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A Response

Switching to Prophylactic Injunctions

Tracy A. Thomas*

In his important new article, *Injunctions as More (or Less) Than ‘Off Switches’: Patent-Infringement Injunctions’ Scope*, John Golden proves my thesis: prophylactic injunctions are, and should be, common, normal types of equitable relief.¹ His careful and detailed analysis of the type and frequency of injunctions issued in patent infringement cases exposes the myth that prophylaxis is illegitimate. Steeped in details of patent law, Golden’s work nevertheless contributes significantly to the broader transsubstantive questions of the metes and bounds of equitable relief. His work documents with factual detail and normative argument what I have previously argued: that “prophylactic relief develops almost instinctively from lawyers and jurists seeking remedial alternatives to empty commands simply to stop the behavior.”² Golden builds a persuasive argument for abandoning the simple “off switch” injunctions ordering the cessation of infringement for more specifically tailored injunctions of prophylactic relief.

In his article, Professor Golden provides valuable insight into what is really happening in the field of patent injunctions. His empirical study collects all injunctions issued by U.S. district courts in patent infringement cases in 2010.³ He finds that the majority of patent injunctions are preventive injunctions ordering the defendant to stop the infringement. He organizes these into three sub-types based on scope: prohibitions on the exact process, the exact process plus variations, and any process that violates the patent. Golden finds a prevalence of “obey-the-law” injunctions prohibited by Federal Rule of Civil Procedure 65(d) and an absence of reparative injunctions, finding only one. One-third of the injunctions he classifies as “specially tailored” prophylactic injunctions, differentiated into four subcategories. He offers mathematical formulas and an alternative taxonomy that may be unnecessarily complex and risk obscuring the flexibility of equity.⁴ Ultimately, though, these classifications advance the thinking about the optimal equitable relief for patent infringement.

Golden’s research provides good evidence to counter the conventional wisdom that prophylactic injunctions are suspect. Prophylactic injunctions are defined as injunctions that address the facilitators or causes of continued harm by ordering additional precautions targeting

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¹ Tracy A. Thomas, *The Continued Vitality of Prophylactic Relief*, 27 REV. LIT. 99 (2007); Tracy A. Thomas, *The Prophylactic Remedy: Normative Principles and Definitional Parameters of Broad Injunctive Relief*, 52 BUFFALO L. REV. 301 (2004).

² Thomas, *Continued Vitality*, *supra* note 1, at 104.

³ John M. Golden, *Injunctions as More (or Less) Than ‘Off Switches’: Patent-Infringement Injunctions’ Scope*, ___ TEX. L. REV. *19 (2012).

⁴ Similarly, Judge Richard Posner has used mathematical formulas to explain the proper operation of equity. *See American Hospital Supply Corp. v. Hospital Products Ltd.*, 780 F.2d 589 (7th Cir. 1986) (developing mathematical formula for assessing whether preliminary injunction should issue).

that collateral behavior.⁵ At times, this relief has been depicted as illegitimate and overly broad relief that reaches beyond the scope of the harm.⁶ It carries a negative image of judicial activism extending beyond the contours of the legal right.⁷ Nevertheless, there has been a begrudging acceptance that sometimes prophylactic relief is a necessary and effective remedy.⁸

I have argued elsewhere that prophylactic injunctions have gotten a bad rap.⁹ Contrary to the conventional wisdom, prophylaxis is not inappropriate judicial activism, but rather is the regular equitable discretion used by courts to flexibly fashion practical relief.¹⁰ Such injunctions do not overreach, but instead precisely target the plaintiff's rightful position by restricting ancillary, causative conduct that is necessary for protecting that position.¹¹ Prophylactic injunctions are prevalent in a variety of subject areas.¹² They are seen in public law cases of school desegregation, prison reform, and sexual harassment.¹³ They are also seen in private law cases of securities regulation, antitrust, and as Golden demonstrates, patent infringement.¹⁴ Prophylactic injunctions offer an immensely practical remedy that makes the abstract legal right tangible with specific, clear commands that circumscribe defendants' conduct assisting compliance and enforcement.

⁵ Thomas, *The Prophylactic Remedy*, *supra* note 1, at 314-15. They are similar to prophylaxis in constitutional law, criminal procedure, and Section 5 legislation designed to be extraprotective of rights. See Tracy A. Thomas, *Understanding Prophylactic Remedies Through the Looking Glass of Bush v. Gore*, 11 W&M BILL RGTS. J. 343 (2002); David A. Strauss, *The Ubiquity of Prophylactic Rules*, 55 U. CHI. L. REV. 190, 195 (1988).

⁶ See, e.g., *Hutto v. Finney*, 437 U.S. 678, 711-12 (1978) (Rehnquist, J., dissenting).

⁷ Thomas, *The Prophylactic Remedy*, *supra* note 1, at 303; Thomas, *Continued Vitality*, *supra* note 1, 99-100; Thomas, *Understanding*, *supra* note 5, at 363-64.

⁸ See *Madsen v. Women's Health Center, Inc.*, 512 U.S. 753 (1994) (prophylactic injunction necessary when prior less restrictive preventive injunction in abortion protest case failed to prevent harm); *Schenk v. Pro-Choice Network of W.N.Y.*, 519 U.S. 357, 382 (1997) (describing prophylactic measures as necessary to prevent violent, assaultive harm involved in abortion protests); *Hutto*, 437 U.S. at 678 (restricting time in punitive isolation as facilitator of unconstitutional conditions where defendant prison had ample opportunity to remedy the conditions and comply with the court's earlier less restrictive order).

