

Improper Reliance on Informal “Opinion of Counsel” Part of Basis for Exceptional Case Award

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In *Drop Stop LLC v. Jian Qing Zhu et al*, 2-16-cv-07916 (CACD January 22, 2018), the Central District of California granted Plaintiff’s motion to award attorney fees due to Defendants’ exceptional litigation tactics under 35 U.S.C. § 285. Initially, counsel for Plaintiff sent a cease and desist email to Defendants to stop selling an infringing product, and attached a draft claim chart in support of its infringement position. The claim chart included a disclaimer stating “PLEASE NOTE - this informal opinion cannot be relied upon definitively. A formal opinion is required, and that involves extensive study and other efforts to provide a reliable outcome. Please call me to discuss.” However, four days later, Defendants re-listed the accused products and sent Plaintiff an email attaching Plaintiff’s draft claim chart without the disclaimer. Defendants relied upon Plaintiff’s claim chart to support its non-infringement positions despite not having performed any analysis of their own, and entirely dismissing Plaintiff’s disclaimer, which expressly disclaimed any formal legal opinion.

Later in the case, Defendants included a new affirmative defense in its amended answer and counterclaims, which the judge denied as untimely. After attempting to add another affirmative defense, Defendants informed Plaintiff for the first time that another entity should have been named as a defendant. The Plaintiff then filed a motion to award attorney fees under § 285 due to Defendants’ exceptional litigation tactics.

The judge granted Plaintiff’s motion stating that “[t]hese fees are warranted both to deter Defendants from engaging in a similar pattern of pre-litigation conduct, and because these fees were incurred largely due to Defendants’ actions—including delay tactics, chilling defenses, and re-raised arguments—taken during the course of litigation.” Practitioners should be mindful to avoid such litigation tactics in the post-*Octane Fitness* world.

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