

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

STI HOLDINGS, INC.,
f/k/a Stoughton Trailers, Inc.,

Plaintiff,

09-cv-570-slc

v.

GREAT DANE LIMITED PARTNERSHIP,
Defendant.

POST-TRIAL INSTRUCTIONS

I. Introduction

Now that you have heard the evidence and the arguments, I will give you the instructions that will govern your deliberations in the jury room. It is my job to decide what rules of law apply to the case and to explain those rules to you. It is your job to follow the rules, even if you disagree with them or don't understand the reasons for them. You must follow all of the rules; you may not follow some and ignore others.

The decision you reach in the jury room must be unanimous. In other words, you must all agree on the answer to each question.

Your deliberations will be secret. You will never have to explain your verdict to anyone.

If you have formed any idea that I have an opinion about how the case should be decided, disregard that idea. It is your job, not mine, to decide the facts of this case.

The case will be submitted to you in the form of a special verdict consisting of 6 questions. You must answer all 6 questions. In answering the questions, you should consider only the evidence that has been received at this trial. Do not concern yourselves with whether your answers will be favorable to one side or another, or with what the final result of this lawsuit may be.

II. Burden of Proof

For those matters that must be proven by clear and convincing evidence, you must be persuaded by the testimony and exhibits that it is highly probable that the matter sought to be proved is true. This is a higher burden of proof than “preponderance of the evidence,” but it does not require that the truth of the matter be established beyond a reasonable doubt. You should base your decision on all of the evidence, regardless of which party presented it.

III. Answers Not Based on Guesswork

If, after you have discussed the testimony and all other evidence that bears upon a particular question, you find that the evidence is so uncertain or inadequate that you have to guess what the answer should be, then the party having the burden of proof as to that question has not met the required burden of proof. Your answers are not to be based on guesswork or speculation. They are to be based upon credible evidence from

which you can find the existence of the facts that the party must prove in order to satisfy the burden of proof on the question under consideration.

IV. The Patent

A patent includes two basic parts: a written description of the invention and the patent claims. The written description, which may include drawings, is often called the “specification” of the patent.

The claims of a patent are the numbered sentences at the end of the patent. The claims describe what the patent owner may prevent others from doing. Claims are usually divided into parts called “limitations” or “requirements.” For example, a claim that covers the invention of a table may describe the tabletop, four legs and glue that holds the legs and the tabletop together. The tabletop, legs and glue are each a separate limitation or requirement of the claim.

V. Independent and Dependent Claims

Patent claims may exist in two forms, either independent claims or dependent claims. An independent claim stands on its own and does not refer to any other claim of the patent. A dependent claim refers to at least one other claim in the patent. A dependent claim includes each of the requirements of the other claim to which it refers, as well as the requirements in the dependent claim itself.

In the hypothetical patent claim for a table that described the tabletop, four legs, and glue to hold the legs and tabletop together, the description would be an example of an independent claim. In that same hypothetical patent, a dependent claim might be one that stated, "the same table in the initial claim, where the tabletop is square."

VI. The Meaning of Claim Terms

This case involves claims 2 and 16 of the '564 patent and 2 and 17 of the '902 patent. Great Dane contends that these claims are invalid. To decide the question of validity, you must first understand what the claims of the patents cover, that is, what they prevent anyone else from doing. This is called "claim interpretation" or "claim construction."

It is my duty under the law to interpret what the words used in the patent claims mean. I have made my determination and I will instruct you accordingly. You must apply the meanings I am about to give you when you decide whether claims 2 and 16 of the '564 patent and 2 and 17 of the '902 patent are invalid.

As used in claims 2 and 16 of the '564 patent and 2 and 17 of the '902 patent:

- "Main plateau" means "a portion of a panel;"
- "Having a" means "having at least one," an open term that does not preclude additional elements; and
- "Comprising" means "including but not limited to," an open term that does not preclude additional elements.

- “Panel” means a “discrete structure capable of being coupled to another discrete structure.”

You should give the rest of the words in the claims their ordinary meaning in the context of the patent specification and prosecution history. In doing so, keep in mind that an inventor can define his or her own claim terms.

VII. Invalidity

Patent invalidity is a defense to patent infringement. Great Dane contends that claims 2 and 16 of the ‘564 patent and 2 and 17 of the ‘902 patent are invalid. Because patent claims are presumed to be valid, Great Dane has the burden of proving invalidity by clear and convincing evidence. “Clear and convincing” evidence means evidence that convinces you that it is highly probable that the particular proposition is true.

