

# INJUNCTION JUNCTION: REMEMBERING THE PROPER FUNCTION AND FORM OF EQUITABLE RELIEF IN TRADEMARK LAW

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## ABSTRACT

*Injunctions are supposed to be among the most extraordinary remedies in the American judicial system, yet they have become anything but rare in trademark litigation. Although the unique nature of trademark protection may explain the frequency of injunctive relief, the process by which this relief is issued is rapidly devolving into rubber-stamping by the courts. This iBrief argues that courts should (1) recommit themselves to the principles of equity before granting injunctions and (2) seriously apply the specificity requirements of Rule 65(d) of the Federal Rules of Civil Procedure to avoid overly broad orders.*

## INTRODUCTION

¶1 Federal judges presiding over trademark disputes are handing out injunctions like candy, and the orders they are writing are sloppy, broad, and nonspecific. Outside the intellectual property context, courts tend to remedy wrongs by granting monetary relief after the damage has been done; they do not issue orders demanding that such wrong never be committed again.<sup>2</sup> Trademark law, however, generally protects a party's right to certain words or symbols via injunctions.<sup>3</sup> Violating such an order carries severe penalties.<sup>4</sup> While courts must clearly protect trademark rights, to think that an individual could serve jail time in

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<sup>2</sup> See, e.g., RESTATEMENT (SECOND) OF CONTRACTS § 359(1) (1981) (“Specific performance or an injunction will not be ordered if damages would be adequate to protect the expectation interest of the injured party.”).

<sup>3</sup> See TERENCE P. ROSS, INTELLECTUAL PROPERTY LAW: DAMAGES AND REMEDIES § 11.01 (repl. 2005).

<sup>4</sup> See 19 FED. PROC., L. ED. §41:1 (2000).

contempt of court for merely using words is unquestionably a jarring proposition.<sup>5</sup>

¶2 This iBrief does not propose the abolition of injunctions. Indeed, even were this iBrief's suggestions adopted in their entirety, injunctions would likely still be issued in the majority of infringement cases. U.S. trademark laws exist first and foremost to protect consumers,<sup>6</sup> and enjoining infringement may offer the best means of accomplishing that goal. Nevertheless, injunctions are not the only available means, nor are they legislatively mandated.<sup>7</sup>

¶3 The readily assumed reliance on injunctive relief is neither ideal nor absolutely necessary. Presently, trademark injunctions are flawed in both the process by which they are issued and the form they ultimately take. The assumption that damages are either incalculable or undesirable has effectively eviscerated the four-part test for injunctions developed at common law to provide *ex ante* protection from abuse. This is, however, far from an unassailable assumption, and courts should reconsider monetary remedies. Much more importantly, courts need not and should not abandon the traditional factors that have guided the issuance of injunctions for centuries.

¶4 Second, because courts have become so willing to issue trademark injunctions, many of the orders they compose consist of boilerplate, formulaic restatements of the law that offer the trademark infringer no meaningful guidance about what action is being enjoined. Appellate courts should therefore rigorously apply Federal Rule of Civil Procedure 65(d)<sup>8</sup> and demand increased specificity in equitable remedies issued in intellectual property litigation. If in fact injunctions are to be the usual remedy, the *ex post* protections of Rule 65(d) must be upheld more vigilantly to prevent unfairness to both trademark holders and infringers.

¶5 The underlying consumer protection theory of trademark law will unavoidably result in the frequent use of injunctions. Because of, not in spite of, their necessary frequency, courts should exercise the greatest

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<sup>5</sup> The threat of jail time is certainly low, but it brings a significant coercive effect.

<sup>6</sup> *See* 15 U.S.C. § 1127 (2000) ("The intent of this chapter is . . . to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks . . .").

<sup>7</sup> The Lanham Act vests courts with the power to issue injunctions according to the traditional principles of equity; it does not *require* their use. 15 U.S.C. § 1116 (2000). The Act also gives courts broad discretionary powers to determine monetary damages in trademark cases. 15 U.S.C. § 1117(a) (2000).

<sup>8</sup> FED. R. CIV. P. 65(d).

care in granting injunctions in trademark law, both in deciding when to issue them and in what form.

#### I. TAKE THE TIME (DO IT RIGHT): THE EX ANTE PROTECTION OF THE FOUR-FACTOR TEST

¶6 Injunctions are often noted as the most common remedy in trademark litigation.<sup>9</sup> This is a serious understatement: Injunctions tend to be the *only* remedy in trademark litigation. Although the Lanham Act explicitly provides for *both* injunctive<sup>10</sup> and monetary<sup>11</sup> relief, damages are extremely difficult to obtain—more difficult than in any other field of intellectual property.<sup>12</sup> This difficulty, combined with consumer protection principles, has led to injunctions' becoming the remedy of choice, which in turn has led to their abuse.

¶7 Courts granted injunctions in seventy percent of the available federal district court trademark opinions from 2005 in which the court specifically considered the question of whether to grant an injunction.<sup>13</sup> Of the thirty percent of opinions denying injunctions, nearly all were denials of preliminary injunctions where the plaintiff failed to show a likelihood of success.<sup>14</sup> Last year, no federal district court denied an

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<sup>9</sup> See, e.g., *Mont. Prof'l Sports, LLC v. Leisure Sports Mgmt., Inc.*, No. CIV605CV1827ORL18DA, 2006 WL 289111, at \*5 (M.D. Fla. Feb. 7, 2006); *Beacon Mut. Ins. Co. v. OneBeacon Ins. Corp.* 376 F. Supp. 2d 251, 265 (D. R.I. 2005); Adam Brookman, *Trademark Law Protection, Enforcement and Licensing* § 9.05[A] (repl. 2005); 5 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 30:2 (4th ed., repl. 2005).

<sup>10</sup> 15 U.S.C. § 1116 (2000).

<sup>11</sup> *Id.* § 1117(a).

<sup>12</sup> ROSS, *supra* note 3, § 4.01.

<sup>13</sup> This data is based on a survey of all available federal district court opinions on trademark infringement claims in 2005. This data set excludes cases where the court dismissed trademark infringement claims under Rules 12(b)(6) or 56 of the Federal Rules of Civil Procedure, even if the plaintiff may ultimately have been seeking an injunction. In other words, the data only includes opinions and orders where the court was asked to address the specific question of whether or not to grant a permanent or preliminary injunction. In total, there were sixty-seven cases that fit the criteria.

