

**IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA**

**SHENZHEN HAPPY VAPING
TECHNOLOGY LTD.,**

Plaintiff,

v.

**LOGIC TECHNOLOGY DEVELOPMENT
LLC, and
JAPAN TOBACCO INTERNATIONAL
U.S.A., INC.,**

Defendants.

CIVIL ACTION NO. 0:22-cv-61407-RS

**DEFENDANTS' MOTION TO DISMISS FOR IMPROPER VENUE OR TO TRANSFER
VENUE AND INCORPORATED MEMORANDUM OF LAW**

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Pursuant to Fed. R. Civ. P. 12(b)(3) and 28 U.S.C. § 1406, Defendants Logic Technology Development LLC (“Logic”) and Japan Tobacco International U.S.A., Inc. (“JTI USA”) respectfully move the Court to dismiss Plaintiff’s Complaint [ECF 1] for improper venue or, in the alternative, to transfer venue to the District of New Jersey where venue is proper.

I. INTRODUCTION

This is a patent infringement case against Delaware and California corporations that share a principal office in New Jersey. *See* Declaration of Brendan LeMoult, attached hereto as **Exhibit 1** (“LeMoult Decl.”), ¶¶ 4-5; Declaration of Nadezda Pshenitsyna, attached hereto as **Exhibit 2** (“Pshenitsyna Decl.”), ¶¶ 4-5. Because neither “resides” in Florida by virtue of its incorporation nor has a “regular and established place of business” in this state under the Supreme Court’s interpretation of the patent venue statute, venue is improper in this District. *See TC Heartland LLC v. Kraft Foods Grp. Brands LLC*, 137 S. Ct. 1514, 1517-21 (2017); 28 U.S.C. § 1400(b). Even Plaintiff Shenzhen Happy Vaping Technology Ltd. (“SHV”) acknowledges Defendants’ incorporations outside this District. ECF 1, ¶¶ 2-3. SHV thus attempts to confer venue by showing that each of the Defendants has a regular and established place of business in this District. *Id.* ¶¶ 7-9, 11. But SHV’s efforts fall short.

None of the Florida addresses identified in the Complaint constituted a place of business of either Defendant for purposes of establishing patent venue in this District for this litigation. *See id.* ¶¶ 7-9; Ex. 1 (LeMoult Decl.), ¶¶ 7-9; Ex. 2 (Pshenitsyna Decl.), ¶ 7. Nor does either company’s use of a registered agent in Florida or filing of annual reports in the state suffice to establish venue. *See infra* Section (IV)(A)(2)(i). Because SHV has not identified a regular and established place of business of each Defendant in this District, its Complaint cannot support venue here with respect to either Defendant. This Court is thus compelled by § 1406 to dismiss this case or transfer it to the District of New Jersey where it could have been brought in the first instance.

II. FACTUAL AND PROCEDURAL BACKGROUND

A. SHV's Complaint and Its Allegations

SHV filed its Complaint on July 28, 2022. *See* ECF 1-1. In the Complaint, SHV acknowledges that JTI USA and Logic are incorporated in California and Delaware, respectively. *Id.* ¶¶ 2-3. SHV also identifies the “principal place of business” of each of the Defendants as “Glenpointe Centre East, 300 Frank W Burr Blvd, Suite 70, Teaneck, New Jersey, 07666.” *Id.*

In the section of the Complaint alleging venue, however, SHV states: “Defendants have established, and during at least a portion of the relevant dates, maintained a regular and physical place of business in this District as discussed in paragraphs 6 through 10 above.” *Id.* ¶ 11. Those paragraphs allege places of business based on use of a registered agent in Tallahassee, Florida, and filing annual reports in Florida by both Defendants (*id.* ¶ 7); “an office at 2004 NW 25th Avenue, Pompano Business Center, Pompano Beach, Florida” for Logic (*id.*); “a physical office at 9130 S. Dadeland Blvd in Miami, Florida,” for JTI USA (*id.* ¶ 8); and an “address of [JTI USA’s] Title Director, Mr. John Colton, . . . located at 501 Brickell Key Drive in Miami, Florida” (*id.* ¶ 9).

