



# MUCH ADO ABOUT NOTICES OF INFRINGEMENT

---

## Overview and Best Practices

September 24, 2025



Armstrong  
Teasdale

# Presenters



**Maggie Szewczyk**  
Partner, Armstrong Teasdale LLP



**Melanie King**  
Associate, Armstrong Teasdale LLP

# Overview

- Infringement Notices
  - Patent infringement
  - Trademark infringement
  - Copyright infringement
- Receiving a Demand Letter
- Sending a Demand Letter
- Best Practice Takeaways

# Patent Infringement Notices

- Also called demand or cease and desist letters
- The purpose of such a notice varies depending on the business goals of a company
  - Serve as a warning to competitors / recipients
  - Open licensing negotiations
  - Create notice for damages
  - Establish knowledge for induced infringement
  - Establish willful infringement
- Damages are limited to infringing acts occurring after the alleged infringer has “notice of infringement”
  - Can be either constructive or actual

# Patent Infringement Notices

- These notices can come in many forms
  - Generally, they claim ownership of one or more patents, and assert or suggest infringement through sale, use or manufacture
- Types
  - Aggressively assert infringement and threaten litigation
  - Suggest infringement and invite discussion
  - Seek to learn about recipient's product or service (information gathering tool)
  - Suggest licensing arrangement
- Sometimes notices will also include a date for response, claim charts, and/or a request for confidentiality

# Trademark Infringement Notice

- Can be based on **registered or common law** trademark rights
  - Don't be fooled by the text of the trademark registration
- Reference **specific** problematic use
  - **Caution:** may be evidence of confusion if sent by junior user
- Can trigger **laches** clock (as well as DJ claim)
- Sets the **tone** for next steps
  - May include broad or limited cease-and-desist demand
  - Should indicate openness to coexistence or phase-out period, if applicable

# Copyright Infringement Notice

- Should have U.S. Copyright **Registration** or application
  - Unlike trademark rights, registration is required to file suit
- Stronger possible **defenses** – fair use
- Should identify **specific** copying claim
- Confirm ownership or exclusive licensing rights
- No **requirement** that you send a demand letter before filing suit

# Declaratory Judgment Jurisdiction

- Depending on the content of the letter, it may create declaratory judgment (“DJ”) jurisdiction
  - If letter creates a “substantial controversy,” DJ jurisdiction is triggered
    - Must create definite and concrete dispute
    - Dispute must have immediacy and reality
    - Analysis goes beyond letter (e.g., informal conversations, history of parties, etc.)
  - DJ jurisdiction allows recipient to select preferred forum and control the timing of action
- Not all notice / demand letters create DJ jurisdiction



# Declaratory Judgment Jurisdiction

- Courts view the totality of circumstances when determining DJ jurisdiction—there are no magic words to avoid
- The key is whether the accused infringer would be reasonably concerned about being sued
- Things that can avoid creating DJ jurisdiction
  - A deadline by which the recipient should respond
  - Framing it as information seeking
  - Inviting discussion

# Declaratory Judgment Jurisdiction

- In *Element Six v. Novatek*, the court found no DJ jurisdiction

## Re: Diamond Enhanced Road Milling Picks Patent Notice

Dear Mrs. Watts,

It has been brought to our attention that Caterpillar Inc. and Element Six Group are performing road milling using diamond enhanced picks that violate U.S. patent rights owned by Novatek Inc.

For example, Novatek Inc. owns the exclusive rights to U.S. Patent No. 7,384,105; U.S. Patent No. 7,665,552; U.S. Patent No. 7,353,893; U.S. Patent No. 7,469,756; U.S. Patent No. 8,028,774; and U.S. Patent No. 7,669,674 for this field of use.

Novatek Inc. also owns pending U.S. Pat. App. No. 13/208,103 as well as others. Such patents and pending applications claim various embodiments of diamond enhanced picks as represented by the attached selection of figures.

Based upon Element Six Group's prior relationship with Novatek Inc., under a confidentiality agreement (see attached), Element Six Group is aware of this technology and Novatek Inc.'s ongoing research and development in this field.

We will appreciate very much your attention with regard to this matter and are willing to assist you in evaluating our position with you.

