

## MVP: Katten's Floyd Mandell

By Dani Kass

*Law360 (November 13, 2019, 3:56 PM EST)* -- Floyd Mandell, the founder of Katten Muchin Rosenman LLP's intellectual property department and widely renowned trademark lawyer, recently brought in a key trademark victory for Gatorade, earning him a spot among Law360's 2019 IP MVPs.

### **WHY HE'S AN IP ATTORNEY:**

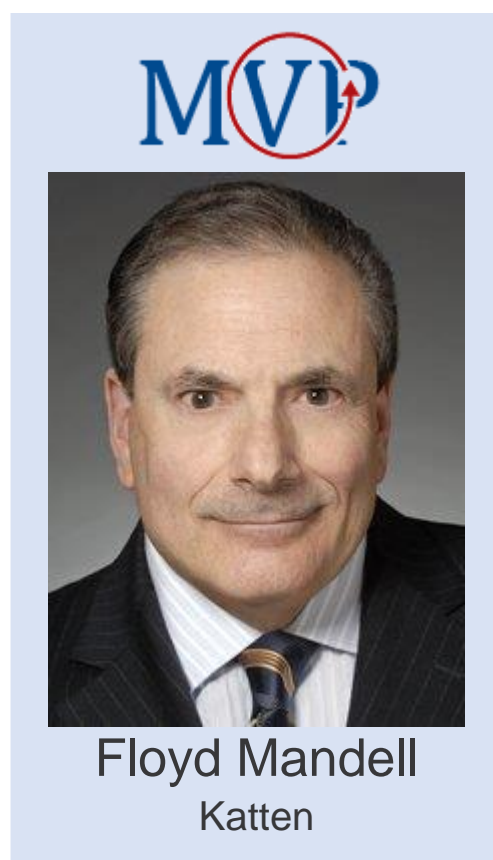
Coming out of law school, Mandell knew he wanted to go into litigation, so he was drawn to an offer from Pattishall McAuliffe that promised just that. The firm happened to be focused on trademarks and copyright, and he took right to it.

"It wasn't something that I had planned to do my whole life, it was just something that I fell into but also really loved it from the first day I started it," he said. "If you think about the kind of area of law this is, you are protecting consumers from confusion. You are protecting against people monopolizing descriptive terms. You are really looking toward the goal of fair competition, and you're dealing with people that regard their intellectual property assets as their most important assets of the company, so you're given a lot of responsibility."

### **HIS BIGGEST ACCOMPLISHMENT THIS YEAR:**

In August, the Seventh Circuit cleared Gatorade Co. to continue using its slogan, "Gatorade The Sports Fuel Company." Mandell had been representing the company in trademark infringement litigation lodged by a company called SportsFuel. He successfully argued that "sports fuel" was fair use, as it had been used widely in the nutritional product industry. The panel affirmed a district court's decision to grant summary judgment to Gatorade and its parent company PepsiCo.

"This was really one of the cases — I thought about it when I went to sleep at night, and I thought about it when I woke up in the morning," he said. "It was one of the cases that I felt I really wanted to win for Pepsi-Gatorade. I thought it was the right decision that the court came to, and I just felt very privileged that they put the confidence in me to trust me with this very important case, where there could have



been a lot of potential exposure. There are a lot of cases of this ilk that go the wrong way against large companies, and I did not want them to have to suffer a defeat in the end. It all worked out the way I had hoped."

Mandell noted that winning a trademark case on summary judgment was a "big achievement," as most of these suits involve at least one question of fact that can't be decided so early. He also noted that the David vs. Goliath nature of going up against a small company could have hurt the beverage giant.

"You're always concerned if you're representing the big company, of a jury who is going to have unwarranted sympathy — or maybe even some warranted sympathy, but the law doesn't support them — for the plaintiff," he said.

#### ***HIS BIGGEST CHALLENGE THIS YEAR:***

Mandell said his biggest challenge this year was managing his caseload, calling it a "very busy year." He said his pro bono caseload in particular had ticked up.

"When you're dealing with a pro se plaintiff whose whole life they feel is wrapped up into a case, gaining their confidence and helping them, that too is a challenge. Because you want to do the right thing in terms of the court, and you want to do the right thing in terms of the law, and you want to represent and do a good job for a party that's disadvantaged and really needs the help," he said.

His pro bono work ranges from civil rights to intellectual property cases. Recently, he represented a pro se plaintiff engaged in a copyright fight, bringing in a win for his client about a month ago. The client wrote a eulogy that was published without being attributed to him, so he sued the newspaper and its editors. Mandell was called in more than a year into the litigation.

"I developed a good relationship with opposing counsel, with the client, and we were able to settle the case not only for a monetary amount that he felt fairly compensated, but also a letter of apology," he said. "The court was so pleased when we went in, the court was about ready to schedule a mediation, and I said that was not necessary ... It was very humbling and gratifying that I was able to resolve what had been very contentious litigation and make this poor party happy, make opposing counsel happy and make the court happy."

He also serves as a mediator for both the International Trademark Association and the U.S. District Court for the Northern District of Illinois.

#### ***OTHER NOTABLE CASES:***

Among his many accomplishments, in November 2018, Mandell represented Microsoft when it reached a settlement with Community Health Systems, a Tennessee-based company that the tech giant accused of violating its software licensing agreements.

In February 2018, he helped Forever 21 dodge a trademark infringement suit filed by "Mickey" singer Toni Basil, who alleged the company was wrongly using her image and voice for advertisement. The court found she was trying to circumvent the fact that she no longer owns the "Mickey" sound recording copyright.

Quite notably, Mandell represented the entertainment industry as it took on peer-to-peer music-sharing service Aimster in the early 2000s. He's also represented Planet Hollywood, British retailer Topshop and Universal Studios as they faced trademark and copyright complaints.

**WHAT MOTIVATES HIM:**

Mandell said he's driven by his relationships with clients, friends, family and others.

"When people trust me to handle a matter, or if they trust me even as a sounding board, whether it's involving their career or a tough issue on the case, it's very gratifying, and it motivates you," he said.

**HIS ADVICE FOR JUNIOR ATTORNEYS:**

Mandell said his advice to younger attorneys, including his two sons, is that "you only have one career and one life, and you should feel professionally fulfilled and feel good about yourself."

"It's part of the reason why I mediate, it's part of the reason why I do pro bono work, because I feel good giving back something to the community to try to make a difference in people's lives, whether it's mentoring or helping somebody who is disadvantaged, and I do encourage younger lawyers to get out there," he said. "You should be going to the office and feeling good about yourself and feel like you're contributing."

— *As told to Dani Kass*

*Law360's MVPs are attorneys who have distinguished themselves from their peers over the past year through high-stakes litigation, record-breaking deals and complex global matters. A team of Law360 editors selected the 2019 MVP winners after reviewing nearly 900 submissions.*