



February 20, 2009

National Patent Jury Instruction Project
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Dear Project Members:

IPO commends the members of the National Patent Jury Instruction Project for the excellent job in drafting what we believe is an easier to understand and streamlined set of model jury instructions. In performing our review, we kept in mind that creating a streamlined version of these instructions was a primary goal of this endeavor; however, we felt that in certain instances the proposed instructions missed some concepts. For example, we felt the means-plus-function instruction should mention infringement under the doctrine of equivalents. Accordingly, many of our comments provide suggestions to supplement instructions for completeness purposes. Other comments are directed at clarifying points of law, such as making suggestions to the willful infringement instruction.

A list of our more significant comments is set forth below in the order presented in the Model Patent Jury Instructions. These comments along with some additional suggestions (in redline) and IPO Comments on the draft instructions are also included as an attachment.

If you have any questions on any of our comments or would like to discuss possible revisions, please let us know.

SPECIFIC COMMENTS

A. Contentions of the Parties

The model instructions describe the patent holder's infringement allegation as contending that the alleged infringer makes, uses, offers to sell, or sells a [[product] [method]] that infringes [claim(s) in dispute] of the [XXX] patent. For completeness we suggested adding "or imports into the United States" to this instruction.

B. Direct Infringement

We recommend adding the following to the proposed instructions on direct infringement:

1) Instruction to address the "exactness" requirement of literal infringement. Litton Sys., Inc. v. Honeywell, Inc., 140 F.3d 1449, 1454 (Fed. Cir. 1998) ("Literal infringement requires that the accused device contain each limitation of the claim exactly; any deviation from the claim precludes a finding of literal infringement.").

2) Instructing that the infringement analysis must be performed individually for each asserted claim, and the comparison is not performed with respect to preferred or commercial

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embodiments of the claimed invention. Also include an instruction telling the jury to apply the ordinary meaning of the claims in the context of the patent specification and prosecution history for any claim term that the court has not construed.

3) “Joint infringement” instruction indicating the requisite “control or direction” that one party must have over the other in accord with Muniauction, Inc. v. Thomson corp., 532 F.3d 1318 (Fed. Cir. 2008) and BMC Resources, Inc. v. Paymentech, L.P., 498 F.3d 1373 (Fed. Cir. 2007)].

4) Infringement instructions on § 271(f)(1), § 271 (f)(2) and § 271 (g).

C. Direct Infringement – Doctrine of Equivalents

We suggest that where legal limitations on the doctrine of equivalents such as amendment-based and argument-based prosecution history estoppel, disclosure/dedication, disclaimer based on express claim language or statements in the specification, or ensnarement of the prior art, apply, the court, where appropriate, instruct the jury as to what scope of equivalents has been excluded, as these four legal limitations on the doctrine of equivalents are all questions of law. Honeywell Int’l, Inc. v. Hamilton Sunstrand Corp., 370 F.3d 1131, 1139 (Fed. Cir. 2004) (en banc) (“Whether a patentee is presumptively estopped from asserting equivalents for an amended claim element is a question of law that we review without deference.”); Pfizer, Inc. v. Teva Pharmaceuticals USA, Inc., 429 F.3d 1364, 1378 (Fed. Cir. 2005) (“Application of the disclosure-dedication rule is a question of law subject to de novo review.”); Ultra-Tex Surfaces, Inc. v. Hill Bros. Chemical Co., 204 F.3d 1360, 1363 (Fed. Cir. 2000) (“Whether an asserted scope of equivalents would impinge on prior art is an issue of law that we review de novo.”).

We also suggest adding an instruction on the defined role or functions of a claim limitation in assessing the insubstantiality of an alleged equivalent in accordance with Vehicular Technologies Corp. v. Titan Wheel Int’l, Inc., 212 F.3d 1377, 1382 (Fed. Cir. 2000) (“If this [omitted] function is ‘key,’ an accused device which does not perform this central function could rarely, if ever, be considered to be insubstantially changed from the claimed invention.”).

D. Direct Infringement – Means-Plus-Function

The means-plus-function instruction should mention infringement under the doctrine of equivalents. ACTV, Inc. v. The Walt Disney Co., 346 F.3d 1082, 1094 (Fed. Cir. 2003) (ruling district court erred in summarily dismissing doctrine of equivalents claims relating to means-plus-function limitations and stating “Although the analyses of insubstantial difference are similar, a court must conduct a separate infringement analysis under the doctrine of equivalents after conducting an analysis of literal infringement for claim limitations written in means-plus-function format if both literal infringement and infringement under the doctrine of equivalents are asserted.” Apex Inc. v. Raritan Computer, Inc., 325 F.3d 1364, 1378 (Fed. Cir. 2003). For a limitation written in means-plus-function form, evidence and arguments concerning equivalents under § 112, ¶ 6 may substantially overlap with those concerning the doctrine of equivalents. However, the evidence and arguments concerning the two ‘types’ of equivalents, and their respective analyses, are by no means perfectly coextensive.” – vacating summary judgment of noninfringement).

Accordingly, we propose adding the following to the instruction: “If the function performed by

the structure is not identical to the function recited in the means-plus-function limitation, the patent owner may prove that the accused product is covered by the means-plus-function limitation under the doctrine of equivalents. To prove equivalents, the patent owner must prove, first, that the accused product contains a structure that performs an equivalent function to the one recited in the claim limitation; and second, that the structure that performs that function is identical or equivalent to the structure described in the patent specification.”

Also to the extent the instructions will adopt the temporal distinction based on after-arising technology for doctrine of equivalents, known interchangeability, insubstantial differences, or same way-result, they could give rise to infringement under doctrine of equivalents if the accused product is after-arising technology. The current instructions only instruct on literal infringement based on interchangeability known at the time the application was filed.

