

COMMIL v. CISCO:
**IMPLICATIONS OF THE INTENT STANDARD FOR
INDUCEMENT LIABILITY ON WILLFULNESS**

Nate Ngerebara[†]

Inducement liability enables patent holders to forestall infringement of their rights when it is either impractical or contrary to public policy to enforce a claim against direct infringers, or when the inducer is more morally culpable than the direct infringers.¹ In other instances, it might be a public relations nightmare for the patentee to sue the direct infringers.² The text of 35 U.S.C. § 271(b), specifically the phrase “whoever actively induces,” has been interpreted to require a scienter analysis.³ In its most recent addition to patent law jurisprudence, the Supreme Court contributed to a line of cases that have focused the issue of inducement liability primarily on the intent of the inducer.⁴

DOI: <http://dx.doi.org/10.15779/Z38MS0Z>

© 2016 Nate Ngerebara.

[†] J.D. Candidate, 2017, University of California, Berkeley, School of Law.

1. Mark A. Lemley, *Inducing Patent Infringement*, 39 U.C. DAVIS L. REV. 225, 228 (2005) (“The goal of secondary liability is to give patent owners effective protection in circumstances in which the actual infringer either is not the truly responsible party or is impractical to sue.”); *see also* Brief for Amicus Curiae Abbvie Inc. in Support of Petitioner at 8, *Commil USA, LLC. v. Cisco Sys. Inc.*, 135 S. Ct. 1920 (2015) (No. 13-896) (discussing the policy hindrances to enforcing patents against direct infringers); Michael N. Rader, *Toward a Coherent Law of Inducement to Infringe: Why the Federal Circuit Should Adopt the Hewlett-Packard Standard for Intent Under §271(b)*, 10 FED. CIR. BAR J. 299, 300 (2000) (“It is often infeasible to sue the individual infringers in such situations, and in any case, the culpable party may well be the company encouraging or facilitating the infringing conduct.”).

2. Rader, *supra* note 1, at 306 (“[S]uing the direct infringers may constitute a bad business judgment. The direct infringers are likely to be customers of the patentee in the affected market and/or other related markets, and the patentee suing its own customers would likely have a detrimental effect on public relations.”).

3. 35 U.S.C. § 271(b) (2006) (“Whoever actively induces infringement of a patent shall be liable as an infringer.”).

4. W. Keith Robinson, *Only a Pawn in the Game: Rethinking Induced Patent Infringement*, SANTA CLARA COMPUTER & HIGH TECH. L.J. (forthcoming) (manuscript at 6), <http://ssrn.com/abstract=2630811> [<https://perma.cc/VW43-HFNL>] (“First, the Supreme Court clarified that liability for induced infringement requires proof that the defendant knew her induced acts infringed the asserted patent.”).

Unlike direct infringement, which is a strict liability offense, third-party liability (through inducement or contributory infringement) requires both knowledge and intent.⁵ Specifically, inducement requires one party actively encouraging or aiding another to infringe a patent.⁶ Following the codification of 35 U.S.C. § 271, courts struggled for over fifty years to clearly define the knowledge and intent requirements for liability under § 271(b), which provides a cause of action for induced infringement, and § 271(c), which addresses contributory infringement.⁷ Resolving its “conflicting precedent” on the scienter for inducement, the Federal Circuit in *DSU Medical Corp. v. JMS Co.* construed “actively induces” as requiring a showing of both the defendant’s knowledge that his actions would induce actual infringement and a specific intent to cause direct infringement.⁸ Subsequent cases sought to delineate the precise knowledge and the level of intent necessary for liability.⁹

Recently, in *Commil USA, LLC v. Cisco Systems, Inc.*, the Supreme Court affirmed its holding in *Global-Tech Appliances, Inc. v. SEB S.A.*, where it held that inducement liability required “actual knowledge” (or willful blindness to the fact) that the induced acts constitute patent infringement.¹⁰

5. See *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060, 2065 n.2 (2011) (asserting that direct infringement requires “no more than unauthorized use,” such that the “direct infringer’s knowledge or intent is irrelevant”).

6. 35 U.S.C. § 271(b) (2006).

7. See generally Lemley, *supra* note 1, at 228–41 (describing the scope of inducement in various cases).

8. *DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293, 1304, 1306 (Fed. Cir. 2006) (referring to the seemingly contradictory standards the Federal Circuit articulated in *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464 (Fed. Cir. 1990), and its panel decision in *Manville Sales Corp. v. Paramount Systems, Inc.*, 917 F.2d 544 (Fed. Cir. 1990), and stating that “[i]nducement requires evidence of culpable conduct, directed to encouraging another’s infringement, not merely that the inducer had knowledge of the direct infringer’s activities” and that “[t]he requirement that the alleged infringer knew or should have known his actions would induce actual infringement necessarily includes the requirement that he or she knew of the patent”).

9. See also *SEB S.A. v. Montgomery Ward & Co.*, 594 F.3d 1360, 1376 (Fed. Cir. 2010), *aff’d sub nom.* *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060 (2011) (stating that “the court resolved conflicting case law setting forth both a requirement to knowingly induce infringement and to merely knowingly induce the acts that constitute direct infringement”); see also *Global-Tech*, 131 S. Ct. at 2068 (“This question closely divided the *Aro II* Court”); Eric L. Lane, *The Federal Circuit’s Inducement Conflict Resolution: The Flawed Foundation and Ignored Implications of DSU Medical*, 6 J. MARSHALL REV. INTELL. PROP. L. 198 (2007).

10. See *Commil USA, LLC v. Cisco Sys. Inc.*, 135 S. Ct. 1920, 1926 (2015) (rejecting Commil’s and the government’s reading of *Global-Tech* as requiring only knowledge of the patent for induced infringement; the Court stated that such a reading “would contravene *Global-Tech*’s explicit holding that liability for induced infringement can

Prior Federal Circuit case law had established that a good-faith belief regarding the non-infringing nature of the defendant's activities was relevant in assessing intent and subsequent liability.¹¹ However, noting that it saw “no principled distinction between a good-faith belief of invalidity and a good-faith belief of non-infringement,” the Federal Circuit in *Commil* expanded on the intent requirement, holding that evidence of a subjective, good-faith belief in the invalidity of the infringed patent could be a defense against induced infringement.¹² The Supreme Court disagreed, instead holding that a belief in the invalidity of a patent was not a defense to induced infringement.¹³

The *Commil* decision suggests that a belief in the invalidity of a patent, no matter how well reasoned, may not prevent a finding that direct infringement was willful.¹⁴ Courts use the willfulness standard to decide when patent infringement (direct or indirect) is egregious enough to merit imposition of treble damages under 35 U.S.C. § 284.¹⁵ Unlike direct infringement, which has no scienter requirement, inducement liability and

only attach if the defendant knew of the patent and knew as well that the induced acts constitute patent infringement”) (internal quotes omitted); *Global-Tech*, 131 S. Ct. at 2068–69 (“The traditional rationale for this doctrine is that defendants who behave in this manner are just as culpable as those who have actual knowledge.”).

