

4-1-2009

## Willful Infringement after *Seagate*: How the Willfulness Standard Has Changed and What Attorneys Should Know about It

Kevin Raudebaugh

Follow this and additional works at: <https://digitalcommons.law.uw.edu/wjlta>



Part of the [Intellectual Property Law Commons](#)

---

### Recommended Citation

Kevin Raudebaugh, *Willful Infringement after Seagate: How the Willfulness Standard Has Changed and What Attorneys Should Know about It*, 5 SHIDLER J. L. COM. & TECH. 20 (2009).

Available at: <https://digitalcommons.law.uw.edu/wjlta/vol5/iss5/1>

This Article is brought to you for free and open access by the Law Reviews and Journals at UW Law Digital Commons. It has been accepted for inclusion in Washington Journal of Law, Technology & Arts by an authorized editor of UW Law Digital Commons. For more information, please contact [lawref@uw.edu](mailto:lawref@uw.edu).

## Litigation

Cite as: Kevin Raudebaugh, *Willful Infringement After Seagate: How the Willfulness Standard Has Changed and What Attorneys Should Know About It*, 5 SHIDLER J. L. COM. & TECH. 20 (2009), available at <<http://lctjournal.washington.edu/vol5/a20Raudegaugh.html>>

# WILLFUL INFRINGEMENT AFTER SEAGATE: HOW THE WILLFULNESS STANDARD HAS CHANGED AND WHAT ATTORNEYS SHOULD KNOW ABOUT IT

---

Kevin Raudebaugh<sup>1</sup>

©Kevin Raudebaugh

## ABSTRACT

In *In re Seagate Technology, LLC*, the Court of Appeals for the Federal Circuit changed the standard for willful patent infringement from one akin to negligence, to one more aligned with recklessness. While the general standard is set forth in the decision, the *Seagate* Court stated that it would leave the development of the new standard's meaning to future cases. This Article surveys cases applying *Seagate* to determine the meaning of this novel standard, and explores what evidence courts have considered relevant to the willfulness inquiry. This Article also discusses how *Seagate* has affected the desirability of opinions of counsel and clearance searches, and concludes with recommendations for practicing attorneys about how to avoid willfulness charges.

## TABLE OF CONTENTS

### [Introduction](#)

### [Willfulness Before \*Seagate\*](#)

### [The \*Seagate\* Opinion](#)

### [The Effects of \*Seagate\*: Clearance Searches Can Be Conducted with Greater Freedom](#)

#### [Opinions of Counsel and the Closeness of the Case](#)

#### [Evidence of Attempts to Work Around Existing Patents](#)

#### [Cessation of Infringing Activities](#)

#### [Issuing Demand Letters](#)

### [Conclusion](#)

### [Practice Pointers](#)

## INTRODUCTION

<1>Patent infringement lawsuits have some of the highest

damages awards in private litigation, with jury awards and settlements regularly in the hundreds of millions of dollars.<sup>2</sup> A finding of willfulness raises the stakes in a patent infringement suit because it carries up to a treble damages penalty under the Patent Act.<sup>3</sup> Due to the incentive of treble damages, willfulness is frequently alleged; one study has shown that willfulness is alleged in over 90% of infringement cases.<sup>4</sup> Thus, it is particularly important for attorneys dealing with patented technology to be aware of ways to defend against and avoid charges of willfulness.

<2>The United States Court of Appeals for the Federal Circuit (CAFC) radically changed the standard for willfulness in *In re Seagate Technology, LLC*. The *Seagate* Court made it much easier to defend against willfulness charges, but left questions as to how the new standard would be interpreted by the courts.<sup>5</sup> Since *Seagate*, a number of opinions by United States District Courts and the CAFC have made it easier to interpret its impact. From the subsequent opinions, as well as *Seagate* itself, conclusions can be drawn regarding what measures are effective for defending against a charge of willfulness. This Article begins by describing the state of willfulness before *Seagate*. It will then analyze the main holdings of the *Seagate* opinion before examining court opinions subsequent to *Seagate* to determine how the standard is being developed and applied.

