

United States District Court  
For the Northern District of California

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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

AIRWAIR INTERNATIONAL LTD., a	)	Case No.: 5:13-CV-01190-LHK
company of the United Kingdom,	)	
	)	ORDER DENYING MOTION TO
Plaintiff,	)	DISMISS
v.	)	
	)	
MATTHEW K. SCHULTZ, an individual doing	)	
business as CALCEUS, a fictitious business	)	
name; NPS (SHOES) LTD., a British Limited	)	
Company; and DOES 1-50,	)	
	)	
Defendants.	)	
	)	

Plaintiff AirWair International Ltd. (“AirWair”), brings this action against defendant NPS (Shoes) Ltd. (“NPS”) and defendant Matthew K. Schultz, an individual doing business as Calceus (“Calceus”), for federal trademark infringement, federal false designation of origin, trademark dilution, California statutory unfair competition, common law unfair competition, and California statutory trademark dilution. ECF No. 28 (“First Am. Compl.”). Before the Court is NPS’s motion to dismiss for lack of personal jurisdiction. ECF No. 30 (“Mot.”).

Pursuant to Civil Local Rule 7-1(b), the Court finds this matter appropriate for resolution without oral argument and hereby VACATES the hearing scheduled for November 13, 2014. The

1 case management conference set for November 13, 2014 at 1:30 p.m. remains as set. Having  
2 considered the submissions of the parties and the relevant law, and for good cause shown, the  
3 Court hereby DENIES NPS’s motion to dismiss.

4 **I. BACKGROUND**

5 **A. Factual Background**

6 The following background is drawn from AirWair’s operative complaint, as well as  
7 declarations submitted in conjunction with NPS’s motion to dismiss.

8 AirWair, a company based in the village of Wollaston, England, designs, manufactures,  
9 markets, and sells footwear under the Dr. Martens trademark. First Am. Compl. ¶¶ 1, 11. AirWair  
10 holds several registrations with the U.S. Patent and Trademark Office for the trade dress of Dr.  
11 Martens footwear, including “the combination of yellow stitching and a two-tone grooved sole  
12 edge”; yellow “welt stitch located around the perimeter of footwear”; longitudinal ribbing and a  
13 dark color band over a light color in the sole edge; and “longitudinal ribbing and a dark color band  
14 over a light color on the outer sole edge, welt stitching, and a tab at the top back heel of footwear.”  
15 Id. ¶ 14 (internal quotation marks omitted). According to AirWair, these trademarks have been in  
16 use for 50 years, and have been used in the United States since 1984. Id.

17 NPS, a British Limited Company also located in Wollaston, England, manufactures,  
18 advertises, distributes, and sells Solovair footwear. Id. ¶ 3. AirWair has alleged that several of  
19 NPS’s Solovair products are sold in the United States, including California, and has further alleged  
20 NPS’s products infringe the trade dress of AirWair’s Dr. Martens footwear. Id. ¶¶ 6, 18-25, 51.

21 At issue in the instant motion is the degree of contact NPS has with the state of California.  
22 According to NPS, the company is not licensed or registered to do business in California; has no  
23 property or subsidiaries here; and has no office, employees or registered agents, phone or mailing  
24 address in-state. Declaration of Christian Castle in Support of NPS’ Motion to Dismiss, ECF No.  
25 30-1, (“Castle Decl.”), ¶¶ 5-13. NPS has further alleged that it does not individually direct  
26 advertisements or knowingly target marketing emails to consumers in California. Id. ¶ 10, 16.

27 Co-defendant Matthew K. Schultz is the owner and principal of Calceus, LLC, a California  
28 limited liability company based in Poway, California. First Am. Compl. ¶ 4. According to

1 AirWair’s First Amended Complaint, sometime on or before 2012 Calceus negotiated with NPS to  
2 be NPS’s official and exclusive authorized importer, distributor and reseller of Solovair footwear in  
3 the United States. Id. ¶¶ 5, 27, 28. Pursuant to the agreement between the two businesses, NPS  
4 licensed to Calceus Solovair-related intellectual property owned by NPS. Id. ¶ 29. Thereafter,  
5 NPS sold over 500 units of infringing footwear to Calceus between January 2012 to January 2013.  
6 Id. at ¶ 41. The infringing footwear was allegedly delivered in six shipments that journeyed from  
7 NPS’s factory in England to Calceus in California. Id. Calceus then resold the Solovair footwear  
8 to consumers and retailers throughout California, as well as the rest of the United States, between  
9 January 2012 and April 2013. Id. Calceus shipped returns from its U.S. sales back to NPS in  
10 England. Id. ¶ 26. According to AirWair, Calceus operated as “a central location to store Solovair  
11 footwear intended for the U.S. market,” and “significant payments flow between Calceus and NPS”  
12 based on shipments from NPS to Calceus. Id. at ¶¶ 26, 43.

