

The IP Beacon[®]

The Intellectual Property Law Newsletter of
Haynes and Boone, LLP

2023 YEAR IN REVIEW



Welcome

Welcome to the 2024 edition of the *Haynes Boone IP Beacon® Year in Review*. We are pleased to highlight key intellectual property (IP) news from 2023, and some of our representative IP client successes and publications over the past year to promote your business success in 2024.

Our patent trials team represented clients in 30 *inter partes* reviews/PTAB proceedings that were filed in 2023, and our patent prosecution team filed over 2,200 U.S. patent applications and helped issue over 1,500 U.S. patents and even more foreign patents in 2023.

We invite you to read on for a review of important IP related cases, updates on some of our firm’s IP litigation efforts and key deals, and a few of the awards our intellectual property team is most proud of from 2023.

Year in Review – Key Case Decisions

AMGEN PATENT RULING’S IMPACT EXTENDS BEYOND LIFE SCIENCES



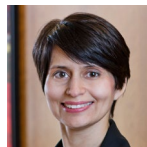
David
McCombs



Eugene
Goryunov



Brooke
Cohen

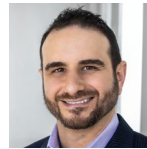


Dina
Blikshteyn

Law360 | September 13, 2023

In *Amgen Inc. v. Sanofi*, the U.S. Supreme Court in May further clarified the patent enablement requirement. At issue in the case were Amgen’s patents that claimed a wide class of antibodies that perform two cholesterol-lowering functions. The patent specifications, however, described only 26 antibodies that would belong to that class.

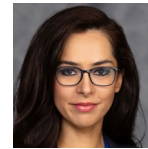
UNANIMOUS SUPREME COURT FINDS ROGERS TEST DOES NOT APPLY WHEN TRADEMARK IS USED AS SOURCE IDENTIFIER



David
Bell



Joseph
Lawlor



Asal
Saffari

Haynes Boone | June 8, 2023

On June 8, 2023, the U.S. Supreme Court issued a unanimous opinion in *Jack Daniel’s Properties, Inc. v. VIP Products LLC*, holding that where an alleged infringer uses a trademark to designate the source of its goods—even in part—the Rogers test does not apply. The *Rogers* test is intended to protect First Amendment rights and shields works of artistic expression from claims of trademark infringement unless certain exceptions are met. While the Court declined to weigh in on the merits of the *Rogers* test, this decision will serve to limit the application of the test to only those cases where a trademark is used *solely* in an artistic and expressive manner rather than to identify the source of the alleged infringer’s product.

US SUPREME COURT: THE MORE ONE CLAIMS, THE MORE ONE MUST ENABLE



David
McCombs



Eugene
Goryunov



Jonathan
Bowser

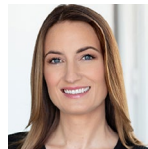
The Patent Lawyer | June 7, 2023

On May 18, 2023, a unanimous US Supreme Court in *Amgen Inc. v. Sanofi* affirmed a decision by the US Court of Appeals for the Federal Circuit that found Amgen's patents invalid for lack of enablement. The Court held that the methods recited in Amgen's patents did not enable a person skilled in the art (POSITA) to practice the claimed invention; that is, the reliable generation of antibodies.

HOW LIP IMPLANT RULING HAS AFFECTED DESIGN PATENT DISPUTES



Alan
Herda



Vera
Suarez



Tanner
Luttrull

Law360 | April 14, 2023

Following the U.S. Patent and Trademark Office's Manual of Patent Examining Procedure, or MPEP, the Examiner reviewing the application rejected the claimed lip implant design over prior art disclosing an art tool.

The rejection was appealed to the Patent Trial and Appeal Board, which, also in accordance with the MPEP, affirmed the Examiner's rejection. Finally, the case was appealed to the U.S. Court of Appeals for the Federal Circuit. In this appeal, the Federal Circuit reversed the Examiner's rejection and overturned patent office precedent as set forth in the MPEP.

TAKEAWAYS FROM PTAB'S PRECEDENTIAL DECISION ON PRIOR ART ANALYSIS FOR POST-AIA PATENTS



David
McCombs

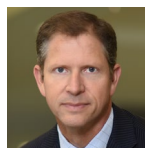


Eugene
Goryunov

IPWatchdog | December 7, 2023

In March 2023, the Patent Trial and Appeal Board (Board) addressed in *Penumbra, Inc. v. Rapidpulse, Inc.*, IPR2021-01466, Paper 34 (Mar. 10, 2023), a key issue in *inter partes* reviews: how to establish a reference patent as prior art based on the filing date of an earlier-filed application, such as a provisional. The Board held that the requirements of the Federal Circuit's decision in *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015), do not apply for post-America Invents Act (AIA) patents. *Penumbra*, IPR2021-01466, Paper 34 at 29-35. On November 15, 2023, U.S. Patent and Trademark Office (USPTO) Director Kathi Vidal designated the *Penumbra* decision precedential. This article explores the evolution of the law on this issue.

COMMERCIAL, PROFESSIONAL PERSPECTIVE: MOVING FORWARD IN THE FACE OF AN ITC EXCLUSION ORDER



Kenneth
Parker

Bloomberg Law | June 14, 2023

An investigation before the U.S. International Trade Commission (ITC) is complete, and the ITC issued an exclusion order preventing the respondent from importing infringing goods into the U.S. A party might wonder: Now what?

Recent Cases | IP Transactions



- Haynes Boone was hired by **SeaSpine Holdings Corporation** (recently purchased by long-time client Orthofix) to take over from prior counsel two patent-infringement cases in Delaware: *Jackson v. SeaSpine Holdings Corp.*, 1:20-cv-01784-RGA and *Barry v. SeaSpine Holdings Corp.*, 1-21-cv-00806-RGA . The Jackson case is a nine-patent case against prolific inventor and plaintiff Dr. Roger Jackson and is set for trial in December. The Barry case is stayed pending the outcome of related litigation. Both cases relate to spinal implants.

