

ASSERTING FOREIGN PATENT CLAIMS IN U.S. FEDERAL COURTS: WHAT'S LEFT AFTER *VODA V. CORDIS*?

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Patent law is inherently territorial; a patent covers infringing activity only within the borders of the nation in which it is granted. However, this makes enforcing patent rights worldwide a daunting challenge. Rather than recklessly extending the extraterritorial reach of U.S. patent law, a better alternative would be to assert claims for infringement of multiple foreign patents in a single, U.S. forum.

This paper focuses on the new barriers raised to the prospects for such consolidated, multinational patent infringement proceedings by *Voda v. Cordis*, decided by the Federal Circuit in February of 2007. *Voda* held that federal supplemental jurisdiction should almost never exist over foreign patent claims due to “discretionary” considerations of comity, fairness, judicial economy, and convenience. The paper analyzes *Voda*’s erroneous statutory construction of the federal supplemental jurisdiction statute, 28 U.S.C. § 1367, which arguably confuses the question of whether there is jurisdiction with the propriety of exercising it. It then explores the limited implications of the decision in light of the availability of federal diversity jurisdiction as an alternative to supplemental jurisdiction. More importantly, this paper also provides a comprehensive response to *Voda*’s ill-informed and narrow treatment of § 1367(c)’s discretionary considerations. First, considerations of international comity may in some situations demand adjudication of foreign patent claims—particularly when the needs of the international system and the

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need to do justice to individual parties are taken into account. Second, since the central obstacle to asserting a foreign patent claim in a U.S. court is the difficulty of adjudicating foreign patent validity, and nothing more, an “inter partes” approach to validity provides an adequate workaround to fairness and Act of State concerns.

Rather than waging a losing battle to exclude foreign patent claims from the federal courts, the Federal Circuit would be better off creating guidelines for when foreign patent claims may be properly asserted. Towards this end, this paper situates Voda within the worldwide debate on consolidated patent infringement, and attempts to provide preliminary suggestions for further inquiry—though a comprehensive examination of such guidelines is beyond its scope.

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INTRODUCTION

In today's world, international commerce has become the norm, not the exception. As globalization lowers the barriers among economic markets and technology continues to make worldwide transfer of information and goods easier than ever, it is imperative that intellectual property protection keep up with these changing trends in commerce.¹ Unfortunately, the patchwork of nationally-based patent laws that protect technological invention in various countries around the world is not up to that task.

Why? Because the biggest challenge to the effectiveness of international patent rights is not just procuring those rights, but effectively enforcing them on a worldwide scale.² Even though international and regional patent treaties, such as the Patent Cooperation Treaty and the European Patent Convention, have made it easier to *obtain* multiple patents abroad for a single invention³, a patent owner must still sue separately in different countries to enforce his rights—a frustratingly inefficient, costly, and piecemeal process.⁴ This is true even if the same invention,

¹ See Donald S. Chisum, *Normative and Empirical Territoriality: Lessons from Patent Law*, 37 VA. J. INT'L L. 603, 616 (1997) (“[T]he increasing interdependence of the global economy and the growing concern over the cost of multinational intellectual property rights procurement and enforcement—will make territorialism an unacceptable obstacle to international trade.”); see also Fritz Blumer, *Jurisdiction and Recognition in Transatlantic Patent Litigation*, 9 TEX. INTELL. PROP. L.J. 329, 332 (2001); Curtis A. Bradley, *Territorial Intellectual Property Rights in an Age of Globalism*, 37 VA. J. INT'L L. 505, 584 (1997).

² See Mark A. Lemley ET AL., *Divided Infringement Claims*, 33 AIPLA Q.J. 255, 283 (2005) (“[T]he international problem of distributed patent claims . . . cannot be solved by simply prosecuting patents in multiple countries. Further, in an ideal world patent law would be fully harmonized and indeed international, not territorial, in nature.”).

³ Patent Cooperation Treaty pmbl., June 19, 1970, 28 U.S.T. 7645; Convention on the Grant of European Patents (European Patent Convention) art. 3, Oct. 5, 1973.

⁴ Harold C. Wegner, *Voda v. Cordis: Trans-Border Patent Enforcement* 2–3, 8 (Nov. 17, 2005) (unpublished manuscript, on file with the Albany Law Journal of Science and Technology), available at http://www.foley.com/files/tbl_s31Publications/FileUpload137/2989/voda_Texas_Paper.pdf (“[T]he unscrupulous defendant who is sued in one country merely needs to pack up his operation, move across the border to another country, and then continue to exploit the intellectual property right with impunity in that country and others where there is no effective intellectual property

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the same disclosure, and similar behavior by the same or related defendants are at issue in every country.

Given that worldwide enforcement does not follow from worldwide rights, how can patent rights be effectively asserted on a worldwide scale? Two alternatives spring to mind. The first option is to increase the scope and reach of national patent law itself over foreign infringement. Arguably, the U.S. has already begun to do this in § 271(f) and § 271(g) of the Patent Act⁵, as well as through decisions like *NTP, Inc. v. Research in Motion, Ltd.*⁶, *Eolas v. Microsoft*, and *AT&T v. Microsoft*.⁷ However, this

enforcement.”). While the Patent Cooperation Treaty and regional agreements, such as the European Patent Convention, allow inventors to *obtain* patents in various countries on a single invention based on a single, original filing, they provide no guidance for unified *enforcement* of those patents; as the Federal Circuit’s Judge Newman has observed, “it was perhaps premature to hope that coordinated patent filing would eventually lead to coordinated patent enforcement.” Hon. Pauline Newman, *On Global Patent Cooperation*, 8 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 3, 8 (1997).

⁵ 35 U.S.C. § 271(f) (2000) (creating liability under certain conditions for those who export “components” of a patented invention with the intent of assembling them outside of the United States); *id.* § 271(g) (creating liability for those who import into the United States products made abroad by a process patented in the United States). Thus, § 271(f) and § 271(g) effectively create liability for overseas conduct that would not otherwise infringe U.S. patents. Indeed, Congress passed § 271(f) specifically to reverse the result of the Supreme Court’s territorial approach in *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518, 527, 531 (1972). See Patent Law Amendments Act of 1984, Pub. L. No. 98-622, 98 Stat. 3383 (1984).

⁶ For example, in the *NTP, Inc. v. Research In Motion, Ltd.* (“RIM”) case, the Federal Circuit held that RIM’s Blackberry network infringed on NTP’s patent even though a crucial step in the Blackberry system involved relaying all its network traffic through a facility in Canada. See generally *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282 (Fed. Cir. 2005). Though not all claimed steps in NTP’s patent were literally performed in the U.S., the Federal Circuit adopted a test which effectively determined that the system was being used in the United States, resulting in liability under U.S. patent law. *Id.* at 1317 (“The use of a claimed system under section 271(a) is the place at which the system as a whole is put into service, *i.e.*, the place where control of the system is exercised and beneficial use of the system obtained.”). The *RIM* case raised sufficient concern for Canada to file a cautious, but concerned, *amicus* brief in that case. See Brief for Amicus Curiae the Government of Canada in Support of the Petition of Research in Motion, Ltd. for Rehearing en Banc at 2, *NTP, Inc.*, 418 F.3d 1282 (No. 03-1615), 2005 WL 4798095 [hereinafter Canada RIM En Banc Amicus Brief] (“Canada also believes that this decision, as it relates to the interpretation and scope of 35 U.S.C. § 271(a), is susceptible of interpretations that may have unfortunate and unintended consequences, affecting Canada’s interests, as well as the interests of Canadian companies carrying on multi-jurisdictional operations.”).

⁷ Similarly, in *Eolas Techs. Inc. and AT&T Corp.*, the Federal Circuit expanded the reach of 35 U.S.C. § 271(f) to include the exportation of intangible

option effectively involves policing behavior that occurs abroad.⁸ This may potentially cause conflict with the laws of other nations and disregards notions of international comity and the norm of territoriality inherent in patent law,⁹ possibly to the detriment of U.S. interests.¹⁰

The second, and preferable option, would be to consolidate claims of infringement arising in multiple countries. This paper argues that consolidated, multinational patent infringement proceedings are not only possible in U.S. district courts, but desirable. Unfortunately, this course of action has been made more difficult by a recent case decided by the Federal Circuit: *Voda v. Cordis*.¹¹ *Voda* involved a plaintiff who attempted to assert American, British, Canadian, French, and German patents, all of which covered the same invention and arose from a related disclosure filing, in a single proceeding against infringers that were related corporate entities.¹² But the Federal Circuit turned him away, holding that the federal district court did not have (and, indeed, should almost never have) supplemental subject matter jurisdiction under 28 U.S.C. §1367 to hear foreign patent claims.¹³

For reasons that will be explained in this paper, *Voda v. Cordis* is based upon an erroneous statutory interpretation of § 1367(c), and its concerns about comity, national patent policy, fairness, and the Act of State doctrine are misguided. Contrary to the majority's reasoning in *Voda*, treating claims for the infringement of foreign patents as "transitory" causes of action

software. *AT&T Corp. v. Microsoft Corp.*, 414 F.3d 1366, 1371 (Fed. Cir. 2005); *Eolas Techs. Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1341 (Fed. Cir. 2005).

⁸ See 35 U.S.C. § 271(f), (g) (codifying liability for export or import of patented goods in such a manner that will cause patent infringement).

⁹ See generally Katherine White, *The Recent Expansion of Extraterritoriality in Patent Infringement Cases*, 2007 UCLA J.L. & TECH. 2 (2007).

¹⁰ See Harold C. Wegner, *A Foreign Square Peg in a Domestic Round Hole: The Eolas-AT&T-Carbide Trilogy*, IPFRONTLINE, July 18, 2006, <http://www.ipfrontline.com/downloads/GeorgeMasonWegner.pdf> (arguing that the "asymmetry" of extraterritorial patent protection effectively forces U.S. research & development offshore and is bad public policy).

¹¹ See *Voda v. Cordis Corp.*, 476 F.3d 887, 904 (Fed. Cir. 2007) (declining to exercise supplemental jurisdiction).

¹² *Id.* at 910–11 (Newman, J. dissenting); Reply Brief for Defendant-Appellant at 1–2, *Voda*, 476 F.3d 887 (No. 05-1238), 2005 WL 2174498; see also Posting of Dennis Crouch to Patently-O Patent Law blog, *Voda v. Cordis: Plaintiff May Not Assert Foreign Patents in US Courts*, http://www.patentlyo.com/patent/2007/02/voda_v_cordis_p.html (Feb. 2, 2007).

¹³ *Voda*, 476 F.3d at 904.

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that may be heard in U.S. courts violates neither patent law's territoriality principle nor principles of international comity or sovereignty. Indeed, the doctrine of international comity, as espoused by theorists of international law, may actually argue *for* asserting such jurisdiction. There is no good reason not to entertain actions for the *infringement* of foreign patents under certain, controlled circumstances (i.e. avoiding findings of formal invalidity), especially when doing so results in more efficient and fair dispute resolution.

If the Federal Circuit was seeking to prevent the assertion of foreign patent claims entirely, then it did not succeed.¹⁴ *Voda* made it much more difficult to assert supplemental jurisdiction over foreign patents.¹⁵ However, *diversity* jurisdiction, as well as the possibility of bringing foreign patent claims in *state* courts, still remains a viable option to the adventurous plaintiff holding patents in multiple countries.¹⁶ Rather than effectively cutting off one, but not all, means by which foreign patents claims may be asserted in American courts, the Federal Circuit would have been better served by providing guidance to district courts as to when assuming jurisdiction over foreign patents would be appropriate.¹⁷

This paper is organized as follows. Section I is an overview of territoriality and transitory causes of action in the intellectual property infringement context, including the thorny issue of adjudicating patent validity. Section II lays out two competing cases that, prior to *Voda*, defined the battle over § 1367 supplemental jurisdiction for foreign patent claims. Section III examines *Voda* in detail, including the arguments made before the court and the reasoning of the majority and dissenting opinions. Section IV then analyzes three aspects of the *Voda* case: the Federal Circuit's motivations in deciding it, the strength of its comity, fairness, and Act of State arguments, and

¹⁴ See Brief for Amici Curiae Law Professors in Support of the Appellee at 6–7, *Voda*, 476 F.3d 887 (No. 05-1238), 2005 WL 2156900 [hereinafter Professors Amicus Brief] (stating that although supplemental jurisdiction may not be satisfied, U.S. federal courts may hear foreign patent infringement claims under diversity jurisdiction).

¹⁵ See *Voda*, 476 F.3d at 898, 904 (setting out considerations that may prohibit exercising supplemental in this instance).

¹⁶ See Professors Amicus Brief, *supra* note 14, at 6–7.

¹⁷ See *id.* at 3–4, 8; see also John R. Thomas, *Litigation Beyond the Technological Frontier: Comparative Approaches to Multinational Patent Enforcement*, 27 L. & POL'Y INT'L BUS. 277, at 346–48, 350–51 (1996).

the possible courses of action after *Voda*. Finally, Section V examines the broader issues of enforcement, remedies, and ultimate goals that must be considered in any push to make consolidated multinational patent infringement proceedings a reality in U.S. courts.

I. TERRITORIALITY AND TRANSITORY CLAIMS

Patent law, like the rest of intellectual property law, is inherently territorial. It is widely accepted that a patent granted by one nation covers infringing activity only within that nation's borders, and should generally not apply to activity outside its borders.¹⁸ Furthermore, unlike grants of copyright, the patent right granted in any one country does not automatically confer rights anywhere else.¹⁹ This situation is at least partly due to necessity: substantive standards of patent law still vary significantly from country to country,²⁰ even though the differences have narrowed significantly due to the 1994 passage of the TRIPs Agreement.²¹

¹⁸ See, e.g., *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518, 527 (1972), *superseded by statute*, Patent Law Amendments Act of 1984, Pub. L. No. 98-622, 98 Stat. 3383 (“[I]t is not an infringement to make or use a [U.S.] patented product outside of the United States.”); Harold G. Maier, *Extraterritorial Jurisdiction at a Crossroads: An Intersection Between Public and Private International Law*, 76 AM. J. INT’L L. 280, 282 (1982) (discussing the origin of the territoriality principle in the writings of seventeenth century Dutch legal scholar Ulrich Huber).

¹⁹ Compare Berne Convention for the Protection of Literary and Artistic Works art. 5, *available at* <http://www.law.cornell.edu/treaties/berne/overview.html> (granting rights “in [all other] countries of the [Berne] Union other than the country of origin” and mandating that those rights “shall not be subject to any formality”), with Paris Convention for the Protection of Industrial Property art. 4bis, Sept. 28, 1979, 21 U.S.T. 1583 [hereinafter Paris Convention], *available at* http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html (mandating that where multiple patents are obtained in different Paris countries for the same convention, those patents must be independent of each other, “both as regards the grounds for nullity and forfeiture, and as regards their normal duration”).

²⁰ See Thomas, *supra* note 17, at 282–88 (comparing the U.S., European, and Japanese patent systems in areas such as novelty, nonobviousness/inventive step, first-to-file/first-to-invent considerations, and the doctrine of equivalents, and concluding that “differences persist” but also “to an increasing extent, the world’s patent laws demonstrate similarity to the point of identity”).

