original patent application was first filed. The disclosure of the best mode must be detailed  
7 enough to enable the persons of ordinary skill in the field to carry out that best mode without  
8 excessive experimentation.

9 The best mode requirement focuses on what the inventor believed at the time the  
10 original patent application was first filed. It does not matter whether the best mode  
11 contemplated by the inventor was, in fact, the best way to carry out the invention. The  
12 question is whether the patent includes what the inventor believed was the best mode at the  
13 time the original patent application was filed. If the inventor did not believe there was a best  
14 way to carry out the invention at the time that application was filed, there is no requirement  
15 that the patent describe a best mode. Although a patent specification must disclose the best  
16 mode, it may disclose other modes as well and need not state which of the modes disclosed is  
17 best. If the inventor believed there was a better way to carry out the invention and the patent  
18 does not disclose it, the patent is invalid.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 4.2c, which cites 35 U.S.C. § 112(1); *Pfizer, Inc. v. Teva Pharms. USA, Inc.*, 518 F.3d 1353, 1364-64 (Fed. Cir. 2008); *Cardiac Pacemaker, Inc. v. St. Jude Medical, Inc.*, 381 F.3d 1371, 1378-79 (Fed. Cir. 2004); *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1049-52 (Fed. Cir. 1995); *Transco Prods. v. Performance Contracting*, 38 F.3d 551 (Fed. Cir. 1994); *Wahl Instruments v. Acvious*, 950 F.2d 1575 (Fed. Cir. 1991); *Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923, 926-28 (Fed. Cir. 1990); *Spectra-Physics Inc. v. Coherent, Inc.*, 827 F.2d 1524 (Fed. Cir. 1987).

1                   **13.     ANTICIPATION [CHALLENGED INSTRUCTION]**

2                   A patent claim is invalid if the claimed invention is not new. For the claim to be  
3 invalid because it is not new, all of its requirements must have existed in a single device or  
4 method that predates the claimed invention, or must have been described in a single previous  
5 publication or patent that predates the claimed invention. In patent law, these previous devices,  
6 methods, publications or patents are called “prior art.” If a patent claim is not new we say it is  
7 “anticipated” by a prior art reference and is not entitled to patent protection.

8                   In general, prior art includes things that existed before the claimed invention, that were  
9 publicly known, or used in a publicly accessible way in this country, or that were patented or  
10 described in a publication in any country.

11                  The description in the written prior art reference does not have to be in the same words  
12 as the claim, but all of the requirements of the claim must be there, either stated or necessarily  
13 implied, so that someone of ordinary skill in the field of microprocessor architecture and  
14 design, looking at that one reference, would be able to make and use the claimed invention.

15                  Acer/Gateway and HTC can show that a patent claim was not new if:

- 16                   • The claimed invention was already publicly known or publicly used by others in  
17 the United States before August 3, 1989.
- 18                   • The claimed invention was already patented or described in a printed  
19 publication anywhere in the world before August 3, 1989. A reference is a  
20 “printed publication” if it is accessible to those interested in the field, even if it  
21 is difficult to find.
- 22                   • The claimed invention was already described in another issued U.S. patent or  
23 published U.S. patent application that was based on a patent application filed  
24 before August 3, 1989.

1 Authorities

2 N.D. Cal. Model Patent Jury Instruction § A.1, 4.3a1, which cites 35 U.S.C. § 102(a), (c), (e),  
3 (f) and (g); *Flex-Rest, LLC v. Steelcase, Inc.*, 455 F.3d 1351, 1358-60 (Fed. Cir. 2006);  
4 *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 424 F.3d 1374, 1379-82 (Fed. Cir. 2005); *Apotex*  
5 *U.S.A., Inc. v. Merck & Co.*, 254 F.3d 1031, 1035 (Fed. Cir. 2001); *Mycogen Plant Science,*  
6 *Inc. v. Monsanto Co.*, 243 F.3d 1316, 1330 (Fed. Cir. 2001); *Ecolochem, Inc. v. S. Cal. Edison*  
7 *Co.*, 227 F.3d 1361, 1367-70 (Fed. Cir. 2000); *Singh v. Brake*, 222 F.3d 1362, 1366-70 (Fed.  
8 *Cir.* 2000); *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1349 (Fed. Cir. 1998); *Gambro Lundia AB v.*  
9 *Baxter Healthcare Corp.*, 110 F.3d 1573, 1576-78 (Fed. Cir. 1997); *Lamb-Weston, Inc. v.*  
10 *McCain Foods, Ltd.*, 78 F.3d 540, 545 (Fed. Cir. 1996); *In re Bartfeld*, 925 F.2d 1450 (Fed.  
11 *Cir.* 1985); *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1574 (Fed. Cir. 1985);  
12 *American Stock Exch., LLC v. Mopies*, 250 F. Supp. 2d 323 (S.D.N.Y. 2003); *In re Wyer*, 655  
13 F.2d 221, 226 (C.C.P.A. 1981).

1 **DEFENDANTS’ OBJECTIONS AND ALTERNATIVE INSTRUCTION:**

2 The second paragraph of Plaintiffs’ proposed instruction is not in the model instructions  
3 and misstates the law. Defendants object to Plaintiffs’ definition of prior art because it is  
4 overbroad and may confuse the jury by suggesting that they consider “things that existed  
5 before the claimed invention,” rather than the specific references at issue in this case.

6 In addition, the first bullet point—which comes from the optional bullet points in the  
7 model instruction—is not applicable to this case. Plaintiffs do not have a prior public  
8 knowledge or use defense. For these reasons, Defendants’ alternative instruction follows the  
9 model instruction without these bullet points.

10  
11 **13. ANTICIPATION DEFENDANTS’ ALTERNATIVE INSTRUCTION**

12 A patent claim is invalid if the claimed invention is not new. For the claim to be  
13 invalid because it is not new, all of its requirements must have existed in a single device or  
14 method that predates the claimed invention, or must have been described in a single previous  
15 publication or patent that predates the claimed invention. In patent law, these previous devices,  
16 methods, publications or patents are called “prior art references.” If a patent claim is not new  
17 we say it is “anticipated” by a prior art reference.

18 The description in the written reference does not have to be in the same words as the  
19 claim, but all of the requirements of the claim must be there, either stated or necessarily  
20 implied, so that someone of ordinary skill in the field of microprocessor architecture and  
21 design, looking at that one reference, would be able to make and use the claimed invention.

22 Acer/Gateway and HTC can show that a patent claim was not new if:

- 23
- 24 • The claimed invention was already patented or described in a printed  
25 “printed publication” if it is accessible to those interested in the field, even if it  
26 is difficult to find.
  - 27 • The claimed invention was already described in another issued U.S. patent or  
28

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

published U.S. patent application that was based on a patent application filed before August 3, 1989.