⁹ Thomas, *The Prophylactic Remedy*, *supra* note 1, at 305; Thomas, *Continued Vitality*, *supra* note 1, at 100.

¹⁰ Thomas, *The Prophylactic Remedy*, *supra* note 1, at 305. "The essence of equity jurisdiction has been the power of the Chancellor to do equity and to mould each decree to the necessities of the particular case. Flexibility rather than rigidity has distinguished it. The regularities of mercy and practicality have made equity the instrument for nice adjustment and reconciliation between the public interest and private needs as well as between competing private claims." *Hecht Co. v. Bowles*, 321 U.S. 321 (1944).

¹¹ See Thomas, *The Prophylactic Remedy*, *supra* note 1, at 305.

¹² DOUGLAS LAYCOCK, *MODERN AMERICAN REMEDIES* 288 (4th ed. 2010) ("Examples [of prophylactic relief] turn up everywhere, some controversial, some not.").

¹³ See, e.g., *Swann v. Charlotte-Mecklenburg Board of Educ.*, 402 U.S. 1, 22-31 (1971); *Women Prisoners of the D.C. Department of Corrections v. District of Columbia*, 877 F. Supp. 634 (D.D.C. 1994), *modified*, 899 F.Supp. 659 (D.D.C. 1995), *vacated in part*, 93 F.3d 910 (D.C. Cir. 1996) (ordering prophylactic measures of monitoring, training, complaint systems, and expert consultation to prevent future constitutional harms to female inmates); *Bundy v. Jackson*, 641 F.2d 934, 946-48 (D.C. Cir. 1981) (ordering institution to adopt procedures for investigating and adjudicating sexual harassment complaints); *Lynch v. City of Des Moines*, 454 N.W.2d 827, 829 (Iowa 1990) (affirming injunction ordering sexual harassment education and training).

¹⁴ See, e.g., *United States v. Microsoft Corp.*, 231 F.Supp. 2d 144, 164 (2002) (imposing prophylactic measures to prevent antitrust monopoly); *Sec. & Exch. Comm'n v. Capital Gains Research Bureau, Inc.*, 375 U.S. 180, 181 (1963) (ordering advisor to disclose to clients his own personal securities dealings in order to prevent continued fraud); *Federal Trade Comm'n v. Nat'l Lead Co.*, 352 U.S. 419 (1957) (prohibiting all zone-delivered pricing as prophylactic measure to prevent illegal price fixing); see George W. Dent Jr., *Ancillary Relief in Federal Securities Law: A Study in Federal Remedies*, 67 MINN. L. REV. 865 (1983) (identifying prophylactic orders in securities cases to include prohibiting violator from acting as officer of any public company, adding reporting requirements, and appointing an independent majority to a corporate board).

Golden's work is significant because it offers a window into both the reality and the ideal. He shows that prophylactic injunctions are routine remedies ordered by district courts. And he takes the normative step of arguing that prophylactic or specially tailored injunctions should be the optimal injunctive remedy because of their tremendous potential for tailoring relief to the equities and efficiencies of a given case. This research makes a persuasive case for shifting our assumptions about prophylactic relief from that of distaste to one of preference.

I. Golden's Taxonomy

Professor Golden adopts his own taxonomy of patent injunctions to describe the data of the district court cases. He draws on the conventional classifications of the types of injunctions: preventive, reparative, prophylactic, and structural.¹⁵ Golden however is primarily concerned about scope. Scope and typology are two different analytical questions, though they are often intertwined. Scope is a question of the amount or measure or breadth of the injunctive relief. Typology or character of the injunction goes to its key functionality, whether it will work against the harm, the consequences of harm, the facilitators of continued harm, or the harmful structure of the defendant. Judicial crafting of appropriate injunctive relief involves questions both of what and how much relief to order.

Golden classifies the data into eight categories demarcated by both type and scope. He identifies three general categories of injunctions that he sees in the district court patent cases: preventive, reparative, and specifically tailored.¹⁶ The first category is that of the usual "off switch" that orders the infringing conduct to stop. He identifies three subtypes of preventive injunctions based on increasing breadth of scope: Type 0 (prohibits exact product found to infringe); Type 1 (prohibits exact product plus variations "not of colorable difference"); and Type 2 (prohibits any infringement of patent).¹⁷ The second category is reparative injunctions, but contains only one example in the data. The remaining injunctions he classifies as specially tailored prophylactic injunctions of both extraprotective and subprotective scope. He differentiates these prophylactic injunctions into four subtypes.¹⁸ Type C injunctions prohibit correlated activities beyond that activity which constitutes infringement. Most of the prophylactic injunctions Golden found fall into this Type C category. Type D injunctions order the destruction, disablement, or delivery of remaining infringing products. Type B are "reformulated bounds" injunctions that prohibit a general range of conduct without reference to the patent. And Type M injunctions are moderated injunctions which include a carve out or exception explicitly or implicitly permitting some future infringing behavior.

