

## THE REQUIREMENT OF MUTALITY IN PATENT CASES

### *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation,* 402 U.S. 313 (1971)

The University of Illinois Foundation brought a patent infringement suit against Blonder-Tongue Laboratories. The trial court's determination that the patent was valid and infringed was affirmed on appeal<sup>1</sup> despite a pre-existing invalidity ruling in a different circuit.<sup>2</sup> The Supreme Court granted certiorari<sup>3</sup> to resolve the conflicting validity determinations and to determine whether Blonder-Tongue should be able to plead the earlier ruling to estop plaintiff patentee.<sup>4</sup> *Held*: A defendant to a patent infringement suit may assert,<sup>5</sup> for collateral estoppel purposes, a prior invalidity ruling to which he was neither a party nor privy.

The public's desire for conclusiveness of litigation gave rise to various doctrines to serve that interest.<sup>6</sup> Res judicata is a judicially formulated defense<sup>7</sup> that provides claim conclusiveness to a final valid judgment.<sup>8</sup> The defense applies to all issues and other matters that were raised or

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1. *University of Illinois Foundation v. Blonder-Tongue Laboratories, Inc.*, 422 F.2d 769 (7th Cir. 1970).

2. *University of Illinois Foundation v. Winegard Co.*, 271 F. Supp. 412 (S.D. Iowa 1967), *aff'd*, 402 F.2d 125 (8th Cir. 1968).

3. *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*, 400 U.S. 864 (1970).

4. *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*, 402 U.S. 313, 317 (1971).

After granting certiorari, the Court requested the parties discuss whether a patent invalidity ruling should be permitted to be asserted as res judicata against the patentee by a defendant who was neither a party or privy to the invalidity ruling. This request put in issue the continued adherence to *Triplett v. Lowell*, 297 U.S. 638 (1936).

5. Res judicata and collateral estoppel are affirmative defenses that will be lost if not pleaded. FED. R. CIV. P. 8(c). The Court added that on remand Blonder-Tongue would be permitted to amend its answer to assert a plea of estoppel. 402 U.S. 313, 350 (1971).

6. Moschzisker, *Res Judicata*, 38 YALE L.J. 299 (1928).

7. The concept of conclusiveness of litigation dates back to Roman law, W. BUCKLAND, *TEXT-BOOK OF ROMAN LAW* 690-92 (1921). See also *Dutchess of Kingston's Case*, 3 Smith, Lead. Cas. 1998 (9th ed. 1776).

8. Vestal, *Preclusion Res Judicata Variables*, 50 IOWA L. REV. 27 (1964). Strictly speaking res judicata includes the doctrines of merger and bar. If a valid and final judgment for money is rendered in favor of the plaintiff, the cause of action is merged in the judgment and he can not thereafter maintain a second cause of action on the original cause. RESTATEMENT OF JUDGMENTS § 47 (1942). See generally 1B. J. MOORE & T. CURRIER, *MOORE'S FEDERAL PRACTICE* § 0.405[1] (2d ed. 1965) [hereinafter cited as 1B. J. MOORE].

Conversely if a valid and final in personam judgment on the merits is rendered for the defendant, the original cause of action is thereafter barred by judgment. RESTATEMENT OF JUDGMENTS § 48 (1942). See generally 1 B. J. MOORE § 0.405[1]; Note, *Developments in the Law Res Judicata*, 65 HARV. L. REV. 818 (1952).

could have been raised in a previous cause of action.<sup>9</sup> Collateral estoppel is an extension to the doctrine of *res judicata*.<sup>10</sup> Although collateral estoppel is also a defense of conclusiveness, it applies finality only to facts that were judicially determined and may be asserted as a defense in a different cause of action.<sup>11</sup> Besides providing finality to litigation, these doctrines also serve individual interests by providing protection from harassment.<sup>12</sup>

Traditionally, before a person could assert a defense of collateral estoppel he had to be a party<sup>13</sup> or privy<sup>14</sup> to the prior judicial proceedings. This prerequisite is known as the doctrine of mutuality.<sup>15</sup> It was adopted by the federal courts<sup>16</sup> and expressly applied to patent law in *Triplett v. Lowell*.<sup>17</sup>

To effectuate the expressed purposes of collateral estoppel, courts modified the requirement by permitting a defendant who lacked mutuality to assert the defense if his alleged liability was derived from one who had successfully defended on the merits.<sup>18</sup> This exception was justified

9. See generally 1B. J. MOORE § 0.405[1] and see note 11 *infra*.

10. Vestal, *supra* note 8.

11. 1B. J. MOORE § 0.405[1], [3]; *Cromwell v. County of Sac*, 94 U.S. 351, 352-53 (1877):

“. . . where the second action between the same parties is upon a different claim or demand, the judgment in the prior action operates as an estoppel only as to those matters in issue or points controverted, upon the determination of which the finding or verdict is rendered.”

