

To Obtain a Patent Non-Infringement Opinion, Or Not to Obtain It. That's the Question!

Obtener o no obtener una opinión de no infringir patentes. ¡Esa es la cuestión!

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Summary

This paper aims at analyzing the risk of whether to acquire a patent non-infringement opinion. After *Seagate*, there have been many decisions of either district courts or Federal Circuit involving willful infringement. This paper discusses some observations from those decisions. The observations give a basis for thinking of whether to acquire a patent non-infringement opinion. The analysis is presented in view of a potential or accused infringer, Company T. Company T could be accused of direct or indirect infringement. By discussing either Federal Circuit's or district courts' cases after *Seagate*, this paper suggests that though there is no duty to get a patent non-infringement opinion, the best strategy for an accused infringer would still be to have such opinion letter.

Keywords

Willful Infringement / Patent / Non-infringement Opinion.

Resumen

Este trabajo pretende analizar el riesgo al adquirir una opinión de no infringir patentes. Después del caso *Seagate*, han aparecido muchas decisiones de los tribunales distritales o del Tribunal de Circuito Federal que han implicado infracciones intencionales. Este documento articula algunas observaciones de esas decisiones que dan una base para pensar en si se debería adquirir una opinión de no infringir patentes. El análisis está presentado para analizar a un infractor, sea potencial o ya acusado: la compañía T que podría ser acusada de violación directa o indirecta. Al analizar y discutir los casos federales de circuito o de juzgados de distrito después del caso *Seagate*, este texto sugiere que no hay ninguna obligación de obtener una opinión de no infringir patentes y que la mejor estrategia para un infractor, sea potencial o ya acusado, sería obtener tal carta de opinión.

Palabras clave

Infracción intencional / Opinión de patentes / Infracción.

1. Introduction²

The United States Patent Law is a driving force for the American economy because it creates incentives for developing new technology or products (Sung, 1999, pp. 1223, 1235-1236). Not only the U.S. citizens or entities but also people outside the U.S. territory are concerned

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with the patent law very much. The key reason is that the judicial system strongly supports patentees (Brandt, 2008, pp. 699, 702)³. The most threatening tool used by courts is “punitive damages” that is vested in Title 35 of the United States Code, Section 284 (hereafter “35 U.S.C. § 284”). Courts will implement this tool only when willful infringement is found (Vickers, 2005, pp. 337, 344). But, the Fed. Cir. case law had created a hurdle of establishing willful infringement.

In 2007, the United States Court of Appeals for the Fed. Cir. (hereafter, “US Fed. Cir”) issued a decision, *In re Seagate Tech., L LC* (hereafter, “Seagate”) and changed the law of willful infringement. The old rule of willful infringement required evaluation of circumstantial evidence by looking to the factors, such as:

(1) whether the infringer deliberately copied the ideas or design of another; [...] (2) whether the infringer, when he knew of the other’s patent protection, investigated the scope of the patent and formed a good-faith belief that it was invalid or that it was not infringed; and (3) the infringer’s behavior as a party to the litigation (US Fed. Cir., 1992, *Read Corp. v. Portec, Inc.*, 816, 827).

It is called the “due care” standard (US Fed. Cir., 2007, *Seagate*, 1368-1369). But, *Seagate* adopted “the objective recklessness standard” (Prati, 2007, pp. 47-48). The standard was inspired by the Supreme Court’s indication of harmonizing the remedy standards of the patent law and copyright law (US Fed. Cir., 2007, *Seagate*, 1370) and by one Supreme Court’s decision regarding the willfulness requirement for punitive damages in the Fair Credit Reporting Act⁴.

But, *Seagate* established an objective recklessness standard that is a two-step test (Seaman, 2012, pp. 417, 464). The first question is “by clear and convincing evidence [whether] the infringer acted despite an objectively high likelihood that its actions constituted infringement of a valid patent” (US Fed. Cir., 2007, *Seagate*, 1371)⁵. If the answer is yes, then the second question is whether “this objectively-defined risk (determined by the record developed in the infringement proceeding) was either known or so obvious that it should have been known to the accused infringer” (1371)⁶. To consider these two steps, the Fed. Cir. suggested that the context of “commerce” might be a factor (1371).

The announcement of *Seagate* affected on-going trials in federal district courts. Some courts refused to review their willful infringement decisions again, because the surrounding facts still supported the finding of willful infringement under the *Seagate* test⁷, or because the defendant did not challenge the jury instruction about willful infringement⁸. Some courts decided not to review the willful infringement verdict, because they did not grant enhanced

³ Specially the part mentioning the trend of district courts’ (hereafter “US District Ct. [State]”) willingness to grant injunction relief before *eBay Inc. v. Mercexchange* (US Supreme Court, 2006, 388).

⁴ In the same document citing *Safeco Ins. Co. of Am. v. Burr* (US Supreme Court, 2007, 127).

⁵ The scenario for the first prong could be (1) a valid patent, (2) defendant’s weak invalidity arguments, which were rejected by the USPTO, (3) defendant’s failure to contest infringement, and (4) unconvincing arguments against the infringement of other patents at issue. See *Church & Dwight Co. v. Abbott Labs* (US District Ct. New Jersey, 2008).

⁶ The scenario for the second prong could be that (1) the plaintiff has informed the defendant of infringement, that (2) the defendant knew the possibility of infringement, that (3) the defendant did not change its products, that (4) the defendant only looked for the indemnifications from its suppliers, and that (5) the defendant sold its business unit to avoid infringement. See *Church & Dwight Co.* (US District Ct. NJ, 2008, at *28-*29).

⁷ See *Ball Aerosol & Specialty Container* (US Fed. Cir., 2008, 939, 953).

