

ONE DAY, THE HEAD OF R&D COMES INTO YOUR OFFICE TO LET YOU know that the company is ready to start production of its stellar new product. “This product,” she says, “is going to revolutionize the industry. We’ve fast-tracked the rollout, so we’re bringing you in a little late. Sorry about that.” She hands you the specs, and mentions that production will begin next week—and that any delays will cost the company about half a million dollars a day.

# Bad Inferences No More?

Steering a Course on  
In-house Noninfringe-  
ment Opinions after  
*Knorr-Bremse*


No pressure, you think, as she leaves your office.

You flip through the CAD drawings, and your heart sinks. You know that you have seen something similar in your recent review of the industry patent watch. Sure enough, when you consult your binders, you come across several patents that appear close to the technology described in the specs from R&D. After talking to a few engineers, you are certain that at least two patents should be scrutinized for freedom-to-operate issues. You know that, per *Underwater Devices*<sup>1</sup> and *Kloster Speedsteel AB v. Crucible Inc.*,<sup>2</sup> you have an affirmative duty of care to respect the patent rights of others. However, with the time crunch and your tight budget, you don’t particularly want to bring in outside counsel for a \$30,000 formal opinion that may take a month to prepare.

Luckily, you remember that the law no longer requires you to obtain an opinion from outside counsel. That requirement was struck down by the Federal Circuit’s recent ruling in *Knorr-Bremse v. Dana Corp.*<sup>3</sup> *Knorr-Bremse* overturns the Federal Circuit’s 1986 *Kloster* decision, which held that the failure to get (or produce) an exculpatory opinion automatically created an adverse inference that any such legal opinion would have been (or is) unfavorable. In other words, failing to get an exculpatory opinion meant, under *Kloster*, that any infringement was a willful infringement, which made the infringer liable for treble damages and attorneys’ fees.<sup>4</sup>

But *Knorr-Bremse* didn’t completely let you off the hook. The decision upheld the duty of care set out in *Underwater Devices*, which requires companies to act affirmatively in order to avoid committing infringements. And unfortunately, the *Knorr-Bremse* decision fails to provide concrete guidance on how to fulfill this affirmative duty of care.

**BY TROY R. LESTER, H.T. THAN, AND JENNIFER R. MAHALINGAPPA**

A close-up photograph of a woman with dark hair, wearing a bright green blazer and a blue patterned scarf. She has a thoughtful or stressed expression, with her right hand raised to her forehead. She is wearing a ring on her ring finger and a watch on her left wrist. The background is blurred, suggesting an office or professional setting.

Troy R. Lester, H.T. Than, and Jennifer R. Mahalingappa, "Bad Inferences No More? Steering a Course on In-house Noninfringement Opinions after *Knorr-Bremse*," ACC Docket 23, no. 7 (July/August 2005): 64-73. Copyright © 2005, the Association of Corporate Counsel. All rights reserved.



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So you take what seems to be a reasonable course of action. You order the file histories, review the patents, and come to a comfortable conclusion that your company's new product does not infringe on any of the claims of the reviewed patents. You write a memo on the clearance, copy the head of R&D and the general counsel on the memo, and put the memo in your files. Great work—or so it seems.

Fast-forward eighteen months. Your company's new product is a market leader. The owner of one of the patents that you had reviewed is threatening an infringement suit unless a license is taken. They are even claiming willful infringement!

The CEO wants a risk assessment of liability before heading into negotiations. What do you tell him? Was your decision not to bring in outside counsel for a formal opinion justified? Will your memo be sufficient to avoid a finding of willful infringement? Can you even represent your company in the potential litigation?

The bottom line: Is the company—and your job—safe?

This article examines *Knorr-Bremse's* ramifications on the affirmative duty of care and exculpatory opinions in general, as well as the ruling's effect on in-house patent counsel who want to advise management on potential infringements. Finally, the article makes some specific recommendations on how in-house patent counsel can effectively meet the affirmative duty of care imposed by *Underwater Devices*.