12. Moschzisker, *Res Judicata*, 38 YALE L.J. 299 (1928).

13. RESTATEMENT OF JUDGMENT § 79 (1942).

14. *Id.* at § 83. To claim privity to a suit, one must have a mutual or successive relationship to the same right in property that was litigated in that suit. *Bigelow v. Old Dominion Copper Mining & Smelting Co.*, 223 U.S. 111, 128-29 (1911).

15. 1B. J. MOORE § 0.412.

16. *Id.*

17. 297 U.S. 638 (1936). “Neither reason nor authority supports the contention that an adjudication adverse to any or all the claims of a patent precludes another suit upon the same claims against a different defendant. While the earlier decision may by comity be given great weight in a later litigation and thus persuade the court to render a like decree, it is not *res judicata* and may not be pleaded as a defense.” 297 U.S. 638, 642 (1936). An identical view was adopted in the RESTATEMENT OF JUDGMENTS § 93 (1942). The principal case relied upon *Mast*, *Foos & Co. v. Stover Manufacturing Co.*, 177 U.S. 485 (1900), and *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30 (1929) as authority for denying *res judicata* in any case where the defendant lacked mutuality. 297 U.S. at 642. These cases are doubtful authority for that proposition. *Mast* concerned a validity ruling that had not been followed in a subsequent suit; *Winters* did not involve a patent’s validity, but whether a patent had been infringed. In addition *res judicata* was not asserted by either party in *Winters*, so the question of whether it would lie was not before the Court. *Nickerson v. Pep Boys-Manny, Moe & Jack*, 247 F. Supp. 221, 222 (D. Del. 1965).

18. A surety can assert *res judicata* if the debtor has been exonerated, *Lamb v. Wahlenmaier*, 144 Cal. 91, 77 P. 765 (1904); *Gill v. Morris*, 58 Tenn. 500 (1872); 35 GEO. WASH. L. REV. 1010, 1015; 57 HARV. L. REV. 98, 104-05 (1944). Whether the defense is available to indemnitors is not yet settled. See generally 1B. J. MOORE § 0.412[3].

on the grounds that it prevented a plaintiff from reopening a settled issue merely by switching defendants.<sup>19</sup> This exception was recognized in patent cases involving a manufacturer-customer relationship.<sup>20</sup>

In addition to these extensions, the soundness of the mutuality doctrine has long been questioned.<sup>21</sup> Under the pressure of heavy dockets, some state courts abandoned the mutuality requirement.<sup>22</sup> Following this lead many federal courts likewise abandoned the requirement.<sup>23</sup> This trend was particularly evident in cases involving a federal question.<sup>24</sup>

Although the mutuality doctrine has been eroded, limits remain on its outright rejection. Even courts that advocate the abrogation of mutuality maintain the requirement when rejection might result in injustice.<sup>25</sup> Basically the interests served by conclusiveness must be balanced against the time honored right of a party to have his day in court.<sup>26</sup>

Whether mutuality is required to sustain a plea of collateral estoppel

19. *Bernhard v. Bank of American Nat'l Trust and Sav. Ass'n*, 19 Cal.2d 807, 811, 122 P.2d 892, 895 (1942).

20. *General Chem. Co. v. Standard Wholesale Phosphate & Acid Works, Inc.*, 101 F.2d 178, 180 (4th Cir. 1939) (manufacturers likened to principals, their customers to sureties). The exception also covered exclusive sales agents. *Warren Featherbone Co. v. DeCamp*, 154 F. 198 (N.D. Ill. 1907). The argument advanced by the manufacturer was that his successful defense would be worthless if one who purchased the product could be sued. *Kessler v. Eldred*, 206 U.S. 285, 289 (1907). Manufacturers have also been allowed to intervene and assert *res judicata* in suits against their customers. *Stoehrer & Pratt Dodgem Corp. v. Glen Echo Park Co.*, 15 F.2d 558 (4th Cir. 1926); *Continuous Extracting Press Corp. v. Eastern Cotton Oil Co.*, 264 F. 340 (E.D.N.C. 1920).