⁸ See *QPSX Devs. 5 PTY Ltd. v. Nortel Networks, Inc.* (US District Ct. Texas, 2008b).

damages⁹. And, some court granted a motion for judgment as a matter of law or a new trial, because the judgment regarding the validity and infringement of the patent had already been entered and such judgment was affirmed by the Fed. Cir. (US Fed. Cir., *MercExchange, L.L.C. v. eBay*, 2007).

In addition, *Seagate* abrogated an affirmative duty to acquire non-infringement opinion letters by stating that “[b]ecause we abandon the affirmative duty of due care, we also reemphasize that there is no affirmative obligation to obtain opinion of counsel” (1371).

An accused infringer may look for a non-infringement opinion written by a legal counsel to support his good faith of not willfully infringing the patent (Imron, 1999, pp. 593, 597). The Fed. Cir. identified a counsel opinion as “an objective assessment for making informed business decisions” (US Fed. Cir., 2007, *Seagate*, 1373). Such counsel opinion should be a “competent legal opinion of non-infringement or invalidity which qualif[ies] as ‘due care’ before undertaking any potentially infringing activity” (1373)¹⁰. Although an accused infringer may have no duty to acquire a counsel opinion, a competent counsel opinion may still help defend against willful infringement (Anderson, 2008). Additionally, providing a counsel opinion as a defense will not waive the attorney-client privilege regarding the accused infringer’s trial attorneys¹¹ as well as the work products made by them¹².

There are three categories of counsel opinions. The first one is to show that the patent is either invalid or unenforceable so that the “infringing” activities are safe (Aly, 1999, p. 605). The second one is to show that the patent is not infringed (p. 605). A basic patent non-infringement opinion includes “that the patent [in dispute] is invalid, unenforceable, and/or not infringed” (US Fed. Cir., 2007, *Seagate*, 1369)¹³. The third one is to demonstrate that the patent is either valid or likely infringed so that the infringing activities should be stopped or looking for alternative designs is necessary (Aly, 1999, p. 605). The third category is concerned with the ethic aspect of business or legal practice (pp. 611-612).

Moreover, the competency of a patent non-infringement opinion has other issues. First, a written opinion is better than an oral opinion in terms of weighing credibility (Lafuze 2007, pp. 325-326). The author should be a U.S. patent attorney (pp. 326-327), and the direction of his or her opinion should not be inflexibly set in favor of the accused infringer (pp. 327-328). Second, an opinion should not be merely a conclusory statement, but must provide arguments supported by evidence, such as cases, prosecution history, and prior arts (pp. 329-331). The opinion also has to provide the investigation scope and the information of supporting documents (p. 330). Third, an opinion is not a one-stop shop. If there have been changes in the accused infringer’s product designs, a new opinion is required (p. 331). If the law is changed, an accused infringer has to acquire an updated opinion regarding the same facts (pp. 331-332).

The value of a patent non-infringement opinion arose from *Kloster Speedsteel AB v.*

⁹ See, e.g., *Informatica Corp. v. Bus. Objects Data Integration, Inc.* (US District Ct. N.D. California, 2007). *Baden Sports, Inc. v. Kabushiki Kaisha Molten*, (US Fed. Cir., 2009).

¹⁰ Citing *Crystal Semiconductor Corp. v. TriTech Microelectronics Int’l, Inc.*, (US Fed. Cir., 2001, 1336, 1352).

¹¹ “[W]e hold, as a general proposition, that asserting the advice of counsel defense and disclosing opinions of opinion counsel do not constitute waiver of the attorney-client privilege for communications with trial counsel. We do not purport to set out an absolute rule. Instead, trial courts remain free to exercise their discretion in unique circumstances to extend waiver to trial counsel, such as if a party or counsel engages in chicanery” (US Fed. Cir., 2007, *Seagate*, 1374).

¹² “[W]e hold that, as a general proposition, relying on opinion counsel’s work product does not waive work product immunity with respect to trial counsel. Again, we leave open the possibility that situations may arise in which waiver may be extended to trial counsel, such as if a party or his counsel engages in chicanery” (US Fed. Cir., 2007, *Seagate*, 1376).

¹³ See also *Aly* (1999, p. 606).

Crucible, Inc. where the Fed. Cir. stated that the defendant “ha[d] not even asserted that it sought advice of counsel when notified of the allowed claims and [the plaintiff’s] warning, or at any time before it began this litigation, [because] it either obtained no advice of counsel or did so and was advised that its importation and sale of the accused products would be an infringement of valid U.S. patents” (US Fed. Cir., 1986, 1580). However, in *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, the Fed. Cir. reversed that proposition and stated that “[a]lthough there continues to be ‘an affirmative duty of due care to avoid infringement of the known patent rights of others,’ *the failure to obtain an exculpatory opinion of counsel shall no longer provide an adverse inference or evidentiary presumption that such an opinion would have been unfavorable*” (US Fed. Cir., 2004, 1345-1346). This was the first time where the Fed. Cir. devalued a patent non-infringement opinion. After three years, *Seagate* demolished such value again, because the Fed. Cir. declared no affirmative duty of due care.

In 2008, the Fed. Cir. in *Broadcom Corp. v. Qualcomm, Inc.* (hereafter “Broadcom”) indicated that failure to acquire counsel opinions may still be a factor in considering the willful, induced infringement. Induced infringement is vested in 35 U.S.C. § 271(b), which provides: “Whoever actively induces infringement of a patent shall be liable as an infringer” (US Fed. Cir., 2008, 683). To establish the induced infringement, direct infringement must exist (US Fed. Cir., 2007, *ACCO Brands, Inc. v. ABA Locks Mfr. Co.*, 1307, 1312)¹⁴. And, it must be shown that the accused infringer knowingly induced such direct infringement and possessed a specific intent to encourage it. Additionally, “specific intent” is proved by showing (1) that the accused infringer’s actions induced infringement and (2) that the accused infringer knew or should have known his actions induced such infringement (1307, 1312)¹⁵. Therefore, “inducement requires evidence of culpable conduct, directed to encouraging another’s infringement, not merely that the inducer had knowledge of the direct infringer’s activities” (US Fed. Cir., 2006, *DSU Med. Corp. v. JMS Co.*, 1306). Either direct evidence or circumstantial evidence can be used to prove “specific intent” (1306).

