



the testimony of the witnesses and the exhibits I have admitted in the record – but as you consider the evidence, both direct and circumstantial, you may make deductions and reach conclusions which reason and common sense lead you to make. “Direct evidence” is the testimony of one who asserts actual knowledge of a fact, such as an eye witness. “Circumstantial evidence” is proof of a chain of facts and circumstances tending to prove, or disprove, any fact in dispute. The law makes no distinction between the weight you may give to either direct or circumstantial evidence.

Remember that anything the lawyers say is not evidence in the case. And, except for my instructions to you on the law, you should disregard anything I may have said during the trial in arriving at your decision concerning the facts. It is your own recollection and interpretation of the evidence that controls.

**OBJECTIONS AND STRICKEN EVIDENCE No. 1(a)**

As to any offer of evidence that has been rejected or ruled out by the court, you, of course, must not conjecture as to what the answer might have been had I allowed the witness to answer or as to the reason for the objection; nor are you permitted to draw any inference from the question

itself. Nor can you speculate what an excluded exhibit might have shown.

It is indeed the duty of the lawyers for the respective parties to make objections when that particular lawyer believes that certain evidence which is offered would be, perhaps, inadmissible or in some manner prejudicial to his or her client.

With reference to the objections made by the lawyers, keep in mind that it is not a question of someone trying to keep anything away from you that you are supposed to hear. Rather, it is a matter of whether, under the Federal Rules of Evidence, the testimony is admissible. If it is not admissible, it must be excluded.

The important thing for you to remember is that if I have sustained an objection, you cannot consider the evidence or draw any inference from the fact that it was offered; but if I have admitted the evidence and overruled the objection, you may and can and should fully consider the evidence admitted.

Also, any evidence which may have been ordered to be stricken must be entirely disregarded by you in keeping with my instructions.

**BENCH CONFERENCES NO. 1(b)**

You observed during the course of the trial that the court from time to time called counsel to the bench for a conference. You are admonished not to draw any unfavorable inference or inferences whatever from these conferences for or against any of the parties to the case. If the court felt that the jury should hear anything that was discussed out of its hearing at the bench, the court permitted that to be presented to you in open court.

## **USE OF DEPOSITIONS NO. 2**

Some of the witness testimony was presented at trial in the form of a deposition. A deposition is a witness's sworn testimony that is taken before the trial. During a deposition, the witness is under oath and swears to tell the truth, and the lawyers for each party may ask questions. A court reporter is present and records the questions and answers. Deposition testimony is entitled to the same consideration as live testimony, and you must judge it in the same way as if the witness was testifying in court.

## **CREDIBILITY OF THE WITNESSES NO. 3**

Now, in saying that you must consider all of the evidence, I do not mean that you must accept all of the evidence as true or accurate. You should decide whether you believe what each witness had to say, and how

important that testimony was. In making that decision you may believe or disbelieve any witness, in whole or in part. Also, the number of witnesses testifying concerning any particular dispute is not controlling. In deciding whether you believe or do not believe any witness I suggest that you ask yourself a few questions: Did the witness impress you as one who was telling the truth? Did the witness have any particular reason not to tell the truth? Did the witness have a personal interest in the outcome of the case? Did the witness seem to have a good memory? Did the witness have the opportunity and ability to observe accurately the things he or she testified about? Did the witness appear to understand the questions clearly and answer them directly? Did the witness' testimony differ from other testimony or other evidence?

**IMPEACHMENT OF WITNESSES, INCONSISTENT STATEMENT NO. 4**

You should also ask yourself whether there was evidence tending to prove that the witness testified falsely concerning some important fact; or, whether there was evidence that at some other time the witness said or did something, or failed to say or do something, which was different from the testimony the witness gave before you during the trial.

You should keep in mind, of course, that a simple mistake by a

witness does not necessarily mean that the witness wasn't telling the truth as he or she remembers it. People naturally tend to forget some things or remember them inaccurately. So, if a witness misstated something, you must decide whether it was because of an innocent lapse in memory or an intentional deception. The significance of your decision may depend on whether the misstatement is about an important fact or about an unimportant detail.

#### **RULE 30(b)(6) WITNESSES NO. 5**

Corporations and other organizations can be deposed using the procedure in Federal Rule of Civil Procedure 30(b)(6). The party taking the deposition must serve a notice which describes with reasonable particularity the topics for examination. Then the organization must designate a person or persons who consent to testify on its behalf, and it can state the matters on which each person designated will testify. The persons designated by the organization must testify about information known or reasonably available to the organization. For answers within the designated topics, the Corporation is bound by the answers of its Rule 30(b)(6) deponents.