Golden's taxonomy is most valuable for illustrating the increasing levels of broad scope an injunction might take. It illustrates gradations of protection that create significant differences in restrictions of the infringing company's future innovation. He uses the example of the

¹⁵ DAVID LEVINE, DAVID JUNG & TRACY THOMAS, REMEDIES: PUBLIC AND PRIVATE 52 (West 5th ed. 2009); Thomas, *The Prophylactic Remedy*, *supra* note 1, at 315-19. Preventive relief orders the harm to stop, reparative repairs the harm by preventing the continued consequences, prophylactic addresses the facilitators of continued harm, and structural restructures the institutional defendant. *Id.* Structural injunctions are not found in Golden's data, but would include an order divesting a monopoly to create two separate companies incapable of perpetuating the illegal monopoly behavior. *See* United States v. Microsoft Corp., 97 F. Supp. 2d 59, 64 (D.D.C. 2000) (ordering divestiture of Microsoft into two "baby Bills"), *vacated on appeal*.

¹⁶ Golden, *supra* note 3, at *5.

¹⁷ *Id.*

¹⁸ *Id.*

infringement of Gillette's 3-blade razor by the Schick Quattro multi-blade razor to illustrate the difference in equitable options.¹⁹ A court could prohibit Schick from making the Quattro (Type 0), making the Quattro and any other product of "no colorable difference" to reach product variations (Type 1), or from making "any product that infringes Gillette's patent" (Type 2). Specially tailored injunctions might prohibit Schick from making "all multi-blade razors" (Type B), or making "the Quattro razor and any variation with two to four blades" (Type M), or require Schick to "destroy all remaining Schick Quattro razors in inventory" (Type D), or "submit future variations of multi-blade razors for Gillette's approval" (Type C).

Reasonable minds might differ as to some of these categorizations. Type D destruction orders might be classified as reparative rather than specially tailored. These orders attack the consequences of the past harm by ordering the destruction of the exact remaining products. Type M specially tailored injunctions might instead be classified as preventive. These moderated injunctions limit the range of variations prohibited seems to fall between exact and colorable variations of Types 0 and 1, and thus might be labeled "Type .5" to show placement in the scope continuum.²⁰ If the data is reorganized this way, the patent infringement landscape includes some reparative relief, four types of preventive relief, and prophylactic injunctions.²¹ Professor Golden uses his taxonomy to make observations about the Federal Circuit's treatment of two categories of patent injunctions: Type 2 and reparative. He hones in on the prevalence of obey the law injunctions like "do not infringe the '777 patent" and the absence of reparative injunctions as rules outside the remedial norm.

A. *The Prevalence of Obey the Law Injunctions*

Golden finds it "striking, if not shocking" that the majority of injunctions issued in patent infringement cases use forbidden obey-the-law language. Federal Rule of Civil Procedure 65(d) requires that injunctions be drafted in specific language and "describe in reasonable detail" the acts to be restrained. This necessitates an avoidance of obey the law injunctions that command compliance with the law generally, for example, ordering that the defendant is "enjoined from violating Title VII." The Supreme Court has indicated that the policy behind the rule is "to prevent uncertainty and confusion on the part of those faced with injunctive orders, and to avoid

¹⁹ These hypotheticals are based on the case *Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d 1367, 1368 (Fed. Cir. 2005), which denied a preliminary injunction because patent covered only a three-bladed razor and Schick's Quattro was a four-bladed razor.

²⁰ Using this Type M injunction, Professor Golden makes the case that prophylactic injunctions can be subprotective, rather than solely extraprotective. These examples don't necessarily make the case, since Type M injunctions are more preventive than prophylactic. Prophylactic injunctions in general have been conceptualized as extraprotective, but the concept of issuing injunctions that protect less than the plaintiff's rightful position due to burdens on the defendant is a standard concept of remedies law applicable to injunctions. See LEVINE, *supra* note 15, at 101; David S. Schoenbrod, *The Measure of an Injunction: A Principle to Replace Balancing the Equities and Tailoring the Remedy*, 72 MINN. L. REV. 627 (1988).

²¹ In addition, Type B injunctions may not be prophylactic, but rather preventive, offering the broadest scope of stopping the harm by general prohibitions and thus might be called "Type 3" injunctions following Golden's nomenclature. See Thomas, *The Prophylactic Remedy*, *supra* note, 1 at 318. Golden follows the lead of most commentators who label as prophylactic those orders prohibiting an entire general category of products or processes sweeping in legal activity. See *id.* at 317n.69. In the patent context, these are orders that prohibit general activity without reference to the patent, for example, prohibiting production of all pet beds with swing arms, rather than just swing-arm beds with three legs detailed in the patent.

the possible founding of a contempt citation on a decree too vague to be understood.”²² Otherwise, future conduct different and independent from the past wrong are swept with the reach of contempt sanctions. Accordingly, the Federal Circuit has explicitly stated that these types of injunctions are prohibited as overly broad.²³

