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United States District Court
Northern District of California

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

INTELLISOFT, Ltd,
Plaintiff,
v.
ACER AMERICA CORPORATION, et
al.,
Defendants.

Case No. 17-cv-06272-PJH

**ORDER DENYING PLAINTIFF'S
MOTION TO REMAND**

Re: Dkt. No. 21

Plaintiff Intellisoft, Ltd's ("Intellisoft") motion to remand came on for hearing before this court on January 10, 2018. Plaintiff appeared through its counsel, Andrew Spielberg. Defendants and counterclaimants Acer America Corporation and Acer Inc. (together, "Acer") appeared through their counsel, Matthew Ball. Having read the papers filed by the parties and carefully considered their arguments and the relevant legal authority, and good cause appearing, the court hereby DENIES plaintiff's motion to remand, for the following reasons.

BACKGROUND

A. Procedural Background

On March 21, 2014, Bruce Bierman and Intellisoft filed this action in the Superior Court of the State of California for the County of Marin. On October 22, 2014, the Marin County Superior Court transferred the case to the County of Santa Clara. In May 2015, Bierman assigned to Intellisoft any and all interest and substantive rights he had to the intellectual property relevant to this case. Dkt. 1-1 ¶ 13. Bierman dismissed himself from the case that same month. On September 25, 2017, Intellisoft filed the operative Fourth

1 Amended Complaint (the “complaint”).

2 Intellisoft alleges that in the early 1990s Bierman shared with engineers at Acer
3 America Corporation pursuant to a non-disclosure agreement certain purported trade
4 secrets related to computer power management. Intellisoft further alleges that in January
5 1992, Acer used those ideas without Bierman’s knowledge or permission in applying for
6 and later obtaining U.S. Patent No. 5,410,713, “Power Management System for a
7 Computer,” (“the ’713 Patent”), as well as three later continuations of that patent
8 (collectively, the “’713 Family of Patents” or the “patents”).

9 The alleged trade secrets relate to a “smart computer power supply” that allows
10 computer manufacturers to manage and control power in a computer by implementing a
11 second “smart” standby low power supply coupled to a pushbutton power switch
12 (eliminating the wall-switch type on/off) and a microprocessor and other components to
13 control power to the computer’s main switchable power supply. Intellisoft also
14 purportedly developed software that interacted with this mechanism to provide enhanced
15 PC wake up and shutdown process and procedures, and the ability to control other
16 system states. See Dkt. 1-1 ¶ 42.

17 The operative complaint asserts four causes of action for: (1) misappropriation of
18 trade secrets, (2) intentional misrepresentation and concealment, (3) breach of contract—
19 non-disclosure agreement, and (4) accounting. The parties agree that causes of action 2
20 and 4 depend on causes of action 1 and 3.

21 Since its filing in March 2014, the case has been actively litigated, including
22 multiple motions to dismiss and multiple summary judgment motions. Prior to removal,
23 the parties had completed fact discovery and expert discovery was nearing completion.
24 Defendants’ removal and the present motion to remand arise directly from expert
25 disclosures and depositions that occurred in September and October 2017—
26 approximately one month before the state court’s November 13, 2017 expert discovery
27 deadline expired.

28 Trial was set to begin in state court on November 28, 2017.

1 **B. Expert Discovery Background**

2 On March 8, 2017, Intellisoft served its expert disclosure. As relevant here, the
3 disclosure described in general terms what plaintiff's experts would opine upon. As
4 relevant here, the disclosure stated that Irving Rappaport "may be called to testify on
5 issues pertaining to liability and damages," Bob Zeidman "may be called to testify on
6 issues pertaining to liability and damages," and Brian Napper "may be called to testify on
7 damages." Ex. 5 at 3-4.

8 In late September 2017, defendants received Rappaport's and Zeidman's expert
9 reports. Exs. 7, 9. On October 11 and 20, 2017, defendants deposed Zeidman and
10 Rappaport, respectively. On October 27, 2017, three days before this case was
11 removed, defendants received Napper's expert report. Ex. 14.

12 Between Rappaport's expert report and deposition, defendants learned for the first
13 time that Rappaport would testify on inventorship, patentability, and validity. For
14 example, Rappaport's expert report states that "Mr. Bierman should have been named as
15 a co-inventor of the '713 patent . . . [and] arguable that Mr. Bierman was the sole inventor
16 of the '713 patent family for all the reasons presented" in the Rappaport's expert report.
17 Ex. 7 at 33. Rappaport also opined that the "trade secret and confidential information
18 described in the '713 Family of Patents, were created by Mr. Biermand on behalf of
19 Intellisoft, Ltd." Id. at 9. During his deposition, Rappaport confirmed that it was his
20 opinion that under federal law Bierman should have been named as an inventor and that
21 he intended to testify to that effect at trial. Ex. 8 at 18:6-19:8. Rappaport also opined on
22 the '713 Family of Patents validity and patentability under federal law. Ex. 7 at 8-9.

23 In Zeidman's report, Ex. 9, supplemental report (filed October 10, 2017), Ex. 11,
24 and deposition, Ex. 13, Zeidman compared the purported trade secrets to the '713 Family
25 of Patents and opined that the patents included plaintiff's trade secrets. See, e.g., Ex. S;
26 see also generally Exs. 9, 11, 13. Zeidman's expert reports also attached 28 separate
27 claim charts, each one analyzing whether an industry standard "read on" the '713 Family
28 of Patents or necessarily used plaintiff's trade secrets. See, e.g., Ex. 10 and 12. In

1 performing this analysis, Zeidman construed the scope and meaning of claims within the
2 '713 Family of Patents. See Id. As relevant here, Zeidman concluded that computers
3 using the ACPI¹ industry standard necessarily used the '713 Family of Patents. Ex. 10 at
4 35, Ex. 11 ¶ 16; Ex. 12 at 2, Ex. 13 at 332:23-333:9. Accordingly, it is Zeidman's opinion
5 that computers using the ACPI industry standard incorporate plaintiff's trade secrets.
6 Ex. 13 at 366:3-6.

7 Lastly, Napper's expert report states that Intellisoft is entitled to royalty damages
8 based on every Acer ACPI-compliant computer sold since 1997. See, e.g., Ex. 14 ¶¶ 8-
9 10, 20. Napper's calculation expressly relies on Zeidman's and Rappaport's analysis,
10 including Zeidman's conclusion that ACPI compliant computers use the '713 Family of
11 Patents (and, therefore, plaintiff's trade secrets) and Rappaport's inventorship opinion.
12 Ex. 14 ¶¶ 8-10, 19, 20.