## **EXPERT WITNESSES NO. 6**

When knowledge of a technical subject matter might be helpful to the jury, a person having special training or experience in that technical field is permitted to state an opinion concerning those technical matters. Merely because such a witness has expressed an opinion, however, does not mean that you must accept that opinion. The same as with any other witness, it is up to you to decide whether to rely upon it. When a witness has been or will be paid for reviewing and testifying concerning the evidence, you may consider the possibility of bias and should view with caution the testimony of such a witness where court testimony is given with regularity and represents a significant portion of the witness' income.

## **CONTENTIONS OF THE PARTIES NO. 7**

NXP contends that BlackBerry makes, uses, offers to sell, sells or imports products that infringe claims 13-17 of the '455 patent; claim 1 of the '654 patent; and claim 3 of the '420 patent. BlackBerry denies that it has infringed any claims of the patents-in-suit, whether directly or by inducing infringement of any of the asserted claims.

BlackBerry also contends that all of the asserted claims are invalid. Invalidity is a defense to infringement. Therefore, even though the United

States Patent and Trademark Office examiner has allowed the claims of the patents-in-suit, you, the jury, must decide whether any of the asserted claims of the patents-in-suit are invalid.

Your job is to decide whether the asserted claims of the patents-in-suit have been infringed and whether any of the asserted claims of the patents-in-suit are invalid. If you decide that any claim of any of the patents-in-suit has been infringed and is not invalid, you will then need to decide any money damages to be awarded to NXP as compensation for the infringement.

### **BURDENS OF PROOF NO. 8**

As I told you at the beginning of the trial, in any legal action, facts must be proved by a required amount of evidence, known as the “burden of proof.” In a patent case such as this, there are two different burdens of proof that are used. The first is the “preponderance of the evidence” standard and the second is the “clear and convincing” standard.

The “preponderance of the evidence” standard means that the evidence persuades you that a claim is more likely true than not true.

The “clear and convincing” standard means that the evidence has

persuaded you that a defense is highly probable. The clear and convincing evidence standard requires a greater degree of proof than is necessary for the preponderance of the evidence standard.

NXP has the burden of proving infringement by a preponderance of the evidence. In determining whether any fact has been proved by a preponderance of the evidence, you may, unless otherwise instructed, consider the stipulations, the testimony of all witnesses regardless of who may have called them, and all exhibits received in evidence regardless of who may have produced them.

The patents-in-suit are presumed to be valid. BlackBerry has the burden of overcoming that presumption and proving invalidity of the patents-in-suit by clear and convincing evidence. In determining whether any fact has been proved by clear and convincing evidence, you may, unless otherwise instructed, consider stipulations, the testimony of all witnesses regardless of who may have called them, and all exhibits received in evidence regardless of who may have produced them.

### **THE ROLE OF THE CLAIMS OF THE PATENT NO. 9**

Before you can decide many of the issues in this case, you will need to understand the role of patent “claims.” The patent claims are the numbered

sentences at the end of each patent. The claims are important because it is the words of the claims that define what a patent covers. The figures and text in the rest of the patent provide a description and/or examples of the invention and provide a context for the claims, but it is the claims that define the breadth of the patent's coverage. Each claim is effectively treated as if it were a separate patent, and each claim may cover more or less than another claim. Therefore, what a patent covers depends, in turn, on what each of its claims covers.

You will first need to understand what each claim covers in order to decide whether or not there is infringement of the claim and to decide whether or not the claim is invalid. The law says that it is my role to define the terms of the claims and it is your role to apply my definitions to the issues that you are asked to decide in this case. Therefore, as I explained to you at the start of the trial, I have determined the meaning of the claims. The meaning of those terms are set forth at the end of these instructions. You must accept my definitions of these words in the claims as being correct. It is your job to take these definitions and apply them to the issues that you are deciding, including the issues of infringement and validity. To the extent that I have not defined a term or phrase, you are to apply the

plain and ordinary meaning of that term or phrase.

### **HOW A CLAIM DEFINES WHAT IS COVERS NO. 10**

I will now explain how a claim defines what it covers.

A claim sets forth, in words, a set of requirements. Each claim sets forth its requirements in a single sentence. If a device or a method satisfies each of these requirements, then it is covered by the claim.

