Second Issue of 2011's Revue Critique de Droit International Privé

The last issue of the *Revue critique de droit international privé* was just released. It contains three articles and several casenotes. The full table of contents can be found here.



In a first article, Pascal de Vareilles Sommieres, who is a professor of law at Paris I Pantheon Sorbonne University, explores the relationship between international mandatory rules and policy (*Lois de police et politiques legislatives*). The English asbtract reads:

> *Still somewhat ill-defined the role of legal policy, which is irrelevant in the determination of ordinary private law rules in Savigny's methodology, is of course a decisive element in characterization of mandatory rules, as a definition of their scope. In conflict of laws, policy considerations occupy a more significant place when the mandatory rule emanates from the legal system of the forum then when it is a foreign rule. In conflict of jurisdiction, policy requirements of varying intensity have to compose with other considerations of judicial administration, so that each mandatory rule exerts its own specific impact, whether on the jurisdiction of the court or on the status of foreign judgments.*

In the second article, Petra Hammje, who is a professor of law at the University of Cergy-Pontoise, offers a survey of the new Rome III Regulation (*Le nouveau reglement (UE) no 1259/2010 du Conseil du 20 décembre 2010 mettant en oeuvre une coopération renforcée dans le domaine de la loi applicable au divorce et à la séparation de corps*).

Finally, in the last article, Horatia Muir Watt, who is a professor of law at the Paris Institute of Political Science (*Science Po*) discusses the implications of the Chevron litigation (*Chevron, l'enchevetrement des fors. Un combat sans issue ?*). I am grateful to the author for providing me with the following abstract:

A decade after the dismissal of their claim by US courts for forum non conveniens and the victims' return to Ecuador, a new act of the Chevron (Texaco) drama began when the local court gave judgment in early 2011 against the multinational for its role in the environmental pollution in the Amazon forest region and its harmful consequences for the health of its indigenous population. Various strategies are currently being deployed internationally with a view to resist, neutralise or invalidate this judgment (in the form of a worldwide anti-suit injunction, a RICO action, or the invocation of international investment law) before the US court or in international arbitration. In this complex game where multiple fora make simultaneous claim to autority and engage in its mutual neutralisation, the reassuring traditional liberal model of international legal order is clearly out-of-step. The lesson of Chevron case is that it is time to quit the Westphalian perspective so that private international law may assume a useful role in global governance.

Subscribers of *Dalloz* can download the *Revue* here.

ECJ Rules on Territorial Scope of Prohibitions to Infringe Community Trade Marks and Coercive Measures

On April 12, 2011, the European Court of Justice ruled in DHL Express France SAS v. Chronopost SA on the territorial scope of prohibitions of infringing Community trade marks and of coercive measures ordered for the purpose of enforcing such prohibitions.

Background

European Regulation No 40/94 establishes a Community trade mark. The substantive effects of this trade mark are governed by the rules of the Regulation, but jurisdiction to rule on infringement proceedings was vested to a limited number of national courts in each Member state. Unless otherwise provided by the Regulation, these courts logically apply their own procedure, including the Brussels Convention (as it was then).

The French Judgments

In a nutshell, the dispute arose out of the use by DHL of a trade mark, "webshipping", that French corporation Chronopost had registered both as a French and as a European trademark. Chronopost initiated infringement proceedings in France against DHL. In a judgment of November 9th, 2007, The Paris Court of appeal found that DHL had indeed infringed Chronopost's European trade mark. It thus ordered DHL to stop doing so and issued a prohibition against further infringement. The prohibition was backed with an "astreinte", a periodic penalty payment of € 1,500 per day of non-compliance, to be paid to the plaintiff. The astreinte was not liquidated, i.e. the final amount of the payment was to be determined later by the court, when it could assess whether and when the defendant had complied.