## WILLFULNESS BEFORE SEAGATE

<3>Prior to *Seagate*, courts judged willfulness by what was, in essence, a negligence standard.<sup>6</sup> Soon after the creation of the CAFC, and mindful of its mandate to correct a "widespread disregard of patent rights . . . undermining the national innovation incentive,"<sup>7</sup> the CAFC established a "due care"<sup>8</sup> standard for willful infringement. Under the "due care" standard, when "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."<sup>9</sup> Although courts considered the "totality of the circumstances" in assessing willfulness,<sup>10</sup> in practice, the analysis usually focused on whether the defendant acquired an opinion of counsel.<sup>11</sup> Thus, when a party received a demand letter from a company accusing them of infringement, the receiving party had an affirmative duty to investigate that charge by obtaining an opinion of counsel. The opinion would typically analyze both whether the allegedly infringed patent was valid and whether the activities actually infringed on it. Unfortunately, the opinion had questionable value when it came to subsequent litigation.

<4>Before *Seagate*, defendants faced a dilemma when asserting an opinion of counsel defense. The disclosure of an opinion letter at trial had the potential to waive both the attorney-client privilege and attorney work-product privilege for both in-house and litigation counsel, resulting in an advantage for the plaintiff.<sup>12</sup> However, if a party failed to assert the opinion to preserve these privileges, a jury could make a negative presumption about the contents of the letter.<sup>13</sup>

<5>Unfortunately, there was considerable confusion over the extent of a privilege waiver,<sup>14</sup> and the waiver was the source of substantial secondary litigation. In 2003, the CAFC eliminated the negative presumption that could arise for withholding an opinion of counsel letter,<sup>15</sup> but an effective opinion remained the best possible defense to a willfulness charge, and many defendants gave up their privileges in order to assert them. In response, the CAFC attempted to clarify the scope of waiver through an en banc hearing, but failed to successfully do so, and perhaps even added to the confusion.<sup>16</sup>

<6>During this same period, there was increasing national attention on the state of patent law. A lawsuit over the Blackberry technology initiated by a patent holding company received broad media coverage as the litigation threatened to shut down the network.<sup>17</sup> This may have led to the Supreme Court's decision to hear *eBay, Inc. v. MercExchange, LLC*, in which the Court tempered the CAFC's position that injunctive relief should be applied automatically upon a finding of infringement.<sup>18</sup> The United States Supreme Court continued to hear patent cases where it corrected CAFC decisions to be more in line with Supreme Court precedent,<sup>19</sup> and the CAFC responded by revisiting some of its own precedent in light of Supreme Court jurisprudence. This review included the standard for willfulness and the application of a waiver.

## THE SEAGATE OPINION

<7>The CAFC heard *Seagate* en banc to answer three specific questions relating to willful infringement: (1) should the assertion of the advice of counsel defense extend also waive the attorney-client privilege for communications with trial counsel; (2) what is the effect of that waiver on work-product immunity; and (3) should the standard for willful infringement be changed?<sup>20</sup> In answer to the first question, the court held that "as a general proposition . . . asserting the advice of counsel defense and disclosing opinions of counsel do not constitute

waiver of the attorney-client privilege for communications with trial counsel;"<sup>21</sup> however, a waiver still may occur in "unique circumstances" such as those involving "chicanery."<sup>22</sup> The CAFC then applied this same rule to work-product immunity using the same "general proposition" and "chicanery" language, and noting that the Supreme Court has approved of narrowly restricting the scope of the work product waiver.<sup>23</sup> These answers helped immensely to clarify that the waiver attached to the assertion of an opinion of counsel defense. Nevertheless, the most significant change to jurisprudence was the answer to the third question, how the standard for willful infringement should be changed.