13 **C. Removal Background**

14 On October 30, 2017, in response to these reports and depositions, defendants
15 filed a cross-complaint in state court naming Bierman and plaintiff. That cross-complaint
16 sought a declaratory judgment under the Federal Declaratory Judgment Act and 35
17 U.S.C. § 256 that Bierman should not be a named inventor on any of the patents in the
18 '713 Family. Ex. 15.² However, defendants' cross-complaint did not become operative
19 because under the California Code of Civil Procedure a party must obtain leave of court
20 to file a cross-complaint unless the party has not filed an answer or the court has not yet
21 set a date for trial. Cal. Code of Civ. P. § 428.50. Because defendants had neither
22 moved nor obtained leave of court, the cross-complaint was deemed "lodged." Ex. D.

23 Also on October 30, 2017, shortly after the cross-complaint was "lodged" with the
24

25 ¹ ACPI is a power management standard developed by a consortium of companies, led
26 by Microsoft and Intel Corporation. Dkt. No. 20, 5 n.1, First Amended Counterclaim. The
27 standard was first released in December 1996 and became the industry-wide power
28 management standard. Id. Acer began designing computers that complied with the
ACPI standard after its release in late 1996. Id.

² As discussed in detail below, § 256 authorizes federal judicial resolution of inventorship
contests over issued patents. 35 U.S.C. § 256.

1 state court, defendants removed the case to this court. In their removal papers,
2 defendants claimed removal was proper under 28 U.S.C. §§ 1338 & 1441 and,
3 alternatively, proper under 28 U.S.C. § 1454. See Dkt. 1. Defendants claim removal was
4 proper under § 1441 because under § 1338(a) federal district courts of the United States
5 have original and exclusive jurisdiction “over any claim for relief arising under any Act of
6 Congress relating to patents.” 28 U.S.C. § 1338(a). Defendants’ notice of removal
7 argued that plaintiff’s misappropriation of trade secrets theory arises under an Act of
8 Congress relating to patents because it necessarily raises the patent issue of
9 inventorship, which is a claim arising under federal patent law—specifically, 35 U.S.C. §
10 256. See Dkt. 1 ¶¶ 10-15.

11 Second, defendants claimed removal was proper under § 1454 based on
12 defendants’ cross-complaint seeking declaratory relief that Bierman was properly not
13 named as an inventor of the ’713 Family of Patents. Dkt. 1 ¶ 16.

14 The notice of removal also argues that though litigation began over three years
15 ago, the case was timely removed because the notice of removal was filed 30 days after
16 receipt of “other paper”—the expert reports—that put defendants on notice that the case
17 is one that had become removable. 28 U.S.C. § 1446(b)(1), (3) (“[I]f the case stated by
18 the initial pleading is not removable, a notice of removal may be filed within thirty days
19 after receipt by the defendant . . . [of] other paper from which it may first be ascertained
20 that the case is one which is or has become removable.”).

21 On November 20, 2017, after removal, defendants timely filed a First Amended
22 Counterclaim in this court. Dkt. 20. That counterclaim repeats the inventorship and
23 declaratory judgment allegations, but also includes numerous allegations based on
24 plaintiff’s experts’ testimony regarding “other federal patent law issues” plaintiff will
25 allegedly argue at trial, namely claim construction, infringement, validity, and
26 patentability. See Dkt. 20 ¶¶ 16-26.

27 Plaintiff filed the present motion to remand on November 27, 2017.

DISCUSSION

1 **A. Legal Standard**

2 A defendant may remove a civil action filed in state court if the action could have
3 originally been filed in federal court. 28 U.S.C. § 1441. Federal courts are courts of
4 limited jurisdiction, possessing only that power authorized by the Constitution and statute.
5 Kokkonen v. Guardian Life Ins. Co. of America, 511 U.S. 375, 377 (1994). A plaintiff may
6 seek to have a case remanded to the state court from which it was removed if the district
7 court lacks jurisdiction or if there is a defect in the removal procedure. 28 U.S.C.
8 § 1447(c). The district court must remand the case if it appears before final judgment
9 that the court lacks subject matter jurisdiction. Id.

10 The removal statutes are construed restrictively, so as to limit removal jurisdiction.
11 See Shamrock Oil & Gas Corp. v. Sheets, 313 U.S. 100, 108-09 (1941). There is a
12 “strong presumption” against removal jurisdiction. Gaus v. Miles, Inc., 980 F.2d 564, 566
13 (9th Cir. 1992). This means that the burden of establishing federal jurisdiction for
14 purposes of removal is on the party seeking removal. Hunter v. Philip Morris USA, 582
15 F.3d 1039, 1042 (9th Cir. 2009). Doubts as to removability are resolved in favor of
16 remanding the case to state court. Matheson v. Progressive Specialty Ins. Co., 319 F.3d
17 1089, 1090 (9th Cir. 2003).

18 Federal courts have original and exclusive jurisdiction in “any civil action arising
19 under any Act of Congress relating to patents.” 28 U.S.C. § 1338(a). “Under the well-
20 pleaded complaint rule, . . . whether a claim arises under patent law must be determined
21 from what necessarily appears in the plaintiff’s statement of his own claim . . . , unaided by
22 anything alleged in anticipation or avoidance of defenses which it is thought the
23 defendant may interpose.” Christianson v. Colt Indus. Operating Corp., 486 U.S. 800,
24 809 (1988).

25 A case can “arise under federal law” in two ways. Gunn v. Minton, 568 U.S. 251,
26 256-58 (2013). First, “a case arises under federal law when federal law creates the
27 cause of action asserted.” Id. at 257. This “creation test” “accounts for the vast bulk of
28 suits that arise under federal law[.]” Id. (citation omitted). Second, even when a claim

1 “finds its origins in state rather than federal law,” the claim nevertheless arises under
2 federal law where it “necessarily raise[s] a stated federal issue, actually disputed and
3 substantial, which a federal forum may entertain without disturbing any congressionally
4 approved balance of federal and state judicial responsibilities.” Id. at 257-58.