There can be several claims in a patent. Each claim may be narrower or broader than another claim by setting forth more or fewer requirements. The coverage of a patent is assessed claim-by-claim. In patent law, the requirements of a claim are often referred to as “claim elements” or “claim limitations.” When a thing (such as a product) meets all of the requirements of a claim, the claim is said to “cover” that thing, and that thing is said to “fall” within the scope of that claim. In other words, a claim covers a product where each of the claim elements or limitations is present in that product.

Sometimes the words in a patent claim are difficult to understand, and therefore it is difficult to understand what requirements these words impose. It is my job to explain to you the meaning of the words in the claims and the requirements these words impose. As I just instructed you, there are certain

specific terms that I have defined and you are to apply the definitions that I provide to you.

By understanding the meaning of the words in a claim and by understanding that the words in a claim set forth the requirements that a product must meet in order to be covered by that claim, you will be able to understand the scope of coverage for each claim. Once you understand what each claim covers, then you are prepared to decide the issues that you will be asked to decide, such as infringement and invalidity.

### **INDEPENDENT AND DEPENDENT CLAIMS NO. 11**

This case involves two types of patent claims: independent claims and dependent claims. An “independent claim” sets forth all of the requirements that must be met in order to be covered by that claim. Thus, it is not necessary to look at any other claim to determine what an independent claim covers.

A dependent claim does not itself recite all of the requirements of the claim but refers to another claim for some of its requirements. In this way, the claim “depends” on another claim. A dependent claim incorporates all of the requirements of the claims to which it refers. The dependent claim then adds its own additional requirements. To determine what a

dependent claim covers, it is necessary to look at both the dependent claim and any other claims to which it refers. A product that meets all of the requirements of both the dependent claim and the claims to which it refers is covered by that dependent claim.

As a result, if you find that an independent claim is not infringed, you must also find that its dependent claims are not infringed. On the other hand, if you find that an independent claim has been infringed, you must still separately decide whether the additional requirements of its dependent claims have also been infringed.

### **OPEN-ENDED OR “COMPRISING CLAIMS” NO. 12**

The beginning, or preamble, of all of the asserted claims use the word “comprising.” “Comprising” means “including” or “containing but not limited to.” For example, if you decide that an accused product includes all the requirements or steps in that claim, the claim is infringed. This is true even if the accused product includes components in addition to those requirements. For example, a claim to a table comprising a tabletop, legs, and glue would be infringed by a table that includes a tabletop, legs, and glue, even if the table also includes wheels on the table’s legs.

### **INFRINGEMENT GENERALLY NO. 13**

I will now instruct you how to decide whether or not BlackBerry has infringed the asserted patents. Infringement is assessed on a claim-by-claim basis. Therefore, there may be infringement as to one claim but no infringement as to another.

In deciding whether or not an accused product infringes a patent, the first step is to understand the meaning of the words used in the patent claims. It is my job as Judge to determine what the patent claims mean and to instruct you about that meaning. You must accept the meanings I give you and use those meanings when you decide whether or not the patent claims are infringed, and whether or not they are invalid. I have interpreted the meaning of some of the language in the patent claims involved in this case.

My interpretation of those claims appears in Appendix A to this charge. The claim language I have not interpreted for you in Appendix A is to be given its ordinary and accustomed meaning as understood by one of ordinary skill in the art. Throughout the trial you have heard reference of person of ordinary skill in the art. Later in these instructions, I will explain to you the meaning of one of ordinary skill in the art.

In this case, NXP has alleged that BlackBerry infringes the '420, '455, and '654 patents. In addition, NXP has also alleged that BlackBerry is also liable for indirectly infringing by actively inducing infringement of the '654 patent. BlackBerry denies that its products infringe, either directly or indirectly through active inducement.

#### **DIRECT INFRINGEMENT, GENERALLY NO. 14**

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

#### **DIRECT INFRINGEMENT – LITERAL INFRINGEMENT, NO. 15**

You must decide whether BlackBerry has made, used, sold, or offered for sale within the United States, or imported into the United States, products covered by claims 13-17 of the '455 patent; and claim 3 of the '420 patent. You must compare each claim to the accused BlackBerry products to determine whether every requirement of the claim is included in the

BlackBerry accused products.

