



haynesboone

THE IP BEACON[®]

The Intellectual Property Law Newsletter
of Haynes and Boone, LLP

**YEAR IN REVIEW 2015-2016
SPECIAL EDITION**

HAYNESBOONE.COM

Austin Chicago Dallas Denver Fort Worth Houston Mexico City New York
Orange County Palo Alto Richardson San Antonio Shanghai Washington, D.C.

© 2016 Haynes and Boone, LLP

WELCOME

Welcome! We are pleased to highlight some of our representative intellectual property-related client successes and publications over the past year that might be relevant to your business.

Our IP Department has grown by leaps and bounds to extend from California through Texas, Colorado, and Illinois, to Washington, D.C. and New York. Our team now includes 75 IP lawyers, 7 Patent Agents, and 5 Scientific Advisors. We participated in more than 30 *inter partes* review proceedings and a few other PTAB proceedings, and our patent prosecution team filed more than 1,500 U.S. patent applications and helped issue almost 1,000 U.S. patents just in 2015. Read on for updates on some of our litigation efforts last year.

RECENT CASES

ARGO DATA RESOURCE CORPORATION

Haynes and Boone defended ARGO Data Resource Corporation in a trade secrets case filed by Spear Marketing, Inc. (“SMI”) involving claims related to cash monitoring software. SMI contended that ARGO copied its software and written materials to create a competing cash management solution for major banks. ARGO removed the case to federal court on copyright preemption grounds, and after prevailing on SMI’s motion to remand the matter to state court, obtained a complete defense victory on summary judgment. SMI appealed the ruling to the Fifth Circuit Court of Appeals, and the Fifth Circuit fully affirmed the trial court’s rulings, making new law in the copyright preemption field in the process. ARGO is now seeking to recover its attorneys’ fees from SMI in the trial court.



TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY, LTD.

Haynes and Boone represents Taiwan Semiconductor Manufacturing Company (“TSMC”) in a patent infringement lawsuit brought against TSMC by DSS Technology Management, Inc. relating to a photolithographic method that may be used in the process of semiconductor fabrication. Specifically, DSS asserts a single, expired patent – US Patent No. 5,652,084. After TSMC prevailed on several claim construction issues, DSS’s counsel agreed to a stipulated judgment of non-infringement based on the court’s claim construction order. DSS pursued an appeal to the Federal Circuit. The briefing on the appeal has been completed and argument should take place in the Spring of 2016. Meanwhile, a concurrent IPR proceeding, in which we also represented TSMC, before the Patent Trial and Appeal Board (“PTAB”) resulted in a decision in December 2015 that all asserted claims of the same patent are invalid.



RECENT CASES

FASHION INSTITUTE OF TECHNOLOGY & BARNES AND NOBLE

This copyright infringement case – which was featured in the *New York Post* and various television news programs when it was filed—involved plaintiff’s claims that the Fashion Institute of Technology (“FIT”) and Barnes & Noble had made millions of dollars on sales of a “Back to School” backpack that she had designed while a student at FIT. Through aggressive early motion practice, Haynes and Boone was able to achieve dismissal of five of six of plaintiff’s claims, including her claim that she was able to claim copyright rights in the backpack itself. By establishing that plaintiff’s rights, at most, covered only her drawing of a backpack, which had modest value, we were able to achieve a quick and favorable settlement of the case.



MATTRESS FIRM

In this dispute involving the two largest mattress and bedding retailers in the U.S., Sleepy’s sought a preliminary injunction in the U.S. District Court for the Eastern District of New York to prevent our client, Mattress Firm, from opening MattressPro branded stores in the Carolinas and other mid-Atlantic states. Sleepy’s claimed that our client’s MattressPro mark infringes its registered mark, The Mattress Professionals. Our team handled extensive expedited discovery, including depositions in New York, Florida and Texas, and defeated Sleepy’s motion for preliminary injunction. Sleepy’s has appealed the district court’s decision denying a preliminary injunction to the United States Court of Appeals for the Second Circuit, and we are defending the lower court’s decision on appeal.



DRYBAR HOLDINGS LLC

Haynes and Boone represented Drybar in Superior Court of the State of California, County of Orange, in its assertion of trademark and other rights against DryBar Inc., a Canadian corporation (“DryBar Canada”). The suit arose out of DryBar Canada’s maintenance of certain email addresses and settings, as well as communications to our client’s customers and employees. Our client felt DryBar Canada’s communications were misleading, tortious and harmful. We asserted trademark infringement and several state tort claims against DryBar Canada. In connection with a resolution of that litigation, Drybar obtained rights to the domain name www.drybar.com.



