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Developing a Legal Framework to Govern Forum Shopping in Transnational Intellectual Property Litigation

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Contents

Abstract

As globalisation facilitates transnational intellectual property litigation, the number of available forums has increased and led to the need to more effectively govern the practice of forum shopping. 'Forum shopping' refers to a litigant's strategic choice of a court or tribunal which has the highest probability of achieving a favourable outcome. The term has traditionally been used in a derogatory manner as the practice can lead to inconvenience and inequity. However, an emerging group of scholars argue that forum shopping is a justifiable and rational choice by litigants which can advance the efficient administration of justice in transnational litigation. In such a context, the central research question to be addressed in the thesis is: what criteria should be utilised as a legal framework by the judiciary and policy makers to determine when global forum shopping can be appropriately used in transnational IP litigation? While there are many opportunities to forum shop in the intellectual property regime complex, there is limited literature on the use of the practice within transnational intellectual property litigation. This thesis seeks to address this gap by using rational choice theory as the foundation for an approach towards forum shopping that balances the interests of the litigants' forum choices with the perceived risks caused by the practice to advance an effective legal framework for the governance of forum shopping. The central research question will be addressed by evaluating the key risks and benefits of forum shopping, undertaking a doctrinal analysis of the current factors the judiciary examine when assessing the practice and considering whether forum shopping can be appropriate in prescribed circumstances. This thesis will then present criteria, including jurisdiction rules, convenience, efficiency, motivations and policy relating to public interest, which can be applied by the judiciary to promote the administration of justice in this field.

Statement of Originality

This work has not previously been submitted for a degree or diploma in any university. To the best of my knowledge and belief, this thesis contains no material previously published or written by another person except where due reference is made in the thesis itself.

Vannessa Ho

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Abbreviations

BIT	Bilateral Investment Treaty
EU	European Union
FCTC	World Health Organization Framework Convention on Tobacco Control
FNC	*Forum non conveniens*
IP	Intellectual Property
ISDS	Investor-State Dispute Settlement
PMA	Philip Morris Asia - a subsidiary of PMI incorporated in Hong Kong
PMI	Philip Morris International group of companies
TRIPs	Trade Related Aspects of Intellectual Property Rights
US	The United States of America
WHO	World Health Organization
WTO	World Trade Organization
WTO DSB	World Trade Organization Dispute Settlement Body

I INTRODUCTION

As globalisation facilitates transnational intellectual property ('IP') litigation, the number of forums available for dispute resolution has increased and led to the need to more effectively govern the practice of forum shopping. 'Forum shopping' is a term used to describe a litigant's strategic choice of a court or tribunal which has the highest probability of achieving a favourable outcome.[1] Forum shopping exposes multiple weaknesses in the ideal positivist legal system including that the outcome of litigation can be influenced by venue due to the impact of social forces upon the formation, interpretation and application of the law.[2] For revealing these issues in the legal system, forum shopping has been characterised as a type of cheating and the term has traditionally been used in a derogatory manner.[3] Nevertheless, forum shopping has also been acknowledged to be a common practice, key to the litigation system and a rational strategy for litigants.[4] Since the beginning of the twenty-first century, the scholarly literature on the topic has explored the legitimate strategic motivations for forum shopping and the positive benefit it can have on the efficient administration of justice in transnational litigation.[5] Similarly, the judiciary has also traditionally used forum shopping as a pejorative term even as they identify instances for when the practice is permitted. In such a context, the central research question to be addressed by this thesis is: what criteria should be utilised as a legal framework by the judiciary and policy makers to

[1] Black's Law Dictionary (10th ed, 2014) 'Forum Shopping'. A more detailed analysis of the concept is provided below in Chapter I(A) of this thesis.
[2] Kevin M Clermont and Theodore Eisenberg, 'Exorcising the Evil of Forum Shopping' (1995) 80 *Cornell Law Review* 1507, 1508; Mary Garvey Algero, 'In Defense of Forum Shopping: A Realistic Look at Selecting a Venue' (1999) 78 *Nebraska Law Review* 79, 80; 'Forum Shopping Reconsidered' (1990) 103 *Harvard Law Review* 1677, 1680, 1684-6.
[3] Friedrich K Juenger, 'Forum Shopping, Domestic and International' (1989) 63 *Tulane Law Review* 553, 553; Debra Lyn Bassett, 'The Forum Game' (2006) 84 *North Carolina Law Review* 333, 336; Harald Koch, 'International Forum Shopping and Transnational Lawsuits' (2006) 31 *The Geneva Papers on Risk and Insurance* 293, 294; Richard Maloy, 'Forum Shopping? What's Wrong with That?' (2005) 24 *Quinnipiac Law Review* 25, 25-6; Linda J Silberman, 'Developments in Jurisdiction and Forum Non Conveniens in International Litigation: Thoughts on Reform and a Proposal for a Uniform Standard' 28 *Texas International Law Journal* 501, 528-30; Einer Elhauge, 'Preference-Eliciting Statutory Default Rules' (2002) 102 *Columbia Law Review* 2162, 2259.
[4] Marc L Busch, 'Overlapping Institutions, Forum Shopping, and Dispute Settlement in International Trade' (2007) 61(4) *International Organization* 735, 735; 'Forum Shopping Reconsidered' (n 2) 1677; Algero (n 2) 82; Bassett (n 3); Donald Earl Childress III, 'Escaping Federal Law in Transnational Cases: The Brave New World of Transnational Litigation' (2015) 93 *North Carolina Law Review* 995, 996; Christopher A Whytock, 'The Evolving Forum Shopping System' (2011) 96 *Cornell Law Review* 481, 487; Nita Ghei and Francesco Parisi, 'Adverse Selection and Moral Hazard in Forum Shopping: Conflicts Law as Spontaneous Order' (2004) 25(4) *Cardozo Law Review* 1367, 1378.
[5] See, eg, Friedrich K Juenger, 'What's Wrong with Forum Shopping?' (1994) 16 *Sydney Law Review* 5; Pamela K Bookman, 'The Unsung Virtues of Global Forum Shopping' (2016) 92 *Notre Dame Law Review* 579; Bassett (n 3); Maloy (n 3).

determine when global forum shopping can be appropriately used in transnational IP litigation? To address this central research question, this thesis will evaluate the primary criticisms associated with forum shopping, analyse the current factors the judiciary considers when assessing the practice and consider whether forum shopping can be appropriate in prescribed circumstances. This thesis will then present criteria which can contribute to the development of a more effective legal framework to govern forum shopping through a method that balances between the plaintiff's right to choose the forum and protect the defendant's interests in being able to easily defend themselves. These criteria include jurisdiction rules, convenience, efficiency, motivations and policy relating to public interest. These criteria should be used by the judiciary, policy makers, legal representation and academia to promote the efficient administration of justice in transnational IP litigation.

A *Background*

The concept of forum shopping has existed since 1870 in the *Phillips v Eyre* case.[6] However, the first mention of the term was in a journal article by Horowitz[7] discussing the 1938 United States ('US') case *Erie Railroad Co v Tompkins*[8] which stated that forum shopping is 'evil' and the presumption against the practice has since persisted.[9] Yet, the precise nature of forum shopping is rarely discussed in case law. Recently, an emerging group of scholars have sought to define the practice, primarily by adopting a broad approach that is not explicitly pejorative. The broad definition of forum shopping is cited from Black's Law Dictionary as 'the practice of choosing the most favourable jurisdiction or court in which a claim might be heard.'[10] This definition implies that the necessary condition for forum shopping to occur is that a choice between different courts or tribunals are available.

This thesis will utilise the broad definition of forum shopping in conjunction with rational choice theory as it provides the most objective approach towards the practice. This theory will be utilised to treat forum shopping in a neutral manner throughout the thesis so that the term is not conceived of in the traditional pejorative way. Rational choice theory has

[6] (1870) LR 6 QB 1.
[7] Harold W Horowitz, 'Erie R.R. v Tompkins: A Test to Determine Those Rules of State Law to Which its Doctrine Applies' (1950) 23 *Southern California Law Review* 204, 214-5.
[8] 304 US 64 (1938).
[9] Kimberly A Moore, 'Forum Shopping in Patent Cases: Does Geographic Choice Affect Innovation' (2001) 83 *Journal of the Patent and Trademark Office Society* 558, 589; RS French, 'Legal Retail Therapy: Is Forum Shopping a Necessary Evil?' [2001] (Summer) *Bar News: The Journal of the NSW Bar Association* 44, 44. 'Forum Shopping Reconsidered' (n 2) 1681; Bassett (n 3) 336.
[10] Black's Law Dictionary (n 1) 'Forum Shopping'.

multiple parallels with the broad definition of forum shopping. The theory assumes that individuals make choices based upon the belief that it will lead to the achievement of a preferred outcome.[11] In the same way, forum shoppers choose a venue which they believe will provide a favourable result. The belief of the litigant is calculated through assessments of information, preferences, values and probability of achieving the desired outcome. In sum, because the outcome of litigation is always uncertain, '[a] rational party will choose the forum that is most likely to yield a favourable outcome.'[12]

In comparison, Maloy has advanced a narrow definition of forum shopping to differentiate it from forum selection. He characterises forum shopping as 'the taking of an unfair advantage of a party in litigation.'[13] This means that if forum shopping is an undesirable practice, then it is always inappropriate and the instances where the courts have allowed forum shopping are actually legitimate forum selections. For this definition, the distinction between an inappropriate shop and an appropriate selection lies in the improper motive of the litigant who seeks an unfair advantage.[14] Bookman criticises this argument, stating that 'it is difficult to identify the line between purportedly legitimate "forum choices" and illegitimate "forum shopping."'[15] Ryan corroborates Bookman by stating:

> [T]here are many situations in which plaintiffs can control the place of suit that are not called 'forum shopping.' There is no principled distinction between those cases and ones in which the plaintiffs' actions are condemned as 'forum shopping.' Thus, the cases on forum selection cannot be explained by whether or not they involve 'forum shopping': either they all do, or none of them does.[16]

As such, the difference between forum selection and forum shopping is a matter of how the terms are defined. The criteria which will be developed in this thesis may be applied to determine when a litigant's forum choice is appropriate or not, whether these choices are labelled as forum shopping or forum selections. As the precise distinction between the two is difficult to identify, the rest of this thesis will utilise the broad definition to assume that

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[11] For a detailed analysis of rational choice theory see below Chapter II(A).
[12] Ghei and Parisi (n 4) 1378.
[13] Maloy (n 3) 28. See also Markus Petsche, 'What's Wrong with Forum Shopping? An Attempt to Identify and Assess the Real Issues of a Controversial Practice' (2011) 45 *The International Lawyer* 1005, 1007-1008; Ghei and Parisi (n 4) 1390-1.
[14] Maloy (n 3) 28; Petsche (n 13) 1008; 'Forum Shopping Reconsidered' (n 2) 1677.
[15] Bookman (n 5) 589, 590. See also Bassett (n 3) 342; 'Forum Shopping Reconsidered (n 2) 1677; Algero (n 2) 80.
[16] Antony L Ryan, 'Principles of Forum Selection' (2000) 103 *West Virginia Law Review* 167, 203.

where litigants can strategically choose between venues, then it is a matter of forum shopping.

Originally, forum shopping was used to refer to a domestic US practice however, with the increase in globalisation the practice may also be used across borders as a type of 'global forum shopping'. The first uses of forum shopping occurred on a domestic scale in the US due to the federal legal system. Plaintiffs could choose between different state courts or a federal court over a state court.[17] In comparison, the term was used in England for the first time during transnational litigation in the 1971 case of *Chaplin v Boys.*[18] This use introduces global forum shopping as another type of the practice and will be the focus of this thesis. While domestic forum shopping involves choosing between courts within a single nation-state, global forum shopping occurs when a litigant can choose among venues in different nation-states or at a supra-national level.[19] Transnational litigants have many venue options to choose among due to the differences in domestic laws and court procedures as well as forums created under international treaties such as free trade agreements.[20] In the context of IP rights, which can cross multiple jurisdictions due to advances in modern technology, there is increased opportunity to forum shop on a global scale.

B *Central Research Question and the Issues to be Addressed*

Prompted by the scholarly debate between the traditional criticisms of forum shopping and the emerging view that the practice can be desirable, the central research question to be addressed by this thesis is: what criteria should be utilised as a legal framework by the judiciary and policy makers to determine when global forum shopping can be appropriately used in transnational IP litigation?

To answer this central research question, the following four issues need to be addressed:

1. Can forum shopping be appropriate in prescribed circumstances?
2. What are the key risks and benefits that occur from the use of forum shopping?
3. What factors are currently being used to determine when forum shopping is appropriate or inappropriate?

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[17] French (n 9) 44; Peter Drahos and John Braithwaite, *Global Business Regulation* (Cambridge University Press, 2000) 564.
[18] [1971] AC 356.
[19] Definition of domestic forum shopping: Petsche (n 13) 1006. Definition of global forum shopping: Bookman (n 5) 590.
[20] Bookman (n 5) 585.

4. Can these existing factors be formulated into effective criteria when identifying appropriate instances of forum shopping?

It is useful to briefly elaborate on each of these issues:

1 *Can Forum Shopping be Appropriate in Prescribed Circumstances?*

In order to be able to develop a legal framework to identify when forum shopping can be used appropriately, it must first be asked whether forum shopping can even be an appropriate practice. This is particularly important when considering that the term has been traditionally used to admonish the forum choice of litigants. This thesis will argue that appropriate uses of forum shopping can be identified once it is perceived in a neutral manner by avoiding the traditional bias which characterises the practice as being inherently undesirable. As such, this thesis will approach forum shopping by using rational choice theory as the theoretical framework to perceive the practice as a litigation strategy which can be used properly or abused. With a rational choice approach as the underlying framework, instances when forum shopping are used appropriately or not may then be identified from case law.

In this thesis, it will be considered that an appropriate use of forum shopping occurs when the benefits resulting from the practice outweighs the risks. The measurement used to determine when the risks of forum shopping outweighs the benefits will be when the risks would result in the unjust outcome of the dispute. For instance, if the forum shop would result in the efficient administration of justice or satisfy public interests, then the forum shop would be appropriate. Whereas an example of an inappropriate forum shop is when it is determined that the shop would result in inconvenience to the defendant to the degree that it would produce an unjust outcome. Rational choice theory may also be used here to determine whether the motives of the forum shopper were appropriate or inappropriate by evaluating if the forum choice was prompted by contributing to efficiency or rorting the legal system.

2 *What are the Key Risks and Benefits that Occur from the Use of Forum Shopping?*

If forum shopping can be appropriate, then it becomes necessary to determine the key risks and benefits of the practice in order to assess the difference between appropriate and inappropriate instances of shopping. To identify the risks and benefits, it will be necessary to review the literature and evolution of the practice in the case law between 1940-80. This

analysis will demonstrate that there are divergent views on the effects that forum shopping has on the convenience of the litigants, the efficient administration of justice, whether the shopper's motives are relevant and the impact of the practice on the consistent application of law.

3 *What Factors are Currently Being Used to Determine when Forum Shopping is Appropriate or Inappropriate?*

Criteria to determine when forum shopping is appropriate may be built upon after analysing the existing factors used by the judiciary in recent case law from the 1980s onwards. The factors may be identified by evaluating how the judiciary assess the risks and benefits resulting from instances of forum shopping. From this analysis it becomes clear that there are five factors that the judiciary may consider when determining whether to allow a forum shopping case to proceed. This includes ensuring that jurisdiction is initially met in accordance with the rules outlined by the relevant statute which governs forum choices in the lawsuit. The second factor raised in common law systems is whether the forum choice was convenient for the litigants and witnesses to access the venue under the *forum non conveniens* ('FNC') doctrine. Issues of efficiency in terms of the financial costs incurred by the litigants and the courts may be considered separately or also under the FNC doctrine. Motives may also be relevant if they effect the jurisdiction, convenience or efficiency of the litigants. Finally, there could be policy reasons to allow or prevent the litigation to proceed when considering the importance of the outcome on public interests. These reasons could include facilitating the development of the law or increasing the opportunity for inappropriate forum shopping.

4 *Can the Existing Factors be Formulated into Effective Criteria when Identifying Appropriate Instances of Forum Shopping?*

To test the effectiveness of the five factors that the judiciary currently considers in recent global forum shopping cases, it is useful to apply the factors to a case study. The case study which has been chosen for this thesis is a transnational IP legal dispute between Philip Morris International ('PMI') and Australia over the legitimacy of Plain Packaging legislation. When applying the factors, it becomes clear that they can effectively be used as the basis of the criteria for a legal framework to determine when global forum shopping can be appropriately used in transnational IP litigation. This is because the application of the

factors to the case study can identify an appropriate and inappropriate instance of global forum shopping by PMI as the approach promotes the benefits resulting from forum shopping and mitigates the risks. After testing whether the existing factors can be effective in application, the proposed criteria may be formulated to answer the central research question.

C Scope and Methodology

The scope of this thesis is confined to analysing global forum shopping, primarily focussed upon transnational IP litigation. The thesis will be excluding instances of forum shopping arising from mutually agreed choice of forum and choice of law contract clauses. Instead, unilateral instances of forum shopping will be the focus. This will often mean that the forum shopper is the plaintiff of the litigation however, instances where the defendant may also forum shop will be considered. This thesis will also assume that the laws of the forum will be applied after the forum choice. While this is not always the case, this assumption will simplify analysis and keep the scope narrow so that choice of law issues will not need to be discussed.[21]

The methodology utilised in this thesis will be doctrinal as it is a useful two-step process to locate and then interpret primary legal texts after a review of the secondary sources.[22] The secondary sources have been found primarily through a search of electronic databases with a focus on journal articles. The case law has been identified by concentrating on US and England's jurisdictions as litigants have the longest history of choosing these venues for forum shopping. A doctrinal analysis of the case law is particularly useful to interpret judicial approaches and attitudes towards forum shopping as the term is not always directly referenced. This is because the strategy is typically undertaken pre-litigation. In the cases where there is no direct mention of the practice, this thesis will highlight when the forum shop occurred using rational choice theory assumptions as the theoretical framework to enrich the doctrinal analysis of the case. Finally, the 4th edition of the Australian Guide to Legal Citation will be followed throughout this thesis.[23]

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[21] For a discussion on the intersection between choice of law and choice of forum: Ghei and Parisi (n 4).
[22] Terry Hutchinson and Nigel Duncan, 'Defining and Describing What We Do: Doctrinal Legal Research' (2012) 17 *Deakin Law Review* 83, 101; Terry Hutchinson, *Research and Writing in Law* (Thomson Reuters, 4th ed, 2018) 50.
[23] *Australian Guide to Legal Citation* (Melbourne University Law Review Association, 4th ed, 2018).

D *Chapter Outline*

To identify whether forum shopping can be appropriate, Chapter II will begin by developing rational choice theory as the theoretical framework of this thesis. It will be argued that this theory is useful as it provides the foundation for treating the practice as one litigation strategy among many available to a litigant seeking to maximise their own self-interest in the dispute resolution process.

