



Expert Commentary

Avoiding Willful Infringement in Intellectual Property Litigation (Part 1)

February 2004

In this 3-part article, general guidelines for patent, trademark, and copyright infringement are addressed, focusing on ways how to avoid it. Part 2 addresses patent opinion requirements, and Part 3 discusses the effect of Knorr-Bremse v Dana Corp.

by Sanford E. Warren Jr. and E.E. "Jack" Richards II, Winstead Sechrest & Minick

I know it when I see it.

—Supreme Court Justice Potter Stewart, *Jacobellis v Ohio*, 378 U.S. 184 (1964)

Justice Stewart made the above comment in an attempt to define pornography and decide whether a risqué movie should be protected as a work of art. So, what does pornography have in common with willful infringement of intellectual property? The answer is simple: both are difficult to define but are routinely recognized by the courts "when they see it." In other words, there are no tried and true tests to help companies completely avoid charges of willful infringement. Still, there are general guidelines that can be observed to lessen one's chance of being hit with a willful infringement charge. This article addresses these guidelines for patent, trademark, and copyright infringement.

Why Should You Care about Willful Infringement?

Willful infringement should be a major concern for almost any business because it allows a judge, in his or her discretion, to award a patentee up to three times the actual damages suffered. In addition, the infringer may be saddled with paying the attorney fees that were incurred during the patent infringement lawsuit.

Assuming You Now Care ... What Is Willful Infringement?

While Justice Stewart may have subscribed to the "I know it when I see it" test, patent lawyers are not nearly so colorful. Consequently, they offer the following definition for willful infringement: whether the infringer, acting in good faith and upon due inquiry, had sound reason to believe that it had the right to act in the manner that was found to be infringing. Courts determine whether this test has been satisfied by examining the

"totality of the circumstances." On second thought, Justice Potter may have gotten right, "They know it when they see it."

In all seriousness, this is about the best guidance courts can offer. The very nature of whether an act is performed willfully depends on the thoughts and actions of the accused infringer. If these "facts" are largely determinative of the outcome, it is no small wonder that case law to date has been unable to articulate any gold standards for defining willful infringement because the facts in each case are unique. Nevertheless, there are some general guidelines that have surfaced to aid those who wish to avoid the sting of willful infringement and its consequent penalties.

So Seriously, What Is Willful Infringement?

The only solid advice to avoid willful infringement is to get a thorough, written opinion from a patent attorney stating you do not infringe the claims of a patent or that the patent is invalid or unenforceable. Just what constitutes such an opinion will be addressed in Part 2 to the riveting article in which you are now so thoroughly engrossed. As much as various unnamed patent attorneys would love to write a noninfringement opinion for you every time you modify or develop a product, doing so might become a little cost-prohibitive. So, the relevant question becomes...

When Should You Obtain a Patent Opinion?

The logic for when to obtain a noninfringement opinion is best set out by addressing the following questions under the premise that you have invented "a better mousetrap."

Do you know of a "target mousetrap" that predates your mousetrap? Certainly, if you design and build your mousetrap without knowledge of any patent ("target patent") that covers another mousetrap ("target mousetrap"), you cannot obtain an opinion addressing that which you do not know. The need for an opinion may arise at a later time if you receive "actual notice" of the target patent. Actual notice is often gained when the patentee sends you a license offer, cease and desist letter, or a summons. At that time, you have a well-recognized responsibility to investigate the possibility of infringement. This duty is usually addressed by obtaining the aforementioned opinion addressing infringement and invalidity. *Braun Inc. v Dynamics Corporation of America*, 975 F2d 815, 24 USPQ2d 1121 (Fed Cir 1992).

Is your mousetrap largely copied from the target mousetrap? If you have knowledge of the target mousetrap, and if you outright copy the target mousetrap then obtaining advice from counsel is highly recommended. This may not be as obvious as you think because the target might have never been the subject of a patent or may be the subject of an expired patent. Still, you would be wise to check into these possibilities. Any attorney fees incurred verifying there is no such patent should be manageable. *American Medical Systems, Inc. v Medical Engineering Corp.*, 6 F3d 1523, 28 USPQ2d 1321 (Fed Cir 1993).