However, the Paris Court refused to rule that the prohibition covered the entirety of the European Union, and limited its territorial scope to France. The court explained its decisions as follows. From a factual point of view, it found that only French speaking consumers could get confused by the infringement of the trade mark. But it also referred to Article 98 of Regulation No 40/94, which provides:

> ***Article 98 Sanctions***
>
> *1. Where a Community trade mark court finds that the defendant has infringed or threatened to infringe a Community trade mark, it shall, unless there are special reasons for not doing so, issue an order prohibiting the defendant from proceeding with the acts which infringed or would infringe the Community trade mark. It shall also take such measures in accordance with its national law as are aimed at ensuring that this prohibition is complied with.*
>
> *…*

The Court ruled that it could not issue an extraterritorial order without knowledge of the laws of other states offering an equivalent remedy.

Chronopost appealed to the French supreme court on private and criminal matters (*Cour de cassation*), which referred the matter to the ECJ and asked:

> *1. Must Article 98 of … Regulation [No 40/94] be interpreted as meaning that the prohibition issued by a Community trade mark court has effect as a matter of law throughout the entire area of the [European Union]?*
>
> *2. If not, is that court entitled to apply specifically that prohibition to the territories of other States in which the acts of infringement are committed or threatened?*
>
> *3. In either case, are the coercive measures which the court, by application of its national law, has attached to the prohibition issued by it applicable within the territories of the Member States in which that prohibition would have effect?*
>
> *4. In the contrary case, may that court order such a coercive measure, similar to or different from that which it adopts pursuant to its national law, by application of the national laws of the States in which that prohibition would have effect?*

The ECJ Ruling

Territorial Reach of the Prohibition

On the first question, the ECJ considered that, as a matter of principle, Community trade mark courts had jurisdiction over the entire area of the European Union. Its holding is:

> ***1. Article 98(1) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, as amended by Council Regulation (EC) No 3288/94 of 22 December 1994, must be interpreted as meaning that the scope of the prohibition against further infringement or threatened infringement of a Community trade mark, issued by a Community trade mark court whose jurisdiction is based on Articles 93(1) to (4) and 94(1) of that regulation, extends, as a rule, to the entire***

***area of the European Union**.*

However, the Court also underlined that in some circumstances, Community trade mark courts should limit the reach of their decisions to some parts of the EU only.

> *48. Accordingly, if a Community trade mark court hearing a case in circumstances such as those of the main proceedings finds that the acts of infringement or threatened infringement of a Community trade mark are limited to a single Member State or to part of the territory of the European Union, in particular because the applicant for a prohibition order has restricted the territorial scope of its action in exercising its freedom to determine the extent of that action or because the defendant proves that the use of the sign at issue does not affect or is not liable to affect the functions of the trade mark, for example on linguistic grounds, that court must limit the territorial scope of the prohibition which it issues.*

The Court further insisted that, pursuant to Article 33 of the Brussels I Regulation, recognition and enforcement of such prohibitions were mandatory.

Territorial Reach of the Coercive Measure

With regard to the coercive measure, the Court ruled that such measures were governed by the lex fori, and that they should have the same reach as the prohibitions if they were to achieve their goal. As a consequence, courts of other members states ought to recognize and enforce them, under the Brussels I Regulation.

The Court did not mention Article 49 of the Brussels I Regulation, which only provides for the enforcement of liquidated "astreintes". Is that to say that all "astreintes" ought to be enforced when used for the purpose of enforcing Community trade marks, even when unliquidated as in the present case?

In his opinion, AG Cruz Villalon had said:

> *64. The fact that a Community trade mark court draws up a periodic penalty payment does not necessarily imply that any quantification or enforcement thereof must be carried out by the same court. (…)*

65. (…) where the prohibition is infringed in a Member State other than the State of the forum, the quantification and enforcement stages must be carried out in the Member State in which that infringement occurred. Thus, whereas the Community trade mark court which heard the substance of the case must, where it finds infringement, impose a penalty payment, the quantification and subsequent enforcement thereof are a matter for the court of the Member State in which the prohibition is infringed, in accordance with the rules on recognition laid down in Regulation No 44/2001.

His argument was that "astreintes" being punitive in character, they should be quantified and enforced in the Member state of enforcement. This seems to mean that unquantified astreintes may, and indeed must be enforced abroad. I am not sure this is fully in accordance with the Brussels I Regulation.