Chapter II will then examine the key risks and benefits that occur from the use of forum shopping in a review of the literature. This review will reveal two primary perspectives towards forum shopping, a traditional view that sees the practice as a form of cheating compared to the emerging literature which identifies positive aspects of the practice.

To analyse the judicial perspectives of the risks and benefits resulting from forum shopping, Chapter III will evaluate case law between 1940-80 in the US and England.

Chapter IV will concentrate upon case law from 1981 to the present to identify the factors currently being used to determine when global forum shopping is appropriate.

To develop these factors into criteria and test their effectiveness, Chapter V will analyse a case study. The case study will focus on the litigation between multinational tobacco company, PMI and Australia over the legitimacy of Plain Packaging legislation which impacts upon the use of trademarks.

Finally, Chapter VI will address the central research question by recommending the five criteria of jurisdiction rules, convenience, efficiency, motivation and policy. It will be argued how these criteria may be used to determine when global forum shopping is appropriate or not in transnational IP litigation.

II THEORETICAL FRAMEWORK AND LITERATURE REVIEW

The objective of this chapter is to identify rational choice theory as an effective theoretical framework that can analyse whether forum shopping can be appropriate along with synthesising the risks and benefits of the practice from a literature review. Rational choice theory treats forum shopping as a strategy which litigants can use appropriately or inappropriately to increase the probability of achieving their preferred outcome. As a result, it is suggested that rational choice theory can be used in this thesis as a framework to perceive forum shopping as a practice which is not inherently undesirable as it can be used by litigants in appropriate ways. Building upon this framework, appropriate uses of forum shopping in case law may then be identified in the following chapters of this thesis. The second half of this chapter will review the literature on forum shopping in order to identify the risks and benefits caused by the practice. The traditional literature argues that the risks include inconvenience, inefficiency, improper motivations and the inconsistent application of law. In comparison, the emerging literature argues that these risks are overexaggerated and there are benefits which result from forum shopping such as material justice, the efficient administration of justice and the development of law. The analysis undertaken will be used in the following chapters to develop the relevant criteria which should be utilised as an approach to govern forum shopping.

A *Using a Rational Choice Approach to Global Forum Shopping*

Rational choice theory provides a framework to understand forum shopping as a practice that may be used in appropriate and inappropriate ways depending upon the circumstances of the case. This theory is a broad paradigm that came to prominence as part of an economic analysis of all aspects of law in the 1960-70s.[24] Due to the versatility of rational choice, not only has it been a highly popular analytical tool but also highly criticised for being unable to accurately predict human behaviour.[25] As rational choice theory has many variations, this

[24] Siegwart Lindenberg 'Rational Choice Theory' in Jens Beckert and Milan Zafirovski (eds), *International Encyclopedia of Economic Sociology* (2006, Routledge) 550; Alexander Thompson, 'Applying Rational Choice Theory to International Law: The Promise and Pitfalls' (2002) 31 *The Journal of Legal Studies* S285, 287; Richard A Posner, *Economic Analysis of Law* (Apsen Publishers, 8th ed, 2011) 29; Russell B Korobkin and Thomas S Ulen, 'Law and Behavioral Science: Removing the Rationality Assumption from Law and Economics' (2000) 88 *California Law Review* 1051, 1060.

[25] Thompson (n 24) 286. For proponents of rational choice theory, see eg: Posner, *Economic Analysis of Law* (n 24); Richard A Posner, 'Rational Choice, Behavioral Economics, and the Law' (1998) 50 *Stanford Law Review* 1551. For critics of rational choice theory see, eg, Chris Guthrie, 'Prospect Theory, Risk Preference,

thesis will use the basic assumption which forms the foundation of the theory to justify that forum shopping can be an appropriate practice.

The basic assumption of rational choice theory is that humans are rational maximisers of self-interest, with the key components of this assumption including belief, rationality and self-interest.[26] When humans decide among a set of choices, rational choice theory assumes they will choose based upon what they believe will help them achieve their goals.[27] Belief is an important component of this assumption as the decision-making process is almost always undertaken during conditions of uncertainty.[28] As such, the choice of action believed to lead to the desired goal will be calculated based upon the costs that may be incurred, the available information that may be obtained, the probability of achieving the desired outcome, and the decision-maker's preferences and values.[29] Rationality may be defined as an ability to evaluate the consequences of the actions people may undertake. The ability to evaluate these consequences means that a human may choose the best action which may lead to the successful realisation of their goals.[30] However, this evaluation does not occur with perfect omniscience of the situation. As such, the theory allows for the fact that humans have a limited ability to obtain, process and use relevant information when decision-making which is why they act upon their calculation of beliefs.[31] It is also important to note that self-interest is not synonymous with selfishness because self-interest is motivated by the preferences, emotions and values of the individual.[32] A useful example by Posner illustrates that self-interest can include the desire for happiness or misery in others.[33]

Bassett applies rational choice theory to the decision-making process involved when forum shopping to support the notion that the practice can be used appropriately because it is a

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and the Law' (2003) 97(3) *Northwestern University Law Review* 1115; Korbokin and Ulen (n 24); Christine Jolls, Cass R Sunstein and Richard Thaler, 'A Behavioral Approach to Law and Economics' (1998) 50 *Stanford Law Review* 1471.

[26] Posner, *Economic Analysis of Law* (n 24) 3-4.

[27] Lindenberg (n 24) 550.

[28] Richard A Posner, 'The Economic Approach to Law' (1975) 53 *Texas Law Review* 757, 761; Posner, *Economic Analysis of Law* (n 24) 4; Guthrie (n 25) 1115; Ghei & Parisi (n 4) 1376.

[29] Richard Warner, 'Impossible Comparisons and Rational Choice Theory' (1995) 68 *Southern California Law Review* 1705, 1710-1; Posner, *Economic Analysis of Law* (n 24) 4; Posner, 'Rational Choice, Behavioral Economics, and the Law' (n 25) 1553-4; Lindenberg (n 24) 551-2; Ghei and Parisi (n 4) 1376-9.

[30] Lindenberg (n 24) 550.

[31] Posner, *Economic Analysis of Law* (n 24) 4; Lindenberg (n 24) 552; Bassett (n 3) 378; Robert O Keohane, 'Rational Choice Theory and International Law: Insights and Limitations' (2002) 31 *The Journal of Legal Studies* S307, 308.

[32] Posner, *Economic Analysis of Law* (n 24) 4; Posner, 'Rational Choice, Behavioral Economics, and the Law' (n 25) 1553-4; Keohane (n 31) 309.

[33] Posner, *Economic Analysis of Law* (n 24) 4.

rational act for the litigants to strategically calculate the expected payoffs of the available choices.[34] The parties involved who can make choices of forum include the plaintiff, defendant, legal counsel and sometimes the judge.[35] Legal counsel adds another dimension to the decision-making process as they provide the advice for the choice of forum to their clients. As they are generally not as emotionally attached to the issue, the rational lawyer may be more willing to push for a risky choice in return for a higher payoff than the client.[36] They are also a factor in the amount of information conveyed and available for the client's choice. There are two primary strategic choices to make, the first is to choose a forum with the most favourable substantive and/or procedural laws but fewer connections to the claim. The second choice is a forum appearing to have more connections to the claim but less favourable substantive and/or procedural laws.[37] The expected payoff in the first choice is normally strategically better for the plaintiff, while the second is better for the defendant. As such, after considering the probability and risk of achieving a successful outcome, the rational actor would choose the forum with the highest expected payoff.[38]

Other forum shopping literature also evaluates forum shopping through the lens of rational choice to argue that forum shopping can be an appropriate practice.[39] The underlying treatment by this group of literature perceives forum shopping as 'a matter neither for surprise nor for indignation.'[40] According to Busch, the use of rational choice by decision-makers is implicit and treats the practice as a key part of litigation strategy.[41] In comparison, Whytock explicitly bases his analysis through a rational choice perspective by considering forum shopping to be strategic behaviour which is influenced by the decision-maker's preferences and expectations of the behaviour of other decision-makers.[42] Overall, Whytock advocates for laws which balances access to justice with the economic costs of litigation when regulating choice of forum.[43] Childress III's article expands on Whytock's financial considerations by committing to a holistic economic approach to law as he compares the

[34] Bassett (n 3) 373.
[35] Ibid 379.
[36] Ibid 382.
[37] Ibid 380.
[38] Warner (n 29) 1711.
[39] Busch (n 4); Whytock (n 4); Childress III (n 4). Compare to Ghei & Parisi (n 4) who see forum shopping as a rational choice that has the risks of inefficiency and manipulation of outcomes but also argue that these risks can be exaggerated: at 1369.
[40] *The Atlantic Star* [1974] AC 436, 471 (Lord Simon) ('*The Atlantic Star House of Lords Decision*').
[41] Busch (n 4) 735-6.
[42] Whytock (n 4) 487.
[43] Ibid 534.

pursuit of forums for the desired legal remedies as a transnational law market.[44] In this context, Childress III considers the cost-benefit payoff of a rational litigant who would only shop among various forums for a favourable outcome as long as the costs available to the litigant supported the choice.[45]

This thesis will use rational choice theory as a restricted analytical tool of forum shopping to mitigate the limitation of the theory. Scholars such as behavioural economists argue that the primary issue with the theory is that it cannot accurately predict human behaviour because there are systematic instances where actors do not behave rationally.[46] As such, this thesis will not use rational choice theory in a predictive or normative way.[47] By removing this predictive limitation, the theory's core assumptions can be usefully applied retrospectively to a decision-maker's choice to determine whether this choice was rational. In determining whether the litigant's forum choice was rational, the thesis argument that forum shopping is merely a litigation strategy and is not a purely 'evil' practice will be sustained. This approach of the theory is a 'thin' positivist version which merely identifies rational behaviour rather than attempting to predict the means a decision-maker would undertake to achieve their goals.[48] Game theory is the other primary theory which may be used to explain forum shopping.[49] As game theory has a more nuanced ability to accurately predict human behaviour, it could be possible to apply game theory as an alternative to the 'thin' positivist version of rational choice theory.[50] Game theory has also previously been used by scholars to enrich rational choice theory and mitigate it's limitations.[51] However, using game theory is beyond the scope of the central research question of this thesis which concentrates upon the circumstances for the appropriate use of forum shopping. Game theory would be more suitably applied to forum shopping during discussions of predicting the motivations of litigants who seek to engage in the practice. In summary, to support the argument that forum shopping can be an appropriate practice, the core assumptions of rational choice theory will form the frame through which the practice will be interpreted.

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[44] Childress III (n 4) 1008.
[45] Ibid 996.
[46] See, eg, Guthrie (n 25); Korobkin and Ulen (n 24); Jolls, Sunstein and Thaler (n 25).
[47] Korobkin and Ulen (n 24) 1061; Posner, *Economic Analysis of Law* (n 24) 31.
[48] The 'thin' positivist approach has a broad, nearly irrefutable application because the observation of behaviour may be justified as being rational as long as the action is determined to be contributing towards the decision-maker's goal: Korobkin and Ulen (n 24) 1060-2. Compare with 'thicker' versions of the theory such as expected utility which seeks to specify the means a decision-maker undertakes in attempts to satisfy their goal: Korobkin and Ulen (n 24) 1062; Warner (n 29) 1715.
[49] Bassett (n 3) 378.
[50] Posner, *Economic Analysis of Law* (n 24) 24; Bassett (n 3) 379.
[51] Posner, *Economic Analysis of Law* (n 24) 24-5.

When evaluating case law, the theory will be utilised as an analytical tool to identify instances of rational forum choice.

B *A Review of the Traditional and Emerging Perspectives Towards Forum Shopping*

This review will commence by analysing the perceived risks and benefits caused by forum shopping. In the process, two major scholarly perspectives will be identified – the traditional perspective which is critical of forum shopping and the emerging perspective which considers the positive effects the practice can have on the legal system. The review will then situate why transnational IP litigation provides so many opportunities for forum shopping due to the regime complex governance system. Finally, the gap in the literature will be delineated in order to establish the significance of this research.

Considering the historically pejorative use of forum shopping discussed in Chapter I, it is unsurprising there is debate over whether forum shopping is appropriate. The debate in the literature is between the traditional perspective, which argues that forum shopping is inherently undesirable, and the emerging perspective, which examines the benefits of the practice. Domestic forum shopping is the centre of the most vitriolic assessments. This viewpoint primarily originates with the US judiciary and politicians[52] which characterise forum shopping as cheating, unethical, unprofessional, nasty and dirty.[53] It is reflected in the literature of the 1990s where scholars used forum shopping with the presumption that it leads to unjust outcomes and inconvenience.[54] Opeskin and Juenger provides the seminal scholarly context to the debate between the traditional and emerging perspectives of forum shopping.[55] Opeskin's traditional argument substantiates the reason why forum shopping is objectionable as it introduces uncertainty in the application of the rule of law and thereby impinges on human dignity.[56] Opeskin's article is particularly valuable as critics rarely elaborate on why forum shopping is undesirable.[57] In comparison, Juenger is a major proponent for the positive effects of forum shopping on material justice in the legal system

[52] Bassett (n 3) 336-7; Maloy (n 3) 26-7.
[53] Bassett (n 3) 336; Juenger 'Forum Shopping, Domestic and International' (n 3) 553; Koch (n 3) 294; Maloy (n 3) 25-6.
[54] Clermont and Eisenberg (n 2) 1507, 1515; Silberman (n 3) 528-30; Elhauge (n 3) 2259; Cameron Moore, 'Our Fragmented Federation: Forum Bias and Forum Shopping in Australia' (1994) 22 *Federal Law Review* 171, 171.
[55] Brian R Opeskin, 'The Price of Forum Shopping: A Reply to Professor Juenger' (1994) 16 *Sydney Law Review* 14; Juenger 'What's Wrong with Forum Shopping?' (n 5).
[56] Opeskin (n 55) 15-20.
[57] Bookman (n 5) 594; Petsch (n 13) 1008; Maloy (n 3) 25.

and represents the start of the emerging literature which treats forum shopping in a more positive manner.[58] He also considers the professional duties of legal practitioners towards their clients is to select a favourable forum and that forum shopping should be promoted by courts in appropriate instances to enable legal practitioners to carry out their duties.[59]

Around the beginning of the twenty-first century, there was a shift in analysis towards global forum shopping as globalisation increased. This trend corresponds with an increase in literature concentrating upon the benefits of forum shopping. For instance, Bookman's article is one of the most extensive pieces of literature that focuses upon the positive effects of forum shopping. Bookman considers global forum shopping to have more positive effects than the domestic practice.[60] Similarly, Helfer argues that if forum shopping among the international human rights petition systems were 'properly regulated, [it] can materially benefit international human rights law.'[61] Petsche argues that unlike domestic forum shopping, the global type of the practice does not cause as much unfairness or inconsistent application of law as traditionally argued.[62]

In proposing that forum shopping has benefits on the legal system, the emerging perspective's literature have raised counter-arguments to the perceived major risks resulting from forum shopping. These risks are that forum shopping produces inconvenience, inefficiency and improper motives which creates an unfair advantage for the shopper against the other litigant.[63] It is this supposed unfair advantage which suggests that the legal system can be manipulated with the fear that the public would lose confidence in the objectivity of the court.[64] The emerging literature has addressed these risks by arguing that they are minimal issues or are being minimised by existing counter-balances in the legal system.[65] For example, defendants have the option to challenge the venue choice as being

[58] Juenger 'What's Wrong with Forum Shopping?' (n 5).
[59] Bassett (n 3) 371-2; Juenger 'Forum Shopping, Domestic and International' (n 3) 572. See also Koch (n 3) 294-5; Maloy (n 3) 5, 60-1; Algero (n 2) 105-8.
[60] Bookman (n 5) 583-5.
[61] Laurence R Helfer, 'Forum Shopping for Human Rights' (1999) 148(2) *University of Pennsylvania Law Review* 285, 292.
[62] Petsche (n 13) 1018-9.
[63] J Jonas Anderson, 'Court Competition for Patent Cases' (2015) 163(3) *University of Pennsylvania Law Review* 631, 645; Petsche (n 13) 1010; Maloy (n 3) 28; Ghei and Parisi (n 4) 1380-1.
[64] Multiple emerging perspective scholars raise this as a common concern of critics. The emerging perspective scholars argue that it is a myth that forum shopping undermines fairness because the reality of the legal system is complicated: 'Forum Shopping Reconsidered' (n 2) 1687; Clermont and Eisenberg (n 2) 1508, 1516; Maloy (n 3) 28; Bassett (n 3) 591.
[65] Bassett (n 3) 384-391; Whytock (n 4) 532; Petsche (n 13) 1026-7; Ghei and Parisi (n 4) 1369.

inappropriate as it creates an intolerable level of inconvenience under the FNC doctrine.[66] Meanwhile, other scholars have analysed the motives of litigants to forum shop and argue that just because these motives are strategic does not mean that they are also improper.[67] For instance, it has been assumed that forum shopping is motivated by seeking advantageous substantive and procedural laws.[68] However, forum shoppers can also be motivated by efficiency which can benefit the legal system by increasing the efficient administration of justice.[69] Additionally, other scholars have built upon Juenger by arguing that forum shopping has multiple beneficial effects on the legal system. This may be seen in the way that forum shopping can force the development of aspects of the law. For example, French principles on contract damages were introduced to English courts through forum shopping.[70]

There is ample opportunity for global forum shopping in transnational IP litigation as the governance system is a regime complex which facilitates increased choice of law and venue. Regime complexes refers to a term developed by Raustiala and Victor to describe the post-war international IP governance system. They define regime complexes as 'an array of partially overlapping and non-hierarchical institutions governing a particular issue-area.'[71] The IP regime complex is fragmented and overlaps with other regimes, including trade and public health. As a result, the choice of forum may be motivated by seeking a venue sympathetic to trade over public health policy considerations (or vice versa) when interpreting IP laws.[72] Forum shopping opportunities for IP disputes occur due to the increase of choices of law and procedure that result from this fragmentation.[73]

[66] Whytock (n 4) 532; Ronald A Brand, 'Comparative Forum Non Conveniens and the Hague Convention on Jurisdiction and Judgments' (2002) 37 *Texas International Law Journal* 467, 467.
[67] For eg, Bassett (n 3) 336-42; Bookman (n 5) 589-90.
[68] Anderson (n 63) 640; Maloy (n 3) 44-8.
[69] Bookman (n 5) 603-14. See a more detailed discussion in Chapter IV(D).
[70] Bookman (n 5) 618.
[71] Kal Raustiala and David G Victor, 'The Regime Complex for Plant Genetic Resources' (2004) 58(2) *International Organization* 277, 279. For further discussion of the evolution of the definition and use of the term 'regime complex', see: Amandine Orsini, Jean-Frederic Morin and Oran Young, 'Regime Complexes: A Buzz, a Boom, or a Boost for Global Governance' (2013) 19 *Global Governance* 27; Karen J Alter and Sophie Meunier, 'The Politics of International Regime Complexity' (2009) 7(1) *Perspectives on Politics* 13.
[72] See below at Chapter V(A) as an example.
[73] Raustiala and Victor (n 71) 300-1; Jonathan Kuyper, 'Deliberative Capacity in the Intellectual Property Rights Regime Complex' (2015) 9(3) *Critical Policy Studies* 1, 4; Alter and Meunier (n 68) 16-7; Karen J Alter and Kal Raustiala, 'The Rise of International Regime Complexity' (2018) 14(1) *Annual Review of Law and Social Science* 329, 341.

