In order to further the objective of the patent system and maximize the public’s incentive to innovate, it is imperative that the patent laws maintain a balance between the interests of patent owners in excluding others from their patents and the interests of society in the continual progress of technology. The current law in willful infringement analysis upsets this balance with the affirmative duty of due care, which shifts the burden of proof in patent infringement suits from the plaintiff to the alleged infringer. The affirmative duty places a heavy burden on the public and is inconsistent with various common law concepts. This comment proposes, as a remedy to these current inefficiencies in the patent law, to remove the affirmative duty from willful infringement analysis.
PLACING THE BURDEN BACK WHERE IT BELONGS: A PROPOSAL TO ELIMINATE THE AFFIRMATIVE DUTY FROM WILLFUL INFRINGEMENT ANALYSES

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INTRODUCTION

"[T]he ultimate good desired is better reached by free trade in ideas—the best test of truth is the power of the thought to get itself accepted in the competition of the market.” –Oliver Wendel Holmes, Jr.¹

For the past twenty years, the placement of an undue burden on alleged patent infringers has resulted in a chilling effect on the free trade of ideas that our patent system contemplates and that is essential to the advancement of innovation in our society.² Our patent system encourages innovation by rewarding inventors with a limited monopoly³ in exchange for their disclosure of a new idea to the public.⁴ Once this new information is available, inventors have the incentive to research it and attempt to design around the patent.⁵ This process of building upon the ideas of others is threatened by a justified fear of liability.⁶

³ 35 U.S.C. § 154(a)(1) (2000). This limited monopoly gives to the patent owner: the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States, and, if the invention is a process, . . . the right to exclude others from using, offering for sale or selling throughout the United States, or importing into the United States, products made by that process.
⁴ Id. This limited monopoly lasts for "20 years from the date on which the application for the patent was filed." Id. § 154(a)(2).
⁵ U.S. CONST. art. I, § 8, cl. 8.

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Current law holds that once an inventor has actual notice\(^7\) of another's patent rights, the inventor must conform his conduct to an affirmative duty of due care. The affirmative duty requires the inventor to determine whether he is infringing before he may safely proceed with the process of invention.\(^8\) In patent infringement suits, a mere failure of the inventor to prove that he exercised due care to determine whether or not his conduct constituted infringement may result in a finding of willful infringement.\(^9\) A patent owner will almost always take advantage of this inequitable rule by accusing willful infringement.\(^10\) Such a willful infringer may be held liable for damages up to three times the amount necessary to compensate the patent owner for his loss.\(^11\)

Until recently, in order to satisfy the standard of due care, an inventor was required to obtain the advice or opinion of counsel, typically in the form of a signed letter discounting any possible infringement.\(^12\) A major problem with the affirmative duty was the "adverse inference" rule, which forced an alleged infringer to waive the attorney-client privilege and disclose the legal advice obtained in order to disprove liability.\(^13\) The rule allowed a jury to infer willful infringement where the alleged

\(^7\) It is uncertain exactly what constitutes actual notice, but generally a "cease and desist" letter is treated as sufficient evidence of actual notice. \textit{See} Domestic Fabrics Corp. v. Sears Roebuck & Co., 326 F. Supp. 2d 694, 700 (E.D.N.C. 2004) (discussing actual notice, the court referred to two cease and desist letters, delivered in December 1998 and February 1999, that informed the defendant of his infringing behavior).

\(^8\) \textit{Underwater Devices Inc. v. Morrison-Knudsen Co.}, 717 F.2d 1380, 1389 (Fed. Cir. 1983) ("Where, as here 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." In this case, the defendant Morrison-Knudsen ("M-K") did not obtain legal advice or investigate patent file histories until long after infringement began. \textit{Id.} at 1390. When M-K did seek advice, it did so from its own in-house counsel who was not a patent attorney. \textit{Id.} Although this by itself does not demonstrate a lack of good-faith, it is a factor that the court considered. \textit{Id.} The court held that the defendant knew or should have known that it continued in its conduct without having legal advice upon which it could have justifiably relied. \textit{Id.}).

\(^9\) \textit{See}, \textit{e.g.}, \textit{Milgo Elecs. Corp. v. United Bus. Communications, Inc.}, 623 F.2d 645, 666 (10th Cir. 1980) (upholding a judgment of willful infringement and holding that once the defendant was put on notice of the plaintiff's patent rights he was under a duty to exercise due care to determine whether or not he was infringing the plaintiff's patents).


\(^12\) \textit{Underwater Devices}, 717 F.2d at 1390. The law as stated in \textit{Underwater Devices}, requiring disclosure of legal advice in order to satisfy the duty of care, has been the general rule, until the Federal Circuit in \textit{Knorr-Bremse Fur Nutzfahrzeuge GmbH v. Dana Corp.} eliminated the adverse-inference rule. 383 F.3d 1337, 1341 (Fed. Cir. 2004).

\(^13\) \textit{Fromson v. Western Litho Plate & Supply Co.}, 853 F.2d 1568, 1572-73 (Fed. Cir. 1988) (discussing the general rule that if an alleged infringer invokes the attorney-client privilege the court or trier of fact is free to infer that no opinion was obtained, or that if one was obtained, that it was contrary to the defendant's position). The main problem is the threat to confidentiality of attorney-client communications. \textit{See} Matthew D. Powers & Steven C. Carlson, \textit{The Evolution and Impact of the Doctrine of Willful Patent Infringement}, 51 SYRACUSE L. REV. 53, 86 (2001). The attorney-client privilege is designed "to encourage full and frank communication between attorneys and their clients." \textit{Id.} If confidentiality between attorney and client cannot be guaranteed, clients
infringer invoked the attorney-client privilege and refused to reveal the advice in order to protect perhaps unrelated confidential information from disclosure.\textsuperscript{14} The en banc decision of *Knorr-Bremse Fuer Nutzfahrzeuge GmbH v. Dana Corp.*\textsuperscript{15} ("*Knorr-Bremse*") reversed some of this precedent that has been inhibiting the free trade of ideas in our society.\textsuperscript{16} Specifically, the U.S. Court of Appeals for the Federal Circuit ("Federal Circuit") in *Knorr-Bremse* effectively eliminated the notorious adverse inference rule.\textsuperscript{17} In addition to finally returning sanctity to the attorney-client privilege in the patent infringement context, *Knorr-Bremse* also lightened the burden imposed upon alleged infringers.\textsuperscript{18} However, despite these
attempts, the Federal Circuit stopped short of eliminating the affirmative duty. The Federal Circuit accordingly failed to calibrate the balance between the rights of a patentee and the ideology of free market competition that fosters innovation in our society.

In order to restore that balance, it is necessary to eliminate the affirmative duty. The duty, which is contrary to centuries of judicial precedent that places the burden of proof on the plaintiff, unjustly shifts the burden from the plaintiff to the alleged infringer. The affirmative duty allows the patentee to prove notice of the patent, allege willful infringement, and wait while the alleged infringer fumbles with the inherently difficult task of proving one’s own mental state.

In the process of sweeping out the adverse inference rule, the Knorr-Bremse decision has stirred up a cloud of dust surrounding the issues of affirmative duty and willfulness. Several questions are unanswered and confusion remains as to what the affirmative duty demands. For example, what constitutes actual notice? Is an inventor put on notice simply by learning of another’s patent, or must he receive a letter from the patentee stating that his conduct may constitute infringement? What action satisfies due care in the absence of an opinion from counsel? Will the absence of an opinion from counsel be considered as a factor in determining willful infringement? Rather than attempt to answer these questions, this comment seeks to settle the dust and eliminate the affirmative duty altogether.

19 Knorr-Bremse, 383 F.3d at 1344.
20 See Knorr-Bremse, 383 F.3d at 1348 (Dyk, J., concurring in part and dissenting in part).
Judge Dyk concurred with the majority regarding the removal of the adverse inference rule, however he wrote a strong dissent proposing to eliminate the affirmative duty of care. Id; see also, TO PROMOTE INNOVATION, supra note 2, ch. 1, at 1. The report discusses the proper balance between patent policy and free market competition. Id. at 2. Policy that overly favors free market competition will inhibit the incentive to patent inventions, whereas policy too much in favor of patent rights may cause fear of liability inhibiting free market competition. Id. at 2. A proper balance between these factors is essential. Id.
22 See Taylor, supra note 21, at 748 (discussing that willfulness applies to the infringer’s state of mind).
23 See Knorr-Bremse, 383 F.3d at 1348 (Dyk, J., concurring in part and dissenting in part). In his dissent, Judge Dyk stated, “I do not join the majority opinion to the extent that it may be read as reaffirming that where, as here, 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.” Id. The majority opinion, while upholding the affirmative duty, made no attempt to clear up any of the uncertainties surrounding the duty of care. See Calderone, supra note 18, at 5 (2004).
24 See Knorr-Bremse, 383 F.3d at 1345. The Federal Circuit in Knorr-Bremse makes clear that where a potential infringer has actual notice of another’s patent, he has an affirmative duty to exercise due care. Id. The court offers no insight, however, as to what constitutes actual notice, or what might satisfy due care. See id.
25 It is at least clear that a cease and desist letter will serve to satisfy the requirement of actual notice. See Domestic Fabrics Corp. v. Sears Roebuck & Co., 326 F. Supp. 2d 694, 700 (E.D.N.C. 2004).
26 The answer to this question is most likely yes. See Knorr-Bremse, 383 F.3d at 1344, 1345. The court in Knorr-Bremse held that, where the alleged infringer either lacks an opinion of counsel or invokes the attorney-client privilege, the jury can no longer draw an adverse inference that such opinion would have been unfavorable. Id. This does not prevent a jury from considering the fact that the failure to obtain an opinion of counsel may suggest a failure to act with care. See
The background section of this comment will discuss willful infringement and its relationship to enhancement of damages. The background will also show what the law requires for a finding of willful infringement and, hence, for an award of enhanced damages. Furthermore, the background section will discuss the progression of the affirmative duty over the past twenty years.