<8>The CAFC specifically overruled its previous standard for willful infringement of patents,<sup>24</sup> and replaced it with a more stringent standard. Again, the *Seagate* Court noted Supreme Court jurisprudence on the topic, which likened willful behavior to recklessness,<sup>25</sup> as being the proper framework for its decision.<sup>26</sup> The CAFC stated that the previous standard, which was "more akin to negligence," is overruled, and the new standard "requires at least a showing of objective recklessness."<sup>27</sup>

<9>To prevail in a claim of willfulness, a patentee must now "show by clear and convincing evidence that the infringer acted despite an objectively high likelihood that its actions constituted infringement of a valid patent."<sup>28</sup> A patentee must "also demonstrate that this objectively-defined risk . . . was either known or so obvious it should have been known to the accused infringer."<sup>29</sup> This holding substantially raised the bar for proving willfulness by eliminating the affirmative obligation to obtain opinion of counsel, which was required under the old duty of care.<sup>30</sup> However, the court stated that it would "leave it to future cases to further develop the application of this standard."<sup>31</sup> Since *Seagate*, a number of cases in both district courts and the CAFC have demonstrated how the new standard is being applied.

## THE EFFECTS OF SEAGATE: CLEARANCE SEARCHES CAN BE CONDUCTED WITH GREATER FREEDOM

<10>*Seagate* has eliminated the threat of a future charge of willfulness as a reason to avoid clearance searches. A clearance search is an informal survey of existing patents in a particular field, which can be helpful for a company in developing its patent portfolio, or in deciding a direction for product development. Under the willfulness standard prior to *Seagate*,

the mere knowledge of an existing patent could be enough to trigger a claim of willfulness. The possibility of finding such a patent discouraged some companies from conducting patent searches, in spite of the fact that by doing so, such companies might have avoided infringement.<sup>32</sup>

<11> Now that the standard is elevated to objective recklessness, the likelihood of a finding of willfulness is reduced. Although it is questionable whether avoiding clearance searches was ever a good strategy,<sup>33</sup> *Seagate* removes the incentive to avoid such searches for fear of an incidental charge of willfulness. In fact, it is likely that conducting a competent clearance search would be evidence against willfulness under the reckless standard. Regardless, actual notice is still a component of the willfulness inquiry,<sup>34</sup> and if a clearance search reveals a patent that might be infringed upon, a company should take reasonable efforts to avoid doing so.

#### Opinions of Counsel and the Closeness of the Case

<12> Despite the changes brought about by *Seagate*, opinions of counsel are still one of the key pieces of evidence available to defend against a charge of willful patent infringement. The CAFC has recently stated that both legitimate defenses to infringement claims and credible invalidity arguments are sufficient to defeat a claim of willful infringement, but it did so without specifically requiring the arguments be in the form of an opinion of counsel.<sup>35</sup> In a separate opinion, the court stated that it “do[es] not think it was objectively reckless for [the defendant] to obtain and rely on the opinion of counsel,” and despite the fact that a district court ruled contrary to the opinion, “reliance on that opinion was nonetheless justified.”<sup>36</sup>

<13> *Seagate* has formally removed the affirmative duty to obtain an opinion of counsel. The CAFC said that “[b]ecause we abandon the affirmative duty of due care, we also reemphasize that there is no affirmative obligation to obtain opinion of counsel.”<sup>37</sup> Because of the elimination of the affirmative duty, a company faced with a potential infringement suit can give more weight to the cost of an opinion of counsel. If a company determines that there is no realistic chance of a finding of willfulness, the company is no longer compelled to obtain an opinion of counsel. However, if it determines that there is a genuine issue of infringement, a competent opinion of counsel in its favor should foreclose the possibility of a successful charge of willfulness. An additional effect of eliminating this duty is that in a multi-defendant lawsuit, it is more likely that a single opinion

letter can cover all defendants. The pre-*Seagate* norm was to have a separate opinion letter for each individual defendant.

<14> In addition, the form that the opinion of counsel should take depends on the closeness of the case. In general, the formality and depth of the opinion should increase as the likelihood of infringement increases. For example, if a company finds that the likelihood of infringement is low, then an informal opinion in the form of a brief document should suffice as a defense against willfulness. However, if such an opinion is later asserted as a defense against willfulness, it must be adequately supported by a factual or legal basis, and not be in the form of mere conclusions.<sup>38</sup> In contrast, if the chance of infringement is very high or definite, then a formal opinion letter should be obtained detailing the grounds for non-infringement or invalidity. Such formal opinion letters are quite expensive, but if they are obtained and relied upon in good faith, then they should prevent the treble damages of a willfulness charge.

