No. 23-1184

In the United States Court of Appeals for the Federal Circuit

SNAPRAYS, DBA SNAPPOWER,

Plaintiff-Appellant

v.

LIGHTING DEFENSE GROUP LLC,

Defendant-Appellee

On Appeal from the United States District Court for the District of Utah (Central)
Civil Docket for Case No. 2:22-cv-00403-DAK

CORRECTED APPELLEE'S PETITION FOR PANEL REHEARING AND REHEARING EN BANC

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UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

CERTIFICATE OF INTEREST

Case Number 23-1184

Short Case Caption SnapRays v. Lighting Defense Group

Filing Party/Entity Appellee / Lighting Defense Group

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Name: Grant B. Martinez

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Lighting Defense Group LLC		

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Statement of Related Cases

There are no related cases to this appeal.

STATEMENT OF COUNSEL – FEDERAL CIRCUIT RULE 35(b)(2)

In this personal jurisdiction appeal, the *defendant* has no contacts with the forum state whatsoever; but the panel's Opinion held that the defendant was subject to specific jurisdiction there because the defendant took an out-of-forum action with knowledge that *plaintiff* would experience effects in the forum. Op. 5-10. For this conclusion, the Opinion departed from binding Supreme Court precedent and relied on two out-of-circuit precedents that this Court has repeatedly rejected and that the Supreme Court has implicitly rejected.

Based on my professional judgment, I believe the panel decision is contrary to the following decisions of the Supreme Court of the United States—*Walden v. Fiore*, 571 U.S. 277 (2014); *Int'l Shoe Co. v. Washington*, 326 U.S. 310 (1945)—and contrary to the following decisions of this Court—*Maxchief Invs. Ltd. v. Wok & Pan, Ind., Inc.*, 909 F.3d 1134 (Fed. Cir. 2018); *Radio Sys. Corp. v. Accession, Inc.*, 638 F.3d 785 (Fed. Cir. 2011); *Avocent Huntsville Corp. v. Aten Int'l Co.*, 552 F.3d 1324 (Fed. Cir. 2008).

Based on my professional judgment, I believe this appeal requires answers to one or more precedent-setting questions of exceptional importance:

> ***Personal Jurisdiction Despite No Contacts*:** Whether a patentee subjects itself to specific personal jurisdiction anywhere a plaintiff operates—even though the patentee has no contacts with the forum or the plaintiff—just because the patentee's out-of-forum conduct has effects on plaintiff in the forum state.

Dated: July 3, 2024

/s/ Grant B. Martinez
Grant B. Martinez
Counsel for Appellee

Introduction

Defendant Lighting Defense Group LLC ("LDG") has no contacts with Utah. Without such contacts, LDG cannot be subjected to personal jurisdiction in Utah.

The reason is simple. *International Shoe* explained that due process requires that a defendant have "minimum contacts" with the forum. 326 U.S. at 316. *Walden* reinforced that this analysis "looks to the defendant's contacts with the forum State itself, not the defendant's contacts with persons who reside there." 571 U.S. at 285. Thus, it is the *defendant*'s contacts with *the forum itself* that count—not the plaintiff's contacts. *Id.* at 285-86. This means that "mere injury to a forum resident is not a sufficient connection to the forum." *Id.* at 290. Nor is knowledge of plaintiff's location relevant: it does not suffice that a defendant "allegedly directed his conduct at plaintiffs whom he knew had [forum] connections." *Id.* at 289.

This Court has applied these well-established principles in multiple cases. It held that "enforcement activities taking place outside the forum state do not give rise to personal jurisdiction in the forum." *Radio Sys.*, 638 F.3d at 792 (discussing *Avocent*). In *Maxchief*, when a patentee's conduct in California sought to stop Staples' selling infringing products, this Court held that "it is not enough that [defendant's conduct] might have 'effects' in Tennessee," the forum where the plaintiff sued the patentee. 909 F.3d at 1138-39 (applying *Walden*).

The Opinion failed to apply these controlling precedents. Op. 6-8. It departed from these bedrock principles by permitting jurisdiction in Utah because LDG knew that its out-of-forum conduct—sending a request to Amazon in Washington—would "necessarily affect" SnapPower's activities in Utah. Op. 5, 7-8. Commentators have correctly observed that, under this "bombshell ruling," defendants could be sued anywhere "a targeted seller operates."[1]

This consequential decision sets up an intractable conflict with controlling, black-letter decisions of the Supreme Court and the Federal Circuit. *Walden*, by itself, disposes of this case. Rehearing is warranted.

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[1] *See* Geno Cheng, *Initiating an Informal Dispute on Amazon's Platform Was Sufficient to Subject a Patentee to Personal Jurisdiction in Accused Infringer's Home State!*, WINSTON & STRAWN LLP (May 7, 2024), https://rb.gy/njdtvi (last visited Jun. 27, 2024); York Faulkner, *The Personal Jurisdiction Pitfall When Unleashing Amazon's "APEX" Patent Predator*, MONDAQ (May 16, 2024), https://rb.gy/rly2ah (last visited Jun. 27, 2024); Dennis Crouch, *Amazon Patent Enforcement Process Can Create Personal Jurisdiction*, PATENTLYO (May 3, 2024), https://rb.gy/cmwf4f (last visited Jun. 27, 2024) (Opinion had "questionable aspects"; "[o]ne point of difficulty here is the Supreme Court's precedent in *Walden*").

ARGUMENT

I. The Opinion contradicts Supreme Court precedent.

A. Jurisdiction must be based on defendant's forum contacts.

Because LDG has no contacts with Utah, jurisdiction could not be established there under *Walden*.

- Personal jurisdiction must be based on "conduct by the defendant that creates the necessary contacts with the forum." *Walden*, 571 U.S. at 286.
- The "defendant's suit-related conduct must create a substantial connection with the forum State." *Id.* at 284.
- The jurisdictional analysis "looks to the defendant's contacts with the forum State itself, not the defendant's contacts with persons who reside there." *Id.* at 285.
- "[M]ere injury to a forum resident is not a sufficient connection to the forum." *Id.* at 290.
- Knowledge of a plaintiff's "forum connections" is irrelevant because this "approach to the 'minimum contacts' analysis impermissibly allows a plaintiff's contacts with the defendant and forum to drive the jurisdictional analysis." *Id.* at 289.
- Defendant's actions cannot create "sufficient contacts with [the forum] simply because he allegedly directed his conduct at plaintiffs whom he knew had [forum] connections." *Id.*
- The "proper question is not where the plaintiff experienced a particular injury or effect but whether the defendant's conduct connects him to the forum in a meaningful way." *Id.* at 289.

