

## Publication

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### Client Alert: Supreme Court to Address International Reach of U.S. Trademark Law

Earlier this month, the Supreme Court agreed to hear an appeal that could clarify the legal landscape for U.S. brand owners seeking to enforce trademarks abroad — namely, whether brand owners may file suit in U.S. court for “extraterritorial” infringement of U.S. trademarks or whether brand owners must rely on foreign trademark rights and on foreign courts for enforcement.

U.S. federal courts have long been split on whether—and how—U.S. federal trademark law reaches conduct by non-U.S. citizens acting outside of the United States. In this case, *Abitron Austria v. Hetronic International*, the U.S. Court of Appeals for the Tenth Circuit adopted a test that requires that the alleged infringement overseas “had a substantial effect on U.S. commerce” in order for a U.S. court to exercise jurisdiction. Of the \$90 million in infringing sales awarded as damages in the case, 97% were *purely* foreign sales—by and to foreign parties with use that never reached the United States nor confused U.S. consumers.

As brand owners may know, trademark law varies widely across global jurisdictions, particularly as it relates to the degree of use necessary to establish trademark rights. If, as many predict, the Supreme Court lessens the enforcement power of U.S. trademark rights abroad, brand owners operating internationally will be wise to strengthen international trademark portfolios, ensuring

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that registrations are in place to enforce against infringement.

We will be monitoring this case for developments and will provide an update when the Supreme Court issues its decision in the case. Should you have any questions in the meantime, do not hesitate to reach out to Lee Eulgen, Lee Stark, or your Neal Gerber Eisenberg attorney.

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