21. *E.g.*, J. BENTHAM, 7 BENTHAM'S WORKS 171 (Bowring's ed. 1843). Bentham thought the mutuality doctrine was unreasonable and belonged on the gaming tables, not in courts of law. His sentiments were cited with approval in the principle case, 402 U.S. at 328-29, and *Bernhard v. Bank of America Nat'l Trust & Savings Ass'n*, 19 Cal. 2d 807, 812, 122 P.2d 892, 895 (1942).

22. The leading case is *Bernhard v. Bank of America Nat'l Trust & Savings Ass'n*, 19 Cal.2d 807, 122 P.2d 892 (1942). *See also Coca Cola Co. v. Pepsi Cola Co.*, 36 Del. 124, 172 A. 260 (1934); *Good Health Dairy Products Corp. v. Emery*, 275 N.Y. 14, 9 N.E.2d 758 (1937); *Jenkins v. Atlantic Coast Line*, 89 S.C. 408, 71 S.E. 1010 (1911).

23. *See, e.g.*, *United States v. United Airlines, Inc.*, 216 F. Supp. 709 (E.D. Wash. & D. Nev. 1962), *aff'd in part and rev'd in part on other grounds sub nom.*, *United Airlines, Inc. v. Wiener*, 335 F.2d 379 (9th Cir. 1964), *cert. denied*, 379 U.S. 951 (1964); *Technograph Printed Circuits Ltd. v. Packard Bell Electronics Corp.*, 290 F. Supp. 308 (C.D. Cal. 1968); *Maryland v. Capital Airlines, Inc.*, 267 F. Supp. 298 (D. Md. 1967).

In diversity jurisdiction cases, federal courts apply the mutuality rule of the forum state. When federal questions are involved the courts apply their own rules of *res judicata*. *Heiser v. Woodruff*, 327 U.S. 726, 733 (1946). *See* 402 U.S. at 325-26 n. 13; 1B J. MOORE 1806 (Supp. 1970).

24. *See, e.g.*, *United Banana Co. v. United Fruit Co.*, 172 F. Supp. 580, 588 (D. Conn. 1959). *See also* 402 U.S. at 324 n. 12.

25. *Evans and Robins, The Demise of Mutuality in Collateral Estoppel (the Second Round Patent Suit—the Not-so-Instant Replay)*, 24 OKLA. L. REV. 179, 188 (1971).

26. *Hansberry v. Lee*, 311 U.S. 32, 40 (1940).

is now sometimes determined by an accommodation of the various competing interests. As the Fifth Circuit in *Rachal v. Hill*<sup>27</sup> stated:

“While the requirement of mutuality need no longer be met, the doctrine of collateral estoppel will not be applied unless it appears that the party against whom the estoppel is asserted had a full and fair opportunity to litigate the issue in a prior proceeding and that application of the doctrine will not result in an injustice . . .”<sup>28</sup>

Despite its adoption in other areas this “fairness” test was not extended to the field of patent law.<sup>29</sup> Courts generally adhered to the *Triplett* mandate, and only one court flatly rejected the mutuality requirement in a patent infringement case.<sup>30</sup>

In the principal case the Court considered the continuing utility of the mutuality rule as laid down by *Triplett*. The specific question was similar to the *Rachal* test: whether an unsuccessful patentee who has been provided “a fair opportunity procedurally, substantively and evidentially to pursue his validity claim”<sup>31</sup> should be given a second chance.

The reexamination of *Triplett* was prompted by two considerations. First was the problem of crowded dockets. This condition could be somewhat relieved by extending the preclusive defenses to more defendants. Secondly was the special public interest in protecting patents. These considerations necessitated an evaluation of the mutuality requirement as it pertained to patent law.<sup>32</sup> The critical injury then was whether the defenses could be extended without sacrificing fairness.<sup>33</sup>

These considerations were approached from three standpoints: the peculiarities of patent litigation that militated against abandoning the mutuality requirement; the economic consequences of *Triplett*; and the burden on the courts that resulted from following *Triplett*. Basically, the special problems of patent litigation were juxtaposed with the costs of continued adherence to the mutuality doctrine.<sup>34</sup>

Two arguments had traditionally been posited to preclude abrogating mutuality in patent cases. First, patents are impliedly sanctioned by the

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27. 435 F.2d 59 (5th Cir. 1970).

