

HOW TO SECURE INJUNCTIVE RELIEF IN PATENT CASES

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David's passion to compete and win has translated well into his legal pursuits. With more than fifteen years of law practice under his belt, David enjoys litigating complex cases across multiple fields, including intellectual property, business, oil and gas, sports and entertainment, and consumer-related matters.

David's courtroom experience, which includes numerous first-chair engagements, includes successful trials in both federal and state court, in Texas and outside of Texas. Since 2007, he has focused the vast majority of his time and efforts representing plaintiffs in high-stakes patent litigation. He was elected by his fellow IP lawyers to serve as Chair of the Tarrant County Bar Association's Intellectual Property Section from 2009 to 2010.

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TABLE OF CONTENTS

INTRODUCTION	1
I. CONSTITUTIONAL AND STATUTORY BASES FOR INJUNCTIVE RELIEF IN PATENT CASES	2
II. TESTS APPLICABLE TO PERMANENT AND PRELIMINARY INJUNCTIVE RELIEF.....	2
A. Permanent Injunctions.....	2
1. Irreparable Harm.....	2
2. No Adequate Remedy at Law.....	3
3. Balance of Hardships.....	4
4. The Public Interest.....	4
B. Preliminary Injunctions	4
1. Likelihood of Success on the Merits	4
2. Irreparable Harm.....	5
3. Balance of Hardships.....	5
4. The Public Interest.....	5
5. Bond Required.....	5
C. Temporary Restraining Orders.....	5
III. PROCEDURAL CONSIDERATIONS AFTER A GRANT OR DENIAL OF A REQUEST FOR INJUNCTIVE RELIEF	6
A. Contempt Proceedings.....	6
B. Appeals.....	6
1. Appealing the Denial of a Request for Permanent Injunctive Relief.....	6
2. Appealing the Denial of a Request for Preliminary Injunctive Relief.....	6
IV. CONCLUSION	7

HOW TO SECURE INJUNCTIVE RELIEF IN PATENT CASES

INTRODUCTION

Over the past dozen or so years, the federal courts have clarified the standards for patentees seeking permanent or preliminary injunctive relief. In 2006, the United States Supreme Court rejected any presumption of irreparable harm for prevailing patentees and unanimously declared that “a federal court considering whether to award **permanent** injunctive relief to a prevailing plaintiff” must apply “the four-factor test historically employed by courts of equity” and that “this traditional test applies to disputes arising under the Patent Act.” *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 390 (2006) (bold added). “According to well-established principles of equity, a plaintiff seeking a permanent injunction ... must demonstrate: (1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction.” *Id.* at 391. In 2008, the Supreme Court clarified that “plaintiffs seeking **preliminary** relief [must] demonstrate that irreparable injury is *likely* in the absence of an injunction.” *Winter v. NRDC, Inc.*, 555 U.S. 7, 21-22 (2008) (bold added) (*italics in original*) (rejecting Ninth Circuit’s “lenient” standard, which “held that when a plaintiff demonstrates a strong likelihood of prevailing on the merits, a preliminary injunction may be entered based only on a ‘possibility’ of irreparable harm”).

In 2011, the Federal Circuit Court of Appeals confirmed that *eBay* had eliminated any presumption of irreparable harm but emphasized that *eBay* did not “swing the pendulum in the opposite direction.” *Robert Bosch LLC v. Pylon Mfg. Corp.*, 659 F.3d 1142, 1149, 1156 (Fed. Cir. 2011) (reversing district court’s denial of a permanent injunction, admonishing courts not to “ignore the fundamental nature of patents as property rights granting the owner the right to exclude,” and explaining that “the nature of patent rights has [a] place in the appropriate equitable analysis”), citing U.S. CONST. art. I, § 8, cl. 8. From 2012 through 2015, the Federal Circuit helped referee the so-called Smartphone Wars – particularly the battles between Apple and Samsung – and, in so doing, helped define the contours of the equitable analysis.¹

Collectively, the federal courts have provided concrete guidance on the standards that govern injunctions in patent cases, while emphasizing that the analysis is necessarily flexible and must be performed on a fact-specific, case-by-case basis. This article sets forth the basic legal principles and framework for a patentee seeking injunctive relief in a federal district court proceeding. Part I provides the constitutional and statutory bases for injunctive relief. Part II describes in more detail the four-factor tests applicable to requests for permanent or preliminary injunctive relief, including temporary restraining orders. And Part III briefly addresses some of the procedural issues that may arise after a district court grants or denies a request for injunctive relief.²

