

ALERTS**Intellectual Property Law Alert - Supreme Court Changes Standard To Obtain Enhanced Damages For Patent Infringement**

June 14, 2016 | [Atlanta](#) | [Chicago](#) | [Columbus](#) | [Dallas](#) | [Delaware](#) | [Elkhart](#) | [Fort Wayne](#) | [Grand Rapids](#) | [Indianapolis](#) | [Los Angeles](#) | [Minneapolis](#) | [South Bend](#)

On June 13, the U.S. Supreme Court issued its decision in *Halo Electronics, Inc. v. Pulse Electronics, Inc.*, No. 14-1513 (Slip Opinion). It rejected the framework established by the Federal Circuit Court of Appeals in *In re Seagate Technology, LLC*, 497 F.3d 1360, for determining whether to award enhanced damages for willful patent infringement under 35 USC Section 284 of the Patent Act.

In re Seagate had a two-part test: 1) a showing by clear and convincing evidence that the infringer acted despite an objectively high likelihood that its actions constituted infringement of a valid patent; and 2) also demonstrating by clear and convincing evidence that the risk of infringement was either known or so obvious that it should have been known to the accused infringer.

The Supreme Court found this two-part test to be inconsistent with the statute. The court reviewed the history of Section 284 and prior precedent and concluded the district court determines when to award enhanced damages, though not at its “whim,” and also noted such discretion should be exercised in light of the considerations giving rise to the discretion such that enhanced damages are not awarded in a typical case but only for egregious behavior typified by willful, wanton, malicious, bad-faith, deliberate, consciously wrongful or flagrant misconduct.

The Supreme Court rejected any requirement that enhanced damages be proven by clear and convincing evidence and, given its ruling that the enhanced damages award is a classic “discretion” determination, clarified that appellate review is limited to an abuse of discretion standard. As a result, the Supreme Court remanded the cases before it that had been decided based on the now-defunct Seagate test. It appears its decision will apply to pending and future cases.

While opinions of counsel as to non-infringement and invalidity are not required in order to rebut a claim for enhanced damages under 35 USC Section 298 and the absence of such an opinion cannot be used to prove willful infringement, the Supreme Court did not address whether the abandonment of the Seagate test may affect whether opinions of counsel are now more important in attempting to rebut willful infringement claims. Likewise, the new willfulness standard will likely effect pleadings changes as to what is now required to support a legally sufficient willfulness charge.

For more information, contact the Barnes & Thornburg attorney with whom you work or a member of the firm’s Intellectual Property Law Department in the following offices: Atlanta (404-846-1693), Chicago

RELATED PRACTICE AREAS

Intellectual Property
Patent Litigation

(312-357-1313), Columbus (614-628-0096), Dallas (214-258-4200), Delaware (302-300-3434), Elkhart (574-293-0681), Fort Wayne (260-423-9440), Grand Rapids (616-742-3930), Indianapolis (317-236-1313), Los Angeles (310-284-3880), Minneapolis (612-333-2111), South Bend (574-233-1171), Washington, D.C. (202-289-1313).

© 2016 Barnes & Thornburg LLP. All Rights Reserved. This page, and all information on it, is proprietary and the property of Barnes & Thornburg LLP. It may not be reproduced, in any form, without the express written consent of Barnes & Thornburg LLP.

This Barnes & Thornburg LLP publication should not be construed as legal advice or legal opinion on any specific facts or circumstances. The contents are intended for general informational purposes only, and you are urged to consult your own lawyer on any specific legal questions you may have concerning your situation.

Visit us online at www.btlaw.com and follow us on Twitter [@BTLawNews](https://twitter.com/BTLawNews).