



The plaintiff is a former professional tennis player and a lifelong tennis enthusiast. In early 2003, plaintiff applied to the United States Patent and Trademark Office for a patent on an invention titled “Dual Surface for Sport Event or Game.” The patent office granted the application in 2004.

The primary invention covered by the patent is a “hybrid tennis court with one type of surface applied to one side of the net from the net to the back fence and a different type of surface applied to the other side of the net from the net to the back fence”. See U.S. Patent No. 6,814,669 (issued Nov. 9, 2004). By way of background, the game of lawn tennis is generally played on a court which has only one type of surface, from the back fence on one side of the net to the back fence on the other side, and there are several different surfaces on which the game is commonly played. Plaintiff’s patent envisions a tennis court with different surfaces on either side of the net. The patent avers that such a court might prove useful as a teaching tool (allowing lessons to take place on more than one surface), and that the court would allow players who have different preferences as to surfaces to play against each other. Tennis players sometimes specialize in playing on a particular surface, professional tennis players are sometimes known for their prowess on particular surfaces, and this specialization led somewhat to this dispute.

Shortly after obtaining the patent, plaintiff contacted defendant IMG to attempt to license the patent for use in a match to be staged between the number one and number two ranked professional tennis players in the world. Roger Federer, the player ranked number

one in the world at the time, was generally renowned as the best grass court tennis player in the world. Rafael Nadal, the player ranked number two in the world at the time, was generally renowned as the best clay court tennis player in the world. Plaintiff sought to license IMG the right to use her patent to stage a match between Federer and Nadal on a court with grass on one side of the net and clay on the other. IMG expressed no interest in the match, and plaintiff continued to market rights to her patent to third parties with the hope of scheduling the match in the future.

In 2007, plaintiff again met with IMG to discuss the possibility of scheduling the match between Federer and Nadal, and IMG again led plaintiff to believe that it was not interested in the match. To phrase it more completely, IMG, whether it said so or not, was only not interested in the match insofar as it included plaintiff in the equation because IMG was, at that time, working with defendant Saatchi & Saatchi, a marketing company based in Argentina, to schedule a match between Federer and Nadal on a half-clay, half-grass court in Nadal's home of Mallorca, an island which is part of the Kingdom of Spain. The match occurred May 2, 2007, was televised throughout the world, and was advertised as the "Battle of the Surfaces."

Plaintiff brought suit against IMG and Saatchi & Saatchi alleging patent infringement, violation of the trademark laws, a state law unfair trade practices claim, and civil conspiracy. The defendants filed separate motions to dismiss, see [dkt. #'s 50 & 51], which have been

fully briefed, and the court heard arguments on the motions June 4, 2008. For the reasons that follow, the court grants the defendants' motions.

## LAW/ANALYSIS

### I. Personal Jurisdiction

Saatchi & Saatchi argue that it is not subject to personal jurisdiction in this court. The court agrees.

The constitutional test for personal jurisdiction has two related components: the minimum contacts inquiry and the fairness inquiry. See *World-Wide Volkswagen Corp. v. Woodson*, 444 U.S. 286 (1980). Due process requires that a non-resident defendant have certain minimum contacts with the forum such that the maintenance of the suit does not offend "traditional notions of fair play and substantial justice." *Int'l Shoe Co. v. Washington*, 326 U.S. 310, 316 (1945). The assertion of personal jurisdiction satisfies due process if "the defendant purposely avails itself of the privilege of conducting activities within the forum state," *Hanson v. Denckla*, 357 U.S. 235, 253 (1958), such that the defendant "should reasonably anticipate being haled into court there," *World-Wide Volkswagen*, 444 U.S. at 297. South Carolina courts have construed South Carolina's long-arm statute, S.C. Code Ann. § 36-2-803 (Supp. 2007), to reach the limits of due process. See *Cockrell v. Hillerich & Bradsby Co.*, 363 S.C. 485, 491, 611 S.E.2d 505, 508 (2005).

Personal jurisdiction over an out of state defendant is sometimes characterized as either "general" or "specific." "Specific" jurisdiction exists when a cause of action arises out

of or is related to a defendant's activities in the forum state. "General" jurisdiction arises from a defendant's "continuous and systematic" activities in the forum state. See *Helicopteros Nacionales de Colombia, S.A. v. Hall*, 466 U.S. 408, 415-16 (1984). The court finds neither specific nor general jurisdiction over Saatchi & Saatchi in this case.