Before *Seagate*, the Fed. Cir. in *DSU Med. Corp. v. JMS Co.* affirmed a jury verdict, where the jury heard the evidence showing that both direct infringer and indirect infringer obtained a non-infringement opinion letter from U.S. patent counsels (US Fed. Cir., 2006, 1307). The *DSU* decision triggered one issue in *Broadcom*, where the defendant asserted that the district court erred in allowing the jury to consider the defendant’s failure to acquire a non-infringement opinion letter in order to determine the “specific intent” element of induced infringement (US Fed. Cir., 2008, *Broadcom*, 697).

In *Broadcom*, a patent non-infringement opinion played a role in the jury instructions for both induced infringement and willful infringement (698). The jury instruction regarding induced infringement included:

When considering whether Qualcomm knew or should have known that the induced actions would constitute infringement, in the totality of the circumstances, *you may consider all of the circumstances, including whether or not Qualcomm obtained the advice of a competent lawyer. I will explain the significance of advice of counsel in more detail in a moment (698, emphasis added [where Qualcomm was the defendant]).*

The jury instruction regarding willful infringement told:

¹⁴ Citing *Minn. Mining & Mfg. Co. v. Chemque*, (US Fed. Cir. 2002).

¹⁵ Citing *DSU Med. Corp. v. JMS Co* (US Fed. Cir., 2006, 1304).

In considering whether QUALCOMM acted in good faith, you should consider all the circumstances, including whether or not QUALCOMM obtained and followed the advice of a competent lawyer with regard to infringement. The absence of a lawyer's opinion, by itself, is insufficient to support a finding of willfulness, and *you may not assume that merely because a party did not obtain an opinion of counsel, the opinion would have been unfavorable. However, you may consider whether QUALCOMM sought a legal opinion as one factor in assessing whether, under the totality of the circumstances, any infringement by QUALCOMM was willful* (698-699, emphasis added).

Broadcom held that those two jury instructions complied with *Seagate* (699-700). The Fed. Cir. pointed out that *Seagate* did not change the "specific intent" requirement of induced infringement (699). Although recognizing that the standard for determining "specific intent" is higher than that for willful infringement, the Fed. Cir. stated that "a lack of culpability for willful infringement does not compel a finding of non-infringement under an inducement theory" (699). Moreover, the Fed. Cir. held that a non-infringement opinion letter is a factor for determining "whether the accused infringer 'knew or should have known' that its actions would cause another to directly infringe" (699). Thus, *Broadcom* indicated that in the context of induced infringement, the plaintiff could present the defendant's failure to obtain a patent non-infringement opinion as evidence of the "specific intent" element. Although *Broadcom* did not place any duty on the accused infringer of inducement, it indirectly instructed that the accused infringer should have done something to mitigate the adverse image regarding the "specific intent" element.

Seagate was not about a district court's decision of willful infringement but about a procedural ruling. But, the consequence was a catastrophe to patent attorneys. You may image a situation where now accused infringers are not likely to acquire a patent non-infringement opinion. The earnings of many IP firms could drop. Nonetheless, a patent non-infringement opinion had a meaningful value, because *Seagate* did not change the evidentiary determination of willful infringement which is "the totality of the circumstances" (US Fed. Cir., 2009, *Arlington Indus. v. Bridgeport Fittings, Inc.*, at *49). On the other hand, *Broadcom* actually secured the market of a patent non-infringement opinion for accused infringers involving induced infringement. Back then, probably all patent attorneys could keep smiling, and some IP firms could abandon their lay-off plans. The market of offering a patent non-infringement opinion returned. After *Seagate*, whether the accused infringer obtained such opinion was still a factor for district courts to determine willful infringement (Harkins, 2007, 24).

The situation changed in 2011 when Congress enacted the America Invents Act (Chen, 2016, 155, 157) and created 35 U.S.C. § 298 which provides:

The failure of an infringer to obtain the advice of counsel with respect to any allegedly infringed patent, or the failure of the infringer to present such advice to the court or jury, may not be used to prove that the accused infringer willfully infringed the patent or that the infringer intended to induce infringement of the patent (US Congress, 2011).

Congress expressly abrogated *Broadcom*¹⁶. However, the Supreme Court of the United States in *Halo Elecs., Inc. v. Pulse Elecs., Inc* (US Supreme Ct., 2016, 1923) has abrogated *Seagate*

¹⁶ See *Spectralytics, Inc. v. Cordis Corp.*, (Fed. Cir. 2011): "Section 298 applies to findings of both willfulness and intent to induce infringement—and thus legislatively abrogates the Federal Circuit's decision in *Broadcom Corp. v. Qualcomm Inc.*, 543 F.3d 683, 699 (US Fed. Cir., 2008)."; see also *Carson Optical Inc. v. eBay Inc.*, No. 15CV3793KAMSIL, 2016 WL 4385998, at *9 (E.D.N.Y. Aug. 17, 2016).

recently (1928). The legal characteristic of a patent non-infringement opinion may become an open question.

