



First Circuit: Supreme Court Decision Calls into Question Presumption of Irreparable Harm in Trademark Infringement Preliminary Injunction Cases

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In *eBay v. MercExchange L.L.C.*, 547 U.S. 388 (2006), the Supreme Court reaffirmed that courts must apply "traditional rules of equity" in deciding whether to grant permanent injunctions in patent cases. It found that the Federal Circuit's "general rule" in patent cases "that a permanent injunction will issue once infringement and validity have been adjudged" except in "exceptional circumstances" was improper. Essentially, then, the Court found that courts cannot presume irreparable harm in the patent injunction context.

In many jurisdictions, irreparable harm has been presumed in trademark infringement preliminary injunction proceedings. After *eBay v. MercExchange*, courts have considered, and sometimes avoided, the question of whether that presumption remains valid. See *Osmose, Inc. v. Viance LLC*, 612 F.3d 1298 (11th Cir. 2010) ("Because the district court did not rely on a presumption of irreparable injury, we need not decide whether such a presumption still applies in the wake of *eBay*"); *N. Am. Med. Corp. v. Axiom Worldwide, Inc.*, 522 F.3d 1211 (11th Cir. 2008) (vacating and remanding preliminary injunction for consideration of whether a presumption of irreparable harm should be applied after the *eBay* decision); *Lorillard Tobacco Co. v. Engida*, 213 Fed. Appx. 654 (10th Cir. 2007), *cert. denied*, 127 S.Ct. 3016 (2007) ("We need not consider how *eBay* may apply in this context . . . because in any event Lorillard has not shown that any harm Lorillard would suffer in the absence of an injunction outweighed the potential harm to I and G"). Compare *Lorillard Tobacco Co. v. Amouri's Grand Foods, Inc.*, 453 F.3d 377 (6th Cir. 2006) (court presumed irreparable harm on a showing of likelihood of success on the merits); *Harris Research, Inc. v. Lydon*, 505 F. Supp. 2d 1161 (D. Utah 2007) ("The Supreme Court has recently disapproved the use of categorical rules in connection with injunctive relief in intellectual property actions, and Plaintiff must show irreparable injury to support a preliminary injunction.") (internal quotations and citations omitted).



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In *Voice of the Arab World Inc. v. MDTV Medical News*, 98 U.S.P.Q.2d 1822 (1st Cir. 2011), the First Circuit became the latest court to recognize that the eBay decision called into question whether irreparable harm may be presumed in a trademark preliminary injunction context. However, the First Circuit decided not to decide. In *Voice of the Arab World*, the movant dealt on and off with the defendant regarding the disputed trademark for approximately 10 years, and only brought a motion for preliminary injunction in response to the other party's complaint seeking a declaratory judgment of non-infringement. The court held that this long delay belied the need for preliminary injunction. Hence, whether or not the movant could benefit from a presumption, it would have been rebutted. The court vacated and remanded the district court's grant of preliminary injunctive relief.

What is the impact of "decisions not to decide"? The smart preliminary injunction movant will be armed with evidence to support its claim of irreparable harm, and will not rely solely on the presumption to prevail.

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