But Golden demonstrates that the rule is not being followed and that such injunctions are in fact common.²⁴ His study finds that 57% of the patent injunctions were this type of obey-the-law injunction. These injunctions commanded “do not infringe the ‘777 patent’” or “do not infringe claim one of the ‘777 patent.’”²⁵ He searches for explanations between contested and uncontested injunctions, permanent and preliminary relief, technical subject matter, geography of the issuing court, and settled versus litigated cases, but finds no statistically significant explanation for the overall high error rate.²⁶ He concludes that it may be “that the very prevalence of such error generates noncorrective inertia” in that the familiarity of the language results in it “being perceived as unsuspecting.”²⁷ It could also be that the assumptions of Rule 65(d) are wrong, at least in the patent context, and that lawyers and litigants clearly understand the dictates and parameters of “do not infringe the patent” which strikes the right balance between protection and innovation.²⁸

The perceived problem of obey the law injunctions is perhaps much ado about nothing. As Golden notes later in his analysis, the Circuit is not actually drafting true obey the law injunctions. The patent orders do not say “do not violate the U.S. Patent Act,” but instead forbid future infringement of a specific patent, “do not infringe the ‘712 patent.’” Granted, this type of order is broader and leaves room for violation of the order by completely new practices not at issue in the initial suit. But the question of breadth of scope is not an issue of drafting, which is the only command of the federal rule.

Moreover, the Federal Circuit has developed an easy corrective rule. At the contempt phase, these Type 2 “do not infringe the patent” injunctions are simply interpreted as narrower Type 1 injunctions prohibiting the infringement by the specific product at issue in the underlying case or its colorable differences.²⁹ Type 2 language is thus considered harmless error.³⁰ Of course, it would certainly be easier if courts and lawyers would simply follow the rule.³¹ As

²² Schmidt v. Lessard, 414 U.S. 473, 476 (1974).

²³ See Forest Labs., Inc. v. Ivax Pharm., Inc., 501 F.3d 1263, 1271 (Fed. Cir. 2007); Int’l Rectifier Corp. v. IXYS Corp., 383 F.3d 1312, 1316 (Fed. Cir. 2004); Additive Controls & Measurement Sys. Inc. v. Flowdata, Inc., 986 F.2d 476, 479089 (Fed. Cir. 1993).

²⁴ KSM Fastening Sys., Inc. v. H.A. Jones Co., 776 F.2d 1522, 1526 (Fed. Cir. 1985) (observing “that injunctions are frequently drafted or approved by the courts in general terms, broadly enjoining ‘further infringement’ of the patent despite the language of Rule 65(d). . .”).

²⁵ Golden, *supra* note 3, at *39.

²⁶ *Id.* at *39-50.

²⁷ *Id.*

²⁸ Golden comments that Rule 65(d) might be “less than entirely intuitive,” noting that Type 2 injunctions are particularly instructive for design patents and that courts in Canada, the United Kingdom, and Australia have found Type 2 injunctions to be the standard, instructive form of relief. *Id.* at *48-49. See also McComb v. Jacksonville Paper Co., 336 U.S. 187 (1949) (enforcing injunction to obey the Fair Labor Standards Act and finding such generalization necessary to restrain defendants’ proclivity).

²⁹ *Id.* at *23 (citing *KSM Fastening*, 776 F.2d at 1526).

³⁰ *Id.* at *24 (citing *Signtech USA, Ltd. v. Vutek, Inc.*, 174 F.3d 1352, 1359 (Fed. Cir. 1999)).

³¹ See Dupuy v. Samuels, 465 F.3d 757 (7th Cir. 2006) (Posner, J.) (objecting to, but still enforcing, injunction that failed to comply with Rule 65(d) by improperly referencing other documents). “Rule 65(d) is simple, clear, sensible, easily complied with, and not even new; we are distressed by the failure of the parties and the district judge to have complied with it in this case.” *Id.*

Golden notes, compliance with this rule is not particularly difficult: just use Type 0 or Type 1 language prohibiting the exact behavior, with or without colorable differences.³²

B. The Absence of Reparative Relief

The absence of reparative injunctions altogether in the patent context is much more surprising and potentially problematic. Reparative injunctions are among the classic, traditional, and usually non-controversial types of relief.³³ Golden's research identifies only one reparative injunction.³⁴ Thus he concludes that compliance with Federal Circuit precedent is quite good here, in contrast to the Type 2 injunctions. For the Federal Circuit has adopted a blanket prohibition on this category of common equitable relief.³⁵

When it comes to remedies, the Federal Circuit has been a bit of a maverick. The Circuit has shown that it is willing to go its own way, bucking the usual traditional rules of remedies in crafting appropriate remedies for patent harms. Its originality, however, has been reined in by the Supreme Court, which has twice in recent years overruled the Federal Circuit's remedial approach. In *eBay Inc. v. MercExchange, LLC.*, the Court unanimously chastised the Federal Circuit for refusing to apply the traditional balancing test for qualifying for injunctive relief and instead adopting a categorical rule that injunctions should always issue in patent infringement cases.³⁶ "The gumption of the Federal Circuit in unilaterally altering the longstanding common-law principles of equity fueled the Court's criticism."³⁷ Similarly, in *MedImmune Inc. v. Genentech, Inc.*, the Court struck down the Federal Circuit's categorical remedial approach for declaratory judgments.³⁸ The Circuit substituted the established test for determining a ripe case for declaratory relief with its own unique test for establishing a justiciable controversy.³⁹ The Supreme Court in a near unanimous decision again struck down the appellate court's exceptional rules for patents and "chided the Federal Circuit for its remedial audacity."⁴⁰

The Federal Circuit seems to have created yet another exception to remedial rules, this time prohibiting reparative injunctions for patent infringement. According to Golden, the Federal Circuit is concerned about reparative injunctions because they "remedy" or "correct" patent infringement rather than "prevent" future infringement.⁴¹ The Court understands its jurisdictional authority to be limited by section 283 of the U.S. Patent Act which authorizes it "to grant injunctions in accordance with principles of equity to *prevent* violation of any right."⁴²

³² Golden, *supra* note 3, at *39.