²¹ See Agreement on Trade-Related Aspects of Intellectual Property Rights arts. 27–34, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments—Results of the Uruguay Round, 33 I.L.M. 1125 (1994) [hereinafter *TRIPs*], *available at* http://www.wto.org/english/docs_e/legal_e/27-trips.pdf (embodying substantive

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Clearly, even though territoriality²² precludes the application of U.S. patent law to cover behavior that would infringe a U.S. patent when that behavior occurs solely in Germany, for example, it does not answer the question whether a U.S. court can apply *German* patent law to determine whether a German patent is infringed in Germany. In the abstract, the answer appears to be yes. Claims of patent infringement should, in theory, be considered “transitory” causes of action that can be heard in a forum other than the one in which they arise.²³ It is well established that actions for tort, i.e., for damage against the body or against personal property, are transitory, not local,²⁴ and that patent infringement is generally considered a species of tort.²⁵ Courts have also established that other kinds of intellectual property infringement, namely copyright claims, are transitory in nature.²⁶ For example, in the *London Film* case, a British plaintiff sued a New York defendant in New York district court for behavior in Chile and other South American countries which violated the plaintiff’s *Chilean* and other South American copyrights, even though plaintiff’s U.S. copyright had lapsed into the public domain.²⁷

However, the question is not whether foreign patents may be asserted in the abstract. There is one big reason that courts tend

minimum standards for, among other things, the scope of patentable subject matter and of rights held by the patent owner). This was a vast improvement over the Paris Convention, which did not require such minimum standards with regard to substantive rights, and which did not even require adherents to have a patent system. See Paris Convention, *supra* note 19, at 4–5.

²² BLACK’S LAW DICTIONARY 1512 (8th ed. 2004) (“[Territoriality is] [t]he principle that a nation has the right of sovereignty within its borders.”).

²³ See *Ortman v. Stanray Corp.*, 371 F.2d 154, 159 (7th Cir. 1967) (Fairchild, J., concurring) (discussing the possibility that foreign patent infringement should be considered a transitory claim and the circumstances in which such a claim should *not* be asserted); 20 AM. JUR. 2D *Courts* § 81 (2007) (discussing the distinction between transitory and local actions generally).

²⁴ 21 C.J.S. *Courts* § 29 (2007) (“Where a cause of action can arise in one place only, [it] is local, but if the cause of action is one which might arise anywhere, the action is transitory.” Actions on contract, for tort, and relating to personal property are, “as a [general] rule, transitory.”); 92A C.J.S. *Venue* § 19 (2007) (“It is the general rule that, in the absence of statutory provisions to other effect, tort actions generally, and more specifically, actions for injuries to the person or to personal property, are transitory” (citations omitted)).

²⁵ See *Ortman*, 371 F.2d at 159 (Fairchild, J., concurring) (“An action for infringement of a patent is classified by American courts as a tort.”).

²⁶ *London Film Prods. Ltd. v. Intercontinental Commc’ns, Inc.*, 580 F. Supp. 47, 49 (S.D.N.Y. 1984) (involving transitory copyright claim).

²⁷ *Id.* at 48 (observing that “[t]here seems to be no dispute that plaintiff has stated a valid cause of action under the copyright laws of a foreign country”).

to treat foreign infringement claims differently than other transitory foreign claims—and it is because considerations of *validity* of the patent, naturally and frequently accompany claims of infringement.²⁸ The ability to raise invalidity of a patent, trademark, or (theoretically) copyright as a defense often takes center stage in U.S. intellectual property litigation; and once a right is held invalid, it cannot be asserted against anyone else.²⁹ But what happens when the grant of right being invalidated is not a U.S. patent, but a German one?³⁰

The *Vanity Fair* case was the first to address the problem of validity of a foreign intellectually property right.³¹ As every court that has followed it has done, the Second Circuit panel in *Vanity Fair* framed its objection in terms of the judicial Act of State doctrine;³² that adjudicating the validity of the Canadian trademark, a property right granted by the Canadian government, would be akin to passing judgment on the “validity of the acts of a foreign sovereign done within its borders.”³³ The

²⁸ See *Blonder-Tongue Labs., Inc. v. Univ. of Ill. Found.*, 402 U.S. 313, 317, 350 (1971) (illustrating the question of the patent’s validity being considered under a patent infringement claim, despite being found invalid in another jurisdiction).

²⁹ In the patent context, the *Blonder-Tongue* case imposed non-mutual collateral estoppel as a barrier to a plaintiff’s ability to bring a claim based on a patent that has previously been adjudicated invalid in another proceeding. *Id.* at 327, 350.

³⁰ The problem of adjudicating invalidity may be compounded because many fora, including Germany, require all questions of patent validity to be heard administratively before their patent offices, and bar those questions from being raised in litigation. See generally Brief of Intellectual Property Owners Association as Amicus Curiae in Support of Appellant, *Voda v. Cordis Corp.*, 476 F.3d 887 (Fed. Cir. 2007) (No. 05-1238), 2005 WL 1649345 [hereinafter IPOA Amicus Brief]. The IPOA Amicus Brief in *Voda* also observes that many fora, including Germany and Japan, utilize their administrative patent agencies to provide advisory opinions on the scope and construction of patents. *Id.* at 13–14.

³¹ See *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 234 F.2d 633, 636, 647 (2d Cir. 1956) (addressing the “novel question[]” of a foreign trademark claim).

³² See *id.* at 646. The judge-made Act of State doctrine dictates that U.S. federal courts “will not sit in judgment on the acts of the government of another [country], done within its own territory.” *Underhill v. Hernandez*, 168 U.S. 250, 252 (1897). See generally Peter Nicolas, *The Use of Preclusion Doctrine, Antisuit Injunctions, and Forum Non Conveniens Dismissals in Transnational Intellectual Property Litigation*, 40 VA. J. INT’L L. 331, 359–64 (1999) (providing a good overview of the Act of State doctrine in the transnational intellectual property litigation context; in particular, footnote 167 provides a good overview of the constantly shifting justifications the Supreme Court has provided for this common law doctrine over the years).

³³ *Vanity Fair*, 234 F.2d at 646.

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reasoning of *Vanity Fair* would seem to apply *a fortiori* in the patent context, in which government patent examiners often play a central role in the grant of a patent.³⁴ However, as discussed more fully in Part IV *infra*, an *inter partes* solution which preserves a defense of invalidity for the defendant, yet substitutes an injunction between the parties for a formal finding of invalidity of the patent, can dissipate these concerns.

At what stage during litigation should concerns about adjudicating patent validity be handled? Many courts, including the majority in *Voda v. Cordis*, have conflated the actual jurisdictional inquiry with concerns related to the Act of State. The better view is that the Act of State doctrine, if it is implicated at all,³⁵ is an inquiry that is independent of whether jurisdiction exists; a court should consider those doctrines only *after* it determines that it has the power to hear the foreign claim for patent infringement.³⁶

II. THE §1367 SUPPLEMENTAL JURISDICTION DEBATE

The transitory nature of a patent infringement action does not arise as a stand-alone issue; it is usually debated within the framework of the Act of State doctrine, *forum non conveniens*,³⁷ abstention doctrine,³⁸ international comity,³⁹ or any number of other considerations that courts use to decline jurisdiction over

³⁴ In contrast, *London Film*, a case involving a transitory *copyright* claim, easily distinguished *Vanity Fair* on the grounds that grants of copyright are not subject to formalities or an administrative prosecution process and, thus, do not require a court to “pass upon the validity of acts of foreign government officials.” *London Film Prods. Ltd. v. Intercontinental Comm’ns., Inc.*, 580 F. Supp. 47, 49 (S.D.N.Y. 1984) (citing 3 M. NIMMER, NIMMER ON COPYRIGHT § 1703 (1982)).

³⁵ For starters, at least a couple of courts have disagreed that the grant of a patent is necessarily a sovereign act of state rather than a mundane administrative act. *See, e.g.,* *Mannington Mills, Inc. v. Congoleum Corp.*, 595 F.2d 1287, 1293–94 (3d Cir. 1979) (stating that a foreign state’s issuance of patents is, by itself, not an act of state); *Forbo Giubiasco v. Congoleum Corp.*, 516 F. Supp. 1210, 1217 (S.D.N.Y. 1981) (finding the Act of State doctrine inapplicable because the case before it did not implicate the legality of a foreign state’s act).

³⁶ Nicolas, *supra* note 32, at 359–60. This argument will be discussed further in Part IV, *infra*.

³⁷ *See* BLACK’S LAW DICTIONARY 680 (8th ed. 2004) (defining the legal term “forum non conveniens”).

³⁸ *See id.* at 8 (defining the legal term “abstention”).

³⁹ *See Philadelphia Gear Corp. v. Philadelphia Gear De Mex.*, 44 F.3d 187, 191 (3d Cir. 1994) (describing the effects of international comity).

foreign issues.⁴⁰ In the Federal Circuit, oddly enough, the battleground in the years leading up to *Voda* has taken shape within the confines of the supplemental jurisdiction doctrine, a doctrine which addresses none of these discretionary, international considerations.⁴¹

In essence, the supplemental jurisdiction inquiry asks whether the district court may hear claims over which it does *not* have original jurisdiction (typically state law claims) because those claims form a single dispute with claims over which the district court *does* have jurisdiction.⁴² The minimal case law on whether supplemental jurisdiction exists for foreign patents has been framed in large part by two opinions: *Ortman v. Stanray*⁴³ and *Mars v. Kabushiki-Kaisha Nippon Conlux*.⁴⁴ *Mars* and *Ortman* differ markedly in their overall worldview of supplemental jurisdiction for foreign patents. As they form the background for

⁴⁰ See, e.g., *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 234 F.2d 633 (2d Cir. 1956) (dismissing the claim on *forum non conveniens* and foreign sovereignty grounds); *Packard Instrument Co. v. Beckman Instruments*, 346 F. Supp. 408 (N.D. Ill. 1972) (dismissing the claim due to the court's improper qualifications to adjudicate the matter, in particular pointing to the multiple languages required to understand the patent claim, and the economic and social policies of a foreign country that are called into question). This paper argues that comity, Act of State doctrine, and other discretionary doctrines are largely inapposite.

⁴¹ This inquiry is necessary because foreign patent claims are not within the original jurisdiction of a federal district court and, thus, the district court must also have subject matter jurisdiction over those claims. Cf. *Mars Inc. v. Kabushiki-Kaisha Nippon Conlux*, 24 F.3d 1368, 1372 (Fed. Cir. 1994) (holding that original jurisdiction over nonfederal patent-related unfair competition claims under 28 U.S.C. § 1338(b) does not extend to *foreign* patents). This is accomplished either pursuant to supplemental jurisdiction under 28 U.S.C. § 1367, or pursuant to diversity jurisdiction under 28 U.S.C. § 1332. Of course, both diversity and supplemental jurisdiction typically govern whether a federal court may hear claims arising under U.S. *state* law, and reflect federalism rather than international concerns.

⁴² The literal language of § 1367 grants supplemental jurisdiction “over all other claims that are so related to claims in the action within such original jurisdiction that they form the same case or controversy under Article III of the United States Constitution.” 28 U.S.C. § 1367(a) (2000). However, some circuits, including the Federal Circuit, hold that § 1367 merely codified the Supreme Court precedent on common law pendent jurisdiction in *Gibbs*, and thus, the proper test under § 1367 in the Federal Circuit is whether there exists a “common nucleus of operative fact.” *United Mine Workers of America v. Gibbs*, 383 U.S. 715, 725 (1966); see also *infra* Part III. for a discussion of how the Federal Circuit has construed § 1367 both before and after *Voda*.

⁴³ See generally *Ortman v. Stanray Corp.*, 371 F.2d 154, 156–58 (7th Cir. 1967) (discussing the question of supplemental jurisdiction in foreign patent claims).

⁴⁴ See generally *Mars, Inc.*, 24 F.3d at 1371–72, 1374–75 (discussing the application of supplemental jurisdiction in foreign patent claims).

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the decision in *Voda*, this section examines them in further detail.

A. *Ortman v. Stanray Corp.*

In *Ortman*, a case decided in the Seventh Circuit in 1967,⁴⁵ the plaintiff sued his former exclusive licensee when the latter ceased paying to use the plaintiff's American and foreign patents.⁴⁶ The defendant moved to dismiss the plaintiff's Canadian, Mexican, and Brazilian patent claims, and the court denied the motion.⁴⁷ Affirming the denial on appeal, the Seventh Circuit noted that the doctrine of pendent jurisdiction (the precursor to the supplemental jurisdiction statute) had been interpreted broadly by the Supreme Court and was capable of encompassing foreign patent claims.⁴⁸ It observed that “[a]ll of the actions of defendant of which complaint is made are the result of defendant doing similar acts both in and out of the United States,” and thus, the U.S. foreign infringements could be viewed, on the pleadings, as a single “case.”⁴⁹

In this procedural posture, *Ortman* never explicitly found supplemental jurisdiction over the foreign patent claims.⁵⁰

⁴⁵ *Ortman*, 371 F.2d at 154. Though *Ortman* was decided long before Congress passed the modern § 1367 supplemental jurisdiction statute, it retains its relevance because it was decided under the common law doctrine of pendent or ancillary jurisdiction on which § 1367 is based. More to the point, that common law pendent jurisdiction doctrine was laid out by the Supreme Court in *United Mine Workers of America v. Gibbs*, 383 U.S. 715 (1966). Because the Federal Circuit is one of the circuit courts that holds that § 1367 codified *Gibbs*, rather than creating new statutory limitations on supplemental jurisdiction, *Ortman* remains persuasive authority that is directly on point. See *infra* Part III.A.

⁴⁶ See *Ortman*, 371 F.2d at 156–158 (noting that the licensing contract involved an assignment of the U.S. and foreign patents from Plaintiff to Defendant and that the patents were transferred back to the Plaintiff before litigation began).

⁴⁷ *Id.*

⁴⁸ See *id.* (citing *United Mine Workers of America v. Gibbs*, 383 U.S. 715 (1966) as arguing against an “unnecessarily grudging” approach to pendent jurisdiction). Ironically, *Gibbs* is the standard still used by the Federal Circuit to determine supplemental jurisdiction—yet they have done so exceedingly narrowly.

⁴⁹ See *id.* at 158 (remanding the case for a determination of the parties’ rights under their licensing contract, and if appropriate, a pendent jurisdiction analysis).

⁵⁰ In a later, *per curiam* opinion, the Seventh Circuit appeared to backtrack a bit, stating that “[w]e recognize that saying that the district court was not required to dismiss for lack of jurisdiction may be somewhat different from saying that the court had jurisdiction . . .” *Ortman v. Stanray Corp.*, 437 F.2d

However, the decision is notable because the Seventh Circuit seemed quite willing to embrace the foreign infringements as part of a single controversy amenable to supplemental jurisdiction, without nitpicking at the details of the foreign patents and foreign infringing behavior.

B. Mars, Inc. v. Kabushiki-Kaisha Nippon Conlux

In *Mars*, a Delaware corporation sued a Japanese company for infringement of both its U.S. and Japanese patents, covering “electronic coin discriminators with programmable memories.”⁵¹ The district court assumed without deciding that it had authority under § 1367(a), but then declined to exercise that authority.⁵² On appeal, the Federal Circuit reversed, finding that the district court should *not* have assumed such authority.⁵³ It reasoned that there was no “common nucleus of operative fact” joining the U.S. and Japanese patent claims sufficient to give rise to supplemental jurisdiction.⁵⁴ The panel in *Mars* distinguished *Ortman* to find that the facts as pled did not support supplemental jurisdiction for four reasons: the respective patents were different (because they did not contain the same literal language); the accused devices were different (as the Japanese patent covered a broader range of devices than the single accused device in the U.S.); the alleged acts were different; and the governing laws were different.⁵⁵

Under any view, this construal is exceedingly narrow; the alleged acts of infringement and the patent laws in different countries will always differ from the facts and law in the U.S. and the literal language of the claims will most likely differ as well.⁵⁶ However, the existence of these factors and the fact that

231, 239 (7th Cir. 1971). However, the fact that its earlier opinion involved a motion to dismiss should not have affected its stance regarding a jurisdictional issue.

⁵¹ *Mars Inc.*, 24 F.3d at 1370 (Fed. Cir. 1994).

⁵² *Id.* at 1374.

⁵³ *Id.* at 1375.

⁵⁴ *Id.* at 1374, 1375 (citing *United Mine Workers of America v. Gibbs*, 383 U.S. 715 (1966)).

