

**Preliminary Relief in Copyright Cases
A Brief Report by the Enforcement Subcommittee of
the Copyright Committee**

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Introduction

One of the unifying themes in intellectual property practice throughout the globe is concern about the damage that an infringement can cause the rights holder during the pendency of legal proceedings. National laws are different, of course, sometimes dramatically so. Within each country there is typically a further division as to how and under what circumstances a court or other tribunal should be empowered to grant preliminary relief in cases concerning trademark, patent or copyright law—the familiar three sisters of statutory intellectual property protection throughout the world.

By preliminary relief, we mean the application of a provisional remedy, frequently in the form of an injunction as to the claimed infringing behavior, granted before the case has been fully adjudicated and even, in certain circumstances, *ex parte*, which we define here as whenever the defending party has not yet responded to the complaint or otherwise appeared in the action. A question that has been examined by the Enforcement Subcommittee of the Copyright Committee during the 2022-2023 term is the extent to which courts are empowered to grant such preliminary injunctive relief in cases involving the alleged infringement of intellectual property rights, focusing here on cases concerning copyrights. Looking forward as to both policy and procedure, should a court (a) grant the rights-holding plaintiff a presumption that any claimed infringement took place and (b) award injunctive relief for that presumed (but as yet unproven) copyright infringement before the defendant shall have been given an opportunity to present its case?

An intuitive response when considering that question within any jurisdiction is to look for analogies from its body of law concerning trademarks and patents, but is such an analogy apposite to the point that it could comfortably be suggested that, should a jurisdiction grant preliminary relief due to a presumption of infringement in trademark or patent claims, it must do the same in copyright cases? As is suggested below, there are unique considerations in copyright law that weigh in favor of a rejection of a presumption of infringement in considering *ex parte* requests for injunctions, even if, had any plausibly analogous cases been filed under trademark law, a presumption of infringement might have been appropriate.

Because we are members of an important association with the word *trademark* in its name, it is instructive to consider, at the outset, the differences between the goals of plaintiffs when seeking to halt the infringement of trademarks and the objectives of

plaintiffs when pursuing that objective in cases of copyright infringement. Those two branches of intellectual property law (sometimes called, perhaps a bit unkindly, “soft IP”) share much in common, but on this point, they diverge in two key respects: (a) the nature of the potential damage that could be caused by an infringement, and (b) the nature of the potential negative consequences of enjoining conduct that, after the case shall have been fully adjudicated, may not have been shown to have been infringing after all. Just the same, it is with patent law that we must start, if only because much commentary has been offered throughout the IP community on what happened in the United States when just such a presumption was made a part of the law—and then removed.

I. The United States

1. Forms of Injunctive Relief

Injunctions have been a part of American jurisprudence since the country was still a collection of British colonies hugging the eastern shore of North America. In general terms, oversimplified for concision, injunctive relief comes from the equity side of English jurisprudence, which originally ran parallel to the common law. Equitable relief was intended for use whenever an award of damages under common law would not be enough to redress the harm.

Injunctive relief comes in three categories and with two methods of delivery. Think of whenever you choose among vanilla, chocolate, or strawberry ice cream and if your selection should be served in a cup or on a cone, and then consider the three flavors of American injunctive relief and the two methods by which they are enforced.

All three forms of injunctive relief share similar characteristics. Being creatures of equity, injunctions are granted whenever a showing has been made that damages would not be a sufficient remedy. In such a situation, a court will typically apply a four-part test, all parts of which would have to be satisfied for the requested relief to be granted. The moving party must show: (1) a likelihood of suffering irreparable harm in the absence of injunctive relief; (2) a likelihood of success on the merits; (3) a balancing of the harms and benefits between the parties favors the moving party; and (4) the injunctive relief would be in the public interest. The trial court typically has broad discretion and, indeed, if an injunction is granted, the appellate court will only reverse the ruling if it should find an abuse of discretion by the court below. The three categories:

A *temporary restraining order* (or simply, a TRO) is typically granted *ex parte*. It is a short-term and quasi-preliminary injunction issued during pretrial proceedings. TROs are intended as bridging measures and are limited in their duration. (Fourteen days is a useful benchmark.) As quickly as practicable, if the plaintiff believes the injunction remains necessary, the court will hold an interparty hearing on the issuance of a preliminary injunction. Needless to say, in large measure due to the strong preference within the United States legal system for bilateral advocacy, seeking a TRO under any circumstances can be challenging.