5 Section 1454 of Title 28 provides an independent additional avenue of removal.
6 That section allows removal of any “civil action in which any party asserts a claim for
7 relief arising under any Act of Congress relating to patents.” 28 U.S.C. § 1454. This
8 provision was “intended to provide federal courts . . . with a broader range of jurisdiction;
9 that is, with jurisdiction over claims arising under the patent laws even when asserted in
10 counterclaims, rather than in an original complaint.” Vermont v. MPHJ Tech.
11 Investments, LLC, 803 F.3d 635, 644 (Fed. Cir. 2015) (emphasis in original).

12 Under either removal statute, defendants removal must comply with § 1446(b)(1),
13 which requires defendants to remove state-court actions to federal court within thirty days
14 of receiving an initial pleading or other document that reveals a basis for removal. Jordan
15 v. Nationstar Mortg. LLC, 781 F.3d 1178, 1179 (9th Cir. 2015). However, the Ninth
16 Circuit has explained that

17 Section 1446(b) is triggered upon the receipt by the
18 defendants of a paper in the action from which removability
19 may be ascertained. For obvious reasons, we don't charge
20 defendants with notice of removability until they've received a
21 paper that gives them enough information to remove.
22 Because the focus remains on whether the case ‘is or has
23 become removable,’ counsel’s clairvoyant sense of what
24 actions a plaintiff might take plays no role in the analysis.
25 Under this approach, a defendant is not put to the impossible
26 choice of subjecting itself to fees and sanctions by filing a
27 premature (and baseless) notice of removal or losing its right
28 to remove the case by waiting too long.

Chan Healthcare Grp., PS v. Liberty Mut. Fire Ins. Co., 844 F.3d 1133, 1142 (9th Cir.
2017) (internal citations and quotation marks omitted).

26 **B. Analysis**

27 As explained below, the court holds that under the facts of this case the court has
28 subject matter jurisdiction and that defendants’ removal was proper under §§ 1338 &

1 1441 and, alternatively, under § 1454. Accordingly, the court DENIES plaintiff's motion to
2 remand.

3 The court's holding is based on the specific facts and procedural history of the
4 case, as well as the theory plaintiff intends to advance at trial. Specifically, the court
5 understands that plaintiff intends to argue and show at trial that Bierman conceived of
6 and disclosed to Acer engineers, pursuant to a non-disclosure agreement, many of the
7 ideas eventually published in Acer's 1992 '713 patent application. In support, Rappaport
8 and Zeidman will testify to that effect on direct examination. Further, Rappaport, during
9 his deposition, testified that at trial he planned to testify that under federal patent law
10 Bierman should have been a named inventor of the '713 Family of Patents.

11 Additionally, in support of plaintiff's theory, Rappaport will also testify, and
12 Rappaport's expert report states, that the patents met federal law's definition for validity
13 and patentability. Plaintiff intends to use that opinion as evidence that the publication of
14 the patent disclosed, for the first time, Bierman's trade secrets.

15 For his part, Zeidman will opine, and his expert report already opines, that the '713
16 Family of Patents includes and discloses the purported trade secrets. Zeidman also will
17 and has already opined that Acer's ACPI compliant computers use the '713 Family of
18 Patents. Zeidman's opinion is based on his interpretation of the ACPI industry standard
19 and his construction of the '713 Family of Patents.

20 Based on Zeidman's and Rappaport's testimony, Napper will testify that plaintiff is
21 entitled to royalty-based damages for each ACPI-compliant Acer computer. A 1990
22 licensing agreement between plaintiff and defendants informs this calculation.

23 The court finds that the above theory, the only one plaintiff has advanced in its
24 briefing and not disclaimed during the hearing, necessarily raises at least two patent
25 issues.

26 First, plaintiff's argument that the patents use and disclose plaintiff's trade secrets
27 necessarily calls into question the named inventors of the '713 Family of Patents. During
28 the hearing on this motion and throughout the briefing, plaintiff carefully stated that on

1 direct examination plaintiff's counsel will not ask its experts to discuss whether Bierman
2 should have been a named inventor under the federal patent laws. Similarly, plaintiff
3 states that neither it nor Bierman seeks to be named as an inventor of the '713 Family of
4 Patents. Indeed, if plaintiff planned to do either of the above, then there would be no
5 question that the case belonged in federal court.

6 However, plaintiff's attestations alone do not remove the question of inventorship.
7 "Conception is the touchstone of inventorship, the completion of the mental part of the
8 invention." Burroughs Wellcome Co. v. Barr Laboratories, Inc., 40 F.3d 1223, 1227-28
9 (Fed. Cir. 1994). Plaintiff's entire theory is based on the argument that the patented
10 invention contains trade secrets conceived of by Bierman. This necessarily challenges
11 the propriety of the '713 Family of Patents' named inventors, who Acer argues and,
12 apparently showed in its patent application, conceived of the '713 Family of Patents. By
13 the same token, Rappaport's opinion that Bierman created and owns the trade secrets
14 contained in the '713 Family of Patents necessarily reaches the issue of "who invented or
15 discovered the subject matter of the invention." 35 U.S.C. § 100(f) (defining inventor).

16 Further, though a defense is not sufficient to create subject matter jurisdiction, if
17 this case remained in state court, defendants will inevitably argue that under federal law
18 the inventors were correctly named. Plaintiff's carefully crafted declarations reveal that
19 on cross-examination, plaintiff will ask Rappaport to opine on who should have been a
20 named inventor under Title 35. At that point, a fully-fledged inventorship dispute would
21 be before a state court. Defendants' § 256 counterclaim seeking a declaration on
22 inventorship recognizes this reality.

23 Second, Zeidman's analysis raises federal patent law issues. Zeidman's analysis
24 compares the purported trade secret to the '713 Family of Patents. Though plaintiff
25 asserts otherwise, Zeidman's analysis entails construing claims within and the scope of
26 the '713 Family of Patents. See, e.g., Ex. S. The same goes for Zeidman's comparison
27 between the '713 Family of Patents and ACPI. See Ex. 12.

28 On the other hand, the court does not agree that plaintiff's theory necessarily

1 raises issues of validity and patentability. Plaintiff intends to use Rappaport's opinion on
2 the validity of the patents as evidence that the trade secrets were not in the public
3 domain. Neither validity nor patentability is the exclusive method of proving that
4 contention. In fact, even if the patent were invalid or the invention not patentable, plaintiff
5 may still be able to show that the '713 patent application disclosed the trade secrets at
6 issue.

