

Multinational Patent Enforcement: What the Parochial United States Can Learn from Past and Present European Initiatives

Kerry J. Begley

Follow this and additional works at: <http://scholarship.law.cornell.edu/cilj>

 Part of the [Law Commons](#)

Recommended Citation

Begley, Kerry J. (2007) "Multinational Patent Enforcement: What the Parochial United States Can Learn from Past and Present European Initiatives," *Cornell International Law Journal*: Vol. 40: Iss. 2, Article 8.
Available at: <http://scholarship.law.cornell.edu/cilj/vol40/iss2/8>

This Note is brought to you for free and open access by the Journals at Scholarship@Cornell Law: A Digital Repository. It has been accepted for inclusion in Cornell International Law Journal by an authorized administrator of Scholarship@Cornell Law: A Digital Repository. For more information, please contact jmp8@cornell.edu.

Multinational Patent Enforcement: What the “Parochial”¹ United States Can Learn from Past and Present European Initiatives

Kerry J. Begley†

Introduction	522
I. The United States	526
A. The Conservative Attitude of U.S. Courts Toward Multinational Patent Enforcement	526
1. <i>Concepts of Jurisdiction in U.S. Courts Relevant to Foreign Patent Claims</i>	526
2. <i>Multinational Patent Enforcement in U.S. Courts</i>	531
B. <i>Voda v. Cordis Corp.</i> : The Federal Circuit Restricts Multinational Patent Enforcement in U.S. Courts	536
1. <i>The Voda Decision</i>	536
2. <i>Implications for Multinational Patent Enforcement in U.S. Courts</i>	543
II. Europe	545
A. Multinational Patent Injunctions: Dutch Courts Attack Patent Territoriality	545
B. The ECJ Assault on Multinational Patent Enforcement ..	548
1. <i>Roche and GAT</i>	548
2. <i>Implications for Multinational Patent Enforcement in European National Courts</i>	552
C. The Community Patent	553
D. The European Patent Litigation Agreement	556
E. The Future of European Patent Litigation: Community Patent, EPLA, or Both?	560
III. Lessons from Europe	561
A. Continued Territoriality Reinforces Comity Concerns ..	561

1. John R. Thomas, *Litigation Beyond the Technical Frontier: Comparative Approaches to Multinational Patent Enforcement*, 27 LAW & POL'Y INT'L BUS. 277, 280 (1996).

† Candidate for J.D., Cornell Law School, 2008; B.S. Loyola College in Maryland, 2005. I would like to thank Professor Oskar Liivak for his guidance in topic selection and the staff of the *Cornell International Law Journal*, especially Elizabeth Rabe, for their helpful editing. I would also like to thank my family for their unwavering support.

B. The Current Realities of Multinational Patent Enforcement in National Courts	564
C. The Best Way Forward	566
Conclusion	570

Introduction

Patents, as “discrete, national instruments,” are of increasingly limited value in a contemporary global economy that transcends national borders.² Patent law,³ like all intellectual property law, has historically been based on national laws and the principle of territoriality.⁴ Individual national governments grant patents to inventors, and the territorial limits of sovereignty preclude a nation from giving extraterritorial effect to its patent laws.⁵ Therefore, the rights, privileges, and obligations that accompany a patent “begin and end with the country that issues it.”⁶ A U.S. patent, for example, provides no protection against infringing activity in any country other than the United States.⁷

The ease of the international flow of goods, services, and information in today’s global society often makes patent rights in a single country insufficient to protect new technology, forcing innovators to procure patents internationally on a nation-by-nation basis.⁸ Although international agreements, including the Paris Convention,⁹ the Patent Cooperation

2. *Id.* at 278.

3. A patent is a statutory right that a national government grants “to an inventor or the inventor’s assignee . . . to exclude other people from practicing the invention disclosed and claimed in the patent specification . . . for a fixed period of years.” Gretchen Ann Bender, *Clash of the Titans: The Territoriality of Patent Law vs. the European Union*, 40 IDEA 49, 51 (2000). The patent owner generally has “the exclusive right to exclude others from making, using, or selling the patented invention.” *Id.* The most important part of a patent is the claims, which set forth the metes and bounds of the patentee’s right to exclude. DONALD S. CHISUM ET AL., PRINCIPLES OF PATENT LAW 90 (3d ed. 2004).

4. Bender, *supra* note 3, at 49, 52.

5. *Id.*

6. *Id.* (quoting *Aluminum Co. of Am. v. Sperry Prod., Inc.*, 285 F.2d 911, 925 (6th Cir. 1960)).

7. *Id.*

8. Brief for *Amici Curiae* Law Professors in Support of the Appellee at 1, *Voda v. Cordis Corp.*, 476 F.3d 887 (Fed. Cir. 2007) (No. 05-1238) [hereinafter *Professors’ Brief*]; Thomas, *supra* note 1, at 278.

9. The International Convention for the Protection of Industrial Property, also known as the Paris Convention, is the foundational patent harmonization treaty. Bender, *supra* note 3, at 53. Prior to 1884, when the Paris Convention became effective, inventors had to submit patent applications simultaneously in every country in which they desired protection; failure to do so could preclude patent protection in every country except that in which the inventor first filed the application. *Id.* The Paris Convention established the fundamental principle of “right of priority,” which entitles a patent applicant of a member country to a twelve-month period after the initial patent application to apply for patents in other member countries. *Id.* at 54-55. This provides a great practical advantage to applicants who desire multinational patent protection because it allows the applicant time to evaluate the economic viability of the invention before deciding on specific countries in which to seek patent protection. *Id.* at 55. The United States is a party to the Paris Convention. *Voda*, 476 F.3d at 898.

Treaty (PCT),¹⁰ and the European Patent Convention (EPC),¹¹ have helped streamline the acquisition of foreign patents,¹² the “national nature of patents means that enforcement remains local.”¹³ Thus, although foreign patents increasingly resemble each other, the continued legal independence and territorial limitations of patents force patent holders to litigate simultaneously in several different countries.¹⁴ Such piecemeal international litigation leads to delay, contradictory results, and expense for both national court systems and the parties to the litigation and, thus, uncertainty, delay, and frustration.¹⁵ The burdens on both patentees and national court sys-

10. The Washington Treaty of 1970, commonly referred to as the Patent Cooperation Treaty (PCT), simplifies the international patent application process by providing a mechanism for filing one patent application that can have effect in many countries. Bender, *supra* note 3, at 56. To begin, an applicant first files a PCT application in a designated national patent office. *Id.* The international search authority conducts a novelty examination and completes an international search report, which “expresses no opinion as to the patentability of the invention but does include the classification of the claimed invention, the technical fields searched and citations to the prior art.” *Id.* Next, in the national stage, the applicant submits the PCT application to national patent offices where patent examiners examine the application based on their own national patent laws. *Id.* Thus, although the PCT facilitates the task of obtaining patents in multiple countries, it does not alter member states’ substantive requirements of patentability. *Id.* at 56-57. The United States became a party to the PCT on January 24, 1978. See *Voda*, 476 F.3d at 899.

11. The Munich Convention on the Grant of European Patents, also known as the European Patent Convention (EPC), which was signed on October 5, 1973 and became effective on October 7, 1977, is an agreement between European states that established a common European patent granting system with a common patent office, the European Patent Office (EPO). Vincenzo Di Cataldo, *From the European Patent to a Community Patent*, 8 COLUM. J. EUR. L. 19, 19 (2002); Jean-Luc Piotraut, *European National IP Laws Under the EU Umbrella: From National to European Community IP Law*, 2 LOY. U. CHI. INT’L L. REV. 61, 63 (2005). The patent applicant submits a single application to the EPO and if accepted, the EPO grants a European patent, which is actually a bundle of multiple national patents for the nations designated in the patent application. Bender, *supra* note 3, at 58; Di Cataldo, *supra*, at 20.

12. Professors’ Brief, *supra* note 8, at 1.

13. *Id.*; Michael C. Elmer & Alejandro I. Garcia, *Are U.S. Courts Going Global on Voda v. Cordis?*, INTELL. PROP. L. NEWSL. (ABA Section of Intellectual Property Law, Chicago, Ill.), Spring 2006, at 4, 4. The 1994 Trade-Related Aspects of Intellectual Property (TRIPS) agreement, to which the United States is a party, provides that member states must provide for effective enforcement of intellectual property rights within their own state, but the agreement does not require member states to provide for consolidation of patent claims arising out of connected instances of infringement, to enforce the judgments of other members, or to exercise claim or issue preclusion based on trials in other member states. See Rochelle Cooper Dreyfuss, *An Alert to the Intellectual Property Bar: The Hague Judgments Convention*, 2001 U. ILL. L. REV. 421, 423-24 (2001).

14. Professors’ Brief, *supra* note 8, at 1; Thomas, *supra* note 1, at 278; Elmer & Garcia, *supra* note 13, at 4; see Judge Randall Rader, United States Court of Appeals for the Federal Circuit, Keynote Address at the High Technology Protection Summit at the University of Washington School of Law: Do you Want Your Foreign Patent Enforced in a U.S. Court? 3-4 (July 21, 2000), available at <http://www.law.washington.edu/CASRIP/Symposium/Number6/Rader.pdf> (explaining, through example, the difficulties facing inventors currently attempting to enforce patents internationally).

15. Professors’ Brief, *supra* note 8, at 1; EUROPEAN PATENT OFFICE, ASSESSMENT OF THE IMPACT OF THE EUROPEAN PATENT LITIGATION AGREEMENT (EPLA) ON LITIGATION OF EUROPEAN PATENTS 1-4 (2006), www.european-patent-office.org/epo/epla/pdf/impact_assessment_2006_02_v1.pdf; Elmer & Garcia, *supra* note 13, at 4.

tems have led to a desire for multinational patent enforcement, which entails consolidating suits regarding patent rights from different countries in a single forum.¹⁶

The potential for U.S. courts to exercise jurisdiction over foreign patent claims initially appears attractive as a means to prevent the debilitating expense and delay of piecemeal patent litigation in individual national courts.¹⁷ As a result, the conservative approach of U.S. courts to multinational patent enforcement has been highly criticized, especially given the willingness of many European courts to adjudicate foreign patent claims.¹⁸ In *Voda v. Cordis Corp.*, Judge Leonard of the Western District of Oklahoma, defying the traditional reluctance of U.S. courts to exercise jurisdiction over foreign patent claims, permitted Dr. Jan K. Voda, a U.S. cardiologist,¹⁹ to allege infringement of his five Canadian and European patents in addition to his three U.S. patents already in suit against Cordis Corporation, a U.S. company.²⁰ Because of the significance of the issue and the likelihood of substantial difference in opinion on the minimal relevant case law,²¹ the U.S. Court of Appeals for the Federal Circuit granted a rare interlocutory appeal.²² In the long-awaited decision handed down on February 1, 2007, the Federal Circuit found that the Oklahoma district court abused its discretion in assuming jurisdiction over Dr. Voda's foreign patent infringement claims,²³ reasserting the traditional hesitance of U.S. courts to assume jurisdiction over foreign patent claims. With a particular emphasis on comity concerns, the decision all but eliminates the potential for U.S. courts to exercise supplemental jurisdiction over foreign patent claims.²⁴

While the immediate future of multinational patent litigation in U.S. courts was pending in the Federal Circuit,²⁵ the European Court of Justice

16. Bender, *supra* note 3, at 53; Elmer & Garcia, *supra* note 13, at 4; Rader, *supra* note 14, at 3.

17. See Professors' Brief, *supra* note 8, at 1-3.

18. See, e.g., Curtis A. Bradley, *Territorial Intellectual Property Rights in an Age of Globalism*, 37 VA. J. INT'L L. 505, 577 (1997); Donald S. Chisum, *Normative and Empirical Territoriality in Intellectual Property: Lessons From Patent Law*, 37 VA. J. INT'L L. 603, 610 (1997); Thomas, *supra* note 1, at 279-80, 346, 352; Harold C. Wegner, *Voda v. Cordis: Trans-Border Patent Enforcement* 3, 12-15 (Nov. 17, 2005) (unpublished paper), available at http://www.foley.com/files/tbl_s31Publications/FileUpload137/2989/Voda_Texas_Paper.pdf.

19. Brief for Appellee at 3, *Voda v. Cordis Corp.*, 476 F.3d 887 (Fed. Cir. 2007) (No. 05-1238) (quoting *Hilton v. Guyot*, 159 U.S. 113, 163-64 (1895)).

20. *Voda v. Cordis Corp.*, No. CIV-03-1512-L (W.D. Okla. Aug. 2, 2004) (order granting plaintiff's motion to amend complaint) [hereinafter Order Granting Amendment].

21. See *Voda v. Cordis Corp.*, No. MISC. 785 (Fed. Cir. Feb. 22, 2005) (order granting appeal) [hereinafter Order Granting Appeal].

22. See Wegner, *supra* note 18, at 33.

23. See *Voda*, 476 F.3d at 887.

24. Toshiko Takenaka, *High Hurdle for U.S. Courts to Hear Foreign Infringement Claims*, CASRIP NEWSL. (Ctr. for Advanced Study & Research on Intellectual Prop., Seattle, Wash.), Spring 2007.

25. See Wegner, *supra* note 18, at 31 ("Judge Leonard's August 2, 2004[] trial court order granted supplemental jurisdiction to hear foreign patent infringement claims; it

(ECJ) largely crushed the European multinational patent enforcement trend²⁶ with two July 13, 2006 decisions in *Roche Nederland v. Primus*²⁷ and *Gesellschaft für Antriebstechnik mbH & Co. KG v. Lamellen und Kupplungsbau Beteiligungs KG (GAT)*.²⁸ As a result, Europe immediately began a “concerted push” for both the Community Patent and the European Patent Litigation Agreement (EPLA), two initiatives to improve the European patent litigation system that have been in negotiations for years.²⁹ These recent European developments suggest the wisdom of U.S. courts’ general refusal to assert jurisdiction over foreign patent claims. The ECJ decisions illustrate the lingering territoriality of patent law³⁰ despite the cooperative legal environment fostered by the European Union (EU)³¹ and the concomitant success in harmonizing European national patent laws.³² In addition to the two decisions,³³ the proposed judicial systems in the Community Patent initiative and the EPLA demonstrate European nations’ continued hesitance to allow foreign national courts to adjudicate patents effective in their territory.³⁴ Furthermore, the unavoidable inefficiencies evident in previous multinational patent enforcement efforts in European national courts,³⁵ despite being better suited for multinational patent enforcement than U.S. courts,³⁶ establish that national courts are not an ideal venue for patent enforcement on an international level. As such, the recent impetus for both the Community Patent and the EPLA suggests that Europe has realized that multinational agreements establishing a common patent judicial system are the appropriate means to ensure effective multinational patent litigation.³⁷ Although multinational patent enforcement is a praiseworthy goal, the lessons from Europe illustrate that it is a goal that the United States generally should not pursue on its own.³⁸

will in hindsight be seen as either the most significant trial court order for the globalization of patent rights in some time or the forerunner for later judicial, treaty, or legislative action that will confirm District Judge Tim Leonard’s bold globalization of patent law.”).

26. Beth Z. Shaw, *Court Rules Against Cross-Border Enforcement of “European” Patent Rights*, LEGAL OPINION LETTER (Wash. Legal Found., Wash. D.C.), Oct. 6, 2006, at 1, 1-2, available at <http://www.wlf.org/upload/100606shaw.pdf>.

27. Case C-539/03, *Roche Nederland BV v. Primus*, 2006 E.C.R. I-6535.

28. Case C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v. Lamellen und Kupplungsbau Beteiligungs KG*, 2006 E.C.R. I-6509.

29. See Charlie McGreevy, *European Comm’r for Internal Mkt. & Servs., IPR- Next Steps* (Sept. 8, 2006) [hereinafter *Next Steps*].

30. See Shaw, *supra* note 26, at 1.

31. See Bender, *supra* note 3, at 49.

32. See *id.*; Di Cataldo, *supra* note 11, at 19.

33. See Shaw, *supra* note 26, at 1.

34. See generally EUROPEAN PATENT OFFICE, *supra* note 15, at 5 (describing the proposed judicial system in the draft EPLA); Di Cataldo, *supra* note 11, at 27 (explaining the difficulties in negotiating a judicial system for the proposed Community Patent).

35. See Reinhardt Schuster, *Divide and Conquer*, MANAGING INTELL. PROP., Oct. 2006.

36. See Koos Rasser, *United Kingdom: Extraterritorial Reach of US Patent Law*, MONDAQ BUS. BRIEFING, Mar. 9, 2006, <http://www.mondaq.com/article.asp?articleid=38098>.

37. See *Next Steps*, *supra* note 29.

38. See *Voda v. Cordis Corp.*, 476 F.3d 887, 900 (Fed. Cir. 2007) (“[W]e as the U.S. judiciary should not unilaterally decide either for our government or for other foreign

After explaining general concepts of jurisdiction in U.S. courts applicable to foreign patent claims (Part I.A.1), this Note examines U.S. courts' traditional hesitance to exercise such jurisdiction (Part I.A.2) and then introduces the controversial Federal Circuit decision in *Voda v. Cordis Corp.*, which perpetuates this conservative approach to multinational patent enforcement (Part I.B). For comparison, the Note turns to a discussion of recent European developments in multinational patent litigation, specifically Dutch courts' progressive use of multinational patent injunctions (Part II.A), followed by the ECJ's decisions in *Roche* and *GAT*, which severely limit the potential for such consolidated suits (Part II.B). Next, the Note describes specific initiatives to harmonize the European patent litigation system, the Community Patent (Part II.C) and the EPLA (Part II.D), along with European leaders' current plan for the implementation of both initiatives (Part II.E).

Finally, the Note explores the lessons that Europe's example provides the United States. The Note argues that, despite progress in unifying the European patent system, European nations remain hesitant to accept a foreign national court's patent invalidity determinations, which the ECJ decisions in *Roche* and *GAT*, as well as the proposed judicial systems in the Community Patent and the EPLA, evidence. This hesitance reinforces comity concerns, which have been the main barrier to the exercise of jurisdiction over foreign patent claims in U.S. courts (Part III.A). Further, the rare availability of multinational patent enforcement, combined with the inherent difficulties of its use, confirm that national courts are not an ideal venue for the global enforcement of patent rights (Part III.B). As such, the Note concludes that Europe's initiatives demonstrate that agreements specifically designed to implement a common patent judicial system, although difficult to establish, are the best means to effectuate multinational patent enforcement (Part III.C).

I. The United States

A. The Conservative Attitude of U.S. Courts Toward Multinational Patent Enforcement

1. *Concepts of Jurisdiction in U.S. Courts Relevant to Foreign Patent Claims*

In order for a U.S. court to exercise jurisdiction over foreign patent claims, the court must consider: (1) whether the court has jurisdiction over the claims, and (2) whether the court, in its discretion, should decline to exercise jurisdiction over the claims.³⁹ Under the first prong of the jurisdiction analysis, for a U.S. court to assume jurisdiction over a foreign patent claim, the court must have both personal jurisdiction and subject

sovereigns that our courts will become the adjudicating body for any foreign patent with a [sufficiently related] U.S. equivalent . . ."); EUROPEAN PATENT OFFICE, *supra* note 15, at 8-9.

