Venue Selection in Trademark Infringement Cases: Where to Obtain Preliminary Injunctive Relief

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Trademark owners have a variety of venues to choose from in deciding where to seek preliminary injunctive relief for trademark infringement. An evaluation of which venue to seek such relief should include consideration of:

- The standards applied by various US district courts in determining whether to grant or deny a preliminary injunction for trademark infringement;
- Each district court's tendencies, if any, toward granting or denying preliminary relief; and
- Each district court's historical latency period between (1) filing of the motion and hearing of the motion, and (2) hearing of the motion and decision.

Depending on the Circuit Court of Appeals in which the district court sits, varying forms of the familiar four-part preliminary injunction standard are applied in determining whether to grant or deny the motion for preliminary injunction. Trademark litigators should be familiar with each standard before seeking preliminary injunctive relief because, depending on the standard applied, the amount of evidence required to obtain injunctive relief may vary. For example, the majority of the Circuit Courts, namely the First, Third, Fourth, Sixth, Seventh, Eighth, Tenth, and Eleventh,[1] explicitly follow the familiar four-factor test in evaluating a motion for preliminary injunction in a trademark case. Specifically, a district court may grant injunctive relief if the trademark owner shows the following: (1) substantial likelihood of success on the merits; (2) irreparable injury will be suffered unless the injunction issues; (3) the threatened injury to the trademark owner outweighs whatever damage the proposed injunction may cause the alleged infringer; and (4) if issued, the injunction would not be adverse to the public interest.[2]

In the Second Circuit, the standard for obtaining a preliminary injunction in a trademark action differs somewhat: "a party . . . must demonstrate (1) the likelihood of irreparable injury in the absence of such an injunction, and (2) either (a) likelihood of success on the merits or (b) sufficiently serious questions going to the merits to make them a fair ground for litigation plus a balance of hardships tipping decidedly toward the party requesting the preliminary relief."[3] The Ninth Circuit applies a similar standard in trademark infringement cases as the Second Circuit. Specifically, a trademark owner must show: (1) "probable success on the merits and the possibility of irreparable injury;" or (2) "the existence of serious questions going to the merits and that the balance of hardships tips sharply in its favor."[4] Regardless of the standard applied, however, the focal point of any district court's analysis will almost always be likelihood of success on the merits. To show a likelihood of success on the merits, the trademark owner must be prepared to demonstrate (1) ownership of a valid trademark; (2) priority and continuity of use of the mark; (3) the alleged infringer's use of the mark or similar mark in commerce; and (4) the likelihood of consumer confusion resulting from the alleged infringer's use of the mark.[5]

In view of these varying standards, an increased success rate in certain venues might be expected, especially in those district courts applying the Second or Ninth Circuit's streamlined standard. As illustrated in Exhibit 1, a survey of district court decisions entered in the last five years[6] indicates that some district courts are far more likely than others to issue preliminary injunctions.

There does not appear to be any correlation, however, between the percentage of motions granted and the standard applied by a particular district court. Trademark litigators should nevertheless consider the past tendencies of judges in the district before seeking preliminary injunctive relief. For example, these popular district courts appear to be statistically adverse towards granting preliminary injunctive relief:

- Southern District of New York (denied 27 out of 45 cases—60 percent refusal rate);
- Northern District of California (denied 10 out of 14 cases—71 percent refusal rate);
- Eastern District of New York (denied 4 out of 6 cases—66 percent refusal rate);