<sup>14</sup> This thirty percent includes several opinions that declined to grant injunctions for technical reasons or because the defendant successfully petitioned the court for a new trial. See *Fibermark, Inc. v. Brownville Specialty Paper Prods., Inc.*, No. Civ.A. 7:02-CV-0517, 2005 WL 3359077 (N.D.N.Y. Dec. 9, 2005) (denying permanent injunction where ordering a new trial); *Gilson v. Rainin Instrument, LLC*, No. 04-C-852-S, 2005 WL 1899472 (W.D. Wis. Aug. 9, 2005) (denying plaintiff's request for an injunction where jury award included no such relief); *Am. Girl, LLC v. Nameview, Inc.*, 381 F. Supp. 2d 876 (E.D. Wis. 2005) (denying an *ex parte* preliminary injunction because it was doubtful whether

injunction where the trademark holder had demonstrated actual or likely success on the merits of its infringement claim. The import of this data is that in the context of trademarks, injunctions are not extraordinary remedies; they are the de facto remedies. Moreover, the data indicate (and a more thorough review of the opinions confirms) that trademark remedies, as granted by the courts, are divorced from the positive law that authorized such remedies in the first place. The Lanham Act offers courts the “power to grant injunctions, according to the principles of equity . . . .”<sup>15</sup> In other words, the statute directs courts to apply injunctions in this area under the same doctrines that guide injunctions generally.<sup>16</sup> A comparison of the traditional principles and approach in trademark law devastatingly demonstrates how far courts have digressed.

### *A. A Brief Review of Injunctions Generally*

¶8 Injunctions, which are *in personam* orders demanding compliance under threat of contempt, trace their roots to Ancient

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court had personal jurisdiction over defendant); *Santa Fe Props., Inc. v. French & French Fine Props., Inc.*, No. CIV 04-0518, 2005 WL 2313680 (D. N.M. Aug. 9, 2005) (denying relief where plaintiff requested an injunction for the first time in a reply brief); *Tony Jones Apparel, Inc. v. Indigo USA, LLC*, No. 03 C 0280, 2005 WL 1667789 (N.D. Ill. Jul. 11, 2005) (denying injunction where defendant corporation was defunct); *Cruising Co., Etc., Inc. v. Mahnken Enters., Inc.*, No. C05632P, 2005 WL 1354532 (W.D. Wash. Jun. 6, 2005) (denying preliminary injunction due to factual inconsistencies in record).. *See* *Fibermark, Inc. v. Brownville Specialty Paper Prods., Inc.*, No. Civ.A. 7:02-CV-0517, 2005 WL 3359077 (N.D.N.Y. Dec. 9, 2005) (denying permanent injunction where ordering a new trial); *Gilson v. Rainin Instrument, LLC*, No. 04-C-852-S, 2005 WL 1899472 (W.D. Wis. Aug. 9, 2005) (denying plaintiff’s request for an injunction where jury award included no such relief); *Am. Girl, LLC v. Nameview, Inc.*, 381 F. Supp. 2d 876 (E.D. Wis. 2005) (denying an *ex parte* preliminary injunction because it was doubtful whether court had personal jurisdiction over defendant); *Santa Fe Props., Inc. v. French & French Fine Props., Inc.*, No. CIV 04-0518, 2005 WL 2313680 (D. N.M. Aug. 9, 2005) (denying relief where plaintiff requested an injunction for the first time in a reply brief); *Tony Jones Apparel, Inc. v. Indigo USA, LLC*, No. 03 C 0280, 2005 WL 1667789 (N.D. Ill. Jul. 11, 2005) (denying injunction where defendant corporation was defunct); *Cruising Co., Etc., Inc. v. Mahnken Enters., Inc.*, No. C05632P, 2005 WL 1354532 (W.D. Wash. Jun. 6, 2005) (denying preliminary injunction due to factual inconsistencies in record).

<sup>15</sup> 15 U.S.C. § 1116(a).

<sup>16</sup> *Cf. Weinberger v. Romero-Barcelo*, 456 U.S. 305 (1982) (requiring an indication from congress before assuming courts will be denied customary equitable discretion).

Rome,<sup>17</sup> and since then courts have never granted them *ex debito justitiae* or as a matter of right.<sup>18</sup> In fact, the U.S. Supreme Court has called injunctions “extraordinary remed[ies],”<sup>19</sup> and remarked that the associated judicial contempt power is a “potent” and “deadly” weapon.<sup>20</sup> Some legal scholars have even raised concern about constitutional issues occasioned by enjoining speech.<sup>21</sup> Others acknowledge a broader danger. One judge, writing in 1830, warned:

There is no power the exercise of which is more delicate, which requires greater caution, deliberation, and sound discretion, or more dangerous in a doubtful case, than the issuing [of] an injunction; it is the strong arm of equity, that never ought to be extended unless to cases of great injury, where the courts of law cannot afford an adequate or commensurate remedy in damages.<sup>22</sup>

¶9 Despite the merger of law and equity, U.S. courts maintain many distinctions between legal and equitable remedies and the availability of each.<sup>23</sup> Under these principles, monetary damages “are considered an adequate remedy in all but the most extraordinary cases.”<sup>24</sup> In other words, if the plaintiff’s wrong can be rectified by money, the court will not issue an injunction.

¶10 That overarching principle has engendered a four-factor test to determine if an injunction is an appropriate and permissible remedy. Before issuing injunctive relief, a court must consider:

1. the likelihood of irreparable harm to the plaintiff in the absence of an injunction;
2. whether the likelihood of that harm is outweighed by the likelihood of harm to the defendant if the injunction were granted;

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<sup>17</sup> See generally A. H. J. GREENIDGE, *THE LEGAL PROCEDURE OF CICERO’S TIME* 210–27 (1971).

<sup>18</sup> FRANCIS HILLIARD, *THE LAW OF INJUNCTIONS* 16 (2d ed. 1869).

<sup>19</sup> *United States v. Oakland Cannabis Buyers’ Coop.*, 532 U.S. 483, 496 (2001) (quoting *Weinberger v. Romero-Barcelo*, 456 U.S. 305, 312 (1982)).

<sup>20</sup> *Int’l Longshoremen’s Ass’n., Local 1291 v. Philadelphia Marine Trade Assn.*, 389 U.S. 64, 76 (1967).

<sup>21</sup> See generally Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 *DUKE L.J.* 147 (1998).

<sup>22</sup> *Bonaparte v. Camden & A.R. Co.*, 3 F. Cas. 821, 827 (C.C.D. N.J. 1830) (No. 1,617).

<sup>23</sup> RUSSELL L. WEAVER ET AL., *MODERN REMEDIES: CASES, PRACTICAL PROBLEMS AND EXERCISES* 17 (1997).

<sup>24</sup> *Bowen v. Massachusetts*, 487 U.S. 879, 925 (1988) (Scalia, J., dissenting).

3. the success of the plaintiff on the merits (or the likelihood of success in the case of a preliminary injunction); and
4. the general public interest.<sup>25</sup>

¶11 This test provides protection to the defendant *ex ante*. The first factor is the natural byproduct of the general principle that equity will not aid one with an adequate remedy at law. Thus, the damage must be irreparable—the sort absolutely incapable of mending by mere money.<sup>26</sup> The second factor, the balance of the hardships, and the fourth factor, the public interest, represent a tacit acknowledgement that injunctions are extremely powerful and underscore the universal reach of equity.

