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You Infringed My Patent, Now Wait Until I Sue You:
The Federal Circuit’s Decision in *Avocent Huntsville Corp. v. Aten International Co.*

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**Abstract:**

The Federal Circuit recently held that it lacked personal jurisdiction over a foreign defendant, because neither the patentee’s sales within the forum state nor their patent enforcement letters constituted sufficient contacts for personal jurisdiction. This Note argues that the Federal Circuit erroneously held that a patentee’s sales in the forum state are irrelevant to specific personal jurisdiction. The Note surveys the legal background of personal jurisdiction in declaratory judgment actions, particularly in the patent context. The Note then argues that the Federal Circuit’s recent line of cases incorrectly held that a patentee’s sales of the patented product within the forum state are irrelevant to specific personal jurisdiction. The patentee’s sales of the patented product are relevant to establishing the patent’s validity, and therefore, the patentee’s sales of the patented product should also be relevant to establishing personal jurisdiction over the patentee. Secondly, the Federal Circuit failed to consider that the patentee’s sales of the patented product are relevant to establishing the proper remedy for infringement of the patent. Therefore, the patentee’s sales of the patented product should be relevant to establishing personal jurisdiction in a suit where such a remedy is at issue. And finally, economic analysis also supports a finding of personal jurisdiction in patent declaratory judgment actions, especially against foreign patentees. Resolution of the declaratory judgment action would likely enhance competition within the forum state while causing relatively little inconvenience to the foreign patentee. Furthermore, the accused infringer should receive the benefit of forum selection for incurring the costs of commencing the litigation. Therefore, the Note argues, the Supreme Court should review and overturn the Federal Circuit’s jurisprudence on personal jurisdiction in patent declaratory actions, and hold that forum sales of the patented product are relevant to personal jurisdiction.
NOTE

YOU INFRINGED MY PATENT, NOW WAIT UNTIL I SUED YOU: THE FEDERAL CIRCUIT’S DECISION IN AVOCENT HUNTSVILLE CORP. V. ATEN INTERNATIONAL CO.

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INTRODUCTION

Cat International Co. (“Cat”), a Chinese corporation, sends a letter to Mouse Inc. (“Mouse”), a Tennessee corporation.¹ Cat threatens to sue Mouse because one of Mouse’s products, Techno XM, allegedly infringes Cat’s patent pending product, Widget 2000.² Mouse, however, believes that Techno XM does not infringe any claims of the Cat patent.³

Mouse soon learns that Cat also sent a letter to Online Retailer’s headquarters.⁴ This letter requested Online to cease ordering Mouse’s product because Online may be liable for secondary infringement of the Cat patent.⁵ Consequently, Online stops ordering Techno XM and removes it from the roster of available products on its website.⁶

¹ The basis of this hypothetical is Avocent Huntsville Corp. v. Aten International Co., 552 F.3d 1324 (Fed. Cir. 2008), cert. denied, 129 S. Ct. 2796 (2009).
² See supra note 1; cf. Viam Corp. v. Iowa Export-Import Trading Co., 84 F.3d 424, 426 (Fed. Cir. 1996).
³ See supra note 1; cf. Viam, 84 F.3d at 426.
⁴ See supra note 1; cf. Campbell Pet Co. v. Miale, 542 F.3d 879, 882 (Fed. Cir. 2008).
⁵ See supra note 1; cf. Campbell Pet, 542 F.3d at 882.
⁶ See supra note 1; cf. Avocent Huntsville Corp. and Avocent Redmond Corp.’s Petition for Rehearing En Banc, 2009 WL 329927, at *4 (Jan. 13, 2009) (No. 2007-1553) (stating that online retailer forwarded infringement notice letter to Avocent’s headquarters in Alabama for resolution); Campbell Pet, 542 F.3d at 886 (stating that patentee enlisted third party to remove defendant’s products from trade show); Genetic Implant Sys., Inc. v. Core-Vent Corp., 123 F.3d 1455, 1457 (Fed. Cir. 1997) (stating that potential customers have refused to purchase Genetic’s products due to fear of litigation).
Mouse’s managers are concerned about the threatened lawsuit.\(^7\) If they continue producing Techno XM, they may be infringing Cat’s patent.\(^8\) Continued infringement would increase the amount of damages that a court may award to Cat if it succeeds in a patent infringement suit.\(^9\) Nevertheless, if a court finds that Techno XM does not infringe Cat’s patent, stopping production would be mistaken and detrimental to Mouse’s bottom line.\(^10\)

Mouse therefore decides to sue Cat for declaratory judgment of non-infringement and, in the alternative, invalidity of the patent on Widget 2000.\(^11\) Mouse files suit in the United States District Court for the Eastern District of Tennessee, where it produces Techno XM and received Cat’s letter.\(^12\) Cat’s products, including Widget 2000, are available for purchase at every major widget retailer in Tennessee.\(^13\)

Nevertheless, the district court dismisses the suit under Federal Rule of Civil Procedure 12(b)(2) for lack of personal jurisdiction.\(^14\) The district court finds that it does not have general personal jurisdiction over Cat because Cat’s contacts with Tennessee are not

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\(^7\) See Declaratory Judgment Act of 1934, Hearings on H.R. 5623 Before a Subcomm. of the S. Comm. on the Judiciary, 70th Cong. 35 (1928) (testimony of Prof. Sunderland) [hereinafter Sunderland Testimony]; supra note 1.

\(^8\) See infra Part I.C; supra note 1.

\(^9\) See infra Part I.C; supra note 1; cf. Sunderland Testimony, supra note 7.

\(^10\) See infra Part III.C; supra note 1.

\(^11\) See supra note 1; cf. Campbell Pet, 542 F.3d at 882; Viam, 84 F.3d at 426.

\(^12\) See supra note 1; cf. Viam, 84 F.3d at 426.

\(^13\) See supra note 1; cf. Viam, 84 F.3d at 428-29.

\(^14\) See FED. R. CIV. P. 12(b)(2); supra note 1.
systematic and continuous.\textsuperscript{15} Moreover, the district court finds that it does not have specific personal jurisdiction over Cat based on Cat’s letters to Mouse and Online.\textsuperscript{16} The district court also refuses to consider Cat’s sales within Tennessee.\textsuperscript{17} Mouse promptly appeals the district court’s ruling.\textsuperscript{18}

The Federal Circuit Court of Appeals faced a similar scenario in \textit{Avocent Huntsville Corp. v. Aten International Co.}\textsuperscript{19} In \textit{Avocent}, the court held that it lacked personal jurisdiction over the defendant.\textsuperscript{20} The \textit{Avocent} court found that neither the patentee’s sales within the forum state, nor their patent enforcement letters constituted sufficient contacts for personal jurisdiction.\textsuperscript{21} This Note argues that the Federal Circuit erroneously held that a patentee’s sales in the forum state are irrelevant to specific personal jurisdiction.\textsuperscript{22}

The Declaratory Judgment Act of 1934 provides relief to a party who desires a declaration of its rights and legal relations.\textsuperscript{23}

\textsuperscript{15} \textit{See supra} note 1; cf. \textit{Viam}, 84 F.3d at 428-29.
\textsuperscript{16} \textit{See supra} note 1; cf. \textit{Viam}, 84 F.3d at 426.
\textsuperscript{17} \textit{See supra} note 1; see also \textit{Red Wing Shoe Co. v. Hockerson-Halberstadt, Inc.}, 148 F.3d 1355, 1360-62 (Fed. Cir. 1998); cf. \textit{Viam}, 84 F.3d at 428-29.
\textsuperscript{18} \textit{See supra} note 1.
\textsuperscript{19} \textit{Avocent Huntsville Corp. v. Aten Int’l Co.}, 552 F.3d 1324 (Fed. Cir. 2008), cert. denied, 129 S. Ct. 2796 (2009).
\textsuperscript{20} \textit{Id.} at 1341.
\textsuperscript{21} \textit{Id.} at 1333, 1336 (holding that neither patentee’s sales of patented product nor patentee’s letters to plaintiff suffice to establish specific personal jurisdiction for declaratory judgment action).
\textsuperscript{22} \textit{See infra} Part III.
\textsuperscript{23} 28 U.S.C. § 2201(a) (2006); see also \textit{MedImmune v. Genentech}, 549 U.S. 118, 128-29 (2007) (stating that Act may also be useful to test constitutionality of
a declaratory judgment action, a putative defendant preemptively files suit against a putative plaintiff, requesting that the court declare the parties’ rights and obligations. In the patent infringement context, the accused infringer, the putative defendant in the infringement suit, becomes the plaintiff in the declaratory judgment action. Nevertheless, the court must meet all jurisdictional prerequisites before pronouncing a declaratory judgment.

laws before commencing activities that would be illegal under challenged law); Donald L. Doernberg & Michael B. Mushlin, The Trojan Horse: How the Declaratory Judgment Act Created a Cause of Action and Expanded Federal Jurisdiction While the Supreme Court Wasn’t Looking, 36 UCLA L. REV. 529, 553 (1989) (discussing that proponents of Act were concerned with social cost of uncertainty of individuals and corporations about their legal positions).


24 See Adam D. Kline, Any Given Forum: A Proposed Solution to the Inequitable Economic Advantage that Arises When Non-Practicing Patent Holding Organizations Predetermine Forum, 48 IDEA 247, 265 (stating patent declaratory judgment action is essentially mirror image of infringement action, but potentially infringing party becomes plaintiff and chooses forum and timing of suit); Ritchie, supra note 24, at 127 (stating that declaratory judgment actions confer subject matter jurisdiction on federal courts where putative plaintiff chooses not to initiate suit, but dispute is otherwise ripe); Van Voorhis & Ballinger, supra note 24, at 553 (stating Declaratory Judgment Act allows accused infringer to force resolution of matters by suing putative plaintiff). But see Red Wing Shoe Co. v. Hockerson-Halberstadt, Inc., 148 F.3d 1355, 1360 (criticizing “mirror-image” understanding of declaratory judgment actions).

25 See Burger King v. Rudzewicz, 471 U.S. 462, 471-72 (1985) (noting that Due Process Clause’s restriction on state power guarantees individual’s liberty interest from unrelated forum’s judgment); World-Wide Volkswagen Corp. v. Woodson, 444 U.S. 286, 291-92 (1980) (same); see also C. Douglas Floyd &
The Supreme Court defined a flexible framework for establishing personal jurisdiction over a defendant.\textsuperscript{27} Courts must consider the defendant’s contacts with the forum state and the relationship between those contacts and the cause of action.\textsuperscript{28} Absent continuous and systematic contacts, which would establish “general” personal jurisdiction without further inquiry, the defendant’s forum contacts must be somewhat related to the litigation.\textsuperscript{29} This establishes “specific” personal jurisdiction.\textsuperscript{30}

This Note argues that the Federal Circuit erroneously held that a patentee’s sales in the forum state are irrelevant to specific personal jurisdiction.\textsuperscript{31} Part I surveys the legal background of personal jurisdiction in declaratory judgment actions, particularly

Shima Baradaran-Robison, \textit{Toward a Unified Test of Personal Jurisdiction in an Era of Widely Diffused Wrongs: The Relevance of Purpose and Effects}, 81 Ind. L.J. 601, 628 (explaining Due Process Clause serves dual purpose of protecting defendant from inconvenient litigation, and confining sovereign authority of states in relation to each other).


\textsuperscript{28} See \textit{Asahi}, 480 U.S. at 112; \textit{Burger King}, 471 U.S. at 475; \textit{Calder}, 465 U.S. at 423; \textit{Helicopteros}, 466 U.S. at 423; \textit{World-Wide Volkswagen}, 444 U.S. at 297; Hanson, 357 U.S. at 253; \textit{Int’l Shoe}, 326 U.S. at 316.

\textsuperscript{29} See infra Part I.B; see also \textit{Burger King}, 471 U.S. at 475; \textit{Helicopteros}, 466 U.S. at 414; \textit{World-Wide Volkswagen}, 444 U.S. at 297.

\textsuperscript{30} R. Scott Weide, \textit{Patent Enforcement Deterrence: Liberal Assertions of Personal Jurisdiction in Declaratory Judgment Actions}, 65 UMKC L. Rev. 177, 187 (1996) (explaining that jurisdiction is “specific” or “limited” absent party’s systematic and continuous contacts with forum, and claim arises out of or relates to party’s act); see also \textit{Burger King}, 471 U.S. at 475; \textit{Helicopteros}, 466 U.S. at 414.

\textsuperscript{31} See infra Part III.
in the patent context. It first provides a brief overview of the fundamentals of patent law. It then examines the Supreme Court’s jurisprudence concerning specific personal jurisdiction. It also examines the relevant provisions of the 1934 Declaratory Judgment Act and its legislative history. Finally, it explores the Federal Circuit’s doctrine regarding personal jurisdiction in declaratory judgment actions for patent non-infringement. Part II discusses the relevant facts, procedure, holding, and rationale of *Avocent*.

