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Eleventh Circuit Reviews Trademark Suit, Finding Cease-and-Desist Letters Directed at Forum State Establish Personal Jurisdiction

By Catherine Nyarady and Crystal Parker
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The United States Court of Appeals for the Eleventh Circuit recently held that a cease-and-desist letter can establish personal jurisdiction. *Frida Kahlo Corp. v. Pinedo*, 172 F.4th 1316, 1319 (11th Cir. 2026). The Eleventh Circuit reversed the district court's dismissal, finding that cease-and-desist letters sent to Floridian licensees that went beyond merely informing others of the sender's intellectual property rights are sufficient to establish the minimum contacts necessary to exercise personal jurisdiction over nonresident defendants.

Personal Jurisdiction

Courts follow a two-step inquiry to determine whether they have personal jurisdiction over a nonresident defendant: "First, the court must determine whether the exercise of jurisdiction is appropriate under [the forum state's] long-arm statute. Second, the court must determine whether personal jurisdiction over the defendant violates the Due Process Clause of the Fourteenth Amendment to the U.S. Constitution." *Frida Kahlo Corp. v. Pinedo,* 2023 WL 9473827, at *4 (S.D. Fla. Dec. 28, 2023), rev'd and remanded, 172 F.4th 1316 (11th Cir. 2026).

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When analyzing whether the exercise of personal jurisdiction is constitutional, courts consider three factors: "(1) whether the plaintiff's claims 'arise out of or relate to' at least one of the defendant's contacts with the forum; (2) whether the nonresident defendant 'purposefully availed' himself of the privilege of conducting activities within the forum state, thus invoking the benefit of the forum state's laws; and (3) whether the exercise of personal jurisdiction comports with 'traditional notions of fair play and substantial justice.'" *Frida Kahlo Corp.*, 172 F.4th at 1323 (quoting *Louis Vuitton Malletier, S.A. v. Mosseri,* 736 F.3d 1339, 1355 (11th Cir. 2013)).

Case Background and the District Court's Decision

Magdalena Carmen Frida Kahlo y Calderon (Frida Kahlo) was a world-famous Mexican artist. *Frida*

Kahlo Corp., 2023 WL 9473827, at *1. Defendant Mara Teresa Cristina Romeo Pinedo (Pinedo) is Frida Kahlo's grandniece, a citizen and resident of Mexico, and owner of Defendant Familia Kahlo, S.A. de C.V. (Familia Kahlo), a Mexican corporation. Pinedo (and Isolda Pinedo Kahlo, Frida Kahlo's niece) inherited certain intellectual property rights from Frida Kahlo upon her passing. Pinedo travels throughout the United States to promote Frida Kahlo and attends Frida Kahlo-related exhibits.

Plaintiff Frida Kahlo Corporation (FKC) is a Panamanian corporation with its principal place of business in Florida. FKC is also the owner of several Frida Kahlo-related trademarks. Plaintiff Frida Kahlo Investments, S.A. is also a Panamanian corporation with an office in Florida formed to manage FKC's trademarks. In 2005, Isolda Pinedo Kahlo along with defendants Pinedo and Familia Kahlo assigned FKC the rights to the Frida Kahlo name, likeness, brand, and marks.

However, disputes arose between the parties regarding plaintiffs' ownership of the assigned intellectual property, resulting in litigation in Panama and Spain. In addition, defendants sent cease-and-desist letters to plaintiffs' licensees in the United States. This included two letters sent to licensees in Florida. Defendants' cease-and-desist letters identified Familia Kahlo as Pinedo's representative in her capacity as Frida Kahlo's heiress. *Frida Kahlo Corp.*, 172 F.4th at 1320.

The letters informed the licensees of the ongoing litigation in Panama and Spain, requested that licensees "refrain from participating, directly or indirectly, in any business initiative that involves the use of the name or image of the painter Frida Kahlo," and stated "we will hold you jointly and severally liable for any damages." However, the letters did not identify any trademark or copyright registrations or otherwise identify defendants' intellectual property rights.

In 2022, plaintiffs brought suit for copyright infringement, tortious interference with advantageous business relationships, and declaratory relief regarding trademark rights. *Frida Kahlo Corp*., 2023 WL 9473827, at *2. The district court dismissed the action for lack of personal jurisdiction. In particular, the district court held that the exercise of personal jurisdiction over defendants did not comply with the Due Process Clause of the Fourteenth Amendment because defendants did not purposefully avail themselves of the benefits and protections of Florida law, and the two cease-and-desist letters were insufficient to establish minimum contacts with Florida.