Is your mousetrap a modified version of the target mousetrap? If your mousetrap was modeled after the target mousetrap but has been modified to incorporate distinguishing features, your efforts in designing around the target trap may be deemed good faith

efforts to simply design a more effective mousetrap ... something condoned as a basic goal of patent law. *Amstar Corp. v Envirotech Corp.*, 3 USPQ2d 1412 (Fed Cir 1987). In this situation, the failure to obtain an opinion, or obtaining advice that is deemed less than sufficient, may be mitigated somewhat in terms of willful infringement. While a judge has discretion to award up to three times actual damages when willful infringement is found, any good-faith efforts might persuade the judge to stop short of the ultimate penalty of treble damages.

Have you known about the target patent for a long time? Suppose you have known about the target patent for some time but, for one reason or another, have never obtained a formal opinion. In that case, turning a blind eye to the patent and any related patents that might issue later could be damaging if you never obtain a formal opinion. However, if you continue to monitor the patent family as well as any changes to your mousetrap, this may be deemed a good effort because you did not ignore the patentee's property rights. Continually monitoring the area, however, also means you must stay ready to obtain an opinion should infringement become a greater concern. *Studiengesellschaft kohle mbH v Dart Industries Inc.*, 666 F Supp 674, 4 USPQ3d 1817 (D Del 1987).

Is the target mousetrap made by a competitor? When you know the target mousetrap is made by a competitor, your risk for willful infringement goes up because a judge might view your efforts as being predatory with a motivation for harm. Also, claiming a lack of knowledge of the target patents and products is a harder argument to make in such a circumstance. Consequently, an opinion is more advisable in this scenario.

Is the target mousetrap in a "hot" sector? For similar reasoning found above, claiming no knowledge of a target mousetrap that has the industry in a buzz is hard to do. Consequently, the need for an opinion is heightened.

Do you have sufficient knowledge of mousetrap prior art? If your in-house patent counsel knows the "lay of the land" in terms of existing patents related to say, mousetraps that incorporate titanium coils, then your failure to obtain a formal opinion might be more excusable. However, if your in-house counsel is more familiar with classic traps, for example, that incorporate steel coils, you may need a formal opinion to evaluate the scope of prior art that is likely unknown to you. *Stryker Corp. v Intermedics Orthopedics, Inc.*, 96 F3d 1409, 40 USPQ2d 1065 (Fed Cir 1996).

Has the target mousetrap been marked? If you know the target mousetrap has been marked with wording along the lines of "U.S. Pat. No. 1,234,567," then you are certainly on notice that you must investigate the patent. Even "Patent Pending" may be considered in a willfulness inquiry depending on whether you tried to obtain a published application concerning the product and whether you continued to monitor new patents to see if the "pending" patent is eventually granted. See *Stryker*.

Did you search for potential target patents? Many businesses keep tabs on the patents that issue in a certain class of products. Doing so might keep you abreast of the latest ideas and further the technical prowess of your organization. Still, gaining knowledge of a target patent might provoke the need for an opinion. Consequently, many organizations choose to stay away from organized searches of patents thereby frustrating the patent system's goal of promoting technical progress. The case law on

this point is mixed. Some courts have found that finding a target patent as a result of one's own efforts suggests reasonableness and not willfulness. See *Dart, Braun, American Standard Inc. v Pfizer Inc.*, 772 F Supp 86, 14 USPQ2d 1673 (D Del 1989).

Other courts, however, have gone the opposite way. See *Stryker*. This split in the case law goes to show how much courts base decisions on the facts of each case and not on nice, clean rules. Many commentators neglect to point out that the infringer in *Stryker* was a (1) well-funded company that (2) kept close tabs on its competitor's products which, in this case (3) was a "hot product." Furthermore, the infringer's patent counsel (4), as well as a manager, had some knowledge of the target product, and (5) was evasive during questioning in the litigation. Finally, (6) the infringer had never made a product in the particular niche of prosthetics that was at issue in the suit.