¶12 In addition to the obvious burdens they impose on defendants,<sup>27</sup> injunctions levy significant costs on plaintiffs and the judicial system as a whole. If the defendant ignores or violates an order, the plaintiff must institute a contempt proceeding,<sup>28</sup> and the losing party may appeal.<sup>29</sup> These proceedings tax both the parties and the courts in time and money. Moreover, Professor Standen has suggested that frequent use of injunctions undesirably shifts risk-analysis burdens to plaintiffs and judges.<sup>30</sup>

¶13 Despite the long history of these protective principles and the incidental costs of injunctions, the frequency with which the remedies are issued belies the strength of the four-factor test.<sup>31</sup> Numerous commentators, citing both descriptive and normative reasons, have called for the end of the inadequate remedy at law / irreparable injury rule in all

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<sup>25</sup> See, e.g., *Metro-Goldwyn Mayer, Inc. v. 007 Safety Products, Inc.*, 183 F.3d 10, 15 n.2 (1st Cir. 1999); Cf. ROSS, *supra* note 3, § 11.02[1][b] (noting that two circuits follow a slightly different formulation, where a “party seeking injunctive relief must show: (1) that it will suffer irreparable harm in the absence of an injunction; and (2) either a likelihood of success on the merits, or sufficiently serious questions going to the merits make them a fair ground for litigation, and a balance of the hardships tipping decidedly in the movant’s favor”).

<sup>26</sup> E.g., *Pappan Enters. v. Hardee’s Food Sys., Inc.*, 143 F.3d 800, 805 (3d Cir. 1998).

<sup>27</sup> See 43A C.J.S. *Injunctions* § 398 (2005) (“Violation of a valid injunction . . . constitutes a contempt of court and is punishable as such.”). See also *id.* § 438 (“[O]ne who violates an injunction is liable to punishment by fine or imprisonment.”) (footnotes omitted).

<sup>28</sup> *Id.* § 423.

<sup>29</sup> *Id.* § 433.

<sup>30</sup> Jeffrey Standen, *The Fallacy of Full Compensation*, 73 WASH. U. L.Q. 145, 161–62 (1995).

<sup>31</sup> See DOUGLAS LAYCOCK, *THE DEATH OF THE IRREPARABLE INJURY RULE* 5 (1991).

areas of law.<sup>32</sup> Nevertheless, even those who have called for reform in this area acknowledge that there is a fundamental need for some limit on the availability of injunctions.<sup>33</sup> The modern significance of the irreparable injury rule is that injunctions are powerful, costly, and can be inefficient if overused. This is precisely the point being largely overlooked in trademark law.

### *B. The Test for Issuing an Injunction in Trademark Law*

¶14 While the four-factor test described above is still used with force in other substantive areas of law,<sup>34</sup> the gradual rise of certain presumptions has enfeebled the test in trademark law.

¶15 With only one exception, every federal court of appeals has a presumption of irreparable harm once the trademark owner has successfully proven a likelihood of success on the merits at the preliminary injunction level.<sup>35</sup> Where the court is contemplating a permanent injunction, the plaintiff's actual success will be sufficient to presume irreparable harm.<sup>36</sup>

¶16 There have been several explanations offered for why courts may presume irreparable harm in the context of trademark disputes. The most popular of these theories is inadequacy of monetary relief where the

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<sup>32</sup> See, e.g., *id. passim*; Richard R.W. Brooks & Warren F. Schwartz, *Legal Uncertainty, Economic Efficiency, and the Preliminary Injunction Doctrine*, 58 STAN. L. REV. 381 *passim* (2005). Still, despite Dean Laycock's copious research to the contrary, LAYCOCK, *supra* note 33, at 23–24, not all judges are sounding the death knell of the irreparable injury rule. See, for example, *Chandler v. James*, 180 F.3d 1254, 1266–77 (11th Cir. 1999) (Tjoflat, J., concurring), for powerful, recent evidence that the rule continues to influence judicial reasoning significantly. See also *Power Mobility Coal. v. Leavitt*, 404 F. Supp. 2d 190, 204–05 (D.D.C. 2005).

<sup>33</sup> See e.g., LAYCOCK, *supra* note 33, at 268–69 (setting out a tentative restatement that maintains a balancing of the respective hardships and consideration of the public interest).

<sup>34</sup> See, e.g., *Sierra Club v. U.S. Army Corps of Eng'rs*, No. Civ.A. 05-1724JAP, 2005 WL 2090028, at \*19–\*20 (D.N.J. Aug 19, 2005) (denying preliminary injunction where balance of hardships favored defendant and public interest militated against injunctive relief); *Taylor v. McCollom*, 958 P.2d 207, 213–14 (Or. Ct. App. 1998) (denying injunctive relief where the balance of hardships tipped in defendants' favor).

<sup>35</sup> ROSS, *supra* note 3, § 11.05[1] (commenting that the Fifth Circuit has not directly addressed the issue of a presumption of irreparable harm in the context of trademark litigation); see, e.g., *Abbott Labs. v. Mead Johnson & Co.*, 971 F.2d 6, 16 (7th Cir. 1992).

<sup>36</sup> See, e.g., *Starbucks Corp. v. Lundberg*, No. Civ. 02-948-HA, 2005 WL 3183858, at \*13 (D. Or. Nov. 29, 2005).

injury is loss of customers and goodwill.<sup>37</sup> Courts have stated that loss of goodwill can grow and magnify, making the harm incalculable. Such a conclusion is attractive for the sake of simplicity, but it is certainly not a hard-and-fast rule. There are numerous approaches to valuation in intellectual property; to assume that damage to goodwill as a result of consumer confusion is unquantifiable defies abundant research.<sup>38</sup> Indeed, one's reputation, once damaged, is unquestionably difficult to restore, but in libel law a preliminary injunction is an unconstitutional prior restraint on free speech.<sup>39</sup> More importantly, difficulty in quantifying damage does not an irreparable injury make: harm is not irreparable simply because damages are complicated. Valuation in trademark disputes is by no means simple, but to presume irreparable injury is to forfeit before the game has begun.

¶17 Moreover, many courts have in fact issued monetary damage awards in trademark disputes. The Seventh Circuit, for example, upheld a jury award of \$4.3 million for trademark infringement in a case where no injunction was issued.<sup>40</sup> The plaintiff held a trademark on a particular greeting card design that it licensed for some time to the defendant.<sup>41</sup> After the expiration of the agreement, the defendant released its own line of greeting cards that were found to infringe.<sup>42</sup> Both parties produced expert testimony on the amount of profit derived from sales of the infringing product, with estimates ranging from approximately \$5

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<sup>37</sup> See, e.g., *McDonald's Corp. v. Robertson*, 147 F.3d 1301, 1309–10 (11th Cir. 1998) (finding irreparable injury where a franchisee sold substandard meat as a genuine McDonald's burger); *S & R Corp. v. Jiffy Lube Int'l, Inc.*, 968 F.2d 371, 378 (3d Cir. 1992) (“[T]rademark infringement amounts to irreparable injury as a matter of law.”).

<sup>38</sup> See generally MARTIN A. GLICK ET AL., *INTELLECTUAL PROPERTY DAMAGES: GUIDELINES AND ANALYSIS* (2003); GORDON V. SMITH, *TRADEMARK VALUATION* (1997) (discussing numerous valuation techniques, including market, cost, and income approaches). In fact, courts already must value harm of this sort in setting the bond amount required by Rule 65 when issuing a preliminary injunction. See FED. R. CIV. P. 65(c).