1 Authorities

2 N.D. Cal. Model Patent Jury Instruction § 4.3a1, which cites 35 U.S.C. § 102(a), (c), (e), (f)  
3 and (g); *Flex-Rest, LLC v. Steelcase, Inc.*, 455 F.3d 1351, 1358-60 (Fed. Cir. 2006); *Invitrogen*  
4 *Corp. v. Biocrest Mfg., L.P.*, 424 F.3d 1374, 1379-82 (Fed. Cir. 2005); *Apotex U.S.A., Inc. v.*  
5 *Merck & Co.*, 254 F.3d 1031, 1035 (Fed. Cir. 2001); *Mycogen Plant Science, Inc. v. Monsanto*  
6 *Co.*, 243 F.3d 1316, 1330 (Fed. Cir. 2001); *Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d  
7 1361, 1367-70 (Fed. Cir. 2000); *Singh v. Brake*, 222 F.3d 1362, 1366-70 (Fed. Cir. 2000);  
8 *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1349 (Fed. Cir. 1998); *Gambro Lundia AB v. Baxter*  
9 *Healthcare Corp.*, 110 F.3d 1573, 1576-78 (Fed. Cir. 1997); *Lamb-Weston, Inc. v. McCain*  
10 *Foods, Ltd.*, 78 F.3d 540, 545 (Fed. Cir. 1996); *In re Bartfeld*, 925 F.2d 1450 (Fed. Cir. 1985);  
11 *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1574 (Fed. Cir. 1985); *American*  
12 *Stock Exch., LLC v. Mopies*, 250 F. Supp. 2d 323 (S.D.N.Y. 2003); *In re Wyer*, 655 F.2d 221,  
13 226 (C.C.P.A. 1981).

1 **PLAINTIFFS’ RESPONSE AND OBJECTIONS TO DEFENDANTS’ ALTERNATIVE**  
2 **INSTRUCTION:**

3 Plaintiffs’ proposed instruction is based on this District’s model instruction. Paragraph  
4 two is the definition of prior art directly from this District’s “What A Patent Is and How One is  
5 Obtained” instruction which Defendants do not challenge. Plaintiffs believe including the  
6 definition of prior art in this instruction will assist the jury and reduce jury confusion.

7 Acer/Gateway disagrees with TPL’s attempt to remove the prior public knowledge/use  
8 bullet point number one, which is relevant to their case. In particular, Acer/Gateway contend  
9 that a Motorola chip that disclosed all elements of the asserted claims was being offered for  
10 sale, was sold and was being used by the public prior to August 3, 1989.

1                   **14. STATUTORY BARS [CHALLENGED INSTRUCTION]**

2                   A patent claim is invalid if the patent application was not filed within the time required  
3 by law. This is called a “statutory bar.” For a patent claim to be invalid by a statutory bar, all  
4 of its requirements must have been present in one prior art reference dated more than one year  
5 before the patent application was filed.

6                   Acer/Gateway and HTC can show that the patent application was not timely filed if:

- 7                   • The claimed invention was already patented or described in a printed  
8 publication anywhere in the world before August 3, 1988. A reference is a  
9 “printed publication” if it is accessible to those interested in the field, even if it  
10 is difficult to find.
- 11                  • The claimed invention was already being openly used in the United States  
12 before August 3, 1988, and that use was not primarily an experimental use (a)  
13 controlled by the inventor, and (b) to test whether the invention worked for its  
14 intended purpose.

15                  For a claim to be invalid because of a statutory bar, all of the claimed requirements  
16 must have been either (1) disclosed in a single prior art reference, (2) implicitly disclosed in a  
17 reference to one skilled in the field, or (3) must have been present in the reference, whether or  
18 not that was understood at the time. The disclosure in a reference does not have to be in the  
19 same words as the claim, but all the requirements must be there, either described in enough  
20 detail or necessarily implied, to enable someone of ordinary skill in the field of microprocessor  
21 architecture and design, looking at the reference, to make and use the claimed invention.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 4.3a2, which cites 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 1273 (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).

**DEFENDANTS' OBJECTIONS AND ALTERNATIVE INSTRUCTION:**

1  
2 Defendants object to the second bullet point in Plaintiffs' proposed instruction—which  
3 comes from the optional bullet points in the model instruction—because its is not applicable to  
4 this case. Plaintiffs do not have a prior public use, on sale bar, or prior foreign patent defense.  
5 Accordingly, Defendants' propose an alternative instruction that is identical to Plaintiffs'  
6 without these three bullet points.

**14. STATUTORY BARS DEFENDANTS' ALTERNATIVE INSTRUCTION**

7  
8 A patent claim is invalid if the patent application was not filed within the time required  
9 by law. This is called a "statutory bar." For a patent claim to be invalid by a statutory bar, all  
10 of its requirements must have been present in one prior art reference dated more than one year  
11 before the patent application was filed.

12 Acer/Gateway and HTC can show that the patent application was not timely filed if:

- 13
- 14 • The claimed invention was already patented or described in a printed  
15 publication anywhere in the world before August 3, 1988. A reference is a  
16 "printed publication" if it is accessible to those interested in the field, even if it  
17 is difficult to find.

18 For a claim to be invalid because of a statutory bar, all of the claimed requirements  
19 must have been either (1) disclosed in a single prior art reference, (2) implicitly disclosed in a  
20 reference to one skilled in the field, or (3) must have been present in the reference, whether or  
21 not that was understood at the time. The disclosure in a reference does not have to be in the  
22 same words as the claim, but all the requirements must be there, either described in enough  
23 detail or necessarily implied, to enable someone of ordinary skill in the field of microprocessor  
24 architecture and design, looking at the reference, to make and use the claimed invention.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 4.3a2, which cites 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 1273 (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).

1 **PLAINTIFFS' OBJECTIONS TO DEFENDANTS' ALTERNATIVE INSTRUCTION:**

2 Plaintiffs' propose instruction is based on this District's model instruction, with  
3 modifications that Plaintiffs believe will assist the jury and reduce the likelihood of jury  
4 confusion. Plaintiffs disagree with Defendants that it misstates the law.

5 Acer/Gateway disagrees with TPL's attempt to remove the prior public knowledge/use  
6 bullet point number two, which is relevant to their case. In particular, Acer/Gateway contend  
7 that a product that practiced all elements of the asserted claims was being offered for sale  
8 and/or sold prior to August 3, 1989.

9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

## 15. OBVIOUSNESS

1  
2 Acer/Gateway and HTC also contend that the claims of the '336 patent and '890 patent  
3 are invalid because the claimed subject matter was "obvious." Not all innovations are  
4 patentable. A patent claim is invalid if the claimed invention would have been obvious to a  
5 person of ordinary skill in the field at the time the application was filed. This means that even  
6 if all of the requirements of the claim cannot be found in a single prior art reference that would  
7 anticipate the claim or constitute a statutory bar to that claim, a person of ordinary skill in the  
8 field of microprocessor architecture and design who knew about all this prior art would have  
9 come up with the claimed invention.

10 The ultimate conclusion of whether a claim is obvious should be based upon your  
11 determination of several factual decisions.

12 First, you must decide the level of ordinary skill in the field that someone would have  
13 had at the time the claimed invention was made. In deciding the level of ordinary skill, you  
14 should consider all the evidence introduced at trial, including:

- 15 (1) the levels of education and experience of persons working in the field;
- 16 (2) the types of problems encountered in the field; and
- 17 (3) the sophistication of the technology.

