

# **Model Patent Jury Instructions**

**prepared by**

**The National Jury Instruction Project**

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**For Comment**

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## **INTRODUCTION**

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

The following instructions are the result of the project. These instructions will not be endorsed by the Federal Circuit Court of Appeals and are not intended to be "official" jury instructions. Nor is any particular member of this Committee endorsing any particular instruction. These instructions are intended to be helpful models for judges and lawyers. In devising this set of instructions, we have looked to and drawn from the work of others, including the committees for the Northern District of California, The Federal Circuit Bar Association, the AIPLA, and the District of Delaware. Judges and lawyers who use these instructions will need to supplement them with instructions that speak generally to the trial and the jury's duties, such as the nature of the evidence and the duty to deliberate, and will have to tailor them to the facts and issues in the particular case.

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

These instructions will need to be updated to incorporate developments in the law. If you have comments, corrections, or suggested changes, please send them to [PatentJuryInstructions@gmail.com](mailto:PatentJuryInstructions@gmail.com)

# **1 PRELIMINARY INSTRUCTIONS**

## **1.1 WHAT A PATENT IS AND HOW ONE IS OBTAINED**

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

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

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

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

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

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

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

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

Just because the PTO grants a patent does not necessarily mean that any invention claimed in the patent is, in fact, legally entitled to the protection of a patent. For example, the examiner may not have had available all the information that will be presented to you. A person accused of infringement has the right to argue here in federal court that a claimed invention in the patent is not entitled to patent protection because it does not meet the requirements for a patent. In other words, an accused infringer may defend a suit for patent infringement on the grounds that the patent is invalid.

**Committee Note:**

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

## **1.2 THE PATENT INVOLVED IN THIS CASE**

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

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



### **1.3 THE POSITIONS OF THE PARTIES**

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

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

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

#### **1.4 BURDEN OF PROOF—PREPONDERANCE OF THE EVIDENCE**

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

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

#### **Committee Note:**

Burden of Proof: In these instructions the Committee has adopted “more probable than not” as a statement of the burden of proof. Consequently, Judges and lawyers may find this instruction is not necessary.

## 1.5 BURDEN OF PROOF—CLEAR AND CONVINCING EVIDENCE

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

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

This burden is not the “beyond a reasonable doubt” requirement used in criminal cases, but it is an intermediate burden higher than the preponderance burden.

### **Committee Note:**

Burden of Proof: In these instructions the Committee has adopted “highly probable” as a statement of the burden of proof. Consequently, Judges and lawyers may find this instruction is not necessary.

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

## **1.6 GLOSSARY OF PATENT AND TECHNICAL TERMS**

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

### **Committee Note:**

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

## **GLOSSARY OF PATENT TERMS**

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

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

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

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

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

**Patent examiners** – Personnel employed by the PTO who review (examine) patent applications, each in a specific technical area, to determine whether the claims of a patent application are patentable.

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

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

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

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

## **2 FINAL JURY INSTRUCTIONS**

### **2.1 CONTENTIONS OF THE PARTIES**

[The patent holder] contends that [the alleged infringer] makes, uses, offers to sell, or sells a [[product] [method]] that infringes [claim(s) in dispute] of the [XXX] patent.

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

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

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

**Committee Notes:**

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

In these instructions I will use the term “infringe” or “infringement” to describe a liability for 1) making, using or selling a product or process that has each of the requirements of a claim of another’s patents, when 2) the claims are valid and enforceable. In this case, the first part of this definition is not in issue: [the alleged infringer] makes, uses or sells [ ] which has each of the requirements of claim[s] [ ] of [patent holder]’s [XXX] patent. The parties dispute the second part of this definition, whether the claim of the [XXX] is valid.

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

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



### **3 INFRINGEMENT**

#### **3.1 DIRECT INFRINGEMENT—GENERALLY**

[The patent holder] alleges that [the alleged infringer] directly infringes claims [ ] of the [XXX] patent.

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

### 3.2 DIRECT INFRINGEMENT—LITERAL INFRINGEMENT

I will tell you shortly what certain language of the claims means.

You must decide whether [the alleged infringer] has made, used, sold, offered for sale, or imported within the United States a product [method] covered by claim [ ] of the [XXX] patent. You must compare each claim, as I have interpreted it, to [the alleged infringer]'s product [method] to determine whether every requirement of the claim can be found in the accused product [method].

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

[The patent holder] is not required to prove that [the alleged infringer] intended to infringe or had actual knowledge of the patent. An alleged infringer may still directly infringe even though it believes in good faith that what it is doing is not an infringement of the patent.

#### **Committee Note:**

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

### **3.3 THE MEANING OF CLAIM TERMS**

I have decided the correct construction or meaning of certain words in the patent claims. During your deliberations you should read and apply those words as having the following meaning:

### 3.4 OPEN-ENDED OR “COMPRISING” CLAIMS

The beginning, or preamble, to claim(s) [ ] use(s) the word “comprising<sup>2</sup>” “Comprising” means “including” or “containing but not limited to.” That is, if you find that [the alleged infringer]’s product [method] includes all the [steps] in claim [ ], the claim is infringed. That the accused product [method] might include additional components [steps] does not avoid infringement.<sup>3</sup>

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

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<sup>2</sup> CIAS, Inc. v. Alliance Gaming Corp., \_\_\_ F.3d \_\_\_, 2007 WL 2791695 (Fed. Cir. 2007) (holding that “comprised of” has the same open-ended meaning as “comprising.”)

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

### 3.5 “CONSISTING ESSENTIALLY OF” CLAIMS

The beginning of claim [ ] uses the phrase “consisting essentially of.” “Consisting essentially of” means that the claimed invention may include requirements that are not expressly listed in the claim, provided those additional requirements do not materially affect the basic and novel properties of the invention as I have defined them. In other words, patent claims that include the language “consisting essentially of” will be infringed only if [the patent holder] proves that any requirements [steps] added by [the alleged infringer] beyond those in the claim(s) do not materially affect the basic and novel features of the claimed invention.<sup>4</sup>

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<sup>4</sup> AK Steel Corp. v. Sollac & Ugine, 344 F.3d 1234, 1239 (Fed. Cir. 2002); CIAS, Inc., 2007 WL 2791695 at \*4.