C Gaps in Scholarly Literature and Significance of Present Research

The present research seeks to concentrate on forum shopping in transnational IP litigation as there is a lack of literature on this specific topic. This is because scholarship which examines global forum shopping tends to concentrate on regimes such as trade or contract law rather than IP.[74] The focus of forum shopping in IP law concentrates on states engaging in the practice as a strategy during the treaty making process rather than a strategy utilised in litigation.[75] This gap has likely arisen as IP law is generally restricted by territoriality, giving rise to litigation across numerous jurisdictions in order to enforce IP rights internationally.[76] However, the gap should be researched because a territoriality-based IP legal system facilitates opportunities for forum shopping.

The present thesis will use the existing scholarship on forum shopping in other fields and apply it to IP litigation in order to address the gap in the literature. As part of this process, the primary risks and benefits of forum shopping discussed in the literature will be used to establish which criteria may be relevant to determinations of when global forum shopping may be appropriate in transnational IP litigation. The criteria may then contribute to developments in the governance of forum shopping as the criteria can be utilised by the judiciary in global forum shopping litigation, by policy makers when creating new legislation that impacts forum choices, by legal representatives when providing advice on which venue their client should choose and by academia when expanding upon this field.

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[74] For trade see, eg, Busch (n 4). For human rights see, eg, Helfer, 'Forum Shopping for Human Rights' (n 61). For contracts law see, eg, Franco Ferrari, "Forum Shopping' Despite International Uniform Contract Law Conventions' (2002) 51 *International and Comparative Law Quarterly* 689. For the environmental regime see, eg, Alexander Gillespie, 'Forum Shopping in International Environmental Law: The IWC, CITES, and the Management of Cetaceans' (2002) 33(1) *Ocean Development & International Law* 17.

[75] When discussing the use of the strategy to influence the treaty making process, the term often used is regime shifting or forum shifting in place of forum shopping. However, these terms have also been used synonymously by scholars. The term used appears to depend upon which term is preferred by the scholar: Peter K Yu, 'International Enclosure, the Regime Complex, and Intellectual Property Schizophrenia' [2007] Spring *Michigan State International Law Review* 1, 15. For an example of forum shopping used as a synonym for regime shifting see, eg, Dirk De Bièvre and Lars Thomann, 'Forum Shopping in the Global Intellectual Property Rights Regime' (Working Paper No 132, The Mannheim Centre for European Social Research, University of Mannheim, 2010). For uses of regime shifting see, eg, Laurence R Helfer, 'Regime Shifting: The TRIPs Agreement and New Dynamics of International Intellectual Property Lawmaking' (2004) 29(1) *The Yale Journal of International Law* 1 ('Regime Shifting'). For uses of forum shifting see, eg, Susan K Sell, 'TRIPS Was Never Enough: Vertical Forum Shifting, FTAS, ACTA, and TPP' (2011) 18 *Journal of Intellectual Property Law* 447; Drahos and Braithwaite (n 17) 564-71; Monique Mann, Ian Warren and Sally Kennedy, 'The Legal Geographies of Transnational Cyber-prosecutions: Extradition, Human Rights and Forum Shifting' (2018) 19(2) *Global Crime* 107.

[76] Kimberlee Weatherall, 'Can Substantive Law Harmonisation and Technology Fix Conflicts Problems?' (2006) 11 *Media and Arts Law Review* 393, 393.

In summary, forum shopping was traditionally presumed to be an undesirable practice as it was considered to impede efficiency and the consistent application of law. However, an emerging group of scholars argue that in appropriate circumstances forum shopping is a rational litigation strategy which could have positive benefits on the legal system. As the governance system of international IP law may be characterised as a regime complex, there are many opportunities for transnational litigants to forum shop. There is a gap within the literature on forum shopping within transnational IP litigation. An expansion in this field is necessary as recommendations of criteria to determine when global forum shopping is appropriate can improve the way that the practice is governed to promote the efficient and fair administration of justice instead of restricting the use of the practice altogether.

III IDENTIFYING FORUM SHOPPING IN THE CASE LAW BETWEEN 1940-80

To address the central research question of which criteria should be used to determine appropriate global forum shopping in transnational IP litigation, it is useful to examine the evolution of the practice by evaluating the case law between 1940-80 in the US and England. The purpose of this chapter is to identify instances when forum shopping was found appropriate by analysing the judiciary's considerations of the risks and benefits of the practice. This analysis extends the review of literature in Chapter II by evaluating some of the primary sources which have informed the traditional and emerging perspectives on forum shopping. The risks and benefits considered within the case law to determine appropriate uses of forum shopping include questions of whether relevant statute allows the practice, whether it would result in the consistent application of the law, would inconvenience occur and, would it result in a fair and just outcome. This will provide background for a more precise analysis in the following chapters of the factors that the judiciary use in recent case law in determining when global forum shopping may be considered appropriate.

A *First Cases of Forum Shopping in US Domestic Case Law*

The first two cases which explicitly refer to forum shopping in the US are *Miles v Illinois Central Railroad Co* ('*Miles*')[77] and *Covey Gas & Oil Co v Checketts* ('*Covey Gas*').[78] These cases demonstrate that the practice is not inherently undesirable as the judiciary identifies different instances for when it is appropriate or inappropriate to forum shop based upon the risks and benefits that may result from the practice. The practice may be appropriate when statute allows choice of forum for the purpose of facilitating the benefits that can arise from forum shopping such as ensuring access to justice. In comparison, it may be inappropriate when using forum shopping for successive litigation of the same set of facts as it risks the inconsistent application of law and wastes court resources. Also, when assessing whether the forum shop should be allowed, it is implied that the judiciary must consider the facts and effects that would result from forum shopping rather than just the motivations of the shopper.

[77] 315 US 698 (1942) ('*Miles*').
[78] 187 F 2d 561 (9th Cir, 1951) ('*Covey Gas*').

The 1942 case *Miles* was the first time the judiciary had explicitly used the term 'forum shopping' and also demonstrated that the practice can be appropriate when statute allows a choice of forum.[79] In this case, the plaintiff's husband was killed in an accident in Tennessee while working for his employer and the defendant, Illinois Railroad. The plaintiff forum shopped by suing Illinois Railroad in a Missouri Federal Court.[80] The Court allowed the suit to proceed in the Missouri Federal Court. Justice Jackson explicitly refers to forum shopping, stating that 'the judiciary has never favoured this sort of shopping for a forum.'[81] However, the use of 'this sort of shopping' suggests that there are types of shopping which may be acceptable. Justice Jackson concludes that even though forum shopping is undesirable in general, in this case the relevant statute allowed the plaintiff to choose their own forum.[82] The statute allows choice of forum for reasons of fairness, to provide the worker with greater leverage against their more powerful employer when seeking compensation.[83] As a result, the type of forum shop in this case was deemed to be appropriate as it would provide the plaintiff with the benefit of access to justice. In comparison, Justice Jackson states that successive lawsuits lodged after receiving a result in a different court would be inappropriate forum shopping, not intended by the statute.[84] The logic behind this reasoning is that such litigation would risk the inconsistent application of the rule of law, undermine the power of the courts to make final, enforceable decisions and waste court resources determining litigation which had already been decided.[85] *Miles* demonstrates that forum shopping can be appropriate after determining that the benefit of the statute allowing for access to justice outweighs any risk of waste or inconsistent application of law.

The 1951 *Covey Gas* case was an instance of inappropriate forum shopping due to the risks resulting from a combination of successive litigation and improper motives.[86] The plaintiffs initially sued the defendant in an Idaho State Court for the negligent driving of their worker which caused the death of the plaintiffs' 8-year-old son. Upon appeal, the damages awarded to the plaintiffs were considered excessive. As a result, the plaintiffs began a new suit and forum shopped to an Idaho Federal Court.[87] In this case, the defendants appealed the

[79] *Miles* (n 77).
[80] Ibid 699-701.
[81] Ibid 706.
[82] Ibid 703-4, 707.
[83] Ibid 707.
[84] Ibid.
[85] See also Ryan (n 16) 185-190; Maloy (n 3) 44; Helfer, 'Forum Shopping for Human Rights' (n 61) 290.
[86] *Covey Gas* (n 78).
[87] Ibid 562.

damages awarded to the plaintiffs again and the award was reduced.[88] The forum shopping was found to be inappropriate in this case due to improper motivations of the shopper and the successive litigation instigated by the plaintiffs. However, improper motives alone are insufficient to condemn forum shopping as an inappropriate practice. This is because the determination of motives to forum shop is dependent upon the subjective perception of the judiciary, making it difficult to distinguish between motives which are simply a rational, strategic choice and motives which illegitimately rort the legal system.[89] This subjectivity is evident when Chief Judge Denman implies that the reason why forum shopping is inappropriate is because the motivation behind the plaintiffs' forum choice was 'apparently seeking the decision of a judge who would sustain a larger award than the state judge.'[90] The use of the word 'apparently' demonstrates the subjective reasoning involved and supports why motivation alone should not be the only criteria to determine when forum shopping is inappropriate.[91] This argument is supported by the judgment of the case as the history of the plaintiffs' forum shopping was also considered. The plaintiffs had already sued the defendants in a state court and received a lower damages award. Due to this history, the judges sought to avoid the waste of resources resulting from successive litigation and upheld the award given by the Idaho state's Supreme Court.[92] As such, considerations of motivations may be used to support evidence of the actual risks that would result from successive litigation when considering whether the shop was appropriate or not.

Miles confirms that forum shopping can be an appropriate practice.[93] This case, along with *Covey Gas*,[94] also reveals three considerations of the risks and benefits of forum shopping when determining whether the practice is appropriately used. The first is that statute can sanction appropriate forum shopping for reasons such as access to justice. Successive litigation is inappropriate as it risks the waste of court resources and inconsistent application of law. Finally, motivations alone are not enough justification when considering the appropriate use of forum shopping, the risks and benefits that may result must also be evaluated.

[88] Ibid 563.
[89] Bookman (n 5) 580; Bassett (n 3) 336; Whytock (n 4) 488.
[90] *Covey Gas* (n 78) 563.
[91] Bookman (n 5) 590; Thompson (n 24) 303.
[92] *Covey Gas* (n 78) 563.
[93] *Miles* (n 77).
[94] *Covey Gas* (n 78).

B *England's First Global Forum Shopping Case Law*

While the early cases of forum shopping in the US were domestic, in England the use of forum shopping was global. In 1971, the use of the term 'forum shopping' appeared in the transnational case of *Chaplin v Boys*.[95] Perhaps due to the global nature of forum shopping in England, the judicial attitudes towards forum shopping were mixed between the traditional view that it was an undesirable practice and a view that it was appropriate as part of a rational strategic choice of the litigant's strategy. These divergent views are evident within *The Atlantic Star* Court of Appeal[96] and House of Lords[97] cases in 1973-4. Due to the divergent views represented among the judiciary, the risks and benefits of the practice were considered. These considerations include determinations of the 'natural' forum, the consistent application of law, inconvenience, justice and fairness.

The judgment in *Chaplin v Boys* discusses the risks caused by forum shopping as being against public policy as it causes litigants to by-pass their 'natural' forum, creating an unfair advantage. In this case, both parties were English citizens stationed in Malta as part of the Air Forces. During this time, Boys was injured in a road accident caused by the admitted negligence of Chaplin.[98] Boys sued Chaplin in an English court and the issue the judges sought to decide was whether to remove the advantage Boys would receive in damages by choosing an English court by applying Maltese instead of English laws.[99] Lord Pearson argues that there is danger in allowing forum shopping because 'a plaintiff by-passing his natural forum and bringing his action to some alien forum … would give him relief or benefits which would not be available to him in his natural forum.'[100] It is unclear what Lord Pearson means by 'natural' and 'alien' forums. 'Natural' could refer to an appropriate forum (such as the forum where the harm occurred or the litigants' domicile) and 'alien' could mean an inappropriate forum. Or 'natural' could refer to citizens, where 'alien' could refer to foreigners accessing the English courts. In either case, this quote demonstrates how Lord Pearson considers that forum shopping promotes the risk of an unfair advantage for the shopper. Ironically, even though the judges expressed their disapproval of forum shopping,

[95] *Chaplin v Boys* (n 18).
[96] *The Atlantic Star* [1973] 1 QB 364 ('*The Atlantic Star Court of Appeal Decision*').
[97] *The Atlantic Star House of Lords Decision* (n 40).
[98] *Chaplin v Boys* (n 18) 356.
[99] Ibid 356.
[100] Ibid 401.

the court held that English damages apply, allowing the forum shop.[101] The judges had slightly different reasoning to reach this decision but Lord Hodson's reasons are particularly interesting. He considers that the policy reasons are against foreigner's forum shopping due to the risks of unfairness but because the parties are both English citizens, there are no policy reasons to reject the case.[102] This supports this chapter's argument that forum shopping can be allowed when considering whether any adverse risks would occur when applied to the circumstances of the case. As such, forum shopping can be an appropriate practice.

The judgments in *The Atlantic Star* Court of Appeal and House of Lords cases elaborate upon the risks and benefits which forum shopping can prompt.[103] These include the inconsistent application of law, inconvenience and justice. The facts of this case occurred in Belgium 1970 when a Dutch container vessel, *Atlantic Star*, collided with two barges when attempting to dock in dense fog. One barge was Belgian and the other Dutch. Both barges were sunk in the collision.[104] The owners of the Belgian barge started proceedings in the Dutch court in Antwerp while the owners of the Dutch barge started a suit in England by serving the writ to the *Atlantic Star* while it was docked in an English port.[105] However, concerned by the lengthy time the English court was taking to resolve the litigation, the Dutch barge owners also lodged a suit in Antwerp before the statute of limitations barred them from pursuing litigation there.[106] England's Court of Appeal upheld the trial judge's decision, allowing the forum shop and the suit to continue in England.[107] This decision was reversed in the House of Lords and proceedings in England were dismissed.[108] The judgments in the Court of Appeal and the dissenting judgments in the House of Lords all consider forum shopping in a positive manner. They considered the choice of forum of the plaintiff to be a rational choice made in the course of the litigant's strategy and that the risks of forum shopping were not severe enough to prevent a just outcome in England. Interestingly, in the Court of Appeal Lord Phillimore allowed the forum shop to proceed even though he expressed concerns that the risks of forum shopping could produce the unfair and inconsistent application of law.[109] The House of Lords majority judgment agreed with

[101] Ibid 356-7.
[102] Ibid 378.
[103] *The Atlantic Star House of Lords Decision* (n 40) 439.
[104] Ibid 439.
[105] Ibid 440.
[106] Ibid 440.
[107] *The Atlantic Star Court of Appeal Decision* (n 96) 365.
[108] *The Atlantic Star House of Lords Decision* (n 40) 437.
[109] *The Atlantic Star Court of Appeal Decision* (n 96) 385-387.

the risks outlined by Lord Phillimore and dismissed the proceedings as they characterised forum shopping as an inappropriate practice that only produced risks of the unfair and inconsistent application of law.[110]

The judges who view forum shopping as a practice which can have beneficial effects on the legal system conceptualise the practice as a rational choice strategy. This is evident in Lord Denning's tongue-in-cheek metaphor when he states that 'he can seek the aid of our courts if he desires to do so. You may call this "forum shopping" if you please, but if the forum is England, it is a good place to shop in, both for the quality of goods and the speed of service.'[111] In this quote, Lord Denning equates litigation to a transnational market, a place where you can 'shop around' for in demand goods and service.[112] By expressing the metaphor with a light-hearted tone, Lord Denning's economic analysis of forum shopping implies an attempt to subvert the negative connotation associated within the term 'shopping.' The quote supports that the benefits of forum shopping are in creating a competitive transnational market which can generate a robust economy in the jurisdiction that supplies an effective litigation service.[113] In comparison, Lord Morris avoids the use of 'forum shopping' altogether even as he conceptualises the practice as a rational choice. He states, 'it is natural and inevitable that the plaintiff will choose the place where he considers his legitimate interests will be best advanced.'[114] Lord Morris' reference to the choice of forum being based upon the maximisation of the litigant's goals demonstrates similarities with the theory of rational choice.[115] Finally, Lord Simon is the most direct in his attempt to justify the use of forum shopping as being rational in the statement:

> 'Forum shopping' is a dirty word; but it is only a pejorative way of saying that, if you offer a plaintiff a choice of jurisdiction, he will naturally choose the one in which he thinks his case can be most favourably presented: this should be a matter neither for surprise nor for indignation.[116]

The Atlantic Star cases also discuss the risks of the consistent application of law and inconvenience which are the two primary effects that are used to support the perspective that

[110] *The Atlantic Star House of Lords Decision* (n 40) 454.
[111] *The Atlantic Star Court of Appeal Decision* (n 96) 382.
[112] Childress III (n 4) 1008.
[113] Ibid 1008-1010; Anderson (n 63) 664-6.
[114] *The Atlantic Star House of Lords Decision* (n 40) 461.
[115] Refer above to Chapter II(A) for details.
[116] *The Atlantic Star House of Lords Decision* (n 40) 471.

forum shopping produces potentially unfair and unjust outcomes.[117] The judges who supported the forum shop assessed these risks on a scale of whether these effects would be unfair or unjust for the defendant to the extent that the case should be dismissed. Normally this risk is discussed in hypothetical terms – that the application of law could become inconsistent if a similar factual scenario in the future produces different outcomes in a different forum.[118] However, the facts of this case make the inconsistent application of law an actual concern as the circumstances of the case involve two types of simultaneous litigation. The first type of simultaneous litigation occurred as the Belgian barge were having ongoing proceedings against the *Atlantic Star* in the Antwerp court.[119] The second type of simultaneous litigation occurred as the plaintiff lodged another suit in the Antwerp court so that the statute of limitations did not bar them from an alternative litigation option if the English courts decided to dismiss the case.[120] This meant that regardless of the outcome of the case in England, there would be another court making decisions on the same factual scenario that could produce a different outcome. In the Court of Appeal case, the inconsistent application of law was Lord Phillimore's primary reservation against forum shopping.[121] In comparison, Lord Denning argued that the possibility of different results in different countries was not enough to consider the forum shop vexatious or oppressive for the defendant.[122] He used the same line of reasoning to argue that the inconvenience to the defendant did not justify dismissal.[123] In the House of Lords dissenting judgments, Lord Morris and Lord Simon framed their argument with similar terminology by considering whether allowing the forum shop would prevent justice from occurring. Lord Morris argued that the risk of inconsistent application of law is irrelevant because courts are meant to do justice in accordance with the law, regardless of whether the laws are different.[124] As such, even if the outcome is different, it does not mean that injustice occurred in either court. Lord Simon asserts that while forum shopping may be inconvenient to some defendants, the legal system can still be 'an instrument of justice.'[125]

[117] Opeskin (n 55) 15-16; Ghei and Parisi (n 4) 1369; Anderson (n 63) 645.
[118] Opeskin (n 55) 17-8; Juenger, 'What's Wrong with Forum Shopping?' (n 5) 6-7; Petsche (n 13) 1017.
[119] *The Atlantic Star House of Lords Decision* (n 40) 439-440.
[120] Ibid 440.
[121] *The Atlantic Star Court of Appeal Decision* (n 96) 387.
[122] Ibid 382, 385.
[123] Ibid 381, 384.
[124] *The Atlantic Star House of Lords Decision* (n 40) 461.
[125] Ibid 473.