28. *Id.* at 62.

29. *E.g.*, *Bettis Rubber Co. v. Kleaver*, 104 Cal. App. 2d 821, 233 P.2d 82 (1951) (the California court followed *Triplett* despite the abandonment of mutuality in *Bernhard*).

30. *Nickerson v. Pep Boys-Manny, Moe & Jack*, 247 F. Supp. 221 (D. Del. 1965).

31. 402 U.S. at 333 *citing* *Eisel v. Columbia Parking Co.*, 181 F. Supp. 298, 301 (D.C. Mass. 1960).

32. *Id.* at 328.

33. *Id.* at 329.

34. *Id.* at 330.

United States Constitution.<sup>35</sup> This sanction has given rise to a legislative presumption of validity to all patents.<sup>36</sup> Second is the complexity of patent litigation.<sup>37</sup> A consideration of these factors can lead to the conclusion that the public interest in patents should be protected from unsound adjudication. Obviously relitigation cannot be allowed against the same defendant. However, the adverse effects of such a decision can be limited if a patentee could sue any other infringer.

The Court rejected these arguments by asserting that *some* issues in patent cases are not so difficult as to warrant reconsideration. These issues can be considered conclusive.<sup>38</sup> Furthermore the economic and judicial costs of continued adherence to *Triplett* warrants some relaxation of the mutuality requirement.<sup>39</sup>

35. U.S. CONST. art. I, § 8.

36. "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on the party asserting it." 35 U.S.C. § 282 (Supp. 1968). Legislation providing an in rem effect to a patent invalidity ruling has been considered but not adopted by Congress. This legislation would not have effected the presumptive validity that initially attached to a patent, but once the patent has been ruled invalid the presumption would have dissolved. S. 1042, 90th Cong., 1st Sess. § 294 (1967).

37. In Learned Hand's opinion, "If there be an issue more troublesome . . . than . . . [validity of patents], we are not aware of it." *Harris v. Air King Products Co.*, 183 F.2d 158, 162 (2d Cir. 1950).

38. Initially the Court recognized other areas of the law were just as complex as patent case, e.g., negligence and scienter, 402 U.S. at 331. In addition, even conceding that patent cases were difficult, a second litigation would not provide any assurance of increased accuracy. *Id. But cf. Triplett v. Lowell*, 297 U.S. 638, 644 (1936), where the Court mentioned that the existence of conflicting decisions was a persuasive factor in their granting certiorari and thus review of the invalidity ruling. See also Rollins, *In Rem Invalidity: A Solution In Search of a Problem?*, 52 J. PAT. OFF. SOC'Y 561, 574 (1970). 402 U.S. at 332. "In any event it can not be sensibly contended that all issues concerning patent validity are so complex and unyielding." Conceding that patent validity questions are exceedingly intricate, the Court noted that a plaintiff-patentee could choose the time and court in which to litigate his claim. Thus he has ample opportunity to prepare his case. In some cases a patentee would also be able to choose his opponent. Rollins, *supra* note 40, at 564. *But see Vermont Structural Slate Co. v. Tatko Bros. Slate Co.*, 134 F. Supp. 4 (N.D.N.Y. 1955), *aff'd* 233 F.2d 9 (2d Cir.), *cert. denied*, 352 U.S. 917 (1956) (patentee defended claim in declaratory judgment action).

39. There are two aspects to the question of economic costs. First is the cost of relitigating a patent invalidity ruling. There was ample evidence that the cost to both parties is considerable. The Court felt that such expenditures are wasteful, 402 U.S. at 338. The Court, quoting Judge Frank, said the expense of a patent litigation suit was staggering. *Id.* at 334. In addition there was evidence from Congressional hearings that the approximate cost of a patent infringement suit was \$50,000. 402 U.S. at 335; Rollins, *supra* note 38, at 562-63.