### 3.6 “CONSISTING OF” CLAIMS

The beginning of claim [ ] uses the phrase “consisting of.” “Consisting of” means that the claimed invention contains only what is expressly stated in the claim. But it does not limit aspects unrelated to the invention. Patent claim(s) using the phrase “consisting of” will be infringed only if you find [the alleged infringer]’s product [method] includes all the requirements [steps] stated in the patent claim and does not include any additional requirements [steps] unless those additional requirements [steps] are unrelated to the invention.<sup>5</sup>

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<sup>5</sup> Norian Corp. v. Stryker Corp., 363 F.3d 1321, 1331 (Fed. Cir. 2004). Impurities that a person of ordinary skill in the art would ordinarily associate with a requirement on the “consisting of” list do not exclude the accused product or process from infringement. See Conoco v. Energy, 460 F.2d 1349 (Fed. Cir. 2006).

### **3.7 INFRINGEMENT OF DEPENDENT CLAIMS**

So far, my instructions on infringement have related to what are known as independent claims. The patent also contains dependent claims. A dependent claim includes each of the requirements of the independent claim to which it refers, plus additional requirements.

If you find that independent claim [ ] of the [XXX] patent has been infringed, in order to find infringement of a dependent claim [ ] you must separately determine whether the dependent claim has also been infringed. If you find that the independent claim is not infringed, then you must find that the dependent claim is not infringed.

### 3.8 DIRECT INFRINGEMENT—DOCTRINE OF EQUIVALENTS

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

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

A claim requirement is present in an accused product [method] under the doctrine of equivalents if the difference between the claim requirement and a corresponding aspect of the accused product [method] is insubstantial. You must determine whether the two requirements are equivalent. In other words, [the patent holder] must prove that the difference between the claim requirement and a corresponding aspect of the accused product [method] is insubstantial. The doctrine of equivalents may not be applied, however, in a way that results in a claim requirement being ignored altogether.

In making this determination, you may consider whether the accused structure [step] performs substantially the same function in substantially the same way to achieve substantially the same result as the requirement in the claimed invention. You may also consider whether people of ordinary skill in the art believed that the structure [step] of the accused product [method] and the requirement recited in the patent claim were interchangeable at the time of the alleged infringement.<sup>6</sup> The proper time for evaluating equivalency—and thus knowledge of

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<sup>6</sup> Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 520 U.S. 17, 117 S.Ct. 1040, 1053 (1997).



interchangeability between requirements—is the time of infringement, not the time the patent was issued. Under the doctrine of equivalents, those of ordinary skill in the art do not have to know of the equivalent when the patent application was filed or when the patent issued. Thus, the inventor need not have foreseen, and the patent need not describe, all potential equivalents to the invention covered by the claims. Also, changes in technique or improvements made possible by technology developed after the patent application is filed may still be equivalent for the purposes of the doctrine of equivalents.<sup>7</sup>

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<sup>7</sup> There are certain limitations on the application of the doctrine of equivalents which a jury should be instructed about on a case-by-case basis. Most notably, some equivalents are barred by prosecution history estoppel. Issues of prosecution history estoppel are questions of law resolved by a judge, not a jury. *See generally Festo Corp. v. Shoketsu Kinzo Kukogyo Kabushiki Co.*, 535 U.S. 722, 733, 122 S.Ct. 1831 (2002); *Festo Corp. v. Shoketsu Kinzo Kukogyo Kabushiki Co.*, 334 F.3d 1359, 1367-1368 (Fed. Cir. 2003) (*en banc*). The doctrine of equivalents may not be used, however, in a way that wholly eliminates a claim element. For example, if a patent states that a claimed device must be nonmetallic, a patent holder may not assert the patent against a metallic device on the ground that a metallic device is equivalent to a nonmetallic device. *Paice LLC v. Toyota Motor Corp.*, \_\_\_ F.3d \_\_\_, 2007 WL 3024994 at \*11 (Fed. Cir. 2007).

### 3.9 DIRECT INFRINGEMENT—MEANS-PLUS-FUNCTION CLAIMS

Some patent claim requirements may describe a “means” [step] for performing a function, rather than describing the structure [act] that performs the function.<sup>8</sup> For example, let’s say that a patent describes a table in which the legs are glued to the tabletop. One way an inventor may claim the table is to recite the tabletop, four legs, and glue between the legs and the tabletop. Another way to claim the table is to recite the tabletop and the legs, but instead of reciting the glue, the inventor recites a “means for securing the legs to the tabletop.” This second type of claim requirement is called a “means-plus-function” requirement. It describes a means for performing the function of securing the legs to the tabletop, rather than expressly reciting the glue.

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

Claims [ ] of the [XXX] patent include means-plus-function requirements. In instructing you about the meaning of a means-plus-function claim requirement, I will tell you, first, the function that each of the means-plus-function claim requirements performs, and second,

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<sup>8</sup> 35 U.S.C. §112, ¶6 (1984) provides: “An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.”

the structure [act] disclosed in the patent specification that corresponds to each means-plus-function requirement.<sup>9</sup>

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

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

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

Two structures [acts] are equivalent if a person of ordinary skill in the art would consider the differences between them to be insubstantial.<sup>10</sup> One way to determine this is to look at whether or not the accused structure [act] performs the identical function in substantially the same way to achieve substantially the same result.<sup>11</sup> Another way is to consider whether people of ordinary skill in the art believed that the structure of the accused product and the structure in the patent were interchangeable at the time the patent was granted by the PTO.<sup>12</sup>

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<sup>9</sup> See Allvoice Computing PLC v. Nuance, \_\_\_ F.3d \_\_\_, 2007 WL 2963933 at \*3-4 (Fed. Cir. 2007) (describing the two-step claim construction of a means-plus-function limitation).

<sup>10</sup> WMS Gaming Inc. v. Int'l Game Tech, 184 F.3d 1339, 1351 (Fed. Cir. 1999) (holding that the disputed issue of substantiality is factual and should be resolved by a jury).

<sup>11</sup> Applied Medical Resources Corp. v. United States, 448 F.3d 1324, 1333 (Fed. Cir. 2006).

<sup>12</sup> See Al-Site Corp. v. VSI Int'l, Inc., 174 F.3d 1308, 1320 (Fed. Cir. 1999) (“An equivalent structure or act under Section 112 cannot embrace technology developed after the issuance of the patent because the literal meaning of a claim is fixed upon issuance.”) However, an “after-arising equivalent” might infringe under the doctrine of equivalents. Id. An equivalence analysis under §112, ¶ 6 and the doctrine of equivalents is not coextensive. For example, §112, ¶6 requires identical, not equivalent function. Chiuminatta Concrete Concepts, Inc. v. (continued...)

