

Patent Opinions Post-*Seagate* still have a role; Clearances have new life

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I. Synopsis

Formal patent opinions are no longer required, and are used less in our experience. However, patent opinions do still provide advantages in many cases. Also, the need for the underlying patent analysis and clearance (right to use) reviews is as great as ever, and in fact now has much less risk of triggering willfulness liability. *In re Seagate*¹ in 2007 replaced the duty of care to avoid willful patent infringement with a new standard of “objective recklessness.”² *Seagate* was preceded in 2004 by *Knorr-Bremse*,³ which eliminated the drawing of an adverse inference by failure to introduce a patent opinion in evidence. This has now been codified in the America Invents Act.⁴ In 2012 came *Bard Peripheral*,⁵ which made the major factors in determining willfulness a matter of law for the judge. Since studies have shown judges are much less likely than juries to find willfulness post-*Seagate*, this is a significant development.

II. The Law of Willfulness and Waiver Before *In re Seagate*

A. The Duty of Due Care

Prior to *Seagate*, the law imposed an affirmative duty of care to avoid infringement of the known patent rights of others.⁶ This affirmative duty often was fulfilled by obtaining competent legal advice, usually in the form of an opinion of counsel, before engaging in any potentially infringing activity.⁷ An entity found liable for infringement that did not exercise due care risked a finding of willful patent infringement, which could subject the infringer to payment of treble damages and the patent holder’s attorneys’ fees.⁸ So, at least pre-*Seagate*, the common practice upon notice of potential patent infringement risk was to seek out and obtain opinions of counsel on either the invalidity of the patents or the non-infringement of the potential defendant’s product or activities.⁹

B. Privilege Waiver / *In re Echostar*¹⁰

When a company relies on an advice of counsel defense to defend against an accusation of willful infringement, it waives the attorney-client privilege as to that advice, and other documents in addition to the opinion itself often become discoverable.¹¹ Once opinions of counsel regarding an asserted patent are produced, the attorney-client privilege and the work product doctrine are waived as to “any document or opinion that embodies or discusses a communication to or from [the client] concerning whether that patent is valid, enforceable, and infringed by the accused.”¹²

¹ *In re Seagate Tech., LLC*, 497 F.3d 1360 (Fed. Cir. 2007), cert. denied, 128 S. Ct. 1445 (2008).

² *Id.* at 1382.

³ *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F. 3d 1337, 1341 (Fed. Cir. 2004).

⁴ Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 17, 125 Stat. 284, 329 (2011): “The failure of an infringer to obtain the advice of counsel, with respect to any allegedly infringed patent, or the failure of the infringer to present such advice to the court or jury, may not be used to prove that the accused infringer willfully infringed the patent or that the infringer intended to induce infringement of the patent.”

⁵ *Bard Peripheral Vascular, Inc. v. W.L. Gore & Assocs., Inc.*, 682 F.3d 1003 (Fed. Cir. 2012), cert. denied, 133 S.Ct. 932 (2013).

⁶ See *Electro Med. Sys., S.A. v. Cooper Life Scis., Inc.*, 34 F.3d 1048, 1056 (Fed. Cir. 1994).

⁷ See *Amsted Indus. Inc. v. Buckeye Steel Castings, Co.*, 24 F.3d 178, 181 (Fed. Cir. 1994).

⁸ See *Am. Med. Sys., Inc. v. Med. Eng’g Corp.*, 6 F.3d 1523, 1530 (Fed. Cir. 1993).

⁹ See *In re Seagate*, 497 F.3d at 1368-69 (“Where . . . a potential infringer has actual notice of another’s patent rights, he has an affirmative duty to exercise due care to determine whether or not he is infringing. Such an affirmative duty includes, *inter alia*, the duty to seek and obtain competent legal advice from counsel before the initiation of any possible infringing activity.”) (citing *Underwater Devices, Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380, 1389-90 (Fed. Cir. 1983)) (ellipsis in original).

¹⁰ *In re EchoStar Commc’ns Corp.*, 448 F.3d 1294 (Fed. Cir. 2006).

¹¹ See *id.*

¹² *Id.* at 1304.