<15> It is possible that the closeness of the case can determine willfulness by itself. A court has found a lack of willfulness when the infringement analysis was a close question,<sup>39</sup> which is one of the original pre-*Seagate* factors for evaluating willfulness.<sup>40</sup> If infringement is a close question, the circumstances should not satisfy the requirement of an objectively high likelihood of infringement.<sup>41</sup> But potential defendants should proceed cautiously if they plan on relying on the closeness of the case as a defense because closeness is a subjective determination made by a court, over which the litigants have little control. If the case is close, it is still a good idea to obtain a documented opinion of counsel, but the opinion does not need to be a formal opinion letter.

#### Evidence of Attempts to Work Around Existing Patents

<16> Even where defendants have full and detailed knowledge of a competitor's patents, they can avoid a charge of willfulness if the competitor can demonstrate that it attempted to work around an existing patent. A deliberate attempt to avoid infringement is strong evidence that a party did not willfully infringe on an existing patent. Several recent cases at the district court level have considered efforts to design around existing patents sufficient to overcome a charge of willfulness.<sup>42</sup> Furthermore, as one court pointed out, the innovation inherent in attempts to design around a patent are good from a policy perspective because they promote innovation, commerce and competition.<sup>43</sup> That same court noted that the policy is evident

in the specificity and narrowness of claim construction, which encourages people to read patents, become inspired by the ideas in them, and innovate to find new ways of accomplishing tasks.<sup>44</sup>

### Cessation of Infringing Activities

<17> Recently, at least one court has recognized cessation of potentially infringing activities as a factor weighing against a claim of willfulness.<sup>45</sup> If defendants have stopped the activities in question, they have not acted with an objectively high likelihood of causing harm through infringement. Although courts have not clarified the specific time at which potential infringers should cease their activities, it is reasonable to conclude that they should cease them after becoming aware of the patent at issue and making a determination on whether there is actual infringement. Ceasing production or operations is a drastic measure, but if a company believes it is infringing on a valid patent, doing so would reduce both the likelihood of a willfulness charge and the amount of damages it would have to pay.

### Issuing Demand Letters

<18> *Seagate* has made it more difficult to establish willfulness in a patent infringement suit, but a patentee may still be able to increase the likelihood of a finding of willfulness in future litigation by drafting a detailed demand letter. Because of the higher post-*Seagate* standard for knowledge of infringing activities,<sup>46</sup> a more detailed demand letter has a greater chance of satisfying the willfulness analysis. A patentee should consider including a copy of the allegedly infringed patent, a summary of how it is infringed, and a claim chart prepared by a patent attorney to ensure that the recipient has a high degree of knowledge.<sup>47</sup> It is also advisable to predict any defenses that the alleged infringer might raise, and to include retorts to those arguments in the letter to reduce the weight given to reliance on those defenses in future litigation.

### CONCLUSION

<19> Although *Seagate* has dramatically changed the standard for willful infringement, it has not dramatically changed the strategy for addressing an infringement claim. When a company becomes aware of a valid patent on which it may be infringing, it should still investigate whether it is actually infringing and

whether the patent is valid. A company that fails to take these actions and proceeds with the infringing activity is still subject to a charge of willfulness. Under *Seagate*, the measures that a company must take are now better scaled to the plausibility of the infringement charge, at least as far as willfulness is concerned. Furthermore, while the duty to obtain an opinion of counsel has been formally eliminated, opinions continue to serve important functions and are more beneficial to defendants in litigation because of the way that *Seagate* changed the waiver of privileges. Thus, *Seagate* has served the goals that it set out to achieve: the standard for willfulness is more in line with the broader law, the scope of waiver is much clearer than before, and the dilemma faced by litigators in asserting an opinion of counsel defense is eliminated. Overall, the new standard is good news for defendants in patent infringement suits because it is harder to sustain a charge of willfulness.

