



## Second Circuit Rules against J.D. Salinger, Finds Presumptions of Irreparable Harm No Longer Applicable for Granting Preliminary Injunctions in Copyright Cases

May 6, 2010

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J.D. Salinger wrote *The Catcher in the Rye*, became a sensation, and then disappeared—except for the occasional copyright suit. In *Salinger v. Colting*, No. 09-2878-cv, slip op. (2d Cir. Apr. 30, 2010), the Second Circuit vacated and remanded for further consideration the district court's decision to grant Salinger a preliminary injunction against the publication in the United States of Frederick Colting's *60 Years Later: Coming Through the Rye*.<sup>1</sup>

The Second Circuit's decision did not turn on any error in the lower court's logic—Judge Calabresi, writing for a unanimous panel, upheld the lower court's findings that Salinger likely would prevail on the merits of his copyright claim because (1) the works at issue were substantially similar and (2) Colting was not likely to prevail on a fair use defense—but instead on a change to the Second Circuit's standard for granting injunctions, both preliminary and permanent, in response to the Supreme Court's decision in *eBay, Inc. v. MercExchange, LLC*, 547 U.S. 388 (2006).

Salinger supporters likely have nothing to worry about because of this change in law, unless they were hoping to read an unauthorized sequel to *The Catcher in the Rye*.<sup>2</sup> The Second Circuit granted a ten day stay of the dissolution of the preliminary injunction, during which time Salinger may seek a temporary restraining order pending the rehearing of the preliminary injunction. The district court is likely to grant both the temporary restraining order and the preliminary injunction, given its prior decision.

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<sup>1</sup> Salinger passed away during the pendency of the appeal, but his estate is now pursuing the lawsuit.

<sup>2</sup> The Second Circuit, citing literary critic Louis Menand, noted that among the numerous novels spawned by Salinger's work and main character, Holden Caulfield, were Sylvia Plath's *The Bell Jar* (1963), Hunter S. Thompson's *Fear and Loathing in Las Vegas* (1971), and Dave Egger's *A Heartbreaking Work of Staggering Genius* (2000). See *Salinger*, slip op. at 4 n.2.



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Prospectively, though, intellectual property owners will face a stricter standard to obtaining injunctive relief. Following *eBay*, the Second Circuit held that, to obtain preliminary injunctive relief, a copyright infringement plaintiff must show that: (1) either (a) a likelihood of success exists on the merits or (b) sufficiently serious questions going to the merits exist to make them a fair ground for litigation and a balance of hardships tipping decidedly in the plaintiff's favor; (2) it is likely to suffer irreparable injury in the absence of an injunction; (3) the balance of hardships tips in its favor; and (4) the public interest would not be disserved by the issuance of a preliminary injunction. In assessing the second prong of the test, a court "must actually consider the injury the plaintiff will suffer if he or she loses on the preliminary injunction but ultimately prevails on the merits." *Salinger*, slip op. at 18. A court "must not adopt a 'categorical' or 'general' rule or presume that the plaintiff will suffer irreparable harm." *Id.* Moreover, the Second Circuit stated that it saw "no reason that *eBay* would not apply with equal force to an injunction in *any* type of case." *Id.* at 15.

*Salinger* likely spells the death of the presumption of irreparable harm in copyright cases. Nonetheless, the Second Circuit acknowledged that proving irreparable harm may not be difficult, citing marketplace confusion over the source of a work, difficulty in proving lost sales due to an infringement, and loss of the freedom not to speak under the First Amendment as potential arguments plaintiffs may assert in support of irreparable harm. See *id.* at 20.

Nor will trademark cases be immune from the heightened standard of proof. Although many courts have attempted to limit *eBay* to its facts by applying the Court's holding only to patent infringement cases, the Eleventh Circuit has explicitly stated that *eBay* applies to trademark infringement claims. See *N. Am. Med. Corp. v. Axiom Worldwide, Inc.*, 522 F.3d 1211, 1228 (11th Cir. 2008) ("[L]anguage of the Lanham Act is so similar to the language of the Patent Act, we conclude that the Supreme Court's *eBay* case is applicable to the instant case."). A number of district courts also have applied the stricter standards of proof enunciated in *eBay* to trademark infringement claims. See, e.g., *Cytosport, Inc. v. Vital Pharmaceuticals, Inc.*, 617 F. Supp. 2d 1051 (E.D. Cal. 2009) (citing *Winter v. Natural Res. Def. Council*, \_\_\_ U.S. \_\_\_, 129 S.Ct. 365 (2008)) (stating that presumption of irreparable harm no longer applies when a plaintiff seeks a preliminary injunction in a trademark infringement action). The Second Circuit's clear and authoritative application of *eBay*'s rejection of the presumption of irreparable harm to copyright infringement in *Salinger* may cause the remaining courts to extend *eBay* to trademark cases as well. As more courts apply *eBay* to trademark infringement cases, plaintiffs will have to present evidence to support findings of irreparable harm, such as loss of control of a business reputation or loss of goodwill, the latter of which is incalculable and hard to repair.

Although the *Salinger* decision eliminates the presumption of irreparable harm granted to a plaintiff seeking an injunction in copyright cases, courts created these presumptions as shorthand for dealing with familiar situations. See *eBay*, 547 U.S. at 395 (Roberts, C.J., concurring) (noting that the historical practice of granting injunctive relief in patent infringement cases is unsurprising, given the difficulty in protecting the rights involved). Copyright plaintiffs and, perhaps soon, trademark plaintiffs will no longer be permitted to rely on this evidentiary shortcut, but will need to present credible proof of the harms that intellectual property owners face from infringement.

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