⁵⁵ *Id.* at 1375; *See also* *Voda v. Cordis Corp.*, 476 F.3d 887, 894–95 (Fed. Cir. 2007) (distinguishing the *Mars* holding from the instant case).

⁵⁶ Professor Thomas provides a critique of the Federal Circuit’s application of supplemental jurisdiction in *Mars*. *See* Thomas, *supra* note 17, at 323 (“None of the four differences that the court judged sufficient to place the Japanese patent claims outside the scope of a ‘common nucleus of operative fact’ appears extremely significant, even when viewed in combination with the others.”).

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the Federal Circuit felt the need to distinguish *Ortman*, implied that supplemental jurisdiction over foreign patents should remain a case-by-case inquiry. This all changed, however, with the recent decision in *Voda*.

III. VODA V. CORDIS

If there was a case that would satisfy this restricted view of *Mars*'s "common nucleus" test, it might have been *Voda v. Cordis*. There, the plaintiff's foreign patents were based on essentially the same specification and drawings as his U.S. patents (actually, a narrower, earlier version of that specification), the same accused product was sold in every country, and the defendants were related corporate entities performing identical allegedly infringing behavior.⁵⁷ Perhaps recognizing this, the Federal Circuit chose not to apply the "common nucleus of operative fact" analysis, but rather imposed a new hurdle to finding supplemental jurisdiction.⁵⁸ Handed down in February of 2007, *Voda* drastically raises the bar for plaintiffs in federal court seeking § 1367 supplemental jurisdiction over foreign patent claims by restricting the court's discretion to take the case under §1367(c).⁵⁹ This section lays out the procedural posture, the arguments made before the court, and the holding and logic of the majority and dissent opinions in *Voda*.

A. *Background of the Case*

Dr. Voda's three U.S. patents at issue in this suit were directed towards a guiding catheter consisting of a certain shape with alternating straight and curved portions.⁶⁰ He originally filed a patent application with the USPTO in January 1991; a continuation-in-part application, filed in October 1992. This was the parent of the three U.S. patents ultimately at issue in this suit, which were issued in 1995, 2000, and 2002.⁶¹ To obtain his international registrations, Dr. Voda filed an application under the Patent Cooperation Treaty in January 1992, based upon his

⁵⁷ See *infra* Part III.A.

⁵⁸ *Voda*, 476 F.3d at 895–897.

⁵⁹ See *id.* at 898 (requiring the district court to apply a § 1367(c) analysis).

⁶⁰ Brief for Defendant-Appellant at 4, *Voda*, 476 F.3d 887 (No. 05-1238), 2005 WL 2174497 [hereinafter *Cordis* Brief].

⁶¹ *Id.* at 5–8.

original 1991 application.⁶² He designated the European Patent Office and Canada.⁶³ Prosecution⁶⁴ in the EPO lasted from September 1992 until October 2001, and national British, French, and German registrations followed.⁶⁵ In Canada, prosecution began in August 1993 and ran until September 1999, when Dr. Voda's Canadian patent was issued.⁶⁶

Voda accused Cordis of selling a single infringing device, Cordis' XB Guiding Catheter, in the five countries at issue in this litigation: the U.S., the U.K., Canada, France, and Germany.⁶⁷ The accused device was manufactured by Cordis in a single plant controlled by Cordis and subsequently shipped to those five countries.⁶⁸ While the only defendant in this case was the American Cordis Corp., sister Cordis companies existed in the U.K., France, Germany, as well as in Italy and the Netherlands.⁶⁹

Dr. Voda filed his action in the Western District of Oklahoma on October 30, 2003, alleging infringement of his three U.S. patents.⁷⁰ Voda then brought a motion to amend his complaint to further assert his Canadian and European patents in the same proceeding.⁷¹ After considering *Mars*, the 1994 Federal Circuit case, and *Ortman*, the 1967 Seventh Circuit case,⁷² Judge Leonard of the District Court ruled that the Court had supplemental jurisdiction over the foreign claims and allowed the amended complaint.⁷³ Defendant Cordis then brought a motion for interlocutory appeal; the District Court certified the issue and stayed the proceedings with respect to the foreign patent

⁶² *Id.* at 8.

⁶³ *Id.*

⁶⁴ BLACK'S LAW DICTIONARY 1258 (8th ed. 2004) (defining as "The process of applying for a patent through the U.S. Patent and Trademark Office and negotiating with the patent examiner—Also termed *patent-prosecution process*").

⁶⁵ Cordis Brief, *supra* note 60, at 8–9.

⁶⁶ *Id.* at 9–10.

⁶⁷ *Id.* at 11.

⁶⁸ Prior to 2001, the plant was located in Florida, and afterwards moved to Mexico. *Voda v. Cordis Corp.*, 476 F.3d 887, 910 (Fed. Cir. 2007) (Newman, J. dissenting); Cordis Brief, *supra* note 60, at 12.

⁶⁹ *Voda*, 476 F.3d at 890 & n.1.

⁷⁰ *Voda v. Cordis Corp.*, No. CIV-03-1512-L, 2004 WL 3392022, at *1(W.D. Okla. Aug. 2, 2004).

⁷¹ *Voda*, 2004 WL 3392022, at *1.

⁷² *Id.*

⁷³ *Id.*

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claims.⁷⁴ The Federal Circuit, citing “the paucity of law surrounding this issue,” granted permission to appeal in February 2005.⁷⁵ (During the interlocutory appeal, the proceedings continued with respect to the U.S. patents, with the parties going through discovery, and eventually a full jury trial on the domestic patents. The jury ultimately found infringement of all three patents.⁷⁶

B. Briefing Before the Federal Circuit

In a lengthy and well-researched appellate brief, Cordis argued that the trial court’s assertion of jurisdiction over Voda’s foreign patents was improper because supplemental jurisdiction under 28 U.S.C. § 1367 could *never* be exercised over foreign patent claims.⁷⁷ Analyzing the handful of cases to broach the issue, including *Mars* and *Ortman*, Cordis noted that none of them, even *Ortman*, had explicitly found supplemental jurisdiction over foreign patent claims, and that some declined to exercise such jurisdiction even where it had been assumed.⁷⁸ Cordis also asserted that differences in the scope and structure of the foreign

⁷⁴ *Voda v. Cordis Corp.*, No. CIV-03-1512-L, 2005 WL 1429887, at *1 (W.D. Okla. Jan. 7, 2005).

⁷⁵ Cordis Brief, *supra* note 60, at 3; *Voda v. Cordis Corp.*, No. MISC. 785, 2005 WL 545706, at *1 (Fed. Cir. Feb. 22, 2005).

⁷⁶ *Voda v. Cordis Corp.*, No. CIV-03-1512-L, 2006 WL 2570614, at *1 (W.D. Okla. Sept. 5, 2006). The jury awarded a reasonable royalty, finding the infringement was willful, and the district court granted increased (but not trebled) damages. *Id.* at *1, *3. The court then denied a permanent injunction because Voda failed to prove an irreparable injury. *Id.* at *5; Darryl J. Adams, Dewey Ballantine, LLP, Update on Post-eBay Permanent Injunction Cases (March 7, 2007), at <http://www.lexology.com/library/detail.aspx?g=958282ca-33ae-4880-8074-2d38fa189183>. Oddly, Cordis chose largely not to contest the validity of the three U.S. patents, limiting its invalidity arguments to only three claims of one of the patents; the jury found these claims to be valid. *Voda*, 2006 WL 2570614 at *1.

⁷⁷ Cordis Brief, *supra* note 60, at 22. While Cordis noted that the proper standard for § 1367 supplemental jurisdiction over *state* claims in the Federal Circuit is the “common nucleus of operative fact” test from *United Mine Workers v. Gibbs*, 383 U.S. 715 (1966), it argued that this test did not apply at all when *foreign law*, not state law, was at issue. Cordis Brief, *supra* note 60, at 19–22. This ignored the Federal Circuit’s 1994 *Mars* precedent, which clearly applied the *Gibbs* standard, not the literal language of the § 1367 statute, in its analysis of supplemental jurisdiction over Japanese patent claims. *Mars, Inc.*, 24 F.3d at 1374–1376. Cordis went on to argue that the literal language of § 1367(a) could *never* support jurisdiction over foreign patents as “so related” to “form part of the same case or controversy.” Cordis Brief, *supra* note 60, at 27–28, 48.

⁷⁸ Cordis Brief, *supra* note 60, at 23–28.

patent claims, as well as in the applicable patent regimes under which those patents were obtained, meant that the trial court would have to effectively conduct five separate trials if it allowed supplemental jurisdiction over them.⁷⁹

To supplement these arguments, Cordis devoted nearly a quarter of its brief to “public policy” issues.⁸⁰ First, it argued that international comity, the “elephant in the room,” counseled against applying foreign patent law, which is “best understood by local tribunals.”⁸¹ It also argued, as a matter of comity, that U.S. courts should avoid ruling on the *validity* of foreign patents as well.⁸² Cordis also raised concerns of judicial economy, arguing that the need to apply the vastly differing legal standards of other countries’ patent laws, especially when those standards may be unsettled and in flux, and to examine materials that may be written in other languages, would prove too heavy of a burden.⁸³

Finally, in an argument it could have no idea would eventually win the day, Cordis also noted that the district court failed to engage in the discretionary balancing required under §1367(c) (which allows a court to decline supplemental jurisdiction on discretionary grounds).⁸⁴ Cordis further argued, mirroring dicta in the *Mars* opinion, that dismissal on *forum non conveniens grounds* would also be proper, especially on the “public” factors.⁸⁵

⁷⁹ *Id.* at 10–11, 50–51.

⁸⁰ *Id.* at 32–48.

⁸¹ *Id.* at 32–33 (quoting *Packard Instrum. Co. v. Becker Instrum. Inc.*, 346 F. Supp. 408, 409 n.1 (D. Ill. 1972)).

⁸² *Id.* at 32–34. Cordis again emphasized the comity argument in its Reply Brief, arguing that “[w]hile the world strives towards harmonization [in patent law], it is a long way away” and, thus, abstaining from adjudicating the validity of foreign patents was still the wisest course of action. Reply Brief for Defendant-Appellant at 16, *Voda v. Cordis Corp.*, 476 F.3d 887 (Fed. Cir. 2007) (No. 05-1238), 2005 WL 2174498 [hereinafter Cordis Reply Brief]. It also supplemented that argument with an argument based on the Act of State doctrine, suggested by several amici. See Professors Amicus Brief, *supra* note 14, at 3.

⁸³ Cordis Brief, *supra* note 60, at 40–43.

⁸⁴ *Id.* at 51–54.

⁸⁵ *Id.* at 46–47. This argument is lifted straight from the *Mars* opinion. See *Mars, Inc.*, 24 F.3d at 1375–76. Anticipating that the plaintiff might replead its Japanese patent claim under § 1332 diversity jurisdiction, the Federal Circuit in *Mars* went out of its way to suggest that the public factors under *forum non conveniens* would favor dismissal of that claim. *Id.* There are two problems with this dictum. First, the Federal Circuit’s *forum non conveniens* analysis was incomplete, as it did not consider the private factors or confirm the existence of an adequate alternative forum; and second, *forum non conveniens*

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In contrast, Dr. Voda's appellee brief argued for a broad view of supplemental jurisdiction.⁸⁶ Unsurprisingly, Voda asserted that both the literal language of § 1367(a) and the *Gibbs* test⁸⁷ supported supplemental jurisdiction over foreign patents.⁸⁸ Voda drew an analogy to the copyright context, where U.S. courts have regularly exercised such supplemental jurisdiction under § 1367 over foreign copyright claims.⁸⁹ Voda also attempted to argue that the issues of comity and *forum non conveniens* were not properly before the court because the issues had not been argued or developed below and because there was no conflict of comity in the current case.⁹⁰

Voda v. Cordis also received a great deal of attention in the patent world, attracting five amicus briefs.⁹¹ Four of the amici sided with appellant Cordis, while the fifth, a group of law professors, argued in favor of Dr. Voda.

For the appellant, the American Intellectual Property Law Association (hereinafter "AIPLA"),⁹² the Federal Circuit Bar Association,⁹³ the Intellectual Property Owners Association,⁹⁴ and the U.S. Government⁹⁵ sounded many of the same policy alarms as Cordis, such as international comity, judicial economy,

typically entails the dismissal of an entire action, not the dismissal of a single claim based on foreign law.

⁸⁶ Cordis Reply Brief, *supra* note 82, at 12–13.

⁸⁷ See *Mars, Inc.*, 24 F.3d at 1374–76 (holding that § 1367 merely incorporated the older Supreme Court precedent on supplemental jurisdiction, *United Mine Workers v. Gibbs*, 383 U.S. 715 (1966) and its test for a “common nucleus of operative fact”).

⁸⁸ Cordis Reply Brief, *supra* note 82, at 12–13. Voda apparently also made a novel argument premising jurisdiction over foreign patent claims in part on the Patent Cooperation Treaty. *Id.*

⁸⁹ *Id.* at 17 (citing, *inter alia*, *London Film Prods. v. Intercontinental Comm'ns, Inc.*, 580 F. Supp. 47 (S.D.N.Y. 1984)).

⁹⁰ *Id.* at 19–20.

⁹¹ Professors Amicus Brief, *supra* note 14; IPOA Amicus Brief, *supra* note 30; Brief for Amicus Curiae American Intellectual Property Law Association in Support of Defendant-Appellant, Cordis Corporation, *Voda v. Cordis Corp.*, 476 F.3d 887 (Fed. Cir. 2007) (No. 05-1238), 2005 WL 1868612 [hereinafter AIPLA Amicus Brief]; Brief for the United States As Amicus Curiae in Support of the Appellant, *Voda*, 476 F.3d 887 (No. 05-1238), 2005 WL 1868615 [hereinafter Government Amicus Brief]; Brief of Amicus Curiae the Federal Circuit Bar Association in Support of Defendant-Appellant's Position Seeking Reversal of the District Court's August 2, 2004 Order, *Voda*, 476 F.3d 887 (No. 05-1238), 2005 WL 1868607 [hereinafter FCBA Amicus Brief].

⁹² AIPLA Amicus Brief, *supra* note 91.

⁹³ FCBA Amicus Brief, *supra* note 91.

⁹⁴ IPOA Amicus Brief, *supra* note 30.

⁹⁵ Government Amicus Brief, *supra* note 91.

fairness, and convenience.⁹⁶ They also raised another ground closely related to comity—the Act of State doctrine, mentioned in Part I *supra*, “which broadly precludes federal courts from determining ‘the validity of the acts of a foreign sovereign done within its borders.’”⁹⁷ Under this theory, the granting of a patent by a foreign government is an official act of a sovereign, and thus, it would be inappropriate for a U.S. court to pass judgment on that act by holding such a patent invalid.⁹⁸

The four amici in favor of reversal made a few other interesting arguments not raised by Cordis. AIPLA, for example, argued for a narrow, territorial interpretation of § 1367.⁹⁹ AIPLA also expressed the fear that allowing foreign patent claims under § 1367, by “increas[ing] the universe of claims and counterclaims,” would *force* parties in federal court to *always* plead those claims or face *res judicata* penalties preventing them from pursuing their foreign patent claims in foreign courts.¹⁰⁰ On another tack, the IPO argued that 38 U.S.C. § 1338, the jurisdictional statute conferring exclusive jurisdiction over patent cases to the federal courts, embodied a “significant federal policy” that U.S. patent law be uniformly interpreted and that many other countries have a similar policy—further buttressing the considerations of comity that would prevent meddling in another country’s patent system.¹⁰¹

The final amicus brief, filed by a group of patent law professors in support of Dr. Voda,¹⁰² provided an important counterweight to

⁹⁶ See AIPLA Amicus Brief, *supra* note 91, at 4–5, 15, 19; IPOA Amicus Brief, *supra* note 30, at 15–23; FCBA Amicus Brief, *supra* note 91, at 10–14; Government Amicus Brief, *supra* note 91, at 16.