## PRACTICE POINTERS

- **Conduct Clearance Analysis:** Companies should not avoid a clearance analysis based on the concern that they will become aware of a patent, and that awareness will lead to a later finding of willfulness. Knowledge of existing patents will help a company avoid infringement charges in general, and if the company acts reasonably to avoid infringing an existing patent, it will not be vulnerable to a willfulness charge.
- **Design Around:** If a company becomes aware of a patent it might be infringing upon, a good faith effort to design around it will probably defeat a charge of willfulness, even if the design is later determined to infringe.
- **Receiving Demand Letters:** After receiving a demand letter alleging infringement, a company should conduct a preliminary analysis to determine the validity of the asserted patent and the likelihood of actual infringement. Decisions on how to proceed should be based on a number of factors, including: the likelihood of infringement, the possible value of a damage award, and many practical business considerations. If a company is unsure how to weigh these factors, it should obtain the advice of a competent patent attorney.
- **Opinions of Counsel:** When in doubt, obtain an opinion of counsel. The formality of the opinion

should increase with the probability of infringement, and formal opinion letters should be obtained if infringement is probable and the value of a potential suit is high.

- **Ceasing Activities:** If a competent investigation or opinion letter finds infringement without an invalidity defense, a company should cease the infringing activities to reduce the possibility of treble damages.
- **Issuing Demand Letters:** If a company becomes aware of a third party's infringing activities and wishes to issue a demand letter, a more detailed letter has a better chance of triggering a willfulness charge.

[<< Top](#)

#### Footnotes

1. Kevin Raudebaugh, University of Washington School of Law, J.D. program Class of 2010. Many thanks to Professor Jane K. Winn, Charles I. Stone Professor of Law at the University of Washington School of Law for her valuable guidance. Thanks also to Nathan Durrance of Seed IP for his generous practical advice.
2. Stephen Levy, *Changes in Patents May be Pending*, NEWSWEEK, 2007, available at <http://www.newsweek.com/id/36513>. For example, a jury awarded \$1.52 billion to Alcatel-Lucent from Microsoft for infringing MP3 patents, which was later overturned on appeal. In addition, Research In Motion settled with NTP for \$612 million claiming infringement of its Blackberry technology.
3. 35 U.S.C. § 284 (2006).
4. Kimberly A. Moore, *Empirical Statistics on Willful Patent Infringement*, 14 Fed. Cir. B.J. 227, 232 (2004) (detailing a study conducted by Professor Moore, now a Federal Circuit judge, on cases from 1999-2000).
5. *In re Seagate Tech. LLC*, 83 U.S.P.Q.2d 1865 (Fed. Cir. 2007) (en banc) [hereinafter *Seagate*].
6. *Id.* at 1870.
7. Advisory Committee on Industrial Innovation Final Report, Dep't of Commerce (1979). The CAFC was

created by the Federal Courts Improvement Act of 1982.

8. *Underwater Devices, Inc. v. Morrison-Knudson Co., Inc.*, 717 F.2d 1380, 1390 (Fed. Cir. 1983).
9. *Id.* at 1389.
10. Prior to *Seagate*, the CAFC had developed a “totality of the circumstances” test for determining willfulness, which included nine specifically enumerated factors. *See Read Corp. v. Portec, Inc.*, 970 F.2d 816, 826-27 (Fed. Cir. 1992) (observing that the factors are as follows: (1) whether the infringer deliberately copied the ideas or design of another, (2) whether the infringer, when he knew of the other’s patent protection, investigated the scope of the patent and formed a good-faith belief that it was invalid or not infringed, (3) the infringer’s behavior as a party to the litigation, (4) the defendant’s size and financial condition, (5) the closeness of the case, (6) the duration of the defendant’s misconduct, (7) remedial action by the defendant, (8) defendant’s motivation for harm, and (9) whether defendant attempted to conceal its misconduct.). Although this test appears to have been superseded by the willfulness standard in *Seagate*, the opinions subsequent to *Seagate* continue to evaluate willfulness by considering all of the circumstances in the situation. *See, e.g., Trading Techs. Int’l, Inc. v. eSpeed, Inc.*, No. 04 C 5312, 2008 WL 4542725, at \*1 (N.D. Ill. Jan. 3, 2008) (“*Seagate* did not alter the requirement that the totality of the circumstances must be taken into account when determining whether infringement was willful.”); *see also Energy Transp. Group, Inc. v. William Demant Holding*, C.A. No. 05-422 GMS, 2008 WL 114861, at \*1 (D. Del. Jan. 7, 2008) (“[N]othing in *Seagate* forbids a jury to consider whether a defendant obtained advice of counsel as part of the totality of circumstances in determining willfulness.”).
11. William L. LaFuze & Michael A. Valek, *Attorney Opinions, Waiver, and the New Law of Willful Infringement in Light of In re Seagate*, 922 PLI/Pat 495, 498-99 (2008).
12. The CAFC acknowledged this dilemma by noting “the functional relationship between our willfulness jurisprudence and the practical dilemmas faced in

