

## Brian S. Mudge



### Partner

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### BIOGRAPHY

Brian assists clients with a broad variety of intellectual property litigation, acquisition and counseling matters concerning patents, trademarks, copyrights and trade secrets. He has provided opinions regarding the scope and validity of patents and trademarks, has defended against claims of infringement of intellectual property rights, and has assisted clients in evaluating, acquiring and enforcing patent portfolios. He has prosecuted patent applications and has handled patent post-grant proceedings before the U.S. Patent and Trademark Office, including inter partes review and reexamination cases. He has counseled clients in trademark selection, assisted clients in protecting works of authorship and assisted in the protection and licensing of proprietary technology.

Brian has experience in a wide variety of business and technology sectors, including internet and information technology, e-commerce, computer hardware and software, telecommunications, image and signal processing, Internet advertising, financial services, interactive entertainment, chemically-sensitive semiconductors and DNA sequencing hardware and software. His experience also includes entertainment law issues involving motion picture, music and publicity rights and new uses.

Prior to becoming a lawyer, Brian worked for RCA Corporation, where he was involved in research and development of image processing technology and commercial broadcast television products.

### REPRESENTATIVE EXPERIENCE

- Hewlett-Packard Co. in which he prepared two successful petitions for post-grant review of covered business method patents; these petitions formed the basis for a successful summary judgment motion in parallel district court litigation.
- j2 Cloud Services and Advanced Messaging Technologies in which he successfully defended against two petitions for inter partes review of a patent.
- AT&T in which he successfully defended client against trademark infringement claims by winning a ruling on summary judgment that “you have mail” is generic. *America Online v. AT&T* (E.D.V.A.).
- D. E. Shaw & Co. in which he successfully obtained injunction against foreign hedge fund’s use of infringing fund name. *D. E. Shaw & Co. v. Razor Investment Management* (S.D.N.Y.).
- Electronic Arts in which he defended against allegations of trade secret misappropriation. *Delphine Software Int’l, SARL v. Electronic Arts* (S.D.N.Y.).

### INDUSTRIES

Internet/E-Commerce  
Software/Electrical  
Technology  
Technology and  
Emerging Companies

### PRACTICES

Copyright Litigation  
Copyrights  
Intellectual Property and  
Technology  
IP Counseling and  
Licensing  
Patent Litigation  
Patent Prosecution  
Patent Trial and Appeal  
Board Proceedings  
Patents  
Securing and  
Maintaining Trademarks  
and Brand Names  
Trade Secret/Trade  
Dress Litigation  
Trade Secrets/Trade  
Dress  
Trademark Proceedings  
and Litigation  
Trademarks

### EDUCATION

JD, 1991, *cum laude*,  
University of  
Pennsylvania Law  
School, Order of the  
Coif, Moot Court Board  
MS, 1984, Systems  
Engineering, University  
of Pennsylvania  
BS, 1979, *magna cum  
laude*, Electrical  
Engineering, University  
of Pennsylvania, Tau  
Beta Pi, Eta Kappa Nu,  
Hexagon Senior Society

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- Home Shopping Network, Ingenious Designs and Joy Mangano in which he successfully defended against allegations of patent infringement. *Pearson v. Mangano* (W.D. Tenn.).
- Disney in which he successfully defended against summary judgment while obtaining a finding that the motion picture “Fantasia” was a work for hire and not a work of joint authorship. *Philadelphia Orchestra Assn. v. Walt Disney Co.* (E.D. Pa.).
- Sightsound in which he helped a patent owner successfully enforce its patents covering music downloading. *Sightsound.com v. N2K* (W.D. Pa.).
- BNP Paribas and CooperNeff Advisors in which he helped overturn a TRO and defeat a preliminary injunction motion in a case involving copyrights and trade secrets. *Zimmer v. CooperNeff Advisors* (E.D. Pa.).

