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# The New Rule for Patent Venue for Corporate Defendants: Kansas was Never Like This

*"Click your heels together three times and say, 'There's no place like home, there's no place like home.'"*<sup>1</sup>

## I. Introduction

In 1989, Congress adopted the Judicial Improvements and Access to Justice Act.<sup>2</sup> The Act, among other things, amended the general corporate venue provision, section 1391(c),<sup>3</sup> to allow for venue in a jurisdiction when personal jurisdiction has been obtained over the corporate defendant. Section 1391(c) now states in pertinent part that "[f]or purposes of venue under this chapter, a defendant that is a corporation shall be deemed to reside in any judicial district in which it is subject to personal jurisdiction at the time the action is commenced . . . ."<sup>4</sup> In *VE Holding Corp. v. Johnson Gas Appliance Co.*,<sup>5</sup> the Court of Appeals for the Federal Circuit<sup>6</sup> interpreted the phrase "for purposes of venue under this chapter" as evidence of Congress' intent to expand the residence test of the special venue statute for patent infringement actions, section 1400(b).<sup>7</sup> The effect of the

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1. *The Wizard of Oz* (Metro-Goldwyn-Mayer 1939).

2. Act of Nov. 19, 1988, Pub. L. No. 100-702, tit. X, § 1013(a), 102 Stat. 4642, 4669 (hereinafter the "Act").

3. 28 U.S.C. § 1391(c) (1988).

4. *Id.* The former provision had stated that "[a] corporation may be sued in any judicial district in which it is incorporated or licensed to do business or is doing business, and such judicial district shall be regarded as the residence of such corporation for venue purposes." 28 U.S.C. § 1391(c) (1982).

5. 917 F.2d 1574, 16 U.S.P.Q.2d 1614 (Fed. Cir. 1990).

6. The Court of Appeals for the Federal Circuit (hereinafter "CAFC") was established by the Federal Court Improvement Act of 1982, Pub. L. No. 97-164, 96 Stat. 25 (1982). The CAFC has jurisdiction over various areas, but its primary focus is on hearing patent appeals from the United States District Courts and the Patent and Trademark Office. 28 U.S.C. § 1295(a)(1), (4) (1988).

7. 28 U.S.C. § 1400(b) (1988). Section 1400(b) provides that: "[a]ny civil action for patent infringement may be brought in the judicial district where the defendant resides,

CAFC's opinion has been the effective repeal of section 1400(b), except for actions involving non-corporate defendants.<sup>8</sup>

Prior to the *VE Holding* decision, the Supreme Court had established conclusively that section 1400(b) was the sole and exclusive venue provision in patent infringement actions.<sup>9</sup> The case law and language of section 1400(b), however, have been the subject of much criticism.<sup>10</sup> Several critics have advocated the legislative repeal of section 1400(b). These critics have focused almost exclusively on the perceived faults in the Court's interpretation of the legislative history of section 1400(b) and the extensive case law which developed to interpret the language of the statute.<sup>11</sup>

These critics have overlooked a fundamental purpose of venue statutes — protecting defendants from litigating in an inconvenient or burdensome forum. Furthermore, they have ignored the importance of the interaction between procedural requirements and the substantive aspects of the law to which the requirements apply. Recent developments in patent law, for example, have created an environment that is overly advantageous to plaintiffs, thereby necessitating a special patent venue provision.<sup>12</sup>

Part II of this Comment discusses the purposes of venue statutes in general, traces the statutory and judicial history of section 1400(b), and describes the state of patent venue before the CAFC's decision in *VE Holding*. Part III discusses the *VE Holding* decision. Previous criticisms of section 1400(b) are summarized in Part IV. Part V addresses the CAFC's opinion in *VE Holding* and the criticisms of section 1400(b), and concludes that a judicial or legislative repeal of the statute is an inappropriate solution to the problems associated with it. This Comment concludes that Congress must act to overturn the *VE*

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or where the defendant has committed acts of infringement and has a regular and established place of business." *Id.*

8. The Supreme Court denied the defendant's writ of certiorari. 111 S. Ct. 1315 (1991). One court has extended the holding to apply to partnerships. *See Injection Research Specialists v. Polaris Indus.*, 759 F. Supp. 1511, 18 U.S.P.Q.2d 1800 (1991).

9. *See infra* notes 32-75 and accompanying text.

10. *See infra* notes 138-162 and accompanying text.

11. *Id.*

12. *See infra* notes 193-209 and accompanying text.

*Holding* decision through a legislative amendment to section 1400(b) that would eliminate its ambiguous and restrictive elements and still protect the interests of corporate defendants.

## II. The History of Patent Venue

### A. Venue Generally

Venue is a statutory device designed to limit a plaintiff's choice of forum.<sup>13</sup> Generally, federal venue provisions provide for venue in a jurisdiction in which either the defendant resides or the subject claim arose.<sup>14</sup> Venue has been recognized as a mechanism to provide litigants with a convenient forum,<sup>15</sup> to protect defendants from litigating in inconvenient forums,<sup>16</sup> and to prohibit plaintiffs from unrestrained forum shopping.<sup>17</sup> In determining whether venue is proper, courts have considered the number of contacts a party has with the jurisdiction<sup>18</sup> and the significance of those contacts.<sup>19</sup>

The first explicit federal venue requirements were imposed by statute in 1887.<sup>20</sup> The statute restricted venue to the district in which the defendant was an inhabitant.<sup>21</sup> Before the statute's adoption, an action could be brought in any district in which the defendant was an inhabitant or could be found.<sup>22</sup>

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13. See *Penrod Drilling Co. v. Johnson*, 414 F.2d 1217, 1221-22 (5th Cir. 1969), *cert. denied*, 396 U.S. 1003 (1970).

14. See WRIGHT, MILLER & COOPER, *FEDERAL PRACTICE & PROCEDURE* § 3804, at 18 (1976).

15. See *Neirbo Co. v. Bethlehem Shipbuilding Corp.*, 308 U.S. 165, 167-68 (1939).

16. See *Whittier v. Emmet*, 281 F.2d 24, 30 (D.C. Cir.), *cert. denied*, 364 U.S. 935 (1960).

17. See *Union Pac. R.R. v. Woodahl*, 308 F. Supp. 1002, 1008 (D. Mont. 1970).

18. See *Pennwalt Corp. v. Horton Co.*, 582 F. Supp. 438, 223 U.S.P.Q. 1113 (E.D. Pa. 1984).

19. See *Commercial Solvents Corp. v. Liberty Mut. Ins. Co.*, 371 F. Supp. 247, 251 (S.D.N.Y. 1974).

20. Act of March 3, 1887, ch. 373, 24 Stat. 552, *as corrected by the Act of August 13, 1888*, ch. 866, 25 Stat. 433.

21. *Id.* at 552, 25 Stat. at 434.

22. Act of March 3, 1875, ch. 137 18 Stat. (Part 3), 470, which was founded on section 11 of the Act of September 24, 1789, ch. 20, 1 Stat. 73, 78-79. For an analysis of the venue provisions of the Act of 1789, see Warren, *New Light on the History of the Federal Judiciary Act of 1789*, 37 HARV. L. REV. 49, 80-81 (1923). Statutory venue provisions were the product of common law concepts of venue. See Blume, *Place of Trial of Cases*, 48 MICH. L. REV. 1 (1949).

## B. *The Statutory History of Patent Venue*<sup>23</sup>

The first patent venue statute was enacted in 1897.<sup>24</sup> Before its adoption, a split in authority had developed among the federal courts. Some courts adopted the venue provisions of the 1887 general venue statute,<sup>25</sup> while other courts followed the provisions of the 1789 statute.<sup>26</sup> Most interpreters of the 1897 patent venue statute agree that it was enacted to resolve the split among the courts.<sup>27</sup> Interpreters have debated whether Congress intended to expand or restrict the scope of patent venue in relation to the general venue provision.<sup>28</sup> The provisions of the 1897 statute were reenacted in the Act of 1911.<sup>29</sup> The Act of 1948<sup>30</sup> revised and recodified the patent venue statute into its present format.<sup>31</sup>

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23. See generally Wydick, *Venue in Actions for Patent Infringement*, 25 STAN. L. REV. 551 (1973); Waldrop, *The Patent Venue Statute*, 28 U.S.C. § 1400(b) *Should Not Be Repealed*, 4 A.P.L.A. Q. J. 32 (1976); Comment, *A New Look at Venue in Patent Infringement Suits*, 21 GEO. WASH. L. REV. 610 (1953); Comment, *Venue in Patent Infringement Suits in the Federal Courts*, 47 NW. U.L. REV. 699 (1952); Note, *Corporate Venue in Patent Infringement Cases*, 40 DEPAUL L. REV. 207 (1990).

24. Act of March 3, 1897, ch. 395, 29 Stat. 695, 695-96. The statute provided that:  
[I]n suits brought for the infringement of letters patent the circuit courts of the United States shall have jurisdiction . . . in the district of which the defendant is an inhabitant, or any other district in which the defendant, whether a person, partnership, or corporation, shall have committed acts of infringement and have a regular and established place of business.

*Id.*

25. Act of March 3, 1887, ch. 373, 24 Stat. 552, 552-53 (venue proper in a forum in which the defendant was an inhabitant); see, e.g., *National Typewriter Co. v. Pope Mfg. Co.*, 56 F. 849 (C.C.D. Mass. 1893); *Gormully & Jeffrey Mfg. Co. v. Pope Mfg. Co.*, 34 F. 818 (C.C. Ill. 1888) (venue governed by provisions of the Act of March 3, 1887, ch. 373, 24 Stat. 552, which allowed for venue only in a forum in which the defendant was an inhabitant).

26. Act of 1789, ch. 20, § 11, 1 Stat. 78. See, e.g., *In re Hohorst*, 150 U.S. 653 (1893) (dicta indicating that venue provisions were governed by the venue provisions of the Judiciary Act of 1789, ch. 20, § 11, 1 Stat. 78, which allowed venue in any district in which the defendant was an inhabitant or could be found).

27. See Wydick, *supra* note 23, at 554; Waldrop, *supra* note 23, at 37.

28. See *infra* notes 148-50 and accompanying text.

29. Act of Mar. 3, 1911, ch. 231, § 48, 36 Stat. 1100.

30. Act of June 25, 1948, ch. 646, 62 Stat. 936.

31. *Id.* at § 1400(b). See *supra* note 7.

### C. *The Sole and Exclusive Venue Provision*

#### 1. *Stonite Products*

In *Stonite Products v. Melvin Lloyd Co.*,<sup>32</sup> the Court addressed the issue of whether the patent venue statute, section 48 of the Judicial Code, was the sole provision governing venue in patent infringement actions, or whether the general venue statute, section 52, augmented the patent venue statute.<sup>33</sup> *Stonite Products Company*, an inhabitant of the Eastern District of Pennsylvania was sued for patent infringement in the Western District of Pennsylvania. The district court granted *Stonite*'s motion to dismiss the action for improper venue because *Stonite* did not have a regular and established place of business in the Western District of Pennsylvania.<sup>34</sup> The Court of Appeals for the Third Circuit reversed<sup>35</sup> and the Supreme Court granted certiorari.<sup>36</sup>

Justice Murphy, writing for a unanimous Court, held that section 48 was the exclusive patent venue provision, and therefore was not supplemented by section 52.<sup>37</sup> Justice Murphy found that the patent venue statute was restrictive and that Congress' intent was not to have the patent venue statute "dove-

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32. 315 U.S. 561, 52 U.S.P.Q. 507 (1942).

33. *Id.* at 561-62. 52 U.S.P.Q. 507. Section 48 stated in part:

In suits brought for the infringement of letters patent the district courts of the United States shall have jurisdiction, in law or in equity, in the district of which the defendant is an inhabitant, or in any district in which the defendant, whether a person, partnership, or corporation, shall have committed acts of infringement and have a regular and established place of business.

28 U.S.C. § 109 (1911) (recodified at 28 U.S.C. § 1400(b) (1988)). Section 52 stated in part:

When a State contains more than one district, every suit not of a local nature, in the district court thereof, against a single defendant, inhabitant of such State, must be brought in the district where he resides; but if there are two or more defendants, residing in different districts of the State, it may be brought in either district, and a duplicate writ may be issued against the defendants . . . .

