

Outline of Materials on Willful Infringement Issues

**by John B. Pegram
Fish & Richardson P.C.**

Leading Cases:

Swofford v. B&W, Inc., 336 F.2d 406 (5th Cir. 1964) (Holding that willfulness findings are to be made by the judge and that such findings should be deferred).

Underwater Devices, Inc. v. Morrison-Knudsen Co., 717 F.2d 1380 (Fed. Cir. 1983) (Establishing a duty of due care to avoid infringement, including a duty to obtain competent legal advice before initiating possibly infringing activity).

Richardson v. Suzuki Motor Co., 868 F.2d 1226 (Fed. Cir. 1989). (Holding that willfulness findings are to be made by a jury).

Quantum Corp. v. Tandon Corp., 940 F.2d 643 (Fed. Cir. 1991) (Recommending that bifurcation of willfulness be considered in every case).

Knorr-Bremse Systems fuer Nutzfahrzeuge GmbH v. Dana Corp., 383 F.3d 1337 (Fed. Cir. 2004) (*en banc*) (No adverse inference should be drawn from a defendant's claim of privilege).

In re Echostar Communications Corp., 448 F.3d 1294 (Fed. Cir. 2006) (Defining the scope of waiver of privilege as including all communications relating to the same subject).

In re Seagate Technology LLC, 497 F.3d 1360 (Fed. Cir. 2007) (*en banc*) (Overruling the *Underwater Devices* duty of due care and establishing a new, two step standard for proof of willful infringement).

Articles:

Mueller, Janice M., *Commentary: Willful Patent Infringement and the Federal Circuit's Pending En Banc Decision in Knorr-Bremse v. Dana Corp.*, 3 John Marshall Rev. I.P. Law 218 (2004).

John B. Pegram, *The Willful Infringement Dilemma and the 7th Amendment*, 86 JPTOS 271 (2004).

John B. Pegram, *Preserving Privilege in the Face of a Willful Infringement Charge*, 73 JPTOS 286 (1991).