The analysis section of this comment is divided into four subsections describing four different reasons why the affirmative duty is undesirable in patent litigation. The first subsection of the analysis will demonstrate that the affirmative duty places heavy economic costs and unreasonable burdens on society and that the need to remove these burdens far outweighs the stated rationale for deterring willful and wanton conduct in patent infringement. The second subsection will demonstrate that the duty is inconsistent with Supreme Court jurisprudence regarding punitive damages and runs contrary to ideals of due process. This subsection will also show that an alleged infringer’s failure to act with due care closely resembles common law negligence, a finding of which does not warrant an award of punitive damages. The third subsection will show that the affirmative duty fails to satisfy common law requirements for imposition of a duty. In particular, this subsection will analyze the considerations that are taken into account when imposing a duty of care in common law negligence cases and show that the affirmative duty as applied to willful infringement does not comport with these negligence considerations. In the final subsection of the analysis, this comment will establish that what the duty purports to achieve can be accomplished in its absence and, therefore, the best possible solution is to eliminate the affirmative duty in patent infringement cases entirely.

I. BACKGROUND

This section of the comment will give the reader a better understanding of the willfulness doctrine in patent infringement suits and how the doctrine relates to a court’s ability to grant an award of enhanced damages. This section will also discuss the fact that enhanced damages, which can be awarded under the current law for a failure to act with due care, have previously only been awarded for punitive

Calderone, supra note 18, at 5 (2004). With Markman v. Westview clarifying that claim construction is a question of law, a patent owner may soundly argue that an alleged infringer cannot meet his duty of care unless he consults with counsel to have the claims of the patent analyzed as a matter of law to determine if he is infringing. Id; see also Markman v. Westview Instruments, Inc., 517 U.S. 370, 372 (1996).

27 See TO PROMOTE INNOVATION, supra note 2, Executive Summary, at 1; see also Powers, supra note 13, at 100-02.

28 Knorr-Bremse, 383 F.3d at 1349 (Dyk, J., concurring in part and dissenting in part) (“The duty of care requirement finds no support in the patent damages statute, the legislative history, or Supreme Court opinions.”).


30 See Powers, supra note 13, at 100-02.

31 In his dissent in Knorr-Bremse, Judge Dyk concluded, “I would recognize that the due care requirement is a relic of the past and eliminate it as a factor in the willfulness and enhancement analysis.” Knorr-Bremse, 383 F.3d at 1352 (Dyk, J., concurring in part and dissenting in part). Judge Dyk realizes that the affirmative duty tilts the scales in favor of the patent owner, and lays too heavy a burden on alleged infringers; see id. at 1349.
purposes. This section will also show how the affirmative duty has developed over the past twenty years and that the duty now threatens the purpose of the patent system: to further innovation.

The United States Constitution grants Congress the power "[t]o promote the Progress of Science and useful Arts by securing for limited times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." The language of the Constitution demonstrates a contractual relationship with the granting of patent rights to an inventor in exchange for the benefit society derives through public disclosure of the new and useful information. The essential quid pro quo arrangement strikes a balance between protection of patent rights and the advancement of innovation through free market competition. The primary objective of the patent system, however, is to benefit the public, and any reward to the inventor is merely a means of achieving that objective.

The objective of the patent system in furthering innovation is threatened by the capricious application of willfulness in patent infringement cases. The term "willful" in the patent infringement context was introduced to define the level of culpability required for an award of enhanced damages under 35 U.S.C § 284. The statute says that:

Upon finding for the claimant the court shall award the client damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer together with interest and costs as fixed by the court.

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32 U.S. CONST. art. I, § 8, cl. 8.
33 To PROMOTE INNOVATION, supra note 2, Executive Summary, at 2.
34 Id. at Executive Summary, 1. The report begins by discussing the benefits of innovation to society:
Technological breakthroughs such as automobiles, airplanes, the personal computer, the Internet, television, telephones, and modern pharmaceuticals illustrate the power of innovation to increase prosperity and improve the quality of our lives... Both competition and patent policy can foster innovation, but each requires a proper balance with the other to do so.

35 United States v. Masonite Corp., 316 U.S. 265, 278 (1942) ("The promotion of the progress of science and the useful arts is the 'main object'; reward of inventors is secondary and merely a means to that end.").
36 See Margaret E. M. Utterback, Substitute This! A New Twist on Lost Profit Damages in Patent Infringement Suits: Grain Processing Corp. v. American Maize-Products Co., 2000 WIS. L. REV. 909, 936 (2000) (emphasizing the severity of willful infringement because of the courts' discretionary ability to treble damages). Because the affirmative duty places a heavy burden on the alleged infringer and requires little proof from the patent owner, it is too easy for the patent owner to allege and succeed in a claim for willful infringement. This advantage of the patent owner in combination with the courts' discretion ability to enhance damages creates unpredictable results. See Taylor, supra note 21, at 725–26.
37 Nat'l Presto Indus., Inc. v. The West Bend Co., 76 F.3d 1185, 1192 (Fed. Cir. 1996) (stating that willful infringement liability depends upon considerations of culpability, intent, and state of mind): see also Sesonic, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1574 (Fed. Cir. 1996) (stating that although 35 U.S.C. § 284 does not mention under what circumstances the court may enhance damages, it is settled that a decision to enhance damages must be based on a finding of willful infringement).
When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed. Increased damages under this paragraph shall not apply to provisional rights under section 154(d) of this title.

The court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances. This statute makes no reference to willful infringement, but gives the court the discretion to increase damages in certain situations. The law of patent infringement has developed to require a finding of willfulness in order for the court to enhance damages. In fact, until 1983, it was the general rule that in order for a plaintiff to obtain an award of enhanced damages, he was required to prove by clear and convincing evidence that the defendant deliberately and willfully copied the patented invention. Under the general rule prior to 1983, the burden of proof was clearly on the plaintiff. Now the burden has shifted to the defendant, and willfulness is decided based on the "totality of the circumstances." The "totality of the circumstances" is a concept which takes into account factors such as the conduct, intent, and adherence to the duty of care of the alleged infringer, as well as whether or not the alleged infringer had actual notice of the patentee's rights.

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39 Id. ("In either event the court may increase the damages up to three times the amount found or assessed.").
40 Sesonics, 81 F.3d at 1574.
41 See Powers, supra note 13, at 69–70. Through analyzing the history of the development of patent infringement, the author discusses how prior to 1983 a plaintiff was required to show clear and convincing evidence that the defendant consciously and deliberately infringed on the plaintiff's patent rights. Id.
42 Id. The plaintiff had the burden to come forth with "clear and convincing" evidence to prove damage and causation. Id.
43 See Taylor, supra note 21, at 725–26 (where willfulness is alleged "we shift the burden of proof to the infringer. We expect the [alleged] willful infringer to prove innocence instead of having the patent owner prove guilt."). The affirmative duty in patent infringement seems to require much more proof from the defendant to demonstrate that he acted with due care than it requires proof from the plaintiff to show that the defendant did not. Id. It can probably be argued that no one is in a better position to prove the defendant's mental state than the defendant himself; however this is an unconvincing argument and does not justify shifting the burden of proof to the defendant. In a criminal case, the defendant may often be in the best position to prove his own mental state, yet he is afforded the presumption that he is innocent until proven guilty. The affirmative duty runs contrary to this essential ideal of our adversarial system.
44 See Exculpatory Opinions, supra note 18, at 1. In deciding whether an infringer's conduct constitutes bad faith, a court must take into consideration the "totality of the circumstances." Id.
45 Knorr-Bremse Fuer Nutzfahrzeuge GmbH v. Dana Corp., 383 F.3d 1337, 1342 (Fed. Cir. 2004) (stating that "[d]etermination of willfulness is made on consideration of the totality of the circumstances"); see Read Corp. v. Portec, Inc., 970 F.2d 816, 827 (Fed. Cir. 1992), which lists nine factors for consideration in finding willfulness:

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 that it was not infringed;
3. the infringer's behavior as a party to the litigation...
Because of the relationship between willfulness and enhanced damages, it is
clear that the circumstances that justify a finding of willful infringement should
coincide with those circumstances deemed appropriate for enhancement of damages
under the common law. The common law traditionally refers to enhanced damages
as punitive. The purpose of an award in punitive damages is to punish unlawful
conduct and to deter its repetition. Numerous Supreme Court decisions have held
that punitive damages should only be awarded in situations where conduct is
egregious or reprehensible. In the last twenty years, however, the courts'
application of the willfulness doctrine in patent infringement has strayed from the
traditional application of enhanced damages for vindictive and punitive purposes.