39. See Elmer & Garcia, *supra* note 14, at 5.

matter jurisdiction.⁴⁰ In the patent context, the requirements for personal jurisdiction, the judicial power to bind the parties, usually do not present much of a barrier and are ordinarily met if the defendant purposefully conducts activity in the forum.⁴¹

There are two possible avenues for a U.S. court to assume subject matter jurisdiction over a foreign patent: diversity jurisdiction and supplemental jurisdiction.⁴² Diversity jurisdiction exists if the requirements of litigant diversity and amount in controversy (currently \$75,000) are met.⁴³ Although the amount in controversy in most patent infringement cases typically exceeds the \$75,000 requirement,⁴⁴ satisfying the litigant diversity requirement is more problematic.⁴⁵ First, domestic diversity must be complete: the parties must be citizens of different states.⁴⁶ Additionally, diversity jurisdiction may fail if aliens litigate on both sides of the proceeding.⁴⁷ Nevertheless, a U.S. court will often have jurisdiction over foreign patent claims based on diversity jurisdiction.⁴⁸

Given that 28 U.S.C. § 1338(a) gives federal district courts original jurisdiction over claims involving U.S. patents,⁴⁹ federal courts may also rely on supplemental jurisdiction to assume jurisdiction over foreign patent claims that are sufficiently related to U.S. patent claims.⁵⁰ The U.S. Supreme Court addressed the fundamental principles of pendent jurisdiction, the predecessor to supplemental jurisdiction,⁵¹ in *United Mine Workers of America v. Gibbs*.⁵² The Court explained that supplemental

40. See Bradley, *supra* note 18, at 578-79; Thomas, *supra* note 1, at 312-14.

41. See Bradley, *supra* note 18, at 578-79 & n.364; Thomas, *supra* note 1, at 314-15.

42. Elmer & Garcia, *supra* note 13, at 5. Theoretically, U.S. federal courts can assume jurisdiction over foreign patent infringement claims based on patent jurisdiction, 28 U.S.C. § 1338(a), unfair competition jurisdiction, 28 U.S.C. § 1338(b), supplemental jurisdiction, 28 U.S.C. § 1367, diversity jurisdiction, 28 U.S.C. § 1332, and the Alien Tort Statute, 28 U.S.C. § 1350, but case law only supports supplemental jurisdiction and diversity jurisdiction as a means of assuming jurisdiction. See *id.* at 5 & n.7.

43. Elmer & Garcia, *supra* note 13, at 6. Section 1332(a) provides in relevant part: "The district courts shall have original jurisdiction of all civil actions where the matter in controversy exceeds the sum or value of \$75,000, exclusive of interest and costs, and is between- (1) citizens of different States; . . . [and] (3) citizens of different States and in which citizens or subjects of a foreign state are additional parties For the purposes of this section, . . . an alien admitted to the United States for permanent residence shall be deemed a citizen of the State in which such alien is domiciled.

28 U.S.C. § 1332(a) (2000).

44. See Brief for the United States as *Amicus Curiae* in Support of the Appellant at 8, *Voda v. Cordis Corp.*, 476 F.3d 887 (Fed. Cir. 2007) (No. 05-1238) [hereinafter U.S. Brief].

45. See Elmer & Garcia, *supra* note 13, at 6.

46. See Thomas, *supra* note 1, at 312; Elmer & Garcia, *supra* note 13, at 6.

47. Elmer & Garcia, *supra* note 13, at 6.

48. See U.S. Brief, *supra* note 44, at 6.

49. 28 U.S.C. § 1338(a) (2000) ("The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents Such jurisdiction shall be exclusive of the courts of the states in patent . . . cases."); see Thomas, *supra* note 1, at 312.

50. See Bradley, *supra* note 18, at 579.

51. Thomas, *supra* note 1, at 318-19.

52. See 383 U.S. 715 (1966).

jurisdiction exists if the non-federal claim arose out of a “common nucleus of operative fact” with a claim within the original jurisdiction of the federal court and, as such, the claims would ordinarily be expected to be tried in one proceeding.⁵³ In 1990, Congress codified the basic principles articulated in *Gibbs* regarding the scope and exercise of supplemental jurisdiction in 28 U.S.C. § 1367.⁵⁴ Section 1367(a) states in relevant part:

in any civil action of which the district courts have original jurisdiction, the district courts shall have supplemental jurisdiction over all other claims that are so related to claims in the action within such original jurisdiction that they form part of the same case or controversy under Article III of the United States Constitution.⁵⁵

Once a court determines that it has jurisdiction, the second prong of the jurisdiction analysis presents the separate question of whether the court should abstain from exercising jurisdiction.⁵⁶ Thus, even if the requirements for personal and subject matter jurisdiction are met, a U.S. court may nonetheless decline to exercise that jurisdiction under certain prudential doctrines,⁵⁷ including the doctrine of *forum non conveniens*, considerations of international comity, and the act of state doctrine.⁵⁸ For supplemental jurisdiction suits, § 1367(c) provides specific bases to decline to entertain supplemental claims.⁵⁹

The *forum non conveniens* doctrine, a likely obstacle to the exercise of jurisdiction over foreign patent claims predicated on either diversity or supplemental jurisdiction, allows a court to decline to exercise jurisdiction if it would be an inconvenient forum and an adequate alternative forum exists.⁶⁰ To obtain a *forum non conveniens* dismissal, the defendant must show that there is an adequate alternative forum and that various private and public interest factors weigh in favor of dismissal.⁶¹ The relevant private interest factors, which relate to the convenience of litigants, include: (1) the relative ease of access to sources of proof, (2) the availability of compulsory process for attendance of the unwilling, (3) the cost of the attendance of the parties and witnesses, (4) if necessary, the possibility of viewing the premises, (5) the enforceability of the judgment, and (6) whether the plaintiff sought to harass the defendant in choosing the

53. *Id.* at 725; see *Mars Inc. v. Kabushiki-Kaisha Nippon Conlux (Mars II)*, 24 F.3d 1368, 1374 (Fed. Cir. 1994) (quoting *Gibbs*, 383 U.S. at 725); Thomas, *supra* note 1, at 312-13.

54. *Mars II*, 24 F.3d at 1374. Although the wording of the statute is slightly different from the *Gibbs* test, the Supreme Court has interpreted the statutory relatedness requirement of § 1367(a) as Congress’s codification of the “common nucleus of operative fact” test of *Gibbs*. *Voda v. Cordis Corp.*, 476 F.3d 887, 894 (Fed. Cir. 2007) (citing *Chicago v. Int’l Coll. of Surgeons*, 522 U.S. 156, 164-65 (1997)); see *Mars II*, 24 F.3d at 1374.

55. 28 U.S.C. § 1367(a) (2000).

56. See Elmer & Garcia, *supra* note 13, at 5.

57. Thomas, *supra* note 1, at 315.

58. See Elmer & Garcia, *supra* note 13, at 6.

59. U.S. Brief, *supra* note 44, at 9; Elmer & Garcia, *supra* note 13, at 6.

60. See U.S. Brief, *supra* note 44, at 14; Thomas, *supra* note 1, at 315.

61. Bradley, *supra* note 18, at 579-80.

forum.⁶² The relevant public interest factors, which relate to the convenience of the forum, include: (1) the burden placed on congested courts that lack a connection to the litigation, (2) the burden placed on jurors in a community unrelated to the litigation, and (3) local interest in having controversies decided at home.⁶³

The act of state doctrine provides another means by which U.S. courts can abstain from exercising jurisdiction over foreign patent claims.⁶⁴ The doctrine essentially prohibits courts from reviewing the validity of public acts of a foreign sovereign performed within its own territory.⁶⁵ For patents, the rationale for the doctrine is that only a court or the patent office in the country that granted the patent should have jurisdiction to invalidate it.⁶⁶ In a foreign patent case, therefore, a dismissal based on the act of state doctrine has two requirements: (1) a foreign country issued a patent wherein the patent itself represents an “act of state,” and (2) a U.S. court is reviewing the validity of that patent.⁶⁷ Significantly, several U.S. courts have held that the doctrine is inapplicable to actions involving foreign patents, reasoning that the grant of a patent is a purely ministerial activity, which does not meet the first requirement of the doctrine.⁶⁸

Concerns of international comity may also preclude the consolidation of foreign patent claims in U.S. courts.⁶⁹ Comity refers to the “spirit of cooperation” in which a domestic court approaches the resolution of cases involving the laws and interests of a foreign sovereign.⁷⁰ Although the precise meaning of the concept remains unclear, the Supreme Court defined comity in *Hilton v. Guyot* as “the recognition which one nation allows within its territory to the legislative, executive or judicial acts of another nation, having due regard both to international duty and convenience, and to the rights of its own citizens, or of other persons who are under the protection of its laws.”⁷¹ In *Société Nationale Industrielle Aérospatiale v. United States District Court*, the Supreme Court added an additional consideration to guide the comity analysis, advising courts to consider whether exercising jurisdiction would prejudice the rights of the foreign

62. See *Gulf Oil Corp. v. Gilbert*, 330 U.S. 501, 508-09 (1947); Elmer & Garcia, *supra* note 13, at n.32.

63. See *Gulf Oil*, 330 U.S. at 508-09; Elmer & Garcia, *supra* note 13, at n.33.

64. Thomas, *supra* note 1, at 315.

65. See *W.S. Kirkpatrick & Co. v. Evtl. Tectonics Corp., Int'l*, 493 U.S. 400, 405 (1990); Bradley, *supra* note 18, at 581.

66. Mariano Municoy, *Allocation of Jurisdiction on Patent Disputes in the Models Developed by the Hague Conference in Private International Law: Asymmetric Countries and the Relationship of Private Parties*, 4 CHL-KENT J. INTELL. PROP. 342, 370 (2005).

67. Elmer & Garcia, *supra* note 13, at 6.

68. Bradley, *supra* note 18, at 581; see *Mannington Mills, Inc. v. Congoleum Corp.*, 595 F.2d 1287, 1292-94 (3d Cir. 1979); *Forbo-Giubiasco S.A. v. Congoleum Corp.*, 516 F. Supp. 1210, 1217-18 (S.D.N.Y. 1981).

69. Elmer & Garcia, *supra* note 13, at 6.

70. *Voda v. Cordis Corp.*, 476 F.3d 887, 900 (Fed. Cir. 2007) (quoting *Société Nationale Industrielle Aérospatiale v. U.S. Dist. Court*, 482 U.S. 522, 543 n.27 (1987)).

71. 159 U.S. 113, 163-64 (1895).

government.⁷² Because invalidating a foreign patent constitutes disrespect toward another sovereign,⁷³ considerations of comity are most acute when, as is usually the case in patent infringement cases, the court must determine the validity of a patent as a result of an invalidity defense.⁷⁴ Notions of comity have presented a substantial bar to foreign patent consolidation in U.S. case law.⁷⁵

Specific to supplemental jurisdiction, a court also has considerable discretion to decline jurisdiction over a non-federal claim under § 1367(c).⁷⁶ The discretionary factors outlined in §1367(c) are, to a considerable extent, a restatement of the factors in a *forum non conveniens* analysis⁷⁷ and require the district court to consider judicial economy, convenience, fairness to litigants, and comity.⁷⁸ Section 1367(c)(1) allows the court to decline to exercise supplemental jurisdiction if the claim “raises a novel or complex issue of State law.”⁷⁹ Patent claims, however, do not necessarily raise especially novel or complex issues under the laws of the issuing country, decreasing the likelihood that § 1367(c)(1) will be applicable to foreign patent cases in U.S. courts.⁸⁰ Additionally, § 1367(c)(2) gives the court discretion to decline to exercise supplemental jurisdiction “if the claim substantially predominates over the claim or claims over which the district court has original jurisdiction.”⁸¹ Furthermore, § 1367(c)(4) permits a court to decline to exercise supplemental jurisdiction “in excep-

72. See *Voda*, 476 F.3d at 900 (citing *Société Nationale Industrielle Aérospatiale*, 482 U.S. at 543 n.27).

73. See *Elmer & Garcia*, *supra* note 13, at 6.

74. U.S. Brief, *supra* note 44, at 12.

75. See *infra* Parts I.A.ii, I.B for a discussion of the relevant case law: *Voda*, 476 F.3d 887; *Mars II*, 24 F.3d 1368 (Fed. Cir. 1994); *Goldberg v. Cordis Corp.*, 203 U.S.P.Q. 717 (N.D. Ill. 1976), *aff'd*, 567 F.2d 392 (7th Cir. 1977); *Packard Instrument Co. v. Beckman Instruments, Inc.*, 346 F. Supp. 408 (N.D. Ill. 1972).

76. *Elmer & Garcia*, *supra* note 13, at 7; see *Dreyfuss*, *supra* note 13, at 433. Section 1367(c) was intended to codify the discretion to exercise supplemental jurisdiction that the Supreme Court emphasized in *Gibbs*. U.S. Brief, *supra* note 44, at 4-5. 28 U.S.C. § 1367(c) provides:

The district courts may decline to exercise supplemental jurisdiction over a claim under subsection (a) if—(1) the claim raises a novel or complex issue of State law, (2) the claim substantially predominates over the claim or claims over which the district court has original jurisdiction, (3) the district court has dismissed all claims over which it has original jurisdiction, or (4) in exceptional circumstances, there are other compelling reasons for declining jurisdiction.

28 U.S.C. § 1367(c) (2000).

77. U.S. Brief, *supra* note 44, at 14.

78. See *Chicago v. Int'l Coll. of Surgeons*, 522 U.S. 156, 172-73 (1997); Brief for Defendant-Appellant at 51, *Voda*, 476 F.3d 887 (No. 05-1238); U.S. Brief, *supra* note 44, at 10.

79. 28 U.S.C. § 1367(c)(1) (2000).

80. *Elmer & Garcia*, *supra* note 13, at 7. In *Mars*, the district court found that the foreign patent claim involved novel and complex issues of Japanese law. *Mars Inc. v. Kabushiki-Kaisha Nippon Conlux (Mars I)*, 825 F. Supp. 73, 76 (D. Del. 1993), *aff'd*, 24 F.3d 1368 (Fed. Cir. 1994) (“Mars’ claim of infringement of a Japanese patent . . . raise[s] novel and complex issues of Japanese law. For example[,] the parties disagree as to the extent to which Japanese law allows discovery, and the Court anticipates disagreements among the parties as to the substance of Japanese patent law.”).

81. 28 U.S.C. § 1367(c)(2) (2000).

tional circumstances” in which “there are other compelling reasons for declining jurisdiction.”⁸²

2. Multinational Patent Enforcement in U.S. Courts

American courts have historically been reluctant to adjudicate claims based on foreign intellectual property law, particularly patent law.⁸³ Despite the practical advantages to the patentee,⁸⁴ suits claiming infringement of foreign patents in U.S. courts have been relatively rare, suggesting that the general reluctance to assume such jurisdiction has led practitioners to believe that it would be futile to seek it.⁸⁵

In *Ortman v. Stanray*, the first case in which a U.S. court addressed the possibility of pendent, or supplemental, jurisdiction over foreign patent claims,⁸⁶ the district court exercised jurisdiction over the foreign claims.⁸⁷ This is a rarity in U.S. courts, as subsequent case law demonstrates.⁸⁸ The plaintiff, an Illinois resident, sued a Delaware corporation alleging infringement of a U.S. patent, as well as “equivalent” Canadian, Brazilian, and Mexican patents, which were all the basis of a contract between the plaintiff and the defendant.⁸⁹ The Seventh Circuit noted that, because the district court had jurisdiction over the alleged infringement of the U.S. patent under § 1338(a), the issue was whether the district court had pendent jurisdiction over the foreign patent infringement claims.⁹⁰ The court explained that “[u]nder ordinary circumstances, it would seem clear that plaintiff could not come into a United States District Court and sue for infringement of patents issued by Canada, Brazil and Mexico where such claim is based upon alleged acts of the defendant in each of the foreign countries named.”⁹¹ Nevertheless, stating that all of the defendant’s allegedly infringing domestic and foreign acts were similar, the court held that the doctrine of pendent jurisdiction could apply depending on the district court’s interpretation of the contract between the parties.⁹² On remand, the district court found that the *Gibbs* test for pendent jurisdiction was satisfied because “charges arising from the sale and manufacture of the same instrumentality in various countries clearly arise from a ‘common nucleus of operative fact.’”⁹³ Thus, both the Seventh Circuit and the dis-

82. 28 U.S.C. § 1367(c)(4) (2000).

83. See Chisum, *supra* note 18, at 610.

84. See Professors’ Brief, *supra* note 8, at 1.

85. See Chisum, *supra* note 18, at 610.

86. See Brief for Defendant-Appellant, *supra* note 78, at 22.

87. *Ortman v. Stanray (Ortman I)*, 371 F.2d 154 (7th Cir. 1967), *remanded to*, 163 U.S.P.Q. 331 (N.D. Ill. 1969), *rev’d on other grounds*, 437 F.2d 231 (7th Cir. 1971).

88. See Thomas, *supra* note 1, at 318-22.

89. *Ortman I*, 371 F.2d at 155-56.

90. *Id.* at 156-57.

91. *Id.* at 156.

92. *Id.* at 158.

93. *Ortman v. Stanray (Ortman II)*, 163 U.S.P.Q. 331 (N.D. Ill. 1969), *rev’d on other grounds*, 437 F.2d 231 (7th Cir. 1971) (quoting *United Mine Workers of America v. Gibbs*, 383 U.S. 715, 725 (1966)). Decided in 1967, the case came shortly after *Gibbs* but before Congress enacted § 1367 in 1990. See Elmer & Garcia, *supra* note 13, at 5.

strict court were receptive to the resolution of foreign patent claims under the doctrine of pendent jurisdiction.⁹⁴ However, the unique factual situation—the foreign patents were entangled in a contractual controversy between two U.S. nationals in which there was minimal risk of offending foreign nations—may limit the applicability of the court's holding to other foreign patent infringement claims.⁹⁵

In contrast, other U.S. courts have either indicated or assumed that they had authority to exercise jurisdiction over foreign patent claims but, nonetheless, have declined to exercise such jurisdiction.⁹⁶ In a 1972 district court case, *Packard Instrument Co. v. Beckman Instruments, Inc.*, another suit between two U.S. nationals, the plaintiff alleged infringement of its U.S. patent and nine corresponding patents from foreign countries.⁹⁷ Seeking to dismiss the foreign patent claims, the defendant noted that it would plead a defense of invalidity to all of the infringement claims.⁹⁸ The court assumed that it could exercise jurisdiction over the foreign patent claims on the basis of pendent jurisdiction or, alternatively, diversity jurisdiction,⁹⁹ but it declined to assert jurisdiction for several reasons.¹⁰⁰ First, the court's determination that a foreign patent, "an act of an agency of a foreign government," is invalid would raise "serious questions of comity."¹⁰¹ The court also noted that a foreign country's patent law is based on economic and social principles best understood by the courts of the granting nation.¹⁰² The court further stated that:

[i]t is not unlikely that the courts in the foreign countries whose patents are involved here would disagree with this court's determinations on the validity of the patents. Those courts would at any rate be faced with the hard choice of accepting the inexpert determination of a foreign court or creating an unseemly conflict with the judgment of the court of another country.¹⁰³

Thus, the prospects for enforcement of the judgment by a foreign court were uncertain.¹⁰⁴ Furthermore, translation difficulties would have inevitably arisen in dealing with the seven foreign languages necessary to adjudicate the foreign patents.¹⁰⁵ Perhaps most importantly, the court was unconvinced of the need to exercise jurisdiction over the foreign patent

94. See Thomas, *supra* note 1, at 319.

95. See Chisum, *supra* note 18, at 611.

96. Thomas, *supra* note 1, at 320.

97. 346 F. Supp. 408, 409 (N.D. Ill. 1972).

98. *Id.*; see Chisum, *supra* note 18, at 611.

99. *Packard*, 346 F. Supp. at 408.

100. Chisum, *supra* note 18, at 611; Thomas, *supra* note 1, at 320.

101. *Packard*, 346 F. Supp. at 410.

102. *Id.* at 410-11; see Chisum, *supra* note 18, at 612; Thomas, *supra* note 1, at 320.

103. *Packard*, 346 F. Supp. at 410.