28 U.S.C. § 113 (1911) (recodified at 28 U.S.C. § 1391(c) (1988)).

34. *Melvin Lloyd Co. v. Stonite Prod.*, 36 F. Supp. 29, 47 U.S.P.Q. 339 (W.D. Pa. 1940), *rev'd*, 119 F.2d 883, 49 U.S.P.Q. 476 (3d Cir. 1941), *rev'd*, 315 U.S. 561, 52 U.S.P.Q. 507 (1942).

35. *Melvin Lloyd Co. v. Stonite Prod.*, 119 F.2d 883, 49 U.S.P.Q. 476 (3d Cir. 1941), *rev'd*, 315 U.S. 561, 52 U.S.P.Q. 507 (1942).

36. 314 U.S. 594 (1941), *rev'd*, 315 U.S. 561, 52 U.S.P.Q. 507 (1942).

37. *Stonite*, 315 U.S. at 563, 52 U.S.P.Q. at 508.

tail with the general provisions relating to the venue of civil suits, but rather that it alone should control venue in patent infringement proceedings.”<sup>38</sup>

## 2. *Fourco*

Fourco Glass Company, a West Virginia corporation, was sued for patent infringement in the Southern District of New York.<sup>39</sup> The district court granted Fourco’s motion to dismiss for improper venue, holding that Fourco, though having a regular and established place of business, did not commit an act of infringement within the forum.<sup>40</sup> The Court of Appeals for the Second Circuit reversed and remanded, holding that Fourco “resided” within the forum and, therefore, met the first prong of the patent venue statute because it was “doing business” within the forum.<sup>41</sup> The court acknowledged that the patent venue statute was the exclusive venue provision for patent infringement actions, but reasoned that the definition of “residence” in section 1391(c) must be incorporated within the patent venue statute.<sup>42</sup>

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38. *Id.* at 566, 52 U.S.P.Q. at 509.

39. *Transmirra Prods. v. Fourco Glass Co.*, 133 F. Supp. 531, 106 U.S.P.Q. 305 (S.D.N.Y. 1955), *rev’d*, 233 F.2d 885, 109 U.S.P.Q. 325 (2d Cir. 1956), *rev’d*, 353 U.S. 222, 113 U.S.P.Q. 234 (1957).

40. *Fourco*, 133 F. Supp. at 533, 106 U.S.P.Q. at 306-07.

41. *Fourco*, 233 F.2d at 886, 109 U.S.P.Q. at 325. The Judicial Code of 1948 enacted a general corporate venue statute which stated: “A corporation may be sued in any judicial district in which it is incorporated or licensed to do business or is doing business, and such judicial district shall be regarded as the residence of such corporation for venue purposes.” Act of June 25, 1948, ch. 646, § 1391(c), 62 Stat. 869, 935 (codified at 28 U.S.C. § 1391(c)). The provisions of the patent venue statute were amended to match the current provision. See *supra* notes 30-31.

42. *Fourco*, 233 F.2d at 886, 109 U.S.P.Q. at 325-26. The court considered three reasons for allowing the provisions of section 1391(c) to expand the definition of “residence” in section 1400(b). First, such an interpretation was consistent with the then current trend of expanding the jurisdiction over corporations beyond the “fiction” of a corporation residing only in the state of its incorporation. *Id.* at 887, 109 U.S.P.Q. at 326-27. Second, the court reasoned that it was “unreasonable” to extend “unexpressed exceptions” to limit the “beneficial principle” of expanding jurisdiction over corporations, noting it would be “odd drafting” to provide a “general and unlimited defining statute” with several specific exceptions, one of which was section 1400(b). *Id.* at 888, 109 U.S.P.Q. at 327. Finally, the court discounted the argument that the integration of the two sections would render section 1400(b) superfluous. The court noted that section 1400(b) would still pertain to non-corporate defendants. *Id.*

The Supreme Court granted certiorari<sup>43</sup> to resolve a conflict among the circuits. Some circuits had held that the amendments to the general venue statute, section 1391(c), should be read into the provisions of section 1400(b). This was the holding of the *Fourco* court.<sup>44</sup> Other circuits, however, followed *Stonite* in holding that section 1400(b) was the exclusive venue statute for patent infringement actions.<sup>45</sup> The Supreme Court reversed and remanded for the court of appeals to consider the district court's ruling that there had been no demonstration of an act of infringement within the forum.<sup>46</sup>

Justice Whittaker stated in the majority opinion that section 1400(b) was the "sole and exclusive provision controlling venue in patent infringement actions, and that it [was] not . . . supplemented by . . . § 1391(c)."<sup>47</sup> The Court reiterated its holding in *Stonite* that the patent venue statute was the exclusive venue provision for patent infringement actions.<sup>48</sup> It then considered whether there had been a "substantive change" in the patent venue statute since the *Stonite* decision.<sup>49</sup> The Court examined the alterations to the statutory language and the legislative history of the 1948 Act and determined that no substantive changes had been made to the previous patent venue statute.<sup>50</sup>

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43. 352 U.S. 820 (1956).

44. *Transmirra Prod. v. Fourco Glass Co.*, 233 F.2d 885, 109 U.S.P.Q. 325 (2d Cir. 1956), *rev'd*, 353 U.S. 222, 113 U.S.P.Q. 234 (1957). The Second Circuit in *Fourco* and the Fifth Circuit in *Guiberson Corp. v. Garrett Oil Tools, Inc.*, 205 F.2d 660, 98 U.S.P.Q. 165 (5th Cir. 1953) and *Dalton v. Shakespeare Co.*, 196 F.2d 469, 93 U.S.P.Q. 134 (5th Cir. 1952) held that section 1400(b) was supplemented by section 1391(c).

45. The Third, Seventh, and Tenth Circuits held in *Ackerman v. Hook*, 183 F.2d 11, 86 U.S.P.Q. 1 (3d Cir. 1950), *C-O-Two Fire Equipment Co. v. Barnes*, 194 F.2d 410, 92 U.S.P.Q. 395 (7th Cir. 1952) and *Ruth v. Eagle-Picher Co.*, 225 F.2d 572, 106 U.S.P.Q. 251 (10th Cir. 1955), respectively, that section 1400(b) was the exclusive venue provision for patent infringement actions.

46. *Fourco*, 353 U.S. at 229, 113 U.S.P.Q. at 237.

47. *Id.*

48. *Id.* at 225, 113 U.S.P.Q. at 235.

49. *Id.*

50. *Id.* at 227-28, 113 U.S.P.Q. at 236. The Court relied heavily on the statements of several of the legislation's sponsors who stated "no changes of law or policy will be presumed from changes of language in revision unless an intent to make such changes is clearly expressed", *id.* at 227 n. 8, 113 U.S.P.Q. at 236 n. 8, and on statutory construction which did not allow for an inference of congressional intent to alter a statute's effect when the statute has been revised and consolidated, "unless such intention is clearly expressed." *Id.* at 227, 113 U.S.P.Q. at 236. The Court discounted *Transmirra's* argument that the language of § 1391(c) was clear and unambiguous, and that its provisions



Justice Harlan, in a lone dissent, objected to the Court's undue reliance on the legislative history of the 1948 Act and supported the reasoning of the court of appeals.<sup>51</sup>

### 3. *Schnell*

In *Schnell v. Peter Eckrich & Sons*,<sup>52</sup> the Court considered whether a manufacturer of an allegedly infringing machine had waived its objection to venue by willingly defending one of its customers.<sup>53</sup> Allbright-Nell Company was an Illinois corporation and the manufacturer of a machine for cutting sausage meat which allegedly infringed Schnell's patent.<sup>54</sup> Allbright Nell sold some of the machines to Peter Eckrich & Sons whose principal place of business was in Fort Wayne, Indiana.<sup>55</sup> Schnell sued Eckrich in Indiana for patent infringement.<sup>56</sup> Allbright-Nell retained counsel to defend Eckrich pursuant to its contract of sale. Under the contract, Allbright-Nell agreed to indemnify Eckrich in any infringement action brought against Eckrich arising out of its use of the sausage cutting machine.<sup>57</sup> Schnell amended its complaint to add Allbright-Nell as an additional defendant.<sup>58</sup> Allbright-Nell sought to dismiss for improper venue because it neither resided in nor had a regular and established place of business within Indiana.<sup>59</sup> Schnell conceded that venue was improper against Allbright-Nell under section 1400(b), but argued that it should be deemed to have entered a general appearance by defending Eckrich and had thus waived objection to venue.<sup>60</sup> The Court held that venue was improper and reaffirmed its previous holdings in *Stonite* and *Fourco*.<sup>61</sup>

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should be read with those of § 1400(b), noting that both venue provisions considered in *Stonite* were equally clear and unambiguous. *Id.* at 228, 113 U.S.P.Q. at 237.

51. *Id.* at 229, 113 U.S.P.Q. at 237.

52. 365 U.S. 260, 128 U.S.P.Q. 305 (1961).

53. *Id.* at 260, 128 U.S.P.Q. at 305.

54. *Id.* at 260-61, 128 U.S.P.Q. at 305.

55. *Id.* at 261, 128 U.S.P.Q. at 305.

56. *Id.*

57. *Id.*

58. *Id.*, 128 U.S.P.Q. at 306.

59. *Id.*

60. *Id.* at 261-62, 128 U.S.P.Q. at 306.

61. *Id.* The Court also considered whether the activities of Allbright-Nell before and after it was joined as a party constituted waiver of an objection to venue, and concluded

#### 4. *Brunette Machine*

In *Brunette Machine Works v. Kockum Industries*,<sup>62</sup> Kockum Industries, an Alabama corporation doing business in Oregon, sued Brunette Machine Works, a Canadian corporation. The suit was brought in Oregon for infringement of Kockum's patent on a machine that removed bark from logs.<sup>63</sup> Brunette moved for dismissal for improper venue, claiming that section 1400(b) was the exclusive venue provision for patent infringement actions.<sup>64</sup> The Court of Appeals for the Ninth Circuit reversed the district court's dismissal of the action because Brunette did not "reside" in Oregon and did not have a regular and established place of business there.<sup>65</sup> The court of appeals held<sup>66</sup> and the Supreme Court affirmed,<sup>67</sup> that section 1391(d) applies "to all others" and therefore Brunette as an alien defendant was subject to suit in any district.<sup>68</sup>

Justice Marshall, writing for a unanimous Court, reaffirmed the decisions in *Stonite* and *Fourco*.<sup>69</sup> The Court distinguished the two decisions, however, by explaining that Congress had enacted section 1391(d) as a "principle of broad and overriding application, and not merely as an adjustment to the general venue statute" as occurred in *Stonite* and *Fourco*.<sup>70</sup>

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they did not. *Id.* at 264, 128 U.S.P.Q. 307. The Court stated that "[t]he requirement of venue is specific and unambiguous; it is not one of those vague principles which, in the interest of some overriding policy, is to be given a 'liberal' construction" (citing *Olberding v. Illinois Central R.R.*, 346 U.S. 338, 340 (1953)). *Id.*

62. 406 U.S. 706, 174 U.S.P.Q. 1 (1972).

63. *Id.* at 707, 174 U.S.P.Q. at 1.

64. *Id.*

65. *Kockum Indus. v. Brunette Machine Works*, 442 F.2d 420, 169 U.S.P.Q. 772 (9th Cir. 1971), *aff'd*, 406 U.S. 706, 174 U.S.P.Q. 1 (1972). (The district court opinion is unpublished.)

66. *Id.*

67. *Brunette Machine Works v. Kockum Indus.*, 406 U.S. 706, 174 U.S.P.Q. 1 (1972).

68. *Id.* at 707, 174 U.S.P.Q. at 1.

69. *Id.* at 713, 174 U.S.P.Q. at 4.

70. *Id.* at 714, 174 U.S.P.Q. at 4. The Court relied largely on its opinion in *In re Hohorst*, 150 U.S. 653 (1893), which stated that the general venue statutes were inapplicable to suits against alien defendants. *Brunette*, 406 U.S. at 709-11, 174 U.S.P.Q. at 2-3. The Court noted that Congress had not acted to overturn the reasoning in *Hohorst*. In *Hohorst*, the Court had concluded that holding the venue statutes applicable to actions against alien defendants would "oust the federal courts of jurisdiction." *Id.* at 709, 174 U.S.P.Q. at 2.