In conclusion, the above factors should be considered when considering whether to obtain a formal patent opinion. If you find the above need for expensive patent opinions frustrating when, for example, the patentee may have no intention of ever asserting the patent, you are not alone. The Federal Trade Commission delivered a report calling for higher requirements for findings of willful infringement. *To Promote Innovation: The Proper Balance of Competition and Patent Law and Policy*, a report by the FTC (October 2003). Still, until the courts or Congress adopts those recommendations, remember Justice Stewart's words of wisdom (and your friendly neighborhood patent attorney).

Trademarks and Copyrights

Similar to patents, a formal opinion concerning potential trademark infringement can constitute good faith and weigh against a willful infringement finding. *Sports Authority v Prime Hospital Corp.*, 89 F3d 955 (2nd Cir 1996). Still, one has no duty to conduct a trademark search or obtain advice of counsel to avoid a finding of willful infringement. Often, an intent to capitalize on the goodwill of the senior user, in addition to failing to properly investigate the matter, may be required for a willfulness finding. See *McCarthy* at § 26:10. Such an intent can be found when, for example, a party disregards advice of counsel or takes advantage of its economic superiority over the plaintiff. So, whether one needs to obtain a formal opinion is largely a function of whether other inculpatory facts are present.

Many businesses might determine that cursory searches (e.g., knock-out searches of federal registrations) are so inexpensive, the risk of later litigation, regardless of willful infringement penalties, make such searches worthwhile. The results might then dictate whether more detailed searches should be conducted. Furthermore, the more important the mark will be in terms of marketing, the more detailed searching makes sense.

With copyrights, the increased statutory damage award depends on a demonstration of willfulness which may require the infringer have acted with "actual knowledge or reckless disregard for whether its conduct infringed upon the plaintiff's copyright." *Universal Studios, Inc. v Ahmed*, 29 USPQ2d 1775 (ED Pa 1993). An element considered in the determination of willfulness is an obligation of reasonable inquiry, including a Copyright Office records search. *M.S.R. Imports, v R.E. Greenspan Co.*, 220 USPQ 361 (ED Pa 1983), *aff'd* without opinion, 732 F2d 146 (3rd Cir 1984). Whether a party is, or should be, familiar with copyright law and the need to secure permission to reproduce

copyrighted works is also considered in a willfulness inquiry. *Viacom International, Inc. v Fanzine International, Inc.*, 2001 U.S. Dist Lexis 11925 (SD NY 2001).

E.E. ("Jack") Richards II is an associate with Winstead Sechrest Minick in Austin, Texas, where he specializes in intellectual property, technology, litigation, dispute resolution, and nanotechnology. He received his BS degree from Texas A&M and his JD degree, cum laude, from the University of Houston Law Center. Before entering law school, he worked as an engineer for a start-up company in the medical device industry, focusing on electronics and software related to cardiac data (electrophysiology and hemodynamics). Mr. Richards can be reached at jrichards@winstead.com.

Avoiding Willful Infringement in Intellectual Property Litigation (Part 2)

May 2004

Willful infringement is best avoided by determining when the situation necessitates a "non-infringement opinion" and, if so, developing a good one. There are six key questions the opinion should address when seeking to instill a belief in the infringer that a court might reasonably hold the patent to be invalid, not infringed, or unenforceable.

by Sanford E. Warren Jr. and E.E. "Jack" Richards II, Winstead Sechrest & Minick

In Part 1 [above] of this 3-part series on avoiding willful infringement in intellectual property litigation, we asked, What is willful infringement and how do I avoid it? We found that defining willful infringement is difficult, and that the best way to avoid it is to obtain a "non-infringement opinion" from an attorney. While we discussed what conditions should prompt you to obtain such an opinion, we did not address, What constitutes an effective "non-infringement opinion?" This article addresses that issue by focusing primarily on the question as it relates to patent law. Part 3 discusses the effect of *Knorr-Bremse v Dana Corp.*

In short, an effective opinion "must be thorough enough, as combined with other factors, to instill a belief in the infringer that a court might reasonably hold the patent is invalid, not infringed, or unenforceable." *Ortho Pharmaceutical Corp. v Smith*, 959 F2d 936, 944 (Fed Cir 1992). Keep this principle in mind as we address six key questions to ask in determining whether a non-infringement opinion will pass muster.