13 According to AirWair, Calceus operates a commercial, interactive website,  
14 www.solovairdirect.com (“Solovair Direct”) for the advertising, promotion, and sale of Solovair  
15 footwear. First Am. Compl. ¶ 31. NPS has worked closely with Calceus in the design of Solovair  
16 Direct by, among other things, sharing images of Solovair footwear and historical images of NPS’s  
17 factory and workers, both for use on Solovair Direct. Id. ¶ 31-32. NPS also allegedly directed  
18 Calceus to make Solovair Direct as similar as possible to NPS’s own website, www.solovair.co.uk.  
19 Id. For example, Calceus’s website contains an “About Us” page that is entitled “History of  
20 Solovair and NPS.” Id. ¶ 33. The page is allegedly very similar to the “About Us” webpage from  
21 NPS’s own websites. Id. NPS also allegedly directed Calceus to add the language, “We are the  
22 official Solovair representative for Canada as well as the US” to Calceus’s website. Id. ¶ 34.  
23 Calceus’ Facebook page similarly contains NPS’s Solovair logo, as well as the blurbs “Official US  
24 Partner” and “Exclusive North American Retailer for Solovair Boots, Shoes and Accessories.” Id.  
25 ¶ 37. NPS’s own website, www.solovair.co.uk, has a “Where To Buy” webpage that directs U.S.  
26 consumers to, among other retailers, the Calceus website. Id. ¶ 37-38.

27 AirWair has alleged that NPS and Calceus have “continuously re-negotiated, added and/or  
28 removed terms to, and renewed [their] Agreement as necessitated by business operations in the

1 United States.” Id. ¶ 29. AirWair has also alleged that NPS provided ongoing support and  
2 oversight to Calceus regarding Calceus’s website, Solovair Direct. Id. ¶ 40. NPS’s alleged support  
3 included: (1) coordination of orders, import/export controls, invoices, customs, and tariffs; (2)  
4 selection of styles, sizes, quantities, pricing, and packaging for the U.S. market; (3) support  
5 regarding the sales performance of Solovair Direct; (4) the provision of promotional materials to  
6 Calceus for events in California and elsewhere in the United States; (5) the supply of product  
7 images for use in advertising and marketing; (6) assistance with U.S. trade shows; (7) strategy for  
8 new promotional opportunities in California and elsewhere in the United States; and (8) assistance  
9 in responding to customer complaints and return requests. Id.

10 Finally, AirWair has alleged that NPS, or Calceus operating at NPS’s behest, established  
11 relationships with retailers in San Francisco and Berkeley, California, as well as Lancaster,  
12 Pennsylvania to sell Solovair footwear. Id. ¶ 45. Calceus has continued to seek out additional  
13 retailers to sell Solovair footwear in the United States, also at NPS’s alleged behest. Id. ¶ 46.

#### 14 **B. Procedural History**

15 On March 3, 2013, AirWair filed a complaint against NPS and defendant Matthew K.  
16 Schultz. ECF No. 1. On April 10, 2014, since AirWair had not yet served the defendants, the  
17 Court ordered service, ECF No. 9, and AirWair shortly thereafter obtained a waiver of service from  
18 each defendant, ECF Nos. 13 & 16. On July 7, 2014, The Court approved a consent judgment  
19 between Plaintiff and defendant Matthew K. Schultz/Calceus. ECF No. 20.

20 On July 18, 2014, NPS filed its first motion to dismiss for lack of personal jurisdiction.  
21 ECF No. 23. In response, on July 29, 2014, Plaintiff filed a First Amended Complaint naming  
22 NPS, Matthew K. Schultz, and Calceus LLC as defendants. ECF No. 28. In its First Amended  
23 Complaint, AirWair alleged trademark infringement, federal unfair competition, trademark  
24 dilution, unfair competition under California Business & Professions Code §§ 17200, et seq.,  
25 common law unfair competition, and trademark dilution under California Business & Professions  
26 Code §§ 14330, et seq. First Am. Compl. ¶¶ 49-74. AirWair also alleged that NPS’s promotion,  
27 advertising, offering for sale, and sale of Solovair footwear is likely to cause and has caused  
28 confusion between AirWair’s footwear and NPS’s footwear. Id. ¶ 47. AirWair further alleged that

1 NPS's activity has caused and continues to cause damage to Plaintiff in California in the form of  
2 lost sales and profits, and damage to its reputation and goodwill in California. FAC ¶ 48. AirWair  
3 requested injunctive relief and monetary damages. *Id.* at 14-15.

4 On August 20, 2014, the Court approved an amended consent judgment between Plaintiff  
5 and defendants Matthew K. Schultz and Calceus, LLC. ECF No. 32.

6 On August 12, 2014, responding to the First Amended Complaint, NPS filed the instant  
7 motion to dismiss for lack of personal jurisdiction, pursuant to Federal Rule of Civil Procedure  
8 12(b)(2). ECF No. 30. On August 26, 2014, AirWair filed its opposition to the motion. ECF. No.  
9 33. On September 2, 2014, NPS filed a reply in support of its motion. ECF No. 34.

## 10 II. LEGAL STANDARD

11 When a defendant moves to dismiss a complaint for lack of personal jurisdiction, the  
12 plaintiff bears the burden of demonstrating that jurisdiction is appropriate. *Schwarzenegger v.*  
13 *Fred Martin Motor Co.*, 374 F.3d 797, 800 (9th Cir. 2004). Where, as here, the defendant's motion  
14 is based on written materials rather than an evidentiary hearing, the plaintiff need only make a  
15 prima facie showing of jurisdictional facts to withstand a motion to dismiss for lack of personal  
16 jurisdiction. *Mavrix Photo, Inc. v. Brand Techs., Inc.*, 647 F.3d 1218, 1223 (9th Cir. 2011) (citing  
17 *Brayton Purcell LLP v. Recordon & Recordon*, 606 F.3d 1124, 1127 (9th Cir. 2010)). At this stage  
18 of the proceeding, "uncontroverted allegations in plaintiff's complaint must be taken as true, and  
19 conflicts between the facts contained in the parties' affidavits must be resolved in plaintiff's favor."  
20 *Brayton Purcell*, 606 F.3d at 1127 (internal quotation marks, citations, and alterations omitted). In  
21 addition, "[t]he court may consider evidence presented in affidavits to assist it in its determination  
22 and may order discovery on the jurisdictional issues." *Doe v. Unocal Corp.*, 248 F.3d 915, 922  
23 (9th Cir. 2001).

