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This Issue: Injunctive Relief

Injunctive Relief in Patent Infringement Cases after *eBay*

By Michael Stolarski and Uma Bansal

Prior to the Supreme Court's decision in *eBay v. MercExchange*, permanent injunctive relief automatically would be granted upon a finding that a patent-in-suit was infringed and not invalid. But the Supreme Court's decision in *eBay* redefines the standard for granting permanent injunctions in patent cases into the four-factor test typically applied at equity.¹ The Supreme Court held that before granting a preliminary or permanent injunction against the infringing activity, a court must find that (1) the

patent holder will suffer irreparable harm in the absence of an injunction on the infringing activity, (2) monetary damages will not adequately remedy the infringement, (3) the balance of hardships favors the patent holder; and (4) the public interest would be served by the injunction. The various patent decisions by the federal circuit and district courts resulting from the Supreme Court's decision in *eBay* offer some insight as to the factors that

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Halting IP Infringement in the UK, Hong Kong, and Germany

By Rebecca Halford-Harrison, Wing Cheung, and Nicolaus Ullrich

What are the options in the United Kingdom, Hong Kong, and Germany for obtaining relief comparable to a United States temporary restraining order or preliminary injunction? There is a significant commercial balance between speed and cost of obtaining injunctive relief in intellectual property (IP) cases no matter where they take place. In some instances, a two-year timeline may be fine for ambling along to a trial and a further year or two to an appeal.

However, increasingly, faster solutions to protect or enforce IP are sought and are the only option to make protection or enforcement of IP commercially worthwhile.

United Kingdom

In the United Kingdom, there are now a variety of ways to obtain a speedy, prohibitory injunction in IP disputes. Not all options fit all cases; some, such as the streamlined procedure, are only available

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Venue Selection for Infringement Cases: Where to Obtain Preliminary Injunctive Relief

By Jason S. Shull and Wendell W. Harris

Trademark owners have a variety of venues from which to choose in deciding where to seek preliminary injunctive relief for trademark infringement. An evaluation of the various available venues should include consideration of the standards applied by various U.S. 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) the filing and the hearing of the motion and (2) the hearing of the motion and the delivery of a 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 a motion for preliminary injunctive relief. Trademark litigators should be familiar with each standard before seeking preliminary injunctive relief because 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 Eleventh¹—explicitly follow the familiar four-factor test in evaluating a motion for preliminary injunctive relief in a trademark case. Specifically, injunctive relief is granted if the applicant can show (1) a substantial likelihood of success at trial on the merits, (2) irreparable injury unless the injunction issues, (3) the threatened injury outweighs the harm the alleged infringer will suffer as a result of the proposed injunction, 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. There, “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)

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	1	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. of Oklahoma	0	1	0%
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%

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, the initial focal point of any district court’s analysis will likely be the 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, one might expect an increased success rate in certain venues, especially in those district courts applying the Second or Ninth Circuit’s streamlined standard. As illustrated herein, a survey of district court decisions entered in the last five years⁶ indicates that some district courts are far more likely than others to issue preliminary injunctions.

There does not appear to be any correlation 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 a particular district before seeking preliminary injunctive relief. For example, the following popular district courts appear to be statistically adverse toward 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);
- Northern District of Ohio (denied 4 out of 6 cases; 66 percent refusal rate); and

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

- Utah (denied 4 out of 5; 80 percent refusal rate).

Of course, the percentage of preliminary injunction motions granted by a particular district court is not necessarily an accurate predictor of the likelihood of success in future motions. This is due to a number of factors including, but not limited to differing facts for each case and 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 the filing and the hearing of the motion, and the hearing of the motion and the delivery of a decision by the court. As summarized herein, some district courts take, on average, substantially more time than others to hear a motion and deliver a decision.⁷

In the absence of an interim injunction, a trademark owner seeking relief will most likely suffer irreparable harm. It logically follows that the longer it takes for