1. What Materials Should Be Analyzed in the Opinion?

Many managers simply want to know whether they can make their widget without being sued for patent infringement. Basically, details are not that important. Sound familiar? Let this serve as a word of caution: there is no such thing as a "big picture" non-infringement opinion. Good opinions deal with details, as well as the big picture, and are likely lengthy and not much fun to read. More specifically, a strong opinion should address several topics.

First, the opinion should deal with claims individually. Claims are one sentence descriptions, included in a patent, that describe what aspects of the invention are protected by law. There are independent claims and dependent claims. Dependent claims add details to independent claims and are consequently more "narrow" than their parent independent claim. Your product need only infringe one claim, independent or dependent, to "infringe the entire patent." If your product does not infringe an independent claim, it cannot infringe any claims that are dependent on the independent claim. Therefore, an opinion should touch on each claim or, on some occasions, at least on each independent claim. For example, an opinion stating "all of the claims" are invalid because the inventor was not the first to discover the invention could be painting too broadly. The better approach would be to address the validity of each claim or family of claims independently. See *Johns Hopkins University v CellPro, Inc.*, 152 F3d 1342 (Fed Cir 1998).

Second, the opinion should address the patent's prosecution history. An inventor usually has to engage in written arguments with the U.S. Patent and Trademark Office (PTO) when trying to obtain a patent. These written arguments constitute the patent's "prosecution history" or "file wrapper," and influence how the patent will later be interpreted by a court. Consequently, the opinion should address the prosecution history and how it affects interpretation of the claims.

Third, the opinion should address (1) whether your product infringes a patent claim and (2) whether the patent is invalid or (3) unenforceable. The opinion does not have to address all three points, but a failure to do so may remove some arrows from your defense counsel's quiver should you ever get sued for patent infringement.

Fourth, the Doctrine of Equivalents should be addressed even though there is no rule to that effect. This doctrine basically states that a small tweaking of a device to avoid a patent claim, if done in only a very superficial way, may not be enough to avoid infringement. Patentees routinely assert this "weapon" in patent infringement. Therefore, good sense dictates that your opinions address whether this doctrine may be used to "reach" your product.

Fifth, analyzing the file wrapper often leads to studying prior art that was cited against the patent during prosecution. This prior art and any other pertinent prior art may need to be examined as a precursor for evaluating infringement and validity of the patent. This prior art should be examined and then applied, in detail, against the claim limitations. See *Johns Hopkins*, 152 F3d 1342.

Sixth, as a corollary to the above points, the technical merits of the device in question must be considered if, for example, the claims are to be applied to the device in any meaningful way.

Finally, it goes without saying that withholding critical facts from counsel is an invitation for treble damages and attorney fees. See *Braun, Inc. v Dynamics Corp. of America*, 975 F2d 815 (Fed Cir 1992). As an additional example, do not rely on a letter from, for example, your supplier assuring you that the supplier has obtained a competent opinion without examining the opinion for yourself.

2. What Level of Analysis Should the Opinion Possess?

An opinion need not possess "perfect analysis." In fact, few opinions with perfect analysis will be examined by a court. If your lawyer says your product does not infringe a claim and he's right, there is no infringement much less willful infringement. If your lawyer feels your product does infringe a claim, however, he likely will call you to give you a "heads up." At that point, prudent clients change their product design thus negating the need to write the initially conceived opinion. So, the fact that the opinion said "no infringement" when a court later felt otherwise does not deem the opinion to be faulty and necessitate a finding of willful infringement.