In 1982, the U.S. Court of Appeals for the Federal Circuit was established in
order to obtain greater uniformity in judicial decisions for patent law cases. Around

(4) Defendant’s size and financial condition.
(5) Closeness of the case.
(6) Duration of defendant’s misconduct.
(7) Remedial action by the defendant.
(8) Defendant’s motivation for harm.
(9) whether defendant attempted to conceal its misconduct.

Id. (citations omitted).

damages are punitive, not compensatory. Enhancement is not a substitute for perceived
inadequacies in the calculation of actual damages, but depends on a showing of willful infringement
or other indicium of bad faith warranting punitive damages.”). In other words, in patent law cases,
a finding of willfulness is required before damages can be enhanced. Id. At common law, egregious
and reprehensible conduct is required before damages are enhanced. BMW of N. Am., Inc. v. Gore,
517 U.S. 559, 575 (1996). The logical rule resulting should be that a finding of willfulness must
comport with the common law requirement of egregious and reprehensible conduct. Knorr-Bremse,
383 F.3d at 1351 (Dyk, J., concurring in part and dissenting in part).

Sensonic, 81 F.3d at 1574: Beatrice Foods Co. v. New England Printing and Lithographing
Co., 923 F.2d 1576, 1580 (Fed. Cir. 1991): Knorr-Bremse, 383 F.3d at 1348 (Dyk, J., concurring in
part and dissenting in part).

serve a broader function: they are aimed at deterrence and retribution.”); Gore, 517 U.S. at 575
(“Perhaps the most important indicium of the reasonableness of a punitive damages award is the
degree of reprehensibility of the defendant’s conduct.”).

See, e.g., Campbell, 538 U.S. at 416; Gore, 517 U.S. at 575.

Powers, supra note 13, at 55; DeMasi, supra note 5, at 5. For over one hundred years, courts
traditionally awarded enhanced damages only in situations were the infringer deliberately copied or
misappropriated the plaintiff’s patents. Id. In the past twenty years, however, courts have awarded
enhanced damages against individuals who independently develop their own technology. Id.; see also Taylor, supra note 21, at 729–30 (“Prior to the Underwater decision, courts referred to the need
for an honest doubt as to patent validity or infringement.”).

Powers, supra note 13, at 77. The intent of Congress in creating the Federal Circuit was to
make patent rights more predictable and stable by having a centralized court of appeals, and also to
eliminate forum-shopping. Id.; see also Knorr-Bremse Fuer Nutzfahrzeuge GmbH v. Dana Corp.,
383 F.3d 1337, 1343 (Fed. Cir. 2004). The court stated that one foundation of the formation of the
Federal Circuit court was to reinforce the duty of inventors to act in accordance with the law. Id. The
court further recognized that this was important because the Federal Circuit was developed “at a
time when widespread disregard of patent rights was undermining the national innovation
incentive.” Id. Although this may seem to be a good intention for enforcing the affirmative duty,
the court fails to realize that the duty, which loosens the requirements for a finding of willfulness, is
having the same negative effect on innovation incentive as was the widespread disregard for patent
rights. See id.
this same time, several Federal Circuit decisions set a trend of interpreting the law on willful infringement in a fashion that would tip the balance in favor of the patent owner.\textsuperscript{52} Willful infringement liability was severely altered as the affirmative duty and adverse inference rule crept into the law.\textsuperscript{53}

Beginning with \textit{Underwater Devices Inc. v. Morrison-Knudsen Co.},\textsuperscript{54} ("Underwater") in 1983, the Federal Circuit, in determining whether the defendant had willfully infringed, ruled that

[w]here...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 ...[which includes] the duty to seek and obtain competent legal advice from counsel before the initiation of any possible infringing activity.\textsuperscript{55}

Following this decision were \textit{Kloster Speedsteel AB v. Crucible Inc.}\textsuperscript{56} in 1986 and \textit{Fromson v. Western Litho Plate & Supply Co.}\textsuperscript{57} in 1988. Both of these decisions applied the adverse inference rule holding that, where an alleged infringer invokes the attorney-client privilege and refuses to produce advice of counsel, the jury would be permitted to draw an inference of willful infringement.\textsuperscript{58}

When \textit{Underwater} established the affirmative duty to obtain legal advice, it relied on \textit{Milgo Electronics v. United Business Communications},\textsuperscript{59} which was the first decision to hold that once a potential infringer receives notice of a patent he must exercise due care to avoid infringement.\textsuperscript{60} With the emergence of the adverse

\textsuperscript{53} \textit{Powers, supra} note 13, at 76. Over the years the affirmative duty rule has "crept its way into the law." \textit{Id.} The first court to use language suggesting an affirmative duty was the 9th Circuit. \textit{See Coleman Co. v. Holly Mfg. Co.}, 269 F.2d 600, 606 (9th Cir. 1959).

\textsuperscript{54} \textit{Cf. Potash Corp. v. United States}, 717 F.2d 1380 (Fed. Cir. 1983).

\textsuperscript{55} \textit{Id.} at 1389-90.

\textsuperscript{56} \textit{Kloster Speedsteel AB, Inc. v. Crucible Inc.}, 793 F.2d 1565 (Fed. Cir. 1986).

\textsuperscript{57} \textit{Fromson v. Western Litho Plate & Supply Co.}, 853 F.2d 1568 (Fed. Cir. 1988).

\textsuperscript{58} \textit{Kloster Speedsteel}, 793 F.2d at 1568; \textit{Fromson}, 853 F.2d at 1572-73.

\textsuperscript{59} \textit{Cf. Milgo Elecs. v. United Bus. Communications}, 623 F.2d 645 (10th Cir. 1980). In this case, it was clearly shown that the defendant deliberately and purposefully copied the patent owner's modem design. \textit{Id.} at 666. The court held that "[o]nce UBC had actual notice of Milgo's patent rights, UBC was under an affirmative duty to exercise due care to determine whether or not it was infringing." \textit{Id.}

\textsuperscript{60} \textit{Id.} To go even further back, the first decision to "suggest" the existence of a duty to act with due care was \textit{Coleman Co. v. Holly Mfg. Co.} in 1959. 259 F.2d 660, 666 (9th Cir. 1959). After holding that the defendant's infringement was deliberate and willful, the court went on to state in
inference rule and the affirmative duty, claims of willfulness have become standard in virtually all patent infringement lawsuits. Many believe that the courts' policies regarding willful infringement have tipped the balance too far in favor of patent owners. Regardless, the courts have consistently applied the affirmative duty and adverse inference rule.

The Federal Circuit has finally given some credence to the unanimous dissatisfaction of the willfulness doctrine by its recent sua sponte grant of rehearing en banc and decision in *Knorr-Bremse v. Dana Corporation*. In considering the issues, the court accepted briefs that were filed by twenty-four *amicus curiae*. Virtually all of the twenty-four briefs requested that the court completely eliminate the adverse inference allowed to the jury when a party fails to produce an opinion of counsel or invokes the attorney-client privilege and refuses to produce an opinion. Two of the briefs argued that the affirmative duty of care should be eliminated altogether. A third brief advocated for a less stringent application of the duty and suggested that the existence of a duty should depend on the degree or quality of dicta that the "defendant did not exercise due care to ascertain whether or not it was infringing plaintiff's patent." 


*See* Moore, *supra* note 10, at 232 (Professor Kimberly Moore's study showed that willful infringement was alleged in 92.3% of patent cases terminated between 1999–2000).


Taylor, *supra* note 21, at 724 ("[T]he Federal Circuit decided *Underwater* in 1983 and started down a path toward severely penalizing knowing infringement... ").


An en banc panel of the Federal Circuit recently heard oral argument in *Knorr-Bremse Systeme fuer Nutzfahrzeuge GmbH v. Dana Corp.*, a case that has the potential to alter over 20 years of legal precedent on the issue of willful patent infringement. By sua sponte taking the case en banc, the Federal Circuit signaled its recognition of the significance of the issue....

Id.

For reference, a list of the amicus curiae briefs filed in *Knorr-Bremse* is available at http://www.ssjr.com/amicusbriefs.asp (last visited Apr. 3, 2005).

Cannella, *supra* note 64, at 25.

The defendants and virtually all amici urged the Federal Circuit to do away with the adverse inference when a party refuses to produce an opinion of counsel on the basis of the attorney-client privilege or work product immunity, and also argued that the adverse inference should be eliminated when a defendant did not obtain legal advice at all.

Id.; see also http://www.ssjr.com/amicusbriefs.asp (last visited Apr. 3, 2005) for direct access to these amicus briefs.