This paper aims at analyzing whether to acquire a patent non-infringement opinion. After *Seagate*, there have been many decisions of either district courts or Fed. Cir. involving willful infringement. This essay discusses some observations from those decisions. The observations give a basis for thinking of whether to acquire a patent non-infringement opinion¹⁷. The following analysis is presented in view of a potential or accused infringer, Company T. Company T could be accused of direct or indirect infringement.

Next, Part 2 discusses some general concerns about a patent non-infringement opinion. Part 3 analyzes whether a patent non-infringement opinion is necessary when Company T may face an accusation of direct infringement. Part 4 addresses the issues related to inducement. Part 5 discusses post-litigation concerns about whether to acquire a patent non-infringement opinion. By discussing either Federal Circuit's or district courts' cases after *Seagate*, this paper suggests that although there may be no duty to get a patent non-infringement opinion, the best strategy for an accused infringer would still be to have such opinion.

2. General Concerns

2.1. Actual Notice of Disputed Patents

35 U.S.C. § 287(a) provides that “*no damages shall be recovered* by the patentee in any action for infringement, *except on proof that the infringer was notified of the infringement* and continued to infringe thereafter, in which event *damages may be recovered only for infringement occurring after such notice*” (US Congress, 2011, emphasis added). In *GSI Group, Inc. v. Sukup Mfg. Co.* (US District Ct. Illinois, 2008, at *17), the district court agreed with one of the defendant's assertions that the plaintiff could not recover any damages before the litigation was filed, because the plaintiff did not provide the notice of the disputed patents. So, Company T may first check whether the disputed patent was publicly notified in accord with § 287(a). If the patentee fails to fulfill § 287(a), a patent non-infringement opinion may not be necessary. But, once the patentee starts a patent litigation, Company T will not have any excuses for willful infringement, because “[f]iling of an action for infringement shall constitute such notice” (US Congress, 2011). “Meaningful” infringement in terms of damages collection occurs after the plaintiff fulfills 35 U.S.C. § 287(a). That could be a good moment for Company T to think of whether to acquire a patent non-infringement opinion.

2.2. Enhanced Damages

A claim of willful infringement is so threatening, because the consequence can be at most treble damages awarded to the plaintiff¹⁸. However, “willful infringement” does not guarantee enhanced damages¹⁹. Nine factors, given to a district court judge to consider, include: “(1) whether the infringer deliberately copied the ideas or design of another; (2) *whether the infringer, when he knew of the other's patent protection, investigated the scope of the patent and formed a good-faith belief that it was invalid or that it was not infringed*; (3) the infringer's behavior as a party to the litigation; (4) Defendant's size and financial condition; (5) Closeness of the case; (6)

¹⁷ If Company T just stops the infringing activities, it definitely has no problem with willful infringement. See *Northbrook Digital Corp. v. Browster, Inc.* (US District Ct. Minnesota, 2008, at *17-*18).

¹⁸ See 35 U.S.C. § 284, 2: “In either event the court may increase the damages up to three times the amount found or assessed”; see also *Cohesive Techs., Inc. v. Waters Corp.* (US Fed. Cir., 2008, 1374): “[E]nhancement of damages must be premised on willful infringement or bad faith”.

¹⁹ See *Read Corp. v. Portec, Inc.*, (US Fed. Cir., 1992): “[A] finding of willful infringement does not mandate that damages be enhanced, much less mandate treble damages”.

Duration of defendant's misconduct; (7) Remedial action by the defendant; (8) Defendant's motivation for harm; (9) Whether defendant attempted to conceal its misconduct" (US District Ct. N.D. California, 2007, *Informatica Corp.*, Supp. 2d at 1084).

In considering the second factor, a district court will look to Company T's failure to determine whether the patent in dispute is invalid or not infringed as evidence²⁰. The court may favor Company T by considering the fact that Company T's technical department advised Company T that "there was a very good chance that the [disputed] patent was invalid" (US Fed. Cir., 2009, *Baden Sports, Inc.*, at *12-*13). However, failure to "obtain the opinion of competent outside counsel" does cause the second factor to favor an award of enhanced damages²¹.

2.3. Attorneys' Fees

Under 35 U.S.C. § 285, an award of reasonable attorney fees may be granted to the prevailing party in exceptional cases (US District Ct. N.D. California, 2007, *Informatica Corp.*, Supp. 2d at 1085). The exceptional cases include "willful infringement" (1086). If a district court refuses to grant attorney fees once willful infringement was found, it must "explain why the case is *not* exceptional" (US Fed. Cir., 2009, *Funai Elec. Co.*, 1618). That is, if Company T cannot get away from willful infringement, it will face a higher risk of paying attorneys' fees to the plaintiff/patentee, because the district court judge will bear a burden to find "not exceptional" so that he or she may rarely provide reasons for "not exceptional" (1618). Therefore, Company T should obtain a patent non-infringement opinion to reduce the risk of such award.

2.4. Evidence of No Willful Infringement

Company T could avoid the finding of willful infringement, if it conducts a patent review, which includes the disputed patents, before entering a market and if its "outside patent counsel was involved and did not identify any infringement issues"²². In the context of design-around, the Fed. Cir. in *Voda v. Cordis Corp* (US Fed. Cir., 2008, 1311) indicated that the evidence of acquiring counsel opinions about whether the redesigned products infringe the disputed patent could be a positive factor for finding that the defendant's objective recklessness did not exist (1328).

After entering the market, Company T would get an insurance of a finding of no willful infringement, if it acquires a patent non-infringement opinion. Although there is no affirmative duty to acquire such opinion letter, Company T's failure to do so could still be considered in a jury instruction on willful infringement. In *Minks v. Polaris Indus.* (US Fed. Cir., 2008, 1364) the Fed. Cir. ultimately affirmed the jury instruction about willful infringement, which included a factor of whether the defendant relied on competent legal advice (1380)²³. That is, failure to acquire competent legal advice might still be a factor of

²⁰ See *Wordtech Sys. v. Integrated Network Solutions, Corp.* (US District Ct., 2009, at *5).

