

The IP Beacon[®]

THE INTELLECTUAL PROPERTY LAW NEWSLETTER
OF HAYNES AND BOONE, LLP

APRIL 2025

RECENT RECOGNITIONS

David O'Dell Is Nation's Top Patent Lawyer and Haynes Boone Ranks No. 3 Patent Prosecution Firm

In the "2025 Patent Prosecution Intelligence Report," Patexia Inc. has named Partner **David O'Dell**, chair of the firm's **Patent Office Trials Practice Group**, the best-performing patent attorney in the country out of nearly 10,000 reviewed and ranked patent practitioners. The report also ranked Haynes Boone as the second-best patent prosecution firm in the high-tech sector and the third-best performing firm overall.

In addition to Patexia, *The Patent Lawyer* ranked Haynes Boone among the top law firms in the world for its work in the patent field in the 2025 Patent Lawyer Law Firm Rankings. The firm placed in the top 10 of the magazine's North America – South region.

Patexia Ranks Haynes Boone Among Most Active Firms in ITC Proceedings

Patexia Inc. has ranked Haynes Boone in the top 30 percent of the most active firms working on International Trade Commission (ITC) Section 337 matters.

In its sixth annual ITC Intelligence Report, which surveyed 337 ITC investigations from Jan. 1, 2019–Dec. 31, 2024, Patexia ranked Haynes Boone among the "most active" and "best performing" firms representing complainants and respondents in Section 337 proceedings..

Patexia Lists Haynes Boone as a Patent Litigation Leader in 2025 Rankings

In an era where modern technologies are speeding up the pace of invention, Haynes Boone continues to shine as a patent litigation global leader, earning recognition in Patexia, Inc.'s 2025 rankings as one of the most active and successful firms worldwide.

Haynes Boone ranked in the top 3 percent of law firms based on patent case winning percentage, and it placed in the top 6 percent based on volume of cases handled..

Haynes Boone Ranked Among Best Firms in 2025 by World Trademark Review for 16th Consecutive Year

World Trademark Review has again ranked Haynes Boone among the nation's top 12 "Gold-tiered" firms in its 2025 edition of the **WTR 1000**. This is the 16th consecutive year that Haynes Boone is ranked among the nation's best in the prestigious directory.



ARTICLES

U.S Copyright Office Issues Highly Anticipated Report on Copyrightability of AI-Generated Works

Annie Allison | Counsel

The United States Copyright Office (Office) has released **Part 2** of its Report on Copyright and Artificial Intelligence which addresses the copyrightability of AI-generated works. It maintains that human authorship and creativity remain essential in the quest to obtain copyright protection for works involving materials created by artificial intelligence.



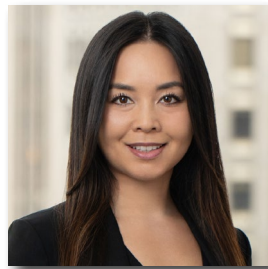
Evolving Contours of Prior Art



David L. McCombs
Partner



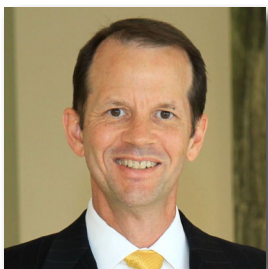
Eugene Goryunov
Partner



Laura Vu
Partner

In 2024, Petitioners at the Patent Trial and Appeal Board (PTAB) continued to test the bounds of what constitutes prior art in *inter partes* review (IPR) proceedings. The Court of Appeals for the Federal Circuit was recently called in to clarify what is, in fact, “public” disclosure prior art. In *Weber v. Provisur*, the court determined that operating manuals – that carried a copyright notice prohibiting reproduction and included a clause indicating ownership – were sufficiently “public” to constitute prior art printed publications. And in *Sanho v. Kaijet*, the court concluded that a private sale of a product was not “public” disclosure for purposes of prior art. These cases demonstrate that there are still nuances in what constitutes prior art, despite the core concepts of prior art being well understood.