<sup>39</sup> See *Lemley & Volokh*, *supra* note 23, at 204. To equate consumer confusion with damage to reputation, as many do, see, e.g., *Papa John's Int'l, Inc. v. Specktaclular Pizza, Inc.*, No. Civ.A. 305CV515H, 2005 WL 3132337, at \*4 (W.D. Ky. Nov. 21, 2005) (noting that infringement threatens a mark holder's reputation and constitutes irreparable injury), would open up a host of relevant constitutional challenges that are beyond the scope of this iBrief.

<sup>40</sup> *Roulo v. Russ Berrie & Co., Inc.*, 886 F.2d 931, 941 (7th Cir. 1989).

<sup>41</sup> *Id.* at 934.

<sup>42</sup> *Id.* at 935.

million to \$40,000, and the jury, free to disregard all such calculations, found relief in the amount of \$4.3 million.<sup>43</sup>

¶18 No one contends that the jury process is error-proof, but it is the same process taken in other substantive areas of law.<sup>44</sup> If one goal of trademark law is deterrence of infringement, there remains no clear reason to deny the purposeful effects of sizeable jury awards. Courts routinely deny injunctions in real and personal property law, requiring injured parties be content with monetary relief.<sup>45</sup> Thus, there exists good reason to believe that not all injuries occasioned by trademark infringement are *per se* irreparable—the presumption of irreparable harm throughout the circuits represents perhaps a lack of understanding of or an unwillingness to engage in traditional or experimental methods of valuation.

¶19 A more persuasive argument for the presumption of irreparable harm focuses on the underlying theory of trademark law and suggests that the harm is to the public rather than the mark holder. Modern trademark law stems from the common law tort of deceit.<sup>46</sup> The real purpose of a trademark is not to show that a particular product is made by XYZ simply for the sake of showing source. Rather, the aim is to provide consistency for the consumer who has previously purchased and been satisfied by a product bearing the mark XYZ.<sup>47</sup> When another firm labels its product as XYZ, the real damage is to the consumer, who reasonably expects that this second product will be of the same quality and from the same source as the first. No amount of money paid to the real XYZ can undo such damage to the customer, and, hence, there is irreparable injury.

¶20 There are, however, three key reasons why this argument does not support a presumption of irreparable harm. First, to succeed in an infringement claim, the mark holder need only prove a likelihood of confusion.<sup>48</sup> The mere possibility of confusion does not justify a

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<sup>43</sup> *Id.* at 941.

<sup>44</sup> See James Thompson, Note, *Permanent Injunctions in Copyright Infringement: Moral and Economic Justifications for Balancing Individual Rights Instead of Following Harsh Rules*, 7 S. CAL. INTERDISC. L.J. 477, 494 (1998).

<sup>45</sup> See 42 AM. JUR. 2D *Injunctions* § 109 (2004) (“Equity has, in most cases, no jurisdiction over simple acts of trespass.”) (footnote omitted).

<sup>46</sup> Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 819 (1926).

<sup>47</sup> *Cf. id.* at 818.

<sup>48</sup> *E.g.*, *Savin Corp. v. Savin Group*, 391 F.3d 439, 459 (2d Cir. 2004) (“[I]t is black letter law that actual confusion need not be shown to prevail under the Lanham Act, since actual confusion is very difficult to prove and the Act

presumption of irreparable harm that procedurally encourages the court to forego analysis of the actual damage. Second, consumer confusion may not irreparably harm anyone. If an infringing firm is in fact making a product of the same quality and function as the product whose mark it infringes, the consumer is not harmed at all. In such a case there is certainly injury to the mark holder via loss of profit, but this is compensable by damages and is therefore by definition reparable. A trademark does not bestow a property right on its holder.<sup>49</sup> The modern trend of “proptertizing” trademarks, as Professor Lemley writes, is a marked departure from the law’s consumer protection underpinnings.<sup>50</sup> Third, and most importantly, the plaintiff mark holder is not the irreparably injured party under this analysis. While the confused consumer lacks the standing to make a claim against an infringer,<sup>51</sup> the legislature’s determination to withhold standing does not lead naturally to the conclusion that the mark holder adequately represents her interests. It would be odd and unfair for the court to presume a particular kind of harm to an abstract party not presently before the court.

¶21 The irreparable harm requirement is not the only component of the four-factor test that has been undermined in trademark law. Although the circuits routinely state the need to balance the hardships to each party caused by the issuance or denial of an injunction,<sup>52</sup> the actual work various courts do to balance the equities is dubious at best.

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requires only a likelihood of confusion as to source.”) (quoting *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 875 (2d Cir. 1986)).

<sup>49</sup> See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 157 (1989) (“The law of unfair competition has its roots in the common-law tort of deceit: its general concern is with protecting *consumers* from confusion as to source. While that concern may result in the creation of ‘quasi-property rights’ in communicative symbols, the focus is on the protection of consumers, not the protection of producers as an incentive to product innovation.”).

<sup>50</sup> Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1694–97 (1999); see also Rochelle Cooper Dreyfuss, *We Are Symbols and Inhabit Symbols, So Should We Be Paying Rent? Deconstructing the Lanham Act and Rights of Publicity*, 20 COLUM. J.L. & ARTS 123, 128 (1996).

<sup>51</sup> Mark A. Kahn, *May the Best Merchandise Win: The Law of Non-Trademark Uses of Sports Logos*, 14 MARQ. SPORTS L.J. 283, 289 (2004). A consumer may, however, bring a claim under 15 U.S.C. § 1125(a) (2000), albeit not for infringement.

<sup>52</sup> See, e.g., *Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 537 (2d Cir. 2005); *Citizens Fin. Group, Inc. v. Citizens Nat. Bank of Evans City*, 383 F.3d 110, 126 (3d Cir. 2004); *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1016 n.5 (9th Cir. 2004); *Scotts Co. v. United Indus. Corp.*, 315 F.3d 264, 271 (4th Cir. 2002); *Cumulus Media, Inc. v. Clear*

¶22 Certainly, some courts have diligently worked through this factor. The Third Circuit, in *KOS Pharmaceuticals, Inc. v. ANDRX Corp.*,<sup>53</sup> reversed a district court's denial of a preliminary injunction in a trademark infringement dispute.<sup>54</sup> The court devoted considerable space to working through the various hardships alleged by the defendant, conducting a more thorough review while granting the injunction than did the district court that denied it.<sup>55</sup> Although ultimately deciding against the defendant, the court implicitly acknowledged that loss of market share represents a proper consideration in the balancing test; this hardship was mitigated by the fact that the preliminary injunction would only require the defendant to abandon its product name until final resolution on the merits.<sup>56</sup>

¶23 Even though the Third Circuit did not find the balance of the hardships in favor of the defendant, the consideration given to its claims does suggest that the court recognized the force and impact of equitable remedies. Unfortunately, *KOS Pharmaceuticals* does not represent the norm. First, many courts, even when reciting the need to balance the hardships, spend little or no time actually considering the impact and damage done by injunctions.<sup>57</sup> Second, and more pervasive, most courts,

