



Preliminary Injunction Granted Due to Weakened Invalidity Defense in Light of Inter Partes Review Decision

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The court considered four factors to determine whether the “drastic and extraordinary remedy” of a preliminary injunction was warranted. Beginning with the likelihood of success on the merits, the court only had to consider invalidity defenses. The defendants raised the obviousness ground that the PTAB had—for reasons of redundancy—declined to institute. The plaintiff’s challenges to the availability of this obviousness defense were unpersuasive to the court. Under recent Federal Circuit precedent, the defendants were not statutorily barred by estoppel under 35 U.S.C. § 315(e). Furthermore, the defendants were not precluded by common law issue preclusion. However, the court still found that the defendants were unlikely to prevail on the obviousness defense. The court also found that the defendants’ enablement defense was unlikely to prevail.

For the irreparable harm factor, the court found that the plaintiff had shown a real risk of being harmed by the defendants’ infringing technology if they were allowed to “capture and define” the developing and critically poised market for the technology at issue. The court then found that the balance of hardships factor weighed in favor of an injunction, and defendants’ alleged lost opportunities were the “price” of their conduct.

Finally, the court found that the public interest would be disserved without an injunction because laboratories, which grew to rely on potentially infringing technology, could end up facing liability of infringement.

Illumina, Inc. v. Qiagen, N.V., No. C 16-02788 WHA, 2016 WL 4719269 (N.D. Cal. Sept. 9, 2016) (Alsup, J.).

Categories

Inter Partes Review

Northern District of California

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