A *preliminary injunction* provides similar relief, but because it is available only after both parties have had chances to appear before the court, its granting is more common—although it can also be quite hard to obtain. In deciding whether to issue a preliminary injunction, in balancing the equities, the judge will likely employ the four-part test referenced above.

After full adjudication on the merits, and commonly after a preliminary injunction has already been granted, a court may impose a *permanent injunction* to make the prevention of irreparable harm ongoing.

The two injunctive methods are *mandatory* and *prohibitory*. A *mandatory injunction* is less common because it means that the court has ordered a party to do something.¹ More familiar, particularly in cases of intellectual property infringement, is the *prohibitory injunction*, which prevents the activity that was made a subject of the complaint for infringement.² In short, and this is no surprise to INTA members, of course, when you are granted a probatory injunction in a trademark infringement case, what typically follows is that all sales of the infringing goods cease, the remaining stock is surrendered or destroyed, and further relief (such as a surrender of profits) may also be granted.

¹ See *Second on Second Cafe, Inc. v. Hing Sing Trading, Inc.*, 66 A.D.3d 255 (N.Y. Sup. 2009)

² See *Trial Lawyers College v. Gerry Spence Trial Lawyers College at Thunderhead Ranch*, 23 F.4th 1262 (10th Cir. 2022); *Two Hands IP LLC v. Two Hands America, Inc.*, 563 F.Supp.3d 290 (S.D.N.Y. 2021)

2. The Evolution of the Presumption of Irreparable Harm Under United States Patent Law

In the United States, enforcement of patent rights had been sporadic until the establishment, in 1982, of a dedicated court for patent appeals (among its other functions), the Court of Appeals for the Federal Circuit. Not long thereafter, in *H.H. Robertson, Co. v. United Steel Deck, Inc.*,³ the court ruled that, in deciding on whether to grant a preliminary injunction, the plaintiff should be given a presumption that it would suffer irreparable harm due to the (still unproven) infringement because it had made a clear showing that the subject patent was valid. In this case, the District Court held that Robertson had “established a basis for the relief it seeks” and granted the preliminary injunction.⁴ The Court of Appeals affirmed that decision. It should be noted that a factor considered by the court was the short term of patents in the United States,⁵ a term that is not suspended during litigation.⁶ Needless to say, if such a presumption is granted, the plaintiff is a good way toward obtaining a TRO, along with considerable leverage for the next phases of the case.

In granting the injunction, the court in *The H.H. Robertson* court granted the plaintiff the preliminary injunction it sought against the defendant. It applied the four-part test and found that each factor favored the plaintiff. It presumed irreparable harm, in part, because the defendant failed to rebut the presumption that arose from the plaintiff making a *prima facie* showing of patent infringement. Because the Federal Circuit has exclusive jurisdiction for patent appeals, the presumption of irreparable harm in the *H.H. Robertson* case became the de facto law of the land—until, nearly four decades later, the Supreme Court decided otherwise in *eBay Inc. v. MercExchange, LLC*.⁷ That was a complex case with a famous plaintiff, but in simple terms, the Supreme Court rejected the presumption of irreparable harm whenever courts would consider granting a TRO. *eBay* changed patent law, and *Robertson* is no longer controlling in patent cases. That does not mean that a party alleging patent infringement cannot get preliminary relief, only that he or she will have to work for it, meeting the typically high standards for receiving the relief, just as might a litigant in an action grounded in other branches of federal jurisprudence.