⁹⁷ AIPLA Amicus Brief, *supra* note 91, at 17.

⁹⁸ See *id.* at 4–5 (discussing the appropriateness of U.S. courts hearing foreign patent claims with regard to issues of international comity). As discussed below, the Federal Circuit explicitly relied on this ground in its majority opinion. *Voda*, 476 F.3d at 904.

⁹⁹ AIPLA Amicus Brief, *supra* note 91, at 4–10 (arguing that § 1367 should be construed narrowly to cover only actions that occur in the United States and in order to avoid “difficult constitutional questions”). AIPLA also argued that a U.S. patent infringement claim will never share a “common nucleus of operative fact” with foreign patent claims because the court should only look at related facts within the United States, and not the facts of foreign infringement abroad. *Id.* at 10–13.

¹⁰⁰ *Id.* at 14.

¹⁰¹ IPOA Amicus Brief, *supra* note 30, at 9, 14.

¹⁰² Professors Amicus Brief, *supra* note 14 (listing professors Christopher Cotropia, Grame B. Dinwoodie, Jay P. Kesan, Mark A. Lemley, and John R. Thomas as authors).

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the one-sided comity and Act of State arguments made by Cordis and the four other amici. The brief noted that the Federal Circuit's current approach to the problem of international infringement, i.e., expanding the reach of U.S. patent law in cases such as *NTP v. RIM*, was arguably more controversial and less justifiable under comity, than the supplemental jurisdiction approach.¹⁰³ In addition, it disputed the premise of the Act of State doctrine by describing the grant of a patent as "less of a governmental act than a governmental reaction."¹⁰⁴ The Law Professors argued that comity concerns could be satisfied if U.S. courts properly applied foreign patent law to foreign facts (as opposed to applying U.S. law to them.)¹⁰⁵ More importantly, they proposed a workaround to the concerns related to the invalidation of foreign patents: rather than formally declaring them invalid, U.S. courts should simply enjoin the plaintiff from enforcing his rights against the defendant.¹⁰⁶ This paper will argue that this workaround is a sufficient alternative to the problem of adjudicating foreign patent validity in Part IV, *infra*.

C. *The Voda Majority*

The short story is that the Federal Circuit vacated and remanded Judge Leonard's decision to allow Voda's amended complaint pleading his foreign patents (and of course, Voda's U.S. patents have already been tried and resolved favorably before a jury, so it may not matter).¹⁰⁷ However, *Voda* is at once a very broad decision and a surprisingly narrow one. In reversing the district court's off-the-cuff finding¹⁰⁸ of supplemental jurisdiction,

¹⁰³ See *id.* at 21–22 (noting that the Government of Canada filed an amicus brief in *NTP v. RIM* protesting that an approach localizing RIM's multinational infringement "within the United States" could be adverse to the interests of Canada and Canadian companies.)

¹⁰⁴ *Id.* at 22–23.

¹⁰⁵ *Id.* at 23–24 (citing *Forbo-Giubiasco S.A. v. Congoleum Corp.*, 516 F. Supp. 1210 (S.D.N.Y. 1981)).

¹⁰⁶ *Id.* at 24. As one piece of evidence, they cited a joint EPO-USPTO report, finding that the variation in prosecution outcomes in many cases was not much greater than those that would result from "reasonable differences between individual examiners." *Id.* at 18–20.

¹⁰⁷ Adams, *supra* note 76, at 3–4.

¹⁰⁸ The extent of Judge Leonard's analysis was, literally, to read the *Mars* and *Ortman* cases, to note that *Ortman* involved "[the] defendant doing similar acts both in and out of the United States," and conclude that "this case is more akin to *Ortman* than to *Mars*." *Voda v. Cordis Corp.*, No. CIV-03-1512-L, 2004 WL 3392022, at *1 (W.D. Okla. Aug. 2, 2004).

the majority opinion, written by Judge Gajarsa, did not decide whether Voda's U.S. and foreign patent infringement claims formed a "common nucleus of operative fact" sufficient to sustain supplemental jurisdiction.¹⁰⁹ Nor did it decide whether Voda could assert his foreign patents on the strength of federal diversity jurisdiction.¹¹⁰ Rather, Judge Gajarsa held that there was no supplemental jurisdiction because the district court judge failed to conduct a discretionary balancing analysis under § 1367(c), which he held to be a mandatory part of the § 1367 jurisdictional inquiry.¹¹¹

In finding that Judge Leonard abused his discretion, the Federal Circuit spent a great deal of time explaining why a wide range of comity, sovereign action, judicial economy, convenience, and fairness considerations—echoing in large part the concerns raised by Cordis and its amici—should have compelled the judge to deny supplemental jurisdiction under the §1367(c) discretionary provision.¹¹² Before examining the court's reasoning in that section, however, a discussion of § 1367 as construed by the Federal Circuit in *Voda* is in order.

1. The structure of 28 U.S.C. § 1367

Section 1367(a) is the main section that provides district courts with the statutory authority to exercise supplemental jurisdiction over claims outside their original jurisdiction.¹¹³

In relevant part, it states:

*Except as provided in subsections (b) and (c) or as expressly provided otherwise by Federal statute, in any civil action of which the district courts have original jurisdiction, the district courts shall have supplemental jurisdiction over all other claims that are so related to claims in the action within such original jurisdiction that they form part of the same case or controversy under Article III of the United States Constitution . . .*¹¹⁴

¹⁰⁹ See *Voda v. Cordis Corp.*, 476 F.3d 887, 896 (Fed. Cir. 2007) (reversing the district court's grant of supplemental jurisdiction as an abuse of discretion, without determining the "common nucleus of operative fact" question).

¹¹⁰ *Id.* at 905. Another smaller issue upon which the Federal Circuit did not pass was when and how district court should resort to the abstention doctrines, as used in the *Packard* case. See *Packard Instrument Co. v. Becker Instruments Inc.*, 346 F. Supp. 408, 409–410 (D. Ill. 1972) (discussing how the district court never decided whether abstention is appropriate in the instant case).

¹¹¹ *Voda*, 476 F.3d at 891, 904–905.

¹¹² See *id.* at 897–904.

¹¹³ *Id.* at 893.

¹¹⁴ 28 U.S.C. § 1367(a) (2000) (emphasis added).

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The Federal Circuit has held that this language incorporates the old standard for pendent or ancillary jurisdiction under *United Mine Workers of Am. v. Gibbs*.¹¹⁵ Thus, it does not apply the “so related . . . that they form part of the same case or controversy” language of § 1367(a) directly or literally.¹¹⁶ Rather, it examines whether, under *Gibbs*, there is a “common nucleus of operative fact” between the claims based on original jurisdiction and those asserted under supplemental jurisdiction.¹¹⁷ The Federal Circuit emphasized in *Voda* that the standard of review for this question, like all questions of jurisdiction before it, was *de novo* review.¹¹⁸ The court declined to construe § 1367(a) further—notably, it considered, but declined to incorporate, additional language in *Gibbs* into the supplemental jurisdiction standard.¹¹⁹

However, the Federal Circuit further held in *Voda* that the supplemental jurisdiction inquiry is expressly limited by subsection (c), which states:

The district courts *may decline* to exercise supplemental jurisdiction over a claim under subsection (a) if –
the claim raises a novel or complex issue of State law,
the claim substantially predominates over the claim or claims over which the district court has original jurisdiction,
the district court has dismissed all claims over which it has

¹¹⁵ 383 U.S. 715, 725 (1966). There is apparently a circuit split on the proper standard, with the Second and Ninth Circuits taking an opposing view—that Congress’ passage of § 1367 “altered and constrained the *Gibbs* analysis.” Cordis Brief, *supra* note 60, at 21–22 (citing *Executive Software N. Am. v. U. S. Dist. Court*, 24 F.3d 1545, 1555–58 (9th Cir. 1994) and *Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, 140 F.3d 442, 445–47 (2d. Cir. 1998)).

¹¹⁶ 28 U.S.C. § 1367(a) (2000).

¹¹⁷ *Voda v. Cordis Corp.*, 476 F.3d 887, 896 (Fed. Cir. 2007) (quoting *Gibbs*, 383 U.S. at 725):

The federal claim must have substance sufficient to confer subject matter jurisdiction on the court. The state and federal claims must derive from *a common nucleus of operative fact*. But if, considered without regard to their federal or state character, a plaintiff’s claims are such that he would *ordinarily be expected to try them all in one judicial proceeding*, then assuming substantiality of the federal issues, there is power in federal courts to hear the whole.

(emphasis added)).

¹¹⁸ *Voda*, 476 F.3d at 892.

¹¹⁹ *Id.* at 896–97. The additional language would examine whether a district court would “ordinarily be expected” to try the claims over which supplemental jurisdiction is to be asserted “all in one judicial proceeding,”—a standard which would probably bar supplemental jurisdiction over foreign patents in every instance.

original jurisdiction, or
in exceptional circumstances, there are other compelling reasons
for declining jurisdiction.¹²⁰

Noting that the Supreme Court, in *City of Chicago v. Int'l College of Surgeons*, found “the values of judicial economy, convenience, fairness, and comity” are proper considerations in the subsection (c) analysis, the Federal Circuit proceeded to apply these factors literally.¹²¹

Indeed, the Federal Circuit elevated § 1367(c) to a full-fledged requirement for supplemental jurisdiction. Although *Voda* attempted to argue that the § 1367(c) analysis was a question of judicial discretion that was independent of the *existence* of subject matter jurisdiction under the § 1367(a) and *Gibbs* standards, the Federal Circuit held that “[t]he text of § 1367(a) indicates § 1367(c) constitutes an express statutory exception” to the former provision.¹²² Thus, to find supplemental jurisdiction, an asserted claim must satisfy both § 1367(a) and § 1367(c). Strangely, however, the standard of review for § 1367(c) is abuse of discretion, even though it is part of the § 1367(a) test, which is ostensibly reviewed under a *de novo* standard.¹²³ What is even stranger, though, is how little discretion the Federal Circuit has left to district courts in exercising their “discretionary” powers under § 1367(c).

2. §1367(c)'s mandatory discretionary balancing test

The Federal Circuit held that the district court abused its discretion in granting supplemental jurisdiction because Judge Leonard's order did not engage in the required §1367(c) discretionary analysis.¹²⁴ However, the majority opinion did not stop there. It proceeded to engage in an extensive treatment of each of the four “discretionary” considerations mentioned by the Supreme Court in *City of Chicago* (and harped upon endlessly by *Cordis* and its four amici): comity, judicial economy, convenience,

¹²⁰ 28 U.S.C. § 1367(c) (2000).

¹²¹ *City of Chi. v. Int'l Coll. of Surgeons*, 522 U.S. 156, 173 (1997). It is notable that the Supreme Court listed these four factors as relevant while analyzing § 1367(c) in the *state law* context, while the Federal Circuit applied them in the context of infringement of *foreign patents*. The Federal Circuit emphasized that the four *Chicago* considerations were a “non-exhaustive list, not a test.” *Voda*, 476 F.3d at 905.

¹²² *Voda*, 476 F.3d at 898.

¹²³ *Id.* at 892, 897–98.

¹²⁴ *Id.* at 898.

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and fairness.¹²⁵ The Federal Circuit determined that these factors, especially comity, should “compel” the district court to decline such jurisdiction *in most circumstances*.¹²⁶ The following subsections examine each of the Federal Circuits points, in turn.

a. Comity

Noting that “comity” is “neither a matter of absolute obligation” nor one “of mere courtesy and goodwill,” but rather a “spirit of cooperation,” the majority found it proper to inquire whether the possibility of jurisdiction over foreign patents would lead to a “prejudice to the rights of the other governments” or violate expectations of “international duty and convenience.”¹²⁷ It then listed a smorgasbord of reasons why adjudicating foreign patents violated comity: Voda had identified no international duty to do so; Voda had not shown that it would be more convenient; Voda did not show that foreign courts would inadequately protect his foreign patent rights.¹²⁸

The most central point, in the majority’s view, for finding comity could be harmed, was that assuming jurisdiction over foreign patents could prejudice the rights of foreign governments.¹²⁹ On this point, the majority reasoned that patent infringement is analogous to an action for trespass on land, which “can only be brought [in the jurisdiction] in which the land lies.”¹³⁰ Adjudicating claims of foreign patent infringement, they argued, was similar—it “would require us to define the legal boundaries of a property right granted by another sovereign, and then determine whether there has been a trespass to that right,” just like a local jury might determine the metes and bounds of a piece of real estate.¹³¹ Thus, hearing foreign patent claims would be as much of an insult to a foreign country as hearing a local action for trespass.

In essence, the Federal Circuit bought Cordis’s argument hook, line, and sinker—even the analogy to land and local law that

¹²⁵ *Id.*

¹²⁶ *Id.* at 902–03, 904.

¹²⁷ *Voda v. Cordis Corp.*, 476 F.3d 887, 900 (Fed. Cir. 2007) (emphasis omitted) (citing *Société Nationale Industrielle Aérospatiale v. U.S. Dist. Court for the S. Dist. of Iowa*, 482 U.S. 522, 543 n.27 (1987)).

¹²⁸ *Voda*, 476 F.3d at 901.

¹²⁹ *Id.* at 902.

¹³⁰ *Id.* at 901 (citing *Ellenwood v. Marietta Chair Co.*, 158 U.S. 105, 107 (1895)).

¹³¹ *Id.* at 900.

Cordis made in its own brief.¹³² The court did focus solely on the damage done by the mere *application* of foreign patent law by a U.S. tribunal, while Cordis also argued that adjudication of foreign patent *validity* also violated comity.¹³³ But the Federal Circuit had not rejected that aspect of Cordis' argument; they had merely saved it for analysis under another *City of Chicago* factor.

b. Fairness

The majority chose to consider the issues raised by adjudication of foreign patent validity as a fairness concern. It asserted that because the Act of State doctrine would prevent courts from passing upon the validity of foreign patents, the exercise of supplemental jurisdiction over foreign patents might be "fundamentally unfair to the alleged infringer[.]" especially "[g]iven the number of U.S. patent cases that we resolve on validity or enforceability, as opposed to infringement grounds."¹³⁴ On this theory, the unfairness arises when a defendant is deprived of the crucial defense of invalidity.¹³⁵ Unfortunately, in reaching this conclusion, Judge Gajarsa did not consider the Law Professors' injunction-based suggestion (i.e., enjoin the plaintiff from enforcing the patent against the defendant) for avoiding the need to formally declare foreign patents invalid.¹³⁶

c. Judicial Economy and Convenience

Lastly, the *Voda* majority merely stated that the district court had not analyzed the final two *City of Chicago* considerations, judicial economy and convenience, and held that this was abuse of discretion. It noted in passing certain factors that might lean against a finding of judicial economy¹³⁷ or convenience.¹³⁸

¹³² See Cordis Brief, *supra* note 60, at 32 (citing Packard Instrument Co. v. Beckman Instruments, Inc., 346 F. Supp. 408, 409 n.1 (N.D. Ill. 1972)).

¹³³ *Id.*

¹³⁴ *Voda*, 476 F.3d at 904.