24 When there is no applicable federal statute governing personal jurisdiction, as is the case  
25 here, the law of the forum state determines personal jurisdiction. *Schwarzenegger*, 374 F.3d at  
26 800. California's long arm statute, which determines personal jurisdiction, is coextensive with  
27 federal due process requirements, and therefore the analysis for personal jurisdiction is the same  
28 under both state and federal law. *Id.* at 800-01; Cal.Code Civ. Pro. § 410.10. A court may exercise

1 personal jurisdiction over a non-resident defendant only when the defendant has ““minimum  
2 contacts”” with the forum state such that jurisdiction ““does not offend traditional notions of fair  
3 play and substantial justice.”” Schwarzenegger, 374 F.3d at 801 (quoting *Int’l Shoe Co. v. Wash.*,  
4 326 U.S. 310, 316 (1945)). This “minimum contacts” requirement can be satisfied either by  
5 establishing general jurisdiction or specific jurisdiction. See *Helicopteros Nacionales de*  
6 *Colombia, S.A. v. Hall*, 466 U.S. 408, 414 (1984). Only specific jurisdiction is at issue here.  
7 *Opp’n* at 5.

8 For specific personal jurisdiction, the Ninth Circuit has adopted a three-part test that  
9 requires the plaintiff to show: (1) the defendant purposefully directed its activities at residents of  
10 the forum or purposefully availed itself of the privilege of doing business in the forum; (2) that the  
11 plaintiff’s claim arises out of or relates to those activities; and (3) that the assertion of personal  
12 jurisdiction is reasonable and fair. Schwarzenegger, 374 F.3d at 802. It is the plaintiff’s burden to  
13 plead allegations satisfying the first two prongs. *Id.* If the plaintiff does so, the burden then shifts  
14 to the defendant to show why the exercise of personal jurisdiction would not be reasonable and  
15 fair. *Id.* “So long as it creates a substantial connection with the forum, even a single act can  
16 support jurisdiction,” but those acts must not “create only an attenuated affiliation with the forum.”  
17 *Burger King Corp. v. Rudzewicz*, 471 U.S. 462, 475 n.18 (1985) (internal quotation marks  
18 omitted).

### 19 III. DISCUSSION

20 NPS has argued that there is no specific personal jurisdiction here because NPS did not  
21 purposefully direct activity at California. *Mot.* at 15-17. NPS has further asserted that AirWair’s  
22 claims do not arise out of NPS’s forum-related activities. *Mot.* at 18. Finally, NPS has contended  
23 that personal jurisdiction would be unreasonable. *Mot.* at 18-20. The Court addresses each of  
24 NPS’s arguments in turn.

#### 25 A. Purposeful Availment or Purposeful Direction

26 The first prong of the Ninth Circuit’s three-part test for personal jurisdiction requires that  
27 the defendant either purposefully directed its activities at residents of the forum or purposefully  
28 availed itself of the privilege of doing business in the forum. For trademark infringement actions,

1 the Ninth Circuit requires a showing of purposeful direction. *Nissan Motor Co. v. Nissan*  
2 *Computer Corp.*, 246 F.3d 675 (9th Cir. 2000). To establish purposeful direction, a plaintiff must  
3 in turn satisfy a three-part test drawn from the Supreme Court’s opinion in *Calder v. Jones*: (1) the  
4 defendant must have committed an intentional act; (2) the defendant’s act was expressly aimed at  
5 the forum state; and (3) the defendant knew the brunt of the harm was likely to be suffered in the  
6 forum state. *Dole Food Co. v. Watts*, 303 F.3d 1104, 1111 (9th Cir. 2002) (citing *Calder v. Jones*,  
7 465 U.S. 783 (1984)).

### 8 **1. Intentional Act**

9 In the context of the *Calder* test, an intentional act is “an external manifestation of the  
10 actor’s intent to perform an actual, physical act in the real world.” *Washington Shoe Co. v. A-Z*  
11 *Sporting Goods, Inc.*, 704 F.3d 668, 674 (9th Cir. 2012); *Schwarzenegger*, 374 F.3d at 806 (an  
12 intentional act “refers to an intent to perform an actual, physical act in the real world.”). The  
13 threshold of what constitutes an intentional act is relatively low. Indeed, under Ninth Circuit law,  
14 an “intentional act” includes engaging in sales transactions outside the forum state, *CE*  
15 *Distribution, LLC v. New Sensor Corp.*, 380 F.3d 1107, 1111 (9th Cir. 2004); advertising a product  
16 outside the forum, *Schwarzenegger*, 374 F.3d at 806; or selling an allegedly infringing product  
17 outside the forum, *Washington Shoe Co.*, 704 F.3d at 674.