While the analysis need not be perfect, it must be sound. For example, an attorney arguing that the PTO "got it wrong" because it should have never granted the patent in light of certain prior art may not help an infringer. Competent counsel should know the burden for proving the PTO "got it wrong" in a court is a high one that is not easily

circumvented. Consequently, the analysis must go beyond saying the PTO made a mistake. See *SRI International, Inc. v Advanced Technology Laboratories, Inc.*, 127 F3d 1462 (Fed Cir 1997).

On a general note, the idea behind "proper analysis" is to avoid conclusory treatment of the subject. The general rule for good opinions is whether a person, often in the form of a manager, could have reasonably relied on the opinion. A jury will likely not believe a manager who claims to have relied on an off-the-cuff analysis. See *Read Corp. v Portec, Inc.*, 970 F2d 816 (Fed Cir 1992). Along those same lines, a "manager" with significant patent experience will have a harder time arguing he could not "sniff out" what the jury or judge deems to be a marginally adequate opinion. See *Johns Hopkins*, 152 F3d 1342.

3. Who Should Author the Opinion?

Many commentators kill many trees delving into the nuances of who should write the opinion. In-house counsel versus outside counsel? Patent attorney versus patent agent? Foreign counsel versus domestic counsel? The academic answer might be that anyone can write the opinion. You obtain an opinion, however, because you might need to persuade a jury one day that you were not a bad actor. To achieve that goal, use a licensed U.S. patent attorney to render the opinion. Here's why.

As set out above, a good opinion includes details about, for example, prosecution history and case law on claim construction and the Doctrine of Equivalents. You will have an easier time convincing a fact finder that these points were adequately addressed by having a licensed patent attorney handle the task. For example, a patent agent is a technically trained person that may pursue patents before the PTO but who is not an attorney and may not practice patent litigation in U.S. courts. Accordingly, some courts have dismissed opinions from patent agents outright. See *Signtech USA Ltd. v Vutek Inc.*, 44 USPQ2d 1741, 1750 (WD Tex 1997).

In a similar vein, other courts have stated "Competent opinions are unlikely to come from a nonpatent counsel." *Jepson v Makita USA Inc.*, 32 USPQ2d 1107 (CD Cal 1994). On the international front, an English patent agent who was not an attorney and was not registered to practice in the U.S. was not "competent to interpret or evaluate ... any patents under U.S. law." *Ethyl Molded Products v Betts Package Inc.*, 9 USPQ2d 1001 (ED Ky 1988).

If a licensed patent attorney is chosen, that attorney can be in-house or outside counsel so long as the opinion is one that could be reasonably relied on. Using in-house counsel can be cost effective, but you should be prepared to show one day that the attorney was "free to think" without the CEO dictating what should be written. Some jurors may be hard to convince to vote along those lines. See *Studiengesellschaft Kohle mbH v Dart Industries Inc.*, 4 USPQ2d 1817 (D Del 1987), affirmed, 9 USPQ2d 1273 (Fed Cir 1988). For that reason, many organizations "farm out" the opinion work when the question of infringement or validity is a close one.

4. Must the Opinion Be Written?

Oral opinions are fine in an academic sense but they fail to hold up when needed most: in court. In other words, an oral opinion could technically convey everything a 20-page written opinion conveys. The problem is, however, that the accused infringer has the burden of proof as to what the opinion contained and why the opinion was competent. As time goes on, memories fade, and eliciting testimony from a forgetful witness is just not as persuasive as showing a written opinion to the jury. See *Minnesota Mining & Manufacturing v Johnson & Johnson Orthopaedics, Inc.*, 976 F2d 1559 (Fed Cir 1992).

5. How Unequivocal Must the Opinion Be?

A good opinion need not be "over the top" in asserting your product does not infringe a claim. In fact, language such as "the patent is probably invalid" has been deemed a sign of genuineness that a reasonable attorney should include in a letter. After all, most opinion letters are only asked for when the issue of infringement or validity is less than certain. See *Read Corp.*, 970 F2d 816.