This “waiver of both the attorney-client privilege and the work product immunity includes not only any letters, memorandum, conversation, or the like between the attorney and his or her client, but also includes, when appropriate, any documents referencing a communication between attorney and client.”¹³ However, the privilege and work product protection are not waived as to communications or work product that are not conveyed to the client—the category of true “opinion work product.”¹⁴ Work product, “which is never communicated to the client, is not discoverable.”¹⁵ Thus, drafts, memos to file, any other similar documents about the patent and its validity or infringement that do not reference such communication and that are not communicated to the client are not discoverable. The client “does not waive the attorney’s own analysis and debate over what advice will be given.”¹⁶ “[C]ounsel’s legal opinions and mental impressions that were not communicated . . . are . . . not within the scope of the waiver.”¹⁷

C. Inducement and 35 U.S.C. § 271(b)¹⁸

Section 271(b) provides that “[w]hoever actively induces infringement of a patent shall be liable as an infringer.”¹⁹ The Federal Circuit in *DSU Medical*²⁰ held that liability for inducement of infringement requires that the accused-inducer have both knowledge of the patent and specific intent and action to induce the infringement.²¹ As such, opinions of counsel may work not only to demonstrate commercially reasonable behavior and avoid willful infringement, but also demonstrate the absence of specific intent to induce the underlying infringement. The America Invents Act in Section 17 also states that the failure to obtain or produce an opinion may not be used “to prove . . . that the infringer intended to induce infringement of the patent.”²²

D. Knorr-Bremse

In 2004, the Federal Circuit held that “[n]o adverse inference that an opinion of counsel was or would have been unfavorable flows from an alleged infringer’s failure to obtain or produce an exculpatory opinion of counsel. Precedent to the contrary is overruled.”²³ Thus, an adverse inference that there must have been willfulness can’t be drawn where attorney-client privilege is asserted to avoid producing an opinion, or where no opinion was obtained.

III. Post-Seagate

A. Seagate – Objective Recklessness

The Federal Circuit’s decision in *Seagate* overruled the court’s previous standard for determining willful patent infringement. The court eliminated the affirmative duty to exercise due care to avoid infringing activity and replaced it with the standard of “objective recklessness.”²⁴ The court also clarified the scope of the waiver for attorney-client privileged communications and work product when an accused infringer chooses to rely upon an opinion of counsel in an effort to defeat a claim of willful infringement.²⁵

The change in the willfulness standard was made to bring the standard in line with recent Supreme Court decisions addressing the willfulness standard.²⁶ In doing so, the court overruled *Underwater Devices*,²⁷ which found a lower threshold for willfulness infringement.²⁸ The new standard of “objective recklessness” articulated in *Seagate* does not account for the accused infringer’s state of mind. Instead, under the new “objective recklessness” standard, a patentee seeking a willful infringement finding must show by clear and convincing evidence that the accused infringer acted despite an *objectively* high likelihood that its actions constituted

¹³ *Id.*

¹⁴ *Id.* at 1303.

¹⁵ *Id.*

¹⁶ *Id.*

¹⁷ *Id.* at 1304.

¹⁸ 35 U.S.C. § 271(b) (2006).

¹⁹ *Id.*

²⁰ See *DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293 (Fed. Cir. 2006).

²¹ *Id.*

²² Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 17, 125 Stat. 284, 329 (2011).

²³ *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F. 3d 1337, 1341 (Fed. Cir. 2004) (en banc).

²⁴ *In re EchoStar*, 448 F.3d at 1303.

²⁵ *In re Seagate*, 497 F.3d at 1371.

²⁶ *Id.* at 1370-1371 (citing *Safeco Ins. Co. of Am. V. Burr*, 551 U.S. 47 (2007) (concluding that “standard civil usage” of “willful” includes reckless behavior)).

²⁷ *Underwater Devices Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380 (Fed. Cir. 1983).

²⁸ *In re Seagate*, 497 F.3d at 1371 (“In contrast, the duty of care announced in *Underwater Devices* sets a lower threshold for willful infringement that is more akin to negligence. This standard fails to comport with the general understanding of willfulness in the civil context”) (internal citations omitted).

infringement of a valid patent.²⁹ To meet the standard for objective recklessness, the record developed in the infringement proceeding must show that the risk was known or so obvious that it should have been known to the accused infringer.³⁰ In application, this standard appears to ask whether there was a commercially reasonable basis for believing that one was not infringing on a valid patent. Judge Newman's concurrence illustrates in more detail the application of the "objective recklessness" standard, stating, "[t]he standards of behavior by which a possible infringer evaluates adverse patents should be the standards of fair commerce, including reasonableness of the actions taken in the particular circumstances."³¹