- Haynes Boone helped **IBM** settle a lawsuit by Isix IP LLC claiming that IBM’s integration software solutions infringed Isix’s patent (22-cv-201, W.D. Tex.). Settlement was reached after Haynes Boone obtained a favorable claim construction ruling and filed an *inter partes* review (IPR) proceeding (IPR2022-01488).

- In 2022 and 2023 we obtained two patents on a new fracking procedure called “continuous pumping” on behalf of **Downing Wellhead Equipment, Inc.**, and in May 2023 we sued Intelligent Wellhead Systems (IWS) in the United States District Court for the District of Colorado for infringing the two patents. That case is pending, along with two related *inter partes* review proceedings before the Patent Trial and Appeal Board.

- Haynes Boone represented Swedish multinational communication and technology services corporation, **Ericsson**, in district court litigation brought by non-practicing entity Nodal Technologies LLC. Ericsson intervened in the suit to defend its LTE technology and its customer; T-Mobile (2:22-cv-176, E.D. Tex.) Ericsson reached an early, favorable settlement. Haynes Boone also represents Ericsson in multiple *inter partes* review (IPR) proceedings before the PTAB.

Recent Cases | IP Transactions

■ We represented **Conformis** in several patent-litigation cases relating to custom-made implants and related patient-specific instruments. In the first, *Osteoplastics, LLC v. Conformis, Inc.*, 1:20-cv-00405-MN-JLH (D. Del.), we defended Conformis against allegations of infringing eight patents. The case settled favorably just before a scheduled trial in July 2023.

■ We also represented **Conformis** in several plaintiff-side cases enforcing Conformis's extensive patent portfolio. In *Conformis, Inc. v. Exactech, Inc.*, 8:21-cv-01348-KKM-TGW (M.D. Fla.), we asserted five patents. The case settled after a favorable Markman decision. Likewise, *Conformis, Inc. v. DePuy Synthes, Inc.*, 1:21-cv-00640-RGA (D. Del.)—a seven-patent case—also settled following a favorable Markman decision.

■ Haynes Boone represents **Hartmann US Inc.** in a patent infringement suit in the Eastern District of Missouri. Hartmann US Inc. is the U.S. subsidiary of the Danish manufacturing company Brødrene Hartmann A/S. Hartmann is the world's leading manufacturer of moulded-fibre egg packaging, a market-leading manufacturer of fruit packaging in South America and India and the world's largest manufacturer of technology for the production of moulded-fibre packaging.

■ Haynes Boone is **Continental Automotive's** IPR counsel. Since it was first retained, the firm has helped Continental achieve advantageous outcomes in numerous highly contentious litigations. The firm has also advised Continental in various FRAND disputes to aid the client to achieve favorable business solutions to international sales disputes.

■ Haynes Boone advised **Brand Engagement Network Inc. (BEN)** on the IP issues in connection with a business combination with special-purpose acquisition company DHC Acquisition Corp. (Nasdaq: DHCA) and a PIPE financing. The transaction would result in BEN, a provider of personalized customer engagement AI technology, becoming a U.S. publicly listed company with an implied initial enterprise value of approximately \$358 million. The transaction is subject to stockholder approval and other customary closing conditions, including receipt of regulatory approvals.

■ In 2023, we represented **Southern Marsh** in more than 10 state and federal trademark lawsuits across three different states. In each of the case, we have obtained favorable results against competing entities in order to protect Southern Marsh's rights in its family of Southern Marsh trademarks, including its signature duck logo.

■ Haynes Boone client, **REPAY**, a public company that provides payment processing services, was sued by one of its competitors for patent infringement based upon the method it uses for payment processing in the Eastern District of Texas. REPAY filed a motion to dismiss the case for lack of personal jurisdiction or alternatively to transfer the case to Georgia where it is based and is also fully defending the case, including based upon non-infringement and invalidity of the asserted patent.

Practice Highlights



ARTIFICIAL INTELLIGENCE AND DEEP LEARNING

Haynes Boone has been active in the artificial intelligence (AI) space for more than 30 years. Today AI and machine learning (ML) continue their rapid growth and profound impact on the world, transforming industry after industry. As AI grows, so does the need for intellectual property and regulatory protection in the AI space. According to a recent World Intellectual Property Organization (WIPO) report, *Technology Trends 2019: Artificial Intelligence*, nearly 340,000 patent families and more than 1.6 million scientific papers related to artificial intelligence were published from 1960 until early 2018, and the number of patent applications filed annually in the AI field grew by a factor of 6.5 between 2011 and 2017.

Haynes Boone's multidisciplinary AI group brings together the technical knowledge and industry experience to effectively advise clients operating in this rapidly evolving space. The AI group helps companies and individuals safeguard their core products and methodologies. Our experience covers all aspects of AI, machine learning, and deep learning technologies, including:

- Developing domestic and international patent portfolios related to AI applications in autonomous driving, machine learning, natural language processing, industrial automation, and anomaly detection in utility and ad hoc wireless networks
- Representing clients in post-grant proceedings covering locating technologies that rely on neural networks
- Drafting patents for autonomous control of robotic operations in energy distribution systems
- Developing a global patent portfolio on deep learning research and engineering for customer relationship management (CRM) platform
- including natural language processing (NLP), commonsense reasoning, and computer vision
- Developing robotic-assisted surgical system patent strategy and protection
- Managing the contractual and copyright issues that relate to the collection and use of training data to develop AI models and algorithms
- Evaluating bias, hallucination, and other issues in developing machine learning technologies
- Analyzing and taking account of AI-related legal and regulatory regimes being developed that affect the operation of AI/ML-using business enterprises

Practice Highlights

BIOTECHNOLOGY

Biotechnology sits at the heart of our Life Sciences practice and covers a complex intersection of technology fields to make or modify products or processes through the manipulation of living or biologically active materials. These manipulations lead to critical breakthroughs in many fields ranging from energy and the environment to food and health.