E. Inducing Patent Infringement

We suggest in appropriate cases that the inducing infringement instruction address the use of an opinion of counsel to show no intent to cause infringement, what constitutes a competent opinion of counsel, and failure to obtain an opinion. DSU Medical Corp. v. JMS Co., Ltd., 471 F.3d 1293, 1307 (Fed. Cir. 2006) (opinion of counsel defeated showing of specific intent for inducing infringement).

F. Contributory Infringement

We edited a significant portion of this instruction because in our opinion the multipart definition of a component’s characteristics could be confusing to a jury. We suggest using the model instructions put forth by the AIPLA (section 3.3) with an instruction on the “substantial non-infringing use” standard. Further, in an appropriate case, the court may instruct the jury that an alleged infringer may be liable even though the challenged component it supplies has additional, separable features that permit a noninfringing use, if the alleged infringer is relying solely on those additional features to assert the component has a substantial noninfringing use. See Ricoh Co. v. Quanta Computer, Inc., No. 2007-1567, slip. pp. at 21-22 (Fed. Cir. December 23, 2008).

G. Willful Infringement

The proposed instruction seems to suggest that a jury needs to find willful infringement to allow the patentee to recover the full range of damages. So we suggest inserting: “Willful infringement” looks to see if the infringer failed to follow “reasonable commercial behavior” in its actions regarding the patent. Vulcan Engineering Co. v. Fata Aluminum, Inc., 278 F.3d 1366, 1378(Fed. Cir. 2002) (“The rules of patent infringement are rules of business ethics, and require prudent commercial actions in accordance with law.”).

Further, we believe that some language in this instruction is inconsistent with the language of Seagate. The instruction should include a clear and convincing standard, and should refer to the “objectively high likelihood” standard emphasized in Seagate. Many jury instructions now list the three elements of willfulness: 1. aware of patent, 2. acted despite high likelihood, 3. known or should have known of high likelihood. These instructions then list factors that make up the “totality of circumstances,” which are not necessarily limited to the state of mind prong.

Also, in some cases it may be appropriate to include the role of litigation defenses in the

assessment of objective recklessness. Black & Decker Inc. v. Robert Bosch Tool Corp., No. 2007-1243, 1244, 2008 WL 60501, *6-*7 (Fed. Cir. Jan. 7, 2008) (nonprecedential) (vacating infringement verdict and willfulness finding due to errors in claim construction and noting that litigation defenses had to be considered as a defense to willful infringement under Seagate).

H. Enablement

We suggest mentioning that the enablement instruction must be based on the level of ordinary skill existing at the time the application was filed (or its effective date). Plant Genetic Sys., N.V. v. DeKalb Genetics Corp., 315 F.3d 1335, 1339 (Fed. Cir. 2003) (“Enablement is determined as of the effective filing date of the patent[.]”).

The proposed enablement instruction identifies factors to consider in determining whether the written description would require undue experimentation. Having the “breadth of the claims” being just one of those factors to consider may not give full effect to the requirement that the claims must have a scope of enablement that is commensurate with the full scope of the claims. This “commensurate with the scope” has become more important where the claims cover two distinct alternative embodiments and only one embodiment is enabled. Sitrick v. Dreamworks, 516 F.3d 993, 999-1000 (Fed. Cir. 2008) (“The full scope of the claimed invention must be enabled. The rationale for this statutory requirement is straightforward. Enabling the full scope of each claim is ‘part of the quid pro quo of the patent bargain.’ A patentee who chooses broad claim language must make sure the broad claims are fully enabled. . . . Because the asserted claims are broad enough to cover both movies and video games, the patents must enable both embodiments. Even if the claims are enabled with respect to video games—an issue we need not decide—the claims are not enabled if the patents do not also enable for movies.”).

I. Anticipation – Publicly Used or Known, or Previously Published

We suggest mentioning that subject matter is inherently present in an item of prior art if the evidence makes clear that the missing descriptive matter is necessarily present and that it would be so recognized by persons of ordinary skill in the field of the invention.

J. Anticipation – Made or Invented by Someone Else

The instruction should include the following: “Conception is complete when one of ordinary skill in the field of the invention could construct the apparatus without unduly extensive research or experimentation.”

Also, the conception instruction appears to account for corroboration by noting the type of proof needed to show conception. But nothing in the reduction to practice instruction indicates the requirement that reduction to practice if being proven by inventor testimony must also be corroborated. We suggest adding an instruction that in order to establish an actual reduction to practice, an inventor’s testimony must be corroborated by independent evidence.

Finally, the instruction does not address the defense of patent invalidity based on failing to name (or misnaming) an inventor under 35 U.S.C. § 256.

K. Obviousness

We suggest replacing certain proposed teaching, suggestion, or motivation language in the instruction with the following: “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 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.”

L. Obviousness – (Alternative)

The proposed instruction seems to indicate that there are differing burdens of proof. It is our belief, however, that the accused infringer always bears the burden of proof to show obviousness. If the accused infringer shows a *prima facie* case of obviousness, the patentee may then attempt to rebut by showing that secondary considerations exist. Then looking at the *prima facie* case and the secondary considerations, *in toto*, the decision maker determines the issue of obviousness in view of the accused infringer’s clear and convincing evidentiary burden. Lindeman Maschinenfabrick GMBH v. American Hoist and Derrick Co., 730 F.2d 1452, 1461 (Fed. Cir. 1984). Under this structure, the patentee should only have a burden of production on secondary considerations, but never a burden of persuasion.

Sincerely,



Steven W. Miller
President

Attachment