18 Here, *AirWair* has identified several of *NPS*’s acts that meet the definition of an intentional  
19 act. See *Opp’n* at 6. According to *AirWair*, *NPS* intentionally entered into a written exclusivity  
20 agreement with *Calceus* that made *Calceus* *NPS*’s official distributor in California. *First Am.*  
21 *Compl.* ¶¶ 27-28. *NPS* subsequently sold and shipped products to *Calceus* in California between  
22 January 2012 and January 2013. *Id.* ¶ 41. *NPS* then assisted *Calceus* in the marketing of allegedly  
23 infringing *Solovair* footwear, including assisting *Calceus* with design of *Calceus*’s *Solovair Direct*  
24 website. *Id.* ¶ 32. *NPS* clearly evinced an intent to perform “an actual, physical act in the real  
25 world.” *Schwarzenegger*, 374 F.3d at 806. In fact, district courts in the Ninth Circuit have found  
26 similar acts to satisfy the intentional act requirement. See *Chanel Inc. v. Yang*, No. C 12-4428  
27 *PJH*, 2013 WL 5755217, at \*7 (N.D. Cal. Oct. 21, 2013) (finding an intentional act for advertising  
28 and offering for sale allegedly infringing products on a website); *Herman Miller Inc. v. Alphaville*

1 Design Inc., No. C 08-03437 WHA, 2009 WL 3429739, at \*3 (N.D. Cal. Oct. 22, 2009) (finding an  
2 intentional act where trademark infringing products were delivered to a reseller in California with  
3 the intent to have those products sold in California). Therefore, the first prong of the Calder test is  
4 satisfied.

## 5 **2. Express Aiming**

6 The second prong of the purposeful direction inquiry is whether the defendant expressly  
7 aimed its act at the forum state. *Dole Food Co*, 303 F.3d at 1111. The “express aiming” analysis  
8 “depends, to a significant degree, on the specific type of tort or other wrongful conduct at issue.”  
9 *Schwarzenegger*, 374 F.3d at 807. In addition, to be satisfied, the “express aiming” inquiry  
10 requires “something more” than “a foreign act with foreseeable effects in the forum state.”  
11 *Washington Shoe Co.*, 704 F.3d at 675 (citing *Bancroft & Masters, Inc. v. Augusta Nat’l Inc.*, 223  
12 F.3d 1082, 1087 (9th Cir. 2000)). For instance, the delivery or consumption of products in the  
13 forum state that are “random,” “fortuitous,” or “attenuated” do not satisfy the express aiming  
14 analysis. *Mavrix Photo*, 647 F.3d at 1230 (citing *Burger King*, 471 U.S. 462, 486 (1985)). On the  
15 other hand, “where a defendant knows—as opposed to being able to foresee—that an intentional  
16 act will impact another state,” then “the ‘expressly aimed’ requirement is satisfied.” *Washington*  
17 *Shoe Co.*, 704 F.3d at 677 (emphasis in original); see also *Schwarzenegger*, 374 F.3d at 803  
18 (holding that purposeful direction “usually consists of evidence of the defendant’s actions outside  
19 the forum state that are directed at the forum, such as the distribution in the forum state of goods  
20 originating elsewhere”). Put another way, where the forum state is the “focal point both of the  
21 [conduct] and of the harm suffered,” jurisdiction is proper. *Calder*, 465 U.S. at 789; *DFSB*  
22 *Kolective Co., Ltd. v. Tran*, No. 11-CV-01049-LHK, 2011 WL 6730678, at \*3 (conduct of foreign  
23 defendant was expressly aimed at California where, inter alia, defendant “used several California  
24 companies to further his scheme of perpetuating” violations of plaintiff’s copyright).

25 As an illustrative example, the Ninth Circuit’s recent opinion in *Mavrix* involved two  
26 parties who were both out-of-state corporations: plaintiff was a photo agency headquartered in  
27  
28



1 Miami, Florida, and defendant was a celebrity gossip website based in Toledo, Ohio.<sup>1</sup> Mavrix  
2 Photo, 647 F.3d at 1221-22. Plaintiff sued defendant in California, alleging that the defendant had  
3 posted one of plaintiff’s copyrighted photos on defendant’s website. Id. at 1221. The question  
4 before the Ninth Circuit was whether the defendant was subject to personal jurisdiction in  
5 California, even though neither party was headquartered in California. Id. at 1221-2. Regarding  
6 the “expressly aimed” requirement, the Ninth Circuit found that the “most salient . . . fact [was]  
7 that Brand [the defendant] used Mavrix’s copyrighted photos as part of its exploitation of the  
8 California market for its own commercial gain.” Id. at 1229. As evidence that the defendant  
9 sought to exploit the California market, the Mavrix court pointed out that the defendant targeted  
10 advertisements to California residents, and that a California viewer base was an “integral  
11 component of [defendant]’s business model and its profitability.” Id. at 1230. Based on this  
12 evidence, the Ninth Circuit held that where a defendant “knows—either actually or  
13 constructively—about its California user base, and . . . it exploits that base for commercial gain,”  
14 that defendant expressly aims its conduct at California. Id. at 1230. Put another way, where a  
15 party “continuously and deliberately exploited” the market of the forum state, that evinces conduct  
16 expressly aimed at the forum. Id.; see also Keeton v. Hustler Magazine, Inc., 465 U.S. 770, 781  
17 (1983) (out-of-state magazine subject to personal jurisdiction where magazine was “carrying on a  
18 part of its general business in” forum state, and “continuously and deliberately exploited” the  
19 forum state’s market).