Cannella, *supra* note 64, at 26 ("Two amici advocated for the elimination of the affirmative duty of care altogether. They argued that patent law in certain fields, such as biotechnology and business methods, is too unpredictable and evolving for the duty to be reasonably applied.").: Brief of Amicus Curiae Biotechnology Industry Organization at 5, *Knorr-Bremse Systeme fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337 (Fed. Cir. 2004) (No. 01-1357) [hereinafter *Amicus Brief Biotech*]; Amicus Curiae Brief of Securities Industry Association at 11, *Knorr-Bremse Systeme fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337 (Fed. Cir. 2004) (No. 01-1357) [hereinafter *Amicus Brief Securities*].
notice that an individual has of another’s patent rights.\(^6\) The court removed the adverse inference rule, but upheld a duty of care.\(^6\)

As a result of the affirmative duty of due care, courts have awarded enhanced damages against infringers who, in fact, did not rely on other patents in developing their own technology.\(^7\) However, an individual who did not rely on another’s patent could not have purposefully and deliberately misappropriated any patent rights.\(^7\) A potential infringer’s failure to engage in due care does not by itself constitute reprehensible conduct.\(^7\) Infringement cases are frequently tried by juries whose decisions on such technical matters could easily be swayed by suggestions of willful behavior.\(^7\) Although such a finding requires consideration of the “totality of the circumstances,” it seems clear that the most convincing factor of willfulness in the minds of the jury is the alleged infringer’s failure to satisfy the affirmative duty of due care.\(^7\)

Although *Knorr-Bremse* has provided a temporary and partial solution to a complex problem, there is more to be done.\(^6\) Individual and corporate inventors are

\(^{6}\) Cannella, *supra* note 64, at 26 (“A third amicus urged that the affirmative duty of care should not be applied rigidly, but rather should depend on the quality of the patentee’s notice of infringement.”); Brief of Amicus Curiae Public Knowledge at 1, Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp., 383 F.3d 1337 (Fed. Cir. 2004) (No. 01-1357) [hereinafter Amicus Brief Public].

\(^{6}\) Knorr-Bremse Fuer Nutzfahrzeuge GmbH v. Dana Corp., 383 F.3d 1337, 1344 (Fed. Cir. 2004).

\(^{7}\) DeMasi, *supra* note 5, at 1 (“In the past 20 years, however, courts have provided for enhanced damages against infringers who independently develop their own technology.”).

\(^{7}\) Awarding enhanced damages against an individual who did not deliberately or purposefully copy or misappropriate another’s idea is not only unjust, but runs contrary to common law jurisprudence requiring proof of egregious conduct before awarding punitive damages. See *Knorr-Bremse*, 383 F.3d at 1351 (Dyk, J., concurring in part and dissenting in part).

\(^{7}\) Id. at 1349 (Judge Dyk dissenting) (“[b]ut a potential infringer’s mere failure to engage in due care is not itself reprehensible conduct”).


It is no surprise that studies have shown that juries are far more likely than judges to find willful infringement. But even if there were no difference in how judges and juries perceive the evidence, willful infringement gives the plaintiff a legitimate reason to focus on the defendant’s ‘bad’ state of mind, an appealing prospect given the usual tedium inherent in patent cases.

*Id.*

\(^{7}\) Knorr-Bremse, 383 F.3d at 1349 (Dyk, J., concurring in part and dissenting in part). In Judge Dyk’s dissent, he stated

> While the duty of care is only one factor in the determination of enhanced damages, no one can seriously doubt that, both in the minds of the jurors (in determining willfulness) and in the decision of the district court (concerning enhancement), the duty of care is by far the preeminent factor in the vast majority of cases.

*Id.*

\(^{7}\) See *id.* at 1347. The majority opinion holding was that “[a]n adverse inference that a legal opinion was or would have been unfavorable shall not be drawn from invocation of the attorney-client and/or work product privileges or from failure to consult with counsel.” *Id.* As stated before, this is a positive improvement, but the opinion fell short of making the most necessary remedy by eliminating the affirmative duty. See *id.*
faced with the constant threat of liability. The affirmative duty will force inventors to devote precious time and resources toward defensive policies to make sure they are constantly living up to the newly ambiguous standard of care. Fear of liability will deter inventors from designing around existing patents. In fact, inventors will have incentive to keep their distance from existing patents in order to avoid receiving "actual notice," a vague concept that initiates the duty to act with due care. This result is directly contrary to the ultimate goal of patent policy in the United States – to foster innovation and further the growth of technology. In order to maximize the accomplishment of this goal, it is necessary to eliminate the affirmative duty of care in patent infringement.

II. ANALYSIS

There are four major reasons why the affirmative duty should be eliminated. Part A of this section will discuss how the affirmative duty places various burdens on the general public. This subsection will also demonstrate not only the difficulties that alleged infringers face in court, but also the economic dilemmas faced by those researchers and developers trying to compete in the market. Part B will establish that because a mere failure to act with due care does not constitute "egregious" or "reprehensible" conduct, an award of enhanced damages for such a failure runs contrary to the Due Process Clause and is inconsistent with Supreme Court jurisprudence regarding punitive damages. Part C will show that at common law there are specific requirements for the imposition of a duty of care, which the Federal Circuit has failed to satisfy in creating the affirmative duty of due care in patent law. Finally, Part D will demonstrate that the affirmative duty, as a consideration in determining liability for willful infringement, is an excessive and unnecessary means for the protection of the rights of patent owners.

76 To PROMOTE INNOVATION, supra note 2, ch. 5, at 29 ("Panelists expressed considerable dissatisfaction with a state of affairs that in effect exposes firms to greater potential damages for trying to learn if they are infringing any patents than if they keep themselves blissfully ignorant.").

77 See Ryco, Inc. v. Ag-Bag Corp., 857 F.2d 1418, 1428 (Fed. Cir. 1988) ("The test is whether... a reasonable person would prudently conduct himself with any confidence that a court might hold the patent invalid or not infringed."). This case is an example of the ambiguity of the duty of care. See id.

78 To PROMOTE INNOVATION, supra note 2, ch. 5, at 30 ("[F]ear of willfulness charges works to undermine the patent system's disclosure goals by discouraging third parties from reading patents."). The Supreme Court recognizes the importance of designing around and further expanding and improving upon existing patents:

When a patent is granted and the information contained in it is circulated to the general public..., such additions to the general store of knowledge are of such importance to the public weal that the Federal Government is willing to pay the high price of 17 years of exclusive use for its disclosure, which...will stimulate ideas and the eventual development of further significant advances in the art. Kewanee Oil v. Bicron Corp., 416 U.S. 470, 481 (1974); Powers, supra note 13, at 96.

79 See To PROMOTE INNOVATION, supra note 2, ch. 5, at 30.

80 See id. at Executive Summary, 2 (discussing that the "quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility").
A. The Affirmative Duty Places Too Heavy a Burden on the General Public and Has Negative Effects on the Efficiency of Technological Advancement

One of the major problems with the affirmative duty is that it "turns the traditional burden for demonstrating willfulness on its head." The former law required the patent owner to prove willful infringement. Now the patent owner simply has to prove notice of the patent and the burden shifts to the alleged infringer, who must negate the presence of willful conduct. This burden shifting implicates to jurors that the defendant is guilty until he proves himself innocent. Although the rule no longer strictly requires disclosure of legal advice in order to prevail, the burden of negating willful infringement will remain difficult without an opinion of counsel.

The uncertainty in the law has created much apprehension in the research and development sectors of the economy. With the number of patent lawsuits tripling in the past twenty years, individuals and corporations cannot help but to be concerned about liability. With the added threat that looking at another's patent may constitute notice and expose them to willfulness charges, many inventors keep their distance from existing patents. Inventors are expressing "considerable dissatisfaction with a state of affairs that in effect exposes firms to greater potential damages for trying to learn if they are infringing any patents than if they keep themselves blissfully ignorant." In essence, the fear of willfulness charges is