104. See *id.*; Thomas, *supra* note 1, at 320.

105. See *Packard*, 346 F. Supp. at 411 ("Not only would this court be dependent upon legal opinions, undoubtedly conflicting, of experts in the laws of the foreign countries involved; the court would also be required to rely upon translations of those opinions and of the patents, statutes, regulations and court and administrative decisions on which the expert opinions are based. The risks of distortion of meaning in translation are apparent.").

claims “in order to give the plaintiff the relief to which it was entitled.”¹⁰⁶ Because the defendant only manufactured the accused devices in the United States, enforcement of the U.S. patent alone would allow the plaintiff to obtain injunctive relief and recover damages for each infringing device.¹⁰⁷

Additionally, in the 1976 case *Goldberg v. Cordis Corp.*, a district court declined to exercise jurisdiction over claims of infringement of Canadian and British patents on the basis of comity.¹⁰⁸ The court explained that “the validity of foreign patents would necessarily be in issue” in a foreign patent infringement claim.¹⁰⁹ Furthermore, determining the validity of foreign patents “would invite conflict with the administrative and judicial officers of those governments” and, thus, the power to adjudicate such conflicts should be exercised “with great reluctance.”¹¹⁰

Similarly, the Federal Circuit has displayed a conservative approach to the exercise of jurisdiction over foreign patent infringement claims.¹¹¹ In *Mars Inc. v. Kabushiki-Kaisha Nippon Conlux*, decided in 1994, the Federal Circuit held that a district court did not have supplemental jurisdiction over an infringement claim based on a Japanese patent.¹¹² The plaintiff, a U.S. national, filed an action in the Delaware district court against Nippon Conlux, a Japanese company, and Conlux U.S.A. Corporation, its U.S. subsidiary, for infringement of both a U.S. and a parallel Japanese patent.¹¹³ The district court “assumed, without deciding, that it had authority under section 1367(a)” to hear the Japanese patent infringement claim but declined to exercise supplemental jurisdiction based on international comity and a § 1367(c) discretionary analysis.¹¹⁴ Under the § 1367(c) analysis, the court reasoned that the case involved novel and complex issues of Japanese law and, therefore, the Japanese patent claims would substantially predominate over the U.S. patent claims.¹¹⁵ In regard to comity, the court held that even if, as the plaintiff argued, Japanese law prevented the defendant from asserting invalidity as a defense to infringement so that the court would not have to rule directly on the validity of the Japanese patent, the claim still implicated the principles underlying comity because the court must decide whether “a Japanese company is prohibited under Japanese law from making or selling its products in Japan.”¹¹⁶ Additionally, the court noted that most courts that have considered the issue of whether to exercise jurisdiction over a foreign patent infringement claim have

106. *See id.*; Thomas, *supra* note 1, at 320.

107. *See Packard*, 346 F. Supp. at 411; Chisum, *supra* note 18, at 612.

108. 203 U.S.P.Q. 717, 718 (N.D. Ill. 1976), *aff'd*, 567 F.2d 392 (7th Cir. 1977).

109. *Id.*; *see* Brief for Defendant-Appellant, *supra* note 78, at 25.

110. *Goldberg*, 203 U.S.P.Q. at 718; *see* Brief for Defendant-Appellant, *supra* note 78, at 25.

111. Thomas, *supra* note 1, at 280.

112. 24 F.3d 1368, 1375-76 (Fed. Cir. 1994).

113. *Id.* at 1370.

114. *Mars I*, 825 F. Supp. 73, 76 (D. Del. 1993); Thomas, *supra* note 1, at 321.

115. *Mars II*, 24 F.3d at 1374.

116. *Mars I*, 825 F. Supp. at 76.

refused to do so on account of comity concerns.¹¹⁷

On appeal, however, the Federal Circuit held that the district court erred in assuming that it had supplemental jurisdiction over the Japanese patent claim under § 1367(a) because the U.S. and Japanese patents did not derive from a common nucleus of operative fact.¹¹⁸ The Federal Circuit distinguished *Ortman*, holding,¹¹⁹ “[I]n contrast to *Ortman*, neither ‘similar acts’ nor the ‘same instrumentality’ are at issue” in the foreign patent claims.¹²⁰ In making this determination, the court noted four differences, now known as the “*Mars* factors,” between: (1) the respective patents, (2) the accused devices, (3) the allegedly infringing acts, and (4) the governing laws.¹²¹ First, the U.S. patent claims were method claims, but the Japanese patent claim was an apparatus claim.¹²² Second, the range of accused devices in Japan was much broader than in the United States.¹²³ Third, the allegedly infringing acts were different in that the defendant was charged with direct and induced infringement of the U.S. patent but only with direct infringement of the Japanese patent.¹²⁴ Fourth, the governing laws were different.¹²⁵ Commentators have argued that because these differences do not appear particularly significant individu-

117. *Id.* (citing *Goldberg v. Cordis Corp.*, 203 U.S.P.Q. 717 (N.D. Ill. 1976), *aff'd*, 567 F.2d 392 (7th Cir. 1977); *Packard Instrument Co. v. Beckman Instruments, Inc.*, 346 F. Supp. 408 (N.D. Ill. 1972)).

118. *Mars II*, 24 F.3d at 1375–76.

119. As affirmed by the Federal Circuit in *Voda v. Cordis Corp.*, 476 F.3d 887, 895 (Fed. Cir. 2007), given the *Mars* court’s deliberate attempt to distinguish the facts of *Ortman* without questioning its holding, *Mars* does allow for the possibility of a foreign patent claim sufficiently related to a U.S. patent claim to permit the existence of supplemental jurisdiction. See *Medigene AG v. Loyola Univ. of Chicago*, No. 98 C 2026, 2001 WL 1636916, at *1 (N.D. Ill. Dec. 19, 2001); Fritz Blumer, *Jurisdiction and Recognition in Transatlantic Patent Litigation*, 9 TEX. INTEL. PROP. L.J. 329, 345 (2001); Gerald J. Mossinghoff & Vivian S. Kuo, *World Patent System Circa 20XX, A.D.*, 38 IDEA 529, 541 (1998); Elmer & Garcia, *supra* note 13, at 5 & n.25; Wegner, *supra* note 18, at 28. But see *Berkshire Furniture Co., Inc. v. Glatstein*, 921 F. Supp. 1559, 1561 (W.D. Ky. 1995).

120. *Mars II*, 24 F.3d at 1375.

121. See *id.*; Chris Igielski, *Voda v. Cordis and the New Score on Supplemental Jurisdiction over Foreign Patent Claims: Comity-1, Judicial Discretion-0*, CASRIP NEWSL. (Ctr. for Advanced Study & Research on Intellectual Prop., Seattle, Wash.), Spring 2007.

122. *Mars II*, 24 F.3d at 1375; see Brief for Defendant-Appellant, *supra* note 78, at 27. A method claim is a patent claim that describes a method of making or using objects or substances to achieve a useful result. See BLACK’S LAW DICTIONARY 1161 (8th ed. 2004); CHISUM ET AL., *supra* note 3, at 92. A method claim patents the combination or sequence of acts or steps, not the resulting product. CHISUM ET AL., *supra* note 3, at 93. In contrast, an apparatus claim is a patent claim on a mechanical device or structure, which must recite the connection of the components and how they function together. See BLACK’S LAW DICTIONARY, *supra*, at 1160; CHISUM ET AL., *supra* note 3, at 93. The court did not consider whether the distinction in the claim formats had a substantive effect on the facts of the case. Thomas, *supra* note 1, at 323.

123. *Mars II*, 24 F.3d at 1375; see Brief for Defendant-Appellant, *supra* note 78, at 27. The court, however, admitted that some of the accused devices in Japan may have been similar to the U.S. device. *Mars II*, 24 F.3d at 1375; Thomas, *supra* note 1, at 323–24.

124. *Mars II*, 24 F.3d at 1375; see Brief for Defendant-Appellant, *supra* note 78, at 27. This difference is perhaps most puzzling given that the Japanese claim of direct infringement was a subset of the U.S. claim of direct and indirect infringement. Thomas, *supra* note 1, at 324.

125. *Mars II*, 24 F.3d at 1375.

ally or even as a whole,¹²⁶ the Federal Circuit's position that the U.S. and Japanese patent claims did not derive from a "common nucleus of operative fact" is "tenuous at best."¹²⁷

Going further, in dicta, the court anticipated that the plaintiff would replead jurisdiction based on diversity of citizenship.¹²⁸ The court noted that such an attempt would be futile because the trial court already made findings pertinent to a forum non conveniens analysis that supported dismissal, including translation issues, the difficulty of resolving complex issues of Japanese procedural and substantive law, and that "general concerns respecting international comity counsel against exercising jurisdiction over a matter involving a Japanese patent, Japanese law, and acts of a Japanese defendant in Japan."¹²⁹ This dicta confirms the Federal Circuit's hostility toward foreign patent claims.¹³⁰ Certainly, with such a rigorous application of the forum non conveniens doctrine, a U.S. court would rarely assume jurisdiction over a foreign patent claim.¹³¹ Although, as dicta, its precedential effect may be limited,¹³² its "chilling effect" has resulted in few attempts to seek multinational patent enforcement in U.S. courts.¹³³

In subsequent cases involving foreign intellectual property claims, district courts have had opposing interpretations of *Mars* and its implications for the availability of jurisdiction over foreign patent claims in U.S. courts. *Mars* has sometimes been interpreted to stand for a broad per se rule that U.S. courts never have supplemental jurisdiction over foreign patent claims.¹³⁴ In the 1995 case *Berkshire Furniture Co., Inc. v. Glattstein*,¹³⁵ for example, a district court noted that in *Mars*, "the Court of Appeals for the Federal Circuit held that U.S. courts do not have . . . supplemental jurisdiction to litigate foreign patents in the same action in which U.S. intellectual properties are in issue."¹³⁶ Nevertheless, in *Medigene AG v. Loyola University of Chicago*, another district court relied on § 1367 and *Mars* to find supplemental jurisdiction over claims related to the inventorship of foreign

126. See *supra* note 122-124; Thomas, *supra* note 1, at 323-24.

127. Chisum, *supra* note 18, at 613.

128. *Mars II*, 24 F.3d at 1375-76.

129. *Id.* at 1376.

130. See Chisum, *supra* note 18, at 613; Wegner, *supra* note 18, at 27.

131. Thomas, *supra* note 1, at 324.

132. *Id.*

133. Wegner, *supra* note 18, at 27.

134. See *Berkshire Furniture Co., Inc. v. Glattstein*, 921 F. Supp. 1559, 1561 (W.D. Ky. 1995).

135. *Id.* *Berkshire* did not involve patent claims; rather, the plaintiff asked the court to adjudicate the validity of foreign design registrations. *Id.* at 1560.

136. *Id.* at 1561. Courts have also cited *Mars* for its recognition that "general concerns respecting international comity counsel against exercising jurisdiction over a matter involving a Japanese patent and the acts of a Japanese defendant in Japan," see *S. Megga Telecommunications Ltd. v. Lucent Techs., Inc.*, No. 96-357-SLR, 1997 WL 86413 (D. Del. Feb. 14, 1997) (quoting *Mars II*, 24 F.3d 1368, 1376 (Fed. Cir. 1994)); *Berkshire*, 921 F. Supp. at 1561 (quoting *Mars II*, 24 F.3d at 1376), which is a less controversial proposition given its recurrence in U.S. case law.

patent applications.¹³⁷ In its motion to dismiss counts of the defendant's counterclaim, the plaintiff relied on *Mars* for the proposition that disputes about foreign patent applications are beyond the jurisdictional reach of § 1367(a).¹³⁸ The district court, however, disagreed and denied the motion, ruling, "We do not read that case to support any such broad rule. Rather, the discussion of the Court made clear that in appropriate circumstances Section 1367 permits exercise of supplemental jurisdiction over a claim for infringement of a foreign patent."¹³⁹ The court held that, in contrast to the facts in *Mars*, the *Medigene* defendant's counterclaim alleged that the foreign patent applications pertained to the same invention and involved the same co-inventorship issue as the U.S. patent,¹⁴⁰ which warranted the existence of supplemental jurisdiction.¹⁴¹ Certainly, the opposing interpretations of *Mars* regarding the availability of supplemental jurisdiction over foreign patent claims in the United States required clarification.¹⁴²

B. *Voda v. Cordis Corp.*: The Federal Circuit Restricts Multinational Patent Enforcement in U.S. Courts

1. *The Voda Decision*

In *Voda v. Cordis Corp.*, the Federal Circuit addressed the jurisdictional reach of U.S. courts to adjudicate foreign patent disputes pursuant to supplemental jurisdiction.¹⁴³ In so doing, the court perpetuated the conservative approach of U.S. courts, particularly the Federal Circuit, to multinational patent enforcement, largely eliminating any hope for multinational patent enforcement in U.S. courts.¹⁴⁴

On October 30, 2003, Dr. Voda, an Oklahoma cardiologist, filed an action against Cordis Corporation, a Florida medical device corporation,¹⁴⁵ in the Western District of Oklahoma seeking damages for alleged infringement of three U.S. patents protecting guiding catheters in angi-

137. See No. 98 C 2026, 2001 WL 1636916, at *1 (N.D. Ill. Dec. 19, 2001); Brief for Appellee, *supra* note 19, at 24.

138. See *Medigene*, 2001 WL 1636916, at *1.

139. *Id.* (citing *Mars II*, 24 F.3d at 1374-75).

140. In a motion to dismiss, the court must assume the truth of the allegations. See *id.*

141. *Id.* The court declined to consider the motion to dismiss on the basis of forum non conveniens because, at the time, the court did not know enough about the foreign patent claims to tell whether any of the problems anticipated by the defendant were likely to arise. *Id.* at *2.

142. See Order Granting Appeal, *supra* note 21 (finding that the issue of the court's supplemental jurisdiction over the foreign patents presents "a controlling question of law to which there is a substantial difference of opinion . . .").

143. 476 F.3d 887 (Fed. Cir. 2007); Darryl J. Adams, *Foreign Patent Disputes Are Off-Limits for U.S. Courts*, INTELL. PROP. STRATEGIST (Law Journal Newsletters, Phila., Pa.), Apr. 2004.

144. See Adams, *supra* note 143.

145. Dr. Voda did not join any of the foreign Cordis affiliates, which the Federal Circuit believed to be separate legal entities. *Voda*, 476 F.3d at 890. All of the Cordis companies, both U.S. and foreign, are subsidiaries of Johnson & Johnson. *Id.* at 890 n.1.

oplasty.¹⁴⁶ During discovery, Dr. Voda learned that Cordis sold the allegedly infringing catheter in Canada and Europe.¹⁴⁷ On June 14, 2004, Dr. Voda, arguing that 28 U.S.C. § 1367(a) gave the district court supplemental jurisdiction,¹⁴⁸ moved to amend his complaint to assert the infringement of his European, British, French, German, and Canadian foreign patents.¹⁴⁹ Dr. Voda's foreign patents resulted from a common PCT application, which was an amended version of Dr. Voda's original U.S. patent application.¹⁵⁰ The three U.S. patents already at issue in the case resulted from continuation applications¹⁵¹ of this original U.S. patent application.¹⁵² Dr. Voda admitted that there was some subject matter in the U.S. patents already at issue that was not present in the foreign patents but insisted that the claims of the U.S. patents and the foreign patents were "substantially identical."¹⁵³

After considering both parties' briefs, the district court granted Dr. Voda's motion to amend his complaint to add infringement claims based on his foreign patents.¹⁵⁴ Although Cordis cited *Mars* for the proposition that U.S. courts do not have supplemental jurisdiction over foreign patent infringement claims in a U.S. patent suit, the district court, like that in *Medigene*,¹⁵⁵ disagreed, holding that "*Mars* . . . does not support such a broad rule."¹⁵⁶ The district court pointed out that the *Mars* court distinguished that case from *Ortman*, in which all of the defendant's allegedly

146. See *id.* at 890-91; Order Granting Amendment, *supra* note 20; Brief for Defendant-Appellant, *supra* note 78, at 2; Elmer & Garcia, *supra* note 13, at 4. Dr. Voda's three U.S. patents at issue in the case were U.S. Patent No. 5,445,625; 6,083,213; and 6,475,195. Brief for Defendant-Appellant, *supra* note 78, at xiii.

147. Brief for Appellee, *supra* note 19, at 10; see Brief for Defendant-Appellant, *supra* note 78, at 12.

148. Dr. Voda did not assert any other statutory basis for subject matter jurisdiction. *Voda*, 476 F.3d at 893 n.5. Therefore, although the parties disputed on appeal whether diversity jurisdiction under § 1332 provided an alternative basis for jurisdiction over Dr. Voda's foreign patent infringement claims, the Federal Circuit declined to decide whether the district court could properly exercise jurisdiction based on diversity. *Id.* at 905.

149. Brief for Appellee, *supra* note 19, at 10-11; Elmer & Garcia, *supra* note 13, at 4. The five foreign patents that Dr. Voda sought to include in his amended complaint are: (1) European Patent No. 0 568 624, (2) German Patent No. DE 69 23 20 95, (3) British Patent No. GB 568 624, (4) French Patent No. FR568624, and (5) Canadian Patent No. CA 2,100,785. *Voda*, 476 F.3d at 890; Brief for Defendant-Appellant, *supra* note 78, at 2.

150. See *Voda*, 476 F.3d at 890; Brief for Defendant-Appellant, *supra* note 78, at 8.

151. A continuation application is an application that is filed while an earlier-filed "parent" application is pending, which carries on the prosecution of some or all of the original parent application. See BLACK'S LAW DICTIONARY, *supra* note 122, at 1159.

152. See Brief for Appellee, *supra* note 19, at 5-6; Brief for Defendant-Appellant, *supra* note 78, at 5-10, for a detailed description of the patent prosecution history for each of the patents at issue in *Voda*.

153. Brief for Appellee, *supra* note 19, at 7.

154. *Voda*, 476 F.3d at 891; Order Granting Amendment, *supra* note 20; Brief for Appellee, *supra* note 19, at 10-11.

155. See *Medigene AG v. Loyola Univ. of Chicago*, No. 98 C 2026, 2001 WL 1636916, at *1 (N.D. Ill. Dec. 19, 2001).

156. Order Granting Amendment, *supra* note 20.

infringing domestic and foreign acts were similar.¹⁵⁷ Noting that “this case is more akin to *Ortman* than to *Mars*,” the district court found that it would have supplemental jurisdiction over Dr. Voda’s foreign patent infringement claims.¹⁵⁸

On August 27, 2004, Cordis moved for reconsideration or, alternatively, for the decision to be certified for appeal.¹⁵⁹ On January 7, 2005, the district court denied reconsideration but granted Cordis’s motion to certify the order for interlocutory appeal, finding that:

the issue of its jurisdiction over the foreign patents presents a controlling question of law on which a substantial ground for difference of opinion exists and the resolution of which would materially advance the ultimate resolution of this action. The court is loathe to put the parties to the expense of litigating the foreign patents if indeed it does not have subject matter jurisdiction over those claims.¹⁶⁰

Cordis then petitioned for review on the issue of “whether the district court has supplemental subject matter jurisdiction over Dr. Voda’s five foreign patents.”¹⁶¹ “Because of the paucity of law surrounding this issue,” the Federal Circuit granted Cordis’s interlocutory appeal on February 22, 2005.¹⁶² The pending Federal Circuit decision in *Voda* sparked increased debate about the availability of multinational patent enforcement in U.S. courts, as evidenced by the five amici curiae briefs on behalf of the United States, the American Intellectual Property Law Association (AIPLA), the Intellectual Property Owners Association (IPOA),¹⁶³ the Federal Circuit Bar Association, and several law professors.¹⁶⁴

157. *Id.*

158. *Id.*

159. Brief for Appellee, *supra* note 19, at 12; Brief for Defendant-Appellant, *supra* note 78, at 3; Elmer & Garcia, *supra* note 13, at 4.

160. *Voda v. Cordis Corp.*, No. CIV-03-1512-L (W.D. Okla. Jan. 7, 2005) (order denying defendant’s motion for reconsideration and granting defendant’s alternative motion for certification).

