

The Honorable Richard A. Jones

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**UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WASHINGTON
AT SEATTLE**

11 ULYSSES GMBH & CO. KG, a German
12 limited partnership,

13 Plaintiff,

14 v.

15 ULYSSESWINDOWS.COM, an unknown
16 entity, SUNISOFT, an unknown entity,
17 SHEN MIN, an individual, CATALINA
18 DEL CASTILLO, an individual aka
"Catalina DC," MERA INC., an unknown
entity, and DOES 1-5

19 Defendants.

Case No. 2:18-cv-00202-RAJ

**ORDER DENYING PLAINTIFF'S
MOTION FOR FOREIGN SERVICE
OF PROCESS UNDER
FRCP(f)(2)(C)(ii) AND FRCP(f)(3)**

21 This matter comes before the Court on Plaintiff's Motion for an Order Directing
22 Foreign Service of Process under Rule 4(f)(2)(C)(ii) and Rule 4(f)(3) of the Federal Rules
23 of Civil Procedure (Dkt. # 12). For the reasons discussed below, this motion is **DENIED**
24 without prejudice.

25 **I. BACKGROUND**

26 On February 8, 2018, Plaintiff, Ulysses GMBH & CO. KG ("Ulysses" or
27 "Plaintiff") brought this action against Defendants, ULYSSESWINDOWS.COM, an
28 unknown entity, and DOES 1-5, asserting trademark infringement, cybersquatting, and

1 false advertising claims. Dkt. #1. Plaintiff alleges that Defendants sold and marketed a
2 software application “Ulysses for Windows” using the domain name
3 “UlyssesWindows.com” and falsely represented that the app was the “genuine Ulysses
4 App.” Dkt. #1 ¶ 18-31. Early discovery served upon Domain Protection Services, the
5 privacy registration service used to register the allegedly infringing domain, revealed that
6 the domain was registered by the account “sunisoft.” Dkt. #12. According to records
7 obtained by Plaintiff, the “sunisoft” account was used by two individuals, Defendant
8 Shen Min (“Defendant Min”) and Defendant Catalina Del Castillo (“Defendant Del
9 Castillo”) to register and renew the allegedly infringing domain. *Id.* Plaintiff also
10 obtained contact information for each defendant, including postal addresses for
11 Defendant Min in China and Defendant Del Castillo in Brazil, and e-mail addresses for
12 both Defendants. *Id.* Plaintiff now seeks leave to serve Defendant Del Castillo by e-mail
13 and private courier and Defendant Min by e-mail.

14 **II. LEGAL STANDARD**

15 Federal Rule of Civil Procedure 4(h)(2) allows service of process upon a foreign
16 corporation to be effected “in any manner prescribed for individuals by subdivision [4](f)
17 except personal delivery.” Rule 4(f) authorizes several methods for service of process
18 including, an “internationally agreed means of service,” or, if there is no “internationally
19 agreed means,” a method that is reasonably calculated to give notice. Fed. R. Civ. P.
20 4(f).

21 **III. DISCUSSION**

22 **A. Service by private courier is prohibited by international agreement**

23 Under Rule 4(f)(2)(C)(ii) a foreign defendant may be served “by a method that is
24 reasonably calculated to give notice[,] unless prohibited by the foreign country’s law, by
25 ... using any form of mail that the clerk addresses and sends to the individual and that
26 requires a signed receipt.” Plaintiff asks the Court for leave to serve Defendant Del
27 Castillo by private courier in Brazil at the address associated with the “sunisoft” account
28 used to register the allegedly infringing domain. Dkt. #12 at 7.

1 As noted by Plaintiff, Brazil and the United States are both signatories to the Inter-
2 American Convention on Letters Rogatory and Additional Protocol (“Inter-American
3 Convention”), which provides a mechanism for service of documents by a foreign central
4 authority. *Id.* Plaintiff argues that service by private courier to Defendant Del Castillo’s
5 address in Brazil does not conflict with the Inter-American Convention. *Id.* Effective
6 June 1, 2019, however, Brazil is also a signatory to the Hague Convention on the Service
7 Abroad of Judicial and Extrajudicial Documents (“Hague Convention”). *See* Hague
8 Convention, Nov. 15, 1965, 20 U.S.T. 361, T.I.A.S. No. 6638; Hague Conference on
9 Private International Law, Status Table, available at:
10 <https://www.hcch.net/en/instruments/conventions/status-table/?cid=17> (last visited Jul.
11 15, 2019).¹ China and the United States are also signatories. *See Melnichuk v. Fine Hau*
12 *Indus. Co.*, 2019 WL 2515181, at *1 (W.D. Wash. June 18, 2019) (internal citation
13 omitted). As a result, the Court must consider whether Plaintiff’s proposed method of
14 service violates the Hague Convention.

15 The Hague Convention requires signatory countries to establish a Central
16 Authority to receive requests for service of documents from other countries and to serve
17 those documents by methods compatible with the internal laws of the receiving state. *See*
18 *Volkswagenwerk Aktiengesellschaft v. Schlunk*, 486 U.S. 694, 698–99 (1988). Service
19 through a country’s Central Authority is the principal means of service under the Hague
20 Convention. *Id.* Article X of the Convention preserves the ability of parties to effect
21 service through means other than a recipient-nation’s Central Authority as long as the
22 recipient-nation has not objected to the specific alternative means of service used. *See*
23 Hague Convention, art. 10, Feb. 10, 1969, 20 U.S.T. 361, T.I.A.S. No. 6638. In signing
24

25 ¹ The record before the Court does not include Brazil’s accession to the Hague
26 Convention. Under Federal Rule of Evidence 201, however, the court may take judicial
27 notice, *sua sponte*, of a “fact not subject to reasonable dispute,” including international
28 treaties. *See States v. Spector*, 102 F. Supp. 75, 83 (S.D. Cal. 1951), rev’d on other
grounds, 193 F.2d 1002 (9th Cir. 1952) (explaining that a court may take judicial notice
of extradition treaties between the United States and other countries).