### 3.10 INDIRECT INFRINGEMENT

[The patent holder] alleges that [the alleged infringer] indirectly infringed the patent. There are two types of indirect infringement: inducing infringement and contributory infringement. The act of encouraging or inducing others to infringe a patent is called “inducing infringement.” The act of contributing to the infringement of others by, for example, supplying them with components used in the patented invention is called “contributory infringement.”<sup>13</sup>

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Cardinal Indus. Inc., 145 F.3d 1303, 1310-1311 (Fed. Cir. 1998). Moreover, the doctrine of equivalents is determined as of the time of infringement, and equivalence under §112, ¶6 is determined at the time of the issuance of the patent. Nonetheless, the tests for equivalence are closely related. See Warner-Jenkinson, 520 U.S. at 26, 117 S.Ct. at 1048. This is a confusing nook of the law.

<sup>13</sup> See 35 U.S.C. §§271(b) and (c) (1984 & Supp. 2001) respectively.

### 3.11 INDUCING PATENT INFRINGEMENT<sup>14</sup>

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

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

1. [the alleged infringer] actively encouraged or instructed another person on how to [use a product or perform a process] in a way that you, the jury, find infringes the patent claims;
2. [the alleged infringer] knew of the patent;
3. [the alleged infringer] knew or should have known that the encouragement or instructions would induce infringement of the patent; and
4. the other person infringed the patent.

[The patent holder] must prove that [the alleged infringer] had a specific intent to induce the infringement. [The patent holder] must prove that [the alleged infringer] knowingly induced infringement, not merely that [the alleged infringer] knowingly induced the acts that constitute infringement. Finally, [the patent holder] must prove that there is a direct infringement for each instance of indirect infringement.

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<sup>14</sup> 35 U.S.C. §271(b) provides that “[w]hoever actively induces infringement of a patent shall be liable as an infringer.” *See generally* DSU Medical Corp. v. JMSCo. Ltd., 471 F.3d 1293, 1304 (Fed. Cir. 2006).

### 3.12 CONTRIBUTORY INFRINGEMENT<sup>15</sup>

Contributory infringement can occur when a party with knowledge of the patent supplies a part, or a component, to another for use in a patented product or machine, or in a patented process.

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

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

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

Finally, [the patent holder] must prove that there is a direct infringement for each instance of indirect infringement.

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<sup>15</sup> 35 U.S.C. §271(c) (2001) states that:

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

## 4 WILLFUL INFRINGEMENT

### 4.1 WILLFUL INFRINGEMENT

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

The issue of willful infringement relates to the amount of damages [the patent holder] is entitled to recover in this lawsuit. If you decide that [the alleged infringer] willfully infringed [the patent holder]'s patent, then it is my job to decide whether or not to award increased damages to [the patent holder].

To prove willful infringement, [the patent holder] must persuade you that it is highly probable that [before the filing date of the complaint],<sup>16</sup> [the alleged infringer] acted with reckless disregard of the claims of [the patent holder]'s patent. To show "reckless disregard," [the patent holder] must satisfy a two-part test: the first concerns [the alleged infringer]'s conduct, the second concerns [the alleged infringer's] state of mind.

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

If you conclude that [patent holder] has proven that [alleged infringer]'s conduct was reckless, then you need to consider the second part of the test. You must determine whether the

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<sup>16</sup> This bracketed language should ordinarily be included as the Federal Circuit has made clear that, in ordinary circumstances, willfulness will depend on an infringer's prelitigation conduct. In re Seagate Technology, LLC, 2007 U.S. App. LEXIS 19768 (Fed. Cir. Aug. 20, 2007)

risk was known or obvious to [the alleged infringer]. [The patent holder] must persuade you that it is highly probable [the alleged infringer] actually knew (or it was so obvious that [the alleged infringer] should have known) that its actions constituted this high risk of infringement of a valid and enforceable patent. In deciding whether [the alleged infringer] satisfied the state-of-mind part of the test, you should consider all facts surrounding the alleged infringement including, but not limited to, the following:

1. whether [the alleged infringer] acted in a manner consistent with the standards of commerce for its industry;
- h2. whether [the alleged infringer] intentionally copied without a reasonable basis a [product] [method] of [the patent holder] covered by the patent, as distinguished from trying to “design around” the patent by designing a [product] [method] that [the alleged infringer] believed did not infringe the patent.<sup>17</sup>

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<sup>17</sup> 35 U.S.C. § 284: In re Seagate Tech., LLC, 2007 U.S. App. LEXIS 19768 (Fed. Cir. Aug. 20, 2007); Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp., 383 F.3d 1337, 1345 (Fed. Cir. 2004) (*en banc*); Crystal Semiconductor Corp. v. Tritech Microelectronics Int'l, Inc., 246 F.3d 1336, 1346 (Fed. Cir. 2001); WMS Gaming Inc. v. Int'l Game Tech., 184 F.3d 1339, 1354 (Fed. Cir. 1999); Read Corp. v. Portec, Inc., 970 F.2d 816 (Fed. Cir. 1992); Gustafson, Inc. v. Intersystems Indus. Prods., Inc., 897 F.2d 508, 510 (Fed. Cir. 1990); Chiron v. Genentech, 363 F. 3d 1247 (Fed. Cir. 2004).



## 5 INVALIDITY

### 5.1 VALIDITY—GENERALLY

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

I will now instruct you on the invalidity issues you should consider. As you consider these issues, remember that [the alleged infringer] bears the burden of proving that it is highly probable that the claims are invalid.<sup>18</sup>

#### **Committee Note:**

Presumption of Validity. Patents are entitled to a presumption of validity. The presumption of validity, like all legal presumptions, is a procedural device. In light of the procedural role of the presumption of validity, instructing the jury on the presumption in addition to informing it of the highly probable burden of proof may cause jury confusion as to its role in deciding invalidity. This instruction, therefore, omits any reference to the presumption of validity.

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<sup>18</sup>Morton Int'l v. Cardinal Chem. Co., 5 F.3d 1464, 1471-2 (Fed. Cir. 1993); Avia Group Int'l, Inc. v. L.A. Gear Cal., 853 F.2d 1557, 1562 (Fed. Cir. 1988); DMI, Inc. v. Deere & Co., 802 F.2d 421, 427 (Fed. Cir. 1986).