7 Similarly, Napper's damages analysis, despite defendants' characterization of it as
8 "patent-like," does not necessarily raise any patent issue. Plaintiff's theory that it is
9 entitled to unjust enrichment damages based on defendants' disclosure of plaintiff's trade
10 secrets and benefit from that disclosure, does not necessarily raise any patent issues.
11 Plaintiff can attempt to show damages based on defendants' conduct using any theory it
12 wishes. That plaintiff chooses to do so using a royalty theory based on a decades old
13 licensing agreement does not raise a patent issue. See Aronson v. Quick Point Pencil
14 Co., 440 U.S. 257, 262 (1979); Ex. T ¶ 14.

15 This, however, does not undercut the fact that Napper's damages analysis
16 necessarily assumes that Bierman is the sole inventor. Ethicon, Inc. v. U.S. Surgical
17 Corp., 135 F.3d 1456, 1466 (Fed. Cir. 1998) (holding that joint inventors each have rights
18 to the entire patent). This underscores that the inventorship issue is not just an alternate
19 theory that plaintiff might use to show liability and damages. Instead, it is plaintiff's only
20 theory of its case.

21 Plaintiff does not convincingly argue otherwise. Though plaintiff implies other
22 theories might be used, plaintiff never comes close to describing a different theory of
23 liability that does not necessarily raise at least the inventorship, infringement, and claim
24 construction issues described above. Plaintiff disavows only that neither plaintiff nor
25 Bierman "seek to be declared as an inventor as that term is defined in Title 35 of the
26 United States Code by any tribunal or by the [United States Patent and Trademark Office]
27 on any patent." Dkt. 21, Spielberger Decl. at ECF pp. 32-33 (emphasis added); Dkt. 28,
28 Bierman Decl. at ECF pp. 27-28. Plaintiff's reply does little better, stating only that on

1 direct examination plaintiff will not ask its experts to opine on who should have been
2 named as an inventor under federal patent law. See, e.g., Dkt 28 at 3; see also Dkt. 28,
3 Spielberg Reply Decl. ¶ 4. As discussed above, this is insufficient to side-step the
4 inventorship issues in this case. During the hearing on this motion, the court provided
5 plaintiff numerous chances to disavow the federal patent law inventorship dispute.
6 Plaintiff declined.

7 Further, neither the briefing nor the declarations assert that plaintiff will not rely at
8 trial on Zeidman's interpretation of the trade secrets, ACPI, or the '713 Family of Patents.
9 And it appears plaintiff's theory of the case would fall apart were plaintiff to do so.

10 With the above as a backdrop, the court next determines whether it has subject
11 matter jurisdiction and whether defendants properly removed the case to this court.

12 **1. Removal Was Proper Under Sections 1338(a) and 1441.**

13 Federal courts have original and exclusive jurisdiction in "any civil action arising
14 under any Act of Congress relating to patents." 28 U.S.C. § 1338(a). Here, plaintiff
15 asserts only state law causes of action. Thus, this court has jurisdiction under § 1338
16 only if defendants establish each of the elements articulated by the Supreme Court in
17 Gunn. The case must "present[] a patent issue that is '(1) necessarily raised, (2) actually
18 disputed, (3) substantial, and (4) capable of resolution in federal court without disrupting
19 the federal-state balance approved by Congress.'" Jang v. Boston Sci. Corp., 767 F.3d
20 1334, 1336 (Fed. Cir. 2014) (quoting Gunn).

21 **a. Patent Issues Are Necessarily Raised.**

22 If a claim "can be supported by alternative and independent theories—one of
23 which is a state law theory and one of which is a federal law theory—federal question
24 jurisdiction does not attach because federal law is not a necessary element of the
25 claim." Rains v. Criterion Sys., Inc., 80 F.3d 339, 346 (9th Cir. 1996). However, "the
26 court's job is not to focus on the prima facie elements of the state cause of action." Baker
27 v. Tait, No. 3:16-CV-00236, 2017 WL 2192965, at *2 (D. Alaska May 18, 2017); see also
28 Gunn, 568 U.S. at 259 (noting the prima facie elements of a legal malpractice claim

1 under Texas law, but holding that the plaintiff's particular claim necessarily raised a
2 federal issue because the court would be required to apply federal patent law to the facts
3 of the case). Instead, the court must determine if the claim itself, as brought in each
4 particular case "actually turn[s] on construction of [a] federal law." El Camino Hospital v.
5 Anthem Blue Cross of Cal., No. 5:14-cv-00662, 2014 WL 4072224, at *3 (N.D. Cal. Aug.
6 14, 2014); see also Christianson, 486 U.S. at 810 ("[A] claim supported by alternative
7 theories in the complaint may not form the basis for § 1338(a) jurisdiction unless patent
8 law is essential to each of those theories.").

9 As described above, the only theory plaintiff has advanced necessarily raises at
10 least two federal patent law issues. First, plaintiff's theory requires a showing that
11 Bierman conceived of the ideas in the '713 Family of Patents. This boils down to an
12 inventorship dispute. Second, Zeidman's analysis amounts to testimony about how the
13 claims within the '713 Family of Patents should be construed and whether Acer's use of
14 the ACPI standard necessarily used the '713 Family of Patents. Claim construction is a
15 federal patent issue. See generally Markman v. Westview Instruments, Inc., 517 U.S.
16 370, 372 (explaining that the final interpretation on a patent's scope and meaning is
17 within "the exclusive province of the court[s]"). Moreover, because Zeidman's theory
18 compares the ACPI standard to the '713 patents, rather than the trade secrets
19 themselves, it is only applicable if Bierman should have been named as an inventor or
20 coinventor on the '713 Family of Patents.

21 Plaintiff's repeated assertion that neither plaintiff nor Bierman "seek to be declared
22 as an inventor as that term is defined in Title 35 of the United States Code", see, e.g.,
23 Dkt. 21, Spielberg Decl. at ECF 32-33, amounts only to a reiteration that the complaint
24 does not assert a federal cause of action. That does not address whether plaintiff's state
25 causes of action raise federal issues—the very point of the Gunn test.

26 Plaintiff also argues that there is no federal issue of inventorship because § 256 is
27 unavailable to plaintiff or Bierman. Plaintiff's first iteration of this argument claims that
28 because the trade secrets were misappropriated by defendants' fraudulent conduct, there

1 is no remedy under § 256. That argument relies on an outdated version of § 256.