11. See *DSU Med. Corp.*, 471 F.3d at 1307 (finding a belief of non-infringement sufficient to support a verdict that the defendant did not induce infringement: “To the contrary, the record contains evidence that ITL did not believe its Platypus infringed. Therefore, it had no intent to infringe.”); *Ecolab Inc. v. FMC Corp.*, 569 F.3d 1335, 1351 (Fed. Cir. 2009) (finding that a reasonable belief of non-infringement supported a jury’s verdict that the defendant lacked the intent required for inducement); *Kinetic Concepts, Inc. v. Blue Sky Med. Grp., Inc.*, 554 F.3d 1010, 1025 (Fed. Cir. 2009) (holding that defendant’s belief supported a jury finding that the necessary intent was lacking); *Bettcher Indus., Inc. v. Bunzl USA, Inc.*, 661 F.3d 629, 648–49 (Fed. Cir. 2011) (finding that opinion of counsel regarding non-infringement was admissible to show the defendant’s state of mind regarding the intent to induce infringement).

12. See *Commil USA, LLC v. Cisco Sys. Inc.*, 720 F.3d 1361, 1364, 1368 (Fed. Cir. 2013), *vacated*, 135 S. Ct. 1920 (2015).

13. See *Commil*, 135 S. Ct. at 1928–29 (2015).

14. See Jason Schwent, *Has the Supreme Court Signaled the End of Invalidity Opinion Letters?* THOMPSON COBURN LLP BLOG (Jun. 24, 2015), <http://www.thompsoncoburn.com/news-and-information/patent-billy-goat-blog/blog/15-06-24/has-the-supreme-court-signal-the-end-of-invalidity-opinion-letters.aspx> [https://perma.cc/UA3L-8KCS] (“In its *Commil* decision, the [J]ustices seemed to suggest that a belief as to the invalidity of a patent—no matter how well reasoned or firmly grounded—may also not prevent a finding that direct infringement was willful.”).

15. 35 U.S.C. § 284 (2009).

willfulness both have similar knowledge and intent requirements.¹⁶ Because it eradicates the good-faith belief in invalidity as a defense against induced infringement, *Commil* is in tension with the willfulness standard set in *In re Seagate Technology, LLC*.¹⁷ Under the current structure, the willfulness inquiry considers, in part, the defendant's knowledge that it proceeded "despite an objectively high likelihood that its actions constituted infringement of a valid patent."¹⁸ The inclusion of "valid" in the inquiry suggests that a good-faith belief of invalidity should remain a defense to willfulness.¹⁹ It is unclear, however, whether this standard might be held to conflict with *Commil's* distinction between validity and infringement for inducement liability.²⁰

This Note explores the impact of the *Commil* holding on willful infringement, and concludes that *Commil* further mandates a reexamination of the standard for willful infringement.²¹ Part I examines the evolution of inducement liability, specifically addressing the knowledge and intent required under § 271(b). Part II discusses the development of the standard for willful infringement. It also addresses the impact of the willfulness jurisprudence on litigation strategies and opinions of counsel. Part III summarizes the *Commil* decision, and Part IV examines the implications of the decision on the willfulness standard as well as on opinions of counsel—a once useful tool for avoiding liability.

16. See Jason A. Rantanen, *An Objective View of Fault in Patent Infringement*, 60 AM. U. L. REV. 1575, 1632 (2011) (noting that contributory infringement and inducement of infringement necessarily lead to findings of willful infringement).

17. *In re Seagate Tech., LLC*, 497 F.3d 1360, 1368, 1370–72 (Fed. Cir. 2007) (en banc).

18. See *id.* at 1371.

19. KIRK SIGMON ET. AL., MORRISON & FOERSTER, SUPREME COURT REJECTS BELIEF OF INVALIDITY DEFENSE FOR INDUCEMENT IN *COMMIL V. CISCO* (2015), <http://www.mofo.com/~media/Files/ClientAlert/2015/05/150526CommilvCisco.pdf> [<https://perma.cc/A9S6-UQ86>].

20. *Id.*

21. The Supreme Court recently granted certiorari to hear two cases on the issue of willfulness under § 284: *Stryker Corp. v. Zimmer Inc.*, 2015 U.S. LEXIS 6727 (U.S. Oct. 19, 2015) and *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 2015 U.S. LEXIS 6634 (U.S. Oct. 19, 2015). The consolidated cases challenge the appropriateness and rigidity of the Federal Circuit's two-prong *Seagate* test in light of the Supreme Court's decision in *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 134 S. Ct. 1749, 1756–57 (2014).

I. INDUCEMENT LIABILITY

Commil eliminated a defendant's good-faith belief in the invalidity of a patent as a defense to inducement liability.²² Hence, for inducement liability, a plaintiff must show that the defendant had the intent to cause inducement, or that the defendant had knowledge of (or was willfully blind to) the existence of the patent, and also knew that the induced acts constituted patent infringement.²³ However, contrary to the Federal Circuit's case law, the defendant may not negate the intent requirement by claiming a good-faith belief that the patent was invalid.²⁴

Patent infringement occurs when "without authority [one] makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent."²⁵ Direct infringement requires that a party perform "all the acts necessary to infringe the patent, either personally or vicariously."²⁶ The Patent Act also provides for secondary liability for those who do not directly practice the invention, but contribute to the infringement or induce others to infringe.²⁷ This secondary liability aims to give patentees effective protection in circumstances where the direct infringer is not the truly responsible party, or where it is impossible or inefficient to sue the direct infringers.²⁸

22. *Commil USA, LLC v. Cisco Sys. Inc.*, 135 S. Ct. 1920, 1931 (2015).

