

6 KEY TAKEAWAYS

Patent Opinions – New Developments and Pitfalls

[Kilpatrick Townsend](#) partner [Paul Haughey](#) recently presented to the IP section of the Utah Bar Association about “Patent Opinions – New Developments and Pitfalls.” The presentation was a review of patent opinion basics, including the major relevant court decisions and some recent decisions regarding willful infringement. A number of practical tips were provided, and pitfalls to avoid which could cause issues in litigation or IPRs.

Key takeaways from the presentation include:

1

A Patent Opinion can insulate against inducement, not just willful infringement. The Supreme Court held in 2015 that an invalidity opinion does not protect against the knowledge requirement for inducement, but a non-infringement opinion does. *Commil USA, LLC v. Cisco Sys.*, 135 S.Ct. 1920 (2015).

2

Since *Halo*, there has been a 28% increase in willfulness findings, but only 9% increase in judges awarding enhanced damages. Recent cases since the 2016 Supreme Court *Halo* decision require a jury “to find no more than a deliberate or intentional infringement” for willfulness. A 2021 study in the Michigan Technology Law Review by Karen Sandrik found a 28% increase in willfulness findings, but only 9% increase in enhanced damages. The judge has discretion in awarding enhanced damages, and only does so if the deliberate infringement is “egregious.”

3

A “no patent review” policy should be written to avoid the risk of “willful blindness.” There is a split in the courts, but at least one judge has held that alleging “willful blindness” is enough to get past a challenge to the pleadings. Courts have said it makes sense to only look for patents where there is a high probability of relevant patents, and the high cost is a reason not to require opinions. Thus, a policy can instruct employees to refer patent search requests to the legal department, which will decide whether to do a search or review based on those factors. That should reduce the already small risk of a “no patent review” policy.

4

Brevity is your friend when writing an opinion. Opinions do not need to be long and expensive, especially non-infringement opinions. While it is desirable to mention the relevant factors (Graham factors for invalidity, level of skill in the art, Doctrine of Equivalents, etc.), it is not necessary, for instance, to have multiple non-infringement or invalidity arguments. Opposing counsel will certainly focus on the weakest argument to allege the opinion is not “well-reasoned.”

5

It is very rare for a patent opinion to be found insufficient, even if wrong. *PAVO Solutions LLC v. Kingston Technology Company, Inc.*, 21-1834 (CAFC Jun. 3, 2022) was a rare instance of a patent opinion being insufficient. The patent opinion relied on a claim error describing a case as pivoting, when it was the cover that pivoted. The opinion was held to not be a defense to willful infringement since it was an obvious typographical error.

6

Make sure the client reads the opinion. In *Acantha v. Depuy Synthes Sales*, 406 F. 3d 742, 754-56 (E.D. Wis. 2019), a request for summary judgment of no willfulness was denied because there was no evidence anyone actually read or relied upon the opinions. Simple delivery of opinions not enough.

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