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THE IP BEACON[®]

The Intellectual Property Law Newsletter
of Haynes and Boone, LLP

2020 YEAR IN REVIEW



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WELCOME

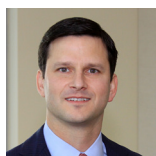
Welcome! We are pleased to highlight IP news, and some of our representative intellectual property-related client successes and publications over the past year, that might be relevant to your business success in the coming year.

Our IP department has continued growing and extends from California through Texas, Colorado, and Illinois to Washington, D.C. and New York. Our IP team now includes 120 IP lawyers, 11 patent agents, and 1 scientific advisor. In fact, Haynes and Boone was recently named among the Top 25 growing patent firms over the past decade by Juristat. We represented clients in 43 *inter partes* review/PTAB proceedings that were filed in 2020, and our patent prosecution team filed more than 2,200 U.S. patent applications and helped issue over 1,600 U.S. patents - in 2020 alone. We also helped close the IP issues in dozens of diligence investigations, financings, M&A transactions, and joint venture/licensing and other contractual arrangements.

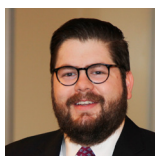
We invite you to read on for a review of important IP related cases from the year, IP related publications, updates on some of our firm's litigation efforts and key deals, and a few of the awards our intellectual property team is most proud of from 2020.

YEAR IN REVIEW CASES

BRIZZY V. VIZZY: MOLSON COORS OBTAINS CHEERS-WORTHY TRADEMARK RULING AT FIFTH CIRCUIT



Jason
Bloom



Wesley
Lewis

It was a good day at the bar for Molson Coors—the Fifth Circuit Bar, that is. The beverage titan Molson Coors Beverage Company (“Coors”) secured a

significant victory in the Fifth Circuit in a trademark dispute with Future Proof Brands, LLC (“Future Proof”) over the two companies’ competing hard seltzer brands, “Vizzy” and “Brizzy.” On December 3, 2020, a three-judge panel affirmed the denial of Future Proof’s motion for a preliminary injunction, which sought to prevent Coors from using the “Vizzy” brand name for its seltzers. But while Future Proof stumbled early on the injunction front, the decision was not a total black-out loss for the Austin-based beverage company. The Fifth Circuit disagreed with the district court’s ruling that Future Proof’s BRIZZY mark was descriptive, holding instead that the mark was suggestive and therefore inherently distinctive. As a result, Future Proof’s mark will be

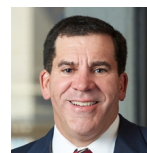
entitled to greater protection moving forward in the litigation—a ruling that may help ease Future Proof’s hangover from the denial of the injunction.

[Read full case here.](#)

COPYRIGHT OFFICE FINDS ASPECTS OF THE DMCA “UNBALANCED” IN FAVOR OF ONLINE SERVICE PROVIDERS



Jason
Bloom



Lee
Johnston



Joseph
Lawlor



Wesley
Lewis

On May 21, 2020, the United States Copyright Office published a long-anticipated report assessing the efficacy of Section 512 of the Digital Millennium Copyright Act (“DMCA”). In the nearly-200-page report, the Copyright Office takes a critical look at the DMCA’s “safe-harbor” provisions, ultimately concluding that certain aspects of Section 512 have become “unbalanced” in the twenty years since it

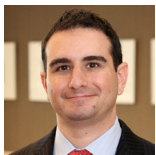
YEAR IN REVIEW CASES

was enacted. According to the Copyright Office, the “balance” has shifted almost uniformly in favor of online service providers (OSPs) to the detriment of copyright holders.

OSPs and others may disagree with the Copyright Office’s characterization of this shift. Many OSPs devote significant resources to comply with the requirements of the DMCA safe harbor, and others have implemented measures that go beyond those required by the DMCA. As one example, in recent years major OSPs have implemented “fingerprinting” technologies that are able to prevent the posting of copyrighted material before it is even posted, even though the DMCA does not require OSPs to take such proactive measures.

[Read full article here.](#)

IF IT ISN’T PERCEIVED AS GENERIC, THEN IT ISN’T GENERIC: TAKEAWAYS FROM *USPTO V. BOOKING.COM*



David Bell



Jeffrey Becker

The Supreme Court ruled in *United States Patent and Trademark Office v. Booking.com B. V.* that domain names comprised of generic terminology and a top-level domain (such as

.com) can be eligible for trademark protection. Below, we explore what this means for brand owners.

