

## On Remand, Federal Circuit Comes Around to Supreme Court's Way of Thinking

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On a remand from the Supreme Court, the U.S. Court of Appeals for the Federal Circuit, addressing the issue of the **sufficiency of infringement evidence**, affirmed a district court's ruling that a patentee failed to prove infringement by a preponderance of the evidence in view of the Supreme Court's holding that the burden is on the patentee to show infringement in a declaratory judgment action. ***Medtronic Inc. v. Boston Scientific Corp.***, Case Nos. 11-1313, -1372 (Fed. Cir., Mar. 11, 2014) (Linn, J.) (non-precedential).

Medtronic filed a declaratory judgment action against defendants (collectively, MFV) seeking a finding that its products did not infringe the MFV patents. At the time of the litigation, Medtronic held a license to the MFV patents. As a result, MFV could not bring a counterclaim for infringement.

MFV argued that Medtronic, as the declaratory judgment plaintiff, bore the burden of proving non-infringement. The district court rejected this argument and found instead that the patentees have the burden to prove infringement. The district court found that MFV failed to show infringement by a preponderance of the evidence because MFV's expert failed to consider each limitation of each asserted claim in comparison to each accused product before rendering his infringement opinions. MFV appealed.

In a prior decision in this litigation, the Federal Circuit determined that the district court had erred in allocating the burden of persuasion to the patentee, given the context of the dispute. The Supreme Court granted *certiorari* and reversed the Federal Circuit, finding that the burden of proving infringement falls on the patentee in a declaratory judgment action. ([IP Update, Vol. 15, No. 10](#)) On remand from the Supreme Court, the Federal Circuit again reviewed the district court's conclusion of non-infringement in view of the Supreme Court's determination that the patentee bears the burden of proving infringement.

This time, the Federal Circuit looked at MFV's evidence and affirmed the district court's ruling that MFV had failed to prove literal infringement by a preponderance of the evidence. The Court found that MFV failed to show evidence that the Medtronic products in question met every limitation of the claims at issue. The Federal Circuit explained that "Medtronic's noninfringement contentions based on certain elements alleged to be missing from its devices do not relieve [MFV's expert] to opine on the presence of structure meeting every claim limitation." Further, based on the evidence presented

at trial, the Federal Circuit concluded that the district court had not abused its discretion in finding that MFV's infringement expert was unreliable based on the lack of foundational evidence provided in his report to support the ultimate conclusion of infringement under the doctrine of equivalents. Accordingly, MFV's arguments presented in rebuttal to Medtronic's non-infringement position were insufficient to meet its burden of proving infringement by a preponderance of the evidence.

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