B. Japan Tobacco International U.S.A., Inc.

JTI USA is a corporation organized and existing under the laws of California. *See* State of California Statement of Information, attached hereto as **Exhibit 3**; Ex. 1 (LeMoult Decl.), ¶ 4. JTI USA is a wholly owned U.S. subsidiary of JTI (US) Holding Inc. (“JTI Holding”). Ex. 1 (LeMoult Decl.), ¶ 3. The ultimate parent company for JTI Holding is Japan Tobacco Inc. (“JTI”), which is a Japanese company based in Tokyo, Japan. *Id.* JTI USA sells tobacco products in the United States and provides certain services to Logic in accordance with a services agreement between Logic and JTI USA. *Id.*

JTI USA’s principal place of business is currently at 300 Frank W Burr Blvd., Suite 70, Teaneck, NJ 07666. Ex. 3; Ex. 1 (LeMoult Decl.), ¶ 5; *see* Teaneck, New Jersey Lease, attached

hereto as **Exhibit 4**¹. JTI USA has maintained its principal place of business at this office complex in New Jersey since at least August 2008. *See* Teaneck, New Jersey Lease, attached hereto as **Exhibit 5**; Ex. 1 (LeMoult Decl.), ¶ 5. JTI USA does not currently lease, own, or maintain any office or other place of business in Florida. Ex. 1 (LeMoult Decl.), ¶ 6.

C. Logic Technology Development LLC

Logic is a corporation organized and existing under the laws of Delaware. *See* Delaware Certificate of Formation, attached hereto as **Exhibit 6**; Ex. 2 (Pshenitsyna Decl.), ¶ 4. Logic was acquired by JTI in 2015 and is currently a wholly owned U.S. subsidiary of JTI Holding. *See* Acquisition Press Release Delaware Certificate of Formation, attached hereto as **Exhibit 7**; Ex. 2 (Pshenitsyna Decl.), ¶ 3. Logic sells vapor products in the United States and receives certain services from JTI USA in accordance with a services agreement between Logic and JTI USA. Ex. 2 (Pshenitsyna Decl.), ¶ 3.

Logic's principal place of business is currently at Glenpointe Centre, 300 Frank W Burr Boulevard, Teaneck, New Jersey 07666. *Id.* ¶ 5. While this location is leased to JTI USA, JTI USA shares this office with Logic. *Id.* Logic has maintained its principal place of business at this address since at least February 2020. Ex. 4; Ex. 2 (Pshenitsyna Decl.), ¶ 5. Before that, since at least September 2015, Logic maintained its principal place of business at Arbor 600, 600 College Road East, Princeton Forrestal Center, New Jersey. *See* Princeton, New Jersey Lease, attached hereto as **Exhibit 8**; Ex. 2 (Pshenitsyna Decl.), ¶ 5. Logic does not currently lease, own, or maintain any office or other place of business in Florida. Ex. 2 (Pshenitsyna Decl.), ¶ 6.

¹ Exhibits 4, 5, and 8 through 21 contain confidential information and have therefore been redacted. Separately, Defendants are filing a Motion to File Under Seal the unredacted exhibits.

III. LEGAL STANDARDS

Under Fed. R. Civ. P. 12(b)(3) and 28 U.S.C. § 1406, an action must be dismissed or transferred when venue is improper under the applicable venue rules. *Atl. Marine Const. Co. v. U.S. Dist. Ct. for W. Dist. of Tex.*, 571 U.S. 49, 55 (2013). Venue in patent cases is governed by 28 U.S.C. § 1400(b), which provides that venue is proper “in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.” Under the first prong, a corporate defendant resides in its state of incorporation. *TC Heartland*, 137 S. Ct. at 1520.