The four cases analysed within this chapter reveal the risks and benefits which may result from forum shopping, such as the inconsistent application of law and access to justice. So, while the use of forum shopping as a pejorative term is prevalent within the case law between 1940-80, there are perspectives that consider the benefits of forum shopping. This chapter has also shown instances where the judiciary have identified appropriate uses of forum shopping. This was assessed by determining that the benefits resulting from the forum shop outweighed any risks or that any risk would not cause an unjust outcome. Like any strategy chosen by rational litigants, forum shopping can be used in appropriate or inappropriate ways, depending upon the circumstances of the case.

IV Approaches to Global Forum Shopping in Case Law From 1981 to the Present

By extending the analysis of the early case law in Chapter III, the present chapter will consider the factors which the judiciary have used in recent cases to identify when global forum shopping should be permitted. It will be argued that these factors may be synthesised to form the criteria used to determine when forum shopping is appropriate or not in particular transnational IP litigation. These factors include rules of jurisdiction which control the amount of forum choice available to the litigants, tests such as the FNC doctrine to measure when the forum choice is intolerably inconvenient to the defendant, the practice's facilitation of the efficient administration of justice in comparison to the production of waste and the rational choice motivations to forum shop. In combination with these factors, fairness and justice may be used by the judiciary to measure the threshold between inappropriate and appropriate forum shopping. While some of the cases analysed in this chapter are not transnational IP litigation, they have been selected as they are seminal examples that provide insight into how the judiciary currently treats forum shopping.

A *Divergent Jurisdiction Rules for Forum Choices*

Legislation on jurisdiction controls forum choices which can enable or limit global forum shopping.[126] These requirements differ depending upon the rationale behind the domestic legislation of the nation-states in which the parties litigate. Regardless of how strict the limitations are, jurisdiction rules allow some degree of forum choice which provides space for permitted forum shopping. This section will examine two divergent examples of jurisdiction rules relating to transnational IP litigation to demonstrate how these laws can influence the amount of global forum shopping within a nation-state. The first example will examine the US personal jurisdiction and venue statute for patent litigation cases as they are interpreted so broadly that litigants can potentially choose up to 94 Federal District Courts to enforce their patent rights.[127] In comparison, the European Union Council Regulation (EC) No 6/2002 on Community Design rights ('EU Community Design Regulation') promotes the principle of the consistent application of law across EU Member States during

[126] Childress III (n 4) 1010.
[127] Brian L Frye and Christopher J Ryan, Jr 'Fixing Forum Selling' (2016) 25 *University of Miami Business Law Review* 1, 3; Anderson (n 63) 632.

transnational litigation.[128] This allows for some forum choice but is much more restrictive than the US patent jurisdiction rules.

The broad interpretation of personal jurisdiction and venue statute for patent litigation in the US has increased the forum choices available to litigants due to the benefits of court competition. This has created incentives for plaintiffs to forum shop to venues with attractive local procedural rules such as the District Court for the Eastern District of Texas. This court has a reputation for attracting patent litigants. In 2016, 44% of patent infringement actions filed in the US were lodged in the Eastern District of Texas.[129] This opportunity for plaintiffs has arisen due to the way that personal jurisdiction and patent venue statute is interpreted. Personal jurisdiction is established if the defendant has minimum contacts with the forum state.[130] As patent parties are generally corporations, minimum contacts are formed if the defendant sells their products in the forum state.[131] For multinational corporations who sell their products throughout the US, personal jurisdiction can be easy to establish in many of the federal district courts.[132]

After personal jurisdiction is established, the patent venue statute is the primary requirement which controls the level of plaintiff forum choice.[133] Since 1990, the interpretation has been broad, allowing greater choice and opportunity for successful forum shopping.[134] The patent venue statute states that 'any civil action for patent infringement may be brought in the judicial district where the defendant resides...'[135] The word 'reside' has been interpreted to mean wherever personal jurisdiction has been established.[136] It is this broad interpretation which has provided plaintiffs high opportunities to forum shop. There have been some attempts by the US Congress to restrict incentives to forum shop due to the view that the practice produces unfair outcomes. For example, the substantive patent laws were harmonised in 1982 when the US Court of Appeals for the Federal Circuit was created.[137]

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[128] *Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs* OJ L 3/1 ('*EU Community Design Regulation*').
[129] Frye and Ryan (n 127) 3.
[130] Ibid 6-7.
[131] Anderson (n 63) 695; Elizabeth P Offen-Brown, 'Forum Shopping and Venue Transfer in Patent Cases: Marshall's Response to *TS Tech* and *Genetech*' (2010) 25 *Berkeley Technology Law Journal* 61, 64
[132] Offen-Brown (n 131) 64.
[133] Ryan (n 16) 170.
[134] Frye and Ryan (n 127) 3; Offen-Brown (n 131) 64.
[135] 28 USC § 1400(b) (2012).
[136] 28 USC § 1391(c) (2012); Frye and Ryan (n 127) 3; Offen-Brown (n 131) 64-5.
[137] Anderson (n 63) 633 n 6; Kimberly A Moore (n 9) 561. This also confirms the argument that forum shopping cannot be prevented by harmonising substantive laws: Ferrari (n 74).

Nevertheless, the procedural differences, which courts create to attract patent litigants, provide enough motivation for forum shopping.[138]

However, the risk of unfairness resulting from the plaintiff's ability to shop in popular pro-plaintiff courts, such as the Eastern District of Texas, may be reduced.[139] For instance, recent developments have meant that defendants can also forum shop within the US through motions to transfer venues under 28 USC § 1404(a) (2012). Since 2008, it has been slightly easier to succeed in a transfer venue plea to shift litigation out of the Eastern District of Texas due to the way that recent cases, such as *In Re Genentech Inc* ('*Genentech*'), have applied the FNC doctrine.[140] This relaxation allows the defendant to forum shop in response to the plaintiff's shopping strategy in situations where the court's discretion deems it to be just. In addition, there are multiple benefits which occur when plaintiffs' forum shop in the Texas Court. Patent specialisation occurs which increases efficiency. Plus, the local economy benefits as foreign litigants travel to the forum and spend money on incidentals like accommodation and food.[141] As such, the higher opportunity for forum shopping to be allowed in the patent litigation courts within the US are justified as the risks associated with the broad interpretation of jurisdiction rules are tempered by defendant pleas for transfer of venue and the economic benefits that can arise from a court's patent specialisation.

In comparison to the broad jurisdiction rules for patent litigation in the US, the EU specifically defines the choices available to transnational litigants to provide more control of global forum shopping. This is evident in the EU Community Design Regulation.[142] Recital 30 of this regulation states 'the litigation system should avoid as far as possible "forum shopping." It is therefore necessary to establish clear rules of international jurisdiction.'[143] The limitations on the opportunity to forum shop are explicit in the recital and are elaborated upon in article 82's clear rules of international jurisdiction which provides

[138] Anderson (n 63) 634-5.
[139] Concern over fairness due to the plaintiff's opportunity to shop to the Eastern District Texas Court: Anderson (n 63) 638. If have method to allow counterstrategy by defendant or rectify non-consensual forum shop then the broad interpretation of venue statute and plaintiff choice should remain appropriate: Frye and Ryan (n 127) 4. Developments in transfer venue plea allowed defendants more leeway to counter-forum shop in a system where specific forums are favoured by plaintiffs to increase fairness: Offen-Brown (n 131) 62.
[140] 566 F 3d 1338 (Fed Cir, 2009) ('*Genentech*'); Offen-Brown (n 131) 66. For further discussion of *Genentech*, see Part B of this chapter.
[141] Childress III (n 4) 1010; Anderson (n 63) 664-6; Frye and Ryan (n 127) 9.
[142] *EU Community Design Regulation* (n 128).
[143] Ibid recital 30.

two main choices of forum – the defendant's domicile or place of establishment.[144] The choices are expanded for actions of infringement or declarations of invalidity and allow plaintiffs to also have the place of infringement as an available choice.[145] These choices are far narrower than the US patent jurisdiction requirements. Nevertheless, the EU Community Design Regulation is intended to encourage fairness during transnational litigation where the plaintiff has the original choice and the defendant's interests are protected by limiting that choice. This attempts to ensure no single party can gain an undue advantage over the other when global forum shopping is involved.[146]

Tech 21 UK v Logitech demonstrates how the jurisdiction rules in the EU Community Design Regulation limit global forum shopping for fairness reasons.[147] In this case, Logitech sent a letter threatening litigation to Tech 21 for allegedly infringing Logitech's Community Design rights by selling protective tablet covers in Germany with designs that were similar to Logitech's covers.[148] Tech 21 is based in the UK while Logitech is a Swiss subsidiary with additional establishments in the Netherlands and Croatia.[149] Tech 21 responded to Logitech's letter by filing declarations in an English court that they had not breached any of Logitech's Community Design rights. A few days later, Logitech lodged proceedings for a preliminary injunction in Germany to prevent further sales of Tech 21's protective covers.[150] In the English court, Logitech challenged Tech 21's jurisdiction.[151] Logitech accused Tech 21's litigation in England as forum shopping as they did not want to be involved in proceedings in Germany.[152]

The English court's decision clarified how to interpret the EU Community Design Regulation's jurisdiction requirements. They held that they had no jurisdiction to hear a declaration of non-infringement as article 82(1) of the Regulation points to Croatia or the Netherlands as the choice of forums available to Tech 21.[153] However, the English court did have jurisdiction to hear a claim regarding the injunction against Logitech for sending

[144] *EU Community Design Regulation* (n 128) art 82(1). Article 82(1) is used when the defendant is part of the Member States of the EU. When they are not, art 82(2) comes into effect and the choice shifts from the defendant's domicile to the plaintiff's domicile.
[145] Ibid art 82(5).
[146] Petsche (n 13) 1021-3.
[147] *Tech 21 UK Ltd v Logitech Europe SA* [2015] EWHC 2614 (Ch) ('*Tech 21*').
[148] Ibid 1.
[149] Ibid 5.
[150] Ibid 12.
[151] Ibid 3.
[152] Ibid 59.
[153] Ibid 43; *EU Community Design Regulation* (n 128) art 82(1), 81(b).

unjustifiable threat letters.[154] They reasoned that Logitech had two choices of forum under the EU Regulation to sue Tech 21. Under article 82(5), Logitech could sue in Germany as this was the place of infringement.[155] England was also an available choice under article 82(1) as this is Tech 21's domicile.[156] As such, it was found to be reasonable for Tech 21 to assume that they may be sued in either Germany or England which meant that lodging an injunction in either forum was rational.[157] The way that the English court interpreted these articles and applied it to the facts confirms the rationale behind the EU jurisdiction rules. This rationale is that the defendant should be sued in their home state or state of infringement to allow them to more easily defend themselves which balances out the plaintiff's right to choose the forum.[158] Compared to the US, the jurisdiction rules for the EU's Community Design Regulation provide fewer choices of forum. The opportunity for global forum shopping is thus limited to circumstances which are deemed as appropriate with regard towards the plaintiff's right to choose the forum but minimising the risks of unfair outcomes.

The US patent and EU Community Design Regulation jurisdiction rules represent divergent approaches to forum choices. The former is broad, allowing a higher opportunity for global forum shopping while the latter is strict, limiting the level of forum shopping. However, jurisdiction rules provide greater leeway for forum shoppers as it is a threshold requirement that attempts to ensure fairness between the litigating parties. There are other principles which can further restrict the ability to forum shop such as the common law systems' FNC doctrine.

B *Approaches to the Forum non Conveniens Doctrine*

Inconvenience to the defendant during global forum shopping is considered a major risk for critics of the practice as they think it leads to unjust outcomes because the plaintiff's forum choice is considered as being inappropriate.[159] Even if jurisdiction has been found, the defendant can contest the forum choice through the FNC doctrine.[160] This doctrine is used in common law courts to determine whether the plaintiff's choice of forum is appropriate

[154] *Tech 21* (n 147) 73-4.
[155] *EU Community Design Regulation* (n 128).
[156] Ibid.
[157] *Tech 21* (n 147) 80.
[158] Ibid 43.
[159] Petsche (n 13) 1010-1; Algero (n 2) 81; Maloy (n 3) 26.
[160] Petsche (n 13) 1010; Brand (n 66) 467-8.

based upon measurements of convenience for all litigants.[161] It is a form of defence for the defendant against the plaintiff's forum shopping but it is also a way for the defendant to engage in their own type of shopping.[162] This section will examine the application of the FNC doctrine in the US and England by analysing *Piper Aircraft Co v Reyno* ('*Piper Aircraft*'),[163] *Genentech*[164] and *Lubbe v Cape plc* ('*Lubbe*').[165]

While *Piper Aircraft* is not an IP case, it is an illustrative example of recent global forum shopping. The case was originally brought to a California State court by Reyno, the administratrix of five Scottish citizens who died in a plane crash in Scotland. The cause of the crash was either due to mechanical failure or pilot error.[166] Reyno sued the manufactures of the plane, Pennsylvanian company Piper Aircraft, and the manufacturer of the propellers, Ohio company Hartzell Propeller.[167] Reyno also sued the pilot's estate and the owner of the plane in England.[168] Other than being a Californian resident, Reyno stated that the action was filed in the US as the laws regarding liability and damages for wrongful death claims were more favourable than Scottish laws.[169] This forum choice is the first global forum shop as Reyno chose the US for the advantageous laws and chose California over Pennsylvania or Ohio due to the familiarity of Reyno's legal representation with Californian courts.[170] However, the defendant also engaged in a series of domestic and global forum shopping.[171] The defendants successfully moved proceedings from the state to federal courts, then from California to Pennsylvania.[172] Finally, the defendant's global forum shop occurred when they moved to dismiss the proceedings under FNC, arguing that Scotland was the more appropriate forum.[173] The Supreme Court granted the dismissal of the case as Scotland was found to be the more convenient forum.[174]

Piper Aircraft demonstrates the current application of the FNC doctrine in the US and how it is used to measure the degree of risk of inconvenience that may have been caused by the

[161] Brand (n 66) 468, 495.
[162] Opeskin (n 55) 24.
[163] 4554 US 235 (1981) ('*Piper Aircraft*').
[164] *Genentech* (n 140).
[165] [2000] 1 WLR 1545 ('*Lubbe*').
[166] *Piper Aircraft* (n 163) 239.
[167] Ibid.
[168] Ibid 240.
[169] Ibid.
[170] Ibid 239.
[171] Bookman (n 5) 591; Childress III (n 4) 1007; Juenger, 'What's Wrong with Forum Shopping?' (n 5) 13.
[172] *Piper Aircraft* (n 163) 240.
[173] Ibid 241; Bookman (n 5) 591.
[174] *Piper Aircraft* (n 163) 238.

forum shop. Identifying an alternative forum is the first step when applying the FNC doctrine. Then the court determines which forum is more appropriate by applying the Gilbert public and private interest factors.[175] If these factors are strongly in the defendant's favour then the litigation is dismissed.[176] Conditions may be imposed to make it easier for the plaintiff to file in the alternative forum. The defendants in *Piper Aircraft* agreed to waive Scotland's statute of limitations.[177] The Gilbert private interest factors include:

> [T]he 'relative ease of access to sources of proof; the availability of compulsory process for attendance of unwilling, and the cost of obtaining attendance of willing, witnesses; possibility of view of premises, if view would be appropriate to the action; and all other practical problems that make trial of a case easy, expeditious and inexpensive.'[178]

Gilbert's public interest factors include:

> [T]he administrative difficulties flowing from court congestion; the 'local interest in having localized controversies decided at home'; the interest in having the trial of a diversity case in a forum that is at home with the law that must govern the action; the avoidance of unnecessary problems in conflict of laws, or in the application of foreign law; and the unfairness of burdening citizens in an unrelated forum with jury duty.[179]

In the application of the Gilbert factors, the court used justice as a measurement on whether to grant the dismissal by assessing the risks of inconvenience to the defendant and preventing access to justice for the plaintiff. They determined whether Scotland's laws which were unfavourable to the plaintiff would result in a just outcome. As a remedy was available, it was determined that justice could be done in the Scottish courts. The court stated that if the possibility of an effective remedy was unavailable in the Scottish courts, then the Scottish forum would be inappropriate as it would be unjust.[180]

Piper Aircraft is also an example of how global forum shopping from a foreign plaintiff is less likely to be accepted as appropriate than a US resident or citizen who chooses to shop. Even though Reyno was a US citizen, she was treated as a foreigner as she represented Scottish citizens. The FNC doctrine is usually only successful in exceptional circumstances

[175] Ibid 241; Brand (n 66) 479.
[176] *Gulf Oil Corp v Gilbert*, 330 US 501 (1947) 508 ('*Gilbert*'); Brand (n 66) 470.
[177] *Piper Aircraft* (n 163) 242; Brand (n 66) 481.
[178] *Piper Aircraft* (n 163) 241 n 6, quoting *Gilbert* (n 176) 508.
[179] *Piper Aircraft* (n 163) 241 n 6, quoting *Gilbert* (n 176) 509.
[180] *Piper Aircraft* (n 163) 254-5.

because of the principle that the 'plaintiff's choice of forum should rarely be disturbed.'[181] However, *Piper Aircraft* explicitly stated that this principle only applies to US citizens who are entitled to choose their forum due to their status.[182] The choice of foreign plaintiffs is to be given less weight.[183] The reasoning for this was because it should be assumed that a citizen plaintiff's forum choice is motivated by convenience.[184] Considering that the citizen defendant's engaged in forum shopping in such a way that increased the length, cost and use of multiple courts' resources, this assumption seems flawed. As such, this assumption suggests that forum shopping by citizens is more likely to be deemed appropriate than foreign litigants due to the entitlement of citizenship status over assessments of convenience. Childress III addresses this apparent bias by observing that the US transnational law market is weak and does not take advantage of the economic benefits transnational litigants bring in comparison to markets like England who are more lenient towards shopping by transnational litigants.[185] *Piper Aircraft* is instructive in the current application of FNC in the US, demonstrating three primary points about when global forum shopping is appropriate or not. The first is that global forum shopping is inappropriate in circumstances where it would strongly inconvenience the defendant. The second suggests that shopping by foreign litigants is more likely to be found inappropriate than shopping by a US citizen. Finally, defendants can utilise the FNC doctrine as a method to perform their own forum shopping.

