

# APPENDIX J - SAMPLE PATENT INFRINGEMENT OPINION

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CONFIDENTIAL: ATTORNEY-CLIENT  
PRIVILEGED COMMUNICATION

Addressee

\_\_\_\_\_  
\_\_\_\_\_

RE: Infringement Analysis re \_\_\_\_\_  
Your Ref: \_\_\_\_\_  
Our Ref: \_\_\_\_\_

Dear Mr. Smith:

We understand that \_\_\_\_\_ is currently developing \_\_\_\_\_ in the field of \_\_\_\_\_. Aspects of that development effort are disclosed in a draft patent application (our docket \_\_\_\_\_), and summarized as follows:

" \_\_\_\_\_ "

We also understand that \_\_\_\_\_ wants to avoid infringement of any patents issued to others, and to that end has asked us to conduct a right to use patent analysis with respect to U.S. patents. This letter responds to that request, and provides a right to practice opinion regarding the currently planned software and implementation. To that end we have conducted right-to-practice patent searches using the Micropatent U.S., WIPO, EU and Japanese abstract databases through \_\_\_\_\_, and analyzed the patents discovered with those searches. Given cost constraints, our search was not comprehensive, and it is entirely possible that we missed one or more relevant patents.

Based on our study and analysis of the facts as we understand them, and in view of the governing law and caveats as set forth below, it is our opinion that the systems, devices, and methods contemplated by \_\_\_\_\_, could be developed and deployed in a manner that would be found by the federal courts to avoid infringement of any of the claims of any issued U.S. patents. The most significant issues relate to \_\_\_\_\_. We are concerned that \_\_\_\_\_. We identified some key patents in this report, but given cost constraints we were not able to conduct a comprehensive analysis of such patents. Further research and analysis may well be advisable.

--- OR ---

You asked us to provide an infringement opinion on whether your <<device>>, as depicted in the attached images, would infringe any of U.S. Patents \_\_\_\_\_, \_\_\_\_\_, and \_\_\_\_\_. This letter summarizes our analysis.

Our analysis to date indicates that your <<device>> would likely not infringe any of U.S. Patents \_\_\_\_\_, \_\_\_\_\_, and \_\_\_\_\_, as several of the required elements present in the claims of the above referenced patents appear not to be present.

Our opinion reflects an outcome that we would reasonably expect in a properly contested and properly decided patent infringement action, based on the law and facts that we have at our disposal. Of course, the results of any litigation are uncertain and this opinion letter does not represent a guarantee of the outcome of any potential litigation. In setting forth our opinion, we have focused on what we believe are the strongest bases for sustaining a finding of non-infringement. Thus, there may be other grounds or arguments for non-infringement in addition to those discussed herein.

## ISSUES

Issue 1 - Whether your <<device>> falls within the scope of any of the claims of U.S. Pat. no. \_\_\_\_\_.

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## SHORT ANSWERS

1. Likely no. To the extent that claims 1-4 and 12 can be read to encompass the <<device>>, those claims are anticipated by \_\_\_\_\_ and should be declared invalid. The <<device>> falls outside the scope of all the other claims.
2. Likely no. All claims should be declared invalid over \_\_\_\_\_ and \_\_\_\_\_.
3. Likely no. The <<device>> falls outside the scope of all claims.

## APPLICABLE LAW

Infringement analysis can be exceedingly complicated, both by patent and procedural legal issues, as well as by technical engineering or scientific issues. We utilized the following principles in our analysis.

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## **Rights In Patent Ownership**

"The rights to which one is entitled by ownership of a patent are principally the right to exclude others from making, using, and selling patented subject matter".<sup>703</sup>

## **Claims Define The Scope Of The Patent Right**

The most important concept to understand in evaluating utility patent infringement is that "[i]t is the claims, not the written description, that define the scope of the patent right".<sup>704</sup> "The language of the claims (plus equivalents of the claimed invention) defines the bounds of the patentee's exclusive rights".<sup>705</sup>

## **Determination Of Infringement Is A Two Step Process**

"A determination of infringement requires a two step analysis, 'First, the claim must be properly construed to determine its scope and meaning. Second, the claim as properly construed must be compared to the accused device or process.'"<sup>706</sup>

## **Independent/Dependent Claims In The Infringement Analysis**

Every independent utility patent claim stands in its own right, and may be held infringed irrespective of infringement with respect to any other claim.<sup>707</sup> The general rule is that if one does not literally infringe an independent claim, a claim dependent on the independent claim also cannot be literally infringed. There are rare circumstances wherein a dependent claim could be infringed under the doctrine of equivalents even though the independent claim was not infringed.<sup>708</sup> Because of this distinction between independent and dependent claims, infringement analysis is directed almost exclusively to the independent claims.