In sum, the "primary focus" of the jurisdictional inquiry is "defendant's relationship to the forum State." *Bristol-Myers Squibb Co. v. Superior Ct. of Cal.*, 582

U.S. 255, 262 (2017). To establish jurisdiction, a defendant "must take some act by which [it] purposefully avails itself of the privilege of conducting activities within the forum State." *Ford Motor Co. v. Montana Eighth Judicial Dist. Court*, 592 U.S. 351, 359 (2021) (quotes omitted). And defendant's contacts with the forum cannot be "random, isolated, or fortuitous." *Id.* "[T]here must be an affiliation between the forum and the underlying controversy, principally, [an] activity or an occurrence that takes place in the forum State and is therefore subject to the State's regulation." *Id.* at 359-60 (quotes omitted). So, "the place of a plaintiff's injury and residence cannot create a defendant's contact with the" forum. *Id.* at 371.

Practically, this means that there is no jurisdiction over a defendant that had "never traveled to, conducted activities within, contacted anyone in, or sent anything or anyone to" the forum. *Id.* at 370 (discussing *Walden*). Because *Walden* applies, jurisdiction could not be established over LDG that undisputedly has no contacts with Utah.

B. The Opinion disregarded *Walden*.

Yet, the Opinion held that LDG's conduct established jurisdiction in Utah, concluding that LDG "expressly aimed" at SnapPower, foreseeing that "the effects" of its actions "would be felt" in Utah. Op. 5, 7-8. To say so, the Opinion:

- Wrongly reached back to and expanded the "effects test" of *Calder v. Jones*, 465 U.S. 783 (1984), a unique libel case with no similarities to this case. Op. 8.
- Relied on two cases that *Walden* had implicitly rejected. Op. 5-6 (citing *Dudnikov v. Chalk & Vermilion Fine Arts, Inc.*, 514 F.3d 1063 (10th Cir. 2008); *Bancroft & Masters, Inc. v. Augusta Nat'l, Inc.*, 223 F.3d 1082 (9th Cir. 2000)).

This was error.

1. *Walden* clarified *Calder*'s application and rejected *Dudnikov* and *Bancroft*.

Walden illustrates *Calder*'s limited application and the implicit rejection of *Dudnikov* and *Bancroft*.

In *Walden*, plaintiffs living in Nevada brought a lawsuit there against an officer who harmed them in Georgia while knowing they had Nevada connections. 571 U.S. at 279-81. Concluding there was no jurisdiction in Nevada, the Court clarified that "it is the defendant, not the plaintiff or third parties, who must create contacts with the forum State." *Id.* at 291. Because the officer's actions "occurred entirely in Georgia, the mere fact that his conduct affected plaintiffs with connections to the forum State does not suffice to authorize jurisdiction." *Id.* (cleaned up). There was

no jurisdiction even if defendant "knew" that plaintiffs "had Nevada connections" and targeted them. *Id.* at 289.

Walden reversed the Ninth's Circuit's erroneous analysis that relied on the *Calder* "effects test." *Fiore v. Walden*, 688 F.3d 558, 576 (9th Cir. 2012), *rev'd*, 571 U.S. 277 (2014). Like the Opinion, the Ninth Circuit held that jurisdiction was proper in Nevada because the officer "expressly target[ed]" plaintiffs there as he "must have known and intended that his actions would have impacts outside" Georgia. *Id.* at 578. Like the Opinion, the Ninth Circuit relied on *Dudnikov* and *Bancroft*. *Id.* at 577-78, 580-81, 590-91. In those cases, the Ninth and Tenth Circuits concluded there was jurisdiction over defendants through a "bank-shot" theory: defendants' out-of-forum conduct affecting a plaintiff's "business interests" in the forum can subject defendants to jurisdiction in the forum. *Radio Systems*, 638 F.3d at 792.

The Supreme Court rejected a broad application of *Calder* and implicitly rejected *Dudnikov* and *Bancroft* in reversing the Ninth Circuit's decision relying on them. *Walden* emphasized that the unique nature of the libel tort in *Calder* meaningfully connected defendants to the forum itself: "The strength of that connection was largely a function of the nature of the libel tort." *Walden*, 571 U.S. at 287. The reputational injury was caused by "the fact that the defendants wrote an

article for publication in California that was read by a large number of California citizens. Indeed, because publication to third persons is a necessary element of libel, the defendants' intentional tort actually occurred in California." *Id.* at 287-88 (citation omitted).

Walden explained that the "crux of *Calder* was that the reputation-based 'effects' of the alleged libel connected the defendants to California, not just to the plaintiff." *Id.* at 287. *Calder* had "examined the various contacts the defendants had created with California (and not just with the plaintiff)" and "found those forum contacts to be ample." *Id.*

Thus, *Walden* implicitly rejected *Dudnikov* and *Bancroft* when reversing the Ninth Circuit's decision relying on them. Further, *Walden* clarified *Calder*'s holding as one depending largely on the libel tort, which resulted in "ample" contacts between defendants and the forum itself. Here, LDG has *no* contacts with Utah.

2. Similar to the Ninth Circuit's reversed holding in *Walden*, the Opinion incorrectly applied *Calder* to this case.

The Opinion avoided applying *Walden.* It incorrectly relied on a broad interpretation of *Calder*, including that "the effects of the alleged libel, loss of reputation through communication to third persons, connected the defendant to California and not just the resident of California." Op. 9. The Opinion improperly

concluded that LDG's "intended effect would," as in *Calder*, "necessarily affect marketing, sales, and other activities within" Utah, creating jurisdiction. *Id.*

This was wrong. *Walden* explained that the distinctive nature of libel created the *Calder* defendants' "various contacts . . . *with California* (and not just with the plaintiff) by writing the allegedly libelous story" and found that those "ample" contacts were sufficient for jurisdiction. 571 U.S. at 287 (emphasis added).

This action has none of *Calder*'s uncommon facts. LDG's request was directed to Amazon to remove Amazon's listings of SnapPower products accessible worldwide. LDG's actions had no focus on Utah—it did not go there, initiate contact with anyone there, publish anything there, or do *anything* in connection with Utah itself.

The Opinion erroneously disregarded *Walden* and its clarification of *Calder*.

3. The Opinion erred by favoring *Dudnikov* and *Bancroft*, two cases that *Walden* effectively rejected.

By avoiding *Walden*, the Opinion wrongly embraced *Bancroft* and *Dudnikov*. Op. 5-6. But *Walden* has rejected these cases' bank shot theory: it is defendant "who must create contacts with the forum State." *Walden*, 571 U.S. at 291.