The court also discussed how this new standard affects pre- and post-litigation conduct, holding "that in ordinary circumstances, willfulness will depend on an infringer's prelitigation conduct."³² However, in the rare circumstances where it is the accused infringer's post-filing conduct that is reckless, "a patentee can move for a preliminary injunction"³³

In *Seagate*, the court also clarified the scope of the waiver for attorney-client privileged communications and work product when an accused infringer chooses to rely upon an opinion of counsel in an effort to defeat a claim of willful infringement. The court held that in general relying on opinion counsel's work product does not waive work product immunity with respect to trial counsel.³⁴ However, the court specified that the *Seagate* decision leaves open the possibility that a situation may arise in which the waiver may be extended to trial counsel.³⁵

B. Bard Peripheral

*Bard Peripheral*³⁶ held that the objective prong of the *Seagate* willfulness test is an issue for the judge, not the jury. It is an issue based on underlying questions of both law and fact, thus is subject to de novo review. This is significant, because as the study discussed below demonstrates, judges are less likely to find willfulness than juries.

Although the ultimate question of willfulness may be a question of fact, the threshold determination of objective recklessness involves questions of both fact and law, requiring an objective assessment of infringement defenses, as well as validity defenses that are not dependent on the factual circumstances of the particular party accused of infringement. *Bard Peripheral* found that the Court is in the best position for making the determination of reasonableness. The judge may allow the jury to determine the underlying facts relevant to the defense in the first instance (for example, the questions of anticipation or obviousness), but the ultimate legal question of whether a reasonable person would have considered there to be a high likelihood of infringement of a valid patent is now decided as a matter of law by the judge.

C. Post Seagate Experience

A study by Christopher Seaman published in the *Iowa Law Review*³⁷ compared willfulness decisions for 3 years prior to *Seagate* and 3 years afterward. Only 2% of cases had a willfulness decision, reflecting the fact that only 3-5% of cases go to trial (most cases settle instead). The study's findings are outlined in the below table:

Period	Percent of decisions finding willfulness
before <i>Knorr-Bremse</i>	63.8%
Post <i>Knorr-Bremse</i> , pre <i>Seagate</i>	48.2%
Post <i>Seagate</i>	37.2%

²⁹ *Id.*

³⁰ *Id.*

³¹ *Id.* at 1385 (Newman J., concurring).

³² *Id.* at 1374.

³³ *Id.*

³⁴ *Id.* at 1376.

³⁵ *Id.*

³⁶ *Bard Peripheral Vascular, Inc. v. W.L. Gore & Assocs., Inc.*, 682 F.3d 1003 (Fed. Cir. 2012), cert. denied, 133 S.Ct. 932 (2013).

³⁷ Christopher B. Seaman, *Willful Patent Infringement and Enhanced Damages After In re Seagate: An Empirical Study*, 97 *Iowa L. Rev.* 417 (2012).

In reviewing the differences between judge and jury decisions, the study found that juries showed almost no change in outcome over the time period studied. Perhaps this is because the difference in the the different standards (“affirmative duty of care” vs. “objective recklessness”) is meaningless to them. Complex jury instructions don’t help. Judges, on the other hand, are well-versed in these different standards. Judges found willfulness in 54% of the decisions pre-*Seagate*, but only 19% post-*Seagate*.³⁸ Thus, the recent *Bard Peripheral* decision, which puts the decision of willfulness in the hands of judges, should cause a significant reduction in the number of willfulness findings.

The study also found that patent opinions made little difference in the determination of willfulness. The factor most correlated with finding willfulness was evidence of copying. Conversely, willfulness was least likely to be found if there was a substantial defense to infringement. Design around evidence did not seem to help avoid willfulness, likely because this could be interpreted to imply that there was copying, which was considered a more significant factor.

However, the study only considered willfulness decisions, which means it self-selected cases where the design around failed to avoid infringement (as infringement is a necessary condition to willfulness). This may also explain why opinions were not effective in the determination of willfulness, because strong opinions likely correlated with early settlement or a finding of non-infringement.

D. Practical Guidelines

1. Clearance Practice Revival

In the past, many companies adopted a “head in the sand” approach to patent clearance (right-to-use) reviews. These companies were likely concerned that conducting a review would expose them to treble damages for willfulness--by putting them on notice of patents about which they would otherwise be unaware. However, that risk has been significantly reduced, and the advantages of clearance reviews are significant. Only 3-5% of suits go to trial, and willfulness is found in less than 20% of those. The odds drop much more when, as a result of a clearance, steps can be taken to reduce the risks.