Can State Law Contracts Limit the Right to Repair Even When Patent Protections Exhaust



Mark Tidwell
Partner



Dirk Bernhardt
Associate

U.S. courts have long established that the owner of a product protected by a U.S. patent has the right to repair the product under the patent exhaustion doctrine (a.k.a. first-sale doctrine), under which the right to repair is generally interpreted to be a very broad right under U.S. patent law. A purchaser of the patented product may face some restrictions (e.g., preventing reconstruction of the item that goes well beyond simple wear-and-tear repairs), but overall courts have determined most modifications fall under the category of repair. This right to repair includes the right to select who repairs the product. But what happens when the product is purchased under a contract that includes a limitation on the right to repair, such as requiring the purchaser to use only the patent owner for repairs or prohibiting repair altogether?.



Patent Law: Federal Circuit Clarifies Application of Collateral Estoppel from IPRs



David L. McCombs
Partner



Eugene Goryunov
Partner



Jonathan R. Bowser
Partner

In February 2025, the U.S. Court of Appeals for the Federal Circuit clarified when collateral estoppel might apply in a district court case following an invalidity determination by the Patent Trial and Appeal Board (PTAB) in a parallel inter partes review (IPR). In *Kroy IP Holdings, LLC v. Groupon, Inc.*, No. 2023-1359, (Fed. Cir. Feb. 10, 2025), Groupon filed two IPRs challenging 21 claims of the asserted patent.

The PTAB found all the challenged claims to be unpatentable, a finding that was appealed to the Federal Circuit and affirmed by the court. After Groupon's IPR filing deadline had passed, Kroy amended its complaint in district court to allege infringement of 14 additional claims, none of which were challenged in Groupon's IPRs.

AI Training Data Might Not Be Protected by Fair Use



David L. McCombs
Partner



Eugene Goryunov
Partner



Calmann Clements
Partner

US copyright laws are intended to protect the rights of authors and creators by granting them exclusive rights over their works. That way, authors and creators can control how their works are used, reproduced, and distributed. These laws are intended to encourage creativity by ensuring that authors and creators are compensated for their works. However, copyright laws are not without limits; they seek to balance the interests of authors and creators with those of the public. This is one of the reasons why copyright law codifies the common law fair use doctrine that allows a third party to make limited use of copyrighted material without permission of the copyright holder. Overall, the copyright law seeks to balance copyright protection with public benefits such as education, commentary, criticism, research, and parody.

What's New at the USPTO and How Will it Shape Life Sciences IP?

Sharon Crane, Ph.D. | Counsel

The United States Patent and Trademark Office (USPTO) is undergoing significant changes as new leadership comes on board to implement policy directives from the new administration.





Teva v. Amneal: Reshaping Generic Drug Rights



Benjamin Pelletier
Partner



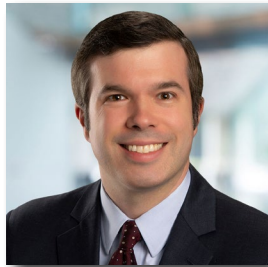
Alexis Blake, Ph.D.
Patent Agent

In an important decision clarifying certain aspects of the Orange Book listing process, the Federal Circuit ruled that patents must claim an active ingredient to be properly listed. This decision marks a significant development in pharmaceutical patent litigation, emphasizing the limits of Orange Book listings for device-related patents and reinforcing the role of antitrust considerations in Hatch-Waxman disputes. Teva is widely expected to petition for certiorari as the case will likely shape future strategies for both innovator and generic pharmaceutical companies making decisions about listing drug/device combination patents with the FDA and how these are challenged when improper, including navigating the intersection of patent and antitrust law.

NIH Issues Guidance Capping Grant Indirect Cost Rates at 15%, Drawing Multiple Legal Challenges Affecting Research-Based Organizations and R&D Innovation



Jeffrey A. Wolfson
Partner



Daniel Ramish
Partner



Jonathan Shaffer
Partner

The National Institutes of Health (NIH) issued ***NIH Supplemental Guidance to the 2024 NIH Grants Policy Statement: Indirect Cost Rates, Notice Number NOT-OD-25-068 (Feb. 7, 2025)*** (NIH Guidance or Guidance), which establishes a standard indirect cost rate (also known as a Facilities and Administration or F&A rate) of 15% across all NIH grants, regardless of existing negotiated indirect cost rates. The standard rate, which operates as a cap on indirect costs, applies to all future NIH grant awards and, specifically for Institutions of Higher Education (IHEs), even applies to existing awards. The Guidance acknowledges that most organizations have F&A rates averaging 27-28% nearly double the new cap, and that many organizations have rates upwards of 50-60%.