6. What Timing Concerns Should the Opinion Address?

The timing of the opinion is also important. If you change your product, subsequent to receiving an opinion in a way unanticipated by that opinion, your opinion shield may be damaged. Although having the opinion updated in light of the changes might be expensive, failure to do so might be more expensive. See *Read Corp.*, 970 F2d 816.

In addition, assuming you now believe that good opinions must be thorough and not "cranked out" overnight, you may not want to delay production of a product while waiting for the opinion. In that case, a preliminary opinion may help provide some protection against willful infringement but only if it is followed up in a timely fashion by a thorough opinion.

Conclusion

Willful infringement is best avoided by determining when the situation necessitates your obtaining a "non-infringement opinion" and then ensuring the opinion is written by a U.S. patent attorney who delves into a detailed analysis as set out above.

E.E. ("Jack") Richards II is an associate with Winstead Sechrest Minick in Austin, Texas, where he specializes in intellectual property, technology, litigation, dispute resolution, and nanotechnology. He received his BS degree from Texas A&M and his JD degree, cum laude, from the University of Houston Law Center. Before entering law school, he worked as an engineer for a start-up company in the medical device industry, focusing on electronics and software related to cardiac data (electrophysiology and hemodynamics). Mr. Richards can be reached at jrichards@winstead.com.

Avoiding Willful Infringement in Intellectual Property Litigation (Part 3)

March 2005

In this month's article, we return to the topic of "avoiding willful infringement" because the issue is an important one to risk managers. In other words, getting hit with a finding of willful infringement may expose an intellectual property infringer to treble damages and attorney fees. Considering the magnitude of damages and attorney fees in intellectual property litigation, willful infringement definitely constitutes a risk that must be managed.

by Sanford E. Warren Jr. and E.E. "Jack" Richards II, Winstead Sechrest & Minick

The more things change, the more they remain the same.

—Alphonse Karr, *Les Guêpes*

In Part 1, of this series [above], we asked "What is willful infringement and how do I avoid it?" We found that defining willful infringement is difficult but that avoiding it is less complicated provided one obtains a "non-infringement" opinion from a patent lawyer. In Part 2, of this series [above], we then addressed "What constitutes an effective "non-infringement" opinion?" Then, along came Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v Dana Corp., 72 USPQ2d 1560 (Fed Cir 2004) (which we will simply refer to, thank goodness, as Knorr-Bremse). This case has created quite a stir amongst intellectual property practitioners because it changes the law on willful infringement. But has it changed anything for the risk management community? Not really. Read below to find out why the more things change, the more they remain the same.

What Knorr-Bremse Changed

The intellectual property (IP) community is in a stir over Knorr-Bremse because it overturned willful infringement precedent. More specifically, precedent dictated that an adverse inference may be drawn by a judge if an organization that has been found to be infringing (1) had not obtained legal advice (e.g., a non-infringement opinion) when confronted with the possibility of infringement, or (2) elected not to produce the legal advice for the judge's scrutiny due to attorney-client privilege.

For example, say you were sued for patent infringement, tried the case, and lost. When given the chance to produce the non-infringement opinion you had obtained, you chose not to do so while invoking attorney-client privilege. Precedent dictated that the judge could then surmise that the content of your opinion was likely bad (i.e., that you infringe) and that is why you did not want the judge to examine it. Knorr-Bremse changed that precedent in that no such adverse opinion should now be drawn. Pretty heady stuff for patent lawyers.

What Knorr-Bremse Didn't Change

While Knorr-Bremse is interesting to patent lawyers, it may not be such a big deal for risk managers. While the case was overturning adverse opinion precedent, it was solidifying precedent on how "willful infringement" is defined. Namely, the court confirmed that the overarching theme for willfulness is whether the infringer acted as a reasonably prudent businessperson to avoid infringing another's patent rights. A party that satisfies this test is said to have fulfilled his "duty of due care."

The court then reaffirmed classic factors for judges to consider in determining whether one has fulfilled his duty of due care. Those factors are now addressed.