23. *See* *DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293, 1306 (Fed. Cir. 2006) (noting that "inducement requires 'that the alleged infringer knowingly induced infringement and possessed specific intent to encourage another's infringement'" (citation omitted)). The modern understanding of intent is comprised of two elements: knowledge and purpose, so whereas the following discussion delineates "intent" and "knowledge" as different elements, knowledge is often subsumed in the intent element. *See* Jason A. Rantanen, *An Objective View of Fault in Patent Infringement*, 60 AM. U. L. REV. 1575, 1578–79 (2011) ("Global-Tech concluded that inducement requires knowledge of infringement, a holding that it necessarily tempered with the invocation of the problematic concept of 'willful blindness'"); *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060 (2011), *aff'g* *SEB S.A. v. Montgomery Ward & Co.*, 594 F.3d 1360, 1376 (Fed. Cir. 2010).

24. *See Commil*, 135 S. Ct. at 1931.

25. 35 U.S.C. § 271(a) (2006).

26. *Akamai Techs., Inc. v. Limelight Networks, Inc.*, 692 F.3d 1301, 1307 (Fed. Cir. 2012) (*per curiam*) (stating that direct infringement occurs when the accused device or process meets each and every claim of the existing patent), *rev'd* on other grounds.

27. *See* 35 U.S.C. §§ 271(b), (c) (2006).

28. Lemley, *supra* note 1, at 228 ("The goal of secondary liability is to give patent owners effective protection in circumstances in which the actual infringer either is not the truly responsible party or is impractical to sue."); *see also* Charles W. Adams, *A Brief History of Indirect Liability for Patent Infringement*, 22 SANTA CLARA COMPUTER & HIGH TECH. L.J. 369, 386 (2006) (stating that contributory infringement was applied to enjoin those

Under the case law before the passage of the Patent Act in 1952, courts considered inducement only as evidence supporting the requisite intent in a case of contributory infringement.²⁹ In the 1952 Patent Act, Congress drew a distinction between the theories of third party liability, separating them into two categories: induced infringement, codified by § 271(b), and contributory infringement, codified by § 271(c).³⁰ Both sections of the statute contain ambiguities as to the requisite levels of knowledge and intent for liability.³¹

Section 271(b) provides that “[w]hoever actively induces infringement of a patent shall be liable as an infringer.”³² Unlike direct infringement, a strict liability offense,³³ inducement liability requires that the patent holder “establish fault on the part of the accused.”³⁴ Courts have interpreted the phrase “actively induces” as used in § 271(b) to add an intent requirement to inducement liability.³⁵ Despite its seemingly straightforward language, the statute raised questions about the scope of liability and the required intent or level of knowledge needed to “actively” induce infringement.³⁶ In *DSU Medical Corp. v. JMS Co.*, the Federal Circuit established that inducement liability required that an alleged infringer “knowingly” and with “specific intent” induce another’s infringement.³⁷ Though the Federal Circuit seemingly settled the mental state requirement, the certainty was short-lived.³⁸ The Supreme Court modified this standard in *Global-Tech* by

who sought to cause infringement by supplying someone else with the means and directions for infringing a patent).

29. Lemley, *supra* note 1, at 227 (“Thus, the earliest cases focusing on efforts to induce infringement did not treat it as a separate offense, but rather as evidence supporting the requisite affirmative intent for a case of contributory infringement.”).

30. See generally *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060, 2067 (2011); Adams, *supra* note 28, at 370.

31. Kristin M. Hagen, *Eyes Wide Shut: Induced Patent Infringement and the Willful Blindness Standard*, 17 MARQ. INTELL. PROP. L. REV. 305, 306–07 (2013).

32. 35 U.S.C. § 271(b) (2012).

33. See *Blair v. Westinghouse Elec. Corp.*, 291 F. Supp. 664, 670 (D.D.C. 1968).

34. Rantanen, *supra* note 23, at 1578.

35. See, e.g., *Global-Tech.*, 131 S. Ct. at 2064–65.

36. See Lemley, *supra* note 1, at 23; see also Rantanen, *supra* note 23, at 1578 n.8, 1590 (pointing out that “[t]he common theme of these [scienter] standards is that they all involve an investigation into whether the accused party either intended to infringe the patent or subjectively knew that the conduct infringed”).

37. *DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293, 1306 (Fed. Cir. 2006) (noting that “the alleged infringer knowingly induced infringement and possessed specific intent to encourage another’s infringement”).

38. Rantanen, *supra* note 23, at 1578 (“[T]he Federal Circuit, citing en banc, recently articulated the fault element for inducement as requiring that ‘the patentee must show . . .

adding a two-part knowledge requirement for inducement liability.³⁹ As discussed in the two Sections, *infra*, this test entails both an inquiry into the knowledge (or willful blindness) of the patent's existence, and an inquiry into the intent of the inducer.⁴⁰

A. THE KNOWLEDGE (WILLFUL BLINDNESS) INQUIRY UNDER
GLOBAL-TECH

To establish indirect patent infringement liability, like other secondary liability tort claims, a plaintiff must prove (1) the underlying tort—direct infringement, (2) the defendant's knowledge of the underlying tort, and (3) the provision of assistance to advance the tort's commission.⁴¹ In *Global-Tech*, the Supreme Court held that liability for induced infringement attaches only if the defendant knew of the patent and also knew that “the induced acts constitute patent infringement.”⁴²

Global-Tech involved Pentalpha, a Hong Kong based subsidiary of the defendant that purchased and copied all but the cosmetic features of a competitor's deep fryer.⁴³ Before copying the design, Pentalpha had conducted market research and was aware of the commercial success of SEB's fryers.⁴⁴ The company also knew that the success was due to the “advanced technology” embodied in the fryers.⁴⁵ Pentalpha hired an attorney to conduct a right-to-use study, without disclosing to the opinion counsel that its fryer design was copied.⁴⁶ Upon conducting a search, the opinion counsel concluded that the defendant was not infringing any known patents.⁴⁷ Pentalpha proceeded to sell its fryers, which were then resold in the United States.⁴⁸ Furthermore, Pentalpha's CEO, a named inventor on U.S. patents, knew that products made for overseas markets did not bear

that the alleged infringer *knowingly* induced infringement and possessed *specific intent* to encourage another's infringement.”).

39. See *Global-Tech*, 131 S. Ct. at 2064–65.

40. *Id.*

41. See, e.g., Dmitry Karshedt, *Damages for Indirect Patent Infringement*, 91 WASH. U. L. REV. 911, 925 (2014).

42. *Global-Tech*, 131 S. Ct. at 2068 (“[W]e now hold that induced infringement under § 271(b) requires knowledge that the induced acts constitute patent infringement.”).

43. *Id.* at 2064.

44. *Id.* at 2071.

45. *Id.*

46. *Id.* at 2064.