Part III argues that *Avocent* incorrectly held that a patentee’s sales of the patented product within the forum state are irrelevant to specific personal jurisdiction. First, the patentee’s sales of the patented product are relevant to establishing the patent’s validity. Therefore, the patentee’s sales of the patented product should also be relevant to establishing personal jurisdiction over the patentee. Second, *Avocent* failed to consider that the patentee’s sales of the patented product are relevant to establishing the proper remedy for

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32 See infra Part I.
33 See infra Part I.A.
34 See infra Part I.B.
35 See infra Part I.C.
36 See infra Part I.D.
37 See infra Part II.
38 See infra Part III.
39 See infra Part III.A.
40 See infra Part III.A.
infringement of the patent. Therefore, the patentee’s sales of the patented product should be relevant to establishing personal jurisdiction in a suit where such a remedy is at issue. Third, economic analysis also supports a finding of personal jurisdiction in patent declaratory judgment actions, especially against foreign patentees. Resolution of the declaratory judgment action would likely enhance competition within the forum state while causing relatively little inconvenience to the foreign patentee.

Furthermore, the accused infringer should receive the benefit of forum selection for incurring the costs of commencing the litigation. Therefore, the Supreme Court should overturn Avocent,  

41 See eBay v. MercExchange, LLC, 547 U.S. 388 (2006); see also Automated Merch. Sys., Inc. v. Crane Co., Nos. 2009-1158, 2009-1164, 2009 WL 4878643, at *3 (Fed. Cir. Dec. 16, 2009); Ecolab, Inc. v. FMC Corp., 569 F.3d 1335, 1352 (Fed. Cir. 2009); Abbott Labs. v. Sandoz, Inc., 544 F.3d 1341, 1363 (Fed. Cir. 2008) (stating that eBay’s legal and equitable factors may be of different weight depending on whether patentee is practicing invention or merely licenses it).

42 See infra Part III.B.

43 See infra Part III.C.

44 See State Indus. v. A.O. Smith Corp., 751 F.2d 1226, 1236 (Fed. Cir. 1985) (highlighting one of many benefits of patent system: it incentivizes design around competitor’s patented product, thus bringing steady flow of innovations to marketplace); STEPHEN McJOHN, INTELLECTUAL PROPERTY: EXAMPLES AND EXPLANATIONS 229 (2d ed. 2006) (stating that patented products compete with products not covered by patent if there is market for patented invention at all); Kline, supra note 25, at 252 (stating that competitors are free to attempt to design around patent and develop their own solutions, but they risk subjecting themselves to infringement liability); Spencer, supra note 89, at 623 (stating that today notions of inconvenience and burden to travel has reduced vitality, in particular for corporate defendants accustomed to operating on international level); cf. Pierre Riou, General Jurisdiction over Foreign Corporations: All that Glitters Is Not Gold Issue Mining, 14 REV. LITIG. 741, 803 (stating that amorphous concepts of fairness, reasonableness, convenience, purposeful availment, and balancing of interests should not complicate determination of personal jurisdiction).

and hold that forum sales of the patented product are relevant to personal jurisdiction.  

I. BACKGROUND

A court’s jurisdiction over a defendant is a major hurdle that a plaintiff must clear before a court will address the merits of the case. Court proceedings must comport with the constitutional requirement of due process. The Supreme Court has laid down a flexible framework for personal jurisdiction evaluation. Under
this framework, a court evaluates the defendant’s contacts with the forum state and their relation to the cause of action.\textsuperscript{50} The basic inquiry is one of fairness: it is unfair to drag an unsuspecting defendant to court in a distant jurisdiction without a sufficient nexus.\textsuperscript{51}

The personal jurisdiction framework has important implications in patent declaratory judgment actions, where a would-be defendant preemptively sues a would-be plaintiff.\textsuperscript{52} In typical patent infringement suits, it is easy to establish that the alleged infringer has contacts in the state where the allegedly infringing acts occurred.\textsuperscript{53} However, in patent non-infringement declaratory judgment actions, the alleged infringer must establish the court’s jurisdiction over the patentee, who may have little

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\textsuperscript{50} \textit{See Asahi}, 480 U.S. at 112; \textit{Burger King}, 471 U.S. at 475; \textit{Helicopteros}, 466 U.S. at 423; \textit{World-Wide Volkswagen}, 444 U.S. at 297; \textit{Hanson}, 357 U.S. at 253; \textit{Int’l Shoe}, 326 U.S. at 316.  
\textsuperscript{51} \textit{Burger King}, 471 U.S. at 474; \textit{see also} Perkins v. Benguet Consol. Mining Co., 342 U.S. 437, 446 (1952) (stating that essence of issue, at constitutional level, is one of general fairness to defendant corporation); \textit{Int’l Shoe}, 326 U.S. at 316.  
\textsuperscript{52} \textit{See} Highway Equip. Co. v. FECO, Ltd., 469 F.3d 1027, 1033 (Fed. Cir. 2006); Red-Wing Shoe Co. v. Hockerson-Halberstadt, Inc., 148 F.3d 1355, 1360 (Fed. Cir. 1998); Super Sack Mfg. Corp. v. Chase Packaging Corp., 57 F.3d 1054, 1058-59 (Fed.Cir. 1995); BP Chems. Ltd. v. Union Carbide Corp., 4 F.3d 975, 977-78 (Fed. Cir. 1993) (stating that Act purported to enable accused infringers to initiate legal action and obtain judicial resolution).  
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forum contacts. The Federal Circuit continues to develop its own doctrine on specific personal jurisdiction for patent declaratory judgment actions. The distinctive features of patent law actions combine with the reverse posture of declaratory judgment actions to present unique issues in personal jurisdiction jurisprudence.

A. Patent Law Fundamentals

To understand the issues that a patent non-infringement and invalidity declaratory judgment action presents, it is necessary to review the fundamentals of patent law briefly. The patent process ensures that inventors receive legal protection of their invention for a limited time, in exchange for early disclosure of their invention.

54 See, e.g., Autogenomics, Inc. v. Oxford Gene Tech. Ltd. 566 F.3d 1012, 1014 (Fed. Cir. 2009) (finding that patentee defendant had no registered business in forum state, or any facilities, assets, employees, or agents there); Avocent Huntsville Corp. v. Aten Int’l Co., 552 F.3d 1324, 1327 (Fed. Cir. 2008) (finding that patentee defendant had no registered business, and only some sales activity within forum state); Viam Corp. v. Iowa Export-Import Trading Co., 84 F.3d 424, 429 (same).

55 See, e.g., Breckenridge Pharm., Inc. v. Metabolite Labs., Inc., 444 F.3d 1356, 1363 (Fed. Cir. 2006) (discussing Federal Circuit doctrine for personal jurisdiction); Elecs. for Imaging v. Coyle, 340 F.3d 1344, 1350 (Fed. Cir. 2003) (same); Silent Drive, Inc. v. Strong Indus., 326 F.3d 1194, 1200 (Fed. Cir. 2003) (same); Red Wing Shoe Co. v. Hockerson-Halberstadt, Inc., 148 F.3d 1355, 1360 (Fed. Cir. 1998) (same); Viam, 84 F.3d at 429 (same); Akro Corp. v. Luker, 45 F.3d 1541, 1546 (Fed. Cir. 1995) (same).

56 See Breckenridge, 444 F.3d at 1363; Silent Drive, 326 F.3d at 1200; Red Wing Shoe, 148 F.3d at 1360.


A patent entitles its owner to exclude others from making, using, selling, offering to sell, or importing the patented invention.\(^{59}\) Such activities, if carried out without a license, constitute infringement.\(^{60}\) In a patent infringement suit, the accused infringer will typically assert the affirmative defenses of non-infringement and invalidity of the patent.\(^{61}\) The validity of the patent is, therefore, a cornerstone of patent related litigation.\(^{62}\)

Under U.S. patent law, an inventor must file a patent application within a short period after conceiving of the invention or reducing it to practice.\(^{63}\) The claimed invention must be novel,
that is, the inventor must have been the first to disclose and
describe it.\textsuperscript{64} The invention must also exhibit a minimal degree of
utility, consistent with the constitutional requirement of being
useful for the art.\textsuperscript{65} Further, the invention must be non-obvious: it
must bring to the public something more than the sum total of the
prior art.\textsuperscript{66}

Non-obviousness is the strictest substantive requirement.\textsuperscript{67} An
invention is non-obvious if it would not have been obvious to a
skilled person at the time of its conception.\textsuperscript{68} The primary

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\bibitem{MERGES}\textit{Merges et al.}, supra note 57, at 185.
\bibitem{MCJOHN}\textit{McJohn}, supra note 44, at 166-70 (discussing novelty requirement); Benson, supra note 57, at 278-79 (same). \textit{But see} 35 U.S.C. § 102(b) (providing inventor with one-year "grace period," unique to U.S. patent law, after disclosing invention to file application); \textit{Merges & Duffy}, supra note 57, at 520 (discussing one-year grace period).\textit{John J. Connors, The Patent Law Humbug, Orange County L., July 2009, 32, at 32 (stating that two unique and interrelated features of American patent system are "first to invent" principle and "one-year grace period" within which to file patent); see also McJohn, supra note 44, at 170-72 (discussing content requirements of patent disclosure).
\bibitem{MERGES}35 U.S.C. § 101 (requiring that invention be useful); \textit{McJohn}, supra note 44, at 180-81 (discussing utility requirement); \textit{Merges & Duffy}, supra note 57, at 207-08 (discussing utility requirement in general); Benson, supra note 57, at 279-81 (discussing overview of utility requirement); \textit{see also} Lowell v. Lewis, 15 F. Cas. 1018, 1019 (C.C.D. Mass. 1817) (No. 8,568) (stating that impractical or useless inventions will slip into disregard, and defining relaxed requirement of only minimal utility).
\bibitem{MERGES}See 35 U.S.C. § 103(a) (2006); \textit{McJohn}, supra note 44, at 184-88 (discussing requirement of non-obviousness); \textit{Merges & Duffy}, supra note 57, at 611-17 (discussing requirement of non-obviousness and its origins); Benson, supra note 57, at 279.
\bibitem{MERGES}\textit{Merges & Duffy}, supra note 57, at 611-12 (citing \textit{Nonobviousness — The Ultimate Condition of Patentability} (John F. Witherspoon ed., 1980) and stating that requirements of novelty and utility are relatively mild); \textit{see also} McJohn, supra note 44, at 184; \textit{cf.} \textit{Merges et al.}, supra note 57, at 223 comm. 3.
\bibitem{MERGES}See 35 U.S.C. § 103(a); \textit{Graham v. John Deere Co.}, 383 U.S. 1 (1966); \textit{see also McJohn}, supra note 44, at 184-88 (discussing requirement of non-obviousness); \textit{Merges & Duffy}, supra note 57, at 630 (discussing § 103 as
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obviousness inquiry takes four distinct steps. First, a court must determine the scope and content of the prior art. Second, the court must ascertain the differences between the prior art and the claimed invention. Third, the court must determine the level of ordinary skill in the pertinent art. Against this background, the court may be able to determine whether the invention was obvious. Courts may also consider secondary factors. These include commercial success, long felt but unresolved need, failure of others, and the like. As evidence of commercial success,
patentees usually submit proof of sales volume of the patented product. Thus, the sales volume of the patented product may help establish the patent’s validity. Proving that the patent is valid may be critical to the patent holder, because accused infringers routinely assert the patent’s invalidity as an affirmative defense.

Naturally, accused infringers also assert the defense of non-infringement of the patent. If the patentee should, however,

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see also Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1539 (Fed. Cir. 1983) (stating that evidence of secondary considerations may often be most probative and cogent evidence in record); cf. Jongjitirat, supra note 74, at 621 (arguing that courts should give generally more weight to secondary considerations).

66 See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1382 (Fed. Cir. 1986) (holding that evidence of commercial success of patentee’s monoclonal diagnostic kit supported finding non-obviousness of invention); Simmons Fastener Corp. v. Ill. Tool Works, Inc., 739 F.2d 1573, 1576 (Fed. Cir. 1984) (stating that evidence of commercial success is entitled to great weight); In re Sernaker, 702 F.2d 989, 996 (Fed. Cir. 1983) (finding that patent applicant successfully licensed the invention which established invention’s commercial success and non-obviousness).