PUBLICATIONS

Why an IPR Amendment Off Ramp Makes Sense

Law360 | October 16, 2015

Andrew Ehmke and David McCombs

A recently proposed amendment to Senate Bill 1137 introduces an improved process for handling claim amendments in Patent Office trials (*i.e.*, inter partes reviews, post-grant reviews and covered business method reviews). The new process provides an “off-ramp” for amendments that takes them out of the time-constrained trial schedule and puts them in an ordinary examination process. This off-ramp approach addresses the complaint of many patent owners that claim amendments are too difficult to obtain in Patent Office trials, while also benefiting petitioners and the Patent Trial and Appeal Board. It’s a win-win-win solution.

8 Tips For Drafting And Prosecuting Patents To Avoid IPR

Law360 | October 16, 2015

Thomas Kelton and David O'Dell

There is no way to make a patent invulnerable to challenge in an inter partes review (“IPR”), but there are ways to make a patent less appealing as a target for IPR and also less susceptible to a finding of unpatentability in an IPR.

We provide the practice tips discussed herein for fellow prosecution practitioners as well as for in-house counsel and client representatives who are consumers of prosecution services. The following practice tips describe actions that can be taken when a patent is drafted and prosecuted to make that patent stronger in the face of a potential IPR challenge. Spending a little more money and effort up front to draft a better patent application may pay off in real dollars when it comes time to enforce the patent.

High Court Underscores the Significance of Patent Invalidity and Non-infringement Opinions

The Houston Lawyer | October 9, 2015

Kyle Musgrove and Mini Kapoor

In *Commil USA, LLC v. Cisco Systems, Inc.*, the Supreme Court held that a good faith, but ultimately incorrect belief in invalidity of a patent is not a defense to induced infringement. Of course, where the claim is found invalid, such a holding still operates to foreclose liability because where a patent “is shown to be invalid, there is no patent to be infringed.”

Commil sued Cisco for induced infringement of Commil’s patent for implementing short-range wireless networks. The Federal Circuit stated that a good faith belief that the patent was invalid negated the requirement that the alleged infringer acted with intent to induce the infringement. The Supreme Court disagreed.

Haynes and Boone in IAM: Go-To Firms for Getting Your IPR Petition Instituted

IAM | September 18, 2015

Haynes and Boone and Wilmer, Cutler, Pickering, Hale & Dorr are the leading law firms when it comes to the institution of inter partes reviews “IPRs” at the USPTO, according to new analysis from Unified Patents. The research found that Haynes and Boone has the highest rate of institution for IPRs for its clients filing a petition when measured by case, while Wilmer leads the way in having the highest proportion of client claim reviews instituted. Fish & Richardson and Sterne Kessler Goldstein & Fox have had the most cases instituted overall.

Tom King in Managing IP Magazine: Proposed PTAB Changes Aim to Increase Balance

Managing IP Magazine | August 31, 2015

PTAB observers have reacted to USPTO’s extensive set of proposed rule changes, noting patent owners will benefit from proposals such as allowing testimonial

PUBLICATIONS

evidence in their preliminary response. The USPTO has followed up the rule changes by also suggesting a pilot program of having a single judge determine whether to institute an IPR.

Tom King, counsel in the Orange County office of Haynes and Boone, noted that the USPTO has decided to keep the rules for IPRs essentially unchanged.

FDA's Focus on Drug Appearance May Cause Ugly Problems

Law360 | August 25, 2015
Jeffrey Wolfson and Evert Tu

The FDA recently issued final guidance regarding the size, shape and other physical characteristics of generic-manufactured tablet and capsule dosage forms. The guidance noted that differences in physical characteristics of a dosage form could affect patient compliance and acceptability of medication regimens, or could lead to medication errors. The main reason for the FDA's guidance appears to be that many patients can experience difficulty swallowing tablets and capsules. But these issues can create impacts on the cost and availability of generic drugs, and may require an additional class of patents to be evaluated in clearing third-party patent rights when filing an ANDA and certain 505(b)(2) applications. For example, a larger tablet is harder to swallow than a smaller tablet, and oval tablets may be easier to swallow than round tablets. Other physical attributes that may affect a patient's ability to swallow, and thus patient compliance with a recommended dosing regimen, include coatings, weight, surface area, disintegration time and propensity for swelling.

