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[for submission]

Patent law is inherently territorial; a patent covers infringing activity only within the borders of the nation in which it should be 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 \textit{Voda v. Cordis}, decided by the Federal Circuit in February. \textit{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 \textit{Voda}’s erroneous statutory construction of the federal supplemental jurisdiction statute, 28 U.S.C. \S1367, 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 \textit{Voda}’s ill-informed and narrow treatment of \S1367(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 need to do justice to individual parties are taken into account. Second, since the central obstacle to asserting a foreign patent claim in 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 \textit{Voda} within the worldwide debate on consolidated patent infringement, and attempts to provides 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.\textsuperscript{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.\textsuperscript{2} Even though international and regional patent treaties such as the Patent Cooperation Treaty and the European Patent Convention have made it easier to \textit{obtain} multiple patents abroad for a single invention\textsuperscript{3}, a patent owner must still sue separately in different countries to enforce his rights – a frustratingly inefficient, costly and piecemeal process.\textsuperscript{4} This is true even if the same invention, 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

\begin{itemize}
\item \textsuperscript{2} See generally Mark Lemley, David O’Brien, Ryan M. Kent, Ashok Ramani, and Robert Van Nest, \textit{Divided Infringement Claims}, AIPLA Quarterly Journal, Summer 2005, at 255, 283 ("the international problem of distributed patent claims . . . cannot be solved by simply prosecuting patents in multiple countries. . . . [I]n an ideal world patent law would be fully harmonized and indeed international, not territorial, in nature.")
\item \textsuperscript{4} Harold C. Wegner, Voda v. Cordis: Trans-Border Patent Enforcement, November 17, 2005, (unpublished conference paper, on file with author), at 8 (observing that “the 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 enforcement”). While the Patent Cooperation Treaty (and regional agreements like the European Patent Convention) allow inventors to \textit{obtain} patents in various countries on a single invention based on a single, original filing, they provide no guidance for unified \textit{enforcement} of those patents. As the Federal Circuit’s Judge Newman has observed, “it was perhaps immature to hope that coordinated patent filing would eventually lead to coordinated patent enforcement.” Pauline Newman, On Global Patent Cooperation, 8 Fordham Intell. Prop. Media & Ent. L.J. 3 (1997).
\end{itemize}
infringement. Arguably the U.S. has already begun to do this in §271(f) and §271(g) of the Patent Act, as well as through decisions like *NTP v. Research in Motion*, *Eolas v. Microsoft*, and *AT&T v. Microsoft*. But this option effectively involves policing behavior that occurs abroad. 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, possibly to the detriment of U.S. interests.

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 just months ago by the Federal

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5 35 U.S.C. §271(f) (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); 35 U.S.C. §271(g) (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 (1972). See Pub.L. 98-622, § 101 (1984).

6 For example, in the *NTP v. RIM* case, the Federal Circuit held that RIM’s Blackberry network infringed NTP’s patent even though a crucial step in the Blackberry system involved relaying all its network traffic through a facility in Canada. 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 *Amicus Curiae* of the Government of Canada in Support of the Request for Rehearing En Banc Made in the Combined Petition by Research in Motion, Ltd. for Panel Rehearing and Rehearing en Banc, Jan. 18, 2005, at *2, available at 2005 WL 4798091 [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. § 27 1(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. v. Microsoft Corp.*, 399 F.3d 1325 (Fed. Cir. 2005) and *AT&T Corp. v. Microsoft Corp.*, 414 F.3d 1366 (Fed. Cir. 2005), the Federal Circuit expanded the reach of 35 U.S.C. §271(f) to include the exportation of intangible software.


9 See Harold C. Wegner, A Foreign Square Peg in a Domestic Round Hole: The Eolas-AT&T-Carbide Trilogy, July 18, 2006 (unpublished conference paper, on file with author), at 9-13 (arguing that the “asymmetry” of extraterritorial patent protection effectively forces U.S. research & development offshore, and is bad public policy).
Circuit: *Voda v. Cordis*.\(^{10}\) *Voda* involved a plaintiff who attempted to assert American, British, Canadian, French, German patents, that covered the same invention and arose from a related disclosure filing, in a single proceeding against infringers that were related corporate entities.\(^{11}\) 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.

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 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 they did not succeed. *Voda* made it much more difficult to assert supplemental jurisdiction over foreign patents. However, *diversity* jurisdiction, as well as the possibility of bringing foreign patent claims in *state* courts, still remain viable options to the adventurous plaintiff holding patents in multiple countries. Rather than effectively cutting off one, but not all,

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\(^{10}\) Voda v. Cordis Corp., 476 F.3d 887 (Feb. 1, 2007).

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.12

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 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.

Part 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.13 Furthermore, unlike grants of copyright, the patent right granted in any one country does not automatically confer rights anywhere else.14 This situation is at least partly due to necessity: substantive standards of

12 See Professors Amicus Brief, infra note 83; Thomas, infra note 15, at 346-351.
14 Compare the Berne Convention for the Protection of Literary and Artistic Works, available at http://www.law.cornell.edu/treaties/berne/overview.html, Article 5 (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
patent law still vary significantly from country to country, even though the differences have narrowed significantly due to the 1994 passage of the TRIPs Agreement.16

Clearly, even though territoriality precludes the application of U.S. patent law to cover behavior that would infringe a U.S. patent when that behavior occurs solely in say, Germany, 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.17 It is well established that actions for tort, i.e. for damage against the body or against personal property, are transitory, not local, and that patent infringement is generally considered a species of tort.19 It is also established that other kinds of intellectual property infringement, namely copyright claims, are transitory in

formality”) with the Paris Convention for the Protection of Industrial Property, Article 4bis, available at http://www.wipo.int/treaties/en/ip/paris/trtdocs_wp020.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.”)

15 See John R. Thomas, Litigation Beyond the Technological Frontier: Comparative Approaches to Multinational Patent Enforcement, 27 L. & Policy Int’l Bus. 277, 282-289 (1996) (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.”)

16 See World Trade Organization, GATT Uruguay Round Trade-Related Aspects of Intellectual Property Rights [hereinafter “TRIPs”] Arts. 27-34 (embodying substantive minimum standards for, among other things, the scope of patentable subject matter and of rights held by the patent owner), available at http://www.wto.org/english/docs_e/legal_e/27-trips_04e_e.htm. 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. Paris Convention, footnote 14 supra.

