
ESSAY

“REVERSE” PATENT DECLARATORY JUDGMENT ACTIONS: A PROPOSED SOLUTION FOR *MEDTRONIC*

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INTRODUCTION

The United States Supreme Court has taken an interest in shaping patent law in recent years, deciding many important cases, a number of which have involved special procedural rules created by the Federal Circuit.¹ With the

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¹ See, e.g., *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2111, 2114 (2013) (holding that a naturally occurring, isolated DNA segment is not patentable subject matter), *affg in part, rev'g in part* 689 F.3d 1303 (Fed. Cir. 2012); *Gunn v. Minton*, 133 S. Ct. 1059, 1063-64, 1068 (2013) (rejecting the Federal Circuit's rule that patent malpractice claims are within the exclusive jurisdiction of the federal courts), *declining to follow* *Immunocept, LLC v. Fulbright & Jaworski, LLP*, 504 F.3d 1281 (Fed. Cir. 2007); *Microsoft Corp. v. i4i Ltd. P'ship*, 131 S. Ct. 2238, 2242-43 (2011) (affirming the Federal Circuit's rule that patent invalidity must be proven by clear and convincing evidence), *affg* 598 F.3d 831 (Fed. Cir. 2010); *Bilski v. Kappos*, 130 S. Ct. 3218, 3226-27 (2010) (affirming the Federal Circuit's ruling, but rejecting its endorsement of the “machine-or-transformation” test as the sole test of subject matter eligibility), *affg* 545 F.3d 943 (Fed. Cir. 2008); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 407, 415-22 (2007) (promoting an expansive obviousness standard and holding that the Federal Circuit's “teaching, suggestion, or motivation” test should be flexibly applied), *rev'g* 119 F. App'x 282 (Fed. Cir. 2005); *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118, 132 n.11 (2007) (rejecting the Federal Circuit's “reasonable apprehension of suit” test for determining the justiciability of declaratory judgment actions), *rev'g* 427 F.3d 958 (Fed. Cir. 2005); *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 390 (2006)

Court scheduled to hear *Medtronic Inc. v. Boston Scientific Corp.* in early November, this term is no exception.² The issue in *Medtronic* is whether the burden of proof in patent declaratory judgment actions (DJ actions) should be on the patent owner (i.e., the defendant) to prove infringement or on the accused infringer (i.e., the plaintiff) to prove noninfringement.³ Ordinarily, the patent owner bears the burden of proving infringement, and the declaratory posture of a suit does not shift that burden.⁴ In *Medtronic*, however, the Federal Circuit created an exception for “*MedImmune*-type” cases—that is, declaratory judgment actions where the plaintiff is a licensee in good standing—since the patent owner cannot counterclaim for infringement.⁵ “Because the declaratory judgment plaintiff is the only party seeking the aid of the court,” the Federal Circuit reasoned, it should bear the burden of proving noninfringement.⁶

Medtronic and its supporting amici (including the United States) argue that the Supreme Court should reverse the opinion below because the Federal Circuit misallocated the burden of proof as a legal matter and because the Federal Circuit’s rule undermines the policy goal of encouraging patent validity challenges.⁷ Without disputing Medtronic’s position, this short Essay suggests, first, that *Medtronic* sweeps more broadly than the parties have acknowledged, and, second, that there may be an additional—and perhaps simpler—ground for reversing the Federal Circuit.

The litigants all appear to believe that the Federal Circuit’s new exception is limited to *MedImmune*-type suits, but *Medtronic* could be interpreted more expansively. In *Medtronic*, the Federal Circuit shifted the burden of proof to the accused infringer because the patent owner could not counterclaim for

(holding that the traditional four-factor test for permanent injunctions applies to patent cases), *vacating* 401 F.3d 1323 (Fed. Cir. 2005).