Finally, my understanding was that "astreinte" is, in Europe, a remedy peculiar to France, Belgium and Luxembourg, but AG Cruz Villalon stated that there are known in most Member States. In any case, an important issue is how to actually enforce a French astreinte in another Member states where it would be an unknown concept. The Court ruled that in the absence of an equivalent measure in the enforcing state, the enforcing court should attain the same objective with its own procedural machinery.

56. Where the national law of the Member State in which recognition and enforcement of the decision of a Community trade mark court is sought does not provide for a coercive measure similar to that ordered by the Community trade mark court which issued the prohibition against further infringement or threatened infringement (and coupled that prohibition with such a measure in order to ensure compliance with the prohibition), the court seised of the case in that Member State must, as the Advocate General has observed at point 67 of his Opinion, attain the objective pursued by the measure by having recourse to the relevant provisions of its national law which are such as to ensure that the prohibition originally issued is complied with in an equivalent manner.

Final holding of the Court on this second set of questions:

*2. **Article 98(1), second sentence, of Regulation No 40/94, as amended by Regulation No 3288/94, must be interpreted as meaning that a***

coercive measure, such as a periodic penalty payment, ordered by a Community trade mark court by application of its national law, in order to ensure compliance with a prohibition against further infringement or threatened infringement which it has issued, has effect in Member States to which the territorial scope of such a prohibition extends other than the Member State of that court, under the conditions laid down, in Chapter III of [the Brussels I Regulation], with regard to the recognition and enforcement of judgments. Where the national law of one of those other Member States does not contain a coercive measure similar to that ordered by the Community trade mark court, the objective pursued by that measure must be attained by the competent court of that other Member State by having recourse to the relevant provisions of its national law which are such as to ensure that the prohibition is complied with in an equivalent manner.

Sanders on Due Process and the Recognition of Same-Sex Marriages

Steve Sanders, who is a Visiting Assistant Professor at the University of Michigan Law School, has posted The Constitutional Right to (Keep Your) Same-sex Marriage: Why the Due Process Clause Protects Marriages that Cross State Lines, Even if Conflict of Laws Cannot on SSRN. Here is the abstract:

> *Same-sex marriage is legal in six states, and nearly 50,000 same-sex couples have already married. Yet 43 states have adopted statutes or constitutional amendments banning same-sex marriage (typically called mini defense of marriage acts, or "mini-DOMAs"), and the vast majority of these measures not only forbid the creation of same-sex marriages, they also purport to void or deny recognition to the perfectly valid same-sex marriages of couples who*

migrate from states where such marriages are legal. These non-recognition laws effectively transform the marital parties into complete legal strangers to each other, with none of the customary rights or incidents of marriage.

In this paper I argue that an individual who legally marries in her state of domicile, then migrates to another state, has a significant liberty interest under the 14th Amendment's Due Process Clause in the ongoing existence of her marriage. This liberty interest creates a right of marriage recognition that prevents a mini-DOMA state from effectively divorcing her by operation of law. This right to marriage recognition is conceptually and doctrinally distinguishable from the constitutional "right to marry." It is a neutral principle, grounded in core Due Process Clause values: protection of reasonable expectations and of marital and family privacy; respect for established legal and social practices; and rejection of the idea that a state can sever a legal family relationship merely by operation of law. A mini-DOMA state will, of course, have interests to be considered in refusing to recognize certain marriages. But under the intermediate form of scrutiny I explain is appropriate, those interests do not rise to a sufficiently important level to justify the nullification of a migratory same-sex marriage.

Stefan on the Political Economy of Extraterritoriality

Paul B. Stefan III, who is the John C. Jeffries Jr. Distinguished Professor at the University of Virginia Law School, has posted the Political Economy of Extraterritoriality on SSRN. The asbtract reads:

I want to use the occasion of the Morrison decision to consider the interests that produce extraterritorial regulation by the United States. International lawyers for the most part have analyzed state decisions to exercise prescriptive jurisdiction over extraterritorial transactions in terms of a welfare calculus that determines the likely costs and benefits to the state as a whole. Fewer studies

have considered the political economy of the decision whether to regulate foreign transactions. No work of which I am aware has considered the political economy of deciding the extraterritorial question through litigation. This paper seeks to fill these gaps by sketching out what political economy suggests both about extraterritoriality and the role of courts as arbiters of regulatory scope.