## THE AFFIRMATIVE DUTY OF CARE

In 1983, when faced with a case of flagrant disregard for the patent rights of another, the Federal Circuit developed a mechanism to force potential infringers to recognize the legal obligation for respecting patent rights.<sup>5</sup> The *Underwater Devices* decision created an affirmative duty to exercise due care to investigate potential infringement of any patent of which the potential infringers have actual notice. In fulfilling this affirmative duty of due care, a potential infringer is expected to “obtain competent legal advice from counsel” prior to engaging in any potentially infringing activities (among other things). (See “The Seeds of Distrust,” on p. 68.)

It is important to recognize that even after *Knorr-Bremse* (as the opinion expressly states) this affirmative duty of care still exists. Although under *Knorr-Bremse* it is no longer mandatory to get and produce an opinion (in order to avoid the *presumption* of willful infringement), it would still be difficult—if not impossible—for a company to avoid a finding of willful infringement without being able to point to the existence of some sort of opinion. You should therefore still seek a legal opinion. But *Knorr-Bremse* raises a new possibility: Can you have the opinion written in-house?

## THE DANGERS OF IN-HOUSE OPINIONS

On some occasions, you may be tempted to save some money and write an exculpatory opinion in-house, rather than have the work done by an outside law firm. But if you choose this route, proceed with caution. The courts don't look kindly on such opinions. (See “The Prejudice Against In-house Counsel,” on p. 69.)

Your opinion won't be rejected by the courts out of hand simply because it is written in-house. An opinion by in-house counsel is not automatically disqualified from being "competent legal advice," according to the Federal Circuit.<sup>6</sup> Even if an in-house opinion turns out to be wrong, a company may be able to use its reasonable reliance on the opinion to avoid a finding of willful infringement.<sup>7</sup>

But in-house opinions live under a legal cloud. On at least one occasion, the Federal Circuit has implied that in-house counsel's advice will be considered tainted as compared with advice received from outside counsel.<sup>8</sup> At times, other courts have also assumed that in-house attorneys lack the mindset of prudent professionals or are more likely to succumb to business pressure from their clients.

To convince the court that your exculpatory opin-

ion is entitled to be taken seriously, you must be like Caesar's wife—above any possible reproach. You must be able to come to court with both the appearance and the reality of professional objectivity. Here are some tips that can help you convince the court of your impartiality.

- The four corners of the opinion itself will provide much of the evidence for your opinion's impartiality. Be sure to give an accurate and verifiable accounting of the facts.
- Your company should have a written policy that forbids R&D managers and management executives from playing any part in the writing of an opinion, other than providing facts to legal counsel. As long as management actually adheres to this policy, in-house counsel can effectively assert in court that their opinion was based solely on their own professional judgment without any undue interference.
- The legal objectivity needed to properly do your job is essential. Unfortunately, in-house counsel is often approached to clear a technology only after the R&D decision-makers have been sold on the idea. Even with everyone around you clamoring for a rubberstamp, maintaining your professional objectivity is critical not only to providing the best possible advice to management, but also to having your opinions appropriately valued by the courts in the event that your company decides to rely on your opinion.
- One pitfall to avoid: issuing an opinion that is inconsistent with other positions your client has taken. A prime example of this mistake occurred in *Minnesota Mining & Manufacturing v. Johnson & Johnson Orthopedics, Inc.*,<sup>9</sup> where 3M's in-house counsel opined to his company that a competitor's patent was unenforceable over prior art, and later told the US Patent Office that 3M's own patent application containing the same technology was patentable over the same prior art. These inconsistent positions helped the court to conclude that the in-house counsel was acting more as a member of the business team than as an objective expert on patent law, and that 3M was thus unreasonable in relying upon the in-house counsel's exculpatory patent opinion.

Even if you are able to convince a court that your patent opinion was produced in an expert and unbiased manner, there are two other significant prob-

## THE SEEDS OF DISTRUST

Corporations were first saddled with the affirmative duty of care in *Underwater Devices*. What so disgusted the court that it imposed such an onerous duty? A damning memo.

Morrison-Knudson had blatantly infringed one of Underwater Devices' patents. When Underwater Devices sent Morrison-Knudson a letter offering a license for \$200,000, Morrison-Knudson's in-house counsel wrote a memo to a regional manager detailing all the reasons why the letter from Underwater Devices should be ignored.