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Channel Commc'ns, Inc., 304 F.3d 1167, 1170 (11th Cir. 2002); *N. Light Tech., Inc. v. N. Lights Club*, 236 F.3d 57, 60 (1st Cir. 2001); *Ford Motor Co. v. Lloyd Design Corp.*, 22 F. App'x 464, 467 (6th Cir. 2001); *Ty, Inc. v. Jones Group, Inc.*, 237 F.3d 891, 896 (7th Cir. 2001); *Hubbard Feeds, Inc. v. Animal Feed Supplement, Inc.*, 182 F.3d 598, 601 (8th Cir. 1999); *Payless Shoesource, Inc. v. Reebok Int'l Ltd.* 998 F.2d 985, 988 (Fed. Cir. 1993); *Lever Bros. Co. v. U.S.*, 877 F.2d 101, 104 (D.C. Cir. 1989); *Amoco Oil Co. v. Rainbow Snow, Inc.*, 809 F.2d 656, 661 (10th Cir. 1987).

<sup>53</sup> 369 F.3d 700 (3d Cir. 2004).

<sup>54</sup> *Id.* at 703.

<sup>55</sup> *Id.*

<sup>56</sup> *Id.* at 729.

<sup>57</sup> *See, e.g.*, *Am. Equity Mortgage, Inc. v. Vinson*, No. 4:05CV1529 RWS, 2005 WL 3372781, at \*1–\*2 (E.D. Mo. Dec. 12, 2005); *MetLife, Inc. v. Metro. Nat'l. Bank*, 388 F. Supp. 2d 223, 229 (S.D.N.Y. 2005); *Cartier, Inc. v. Symbolix, Inc.*, 386 F. Supp. 2d 354, 358 (S.D.N.Y. 2005); *Schick Mfg., Inc. v. Gillette Co.*, 372 F. Supp. 2d 273, 276 (D. Conn. 2005); *DaVinci Tech. Corp. v. Rubino*, No. Civ. 05-1561, 2005 WL 1249462, at \*9 (D. N.J. May 25, 2005) (“[T]he strong showing of irreparable injury to Plaintiff clearly outweighs any potential harm to Defendants and thus tips the equities in its favor.”); *City Bonding Co., Inc. v. Hauther*, No. 3:05CV90, 2005 WL 1159431, at \*8 (E.D. Tenn. May 17, 2005); *Abercrombie & Fitch v. Fashion Shops of Kentucky, Inc.*, 363 F. Supp. 2d 952, 958 (S.D. Ohio 2005); *Perfection Fence Corp. v. Fiber Composites, LLC*, No. Civ.A. 04-12094-GAO, 2005 WL 353017, at \*2 (D. Mass. Feb. 10, 2005); *Connelly v. ValueVision Media, Inc.*, 393 F. Supp. 2d 767, 777 (D. Minn. 2005)

including the Third Circuit, balance the hardships on a sliding scale that holds “[t]he more likely the plaintiff is to win, the less heavily need the balance of harms to weigh in his favor.”<sup>58</sup>

¶24 This sliding-scale analysis, when used aggressively, rips the heart out of the balancing inquiry in the traditional four-factor test for injunctions. There are far too many examples of this unfortunate doctrine to even begin assembling a comprehensive list, although a great number offer potent illustrations. In *Resource Lenders, Inc. v. Source Solutions, Inc.*, the District Court for the Eastern District of California explained that “once likelihood of confusion is established, it is usually presumed that the Plaintiff will suffer irreparable harm and that the balance of hardships tips in Plaintiff’s favor.”<sup>59</sup> The court summarized the parties’ arguments on this point in a meager paragraph and did not analyze them.<sup>60</sup> To conduct a balancing test without balancing anything is laughable—yet this is precisely the approach adopted by the court.

¶25 In fact, *Resource Lenders* and other cases go even further. Most district courts have also collapsed the public interest factor into the likelihood of success factor.<sup>61</sup> The leading case on this point comes from the Third Circuit, stating that in the context of trademark litigation, public interest is just “a synonym for the right of the public not to be deceived or confused.”<sup>62</sup> Following this logic, *Resource Lenders* addressed the fourth factor of the injunction test in a single sentence: “Here, because a likelihood of confusion was demonstrated, the public interest would be served by issuance of an injunction.”<sup>63</sup> For a law with the purpose of protecting the public, the actual consideration of the public’s interest—and not just a conclusory statement thereon—would seem necessary.

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(“[B]ecause Plaintiffs have demonstrated a likelihood of confusion in the marketplace, the balance of harms tips in their favor.”).

<sup>58</sup> *KOS Pharms.*, 369 F.3d at 729 (quoting *Novartis Consumer Health, Inc. v. Johnson & Johnson-Merck Consumer Pharms. Co.*, 290 F.3d 578, 597 (3d Cir. 2002); see also *Manpower, Inc. v. Manson*, 405 F. Supp. 2d 959 (E.D. Wis. 2005).

<sup>59</sup> 404 F. Supp. 2d 1232, 1249 (E.D. Cal. 2005).

<sup>60</sup> *Id.*

<sup>61</sup> ROSS, *supra* note 3, § 11.05[3][c].

<sup>62</sup> *Optician’s Ass’n of Am. v. Indep. Opticians of Am.*, 920 F.2d 187, 197 (3d Cir. 1990).

<sup>63</sup> 404 F. Supp. 2d at 1250; see also *Connelly v. ValueVision Media, Inc.*, 393 F. Supp. 2d 767, 777 (D. Minn. 2005) (“The Court finds that since it has already determined that Plaintiffs have demonstrated a likelihood of success on the merits of its trademark infringement claim, the public interest is best served by issuing a preliminary injunction. Infringement of a trademark is inherently contrary to the public interest.”).

¶26 In sum, injunctions in trademark disputes are guided by the traditional four-factor test (likelihood of success; irreparable harm; balance of hardships; and public interest) as modified in the following ways:

1. Irreparable harm is presumed;
2. A plaintiff need not show that the balance of the hardships tips significantly in its favor where it has demonstrated a likelihood of success on the merits; and
3. The public interest is served by injunctions where the plaintiff has demonstrated a likelihood of success on the merits.

¶27 As such, the four-factor test, which was developed to provide ex ante protections against the abuses associated with over-issuance of injunctions, now turns almost entirely on one factor: the likelihood of success on the merits.