Hague Academy, Summer Programme for 2012

Private International Law

* **Inaugural Conference** (30 July)
Conflicts of Laws and Uniform Law In Contemporary Private International Law : Dilemma or Convergence?
Didier OPERTTI BADÁN; Professor at the Catholic University of Montevideo.

General Course (6-17 August)
The Law of the Open Society
Jürgen BASEDOW; Director of the Max Planck Institute for Comparative and International Private Law, Hamburg.

The Private International Law Dimension of the Security Council's Economic Sanctions (30 July-3 August)
Nerina BOSCHIERO; Professor at the University of Milan.

* *The New Codification of Chinese Private International Law* (30 July-3 August)
CHEN Weizuo; Professor at Tsinghua University, Beijing.

Applying Foreign Public Law in Private International Law – A Comparative Approach (30 July-3 August)
Andrey LISITSYN-SVETLANOV; Professor at the Institute of State and Law, Russian Academy of Sciences, Moscow.

* *Party Autonomy in Private International Law: A Universal Principle between Liberalism and Statism* (6-10 August)
Christian KOHLER; Honorary Director-General at the Court of Justice of the European Union, Luxembourg.

Applying the most Favourable Treaty or Domestic Rules to Facilitate Private International Law Co-operation (6-10 August)
Maria Blanca NOODT TAQUELA; Professor at the University of Buenos Aires.

* *Bioethics in Private International Law* (13-17 August)
Mathias AUDIT; Professor at the University of Paris Ouest Nanterre La Défense

Compétence-Compétence in the Face of Illegality in Contracts and Arbitration Agreements (13-17 August)
Richard H. KREINDLER; Professor at the University of Münster

* Lectures delivered in French, simultaneously interpreted into English.

More information is available here.

Long Life ATS

American ATS is far from being dead: that's true both from the standpoint of academics and practitioners. Only two days ago, on Tuesday, Gilles announced a new article on the Statute. Less than a month after a paper of my own called "Responsabilidad civil y derechos humanos en EEUU: el fin del ATS?" was published, I learned about a new title from O. Murray, D. Kinley and C. Pitts: "Exaggerated Rumours of the Death of an Alien Tort? Corporations, Human Rights and the Remarkable Case of Kiobel" (Melbourne Journal of International Law, vol. 52). The summary reads as follows:

> *Over the past 15 years or so, we have become accustomed to assuming that corporations are proper subjects of litigation for alleged infringements of the 'law of nations' under the Alien Tort Statute ('ATS'). But, in a dramatic reversal of this line of reasoning, the United States Court of Appeals for the Second*

Circuit in Kiobel v Royal Dutch Petroleum ('Kiobel'),2 has dismissed this assumption and concluded that corporations cannot be sued under the ATS. This article explores the Court's reasoning and the ramifications of the decision, highlighting the ways in which the Kiobel judgment departs from both Supreme Court and Second Circuit precedent. The authors take to task the critical failure of the majority in Kiobel to distinguish between the requirements of legal responsibility at international law and that which is necessary to invoke ATS jurisdiction in the US District Courts. In the context of the maturing debates over the human rights responsibilities of corporations, the authors point to the political as well as legal policy implications of Kiobel and underscore the reasons why the case has already attracted such intense interest and will continue to excite attention as a US Supreme Court challenge looms.

And these are the main issues addressed:

.- the source of law for causes of action under the ATS (does the ATS create a statutory cause of action, does it grant jurisdiction to federal courts to recognise federal common law causes of action, or does the ATS only permit the recognition of causes of action that exist in international law?); and
.- the debate regarding secondary liability: critics to the adoption by the Second Circuit of international law as the source of law for determining the rules on secondary liability under the ATS, and the conclusion of the majority in Kiobel (there is no norm of corporate liability in customary international law, and therefore there can be no liability of corporations under the ATS).