161. See Order Granting Appeal, *supra* note 21.

162. Brief for Defendant-Appellant, *supra* note 78, at 3. The Federal Circuit has shown “extreme reluctance” to accept an interlocutory appeal in a patent case, which makes *Voda* “all the more surprising as the Federal Circuit oddly granted an interlocutory appeal . . . with very few of the critical facts needed for a decision.” Wegner, *supra* note 18, at 33. Evidencing the lack of a developed record on the foreign patents, in view of the appeal, Cordis did not answer Dr. Voda’s amended complaint and no discovery was taken on the foreign patents. Brief for Defendant-Appellant, *supra* note 78, at 3.

163. An executive from Johnson & Johnson, which owns the defendant, Cordis Corporation, holds one of the forty-five board positions in the IPOA. Igielski, *supra* note 121.

164. See Brief for Amicus Curiae American Intellectual Property Law Association in Support of Defendant-Appellant, *Voda v. Cordis Corp.*, 476 F.3d 887 (Fed. Cir. 2007) (No. 05-1238); Brief of Amicus Curiae the Federal Circuit Bar Association in Support of Defendant-Appellant’s Position Seeking Reversal of the District Court’s Aug. 2, 2004 Order, *Voda*, 476 F.3d 887 (No. 05-1238) [hereinafter Federal Circuit Bar Association Brief]; Brief of Intellectual Property Owners Association as Amicus Curiae in Support of Appellant, *Voda*, 476 F.3d 887 (No. 05-1238); Professors’ Brief, *supra* note 8; U.S. Brief, *supra* note 44.

After oral arguments on January 12, 2006,¹⁶⁵ the Federal Circuit eventually handed down a long-awaited opinion more than a year later.¹⁶⁶ On February 1, 2007, in a 2-1 decision, the panel majority ruled that the district court abused its discretion by assuming jurisdiction over Dr. Voda's foreign patents.¹⁶⁷ The majority clearly set forth the two-part test for the appropriate exercise of supplemental jurisdiction pursuant to § 1367,¹⁶⁸ requiring both (1) the presence of jurisdiction under § 1367(a) and (2) an "appropriate decision" to exercise that jurisdiction under § 1367(c).¹⁶⁹ Finding that the district court abused its discretion under the second prong of the analysis in failing to decline jurisdiction under § 1367(c),¹⁷⁰ the court did not squarely address the first prong of the analysis, whether the district court had authority to exercise supplemental jurisdiction under § 1367(a).¹⁷¹ Thus, the court refocused the inquiry from whether the district court "could" exercise jurisdiction over Dr. Voda's foreign patent infringement claims under § 1367(a) to whether it "ought" to have done so "as a matter of judicial discretion under § 1367(c)."¹⁷²

Under the first prong of the supplemental jurisdiction analysis, whether § 1367(a) authorizes supplemental jurisdiction over foreign patent claims, the majority noted that the district court was correct in that *Mars* did not establish a per se rule barring U.S. courts from adjudicating foreign patents.¹⁷³ Thus, the court clarified the opposing interpretations of *Mars* in earlier district court decisions.¹⁷⁴ Further, the court explained that the *Mars* factors¹⁷⁵ do not supplant the *Gibbs* test codified in § 1367(a) and are neither an exhaustive list of factors to consider nor necessary conditions for finding supplemental jurisdiction under § 1367(a).¹⁷⁶ The court, however, objected to the district court's failure to articulate any analysis of relevant factors,¹⁷⁷ merely concluding that "allegations in the amended complaint demonstrate that this case is more akin to *Ortman* than to *Mars*,"¹⁷⁸ which does not answer the legal question of

165. Elmer & Garcia, *supra* note 13, at 4.

166. See *Voda*, 476 F.3d 887.

167. See Igielski, *supra* note 121.

168. Takenaka, *supra* note 24.

169. *Voda*, 476 F.3d at 891.

170. *Id.*

171. See Igielski, *supra* note 121.

172. *Id.* As Igielski notes, there is both "logical and historical irony in the *Voda* approach." *Id.* Logically, it seems that a court can only decline to exercise jurisdiction when the court ascertains that it has jurisdiction. *Id.* This is the approach that the Federal Circuit took in *Mars*, holding that it was erroneous for the district court to assume that it had jurisdiction under § 1367(a) before declining to exercise jurisdiction under § 1367(c). *Id.*

173. *Voda*, 476 F.3d at 895.

174. See *supra* pp. 116-117 for a discussion of district courts' disagreement over whether *Mars* established a per se rule that U.S. courts could never have supplemental jurisdiction over foreign patent claims.

175. See *supra* pp. 114-115 for a discussion of the *Mars* factors.

176. See *Voda*, 476 F.3d at 895.

177. *Id.*

178. *Id.* at 895-96 (quoting Order Granting Amendment, *supra* note 20).

whether the claims satisfy the *Gibbs* test.¹⁷⁹ Nevertheless, reasoning that it was “more prudent . . . not to decide this ‘common nucleus of operative fact’ question in the first instance,”¹⁸⁰ the court refrained from deciding whether Dr. Voda’s foreign patent infringement claims satisfied the threshold requirement of § 1367(a).¹⁸¹

Instead, the court’s decision turned on the district court’s abuse of discretion in assuming jurisdiction over the foreign patent claims without performing a proper § 1367(c) discretionary analysis.¹⁸² The court held that the § 1367(c) considerations of comity, judicial economy, convenience, fairness, and other exceptional circumstances, including international treaty obligations, constitute compelling reasons to decline jurisdiction in this case.¹⁸³ Although the interlocutory appeal was taken on the pleadings, the Federal Circuit demanded a thorough analysis of these factors as a “condition precedent to the proper exercise of [supplemental] jurisdiction,” emphasizing that § 1367(c) requires a case-specific inquiry at every stage of litigation.¹⁸⁴ In regard to each factor, the court set “tough standards”¹⁸⁵—further displaying the Federal Circuit’s hostility toward the adjudication of foreign patent claims in U.S. courts.

First, the court noted that a district court’s exercise of supplemental jurisdiction over foreign patent claims could undermine the international treaty obligations of the United States, constituting an exceptional circumstance to decline jurisdiction under § 1367(c)(4).¹⁸⁶ The international patent treaties, including the Paris Convention, the PCT, and TRIPS, to which the United States and each foreign country whose patents were at issue are parties, do not contemplate or allow one jurisdiction to adjudicate the patents of another.¹⁸⁷ Although conceding that the treaties do not expressly prohibit courts from adjudicating foreign patent claims, the court explained that each affirms the independence of member nations’ patent granting and adjudication systems.¹⁸⁸ Therefore, regardless of the harmonization trend that these treaties may represent, the court found that “we as the U.S. judiciary should not unilaterally decide either for our government or for other foreign sovereigns that our courts will become the adjudicating body for any foreign patent with a [sufficiently related] U.S.

179. *Id.* at 896.

180. *Id.*

181. *See id.* at 897; Adams, *supra* note 143.

182. *See Voda*, 476 F.3d at 898.

183. *See id.*

184. Igielski, *supra* note 121 (quoting *Chicago v. Int’l Coll. of Surgeons*, 522 U.S. 156, 173 (1997)).

185. *Id.*

186. *Voda*, 476 F.3d at 900.

187. *See id.* at 898-99.

188. *See id.* at 899. To inform its analysis, the court contrasted these treaties with the EPC, which has rules specifying courts of exclusive jurisdiction. *See id.* at 899 n.8. The court further noted that even members of the EPC have not been able to agree on a centralized European patent court. *Id.* *See supra* note 11 and *infra* Part II.C pp. 553-54 for a description of the EPC.

equivalent”¹⁸⁹ Thus, for the Federal Circuit, the international patent treaties to which the United States is a party present a strong rationale to decline supplemental jurisdiction under § 1367(c).

Next, the court determined that comity strongly disfavors the exercise of supplemental jurisdiction over Dr. Voda’s foreign patent claims.¹⁹⁰ The court held that the four considerations of comity from *Société Nationale Industrielle Aérospatiale v. United States District Court*¹⁹¹ did not support the district court’s exercise of supplemental jurisdiction because (1) there is no international duty to adjudicate the foreign claims, (2) Dr. Voda did not show that adjudicating his foreign patent claims would enhance convenience, (3) Dr. Voda failed to show that foreign courts would inadequately protect his foreign patent rights, and (4) the exercise of jurisdiction could prejudice the rights of foreign governments.¹⁹² Thus, the court concluded that exercising jurisdiction over Dr. Voda’s foreign patent infringement claims would “undermine the ‘spirit of cooperation’ underlying the comity doctrine.”¹⁹³

Further, the court concluded that exercising jurisdiction in this case would risk “unreasonable interference with the sovereign authority of other nations,” which ordinarily should be avoided.¹⁹⁴ The court reasoned that because the foreign countries whose patents were at issue had specialized judges, resources, and procedures to foster integrity and consistency in the application of their patent laws, exercising jurisdiction over Dr. Voda’s foreign patents could disrupt their established procedures.¹⁹⁵

The court also found that judicial economy failed to support the exercise of supplemental jurisdiction in this case because U.S. courts and juries lacked knowledge of and experience with the foreign patent regimes at issue.¹⁹⁶ Going further, the court noted that, under § 1367(c)(2), the adjudication of Dr. Voda’s five foreign patents may substantially predominate his U.S. patent claims.¹⁹⁷ Moreover, the court emphasized that the United States is not a member of any international treaty requiring foreign countries to recognize or enforce its judgments.¹⁹⁸ Thus, the court countered the argument that consolidating foreign patent claims in one U.S. court would be more efficient with the “major drawback”¹⁹⁹ of the

189. *Voda*, 476 F.3d at 900.

190. *See id.* at 900-03.

191. *See supra* p. 110 for a discussion of these factors.

192. *See Voda*, 476 F.3d at 901; Adams, *supra* note 143; Igielski, *supra* note 121.

193. *Voda*, 476 F.3d at 902.

194. *See id.* (quoting *F. Hoffmann-La Roche Ltd. v. Empagran S.A.*, 542 U.S. 155, 164 (2004)).

195. *Id.* at 902-03. By way of analogy, the court further pointed out that foreign courts’ exercise of jurisdiction over U.S. patent claims would destroy Congress’s attempt to unify U.S. patent jurisprudence by creating the Federal Circuit to which Congress granted exclusive jurisdiction to hear appeals on patent claims. *Id.* at 903.

196. *Id.*

197. *Id.*

198. *See id.*

199. John R. Schmertz & Mike Meier, *In Reviewing District Court’s Finding of Supplemental Jurisdiction Over Foreign Patent Infringement Claims, Panel Majority of Federal*

uncertainty of foreign enforcement due to the present lack of international mechanisms to secure the enforcement of U.S. judgments abroad.²⁰⁰

Finally, the court opined that the act of state doctrine may make the exercise of supplemental jurisdiction over foreign patent claims “fundamentally unfair.”²⁰¹ Unconvinced that the grant of a patent by a sovereign is not an act of state, the court assumed, without deciding, that the act of state doctrine applied to foreign patent claims.²⁰² Under this assumption, U.S. courts could not question the validity of a foreign patent and would have to adjudicate the patent claim regardless of validity or enforceability.²⁰³ Because many patent cases are resolved on validity or enforceability grounds, exercising such jurisdiction could be unfair to the alleged infringer.²⁰⁴

Based on this reasoning, the court concluded that the district court was compelled to decline supplemental jurisdiction over Dr. Voda’s foreign patent infringement claims under § 1367(c).²⁰⁵ Because the district court failed to undertake any analysis under § 1367(c), the court held that the district court abused its discretion in exercising supplemental jurisdiction.²⁰⁶ Therefore, the court vacated the order of the district court granting Dr. Voda leave to amend his complaint to add his foreign patent infringement claims pursuant to § 1367.²⁰⁷

In her lengthy dissent, Judge Pauline Newman concluded that the district court did not abuse its discretion in exercising jurisdiction over Dr. Voda’s foreign patent infringement claims.²⁰⁸ The dissent argued that the criteria of § 1367 “reinforce, rather than negate, the district court’s exercise of discretion to accept Voda’s amended complaint.”²⁰⁹ Specifically, the dissent vehemently contested the majority’s finding that judicial economy does not support the exercise of supplemental jurisdiction, arguing that “[i]t surely is not apparent that multiple litigation of the same issues in five countries and three languages is likely to be more economical of judicial time and litigation expense . . . than resolving all of the issues before one judge in one case and one language.”²¹⁰ Furthermore, the dissent argued that, rather than merely considering convenience to U.S. courts, the court could have considered the overwhelming convenience to both parties of avoiding multiple litigations in foreign countries.²¹¹ Pointing to extensive supporting case law, the dissent argued that U.S. courts routinely

Circuit Finds Abuse of Discretion Based on Comity, Judicial Economy, Convenience, and Fairness, INT’L L. UPDATE (Transnational Law Assocs., LLC, Wash., D.C.), Feb. 2007.

200. See Adams, *supra* note 143; Schmertz & Meier, *supra* note 199.

201. Voda, 476 F.3d at 904.

202. *Id.* at 903; see Adams, *supra* note 143; Schmertz & Meier, *supra* note 199.

203. Voda, 476 F.3d at 904; see Adams, *supra* note 143.

204. Voda, 476 F.3d at 904.

205. *Id.*

206. *Id.*

207. *Id.* at 905.

208. See Adams, *supra* note 143.

209. Voda, 476 F.3d at 909 (Newman, J., dissenting).

210. *Id.* at 913.

211. See *id.* at 911; Igielski, *supra* note 121.

determine and apply foreign law.²¹² Adopting a view common to proponents of patent harmonization,²¹³ the dissent emphasized that the application of foreign patent law would not be a significant challenge to U.S. courts because similar policies underlie the patent law of all industrialized nations.²¹⁴

Significantly, the dissent emphasized the broad restrictive effect of the majority's decision on the possibility of multinational patent enforcement in U.S. courts.²¹⁵ Judge Newman's opinion stressed that the majority's "extreme limitation and bar"²¹⁶ on the district court's exercise of discretion to assume supplemental jurisdiction over foreign patent claims "essentially eliminates" any such discretion in foreign patent cases.²¹⁷ For Judge Newman, "in contrast to the case-specific analyses in precedent," under the majority's opinion, "it would always be an abuse of discretion for the district court to decide foreign patent issues, unless some sort of new treaty is produced."²¹⁸

2. *Implications for Multinational Patent Enforcement in U.S. Courts*

The dissent's characterization of the breadth of the *Voda* holding is likely not overstated,²¹⁹ as the facts of *Voda* arguably approached an ideal case for consolidation of foreign patent claims.²²⁰ Both the plaintiff and the defendant were U.S. nationals.²²¹ Furthermore, the foreign patents shared a common lineage in that they all originated from a common PCT application and, additionally, they were counterparts of the asserted U.S. patents.²²² Moreover, the domestic and foreign acts constituting infringement were identical,²²³ involving direct infringement of a single accused

212. See *Voda*, 476 F.3d at 906-09 (Newman, J., dissenting); Takenaka, *supra* note 24.

213. See Professors' Brief, *supra* note 8, at 18-21 ("[I]t is simply inaccurate to assert that assumption of foreign patent infringement claims will invariably lead U.S. courts into unknown landscapes. Core doctrines of the leading patent-issuing states are substantially similar to the point of identity"); Wegner, *supra* note 18, at 2; Takenaka, *supra* note 24.

214. See *Voda*, 476 F.3d at 917 (Newman, J., dissenting).

215. See *id.* at 906-17.

216. *Id.* at 917.

217. *Id.* at 910.

218. *Id.* at 909.

219. See Adams, *supra* note 143.

220. See Brief for Appellee, *supra* note 19, at 15 ("Indeed, if the facts of this case do not justify exercise of jurisdiction over some or all of the Counterpart Patents then this Court should simply forthrightly and plainly announce that no such claims should ever be entertained. And yet, the case for jurisdiction is strong—especially given the unique facts of this case.").

221. See *Voda*, 476 F.3d at 890; Ramsey Al-Salaam, Presentation at the High Technology Protection Summit at the University of Washington School of Law: Adjudicating Foreign Intellectual Property Claims in United States Courts 1 (July 21, 2000), available at <http://www.law.washington.edu/casrip/Symposium/Number6/Al-Salaam.pdf>.

222. See *Voda*, 476 F.3d at 910-11 (Newman, J., dissenting); Elmer & Garcia, *supra* note 13, at 6. The parties disagreed about the extent of similarity between the patents; Cordis argued that the patents differed materially, whereas Dr. Voda argued that they differed only in slight respects. *Voda*, 476 F.3d at 895.

223. See Elmer & Garcia, *supra* note 13, at 6; Rader, *supra* note 14, at 5.

device.²²⁴ Finally, only monetary damages were sought against the defendant, a U.S. company with substantial U.S. assets,²²⁵ preventing the need for foreign enforcement of a judgment on the foreign patent claims.²²⁶ Despite the strong argument for supplemental jurisdiction based on these facts, the Federal Circuit still found that the district court abused its discretion in assuming supplemental jurisdiction over Dr. Voda's foreign patent infringement claims.

Therefore, although the *Voda* decision did not completely eliminate the possibility of supplemental jurisdiction over foreign patent claims, it largely forecloses any such opportunity.²²⁷ With the exception of the obligations of the United States under international patent treaties, the majority nominally made its analysis specific to Dr. Voda's foreign patent claims;²²⁸ however, the dissent is correct in that most of the Federal Circuit's findings are generic to all foreign patent claims.²²⁹ For example, the majority neither analyzed the specific patent judicial systems of any of the foreign countries whose patents were at issue nor addressed the extent of difference between U.S. patent law and the patent laws of the foreign countries whose patents were at issue.²³⁰ Furthermore, although the court noted that a change in circumstances, such as "if the United States were to enter into a new international patent treaty," might alter the analysis,²³¹ there are currently no plans for such a treaty.²³² Finally, despite the particularly low risk of offending a foreign sovereign because the case involved only U.S. parties and no foreign sovereign's cooperation would have been necessary to secure the requested monetary judgment, the Federal Circuit still found that comity was a compelling basis to decline jurisdiction over the foreign patent claims.²³³ Thus, the *Voda* court's comity analysis appears to largely preempt federal jurisdiction over foreign patent claims.²³⁴

As such, it would be difficult to imagine a foreign patent claim that would pass the Federal Circuit's rigorous analysis laid out in both *Mars* and *Voda*. For diversity jurisdiction cases, the rigorous application of the forum non conveniens doctrine in the *Mars* dicta ensures that U.S. courts would properly assume jurisdiction over foreign patents based on diversity

224. See *Voda*, 476 F.3d at 895; Igielski, *supra* note 121.

225. See *Elmer & Garcia*, *supra* note 13, at 8 ("The most compelling case for consolidation occurs when the plaintiff seeks only a damage award and the enforcement of that award in the United States.").

226. See Igielski, *supra* note 121.

227. See *Takenaka*, *supra* note 24.

228. See *Voda*, 476 F.3d at 899-905.

229. See *id.* at 909 (Newman, J., dissenting); *Adams*, *supra* note 143; Igielski, *supra* note 121.

230. See *Voda*, 476 F.3d at 902-03; *Adams*, *supra* note 143.

231. See *Voda*, 476 F.3d at 905.

232. See *id.* at 916 (Newman, J., dissenting).

233. See Igielski, *supra* note 121.

234. See *id.*

jurisdiction only in rare cases.²³⁵ For supplemental jurisdiction, the two Federal Circuit decisions set tough standards for both prongs of the § 1367 analysis. First, in the § 1367(a) analysis of *Mars*, the Federal Circuit's rigorous application of the *Mars* factors limits the number of foreign patent claims that would pass the "common nucleus of operative fact" test.²³⁶ Moreover, even if a claim were to pass the first prong of the supplemental jurisdiction analysis under § 1367(a), the *Voda* decision severely restricts judicial discretion to exercise jurisdiction under § 1367(c).²³⁷ Thus, as emphasized in Judge Newman's dissent, *Voda* significantly limited the possibility of a U.S. court assuming supplemental jurisdiction over foreign patent infringement claims.²³⁸ Although the *Voda* decision may be disappointing for patent litigants that must pursue litigation in various national courts, Europe's example demonstrates the wisdom of the Federal Circuit's restriction of multinational patent enforcement in U.S. courts.