68 See 35 U.S.C. § 282 (2006) (providing list of affirmative defenses to patent infringement involving questions of validity); McJohn, supra note 44, at 226-29 (discussing available defenses to infringement suit, other than non-infringement); Millane Whitney, supra note 61, at 276 (stating that in response to patentee’s allegations of infringement, alleged infringers attempt to either invalidate patent or assert defense of non-infringement).

prevail on its patent infringement claim, it will likely be able to obtain damages and even permanent injunctive relief. An injunction would in turn bar the infringer from further harmful activities. An injunction is not automatic where the patent holder would not suffer irreparable harm if an injunction did not issue. A patent holder practicing the invention may obtain a permanent injunction upon sufficient showing of irreparable harm. Infringement of a patent, nevertheless, does not necessarily cause irreparable harm to a patent owner who does not practice or license the invention.

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80 See 35 U.S.C. §§ 283-84 (2006); McJohn, supra note 44, at 236-37 (discussing remedies available in patent infringement actions); Merges & Duffy, supra note 57, at 933; Merges et al., supra note 57, at 348-50. 81 See 35 U.S.C. § 283 (stating that injunction purports to prevent violation of any right secured by patent on such terms as court deems reasonable); Merges & Duffy, supra note 57, at 933-34; Merges et al., supra note 57, at 348 (noting that availability of injunctive relief is traditional aspect of property rights).


83 See eBay, 547 U.S. at 394 (declining to decide if permanent injunctive relief should or should not issue in category of cases and entrusting issue of injunctive relief to equitable discretion of courts); see also Automated, 2009 WL 4878643, at *3; Ecolab, 569 F.3d at 1352; Abbott Labs., 544 F.3d at 1363; z4 Tech., 434 F. Supp. 2d at 440.

84 eBay, 547 U.S. at 393; see also Automated, 2009 WL 4878643, at *3; Ecolab, 569 F.3d at 1352; Abbott Labs., 544 F.3d at 1363; z4 Tech., 434 F. Supp. 2d at 440.
While usually patentees sue infringers for damages and injunctive relief, this is not always the case. An accused infringer who feels threatened by a patent owner may also sue for a declaratory judgment of non-infringement and invalidity of the patent. Before either party can obtain a judgment on the merits, the court must establish that it has power over the defendant to render a decision.

B. The Personal Jurisdiction Framework

The Supreme Court has laid down a flexible framework for the personal jurisdiction inquiry. The framework requires evaluation

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86 See, e.g., Hewlett-Packard Co. v. Acceleron LLC; 587 F.3d 1358, 1360 (Fed. Cir. 2009) (suit for declaratory judgment of non-infringement and invalidity of patent); Autogenomics, Inc. v. Oxford Gene Tech. Ltd., 566 F.3d 1012, 1014 (Fed. Cir. 2009) (same); Viam Corp. v. Iowa Export-Import Trading Co., 84 F.3d 424, 428 (Fed. Cir. 1996) (stating that potential infringement defendant may preempt patentee and initiate suit, challenging enforceability of patent).

87 Cf. Burger King Corp. v. Rudzewicz, 471 U.S. 462, 472 (1985) (stating that Due Process Clause protects individual’s liberty interest in not being subject to binding judgment of forum without jurisdiction); Int’l Shoe Co. v. Washington, 326 U.S. 310, 316 (1945) (stating that proceedings in state courts without jurisdiction would be denial of due process); Pennoyer v. Neff, 95 U.S. 714, 733 (1877) (stating that court proceedings to determine rights and obligations of party over whom that court has no jurisdiction do not constitute due process of law).

of the defendant’s contacts with the forum state. Absent minimally sufficient contacts, the court cannot reasonably require a defendant to defend a suit brought in that forum. Moreover, the defendant must have initiated the contacts with the forum state. If the defendant purposefully avails itself of the forum’s marketplace and its laws and protection, then personal jurisdiction over the defendant is reasonable and fair. However, unilateral activity of the plaintiff or third parties within the forum state does not satisfy the requirement of minimum contacts with the forum. This “purposeful availment” requirement ensures that random,

89 See Int’l Shoe, 326 U.S. at 317; see also Asahi Metal Indus. Co. v. Superior Court, 480 U.S. 102, 112 (1987); Burger King, 471 U.S. at 475; Helicopteros, 466 U.S. at 423; World-Wide Volkswagen Corp. v. Woodson, 444 U.S. 286, 297 (1980); Hanson v. Denckla, 357 U.S. 235, 253 (1958). But see A. Benjamin Spencer, Jurisdiction to Adjudicate: A Revised Analysis, 73 U. Chi. L. Rev. 617, 617 (stating that constitutional doctrine of personal jurisdiction has generated confusion, unpredictability, and extensive satellite litigation over what should be uncomplicated preliminary issue).
90 See Int’l Shoe, 326 U.S. at 317; see also Asahi, 480 U.S. at 112; Burger King, 471 U.S. at 475; Helicopteros, 466 U.S. at 423; World-Wide Volkswagen, 444 U.S. at 297; Hanson, 357 U.S. at 253.
91 See Hanson, 357 U.S. at 253; see also Burger King, 471 U.S. at 476, (stating that if party availed himself of privilege of conducting business within state, then it is reasonable to subject him to burdens of litigation there); McGee v. Int’l Life Ins. Co., 355 U.S. 220, 223 (1957) (finding sufficient for purposes of due process that suit was based on contract which had substantial connection with forum state).
92 Hanson, 357 U.S. at 253; see Burger King, 471 U.S. at 476, (stating that if party availed himself of privilege of conducting business within state, then it is reasonable to subject him to burdens of litigation there); McGee, 355 U.S. at 223 (finding contract substantially connected with forum state and sufficient to satisfy due process).
93 Hanson, 357 U.S. at 253; see Burger King, 471 U.S. at 476; Helicopteros, 466 U.S., at 417; World-Wide Volkswagen, 444 U.S. at 315 (Marshall, J., dissenting).
serendipitous, or attenuated contact in a foreign jurisdiction will not expose an unsuspecting party to a suit there.\textsuperscript{94}

The defendant’s contacts with the forum state must be either continuous and systematic, or the claim must relate to or arise from such contacts.\textsuperscript{95} Continuous and systematic contacts establish general personal jurisdiction.\textsuperscript{96} These contacts need not relate to the cause of action in any way.\textsuperscript{97} If such contacts are less than continuous and systematic, however, the court must either establish specific personal jurisdiction, or decline to hear the case.\textsuperscript{98}

To establish specific personal jurisdiction, the court must find a nexus between the defendant’s contacts and the litigation.\textsuperscript{99} The

\textsuperscript{95} Burger King, 471 U.S. at 472-73; Helicopteros, 466 U.S. at 415-16 (1984); see also Shaffer v. Heitner, 433 U.S. 186, 205 (1977) (stating that modern personal jurisdiction analysis examines relationship among defendant, forum, and litigation).
\textsuperscript{97} See Burger King, 471 U.S. at 472-73 & n.15; Helicopteros, 466 U.S. at 414, n.9, 415-16; see also Perkins, 342 U.S. at 443-45. But see Viam Corp. v. Iowa Export-Import Trading Co., 84 F.3d 424, 427 (stating that even though distinction between general and specific personal jurisdiction is analytically helpful in some fact situations, it is not useful in patent declaratory judgment action).
\textsuperscript{98} See Burger King, 471 U.S. at 472-73 & n.15; Keeton, 465 U.S. at 774; Helicopteros, 466 U.S. at 414; see also Synthes (U.S.A.) v. G.M. Dos Reis Jr. Ind. Com. de Equip. Medico, 563 F.3d 1285, 1297 (Fed. Cir. 2009) (stating that depending on their nature and number, defendant’s contacts with forum can provide court with general jurisdiction or specific jurisdiction); Weide, supra note 30, at 187 (explaining that jurisdiction is “specific” or “limited” absent party’s systematic and continuous contacts with forum, and claim arises out of or relates to party’s act).
\textsuperscript{99} See Burger King, 471 U.S. at 476 n.18; Helicopteros, 466 U.S. at 415-16; Synthes, 563 F.3d at 1297; see also Weide, supra note 30, at 187 (explaining
more attenuated the contacts are with the forum state, the more related they must be to the cause of action to establish jurisdiction. Sporadic or accidental contacts with a state, which are unrelated to the cause of action, are insufficient for personal jurisdiction.

If a defendant merely injects its product into the stream of commerce, courts require some additional contacts with the forum state. However, out-of-state tortious conduct causing injury to persons in the forum state may suffice to establish personal jurisdiction. Under this “adverse effects” test, courts may use that jurisdiction is “specific” or “limited” absent party’s systematic and continuous contacts with forum, and claim arises out of or relates to party’s act.

100 See Perkins, 342 U.S. at 446 (stating that court must consider amount and kind of defendant’s activities within forum state for jurisdiction to be reasonable and just in that state); cf. Hannon v. Beard, 524 F.3d 275, 282 (1st Cir. 2008); United States v. Swiss Am. Bank, Ltd. 274 F.3d 610, 621 (1st Cir. 2001) (describing relatedness as least developed part of due process standard); Adelson v. Hananel, 510 F.3d 43, 49 (1st Cir. 2007) (stating that for specific jurisdiction, First Circuit have broken minimum contacts analysis into three categories: relatedness, purposeful availment, and reasonableness).

101 See Burger King, 471 U.S. at 476 n.18 (noting that single or occasional acts only remotely related to forum may not be sufficient to establish jurisdiction, because of diminished foreseeability of litigation there); see also Int’l Shoe Co. v. Washington, 326 U.S. 310, 318 (1945); World-Wide Volkswagen Corp. v. Woodson, 444 U.S. 286, 299 (1980).


three factors to examine the defendant’s conduct. First, the court may examine the defendant’s knowledge of the adverse effect on the residents of the forum. Second, the court may take into account the defendant’s substantial sales within the forum state or its specific targeting of the forum’s residents. Third, if the defendant offers products for sale on the internet, this may qualify both as contacts with the forum state and as purposeful availment.

Once it finds sufficient minimum contacts, the court must also consider the fairness, or reasonableness, of exercising personal jurisdiction. The court must evaluate five fairness factors. First, the court must consider the defendant’s burden of litigating

104 Calder, 465 U.S. at 789-90 (discussing so-called “Calder factors”); see also Boyko v. Robinson, 321 Fed. App’x 526, 527 (8th Cir. 2009); Brayton Purcell LLP v. Recordon & Recordon, 575 F.3d 981, 986 (9th Cir. 2009); Licciardello v. Lovelady, 544 F.3d 1280, 1285-86 (11th Cir. 2008).
105 Calder, 465 U.S. at 789-90; Brayton Purcell, 575 F.3d at 986; Licciardello, 544 F.3d at 1286.
106 Calder, 465 U.S. at 784, 789; Brayton Purcell, 575 F.3d at 986; Licciardello, 544 F.3d at 1286; see also von Mehren & Trautman, supra note 102, at 1147 (stating that doing business or carrying on continuous course of activity within forum may establish specific personal jurisdiction over defendant).
107 See Brayton Purcell, 575 F.3d at 986-88; Licciardello, 544 F.3d at 1283; cf. Pavlovich v. Superior Court, 58 P.3d 2, 13 (Cal. 2002) (declining to extend personal jurisdiction over defendant but not foreclosing that sales and other conduct over internet may serve as basis for personal jurisdiction).
108 Burger King Corp. v. Rudzewicz, 471 U.S. 462, 476 (1985); see also Burnham v. Superior Court, 495 U.S. 604, 632 (1990) (citing RESTATEMENT (SECOND) OF JUDGMENTS § 8, cmt. a (Tent. Draft No. 5, Mar. 10, 1978)). But see Asahi Metal Indus. Co. v. Superior Court, 480 U.S. 102, 121 (Stevens, J., concurring) (stating that if court first determined that exercise of jurisdiction over defendant would be unfair, then court need not consider defendant’s forum contacts).
109 Burger King, 471 U.S. at 477; World-Wide Volkswagen Corp. v. Woodson, 444 U.S. 286, 292 (1980); see also Floyd & Baradaran-Robison, supra note 26, at 628 (explaining that test is balancing interests of forum and plaintiff against those of defendant).
in the forum state and, secondly, the plaintiff’s interest in maintaining the suit there.\textsuperscript{110} Third, the court must evaluate the forum state’s interest in adjudicating the dispute, and fourth, the judicial system’s interest in the efficient resolution of controversies.\textsuperscript{111} Finally, the court must take into account the shared interest of the states in furthering fundamental social policies.\textsuperscript{112} The defendant bears the burden of proof in the fairness determination: she has to make a compelling case that these considerations render jurisdiction unreasonable.\textsuperscript{113} Consideration of the five fairness factors may also justify personal jurisdiction upon a lesser showing of minimum contacts with the forum state.\textsuperscript{114} In actions for declaratory judgment, however, the parties are in reverse positions.\textsuperscript{115} Thus, the court must consider the

