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Court Denies Preliminary Injunction in Light of Pending IPR of Similar Patent Claims

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The court addressed four factors in determining whether injunctive relief was appropriate: 1) whether the plaintiff is likely to succeed on the merits, 2) whether he is likely to suffer irreparable harm in the absence of preliminary relief, 3) whether the balance of equities tips in his favor, and 4) whether an injunction is in the public interest.

With regard to the first factor, the court found that the plaintiff had not shown a likelihood of success on the merits. In reaching that conclusion, the court was persuaded by the defendant's argument that "pending *inter partes* review (IPR) proceedings on claims in a related patent similar to those asserted in this case raise a substantial question about the validity of certain of the asserted claims." In making their argument, defendants provided the court with claim charts detailing similarities between the asserted claims and analogous claims in a related patent involved in an IPR proceeding, as well as IPR statistics showing that "an overwhelming percentage of IPR petitions are accepted and result in cancellation or amendment" of claims. Because the plaintiff was not likely to succeed on the merits with regard to validity, the court did not consider the parties' infringement arguments.

Regarding the other preliminary injunction factors, the court declined to address whether the plaintiff is likely to suffer irreparable harm, explaining that the plaintiff is not likely to succeed on the merits and "thus the Court may deny the motion on this finding alone." The court found that the balance of hardships tips in favor of denying an injunction because, "[w]hile Plaintiff may suffer by having Defendants continue as a market competitor, a complete ban of Defendants' product is much more likely to result in 'devastating' harm." Finally, the court held that denying an injunction was in the public's interest. "While Plaintiff is correct that a strong patent system—and its enforcement—is in the public interest . . . the public interest would

be better served by increased competition between two competitors concerning a product that may not only be found to be noninfringing, but also noninfringing an invalid patent."

DNA Genotek Inc. v. Spectrum Sltns. LLC, 16-cv-1544 (S.D. Cal. Oct. 6, 2016) (Sammartino, J.).

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