



## Patent Resources Group

### Patent Opinions, Strategy and Tactics Course Syllabus

#### I. THE NECESSITY OF ADVICE OF COUNSEL

- A. Infringement Opinions
- B. Clearance Opinions
- C. Validity Opinions
- D. Patentability Opinions
- E. Patent Due Diligence Opinions
- F. Pre-Litigation Opinions
  - 1. Compliance with Rule 11 of the Federal Rules of Civil Procedure
  - 2. Antitrust Issues
  - 3. Jurisdictional Issues (Forum Selection)
  - 4. Estimation of Damages/Remedies
- G. Avoidance of Willfulness: Advice of Counsel on the Subjects of Infringement, Validity and Enforceability in the Wake of the Federal Circuit's *en banc Knorr-Bremse* Decision
  - 1. Life Before *Knorr-Bremse*
  - 2. Review of *Knorr-Bremse*
  - 3. Did *Knorr-Bremse* Change Anything?
  - 4. The Federal Circuit's *Seagate* Decision Eliminates the "Duty of Care" Standard
  - 5. Does *Seagate* Really Constitute a Change as a Practical Matter?
  - 6. Selected Post-*Seagate* Jury Instructions

#### II. PROCEDURAL ASPECTS OF OPINION PRACTICE

- A. Pre-Opinion Drafting Considerations
  - 1. Business and Legal Reasons for Obtaining Opinions
- B. Legal Reasons
  - 1. When Should an Opinion Be Obtained?
- C. Opinion Drafting Fundamentals
  - 1. Formalities and Competency of the Opinion
  - 2. Authorship of the Opinion
  - 3. Recipient of the Opinion
  - 4. Reliance on the Opinion
  - 5. Duty to Update the Opinion

#### III. THE SUBSTANCE OF THE OPINION: INFRINGEMENT ADVICE

- A. Infringement Advice in a Sea of Chaos
  - 1. Claim Construction Chaos
  - 2. Advice on the Subject of Infringement
  - 3. Means-Plus-Function Claims: Yet Another Opportunity to Demonstrate Non-Infringement
  - 4. Special Infringement Issues
- B. Other Defenses:
  - 1. License
  - 2. Exhaustion
  - 3. Laches and the Six-Year Limitation Period of §286



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4. Equitable Estoppel
- IV. THE SUBSTANCE OF THE OPINION: VALIDITY ADVICE**
  - A. Anticipation
    1. Section 102(a): Consideration of Date of Invention by the Patentee and Whether the Reference Discloses the Patentee's Own Work
    2. Section 102(b): Public Use and On Sale
    3. Other Subsections of §102
    4. What Constitutes Anticipation
  - B. Obviousness
    1. *Graham* Factors
    2. *KSR Int'l Co. v. Teleflex Inc.*
    3. Obviousness After *KSR v. Teleflex*
    4. Establishing a *Prima Facie* Case of Obviousness
    5. Responding to an Alleged *Prima Facie* Case by Attacking Its Premise
    6. Objective Indicia of Non-Obviousness
  - C. The Requirement of Written Description
    1. Claims Are Too Broad
    2. Claims Are Too Narrow
    3. Applicant Adds New Matter
  - D. Enablement
    1. Consideration of the Full Scope of the Claims
    2. Enablement and Nascent Technology
    3. Need for Experts
  - E. Best Mode: Subjective and Objective Criteria
  - F. Indefiniteness
  - G. Other Bases of Invalidity
    1. Inventorship
    2. Double Patenting
    3. Inoperability
    4. Non-Statutory Subject Matter Under 35 USC §101
- V. THE SUBSTANCE OF THE OPINION: UNENFORCEABILITY**
  - A. General Aspects of Opinions on Inequitable Conduct
  - B. General Aspects on Patent Misuse
- VI. LITIGATION ISSUES ARISING FROM ASSERTING AN ADVICE OF COUNSEL DEFENSE**
  - A. The Duty of Due Care and the Defense of Reliance on the Advice of Counsel
  - B. Reliance on the Opinion, Waiver of the Privilege and the Scope of Discovery on the Opinion
  - C. Use of Opinion in Litigation: Getting It Into Evidence
    1. Failure to Disclose Opinion Generally Precludes Use at Trial
    2. When Must the Advice of Counsel Defense Be Asserted?



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3. Who Can Authenticate the Opinion?
  4. Procedural Mechanism to Obtain Withheld Opinions or Related Documents
  - D. Bifurcation: Trial and Discovery
    1. Bifurcation by State of Original
    2. Bifurcation Cannot Violate the Seventh Amendment
  - E. Proposed Amendments to the Patent Laws
- VII. RISK MANAGEMENT AND ETHICS ISSUES ASSOCIATED WITH IP OPINIONS**
- A. Introduction
    1. What Is an "Opinion"?
    2. What Are the Different Kinds of "Opinions" Frequently Encountered?
  - B. Opinions to Clients
    1. Who Is the Client?
    2. Ethical Duties and Responsibilities in Drafting IP Opinions Specifically for the Client
  - C. Opinions to Non-Clients
    1. In General
    2. ABA Model Rule 2.3
    3. Is There a Duty to Non-Clients in Drafting IP Opinions Specifically for Non-Clients?
    4. Underwriter's Letters
    5. Potential Concerns in Sharing IP Opinions With Non-Clients
  - D. Responding to Auditors' Requests for Information
    1. In General
    2. The ABA-AICPA Treaty and the ABA Policy Statement
    3. What to Disclose in Specific Situations
    4. Watching for Inappropriate Requests from Auditors
    5. Sarbanes-Oxley
    6. Case Law
  - E. When May IP Opinions Be Actionable?
    1. Negligence
    2. Fraud or Fraudulent Misrepresentation
    3. Breach of Fiduciary Duty
  - F. Avoiding Legal Opinion Claims by Clients and Non-Clients
    1. Disclaimers
    2. Tips to Reduce the Risk of Legal Opinion Claims