

THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF NEW JERSEY  
CAMDEN VICINAGE

QUANTIFICARE, INC.,

Plaintiff,

v.

Civil No. 20-12305 (RMB/JS)

CANFIELD SCIENTIFIC, INC.,

Defendant.

O R D E R

This matter is before the Court on the "Motion for Alternative Service" ("motion") [Doc. No. 28] filed by defendant Canfield Scientific, Inc. ("defendant"). The Court received the opposition filed by plaintiff Quantificare, Inc. [Doc. No. 32] and defendant's reply [Doc. No. 34]. The Court exercises its discretion to decide defendant's motion without oral argument. See Fed. R. Civ. P. 78; L. Civ. R. 78.1. For the reasons to be discussed, defendant's motion is GRANTED.

Background

Plaintiff Quantificare, Inc. initially filed this action on September 3, 2020 alleging three counts of patent infringement against defendant. See Compl. [Doc. No. 1]. On October 29, 2020, defendant filed its initial answer [Doc. No. 15]. Subsequently, defendant amended its answer [Doc. No. 25] to include counterclaims

against both plaintiff and its alleged foreign parent corporation, Quantificare S.A.<sup>1</sup> See Mot. Br. at 1-2. Quantificare S.A. is a French company headquartered in France that owns the three patents at issue in this action. Id. Defendant asserts that plaintiff is a “wholly owned U.S. subsidiary and alleged exclusive licensee” of Quantificare S.A. Id. at 1. Defendant seeks a declaration that the patents asserted by plaintiff are invalid and unenforceable on various grounds. See id. at 2.

On November 23, 2020, defendant contacted Quantificare S.A.’s counsel, Mark D. Giarratana, Esq., to inquire whether his client would agree to waive service with respect to the counterclaims challenging its patents. See Duson Cert. ¶ 6 [Doc. No. 28-1]. Defendant asserts Mr. Giarratana previously appeared before the U.S. Patent Office as counsel of record for Quantificare S.A., along with his partner, Kevin L. Reiner, Esq. Id.; Mot. Br. at 2 [Doc. No. 28-2]. Defendant also asserts that Mr. Giarratana and Mr. Reiner have appeared as counsel for plaintiff in this case and that both have repeatedly declined defendant’s requests that they agree to waive service on behalf of their client. See Mot. Br. at 2-3. Defendant acknowledges, however, that it has yet to attempt service on Quantificare S.A. “through other channels, such as the Hague Convention.” Mot. Br. at 5. Defendant alleges service under

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<sup>1</sup> Plaintiff Quantificare, Inc. is a Delaware corporation with its principal place of business located in Georgia. See Opp’n at 2.

the Convention would be too costly, require translations, and delay service by months. See Duson Cert. ¶¶ 14-15. Defendant also alleges it was advised service "via mail pursuant to Rule 4(f)(2)(C)(ii) is [and/or was] apparently unavailable." Id. ¶ 14.

Defendant now moves for a Court Order to permit substituted service via alternative modes of service. Specifically, defendant requests that service directed to Quantificare S.A. be served upon its U.S. attorney, Mark D. Giarratana, Esq., and if necessary, simultaneously via international certified mail addressed to the attention of Quantificare S.A.'s Chief Executive Officer ("CEO") at its headquarters in France. Id. at 8.

Plaintiff opposes defendant's motion, contending it should be denied because defendant made no effort to serve Quantificare S.A. in accordance with the Hague Convention. Opp'n at 1. Plaintiff alleges while it wanted to cooperate with defendant, the Convention did not appear to contemplate its requested waiver of service. Id. In addition, plaintiff argues the particularities and necessities of this case do not require alternative service and asserts that the form of service defendant requests could have been effected without the Court's intervention. Id. at 6-9 (citing Fed. R. Civ. P. 4(f)(2)(C)(ii)). Plaintiff also disputes defendant's contention that this alternative was "apparently unavailable." Id. at 9. Plaintiff does not dispute, however, defendant's contention that it is a wholly owned subsidiary of Quantificare S.A.