¹ The Smartphone Wars involved litigation in at least ten countries and cost the parties hundreds of millions of dollars in legal fees. The U.S. proceedings between Apple and Samsung spawned four detailed opinions from the Federal Circuit, which are typically referred to as *Apple I*, *Apple II*, *Apple III*, and *Apple IV*. See *Apple, Inc. v. Samsung Elecs. Co. (Apple I)*, 678 F.3d 1314, 1324 (Fed. Cir. 2012) (reviewing motion for preliminary injunction); *Apple, Inc. v. Samsung Elecs. Co. (Apple II)*, 695 F.3d 1370, 1374-76 (Fed. Cir. 2012) (same); *Apple, Inc. v. Samsung Elecs. Co. (Apple III)* (addressing causal nexus in context of permanent injunction), 735 F.3d 1352, 1369-70 (Fed. Cir. 2013); and *Apple, Inc. v. Samsung Elecs. Co. (Apple IV)*, 809 F.3d 633, 641-42 (Fed. Cir. 2015) (same). Apple and Samsung finally declared a truce in June 2018, when they reached a settlement to resolve all pending litigation between them.

² The availability of injunctive relief in other types of IP cases is outside the scope of this article. On the other hand, a central tenet of this article is that the Supreme Court in *eBay* and *Winter* reaffirmed the “historic” or “traditional” four-factor tests for injunctive relief and declared that the equitable analysis should not change from case to case or from subject matter to subject matter. Regardless, it is always instructive to observe how the federal courts apply those tests to the fact-specific scenarios that arise in other types of IP cases and under other statutory schemes. See, e.g., *Disney Enters. v. VidAngel, Inc.*, 869 F.3d 848 (9th Cir. 2017) (affirming district court’s injunction against VidAngel for copyright infringement, 17 U.S.C. § 106, and for “circumvention of access control measures” under the Digital Millennium Copyright Act (“DMCA”), 17 U.S.C. § 1201(a); regarding the statutory grounds supporting such relief, the Federal Circuit referenced 17 U.S.C. § 502 but did not reference the additional authority codified at 17 U.S.C. § 1203(b)); *ADT, LLC v. Capital Connect, Inc.*, 145 F. Supp. 3d 671, 685-702 (N.D. Tex. 2015) (granting preliminary injunction in trademark infringement case under Section 43 of the Lanham Act, 17 U.S.C. § 1125(a)); *Wealth Mgmt. Assocs. LLC v. Farrad*, 2019 U.S. Dist. LEXIS 105381, at *12-18 (S.D.N.Y. June 21, 2019) (analyzing request for injunctive relief under the federal Defend Trade Secrets Act (“DTSA”), 18 U.S.C. § 1836(b)(3)(A), and “recommend[ing] that the Court issue a permanent injunction”); see also John M. Cone, *Permanent Injunctions in Trademark Infringement Actions After eBay* and Herbert J. Hammond, *Texas Uniform Trade Secrets Act* (at pages 10-12), which were presented at the State Bar of Texas 27th Annual Advanced IP Law Course, March 20-21, 2014, available at <http://www.texasbarcle.com/CLE/OLHome.asp> (may require subscription).

I. CONSTITUTIONAL AND STATUTORY BASES FOR INJUNCTIVE RELIEF IN PATENT CASES

The United States Constitution provides the foundational basis for inventors to exclude others from practicing their patented inventions: “The Congress shall have Power ... To promote the Progress of Science and useful Arts, by *securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.*” U.S. CONST. art. I, § 8, Cl. 8 (emphasis added). Based on that authority, Congress passed The Patent Act of 1819, which granted federal courts “[u]pon any bill in equity[, the] ... authority to grant injunctions, according to the course and principles of courts of equity ... on such terms and conditions as the said courts may deem fit and reasonable.” Act of Feb. 15, 1819, ch. 19, 3 Stat. 481, 481-82 (1819).

Today, a patentee’s statutory basis for injunctive relief is codified at 35 U.S.C. § 283: “The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.” One of the rights secured by a patent is the right to exclude others: “Every patent shall contain ... a grant to the patentee ... of the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States, and, if the invention is a process, of the right to exclude others from using, offering for sale or selling throughout the United States, or importing into the United States, products made by that process” 35 U.S.C. § 154(a)(1); *see also id.* § 261 (“Subject to the provisions of this title, patents shall have the attributes of personal property.”).