## 5.2 WRITTEN DESCRIPTION

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

The written description requirement is satisfied if a person of ordinary skill in the field of reading the patent application as originally filed would recognize that the patent application described the invention as claimed, even though the description may not use the exact words found in the claim. The written description is adequate if it shows 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 during the prosecution of the application. It is not necessary that each and every aspect of the claim be explicitly discussed, as long as a person of ordinary skill would understand that the aspect is implicit in the patent application as originally filed.<sup>19</sup>

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<sup>19</sup> Univ. of Rochester v. G.D. Searle & Co., 358 F.3d 916 (Fed. Cir. 2004); Turbocare Div. of Demag Delaval Turbomach. Corp., v. Gen. Elec. Co., 264 F.3d 1111, 1118 (Fed. Cir. 2002); Enzo Biochem, Inc. v. Gen-Probe Inc., 323 F.3d 956 (Fed. Cir. 2002) (en banc); Purdue Pharma L.P. v. Faulding Inc., 230 F.3d 1320 (Fed. Cir. 2000); Reiffin v. Microsoft Corp., 214 F.3d 1342, 1345-46 (Fed. Cir. 2000); Union Oil Co. of Cal. v. Atl. Richfield Co., 20 F.3d 989, 996-1001 (Fed. Cir. 2000); Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473, 1478-90 (Fed. Cir. 1998); Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555 (Fed. Cir. 1991); Kao Corp. v. Unilever U.S., Inc., 441 F.3d 963, 968 (Fed. Cir. 2006).

### 5.3 ENABLEMENT

[The alleged infringer] claims the patent is invalid because it does not disclose sufficient information to enable one skilled in the field of the invention to make and use the claimed invention. This requirement is known as the enablement requirement. If a patent claim is not enabled, it is invalid. [The alleged infringer] must prove that it is highly probable that the claim was not enabled.

In considering whether the patent satisfies the enablement requirement, you must keep in mind that patents are written for persons of skill in the field of the invention. Thus, a patent need not expressly state information that skilled persons would be likely to know or could obtain. [The alleged infringer] bears the burden of establishing lack of enablement by showing it is highly probable that a person skilled in the art, upon reading the patent document, would not be able to make the invention work. The fact that some experimentation may be required for a skilled person to make or use the claimed invention does not mean that a patent's written description fails to meet the enablement requirement. Factors you may consider in determining whether the written description would require undue experimentation include:

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

8. the breadth of the claims.<sup>20</sup>

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<sup>20</sup> Durel Corp. v. Osram Sylvania Inc., 256 F.3d 1298, 1306 (Fed. Cir. 2001); Union Pac. Res. Co. v. Chesapeake Energy Corp., 236 F.3d 684, 690-92 (Fed. Cir. 2001); Ajinomoto Co. v. Archer-Daniels-Midland Co., 228 F.3d 1338, 1345-46 (Fed. Cir. 2000); Nat'l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc., 166 F.3d 1190, 1195-98 (Fed. Cir. 1999); Enzo Biochem, Inc. v. Calgene, Inc., 188 F.3d 1362, 1371 (Fed. Cir. 1999); In re Wands, 858 F.2d 731, 737 (Fed. Cir. 1988); Spectra-Physics, Inc. v. Coherent, Inc., 827 F.2d 1524, 1533 (Fed. Cir. 1987); Hybritech Inc. v. Monolonal Antibodies, Inc., 802 F.2d 1367, 1384 (Fed. Cir. 1986); Ralston Purina Co. v. Far-Mar Co., 772 F.2d 1570, 1573-74 (Fed. Cir. 1985); Linedmann Maschinenfabrik GmbH v. Am. Hoist & Derrick Co., 730 F.2d 1452, 1463 (Fed. Cir. 1984); White Consol. Indus., Inc. v. Vega Servo Control, Inc., 713 F.2d 788, 791 (Fed. Cir. 1983); AK Steel Corp. v. Sollac & Ugine, 344 F.3d 1234, 1244 (Fed. Cir. 2003).

## 5.4 BEST MODE

The patent laws require that if the inventor knew of a best way, or “mode,” of making and using the claimed invention when he or she filed the patent application, then the patent specification must contain a description of that mode.

The purpose of this “best mode” requirement is to ensure that the public obtains a full disclosure of how to carry out the invention claimed in the patent. It prevents an inventor from obtaining a patent, while at the same time not disclosing to the public the inventor’s preferred way of making or using the claimed invention. The inventor must disclose the best mode he or she knew of for carrying out the invention as it is described in the patent claims.

Determining whether or not an inventor disclosed the best mode involves answering two questions. The first question is: At the time the application was filed, did the inventor know of a way, or mode, of making or using the invention claimed in the patent that the inventor considered to be better than any other mode? This question involves only what the inventor actually thought or believed. However, the alleged best mode must relate directly to the claimed invention.

If you find that the answer to the first question is no—that is, the inventor did not know of a best mode of making or using the invention at the time the application was filed—you should stop there. The patent cannot be invalid for failure to disclose the best mode if the inventor did not know of a best mode when the application was filed.

If you find that the inventor did know of a best mode at the time the application was filed, then you must consider the second question: Does the patent contain a description of the inventor’s best mode that is sufficient to enable a person skilled in the art to carry out the best mode? This question does not ask what the inventor thought or understood, but rather focuses on what a person skilled in the field of the invention reading the patent would understand.

A patent describes the best mode if it contains enough information that a skilled person reading the patent would be able to carry out the best mode without undue experimentation. That means that a skilled person reading the patent would be able to make and use the best mode of the invention using only an amount of experimentation that is appropriate for the complexity of the field of the invention and for the level of expertise and knowledge of persons skilled in that field.

If you find that [the alleged infringer] has proved that it is highly probable that (1) [the inventor] [one of the inventors] had a best mode of practicing the invention at the time the application was filed, and (2) the patent does not contain a written description that would enable a skilled person to make and use that best mode without undue experimentation, then you should find that these claims are invalid.<sup>21</sup>

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<sup>21</sup> *Bayer AG v. Schein Pharms., Inc.*, 301 F.3d 1306 (Fed. Cir. 2002); *Mentor H/S Inc., v. Med. Device Alliance, Inc.*, 244 F.3d 1365 (Fed. Cir. 2001); *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 963 (Fed. Cir. 2001); *N. Telecom Ltd. v. Samsung Elec. Co.*, 215 F.3d 1281,1286 (Fed.Cir. 2000); *Applied Materials, Inc. v. Advanced Semiconductor Am. Materials, Inc.*, 98 F.3d 1563, 1581 (Fed. Cir. 1996); *U.S. Gypsum Co. v. Nat'l Gypsum Co.*, 74 F.3d 1209, 1212 (Fed. Cir. 1996); *Transco Prods. Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 558 (Fed. Cir. 1994); *Shearing v. Iolab Corp.*, 975 F.2d 1541 (Fed. Cir. 1992); *Wahl Instruments, Inc. v. Acvious, Inc.*, 950 F.2d 1575, 1581 (Fed.Cir. 1991); *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209-10 (Fed. Cir. 1991); *Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923, 928 (Fed. Cir. 1990); *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1535 (Fed. Cir. 1987); *DeGeorge v. Bernier*, 768 F.2d 1318, 1324 (Fed.Cir. 1985); *In re Gay*, 309 F.2d 769, 772 (C.C.P.A. 1962).

