

## Supreme Court Vacates and Remands 10<sup>th</sup> Circuit's Decision in "Abitron"

By: [Monica Riva Talley](#)

The US Supreme Court ruled today in the closely watched [Abitron Austria GmbH v. Hetronic International, Inc.](#) case, which considered whether a party could recover in US courts for trademark infringement that occurred outside the US. Not unexpectedly, the Court vacated and remanded the lower court's decision finding liability for extraterritorial acts, stating that §1114(1)(a) and §1125(a)(1) of the Lanham Act do not apply outside of the US. The Court confirmed that "use in commerce" of a trademark provides the dividing line between whether a claimed infringement is foreign or domestic.

This ruling is consistent with prior US practice, and also how trademark laws are interpreted and enforced around the globe, in which each country is empowered to grant trademark rights and police infringement within its borders. As a practical matter, what this means for US trademark owners is that they will need to bring actions in foreign jurisdictions to enforce against trademark infringement outside of the US. It also means that US brand owners will continue to need to seek registration in jurisdictions outside of the US in which they plan to do business, in order to obtain rights to enforce against bad actors.

### Author



**Monica Riva Talley**  
Director  
[mtalley@sternekessler.com](mailto:mtalley@sternekessler.com)

[Visit Website](#)

[Contact Us](#)

[Download PDF](#)



The information contained in this message is intended to convey general information only, and should not be construed as a legal opinion or as legal advice. Sterne, Kessler, Goldstein & Fox PLLC disclaims liability for any errors or omissions, and information in this message is not guaranteed to be complete, accurate, and updated. Please consult your own lawyer regarding any specific legal questions.

© 2023 Sterne, Kessler, Goldstein & Fox PLLC | [Privacy Policy](#)

Sterne, Kessler, Goldstein & Fox PLLC, 1100 New York Avenue NW, Washington, D.C. 20005

[Manage preferences](#)