³ *H.H. Robertson, Co. v. United Steel Deck, Inc.*, 820 F.2d 384 (Fed.Cir.1987)

⁴ *H.H. Robertson, Co. v. United Steel Deck, Inc.*, 820 F.2d 384, 386 (Fed.Cir.1987)

⁵ 35 U.S.C. § 154

⁶ *H.H. Robertson, Co. v. United Steel Deck, Inc.*, 820 F.2d 384, 390 (Fed.Cir.1987)

⁷ *eBay Inc. v. MercExchange, LLC*, 547 U.S. 388, 126 S.Ct. 1837, 164 L.Ed.2d 641 (2006)

3. A Different Path for United States Trademark Law

On December 27, 2020, the Trademark Modernization Act of 2020 became law, amending the United States trademark statute (commonly known as the Lanham Act), to place into trademark jurisprudence the rebuttable presumption of irreparable harm for plaintiffs seeking injunctive relief.⁸ In general terms, the rule that, in *eBay, Inc. v. MercExchange*, the Supreme Court had excised from judge-made law in patent cases had now been codified for trademark cases.

There is credible reasoning behind that. United States trademark law had developed in equity. Historically, it was considered a win whenever a trademark owner obtained an injunction against an infringer, with damages playing a secondary role to the point they were considered a bonus. As any INTA member knows all too well, that was also due to the fact that the reputation of the source of a trademark can be damaged quickly and with great longevity or even permanence if an infringement continues for the duration of a typical federal lawsuit grounded in halting trademark infringement (or dilution). The owner of the mark could be irreparably damaged in the marketplace and the trademark, which had held economic value for the goodwill it presented, could become either worthless or even an impediment.

4. Applicability to United States Copyright Law

And that is how it has stood as, in recent years, questions have arisen whether and under what circumstances there should be a presumption of infringement in cases of alleged copyright infringement—to bring into copyright law the rule that *eBay* removed from patent law and that Section 34(a) of the Lanham Act added to trademark law.

Under current law, a preliminary injunction for copyright infringement will not be issued based on a presumption of irreparable harm. Instead, the party seeking the injunction will have to satisfy each part of the four-prong test, a point cited by the Supreme Court in its *eBay* decision: “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. [...] That approach is consistent with our treatment of injunctions under the Copyright Act.”⁹

⁸ Lanham Act, Section 34 (a)

⁹ See *eBay Inc. v. MercExchange, LLC*, 547 U.S. 388, 391–392, 126 S.Ct. 1837, 164 L.Ed.2d 641 (2006).

Although trademark and copyright might both be “soft IP,” concerned with non-functional forms of intellectual property, it is here that they diverge in purpose and in application of considerations of the public interest. United States trademark law, which is grounded in the protection of the reputation of the source of goods and services, is a branch of commercial law. Paradoxically, it protects monopolies and the rights of consumers. By giving an enterprise a monopoly in its trademark or services marks for (at the very least) the goods and services it markets, it allows the enterprise to trade without fear that its marketplace will be confused about the origin of what it offers: the mark COCA-COLA identifies only one maker’s cola soft drink, and if you want an HERMÈS bag (and who would not?), there is only one place to go. Assuming a mark holder keeps using the mark in United States commerce, the monopoly is perpetual.

All United States copyright law, however, derives, along with patent law, from a single sentence in the nation’s constitution: “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.”¹⁰ Unlike trademark law, federal copyright law preempted state law that provided protection for rights that are equivalent to any of the rights protected by the Copyright Act.