As to general jurisdiction, the court finds that there is no evidence that Saatchi & Saatchi have any systematic or continuous contacts with South Carolina. Saatchi & Saatchi apparently has only one place of business, located in the country of Argentina, and Saatchi & Saatchi apparently do not own property, maintain offices, or conduct business in South Carolina. The conclusion that there is a lack of general jurisdiction in this case is not altogether unsurprising - plaintiff's pleadings on this issue give the impression that she hinges her jurisdictional argument primarily on specific jurisdiction.

Turning to specific jurisdiction, the court finds that this case is similarly flawed. Recalling that specific jurisdiction exists when a cause of action arises out of the defendant's activities in the forum state, jurisdiction here must fail because Saatchi & Saatchi had very little interaction with South Carolina, and the court finds that none of this limited interaction was meaningful.

Plaintiff first alleges that Saatchi & Saatchi committed an intentional tort which was directed at a resident of South Carolina, but as this order will later make clear, the court finds as a matter of law that plaintiff has failed to allege conduct which amounts to a tort.

Second, plaintiff points to e-mail correspondence between her and Saatchi & Saatchi's chief executive, but this argument fails no better. As a starting point, this e-mail traffic was initiated by plaintiff, but more importantly, the e-mails do not discuss potential infringement of plaintiff's patent or protection of her rights in the pending exhibition. Instead, the e-mail provides:

I have noticed that your company is promoting a tennis match between Roger Federer and [Rafael] Nadal on May 2 in Mallorca. It is on a hybrid court, which is actually my idea, which I have a patent for. If the exhibition goes well in Mallorca, which I believe is run by a Mr. Pablo Del Campo, would you be interested in doing it in the US? I would like to get a licensing agreement on my patent and believe that possibilities are endless with Hybrid Court. I will try to call your office tomorrow. Thank you for your time.

See [dkt. # 67-3, p.2]. The Fourth Circuit has instructed that “[t]he unilateral activity of those who claim some relationship with a nonresident defendant cannot satisfy the requirement of contact with the forum State.” *Chung v. NANA Dev. Corp.*, 783 F.2d 1124, 1127 (1986) (quoting *Hanson v. Denckla*, 357 U.S. 235, 253 (1958)). The court finds this maxim particularly appropriate in this case - the correspondence relates more to future business opportunities than Saatchi & Saatchi's then-current activities over which plaintiff now cries “foul!”

Plaintiff's final two specific jurisdiction arguments fall by the wayside as well. Plaintiff argues that Saatchi & Saatchi enabled third parties to infringe her patent and are therefore subject to jurisdiction under the “stream of commerce” and “effects” tests, see *Calder v. Jones*, 465 U.S. 783, (1984) and *World-Wide Volkswagen v. Woodson*, 444 U.S.

286 (1980), but as this order will lay out, there has been no infringement here. Similarly, plaintiff's argument based on Rule 4(k) of the Federal Rules of Civil Procedure does not get off the ground. To establish jurisdiction under Rule 4(k), plaintiff must demonstrate that the court's exercise of jurisdiction would be "consistent with the Constitution and laws of the United States." *Base Metal Trading v. Ojsc Novokuznetsky Aluminum Factory*, 283 F.3d 208, 215 (4th Cir. 2002). As the court has set forth, exercising jurisdiction over Saatchi & Saatchi in this case would not comport with the constitutional requirement of due process.

For the foregoing reasons, the court finds that it cannot exercise personal jurisdiction over defendant Saatchi & Saatchi in this case.

## **II. Failure to State a Claim**

Plaintiff asserts four claims against IMG, and IMG argues that none of these claims are of such a type that relief can be granted to the plaintiff on them. The court agrees.

### *Patent Infringement*

United States patent laws secure to the holder of a patent the exclusive rights to make, use, offer to sell, and sell their inventions. See 35 U.S.C.A. § 271 (West 2001). With regard to plaintiff's claim for patent infringement, the question in this case is whether IMG has made, offered to sell, sold, or used plaintiff's invention *in the United States*. In this case, the court concludes that IMG has not.

The patent laws of the United States "do not, and were not intended to, operate beyond the limits of the United States." *Brown v. Duchesne*, 60 U.S. 183, 195 (1856). Thus,

although there is no allegation that IMG constructed, sold, or offered to sell a hybrid tennis court in Mallorca, Spain, there would be no violation of the United States patent laws if they did so. In this case, plaintiff contends that IMG *used* her patent in the United States by maintaining a globally accessible website which promoted the tennis exhibition in Spain, utilized depictions of the hybrid tennis court, promoted ticket sales within the United States to the foreign event, and allowed the download of both photographs and videos of the match. Plaintiff additionally contends IMG used her patent by controlling the overall broadcast rights to the exhibition, which included broadcasting in the United States, promoting its own services through depictions of the hybrid tennis court, and receiving money from the exhibition.