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81 Amicus Brief Securities, supra note 67, at 10. This amicus brief advocated for the elimination of the affirmative duty. Id. at 11. The burden for demonstrating willfulness has traditionally been placed on the patent owner. Id. at 10.
82 Id. at 10.
83 Id. Shifting the burden to the alleged infringer cuts against the general rule requiring clear and convincing evidence of willful misconduct for imposition of punitive damages. Id: Taylor, supra note 21, at 729–30.
84 Taylor, supra note 21, at 726 ("In fact, our present approach is closer to assuming willfulness than the presumption of innocence afforded a criminal defendant.").
85 Amicus Brief Biotech, supra note 67, at 6 ("With complex, evolving, uncertain, and disputed doctrines of patent law as the predicate for gauging the state of mind, it has become difficult to know what lengths to go to secure enough advice so that in hindsight it will assuredly look to have been competent."). Because of the vagueness as to what constitutes notice and what conduct satisfies due care, potential infringers will be uncertain whether their conduct adheres to the duty of care and whether they have received notice triggering the duty in the first place. See id. It is obvious that this uncertainty creates problems for the defendant in proving that his conduct was proper. See id. Many potential infringers will feel that they have no choice but to obtain an opinion of counsel in order to negate any possible future finding of willfulness. Calderone, supra note 18, at 5.
86 See Thronson, supra note 62, at 2 (The authors discussed the FTC Report, which "found that the willful infringement doctrine has few defenders." Some of the individuals at the hearings stated that "the doctrine has an in terrorem effect that is out of proportion to its beneficial effects.").
87 TO PROMOTE INNOVATION, supra note 2, ch. 5, at 24 ("patent litigation . . . has increased greatly in recent years, tripling between 1981 and 2000"). Not only are the amount of law suits excessive, but the costs of litigation are extremely exorbitant. Kenneth S. Weitzman, How to Avoid Patent Infringement Litigation, Md News, at http://www.morganfinnegan.com/articles/MDM04.pdf (last visited Apr. 3, 2004). "It is reported that the average cost of a patent litigation in the U.S. exceeds $2 million." Id.
88 This "see-no-evil" philosophy is an attempt to avoid having prior knowledge of competitor patents. Thronson, supra note 62, at 2. According to the current law, there may be no willful infringement where the alleged infringer was not aware of the other's patent. Id.
89 TO PROMOTE INNOVATION, supra note 2, ch. 5, at 29.
undermining the goals of the patent system by inhibiting the dissemination of new ideas.\textsuperscript{90} Once notice has been established, firms will most likely seek legal advice in order to show due care and overcome any future willfulness charges.\textsuperscript{91} This is not a simple process and is often an extremely expensive endeavor. A patent opinion from outside counsel will generally cost around $20,000, and can exceed $100,000 where the opinion involves a complex patent.\textsuperscript{92} In addition to the burdensome costs, it is also a time consuming process that distracts employees from their normal course of business.\textsuperscript{93} This costly and time consuming defense is simply not an option for individual inventors and small companies.\textsuperscript{94} The affirmative duty therefore imposes extreme and unnecessary financial burdens on large companies and creates an injustice for small companies and individuals that cannot afford to obtain an opinion of counsel.\textsuperscript{95} It is necessary to eliminate the affirmative duty in order to remove the apprehensions and financial burdens associated with the threat of willfulness liability.

\textbf{B. The Affirmative Duty is Inconsistent with Supreme Court Jurisprudence Regarding Punitive Damages and Runs Contrary to the Due Process Clause}

A mere failure to act according to a standard of care does not constitute the reprehensible conduct required at common law for the enhancement of damages.\textsuperscript{96} In fact, a failure to satisfy a duty of care is squared more closely with common law definitions of negligence than it is with concepts of egregious and reprehensible

\begin{footnotes}
\item[90] See Taylor, \textit{supra} note 21, at 737. ("As matters now stand many companies discourage employees from reading patents . . . this defeats the basic purpose of the patent laws, dissemination of information.").
\item[91] Calderone, \textit{supra} note 18, at 5 (2004). Although no longer required by law to negate willfulness, the opinion letter remains the most assured way to defend against claims of willful infringement. \textit{Id.} Until the courts better define conduct that satisfies the duty of due care, firms will most likely obtain opinions to be safe. \textit{Id.}
\item[92] See Taylor, \textit{supra} note 21, at 740: Powers, \textit{supra} note 13, at 102 ("patent opinions generally cost at least $20,000, and frequently cost over $100,000"); \textit{Amicus Brief Securities, supra} note 67, at 9.
\item[93] See Taylor, \textit{supra} note 21, at 740. The estimated costs of $20,000 to over $100,000 do not include the "internal costs to the company involved in communicating with employees to get information on products or processes, time spent reviewing the patent by corporate officers, and delays induced in projects due to possible infringement issues." \textit{Id.}
\item[94] See Amicus Brief Public, \textit{supra} note 68, at 7 ("Upon receiving notice of an existing patent, the only practical options for most small entities are to cease their activities or to continue them while risking treble damages."). It is a safe assumption to say that most individual inventors and small companies would not be able to afford $100,000 plus external costs and time expenditures any time they thought they might be infringing another's patent. \textit{See id.}
\item[95] See \textit{id.} In discussing the financial burden on small entities this brief explains that "[p]urchasing an opinion of counsel or negotiating and paying for a license normally will be infeasible. Because treble damages would be financially crippling, many legitimate activities will be improperly chilled." \textit{Id.}
\item[96] Knorr-Bremse Fuer Nutzfahrzeuge GmbH v. Dana Corp., 383 F.3d 1337, 1349 (Fed. Cir. 2004) (Dyk, J., concurring in part and dissenting in part). Judge Dyk stated that "a potential infringer's mere failure to engage in due care is not itself reprehensible conduct." \textit{Id.}
\end{footnotes}
conduct. Negligence has often been defined as the failure to take precautions that cost less than the damage wrought by the [harm]. This seems to precisely define a defendant's conduct where he fails to adhere to the duty of taking sufficient precautions to make sure that his conduct did not infringe another's patent rights.

The following hypothetical may help to illustrate this point: A store owner notices that a container of milk has been spilled creating a potentially slippery and dangerous situation for his customers. Having knowledge of the potentially damaging situation, the store owner has a duty to act with care to make sure his customers are not injured. Similarly, in patent law, when an inventor becomes aware that he might be infringing another's patent rights, he has knowledge of a potentially damaging situation and has a duty to act with care to make sure the patent owner is not injured. In the above store owner scenario, if a customer slipped and fell, the store owner's failure to clean up the mess would still not justify punitive damages no matter how badly the customer was injured. "Conduct that is merely negligent, even if it causes severe damage, is insufficient to justify punitive damages."

The defendant's failure to conform his conduct to an affirmative duty of due care comports more closely with common law negligence than with common law...
concepts of willful behavior, and as such, an award of enhanced damages is unwarranted.\textsuperscript{103}

Furthermore, Supreme Court decisions have limited the award of punitive damages based on the Due Process Clause.\textsuperscript{104} The Court in \textit{Gore} stated that "[p]erhaps the most important indicium of the reasonableness of a punitive damages award is the degree of reprehensibility of the defendant's conduct."\textsuperscript{105} In rejecting an award of punitive damages the Court noted that the record was devoid of any "acts of affirmative misconduct," or "deliberate false misstatements," or "concealment of evidence of improper motive."\textsuperscript{106} The current patent law is inconsistent with \textit{Gore} because liability under the duty of care stems from a failure to act, as opposed to affirmative misconduct, deliberate false misstatements, or attempts at concealment.

The Supreme Court requirement of reprehensible conduct demonstrates that a mere failure to act according to a duty of care is not a sufficient basis to award punitive damages.\textsuperscript{107} The patent law has developed, however, to allow a court to find willful conduct where the alleged infringer has done no more than just that, failed to adhere to the duty of care.\textsuperscript{108} This application of willfulness unjustly allows the award of punitive damages in cases involving good-faith or ignorant conduct.\textsuperscript{109} In \textit{Seymour v. McCormick},\textsuperscript{110} while discussing the Patent Act of 1793, the Court recognized the injustices of punishing a defendant for ignorant conduct:

\begin{itemize}
\item \textsuperscript{103} See Knorr-Bremse, 383 F.3d at 1350 (Dyk, J., concurring in part and dissenting in part). Supreme Court cases interpreting 35 U.S.C. § 284 do not provide any basis for a duty of care. \textit{Id.} "Indeed, they appear to limit enhanced damages to cases of 'willful or bad-faith infringement.'" \textit{Id.} Failure to conform to a duty constitutes no more than negligent behavior and definitely does not constitute "willful or bad-faith infringement." \textit{See id.}
\item \textsuperscript{104} \textit{Id.; see also BMW of N. Am., Inc. v. Gore, 517 U.S. 559, 562 (1996).} The court in \textit{Gore} begins the opinion with reference to the Fourteenth Amendment by stating that "The Due Process Clause of the Fourteenth Amendment prohibits a State from imposing a 'grossly excessive' punishment on a tortfeasor." \textit{Id.} Although the Fourteenth Amendment only prohibits states from violating due process, federal laws (and therefore patent laws) are equally prohibited from violating due process through application of the Fifth Amendment. \textit{See U.S. CONST. amend. V ('No person shall be... deprived of life, liberty, or property, without due process of law').}
\item \textsuperscript{105} \textit{Gore, 517 U.S. at 575; State Farm Mut. Auto. Ins. Co. v. Campbell, 538 U.S. 408, 419 (2003).} \textit{Campbell} upheld the reasoning in \textit{Gore} by affirming that the degree of reprehensibility is the most important consideration in a determination of punitive damages. \textit{Id.}
\item \textsuperscript{106} \textit{Gore, 517 U.S at 579.} Similarly, punitive damages should not be warranted in patent law cases for a potential infringer's failure to prove that he adhered to the affirmative duty of care, where there exists no evidence of "deliberate false statements, acts of affirmative misconduct, or concealment of evidence of improper motive." \textit{See id.}
\item \textsuperscript{107} \textit{Id.} at 562. It can therefore be argued that the affirmative duty in patent law violates the Due Process Clause because it allows for the imposition of a "grossly excessive" punishment on a tortfeasor. \textit{See id.} Enhancement of damages for a failure to act with due care would be "grossly excessive" in the sense that the punishment does not fit the crime, for the culpability of such a failure does not rise up to the level of reprehensible conduct. \textit{See id.}
\item \textsuperscript{108} Underwater Devices Inc. v. Morrison-Knudsen Co., 717 F.2d 1380, 1389-90 (Fed. Cir. 1983).
\item \textsuperscript{109} \textit{See Powers, supra note 13, at 99.} Parties that independently develop their own technology without relying on the patents of others can be held liable for willful infringement. \textit{Id.} Once the independent inventor receives notice of his possible infringement, he has an affirmative duty to determine whether or not he is infringing. \textit{Underwater, 717 F.2d at 1389.} Failure to act with due care may result in liability for willful infringement. \textit{Id.}
\item \textsuperscript{110} \textit{Seymour v. McCormick, 57 U.S. 480 (1854).}
The defendant who acted in ignorance or good faith . . . was made liable to the same penalty with the wanton and malicious pirate . . . It is true, where the injury is wanton or malicious, a jury may inflict vindictive or exemplary damages, not to recompense the plaintiff, but to punish the defendant.\textsuperscript{111}