Copyright law, as so administered in the USA, does not protect commercial interests *per se*; it protects, for a limited period of time, a property right to expression in a fixed form—that is, in simple reductionist terms, the arts. That is why the novel *The Great Gatsby* was only available from the licensed publisher of F. Scott Fitzgerald from 1925, when it was first published, until 2021, when the copyright expired and the classic work fell into the public domain. It also helps explain why The Walt Disney Company has been so diligent in bolstering trademark rights to Mickey Mouse, the first iteration of whom (as Steamboat Willy) will lose copyright protection in 2024. In short, trademarks, which are not referenced in the United States Constitution, are protected under statutory and case law grounded in the regulation of commerce, but works of artistic expression are protected by a federal copyright law that is grounded in a constitutionally expressed hope for aiding human progress.

Just as important is another part of the United States Constitution, the First Amendment, which famously guards free expression: “Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom

¹⁰ U.S. Const. art. I, § 8, cl. 8

of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances.”¹¹ Courts will safeguard against the “chilling effect” that both law and conduct can have on free expression.¹² More consequential for our purposes is the strong preference against the “prior restraint” of free speech, meaning, “a law, regulation or judicial order that suppresses speech—or provides for its suppression at the discretion of government officials—on the basis of the speech’s content and in advance of its actual expression.”¹³

It is hard to see how those important constitutional considerations can be reconciled with any expectation that *ex parte* relief could be granted to enjoin the dissemination of an expressive work based on a presumption of its commercially harmful effect. In a controversial 1996 case, the distribution of the feature film *12 Monkeys* was preliminarily enjoined barely three months following its initial release into theaters because a set was found to have substantially a single graphite pencil illustration.¹⁴ What harm a major feature film could have done to a pencil drawing that could not be rectified with a payment of damages (the case was ultimately settled) remains unclear, the case perhaps illustrating, in a backwards way, why a presumption of infringement in the earliest phase of a copyright case likely does not serve the public interest.

The United States Copyright Act was crafted around the understanding that, unlike trademark law, damages are the core goal in infringement cases. Indeed, and quite atypically under United States law, the Copyright Act provides for what are effectively statutory penalties for infringement, to be awarded at judicial discretion even if actual damages are nominal or difficult to prove.¹⁵ Oversimplified for concision: trademark infringement cases turn on questions of injunctive relief in large measure because the potential damage is to the reputation of the source of the goods or services rather than to those goods or services themselves. Copyright, in contrast, is about damage to a creative

¹¹ U.S. Const. amend. I

¹² *Laird v. Tatum*, 408 U.S. 1 (1972); *Morrison v. Board of Educ. of Boyd County*, 521 F.3d 602 (6th Cir. 2008); *American Library Ass’n v. Barr*, 956 F.2d 1178 (D.C.Cir.1992); *National Student Ass’n v. Hershey*, 412 F.2d 1103 (D.C.Cir.1969). “Constitutional violations may arise from the deterrent, or ‘chilling,’ effect of governmental regulations that fall short of a direct prohibition against the exercise of First Amendment rights.”

¹³ *United States v. Quattrone*, 402 F.3d 304, 309 (2d Cir. 2005); see also *Alexander v. United States*, 509 U.S. 544, 550 (1993); *Southeastern Promotions, Ltd. v. Conrad*, 420 U.S. 546 (1975); *International Outdoor, Inc. v. City of Troy, Michigan*, 974 F.3d 690, 716 (6th Cir. 2020)

¹⁴ *Woods v. Universal City Studios, Inc.*, 920 F.Supp. 62 (S.D.N.Y.1996)

¹⁵ 17 U.S.C.A. § 504 (c)

work itself, rather than its author, the infringement usually being understood to be by the hand of another party.