As brief background, this represents the latest chapter in Booking.com’s eight years of efforts to federally register Booking.com as a trademark. Consumers visit Booking.com to book travel arrangements and accommodations. The United States Patent and Trademark Office (USPTO) Examining Attorney denied registration based on genericness. The Trademark Trial and Appeal Board (TTAB) affirmed.

[Read full case here.](#)

THE SUPREME COURT DECLINES TO REVAMP PRECLUSION LAW IN *LUCKY V. MARCEL* TRADEMARK DISPUTE



Stephanie Sivinski

In a unanimous opinion authored by Justice Sotomayor, the U.S. Supreme Court declined to redefine preclusion, reversing the Second Circuit’s decision in trademark dispute *Lucky Brand Dungarees Inc. v. Marcel Fashion Group Inc.* The Second Circuit’s opinion had attempted to expand res judicata beyond the well-recognized issue preclusion and claim preclusion, creating a new category it called “defense preclusion.” The Supreme Court determined that a defense will only be precluded if it meets the requirements of issue preclusion or claim preclusion. Thus, defendants need not litigate to finality all possible defenses, which could vastly increase the cost of litigation.

The dispute arises from three rounds of longstanding litigation between apparel companies Lucky and Marcel. The first round began in 2001 when Marcel sued Lucky for allegedly infringing Marcel’s GET LUCKY trademark. The parties signed a settlement agreement in 2003, in which Marcel released its claims of infringement.

[Read full case here.](#)



YEAR IN REVIEW CASES

THREE TAKEAWAYS FROM SUPREME COURT RULING THAT TRADEMARK INFRINGER'S PROFITS MAY BE AWARDED WITHOUT A SHOWING OF 'WILLFUL' INFRINGEMENT



Joseph
Lawlor

In *Romag Fasteners, Inc. v. Fossil, Inc.*, the U.S. Supreme Court unanimously held that a plaintiff in a trademark infringement suit is not required to show that the infringing defendant acted “willfully” to avail itself of the Lanham Act’s disgorgement remedy. Because actual damages are often difficult to prove in trademark infringement actions,

this decision is a significant development in trademark law as it expands the number of cases in which a jury may award a defendant’s profits to a prevailing plaintiff.

However, the case leaves unsettled whether disgorgement may now be available for “innocent” infringement, and the concurrences by Justice’s Alito and Sotomayor both caution that a finding of willfulness or some other enhanced mental state should remain an important consideration before awarding a defendant’s profits.

[Read full case here.](#)

RECENT CASES

GLOBALFOUNDRIES U.S. INC. V. TAIWAN SEMICONDUCTOR MANUFACTURING CO., LTD. ET AL

Haynes and Boone represented TSMC in multiple lawsuits brought against the company by Global Foundries (“GF”) in the Western District of Texas (Judge Albright) and in Delaware. The technology involved multiple aspects of semiconductor fabrication. GF brought 13 lawsuits against TSMC and 2 ITC proceedings in the US as well as actions in Germany.

AT&T MOBILITY LLC V. DORMITUS BRANDS

Dormitus Brands is trying to claim ownership of the CINGULAR brand, which belongs to our client AT&T. On Feb. 10, 2020, the Trademark Trial and Appeal Board (TTAB) issued a precedential ruling in AT&T’s favor that AT&T had standing to challenge Dormitus Brands’ attempt to misappropriate the CINGULAR brand, notwithstanding the fact that AT&T transitioned much of its branding from CINGULAR to AT&T in 2007. This ruling was discussed numerous times in the legal press and has been listed as one of the most important trademark decisions of the year.

IN THE MATTER OF CERTAIN BLOOD CHOLESTEROL TESTING STRIPS AND ASSOCIATED SYSTEMS CONTAINING THE SAME

We recently represented patent owner Polymer Technology Systems, Inc. (“PTS”) as the complainant in a Section 337 investigation in the International Trade Commission. We obtained an initial determination in June 2019 that the Respondents, ACON Laboratories, Inc. and its related entity, infringe two patents, and a further recommendation that the infringing products be banned from importation. On April 16, 2020, the ITC issued a Final Determination finding that ACON Laboratories, Inc. and ACON Biotech (Hangzhou) Co. infringed two of PTS Diagnostics’ key patents. Additionally, the ITC determined that a limited exclusion order prohibiting ACON from importing the infringing products into the U.S. is proper.

PTS designs, manufactures, and markets point-of-care diagnostic products in the United States and internationally and makes an award-winning handheld device that measures HDL cholesterol, total cholesterol, and triglycerides in under two minutes. The patents in suit cover that device and other products. The Haynes and Boone team previously successfully represented PTS in a similar investigation in 2015.

