

Fitch, Even, Tabin & Flannery

FITCH EVEN TABIN & FLANNERY
INTELLECTUAL PROPERTY LAW | EST. IN 1859

**PATENT OPINIONS IN
THEORY AND TRIAL PRACTICE**

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INTRODUCTION

- Opinions of Counsel
 - Timely Advise of Counsel may Shield an Infringer from a Charge of Willful Infringement
 - Good Faith – Opinion Sought and Relied Upon
 - Absence of Counsel's Opinion

STATUTORY AUTHORITY

- Patent Acts of 1793 and 1800
- Patent Act of 1836
- Patent Act of 1870
- 35 USC Section 284

STATUTORY AUTHORITY

- 35 USC Section 284

..... the court may increase the damages up to three times the amount found or assessed....

POLICY BEHIND TREBLE DAMAGES

Punishment or Compensation

- Justification
- Bad Faith or Willfulness
- Exemplary Conduct

Factors Leading To A Finding Of Willfulness

BOTT FACTORS

Deliberate Copying

Investigation – Good Faith Belief

Infringer's Conduct

- Bott v. Four StarCorp. 807 F.2d 1567

Findings of Willfulness

OTHER FACTORS –

Defendant's Size and Economic Health

Evidence Supporting Willfulness

Length of Infringing Activity

Evidence of Malice

Evidence of Concealment

WILLFULNESS/OPINIONS

....As a general matter, a potential infringer with actual notice of another's patent has an affirmative duty of care that usually requires the potential infringer to obtain competent legal advice before engaging in any activity that could infringe another's patent rights....

Comark Comm. V. Harris, 156 F.3d 1182

UNDERWATER DEVICES AND CENTRAL SOYA

- Good Faith = Competent Advice
 - Outside Counsel
 - Patent Attorney
 - Timing of Investigation (before infringing acts)
 - Scope of Investigation (necessary and proper)
 - Delivery of Opinion (form and content)
 - Activity as Evidence of Reliance

COMPETENCE

- In – House Counsel
 - Competence
 - Objectivity
 - Reasonable Reliance

COMPETENCE

- Patent Expertise Versus General Counsel
 - Technical Competence
 - Legal Competence
 - US Counsel/USPTO Admitted
 - Good Faith

COMPETENCE

- Timing of the Opinion/Investigation
 - Level of scrutiny
 - Motivation
 - Good Faith

COMPETENCE

- Scope of Investigation
 - Review of the patent file history
 - Discussion of the legal basis for the opinion
 - Interaction with relevant people from the client
 - Review of MATERIAL factual information

COMPETENCE

- Oral Versus Written Opinions
 - Written record of thought process
 - Reluctance of Counsel
 - Multiple opinions
 - “Off the cuff” opinions




Golight v. Walmart, 69 PQ2d 1481
(deliberate copying after notice)

Norian v. Stryker, 70 PQ2d 1509 (every
infringement is not presumed willful – prior
knowledge of patents)

Metabolite Labs, 71 PQ2d 1081
(incompetent legal opinion)

Insituform, 72 PQ2d 1870 (follows Knorr)



Applied Medical Resources, 75 PQ2d 1681
(willful infringement found where opinions
sought as mere insurance against
damages)

Golden Blount, 78PQ2d 1004 (oral opinion
without benefit of accused device or patent
file history – willful infringement found)

LEGAL PRECEDENTS

- Underwater Devices, 717 F.2d 1380
- Central Soya, 723 F.2d 1573
- Bott v. Four Star, 807 F.2d 1567
- SRI International, 127 F.3d 1462
- Comark, 156 F.3d 1182
- Acoustical Design, 932 F.2d 939
- American Medical, 6 F.3d 1523
- Beatrice Foods, 923 F.2d 1576