Haynes and Boone Wins Fifth Circuit Appeal for ARGO

Law360 | August 18, 2015

On June 30, the Fifth Circuit Court of Appeals issued an important decision that clarified the scope of copyright preemption. Affirming a decision from the Northern District of Texas, the court held that the time-of-

filing rule applies to federal question jurisdiction, that preemption by the Copyright Act is appropriate when the type of work in suit falls within the subject matter of copyright, even if the work itself is not copyrightable, and that copyright preemption can apply to claims under the Texas Theft Liability Act ("TTLA"). The court denied plaintiff/appellant Spear Marketing Inc.'s motion for rehearing en banc on July 28.

Haynes and Boone Adds the Mavrakakis Law Group Lawyers, Expanding in Silicon Valley and Establishing Chicago Office

Haynes and Boone News | August 13, 2015

Haynes and Boone, LLP proudly announces the addition of the partners and associates of Mavrakakis Law Group LLP (MLG), an intellectual property boutique with offices in Palo Alto, Calif. and Chicago, Ill.

All MLG personnel will be joining Haynes and Boone, resulting in an expansion of the firm's Silicon Valley office and the establishment of a Chicago office. The announcement comes on the heels of the January opening of a Haynes and Boone office in Denver.

Moving to Haynes and Boone are Palo Alto MLG Partners Tom Mavrakakis and Brian Kwok and Chicago Partners Jim Shimota and Howard Levin. Mavrakakis is the former director of patent strategy at Apple Inc.

The U.S. Supreme Court Declined to Review *Oracle v. Google*, but the Billion-Dollar Case is Just Booting Up

Haynes and Boone News | August 3, 2015

On June 29, 2015, the Supreme Court denied Google's petition for certiorari, refusing to review the long-running battle over the scope of software copyright protection. The suit began almost five years ago when Oracle sued Google for infringing Oracle's copyright on portions of the popular Java software that allowed Java to communicate with other programs. After licensing negotiations over the software failed, Google copied portions of the Java code for use in its Android

PUBLICATIONS

operating system. While Google independently recreated much of the implementing code, it allegedly copied Java's declaring code that provided the taxonomy system Java used to name routinely-used functions. For example, the declaring code "java.lang.Math.max(1,2)" refers to a method for returning the greater of two numbers.

Internet TV in a Post-Aereo World

Texas Entertainment and Sports Law Journal

July 6, 2015

Thomas Williams, Dustin Johnson and Jason Bloom

Last June, the United States Supreme Court held that Aereo's system for transmitting over-the-air television broadcasts over the Internet violated copyright law, concluding, in a 6-3 decision, that Aereo both performed the television broadcasts at issue and did so "publicly." Aereo has ceased operations and filed bankruptcy, but both policymakers and media companies have taken steps to respond to the market demand Aereo sought to fill.

Haynes and Boone Adds Denver IP Capabilities with Addition of Experienced Denver Practitioner Robert Ziemian

Haynes and Boone News | June 26, 2015

Robert Ziemian, a seasoned intellectual property lawyer with deep experience obtaining and enforcing patents and trademarks on a global basis, has joined the newly established Haynes and Boone, LLP Denver office.

Firms Claim Bragging Rights in New Field of Patent Litigation

Law.com | March 6, 2015

If there really is a death squad for patents, it may not be found at the Patent Trial and Appeal Board. A more likely location is the Richardson, Texas, office of David O'Dell, chairman of Haynes and Boone's patent trials practice group.

Haynes and Boone has persuaded the PTAB to institute inter partes review in 72 cases—the most for any law firm according to an analysis of Lex Machina's new PTAB database. Haynes has been turned away without a trial only three times. Even in light of the PTAB's willingness to launch IPR proceedings, Haynes and Boone's 96 percent success rate is exceptionally high.

Richard Rochford in *Billboard Magazine*: The Real Reason Behind Taylor Swift Trying to Trademark 'This Sick Beat'

Billboard Magazine | February 6, 2015

Although she's notoriously protective of her brand, Taylor Swift isn't known to be especially litigious. But the singer has been on a trademark tear, attempting to register a handful of phrases in advance of her 1989 World Tour, which launches in Tokyo on May 5.