³³ See 1 DAN B. DOBBS, LAW OF REMEDIES §2.9, at 225 (2d ed. 1993); LAYCOCK, *supra* note 12.

³⁴ The one injunction he has coded as reparative is an order to provide a written letter of apology. *Batesville Servs., Inc. v. S. Rain Casket and Funder Supply*, No. 1:09-CV-257, at 5 (N.D. Ind. July 15, 2010).

³⁵ *Spine Solutions, Inc. v. Medtronic Sofamor Danek USA, Inc.*, 620 F.3d 1305, 1320 (Fed. Cir. 2010); *John Hopkins Univ. v. Cellpro, Inc.*, 152 F.3d 1342, 1365 (Fed. Cir. 1998); *Eli Lilly & Co. v. Medtronic, Inc.*, 915 F.2d 670 (Fed. Cir. 1990); *but see TiVo Inc. v. EchoStar*, 646 F.3d 869, 890 n.9 (Fed. Cir. 2011) (en banc) (stating that "district courts are in the best position to fashion an injunction tailored to prevent or remedy infringement.").

³⁶ 126 S.Ct. 1837 (2006). See Tracy A. Thomas, *eBay Rx*, 2 AKRON J. INT. PROP. 187 (2008).

³⁷ Thomas, *eBay Rx*, *supra* note 36, at 189.

³⁸ 127 S.Ct. 764 (2007).

³⁹ *MedImmune, Inc. v. Genentech, Inc.*, 427 F.3d 958 (Fed. Cir. 2005); see David I. Levine & Charles E. Belle, *Declaratory Relief After MedImmune*, 14 LEWIS & CLARK L. REV. 491 (2010).

⁴⁰ Thomas, *eBay Rx*, *supra* note 36, at 190.

⁴¹ Golden, *supra* note 3, at *26

⁴² 35 U.S.C. § 283 (2006) (emphasis added); *Spine Solutions*, 620 F.3d at 1320.

And so it has held that “[a]n injunction is only proper to prevent future infringement of a patent, not to remedy past infringement.”⁴³

This thinking, however, demonstrates a fundamental misunderstanding of reparative relief. All injunctive relief is aimed at preventing future harm. Reparative relief is no different. Reparative injunctions attack the continued effects of past harm in order to prevent that ongoing harm in the future.⁴⁴ This relief prevents the harmful consequences of violations that otherwise will continue in the future.⁴⁵ The leftover results of past harm need to be altered, in a sense “repairing” the past infraction, while serving the general purpose of preventing harm in the future from those continued effects. Excluding this type of injunctive relief from the possible remedies for patent infringement thus permits the consequences of patent infringement to continue, essentially allowing infringers to get away with it, at least once. This type of categorical rule denying traditional equitable relief would likely capture the interest of a reviewing Supreme Court which has not looked favorably on the Federal Circuit’s creation of unique remedial rules for patents.

However, it may also be that this alarm is unfounded, and that the courts are actually issuing reparative relief in patent infringement cases. Many of the injunctions Golden has classified as specifically tailored are reparative relief.⁴⁶ These are disposal orders where the defendant is ordered to destroy, disable, or deliver for destruction remaining inventory that infringes the patent.⁴⁷ These orders target the leftover effects of past harm—the remaining product supply—and prevent the future harm of the ongoing sale or use of those products. These injunctions address the consequences left over from the harm that needs to be prevented going forward. They are not prophylactic because they do not address a cause or facilitator of harm that in and of itself is not illegal, and they are not preventive because they are not a command prohibiting new infringement in the future.⁴⁸

The two cases Golden discusses as proof of the Federal Circuit’s rejection of reparative relief are primarily about scope. In these cases, the appellate court ultimately rejects the proposed reparative relief because of its overbroad reach.⁴⁹ The lower courts had ordered destruction of products in foreign locales. The overturning of these injunctions focused on the overbreadth of the extraterritorial reach where those foreign inventories showed no threat of distribution in the U.S. and thus no risk to infringement of the U.S. patent. The scope of an injunction must have a nexus with the perceived threat, and thus the injunctions were rejected for this missing link between the conduct and the harm. Reparative injunctions, like all injunctions,

⁴³ *Spine Solutions*, 620 F.3d at 1320.

⁴⁴ LAYCOCK, *supra* note 12, at 269; see, e.g., *Brown v. Board of Education (Brown II)*, 349 U.S. 294 (1955) (ordering not just the cessation of racially-discriminatory student school assignments but the immediate admission of students to the public schools); *Bell v. Southwell*, 376 F.2d 659 (5th Cir. 1967) (ordering new election for justice of the peace where election tainted by racial discrimination against voters).