## D. Patent Venue Prior to VE Holding

Venue for a corporate defendant in a patent infringement action is determined by either (1) where the defendant resides, or (2) where it has a regular and established place of business and has committed an act of infringement.<sup>71</sup>

### 1. Resides

Prior to the CAFC's opinion in *VE Holding Corp. v. Johnson Gas Appliance Co.*,<sup>72</sup> it had been a virtual maxim of patent law that, for venue purposes, a corporate defendant resides only in the state of its incorporation.<sup>73</sup> The CAFC's decision, however, swept away fifty years of judicial precedent by holding that section 1400(b) was no longer the sole and exclusive patent venue provision and that the term "resides" in section 1400(b) was to be interpreted in conjunction with the definition of "reside" as found in section 1391(c).<sup>74</sup> Now, venue in patent infringement actions will be found proper in any district in which a court has personal jurisdiction over the corporate defendant.<sup>75</sup>

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71. 35 U.S.C. 271(a) (1988). Both provisions of the second prong of section 1400(b) must be met. See *Holab Indus., Inc. v. Wyche*, 290 F.2d 852, 129 U.S.P.Q. 242 (4th Cir. 1961).

72. 917 F.2d 1574, 16 U.S.P.Q.2d 1614 (Fed. Cir. 1990).

73. *Fourco Glass Co. v. Transmirra Products*, 353 U.S. 222, 113 U.S.P.Q. 234 (1957). The decision was founded primarily on the exclusive nature of the patent venue statute. See *supra* notes 39-51 and accompanying text. The definition has gone almost unquestioned by the judiciary. See, e.g., *Picker Int'l Inc. v. Varian Assocs., Inc.*, 661 F. Supp. 347, 2 U.S.P.Q.2d 1964 (N.D. Ohio 1987); *Byrnes v. Jetnet Corp.*, 231 U.S.P.Q. 670 (D. Neb. 1986); *B.W.B. Controls, Inc. v. C.S.E. Automation Eng'g & Servs.*, 587 F. Supp. 1027, 224 U.S.P.Q. 444 (W.D. La. 1984); *Datascope Corp. v. SMEC, Inc.*, 561 F. Supp. 787 (D. N.J. 1983); *Brunswick Corp. v. Suzuki Motor Co.*, 575 F. Supp. 1412, 220 U.S.P.Q. 822 (E.D. Wis. 1983); *Air Factors, Inc. v. Tempmaster Corp.*, 363 F. Supp. 93, 180 U.S.P.Q. 29 (E.D. Wis. 1973); *Faberge, Inc. v. Schick Elec., Inc.*, 312 F. Supp. 559, 165 U.S.P.Q. 592 (D. Del. 1970); *Aileen Mills Co. v. Ojay Mills, Inc.*, 192 F. Supp. 131, 128 U.S.P.Q. 109 (S.D.N.Y. 1960).

*In re Cordis Corp.*, 769 F.2d 733, 16 U.S.P.Q. 784 (Fed. Cir.), cert. denied, 474 U.S. 851 (1985), its only opinion addressing patent venue prior to *VE Holding*, the CAFC also adopted the definition of "resides" established by *Fourco Cordis*, 769 F.2d at 735-36.

74. *VE Holding*, 917 F.2d at 1575, 16 U.S.P.Q.2d at 1614-15.

75. A defendant must have minimum contacts with the forum so that maintaining an action in the forum will not deprive him of his due process rights. See *Asahi Metal Indus. Co. v. Super. Ct. of Cal.*, 480 U.S. 102 (1987); *Burger King Corp. v. Rudzewicz*, 471 U.S. 462 (1985); *World-Wide Volkswagen Corp. v. Woodson*, 444 U.S. 286 (1980);

## 2. Regular and Established Place of Business and Act of Infringement

### a. Regular and Established Place of Business

Two distinct lines of reasoning developed to determine when a corporate defendant maintained a "regular and established place of business" within the forum.<sup>76</sup> The first established that the defendant must have a fixed, physical facility under its substantial control within the forum.<sup>77</sup> Under the other, more liberal approach, the appropriate test is whether the defendant has a "permanent and continuous presence" within the forum.<sup>78</sup>

In *In re Cordis Corp.*,<sup>79</sup> on petition for a writ of mandamus,

*International Shoe Co. v. Washington*, 326 U.S. 310 (1945)

76. For a thorough discussion of earlier courts' approaches, see Annotation, *What Constitutes "Regular and Established Place of Business" Within Meaning of 28 U.S.C.S. § 1400(b). Fixing Venue in Actions for Patent Infringement*, 12 A.L.R. Fed. 502 (1972).

77. An often cited opinion exemplifying this line of reasoning is *Mastantuono v. Jacobsen Mfg Co.*, 184 F. Supp. 178, 126 U.S.P.Q. 38 (S.D.N.Y. 1960). The court stated that a "regular and established place of business" was determined by the following requirements:

Mere "doing business" in a district is not of itself sufficient to confer venue in patent suits. Something more is required. It must appear that a defendant is regularly engaged in carrying on a substantial part of its ordinary business on a permanent basis in a physical location within the district over which it exercises some measure of control.

*Id.* at 180, 126 U.S.P.Q. at 40.

The Seventh Circuit has consistently adopted this viewpoint. See, e.g., *Dual Mfg & Eng'g, Inc. v. Burris Indus., Inc.*, 531 F.2d 1382, 190 U.S.P.Q. 449 (7th Cir. 1976); *University of Illinois Found. v. Channel Master Corp.*, 382 F.2d 514, 155 U.S.P.Q. 117 (7th Cir. 1967); *Grantham v. Challenge-Cook Bros., Inc.*, 420 F.2d 1182, 164 U.S.P.Q. 259 (7th Cir. 1969); *Knapp-Monarch Co. v. Casco Prod. Corp.*, 342 F.2d 622, 145 U.S.P.Q. 1 (7th Cir. 1965).

78. See *In re Cordis Corp.*, 769 F.2d 733, 737 (Fed. Cir.), cert. denied, 474 U.S. 851 (1985); see, e.g., *Instrumentation Specialties Co. v. Water Assocs., Inc.*, 196 U.S.P.Q. 684, (N.D. Ill 1977); *CPG Prod. Corp. v. Mego Corp.*, 214 U.S.P.Q. 129 (S.D. Ohio 1980); *Brunswick Corp. v. Suzuki Motor Co.*, 575 F. Supp. 1412, 220 U.S.P.Q. 822 (E.D. Wis. 1983); *Shelter-Lite, Inc. v. Reeves Bros., Inc.*, 356 F. Supp. 189, 177 U.S.P.Q. 683 (N.D. Ohio 1973).

79. *Cordis* 769 F.2d at 733. *Cordis*, a Florida corporation with its principal place of business in Miami, Florida, was sued by *Medtronic*, a Minnesota corporation, for allegedly infringing *Medtronic's* four patents on pace makers. *Id.* at 734. The district court denied *Cordis's* motion to dismiss for improper venue under § 1400(b), in support of which *Cordis* had contended that a finding of a regular and established place of business required a "fixed, physical location." *Id.* at 734-35. The district court considered that

the CAFC had an opportunity to address the issue of what constitutes a "regular and established place of business."<sup>80</sup> The CAFC concluded that the determination of "whether a corporate defendant has a regular and established place of business in a district . . . is whether the corporate defendant does its business in that district through a permanent and continuous presence there and not . . . whether it has a fixed physical presence . . . ." <sup>81</sup> In reaching its conclusion, however, the CAFC limited the application of its holding by noting that mandamus is "reserved for the most serious and critical ills, and if a rational and substantial legal argument can be made in support of the rule in question, the case is not appropriate for mandamus, even though on normal appeal, a court might find reversible error."<sup>82</sup>

In *Minnesota Mining & Manufacturing v. Johnson & Johnson Products*,<sup>83</sup> the court adopted the "permanent and continuous presence" approach employed in *Cordis*.<sup>84</sup> The court upheld venue in Minnesota due to the defendant's "substantial" presence in the forum, despite the absence of a fixed location.<sup>85</sup> In contrast, the court in *Herbert v. Diagnostic Products*,<sup>86</sup> adopted the more conservative approach, which it found reflected an "older line of authority and apparently the majority rule."<sup>87</sup>

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Cordis employed two fulltime sales representatives within Minnesota, who maintained offices within their homes for which they took income tax deductions and which were used to store Cordis products valued between \$30,000 and \$60,000. *Id.* Cordis was listed in the local telephone directory and employed a secretarial service to answer telephone calls, provide typing services to the two sales representatives, and receive shipments of Cordis sales literature. *Id.*

80. *Id.* at 736-37.

81. *Id.* at 737.

82. *Id.*

83. 1 U.S.P.Q.2d 1992 (D. Minn. 1986).

84. *Id.* at 1994-95. The court acknowledged that the *Cordis* holding had limited application because of the "peculiar procedural posture" of *Cordis*, but noted that the holding nevertheless reflected a majority trend in patent venue cases. *Id.* at 1994.

85. *Id.* at 1996. Johnson & Johnson, a New Jersey corporation, neither owned nor leased office space or property within Minnesota. It had no telephone listings or central location for the receipt of mail. *Id.* It operated through three divisions with aggregate sales over 43 million dollars in Minnesota from 1981 to 1985. Its 1985 sales volume exceeded ten million dollars. Johnson & Johnson also used Minnesota as the base for its activities in surrounding states. *Id.* at 1995-96.

86. 231 U.S.P.Q. 909 (S.D.N.Y. 1986).

87. *Id.* at 912. The court distinguished *Cordis* on the basis of the procedural nature of the appeal and the CAFC's emphasis on the particular facts of the case. *Id.* See also *Omi Int'l Corp. v. MacDermid, Inc.*, 648 F. Supp. 1012, 231 U.S.P.Q. 232 (M.D.N.C.

b. *Act of Infringement*

The analysis employed by the courts concerning what constitutes an "act of infringement" is equally uncertain.<sup>88</sup> As with the first prong of the requirement for venue, two viewpoints have developed interpreting when an act of infringement has occurred in the forum. The more restrictive viewpoint evolved from the Supreme Court's decision in *W.S. Tyler Co. v. Ludlow-Saylor Wire Co.*<sup>89</sup> The contrary approach developed from the reasoning of the Court of Appeals for the Seventh Circuit in *Union Asbestos & Rubber Co. v. Evans Products*.<sup>90</sup>

In *Tyler*, the Court determined that the sale that was the subject of the infringement action must be consummated in the district in which the suit was brought and that the mere solicitation of sales orders in that district did not constitute an act of infringement.<sup>91</sup> The Court's decision spawned a line of reasoning commonly referred to as the "consummated sale doctrine" which determined the concept of "sale" in relation to the term in commercial law.<sup>92</sup> In *Laitram Corp. v. Rexnord, Inc.*,<sup>93</sup> the court determined that venue was proper in the forum in which the contract was made as determined through a contract analysis.<sup>94</sup> The courts in both *Medical Designs v. Orthopedic Technology*<sup>95</sup> and *Picker International v. Varian Associates*<sup>96</sup> upheld the defendants' contention that the term "sale" should be interpreted as defined in the Uniform Commercial Code.<sup>97</sup>

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1986); *Schoofs v. Union Carbide Corp.*, 228 U.S.P.Q. 540 (E.D. Cal. 1985) (adopting the conservative approach). *Contra* *London v. Carson Pirie Scott & Co.*, 4 U.S.P.Q.2d 1148 (N.D. Ill. 1987); *MAGICorp. v. Kinetic Presentations, Inc.*, 718 F. Supp. 334 (D.N.J. 1989) (following the reasoning of *Cordis*).

88. Infringement occurs when the alleged infringer without authority makes, uses, or sells the patented invention. 35 U.S.C. § 271(a) (1988). A lesser showing is necessary, however, to establish venue than is required to prove infringement. *See* *Kaz Mfg. Co. v. Chesebrough-Ponds, Inc.*, 317 F.2d 679, 681, 137 U.S.P.Q. 588, 589 (2d Cir. 1963).

89. 236 U.S. 723 (1915).

90. 328 F.2d 949, 140 U.S.P.Q. 634 (7th Cir. 1964).