Rochford explains that unlike copyright law, trademark rights don't require the phrases to be absolutely unique or for the applicant to have coined them personally. Therefore, obtaining the rights requires an artist to prove that they're profiting off of a phrase associated with their brand. In Swift's case, that could mean she has already manufactured, say, a "Shake It Off" salt-and-pepper set. Adds Rochford, "She's saying she wants the ability to make money off of the things she's created. Whether the net she's cast is too wide remains to be seen."

2015 NEWSLETTERS

The IP Beacon®
August 2015

The IP Beacon®
March 2015

AWARDS



BEST LAWYERS IN AMERICA 2015

- Jeffrey Becker
- Randall Colson
- Russell Emerson
- David Harper
- David McCombs
- Phillip Philbin
- Thomas Williams



2015 TEXAS SUPER LAWYERS

- Purvi Patel Albers
- Jeffrey Becker
- Russell Emerson
- David Harper
- David McCombs
- Phillip Philbin
- Thomas Williams



2015 D.C. SUPER LAWYERS

- Philip Hampton
- Jeffrey Wolfson



CHAMBERS USA 2015

- Jeffrey Becker
- Randall Colson
- Russell Emerson
- David McCombs
- Phillip Philbin



WORLD TRADEMARK REVIEW 2015

- Purvi Patel Albers
- Jeffrey Becker
- David Bell
- Richard Rochford
- Philip Hampton
- Kenneth Parker



MANAGING IP MAGAZINE 2015 IP STARS

- Purvi Patel Albers
- Jeffrey Becker
- Randall Brown
- Andrew Ehmke
- David McCombs
- Kenneth Parker

IP QUIZ

Is there a likelihood of confusion?

Attempted registration

DASH
NEIGHBORHOOD

for retail store services
featuring gasoline

Registered marks



and DASH IN

for retail store services featuring
convenience store items and gasoline

According to the U.S. Trademark Trial and Appeal Board, the answer is NO.

The Board reversed the U.S. Trademark Office's final refusal of an application to register the mark DASH NEIGHBORHOOD covering "retail store services featuring gasoline" in light of prior registrations for DASH IN and D DASH IN and Design covering "retail store services featuring convenience store items and gasoline." Here, the Board found that the term DASH was so weak for retail store services that consumer confusion was unlikely even though the marks covered identical services.

As to the services, the Board presumed that the respective trade channels and classes of purchasers were the same since the goods directly overlapped. Further, as to the marks themselves, the Board noted that the amount of similarity between the marks necessary to find a likelihood of confusion decreases when the services are identical in part. It also determined that the respective connotations and commercial impressions of the marks were the same because of the shared term DASH.

These factors typically cut heavily in favor of finding likelihood of confusion.

Nevertheless, the fact that at least 17 different convenience stores across the nation operate under marks that incorporate the term DASH persuaded the Board that the term is weak for such services. As a result, consumers readily distinguish such marks based on minor differences, such as the presence of NEIGHBORHOOD versus IN.

On balance, the weak-nature of the term DASH in conjunction with the auditory and visual differences between the marks were sufficient to overcome the shared connotations and commercial impressions. Accordingly, the Board determined that DASH NEIGHBORHOOD is not likely to cause confusion with DASH IN.

In re SDI Petroleum, LLC, Serial No. 86011946 (TTAB November 30, 2015) [not precedential].

REPRESENTATIVE IP PRACTICE GROUP MEMBERS

Please contact any member of our team to discuss how we can assist with your specific IP needs:

<http://www.haynesboone.com/people>

	Purvi Patel Albers		Russell Emerson		Jennifer Lantz		David O'Dell
	John Bateman		Brent Folsom		Howard Levin		Kenneth Parker
	Jeffrey Becker		Theo Foster		Andrew Lowes		Phillip Philbin
	David Bell		George Gavin		Thomas Mavrakakis		Laura Prather
	Jason P. Bloom		Jonathan Hallman		David McCombs		Whitney Remily
	Randall Brown		Philip Hampton		Jamie McDole		Richard Rochford
	Tom Chen		David Harper		Joe Mencher		James Shimota
	Randall Colson		Alan Herda		Greg Michelson		Mark Tidwell
	Scott Cunning		Dustin Johnson		Kyle Musgrove		Greg Webb
	John Demarco		Thomas Kelton		William Nash		Glen Westreich
	Gary Edwards		Thomas King		Julie Nickols		Jeffrey Wolfson
	Andrew Ehmke		Brian Kwok		David O'Brien		Robert Ziemian