17 See Ortman v. Stanray Corp., 371 F.2d 154, 159-160 (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); Anne Payne, Jurisdiction as to Transitory Actions and Local Actions, 20 Am. Jur. 2d Courts § 81 (discussing the distinction between transitory and local actions generally).

18 See 21 Corpus Juris Secundum Courts §29 (“Where a cause of action can arise in one place only, it is local, but otherwise it is transitory; as a general rule, actions on contract, actions for tort and actions relating to personal property are transitory”), 92A Corpus Juris Secundum Venue §19 (“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”) (footnotes omitted).

19 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.”)
nature. 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.

However, the question is not whether foreign patents may be asserted in the abstract. There is one big reason that courts tend to treat foreign infringement claims differently than other transitory foreign claims – and it is because considerations of validity of the property grant naturally and frequently accompany claims of infringement. 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. But what happens when the grant of right being invalidated is not a U.S. patent, but a German one?

The Vanity Fair case was the first to address the problem of validity of a foreign intellectually property right. 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: that

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21 Id at 47, 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”). The opening paragraph of the opinion contains an error in that it is not the plaintiff’s British copyrights that are being infringed, but its Chilean and other copyright in South American countries.

22 In the patent context, the Blonder-Tongue case imposed nonmutual 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. Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, 402 U.S. 313 (1971).

23 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 FCBA Amicus Brief, infra note 74. The Federal Circuit’s Amicus brief in Voda also observes that many fora, including Germany and Japan, utilize their patent agencies to provide advisory opinions on the scope and construction of patents. Id.

24 Vanity Fair, 234 F.2d at 645-647 (trademark claim).

25 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 Peter Nicholas, The Use of Preclusion Doctrine, Antisuit Injunctions, and Forum Non Conveniens Dismissals in
adjudicating the validity of the Canadian trademark, a property right granted by the Canadian government, would be akin passing judgment on the “validity of the acts of a foreign sovereign done within its borders.” The reasoning of *Vanity Fair* would seem to apply *a fortiori* in the patent context, in which government patent examiners often place a central role in the grant of a patent. 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, 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.

**Part II: The §1367 Supplemental Jurisdiction Debate**

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

*Transnational Intellectual Property Litigation*, 40 Va. J. Int’l L. 331, 359-366 (1999), for 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.

26 *Id.* at 646.

27 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*, 580 F. Supp. at 47 (citing M. Nimmer, 3 Nimmer on Copyright (1982) at 1703).

28 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 Manning Mills, Inc. v. Congoleum Corp., 595 F.2d 1287 (3d Cir. 1979); Forbo Giubiasco v. Congoleum Corp., 516 F. Supp. 1210 (S.D.N.Y. 1981).

29 *See* Nicholas, supra note 25, at 359-66. This argument will be discussed further in Part IV, infra.
to decline jurisdiction over foreign issues. In the Federal Circuit, oddly enough, the battleground in the years leading up to Voda has taken shape within the confines of supplemental jurisdiction doctrine, a doctrine which addresses none of these discretionary, international considerations.

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. The thin caselaw on whether supplemental jurisdiction exists for foreign patents has been framed in large part by two opinions: Ortman v. Stanray and Mars v. Kabushiki-Kaisha Nippon Conlux. Mars and Ortman differ markedly in their overall worldview of supplemental jurisdiction for foreign patents. As they form the background for the decision in Voda, this section examines them in further detail.

1. Ortman v. Stanray Corp.

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30 See, e.g., Vanity Fair Mills Inc. v. T. Eaton Co., 234 F.2d 633 (2d Cir. 1956) (dismissal on forum non conveniens and Act of State grounds, despite assuming jurisdiction); Packard Instrument Co. v. Beckman Instruments, 346 F.Supp. 408 (N.D. Ill. 1972) (dismissal on abstention ground despite assuming subject matter jurisdiction.) This paper argues that comity, Act of State doctrine, and other discretionary doctrines are largely inapposite.

31 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, 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.

32 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). However, some circuits, including the Federal Circuit, hold that §1367 merely codified the Supreme Court precedent on common law pendent jurisdiction in Gibbs, 383 U.S. at 715, and thus the proper test under §1367 in the Federal Circuit is whether there exists a “common nucleus of operative fact.” Id. at 725. See infra section III.1.a for a discussion of how the Federal Circuit has construed §1367 both before and after Voda.

33 Ortman v. Stanray Corp., 371 F.2d 154 (7th Cir. 1967).

In Ortman, a case decided in the Seventh Circuit in 1967\textsuperscript{35}, the plaintiff sued his former exclusive licensee when the latter ceased paying to use the plaintiff’s American and foreign patents.\textsuperscript{36} The defendant moved to dismiss the plaintiff’s Canadian, Mexican and Brazilian patents claims, and the court denied the motion.\textsuperscript{37} 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.\textsuperscript{38} 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.”\textsuperscript{39}

In this procedural posture, Ortman never explicitly found supplemental jurisdiction over the foreign patent claims.\textsuperscript{40} 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.

\begin{itemize}
\item \textsuperscript{35} 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 Part IV.3.a below.
\item \textsuperscript{36} Ortman, 371 F.2d at 155-156. The licensing contract involved actually involved an assignment of the U.S. and foreign patents to defendant Stanray Corp., which were transferred back before litigation began. Id.
\item \textsuperscript{37} Id.
\item \textsuperscript{38} 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.
\item \textsuperscript{39} Id. at 158. It then remanded for a determination of the parties rights under their licensing contract, and then, if appropriate, a pendent jurisdiction analysis.
\item \textsuperscript{40} 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, 437 F.2d 231, 239 (7th Cir. 1971). However, the fact that its earlier opinion involved a motion to dismiss should not have affective its stance regarding a jurisdictional issue.
\end{itemize}

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.” The district court assumed without deciding that it had authority under §1367(a), but then declined to exercise that authority. On appeal, the Federal Circuit reversed, finding that the district court should not have assumed such authority. 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. 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.

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. However, the existence of these factors, and the fact that 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*.

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41 *Mars*, 24 F.3d at 1370.
42 *Id.* at 1374 (citing *United Mine Workers of America v. Gibbs*, 383 U.S. 715 (1966)).
43 *Id.* at 1375. See also *Voda v. Cordis Corp.*, 476 F.3d 887, 894-95 (reiterating the *Mars* holding).
44 Professor Thomas provides a thorough critique of the Federal Circuit’s application of supplemental jurisdiction in *Mars*. Thomas, supra note 15, at 321-325 (“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.”) (footnote omitted).
Part 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.\(^{45}\) 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. 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). 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*.