Five Takeaways on Bridging Generational Gaps from the Law Firm Committee Idea Exchange

Katie Eissenstat | Associate

In 2020, Generation Z (also called Gen Z, those born between 1997 and 2012) made up 6.1 percent of the workforce. By 2030, this number is predicted to increase to a whopping 30 percent, according to an article by Chloe Donelan entitled "Gen Z In the Workplace: How Should Companies Adapt?," which appeared in the Johns Hopkins University blog entitled "Integrative Learning and Life Design." This striking estimate serves as a wake-up call for industries worldwide, and the legal profession is no exception. The next generation of lawyers is coming, bringing with them a distinct shift in priorities from prior generation.





New White House, New AI Rules: Corporate America's Next Move



Eugene Goryunov
Partner

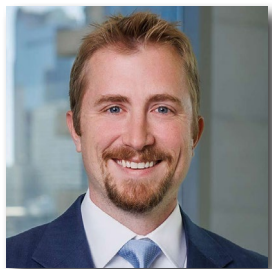


Alla Digilova
Partner

The past few years have seen a significant rise in the popularity and influence of AI technologies. Many public companies in the US have either already implemented or are actively exploring the adoption of AI in their business.

AI tools are rapidly changing the market landscape, promising significant technological progress. Most recently, promulgation of generative AI (GenAI) tools, such as ChatGPT, has further enhanced interest among companies and the general public in such technology.

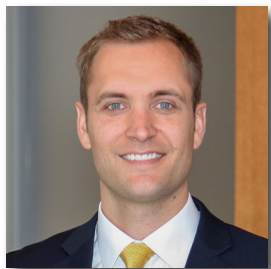
No More Rubber Stamps: Best Practices for Drafting Revival Petitions for Patents and Patent Applications



Adam C. Fowles
Partner



Dirk Bernhardt
Associate



Brett Bostrom
Partner

When the United States Patent and Trademark Office (USPTO) changed the rule regarding revival petitions in March 2020 to additionally require a statement explaining unintentional delays of more than two years, ambiguity remained on what constituted a successful statement.

Now that the rule has been in effect for several years and the USPTO has had opportunity to respond to several relevant petitions, it is worth revisiting the topic and glean insight from the responses about what the USPTO considers to be a grantable revival petition.



Drop by to see our Life Sciences Team at BIO in Boston June 16-19. Contact us below for more details.



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PODCAST

Privacy and Legal Risks of On-Device vs Cloud AI



Fred Bliss

Eugene Goryunov

The Legal Landscape: Privacy and Legal Risks of On-Device vs Cloud AI

Eugene Goryunov and Guest Fred Bliss of Intersect Next



IN THE NEWS

Haynes Boone Secures Federal Circuit Patent Appeal Victory for Unified Patents

Haynes Boone successfully represented Unified Patents before the U.S. Court of Appeals for the Federal Circuit, securing a significant ruling that affirmed the Patent Trial and Appeals Board's (PTAB) decision invalidating 29 out of 31 claims of a patent asserted by Gesture Technology Partners LLC.

Haynes Boone Guides PATHOMIQ in AI Diagnostics Deal with Myriad Genetics to Transform Cancer Care

Haynes Boone represented **PATHOMIQ, Inc.**, a pioneer in artificial intelligence-driven diagnostics, in securing an exclusive U.S. licensing agreement with Myriad Genetics, Inc. (NASDAQ: MYGN), a leader in molecular diagnostic testing and precision medicine. The new collaboration will bring PATHOMIQ_PRAD, a cutting-edge AI technology platform for prostate cancer, to patients, and it will empower clinicians with more precise diagnostic insights and personalized treatment plans.

Haynes Boone Represents RedHill in Global Licensing Agreement with Hyloris

A cross-practice Haynes Boone team represented **RedHill Biopharma Ltd.** (NASDAQ: RDHL) in negotiating an exclusive worldwide development and commercialization licensing agreement, excluding North America, for its RHB-102 drug candidate, securing potential payments of up to \$60 million plus royalties.

Haynes and Boone, LLP is an international corporate law firm with a cross-disciplinary team of over 700 lawyers providing a full spectrum of legal services to clients across the nation and around the world.

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