### *C. Why this matters—a hypothetical*

¶28 Imagine that Bi-Goxx Pharmaceuticals has committed the majority of its resources to researching a rare form of skin cancer and that there are reasonable indications that it is close to a profound breakthrough treatment. The research, however, is time-sensitive, and any delay could derail the project. During this time, Bi-Goxx is sued under 15 U.S.C. § 1114(1) for trademark infringement by Big-Oxx Chemical Co., a company that develops and manufactures cleaning chemicals. Big-Oxx has a registered trademark in its logo, which is its name in a sans-serif, italicized, blue font presented in a green oval. Bi-Goxx, which came into existence after Big-Oxx, uses a remarkably similar logo, the only true differences being capitalization, the placement of the hyphen, and minor differences in color tone.<sup>64</sup> The two companies share some, but few, purchasers, both advertise extensively on the internet,<sup>65</sup> and their print advertisements have both appeared in certain magazines. Big-Oxx became aware of Bi-Goxx when one of its long time

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<sup>64</sup> See *GoTo.com, Inc. v. Walt Disney Comp.*, 202 F.3d 1199, 1205 (9th Cir. 2000) (holding that plaintiff's "GoTo" logo was infringed by defendant's "Go Network" logo, where both consisted of white capital letters in similar typeface on a green circle).

<sup>65</sup> See *Brookfield Commc'ns, Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036, 1057 (9th Cir. 1999) (finding that use of internet for marketing and advertisement is "a factor that courts have consistently recognized as exacerbating the likelihood of confusion").

customers expressed confusion over a Bi-Goxx ad on cancer research that the purchaser mistook for a Big-Oxx ad.<sup>66</sup>

¶29 Bi-Goxx is concerned that its present financial condition cannot support prolonged litigation, but Big-Oxx has refused to settle out of court. Because of its excitement about what appears to be an imminent breakthrough on skin cancer, Bi-Goxx recently spent considerable funds on developing marketing materials, all of which use the allegedly infringing logo. Bi-Goxx cannot afford to hire an artist to create a new logo, to reproduce these materials, to develop a new website, and continue to fund, uninterrupted, the skin cancer research. Big-Oxx, however, has moved the court for a preliminary order enjoining Bi-Goxx from using the allegedly infringing logo. Although it can prove only one instance of actual consumer confusion and cannot show bad intent on the part of Bi-Goxx, Big-Oxx can probably show a likelihood of success on the merits of its infringement claim or can at least raise sufficiently serious questions going to the merits.

¶30 Under the traditional principles of equity, no injunction would issue. Bi-Goxx will argue that the issuance of an injunction imposes significant irreparable harm because the financial burden of altering its marketing will likely derail its time-sensitive cancer research. The hardship suffered by Big-Oxx in the absence of an injunction, on the other hand, is not as serious. Big-Oxx is unable to prove any monetary damage as a result of the similar logos; it can only point to a nebulous potential for consumer confusion and one slightly confused customer. Finally, Bi-Goxx will invoke the public interest in cancer research that will be impeded by the injunction.

¶31 In the present world where the court does not implement the traditional four-factor test, however, an injunction will issue upon a mere showing of a likelihood of confusion. Bi-Goxx will go bankrupt, and the breakthrough on skin cancer will be significantly delayed or even lost.

¶32 The skeptical reader may at this point note two things: (1) courts have not eliminated the four-factor test entirely, and (2) this is an extreme example. Both are true. Nevertheless, one must remember that while courts presently do at least mention the four-factor test, there is serious concern that the law could change.<sup>67</sup> Secondly, although this is

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<sup>66</sup> See *AutoZone, Inc. v. Tandy Corp.*, 373 F.3d 786, 798 (6th Cir. 2004) (“Evidence of actual confusion is undoubtedly the best evidence of likelihood of confusion.”).

<sup>67</sup> Cf. *eBay, Inc. v. MercExchange, L.L.C.*, No. 05-130, *cert. granted* (U.S. Nov. 28, 2005) (presenting question of whether injunctions are the “general rule” in patent law); see generally Donna Higgins, *Supreme Court to hear eBay Patent*

extreme, it is not implausible, and the principles behind remedies cannot be suited only to the lowest common denominator. In fact, we have such rules to ensure protection at the margins.

¶33 The purpose of presumptions is to put a thumb on the scale of judicial analysis—to direct courts towards predetermined conclusions.<sup>68</sup> Presumptions make no sense in equity jurisprudence. Courts of equity (and, hence, equitable remedies) arose when courts of law were unable to effect complete justice because they were bound by rigid rules.<sup>69</sup> In other words, equity exists to provide courts the freedom to operate outside inflexible boxes. The presumptions in trademark law regarding injunctions reconstruct the inflexible boxes equity seeks to avoid. In fact, the presumptions regarding the balance of harms and the public interest are destabilized by the meaning of the word equity itself. The word derives from the Latin *aequitas*, which, in its most basic form, means universality or uniformity.<sup>70</sup> To issue an injunction without considering its effects broadly, therefore, is a dynamic departure from not only the

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Case, FINDLAW, Dec. 6, 2005,

<http://news.lp.findlaw.com/andrews/bt/slb/20051206/20051206ebay.html>.

<sup>68</sup> Cf. Joel Alan Fischman, *Winstead v. Derreberry: Stepchildren and the Presumption of Dependence under the North Carolina Workers' Compensation Act*, 64 N.C. L. Rev. 1548, 1563 (1986) (“The very purpose of a presumption is to alleviate the need for a detailed consideration of the circumstances of each case.”). Presumptions are useful in situations where evidence is difficult or impossible to gather. In securities law, where a Rule 10b-5 action is predicated on a defendant’s *omission* of a material fact, the Court has noted that it would be impractical to require the plaintiff to prove reliance on something that was never said. Such reliance is, therefore, presumed. See *Affiliated Ute Citizens v. United States*, 406 U.S. 128, 153–54 (1972); *Shores v. Sklar*, 647 F.2d 462, 468 (5th Cir. 1983). Because there is no reason why irreparable injury is any more difficult to prove in trademark law than in any other substantive area, there are no grounds for its presumption.

<sup>69</sup> See 27A AM. JUR. 2D *Equity* § 2 (1996). The tension between the desire for flexibility and the desire to prevent unfettered power is longstanding. Equity requires the freedom to adequately address wrongs, yet there has long been recognized a need for guidance. Consider the juxtaposition of Cicero and Justinian. Cicero believed that law need not be limited to positive enactment: “*non ergo a praetoris edicto, ut plerique nunc, neque a duodecim tabulis, ut superiores, sed penitus ex intima philosophia hauriendam iuris disciplinam . . .*” —“The discipline of law must not be gathered from the praetor’s edict, as most now think, nor from the Twelve Tables, as they used to believe, but inwardly, from our innermost philosophy.” DE LEGIBUS I.v.17, available at <http://www.thelatinlibrary.com/cicero/leg1.shtml#17>. Law, he wrote, is a *naturae vis*—a force of nature. *Id.* at I.v.19. Justinian’s *Corpus Juris Civilis*, on the other hand, is arguably an attempt to capture that *naturae vis* in a defined code.

<sup>70</sup> CHARLTON T. LEWIS, AN ELEMENTARY LATIN DICTIONARY 35 (1891).

traditional “principles of equity,”<sup>71</sup> but from the very notion of equity at all.