Under the second prong, a “regular and established place of business” requires more than just conducting business in the district. *See In re Cordis Corp.*, 769 F.2d 733, 737 (Fed. Cir. 1985) (“[T]he appropriate inquiry is whether the corporate defendant does its business in that district through a permanent and continuous presence there and not . . . whether it has a fixed physical presence in the sense of a formal office or store.”). Further, that a defendant is “authorized to do business in [the state] is not controlling and will not satisfy the [§ 1400(b)] requirement.” *Gaddis v. Calgon Corp.*, 449 F.2d 1318, 1320 (5th Cir. 1971).

“On a motion to dismiss based on improper venue, the plaintiff has the burden of showing that venue in the forum is proper.” *Wai v. Rainbow Holdings*, 315 F. Supp. 2d 1261, 1268 (S.D. Fla. 2004). In considering the motion to dismiss, the “court must accept all allegations of the complaint as true, unless contradicted by the defendants’ affidavits.” *Id.* “The court must draw all reasonable inferences and resolve all factual conflicts in favor of the plaintiff.” *Id.*

IV. ARGUMENT

A. Venue Is Improper in the Southern District of Florida

As explained above, venue for this patent infringement action is proper as to each defendant only in (1) the district where the defendant resides (i.e., where it is incorporated); or (2) where acts

of infringement were committed *and* the defendant has a regular and established place of business. 28 U.S.C. § 1400(b); *TC Heartland*, 137 S. Ct. at 1517-21. SHV cannot show that venue is proper as to either of the Defendants because neither is incorporated in Florida nor does either have a regular and established place of business in Florida.

1. Neither Logic nor JTI USA Resides in Florida

Since JTI USA is incorporated in California, it does not reside in Florida, and SHV cannot rely on JTI USA's residence in California to establish venue in this District. *See* Ex. 3; Ex. 1 (LeMoult Decl.), ¶ 4. Likewise, because Logic is incorporated in Delaware, its non-Florida residence precludes SHV from relying on Logic's state of incorporation to establish venue in this District. Ex. 6; Ex. 2 (Pshenitsyna Decl.), ¶ 4.

2. Neither Logic nor JTI USA Maintains a Regular and Established Place of Business in This District

SHV also cannot satisfy the second prong of § 1400(b) with respect to either of the Defendants because neither Logic nor JTI USA has a "regular and established place of business" in this District.

i. Registration to Do Business in Florida Cannot Confer Venue

SHV's reliance in the Complaint on the Defendants' use of a registered agent in Florida and filing of annual reports there in support of its venue assertions is misplaced. *See* ECF 1, ¶ 7. Courts have repeatedly rejected the theory that by attending to these types of administrative formalities in a state constitutes establishing a "regular and established place of business" in that state for purposes of § 1400(b). *See, e.g., Mallinckrodt IP v. B. Braun Med. Inc.*, Nos. 17-365-LPS, 17-660-LPS, 2017 WL 6383610, at *5 (D. Del. Dec. 14, 2017) ("The Court disagrees with Plaintiffs' assertion that [the defendant] 'has a physical presence in Delaware through its appointment of an agent for the service of process in Delaware.'" (citations omitted)); *Symbology*

Innovations, LLC v. Lego Sys., Inc., 282 F. Supp. 3d 916, 931 (E.D. Va. 2017) (“Consideration of the appointed agent is especially inappropriate because the patent venue statute was intended to eliminate the abuses engendered by subjecting defendants to suit wherever they could be served.”); *BillingNetwork Pat., Inc. v. Modernizing Med., Inc.*, No. 17 C 5636, 2017 WL 5146008, at *2 (N.D. Ill. Nov. 6, 2017) (“It is likewise irrelevant that, incident to Defendant's registration to do business in Illinois, it has appointed an agent for service of process in this state”); *Genuine Enabling Tech., LLC v. Nintendo Co.*, 369 F. Supp. 3d 590, 597 (D. Del. 2019) (denying the theory that by appointing an agent for service of process, a corporation waived the right to object to venue there because “[s]urely, in seeking to prevent corporate defendants from being sued for patent infringement ‘in any district in which [they] could be served,’ Congress did not intend that, by operation of a waiver rule, a corporate defendant could be sued in any state in which it had appointed an agent to receive service of process” (alteration in original) (citation omitted)). Accordingly, SHV cannot properly rely on either Defendant’s administrative activities related to merely doing business in the state of Florida to confer patent venue.