Biotechnology inventions face a minefield of legal issues including patent eligible subject matter, written description, enablement, double patenting, and patent term. Despite the global increase in biotechnology R&D investment and the life-saving innovations being developed, the IP landscape has become increasingly complex and difficult to navigate for biotechnology companies. More than ever, it is critical for biotechnology companies to find the right partner to develop strategic IP portfolios and develop supply chains and contractual arrangements that successfully navigate this challenging and rapidly evolving legal landscape.

The Biotech practice features a robust and expanding team, most of whom hold advanced degrees in complementary technical fields, and we leverage this highly skilled, cross-disciplinary group to provide premier support. Our Biotech IP team has managed a broad spectrum of biotechnology areas, including:

- Protein and Pharmaceutical Therapeutics
- Immunotherapies
- Vaccines
- Monoclonal Antibodies, Antibody Drug Conjugates, T-cell Engagers and CAR-T Cells
- Cellular Therapeutics
- Genetic Engineering
- Synthetic Oligosaccharides
- Computational Biology and Bioinformatics
- Molecular Biology and Genomic Sequencing
- Molecular Diagnostics and Software
- Bioprocess Manufacturing
- AI/Machine Learning as applied to the Life Sciences Sector

SELECTED CLIENT REPRESENTATIONS

We represented **EutilexCo. Ltd.**, a global immunotherapeutics company that develops targeted therapies for various hematologic and solid cancers, in patent prosecution and related counselling support. This work included assisting with IP coordination, filings, and patent application preparation and prosecution.

Haynes Boone's Life Sciences team continued work with **TeneoBio** (a division of Amgen) on the world-wide prosecution of several different patent families relating to monoclonal antibody therapeutics and their methods of use. The team served as sole patent counsel to TeneoBio and advised on all IP-related aspects of Amgen's acquisition in 2021.



Practice Highlights

INTERNATIONAL TRADE COMMISSION SECTION 337 PROCEEDINGS

Our IP litigation team has successfully prepared for and tried numerous Section 337 investigation and hearings before the ITC, relying not only on extensive trial experience but on particular knowledge of the ITC's judges, rules, and procedures. This proven track record and experience with ITC procedures and personnel ensure that our teams are well suited to meet the high demands of ITC schedules and cases to obtain the best possible results for our clients.

Our team includes a former head of the ITC's Section 337 legal office as well as lawyers who have represented clients in investigations. In particular, Ken Parker and Rich Rochford have worked together as an effective, efficient, and successful team in these intense cases. Ed Lebow also served as an Assistant General Counsel of the U.S. ITC before entering private practice and handles various other ITC matters as described below.

Our frequent appearances before the ITC give us significant familiarity and knowledge of specialized

rules for discovery and evidentiary hearings (trial). We also have in-depth experience with a wide range of technologies and products, including semiconductors, electronic devices, medical devices, pharmaceuticals, software, and smartphones.

As part of our extensive experience in successfully litigating ITC cases, we also have worked with U.S. Customs and Border Protection officials to implement or enforce or ensure compliance with ITC exclusion orders. This unique knowledge of enforcement issues gives our clients the foresight vitally needed in a constantly changing global marketplace.

Anti-Dumping Proceedings and Other ITC Matters
In an IP-adjacent practice note, we also obtain relief for U.S. industries injured by dumped or subsidized imports and successfully defends foreign companies against such actions. We are especially adept in advising clients on how to comply with U.S. trade laws and avoid costly legal proceedings. We regularly deal with OFAC sanctions, export controls, USMCA, anti-bribery issues under the Foreign Corrupt Practices Act (FCPA), and customs matters such as countervailing duties.

Publications

IPR tricks of the trade: changes to expect at the USPTO in 2023

Reuters | February 1, 2023

David McCombs, Eugene Goryunov, Jonathan Bowser

On April 5, 2022, after more than one year without a Senate-confirmed Director, Kathi Vidal was confirmed as the new Director of the U.S. Patent and Trademark Office. She got to work right away. Director Vidal first issued a binding Guidance memorandum that clarified the Patent Trial and Appeal Board's application of the controversial Fintiv factors for discretionary institution to deny a petition for *inter partes* review or post-grant review of a patent involved in parallel litigation in federal district court or the International Trade Commission (Fintiv Guidance).

Trial Lawyer's Guide to Post Grant Patent Proceedings

LexisNexis | February 3, 2023

David McCombs, Eugene Goryunov, Theo Foster

Terminal Disclaimers and Common Ownership

Patent Lawyer | February 8, 2023

David McCombs, Eugene Goryunov, Austin Lorch

David McCombs, Eugene Goryunov, Alan Wang & Austin Lorch of Haynes Boone LLP and Tom Kaczmarek of Continental review the conditions of terminal disclaimers and the grounds for common ownership to identify necessary steps for maintaining patent protection when multiple parties are involved.

IPR Tricks of the Trade: Don't Give Up, Rehearing is Possible

Thomson Reuters Westlaw | March 1, 2023

Eugene Goryunov, David McCombs, Jonathan Bowser

The Patent Trial and Appeal Board's rules permit any party that is dissatisfied with a decision of a PTAB panel to file a request for rehearing. A dissatisfied party may also request review by the PTAB's Precedential Opinion Panel (POP). Many practitioners perceive the chances of success on rehearing as low because the requesting party must show the panel misapprehended or overlooked arguments or evidence.

Paper Patents Are No More!

Haynes Boone | March 2, 2023

Vincent Shier Ph.D., Nora Titus

Over the past few years, the U.S. Patent and Trademark Office has worked towards reducing the duration of time between filing a patent application and either abandonment or issuance of the application, otherwise known as "patent pendency." Various measures included hiring more examiners and changing the criteria with which examiners are evaluated.

Is the Standard Essential Patent (SEP) a certainty for the field of uncertainty – quantum technology?