The new Copyright Claims Board, a tribunal operated by the Copyright Office to serve as a “small claims court” for copyright holders either unable to pay for federal court litigation or who are prepared to accept a more modest award of damages than could potentially be had by litigation, does not even have the power to issue an injunction.¹⁶

Of course, there is an expressive element to all creations originating with the human mind.¹⁷ That was the grounding consideration in the often-cited case of *Rogers v. Grimaldi*.¹⁸ The reach of the “Rogers test” had been expanded over the years by federal courts to mean, in effect, that, whenever an expressive element was at issue in a trademark dispute, the standard of review should include an examination of the effect of a ruling on that expression. Because trademarks rarely fail to express something, the broadening use of the Rogers test was threatening to raise the bar for complaining parties to put a stop to infringement. The Supreme Court recently clipped back the use of the Rogers test, however, stating that, although expressive elements may indeed be present in trademark cases, in typical disputes of “*Goods v. Goods*” or “*Services v. Services*,” the old rule is the best rule: you have to prove infringement the standard way—by an analysis of several factors is necessary to determine whether there is a likelihood of confusion between two marks.

Commerce will indeed continue to drive the advancement of the arts. And it will indeed be possible to protect graphic designs and other creations as both trademarks and copyrights.¹⁹ But copyright and trademark remain highly distinct bodies of United States law for good reason. For copyright protected works, the rule should remain what it has been for centuries: whenever in doubt, let free expression continue, but if infringement is found, it must be halted and damages paid.

¹⁶ See [Claimant Information | U.S. Copyright Office \(ccb.gov\)](https://www.ccb.gov).

¹⁷ Let’s please leave out of the discussion for the moment where we would place creations by artificial intelligence.

¹⁸ *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989)

¹⁹ See Copyright Offices Board Opinion of the American Airlines Flight Symbol from December 7, 2018 (“After careful examination of the Work, as well as the first and second requests for reconsideration and the additional higher-quality images, the Board finds that the Work contains a minimal, but sufficient amount of original and creative authorship to sustain a claim to copyright.” (Page 5))

II. The Perspective in Europe (Selected Examples)

In 2019, the European Union adopted the EU Copyright Directive, which is intended to bring certain adjustments to copyright and related rights in line with advances in the digital marketplace. Copyright law is, however, not fully harmonized within the European Union. Enforcement of copyright law falls within the competence of individual EU member states, which have their own national regulations and practices regarding preliminary relief, including whether to presume irreparable harm.

Even though the Directive 2004/48/EC²⁰ on the Enforcement of Intellectual Property Rights was a first step toward harmonization,²¹ differences remain among EU members regarding the issuance of preliminary injunctions in copyright infringement cases. As a result, to determine whether it is possible to obtain a preliminary injunction *ex parte* in a copyright case, parties must still look to the national law of EU member states.

In **France**, it is theoretically possible to obtain a preliminary injunction against alleged infringement either *ex parte* or *interparty*. In practice, however, the granting of preliminary injunction on an *ex parte* application is extremely rare. Preliminary injunctions may also be granted in case management orders during proceedings on the merits. Plaintiffs who are successful in proceedings on the merits are, however, commonly granted injunctive relief.

In **Germany**, Articles 935 *et seq.* of the ZPO (the German Code of Civil Procedure) set the framework for the granting of preliminary injunctions. The party seeking the injunction must provide *prima facie* proof that it is more than likely that infringement was indeed taking place. The applicant further needs to convince the judge that urgent relief is necessary. Unlike in France (and Italy), the issuance of a preliminary injunction is usually granted only after there has been an oral argument in which both sides participate. However, under Article 937 para. 2 ZPO, as in Italy and France, in cases of particularly urgent need, and as an exception to the general rule, a preliminary injunction will be

²⁰ Directive 2004/48/EC of the European Parliament and of the European Council of 29 April 2004 on the enforcement of intellectual property rights (a common unofficial abbreviated title is “Intellectual Property Rights Enforcement Directive” is a legal act of the European Community in the field of industrial property protection. It is primarily aimed at ensuring equivalent protection of intellectual property in the Member States. It serves to implement the requirements of Articles 44 *et seq.* of the TRIPS Agreement. In particular, it covers the gathering of information in the run-up to a possible lawsuit, provisional legal protection and the procedure for taking evidence.

granted without a hearing. In cases filed under press or competition law, however, hearings are usually required.

