

**PRESENTATION:**

**A FEDERAL COURT PERSPECTIVE  
ON EXTRATERRITORIAL ENFORCEMENT  
OF INTELLECTUAL PROPERTY**

**Judge Avern Cohn\***

I want to express my appreciation to Professor Takenaka for the invitation, the transport, and the housing. Extraterritorial intellectual property enforcement is not a new problem. In the conference materials, you will find a 1968 note from the Michigan Law Review discussing the legal ramifications of jurisdiction over foreign patent claims in the United States.<sup>1</sup>

I want to focus directly on the title of this session: “Extraterritorial Intellectual Property Enforcement.” Those of you who want foreign patents enforced in United States courts should understand that I would be one of the enforcers. I am one of 600 federal judges, more or less, who enforce domestic patents. You must ask: do you want a foreign patent enforced by me or one of my colleagues? But I would not be alone in such activity. If you listened carefully to Judge Rader’s discussion of jurisdiction, either supplemental jurisdiction or diversity jurisdiction, you would immediately understand that thousands of state court trial judges have the same jurisdiction as I have. When I have diversity jurisdiction, a state court judge can have jurisdiction in the same case. If I exercise supplemental jurisdiction, it is likely a state court judge also has jurisdiction in the case.

You also have to consider, as Judge Rader mentioned, reciprocity. Do you want your U.S. patent enforced in a foreign court? Let me make a confession. When I received the invitation to speak today, I had no idea of the meaning of the subject matter. I did not know that the issue existed; that there was such a thing as enforcement of a foreign patent in a U.S. court. I looked at Judge Rader and Professor Adelman’s book.<sup>2</sup> Lo and behold, I found a whole section in it on the subject. It was mind-boggling to me. It was as if I discovered, looking at the skies, there was a ninth or tenth planet, that I never knew existed.

---

\* Eastern District Court of Michigan.

<sup>1</sup> *Jurisdiction-Foreign Patents*, 66 Mich. L.R. No. 2 (Dec. 1967).

<sup>2</sup> Martin J. Adelman, et al., *CASES AND MATERIALS ON PATENT LAW* (1999).

Also, a trial is only one step in the enforcement process. My patent decisions are appealed to the Federal Circuit. I also have decisions that are appealed to the Court of Appeals for the Sixth Circuit. Appeals for a state court go to a state supreme court. Judge McKeown is wrong. She may not do patents. She just does not do federal patents. If I had an enforcement action on a foreign patent on diversity in my court, the appeal would go to the Sixth Circuit, and if I was sitting in San Francisco, the appeal would go to Judge McKeown's court.

Also, enforcement actions need not be only associated with an effort to enforce a domestic patent. There may be other facts and circumstances in a dispute scenario that would bring a foreign patent into my court.

What Judge Rader did not talk about, and that the literature does discuss, is that there is distinction between an enforcement action and an action in which the validity of a patent is challenged. I think it highly unlikely, however we expand jurisdiction, that a validity question would ever be involved in extraterritorial decision-making. Validity depends upon the law of the sovereign which issues the patent. It is inconceivable to me that I would ever deal with a validity question. Additionally, the question of validity is not always a judicial question. In some countries it is purely an administrative decision. If there is a challenge to the validity of a patent, or of a claim, in the words of the European Union "the patent is a nullity," it could go to an administrative agency.

You hear from time-to-time the differences among federal judges. I think the principle factor that would be at play when you strip everything else away in an extraterritorial action, is the willingness of the judge to take on the challenge. Let me let you in on a secret. The least favorable case on any federal district judge's docket is usually a patent case.

Now, you tell me we're generalists. But the difficulty is that first of all, there are very few such cases coming along. I gathered the statistics on the number of cases, at both the federal district court level and the federal court of appeals level. There are approximately 2,300 patent cases filed each year in federal courts. That is, in the administrative office classification about 2,300 cases were terminated. But there are only 100 trials, and only about 60 or 70 that ever go to completion. Half of those are jury and half are non-jury. There are 600 federal judges. So do the arithmetic and see how much real experience federal judges have with patent cases—except possibly in the District of Delaware (Wilmington), the Eastern District of Virginia, the Southern District of New York, and the Northern District of California (San Francisco).