Reuters | March 9, 2023

Eric Horsley, Raghav Bajaj

Where the first quantum revolution upended our understanding of the world, the second quantum revolution is radically altering how we design our technology. Just as the semiconductor replaced vacuum tubes and is now ubiquitous in our technology, the implements of quantum computing, quantum communication, quantum sensing, and quantum optics are likewise poised to replace current technologies.

FTC Orders 8 Social Media Giants to Report on Their Efforts Combating False Advertising and Scams

Haynes Boone | March 17, 2023

Tiffany Ferris, Joseph Lawlor, Emily Ketterer

On March 16, 2023, the Federal Trade Commission voted 4-0 to issue Section 6(b) Orders to eight social media and video streaming platforms, including Meta, Instagram, YouTube, TikTok, Twitter, Pinterest, and others. Within 45 days of receiving the orders, these companies must either divulge how they have monitored and reviewed advertising on their platforms since 2019 or petition to limit or quash the Section 6(b) Orders.

Chatbot Patents Are Likely to Spark AI Wars

Law360 | April 3, 2023

David McCombs, Dina BlikshTEYN, Brett Bostrom, Eugene Goryunov

Over the past year, artificial intelligence tools have been released to the public in waves, demonstrating AI's impressive, and often amusing, abilities.

OpenAI, an AI research organization, has been one of the principal contributors of these tools, such as the DALL-E image-generation engine and the Chat Generative Pre-trained Transformer chatbot, known as ChatGPT.

The Sun Rises Over the European Unified Patent Court: Key Considerations

Bloomberg Law | April 21, 2023

Jeffrey Wolfson, Kalyani Joshi, Caylee Phillips

The European Agreement on a Unified Patent Court (UPCA) was further ratified by Germany on February 17, 2023, and with this ratification the UPCA can now proceed. Accordingly, the UPCA will enter into force on June 1, 2023, marking the beginning of the Unified Patent Court (UPC) and the Unitary Patent (UP). The UP is a single patent that will have effect in all participating countries of the UP system.

IPR Tricks of the Trade: Federal Circuit Clarifies Standard for IPR Estoppel

Westlaw Today | April 24, 2023

David McCombs, Eugene Goryunov, Jonathan Bowser

Patent Trial and Appeal Board (PTAB) post-grant validity challenges — for example, *inter partes* review — are frequent components of a patent litigation strategy for defendants. Challenging the validity of a patent in an IPR does not come without risk, however.

Using AI for Competitive Advantage

The Journal of Robotics, Artificial Intelligence and Law | May 3, 2023

David McCombs, Dina BlikshTEYN, Eugene Goryunov, Nicolette Nunez

Financial institutions around the world have made many uses of artificial intelligence (AI), including the “automated trading and investment discovery, trading strategies, robo-advisors, voice-based commerce, customer behavior analysis, and chatbots for customer services, identity verification and fraud detection.” In fact, some banks, such as J.P. Morgan Chase, have fully funded and developed entire AI research sectors intended to find innovative and productive ways to use AI in investment banking.

Guidance for ‘Sustainable’ Claims After Dismissal of H&M ‘Greenwashing’ Class Action

Westlaw Today, Reuters | June 2, 2023

Tiffany Ferris, Joseph Lawlor, Emily Ketterer

On May 12, a federal judge in the Eastern District of Missouri dismissed a proposed class action lawsuit against H&M for its “Conscious Choice” line of products based, in part, on a finding that plaintiff’s allegations that H&M’s “sustainable” marketing violated California and Missouri consumer protection laws, as well as the FTC’s Guides for the Use of Environmental Marketing Claims, known as Green Guides, were not supported (*Abraham Lizama, et al., v. H&M Hennes & Mauritz LP*, 4:22-cv-01170 (E.D. Mo)).

Imitation in Patent Applications: The Sincerest Form of Flattery, or Trouble in Paradise?

Intellectual Property and Technology Law Journal | June 9, 2023

Brett Bostrom, Jeffrey Wolfson

Associate Brett Bostrom and Partner Jeffrey Wolfson authored an article in *Intellectual Property and Technology Law Journal* discussing the slippery slope of imitation in patent applications.

Protecting innovation is an economic driver. Yet some enterprises treat inventions as a virtual commodity. In some industries, the high demand for efficiency in patent application drafting creates incentives to recirculate descriptive materials.

Fed. Circ. Args Don’t Bode Well For Patent Term Adjustment

Law360 | June 15, 2023

Vincent Shier Ph.D.

Patent term adjustment, or PTA, plays an essential role in ensuring the intention of Congress — to guarantee to inventors an effective 17-year patent term in cases where U.S. Patent and Trademark Office delays would otherwise shorten that effective patent term — is preserved.

Which State Leads the Way? A Comparison of Data Privacy Laws in Texas and California

The Texas Lawbook | June 16, 2023

Gavin George

The absence of comprehensive federal privacy regulation in the United States has created an open field for states to take the lead in addressing individual data protection and privacy rights. The first state to take the field was California, which

enacted the comprehensive California Consumer Privacy Act (CCPA) in 2018. More recently, Texas joined the game by passing HB 4, the Texas Data Privacy and Security Act (TDPSA), making Texas the 10th state to enact a comprehensive privacy statute. While both California's and Texas' laws share the common goal of safeguarding personal information and empowering consumers with new data rights, there are some significant differences in scope and coverage.

Will National Security Concerns Obstruct Quantum Computer Finance?

Inside Quantum Technology News | June 26, 2023
Tanner Luttrull, Edward Lebow

Most quantum computing companies are on the hunt for two things (1) a way to develop and/or use a fault-tolerant quantum computer that provides an industry advantage and (2) funding to enable that development. There are, however, some hurdles and pitfalls quantum computing companies should avoid in their quest for cash.

Fed. Circ. Decision Offers Lessons In Analogous Art Tests

Law360 | June 26, 2023
Clint Wilkins Ph.D.