¹³⁵ *Id.*

¹³⁶ Specifically, the majority asserted that none of the parties or amici had *persuaded* them that the grant of a patent is not an act of state. *Id.*

¹³⁷ Namely, the possibility that *Voda's* foreign patent claims might "substantially predominate" its U.S. patent claims, or the specter that a jury may be confused by the need to apply various patent laws, necessitating separate jury trials. *Id.* at 903. Interestingly enough, the "substantially predominate" language is from § 1367(c)(2), and is only one of two times in the opinion that the Federal Circuit employs the § 1367(c) statutory language. 28

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Interestingly, it did not directly dispute the possibility that consolidated multinational patent adjudication could be more efficient; rather, it pointed out the uncertainty surrounding whether a foreign court would recognize a U.S. court decision adjudicating foreign patents could in fact lead to less efficient outcomes.¹³⁹

d. International treaties

A fifth, and puzzling, consideration the Federal Circuit took into account was the role of international treaties on intellectual property to which the U.S. is a party. It noted that the Paris Convention affirmed the “independence of each country’s sovereign patent systems” and argued that nothing in the Paris Convention, the PCT, or the TRIPs Agreement contemplates the patents of one nation being adjudicated in another, or imposes a duty to do so.¹⁴⁰ What the court failed to mention, of course, is that nothing in those treaties forbids it, either—all of these agreements are entirely silent on the issue.¹⁴¹ Nevertheless, the court cited this as evidence of “exceptional circumstances” providing “compelling reasons” for declining jurisdiction to be considered under factor (4) of § 1367(c).¹⁴²

e. Exceptions to the Ordinary §1367(c) Analysis

The court suggested two narrow exceptions to the normal result that the § 1367(c) analysis should ordinarily “compel” a

U.S.C. § 1367 (2000).

¹³⁸ The court suggested that the costs of obtaining and translating evidence from another language, and retaining foreign patent experts, might be relevant here. It suggested that deference to the plaintiff’s choice of forum, however, would cut the other way. *Voda*, 476 F.3d at 904.

¹³⁹ *Id.* at 903 (noting that the U.S. has not entered any treaty ensuring the recognition of judgments abroad, analogous to the “full faith and credit” guarantee enjoyed by American states).

¹⁴⁰ *Id.* at 899 (“Like the Paris Convention, nothing in the PCT or the Agreement on TRIPs contemplates or allows one jurisdiction to adjudicate patents of another.”).

¹⁴¹ Judge Newman points out as much in her dissent stating, “None of these treaties prohibits resolution by a national court of private disputes that include foreign patent rights The question is whether any treaty prohibits a national court from resolving a dispute between entities under the personal jurisdiction of the court. No treaty bars such dispute resolution.” *Id.* at 915–16 (Newman, J., dissenting).

¹⁴² *Id.* at 898 (providing another rare example of the Federal Circuit applying the literal language of the supplemental jurisdiction statute).

district court judge to decline supplemental jurisdiction over foreign patents. First, “if circumstances change, such as if the United States were to enter into a new international patent treaty[,]” this might affect the analysis.¹⁴³ The second exception occurs “if events during litigation alter a district court’s conclusions regarding comity, judicial economy, convenience, or fairness.”¹⁴⁴ Part IV, *infra*, analyzes the viability of these two exceptions to the “mandatory” § 1367(c) balancing act (and concludes they are too narrow to be of any use).

3. Judge Newman’s Dissent

In a sharp and vigorous dissent, Judge Newman objected to the majority’s entire §1367 framework. Noting that “[a] foreign country is not a ‘state’ in the constitutional context,” she argued that the jurisdictional balancing under § 1367(c) and *City of Chicago*, which were fashioned in response to *federalism* concerns, should play no role in a court’s decision to apply foreign law.¹⁴⁵

Even within the majority’s § 1367(a)–§ 1367(c) framework, however, Judge Newman argued that the “common nucleus of operative fact,” as well as the factors of comity, judicial economy, fairness, and convenience, should point jurisdiction over foreign patents where, as in *Voda*, the district court is willing and there appears to be significant judicial economy advantages to hearing all the claims in a single forum.¹⁴⁶ In her view, of course, “comity has no relevance to the need to apply foreign law and the . . . authority to meet that need,” nor should concerns about local action or the Act of State doctrine play a role.¹⁴⁷

Newman also embarked on an exhaustive survey of cases in which federal courts have considered complex issues of foreign law, citing the Supreme Court’s observation that U.S. courts

¹⁴³ *Id.* at 905.

¹⁴⁴ *Id.*

¹⁴⁵ *Id.* at 905–06 (Newman, J. dissenting). Instead, she would allow claims of foreign law to be brought *independent* of the existence of § 1367 supplemental subject matter jurisdiction, asserting that “judicial authority to determine and apply foreign law does not require that the foreign issue is supplemental to a domestic issue.” *Id.* at 909 (leaving the statutory basis under which Judge Newman would bring such claims in federal courts, which are courts of limited jurisdiction, is unclear).

¹⁴⁶ *Voda v. Cordis Corp.*, 476 F.3d 887, 909 (Fed. Cir. 2007) (Newman, J., dissenting).

¹⁴⁷ *Id.* at 914,–16 (Newman, J., dissenting).

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apply the law of other sovereigns “all the time.”¹⁴⁸ She argued that in light of the *eBay v. MercExchange* case, the Supreme Court has in fact discouraged the “carving out of . . . exception[s] unique[] for patent cases;”¹⁴⁹ why should foreign patent law be treated differently? The fact that foreign patents involve complex questions of law and fact, she asserted, is not reason enough to strip district courts of their *discretion* to adjudicate foreign patent disputes should they choose to do so.¹⁵⁰

IV. ANALYSIS, OR, WHAT DOES *VODA* REALLY MEAN?

The majority’s construction of § 1367(c) is simply wrong. While the Federal Circuit may be free to implement their *Gibbs*-based (i.e. “common nucleus of operative fact”) standard for §1367, it is a bit odd for them to hold that the § 1367(c) discretionary balancing test is actually an integral part of the § 1367(a) standard, and furthermore, that this supposedly discretionary test should *almost always* come out one way. § 1367(a) is written in terms of command: the district court “shall” have supplemental jurisdiction over claims that satisfy its demands, while § 1367(c) is a permissive, discretionary clause that “may” allow a district court to decline supplemental jurisdiction.¹⁵¹ The majority has a point as a literal matter of statutory construction that subsection (c) may be read as an “express statutory exception” to subsection (a). But even the Federal Circuit admits that the standards of review for § 1367(a) (de novo) and § 1367(c) (nominally, abuse of discretion) are different for the two parts of this “test,” which also seems incongruous.

Furthermore, as suggested in Part I, *supra*, the Federal Circuit has conflated the analysis of whether jurisdiction *exists* to hear a foreign patent claim with the inquiry into whether jurisdiction *is appropriate* in a particular case. If a foreign claim falls within the “common nucleus of operative fact” standard, a court should have supplemental jurisdiction; whether it chooses to exercise that jurisdiction (and decline it under § 1367(c), *forum non conveniens*, or Act of State, or abstention doctrine) is another issue. While a different approach might be appropriate where national law is given *extraterritorial* application, that is not the

¹⁴⁸ *Id.* at 906–08 (Newman, J., dissenting) (citing *Printz v. United States*, 521 U.S. 898, 907 (1997)).

¹⁴⁹ *Id.* at 910.

¹⁵⁰ *Id.* at 912.

¹⁵¹ 28 U.S.C. § 1367(a), (c) (2000).

situation presented here, where a court simply intends to apply the law of a foreign country to acts occurring there.¹⁵² This section analyzes three aspects of the *Voda* opinion. First, it examines the Federal Circuit's motivations and concludes that *Voda*'s statutory construction was an ugly matter of necessity from the court's perspective. Second, it considers the merit of the Federal Circuit's comity and fairness arguments, and finds them valid only to the extent that they implicate formal adjudication of the validity of foreign patents. (That subsection will also explain why, rather than counseling against jurisdiction, considerations of comity may actually argue for effective resolution of disputes). Third, this section explores the options remaining after *Voda* to those seeking to bring foreign patent claims in federal court.

A. *What Motivated the Federal Circuit in Voda?*

Why did *Voda* interpret § 1367(c) in such an awkward manner? The most plausible answer is that the Federal Circuit was just confronted with a gap between where it wanted to go and the ways in which it could get there, and this interpretation of § 1367(c) was able to bridge that gap. One must understand, first, that both the Federal Circuit and its predecessor court, the C.C.P.A., have long displayed a wariness, if not outright hostility, to foreign patent law—a hostility that stands in stark contrast to the generally permissive attitude taken by other federal courts towards other areas of foreign law.¹⁵³ The Federal Circuit likely

¹⁵² In a seminal article on public and private international law, Harold Maier argues against “separat[ing] the existence of authority from the wisdom of applying [it]” only in the *transnational* regulatory context—in particular, the situation in which U.S. antitrust law is applied *extraterritorially* to behavior abroad. Maier, *supra* note 18, at 287, 299 (transnational regulatory context); see also Note, *Predictability and Comity: Toward Common Principles of Extraterritorial Jurisdiction*, 98 HARV. L. REV. 1310, 1322 (1985) (similar argument in U.S. antitrust context). Maier distinguishes this situation from the traditional international choice-of-law cases. Maier, *supra* note 18, at 287 n.29 (“The principal distinction is that in nonregulatory choice-of-law cases the court will apply the law of a foreign jurisdiction if it finds that that jurisdiction has a greater interest . . .”). However, this critique does not apply because asserting foreign patent claims are a matter of nonregulatory, nonextraterritorial application of foreign law (the choice of law, of course, being determined by the rule of territoriality).

¹⁵³ Compare Thomas, *supra* note 20, at 280, 305–12 (criticizing the Federal Circuit’s “parochial attitude”), with *Stein Assocs., Inc. v. Heat and Control, Inc.*, 748 F.2d 653, 658 (Fed. Cir. 1984) (“Only a British court, applying British law, can determine validity and infringement of British patents”), and *Voda v. Cordis Corp.*, 476 F.3d 887, 902 (Fed. Cir. 2007) (expressing same worldview

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does not want the additional workload and headaches that may come with complicated issues of foreign patent claim construction and infringement, let alone validity. The Federal Circuit may also fear district courts are not up to the task.

Now add in the reality that there is no easy doctrinal “hook” upon which the court could have held that jurisdiction over foreign patents should *always* be denied. As noted above, the supplemental jurisdiction doctrine, properly interpreted and applied, can provide no absolute barrier to foreign claims; once a foreign claim meets the “common nucleus of operative fact” test, the court “shall” have jurisdiction, subject to a discretionary call under § 1367(c)—even if, as demonstrated in *Mars*, the Federal Circuit tends to apply that standard very narrowly.¹⁵⁴

The situation under § 1332 diversity jurisdiction is even more automatic—the court can hear the claim as long as the parties are diverse and the claims meet the \$75,000 amount in controversy threshold.¹⁵⁵ Though courts can and often do dismiss claims related to foreign law or foreign acts under the doctrine of *forum non conveniens*, the Supreme Court has held that the judicial discretion inhering under that doctrine cannot be limited by *per se* rules.¹⁵⁶ It would be very difficult to hold in the *forum non conveniens* context, as the Federal Circuit did for §1367(c), that the district court’s discretionary analysis should usually come out a certain way.¹⁵⁷ In addition, *forum non conveniens* is typically used to dismiss an entire case, not individual claims

regarding the comity factor of § 1367(c) that patents are quasi-local actions that cannot be heard anywhere except where they arise).

¹⁵⁴ *Mars, Inc.*, 24 F.3d at 1374; *see also* Keynote Address by Judge Randall Rader (July 21, 2000) at the High Technology Summit at the University of Washington School of Law in DO YOU WANT YOUR FOREIGN PATENT ENFORCED IN A U.S. COURT? (Hill, Takenaka, Takeuchi, eds., CASRIP Symposium Series Number 6) (2000) *available at* <http://www.law.washington.edu/CASRIP/Symposium/Number6/Rader.pdf>. Of course, the Federal Circuit did not decide whether or not a “common nucleus” existed in *Voda*. I suspect the reason is that it was a much closer question than it was in *Mars*, on the facts of the case.

¹⁵⁵ 28 U.S.C. § 1332 (2000).

¹⁵⁶ *Piper Aircraft Co. v. Reyno*, 454 U.S. 235, 247, 249 (1981) (emphasizing “the need to retain flexibility” in *forum non conveniens* considerations).

¹⁵⁷ In *Piper Aircraft*, the Supreme Court reversed the Third Circuit’s holding that analysis under *forum non conveniens* should *never* be dismissed on *forum non* grounds where the plaintiff shows that the law of the alternative forum is less favorable to him than U.S. law. *Id.* at 261. Thus, the Supreme Court would probably not allow *per se* rules, such as the one the Federal Circuit established for § 1367(c), to limit discretion in the *forum non conveniens* context.

(although the *Mars* opinion suggested otherwise).¹⁵⁸

Finally, the application of foreign law also does not appear to cause any serious conflicts with the U.S. Constitution or with substantive U.S. law.¹⁵⁹ Thus, it is not at all surprising that the *Voda* majority, unwilling to touch the issues of diversity jurisdiction or *forum non conveniens*, arrived at the tortured statutory construction that it did (*Mars* itself reached an exceedingly narrow interpretation of the “common nucleus of operative fact” for similar practical reasons).¹⁶⁰

B. What about Comity and Fairness? A Response, and Alternate Perspectives

Even if the Federal Circuit’s statutory construction is suspect, another question still remains: are any of the Federal Circuit’s concerns about comity and fairness valid?¹⁶¹ Yes and no. The majority’s fairness argument, based on the Act of State doctrine, raises a genuine issue to the extent it emphasizes that adjudication of foreign patent validity is problematic. This holds true even though the Federal Circuit’s fairness argument, and the Act of State premise on which it rests, are questionable.¹⁶² On the other hand, the majority’s comity argument, which relies on the entirely inapposite “local action” doctrine, is without reason or precedent when situated within the broader literature

¹⁵⁸ See generally Nicolas, *supra* note 32, at 379 (“With the exception of the *Mars* court . . . nearly all modern courts applying the *forum non conveniens* doctrine in transnational intellectual property law disputes involving claims arising under both U.S. and foreign laws have either dismissed all claims . . . or none of them.”). See also Dismissal of Cases Under the Doctrine of Forum Non Conveniens, 32A AM. JUR. 2D *Federal Courts* § 1353 (2007) (discussing dismissal of an entire case or action on *forum non conveniens* grounds).

¹⁵⁹ At the very least, no such conflict has been substantiated by the parties, amici, or the Court in *Voda*, and there is no mention of such issues in the literature. Vague doctrines like “comity” and abstention are probably necessary in the first place precisely because there are no strong barriers, constitutional or otherwise, to applying foreign law (or for that matter, to extraterritorial application of U.S. law).

¹⁶⁰ Indeed, the Federal Circuit’s unwillingness to narrow the scope of the “common nucleus” test further (through the “ordinarily . . . all in one proceeding” language or otherwise) may explain its reluctance to rule expressly on that issue in *Voda*. *Voda v. Cordis Corp.*, 476 F.3d 887, 895 (Fed. Cir. 2007).

¹⁶¹ See *infra* Part IV.B. (stating that the comity and fairness factors are largely normative, while judicial economy and convenience are empirically based). In addition, the *Voda* majority analyzed fairness and especially comity in depth, while its analysis of the other two factors was limited. 476 F.3d at 900–04.

¹⁶² *Id.* at 904.

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on transnational litigation.

1. Fairness and the Act of State Doctrine

In its analysis of fairness, the Federal Circuit expressed the concern that invalidation of foreign patents by U.S. courts would be “fundamentally unfair to the alleged infringer” because the crucial defense of invalidity would be unavailable to him where foreign patents are at issue.¹⁶³ These are two responses to the Federal Circuit’s fairness concerns. First, an *inter partes*¹⁶⁴ approach to invalidity can alleviate any “unfairness” involved. Second, it is not plausible to extend the Act of State doctrine to the grant of foreign patents; and in any case, the Act of State doctrine is not implicated in the *inter partes* approach.

a. Inter Partes, Not Erga Omnes

A straightforward and sufficient alternative already exists to formal pronouncements of invalidity: enjoining the patentee from enforcing her patent against the defendant.¹⁶⁵ But this *inter partes* approach affects only the rights between the plaintiff and defendant, and does not implicate the plaintiff’s rights against any other party. Effective enforcement of the U.S. outcome would only require a foreign court to recognize a limited U.S. injunction, rather than a U.S. ruling that holds invalid a foreign property right.