To prove literal infringement, NXP must prove that it is more probable than not that the BlackBerry accused products include every requirement in NXP's patent claim. If the BlackBerry accused products omit any requirement recited in NXP's patent claim, BlackBerry does not infringe that claim. For literal infringement, NXP is not required to prove that BlackBerry intended to infringe or knew of the patent.

#### **DIRECT INFRINGEMENT – DOCTRINE OF EQUIVALENTS NO. 16**

NXP alleges that BlackBerry infringed claim 1 of the '654 patent and claim 3 of the '420 patent under the "doctrine of equivalents." A claim requirement is present in an accused product under the doctrine of equivalents if the difference between the claim requirement and a corresponding aspect of the accused product is insubstantial. To prevail on its allegations of infringement, NXP must prove that it is more probable than not that the accused product contains requirements identical or equivalent to each claimed requirement of the patented invention. You must proceed on a requirement-by-requirement basis. NXP must establish that each requirement in the claim is present in the accused product, either literally or

under the doctrine of equivalents.

In making this determination, you may consider whether the corresponding aspect performs substantially the same function in substantially the same way to achieve substantially the same result as the requirement in the claim. You may also consider whether people of ordinary skill in the art believed that the corresponding aspect of the accused product and the requirement recited in the patent claim were interchangeable at the time of the alleged infringement.

The proper time for evaluating equivalency-and thus knowledge of interchangeability between requirements is the time of infringement, not the time the patent was issued. Under the doctrine of equivalents, those of ordinary skill in the art do not have to know of the equivalent when the patent application was filed or when the patent issued. Thus, 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. In order to prove infringement by "equivalents," NXP must prove the equivalency of the structure to a claim element by a

preponderance of the evidence.

### **INDUCING PATENT INFRINGEMENT NO. 17**

NXP alleges that BlackBerry indirectly infringed claim 1 of the '654 patent. There are two types of indirect infringement, but only one is at issue in this case: inducing infringement. The act of knowingly encouraging or inducing others to infringe a patent is called "inducing infringement."

NXP alleges that BlackBerry is liable for infringement by actively inducing a user to directly infringe the '654 patent by placing MicroSD memory cards in BlackBerry products. As with direct infringement, you must determine whether there has been active inducement on a claim-by-claim, element-by-element basis.

BlackBerry is liable for active inducement of a claim only if NXP proves by a preponderance of the evidence that:

- (1) the acts are actually carried out by a user of BlackBerry products to directly infringe that claim;
- (2) BlackBerry took action during the time the '654 patent was in force intending to cause the user's infringing acts; and
- (3) BlackBerry was aware of the '654 patent and knew that the acts, if taken, would constitute infringement of that patent or BlackBerry believed there was a high probability that the acts, if taken, would constitute infringement of the '654 patent but

deliberately avoided confirming that belief.

In order to establish active inducement of infringement, it is not sufficient that a user of BlackBerry's products directly infringes the claim. Nor is it sufficient that BlackBerry was aware of the acts by the user that allegedly constitute the direct infringement. Rather, you must find that BlackBerry specifically intended for the user of its products to infringe the '654 patent or that BlackBerry believed there was a high probability that the user of its products would infringe the '654 patent - but remained willfully blind to the infringing nature of the user's acts - in order to find inducement of infringement.

### **INVALIDITY – GENERALLY NO. 18**

Patent invalidity is a defense to patent infringement. Even though the United States Patent and Trademark Office examiner has allowed the claims of a patent, you have the ultimate responsibility for deciding whether the claims of the patent are valid. I will now instruct you on the invalidity issues you should consider. As you consider these issues, remember that to prove that any claim of a patent is invalid, BlackBerry must persuade you by clear and convincing evidence, i.e., you must be left with a clear

conviction that the claim is invalid.

**ANTICIPATION – PUBLICLY USED OR KNOWN, OR PREVIOUSLY PUBLISHED NO. 19**

BlackBerry contends that claims 13-17 of the '455 patent and claim 1 of the '654 patent are invalid because the claimed invention is not new. For a claim to be invalid because it is not new, all of its requirements must have existed in a single device or method that predates the claimed invention, or must have been described in a single previous publication or patent that predates the claimed invention. In patent law, such previous device, method, publication or patent is called a "prior art reference." If a patent claim is not new we say it is "anticipated" by a prior art reference.

BlackBerry must prove by clear and convincing evidence that the claim was anticipated.