II. Europe

A. Multinational Patent Injunctions: Dutch Courts Attack Patent Territoriality

Although Europe has a streamlined method for national patent acquisition under the European Patent Convention (EPC),²³⁹ until recently, patentees had no recourse to a similarly centralized patent enforcement forum in Europe and, thus, had to pursue separate patent infringement litigations in national courts.²⁴⁰ The 1989 Dutch Supreme Court decision in *Lincoln v. Interlas*,²⁴¹ however, began a trend of multinational patent enforcement, attacking the traditional territoriality of patent rights.²⁴²

In *Lincoln v. Interlas*, the Dutch Supreme Court granted an injunction against trademark infringement in Belgium and Luxembourg in addition to the Netherlands.²⁴³ *Interlas*, a Dutch company, imported diesel welding units bearing the "Lincoln" trademark from the United States into the Netherlands, modified the units, and offered them for sale throughout Europe.²⁴⁴ The Dutch owners of the "Lincoln" trademark sued *Interlas* in the Netherlands for trademark infringement.²⁴⁵ Because the plaintiffs'

235. See *Mars II*, 24 F.3d 1368, 1375-76 (Fed. Cir. 1994); Chisum, *supra* note 18, at 613; Thomas, *supra* note 1, at 324; Wegner, *supra* note 18, at 27. See *supra* pp. 535 for a discussion of the *Mars* dicta.

236. See *Mars II*, 24 F.3d at 1375; Chisum, *supra* note 18, at 613. See *supra* pp. 533-34 for a discussion of the *Mars* § 1367(a) analysis.

237. See *Voda*, 476 F.3d at 909 (Newman, J., dissenting); Adams, *supra* note 143; Igielski, *supra* note 121.

238. See *Takenaka*, *supra* note 24.

239. See *supra* note 11 and *infra* Part II.C pp. 553-54 for a description of the EPC.

240. Thomas, *supra* note 1, at 299.

241. Judgment of Nov. 24, 1989, HR, 1992 NJ 404 (Neth.).

242. Bender, *supra* note 3, at 68; John Gladstone Mills III, *A Transnational Patent Convention for the Acquisition and Enforcement of International Rights*, 84 J. PAT. & TRADE-MARK OFF. SOC'Y 83, 103 (2002); Thomas, *supra* note 1, at 299.

243. Mills, *supra* note 242, at 104.

244. Thomas, *supra* note 1, at 299.

245. Mills, *supra* note 242, at 103; Thomas, *supra* note 1, at 299.

trademark rights were also effective in Belgium and Luxembourg, the plaintiffs' requested relief included an injunction against infringement in each of these jurisdictions, which the lower court granted.²⁴⁶ On appeal, the defendants questioned the court's jurisdiction to issue the multinational injunction, but the Supreme Court rejected this argument, reasoning that to hold otherwise would lead to the "undesirable result" that the injured party must file suit in every country where infringement occurred.²⁴⁷ Thus, the Dutch Supreme Court specifically acknowledged that Dutch courts had the right to enforce intellectual property rights outside the Netherlands.²⁴⁸

In view of the *Interlas* decision, Dutch lower courts granted several multinational injunctions in cases involving patent infringement litigation.²⁴⁹ For example, in the 1994 case, *Chiron Corp. v. Organanon AKZO Pharma-Organon Technika-UBI*,²⁵⁰ the plaintiff, a U.S. company, sued four Dutch AKZO subsidiaries, one Belgium subsidiary, and a U.S. supplier.²⁵¹ The court of appeals upheld the trial court decision to grant an injunction against all the defendants in the countries in which the plaintiff held a European patent.²⁵²

Although no specific legislation authorizing multinational injunctions for patent infringement exists,²⁵³ Dutch courts issuing such injunctions relied primarily on two different international agreements: the EPC and the Brussels Convention on Jurisdiction and Enforcement of Judgments in Civil and Commercial Matters.²⁵⁴ Because Dutch domestic patent law is integrated into the European system through the EPC,²⁵⁵ Dutch courts acknowledged the success of the EPC and reasoned that a single legal determination under Dutch law is sufficient to establish patent status throughout Europe and, in fact, is preferable to multiple suits for both simplicity and the credibility of the European patent system.²⁵⁶ Further, as the Netherlands is a member of the EU, Dutch courts relied on the Brussels Convention, which applies only to member states of the EU.²⁵⁷ The Brus-

246. Thomas, *supra* note 1, at 299.

247. *Lincoln v. Interlas*, Judgment of Nov. 24, 1989, HR, 1992 NJ 404, 1606 (Neth.); Thomas, *supra* note 1, at 300.

248. Bender, *supra* note 3, at 68.

249. Bender, *supra* note 3, at 68-71; Mills, *supra* note 242, at 104-105. See *Applied Research Systems v. Organon*, 1994 IER, No. 57 (Hague Ct. of App. Feb. 1994); *Chiron Corp. v. Organon AKZO Pharma-Organon Technika-UBI*, 1994 IER, No. 10 (Hague Dist. Ct. Jul. 1994), *upheld* 1994 IER, No. 24 (Hague Dist. Ct. Dec. 94); *Philips v. Hemogram*, 1992 BIE, No. 80 (Hague Dist. Ct. Dec. 1991).

250. 1994 IER, No. 10 (Hague Dist. Ct. Jul. 1994), *upheld* 1994 IER, No. 24 (Hague Dist. Ct. Dec. 1994).

251. Bender, *supra* note 3, at 70.

252. *Id.*

253. Shaw, *supra* note 26, at 1.

254. Thomas, *supra* note 1, at 301.

255. See *id.* at 301.

256. See Bender, *supra* note 3, at 71; Mills, *supra* note 242, at 105; Thomas, *supra* note 1, at 301.

257. Brussels Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, Sept. 27, 1968, 1972 O.J. (L 299) 32 [hereinafter Brussels

sels Convention mandates contracting states to recognize and enforce jurisdictionally valid judgments rendered in one EU state.²⁵⁸

To the extent that Dutch courts issued multinational injunctions outside of Europe, such reliance on the EPC and the Brussels Convention ended, making the validity of such injunctions more questionable.²⁵⁹ Nevertheless, Dutch courts considered themselves competent to adjudicate non-European patents.²⁶⁰ For example, in the 1992 case of *Philips v. Hemogram*,²⁶¹ a Dutch court granted an injunction covering all nations in which the plaintiff held parallel patents, including Argentina, Australia, Brazil, Belgium, Denmark, Germany, Finland, Hungary, Sweden, and the Netherlands.²⁶²

The *Interlas* line of cases altered patent law's traditional territorial approach, which historically has required separate litigations in various national courts, and in so doing created a strategic innovation for the management of international patent portfolios and international patent litiga-

Convention]. The Brussels Convention, which applies only to EU members, established a comprehensive system of jurisdiction for litigation in civil and commercial matters, including intellectual property, under which persons domiciled in a contracting state may be sued in the courts of another contracting state. Blumer, *supra* note 119, at 337-38. The Brussels Convention has been amended several times, see Case C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v. Lamellen und Kupplungsbau Beteiligungs KG*, 2006 E.C.R. I-6509, para. 1, and was superseded in 2000 by the Brussels Regulation, which is very similar to the Brussels Convention, see Matthew H. Adler & Michele Crimaldi Zarychta, *The Hague Convention on Choice of Court Agreements: The United States Joins the Judgment Enforcement Band*, 27 NW. J. INT'L L. & Bus. 1, 16 (2006). Because the ECJ decisions in *Roche* and *GAT* were decided under the Brussels Convention, for consistency and simplicity, the term "Brussels Convention" is used throughout this Note.

258. See Thomas, *supra* note 1, at 301-02. The Dutch courts relied on Article 24 of the Brussels Convention, a jurisdictional mandate, which provides that "[a]pplication may be made to the courts of a Contracting State for such provisional, including protective, measures, as may be available under the laws of that state, even if, under this Convention, the courts of another Contracting State have jurisdiction as to the substance of the matter." Brussels Convention, *supra* note 257, art. 24; Thomas, *supra* note 1, at 302. Other jurisdictional provisions of the Brussels Convention are less supportive of the Dutch approach, including Article 16(4), which provides for exclusive jurisdiction in proceedings concerning the registration or validity of patents in "the courts of the Contracting State in which the deposit or registration has been applied for, taken place or is under the terms of an international convention deemed to have taken place." Thomas, *supra* note 1, at 302-03; see Brussels Convention, *supra* note 257, art. 16(4). Nevertheless, Article 16(4) has been of little consequence because the Dutch action granting preliminary relief is a summary proceeding called a "kort geding," which is not subject to ordinary rules of evidence and has no pre-trial discovery and no oral testimony from witnesses. Mills, *supra* note 242, at 106; Thomas, *supra* note 1, at 302. Because the kort geding procedure is considered provisional, Dutch courts ordinarily do not resolve validity and simply determine the likelihood of success elsewhere. Thomas, *supra* note 1, at 302-03. See *infra* Part II.B for a more detailed discussion of the articles of the Brussels Convention on which plaintiffs seeking multinational patent enforcement in courts of contracting states relied, as well as the ECJ's determination of the applicability of these provisions.

259. Thomas, *supra* note 1, at 303.

260. *Id.*

261. 1992 BIE, No. 80 (Hague Dist. Ct. Dec. 1991).

262. Mills, *supra* note 242, at 69; Thomas, *supra* note 1, at 303-04.

tion.²⁶³ As a result of the willingness of Dutch courts to grant multinational injunctions, the Netherlands quickly became the preferred forum for patent infringement litigation in Europe in the 1990s.²⁶⁴ Although other European countries, most notably Germany, embraced the Dutch multinational approach to patent litigation,²⁶⁵ the inefficiencies and difficulties of multinational patent enforcement in European courts prevented it from becoming the “dominant model” of enforcing patent rights in multiple countries.²⁶⁶ In addition to lingering questions about its legality, the use of multinational patent enforcement in national courts often led to various national validity or anti-suit related follow-up or collateral proceedings in the courts of foreign nations that granted the patents-in-suit, leading to increased costs and delay.²⁶⁷

The Dutch approach remained controversial and was not embraced throughout the EU.²⁶⁸ Specifically, courts in the United Kingdom developed an opposing body of patent cases in which they refused to grant multinational patent injunctions.²⁶⁹ In the 1995 case, *Chiron Corp. v. Organon Teknika Ltd. (No 10)*,²⁷⁰ for example, Mr. Justice Aldous specifically rejected multinational patent injunctions, stating in dicta, “At one time I wondered whether it would be right for this court to do the same as the Dutch court, but have concluded that it would not be right for this court to grant an injunction which had effect outside the United Kingdom.”²⁷¹

B. The ECJ Assault on Multinational Patent Enforcement

1. *Roche and GAT*

In two decisions handed down on July 13, 2006, *Roche Nederland v. Primus*²⁷² and *Gesellschaft für Antriebstechnik mbH & Co. KG v. Lamellen und Kupplungsbau Beteiligungs KG (GAT)*,²⁷³ the ECJ²⁷⁴ effectively ended

263. Bender, *supra* note 3, at 72.

264. Thomas, *supra* note 1, at 305.

265. Schuster, *supra* note 35.

266. *Id.*

267. *Id.*

268. Bender, *supra* note 3, at 72; Thomas, *supra* note 1, at 304.

269. Bender, *supra* note 3, at 73; Mills, *supra* note 242, at 105; *See Chiron Corp. v. Organon Teknika Ltd. (No 10)*, [1995] F.S.R. 325 (Eng. Ch. 1995); *Coin Controls Ltd. v. Suzo International (U.K.) Ltd.*, [1997] F.S.R. 660 (Eng. Ch. 1997).

270. [1995] F.S.R. 325 (Eng. Ch. 1995).

271. *Id.* at 338.

272. Case C-539/03, *Roche Nederland BV v. Primus*, 2006 E.C.R. I-6535.

273. Case C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v. Lamellen und Kupplungsbau Beteiligungs KG*, 2006 E.C.R. I-6509.

274. The ECJ was created in 1957 by the Treaties of Rome. Kevin Andrew Swartz, *Powerful, Unique, and Anonymous: The European Court of Justice and Its Continuing Impact on the Formation of the European Community*, 3 S. CAL. INTERDISC. L.J. 687, 691 (1994). Under the Brussels Convention, supreme courts of the contracting states can submit questions of interpretation on unsettled areas of Community law to the ECJ for preliminary rulings. Blumer, *supra* note 119, at 337. In such cases, the ECJ, in theory, is to refer solely to the legal issue of Community law without considering the underlying facts of the case, but, in practice, the court often becomes quite involved in the facts of the case, making clear how the national court should finally decide the case. Swartz, *supra*, at 692-93. After the ECJ settles the disputed legal issue, the national court that

the practice of multinational injunctions for patent infringement.²⁷⁵ The ECJ clarified that a European patent is merely a bundle of national and territorial patent rights and, thus, reaffirmed the historic territoriality of patent law despite the increasing harmonization of European patent laws.²⁷⁶ After proceedings lasting more than three years, the ECJ released both decisions on the same day “like a shot from a double-barrel-rifle at the concept [of multinational patent enforcement].”²⁷⁷

In seeking multinational injunctions for patent infringement against multiple defendants domiciled throughout Europe, plaintiffs had made use of the Article 6(1) exception to Article 2 of the Brussels Convention.²⁷⁸ Article 2 of the Convention provides that persons domiciled in a contracting state of the Brussels Convention must be sued in the courts of that state.²⁷⁹ Article 6(1) provides an exception: when a plaintiff is suing multiple defendants domiciled in different contracting states, the defendants may be sued in any contracting state where one of the defendants is domiciled.²⁸⁰

In the primary case, *Roche*, the ECJ, reasoning that there is never a sufficient connection between foreign patent claims to necessitate consolidation, effectively eliminated the possibility of using an Article 6(1) exception to bring a consolidated patent infringement suit against multiple defendants domiciled in different countries.²⁸¹ The plaintiffs, Dr. Primus and Dr. Goldenberg, two U.S. doctors, attempted to make use of the Article 6(1) exception, bringing an infringement action in the Netherlands against Roche Nederland, a Dutch company, and eight other companies in the Roche group domiciled in the United States, Belgium, Germany, France, the United Kingdom, Switzerland, Austria, and Sweden.²⁸² The plaintiffs alleged that the nine co-defendants’ conduct infringed the plaintiffs’ European patent in their respective countries.²⁸³ The eight non-Dutch companies in the Roche group contested the jurisdiction of the Dutch court.²⁸⁴

requested the preliminary ruling must apply the court’s ruling to the facts of the case. *Id.* at 693.

275. See Shaw, *supra* note 26, at 1.

276. See Emma Barraclough, *ECJ Blocks Cross-Border Patent Litigation*, MANAGING INTELL. PROP., Sept. 2006; Shaw, *supra* note 26, at 1.

277. Schuster, *supra* note 35.

278. Shaw, *supra* note 26, at 1.

279. Brussels Convention, *supra* note 257, art. 2.

280. *Id.* art. 6(1).

281. See Case C-539/03, *Roche Nederland BV v. Primus*, 2006 E.C.R. I-6535; R. Scott MacKendrick, *Crossing Borders: Trade-mark Issues and Concerns in Canada and Elsewhere*, in AM. L. INST., LITIGATING TRADEMARK, DOMAIN NAME, AND UNFAIR COMPETITION CASES 325, 327 (2006); Friedrich Klinkert et al., *European Union: The (Cross) Border is Closed: ECJ Rules on Patent Injunctions*, MONDAQ BUS. BRIEFING, July 20, 2006, <http://www.mondaq.com/article.asp?articleid=41396>.

282. *Roche*, 2006 E.C.R. I-6535, at para. 13-14; Klinkert et al, *supra* note 281.

283. *Roche*, 2006 E.C.R. I-6535, at para. 13-14; Klinkert et al, *supra* note 281. The patent in question was European patent No. 131 627, and the alleged infringement consisted of placing immuno-assay kits on the market. *Roche*, 2006 E.C.R. I-6535, at para. 13-14.

284. *Roche*, 2006 E.C.R. I-6535, at para. 13-14; Klinkert et al, *supra* note 281.

Although the lower court determined that it had jurisdiction,²⁸⁵ the Dutch Supreme Court, on appeal, stayed the proceedings and submitted two questions to the ECJ.²⁸⁶ First, the Dutch Supreme Court asked the ECJ to determine whether the Article 6(1) jurisdiction exception applies where a number of different companies established in various contracting states are accused of infringing a common European patent in different contracting states.²⁸⁷ Second, the court asked the ECJ to clarify within the Article 6(1) jurisdiction exception the relevance of whether the alleged infringing acts of the defendants are identical or similar, the defendants are part of the same group of companies, and the defendants are acting under a common policy.²⁸⁸

Addressing the first question, the ECJ found that, under relevant case law, Article 6(1) applies only if the different acts of the various defendants are connected in such a way that “it is expedient to determine the actions together in order to avoid the risk of irreconcilable judgments.”²⁸⁹ The ECJ determined that, even if the concept of the risk of “irreconcilable judgments” is defined broadly as the risk of “contradictory decisions,” there is no such risk in the case of alleged patent infringement committed by different defendants in different countries.²⁹⁰ Because the defendants are different and the alleged infringement occurred in different countries, the factual situation for each individual action will also be different.²⁹¹ Similarly, the legal situation is different because a European patent is governed by the national law of the contracting state for which it was granted.²⁹² Addressing the second question, the ECJ concluded that this holding

285. The Dutch and French governments supported the decision of the lower court, but the U.K. government argued that *Primus* should have litigated nation-by-nation. William Hoyng, *Cross-Border Injunctions. Where Are We and Where Should We Go?*, MONDAQ BUS. BRIEFING, July 18, 2005, <http://www.mondaq.com/article.asp?articleid=33412>.

286. *Roche*, 2006 E.C.R. I-6535, at para. 16-17; Shaw, *supra* note 26, at 1. The Supreme Court referred the following questions to the ECJ for a preliminary ruling: “(1) Is there a connection, as required for the application of Article 6(1) of the Brussels Convention, between a patent infringement action brought by a holder of a European patent against a defendant having its registered office in the State of the court in which the proceedings are brought, on the one hand, and against various defendants having their registered offices in Contracting States other than that of the State of the court in which the proceedings are brought, on the other hand, who, according to the patent holder, are infringing that patent in one or more other Contracting States? (2) If the answer to Question 1 is not or not unreservedly in the affirmative, in what circumstances is such a connection deemed to exist, and is it relevant in this context whether, for example, the defendants form part of one and the same group of companies? the defendants are acting together on the basis of a common policy, and if so is the place from which that policy originates relevant? the alleged infringing acts of the various defendants are the same or virtually the same?” *Roche*, 2006 E.C.R. I-6535, at para. 17. In the late 1990s, the ECJ was asked to clarify such questions in two prior cases but both cases settled before the ECJ could rule. See Schuster, *supra* note 35.

287. *Roche*, 2006 E.C.R. I-6535, at para. 17-18; Klinkert et al, *supra* note 281.

288. *Roche*, 2006 E.C.R. I-6535, at para. 17-18; Shaw, *supra* note 26, at 1.

289. *Roche*, 2006 E.C.R. I-6535, at para. 20; Klinkert et al, *supra* note 281.

290. *Roche*, 2006 E.C.R. I-6535, at para. 25.

291. *Id.* at para. 27; Shaw, *supra* note 26, at 1.