20 Here, AirWair has alleged that NPS signed Calceus to an exclusive distribution agreement,  
21 with the goal of selling NPS’s product in the California market. Specifically, AirWair claimed that  
22 NPS selected Calceus “to act as its official authorized importer, distributor, and reseller” of NPS’s  
23 footwear with the goal of “serv[ing] the entire North American market, including California.” First  
24 Am. Compl. ¶ 27. AirWair has also alleged that NPS shipped approximately 500 products to  
25 Calceus in California, in six separate shipments, for sale and distribution to customers in  
26 California, as well as other locations. Id. ¶ 41. AirWair further contended that Calceus did in fact

27 \_\_\_\_\_  
28 <sup>1</sup> Plaintiff also had a Los Angeles, California office, but the Ninth Circuit did not consider this to  
be relevant in its decision as to whether the defendant had expressly aimed its conduct at  
California. See Mavrix, 647 F.3d at 1229-30.

1 sell infringing footwear in California, including in this district. *Id.* ¶ 42 (citing Exhibit 13 to First  
2 Amended Complaint). NPS also stands accused of closely coordinating the sale, marketing, and  
3 distribution of infringing footwear with Calceus in California and elsewhere. See *id.* ¶¶ 40-45.  
4 According to AirWair, NPS also signed the distribution agreement with Calceus to use “Calceaus’s  
5 place of business in Poway, California as a central location to store Solovair footwear intended for  
6 the U.S. market . . . including California.” *Id.* ¶ 43. AirWair also alleged that NPS, or Calceus  
7 acting at NPS’s behest, established relationships with other retailers of footwear in, among other  
8 places, San Francisco and Berkeley, California. *Id.* ¶ 45. Finally, AirWair has alleged that while  
9 NPS was establishing these contacts with Calceus, NPS contemplated that it might inflict harm on  
10 AirWair’s trademark and discussed this fact with Calceus. See *id.* ¶ 30. Indeed, AirWair maintains  
11 brick-and-mortar stores in San Francisco and Los Angeles, *id.* ¶ 21, which makes it more likely  
12 that the sale of NPS’s infringing footwear would harm AirWair in the California market.

13 Taking the uncontroverted allegations in AirWair’s complaint as true, NPS “continuously  
14 and deliberately exploited” the California market, such that NPS “must reasonably anticipate being  
15 haled into court” here. *Hustler*, 465 U.S. at 781. AirWair has sufficiently pled, based on specific  
16 allegations, that NPS knew “actually or constructively” about its California customer base, and that  
17 NPS used AirWair’s protected trade dress “as part of its exploitation of the California market for its  
18 own commercial gain.” *Mavrix Photo*, 647 F.3d at 1229. Such conduct satisfies the “expressly  
19 aimed” requirement. *Id.*; see also *Plant Food Co-op v. Wolfkill Feed & Fertilizer Corp.*, 633 F.2d  
20 155, 159 (9th Cir. 1980) (where “the sale of a product of a distributor is not an isolated occurrence,  
21 but arises from the efforts of the distributor to serve, directly or indirectly, the market for its  
22 products in other states, it is not unreasonable to subject it to suit in one of those states.”) (emphasis  
23 added); *Monje v. Spin Master Inc.*, No. CV-09-1713, 2013 WL 2369888, at \*9 (D. Ariz. May 29,  
24 2013) (holding that a defendant “cannot plan to have its product shipped into all of the United  
25 States, work closely with another entity to execute that plan, and then object when a federal court  
26 located in one of those states attempts to exercise personal jurisdiction over it.”). Moreover,  
27 AirWair has pled that NPS and Calceus “discussed the fact that they were introducing footwear in  
28 the United States that included AirWair’s Trade Dress Marks, contemplating that it may draw legal

1 attention from AirWair.” First Am. Compl. ¶ 30. This indicates that NPS “knows—as opposed to  
2 being able to foresee—that an intentional act will impact” AirWair in California, in which case  
3 “the ‘expressly aimed’ requirement is satisfied.” Washington Shoe Co., 704 F.3d at 675 (emphasis  
4 in original).

5 NPS has argued that the “‘express aiming’ requirement is met when the defendant is alleged  
6 to have engaged in wrongful conduct targeted at a plaintiff whom the defendant knows to be a  
7 resident of the forum state.” Reply at 3. NPS appears to imply that because AirWair is not a  
8 resident of California, it is impossible for NPS to have expressly aimed its conduct at California. It  
9 is true that the Ninth Circuit has held that the expressly aimed requirement is met “when the  
10 defendant is engaged in wrongful conduct targeted at a plaintiff whom the defendant knows to be  
11 resident of the forum state.” Dole Food Co., 303 F.3d at 1111 (internal quotation marks omitted).  
12 However, while the fact that the plaintiff is a resident of the forum state may be sufficient for  
13 purposes of specific personal jurisdiction, it is not a necessary one. See, e.g., Mavrix Photo, 647  
14 F.3d at 1221-22; Hustler, 465 U.S. at 781 (New Hampshire court had personal jurisdiction over  
15 New York plaintiff and Ohio-based defendant where defendant “has continuously and deliberately  
16 exploited the New Hampshire market”); see also Herman Miller Inc. v. Alphaville Design Inc., No.  
17 C 08-03437, 2009 WL 3429739, at \*3 (N.D. Cal. Oct. 22, 2009) (foreign defendant’s delivery of  
18 counterfeit chairs to a company in California for the intended resale of the counterfeited chairs in  
19 California satisfied the express aiming requirement, even though plaintiff was an out-of-state  
20 corporation).