The cost of a clearance can still be a challenge for some companies. However, clearances can vary widely in scope. A minimal clearance of searching for litigation in a particular area and doing a limited on-line key word search can be very economical.

Situations when a patent review or clearance should be strongly considered:

- The company is trying to raise money – investors will want to know about the risks to be evaluated.
- To evaluate risks with an acquisition – companies too small to draw attention will often get sued after being acquired and becoming a bigger target.
- When notice of a patent is received.
- When new products are being launched or a new business area is being explored (competitors are likely to have a head start on patents; they may have already licensed needed patents).
- When new significant features are being added to an existing product line (i.e., not features that have been in the company’s products for a number of years).

Advantages of conducting a clearance or other patent review:

- To show a lack of recklessness, to avoid willfulness.
- To catch problems in advance and avoid them (design around, license, attack them in the Patent Office) or factor litigation costs into product budget.
- To respond to investors’ questions and to reassure them about their investment in the company.
- To be prepared with a strategy to communicate to management and customers the day you are sued.
- To obtain a base of knowledge for a new product area; to guide development direction with a knowledge of the patent landscape.
- To locate expired patents that can be used as a safe harbor.

³⁸ *Id.*

- To find technology that can keep engineers from re-inventing the wheel.

2. When to get a patent opinion

- When there is a risk of going to trial over the patent, such as a patent of an aggressive competitor, or where the patent has been asserted before. Typically NPE (Non-Practicing Entity) suits do not go to trial, so a formal opinion is likely not needed. The patent opinion is not only useful to negate willfulness, it can be evidence of non-infringement or invalidity. The patent attorney who prepares the opinion may be a witness and can be a powerful advocate. Some judges have concluded that the absence of an opinion, while not usable as a presumption, remains a “factor” that the jury may consider when assessing willful infringement³⁹.
- When there is risk of an inducement allegation, to negate the required intent.

3. What to do short of an opinion

Formal written opinions can be expensive. Because they are now of limited use in avoiding willfulness, the main concern should be conducting the patent review, taking the appropriate actions, and appropriately documenting the results. For a clearance review, patents that are easily eliminated as issues can be dealt with in a short memo outlining why those patents found in a search are not relevant. For patents that in the past would have triggered a formal opinion, a 1-2 page review memo may now be sufficient.

4. In-house v. Outside Counsel Opinion

The opinion need not be done by outside counsel, although it may provide the appearance of more objectivity if it is. Another consideration is that patents found in outside counsel review, but not communicated to the client in the opinion or otherwise, are work product, not attorney-client communications, and thus not subject to the same discovery as client communications.

E. Questions and Answers

Q: *Does one who has knowledge of a patent have an affirmative “duty of due care” to avoid infringing valid patent rights?*

No, not anymore. The court in *Seagate* overruled and abandoned the affirmative duty of due care and, along with it, the affirmative obligation to obtain opinion of counsel.

Q: *What is the current standard to use in evaluating whether an infringer is a willful infringer?*

The current standard is that of “objective recklessness.”⁴⁰ The *Seagate* court held that “proof of willful infringement permitting enhanced damages requires at least a showing of objective recklessness.”⁴¹

Q: *What is the definition of “objective recklessness?”*

The *Seagate* court acknowledged that “reckless” is not “self-defining” and provided some guidance on its meaning.⁴² The court noted that “[t]he civil law generally calls a person reckless who acts . . . in the face of an unjustifiably high risk of harm that is either known or so obvious that it should be known.”⁴³ As mentioned above, this appears to require that a potential infringer act in a commercially reasonable manner if it knows of, or should know of, a risk of patent infringement. The *Bard* court clarified that this is a matter of law for the judge.

Q: *Does this mean that my company will never need to obtain an opinion of counsel?*

No. Post-*Seagate*, even if one knows of third-party patent rights of potential concern, the law does not require one to seek an opinion of counsel. Now, practical concerns and other considerations can be weighed to determine whether to obtain an opinion of counsel. Primary questions include: (1) do the particular circumstances suggest that an opinion may be prudent because a lawsuit is likely (e.g., you’ve received a threatening letter, or your company is cloning a competitor product with known patent protection); (2) will an opinion of counsel help

³⁹ See, e.g., *Franklin Elec. Co. v. Dover Corp.*, 2007 U.S. Dist. LEXIS 84588, at *22. (W.D. Wis. Nov. 15, 2007).