Granted, the *inter partes* approach would still lead to one anomalous result—the patentee would still hold rights in its foreign patent and it would remain valid as against other potential infringers in the country where that patent was granted. One could imagine the situation where an unsavory patentee, aware of weaknesses in its non-U.S. patents, repeatedly seeks to assert them in the U.S. in order to shield them from a real ruling of invalidity. However, even this situation would not leave accused infringers without a remedy; the patent can still be invalidated in the country in which it was granted.¹⁶⁶ Whether this is done through administrative

¹⁶³ *Voda*, 476 F.3d at 904.

¹⁶⁴ BLACK’S LAW DICTIONARY 836 (8th ed. 2004) (defining *inter partes* as “between two or more parties”).

¹⁶⁵ See, e.g., Professors Amicus Brief, *supra* note 14, at 24 (making this suggestion).

¹⁶⁶ See *Vanity Fair Mills, Inc.*, 234 F.2d at 646 (observing that a patent registered in Canada can be found invalid in a Canadian court).

proceedings, in the foreign country's courts, or via other appropriate means, *inter partes* findings of invalidity made in U.S. courts may still have persuasive or informative effect. Although allowing a plaintiff to continue to assert its foreign patent in U.S. courts, even after that patent has been "deemed invalid" in U.S. proceedings multiple times, might be *inefficient*, it is not *unfair* to any particular defendant. It is worthwhile noting, in any case, that this "inefficiency" was one the U.S. patent system managed to tolerate for almost two hundred years.¹⁶⁷

b. No Act of State to Begin With

A second objection to the Federal Circuit's "unfairness argument" disputes the Act of State premise itself. Courts dating back to *Vanity Fair* and *London Film* have assumed, without more, that the grant of a patent right should be considered an "Act of State."¹⁶⁸ However, the Supreme Court has consistently applied the Act of State doctrine in cases involving political acts by a foreign sovereign.¹⁶⁹ It is not at all clear that the definition of an "act" should encompass the grant of a *patent*, which is in some sense, is "less of a governmental act than a governmental reaction" and does not directly affect the conduct of the U.S.'s international affairs.¹⁷⁰ This is especially true if, as Professor

¹⁶⁷ See *Blonder-Tongue Labs., Inc. v. Univ. of Ill. Found.*, 402 U.S. 313, 323–25 (1971) (imposing the rule of nonmutual collateral estoppel upon a patent that has previously been adjudicated invalid in another proceeding); see also *Triplett v. Lowell*, 297 U.S. 638, 641–43 (1936). It was only until *Blonder-Tongue* that a U.S. patent that had been adjudicated invalid in court stayed invalid.

¹⁶⁸ See *Vanity Fair Mills, Inc.*, 234 F.2d at 646 (defining the act of patent registration in Canada as an act of a foreign state); see also *London Film Prod. Ltd. v. Intercontinental Commc'ns*, 580 F.Supp. 47, 49 (S.D.N.Y. 1984) (extending this concept to copyrights).

¹⁶⁹ See, e.g., *Underhill v. Hernandez*, 168 U.S. 250, 254 (1897) (holding act of Venezuelan military general in refusing to grant passport to U.S. citizen in Venezuela was an act of state); *Oetjen v. Cent. Leather Co.*, 246 U.S. 297, 303 (1918) (holding that seizure of property by Mexican military commander in his official capacity was an Act of State). See generally *Banco Nacional de Cuba v. Sabbatino*, 376 U.S. 398, 436–37 (1964) (holding expropriation decree by Cuba was an Act of State). The actual policy rationale for the Act of State doctrine is unclear; the Supreme Court has variously characterized it as an outgrowth of sovereign immunity, a matter of international comity, grounded in the separation of powers, or as a choice of law rule. See *Nicolas*, *supra* note 32, at 360 n.167.

¹⁷⁰ See Professors Amicus Brief, *supra* note 14, at 23 (relying on *Mannington Mills, Inc. v. Congoleum Corp.*, 595 F.2d 1287, 1294 (3d Cir. 1979), which found

Chisum has observed, patent prosecution in other countries does not involve as many complex issues of law and historical fact as it does in the United States.¹⁷¹

Furthermore, even if the Act of State doctrine is implicated when the validity of a foreign patent is raised, an injunction that merely enjoins enforcement against a particular defendant—the *inter partes* alternative discussed above—would not violate it. Though such an injunction is designed to replace a formal ruling of foreign patent invalidity and thus might “imply” the patent was invalid, courts have defined the actual “act,” whose validity must not be judged, as being quite narrow. In *Kirkpatrick v. Environmental Tectonics*, the Supreme Court held that even “factual findings that may cast doubt upon the validity of foreign sovereign acts” do not violate the Act of State doctrine; only where a claim or defense *turns* on the validity of a sovereign act must courts refrain from deciding them.¹⁷² Where a given claim or defense can prevail short of a formal finding of invalidity of the sovereign act, then there is no conflict.

This proposition is illustrated in two cases involving foreign patents (but on antitrust-related claims, not infringement): *Mannington Mills* and *Forbo-Giubiasco*.¹⁷³ Both these cases

that a foreign grant of patent is not an act “that would be of substantial concern to the executive branch in its conduct of international affairs.”); see also *Forbo-Giubiasco S.A. v. Congoleum Corp.*, 516 F.Supp. 1210, 1217 (S.D.N.Y. 1981) (applying the reasoning of *Mannington Mills* in the context of a patent license agreement); cf. *Mannington Mills*, 595 F.2d at 1293 (describing governmental action in granting a patent as nothing more than “mere approval,” in the separate context of refusing to recognize the antitrust defense of compulsion by a foreign sovereign).

¹⁷¹ As Professor Chisum argues:

[I]n the United States . . . assessing validity may involve complex issues of law and fact. Courts assume that similar complexities will arise in assessing the validity of a foreign patent. In fact, such difficulties will not often arise. The patentability requirements in other countries are usually more straightforward and less dependent on issues of historic fact than those in the United States.

Chisum, *supra* note 1, at 610–11.

¹⁷² *W.S. Kirkpatrick & Co. v. Env'tl. Tectonics Corp.*, 493 U.S. 400, 406 (1990). The plaintiff in *Kirkpatrick* brought U.S. anti-racketeering charges alleging that defendant, a competitor, had obtained a government contract in Nigeria through bribery. *Id.* at 401–02. To succeed on his claim, plaintiff would have had to show that bribery *did* occur, which might tend to show the Nigerian contract, a sovereign Act of State, was invalid. However, the Supreme Court held the Act of State doctrine was not implicated. *Id.* at 405–06.

¹⁷³ *Mannington Mills*, 595 F.2d at 1290–91; *Forbo-Giubiasco*, 516 F.Supp. at 1217–18.

allowed antitrust claims, alleging fraud was involved in procuring foreign patents.¹⁷⁴ Fraud, if proven, would show that the patents were invalid.¹⁷⁵ Yet in both cases, it was held that the Act of State doctrine did not apply because formal invalidity was not at issue.¹⁷⁶ Similarly, an invalidity defense to a claim of foreign patent infringement, given *inter partes* effect, would not implicate the Act of State doctrine.¹⁷⁷

2. Comity: Two Perspectives

Unlike its fairness arguments, which touched upon the real problem of adjudication of foreign patent validity, the Federal Circuit's comity-based arguments do not provide any genuine reasons for declining supplemental jurisdiction. In the majority's view, the mere *adjudication* of an infringement claim based on a foreign patent, even where patent validity is not an issue, offends comity.¹⁷⁸ But the *Voda* decision provides no compelling reason, let alone a coherent framework for analysis, in reaching this conclusion. It merely speaks of "the spirit of cooperation" and the potential for "prejudice to the rights of the other governments."¹⁷⁹

At best, the *Voda* majority confuses two key distinctions: the dichotomy between local and transitory causes of action, and the difference between territorial and extraterritorial application of U.S. law. At worst, its position on international comity is inconsistent with the position taken in prior Federal Circuit case

¹⁷⁴ *Mannington Mills*, 595 F.2d at 1289; *Forbo-Giubiasco*, 516 F.Supp. at 1217.

¹⁷⁵ The specifics, of course, would depend on national law in the country where the patents were obtained.

¹⁷⁶ *Mannington Mills*, 595 F.2d at 1290–91; *Forbo-Giubiasco*, 516 F.Supp. at 1217.

¹⁷⁷ *Kirkpatrick*, *Mannington Mills*, and *Forbo-Giubiasco* are, perhaps, distinguishable from the *inter partes* approach on the ground that they all involved directly passing judgment upon *acts of a private party* in their relations with a foreign sovereign and not upon the act of the sovereign itself. However, this does not change the fact that the "act" whose validity the Act of State doctrine protects is construed extremely narrowly and that the *inter partes* approach declares nothing formally invalid. Incidentally, the facts *Kirkpatrick* seems to encompass finding of wrongdoing on the part of the foreign sovereign, not just the private party—bribery is a two way street.

¹⁷⁸ *Voda v. Cordis Corp.*, 476 F.3d 887, 902 (Fed. Cir. 2007).

¹⁷⁹ *Id.* at 900 (citing *Emory v. Grenough*, 3 U.S. (3Dall.) 369, 370 (1797) (emphasis removed)). Harold Maier's observation that "the label 'comity' in modern times has sometimes come to serve as a substitute for analysis" seems particularly relevant here. Maier, *supra* note 18, at 281. The Federal Circuit took an "anything goes" approach to its analysis of comity, which also happens to be the longest discussion out of the four *City of Chicago* factors.

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law and ignores the reality of the international legal landscape. This section analyzes the problems with *Voda's* comity argument and suggests why the doctrine of comity might actually point in *favor* of assuming jurisdiction over foreign patents.

a. The Federal Circuit's "Comity" Unraveled

There are many incoherent parts to the court's comity analysis; many of the factors it lists before it gets to its central rationale of "prejudice" are simply irrelevant,¹⁸⁰ or seem better suited to other sections of the § 1367(c) analysis, such as convenience or judicial economy.¹⁸¹ The court seems to be making the point that foreign patent litigation would not *help*, and has the potential to *hurt*, the concerns of comity.¹⁸² But the most bewildering part is the Federal Circuit's entirely inapposite analogy to the local action doctrine.¹⁸³ The crux of Judge Gajarsa's oblique local-action argument is apparently as follows: (1) foreign patent law is complex, (2) foreign countries have established particular

¹⁸⁰ The majority inexplicably spends nearly an entire paragraph discussing the "territorially limited nature of patent rights." *Voda*, 476 F.3d at 902. Of course patent law is territorial; of course it should not apply to acts that occur outside of the national boundaries. And as noted in the Introduction to this paper, existing U.S. patent law arguably violates this territoriality principle in a number of ways. But that says nothing about the *forum* in which this territorial right may be heard. Also irrelevant is the mention of a lack of international duty to adjudicate foreign patents. The Paris Convention, the PCT, and TRIPs are silent on the issue because it was obviously not contemplated at the time they were entered into. The lack of any duty also implies a corresponding lack of any *prohibition* against such adjudication, which the Court does not bother to mention.

¹⁸¹ Included in the "smorgasbord" of reasons why foreign patent claims violate comity is that *Voda* has not shown it would be more convenient or that foreign courts would not protect his rights. How these considerations go towards the "spirit of comity," rather than considerations of convenience or judicial economy, is unclear.

¹⁸² See *Voda*, 476 F.3d at 902 ("Because the purpose underlying comity is not furthered and potentially hindered in this case, adjudication of *Voda's* foreign patent infringement claims should be left to the sovereigns that create the property rights in the first instance.").

¹⁸³ The court concedes that patent infringement is not, per se, a "local action," yet it argues that it should be considered, in essence, a *quasi*-local action. From a theoretical standpoint, this does not make sense. For one, as Part I explains, the opposite of a local action is, by definition, a transitory action. Furthermore, if one takes into account the fact that the Federal Circuit is objecting here only to the *application* of foreign patent law, and *not* the invalidity adjudication issue (which Part I explains is the main reason patent infringement claims are not treated as transitory causes of action), patent infringement then becomes just a species of tort, which is most certainly a transitory action.

institutions with the singular expertise to interpret and apply their complex patent laws, and therefore, (3) assuming jurisdiction over these complex foreign patent claims might “disrupt” the functioning of those institutions, contrary to the “spirit of cooperation” underlying comity.¹⁸⁴ It is flawed not only because patent infringement is not a “local” action,¹⁸⁵ but also because it presents no real objection to foreign patent claims.

Applying foreign patent law will not “disrupt” the functioning of foreign institutions. As Judge Newman and the Supreme Court both note, American courts apply foreign law in a wide variety of areas all the time; apart from the invalidity adjudication issue, which *Voda* does *not* bring into play under considerations of “comity,” patent law should be no different. Furthermore, adjudicating foreign patent infringement claims will not “disrupt” the patent law doctrines of a particular foreign country from being uniformly interpreted. American judgments (a) are obviously non-precedential in foreign countries and (b) only affect rights as between the *private parties* before the court. Nor does claim construction, which is not binding in a non-mutual collateral estoppel sense, have a permanent effect on the claims of a patent or present any other special problems. Stripped of these potential objections, the Federal Circuit’s argument boils down to the complaint that foreign patent law is too complex. This alone should not be sufficient to deny supplemental jurisdiction in all cases.¹⁸⁶

The fact that a number of cases in foreign courts have treated U.S. patent infringement claims as transitory causes of action casts doubt on whether comity is being violated in the first instance. Judge Newman’s dissent, for example, cites the 2003 *K.K. Coral* case, in which a Japanese court decided, in a declaratory action for a finding of non-infringement and injunctive relief, whether one Japanese company infringed the U.S. patent of another under U.S. law.¹⁸⁷ Finding that

¹⁸⁴ *Voda v. Cordis Corp.*, 476 F.3d 887, 902–03 (Fed. Cir. 2007).

¹⁸⁵ *Voda*, 476 F.3d at 902; *see supra*, Part I.

¹⁸⁶ *Cf.* *Piper Aircraft Co. v. Reyno*, 454 U.S. 235, 260 (1981) (holding that the difficulty of applying foreign law may be one consideration in deciding *forum non conveniens*, but is not alone sufficient to warrant dismissal). *But see* Wegner, *supra* note 4, at 20 (suggesting that particularly complicated areas of foreign patent law might be “difficult if not an impossible imposition on the workload of a court to sort through the various foreign laws to reach a proper conclusion”).

¹⁸⁷ *Voda*, 476 F.3d at 917 (citing to *K. K. Coral Corp. v. Marine Bio K. K.*,

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jurisdiction was warranted on the basis of “equity between parties,”¹⁸⁸ the court in *K.K. Coral* performed a full claim construction and infringement analysis of the U.S. patent, including interpretation of the technical claim terms,¹⁸⁹ application of prosecution history estoppel,¹⁹⁰ and examination of whether a particular equivalent had been surrendered under the doctrine of equivalents laid out in *Festo*.¹⁹¹ A similar doctrine of equivalents issue was decided in the English case of *Celltech Chiroscience*, in the context of a licensing dispute.¹⁹² Presently, it seems as though these cases have caused no concern or uproar in the U.S., no retaliatory action from United States courts; in fact they seem to have been barely noticed. It is clear that issues of infringement affect primarily issues among private parties, not

Case No.1943(wa)/2002 (Tokyo District Court, Oct. 16, 2003)). In that case, *K. K. Coral* brought an action for a declaration that its coral powder health product did not infringe *Marine Bio's* U.S. patent due to actions and sales in the state of Nevada. See Claire Wan-Chiung Cheng, Comparative Analysis of the Extraterritorial Reach of Patent Law at 10–11 (Spring 2007) (unpublished manuscript, on file with the Albany Law Journal of Science and Technology) (translating much of the original opinion from the original Japanese text) [hereinafter “Cheng, Comparative Analysis”]. Fascinatingly, defendant/patentee Marine Bio *did* raise an objection that jurisdiction was not proper because of the existence of the invalidity defense under 35 U.S.C. § 282(2), but the Japanese court rejected that argument. In fact, it explicitly decided that 35 U.S.C. § 282, which states the presumption of validity in United States law does *not* give rise to exclusive jurisdiction in the U.S. See 35 U.S.C. § 282(2) (2000); Cheng, Comparative Analysis at 14. The court then satisfied itself that an *inter partes* approach to invalidity would resolve the issue. See *id.* at 14.