292. See *Roche*, 2006 E.C.R. I-6535, at para. 29-30; Shaw, *supra* note 26, at 1.

applies even if the defendant companies belong to the same group and acted in identical or similar ways in accordance with a common policy, because the legal situation would never be the same.²⁹³

From a practical standpoint, the ECJ also pointed out that the advantages of a consolidated action were limited because consolidation would multiply the number of courts with jurisdiction to hear a proceeding, which would undermine legal certainty and encourage forum shopping.²⁹⁴ Furthermore, as confirmed by the *GAT* decision, under Article 16(4) of the Brussels Convention, proceedings concerning the validity of a patent must take place in the national courts of the granting country.²⁹⁵ Thus, because patent validity is frequently challenged in infringement actions, some fragmentation of the proceedings is inevitable.²⁹⁶

In *GAT*, the ECJ held that, under Article 16(4) of the Brussels Convention,²⁹⁷ patent validity is to be determined exclusively by the national courts of the granting state, which are uniquely qualified to assess the validity of a national patent.²⁹⁸ *GAT*, a German motor vehicle company, brought a declaratory action before a regional court in Germany seeking a declaration of noninfringement and, additionally, revocation of two French patents after *LuK*, another Germany motor vehicle company, alleged that *GAT* had infringed both of these patents.²⁹⁹ The regional court, the *Landgericht Dusseldorf*, held that it had international jurisdiction to adjudicate both the alleged infringement and invalidity actions and dismissed *GAT*'s action, holding the French patents at issue valid.³⁰⁰ On appeal, the higher regional court, the *Oberlandesgericht Dusseldorf*, stayed the proceedings and referred to the ECJ the question of whether the exclusive jurisdiction provision of Article 16(4) of the Brussels Convention applies to all proceedings relating to the registration or validity of a patent, including those in which invalidity is raised as a defense to infringement.³⁰¹

293. *Roche*, 2006 E.C.R. I-6535, at para. 34-35.

294. *Id.* at para. 37-38; Klinkert et al, *supra* note 281; Shaw, *supra* note 26, at 2.

295. Case C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v. Lamellen und Kupplungsbau Beteiligungs KG*, 2006 E.C.R. I-6509, para. 31.

296. *Id.* at para. 17; Klinkert et al., *supra* note 281.

297. Article 16(4) of the Brussels Convention, which is now Article 22(4) of the Brussels Regulation, Barraclough, *supra* note 276, provides that "in proceedings concerned with the registration or validity of patents, . . . the courts of the Contracting State in which the deposit or registration has been applied for, has taken place or is under the terms of an international convention deemed to have taken place" shall have exclusive jurisdiction. Brussels Convention, *supra* note 257, art. 16(4).

298. *Gesellschaft für Antriebstechnik*, 2006 E.C.R. I-6509, at para. 22; Klinkert et al., *supra* note 281; Shaw, *supra* note 26, at 2. The court emphasized that a number of member states have set up specialized courts for patent cases, making the exclusive jurisdiction for validity claims even more important. *Gesellschaft für Antriebstechnik*, 2006 E.C.R. I-6509, at para. 22.

299. *Gesellschaft für Antriebstechnik*, 2006 E.C.R. I-6509, at para. 8-10; Klinkert et al., *supra* note 281; Shaw, *supra* note 26, at 2.

300. *Gesellschaft für Antriebstechnik*, 2006 E.C.R. I-6509, at para. 11; Klinkert et al., *supra* note 281.

301. *Gesellschaft für Antriebstechnik*, 2006 E.C.R. I-6509, at para. 12; Klinkert et al., *supra* note 281. The *Oberlandesgericht Dusseldorf* referred the following question to the ECJ: "Should Article 16(4) of the Convention . . . be interpreted as meaning that the

Defining the scope of Article 16(4), the ECJ ruled that the Article “is to be interpreted as meaning that the rule of exclusive jurisdiction laid down therein concerns all proceedings relating to the registration or validity of a patent, irrespective of whether the issue is raised by way of an action or a plea of objection.”³⁰² The ECJ noted that the provision does not apply when validity is not challenged.³⁰³ Once the validity of a patent is challenged, however, irrespective of whether the party challenging validity brought proceedings specifically to invalidate the patent or merely raised invalidity as a defense to an infringement action, the national court of the patent-granting state has exclusive jurisdiction.³⁰⁴ The ECJ reasoned that to hold otherwise would undermine the binding nature of the exclusive jurisdiction provision of Article 16(4).³⁰⁵ Furthermore, circumventing the exclusive jurisdiction of Article 16(4) would increase the number of jurisdictions able to determine the validity of a patent, thereby undermining predictability by increasing the risk of conflicting decisions by different national courts, which the Brussels Convention specifically seeks to avoid.³⁰⁶

2. Implications for Multinational Patent Enforcement in European National Courts

The ECJ’s decisions severely limit the possibility of centralizing infringement claims on foreign patents before a single European national court, quelling the trend towards centralized patent infringement litigation in European jurisdictions.³⁰⁷ After *Roche*, multinational relief on a European patent is theoretically available in the limited circumstance in which a patentee sues a single defendant in its country of domicile for infringing activity in multiple states.³⁰⁸ Moreover, in light of GAT, the defendant simply has to challenge validity to limit the suit to the patent in that jurisdiction; the foreign patent infringement proceedings are then unable to

exclusive jurisdiction conferred by that provision on the courts of the Contracting State in which the deposit or registration of a patent has been applied for, has taken place or is deemed to have taken place under the terms of an international convention only applies if proceedings (with erga omnes effect) are brought to declare the patent invalid or are proceedings concerned with the validity of patents within the meaning of the aforementioned provision where the defendant in a patent infringement action or the claimant in a declaratory action to establish that a patent is not infringed pleads that the patent is invalid or void and that there is also no patent infringement for that reason, irrespective of whether the court seised of the proceedings considers the plea in objection to be substantiated or unsubstantiated and of when the plea in objection is raised in the course of proceedings?” *Gesellschaft fur Antriebstechnik*, 2006 E.C.R. I-6509, at para. 12.

302. *Gesellschaft fur Antriebstechnik*, 2006 E.C.R. I-6509, at para. 31.

303. *Id.* at para. 16; Klinkert et al., *supra* note 281; Shaw, *supra* note 26, at 2.

304. Shaw, *supra* note 26, at 2; see *Gesellschaft fur Antriebstechnik*, 2006 E.C.R. I-6509, at para. 25.

305. *Gesellschaft fur Antriebstechnik*, 2006 E.C.R. I-6509, at para. 26; Shaw, *supra* note 26, at 2.

306. *Gesellschaft fur Antriebstechnik*, 2006 E.C.R. I-6509, at para. 28; Klinkert et al., *supra* note 281; Shaw, *supra* note 26, at 2.

307. See Bender, *supra* note 3, at 49; Klinkert et al., *supra* note 281; Shaw, *supra* note 26, at 1.

308. Klinkert et al., *supra* note 281; Shaw, *supra* note 26, at 2.

proceed.³⁰⁹ As the ECJ noted in *GAT*, defendants usually challenge patent validity in an infringement action, further decreasing the likelihood of a case suitable for multinational patent enforcement.³¹⁰ Given the ECJ's decision, defendants desiring to make the litigation more difficult and expensive for plaintiffs will certainly be more apt to challenge validity, forcing the litigation to separate into different national litigations. Additionally, although it is unclear whether European courts would accept such a case after the ECJ decisions, the rulings seem to allow for companies accused or suspected of infringement without merit to seek, in the patentee's domicile country, a single, consolidated declaration of non-infringement.³¹¹ Given the ruling in *GAT*, however, such an action could only proceed if the accused or suspected infringer does not need to argue that the patent is invalid because the non-infringement argument is sufficiently strong.³¹² In practice, therefore, multinational injunctions for patent infringement in Europe are "effectively dead."³¹³

The ECJ's decisions illustrate the need for a more harmonized approach to European patent litigation.³¹⁴ As such, the decisions have accelerated negotiations toward alternative methods of multinational patent enforcement in Europe, the Community Patent and the European Patent Litigation Agreement (EPLA).³¹⁵

C. The Community Patent

The first harmonization of European patent law occurred with the Munich Convention on the Grant of European Patents, also known as the European Patent Convention (EPC),³¹⁶ which was signed on October 5, 1973 and became effective on October 7, 1977.³¹⁷ The EPC is a conglomerate of thirty-one European states that have agreed to a common European patent granting system with a common European Patent Office (EPO) to search and examine patent applications.³¹⁸ The EPC allows an applicant to file a single patent application with the EPO.³¹⁹ If the EPO accepts the application, it grants a European patent, which is actually a bundle of

309. Klinkert et al., *supra* note 281; Shaw, *supra* note 26, at 2.

310. *Gesellschaft für Antriebstechnik*, 2006 E.C.R. I-6509, at para. 17.

311. See Schuster, *supra* note 35.

312. See *id.* The patentee would never question the validity of its own patent because the patentee would immediately lose the action. *Id.*

313. Klinkert et al., *supra* note 281.

314. Shaw, *supra* note 26, at 2.

315. See Barraclough, *supra* note 276; Klinkert et al., *supra* note 281; Shaw, *supra* note 26, at 2.

316. Piotraut, *supra* note 11, at 61.

317. See Di Cataldo, *supra* note 11, at 19; Christopher Heath, *Harmonizing Scope and Allocation of Patent Rights in Europe—Towards a New European Patent Law*, 6 MARQ. INTELL. PROP. L. REV. 11, 11 (2002).

318. EUROPEAN PATENT OFFICE, *supra* note 15, at 1; Di Cataldo, *supra* note 11, at 19. The EPC system is established outside the legal framework of the European Community Treaty so European countries that are not EU members can join the EPC. Sascha E. Schalkwijk, *Community Patent: The EU Stuck Again?*, INTELL. PROP. STRATEGIST (Law Journal Newsletters, Phila., Pa.), Sept. 2004.

319. Bender, *supra* note 3, at 58.

national patents for each state designated in the patent application.³²⁰ The EPC, however, does not provide for a common European patent litigation system.³²¹ National courts, applying their respective national laws, adjudicate enforcement disputes, including infringement or revocation³²² actions.³²³

The EPC was originally intended only to be a provisional tool, the first step towards unifying the European patent system.³²⁴ Following the EPC, the Community Patent Convention (CPC) was to be the next step in creating a supranational European patent system.³²⁵ Although the EPC has been very successful, the CPC, which was signed in Luxembourg on December 15, 1975, has never become effective.³²⁶ The main idea of the CPC is that, for EU members, the European patent, after being granted by the EPO, would not be divided into separate national patents but would become a single "supranational unitary Community patent," enforceable under one uniform patent law in a special, centralized judicial system.³²⁷ Thus, the CPC was to "eliminate the post-grant territorial limitations" of the European patent within the EU.³²⁸ Immediately after signing, however, the CPC faced extensive problems that have prevented its ratification and, consequently, its taking effect.³²⁹

The first problem facing the CPC was its competence to decide the validity of Community patents.³³⁰ The original text of the CPC gave the EPO exclusive competence to decide applications for the revocation of a Community patent but authorized member states to grant their national courts the competence to decide on counterclaims of invalidity in infringement suits.³³¹ The national court's decision would bind only that particular state.³³² This rule, however, is inconsistent with the idea that the Community patent is a single, supranational patent valid throughout the EU.³³³

320. EUROPEAN PATENT OFFICE, *supra* note 15, at 1; Bender, *supra* note 3, at 57; Di Cataldo, *supra* note 11, at 20. The designation "European patent" is misleading. See Di Cataldo, *supra* note 11, at 20. "[I]n fact, there is no single European Patent. Instead, there are multiple national patents collectively referred to as a 'European Patent.'" *Id.*

321. See EUROPEAN PATENT OFFICE, *supra* note 15, at 1.

322. *Id.*; Heath, *supra* note 317, at 12. There is a nine-month time limit for filing an opposition at the EPO, after which the party interested in seeking revocation must file revocation actions in all the states for which the European patent was granted. EUROPEAN PATENT OFFICE, *supra* note 15, at 1.

323. EUROPEAN PATENT OFFICE, *supra* note 15, at 1.

324. Di Cataldo, *supra* note 11, at 19.

325. Bender, *supra* note 3, at 57, 59.

326. Di Cataldo, *supra* note 11, at 19; Schalkwijk, *supra* note 318.

327. Bender, *supra* note 3, at 57, 59; Di Cataldo, *supra* note 11, at 19.

328. Mossinghoff & Kuo, *supra* note 119, at 543.

329. Di Cataldo, *supra* note 11, at 27.

330. *Id.*

331. *Id.*

332. *Id.* This is the rule that currently applies in the EPC, which holds that a determination on the validity of a patent granted by the EPO is only binding on that particular state. *Id.*

333. *Id.*

As a result, some states requested a common court for Community patents.³³⁴ Other states, specifically Denmark and Ireland, however, asserted that their constitutions prohibited such a special patent court.³³⁵ After fourteen years of discussion, the member states agreed on a solution embodied in the 1989 Agreement, which was signed on December 15, 1989.³³⁶ The agreement gave national courts the competence to decide invalidity in the first instance.³³⁷ Because the states could not accept the invalidation of a Community patent by another state's national court, the validity decisions of national courts could be appealed to a Community Patent Appeals Court (CoPAC).³³⁸ Although the main purpose of CoPAC was to avoid invalidation of a Community patent by a single national court, CoPAC would also ensure a unified final interpretation of the validity of a Community patent, furthering the goal of a unified European patent system.³³⁹ Nevertheless, largely on account of disputes over the translation requirements for Community patents,³⁴⁰ several member states did not ratify the second version of the CPC by the December 31, 1991 deadline and, consequently, it has not become effective.³⁴¹

The increased frequency of infringement suits across Europe over the last ten years, along with the frequent non-uniform interpretations and decisions of European national courts on EPO-granted patents, has raised awareness of the importance of enforcement and sparked renewed attempts to overcome the difficulties preventing a workable Community Patent.³⁴² The 2003 amended proposal includes a more extensive Community patent jurisdiction under the aegis of the ECJ, which would have jurisdiction over disputes regarding the invalidity or infringement of a Community patent.³⁴³ A new Community Patent Court, rather than national courts, would exercise the jurisdiction of the ECJ in the first

334. *Id.*

335. *Id.*

336. *Id.*

337. *Id.*

338. *Id.*

339. *Id.* CoPAC's competence would only encompass patent validity disputes and no other disputes that could arise regarding a Community patent. *Id.* at 27-28. National courts of second instance would ultimately grant remedies, such as damages and injunctive relief. Heath, *supra* note 317, at 13.

340. See Di Cataldo, *supra* note 11, at 28; Schalkwijk, *supra* note 318, for a detailed discussion of the translation debate that has largely prevented the establishment of the Community Patent.

341. Di Cataldo, *supra* note 11, at 28; Schalkwijk, *supra* note 318.

342. See Di Cataldo, *supra* note 11, at 21; Bender, *supra* note 3, at 60; Heath, *supra* note 317, at 13.

343. See *Commission Proposal for a Council Decision Establishing the Community Patent Court and Concerning Appeals Before the Court of First Instance*, at 6, COM (2003) 828 final (Dec. 23, 2003) [hereinafter *2003 Commission Proposal*]; Press Release, European Comm'n, Industrial Property: Commission Proposes Establishing Community Patent Court (Feb. 2, 2004). Until the Community Patent Court is established, member states would designate a limited number of national courts to exercise jurisdiction over Community patents. *2003 Commission Proposal, supra*, at 10. At the end of the transitional period, jurisdiction over Community patents would be conferred to on the ECJ. *Id.*

instance.³⁴⁴ The proposal also establishes a specialized patent appeal chamber within the Court of First Instance, consisting of judges having greater expertise in patent law.³⁴⁵ In exceptional cases, the ECJ could review a decision of the Court of First Instance.³⁴⁶ The Community Patent Court's judgments would be effective throughout the EU.³⁴⁷

The detailed proposal also provides for the logistical arrangements of proceedings before the Community Patent Court. The proceedings can take place in any official EU language if the parties so request and the Community Patent Court consents.³⁴⁸ Nevertheless, the proposal established two default rules.³⁴⁹ First, if the defendant is domiciled in an EU member state, the language of the proceedings before the Community Patent Court would be the official EU language of that state or, if there is more than one official language, the defendant can choose from the official languages.³⁵⁰ Second, if the defendant is not domiciled in an EU member state, the language of the proceedings would be the official EU language of the state that granted the Community patent.³⁵¹ Additionally, the Community Patent Court would operate under a uniform set of procedural rules.³⁵² Given that the Community Patent Court's judgments are effective throughout the EU, for Community patents, the uniform jurisdictional system of the Community Patent Court would avoid the expense, inconvenience, and confusion inherent in patent litigation involving several national courts.³⁵³ Although the Community Patent concept has such clear advantages, residual difficulties, especially concerning the extent and legal effect of translations, continue to prevent an effective agreement.³⁵⁴

D. The European Patent Litigation Agreement (EPLA)

Faced with an unpromising deadlock in the Community Patent initiative, EPC member states began to explore other options to end the inconsistency of patent protection in Europe.³⁵⁵ As European Commissioner for Internal Market and Services, Charlie McGreevy, explained in a presentation to the European Parliament, "In an ideal world, the Community Patent

344. See 2003 Commission Proposal, *supra* note 343, at 6-7; Press Release, *supra* note 343. The Community Patent Court will consist of seven judges, including a president. 2003 Commission Proposal, *supra* note 343, at 7. The judges will be divided into two chambers of three. *Id.* The seventh judge will be available for reinforcement as needed; for example, if a judge is ill or the president must assume administration-related tasks. *Id.*

345. 2003 Commission Proposal, *supra* note 343, at 9; Press Release, *supra* note 343.

346. Press Release, *supra* note 343.

347. *Id.*

348. 2003 Commission Proposal, *supra* note 343, at 8.

349. See *id.*

350. See *id.*

351. See *id.*

352. Press Release, *supra* note 343.

353. See *id.* Of course, disputes involving national patents or European patents would not be subject to the jurisdiction of the Community Patent Court and, thus, would still be decided by individual national courts. *Id.*

354. Schalkwijk, *supra* note 318.

355. See EUROPEAN PATENT OFFICE, *supra* note 15, at 1-4.

is the solution. But in the real world, this is not possible. Should [we] sit around doing nothing? No, that would be grossly irresponsible.”³⁵⁶ As such, the EPC member states established a Working Party on Litigation in June 1999 with the mandate to submit an *optional* agreement on an integrated judicial system for European patent litigation, the European Patent Litigation Agreement (EPLA).³⁵⁷ The goal of the EPLA is to improve the European patent system by creating an efficient litigation system to increase legal certainty by ensuring uniform patent law interpretation.³⁵⁸ Another objective of the proposed EPLA is to reduce the number of cases requiring multiple separate actions, thereby reducing costs for parties.³⁵⁹ Unlike the Community Patent initiative, the proposed EPLA would consist only of a judicial system to interpret European patents granted through the EPO; it would not revise the patent granting system to create a unified Community patent, a further goal of the Community Patent initiative.³⁶⁰

The integrated judicial system in the EPLA draft agreement provides for a new European Patent Judiciary, which is to be composed of the European Patent Court and a supervisory body, the Administrative Committee.³⁶¹ The European Patent Court, which would have jurisdiction to hear infringement and revocation actions concerning European patents across any state that accedes to the EPLA, would consist of the Court of First Instance and the Court of Appeal, both of which would be comprised of international panels of legally and technically qualified judges.³⁶² The Court of First Instance would consist of a Central Division and several Regional Divisions.³⁶³ The single common Court of Appeal would hear appeals from the Courts of First Instance.³⁶⁴ Furthermore, the draft agreement enables the Court of Appeal, acting as Facultative Advisory Council, to deliver non-binding opinions on any point of law concerning European or harmonized national patent law to national courts trying infringement and validity actions.³⁶⁵ The common Court of Appeal would help guarantee consistent case law, improving legal certainty for European patents.³⁶⁶ If a state decides to join the EPLA, it must choose between transferring jurisdiction to the European Patent Court or merely allowing its courts to

356. *Intellectual Property: McGreevy Outlines ‘Concerted Push’ for European Patents*, EUR. REP. (European Info. Serv., London), Sept. 29, 2006 [hereinafter ‘*Concerted Push for European Patents*’].