91. *Tyler*, 236 U.S. at 725.

92. *In re Amoxicillin Patent and Antitrust Litigation*, 220 U.S.P.Q. 379 (D.D.C. 1982); *Self v. Fisher Controls, Co.*, 566 F.2d 62, 197 U.S.P.Q. 337 (9th Cir. 1977).

93. 226 U.S.P.Q. 971 (D. Md. 1985).

94. *Id.* at 973.

95. 684 F. Supp. 445 (N.D. Tex. 1988).

96. 661 F. Supp. 347, (N.D. Ohio 1987), *aff'd*, 869 F.2d 578 (Fed. Cir. 1989).

97. *Medical Designs*, 684 F. Supp. at 448; *Picker Int'l*, 661 F. Supp. at 350.

In *Union Asbestos*, the seventh circuit rejected the restrictive interpretation established by *Tyler*, finding that it was based on dicta.<sup>98</sup> It concluded that "the technicalities of sales law should not control whether defendant's degree of conduct within the district was sufficient to constitute 'acts of infringement' for venue purposes."<sup>99</sup> The court held that the demonstrations of the allegedly infringing device, coupled with the "systematic and continuous solicitation of orders within the district," were sufficient to establish venue.<sup>100</sup>

### III. *VE Holding Corp. v. Johnson Gas Appliance Co.*

#### A. *Background*

The case of *VE Holding* arose from an appeal of a district court decision granting a motion by the co-defendant, Johnson Gas Appliance Company (Johnson Gas), to dismiss for improper venue.<sup>101</sup> VE Holding Corporation (VE Holding) had filed an action in the district court for the Northern District of California against California Pellet Mill Company and Johnson Gas for alleged direct and contributory infringement of its patents.<sup>102</sup> Johnson Gas moved to dismiss for improper venue because, as an Iowa corporation, it did not "reside" in California.<sup>103</sup> VE

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98. 328 F.2d 949, 951 (7th Cir. 1964). According to the court, the Supreme Court had already determined that venue was improper because of the failure to meet the "regular and established place of business" provision, and therefore the additional commentary on acts of infringement was dicta. *Id.*

99. *Id.* at 952.

100. *Id.*

101. *VE Holding Corp. v. Johnson Gas Appliance Co.*, No. C89-3856SCENE, slip op. at 1 (N.D. Cal. Feb. 9, 1990). The case was actually the consolidation of two separate actions brought by VE Holding against Johnson Gas. VE Holding brought its initial action on January 24, 1989. The district court dismissed the action against Johnson Gas for improper venue on May 19, 1990. VE Holding subsequently refiled the same action against Johnson Gas in the same court on October 26, 1989. The two actions were consolidated on November 3, 1989. VE Holding's refile was prompted by a technicality involving the effective date of the Act on February 27, 1989. As the date of the original complaint preceded the effective date of the Act, the court's initial decision would not allow for an appeal regarding the applicability of the amendments to section 1391(c). The district court entered a final judgment on February 9, 1990. *Id.* at 1-2.

102. *Id.* VE Holding holds three U.S. patents, numbers 4,667,418, 4,704,804 and 4,731,938, for the treatment and temperature conditioning of various material in an anaerobic environment. *Id.* (Court of Appeals indicated the incorrect patent numbers).

103. *Id.*

Holding responded that the new broad definition of "reside" found in section 1391(c), allowing for venue when personal jurisdiction could be obtained over the defendant, should expand the definition of "reside" in section 1400(b).<sup>104</sup> VE Holding predicated its argument on the phrase "[f]or purposes of venue under this chapter" as contained in the amended section 1391(c).<sup>105</sup> It also asserted that the statute's plain language indicated congressional intent to expand the scope of "reside" in section 1391(c) to cover all venue provisions contained in the chapter, including 1400(b).<sup>106</sup> Several district courts had already issued conflicting decisions interpreting the effect of the amendment to section 1391(c) on section 1400(b).<sup>107</sup>

### B. *The District Court Opinion*

In granting the motion to dismiss, the court rejected VE Holding's contention that the new language of section 1391(c) should be interpreted to expand its scope to that of section 1400(b).<sup>108</sup> The court recognized that a "literal interpretation [of section 1391(c)] against a fresh backdrop would demand that its definition of 'reside' be applied to section 1400(b)," but noted that it was "not free to interpret sections 1391(c) and 1400(b) without considering [the] binding precedent" established by *Fourco Glass Co. v. Transmirra Prods.*

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104. *Id.* slip op. at 3. VE Holding also contended that Johnson Gas maintained a regular and established place of business in California. *VE Holding Corp. v. Johnson Gas Appliance Co.*, 917 F.2d 1574, 1576, 16 U.S.P.Q.2d 1614, 1615. The court, however, rejected VE Holding's argument in its May 19 opinion. In the subsequent action, VE Holding focused on the "residence" argument to sustain venue. *VE Holding*, slip op. at 2. The district court obtained personal jurisdiction over Johnson Gas through Johnson Gas' failure to join motions to dismiss for lack of personal jurisdiction in its motions to dismiss for improper venue pursuant to Rules 12(g) and 12(h)(1)(A) of the Federal Rules of Civil Procedure.

105. *Id.*

106. *Id.*

107. *See, e.g., Doelcher Prod. v. Hydrofoil Int'l*, 735 F. Supp. 666, 14 U.S.P.Q.2d 1067 (D. Md. 1989) (holding amendment to Section 1391(c) did not supplement provisions of Section 1400(b)); *Joslyn Mfg. Co. v. Amerace Corp.*, 729 F. Supp. 1219, 14 U.S.P.Q.2d 1223 (N.D. Ill. 1990) (holding similar to *Doelcher*); *Century Wrecker Corp. v. Vulcan Equip. Co.*, 733 F. Supp. 1170, 13 U.S.P.Q.2d 1715 (E.D. Tenn. 1989) (holding similar to *VE Holding*); *Regents of Univ. of Cal. v. Eli Lilly & Co.*, 734 F. Supp. 911, 14 U.S.P.Q.2d 1909 (N.D. Cal. 1990) (holding similar to *VE Holding*); *Oakley Inc. v. Smith Sports Optics Inc.*, 16 U.S.P.Q.2d 1472 (C.D. Cal. 1990) (holding similar to *VE Holding*).

108. *Id.* slip op. at 2-3.



*Fourco* unequivocally established section 1400(b) as the sole and exclusive patent venue statute.<sup>109</sup> The district court in *VE Holding* acknowledged that the Supreme Court's reasoning in *Fourco* relied on the "history and purpose" of section 1400(b) and not on its interpretation of the language of section 1391(c).<sup>110</sup> The court noted that Congress may supercede a Supreme Court interpretation by amending the subject statute. However, rules of statutory construction require courts to presume that in the absence of an express statement to the contrary, a legislature's intent is not to negate a long-standing precedent.<sup>111</sup> The court stated that "unless it is obvious that Congress intended to overturn the *Fourco* Court's determination of section 1400(b)'s purpose . . . too much weight [should not be given] to a change in the language of section 1391(c) when determining the scope of section 1400(b)."<sup>112</sup>

The court found that the legislative history of section 1391(c) "manifests a concern wholly unrelated to altering the historical exclusivity of section 1400(b)."<sup>113</sup> Rather, it demonstrated that Congress amended section 1391(c) to allow for venue in any district in a multidistrict state.<sup>114</sup> The court concluded that there was insufficient evidence of Congress' intent to alter the "historical exclusivity" of section 1400(b).<sup>115</sup> Additionally, the court stated that the interpretation advanced by *VE Holding* would render the second portion of section 1400(b) superfluous, thereby violating the "cardinal rule" of statutory construction that each part of an act should have meaning.<sup>116</sup>

### C. *The CAFC Opinion*

The CAFC agreed to hear *VE Holding*'s appeal in order to resolve the conflict among district courts over the proper inter-

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109. *Id.* slip op. at 4.

110. *Id.* slip op. at 5.

111. *Id.*

112. *Id.* slip op. at 5.

113. *Id.* slip op. at 6. The court considered the evidence of legislative history presented by *VE Holding* to be inconclusive and "too tenuous . . . to find conclusively that Congress intended to change the scope of section 1400(b)." *Id.*

114. *Id.*

115. *Id.* slip op. at 5-6.

116. *Id.* slip op. at 7.

pretation of the relationship between sections 1391(c) and 1400(b).<sup>117</sup> The CAFC reversed and remanded, holding that Congress intended the definition of "reside" in section 1391(c) to apply to all venue provisions within the chapter, including section 1400(b).<sup>118</sup>

Judge Plager, writing for a unanimous court,<sup>119</sup> limited *Fourco* and its progeny by categorizing them as isolated interpretations of then-current statutory language rather than as general interpretations of the history and purpose of section 1400(b).<sup>120</sup> He narrowed the analysis to an inquiry of Congress' intent in adopting the amendments to section 1391(c).<sup>121</sup>

Judge Plager began his analysis by reviewing the plain language of the statute, noting that where the language is clear and unambiguous, the plain meaning will be treated as dispositive.<sup>122</sup> Judge Plager concluded that the language of section 1391(c) was both clear and unambiguous, and that "[s]ection 1391(c) applies to all of chapter 87 of title 28, and thus to section 1400(b), as expressed by the words 'For purposes of venue under this chapter.' There can be no mistake about that."<sup>123</sup>

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117. *VE Holding Corp. v. Johnson Gas Appliance Co.*, 917 F.2d 1574, 1575, 16 U.S.P.Q.2d 1614, 1615 (Fed. Cir. 1990). On March 22, 1990, the CAFC also granted a petition for appeal in *Century Wrecker*, 902 F.2d 43 (Fed. Cir. 1990).

118. *VE Holding*, 917 F.2d at 1575-76, 1578-79, 16 U.S.P.Q.2d at 1614, 1616-17.

119. Judges Archer and Clevenger concurred in the opinion.

120. Judge Plager made short shrift of fifty years of judicial precedent, including four major Supreme Court decisions, in the following few sentences:

The specific question in *Fourco* was whether the statutory language previously enacted by the Congress as § 1391(c) supported a conclusion that Congress intended to have §§ 1391(c) and 1400(b) read together. On the basis of the nonspecific language of § 1391(c) and prior history as the Court read it, the Court concluded the answer was no.

Section 1391(c) as it was in *Fourco* is no longer. We now have exact and classic language of incorporation: "For purposes of venue under this chapter. . . ." Congress could readily have added "except for section 1400(b)," if that exception, which we can presume was well known to the Congress, was intended to be maintained. . . .

The issue, then, is not whether the prior cases, including Supreme Court cases, determined that under different statutory language Congress' intent was that § 1400(b) stood alone. The issue is, what, as a matter of first impression, should we conclude the Congress *now* intends by this new language in the venue act.

*Id.* at 1579, 16 U.S.P.Q.2d at 1616-18 (emphasis in original).

121. *Id.*

122. *Id.* at 1578-79, 16 U.S.P.Q.2d at 1616-17.

123. *Id.* at 1580, 16 U.S.P.Q.2d at 1616-17.

Judge Plager did not apply the rule of statutory interpretation that states that general statutes do not control or nullify specific statutes, absent a clear legislative expression to the contrary.<sup>124</sup> He gave two reasons to allow the general provision of section 1391(c) to control those of section 1400(b). First, the language of section 1391(c) "expressly reads itself into" section 1400(b).<sup>125</sup> Second, the provisions of section 1391(c) only define a single term contained in section 1400(b) and do not govern patent venue or provide a separate rule for its operation.<sup>126</sup> Even if the statutory rule were applicable, the court stated that the language of section 1391(c) provided " 'a clear intention' that §1391(c) is to supplement § 1400(b)."<sup>127</sup>

Judge Plager buttressed the court's holding by determining that the legislative history of the Act revealed that Congress did not intend to contradict the plain meaning of the statute.<sup>128</sup> Finding no specific legislative history, Judge Plager decided that he was justified in relying on the plain language of the statute.<sup>129</sup> He invoked the rule that Congress' knowledge of established judicial precedent may be presumed by a court interpreting legislation.<sup>130</sup> In support of this presumption, Judge Plager indicated that the amendments were the result of much compromise and debate in Congress.<sup>131</sup> He further found that the compromises

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124. *Id.*, 16 U.S.P.Q.2d at 1618.