\textsuperscript{110} \textit{Burger King}, 471 U.S. at 477; \textit{World-Wide Volkswagen}, 444 U.S. at 292; Floyd & Baradaran-Robison, \textit{supra} note 26, at 628, 629.
\textsuperscript{111} \textit{Burger King}, 471 U.S. at 477; \textit{World-Wide Volkswagen}, 444 U.S. at 292; Floyd & Baradaran-Robison, \textit{supra} note 26, at 628.
\textsuperscript{112} \textit{Burger King}, 471 U.S. at 477; \textit{World-Wide Volkswagen}, 444 U.S. at 292; \textit{see also} Bauman v. DaimlerChrysler Corp. 579 F.3d 1088, 1105 (9th Cir. 2009) (Reinhardt, J., dissenting) (stating that California has strong interest in adjudicating human rights abuses which tips scale in favor of reasonableness of exercising personal jurisdiction).
\textsuperscript{113} \textit{Burger King}, 471 U.S. at 477; \textit{World-Wide Volkswagen}, 444 U.S. at 292; \textit{see also} Breckenridge Pharm., Inc. v. Metabolite Labs., Inc., 444 F.3d 1356, 1363 (Fed. Cir. 2006).
\textsuperscript{115} See, e.g., Light, \textit{supra} note 24, at 255 (describing declaratory judgment action as putative defendant’s remedy); Ritchie, \textit{supra} note 24, at 127 (stating that declaratory judgment actions confer subject matter jurisdiction on federal courts where putative plaintiff chooses not to initiate suit, but dispute is otherwise ripe); Van Voorhis & Ballinger, \textit{supra} note 24, at 553 (stating
minimum contacts of the declaratory judgment defendant, who
would take the plaintiff’s place in an action for damages.116

C. The Declaratory Judgment Act

The Declaratory Judgment Act of 1934 (“Declaratory
Judgment Act”) purported to eliminate uncertainty in situations
where a party threatens to sue but does not proceed.117 Under
traditional common law, the injured party always had control over
commencing a lawsuit.118 It was, and still is, lawful for a patentee
to inform an alleged infringer of its patent, but not to commence

Declaratory Judgment Act allows accused infringer to force resolution of
matters by suing putative plaintiff).


117 See Doernberg & Mushlin, supra note 23, at 553 (discussing that proponents of Act were concerned with social cost of uncertainty of individuals and corporations about their legal positions); Lisa A. Dolak, Declaratory Judgment Jurisdiction in Patent Cases: Restoring the Balance Between the Patentee and the Accused Infringer, 38 B.C. L. REV. 903, 903 (1997) (stating that Congress enacted Act to provide remedy to accused patent infringers, because threat of infringement liability potentially crippled their enterprises); see also MedImmune v. Genentech, 549 U.S. 118, 128-29 (2007) (stating that Act may also be useful to challenge constitutionality of laws before commencing activities that would be illegal under challenged law); Viam Corp. v. Iowa Export-Import Trading Co., 84 F.3d 424, 428 (Fed. Cir. 1996) (stating that potential defendant now may preempt patentee and initiate suit challenging patent’s enforceability).

118 Doernberg & Mushlin, supra note 23, at 552 & n.100; Dolak, supra note 117, at 905 (stating that prior to 1934, patentees’ economic power was unchecked, as they could effectively paralyze alleged infringers’ enterprise with mere threats of enforcement); cf. Alt vater v. Freeman, 319 U.S. 359, 364 (1943) (rejecting argument that patentee should be allowed control over litigation of validity of its patent so long as patent licensees continued to pay royalties).
infringement action. This left the alleged infringer with only three ways to respond. First, it could enter into a licensing agreement with the patentee. Second, it could cease its allegedly infringing activities, or cease operations altogether. Third, the alleged infringer could continue its operations at the risk of increasing the damages it would have to pay should the patentee eventually prevail.

Congress enacted the Declaratory Judgment Act to eliminate uncertainty in situations where one of the parties threatens to sue but does not proceed. Subcommittee hearings show that

119 See Red Wing Shoe Co. v. Hockerson-Halberstadt, Inc., 148 F.3d 1355, 1357 (Fed. Cir. 1998); Viam, 84 F.3d at 426; Doernberg & Mushlin, supra note 23, at 553, 564; Dolak, supra note 117, at 905.
121 See Shell Oil, 970 F.2d at 886; Doernberg & Mushlin, supra note 23, at 564; Dolak, supra note 117, at 905, 926-28.
122 See Arrowhead, 846 F.2d at 737 (stating that in response to thinly veiled threats from Ecolochem, Arrowhead might have had to abandon its allegedly infringing process); see also Doernberg & Mushlin, supra note 23, at 564; Dolak, supra note 117, at 905.
124 See Arrowhead, 846 F.2d at 734 (Fed. Cir. 1988) (describing scenario that led to enactment of Declaratory Judgment Act); Doernberg & Mushlin, supra note 23, at 553 (stating that proponents of Act were concerned with disturbance in social equilibrium caused by actions that leave persons in doubt about their legal positions); Dolak, supra note 117, at 911; see also BP Chems. Ltd. v. Union
Congress was especially mindful of the problems presented in patent, trademark, and copyright infringement cases. Owners of intellectual property often threaten to sue alleged infringers in the hope of securing a licensing agreement. Without the Declaratory Judgment Act, an accused infringer would have to wait until the property owner sued him to get a judicial declaration of non-infringement.

The Declaratory Judgment Act provides that any federal court may declare the rights of the parties in an actual controversy arising within its jurisdiction. An actual controversy exists if parties of adverse legal interests substantially and immediately

Carbide Corp., 4 F.3d 975, 977-78 (Fed. Cir. 1993) (stating that Act purported to enable persons who were reasonably at legal risk, because of unresolved dispute, to initiate action and obtain judicial resolution).

See Doernberg & Mushlin, supra note 23, at 564; see also BP Chems., 4 F.3d at 977-78 (stating that Act purported to enable persons who were reasonably at legal risk, because of unresolved dispute, to initiate action and obtain judicial resolution); Arrowhead, 846 F.2d at 734 (describing scenario that led to enactment of Declaratory Judgment Act); Dolak, supra note 117, at 911.

Cf. Red Wing Shoe, 148 F.3d. at 1360-61; Shell Oil, 970 F.2d at 886; Overstock.com, Inc. v. Furnace Brook, LLC, 420 F. Supp. 2d 1217, 1222 (D. Utah 2005) (explaining how patentees threaten litigation against potential infringers in foreign fora in hope of licensing agreement).

See BP Chems., 4 F.3d at 977-78 (stating that Act purported to enable persons who were reasonably at legal risk, because of unresolved dispute, to initiate action and obtain judicial resolution); Doernberg & Mushlin, supra note 23, at 553 (discussing societal disturbance resulting from uncertainty of legal rights and obligations); Dolak, supra note 117, at 911 (stating Act affords opportunity for judicial scrutiny of patents that patentee is using to interfere with otherwise lawful conduct potentially beneficial to society).

disagree. Under the Declaratory Judgment Act, a putative defendant can preemptively sue a putative plaintiff to obtain a declaration of its rights and responsibilities.

The Declaratory Judgment Act also provides that a court may at its discretion decline to exercise its jurisdiction. The court may decline to entertain a declaratory judgment action, for example, to abstain from interference with parallel state proceedings, or for other prudential reasons. The court may decline to issue a declaratory judgment if the judgment would not resolve the dispute between the parties. Appellate courts review

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130 See, e.g., Light, supra note 24, at 255 (describing declaratory judgment action as putative defendant’s remedy); Ritchie, supra note 24, at 127 (stating that declaratory judgment actions confer subject matter jurisdiction on federal courts where putative plaintiff chooses not to initiate suit, but dispute is otherwise ripe); Van Voorhis & Ballinger, supra note 24, at 553 (stating Declaratory Judgment Act allows accused infringer to force resolution of matters by suing putative plaintiff).


133 See Wilton, 515 U.S. at 289 (stating that district courts may determine if case is unfit for resolution); Minn. Mining & Mfg. Co. v. Norton, 929 F.2d 670, 672-
discretionary denials of hearing a declaratory judgment action only for abuse of discretion. 134 A court may also decline hearing a declaratory judgment action for lack of personal jurisdiction over the declaratory judgment defendant. 135 Because personal jurisdiction in a patent declaratory judgment action is dependent on issues of patent law, the Federal Circuit’s personal jurisdiction jurisprudence governs the analysis. 136


The Federal Circuit’s doctrine on personal jurisdiction governs the analysis in patent declaratory judgment actions. 137 The doctrine acknowledges that for general personal jurisdiction, the defendant must have continuous and systematic contacts with the forum. 138 Absent such systematic and continuous contacts, the court must

73 (Fed. Cir. 1991) (outlining criteria that favor issuance of declaratory judgment).
134 See, e.g., Wilton, 515 U.S. at 289 (stating that proper application of abuse of discretion standard on appellate review can provide appropriate guidance to lower courts); Sony Elecs., Inc. v. Guardian Media Techs., Ltd., 497 F.3d 1271, 1288 (Fed. Cir. 2007); Elecs. for Imaging, Inc. v. Coyle, 394 F.3d 1341, 1345, 1348 (Fed. Cir. 2005).
137 See Deprenyl, 297 F.3d at 1348; Hildebrand, 279 F.3d at 1354; Graphic Controls, 149 F.3d at 1385.
138 See Autogenomics, 566 F.3d at 1018; Campbell Pet Co. v. Miale, 542 F.3d 879, 884 (Fed.Cir. 2008); Silent Drive, 326 F.3d at 1200.
assess the relationship between the defendant’s contacts with the forum and the claims at bar.\textsuperscript{139} The Federal Circuit uses a three-prong test to determine if the court has jurisdiction that is specific to the cause of action.\textsuperscript{140} First, the defendant must have purposefully directed its activities at residents of the forum state.\textsuperscript{141} Second, the cause of action must arise from or relate to the defendant’s activities within the forum state.\textsuperscript{142} Third, a defendant may present a compelling case that personal jurisdiction is unreasonable under the Supreme Court’s five fairness factors.\textsuperscript{143}

In declaratory judgment actions, the key issue at bar is not whether the defendant’s activities infringe the plaintiff’s patent.\textsuperscript{144} Instead, the plaintiff’s claims of non-infringement and invalidity arise out of the defendant patentee attempting to enforce its patent rights within the forum.\textsuperscript{145} Therefore, the Federal Circuit’s specific personal jurisdiction inquiry in declaratory judgment actions

\textsuperscript{139} Autogenomics, 566 F.3d at 1018; Breckenridge Pharm., Inc. v. Metabolite Labs., Inc., 444 F.3d 1356, 1361 (Fed. Cir. 2006); Silent Drive, 326 F.3d at 1202.
\textsuperscript{140} Autogenomics, 566 F.3d at 1018; Breckenridge, 444 F.3d at 1363; Silent Drive, 326 F.3d at 1201-02.
\textsuperscript{141} Autogenomics, 566 F.3d at 1018; Breckenridge, 444 F.3d at 1363; Silent Drive, 326 F.3d at 1201-02.
\textsuperscript{142} Autogenomics, 566 F.3d at 1018; Breckenridge, 444 F.3d at 1363; Silent Drive, 326 F.3d at 1201-02.
\textsuperscript{143} Autogenomics, 566 F.3d at 1018; Breckenridge, 444 F.3d at 1363; Silent Drive, 326 F.3d at 1201-02.
\textsuperscript{145} See Red Wing Shoe, 148 F.3d. at 1360; Arrowhead, 846 F.2d at 735; cf. Genetic Implant, 123 F.3d at 1458.
addresses the nexus between the defendant’s patent enforcement activities and the forum. The court must first examine if the defendant patentee purposefully directed its enforcement activities at parties within the forum state. Next, the court must examine if the declaratory judgment action arises out of or relates to the patentee’s enforcement activities within the forum state.

Cease-and-desist letters are patent enforcement activities. Nevertheless, due to policy considerations, such cease-and-desist letters, without more, cannot establish personal jurisdiction over a patentee. A patentee should be able to advise others of its patent rights without subjecting itself to a foreign forum’s jurisdiction.