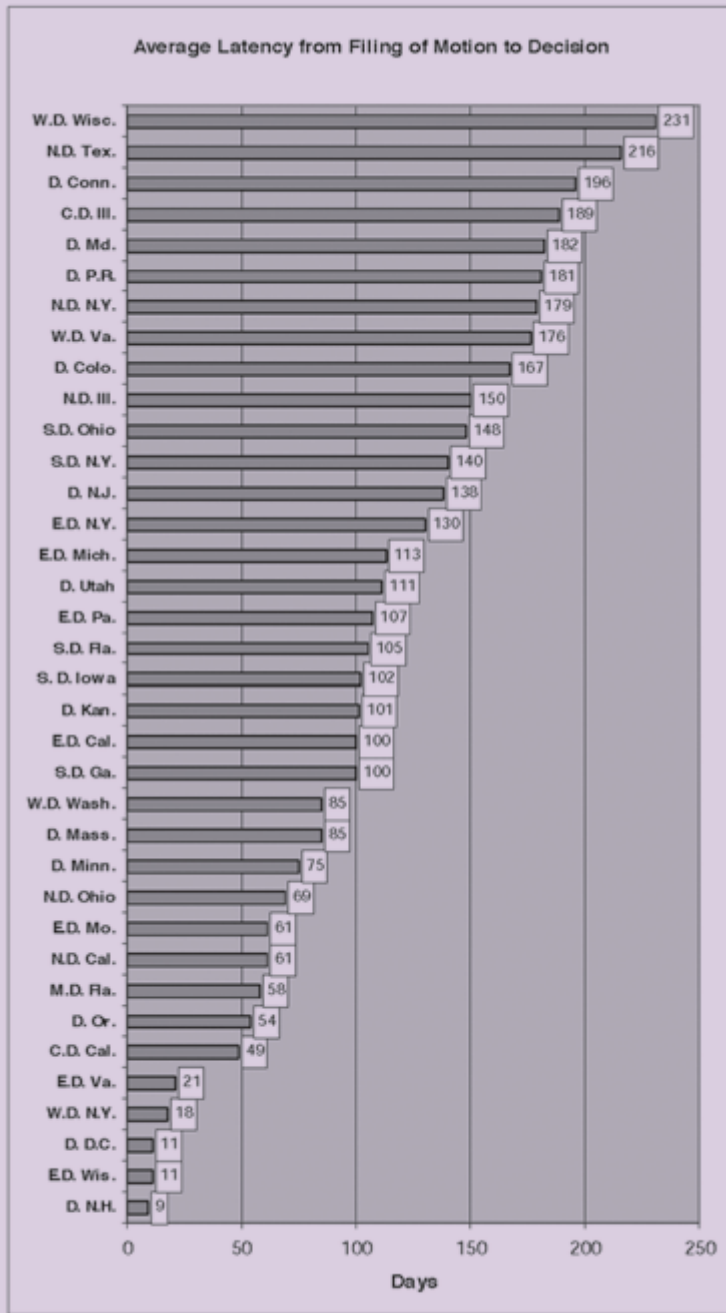
the district court to hear and rule on the motion, the more harm the trademark owner will presumably suffer. Thus, getting to a hearing and receiving a decision as soon as possible is critical for some trademark owners. The average latency between filing a motion and receiving a decision from particular district courts is illustrated above.

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

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

By contrast, some trademark owners have got 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).

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. Foremost considerations should be how quickly the motion can be heard and how long it will take to get a ruling. Rulings within one to two months are possible, but it depends on where the motion is filed. Equally important

is the likelihood of prevailing. Of the cases filed within the past five years, however, only about 48 percent of the motions for preliminary injunctions were granted. Some courts rarely, if ever, grant motions for preliminary injunctions. Considering each district court's tendencies, if any, toward hearing, deciding, and granting preliminary injunctive relief may assist in efficiently obtaining the sought-after result.●

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Endnotes

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 (3rd 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, 1204-05 (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 See, e.g., *Brookfield*, 174 F.3d. 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 only for 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 (Public Access to Court Electronic Records) system, 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.