2 Section 256 as amended states (with deletions struck and additions underlined):

3 (a) Correction.--Whenever through error a person is named in
4 an issued patent as the inventor, or through error an inventor
5 is not named in an issued patent ~~and such error arose without~~
6 ~~any deceptive intention on his part~~, the Director may, on
7 application of all the parties and assignees, with proof of the
8 facts and such other requirements as may be imposed, issue
9 a certificate correcting such error.

10 (b) Patent Valid if Error Corrected.--The error of omitting
11 inventors or naming persons who are not inventors shall not
12 invalidate the patent in which such error occurred if it can be
13 corrected as provided in this section. The court before which
14 such matter is called in question may order correction of the
15 patent on notice and hearing of all parties concerned and the
16 Director shall issue a certificate accordingly.

17 35 U.S.C. § 256. Thus, § 256 covers corrections regardless of deceptive intent
18 allegations.

19 The other iterations of plaintiff's § 256 argument also fail. Contrary to plaintiff's
20 assertion, "[n]othing in the statute governing a court's power to correct inventorship . . .
21 prevents a court from correcting the inventorship of an unenforceable patent." Frank's
22 Casing Crew & Rental Tools, Inc. v. PMR Techs., Ltd., 292 F.3d 1363, 1377 (Fed. Cir.
23 2002). The same is true for expired patents. See, e.g., Schreiber v. Eli Lilly & Co., No. 5-
24 cv-2616, 2007 U.S. Dist. LEXIS 40884, at *16 (E.D. Penn. Mar. 19, 2007) (discussing
25 § 256 breadth and holding that § 256 permits correction of inventorship of surrendered
26 patents); Magnetar Techs. Corp. v. Six Flags Theme Parks Inc., No. 07-127, 2017 U.S.
27 Dist. LEXIS 121148, at * 9-10 (D. Del. Aug. 2, 2017) ("Section 256 has no limitations
28 period, and courts tend to read the statute broadly, erring on the side of providing relief in
correcting inventorship.").

29 Lastly, relying on Altavion, Inc. v. Konica-Minolta Sys. Lab., Inc., 2008 WL
30 2020593, at *6 (N.D. Cal. May 8, 2008), plaintiff argues that though defendants'
31 fraudulent conduct before the USPTO will be a part of the proceeding, it does not form
32 plaintiff's exclusive theory and therefore the court does not have jurisdiction. But plaintiff
33 has not actually articulated an alternate theory that departs from the inventorship dispute

1 described above. Plaintiff cannot sidestep federal jurisdiction based on the mere
2 possibility an alternative theory of liability exists but will not actually be pursued. If that
3 were the case, a plaintiff asserting state law causes of action could always defeat the
4 Gunn test.

5 Altavion does not persuade the court otherwise. Discussing the Supreme Court's
6 decision in Christianson v. Colt Indus. Operating Corp., 486 U.S. 800, 811 (1988), the
7 Altavion court found that on the face of the complaint plaintiff asserted two alternative
8 theories to support its claim, one of which involved no patent law issues. Altavion, Inc. v.
9 Konica-Minolta Sys. Lab., Inc., 2008 WL 2020593, at **4-6 (N.D. Cal. May 8, 2008). On
10 those facts, the Altavion court remanded because an alternative theory of liability
11 supported plaintiff's claim. Id.

12 In Christianson, the Court held that "just because an element that is essential to a
13 particular theory might be governed by federal patent law does not mean that the entire
14 [] claim 'arises under' patent law." Christianson, 486 U.S. at 811. The Court went on to
15 explain that though the defendant pointed to one theory in the complaint that involved a
16 substantial question of patent law, the face of the complaint also contained other theories
17 supporting the antitrust claim that did not depend on resolving patent law issues. Id. at
18 812-13. Consequently, "the appearance on the complaint's face of an alternative, non-
19 patent theory [compelled] the conclusion that the [antitrust] claim [did] not 'arise under'
20 patent law." Id. at 813.

21 Here, on the other hand, after over three years of litigation and on the eve of trial,
22 plaintiff's only theory of liability necessarily involves issues that arise under patent law.
23 Accordingly, the court finds the first Gunn factor satisfied.

24 **b. Patent Issues Are Actually Disputed.**

25 "A federal issue is 'actually disputed' where the parties are in disagreement
26 regarding its potential application or resolution." Desktop Alert, Inc. v. ATHOC, Inc., No.
27 215CV8337, 2016 WL 1477029, at *4 (D.N.J. Feb. 24, 2016) report and recommendation
28 adopted, No. CV158337, 2016 WL 1450551 (D.N.J. Apr. 13, 2016); see, e.g., Gunn, 568

1 U.S. at 259 (where parties disagreed on whether a particular exception to the “on-sale
2 bar” might have operated to save a patent from being declared invalid, the Court found
3 that federal law was “actually disputed”).

4 Here, the parties dispute whether Bierman conceived of the ideas published in the
5 ‘713 Family of Patents. That is, whether or not plaintiff seeks to alter the named
6 inventors on the ‘713 Family of Patents, the parties dispute whether those patents
7 correctly fail to name Bierman. This is the central point of dispute in the case.

8 Plaintiff’s argument to the contrary fails. That plaintiff does not seek to have
9 Bierman declared as an inventor as defined under federal law does not show there is no
10 dispute. Put another way, plaintiff will surely contest defendants’ counterclaim for a
11 declaratory judgment stating Bierman should not have been a named inventor on the
12 patents.³ During the hearing on this motion, plaintiff’s counsel confirmed that his client
13 would not stipulate to the same.

14 **c. There Are Substantial Federal Issues.**

15 The Federal Circuit has “held that, for the purposes of section 1338(a) jurisdiction,
16 at least four issues of federal patent law are substantial enough to satisfy the jurisdiction
17 test,” including infringement and inventorship issues under 35 U.S.C. §§ 116, 256.
18 Hunter Douglas, Inc. v. Harmonic Design, Inc., 153 F.3d 1318, 1330 (Fed. Cir. 1998)
19 (collecting cases), overruled on other grounds by Midwest Indus., Inc. v. Karavan
20 Trailers, Inc., 175 F.3d 1356 (Fed. Cir. 1999). Plaintiff cites no case law contradicting this
21 binding authority.