The content and scope of injunctions and restraining orders are governed by Federal Rule of Civil Procedure 65(d)(1), which states: “Every order granting an injunction and every restraining order must: (A) state the reasons why it issued; (B) state its terms specifically; and (C) describe in reasonable detail—and not by referring to the complaint or other document—the act or acts restrained or required.” Fed. R. Civ. P. 65(d)(1); *see also Int’l Rectifier Corp. v. IXYS Corp.*, 383 F.3d 1312, 1316 (Fed. Cir. 2004) (explaining that order granting injunctive relief must include “specific terms and a reasonably detailed description of the acts ... to be restrained” and admonishing drafters “to state which acts constituted infringement or to expressly limit [the order’s] prohibition to the manufacture, use, or sale of the specific device found to infringe, or devices no more than colorably different from the infringing device”).

II. TESTS APPLICABLE TO PERMANENT AND PRELIMINARY INJUNCTIVE RELIEF

In the wake of *eBay*, federal courts have created a well-developed body of law applying the “traditional” four-factor test to patentees’ requests for injunctive relief.

A. Permanent Injunctions

Prior to *eBay*, the Federal Circuit had suggested that the traditional equitable analysis applicable in other types of cases should yield to a presumption that a permanent injunction should issue to a prevailing patentee absent extraordinary circumstances. *See, e.g., Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1246-47 (Fed. Cir. 1989). In *eBay*, a unanimous Supreme Court rejected this presumption and rejected the notion that patent cases are somehow special: “According to well-established principles of equity, a plaintiff seeking a permanent injunction must satisfy a four-factor test before a court may grant such relief. A plaintiff must demonstrate: (1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction.” *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391 (2006); *see also TEK Glob., S.R.L. v. Sealant Sys. Int’l*, 920 F.3d 777, 791 (Fed. Cir. 2019), quoting *eBay*.

The *eBay* Court continued: “These familiar principles apply with equal force to disputes arising under the Patent Act. As this Court has long recognized, a major departure from the long tradition of equity practice should not be lightly implied. Nothing in the Patent Act indicates that Congress intended such a departure. To the contrary, the Patent Act expressly provides that injunctions ‘may’ issue ‘in accordance with the principles of equity.’” *Id.* at 391-92, quoting 35 U.S.C. § 283. Each of these four “familiar” factors is addressed below.

1. Irreparable Harm

To establish irreparable harm, a patentee must show harm caused by the infringer’s actions, as well as a “causal nexus” between the infringement and his injury. “To establish causal nexus, the patentee must show that ‘the infringing feature drives consumer demand for the accused product’—in other words, that consumers bought the accused product because it was equipped with an apparatus claimed in the [asserted] patent.” *TEK Glob.*, 920 F.3d at 792, quoting *Apple Inc. v. Samsung Elecs. Co. (Apple II)*, 695 F.3d 1370, 1375-76 (Fed. Cir. 2012). “When a patentee alleges it suffered irreparable harm stemming from lost sales solely due to a competitor’s infringement, a finding that the competitor’s infringing features drive consumer demand for its products satisfies the causal nexus inquiry.” *Apple Inc. v. Samsung*

Elecs. Co. (Apple IV), 809 F.3d 633, 641 (Fed. Cir. 2015). “[T]he causal nexus requirement” is subject to “a flexible analysis, as befits the discretionary nature of the four-factor test for injunctive relief.” *Id.*

The patentee need not “prove that the infringement was the sole cause of the lost downstream sales.” *Id.* Rather, “proving a causal nexus requires the patentee to show ‘some connection’ between the patented features and the demand for the infringing products.” *Id.*, quoting *Apple III*, 735 F.3d at 1364. A patentee may “show some connection [in] a variety of ways . . . , for example, with evidence that a patented feature is one of several features that cause consumers to make their purchasing decisions[,] with evidence that the inclusion of a patented feature makes a product significantly more desirable[, or] with evidence that the absence of a patented feature would make a product significantly less desirable.” *Apple III*, 735 F.3d at 1364. Further, in cases involving multiple patents, the patentee is not required to show causal nexus for each patent, on a patent-by-patent basis, if those patents all relate to the same technology. *Id.* at 1364-65.