\textit{Seymour} is consistent with the 150 years of precedent that had been strictly followed prior to the formation of the Federal Circuit.\textsuperscript{112} Prior to the 1980's, judges only awarded enhanced damages in unusual cases, typically involving egregious conduct,\textsuperscript{113} The affirmative duty clearly contradicts this precedent.\textsuperscript{114} The law needs to return to its former interpretation, which involved no affirmative duty and more effectively achieved the goals of the patent system.

\section*{C. The Affirmative Duty of Care in the Patent Infringement Context Fails to Satisfy Common Law Requirements for Imposition of a Duty}

Well established common law concepts regarding duty of care suggest that the imposition of an affirmative duty on researchers and developers to make sure their conduct avoids infringement is inappropriate.\textsuperscript{115} Willful infringement incorporates the defendant's state of mind as the primary element in determining liability.\textsuperscript{116} In determining a defendant's state of mind, courts have established that a failure to act with due care once upon notice of the other's patent is a sufficient basis for a finding of willfulness, and accordingly for enhancement of damages.\textsuperscript{117} The duty of care in the law of patent infringement runs contrary to the common law.

The common law holds that, in choosing whether to impose a duty of care, there are important considerations that must be taken into account.\textsuperscript{118} For instance, it is important to evaluate and balance the conflicting interests of the respective parties.\textsuperscript{119} Factors to be considered are the risk of harm and the practicality of preventing that harm.\textsuperscript{120} Where it is relatively easy to correct the defendant's actions

\begin{itemize}
\item \textsuperscript{111} \textit{Id.} at 488–89. It is important to note that in this passage the court used the terms "wanton" and "malicious" twice, stressing that the use of "vindictive" or "exemplary" damages is only justified in situations involving serious misconduct. \textit{See id.}
\item \textsuperscript{112} \textsuperscript{Beck, supra note 73, at 1.}
\item \textsuperscript{113} \textit{Id.}
\item \textsuperscript{114} The fact that courts enforced the patent laws for over 100 years without an affirmative duty of care is a strong argument that the affirmative duty is unnecessary for the effective enforcement of patent rights.
\item \textsuperscript{115} The common law concepts referred to are generally applied in negligence cases. Since direct patent infringement is a strict liability offense, it might be argued that this comparison is inappropriate. However, a claim of willfulness considers the defendant's state of mind, and therefore steps out of the bounds of strict liability. Therefore it is not unreasonable to compare affirmative duty in willfulness claims to duty of care in negligence cases.
\item \textsuperscript{116} \textit{Taylor, supra note 21, at 748 (referring to statements made by commentator Richard Rainey, in which Rainey points out that a determination of willfulness focuses mainly on the infringer's state of mind). Id.}
\item \textsuperscript{117} Underwater Devices Inc. v. Morrison-Knudsen Co., 717 F.2d 1380, 1389–90 (Fed. Cir. 1983).
\item \textsuperscript{118} \textit{J.S. v. R.T.H., 155 N.J. 330, 337 (1998).}
\item \textsuperscript{119} \textit{Id.} at 338.
\item \textsuperscript{120} \textit{Id.} at 339.
\end{itemize}
and the harm at risk is serious, it may be appropriate to impose a duty to act with care.\footnote{Id. at 339–40.} Furthermore, the determination of whether to impose a duty of care should also take into account notions of public policy, fairness, common sense, and morality.\footnote{Id. at 339.}

In implementing the affirmative duty of due care, the courts have not given proper consideration to the appropriate factors.\footnote{\textit{The precedent for imposing an affirmative duty begins with Coleman, in which the court stated in dicta that the defendant did not act with due care. Coleman Co. v. Holly Mfg. Co., 269 F.2d 660, 666 (9th Cir. 1959). The court in Milgo picked up on this language and relied on it in holding that the defendant had "an affirmative duty to exercise due care to determine whether it was infringing [plaintiff's] patents." Milgo Elecs. Corp. v. United Bus. Communications, Inc., 623 F.2d 645, 666 (10th Cir. 1980). While establishing new precedent, the court does not justify its imposition of such a duty. See \textit{id.}} at 339. The precedent for imposing an affirmative duty begins with Coleman, in which the court stated in dicta that the defendant did not act with due care. Coleman Co. v. Holly Mfg. Co., 269 F.2d 660, 666 (9th Cir. 1959). The court in Milgo picked up on this language and relied on it in holding that the defendant had "an affirmative duty to exercise due care to determine whether it was infringing [plaintiff's] patents." Milgo Elecs. Corp. v. United Bus. Communications, Inc., 623 F.2d 645, 666 (10th Cir. 1980). While establishing new precedent, the court does not justify its imposition of such a duty. See \textit{id.} at 339.} Of utmost importance is the balance of conflicting interests of the respective parties.\footnote{The precedent for imposing an affirmative duty begins with Coleman, in which the court stated in dicta that the defendant did not act with due care. Coleman Co. v. Holly Mfg. Co., 269 F.2d 660, 666 (9th Cir. 1959). The court in Milgo picked up on this language and relied on it in holding that the defendant had "an affirmative duty to exercise due care to determine whether it was infringing [plaintiff's] patents." Milgo Elecs. Corp. v. United Bus. Communications, Inc., 623 F.2d 645, 666 (10th Cir. 1980). While establishing new precedent, the court does not justify its imposition of such a duty. See \textit{id.} at 339.} On one side, the patent owner has an interest in protecting his limited monopoly which he has rightfully earned through public disclosure of his new and useful idea.\footnote{On one side, the patent owner has an interest in protecting his limited monopoly which he has rightfully earned through public disclosure of his new and useful idea.} On the other side, there is the interest of the alleged infringer, which represents the interests of the public and the need to advance technology by expanding upon already existing ideas, including those of the patent owner.\footnote{On the other side, there is the interest of the alleged infringer, which represents the interests of the public and the need to advance technology by expanding upon already existing ideas, including those of the patent owner.} It is difficult to argue that the interests of the patent owner outweigh the interests of inventors, researchers and developers.\footnote{It is difficult to argue that the interests of the patent owner outweigh the interests of inventors, researchers and developers.}

This is especially true since the primary objective of the patent system is to benefit the public, and any reward to the inventor is merely a means of achieving that end.\footnote{This is especially true since the primary objective of the patent system is to benefit the public, and any reward to the inventor is merely a means of achieving that end.}

The affirmative duty also improperly favors patent owners by providing them a windfall for enhanced damages.\footnote{The affirmative duty also improperly favors patent owners by providing them a windfall for enhanced damages.} The patent owner has the ability to protect his patent by simply spending thirty-seven cents in postage to send a form letter to any

\footnote{\textit{Id. at 339–40.} \textit{Id. at 339.} \textit{The precedent for imposing an affirmative duty begins with Coleman, in which the court stated in dicta that the defendant did not act with due care. Coleman Co. v. Holly Mfg. Co., 269 F.2d 660, 666 (9th Cir. 1959). The court in Milgo picked up on this language and relied on it in holding that the defendant had "an affirmative duty to exercise due care to determine whether it was infringing [plaintiff's] patents." Milgo Elecs. Corp. v. United Bus. Communications, Inc., 623 F.2d 645, 666 (10th Cir. 1980). While establishing new precedent, the court does not justify its imposition of such a duty. See \textit{id.} at 339.} \textit{To PROMOTE INNOVATION, supra note 2, Executive Summary, at 2. The patent owner's rights must be protected so that his patent effectively excludes others, thus allowing him to reap the benefits of a limited monopoly. See \textit{id.} If the rights of patent owners to exclude others are weakened, then inventors will have less incentive to share their ideas with the public through the patent system. See \textit{id.}} \textit{Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 146 (1989). ("From their inception, the federal patent laws have embodied a careful balance between the need to promote innovation and the recognition that imitation and refinement through imitation are both necessary to invention itself and the very lifeblood of a competitive economy.").} \textit{To say so would be contrary to the overall purpose of the patent system—to benefit the public. See United States v. Masonite Corp., 316 U.S. 265, 278 (1942).} \textit{Id. ("The promotion of the progress of science and the useful arts is the 'main object': reward of inventors is secondary and merely a means to that end.").} \textit{See Powers, supra note 13, at 101. (discussing an interview with Judge Mary Pat Thyngge, in which Judge Thyngge stated that defendants do not often consider willful infringement in settlement negotiations because they see this remedy as a "windfall for the patentee").}
Placing the Burden Back Where It Belongs

This simple process sets the affirmative duty in motion. It is entirely possible for a company to receive hundreds of these allegations every year, requiring them to expend substantial time, money, and resources into investigating patents that may never be asserted.