The court finds that these allegations simply spread the term “use” too thin. As a practical matter, the exhibition promoted on the internet and televised throughout the world was held on a tennis court built and housed in the Kingdom of Spain, and it was this Spanish tennis court that provided the playing surface for the “Battle of the Surfaces” exhibition over which IMG and other entities obtained trademarks, advertised, and licensed broadcast rights throughout the world. In this case, the hybrid tennis court was not “used” in the United States - it was “used” in Spain and that use was broadcast in the United States. Plaintiff’s frustration is perhaps understandable, but in the event the hybrid tennis court enjoyed increased visibility by virtue of the foreign exhibition, plaintiff may ultimately receive the fruits of some free advertising.

The cases plaintiff cites to support her argument are meaningfully distinguishable. It is true that the Court of Appeals for the Federal Circuit recently found that a claim for patent infringement was not precluded even though a portion of the acts alleged as infringement occurred outside the United States, see *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1316-17 (2005), but in *NTP* the patents in issue covered electronic mail transmission technology and the integration of electronic mail systems, and the evidence there suggested that although the alleged infringer was located primarily in Canada, customers in the United States could use and benefit from the technology. See *id.*, at 1289, 1317. IMG did not use plaintiff's hybrid tennis court in the United States in the same way that customers in *NTP* used e-mail integration technology. IMG was involved in developing and publicizing a tennis match played on foreign soil on a tennis court over which plaintiff enjoys no rights unless that court is made, used, offered for sale, or sold in the United States. When it comes to a tennis court, this judicial court is of the opinion that the playing surface must be in the United States for the surface to be "used" here. Should such use occur, plaintiff's patent would unquestionably be in play.

Accordingly, the court grants IMG's motion to dismiss plaintiff's claim for patent infringement.

*Lanham Act*

A false advertising claim under 15 U.S.C. § 1125(a)(1)(B) requires that the plaintiff establish:

(1) the defendant made a false or misleading description of fact or representation of fact in a commercial advertisement about his own or another's product; (2) the misrepresentation is material, in that it is likely to influence the purchasing decision; (3) the misrepresentation actually deceives or has the tendency to deceive a substantial segment of its audience; (4) the defendant placed the false or misleading statement in interstate commerce; and (5) the plaintiff has been or is likely to be injured as a result of the misrepresentation, either by direct diversion of sales or by a lessening of goodwill associated with its products.

*Scotts Co. v. United Indus. Corp.*, 315 F.3d 264, 272 (2002). As the quotation makes evident, this particular section of the Lanham Act prohibits false advertising in connection with the name, description, or origin of "goods or services," see 15 U.S.C.A. § 1125 (a)(1) (West 1998), but in this case, there is no allegation of a false designation of the origin of a good or service. Instead, plaintiff alleges that the website for the exhibition stated that "the idea for the hybrid court 'began with an idea by Pablo Del Campo, president of Del Campo Saatchi & Saatchi.'"

Ideas are not goods or services. It would be one thing to say that the tennis court used for the exhibition match was constructed by one party if it was, in fact, constructed by another party. The Lanham Act could extend to attach civil liability to such a misstatement if it was likely to confuse consumers in deciding whether to commercially use the tennis court and would be material to the decision to use the court. But it is another thing to say that the "idea" for the court "originated" with one party or another. Patents do not cover ideas - they protect ideas that have been translated to inventions. Trademarks do not protect ideas - they protect ideas that have solidified into marks associated with goods or services. In this

case, plaintiff's Lanham Act claim is built on the alleged misstatement that another party originated the "idea" for the hybrid tennis court. Even if a misstatement, this is not actionable under the Lanham Act.

Accordingly, the court grants IMG's motion to dismiss plaintiff's Lanham Act claim for false advertising.

*Unfair Trade Practices & Civil Conspiracy*

Plaintiff's remaining causes of action are state-law claims, and these claims rely on the predicate of IMG having undertaken a scheme to infringe plaintiff's intellectual property rights and violate the Lanham Act. This court has determined, however, that plaintiff's complaint does not allege facts which, if proved, constitute violations of these laws. For that reason, plaintiff's remaining causes of action necessarily fail as well.

**CONCLUSION**

For the foregoing reasons, the court grants the defendants' motions to dismiss.

IT IS SO ORDERED.

December 29, 2008  
Columbia, South Carolina



Joseph F. Anderson, Jr.  
United States District Judge