18 Acer/Gateway contends that the level of ordinary skill in the field was someone at least  
19 having a bachelor's degree in electrical engineering, computer engineering, or computer  
20 science and having approximately 3-5 years of experience in the field of microprocessor design  
21 and programming or an equivalent combination of education and experience. Such a person  
22 would be able to read and understand the patents and given adequate implementation  
23 resources, practice the patents.

24 HTC contends that the level of ordinary skill in the field is one with a bachelor's  
25 degree in electrical engineering, computer engineering, or a related field, and at least two years  
26 of experience in the field of semiconductor design or analysis, or a commensurate amount of  
27 relevant experience.



1 TPL contends that the level of ordinary skill in the field was one with a minimum of a  
2 bachelor's degree in electrical engineering and with two to three years of experience in  
3 semiconductor design.

4 Second, you must decide the scope and content of the prior art. In order to be  
5 considered as prior art to the '336 patent and the '890 patent, these references must be  
6 reasonably related to the claimed invention of that patent. A reference is reasonably related if  
7 it is in the same field as the claimed invention or is from another field to which a person of  
8 ordinary skill in the field would look to solve a known problem.

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

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

- 13 1. commercial success of a product due to the merits of the claimed invention;
- 14 2. a long felt need for the solution provided by the claimed invention;
- 15 3. unsuccessful attempts by others to find the solution provided by the claimed  
16 invention;
- 17 4. copying of the claimed invention by others;
- 18 5. unexpected and superior results from the claimed invention;
- 19 6. acceptance by others of the claimed invention as shown by praise from others in the  
20 field or from the licensing of the claimed invention;
- 21 7. other evidence tending to show non-obviousness;
- 22 8. independent invention of the claimed invention by others before or at about the  
23 same time as the named inventor thought of it; and
- 24 9. other evidence tending to show obviousness.

25 The presence of any of factors 1 through 7, above, may be considered by you as an  
26 indication that the claimed invention would not have been obvious at the time the claimed  
27 invention was made, and the presence of the factors 8 or 9 may be considered by you as an  
28

1 indication that the claimed invention would have been obvious at such time. Although you  
2 should consider any evidence of these factors, the relevance and importance of any of them to  
3 your decision on whether the claimed invention would have been obvious is up to you.

4 A patent claim composed of several elements is not proved obvious merely by  
5 demonstrating that each of its elements was independently known in the prior art. In  
6 evaluating whether such a claim would have been obvious, you may consider whether TPL has  
7 identified a reason that would have prompted a person of ordinary skill in the field to combine  
8 the elements or concepts from the prior art in the same way as in the claimed invention. There  
9 is no single way to define the line between true inventiveness on the one hand (which is  
10 patentable) and the application of common sense and ordinary skill to solve a problem on the  
11 other hand (which is not patentable). For example, market forces or other design incentives  
12 may be what produced a change, rather than true inventiveness. You may consider whether the  
13 change was merely the predictable result of using prior art elements according to their known  
14 functions, or whether it was the result of true inventiveness. You may also consider whether  
15 there is some teaching or suggestion in the prior art to make the modification or combination of  
16 elements claimed in the patent. Also, you may consider whether the innovation applies a  
17 known technique that had been used to improve a similar device or method in a similar way.

18 You may also consider whether the claimed invention would have been obvious to try,  
19 meaning that the claimed innovation was one of a relatively small number of possible  
20 approaches to the problem with a reasonable expectation of success by those skilled in the art.  
21 However, you must be careful not to determine obviousness using the benefit of hindsight;  
22 many true inventions might seem obvious after the fact. You should put yourself in the  
23 position of a person of ordinary skill in the field at the time the claimed invention was made  
24 and you should not consider what is known today or what is learned from the teaching of the  
25 patent.

1 Authorities

2 N.D. Cal. Model Patent Jury Instruction § 4.3b (Alternative 2), which cites 35 U.S.C. § 103;  
3 *Graham v. John Deere Co.*, 383 U.S. 1 (1966); *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398,  
4 407 (2007); *Ruiz v. A.B. Chance Co.*, 234 F.3d 654 (Fed. Cir. 2000); *Arkie Lures, Inc. v. Gene*  
5 *Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed. Cir. 1997); *Specialty Composites v. Cabot Corp.*,  
6 845 F.2d 981, 991 (Fed. Cir. 1988); *Windsurfing Int'l, Inc. v. AMF, Inc.*, 782 F.2d 995, 1000  
7 (Fed. Cir. 1986); *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 313 (Fed. Cir. 1985).  
8 *See Novo Nordisk A/S v. Becton Dickinson & Co.*, 304 F.3d 1216, 1219-20 (Fed. Cir. 2002);  
9 *Wang Labs. v. Toshiba Corp.*, 993 F.2d 858, 864 (Fed. Cir. 1993); *Daiichi Sankyo Co. v.*  
10 *Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007); *Brown & Williamson Tobacco Corp. v.*  
11 *Philip Morris Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000); *SIBIA Neurosciences, Inc. v. Cadus*  
12 *Pharm. Corp.*, 225 F.3d 1349, 1355 (Fed. Cir. 2000); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d  
13 714, 718-19 (Fed. Cir. 1991).

1           **16. DAMAGES – BURDEN OF PROOF [CHALLENGED INSTRUCTION]**

2           I will instruct you about the measure of damages. By instructing you on damages, I am  
3 not suggesting which party should win on any issue. If you find that Acer, Gateway or HTC  
4 infringed any valid claim of the '336 patent or the '890 patent, you must then determine the  
5 amount of money damages in the form of a reasonable royalty to be awarded to TPL to  
6 compensate it for the infringement of each such patent. Because TPL has accused certain  
7 products of accusing the '336 patent and certain products of infringing the '890 patent, if you  
8 find that Acer, Gateway or HTC only infringed a valid claim of one patent, then you cannot  
9 award damages related to any alleged infringement of the product or products accused of  
10 infringing the other patent.

11           The amount of those damages must be adequate to compensate TPL for the  
12 infringement. A damages award should put the patent holder in approximately the same  
13 financial position parties negotiated a license and the infringement not occurred, but in no even  
14 may the damages award be less than a reasonable royalty. You should keep in mind that the  
15 damages you award are meant to compensate the patent holder and not to punish an infringer.

16           TPL has the burden of proving each element of its damages by a preponderance of the  
17 evidence. In other words, you should award only the amount of a reasonable royalty that TPL  
18 establishes that it more likely than not would have received if Acer and Gateway and HTC had  
19 negotiated a license prior to when any infringement began. While TPL is not required to prove  
20 its damages with mathematical precision, it must prove them with reasonable certainty. TPL is  
21 not entitled to damages that are remote or speculative. Where the parties dispute a matter  
22 concerning damages, it is TPL's burden to prove that it is more probable than not that TPL's  
23 determination is correct.

1 Authorities

2 N.D. Cal. Model Patent Jury Instruction § 5.1, which cites 35 U.S.C. § 284; *Dow Chem. Co. v.*  
3 *Mee Indus., Inc.*, 341 F.3d 1370, 1381-82 (Fed. Cir. 2003); *Grain Processing Corp. v.*  
4 *American Maize-Prod. Co.*, 185 F.3d 1341, 1349 (Fed. Cir. 1999); *Maxwell v. J. Baker, Inc.*,  
5 86 F.3d 1098, 1108-09 (Fed. Cir. 1996); *Rite-Hite Corp. v. Kelley Co.*, 56 F.3d 1538, 1544-45  
6 (Fed. Cir. 1995) (en banc); Final Jury Instructions §5.1; Federal Circuit Bar Association Model  
7 Patent Jury Instructions, 2012 §6.1; modification in brackets adapted from ABA Model Jury  
8 Instructions: Patent Litigation (ed. Denise Loring).

