

ROBERT A. MATTHEWS JR.

Counselor – Patent Law & Litigation Author – Annotated Patent Digest Telephone 434.525.1141

Patent Jury Instruction Handbook

By Robert A. Matthews, Jr.

Table of Contents (2010-2011 Edition)

Available on **Westlaw** (database PATENT-JI)

CHAPTER 1. PRELIMINARY INSTRUCTIONS FOR INFRINGEMENT TRIAL OF A UTILITY PATENT

I. PRELIMINARY INSTRUCTIONS GIVEN BY COURTS

- § 1:1 Basic Preliminary Instructions (S.D. Cal.)
- § 1:2 Preliminary Instructions showing jury the Federal Judicial Center videotape "Introduction to the Patent System," providing court's claim construction, glossary of terms, and permitting jurors to submit written questions for court to ask witnesses (N.D. Cal.)
- § 1:3 Preliminary instructions with an overview of the patent law principles of infringement and invalidity, court appointed expert, permitting jurors to submit written questions for court to ask witnesses, use of translators, providing jury with a copy of the patent (N.D. Cal.)
- § 1:4 Preliminary instructions warning jury that no written copies of the preliminary or final instructions would be provided, reading jury glossary of patent terms (E.D. Tex.)
- § 1:5 Preliminary instructions with glossary of patent terms, invalidity defenses, and technical terms, allowing juror notes but only for individual juror's personal use (D. Del.)
- § 1:6 Preliminary instructions, short version (E.D. Tex.)

II. EXCERPTS OF PRELIMINARY INSTRUCTIONS FROM MODEL PATENT JURY INSTRUCTIONS

- § 1:7 AIPLA Model Instructions with Glossary
- § 1:8 Northern District of California Model Instruction with Glossary
- § 1:9 National Jury Instruction Project's Model Patent Jury Instructions

CHAPTER 2. INFRINGEMENT OF A UTILITY PATENT

I. INSTRUCTIONS ACTUALLY GIVEN BY COURTS ON INFRINGEMENT AND WILLFUL INFRINGEMENT

- § 2:1 Direct infringement, literal and doctrine of equivalents, court-appointed expert witness, verdict form (N.D. Cal.)
- § 2:2 Direct literal infringement where parties stipulated that only certain claim limitations were in dispute, sale of non-accused redesigned product not evidence that accused product infringed, improper to compare to patentee's commercial product—Verdict form (D. Minn.)
- § 2:3 Direct infringement, literal and under doctrine of equivalents, of "comprising" claims, infringement by means-plus-function limitations, prosecution history estoppel barring specific equivalents, impact of separate patenting of accused device, "burden of proof" (D. Kan.)
- § 2:4 Inducing infringement with detailed general instructions (E.D. Mich.)
- § 2:5 Claim construction instructions expressly instructing the jury that claim was not limited to patent figures and that certain features were *not* required by the claim, Inducing infringement, Willful infringement with focus on state of mind of accused infringer's employee, Verdict Form with jury interrogatories specific to elements of inducing infringement (N.D. Cal.)
- § 2:6 Direct infringement, inducing infringement based on providing instructions, and contributory infringement (M.D. Fla.)
- § 2:7 Inducing infringement, contributory infringement, exporting components under § 271(f), product-by-process claims, providing jury with exhibits of court's claim construction (S.D. Cal.)
- § 2:8 Direct infringement, inducing infringement, contributory infringement, willful infringement with "reasonable person" standard, claim construction supplied as an appendix, verdict form (E.D. Tex.)
- § 2:9 Direct infringement, means-plus-function limitations, inducing infringement, "within U.S." requirement applied to method and apparatus claims, willful infringement in view of accused infringer's litigation defenses (E.D. Tex.)
- § 2:10 Infringement of means-plus-function claims, inducing infringement with a *Broadcom* opinion of counsel instruction, contributory infringement, infringement by supplying exported components under § 271(f)(1) and (f)(2), willful infringement (E.D. Tex.)
- § 2:11 Willful infringement in view litigation defenses and efforts to obtain a preliminary injunction, literal infringement, means-plus-function limitation, impact of prior adjudication of infringement of different product (C.D. Cal.)
- § 2:12 Direct literal infringement and infringement under doctrine of equivalents, willful infringement with a list of 9 specific factors to consider, including an internal investigation by the accused infringer's in-house counsel that was not relied upon as an opinion of counsel (E.D. Tex.)

- § 2:13 Infringement, literal and doctrine of equivalents, inducing infringement with a *Broadcom* opinion of counsel instruction, contributory infringement with instruction that noninfringing uses must be of the patented component, not overall accused product, willful infringement, closing instruction regarding a patentee's right to bring a suit even if it is a small entity that does not compete with the accused infringer, Verdict Form (E.D. Tex.)
- § 2:14 Literal infringement method claims and claims with means-plus-function limitations, express instruction that accused product being an improvement over the patent does not avoid infringement, Inducing infringement, Contributory infringement, infringement by Exportation under § 271(f) (D. Del.)
- § 2:15 Divided (Joint) infringement, Willful infringement permitting jury to consider pre-issuance activity and whether accused infringer offered to indemnify its customers (W.D. Mo.)
- § 2:16 Importation of product made by a patented process under § 271(a) and § 271(g), literal infringement, infringement under the doctrine of equivalents, and infringement of means-plus-function limitations, Verdict Form (E.D. Tex.)
- § 2:17 Infringement by importation of product made by a patented process focusing on "materially changed" aspect of § 271(g) (C.D. Cal.)