47. *Id.*

48. *Id.*

U.S. patent markings, and failed to disclose the copying of the Hong Kong model of the SEB fryer to opinion counsel.⁴⁹

Given the lack of direct evidence of the defendant's actual knowledge of the patent, the Supreme Court adopted the criminal law doctrine of willful blindness to affirm the lower court's finding of liability.⁵⁰ The Court explained that to be willfully blind, an accused infringer must: (1) have a subjective belief that there is a high probability that a fact exists and (2) take deliberate actions to avoid learning of that fact.⁵¹ Given the defendant's research and awareness of the success of the advanced technology in the fryers it copied, the fact that its CEO knew that products for overseas markets did not bear U.S. patent markings, and the failure to disclose the copying to opinion counsel, the Court concluded that Pentalpha had a subjective belief of a high probability that its activity constituted patent infringement.⁵² The Court also concluded that Pentalpha took deliberate steps to avoid confirming its knowledge, thereby willfully blinding itself to the infringing nature of the sale of its fryers in the United States.⁵³ The Federal Circuit had reasoned that the required knowledge threshold was something more than "should have known," but less than actual knowledge.⁵⁴ The Supreme Court disagreed. Rejecting the Federal Circuit's "deliberate indifference" standard, the Court explained that "[the standard] permits a finding of knowledge when there is merely a 'known risk' that the induced acts are infringing."⁵⁵

Under the willful blindness doctrine, a defendant cannot shield himself from laws requiring knowledge or intent by ignoring key facts that should be abundantly clear from the given circumstances.⁵⁶ Willful blindness, according to the Court, is appropriately limited and surpasses both recklessness and negligence.⁵⁷ A willfully blind defendant takes "deliberate actions to avoid confirming a high probability of wrongdoing," and can be said to actually know of "critical facts."⁵⁸ In contrast, recklessness requires that a defendant know and consciously disregard "a substantial and

49. *Id.* at 2071.

50. *Id.* at 2070–71.

51. *Id.*

52. *Id.* at 2072.

53. *Id.*

54. *SEB S.A. v. Montgomery Ward & Co.*, 594 F.3d 1360, 1376–77 (Fed. Cir. 2010).

55. *Global-Tech*, 131 S. Ct. at 2071.

56. See Jonathan A. Choa, *Commil v. Cisco Systems: The End of Induced Infringement?*, 27 *INTELL. PROP. LITIG.* 35, 37 (2015).

57. *Global-Tech*, 131 S. Ct. at 2070–71.

58. *Id.* at 2068–71 (explaining willful blindness).

unjustified risk” of wrongdoing.⁵⁹ A negligent defendant is one who should have known of a similar risk, but did not.⁶⁰ Notably, the Court in *Global-Tech* applied willful blindness only in the context of knowledge of the patent-in-suit.⁶¹ However, lower courts have subsequently applied the doctrine to “both knowledge elements” for inducement.⁶² Although the Court in *Commil* did not expressly discuss the willful blindness doctrine, it reiterated *Global-Tech*’s holding regarding the knowledge necessary for inducement.⁶³

Relying on guidance from the Supreme Court on inducement in a copyright case, the Federal Circuit addressed the intent prong of inducement liability for patent infringement.

B. THE INTENT REQUIREMENT FOR INDUCEMENT

The Supreme Court’s first substantive discussion of the required intent for “active inducement” arose in the context of illegal downloads of copyrighted music in *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster Ltd.*⁶⁴ There, the Court premised inducement liability on “purposeful, culpable expression and conduct.”⁶⁵ The Court held that liability for inducement exists “where evidence goes beyond a product’s characteristics or the knowledge that it may be put to infringing uses, and shows statements or actions directed to promoting infringement.”⁶⁶

Relying on the *Grokster* decision, the Federal Circuit in *DSU Medical Corp. v. JMS Co., Ltd* clarified its seemingly conflicting precedent on the intent standard for inducement claims.⁶⁷ The court held that in addition to

59. *Id.* at 2070–71.

60. *Id.* at 2071.

61. *Id.* at 2070 (stating that there was no need to invoke the doctrine to establish knowledge of the infringing nature of its activities, as the defendant was “indisputably aware” that its customers were selling the product in this country).

62. Paul Ragusa & Julie Albert, *Navigating Induced Infringement Claims: A Practical Application of the Willful Blindness Doctrine*, 21 IP LITIGATOR 18, 18 (2015).

63. See *Commil USA, LLC v. Cisco Sys. Inc.*, 135 S. Ct. 1920, 1928 (2015) (“the *Global-Tech* rationale is sound”).

64. *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster Ltd.*, 545 U.S. 913 (2005).

65. Timothy R. Holbrook, *The Supreme Court’s Quiet Revolution in Induced Patent Infringement*, NOTRE DAME L. REV. (forthcoming 2016) (manuscript at 107), <http://ssrn.com/abstract=2653077> [<https://perma.cc/E3SL-E9EW>].

66. *Grokster*, 545 U.S. at 935.

67. See Lane, *supra* note 9, at 198. The Federal Circuit first held in *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464 (Fed. Cir. 1990), that inducement required intent to cause the acts constituting infringement. However, in *Manville Sales Corp. v. Paramount Systems, Inc.*, 917 F.2d 544 (Fed. Cir. 1990), the court set a higher intent, holding that the

the inducer's knowledge, the plaintiff had to show specific intent to cause direct infringement, that is, "that the alleged infringer knowingly induced infringement and possessed specific intent to encourage another's infringement."⁶⁸

II. BACKGROUND ON WILLFUL INFRINGEMENT

Like inducement, willful infringement, an often-alleged adjunct to claims of patent infringement, requires a similar assessment of the mental state of the alleged infringer. The willful infringement standard has evolved through Federal Circuit case law.

As explained by the Federal Circuit, the possibility of treble damages for willful infringement serves as an "economic deterrent" to patent infringement.⁶⁹ As such, patentees often assert claims of willful infringement in litigation.⁷⁰ Section 284 of the Patent Act allows a court to enhance a prevailing plaintiff's damage award "up to three times the amount found or assessed."⁷¹ In its seminal opinion in *Seagate*, the Federal Circuit held "that an award of enhanced damages requires a showing of willful infringement."⁷² To establish willful infringement, a plaintiff must prove that the defendant was objectively reckless.⁷³ This standard requires a two-prong test. First, an objective inquiry into whether "the infringer acted despite an objectively high likelihood that its actions constituted infringement of a valid patent," and second, a subjective inquiry into whether the objectively-defined risk (as determined by the record) was

plaintiff must show that the infringer induced the infringing acts and knew or should have known his actions would cause actual infringement. *Id.*

68. *DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293, 1306 (Fed. Cir. 2006) ("Inducement requires evidence of culpable conduct, directed to encouraging another's infringement, not merely that the inducer had knowledge of the direct infringer's activities") (quoting *Grokster*, 125 S. Ct. at 2780; *Manville*, 917 F.2d at 553; *MEMC Elec. Materials, Inc. v. Mitsubishi Materials Silicon Corp.*, 420 F.3d 1369, 1378 (Fed. Cir. 2005)).