¹⁸⁸ The court noted that there was “no law or well-established custom law in terms of cross-border jurisdiction,” but found that “the principles of equity between parties, and fair and speedy trial,” in the absence of exceptional circumstances, gave rise to jurisdiction. See Cheng, Comparative Analysis, *supra* note 187, at 12–13.

¹⁸⁹ *Id.* at 20 (“The discussion then centered on two elements: (A) coral sand; and (B) a particle size passing about 150 to 500 mesh.”)

¹⁹⁰ *Id.* at 21–22 (“During the prosecution, ‘a particle size passing about 150 to 500 mesh’ was added to the claim . . . the court found Marine Bio’s statement irrevocable.”).

¹⁹¹ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 739–40 (2002).

¹⁹² See *Celltech Chiroscience Ltd. v. Medimmune* [2002] EWHC 2167 (Pat) 1008, [1], [4], [8] (Eng.) (arising within context of a license, containing an English choice of law and jurisdiction clause, which required the defendant licensee to pay a royalty to the claimant upon sales covered by a U.S. patent) available at <http://www.bailii.org/ew/cases/EWHC/Patents/2002/2167.html>; see also John Lambert, *Case Note: Celltech Chiroscience Ltd. v Medimmune Inc.*, <http://www.ipit-update.com/pat23.htm> (last visited April 2, 2008) (discussing *Celltech Chiroscience Ltd. v. Medimmune Inc.*).

comity among nations. Furthermore, the fact that these foreign courts have successfully applied one of the most arguably difficult doctrines in U.S. patent law (and in the *K.K. Coral* case, across a language barrier) indicates that U.S. courts should be just as competent in deciding similar issues under foreign patent law.

Perhaps the biggest problem with the Federal Circuit's sudden attention to comity is that it is inconsistent with its prior decisions in *NTP v. RIM*,¹⁹³ *Eolas*,¹⁹⁴ and *AT&T*,¹⁹⁵ all of which extended the *reach* of U.S. patent law to foreign acts.¹⁹⁶ *Voda* speaks forcefully of the principle that we should "avoid unreasonable interference with the sovereign authority of other nations."¹⁹⁷ Yet, is it not true that expanding the coverage of U.S. patent law to include infringements that occur, at least in part, within the sovereign borders of other nations is arguably that kind of unreasonable interference? The Canadian government apparently thought so in *RIM*.¹⁹⁸ Expand the territorial reach of U.S. patent law too far and other countries may begin to push back.¹⁹⁹ In contrast, recognizing that a cause of action for patent infringement is transitory and applying the appropriate foreign patent regime law does not violate comity. On the contrary, it respects the territoriality of patent law, an

¹⁹³ See generally *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1315, 1325–26 (Fed. Cir. 2005).

¹⁹⁴ See generally *Eolas Techs. Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1327, 1341 (Fed. Cir. 2005).

¹⁹⁵ See generally *AT&T Corp. v. Microsoft Corp.*, 414 F.3d 1366, 1371–72 (Fed. Cir. 2005).

¹⁹⁶ See, e.g., *NTP, Inc.*, 418 F.3d at 1317 (holding that it was proper for a jury to find that use occurred in the United States, despite the fact that acts occurring in Canada); *Eolas Techs. Inc.*, 399 F.3d at 1325, 1338–41; *AT&T*, 414 F.3d at 1369–72.

¹⁹⁷ *Voda v. Cordis Corp.*, 476 F.3d 887, 902 (Fed. Cir. 2007).

¹⁹⁸ See Canada *RIM En Banc Amicus Brief*, *supra* note 6, at 4 (arguing that expansion of U.S. patent law into foreign countries can have an unreasonably detrimental effect on foreign commerce).

¹⁹⁹ Professor Thomas provides excellent examples of this in the antitrust context, where the U.S. extraterritorial regulation of foreign acts has provoked vehement resistance from foreign courts in the form of refusals to enforce injunctions. See Thomas, *supra* note 17, at 316–17 (1996) (offering examples of international reaction to American expansion of patent law); *Accord Note, Predictability and Comity: Towards Common Principles of Extraterritorial Jurisdiction*, 98 HARV. L. REV. 1310, 1321 n.57 (1985) (detailing retaliatory measures in other countries, such as secrecy statutes, blocking statutes, and 'clawback' statutes, which were enacted to guard against extraterritorial application of antitrust law by the U.S. and other nations).

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expectation that is itself embedded in international comity.²⁰⁰

b. Comity as an Obligation “To Do Justice” to Individual Parties

The *Voda* majority *is* correct (and Judge Newman is wrong on this point) in recognizing that considerations of comity are relevant—though perhaps they do not belong in the § 1367(c) supplemental jurisdiction analysis.²⁰¹ But given the amorphous nature of the concept of international comity,²⁰² what sort of guidance *should* courts draw from it?

Not surprisingly, courts and commentators cannot even agree on a definition for “comity.”²⁰³ On a broad level, it is accepted that the comity doctrine requires, where two or more sovereigns have concurrent jurisdiction, that a judge seeking to adjudicate international issues balance national and foreign interests; it is also recognized that the balancing is a one-sided and uncertain exercise.²⁰⁴ Much of the literature on international comity focuses on the *extraterritorial* application of U.S. antitrust and regulatory law, and is not entirely relevant here.²⁰⁵ However, it

²⁰⁰ See Maier, *supra* note 18, at 282 (noting the considerations of international comity underlying the territoriality principle).

²⁰¹ As noted earlier in passing, the *City of Chicago* case cited “comity” in the state law context, which is an entirely different proposition. See *City of Chi. v. Int’l Coll. of Surgeons*, 522 U.S. 156, 173 (1997) (discussing issues of comity in the context of state law).

²⁰² See Brian Pearce, *The Comity Doctrine as a Barrier to Jurisdiction: A U.S.–E.U. Comparison*, 30 STAN. J. INT’L L. 525, 547 (Summer 1994) (providing a broad look at the development comity doctrine, including its American origins “as the foundation for both the international order and the federal system”); see also Maier, *supra* note 18, at 281–82 (discussing the development of the comity doctrine). Maier cites Justice Story’s writings as the genesis of thinking on comity in the U.S.; he argues that Story’s usages of the term include both the ad-hoc, politically driven version of comity that American courts use today, and a second, more legally principled usage, which pragmatically applies comity with an eye towards an efficient functioning of the international system. See *generally id.* at 282–85.

²⁰³ See N. Jansen Calamita, *Rethinking Comity: Towards a Coherent Treatment of International Parallel Proceedings*, 27 PA. J. INT’L ECON. L. 601, 614 (noting that “the only practical meaning of ‘international comity’ in the current case law is its role as a signal to litigants that the court will engage in some sort of ad hoc balancing in reaching its decision”).

²⁰⁴ See Maier, *supra* note 18, at 317 (stating that “[a] unilateral decision maker cannot simulate intellectually the international process of demand, response, and compromise . . . operative in the international law formation process.”)

²⁰⁵ See, e.g., Maier, *supra* note 18, at 281; *Predictability and Comity*, *supra* note 199, at 1311; Calamita, *supra* note 203, at, at 615; Pearce, *supra* note 202, at 547.

is clear that considerations of comity need not always result in a court declining to hear claims under foreign patent law.

Towards this end, a number of guiding principles can be discerned. First, Professor Maier advocates strongly for an approach that takes into account the needs of the international system.²⁰⁶ Thus, accepting or declining jurisdiction must be done with an eye towards whether the outcomes will ultimately be efficient on a worldwide scale; in the words of one commentator, N. Jansen Calamita, this end of international comity is geared towards the “practical goal of creating an international environment in which transnational commerce can flourish.”²⁰⁷ Calamita further argues that international comity also serves the goal of “doing justice in individual cases,”²⁰⁸ which is accomplished “by facilitating the application of the law most appropriate to the parties’ dispute, even if it happens to be foreign.”²⁰⁹ At least in some cases, this approach to comity will argue *for*, not against, the assertion of jurisdiction by U.S. district courts over foreign patent infringement claims.²¹⁰

3. The Future After *Voda*

The Federal Circuit denied rehearing and rehearing *en banc* in May 2007.²¹¹ Given that *Voda* is now the law of the Federal Circuit, what options are left for bringing consolidated

²⁰⁶ See Maier, *supra* note 18, at 296 (advocating a system respectful of international needs).

²⁰⁷ Calamita, *supra* note 203, at 617.

²⁰⁸ *Id.* at 617.

²⁰⁹ *Id.* at 622 (tying the argument about comity into the writings of seventeenth century Dutch thinker Ulrich Huber).

²¹⁰ On this point, note Professor Harold Wegner’s observation that:

. . . it must be admitted that where judicial workload is viewed *from the standpoint of a single case* that transnational jurisdiction in intellectual property law does impose some extra work. Yet, if one compares the burden on the collective judicial systems of, say, 100 countries in the enforcement of a pioneer patent, clearly having one court decide the case is in the greatest interest of judicial economy.

Wegner, *supra* note 4, at 32. Situations in which transitory patent actions might be particularly appropriate are examined in Part V, *infra*.

²¹¹ See *Voda v. Cordis Corp.*, 2007 U.S. App. LEXIS 12955 at *1-3 (Fed. Cir. filed April 9, 2007) (noting that Judge Newman would rehear the appeal *en banc*). It also appears that the plaintiff decided not to seek certiorari review; no certiorari briefs are available from electronic sources. See also United States Supreme Court, Granted & Noted List, October Term 2007, <http://www.supremecourtus.gov/orders/07grantednotedlist.pdf> (not listing *Voda* not among cases for which certiorari was granted). For now, *Voda* remains the law.

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multinational patent proceedings in U.S. courts? The two alternatives appear to be working within the *Voda* framework for supplemental jurisdiction; or avoiding *Voda* and supplemental jurisdiction entirely by bringing foreign patent claims under § 1332 diversity jurisdiction.²¹² As explained below, since the only real exception to the rule stated by the *Voda* majority presents a chicken-and-egg problem of insufficient empirical evidence, federal diversity jurisdiction, and perhaps state court jurisdiction, remain the only viable choices.

a. Living With *Voda*: Can We Obtain Empirical Evidence of Judicial Economy & Convenience?

The Federal Circuit left open two narrow possibilities for changing the § 1367(c) balancing equation, which ordinarily should “compel” district courts to decline jurisdiction over foreign patents. The first, if circumstances change or “if the United States were to enter into a new international patent treaty,”²¹³ is entirely a nonstarter. On the other hand, what about “events during litigation [that] alter a district court’s conclusions regarding comity, judicial economy, convenience, or fairness?”²¹⁴ At first blush, this seems like a real possibility. The *City of Chicago* considerations, which will probably be applied like a four-factor test, even though the Federal Circuit emphasizes they comprise a nonexhaustive list, are not created equal. Even though the comity and fairness factors are normative factors, which are unlikely to change during litigation,²¹⁵ the remaining two factors of convenience and judicial economy are essentially

²¹² While reversing the supplemental jurisdiction rule laid out in *Voda* is a third option, it will have to happen in a different case. Significantly, if the Federal Circuit ever revisits the § 1367(c) issue and overturns the *Voda* majority’s statutory construction, it may be compelled to address the narrow scope given to § 1367(a) by *Mars*, which is also still good law. *See Voda v. Cordis Corp.*, 476 F.3d 887, 895 (Fed. Cir. 2007) (discussing the “common nucleus of operative fact” test in the context of *Mars*). Additionally, in her *Voda* dissent, Judge Newman points to the Supreme Court’s recent inclination to harmonize the rules for patent law with those in other areas of law, which may eventually lead the Court to address supplemental jurisdiction in this context. *See Voda*, 476 F.3d at 910 (discussing the arguments supported by proponents of patent law harmonization).

²¹³ *Id.* at 905.

²¹⁴ *Id.*

²¹⁵ Obviously, Dr. *Voda*’s protest that no comity conflict existed in the *current* case fell upon deaf ears at the Federal Circuit.

empirical in nature.²¹⁶ This insight explains why the majority opinion did not explicitly hold that the judicial economy and convenience factors always require that jurisdiction be declined, but rather that the district court's failure to consider them was an abuse of discretion.²¹⁷

The logical solution, then, would be to obtain empirical evidence on the efficiency and convenience advantages of multinational patent litigation. Comprehensive studies on the cost of litigating all patents in one consolidated proceeding versus in a series of individual adjudications, the cost of obtaining and translating foreign legal documents, the cost and scope of foreign discovery, or the cost of retaining foreign patent experts, would all help put a more definite face on those two factors. Ideally, these studies could then be buttressed by individual judicial findings on the particular facts of a case that such consolidated proceedings would be both convenient and efficient for both the justice system *and* for private parties. Together, they might make a compelling case for multinational patent adjudication on the Federal Circuit's own terms.

There is only one problem with this solution: it cannot be accomplished through the use of § 1367(c) supplemental subject matter jurisdiction. This is a chicken-and-the-egg problem. Empirical evidence about the efficiency of adjudicating foreign patents can only be gathered when U.S. courts are actually adjudicating foreign patents, but it is impossible to acquire such data unless there is jurisdiction, which under § 1367(c) in turn requires empirical evidence to alter the balancing analysis. To take the example of *Voda* itself, proceedings related to the foreign patent claims were stayed while the U.S. patents were tried before a jury; yet there is no indication that by hearing the U.S. patent claims, Judge Leonard's court gained any insight on whether hearing the related foreign patent claims would be convenient or efficient.

²¹⁶ See *Voda*, 476 F.3d at 903–04 (overruling a court's decision because it did not meet the minimum requirement of any analysis on the issues of judicial economy and convenience).

²¹⁷ *Id.* at 903 (concluding that comity, and to a lesser extent, fairness, clearly pointed towards declining jurisdiction even in the absence of analysis of those factors by the district court, but only noting that “the district court did not articulate any such judicial economy analysis” and “the district court did not articulate any such analysis [of the convenience factor]”).

b. Diversity and Beyond

Voda, of course, did not address the other option for basing jurisdiction over foreign patent claims in federal court. As the court in *Mars* was aware, nothing precludes a plaintiff who has been denied supplemental jurisdiction over his foreign patent claims from re-pleading those causes of action under diversity jurisdiction.²¹⁸ At first blush, this merely shifts the battleground over foreign patents from supplemental jurisdiction to the *forum non conveniens* doctrine.²¹⁹ But as noted previously, the Federal Circuit will have even more difficulty molding *forum non conveniens* doctrine into a tool of blanket denial of jurisdiction over foreign patent litigation than it did in its construction of § 1367(c). Moreover, there remains the practical difficulty that *forum non conveniens* might also require the dismissal of an entire case, U.S. patent claims included, not just the dismissal of foreign claims.²²⁰ In any case, *Mars*' incomplete dicta about the *forum non conveniens* public factors in that particular litigation will not suffice as a general rule.²²¹

The diversity route has already proven viable as a jurisdictional workaround. Less than two months after *Voda* was issued, an Ohio district court in the case of *Baker-Bauman v. Walker* denied a motion to dismiss a plaintiff's foreign patent claims on the grounds that there was complete diversity between the parties.²²² *Baker-Bauman* correctly distinguished *Voda* as a decision about supplemental jurisdiction, not about diversity;²²³ while the plaintiff also argued that § 1367 supplemental jurisdiction existed in spite of *Voda*, the court wisely chose to

²¹⁸ See *Mars, Inc.*, 24 F.3d at 1375 n.5, 1376 (Fed. Cir. 1994) (acknowledging the availability of diversity jurisdiction but characterizing any attempt to replead on that jurisdictional ground as "ill founded," given the threat of dismissal pursuant to *forum non conveniens*).

