



BURDEN OF PROOF IN INFRINGEMENT SUITS

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The general rule in patent infringement proceedings is that the owner of a patent bears the burden of proving infringement. However, does this rule apply when a third party seeks a declaratory judgment of non-infringement?

In *Medtronic, Inc. v. Mirowski Family Ventures, LLC* (2014), 695 F3d 1266 (USSC), the Supreme Court of the United States ruled that, in the context of a motion for a declaratory judgment of non-infringement, the patentee still bears the burden of proving infringement, even if he is acting as a defendant. In other words, a plaintiff who seeks a declaratory judgment of non-infringement does not need to prove that he is not infringing on the patent in question.

In the present case, Medtronic, Inc. sought a declaratory judgment stating that the implantable cardiac pacemakers it produced and sold did not constitute an infringement of Mirowski Family Ventures, LLC's patents relating to a device which causes heart ventricles to contract in rhythm with the heart beat.

The District Court ruled in favor of Medtronic, because Mirowski did not provide evidence in support of the existence of patent infringement by Medtronic. However, the Federal Circuit reversed this decision on the grounds that the burden of proof in this case instead should be borne by the plaintiff. According to the Federal Circuit, Medtronic failed to meet its burden because it should have provided evidence that its product did not infringe the Mirowski patents.

The Supreme Court of the United States reversed the decision of the Federal Circuit. According to Justice Breyer, in the context of a motion for a declaratory judgment of non-infringement, the patentee bears the burden of proof, even if it is acting as the defendant.

First, the general rule in U.S. law is that the burden of proof with respect to questions of patent infringement belongs to the owner of the patent.

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Second, although the rules applicable to a motion for a declaratory judgment differ from those applicable to an original notice of motion, the rules of substantive law applicable to the facts in question remain the same. The procedural role of both parties may seem “reversed”: the party who would normally be the defendant in an infringement action is now acting as the plaintiff in a motion for a declaratory judgment involving the same facts. Despite this reversal, the procedural nature of the action does not entail a change in the substantive rights of the parties.

Third, the burden of proof is a question of substantive law. The reversal of the procedural burden does not modify the substantive legal rules applicable to patent infringement. Thus, the patentee must establish proof of infringement when he acts as a defendant in a motion for a declaratory judgment.

According to Justice Breyer, the owner of a patent is in a better position to explain the scope of his patent than a third party. The patentee is also in a better position to identify and explain how a product is infringing his patent. In a motion for a declaratory judgment, if the plaintiff were required to provide evidence of non-infringement, he would have to do so without knowing the specific allegations of infringement. Therefore, the plaintiff would need to guess all the possible allegations which may be raised by the owner of the patent in order to successfully make his case.

Moreover, the Court considered that the public has a paramount interest in understanding the scope of a patent. Although a patent grants its owner exclusive rights to the exploitation of the patented invention, there are limits to his monopoly. In particular, the owner of a patent should not be allowed to extend the scope of his monopoly by requiring royalties for the sale of a product that is beyond the scope of the patent. As explained above, the owner of a patent is better able to demonstrate the scope of his monopoly.

Furthermore, assigning the burden of proof to the owner of the patent in an infringement procedure favors consistency of judgments relating to the same patent. If the assignment of the burden of proof depended on the nature of the proceedings, there would be a risk of contradictory judgments relating to the same patent. The decisions of the District Court and the Federal Circuit illustrate this problem: the District Court considered that Mirowski had not met the burden of proving infringement, whereas the Federal Circuit, relying on the same facts, decided that Medtronic didn't prove the absence of patent infringement. In these cases, even though the evidence submitted was the same, Medtronic's liability varied depending on who bore the burden of proof.

As a result, in U.S. law, when a party institutes a proceeding in order to obtain a declaratory judgment, that party doesn't have to prove the absence of infringement. The burden of proving infringement is always on the patentee, whether he is acting as defendant or a plaintiff.

Presently, this rule created by the U.S. Supreme Court has no equivalent in the Quebec or Canadian law. Similarly to the American rule, the general rule in Quebec and Canada is that the patentee must prove infringement. However, under Quebec law, the plaintiff generally must prove the merits of the conclusions sought in a declaratory judgement. Notwithstanding, in practice the defendant in a motion for a declaratory judgment of non-infringement will always bring evidence of infringement. The practical reasons given by the Supreme Court of the United States are persuasive, but are not determinative of the Quebec or Canadian law applicable to the same facts. The Quebec and Canadian Law regarding the assignment of the burden of proof in such cases is therefore still subject to discussion



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