Courts have noted *Walden*'s rejection of *Bancroft*. *Bluestar Genomics v. Song*, 2023 WL 4843994, at *21 (N.D. Cal. 2023) ("*Bancroft* is no longer good law."). And contrary to *Dudnikov*, *Walden* and its progeny "clearly instruct that a plaintiff's

presence in the forum cannot serve as the basis for minimum contacts, regardless of the defendant's knowledge of that presence." *Dadbod Apparel LLC v. Hildawn Design LLC*, 2024 WL 1886497, at *5 (E.D. Cal. 2024). *Dadbod* held that a takedown action on Amazon is not "purposeful direction" and that *Calder*'s effects test is not satisfied by defendant's intent to affect plaintiff and knowledge of plaintiff's forum contacts. *See id.*; *see also Eighteen Seventy L.P. v. Jayson*, 532 F. Supp. 3d 1125, 1139 (D. Wyo. 2020), *aff'd*, 32 F.4th 956 (10th Cir. 2022) (citing *Dudnikov* as *contra* to *Walden*); *Big Birds, LLC v. CC Beauty Collection Inc.*, 2020 WL 5095856, at *4-5 (D. Md. 2020) (rejecting *Dudnikov*); *Carmel v. Mizuho Bank, Ltd.*, 2018 WL 6981840, at *8 n.7 (C.D. Cal. 2018) (*Dudnikov* not persuasive as to "individualized targeting analysis").

The Ninth and Tenth Circuits too now recognize the limited application of their decisions in *Dudnikov* and *Bancroft*. They now look to defendants' own contacts *with the forum*. The Ninth Circuit has explained that *Walden* "required us to focus instead on defendant's intentional conduct that is aimed at, and creates the necessary contacts with, the forum state." *AMA Multimedia, LLC v. Wanat*, 970 F.3d 1201, 1209 n.5 (9th Cir. 2020). Likewise, the Tenth Circuit has recognized that "effects . . . intended to be felt in" and having the "brunt of the harm" in the forum are insufficient to support jurisdiction. *C5 Med. Werks, LLC v. CeramTec GMBH*,

937 F.3d 1319, 1324 (10th Cir. 2019). It has also limited *Dudnikov* to situations where defendants have intentionally affected not just *general* sales but a "particular sale or transaction in" the forum "that was disrupted by" their actions elsewhere. *Id.* at 1324; *accord New Angle LLC v. IQAir N. Am., Inc.*, 2022 WL 4386661, at *2 (D.N.H. 2022) ("*Dudnikov*'s reasoning is limited to cases when there is a particular sale or transaction in the forum state that was disrupted by the defendant's out-of-state actions." (cleaned up)).

The Opinion disregarded these developments and cited *Bancroft* and *Dudnikov* to support its holding. Rehearing is necessary to correct the Opinion's embrace of flawed, abrogated out-of-circuit cases at the expense of *Walden*.

II. The Opinion Conflicts with Controlling Federal Circuit Precedent.

Rehearing is warranted for another reason: it conflicts with this Court's precedent that, like *Walden*, control this case.

Prior to the Opinion, this Court's decisions were in accord with *Walden*:

- "[E]nforcement activities taking place outside the forum state do not give rise to personal jurisdiction in the forum." *Radio Sys.*, 638 F.3d at 792 (discussing *Avocent*).

- It "is not enough that [defendant's conduct] might have 'effects' in" the forum. *Maxchief*, 909 F.3d at 1138-39 (applying *Walden*).

- While some have argued that "foreseeability of causing injury in another State" may sometimes be sufficient to establish minimum contacts, "the Court has consistently held that this kind of for[e]seeability is not a 'sufficient

benchmark' for exercising personal jurisdiction." *Avocent*, 552 F.3d at 1329-30 (quoting *Burger King Corp. v. Rudzewicz*, 471 U.S. 462, 474 (1985)).

Radio Systems, *Avocent*, and *Maxchief* control. While the Opinion misapprehended them, they are not distinguishable in constitutionally relevant ways.

A. *Radio Systems*

Radio Systems is dispositive. Anticipating *Walden*, *Radio Systems* held that conduct directed at an out-of-forum state is insufficient to create jurisdiction in the forum. 638 F.3d at 792. The Opinion should have applied *Radio Systems*, but it erroneously distinguished it instead.

In *Radio Systems*, the plaintiff sought a declaration of noninfringement. Defendant owned a patent and approached plaintiff for a partnership. Plaintiff, however, applied for a competing patent and began marketing. The PTO later issued a notice of allowance for it. Defendant alerted the PTO to its own patent. The PTO withdrew the notice, causing the plaintiff to file suit in Tennessee. *Id.* at 787-88.

This Court held that defendant's conduct was insufficient to "give rise to jurisdiction as extra-judicial enforcement efforts" in Tennessee. *Id.* at 791-92. Defendant's "contacts were directed at Virginia (the site of the PTO) rather than Tennessee." *Id.* at 792. Since the "enforcement activities" were directed at Virginia, they did not give "rise to personal jurisdiction" in Tennessee. *Id.* Similarly, here, LDG's complaint was directed at Amazon in Washington, not at Utah.

Crucially, *Radio Systems* expressly rejected a bank-shot theory based on *Dudnikov* and *Bancroft*, which the Opinion here erroneously embraced. *Id. Radio Systems* proved prescient because *Walden* itself later implicitly rejected *Bancroft* and *Dudnikov*. *See* Sections I.B.1, I.B.3, *supra*. *Radio Systems* is dispositive.

Still, the Opinion held that *Radio Systems* did not apply because defendant there "did not initiate extra-judicial patent enforcement" against or "affect allegedly infringing sales" of plaintiff. Op. 7. The distinction is factually wrong because the Court expressly recognized defendant's PTO contacts as "extra-judicial enforcement efforts." *Radio Sys.*, 638 F.3d at 792. And the distinction is constitutionally irrelevant because jurisdiction depends on whether LDG's conduct, regardless of its nature, was directed at Utah itself—not Utah-based companies.

Radio Systems applies, and the Opinion erred in disregarding it.

B. *Avocent*

Avocent too is helpful because, like *Walden* and *Radio Systems*, it effectively rejected the application of *Dudnikov*'s and *Bancroft*'s bank shot theory here.

Avocent held that cease-and-desist letters "without more" do not create jurisdiction in the plaintiff's forum state. 552 F.3d at 1340. *Avocent* was prescient: it anticipated *Walden*'s implicit rejection of *Dudnikov* and *Bancroft*. The *Avocent* dissent argued that "courts tend to allow personal jurisdiction when the injury to the

plaintiff has been manifested in the forum" when fairness is not compromised. *Avocent*, 552 F.3d at 1346 (Newman, J., dissenting) (citing *Dudnikov* and *Bancroft*). Instead, the *Avocent* majority explained that the "foreseeability of causing *injury* in another State . . . is not a 'sufficient benchmark' for exercising personal jurisdiction." *Id.* at 1330. *Avocent* thus foreclosed the Opinion's embrace of *Dudnikov* and *Bancroft*.

The Opinion made factual and legal errors in distinguishing *Avocent*. The Opinion mistakenly said the Amazon Patent Express ("APEX") program results in an "automatic takedown" of Amazon listings that does "more" than cease-and-desist letters and sufficient to create jurisdiction. Op. 6-7. This distinction is constitutionally irrelevant because it does not focus on the defendant's contacts with the forum, but rather the degree to which the plaintiff is impacted there. LDG's conduct was directed at Amazon, whose listings are accessible worldwide. LDG's conduct has no "connection with the forum State," *Walden*, 571 U.S. at 285, and foreseeability of harm—automatic or otherwise—to plaintiff there was not a "sufficient benchmark" for jurisdiction, *Avocent*, 552 F.3d at 1330.

