

## IP MVP: Mayer Brown's A. John P. Mancini

By **Dan Prochilo**

*Law360, New York (November 20, 2013, 8:39 PM ET)* -- Securing court victories that saved clients such as Google Inc. significant damages and that led to landmark decisions, including a finding that U.S. trade law doesn't protect the licensing businesses of "patent trolls," has made A. John P. Mancini of Mayer Brown LLP one of Law360's 2013 Intellectual Property MVPs.

Mancini helped obtain major legal wins during the past 12 months that shaped intellectual property law, including his defeat of a nonpracticing entity's U.S. International Trade Commission case against French liquor producer Pernod Ricard SA's U.S. unit.

His cases over the past year have led to the ITC's controversial early-determination process — imposing tight deadlines on the commission's administrative law judges to resolve issues that could short-circuit some patent investigations — and other groundbreaking decisions.

An advocate for pioneering tech companies since the start of the Internet age, Mancini said his practice is motivated by a desire to stop the law from being used to get in the way of innovation.

"Our country distances itself from the rest of the world because of the new inventions we make, and it would be a tragedy if the law were used to impede the advancement of new technology," Mancini told Law360. "I have taken it upon myself to fight those attempts, and to be creative about it each time, to foster the growth of new technology ... because it's important to our economy."

At the beginning of his career in the early 1990s, Mancini recognized how the Internet would transform commerce, and he made a name for himself by winning cases for Silicon Alley clients such as Citysearch and Winstar Communications Inc., a provider of high-speed Internet access via radio antennas, he said.

A huge litigation victory he had clenched for Winstar made Mancini known in the growing high technology space and taught him that winning cases for tech startups required taking traditional tenets of intellectual property law and applying them to the still-undeveloped field of information technology law.

"That approach of extending the law has stayed with me," Mancini said. "It has become a theme throughout my career, and it is part of the secret to my success."

Drawing a comparison between a well-worn legal concept and a purportedly new service was how Mancini recently derailed a December 2011 suit against Google alleging the search giant's Trusted

Stores initiative infringed a patented method for guaranteeing online transactions.

BuySAFE Inc. alleged Google's program infringed its method of providing Internet retailers and their customers with third-party certification and transactional guarantees, But Mancini and the rest of Google's defense team argued that buySAFE had tried patenting the archaic concept of a guaranty.

"The plaintiffs' own website acknowledged this notion had been around since the time of Hammurabi," and Google's attorneys sought summary judgment on the grounds that buySAFE's patent was invalid. A Delaware federal judge agreed in late July, ruling that buySAFE tried claiming a well-known, abstract concept just by applying the idea online, and its would-be invention was ineligible for patent protection.

Mancini said his track record of beating infringement allegations can also be attributed to his ability to explain complex scientific and legal concepts consistent with simple, stirring narratives.

"Even if you are dealing with a case with complicated technology and facts, it all comes down to telling a story," he said.

His characterization of YouTube during a copyright infringement case filed against the video-sharing site by Viacom resonated with a New York federal judge, who dismissed the suit in June 2010 after concluding that YouTube had lived up to its obligations under the Digital Millennium Copyright Act, Mancini said. The Second Circuit partly affirmed that decision in April 2012, according to the attorney, but the appeals court also revived Viacom's claims, saying it had been premature to grant summary judgment.

Before the trial court, Viacom tried portraying the website as a facilitator of mass piracy, but Mancini said he presented his client as a vehicle for free expression, offering underground artists and people living under oppressive regimes an unprecedented avenue for reaching a global audience.

"I think that story was powerful," Mancini said.

U.S. District Judge Louis Stanton in June 2010 ruled that the DMCA made it the copyright holder's responsibility to police sites with user-generated content and notify them when infringing clips had been put up so they could be removed. The judge said YouTube's "notice and takedown" policy shielded it from infringement claims under the DMCA's safe harbor provision.

He rejected Viacom's arguments that the law did not cover YouTube because it knowingly contributed to and benefitted from infringement by its users.

Viacom appealed to the Second Circuit, which in April 2012 resurrected the case after finding there was evidence YouTube's higher ups knew there was infringing activity on their site, disqualifying it from protection under the law's safe harbor.

The appeals court cited an internal YouTube report from 2006 stating that clips of Viacom shows including "The Daily Show" and "South Park" were available on YouTube, and that such content was "blatantly illegal" and should be removed. According to the Second Circuit, that could be enough to convince a reasonable juror that YouTube was aware of some of the infringing content on its site, rendering it potentially liable for the offending clips it knew about.

But on remand — after Mancini was no longer representing YouTube and attorneys from Quinn

Emanuel Urquhart & Sullivan LLP and Wilson Sonsini Goodrich & Rosati PC had taken over as defense counsel — Judge Stanton dismissed the case a second time. The judge ruled in April that there was no evidence the site's executives were cognizant of the posting of specific, allegedly infringing clips from shows such as "South Park" on YouTube, and he reiterated that they were therefore shielded by the DMCA. Viacom has once more appealed to the Second Circuit.

A February patent case before the ITC in which Mancini defended Pernod Ricard USA LLC from a nonpracticing entity's infringement claims was significant not only in terms of its outcome, but also in how the commission handled it.

With Congress looking for ways to curb frivolous lawsuits from "patent trolls," the ITC gave one of its administrative law judges 100 days to decide the potentially dispositive question of whether the patent holder, Lamina Packaging Innovations LLC, had a business that qualified as a domestic industry under U.S. trade law. A company must have a domestic industry to file suit at the ITC.

The judge determined in July that Lamina's business failed to meet that standard, ruling that a patent licensing business involving companies taking licenses just to settle litigation — rather than to exploit patented technology — wasn't what the Tariff Act was designed to protect, Mancini said.

The ITC's first-of-its-kind accelerated-review order also provided the inspiration for a pilot program. The commission announced in June that it would be identifying cases that similarly hinged on one or two issues and ordering expedited reviews to assess early on whether the patent owners had standing or a domestic industry, for example, instead of waiting to confront those questions after drawn-out litigation.

The program could place so-called "patent trolls" on the defensive for the first 100 days of an ITC patent proceeding, "which will be all about their activities instead of focusing on the defendant," Mancini said. The quick review process may also save accused infringers from having to choose between spending millions to defend themselves or settling with a nonpracticing entity, regardless of how weak its claims are.

"That is exactly what these trolls want," he said.

Mancini said his success rate in defending heavy-hitting clients in high-stakes cases is also a testament to the strength and culture of Mayer Brown's IP practice, which has attorneys who are both deeply familiar with complex technologies — a number of them being former electrical and computer engineers — and with their clients' businesses.

"We have people who not only know the technology, but also the industry," Mancini said. "We know their business and their products. It's everybody's job to know what our clients are doing and what is happening in the industry."