Among those reasons:

- a bald, and apparently incorrect, statement that since courts had been invalidating approximately 80 percent of patents in litigation, Underwater Devices was unlikely to prevail in a lawsuit;
- a statement that Underwater Devices wanted to keep Morrison-Knudson as a customer and was thus unlikely to sue;
- an assumption that Underwater Devices could simply use any lawsuit as a prelude to license negotiations; and
- a statement that Underwater Devices wasn't serious about protecting its patent rights because that company's outside counsel was composed of generalists, not patent attorneys. Ironically, one reason why the court found that the memo lacked reliability was that its author was not a patent attorney.

lems with preparing an opinion in-house. First, you risk becoming a witness in any litigation concerning that opinion. If the written opinion is produced in discovery, you will probably be deposed regarding that opinion and a wide range of related subjects—such as the company’s technology, its patent strategies, and its litigation concerns—which you probably won’t want to talk about. If the opinion is used in the

trial by either side, you will most likely be required to testify under oath about the opinion and related subjects. Such testimony can be more than simply embarrassing; it can reveal information harmful to your client. Also, such testimony can require you to remove yourself from actively participating in the litigation. The rules of professional responsibility in many jurisdictions do not permit attorneys to be both

## THE PREJUDICE AGAINST IN-HOUSE COUNSEL

The Federal Circuit’s negative view of reliance on in-house patent counsel may be shifting. Judges Lourie and Meyer indicated during oral argument in *Knorr-Bremse* that they believed consulting in-house counsel, or even one of ordinary skill in the art, should be given status equal to that of consulting outside counsel. However, the court has not officially altered its position that the opinions of in-house patent counsel are somewhat suspect.

In order to determine whether a company has reasonably relied on an opinion, the courts apply a totality of the circumstances test to determine the objective reasonableness of the reliance. Some of the factors of this test include the thoroughness of the analysis and the independence of the counsel rendering the opinion. And, unfortunately, in-house counsel are seen as less independent than outside counsel.

The rationale for this prejudice against in-house patent counsel is that the courts assume in-house patent counsel are subject to greater influence on their professional judgment than are other corporate counsel and outside patent counsel. This is questionable, since outside patent counsel are not automatically free from influence. The fees for professional services from clients are a real financial incentive for outside counsel to toe the corporate line.

Furthermore, some outside counsel have an actual financial stake in the outcome of litigation beyond mere fees for professional services. In those cases, opinions from outside counsel are also found to be unreliable due to the lack of independence. For instance, in *Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal, Inc.*,<sup>\*</sup> a generic drug manufacturer contracted with outside counsel to discover drug patents ripe for exploitation. The outside counsel was not paid legal fees outright. Instead, the parties arranged for the outside counsel to receive 50

percent of the gross profits from the sale of any drugs developed under the contract. Not surprisingly, the court found that the outside counsel was not independent enough to give an opinion on validity that the company could reasonably rely on.

In short, neither in-house nor outside counsel are entirely free from the influence of their clients. The courts should not presume, therefore, that one group of attorneys is more susceptible to being influenced by their clients’ wishes.

Courts should be comfortable allowing corporations to rely on opinions of corporate counsel, as long as corporate counsel provide an appropriately objective, analytical written opinion. Courts should not assume that corporate counsel are always willing to give management an exculpatory opinion, regardless of the merits of the matter.

Corporate counsel are, after all, prudent, professional attorneys responsible for their companies. Perhaps even more than outside counsel, they have a vested interest in limiting the liability exposure of the company and will, therefore, provide a thorough analysis of the pertinent infringement issues. Furthermore, in-house patent counsel have the detailed factual understanding of the technology and the relevant art, as well as the legal know-how, to fully assess potential infringement issues.

Ultimately, corporate management should be able to discuss infringement issues with both in-house and outside counsel in a candid, thorough manner. Courts ought to encourage this process to foster greater respect for the patent rights of others.

