

Edward Manzo

Patent Attorney's Pursuits Are Far from the Ordinary

by Dan Rafter



Edward D. Manzo is considered one of Chicago's top patent attorneys. The **Husch Blackwell LLP** partner has a secret: While he, as one colleague says, "lives and breathes" his profession, law is not his only passion.

Far from it, in fact.

What else fuels Manzo's life? He's an avid ballroom dancer. He was a saber fencer in college and still draws life lessons from the sport. In high school he played lead guitar in a rock band. After law school, he followed a new passion by learning to play classical guitar. Twenty years later, he took singing lessons.

Manzo even went through an Easy Rider phase, logging nearly 100,000 miles on various motorcycles while a college student in Brooklyn, N.Y.

"He's a bit of a Renaissance man," says Joshua Sarnoff, a professor of law at DePaul University and a longtime friend of Manzo.

But these varied interests don't distract Manzo from his passion for the law. The opposite is true, says Sarnoff.

"He's a very talented guy with extremely varied interests," Sarnoff says. "Those interests are part of what makes him so successful. He understands other people. He understands the art of persuasion. That's important. That's a

large part of what successful lawyers do. He's just a very intelligent person interested in a lot of things. Really, he's just a delight."

Career Approaches Fourth Decade

Manzo's desire to explore has served him well during his legal career. Kevin Noonan, a partner with Chicago law firm McDonnell Boehnen Hulbert & Berghoff, says Manzo is one of those few attorneys who "really can do it all."

Manzo is known for his patent work, which his colleagues refer to as "groundbreaking." But he's also thrived in IP litigation, Noonan says.

This legal success mirrors Manzo's life outside the courtroom: He's not afraid to experiment. And he never gives his various endeavors less than his full commitment.

"There are few people who do it all in that way. He is one of them," Noonan says. "The law is his interest and his passion. He loves the law. He thinks about it even when he's not at work. He writes about it even when he's not at work. There are some lawyers who treat their profession like a job. They do it when they are at work. Then they close up shop at the end of the day and put down their pencils. There are others who live and breathe the stuff. Edward is one of those."

Manzo is passionate enough about law to have enjoyed success in the field for close to 40 years. His fourth decade as a lawyer begins in 2015.

Like many skilled lawyers, Manzo almost chose a different career path. While an undergraduate and graduate student, his plan had been to work as a scientist or engineer. But a bad job market for those positions scuttled that idea.

"There was a severe market downturn for scientists and engineers while I was in the process of getting my science degree," Manzo says. "It was so devastating that even the professors were looking for other jobs and counseling students to look toward different careers."

Manzo's father, a hard worker, once saw his job disappear. That placed the family in a difficult financial situation, one that Manzo didn't want his own future family to suffer.

Manzo knew he could have stayed in school to finish some graduate degrees while he waited for the economy to recover. But what if the job market for engineers didn't improve?

"I could have found myself in the same situation that my father had been in," Manzo says. "I decided to think about a career outside of physics."

Law was a good fit for Manzo's temperament. But if it wasn't for a report he did in an undergraduate humanities class, this future patent expert might never have even considered law school.

Manzo's report centered on *L'Amistad*, a 19th-century schooner that transported slaves. In 1839, the African slaves aboard the ship took control of the vessel. Eventually, the USS *Washington* captured the ship near Long Island. The slaves, though, argued that they were free men and that they were no longer property.

The case went to the Supreme Court. In a landmark decision, the court ruled in favor of the slaves, returning to them their freedom.

"Studying that case, learning about the legal theories and procedures that went into the Supreme Court decision, was a gripping experience for me as an undergraduate," Manzo says. "I was attending an institution devoted to science and engineering. It was liberating to work on something that focused instead on law, legal theory, and fundamental human rights. It really opened my eyes to the potential of a career in law and helping other people in a more direct way."

Manzo took his LSAT and did well, although he didn't know what type of legal career he wanted. He had a degree in physics and nearly enough credits to claim a degree in math, too. This made him a good fit for firms that focused on patent law.

"I figured that by practicing intellectual property law," Manzo says, "I could stay connected to science and scientists through that route."

It turned out to be a wise decision. Manzo went to work full time in 1975 as an associate in a patent law firm in New York, N.Y. He stayed in the city until 1979 when he moved to Chicago, where he has thrived in patent law and intellectual property for more than 35 years.

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Manzo has never been bored. Intellectual property law remains fascinating to him. There is always something new to learn, he says.

"I have had an almost constant evolution throughout these 40 years," Manzo says.

When Manzo began his career in New York, he focused on various IP litigation and patent-application work. In addition to working on the first fetal heart monitor device and on some early video game inventions, he got involved in one of the earliest cases in the drug wars, a false-advertising case between rival pain relievers Anacin® and Excedrin®. In Chicago, Manzo spent much of his time in patent cases involving electrical products. He also became involved in major litigation during his earlier years, working with some of Chicago's most prominent litigators.