There are two reasons why federal judges do not like patent cases. First is that the judge not only has to deal with a complex legal structure, Title 35 and all that goes with it, *i.e.*, best mode, obviousness, prior sale, claim construction, etc. This is the legal side. The judge also has to familiarize himself, or herself, with the technology. Judges have little technological training. I, personally, in every patent case usually visit the plant, if it is an

industrial patent. Alternatively, I find a way to see the process in action by a video or tutorial. I insist that I get the brochures and the advertising material about the subject matter. Sometimes I go into the Internet and find the trade association associated with the subject matter, so I understand the technology. I have a hunch I am an exception, I believe, if you talk to federal judges around the country you will find my curiosity unusual. I hope I am wrong. Most of my colleagues' curiosity goes in other directions.

I have tried about 18 patent cases in my 20 years at the bench. This is probably substantially more than the average federal judge. A third of these cases did not come to me in the normal course; they were reassigned from other judges or were in other districts. Now I might be asked to familiarize myself with foreign law, and foreign patents. This is a bit much. What about specialized judges? I just do not think it will happen. This raises a very complex question, and it is something not likely to occur.

As the case law stands now, as Judge Rader has told you, the answer is "no," we are not going to take on enforcement of foreign patents in the federal district court. Maybe a bright, imaginative patent lawyer will bring one of these cases in a state court someplace. He, or she, might get a state court judge who is also imaginative, like the judge who says, "I'll take this on... I'll adjudicate it, because I've got personal jurisdiction, and I have common law jurisdiction. There's nothing in the statutes in my state that says I can't and we'll see what happens." That is the way it might get started. This will stir things up. It will stir up federal judges who will be jealous, and it will really stir up the Federal Circuit.

Again, the basis of jurisdiction can be either supplemental or diversity. There are good reasons against it happening. I have told you of the subjective reasons, the attitudinal reasons why judges will say no. More particularly, as Judge Rader explained from the *Mars, Inc.* case,<sup>3</sup> when a judge truly believes it is a local conflict, he, or she, will say it should be decided locally. The lack of familiarity with the subject matter and the avoidance of unnecessary problems and the conflict of laws problem that judges will encounter will also mitigate against it happening. Basically, jurisdiction will be determined on the basis of a *forum non conveniens*. Supplemental jurisdiction is discretionary. A judge can always dismiss a diversity case on the basis of *forum non conveniens* and be affirmed on appeal.

Let me conclude. I assume many of you know Judge Jack Weinstein of the Eastern District of New York. He has the longest arms of any federal judge living today. He finds jurisdiction where no one else thinks it exists.

---

<sup>3</sup> *Mars, Inc. v. Kabusushiki-Kaishn-Nippon Conlux*, 24 F.3d 1368 (Fed. Cir. 1994).

This is what he said in a case several years ago, in which a patent was being litigated in his court identical to a patent that had been litigated in England where it has been found valid, and not infringed:

It is a quiddity of our law that a well and thoroughly reasoned decision reached by a highly skilled and scientifically informed justice of the Patent Court, Chancery Division, and the High Court of Justice of Great Britain after four weeks of trial must be ignored and essentially the same issues with the same evidence must now be retried by American jurors with no background in science or patents, whose average formal education will be no more than high school. This curious event is the result of the world's chauvinistic view of patents.<sup>4</sup>

I also suggest that you read Professor Thomas's article, *Litigation Beyond the Technological Frontier*.<sup>5</sup> In the concluding section he makes observations and suggestions for dealing with a world patent order in which for many there is a shared confidence to resolve patent disputes. It is encouraging regarding what we are talking about today. Thomas says, and this is what we all have to think about,

Circumstances have rendered the allocation of exclusive competence in patent disputes to a particular national judiciary increasingly difficult to justify. If U. S. courts recognize these trends and choose to abandon the exclusionary rule, they would surely accelerate the Dutch-inspired movement toward a compellingly different world patent enforcement regime. As with most things, time will tell.

Thank you.

---

<sup>4</sup> *Cuno, Inc. v. Pall Corp.*, 729 F. Supp. 234, 239 (EDNY 1989).

<sup>5</sup> John R. Thomas, *Litigation Beyond The Technological Frontier: Comparative Approaches to Multi-National Patent Enforcement*, 27 Law & Policy In International Business 277, 346 (1996).