69. *Rite-Hite Corp. v. Kelley Co.*, 819 F.2d 1120, 1126 (Fed. Cir. 1987) (en banc).

70. See Kimberly A. Moore, *Empirical Statistics on Willful Patent Infringement*, 14 FED. CIR. B.J. 227, 232 (2004) (finding that willfulness was asserted in 92% of the 1,721 cases studied).

71. 35 U.S.C. § 284 (2012).

72. *In re Seagate Tech., LLC*, 497 F.3d 1360, 1368 (Fed. Cir. 2007) (en banc).

73. *Id.* at 1371 ("Accordingly, we overrule the standard set out in *Underwater Devices* and hold that proof of willful infringement permitting enhanced damages requires at least a showing of objective recklessness.").

either known or so obvious that it should have been known to the accused infringer.⁷⁴

Prior to *Seagate*, opinions of counsel regarding non-infringement or invalidity were seen as a guarantee against liability for willful infringement.⁷⁵ The Federal Circuit's decision in *Underwater Devices Inc. v. Morrison-Knudsen Co.* set forth the traditional standard for willful infringement.⁷⁶ There, the court established a "due care" standard, under which, upon actual notice of another's rights, a potential infringer "ha[d] an affirmative duty to exercise due care to determine whether or not he is infringing."⁷⁷ This duty included seeking and obtaining competent legal advice before initiating possibly infringing activities.⁷⁸ Compliance with this standard spurred the "advice of counsel" defense.⁷⁹ Defendants sought to establish that they based their infringing activity on a reliance on the advice of counsel.⁸⁰ In *Seagate*, the Federal Circuit eliminated the affirmative duty to obtain an opinion of counsel to defend against a claim of willful infringement.⁸¹

A. SEAGATE'S OBJECTIVE RECKLESSNESS STANDARD

In light of "the practical concerns facing litigants" under the *Underwater Devices* regime, the Federal Circuit revisited its willfulness doctrine in *Seagate*.⁸² In an en banc opinion, the court overruled *Underwater Devices*.⁸³ Reasoning that the "due care" standard—which was akin to negligence—was improper, the court established the more stringent "objective recklessness" standard.⁸⁴ To prevail on a claim of willful infringement under the new standard, a plaintiff must show that the infringer "acted despite an objectively high likelihood that its actions constituted infringement of a valid patent."⁸⁵ In this prong of the new standard, the infringer's subjective

74. *Id.*

75. See *Moore*, *supra* note 70, at 228 (noting that most practitioners and scholars believe that willfulness determinations often turned on opinion letters).

76. 717 F.2d 1380, 1389–90 (Fed. Cir. 1983).

77. *Id.*

78. *Id.*

79. See Brett Williamson & Edgar Martinez, *Post-Seagate: Advice of Counsel in Patent Defense*, 20 INTELL. PROP. LITIG. 1, 1 (2008).

80. *Id.*

81. *In re Seagate Tech., LLC*, 497 F.3d 1360, 1371 (Fed. Cir. 2007) (en banc) ("Because we abandon the affirmative duty of due care, we also reemphasize that there is no affirmative obligation to obtain opinion of counsel.").

82. *Id.* at 1370.

83. *Id.* at 1371.

84. *Id.*

85. *Id.*

state of mind is not relevant.⁸⁶ Upon meeting this threshold objective prong, the plaintiff must then demonstrate that the objectively defined risk was either known, or so obvious that the accused infringer should have known it.⁸⁷ Having abandoned the duty of care, the court emphasized that an alleged infringer had no affirmative obligation to obtain opinion of counsel.⁸⁸ This holding was subsequently codified in the America Invents Act, 35 U.S.C. § 298.⁸⁹

B. DEVELOPMENT OF THE WILLFULNESS STANDARD AFTER
SEAGATE

Following *Seagate*, the Federal Circuit further defined the contours of the willfulness standard in *Finisar Corp. v. DirecTV Group, Inc.*, where the defendant had obtained an opinion of counsel on non-infringement.⁹⁰ The court noted that a competent opinion of counsel on non-infringement or invalidity would be sufficient to proceed without being objectively reckless.⁹¹ Three years later, in *Spine Solutions, Inc. v. Medtronic Sofamor Danek USA, Inc.*, the court established that the “objective prong” of *Seagate* tends not to be met” where the alleged infringer relies on a reasonable defense to a charge of infringement.⁹² In contrast with the traditional paradigm where willfulness was a jury question, the Federal Circuit in *Bard Peripheral Vascular, Inc. v. W.L. Gore & Assocs., Inc.* announced that *Seagate*’s threshold objective prong is a question of law.⁹³ In the court’s opinion, when a defense or non-infringement theory is purely legal, the recklessness of such a theory is better left to the judge.⁹⁴ Similarly, the judge should determine the reasonableness of a proposed defense when the objective prong of the *Seagate* “objective recklessness” analysis turns on fact questions related, for example, to anticipation.⁹⁵ Given the *Seagate* standard, which puts the burden of proof on the patentee to meet the threshold objective prong, and

86. *See id.*

87. *Id.*

88. *Id. But see* *Broadcom Corp. v. Qualcomm Inc.*, 543 F.3d 683, 699 (Fed. Cir. 2008) (creating an exception in the context of inducement, such that “failure to procure such an opinion may be probative of intent”), *superseded by statute*, AIA 35 U.S.C. § 298.

89. AIA, 35 U.S.C. § 298 (stating that “[t]he failure of an infringer to obtain the advice of counsel . . . may not be used to prove that the accused infringer willfully infringed the patent or that the infringer intended to induce infringement of the patent.”).

90. *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1339 (Fed. Cir. 2008).

91. *Id.*

92. *Spine Sols., Inc. v. Medtronic Sofamor Danek USA, Inc.*, 620 F.3d 1305, 1319 (Fed. Cir. 2010).

93. 682 F.3d 1003, 1006 (Fed. Cir. 2012).

94. *Id.* at 1007.