Although the risk of harm to the patent owner is serious, it is not equally convincing that the defendant's conduct can easily be prevented or corrected. Due to the uncertainty of the current law, it is difficult for a defendant to know when he has been put on notice of the other's patent or whether his conduct fails to conform to the affirmative duty of due care. Researchers and developers are left with the decision to expend significant time and money on excessive defensive policies, investigating every single allegation in order to avoid liability, or to risk a possible finding of willful infringement in court. Although some may try to justify the affirmative duty on grounds of the serious risk to the patent owner, the excessive costs to defendants in attempting to avoid liability cuts against this rationalization.

The affirmative duty also runs contrary to notions of public policy, fairness and common sense. The correct public policy in patent law is to balance rights of a patent owner with the rights of the public to research and develop in attempt to advance our technology. The affirmative duty violates notions of public policy and fairness by

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130 See Amicus Brief Securities, supra note 67, at 5 ("In what has become colloquially known as the '37 cent notice' problem, patent holders can set in motion a very costly process for alleged infringers merely by sending a letter.").

131 Id.

132 DeMasi, supra note 5, at 2.

In addition to patents that employees of companies encounter in the course of their work, companies may receive hundreds of allegations of patent infringement annually . . . Despite a company's best efforts to identify those patents or allegations that are most credible, it is still forced to spend substantial resources in employee time and legal fees investigating patents that may never be asserted.

Id.

133 In all practicality, it is conceded that in today's competitive market patent owners face significant risks of having their patent rights infringed. Free market competition however, is essential to a thriving economy, and where research and development firms face the constant threat of infringement liability, it is necessary to have rules that more clearly define the rights of a patent owner. Because of the ambiguity of the affirmative duty research and development firms are constantly left guessing as to whether their conduct might result in liability.

134 See Taylor, supra note 21, at 735. What is necessary to put a potential infringer on notice is far from clear. Id; see also id. at 737 ("Two commentators recently suggested that the Federal Circuit has indicated an infringer can have notice of a patent merely by reading about its issuance in the OFFICIAL GAZETTE."). That notice can be found where a potential infringer reads about the issuance of a patent in a publication seems like a strained interpretation of case law. Id. The only thing that is certain is that the Federal Circuit has not clearly defined what constitutes notice. See id. It seems that the courts prefer to decide on a case-by-case basis. See id.

135 Id. at 740. The law leaves potential infringers wondering whether they have avoided notice and whether their conduct has satisfied the affirmative duty. Id. This uncertainty in turn creates economic inefficiency. Id.

136 Although we must protect the rights of patent owners, we must not do so in a way that puts an unreasonable economic burden on the public. See Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 146 (1989).

137 Id.
tipping the balance too far in favor of patent owners.\textsuperscript{138} Policy and fairness mandate that we return the parties of a patent infringement suit to an equal playing field by removing the affirmative duty.

\textit{D. What the Affirmative Duty Purports to Achieve Can Be Accomplished in Its Absence}

Although the affirmative duty accomplishes its purpose of protecting the rights of patent owners, it does so only while inflicting a serious inconvenience on information sharing.\textsuperscript{139} In addition, the duty adds too much confusion to an already complex area of law.\textsuperscript{140} To put things in perspective it may help to compare and contrast patent rights to tangible property rights.\textsuperscript{141} One of the \textit{amicus briefs} made an important observation:

A chain link fence, with \ldots posted "No Trespassing" signs along the perimeter defines precisely the metes and bounds of a parcel of real property. When the perimeter of protected rights is well defined and their validity self-evident, a duty of due care to avoid willful trespass \ldots may indeed legitimately vindicate private property interests. Patents \ldots are not surrounded by "bright line" perimeters and certain validity. Applying a "duty of due care" to such inherently uncertain, unpredictable, shifting patent property perimeters is particularly problematic.\textsuperscript{142}

A patent uses words to define an idea and identify the scope or "perimeters" of the invention that is claimed.\textsuperscript{143} It has been said that an inventor may become his

\textsuperscript{138} See \textit{TO PROMOTE INNOVATION}, supra note 2, ch. 5, at 29. Fear of liability for willfulness is discouraging inventors from reading patents, thereby undermining the purpose of the patent system. \textit{Id.} see \textit{Thronson}, supra note 62, at 2. The article discusses the FTC report which found that the willfulness doctrine has few defenders. \textit{Id.} One person reportedly said, "I simply didn't look at any patents \ldots and if anybody mentioned a patent I burned it as quickly as possible." \textit{Id.} This shows that the affirmative duty has detrimental effects on public policy. See \textit{id.}.

\textsuperscript{139} The negative effect of the affirmative duty on the distribution of information is an extremely important consideration. In discussing the importance of circulating patent information to the public, the Supreme Court has stated that "additions to the general store of knowledge are of such importance to the public weal that the Federal Government is willing to pay the high price of [20] years of exclusive use for its disclosure." \textit{Kewanee Oil Co. v. Bicron Corp.}, 416 U.S. 470, 481 (1974).

\textsuperscript{140} See \textit{Amicus Brief Securities}, supra note 67, at 5 ("As the uncertainty increases, it becomes more difficult — and more costly — for a company to evaluate whether it has a good-faith basis to practice a claimed technology.").

\textsuperscript{141} Although some similarities may exist between tangible property rights and intellectual property rights, it is the distinctions between them that are important and that warrant a different treatment with respect to policies involving exemplary damages.

\textsuperscript{142} See \textit{Amicus Brief Biotech}, supra note 67, at 12.

\textsuperscript{143} \textit{35 U.S.C. § 112} (2000). The specification of a patent contains both a written description of the invention and one or more claims describing the scope of the subject matter being claimed as the invention. \textit{Id.} The written description consists of the "enablement" and "best mode." \textit{Id.} The enablement refers to the terms which would describe the invention in a way to allow a person having ordinary skill in the art to make and use the invention, whereas the best mode describes the best way of carrying out the invention. \textit{Id.} In patent infringement suits, the claims are the most
Placing the Burden Back Where It Belongs

There is an inherent difficulty and uncertainty associated with using words, which depend greatly upon interpretation, to describe a completely new idea. An alleged infringer should not be punished for his incorrect "interpretation" of the words that define the "perimeters" of another's patent. A duty of care cannot work effectively where an actor is uncertain whether his conduct is violating the rights of another.

There are various threats facing an alleged patent infringer designed to protect a patent owner. In fact, it has been suggested that the threat of willful infringement provides superfluous protection to the rights of the patent owner. An accusation of infringement is often aimed at the heart of a company's technology. Perhaps the most serious threat is the possibility of injunctive relief, which would require a party to shut down their infringing activity. Where a company has devoted significant time, money and resources into the development, production and sale of a particular product, an injunction requiring them to cease that activity could deal a serious economic blow to the company. This powerful deterrent has been described as the "hammer" relied on by patent owners in settlement negotiations to compel alleged infringers to purchase a license. Although removal of the affirmative duty may reduce the threat of willful infringement, the lingering threat of permanent injunction will continue to deter infringing activity.

Furthermore, because a finding of willful infringement requires consideration of the "totality of the circumstances," elimination of the affirmative duty only removes relevant because they define "the subject matter which the [patent owner] regards as his invention."
one factor from the determination.\textsuperscript{152} It can be argued that, in cases that developed the affirmative duty, the purposeful and deliberate copying of another’s patent is so apparent that consideration of the infringer’s adherence to a duty is unnecessary to find liability.\textsuperscript{153} For instance, purposeful copying was apparent in \textit{Coleman Co. v. Holly Mfg. Co.}, which was the first case to mention a duty of care.\textsuperscript{154} In this case, Coleman continued sales of an infringing product after the issuance of a previous court ordered injunction.\textsuperscript{155} Coleman added a useless part to its infringing product in attempt to disguise its obvious willful conduct.\textsuperscript{156} Although the court stated that Coleman failed to act with due care, this was an unnecessary understatement because the evidence of purposeful infringement was readily apparent.\textsuperscript{157} In addition, \textit{General Electric Co. v. Skiaky Bros., Inc.} implied the existence of an affirmative duty.\textsuperscript{158} According to the trial court, the evidence demonstrated that General Electric had pirated Skiaky’s patents once it realized it could not develop a superior product.\textsuperscript{159} Moreover, in \textit{Milgo}, the case officially establishing the affirmative duty, the trial court found evidence that the patent had been “faithfully copied” and that the infringement was not “merely accidental or negligent.”\textsuperscript{160}

It is apparent from these decisions that evidence from the patent owner tending to show malicious, purposeful, or deliberate copying or pirating of another’s patent should be sufficient to establish willful liability. In fact, recent case law has established that behavior such as purposeful copying, concealment of infringement, or infringement intended to injure a competitor is sufficient for a finding of willful infringement.\textsuperscript{161} Evidence of purposeful and deliberate conduct was clear in the cases discussed above, and therefore the use of the affirmative duty was unnecessary for a determination of willful infringement. Because the affirmative duty is unnecessary and excessive in deterring infringement and it adds too much confusion to the complexity of patent law, it accordingly should be eliminated.