²¹ See *Funai Elec. Co. v. Daewoo Elecs. Corp.* (US Fed. Cir., 2009, 1618) where the infringer only asked its own employees to analyze the possible infringement of its products and later looked for a South Korean law firm of no training in U.S. patent law to provide an opinion.

²² See *Honeywell Int'l Inc. v. Universal Avionics Sys. Corp.* "[P]erforming a patent review before entering the market with a new device evidences that Universal's conduct was not reckless. Further, knowledge of a patent does not mean willfulness" (US District Ct. Delaware, 2008, 643-644).

²³ Noticeably, the defendant in fact challenged the jury instruction that covered "whether [the defendant] exercised due care to avoid infringing the patent" (US Fed. Cir., 2008, 1380) Nonetheless, the Fed. Cir. held that the defendant did not make arguments or cite any evidence to assert that, "any alleged error affected its substantial rights or affected the fairness, integrity, or public reputation of judicial proceedings" (1380). That could mean that the phrase of "due care" may still be ok to appear in a jury instruction.

the totality of the circumstances regarding willful infringement²⁴. Maybe under 35 U.S.C. § 298, such evidence is not admissible. But, if any evidence implying the defendant's failure to acquire a patent non-infringement opinion is admitted, it is possible that jury may still give a negative judgment on such failure.

On the other hand, obtaining a patent non-infringement opinion does support that Company T acts in good faith to conduct "infringing" activities. In *TGIP, Inc. v. AT&T Corp.* (US District Ct. E.D. Texas, 2007, 561), the district court held that the plaintiff did not prove willful infringement by clear and convincing evidence, mainly because the defendant's continuous infringing activities were based on the opinions of non-infringement and invalidity provided by two famous patent firms (578-579)²⁵. In *Cohesive Techs., Inc. v. Waters Corp.* (US. Fed. Cir. 2008, 1351), the district court considered "whether the infringer solicited or followed the advice of counsel" as a factor for determining willful infringement (103). Then, it found no willful infringement, partially because the defendant "obtained an opinion of counsel in good faith" (104).

Consulting with a patent attorney regarding the disputed patent may also help Company T win a motion for summary judgment on willful infringement. In *Pivonka v. Cent. Garden & Pet Co.* (US District Ct. Colorado, 2008), the district court granted the accused infringer's motion for summary judgment on the issue of willful infringement, because the accused infringer consulted with legal counsels after knowing the existence of the disputed patent (*6). In this situation, the accused infringer made the judge believe that "there were defenses to infringement"²⁶.

It should be noted that waiver of a defense relying on a patent non-infringement opinion could cause courts more likely to find willful infringement. In *Ball Aerosol & Specialty Container, Inc. v. Ltd. Brands, Inc.* (US Fed. Cir., 2008, 939)²⁷ the district court found willful infringement under the *Seagate* test, where the defendant waived an advice-of-counsel defense (955-956). Other facts included that the defendant was a previous supplier for the plaintiff (954), that the defendant was informed of the disputed patent (954), that the defendant sold the accused products without the plaintiff's permit (955), and that the plaintiff once sent a cease-and-desist letter to the defendant (955). So, if Company T is confronted with the defendant's situation in *Ball*, Company T should not waive an advice-of-counsel defense.

2.5. Scope of a Patent Non-Infringement Opinion

Because a patent attorney charges fees by working hours, Company T may think of the scope of a patent non-infringement opinion so that it will not spend too much money on the opinion letter. But, an opinion needs to be well drafted. In any events, an opinion cannot merely state that "no infringement could occur without a finding of infringement" (956).

The Fed. Cir. in *Finisar Corp. v. DirecTV Group, Inc.* (US Fed. Cir., 2008, 1323) announced that an opinion containing merely an analysis of non-infringement was sufficient for the defendant to stay away from objective recklessness (1339). In *Finisar*, the defendant only acquired a non-infringement opinion before proceeding to practice the accused system (1339). Rejecting the district's view that failure to acquire an opinion on validity is a negative

²⁴ A counsel opinion is still a defense tool against a willful infringement claim. See *Lucent Techs., Inc. v. Gateway* *11.

²⁵ Here, the district court actually held the disputed patents were not infringed (567).

²⁶ Here, the district court's decision did not show what content in the counsel opinion made it believe that the accused infringer thought that there were defenses against infringement.

²⁷ Vacated on another ground, 555 F.3d 984 (US Fed. Cir., 2009).

factor for considering willful infringement, the Fed. Cir. held that “[a patent] would have been a problem for [the defendant] if [the defendant] infringed it and it was valid” (1339). The Fed. Cir. further stated that “a competent opinion of counsel concluding either [non-infringement] or [invalidity] would provide a sufficient basis for [the defendant] to proceed without engaging in objectively reckless behavior [regarding the disputed patent] (1339)”.

However, there are more to be concerned with, and a pure non-infringement opinion may be less risky than an opinion that also covers validity analysis. Producing an opinion on non-infringement only needs the specification, drawings, and prosecution record of the disputed patent. This opinion will use those three sources to interpret the claims and determine whether infringement exists. On the other hand, drafting an opinion on validity needs more efforts. An attorney has to search for relevant prior arts. This work may cause a risk of knowing other potential infringed patents. Because the infringed patent in dispute and the accused product could be from similar technical fields, a patent used in the opinion to invalidate the infringed patent may also cover the accused product. So, when an opinion covering both non-infringement and validity is presented as evidence, it will show the defendant’s knowledge of the patents used for validity analysis could lead to a finding of recklessly infringing such patents.