ii. Logic Ceased Doing Business at the Pompano Address Years Before Filing of the Complaint

The Complaint alleges that “[u]pon information and belief,” Logic “established and maintained, during at least a portion of the relevant timeframe, an office at 2004 NW 25th Avenue, Pompano Business Center, Pompano Beach, Florida.” ECF 1, ¶ 7. The Complaint does not set forth any facts supporting its belief that Logic has an office at this location nor does it explain what SHV considers to be the “relevant timeframe.” *Id.* Regardless, SHV’s information is inaccurate and its belief unfounded.

Because § 1400(b) is a patent-specific venue provision, and the Federal Circuit has exclusive jurisdiction over patent infringement actions, Federal Circuit law controls over regional

circuit precedent when interpreting this statute. *See, e.g., In re Oath Holdings Inc.*, 908 F.3d 1301, 1304-05 (Fed. Cir. 2018) (“We made clear, however, that the interpretation of § 1400(b), a patent-specific statute, . . . is a matter of Federal Circuit law, not regional circuit law . . .”). However, with respect to “the exact timing for determining” whether the facts confer patent “venue,” the Federal Circuit recently declined to “decide the correct standard” while acknowledging that “[t]he regional circuits appear to be split.” *In re Google LLC*, 949 F.3d 1338, 1340 n.1 (Fed. Cir. 2020). In the 11th Circuit, “venue must be determined based on the facts at the time of filing.” *Flowers Indus., Inc. v. F.T.C.*, 835 F.2d 775, 776 n.1 (11th Cir. 1987); *see also Omega Pats., LLC v. CalAmp Corp.*, No. 6:13-cv-1950-Orl-40DCI, 2017 WL 4990654, at *3 (M.D. Fla. Sept. 22, 2017) (applying the time-of-filing rule from *Flowers* in the patent venue context). This rule is consistent with the present tense of the statute, describing a place where the defendant “*has* a regular and established place of business.” 28 U.S.C. § 1400(b) (emphasis added).

Under the prevailing 11th Circuit rule, the Pompano address cannot confer patent venue because Logic discontinued use of this warehouse space in November 2018, with the lease on the space formally ending in March 2019. Ex. 2 (Pshenitsyna Decl.), ¶ 7; *see* Pompano, Florida Lease, attached hereto as **Exhibit 9**. As explained by Logic’s Treasurer and Chief Financial Officer, the Pompano warehouse was relocated to Danville, Virginia, in September 2018. Ex. 2 (Pshenitsyna Decl.), ¶ 7; *see* Danville, VA lease, attached hereto as **Exhibit 10**. Because the Complaint in the present case was filed on July 28, 2022, years after relocation of the Pompano warehouse, the Pompano warehouse was not used or leased by Logic at the time of filing of the case.

Moreover, even if this Court departs from the Eleventh Circuit rule with respect to the temporal requirements of the patent venue statute, the Pompano address still cannot confer venue in this District because SHV delayed over three years from when Logic left the forum in March 2019