A method for defendant's to forum shop in the US is sanctioned through the transfer of venue provision as it provides a defence against a plaintiff's inappropriate forum shop. The provision codifies the FNC doctrine by seeking the convenience of the litigating parties to prevent unjust outcomes. It states, 'for the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to another district court or division where it might have been brought.'[186] The transfer is only intended to be granted in extreme cases where the plaintiff's forum shop was inappropriate as it would produce an unjust outcome due to an unacceptable level of inconvenience to the defendant.[187] *Genentech* is an example which involved an initial global forum shop by the plaintiff and

[181] Ibid 241; *Gilbert* (n 176) 508-6; Ryan (n 16) 168.
[182] *Piper Aircraft* (n 163) 255-6.
[183] Ibid.
[184] Ibid 256.
[185] Childress III (n 4) 997, 1000-1, 1010, 1038-1040. See also, Anderson (n 63) 664-6; Juenger, 'What's Wrong with Forum Shopping?' (n 5) 13.
[186] 28 USC §1404(a) (2012).
[187] Clermont and Eisenberg (n 2) 1516.

represents a rare example of the defendant's successful forum shop under the transfer provision.[188] In the case, German company Sanofi chose the Eastern District Court of Texas to bring a patent infringement suit against Californian companies Genentech and Biogen.[189] The defendants sought to transfer the case to the Northern District Court in California because the Texas court 'indisputably has no connection to any witnesses or evidence relevant to the cause of action.'[190] The Texas court initially denied the transfer but this decision was overturned on appeal because, in accordance with the application of the Gilbert factors, the majority of the witnesses and evidence were in California.[191] Deciding on whether to grant the transfer increases inefficiency for all parties as it increases the expense and time it takes to resolve the dispute. However, this is an accepted side effect because the transfer is a sanctioned type of forum shopping designed to increase fairness by preventing an initial inappropriate forum shop by the plaintiff.[192]

In comparison, *Lubbe* affirms England's current approach when applying the FNC doctrine.[193] *Lubbe* is a class action case where the plaintiffs sought compensation for the defendant's failure to take positive steps to prevent exposure to asbestos.[194] There were 3,000 plaintiffs, one was an English citizen while the rest were South African.[195] They sued an English company Cape PLC whose subsidiaries had mined, processed and sold asbestos in South Africa.[196] The plaintiffs chose to forum shop in England as they could receive funding from legal aid and contingency fees were available.[197] The House of Lords held that because funding was essentially unavailable in South Africa, the plaintiffs would be unable to litigate which would deny them access to justice.[198] This made the English court the most appropriate and the forum shop was allowed.

The approach towards the FNC doctrine in *Lubbe* is similar to the current US approach as it also uses convenience and justice to determine the appropriate forum. The House of Lords applied the two-step *Spiliada* test in response to the defendant's argument that the English court was inconvenient. The first step when applying the FNC doctrine is the same as the

[188] *Genentech* (n 140) 1340.
[189] Ibid.
[190] Ibid.
[191] Ibid 1344-7.
[192] Clermont and Eisenberg (n 2) 1515.
[193] *Lubbe* (n 165) 1554.
[194] Ibid 1550.
[195] Ibid 1554.
[196] Ibid 1550.
[197] Ibid 1557.
[198] Ibid.

US in that another appropriate forum must be identified. The defendant must prove that it is 'clearly or distinctly more appropriate.'[199] Next the plaintiff must prove that there are circumstances why justice would not be granted if a stay is provided.[200] There are multiple points which have been developed in the case law to guide what information is relevant in this assessment.[201] These points have some overlaps with the US Gilbert factors, such as the convenience of the witnesses and parties as well as avoiding waste. Justice was also used to determine if the forum shop was appropriate in *Lubbe* in a similar manner to the US FNC doctrine. *Piper Aircraft* considered whether the Scottish courts would be able to provide a just outcome where *Lubbe* considered which forum would provide access to justice.[202] Even though the decision was the opposite in each case, this was due to the application of the facts. In both cases, they considered whether the alternative forum would provide a just outcome after an application of the relevant factors which were used to determine if the alternative forum was more appropriate.[203]

There are two main differences when applying the FNC doctrine between England and the US. First, *Lubbe* determined that the major difference between England's approach and the Gilbert factors is that public interest is irrelevant unless it impacts upon the private interests of the parties.[204] The second difference between *Lubbe* and *Piper Aircraft* is the treatment of foreign plaintiffs. The US qualified their usual determination that the 'plaintiff's choice of forum should rarely be disturbed' by regarding a citizen's choice with more deference than a foreigner.[205] In comparison, the House of Lords in *Lubbe* did not distinguish between a foreign and citizen plaintiff as the concentration was on the consideration of the parties' convenience.[206] Perhaps this is because the English courts have historically been more likely to allow global forum shopping by transnational litigants if they had jurisdiction.[207]

Other than jurisdiction rules, the FNC doctrine is the most developed legal principle currently used to determine whether a plaintiff's forum shop is appropriate. This section has outlined the use of the FNC doctrine in the US and England but there are divergent tests

[199] Ibid 1554.
[200] Ibid.
[201] For detailed list of the points see: Brand (n 66) 473.
[202] *Piper Aircraft* (n 163) 254-5; *Lubbe* (n 165) 1557.
[203] *Piper Aircraft* (n 163) 255; *Lubbe* (n 165) 1556-60.
[204] *Lubbe* (n 165) 1561; Brand (n 66) 473.
[205] *Piper Aircraft* (n 163) 241, 255-6.
[206] *Lubbe* (n 165) 1556, 1560.
[207] CGJ Morse, 'Not in the Public Interest? *Lubbe v Cape PLC*' (2002) 37 *Texas International Law Journal* 541, 452; Brand (n 66) 470; Juenger, 'Forum Shopping, Domestic and International' (n 3) 564; Childress III (n 4) 1000.

across different nation-states. For example, civil law nation-states use *lis alibi pendens* to favour the plaintiff's first choice over the most appropriate forum.[208] There are also elements of efficiency and motivation which can overlap with considerations of FNC and jurisdiction. The next two sections will examine efficiency and motivations to determine how the judiciary considers these factors.

C Facilitating the Efficient Administration of Justice through Global Forum Shopping

Efficiency is another element which the judiciary considers when assessing whether a global forum shop is appropriate under the FNC doctrine. This section analyses efficiency separately because a major concern of the critics of forum shopping is that it produces inefficiency or waste.[209] Yet proponents of the practice argue that some shoppers are motivated by efficiency in their forum choice.[210] As a topic of interest to both perspectives of forum shopping, analysing the judicial treatment of efficiency is important.

Efficiency refers to the length and costs associated with litigation which can be borne by both the litigants and the court system. The impact of efficiency is intertwined between the court and the litigants because the more efficient or speedy the court is in processing the litigation, the less costs are expended by the parties, witnesses and jury.[211] This economic-focussed aspect has overlaps with convenience. For instance, the Gilbert factors which concern efficiency include the costs of the attendance of witnesses, issues which make the litigation inexpensive and considerations of court congestion.[212] The importance of litigation costs was emphasised in *Lubbe* when considering the plaintiffs' ability to properly fund legal representation.[213] This was acknowledged in assessments of the degree of money, time and workload required for the legal representation 'to have any reasonable prospect of addressing the plaintiffs' allegations meaningfully.'[214] Plus, as the South African courts of

[208] Brand (n 66) 468, 488-493.
[209] See for eg Petsche (n 13) 1015-7; Anderson (n 63) 645. Some emerging scholars address the concern as they disagree: see, eg, Ghei & Parisi (n 4) 1369; Whytock (n 4) 531; Bookman (n 5) 605-6. An example of a litigant motivated by efficiency is seen in *Schrems v Facebook Ireland Ltd* (Court of Justice of the European Union, C-498/16, ECLI:EU:C:2018:37, 25 January 2018). In this case Schrems shopped to his domicile court in Austria for a privacy dispute with Facebook Ireland. This was motivated by efficiency as the Austrian court was more affordable for Schrems than a suit in Ireland, which is Facebook Ireland's domicile. The European Court of Justice allowed Schrems to continue the suit alone as the relevant EU Regulation considers it appropriate to forum shop in the party's own domicile when they are the economically weaker party and it would facilitate access to justice.
[210] Maloy (n 3) 27; Frye and Ryan (n 127) 2; Bookman (n 5) 605-6.
[211] Petsche (n 13) 1015; Bookman (n 5) 603.
[212] *Piper Aircraft* (n 163) 241 n 6, quoting *Gilbert* (n 176) 508-9.
[213] *Lubbe* (n 165) 1557-1560.
[214] Ibid 1557.

the time had underdeveloped procedures for class actions, it was considered that the most appropriate forum that could provide access to the efficient administration of justice was England.[215] As a result, the global forum shop was allowed because the benefit of efficiency resulting from the forum shop outweighed any risks that may occur from the defendant's inconvenience.

Another type of inefficiency which can be caused by global forum shopping in IP litigation is an inability to enforce the decision overseas, necessitating further litigation or resulting in a wasted initial outcome. This situation occurs when a plaintiff chooses a forum where the defendant has no assets which leaves no way for a favourable judgment to be enforced.[216] If the plaintiff attempt to enforce the decision in the defendant's domicile they could be denied jurisdiction or if they pursue fresh proceedings there are additional court costs to the litigants.[217] This was the situation when Lucasfilm decided to sue Ainsworth in the US for copyright infringement. In 2006 Lucasfilm, the California based company who created Star Wars, sued Ainsworth and his company Shepperton Studio Designs for breaching their copyrights.[218] Ainsworth, an English resident, was commissioned to build the Storm Trooper uniforms. He subsequently sold Storm Trooper uniforms to consumers in the US without permission from Lucasfilm. Lucasfilm initially forum shopped in a Californian court.[219] There is no direct evidence for this choice but, assuming Lucasfilm's choice was rational, it was likely based upon familiarity with their domicile's court and the higher probability of a favourable outcome. However, Ainsworth had no assets in the US so enforcement of the California court's decision was next to impossible as Ainsworth refused US jurisdiction.[220] As a result, Lucasfilm proceeded to sue Ainsworth in England. One of the main legal issues the English court looked at was 'whether the English court may exercise jurisdiction in a claim against persons domiciled in England for infringement of copyright committed outside the EU in breach of the copyright law of that country.'[221] The Supreme Court held that they

[215] Ibid 1560.
[216] Petsche (n 13) 1016; Joost Blom, 'Star Wars Storm Troopers, the Next Episode: Lucasfilm in the United Kingdom Supreme Court' (2011) 24 *Intellectual Property Journal* 15, 25-6.
[217] Petsche (n 13) 1016
[218] *Lucasfilm Ltd v Shepperton Design Studios Ltd* (CD Cal, No CV05-3434 RGK MANX, 26 September 2006).
[219] Ibid 1-3.
[220] Blom (n 216) 15, 25.
[221] *Lucasfilm Ltd v Ainsworth* [2011] UKSC 39, 19[50] ('*Lucasfilm Supreme Court Decision*').

had jurisdiction,[222] thereby allowing the forum shop as the enforcement of foreign IP rights promoted efficiency.

It is interesting to compare the Supreme Court's decision against the Court of Appeal's reasoning as the courts assessed the risks and benefits resulting from the forum shop differently. The Court of Appeal's decision argued that jurisdiction should not be allowed for the policy reason that 'if national courts of different countries all assume jurisdiction there is far too much room for forum-shopping.'[223] The Court of Appeal's concern of the policy risk of forum shopping increasing due to granting jurisdiction is a flawed argument as it assumes that no benefit can be caused by the practice. For example, innovations in technology mean that redundant and simultaneous litigation may occur because the IP legal system is different in each nation-state.[224] As such, by rejecting the Court of Appeal's reasoning, the Supreme Court's decision reduces the inefficiency caused by redundant and simultaneous litigation.[225] The Supreme Court's decision broadens the ability for appropriate global forum shopping to occur in England for scenarios similar to Lucasfilm to promote the beneficial effect of the efficient administration of justice resulting from the practice.[226]

D *The Rationality Underlying Motives when Forum Shopping*

As the outcome of litigation is influenced by the choice of forum, the motive of the forum shopper can be relevant to whether the shop is appropriate.[227] In particular, the motivations of shoppers are of interest in the literature. Most traditional scholars argue that forum shoppers' motives are improper for trying to gain an advantage or influence the outcome of the litigation while emerging scholars justify motives as being rational. This section will contribute to the emerging scholars' arguments by interpreting the recent case law through the rational choice assumption that forum shoppers are rational maximisers of self-interest.[228]

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[222] Ibid 38[114].
[223] *Lucasfilm Ltd v Ainsworth* [2009] EWCA Civ 1328, [178] ('*Lucasfilm Court of Appeal Decision*').
[224] Kristen Elisabeth Bollinger, 'A New Hope for Copyright: The UK Supreme Court Ruling in Lucasfilm Ltd v Ainsworth and Why Congress Should Follow Suit' (2012) 20 *Journal of Intellectual Property Law* 87, 109.
[225] *Lucasfilm Supreme Court Decision* (n 221) 31[91]-[92].
[226] Blom (n 216) 25.
[227] Clermont and Eisenberg (n 2) 1515; Kimberly A Moore (n 9) 561.
[228] Posner, *Economic Analysis of Law* (n 24) 3.

In accordance with the rational choice principle of self-interest, a forum shopper chooses a venue that they believe is more likely to achieve their preferred outcome. This does not always mean that they seek to cause inconvenience or unfairness as traditional scholars argue, rather they are trying to maximise the probability of achieving their self-interest. This is evident from Reyno's admitted motivation in *Piper Aircraft.*[229] Reyno sought a result that would maximise the interests of the estate of which she was the administratrix. Reyno's legal representation was a Californian lawyer, familiar with the US courts.[230] This expertise and familiarity coupled with the higher threshold of compensation available, demonstrates the underlying rationality behind the forum choice.[231] The court in *Piper Aircraft* did not condemn this motive either. The language used has neutral connotations and they acknowledge the fact that the Scottish laws were unfavourable to Reyno and considered whether this could cause injustice to the plaintiff.[232] While the FNC doctrine was applied in the defendant's favour, it was not because Reyno's motive was seen as improper. Instead the global forum shop was deemed inappropriate due to the degree of inconvenience to the defendant.

The motive of forum shoppers may also be spurred by the benefits of efficiency and access to justice which was evident in *Lubbe*.[233] In these situations, the forum shopper's rational choice is calculated based upon their ability to fund their suit sufficiently to have a prospect of success in the chosen forum rather than to necessarily achieve a more advantageous outcome. For *Lubbe* the motive to forum shop for the plaintiffs were to access justice as funding was available in England for what would be an extremely complex and lengthy case. It also necessitated a class action for efficiency reasons as so many people were affected.[234] In terms of the rational choice between the South African court where funding was next to impossible and the underdeveloped class action procedures would only increase the length of the litigation, a positive outcome of the litigation was more likely to succeed in an English court.[235] Since this motive was based upon seeking access to justice, the English courts allowed the forum shop.

[229] *Piper Aircraft* (n 163) 240.
[230] Childress III (n 4) 1007.
[231] Ibid; *Piper Aircraft* (n 163) 240.
[232] *Piper Aircraft* (n 163) 254-5.
[233] *Lubbe* (n 165).
[234] Ibid 1557-9.
[235] Ibid 1557-60.

This chapter has analysed recent case law to determine the common factors which the judiciary considers when allowing global forum shopping or dismissing it as inappropriate. This demonstrates that there are circumstances which the judiciary can determine are appropriate for forum shopping by considering the risks and benefits that result from the practice. These circumstances can be identified through rules on jurisdiction which control forum choices, the convenience to the parties, efficiency when completing the litigation and the motivations of the forum shoppers. The factors identified in this chapter form the basis for the criteria being developed in this thesis to identify when forum shopping is appropriate in a particular transnational IP case. To test the effectiveness of using these factors as criteria, the next chapter will apply them to a case study.

V CASE STUDY: PHILLIP MORRIS INTERNATIONAL'S GLOBAL FORUM SHOPPING LITIGATION STRATEGY

As forum shopping is often a pre-litigation strategy of the plaintiff, the judiciary does not necessarily consider the forum choice directly unless the defendant raises the jurisdiction of the court as an issue. As such, a detailed analysis of a case study where forum shopping has occurred but not been discussed within the judgment is necessary to further develop and test relevant criteria when determining whether the shop was appropriate or not. The case study chosen in this thesis is the litigation which has been ongoing since 2011 between PMI[236] and Australia regarding the legitimacy of Plain Packaging legislation.[237] The Plain Packaging dispute was chosen as there has been much discussion among academia and the media about the litigation strategies undertaken by PMI but while forum shopping has been mentioned, it has yet to be analysed.[238] This chapter will perform two functions when analysing the case study. The first is to apply the factors discussed in Chapter IV as criteria to help determine retrospectively whether the forum shopping strategy undertaken by PMI was appropriate or not. These criteria include jurisdiction, convenience, efficiency and motivation. The second function of this chapter is to identify policy, which has briefly been mentioned in the case law, as relevant criteria when determining the suitability of forum shopping. This chapter will highlight one instance where the shop was inappropriate in PMI's investment arbitration claim in 2011 under the Hong Kong-Australia Bilateral Investment Treaty ('BIT')[239] and one instance where the shop was appropriate when PMI lobbied and funded the Dominican Republic to lodge a claim in 2012 with the World Trade Organization's Dispute Settlement

[236] PMI is a multinational conglomerate based in the US which includes multiple subsidiary companies spread across the world. When using PMI this thesis is generally referring to the entire PMI group, unless specifically using the name of a subsidiary group such as Philip Morris Asia ('PMA').
[237] When referring to Australia's Plain Packaging legislation, these laws collectively include: *Tobacco Plain Packaging Act 2011* (Cth); *Tobacco Plain Packaging Regulations 2011* (Cth); *Trade Marks Amendment (Tobacco Plain Packaging) Act 2011* (Cth).
[238] See, eg, Eva Nanopoulos and Rumiana Yotova, ''Repackaging' Plain Packaging in Europe: Strategic Litigation and Public Interest Considerations' (2016) 19 *Journal of International Economic Law* 175, 175-8; Matthew Rimmer, 'The Chilling Effect: Investor-State Dispute Settlement, Graphic Health Warnings, The Plain Packaging of Tobacco Products, and the *Trans-Pacific Partnership*' (2017) 7(1) *Victoria University Law and Justice Journal* 76, 77; Aditya Kalra et al, 'The Philip Morris Files: Inside Philip Morris' Campaign to Subvert the Global Anti-Smoking Treaty' *Reuters* (Web Page, 13 July 2017) <https://www.reuters.com/investigates/special-report/pmi-who-fctc/>.
[239] *Agreement Between the Government of Australia and the Government of Hong Kong for the Promotion and Protection of Investments*, signed 15 September 1993, [1993] ATS 30 (entered into force 15 October 1993) ('*Hong Kong-Australia BIT*'); *Philip Morris Asia Ltd v Australia (Award on Jurisdiction and Admissibility)* (Arbitral Tribunal, PCA Case 2012-12, 17 December 2015) ('*PMA v Australia*').