6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1 **DEFENDANTS' OBJECTIONS AND ALTERNATIVE INSTRUCTION:**

2 Although HTC initially proposed an instruction that followed the model instruction,  
3 Plaintiffs now propose significant changes to each paragraph of the model instruction.  
4 Defendants object to these changes. The changes to the first paragraph are confusing and  
5 suggest an improper limitation on damages. Plaintiffs' changes to the second paragraph result  
6 in a misstatement of law relating to the financial position TPL and Patriot would have been in  
7 but for infringement. Finally, Plaintiffs' third paragraph attempts to reformulate the burden of  
8 proof by restating it multiple times in formulations that are inconsistent and unsupported by  
9 controlling law. For these reasons, Defendants propose using the model instruction.

10 **16. DAMAGES – BURDEN OF PROOF [CHALLENGED INSTRUCTION]**

11 I will instruct you about the measure of damages. By instructing you on damages, I am not  
12 suggesting which party should win on any issue. If you find that Acer/Gateway or HTC infringed  
13 any valid claim of the '336 patent or the '890 patent, you must then determine the amount of  
14 money damages to be awarded to TPL and Patriot to compensate it for the infringement.

15 The amount of those damages must be adequate to compensate TPL and Patriot for the  
16 infringement. A damages award should put the patent holder in approximately the financial  
17 position it would have been in had the infringement not occurred, but in no event may the damages  
18 award be less than a reasonable royalty. You should keep in mind that the damages you award are  
19 meant to compensate the patent holder and not to punish an infringer.

20 TPL and Patriot have the burden to persuade you of the amount of its damages. You  
21 should award only those damages that TPL and Patriot more likely than not suffered. While TPL  
22 and Patriot are not required to prove their damages with mathematical precision, they must prove  
23 them with reasonable certainty. TPL and Patriot are not entitled to damages that are remote or  
24 speculative.  
25  
26  
27  
28

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 5.1, which cites 35 U.S.C. § 284; *Dow Chem. Co. v. Mee Indus., Inc.*, 341 F.3d 1370, 1381-82 (Fed. Cir. 2003); *Grain Processing Corp. v. American Maize-Prod. Co.*, 185 F.3d 1341, 1349 (Fed. Cir. 1999); *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1108-09 (Fed. Cir. 1996); *Rite-Hite Corp. v. Kelley Co.*, 56 F.3d 1538, 1544-45 (Fed. Cir. 1995) (en banc).

1 **PLAINTIFFS' RESPONSE AND OBJECTIONS TO DEFENDANTS' ALTERNATIVE**  
2 **INSTRUCTION:**

3 TPL's claim that this was not initially proposed is inaccurate as a similar instruction  
4 was included in Acer/Gateway's proposed instructions served on August 15, 2013. Plaintiffs'  
5 proposed instruction is based on this District's model instruction and other accepted model  
6 instructions. This District's model rule is designed to be used in cases where both lost profits  
7 and reasonable royalties may be sought. Since TPL only seeks a reasonable royalty, Plaintiffs'  
8 instruction is more narrowly tailored to that end. Plaintiffs' instruction accurately reflects the  
9 state of the law concerning damages with respect to a reasonable royalty.

10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28



1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**17. REASONABLE ROYALTY – ENTITLEMENT**

For damages in these cases, TPL seeks only a reasonable royalty for the infringement of their two patents. If you determine that any products sold by either Acer, Gateway or HTC infringed any valid claims of the '336 patent or the '890 patent, then TPL should be awarded a reasonable royalty for all sales associated with each such product infringing a particular patent.

1 Authorities

2 N.D. Cal. Model Patent Jury Instruction § 5.6; 35 U.S.C. § 284; Crystal Semiconductor Corp.  
3 v. Tritech Microelectronics Int'l, Inc., 246 F.3d 1336 (Fed. Cir. 2001); Fromson v. Western  
4 Litho Plate & Supply Co., 853 F.2d 1568, 1574 (Fed. Cir. 1998) (overruled on other grounds);  
5 Minco, Inc. v. Combustion Eng'g, Inc., 95 F.3d 1109, 1119-20 (Fed. Cir. 1996); Mahurkar v.  
6 C.R. Bard, Inc., 79 F.3d 1572, 1579 (Fed. Cir. 1996); Rite-Hite Corp. v. Kelley Co., 56 F.3d  
7 1538, 1554 (Fed. Cir. 1995) (en banc).

6

7

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28

1       **18.     REASONABLE ROYALTY – DEFINITION [CHALLENGED INSTRUCTION]**

2             A royalty is a payment or series of payments made to a patent holder in exchange for the  
3 right to make, use or sell the claimed invention. This right is called a “license.”

4             A reasonable royalty is the payment for the license that would have resulted from a  
5 hypothetical negotiation between the patent holder and the infringer taking place at the time  
6 when the infringing activity first began. In considering the nature of this negotiation, you must  
7 assume that the patent holder and the infringer would have acted reasonably and would have  
8 entered into a license agreement. You must also assume that both parties believed the patent was  
9 valid and infringed. Your role is to determine what the result of that negotiation would have  
10 been. The reasonable royalty you determine must be a royalty that would have resulted from an  
11 arms-length negotiation between a willing licensee and willing licensor, and not simply a royalty  
12 either party would have preferred.

13             A royalty can be calculated in several different ways and it is for you to determine  
14 which way is the most appropriate based on the evidence you have heard. One way to  
15 calculate a royalty is to determine what is called an “ongoing royalty.” To calculate an  
16 ongoing royalty, you must first determine the “base,” that is, the product on which the infringer  
17 is to pay. You then need to multiply the revenue the defendant obtained from that base by the  
18 “rate” or percentage that you find would have resulted from the hypothetical negotiation. For  
19 example, if the patent covers a nail, and the nail sells for \$1, and the licensee sold 200 nails, the  
20 base revenue would be \$200. If the rate you find would have resulted from the hypothetical  
21 negotiation is 1%, then the royalty would be \$2, or the rate of .01 times the base revenue of  
22 \$200.

23             If the patent covers only part of the product that the infringer sells, then the base would  
24 normally be only that feature or component. For example, if you find that for a \$100 car, the  
25 patented feature is the tires which sell for \$5, the base revenue would be \$5. However, in a  
26 circumstance in which the patented feature is the reason customers buy the whole product, the  
27 base revenue could be the value of the whole product. Even if the patented feature is not the  
28

1 reason for customer demand, the value of the whole product could be used if, for example, the  
2 value of the patented feature could not be separated out from the value of the whole product.  
3 In such a case, however, the rate resulting from the hypothetical negotiation would be a lower  
4 rate because it is being applied to the value of the whole product and the patented feature is not  
5 the reason for the customer's purchase of the whole product.