# Declaratory Judgment Jurisdiction

- *Element Six v. Novatek*, 4:14-cv-71 (S.D. Tex. June 9, 2014)
  - The patent owner worded its letter as an information gathering tool
  - The Court did not consider this to be a demand or an accusation
  - The patentee did not provide an infringement analysis until it was requested
  - The Court determined that a request for information was not a definite enough threat to enforce the patent owner's rights and did not create a substantial controversy

# Declaratory Judgment Jurisdiction

- In *Crowned Heads v. National Grange*, the court found there was DJ jurisdiction

The Grange owns a number of valid, incontestable U.S. Trademark Registrations for its GRANGE trademarks. These include U.S. Trademark Registration Number 1,872,429 for the mark GRANGE, a mark the Grange has used in commerce in the United States from 1876 to the present day. The Grange also owns U.S. Registration No. 1,817,894 for NATIONAL GRANGE; U.S. Registration No. 1,782,923 for THE GRANGE FOUNDATION; U.S. Registration No. 1,816,827 for NATIONAL GRANGE OF THE ORDER OF PATRONS OF HUSBANDRY; U.S. Registration No. 1,824,368 for the GRANGE LOGO; and U.S. Registration Nos. 3,792,978 and 3,974,240 for GRANGE.

We therefore strongly urge that your client withdraw application no. 85/547,248 and refrain from using the GRANGE mark in commerce in the United States. The Grange would oppose any application and object to any use of its GRANGE Trademarks in commerce in the United States.

The National Grange would prefer to resolve this matter amicably. Fortunately, your client already markets cigars under another brand, and chose the HEADLEY GRANGE mark as a proposed second brand very recently, in late October/early November of 2011, a few months before filing its application on an intent-to-use basis. It should therefore be able to select another mark before it invests significant capital in this mark. Kindly discuss the matter with your client, and let us know if it can resolve this dispute by adopting another mark. We will contact you shortly to ascertain if we can settle this matter amicably.

# Declaratory Judgment Jurisdiction

- *Crowned Heads v. National Grange*, 3:12-cv-1062 (M.D. Tn. April 3, 2013)
  - The trademark owner noted that it owned several incontestable registrations for its marks
  - Stated that the alleged infringer's usage would cause a likelihood of confusion and dilution
  - Urged the alleged infringer to withdraw its application
  - Suggested the trademark owner would oppose it
  - Warned the alleged infringer to not use the mark
  - Threatened objection to any use of the mark

# RECEIVING A DEMAND LETTER

---

Steps to Take and Calls to Make

# General Steps in Reviewing Patent Infringement Notice

- Initial assessment
  - Does the notice require further action?
    - Does the notice require a routine clearance opinion, or
    - Does it present significant potential exposure?
- Engage outside counsel
- In-house counsel action

# Initial Assessment

- Does the letter **identify**:
  - The specific IP asserted and the owner
  - Specific products/usages that allegedly infringe
  - An acceptable addressee (appropriate contact at the correct entity)
- Is the letter **merely**:
  - An **unsolicited** offer to sell or license the IP of concern?
  - Informational **without accusation** of infringement?
- Is the letter **from**:
  - An active NPE?
  - A direct competitor?
- If the designated recipient is not an attorney, **forward** to in-house counsel



# Initial Assessment

- Outside patent counsel can assist in determining the risk associated with an asserted patent
- When determining whether a response is required, some things to consider:
  - Likelihood of litigation
  - Importance of accused product/business line
  - Patent owner (competitor or NPE)
  - Evidence of copying
  - Licensing ask / size of potential damages award

# Another consideration: Willfulness

- An analysis of the notice is important because it could create knowledge on your part, as the recipient
  - Must show the alleged infringer knew of the patent and intentionally disregarded the patent owner's rights
- A finding of willfulness may entitle the patent owner to enhanced damages and/or an award of fees.
  - Damages may be increased up to three times. 35 U.S.C § 284
- Opinions of counsel can show reasonableness of actions and avoid willfulness
  - Opinions should document subjective belief of non-infringement and/or invalidity at the time of notice of potential infringement
    - Invalidity opinion: all claim limitations met by prior art
    - Non-infringement opinion: must only show one claim element missing

# Engage with Outside Counsel

- If **routine clearance opinion**:
  - Forward to outside counsel to conduct a prior art search and prepare a **routine clearance opinion** (non-infringement and invalidity opinion prepared by outside patent counsel)
- If **significant potential exposure**:
  - Forward to outside counsel to conduct **full-detail non-infringement and invalidity opinions** (prepared by outside patent counsel, approved by litigation counsel)
  - Assess need to institute or engage with opposing counsel/third party
- Engaging with third party
  - **Request more information** without specifically disputing or admitting facts
  - Determine if **patent-trolling statutes** should be raised
- **Re-assess applicability** to company by consulting relevant personnel
  - **Caution**: Ensure that employees do not generate documents or communications that are not attorney-client privileged

# In-House Counsel Action

- Obtain opinion of outside patent counsel **in writing**
- Store opinions in **stable repository**
- Designate opinions and communications as **attorney-client privileged**
- Document transmission of opinion to business leaders to show “**reliance**”

