



# SHIMOKAJI & ASSOCIATES, P.C.

# NEWSLETTER

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Intellectual Property Lawyers  
[www.shimokaji.com](http://www.shimokaji.com)

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We specialize in the litigation, registration, and monetization of patent, trademark, and copyright matters. The clients we serve range from start-ups to Fortune 500 companies, government entities, and universities. Though located in the US, our expertise and representation has an emphasis in Asia.

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## *Functional Claim Requires Both Hardware and Software*

This applies when the hardware cannot alone perform the claimed functionalities - *Nazomi v. Nokia*.

More information can be obtained at [info@shimokaji.com](mailto:info@shimokaji.com)



## *US Supreme Court Says that Patentee Must Prove Infringement - Even When It is the Defendant*

In *Medtronic v. Mirowski*, Medtronic sublicensed patents from Mirowski who later claimed that certain new Medtronic products infringed the sublicensed patents. Medtronic filed a declaratory judgment action of noninfringement.

The district court said that Mirowski had the burden of proving infringement, since it was the party asserting infringement. The Federal Circuit disagreed.

The US Supreme Court began its analysis with the principle that the patentee ordinarily bears the burden of proving infringement. The question, according to the Supreme Court, was whether the burden changes when the patentee is a defendant in a declaratory judgment action. It does not, according to the Supreme Court.

A declaratory judgment process, according to the Supreme Court, is only "procedural" and the "substantive rights" do not change. The burden of proof is a substantive right.

There are practical considerations to leaving the burden of proof with the patentee, according to the Supreme Court. If the alleged infringer fails to prove noninfringement, the alleged infringer might continue its infringing activity and force the patentee to bring an infringement lawsuit. The patentee might then fail to prove infringement in its lawsuit. Both parties are then left with the question of infringement undecided.

Another practical consideration is that the patentee is in a better position to identify where and how a product infringes. On the other hand, the alleged infringer may be "in the dark" and forced to "negate every conceivable infringement theory."