To answer the special verdict questions, you must determine whether each asserted claim is invalid because it is anticipated, because it is obvious or both.

You must evaluate and determine separately the validity of each claim of the patents.

Questions of invalidity involve comparing the disputed claims in the patent to devices, methods, publications or patents that predate the claimed invention to determine whether the claimed invention is a new invention. Such previous device, method, publication or patent is commonly referred to as a “prior art reference.”

VIII. Anticipation

Questions No. 1 and No. 2 ask whether Great Dane has proven by clear and convincing evidence that claims 2 and 16, respectively, of the '564 patent are invalid as anticipated.

A person cannot obtain a patent if someone else already has made an identical invention. Simply put, the invention must be new. If there is a prior art reference that already shows every limitation of the same invention covered by a patent claim, then the claim is invalid because it is “anticipated” by the prior art.

To anticipate a claim, each and every element in the claim must be present in a single item of prior art. You may not combine two or more items of prior art to prove anticipation.

You may answer “yes” to Questions 1 and 2 only if you find that Great Dane has proven by clear and convincing evidence that:

- (1) All of the requirements of the claim are expressly stated or shown in a single item of prior art. Drawings and pictures can anticipate claims if they clearly show all the claimed structural features and how they are put together. Proportions of features in a drawing, however, are not evidence of actual proportions unless there is reason to think the drawing is to scale or is intended to represent a particular dimension or proportionality. And,
- (2) A person of ordinary skill in the field of the invention, looking at the single prior art item, would be able to make and use the invention disclosed in the claim.

If you find that Great Dane has proved each of these two matters by clear and convincing evidence as to a particular patent claim, then you must find for Great Dane on that patent claim.

You should also consider not only what is expressly disclosed in the prior art, but also what inherently resulted from its practice. This is called “inherency.” A party claiming inherency must prove it by clear and convincing evidence. To establish inherency, the evidence must make clear that the prior art either necessarily resulted in the missing descriptive matter and that it would be so recognized by a person of ordinary skill in the art at the time the patent application was filed. It is not required, however, that the person of ordinary skill would have recognized the inherent disclosure. Thus, the prior use of the patented invention that was unrecognized and unappreciated can still be an invalidating anticipation.

IX. Obviousness

Questions 3 through 6 of the special verdict form ask whether Great Dane has proven by clear and convincing evidence that claims 2 and 16 of the ‘564 patent and claims 2 and 17 of the ‘902 patent are obvious over the prior art.

You may answer “yes” with respect to any of Questions Nos. 3 through 6 only if you find that Great Dane has proven by clear and convincing evidence that, for each

claim being challenged, a person of ordinary skill in the invention, who knew about all the prior art existing at the time the invention was made, would have come up with the claimed invention at the time. Unlike anticipation, which allows consideration of only one item of prior art, obviousness may be shown by considering more than one item of prior art. Obviousness may also be shown by demonstrating that one item of prior art could have been modified in an obvious way.

In considering whether Great Dane has established that claims 2 and 16 of the '564 patent and claims 2 and 17 of the '902 patent are obvious, you should consider:

1. the scope and content of the prior art relied upon by Great Dane;
2. the difference or differences, if any, between each of claims 2 and 16 of the '564 patent and claims 2 and 17 of the '902 patent that Great Dane contends is obvious and the prior art;
3. the level of ordinary skill in the art at the time the invention of claims 2 and 16 of the '564 patent and claims 2 and 17 of the '902 patent were made; and
4. additional considerations, if any, that indicate that the invention was obvious or not obvious.

Each of these factors must be evaluated, although they may be analyzed in any order, and you must perform a separate analysis for each of the claims.

A. Scope and Content of Prior Art

You must determine what is the prior art that may be considered in determining whether claims 2 and 16 of the '564 patent and claims 2 and 17 of the '902 patents are obvious. A prior art reference may be considered if it discloses information designed to solve the same problem(s) faced by the inventor or if the reference discloses information that has obvious uses beyond its main purpose that a person of ordinary skill in the art would reasonably examine to solve the same problem(s) faced by the inventor.

B. Differences Between the Claimed Invention and the Prior Art

You should analyze whether there are any relevant differences between the prior art and the claimed invention from the view of a person of ordinary skill in the art at the time of the invention. Your analysis must determine the impact, if any, of such differences on the obviousness or nonobviousness of the invention as a whole, and not merely some portion of it.