TECHNOLOGY AND M&A TRANSACTIONAL REPRESENTATIVE EXPERIENCE



- Represented Orthofix in all intellectual property aspects of its the acquisition of the FITBONE Limb Lengthening System from Wittenstein, closed in February 2020, for \$18 million dollars.
- Drafted and negotiated a new agreement with a European-based vendor for mission-critical flight planning software that will replace American Airline's legacy flight-planning system fleet-wide. This year we also negotiated several new agreements covering the delivery and implementation of cutting-edge biometric passenger identification technology and hardware on behalf of American Airlines at various U.S. airports, which required satisfying various internal security policies and applicable national and international privacy laws and regulations.
- Represented Golden Nugget Online Gaming, a leading online gaming and digital sports entertainment company, in its business combination with Landcadia Holdings II, a publicly traded special purpose acquisition company (SPAC).
- Represented ComplianceEase, the mortgage industry's largest provider of compliance software for mortgage originators, in the sale of a majority of its equity interest to TechEssential, LLC, a wholly owned subsidiary of SitusAMC Holdings Corporation.
- Represented Orthofix in intellectual property diligence and negotiation of development and distribution agreements with Neo Medical SA, resulting in a partnership that is co-developing single-use instrumentation for cervical spine procedures and Orthofix's distribution of Neo Medical's disruptive value-based thoracolumbar solutions in the U.S.
- Represented Actinium Pharmaceuticals, Inc., a clinical-stage biopharmaceutical company developing ARCs or Antibody Radiation-Conjugates, in a \$25 million public offering of its common stock. Lawyers in Haynes and Boone's Capital Markets and Securities Practice Group led the team representing Actinium, and were assisted by lawyers across several practices, including intellectual property lawyers, who managed the IP due diligence review in this transaction.

PUBLICATIONS

Significant Changes to U.S. Trademark and Copyright Law Included in Latest Coronavirus Relief Legislation

Haynes and Boone News | December 28, 2020
David Bell, Jason Bloom, Joseph Matal, Wesley Lewis

On Sunday, December 27, 2020, President Trump signed into law a COVID-19 relief and government spending bill entitled the “Consolidated Appropriations Act, 2021.” Within its nearly 5,600 pages are significant new trademark and copyright provisions unrelated to either the coronavirus or the funding of the government. For trademark owners, the legislation incorporates the Trademark Modernization Act of 2020, H.R. 6196, likely the most significant trademark legislation since the Lanham Act’s enactment nearly 75 years ago. It

will change trademark practice in several ways, including: (i) providing a statutory rebuttable presumption of irreparable harm to benefit brand owners in trademark litigation; and (ii) creating new expungement and reexamination proceedings before the United States Patent and Trademark Office (USPTO) to more efficiently remove unused marks from the registry.

For copyright owners, the legislation creates a new “Copyright Claims Board” within the United States Copyright Office to adjudicate certain “small-claims” copyright disputes rather than trying them in the courts. It also increases criminal penalties for illegally streaming content, making certain streaming of copyrighted content for profit a felony punishable by up to 10 years of imprisonment.

IP QUIZ



**IS THIS A
PROTECTABLE
TRADEMARK?**

See the answer on page 19

PUBLICATIONS

Trends in ISP and Platform Liability: CDA Section 230 and DMCA Safe Harbors

Haynes and Boone News | August 18, 2020
Wesley Lewis

The internet as we know it today was made possible, in part, through the creation of a legal framework that permits platforms and internet service providers (ISPs) to host user-generated content without substantial risk of liability. Two significant statutes are collectively responsible for establishing this framework: The Communications Decency Act of 1996 (CDA) and The Digital Millennium Copyright Act (DMCA), enacted in 1998.

Without these two pieces of legislation, the internet would be a vastly different place than it is today. The CDA and DMCA both allow ISPs, social media platforms, and other online service providers (collectively referred to in this article as “service providers”) to act as conduits and repositories for user-generated content without liability for such content. This statutory civil immunity allows service providers to take a hands-off approach to user-generated content, obviating the need to conduct pre-publication moderation or review of content made available on or through their services. Without this protection, service providers would be less likely to host the third-party content we have come to expect on the internet—such as reader commentary on news sites, YouTube videos, and Instagram posts—lest they be exposed to liability for defamation, copyright infringement, or other causes of action arising from the user-generated content they host. Considering, for example, that an estimated 500 hours of video are uploaded to YouTube *per minute*, service providers simply could not exist in their current form without Section 230 of the CDA and Section 512 of the DMCA to protect them from liability arising from such content.

