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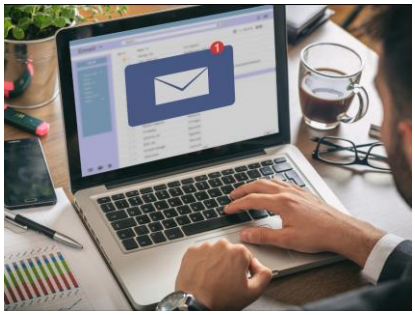
IP CASE OF THE WEEK

You've Got Mail: Federal Circuit Allows Service Through Email

***In re: Aputure Imaging Industries Co., Ltd*, No. 2024-103 (Fed. Cir. Jan. 22, 2024)**

By: Michael Carwin & Victoria Hanson | February 5, 2024

On January 26, 2024, the Federal Circuit denied a petition for writ of mandamus to vacate an order permitting Rotolight Limited ("Rotolight") to serve Aputure Imaging Industries Co., Ltd. ("Aputure") through email to Aputure's in-house counsel.



Rotolight and Aputure manufacture and sell LED lights used in photography and filmmaking. In June 2023, Rotolight filed a complaint in the Eastern District of Texas against Aputure, a China-based company, for patent infringement. Rotolight made several unsuccessful attempts to serve Aputure at a California address obtained from multiple online business databases that had the same zip code as an office listed on Aputure's website. In September 2023, Rotolight moved for substitute service pursuant to Texas Rule of Civil Procedure 106(b) to seek permission to serve Aputure by emailing Aputure's legal counsel.

On October 16, 2023, the Eastern District of Texas granted Rotolight's motion for substitute service to serve Aputure via email. The court found that Rotolight had attempted service enough times on Aputure at locations reported to be its place of residence in California and that service of the complaint and summons on Aputure's in-house counsel's email address would be effective to give notice to Aputure of the suit. In response, Aputure filed a petition for writ of mandamus to the Federal Circuit to vacate the order and deny the request for substituted service because service by email was improper and service should have been attempted through the Hague Convention since Aputure is based in China.

The Federal Circuit denied Aputure's petition because Aputure failed to satisfy the three conditions in order to grant a writ of mandamus: (1) the petitioner must have "no other adequate means to attain the relief [it] desires," (2) that the "right to issuance of the writ is clear and indisputable," and (3) the court "in the exercise of its discretion, must be satisfied that the writ is appropriate under the circumstances." For the first factor, Aputure did not show that a post-judgment appeal would be inadequate. For the second factor, Aputure did not demonstrate that it had a clear and indisputable right to relief. Although Aputure argued that the district court erred by refusing to require Rotolight to first attempt service of process in China pursuant to the Hague Convention, that argument failed because the district court appeared to have concluded Aputure could be served in California. Further, the Federal Circuit held district courts are given broad discretion to determine alternative means of service not prohibited by international agreement. For the third factor, the Federal Circuit ultimately determined that it was not prepared to determine that granting the motion was a clear abuse of discretion that warranted mandamus relief.

While a denial of the writ of mandamus does not determine whether the district court's grant of the motion for substitute service was an abuse of discretion, this case demonstrates facts that may assist a court in finding substitute service appropriate on a foreign company. Whether the district court was ultimately correct may likely not be resolved until after the case is decided and if Aputure appeals this decision.