21 In addition, NPS has argued that substantial sales by a foreign company to a local  
22 distributor is not enough for personal jurisdiction. In support, NPS has cited three cases from the  
23 1950s, all of which pre-date the Ninth Circuit’s first enunciation of the “expressly aimed”  
24 requirement by over four decades. See Bancroft & Masters, Inc. v. *Augusta Nat’l Inc.*, 223 F.3d  
25 1082, 1087 (9th Cir. 2000). Moreover, none of these three cases are persuasive here. *Le Vecke v.*  
26 *Griesedieck Western Brewery Co.*, dealt with whether a foreign corporation that was not based in  
27 California was subject to local service of process. 233 F.2d 772, 776 (9th Cir. 1956). The Ninth  
28 Circuit ultimately ruled that the foreign corporation was not subject to local service of process,

1 relying in part on a provision of the California corporations code that was repealed in 1976. See *id.*  
2 at 724. Le Vecke did not address whether distribution through an intermediary could satisfy the  
3 “expressly aimed” requirement. Furthermore, the Le Vecke court noted the limitations of its ruling  
4 when it stated that whether a corporation is subject to service of process in-state “of course, turns  
5 on its peculiar facts.” *Id.* at 775.

6 In *Estwing Manufacturing Co. v. Superior Court of San Mateo County*, also cited by NPS, a  
7 man in California was injured by a hammer that he purchased from a local hardware company that  
8 was manufactured by an Illinois company. 275 P.2d 146, 147-48 (Cal. Ct. App. 1954). The  
9 California Court of Appeal ruled that there was no personal jurisdiction because the manufacturer  
10 had only put out a catalog and then filled orders of distributors, with no franchise agreements or  
11 other contracts. *Id.* Here, NPS has done much more than the defendant in *Estwing* because NPS  
12 had a more targeted relationship with its distributor. Unlike the defendant in *Estwing*, NPS  
13 allegedly entered into an exclusive relationship with a specific distributor, worked closely with that  
14 distributor to assist in the marketing and sale of its products in California and elsewhere, and  
15 encouraged that distributor to engage other retailers in the sale of its products. First Am. Compl. ¶¶  
16 27-29, 40, 45-46.

17 Finally, in *Bar’s Leaks Western, Inc. v. Pollock*, also cited by NPS, California and  
18 Michigan plaintiffs brought copyright and trademark infringement claims against California and  
19 Pennsylvania defendants. 148 F. Supp. 710, 711 (N.D. Cal. 1957). The Pennsylvania defendants  
20 claimed they had only shipped their products to an independent distributor in California, and  
21 moved to dismiss on the grounds of improper service and venue. *Id.* at 712. The court dismissed  
22 the Pennsylvania defendants, on the grounds that venue was improper under 28 U.S.C. § 1391, as  
23 “the inconveniences associated with defending a suit in the state’s federal court far outweigh the  
24 inconveniences visited upon the plaintiff . . . by his having to bring suit in a more appropriate  
25 forum.” *Id.* at 714. The relevant part of the *Bar Leaks* decision did not discuss personal  
26 jurisdiction, or the express aiming requirement. Accordingly, it is of minimal relevance here.

27 For the foregoing reasons, the Court finds that AirWair has made a prima facie showing  
28 that NPS expressly aimed its actions at California.



1 bearing an infringing trademark, and foreseeable that some of this harm would occur in  
2 California.”)

3 Here, AirWair’s First Amended Complaint stated that it sells its trademarked footwear  
4 through its website, brick and mortar stores, and at major retailers in California, including AirWair  
5 stores in San Francisco and Los Angeles. First Am. Compl. ¶ 21. AirWair further alleged that  
6 NPS sold infringing footwear in California via its exclusive in-state distributor, Calceus. Id. at 41-  
7 42. In addition, AirWair has pled that when NPS and Calceus first engaged in negotiations to enter  
8 into an exclusive distribution agreement, the two parties “discussed the fact that they were  
9 introducing footwear in the United States that included AirWair’s Trade Dress Marks,  
10 contemplating that it may draw legal attention from AirWair.” Id. ¶ 30. AirWair has therefore  
11 made out a prima facie case that AirWair sold trademarked footwear in California, that NPS  
12 infringed that trademark in California, and that NPS was aware that its acts would cause harm to  
13 AirWair in California. Therefore, AirWair has satisfied the foreseeable harm inquiry. Moreover,  
14 AirWair has satisfied all three parts of the purposeful direction test.

15 **B. Claim Arising Out of Form-Related Activities**

16 The second prong of the specific jurisdiction test requires that the plaintiff’s claims arise  
17 out of defendant’s forum-related activities. *Schwarzenegger*, 374 F.3d at 802. To determine  
18 whether the plaintiff’s claims arise from the defendant’s forum-related activities, courts use a  
19 traditional “but for” causation analysis. *Bancroft*, 223 F.3d at 1088. The Ninth Circuit has  
20 recognized that, in trademark infringement actions, if the defendant’s infringing conduct harms the  
21 plaintiff in a forum state where plaintiff uses its trademark, this element is satisfied. *Panavision*  
22 *Int’l, L.P.*, 141 F.3d at 1322; see also *Vanity.com, Inc. v. Vanity Shop of Grand Forks, Inc.*, No. C  
23 12-02912 SI, 2012 WL 4755041, at \*4 (N.D. Cal. Oct. 4, 2012) (where “[defendant]’s dealings  
24 with California customers enable it to profit from its alleged [trademark infringement]” then  
25 plaintiff’s “claims arise out of defendant’s forum-related activities.”)