Exhibit 1

U.S. District Court	Motions Granted	Motions Denied	Percentage of Motions Granted
Alaska	1	0	100%
E.D. of Arkansas	0	1	0%
C.D. of California	5	5	50%
E.D. of California	3	0	100%
N.D. of California	4	10	29%
Colorado	1	1	50%
Connecticut	0	3	0%
Delaware	0	3	0%
District of Columbia	1	1	50%
M.D. of Florida	6	3	66%
S.D. of Florida	2	2	50%
N.D. of Georgia	0	1	0%
S.D. of Georgia	1	1	50%
Idaho	1	0	100%
C.D. of Illinois	1	1	50%
N.D. of Illinois	7	4	64%
S.D. of Iowa	0	2	0%
Kansas	0	2	0%
W.D. of Kentucky	0	1	0%
Maine	0	1	0%
Maryland	1	1	50%
Massachusetts	4	3	57%
E.D. of Michigan	5	6	45%
Minnesota	5	4	55%
E.D. of Missouri	1	2	33%
W.D. of Missouri	1	0	100%
Nevada	1	0	100%
New Hampshire	0	2	0%
New Jersey	3	4	43%
New Mexico	1	0	100%
E.D. of New York	2	4	33%
N.D. of New York	3	0	100%
S.D. of New York	18	27	40%
W.D. of New York	2	0	100%
E.D. of North Carolina	0	1	0%
W.D. of North Carolina	1	0	100%
North Dakota	1	0	100%
N.D. of Ohio	2	4	33%
S.D. of Ohio	4	1	80%
W.D. Oklahoma	0	1	0%

Exhibit 1 *(continued)*

U.S. District Court	Motions Granted	Motions Denied	Percentage of Motions Granted
Oregon	3	0	100%
E.D. of Pennsylvania	3	3	50%
W.D. of Pennsylvania	1	0	100%
Puerto Rico	2	1	66%
South Carolina	0	1	0%
South Dakota	1	0	100%
M.D. of Tennessee	1	0	100%
N.D. of Texas	2	3	40%
S.D. of Texas	1	0	100%
Utah	1	4	20%
E.D. of Virginia	1	0	50%
W.D. of Virginia	2	0	100%
W.D. of Washington	3	3	50%
E.D. of Wisconsin	0	2	0%
W.D. of Wisconsin	1	1	50%

- Northern District of Ohio (denied 4 out of 6 cases—66 percent refusal rate); and
- Utah (denied 4 out of 5—80 percent refusal rate).

Of course, the percentage of preliminary injunction motions granted by a particular district court will not be an accurate predictor as to the likelihood of success of any future motions. This is because of a number of factors including, but not limited to: (1) differing facts for each case, and (2) a different judge and different counsel in each case.

In addition to a particular district court's disposition towards granting or denying preliminary relief, counsel should be cognizant of the historical latency period between: (1) filing of the motion and hearing of the motion, and (2) hearing of the motion and decision on the motions by the court. As summarized in Exhibit 2, some district courts take, on average, substantially more time than others to get to a hearing and rule on these motions.[7]

Absent an injunction, a trademark owner seeking preliminary injunctive relief will most likely suffer irreparable harm. It logically follows that the longer it takes for the district court to hear and rule on the motion, the more harm the trademark owner will presumably suffer. Thus, getting to a hearing and receiving a decision as soon as possible is critical for some trademark owners. The average latency between filing a motion and receiving a decision from particular district courts is illustrated in Exhibit 3.

Thus, historically, the most expeditious courts for preliminary injunction motions appear to be:

- New Hampshire (9 days);
- Eastern District of Wisconsin (11 days); and
- District of Columbia (11 days).

In contrast, a trademark owner might be able to get to trial in some districts before obtaining a ruling on a preliminary injunction motion. For example, the slowest courts for such motions appear to be:

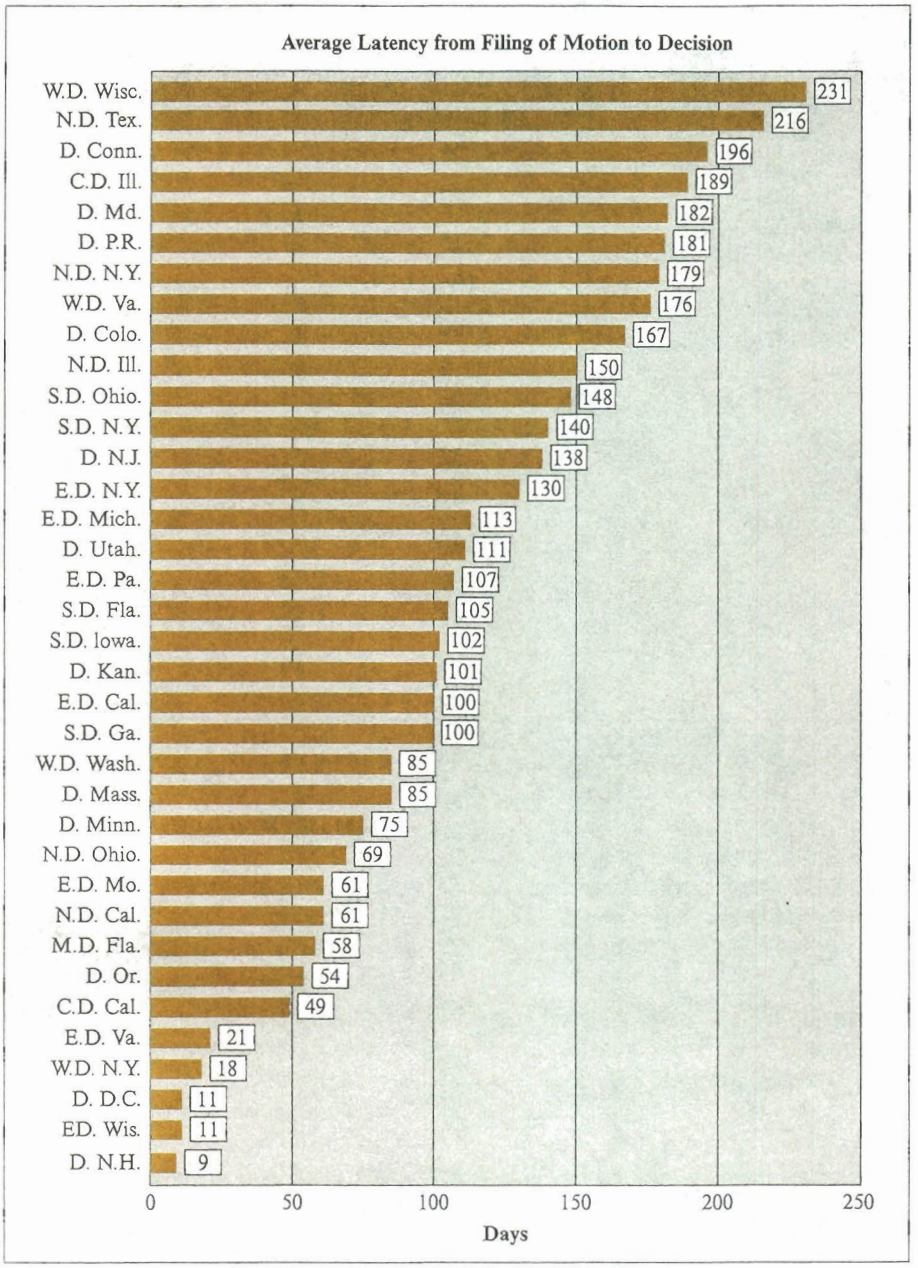
- Western District of Wisconsin (231 days);
- Northern District of Texas (216 days); and
- Connecticut (196 days).

In sum, there are many variables that trademark litigators and their clients should consider before selecting a venue in a trademark infringement case—this is especially true when the trademark owner plans to seek preliminary injunctive relief. How fast will a trademark owner get to a preliminary injunction hearing and how long will it take the Court to rule on the motion? It will depend on where you file. Rulings within one to two months are possible. What are your odds of obtaining preliminary relief? As noted, the likelihood of prevailing will depend on a number of factors. Of the cases filed within the past five years, however, only about 48 percent of the motions for preliminary injunctions were granted. Moreover, it appears some courts rarely, if ever, grant motions for preliminary injunctions. However, consideration of each district court's tendencies, if any, toward granting or denying preliminary relief and each district court's average number of days from filing to decision may help in obtaining efficient and speedy relief.