The Eleventh Circuit's Opinion

Plaintiffs appealed the dismissal, and the Eleventh Circuit reversed. Frida Kahlo Corp., 172 F.4th at 1319. Under its due process analysis, the district court considered only the second prong (purposeful availment) and determined that prong barred the exercise of personal jurisdiction. The Eleventh Circuit, which considered all three prongs of the analysis, disagreed.

Whether plaintiffs' claims "arise out of or relate to" defendants' contacts with Florida. Regarding the first prong, which evaluates the relationship among the defendant, the forum, and the litigation, the Eleventh Circuit concluded that this prong was satisfied. In particular, it found that defendants sent cease-and-desist letters into Florida that made allegedly false assertions of trademark ownership. The Circuit explained that defendants "directed their conduct into Florida," and that "very same conduct" was the basis for plaintiffs' claims.

Whether defendants "purposefully availed" themselves of the privilege of conducting activities in Florida. The Eleventh Circuit also found the second prong satisfied. When a case involves an intentional tort, the second prong can be satisfied by either the effects test or the traditional minimum contacts test.

While the district court found the minimum contacts test was not satisfied, the Eleventh Circuit concluded that there was purposeful availment under the effects

test. The effects test "requires a showing that the defendant (1) committed an intentional tort (2) that was directly aimed at the forum, (3) causing an injury within the forum that the defendant should have reasonably anticipated." (Quoting *Moore v. Cecil,* 109 F.4th 1352, 1362 (11th Cir. 2024)).

The Circuit found that because defendants allegedly committed an intentional tort directed at Florida (e.g., sending multiple cease-and-desist letters there) and should have reasonably anticipated plaintiffs' injury, the effects test was satisfied.

While satisfying the effects test is enough to meet the second prong of due process, the Eleventh Circuit further concluded that the minimum contacts test was also met. "The minimum contacts test assesses the nonresident defendant's contacts with the forum state and asks whether those contacts (1) are related to the plaintiff's cause of action; (2) involve some act by which the defendant purposefully availed himself of the privileges of doing business within the forum; and (3) are such that the defendant should reasonably anticipate being haled into court in the forum." (Quoting *Del Valle v. Trivago GMBH*, 56 F.4th 1265, 1276 (11th Cir. 2022)).

In connection with the second factor, defendants argued that their cease-and-desist letters were merely "informative" and, without more, such letters are not sufficient to establish purposeful availment. (Relying on *Red Wing Shoe Co. v. Hockerson-Halberstadt, Inc.*, 148 F.3d 1355, 1361 (Fed. Cir. 1998)).

Most notably, the Eleventh Circuit observed a shift in authority in relation to Red Wing: "in the context of patent litigation, communications threatening suit or proposing settlement or patent licenses can be sufficient to establish personal jurisdiction." (Quoting *Trimble Inc. v. PerDiemCo LLC,* 997 F.3d 1147, 1155 (Fed. Cir. 2021)). Defendants' cease-and-desist letters were not simply "informative."

Thus, the court found that defendants' allegedly tortious cease-and-desist letters regarding trademark rights "are enough to constitute purposeful availment, at least where the cause of action directly arises from the contacts with the forum."

Whether the exercise of personal jurisdiction comports with "traditional notions of fair play and substantial justice." The last prong considers "(1) the burden on the defendant; (2) the forum's interest in adjudicating the dispute; (3) the plaintiff's interest in obtaining convenient and effective relief; and (4) the judicial system's interest in resolving the dispute." (Quoting *Louis Vuitton*, 736 F.3d at 1358). The Eleventh Circuit found all factors weighed in favor of exercising personal jurisdiction.

While defendants attempted to emphasize Florida's lack of interest or connection to the case (e.g., plaintiffs are Panamanian nationals and Defendants are Mexican nationals), the Eleventh Circuit was not persuaded, including because the already-pending lawsuits in Spain and Panama cannot determine trademark use or validity in the United States.

Conclusion

The Eleventh Circuit recognized that cease-and-desist letters sent by nonresident defendants can be sufficient to establish personal jurisdiction. Parties considering sending such letters should be aware of the possibility of even a small number of letters being sufficient to require them to defend actions where they otherwise have limited contacts.

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