<sup>\*</sup> 21 F. Supp. 2d 366 (S.D.N.Y. 1998), *aff’d* *Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal, Inc.*, 231 F.3d 1339 (Fed. Cir. 2000), *reh’g en banc denied* (2000).

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#### ACC INTELLECTUAL PROPERTY RESOURCES:

Amicus Brief of the Association of Corporate Counsel in *Knorr-Bremse* (2003). Available on ACC Online<sup>SM</sup> at [www.acca.com/public/amicus/knorrbremse.pdf](http://www.acca.com/public/amicus/knorrbremse.pdf).

“Circling the Wagons: How Small Law Departments Can Protect & Maximize Corporate IP Assets.” 2004 Annual Meeting Program Material, available on ACC Online at [www.acca.com/am/04/cm/102.pdf](http://www.acca.com/am/04/cm/102.pdf).

“Intellectual Property Primer” (2004), an ACC InfoPAK<sup>SM</sup>, available on ACC Online at [www.acca.com/protected/infopaks/ip/INFOPAK.PDF](http://www.acca.com/protected/infopaks/ip/INFOPAK.PDF).

- THE INTELLECTUAL PROPERTY HANDBOOK (2004/2005), a Global Counsel resource, available via ACC Online at [www.acca.com/practice/global.php](http://www.acca.com/practice/global.php).

Melissa S. Sellers and Trace-Gene G. Durkin, *Eternal Sunshine of the Spotless IP Portfolio: Creating and Implementing an Effective Corporate Intellectual Property Program*, ACC DOCKET 22, no. 10 (November/December 2004): 78–101. Available on ACC Online at [www.acca.com/protected/pubs/docket/nd04/eternalsunshine.pdf](http://www.acca.com/protected/pubs/docket/nd04/eternalsunshine.pdf).

William A. Wise and Kirk Teska, *Patent Literacy For In-House Counsel: Service, Competitive Advantage, and Protection*, ACC DOCKET 22, no. 4 (April 2004): 94–109. Available on ACC Online at [www.acca.com/protected/pubs/docket/apr04/literacy.pdf](http://www.acca.com/protected/pubs/docket/apr04/literacy.pdf).

If you like the resources listed here, visit ACC’s Virtual Library<sup>SM</sup> on ACC Online<sup>SM</sup> at [www.acca.com/resources/vl.php](http://www.acca.com/resources/vl.php). Our library is stocked with information provided by ACC members and others. If you have questions or need assistance in accessing this information, please contact Senior Attorney and Legal Resources Manager Karen Palmer at 202.293.4103, ext. 342, or [palmer@acca.com](mailto:palmer@acca.com). If you have resources, including redacted documents, that you are willing to share, email electronic documents to Director of Legal Resources Julianne Bramesco at [bramesco@acca.com](mailto:bramesco@acca.com).

counsel and witness in a trial. In such jurisdictions, it is often better to keep yourself and other knowledgeable in-house counsel on the trial team rather than risk disqualification by acting as opinion counsel. That’s because in-house counsel has a unique familiarity with both the technology and the company, which can prove invaluable in developing and executing the company’s litigation strategy. Losing in-house counsel from the litigation team could thus spell disaster for the outcome of the litigation.

A related problem is that if you produce the opinion in discovery or introduce it in evidence, your client will be deemed to have waived attorney-client privilege—and not just for the document. In federal court, waiving attorney-client privilege as to an opinion constitutes a general waiver of attorney-client privilege.<sup>10</sup> Such a general waiver can force in-house counsel to be questioned outside the scope of the opinion, thereby opening the door to disclosures of litigation strategies or factual fishing expeditions.

#### THE SUBSTANCE OF THE OPINION

Given the significant problems described above, it is unsurprising that conventional wisdom indicates an exculpatory opinion should not be created by in-house counsel, but should be prepared by outside counsel.<sup>11</sup> However, owing to the often prohibitive expense of obtaining an exculpatory opinion of counsel, or simply because the best opinion may come from an in-house attorney with years of experience in the field, the conventional wisdom must sometimes yield to the practical reality that an exculpatory opinion needs to come from in-house counsel.

