

How to Defend Against Willful Infringement Claims in US Lawsuits With or Without Attorney Opinions

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In US patent infringement lawsuits, there is the risk that infringers will be required to pay increased damages or attorney's fees if the court finds willful infringement. Although whether or not infringement is willful is determined in consideration of the totality of circumstances in US patent infringement lawsuits, suspected infringers who received an infringement warning have an obligation to obtain valid legal advice. Consequently, suspected infringers have often been deemed to have committed willful infringement due to the non-obtainment of attorney opinions, or have been treated unfavorably in the court on the ground that they have not disclosed attorney opinions through exercise of the attorney-client privilege. In short, the obtainment and disclosure of attorney opinions has had a large impact on the determination of whether or not an infringement is willful.

In some decisions referred to in the Amicus Curiae briefs of the Knorr case, which attracted attention in terms of how to defend against willful infringement claims with or without attorney opinions, the court found willful infringement despite opinions of an outside attorney being available. To avoid the finding of willful infringement, it is considered necessary to obtain attorney opinions and thoroughly examine the time of obtainment and the validity of the written attorney opinions.

For the purpose of examining the points for companies to take into account in preventing the finding of willful infringement, this report analyzes the impact of the existence of attorney opinions on the determination of willful infringement in consideration of the standard for finding willful infringement with a focus on the decisions referred to in the Amicus Curiae briefs of the Knorr case and then summarizes (1) the content of the opinions, (2) the time when the opinions were obtained, and (3) the points to take into account in the case of not obtaining opinions of an outside attorney.

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