1. 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.\(^{46}\) He originally filed a patent application with the USPTO in January 1991; a continuation-in-part application, filed in October 1992, was the parent of the three U.S. patents ultimately at issue in this suit, which were issued in 1995, 2000, and 2002.\(^{47}\) To obtain his international registrations, Dr. Voda filed an application under the Patent Cooperation Treaty in January 1992, based upon his original 1991

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\(^{45}\) See Part III.1 infra.

\(^{46}\) Brief for Defendant-Appellant Cordis Corp. [hereinafter Cordis brief], June 6, 2005, at 5. Dr. Voda’s Appellee brief is unavailable on both Westlaw and the Internet, so basic facts and arguments from Cordis’ brief have been used.

\(^{47}\) Id.
application. He designated the European Patent Office and Canada. Prosecution in the EPO lasted from September 1992 until October 2001, and national British, French, and German registrations followed. In Canada, prosecution began in August 1993 and ran until September 1999, when Dr. Voda’s Canadian patent was issued.

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. The accused device was manufactured by Cordis in a single plant controlled by Cordis, and subsequently shipped to those five countries. While the only defendant in this case was the American Cordis Corp., sister Cordis companies existed in the U.K., France, Germany, as well in as Italy and the Netherlands.

Dr. Voda filed his action in the Western District of Oklahoma on October 15, 2003, alleging infringement of his three U.S. patents. Voda then brought a motion to amend his complaint to further assert his Canadian and European patents in the same proceeding. After considering Mars, the 1994 Federal Circuit case, and Ortman, the 1967 Seventh Circuit case, Judge Leonard of the district court ruled that the court had supplemental jurisdiction over the foreign claims and allowed the amended complaint. Defendant Cordis then brought a motion for interlocutory appeal; the district court certified the issue and stayed the proceedings with

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48 Id. at 8.
49 Id. at 9.
50 Id. at 10.
51 Id. at 11.
52 Voda v. Cordis Corp., 476 F.3d at 910-911 (Newman, J. dissenting); Cordis brief, supra note 46, at 4-12. Prior to 2001, the plant was located in Florida, and afterwards moved to Mexico.
53 Voda,476 F.3d at 890 & n.1.
respect to the foreign patent claims.\textsuperscript{57} The Federal Circuit, citing “the paucity of law surrounding this issue,” granted permission to appeal in February 2005.\textsuperscript{58} (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.\textsuperscript{59})

2. 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 \textit{never} be exercised over foreign patent claims.\textsuperscript{60} Analyzing the handful of cases to broach the issue, including \textit{Mars} and \textit{Ortman}, Cordis noted that none of them, even \textit{Ortman}, had explicitly found supplemental jurisdiction over foreign patent claims, and that some declined to exercise such jurisdiction even where it had been assumed.\textsuperscript{61} Cordis also asserted that differences in the scope and structure of the foreign patent claims, as well as in the applicable patent regimes under which those patents were obtained,

\textsuperscript{59} Voda v. Cordis Corp. (W.D. Okla. Sept. 5, 2006), 2006 WL 2570614, at *1, *5. The jury awarded a reasonable royalty. The jury also found the infringement was willful, and the district court granted increased (but not trebled) damages. The court then denied a permanent injunction because Voda did not practice the invention, though it was practiced by Voda’s exclusive licensee, who was not a co-plaintiff. See Voda v. Cordis Corp., No. CIV-03-1512-L, judgment (W.D. Okla. May 25, 2006); DARRYL J. ADAMS, DEWEY BALLANTINE, WHITE PAPER, UPDATE ON POST-EBAY PERMANENT INJUNCTION CASES (March 7, 2007), at *3, available at http://www.deweyballantine.com/docs/publications/2096.pdf?u=%22Update%20On%20Post-eBay%20Permanent%20Injunction%20Cases%22.pdf.
\textsuperscript{60} 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. \textit{Voda}, 2006 WL 2570614 at *1. Cordis Brief, supra note 46, at 22-31. While Cordis noted that the proper standard for §1367 supplemental jurisdiction over \textit{state} claims in the Federal Circuit is the “common nucleus of operative fact” test from \textit{United Mine Workers v. Gibbs}, 383 U.S. 715 (1966), it argued that this test did not apply at all when \textit{foreign} law, not state law, was at issue. Cordis Brief, supra note 46, at 21-22. This ignored the Federal Circuit’s 1994 \textit{Mars} precedent, which clearly applied the \textit{Gibbs} standard, not the literal language of the §1367 statute, in its analysis of supplemental jurisdiction over Japanese patent claims. \textit{Mars}, 24 F.3d at 1374-1376. Cordis went that the literal language of §1367(a) could \textit{never} support jurisdiction over foreign patents as “so related” to form “part of the same case or controversy.”
\textsuperscript{61} Id. (citing Packard Instrum. Co. v. Becker Instrum. Inc., 346 F. Supp. 408 (D. Ill. 1972)).
meant the trial court would have to effectively conduct five separate trials if it allowed supplemental jurisdiction over them.\textsuperscript{62}

\textsuperscript{62} Cordis Brief, supra note 46, at 10-11, 50-51.
To supplement these arguments, Cordis devoted nearly a quarter of its brief to “public policy” issues. First, it argued that international comity, the “elephant in the room,” counseled against applying foreign patent law, which is “best [be] understood by local tribunals.” It also argued, as a matter of comity, that U.S. courts should avoid ruling on the validity of foreign patents, as well. 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.

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). 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.

In contrast, Dr. Voda’s appellee brief argued for a broad view of supplemental jurisdiction. Unsurprisingly, Voda asserted that both the literal language of §1367(a) and the

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63 Id. at 32-48.
64 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. It also supplemented that argument with an argument based on the Act of State doctrine, suggested by several amici below.
65 Id. at 40-43.
66 Id. at 51-54.
67 Id. at 46-47. This argument is lifted straight from the Mars opinion. See 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 dicta. First, the Federal Circuit’s forum non analysis was incomplete, as it did not consider the private factors or confirm the existence of an adequate alternative forum. Second, forum non conveniens typically entails the dismissal of an entire action, not the dismissal of a single claim based on foreign law. See infra note 128.
68 I could not find Voda’s appellee brief either on Westlaw or on the Internet. This summary is derived from the undoubtedly skewed account of Voda’s arguments in Cordis’ reply brief.
Gibbs test supported supplemental jurisdiction over foreign patents. Voda drew an analogy to the copyright context, where U.S. courts have regularly exercised such supplemental jurisdiction under §1367 over foreign copyright claims. 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.