Exhibit 2

U.S. District Court	Avg. No. Days from Filing to Hearing	Avg. No. Days from Hearing to Decision
C.D. of California	27	22
E.D. California	57	43
N.D. of California	35	26
Colorado	106	61
Connecticut	90	106
District of Columbia	7	4
M.D. of Florida	57	58
S.D. of Florida	32	64
S.D. of Georgia	43	57
C.D. of Illinois	146	43
N.D. of Illinois	52	99
S.D. of Iowa	83	19
Kansas	78	23
Maryland	27	211
Massachusetts	48	37
E.D. of Michigan	50	63
Minnesota	36	39
E.D. of Missouri	37	24
New Hampshire	12	2
New Jersey	94	44
E.D. of New York	67	63
N.D. of New York	20	159
S.D. of New York	61	70
W.D. of New York	13	5
N.D. of Ohio	47	32
S.D. of Ohio	44	104
Oregon	34	20
E.D. of Pennsylvania	46	61
Puerto Rico	94	87
N.D. of Texas	307	18
Utah	44	87
W.D. of Virginia	106	70
W.D. of Washington	52	33
E.D. of Wisconsin	5	6
W.D. of Wisconsin	134	77

Exhibit 3



Notes

1. The Federal Circuit defers to the law of the regional circuit when addressing substantive legal issues over which it does not have exclusive subject matter jurisdiction, such as preliminary injunction standards. Nitro Leisure Products, L.L.C. v. Acushnet Co., 341 F.3d 1356, 1359 (Fed. Cir. 2003).
2. *See, e.g.*, I.P.Lund Trading ApS v. Kohler Co., 163 F.3d 27, 33 (1st Cir. 1998); Kos Pharmaceuticals, Inc. v. Andrx Corp., 369 F.3d 700, 708 (3d Cir. 2004); MicroStrategy Inc. v. Motorola, Inc., 245 F.3d 335, 339 (4th Cir. 2001); Sugar Busters LLC v. Brennan, 177 F.3d 258, 265 (5th Cir. 1999); Lorillard Tobacco Co. v. Amouri's Grand Foods, Inc., 453 F.3d 377, 380 (6th Cir. 2006); Mil-Mar Shoe Co., Inc. v. Shonac Corp., 75 F.3d 1153, 1156 (7th Cir. 1996); Hubbard Feeds, Inc. v. Animal Feed Supplement, Inc., 182 F.3d 598, 601 (8th Cir. 1999); Hartford House, Ltd. v. Hallmark Cards, Inc., 846 F.2d 1268, 1270 (10th Cir. 1988); McDonald's Corp. v. Robertson, 147 F.3d 1301, 1306 (11th Cir. 1998).
3. 1-800 Contacts, Inc. v. WhenU.com, Inc., 414 F.3d 400, 408 (2d. Cir. 2005).
4. GoTo.com, Inc. v. Walt Disney Co., 202 F.3d 1199, 1204–1205 (9th Cir. 2000) (citation and internal quotation marks omitted); *see* Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d. 1036, 1046 (9th Cir. 1999).
5. E.g., Brookfield at 1046.
6. Our research identified a total of 228 district court opinions granting or denying preliminary injunction motions in trademark infringement cases, which were published from February 16, 2002 through February 16, 2007. District court opinions pertaining solely to trade dress infringement, trademark dilution, and cybersquatting were excluded from our research.
7. Latency periods were calculated for only district courts reporting two or more preliminary injunction motions for trademark infringement filed within the past five years. The average number of days from filing to hearing (when a hearing was granted), from hearing to decision, and from filing to decision were calculated based on docket information obtained from the PACER system (*i.e.*, Public Access to Court Electronic Records), which can be found at *http://pacer.ilnd.uscourts.gov/*. Because not all cases were granted a hearing, the total time from filing to decision does not necessarily equal the sum of time from filing to hearing and hearing to decision. Note further that docket information was not available for all cases in all districts.