



ARE Patent Law Alert: Supreme Court to Decide Whether Foreign Sale Exhausts Copyrights

April 23, 2010

Author(s): Charles R. Macedo, Josep Casino, Michael J. Kasdan

(April 23, 2010) On April 20, 2010 the Supreme Court announced that it has accepted certiorari in *Costco Wholesale Corp. v. Omega, S.A.*, Docket No. 08-1423 (2010) to determine whether an authorized foreign sale of a product exhausted applicable U.S. copyrights.

In *Costco*, Omega, a watch manufacturer, filed suit against Costco, a retailer, alleging that Costco's purchase of watches from foreign distributors, and resale of those watches in the United States below their suggested retail price, constituted copyright infringement. Omega's specific copyright claim was in the "Omega Globe Design" that is engraved in the underside of its watches. The U.S. District Court for the Central District of California granted summary judgment of noninfringement in favor of Costco, based upon the exhaustion doctrine. *Omega S.A. v. Costco Wholesale Corp.*, No. CV 04-5443 (C.D. Cal. June 8, 2005). On appeal, the Ninth Circuit Court of Appeals reversed, holding that Omega's U.S. copyright was not exhausted because Omega had first sold the watches to distributors overseas. *Omega S.A. v. Costco Wholesale Corp.*, 541 F.3d 982 (9th Cir. 2008). The Ninth Circuit reasoned that under U.S. copyright law exhaustion only applied to a first lawful sale in the United States and that foreign sales could not trigger exhaustion.

Costco, which will be argued to the Court next fall, could dramatically affect the impact of exhaustion on foreign companies. The decision could also have broad implications outside of copyright law. Specifically, the related doctrine of patent exhaustion prevents patent owners from collecting licensing royalties from multiple entities in a supply chain for use of the same patented invention. However, as the Ninth Circuit held in *Costco* in the context of copyright infringement, the Federal Circuit has likewise held that foreign sales or licenses, even if authorized, cannot exhaust U.S. Patents. *Jazz Photo Corp. v. U.S. ITC*, 264 F.3d 1094, 1105 (Fed. Cir. 2001); see also *Fuji Photo Film Co., Ltd. v. Jazz Photo Corp.*, 394 F.3d 1368, 1376 (Fed. Cir. 2005) ("the patentee's authorization of an international first sale does not affect exhaustion of the patentee's rights in the United States"); *but see LG Electronics, Inc. v. Hitachi, Ltd.*, No. C 07-6511 CW (N.D. Cal. Mar. 13, 2009) (holding that after the Supreme Court's reaffirmation of a broad patent exhaustion doctrine in *LGE v. Quanta*, patent exhaustion now applies to foreign sales).

The Supreme Court last addressed the issue of patent exhaustion just two years ago in *Quanta Computer, Inc. v. LG Elecs., Inc.*, 553 U.S. 617 (U.S. 2008). See [Will The High Court Clarify The Exhaustion Doctrine?](#), IP Law360 (January 16, 2008); [Reviving The Exhaustion](#)



[Doctrine](#), IP Law360 (January 10, 2008). However, the *Quanta* decision left open a number of important issues relating to exhaustion, including the question of whether foreign sales exhausted patent rights. See *Quanta Computer v. LG Electronics: Will The Supreme Court Revive The Exhaustion Doctrine?*, Amster, Rothstein & Ebenstein, LLP (January 2008).

We will be providing additional details as this case develops. Please check our website for additional reports on this issue.

For further information on how this issue could impact your business, please contact one of our attorneys.

* Joseph Casino was a Partner, [Charles R. Macedo](#) is a Partner, [Mark Berkowitz](#) is an Associate, and Michael Kasdan was an Associate at Amster, Rothstein & Ebenstein LLP. Their practice specializes in intellectual property issues including litigating patent, trademark and other intellectual property disputes, prosecuting patents before the U.S. Patent and Trademark Office, and other patent offices throughout the world, registering trademarks and service marks with U.S. Patent and Trademark Office, and other trademark offices throughout the world, and drafting and negotiating intellectual property agreements. They may be reached at cmacedo@arelaw.com and mberkowitz@arelaw.com.

453622.1