before filing its Complaint. Specifically, the competing rule in other circuits is that venue is proper if the defendant had a “regular and established place of business at the time the cause of action accrued and suit is filed within a reasonable time thereafter.” *Welch Sci. Co. v. Hum. Eng’g Inst., Inc.*, 416 F.2d 32, 35 (7th Cir. 1969). Under that rule, the Pompano address cannot confer patent venue in Florida because courts permit only a small period of time—much less than three years—to elapse between when a defendant left the forum and when the Complaint was filed. *See, e.g., Level Sleep LLC v. Dormeo N. Am., LLC*, No. 2:18-CV-00120-RWS, 2019 WL 458467, at *3 (E.D. Tex. Feb. 1, 2019) (subjecting defendants to “suit four months after their lease in this district expired” would be improper); *Incipio, LLC v. Argento Sc By Sicura Inc.*, No. SACV 17-01974 AG (KESx), 2018 WL 4945002, at *5 (C.D. Cal. July 18, 2018) (finding a six-month delay to be too long to subject defendants to suit in the district). Since courts have rejected cases with much more compelling delays, even under the rule in other circuits, venue in Florida based on Logic’s prior lease or use of the Pompano address is improper.

In short, no accurate allegation supports SHV’s attempt to establish that Logic had a “regular and established place of business” at the Pompano address as of the filing date of the Complaint or that a reasonable time elapsed between when Logic terminated the lease and use of the Pompano address and the Complaint was filed. Venue in this District with respect to Logic is therefore improper.

iii. JTI USA Never Maintained an Office at the Dadeland Address

The Complaint alleges that “[u]pon information and belief, during a portion of the relevant dates and at the time the complaint was filed, [JTI USA] maintained a physical office at 9130 S. Dadeland Blvd in Miami, Florida.” ECF 1, ¶ 8. This is incorrect. *See* Dadeland Lease Termination Letter, attached hereto as **Exhibit 11**; Ex. 1 (LeMoult Decl.), ¶ 7. JTI USA does not presently and never previously maintained an office at this address. Ex. 11; Ex. 1 (LeMoult Decl.), ¶ 7. The

Dadeland address was once leased by another entity with the same ultimate parent as JTI USA, but even that entity vacated the property in 2008. Ex. 11; Ex. 1 (LeMoult Decl.), ¶ 7. Accordingly, the Dadeland address cannot be relied on to confer patent venue in Florida with respect to JTI USA.

iv. JTI USA Never Maintained an Office at the Brickell Key Address

The Complaint alleges that “[u]pon information and belief, . . . the address of [JTI USA’s] Title Director, Mr. John Colton, is located at 501 Brickell Key Drive in Miami, Florida.” ECF 1, ¶ 9. However, the Brickell Key address is not a “regular and established place of business” of JTI USA for purposes of § 1400(b).

A “regular and established place of business” for purposes of § 1400(b) requires more than simply “doing business” in the district. *Wilson v. McKinney Mfg. Co.*, 59 F.2d 332, 335 (9th Cir. 1932). The corporation must be “engaged in carrying on in a continuous manner a substantial part of its ordinary business” at a location for it to constitute a regular and established place of business. *Id.* (citations omitted); *see also IPCO Hosp. Supply Corp. (Whaledent Int’l Div.) v. Les Fils D’Auguste Maillefer S.A.*, 446 F. Supp. 206, 208 (S.D.N.Y. 1978) (“It must appear that a defendant is regularly engaged in carrying on a substantial part of its ordinary business on a permanent basis in a physical location within the district” (citation omitted)); *L.D. Schreiber Cheese Co. v. Clearfield Cheese Co.*, 495 F. Supp. 313, 317 (W.D. Pa. 1980) (“A regular and established place of business under 28 U.S.C. § 1400(b) has been described as a place where a party is ‘engaged in carrying on in [a] continuous manner a substantial part of its ordinary business.’” (citation omitted)). The Federal Circuit has required all three of the following to be met to show a “regular and established place of business”: (1) “a physical, geographical location in the district from which the business of the defendant is carried out”; (2) the activities at that location are not “sporadic”

and occurred “for a meaningful period of time”; and (3) the location is “of the defendant.” *In re Cray Inc.*, 871 F.3d 1355, 1360-64 (Fed. Cir. 2017). With respect to the third prong, “[r]elevant considerations include whether the defendant owns or leases the place, or exercises other attributes of possession or control over the place.” *Id.* at 1363.