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146 Breckenridge, 444 F.3d at 1363; see Red Wing Shoe, 148 F.3d at 1360; Genetic Implant, 123 F.3d at 1458.
147 Breckenridge, 444 F.3d at 1363; Silent Drive, 326 F.3d at 1202; Genetic Implant, 123 F.3d at 1458; Akro Corp. v. Luker, 45 F.3d 1541, 1545 (Fed. Cir. 1995).
148 Breckenridge, 444 F.3d at 1363; see also MedImmune v. Genentech, 549 U.S. 118, 136 (2007) (eliminating additional requirement of “reasonable apprehension of suit” for subject-matter jurisdiction in declaratory judgment actions); SanDisk Corp. v. ST Microelecs., Inc., 480 F.3d 1372, 1380 (Fed. Cir. 2007) (recognizing that MedImmune rejected “reasonable apprehension of suit” test); cf. Avocent Huntsville Corp. v. Aten Int’l Co., 552 F.3d 1324, 1333 n.2 (Fed. Cir. 2008) (recognizing that after MedImmune it is easier to establish declaratory judgment subject-matter jurisdiction and, therefore, personal jurisdiction inquiry is becoming even more important).
149 See, e.g., Red Wing Shoe, 148 F.3d. at 1360 (discussing cease-and-desist letters); Akro, 45 F.3d at 1546 (same); Viam Corp. v. Iowa Export-Import Trading Co., 84 F.3d 424, 429 (Fed. Cir. 1996) (same).
150 Red Wing Shoe, 148 F.3d. at 1360-61; Genetic Implant, 123 F.3d at 1458; cf. Akro, 45 F.3d at 1548 (listing earlier cases holding that patent enforcement letters, without more, do not support specific personal jurisdiction). But see Luxardo, supra note 45, at 823 (quoting Overstock.com, Inc. v. Furnace Brook, LLC, 420 F. Supp. 2d 1217, 1222 (D. Utah 2005) (stating that patent trolls thrive under Federal Circuit’s doctrine threatening litigation against potential infringers in foreign fora without fear of being subject to suit themselves)).
151 Red Wing Shoe, 148 F.3d. at 1360-61. But see Peter E. Heuser & Robert A. Shlachter, Column, Legal Practice Tips: If You're Going to Do It, Do It Right:
Consequently, the Federal Circuit requires that a declaratory judgment defendant have additional enforcement contacts with the forum state that relate to the cause of action.\textsuperscript{152}

The Federal Circuit has developed this doctrine into an exacting measure of additional enforcement activities.\textsuperscript{153} These activities must be judicial or extra-judicial proceedings, or entering into an exclusive license, or otherwise undertaking patent enforcement obligations in the forum state.\textsuperscript{154} The defendant’s own commercialization of the patented product does not necessarily

\textsuperscript{152} Breckenridge, 444 F.3d at 1363-67; Red Wing Shoe, 148 F.3d. at 1360-61; Akro, 45 F.3d 1541.

\textsuperscript{153} Breckenridge, 444 F.3d at 1363-67 (explaining requirement of licensing or other undertaking of enforcement obligations); Red Wing Shoe, 148 F.3d. at 1360-61; Akro, 45 F.3d 1541. But see Weide, supra note 30, at 178 (criticizing inconsistent rulings asserting personal jurisdiction over patent owners who had minimal contacts with forum).

\textsuperscript{154} See Avocent Huntsville Corp. v. Aten Int’l Co., 552 F.3d 1324, 1334 (Fed. Cir. 2008) (listing examples of enforcement activities as judicial or extra-judicial enforcement within forum, entering into exclusive licensing agreement or other undertaking of enforcement obligations with party residing or doing business in forum); see also Breckenridge, 444 F.3d at 1363-67 (explaining requirement of licensing or other undertaking of enforcement obligations); Campbell Pet Co. v. Miale, 542 F.3d 879, 886 (Fed. Cir. 2008) (finding jurisdiction in case of extra-judicial patent enforcement attempt); Silent Drive, Inc. v. Strong Indus., 326 F.3d 1194, 1202 (Fed. Cir. 2003) (noting courts have held exclusive license agreements sufficient to confer personal jurisdiction); Inamed Corp. v. Kuzmak, 249 F.3d 1356, 1361 (Fed. Cir. 2001) (finding jurisdiction where patentee granted exclusive license); Red Wing Shoe, 148 F.3d at 1362 (noting patentee’s substantial contacts with its exclusive licensee may be sufficient nexus to establish specific personal jurisdiction); Genetic Implant Sys., 123 F.3d 1455, 1458 (Fed. Cir. 1997) (finding exclusive distributor analogous to patent licensee); Akro, 45 F.3d at 1543, 1548-49 (finding personal jurisdiction over patentee who had exclusively licensed patent to competitor of plaintiff with obligation to defend and pursue any infringement).
relate to the patentee’s amenability to specific personal jurisdiction. These sales establish personal jurisdiction only if the patentee entered into an exclusive license agreement or similar contract. Such agreements usually create an affirmative obligation on the patentee to defend or pursue alleged infringement activities by suit. Receipt of royalties or other proceeds from the forum state, without an affirmative obligation for patent


156 See Breckenridge, 444 F.3d at 1363-67 (explaining requirement of licensing or other undertaking of enforcement obligations); Silent Drive, 326 F.3d at 1202 (noting courts have held exclusive license agreements sufficient to confer personal jurisdiction); Inamed, 249 F.3d at 1361 (finding jurisdiction where patentee granted exclusive license); Red Wing Shoe, 148 F.3d at 1362 (noting patentee’s substantial contacts with its exclusive licensee may provide sufficient nexus to establish specific personal jurisdiction); Genetic Implant, 123 F.3d at 1458 (finding exclusive distributor analogous to patent licensee and thus sufficient to establish specific personal jurisdiction); Akro, 45 F.3d at 1543, 1548-49 (finding specific personal jurisdiction over patentee who had exclusively licensed patent to competitor of plaintiff with obligation to defend and pursue any infringement).

157 See Akro, 45 F.3d at 1543, 1548-49 (examining exclusive license’s terms as to its creation of obligation to defend and pursue any infringement); cf. Avocent, 552 F.3d at 1336 (stating that even patentee’s exclusive licensing and enforcement activities raise questions as to propriety of assertion of personal jurisdiction over non-resident defendant).
enforcement is insufficient for personal jurisdiction.\textsuperscript{158} In \textit{Avocent}, the Federal Circuit had to decide the relevance of the patentee’s forum sales in addition to its notice letters.\textsuperscript{159}

\section*{II. The Federal Circuit’s Decision in \textit{Avocent Huntsville Corp. v. Aten International Co.}}

Avocent Huntsville Corporation, having a principal place of business in Alabama, develops and markets computer hardware devices.\textsuperscript{160} Aten International Co. is a Taiwanese company that is also in the computer hardware business.\textsuperscript{161} The two companies are in fierce competition in the manufacture and sale of keyboard-video-mouse (“KVM”) switches.\textsuperscript{162} KVM switches allow multiple computer users to share computer video equipment and keyboards or mice.\textsuperscript{163} Both Avocent and Aten own patents on KVM switch configurations.\textsuperscript{164} This case arose from Aten’s enforcement efforts of two of its KVM switch patents.\textsuperscript{165}

Aten first sent a letter to Avocent advising that the United States Patent and Trademark Office (“USPTO”) had published

\begin{footnotes}
\item\textsuperscript{158} Autogenomics, Inc. v. Oxford Gene Tech. Ltd., 566 F.3d 1012, 1019 (Fed. Cir. 2009); \textit{Avocent}, 552 F.3d at 1335; \textit{Breckenridge}, 444 F.3d at 1366.
\item\textsuperscript{159} \textit{Avocent}, 552 F.3d at 1335.
\item\textsuperscript{160} \textit{Avocent Huntsville Corp. v. Aten Int’l Co.}, 552 F.3d 1324, 1327 (Fed. Cir. 2008).
\item\textsuperscript{161} Id.
\item\textsuperscript{162} See \textit{id}.
\item\textsuperscript{163} Id.
\item\textsuperscript{164} Id.
\item\textsuperscript{165} Id.
\end{footnotes}
Aten’s patent application.\textsuperscript{166} Aten requested that Avocent review the patent because they believed that the claims related to a product that Avocent was making, using, selling, or importing.\textsuperscript{167} After the USPTO issued the patent, Aten wrote a letter to Amazon.com’s headquarters, encouraging them to discontinue selling the allegedly infringing KVM switches.\textsuperscript{168} Finally, Aten wrote a letter to Avocent’s counsel, asserting that Avocent infringed the Aten patent.\textsuperscript{169}

Avocent filed a suit for declaratory judgment of non-infringement and invalidity of Aten’s patent in the Northern District Court of Alabama.\textsuperscript{170} Aten moved for dismissal under Federal Rule of Civil Procedure 12(b)(2) for lack of personal jurisdiction.\textsuperscript{171} The district court granted Aten’s motion to dismiss the action without prejudice, holding that it could not establish personal jurisdiction over Aten.\textsuperscript{172} Avocent appealed to the Federal Circuit.\textsuperscript{173} The Federal Circuit affirmed, and held that there was no personal jurisdiction over Aten in Alabama.\textsuperscript{174}

\textsuperscript{166} Id.
\textsuperscript{167} Id.
\textsuperscript{168} Id.
\textsuperscript{169} Id. at 1327-28.
\textsuperscript{170} Id. at 1328.
\textsuperscript{171} Id.
\textsuperscript{172} Id.
\textsuperscript{173} Id.
\textsuperscript{174} Id. at 1340.
The court held that Aten’s sales through retailers in Alabama did not amount to continuous and systematic activity sufficient to establish general personal jurisdiction.\footnote{Id. at 1337.} Turning to specific personal jurisdiction, the court held that a patentee’s own sales of the patented product in the forum state were insufficient contacts.\footnote{Id.} The court reasoned that such sales do not, in the jurisdictional sense, relate to the patent right at issue.\footnote{Id. (citing Leatherman Tool Group Inc. v. Cooper Indus., 131 F.3d 1011, 1015 (Fed. Cir. 1997) (stating that patents do not create affirmative right to make, use, or sell anything) and Bloomer v. McQuewan, 55 U.S. (14 How.) 539, 549 (1852) (same)).} While the defendant’s sales may support a finding of general personal jurisdiction, they do not establish a basis for specific personal jurisdiction.\footnote{Avocent, 552 F.3d at 1337; see also Helicopteros Nacionales de Colombia, S.A. v. Hall, 466 U.S. 408, 415 (1984).} For specific personal jurisdiction, only those purposeful activities count that relate to the enforcement of the patent at issue.\footnote{Avocent, 552 F.3d at 1336. But see von Mehren & Trautman, supra note 102, at 1147 (stating that doing business or carrying on continuous course of activity within forum may establish specific personal jurisdiction over defendant).}

The court acknowledged a concern that foreign patentees may be able to isolate themselves from domestic litigation due to their nebulous corporate personas.\footnote{Avocent, 552 F.3d at 1339; see also Viam Corp. v. Iowa Export-Import Co., 84 F.3d 424, 430 (Fed. Cir. 1996).} Such concerns, however, cannot obviate the need for finding personal jurisdiction over the
defendant. Furthermore, the patent statute alleviates this concern, because it mandates every patentee to designate a person for service of process at the USPTO. In the absence of such designation, the District Court for the District of Columbia will have jurisdiction for actions respecting the patent. Further, the D.C. District Court would have supplemental jurisdiction to adjudicate Avocent’s state law claims.

