The Long-Arm of the USPTO: A Significant Decision (and a Significant Dissent) from the Fourth Circuit

When panel issues a 16-page decision, and Judge James Harvie Wilkinson III writes a 20-page dissent, people seem to take notice. In *Rosenruist-Gestao E servicos LDA v. Virgin Enterprises Ltd*., No. 06-1588 (4th Cir., December 27, 2007), Judge Wilkinson sharply derided his colleagues in holding that:

> *"a foreign company that has no United States employees, locations or business activities must produce a designee to testify at a deposition in the Eastern District of Virginia so long as it has applied for a trademark registration with a government office located there. As a result, foreign witnesses can be compelled to travel to the United States and give in-person testimony at the behest of any litigant in a trademark dispute, . . . even though the PTO's own procedures call for obtaining testimony from foreign companies through [the Hague Evidence Convention]."*

This decision is, as Judge Wilkinson recognizes, "a first for any federal court," and "problematic for many reasons." Specifically:

> *It fails to properly apply the statute, 35 U.S.C. § 24, that is directly relevant to its decision, and it reaches a result that is bound to embroil foreign trademark applicants in lengthy, procedurally complex proceedings. It inverts longstanding canons of construction that seek to protect against international discord, and it disregards the views of the PTO whose proceedings 35 U.S.C. § 24 is designed to aid. In view of the statutory text (see Section I), interpretive canons, international relationships, and separation of powers concerns (II), and the PTO's own framework (III), I firmly believe this subpoena must be quashed.*

The decision can be obtained here. One cannot help but wonder whether the significance and recurrence of the issue doesnt warrant immediate Supreme

Court review of the decision, even absent a clear split of circuit authority. Indeed, as Judge Wilkinson implicitly acknowledges, such a split may never occur; "the majority creates a standard that is in fact a national one: the PTO is located in the Eastern District of Virginia; applications for trademark registration are filed there; and subpoena enforcement will frequently be sought in that district. Indeed, for any foreign corporation without a preexisting United States presence, the majority's decision will be controlling."