Here, the Brickell Key address is leased to JTI s-Free USA Inc., not JTI USA (Exs. 12-20²; Ex. 1 (LeMoult Decl.), ¶ 8) and therefore not a place “of the defendant” JTI USA. *See In re Cray*, 871 F.3d at 1363. Further, JTI USA’s operations at the Brickell Key address are neither significant nor substantial in the context of JTI USA’s ordinary business. *See, e.g., Wilson*, 59 F.2d at 335. Presently, JTI USA has only one employee working at the Brickell Key address. Ex. 1 (LeMoult Decl.), ¶ 8. And she is on a temporary contract assignment, handling marketing and advertising responsibilities unrelated to the present litigation. *Id.* While JTI USA also previously had one of its appointed directors working there, he was an employee of JTI Holding. *Id.* ¶ 9.

These minimal activities are not enough to render the Brickell Key address a “regular and established place of business” under the applicable precedent. *See, e.g., Wilson*, 59 F.2d at 335. The present employee working out of the Brickell Key facility is on a temporary contract assignment ending in June 2023 such that her assignment is discontinuous in nature. Ex. 1 (LeMoult Decl.), ¶ 8. And the prior director was an employee of JTI Holding and is no longer working at the Brickell Key address. *Id.* ¶¶ 8-9; *see* Written Consent to Remove John Colton as Director of JTI USA, attached hereto as **Exhibit 21**. These minimal activities at this location are

² *See* Brickell Key Lease, attached hereto as **Exhibit 12**; 1st Amendment to Brickell Key Lease, attached hereto as **Exhibit 13**; 2nd Amendment to Brickell Key Lease, attached hereto as **Exhibit 14**; 3rd Amendment to Brickell Key Lease, attached hereto as **Exhibit 15**; 4th Amendment to Brickell Key Lease, attached hereto as **Exhibit 16**; Ex. E to 4th Amendment to Brickell Key Lease, attached hereto as **Exhibit 17**; 5th Amendment to Brickell Key Lease, attached hereto as **Exhibit 18**; Ex. E to 5th Amendment to Brickell Key Lease, attached hereto as **Exhibit 19**; Brickell Key Commencement Letter, attached hereto as **Exhibit 20**.

also a small fraction of JTI USA's operations as compared to those at its principal place of business in Teaneck, New Jersey. Ex. 1 (LeMoult Decl.), ¶ 5. Accordingly, the Brickell Key address is not a "regular and established place of business" of JTI USA for purposes of § 1400(b) and cannot confer patent venue on JTI USA in Florida. *See Wilson*, 59 F.2d at 335; *L.D. Schreiber*, 495 F. Supp. at 317.

B. If This Court Decides Not to Dismiss This Case, then § 1406(a) Mandates Transfer to the District of New Jersey

Pursuant to § 1406(a), when venue is improper, the Court "shall dismiss, or if it be in the interest of justice, transfer such case to any district or division in which it could have been brought." 28 U.S.C. § 1406(a). Since the Defendants are each incorporated in and, therefore, reside in, different states under prong 1 of the patent venue statute (Ex. 1 (LeMoult Decl.), ¶ 4, 5; Ex. 2 (Pshenitsyna Decl.), ¶ 4, 5), venue is proper as to both Defendants only where they each maintain a "regular and established place of business." *See* 28 U.S.C. § 1400(b). If the Court determines that the interests of justice in this case require transfer, Defendants respectfully request that the Court transfer this case to the District of New Jersey, where both Defendants maintain a "regular and established place of business" under prong 2 of the patent venue statute. *See id.*; Ex. 1 (LeMoult Decl.), ¶ 4, 5; Ex. 2 (Pshenitsyna Decl.), ¶ 4, 5.

V. CONCLUSION

For the foregoing reasons, Defendants respectfully request that this Court dismiss Plaintiff's Complaint or, in the alternative, transfer the case to the District of New Jersey.

Dated: December 15, 2022

Respectfully submitted,

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