## **5.5 ANTICIPATION – PUBLICLY USED OR KNOWN, OR PREVIOUSLY PUBLISHED**

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

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

Here is a list of the ways that [the alleged infringer] can show that a patent claim was not new [use those that apply to this case]:

[– if the claimed invention was already publicly known or publicly used by others in the United States before [insert date of invention unless at issue];]

[– if the claimed invention was already patented or described in a printed publication anywhere in the world before [insert date of invention unless at issue]. [A reference is a “printed publication” if it is reasonably accessible to those interested in the field, even if it is difficult to find.];]

[– if the claimed invention was already described in another issued U.S. patent or published U.S. patent application that was based on a patent application filed before

[insert date of the patent holder's application filing date] [or] [insert date of invention unless at issue];]

[Since it is in dispute, you must determine a date of invention for the [claimed invention.]<sup>22</sup>

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<sup>22</sup> 35 U.S.C. § 102(a), (c), (e), (f) and (g); Apotex U.S.A., Inc. v. Merck & Co., 254 F.3d 1031, 1035 (Fed. Cir. 2001); Mycogen Plant Science, Inc. v. Monsanto Co., 243 F.3d 1316, 1330 (Fed. Cir. 2001); Ecolochem, Inc. v. S. Cal. Edison Co., 227 F.3d 1361, 1367-70 (Fed. Cir. 2000); Singh v. Brake, 222 F.3d 1362, 1366-70 (Fed. Cir. 2000); Pannu v. Iolab Corp., 155 F.3d 1344, 1349 (Fed. Cir. 1998); Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1576-78 (Fed. Cir. 1997); Lamb-Weston, Inc. v. McCain Foods, Ltd., 78 F.3d 540, 545 (Fed. Cir. 1996); In re Bartfeld, 925 F.2d 1450 (Fed. Cir. 1985); Ralston Purina Co. v. Far-Mar-Co, Inc., 772 F.2d 1570, 1574 (Fed. Cir. 1985); American Stock Exch., LLC v. Mopies, 250 F. Supp. 2d 323 (S.D.N.Y. 2003); In re Wyer, 655 F.2d 221, 226 (C.C.P.A. 1981).



## 5.6 ANTICIPATION—MADE OR INVENTED BY SOMEONE ELSE

In this case [the alleged infringer] argues that claims [ ] of the XXX patent are invalid as anticipated because it was made or invented by someone else. If someone other than [the named inventor] made or invented the invention described in the patent claims involved in this lawsuit, then [the patent holder]’s claims were “anticipated” by the other invention, and those claims are invalid. [The alleged infringer] contends this patent is not new and must prove that it is highly probable that the claim was anticipated.

Here is a list of the ways that [the alleged infringer] can show that a patent claim was not new because the invention described by those claims was first made or invented by someone else [use those that apply to this case]:

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

[Use if inventorship is in dispute]: [A claimed invention is “reduced to practice” when it has been tested sufficiently to show that it will work for its intended purpose or when it is fully described in a filed patent application.]

[Since inventorship is in dispute in this case, you must determine a date of conception, reduction to practice and/or diligence for the [claimed invention] [and/or] [prior invention]. Conception is the mental part of an inventive act and is proven when the invention is shown in its complete form by drawings, disclosure to another, or other forms of evidence presented at trial.

Reduction to practice occurs either as of the filing of the patent application or when the invention was actually made and was shown to work for its intended purpose. Reasonable diligence means that the inventor worked continuously on reducing the invention to practice. Interruptions necessitated by the everyday problems and obligations of the inventor or others working with him or her do not prevent a finding of diligence.]<sup>23</sup>

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<sup>23</sup> 35 U.S.C. § 102(a), (c), (e), (f) and (g); Apotex U.S.A., Inc. v. Merck & Co., 254 F.3d 1031, 1035 (Fed. Cir. 2001); Mycogen Plant Science, Inc. v. Monsanto Co., 243 F.3d 1316, 1330 (Fed. Cir. 2001); Ecolochem, Inc. v. S. Cal. Edison Co., 227 F.3d 1361, 1367-70 (Fed. Cir. 2000); Singh v. Brake, 222 F.3d 1362, 1366-70 (Fed. Cir. 2000); Pannu v. Iolab Corp., 155 F.3d 1344, 1349 (Fed. Cir. 1998); Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1576-78 (Fed. Cir. 1997); Lamb-Weston, Inc. v. McCain Foods, Ltd., 78 F.3d 540, 545 (Fed. Cir. 1996); In re Bartfeld, 925 F.2d 1450 (Fed. Cir. 1985); Ralston Purina Co. v. Far-Mar-Co, Inc., 772 F.2d 1570, 1574 (Fed. Cir. 1985); American Stock Exch., LLC v. Mopies, 250 F. Supp. 2d 323 (S.D.N.Y. 2003); In re Wyer, 655 F.2d 221, 226 (C.C.P.A. 1981).

## 5.7 STATUTORY BARS

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

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

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

For a claim to be invalid because of a statutory bar, all the claimed requirements must have been either (1) disclosed in a single prior art reference or (2) implicitly disclosed in a reference to one of ordinary skill in the field of the invention. The disclosure in a reference does not have to be in the same words as the claim, but all the requirements must be there, either

described in enough detail or necessarily implied to enable someone of ordinary skill in the field of the invention looking at the reference to make and use the claimed invention.<sup>24</sup>

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<sup>24</sup> 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).

## 5.8 OBVIOUSNESS<sup>25</sup>

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

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

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<sup>25</sup> KSR Intern. Co. v. Teleflex, Inc., 127 S.Ct. 1727 (2007)

person of ordinary skill in the art would employ. Additionally, teachings, suggestions, and motivations may be found in the nature of the problem solved by the claimed invention.

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

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

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

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

1. You must decide the level of ordinary skill in the field of the invention that someone would have had at the time the claimed invention was made.
2. You must decide the scope and content of the prior art. In determining the scope and content of the prior art, you must decide whether a reference is pertinent, or analogous, to the claimed invention. Pertinent, or analogous, prior art is defined by the nature of the problem solved by the claimed invention. It includes prior art in the same field of endeavor as the claimed invention, regardless of the problems addressed by the reference, and prior art from different fields reasonably pertinent to the particular

problem with which the claimed invention is concerned. Remember that prior art is not limited to patents and published materials, but includes the general knowledge that would have been available to one of ordinary skill in the field of the invention.