More recently, the Federal Circuit summarized the “causal nexus” standard developed in *Apple I through Apple IV*: “The clarified standards set forth in *Apple III* and *Apple IV* govern the causal-nexus inquiry, at least in a multi-purchaser, multi-component situation in which only a component of a larger product or system is covered by the patent in suit. The formulations in those decisions avoid a too-demanding causal-nexus requirement that might be attributed to the ‘drive demand’ language. The standard prescribed by *Apple III* and *Apple IV*, as appropriate to the multi-purchaser, multi-component context, lies between the unduly stringent ‘sole reason’ standard . . . rejected in *Apple III* and *Apple IV* and the unduly lax ‘insubstantial connection’ standard . . . rejected in *Apple II*. The standards seek to reflect ‘general tort principles of causation, *Apple III*, 735 F.3d at 1361, and to make proof of causal nexus practical ‘from an evidentiary standpoint,’ *Apple IV*, 809 F.3d at 641, in a multi-purchaser, multi-component setting.” *Genband US LLC v. Metaswitch Networks Corp.*, 861 F.3d 1378, 1384 (Fed. Cir. 2017)

Even after *eBay*, courts tend to grant permanent injunctive relief to prevailing patentees who compete directly with the infringer or have lost market share to the infringer. “Head-to-head competition and lost market share tend to evidence irreparable harm.” *TEK Glob., S.R.L. v. Sealant Sys. Int’l*, 920 F.3d 777, 793 (Fed. Cir. 2019), citing *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1337-38 (Fed. Cir. 2013) (competition and lost market share established irreparable harm – even where patent owner did not practice the patented invention) and *Robert Bosch LLC v. Pylon Mfg. Corp.*, 659 F.3d 1142, 1151 (Fed. Cir. 2011) (concluding that district court erred in not finding irreparable harm when parties were direct competitors and patentee showed lost market share, even though infringement only affected patentee’s “non-core” business). In addition, “[p]rice erosion, loss of goodwill, damage to reputation, and loss of business opportunities are all valid grounds for finding irreparable harm.” *Indivior Inc. v. Dr. Reddy’s Labs., S.A.*, 752 F. App’x 1024, 1041 (Fed. Cir. 2018), quoting *Celsis in Vitro, Inc. v. CellzDirect, Inc.*, 664 F.3d 922, 930 (Fed. Cir. 2012); see also *Douglas Dynamics, LLC v. Buyers Prods. Co.*, 717 F.3d 1336, 1344-45 (Fed. Cir. 2013) (“Irreparable injury encompasses different types of losses that are often difficult to quantify, including lost sales and erosion in reputation,” and including patentee’s “reputation as an innovator”).

Finally, district courts may consider both past harm and future harm when evaluating the irreparable harm factor. *i4i Ltd. P’ship v. Microsoft Corp.*, 598 F.3d 831, 861-62 (Fed. Cir. 2010) (“Past harm to a patentee’s market share, revenues, and brand recognition is relevant for determining whether the patentee “has suffered an irreparable injury.”), quoting *eBay*, 547 U.S. at 391. “Although injunctions are tools for prospective relief designed to alleviate future harm, by its terms the first *eBay* factor looks, in part, at what has already occurred.” *Id.* (“district court properly considered . . . evidence that Microsoft’s infringement rendered i4i’s product obsolete . . . , causing i4i to lose market share and change its business strategy to survive”).

2. No Adequate Remedy at Law

Difficulty in estimating monetary damages is evidence that remedies at law are inadequate. *i4i*, 598 F.3d at 862. For example, when there is an inherent difficulty in quantifying “loss of market share, brand recognition, [or] customer goodwill,” that is a strong indication that that “remedies at law are inadequate.” *TEK Glob.*, 920 F.3d at 792, quoting *i4i*, 598 F.3d at 862 (such losses “frequently defy attempts at valuation, particularly when the infringing acts significantly change the relevant market”). Remedies at law may be inadequate even where the infringer’s market share is minimal. For example, in *Douglas Dynamics, LLC v. Buyers Prods. Co.*, the court highlighted “the rise in Buyers’s market share from zero to about 5% in three years while infringing Douglas’s patents. This record evidence underscores the profitability of infringement and suggests that mere damages will not compensate for a competitor’s increasing share of the market, a market which Douglas competes in, and a market that Douglas has in part created with its investment in patented technology.” 717 F.3d 1336, 1345 (Fed. Cir. 2013); see also *Windsurfing Int’l, Inc. v. AMF, Inc.*, 782 F.2d 995, 1003 (Fed. Cir. 1986) (“district court abused its discretion in refusing to enjoin” infringer simply because infringer was “such a small operation”).