¶34 The nature of trademark law may necessarily result in the frequent issuance of injunctive relief. Where there is a threat of continuous harm, injunctions make sense.<sup>72</sup> Because trademark disputes often arise in such a context, injunctions seem entirely appropriate. Nevertheless, courts have long called injunctions “extraordinary remedies,”<sup>73</sup> and they have done so with purpose. “Extraordinary,” despite contemporary parlance, does not mean “great” or “amazing.” It means “unusual” or “rare.”<sup>74</sup> Thus, our judicial system has long considered injunctions “rare” remedies. To make them the axiomatic choice in trademark disputes contradicts their very nature. Even if they must represent the majority of remedies issued in trademark litigation, courts should neither abandon the four-factor test nor cripple it with unnecessary presumptions. Indeed, the example of Bi-Goxx and Big-Oxx is extreme and somewhat exaggerated. Nevertheless, the traditional four-factor test offers protection for those rare, extreme cases; we need such rules at the margins. The increased fairness in the substance of the subsequent orders will more than repay the effort spent considering each factor carefully.

## II. THE DEVIL IS IN THE DETAILS: THE EX POST PROTECTION OF RULE 65(D)

¶35 With the decline of the ex ante protections of the four-factor test, there exists great danger that injunctions are being issued both excessively and sloppily.<sup>75</sup> To combat the latter problem, appellate

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<sup>71</sup> 15 U.S.C. § 1116(a) (2000).

<sup>72</sup> See, e.g., *U.S. v. Zenon*, 711 F.2d 476 (1st Cir. 1983) (noting that an injunction is authorized to avoid a “multiplicity” of legal actions”).

<sup>73</sup> See, e.g., *Citizens Fin. Group, Inc. v. Citizens Nat. Bank of Evans City*, 383 F.3d 110, 126 (3d Cir. 2004).

<sup>74</sup> “Extraordinary” is derived from the Latin *extraordinarius*, which is *extra* (outside of) + *ordo, ordinis* (row, order, rank). In Roman law, most cases were framed by praetors, but issues of fact were decided by a *judex* or other lay person. This was ordinary jurisdiction (in *ordinem*). Eventually, there developed another form of jurisdiction, in which the praetor decided all issues of law and fact himself without adhering to the strict technical requirements. This was called extraordinary jurisdiction (*extra ordinem* because it was out of course or unusual). 1 JOHN NORTON POMEROY, *TREATISE ON EQUITY JURISPRUDENCE* 7–8 (1881).

<sup>75</sup> See, e.g., *Beacon Mut. Ins. Co. v. OneBeacon Ins. Corp.* 376 F. Supp. 2d 251, 265, 266–67 (D. R.I. 2005) (enjoining defendant “from using the OneBeacon name and lighthouse logo in Rhode Island”); *Lacey ex rel. Gaphic Commc’ns Int’l Union v. Big Impressions, Inc.*, No. 4:04CV00184SWW, 2005 WL

courts must police injunctions more zealously via the ex post protections of Rule 65(d) of the Federal Rules of Civil Procedure.

¶36 Rule 65 in general covers very basic procedural requirements of issuing injunctions in the federal courts. Specifically, Rule 65(d) provides:

Every order granting an injunction and every restraining order shall set forth the reasons for its issuance; *shall be specific in terms*; *shall describe in reasonable detail*, and not by reference to the complaint or other document, *the act or acts sought to be restrained*. . . .<sup>76</sup>

¶37 The rule thus contains two key elements pertinent to this discussion: (1) the court must give a brief rationale for why the injunction is being imposed; and (2) the court must specifically and in reasonable detail describe what is being enjoined. Because the law of injunctions has such a full, complicated history, the drafters of the Federal Rules opted to depend almost entirely on the traditional principles of equity, and Rule 65(d) is no exception to this general approach.<sup>77</sup> Prior to the enactment of the federal rules, however, numerous injunctions were issued that were too vague to be comprehensible.<sup>78</sup> It is exactly this sort of imprecision that Rule 65(d) seeks to address: “The drafting standard established by Rule 65(d) is that an ordinary person reading the court’s order should be able to ascertain from the document itself exactly what conduct is proscribed.”<sup>79</sup>

¶38 The Supreme Court has elaborated on the importance of specificity in injunctions. In *International Longshoremen’s Ass’n. v. Philadelphia Marine Trade Ass’n.*,<sup>80</sup> the court invalidated an order under Rule 65(d), remarking, “The most fundamental postulates of our legal order forbid the imposition of a penalty for disobeying a command that defies comprehension.”<sup>81</sup> More recently, the Court explained that “the specificity provisions of Rule 65(d) are no mere technical requirements”

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1773679, at \*4 (E.D. Ark. Jul. 7, 2005) (stating only, “Defendant is enjoined from any further misuse of plaintiff’s trademark”); *Harvic Intern. Ltd. v. Galaxy Fashions, Inc.*, No. 03CIV3429RLE, 2005 WL 1338035, at \*3 (S.D.N.Y. Jun. 7, 2005) (enjoining defendant from using “any colorable imitation” of plaintiff’s mark).

<sup>76</sup> Fed. R. Civ. P. 65(d) (emphasis added).

<sup>77</sup> 11A CHARLES ALAN WRIGHT, ARTHUR R. MILLER & MARY KAY KANE, FEDERAL PRACTICE AND PROCEDURE § 2941 (2d ed. 1987 & Supp. 2005).

<sup>78</sup> See generally Note and Comment, *Nebulous Injunctions*, 23 MICH. L. REV. 53 (1924); Note and Comment, *Nebulous Injunctions*, 19 MICH. L. REV. 83 (1920).

<sup>79</sup> WRIGHT, *supra* note 79, § 2955.

<sup>80</sup> 389 U.S. 64 (1967).

<sup>81</sup> *Id.* at 76.

but rather prevent unfairness in the imposition of orders too vague to be followed.<sup>82</sup>

¶39 The proper use of Rule 65(d) is beneficial to both trademark holders and alleged trademark infringers. As for the former, courts can use the rule to invalidate vague and unspecific portions of injunctive orders that provide infringers with a loophole. The Second Circuit recently did just that in *Weight Watchers International v. Luigino's Inc.*<sup>83</sup> Weight Watchers registered the term “Points” in connection with a particular weight loss program.<sup>84</sup> The defendant manufactured frozen food, and on its packaging specified how many points its meals would be worth under the Weight Watchers system.<sup>85</sup> The defendant did not, however, obtain permission to do so.<sup>86</sup> The district court found that the defendant’s packaging was likely to confuse customers, who would believe “that Weight Watchers had assigned the [points] to or otherwise endorsed . . . the products.”<sup>87</sup> The court therefore enjoined the defendant from using the packaging but also included an ill-defined statement that the defendant could “convey accurate factual information concerning the [point] values of products” so long as it stated that the defendant itself had “calculated such values.”<sup>88</sup> Defendant modified its packaging by placing a small disclaimer that stated, “[t]he number of winning points provided here has been calculated by Michelina’s . . . .”<sup>89</sup> Weight Watchers moved to modify the original injunction to cover the new packaging, but the district court declined to do so.<sup>90</sup> On appeal, the Second Circuit found no need to modify the original injunction to include the new packaging because the escape clause provided for by the district court was too vague to withstand Rule 65(d).<sup>91</sup> The provision of the injunction did not enjoin any action and was “entirely hypothetical.”<sup>92</sup>

¶40 Courts have also used Rule 65(d) to protect alleged infringers from overly broad<sup>93</sup> and insufficiently specific injunctions. For example, the Eleventh Circuit invalidated an order that enjoined “using trade dress

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<sup>82</sup> *Schmidt v. Lessard*, 414 U.S. 473, 476 (1974).