125. *Id.*

126. *Id.* Judge Plager countered the position taken by the district court that the CAFC's decision would render the second test under section 1400(b) superfluous and therefore meaningless, by stating that this position "overlooks that § 1400(b) applies to all defendants, not just corporate defendants, and thus the second test for venue remains operative with respect to defendants that are not corporations." *Id.* at 1580 n.17, 16 U.S.P.Q.2d at 1618 n. 17 (emphasis in original).

127. *Id.* at 1580, 16 U.S.P.Q.2d at 1618.

128. *Id.*

129. *Id.* at 1580-81, 16 U.S.P.Q.2d at 1618-19. The court quoted the Supreme Court's decision in *United States v. Locke*, 471 U.S. 84, 95 (1985) which stated: "deference to the supremacy of the Legislature, as well as recognition that Congressmen typically vote on the language of a bill, generally requires [courts] to assume that 'the legislative purpose is expressed by the ordinary meaning of the words used.'" (quoting *Richards v. United States*, 369 U.S. 1, 9 (1962)). *VE Holding*, 917 F.2d at 1581, 16 U.S.P.Q.2d at 1619.

130. *Id.* (citing *Goodyear Atomic Corp. v. Miller*, 486 U.S. 174, 184-85 (1988)).

131. *Id.* at 1581-82, 16 U.S.P.Q.2d at 1619. The court cited the following statements made by Senator Heflin, Chairman of the Subcommittee on Courts and Administrative Practice, regarding a group of proposed provisions which included the amendments to

and debate are significant in that "strict adherence to the language and structure of an Act is particularly appropriate where . . . a statute is the result of a series of carefully crafted compromises."<sup>132</sup>

Judge Plager further stated that the court's interpretation of the effects of section 1391(c) on section 1400(b) was so predictable that Congress must have intended that result.<sup>133</sup> As evidence of the probability that Congress intended the result adopted by the court, he referred to: academic criticisms of section 1400(b);<sup>134</sup> a 1974 resolution adopted by the Patent, Trade-mark and Copyright Section of the American Bar Association advocating that the term "resides" in section 1400(b) be defined by section 1391(c);<sup>135</sup> the disparity between venue requirements

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section 1391(c):

Title X consists of 23 miscellaneous provisions to improve the administration of justice. Most come from specific recommendations of the Judicial Conference as developed over the past several years as problems surface. The source and merits of the various provisions are discussed in the section-by-section analysis. *This bill represents numerous hours of negotiation and compromise.*

*Id.* at 1581, 16 U.S.P.Q.2d at 1619 (emphasis in original) (citation omitted).

The court also cited the decision in *Century Wrecker Corp. v. Vulcan Equip. Co.*, 733 F. Supp. 1170, 1173, 13 U.S.P.Q.2d 1715, 1717 (E.D. Tenn. 1989) which noted that the phrase "for purposes of venue under this chapter" was included in the proposed redraft of section 1391(c) as early as December, 1985, and that the phrase had not been amended or modified in two years of consideration of the amendments to section 1391(c). *VE Holding*, 917 F.2d at 1582, 16 U.S.P.Q.2d at 1619-20.

Finally, the court quoted a memorandum from Professor Edward H. Cooper, the reporter for the Judicial Conference Subcommittee, to the Subcommittee explaining the proposed modifications to section 1391(c):

The [new] definition of corporate residence in § 1391(c) now provides a basis for applying the substantial number of venue statutes enacted as part of the various substantive federal laws. *As a matter of caution, the proposal limits its definition of residence to the venue provisions gathered in Chapter 87 of the Judicial Code, 28 U.S.C. § § 1391 through 1412.*

*Id.* at 1582, 16 U.S.P.Q.2d at 1620 (emphasis in original) (citation omitted).

132. *Id.* (quoting *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 748 n.14, 10 U.S.P.Q.2d 1985, 1993 n.14 (1989)).

133. *Id.* at 1583, 16 U.S.P.Q.2d at 1620-21.

134. *Id.* at 1582-83, 16 U.S.P.Q.2d at 1620-21. Judge Plager cited the discussion of Congress' original intent in adopting section 1400(b) contained in Wydick, *Venue in Actions for Patent Infringement*, 25 STAN. L. REV. 551 (1973) and Waldrop, *The Patent Venue Statute*, 28 U.S.C. § 1400(b) *Should Not Be Repealed*, 4 A.P.L.A. Q. J. 32 (1976).

135. *VE Holding*, 917 F.2d at 1583, 16 U.S.P.Q.2d at 1621. The court quoted the Section's opinion that the Supreme Court's interpretation of section 1400(b) in *Fourco* was the result of "historical accident". *Id.*

for declaratory judgments and patent infringement actions;<sup>136</sup> and a statement by Justice White.<sup>137</sup>

#### IV. Criticism of the Patent Venue Statute

Judge Plager concluded the CAFC's opinion in *VE Holding* with the observation that a more suitable resolution to the issue would be congressional repeal of section 1400(b). Venue in patent infringement actions would then be governed entirely by the general venue statute.<sup>138</sup> The court's dicta reflects years of controversy over, and criticism of, section 1400(b).

Since 1965, the Patent, Trademark and Copyright Section of the American Bar Association (Patent Section) has proposed six separate resolutions addressing section 1400(b).<sup>139</sup> The latest

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136. *Id.* at 1583, 16 U.S.P.Q.2d at 1620. The court indicated that its decision would bring "the law of venue in patent cases more in line with venue law generally, as well as with other types of patent litigation." *Id.* at 1583-84, 16 U.S.P.Q.2d at 1621.

137. *Id.* (The court incorrectly attributed the quote to Justice White. Justice Marshall was the author of the Court's opinion in *Brunette Machine Works, Ltd. v. Kockum Indus.*, 406 U.S. 706, 174 U.S.P.Q. 1 (1972)). The court quoted the following statement:

Ironically, changes in the general venue law have left the patent venue statute far behind. Since 1948, the general venue law has authorized suit against a corporate defendant not only where he maintains a "regular and established place of business" as in § 1400(b), but also where he is "doing business." 62 Stat. 935, now § 1391(c). And since 1966, the general venue law has authorized suit where "the claim arose . . ."

*Id.* (quoting *Brunette Machine Works, Ltd. v. Kockum Indus.*, 406 U.S. 706, 713 n.13, 174 U.S.P.Q. 1, 3-4 n.13 (1972)).

138. *Id.* at 1583, 16 U.S.P.Q.2d at 1620-21.

139. The Patent Section proposed five resolutions regarding section 1400(b) prior to the 1989 resolution. The current resolution represents a gradual change in position of the Patent Section toward section 1400(b).

The resolution proposed in 1965 opposed the adoption of proposed legislation to repeal Section 1400(b). Clark, *Proposal to Repeal Special Venue Section Relating to Patent Infringement Actions*, 1965 A.B.A. SEC. PAT. TRADEMARK AND COPYRIGHT L. 148. The Patent Section relied on the Supreme Court's decisions in *Stonite*, *Fourco*, and *Schnell*, and on congressional history that indicated that "the forum of a patent infringement action should be one reasonably convenient to the defendant." *Id.* at 149. The committee further noted that Section 1400(b) represented legislative policy which recognized the "technical and intricate nature of patent litigation" and that "practicality and convenience" were best served by the provision of Section 1400(b). *Id.*

In 1966, the Patent Section recommended expanding the scope of "resides" to include "any state in which it is incorporated or of any judicial district in which it has a principal place of business." Wyss, *Proposal to Amend Special Venue Statute Relating to Patent Infringement Actions*, 1966 A.B.A. SEC. PAT. TRADEMARK AND COPYRIGHT L. 122. The committee stated the proposed modification to Section 1400(b) would "decrease the possibility of future attempts" to repeal section 1400(b). *Id.* at 123.

resolution, proposed in 1989, favored the legislative repeal of section 1400(b).<sup>140</sup>

The Patent Section provided several reasons in support of its resolution which illustrate the most frequently advanced criticisms of section 1400(b). First, the Patent Section criticized the Supreme Court's interpretation in *Stonite* and *Fourco* of section 1400(b) as the exclusive venue provision for patent infringement,<sup>141</sup> and it criticized the Court for restricting "resides" to the defendant's state of incorporation.<sup>142</sup> The Patent Section re-

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In 1974, the Patent Section proposed an amendment to section 1400(b) providing that the definition of "residence of a corporation" in section 1391(c) be used as the definition of "resides" under section 1400(b). Gess, *Desirability of Initiating Patent Litigation Wherever the Defendant is Found*, 1974 A.B.A. SEC. PAT. TRADEMARK AND COPYRIGHT L. 114.

The Patent Section cited several reasons for its recommendation. First, they believed the interpretation adopted by the Supreme Court in *Fourco*, was the result of "historical accident" which "create[d] confusion in the courts and . . . unduly shield[ed] a corporate infringer." *Id.* at 115. Second, under an action for declaratory judgment, "the plaintiff/alleged infringer [has a] wider latitude in his choice of forum than the patentee" because venue for declaratory judgment actions is governed by § 1391(c). *Id.* Third, other special venue statutes had been held to be supplemented by section 1391(c). *Id.* Finally, the Patent Section found that the Act of 1897, which created the predecessor to § 1400(b), was "intended to eliminate the abuses that resulted from the absence of [28 U.S.C.] Section 1404(a)" which provides for the transfer of venue to another forum at the court's discretion. *Id.* At the time of the Act of 1897, there was no provision for venue transfer and an alleged infringer could be sued in any forum in which he could be found. *Id.* The Patent Section felt that its current recommendation would put the choice of venue back within the discretion of the courts through the operation of the transfer of venue statute, 28 U.S.C. § 1404(a)(1988). *Id.* at 115-16.

In 1975, Subcommittee A of the Committee on Enforcement of Patents proposed a legislative amendment to implement the 1974 resolution. Schneider, *Extending the Patent Venue Statute with Respect to Corporations*, 1975 A.B.A. SEC. PAT. TRADEMARK AND COPYRIGHT L. 84. The Subcommittee recommended expanding the scope of "resides" to include the judicial district in which the corporate defendant is licensed to do business or is doing business. *Id.* at 85. The Subcommittee felt a deletion of section 1400(b) without additional changes might create more confusion and ambiguities when the courts determined venue under the existing general venue provisions. *Id.*

Subcommittee B of the Committee on Federal Practice and Procedure also proposed a revision to section 1400(b) in 1975. Bosses, *Revision of the Patent Venue Statute*, 1975 A.B.A. SEC. PAT. TRADEMARK AND COPYRIGHT L. 185. The Subcommittee recommended the deletion of the "act of infringement" provision from section 1400(b), leaving only the "resides" and "regular and established place of business" requirements. *Id.*

140. Peterson, *Repeal of the Patent Venue Statute*, 1989 A.B.A. SEC. PAT. TRADEMARK AND COPYRIGHT L. 240. The A.B.A. delegates adopted a similar resolution in February 1991.

141. Peterson, *supra* note 140, at 243.

142. *Id.*

lied extensively on the criticisms propounded by James Geriak<sup>143</sup> and Professors Wydick,<sup>144</sup> Wright,<sup>145</sup> and Moore,<sup>146</sup> in support of its position.<sup>147</sup>

Professor Wydick advocated a repeal of section 1400(b), stating that its "original purpose has been frustrated by judicial opinions, and its continued existence serves merely to consume the time and effort of lawyers and judges and to strain the purses and patience of persons seeking prompt, efficient adjudication of their rights."<sup>148</sup> Professor Wydick contended that in *Stonite*<sup>149</sup> the Supreme Court misinterpreted Congress' legislative intent. He concluded that the purpose of the patent venue statute was to expand the venue options of plaintiffs in patent infringement actions and that it was not a narrower, more restrictive provision, as the Supreme Court had determined.<sup>150</sup> Professor Wydick further contended that the *Fourco* decision resulted from an uncritical analysis of the earlier *Stonite* decision.<sup>151</sup>

The Patent Section also criticized the Supreme Court's restrictive interpretation of section 1400(b) in *Fourco* and *Stonite* because it prevented patent venue from expanding along with the expansion of venue under section 1391(c).<sup>152</sup> The Patent Section commented that "the general venue provisions have changed to reflect modern day business practices, [but] the patent venue provisions have not, and remain essentially locked to the business environment of 1897."<sup>153</sup>

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143. See Geriak, *Fifteen Years of Fourco — The Needless Disputes Over Patent Venue*, 24 HASTINGS L.J. 55 (1972).