The disclosure in a prior art reference does not have to be in the same words as the claim. What is required is that all of the requirements of the claim must be there in some form, either explicitly or necessarily implied, so that someone of ordinary skill in the field looking at that one reference would be able to make and use at least one embodiment of the claimed invention.

Here is a list of the ways that BlackBerry can show that a patent claim was not new:

(1) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(2) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(3) he did not himself invent the subject matter sought to be patented.

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

### **PRIOR ART – CITED REFERENCES NO. 19(a)**

You have just heard me explain that a patent claim may be “anticipated” by a prior art reference and therefore invalid. Prior art is defined by law, and I will next give you specific instructions as to what constitutes prior art. The prior art references considered by a patent examiner during the patent prosecution process are listed on the face of a United States Patent. A patent lists the prior art that the patent examiner considered; this list is called the “cited references.” This list appears on the cover of a United States patent.

**PRIOR ART – PRIOR PRINTED PUBLICATION NO. 19(b)**

Now I will instruct you about prior art. Printed publications from anywhere in the world are prior art if the printed publications were published, either before the inventor made the claimed invention or more than one year before the application for the patent was filed.

For a reference to qualify as a prior printed publication, BlackBerry must prove that it is highly likely that the reference was accessible to that portion of the public concerned with the art to which the document relates, or in other words, that the reference was available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, could have located it.

**OBVIOUSNESS NO. 20**

In this case, BlackBerry contends that Claims 13-17 of the '455 Patent and Claim 3 of the '420 Patent are invalid as obvious. Even though an invention may not have been identically disclosed or described before it was made by an inventor, in order to be patentable, the invention must also not have been obvious to a person of ordinary skill in the field of technology of the patent at the time the invention was made. BlackBerry may establish that a patent claim is invalid by showing, by clear and convincing evidence,

that the claimed invention would have been obvious to persons having ordinary skill in the art at the time the invention was made in the field of the invention.

In considering whether the claimed invention was obvious, you must first determine the scope and content of the prior art. The scope and content of prior art for deciding whether the invention was obvious includes prior art in the same field as the claimed invention, regardless of the problem addressed by the item or reference, and prior art from different fields that a person of ordinary skill in the art using common sense might combine if familiar so as to solve the problem, like fitting together the pieces of a puzzle.

In determining whether a claimed invention is obvious, you must consider the level of ordinary skill in the field of the invention that someone would have had at the time the claimed invention was made, the scope and content of the prior art, and any differences between the prior art and the claimed invention.

In order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent, you may consider the background knowledge possessed by a person having ordinary skill in the art, including taking into account the inferences and

creative steps employed by a person of ordinary skill in the art. In considering whether a claimed invention is obvious, you may but are not required to find obviousness if you find that at the time of the claimed invention there was a reason that would have prompted a person having ordinary skill in the field of the invention to combine the known elements in a way the claimed invention does, taking into account such factors as:

- (1) whether the claimed invention was merely the predictable result of using prior art elements according to their known function(s);
- (2) whether the claimed invention provides an obvious solution to a known problem in the relevant field;
- (3) whether the prior art teaches or suggests the desirability of combining elements claimed in the invention;
- (4) whether the prior art teaches away from combining elements in the claimed invention;
- (5) whether it would have been obvious to try the combinations of elements, such as when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions; and
- (6) whether the change resulted more from design incentives or other market forces. To find it rendered the invention obvious, you must find that the prior art provided a reasonable expectation of success.

In determining whether the claimed invention was obvious, consider each claim separately. Do not use hindsight, i.e., consider only what was known at the time of the invention. Keep in mind that the existence of each

and every element of the claimed invention in the prior art does not necessarily prove obviousness. Most, if not all, inventions rely on building blocks of prior art.

In making these assessments, you should take into account any objective evidence (sometimes called "secondary considerations") that may have existed at the time of the invention and afterwards that may shed light on the obviousness or not of the claimed invention, such as:

- a. Whether the invention was commercially successful as a result of the merits of the claimed invention (rather than the result of design needs or market-pressure advertising or similar activities);
- b. Whether the invention satisfied a long-felt need;
- c. Whether others had tried and failed to make the invention;
- d. Whether others invented the invention at roughly the same time;
- e. Whether others copied the invention;
- f. Whether there were changes or related technologies or market needs contemporaneous with the invention;
- g. Whether the invention achieved unexpected results;
- h. Whether others in the field praised the invention;
- i. Whether persons having ordinary skill in the art of the invention expressed surprise or disbelief regarding the invention;
- j. Whether others sought or obtained rights to the patent from the patent holder; and

- k. Whether the inventor proceeded contrary to accepted wisdom in the field.