the areas of attorney-client privilege and work product protection." *Seagate*, 83 U.S.P.Q.2d at 1867.

13. *Fromson v. W. Litho Plate & Supply Co.*, 853 F.2d 1568, 1572-73 (Fed. Cir. 1988) ("[A] court must be free to infer that either no opinion of counsel was obtained or, if an opinion were obtained, it was contrary to the infringer's desire to initiate or continue its use of the patentee's invention.").
14. Dov Greenbaum, Comment, *In re Seagate: Did It Really Fix the Waiver Issue? A Short Review and Analysis of Waiver Resulting from the Use of a Counsel's Opinion Letter as a Defense to Willful Infringement*, 12 MARQ. INTELL. PROP. L. REV. 155, 166 (2008).
15. *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337, 1344 (Fed. Cir. 2004) (en banc) ("The adverse inference that an opinion was or would have been unfavorable, flowing from the infringer's failure to obtain or produce an exculpatory opinion of counsel, is no longer warranted. Precedent authorizing such inference is overruled.").
16. Greenbaum, *supra* note 14, at 172. The CAFC refused to rehear the case when it was apparent that the confusion persisted.
17. Patent holding company NTP Inc. won an injunction against Research In Motion Ltd. based on a finding of infringement that would have shut down the Blackberry network in the United States. The injunction was stayed pending appeal, and the Department of Defense and Department of Justice both filed briefs urging against an injunction.
18. *eBay, Inc. v. MercExchange, LLC*, 547 U.S. 388 (2006) [hereinafter *eBay*].
19. *See, e.g., KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007) (overturning CAFC's test for obviousness that did not follow Supreme Court precedent); *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118 (2007) (noting that CAFC's "reasonable apprehension of suit" test for determining the existence of a case or controversy was in conflict or tension with four Supreme Court decisions); *Festo Corp. v. Shoketsu Kinzoku Kogyokabushiki Co. Ltd.*, 535 U.S. 722, 739 (2002) (vacating CAFC test for the Doctrine of

Equivalents which conflicted with Supreme Court precedents, which are “settled law.”). *eBay* was also decided on grounds that the CAFC’s low standard for granting injunctions conflicted with Supreme Court precedent holding that injunctions were only to be used in extraordinary circumstances.

20. *Seagate*, 83 U.S.P.Q.2d at 1867.
21. *Id.* at 1873.
22. *Id.*
23. *Id.* at 1874. The Supreme Court precedent the CAFC refers to is *United States v. Nobles*, 422 U.S. 225 (1975).
24. *Seagate*, 83 U.S.P.Q.2d at 1870 (“Accordingly, we overrule the standard set out in *Underwater Devices . . . .*”).
25. *Safeco Ins. Co. of Am. v. Burr*, 127 S. Ct. 2201, 2208 (2007).
26. *Seagate*, 83 U.S.P.Q.2d at 1870.
27. *Id.*
28. *Id.*
29. *Id.*
30. *Id.*
31. *Id.* at 1871.
32. MARK J. THRONSON & GABRIELLE S. ROTH & JOEL M. GROSSMAN, *INTELLECTUAL PROPERTY LEGAL OPINIONS* § 6.02B (2d ed. Aspen Publishers 2008); *see also* *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp*, 383 F.3d 1337, 1351 (Fed. Cir. 2004) (en banc) (Dyk, J., dissenting) (“[T]he due care requirement has fostered a reluctance to review patents for fear that the mere knowledge of a patent will lead to a finding of lack of due care . . . .”). If an organization becomes aware that its activities may infringe upon a patent via investigation, that awareness could be used as evidence of actual knowledge, which would trigger the duty to obtain an opinion of counsel. If an organization subsequently failed to fulfill this duty, it could be vulnerable to a willfulness charge in future litigation. This possible vulnerability resulted in a situation of willful ignorance about the content of existing