² See 133 S. Ct. 2393 (2013) (granting certiorari); *Medtronic, Inc. v. Boston Scientific Corp.*, SCOTUSBLOG, <http://www.scotusblog.com/case-files/cases/medtronic-inc-v-boston-scientific-corp> (last visited Oct. 7, 2013). The Court has also agreed to review two cases concerning the patent fee-shifting statute, 35 U.S.C. § 285 (2006). See *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, No. 12-1184, 2013 WL 1283843, at *1 (Oct. 1, 2013), *granting cert. to* 496 F. App’x 57 (Fed. Cir. 2012); *Highmark, Inc. v. Allcare Health Mgmt. Sys., Inc.*, No. 12-1163, 2013 WL 1217353, at *1 (Oct. 1, 2013), *granting cert. to* 687 F.3d 1300 (Fed. Cir. 2012).

³ See Brief for Petitioner at i, *Medtronic*, 133 S. Ct. 2393 (No. 12-1128), 2013 WL 3935883.

⁴ See *Medtronic Inc. v. Bos. Scientific Corp.*, 695 F.3d 1266, 1272 (Fed. Cir. 2012), *cert. granted*, 133 S. Ct. 2393 (2013).

⁵ *Id.* at 1273-74. In *MedImmune*-type suits, plaintiffs generally seek a declaration that the patent is invalid and/or that certain products are not covered by the terms of the license so that they no longer have to pay royalties.

⁶ *Id.* at 1274.

⁷ See, e.g., Brief for Petitioner, *supra* note 3, at 38-47; Brief for the United States as Amicus Curiae Supporting Petitioner at 24-31, *Medtronic*, 133 S. Ct. 2393 (No. 12-1128), 2013 WL 3990879.

infringement. Yet, there are declaratory judgment actions outside the *MedImmune* context where an infringement counterclaim is also precluded. For instance, plaintiffs sometimes file “anticipatory” declaratory judgment actions *before* engaging in any potentially infringing activities.⁸ In these suits, the patent owner cannot counterclaim for infringement because no infringing activity has occurred. Under the logic of *Medtronic*, therefore, the burden of proof would shift to the plaintiff in this category of cases even though there’s no license involved.

Whether limited to *MedImmune*-type suits or not, the Federal Circuit’s reasoning in *Medtronic* is significantly flawed. While it’s true that patent owners cannot counterclaim for infringement in certain types of declaratory judgment actions, they may always counterclaim for a declaration of *future* infringement.⁹ In other words, the patent owner in *Medtronic* was not, as the Federal Circuit determined, precluded from “seeking the aid of the court”;¹⁰ instead, the owner could have asked the court to resolve the infringement question by filing a “reverse” declaratory judgment action against the accused infringer. Thus, the Federal Circuit’s rationale for crafting this exception was wholly unjustified, and *Medtronic* should be reversed.

I. THE DECLARATORY JUDGMENT ACT

The Declaratory Judgment Act (DJ Act), which was enacted in 1934,¹¹ provides that “[i]n a case of actual controversy within its jurisdiction, . . . any court of the United States, upon the filing of an appropriate pleading, may declare the rights and other legal relations of any interested party seeking such declaration.”¹² The DJ Act further provides that “[a]ny such

⁸ See, e.g., *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 689 F.3d 1303 (Fed. Cir. 2012), *rev’d in part on other grounds*, 133 S. Ct. 2107 (2013). In *Myriad*, the Federal Circuit held that one of the plaintiffs, Dr. Ostrer, demonstrated an actual case or controversy even though he had not yet engaged in any infringing activity because Ostrer “not only has the resources and expertise to immediately undertake clinical *BRCA* testing, but also states unequivocally that he will immediately begin such testing.” *Id.* at 1320-21.

⁹ See *Lang v. Pac. Marine & Supply Co.*, 895 F.2d 761, 764 (Fed. Cir. 1990) (holding that a patentee may seek a declaration of infringement against a future infringer as long as the case-or-controversy requirement, U.S. CONST. art. III, § 2, cl. 1, is satisfied). *Medtronic* cites *Lang* once in its brief, Brief for Petitioner, *supra* note 3, at 39, yet neither the parties nor the amici focus on the argument that the patent owner could have counterclaimed for a declaration of future infringement.

¹⁰ See *Medtronic*, 695 F.3d at 1273-74.

¹¹ Ch. 512, 48 Stat. 955 (1934) (codified as amended at 28 U.S.C. § 2201 (2006)).