6 A second way to calculate a royalty is to determine a one-time lump sum payment that  
7 the infringer would have paid at the time of the hypothetical negotiation for a license covering  
8 all sales of the licensed product both past and future. This differs from payment of an ongoing  
9 royalty because, with an ongoing royalty, the licensee pays based on the revenue of actual  
10 licensed products it sells. When a one-time lump sum is paid, the infringer pays a single price  
11 for a license covering both past and future infringing sales.

12 It is up to you, based on the evidence, to decide what type of royalty is appropriate in  
13 this case. Remember, however, you may only award reasonable royalty damages for any  
14 infringement — direct or indirect — you have found occurred according to the instructions I  
15 have provided throughout these instructions and only for the period after infringement began  
16 and after the infringer received notice of the patent.

1 Authorities

2 N.D. Cal. Model Patent Jury Instruction § 5.7, which cites *Golight, Inc., v. Wal-Mart Stores,*  
3 *Inc.*, 355 F.3d 1327, 1338 (Fed. Cir. 2004); *Maxwell v. Baker, Inc.*, 86 F.3d 1098, 1108-10  
4 (Fed. Cir. 1996); *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1579-81 (Fed. Cir. 1996); *Rite-*  
5 *Hite Corp. v. Kelley Co.*, 56 F.3d 1538, 1554 (Fed. Cir. 1995) (en banc); *Georgia-Pacific*  
6 *Corp. v. United States Plywood Corp.*, 318 F. Supp. 1116, 1120 (S.D.N.Y. 1970); *Apple, Inc.*  
7 *v. Samsung Elecs. Co., Ltd.*, Case No. 11-01846-LHK (N.D. Cal., Aug. 21, 2012); *Oracle*  
8 *America, Inc. v. Google Inc.*, 798 F.Supp.2d 1111, 1121 (N.D.Cal. 2011) (“While the patents  
9 holder had the infringer ‘over the barrel’ due to infringement that later occurred and, therefore,  
10 could extract a premium.”)  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1 **DEFENDANTS' OBJECTIONS AND ALTERNATIVE INSTRUCTION:**

2 Although HTC initially proposed an instruction that followed the model instruction,  
3 Plaintiffs now add a new third paragraph and additional language at the end of the last  
4 paragraph that are not found in the model instruction. Defendants object to these additions  
5 because they change the balance of the instruction and are an incorrect formulation of law.  
6 Accordingly, Defendants' propose using the model instruction, as Defendants and HTC  
7 initially proposed.

8  
9 **18. REASONABLE ROYALTY – DEFINITION DEFENDANTS' ALTERNATIVE**  
10 **INSTRUCTION**

11 A royalty is a payment made to a patent holder in exchange for the right to make, use or  
12 sell the claimed invention. This right is called a "license." A reasonable royalty is the payment  
13 for the license that would have resulted from a hypothetical negotiation between the patent holder  
14 and the infringer taking place at the time when the infringing activity first began. In considering  
15 the nature of this negotiation, you must assume that the patent holder and the infringer would have  
16 acted reasonably and would have entered into a license agreement. You must also assume that  
17 both parties believed the patent was valid and infringed. Your role is to determine what the result  
18 of that negotiation would have been. The test for damages is what royalty would have resulted  
19 from the hypothetical negotiation and not simply what either party would have preferred.

20 A royalty can be calculated in several different ways and it is for you to determine which  
21 way is the most appropriate based on the evidence you have heard. One way to calculate a royalty  
22 is to determine what is called an "ongoing royalty." To calculate an ongoing royalty, you must  
23 first determine the "base," that is, the product on which the infringer is to pay. You then need to  
24 multiply the revenue the defendant obtained from that base by the "rate" or percentage that you  
25 find would have resulted from the hypothetical negotiation. For example, if the patent covers a  
26 nail, and the nail sells for \$1, and the licensee sold 200 nails, the base revenue would be \$200. If  
27  
28

1 the rate you find would have resulted from the hypothetical negotiation is 1%, then the royalty  
2 would be \$2, or the rate of .01 times the base revenue of \$200.

3 If the patent covers only part of the product that the infringer sells, then the base would  
4 normally be only that feature or component. For example, if you find that for a \$100 car, the  
5 patented feature is the tires which sell for \$5, the base revenue would be \$5. However, in a  
6 circumstance in which the patented feature is the reason customers buy the whole product, the base  
7 revenue could be the value of the whole product. Even if the patented feature is not the reason for  
8 customer demand, the value of the whole product could be used if, for example, the value of the  
9 patented feature could not be separated out from the value of the whole product. In such a case,  
10 however, the rate resulting from the hypothetical negotiation would be a lower rate because it is  
11 being applied to the value of the whole product and the patented feature is not the reason for the  
12 customer's purchase of the whole product.

13 A second way to calculate a royalty is to determine a one-time lump sum payment that the  
14 infringer would have paid at the time of the hypothetical negotiation for a license covering all sales  
15 of the licensed product both past and future. This differs from payment of an ongoing royalty  
16 because, with an ongoing royalty, the licensee pays based on the revenue of actual licensed  
17 products it sells. When a one-time lump sum is paid, the infringer pays a single price for a license  
18 covering both past and future infringing sales.

19 It is up to you, based on the evidence, to decide what type of royalty is appropriate in this  
20 case.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 5.7, which cites *Golight, Inc., v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1338 (Fed. Cir. 2004); *Maxwell v. 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); *Georgia-Pacific Corp. v. United States Plywood Corp.*, 318 F. Supp. 1116, 1120 (S.D.N.Y. 1970).



1 **PLAINTIFFS' RESPONSE AND OBJECTIONS TO DEFENDANTS' ALTERNATIVE**  
2 **INSTRUCTION:**

3 TPL's claim that this was not initially proposed is inaccurate as a similar instruction  
4 was included in Acer/Gateway's proposed instructions served on August 15, 2013. Plaintiffs'  
5 proposed instruction is based on this District's model instruction and includes additional  
6 language that will provide further clarification to the jury regarding what a reasonable royalty  
7 is and how it is determined. Plaintiffs' believe that their modifications will assist the jury and  
8 reduce the likelihood of jury confusion.

9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28



1 on them in your deliberations.

2 Each of the Acer and Gateway and HTC accused products is made up of many features  
3 and components, and the accused technology is one component of many in complex products.  
4 Therefore, for each of the accused products, damages cannot be calculated on the entire market  
5 value of the whole accused product for the reason that the entire value of the whole product, as a  
6 marketable article, is not properly attributable to the patented feature. Any award of damages  
7 must be based on evidence of the separate value of the patented feature. In making this  
8 determination, if any, you should consider the value attributable to the use of the patented feature  
9 and value attributable to the unpatented features. You may only award damages for the value of  
10 the patented feature. Such award must be based on reliable and tangible evidence that is not  
11 conjectural or speculative. But, if a patent is infringed, the patentee is entitled to a reasonable  
12 royalty.]