22 **d. “Federal-State Balance” Supports Removal.**

23 The federal courts have a clear interest in regulating inventorship and infringement
24 issues under federal patent law. See Hunter Douglas, 153 F.3d at 1330; Nippon
25 Telephone and Telegraph Corp., 414 F.3d 1358, 1363 (Fed. Cir. 2005); American
26

27 ³ Plaintiff also argues that there is no “operative cross-complaint.” Plaintiff cites no case
28 law supporting the assertion that a “dispute” under Gunn requires an operative cross-
complaint.

1 Cyanamid, 196 F.3d 1366, 1372 (Fed. Cir. 1999). Similarly, Congress' enactment of the
2 America Invents Act (the "AIA") was "intended to provide federal courts . . . with a broader
3 range of jurisdiction." Vermont, 803 F.3d at 644. The AIA "expressly removes [patent
4 law] claims from the ambit of state court jurisdiction." Id.

5 Plaintiff argues that allowing removal to stand would disrupt the federal-state
6 balance because state courts have jurisdiction over state law claims even when the state
7 court has to interpret federal law. Here, however, plaintiff's theory does not only require
8 the state court to interpret federal law but also decide the federal patent issues of
9 inventorship, claim construction, and infringement as they relate to the '713 Family of
10 Patents.

11 **e. Conclusion: Sections 1338 & 1441**

12 At the eve of trial, plaintiff has only advanced one theory of liability and that theory
13 necessarily raises substantial patent law issues that are within the exclusive province of
14 the federal courts. Under these facts, the court finds that the four Gunn factors have
15 been met and therefore it has subject matter jurisdiction under § 1441

16 **2. Removal Was Proper Under § 1454.**

17 "A civil action in which any party asserts a claim for relief arising under any Act of
18 Congress relating to patents . . . may be removed . . ." 28 U.S.C. § 1454. This provision,
19 added by the AIA in 2011, was "intended to provide federal courts . . . with a broader
20 range of jurisdiction; that is, with jurisdiction over claims arising under the patent laws
21 even when asserted in counterclaims, rather than in an original complaint." Vermont, 803
22 F.3d at 644 (emphasis in original). The AIA "expressly removes such claims from the
23 ambit of state court jurisdiction." Id. (discussing changes to § 1338).

24 Defendants filed a cross-complaint on October 30, 2017, naming Bierman and
25 Intellisoft. That cross-complaint alleges that Intellisoft intends to rely on Bierman's
26 federal inventorship claim. Ex. 15 ¶¶ 19-20. The cross-complaint further alleges that
27 there is an actual controversy regarding the inventorship of the '713 Family of Patents
28 and that, if plaintiff is successful, it is possible the patents might be invalidated under

1 § 256 for defect in inventorship. Id. ¶ 20. Under the Federal Declaratory Judgment Act
2 and § 256, defendants' cross-complaint seeks a declaratory judgment that Bierman
3 should not be a named inventor of the '713 Family of Patents. Id. ¶¶ 15-23.

4 The court finds that defendants' cross-complaint satisfies § 1454's requirements.

5 **a. Plaintiff's Cross-Complaint and Counterclaim Arguments Fail.**

6 Plaintiff argues (i) that defendants admit § 1454 requires the assertion be in a
7 pleading and (ii) that the cross-complaint was never filed.

8 Defendants did not admit that § 1454 requires the asserted claim be in a pleading.
9 Defendants first correctly pointed out that § 1454's plain language only requires a party to
10 "assert" a claim for relief relating to patents. Whether or not defendants' cross-complaint
11 was allowed by the court, there can be little dispute that defendants have asserted a
12 claim involving patent law.

13 Defendants then, citing Masimo Corp. v. Mindray DS USA, Inc., No. 14-cv-0405,
14 2015 WL 93759 (D. N.J. Jan 7, 2015), recognized that one court required a pleading to
15 satisfy § 1454. In Masimo, defendants did not even attempt to file a cross-complaint
16 before removing and the court held that the notice of removal's "reference to potential
17 patent law counterclaims" did not provide jurisdiction. Masimo, 2015 WL 93759, at **3-4
18 (emphasis added). The court also refused to retain jurisdiction based on asserted federal
19 claims made "several months" after removal. Id. at *4.

20 The fact pattern here is far from similar. Defendants have asserted a claim in a
21 pleading—the cross-complaint—and, within the 21 day period allowed by Rule 15(a), re-
22 asserted the same claim in an amended counterclaim.

23 Plaintiff next argues there is no jurisdiction under § 1454 because the cross-
24 complaint is currently "lodged"⁴ and not operative because the state court had not yet
25 allowed defendants to file the cross-complaint. California Code of Civil Procedure
26

27 ⁴ Plaintiff misleadingly asserts that under California Rule of Court 2.550(b) "lodged" is
28 defined as "a record that is temporarily placed or deposited with the court, but not filed."
That definition only applies to records sealed or proposed to be sealed by court order.

1 § 428.50 requires a defendant who has filed an Answer to obtain leave of court before
2 filing a cross-complaint. In effect, plaintiff argues that in the situation at bar, removal
3 under § 1454 is only proper if the state court allows defendants' cross-complaint to be
4 filed and become operative.

5 The court has multiple concerns with this argument. As an initial matter, contrary
6 to plaintiff's assertion it appears that the cross-complaint was "filed" pursuant to California
7 law. Tregambo v. Comanche Mill & Mining Co., 57 Cal. 501 (1881) ("A paper in a case is
8 deemed to be filed when it is delivered to the clerk for that purpose, and the clerk's fees
9 paid if demanded.").

10 More importantly, plaintiff's rule would allow state courts to decide whether federal
11 jurisdiction exists and whether a case could be properly removed to federal court.

12 There is no question that the court would have jurisdiction over defendants' § 256
13 declaratory judgment claim if it were filed in federal court as a separate action. Under
14 plaintiff's rule, however, the same federal court would not have jurisdiction over that same
15 § 256 claim filed as a cross-complaint in a state court matter until the state court granted
16 defendants leave to file the cross-complaint.

17 That result is illogical and contrary to decades of precedent and to § 1454.

18 [A]t the outset it is to be noted that decision turns on the
19 meaning of the removal statute and not upon the
20 characterization of the suit or the parties to it by state statutes
21 or decisions. The removal statute which is nationwide in its
22 operation, was intended to be uniform in its application,
23 unaffected by local law definition or characterization of the
24 subject matter to which it is to be applied. Hence the Act of
25 Congress must be construed as setting up its own criteria,
26 irrespective of local law, for determining in what instances
27 suits are to be removed from the state to the federal courts.