¹² 28 U.S.C. § 2201(a).

declaration shall have the force and effect of a final judgment or decree and shall be reviewable as such.”¹³

The Supreme Court has held that the DJ Act “enlarge[s] the range of remedies available in the federal courts but d[oes] not extend their jurisdiction.”¹⁴ Like many remedial devices, the DJ Act is transsubstantive, meaning it is available in all federal civil suits regardless of the substantive nature of the underlying claims.¹⁵ From the outset, though, the DJ Act has played a prominent role in patent cases. Indeed, the legislative history demonstrates that Congress specifically considered patent rights while debating the DJ Act:

I assert that I have a right to use a certain patent. You claim that you have a patent. What am I going to do about it? There is no way I can litigate my right, which I claim, to use that device, except by going ahead and using it, and you can sit back as long as you please and let me run up just as high a bill of damages as you wish to have me run up, and then you may sue me for the damages, and I am ruined, having acted all the time in good faith and on my best judgment, but having no way in the world to find out whether I had a right to use that device or not.¹⁶

Thus, Congress enacted the DJ Act, at least in part, to provide accused infringers with a procedural remedy to counter the use of patents as “scarecrows” to quash competition.¹⁷

Over the past eighty years, the DJ Act has been invoked in a number of patent cases—usually by accused infringers who have been threatened by patent owners. Yet for more than two decades now, it has been well settled that patent owners also have the right to seek declaratory relief, as long as a justiciable controversy exists.¹⁸ Despite this precedent, reverse declaratory judgment

¹³ *Id.*

¹⁴ *Skelly Oil Co. v. Phillips Petroleum Co.*, 339 U.S. 667, 671 (1950).

¹⁵ See H.R. REP. NO. 70-366, at 2 (1928) (noting that a declaratory judgment “may be applied to the ascertainment of almost any determinative fact or law”).

¹⁶ *Declaratory Judgments: Hearings on H.R. 5623 Before a Subcomm. of the S. Comm. on the Judiciary*, 70th Cong. 35 (1928) (statement of E.R. Sunderland).

¹⁷ See *Cardinal Chem. Co. v. Morton Int’l, Inc.*, 508 U.S. 83, 95-96 (1993) (quoting Judge Learned Hand’s opinion in *Bresnick v. U.S. Vitamin Corp.*, 139 F.2d 239, 242 (2d Cir. 1943)).

¹⁸ See, e.g., *Lang v. Pac. Marine & Supply Co.*, 895 F.2d 761, 764 (Fed. Cir. 1990) (“If the controversy requirement is met by a sufficient allegation of immediacy and reality, we see no reason why a patentee should be unable to seek a declaration of infringement against a future infringer when a future infringer is able to maintain a declaratory judgment action for noninfringement under the same circumstances.”); see also *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1369 (Fed. Cir. 2004) (“Although not as common as the scenario in which the alleged infringer seeks declaratory judgment against the patentee, it is possible for a patentee to also seek a declaratory judgment against a future infringer.” (citation omitted));

actions have been rare—perhaps because of the difficulty patent owners faced in proving a justiciable controversy. Thanks to the Supreme Court’s decision in *MedImmune, Inc. v. Genentech, Inc.*,¹⁹ however, that justiciability hurdle is now easier to overcome.

II. *MEDIMMUNE V. GENENTECH*

As with all suits brought in federal court, plaintiffs seeking declaratory judgments must demonstrate that there is an actual case or controversy for the court to resolve.²⁰ This can prove difficult since declaratory relief is an anticipatory remedy that addresses future conduct. Because justiciability is often challenged in patent declaratory judgment actions, the Federal Circuit has fashioned tests for determining when a case or controversy exists in both “standard” and “reverse” DJ actions.