**LEVEL OF ORDINARY SKILL IN THE ART NO. 21**

Several times in my instructions I have referred to a person of ordinary skill in the art of the field of the invention. It is up to you to decide the level of ordinary skill in the art. You should consider all of the evidence introduced at trial in making this decision, including:

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

**WRITTEN DESCRIPTION NO. 22**

BlackBerry contends that claim 3 of the '420 patent is invalid for failure of the patent to provide an adequate written description of the claimed invention. A patent claim is invalid if the patent does not contain an adequate written description of the claimed invention. BlackBerry must prove that it is highly probable this claim lacked an adequate written description.

The written description requirement is satisfied if a person of ordinary skill in the field, reading the patent application as originally filed, would

recognize that the patent application described the invention of these claims, even though the description might not use the exact words found in the claim. The written description is adequate if it shows that the inventor was in possession of each claim of the invention at the time the application for the patent was filed, even though the claim may have been changed or new claims added during the prosecution of the application. It is not necessary that each and every aspect of the claim be explicitly discussed, as long as a person of ordinary skill would understand that any aspect not expressly discussed is implicit in the patent application as originally filed.

### **DAMAGES GENERALLY NO. 23**

I will instruct you about the measure of damages. By instructing you on damages, I am not suggesting which party should win on any issue. If you find that BlackBerry infringed any valid claim of the '455, '654, or '420 patents, you must then determine the amount of money damages to be awarded to NXP to compensate it for the infringement.

The amount of those damages must be adequate to compensate NXP for the infringement. A damages award should put the patent holder in approximately the financial position it would have been in had the infringement not occurred, but in no event may the damages award be less

than a reasonable royalty. In this case, NXP seeks a reasonable royalty. You should keep in mind that the damages you award are meant to compensate the patent holder and not to punish an infringer.

NXP has the burden of proving damages and also the burden of persuading you of the amount of its damages. You should award only those damages that NXP more likely than not suffered. While NXP is not required to prove its damages with mathematical precision, it must produce evidence to prove damages with reasonable certainty. NXP is not entitled to damages that are remote or speculative, and you should award damages only where there is evidence to support the claimed royalty rate.

#### **DAMAGES—REASONABLE ROYALTY NO. 24**

A royalty is a payment made to a patent holder in exchange for the right to make, use, or sell the claimed invention. A reasonable royalty is the amount of royalty payment that a patent holder and the infringer would have agreed to in a hypothetical negotiation taking place at a time prior to when the infringement first began. In considering this hypothetical negotiation, you should focus on what the expectations of the patent holder and the infringer would have been had they entered into an agreement at that time, and had they acted reasonably in their negotiations.

In determining this, you must assume that both parties believed the patent was valid and infringed and the patent holder and infringer were willing to enter into an agreement. The reasonable royalty you determine must be a royalty that would have resulted from the hypothetical negotiation, and not simply a royalty either party would have preferred. Evidence of things that happened after the infringement first began can be considered in evaluating the reasonable royalty only to the extent that the evidence aids in assessing what royalty would have resulted from a hypothetical negotiation. Although evidence of the actual profits an alleged infringer made may be used to determine the anticipated profits at the time of the hypothetical negotiation, the royalty may not be limited or increased based on the actual profits the alleged infringer made.

In determining the reasonable royalty, you should consider all the facts known and available to the parties at the time the infringement began. Some of the kinds of factors that you may consider in making your determination are:

- (1) The royalties received by the patentee for the licensing of the patent-in-suit, proving or tending to prove an established royalty.
- (2) The rates paid by the licensee for the use of other patents comparable to the patent-in-suit.

- (3) The nature and scope of the license, as exclusive or nonexclusive, or as restricted or nonrestricted in terms of territory or with respect to whom the manufactured product may be sold.
- (4) The licensor's established policy and marketing program to maintain his or her 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 licensor and licensee, such as whether they are competitors in the same territory in the same line of business, or whether they are inventor and promoter.
- (6) The effect of selling the patented specialty in promoting sales of other products of the licensee, the existing value of the invention to the licensor as a generator of sales of his nonpatented items, and the extent of such derivative or convoyed sales.
- (7) The duration of the patent and the term of the license.
- (8) The established profitability of the product made under the patents, its commercial success, and its current popularity.
- (9) The utility and advantages of the patented property over the 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 licensor, and the benefits to those who have used the invention.
- (11) The extent to which the infringer has made use of the invention and any evidence probative of 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 business

to allow for the use of the invention or analogous inventions.