The practical realities may also point toward a less formal opinion, which can also increase the incentive to keep the work in-house. Prior to the *Knorr-Bremse* ruling, patent opinions were prepared with the knowledge that, if there was an infringement suit, the relevant legal opinions would have to be produced in court (lest the alleged infringer be presumed to have acted willfully). In the wake of *Knorr-Bremse*, however, companies have—and will usually take—the option to keep their patent opinions to themselves. The opinions need not be produced in discovery and provided at trial in order to avoid a presumption of willfulness. This means that

patent opinions no longer necessarily have to be written with the court in mind. Instead of the lengthy, intensely formal, and rather expensive opinions of recent years, opinions can now be written for the client, in a short and straightforward manner that the client can actually understand. This should reduce the costs of obtaining these opinions, regardless of whether in-house or outside counsel provides the analysis.

**INSTEAD OF THE LENGTHY, INTENSELY FORMAL, AND RATHER EXPENSIVE OPINIONS OF RECENT YEARS, OPINIONS CAN NOW BE WRITTEN FOR THE CLIENT, IN A SHORT AND STRAIGHTFORWARD MANNER THAT THE CLIENT CAN ACTUALLY UNDERSTAND.**

But even if you are not required to introduce your in-house opinion to disprove an allegation of willful infringement, you might still find it beneficial to do so. Thus you should still be sure that the opinion contains all of the components of a competent and complete legal analysis. Here are some important guidelines:

Would you like to find out what kind of pre-litigation activity could reduce the risk of having to engage in IP litigation? Do you want the opportunity to join in-house counsel and explore the process behind building an effective protection system and the steps that you should take if your products are pirated or counterfeited? Then register for ACC's 2005 Annual Meeting, October 17-19 in Washington, DC, and look for these sessions:

- Avoiding Patent Litigation
- Dealing with Counterfeiting & Piracy

For more information and to register, visit [www.acca.com/am/05](http://www.acca.com/am/05).

*Provide an opinion as soon as possible after becoming aware of a troubling patent.* Upon discovery of the possibly infringed patent, a patent expert should perform the analysis as soon as possible. Waiting until a lawsuit actually happens is taken as evidence that the company was unconcerned about respecting the patent rights of the other party.

*Provide a written opinion.* Courts disfavor reliance on oral advice.<sup>12</sup> Given the vague standard that remains after *Knorr-Bremse*, an oral opinion may provide a safe harbor against a willfulness accusation, but a written opinion is simply going to convey a greater sense of credibility to a trier of fact. Moreover, should willfulness become an issue, the attorney providing an oral opinion should be prepared to testify as to that opinion.

*Discuss the relevant case law.* It is not necessary to devote an entire section of the opinion to the history of claim construction. However, when relying on a particular point of law to provide a favorable interpretation, it is best to include a discussion of that particular legal issue.

*Review the prosecution history.* As has long been the case in patent law, no interpretation of patent claims is complete without knowing what was said during prosecution.<sup>13</sup> Statements made during prosecution can define terms, relinquish apparent equivalents due to prosecution history estoppel, or otherwise clearly identify the limits of the patent claims.

*Clearly apply the legal analysis of the patent claims to your company's invention.* Nothing hurts the credibility of an opinion more than if it ignores facts or if facts are kept from the patent attorney in the hopes of a more favorable opinion. If the opinion is prepared in-house, be prepared for a court to require the opinion to satisfy unusually high standards—which means that it is especially critical for all facts to be shared with and used by in-house counsel.

*Clearly indicate that the opinion covers all of the claims of the possibly infringing patent.* If an element of an independent claim or group of claims clearly distinguishes the patent claim from your company's invention, mention it, as all elements of a claim have to be found in the potentially infringing product in order to find infringement. A sentence or two now could save millions of dollars down the road.

*Don't ignore the doctrine of equivalents.* Under this equitable doctrine, the courts look beyond the

literal elements of a patent claim to see if infringement has occurred, and will find infringement if an allegedly infringing invention includes substantial equivalents of a patent's literal elements. Your analysis should thus discuss why your company's invention is different enough so that it does not violate the protection that the doctrine of equivalents provides to other patents. Even a few sentences addressing this issue will demonstrate a concern for a thorough analysis.