3. Potential Direct Infringement

3.1. Situations Where Willful Infringement did not Exist

Some contexts of infringing activities have been identified as a situation where willful infringement did not exist. In those cases, perhaps a patent non-infringement opinion may not be required.

3.1.1. Ambiguous Claim Language

If the disputed claims are ambiguous in view of the specification and prosecution history, Company T need not look for patent non-infringement opinions. In *Cohesive Techs., Inc. v. Waters Corp.*, (US Fed. Cir., 2008, 1351) the Fed. Cir. held that willful infringement did not exist because of a suspicious term “rigid” that modifies “particles” (1374). The Fed. Cir. stated that it was reasonable for the defendant to conclude that “right particles” did not mean “polymeric particles,” which were used by accused products (1374). There, the undisputed ordinary meaning of “rigid particle” was “a particle that is monomeric, rather than polymeric” (1360). The specification only gave monomeric examples (1360). During the prosecution, the patentee asserted “truly rigid” in order to avoid anticipation under a prior art using polymeric materials for particles (1360).

Therefore, when confronted with a patent that has ambiguous terms, Company T may not need to get a patent non-infringement opinion. But, *Cohesive* was based particularly on technical or scientific arguments about the disputed terms. Because a person who can judge those arguments may still be a competent patent attorney, it may be safer for Company T to acquire a patent non-infringement opinion.

3.1.2. Careful Design-Around

It is possible that carefully designing around the disputed patent could help Company T get away from either willful infringement or treble damages. In *Muth Mirror Sys., LLC v. Gentex Corp.* (US Bankruptcy Ct. Wisconsin, 2007, 805), the court held that the willful infringement was not found and that “treble damages would not be appropriate,” not only because the defendant was aware of the numerical parameters of the disputed patent, but also because it “carefully [worked] around those limitations” (827). Noticeably, there the court’s ruling on willful infringement was based on a policy

reason. That is, “[i]nventing around patents is encouraged and promotes commerce and competition” (827)²⁸.

Muth indicates a situation where the disputed patent has claims that include some numerical limitations so that the Company T could easily get around it. But, the uncertainty is that Company T may not be sure whether the alternative designs could still be covered by the same disputed patent under the Doctrine of Equivalents (“DOE”)²⁹. So, the best suggestion is that Company T needs to find a patent attorney to evaluate infringement³⁰.

3.1.3. Prior Unsuccessful Patent Licensing Negotiation

If Company T was trying to get a license of the disputed patent, does Company T need to acquire a patent non-infringement opinion? According to *Franklin Elec. Co. v. Dover Corp.* (US District Ct. W.D. Wisconsin, 2007), the answer may be no. The district court in *Franklin* held that no willful infringement was found though the accused infringer was looking for the patent license. The issue there was about the second element of the *Seagate* test: “what defendant knew or should have known with respect to the likelihood of infringement” (*21-*23) Because “the defendant’s knowledge and state of mind” are irrelevant to the second element (*21-*23), the district court held that the defendant’s unsuccessful patent licensing was irrelevant to the *Seagate* test (*22-*23)³¹.

However, the application of *Franklin* may be limited, because a prior patent licensing negotiation is merely excluded when the likelihood of infringement is being determined. In some contexts, licensing negotiations may still be within an infringing activity. For example, Company T starts to negotiate with the plaintiff/patentee, because its patent search report for certain product or technology indicates that it needs the licensing agreement of such patent.

3.1.4. Prior Judicial Opinions Suspecting the Validity of the Disputed Patent

If the disputed patent is being adjudicated in some court, Company T may wait for the outcome before taking actions. Once the validity of the disputed patent is questioned by a court, Company T could act without objective recklessness to continue the accused infringing activities. In *Abbott Labs. v. Sandoz, Inc.* (US District Ct., N.D. Illinois, 2007, 996) the district court dismissed the willful infringement count, because in other prior litigation the Fed. Cir. reversed a preliminary injunction ruling by raising a validity issue of the disputed patent (1000).

It is not to say that Company T is safe when such prior judicial opinion comes out.

²⁸ Here, the court also commented on treble damages by saying that “[t]he integrity of that process was obvious in *Gentex*’s procedures and the care it took in manufacturing specifications. Treble damages would not be appropriate”. Although this comment is like a dictum, it still reflects that careful design-around mitigates treble damages.

²⁹ See *Hull* (2004, 343-344): “Under the doctrine of equivalents, ‘a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is ‘equivalence’ between the elements of the accused product or process and the claimed elements of the patented invention.’ In this way, the doctrine protects the patent holder from copiers who ‘make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law’” (footnotes omitted).

³⁰ In a very particular case where the defendant designed around the disputed patent without acquiring a counsel opinion, courts may hold that no willful infringement existed, if the disputed claim is so narrowly construed to include only “one piece” whereas the defendant used more than one component to make a counterpart of such “piece” (US District Ct. M.D. Pennsylvania, 2007, 658-659).

³¹ Additionally, *Franklin* could be comparable to *Cohesive*, because the district court said, “Given the significant support in the language of the patent, the specification and prosecution history for defendant’s non-infringement position, plaintiff cannot meet its burden to prove objective recklessness by clear and convincing evidence” (US District Ct. W.D. Wisconsin, 2007, *23). So, acquiring a counsel opinion letter could still be a safer choice in understanding the claim language.

Company T should keep in mind that the infringement analysis is based on a single claim. It is possible that the claims attacked in such prior litigation are different from those Company T is confronted with. Therefore, if the disputed claims affecting Company T are not questioned in such prior judicial opinion, Company T may still need to consult with patent attorneys for the rest claims.