Body ('WTO DSB').[240] In identifying both appropriate and inappropriate instance of forum shopping, it demonstrates how the proposed criteria can be applied through a method which promotes the benefits of forum shopping while mitigating the adverse risks that can result from the practice.

A *The Legal and Political Context to the Plain Packaging Dispute*

The Plain Packaging legislation dispute between PMI and Australia arose due to tension at the international treaty-making level between the priority of the human right to health against the economic benefits when exercising IP rights. This tension was highlighted in 2005 by the creation of the World Health Organization's Framework Convention on Tobacco Control ('FCTC').[241] When the FCTC is implemented on a domestic level, nation-states are justified by the right to health to tighten tobacco control laws by imposing restrictions on the use of trademarks on tobacco products through graphic health warnings, plain text and colouring on the packages.[242] For the nation-states and non-government organisations who have been attempting to weaken the linkage between trade and IP in order to strengthen the linkage between human rights and IP, the FCTC has been perhaps the biggest step forward since the Doha Declaration.[243] As a result of differing interests between trade and human rights in relation to IP, the success or failure of the FCTC being implemented by nation-states is an important site of conflict. Considering Australia was the first nation-state to implement Plain Packaging legislation in accordance with the FCTC, the dispute with the leading multinational tobacco companies like PMI have been vigorous, expensive and lengthy.

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[240] Panel Report, *Australia – Certain Measures Concerning Trademarks, Geographical Indications and Other Plain Packaging Requirements Applicable to Tobacco Products and Packaging*, WTO Doc WT/DS435/R; WT/DS441/R; WT/DS458/R; WT/DS467R (28 June 2018) ('*Plain Packaging Panel Report*').
[241] 'WHO Framework Convention on Tobacco Control' (Web Page) <https://www.who.int/fctc/en/>.
[242] Ibid; *The World Health Organization Framework Convention on Tobacco Control*, opened for signature 21 May 2003, 2302 UNTS 166 (entered into force 27 February 2005) art 5, 11 ('*FCTC*').
[243] For discussions of how the linkage between IP, human rights, public health and biodiversity were negotiated during the period surrounding the Doha Declaration see: Helfer, 'Regime Shifting' (n 75) 42-5; Laurence R Helfer, 'Regime Shifting in the International Intellectual Property System' (2009) 7(1) *Perspectives on Politics* 39, 39; Claire R Kelly, 'Power, Linkage and Accommodation: The WTO as an International Actor and Its Influence on Other Actors and Regimes' (2006) 24(1) *Berkeley Journal of International Law* 79, 87; Valbona Muzaka, 'Linkages, Contests and Overlaps in the Global Intellectual Property Rights Regime' (2010) 17(4) *European Journal of International Relations* 755, 767-9; Milana Karayanidi, 'Bargaining Power in Multilateral Negotiations on Intellectual Property Rules: Paradox of Weakness' (2011) 14(3-4) *The Journal of World Intellectual Property* 265, 269-70.

PMI has engaged in a multi-pronged strategy to first prevent creation of the FCTC and then prevent it from being implemented on a domestic level.[244] This strategy involved lobbying and evidence gathering in the hopes of preventing the FCTC from coming into force. Then after the FCTC was implemented by Australia, PMI began a litigation strategy that included forum shopping. It should be noted that PMI is one of four major multinational tobacco companies who have engaged in strategies to litigate against Plain Packaging legislation as soon as it has been enacted in a nation-state.[245] These companies include Japan Tobacco International, British America Tobacco and Imperial Tobacco. These companies have co-operated together in their litigation and lobbying strategies. For instance, in 2012 Japan Tobacco International and British America Tobacco became joint plaintiffs in the constitutional claim in the High Court of Australia that the Plain Packaging legislation constituted an acquisition of property. The Australian subsidiary of PMI and Imperial Tobacco were interveners in the case.[246] Due to the creation of the FCTC, Australia became the first nation-sate to implement Plain Packaging legislation which spurred PMI to engage in forum shopping tactics in their efforts to litigate against the legitimacy of this method of tobacco control.

B *A Rational Choice Approach to PMI's Global Forum Shopping Choices*

PMI is the primary tobacco company which engaged in global forum shopping tactics in their litigation against Plain Packaging legislation. PMI chose three forums to shop at which they believed were the most favourable tribunals which could help them achieve their preferred outcome. These three instances include the arbitration against Uruguay in the Switzerland-Uruguay BIT decided in 2016,[247] the arbitration against Australia in the Hong Kong-Australia BIT decided in 2015 and PMI's indirect involvement in the Dominican

[244] Kalra et al (n 238); Patricia Ranald, 'Expropriating Public Health Policy: Tobacco Companies' Use of International Tribunals to Sue Governments over Public Health Regulation' [2014] (73) *Journal of Australian Political Economy* 76, 94 ('Expropriating Public Health Policy').
[245] For example, there have been as series of litigation in England, Ireland and France in response to similar Plain Packaging legislation being implemented: *R (British American Tobacco & Ors) v Secretary of State for Health* [2016] EWHC 1169; *Sarl & Others v Secretary of State for Health* (Court of Justice of the European Union, C-547/14, ECLI:EU:C:2015:853); *Société JT International SA, Société d'exploitation industrielle des tabacset des allumettes, Société Philip Morris France SA,* Conseil d'Etat [French Administrative Court], 23 December 2016; Conseil constitutional [French Constitutional Court], decision nº 2015-727 DC, 21 January 2016 reported in JO, 27 January 2016; *JTI Ireland Ltd v Minister for Health & Ors* [2015] IEHC 481.
[246] *JT International SA v Cth* [2012] HCA 43.
[247] *Philip Morris Brand Sàrl v Uruguay (Award)* (ICSID Arbitral Tribunal, Case No. ARB/10/7, 8 July 2016). Note that this arbitration wasn't against Plain Packaging legislation created in accordance to the FCTC but was similar tobacco control legislation against health warnings.

Republic's claim against Australia in the WTO DSB whose appeal is currently ongoing. This forum shopping strategy may be demonstrated as rational choices by identifying PMI's self-interest, preferred outcomes, belief and rationality.

The self-interest of PMI is determined based upon the company's preferences. As the purpose of a company is to trade profitably, the primary preference of PMI would be to maintain their business interests of continuing to profit from the sale of their products. PMI currently has two major products they develop, produce and sell – tobacco cigarette products and smoke free products.[248] The primary aim of the FCTC and Plain Packaging laws is to reduce the consumption of tobacco cigarette products.[249] The FCTC and Plain Packaging legislation threaten PMI's self-interest as the reduced consumption of tobacco products would negatively impact the company's profits. As such, PMI's forum shopping strategy is aimed at maintaining PMI's self-interest of continuing to trade profitably.

PMI has two preferred outcomes that they seek to achieve through their forum shopping litigation strategy. The first outcome is to achieve a ruling in their favour so that Plain Packaging laws may be repealed or amended. However, if this outcome fails PMI has a second preferred goal which is regulatory chill. As PMI's Chairman Grady stated in 2010, regulatory chill seeks to prevent nation-states from implementing Plain Packaging laws by 'dissuading other countries from implementing similarly strong measures or delaying such action.'[250] In the previous section, it was mentioned that the tobacco industry as a whole co-operated in their litigation strategy to ensure that each time Plain Packaging was implemented, a tobacco company litigated against the legislation. This strategy is designed to create regulatory chill as the certainty of a tobacco company litigating against Plain Packaging legislation impacts upon the decisions of other nation-states when they consider whether to implement the same laws. This is reminiscent of Axelrod's iterated game which suggests that litigation does not occur in a vacuum, the decision-making of nation-states to implement the legislation occurs after considering the likelihood of the past action of

[248] 'Designing a Smoke-Free Future', *Philip Morris International* (Web Page) <https://www.pmi.com/who-we-are/designing-a-smoke-free-future> ('Designing a Smoke-Free Future').
[249] *FCTC* (n 242) art 3; *Tobacco Plain Packaging Act 2011* (Cth) s 3.
[250] Grady quoted in Robert Stumberg, 'Safeguards for Tobacco Control: Options for the TPPA' (2013) 39 *American Journal of Law and Medicine* 382, 395. See also, EM Greenhalgh, C Grace and MM Scollo, '18B.9 International Regulatory Overview' in MM Scollo and MH Winstanley (eds) *Tobacco in Australia: Facts and Issues* (Web Page, January 2019) <https://www.tobaccoinaustralia.org.au/chapter-18-harm-reduction/indepth-18b-e-cigarettes/18b-9-regulatory-overview>.

litigation repeating in the future.[251] For the iterated regulatory chill strategy to continue to be effective the litigation must occur for as long as possible which means gaining access to as many forums as possible through tactics such as PMI's global forum shopping.[252] However, PMI does not require regulatory chill to be effective indefinitely. The spread of Plain Packaging legislation only needs to be delayed. This requirement of delay is implied in the way that PMI has committed to shift their business towards smoke-free nicotine products which currently has less legislation regulating it.[253] Due to the costs of litigation, regulatory chill is a credible deterrence. Regulatory chill especially effects developing nation-states as the expense to defend against litigation could consume the entire annual budget for tobacco control and education to reduce smoking campaigns.[254] It has been reported that Uruguay nearly settled the arbitration proceedings under the Switzerland-Uruguay BIT because the legal costs were too high. They were able to proceed only because the Bloomberg Foundation provided finance.[255] PMI's self-interest may be achieved through two possible outcomes when litigating, either receiving a favourable result or regulatory chill. For either of these outcomes to occur, PMI would have to believe before lodging the claim, that they could have a reasonable likelihood to achieve these outcomes.

The investment and trade venues where PMI chose to forum shop were likely based upon the belief that they were more likely than the domestic courts to consider international trade obligations over the public health rhetoric which accompanies support for Plain Packaging legislation. This belief would have been formed based upon information gathered by PMI through avenues such as legal advice, a cost-benefit analysis in consideration of the preferred outcomes and the results of previous domestic litigation. There is evidence of such legal advice recommending the investment arbitration venues as a favourable forum discussed within the Hong Kong-Australia BIT arbitration judgment on jurisdiction but the specifics have been redacted.[256] Nevertheless, PMI expended many resources to gain access to the investment and trade forums due to this belief. First, they framed the legal issues by

[251] Robert Axelrod and William D Hamilton, 'The Evolution of Cooperation' (1981) 211 *Science* 1390, 1392. See also, Whytock (n 4) 488: where forum shopping equals strategic behaviour which is calculated based upon an actor's preferences plus expectations of the behaviour of other actors.
[252] Axelrod and Hamilton (n 251) 1392.
[253] 'Designing a Smoke-Free Future' (n 248); Greenhalgh, EM et al, '18B.9 International Regulatory Overview' in MM Scollo and MH Winstanley (eds) *Tobacco in Australia: Facts and Issues* (Web Page, January 2019) <https://www.tobaccoinaustralia.org.au/chapter-18-harm-reduction/indepth-18b-e-cigarettes/18b-9-regulatory-overview>.
[254] Ranald, 'Expropriating Public Health Policy' (n 244) 92; Stumberg (n 250) 397.
[255] Ranald, 'Expropriating Public Health Policy' (n 244) 92; Stumberg (n 250) 396.
[256] For eg, *PMA v Australia* (n 239) 171[556]-175[566].

minimising IP to emphasise the investment issues.[257] PMI then went to great lengths to obtain jurisdiction to the Hong Kong-Australia BIT arbitration by completely restructuring their company.[258] This restructure meant that while the Uruguay arbitration was judged based on the merits, PMI failed to obtain jurisdiction in the Australian arbitration due to abuse of process.[259] Finally, PMI lobbied the Dominican Republic to lodge a claim against Australia in the WTO DSB and are currently funding their legal representation.[260] As one of PMI's preferred outcomes is regulatory chill, the company has demonstrated a willingness to expend resources litigating even if the result is not successful. As long as there is enough uncertainty of the legal issues, PMI will litigate in any forum in which they can gain access.[261]

The final element of the basic assumptions of rational choice is whether the decision to forum shop in the investment and trade venues had underlying rationality in consideration of PMI's self-interest, preferred outcomes and belief in the likelihood of achieving these outcomes. The definition of rationality is the consideration of the consequences of the chosen act, which is litigation, to determine whether the preferred outcomes are possible.[262] In this case, the consequences of litigation include either a favourable outcome or further regulatory chill. As such, no matter the result of the litigation, PMI could achieve at least one outcome making the decision to undertake global forum shopping litigation a rational choice.

C Application of the Proposed Criteria to the Hong Kong-Australia Bilateral Investment Treaty Arbitration

This section will examine the Hong Kong-Australia BIT arbitration between Philip Morris Asia ('PMA') and Australia by applying the criteria of jurisdiction, motivation, convenience, efficiency and policy. Upon applying these criteria to this arbitration, it is evident that this was an instance of inappropriate global forum shopping. This demonstrates that these criteria can be applied in a way which can mitigate the risk of inefficiency and

[257] Nanapolous and Yotova (n 238) 175-6.
[258] *PMA v Australia* (n 239) 184[585]-[588].
[259] Ibid.
[260] Stumberg (n 250) 396.
[261] Ibid 395; Jappe Eckhardt and Dirk De Bièvre, 'Boomerangs over Lac Leman: Transnational Lobbying and Foreign Venue Shopping in WTO Dispute Settlement' (2015) 14(3) *World Trade Review* 507, 513
[262] Lindenberg (n 24) 550.

prevent litigants from rorting the investment arbitration system because of improper motives.

The first criteria to determine whether PMA's forum shopping was appropriate is to apply the relevant jurisdiction rules of the forum, using the motivation criteria to support the consideration. The arbitration's judgment denied jurisdiction as the primary motivation behind PMA's restructure was improper. The facts behind this restructure was essential to the tribunal's decision and why the forum shop was subsequently inappropriate. PMA is the primary claimant in the dispute as they are the foreign investor in Australia and were incorporated in Hong Kong. However, originally, the Australian subsidiaries of PMI (Philip Morris Australia and Philip Morris Limited) were 100% owned by Philip Morris Brands Sàrl, a Swiss owned subsidiary of PMI.[263] The decision to restructure occurred around September 2010, the same month that the Rudd Government announced that Australia would be implementing Plain Packaging legislation.[264] In February 2011, ownership of the Australian subsidiaries shifted to PMA.[265] Then, on 21 November 2011, PMA served the Notice of Arbitration to the Australia government on the same day that the *Tobacco Plain Packaging Act 2011* (Cth) was enacted.[266] The tribunal utilised evidence of PMA's internal memos and legal advice to conclude that this restructure's primary purpose was to gain jurisdiction to arbitrate under the Hong Kong-Australia BIT.[267] As such, PMA were refused jurisdiction as being an abuse of process because the attempt to gain access to the BIT was foreseen by PMI in 2010 when the Australian government announced that the Plain Packaging legislation would be passed.[268]

The motivation behind PMA's restructure and the evidence demonstrating this motivation was a primary factor in the tribunal's finding of the abuse of process. As such, while motivations alone are not generally determinative when considering whether forum shopping is appropriate or not, motivation can be used to support considerations of other criteria like jurisdiction. This is similar to the way that *Covey Gas* used motivation in conjunction with the historical duplicative litigation suits lodged by the plaintiff which was discussed in Chapter III.[269] The criteria of jurisdiction, with motivation used as support,

[263] *PMA v Australia* (n 239) 16[97].
[264] Ibid 26[143] – 27[150].
[265] Ibid 30[163].
[266] Ibid 33[176].
[267] Ibid 184[585]-[588].
[268] Ibid 184[586].
[269] *Covey Gas* (n 78).

demonstrates that the global forum shopping undertaken by PMI in the Hong Kong-Australia BIT was inappropriate. As jurisdiction is a threshold requirement, normally it would be enough to deem the forum shop inappropriate if jurisdiction is not found. However, for the purposes of this case study, the rest of the criteria will be analysed as well to demonstrate how they may be applied in instances where the forum shop is inappropriate.

Depending upon the circumstances of the case, the extent that litigants are inconvenienced and experience inefficiency vary. In this case, the effect of inconvenience on the litigants was low due to the arbitration's application of the 2010 United Nations Commission on International Trade Law rules.[270] Under article 18, the tribunal decided that the appropriate place for the arbitration to take place was Singapore.[271] However, considering the power and resources of both PMA and Australia, the inconvenience related to concerns over geographic proximity, gathering of evidence and witnesses is minimal. As such, this factor provides support for the forum shop to be appropriate as the inconvenience to the litigants is low. However, in this arbitration, the risk of inefficiency has a high impact upon Australia, outweighing any benefit of convenience and supporting that this instance of global forum shopping was inappropriate.

The costs to defend against the arbitration for Australia was high which benefitted PMI's desired outcome of regulatory chill. There was also controversy involved by Australian politicians over the costs.[272] After a Freedom of Information request was lodged by former Senator Nick Xenophon and Senator Rex Patrick, it was later revealed that it cost Australia a total of AUD$24 million for the arbitration.[273] With PMA being ordered to pay fifty percent of these costs, in total Australia spent AUD$12 million defending the litigation.[274] The Senators were particularly vocal about criticising the investor-state dispute settlement ('ISDS') provision which provided space for PMA to lodge the claim under the Hong Kong-

[270] *United Nations Commission on International Trade Law Arbitration Rules (as revised in 2010),* GA Res 65/22, UN Doc A/RES/65/22 (adopted 6 December 2010).
[271] Ibid art 18; *PMA v Australia* (n 239) 7[34].
[272] Pat Ranald, 'The Cost of Defeating Philip Morris Over Cigarette Plain Packaging', *Sydney Morning Herald* (online at 2 April 2019) <https://www.smh.com.au/national/the-cost-of-defeating-philip-morris-over-cigarette-plain-packaging-20190327-p5182i.html>.
[273] Ibid; Jarrod Hepburn, 'Final Costs Details are Released in Philip Morris v Australia Following Request by IA Reporter', *Investment Arbitration Reporter* (online at 21 March 2019) <https://www.iareporter.com/articles/final-costs-details-are-released-in-philip-morris-v-australia-following-request-by-iareporter/>.
[274] Hepburn (n 273); *Philip Morris Asia Ltd v Australia (Final Award Regarding Costs)* (Arbitral Tribunal, PCA Case 2012-12, 8 March 2017).