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<sup>703</sup> *Kimberly-Clark Corp. v. Procter & Gamble Distributing Co., Inc.*, 973 F.2d 911 (Fed. Cir. 1991).

<sup>704</sup> *Laitram Corp. v. NEC Corp.*, 163 F.3d 1342 (Fed. Cir. 1998).

<sup>705</sup> *Wiener v. NEC Electronics, Inc.*, 102 F.3d 534 (Fed. Cir. 1996), citing *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 619-20 (Fed. Cir. 1995).

<sup>706</sup> *Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 149 F.3d 1309 (Fed. Cir. 1998) citing *Carroll Touch, Inc. v. Electro Mechanical Sys., Inc* (Fed. Cir. 1993).

<sup>707</sup> *Jones v. Hardy*, 727 F.2d 1524, 1528 (Fed. Cir. 1984).

<sup>708</sup> *Wilson Sporting Goods Co. v. David Geoffrey & Associates*, 904 F.2d 677 (Fed. Cir. 1990).

## Determination Of The Meaning Of Claims

"Claims should be construed as they would by those skilled in the art".<sup>709</sup> One of the most common mistakes is to infer limitations from the specification into the claims. "Where a Specification does not require a limitation, that limitation should not be read from the Specification into the claims".<sup>710</sup>

"To determine the proper meaning of claims we first consider the so-called intrinsic evidence, i.e., the claims, the written description, and if in evidence, the prosecution history".<sup>711</sup> If the meaning of a term in a claim is unclear, "It is entirely proper to 'use the specification in order to determine what the inventor meant by terms and phrases in the claims.'"<sup>712</sup> "The court may receive extrinsic evidence to educate itself about the invention and the relevant technology, but the court may not use extrinsic evidence to arrive at a claim construction that is clearly at odds with the construction mandated by the intrinsic evidence".<sup>713</sup>

"The court...determines whether there is any estoppel derived from the prosecution history that bars remedy even when there is technologic equivalency, for the patentee is precluded from reaching, under the doctrine of equivalents, subject matter that was disclaimed in order to obtain the patent".<sup>714</sup>

## Establishment of Infringement

"[T]he patentee must prove that the accused device embodies every limitation in the claim, either literally or by a substantial equivalent".<sup>715</sup>

"Intent is not an element of infringement...A patent owner may exclude others from practicing the claimed invention, regardless of whether infringers even know of the patent".<sup>716</sup>

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<sup>709</sup> *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861 (Fed. Cir. 1985).

<sup>710</sup> *Benetton Sportssystem USA, Inc. v. First Team Sports, Inc.*, 38 Fed. Appx. 599 (June 14, 2002); *E. I. Du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430 (Fed. Cir. 1988).

<sup>711</sup> *Vitronics Corp. v. Conceptronic, Inc.* (Fed. Cir. 1996)". *Digital Biometrics, Inc. v. Identix, Inc.* 149 F.3d 1335 (Fed. Cir. 1998).

<sup>712</sup> *Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.* (Fed. Cir. 1992)". *Laitram Corp v. Morehouse Industries, Inc.* 143 F.3d 1456 (Fed Cir. 1998).

<sup>713</sup> *Karlin Technology Inc. v. Surgical Dynamics, Inc.* 177 F.3d 968 (Fed. Cir. 1999).

<sup>714</sup> *Multiform Desiccants, Inc. v. Medzam Ltd.* 133 F.3d 1473 (Fed. Cir. 1998), see also *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.* 234 F.3d 558 (Fed. Cir. 2000).

<sup>715</sup> *Conroy v. Reebok International, Ltd.*, 14 F.3d 1570 (Fed. Cir. 1994).

<sup>716</sup> *Hilton Davis Chemical Co. v. Warner-Johnson Co. Inc.* 62 F.3d 1512 (Fed. Cir. 1995).