144. See Wydick, *supra* note 23.

145. See WRIGHT, *supra* note 14, at § 3823.

146. See 1A J. MOORE, W. TAGGART, A. VESTAL, J. WICKER & B. RINGLE, MOORE'S FEDERAL PRACTICE ¶ 0.344 at 4240-60 (2d ed. 1990).

147. See Peterson, *supra* note 140, at 243-44.

148. See Wydick, *supra* note 23, at 551.

149. *Id.* at 557-58.

150. *Id.*

151. *Id.* at 559. See also Geriak, *supra* note 143, at 56-60; MOORE, *supra* note 146, ¶ 0.44[9], at 4244-51; WRIGHT, *supra* note 14, § 3823, at 135-39.

152. See Peterson, *supra* note 140, at 243.

153. *Id.* at 245. For emphasis, the Patent Section referred to Justice Marshall's comment in *Brunette*, see *supra* note 137, and to the expanded scope of section 1391(c) created by the Judicial Improvements Act, see *supra* note 2. *Id.* Ironically, the Section mentioned that the expanded venue offered under section 1391(c) will most likely have

The second advantage of repeal would be to clarify the ambiguous and conflicting case law interpreting the phrases "regular and established place of business" and "acts of infringement," thereby making venue interpretations easier and reducing the cost and time of litigating venue decisions.<sup>154</sup> The conflicting judicial interpretations of the terms "acts of infringement" and "regular and established place of business" in section 1400(b) have created an unworkable body of law and result in much unnecessary and expensive litigation.<sup>155</sup> Even with a judicial resolution by the CAFC of the conflicting case law, repeal of section 1400(b) would still be needed to alleviate the restrictive interpretation of section 1400(b) created by *Fourco* and *Stonite*.<sup>156</sup>

Finally, repeal would eliminate the disparity between venue provisions for patent infringement actions and those for declaratory judgment actions.<sup>157</sup> The current interpretation of section 1400(b) creates a disparity between patent infringement actions and declaratory judgment actions, which are governed by section 1391(c).<sup>158</sup> Most of the evidence presented under both actions is identical; however, the determination of venue depends on which party files first — the alleged patent infringer (for a declaratory judgment) or the patentee (for infringement).

Professor Wydick discounted the benefit of conducting trial at the defendant's corporate headquarters because of the availability of witnesses and documents, principally because other "complex" litigation with similar evidentiary requirements is governed by the general venue statutes.<sup>159</sup> The Patent Section stated unequivocally that there is no justification for maintain-

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no effect on the current interpretation of section 1400(b). *Id.* at 243-44.

154. *Id.* See also Wydick, *supra* note 23, at 573-81.

155. See Peterson, *supra* note 140, at 246.

156. *Id.* at 243.

157. *Id.* at 243; see also Geriak, *supra* note 143, at 61.

158. See Peterson, *supra* note 140, at 243.

159. *Id.* at 247 (citing cases in which provisions of the general venue statutes were found to supplement other special venue statutes: *Pure Oil Co. v. Suarez*, 384 U.S. 202 (1966) (Jones Act); *Vermont Castings, Inc. v. Evans Prods.*, 510 F. Supp. 940 (D. Vt. 1981) (antitrust venue provision)). The discussion further noted that current judicial interpretations have allowed venue far from a corporate defendant's headquarters. *Id.* (citing *London v. Carson Pirie Scott & Co.*, 4 U.S.P.Q.2d 1148 (N.D. Ill. 1987) (venue established in Northern District of Illinois under "regular and established place of business" test by activities of three employee/salespersons residing in forum)).



ing a special venue statute for patent law.<sup>160</sup> The arguments advanced to justify its existence, particularly the argument that patent litigation involves technical and complex material requiring a forum convenient to the defendant, are undermined by the fact that other technical areas of law do not require special venue provisions.<sup>161</sup> Furthermore, a transfer of venue under Section 1404(a) is available to a defendant if an action is in an improper venue.<sup>162</sup>

## V. Analysis

### A. *The CAFC's decision in VE Holding*

The CAFC began its analysis with the language of the statute, but failed to consider Supreme Court precedent in the area of patent venue.<sup>163</sup> The CAFC dismissed the Court's decision in *Fourco*<sup>164</sup> as an isolated interpretation of the statutory language in effect at that time.<sup>165</sup> Instead, the CAFC addressed the issue as one of "first impression"<sup>166</sup> — an approach the Supreme Court did not find objectionable.<sup>167</sup>

If the concept of stare decisis is to be preserved, then the district court's approach in *VE Holding* is the correct one in light of the Court's previous decisions. Although the district court acknowledged that *VE Holding*'s arguments were compelling, it found that the Supreme Court had clearly established section 1400(b) as the sole and exclusive patent venue statute. It therefore appropriately held that the Supreme Court's rules

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160. See Peterson, *supra* note 140, at 247.

161. *Id.*

162. *Id.*

163. The court ignored the Supreme Court's decisions in *Stonite*, *Schnell* and *Brunette*.

164. 353 U.S. 222, 113 U.S.P.Q. 234 (1957).

165. *VE Holding Corp. v. Johnson Gas Appliance Co.*, 917 F.2d 1574, 1579, 16 U.S.P.Q.2d 1614, 1617-18 (Fed. Cir. 1990).

166. *Id.* at 1575, 16 U.S.P.Q.2d at 1614.

167. The Supreme Court's denial of the writ of certiorari is in keeping with its recent liberal approach to stare decisis. See Eskridge, *Overruling Statutory Precedents*, 76 GEO. L.J. 1361 (1988); Greenhouse, *A Longtime Precedent for Disregarding Precedent*, N.Y. TIMES, July 21, 1991, at E4. A major reason behind Congress' creation of the CAFC, however, was to remedy the lack of Supreme Court review of cases in patent law. See S. REP. NO. 275, 97th Cong., 2d Sess. 4 (1981), reprinted in 1982 U.S. CODE CONG. & ADMIN. NEWS 11, 14-15. Clearly, the few opinions that exist should be accorded great weight.

must be followed unless the Court or Congress expressly overturns the Court's decisions.<sup>168</sup>

The CAFC also misapplied its stated rules of statutory interpretation. It attempted to distinguish the well established principle of statutory interpretation that a specific statute is not controlled or nullified by a general statute.<sup>169</sup> In *Radzanower v. Touche Ross & Co.*,<sup>170</sup> the Supreme Court stated the rule as: "a statute dealing with a narrow, precise, and specific subject is not submerged by a later enacted statute covering a more generalized spectrum."<sup>171</sup> The opinions cited by the Court in *Radzanower* as authority for this principle considered the manner in which the provisions of the general statute affected those of the specific statute. The only consideration given was whether the legislature had manifested a "clear intention" to have the general statute affect the specific statute.<sup>172</sup> The Court provided several rules for determining whether a "clear intention" is present. The Court stated that "[i]t is, of course, a cardinal principle of statutory construction that repeals by implication are not favored."<sup>173</sup> A general statute may repeal a specific one by implication only if the two are in "irreconcilable conflict" or "if the later act covers the whole subject of the earlier one and is clearly intended as a substitute . . ."<sup>174</sup> According to the rules outlined in *Radzanower*, the CAFC should have found that there was insufficient legislative history to conclude that Congress intended to modify section 1400(b).

The CAFC attempted to circumvent the lack of legislative history by presuming that Congress must have been aware of the effect the section 1391(c) amendments would have on section

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168. *VE Holding Corp. v. Johnson Gas Appliance Co.*, No. C89-3856SCENE, slip op. at 3-4 (N.D. Cal. Feb. 9, 1990).

169. *VE Holding*, 917 F.2d at 1580.

170. 426 U.S. 148 (1976).

171. *Id.* at 153. The Court cites as further authority *Brown v. GSA*, 425 U.S. 820 (1976); *Morton v. Mancari*, 417 U.S. 535, 550-51 (1974); *Bulova Watch Co. v. United States*, 365 U.S. 753, 758 (1961); *Fourco Glass Co. v. Transmirra Prod. Corp.*, 353 U.S. 222, 113 U.S.P.Q. 234 (1957); *Stonite Prod. Co. v. Melvin Lloyd Co.*, 315 U.S. 561, 52 U.S.P.Q. 507 (1942); *Rodger v. United States*, 185 U.S. 83, 87-89 (1902); *Ex Parte Crow Dog*, 109 U.S. 556, 570-71 (1883).

172. *Id.* at 154.

173. *Id.* (quoting *United States v. United Continental Tuna Corp.*, 425 U.S. 164, 168 (1976)).

174. *Id.* (quoting *Posadas v. National City Bank*, 296 U.S. 497, 503 (1936)).

1400(b).<sup>175</sup> The CAFC supported its presumption by quoting Senator Heflin's statement that the amendments were the result of numerous compromises and debates.<sup>176</sup> In doing so the CAFC misapplied the rule of statutory construction employed by the Supreme Court in *Community for Creative Non-Violence v. Reid*,<sup>177</sup> that strict adherence to the statutory language is appropriate when the language results from a series of carefully considered compromises.<sup>178</sup> The statement by Senator Heflin<sup>179</sup> clearly applies to the entire Judicial Improvements and Access to Justice Act and not to the specific amendment of section 1391(c).

Finally, the CAFC's opinion failed to address the impact its decision would have on the remainder of section 1400(b). As the district court noted, a holding similar to the CAFC's would render the second prong of section 1400(b) meaningless.<sup>180</sup> In *VE Holding*, the CAFC addressed this issue by noting that section 1400(b) would still apply to noncorporate defendants.<sup>181</sup> This argument, although outwardly plausible, is erroneous because a review of patent infringement cases produces few, if any, non-corporate defendant.<sup>182</sup>

The CAFC's holding goes beyond rendering the second prong of section 1400(b) useless: it eliminates the entire concept of patent venue for corporate defendants because the court has equated personal jurisdiction with venue.<sup>183</sup> Although Congress

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175. *VE Holding Corp. v. Johnson Gas Appliance Co.*, 917 F.2d 1574, 1581, 16 U.S.P.Q.2d 1614, 1619 (Fed. Cir. 1990).

176. *Id.* See *supra* note 131 for the text of Senator Heflin's statement.

177. 490 U.S. 730, 10 U.S.P.Q.2d 1985 (1989).

178. *Id.* at 738 n.14, 10 U.S.P.Q.2d at 1993 n.14. See *supra* note 131.

179. See *supra* note 131.

180. *VE Holding Corp. v. Johnson Gas Appliance Co.*, No. C89-3856SCENE, slip op. at 7 (N.D. Cal. Feb. 9, 1990).

181. See *supra* note 126.

182. It has been noted that fewer patents are granted each year to individuals and that recently Japanese corporations have been granted more patents than American corporations. See Schlesinger, *An Open Letter to President George Bush*, 73 J. PAT. & TRADEMARK OFF. SOC'Y 484, 485 (1991).

183. It can be argued that the current version of 1391(c) is unconstitutional because of its complete elimination of venue for corporate defendants. See Cox, *Jurisdiction, Venue, and Aggregation of Contacts: The Real Minimum Contacts and Federalism Questions Raised by Omni Capital, International v. Rudolph Wolff & Co.*, 42 ARK. L. REV. 211 (1989) (contending that a separate constitutional right exists for venue separate and distinct from personal jurisdiction).

may have intended such a dramatic occurrence for the general venue statute, it cannot be assumed that such a result was intended for the patent venue statute without more substantive indications.<sup>184</sup>

### B. *The Need for a Unique Patent Venue Statute*

Critics of the statute have correctly observed that a judicial interpretation of the statute would not clarify the convoluted and ambiguous case law interpreting the phrases "regular and established place of business" and "act of infringement." Moreover, such a decision would not remove the disparity between the venue provisions for patent infringement actions and other patent related actions.<sup>185</sup> Almost unanimously, these critics have advocated repeal of section 1400(b).<sup>186</sup> Their reflexive response to the problems associated with section 1400(b) ignores the unique nature of patent law and the need for a special venue provision to protect corporate defendants. Legislative action is necessary to clarify the law and to remedy the defect in the statutory language of section 1400(b).