357. EUROPEAN PATENT OFFICE, *supra* note 15, at 1. The main states active in the Working Party on Litigation are Denmark, Germany, Finland, France, Luxembourg, Monaco, the Netherlands, Sweden, Switzerland, and the United Kingdom. *Id.* at 5.

358. *Id.* at 8.

359. *Id.* at 9.

360. *See id.* at 4; Di Cataldo, *supra* note 11, at 19.

361. EUROPEAN PATENT OFFICE, *supra* note 15, at 5-6.

362. *Id.* On request by the European Patent Court, the ECJ will issue preliminary rulings binding on the European Patent Court in so far as its decision takes effect in a member state of the European Union. *Id.* at 7.

363. *Id.* at 6.

364. *Id.*

365. *Id.*

366. *See Patents: All-English Patents Seen Looming*, EUR. REP. (European Info. Serv., London), Dec. 21, 2006.

present requests for opinions to the Facultative Advisory Council.³⁶⁷

In contrast to the unified judicial system for European patents, national courts would continue to handle infringement and revocation proceedings concerning national patents.³⁶⁸ Additionally, national courts would retain jurisdiction to order provisional and protective measures in disputes relating to both national and European patents.³⁶⁹

The EPLA also has an extensively detailed language regime based on that of the EPC granting system but adapted to post-grant litigation.³⁷⁰ In a proceeding before the Central Division, the language of the proceeding would be that of the proceeding before the EPO.³⁷¹ Furthermore, in a proceeding before a Regional Division located in a state having an EPO official language as an official language, the language of the proceeding would be that language.³⁷² Finally, in a proceeding before a Regional Division located in a state having either more than one or no official language that is an EPO official language, the language of the proceeding would be any official language of the EPO that the state designates.³⁷³ The language of the proceeding before the Court of Appeal would always be the language of the first-instance proceedings.³⁷⁴ Upon agreement by the parties, the court may allow the use of another language during all or part of the proceedings.³⁷⁵

As support for the EPLA from judges, academics, members of the European industry, and expert groups increases, optimism about the successful conclusion of EPLA negotiations continues to rise.³⁷⁶ Results of the European Commission's January 2006 survey of European practitioners revealed that the majority of participants support the draft EPLA.³⁷⁷ Specifically, most support the language regime, the specialized judges that ensure high quality decisions, and the judicial system that balances simple access to court through regional divisions with legal certainty through the central Court of Appeal.³⁷⁸ Supporters also point to decreased litigation costs on account of a single, centralized suit rather than multiple disjointed proceedings.³⁷⁹ For example, Member of the European Parliament (MEP)

367. EUROPEAN PATENT OFFICE, *supra* note 15, at 5.

368. *Id.*

369. *Id.*

370. *Id.* at 6.

371. *Id.*

372. *Id.*

373. *Id.*

374. *Id.*

375. *Id.* at 7. To provide for a situation in which the parties agree on a language other than an official language of the EPO, the rules of procedure will have further rules on simultaneous interpretation during oral proceedings and translation of the file. *Id.*

376. *Id.* at 9; Next Steps, *supra* note 29; see Schalkwijk, *supra* note 318.

377. EUROPEAN COMM'N, FUTURE PATENT POLICY IN EUROPE 4 (2006), http://ec.europa.eu/internal_market/indprop/docs/patent/hearing/report_en.pdf [hereinafter FUTURE PATENT POLICY].

378. *Id.*

379. Next Steps, *supra* note 29; *Industrial Property: McGreevy's Concerted Push for Patents*, EUR. REP. (European Info. Serv., London), Sept. 25, 2006 [hereinafter *Industrial Property*].

Klaus-Heiner Lehne argues that a patent dispute in three EU countries would be 45% cheaper in the EPLA than with the disjointed litigations currently necessary.³⁸⁰ In fact, as the European Commission's Internal Market Spokesman, Oliver Drewes, points out, despite puzzling comments to the contrary, the EPLA would not be more expensive for litigants than the current system, because "[o]ne of the ongoing ideas is that you could also go to a local court, not a European court."³⁸¹

The initiative, however, is not without its problems. The main concerns relate to the judicial system and costs.³⁸² The debate over the judicial system focuses on the degree of centralization and the nature of the local Courts of First Instance.³⁸³ Another crucial concern is that the EPLA would drastically increase patent litigation costs. Although the position is contested, some MEPs argue that small companies could face litigation bills of 97,000 to 415,000³⁸⁴ Euros for a medium-scale action under the proposed EPLA.³⁸⁵ Additionally, some countries, especially France, object to the language scheme, which concentrates on the EPC official languages.³⁸⁶ France has highlighted constitutional concerns for the EU, arguing that it is unacceptable to create a non-EU legal system with a non-EU court.³⁸⁷ Additionally, France has raised institutional compatibility concerns regarding possible contradictions between the EPLA's proposed intergovernmental court and the judicial order established by European Community treaties.³⁸⁸ Finally, because the EPLA is an optional additional agreement, if the EPLA were adopted, EPC contracting states would have the option not to sign and, thus, could continue using the EPC in its present form.³⁸⁹ It is likely that a number of EPC contracting states would not participate.³⁹⁰

380. *Industrial Property*, *supra* note 379.

381. *Id.*

382. *Intellectual Property: McGreevy Told European Community Patent Not Dead*, EUR. REP. (European Info. Serv., London), Oct. 2, 2006 [hereinafter *Intellectual Property*].

383. See Charlie McGreevy, European Comm'r for Internal Mkt. & Servs., Closing Remarks at Public Hearing on Future Patent Policy (July 12, 2006) [hereinafter *Closing Remarks*].

384. This represents approximately \$130,600-\$558,500. See FIN. MGMT. SERV., TREASURY REPORTING RATES (2007) (reporting that, as of June 30, 2007, \$1 equals 0.7430 Euros).

385. FUTURE PATENT POLICY, *supra* note 377, at 5; *Industrial Property*, *supra* note 379; *Intellectual Property*, *supra* note 382.

386. See EUROPEAN PATENT OFFICE, *supra* note 15, at 6; 'Concerted Push' for European Patents, *supra* note 356.

387. *Innovation/Intellectual Property: Solution Emerging on European Dispute Settlement*, EUR. REP. (European Info. Serv., London), Oct. 24, 2006 [hereinafter *Innovation/Intellectual Property*].

388. *Industrial Property*, *supra* note 379.

389. Schalkwijk, *supra* note 318.

390. *Id.*

E. The Future of European Patent Litigation: Community Patent, EPLA, or Both?

The patent litigation system in Europe has generated an extraordinary level of interest, as evidenced not only by the European Commission's initiative to institute a consultation on the European patent system that began in January 2006³⁹¹ but also by the "unprecedented" 2,515 responses to the survey.³⁹² As a result of this heightened interest, on September 8, 2006, Charlie McGreevy vowed to make a "concerted push to improve the patent system in Europe."³⁹³ As McGreevy explained, the consultation results make clear that there is widespread industry support for the Community Patent concept, but not for the "current Community Patent deal on the table—the 2003 Common Political Approach," which fails to offer an affordable and competitive Community patent.³⁹⁴ Many remain unsatisfied with the proposed language regime, as well as the seemingly inadequate jurisdictional arrangements.³⁹⁵

In addition to supporting the Community Patent concept, both industry and attorneys favor the Community's involvement in the EPLA.³⁹⁶ The two initiatives are no longer seen as mutually exclusive,³⁹⁷ because even if the Community Patent were to become effective with a common patent judicial system, the EPLA offers a unified jurisdiction for the hundreds of thousands of patents that the EPO already granted.³⁹⁸ Thus, McGreevy prudently intends to pursue both, proposing a "two-prong approach": (1) advance the Community Patent with new ideas and (2) in parallel, bring the EPLA negotiations to finality.³⁹⁹

The European Parliament's joint resolution of October 12, 2006 seconded McGreevy's double-pronged "concerted push."⁴⁰⁰ Similar to McGreevy, the joint resolution called on the Commission to explore "all possible ways of improving the patent and patent litigation systems," which includes not only further revised proposals for a Community Patent but also discussions on the EPLA.⁴⁰¹ As MEP Sharon Bowles remarked, "In the

391. EUROPEAN COMM'N, QUESTIONNAIRE ON THE PATENT SYSTEM IN EUROPE (2006), http://ec.europa.eu/internal_market/indprop/docs/patent/consult_en.pdf. The consultation focused on four major areas: the basic principles of the patent system, the Community Patent, the EPLA, and the mutual recognition of national patents. Grazyna Piesiewicz, *Stakeholders Debate Future Policy on Patents*, EUROPEAN COMMISSION, July 2006, http://ec.europa.eu/internal_market/smn/smn42/docs/patents_en.pdf.

392. See Closing Remarks, *supra* note 383; Next Steps, *supra* note 29 ("The level of participation in the consultation exercise exceeded my most optimistic expectations.").

393. Next Steps, *supra* note 29.

394. *Id.*; FUTURE PATENT POLICY, *supra* note 377, at 4,5; see Closing Remarks, *supra* note 383.

395. Closing Remarks, *supra* note 383; Piesiewicz, *supra* note 391, at 1.

396. See Next Steps, *supra* note 29; Piesiewicz, *supra* note 391, at 2.

397. See Piesiewicz, *supra* note 391, at 2.

398. Next Steps, *supra* note 29.

399. *Id.*

400. See *id.*; *Intellectual Property: Mixed Reactions to Patent Resolution*, EUR. REP. (European Info. Serv., London), Oct. 16, 2006 [hereinafter *Mixed Reactions*]. There were 494 votes for the joint resolution, 109 against, and 18 abstentions.

401. *Mixed Reactions*, *supra* note 400.

Parliament, we all wish to see a Community Patent in place eventually rather than a system based on a different multi-national convention. But the Community Patent proposals as they stand now are hopelessly stuck."⁴⁰² In regard to the EPLA, the MEPs called for greater democratic control, increased judicial independence, more guarantees on litigation costs, and a proposal for the EPLA court's rules of procedure.⁴⁰³ Although the European Community postponed its self-imposed 2006 end-of-year deadline for presenting a communication on European patent strategy because member states could not agree on the proposal,⁴⁰⁴ given McGreevy's and the European Parliament's recent statements and efforts, there is good reason for optimism in regard to future improvements in the European patent litigation system.⁴⁰⁵

III. Lessons from Europe

A. Continued Territoriality Reinforces Comity Concerns

After *Interlas*, advocates of the exercise of jurisdiction over foreign patent claims in U.S. courts bemoaned the "parochial"⁴⁰⁶ attitude of the United States toward multinational patent enforcement in comparison to European courts, specifically the Dutch.⁴⁰⁷ Because multinational patent enforcement was "garden variety" in many European countries, advocates dismissed as "completely absurd" the concerns that assertion of jurisdiction over foreign patents in U.S. courts would undermine principles of international comity.⁴⁰⁸ Relying heavily on the "Dutch[-]inspired movement toward a compellingly different world patent enforcement regime,"⁴⁰⁹ these advocates argued that the United States should recognize and accelerate global trends toward multinational patent enforcement in national courts.⁴¹⁰

402. *Id.*

403. *Id.*

404. See *European Patent: Towards a Watered-Down Patent?*, EUR. REP. (European Info. Serv., London), Nov. 23, 2006; *Intellectual Property: A Patent Failure*, EUR. REP. (European Info. Serv., London), Dec. 8, 2006; *Patents: All-English Patents Seen Looming*, *supra* note 366.

405. Certainly, such improvements cannot be expected soon. As President of the EPO, Alain Pompidou, admits, even if the problems with the agreements were solved immediately, it would take approximately five to eight years for the court system to be established. See *Patents: All-English Patents Seen Looming*, *supra* note 404.

406. Thomas, *supra* note 1, at 280.

407. See, e.g., Thomas, *supra* note 1, at 280, 346, 352 (asserting that, in accepting jurisdiction over foreign patents, U.S. courts would be following the Dutch movement toward international patent enforcement); Wegner, *supra* note 18, at 3, 12-15 (arguing that the conservative American approach to transnational enforcement has left the United States behind Europe and Japan, who are both leaders in the area).

408. Wegner, *supra* note 18, at 10, 12, 15-17; see Professors' Brief, *supra* note 8, at 14.

409. Thomas, *supra* note 1, at 346.

410. *Id.* at 346; Wegner, *supra* note 18, at 12; see Professors' Brief, *supra* note 8, at 12; Brief for Appellee, *supra* note 19, at 47-49. Advocates pointed out that foreign national courts' greater amenability to foreign patent claims put U.S. industry, without the ability to rely on its own courts for consolidated patent claims, at a comparative disadvantage. Professors' Brief, *supra* note 8, at 12.

The July 13, 2006 ECJ decisions in *Roche* and *GAT*, decided while the *Voda* decision was pending in the Federal Circuit, however, largely halted the European multinational patent enforcement trend, emphasizing the continued territoriality of patent law despite continued efforts to the contrary.⁴¹¹ In so doing, the ECJ eliminated such arguments, forcefully presented in the *Voda* briefs supporting consolidation and scholarly literature, which pointed to European case law to belittle international comity⁴¹² and encouraged U.S. courts to follow European trends toward multinational patent enforcement.⁴¹³ In contrast to these arguments, recent European trends counsel against widespread multinational patent enforcement in national courts. Thus, in *Voda*, the Federal Circuit, emphasizing comity considerations, wisely followed the example of the ECJ in further limiting the opportunity for U.S. courts to exercise jurisdiction over foreign patent claims.⁴¹⁴

The ECJ decisions in *Roche* and *GAT* emphasize that patents remain national instruments, disputes over which are usually appropriate for the national courts of the granting nation, especially when validity is in dispute.⁴¹⁵ The ECJ's re-emphasis on the territoriality of European patent law is of particular importance because Europe led the way in multinational patent enforcement.⁴¹⁶ Significantly, the ECJ itself exists to defend the harmonization of European legal standards and has worked in this direction on the basis of conventions meant to overcome the traditional concept that each nation is individually responsible for its own legal standards and the assertion and enforcement of rights in its territory.⁴¹⁷ Furthermore, the basic principles of the EU, a cooperative association of European states, clash with the concept of limited patent enforceability,⁴¹⁸ leading to the increasing harmonization and unification of European patent laws through agreements such as the EPC.⁴¹⁹ Additionally, within the EU, the Brussels Convention requires all contracting states to recognize and

411. See Shaw, *supra* note 26, at 1.

412. See Professors' Brief, *supra* note 8, at 14; Wegner, *supra* note 18, at 10, 12, 15-17.

413. See Brief for Appellee, *supra* note 19, at 47-49; Professors' Brief, *supra* note 8, at 12-14; Thomas, *supra* note 1, at 346; Wegner, *supra* note 18, at 12, 15-17, 122.

414. See *Voda v. Cordis Corp.*, 476 F.3d 887, 900-03 (Fed. Cir. 2007); Takenaka, *supra* note 24.

415. See Case C-4/03, *Gesellschaft für Antriebstechnik mbH & Co. KG v. Lamellen und Kupplungsbau Beteiligungs KG*, 2006 E.C.R. I-6509, para. 22 ("[T]he exclusive jurisdiction in proceedings concerned with the registration or validity of patents conferred upon the courts of the Contracting State in which the deposit or registration has been applied for or made is justified by the fact that those courts are best placed to adjudicate upon cases in which the dispute itself concerns the validity of the patent or the existence of the deposit or registration."); Barraclough, *supra* note 276; Shaw, *supra* note 26, at 1.

416. See Wegner, *supra* note 18, at 12.

417. Schuster, *supra* note 35.

418. Bender, *supra* note 3, at 49.

419. See Di Cataldo, *supra* note 11, at 19; Piotraut, *supra* note 11, at 61-62. In addition to creating a European patent, the EPC established uniform provisions for determining the validity and scope of European patents that are binding on national judges. Schuster, *supra* note 35.

enforce the judgments of other contracting states' courts that are rendered within the parameters of the Convention.⁴²⁰ Despite these factors, which make European courts, especially those of EU member states, a much more ideal venue for multinational patent enforcement than those of the United States,⁴²¹ the ECJ largely quelled the possibility for multinational patent enforcement,⁴²² displaying an undeniable "mistrust for the Dutch approach" to multinational patent enforcement.⁴²³ At a minimum, the ECJ decisions reinforced the "international consensus" that courts of one sovereign nation cannot rule on the validity of another nation's patents.⁴²⁴ The broader implication, however, is that, in the large majority of circumstances, national courts are not an appropriate forum for multinational patent enforcement,⁴²⁵ even within countries that have similar patent laws⁴²⁶ and agreements to recognize and enforce national courts' judgments.⁴²⁷

Despite both the Community Patent and EPLA's goal of unifying the European patent system beyond national borders, the initiatives provide further evidence of European nations' general refusal to allow a foreign national court to determine the validity of patents effective in their territory. In Community Patent negotiations, the problems concerning the competence to invalidate a Community patent exhibit this hesitance,⁴²⁸ as contracting states would not accept a foreign national court's invalidation of a Community patent, an instrument which, given the proposed common granting system, would have less territorial attachment to the sovereign nation than a national patent granted in a national patent office.⁴²⁹ Specifically, in the original CPC plans, member states had the authority to grant their national courts the competence to determine the validity of a Community patent only in the context of a counterclaim to an infringement action and, furthermore, such a determination would only be binding on that particular state.⁴³⁰ Moreover, the revised 1989 Agreement gave national courts the competence to decide invalidity in the first instance, but because the states would not accept a foreign national court's invalidation of a Community patent, the validity decisions of national courts could be appealed to a CoPAC.⁴³¹ The insistence on an appellate court to review

420. See Dreyfuss, *supra* note 13, at 426.

421. See Rasser, *supra* note 36 ("As the United States is not a member of anything that even approaches the EU in terms of level of cooperation, one might not expect the issue" of jurisdiction over the alleged infringement of a foreign patent "to play much of a role in U[.]S[.] court practice.").

422. See Shaw, *supra* note 26, at 1.

423. See Thomas, *supra* note 1, at 351.

424. See Brief for Defendant-Appellant, *supra* note 78, at 33.

425. Klinkert et al., *supra* note 281; Shaw, *supra* note 26, at 2.

426. See Di Cataldo, *supra* note 11, at 19; Piotraut, *supra* note 11, at 61-62.

427. See Brief for Defendant-Appellant, *supra* note 78, at 34; Thomas, *supra* note 1, at 301-02.

428. See Di Cataldo, *supra* note 11, at 27.

429. Schalkwijk, *supra* note 318.

430. Di Cataldo, *supra* note 11, at 27.

431. *Id.*

a national courts' determination on the validity of a Community patent suggests that European nations are not prepared to accept a foreign national court's invalidation of a patent effective in their country. In contrast to their refusal to allow foreign national courts to judge patent invalidity, the most recent agreements for both the Community Patent and the EPLA show that European nations are more receptive to allowing a common multinational patent court or judicial system to adjudicate patents valid in their territory.⁴³² Thus, although the current network of patent treaties shows that European nations appreciate that they must work together to ensure patent protection for their own inventors,⁴³³ European nations undeniably remain hesitant to permit other national courts to adjudicate their own patents.

European nations' reluctance to allow foreign national courts to adjudicate their patents confirms that international comity concerns undoubtedly linger when one national court asserts jurisdiction over a foreign country's patent, suggesting the wisdom of Federal Circuit's hesitance to permit U.S. courts to assume jurisdiction over foreign patent claims, particularly on account of comity concerns.⁴³⁴ "As long as the force of a patent instrument remains tied to territorial boundaries,"⁴³⁵ comity considerations, which continue to be the main obstacle to the exercise of jurisdiction over foreign patent claims in U.S. case law,⁴³⁶ are inevitable in an extraterritorial patent adjudication.⁴³⁷ As such, European developments seem to serve as a clear warning to U.S. courts to exercise jurisdiction over foreign patents in very limited circumstances to avoid offending other nations' sovereignty.