95. *Id.*

Bard's determination that this inquiry is a question of law for the judge, there is essentially an increased likelihood of summary judgment resolution of claims of willful infringement against patentees.⁹⁶

As discussed, *supra*, in *Global-Tech* the Supreme Court established another prong to the requisite scienter for inducement liability: knowledge or willful blindness, a holding the Court subsequently affirmed in *Commil*. The *Commil* Court went further, eliminating good-faith belief in the invalidity of the patent-in-suit as a defense to inducement liability. In so doing, the Court created a tension with the Federal Circuit's willfulness standard established in *Seagate*.⁹⁷ This tension, along with the heightened intent standard for inducement liability, necessitates a review of the current standard for willful patent infringement.

III. THE *COMMIL* DECISION

In *Commil*, the Supreme Court ruled that induced infringement under § 271(b) required a showing that the defendant knew of the patent and the infringing nature of the induced acts. The Court further held that a belief as to patent invalidity is not a defense to, and cannot negate the scienter required for, a claim of induced infringement. The opinion raises the scienter standard for induced infringement. This heightened standard could lead to absurd results in cases alleging direct, induced, and willful infringement.

A. FACTS AND PROCEDURAL HISTORY

The induced infringement claim in *Commil* centered on Cisco's sale of mobile devices to customers who subsequently infringed *Commil's* '395 patent. *Commil*, a patent-holding company, sued Cisco Systems, alleging direct, induced, and contributory infringement of its patent related to a method of providing faster and more reliable handoffs for mobile devices.⁹⁸

96. Eric Hagen et al., *Treble Damages in Patent Cases—A Diminishing Threat?* BLOOMBERGBNA (Sep. 21, 2012), http://www.mwe.com/files/Publication/42a79193-9972-4bc0-b92c-6d5522af7706/Presentation/PublicationAttachment/b970ac08-98ed-4902-818c-752a4c0efad9/Treble_Damages.pdf?PublicationTypes=d4366db4-cfb3-4a31-95e6-f18e3d273c8a [https://perma.cc/86KQ-J9NE]; see Christopher B. Seaman, *Willful Patent Infringement and Enhanced Damages After In re Seagate: An Empirical Study*, 97 IOWA L. REV. 417, 444–45 (2012) (finding that in post-*Seagate* cases, willfulness was found in sixty-two percent of cases when the jury was the decision maker at trial, versus nineteen percent of cases decided by a judge).

97. *In re Seagate Tech., LLC.*, 497 F.3d 1360, 1371 (Fed. Cir. 2007) (en banc).

98. *Commil USA, LLC v. Cisco Sys. Inc.*, 135 S. Ct. 1920, 1924–25 (2015). The technical details of the patent were not extensively discussed in the Supreme Court's opinion and are only summarized here.

Commil asserted that through Cisco's sale of access points and controllers, Cisco induced consumers to practice and infringe its patent.⁹⁹

Rejecting Cisco's invalidity defenses, the jury found that Cisco directly infringed but did not induce infringement of Commil's patent and awarded \$3.7 million in damages.¹⁰⁰ Commil moved for and was granted a new trial on its inducement claims.¹⁰¹ Upon retrial, a second jury found Cisco liable for inducement as well.¹⁰² On appeal to the Federal Circuit, and as relevant to the Supreme Court's analysis, Cisco argued that the district court in the second trial erroneously precluded it from presenting evidence of its good-faith belief that the patent was invalid, to rebut the requisite intent for inducement liability.¹⁰³

B. VALIDATING A NEW DEFENSE: THE FEDERAL CIRCUIT'S REASONING

The Federal Circuit agreed with Cisco, holding that "a good-faith belief of invalidity is evidence that may negate the specific intent to encourage another's infringement, which is required for induced infringement."¹⁰⁴ The Federal Circuit's analysis began by noting that the court saw "no principled distinction between a good-faith belief of invalidity and a good-faith belief of non-infringement for the purpose" of specific intent to induce infringement.¹⁰⁵ Furthermore, noting that it is "axiomatic that one cannot infringe an invalid patent," the court determined that one could be aware of a patent and induce another to perform the claimed steps without necessarily intending to induce infringement.¹⁰⁶ In the court's view, causing other entities to infringe without the required intent can occur when there is a "good-faith belief that the patent is not valid."¹⁰⁷ As such, the court concluded that "evidence of an accused inducer's good-faith belief of invalidity may negate the requisite intent for induced infringement."¹⁰⁸ Therefore, the Federal Circuit held that the district court erred in barring the defendant from presenting evidence of its good-faith belief of invalidity

99. *Commil USA, LLC v. Cisco Sys. Inc.*, 720 F.3d 1361, 1364–65 (Fed. Cir. 2013), *vacated*, 135 S. Ct. 1920 (2015).

100. *Id.* at 1365.

101. *Id.*

102. *Id.* at 1366.

103. *Id.* at 1367–68.

104. *Id.* at 1368.

105. *Id.*

106. *Id.*

107. *Id.*

108. *Id.* at 1368–69.

to rebut allegations of induced infringement.¹⁰⁹ The Supreme Court granted certiorari and reversed the Federal Circuit on the question of whether a good-faith belief in invalidity is a defense to induced infringement.¹¹⁰

C. THE SUPREME COURT'S ANALYSIS

Vacating the Federal Circuit's decision, the Supreme Court held that a good-faith belief of patent invalidity is not a defense to induced infringement.¹¹¹ The Court began by affirming its *Global-Tech* knowledge standard, under which inducement liability (as well as liability for contributory infringement) attaches only if the defendant knew of the patent and that "the induced acts constitute patent infringement."¹¹² The Court further noted that invalidity and infringement were long accepted as separate and distinct issues under the Patent Act.¹¹³ Accordingly, invalidity and non-infringement appear in separate parts of the Act, and are treated as independent defenses.¹¹⁴ The Court reasoned that because "the scienter element for induced infringement concerns infringement," which is a different issue from validity, "belief regarding validity cannot negate the scienter" for inducement liability.¹¹⁵ Furthermore, the Court reasoned that treating belief of a patent's invalidity the same as belief of non-infringement to defend against inducement claims would "conflate the issues."¹¹⁶ In the Court's opinion, allowing the defense of a good faith, but erroneous, belief in invalidity would undermine the statutory presumption of validity of issued patents.¹¹⁷

Additionally, the Court reasoned that since invalidity is an affirmative defense that "can preclude enforcement of a patent against otherwise infringing conduct," an accused inducer has the option of avoiding liability by proving that the patent was indeed invalid.¹¹⁸ In the Court's view, because "invalidity . . . is a defense to liability," not to infringement, a belief as to the invalidity of the patent cannot negate the scienter for induced infringement.¹¹⁹

109. *See id.* at 1367.