The second aspect of the economic costs question stems from a patent's presumptive validity. This presumption remains despite a court ruling of invalidity. 402 U.S. at 338. *But see Gold Seal Importers, Inc. v. Westerman-Rosenberg, Inc.*, 133 F.2d 192 (2d Cir. 1943) (when issues before a District Court are the same as those that were decided by the Circuit Court for that district, then the Circuit Court's ruling is conclusive unless patentee offers new evidence). Faced with such a

To insure that a patentee has been given a fair opportunity to litigate his patent, the Court suggested certain claims he might assert to avoid the conclusiveness of an invalidity ruling, *e.g.*, choice of forum, incentive to litigate and standard for obviousness.<sup>40</sup>

Basically, therefore, the Court refused to recognize any overriding interests so unique to patent law as to outweigh the adverse effects of further adherence to *Triplett*. It seems futile to analyze this conclusion since it fundamentally depends on the relative weights one believes should be given each conflicting interest. Moreover, even though some may disagree as to the appropriate weights, it can not be said the Court is clearly wrong. A more useful analysis is directed toward the scope of the decision and its importance to future cases.

The *Blonder-Tongue* opinion was narrowly drawn. The holding pertained only to patent law.<sup>41</sup> Furthermore, its ambits were not extended into "due process" or "offensive use" questions.<sup>42</sup> Nevertheless the decision raised problems in each of these areas.

By limiting the application of its decision to patent litigation, the Court left unanswered the question of whether mutuality will be retained

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presumption and the high costs of patent litigation, a businessman might choose to seek a license rather than go to trial. 402 U.S. at 338-42. The court branded such settlements an anomaly within our economic system. *Id.* at 343. The Court noted that a patent is a monopoly, and must be closely scrutinized. *Cf.* *Royal Typewriter Co. v. Remington Rand, Inc.*, 168 F.2d 691 (2d Cir.), *cert. denied*, 335 U.S. 825 (1948); *Cover v. Schwartz*, 133 F.2d 541, 544-45 (2nd Cir. 1942). Furthermore the costs of these settlements are passed on to the consumer. 402 U.S. at 346.

In addition the Court did not think the expenses of determining the fairness of a prior validity ruling were comparable to those of an infringement suit. *Id.* at 344-46. Thus, businessmen would be less apt to be intimidated if they knew they could rely on the first judgment. In comparison, the existing scheme provided encouragement only to those who could initially afford the expense of a patent suit. The Court examined 35 U.S.C. § 285 (1952), which permits a court to award attorney's fees, and 35 U.S.C. § 288 (1952), which penalizes patentees who fail to make disclaimers, and concluded that "neither of these provisions can operate until after litigation has occurred, and the outlay required to try a lawsuit presenting validity issues is the factor which undoubtedly forces many alleged infringers into accepting licenses rather than litigating." *Id.* at 347-48.

Another cost of adhering to *Triplett* is the burden on the judiciary. Despite the relatively small amount of time devoted to patent relitigations, the Court applied an absolute standard—some time will be saved by precluding relitigation. *Id.* at 348.

40. The Court posited the issue as whether the patentee had a full and fair opportunity to litigate his claim. "Choice of forum" and "incentive to litigate" were given as examples of the types of considerations trial courts should employ to determine whether a patentee had such an opportunity. "Obviousness" claims would present unique problems to the second tribunal for it would have to consider whether the proper standard had been employed in finding the patent void for obviousness, whether the first court had been able to fathom the difficult subject matter involved in those claims, and whether the patentee had been deprived of crucial evidence or witnesses, and if so whether the deprivations were the patentee's own fault. 402 U.S. at 332-34.

41. *Id.* at 329.

42. *Id.* at 329-30.

in other areas of the law. *Blonder-Tongue* can be read as a general indictment of the mutuality requirement. The mutuality requirement would probably have not been rejected in patent law if the removal of mutuality in other areas of law had lead to undesirable results.<sup>43</sup> On the other hand, *Blonder-Tongue* also requires a case by case determination.<sup>44</sup> The holding is clearly not an absolute rejection of mutuality.

The Court also avoided the "due process" question. Basically, due process prevents a litigant who never appeared in a prior action from being estopped without litigating the issue.<sup>45</sup> However, other due process questions are also involved. The first question concerns what a patentee must prove to avoid the preclusive effect of the earlier ruling.<sup>46</sup> The second question involves the extent to which preclusion is available. The Court stated that, as long as the basic due process limitation is met, when identical issues are raised, a prior invalidity ruling may be asserted as conclusive.<sup>47</sup> The determination of whether issues are identical was left to the trial courts.