With respect to standard DJ actions, the accused infringer must prove that, (1) based on the defendant’s conduct, it had a reasonable apprehension of suit at the time it filed the action; and, (2) it produced, or made meaningful preparations to produce, an allegedly infringing product.²¹ For reverse DJ suits, the Federal Circuit established in *Lang* that patent owners must show that, (1) the accused infringer was engaged in an activity directed toward making, selling, or using a patented product that would subject it to an infringement charge, or was making meaningful preparation for such an activity; and, (2) the acts of the accused infringer indicate a refusal to change the course of its actions despite acts by the patent owner sufficient to create a reasonable apprehension of suit.²²

For years, these tests posed significant hurdles for patent litigants seeking declaratory relief. The issue came to a head in *MedImmune*—a standard DJ action—where the Supreme Court addressed whether an accused infringer, who was also a licensee, could sue for declaratory relief.²³ The Federal Circuit had decided that, because the license protected the licensee from an infringement suit, there was no “reasonable apprehension of suit” and thus no case or controversy.²⁴ The Supreme Court reversed and held that a licensee in good standing may sue for declaratory relief as long as “the facts alleged,

Lawrence M. Sung, *Intellectual Property Protection or Protectionism? Declaratory Judgment Use by Patent Owners Against Prospective Infringers*, 42 AM. U. L. REV. 239 (1992).

¹⁹ 549 U.S. 118 (2007).

²⁰ See U.S. CONST. art. III, § 2, cl. 1.

²¹ See *Shell Oil Co. v. Amoco Corp.*, 970 F.2d 885, 887 n.2 (Fed. Cir. 1992).

²² 895 F.2d at 764.

²³ See 549 U.S. at 120-21.

²⁴ *MedImmune, Inc. v. Genentech, Inc.*, 427 F.3d 958, 962-65 (Fed. Cir.), *rev'd*, 549 U.S. 118 (2005).

under all the circumstances, show that there is a substantial controversy, between parties having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.”²⁵

In reaching this decision, the Supreme Court found the Federal Circuit’s “reasonable apprehension of suit” test to be in conflict with Court precedent.²⁶ Instead, whether plaintiffs in a patent declaratory judgment action have established a justiciable controversy depends on the totality of the circumstances—just like in any other declaratory judgment suit.²⁷ In other words, there is no special justiciability test for patent cases.

Since *MedImmune*, the Federal Circuit has been all over the map with respect to the justiciability of patent declaratory judgment actions.²⁸ What’s clear, though, is that *MedImmune* made it easier to prove an actual case or controversy between the parties. And while the Federal Circuit has yet to address *MedImmune*’s impact on reverse declaratory judgment actions, every district court to address the question agrees that *MedImmune*’s more lenient standard is equally applicable when a patent owner—rather than an accused infringer—is the party seeking declaratory relief.

III. REVERSE DECLARATORY JUDGMENT ACTIONS POST-MEDIMMUNE

Before *MedImmune*, the Federal Circuit had adopted unique tests for evaluating the case-or-controversy requirement in both standard and reverse patent declaratory judgment actions. In the immediate wake of *MedImmune*, the Federal Circuit acknowledged that it would have to alter its approach to justiciability in standard DJ actions.²⁹ Because reverse suits are relatively rare, however, the Federal Circuit has not had the chance to consider them post-*MedImmune*. In the meantime, a few district courts have weighed in on the question and have uniformly held that *MedImmune* applies with equal force to reverse patent declaratory judgment suits.

²⁵ *MedImmune*, 549 U.S. at 127, 137 (quoting *Md. Cas. Co. v. Pac. Coal & Oil Co.*, 312 U.S. 270, 273 (1941)).

²⁶ *Id.* at 132 n.11 (citing *Altwater v. Freeman*, 319 U.S. 359 (1943); *Md. Cas. Co.*, 312 U.S. at 273; and *Aetna Life Ins. Co. v. Haworth*, 300 U.S. 227, 239 (1937)).

²⁷ *Id.* at 127.

²⁸ See Megan M. La Belle, *Patent Law as Public Law*, 20 GEO. MASON L. REV. 41, 77-79 (2012) (collecting cases).

²⁹ See, e.g., *SanDisk Corp. v. STMicroelectronics, Inc.*, 480 F.3d 1372, 1380-81 (Fed. Cir. 2007) (“The Supreme Court’s opinion in *MedImmune* represents a rejection of our reasonable apprehension of suit test. . . . We need not define the outer boundaries of declaratory judgment jurisdiction, which will depend on the application of the principles of declaratory judgment jurisdiction to the facts and circumstances of each case.”).