The court then analyzed Avocent’s “adverse effect” theory as an independent basis for personal jurisdiction. Aten’s letters to Amazon.com were not relevant to the patent claims. The letters

181 Avocent, 552 F.3d at 1339.
182 Id.; see also 35 U.S.C. § 293 (2006) (establishing that in absence of designation of person for service of process, District Court for District of Columbia shall have jurisdiction for patent claims).
183 Avocent, 552 F.3d at 1339; see also 35 U.S.C. § 293.
184 Avocent, 552 F.3d at 1339 (citing Elecs. for Imaging v. Coyle, 340 F.3d 1344, 1348 n. 1 (Fed. Cir. 2003) (stating that if district court had personal jurisdiction for patent claims, it would also have personal jurisdiction over defendants as to two state law claims)); Silent Drive, Inc. v. Strong Indus., 326 F.3d 1194, 1206 (Fed. Cir. 2003) (stating that supplemental jurisdiction existed with respect to both subject-matter and personal jurisdiction where claims satisfy same case or controversy requirement); Inamed Corp. v. Kuzmak, 249 F.3d 1356, 1362-63 (Fed. Cir. 2001) (holding that district court had both personal jurisdiction over plaintiff’s patent misuse claim and supplemental jurisdiction over other causes of action); Oetiker v. Jurid Werke, G.m.b.H., 556 F.2d 1, 5 (D.C. Cir.1977) (finding that supplemental jurisdiction may be helpful in achieving purposes of § 293 to give American manufacturers relief against harassment by foreign patent holders). But see Avocent, 552 F.3d at 1348 (Newman, J., dissenting) (disputing majority’s assertion that District Court of District of Columbia would exercise supplemental jurisdiction or be adequate alternative forum for this litigation).
185 Avocent, 552 F.3d at 1340. But see id. at 1342 (Newman, J., dissenting) (stating that by taking Aten’s contacts one by one, in isolation, Avocent majority failed to appreciate Aten’s involvement with Alabama as whole).
186 Id. at 1340 (majority opinion). But see id. at 1348 (Newman, J., dissenting) (stating that Aten’s interference with business practices of Avocent caused sufficient harm in Alabama to anchor jurisdiction there especially together with Aten’s other Alabama contacts).
would have been justifiable if the Avocent KVM switches had in fact infringed the Aten patent. Furthermore, a patentee may send cease-and-desist letters to suspected infringers or their customers without subjecting itself to personal jurisdiction in the states of each recipient. The Federal Circuit’s doctrine requires additional contacts with the state for personal jurisdiction, and such contacts are restricted to the existence of an exclusive license. Accordingly, the court found that Alabama did not have personal jurisdiction over Aten. Thus, the Federal Circuit held that, absent general personal jurisdiction, a court must exclude all forum sales of the patentee from the minimum contacts analysis.

\[\text{Id. at } 1340 \text{ (majority opinion) (stating that because patent laws were material to this claim, Federal Circuit law applied to personal jurisdiction of court to adjudicate it); see infra Part III.A (discussing how this arguments assumes that patent is valid).} \]

\[\text{Avocent, } 552 \text{ F.3d at } 1340; \text{ see also Breckenridge Pharm., Inc. v. Metabolite Labs., Inc., } 444 \text{ F.3d } 1356, 1362 \text{ (Fed. Cir. 2006). But see Avocent, } 552 \text{ F.3d at 1343 (Newman, J., dissenting) (stating that court need not decide whether infringement letter, without more, would provide personal jurisdiction over sender, because several additional factors provide necessary weight).} \]

\[\text{Avocent, } 552 \text{ F.3d at } 1340; \text{ cf. id. at } 1336 \text{ (stating that even patentee’s exclusive licensing and enforcement activities raise questions as to propriety of assertion of personal jurisdiction over non-resident defendant). But see id. at 1341 (Newman, J., dissenting) (stating that distinction between selling products through exclusive licensee versus selling products directly or through subsidiary was delicate and contrary to precedent).} \]

\[\text{Id. at } 1340 \text{ (majority opinion). But see id. at } 1347 \text{ (Newman, J., dissenting) (stating that Aten born burden but failed to establish that exercise of jurisdiction over it would be unreasonable or unfair); see also Perkins v. Benguet Consol. Mining Co., } 342 \text{ U.S. } 437, 446 \text{ (1952) (stating that issue is one of fairness towards defendant corporation).} \]

\[\text{Avocent, } 552 \text{ F.3d at 1336.} \]
However, the Federal Circuit’s holding was incorrect, because the patentee’s forum sales are relevant to the patent claims at bar.\textsuperscript{192}

\section{Analysis}

The \textit{Avocent} court erroneously held that a patentee’s sales in the forum state are irrelevant to the issue of specific personal jurisdiction.\textsuperscript{193} First, the patentee’s sales of the patented product are relevant to establish the patent’s validity.\textsuperscript{194} \textit{Avocent} erroneously held that because the patentee’s sales are possibly irrelevant to the claim of non-infringement, they are also irrelevant to other patent claims.\textsuperscript{195} Second, \textit{Avocent} failed to consider that the patentee’s sales of the patented product are relevant to establishing the proper remedy for the patent infringement.\textsuperscript{196} Third, economic analysis supports a finding of personal jurisdiction in patent declaratory judgment actions, especially against foreign patent owners.\textsuperscript{197} Resolution of the declaratory judgment action would likely enhance competition within the forum state while causing relatively little inconvenience to the

\begin{flushright}
\textsuperscript{192} See infra Part III.
\textsuperscript{193} See infra Part III.
\textsuperscript{194} See infra Part III.A.
\textsuperscript{195} \textit{Avocent}, 552 F.3d at 1340. \textit{But see} von Mehren & Trautman, \textit{supra} note 102, at 1147 (stating that doing business or carrying on continuous course of activity within forum may establish specific personal jurisdiction over defendant).
\textsuperscript{196} eBay v. MercExchange, LLC, 547 U.S. 388 (2006); \textit{see also infra} Part III.B.
\textsuperscript{197} See infra Part III.C.
\end{flushright}
Furthermore, the accused infringer should receive the benefit of forum selection for incurring the costs of

198 See State Indus. v. A.O. Smith Corp., 751 F.2d 1226, 1236 (Fed. Cir. 1985) (highlighting one of many benefits of patent system: it incentivizes design around competitor’s patented product, thus bringing steady flow of innovations to marketplace); McJohn, supra note 44, at 229 (stating that patented products compete with products not covered by patent if there is market for patented invention at all); Kline, supra note 25, at 252 (stating that competitors are free to attempt to design around patent and develop their own solutions, but they risk subjecting themselves to infringement liability); Spencer, supra note 89, at 623 (stating that today notions of inconvenience and burden to travel has reduced vitality in particular for corporate defendants accustomed to operating on international level); cf. Riou, supra note 44, at 803
commencing the litigation.\textsuperscript{199}

A. Avocent \textit{Erroneously Held that the Patentee’s Sales Do Not Relate to the Patent Claims at Bar}

\textit{Avocent} erroneously held that a patentee’s sales are irrelevant to the patent claims at bar, and thus not relevant for specific personal jurisdiction either.\textsuperscript{200} \textit{Avocent} held that a patentee’s patent enforcement activities give rise to an accused infringer’s declaratory judgment claim.\textsuperscript{201} Therefore, only the patentee’s


(stating that amorphous concepts of fairness, reasonableness, convenience, purposeful availment, and balancing of interests should not complicate determination of personal jurisdiction).

\textsuperscript{199} \textit{Cf.} Luxardo, \textit{supra} note 45, at 823 (quoting Overstock.com, Inc. v. Furnace Brook, LLC, 420 F. Supp. 2d 1217, 1222 (D. Utah 2005) (stating that patent trolls thrive under Federal Circuit’s doctrine threatening litigation against potential infringers in foreign fora without fear of being subject to suit themselves)); \textit{see also} Kline, \textit{supra} note 25, at 272 (highlighting patent troll problem and that trolls now have effective control over locus of any patent-related litigation). \textit{But see} Weide, \textit{supra} note 30, at 178 (arguing that liberal findings of personal jurisdiction in patent declaratory judgment actions may conflict with public policy and statutory rights of patent owner).

\textsuperscript{200} \textit{Cf.} Viam Corp. v. Iowa Export-Import Trading Co., 84 F.3d 424, 428-29 (Fed. Cir. 1996) (anchoring personal jurisdiction in patent declaratory judgment action to patentee’s sales of its products within forum state); Akro Corp. v. Luker, 45 F.3d 1541, 1548 (Fed. Cir. 1995) (finding that sales by licensee within forum state of patented product was sufficient to establish jurisdiction); B&J Mfg. v. Solar Indus., 483 F.3d 594, 598-99 (8th Cir. 1973) (stating that selling other products but patented item in forum state was sufficient to establish jurisdiction; patentee cannot avoid suit by not selling patented product there); von Mehren & Trautman, \textit{supra} note 102, at 1147 (stating that doing business or carrying on continuous course of activity within forum may establish specific personal jurisdiction over defendant).

\textsuperscript{201} Avocent Huntsville Corp. v. Aten Int’l Co., 552 F.3d 1324, 1334 (Fed. Cir. 2008).
patent enforcement activities have a sufficient nexus to the entire litigation.\textsuperscript{202} However, a patentee cannot lawfully enforce an invalid patent.\textsuperscript{203} Without a valid patent, there is no right to exclude, and thus no infringement action can stand.\textsuperscript{204} Therefore, actions affecting a patent’s validity should be relevant in the specific personal jurisdiction inquiry.\textsuperscript{205}

\footnotesize
\textsuperscript{202} Id.
\textsuperscript{204} See McJohn, supra note 44, at 226-29 (discussing available defenses to infringement suit, other than non-infringement); Millane Whitney, supra note 61, at 276 (stating that in response to patentee’s allegations of infringement, alleged infringers attempt to either invalidate patent or assert defense of non-infringement); \textit{cf.} Avocent, 552 F.3d at 1346 (Newman, J., dissenting) (stating that infringement of patent is compulsory counterclaim in declaratory judgment actions); Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473, 1475 (Fed. Cir. 1998) (consolidating earlier filed action for declaratory judgment action of invalidity and non-infringement with infringement action); Millane Whitney, supra note 61, at 276 (stating that in response to patentee’s allegations of infringement, alleged infringers attempt to either invalidate patent or assert defense of non-infringement).
\textsuperscript{205} See Helicopteros, 466 U.S. at 416 n.10 (declining to decide whether terms “arising out of” and “related to” describe different connections between defendant’s contacts and forum, and what nexus is exactly necessary). \textit{But see id.} at 420 (Brennan, J., dissenting) (warning that by refusing to distinguish requirements of “related to” and “arising out of,” court severely limited type and amount of contacts satisfying constitutional minimum); von Mehren & Trautman, supra note 102, at 1147 (stating that doing business or carrying on continuous course of activity within forum may establish specific personal jurisdiction over defendant).
The patentee’s sales of the patented product are relevant to establish the patent’s validity. The patentee’s sales of its product may evidence that the underlying invention is non-obvious, and thus, support a finding of the patent’s validity. As the plaintiff asserted both non-infringement and invalidity of the patent, both of these claims should be relevant to the court’s jurisdiction.

Avocent erroneously held that because the patentee’s sales are arguably irrelevant to the claim of non-infringement, they are also irrelevant to the other patent claims. Establishing the patent’s validity is a necessary element of finding infringement. Thus,

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207 See KSR, 550 U.S. at 399; Graham, 383 U.S. at 17; Jongjitirat, supra note 74, at 612; Robbins, supra note 75, at 1172-84.
208 Cf. Broadview Chem. Corp. v. Loctite Corp., 474 F.2d 1391, 1394 (2d Cir. 1973) (stating that court has discretion to decide which claim, validity or infringement, to decide first). But see Sinclair & Carroll Co. v. Interchem. Corp., 325 U.S. 327, 330 (1945) (stating that better practice is inquiring fully into validity of patent before moving onto infringement issue, as validity is of more importance to society).
209 See Avocent, 552 F.3d at 1335 (citing Bloomer v. McQuewan, 55 U.S. (14 How.) 539, 549 (1852) and Leatherman Tool Group Inc. v. Cooper Indus., 131 F.3d 1011, 1015 (Fed. Cir. 1997)); see also Polymers, Inc. v. Ultra Flo Filtration Sys., Inc., 33 F.Supp.2d 1008, 1017 (M.D. Fla. 1998) (holding that sale of patented goods in Florida is not sufficiently connected to cause of action to obtain declaratory judgment of non-infringement); DP Envtl. Servs., Inc. v. Bertlesen, 834 F.Supp. 162, 166 (M.D.N.C. 1993) (stating “stream of commerce” theory is inapplicable where cause of action did not arise from such contacts); Ryobi Am. Corp. v. Peters, 815 F.Supp. 172, 177 (D.S.C. 1993) (stating that declaratory judgment jurisdiction does not flow from actual manufacture of patented item by patent holder or licensee).
210 See Broadview, 474 F.2d at 1394 (stating that whether court should determine first validity is matter for trial court’s discretion). But see Sinclair, 325 U.S. at 330 (stating that better practice is inquiring fully into validity of patent before moving onto infringement issue, as patent validity is of more importance to society).
Avocent erred when it found Aten’s sales of the patented product unrelated to Avocent’s non-infringement claim.\textsuperscript{211} However, those who favor Avocent’s approach may argue that the Federal Circuit justifiably dismissed the patentee’s sales of the patented product.\textsuperscript{212} Such sales fail to establish minimum contacts because they do not create a continuing obligation to enforce the patent.\textsuperscript{213} The relationship seems too attenuated between the patentee’s sales and the declaratory judgment action.\textsuperscript{214} Supreme