# General Steps in Reviewing Trademark Infringement Notice

- Review the sender's **actual commercial use** of its asserted mark
  - Trademark rights flow from use in commerce, not registration
- Review **scope of asserted registration**, if any
  - Verify details like first-use date at [tsdr.uspto.gov](https://tsdr.uspto.gov) – you may be the senior user!
- Determine **scope** of demand
  - Can you live with coexistence agreement or partial phase out?
- Consider possible defenses & declaratory judgment action

# General Steps in Reviewing Copyright Infringement Notice

- Review asserted copyright **registration**
  - Was it filed after you created your alleged copy?
- Determine strength of **non-infringement** and/or **fair use** defense
- Research sender's **litigation behavior**
  - Beware the troll and/or non-exclusive licensee

# SENDING DEMAND LETTERS

---

Things to be Aware of and Avoid

# Primary Concerns

- Providing actual, good-faith notice under federal law
- Complying with applicable state laws (e.g., patent trolling statutes)
- Avoiding Declaratory Judgment jurisdiction (discussed in previous slides)

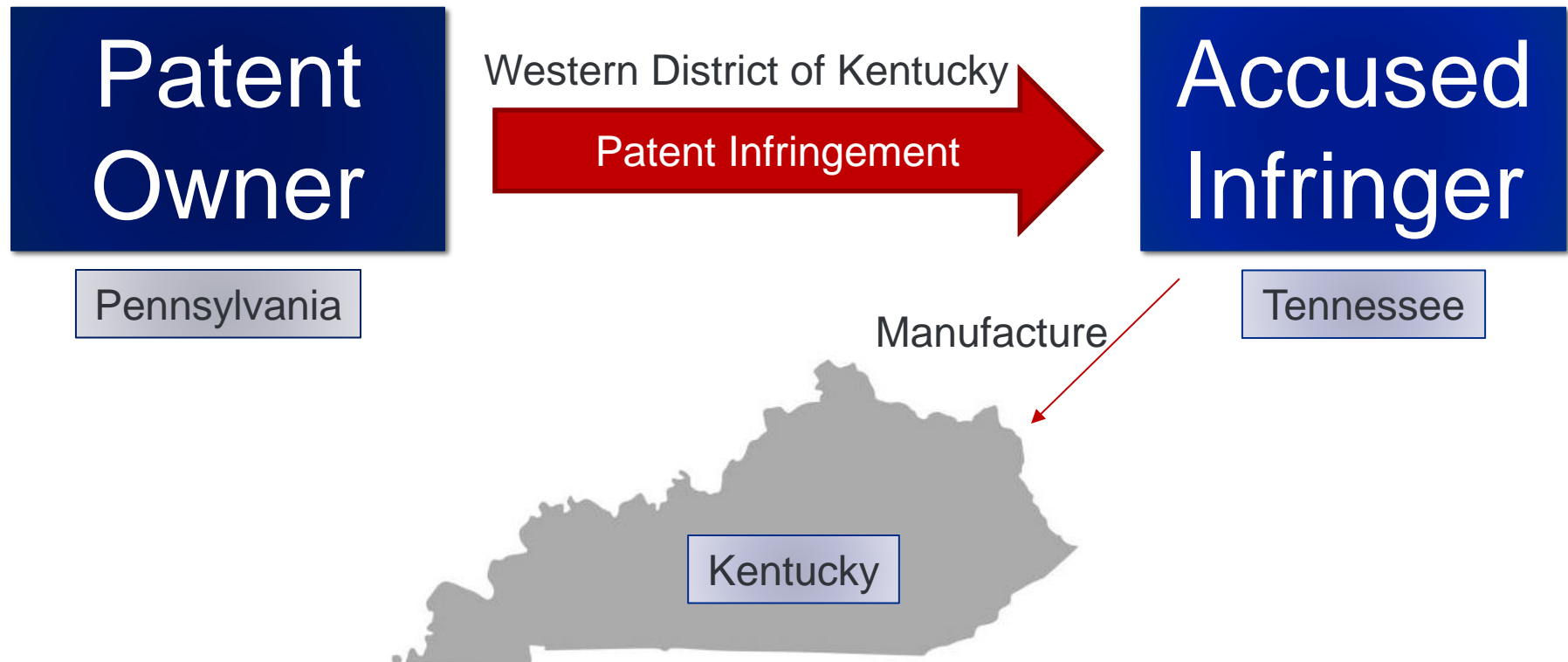


# Avoid Triggering Defenses/Counterclaims

- Federal Claims & Defenses
  - Patent/copyright/trademark misuse
  - Sham litigation
  - Antitrust claims
- State Law Claims & Defenses
  - Patent trolling statutes (jurisdiction matters)
  - Statutory or common law unfair competition
  - Deceptive trade practices
  - Defamation
  - Consumer protection statutes