110. *Commil USA, LLC v. Cisco Systems, Inc.*, 135 S. Ct. 1920, 1925 (2015).

111. *Id.* at 1930–31.

112. *Id.* at 1927.

113. *Id.* at 1928.

114. *Id.*

115. *Id.*

116. *Id.*

117. *Id.* at 1928–29.

118. *Id.*

119. *Id.*

The Court also noted “practical reasons not to create a defense based on a good-faith belief in invalidity.”¹²⁰ An alleged inducer with a belief that a patent is invalid has numerous proper ways to challenge the validity of the patent: they can seek *inter partes* review, as well as *ex parte* reexamination, and they can also raise invalidity as an affirmative defense.¹²¹ Moreover, the Court reasoned that creating a defense of belief in invalidity could render litigation more burdensome for all parties, as every accused inducer would put forth said defense.¹²² Juries would then be tasked with separating the defendant’s belief regarding validity from the actual issue of validity.¹²³

IV. IMPLICATIONS OF THE *COMMIL* DECISION ON THE WILLFULNESS STANDARD AND OPINIONS OF COUNSEL

Commil reveals a tension between the intent standards for inducement and willful infringement. Although the *Commil* holding centers on inducement liability, the holding may affect the willfulness standard and the viability of opinion letters. First, the holding calls into question the current objective recklessness standard for willful infringement. Further, it undermines the viability and utility of counsel opinions regarding invalidity and non-infringement.

A. *COMMIL* CALLS TO QUESTION *SEAGATE*’S STANDARD ON WILLFUL INFRINGEMENT

In light of *Commil*, the culpability standard for willful infringement ought to be modified to avoid situations where a finding of inducement liability under § 271(b) essentially and inevitably implies that an accused infringer is also liable for treble damages, as having willfully infringed the patent at issue. Following the *Global-Tech* decision, courts applying the willful blindness standard to inducement liability have performed an analysis similar to the “totality of circumstances” analysis currently applied in cases of willful infringement.¹²⁴

120. *Id.*

121. *Id.*

122. *Id.*

123. *Id.* at 1930.

124. Richard W. O’Neill et al., *A Practical Guide to ‘Willful Blindness’ Under Global-Tech: When Does Fear of Infringement Turn Into Knowledge of Infringement?* BNA INSIGHTS: IP LAW (June 13, 2014), <https://www.bloomberglaw.com/document/XAIK4VM4000000> [<https://perma.cc/3D2B-LHJ7>] (positing that courts assessing willful blindness conduct an intensive factual analysis of all relevant circumstances surrounding the infringer’s state of mind, particularly factors that generally address the accused inducer’s

1. *After Commil and Global-Tech, the Scier for Inducement Is Different from, and Higher than, that for Willful Infringement*

Under the *Global-Tech* holding, affirmed in *Commil*, the scier for inducement could be met by showing either actual knowledge or willful blindness—a standard the Court noted was of “appropriately limited scope . . . surpass[ing] recklessness and negligence.”¹²⁵ In essence, the scier standard for inducement liability exceeds the objective recklessness standard articulated in *Seagate*.¹²⁶ This calls into question the willfulness standard, and could lead to absurd results where defendants found to be liable for inducement are invariably also liable for willful infringement and potentially subject to treble damage penalties.

2. *Willful Patent Infringement Requires More Culpability than Inducement, Hence the Scier for Willfulness Should Be the Same or Higher than That for Inducement to Avoid Absurd Results*

The scier standard for willful infringement requires more culpability in intent (and conduct) than inducement. This higher scier standard is necessary to avoid situations where inducement liability automatically implies potential exposure to treble damages.

“Actively induces” as used in § 271(b) directly led to the Supreme Court’s holding in *Commil*.¹²⁷ Therefore, the standard for scier of inducement arguably stems from the statute.¹²⁸ In contrast, the statutory basis for willful infringement merely states that “the court may increase the damages up to three times the amount found or assessed.”¹²⁹ Furthermore, given that willful blindness is a heightened standard applicable to inducement liability, a finding of induced infringement, especially under a totality of circumstances analysis, would almost always result in a finding of willful infringement. The instance where induced infringement could otherwise have been found, without necessarily mandating a willful

subjective belief that there was a high probability of infringement and whether the inducer took steps to avoid learning if it infringed the asserted patent); *see also* *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 826 (Fed. Cir. 1992) (setting out factors to be considered in determining whether, and to what extent, to enhance damages).

125. *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060, 2070 (2011) (emphasis added).

126. *See In re Seagate Tech., LLC*, 497 F.3d 1360, 1371 (Fed. Cir. 2007) (finding that willful infringement required proof that a defendant was “objectively reckless”).

127. *See Commil USA, LLC v. Cisco Sys. Inc.*, 135 S. Ct. 1920, 1928 (2015).

128. *Id.* The *Commil* Court made a distinction between the infringement and invalidity scier (“The scier element for induced infringement concerns infringement; that is a different issue than validity.”).

129. *See* 35 U.S.C. § 284.

infringement finding, was when the accused infringer had a good-faith belief in the patent's invalidity.¹³⁰ However, after *Commil*, such a belief is no longer a defense to induced infringement, but is still a defense to willful infringement.¹³¹

Section 284 provides for increased damages where the defendant's culpability is aggravated by willful acts.¹³² Although there is no express mental state requirement codified in § 284, the Supreme Court has explained that increased damages are only available "in a case of willful or bad-faith infringement."¹³³ As articulated in *Seagate*, "proof of willful infringement permitting enhanced damages requires at least a showing of objective recklessness."¹³⁴

In *Global-Tech*, the Court noted that the willful blindness standard "surpasses" recklessness.¹³⁵ Willful blindness, the Court found, requires taking "deliberate actions to avoid confirming a high probability of wrongdoing."¹³⁶ In contrast, recklessness is knowing "of a substantial and unjustified risk" of wrong, while negligence is where a similar risk should have been known but was not.¹³⁷ The willful infringement standard, as articulated in *Seagate*, "requires at least a showing of objective recklessness."¹³⁸ As such, induced infringement will be harder to prove than willful infringement.¹³⁹ This is, however, counter-intuitive.¹⁴⁰ Ordinarily, willful infringement should require more culpable conduct than inducement. First, a finding of willful infringement implicates the

130. See Choa, *supra* note 56, at 35.

131. See, e.g., *Stryker Corp. v. Zimmer, Inc.*, 782 F.3d 649, 661–62 (Fed. Cir. 2015) ("The district court failed to undertake an objective assessment of Zimmer's specific defenses to Stryker's claims.").