In *Eisai Co. v. Mutual Pharmaceutical Co.*, for example, the patent owner brought a reverse DJ action seeking a declaration of future infringement, and the defendant (i.e., the accused infringer) moved to dismiss on justiciability grounds.³⁰ To resolve the motion, the district court first had to determine the standard for evaluating justiciability in reverse declaratory judgment actions: did the Federal Circuit's *Lang* test apply or was *MedImmune* now controlling? Citing similarities between the *Lang* test and the recently invalidated test for standard DJ actions, the district court held that *MedImmune* applies to reverse patent declaratory judgment actions.³¹ Accordingly, patent owners seeking declaratory relief for future infringements must demonstrate a case or controversy under *MedImmune*'s totality of the circumstances standard.³²

Other district courts have reached the same conclusion as the *Eisai* court, but through slightly different reasoning. *Cordance Corp. v. Amazon.com, Inc.*³³ is a good example. There, Cordance sued Amazon for infringement, and Amazon counterclaimed for a declaration of future infringement of one of its patents.³⁴ In moving to dismiss Amazon's counterclaim, Cordance argued that *MedImmune* was distinguishable because it dealt with a standard DJ action, while Amazon's counterclaim should continue to be governed by *Lang*.³⁵ The U.S. District Court for the District of Delaware disagreed, reiterating *MedImmune*'s holding that the totality of the circumstances standard should apply to *all* types of suits brought under the Declaratory Judgment Act, including reverse DJ cases.³⁶ The court then concluded that Amazon had established a case or controversy under *MedImmune* and denied Cordance's motion to dismiss.³⁷

At bottom, it seems clear that *MedImmune*'s more flexible standard applies to reverse patent declaratory judgment actions. To be sure, it is unlikely that the Supreme Court would reject a special justiciability test for standard DJ actions, but uphold a similar test for reverse suits. Accordingly, as long

³⁰ No. 06-3613, 2007 WL 4556958, at *14 (D.N.J. Dec. 20, 2007).

³¹ See *id.* at *16 ("[B]ecause the Federal Circuit equated the second *Lang* prong with the now-rejected reasonable apprehension of suit in a 'normal' declaratory judgment action, the second *Lang* prong is no longer good law.").

³² *Id.*; see also *Geisha, LLC v. Tuccillo*, 525 F. Supp. 2d 1002, 1004, 1012-13 (N.D. Ill. 2007) (concluding that *MedImmune* applies in reverse declaratory judgment actions involving trademark infringement).

³³ 521 F. Supp. 2d 340 (D. Del. 2007).

³⁴ *Id.* at 341-42.

³⁵ *Id.* at 343 n.13.

³⁶ *Id.* at 344 n.13, 345.

³⁷ *Id.* at 345-46.

as the totality of the circumstances creates an actual case or controversy, patent owners may seek declarations of future infringement against licensees just as licensees may seek declarations of future noninfringement against patent owners.

IV. *MEDTRONIC V. BOSTON SCIENTIFIC*

Because the background of *Medtronic* is somewhat complicated, this Part provides a brief summary of those facts essential to this Essay. Medtronic and defendants Boston Scientific Corporation and Guidant Corporation are all leading manufacturers of medical devices. In 1991, Medtronic agreed to license U.S. Patent No. 4,928,688 (the '688 patent) from Eli Lilly & Co., Guidant's predecessor-in-interest to the patent.³⁸ Sometime thereafter, the U.S. Patent and Trademark Office reissued the '688 patent as United States Reissued Patent Nos. RE 38,119 and RE 39,897 (collectively "the reissue patents").³⁹

In December 2007, Medtronic filed a declaratory judgment action in the U.S. District Court for the District of Delaware against Boston Scientific, Guidant, and Mirowski Family Ventures LLC (MFV) (collectively "defendants") seeking a declaration of noninfringement and invalidity as to the reissue patents.⁴⁰ Defendants did not contest justiciability, perhaps because the parties had previously entered into a "Litigation Tolling Agreement" that specifically recognized that "an actual controversy exists . . . as to the scope, validity and enforceability of the [reissue patents]."⁴¹ Of course, the case-or-controversy requirement is a true jurisdictional limitation that cannot be waived by the parties,⁴² so the district court could have—but did not—raise justiciability on its own.