3.2. Situations Where Willful Infringement was Found

3.2.1. Unsuccessful Validity Challenges in the USPTO

If Company T decides to bring an invalidation action in the USPTO against the disputed patent, it must succeed in the invalidation in order to get away from willful infringement. In *Bard Peripheral Vascular, Inc. v. W.L. Gore & Assocs.* (US Fed. Cir., 2008, 1083), the district court found that willful infringement existed because the disputed patent survived after the invalidity challenge in the USPTO while the same evidence for such challenge was still presented before the jury (1088-1089). Thus, if Company T fails in challenging the validity of the disputed patent, it needs a patent non-infringement opinion before continuing the “infringing” activities.

3.2.2. Copying Patentee’s Products

If Company T once consulted with the patentee’s product documents or inspected the patentee’s products, Company T may have to acquire a counsel opinion. In *GSI* (US District Ct. Illinois, 2008) the district court denied the defendant’s motion for summary judgment on willful infringement, because the defendant’s marketing officer had a copy of the brochure of plaintiff’s products and its staffs inspected and photographed plaintiff’s products while developing its own products (*11-*12). Therefore, if Company T has a history of bench-marking other competitors’ products when developing its own products, it may have to consult with a patent attorney to make sure that there is no infringement on the patents related to the competitors’ products.

4. Potential Indirect Infringement

If Company T closely works with its clients to develop their products, a patent non-infringement opinion is needed. *Broadcom* (Fed. Cir. 2008, 700) was a case where the defendant’s failure to obtain a non-infringement opinion caused induced infringement. The Fed. Cir. held that the failure to procure a non-infringement opinion “may be probative of intent” (700).

There are some relevant facts. First, the defendant was aware of the plaintiff’s patent and infringement assertions. Second, the defendant “worked closely with its customers to develop and support the accused products, and did not make changes to those products or give its customers [instructions regarding how to avoid infringement] after [the] law suit was filed” (700). Therefore, if Company T closely works with its clients to develop their products and if they do not want to design around, it is safer to acquire a patent non-infringement opinion after Company T knows the possibility of infringing a patent.

Moreover, the *Broadcom* court discussed willful infringement in the context of induced infringement (700). The Fed. Cir. upheld the district court’s decision concerning the evidence supporting willful infringement. The evidence showed that the defendant failed (1) to investigate, (2) to explore design around approaches, (3) to take remedial steps, and (4) to seek legal advice. These failures indicated the defendant’s lack of good faith so as to willfully induce direct infringement (700).

Broadcom may teach us that after the notice of a patent, it is necessary to acquire a patent non-infringement opinion, if Company T’s business involves a customer service regarding design supports. Otherwise, treble damages may be expected in future patent infringement litigation, where induced infringement is at issue. For example, in the semiconductor industry,

an IC (integrated circuits) design company usually works with an appliance company to develop an electric product. If the IC chip designed for such electric product could be one element of an infringing product, it may cause the IC design company to induce direct infringement. In such situation, the IC design company may acquire an opinion letter to show no patent infringement. But, if the opinion letter declares a potential concern of infringement, the IC design company may either need to work with the appliance company to design round the disputed patent, or need to stop providing the IC chips to the appliance company.

It should be noted that 35 U.S.C. § 298 may limit the implications drawn from *Broadcom*. However, acquiring an opinion of patent non-infringement is still a defense to “specific intent” (Countryman, 2015, 821).

5. Post-Litigation Concerns

5.1. Willful Infringement after Litigation

In a case where Company T did not have a patent non-infringement opinion before the law suit was filed, does Company T need to acquire such opinion after the litigation? The answer is conditioned on whether the plaintiff moves for preliminary injunction³². This is because, without asking preliminary injunction, the plaintiff cannot be awarded with enhanced damages for the post-litigation willful infringement (US District Ct. E. D. Texas, 2008a, *19-*20). If the plaintiff does, an opinion is needed (US Fed. Cir., 2007, *Seagate*, 1374). Otherwise, such letter is not required (1374).

The main concern is willful infringement of post-litigation. In *Lexion Med., LLC v. Northgate Techs., Inc.* (US Fed. Cir., 2008, 292), the Fed. Cir. held that the defendant’s sales after the infringement was found by the jury did not constitute the willful infringement for the post-verdict infringing activities (51). There, after the jury verdict of infringement, the defendant acquired an oral opinion from its counsel that the accused products did not infringe the disputed claims (51). Further, based on that oral opinion, the defendant filed a motion of judgment as a matter of law (51). Though eventually the district court denied that motion, the defendant was not objectively reckless, and the defendant’s post-verdict infringement was not willful (51).

What if Company T wants to sell the rest of infringing products after the jury verdict of infringement?³³ The *Lexion* scenario does not give us a clear instruction of whether a paper opinion is required. But, at least an oral opinion of non-infringement from a counsel is insurance for such sales.

5.2. Support for Legitimate Defenses against Infringement Claims

Company T can get away from pre-litigation willful infringement and enhanced damages, if it fights against a valid patent legitimately but fails. In *Black & Decker, Inc. v. Robert Bosch Tool Corp.*, (US Fed. Cir., 2008, 284) the Fed. Cir. reversed the decision of claim construction so as to vacate the district court’s finding of willful infringement (285). Because such finding occurred prior to *Seagate*, the Fed. Cir. then provided a proper standard. It stated that “[u]nder this objective standard, both *legitimate defenses to infringement claims* and *credible invalidity arguments* demonstrate the lack of an objectively high likelihood that a party took actions

³² See *Seagate Tech.* (US Fed. Cir., 2007, 1374): “when an accused infringer’s post-filing conduct is reckless, a patentee can move for a preliminary injunction, which generally provides an adequate remedy for combating post-filing willful infringement. [...] A patentee who does not attempt to stop an accused infringer’s activities in this manner should not be allowed to accrue enhanced damages based solely on the infringer’s post-filing conduct. Similarly, if a patentee attempts to secure injunctive relief but fails, it is likely the infringement did not rise to the level of recklessness”.

