

The Johnson & Johnson Acuvue Compulsory License

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In April of 2010, District Judge Timothy J. Corrigan (M.D Florida, Jacksonville division) declined to grant a permanent injunction following a finding that the Johnson & Johnson's ACUVUE®OASYS contact lens product infringed patents owned by CIBA Vision Corporation, providing another example of, in effect, a judicial compulsory license following the 2006 *eBay v. MercExchange* case; the judge wrote:

In *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 126 S.Ct. 1837, 164 L.Ed.2d 641 (2006), the Supreme Court held that in patent cases, a plaintiff seeking a permanent injunction must satisfy the same four-factor test applicable to other requests for permanent injunctive relief:

A [patent] plaintiff must demonstrate: (1) that it has suffered an irreparable injury; (2) that remedies at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction.

Id. at 391, 126 S.Ct. 1837. The patent plaintiff bears the burden of proving its entitlement to a permanent injunction. See *Voda v. Cordis Corp.*, 536 F.3d 1311, 1329 (Fed.Cir.2008).

This decision was of interest because, not only did the court hold that CIBA had failed to prove irreparable harm and had failed to prove that monetary damages would be insufficient compensation for future harm, but the court also included a thorough and considered discussion of the public interests at stake:

The Court now addresses the public interest. CIBA relies upon the truism that the general public has an interest in enforcement of the patent laws. See e.g. *Abbott Labs. v. Andrx Pharms., Inc.*, 452 F.3d 1331, 1348 (Fed.Cir.2006). While acknowledging that enjoining the future sales of ACUVUE®OASYS will cause some disruption to eye care practitioners and patients, CIBA seeks to minimize this concern by stating that it will entail "inconvenience" and no more. However, the persuasive evidence shows otherwise.

Finding that approximately 5.5 million American patients presently wear the infringing lenses and that the total cost of refitting for all current users would be between \$275 million and \$687.5 million, the court stated that “millions of innocent lens wearers will suffer real adverse consequences if sale of ACUVUE®OASYS is enjoined.” The concerns, said the court, were not limited to “issues of comfort or cosmetics, as CIBA argu[ed], but rather deal[t] with the more substantive concerns of proper vision and eye care.” It concluded:

The preponderance of the evidence convinces the Court that an injunction will create consequential medical, practical and economic issues for large numbers of ACUVUE®OASYS users. The deleterious effects of the injunction on the general public would simply be too great to permit. [...] The Court understands that the product in *Bard Peripheral* involved "potentially life saving technologies." Here, the consequences of enjoining the ACUVUE®OASYS are not so grave; nevertheless, this Court, sitting in equity, finds those consequences to be sufficiently important and adverse to millions of ACUVUE®OASYS patients that the public interest would be disserved if an injunction were to be entered.

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