

## Patent Infringement Opinion

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### **What is a Patent Infringement Opinion?**

Patent Infringement Opinions are an evaluation of a patent by reference to the issued patent and all the documentation generated in obtaining the patent (the patent prosecution file) and comparing the patent with another article, method, process, or composition.

In many instances, evaluation of a patent will depend upon the patent history as reflected in the patent prosecution file. By reviewing that file, patent counsel can determine what aspects of the patent may have been abandoned in return for the Patent Office agreeing to issue the patent. The Doctrine of Equivalents provides that a patent grants the right to exclude not only the literal elements in the patent but all equivalent elements. A patent owner can abandon the right to these equivalents in the course of obtaining the patent. The patent prosecution file will show this.

After a careful analysis of the scope of protection offered by the patent, for each separate patent claim, reference is made to each protected element and directly

compared with each of the elements present in the non-patented article, method, process, or composition. In an instance of infringement, for at least one patent claim each element of the claim (or its equivalent) will be found in the non-patented article. The article need not infringe all claims in the patent, only one. Non-infringement occurs when the non-patented article lacks one or more elements for each of the patent claims.

## **When do I want an Opinion?**

Infringement opinions are "cheap" insurance. Before investing in the manufacture of a new product, or accepting distribution of imported goods, an infringement opinion can help avoid the possibility that you will be sued for patent infringement by a competitor. Patent infringement litigation is some of the most resource intensive and expensive litigation "enjoyed" by the federal courts.

An infringement opinion is particularly useful in avoiding the sanction of triple damages and attorney's fees that are awarded in cases of willful infringement. An opinion of non-infringement, from a qualified patent counsel, having full knowledge of all relevant facts, may be worth it's weight in gold if you find yourself in court.

If you've already manufactured the goods or distributed the product, and received a notice of infringement, an infringement opinion can help you understand your rights and decide on a course of action. It is possible, after a careful evaluation of the patent, that existing product lines or research and development of new products can be salvaged by "designing around" the patent, and avoiding infringement.

## **When don't I want an Opinion?**

If, with full knowledge of an existing patent, you've already begun to manufacture and infringe the patent, a later opinion will not negate liability for wilfulness. In fact, failure or refusal to produce the infringement opinion may give rise to an inference that the opinion is unfavorable.

## **Should I use my current IP attorney?**

Using a patent infringement opinion in defense of a charge of willful infringement requires you to waive the attorney-client privilege and hand over the opinion along with the materials used by your attorney in making the evaluation and rendering the opinion. The patent holder will try to invalidate your attorney's opinion by showing that the opinion is not thorough or is not based on a true set of facts. This opens your attorney up to examination by your adversary and the court. It would be far better to have the benefit of a patent infringement opinion supplemented by the independent review of your current patent attorney, all while preserving the attorney-client privilege. This can be accomplished through judicious use of outside patent counsel.

## **What is the cost of an Opinion?**

Researched and prepared by a Registered U.S. Patent Attorney, Patent Infringement Opinions are rendered on an hourly basis calculated at \$250.00 per hour. In addition, the actual cost of obtaining the prosecution file from the U.S. Patent Office is charged to the

client. An initial retainer in the sum of \$1,000.00 is required to offset the anticipated cost of obtaining the prosecution file and beginning work on the opinion. The attorney time will vary depending upon the complexity of the patent, the number of claims to be evaluated and the size of the patent prosecution file.

### **What information do you need?**

1. The U.S. Patent Number; and
2. A full and complete description of the goods to be compared to the patent.

All this information may be provided by fax, email, physical delivery by mail, by courier or the equivalent, at your discretion. Information exchanged over the Internet may not be secure. We provide a PGP public key for the secure submission of your information.

### **How long will it take?**

A Patent Infringement Opinion requires the delivery of the patent prosecution file from the U.S. Patent Office archives. Once we receive this file, an opinion should be rendered within two weeks time.