26 Here, as discussed in Section III.A.3, *supra*, AirWair has established a prima facie case that  
27 NPS’s sales of allegedly infringing footwear harmed AirWair in California. In addition, AirWair  
28 has pled that NPS’s alleged infringement has damaged AirWair’s “business, reputation, and

1 goodwill,” caused AirWair to suffer “the loss of sales and profits,” and diluted AirWair’s  
2 trademark. See First Am. Compl. ¶ 48. Therefore, but for NPS’s alleged infringement, AirWair  
3 would not have endured the harm it has now claimed. AirWair has established a prima facie case  
4 that its claim arises out of NPS’s alleged infringement.

### 5 **C. Reasonableness**

6 Once a plaintiff has met its burden on the first two prongs of the specific personal  
7 jurisdiction inquiry, the burden shifts to the defendant to show why the exercise of specific  
8 personal jurisdiction would not be reasonable and fair. *Schwarzenegger*, 374 F.3d at 802.  
9 Generally, a defendant must “present a compelling case that the exercise of jurisdiction would not  
10 be reasonable.” *Id.* (internal quotation marks omitted). However, a plaintiff seeking to hale a  
11 foreign defendant into court in the United States must meet a “higher jurisdictional threshold” than  
12 is required when a defendant is a United States resident. See *Core-Vent Corp. v. Nobel Indus. AB*,  
13 11 F.3d 1482, 1490 (9th Cir. 1993)

14 Seven factors are considered to determine whether personal jurisdiction is reasonable: (1)  
15 the extent of a defendant’s purposeful interjection; (2) the burden on the defendant in defending in  
16 the forum; (3) the extent of conflict with the sovereignty of the defendant’s state; (4) the forum  
17 state’s interest in adjudicating the dispute; (5) the most efficient judicial resolution of the  
18 controversy; (6) the importance of the forum to the plaintiff’s interest in convenient and effective  
19 relief; and (7) the existence of an alternative forum. *Panavision*, 141 F.3d at 1323 “No one factor  
20 is dispositive; a court must balance all seven.” *Id.*

#### 21 **1. Purposeful Interjection**

22 “Even if there is sufficient ‘interjection’ into the state to satisfy the [purposeful availment  
23 prong], the degree of interjection is a factor to be weighed in assessing the overall reasonableness  
24 of jurisdiction under the [reasonableness prong].” *Core-Vent Corp.*, 11 F.3d at 1488 (quoting  
25 *Insurance Co. of N. Am. v. Marina Salina Cruz*, 649 F.2d 1266, 1271 (9th Cir. 1981)). “The  
26 smaller the element of purposeful interjection, the less is jurisdiction to be anticipated and the less  
27 reasonable is its exercise.” *Id.*

1 Here, the fact that NPS is based in the United Kingdom, and claims it does not have any  
2 officers, employees, registered agents, or property in California, tips against purposeful  
3 interjection.<sup>3</sup> See Castle Decl. ¶¶ 4, 8, 11 & 12. However, according to AirWair’s First Amended  
4 Complaint, NPS negotiated with Calceus, a California business, for Calceus to become NPS’s  
5 exclusive importer and distributor in North America. First Am. Compl. ¶¶ 28-29. NPS sold and  
6 shipped over 500 units of footwear to Calceus in California, and worked closely with Calceus to  
7 coordinate the marketing and sales of NPS’s product in the United States, including California. *Id.*  
8 ¶¶ 40-41. Moreover, AirWair has alleged that NPS discussed with Calceus the possibility that  
9 NPS’s sales of infringing footwear might draw the legal attention of AirWair. *Id.* ¶ 30. NPS  
10 therefore allegedly knew of the damage its sales might cause AirWair’s trademark, a factor that tips  
11 in favor of finding a larger degree of purposeful interjection. See *Panavision*, 141 F.3d at 1323  
12 (finding more purposeful interjection where there is knowledge of likely injury). The Court finds  
13 that this factor weighs in favor of finding that personal jurisdiction is reasonable.

## 14 2. Burden on Defendant

15 When considering the burden on the defendant, “unless the ‘inconvenience is so great as to  
16 constitute a deprivation of due process, it will not overcome clear justifications for the exercise of  
17 jurisdiction.’” *Panavision*, 141 F.3d at 1323 (quoting *Caruth v. Int’l Psychoanalytical Ass’n*, 59  
18 F.3d 126, 128-29 (9th Cir. 1995)). Here, NPS has stated that forcing NPS to litigate in California  
19 would impose a great burden on NPS, but NPS makes no factual showing of this burden other than  
20 to point out that NPS’s headquarters in the United Kingdom is 5,000 miles away. Reply at 8.  
21 However, while litigating this matter in California may impose some burden on NPS, concerns  
22 over exerting jurisdiction over international defendants have diminished as “progress in  
23 communications and transportation has made the defense of a suit in a foreign tribunal less  
24 burdensome.” *World-Wide Volkswagen Corp. v. Woodson*, 444 U.S. 286, 294 (1980) (quoting  
25 *Hanson v. Denckla*, 357 U.S. 235, 250–251 (1958)); see also *Panavision*, 141 F.3d at 1323 (“in  
26 this era of fax machines and discount air travel, requiring [defendant] to litigate in California is not  
27 constitutionally unreasonable.”) NPS may confer with its local counsel by phone, fax, e-mail,

28 <sup>3</sup> AirWair appears not to argue that Calceus was NPS’s agent in California.