Australia BIT.[275] Without this provision, the money necessarily spent in litigation, could have been put towards achieving other health goals in Australia.[276] While Australia has the resources to pay the costs of defending against these litigation suits, it is still an inefficient waste of Australian resources. Inefficiency is the second major factor after jurisdiction, which demonstrates PMI's inappropriate forum choice.

The application of the fifth criteria of public policy also demonstrates that this forum shop was inappropriate. There are two aspects of the policy criteria to consider when applying it – the first are considerations on how the law may be positively developed as a result of the forum shop and the second is whether there is a public interest reason to restrict such cases from occurring.[277] By choosing investment forums, PMI have revealed the policy dangers involved with ISDS clauses in trade agreements. The result of the arbitration has contributed to developments on the use of ISDS clauses. Nation-states have begun to either remove or restrict ISDS provisions in trade and investment treaties. For example, after the result of the arbitration, Hong Kong and Australia amended their BIT to carve out public health and tobacco control legislation exceptions on the use of the ISDS clause.[278] In addition, the ISDS clause has been removed from NAFTA while India, South Africa and Indonesia have withdrawn from all ISDS provisions.[279] This arbitration revealed the dangers of the ISDS clause as it was used by PMA to attack the legitimacy of Australia's public interest legislation.[280] As such, there were public interest reasons to deem the forum shop in the Hong Kong-Australia BIT as inappropriate to prevent similar litigation in the future. This is especially because the governments implementing Plain Packaging legislation have justified these laws as being for legitimate public health reasons. It would be in Australia's interests to prevent the precedent of using investment forums to undermine the legitimacy of public

[275] For academic criticism of ISDS, see Rimmer (n 238) 87; Ranald, 'Expropriating Public Health Policy (n 244) 86-91; Tania Voon and Andrew Mitchell, 'Time to Quit? Assessing International Investment Claims Against Plain Tobacco Packaging in Australia' (2011) 14(3) *Journal of International Economic Law* 515, 552.
[276] '39 Million Taxpayer Dollars Up in Smoke: Government Forced to Release Philip Morris Tobacco Plain Packaging ISDS Legal Costs', *Rex Patrick* (Web Page, 2 July 2018) <https://rex.centrealliance.org.au/media/releases/39-million-taxpayer-dollars-up-in-smoke-government-forced-to-release-philip-morris-tobacco-plain-packaging-isds-legal-costs/>; Stumberg (n 250) 397.
[277] See below Chapter VI(A) for a more detailed discussion on the policy criteria.
[278] *Investment Agreement between the Government of Australia and the Government of the Hong Kong Special Administrative Region of the People's Republic of China*, signed 26 March 2019, [2019] ATNIF 21 (not yet in force), art 18(1)(b), Section C n 13-14.
[279] Ranald, 'The Cost of Defeating Philip Morris Over Cigarette Plain Packaging' (n 272); Ranald, 'Expropriating Public Health Policy' (n 244) 86-91. See also, analysis from before the result of *PMA v Australia* were released, recommending that if the ISDS was removed or restricted it would prevent the arbitration: Voon and Mitchell (n 275) 552.
[280] Rimmer (n 238) 87.

interest legislation for the benefit of private entities.[281] The only way to reduce the danger would be to remove or restrict the ISDS clause by amending the international treaty.[282] Australia was not able to amend the ISDS clause before the arbitration, so instead the effects were mitigated by the tribunal denying PMA jurisdiction. Overall, PMA's choice of the investment arbitration forum was also inappropriate due to policy reasons.

The application of the criteria demonstrates that the arbitration between PMA and Australia was inappropriate. This also shows the application of the criteria allows for considerations of the actual risks that may result from forum shopping, such as effects of inefficiency and the dangers of using the ISDS clause to challenge legitimate public interest legislation.

D *Application of the Proposed Criteria to The World Trade Organisation Dispute*

This section will apply the proposed criteria to the WTO dispute against Australia's Plain Packaging legislation as PMI has been involved in lobbying and funding the Dominican Republic's legal representation. In contrast to the Australian investment arbitration, the WTO dispute is an instance of appropriate global forum shopping by PMI primarily because it was convenient and efficient, supported by policy reasons. As a non-determinative factor, the motivation criteria will not be applied as it was not relevant in the dispute. Identifying an appropriate instance of forum shopping demonstrates that the application of the criteria can also allow for the consideration of the benefits that can result from the practice. In this instance, these benefits include the efficient administration of justice and facilitating the development of laws created legitimately for the public interest of health.

Only nation-states have access to the WTO DSB so PMI's indirect involvement with the Dominican Republic does not impact any jurisdiction rules. In fact, the practice of lobbying nation-states to lodge a claim in the WTO DSB is a growing trend among multinational corporations as they seek to advance their interests by influencing the outcomes of negotiation and enforcement in the WTO.[283] The influence of PMI funding the Dominican Republic's legal representation has been evident in the way that the Panel Report has been appealed only by the Dominican Republic and Honduras (who has reportedly been funded by British American Tobacco).[284] This funding seems essential to enable the appeal

[281] Ibid.
[282] As proposed by Voon and Mitchell (n 275) 519.
[283] Eckhardt and De Bièvre (n 261) 507-8.
[284] Status of dispute: 'Dispute Settlement 435: Australia – Certain Measures Concerning Trademarks, Geographical Indications and Other Plain Packaging Requirements Applicable to Tobacco Products and

considering that both nation-states have developing economies and the estimated average expense of a WTO claim is around USD$1 million per year, with this year being the seventh year that proceedings have been ongoing.[285] Finally, the complaint was made under the Dispute Settlement Rules challenging Australia's Plain Packaging laws as being inconsistent with several measures that are regulated by the WTO including TRIPS.[286] As a result, the jurisdictional threshold is fulfilled, making this global forum shop appropriate for the first criteria.

Similarly to the Australian investment arbitration, convenience has a low effect on the parties involved in the WTO DSB. Instead, efficiency has a higher impact and due to the significance of the WTO Panel Report's outcome on the numerous interested third-party nation-states, the WTO claim is perhaps the most efficient forum PMI could have chosen when disputing Plain Packaging legislation. The WTO claim was efficient primarily because it provided an indication of the validity of Plain Packaging legislation before a nation-state decided whether they would enact their own tobacco control laws. The Panel Report's result confirming the legitimacy of Plain Packaging legislation diminished the threat of regulatory chill, reducing the risk that the tobacco industry would litigate. Plus, even if litigation does occur regardless of the WTO Panel Report, the nation-states who choose to proceed will have a clearer indication that the outcome of any litigation is likely to be in favour of allowing the Plain Packaging legislation as the WTO confirmed the interpretation of IP rights exceptions in relation to public health. As Dr Kelly Henning of Bloomberg Philanthropies stated:

> The World Trade Organization's ruling in favour of Australia's plain packaging law is an important victory for public health. It sends a message to tobacco companies worldwide that

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Packaging', *World Trade Organization* (Web Page, 2019) <https://www.wto.org/english/tratop_e/dispu_e/cases_e/ds435_e.htm>; 'Dispute Settlement 441: Australia – Certain Measures Concerning Trademarks, Geographical Indications and Other Plain Packaging Requirements Applicable to Tobacco Products and Packaging', *World Trade Organization* (Web Page, 2019) <https://www.wto.org/english/tratop_e/dispu_e/cases_e/ds441_e.htm>. Where the Dominican Republic is being funded by PMI, Honduras is being funded by British America Tobacco: Eckhardt and De Bièvre (n 261) 396.

[285] Stumberg (n 250) 396. Note that the estimated costs of a WTO claim have been calculated from studies in 2013. As such, the costs could have increased due to inflation since this time. The Dominican Republic and Honduras are listed as developing nations on the International Monetary Fund's World Economic Database: 'World Economic Outlook Database' *International Monetary Fund* (Web Page, April 2019) <https://www.imf.org/external/pubs/ft/weo/2019/01/weodata/weoselco.aspx?g=2200&sg=All+countries+%2f+Emerging+market+and+developing+economies>.

[286] *Plain Packaging Panel Report* (n 240) [1.1]-[1.5]; *Dispute Settlement Rules: Understanding on Rules and Procedures Governing the Settlement of Disputes,* Annex 2 of the Marrakesh Agreement Establishing the World Trade Organization, opened for signature opened for signature 15 April 1994, 1869 UNTS 401 (entered into force 1 January 1995) art 4, 6.

> they can and will be defeated, and it helps create a roadmap for other countries to implement plain packaging laws...[287]

The impact since the WTO Panel Report was released on 28 August 2018 has already had an adverse effect on PMI's regulatory chill strategy as more nation-states have either implemented Plain Packaging laws or strengthened current tobacco control legislation. For example, with the result of the WTO Panel Report reducing the risk of regulatory chill, more developing nations have implemented Plain Packaging laws that are in accordance with FCTC standards. The developing nations which have implemented Plain Packaging laws include Ethiopia,[288] Pakistan,[289] Turkey,[290] Thailand[291] and Uruguay.[292] As the outcome of the WTO Panel Report had an impact on multiple interested nation-states, this dispute was an efficient and appropriate forum to determine the legal issues surrounding Plain Packaging legislation.

The policy criteria also supports that the global forum shop to the WTO was appropriate. As mentioned under the efficiency criteria, the result from the WTO Panel Report has had an impact on the spread of Plain Packaging legislation as the outcome provides more certainty on the way that IP and public health rights interact. This also provides legitimacy to the FCTC which could potentially encourage the WHO to implement similar conventions concerning public health in the future. Providing more certainty that Plain Packaging legislation does not impinge on IP rights was an important legal issue to determine for the

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[287] 'Statement from Bloomberg Philanthropies' Dr. Kelly Henning on the World Trade Organization's Ruling Upholding Plain Packaging Requirements in Australia', *Bloomberg Philanthropies* (Web Page, 28 June 2018) <https://www.bloomberg.org/press/releases/statement-bloomberg-philanthropies-dr-kelly-henning-world-trade-organizations-ruling-upholding-plain-packaging-requirements-australia/>.

[288] Ethiopia passed a suite of tobacco control laws which include Plain Packaging legislation on 5 February 2019: 'Ethiopia: Parliament Passing One of the Strongest Tobacco Control Legislations in Africa', *WHO FCTC Implementation Database* (Web Page, 13 February 2019) <https://untobaccocontrol.org/impldb/ethiopia-parliament-passing-one-of-the-strongest-tobacco-control-legislations-in-africa/>.

[289] On 29 January 2019, Pakistan strengthened health warnings in accordance with article 11 of the FCTC: 'Pakistan: New Pictorial Health Warning on Cigarette Packs', *WHO FCTC Implementation Database* (Web Page, 31 January 2019) <https://untobaccocontrol.org/impldb/pakistan-new-pictorial-health-warning-on-cigarette-packs/>.

[290] Turkey Gazetted Plain Packaging legislation on 5 December 2018: 'Turkey: New Regulations on Plain Packaging', *WHO FCTC Implementation Database* (Web Page, 5 March 2019) <https://untobaccocontrol.org/impldb/turkey-new-regulations-on-plain-packaging/>.

[291] Gazetted on 14 December 2018, the first middle-income nation-state in Asia to adopt Plain Packaging laws: 'Thailand: First Country in Asia to Adopt Tobacco Plain Packaging', *WHO FCTC Implementation Database* (Web Page, 19 December 2018) <https://untobaccocontrol.org/impldb/thailand-first-country-in-asia-to-adopt-tobacco-plain-packaging/>.

[292] Uruguay strengthened measures so laws more in line with FCTC recommendations regarding Plain Packaging laws which came into force on 29 April 2019: 'Uruguay: Adopts Plain Packaging', *WHO FCTC Implementation Database* (Web Page, 29 April 2019) <https://untobaccocontrol.org/impldb/uruguay-adopts-plain-packaging/>.

future development of international treaties that impact IP and human rights. Similarly, there is a public interest in the outcome of the legitimacy of tobacco control laws as it pertains to the reduction of the adverse effects of tobacco products on human health. As such, the policy criteria supports the WTO claim as being an appropriate global forum shop by PMI.

This chapter has applied the criteria of jurisdiction, convenience, efficiency, motives and policy to two instances of global forum shopping by PMI when litigating against Australia's Plain Packaging laws. While the Australian investment arbitration was an inappropriate forum shop, the WTO DSB claim was appropriate. The fact that appropriate and inappropriate forum shopping was identified demonstrates that the application of the proposed criteria can ensure fairness by mitigating the risks of inefficiency to promote the benefits of the efficient administration of justice and positive development of law. Due to the rational choice approach adopted, the criteria does not privilege any biased view of forum shopping. Instead the facts and circumstances of the case can be applied to consider whether the practice was used properly or not by the litigants.

VI Criteria to Identify Appropriate Global Forum Shopping in Transnational Intellectual Property Litigation

The criteria which should be used to determine when global forum shopping can be appropriate has been developed within Chapters IV and V as including jurisdiction rules, convenience, efficiency, motivation and policy. This chapter will propose that these criteria may be used in a way that acknowledges that forum shopping is a rational choice made by litigants. As a result, forum shopping may be perceived to be a strategy which can be used in appropriate and inappropriate ways as it is not inherently undesirable. These criteria may also be utilised to balance the competing interests of the plaintiff and the defendant so that fair outcomes and the efficient administration of justice are promoted. Such an approach towards global forum shopping may be used by the judiciary during the litigation, by policy makers when governing choice of forum rules, by legal representation when advising clients on forum choices and by academics when analysing case law.

A Method of Application for the Proposed Criteria

This section will elaborate on methods for applying the proposed criteria in general transnational IP litigation scenarios. By using a rational choice perspective of forum shopping, these methods aim to balance the defendant's interests in being able to easily defend themselves with the plaintiff's right to choose the forum. This approach may then assist in being an effective way to govern forum shopping by recognising that the litigation process allows for the practice, rather than attempting to eliminate it for the sake of an idealistic positivist legal system.[293]

For the criteria to be applicable, the factual scenario must meet two conditions. The first being an IP legal dispute arising between at least two parties in different nation-states. The second condition is that the plaintiff must have multiple forum choices available on a transnational level. The choice of forum is then selected in accordance to rational choice by the plaintiff to maximise their self-interest after calculating the probability of a favourable outcome. This calculation would be the result of information gathering performed by the plaintiff's legal representation. It should be noted that a lawyer would be discharging their

[293] Kimberly A Moore (n 9) 561; 'Forum Shopping Reconsidered' (n 2) 1686.

professional duties by advising the plaintiff on the available forum choices and which one would provide the greatest likelihood of a successful outcome.[294] After making the choice, the plaintiff initiates proceedings against the defendant and the first criteria of jurisdiction becomes relevant.[295]

Jurisdiction is a threshold requirement. If there is no jurisdiction found, then the connection between the litigation and the court is so exorbitant that the proceedings will be dismissed.[296] This means that the forum shop would also be inappropriate. If jurisdiction is found, then the next criteria may be applied where relevant. It would also mean that the forum shop would be provisionally appropriate pending application of the next criteria. When determining whether there is jurisdiction, other than the relevant legislative rules of the territory, the criteria of efficiency, motives and policy could be used to support a final decision. As has been discussed in *Lucasfilm Ltd v Ainsworth,* the Supreme Court considered that jurisdiction was found as the enforcement of foreign IP would be efficient and also considered that there was no policy reason against providing jurisdiction.[297] Similarly, motives were used to support finding a lack of jurisdiction in *PMA v Australia*.[298]

If jurisdiction is found, then the defendant can also challenge the plaintiff's forum choice on the grounds of inconvenience and inefficiency where relevant. If it is found that the forum choice would result in inconvenience and inefficiency to the extent that it would result in an unjust outcome, then the forum shop is inappropriate. In the reverse, a finding of convenience and efficiency would mean an appropriate forum shop. However, it should be noted that the threshold must be high by necessity as there is always going to be a degree of inconvenience and inefficiency in transnational IP litigation.[299] A test for convenience of the litigants already exists, such as the common law's FNC doctrine. Elements of efficiency are also considered within the doctrine. Utilising the FNC doctrine when applying the convenience factor should continue to be effective as it is an approach which can be applied while balancing the plaintiff and defendant's interests as the judiciary considers the impact

[294] For further discussion on the tension between professional and ethical duties in advising on forum choices, see: Juenger, 'Forum Shopping, Domestic and International' (n 3) 570-3; Maloy (n 3) 60-1; Bassett (n 3) 344; Algero (n 2) 105-8.
[295] Please note that the defendant may also make choices about which forum they could be subject to in the case of a dispute. For example, this may be undertaken by choosing the jurisdictions they seek to perform their business: Ghei and Parisi (n 4) 1385.
[296] Bookman (n 5) 595.
[297] *Lucasfilm Supreme Court Decision* (n 221) 31[91]-[92].
[298] *PMA v Australia* (n 239) 184[585]-[588].
[299] Petsche (n 13) 1014.

of forum choice on the just outcome of the dispute. This may be seen in the way that the transfer of venue provision in the US has a high threshold. For example, the provision has only been granted in the Eastern District of the Texas District Court around seven times since the result of *Genentech.*[300] It should be noted however, that the US approach to the FNC doctrine treats foreign plaintiff's forum choices with less deference than a citizen plaintiff.[301] This approach risks the accurate assessment of the appropriate use of forum shopping as it skews considerations of the actual convenience to the litigants by emphasising the status of the litigant. Such an approach should be remedied in order to ensure that the doctrine may continue to be applied in a way which fairly balances the interests of the litigants based upon assessments of convenience.[302] In comparison, global forum shopping has been assumed to be inefficient by the critics of the practice.[303] Efficiency refers to the use of litigant resources, the length and workload of the courts and the efficient administration of justice.[304] Critics of forum shopping assume that the practice produces waste because determining issues over jurisdiction and appropriate forum increases the length of litigation and resources expended making a decision.[305] There are times that this assumption is correct, seen in the amount of time and resources the litigants in *Piper Aircraft* spent with forum shopping tactics.[306] Despite this, there have also been forum shopping cases which have promoted efficiency such as *Lucasfilm Ltd v Ainsworth* and *Lubbe.*[307] As such, efficiency considerations should consider that global forum shopping can produce waste and facilitate efficient litigation. To assess the degree of inefficiency at risk by forum shopping in a dispute, using the determination of which forum may achieve just outcomes would be effective. This would be consistent with the approach used when applying the FNC doctrine. It would also balance the interests of the litigating parties by allowing forum shopping when it encourages efficiency but mitigating excessive costs which may be caused by the practice.