The Opinion also factually erred: an APEX request seeks to stop Amazon's infringing, and Amazon has full discretion in how to respond. *See* LDG's Resp. 10-11, 43-48. There is no "automatic takedown" similar to those in *Dudnikov* and *Bancroft*. *Id.*

The Opinion should have applied *Avocent*, but the Opinion relied on factually wrong and constitutionally irrelevant distinctions to avoid *Avocent*.

C. *Maxchief*

Maxchief also controls. Following *Walden*, *Maxchief* held that defendants' conduct having effects on plaintiffs in the forum do not suffice to create jurisdiction there. 909 F.3d at 1138. Instead, jurisdiction should be based on conduct by the defendant "directed at the forum" itself. *Id.* Exactly like this case, *Maxchief* held that an out-of-forum complaint directed at an out-of-forum retailer "did not create sufficient contacts" with the forum simply because the patentee knew the complaint would have effects on a party in the forum. *Id.* at 1139.

Maxchief was a Tennessee declaratory judgment action involving Maxchief's seeking noninfringement against Wok. Wok had sued Maxchief's customer Staples in California for selling Maxchief's products that allegedly infringed Wok's patents. Wok sought "a broad injunction against 'all those in active concert' with Staples, including its 'distributors'" in Tennessee. *Id.* at 1138. Staples asked for a defense from its Tennessee-based distributor, who then asked for a defense from Maxchief. Maxchief then filed the Tennessee action against Wok. *Id.* at 1136.

Maxchief argued that Wok's California activities created jurisdiction in Tennessee under *Calder*. *Id.* at 1138. But this Court held that the California

complaint did not give rise to jurisdiction in Tennessee. *Maxchief* explained that jurisdiction is based on defendants' conduct "directed at the forum" itself, not on the "effects" of that conduct on plaintiffs. *Id.* So, the "California lawsuit did not create sufficient contacts with Tennessee simply because Wok directed the lawsuit at an entity (Staples) that Wok knew had a Tennessee connection." *Id.* at 1139.

Like Wok's California lawsuit, LDG's complaint to Amazon in Washington did not create sufficient contacts with Utah. LDG directed *nothing* at Utah. Still, the Opinion distinguished *Maxchief*, saying that Wok did not direct "any action at all" at Tennessee and Meco. Op. 8. That distinction is incorrect. Maxchief's action was in response to Wok's California lawsuit directed to Staples and its Tennessee-made products and distributors. *Maxchief*, 909 F.3d at 1136-37.

The Opinion should have applied *Maxchief* to conclude that there was no jurisdiction over LDG in Utah.

* * *

Radio Systems, *Avocent*, and *Maxchief* control this case, but the Opinion avoided them through constitutionally irrelevant distinctions. The Opinion creates irreconcilable conflicts within this Court's precedents, warranting rehearing.

III. The Opinion created an inter-circuit split.

Beyond the intractable split with this Court's precedents, the Opinion created a split with other courts. Multiple sister circuits have followed *Walden*, finding no jurisdiction absent defendants' contacts with the forum itself:

- In the Seventh Circuit, "when a plaintiff is injured by acts that a defendant commits entirely within one forum . . . the fact that the plaintiff suffers the negative effects of those acts in his home forum . . . does not confer personal jurisdiction over the defendant." *In re Sheehan*, 48 F.4th 513, 524 (7th Cir. 2022).

- In the Ninth Circuit, "defendant's knowledge of the plaintiffs' strong forum connections, plus the foreseeable harm the plaintiffs suffered in the forum," does not comprise sufficient minimum contacts. *Axiom Foods, Inc. v. Acerchem Int'l, Inc.*, 874 F.3d 1064, 1069-70 (9th Cir. 2017).

- The Tenth Circuit held that the fact that the "effects" of defendant's conduct "were intended to be felt in Colorado" and "the brunt of the harm" occurred there did not establish jurisdiction there absent a specific disruption of a "particular sale or transaction" in Colorado. *C5 Med. Werks*, 937 F.3d at 1324.

- The Eighth Circuit held that there was no jurisdiction in Missouri because defendant did not "specifically target[ ]" and "uniquely or expressly" aim its sales of infringing products at Missouri through its nationally accessible website. *Bros. & Sisters in Christ, LLC v. Zazzle*, *Inc.*, 42 F.4th 948, 954 (8th Cir. 2022).

District courts similarly apply *Walden*'s principles:

- Exactly like this case, jurisdiction "must be based on intentional conduct directed at the forum state, and enforcement action directed at Amazon in Washington simply does not give rise to personal jurisdiction" in Illinois. Addendum B (*Wuhu Fashang Trading Co., v. Tim Mei Trade & Investments*, No. 23-cv-3226 (N.D. Ill. 2023)).

- No jurisdiction where defendant solicited investments "around the world" and plaintiffs were the only link to the forum. *Jayson*, 532 F. Supp. 3d at 1139.

- "The *Calder* effects test provides a basis for personal jurisdiction only in rare circumstances. . . . If, however, [defendant] directed his actions at Texas no more specifically than any other State, the case must be dismissed for lack of personal jurisdiction." *Brainstorm XX, LLC v. Wierman*, 2022 WL 4387858, at *5 (E.D. Tex. 2022) (quotes omitted).

- Defendant's knowledge of plaintiff's connection to forum and injury due to defendant's out-of-forum activities are insufficient. *Strong v. Scout Sec., Inc.*, 2022 WL 266709, at *9 (D.N.M. 2022).

- *Walden* clarified the contours of the "effects" test as applied to libel and "may significantly narrow otherwise broad readings of *Calder*'s 'effects' test." *Younique, L.L.C. v. Youssef*, 2016 WL 6998659, at *7 (D. Utah 2016).

Notably, Utah state courts would not exercise jurisdiction here: "[W]e emphasize that allegations of out-of-state conduct that happen to have effects that ripple into Utah cannot, by themselves, establish specific jurisdiction." *Raser Techs., Inc. v. Morgan Stanley & Co., LLC*, 449 P.3d 150, 162 (Utah 2019). Other state courts are consistent:

- Knowledge that the brunt of harm would have effects in the forum is insufficient to create jurisdiction. *Searcy v. Parex Res., Inc.*, 496 S.W.3d 58, 68-69 (Tex. 2016).

- No jurisdiction because defendant's "publication appears to be entirely out-of-state conduct that happened to affect a person with connections to Alaska." *Harper v. BioLife Energy Sys., Inc.*, 426 P.3d 1067, 1076 (Alaska 2018).

- No jurisdiction because, while defendant's Facebook post "could be read as being expressly aimed at Plaintiffs, whom [defendant] knew to be California residents," there was no evidence that posting was directed to California or

California audience and the readers are spread worldwide. *Burdick v. Superior Court*, 183 Cal. Rptr. 3d 1, 14 (2015).