3. Balance of Hardships

This factor considers the relative effect of granting or denying an injunction on the parties. *i4i Ltd. P'ship v. Microsoft Corp.*, 598 F.3d 831, 862-63 (Fed. Cir. 2010), citing *Broadcom Corp. v. Qualcomm Inc.*, 543 F.3d 683, 703-04 (Fed. Cir. 2008). Factors to consider include the parties' respective sizes, products, and revenue sources. *Id.* In *i4i*, "[t]he district court's analysis properly ignored the expenses Microsoft incurred in creating the infringing products" and properly ignored as "irrelevant ... the consequences to Microsoft of its infringement, such as the cost of redesigning the infringing products. ... [N]either commercial success, nor sunk development costs, shield an infringer from injunctive relief." *Id.* (affirming district court's grant of permanent injunction, while observing that the "patented technology is central to i4i's business" and that "Microsoft is not entitled to continue infringing simply because it successfully exploited its infringement").

As referenced above, district courts may consider both past harm and future harm when attempting to balance the hardships. "Although injunctions are tools for prospective relief designed to alleviate future harm, by [their] terms the ... *eBay* factor[s] look[], in part, at what has already occurred." *TEK Glob.*, 920 F.3d at 793, quoting *i4i*, 598 F.3d at 862. Further, a "party cannot escape an injunction simply because it is smaller than the patentee or because its primary product is an infringing one." *Robert Bosch LLC v. Pylon Mfg. Corp.*, 659 F.3d 1142, 1156 (Fed. Cir. 2011), quoting *Windsurfing Int'l, Inc. v. AMF, Inc.*, 782 F.2d 995, 1003 n.12 (Fed. Cir. 1986) ("One who elects to build a business on a product found to infringe cannot be heard to complain if an injunction against continuing infringement destroys the business so elected."). Simply forcing the patentee "to compete against its own patented invention" may be sufficient to show that the balance of hardships favors the patentee. *See id.*

4. The Public Interest

The public certainly has an interest in upholding patent rights – an interest that favors injunctive relief. *i4i*, 598 F.3d at 863, citing *Broadcom*, 543 F.3d at 704. Therefore, "the touchstone of the public interest factor is whether an injunction, both in scope and effect, strikes a workable balance between protecting the patentee's rights and protecting the public from the injunction's adverse effects." *Id.* Inconvenience to an infringer's customers or to other third parties does not necessarily mean that the public interest analysis favors the infringer; to the contrary, courts have broad discretion to craft injunctions that address such concerns – e.g., injunctions that minimize or reduce the inconvenience while protecting the patentee's (and the public's) interest in upholding patent rights. *See Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1339 (Fed. Cir. 2013) (extolling district court's "exemplary exercise of discretion" in "tailor[ing] a permanent injunction to meet unique market concerns with a well-crafted sunset period").

B. Preliminary Injunctions

At the preliminary injunction stage, before the issues of fact and law have been fully explored and finally resolved, the purpose of a preliminary injunction is to preserve the relative positions of the parties until a trial on the merits can be held. *Abbott Labs. v. Sandoz, Inc.*, 544 F.3d 1341, 1344-45 (Fed. Cir. 2008). In considering a preliminary injunction, the precedent of the Federal Circuit applies to substantive issues within the domain of patent law. *See Hybritech Inc. v. Abbott Laboratories*, 849 F.2d 1446, 1452 n.12 (Fed Cir. 1988).

Courts have discretion to grant two types of preliminary injunctive relief: preliminary injunctions (addressed here in Part II.B) and temporary restraining orders (addressed in Part II.C *infra*). The standard for both forms of relief are the same. Generally, a patentee seeking preliminary injunctive relief must establish: (1) a likelihood of success on the merits, (2) a likelihood of suffering irreparable harm in the absence of preliminary relief, (3) that the balance of equities tips in his favor, and (4) that an injunction is in the public interest. *Winter v. NRDC, Inc.*, 555 U.S. 7, 20 (2008); *Abbott Labs.*, 544 F.3d at 1344. A movant cannot be granted a preliminary injunction unless it establishes both of the first two factors, i.e., likelihood of success on the merits and irreparable harm. *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1350 (Fed. Cir. 2001).³ Part II.A *supra* addresses some of these factors. In addition, each factor is addressed briefly below.