⁴⁵ *Id.*

⁴⁶ See *supra* text accompanying note 20. There were 7 destruction or disablement orders out of 143 injunctions. Golden, *supra* note 3, at *53.

⁴⁷ *TiVo*, 646 F.3d at 890 (ordering disablement of DVR functionality in remaining units); *Caught Fish Enters., LLC v. Metal Roof Innovations, Ltd.*, No. 09-cv-02878 (D. Colo. Feb. 24, 2010) (requiring infringer to ship to plaintiff for destruction all remaining product in their possession or control); *Saint-Gobain Technical Fabrics Am., Inc. v. Checkmate Geosynthetics, Inc.*, No. 6:09-cv-557-Orl-35KRS (M.D. Fla. Oct. 26, 2010).

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⁴⁹ *Spine Solutions*, 620 F.3d at 1320; *Johns Hopkins*, 152 F.3d at 1366.

can sometimes be overbroad in scope.⁵⁰ The courts' issuance of destruction orders (for US inventory) in other cases shows that it has not eliminated this category wholesale, but instead, is demanding that injunction relief be of proper scope.⁵¹ Thus, despite the Federal Circuit's dicta against reparative relief, courts are finding it appropriate as part of its usual resolution of disputes as commonly ordered in other types of cases.

II. *The Optimal Injunction*

The purpose of Golden's study ultimately is to determine the optimal injunction for patent infringement cases.⁵² His solution is a specially tailored injunction. He argues that specially tailored prophylactic injunctions should be the norm and replace the conventional "do not infringe" Type 2 obey-the-law injunctions that currently dominate the decisions. Golden's argument ultimately is a plea for specificity. Tailored injunctions, he argues, appropriately accommodate the protections guaranteed to patent holders while facilitating socially desirable innovation. While Type 1 colorable differences injunctions might seem to be an appropriate default, they "fall far short of providing a complete answer to problems of injunction scope."⁵³ Patentees are unsatisfied with the protection offered by these narrow injunctions, the vagaries of "colorable differences" invite continued litigation and business uncertainty over permissible variations, and the orders are "too easily circumvented."⁵⁴ Golden instead finds value in preferring specially tailored injunctions like prophylactic relief.⁵⁵

A. *Incentives and Efficiencies*

In evaluating the optimal injunctive relief for patent infringement, Golden is guided by concerns of over and under deterrence. Underdeterrence of infringement is a concern of narrow injunctions that leave a rational infringer with substantial reason to pursue a course of action likely constituting further infringement because it will not be subjected to contempt. If injunctions are inadequate to protect patentee rights, there is the potential for socially undesirable erosion of the value of those patent rights.⁵⁶ A broad injunction on the other hand, threatens overdeterrence because the severity of threatened contempt sanctions deters future activity that is unlikely to be contempt, even though it would likely not be infringing. This is a concern because society rationally wishes to encourage market actors, even adjudged infringers, to develop and disseminate innovations through product redesign.⁵⁷ Golden finds the solution in a successfully drafted specially tailored injunction which "can possess comparatively clear limits that provide safe havens for a broad range of potential future activities," and whose havens reduce the

⁵⁰ See, e.g., *Mt. Healthy City School District Bd. of Educ. v. Doyle*, 429 U.S. 274 (1977) (reversing reinstatement of teacher as overly broad for guaranteeing de facto tenure to teacher on renewable contract).

⁵¹ See cases cited *supra* note 47; *Proveris Scientific Corp. v. InnovaSystems Inc.*, No. 05-12424-WGY (D. Mass May 11, 2007) (requiring defendant to "destroy all inventory of its OSA product").

⁵² Not everyone agrees on the practical appropriateness of injunctive relief. See H. Tomas Gomez-Arostegui, *Prospective Compensation in Lieu of a Final Injunction in Patent and Copyright Cases*, 78 *FORDHAM L. REV.* 1661 (2010).

⁵³ Golden, *supra* note 3, at *62.

⁵⁴ *Id.* at *62, *64, *69.

⁵⁵ His preferred specially tailored injunctions include prophylactic injunctions Type C and Type B and more specific, narrow preventive injunctions Type M.

⁵⁶ *Id.* at *67.

⁵⁷ *Id.* at *58.

possibility that “a combination of uncertainty and infringer risk aversion will cause an injunction’s deterrent effect to overshoot its mark.”⁵⁸

Golden argues that specially tailored relief is more efficient. He identifies the options defendants have to react to injunctions by either stopping production of the product, paying damages in lieu of the injunction, or designing around the injunction.⁵⁹ He finds value in injunctions that create incentives to design around the injunction because they contribute to further innovation. Golden argues that a positive justification for the patent system is the incentive to design around competitors’ products, thus bringing the steady flow of innovations to the marketplace.⁶⁰ He offers a different approach than a typical one offered by law and economics scholars concerned with efficient injunctions focusing on the buyout of the injunction.⁶¹ To these theorists, the efficient injunction is one that provides leverage to incorporate legal norms into the dispute, but which permits the parties to negotiate around the injunction to reach an efficient result permitting desired profit-maximizing behavior. However, Golden notes that such bargained solutions are not always feasible, whether because of information costs, distrust between the parties, strategic behavior, or holdout behavior, and thus reasonable licenses do not always occur.⁶² He instead finds the operative economic value to be one that encourages the socially desirable innovation behavior embodied in the patent law.