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

Where these matters are in dispute, the party asserting invalidity of the patent has the burden to establish that it is highly probable that its version of these facts is correct. Finally, you should consider any of the following factors that you find have been shown by the evidence:

A. Factors tending to show nonobviousness:

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

B. Factors tending to show obviousness

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

[You may consider the presence of any of the [list factors 1-7 as appropriate] as an indication that the claimed invention would not have been obvious at the time the claimed invention was made. And you may consider the presence of the [list factors 8-9 as appropriate] as an indication that the claimed invention would have been obvious at such time. Although you should consider any evidence of these factors, the relevance and importance of any of them to your decision on whether the claimed invention would have been obvious is up to you.]



## 5.9 OBVIOUSNESS—(Alternative)

In this case, [the alleged infringer] contends claim [ ] of the [xxx] patent is invalid as obvious. A patent claim is invalid if the claimed invention would have been obvious to a person of ordinary skill in the field of the invention [at the time the application was filed] [as of [insert date]]. The court, however, has the responsibility of determining whether a patent claim was obvious based on your determination of several factual questions.<sup>26</sup> Where these matters are in dispute, the party asserting invalidity has the burden to establish that it is highly probable that its version of these facts is correct.

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

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

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<sup>26</sup> This instruction provides the jury with an instruction on the underlying factual questions it must answer to enable the court to make the ultimate legal determination of the obviousness question. *KSR Intern. Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1745 (2007)(“The ultimate judgment of obviousness is a legal determination.”); see *Dippin' Dots, Inc. v. Mosey*, 476 F.3d 1337, 1343 (Fed. Cir. 2007).

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

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

A. Factors tending to show nonobviousness:

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

B. Factors tending to show obviousness

- [1. independent invention of the claimed invention by others before or at about the same time as the named inventor thought of it]; and
- [2. other evidence tending to show obviousness].<sup>27</sup>

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<sup>27</sup>35 U.S.C. § 103; Graham v. John Deere Co., 383 U.S. 1 (1966); KSR Int'l Co. v. Teleflex, Inc., 127 S.Ct. 1727 (2007); Ruiz v. A.B. Chance Co., 234 F.3d 654 (Fed. Cir. 2000); Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 957 (Fed. Cir. 1997); Specialty Composites v. Cabot Corp., 845 F.2d 981, 991 (Fed. Cir. 1988); Windsurfing Int'l. Inc. v. AMF, Inc., 782 F.2d 995, 1000 (Fed. Cir. 1986); Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 313 (Fed. Cir. 1985); Novo Nordisk A/S v. Becton Dickinson & Co., 304 F.3d 1216, 1219

(continued...)

**Committee Note:**

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

We suggest that the best approach will be for parties and the courts to develop an instruction and form in the context of the fact patterns in particular cases. And we note that the Northern District of California has adopted a model instruction and form where the court submits these underlying issues of fact to the jury. Judges and lawyers should look to those forms for guidance.

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(Fed. Cir. 2002); *In re Fulton* 391 F.3d 1195, 1201 (Fed. Cir. 2004); *Ryco Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 716 (Fed. Cir. 1991), *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979).

## 5.10 SCOPE AND CONTENT OF PRIOR ART

[The patent holder] and [the alleged infringer] disagree on whether [identify prior art reference(s)] should be included in the prior art you use to decide the validity of claims [ ] of the [ ] patent. To qualify as prior art relevant to the [ ] patent, these references must be reasonably related to the claimed invention of that patent. A reference is reasonably related if it is in the same field as the claimed invention or is from another field to which a person of ordinary skill in the field would look to solve a known problem.<sup>28</sup> Remember that prior art is not limited to patents and published materials, but includes the general knowledge that would have been available to one of ordinary skill in the field of the invention.

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<sup>28</sup> Graham v. John Deere Co., 383 U.S. 1 (1966); KSR Int'l Co. v. Teleflex, Inc., 550 U.S. \_\_\_\_ (2007); Ruiz v. A.B. Chance Co., 234 F.3d 654, 664-65 (Fed. Cir. 2000); Wang Labs. v. Toshiba Corp., 993 F.2d 858, 864 (Fed. Cir. 1993).

## 5.11 DIFFERENCES OVER THE PRIOR ART

In reaching your conclusion about whether or not claim [ ] would have been obvious at the time the claimed invention was made, you should consider any difference or differences between the [identify prior art reference(s)] and the claimed requirements.<sup>29</sup>

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<sup>29</sup> Graham v. John Deere Co., 383 U.S. 1 (1966); Yamanouchi Pharm. Co. v. Danbury Pharmacal, Inc., 231 F.3d 1339, 1343-45 (Fed. Cir. 2000); In re Kotzab, 217 F.3d 1365, 1369 (Fed. Cir. 2000); Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 935 (Fed. Cir. 1990).

## 5.12 LEVEL OF ORDINARY SKILL

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

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

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

[The patent holder] contends that the level of ordinary skill in the field of the invention was [ ]. [The alleged infringer] contends that the level of ordinary skill in the field was [ ].<sup>30</sup>

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<sup>30</sup> Graham v. John Deere Co., 383 U.S. 1 (1966); Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1125 (Fed. Cir. 2000); SIBIA Neurosciences, Inc. v. Cadus Pharm. Corp., 225 F.3d 1349, 1355 (Fed. Cir. 2000); Ryko Mfg. Co. v. Nu-Star, Inc., 950 F.2d 714, 718-19 (Fed. Cir. 1991).

## **6 DAMAGES**

### **6.1 DAMAGES: GENERALLY**

I will now instruct you on damages. If you find that [the alleged infringer] has infringed one or more valid claims of the [XXX ] patent you must determine the amount of money damages due to [the patent holder].

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

I will now instruct you on how to calculate damages. By instructing you on damages, I do not suggest that one or the other party should prevail. These instructions are provided to guide you on the law in the event you find infringement of a valid patent claim and thus must address the damages issue.