28 Shamrock Oil & Gas Corp., 313 U.S. at 104 (internal citations omitted).

Plaintiff's rule would run directly contrary to Shamrock. By conditioning removal
on both a state court's rules of civil procedure and a state court's decision to allow the
filing of a cross-complaint, the rule would allow local law to define the scope and
applicability of a federal removal statute. Section 1454 allows removal whenever "any

1 party asserts a claim for relief arising under any act of Congress relating to patents.” 28
2 U.S.C. § 1454. Nothing in that statute imbues the state court with the power to determine
3 whether a case may be removed. See also Vermont, 803 F.3d at 644 (interpreting
4 § 1454 to allow removal of claims “arising under the patent laws even when asserted in
5 counterclaims”).

6 In addition, though many state courts have a similar rule to California Code of Civil
7 Procedure § 428.50, not all states require leave of court to file a counterclaim. See, e.g.,
8 Illinois Code of Civil Procedure, 735 ILCS 5/2-609. Under plaintiff’s proposed rule, the
9 very same cross-complaint might create federal jurisdiction in one state without any
10 action by the state court while at the same time having no effect on federal jurisdiction in
11 another state. Thus, the proposed rule would not only grant the states the power to
12 determine if and when federal jurisdiction attaches under § 1454, but also imbue only
13 some state courts with that power. Such a rule hardly promotes the uniform application
14 of § 1454.

15 The cases plaintiff cites do not persuade the court otherwise. McDonough v. UGL
16 UNICCO, 766 F. Supp. 2d 544 (E.D. Pa. 2011) (finding that plaintiff’s proposed amended
17 complaint was not removable until plaintiff’s motion to amend was granted and the
18 amended complaint became effective); Peaches & Cream LLC v. Robert W. Baird & Co.
19 Inc., No. 14-CV-6633 JG, 2015 WL 1508746 (E.D.N.Y. Mar. 31, 2015) (holding that
20 defenses that involve federal issues do not create jurisdiction and not actually addressing
21 § 1454); Sullivan v. Conway, 157 F.3d 1092, 1094–95 (7th Cir. 1998) (addressing the
22 issue of whether the 30 day deadline for removal begins when plaintiff’s motion to amend
23 the complaint is filed); Jackson v. Bluecross & Blueshield of Georgia, Inc., No. 4:08-CV-
24 49 (CDL), 2008 WL 4862686, at *2 (M.D. Ga. Nov. 10, 2008) (same).

25 This court’s decision, however, does conflict with Rutgers, The State Univ. v.
26 BioArray Sols., Ltd., No. CV 16-4183, 2017 WL 1395486, at *6 (D.N.J. Apr. 18, 2017),
27 which illustrates exactly the situation this court refuses to create. In that case, though
28 plaintiff’s complaint asserted only fraud and contract claims, during a deposition plaintiff’s

1 counsel stated that plaintiff intended to show that the inventor of one patent should have
2 been a named inventor of a disputed patent. Rutgers, The State Univ. v. BioArray Sols.,
3 Ltd., No. CV 16-4183, 2017 WL 1395486, at *2 (D.N.J. Apr. 18, 2017). In response to
4 this revelation, defendant requested the state court to grant defendant leave to file a
5 counter claim. Id. at *3. Before the state court issued an order on that request and
6 before § 1446's 30 day deadline expired, defendant removed the case based on § 1454
7 and § 1338. Id. With respect to defendant's § 1454 argument, the BioArray court
8 refused to consider the state court counterclaim because the state court had not yet
9 granted leave for it to be filed. Id. at *7. Thus, the Bioarray court allowed the state court
10 to decide whether the case could be removed to federal court.

11 Lastly, though the court finds it unnecessary to do so in light of the court's
12 jurisdiction based on the cross-complaint, the court also finds that the weight of authority
13 supports defendants' argument that the First Amended Counterclaim, filed in this court,
14 independently establishes jurisdiction under § 1454. See, e.g., Sleppin v.
15 Thinkscan.com, LLC, 55 F. Supp. 3d 366, 378 (E.D.N.Y. 2014) (holding that federal
16 copyright claims asserted for the first time in a counterclaim could, although did not in
17 that case, constitute a basis to deny remand); Acorne Productions, LLC v. Tjeknavorian,
18 33 F. Supp. 3d 175, 182 (E.D.N.Y. 2014) ("If defendants' counterclaims, which were
19 asserted after removal, arise under the Copyright Act, this court would have jurisdiction
20 over the counterclaims, and could exercise supplemental jurisdiction over plaintiffs'
21 claims."); Concordia Partners, LLC v. Pick, Case No. 14-cv-09, 2014 WL 4060253, at*4
22 (D. Maine Aug. 14, 2014) (rejecting argument that the court could not consider the
23 defendant's Copyright Act counterclaim because it was filed after removal reasoning that
24 such a result would be contrary to the plain language of 28 U.S.C. § 1454 and would
25 "unduly tend to exalt form over substance").⁵

26 **b. There Is A Justiciable Basis for Declaratory Relief**

27
28 ⁵ Section 1454 also covers copyright claims.

1 Plaintiff next argues that there is no federal jurisdiction under the Declaratory
2 Judgment Act because the true character of defendants' action is to determine who
3 created the trade secret technology at issue.

4 "The Declaratory Judgment Act provides that, '[i]n a case of actual controversy
5 within its jurisdiction . . . any court of the United States, upon the filing of an appropriate
6 pleading, may declare the rights and other legal relations of any interested party seeking
7 such declaration, whether or not further relief is or could be sought.' " Danisco U.S. Inc.
8 v. Novozymes A/S, 744 F.3d 1325, 1329 (Fed.Cir.2014) (quoting 28 U.S.C. § 2201(a)).

9 "[T]o demonstrate a sufficient controversy for a declaratory judgment claim that satisfies
10 the requirements of Article III, 'the facts alleged, under all the circumstances, [must] show
11 that there is a substantial controversy, between parties having adverse legal interests, of
12 sufficient immediacy and reality to warrant the issuance of a declaratory judgment.' " Id.
13 (quoting MedImmune, Inc. v. Genentech, Inc., 549 U.S. 118, 127 (2007)).