B. The Current Realities of Multinational Patent Enforcement in National Courts

In Europe, the ECJ's decisions basically eliminate the possibility of multinational patent enforcement for EU nations.⁴³⁸ It is true that the ECJ did leave a window of opportunity for multinational patent enforcement where a patentee sues a single defendant in its country of domicile and the defendant does not challenge patent validity.⁴³⁹ The reality, however, is

432. See Press Release, *supra* note 343; EUROPEAN PATENT OFFICE, *supra* note 15, at 5-6. In the EPLA, national courts must retain authority over infringement and revocation actions concerning national patents, but participating nations can transfer jurisdiction over European patents granted by the EPO to the common European Patent Court. See EUROPEAN PATENT OFFICE, *supra* note 15, at 5-6. In the latest Community Patent proposal, the Community Patent Court would have jurisdiction over Community patents, but national courts would retain jurisdiction over national patents and European patents. Press Release, *supra* note 343.

433. Thomas, *supra* note 1, at 325-26.

434. See *Voda v. Cordis Corp.*, 476 F.3d 887, 900-03 (Fed. Cir. 2007); *Mars II*, 24 F.3d 1368, 1376 (Fed. Cir. 1994).

435. Thomas, *supra* note 1, at 340.

436. See Rader, *supra* note 14, at 6.

437. Thomas, *supra* note 1, at 340.

438. See MacKendrick, *supra* note 281, at 373.

439. See Klinkert et al., *supra* note 281; Shaw, *supra* note 26, at 2.

that such circumstances are bound to occur rarely, if ever.⁴⁴⁰ Although the full scope of the decisions,⁴⁴¹ as well as the impact of the litigation on non-EU member states, remains to be seen,⁴⁴² the ECJ decisions have undoubtedly largely limited the occurrence of multinational patent litigation in European countries.⁴⁴³

Similarly, in the United States, the Federal Circuit's decisions in *Voda* and *Mars*, which perpetuate U.S. courts' historically conservative approach to jurisdiction over foreign patent claims,⁴⁴⁴ have all but eliminated the possibility of a U.S. court exercising such jurisdiction.⁴⁴⁵ Both decisions emphasize comity concerns,⁴⁴⁶ which have been the most significant barrier to jurisdiction over foreign patent claims in U.S. case law.⁴⁴⁷ Given that the facts of *Voda* presented a minimal risk of offending a foreign sovereign, the decision likely indicates that comity concerns remove the possibility of a U.S. court assuming jurisdiction over foreign patent claims in the vast majority of cases.⁴⁴⁸ With regard to supplemental jurisdiction over foreign patent claims, *Mars* and *Voda* set high standards for both prongs of the § 1367 analysis. Certainly, *Mars*' strict § 1367(a) analysis for the existence of supplemental jurisdiction⁴⁴⁹ and *Voda*'s limitation on judicial discretion to exercise supplemental jurisdiction under §1367(c)⁴⁵⁰ make it highly unlikely that a foreign patent claim would pass both prongs of the analysis. Moreover, the strict application of the forum non conveniens doctrine in the *Mars* dicta largely forecloses the possibility of a U.S. court assuming jurisdiction over a foreign patent claim based on diversity jurisdiction.⁴⁵¹ Thus, current U.S. case law emphasizes that only a rare foreign patent claim would survive a U.S. court's discretion not to exercise juris-

440. See Klinkert et al., *supra* note 281; Shaw, *supra* note 26, at 2. See *supra* Part II.B pp. 133-34 for a more thorough discussion of the rare situations in which multinational patent enforcement is still permissible in the national courts of EU members after the ECJ decisions.

441. See MacKendrick, *supra* note 281, at 373 (noting that the President of the District Court of The Hague held in a September 21, 2006 verdict that GAT does not affect cross-border injunctions in summary proceedings and granted a cross-border injunction for Germany).

442. See Professors' Brief, *supra* note 8, at 12 n.9.

443. Schuster, *supra* note 35.

444. See *Voda v. Cordis Corp.*, 476 F.3d 887, 900-03 (Fed. Cir. 2007); *MARS II*, 24 F.3d 1368, 1376 (Fed. Cir. 1994); Chisum, *supra* note 18, at 610; Wegner, *supra* note 18, at 12-15.

445. See Chisum, *supra* note 18, at 613; Takenaka, *supra* note 24.

446. See *Voda*, 476 F.3d at 900-03; *Mars II*, 24 F.3d at 1376.

447. Rader, *supra* note 14, at 6.

448. Igielski, *supra* note 121. See *supra* pp. 543-44 for a discussion of the strong argument for supplemental jurisdiction in *Voda*.

449. See *Mars II*, 24 F.3d at 1375; Chisum, *supra* note 18, at 613. See *supra* pp. 533-34 for a discussion of the *Mars* § 1367(a) analysis.

450. See *Voda*, 476 F.3d at 909 (Newman, J., dissenting); Adams, *supra* note 143; Igielski, *supra* note 121. See *supra* pp. 539-541 for a discussion of the *Voda* § 1367(c) analysis.

451. See *Mars II*, 24 F.3d at 1375-76; Chisum, *supra* note 18, at 613; Thomas, *supra* note 1, at 324; Wegner, *supra* note 18, at 27. See *supra* p. 535 for a discussion of the *Mars* dicta.

diction based on forum non conveniens, comity concerns, and, for supplemental jurisdiction cases, the § 1367(c) discretionary analysis.⁴⁵²

In addition to its rare permissibility, the realities of multinational patent litigation in national courts prevent it from being an ideal solution to patentees' problems.⁴⁵³ Even in Europe where numerous agreements have harmonized national patent law and provide for enforcement and recognition of national court decisions,⁴⁵⁴ suits for multinational patent enforcement in one national court often lead to unavoidable national validity or anti-suit related follow-up or collateral proceedings in foreign national courts.⁴⁵⁵ As a result, even during its peak in Europe in the mid-1990s, multinational patent litigation was never "the dominant model of choice" for patentees confronted with infringement in various countries.⁴⁵⁶ As the Federal Circuit emphasized in *Voda*, for litigation in the United States, the additional uncertainty of enforcing the decision abroad makes multinational patent litigation even more problematic.⁴⁵⁷ Thus, the majority of cases in European and U.S. courts will never qualify for consolidation and, for those that do, the difficulties involved risk increased costs, delay, and uncertainty on account of parallel or collateral proceedings.⁴⁵⁸ As a result, consolidation of foreign patent claims will currently only prove to be expedient in a very small number of cases.⁴⁵⁹

C. The Best Way Forward

The current realities of multinational patent enforcement in national courts illustrate that it is, at best, an "intermediate solution[]"⁴⁶⁰ on the path toward an integrated international patent enforcement system. Although there are undeniable benefits to the global litigation of patents, the current system of international treaties is not sufficiently developed to allow for the effective adjudication of foreign patents in national courts in most situations.⁴⁶¹ An integral solution for piecemeal patent litigation on a nation-by-nation basis ultimately depends on a "much more long term and focused global plan of international treaties and conventions . . ."⁴⁶²

The ECJ's decisions in *Roche* and *GAT*, which curtail the multinational patent enforcement trend in European national courts, as well as the Fed-

452. See *Voda*, 476 F.3d 887; *Mars II*, 24 F.3d 1368; *Goldberg v. Cordis Corp.*, 203 U.S.P.Q. 717 (N.D. Ill. 1976), *aff'd*, 567 F.2d 392 (7th Cir. 1977); *Packard Instrument Co. v. Beckman Instruments, Inc.*, 346 F. Supp. 408 (N.D. Ill. 1972).

453. Schuster, *supra* note 35.

454. See *Rasser*, *supra* note 36; Schuster, *supra* note 35.

455. Schuster, *supra* note 35.

456. *Id.*

457. See *Voda*, 476 F.3d at 903; *Elmer & Garcia*, *supra* note 13, at 9.

458. See *Voda*, 476 F.3d at 903; Schuster, *supra* note 35.

459. *Elmer & Garcia*, *supra* note 13, at 4.

460. See *Mossinghoff & Kuo*, *supra* note 119, at 560 (quoting Lois E. Boland, Future Development of the PCT System: The View of the United States Patent and Trademark Office, Address to the International Symposium on the PCT System in the 21st Century (Apr. 15-17, 1998)).

461. See *Voda*, 476 F.3d at 898-900; *Municoy*, *supra* note 66, at 342.

462. *Elmer & Garcia*, *supra* note 13, at 9.

eral Circuit's decisions in *Mars* and *Voda*, which further restrict the possibility of multinational patent enforcement in U.S. courts, demonstrate the necessity of an international patent enforcement system to overcome the duplicative litigation currently required.⁴⁶³ Moreover, subsequent to the ECJ decisions, the increased emphasis on the EPLA, a common judicial system for European patents, and the Community Patent initiative, which encompasses not only a unified judicial system but also a unitary supranational patent, demonstrates the inevitability of such an international patent system.⁴⁶⁴ The European initiatives, which remain the only negotiations toward an international procedure for patent enforcement,⁴⁶⁵ are a prime illustration of the difficulties involved in establishing an international patent system, as well as the likely steps along the way.

As the Federal Circuit noted in *Voda*, an international agreement providing for the mutual recognition and enforcement of foreign judgments would undoubtedly make multinational patent enforcement in national courts a more practical solution by enabling the rendering court to make a plaintiff whole in a single proceeding.⁴⁶⁶ Such agreements exist on bilateral and regional bases,⁴⁶⁷ but an international agreement, embracing a more extensive network of countries, would provide for more effective multinational patent litigation.⁴⁶⁸ Efforts in the 1990s toward such an agreement, the Hague Conference on Private International Law, a proposed international agreement for the enforcement of foreign judgments in civil and commercial matters modeled after the Brussels Convention, ultimately failed.⁴⁶⁹ However, the progress towards an agreement to improve multinational litigation offers "significant hope for the future" of multinational patent enforcement in national courts.⁴⁷⁰ Nevertheless, the European example of multinational patent enforcement in national courts on the basis of the Brussels Convention suggests that general agreements to respect and enforce the judgments of foreign national courts do not fully streamline the multinational patent litigation process, because national validity or anti-suit related follow-up proceedings are unavoidable.⁴⁷¹ In light of the European experience, agreements providing for mutual recognition of judgments in national courts are likely insufficient to provide the

463. See Anneliese M. Seifert, *Will the United States Take the Plunge into Global Patent Law Harmonization? A Discussion of the United States' Past, Present, and Future Harmonization Efforts*, 6 MARQ. INTELL. PROP. L. REV. 173, 173 (2002); Igielski, *supra* note 121.

464. See Mossinghoff & Kuo, *supra* note 119, at 547, 560 ("Will the [world patent system] be in effect by the year 2099? Without a doubt!").

465. John H. Barton, *Issues Posed by a World Patent System*, 7 J. INT'L ECON. L. 341, 349 (2004).

466. See *Voda*, 476 F.3d at 903; Dreyfuss, *supra* note 13, at 424; Elmer & Garcia, *supra* note 13, at 7.

467. See, e.g., Brussels Convention, *supra* note 257.

468. See Dreyfuss, *supra* note 13, at 425.

469. Municoy, *supra* note 66, at 378-79.

470. Dreyfuss, *supra* note 13, at 425-41 (analyzing an intellectual property case both without and under the proposed Hague Convention to show the potential benefits to "international litigation and to the sound administration of intellectual property law"); see Rader, *supra* note 14, at 7.

471. See Elmer & Garcia, *supra* note 13, at 8; Schuster, *supra* note 35.

“consistent and economically available system of judicial interpretation and enforcement”⁴⁷² necessary for effective patent enforcement.

After the ECJ decisions, the recent push primarily for a more realistic EPLA and, ultimately, for the ideal Community Patent suggests that Europe has realized that the appropriate means to ensure effective, uniform multinational patent enforcement is a multinational agreement establishing a common patent judicial system.⁴⁷³ An international patent judicial system or a single international patent court, on a global as opposed to a regional European level, would create a more streamlined method of multinational patent enforcement of national patents,⁴⁷⁴ avoiding the collateral and parallel proceedings that prevent multinational patent enforcement in national courts from functioning effectively.⁴⁷⁵ A single international patent court, similar to the CoPAC proposed in the 1989 Community Patent Agreement,⁴⁷⁶ or, ideally, a fully integrated patent judicial system, similar to the Community Patent Court envisaged in the 2003 Community Patent proposal or the European Patent Court planned in the EPLA,⁴⁷⁷ would ensure a uniform, final decision on each litigated national patent, which is often absent in present attempts at multinational patent enforcement in national courts.⁴⁷⁸ Additionally, uniform procedural rules of the international court would assuage another problem with the multinational patent litigation in national courts, which plunges foreign litigants into an unfamiliar system with often substantially different procedural laws.⁴⁷⁹ Furthermore, a detailed language regime would better anticipate the translational issues likely to occur when a court adjudicates multiple national patents.⁴⁸⁰

As illustrated in Europe’s aspiration for the implementation of the

472. See Pauline Newman, *On Global Patent Cooperation*, 8 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 3, 3 (1997).

473. See Closing Remarks, *supra* note 383; Next Steps, *supra* note 29.

474. Newman, *supra* note 472, at 3, 6.

475. See Elmer & Garcia, *supra* note 13, at 8; Schuster, *supra* note 35.

476. See DiCataldo, *supra* note 11, at 27.

477. See EUROPEAN PATENT OFFICE, *supra* note 15, at 5-6.

478. See Schuster, *supra* note 35. As the EPLA demonstrates, see *Industrial Property*, *supra* note 379 and *Innovation/Intellectual Property*, *supra* note 387, national sovereignty and constitutional concerns would undoubtedly be an issue in the delegation of power to an international body for patent enforcement. See Newman, *supra* note 472, at 7. Although the constitutionality of such a patent court is beyond the scope of this article, see David W. Okey, *Constitutionality of a Multi-National Patent System, Part II*, 81 J. Pat. & Trademark Off. Soc’y 927, 939-49 (1999) and Seifert, *supra* note 463, at 202-03, for an argument that an international patent court would not raise any constitutional issues in the United States. Additionally, see Newman, *supra* note 472, at 6, for the suggestion that, in order to avoid such national sovereignty concerns, a tribunal could be established in which nations do not yield their sovereignty, but rather citizens themselves would yield to the tribunal.

479. See Chisum, *supra* note 18, at 614; Municoy, *supra* note 66, at 372. U.S. civil procedure rules, which feature liberal discovery and the right to a jury trial, differ substantially from foreign procedural rules. Chisum, *supra* note 18, at 614. Such differences constitute a strong argument against the adjudication of foreign patent claims in U.S. courts. *Id.*

480. See 2003 Commission Proposal, *supra* note 343, at 9; EUROPEAN PATENT OFFICE, *supra* note 15, at 6.

Community Patent,⁴⁸¹ an ideal solution to multinational patent enforcement entails not only a common judicial system but also an international, global patent.⁴⁸² A multinational organization, established by treaty, creating a global patent that is respected in all member states and enforced by an international patent court would allow for the most uniform interpretation and enforcement of global patent rights.⁴⁸³ Nevertheless, as the years of negotiations in the Community Patent initiative clearly show, there are many obstacles along the way to a truly international patent system.⁴⁸⁴ Given the increased harmonization of European patent law on account of the EPC,⁴⁸⁵ the establishment of a global patent, which would require the agreement of nations with more divergent patent laws, would likely be even more problematic than the establishment of a Community Patent within the EU.⁴⁸⁶ Therefore, such a fully harmonized international patent system complete with a global patent and international patent court is certainly not likely in the short term,⁴⁸⁷ but the obstacles do not appear to be insurmountable.⁴⁸⁸ As now Director of the Office of International Relations for the U.S. Patent and Trademark Office (USPTO), Lois E. Boland, stated,

At some point in the future, we will have an international patent system . . . [in which] the right of an inventor will be universally recognized without having to seek patent protection in each of the countries of the world. It is likely that we will experience a number of intermediate solutions on the way to this true 'global patent,' but we have started down that path and we are not likely to turn back.⁴⁸⁹

Europe's example shows that progressive, intermediate steps toward effective multinational patent enforcement are on the horizon.⁴⁹⁰

481. See 'Concerted Push' for European Patents, *supra* note 356 ("In an ideal world, the Community Patent is the solution.").

482. See Mossinghoff & Kuo, *supra* note 119, at 547.

483. See *id.* (predicting that, "[t]o be truly effective," the world patent system will grant "a single, unitary patent respected in all of the member states").

484. See generally Di Cataldo, *supra* note 11, at 27-29 (explaining the difficulties encountered in negotiations toward a Community Patent).

485. See *id.* at 27; Heath, *supra* note 317, at 17.

486. The implementation of a global patent entails a tremendous number of issues related to patent prosecution beyond those relating to enforcement, including translation requirements upon issuance, the definition of patentable subject matter, whether to require "best mode" disclosure, whether to require relevant prior art disclosure, post-grant procedures, claiming practice, and patent term extension. See Mossinghoff & Kuo, *supra* note 119, at 554-56; Seifert, *supra* note 463, at 201.

487. See Municoy, *supra* note 66, at 404; Seifert, *supra* note 463, at 202.

488. See Di Cataldo, *supra* note 11, at 27 ("Immediately after its signing, the CPC faced unsolvable non-strategic problems that have prevented its ratification and its becoming effective. These problems are not per se insurmountable; rather they are problems whose settlement has been prevented only by the sometimes, and all too often, resurgent chauvinism of the European States."); Newman, *supra* note 472, at 7.

489. See Mossinghoff & Kuo, *supra* note 119, at 17 (quoting Lois E. Boland, Future Development of the PCT System: The View of the United States Patent and Trademark Office, Address to the International Symposium on the PCT System in the 21st Century (Apr. 15-17, 1998)).

490. See Mossinghoff & Kuo, *supra* note 119, at 547.

Conclusion

The historic territoriality of patent law fundamentally clashes with the increasingly global technology that it seeks to protect. As a result, in order to protect their inventions on an international level as required in today's global marketplace, inventors are forced to pursue duplicative litigations on a nation-by-nation basis. In response, advocates in both Europe and the United States have called for multinational patent enforcement, which has tremendous potential advantages over multiple suits in various national courts. Beginning in 1989, Dutch courts led Europe in a multinational patent enforcement trend, attacking the conventional territoriality of patent rights. In contrast, mainly due to international comity concerns, U.S. courts remain reluctant to exercise jurisdiction over foreign patent claims, leading to a handful of futile attempts to litigate foreign patents in the United States.

As the Federal Circuit's opinion on the issue awaited clarification in *Voda v. Cordis Corp.*, intervening ECJ decisions crushed the multinational patent enforcement trend in European courts, leading to an increased emphasis on both the Community Patent and the EPLA in an attempt to unify the disjointed European patent litigation system. The ECJ decisions, which largely destroy the potential for multinational patent enforcement in European national courts, as well as the proposed judicial systems in the Community Patent initiative and the EPLA, demonstrate European nations' continued hesitance to allow foreign national courts to adjudicate patents effective in their territory and, thus, reinforce the logic of U.S. courts that have refused to exercise jurisdiction over foreign patent claims. Furthermore, the inefficiencies evident in past multinational patent enforcement efforts in European national courts establish that unavoidable parallel and collateral proceedings in foreign national courts result in substantial expense, delay, and uncertainty for litigants. As a result of these difficulties and the recent ECJ decisions, the drive for both the more-readily-attainable EPLA and the ideal Community Patent show that Europe has realized that multinational agreements to establish a common patent judicial system are the appropriate means to ensure uniform, efficient multinational patent enforcement. Thus, as past and present European initiatives illustrate, multinational patent enforcement in national courts is only an intermediate solution in the long and difficult path toward the effective protection of international patent rights.