

# **Non-Infringement & Invalidity Opinions**

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**Chicago, Illinois  
February, 2002**

## NON-INFRINGEMENT & INVALIDITY OPINIONS

### Purpose

- Avoid Willful Infringement & Trebel Damages
- Ethical Business Practice
- Culmination of Legitimate Design Around Efforts

### Competent Opinion of Counsel

1. Objective; Honest; Acknowledge Risk/Uncertainty/Probabilities
2. In Writing
3. Consider Audience; Assert Privilege, But Write as Non-Privileged
4. Professional, Good Grammar, No Typos
5. Accurate Technical Facts
6. Detailed, Well Reasoned Analysis – Not Conclusory
7. File History and Prior Art Considered
8. Consider Likely Counter Arguments
9. Complete, Exhibits Bound with Opinion
10. Follow-up, Has Client Followed Advise?

### Non-Infringement Opinion

- ◆ Introduction
  - Summary of Conclusion
  - Materials Considered
    - Client's Apparatus/Process
    - Patent
    - File History
    - References
  - Risk Acknowledgment
- ◆ Applicable Patent Infringement Principles
  - Claim Construction
  - Literal Infringement
  - Equivalence
- ◆ Patent-In-Issue
  - Independent Claims

- Dependent Claims
- Prosecution History
- Relevant Prior Art
  
- ◆ Client's Product/Process
  - Demonstrate Understanding
  - Literal Infringement
    - Means-Plus-Function Elements
  - Equivalence
    - Hilton-Davis Substantial/Insubstantial
    - Graver Tank Function-Way-Result
    - Missing Element
    - Prosecution History Estoppel
    - Prior Art Limits on Equivalence
  
- ◆ Conclusion
  - Questions/Comments

### Invalidity Opinions

- ◆ Introduction
  - Summary of Conclusion
  - Materials Considered
    - Patent
    - File History
    - Prior Art References (Search Results)
    - Technical Data, Tests, Etc.
  - Risk Acknowledgement
  
- ◆ Applicable Patent Validity Principles
  - Clear and Convincing Evidentiary Standard
  - Consider All Claims
  - Claim Construction
  - Prior Art Defined
  - Anticipation
  - Obviousness
  
- ◆ Patent-In-Issue
  - Analyze Each and Every Claim
  - Prosecution History

- Cited Prior Art
- Reason for Allowance
  
- ◆ Invalidating Prior Art
  - Section 102 Basis for Prior Art
  - Public Use and On Sale Corroboration
  - Demonstrate Understanding of Prior Art
  
- ◆ Invalidity Analysis
  - Application to Claims
    - Exhibit to Show Application of Prior Art to Claims
    - Means-Plus-Function Elements
  - Section 103 Considerations
    - Skill in Art
    - Motivation to Combine
    - Secondary Considerations
  
- ◆ Conclusions
  - Questions/Comments

February 2002  
Greer, Burns & Crain, Ltd.