The Willfulness Factors

The willfulness factors set out by the court actually concern how to avoid enhanced damages more than they define willful infringement itself. For example, several of the factors concern conduct occurring during litigation—litigation that might occur after a defendant has already switched to a non-infringing product (i.e., the defendant no longer infringes or willfully infringes). Regardless, the factors are provided below using the point-of-view that you, the reader, are a risk manager for a company accused of patent infringement. The factors are as follows.

1. *Did you deliberately copy the idea or design of another?*

Having knowledge of another's idea and then blatantly copying it is a risky venture. Still, some may choose to go this route but hopefully after having sought formal, written advice of counsel wherein the patent at issue is determined to be unenforceable or invalid.

2. *Did you investigate the scope of the patent?*

This factor asks whether you investigated the patent and subsequently formed a good-faith belief that the patent was invalid or that it was not infringed. This factor is usually satisfied when one obtains a competent non-infringement opinion.

3. *Did you behave appropriately during the lawsuit concerning your infringement?*

As is the case in non-intellectual property cases, litigation misconduct is a sure way to get hit with enhanced damages. For example, wrongful failure to produce key documents during the suit is not going to be looked at favorably by a judge.

4. *Are you a large and financially strong institution?*

If you are an industry giant and the patentee is an inventor tucked away in his garage somewhere, courts often feel that enhanced damages are the best way to ensure the financially strong do not run rough-shod over the weak. Much of the patent system is set up to protect the interests of the small, solo inventor.

5. *Was the issue of willfulness a close one?*

Certainly, a finding of willfulness may be less likely if the court considers the willfulness question to be a close one.

6. How long have you infringed?

For example, did you quickly switch to a non-infringing product line once you were made aware of the patent? Or did you wait until after you were sued to make the change or even worse, continue to infringe up until the day you lost at trial? The longer and more brash your infringement, the greater chance you have for being found to have willfully infringed the patent at issue.

7. Did you engage in remedial action?

A court may stop short of treble damages and attorney fees if you voluntarily ceased selling infringing products during the pendency of the litigation or once you were made aware of the asserted patent. This factor may strongly relate to factor 6.

8. Did you have any motivation to harm the patent owner?

If, for example, the court determines you tried to "run off" a would-be competitor by infringing his patent, hoping he was too weak to engage in related litigation, the court is more likely to award enhanced damages.

9. Did you attempt to conceal your misconduct?

Did you, for example, fail to preserve your pertinent records such as e-mail and memoranda that discuss the patent? If so, enhanced damages are more likely.

What Knorr-Bremse Means for Risk Managers

In the end, if your organization is ever on trial for patent infringement, the patentee will undoubtedly assert many of the above willfulness factors against you in his pursuit of treble damages and attorney fees. In the past, your failure to obtain or produce a non-infringement opinion, for whatever reason, allowed a court to infer that any opinion you would have obtained or produced for inspection would have been a negative one—one stating you infringed. A court may no longer formally make such an inference. Still, a court will continue to evaluate the same willfulness factors as dictated by precedent regardless of whether it may make a formal adverse inference concerning willfulness. And to ensure that those traditional factors tilt in your favor, a well-reasoned opinion, presented by an expert, may still be the best option.

For example, the second willfulness factor asks whether the infringer investigated the scope of the patent? What better way to "win" this factor than to have obtained, and later produced to the judge, a formal non-infringement opinion?

So, in conclusion, when it comes to risk managers and Knorr-Bremse, obtaining and producing a formal noninfringement opinion may still be the best route to manage risk. In other words, the more things change the more they remain the same.

E.E. ("Jack") Richards II is an associate with Winstead Sechrest Minick in Austin, Texas, where he specializes in intellectual property, technology, litigation, dispute resolution, and nanotechnology. He received his BS degree from Texas A&M and his JD degree, cum laude, from the University of Houston Law Center. Before entering law school, he worked as an engineer for a start-up company in the medical device industry, focusing on electronics and software related to cardiac data (electrophysiology and hemodynamics). Mr. Richards can be reached at jrichards@winstead.com.