The recent *Sanofi-Aventis Deutschland GmbH v. Mylan Pharmaceuticals Inc.* decision reminds petitioners in *inter partes* reviews of the importance of sufficiently addressing a long-standing threshold issue that seems to have been recently rediscovered: whether a reference constitutes analogous art compared with the challenged patent and therefore qualifies as prior art.

Downing Wellhead Equipment Enforces Its Patents Covering Continuous Pumping in Hydraulic Fracturing Operations

The Patent Lawyer | June 27, 2023
Alan Herda, Russ Emerson, Zachary Halbur

The successful combination of hydraulic fracturing (or “frac”) technology with horizontal drilling dramatically increases production in tight-rock petroleum reservoirs and has resulted in a decades-long “shale revolution” in the United States. Frac technology has evolved over the years, and this evolution has led to an unprecedented run up in the domestic production of oil and natural gas.

The Supreme Court Leaves Patent Eligibility in Flux

The Patent Lawyer | July 7, 2023

David McCombs, Eugene Goryunov, Dina Blikshteyn, Michael McCarty, Nora Titus

In May 2023, the U.S. Supreme Court declined to hear three cases concerning patent eligibility: *Interactive Wearables LLC v. Polar Electro OY*, *Tropp v. Travel Sentry Inc.*, and *Avery Dennison Corp. v. ADASA Inc.* This is despite the U.S. solicitor general, the U.S. Patent and Trademark Office (USPTO), and the bar asking for clarity and certainty in applying the now infamous patent eligibility test.

IPR Tricks of the Trade: Evolving Standards for Stipulations to Avoid Discretionary Denial

Thomson Reuters Westlaw Today | July 17, 2023

David McCombs, Eugene Goryunov, Jonathan Bowser

Inter partes review (IPR) proceedings before the Patent Trial and Appeal Board (PTAB) are frequent components of patent litigation disputes. As part of a defense strategy, a party accused of patent infringement often files an IPR petition to challenge the validity of the asserted patent(s).

Navigating the Murky Waters of Patent Claims Involving AI After Amgen v. Sanofi

Drug Discovery Online | August 30, 2023

David McCombs, Eugene Goryunov, Dina Blikshteyn

Partners David McCombs, Dina Blikshteyn, and Eugene Goryunov and Associate Matthew Beck authored an article in *Drug Discovery Online*, a publication of Life Science Connect, discussing the possible implications that stem from a U.S. Supreme Court unanimous ruling in *Amgen Inc. v. Sanofi* on the Section 112 enablement requirement for patents. In May 2023, a unanimous U.S. Supreme Court in *Amgen Inc. v. Sanofi* issued a ruling on the Section 112 enablement requirement for patents.

Goryunov Authored 2 Chapters in Global Legal Insights 2023 Litigation and Dispute Resolution

Haynes Boone | August 22, 2023

Eugene Goryunov

Partner Eugene Goryunov co-authored two chapters in *Global Legal Insights 2023 Litigation and Dispute Resolution* book with Kenneth Adamo, principal in the law office of KRadamo, discussing Fintiv stipulations in *inter partes* review proceedings and USA jurisdiction

IPR Tricks of the Trade: 2023 Revised Director Review Process

Thomson Reuters Westlaw Today | August 22, 2023
David McCombs, Eugene Goryunov, Jonathan Bowser

In *United States v. Arthrex, Inc.*, 141 S. Ct. 1970 (2021), the U.S. Supreme Court held that the U.S. Patent and Trademark Office (USPTO) Director must have the authority and opportunity to review a Patent Trial and Appeal Board (PTAB) final written decision before it becomes the decision of the agency. In response to Arthrex, the PTAB implemented an interim Director review process. “USPTO implementation of an interim Director review process following Arthrex.”

Evidence of copying by IPR petitioner may be enough for secondary considerations to overcome showing of obviousness

The Patent Lawyer | September 20, 2023
Eugene Goryunov, Adam Erickson

In *Volvo Penta v. Brunswick* (2022-1765), evidence of copying overcame the showing that all claim limitations were obvious in light of the prior art.

The goal for petitioners in an *inter partes* review is pretty straightforward: find prior art that teaches all of the claim elements and show that a POSITA would have been motivated to combine them.

Mergers and the 35 U.S.C. § 315(b) patent IPR institution time bar

Westlaw Today | October 24, 2023
Andrew Lowes

Under 35 U.S.C. § 315(b), “[a]n *inter partes* review may not be instituted if the petition is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.”

Interpretation of this provision has presented many interesting dilemmas for parties, the Patent Trial and Appeal Board (PTAB), and the U.S. Court of Appeals for the Federal Circuit alike in recent years.

White House executive order expands regulation of artificial intelligence

Westlaw Today | November 8, 2023
David McCombs, Eugene Goryunov, Dina Blikshsteyn, Jonathan Bowser

On October 30, 2023, President Biden issued

an Executive Order that seeks to establish new standards for the development, training, and implementation of artificial intelligence (AI) tools. Bypassing Congress, the Executive Order creates a national policy on the regulation of AI that focuses primarily on AI developers and the data used in the implementation of AI tools.

Section 112 concerns in an IPR at institution and final written decision

Thomson Reuters, Daily Docket | November 16, 2023
David McCombs, Eugene Goryunov, Jonathan Bowser

An *inter partes* review (IPR) can only challenge claims of an issued patent on anticipation or obviousness grounds, under 35 U.S.C. §§ 102 and 103, based on patents or printed publications. Patent claims cannot be challenged or cancelled by the Patent Trial and Appeal Board (PTAB) under the definiteness, written description, or enablement requirements of 35 U.S.C. § 112. *Cuozzo Speed Tech. v. Lee*, 136 S. Ct. 2131, 2141-42 (2018).

How might an AI Model affect vehicle accident liability?

The Patent Lawyer | December 5, 2023
David McCombs, Eugene Goryunov, Calmann Clements

The automobile has been around for well over a century. As such, society has in place a legal framework for determining liability in case of an accident. When an automobile is involved in an accident, the law determines whether that accident was the result of a negligent driver or a defective automobile and then assigns liability as appropriate.