The case proceeded to a bench trial where the judge had to decide, among other things, which party should bear the burden of proof as to infringement. Defendants argued that Medtronic, as plaintiff, should have the burden of proving noninfringement, while Medtronic took the position that defendants, as patent owners, always bear the burden of proving infringement.⁴³ The trial court agreed with Medtronic, citing Federal

³⁸ *Medtronic Inc. v. Bos. Scientific Corp.*, 777 F. Supp. 2d 750, 758, 761 (D. Del. 2011), *vacated*, 695 F.3d 1266 (Fed. Cir. 2012), *cert. granted*, 133 S. Ct. 2393 (2013).

³⁹ *Id.*

⁴⁰ *Id.* at 757-58. MFV, the assignee of the reissue patents, exclusively licensed them to Guidant, a wholly owned subsidiary of Boston Scientific. *Id.* at 758.

⁴¹ *Id.* at 759 (citations and internal quotation marks omitted).

⁴² See, e.g., Lea Brilmayer, *The Jurisprudence of Article III: Perspectives on the "Case or Controversy" Requirement*, 93 HARV. L. REV. 297, 298 (1979) (stating that if there is no case or controversy, "courts are without power to proceed, regardless of the wishes of the parties").

⁴³ *Medtronic*, 777 F. Supp. 2d at 765.

Circuit cases holding that “[t]he burden is always on the patentee to show infringement”⁴⁴ and never shifts to the accused infringer.⁴⁵ Applying this standard, the court then concluded that defendants failed to meet their burden and issued a declaratory judgment of noninfringement in favor of Medtronic.⁴⁶

On appeal, defendants persuaded the Federal Circuit that the trial court had misallocated the burden of proof on infringement. The Federal Circuit acknowledged that in ordinary patent declaratory judgment actions, the patent owner counterclaims for infringement and thus bears the burden of proof.⁴⁷ In *MedImmune*-type cases, however, “the continued existence of the license precludes the very infringement counterclaim that normally would impose the burden of proving infringement on the patentee.”⁴⁸ Therefore, the Federal Circuit reasoned, in this limited circumstance where the patent owner cannot counterclaim and the accused infringer is the only party who may “seek[] the aid of the court,” the burden of persuasion lies with the licensee to show noninfringement of the patents in suit.⁴⁹ Given the district court’s misallocation of the burden of proof, the Federal Circuit vacated the judgment below and remanded for further proceedings on the question of infringement.⁵⁰

Medtronic filed a petition for certiorari, which the Supreme Court granted in May.⁵¹ Medtronic has now filed its opening brief, and oral argument is scheduled for November 5, 2013.⁵² Two amicus briefs have been filed in support of Medtronic, one of them by the United States.⁵³ Petitioner and its amici argue that the Federal Circuit’s new rule regarding the burden of proof is not only legally erroneous but also problematic from a policy perspective because it deters patent validity challenges.⁵⁴ The purpose of this Essay is certainly not to challenge these arguments, but instead to focus on an alternative ground for reversing the decision below.

⁴⁴ *Id.* (alteration in original) (quoting *Under Sea Indus., Inc. v. Dacor Corp.*, 833 F.2d 1551, 1557 (Fed. Cir. 1987)).

⁴⁵ *Id.* at 765-66 (citing several Federal Circuit decisions).

⁴⁶ *Id.* at 782-83.

⁴⁷ See *Medtronic Inc. v. Bos. Scientific Corp.*, 695 F.3d 1266, 1272 (Fed. Cir. 2012) (noting that such counterclaims are compulsory), *cert. granted*, 133 S. Ct. 2393 (2013).

⁴⁸ *Id.* at 1273.

⁴⁹ *Id.* at 1274.

⁵⁰ See *id.* at 1274-75 (noting that it would be within the district court’s discretion to allow Medtronic to amend its interrogatory answer to include additional noninfringement contentions).