Voda v. Cordis also received a great deal of attention in the patent world, attracting five amicus briefs. 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, the Federal Circuit Bar Association, the Intellectual Property Owners Association, and the U.S. government sounded many of the same policy alarms as Cordis, such as international comity, judicial economy, fairness, and convenience. They also raised another ground closely related to comity – the Act of State doctrine, mentioned in Part I supra, “which broadly precludes federal

69 The Federal Circuit is one of the circuits which hold 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.” See Mars Inc. v. Kabushiki-Kaisha Nippon Conlux, 24 F.3d 1368, 1374-1376 (Fed. Cir. 1994).
71 Id. at 17 (citing, inter alia, London Film Prods. v. Intercontinental Comm’ns, Inc., 580 F. Supp. 47 (S.D.N.Y. 1984)).
72 Id. at 19-20.
76 Brief for the United States as Amicus Curiae In Support of the Appellant, June 15, 2005 [hereinafter Government Amicus Brief].
77 See AIPLA Amicus Brief at 5, 15, 19; IPO Amicus Brief at 15-23; FCBA Amicus Brief at 10-14; Government Amicus Brief at 16.
courts from determining ‘the validity of the acts of a foreign sovereign done within its borders.’” 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.

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. AIPLA also expressed the fear that allowing foreign patent claims under §1367, by “increasing 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. 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.

The final amicus brief, filed by a group of patent law professors in support of Dr. Voda, provided an important counterweight to the one-sided comity and act-of-state arguments made by Cordis and the four other amici. It 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

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78 See, e.g., AIPLA Amicus Brief at 17, IPO Amicus Brief at 15-21, FCBA Amicus Brief at 12-14.
79 See sources supra note 78. As discussed below, the Federal Circuit explicitly relied on this ground in its majority opinion. Voda v. Cordis, No. 05-1238, Slip. Op., at 28-29.
80 AIPLA argued that §1367 should be construed narrowly to cover only actions that occur in the United States and in order to avoid “difficult Constitutional questions” (none of which AIPLA bothered to enumerate.) AIPLA Amicus Brief at 4-10. 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.
81 Id. at 14.
82 IPO Amicus Brief at 9-15.
83 Brief for Amici Curiae Law Professors In Support of the Appellee, July 29, 2005 [hereinafter Professors Amicus Brief] (Professors Christopher Cotropia, Grame B. Dinwoodie, Jay P. Kesan, Mark A. Lemley, and John R. Thomas.)
as *NTP v. RIM*, was arguably more controversial, and less justifiable under comity, than the supplemental jurisdiction approach. 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.” 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.) 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. This paper will argue that this workaround is a sufficient alternative to the problem of adjudicating foreign patent validity in Part IV, infra.

3. 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.) However, *Voda* is at once a very broad decision, and a surprisingly narrow one. In reversing the district court’s off-the-cuff finding of supplemental jurisdiction, the majority opinion, written by Judge Gajarsa, did not decide whether Voda’s U.S. and foreign patent infringement claims

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84 *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.)
85 *Id.* at 23.
87 *Id.* 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 18-21.
88 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.*, 2004 WL 3392022 (W.D. Okla. Aug. 2, 2004), at *1.
formed a “common nucleus of operative fact” sufficient to sustain supplemental jurisdiction.\textsuperscript{89} Nor did it decide whether Voda could assert his foreign patents on the strength of federal diversity jurisdiction.\textsuperscript{90} 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.

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.\textsuperscript{91} Before examining the court’s reasoning in that section, however, a discussion of how §1367 as construed by the Federal Circuit in \textit{Voda} is in order.

\textbf{a. 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.\textsuperscript{92}

In relevant part, it states:

\textit{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 the same case or controversy under Article III of the United States Constitution . . .}


The Federal Circuit has held that this language incorporates the old standard for pendent or ancillary jurisdiction under \textit{United Mine Workers of Am. v. Gibbs}, 383 U.S. 715, 725 (1966).\textsuperscript{93}

\textsuperscript{89} Voda v. Cordis Corp., 476 F.3d 887, 896 (2007).
\textsuperscript{90} \textit{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 \textit{Packard} case. Packard Instrum. Co. v. Becker Instrum. Inc., 346 F. Supp. 408 (D. Ill. 1972).
\textsuperscript{91} \textit{Voda}, 476 F.3d at 897-904.
\textsuperscript{92} \textit{Id.} at 893.
Thus, it does not apply the “so related . . . that they form the same case or controversy” language of §1367(a) directly or literally. 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.\textsuperscript{94} 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.\textsuperscript{95} The court declined to construe §1367(a) further – notably, it considered, but declined to incorporate, additional language in Gibbs into the supplemental jurisdiction standard.\textsuperscript{96}

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 –
\begin{itemize}
\item[(1)] the claim raises a novel or complex issue of State law,
\item[(2)] the claim substantially predominates over the claim or claims over which the district court has original jurisdiction,
\item[(3)] the district court has dismissed all claims over which it has original jurisdiction, or
\item[(4)] in exceptional circumstances, there are other compelling reasons for declining jurisdiction.
\end{itemize}

28 U.S.C. §1367(c) (emphasis added). Noting that the Supreme Court, in City of Chicago v. Int’l College of Surgeons, has found “the values of judicial economy, convenience, fairness, and

\textsuperscript{93} There is apparently a circuit split on the proper standard, with the Second and Ninth Circuits apparently taking an opposing view – that Congress’ passage of §1367 “altered and constrained the Gibbs analysis.” Cordis Brief, supra note 46, at 21 (citing Executive Software N. Am. v. United States Dist. Court, 24 F.3d 1545 (9th Cir. 1994) and Itar-Tass Russian News Agency v. Russian Kurier, Inc., 140 F.3d 442 (2d. Cir. 1998)).

\textsuperscript{94} Gibbs stated that:
\begin{quote}
[i]n the federal claim must have substance sufficient to confer subject matter jurisdiction on the court. The state and federal claims must derive from \textit{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 \textit{ordinarily be expected to try them all in one judicial proceeding}, then assuming substantiality of the federal issues, there is power in the federal courts to hear the whole.
\end{quote}

383 U.S. at 725 (citation and footnote omitted) (emphasis added).

\textsuperscript{95} Id. at 892.