\textsuperscript{211} See Sinclair, 325 U.S. at 330 (praising district court’s approach in first evaluating patent’s validity before turning to infringement issues); see also Cover v. Schwartz, 133 F.2d 541, 545 (2d Cir. 1942) (describing as more important to decide validity first; if court found non-infringement, it could not also find patent invalid for mootness or lack of controversy).\textsuperscript{212} See Avocent, 552 F.3d at 1335 (citing Bloomer, 55 U.S. (14 How.) at 549 and Leatherman, 131 F.3d at 1015); Weide, supra note 30, at 178 (arguing for narrowing personal jurisdiction in patent declaratory judgment actions to better protect statutory rights of patent owner).\textsuperscript{213} See Avocent, 552 F.3d at 1335; see also Polymers, 33 F. Supp. 2d at 1017 (holding that distribution of patentee’s patented goods in Florida is not intimately or sufficiently connected to cause of action to obtain declaratory judgment of non-infringement); DP Envtl., 834 F. Supp. at 166 (stating that stream of commerce theory is inapplicable where cause of action did not arise from sale of manufacturer’s products in forum state); Ryobi, 815 F. Supp. at 177 (stating that declaratory judgment jurisdiction does not flow from actual manufacture of patented item by patent holder or licensee). But see von Mehren & Trautman, supra note 102, at 1147 (stating that doing business or carrying on continuous course of activity within forum may establish specific personal jurisdiction over defendant).\textsuperscript{214} Polymers, 33 F. Supp. 2d at 1017 (holding that distribution of patentee’s patented goods in Florida is not intimately or sufficiently connected to cause of action to obtain declaratory judgment of non-infringement); DP Envtl., 834 F. Supp. at 166 (stating that stream of commerce theory is inapplicable where cause of action did not arise from sale of manufacturer’s products in forum state); Ryobi, 815 F. Supp. at 177 (stating that declaratory judgment jurisdiction does not flow from actual manufacture of patented item by patent holder or licensee). But see SRAM Corp. v. Sunrace Roots Enter. Co., 390 F. Supp. 2d 781, 787 (N.D. Ill. 2005) (holding that declaratory judgment defendant had purposefully directed its activities at residents of forum by marketing product in direct competition with allegedly infringing product); Stomp, Inc. v. NeatO. LLC, 61 F. Supp. 2d 1074 (C.D. Cal. 1999) (holding that declaratory judgment
Court precedent teaches that single or occasional acts, even if related to the forum, are too attenuated and insufficient to establish specific personal jurisdiction.\textsuperscript{215} Therefore, the Federal Circuit justifiably discounted such attenuated contacts from the personal jurisdiction analysis.\textsuperscript{216}

This argument fails, however, because precedent only requires that the claim at bar arise out of or relate to some contact with the forum state.\textsuperscript{217} Supreme Court precedent requires only a substantial relationship to the claim for specific personal jurisdiction.\textsuperscript{218} On the other hand, \textit{Avocent} requires that the patentee’s activities within the forum state be sufficient to give rise to the declaratory action for patent non-infringement may proceed in California because patentee’s interactive website offered patented device for sale).


\textsuperscript{216} See \textit{Avocent}, 552 F.3d at 1336; \textit{cf}. Autogenomics, Inc. v. Oxford Gene Tech. Ltd., 566 F.3d 1012, 1020 (Fed. Cir. 2009) (citing \textit{Avocent}, 552 F.3d at 1336, in holding that patentee’s own commercialization efforts are not relevant for specific personal jurisdiction); William C. Rooklidge & Alyson G. Barker, Reform of a Fast-Moving Target: The Development of Patent Law Since the 2004 National Academies Report, 91 J. PAT. & TRADEMARK OFF. SOC’Y 153, 185 n.199 (2009) (stating that after \textit{Avocent}, declaratory judgment plaintiff’s ability to choose forum is nowhere near as broad as that of ordinary patent infringement plaintiff).

\textsuperscript{217} See Helicopteros Nacionales de Colombia, S.A. v. Hall, 466 U.S. 408, 414-16 (1984); Calder v. Jones, 465 U.S. 783, 787 (1984) (jurisdiction found where cause of action directly arose from contacts with state); see also von Mehren & Trautman, \textit{supra} note 102, at 1144-45 (stating that in specific jurisdiction, assertion of power to adjudicate is limited to matters arising out of or intimately related to basis of jurisdictional claim).

This requirement unduly limits the scope of personal jurisdiction that precedent allows. Furthermore, *Avocent* failed to consider that the patentee’s sales of the patented product might also establish that the patentee is practicing the invention.

B. *Avocent* Failed to Consider that the Patentee’s Sales of the Patented Product Might Also Establish Its Practicing Entity Status

*Avocent* failed to consider that the patentee’s sales of the patented product are relevant to establishing that it is practicing the patented invention. The Supreme Court recently held that the patentee’s practicing of the invention is relevant for finding the

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219 *Avocent*, 552 F.3d at 1333.

220 See *Helicopteros*, 466 U.S. 420 (Brennan, J., dissenting) (warning that by refusing to distinguish requirements of “related to” and “arising out of,” court severely limited type and amount of contacts satisfying constitutional minimum); von Mehren & Trautman, *supra* note 102, at 1147 (stating that doing business or carrying on continuous course of activity within forum may establish specific personal jurisdiction over defendant). But see *Helicopteros*, 466 U.S. at 416 n.10 (declining to decide whether terms “arising out of” and “related to” describe different connections between defendant’s contacts and forum, and what nexus is exactly necessary).

221 See *eBay* v. MercExchange, LLC, 547 U.S. 388, 393 (2006); see also Automated Merch. Sys., Inc. v. Crane Co., Nos. 2009-1158, 2009-1164, 2009 WL 4878643, at *3 (Fed. Cir. Dec. 16, 2009); Ecolab, Inc. v. FMC Corp., 569 F.3d 1335, 1352 (Fed. Cir. 2009); Abbott Labs. v. Sandoz, Inc., 544 F.3d 1341, 1363 (Fed. Cir. 2008) (stating that *eBay*’s legal and equitable factors may be of different weight depending on whether patentee is practicing invention or merely licenses it); Kline, *supra* note 25, at 268.

222 See *eBay*, 547 U.S. at 393; see also Automated, 2009 WL 4878643, at *3; *Ecolab*, 569 F.3d at 1352; *Abbott*, 544 F.3d at 1363 (stating that *eBay*’s legal and equitable factors may be of different weight depending on whether patentee is practicing invention or merely licenses it); Kline, *supra* note 25, at 268 (distinguishing patent licensing or practicing organizations, which establish contacts with forum state through sales or other marketing activities, and patent holding organizations, which do not).
proper remedy for patent infringement.223 An injunction is not automatic where the patent holder would not suffer irreparable harm if an injunction did not issue.224 Infringement does not necessarily cause irreparable harm to a patentee that does not itself practice the patent, and is not licensing its patent rights either.225 Sales of the patented product indicate that the patentee is an entity actually practicing the patent, not a “patent troll.”226 Thus, sales of

223 See eBay, 547 U.S. at 392-94; see also Automated, 2009 WL 4878643, at *3; Ecolab, 569 F.3d at 1352; Abbott, 544 F.3d at 1363 (stating that eBay’s legal and equitable factors may be of different weight depending on whether patentee is practicing invention or merely licenses it).

224 eBay, 547 U.S. at 392-93, 393-94 (stating also that there is no automatic denial of preliminary injunction based on patentee’s non-practicing status); see also z4 Tech., Inc. v. Microsoft Corp., 434 F. Supp. 2d 437, 440 (E.D. Tex. 2006); cf. MCI JOHN, supra note 44, at 236 (stating prior general rule that permanent injunction would automatically issue once court established infringement and validity).

225 eBay, 547 U.S. at 393; see also Automated, 2009 WL 4878643, at *3; Ecolab, 569 F.3d at 1352; Abbott, 544 F.3d at 1363 (stating that eBay’s legal and equitable factors may be of different weight depending on whether patentee is practicing invention or merely licenses it).

226 Luxardo, supra note 45, at 823 (quoting Overstock.com, Inc. v. Furnace Brook, LLC, 420 F. Supp. 2d 1217, 1222 (D. Utah 2005) (stating that patent trolls thrive under Federal Circuit’s doctrine, threatening accused infringers in foreign fora without fear of being subject to suit themselves)); see also Kline, supra note 25, at 272 (stating that even in declaratory judgment actions, patent trolls are
the patented product may be highly relevant to whether a court
would order a preliminary injunction against the accused
infringer.\footnote{227} Accordingly, \textit{Avocent} erred when it held that the sales
of the patented product are not relevant to personal jurisdiction in a
patent declaratory judgment action.\footnote{228} Further, economic analysis
also supports finding personal jurisdiction in a plaintiff’s home
state against foreign patentees in declaratory judgment actions.\footnote{229}

\textbf{C. Economic Analysis Supports Finding Specific Personal
Jurisdiction in a Declaratory Judgment Action, Especially Against
a Foreign Patentee}

Economic analysis of the law shows that a patentee’s sales of
the patented product have a bearing on the declaratory judgment
able to isolate themselves in single forum, allowing them effective
control over locus of litigation).

\footnote{227 \textit{eBay}, 547 U.S. at 392-94; \textit{Overstock.com}, 420 F. Supp. 2d at 1222; Luxardo, \textit{supra} note 45, at 823.}

\footnote{228 \textit{Cf.} Viam Corp. v. Iowa Export Import Trading Co., 84 F.3d 424, 429 (1996) (finding that sales by patentee within forum state were sufficient to anchor specific personal jurisdiction there); SRAM Corp. v. Sunrace Roots Enter. Co., 390 F. Supp. 2d 781, 787 (N.D. Ill. 2005) (holding that declaratory judgment defendant had purposefully directed its activities at residents of forum by marketing product in direct competition with allegedly infringing product); Stomp, Inc. v. NeaO, LLC, 61 F. Supp. 2d 1074 (C.D. Cal. 1999) (holding that declaratory judgment action for patent non-infringement may proceed in California because patentee’s interactive website offered patented device for sale).}

First, should the declaratory judgment plaintiff prevail in its non-infringement action, the two products would compete within the forum state without any barrier. Accordingly, the earliest resolution of the patent infringement issue would enhance competition within the forum state. Competition is beneficial for the forum state because it lowers prices, increases quality, and encourages innovation. Thus, the forum state has an interest in

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230 See generally Mossoff, supra note 229, at 2028 (providing current economic analysis of patent system); Duffy, supra note 229, at 439 (reviewing economic theories of patents, in particular prospect theory); Oddi, supra note 229, at 273-86 (reviewing economic theories of patents).

231 See State Indus. v. A.O. Smith Corp., 751 F.2d 1226, 1236 (Fed. Cir. 1985) (highlighting one of many benefits of patent system: it incentivizes design around competitor’s patented product, thus bringing steady flow of innovations to marketplace); McJohn, supra note 44, at 229 (stating that patented products compete with products not covered by patent if there is market for patented invention at all); Kline, supra note 25, at 252 (stating that competitors are free to attempt to design around patent and develop their own solutions, but they risk subjecting themselves to infringement liability). But see generally Merges & Duffy, supra note 57, at 1239-1309 (explaining that patentees may easily misuse their monopoly by tying arrangements, patent pools and like).

232 See generally Mossoff, supra note 229, at 2028 (providing current economic analysis of patent system); Duffy, supra note 229, at 439 (reviewing economic theories of patents, in particular prospect theory); Oddi, supra note 229, at 273-86 (reviewing economic theories of patents).

adjudicating this dispute, because finding non-infringement
enhances its economy with more or better competition.234

Furthermore, patent declaratory judgment actions are double-
edged swords, as filing such a suit may backfire and saddle the
plaintiff with an enormous judgment.235 Commencing litigation
and prosecuting it is costly and work-intensive.236 Defending an
infringement suit may be cheaper and easier than prosecuting it.237
The accused infringer may file a suit only when an actual

234 See Burger King Corp. v. Rudzewicz, 471 U.S. 462, 477 (1985)
(paraphrasing listing of five fairness factors in World-Wide Volkswagen Corp. v.
Woodson, 444 U.S. 286, 292 (1980), among them forum state’s interest in early
and efficient resolution of dispute); Viam Corp. v. Iowa Export-Import Trading
Co., 84 F.3d 424, 430 (Fed. Cir. 1996) (stating that state has definite interests in
commerce and scientific development); Akro Corp. v. Luker, 45 F.3d 1541,
1547-48 (Fed. Cir. 1995) (emphasizing forum state’s interest in providing forum
to resident who claims defendant unlawfully restricted marketing and
distribution of its product).
235 See, e.g., EDWARD F. O’CONNOR, INTELLECTUAL PROPERTY LAW AND
LITIGATION 129 (2d ed. 2003) (explaining that proceedings that started out as
simple declaratory judgment action resulted in substantial judgment against
plaintiff for several antitrust causes of action); McJOHN, supra note 44, at 235
(explaining that courts may award attorneys fees against party who practices
offensive litigation tactics or vexatious or unjustified litigation); see also
Yamanouchi Pharm. Co. v. Danbury Pharmacal, 231 F.3d 1339, 1347 (Fed. Cir.
2000).
236 See McJOHN, supra note 44, at 237 (stating that patent litigation is so costly
that practitioners call it “sport of kings”); Kline, supra note 25, at 277 (stating
rational manufacturer will pay licensing fees to avoid litigation if those fees will
not exceed, over term of license agreement, probable cost of litigation, including
remedies); Joseph E. Stiglitz, Economic Foundations of Intellectual Property
Rights, 57 DUKE L.J. 1693, 1716 (2008) (stating that it is very expensive to
challenge patents); cf. Edward F. Sherman, Aggregate Disposition of Related
Cases: The Policy Issues, 10 REV. LITIG. 231, 237 (observing that amount of
time and money expended in resolving issue in litigation is partly function of
amount of money at stake).
237 See supra note 236. But see McJOHN, supra note 44, at 235 (explaining
reasons why filing declaratory judgment suit may make sense to accused
infringer).
controversy already exists between the parties. For the cost and inconvenience of commencing the litigation, our system should offer a trade-off in allowing the accused infringer to choose a convenient forum.

