

For: LeClairRyan, Detroit, Mich.  
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FOR IMMEDIATE RELEASE

**LeClairRyan Attorney Offers Guidance on Avoiding Patent Infringement Liability**

*Obtain an opinion early, protect in-house experts from being called as witnesses,  
Matthew Epstein advises in article for legal blog*

DEARBORN, Mich. (4/29/19)— A series of conflicting court decisions regarding willful patent infringement may have left companies confused, according to Matthew Epstein, a Detroit-based associate at national law firm LeClairRyan in a just-published article appearing in [IPWatchdog](#).

The Supreme Court decision in [Halo Electronics, Inc. v. Pulse Electronics, Inc.](#), 136 S. Ct. 1923 (2016) highlighted how a potential infringer should obtain an infringement opinion at the outset of undertaking any potentially infringing actions, as opposed to waiting to present such arguments at trial, he writes. Additionally, some Federal Circuit decisions let such opinions be entered as a defense regardless of whether they were prepared by in-house counsel, a patent agent, or an engineer.

But other courts have decisively dismissed opinions prepared by in-house patent agents, he cautioned, adding that in-house patent agents and/or engineers who prepare an opinion may be called as a witness during any litigation concerning the scope of the opinion.

“Therefore, in view of the courts’ decisions and overall attitude toward non-infringement opinions and invalidity opinions prepared by non-patent counsel, patent agents, and engineers, specifically those in-house, it is best practice to have outside patent counsel prepare these types of opinions,” Epstein concluded. “Doing so provides the greatest assurance that the author is not persuaded by any corporate influences. Furthermore, obtaining an opinion from outside counsel will avoid any unnecessary risks if litigation were to arise, such as waivers of privilege, as opposed to if the opinion was prepared by an in-house patent agent or engineer.”

The full column is available at: <https://www.ipwatchdog.com/2019/04/13/infringement-validity-opinions-prepared-inhouse/id=108253/>

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As a trusted advisor, LeClairRyan provides business counsel and client representation in corporate law and litigation. In this role, the firm applies its knowledge, insight and skill to help clients achieve their business objectives while managing and minimizing their legal risks, difficulties and expenses. With offices from coast to coast, the firm represents a wide variety of clients nationwide. For more information about LeClairRyan, visit [www.leclairryan.com](http://www.leclairryan.com).

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