patents in the relevant field.

33. THRONSON ET AL., *supra* note 32, at § 6.02B.
34. *Seagate*, 83 U.S.P.Q.2d at 1870 (recklessness is determined by “an unjustifiably high risk of harm that is either known or so obvious that it should be known,”); *Northbrook Digital Corp. v. Browster, Inc.*, No. 06-4206, 2008 WL 4104695, at \*5 (D. Minn. Aug. 26, 2008) (knowledge of existing patents is relevant to willfulness inquiry); *GSI Group, Inc. v. Sukup Mfg. Co.*, 591 F. Supp. 2d 977, 982 (C.D. Ill. 2008) (presence of patent number on parts that components that competitor copied is evidence to determine whether defendant had actual knowledge required by reckless standard).
35. *Black & Decker, Inc. v. Robert Bosch Tool Corp.*, 260 Fed. Appx. 284, 291 (Fed. Cir. 2008).
36. *Lexicon Medical, LLC v. Northgate Techs., Inc.*, 292 Fed. Appx. 42, 51 (Fed. Cir. 2008). *See also* *Cohesive Techs. Inc. v. Waters Corp.*, 526 F. Supp. 2d 84, 104 (D. Mass. 2007) (no willfulness because defendant obtained opinion of counsel in good faith, and there was a bona fide dispute over infringement), *aff'd in part, rev'd in part, and vacated in part*, 543 F.3d 1351 (Fed. Cir. 2008).
37. *Seagate*, 83 U.S.P.Q.2d at 1870. Despite this assurance, it should be noted that when considering the totality of the circumstances, see note 10, *supra*, at least one court has treated the failure to obtain an opinion after being sued for infringement as evidence of willfulness. *GSI Group, Inc. v. Sukup Mfg. Co.*, 591 F. Supp. 2d 977, 983 (C.D. Ill. 2008).
38. *VNUS Medical Techs., Inc. v. Diomed Holdings, Inc.*, 527 F. Supp. 2d 1072, 1075-76 (N.D. Cal. 2007) (ruling that conclusory e-mails from counsel were insufficient to foreclose a finding of willful infringement.).
39. *TGIP, Inc. v. AT&T Corp.*, 527 F. Supp. 2d 561, 579 (E.D. Tex. 2007).
40. *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 826 (Fed. Cir. 1992). Factor number five of the *Read* factors is the “closeness of the case.”
41. Danny Prati, *In Re Seagate Technology LLC: A Clean Slate for Willfulness*, 23 BERKELEY TECH. L.J. 47, 69

(2008).

42. *E.g.*, *Northbrook Digital Corp. v. Browster, Inc.*, No. 06-4206, 2008 WL 4104695 (D. Minn. Aug. 26, 2008); *In re Muth Mirror Sys., LLC*, 379 B.R. 805 (E.D. Wisc. 2007); *Rhino Assocs., L.P. v. Berg Mfg. & Sales Corp.*, 531 F. Supp. 2d 652 (M.D. Pa. 2007).
43. *Muth Mirror*, 379 B.R. at 827.
44. *Id.*
45. *Northbrook*, 2008 WL 4104695 at \*7.
46. *Seagate*, 83 U.S.P.Q.2d at 1870.
47. A claim chart is typically a two-column chart that compares patent claims to a challenged object, usually an allegedly infringing product or prior art. Claim charts typically consist of at least a left column, which contains the claim language, broken down into individual elements, and a right column that shows how the compared object does or does not satisfy those elements.