

## **Andrew S. MacKay**

Managing Partner

1999 Harrison Street  
26th Floor  
Oakland, CA 94612  
(510) 451-3300  
amackay@donahue.com



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## **Practice Areas**

- Intellectual Property
- Litigation
- Music and Entertainment
- Employment

## **Overview**

Andrew S. MacKay focuses his practice on trademark, copyright, and patent enforcement, commercial litigation, and employment. He has extensive experience representing clients at all stages of litigation, including at trials, appeals, arbitration, and mediation. He serves as the firm's Managing Partner, is the past Co-Chair of the firm's Litigation Practice Group, and is a core member of the firm's Intellectual Property Practice.

He is a leader in Donahue Fitzgerald LLP's successful prosecution of the internationally renowned "Happy Birthday To You" class action lawsuit, recovering \$14 million in licensing fees and obtaining a court order placing the world's most famous song in the public domain. He is a key member of the firm's intellectual property enforcement and litigation teams, which have recovered hundreds of millions of dollars and stopped the illegal distribution of hundreds of thousands of unauthorized products for clients such as Dyson Technology Ltd. and Autodesk, Inc.

In his trademark enforcement practice, Andrew polices and enforces his clients' trademark and trade dress rights in federal and state courts, as well as proceedings before the Trademark Trial and Appeal Board. He has extensive experience enforcing his clients' trademark rights in domain names, especially proceedings under the Uniform Domain Name Resolution Policy (UDRP). As one of the worldwide IP enforcement counsel for Autodesk, Inc., he represents it in litigation and UDRPs.

In addition, Andrew enforces copyrights in software, music, architectural drawings, video games, books, and artwork. His patent practice involves enforcement of both design and utility patents. He is one of UK-based Dyson Technology Limited's U.S. enforcement counsel for trademarks, patents and copyrights, and trademark counsel for Monster Inc.

Andrew's commercial litigation experience covers disputes involving a wide variety of business contracts and corporate issues. He has litigated employment cases involving discrimination and wage and hour issues, including many class actions; trust and estate disputes; and trade secret cases.

### **Representative Engagements**

- *Good Morning to You Productions Corp. et al. v. Warner/Chappell Music, Inc.*, C.D. Cal. Case No. CV 13-04460 (co-counsel) – The “Happy Birthday” class action lawsuit was described by the *New York Times* as “a lawsuit for the ages.” A leader in Donahue Fitzgerald's successful prosecution of plaintiffs' case, which resulted in the Court granting summary judgment on liability in his clients' favor. The Court ruled that Warner/Chappell Music, Inc., one of the world's top music publishers, had no rights to the song after it had collected millions of dollars in royalties from the song for decades. Shortly thereafter, Warner/Chappell Music, Inc. agreed to a settlement that repaid \$14 million in royalties and placed the song “Happy Birthday to You,” the world's most popular song, in the public domain.
- *Autodesk, Inc.* – As litigation and IP enforcement co-counsel managed a program combatting online unauthorized distribution of software products in over fifty successful UDRPs, including:
  - *Autodesk, Inc. v. Domain Admin/Hulmiho Ukolen Poste resante*, Case No. D2015-2014 (WIPO) (autocadd.com domain ordered transferred to complainant)
  - *Autodesk, Inc. v. Marek Jakubczak, The Blue Solutions Corp.*, Case No. D2015-1791 (WIPO) (iautocad.com domain ordered transferred to complainant)
  - *Autodesk, Inc. v. Web Admin, Ebills Online Services*, Case No. D2015-1358 (WIPO) (autocadzone.com domain ordered transferred to complainant)
- *Dyson Technology Ltd.* – As co-lead U.S. intellectual property enforcement counsel to cease online distribution of thousands of infringing bladeless fans and enforce Dyson's design and utility patents, trademarks, trade dress, and copyrights. Counsel for plaintiffs in *Dyson Limited, Dyson Research Limited, and Dyson Technology Limited v. BHN Intl LLC dba Lava Heat Italia et al.*, Case No. C13-4694 (JSC) (Northern District of CA), in which defendants agreed to cease all distribution of bladeless fans that infringe plaintiffs' trademarks and patents, destroy all inventory, and pay damages.
- *Maximum Games, LLC* – Lead intellectual property counsel. Matters include IP clearance and protection of video games. Lead counsel for defendant in *CMG Worldwide v. Maximum Games et al.*, Case No. 3:14-cv-05124-JST (Northern District of California), in which plaintiff alleged right of publicity and trademark claims on behalf of General Patton's heirs related to video game; parties entered into

- confidential settlement after defendant filed anti-SLAPP motion and motion to dismiss.
- Software & Information Industry Association (SIIA) – Co-lead intellectual property enforcement counsel for the principal trade association for the software and digital content industry. Work involves enforcement of SIIA members' copyrights in business software products.
  - Monster, Inc. – Intellectual property counsel on trademark matters.

## Professional & Community Affiliations

- Member, Intellectual Property, Litigation, and Employment Law Sections, Marin County Bar Association
- Member, Alameda County Bar Association

## Recognition

- Recipient, Anthony F. Draggonette Award for Outstanding Achievement in Civil Litigation Trial Practice, *University of California, Berkeley, School of Law*
- Recipient, American Jurisprudence Award for Civil Litigation Trial Practice

## Bar Admissions

- California

## Education

- **J.D.**, University of California, Berkeley, School of Law, 1998
- **B.A.**, Yale University, *summa cum laude*, 1995

## Recent Articles/News

- [Donahue Fitzgerald Recognized in the World Trademark Review's 2020 WTR 1000 Ranking](#), February 13, 2020
- [Spotify Settles \\$1.6B IP Suit Brought By Tom Petty's Publisher](#), *Law360*, December 20, 2018
- [Chinese Broadcaster Alleges Massive Copyright Theft – in the U.S.](#), *Variety*, May 3, 2017
- [Donahue Fitzgerald Honored to Present Award to Maximum Games](#)
- ['Happy birthday' Case May Change Content Licensing Practices](#), *Daily Journal*, *Daily Journal*, Vol. 67, Iss. 6, July 14, 2016
- [The Most Famous Song in the World Set Free: Impacts of the Happy Birthday to You Settlement](#), *IPWatchdog.com*®, July 28, 2016

- [Oh, Happy Day: Happy Birthday Enters the Public Domain](#), *Franchise Times*, July 2016
- [‘Happy Birthday’ Suit Resolved: The Most-Sung Song Is Free for All](#)
- [Donahue Fitzgerald Attorneys Wrap Up \\$14 Million Settlement in “Happy Birthday to You” Class Action Lawsuit](#)
- [Domain Name Enforcement](#)
- [Judge Rules “Happy Birthday To You” Now In Public Domain](#)

## Past Articles/News

- [Judge Rules “Happy Birthday To You” Now In Public Domain](#)

## Recent Speaking Engagements

- June 30, 2020, Fundamentals of Trademark Law in the Global Marketplace 2020 , Practising Law Institute (PLI), Live Webcast
- July 09, 2019, Fundamentals of Trademark Law in the Global Marketplace 2019 , Practising Law Institute (PLI), San Francisco, CA
- July 10, 2018, Fundamentals of Trademark Law in the Global Marketplace 2018 , Practising Law Institute (PLI), San Francisco, CA
- July 18, 2017, Fundamentals of Trademark Law in the Global Marketplace 2017 , PLI Practising Law Institute, San Francisco, CA
- October 13, 2016, Trademark Fundamentals , Oakland, California

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- *Fundamentals of Trademark Law in the Global Marketplace*, Practising Law Institute, San Francisco, CA, June 24, 2016