Transnational Enforcement

Marketa Trimble

Samuel S. Lionel Professor of Intellectual Property Law
William S. Boyd School of Law, UNLV
Territoriality of Patent Protection

- Territoriality of patent protection
  - National patents
  - Regional patents (e.g. European patent)
  - European (EU) patent with unitary effect

- According to the WIPO, “[a]round 85% of patent families created worldwide between 2011 and 2013 were filed in fewer than three patent offices.”

  World Intellectual Property Indicators 2016, WIPO, 2016, p. 26
Extraterritorial Reach of Patent Protection

- **Extraterritorial Reach:** Some patent rights may reach extraterritorially in some circumstances.

- **Limitations on Transnational Enforcement:**
  - Limitations posed by rules on personal jurisdiction and by the availability of enforcement of judgments abroad
  - Patent infringement claims are often not treated as transitory causes of action, i.e. courts will not adjudicate infringements under foreign countries’ laws
    - For the U.S. courts’ approach see Voda v. Cordis Corp., 476 F.3d 887 (Fed. Cir. 2007); *but cf.* Fairchild Semiconductor Corp v. Third Dimension (3D) Semiconductor, Inc., D. Me., 2:08-cv-00158-DBH
Extraterritorial Reach of U.S. Patents (I)

• Courts’ localizing of infringing acts
  • *E.g.*, Litecubes, LLC v. Northern Light Products, Inc., 523 F.3d 1353 (Fed.Cir. 2008) (cert denied); NTP, Inc. v. Research in Motion, Ltd., 418 F.3d 1282 (Fed.Cir. 2005)

• Offer made abroad to sell in the United States §271(a)
  • Rotec Indus., Inc. v. Mitsubishi Corp., 215 F.3d 1246 (Fed.Cir. 2000)
  • Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contractors USA, Inc., 617 F.3d 1296 (Fed.Cir. 2010); Halo Electronics, Inc. v. Pulse Electronics, Inc., 769 F.3d 1371 (Fed.Cir. 2014)
Extraterritorial Reach of U.S. Patents (II)

• Supply of components in or from the U.S. §271(f)
  • Life Technologies Corp. v. Promega Corp., 137 S.Ct. 734 (2017)

• Supply of products made by patented methods §271(g)
Extraterritorial Reach of U.S. Patents (III)

• Inducement §271(b)

• Trade shows in the United States
  • Temporary restraining orders or preliminary injunctions to stop exhibitions, offers to sell, and sales of infringing products
Limitations on Jurisdiction and Enforcement

• Personal jurisdiction
  • Specific jurisdiction based on the place of infringement (e.g., at a trade show)
  • Transient jurisdiction (based on temporary presence and service of process) questionable – e.g., Percept Technologies v. Fove, Inc., DNEV, 2:15-cv-02387-RFB-CWH, order, August 8, 2017

• Enforcement of U.S. judgments abroad
  • Limitations (e.g., reciprocity, punitive damages, injunctions)
  • Proposal for the Hague Convention on the recognition and enforcement of foreign judgments (draft of February 2017)