## INSIGHTS

- “Federal Circuit Rules Petitioners Bear Burden of Proof to Establish Unpatentability of Claim Amendments in Inter Partes Reviews” *Andrews Kurth Kenyon IPR Blog* (November 9, 2017)
- “PTAB Section 101 Ruling Breaks With CAFC Opinion on Business Method” *Andrews Kurth Kenyon IPR Blog* (September 15, 2017)
- How Fed. Circ. Guides PTAB On CBM Review: Part 2 *Law360* (August 8, 2017)
- How Fed. Circ. Guides PTAB On CBM Review: Part 1 *Law360* (August 7, 2017)
- Is it Settled (Part 2)? PTAB Following Federal Circuit’s Narrowed CBM Definition *Andrews Kurth Kenyon IPR Blog* (July 31, 2017)
- Is it Settled (Part 1)? Divided Federal Circuit Denies En Banc Review of Narrowed Definition of Covered Business Method *Andrews Kurth Kenyon IPR Blog* (June 29, 2017)
- SCOTUS to Decide 2: Are AIA Patent Reviews Constitutional? *Andrews Kurth Kenyon IPR Blog* (June 22, 2017)
- U.S. Supreme Court to Decide Whether AIA Patent Reviews are Constitutional (June 13, 2017)
- “SCOTUS to Decide: Is PTAB Required to Determine Patentability of All Claims Challenged in an IPR Petition?” *Andrews Kurth Kenyon IPR Blog* (May 25, 2017)
- U.S. Supreme Court to Decide Whether PTAB is Required to Determine Patentability of All Claims Challenged in an IPR Petition (May 23, 2017)
- Opinions of Counsel Post-Halo: Lessons From 16 Cases *Law360* (May 22, 2017)
- “PTAB Nixes Reliance on Technical Report: Not Publication,” *Andrews Kurth Kenyon IPR Blog* (May 18, 2017)
- Opinions of Counsel Once Again Key to Avoiding Enhanced Damages (April 27, 2017)
- “Federal Circuit Lets CBM-Narrowing Decision Stand,” *Andrews Kurth Kenyon IPR Blog* (April 26, 2017)
- “PTAB, District Courts Diverge on Scope of Estoppel,” *Andrews Kurth Kenyon IPR Blog* (April 5, 2017)
- “Patent Owner’s Challenge to Wayback Machine Evidence Fails,” *Andrews Kurth Kenyon IPR Blog* (February 2, 2017)

## ADMISSIONS

District of Columbia  
Pennsylvania  
New Jersey  
US Patent and  
Trademark Office  
US Court of Appeals for  
the Federal Circuit  
US Court of Appeals for  
the Third Circuit  
US District Court for the  
Eastern District of  
Pennsylvania  
US District Court for the  
District of New Jersey