1 Authorities

2 *LaserDynamics, Inc. v. Quanta Computer, Inc.*, 694 F.3d 51, 67-68 (Fed. Cir. 2012); *Uniloc*  
3 *USA, Inc. v. Microsoft Corp.*, 632 F.3d 1292, 1320-21 (Fed. Cir. 2011); *Lucent Techs., Inc. v.*  
4 *Gateway, Inc.*, 580 F.3d 1301 (Fed. Cir. 2009); *Brocade Communications Systems, Inc. v. A10*  
5 *Networks, Inc.*, No. C 10-3428 PSG, 2013 WL 831528 (N.D.Cal. Jan, 10, 2013); *Multimedia*  
6 *Patent Trust v. Apple Inc.*, NO. 10-CV-2618-H KSC, 2012 WL 8435344 (S.D.Cal. Dec. 13,  
7 2012) (Final Jury Instruction No. 33); *U.S. Philips Corp. v. Eastman Kodak Co.*, NO. CIV. A.  
8 06-251 GMS, 2008 WL 1983135 (D.Del. Mar. 4, 2008) (Final Jury Instruction No. 6.3); *Lucent*  
9 *Tech. Inc. v. Gateway, Inc.*, 2008 WL 1896155 (S.D.Cal. Feb. 19, 2008) (Final Jury Instruction  
10 No. 6.4) *Koito Manf. Co., Ltd., v. Turn-Key-Tech, LLC*, 2003 WL 25754349 (S.D. Cal. Apr 7,  
11 2003) (Final Jury Instruction No. 50); Uniform Jury Instructions For Patent Cases In The United  
12 States District Court For The District Of Delaware 5.6 (1993).  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1 **DEFENDANTS' OBJECTIONS:**

2           This instruction is not in the model instructions. It sews confusion because it does not  
3 fit in with the other instructions based on the model rules and because it is long and legalistic.  
4 At the same time, the instruction does not accurately reflect current law on the EMVR. In  
5 addition, HTC did not propose an instruction on the EMVR initially and Acer has argued in its  
6 Daubert motion that the issue is ripe for the Court to decide as a matter of law. Therefore, it  
7 should not be put to the jury. Defendants object to the inclusion of this instruction in its  
8 entirety. If the Court is inclined to include an instruction on the EMVR, Defendants request  
9 the opportunity to brief the issue—something they could not have done in time for this  
10 submission in light of co-pending pretrial deadlines.

11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1 **PLAINTIFFS' RESPONSE AND OBJECTIONS TO DEFENDANTS' ALTERNATIVE**  
2 **INSTRUCTION:**

3         Since Plaintiffs served their rebuttal expert reports on damages, TPL has known that  
4 there would be a dispute over whether it is entitled to invoice the EMVR. TPL therefore had  
5 ample opportunity to propose an EMVR instruction. This EMVR instruction was also in  
6 Acer/Gateway's proposed instructions served on August 15, 2013. Thus, TPL's claim of lack  
7 of notice and request for further briefing is untenable.

8         As detailed in Plaintiffs' *Daubert* motions, TPL improperly seeks to rely upon the  
9 entire market value rule without showing that the smallest saleable unit, the accused chips,  
10 primarily drives consumer demand for the entire end-products. As there is no dispute that the  
11 accused products contain multiple non-accused features and components, the teachings of  
12 *LaserDynamics, Inc. v. Quanta Computer, Inc.*, 694 F.3d 51 (Fed. Cir. 2012) are applicable  
13 here and justify the inclusion of this instruction.

14         Finally, this instruction is consistent with the most recent Federal Circuit opinions on  
15 the determination of damages in multi-component/multi-feature products and that the EMVR  
16 does not apply unless the patentee makes the requisite showing of customer demand. This  
17 instruction is based on those used by other district courts and provided in widely-cited model  
18 instructions. Plaintiffs provided bracketed parts that would be chosen at the Court's discretion  
19 depending on how it rules on Plaintiffs' *Daubert* motions.



1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

*AIPLA Model Patent Jury Instructions*, No. 11.19 (2012); *American Seating Co. v. USSC Group, Inc.*, 514 F.3d 1262 (Fed. Cir. 2008); *Mars, Inc. v. Coin Acceptors, Inc.*, 527 F.3d 1359, 1372-73 (Fed. Cir. 2008); *Riles v. Shell Exploration and Production Co.*, 298 F.3d 1302, 1312 (Fed. Cir. 2002); *Grain Processing Corp. v. Am. Maize-Prods. Co.*, 185 F.3d 1341, 1349 (Fed. Cir. 1999).



1 **DEFENDANTS' OBJECTIONS:**

2           This is another example of an instruction that HTC did not initially propose and that  
3 cannot be found in the Northern District model instructions. Defendants object to the  
4 instruction in its entirety because it reargues expert opinions in the form of a jury instruction  
5 and broadly misstates the law regarding noninfringing alternatives. In addition, it would lead  
6 to confusion on the part of the jury because it unduly elevates one of many factors that are to  
7 be considered in a reasonable royalty analysis. Because the experts will testify regarding the  
8 reasonable royalty analysis, it is unnecessary to call out one factor in that analysis in a separate  
9 jury instruction. If the Court is inclined to include an instruction on acceptable noninfringing  
10 alternatives, Defendants request the opportunity to brief the issue—something they could not  
11 have done in time for this submission in light of co-pending pretrial deadlines.

12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1 **PLAINTIFFS' RESPONSE AND OBJECTIONS TO DEFENDANTS' ALTERNATIVE**  
2 **INSTRUCTION:**

3           Since Plaintiffs served their rebuttal expert reports on damages, TPL has known that  
4 Plaintiffs would rely upon non-infringing alternatives. TPL therefore had ample opportunity to  
5 propose such an instruction. This non-infringing alternative instruction was also included in  
6 Acer/Gateway's proposed instructions served on August 15, 2013. Thus, TPL's claim of lack  
7 of notice and request for further briefing is untenable.

8           This instruction is consistent with controlling Federal Circuit case law. This instruction  
9 is based such authority and a widely-recognized model instruction. The issue of non-infringing  
10 alternatives is particularly important because of the accused chips/components make up a small  
11 part of the accused products, and in some cases, have non-infringing or licensed substitutes.



1 as owned and produced by the licensor, and the benefits to those who have used the  
2 invention.

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

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

8 13) The portion of the realizable profits that should be credited to the invention as  
9 distinguished from non-patented elements, the manufacturing process, business risks, or  
10 significant features or improvements added by the infringer.

11 14) The opinion and testimony of qualified experts.

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

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

28

1 Authorities

2 Federal Circuit Bar Association Model Patent Jury Instruction § 6.7, which cites several cases  
3 including, *Georgia-Pacific Corp. v. U.S. Plywood Corp.*, 318 F. Supp. 1116, 1120 (S.D.N.Y.  
4 1970).  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1 **DEFENDANTS' OBJECTIONS:**

2 This is yet another example of an instruction that HTC did not initially propose and that  
3 cannot be found in the Northern District model instructions. It is not included in the model  
4 instructions for a reason—it invites the jury to perform an independent reasonable royalty  
5 analysis, which something that should be done by a qualified expert. Further, the long and  
6 legalistic recitation of the *Georgia-Pacific* factors in this instruction are more likely to confuse  
7 than assist the jury in reaching its decision regarding a reasonable royalty.