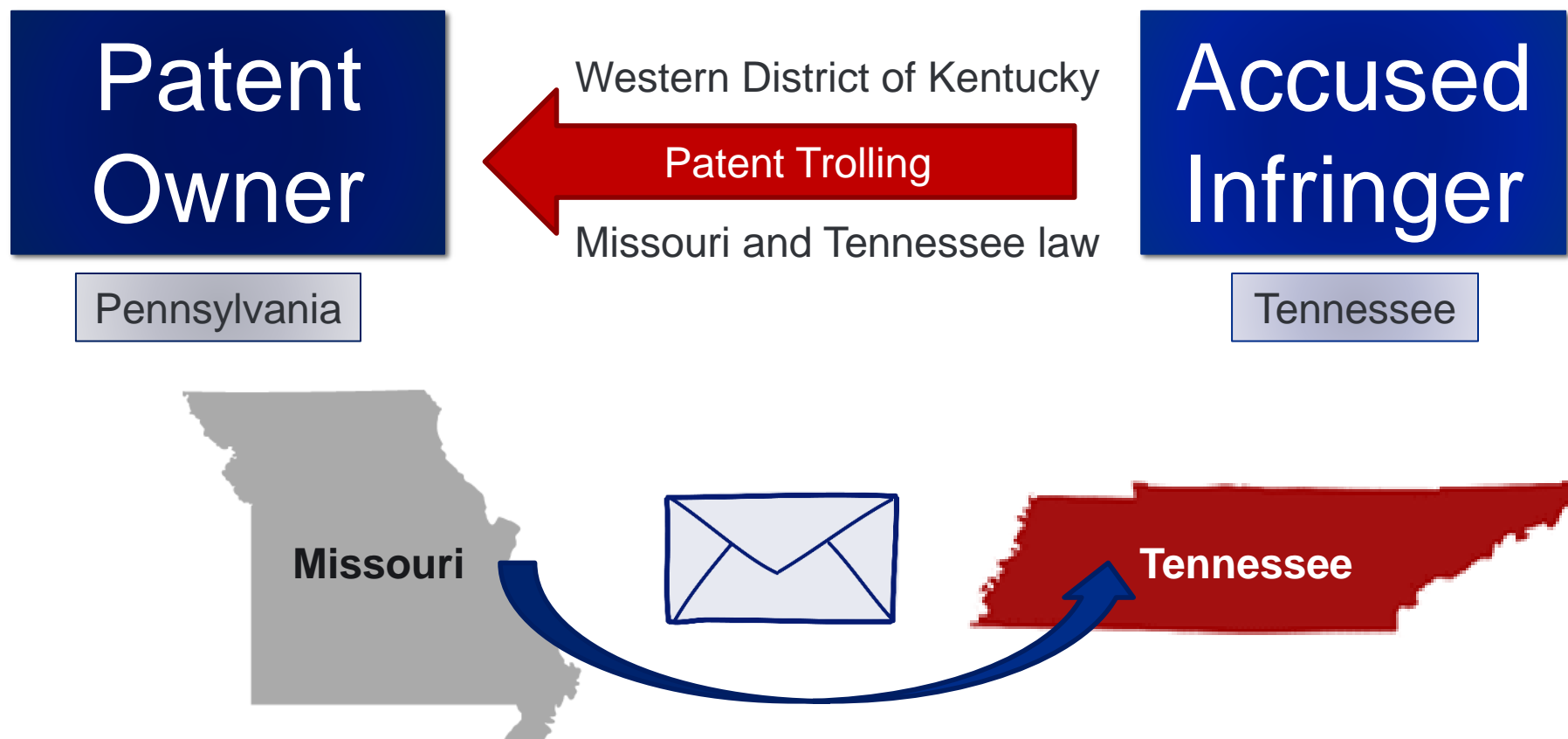
# Case Study: Patent Trolling Claims

Original Lawsuit



# Case Study: Patent Trolling Claims

## Counterclaims



# Best Practices

- If specific IP is asserted, proceed with caution
  - Sender: (1) make sure you own it and (2) avoid triggering declaratory judgment action
  - Recipient: engage outside counsel
- Balance ultimate business goals – what can you live with?
- Consider jurisdictional concerns when sending letters (and use them to your advantage)

# Questions?



**Maggie Szewczyk**  
Partner, Armstrong Teasdale LLP



**Melanie King**  
Associate, Armstrong Teasdale LLP