Ample precedent exists for maintaining special venue provisions for particular areas of the law.<sup>187</sup> Patent infringement actions should be treated separately for several reasons. First, the United States Constitution recognizes the importance of the patent system.<sup>188</sup> Second, several courts have adopted a line of reasoning to support the existence of a special venue provision

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184. See Note, *supra* note 23 (concluding after an examination of the legislative history of the Judicial Improvements and Access to Justice Act that Congress did not intend for the implicit repeal of section 1400(b)).

185. See Peterson, *supra* note 140, at 247.

186. See, e.g., Wydick, *supra* note 23, at 584-85; Peterson, *supra* note 140, at 240-47; Wright, *supra* note 14, § 3823 ("The statute ought to be repealed and patent cases treated in the same fashion as federal question cases generally.").

187. Special venue statutes already exist for suits against aliens, 28 U.S.C. § 1391(d) (1988); suits involving national banking associations, 28 U.S.C. § 1394 (1988); suits for collection of internal revenue taxes, 28 U.S.C. § 1396 (1988); suits regarding Interstate Commerce Commission orders, 28 U.S.C. § 1398 (1988); and suits for shareholders' derivative actions, 28 U.S.C. § 1401 (1988).

188. Congress' power to issue patents is found in the Constitution: "The Congress shall have Power To . . . promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8.

predicated on the unique nature of patent litigation.<sup>189</sup> Third, Congress has clearly recognized the unique character of patent law by creating the CAFC as a special court to address all appeals on matters of patent law. Congress' intent in creating the CAFC was to improve the efficiency of the federal courts in hearing patent litigation, to provide uniformity and stability in the treatment of patent law among the circuits, and to discourage forum shopping.<sup>190</sup> Senator Patrick Leahy stated in a letter to the Senate Subcommittee on Courts considering the creation of the CAFC:

I believe that patent law stands apart from virtually every other legal discipline both in its extreme focus on science and technology and its need for uniformity in decisionmaking . . . .

In patent cases, the court is almost always dealing with claims of innovation and weighing one body of technical evidence against another.

. . . .

In short, I am aware of no likely candidate [other than patent law] for an additional specialty court and wish to place in the record the considerations I believe justify distinguishing patent cases from other litigation.<sup>191</sup>

In fact, the repeal of section 1400(b) would contravene one of Congress' reasons for creating the CAFC — the elimination of forum shopping in patent infringement actions. The American

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189. The court in *Ruth v. Eagle-Picher Co.*, 225 F.2d 572, 106 U.S.P.Q. 251 (10th Cir. 1955), adopted the policy that:

A patent infringement action involves a peculiar combination of science or technology and law. In the ascertainment of the pertinent technical facts, it is important that the trial judge have first-hand visual and audible knowledge of the conditions, the environment and the art itself and the testimony of the most competent witnesses. Practicality and convenience are best served when the case is prosecuted where the alleged acts of infringement occurred and the defendant has a regular and established place of business.

An intention on the part of Congress to depart from that policy should not be lightly inferred.

*Id.* at 577, 106 U.S.P.Q. at 255. See also *Jeffrey Galion, Inc. v. Joy Mfg. Co.*, 323 F. Supp. 261, 168 U.S.P.Q. 708 (N.D. W. Va. 1971); *Vibber v. United States Rubber Co.*, 255 F. Supp. 47, 150 U.S.P.Q. 30 (S.D.N.Y. 1966); *Morse v. Master Specialties Co.*, 239 F. Supp. 641, 144 U.S.P.Q. 528 (D.N.J. 1964); *Bradford Novelty Co. v. Manheim*, 156 F. Supp. 489, 115 U.S.P.Q. 278 (S.D.N.Y. 1957).

190. S. REP. NO. 275, 97th Cong., 2d Sess. 4 (1981), reprinted in 1982 U.S. CODE CONG. & ADMIN. NEWS 11, 14-15.

191. *Id.* at 39.

Law Institute, in recommending repeal of section 1400(b), acknowledged that expanding venue provisions would increase the already prevalent forum shopping in patent litigation.<sup>192</sup>

Finally, the CAFC has created a body of patent law favorable to patentees that necessitates a special, restrictive venue provision to protect corporate defendants.<sup>193</sup> CAFC opinions favor patentees in the areas of the statutory presumption of validity,<sup>194</sup> secondary considerations,<sup>195</sup> and patent infringement.<sup>196</sup> The CAFC routinely vacates holdings of invalidity if the infringement action fails.<sup>197</sup> Additionally, the CAFC has also

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192. AMERICAN LAW INSTITUTE, STUDY OF THE DIVISION OF JURISDICTION BETWEEN STATE AND FEDERAL COURTS 220-21 (1969).

193. The Court recognized with section 1391(c) that current developments in the law and the applicable venue provision are related. See *Pure Oil Co. v. Suarez*, 384 U.S. 202, 204 (1966) (Congress enacted section 1391(c) "to bring venue law in tune with modern concepts of corporate operations.").

194. See 35 U.S.C. § 282 (1988). See also *Adelman, The New World of Patents Created by the Court of Appeals for the Federal Circuit*, 20 U. MICH. J.L. REF. 979, 992 (1987); *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 220 U.S.P.Q. 763 (Fed. Cir.), cert. denied, 469 U.S. 821, 224 U.S.P.Q. 520 (1984) (firmly adopting the clear and convincing standard required to overcome the statutory presumption of a patent's validity); *SSIH Equip. S.A. v. United States Int'l Trade Comm'n*, 718 F.2d 365, 219 U.S.P.Q. 686 (Fed. Cir. 1983) (each claim of a patent must be challenged independently, unlike previous courts which allowed the validity of a patent to be attacked as a whole); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 U.S.P.Q. 871 (Fed. Cir. 1983) (disallowed any shifting of the burden of proof to the plaintiff or any weakening of it by the introduction of evidence not considered by the Patent and Trademark Office).

195. *Harris, The Emerging Primacy of "Secondary Considerations" as Validity Ammunition: Has the Federal Circuit gone too far?*, 71 J. PAT. & TRADEMARK OFF. SOC'Y 185, 201 (1989) ("The one-sidedness of the CAFC approach, in approving only pro-patentee forms of secondary considerations evidence . . . is a pattern which would not be surprising in a brief by a patentee's counsel.").

196. *Hantman, Patent Infringement* 72 J. PAT. & TRADEMARK OFF. SOC'Y 454 (1990): The CAFC decisions have clearly shifted the advantage to the patentee in defense of his property rights. . . . As has been shown in its departures on literal infringement and the doctrine of equivalents, the CAFC has abandoned judicial precedent and tended to create new law in support of the patentee's positions. But whatever the reason for the CAFC's bias toward the patentee, it is wishful thinking to believe that the actions of the CAFC will result in the encouragement of innovation. *Id.* at 518.

197. See *Re and Rooklidge, Vacating Patent Invalidity Judgments Upon an Appellate Determination of Noninfringement*, 72 J. PAT. & TRADEMARK OFF. SOC'Y 780 (1990). The authors contend that the CAFC's practice of routinely vacating declarations of invalidity adds to the expense of litigation. Particularly, patentees may assert a resurrected patent against other infringers or against the same infringer in another forum. (As examples, the authors cite *Morton Int'l, Inc. v. Cardinal Chem. Co.*, No. 6:83-889-OK (D.S.C.), and *Morton Int'l, Inc. v. Atochem North America, Inc.*, No. 87-60-CMW (D.

expanded injunctive relief<sup>198</sup> and upheld excessive damage awards against infringers.<sup>199</sup>

The precedent established by the CAFC has dramatically increased the importance of winning in the district court.<sup>200</sup> A statistical study indicates that the CAFC affirmed district court decisions three times as often as it reversed them.<sup>201</sup> The problem becomes more acute with jury trials, which have markedly increased since the creation of the CAFC.<sup>202</sup> Juries tend to be pro-patentee<sup>203</sup> and the standard for reversal of a jury verdict is higher than that of a bench verdict.<sup>204</sup> There is not much hope

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Del.), in which the patentee asserted a patent resurrected by the CAFC in *Morton Thio-kol, Inc. v. Argus Chem. Corp.*, 11 U.S.P.Q.2d 1152 (Fed. Cir. 1989). *Id.* at 795, 795 n. 75. See also, Donafrio, *The Disposition of Unreviewable Judgments by the Federal Circuit*, 73 J. PAT. & TRADEMARK OFF. SOC'Y 462 (1991).

198. See *Smith Int'l, Inc. v. Hughes Tool Co.*, 718 F.2d 1573, 219 U.S.P.Q. 686 (Fed. Cir.), *cert. denied*, 464 U.S. 996, 220 U.S.P.Q. 385 (1983).

199. See *Polaroid Corp. v. Eastman Kodak Co.*, 789 F.2d 1556, 229 U.S.P.Q. 561 (Fed. Cir.), *cert. denied*, 479 U.S. 850 (1986) (upholding record 909 million dollars in damages against Kodak); see also Ropski and Cooperman, *Damages in USA Intellectual Property Litigation*, 72 J. PAT. & TRADEMARK OFF. SOC'Y 181 (1990).

200. Schwab, *Defending a Patent Case Under the Watchful Eye of the Federal Circuit*, 70 J. PAT. & TRADEMARK OFF. SOC'Y 100, 104 (1988) ("To be successful on any other defense, however, it is almost essential to prevail in the district court, because the overwhelming majority of all Federal Circuit decisions which favored the alleged infringer are affirmances of the district court.").

201. Coolley, *What the Federal Circuit Has Done and How Often: Statistical Study of the CAFC Patent Decisions — 1982 to 1988*, 71 J. PAT. AND TRADEMARK OFF. SOC'Y 385, 388 (1989). The statistics become more significant when the issues litigated are analyzed. In cases in which patent invalidity was at issue, the CAFC affirmed the lower tribunals almost universally when the tribunal found the patent valid. However, when patents were held invalid, the percentages were nearly fifty-fifty. *Id.* at 391.

202. See Hofer, *The Real World of Juries, Damages, and Injunctions in Patent Cases*, 50 ALB. L. REV. 593 (1986).

203. *Id.* at 594. The author conducted a study of every district court decision during the period 1975-1979. He found that approximately two-thirds of patents tried before a jury were held valid. *Id.*

204. Most patent cases have been tried to the bench, and therefore the "clearly erroneous" standard of Rule 52(a) of the Federal Rules of Civil Procedure has applied to review of the trial court's decision. See *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 U.S.P.Q. 337 (Fed. Cir. 1985), *rev'd*, 475 U.S. 809, 229 U.S.P.Q. 478 (1986). Jury trials present a greater obstacle for review because appellate review involves seventh amendment issues with the implied, if not express, higher level of review needed to overturn the jury's verdict. See *Lavender v. Kurn*, 327 U.S. 645 (1946) (reversible error occurs when there is a complete absence of probative facts to support the jury's verdict). For the CAFC's treatment of jury verdicts, see *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983); *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 225 U.S.P.Q. 634 (Fed. Cir. 1985); *Orthokinetics, Inc. v. Safety Travel*

for a defendant to receive any review of the CAFC's decision, as the probability of obtaining a writ of certiorari to the Supreme Court is slight.<sup>205</sup>

Finally, the perceived bias of the CAFC can induce patentees holding marginal patents to enforce their patents through litigation or the threat of litigation.<sup>206</sup> The Court recognized the coercive effect of threatened litigation by a patentee in *Blonder-Tongue Lab. v. Univ. of Ill. Found.*<sup>207</sup> The Court relied extensively on the high costs faced by defendants in patent litigation as the basis for establishing that a previous holding of patent invalidity acted as *res judicata* on future litigation involving that patent.<sup>208</sup> Justice White, writing for the Court, stated:

[T]he defendant in an infringement suit will have even higher costs [than the plaintiff] as he both introduces proof to overcome the presumption [of validity] and attempts to rebut whatever

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Chairs, Inc., 806 F.2d 1565, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986); see also Hofer, *The CAFC and Fact/Law Questions in Patent Cases: The Jury's Role Burgeons!*, 12 A.P.L.A.Q.J. 295 (1984). Writing of the CAFC's approach to jury damage awards, Hofer stated:

[T]he CAFC is willing to go far to affirm jury damage awards. . . . It [the CAFC's approach] encourages jury trials. It greatly expands the jury's role. Now validity and infringement will be decided by 6 to 12 lay persons, rather than a few lawyer/judges. It is not a bad game — because it's played in the patentee's ballpark.