\textsuperscript{96} 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.
comity” are proper considerations in the subsection (c) analysis, the Federal Circuit proceeded to apply these factors literally.97

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.98 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.99 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).

b. §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.100 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, and fairness. The Federal Circuit determined that these

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97 City of Chicago v. Int’l College 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.
98 Id. at 898.
99 Id. at 892, 897.
100 Id. at 898.
factors, especially comity, should “compel” the district court to decline such jurisdiction in most circumstances.\textsuperscript{101} The following subsections examine each of the Federal Circuits points, in turn.

i. 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.”\textsuperscript{102} 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.\textsuperscript{103}

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.\textsuperscript{104} 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.”\textsuperscript{105} 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.\textsuperscript{106} Thus, hearing foreign patent claims would be as much as an insult to a foreign country as hearing a local action for trespass.

\textsuperscript{101} Id at 904.
\textsuperscript{102} Id. at 900 (citing Société Nationale Industrielle Aérospatiale v. U.S. Dist. Court for the S.D. of Iowa, 482 U.S. 522, 543 n.27 (1987)).
\textsuperscript{103} Id. at 901.
\textsuperscript{104} Id at 902.
\textsuperscript{105} Id. at 901.
\textsuperscript{106} Id.
In essence, the Federal Circuit bought Cordis’s argument hook, line, and sinker— even the analogy to land and local law that Cordis made in its own brief. 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. 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.

ii. 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 accused infringer, especially “[g]iven the number of U.S. patent cases that we resolve on validity or enforceability as opposed to infringement grounds.” On this theory, the unfairness arises when a defendant is deprived of the crucial defense of invalidity. 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.  

iii. 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

108 Id. at 904.
109 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.
economy\textsuperscript{110} or convenience.\textsuperscript{111} 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.\textsuperscript{112}

iv. 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.\textsuperscript{113} What they failed to mention, of course, is that nothing in those treaties forbids it, either – all of these agreements are entirely silent on the issue.\textsuperscript{114} 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).\textsuperscript{115}

v. 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 district court judge to decline supplemental jurisdiction over foreign patents. First, “if circumstances change, such as if the United States were to enter

\textsuperscript{110} 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. \textit{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.

\textsuperscript{111} 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. \textit{Id.} at 904.

\textsuperscript{112} Id. at 903. In particular, the court noted 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.

\textsuperscript{113} Id. at 899.

\textsuperscript{114} Judge Newman points out as much in her dissent. \textit{Id.} At 915-916.

\textsuperscript{115} Id. At 899. This is another rare example of the Federal Circuit applying the literal language of the supplemental jurisdiction statute.
into a new international patent treaty,” this might affect the analysis.\textsuperscript{116} The second exception occurs “if events during litigation alter a district court judge’s conclusions regarding comity, judicial economy, convenience, or fairness.”\textsuperscript{117} 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.)

2. 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.\textsuperscript{118}

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. 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.\textsuperscript{119}

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.

\textsuperscript{116} Id. at 905.
\textsuperscript{117} Id.
\textsuperscript{118} Id at 905-906 (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 8. (The actual statutory basis under which Newman would bring such claims in federal courts, which are courts of limited jurisdiction, is unclear.)
\textsuperscript{119} Id.
courts apply the law of other sovereigns “all the time.”¹²⁰ She argued that in light of the *eBay v. MercExchange* case, the Supreme Court has in fact discouraged the carving out of exceptions uniquely for patent cases; why should foreign patent law be treated differently?¹²¹ The fact that foreign patents involve complex questions of law and fact, she asserted, is not reason enough to strips district courts of their discretion to adjudicate foreign patent disputes should they choose to do so.

**Part 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. 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 alluded to 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 they

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¹²⁰ *Id.* at 906–909.  
¹²¹ *Id.* at 910.
choose 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 situation presented here, where a court simply intends to apply the law of a foreign country to acts occurring there.\(^{122}\)

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.

1. **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...

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\(^{122}\) 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 13, at 287, 299 (transnational regulatory context). See also Note, *Predictability and Comity: Towards 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 13, 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 the 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.)
courts towards other areas of foreign law.\textsuperscript{123} The Federal Circuit likely does not want the additional workload and headaches that may come with complicated issues of foreign-patent claim construction and infringement, let alone validity. They 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 \emph{always} be denied. As noted above, 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 \textit{Mars}, the Federal Circuit tends to apply that standard very narrowly.\textsuperscript{124}

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.\textsuperscript{125} Though courts can and often do dismiss claims related to foreign law or foreign acts under the doctrine of \textit{forum non conveniens}, the Supreme Court has held that the judicial discretion inhering under that doctrine cannot be limited by \textit{per se} rules.\textsuperscript{126} It would be very difficult to hold in the \textit{forum non} context, as the Federal Circuit did for §1367(c), that the district court’s discretionary analysis should usually come out a certain way.\textsuperscript{127} In addition,

\textsuperscript{123} See Thomas, supra note 15, at 280, 305-312 (critizing the Federal Circuit’s “parochial attitude”). \textit{See also} Stein Assoc., 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”). This is the same worldview exhibited in the Federal Circuit’s analysis under the comity factor of §1367(c) in \textit{Voda}: that patents are quasi-local actions that cannot be heard anywhere except where they arise.

\textsuperscript{124} Of course, the Federal Circuit did not decide whether or not a “common nucleus” existed \textit{Voda}. I suspect the reason is that it was a much closer question than it was in \textit{Mars}, on the facts of the case.

\textsuperscript{125} 28 U.S.C. §1332.

\textsuperscript{126} \textit{Piper Aircraft Co. v. Reyno}, 454 U.S. 235, 247 (1981) (emphasizing “the need to retain flexibility” in \textit{forum non conveniens} considerations.)

\textsuperscript{127} In \textit{Piper Aircraft}, the Supreme Court reversed the Third Circuit’s holding that analysis under \textit{forum non conveniens} should \emph{never} be dismissed on \textit{forum non} grounds where the plaintiff shows that the law of the alternative forum is less favorable to him than U.S. law. \textit{Id} at 235. Thus, the Supreme Court would probably not allow \textit{per se}
forum non is typically used to dismiss an entire case, not individual claims (although the Mars opinion suggested otherwise.)

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. 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.)

2. 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? 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 actual fairness argument, and the Act of State premise on which it rests, are questionable. On the other hand, the majority’s comity argument, which

rules, such as the one the Federal Circuit established for §1367(c), to limit discretion in the forum non conveniens context.

See discussion, supra note 67. See generally Nicholas, supra note 25, 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.”); Dismissal of Cases Under the Doctrine of Forum Non Conveniens, 32A Am. Jur. 2d Federal Courts §1353.