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

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

infringement began.

**DAMAGES – WHEN DAMAGES BEGIN NO. 25**

In determining the amount of damages, you must determine when the damages began. Damages commence on the date that BlackBerry first infringed the '420, '654, and '455 patents.

**CLOSING INSTRUCTION NO. 26**

When you retire to the jury room to deliberate, you may take with you these instructions, your notes, and the exhibits that the Court has admitted into evidence. You should select one member of the jury as your foreperson. That person will preside over the deliberations and speak for you here in open court.

You have two main duties as jurors. The first one is to decide what the facts are from the evidence that you saw and heard here in court. Deciding what the facts are is your job, not mine, and nothing that I have said or done during this trial was meant to influence your decision about the facts in any way.

Your second duty is to take the law that I give you, apply it to the facts, and decide if, under the appropriate burden of proof, the parties have

established their claims. It is my job to instruct you about the law, and you are bound by the oath that you took at the beginning of the trial to follow the instructions that I give you, even if you personally disagree with them. This includes the instructions that I gave you before and during the trial, and these instructions. All the instructions are important, and you should consider them together as a whole.

Perform these duties fairly. Do not let any bias, sympathy or prejudice that you may feel toward one side or the other influence your decision in any way.

As jurors, you have a duty to consult with each other and to deliberate with the intention of reaching a verdict. Each of you must decide the case for yourself, but only after a full and impartial consideration of all of the evidence with your fellow jurors. Listen to each other carefully. In the course of your deliberations, you should feel free to re-examine your own views and to change your opinion based upon the evidence. But you should not give up your honest convictions about the evidence just because of the opinions of your fellow jurors. Nor should you change your mind just for the purpose of obtaining enough votes for a verdict.

When you start deliberating, do not talk to the jury officer, to me or to anyone but each other about the case. During your deliberations, you must

not communicate with or provide any information to anyone by any means about this case. You may not use any electronic device or media, such as a cell phone, smart phones, or computer of any kind; the internet, any internet service, or any text or instant messaging service like Twitter; or any internet chat room, blog, website, or social networking service such as Facebook, MySpace, LinkedIn, or YouTube, to communicate to anyone any information about this case or to conduct any research about this case until I accept your verdict.

If you have any questions or messages for me, you must write them down on a piece of paper, have the foreperson sign them, and give them to the jury officer. The officer will give them to me, and I will respond as soon as I can. I may have to talk to the lawyers about what you have asked, so it may take some time to get back to you.

One more thing about messages. Never write down or tell anyone how you stand on your votes. For example, do not write down or tell anyone that a certain number is voting one way or another. Your votes should stay secret until you are finished.

Your verdict must represent the considered judgment of each juror. In order for you as a jury to return a verdict, each juror must agree to the verdict. Your verdict must be unanimous.

A form of verdict has been prepared for you. It has a series of questions for you to answer. You will take this form to the jury room and when you have reached unanimous agreement as to your verdict, you will fill it in, and have your foreperson date and sign the form. You will then return to the courtroom and your foreperson will give your verdict. Unless I direct you otherwise, do not reveal your answers until you are discharged. After you have reached a verdict, you are not required to talk with anyone about the case unless I order you to do so.

Once again, I want to remind you that nothing about my instructions and nothing about the form of verdict is intended to suggest or convey in any way or manner what I think your verdict should be. It is your sole and exclusive duty and responsibility to determine the verdict.

Keep in mind that the dispute between the parties is, for them, a most serious matter. They and the court rely upon you to give full and conscientious deliberation and consideration to the issues and evidence before you.

Consider all the surrounding circumstances, the probabilities or improbabilities of the testimony, what counsel and the court have said. You should try to reach what is a just, true, and correct solution of the controversy submitted to you. In reaching your conclusion you should be

guided solely by the evidence which has been presented to you, the inferences drawn from the evidence, and the instructions of the court on the law. You should not be influenced by fear, favor, prejudice or sympathy. All the parties stand equally before the court, and each is entitled to the same fair and impartial treatment at your hands.

The court would ask counsel whether there has been a failure to charge on any substantial matter of law.