Motive and policy are non-determinative criteria which may be used to provide support in assessments of the first three criteria. They are to be applied in two instances. The first is if

[300] Anderson (n 63) 675.
[301] *Piper Aircraft* (n 163) 255.
[302] Juenger, 'What's Wrong with Forum Shopping?' (n 5) 13; Bookman (n 5) 631.
[303] Bookman (n 5) 605; Petsche (n 13) 1015-7; Kimberly A Moore and Francesco Parisi, 'Rethinking Forum Shopping in Cyberspace' (2002) 77 *Chicago-Kent Law Review* 1325, 1331; Kimberly A Moore (n 9) 589.
[304] Petsche (n 13) 1015-9; Bookman (n 5) 603-4.
[305] Bookman (n 5) 594, 603; Ghei and Parisi (n 4) 1380; Anderson (n 63) 645.
[306] *Piper Aircraft* (n 163) 240.
[307] *Lucasfilm Supreme Court Decision* (n 221) 19[50]-38[114]; *Lubbe* (n 165).

it is relevant to assist in deciding on whether the court has jurisdiction to proceed with the litigation. The second is if it is required to make a final decision in a situation where determinations of whether the forum shop was appropriate or inappropriate are inconclusive based upon considerations of convenience and efficiency. Motives would only be relevant as an indicator of inappropriate forum shopping in a narrow set of factual situations. While motives may be strategic they would not ordinarily cause the forum shop to become inappropriate as there is a limited connection between motives and the potentially adverse risks of forum shopping.[308] Primarily it is only when the motive negatively impacts upon another determinative criteria that it would be relevant. For example, PMA had an improper motive when restructuring their business because gaining jurisdiction in the Hong Kong-Australia BIT arbitration was their sole purpose.[309] Similarly, the plaintiff's in *Covey Gas* instigated successive litigation which wasted court resources and was inefficient in pursuit of receiving higher compensation.[310] There is also a limitation when applying motives because of the difficulties in obtaining actual evidence of the forum shoppers' reasons for venue choice.[311] Unless a shopper discloses their motive to the court, the evidence would be limited and applying the motive criteria would become an exercise in speculation.[312]

Policy has broader application than motives. There are two factors which may be relevant to consider including public interest reasons and development of law reasons to allow or prevent forum shopping. The first factor relates to the notion of the floodgates where allowing global forum shopping could create more opportunities to shop with the fear being that inappropriate instances of the practice will increase and cause adverse risks to the legal system. This was what the Court of Appeal argued in *Lucasfilm Ltd v Ainsworth* when they reasoned that allowing jurisdiction for enforcement of foreign IP would create too much opportunity for forum shopping.[313] There are also policy reasons for allowing global forum shopping under the public interest factor. This was demonstrated in Chapter V with PMI's global forum shopping strategy in the WTO dispute as the result provided indications for other nation-states that Plain Packaging laws were consistent with international obligations and could be validly implemented. The development of law is the second factor which may

[308] Bookman (n 5) 630; Algero (n 2) 102.
[309] *PMA v Australia* (n 239) 184[584].
[310] *Covey Gas* (n 78).
[311] Thompson (n 24) 303.
[312] There are some exceptions of course. For example, the internal memoranda and legal advice scrutinised by the tribunal throughout *PMA v Australia* (n 239).
[313] *Lucasfilm Court of Appeal Decision* (n 223) [178].

be considered under the policy criteria. The development of law can be a positive effect that may result from global forum shopping.[314] By allowing the global forum shop, it can provide opportunity for the courts or legislature to consider changes in the current laws as the shop reveals anachronistic laws as well as new interpretations in existing laws.[315] This was seen on appeal in *Lucasfilm Ltd v Ainsworth* when the Supreme Court determined that the modern trend in the case law was in favour of enforcing foreign IP rights and that the old *Mocambique* rule which was used by the defendant had been 'eroded over time.'[316] In addition, the Hong Kong-Australia arbitration between PMA and Australia demonstrates how the two factors can overlap. To briefly reiterate what was discussed in Chapter V, the arbitration demonstrated that PMA's use of the ISDS clause could potentially set a dangerous precedent for companies to attack a nation-state's legitimate public interest legislation by global forum shopping in investment arbitrations. As such, there were public interest reasons for preventing the forum shop as it risked further arbitrations based upon undesirable developments in the use of the ISDS provision by multinational corporations.

One of the major concerns of critics of forum shopping is the risk that it causes the inconsistent application of law.[317] The notion that the laws must be consistently applied is a result of ideals from legal positivism.[318] However, the law is subject to different interpretations arising from the influence of social principles meaning that there will always be some inconsistency in the application of the law simply because humans are involved in the process.[319] Additionally, this concern is primarily relevant for domestic rather than global forum shopping.[320] This is because attempting to ensure the consistent application of laws across nation-states in transnational litigation is currently unrealistic. It would require an international harmonised IP legal system which is not feasible because of the lack of political and economic will to create IP standards which every nation-state could agree upon plus be able to implement.[321]

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[314] Bookman (n 5) 616-9.
[315] Ibid 618-9.
[316] *Lucasfilm Supreme Court Decision* (n 221) 36[105], 37[108].
[317] Pestche (n 13) 1017; Opeskin (n 55); Juenger, 'What's Wrong with Forum Shopping?' (n 5) 6; Ferrari (n 74).
[318] Bassett (n 3) 384-91; 'Forum Shopping Reconsidered' (n 2) 1686; Opeskin (n 55) 16.
[319] 'Forum Shopping Reconsidered' (n 2) 1685-6; Bassett (n 3) 384-91.
[320] Bookman (n 5) 597; Petsche (n 13) 1019.
[321] Ferrari (n 74) 690; Bookman (n 5) 601-2. There are also many scholars who argue for or against harmonisation as they debate whether it would be effective for the current IP legal system: see, eg, Dongwook Chun, 'Patent Law Harmonisation in the Age of Globalization: The Necessity and Strategy for a Pragmatic Outcome' (2011) 93 *Journal of Patent and Trademark Office Society* 127, 130; Anna Kingsbury, 'International Harmonisation of Designs Law: The Case for Diversity' (2010) 32(8) *European Intellectual*

In summary, this section has elaborated on five proposed criteria which may be applied to decide whether a global forum shop was appropriate in transnational IP law. The first criteria is applied to determine if the court has jurisdiction over the issue and is a threshold requirement. The criteria of efficiency, motivation and policy may be used to support this decision where they are relevant to the circumstances of the case. If jurisdiction is found, then the defendant may have recourse to challenge whether the court should continue to grant jurisdiction by raising issues of convenience and efficiency. At this stage the territory's requisite tests on convenience such as the FNC doctrine may be applied with further considerations of efficiency. Where relevant, the criteria of motivation and policy may also be applied to provide support in making a definitive decision.

B *Use of the Proposed Criteria in the Current Legal System*

The benefits of applying the criteria is to generate an approach which perceives global forum shopping in transnational IP litigation as a rational strategy that can be used appropriately or inappropriately depending upon the circumstances of the case. This section will discuss what would be required to apply the proposed criteria by the judiciary and policy makers.

This thesis has discussed how forum shopping is just 'one tool among many' for the litigant when rationally choosing between multiple forum options.[322] This means that forum shopping is a reality of the legal system and lawyers will continue to advise their clients to utilise the practice in order to meet their professional duties.[323]As such, forum shopping is a strategy like any other, it can be used properly or abused.[324] However, currently forum shopping is mainly perceived as a practice which can only be used as a way to cheat or rort the legal system and create an unfair advantage for the forum shopper. To overturn this perspective of forum shopping, the courts and policy makers must acknowledge that the practice will continue to be utilised because it is a rational choice and that there is potential for it to be used to facilitate the efficient administration of justice in prescribed

Property Review 382, 395; John F Duffy, 'Harmony and Diversity in Global Patent Law' (2002) 17 *Berkeley Technology Law Journal* 685, 691; Eyal Benvenisti and George W Downs, 'The Empire's New Clothes: Political Economy and the Fragmentation of International Law' (2007) 60 *Stanford Law Review* 595; Weatherall (n 76) 397; Juenger, 'What's Wrong with Forum Shopping?' (n 5) 10; Juenger, 'Forum Shopping, Domestic and International' (n 3) 572-3; Bookman (n 5) 598; Koch (n 3) 295; Petsche (n 13) 1024-5; Mann, Warren and Kennedy (n 75) 116; Yu (n 75) 25; Helfer, 'Forum Shopping for Human Rights' (n 61) 42.

[322] Anderson (n 63) 638.

[323] Maloy (n 3) 25; Algero (n 2) 82; Bassett (n 3) 344; Childress III (n 4) 996; Ghei and Parisi (n 4) 1378.

[324] 'Forum Shopping Reconsidered' (n 2) 1691; Maloy (n 3) 60.

circumstances.[325] The proposed criteria are designed to assist with this approach to forum shopping and it should be feasible to apply the criteria as it builds upon current factors used in case law.

Incorporating the proposed criteria into the legal system could be initiated more effectively by the judiciary than policy makers. This is because the perspective that forum shopping is undesirable is primarily encouraged by policy makers and the legislature.[326] In comparison, Chapters III and IV of this thesis identified when appropriate instances of global forum shopping were found by the judiciary for reasons of jurisdiction rules, motivations of efficiency, providing access to justice as well as policy reasons which promote public interests and developments in the law. As such, the initial source to encourage an approach that perceives both the risks and benefits of forum shopping would be the courts, rather than the policy makers, as they play a significant role in determining when the practice may be used appropriately.[327] Plus, if the courts instigate changes in their approach towards forum shopping, this will avoid a reliance on changing the current political will.[328] To use the criteria in a consistent manner internationally, greater communication between courts would also be required.[329] If the courts begin to implement a clear and consistent approach towards determining when global forum shopping is appropriate, then this will also assist legal representation when advising clients on their forum choice. It would also prevent the future implementation of excessive legislative limits being placed on the plaintiff's right to choose a forum.

C The Impact of Forum 'Shopping' or 'Selection' on the Application of the Proposed Criteria

As discussed in Chapter I, distinguishing the difference between forum selection and forum shopping is difficult but developments in the terminology's usage could affect the way that the criteria proposed in this thesis is applied. Some of the literature argues that all forum shopping is inappropriate and anytime the judiciary allows the plaintiff's forum choice it is actually an appropriate forum selection rather than an appropriate forum shop.[330] This view

[325] 'Forum Shopping Reconsidered' (n 2) 1687; Maloy (n 3) 25; Bassett (n 3) 382-3.
[326] 'Forum Shopping Reconsidered' (n 2) 1680-1; Bassett (n 3) 391; Algero (n 2) 87.
[327] Bookman (n 5) 629; Anderson (n 63) 677.
[328] Helfer, 'Forum Shopping for Human Rights' (n 61) 391-2.
[329] Childress III (n 4) 1043; Bookman (n 5) 629-634; Maloy (n 3) 60-1.
[330] Maloy (n 3) 28; Petsche (n 13) 1008. For more detailed discussion of the definitions of forum shopping versus forum selection, refer above to Chapter I(A).

supports a narrower definition of forum shopping than was used throughout this thesis. Nevertheless, it would be possible to alter the use of the proposed criteria to form the basis of a test to distinguish between appropriate forum selection and inappropriate forum shopping. There are persuasive arguments however, that distinguishing between forum shopping and forum selection is impossible because they are essentially the same practice.[331] As such, development in the use of terminology could eliminate the use of forum shopping altogether and replace it with appropriate and inappropriate forum selections. This could also assist in removing the pejorative connotation that has traditionally been attached to forum shopping. Considering that the direct reference to forum shopping within case law has decreased in usage even as a derogatory term, eliminating its use could be a feasible development. For example, forum shopping was definitely present in *Piper Aircraft* but the term was only used twice throughout the whole judgement, one in reference to another case and another in the footnotes to say that any 'reverse forum-shopping' engaged in by the defendant was irrelevant.[332] Similarly, there were no references of forum shopping in *Genentech*, yet both cases were dismissed from the court the plaintiff chose as it was seen to be an inappropriate selection.[333] The criteria would continue to be relevant to determine appropriate and inappropriate forum selection rather than forum shopping as it is only a matter of changing the terminology. For either use of the terms, the criteria proposed in this thesis may still be useful to identify appropriate instances of forum choice while acknowledging but not condemning the likelihood that the choice is made in the hope that it will influence a positive outcome in the litigation.

This chapter has summarised how the proposed criteria should be applied by balancing the interests of the litigants to enable the benefits and mitigate the risks caused by forum shopping on the legal system. These criteria are an attempt to provide an approach which acknowledges that litigants will choose a forum that will maximise their self-interests when a choice is available. As the criteria builds upon current judicial approaches, application of the criteria could realistically be utilised in the current legal system to identify appropriate and inappropriate forum choices.

[331] 'Forum Shopping Reconsidered' (n 2) 1677; Bassett (n 3) 342; Bookman (n 5) 590; Ryan (n 16) 203.
[332] *Piper Aircraft* (n 163) 253 n 19, 254.
[333] *Genentech* (n 140).

VII CONCLUSION

Forum shopping has traditionally been used as a derogatory term to condemn a litigant's strategic choice of forum. However, since the twenty-first century an emerging group of scholars have reconsidered the positive benefits of the practice and acknowledge that like any litigant's strategy, forum shopping can be used properly or abused. This shift in the scholarship has coincided with a focus on the analysis of the benefits and risks of forum shopping in transnational litigation. Due to the innovations in modern technology the necessity to enforce IP rights across multiple territories have increased, causing a commensurate increase in opportunities for global forum shopping in IP disputes. Despite this, there has been a lack of literature considering forum shopping in transnational IP litigation. This thesis has sought to address this gap by considering the type of criteria that should be used by the judiciary when determining whether forum shopping has been appropriately used by litigants in a transnational IP case. It has been argued that criteria may be identified and built upon from existing case law which may be applied when considering whether forum shopping's use was appropriate. These criteria include jurisdiction rules, convenience, efficiency, motivations and policy. This chapter will conclude by considering how the criteria may be improved upon by researching the merits of an international regulatory framework and summarising the proposed criteria which this thesis recommends to improve the governance of global forum shopping.

Increasing the consistency of the application of law in transnational litigation is a concern for critics who argue that forum shopping encourages the inconsistent application of law and is an area which warrants further research. As discussed in Chapter IV, there are divergent domestic jurisdiction laws between nation-states. Considerations of consistency of jurisdiction rules in transnational litigation is important as it impacts the forum choices available to litigants and can control the amount of opportunity for litigants to engage in appropriate forum shopping.[334] As such, while the proposed criteria are flexible enough to apply different domestic jurisdiction laws, a regulatory framework on jurisdiction in transnational litigation could assuage concerns about the inconsistent application of law without requiring this factor to become a criteria. Achieving consistent jurisdiction rules have stalled negotiations of the Hague Convention on Jurisdiction and Foreign Judgments

[334] Childress III (n 4) 1010.

in Civil and Commercial Matters ('the Hague Convention').[335] Dreyfuss and Ginsburg have proposed that a specific framework for transnational IP litigation would be more effective than the Hague Convention as it would be tailored towards specific concerns that arise in IP litigation. Plus, it would be more likely to achieve consensus for enactment as it is not as broad as the Hague Convention.[336] Such an approach could be effective as the draft convention proposed by Dreyfuss and Ginsburg specifies rules for forum choices that would encourage consistency but still allow opportunities for appropriate forum shopping.[337] Similarly, there are some differences in the way that the FNC doctrine is applied across common law systems. Dreyfuss and Ginsburg propose using the US model however,[338] the bias against foreign litigants and emphasis on the more appropriate forum rather than convenience has its own issues. This is especially evident when comparing the FNC doctrine to civil law determinations of convenience which place more emphasis on the following the plaintiff's first forum choice over the most appropriate forum.[339] A regulatory convention could potentially create more consistency by codifying a single method of considering convenience however, reconciling these two approaches is a difficult task to achieve which is evident by the fact that it is an obstacle in the Hague Convention negotiations.[340] Due to these issues, researching an effective regulatory model to increase the consistency of jurisdiction laws in transnational litigation would be beneficial.[341]

In such a context, this thesis proposes criteria which may be used to govern an approach to global forum shopping which allows for the identification and use of appropriate instances of the practice in transnational IP litigation. An appropriate use of forum shopping occurs when the impact of the benefits caused by the practice on the litigants outweighs the risks and assessments that a just outcome in the chosen forum can eventuate. Due to the historical

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[335] Rochelle C Dreyfuss and Jane C Ginsburg, 'Draft Convention on Jurisdiction and Recognition of Judgments in Intellectual Property Matters' (2002) 77 *Chicago-Kent Law Review* 1065, 1065; Brand (n 66) 468.
[336] Dreyfuss and Ginsburg (n 335) 1065-1067.
[337] Ibid 1069.
[338] Ibid 1071.
[339] Brand (n 66) 468.
[340] Ibid.
[341] Scholars have considered the harmonisation of IP laws rather than a regulatory framework as being an alternative solution to decreasing the inconsistent application of law and inappropriate forum shopping: Chun (n 321) 130; Benvenisti and Downs (n 321); Weatherall (n 76) 397; Graeme B Dinwoodie, 'The Integration of International and Domestic Intellectual Property Lawmaking' (1999) 23 *Columbia-VLA Journal of Law and the Arts* 307. However, harmonisation is highly unlikely to restrict inappropriate forum shopping as it would still be available to litigants due to procedural differences between forums and divergent interpretations of the law: Weatherall (n 76) 397. See also Petsche (n 13) 1024-5; Juenger, 'What's Wrong with Forum Shopping?' (n 5) 10; Juenger, 'Forum Shopping, Domestic and International' (n 3) 572-3; Bookman (n 5) 598; Koch (n 3) 295; Mann, Warren and Kennedy (n 75) 116; Ferrari (n 74) 690.

use of the term ‘forum shopping’ to refer to undesirable forum choices, this thesis takes a rational choice approach to dispel the assumption that the practice is inherently undesirable. Instead, rational choice theory was used as a tool to perceive forum shopping as a litigation strategy which may be used appropriately or abused. An analysis of the literature and evolution of the early case law between 1940-80 identifies that the risks which may result from global forum shopping are unfairness, inconvenience and waste. Comparatively, the benefits resulting from the practice include access to justice, efficiency and developments in the law. Using this analysis, the recent case law shows the current factors the judiciary utilise in their determinations on whether to allow a litigant’s forum choice or not. These factors form the basis of the proposed criteria to identify appropriate instances of forum shopping. This thesis recommends that the criteria include the rules of jurisdiction to control forum choices, the convenience of the litigants, the costs which effect the efficient resolution of the dispute, the rationality underlying the motivation of the litigants and policy considerations of public interests as well as developments in law. It is submitted that the proposed criteria provide a foundation for judiciary and policy makers to use in developments on more effective ways to govern global forum shopping. The approach allows for considerations that the practice will be used by a rational litigant while ensuring fairness by balancing the interests of the plaintiff and defendant.

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