Rehearing is needed to avoid a split with courts that apply *Walden*'s principles.

CONCLUSION

The Opinion failed to apply *Walden* and controlling Federal Circuit precedent while embracing abrogated, out-of-circuit cases. The Opinion split with courts following settled precedent and will foster confusion. The Court should grant panel rehearing or rehearing en banc.

Dated: July 3, 2024

Respectfully submitted,

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ADDENDUM

Tab	Document
A.	Opinion
B.	Copy of Order in *Wuhu Fashang Trading Co., v. Tim Mei Trade & Investments*, No. 23-cv-3226 (N.D. Ill. 2023)

Addendum A

United States Court of Appeals for the Federal Circuit

SNAPRAYS, DBA SNAPPOWER,
Plaintiff-Appellant

v.

LIGHTING DEFENSE GROUP,
Defendant-Appellee

2023-1184

Appeal from the United States District Court for the District of Utah in No. 2:22-cv-00403-DAK, Senior Judge Dale A. Kimball.

Decided: May 2, 2024

ELLIOTT J. WILLIAMS, Stoel Rives LLP, Portland, OR, argued for plaintiff-appellant. Also represented by NATHAN C. BRUNETTE; BRIAN PARK, Seattle, WA.

JEFFREY A. ANDREWS, Yetter Coleman, LLP, Houston, TX, argued for defendant-appellee. Also represented by DAVID JOSHUA GUTIERREZ, CHRISTOPHER JOHNSON.

Before MOORE, *Chief Judge*, LOURIE and DYK, *Circuit Judges*.

MOORE, *Chief Judge*.

SnapRays, d/b/a SnapPower (SnapPower) appeals a judgment of the United States District Court for the District of Utah dismissing its complaint for declaratory judgment of noninfringement against Lighting Defense Group (LDG) for lack of personal jurisdiction. Because we conclude LDG purposefully directed extra-judicial patent enforcement activities at SnapPower in Utah, we reverse and remand for further proceedings.

BACKGROUND

LDG is a Delaware limited liability company with its principal place of business in Arizona. LDG owns U.S. Patent No. 8,668,347. The ’347 patent relates to a cover for an electrical receptacle including a faceplate and a transmission tab configured to be electrically connected to the receptacle. ’347 patent at Abstract.

SnapPower is a Utah company with its principal place of business in Utah. SnapPower designs, markets, and sells electrical outlet covers with integrated guide lights, safety lights, motion sensor lights, and USB charging technology. These activities take place in Utah. J.A. 144. SnapPower sells its products on Amazon.com.

Amazon offers a low-cost procedure called the Amazon Patent Evaluation Express (APEX) “[t]o efficiently resolve claims that third-party product listings infringe utility patents.” J.A. 160. Under APEX, a third-party determines whether a product sold on Amazon.com likely infringes a utility patent, and if so, Amazon removes the listing from Amazon.com. J.A. 163. To initiate an evaluation under APEX, a patent owner submits an APEX Agreement to Amazon which identifies one claim of a patent and up to 20 allegedly infringing listings. J.A. 161. Amazon then sends the APEX Agreement to all identified sellers. J.A. 160. Each seller has three options to avoid automatic removal of their accused listings: (1) opt into the APEX program and

proceed with the third-party evaluation; (2) resolve the claim directly with the patent owner; or (3) file a lawsuit for declaratory judgment of noninfringement. J.A. 66–67. If the seller takes no action in response to the APEX Agreement, the accused listings are removed from Amazon.com after three weeks. J.A. 160.

In May 2022, LDG submitted an APEX Agreement alleging certain SnapPower products sold on Amazon.com infringed the '347 patent. Amazon notified SnapPower of the APEX Agreement and the available options. J.A. 66–67. After receiving the notification, SnapPower and LDG exchanged emails regarding the notice. J.A. 95. The parties also held a conference call, but no agreement was reached.

SnapPower subsequently filed an action for declaratory judgment of noninfringement. LDG moved to dismiss for lack of personal jurisdiction under Federal Rule of Civil Procedure 12(b)(2). The district court granted LDG's motion, holding it lacked specific personal jurisdiction over LDG. *SnapRays, LLC v. Lighting Def. Grp. LLC*, No. 2:22-CV-403-DAK-DAO, 2022 WL 16712899 (D. Utah Nov. 4, 2022) (*Decision*).

The district court concluded LDG lacked sufficient contacts with Utah for it to exercise specific personal jurisdiction. *Id.* at *5. Specifically, the district court found SnapPower did not demonstrate LDG purposefully directed activities at SnapPower in Utah, or that the action arose out of or related to any LDG activities in Utah. *Id.* Instead, the district court found LDG's allegations of infringement were directed toward Amazon in Washington, where the APEX Agreement was sent. *Id.* at *4. The district court found that while there may have been foreseeable effects in Utah, there was no evidence that LDG reached out to Utah except in response to SnapPower's communications. *Id.* The district court also noted that under Federal Circuit law, principles of fair play and substantial justice support a finding that LDG is not subject to

specific personal jurisdiction in Utah. *Id.* at *5 (citing *Red Wing Shoe Co. v. Hockerson-Halberstadt, Inc.*, 148 F.3d 1355, 1360–61 (Fed. Cir. 1998)). SnapPower appeals. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

DISCUSSION

Personal jurisdiction is a question of law that we review de novo. *Autogenomics, Inc. v. Oxford Gene Tech. Ltd.*, 566 F.3d 1012, 1016 (Fed. Cir. 2009). This appeal involves only claims of patent noninfringement, so "we apply Federal Circuit law because the jurisdictional issue is intimately involved with the substance of the patent laws." *Id.* (internal quotation marks omitted) (quoting *Avocent Huntsville Corp. v. Aten Intern. Co., Ltd.*, 552 F.3d 1324, 1328 (Fed. Cir. 2008)).

"Determining whether personal jurisdiction exists over an out-of-state defendant involves two inquiries: whether a forum state's long-arm statute permits service of process, and whether the assertion of personal jurisdiction would violate due process." *Inamed Corp. v. Kuzmak*, 249 F.3d 1356, 1359 (Fed. Cir. 2001). Utah's long-arm statute is "extended to the fullest extent allowed by due process of law." *Starways, Inc. v. Curry*, 980 P.2d 204, 206 (Utah 1999). Therefore, "the two inquiries collapse into a single inquiry: whether jurisdiction comports with due process." *Inamed*, 249 F.3d at 1360.