*Id.* at 309.

205. See Banner, *The Creation of the Federal Circuit Court of Appeals and the Resulting Revitalization of the Patent System*, 50 ALB. L. REV. 585, 585 (1986) ("While, theoretically, the possibility of having a patent infringement case further considered by the Supreme Court exists, many efforts to have the Court review a decision by the Federal Circuit have been fruitless."). To date, the Court has heard only two appeals from the CAFC. See *Dennison Mfg. Co. v. Panduit Corp.* 475 U.S. 809, 229 U.S.P.Q. 478 (1986); *Eli Lilly and Co. v. Medtronic, Inc.*, 110 S. Ct. 2683, 5 U.S.P.Q.2d 1760 (1990). See also, Vandenburg, *The Truth About Patent Litigation for Patent Owners Contemplating Suit*, 73 J. PAT. & TRADEMARK OFF. SOC'Y 301, 307 (1991).

206. Sobel, *The Court of Appeals for the Federal Circuit: A Fifth Anniversary Look at Its Impact on Patent Law and Litigation*, 37 AM. U.L. REV. 1087, 1090 (1988). An example of this possibility is the aggressive enforcement by Texas Instruments, Inc. of its assorted patents on integrated circuits and computer memory chips. Texas Instruments has been demanding large royalty fees for licensing rights to its patents and has been willing to sue for infringement when other companies have not agreed to the fees. Several smaller corporations have criticized Texas Instruments for its practices, stating that they will ultimately stifle innovation in the industry. See N.Y. TIMES, Oct. 16, 1990, at D1, col. 3; CHICAGO TRIBUNE, Oct. 14, 1990, at 11B; WASHINGTON POST, Oct. 21, 1990, at H1, col. 1.

207. 402 U.S. 313, 169 U.S.P.Q. 513 (1971).

208. *Id.* at 335, 169 U.S.P.Q. at 533.



proof the patentee offers to bolster the claims. In testimony before the Senate subcommittee considering patent law revision in 1967, a member of the President's Commission on the Patent System discussed the financial burden looming before one charged as a defendant in a complex infringement action in terms of amounts that sometimes run to "hundreds of thousands of dollars."<sup>209</sup>

Critics of section 1400(b) have been quick to complain of the statute's failure to adapt to changes in the law.<sup>210</sup> Section 1391(c) governs a variety of actions, and therefore must be general in its scope and adapt to changes in the laws to which it pertains.<sup>211</sup> It is unreasonable, however, to require the patent venue statute to change in the identical fashion, as the two statutes serve entirely different purposes. Unique venue statutes exist to serve the unique nature of the laws to which they apply. If these statutes change with each modification of the general venue provision, then why maintain separate provisions at all? Any patent venue statute should reflect the particular needs of defendants in patent litigation and the unique nature of patent law.

### C. *Section 1400(b) as a True Venue Provision*

Most venue provisions allow for venue in a jurisdiction in which either the defendant resides or the claim arose.<sup>212</sup> There are two problems with the language of section 1400(b): the overlap of the two distinct tests for venue and the failure to define for patent terms "where the claim arose." Section 1400(b) currently provides one test for residency (the "resides" question which engendered *VE Holding*), and a second test requiring that both the residence provision ("regular and established place of business") and the claim arose provision ("act of infringement") be satisfied. The combination of these tests has resulted in an overly restrictive venue provision.<sup>213</sup> Patentees should have the

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209. *Id.* at 335-36 (citations omitted).

210. See Peterson, *supra* note 140, at 245; WRIGHT, *supra* note 14, § 3823, at 138; Wydick, *supra* note 23, at 584.

211. See Note, *Defining 'Doing Business' to Determine Corporate Venue*, 65 TEX. L. REV. 153 (1986).

212. See *supra* note 14 and accompanying text.

213. See AMERICAN LAW INSTITUTE, STUDY OF THE DIVISION OF JURISDICTION BETWEEN

option to establish venue in either of the two locations (where the defendant resides or where the claim arose). Additionally, the tests should be structured to reflect the unique nature of patent law. Therefore, the first step toward a new patent venue statute should be the separation of the tests for venue: one for the traditional notion of where the defendant resides and the other for where the claim arose.

### 1. *Where the Defendant Resides*

The definition of "resides" employed prior to *VE Holding* was a workable test which provided few interpretive problems for the courts.<sup>214</sup> Critics of the "resides" provision of section 1400(b) have not attacked the operation of the provision, but only the Supreme Court's views that section 1400(b) is the sole and exclusive venue provision for patent infringement actions.<sup>215</sup> As a result, they contend that the "resides" test is more restrictive than the corresponding test in the general venue statute and has allowed patent venue to evolve separately from the general venue statute.<sup>216</sup>

Such critics as Professor Wydick have overemphasized the importance of the original intent of Congress when it adopted the patent venue statute. The intent of Congress almost 100 years ago is no longer germane to the discussion of the value of a separate patent venue statute.<sup>217</sup> A present need exists for an

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STATE AND FEDERAL COURTS 20-21 (1969). The ALI proposed that section 1400(b) be repealed and that the general venue provisions govern actions for patent infringement. *Id.* In support of its position, the Study stated:

In United States Code Annotated there are more than 19 columns of annotations of cases on what is a "regular and established place of business." Any venue statute that produces a large volume of litigation on where suit may be brought is inherently suspect. Further, even giving the fullest weight to "the technical and intricate nature of patent litigation," there is no compelling reason why the alleged infringer should not be suable in the district where he is claimed to have acted wrongfully, even though he has no regular and established place of business there.

*Id.* at 220-21 (citation omitted).

214. See *supra* notes 72-75.

215. See, e.g., Peterson, *supra* note 140, at 244; WRIGHT, *supra* note 14, § 3823, at 138; Wydick, *supra* note 23, at 584.

216. See, e.g., Peterson, *supra* note 140, at 245; WRIGHT, *supra* note 14, § 3823, at 138-39; Wydick, *supra* note 23, at 584.

217. Not all legal scholars are in agreement with Professors Wydick, Wright, and

independent patent venue statute that will address existing conditions in patent law.<sup>218</sup>

A modified version of section 1400(b) should continue to provide that the “resides” test include the defendant’s state of incorporation. Patent venue, however, does need to change with the realities of practice. A corporation is rarely restricted to doing business in its state of incorporation. The “resides” provision should be modestly expanded to include other forums in which the defendant conducts a significant portion of its business. Venue statutes should be easy for a court to interpret and implement.<sup>219</sup> Therefore, any addition to the “resides” provision should be clear and simple, but the overall scope of the venue provision should be limited to restrict the possible forums.

## 2. *Where the Claim Arose*

The phrase “regular and established place of business” should be deleted from the second portion of section 1400(b). The courts have had great difficulty in interpreting the phrase.<sup>220</sup> As a test of the defendant’s residence, it overlaps the “resides” test in the first prong of section 1400(b). An expansion of “resides” would eliminate the need for this phrase. Additionally, its conjunction with an “act of infringement” unduly restricts the operation of the overall venue provision. Before *VE Holding*, a plaintiff had to fulfill a residence test and a claims arose test to establish venue in a forum other than the defendant’s state of incorporation. Plaintiffs should be provided with the opportunity to bring an action in the forum in which the claim arose even if the defendant does not reside there.<sup>221</sup>

The provision of section 1400(b) pertaining to where the cause of action arose — “act of infringement” — should be clarified to reflect the specific elements of infringement.<sup>222</sup> Courts have had difficulty interpreting the current language of section 1400(b) because the language was not specific to in-

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Moore. For a contrary interpretation of the legislative history of the 1897 Act, see Wal-drop, *supra* note 23, at 38-40.

218. See *supra* notes 185-211 and accompanying text.

219. See MOORE, *supra* note 146, ¶ 0.340 at 4007.

220. See *supra* notes 76-87 and accompanying text.

221. See AMERICAN LAW INSTITUTE, *supra* note 213, at 221.

222. See *supra* note 71.

fringement actions. Courts have attempted to treat these provisions in a manner similar to certain tort actions. For example, a corporate defendant in a product liability action may be amenable to suit in the forum in which the injury occurs, even though the product was manufactured in another jurisdiction.<sup>223</sup> In *Union Asbestos & Rubber v. Evans Products*,<sup>224</sup> the court expressly refuted any parallel between the definition of "sale" in infringement actions and "sale" in commercial law.<sup>225</sup> Rather, the court developed a test to establish an act of infringement based on the defendant's "systematic and continuous solicitation" of orders within the forum,<sup>226</sup> an analysis which is similar to the "purposeful availment" rationale behind most long-arm statutes used for obtaining personal jurisdiction over the defendant.<sup>227</sup>

Such an analogy is misplaced. The purpose of long-arm statutes is to allow state courts to obtain jurisdiction over transient defendants who commit isolated torts within the state, but whose contacts with the forum are not sufficient to constitute a presence there.<sup>228</sup> Infringement of patented inventions, and particularly patented processes, have no one identifiable place where the "injury" occurs. The damages from infringement do not arise from isolated incidents, but are the cumulative result of infringement in many forums. Irregularities in the law have resulted from the courts' attempt to create this analogy.

The venue provision under the Foreign Sovereign Immunities Act<sup>229</sup> allows for venue "in any judicial district in which a substantial part of the events or omissions giving rise to the claim occurred, or a substantial part of property that is the subject of the action is situated . . . ."<sup>230</sup> A similar provision should be adopted for patent venue, placing emphasis on the origin of the infringement — the place of manufacture or alternatively, the primary point of distribution.

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223. See MOORE, *supra* note 146, ¶ 4.41 at 352-53.

224. 328 F.2d 949, 140 U.S.P.Q. 634 (7th Cir. 1964).

225. *Id.* at 951-52, 140 U.S.P.Q. at 635-36.

226. *Id.* at 952, 140 U.S.P.Q. at 636.

227. See MOORE, *supra* note 146, ¶ 4.41 at 352.

228. See *id.* at 352-54.

229. 28 U.S.C. § 1391(f) (1988).

230. *Id.* at §1391(f)(1).

#### D. *Suggested Amendment to Section 1400(b)*

A modified version of section 1400(b) should include the recommendations contained in Parts V-B and V-C above. The following is the author's suggested language to replace the current version of section 1400(b):

Any civil action for patent infringement or other actions related to a United States patent may be brought in the judicial district in which the defendant resides, or in which the defendant has committed an act which constitutes the making, using, or selling of the patented invention. For purposes of this section, a corporate defendant shall be deemed to reside in either its state of incorporation or the state in which it maintains a principal place of business.

#### VI. Conclusion

The creation of the CAFC has been termed the "most important legislative act" in a decade during which the importance and economic power of patents reached their highest level in the 200 year history of the patent system.<sup>231</sup> The CAFC has brought about uniformity and predictability in interpreting patent law and has reinforced the economic power of patents.<sup>232</sup> In *VE Holding*, the CAFC was presented with an opportunity to craft a creative and unique remedy to the problems associated with section 1400(b), reflecting the needs and realities of a revitalized patent system. Instead, the court adhered to the old line of criticisms and suggestions. Now, only congressional action can repair the language of section 1400(b). A new venue provision should be adopted. It should be patterned after the other federal venue provisions, with language that reflects the realities of patent law. It should define venue in terms tailored to patent law, and it should protect corporate defendants from being forced to litigate in burdensome and expensive forums. With the revitalization of the patent system will come greater competition among technology based businesses, greater emphasis by these businesses on obtaining patents, and ultimately more patent litigation.<sup>233</sup> Pro-

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231. Kastriner, *The Revival of Confidence in the Patent System*, 73 J. PAT. & TRADEMARK OFF. SOC'Y 5, 8 (1991).

232. *Id.*

233. *Id.* at 22-23.

tection must be instituted to prevent aggressive patentees armed with a powerful new patent system from smothering innovation through the threat of expensive and debilitating litigation.

*William C. Johnson*



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