Patents: IPR year in review 2023

Westlaw Today | December 22, 2023
David McCombs, Jonathan Bowser, Eugene Goryunov

Inter partes reviews (IPRs) are a frequent component of patent litigation disputes. For example, a party accused of patent infringement in U.S. district court may challenge the validity of claims of the asserted patent in an IPR. The Patent Trial and Appeal Board (PTAB) of the U.S. Patent and Trademark Office (USPTO) adjudicates IPRs. Within the statutory guidelines set forth in the America Invents Act (AIA), the USPTO Director has authority to implement changes to the conduct of IPR proceedings.

Giving Back



Our firm actively participates in various charitable and civic organizations dedicated to improving the communities we serve, providing free legal services to residents in need, and increasing diversity in the legal profession. Our lawyers are members and serve on the boards of organizations engaged in economic development, public policy, education, arts and culture, and racial equity. We provide substantial monetary donations and services to myriad organizations through our community engagements. Further, Haynes Boone boasts a strong legacy of pro bono work, and this past year was no exception as we provided more than 15,000 pro bono hours to clients valued at nearly \$12 million.

We are proud to share some of our most recent achievements to give back to our communities.

- The Haynes Boone Foundation and two partners, Purvi Patel Albers and David McCombs proudly supported “**Kinship**,” the latest exhibit in the **Smithsonian National Portrait** Gallery’s long-running “Portraiture Now” series. “Kinship” showcases the work of eight contemporary artists.
- Our Attorney Diversity, Equity and Inclusion Committee proudly sponsored a reception and private viewing of the exhibition **Notorious RBG: The Life and Times of Ruth Bader Ginsburg at the Holocaust Museum**.
- **Gentle Barn** is a national nonprofit organization, founded in 1999 as a sanctuary for severely abused farm animals. In late 2023, Haynes Boone began helping The Gentle Barn further expand its vital mission and services to provide better futures and lives for both animals and the underserved youth and people with disabilities who work with the animals, and support the opening of a new location in New York.
- Haynes Boone Associates Caylee Phillips, Joe Pinto and Lyric Stephenson worked with **Genesis Women’s Shelter** in Dallas and assisted a mother and child escaping domestic violence with a divorce filing and child custody case.
- **The Dallas Volunteer Attorney Program (DVAP)** recognized Haynes Boone with its 2023 Law Firm of the Year award. Attorneys conduct a monthly virtual clinic to provide legal information to applicants. Attorney development specialist Belinda Seymour was also honored with the Clinic Coordinator of the Year award for her related volunteer work.
- Haynes Boone helped transportation leader **First Transit Inc.** increase its diversity, equity and inclusion objectives by changing its background check policy. Associates Greg Van Houten and Michael Freyberg helped craft a new hiring policy using recidivism research to tighten First Transit’s criminal record screening. In July 2023, the *Washington Lawyers’ Committee for Civil Rights and Urban Affairs (WLC)* honored Haynes Boone with a 2023 Outstanding Achievement Award for this work for elementary and other schools.



Awards and Recognitions

New IP Partner



Jonathan Bowser

Washington, D.C. | Intellectual Property Practice Group

Jonathan focuses on patent litigation disputes before the Patent Trial and Appeal Board (PTAB) and federal district courts. He has been counsel in more than 100 AIA trials before the PTAB, representing both patent challengers and patent owners, and he litigates appeals before the U.S. Court of Appeals for the Federal Circuit. He also assists clients in counseling and patent procurement, with a specific focus on electrical, computer, networking, and medical device technologies.

LEGAL 500 2023 LEGAL DIRECTORY

The Legal 500 U.S. 2023 ranked 10 Haynes Boone practice areas among the best in the nation, up one from last year's nine, with three newly recognized practices: IP: Patent Prosecution, Appellate: Court of Appeals, and Appellate: Supreme Court.

INTELLECTUAL ASSET MANAGEMENT (IAM) PATENT 1000

Haynes Boone and 16 of its partners from California, Colorado, Illinois, Texas and Washington, D.C., were recognized in the 2023 edition of the *Intellectual Asset Management (IAM) Patent 1000* legal directory. The publication listed Haynes Boone among the top firms in the nation in various practice categories and among the leading firms in California, Illinois, and Texas.

MANAGING IP – IPSTARS

Managing Intellectual Property has again recognized Haynes Boone and 11 of its partners in the 2023 *IP STARS* directory. The firm's patent practice is ranked nationally, placing among the top six firms for PTAB Litigation and among the top 27 firms in Patent Prosecution. Haynes Boone is also ranked among the top five Texas firms for Patent Prosecution and among the top six Texas firms in Patent Disputes.

Haynes Boone also ranked among the top 11 firms in the U.S. in Trademark Prosecution, according to *Managing IP*. The firm ranked in the highest trademark tier in Texas, as one of only four "highly recommended" trademark firms in the state.

PATEXIA INC.'S PATENT PROSECUTION INTELLIGENCE REPORT

Patexia Inc., a publisher of analysis and data-driven rankings about the intellectual property sector, has ranked Haynes Boone one of the nation's leading patent prosecution firms.

In Patexia's 2023 Patent Prosecution Intelligence Report, Haynes Boone ranked as the fourth "best performing" patent prosecution firm in the high-tech sector and the sixth "best performing" firm overall, spanning all industries.

Awards and Recognitions

INTELLECTUAL ASSET MANAGEMENT (IAM) PTAB REPORT

Haynes Boone scored the highest win rate among the 10 law firms with the heaviest caseloads representing petitioners before the Patent Trial and Appeal Board (PTAB) in 2022, *Intellectual Asset Media (IAM)* reports.

In a Feb. 6, 2023 article, *IAM* credited Haynes Boone with a 45.9% success rate for PTAB petitioners, the best winning percentage among the select law firms with heavy caseloads.

In 2022, Haynes Boone ranked as the third busiest firm representing PTAB petitioners, with 67 cases filed on behalf of patent challengers in 2022.

