COURT RULING SIMPLIFIES SERVICE UPON FOREIGN TRADEMARK INFRINGERS

Hodgson Russ Intellectual Property Litigation Alert
December 20, 2022

Enforcing trademark rights against an overseas defendant can be a lengthy and expensive process. But a recent ruling may make serving legal papers upon a foreign-domiciled infringer easier (and less expensive) when the infringer owns United States trademark registrations or applications so long as the action relates to those registrations.

Background. In *San Antonio Winery, Inc. v. Jiaxing Micarose Trade Co.*, San Antonio, a California winery commenced an action for trademark infringement against a Chinese company, Jiaxing. San Antonio has been selling wine under the marks RIBOLI and RIBOLI FAMILY since at least 1998. Jiaxing was able to obtain a U.S. trademark registration for the mark RIBOLI used with clothing and shoes in 2018, and the company later filed new applications to register the mark RIBOLI for use with wine pourers, cocktail shakers, and other household items.

San Antonio filed a lawsuit seeking to bar Jiaxing from selling goods bearing the RIBOLI mark and cancellation of its trademark registration and pending application. Because Jiaxing is located in China, San Antonio would typically be required to go through an expensive and time-consuming process to serve Jiaxing. That process involves translating the documents, delivering them to a "Central Authority" designated by China, and waiting for that Central Authority to deliver the documents to Jiaxing and confirm receipt.

Seeking to avoid this process, San Antonio served its complaint upon Jiaxing pursuant to 15 U.S.C. § 1051(e), a provision of the trademark statute which, in "proceedings" that affect the trademark, allows for service of a foreign trademark owner via delivery of documents to the director of the United States Patent and Trademark Office (USPTO). District courts have been split on whether this provision applies only to proceedings before the USPTO or covers civil actions commenced in federal district courts.

Decision. The Ninth Circuit held that Jiaxing was properly served. It further held that the language of § 1051(e) is broad enough to encompass civil actions. The court further ruled that permitting foreign trademark owners to be served via the USPTO does not conflict with the U.S.'s obligations under international treaties concerning service of process. As a result of the ruling, a foreign trademark owner can now be properly served notice of a trademark infringement lawsuit via service on the

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USPTO. This was the first appellate decision on this issue.

Key Takeaways. The ruling provides a faster, cheaper way to bring cases against foreign trademark infringers that have registered trademarks in the U.S. Companies located outside of the U.S. should also be aware that a U.S. trademark registration or application could now be sufficient to subject them to service of a U.S. lawsuit involving that trademark. Hodgson Russ's intellectual property team helps clients looking to enforce their intellectual property rights or defend against claims of intellectual property infringement. For more information, please contact **Jodyann Galvin** or any member of our **Intellectual Property Litigation Practice**.