

IP Group Of The Year: Mayer Brown

By **Dani Kass**

Law360 (December 4, 2020, 5:13 PM EST) -- Mayer Brown LLP spearheaded 3M's use of trademark law to target price gouging of its masks during the COVID-19 pandemic and represented Spotify in a high-profile fight over streaming royalty rates, earning it a place among Law360's 2020 Intellectual Property Groups of the Year.

The firm's women-led IP practice group includes more than 100 of its 1,600 attorneys, with the U.S. lawyers based largely in Chicago, New York and Northern California. It also has a strong presence in London, Hong Kong, China, Brazil and Frankfurt and Düsseldorf, Germany.

"It's an extremely global practice" said practice co-chair Lisa M. Ferri. "With the challenges that the pandemic has brought, that's really in a way given us this great foundation, because we're finding that our teams are more truly cross-office than ever. We're working around the globe, our cases and our deals are very inter-practice and inter-office, and that's helped in this work-from-home situation. And that, in many ways, is what defines us as a really top-flight IP group"

3M Co. tapped Mayer Brown to represent it in a series of lawsuits going after companies that were reselling its N95 masks at dramatically increased prices, just as the COVID-19 pandemic was picking up and personal protective equipment was in short supply and high demand.

"The harm was true and real, not just to 3M, but to the economy as a whole — that somebody could be trying to take advantage of a real need amongst consumers, including municipalities, and gouge them because of the need that existed. Something that 3M would never do," said partner John Mancini. "It was really important for 3M, reputationally, to get ahead of this, and show not only that this was not 3M, but also from a legal perspective, to come up with a theory that would allow this to stick."

The firm decided to target the price-gouging by arguing that the companies' violated federal trademark and false advertising law by claiming to be affiliated with 3M, thereby making it seem like 3M approved the drastically inflated prices. The litigation has led to a stream of injunctions and settlements.

"It was a very significant development in trademark law, frankly confirming what I think is a principle most practitioners understood but rarely applied," Mancini said.



Mayer Brown also represented Spotify as it fought along other streaming platforms to overturn the rates the Copyright Royalty Board set for them to pay songwriters and publishers. The D.C. Circuit in August said the streaming companies weren't given enough notice for the "extreme" rate hikes and that the board needed to better justify rates that it had rejected.

Mancini said this is one of the first times the D.C. Circuit has overturned a CRB rates ruling.

"It's probably one of the biggest copyright rate-setting decisions of the past decade or so," he added. "We won most of the issues at lower level, have now successfully vacated at the appellate level the only issues we did not win at the lower level, and hopefully on remand we'll succeed on the remaining open issues."

In the patent world, the Federal Circuit handed a win in May to Mayer Brown client Maxell, in a venue fight with Apple. Apple had been trying to get Maxell's patent suit transferred from the Eastern District of Texas to the Northern District of California.

The 2-1 ruling held that an agreement between Apple and Maxell's parent, Hitachi, requiring disputes to be handled in California was unrelated to the current infringement dispute, so the fight could stay in Texas.

In April, Mayer Brown got the Federal Circuit to affirm a U.S. International Trade Commission decision in favor of Ninestar Corp. and its parent company, Static Control. Canon Inc. had said the companies infringed seven patents directed to laser tone cartridges.

Partner Gary Hnath said Ninestar had redesigned its toner cartridge replacements to avoid infringement, which the ITC and Federal Circuit said worked.

"It was a huge victory for Ninestar, and in some ways, for the entire secondary market for toner cartridges," he said.

While the firm didn't have any large expansion in the last year due to the pandemic, Ferri said, growth is on its mind.

"We're definitely in the mode to expand in a couple of these strategic areas. In life sciences, in high tech, in the media space," she said. "It's certainly something we have our eye on."

--Editing by Gemma Horowitz.