PATEXIA INC.'S ITC INTELLIGENCE REPORT

Patexia Inc. has ranked Haynes Boone among the nation's top 50 firms representing complainants in International Trade Commission (ITC) Section 337 matters.

In its fourth annual ITC Intelligence Report, which surveyed 416 ITC investigations from Jan. 1, 2017, to Dec. 31, 2022, Patexia ranked Haynes Boone among the "most active" and "best performing" firms representing complainants in Section 337 proceedings.

THE PATENT LAWYER MAGAZINE

Haynes Boone has been ranked by *The Patent Lawyer Magazine* among the top law firms in the world for its work in the patent field in the 2023 Patent Lawyer Law Firm Rankings. This year, the firm was named in the top 10 of the magazine's North America – South region.

The annual rankings are based on extensive criteria, including market reputation, achievements within the last year, strengths, accessibility, client testimonials, firm-created thought leadership, website quality, DEI, other third-party rankings, and involvement in legal associations and conferences.

WTR 1000 AND WTR GLOBAL LEADERS

Calling Haynes Boone "one of the best-known names in the American trademark practice [and] well equipped to support clients from coast to coast," the World Trademark Review ranked the firm among the nation's top 11, "Gold-tiered" firms in the 2023 edition of the *WTR 1000*.

This is the 14th consecutive year for Haynes Boone to rank among the nation's best in the prestigious directory. Additionally, Haynes Boone Partners Purvi Patel Albers, Jeff Becker and David Bell are featured as 2023 World Trademark Review (WTR) Global Leaders.

D MAGAZINE REPORT

D Magazine has once again ranked many Haynes Boone lawyers, across most major practice areas, among the best lawyers in Dallas. A total of 27 lawyers were included in the 2023 Best Lawyers in Dallas directory. They were nominated by their peers for offering "unparalleled counsel" in their practice area and "representing the people and institutions of Dallas with mastery and drive," according to *D Magazine*. A select panel of lawyers evaluates the nominations to finalize the list.

CHAMBERS GLOBAL

Seven Haynes Boone lawyers are ranked in the 2023 edition of the *Chambers Global Legal Guide* of the leading international lawyers.

Awards and Recognitions

MANAGING IP AWARDS

Managing IP has shortlisted Haynes Boone Partner David McCombs as one of the nation's top lawyers practicing before the Patent Trial and Appeal Board (PTAB).

Managing IP also shortlisted Haynes Boone among the top law firms in the southern U.S. in both Patent Prosecution and Trademark Prosecution. Haynes Boone was one of only two firms to be named in both categories in *Managing IP's* 2023 Americas Awards.

PATEXIA INC.'S CAFC INTELLIGENCE REPORT

The Haynes Boone Appellate Practice Group ranks fifth out of more than 1,000 firms presenting in the Court of Appeals for the Federal Circuit (CAFC) based on number of cases and success rate. Patexia's 2023 CAFC Intelligence Report also ranked five Haynes Boone lawyers within the top one percent of attorneys representing appellees or appellants: Debbie McComas, Angela Oliver, David McCombs, Raghav Bajaj, and Andrew Ehmke.

PATEXIA INC.'S PATENT LITIGATION REPORT

Patexia Inc. has ranked Haynes Boone among the most active and best-performing U.S. patent litigation firms in 2023. Haynes Boone ranked as the 43rd most active firm representing defendants and the 55th most active firm overall, including the representation of plaintiffs and defendants in patent litigation in federal courts. Additionally, the firm ranked as the 38th best-performing firm in the representation of plaintiffs.

WIPR LEADERS DIRECTORY

World IP Review has listed Haynes Boone Partners Purvi Patel Albers, Jeff Becker and David McCombs among the world's leading technology, trademark and patent lawyers for 2023.

BEST LAWYERS IN AMERICA

Six Haynes Boone lawyers earned special recognition as Lawyer of the Year in their respective practice areas, while hundreds more were designated as *Best Lawyers and Ones to Watch*. The Lawyer of the Year winners include IP Partner Russ Emerson and Counsel Catherine Robb, who received the distinction in two practice areas, as well as IP Partners David McCombs, Purvi Patel Albers, W. Scott Wallace, and Tom Chen.

CHAMBERS USA

Haynes Boone lawyers and practices, spanning the firm's 16 U.S. offices, were recognized as industry leaders in Chambers USA 2023 (Chambers and Partners). Chambers USA 2023 recognized 75 Haynes Boone lawyers and 31 practices, the highest ever totals for the firm. 5 IP attorneys were ranked for Intellectual Property in their respective practices.

TEXAS SUPER LAWYERS - RISING STARS

Texas Super Lawyers Rising Stars has included 27 Haynes Boone lawyers in its 2023 directory. Published by Thomson Reuters, the *Texas Rising Stars* directory includes only 2 percent of young lawyers in Texas, selected through peer nominations and research. To be eligible, lawyers must be 40 or younger or practicing less than 10 years.

CALIFORNIA SUPER LAWYERS AND RISING STARS

Seven Haynes and Boone, LLP's lawyers are included in the 2023 California *Super Lawyers* and *Rising Stars* directories.