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).

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.

As discussed in subsection 3 infra, 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.

See Part I, supra for a general discussion of these issues.
relies on the entirely inapposite “local action” doctrine, is without reason or precedent when situated within the broader literature on transnational litigation.

**a. 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. These are two responses to the Federal Circuit’s fairness concerns. First, an *inter partes* 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.

**i. 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. 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 thus there would be no nonmutual collateral estoppel effect against other accused infringers. 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

133 See, *e.g.*, Professors Amicus Brief, supra note 83 (making this suggestion.)
country in which it was granted. Whether this is done through administrative proceedings, in the foreign country’s courts, or 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.\(^{134}\)

**ii. 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.” However, the Supreme Court has consistently applied the Act of State doctrine in cases involving political acts by a foreign sovereign.\(^ {135}\) 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.\(^ {136}\) This is

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134 See Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, 402 U.S. 313 (1971) (imposing the rule of nonmutual collateral estoppel upon a patent that has previously been adjudicated invalid in another proceeding). It was only until *Blonder-Tongue* that a U.S. patent that had been adjudicated invalid in court stayed invalid.

135 See, e.g., Underhill v. Hernandez, 168 U.S. 250 (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. Central Leather Co., 246 U.S. 297 (1918) (holding that seizure of property by Mexican military commander in his official capacity was an act of state); Banco Nacional de Cuba v. Sabbatino, 376 U.S. 398 (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 Nicholas, supra note 26, at 359 n.167.

136 Professors Amicus Brief, supra note 83, at 23 (relying on Mannington Mills, Inc. v. Congoleum Corp., 595 F.2d 1287, 1294 (3d Cir. 1979)(finding 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 (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).
especially true if, as Professor 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.\footnote{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.}

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 \textit{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 \textit{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 \textit{turns} on the validity of a sovereign act must courts refrain from deciding them.\footnote{W.S. Kirkpatrick \& Co., Inc. v. Environmental Tectonics Corp, 493 U.S. 400, 406 (1990). The plaintiff in \textit{Kirkpatrick} brought U.S. anti-racketeering charges alleging that defendant, a competitor, had obtained a government contract in Nigeria through bribery. \textit{Id}. at 401. To succeed on his claim, plaintiff would have had to show that bribery \textit{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. \textit{Id}. at 405-407.} 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): \textit{Mannington Mills} and \textit{Forbo-Giubiasco}.\footnote{\textit{Mannington Mills}, 595 F.2d at 1287; \textit{Forbo-Giubiasco}, 516 F.Supp. at 1210.}\footnote{\textit{Mannington Mills}, 595 F.2d at 1290-91; \textit{Forbo-Giubiasco}, 516 F.Supp. at 1217-19.} Both these cases allowed antitrust claims alleging fraud was involved in procuring foreign patents.\footnote{The specifics, of course, would depend on national law in the country where the patents were obtained.} Fraud, if proven, would show invalidity the patents were invalid.\footnote{\textit{Mannington Mills}, 595 F.2d at 1290-91; \textit{Forbo-Giubiasco}, 516 F.Supp. at 1217-19.} Yet in both cases it was held that the
Act of State doctrine did not apply because formal invalidity was not at issue. Similarly, an invalidity defense to a claim of foreign patent infringement, given *inter partes* effect, would not implicate the Act of State.

b. 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. But the *Voda* 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.”

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

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142 Mannington Mills, 595 F.2d at 1290-91; Forbo-Giubiasco, 516 F.Supp. at 1217-19.

143 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 of the foreign sovereign, not just the private party – bribery is a two way street.)

144 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 13, at 281 n.2. 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.
i. 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\textsuperscript{145}, or seem better suited to other sections of the §1367(c) analysis, such as convenience or judicial economy.\textsuperscript{146} (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.\textsuperscript{147}) But the most bewildering part is the Federal Circuit’s entirely inapposite analogy to the local action doctrine.\textsuperscript{148} 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 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. It is flawed not only because patent infringement is not a “local” action\textsuperscript{149} but also because it presents no real objection to claims foreign patent claims.

\textsuperscript{145}The majority inexplicably spends nearly an entire paragraph discussing the “territorially limited nature of patent rights.” Voda v. Cordis Corp., 476 F.3d 887, 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, the U.S. 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.

\textsuperscript{146}Included in the “smorgasbord” of reasons why foreign patent claims violate comity are that Voda hasn’t shown it would be more convenient or that foreign courts would not protect his rights; how these affect the “spirit of comity,” rather than considerations of convenience or judicial economy is unclear.

\textsuperscript{147}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.”)

\textsuperscript{148}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 that the opposite of a local action is, by definition, a transitory action. Furthermore, if you take 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 aren’t treated as transitory causes of action), patent infringement then becomes just a species of tort, which is most certainly a transitory action.

\textsuperscript{149}See supra note 148, as well as Part I, supra.
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 nonprecedential 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 nonmutual 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 one thing, and one thing only: the complaint that “foreign patent law is too complex.” This alone should is not sufficient to deny supplemental jurisdiction in all cases.\textsuperscript{150}

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 noninfringement and injunctive relief, whether one Japanese company infringed the U.S. patent of another under U.S. law.\textsuperscript{151}

\textsuperscript{150} Cf. Piper Aircraft v. Reyno, 454 U.S. 235, 260 n.29 (1981) (difficulty of applying foreign law may be one consideration in deciding \textit{forum non conveniens}, but is not alone sufficient to warrant dismissal.) But see Wegner, Trans-Border Patent Enforcement, supra note 4, at 20 (suggesting that, for a few particularly complicated areas of foreign patent law, it might be a “difficult if not an impossible imposition on the workload of a court to sort through the various foreign laws to reach a proper conclusion.”)

