



A Comprehensive and Extensive Collection of Legal Principles on Patent Opinions Under US Patent Laws

– *Journal of Intellectual Property Law & Practice*, 2011

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Before the US Court of Appeals for the Federal Circuit rewrote US patent law on wilful infringement in *In re Seagate Technology, LLC*, 497 F.3d 1360 (Fed. Cir. 2007), it was quite commonplace for formal legal opinions to be sought and obtained by those concerned with potential accusations of infringement of patents that were brought to their attention. While the practice has dwindled substantially since 2007, obtaining competent legal advice on the scope, reach, and validity of US patents nonetheless remains important, at least for its original intended purpose: to evaluate and mitigate the risks associated with infringing a patent.

US Patent Opinions and Evaluations provides a comprehensive and voluminous explanation of key legal principles to consider when reading, writing, and evaluating patent opinions under US patent laws. Fox includes discussions not only of the current law on the many topics addressed, but also of historical developments which provide context on the current state of the law.

Fox begins his analysis by introducing four fundamental patent law principles: claim construction (Chapter 2); infringement (Chapters 3–5); validity (Chapters 6–9); and enforceability (Chapter 10). His descriptions of these topics include consideration of current laws, historical background, and particular contexts in which the principles are raised. A focused reader may find more information than necessary on these topics, but his contextual discussions offer an enhanced level of understanding.

Fox next offers his pearls of wisdom on evaluating and opining on third party patent rights in the context of various situations including: patent due diligence for mergers, acquisitions, and licensing (Chapter 11); freedom to operate/clearance patent opinions (Chapter 12); avoiding wilful infringement (Chapter 13); prefiling requirements in litigation and Abbreviated New Drug Application (ANDA) Paragraph IV Certifications, and readiness for litigation in ‘rocket dockets’ and before the International Trade Commission (‘ITC’) (Chapter 14); as well as prefiling evaluations for post-grant proceedings before the US Patent and Trademark Office, such as *inter partes* and *ex partes* reexamination proceedings (Chapter 15). Fox's use of extensive block quotes provides the reader with the court's original analysis to evaluate the points being addressed.

Fox further offers the reader guidance on evaluating and opining on one's own patent rights in the context of similar countervailing situations, such as: typical business considerations involving the SEC and patent audits (Chapter 16); patentability opinions for new inventions



(Chapter 17); strategic patenting (Chapter 18); defensive due diligence from the patent owners' perspective before selling or licensing one's own patents (Chapter 19); prefiling requirements in litigation and ANDA Paragraph IV Certifications, and readiness for litigation in obtaining preliminary injunctions, in rocket docket, and before the ITC (Chapter 20); prefiling evaluations for post-grant correction proceedings before the US Patent and Trademark Office, such as reexamination, reissue, disclaimer, and certificates of correction (Chapter 21); as well as bankruptcy-related issues (Chapter 22). While some of these topics seem mirror images of the topics raised from the potential target's perspective, Fox offers different analyses based on this different perspective.

In the final two chapters of his tome, Fox provides guidance on evaluating competency of and reliance upon opinions for avoiding findings of wilful infringement (Chapter 23) and waiver of attorney-client privilege and work product immunity (Chapter 24).

Each chapter is written to stand alone, although Fox dutifully notes at the beginning of Chapter 2 on claim construction that 'claim construction is a necessary component of virtually every evaluation and opinion of U.S. patents' (p. 33, usage note). His usage notes at the beginning of each chapter help cross-reference the relevance of the discussion in each chapter to other discussions in the book.

The bold headings and extensive table of authorities make it easy for the reader to locate particular topics of interest to pinpoint relevant analysis and authority.

While future editions perhaps should add a chapter devoted to opinions used to address the intent element in indirect infringement and issues associated with mismarking patent numbers on goods, Fox has provided the reader with his answers to virtually any other question the reader may want to ask regarding US patent opinions and evaluations.