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Supreme Court Helps Level the Playing Field for Patent Infringement Defendants

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When facing a patent litigation threat, potential defendants have the option to seek a declaration that they are not infringing. Until recently, however, that strategy carried a hidden risk: the burden of proof on the infringement issue could shift to the accused infringer, instead of resting with the patentee. The Supreme Court has now mitigated that risk by holding that the patentee must carry the infringement burden, regardless of who brings the action. In *Medtronic, Inc. v. Mirowski Family Ventures, LLC*, the Court held that "when a licensee seeks a declaratory judgment against a patentee to establish that there is no infringement, the burden of proving infringement remains with the patentee." Mirowski accused its sub-licensee Medtronic of infringing patents relating to implantable heart stimulators, and Medtronic responded with a declaratory judgment action. After the trial court found Mirowski had failed to show infringement, Mirowski appealed, arguing that the burden was on Medtronic to show non-infringement since Medtronic brought the action. The Federal Circuit agreed, holding that, as a licensee and declaratory judgment plaintiff, the burden was Medtronic's. The Supreme Court has now reversed, however, and confirmed that the burden remains on the patentee regardless of the form of the action. Prior to *Medtronic*, it was not clear which party faced the burden on the infringement issue when a licensee brought a declaratory judgment action. That lack of clarity helped patentees by making declaratory judgment actions riskier. ***Medtronic* now levels the field somewhat by making it clear that the patentee must do the heavy lifting to show infringement, regardless of who commences litigation.** Some are concerned that licensees now have too much power to force the patentee into litigation. The Court reminded us, however, that the declaratory judgment action only arises when the patentee threatens litigation in the first place.

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