\textsuperscript{151} Voda, 476 F.3d at 917 (citing Kabushik-kaisha Coral Corp. v. Marine Bio Kabushiki-kaisha, Heisei 02 (wa) 1943 (D.Tokyo Oct. 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 Cheng, Comparative Analysis of the Extraterritorial Reach of Patent Law (unpublished manuscript) (on file with author) (translating much of the original opinion from the original Japanese text). Fascinatingly, defendant/patentee Marine Bio \textit{did} raise an objection that jurisdiction was not proper because of the existence of the invalidity defense, but the Japanese court rejected that argument. \textit{Id.} at 14. It in fact explicitly decided that 35 U.S.C. §282(2), which states U.S. law’s presumption of validity, \textit{does not} give rise to exclusive jurisdiction in the U.S. \textit{Id.} The Court then satisfied itself that an \textit{inter partes} approach to invalidity would resolve the issue. \textit{Id.} at 14.
Finding that jurisdiction was warranted on the basis of “equity between parties,” 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, application of prosecution history estoppel, and examination of whether a particular equivalent had been surrendered under the doctrine of equivalents laid out in *Festo*. A similar doctrine of equivalents issue was decided in the English case of *Celltech Chiroscience*, in the context of a licensing dispute. These cases caused no concern or uproar in the U.S., no retaliatory action from United States courts; they were barely noticed. It is clear that issues of infringement affect primarily issues among private parties, not comity among nations. Furthermore, the fact that these foreign courts have successfully applied one of the most 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*, *Eolas*, and *AT&T*, all of which extended the reach of U.S. patent law to foreign acts. *Voda* speaks forcefully of “the principle that we should ‘avoid unreasonable interference with the sovereign authority of other

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152 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. *Id.* at 12-13.
153 *Id.* at 20 (“The discussion then centered on two elements: (A) coral sand; and (B) a particle size passing about 150 to 500 mesh.”)
154 *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.”).
157 NTP, Inc. v. Research in Motion, Ltd., 418 F.3d 1282 (Fed. Cir. 2005).
158 Eolas Techs. Inc. v. Microsoft Corp., 399 F.3d 1325 (Fed. Cir. 2005); AT&T Corp. v. Microsoft Corp, 414 F.3d 1366 (Fed. Cir. 2005).
nations.’” Yet isn’t expanding the coverage of U.S. patent law to include infringements that occur (at least in part) within the sovereign borders of other nations arguably that kind of unreasonable interference? (The Canadian government apparently thought so in *RIM*.) Expand the territorial reach of U.S. patent law too far, and other countries may begin to push back. 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 expectation that is itself embedded in international comity.

**ii. 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. But given the amorphous nature of the concept of international comity, what sort of guidance should courts draw from it?

Not surprisingly, courts and commentators cannot even agree on a definition for “comity.” On a broad level, it is accepted that the comity doctrine requires, where two or more

159 Voda v. Cordis Corp., 476 F.3d 887, 902.
160 Canada *RIM En Banc* Amicus Brief, supra note 8.
161 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. Thomas, supra note 15, at 316-318. *Accord Predictability and Comity*, supra note 122, at 1321 n.57 (detailing retaliatory measures in other countries, such as secrecy statutes, blocking statutes, and ‘clawback’ statutes, enacted to guard against extraterritorial application of antitrust law by the U.S. and other nations).
162 See Maier, supra note 13, at 282 (noting the considerations of international comity underlying the territoriality principle).
163 As noted earlier in passing, the *City of Chicago* case cited “comity” in the state law context, which is an entirely different proposition.
164 Brian Pearce, *The Comity Doctrine as a Barrier to Jurisdiction: A U.S. –E.U. Comparison*, 30 Stan. J. Int’l L. 525, 547 (1994) provides 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 13. 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. Id. at 282-285.
165 See N. Jansen Calamita, Rethinking Comity: Towards a Coherent Treatment of International Parallel Proceedings, 27 Penn. J. of Int’l Econ. L. 601, 614 (noting that “the only practical meaning of ‘international comity’
sovereigns have concurrent jurisdiction, that a judge seeking to adjudicate international issues must balance national and foreign interests; it is also recognized that the balancing is a one-sided and uncertain exercise.\textsuperscript{166} Much of the literature on international comity focuses on the \textit{extraterritorial} application of U.S. antitrust and regulatory law, and is not entirely relevant here.\textsuperscript{167} However, it 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.\textsuperscript{168} Thus, accepting or declining jurisdiction must be done with an eye towards whether the outcomes will ultimately be efficient on a worldwide scale; as Calamita notes, this end of international comity is geared towards the “practical goal” of creating an international environment in which transnational commerce can flourish.\textsuperscript{169} Building upon this, Calamita further argues that international comity also serves the goal of “doing justice in individual cases.”\textsuperscript{170} He argues that this is accomplished “by facilitating the application of the law most appropriate to the parties' dispute, even if it happens to be foreign.”\textsuperscript{171} At least in some cases, this approach to comity will argue \textit{for}, not against, the assertion of jurisdiction by district courts over foreign patent infringement claims.\textsuperscript{172}

\begin{footnotesize}
\textsuperscript{166} See Maier, supra note 13, at 317 (“A unilateral decision make cannot simulate intellectually the international process of demand, response, and compromise . . . operative in the international law formation process.”)
\textsuperscript{167} See, e.g., Maier, supra note 13; \textit{Predictability and Comity}, supra note 122; Calamita, supra note 165; Pearce, supra note 164.
\textsuperscript{168} Maier, supra note 13, at 283-84, 289, 296.
\textsuperscript{169} Calamita, supra note 154, at 617.
\textsuperscript{170} \textit{Id.}
\textsuperscript{171} \textit{Id.} at 622. Calamita ties this argument about comity into the writings of seventeenth century Dutch thinker Ulrich Huber.
\textsuperscript{172} 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
\end{footnotesize}
3. The Future After *Voda*

Given that *Voda* is now the law of the Federal Circuit, what options are left for bringing consolidated multinational patent proceedings in U.S. courts? The three most obvious alternatives are to seek reversal of the *Voda* decision; attempting to work within the *Voda* framework for supplemental jurisdiction; or bringing foreign patent claims under §1332 diversity jurisdiction or in state courts. But because reversal is always an uncertain proposition and because the two exceptions in *Voda* are merely theoretical in today’s legal landscape, only the third option seems to present a viable course of action.

a. Reversal

The chances that *Voda* could be taken up on certiorari depend on how egregious reviewing courts consider the statutory misinterpretation of §1367(c). One factor that might lead to a grant of certiorari, as Judge Newman noted, is the Supreme Court’s current inclination to harmonize the rules for patent law with those in other areas of law. However, it is important to note that even if Federal Circuit law is restored its pre-*Voda* state, that court’s narrow interpretation of the §1367 “common nucleus of operative fact” test still stands, because *Mars* is still good law. If either an *en banc* court or the Supreme Court revisits the §1367(c) issue and overturns the *Voda* majority’s statutory construction, it may be compelled to touch upon the §1367(a) issue and *Mars*, as well.