## 6.2 DAMAGES—BURDEN OF PROOF

Where the parties dispute a matter concerning damages, it is [the patent holder]’s burden to prove it is more probable than not that [the patent holder]’s version is correct. [The patent holder] must prove the amount of damages with reasonable certainty, but need not prove the amount of damages with mathematical precision. However, [the patent holder] is not entitled to damages that are remote or speculative. When the amount of damages cannot be ascertained with precision, any doubts regarding the amount should be resolved against [the alleged infringer].<sup>31</sup>

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<sup>31</sup> Wechsler v. Macke Intern. Trade, Inc., 486 F.3d 1286, 1298-99 (Fed. Cir. 2007); Union Carbide Chems. & Plastics Tech. Corp. v. Shell Oil Co., 425 F.3d 1366, 1372-73 (Fed. Cir. 2005); State Contracting & Eng’g Corp. v. Condotte Am., Inc., 346 F.3d 1057, 1072 (Fed. Cir. 2003); SmithKline Diagnostics, Inc. v. Helena Labs. Corp., 926 F.2d 1161, 1164 (Fed. Cir. 1991); Lam, Inc. v. Johns-Mansville Corp., 718 F.2d 1056, 1065 (Fed. Cir. 1983).



### 6.3 DAMAGES—WHEN DAMAGES BEGIN

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

In this case, [the patent holder] and [the alleged infringer] agree that date was [insert date]. You should assess damages beginning on this date.

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

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

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

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

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

Constructive notice means that [the patent holder] complied with the marking requirement of the patent law. “Marking” means that products made, offered for sale, or sold under the [XXX] patent are marked to display the word ‘patent’ or the abbreviation ‘pat.’, together with the number of the patent. [The patent holder] has the burden of establishing substantial compliance with the marking requirement. To do so, [the patent holder] must show it

is more probable than not that products it made, offered for sale, or sold under the [XXX] patent were marked, and that [the patent holder] made reasonable efforts to ensure that its licensees who made, offered for sale, or sold products under the [XXX] patent marked the products.

Your job is to calculate damages from the date [the alleged infringer] received either actual or constructive notice, whichever was first. You should not award damages for any infringement by [the alleged infringer] occurring before it first received notice of the [XXX] patent. However, the notice requirement does not apply to method claims, and your calculation of damages for infringement of method claims should begin as of the date the [XXX] patent issued ([date patent issued]), or the date you find the infringement began, whichever was first.<sup>32</sup>

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<sup>32</sup> 35 U.S.C. § 287; State Contracting & Eng'g Corp. v. Condotte Am., Inc., 346 F.3d 1057, 1073 (Fed. Cir. 2003); Crystal Semiconductor Corp. v. Trittech Microelectronics Int'l, Inc., 246 F.3d 1336, 1343 (Fed. Cir. 2001); Gart v. Logitech, 254 F.3d 1334, 1345 (Fed. Cir. 2001); Maxwell v. J. Baker, 86 F.3d 1098, 1111 (Fed. Cir. 1996); Amsted Indus. Inc. v. Buckeye Steel Castings Co., 24 F.3d 178, 187 (Fed. Cir. 1984).

## 6.4 DAMAGES—LOST PROFITS

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

In this case, [the patent holder] seeks to recover lost profits resulting from [the alleged infringer]'s sales of [accused device]. To recover lost profits, [the patent holder] must show that it is more probable than not that it lost sales of its products as a result of the infringement.

One way [the patent holder] may establish lost profits is by proving it is more probable than not:

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

For those infringing sales where [the patent holder] does not seek, or does not prove, lost profits damages, the law requires that you award [the patent holder] a reasonable royalty. I will now instruct you on how to calculate reasonable royalty damages.<sup>33</sup>

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<sup>33</sup> 35 U.S.C. § 284; Wechsler v. Macke Intern. Trade, Inc., 486 F.3d 1286, 1298-99 (Fed. Cir. 2007); Beauregard v. Mega Sys., LLC, 350 F.3d 1327, 1345-46 (Fed. Cir. 2003); Ericsson, Inc. v. Harris Corp., 352 F.3d 1369, 1377-79 (Fed. Cir. 2003); Micro Chem., Inc. v. Lextron, Inc., 318 F.3d 1119, 1123 (Fed. Cir. 2003); Gargoyles, Inc. v. United States, 113 F.3d 1572, 1577-78 (Fed. Cir. 1997); Rite-Hite Corp. v. Kelley Co., 56 F.3d 1538, 1545 (Fed. Cir. 1995) (*en banc*); State Industries, Inc. v. Mor-Flo Industries, Inc., 883 F.2d 1573, 1576-80 (Fed. Cir. 1989); Carella v. Starlight Archery, 804 F.2d 135, 141 (Fed. Cir. 1986); Gyromat Corp. v. Champion Spark Plug Co., 735 F.2d 549, 552 (Fed. Cir. 1984); Central Soya Co. v. George A. Hormel & Co., 723 F.2d 1573, 1579 (Fed. Cir. 1983); Lam, Inc. v. Johns-Mansville Corp., 718 F.2d 1056, 1065 (Fed. Cir. 1983); Panduit Corp. v. Stahl Bros. Fibre Works, Inc., 575 F.2d 1152, 1156 (6th Cir. 1978); Aro Mfg. Co. v. Convertible Top Co., 377 U.S. 476, 502-07 (1964).

**Committee Note:**

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

## 6.5 REASONABLE ROYALTY – ENTITLEMENT<sup>34</sup>

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

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<sup>34</sup> 35 U.S.C. § 284; Crystal Semiconductor Corp. v. Tritech Microelectronics Int'l, Inc., 246 F.3d 1336 (Fed. Cir. 2001); Fromson v. Western Litho Plate & Supply Co., 853 F.2d 1568, 1574 (Fed. Cir. 1998) (overruled on other grounds); Minco, Inc. v. Combustion Eng'g, Inc., 95 F.3d 1109, 1119-20 (Fed. Cir. 1996); Mahurkar v. C.R. Bard, Inc., 79 F.3d 1572, 1579 (Fed. Cir. 1996); Rite-Hite Corp. v. Kelley Co., 56 F.3d 1538, 1554 (Fed. Cir. 1995) (en banc). *B.5. Patent Damages*