II. EXCERPTS OF MODEL PATENT JURY INSTRUCTIONS ON INFRINGEMENT & WILLFUL INFRINGEMENT

- § 2:18 AIPLA Model Instructions
- § 2:19 Northern District of California Model Instruction
- § 2:20 National Jury Instruction Project's Model Patent Jury Instructions

CHAPTER 3. INVALIDITY DEFENSES

I. INSTRUCTIONS ACTUALLY GIVEN BY COURTS INVALIDITY DEFENSES

- § 3:1 Validity only trial, anticipation by public knowledge, public use, on-sale bar, prior U.S. patent, prior invention, abandonment, obviousness (D. Del.)
- § 3:2 Anticipation by prior art, on-sale bar, obviousness, inventor proving earlier date of invention, and verdict form (N.D. Cal.)
- § 3:3 Anticipation, inherent anticipation, obviousness (with *Dystar* instruction) (D. Kan.)
- § 3:4 Prior public knowledge or use, printed publication and accessibility, prior U.S. patent, incorrect inventorship, prior inventor, error in reissue (S.D. Cal.)
- § 3:5 Anticipation by public knowledge, public use, printed publication, prior patent, on-sale bar, corroboration requirement for oral testimony to support anticipation, obviousness, Verdict Form (E.D. Tex.)
- § 3:6 Anticipation, inherent anticipation, public use, obviousness, analogous art (M.D. Fla.)
- § 3:7 Derivation, obviousness, printed publication (S.D. Tex.)

- § 3:8 Enablement, anticipation, obviousness, date of invention, verdict form (E.D. Tex.)
- § 3:9 Enablement, written description, best mode, obviousness (E.D. Mich.)
- § 3:10 Written description, enablement, anticipation, verdict form (D. Kan.)
- § 3:11 Obviousness, limiting instruction on impact of PTO's grant of a reexamination on invalidity while admitting the evidence of the granted reexamination for purposes of willful infringement (D. Neb.)

II. EXCERPTS OF MODEL PATENT JURY INSTRUCTIONS ON INVALIDITY DEFENSES

- § 3:12 AIPLA Model Instructions
- § 3:13 Northern District of California Model Instruction
- § 3:14 National Jury Instruction Project's Model Patent Jury Instructions

CHAPTER 4. EQUITABLE & OTHER NON-INVALIDITY DEFENSES TO PATENT INFRINGEMENT

I. INSTRUCTIONS GIVEN IN ACTUAL CASES

- § 4:1 Inequitable conduct (S.D. Tex.)
- § 4:2 Inequitable conduct (E.D. Mich.)
- § 4:3 Laches and inequitable conduct, verdict form (E.D. Tex.)
- § 4:4 Inequitable conduct and unclean hands (W.D. Tex.)
- § 4:5 Express and implied license (M.D. Fla.)
- § 4:6 Implied License (E.D. Tex.)
- § 4:7 Patent Misuse based on marking with expired patent number (N.D. Iowa)
- § 4:8 Laches, equitable estoppel, and patent misuse (jury making findings for court's later use), patent exhaustion and repair/reconstruction, and special verdict form (E.D. Ky.)
- § 4:9 Intervening rights arising from reexamination (W.D. Wash.)
- § 4:10 Advisory verdict on Prosecution laches and Unclean Hands (C.D. Cal.)

II. EXCERPTS OF MODEL PATENT JURY INSTRUCTIONS

§ 4:11 AIPLA Model Instructions on Inequitable Conduct

CHAPTER 5. COMPENSATORY DAMAGES FOR INFRINGEMENT OF A UTILITY PATENT

I. INSTRUCTIONS ACTUALLY GIVEN BY COURTS ON DAMAGES

- § 5:1 Trial limited to damages and willful infringement—Lost profits due to lost sales, lost convoyed sales, price erosion, and market share—Reasonable royalty damages—Marking and/or actual notice—Verdict form (S.D. Tex.)
- § 5:2 Reasonable royalty damages—Jury to determine damages only if they find in favor of the patentee on the issues of infringement and validity (D. Kan.)
- § 5:3 Lost profits from lost sales, lost convoyed sales, and past and future price erosion—Reasonable royalty damages—Date damages began based on marking— Jury must determine damages even if they find in favor of the accused infringer—Verdict form (D. Minn.)
- § 5:4 Reasonable royalty accounting for infringer's actual and foreseeable profits, i.e., applying the "book of wisdom" and including all 16 Georgia-Pacific factors (M.D. Fla.)
- § 5:5 Reasonable royalty only, with specific instructions on precision of patentee's proof required to prove damages (E.D. Tex.)
- § 5:6 Reasonable royalty for a computer-based invention based on the entire market value rule and accounting for infringer's actual and foreseeable profits—Reissue claims substantially identical to original claims (S.D. Cal.)
- § 5:7 Reasonable royalty sought by a nonpracticing entity— Patentee asserting entitlement under the entire market value rule to overall assembly (S.D. Cal.)

II. EXCERPTS OF MODEL PATENT JURY INSTRUCTIONS ON DAMAGES

- § 5:8 AIPLA Model Instructions
- § 5:9 Northern District of California Model Instruction
- § 5:10 National Jury Instruction Project's Model Patent Jury Instructions