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5 TOP TAKEAWAYS

When Is an Opinion of Counsel Required in the New, Post-Halo Environment?

Kilpatrick Townsend Partner James Isbester recently addressed the Intellectual Property Section of the Contra Costa County Bar Association at a CLE event held at the firm's Walnut Creek office. The presentation, "When Is an Opinion of Counsel Required in the New Post-Halo Environment?", provided key insight on changes regarding the legal aspects of patent opinions.

Top takeaways from Mr. Isbester's analysis, include:

1. The Supreme Court's decision in *Halo Electronics, Inc. v. Pulse Electronics*, 136 S. Ct. 1923 (2016) and the subsequent lower court cases applying *Halo* make clear that willful infringement has returned as a real but containable risk.

2. Willful infringement is a question of the state of mind ***at the time infringement commenced*** (or the patent was first discovered). The later discovery of a reasonable defense is not relevant.

3. But willful infringement is meant for really egregious cases only. Facts that show good faith (i.e., not egregious) are: a) compliance with policies to protect IP rights of third parties; b) clearance (freedom to operate) studies; c) opinions of counsel; d) efforts to design around; and, e) prompt action in response to learning of a patent.

4. Obtain formal opinion when: a) only defense is invalidity based on third party prior art; b) non-infringement rests upon the legal interpretation of a specific term; or c) non-infringement turns upon legal analysis of doctrine of equivalents. Otherwise, a summary memo regarding a specific patent or a freedom to operate memo covering all patents prior to product launch should be adequate.

5. Don't knowingly infringe a valid patent!

Mr. Isbester has been advising and representing clients in intellectual property and technology-related matters for 30 years. Although his clients span the business world, most of his work is on behalf of high technology and medical device companies.

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