1 video conference, or other forms of electronic communication. In light of the fact that “modern  
2 advances in communications and transportation have significantly reduced the burden on litigating  
3 in another country,” *Sinatra v. Nat’l Enquirer, Inc.*, 854 F.2d 1191, 1199 (9th Cir. 1988), the Court  
4 finds that NPS has not carried its burden to show that this factor tips in its favor, and therefore it is  
5 neutral.

### 6 **3. Conflict with the Sovereignty of Defendant’s State**

7 Conflict with the sovereignty of a defendant’s state requires “an examination of the  
8 competing sovereign interests in regulating [the defendant’s] behavior.” *Dole Food Co.*, 303 F.3d  
9 at 1115. However, since sovereignty concerns inevitably arise whenever a U.S. court exercises  
10 jurisdiction over a foreign national, this factor is “by no means controlling,” *Ballard v. Savage*, 65  
11 F.3d 1495, 1501 (9th Cir. 1995); otherwise “it would always prevent suit against a foreign national  
12 in a United States court,” *Gates Learjet Corp. v. Jensen*, 743 F.2d 1325, 1333 (9th Cir. 1984).  
13 Here, the United Kingdom has some interest in regulating the conduct of its resident corporations.  
14 However, AirWair’s complaint only raises questions of U.S. and California law; it does not allege  
15 any cause of action under the laws of the United Kingdom, or any other sovereign country.  
16 Therefore, this factor is at best neutral.

### 17 **4. California’s Interest**

18 California has a strong interest in discouraging trademark infringement injuries that occur  
19 within the state. See *Fujitsu Ltd. v. Belkin Int’l, Inc.*, 782 F. Supp. 2d 868, 885 (N.D. Cal. 2011)  
20 (finding California has a strong interest in preventing patent infringement injury within the state,  
21 even where committed by a foreign Taiwanese company); *Beverly Hills Fan. Co. v. Royal*  
22 *Sovereign Corp.*, 21 F.3d 1558, 1568 (Fed. Cir. 1994) (forum state “has an interest in discouraging  
23 injuries that occur within the state” including injuries stemming from patent infringement). This  
24 interest derives in part from California’s “strong interest in protecting its citizens from trademark  
25 infringement and consumer confusion.” *Nissan Motor Co. v. Nissan Computer Corp.*, 89 F. Supp.  
26 2d 1154, 1161 (C.D. Cal. 2000). In addition, California has an interest in adjudicating actions in  
27 which a California company is used to perpetuate trademark infringement. See *DFSB Kollektive*  
28 *Co.*, 2011 WL 6730678, at \*5 (California has an interest in adjudicating dispute where “California

1 companies [are used] to perpetuate . . . copyright infringement”). Therefore the Court finds this  
2 factor weighs in favor of reasonableness.

### 3 **5. Efficient Resolution**

4 The Ninth Circuit has held that efficient resolution “focuses on the location of the evidence  
5 and witnesses. It is no longer weighed heavily given the modern advances in communication and  
6 transportation.” Panavision, 141 F.3d at 1323 (internal citation omitted). Further, “electronic  
7 access to documents makes the location of . . . evidence far less important to efficient resolution of  
8 the case.” Anspach v. Meyer, No. CV-13-01877, 2014 WL 345676, at \*5 (D. Ariz. Jan. 30, 2014).  
9 Here, witnesses for NPS and AirWair may have to engage in significant travel to this forum,  
10 making resolution less efficient. However, Calceus, which is based in California, may also play a  
11 central role in any trial, and therefore California would be the most efficient forum for any  
12 witnesses from Calceus. On balance, and considering the Ninth Circuit has explained that this  
13 factor is not weighed heavily, this factor is neutral.

### 14 **6. Convenience to Plaintiff**

15 “In evaluating the convenience and effectiveness of relief for the plaintiff, we have given  
16 little weight to the plaintiff’s inconvenience.” Panavision, 141 F.3d at 1324; see also Dole Food  
17 Co., 303 F.3d at 1116 (“[I]n this circuit, the plaintiff’s convenience is not of paramount  
18 importance.”). Although AirWair is from the United Kingdom, AirWair chose to litigate in this  
19 forum. Further, AirWair’s inconvenience is mitigated somewhat by the fact that it has a presence  
20 in California with stores in San Francisco and Los Angeles. Compl. ¶ 21. Therefore this factor,  
21 although given little weight, is neutral.

### 22 **7. Alternative Forum**

23 NPS has contended that AirWair should have filed this lawsuit in the United Kingdom, the  
24 home country for both parties. Reply at 9. However, AirWair raises no claims under the laws of  
25 the United Kingdom; to the contrary, all of AirWair’s prayers for relief arise under U.S. or  
26 California law. See First Am. Compl. at 10-14. NPS also does not establish that AirWair could  
27 assert its claims for U.S. and California trademark infringement in the United Kingdom. The Court  
28 finds that this factor weighs in favor of reasonableness.

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On balance, three factors in the reasonableness test weigh in AirWair’s favor, and the remaining are neutral. The Court therefore finds that NPS has not satisfied its burden to show that the exercise of specific personal jurisdiction would be unreasonable.

**IV. CONCLUSION**

For the foregoing reasons, the Court DENIES NPS’s motion to dismiss.

**IT IS SO ORDERED.**

Dated: November 12, 2014

  
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LUCY H. KOH  
United States District Judge