²¹⁹ See sources cited *supra* notes 85, 157–58.

²²⁰ See sources cited *supra* note 85 (noting the need to determine the existence of an adequate alternative forum prior to dismissal); 158 (discussing how *forum non conveniens* is typically used to dismiss an entire case).

²²¹ *Mars*, 24 F.3d at 1376 (Fed. Cir. 1994).

²²² *Baker-Bauman v. Walker*, No. 3:06cv017, 2007 WL 1026436 (S.D. Ohio March 29, 2007). In *Baker-Bauman*, the plaintiff alleged infringement of two U.S. patents, an Australian patent, and a Chinese patent; the defendant brought a motion to dismiss only the foreign patent claims. *Id.*

²²³ *Id.* at *1 & n.6 (further characterizing *Stein Assoc., Inc. v. Heat & Control, Inc.*, 748 F.2d 653 (Fed. Cir. 1984) as inapposite to the issue of diversity jurisdiction).

avoid the issue.²²⁴ Furthermore, perhaps recognizing the problematic nature of that doctrine, the defendants in *Baker-Bauman* declined to seek dismissal of the foreign patent claims under *forum non conveniens*.²²⁵

Moving beyond *federal* diversity jurisdiction, foreign patent claims could conceivably be asserted (by themselves, stripped of any accompanying U.S. patent claims) in *state* trial courts because foreign law normally lies outside the limited original jurisdiction of the federal courts.²²⁶ Similarly, foreign patent claims, pled alone in federal court under diversity jurisdiction, might on appeal be handled by a regional Circuit Court other than the Federal Circuit.²²⁷ These bewildering possibilities are simply a result of the lack of uniformity in U.S. law for recognizing and applying foreign law.²²⁸

²²⁴ *Id.* at *1 n.1 (“[T]his Court need not decide whether it can exercise supplemental jurisdiction over the foreign patent infringement claims, given that it concludes that it can exercise diversity jurisdiction.”). Supplemental jurisdiction was not at issue in the first place in *Baker-Bauman* because plaintiff had not pleaded it in his complaint. *Id.*

²²⁵ *Id.* at *1.

²²⁶ *See* *Voda v. Cordis Corp.*, 476 F.3d 887, 894 (Fed. Cir. 2007).

²²⁷ In provocative comments made at a patent law conference, Federal District Court Judge Avern Cohn noted that

[Y]ou would immediately understand that thousands of state court trial judges have the same jurisdiction as I have. When I have diversity jurisdiction, a state court judge can have jurisdiction in the same case. If I exercise supplemental jurisdiction, it is likely a state court judge also has jurisdiction in the case.

He continued:

Maybe a bright, imaginative patent lawyer will bring one of these cases in a state court someplace. He, or she, might get a state court judge who is also imaginative, like the judge who says . . . “[t]here’s nothing in the statutes in my state that says I can’t and we’ll see what happens.” That is the way it might get started. This will stir things up.

Avern Cohn, Judge, E.D.Mich., A Federal Court Perspective on Extraterritorial Enforcement of Intellectual Property, Presentation before the 2000 High Technology Summit Conference at the University of Washington, Seattle (2000), in CASRIP PUBL’N SERIES: RETHINKING INT’L INTELL. PROP., No. 6 at 31, 33, *available* at <http://www.law.washington.edu/CASRIP/Symposium/Number6/Cohn.pdf>.

²²⁸ *See e.g.* Blumer, *supra* note 1, at 380 (explaining that since recognition and enforcement of foreign judgments is generally viewed as a matter of state law since it is not a federal question). Indeed, the Tokyo District Court in the Japanese *K.K. Coral* case looked to the law of the state of Nevada, (which was where the infringement of the patent occurred), not to federal law, to determine whether a Japanese judgment would be recognized and enforced in the U.S. *See* *K. K. Coral Corp. v. Marine Bio K. K.*, Case No.1943(wa)/2002 (Tokyo District Court, Oct. 16, 2003); Cheng, Comparative Analysis, *supra* note 187, at 15 (providing English translation of opinion). For good measure, the *K.K. Coral*

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To summarize, the less-defined options of diversity and state jurisdiction are the most viable paths for future attempts at multinational patent litigation.²²⁹ Exercising them may, in fact, provide the only means to generate the empirical data of efficiency and convenience that could possibly reverse the Federal Circuit's construction of § 1367(c).

V. THE LARGER PICTURE

Just as international patent procurement under the Patent Cooperation Treaty and regional patent offices was only the first step towards a fully effective, international patent regime, *allowing* foreign patent claims to be asserted in U.S. district court is also only a first step towards effective enforcement of those patents. Courts that hear such claims must proceed with caution, as there is plenty of room for mischief. The European experience with consolidated, multinational patent litigation is instructive.²³⁰

Beginning with the Dutch *Interlas* case in 1989, the courts of the Netherlands routinely heard cases for the cross-border enforcement of patent rights.²³¹ These cases were conducted in summary proceedings, known as *kort geding*, which allowed rapidly-obtained preliminary injunction style relief, with no obligation to start proceedings on the merits after an injunction

court also observed that Japan had, on at least one occasion, recognized a judgment made by a Nevada court. Cheng, *Comparative Analysis*, *supra* note 187, at 15.

²²⁹ Nicolas also points to the Alien Tort Statute, which provides original federal jurisdiction over "any civil action by an alien for a tort only, committed in violation of the law of nations or a treaty of the United States," as a potential source of federal jurisdiction. Nicholas, *supra* note 32, at 356 (quoting 28 U.S.C. § 1350 (1994)). This theory of jurisdiction has never been tested, and it would require a *foreign* plaintiff to sue either foreign or U.S. defendants. *Id.*

²³⁰ See generally Arnaud Nuyts, Katarzyna Szychowska, and Nikitas Hatzimhail, University of Brussels, *Cross-Border Litigation in Intellectual Property Matters in Europe* (2006), available at <http://www.ulb.ac.be/droit/ipit/docs/HeidelbergBackgPaper1.pdf> (providing a comprehensive overview of the legal issues of jurisdiction within the European Community under the Brussels I Regulation related to patents, as well as a history of consolidated patent infringement from the first Dutch case in 1989 through the *GAT v. LuK* and *Roche* judgments of July 2006 that effectively ended the practice).

²³¹ Nuyts, *supra* note 227, at 9, 11 (citing Hoge Raad of November 24, 1989 *Nederlandse Jurisprudentie*, 1992.404; BIE, 1991.86 (stating there is no support in law for a restrictive interpretation that could lead to an undesirable result of a plaintiff whose intellectual property rights have been infringed in a cross-border dispute)).

was obtained.²³² Other European courts, including Belgium and Germany, followed suit in the period from 1999–2005.²³³ Until the European Court of Justice ended the practice in 2006,²³⁴ the story of multinational patent infringement cases in the European states was one of jurisdictional abuse and excesses by both rights holders and defendants.²³⁵

To prevent abuses of the multinational patent litigation system, guidelines will be needed to determine the kinds of situations in which it would be proper for district courts to assert subject matter jurisdiction over foreign patents. The federalism considerations that guide discretionary jurisdiction in the state law context are inadequate to guide the jurisdictional analysis on an international scale; so too, do the demands of comity change when relations among foreign sovereigns, not American states, are at issue. The sooner this is recognized, the better.

No matter what form these rules take, the overriding concerns should be comity and efficiency, so that multinational patent litigation is only consolidated in the U.S. when it is beneficial to the parties and jurisdictions involved, and not when the claims might be more conveniently heard elsewhere.²³⁶ The eight criteria suggested in the Law Professors' brief, which include the nationality of the plaintiff, his financial means, and whether the

²³² *Id.* at 12.

²³³ *Id.* at 11.

²³⁴ The ECJ handed down two cases in July 2006, *GAT v. LuK* and *Roche Nederland*, that together effectively ended the possibility of asserting a patent infringement claim outside the country in which the patent was granted. *GAT* held that exclusive jurisdiction for proceedings related to the validity of a patent under Article 16(4) of the Brussels Regulation arises even when validity is pled as a counterclaim; thus, an infringement claim must be transferred to the country in which the patent was granted whenever the defendant asserts the defense of invalidity. See Case C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v. Lamellen und Kupplungsbau Beteiligungs KG*, 2006 E.C.R. I-0000, available at <http://curia.europa.eu> (follow "Case Law"; and select "Search Form" hyperlink; then enter "C-4/03" for case number; then click "Submit"; and follow "Judgment" link) (Dutch). *Roche* narrowly interprets and limits the scope of Brussels Convention Article 6(1), allowing jurisdiction over many defendants, to instances where there is "risk of irreconcilable judgments resulting from separate proceedings." Case C-539/03, *Roche Nederland BV v. Frederick Primus, Milton Goldberg*, 2006 E.C.R. I-0000, available at <http://curia.europa.eu> (follow "Case Law"; and select "Search Form" hyperlink; then enter "C-539/03" for case number; then click "Submit"; and follow "Judgment" link) (Dutch). Though the issue is not the same, this bears resemblance to the narrow construction of "common nucleus of operative fact" adopted by the Federal Circuit in *Mars*.

²³⁵ Nuyts, *supra* note 227, at 15–21.

²³⁶ See *infra* Part IV.B.2. (discussing comity).

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foreign patent claims that are sought to be asserted have the same or similar disclosure, prior art, and claim language, are a good start.²³⁷ Similarly, Professor Harold Wegner would examine whether the controversy was essentially one between U.S. entities; he would also limit consolidated multinational infringement to cases in which the foreign patent doctrines at issue are not overly complex or cases in which a “pioneering” invention is at stake.²³⁸ Yet another possibility is the “spider in the web” theory employed by Dutch courts at the tail end of the 1990s.²³⁹ This theory allowed consolidation of patent infringement only when the infringers were related corporate entities with infringement orchestrated by a single entity, i.e., the “spider.”²⁴⁰ Hopefully, the Federal Circuit (or better yet, Congress) will be in a position to promulgate such guidelines, as well as find a proper doctrinal place for them in the U.S. jurisdictional analysis.²⁴¹

Granted, even when U.S. district courts assert such foreign patent claims within the proper parameters, a number of other issues will arise that may prevent fully effective multinational patent adjudication. At least two particularly thorny problems remain. The first is coordination with foreign courts. Mechanisms such as anti-suit injunctions²⁴² and preclusion

²³⁷ See Professors Amicus Brief, *supra* note 14, at 25–28. In the same vein, Professor Wegner would put heavy emphasis on whether both the parties are American and the dispute is “strictly” American in nature, with “global spillover” in the form of damages based upon foreign sales. Wegner, *supra* note 4, at 12.

²³⁸ Wegner, *supra* note 4, at 12, 20. Analogizing, perhaps, to the essentially Japanese dispute in *K.K. Coral*, he asks, “[w]hat possible interest does, say, a Japanese court have in running an expensive and time-consuming trial between two American companies which has little impact on the local scene?” *Id.* at 12. Wegner’s last point is that pioneering inventions are especially deserving of transnational protection, because it would give the U.S. companies that manufacture them an advantage in international commerce versus cheaper foreign imitators (and presumably, a greater incentive to invent). *Id.* at 8, 20.

²³⁹ See Nuyts, *supra* note 227, at 16 (noting the origin of this theory in the Court of Appeals in the Hague in *Expandable Grafts, Ethicon & Cordis Europe v. Boston Scientific*, [1999] F.S.R. 352.) The spider in the web theory fits the fact pattern in *Voda* quite nicely.

²⁴⁰ *Id.*

²⁴¹ In this light, it is quite understandable that the Federal Circuit was tempted to construe § 1367(c) so as to insert considerations of comity, fairness, convenience, and judicial economy into the jurisdictional analysis itself.

²⁴² *Goss Int’l Corp. v. Man Roland Druckmaschinen Aktiengesellschaft*, 491 F.3d 355, 362-363 (8th Cir. 2007) (explaining that an antisuit injunction essentially terminates foreign litigation and “effectively restrict[s] the foreign court’s ability to exercise its jurisdiction”).

doctrines²⁴³ must be implemented to prevent the parties from re-litigating the exact same claims abroad in foreign forums after they are “heard” in U.S. courts.²⁴⁴ And while enforcement of U.S. judgments abroad is likely in most cases (especially if the judgments are limited to *inter partes* injunctions), the U.S., as noted in *Voda*, is not a party to any international treaty that provides for automatic recognition of U.S. judgments abroad.²⁴⁵ At the same time, so long as consolidated multinational patent litigation remains an optional and novel enterprise, and not a mandatory one, there should be no *res judicata* effect imposed abroad where a party could have asserted its foreign patent claims in U.S. court but chooses not to do so.

Secondly, even as *substantive* standards of patent law around the world converge, the vast *procedural* differences among nations may make adjudication of foreign patent claims less than entirely forum-neutral. Professor Chisum astutely observes that the line between “substantive” and “procedural” law is an artificial one, at best; foreign litigants may be especially drawn towards the U.S.’s generous discovery rules, access to courts, and civil jury system, which are not duplicated anywhere else in the world.²⁴⁶ Whether or not the “procedural” advantages or disadvantages of a U.S. or other forum make patent infringement claims less than transitory will remain to be seen.

VI. CONCLUSION

This paper does not seek to definitively outline the scope of consolidated multinational patent litigation; indeed, only experience and time will tell whether this judicial experiment will bear fruit. But as Judge Newman emphasized in her dissent, preclusion and prejudgment are inappropriate and unnecessary—indeed, if diversity and state jurisdiction remain alternative options to supplemental jurisdiction, as that district

²⁴³ *Johnson v. State of Kansas*, 888 F.Supp 1073, 1080 (D. Kan 1995) (explaining that preclusion doctrines prevent a litigant from further pursuing his claim once it has been adjudicated in a court of competent jurisdiction).

²⁴⁴ See Nicolas, *supra* note 32, at 379–83 (discussing at length the need to provide one, and only one, forum to litigate all issues, and the mechanisms that can be used to get there).

²⁴⁵ See generally Blumer, *supra* note 1, at 396.

²⁴⁶ Chisum, *supra* note 1, at 614 (observing that “[t]he theoretical distinction between procedure and substantive right is just that—theoretical” and arguing that this distinction is perhaps the strongest objection to adjudication of foreign patents).

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case suggests, they may well be unworkable. At the very least, considerations of comity and fairness do not point so strongly against jurisdiction as the Federal Circuit has held. In the meantime, helpful guidelines on when and how foreign patents may be heard in our district courts should be the Federal Circuit's primary concern, not finding increasingly futile ways to deny jurisdiction over such claims.

Voda is only a small piece of the puzzle. In the final analysis, foreign patent litigation in U.S. courts may only be a means to an end—the ultimate goal of a worldwide patent, with worldwide enforcement. The European story, which is a few years ahead of ours, may be telling. The foreclosure of cross-border enforcement proceedings within the European Community, at least under the jurisdiction rules of the Brussels Convention, by *Roche Nederland* and *GaT v. LuK* decisions seems to have jump-started long dormant proposals for an effective multinational patent litigation agreement.²⁴⁷ But without the experience the Europeans gained during the roughly seventeen year period in which multinational patent litigation was tried and then abandoned, these collaborative agreements would never have had the chance that they have today.²⁴⁸ Similarly, perhaps the U.S. experience, however it turns out, can generate valuable insight for future discussions of worldwide patent enforcement.

²⁴⁷ Nuyts, *supra* note 230, at 27–29 (describing the European Patent Litigation Agreement proposal as well as the idea of a Community Patent System).

²⁴⁸ See Thomas, *supra* note 20, at 298 (noting that despite a strong start, the deliberations surrounding a Community Patent System in Europe actually began in 1975, but were bogged down and never ratified by some European nations).