WINSTON & STRAWN LLP

CLIENT ALERT

In Response to Willfulness, Alleged Infringer's Decision Makers and Counsel Can Testify Regarding State of Mind and Basis for Non-Infringement and Invalidity Conclusions

APRIL 9, 2019

Omega Patents, LLC v. Calamp Corp., No. 2018-1309 (Fed. Cir. Apr. 8, 2019)
The patentee alleged infringement and willfulness. On appeal, the Federal Circuit resolved several issues related to validity, infringement, damages, and willfulness. With regard to willfulness, the alleged infringer appealed several evidentiary rulings. First, the district court had restricted the testimony of a business person tasked with investing the patentee's patents as not relevant and hearsay. Second, the district court restricted the alleged infringer's counsel from explaining the basis of his opinions as to non-infringement and invalidity. The Federal Circuit explained that on remand, the testimony should be allowed.

Evidence relevant to an alleged infringer's state of mind at the time of the infringement is relevant to willfulness. Accordingly, the alleged infringer's business person, who had responsibility for investigating the patents, should be allowed to testify regarding his investigation of the patent and his conclusions about the patent. Such testimony would not be hearsay because it was not offered for the truth of the matter asserted.

Further, an opinion of counsel is relevant to the alleged infringer's state of mind and to disputing a claim of willfulness. An alleged infringer's counsel should be permitted to testify to the conclusions and a reasonable explanation of the conclusions. These opinions and reasonable explanation should be permitted even though there is a possibility that the jury could confuse the issues of liability and willfulness.
A copy of the opinion can be found here

1 Min Read

Author

David Enzminger

Related Locations

Charlotte | Chicago | Los Angeles | Silicon Valley

Related Topics

Invalidity | Infringement | Damages | Willfulness

Related Capabilities

Intellectual Property | Patent Litigation

Related Regions

North America

Related Professionals

David Enzminger

Ivan Poullaos

Mike Rueckheim

Danielle Williams