

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

# Are Injunctions an Endangered Species in U.S. Trademark Enforcement?

Laura Popp-Rosenberg  
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## *The Landscape Shifts: eBay/Winter*

*eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006)

- Rejected presumption of irreparable harm in patent infringement case and held that court must apply the traditional four-factor test

*Winter v. Natural Resources Defense Council*, 555 U.S. 7 (2008)

- Rejected Ninth Circuit's holding that if a plaintiff makes a strong showing of likelihood of success on the merits, then the plaintiff need only prove a "possibility" of irreparable harm – i.e., reiterated "likely" standard

## Is the *eBay/Winter* Shift Appropriate?

- Trademark law is different from patent and copyright law
- Trademarks are different from patent and copyrights
- *eBay* and *Winter* holdings on their face are not inconsistent with application of presumption

# Does the *eBay/Winter* Shift Really Matter?

- Preliminary Injunctions
- Forum shopping
- Inconsistent results
  - *US Polo Ass'n, Inc. v. PRL USA Holdings, Inc.*, 800 F. Supp. 2d 515 (S.D.N.Y. 2011)
  - *Tecnimed SRL v. Kidz-Med, Inc.*, 763 F. Supp. 2d 395 (S.D.N.Y. 2011), *aff'd*, 462 Fed. Appx. 31 (2d Cir. 2012)
- Potential lack of remedy
  - *Active Sports Lifestyle USA, LLC v. Old Navy, LLC*, 2014 WL 1246497 (C.D. Cal. March 21, 2014)

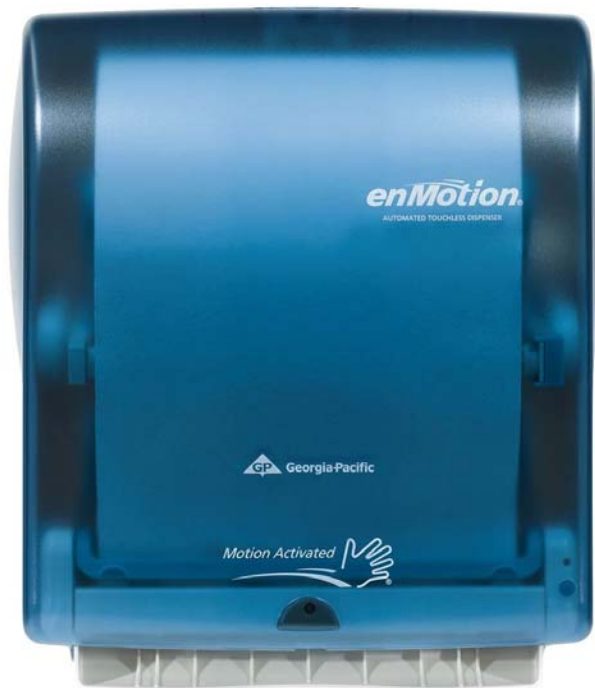
# The Borders Expand: La Quinta v. Q.R.T.M.



## *The Borders Expand: La Quinta v. Q.R.T.M.*

“We are concerned that the district court’s analysis does not discuss a fact we think relevant to weighing the equities in this case: That a permanent injunction in favor of La Quinta here would bar Quinta Real from opening a hotel in the United States under its own name, while at the same time La Quinta would remain free to open hotels and do business in Mexico as ‘La Quinta.’”

# *The Borders Contract: Georgia-Pacific v. von Drehle*



**VONDREHLE**  
CORPORATION

## *The Borders Contract: Georgia-Pacific v. von Drehle*

“Defendant is hereby enjoined from any activity in the states comprising the Fourth Circuit which purposefully interferes with plaintiff’s trademark rights in the states comprising the Fourth Circuit. Any deliberate placement of defendant’s paper towels in plaintiff’s enMotion dispensers in the states comprising the Fourth Circuit shall constitute a violation of this permanent injunction.”



Thank you.

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