1. Likelihood of Success on the Merits

For a patentee to establish that he is likely to succeed on the merits, he must demonstrate that he will likely prove infringement of one or more claims of the patents-in-suit, and that at least one of those same allegedly infringed claims

³ The Ninth Circuit has held that a preliminary injunction may issue under the "serious questions" test: "Alternatively, serious questions going to the merits and a hardship balance that tips sharply toward the plaintiff can support issuance of an injunction, assuming the other two elements of the *Winter* test are also met. A 'serious question' is one on which the movant has a fair chance of success on the merits." *Hand & Nail Harmony, Inc. v. ABC Nail & Spa Prods.*, 2016 U.S. Dist. LEXIS 82147, at *8-9 (C.D. Cal. June 14, 2016) (some internal quotations and citations omitted), citing *Alliance for the Wild Rockies v. Cottrell*, 632 F.3d 1127, 1132 (9th Cir. 2011) and *Sierra On-Line, Inc. v. Phoenix Software, Inc.*, 739 F.2d 1415, 1421 (9th Cir. 1984).

will also likely withstand the validity challenges presented by the accused infringer. *AstraZeneca LP v. Apotex, Inc.*, 633 F.3d 1042, 1050 (Fed. Cir. 2010), citing *Amazon.com*, 239 F.3d at 1351. A preliminary injunction should not issue if an accused infringer raises a substantial question regarding either infringement or validity, i.e., the alleged infringer asserts an infringement or invalidity defense that the patentee has not shown lacks substantial merit. *AstraZeneca*, 633 F.3d at 1050. District courts have discretion to make tentative claim construction rulings, as may be necessary to resolve infringement or validity questions. See *Int'l Commun. Material, Inc. v. Ricoh Co.*, 108 F.3d 316, 319 (Fed. Cir. 1997).

2. Irreparable Harm

Regarding irreparable harm, a patentee seeking preliminary injunctive relief cannot rely on the *possibility* of such harm. Rather, he must demonstrate that irreparable injury is *likely* in the absence of an injunction. *Winter*, 555 U.S. at 22; see also 11A C. Wright, A. Miller, & M. Kane, FEDERAL PRACTICE AND PROCEDURE § 2948.1, p. 139 (2d ed. 1995) (applicant must demonstrate that in the absence of a preliminary injunction, “the applicant is likely to suffer irreparable harm before a decision on the merits can be rendered”).

3. Balance of Hardships

In balancing the hardships, the court may consider whether the patentee “would lose the value of its patent” or “suffer ... loss of goodwill and reputation ...” *Celsis in Vitro, Inc. v. CellzDirect, Inc.*, 664 F.3d 922, 931 (Fed. Cir. 2012). And the court may consider the alleged infringer’s “interest in fulfilling its current contract obligations.” *Id.* (rejecting alleged infringer’s “claims that it would have to shut down operations upon a preliminary injunction” and opining that the infringer’s “losses were the result of its own calculated risk in selling a product with knowledge of [the] patent”).

4. The Public Interest

In considering the public interest, courts have typically “acknowledged the importance of the patent system in encouraging innovation.” *Sanofi-Synthelabo v. Apotex, Inc.*, 470 F.3d 1368, 1383-84 (Fed. Cir. 2006). Indeed, the “encouragement of investment-based risk is the fundamental purpose of the patent grant, and is based directly on the right to exclude.” *Id.* (affirming district court’s grant of preliminary injunction because the “public interest in encouraging investment in [product] development and protecting the exclusionary rights conveyed in valid ... patents tips the scales in favor of [patentee]”) (internal quotations omitted).

5. Bond Required

Finally, Federal Rule of Civil Procedure 65(c) requires that the Court order the patentee to provide security “in an amount that the court considers proper to pay the costs and damages sustained by any party found to have been wrongfully enjoined or restrained.” *Apple, Inc. v. Samsung Elecs. Co.*, 877 F. Supp. 2d 838, 918 (N.D. Cal. 2012). The amount of bond is within the court’s discretion. *Id.* The bond requirement is designed to protect the enjoined party’s interests in the event that future proceedings show the injunction issued wrongfully. *Id.*

C. Temporary Restraining Orders

As noted above, courts evaluating an application for a temporary restraining order (“TRO”) must consider the same four factors that they consider when evaluating a motion for preliminary injunction. However, before issuing an *ex parte* TRO, a court must determine whether “immediate and irreparable injury, loss, or damage will result to the movant before the adverse party can be heard in opposition.” Fed. R. Civ. P. 65(b)(1)(A). Rule 65(b) also requires that the applicant “certif[y] in writing any efforts made to give notice and the reasons why it should not be required.” Fed. R. Civ. P. 65(b)(1)(B). For example, an *ex parte* TRO may be appropriate, even without notice, when the alleged infringer’s identity is unknown. See *First Tech. Safety Sys., Inc. v. Depinet*, 11 F.3d 641, 649-51 (6th Cir. 1993) (copyright case providing detailed analysis of situations in which *ex parte* TRO may be appropriate).