8  
9 **PLAINTIFFS' RESPONSE AND OBJECTIONS TO DEFENDANTS' ALTERNATIVE**  
10 **INSTRUCTION:**

11 TPL's objection is entirely meritless. This instruction was included in pages 44-46 of  
12 HTC's proposed jury instructions and pages 43-45 of Acer's proposed jury instructions served  
13 last week. This instruction comes from the Fed. Circuit Bar Association and has been used in  
14 numerous other patent cases. Since all of the parties' respective damages experts rely upon  
15 *Georgia-Pacific* in determining a reasonable royalty, the jury should have an instruction to  
16 ensure that they understand how to make such a determination. Contrary to TPL, this will  
17 reduce jury confusion.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**22. INTEREST [CHALLENGED INSTRUCTION]**

None of the parties' calculations include interest. Therefore, in arriving at your damages calculation, you should not consider interest in any way because it is the job of the Court to award interest.

Authorities

*Tarkus Imaging, Inc. v. Adobe Sys., Inc.*, Case No. 10-cv-063-LPS, 2012 WL 3868139 (D. Del., June 27, 2012), (Final Jury Instruction No. 5.5)(citing Uniform Delaware Patent Jury Instructions § 5.15 (2004).

1 **DEFENDANTS' OBJECTIONS:**

2 This is another example of an instruction that HTC did not initially propose and that  
3 cannot be found in the Northern District model instructions. The instruction is not needed  
4 because the jury will not be asked to include interest in the verdict form. Injecting an  
5 unnecessary issue into the jury instructions could potentially confuse the jury.

6  
7  
8 **PLAINTIFFS' RESPONSE AND OBJECTIONS TO DEFENDANTS' ALTERNATIVE**  
9 **INSTRUCTION:**

10 TPL's objection to this instruction is meritless. This cautionary instruction comes from  
11 the Uniform Delaware Patent Jury Instructions and has been used in numerous other patent  
12 cases. TPL does not adequately explain how such an instruction is prejudicial or would  
13 confusion the jury. To the contrary, it is helpful and will reduce potential confusion and error  
14 in the determination of damages. TPL's claim that this was not initially proposed is inaccurate  
15 as this was included in Acer/Gateway's proposed instructions served on August 15, 2013.

16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28



1           **23.    DATE OF COMMENCEMENT<sup>7</sup> [CHALLENGED INSTRUCTION]**

2           The damages that you may award TPL commence on the date that Acer and Gateway and  
3 HTC each respectively have infringed and also been notified of the patent or patents each  
4 infringed.

5           Actual notice is effective from the time it is given. The initiation of a patent  
6 infringement lawsuit can constitute notice of TPL's patent rights. However, TPL can also  
7 provide notice of its patent is by an affirmative communication of a specific charge of  
8 infringement by a specific product or device sold by an accused infringer, such as Acer,  
9 Gateway or HTC, prior to filing a lawsuit. It is TPL's burden to prove that it is more probable  
10 than not that it gave sufficient notice to Acer and Gateway and HTC of their alleged  
11 infringement of a particular patent.

12           **HTC**

13           TPL contends that HTC has known about the asserted patents since November 7, 2006.  
14 HTC contends that TPL provided notice of the '336 patent no earlier than November 7, 2006.  
15 HTC contends that there is no evidence that HTC was placed on notice of the '890 patent prior  
16 to TPL's filing of the countersuit against HTC.

17           **Acer/Gateway**

18           [The actual notice requirement is not satisfied merely by TPL providing notice of the  
19 existence or its ownership of the '336 patent and the '890 patent. A general reference to  
20 "products" infringing a patent or the fact that there is an ongoing litigation with unrelated  
21 accused infringers is insufficient to put Acer and Gateway on actual notice. Likewise, TPL  
22 merely referring to a patent being part of a larger portfolio of patents is not considered being  
23 actual notice.

24           Your focus should be solely on whether TPL's actions, under the circumstances, not the  
25 knowledge or understanding of Acer or Gateway. To serve as actual notice, a letter must be  
26 sufficiently specific to support an objective understanding that the recipient may be an

27 \_\_\_\_\_  
28 <sup>7</sup> This instruction is dependent on how the Court rules on Plaintiffs' Motion for Summary Judgment regarding the Appropriate Damages Period.

1 infringer Whether or not Acer or Gateway subjectively believed that a letter constituted a  
2 charge of infringement has no bearing on the adequacy of notice. You should look at all  
3 relevant communications by to determine when sufficient notice was provided by TPL.

4 The parties dispute when Acer and Gateway received notice of the '336 patent. TPL  
5 contends that both Acer and Gateway received notice on April 21, 2004, and in the alternative  
6 on May 24, 2004. Acer/Gateway contends that Gateway could not have received adequate  
7 notice of its alleged infringement of the '336 patent any earlier than April 5, 2006. Similarly,  
8 Acer/Gateway contends that Acer could not have received adequate notice of its alleged  
9 infringement of the '336 patent prior to April 17, 2006.

10 The parties also dispute when Acer and Gateway received notice of the '890 patent.  
11 TPL contends that both Acer and Gateway received actual notice on April 21, 2004, and in the  
12 alternative on May 24, 2004. Acer/Gateway contends that Acer and Gateway could not have  
13 received adequate notice of its alleged infringement of the '890 patent prior to June 4, 2008  
14 when TPL filed its complaint in the U.S. District Court for Eastern District of Texas.

15 You must decide whether TPL has met is burden of proof that it gave sufficient notice  
16 to Acer and Gateway of the `336 and the '890 patent.]

17 *Or, alternatively,*

18 [In this case, TPL asserts that Gateway did not receive adequate notice of its alleged  
19 infringement of the '336 patent until April 5, 2006 and Acer did not receive adequate notice of  
20 its alleged infringement of the '336 patent until April 17, 2006. Acer/Gateway did not receive  
21 notice of the '890 patent until it was served with TPL's complaint filed in the U.S. District  
22 Court for Eastern District of Texas on June 4, 2009.]

23 *Or, alternatively,*

24 [While you may identify an earlier date by which Acer and Gateway had actual notice  
25 of TPL's claims of infringement based on your evaluation of the evidence, Acer is considered  
26 to have had such notice of the '336 patent no later than November 21, 2008 when TPL filed its  
27 infringement claims against Acer. Likewise, Acer/Gateway is considered to have such notice  
28

1 of the '890 patent no later than when served with TPL's complaint filed in the U.S. District  
2 Court for Eastern District of Texas on June 4, 2009.]

3

4

5

6

7

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

27

28

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 5.8, which cites 35 U.S.C. § 287; *Crystal Semiconductor Corp. v. Tritech Microelectronics Int’l, Inc.*, 246 F.3d 1336 (Fed. Cir. 2001); *Nike Inc. v. Wal-Mart Stores*, 138 F.3d 1437, 1443-44 (Fed. Cir. 1998); *Maxwell v. Baker, Inc.*, 86 F.3d 1098, 1111-12 (Fed. Cir. 1996); *American Med. Sys. v. Medical Eng’g Corp.*, 6 F.3d 1523, 1534 (Fed. Cir. 1993); *Devices for Med., Inc. v. Boehl*, 822 F.2d 1062, 1066 (Fed. Cir. 1987); *Amsted Indus. Inc. v. Buckeye Steel Castings Co.*, 24 F.3d 178, 187 (Fed. Cir. 1994); *Funai Elec. Co., Ltd. v. Daewoo Electronics Corp.*, 616 F.3d 1357 1329 (Fed.Cir. 2010).