In its reply, defendant argues that plaintiff's arguments are without merit. Defendant asserts "[f]or all practical purposes, Quantificare S.A. has already appeared in this Court" and has "enlisted its U.S. subsidiary, Quantificare, Inc., to oppose [defendant's] motion and to advance its arguments." Reply at 2. Accordingly, defendant contends "Quantificare S.A. is indisputably 'apprised' of the pendency of this action, and service upon its counsel is (and demonstrably has been) more than sufficient to 'afford them an opportunity to present their objections'" to defendant's action. Id. at 3.

### **Discussion**

Service of process upon foreign corporations is governed by Federal Rule of Civil Procedure 4(h). "In the United States, a foreign corporation may be served either pursuant to the laws of the state in which the district court is located or by delivering a copy of the summons and complaint to an officer or agent within the United States." Dimensional Commc'ns, Inc. v. OZ Optics Ltd., 218 F. Supp. 2d 653, 655 (D.N.J. 2002) (citing Fed. R. Civ. P. 4(h)(1), 4(e)). Outside of the United States, service may be accomplished in several ways, including by any internationally agreed means reasonably calculated to give notice, such as those means authorized by the Hague Convention on the Service Abroad of Judicial and Extrajudicial Documents ("Hague Convention"). See id. (citing Fed. R. Civ. P. 4(h)(2), 4(f)).

Under Rule 4(f)(3), a court has discretionary authority to order service "by other means not prohibited by international agreement." Vanderhoef v. China Auto Logistics Inc., C.A. No. 2:18-10174 (CCC/SCM), 2019 WL 6337908 (D.N.J. Nov. 26, 2019) (permitting alternative service through U.S. counsel for defendants residing in China); see SEC v. Dubovoy, C.A. No. 15-6076(MCA/MAH), 2016 WL 7217607, at \*2 (D.N.J. Dec. 13, 2016). Alternative means of service pursuant to Rule 4(f)(3) is neither a last resort nor extraordinary relief; "[i]t is merely one means among several which enables service of process on an international defendant." Vanderhoef, 2019 WL 6337908, at \*2 (citation omitted).

Courts have granted motions for alternative service when the movant shows: (a) there is no international agreement prohibiting service by the proposed method; (b) the proposed method of service is reasonably calculated to provide the defendant with notice; and (c) it made a good faith effort to locate and serve defendant by traditional means. Id.; Celgene Corp. v. Blanche Ltd., C.A. No. 16-501 (SDW/LDW), 2017 WL 1282200, at \*2 (D.N.J. Mar. 10, 2017). For alternative service to comport with due process requirements, the proposed method of service must be "reasonably calculated, under all the circumstances, to apprise interested parties of the pendency of the action and afford them an opportunity to present their objections." Mullane v. Cent. Hanover Bank & Tr. Co., 339 U.S. 306, 314 (1950). District courts maintain the discretionary

authority to determine whether the particularities and necessities of a case warrant alternative service. Vanderhoef, 2019 WL 6337908, at \*2 (citation omitted).

Here, defendant's proposed method of alternative service on Quantificare S.A. through its U.S. counsel is not prohibited by international law, specifically the Convention, of which both the United States and France are signatories. See Convention on the Service Abroad of Extrajudicial Documents, Nov. 15, 1965, 20 U.S.T. 361, 658 U.N.T.S. 9432. The Convention was ratified with the intent of streamlining the procedure by which "judicial and extrajudicial documents [are] served abroad." Id. (emphasis added). Accordingly, courts have held that the Convention is not relevant when the proposed method of alternative service is to be effectuated domestically. See Bravetti v. Liu, C.A. No. 3:12-7492 (MAS/TJB), 2013 WL 6501740, at \*3-4 (D.N.J. Dec. 11, 2013). In Volkswagenwerk Aktiengesellschaft v. Schlunk, the Supreme Court clarified that "[t]he only transmittal to which the Convention applies is a transmittal abroad," and "[w]here service on a domestic agent is valid and complete under both state law and the Due Process Clause, our inquiry ends and the Convention has no further implications." 486 U.S. 694, 707 (1988). Thus, the Convention does not apply since the proposed method of service is to be effected domestically.<sup>2</sup>