Finally, the holding in *Blonder-Tongue* was limited to allowing only a defensive use of an invalidity ruling.<sup>48</sup> Collateral estoppel will usually be pleaded as a defense to an infringement claim. The holding leaves unanswered the extent to which a prior ruling of invalidity may be pleaded offensively against a patentee defendant. Given the apparent adoption of the "fairness" test espoused in *Rachal v. Hill*, an offensive use of a prior invalidity ruling would seem warranted in appropriate circumstances.<sup>49</sup>

43. The Court noted that the recent development in the doctrine of res judicata had "enhance[d] the capabilities of the courts to deal with some issues swiftly but fairly." *Id.* at 327. It was also noted that the lower courts had handled with considerable skill the problem of when to allow a party who lacked mutuality to assert res judicata. *Id.* at 349.

44. *Id.* at 331.

45. *Id.* at 329.

46. The Court noted this difficulty and then relegated the solution to the lower courts. "In the end, decision will necessarily rest on the trial court's sense of justice and equity." *Id.* at 334.

47. Identity of issue has been retained as a prerequisite for asserting res judicata by those courts that have abandoned the mutuality requirement. *Bernhard v. Bank of America Nat'l Trust & Sav. Ass'n*, 19 Cal.2d 807, 813, 122 P.2d 892, 895 (1942).

48. 402 U.S. at 330.

49. Offensive use questions center on the considerations of allowing a plaintiff in a second suit to assert a judgment obtained by a different plaintiff in a prior suit against the same defendant. *Id.* Although different policies are involved than in a defensive use situation (see *Evans & Robins supra* note 25, at 188-90), some courts have allowed an offensive use when the defendant clearly had an opportunity to litigate fully the issue in the prior proceedings; see, e.g., *United States v. United Airlines, Inc.*, 216 F. Supp. 709 (E.D. Wash. & D. Nev. 1962), *aff'd in part and rev'd in part on other grounds sub nom. United Airlines, Inc. v. Wiener*, 335 F.2d 379, 404 (9th Cir.), *cert. denied*, 379 U.S. 951 (1964).

Three problems that the Court did not even mention in *Blonder-Tongue* are particularly troublesome: First, if a ruling of validity is followed by an invalidity ruling in a second suit, is the second determination controlling? Second, if an infringement claim is rejected for non-infringement, would an additional ground of invalidity be considered holding, or merely dictum, for the purposes of collateral estoppel? Lastly does the new rule apply to a non-infringement ruling?

These questions are partially dependent on the ultimate scope given the *Blonder-Tongue* decision. Some commentators have interpreted it as giving an invalidity ruling an in rem effect.<sup>50</sup> This interpretation seems unfounded. A clear difference exists between a prior ruling being conclusive between appropriate litigants and being conclusive against the world. The court in *Blonder-Tongue* clearly recognized this difference and refused to adopt that approach.<sup>51</sup> The "fairness" test, therefore, would seem to govern what effect prior invalidity rulings will be given outside an infringement context as well as the scope of other rulings in patent cases.<sup>52</sup>

The Court in *Blonder-Tongue* brought patent law in phase with other areas of law as regards res judicata, collateral estoppel and mutuality. Although the holding presents many new problems, there are established guidelines to their solution.<sup>53</sup>

The Court decided that no overriding policies warranted treating patent cases differently from other federal questions. Instead, it seems to have adopted the "fairness" test of *Rachal v. Hill*. This test may result in inconsistent applications of the *Blonder-Tongue* decision. Consistency of application, however, should not be the standard to measure *Blonder-Tongue's* success. Rather, the proper standard should be the extent that it eliminates unnecessary patent litigation in federal courts.

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50. Chisum, *The Allocation of Jurisdiction Between State and Federal Courts in Patent Litigation*, 46 WASH. L. REV. 633, 664 (1971).

51. "[W]e do not suggest, without legislative guidance, that a plea of estoppel by an infringement or royalty suit defendant must automatically be accepted [provided the issues are identical]" 402 U.S. at 332-33. The phrase "without legislative guidance" is particularly important. The Court specifically noted an attempt in 1967 to amend the patent laws to provide for an in rem determination of validity. The bills died in committee. *Id.* at 340-42 nn. 34-37. See also note 36 *supra*.

52. The Court specifically referenced royalty suits, 402 U.S. at 333.

53. See note 52 *supra*.