Prophylactic injunctions also offer functional benefits. A prophylactic remedy can “counter the defendant’s resistance to compliance, provide precise notice to the defendant of expected conduct, and facilitate the court’s oversight” and enforcement of the order.⁶³ Golden demonstrates how specially tailored injunctions in the patent context provide better notice, compliance, enforceability, and administrability of the injunction.⁶⁴ Providing detailed background about the law of contempt,⁶⁵ he shows how tailored injunctions generate increased compliance with issued injunctions by providing clearer instruction, and may even increase compliance by third parties who otherwise might be encouraged to disrespect those patent rights.⁶⁶ These specially tailored injunctions also reduce the chilling effect on desired design-around activity, providing another positive aspect to such relief.⁶⁷ While prophylactic injunctions might entail more upfront costs in drafting a tailored injunction rather than parroting the language of the statute, those costs are saved at the back end by avoiding or minimizing costs of enforcement and contempt.⁶⁸ This tailored approach provides an opportunity to tailor the

⁵⁸ *Id.* at *65.

⁵⁹ *Id.* at *16.

⁶⁰ *Id.* at *10.

⁶¹ LEVINE, *supra* note 15, 92-94.

⁶² Golden, *supra* note 3, at 61.

⁶³ Thomas, *The Prophylactic Remedy*, *supra* note, at 372, 379; *see also* Paul Gewirtz, *Remedies and Resistance*, 92 *YALE L.J.* 585, 587 (explaining that specific measures eliminate the defendant’s discretion to avoid the change necessary to conform with the legal right, thereby ensuring a higher level of remedial effectiveness.).

⁶⁴ Golden, *supra* note 3, at *73-74.

⁶⁵ Golden interestingly discovers virtually zero instances of valid criminal contempt sanctions in patent cases. *Id.* at *12. This conclusion is based on an electronic search of case databases since 1970, but which would not turn up unreported cases like most contempt orders. The conclusion however makes sense because criminal contempt sanctions require process commiserate with criminal due process, including proof beyond a reasonable doubt, Sixth and Fifth Amendment rights, etc., and most civil courts get this wrong. *See United Mine Works v. Bagwell*, 512 U.S. 821 (1994).

⁶⁶ Golden, *supra* note 3, at *66.

⁶⁷ *Id.* at *67.

⁶⁸ *Id.* at *66.

concerns of both parties more carefully to better address the practical innovation and business realities of the parties.

B. Prophylaxis as Threshold Rather than Afterthought

Prophylactic relief has often been used as a remedy of last resort.⁶⁹ The conventional suspicion of prophylaxis as judicial activism and its prevalence in public law cases countenanced a cautious approach to issuing this relief.⁷⁰ Courts thus often reserved prophylactic relief for recalcitrant defendants or particularly obstreperous conduct when less restrictive injunctions were ineffective.⁷¹ The Federal Circuit has followed this approach, utilizing broad prophylactic injunctions in cases of flagrant and continued violations of prior orders.⁷² This use of prophylaxis as a last resort, Golden notes, has value beyond the expected gain from increased compliance in the individual case, offering a “systemic gain from a more general signal to third parties of courts’ willingness and capacity to ensure that patent rights are ultimately respected.”⁷³ Golden, however, would expand the use of prophylactic relief into a conventional, initial remedy. His empirical research demonstrates that prophylactic injunctions are in fact being used as remedies of first resort in patent cases because they provide the specific tailoring effective at balancing protection of patentee rights while fostering innovation.⁷⁴ I agree with Golden’s argument to move prophylactic relief to the front line.

The conventional judicial restraint in using prophylaxis as a last resort arose out of cases with defendants like prisons, schools, and governmental institutions. Courts adopted a “special deference to public institutional defendants” out of concern with federalism and “the interests of state and local authorities in managing their own affairs” which resulted in prophylactic relief being applied as a secondary rather than initial remedy.⁷⁵ In other cases prophylaxis was a remedy because there were constitutional implications of limiting defendants’ activities, such as restricting protestors’ first amendment rights to political speech.⁷⁶ These types of concerns are

⁶⁹ Thomas, *The Prophylactic Remedy*, *supra* note 1, at 353; Thomas, *Continued Vitality*, *supra* note 1, at 112.

⁷⁰ William A. Fletcher, *The Discretionary Constitution: Institutional Remedies and Judicial Legitimacy*, 91 YALE L.J. 635, 695-97 (1982) (“[R]emedial discretion in institutional suits is inevitably political in nature,” and therefore “presumptively illegitimate” except when political bodies that should ordinarily exercise such discretion are “seriously and chronically in default” in which case judicial discretion is a “necessary” and “legitimate” substitute.).

⁷¹ See, e.g., *Madsen v. Women’s Health Ctr.*, 512 U.S. 753 (1994); *Hutto v. Finney*, 437 U.S. 678, 687 (1978); *Swann v. Charlotte-Mecklenburg Bd. of Educ.*, 402 U.S. 1, 16 (1971). In another example, the Supreme Court in *Brown v. Plata* upheld an injunction ordering the release of prison inmates to address the overcrowding causing continued and extreme denial of medical care including many deaths. The order was influenced by the decades-long refusal and inability of the California prison system to alleviate or mitigate the harm. The majority framed the decision in terms of structural injunctive relief, but seemed to appreciate that the order was a prophylactic injunction that addressed “the continuing cause of the harm,” as the operative statute, the Prison Litigation Reform Act, allowed injunctive relief to reach “the primary cause” of the constitution violation. 563 U.S. ___, 131 S.Ct. 1910 (2011).