⁵¹ *Medtronic Inc. v. Bos. Scientific Corp.*, 133 S. Ct. 2393 (2013).

⁵² See SCOTUSBLOG, *supra* note 2.

⁵³ See *id.*; see also Brief for the United States as Amicus Curiae Supporting Petitioner, *supra* note 7.

⁵⁴ See *supra* note 7 and accompanying text.

V. THE FEDERAL CIRCUIT WRONGLY CONCLUDED THAT DEFENDANTS COULD NOT FILE A COUNTERCLAIM

In *Medtronic*, the Federal Circuit held that accused infringers should bear the burden of proof in declaratory judgment actions when the patent owner is precluded from filing a counterclaim for infringement.⁵⁵ The problem with this decision, aside from the legal and policy considerations raised by *Medtronic* and its amici, is two-fold. First, the Federal Circuit claims that this exception is limited to *MedImmune*-type suits, but its reasoning sweeps far more broadly. Under *Medtronic*, the burden of proof will shift in any DJ action in which the patent owner cannot counterclaim for infringement. This is not limited to suits between licensees and licensors, but includes any anticipatory declaratory relief action where the accused infringer has not yet engaged in infringing conduct.⁵⁶ This possibility of *Medtronic* extending beyond the *MedImmune* context raises very real concerns about the far-reaching implications of the Federal Circuit's decision.

Second, and perhaps more fundamentally, the *Medtronic* decision is based on a faulty premise. The fact that a license is in place or that a plaintiff has not yet infringed does not preclude counterclaims in DJ actions. Instead, it means only that patent owners will have to file a different type of counterclaim—one that focuses on *future* infringement.⁵⁷ As one district court recently explained, “The Federal Circuit has held that the proper vehicle for a suit to redress the future infringement would be an action under the Declaratory Judgment Act . . . rather than a suit under 35 U.S.C. § 271 alone.”⁵⁸

Thus, contrary to the Federal Circuit's holding in *Medtronic*, the defendants' hands were not tied by the license.⁵⁹ Just as *Medtronic* was able to sue for declaratory relief notwithstanding the license, the defendants could have counterclaimed with a DJ suit of their own. Indeed, the Federal Circuit

⁵⁵ 695 F.3d at 1274.

⁵⁶ See *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 689 F.3d 1303, 1319-21 (Fed. Cir. 2012) (allowing one plaintiff's declaratory judgment action to proceed even though he had not yet engaged in infringing activity), *rev'd in part on other grounds*, 133 S. Ct. 2107 (2013); *Teletronics Pacing Sys., Inc. v. Ventritex, Inc.*, 982 F.2d 1520, 1526-27 (Fed. Cir. 1992) (acknowledging that a patent owner may seek declaration of future infringement, but dismissing the patent owner's claim in the instant case for failure to demonstrate an actual case or controversy).

⁵⁷ See *supra* Parts I, III. Notably, the *Medtronic* defendants did initially file a counterclaim for declaratory relief, but it concerned the right to recover money paid into an escrow account—not future infringement. 695 F.3d at 1273 n.2. That counterclaim was dismissed without prejudice pursuant to a joint stipulation of the parties. *Id.*

⁵⁸ *WesternGeco L.L.C. v. Ion Geophysical Corp.*, 776 F. Supp. 2d 342, 351 (S.D. Tex. 2011) (citing *Lang v. Pac. Marine & Supply Co.*, 895 F.2d 761, 765 (Fed. Cir. 1990)).

⁵⁹ See *supra* notes 9-10 and accompanying text.

recognized this explicitly in *Lang*, holding that, as long as there's a justiciable controversy, a patentee's right to seek a declaration of infringement against a future infringer mirrors the right of a future infringer to seek a declaration of noninfringement against a patentee.⁶⁰