Kiobel has also been delt with in Spain by professor Zamora Cabot (University of Castellón), an ATS expert: see here his last paper, which will soon be published in English.

As for the judiciary: a petition for writ of certiorari was filed on June, 2011, to review the Kiobel judgment of the United States Court of Appeals for the Second Circuit, entered on September 17, 2010.

I would conclude that the ATS has a "mala salud de hierro" (prognosis: ill, but still a long way to go).

Comity and Overseas Witnesses in Australia

An interesting recent decision of the Full Court of the Federal Court of Australia, *Joyce v Sunland Waterfront (BVI) Ltd* [2011] FCAFC 95, considers the role of comity and the interrelationship of public and private international law in the context of taking testimony from a witness outside the court's territorial jurisdiction.

The issue arose in civil proceedings in the Federal Court of Australia about misrepresentations said to have been made in Australia about the purchase of land in Dubai. Several witnesses (mainly Australian citizens) were located in Dubai, and although they were willing to testify, they were unable to travel to Australia to give evidence in person.

Under the Federal Court's rules, the two options were either for the judge to travel to Dubai to take evidence on commission, or for the witnesses to give evidence by video link. Approaches through diplomatic channels revealed at best an ambiguous attitude on the part of the UAE government about whether either course would be acceptable to it, but UAE lawyers gave evidence to the Australian court that there were no local statutes prohibiting either means of taking evidence.

The trial judge was concerned, in the light of diplomatic correspondence placed before him, that there was no evidence "that the UAE government would permit the taking of evidence by video link" and that to do so "without that permission, … would be seen to be, or could be seen to be, a subversion of a refusal by a sovereign government to permit the taking of evidence on commission on its soil." *Sunland Waterfront (BVI) Ltd v Prudentia Investments Pty Ltd (No 9)* [2011] FCA 832 at [40]

Referring to remarks in *Yamouchi v Kishimoto* (2002) 12 NTLR 32 and *Bell Group Ltd (In Liq) v Westpac Banking Corporation* (2004) 208 ALR 491, his Honour considered that to take evidence by video link was, in effect, to exercise the

judicial power of the Commonwealth of Australia in the foreign country in which the witness was sitting; and that even if the witness testified voluntarily, the exercise of the Australian court's powers could be viewed as an infringement of that foreign jurisdiction's sovereignty in the absence of clearer consent than was available in the present case. Given the diplomatic involvement of the Australian Department of Foreign Affairs and Trade, his Honour was especially wary of being perceived by a foreign sovereign as having acted unilaterally. In that context, he refused to order that evidence be taken by video link from Dubai.

The Full Court reversed that conclusion. Keane CJ, Dowsett and Greenwood JJ discussed the role of comity when taking evidence from witnesses overseas (whether on commission or by video link). Their Honours quoted a number of sceptical statements about the value of comity as a guiding principle, including the trenchant remark of Perram J in *Habib v Commonwealth* (2010) 183 FCR 62 at [27] that: "No doubt comity between the nations is a fine and proper thing but it provides no basis whatsoever for this Court declining to exercise the jurisdiction conferred on it by Parliament."

Reviewing the Australian statute on taking evidence by video link, their Honours remarked that it:

> *does not require that the foreign state consent to a person within its borders giving evidence by video link to an Australian court. If the Parliament perceived any problem arising out of the concept of sovereignty or that of comity, then it seems to have overridden any obligation which Australia may have had in that regard. … We see no justification for imposing upon the exercise of the discretion conferred by [the statute] a requirement that the other state consent to the taking of evidence in that way. [at [60]]*

Their Honours concluded that:

> *in exercising the discretion [to take evidence by video link], the Court is not hampered by any need to consider questions of sovereignty or comity between nations, at least absent any law forbidding such conduct, and subject to the question of whether an oath or affirmation should be required. To the extent that his Honour disposed of the matter upon the basis that questions of sovereignty and comity were relevant, he took into account irrelevant considerations. The exercise of the discretion miscarried. [at [62]]*

Australian courts quite regularly take evidence by video link, and it is unusual for a party (in this case, the defendants) to have objected so vehemently, especially as the witnesses were themselves willing to testify. The subtext, it seems, was that one of the unavailable witnesses was the plaintiff himself: the defendants would have benefitted from a permanent stay or non-suit in the event of his inability to testify.