David McCombs, Raghav Bajaj, Dina Blikshteyn, Jonathan Bowser, Eugene Goryunov, Angela Oliver in *Legal Tech News*: Navigating a New Realm: AI and Patent Law

Legal Tech News | July 16, 2020
David McCombs, Raghav Bajaj, Eugene Goryunov, Dina Blikshteyn, Jonathan Bowser, Angela Oliver

Back in 1955, John McCarthy coined the term “artificial intelligence” to represent the science of developing intelligent machines. The following year, McCarthy established AI as a field when he organized the Dartmouth Conference to operate under the “conjecture that every aspect of learning or any other feature of [human] intelligence can in principle be so precisely described that a machine can be made to simulate it.” While AI as a term and science may not be new, certain legal issues surrounding the patenting of AI inventions certainly is at its infancy.

Fast Tracking Your *Ex Parte* Patent Appeals May Be Appealing: United States Patent & Trademark Office (USPTO) Announces New Pilot Program

Haynes and Boone News | July 6, 2020
Kelvin Varghese, Jeffrey Wolfson

Starting July 2, 2020, *ex parte* appeals to the Patent Trial and Appeal Board (PTAB) can be expedited under the new Fast-Track Appeals Pilot Program. It currently takes approximately 15 months for the PTAB on a typical appeal when decisions are issued in the order that the appeals are docketed, and this delay is often longer for certain technology centers. The new Pilot Program advances an appeal out of turn, and guarantees that the PTAB will issue a decision within 6 months of the appeal’s entry into the program.

PUBLICATIONS

U.S. Supreme Court Hears First Ever Teleconference Oral Arguments in *USPTO v. Booking.com B.V.* Trademark Case

Haynes and Boone News | May 6, 2020

David Bell, Ellie Sowanick

On Monday, May 4, 2020, for the first time in history, the U.S. Supreme Court heard oral arguments via teleconference and live-streamed the conference call to the public. And, if that was not exciting enough, to kick off a planned two-week session of tele-arguments, the Court chose a case whose subject is relatable to the general public – domain names. Although the live-streamed teleconference was broadcast practically glitch-free, the attorneys did not get off quite so easily, with each of the Justices taking turns in order of seniority to scrutinize the counselors. Here, we discuss some of the noteworthy arguments from Monday's hearing in *United States Patent and Trademark Office v. Booking.com B.V.*

Joseph Lawlor in *Mobile Marketing Magazine*: Running a Micro-Influencer Campaign

Mobile Marketing Magazine | February 27, 2020

Joseph Lawlor

The Michael Bloomberg 2020 presidential campaign has hired hundreds of individuals in California to post social media content supportive of the New York billionaire, as first reported by the *Wall Street Journal*. This strategy is an unorthodox method for distributing sponsored content at a scale previously unheard of.

Bloomberg's strategy has already hit several roadblocks. Its quality control team has failed to prevent paid micro-influencers from making false postings on social media postings. 70 Bloomberg micro-influencers have been **banned by Twitter** outright. Brands will be wise to consider the significant compliance and PR costs before engaging in a micro-influencer campaign of this scale.

The USPTO Extends Certain Trademark Deadlines Again, Now Through May

Haynes and Boone News | April 8, 2020

David Bell, Mike McArthur

As first announced in March, the USPTO has provided two avenues for relief to trademark owners impacted by the novel coronavirus (COVID-19) pandemic. These policies have recently been updated and extended through May:

- CARES Act Relief: Applicants and registrants can claim the benefit of a grace period extension on many types of filings with deadlines between, and inclusive of, March 27, 2020 and May 31, 2020. The requesting party must make the late filing or payment by Monday, June 1st with a statement that COVID-19 *materially interfered* with meeting the original deadline. This alert mostly will elaborate on this grace period measure.
- Other Relief - Petitions: The USPTO will waive its fees for both Petitions to Revive applications abandoned by May 31, 2020 and Petitions to the Director to reinstate registrations that were cancelled or expired within this timeframe.

We recommend trying to meet all trademark deadlines during this time – yet turning to the options explained here if applicable and necessary in your situation. Even if you need not make use of these extension or petition options, these developments may have an impact on your trademark decisions and portfolio.

2020 NEWSLETTERS

The IP Beacon®

April 2020 July 2020 November 2020

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The IP Beacon®: Patent Law Review

PUBLICATIONS

Michael Tobin: ‘Consisting Essentially of’ Claims Nixed at Federal Circuit

Intellectual Property & Technology Law Journal | February 26, 2020

Michael Tobin

In *HZNP Medicines LLC v. Actavis Laboratories UT, Inc.*, the U.S. Court of Appeals for the Federal Circuit affirmed the district court’s holding that the transitional phrase “consisting essentially of” was indefinite as used in several claims of patents owned by HZNP Medicines LLC and Horizon Pharma USA, Inc. (“Horizon”).