1 **DEFENDANTS' OBJECTIONS AND ALTERNATIVE INSTRUCTION:**

2 The Northern District model instruction on date of commencement is simple and brief.  
3 HTC's initial propose instruction followed the model instruction. Plaintiffs' current proposed  
4 construction, is at least 4-5 time longer than the model instruction and is confusing. Further, it  
5 needlessly introduces legal concepts that are not necessary to Jury's deliberations and pieces  
6 them together in away that is contrary to the current state of the law. For these reasons,  
7 Defendants propose using the instruction HTC initially proposed (which follows the Northern  
8 District model instruction) with one exception—Defendants propose inserting the words “or  
9 product categories” in the last sentence of the instruction, consistent with the state of the law,  
10 as discussed in conjunction with Acer's motion for summary judgment regarding the proper  
11 damages period.

12  
13 **23. DATE OF COMMENCEMENT DEFENDANTS' ALTERNATIVE**  
14 **INSTRUCTION**

15 Damages that TPL and Patriot may be awarded by you commence on the date that  
16 Acer/Gateway and HTC have both infringed and been notified of the '336 patent and the '890  
17 patent.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 5.8, which cites 35 U.S.C. § 287; *Crystal Semiconductor Corp. v. Tritech Microelectronics Int'l, Inc.*, 246 F.3d 1336 (Fed. Cir. 2001); *Nike Inc. v. Wal-Mart Stores*, 138 F.3d 1437, 1443-44 (Fed. Cir. 1998); *Maxwell v. Baker, Inc.*, 86 F.3d 1098, 1111-12 (Fed. Cir. 1996); *American Med. Sys. v. Medical Eng'g Corp.*, 6 F.3d 1523, 1534 (Fed. Cir. 1993); *Devices for Med., Inc. v. Boehl*, 822 F.2d 1062, 1066 (Fed. Cir. 1987).

1 **PLAINTIFFS' RESPONSE AND OBJECTIONS TO DEFENDANTS' ALTERNATIVE**  
2 **INSTRUCTION:**

3 Plaintiffs' proposed instruction (originally included in Acer/Gateway's proposed  
4 instructions served on August 15, 2013) is based on this District's model instruction and  
5 addresses the specific factual issues that are unique for this case. Plaintiffs' instruction is also  
6 consistent with the briefing presented on Plaintiffs' Motions for Summary Judgment on the  
7 issue of damages and accurate reflects the current state of the law on notice. Plaintiffs'  
8 instruction also provides optional language that hinges on how the Court rules on Plaintiffs'  
9 motion. The parties' briefing on this motion narrowed and framed the notice issues. Thus,  
10 there is no reason to do so in this jury instruction to assist the jury and reduce the chances of  
11 confusion.

12 TPL's alternative instruction is also vague and may mislead the jury. In particular,  
13 TPL's instruction introduces the concept of marking, which is not at issue. TPL has conceded  
14 that it did not sell products marked with either patent-in-suit or otherwise provided  
15 constructive notice. TPL also ignores that it conceded that Acer/Gateway could not have  
16 received notice prior to April 21, 2004. The inclusion of that limitation will reduce the chance  
17 for confusion and error.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**24. CALCULATING DAMAGES IN CASES OF INDUCEMENT**

In order to recover damages for induced infringement, TPL must either prove that the accused devices necessarily infringe the '336 patent and the '890 patent or prove acts of direct infringement by others that were induced by Acer, Gateway or HTC. Because the amount of damages for induced infringement is limited by the number of instances of direct infringement, TPL must further prove the number of direct acts of infringement of the '336 and the '890 patent—for example, by showing individual acts of direct infringement or by showing that a particular type of Acer, Gateway or HTC products or uses directly infringes.



1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Authorities

N.D. Cal. Model Patent Jury Instruction § 5.9, which cites *Dynacore Holdings Corp. v. U.S. Philips Corp.*, 363 F.3d 1263 (Fed. Cir. 2004); *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 576 F.3d 1348 (Fed. Cir. 2009).

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1 Dated: August 21, 2013

Respectfully submitted,

2 K&L GATES LLP

3  
4 By: /s/ Michael J. Bettinger

5 Michael J. Bettinger, Esq. SBN 122196  
6 Mike.bettinger@klgates.com  
7 Timothy P. Walker, Esq. SBN 105001  
8 Timothy.walker@klgates.com  
9 Harold H. Davis, Jr., Esq. SBN 235552  
10 Harold.davis@klgates.com  
11 Four Embarcadero Center, Suite 1200  
12 San Francisco, CA 94111  
13 Phone: (415) 882-8200  
14 Fax: (415) 882-8220

11 Attorneys for Plaintiffs and Counter-  
12 Defendants  
13 ACER, INC., ACER AMERICA  
14 CORPORATION, and GATEWAY, INC.

15  
16 COOLEY LLP

17 By: /s/ Kyle D. Chen

18 Heidi L. Keefe, Esq. SBN 178960  
19 hkeefe@cooley.com  
20 Mark R. Weinstein, Esq. SBN 193043  
21 mweinstein@cooley.com  
22 Kyle D. Chen, Esq. SBN 239501  
23 kyle.chen@cooley.com  
24 3000 El Camino Real  
25 Five Palo Alto Square, 4th Floor  
26 Palo Alto, California 94306  
27 Phone: (650) 843-5000  
28 Fax: (650) 857-0663

Attorneys for Plaintiffs  
HTC CORPORATION and HTC AMERICA,  
INC.

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

AGILITY IP LAW, LLP

By: /s/ Thomas T. Carmack

James C. Otteson, Esq. SBN 157781  
jim@agilityiplaw.com  
Thomas T. Carmack, Esq. SBN 229324  
tom@agilityiplaw.com  
Philip W. Marsh, Esq. SBN 76383  
phil@agilityiplaw.com  
David Lansky, Esq. SBN 199952  
dlansky@agilityiplaw.com  
149 Commonwealth Drive  
Menlo Park, California 94025  
Phone: (650) 227-4800  
Fax: (650) 318-3483

Attorneys for Defendants  
TECHNOLOGY PROPERTIES LIMITED  
LLC and PHOENIX DIGITAL SOLUTIONS  
LLC

KIRBY NOONAN LANCE & HOGE LLP

By: /s/ Charles T. Hoge

Charles T. Hoge, Esq. SBN 110696  
choge@knlh.com  
35 Tenth Avenue  
San Diego, California 92101  
Phone: (619) 231-8666  
Fax: (619) 231-9593

Attorneys for Defendants  
PATRIOT SCIENTIFIC CORPORATION

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**FILER’S ATTESTATION PURSUANT TO L.R. 5-1(i)(3)**

I, Michael J. Bettinger, am the ECF User whose ID and password are being used to file “JOINT PROPOSED JURY INSTRUCTIONS” I hereby attest that concurrence in the filing of this document has been obtained from each of the other signatories.

Dated: August 22, 2013

By: /s/ Michael J. Bettinger