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173 The Federal Circuit has already denied the petition for *en banc* rehearing, which was filed on April 9, 2007.
b. 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,” is entirely a nonstarter. But what about “events during litigation [that] alter a district court’s conclusions regarding comity, judicial economy, convenience, or fairness”?\(^{174}\) At first blush, this seems like a real possibility. The *City of Chicago* considerations (which, though the Federal Circuit emphasizes form a non-exhaustive list, will probably be applied like a four-factor test) are not created equal. Even though the comity and fairness factors are normative factors, which are unlikely to change during litigation\(^ {175}\), the remaining two factors of convenience and judicial economy are essentially *empirical* in nature. That explains why the majority opinion did not explicitly hold that the judicial economy and convenience factors always require that jurisdiction be declined, but rather only that the district court’s failure to consider them was abuse of discretion.\(^ {176}\)

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

\(^{174}\) *Voda*, No. 05-1238, at 29-30.

\(^{175}\) Obviously, Dr. Voda’s protest that no comity conflict existed in the *current* case fell upon deaf ears at the Federal Circuit.

\(^{176}\) *Id.* at 27 (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 pointing out that 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]”).

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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. There 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; there is no indication that by hearing the U.S. patent claims, Judge Leonard’s court gained any insight on whether hearing foreign patent claims are convenient or efficient.

c. Diversity and Beyond

Fortunately, there is another option in federal court. As the court in Mars was aware, nothing precludes a plaintiff denied supplemental jurisdiction over his foreign patent claims from repleading those causes of action under diversity jurisdiction. This would only shift the battleground over foreign patents to the forum non conveniens doctrine.177 But as noted previously, the Federal Circuit will have difficulty molding forum non doctrine into a tool of blanket denial of jurisdiction over foreign patents in the same way it has manipulated §1367(c). And again, there is the practical difficulty that forum non might also require the dismissal of an entire case, U.S. patent claims included, not just the dismissal of foreign claims. In any case,  

177 See note 67, supra, and accompanying text; notes 127-128, supra, and accompanying text.
Mars’ incomplete dicta about the forum non public factors in that particular litigation will not suffice as a general rule.\textsuperscript{178}

Even more broadly, foreign patent claims could conceivably be asserted (by themselves, stripped of any accompanying U.S. patent claims) in state trial courts. This is because foreign law lies outside the limited original jurisdiction of the federal courts. 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.\textsuperscript{179} These bewildering possibilities are simply a result of the lack of uniformity in U.S. law for recognizing and applying foreign law.\textsuperscript{180}

To summarize, the less-defined options of diversity and state jurisdiction are the most viable paths for future attempts at multinational patent litigation.\textsuperscript{181} 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).

\textbf{Part 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,

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\textsuperscript{178} Mars Inc. v. Kabushiki-Kaisha Nippon Conlux, 24 F.3d 1368, 1376 (Fed. Cir. 1994).
\textsuperscript{179} 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:
\begin{quote}
May be 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.
\end{quote}
\textsuperscript{180} For example, recognition and enforcement of foreign judgments is generally viewed as a matter of state law.
Blumer, supra note 1, at 380.
\textsuperscript{181} Nicholas 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 25, at 355 (quoting 28 U.S.C. §1350). This theory of jurisdiction has never been tested, and it would require a foreign plaintiff to sue either foreign or U.S. defendants.
\end{flushright}
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.¹⁸²

Beginning with the Dutch Interlas case in 1989, the courts of the Netherlands routinely heard cases for the cross-border enforcement of patent rights.¹⁸³ 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 was obtained.¹⁸⁴ Other European courts, including Belgium and Germany, followed suit in the period from 1999-2005.¹⁸⁵ Until the European Court of Justice ended the practice in 2006¹⁸⁶, the story of multinational patent infringement cases in the European states was one of jurisdictional abuse and excesses by both rights holders and defendants.¹⁸⁷

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

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¹⁸⁴ Id.
¹⁸⁵ Id.
¹⁸⁶ 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 (July 13, 2006). Roche narrowly interprets 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 (July 13, 2006). 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.
¹⁸⁷ Nuyts, supra note 182, at 15-21.
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. The eight considerations criteria suggested in the Law
Professors’ brief, which include the nationality of the plaintiff, his financial means, and whether
the foreign patent claims that are sought to be asserted have the same or similar disclosure, prior
art, and claim language, are a good start. 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. A third
possibility is the “spider in the web” theory employed by Dutch courts at the tail end of the
1990’s. This theory allowed consolidation of patent infringement only when the infringers were

188 See the discussion of comity at the end of Part IV.2.b.ii.
189 See Professors Amicus Brief, supra note 83, 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.
190 Wegner, Trans-Border Patent Enforcement, 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.
related corporate entities with infringement orchestrated by a single entity, i.e., the “spider.”\textsuperscript{191} 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.\textsuperscript{192}

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 antisuit injunctions and preclusion doctrines must be implemented to prevent the parties from relitigating the exact same claims abroad in foreign forums after they are “heard” in U.S. courts.\textsuperscript{193} 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 \textit{Voda}) is not a party to any international treaty that provides for automatic recognition of U.S. judgments abroad.\textsuperscript{194} 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 \textit{substantive} standards of patent law around the world converge, the vast \textit{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


\textsuperscript{192} In this light, it is quite understandable that the Federal Circuit was tempted to construe \textsection 1367(c) so as to insert considerations of comity, fairness, convenience, and judicial economy into the jurisdictional analysis itself.

\textsuperscript{193} Nicholas, supra note 29, discusses 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.

\textsuperscript{194} On this topic, see \textit{generally} Blumer, supra note 1.
system, which are not duplicated anywhere else in the world.\textsuperscript{195} 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.

\textbf{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, they may well be unworkable. At the 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.

\textit{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 \textit{Roche Nederland} and \textit{GaT v. LuK} decisions seems to have jump-started long dormant proposals for an effective multinational patent litigation agreements.\textsuperscript{196} But without the experience the Europeans gained during the roughly seventeen year period in which multinational patent litigation was tried and then

\textsuperscript{195} 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.).

\textsuperscript{196} NUYTS, supra note 182, at 27-29 (describing the European Patent Litigation Agreement proposal as well as the idea of a Community Patent System.)
abandoned, these collaborative agreements would never had the chance that they have today.\textsuperscript{197} Similarly, perhaps the U.S. experience, however it turns out, can generate valuable insight for future discussions of worldwide patent enforcement.

\textsuperscript{197} See Thomas, supra note 15, at 294-95, 297-299 (noting that despite a strong start, the deliberations surrounding a Community Patent System in Europe actually began in 1975, but bogged down and was never ratified.)