### III. Proposal

There are various ways to go about solving the problems with the current law of willfulness doctrine. For instance, one of the amicus briefs in \textit{Knorr-Bremse} advocated for a less strict application of the affirmative duty.\textsuperscript{162} The amicus brief by

\textsuperscript{152} \textit{See} Read Corp. v. Portec, Inc., 970 F.2d 816, 827 (Fed. Cir. 1992) (The second factor, although not explicitly referring to the “affirmative duty,” describes the alleged infringer’s duty to form a good-faith belief that his conduct did not constitute infringement.).

\textsuperscript{153} \textit{See} Powers, \textit{supra} note 13, at 76 (suggesting that the affirmative duty “grew out of cases where the trial court found that the defendant had intentionally copied the patented technology”).

\textsuperscript{154} Coleman Co. v. Holly Mfg. Co., 269 F.2d 660, 666 (9th Cir. 1969).

\textsuperscript{155} \textit{Id.} at 661–63.

\textsuperscript{156} \textit{Id.} at 665.

\textsuperscript{157} \textit{Id.} at 666 (The court found that the defendant had “faithfully copied” the device, and that such copying revealed an intentional disregard of the patentee’s rights.).


\textsuperscript{159} \textit{Id.} at 1072.

\textsuperscript{160} Milgo Elecs. Corp. v. United Bus. Communications, Inc., 623 F.2d 645, 666 (10th Cir. 1980).


\textsuperscript{162} \textit{See} Amicus Brief Public, \textit{supra} note 68, at 1.
Public Knowledge requested that the application of the duty to act with due care depend on the quality of actual notice received by the alleged infringer.\textsuperscript{163} Another solution is to require additional evidence to substantiate bad-faith intent to infringe.\textsuperscript{164} Although these options would alleviate some of the burden on research and development, such solutions ignore the fact that the affirmative duty, causes too much uncertainty and confusion, is inconsistent with common law principles and gives patent owners the upper hand in patent litigation. Accordingly, the most effective solution to the problem is elimination of the affirmative duty.

Along with being burdensome and inconsistent with the law, the affirmative duty is also unnecessary and excessive in achieving what it purports to accomplish. The affirmative duty is the hair-pin trigger on willful infringement analysis in court.\textsuperscript{165} When this lethal weapon is pointed at the alleged infringer, the affirmative duty makes the threat of willful liability all the more serious. This added threat, however, is unnecessary to enforce the rights of patent owners because willful liability depends on other considerations within the "totality of the circumstances."\textsuperscript{166} Removal of the affirmative duty will not change the threat of willful infringement, but taking out this hair-pin trigger will eliminate the unpredictability of punishment.\textsuperscript{167} Furthermore, it is understood that a permanent injunction forcing the infringer to cease and desist its infringing activity is the most serious threat in patent infringement cases.\textsuperscript{168} The threats involved in patent infringement litigation are sufficient enough to deter purposeful and deliberate infringement of another's inventions.\textsuperscript{169} It is unjust to punish an individual for his good-faith interpretation of another's patent, especially when there are sufficiently available means for punishing only those who act knowingly and maliciously.\textsuperscript{170}

\textsuperscript{163} Id.
\textsuperscript{164} See Taylor, supra note 21, at 741 (proposing to amend the second paragraph of section 284 to give the court authority to enhance damages only after finding "clear and convincing evidence of willful infringement" as well as "literal infringement").
\textsuperscript{165} Although it is often claimed that the duty of care is one factor to be considered in the willful infringement analysis, a look at the jury instruction tends to demonstrate just how easily a failure to act with due care can result in a jury finding of willful infringement. See, e.g., Hoechst Celanese Corp. v. BP Chemicals, 78 F.3d 1575, 1583 (Fed. Cir. 1996). The following instruction was read to the jury in Hoechst v. BP Chems: "You may find that BP and Sterling willfully infringed the '806 patent if you find, by clear and convincing evidence, that BP and Sterling failed to exercise due care to determine whether or not they were infringing the patent, after they had actual notice of the patent." Id. This instruction gives to the jury everything they need to make a finding of willful infringement with nothing more than a conclusion that the alleged infringer failed to act with care. Id.
\textsuperscript{166} See supra note 45 and accompanying text.
\textsuperscript{167} Unpredictability of whether or not damages will be trebled is what makes designing around patents such a dangerous endeavor. If the law were more certain, inventors would not have to worry that their good-faith conduct in attempting to improve upon existing patents might result in liability for willful infringement.
\textsuperscript{168} See supra note 151 and accompanying text.
\textsuperscript{169} See supra note 151 and accompanying text.
\textsuperscript{170} In many of the cases applying the affirmative duty, there was already sufficient evidence of purposeful or deliberate copying. See, e.g., L.A. Gear, Inc. v. Thom Mcan Shoe Co., 988 F.2d 1117, 1126–27 (Fed. Cir. 1993). In this case, the alleged infringer actually admitted to deliberately copying the patent. Id. In holding that the defendant willfully infringed, the court stated that "the law imposes an affirmative duty of due care to avoid infringement of the known patent rights of
Accordingly, elimination of the affirmative duty is the only solution that will effectively remove the undue burdens on society while curing the inconsistencies in the law. With removal of the affirmative duty, the burden of proof for establishing willful conduct will shift back to the patent owner, who will once again be required to prove that the defendant purposefully and deliberately infringed his patent rights. Inventors will be able to go about designing around patents without fear of excessive liability. Inventors will still proceed with respect for the rights of patent owners, knowing that they will be punished for any purposeful infringements. Patent owners can rest assured that, while enhanced damages might not be as readily available for every infringement, they will remain accessible for situations in which the alleged infringer's conduct is proved to be reprehensible. Certainty will return to the law of patent infringement, allowing companies to proceed based on the good-faith assertions of their in-house patent counsel and to cut back on some of their excessive costly defensive policies.

IV. CONCLUSION

The patent system contemplates that an inventor should be rewarded for his contribution of a new and useful idea to society. As a reward, the inventor is given a limited monopoly which allows him to exclude others from his intellectual property for a period of twenty years. In order to encourage inventors to disclose their ideas to the public, it is important to vigorously enforce the rights of patent owners. It is imperative, however, that while enforcing the rights of patent owners we also consider the interests of society in the continual advancement and development of technology. While affording patent owners diminutive protection will discourage public disclosure of inventions, affording them excessive protection will discourage inventors from building upon existing patents, which will result in the suppression of innovation.
It is apparent that, for the past twenty years, the Federal Circuit has provided excessive protection to patent owners. The crucial balance of the rights of patent owners and the interests of the public has been thrown askew with the introduction of the affirmative duty in patent law. The Federal Circuit has shown its willingness to reset the balance with its decision in Knorr-Bremse to eliminate the adverse inference rule. The law continues to favor patent owners, however, and the removal of the adverse inference rule did not greatly rectify this situation. The problems with the affirmative duty are clear. Therefore, in order to return harmony to the essential balance between respect for the rights of the patent owner and the necessity for the public to design around existing patents, it is most beneficial to view the affirmative duty as “a relic of the past and eliminate it as a factor in the willfulness and enhancement analysis.”

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176 See Powers, supra note 13, at 55 (“In the past twenty years... courts have extended the reach of the treble damages provision to permit an award of increased damages against infringers who independently developed their own technology.”).

177 See Knorr-Bremse, 383 F.3d at 1344.

178 What the removal of the adverse inference rule did effectively accomplish was that it returned the sanctity to the attorney-client privilege. Since, the Federal Circuit in Knorr-Bremse, however, did not provide any insight as to what conduct will suffice to meet the duty of care in the absence of an opinion of counsel, the uncertainty in the law will continue to adversely affect technological advancement. See Stephen C. Durant & Gene H. Yee, An Analysis of Knorr-Bremse, THE INTELL. PROP. STRATEGIST, Nov. 11, 2004, at 3 (“[U]ntil the Federal Circuit provides guidance as to what conduct will suffice to meet the duty of due care in the absence of opinion of counsel, there will be uncertainty as to what actions ultimately will be held sufficient to discharge that duty.”).

179 In his dissent in Knorr-Bremse, Judge Dyk finished his argument by stating, “I would recognize that the due care requirement is a relic of the past and eliminate it as a factor in the willfulness and enhancement analysis.” Knorr-Bremse, 383 F.3d at 1352 (Dyk, J., concurring in part and dissenting in part). Judge Dyk is correct because he realizes that the affirmative duty tilts the scales in favor of the patent owner, and lays too heavy a burden on alleged infringers. See id. at 1349.