Finally, the choice of a United States forum state for litigating its patent rights should be relatively unimportant for a foreign patentee. Some benefits, especially for plaintiffs, may accrue in one district court over another. At the same time, it is unlikely that litigating in any one state is substantially more inconvenient


239 See Stiglitz, supra note 236, at 1715 (arguing that lawsuits filed to challenge patents are “public goods” and there is significant underinvestment in such challenges); cf. Luxardo, supra note 45, at 823 (highlighting patent troll problem); Kline, supra note 25, at 272 (highlighting patent troll problem and that trolls now have effective control over locus of any patent-related litigation). But see Weide, supra note 30, at 178 (arguing that liberal findings of personal jurisdiction in patent declaratory judgment actions may conflict with public policy and statutory rights of patent owner).

240 Cf. Avocent Huntsville Corp. v. Aten Int’l Co., 552 F.3d 1324, 1347 (Fed. Cir. 2008) (Newman, J., dissenting) (noting that Aten invoked federal judiciary to enforce its patents and requested transfer to another District Court, indicating that it would be amenable to personal jurisdiction there).

than litigating in another for a foreign patentee.\textsuperscript{242} Therefore, the convenience of litigating in any state versus another state should carry roughly even weight in the analysis of the fairness factors.\textsuperscript{243}

However, those favoring \textit{Avocent}'s approach may argue that it is already too easy to obtain declaratory judgment jurisdiction, which lowers the value of U.S. patents.\textsuperscript{244} A patent is less valuable if it puts its holder at risk of vexatious litigation in foreign fora, with the accompanying high costs and inconvenience.\textsuperscript{245} A patentee should be able to advise others of its patent rights without

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\textsuperscript{242} \textit{Cf.} \textit{Avocent Huntsville Corp. v. Aten Int’l Co.}, 552 F.3d 1324, 1347 (Fed. Cir. 2008) (Newman, J., dissenting) (noting Aten requested transfer of action to Western District of Washington, where it already had pending suit with Avocent’s parent company); Richard H. Kreindler, \textit{Arbitration or Litigation? ADR Issues in Transnational Disputes}, 52 DISP. RESOL. J. 79 (Fall 1997) (stating that foreign litigants may seek transfer of action to another district court in interest of justice and for convenience of parties); Hans Smit, \textit{Recent Developments in International Litigation}, 35 S. TEX. L. REV. 215, 216 n.1 (1994) (stating that there is more inconvenience for foreign party having to defend in American court than for American party having to defend suit in sister state). \textsuperscript{243} \textit{See} \textit{Burger King v. Rudzewicz}, 462, 477 (1985); \textit{World-Wide Volkswagen Corp. v. Woodson}, 444 U.S. 286, 292 (1980); \textit{Floyd & Baradaran-Robison}, \textit{supra} note 26, at 628, 629; \textit{see also} Taylor, \textit{supra} note 241, at 571 n.11 (stating that in patent cases multitude of districts would be equally convenient for both parties).
\textsuperscript{244} \textit{See}, e.g., \textit{Weide, supra} note 30, at 178 (arguing that liberal findings of personal jurisdiction in patent declaratory judgment actions may conflict with public policy and statutory rights of patent owner). \textit{But see} Luxardo, \textit{supra} note 45, at 823 (quoting Overstock.com, Inc. \textit{v. Furnace Brook, LLC, 420 F. Supp. 2d} 1217, 1222 (D. Utah 2005) (highlighting patent troll problem)); \textit{Kline, supra} note 25, at 272 (highlighting patent troll problem and that trolls now have effective control over locus of any patent-related litigation).
\textsuperscript{245} \textit{See} Christopher R. Leslie, \textit{The Role of Consumers in Walker Process Litigation}, 13 SW. J.L. & TRADE AM. 281, 312 (2007) (expressing fear that vexatious litigation could chill legitimate patent activity). \textit{But see} John R. Allison et al., \textit{Valuable Patents}, 92 GEO. L.J. 435, 441 (2004) (stating there is correlation between litigation and value attributed to patent in that litigated patents are relatively more valuable than overwhelming number of non-litigated patents); James Bessen, \textit{The Value of U.S. Patents by Owner and Patent Characteristics}, 37 RES. POL’Y 932, 932 (2008) (stating that litigated patents are generally more valuable).
subjecting itself to the jurisdiction of a foreign forum. \textsuperscript{246} Allowing suits such as \textit{Avocent} to proceed may have a chilling effect on patentees attempting to put suspected infringers on notice.\textsuperscript{247} However, this argument fails because the uncertainty in the marketplace following the sending of infringement notice letters is equally damaging.\textsuperscript{248} An accused infringer may lower production, or even cease operation, upon receiving a notice letter threatening with suit.\textsuperscript{249} A finding of willful infringement carries stiff penalties: up to treble damages and attorney’s fees and costs.\textsuperscript{250} To avoid a

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  \item \textsuperscript{246} Red Wing Shoe Co. v. Hockerson-Halberstadt, Inc., 148 F.3d 1355, 1360-61 (Fed. Cir. 1998); see Weide, \textit{supra} note 30, at 195 (stating that subjecting patentee to jurisdiction in remote forum based on its limited patent enforcement activities is contrary to Congressional intent embodied in patent laws). \textit{But see} Heuser & Shlachter, \textit{supra} note 151, at 38 (stating that while patentees wishing to put potential infringer on notice may allow putative infringer to select forum for bring declaratory judgment action).
  \item \textsuperscript{247} \textit{See Red Wing Shoe}, 148 F.3d. at 1360-61; Weide, \textit{supra} note 30, at 195. \textit{But see} Heuser & Shlachter, \textit{supra} note 151, at 38.
  \item \textsuperscript{248} \textit{See} Doernberg & Mushlin, \textit{supra} note 23, at 553 (discussing that proponents of Act were concerned with social cost of uncertainty of individuals and corporations about their legal positions); Dolak, \textit{supra} note 117, at 905 (stating that prior to 1934, patentees enjoyed unchecked economic power, as they could effectively paralyze alleged infringers’ enterprise with mere threats of enforcement); \textit{see also} MedImmune v. Genentech, 549 U.S. 118, 128-29 (2007) (stating that Act may also be useful to test constitutionality of laws before commencing activities that would be illegal under challenged law).
  \item \textsuperscript{249} \textit{See} Arrowhead Indus. Water, Inc. v. Ecolochem, Inc., 846 F.2d 731, 737 (Fed. Cir. 1988) (stating that in response to thinly veiled threats from Ecolochem, Arrowhead might have had to abandon its allegedly infringing process); \textit{see also} Doernberg & Mushlin, \textit{supra} note 23, at 564; Dolak, \textit{supra} note 117, at 905; cf. Zenie Bros. v. Miskend, 10 F. Supp. 779, 781 (S.D.N.Y. 1935) (stating that finding the defendant’s patent valid in declaratory judgment suit effectively ruins plaintiff’s business).
  \item \textsuperscript{250} 35 U.S.C. § 284 (2006); McJOHN, \textit{supra} note 44, at 237 (stating that courts interpreted exceptional circumstances under which statute authorizes treble damages to mean willful infringement); MERGES & DUFFY, \textit{supra} note 57, at 1029 (citing Polaroid Corp. v. Eastman Kodak Co., 16 U.S.P.Q. 2d (BNA) 1481 (D. Mass. 1990) as example where court would treble $900 million damages award to $2.7 billion upon finding of willful infringement).
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possible judgment finding willful infringement, an accused infringer has only limited room to maneuver.\textsuperscript{251} Thus, it is especially beneficial for smaller corporations to “clear the air” of an accusation of infringement.\textsuperscript{252}

Further, tightening personal jurisdiction in otherwise discretionary declaratory judgment actions seems unnecessary.\textsuperscript{253} Courts may decline to exercise declaratory judgment jurisdiction based on prudential reasons.\textsuperscript{254} Appellate courts only review prudential dismissals of declaratory judgment actions for abuse of discretion, a relatively low standard.\textsuperscript{255} Nevertheless, in \textit{Avocent},

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\item \textsuperscript{251} See Shell Oil Co. v. Amoco Corp., 970 F.2d 885, 886 (Fed. Cir. 1992); \textit{Arrowhead}, 846 F.2d at 737; Dewey & Almy Chem. Co. v. Am. Anode, Inc., 137 F.2d 68, 71 (3d Cir. 1943); cf. \textit{Zenie Bros.}, 10 F. Supp. at 781 (stating that if patent is found valid in declaratory judgment suit, plaintiff’s business is ruined).
\item \textsuperscript{252} See \textit{Arrowhead}, 846 F.2d at 735; Greg Halsey, Comment, \textit{There Is a Pink Elephant at Our Patent Negotiation, and His Name Is Declaratory Judgment}, 46 SAN DIEGO L. REV. 247, 256 (2009) (discussing effect of broader declaratory judgment jurisdiction on small entity patentees and accused infringers); Paul J. LaVanway, Jr., \textit{Patent Licensing and Discretion: Reevaluating the Discretionary Prong of Declaratory Judgment Jurisdiction After MedImmune}, 92 MINN. L. REV. 1966, 1997 (2008) (suggesting that courts should be more solicitous toward accepting declaratory judgment jurisdiction where party seeking jurisdiction is small entity and defendant is large entity).
\item \textsuperscript{254} See \textit{Wilton}, 515 U.S. at 282-83; \textit{Abbott Labs.}, 387 U.S. at 155; \textit{Brillhart}, 316 U.S. at 495, \textit{Minn. Mining}, 929 F.2d at 672-73.
\item \textsuperscript{255} See, e.g., \textit{Wilton}, 515 U.S. at 289 (stating that proper application of abuse of discretion standard on appellate review can provide appropriate guidance to lower courts); Sony Elecs., Inc. v. Guardian Media Techs., Ltd., 497 F.3d 1271,
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the Federal Circuit narrowed the availability of personal jurisdiction in declaratory judgment actions.\textsuperscript{256} \textit{Avocent} thus disregarded both the discretionary nature of the Declaratory Judgment Act, and the Supreme Court’s flexible personal jurisdiction framework.\textsuperscript{257}

\textbf{CONCLUSION}

The \textit{Avocent} court erroneously held that a patentee’s sales in the forum state are irrelevant to the issue of specific personal jurisdiction.\textsuperscript{258} First, the patentee’s sales of the patented product are relevant to establish the patent’s validity.\textsuperscript{259} Second, \textit{Avocent} failed to consider that the patentee’s sales of the patented product are relevant to the issue of the proper remedy for infringement.\textsuperscript{260} Third, economic analysis also supports a finding of personal jurisdiction in patent declaratory judgment actions, especially against foreign patentees.\textsuperscript{261} Accordingly, when appropriate, the

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1288 (Fed. Cir. 2007); Elecs. for Imaging, Inc. v. Coyle, 394 F.3d 1341, 1345, 1348 (Fed. Cir. 2005). \textsuperscript{256} \textit{See Avocent Huntsville Corp. v. Aten Int’l Co.,} 552 F.3d 1324, 1336 (Fed. Cir. 2008).
257 \textit{Cf. Wilton,} 515 U.S. at 282-83; \textit{Abbott Labs.,} 387 U.S. at 155; \textit{Brillhart,} 316 U.S. at 495; \textit{Sony,} 497 F.3d at 1288; \textit{Minn. Mining,} 929 F.2d at 672-73; \textit{Elecs. for Imaging,} 394 F.3d at 1345, 1348.
258 \textit{See Avocent,} 552 F.3d. at 1336, for the majority’s holding. \textit{Cf. Viam Corp. v. Iowa Export-Import Trading Co.,} 84 F.3d 424, 428-29 (Fed. Cir. 1996); Kline, \textit{supra} note 25, at 268 (stating that patent licensing or practicing organizations may establish sufficient minimum contacts with forum state through sales or other marketing activities).
259 \textit{See supra} Part III.A.
260 \textit{See supra} Part III.B.
261 \textit{See supra} Part III.C.
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Supreme Court should overturn *Avocent* and hold that courts may consider forum sales of the patented product for specific personal jurisdiction.