In analyzing the relevance of the differences between the claimed invention and the prior art, you do not need to look for precise teaching in the prior art directed to the subject matter of the claimed invention. You may take into account the inferences and creative steps that a person of ordinary skill in the art would have employed in reviewing

the prior art at the time of the invention. For example, if the claimed invention combined elements known in the prior art and the combination yielded results that were predictable to a person of ordinary skill in the art at the time of the invention, then this evidence would make it more likely that the claim was obvious. On the other hand, if the combination of known elements yielded unexpected or unpredictable results, or if the prior art teaches away from combining the known elements, then this evidence would make it more likely that the claim that successfully combined those elements was not obvious.

Importantly, a claim is not proved obvious merely by demonstrating that each of the elements was independently known in the prior art. Most, if not all, inventions rely on building blocks long since uncovered, and claimed discoveries almost of necessity will likely be combinations of what is already known. Therefore, you should consider whether a reason existed at the time of the invention that would have prompted a person of ordinary skill in the art in the relevant field to combine the known elements in the way the claimed invention does. The reason could come from the prior art, the background knowledge of one of ordinary skill in the art, the nature of the problem to be solved, market demand, or common sense.

If you find that a reason existed at the time of the invention to combine the elements of the prior art to arrive at the claimed invention, this evidence would make it more likely that the claimed invention was obvious.

Again, you must undertake this analysis separately for each claim that Great Dane contends is obvious.

C. Level of Ordinary Skill

The determination of whether a claimed invention is obvious is based on the perspective of a person of ordinary skill in the art. The person of ordinary skill is presumed to know all prior art that you have determined to be reasonably relevant. The person of ordinary skill is also a person of ordinary creativity that can use common sense to solve problems.

Stoughton and Great Dane agree that the level of ordinary skill in the art is someone with a degree in mechanical engineering and at least five years in designing and constructing trailers.

D. Factors Indicating Nonobviousness

Before deciding the issue of obviousness, you must also consider certain factors, which, if established, may indicate that the invention would not have been obvious. No factor alone is dispositive, and you must consider the obviousness or nonobviousness of the invention as a whole.

1. Were products covered by the claim commercially successful due to the merits of the claimed invention rather than due to advertising, promotion, salesmanship, or features of the product other than those found in the claim?
2. Was there long felt need for a solution to the problem facing the inventors, which was satisfied by the claimed invention?
3. Did others try, but fail, to solve the problem solved by the claimed invention?
4. Did others copy the claimed invention?
5. Did the claimed invention achieve unexpectedly superior results over the closest prior art?
6. Did others in the field, or Great Dane praise the claimed invention or express surprise at the making of the claimed invention?

Not all of these factors may be present. No single factor is more or less important than the others. When you consider these factors, keep in mind that each factor should be considered as it relates to the "claimed invention," that is, the scope of the patent claims themselves.

X. Suggestions for Conducting Deliberations

In order to help you determine the facts, you may want to consider discussing one claim at a time, and use my instructions to the jury as a guide to determine whether there is sufficient evidence to prove all the necessary legal elements for each claim or defense. I also suggest that any public votes on a verdict be delayed until everyone can have a chance to say what they think without worrying what others on the panel might think of their opinion. I also suggest that you assign separate tasks, such as note taking, time keeping and recording votes to more than one person to help break up the workload during your deliberations. I encourage you at all times to keep an open mind if you ever disagree or come to conclusions that are different from those of your fellow jurors. Listening carefully and thinking about the other juror's point of view may help you understand that juror's position better or give you a better way to explain why you think your position is correct.

XI. Selection of Presiding Juror; Communication with the Judge; Verdict

When you go to the jury room to begin considering the evidence in this case you should first select one of the members of the jury to act as your presiding juror. This person will help to guide your discussions in the jury room.

You are free to deliberate in any way you decide or select whomever you like as a presiding juror. However, I am going to provide some general suggestions on the process to help you get started. When thinking about who should be presiding juror, you may want to consider the role that the presiding juror usually plays. He or she serves as the chairperson during the deliberations and has the responsibility of insuring that all jurors who desire to speak have a chance to do so before any vote. The presiding juror should guide the discussion and encourage all jurors to participate.

Once you are in the jury room, if you need to communicate with me, the presiding juror will send a written message to me. However, don't tell me how you stand as to your verdict.

As I have mentioned before, the decision you reach must be unanimous; you must all agree.

When you have reached a decision, the presiding juror will sign the verdict form, put a date on it, and all of you will return with the verdict into the court.