## PROCEED WITH CAUTION

Even after *Knorr-Bremse*, the Federal Circuit is requiring companies to act affirmatively in order to avoid infringing others' patents. This is not unreasonable. After all, you want your competitors to treat your company's patent portfolio with respect; the affirmative duty of care imposed by the Federal Circuit simply makes sure that all companies adhere to the golden rule.

Unfortunately, the *Knorr-Bremse* ruling leaves several important questions unanswered: How can a company fulfill its affirmative duty of care—and prove in court that it has done so—without a written opinion of counsel? If an opinion is obtained and not produced, is the trier of fact permitted to know? If so, how can the attorneys overcome the natural inclination of the trier of fact to assume that an unproduced opinion is a negative opinion? Will the Federal Circuit finally eliminate the perception or presumption that an opinion from in-house counsel is unreliable because it is biased in favor of the client?

Until the Federal Circuit clarifies its position on the affirmative duty of care, obtaining a written exculpatory opinion is strongly advised. Perhaps, after a few well-written opinions from in-house counsel are litigated, the Federal Circuit may finally even end the courts' long prejudice against in-house opinions. ❏

## NOTES

1. *Underwater Devices, Inc. v. Morrison-Knudson Co.*, 717 F.2d 1380 (Fed. Cir. 1983).
2. *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. (BNA) 81 (Fed. Cir. 1986).
3. *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v.*

*Dana Corp.*, 383 F.3d 1337, 72 U.S.P.Q.2d (BNA) 1560 (Fed. Cir. 2004) (en banc).

4. 35 U.S.C. § 284.
5. *Underwater Devices*, 717 F.2d at 1390.
6. *See, e.g., Studiengesellschaft Kohle, m.b.H. v. Dart Industries, Inc.*, 862 F.2d 1564, 1573–76, 9 U.S.P.Q. 2d 1273, 1282–83 (Fed. Cir. 1988).
7. *Id.*
8. *Minnesota Mining & Manufacturing v. Johnson & Johnson Orthopedics, Inc.*, 976 F.2d 1559 (Fed. Cir. 1992), *reh'g en banc denied* (1992).
9. *Id.*
10. *See, e.g., Genentech, Inc. v. U.S. International Trade Comm'n*, 122 F.3d 1409 (Fed. Cir. 1997).
11. *See, e.g., Emily A. Evans, Advice of Counsel Regarding Another's Patent*, INTELLECTUAL PROPERTY TODAY, Sept. 2004, at 18.
12. *See, e.g., Bott v. Four Star Inc.*, 807 F.2d 1567, 1572, 1 U.S.P.Q.2d 1210, 1213 (Fed. Cir. 1986).
13. *See, e.g., Underwater Devices, supra*, note 1.

## ADDITIONAL REFERENCES

For more information on the issues raised by the *Knorr-Bremse* decision, you can refer to the following:

The text of the decision itself at [www.ll.georgetown.edu/federal/judicial/fed/september2004.cfm](http://www.ll.georgetown.edu/federal/judicial/fed/september2004.cfm).

The AIPLA amicus curiae brief, available at [www.aipla.org/Content/ContentGroups/Issues\\_and\\_Advocacy/Amicus\\_Briefs1/knorr\\_bremse.PDF](http://www.aipla.org/Content/ContentGroups/Issues_and_Advocacy/Amicus_Briefs1/knorr_bremse.PDF).

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Thomas Presson, *Knorr-Bremse and Questions About Production of an Exculpatory Legal Opinion and the Adverse Inference*, 44 IDEA 409, 417 (2004).

Marcia H. Sundeen & George Langendorf, *Willfulness: Opinions, Discovery and Waiver*, 804 PLI/PAT 919, 928 (2004).

David O. Taylor, *Wasting Resources: Reinventing the Scope of Waiver Resulting from the Advice-of-Counsel Defense to a Charge of Willful Patent Infringement*, 12 TEX. INTEL. PROP. L.J. 319, 326 (2004).

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