⁴⁰ *In re Seagate*, 497 F.3d at 1382.

⁴¹ *Id.* at 1371.

⁴² See *id.* (citing *Farmer v. Brennan*, 511 U.S. 825 (1994)).

⁴³ *Id.* (quoting *Farmer v. Brennan*, 511 U.S. 825, 836).

show that one did not know of any objectively high likelihood of infringement of a valid patent; and (3) will an opinion help show that one did not act recklessly relative to patent rights of others.⁴⁴

Q: *Can a competent opinion of counsel concluding the patent at issue is not infringed or is invalid serve as sufficient proof that the recipient of the opinion has not engaged in “objectively reckless” behavior that can give rise to a willful infringement finding?*

Yes, it can certainly help. The court explained that *Seagate* imposes “no affirmative obligation to obtain opinion of counsel,” but held that such an opinion can negate an accusation of objectively reckless behavior.⁴⁵ Opinions of counsel will still be weighed to determine if reliance on the opinion of counsel was reasonable. Considerations such as whether opinion counsel was given access to all relevant information necessary to analyze properly positions of non-infringement or invalidity will still be important. Opinions are not unyielding shields from potential liability. They are, however, another mechanism a potential patent infringer may use to demonstrate commercially reasonable behavior.⁴⁶

Q: *Is an opinion of counsel obtained after the filing of a lawsuit helpful?*

Probably not. The *Seagate* court noted that reliance on opinions obtained post-filing “will likely be of little significance” in willfulness analysis.⁴⁷ Post-suit opinions may be useful, however, in defending against an assertion of inducement of infringement. In particular, where the patent lawsuit itself or a letter shortly before the lawsuit is the first notice of the patent, the specific intent required for inducement may be countered by such an opinion.

Q: *Is knowledge of and causing the acts alleged to constitute infringement enough to prove inducement of infringement under § 271(b)?*

No. Knowledge of the patent and specific intent and action to induce the infringement are required elements.⁴⁸ Specifically:

[i]t must be established that the defendant possessed specific intent to encourage another’s infringement and not merely that the defendant had knowledge of the acts alleged to constitute inducement. The plaintiff has the burden of showing that the alleged infringer’s actions induced infringing acts *and* that he knew or should have known his actions would induce actual infringements.⁴⁹

Moreover, “inducement requires evidence of culpable conduct, directed to encouraging another’s infringement, not merely that the inducer had knowledge of the direct infringer’s activities.”⁵⁰

Q: *Can a non-infringement opinion of counsel eliminate the intent element of inducement of infringement and thus avoid liability for alleged inducement?*

Yes, if it is a good opinion.⁵¹ This argument was made in a 2006 case, but the district court found the legal opinion to be incompetent and the Federal Circuit agreed.⁵² It seems to follow, however, that because inducement requires knowledge of the patent and intent to infringe, demonstrating a commercially reasonable basis that no infringement exists may assist in defending a claim of induced infringement.

Q: *Can an invalidity opinion of counsel eliminate the intent element of inducement of infringement and thus avoid liability for alleged inducement?*

Yes. In *Gen-Probe Inc. v. Becton Dickinson & Co.*,⁵³ a district court in the Southern District of California denied a motion for summary judgment of contributory and induced infringement on the basis of an invalidity opinion the defendant had obtained before bringing its accused product to market. This was followed by the Federal Circuit ruling that a defendant's good faith belief that a patent is invalid can be a defense to induced infringement in *Commil*.⁵⁴

⁴⁴ See *id.*

⁴⁵ *Id.* at 1371.

⁴⁶ *Finistar Corp. v. DirectTV Group, Inc.*, No. 2007-1023-1024, slip op., (Fed. Cir. Apr. 18, 2008) (opinion of invalidity or non-infringement can negate an accusation of objectively reckless behavior).

⁴⁷ *In re Seagate*, 497 F.3d at 1374.

⁴⁸ See *DSU Med. Corp. v. JMS Co. Ltd.*, 471 F.3d 1293 (Fed. Cir. 2006).

⁴⁹ *Id.* at 1306 (emphasis in original).

⁵⁰ *Id.*

⁵¹ See *id.*; *Golden Blount, Inc. v. Robert H. Peterson Co.*, 438 F.3d 1354 (Fed. Cir. 2006).

