

IP Group Of The Year: Mayer Brown

By **Tiffany Hu**

Law360, New York (January 31, 2018, 3:58 PM EST) -- Mayer Brown LLP secured a victory in the Supreme Court decision *Impression Products v. Lexmark International*, a major win for Impression and companies in the secondary market for patented products, landing the firm a spot among Law360's 2017 Intellectual Property Groups of the Year.

The firm's intellectual property practice group consists of over 100 lawyers, and John Mancini, co-leader of the firm's IP practice, attributed the success of the group to its ability to leverage the strength of its reputation and its ability to "seamlessly work" with the firm's appellate group.

"In the landscape of intellectual property law, so much of the law is in flux and susceptible to revision at the appellate courts," Mancini told Law360, adding that the combination of both factors is what "brings results to the table."

One of the firm's recent achievements was the Supreme Court's May decision, in which the court held that a patentee could not impose patent-based restrictions on the use of a product after domestic and foreign sales, throwing out two Federal Circuit rules that kept some patent rights in place even after sales.

Mayer Brown represented Impression Products, one of the resellers Lexmark sued for buying and reselling refurbished ink cartridges. Every defendant had settled except Impression. In May, the high court found in favor of Impression, applying the doctrine of "patent exhaustion" to conclude that a patentee's exclusive right to make and sell a patented product was limited.

The lead counsel for the case, Paul Hughes, said the decision had "enormous implications" for the economy, as secondary markets were "essential" to the modern economy.

"There was some question in the law before that case, but, ultimately, the Supreme Court got it right with our help and created a business-friendly environment for our clients," Mancini added.

Mancini also highlighted major patent wins this year for the firm's high-tech clients, including LG Electronics and Google. In March, Mayer Brown secured a victory for LG when the U.S. Patent Trial and



Appeal Board invalidated two patents in inter partes review proceedings, while delivering another win in May for Google when the board invalidated part of two patents covering pay-per-click advertising.

“There were new and novel arguments that we advanced, and in some cases, these were cases of first impression before the PTAB, and we delivered outstanding results for our clients,” Mancini said.

Lisa Ferri, co-head of the firm's IP practice group, noted that while litigation in the patent space has been decreasing over the last few years, their clients have increased their post grant practice. However, she said the team has “met that challenge” by growing its expertise to meet their clients’ needs.

“We’ve had major wins in high tech, life science, chemistry and even the mechanical area. This is where we’ve met the challenge that the industry has brought to us, and have addressed that for our clients by becoming PTAB experts,” Ferri said.

Other notable achievements include Mayer Brown’s win for ViiV Healthcare and Vervex Pharmaceuticals before the PTAB, which found in a rare decision in July that secondary considerations regarding a prodrug patent weighed in favor of patentability. As a result of a victory on the claims challenged by a generics maker, Mayer Brown was able to keep generic competition off the market for the full patent term.

“We came up with a unique solution, and it’s one of the very few cases where a patent holder has won secondary consideration,” Ferri said. “That highlights the creative expertise we’re bringing out for our clients.”

Mancini agreed, saying the group is comprised of “thought leaders and great advocates” that intimately understand clients’ businesses, which he said allowed their lawyers to “make a real difference in the courtroom.”

“We are not afraid to advance legal concepts and shake the law in a way that is both rational and serves our clients’ purposes,” he said, adding that this was one of the “true strengths” of the team.

--Editing by Alyssa Miller.