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<sup>2</sup> The Court is aware that defendant requested, as an alternative, to simultaneously effect service via international certified mail

The Court also finds defendant's proposed method of service is reasonably calculated to provide Quantificare S.A. with notice. It appears counsel for Quantificare S.A. has already appeared on behalf of plaintiff in this action and plaintiff does not dispute defendant's contention that it is a wholly owned U.S. subsidiary of Quantificare S.A. This being the case, neither the Convention nor the Due Process Clause requires an official transmittal of documents abroad to properly effect service on Quantificare S.A. See Volkswagenwerk, 486 U.S. at 707-08. Thus, while plaintiff asserts "the Convention pre-empts inconsistent methods of service . . . in all cases to which it applies," it fails to acknowledge the Convention is inapplicable where the proposed method of service sought is to be effectuated domestically and not abroad. Opp'n at 6 (citing Volkswagenwerk, 486 U.S. at 699). In addition, the Court notes that Quantificare S.A. is aware of the dispute underlying this action, which involves allegations of infringement and challenges to the validity of certain patents it owns. Further, Quantificare S.A. directed its U.S. counsel to represent plaintiff in this matter, which appears to indicate it is already aware of the pendency of this action. Nevertheless, the Court finds this

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addressed to Quantificare S.A.'s CEO in France. However, because the Court finds service through U.S. counsel for Quantificare S.A. provides it with sufficient notice for the reasons to be discussed, the Court finds defendant's proposed method of service does not require the transmittal of documents abroad.

information indicates that U.S. counsel for Quantificare S.A., Mark D. Giarratana, Esq., will be successful in forwarding the summons and complaint to his client in order to properly apprise it of the pendency of this action and to provide it with an opportunity to present any objections.

Last, the Court finds defendant's efforts to obtain a waiver of service from Quantificare S.A.'s domestic counsel demonstrates a good faith effort to effectuate service via traditional means, particularly in light of the extraordinary circumstances presented by the ongoing pandemic. The Court also finds the particularities and necessities of the case and principles of judicial economy warrant alternative service in order to prevent further delays in this litigation. As such, the Court will permit Quantificare S.A. to be served through its U.S. counsel, as it is apparent it is in contact with counsel and because service upon Quantificare S.A. through its U.S. counsel comports with constitutional due process. See Marlabs Inc. v. Jakher, C.A. No. 07-4074(DMC/MF), 2010 WL 1644041, at \*3 (D.N.J. Apr. 22, 2010) (quoting Mullane, 339 U.S. at 314); see also LG Elecs., Inc. v. ASKO Appliances, Inc., C.A. No. 08-828 (JAP), 2009 WL 1811098, at \*4 (D. Del. June 23, 2009) (finding service upon a foreign corporation via its U.S. counsel was appropriate, despite prior refusals to waive service, in order "to prevent further delays in litigation," and noting that "the regularity of contact between [the corporation] and [its counsel]

clearly demonstrate that [the corporation] is on notice of the contents of the instant complaint”).

**Conclusion**

Accordingly, for the foregoing reasons,

IT IS HEREBY ORDERED this 12th day of January 2021, that defendant’s “Motion for Alternative Service” [Doc. No. 28] is GRANTED; and it is further

ORDERED defendant shall direct service to Quantificare S.A. via its U.S. counsel, Mark D. Giarratana, Esq., in his capacity as its designated legal representative and/or agent.

s/Joel Schneider  
JOEL SCHNEIDER  
United States Magistrate Judge