132. 35 U.S.C. § 284 ("[T]he court may increase the damages up to three times the amount found or assessed."). Statutory damage enhancement in the context of copyright infringement is assessed under the recklessness standard. See 17 U.S.C. § 504(c); Rachel L. Emsley, *Copying Copyright's Willful Infringement Standard: A Comparison of Enhanced Damages in Patent Law and Copyright Law*, 42 SUFFOLK U. L. REV. 157, 157 (2009) (although the statute does not define willful, the term has consistently been defined as including reckless behavior).

133. *Aro Manufacturing Co. v. Convertible Top Replacement Co.*, 377 U.S. 476, 508 (1964).

134. *In re Seagate Tech., LLC*, 497 F.3d 1360, 1371 (Fed. Cir. 2007).

135. See 131 S. Ct. at 2070–71.

136. See *id.*

137. See *id.*

138. See *id.* at 1368.

139. See Choa, *supra* note 56, at 35.

140. *Id.*

possibility of punitive treble damages,¹⁴¹ whereas a finding of inducement only connotes liability. Furthermore, in criminal law, knowing—the mental state required for recklessness—only requires intent to commit an act, whereas willfulness requires knowledge that the act was illegal, and hence willfulness carries more culpability than recklessness.¹⁴² Accordingly, the current scienter standard for inducement appears to be more stringent than the scienter for willful infringement and should be changed to avoid unwarranted imposition of punitive damages.

In light of the *Commil* holding, it is still unclear what happens where an alleged inducer has good reason to believe a patent is invalid, for example, following a lower court's decision. Is the inducer still liable for damages that accrue during the pendency of an appeal where the lower court is reversed on the question of validity? A possible remedy would be to interpret *Commil* as only precluding a defense of good-faith belief in patent invalidity when the basis of the belief was subjective (e.g., from an opinion of counsel), and not judicially mandated. Under a totality-of-the-circumstances analysis, judicial adjudication of invalidity, though later proven wrong, should suffice for a defendant to escape inducement liability.

B. *COMMIL*'S IMPACT ON THE VIABILITY AND POTENCY OF OPINIONS OF COUNSEL

The *Commil* holding undermines the viability of invalidity opinion letters against claims of inducement and willful infringement. Furthermore, a defendant relying on such opinions would arguably be acting objectively recklessly if, in addition to relying on such opinions, the defendant failed to take the steps outlined in *Commil* to confirm the invalidity belief.

The Federal Circuit's precedent allows for an inducer who has "actual knowledge" of the patent under *Global-Tech* to still escape willfulness liability by claiming a subjective, good-faith belief in invalidity.¹⁴³ The Federal Circuit has found that a non-infringement or invalidity opinion of counsel "would provide a sufficient basis for [a potential infringer] to proceed without engaging in objectively reckless behavior."¹⁴⁴ The court has

141. See 35 U.S.C. § 284.

142. See, e.g., *United States v. McCullough*, 348 F.3d 620, 626–27 (7th Cir. 2003) ("The final difference between the two statutes is that the charged offense requires that the defendant act 'willfully,' while the lesser offense, § 922(m), requires that the defendant act 'knowingly.'").

143. See Laura Burton Perry, *Understanding the Good-Faith Belief in Invalidity: How Commil Has Impacted the Law of Induced Infringement*, 24 FED. CIR. B.J. 699, 717 (2015).

144. See *Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323, 1339 (Fed. Cir. 2008).

described opinions of counsel as serving “to provide an *objective assessment* for making informed business decisions.”¹⁴⁵

The post-*Seagate* case law further strengthened the viability of counsel opinions. In light of the *Bard* decision, judges have greater discretion to keep questions of willfulness out of the hands of a jury by determining as a matter of law that a defendant’s reliance on advice of counsel was reasonable.¹⁴⁶ Thus, obtaining a non-infringement and/or invalidity opinion still remains a powerful tool against a claim of willful infringement.

For a short while after the Federal Circuit’s *Commil* decision, invalidity opinions could provide an absolute defense against liability for induced infringement.¹⁴⁷ Although the Supreme Court’s decision did not address the viability or relevance of believing that a patent is invalid in determining whether an infringement was willful, *Commil* arguably undermines the efficacy and potency of invalidity opinions.¹⁴⁸

On the one hand, reliance on an invalidity opinion of counsel under the Federal Circuit’s precedent is seemingly reasonable. However, in light of *Commil* such reliance is arguably objectively reckless, as invalidity opinions cannot be used to show that an accused infringer lacked the requisite intent to induce under § 271(b). Although the *Commil* decision undermines the viability of invalidity opinions, parties can still use such opinions to memorialize early-stage validity analyses as part of a broader strategy of assessing potential infringement risk.¹⁴⁹

V. CONCLUSION

Although addressing inducement liability, the *Commil* holding also has implications for the Federal Circuit’s *Seagate* standard for willful infringement. The threshold standard for willfulness is currently objective recklessness, which is arguably lower than the scienter for inducement liability established in *Global-Tech* and *Commil*. This discrepancy is seemingly in tension with other areas of law, where the culpability level for

145. See *In re Seagate Tech., LLC*, 497 F.3d 1360, 1373 (Fed. Cir. 2007) (emphasis added).

146. See *Bard Peripheral Vascular, Inc. v. W.L. Gore & Assocs., Inc.*, 682 F.3d 1003, 1006–07 (Fed. Cir. 2012) (holding that the threshold objective prong of *Seagate* is a question of law for the judge).

147. See Perry, *supra* note 143, at 711 (“This case demonstrates that in the very short amount of time since *Commil* was decided, its holding has, in fact, allowed a subjective belief of invalidity to serve as an absolute defense to liability for induced infringement.”).

148. See generally Schwent, *supra* note 14.

149. Thomas Hipkins, *Invalidity Opinions of Counsel After Commil*, FREDRIKSON & BYRON, P.A. (June 30, 2015), http://www.fredlaw.com/news__media/2015/06/30/859/invalidity_opinions_of_counsel_after_commil [<https://perma.cc/H57L-NYZP>].

inducement liability is lower than the culpability necessary for claims that have punitive implications. Furthermore, *Commil* also undermines what was once a powerful tool to avoid direct and willful infringement liability—opinions of counsel regarding invalidity.