³³ Company T may have to sell the rest of accused products to fulfill its contract duty with buyers.

constituting infringement of a valid patent” (291, emphasis added). The standard for “legitimate defenses to infringement claims and credible invalidity arguments” let jury find claims invalid so as to show an accused infringer “made a credible invalidity argument” (291).

Therefore, as long as Company T can prepare “legitimate defenses to infringement claims” and “credible invalidity arguments,” a patent non-infringement opinion is not necessary, because of no threat from willful infringement claims and enhanced damages. Moreover, the attorney’s works for the legitimate defenses actually mean a source of providing a patent non-infringement opinion. If necessary, Company T could still quickly ask a patent attorney to provide such opinion letter at any point.

5.3. Evidence of Pre-litigation Willful Infringement

The Company T’s post-litigation acts could be a factor of its pre-litigation willful infringement, so Company T needs a counsel opinion as a shield. In *GSI*, the district court denied the defendant’s motion for summary judgment on willful infringement (US District Ct. Illinois, 2008, *15), though the pre-litigation evidence could not show that the defendant “knew or should have known of the objectively high likelihood of [willful infringement]” (*13). There, the defendant’s post-litigation act might show willful infringement because the defendant got the non-infringement opinion eighteen months after the case was filed (*14-*15). As a result, to likely prevail in a motion for summary judgment on willful infringement, Company T may have to acquire a patent non-infringement opinion as soon as possible after the litigation started.

5.4. Other Concerns

Sometimes having a patent non-infringement opinion may be not enough for certainly getting rid of willful infringement. Challenging the disputed patent in the USPTO could help Company T’s motion for summary judgment against willful infringement, while Company T acquires counsel opinions after the litigation³⁴.

6. Conclusion

How does Company T make a decision of whether to obtain a patent non-infringement opinion? Two scenarios are given. First, Company T has been aware of the disputed patent, because it did patent search before designing new products or inventing new technology. Second, Company T has been informed of the disputed patent, because the patentee gave a notification or sent a warning letter to Company T.

In the first scenario, the patentee/plaintiff has not taken any action. Two types of patent will lead to different considerations. If a disputed patent claims specific parameters, which are mechanical, physical or chemical, Company T could rely on in-house technical experts to design around such parameters. However, infringement under the DOE should be kept in mind. Company T may obtain a patent attorney’s opinion about infringement under the DOE to be sure that it believes its “infringing” act is in good faith.

If a disputed patent does not provide product parameter terms in its claims, Company T may wait until the patentee/plaintiff knocks the door, because the damages period has not started if the patentee/plaintiff has not fulfilled the notice requirement. However, Company T’s activities could be considered part of a whole scene of infringing activities. Company T may be considered reckless, if it knows its potential infringement of the disputed patent but refuses to obtain an opinion letter.

³⁴ See *Pivonka v. Cent. Garden & Pet Co.* (US District Ct. Colorado, 2008, *6).

In the second scenario, Company T is going nowhere but facing the challenge from the patentee/plaintiff. The best strategy is to obtain a patent non-infringement opinion, because such opinion does help Company T rebut the willful infringement count. Nonetheless, Company T could still take a chance in terms of the pre-litigation or post-litigation concern regarding treble damages.

In the pre-litigation context, Company T might not need a non-infringement opinion in the following circumstances that usually lead to no finding of willful infringement. First, the disputed patent has ambiguous claim terms so as to show the difficulty of understanding the meanings of claim language. Second, the disputed patent has specific parameters in the claims so that Company T could design around those parameters. Third, the validity of the disputed patent was being challenged in other courts. However, if the reason for not obtaining a non-infringement opinion is based on the claim interpretation of the disputed patent, it is better to get such opinion, because the persons who can draft such opinion are patent attorneys and they are the one who can judge the meanings of claim language.

If the patentee/plaintiff does not successfully move for preliminary injunction in the litigation, Company T does not have to worry about the treble damages for post litigation, because the willful infringement may not be established throughout the trial. In addition, the threatening part of the willful infringement issue is the result of treble damages. Without such threat, Company T need not care about the treble damages for the post-litigation infringing activities. So, a counsel opinion is not required.

Bearing treble damages in mind, a company should be very cautious when it receives a warning letter claiming patent infringement or when it finds any possibly-infringed patents. Its objectively reckless acts of keeping “infringing” the disputed patent will lead to a finding of willful infringement. Eventually, a treble damages reward to the plaintiff/patentee will follow. But, the only cure may be a patent non-infringement opinion.

Seagate does not totally alleviate the accused infringer’s duty to acquire a patent non-infringement opinion. The court decisions after *Seagate* in either the district court level or Fed. Cir. level have indicated the importance of obtaining such opinion letter. Failure to acquire opinion letters could still be a factor for jury to decide willful infringement. Such factor could still give a negative impact on the judgment of willful infringement.³⁵

In conclusion, as a potential infringer, a company needs to obtain a patent non-infringement opinion so as to “infringe” the patent at dispute in a good faith. In considering the totality of circumstances surrounding an infringing activity, holding a patent non-infringement opinion will let courts more likely to find no willful infringement. To obtain a patent non-infringement opinion, or not to obtain it, that’s not a question. Just obtain one so as to secure a safer position.

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35 This may not be true in the context of indirect infringement. While *Broadcom* indicates that failure to get an opinion letter would support a proof of the “intent” requirement, 35 U.S.C. § 298 has negated that indication.

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