There's little doubt that the defendants in *Medtronic* could have demonstrated the requisite case or controversy. For starters, the parties specifically recognized that "an actual controversy exists . . . as to the scope, validity and enforceability of the [reissue patents]." ⁶¹ There was also a long history of litigation among the parties concerning the patents in suit,⁶² which suggests a justiciable controversy.⁶³ More to the point, however, *Medtronic's* filing of a declaratory judgment action unquestionably created the case or controversy necessary for defendants to counterclaim for declaratory relief.⁶⁴ In fact, there's a good argument that a counterclaim for a declaration of future infringement is not merely permissive under these circumstances but actually compulsory,⁶⁵ just as infringement counterclaims are compulsory in response to DJ actions brought by nonlicensees.⁶⁶

In the end, the Federal Circuit should not have shifted the burden of proof to the accused infringer in *Medtronic* simply because the patent owner was precluded from asserting a counterclaim for present infringement. The patent owner had another option—it could have (and perhaps should have) sought a declaration of future infringement. The fact that the patent owner, for whatever reason, chose not to file such a counterclaim should have no impact on the burden of proof.⁶⁷ Thus, the Supreme Court should reject the

⁶⁰ See 895 F.2d at 764.

⁶¹ *Medtronic Inc. v. Bos. Scientific Corp.*, 777 F. Supp. 2d 750, 759 (D. Del. 2011), *vacated*, 695 F.3d 1266 (Fed. Cir. 2012), *cert. granted*, 133 S. Ct. 2393 (2013) (citations and internal quotation marks omitted).

⁶² *Id.* at 758.

⁶³ See, e.g., *Prasco, LLC v. Medicis Pharm. Corp.*, 537 F.3d 1329, 1341 (Fed. Cir. 2008) ("Prior litigious conduct is one circumstance to be considered in assessing whether the totality of circumstances creates an actual controversy.").

⁶⁴ See, e.g., *Arteris S.A.S. v. Sonics, Inc.*, No. 12-0434, 2013 WL 3052903, at *5 (N.D. Cal. June 17, 2013) ("[B]ecause Arteris' patent claims were pending at the time Sonics filed its non-infringement and invalidity counterclaims, a case or controversy existed when the counterclaims were filed.").

⁶⁵ See FED. R. CIV. P. 13(a)(1) (requiring a party to plead as a counterclaim any claim that "arises out of the transaction or occurrence that is the subject matter of the opposing party's claim").

⁶⁶ *Medtronic*, 695 F.3d at 1272 (Fed. Cir. 2012) (citations omitted).

⁶⁷ It appears that defendants did not assert such a counterclaim in *Medtronic* under the misapprehension that a licensor receiving royalty payments is ineligible to seek the aid of the court. See Brief for Respondent Mirowski Family Ventures at 27, *Medtronic*, 133 S. Ct. 2393 (No. 12-1128), 2013 WL 5172001. Of course, had they raised a counterclaim for future infringement, they would not have been able to advance the burden-shifting argument that ultimately prevailed at the circuit level. Thus, allowing the allocation of the burden of proof to depend on whether the patent

exception created by *Medtronic* and hold that the same rules regarding burden of proof apply in all patent declaratory judgment actions.

CONCLUSION

Medtronic is the latest example of the Federal Circuit's creation of special procedural rules for patent cases, a trend that the Supreme Court has consistently eschewed in recent years.⁶⁸ It is well established that patent owners bear the burden of proof on infringement and that the declaratory posture of the suit does not alter that burden. That a patent owner may be unable to counterclaim for present infringement in certain situations does not justify an exception to these rules. *MedImmune* held that all declaratory judgment actions should be treated equally, and *Medtronic* will now provide the Supreme Court with the opportunity to remind the Federal Circuit of this guiding principle.

Preferred Citation: Megan M. La Belle, "Reverse" Patent Declaratory Judgment Actions: A Proposed Solution for *Medtronic*, 162 U. PA. L. REV. ONLINE 43 (2013), <http://www.pennlawreview.com/online/162-U-Pa-L-Rev-Online-43.pdf>.

owner asserts a counterclaim invites exactly the kind of gamesmanship the Declaratory Judgment Act was intended to eliminate. See *supra* Part I (discussing Congress's reasons for enacting the DJ Act).

⁶⁸ See Sarah Tran, *Policy Tailors and the Patent Office*, 46 U.C. DAVIS L. REV. 487, 492 n.17 (2012) (cataloguing a series of recent cases in which the Court has rejected these rules).