Today, Manzo has earned a reputation as a top patent lawyer. During his career, he's resolved patent and trademark infringement cases for the makers of semiconductors, consumer goods, computing systems, infrastructure materials and medical technology.

Writes and Edits in Spare Time

When Manzo wraps up a big case and finds he has some free time, he turns to other interests. These days, in addition to learning some new steps in the tango or quickstep, he prefers to write and edit.

Manzo is a frequent author and editor for Thomson Reuters Westlaw. He is the general editor for the 2014-2015 edition of the *Patent Jury Instruction Handbook* by Robert Matthews. He also is the editor and co-author of *Patent Claim Construction in the Federal Circuit*, an annual publication written with other members of the Intellectual Property Law Association of Chicago (IPLAC).

Manzo serves as author of *The America Invents Act: A Guide to Patent Litigation and Patent Procedure*, published annually by Thomson Reuters beginning in 2013, which the U.S. Supreme Court cited in June 2014 in its decision about indefiniteness.

Manzo has shared his knowledge with law students, too, as an adjunct professor at DePaul University College of Law. He taught the doctrinal course on patent law while the college was between professors.

"Some lawyers take a vacation when they have time on their hands at the end of a big litigation," Manzo says. "I usually decide to do some legal writing. Or maybe I'll prepare a speech or lecture. I've enjoyed that. It's a way to improve my own understanding of the law. It seemed like a good way to spend the downtime that I do have."

When Manzo isn't enjoying his infrequent downtime, he's usually adding to his reputation as one of the most skillful patent lawyers in the country. In 1982, he served on a legal team that made a bit of history in the field.

That year, the U.S. Congress established the only U.S. Court of Appeals defined solely by its jurisdiction instead of by geographical boundaries, the U.S. Court of Appeals for the Federal Circuit.

Manzo was on a legal team representing Mattel in a patent case against Magnavox. The judge who heard the original case ruled in favor of Magnavox, causing Manzo and his fellow lawyers to appeal the decision. This sent the case to the U.S. Court of Appeals for the Federal Court, the first district court appeal to be heard there after Congress created the court.

"We made a wonderful argument to the Federal Circuit," Manzo says. "The big opinion—the first opinion from this court—was ready to roll. We were all eager to see it."

Unfortunately, that decision was never unveiled. The parties settled the day before the Federal Court was going to give its ruling.

"I'm pretty sure they were going to reverse," Manzo says. "We were arguing a point of law that was very clear, and later cases completely agreed with the position we were arguing. But we shall never know."

This was far from Manzo's only big case. For example, he and his team once won five consecutive appeals at the Federal Circuit for a single individual patent owner. He even established an exception to Supreme Court law in one of these cases. Three of the other successful appeals resulted in the rewriting of the equitable defense of laches, while the fourth reversed an inequitable conduct ruling.

When the Legs Go

Manzo's law career today remains a busy and fulfilling one. It doesn't allow for too much of the free time he treasures. And Manzo doesn't expect this to change anytime soon.

That's good news. As Manzo's legal career advances, it remains a passion for him, but he is still taking dance lessons, singing, and exploring new horizons.

He points back to his days as a college fencer. The team fencing coach once told him that, as people age, it's inevitable that their legs will slow down. But that doesn't mean that aging fencers are destined to lose.

Instead, the best fencers compensate for aging legs with improved eye-to-hand coordination.

"They might not be able to get out of the way of an attack as fast as they once could, but their reflexes get much better. Their own attack is more accurate, and they can parry

faster," Manzo says. "They can still prevail. So fencing is a lifelong sport. Even though it is a vigorous sport, you can still succeed in it even as you get older."

Manzo isn't relying on improved eye-hand coordination to continue his legal success, of course. But he does have experience and knowledge on his side. Lawyers who've been in the field for decades pick up invaluable experience as they argue cases and craft winning settlements for their clients. They hone their own styles and methods, and learn how best to communicate with judges and juries. This experience can give them an advantage in the courtroom and while working with clients.

When Manzo is ready to step away from the law, don't think he will ever be bored.

"He's very erudite in a lot of ways," says Noonan. "Of course, Edward makes light of that."

As a final example of the varied interests that have left Manzo with such an interesting life, Noonan tells a story.

Manzo acquired an antique, Italian concert violin and became a patron of the Stradivari Society of Chicago. He permitted a deserving violinist, who was far from rich, to use the valuable violin while playing concerts throughout the United States and occasionally in other countries. When the violinist was leaving his position as a professor of violin with the San Francisco Conservatory of Music and heading to a new position in Montreal, Manzo held a special event in his Lake Forest residence, a violin recital in his home's drawing room.

"It was sort of this violinist's last hurrah with this great instrument," Noonan says. "So we all sat there and listened to this amazing performance."

"That's a good example of what Edward is all about. He's not your garden-variety person." ■



Manzo managed to avoid serious injuries while riding motorcycles in New York. The bikes included a Honda 350 Street Scrambler, a Yamaha and this Kawasaki Mach III 5000, pictured in 1971.