## 6.6 REASONABLE ROYALTY – DEFINITION<sup>35</sup>

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

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<sup>35</sup> 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*). The Court in Georgia-Pacific Corp. v. United States Plywood Corp., 318 F. Supp. 1116, 1120 (S.D.N.Y. 1970) identified the following factors that may be considered in determining a reasonable royalty: 1) the royalties received by the patent holder for the licensing of the patent, which proves or tends to prove an established royalty; 2) the rates paid by the alleged infringer for the use of other patents comparable to the patent; 3) the nature and scope of the license, as exclusive or nonexclusive; or as restricted or unrestricted in terms of territory or identity of buyers of the manufactured product; 4) the patent holder's established policy and marketing program to maintain their patent monopoly by not licensing others to use the invention or by granting licenses under special conditions designed to preserve that monopoly; 5) the commercial relationship between the patent holder and the alleged infringer, such as, whether they are competitors in the same territory in the same line of business; or whether they are inventor or promoter; 6) the effect of selling the patented specialty in promoting sales of other products of the alleged infringer; the existing value of the invention to the patent holder as a generator of sales of its nonpatented items; and the extent of such derivative or convoyed sales; 7) the duration of the patent and the term of the licenses; 8) the established profitability of the product made under the patent; its commercial success; and its current popularity; 9) the utility and advantages of the patent property over old modes or devices, if any, that had been used for working out similar results; 10) the nature of the patented invention; the character of the commercial embodiment of it as owned and produced by the patent holder; and the benefits to those who have used the invention; 11) the extent to which the alleged infringer has made use of the invention; and any evidence tending to prove the value of that use; 12) the portion of the profit or of the selling price that may be customary in the particular business or in comparable businesses to allow for the use of the invention or similar inventions; 13) the portion of the realizable profit that should be credited to the invention as distinguished from nonpatented elements, the manufacturing process, business risks, or significant features or improvements added by the infringer; 14) the opinion and testimony of qualified experts; and 15) any other economic factor that a normally prudent businessperson would, under similar circumstances, take into consideration in negotiating the hypothetical license. Applied Medical Resources Corp. v. U.S. Surgical Corp., 435 F.3d 1356, 1361-64 (Fed. Cir. 2006); Trans-World Manufacturing Corp. v. All Nyman & Sons, Inc., 750 F.2d 1552, 1568 (Fed. Cir. 1984); Georgia-Pacific Corp. v. U.S. Plywood-Champion Papers, 318 F. Supp. 1116, 1120 (S.D.N.Y. 1970).

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

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

## **APPENDICES**

### **MODEL VERDICT FORMS**

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



**IN THE UNITED STATES DISTRICT COURT**  
**FOR THE DISTRICT OF \_\_\_\_\_**

PATENT HOLDER,

Plaintiff,

vs.

Civil Action No.

ALLEGED INFRINGER,

Defendant.

**Verdict Form A**

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

**I. Infringement**

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

a. Claim 1 of the '123 patent                      Yes \_\_\_\_\_                      No \_\_\_\_\_

**II.    Validity\_**

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

a. Claim 1 of the '123 patent                      Yes \_\_\_\_\_                      No \_\_\_\_\_

**III.    Damages**

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

i. Lost Profits: \_\_\_\_\_

ii. Reasonable Royalty

rate \_\_\_\_\_

total royalty damages: \_\_\_\_\_

Total Damages: \_\_\_\_\_

For the Jury:

By: \_\_\_\_\_  
Foreperson

Date: \_\_\_\_\_

**IN THE UNITED STATES DISTRICT COURT**  
**FOR THE DISTRICT OF \_\_\_\_\_**

**PATENT HOLDER,**

Plaintiff,

vs.

Civil Action No.

**ALLEGED INFRINGER**

Defendant.

**Verdict Form B**

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

**I. Infringement**

**A. Direct Infringement\_**

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

a. Claim 1 of the '123 patent                      Yes\_\_\_\_\_                      No\_\_\_\_\_

**2. Equivalents.** Where you answered "No" to Literal Infringement, has [the patent holder] proven that it is more probable than not that the accused product [method] includes parts [steps] that are identical or equivalent to every requirement of that claim of [the patent holder]'s patent?

a. Claim 1 of the '123 patent                      Yes\_\_\_\_\_                      No\_\_\_\_\_

**B. Contributory Infringement.** Where [the patent holder] has proven that it is more probable than not that Claim 1 of the '123 patent was infringed either directly or by equivalents, has [the patent holder] proven it is more probable than not (i) that [the alleged infringer] supplied an important component of the infringing part of the product or method; (ii) that the component was not a common component suitable for noninfringing use; and (iii) that [the alleged infringer] supplied the component with knowledge of the patent and knowledge that the component was especially made or adapted for use in an infringing manner?

a. Claim 1 of the '123 patent                      Yes\_\_\_\_\_                      No\_\_\_\_\_

**C. Inducing Infringement.** Where [the patent holder] has proven that it is more probable than not that [the alleged infringer] took action that actually induced that infringement of claim 1 of the '123 patent; (ii) that [the alleged infringer] was aware of the patent; and (iii) that [the alleged infringer] knew or should have known that taking such action would induce direct infringement?

a. Claim 1 of the '123 patent                      Yes\_\_\_\_\_                      No\_\_\_\_\_

**D. Willful Infringement.** Has [the patent holder] proven that it is highly probable that [the alleged infringer] infringed the following claim of [the patent holder]'s patent with reckless disregard of whether such claim was infringed or was invalid or unenforceable?

a. Claim 1 of the '123 patent                      Yes\_\_\_\_\_                      No\_\_\_\_\_

**II. Validity\_**

**A. Obviousness.** Has [the alleged infringer], proven that it is highly probable that the following claim is invalid as obvious:

a. Claim 1 of the '123 patent                      Yes\_\_\_\_\_                      No\_\_\_\_\_

**B. Written Description Requirement.** Has [the alleged infringer], proven that it is highly probable that the following claim does not contain an adequate written description of the claimed invention?

a. Claim 1 of the '123 patent                      Yes\_\_\_\_\_                      No\_\_\_\_\_

**C. Enablement.** Has [the alleged infringer] proven that it is highly probable that the following claim does not contain a description of the claimed invention that is sufficiently full and clear to enable persons of ordinary skill in the field of the invention to make and use the invention?

a. Claim 1 of the '123 patent                      Yes\_\_\_\_\_                      No\_\_\_\_\_

**D. Best Mode.** Has [the alleged infringer] proven that it is highly probable that the following patent does not disclose what the inventor believed was the best way to carry out the claimed invention at the time the patent application was filed?

a. The '123 patent                                      Yes\_\_\_\_\_                      No\_\_\_\_\_

**E. Anticipation.** Has [the alleged infringer] proven that it is highly probable that the following claim was "anticipated," or, in other words, not new?

a. Claim 1 of the '123 patent                      Yes \_\_\_\_\_      No \_\_\_\_\_

**F. Inventorship.** Has [the alleged infringer] proven that it is highly probable that the following patent fails to meet the requirement to name all actual inventors and only the actual inventors?

a. The '123 patent                      Yes \_\_\_\_\_      No \_\_\_\_\_

**III. Damages**

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

i. Lost Profits: \_\_\_\_\_

ii. Reasonable Royalty

rate \_\_\_\_\_

total royalty damages: \_\_\_\_\_

Total Damages: \_\_\_\_\_

For the Jury:

By: \_\_\_\_\_

Foreperson

Date: \_\_\_\_\_