1 the Convention, however, Brazil expressly rejected service through means enumerated in
2 Article X, including service through postal channels and through its judicial officers. *See*
3 Declaration of Brazil in Connection with the Convention, Hague Convention, Nov. 15,
4 1965, 20 U.S.T. 361, T.I.A.S. No. 6638, available at: [https://www.hcch.net/en/
5 instruments/conventions/status-table/notifications/?csid=1399&disp=resdn](https://www.hcch.net/en/instruments/conventions/status-table/notifications/?csid=1399&disp=resdn) (last visited
6 Jul. 15, 2019). Accordingly, Plaintiff’s proposed method of serving Defendant Del
7 Castillo by private courier under Fed. R. Civ. P. 4(f)(2)(C)(ii) is prohibited by
8 international agreement.

9 **B. Plaintiff has not shown sufficient cause to merit alternative service**

10 Under Fed.R.Civ.P. 4(f)(3), courts have discretion to allow service by alternative
11 means provided the court’s method of service comports with constitutional notions of due
12 process and is not prohibited by international agreement. *Rio Properties, Inc. v. Rio Int’l*
13 *Interlink*, 284 F.3d 1007, 1016 (9th Cir. 2002). A method of service comports with due
14 process if it is “reasonably calculated, under all the circumstances, to apprise interested
15 parties of the pendency of the action and afford them an opportunity to present their
16 objections.” *Rio Properties, Inc.*, 284 F.3d at 1016, 1017 (quoting *Mullane v. Cent.*
17 *Hanover Bank & Trust*, 339 U.S. 306, 314 (1950)). Courts have authorized numerous
18 methods of alternative service under Rule 4(f)(3), including service by publication, mail,
19 and e-mail. *Id.* at 1016 (citations omitted). Parties are not required to attempt service by
20 other methods before petitioning the court for alternative service of process, instead it is
21 within the discretion of the district court to determine “when the particularities and
22 necessities of a given case require alternate service of process under rule 4(f)(3).” *Id.* at
23 1016.

24 Courts have considered a variety of factors when evaluating whether to grant relief
25 under Rule 4(f)(3) including whether the plaintiff identified a physical address for the
26 defendant, whether the defendant was evading service of process, and whether the
27 plaintiff had previously been in contact with the defendant. *See e.g. Rio Properties, Inc.*
28 *v. Rio Int’l Interlink*, 284 F.3d 1007 (9th Cir. 2002) (authorizing alternative service where

1 the plaintiff made multiple good faith yet unsuccessful attempts to serve the defendant
2 and the defendant was “striving to evade service of process”); *Liberty Media Holdings,*
3 *LLC v. Vinigay.com*, 2011 WL 810250 (D. Ariz. Mar. 3, 2011) (allowing alternative
4 service by e-mail where the plaintiff was unable to identify a physical address for the
5 defendant and the plaintiff had previously communicated with the defendant by e-mail);
6 *Sun v. Kao*, 170 F. Supp.3d 1321, 1327 (W.D. Wa. 2016) (permitting alternative service
7 via email where defendant was living in China at an unknown address and plaintiff
8 detailed threat of irreparable harm without expedited service).

9 The advisory committee notes to Rule 4 also provide several examples of situations
10 that might merit alternative means of service such as cases of urgency or the failure of a
11 country’s Central Authority to effect service within the six-month period provided by the
12 Hague Convention. *See* Fed. R. Civ. P. 4 advisory committee’s notes (1993 amendment,
13 subdivision (f)). The advisory notes caution courts to select a method of service that is
14 “consistent with due process and minimizes offense to foreign law.” *Id.*

15 Plaintiff argues that alternative service should be allowed because service under
16 the Inter-American Convention can be “problematic” and “fruitless.” Dkt. # 12 at 9.
17 This alone is insufficient to justify alternative service under Rule 4(f)(3). *U.S. Aviation*
18 *Underwriters, Inc. v. Nabtesco Corp.*, 2007 WL 3012612, at *2 (W.D. Wash. Oct. 11,
19 2007) (denying alternative service where the sole basis for the request was to move the
20 case forward in an “expeditious and cost-effective manner”). Plaintiff has identified
21 physical addresses for each of the defendants and there is no evidence that the defendants
22 are attempting to avoid service of process, as in *Rio Properties*. 284 F.3d at 1016. While
23 a plaintiff need not have attempted every possible method of service of process before
24 petitioning the court for alternative relief, it must “demonstrate that the facts and
25 circumstances of the present case necessitate[] the district court's intervention.” *Id.* at
26 1016. The Court finds that, at present, Plaintiff has failed to do so.

27 **IV. CONCLUSION**

28 For the foregoing reasons, Plaintiff’s Motion for an Order Directing Foreign Service

1 of Process under Rule 4(f)(2)(C)(ii) and Rule 4(f)(3) of the Federal Rules of Civil
2 Procedure (Dkt. # 12) is **DENIED** without prejudice. Plaintiff has 30 days from the date
3 of this Order to serve the Defendants in accordance with Rule 4(f) and the Hague
4 Convention.

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6 DATED this the 29th of July, 2019.

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10 The Honorable Richard A. Jones
11 United States District Judge
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