A product or method can infringe directly, or a company or person can infringe under contributory infringement or inducement to infringe. Liability for contributory infringement arises when one "sells within the United States... a component of a patented machine... knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial non-infringing use".<sup>717</sup> Liability for inducing infringement arises when one acts in a manner that actually induces infringement,<sup>718</sup> and the actor knew or should have known that his actions would induce direct infringement.<sup>719</sup> Both contributory infringement and inducement to infringe are dependent upon the proof of direct infringement by some other party. There can be no indirect infringement without direct infringement.<sup>720</sup>

### **Infringement Under The Doctrine Of Equivalents**

In the absence of literal infringement, there can still be infringement under the doctrine of equivalents if the accused device is substantially similar to that claimed. Courts have recognized various tests over the years to determine whether a patent is infringed under the doctrine of equivalents, but none of those tests are completely satisfactory. As noted in a 1997 Federal Circuit case, "The relationship between infringement and the claims becomes even more tenuous under the doctrine of equivalents, where a product is deemed to infringe the patentee's rights to exclude even though the product does not fall within the scope of the patent's claims".<sup>721</sup> The problem is exacerbated because application of the equivalents tests is ordinarily treated as a question of fact.<sup>722</sup>

For many years the dominant test was the function-way-result test, which focuses on whether "the accused process [performs] substantially the same steps as the patented process, in substantially the same way, to obtain the same result".<sup>723</sup> But the outcome of that test lies with the level of abstraction used by the trier of fact. Is a wood screw equivalent to a nail? On a high level of abstraction one could argue that yes, they are equivalent because they both are physical devices that are forced into two pieces of wood (same steps) by hand or power tools (same way) to keep the two pieces together (same result). On the

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<sup>717</sup> 35 U.S.C. § 271(c) (2000); *Golden Blount, Inc. v. Robert H. Peterson Co.*, 365 F.3d 1054, 1061 (Fed. Cir. 2004).

<sup>718</sup> 35 U.S.C. § 271(b); *Golden Blount, Inc. v. Robert H. Peterson Co.*, 365 F.3d 1054, 1061 (Fed. Cir. 2004).

<sup>719</sup> *Micro Chem. Inc. v. Great Plains Chem. Co.*, 194 F.3d 1250 (Fed. Cir. 1999).

<sup>720</sup> *Met-Coil Sys. Corp. v. Korners Unlimited, Inc.*, 803 F.2d 684, 687 (Fed. Cir. 1986).

<sup>721</sup> *Hoechst-Roussel Pharmaceuticals, Inc. v. Lehman*, 109 F.3d 756 (Fed. Cir. 1997) citing *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.* 498 U.S. 992; 111 S. Ct. 537 (Supreme Court 1990).

<sup>722</sup> *Dawn Equipment Co. v. Kentucky Farms, Inc.*, 140 F.3d 1009 (Fed. Cir. 1998).

<sup>723</sup> *Pennwalt Corp. v. Durand-Wayland Inc.*, 833 F.2d 931, 934 (Fed. Cir. 1987); *Fromson v. Anitec Printing Plates, Inc.*, 132 F.3d 1437 (Fed. Cir. 1997).

other hand one could readily argue at a lower level of abstraction that screws and nails are not at all equivalent. A screw relies on rotational insertion using a screw driver, and results in a joint that can only be pulled apart by damaging the pieces. A nail relies upon linear insertion (different steps) using a hammer (different way) and often results in a joint that can be pulled apart without damaging the pieces (different result).

The same flaw results from focusing on interchangeability.<sup>724</sup> In a great many cases one could reasonably argue screws and nails are roughly interchangeable, one could just as readily argue that each has advantages and disadvantages over the other. It all depends upon the granularity of the analysis.

For awhile the Federal Circuit was focusing on the "substantiality" or "insubstantiality" of the differences between the accused device or method and that set forth in the claims. This principle was confirmed in the famous *Hilton Davis* case,<sup>725</sup> holding that "[T]he substantiality of the differences between the claimed and accused products or processes is the ultimate question under the doctrine of equivalents..." and "In either event, the vantage point of one of ordinary skill in the relevant art provides the perspective for assessing the substantiality of the differences".

There is even a special twist in the analysis for claims that define elements using "means plus function" terms. In those cases the court must compare the accused structure with the structure, materials, and acts expressly disclosed in the body of the patent and must find the equivalent structure as well as identity of claimed function for that structure.<sup>726</sup>

Very recently the Federal Circuit handed down the *Bicon* case,<sup>727</sup> in which it focused on the importance of the amount of detail used in the claims in limiting the scope of equivalents. According to the so-called specific exclusion rule, "A claim that contains a detailed recitation of structure is properly accorded correspondingly limited recourse to the doctrine of equivalents". While some commentators immediately panned the idea as being unworkable, the Court was careful to point out that reliance on amount of detail is not a change in the law, but instead has been used for almost ten years.<sup>728</sup> Indeed, focusing on the

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<sup>724</sup> *Multiform Dessicants, Inc. v. Medzam, Ltd.* 133 F.3d 1473 (Fed. Cir. 1998).

<sup>725</sup> *Hilton Davis*, *supra*, 62 F.3d 1512.

<sup>726</sup> *Pennwalt Corp. v. Durand-Wayland Inc.*, *supra*, 833 F.2d at 934.

