



No Time for Cat-and-Mouse Games: Another Federal Court Allows for Service of Patent Infringement Complaint via E-Mail on Foreign Defendants Residing in Mainland China, Skirting Hague Convention Procedures

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A recent decision by the federal district court in the Southern District of Florida (*Xiamen Zhaozhao Trading Co., Ltd. v. The Individuals, Partnerships and Unincorporated Associations Identified on Schedule A*, No. 23-61347-CV, docket entry 21 (September 27, 2024)) permitted the Chinese corporate plaintiff to serve its complaint alleging patent infringement on the putative foreign defendants via e-mail. This case is among a growing number of “Schedule A lawsuits” filed in this judicial district, where numerous defendants, identified only by the pseudonyms (Seller ID’s) used for operating their respective online storefronts on large e-commerce platforms such as Amazon.com, are listed in a separate Schedule A attached to the complaint asserting the defendants’ infringement of the plaintiff’s trademarks, copyrights, design patents or, occasionally, utility patents. Here, the plaintiff accused the various sellers of infringing its patented design over the appearance of a pet house for cats.

Rule 4(f) of the Federal Rules of Civil Procedure governs service of a foreign defendant. Sub-paragraph (f)(3) gives a district court broad discretion to order an alternative method of service, provided that it is reasonably calculated to give notice to defendants and is not “prohibited by international agreement.” In the instant case, plaintiff requested permission to serve its complaint, the court’s summons, and all future discovery requests on each defendant via electronic messaging through Amazon’s Buyer-Seller Messaging Service. Each message was to further include the url link to a dedicated website maintained by plaintiff for serving notice and posting its case filings.

Here, the court had denied plaintiff’s earlier Rule 4(f)(3) motion for failing to identify in which country or countries each putative defendants resided. Subsequently, the plaintiff singled out the foreign defendants residing in mainland China in an amended Schedule A. In granting the plaintiff’s renewed motion for alternative service, the district court determined that no international agreement between the U.S. and the People’s Republic of China (“PRC”) prohibited service via e-mail or electronic messaging. Rather, while both countries are signatories to the Hague Convention, the PRC had merely objected to the enumerated exceptions to service under Article 10 of the Convention, but failed to expressly object to service via e-mail and website postings. (The PRC’s lack of objection to these two methods of providing notice is unsurprising, since the Internet did not exist at the time of the 1965 Hague Convention.)

The Southern District of Florida is presently one of many federal district courts to have interpreted the Hague Convention narrowly, allowing for service of process via e-mail notwithstanding of a signatory’s objection to Article 10. Within the last year, the Northern District of California (defendant in Pakistan), the Eastern District of Virginia (defendants in the Philippines), and numerous other courts have cabined Article 10 to its enumerated exceptions,

allowing for online service of process on foreign defendants. Likewise, lacking guidance from the appeals court in the Second Circuit, the [Eastern District of New York](#) has permitted service of process via e-mail on defendants in the PRC. In contrast, its sister court in the [Southern District of New York](#) has refused to allow service of process on mainland Chinese defendants via e-mail when the defendant's location is readily ascertainable.

TAKEAWAY

Without clear and uniform guidance from the appellate Circuit Courts, potential foreign defendants and especially online business operators should be live to the possibility of being tagged by expedited service under the federal rules and forced to defend itself in an American court. Foreign companies with a strong online presence who make sales to customers in those U.S. districts listed above are at risk of online service of process; and to a greater extent if they conceal their true physical locations in frustration of more traditional methods of service.

Hamza Rashid also contributed to this blog post.

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