⁵² See *Golden Blount*, 438 F.3d 1354.

⁵³ No. 09-cv-2319 – BEN (NLS) (S.D. Cal. Filed Oct. 19, 2009).

⁵⁴ *Commil USA LLC v. Cisco Sys. Inc.*, 730 F.3d 1361 (Fed. Cir. 2013). *Commil* has indicated that it will seek en banc review.

Q: *If the patentee does not seek a preliminary injunction, can the patentee seek enhanced damages based on post-filing infringement conduct alone?*

No. The Federal Circuit has explained that “[a] patentee who does not attempt to stop an accused infringer’s activities [with a preliminary injunction motion] should not be allowed to accrue enhanced damages based solely on the infringer’s post-filing conduct.”⁵⁵ The court also stated that “when an accused infringer’s post-filing conduct is reckless, a patentee can move for a preliminary injunction, which generally provides an adequate remedy for combating post-filing willful infringement.”⁵⁶

Q: *Will a court’s denial of a patentee’s motion for preliminary injunction impact the patentee’s ability to obtain enhanced damages in the suit?*

Unless the denial is based on factors other than the merits of the infringement and validity case, then it would have a significant negative impact.⁵⁷ In *Seagate*, the court held that a district court’s denial of a preliminary injunction motion based on a finding of a “substantial question about invalidity or infringement is likely sufficient not only to avoid a preliminary injunction, but also a charge of willfulness based on post-filing conduct.”⁵⁸

Q: *When a company relies on advice of counsel to defend an accusation of willful infringement and thereby waives privilege as to that advice, what documents besides the written opinion itself are discoverable? What about other documents sent to the company by outside counsel concerning the patent’s validity, enforceability, or infringement?*

Attorney-client privilege and the work product doctrine are waived as to “any document or opinion that embodies or discusses a communication to or from [the client] concerning whether that patent is valid, enforceable, and infringed by the accused.”⁵⁹ So any document or communication relayed from counsel to the client concerning the produced opinion must also be produced. Work product that is not communicated to the client, or otherwise referenced in communicated work product, does not have to be disclosed. It is also important to note that in many jurisdictions, such as the Northern District of Georgia, Eastern District of Texas, and Northern District of California, the local litigation rules define what and when these ancillary documents and communications must be produced.

Q: *Does the waiver of privilege and work product protection apply to litigation counsel in addition to opinion counsel?*

No, not unless unique circumstances arise.⁶⁰ The court in *Seagate* held that the disclosure of opinion counsel’s opinion in defending against an accusation of willful infringement does not generally waive attorney-client privilege for communications with trial counsel.⁶¹ The court reasoned that:

[T]he significantly different functions of trial counsel and opinion counsel advise against extending waiver to trial counsel. Whereas opinion counsel serves to provide an objective assessment for making informed business decisions, trial counsel focuses on litigation strategy and evaluates the most successful manner of presenting a case to a judicial decision maker. And trial counsel is engaged in an adversarial process.⁶²

However, the court said waiver could reach trial counsel in certain circumstances, such as chicanery.⁶³

An important lesson from the *Seagate* holding is that the work product associated with an opinion of counsel ought to be kept separate from work product associated with trial counsel. If trial counsel becomes involved in the generation of work product, even work product not communicated to the client, waiver could end up attaching to that work product. A true slippery slope could then be created because it would likely be difficult for a court to parse out where the “opinion” work product ended and the trial counsel work product began.

⁵⁵ *In re Seagate*, 497 F.3d at 1374.

⁵⁶ *Id.*

⁵⁷ *See id.*

⁵⁸ *See id.*

⁵⁹ *See In re Echostar*, 448 F.3d at 1304.

⁶⁰ *In re Seagate*, 497 F.3d 1360.

⁶¹ *Id.* at 1376.

⁶² *Id.* at 1373.

⁶³ *Id.* at 1375.



IV. Conclusion

Patent opinions are no longer required, and the Seaman study discussed above shows they were not a significant factor in a determination of willfulness. The study did not examine, however, the effect of an opinion and the underlying determination of infringement or validity. Also, an opinion may have some impact in certain cases. The cases and law changes have reduced the likelihood of a willfulness finding, and thus have significantly reduced this concern as a reason for not doing clearance reviews. While a formal opinion may not be required, conducting the underlying analysis in a clearance review, regardless of how it is documented, still has many advantages.