<sup>727</sup> *Bicon*, *supra*, 2006 U.S. App. LEXIS 6813 at 25-27.

<sup>728</sup> See *Tanabe Seiyaku Co. v. United States ITC*, 109 F.3d 726, 732 (Fed. Cir. 1997) ("The sharply restricted nature of the claims has much to do with the scope we accord to the doctrine of equivalents"). *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, *supra*, 149 F.3d at 1317 (subject matter is "specifically excluded" from coverage under the doctrine of equivalents if its inclusion is "inconsistent with the language of the claim").

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amount of detail is a very good way to limit the scope of equivalents. After all, as the Federal Circuit notes:

- the term 'unmounted' is not equivalent to mounted;<sup>729</sup>
- a minority is not equivalent to a majority;<sup>730</sup> and
- a hemispherical shape is not equivalent to a conical outer surface.<sup>731</sup>

To hold otherwise would effectively write those limitations out of the claims. What is really happening here is that patent practitioners don't spend the time to figure out what the invention is. Instead, they blather on with a hundred pages or more of specification, secure allowance by filing dozens or even hundreds of narrow claims, and then rely upon the doctrine of equivalents to provide the needed protection. That practice is destroying the patent system. Patent practitioners should rise or fall according to the skill with which they practice their craft. They need to clearly analyze the prior art, and then draft short claims that clearly delineate how the invention is different from that art.

### **Defenses To Infringement**

Defenses to allegations of patent infringement fall into two broad groups: statutory and equitable.<sup>732</sup> The statutory defenses are set forth in 35 U.S.C. § 282 and include non-infringement, absence of liability for infringement, unenforceability, and invalidity (for failure to meet the conditions of patentability or to comply with any requirement of sections 112 or 251).<sup>733</sup> The equitable defenses include unclean hands, unenforceability of the patent for fraud and inequitable conduct, misuse, and delay in filing suit resulting in laches or estoppel.<sup>734</sup>

## **ANALYSIS OF THE ISSUES**

### **Critical Claim Language**

There are only four terms in the claims where the meaning is likely to be disputed, "aaa", "bbb" and "ccc". With respect to "aaa" the dictionary definition is \_\_\_\_\_. There is no express teaching in the specification that would cause one to interpret the term differently, but during prosecution the application expressly

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<sup>729</sup> *Asyst Techs., Inc. v. Emtrak, Inc.*, 402 F.3d 1188, 1195 (Fed. Cir. 2005).

<sup>730</sup> *Moore U.S.A., Inc. v. Standard Register Co.*, 229 F.3d 1091, 1106 (Fed. Cir. 2000).

<sup>731</sup> *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1160 (Fed. Cir. 1998).

<sup>732</sup> *Mylan Pharms., Inc. v. Thompson*, 268 F.3d 1323, 1331 (Fed. Cir. 2001).

<sup>733</sup> 35 U.S.C. § 282

<sup>734</sup> *J.P. Stevens & Co. v. Lex Tex, Ltd.*, 747 F.2d 1553, 1561 (Fed. Cir. 1984).

disclaimed \_\_\_\_\_. The patent holder could argue that \_\_\_\_\_ but that argument would likely fail because \_\_\_\_\_....

With respect to "aaa"....

With respect to "bbb"....

With respect to "ccc"....

**U.S. Pat. no.** \_\_\_\_\_.

### **Claim 1**

Claim 1 recites:

<<listing of claim 1 with relevant portions emphasized>>

The <<device>> does not literally infringe claim 1 because \_\_\_\_\_. There is a potential argument that device would infringe under the doctrine of equivalents because \_\_\_\_\_. The argument could be further supported by \_\_\_\_\_. That argument, however, should fail on the grounds that \_\_\_\_\_.

### **Claims 2-4**

Claims 2-4 recite the following:

<<listing of claims 2-4 with relevant portions emphasized>>

The <<device>> clearly cannot directly infringe claims 2-4 because those are method claims, and the actor of the method would be \_\_\_\_\_. It is possible, however, that the patent holder could assert infringement of these claims on the grounds of contributory infringement or inducement to infringe. In the case of contributory infringement, the patent holder would have to prove that the only substantial use of the \_\_\_\_\_ is as a component of the <<device>>. That argument, however, is unlikely to prevail because \_\_\_\_\_. In the case of inducement to infringe the patent holder would have to show that the company actively induced others to infringe. The only possible argument there would likely be founded on the company's prints advertisements showing .....

<<All remaining claims of each of the patents at issue should be discussed in turn. It is important to weigh all reasonable sides of every issue, and avoid unsupported summary conclusions>>.