Here, where the parties agree there is no general jurisdiction over LDG, we have set forth a three-factor test for whether specific personal jurisdiction comports with due process: "(1) whether the defendant 'purposefully directed' its activities at residents of the forum; (2) whether the claim 'arises out of or relates to' the defendant's activities with the forum; and (3) whether assertion of personal jurisdiction is 'reasonable and fair.'" *Xilinx, Inc. v. Papst Licensing GmbH & Co. KG*, 848 F.3d 1346, 1353 (Fed. Cir. 2017) (citing *Inamed*, 249 F.3d at 1360). "The first two factors comprise the 'minimum contacts' portion of the

jurisdictional framework. . . ." *Jack Henry & Assocs., Inc. v. Plano Encryption Techs. LLC*, 910 F.3d 1199, 1204 (Fed. Cir. 2018). Where the first two factors are satisfied, specific jurisdiction is "presumptively reasonable." *Xilinx*, 848 F.3d at 1356. The burden then shifts to the defendant to present "a compelling case that the presence of some other considerations would render jurisdiction unreasonable." *Burger King Corp. v. Rudzewicz*, 471 U.S. 462, 477 (1985).

I

SnapPower argues that LDG purposefully directed enforcement activities at Utah when it initiated the APEX program. We agree LDG purposefully directed its activities at SnapPower in Utah, intending effects which would be felt in Utah, and conclude this satisfies the first element of our test for specific personal jurisdiction. LDG intentionally submitted the APEX Agreement to Amazon. The APEX Agreement identified SnapPower listings as allegedly infringing. LDG knew, by the terms of APEX, Amazon would notify SnapPower of the APEX Agreement and inform SnapPower of the options available to it under APEX. J.A. 160. If SnapPower took no action, its listings would be removed, which would necessarily affect sales and activities in Utah. SnapPower therefore sufficiently alleged LDG "undertook intentional actions that were expressly aimed at th[e] forum state," and "foresaw (or knew) the effects of its action would be felt in the forum state." *Dudnikov*, 514 F.3d at 1077. This satisfies the first factor.

This decision is consistent with our sister circuits which held extra-judicial enforcement activities, even when routed through a third-party, satisfy purposeful direction. *Dudnikov v. Chalk & Vermilion Fine Arts, Inc.*, 514 F.3d 1063 (10th Cir. 2008); *Bancroft & Masters, Inc. v. August National Inc.*, 223 F.3d 1082 (9th Cir. 2000), *overruled in part on other grounds by Yahoo! Inc. v. La Ligue Contre Le Racisme Et L'Antisemitisme*, 433 F.3d 1199, 1207 (9th Cir. 2006) (holding that "the 'brunt' of the harm need

not be suffered in the forum state" and "[i]f a jurisdictionally sufficient amount of harm is suffered in the forum state, it does not matter that even more harm might have been suffered in another state").

In *Dudnikov*, the Tenth Circuit concluded a Colorado court had specific personal jurisdiction over a copyright owner where that owner submitted a notice of claimed infringement (NOCI) to eBay's Verified Rights Owner (VeRO) program. *Dudnikov*, 514 F.3d at 1068. Under the VeRO program, eBay automatically terminated the plaintiffs' auction when a NOCI was submitted. *Id.* The court reasoned that while the defendants' NOCI was technically directed at California, where eBay was located, defendants' "express aim in acting was to halt a Colorado-based sale by a Colorado resident, and neither the lack of defendants' physical presence in Colorado nor the fact that they used a California-based entity to effectuate this purpose diminish this fact." *Id.* at 1076.

The Ninth Circuit reached a similar conclusion in *Bancroft*. There, the court concluded a California district court had specific personal jurisdiction over a defendant who sent a letter to Network Solutions, Inc. (NSI), the sole registrar of domain names in the United States at the time, challenging plaintiff's use of a domain name. *Bancroft*, 223 F.3d at 1084–85. Like *Dudnikov*, defendant's letter automatically triggered NSI's dispute resolution process, which would result in the plaintiff losing the domain name unless a declaratory judgment action was filed. *Id.* at 1085. The court reasoned the defendant acted intentionally when it sent the letter, and even though the letter was sent to NSI in Virginia, it was expressly aimed at the plaintiff in California because it individually targeted the plaintiff, a California corporation, and the effects would foreseeably be felt primarily in California. *Id.* at 1088.

LDG argues our precedent requires a different outcome. In *Avocent*, Avocent argued the purposeful direction

element was satisfied by letters sent by the defendant to Amazon and Avocent because "the intended effect of the letters was to slow the sale of Avocent's allegedly infringing products." 552 F.3d at 1340. We held sending the letters did not constitute purposefully directed activities because "a patent owner may, without *more*, send cease and desist letters to a suspected infringer, or its customers, without being subjected to personal jurisdiction in the suspected infringer's home state." *Id.* (emphasis added) (quoting *Breckenridge Pharm., Inc. v. Metabolite Lab'ys, Inc.*, 444 F.3d 1356, 1362 (Fed. Cir. 2006)). Importantly, the letters sent by Aten did not have any automatic effect. In other words, the letters could be ignored without automatic consequences to Avocent and Avocent's business activities. The APEX Agreement goes beyond a cease and desist letter because, absent action by SnapPower in response to the APEX Agreement, SnapPower's listings would have been removed from Amazon.com. J.A. 67. The automatic takedown process, which would affect sales and activities in the forum state, is the "more" *Avocent* envisioned.

Second, LDG argues we are bound by *Radio Systems Corp. v. Accession, Inc.*, 638 F.3d 785 (Fed. Cir. 2011), where we rejected the logic of *Dudnikov* and *Bancroft*. We do not agree. In *Radio Systems*, we held interactions between the defendant's counsel and the Patent and Trademark Office (PTO) did not give rise to personal jurisdiction. 638 F.3d at 792. The defendant in *Radio Systems* alerted the PTO to the existence of the patent in question during examination of plaintiff's patent. *Id.* at 788. The defendant did not initiate extra-judicial patent enforcement or reach into the forum state to affect allegedly infringing sales. To the extent LDG argues *Radio Systems* stands for the idea that *in personam* patent enforcement within the forum state is necessary to create specific personal jurisdiction, courts have held otherwise. *See, e.g.*, *Trimble Inc. v. PerDiem Co. LLC*, 997 F.3d 1147, 1155–56 (Fed. Cir. 2021) (describing relevant contacts such as sending

communications into the forum state); *see also Burger King*, 471 U.S. at 467 ("So long as a commercial actor's efforts are 'purposefully directed' toward residents of another State, we have consistently rejected the notion that an absence of physical contacts can defeat personal jurisdiction there.").

Third, LDG argues we also rejected *Dudnikov* and *Bancroft* in *Maxchief Investments, Ltd. v. Wok & Pan Industry, Inc.*, 909 F.3d 1134 (Fed. Cir. 2018). We do not agree. In *Maxchief*, we held a patentee's suit against a company in California did not give rise to specific personal jurisdiction over the patentee in Tennessee, the home state of a downstream distributor of the California company. 909 F.3d at 1138. "[I]t is not enough that [the patentee's] lawsuit might have 'effects' in Tennessee. Rather, jurisdiction 'must be based on intentional conduct by the defendant' directed at the forum." *Id.* (quoting *Walden v. Fiore*, 571 U.S. 277, 286 (2014)). The lawsuit filed in California was directed at California, not Tennessee, and any effects that might be felt in Tennessee were too attenuated to satisfy minimum contacts. *Id.* at 1139. There was no enforcement action, or any action at all, taken against the Tennessee distributor or directed at Tennessee. Here, however, LDG purposefully directed the APEX Agreement, through Amazon in Washington, at SnapPower in Utah. LDG's express aim was the removal of SnapPower's Amazon.com listings, which would necessarily affect sales, marketing, and other activities in Utah.