⁷² *Additive Controls & Measurement Systems, Inc. v. Flowdata, Inc.*, 154 F.3d 1345 (Fed. Cir. 1998); *Spindelfabrik Suessen-Schurr v. Suber & Salzer Maschinenfabrik Aktiengesellschaft*, 903 F.2d 1568, 1577 (Fed. Cir. 1990).

⁷³ Golden, *supra* note 3, at *67.

⁷⁴ See, e.g., *Silverlit Toys Manufactory Ltd. V. JP Commerce, LLC*, No. 2:09-cv-08959-CAS-JC 9C.D. Cal. Apr. 29, 2010) (enjoining the “marketing, reproducing, distributing, receiving, forwarding, shipping, displaying (on their websites or otherwise), or in any way commercially exploiting . . . any toy helicopters” that infringe the patent); *Innovation U.S.A., Inc., v. Ido Furniture (U.S.A.) Corp.*, No. 1:09-cv-01727-JBW-RLM (E.D.N.Y. Mar. 31, 2010).

⁷⁵ Thomas, *The Prophylactic Remedy*, *supra* note 1, at 354.

⁷⁶ *Madsen*, 512 U.S. at 753; *Schenk v. Pro-Choice Network of W.N.Y.*, 519 U.S. 357, 382 (1997).

not present in the patent context. Thus there is no need to subordinate this relief below other remedial options. Moreover, as Golden notes, any undue burden to the defendant from the potential breadth of the injunction is mitigated by the specificity of the prophylactic injunction, which removes uncertainty and gives defendants freedom to continue their business practices and desired innovation and redesigns.⁷⁷

Golden conditions his argument a bit by suggesting steps courts could take to ensure that prophylaxis is not used “too readily or rashly” and result in overdeterrence.⁷⁸ These steps however are unnecessary, as the law already contains parameters to circumscribe prophylactic injunctions to prevent overreaching.⁷⁹ Prophylactic relief is not courts gone wild. Properly issued prophylactic injunctions require causal connection between the activity restrained and violation of the law.⁸⁰ This is a meaningful restriction, for when courts try to go astray from this and restrain legal conduct with no nexus to wrongdoing under the guise of prophylaxis, they are, and should be, struck down.⁸¹ There are thus legal rules in place, as there are with all injunctions, to avoid injunctions that extend too far.

Prophylactic injunctions are practical and effective. They make sense to the people in the trenches tasked with the job of implementing the abstraction of legal protections in the real world business context. Simply put, “[p]rophylaxis seems to work.”⁸² Professor Golden’s research demonstrates this reality, showing the use of prophylactic relief in patent infringement cases through careful, exhaustive research. The data shows that lawyers and judges understand the utility of a specially tailored injunction. Golden uses this evidence to make the normative argument for prophylactic relief. “The key point,” he argues, “is that the remedial quiver of district courts appears to contain an additional arrow that the Federal Circuit and commentators have often neglected to discuss—the capacity to craft a specially tailored injunction.”⁸³ His work erodes “the existing academic and political bias against such commonly-used judicial remedies” and shows that prophylactic relief has much to offer.⁸⁴

⁷⁷ Thomas, *The Prophylactic Remedy*, *supra* note 1, at 382-83 (“[T]he certainty of prophylactic measures protects defendants against exposure to contempt punishment for violating a vague or confusing order.”).

⁷⁸ He suggests sunset provisions limiting the operative time of the injunction, judicial willingness to modify the injunction for changed circumstances, or requirements of special degrees of explicit justification by the party requesting the relief. Golden, *supra* note 3, at *69.

⁷⁹ Thomas, *The Prophylactic Remedy*, *supra* note 1, at 370-83; Schoenbrod, *supra* note 20, at 671-82 (explaining that prophylactic relief can give more than the plaintiff’s rightful position when necessary to remedy the violation as long as it aims for that rightful position and not some other purpose).

⁸⁰ Thomas, *The Prophylactic Remedy*, *supra* note 1, at 309, 339-44.

⁸¹ *See, e.g.*, *Rizzo v. Goode*, 423 U.S. 362 (1976) (invalidating prophylactic relief of establishing civilian complaint system where no evidence that police department or its policies were the cause of continued police brutality and assaults); *Lewis v. Casey*, 518 U.S. 343, 356-60 (1996) (invalidating prophylactic measures of prison law library hours, books, and Spanish speaking services that had no connection with harm of denial of access to courts to illiterate inmate); *People Who Care v. Rockford Bd. of Educ.*, 111 F.3d 528, 532 (7th Cir. 1997) (invalidating prophylactic measure of racial quotas for teachers finding no connection between faculty composition and proven discriminatory harm against students).

⁸² Thomas, *Continued Vitality*, *supra* note 1, at 111.

⁸³ Golden, *supra* note 3, at *73.

⁸⁴ Thomas, *The Prophylactic Remedy*, *supra* note 1, at 306.