Perhaps of most interest to international readers is the sceptical attitude of the Full Court towards judicial comity in international litigation. This could perhaps be seen as part of a wider trend towards robust individualism on the part of the Australian courts when it comes to the exercise of their jurisdiction in cross-border cases (another example being the remarkable tenacity of Australian courts in *forum non conveniens* cases). It is also an example of the less deferential attitude taken by the Australian courts towards the executive government's conduct of foreign relations in recent times (*Habib v Commonwealth* (2010) 183 FCR 62 being the most notable example).

Joyce v Sunland Waterfront (BVI) Ltd [2011] FCAFC 95 (19 August 2011)

Strike Out for Breach of Anti-Suit Injunction

What are the options open to a plaintiff where a foreign defendant, who files an appearance and a defence, subsequently commences and continues foreign proceedings in breach of an anti-suit injunction, where the defendant has no assets in the jurisdiction? That was the circumstance that confronted the plaintiffs in the Supreme Court of Victoria in *Cocoon Data Holdings Pty Ltd v K2M3 LLC* [2011] VSC 355. Among the counsel for the plaintiff was my Australian co-editor, Perry Herzfeld.

After filings its unconditional appearance and defence in Victoria, the defendant

K2M3 commenced proceedings of its own in the USA, in response to which the Victorian court issued an anti-suit injunction. Significantly, the US court refused K2M3's application for an injunction against Cocoon, and the US proceedings were stayed on *forum non conveniens* grounds. K2M3 appealed against that decision, and it was that act of appealing and continuing to prosecute the appeal in the US that constituted the ongoing breach of the Victorian anti-suit injunction.

In the exercise of the inherent jurisdiction of the Victorian Supreme Court, Ferguson J struck out the defendant's defence and gave judgment for the plaintiffs. Her Honour quoted *Derby & Co Ltd v Weldon* [1990] 1 Ch 65 at 81 (CA), where Lord Donaldson of Lymington MR referred to the possibility of barring the right to defend of a defendant with no assets within the jurisdiction who breaches a *Mareva* injunction freezing those assets. Her Honour concluded (at [21]-[22]):

> *Non compliance with an anti-suit injunction is a grave matter. There must be compliance with such orders. If there is not, and no proper explanation for their breach is given, then severe sanctions may be warranted. Any such sanctions which are imposed are not aimed at punishing a defaulting party but rather are necessary to safeguard the administration of justice.*
>
> *Whilst the remedy sought by [the plaintiffs] is drastic, in the circumstances, it is appropriate for orders to be made striking out the defence of K2M3. No practical alternative course is available. Such orders are necessary to maintain the authority of the Court. On the evidence before me, K2M3 has deliberately breached the terms of the orders on multiple occasions without explanation, despite opportunities being given to it to provide an explanation. It did so in circumstances where it had chosen to submit to the jurisdiction of this Court; it had taken steps in this proceeding by filing an unconditional appearance and defence; it had been represented by counsel on the application when the first anti-suit injunction was granted; it did not appeal from any of the orders made in the proceeding; after breaching the orders, it instructed counsel to appear on a further hearing but failed to instruct counsel as to the reason(s) for non-compliance with the orders; it has had notice of this application and chose not to be represented on either this occasion or when the application first came on for hearing.*

Bellia & Clark on the Original Meaning of the Alien Tort Statute

Anthony Bellia (Notre Dame Law School) and Bradford Clark (The George Washington University Law School) have published an article on the Alien Tort Statute and The Law of Nations in the last issue of the *Chicago Law Review*. The abstract reads:

Courts and scholars have struggled to identify the original meaning of the Alien Tort Statute (ATS). As enacted in 1789, the ATS provided "[t]hat the district courts . . . shall . . . have cognizance . . . of all causes where an alien sues for a tort only in violation of the law of nations or a treaty of the United States." The statute was rarely invoked for almost two centuries. In the 1980s, lower federal courts began reading the statute expansively to allow foreign citizens to sue other foreign citizens for all violations of modern customary international law that occurred outside the United States. In 2004, the Supreme Court took a more restrictive approach. Seeking to implement the views of the First Congress, the Court determined that Congress wished to grant federal courts jurisdiction only over a narrow category of alien claims "corresponding to Blackstone's three primary [criminal] offenses [against the law of nations]: violation of safe conducts, infringement of the rights of ambassadors, and piracy." In this Article, we argue that neither the broader approach initially endorsed by lower federal courts nor the more restrictive approach subsequently adopted by the Supreme Court fully captures the original meaning and purpose of the ATS. In 1789, the United States was a weak nation seeking to avoid conflict with other nations. Every nation had a duty to redress certain violations of the law of nations committed by its citizens or subjects against other nations or their citizens—from the most serious offenses (such as those against ambassadors) to more commonplace offenses (such as violence against private foreign citizens). If a nation failed to redress such violations, then it became responsible and gave the other nation just cause for war. In the aftermath of the Revolutionary War, Congress could not rely upon states to redress injuries suffered by aliens (especially British subjects) at the hands of

Americans. Accordingly, the First Congress enacted the ATS as one of several civil and criminal provisions designed to redress law of nations violations committed by United States citizens. The ATS authorized federal court jurisdiction over claims by foreign citizens against United States citizens for intentional torts to person or personal property. At the time, both the commission of—and the failure to redress—such "torts" violated "the law of nations." The statute thus employed these terms to create a self-executing means for the United States to avoid military reprisals for the misconduct of its citizens. Neither the ATS nor Article III, however, authorized federal court jurisdiction over tort claims between aliens. Indeed, federal court adjudication of at least one subset of such claims—alien–alien claims for acts occurring in another nation's territory—would have contradicted the statute's purpose by putting the United States at risk of foreign conflict. Despite suggestions that the true import of the ATS may never be recovered, the original meaning of the statute appears relatively clear in historical context: the ATS limited federal court jurisdiction to suits by aliens against United States citizens but broadly encompassed any intentional tort to an alien's person or personal property.

Holbrook on Offers to Sell Inventions and Territoriality of Patent Law

Timothy Holbrook, who is a professor of law at Emory Law School, has posted Territoriality and Tangibility after *Transocean* on SSRN.

Patent law is generally considered the most territorial forms of intellectual property. The extension of infringement to include "offers to sell" inventions opened the door to potential extraterritorial expansion of U.S. patent law. In Transocean Offshore Deepwater Drilling, Inc. v. Maersk Contractors USA, Inc., the U.S. Court of Appeals walked through the door by concluding (1) that the

location of the ultimate sale, not the location of the offer, determines whether patent infringement occurred and (2) that there can be infringement by selling or offering to sell an invention based solely on diagrams and schematics. The one-two punch of these holdings works a considerable expansion of the territorial scope of a U.S. patent and of these infringement provisions generally. This essay explores the consequences of these holdings, making the following conclusions. First, the elimination of a tangibility requirement for infringement, while ultimately correct, creates a number of problems when coupled with the court's holding on extraterritoriality. Because the sale need not be consummated for there to be an infringing offer to sell, the court extended infringement to circumstances where no activity has taken place within the United States. Moreover, if this standard is used to inform the scope of the on-sale bar patentability, then the court greatly expanded potential sources of prior art that could be used to invalidate existing U.S. patents. Additionally, comparing Transocean to the territoriality standards in trademark law demonstrates that the holding of Transocean may not be as extensive if it is limited to offers made abroad by U.S. citizens or corporations. Regardless of the citizenship factor, this comparative analysis also demonstrates that the Federal Circuit should take into account potential conflicts with the law in foreign locations where the negotiations take place.

The paper is forthcoming in the *Emory Law Journal*.