<sup>83</sup> *Weight Watchers Int’l, Inc. v. Luigino’s, Inc.*, 423 F.3d 137 (2d Cir. 2005).

<sup>84</sup> *Id.* at 139.

<sup>85</sup> *Id.*

<sup>86</sup> *Id.*

<sup>87</sup> *Id.*

<sup>88</sup> *Id.*

<sup>89</sup> *Id.* at 140.

<sup>90</sup> *Id.* at 141.

<sup>91</sup> *Id.* at 142.

<sup>92</sup> *Id.*

<sup>93</sup> *See, e.g., Allard Enters., Inc. v. Advanced Programming Res., Inc.*, 146 F.3d 350 (6th Cir. 1998).

for bank check products which [sic] is confusingly similar to the trade dress or overall appearance of plaintiff's . . . products or is likely to cause confusion therewith . . . ."<sup>94</sup> The use of the term "confusingly similar" offered no guidance about the actual acts the defendant needed to refrain from doing.<sup>95</sup>

¶41 Unfortunately, the Eleventh Circuit later departed from its sound methodology. In 2001, the court upheld an injunctive order against a challenge under Rule 65(d) that enjoined defendant from "using any logo, trade name, trademark or servicemark which [sic] may be calculated to represent falsely that the services or products of defendants are affiliated, connected or associated with [plaintiff]; . . . otherwise infringing on the 'Coolmail' mark; [and] unfairly competing with Planetary Motion . . . ."<sup>96</sup> The court justified its conclusion by noting that it would not apply Rule 65(d) "rigidly." Rather, it would "determine the propriety of an injunctive order by inquiring into whether the parties subject thereto understand their obligations under the order."<sup>97</sup> Nevertheless, the court gave no indication of how it planned to conduct such an inquiry, and in fact there is no reasonable way to conduct it. If the inquiry is based on purely the subjective understanding of the parties, the defendant's challenge to the specificity of the order powerfully suggests that it fails to comprehend its import. Moreover, even if based on an objective reading, this order should fail; for the court itself was not quite sure: defendant "likely will not violate the injunction if it completely ceases the use of 'Coolmail' in connection with e-mail services or markets related thereto."<sup>98</sup> To enjoin a defendant from "otherwise infringing" a mark or "unfairly competing" with the plaintiff is by no means a reasonably detailed description of the acts sought to be restrained by the injunction. Under any sensible reading of the rule, this order should have been vacated.

¶42 The Eleventh Circuit is not alone, however, in the assault on the vitality of Rule 65(d) in trademark disputes. The Seventh Circuit has complained that "[t]here is a limit to what words can convey," and Rule 65(d) "does not require the impossible."<sup>99</sup> Using this rhetorically appealing but substantively bankrupt logic, the court upheld an injunction that prohibited the defendant from using any "colorable

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<sup>94</sup> John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 984 (11th Cir. 1983).

<sup>95</sup> *Id.* at 985.

<sup>96</sup> Planetary Motion, Inc. v. Techsplosion, Inc., 261 F.3d 1188, 1205 n.31 (11th Cir. 2001).

<sup>97</sup> *Id.* at 1203.

<sup>98</sup> *Id.* at 1205 (emphasis added).

<sup>99</sup> Scandia Down Corp. v. Euroquilt, Inc., 772 F.2d 1423, 1431 (7th Cir. 1985).

imitation” of plaintiff’s registered logo.<sup>100</sup> Although the court claimed that defendant failed to provide “a formulation that would have given it better notice”<sup>101</sup> of what was being enjoined, Rule 65(d) imposes no requirement on the defendant to do the work of the district courts.<sup>102</sup> A defendant appeals under Rule 65(d) because it fails to comprehend from the order what it can and cannot do; to require the defendant to then explain the very thing it cannot ascertain is ludicrous. The logo at issue in this case involved a goose and a particular style of typeface.<sup>103</sup> Perhaps the district court’s order intended to enjoin the defendant from using any logo with a goose, or perhaps any bird, or maybe only waterfowl, or possibly it really turns on the bird’s posture. Indeed, there is no way to know because the term “colorable imitation” is an empty phrase that gives no meaningful guidance to an enjoined party. While Judge Easterbrook waxed poetic about the inability of words to describe the “variousness of experience,”<sup>104</sup> the defendant simply wanted to know what sorts of birds it could and could not use in its everyday business. While the defendant in this case may not have offered (and was not required by the rule to offer) any alternative formulations, specifying what sorts of birds and bird-stances were off-limits is certainly not the “prolix imprecise standards”<sup>105</sup> the court sought to avoid.

¶43 No one is suggesting that Rule 65(d) requires courts to lay out with perfect precision every conceivable action from which the defendant must abstain. Nevertheless, with well over half a million words in the English language, it is ridiculous to think our judges cannot do better than “colorable imitation.”

#### CONCLUSION

¶44 Whether it is the applicability of tax principles to e-commerce<sup>106</sup> or of the National Labor Relations Act to employee blogging,<sup>107</sup> the law must adapt as the world changes. Change, however, cannot justify the haphazard disregard of the traditional principles of equity. Injunctions have gone from one of the most extraordinary remedies in the American

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<sup>100</sup> *Id.*

<sup>101</sup> *Id.* at 1432.

<sup>102</sup> *See* FED. R. CIV. P. 65.

<sup>103</sup> *Scandia Down*, 772 F.2d at 1425.

<sup>104</sup> *Id.* at 1432.

<sup>105</sup> *Id.*

<sup>106</sup> *See* Walter J. Baudier, *Internet Sales Taxes from Borders to Amazon: How Long Before All of Your Purchases Are Taxed?* 2006 DUKE L. & TECH. REV. 0005 (2006).

<sup>107</sup> *See* Katherine Scott, *When is Employee Blogging Protected by Section 7 of the NLRA?*, 2006 DUKE L. & TECH. REV. (forthcoming May 2006).

judicial system with strict specificity requirements to the default order in trademark litigation where courts can essentially enjoin defendants from activities as broad and nondescript as “infringing.” The slow and regretful evisceration of the traditional ex ante protections afforded by the four-factor injunction test has rendered injunctive relief almost automatic in trademark disputes, and the subsequent over-issuance of injunctions has led to a decline in the specificity of the orders.

¶45 Injunctions will likely remain the typical remedy for trademark disputes, but for the very reason that there will be so many of them, judges should exercise the utmost care. A thoughtful consideration of all four traditional factors should lead judges to compose more equitable orders, which in turn should make them more specific and helpful. Concomitantly, appellate courts should more vigilantly enforce the ex post protections of Rule 65(d) to ensure clarity in the myriad injunctive orders issued in trademark litigation. Procedure profoundly affects substance; we must not let unnecessary presumptions erode much needed precision.