## Brian S. Mudge

- "CAFC Rejects Broad Eligibility For CBM Review, Adds to Program Uncertainty," *Andrews Kurth Kenyon IPR Blog* (January 4, 2017)
- "Federal Circuit Declines Review of PTAB Assignor Estoppel Ruling," *IP Litigator* (November/December 2016)
- "PTAB Rules Dealer Show Catalog Fails to Qualify as Prior Art," *Andrews Kurth Kenyon IPR Blog* (November 18, 2016)
- "Federal Circuit Declines Review of PTAB Assignor Estoppel Ruling," *Andrews Kurth Kenyon IPR Blog* (October 4, 2016)
- "CAFC Rejects Strict Requirement for Motions to Amend," *Andrews Kurth Kenyon IPR Blog* (September 15, 2016)
- "USPTO's Powers Emerge Intact from Supreme Court Row," *Intellectual Property Magazine* (September 2016)
- "PTAB Is Inconsistent On Qualifications For CBM Review," *Law360* (August 10, 2016)
- "Tension in the PTAB: How to Determine Whether a Patent Claims a Covered Business Method?" *Andrews Kurth Kenyon IPR Blog* (August 8, 2016)
- "CGH Wins Rare Grant of Motion to Amend," *Andrews Kurth Kenyon IPR Blog* (July 25, 2016)
- "Patent Trial Program Emerges Intact From Supreme Court Row," *Andrews Kurth Kenyon IPR Blog* (July 11, 2016)
- "Board Issues Mixed Rulings on Patent Eligibility After Enfish," *Andrews Kurth Kenyon IPR Blog* (June 14, 2016)
- "Federal Circuit: Estoppel Does Not Apply to Non-Instituted Grounds," *Andrews Kurth Kenyon IPR Blog* (May 31, 2016)
- "PTAB Grants Rare Claim Amendment in an IPR," *Andrews Kurth Kenyon IPR Blog* (May 25, 2016)
- "Federal Circuit Rules on Burden to Establish Patentability of Amended Claims," *Andrews Kurth Kenyon IPR Blog* (March 22, 2016)
- "Federal Circuit Approves PTAB Trial Approach," *Andrews Kurth Kenyon IPR Blog* (February 18, 2016)
- "Supreme Court to Hear Review of AIA Trial," *Andrews Kurth Kenyon IPR Blog* (January 19, 2016)
- "Board Continues Development of Estoppel Caselaw," *Andrews Kurth Kenyon IPR Blog* (November 30, 2015)
- "PTAB Ruling Breaks Ranks With Supreme Court and Federal Circuit," *Andrews Kurth Kenyon IPR Blog* (August 27, 2015)
- "PTAB Issues Second Ruling on Scope of Estoppel After Final Decision," *Andrews Kurth Kenyon IPR Blog* (June 1, 2015)
- "PTAB Rules on Scope of Estoppel Following Final Decision," *Andrews Kurth Kenyon IPR Blog* (April 24, 2015)
- "Federal Circuit Affirms PTAB in First Appeal After Final AIA Decision," *Andrews Kurth Kenyon IPR Blog* (February 5, 2015)
- "Some Business Method Patents are Ineligible for CBM Review," *Law360* (August 4, 2014)
- "Not So Fast! PTAB Rules Patent Not Covered Business Method," *Andrews Kurth Kenyon IPR Blog* (June 13, 2014)
- "New Covered Business Method Program Is Smashing Success For Patent Challengers," *Intellectual Property Today* (June 2014)
- "Patent Challengers Succeed With New Covered Business Method Program," *Andrews Kurth Kenyon IPR Blog* (April 10, 2014)
- "Covered Business Method Patents: One Year On," *Intellectual Property Magazine* (December 2013/January 2014)
- "Expanding Defenses To Inducing Infringement," *Intellectual Property Strategist* (December 2013)
- "*Commil USA v. Cisco*: Expanding Defenses to Inducing Infringement," *IP Strategist* (December 20, 2013)
- "A Madness to the Method," *The Intellectual Property Strategist* (August 2, 2010)
- "Bilski: 'Machine or Transformation' is not Exclusive Test for Patentable Processes," *International Law Office* (July 26, 2010)
- "Bilski: 'Machine or Transformation' not Exclusive Test for Patentable Processes," *Intellectual Asset Management* (July 21, 2010)
- "*MGM v. Grokster*: Questions Remain," *International Law Office* (October 10, 2005)
- "*Eolas Technologies v. Microsoft* – A Premium Royalty Base," *Patent Strategy & Management* (September 2004)
- "Getting Patently Offensive," *CNET* (January 21, 2004)

## Brian S. Mudge

- "Is It Actually Diluted Yet?" *Legal Times / IP* (July 21, 2003)
- "Personalized Medicine on the Horizon," *New York Law Journal* (February 3, 2003)
- "Importance of Contracts for Employee Inventions," *International Legal Strategy* (November 15, 2002)
- "Prosecuting Patents Under the Scrutiny of Festo's Rebuttable Presumption," *Intellectual Property Today* (September 2002)
- "The Future of Online Music and Copyright Law," *International Legal Strategy* (October 15, 2001)
- "PANEL TWO: Which Legal Rules Control?: Evaluating Arguments," *American University Law Review* (November 16, 2000)
- "Napster Must Die! TNE Online Interview: Brian Mudge," *The Net Economy* (November 16, 2000)
- "Copyright's Not Wrong," *Legal Times / IP* (October 16, 2000)
- "Trademark Practice in a Dynamic Economy: More Deals, More Laws, More Resources than Ever for the Trademark Practitioner," *Fordham Intellectual Property Media & Entertainment Law Journal* (December 1, 1999)
- "The Future of Electronic Commerce Law: Proposed Changes to the Uniform Commercial Code," *IEEE Communications Magazine* (February 1998)
- "The World Wide Web as a New Medium: From Links to Infringement," *IEEE Communications Magazine* (November 1997)

### BRIEFINGS, SEMINARS & SPEECHES

- Panelist/Presenter, "Evidence of Prior Art at the PTAB: Rigorous Proof — or Else," Intellectual Property Owners Association's IP Chat Channel (January 19, 2017)

### AFFILIATIONS

- American Bar Association
- American Intellectual Property Law Association

### IN THE NEWS

- Quoted in "AIA Review Denials Don't Always Free Patent Owners," *Law360* (April 9, 2015)