As a practical matter, patent infringement plaintiffs do not typically seek temporary restraining orders, and district courts do not often grant them. However, district courts have occasionally granted such requests. See, e.g., *Aevoe Corp. v. AE Tech Co.*, 727 F.3d 1375, 1377-78 (Fed. Cir. 2013) (declining to exercise jurisdiction over interlocutory appeal, where district court: granted TRO and preliminary injunction in favor of Aevoe; enjoined AE Tech and its distributor from marketing its competing touch screen protector at a Las Vegas trade show; held AE Tech and its distributor in contempt for violating the injunction order; and sanctioned AE Tech and its distributor for their violations); see also *Talavera Hair Prods., Inc. v. Taizhou Yunsung Elec. Appliance Co., Ltd.*, 2018 U.S. Dist. LEXIS 199020, at *14 (S.D. Cal. May 10, 2018) (granting TRO against infringement of utility patent); *Neptune Techs. & Bioresources, Inc. v. Luhua Biomarine Shandong Co.*, 2015 U.S. Dist. LEXIS 192570, at *2-7 (D. Nev. Oct. 7, 2015) (granting TRO against infringement of utility patent and issuing order for U.S. marshals to seize property of China-based manufacturer); *Equalia, LLC v. Kushgo LLC*, 2017 U.S. Dist. LEXIS 4112, at *25 (D. Nev. Jan. 11, 2017) (granting TRO in design

patent case); *Conair Corp. v. Le Angelique, Inc.*, 2014 U.S. Dist. LEXIS 128758, at *14 (D. Nev. Sep. 15, 2014) (same), quoting *Douglas Dynamics, LLC v. Buyers Prods. Co.*, 717 F.3d 1336, 1344-46 (Fed. Cir. 2013) (“[T]he public has a greater interest in acquiring new technology through the protections provided by the Patent Act than it has in buying ‘cheaper knock-offs.’”). Prof. Marketa Trimble, *Temporary Restraining Orders to Enforce Intellectual Property Rights at Trade Shows: An Empirical Study* (2018), available at <https://scholars.law.unlv.edu/facpub/1096> or 83 Brooklyn L. Rev. 1345, 1356 (2018) (“As for the immediacy of irreparable harm, a plaintiff seeking a trade show-related TRO will allege that (1) harm will occur in such a short period that there is no time for a court to order a hearing and issue a preliminary injunction in time to prevent the harm, and/or (2) harm is likely to occur when the defendant is served, the notice being likely to cause the defendant to accelerate and/or intensify his infringing actions before the court can hear the parties and issue a preliminary injunction.”). Of course, district courts sometimes deny a patentee’s request for a TRO. See, e.g., *FieldTurf USA, Inc. v. AstroTurf, Ltd. Liab. Co.*, 725 F. Supp. 2d 609, 611 (E.D. Mich. 2010) (denying patentee’s request for TRO); *Banjo Buddies, Inc. v. Renosky*, 160 F. Supp. 2d 138, 140 (D. Me. 2001) (same).

III. PROCEDURAL CONSIDERATIONS AFTER A GRANT OR DENIAL OF A REQUEST FOR INJUNCTIVE RELIEF

A patentee who secures an order granting injunctive relief expects to enjoy the benefits of that relief and must therefore be able to enforce the order. On the other hand, a patentee who has been denied injunctive relief may wonder whether he has any recourse – either during the case or after final judgment. These issues are addressed briefly below.