In judicial practice, that development has been overturned by the German Bundesverfassungsgericht (Federal Constitutional Court), (1 BvR 2421/17) in 2018.²² In its decision, which concerned a case regarding media law, the Bundesverfassungsgericht declared that practice of permitting *ex parte* injunctions was unconstitutional.

The rules on preliminary injunctions in both **Ireland** and the **United Kingdom** are comparable to those of Germany. In both countries, *ex parte* preliminary injunctions are rare and can only be granted in cases of demonstrated urgent need. In Ireland, the granted relief is typically of relatively short duration before the court gives the question further review. In the UK, the enjoined party may seek a hearing to have the injunction lifted. In both countries, the party granted the injunction runs the risk that, if it loses on the merits, the defendant may claim for damages suffered under the preliminary injunction.

In either country, the plaintiff does not have to prove a likelihood of success on the merits, only that there is a fair question to be tried and that the claim is not merely frivolous or vexatious (in Ireland) or that there is a serious issue to be tried (in the UK). In both countries, courts will carefully examine the difficulties in calculating and assessing damages and the question of what is just and reasonable in view of the relative positions of the parties. In reasoning similar to that in the USA, the court will review whether damages alone would be capable of being assessed and would alone be a sufficient award. (For the UK: *American Cyanamid v Ethicon Ltd* [1975] 2 WLR 316; for Ireland: *Merck Sharp & Dohme Corp v Clonmel Healthcare Ltd* [2019] IESC 65).

In **Italy**, a preliminary injunction may be granted *ex parte* as long as the requirements of the standard are met by the rights holder. They are (1) the *fumus boni iuris* (if success on the merits of the case appears likely) and (2) *periculum in mora* (the risk that delaying relief until the end of the trial would cause irreparable harm to the claimant). It is possible to apply for an expedited procedure based on the *prima facie* demonstration of infringement and the risk of the infringer causing serious and irreparable harm to the rights holder.

²² The following and above-mentioned combination “1 BvR 2421/17” is the file number of the proceeding, since cases in Germany only get unique file numbers.

Although the **Netherlands** permits the granting of *ex parte* injunctions, enforcement is at the risk of the party granted the relief. In intellectual property cases, if that enforcement should later be found unjust, the alleged infringer can claim compensation for any damages caused by the enforcement of the injunction. Article 1019g DCCP. That can put a rights holder into a particularly challenging situation in assessing the risks to seeking preliminary relief.

Poland has introduced new rules for granting injunctive relief in cases of claimed infringement of intellectual property. New regulations specify that a request for a preliminary injunction needs to be filed within six months from the date on which the requesting party became aware of the claimed infringement. *Ex parte* proceedings for preliminary injunctions are no longer permitted unless an immediate decision is shown to be necessary. There are exceptions in cases in which injunctions are solely those for enforcement by bailiffs or for administrative receiverships for failing enterprises. It is possible for the party seeking the preliminary injunction to withdraw its request or, in the event of the granting of the injunction, to seek its dismissal (before the court order shall become final).

Conclusion

If there is a common thread among the systems of jurisprudence examined here it is a profound awareness of the exceptional nature of *ex parte* relief and of the difficulty in balancing competing interests when determining whether the relief should be granted. In copyright cases in democratic societies, the difficulties are heightened by the importance of maintaining a free flow of information. Technology has made all of these considerations even more pressing; once an author clicks “enter” on a keyboard and uploads or simply passes along his or her creation, literally every person and entity in the world could potentially be an infringer. There are new participants: AI programs capable of infringing without human intervention. It has never been easier for creative works to reach wide audiences, and it has never been easier for something to go wrong in the dissemination process. Many nations are struggling with how their laws should address that, but none is yet claiming to have found an ideal solution.