

# Opinions of Counsel after *Halo*

Presented at

21<sup>st</sup> Annual Advanced Patent Law Institute  
Nov. 3-4, 2016, Austin, Texas

Jeffrey D. Mills  
King & Spalding LLP  
[jmills@kslaw.com](mailto:jmills@kslaw.com)  
512.457.2000

---

Jeffrey D. Mills

## Opinions of Counsel After *Halo*

- History of Opinions Counsel in Patent Litigation
- *Halo Electronics, Inc. v. Pulse Electronics, Inc.*
- Impact of *Halo* on Opinions of Counsel

## History of Opinions of Counsel

Time Period	Opinions of Counsel in Patent Litigation
1983-2003	CAFC Opinions Are Necessary
2004-2014	CAFC Opinions Become Optional
2014	Supreme Court Foreshadows Change

### 1983-2003 – Opinions Are Necessary

- **CAFC Creates Duty to Seek Advice of Counsel**

A party with actual notice of another's patent rights has "an affirmative duty to exercise due care to determine whether or not he is infringing."

This duty includes the obligation "to seek and obtain competent legal advice from counsel *before* the initiation of any possible infringing activity."

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

## 1983-2003 – Opinions Are Necessary

- **Opinions become more expensive and complicated**
  - Affirmative duty broadly interpreted
  - Adverse inference if opinion not disclosed
  - Trial defenses insufficient
  - Privilege waiver extended to trial counsel

## 1983-2003 – Opinions Are Necessary

- **The result = an unbalanced legal landscape**
  - Willful infringement asserted in 92% of patent cases
  - Willful infringement claims successful with over 67% of juries

See K. A. Moore, *Empirical Statistics on Willful Patent Infringement*, 14 Fed. Cir. B.J. 227 (2004).

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](http://utcle.org/elibrary)

Title search: Opinions of Counsel after Halo

Also available as part of the eCourse

[2016 Advanced Patent Law eConference - Austin](#)

First appeared as part of the conference materials for the  
21<sup>st</sup> Annual Advanced Patent Law Institute session

"Opinion Practice after *Halo* and *Stryker*—More Valuable Now?"