Podcasts

AI Chats Episode 25: Artificial Intelligence and Life Sciences

Featured Speakers: Eugene Goryunov, Dina Blikshteyn, Vincent Shier Ph.D., Brooke Cohen

AI Chats Episode 26: Artificial Intelligence and Inventorship Part I

Featured Speakers: Eugene Goryunov, Dina Blikshteyn, Vincent Shier Ph.D., Jamie Raju

AI Chats Episode 27: Artificial Intelligence and Inventorship Part 2

Featured Speakers: Eugene Goryunov, Dina Blikshteyn, Vincent Shier Ph.D., Jamie Raju

AI Chats Episode 28: Artificial Intelligence and Copyright

Featured Speakers: Eugene Goryunov, Dina Blikshteyn, Jason Bloom

AI Chats Episode 29: Artificial Intelligence and Generative AI Wars

Featured Speakers: Eugene Goryunov, Dina Blikshteyn, Brett Bostrom

AI Chats Episode 30: Artificial Intelligence and Finance

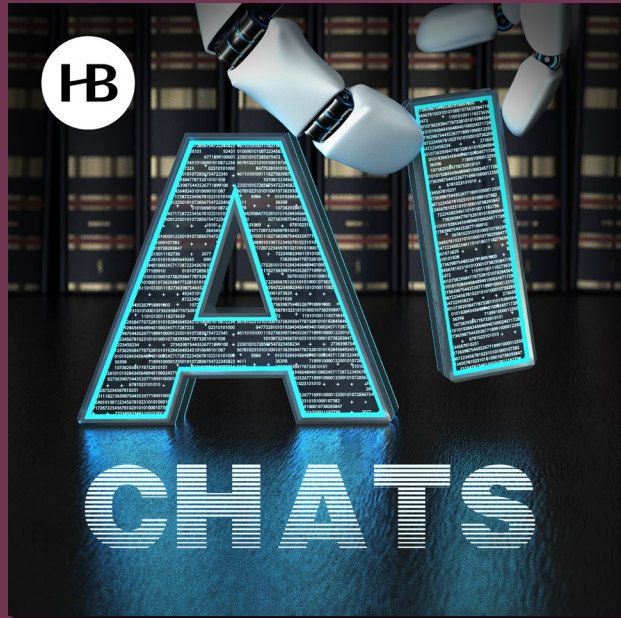
Featured Speakers: Dina Blikshteyn, Nicolette Nunez

AI Chats Episode 31: Current State of AI Regulation in the UK and Europe

Featured Speakers: Dina Blikshteyn, James Brown

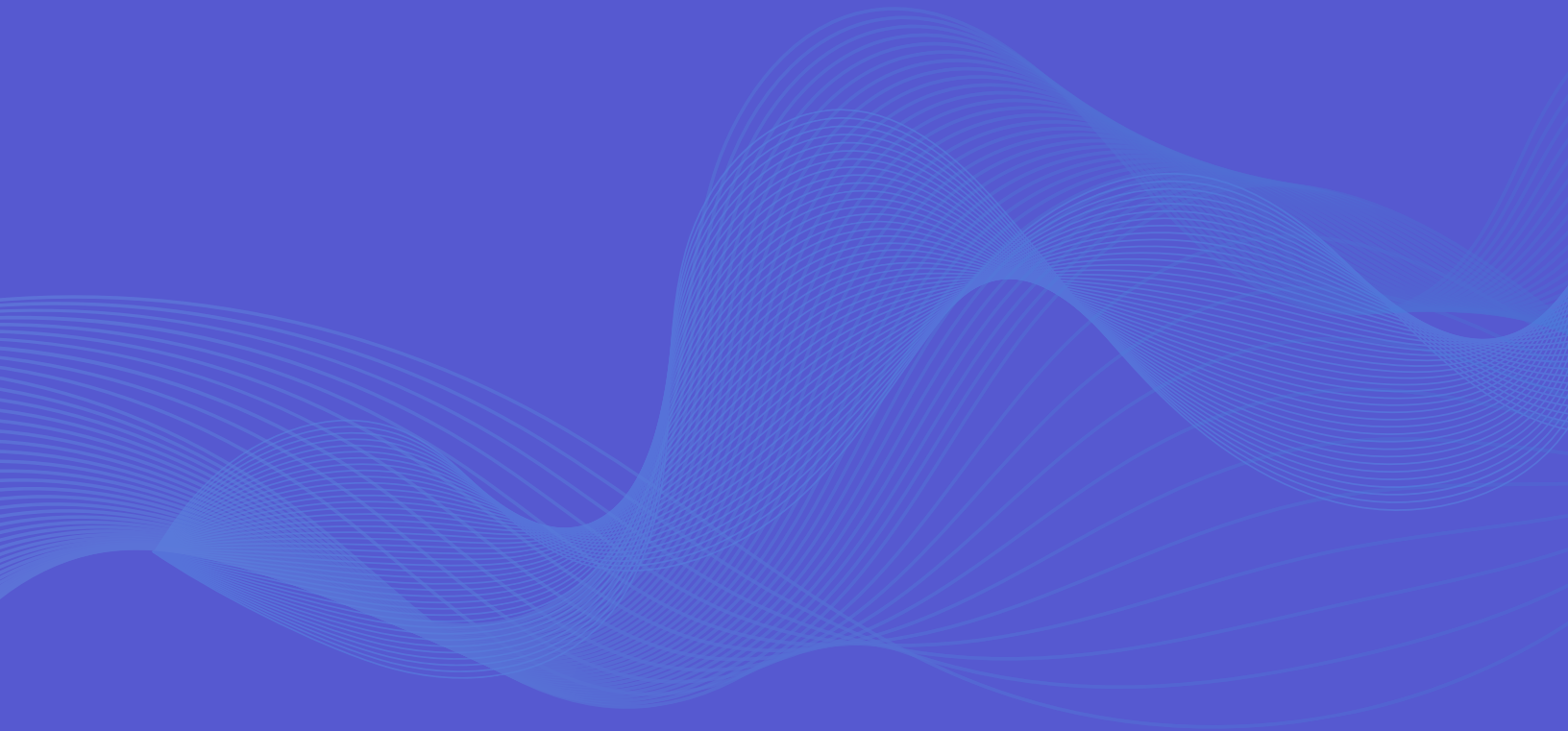
AI Chats Episode 32: AI Executive Order and Employment

Featured Speakers: Dina Blikshteyn, Adam Sencenbaugh



Meet Our Team

To learn more about the Haynes Boone Intellectual Property Practice Group and meet our team, [**CLICK HERE.**](#)



HAYNES BOONE

This publication is for informational purposes only and is not intended to be legal advice and does not establish an attorney-client relationship. Legal advice of any nature should be sought from legal counsel.

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