A. Contempt Proceedings

A patentee who believes the enjoined party has violated the injunction may seek relief through a motion for contempt. See *Tivo Inc. v. Echostar Corp.*, 646 F.3d 869, 880 (Fed. Cir. 2011) (en banc). The movant need not show that the infringer intended to violate the injunction; to the contrary, a lack of intent to violate an injunction alone cannot save an infringer from a finding of contempt. *Id.* It matters not with what intent the defendant did the prohibited act – an act does not cease to be a violation merely because it may have been done innocently. *Id.* Although a defendant’s diligence and good faith efforts are not a defense to contempt, such factors may be considered in assessing penalties, a matter as to which the district court has considerable discretion. *Id.*

B. Appeals

1. Appealing the Denial of a Request for Permanent Injunctive Relief

“The decision to grant or deny permanent injunctive relief is an act of equitable discretion by the district court, reviewable on appeal for abuse of discretion.” *eBay*, 547 U.S. at 391; see also *TEK Glob.*, 920 F.3d at 791 (appellate review of an order granting or denying injunctive relief “is guided by statute and well-established principles of equity”), citing 35 U.S.C. § 283. If the Federal Circuit agrees that a request for permanent injunction was improperly denied, then it may reverse and remand for further consideration. See, e.g., *Windsurfing, Int’l, Inc. v. AMF, Inc.*, 782 F.2d 995, 1002-03 (Fed. Cir. 1986) (concluding that district court abused its discretion in denying request for permanent injunction and remanding for further consideration of that request). In some instances, the Federal Circuit may direct the district court to enter an injunction without further consideration. See, e.g., *Robert Bosch LLC v. Pylon Mfg. Corp.*, 659 F.3d 1142, 1150-51, 1156-57 (Fed. Cir. 2011) (concluding that district court abused its discretion in denying request for permanent injunction and commanding district court to enter an appropriate permanent injunction without “[f]urther delay”). For an excellent discussion and in-depth analysis of the Federal Circuit’s review of orders granting and denying requests for permanent injunctions, see Ryan T. Holte and Christopher B. Seaman, *Patent Injunctions on Appeal: An Empirical Study of the Federal Circuit’s Application of eBay*, 92 Wash. L. Rev. 145 (2017).

2. Appealing the Denial of a Request for Preliminary Injunctive Relief

A patentee whose request for a preliminary injunction has been denied may seek an interlocutory appeal. The Federal Circuit has jurisdiction over such appeals under 28 U.S.C. §§ 1292(c)(1) and 1295(a)(1). *Celgard, LLC v. LG Chem, Ltd.*, 624 F. App’x 748, 751 (Fed. Cir. 2015). As clarified by *eBay*, the “grant, denial, or modification of a preliminary injunction . . . is not unique to patent law, so [the Federal Circuit] applies the law of the regional circuit when reviewing and interpreting such a decision.” *Aevoe Corp. v. AE Tech Co.*, 727 F.3d 1375, 1381 (Fed. Cir. 2013). However, the Federal Circuit has itself built a body of precedent applying the general preliminary injunction considerations to a large number of factually variant patent cases, and gives dominant effect to Federal Circuit precedent insofar as it reflects considerations specific to patent issues. *Trebro Mfg. v. FireFly Equip., LLC*, 748 F.3d 1159, 1165-66 (Fed. Cir. 2014).

To reverse the denial of a request for a preliminary injunction, the appellant must show not only that one or more of the district court’s findings was clearly erroneous, but also that denial of the injunction amounts to an abuse of the

court's discretion upon reversal of the erroneous findings. *Id.* (reversing district court's denial of Trebro's motion for preliminary injunction), citing *Aria Diagnostics, Inc. v. Sequenom, Inc.*, 726 F.3d 1296, 1300 (Fed. Cir. 2013). On appeal, any tentative claim construction rulings will be reviewed *de novo*, except that the Court must afford deference to any underlying factual findings. See *Lighting Ballast Control LLC v. Philips Elecs. N. Am. Corp.*, 790 F.3d 1329, 1335-36 (Fed. Cir. 2015) (holding, after remand from the Supreme Court, that "the ultimate question of the proper construction of a claim is a legal question ... review[ed] de novo, [but] underlying 'subsidiary' factual findings ... are reviewed for clear error").

IV. CONCLUSION

Following the U.S. Supreme Court's pronouncements in *eBay* and *Winter*, some litigants worried that the playing field had been drastically altered and that injunctive relief in patent cases would become increasingly rare. However, the Federal Circuit, in *Robert Bosch* and other cases, has since reaffirmed "the fundamental nature of patents as property rights granting the owner the right to exclude" – reminding district courts that these fundamental truths maintain an important "place in the ... equitable analysis" and must "not be ignored" when applying the "traditional tests." Federal courts will continue to develop and refine the outer contours of the equitable analysis, but the basic pillars of these traditional tests are well established, and their applicability in patent cases has been reaffirmed. Accordingly, patentees have a clear roadmap for requesting injunctive relief, and district courts have broad discretion to fashion equitable remedies where appropriate.