Fourth, LDG argues *Walden v. Fiore*, 571 U.S. 277, (2014), requires affirmance. The Supreme Court in *Walden* held Nevada did not have specific personal jurisdiction over a Drug Enforcement Agency (DEA) officer in a suit seeking money damages under *Bivens v. Six Unknown Fed. Narcotics Agents*, 403 U.S. 388 (1971). *Walden*, 571 U.S. at 281. The Court explained "the plaintiff cannot be the only link between the defendant and the forum. Rather, it is the defendant's conduct that must form the necessary connection

with the forum State that is the basis for its jurisdiction over him." *Id.* at 285 (citing *Burger King*, 471 U.S. at 478). The Court concluded that the defendant's actions of approaching, questioning, searching, and seizing the money of plaintiffs in the Atlanta airport was not directed at Nevada, the home state of the plaintiffs. *Id.* at 288. The Court also concluded that drafting a "false probable cause affidavit" in Georgia, sent to the United States Attorney's Office in Georgia, did not connect the defendant to Nevada. *Id.* The plaintiffs' connections to Nevada did not satisfy minimum contacts of the defendant with Nevada. *Id.* at 289.

The *Walden* Court distinguished the result in *Calder v. Jones*, 465 U.S. 783 (1984), where the out-of-state action "connected the defendants' conduct to *California*, not just to a plaintiff who lived there." *Id.* at 288 (emphasis in original). In *Calder*, the Court found specific personal jurisdiction where an out-of-state defendant wrote an allegedly libelous article about a resident of California. *Calder*, 465 U.S. at 791. The *Walden* Court explained that the effects of the alleged libel, loss of reputation through communication to third persons, connected the defendant to California and not just the resident of California. *Walden*, 465 U.S. at 287. Here as well, the intended effect would necessarily affect marketing, sales, and other activities within Utah. We therefore conclude LDG's actions were purposefully directed at residents of Utah.

II.

The second factor in the test for whether specific personal jurisdiction comports with due process asks whether the claim arises out of or relates to the defendant's activities with the forum. *Xilinx*, 848 F.3d at 1353. LDG argues SnapPower's action for declaratory judgment of noninfringement does not arise from or relate to any activity by LDG in Utah because the APEX Agreement was sent to Washington, not Utah. Because we hold LDG's action of submitting the APEX Agreement was directed towards

SnapPower in Utah and aimed to affect marketing, sales, and other activities in Utah, we also conclude SnapPower's suit arises out of defendant's activities with the forum.

III.

Having satisfied the first two factors, specific jurisdiction is "presumptively reasonable." *Xilinx*, 848 F.3d at 1356. LDG argues, under the third factor, the assertion of specific personal jurisdiction over it in Utah would be unfair and unreasonable. The "crux" of LDG's argument is "based on concerns about how ruling for SnapPower in this matter opens the floodgates of personal jurisdiction and allow lawsuits against any APEX participant anywhere in the country." Response Br. at 51. The district court agreed with LDG, noting under our case law, "principles of fair play and substantial justice afford a patentee sufficient latitude to inform others of its patent rights without subjecting itself to jurisdiction in a foreign forum." *Decision* at *5 (quoting *Red Wing Shoe*, 148 F.3d at 1360–61)). We conclude LDG did not meet its burden to present "a compelling case that the presence of some other considerations would render jurisdiction unreasonable." *Burger King*, 471 U.S. at 477.

First, we are unpersuaded that our holding will open the floodgates of personal jurisdiction, or that such a result is inherently unreasonable. Parties who participate in APEX by submitting an Agreement will only be subject to specific personal jurisdiction where they have targeted a forum state by identifying listings for removal that, if removed, affect the marketing, sales, or other activities in that state. LDG has not presented any compelling argument for why this result is unreasonable.

Second, our holding does not disturb the policy of *Red Wing Shoe*. *Red Wing Shoe* held principles of fair play and substantial justice protected a patentee from being subject to specific personal jurisdiction in a forum where the only contact with the forum is sending a cease and desist letter.

148 F.3d at 1361. We explained that a "patentee should not subject itself to personal jurisdiction in a forum solely by informing a party who happens to be located there of suspected infringement." *Id.* Here, LDG did more than send a cease and desist letter. LDG initiated a process that, if SnapPower took no action, would result in SnapPower's listings being removed from Amazon.com, necessarily affecting sales activities in Utah. LDG has not articulated a compelling argument why it would be unfair or unreasonable for it to be subject to specific personal jurisdiction in Utah under these circumstances.

CONCLUSION

We have considered LDG's other arguments and find them unpersuasive. Because LDG's actions satisfy the three-factor test for specific personal jurisdiction, we reverse and remand for further proceedings.

REVERSED AND REMANDED

COSTS

No costs.

Addendum B

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

Wuhu Fashang Trading Co., *Plaintiff*, v. Tim Mei Trade & Investments Ltd., *Defendant*	No. 23 CV 3226 Judge Lindsay C. Jenkins

ORDER

Plaintiff Wuhu Fashang Trading Co. ("Wuhu") filed this suit against Defendant Tim Mei Trade & Investments, Ltd. ("Tim Mei"). The heart of the allegations concern U.S. Design Patent No. D943,337 ("'337 patent"), which is held by Tim Mei. [Dkt. No. 1 at ¶ 1.] Wuhu seeks declaratory judgment relief (Count I) and brings two state law claims for violation of the Uniform Deceptive Trade Practices Act (815 ILCS § 510) (Count II) and Tortious Interference with Prospective Economic Advantage (Count III). [Dkt No. 1.]

Before the Court is Tim Mei's motion to dismiss pursuant to Federal Rule of Civil Procedure 12(b)(2). Because the contacts between Tim Mei and the State of Illinois are insufficient to confer personal jurisdiction, the motion to dismiss is granted [Dkt. No. 11] and all other motions are terminated as moot.

A motion to dismiss under Rule 12(b)(2) challenges whether the Court has jurisdiction over a party. The party asserting jurisdiction has the burden of proof. *See Tamburo v. Dworkin*, 601 F.3d 693, 701 (7th Cir. 2010); *Elecs. for Imaging, Inc. v. Coyle*, 340 F.3d 1344, 1350 (Fed. Cir. 2003). Since this is a patent case, the Court applies the law of the Federal Circuit in determining whether to exercise personal jurisdiction over a defendant. *Beverly Hills Fan Co. v. Royal Sovereign Corp.*, 21 F.3d 1558, 1565 (Fed. Cir. 1994).