14 The court finds the present controversy meets that standard. Plaintiff's state court
15 cause of action is premised on a showing that the '713 Family of Patents contain ideas
16 that were not conceived of by the named inventors of those patents. Plaintiff does not
17 dispute that Bierman's purported conception of the technology is central to plaintiff's
18 misappropriation theory. Further, if plaintiff succeeds in showing Bierman conceived of
19 the ideas, any or all of the '713 Family of Patents might be invalidated for defect in
20 inventorship under 35 U.S.C. § 256. The court also finds the dispute sufficiently
21 "immediate" and "real" because if remanded to state court it will likely be litigated within
22 weeks. Plaintiff's refusal to stipulate that the '713 Family of Patents correctly lists the
23 named inventors, confirms this holding.

24 Plaintiff's citation to Sleppin v. Thinkscan.com, LLC, 55 F.Supp.3d 366 (E.D. N.Y.
25 2014), does not persuade the court otherwise. There, defendants' counterclaim sought a
26 declaratory judgment as to copyright ownership and infringement. Sleppin, 55 F.Supp.3d
27 at 370. Regarding the ownership issue, the court found that the "key dispute" between
28 the parties was whether the parties' business venture was organized as an

1 unincorporated partnership or a limited liability company. Id. at 380. With regards to the
2 alleged infringement issue, the court determined that it actually turned on what fiduciary
3 duties, if any, defendants owed the venture. Id. Thus, the court determined that it did not
4 have jurisdiction under § 1454 because the declaratory judgment counterclaim did not
5 “arise under” the Copyright Act. Id. The opposite is true here.

6 Plaintiff’s citation to Preston v. Nagel, 857 F.3d 1382 (Fed. Cir. 2017), also misses
7 the mark. There, contrary to plaintiff’s description, the court did not “appl[y] 28 U.S.C. §
8 1454 and remand[] the action back to state court because there was no sufficient
9 immediacy and reality to warrant the issuance of a declaratory judgment.” Dkt. 28 at
10 15:1-5. Instead, the court held that it did not have jurisdiction to review the district court’s
11 remand. See generally Preston v. Nagel, 857 F.3d 1382 (Fed. Cir. 2017).

12 **c. Conclusion: Section 1454**

13 In accordance with the above, the court holds that is has jurisdiction under § 1454
14 based on defendants’ state court cross-complaint and, in the alternative, defendants’ First
15 Amended Counterclaim.

16 **3. Removal Was Timely Under § 1446(b)(1).**

17 Section 1446(b)(1) permits defendants to remove state-court actions to federal
18 court within thirty days of receiving an initial pleading or other document that reveals a
19 basis for removal. Jordan, 781 F.3d at 1179. “Section 1446(b) is triggered upon the
20 receipt by the defendants of a paper in the action from which removability may be
21 ascertained.” Chan, 844 F.3d at 1142 (internal citations and quotation marks omitted).

22 Defendants argue that their receipt of the expert reports on September 28 and 29,
23 2017, was the first time removability of the case had been ascertained. Defendants also
24 argue that expert reports constitute “other paper” under § 1446. The court agrees.

25 **a. Other Paper**

26 “The type of document that constitutes an ‘other paper’ for the purposes of the
27 statute is broad, reflecting courts’ ‘embrasive construction’ of the term.” Rynearson v.
28 Motricity, Inc., 626 F. Supp. 2d 1093, 1097 (W.D. Wash. 2009) (quoting 14C Charles

1 Alan Wright & Arthur Miller, Federal Practice & Procedure § 3732 n. 26 (collecting
2 cases)). While the Ninth Circuit has not conclusively ruled on whether expert reports or
3 expert testimony constitute “other papers,” courts and treatises have often interpreted
4 “other papers” to include discovery related material. See 32A Am. Jur. 2d Federal Courts
5 § 1451 (discovery documents, briefing, and deposition testimony all qualify as “other
6 paper”); DeJohn v. AT & T Corp., No. CV 10–07107, 2011 WL 9105, at *2 (C.D.Cal. Jan.
7 3, 2011) (“[A]ll ‘formal discovery,’ including a ‘deposition, interrogatory, or request for
8 admission’ meets the definition of ‘other paper . . .’”). Plaintiff’s expert reports fall
9 squarely into that category. See also Gibson v. Clean Harbors Env’tl. Servs., Inc., 840
10 F.3d 515, 522 (8th Cir. 2016) (holding an expert report constituted “other paper”).

11 **b. Within 30 Days**

12 The notice of removal was filed within 30 days of receiving an initial pleading or
13 other document that reveals a basis for removal. Defendants received Rappaport’s
14 expert report on September 28, 2017. October 30, 2017 is the first non-weekend day
15 after the 30-day deadline.

16 Plaintiff does not disagree. Plaintiff, however, argues that removal was untimely
17 because in a April 28, 2017 motion in limine, defendants argued that plaintiff’s damages
18 claim should be treated as a patent claim. Plaintiff argues that defendants’ window to
19 remove the case, therefore, expired 30 days after the motion in limine filing. This
20 argument fails.

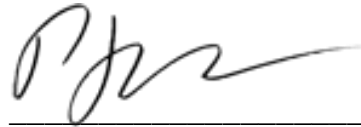
21 The Ninth Circuit does not “charge defendants with notice of removability until
22 they’ve received a paper that gives them enough information to remove. Because the
23 focus remains on whether the case ‘is or has become removable,’ counsel’s clairvoyant
24 sense of what actions [or arguments] a plaintiff might take plays no role in the analysis.”
25 Chan, 844 F.3d at 1142 (internal citations and quotation marks omitted). That is, though
26 defendants may have had theories or arguments that plaintiff’s claim raised federal
27 issues, those do not create a removable case. Instead, plaintiff’s affirmative
28 representations—here, plaintiff’s expert discovery—trigger § 1446’s 30 day deadline.

CONCLUSION

For all the foregoing reasons, defendants have sufficiently demonstrated removability under §§ 1338 & 1441 and separately under § 1454. Therefore, the court DENIES plaintiff’s motion to remand.⁶

IT IS SO ORDERED.

Dated: January 22, 2018



PHYLLIS J. HAMILTON
United States District Judge

United States District Court
Northern District of California

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⁶ Though neither party raised the issue, the court also has supplemental jurisdiction over the plaintiff’s other causes of action because they all form part of the same case or controversy under Article III of the United States Constitution. 28 U.S.C. § 1367(a).