Personal jurisdiction comes in two forms: general and specific. General jurisdiction arises when the defendant has "continuous and systematic" contacts with the forum state. *Helicopteros Nacionales de Colombia, S.A. v. Hall*, 466 U.S. 408, 416, 104 S.Ct. 1868, 80 L.Ed.2d 404 (1984). A defendant is subject to general jurisdiction only where its contacts with the forum state are so substantial that it can be considered "constructively present" or "at home" in the state. *Goodyear Dunlop Tires Ops., S.A. v. Brown*, 564 U.S. 915, 131 S.Ct. 2846, 2851, 180 L.Ed.2d 796 (2011). There is no dispute that Tim Mei has no substantial and continuous presence in Illinois, and thus the Court lacks general jurisdiction over it.

To establish specific jurisdiction, the Federal Circuit uses a three-factor test: "(1) whether the defendant 'purposefully directed' its activities at residents of the forum; (2) whether the claim 'arises out of or relates to' the defendant's activities with the forum; and (3) whether assertion of personal jurisdiction is 'reasonable and fair.'" *Xilinx, Inc. v. Papst Licensing GmbH & Co. KG*, 848 F.3d 1346, 1353 (Fed. Cir. 2017). Since Wuhu seeks declaratory relief, such a claim arises out of the patentee's contacts with the forum state only if those contacts "relate in some material way to the enforcement or the defense of the patent." *Avocent Huntsville Corp. v. Aten Int'l Co.*, 552 F.3d 1324, 1336 (Fed. Cir. 2008). This requires "some enforcement activity in the forum state by the patentee." *Id.* For instance, a patentee who sends infringement notice letters to an entity doing business in the forum state and travels there to discuss the alleged infringement satisfies the minimum contacts requirement, as does a patentee who enters into an exclusive licensing agreement with an entity in the forum state. *Maxchief Invs. Ltd. v. Wok & Pan, Ind., Inc.*, 909 F.3d 1134, 1138 (Fed. Cir. 2018)

Wuhu's complaint states the following with respect to jurisdiction: ". . . this Court may properly exercise personal jurisdiction over Defendant because defendant, through its wrongful enforcement of the '337 Patent against Plaintiff on the Amazon.com platform, has caused Plaintiff's sales of a certain food grill product into Illinois to cease. Prior to Defendant's wrongful enforcement of the '337 Patent against the product, Plaintiff enjoyed sales of the product into Illinois, however once Defendant wrongfully enforced its '337 Patent against Plaintiff's product through Amazon.com's infringement reporting function, Plaintiff's sales of the product into Illinois has ceased." [Dkt. No. 1, ¶ 6.]

Relying on the declaration of Yeung Yuen Fung, Tim Mei asserts that it has not directed any enforcement action toward Illinois. [Dkt. No. 12 at ¶¶ 8-9.] For its part, Wuhu does not dispute this; rather, it maintains that specific jurisdiction arises from Tim Mei's "filing of the infringement complaint with Amazon" on Amazon's dispute platform in Washington state, which resulted in lost sales including in Illinois. [Dkt. No. 18 at 1.]

Whether a defendant's contacts with Amazon's patent enforcement measures amounts to extra-judicial enforcement activity sufficient to establish personal jurisdiction was squarely addressed in *SnapRays, LLC v. Lighting Defense Group, LLC*, 22-cv-403, 2022 WL16712899 (D. Utah Nov. 4, 2022). There, defendant's relevant contacts with the forum state of Utah consisted of responding to an email from the plaintiff that originated from Utah; accepting an invitation for a phone conference from the plaintiff that originated in Utah; and initiating a dispute resolution procedure with Amazon in Washington, a process that prompted Amazon to contact the plaintiff in Utah. *Id.* at *1. The Court held these contacts were "not an extra-judicial enforcement activity in Utah that can give rise to personal jurisdiction

in Utah." *Id*. at *4. In so holding, the Court distinguished the very cases Wuhu cites in its brief, namely, *Campbell Pet Co. v. Miale*, 542 F.3d 879, 886 (Fed.Cir.2008) and *Dudnikov v. Chalk & Vermilion Fine Arts, Inc.*, 514 F.3d 1063, 1069 (10th Cir. 2008).

In *Radio Systems Corp. v. Accession, Inc.*, the Federal Circuit declined to follow *Dudnikov*, noting that *Dudnikov*, a Tenth Circuit Case, was at odds with *Avocent*. *Radio Systems Corp. v. Accession, Inc.*, 638 F.3d 785 (Fed. Cir. 2011) (declining to follow *Dudnikov's* "bank shot" theory). *Avocent* "distinguished *Campbell Pet* on the ground that in that case, the extrajudicial enforcement activities occurred within the forum state." *Id.*

Though not binding, the Court agrees with the conclusion reached in *SnapRays* – jurisdiction must be based on intentional conduct directed at the forum state, and enforcement action directed at Amazon in Washington simply does not give rise to personal jurisdiction. The Complaint does not allege that Tim Mei directed any intentional conduct toward Illinois, *see* Dkt. No. 1, ¶¶ 10-15, such as, for instance, an exchange of correspondence or an infringement notice letter. *Xilinx.* 848 F.3d at 1353. In this way, the Complaint alleges even fewer contacts between Tim Mei and Illinois than the defendant had with Utah in *SnapRays*. The motion to dismiss is granted.

Wuhu's other claims must be dismissed, as well. Absent a viable federal claim, the state law claims are properly dismissed due to lack of supplemental jurisdiction. *See Dietchweiler by Dietchweiler v. Lucas*, 827 F.3d 622, 631 (7th Cir. 2016) ("when the federal claims are dismissed before trial, there is a presumption that the court will relinquish jurisdiction over any remaining state law claims"). This presumption is statutorily expressed in 28 U.S.C. § 1367(c)(3), which provides for the discretionary relinquishment of jurisdiction over state claims when the claims providing original jurisdiction (here, federal-question jurisdiction) have been dismissed.

Civil case terminated.

Enter: 23-cv-3226
Date: August 3, 2023

Lindsay C. Jenkins
United States District Judge

Certificate of Compliance

1. This document complies with the type-volume limitations of Federal Rule of Appellate Procedure 32(a)(7)(B) because this document contains 3,869 words, excluding the parts of the document exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b)(2).

2. This document complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type-style requirements of Federal Rule of Appellate Procedure 32(a)(6) because this document has been prepared in a proportionally spaced typeface using Microsoft® Office Word 2016 in 14-Point Equity A font.

Date: July 3, 2024

/s/Grant B. Martinez
Grant B. Martinez

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing Corrected Appellee Lighting Defense Group's Petition for Rehearing and Rehearing En Banc with the Clerk of the United States Court of Appeals for the Federal Circuit via the CM/ECF system, on the 3rd day of July, 2024, which will send an electronic copy and notice all counsel of record registered as CM/ECF users in this matter.

/s/Grant B. Martinez
Grant B. Martinez