Alexander Lutzky in *IP Litigator*: Practice Areas: Patent Litigation

IP Litigator | March 11, 2020

Alexander Lutzky

Did the Federal Circuit Just Raise the Evidentiary Bar for Establishing Obviousness?

According to the panel in *OSI Pharmaceuticals, LLC v. Apotex, Inc.*, Slip Op. No. 2018-1925 (Fed. Cir. Oct. 4, 2019), the answer to the question posed in this article’s title is a solid no. Considering the opinion’s precedential nature and the facts in the case, the Federal Circuit, however, may have just given patentees extra ammunition to defeat an obviousness challenge on evidentiary grounds.

The Federal Circuit analyzed whether certain pharmaceutical method claims related to a treatment for lung cancer were obvious and concluded that the lack of efficacy data in asserted prior art showed a person of ordinary skill would not have a reasonable expectation of success in applying their teachings. This holding reversed an obviousness determination by the PTAB in a preceding IPR of the patent at issue, and shows that for challengers mounting an obviousness challenge, prior art containing data-based evidence may be needed to be successful, particularly if the patent being targeted is in the pharmaceutical or chemical arts.

Brave New World: How AI Tools Are Used in the Legal Sector

LegalTech News | August 12, 2020

David McCombs, Raghav Bajaj, Eugene Goryunov, Dina Blikshteyn, Jonathan Bowser, Angela Oliver

In our [previous article](#), we explored several legal implications that artificial intelligence will have on patent law, and the availability of patent protection for AI inventions. In this article, we explore the impact of AI in the legal industry, including new AI tools for legal departments, and how to plan for risk when using these AI tools.

A Biden Administration Bodes Well for the Electric Vehicle Industry

Haynes and Boone News | January 28, 2021

Jade Laye

The Biden Administration appears poised to drive the federal government’s approach to vehicle electrification down a friendlier road. During the past four years, the Trump Administration’s support for fossil fuels as an economic driver generally overshadowed any push in favor of electric vehicles (“EVs”) and limited any corresponding financial support for the EV industry. While President Trump left in place the Bush-era tax incentive for EV purchases, he later unsuccessfully attempted to eliminate that credit in his original 2020 budget, stating the move would save the Federal government \$2.5 billion over a decade. In September of 2020, President Trump signed into law a bipartisan bill allowing federal employees to pay for EV charges using their government issued purchase cards. Yet in general, President Trump favored fossil fuels over electrification by seeking to roll back vehicle emission standards citing the attendant increase in vehicle costs for consumers.

INDUSTRIES

ADVERTISING, MARKETING, AND PROMOTIONAL LAW

In today's competitive environment, compliance with advertising laws is critical as brands face more scrutiny than ever before. Our Advertising, Marketing, and Promotional Law Practice Group provides clients with practical guidance to help manage their advertising legal risks related to consumer legal actions and competitors' potential claims, as well as to regulatory and enforcement actions. Our team regularly advises clients on all issues relating to the creation, structure, production, implementation, and defense of advertising, marketing, and promotional campaigns across all types of media.

We represent clients in state and federal court and before the National Advertising Division (NAD) to assert challenges and defend against false advertising claims. Advertisers and challengers have come to rely on our team to successfully challenge unfair, deceptive, or misleading advertising as well as to defend adequately substantiated claims. Our team routinely advises clients as to the strategic choice of which is the best forum to address their advertising related disputes.



AI AND DEEP LEARNING

Artificial intelligence (AI) continues its 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.

Applicants for AI patents face unique challenges. Who can be listed as an inventor if AI creates or contributes to an invention? Are AI inventions susceptible to the subject matter eligibility challenges? Who can be a person of ordinary skill in the art be when determining obviousness of the AI inventions?

Our 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, and has begun a regular series of podcasts called AI Chats^{HB} [available here](#).

AUTONOMOUS TRANSPORTATION

Self-driving cars and autonomous vessels are becoming a reality, signaling a shift in the way vehicles and vessels operate. Travel and carriage of goods from point A to point B is changing, disrupting the transportation industry on land, at sea and in the air. As the way people and products move and operate continues to change, automotive manufacturers, ship builders, offshore operations, insurers, technical managers, OEMs and other suppliers are assessing this industry shift and preparing for its impact on their respective businesses.

Our Autonomous Transportation Industry Group is equipped to help clients navigate these changes, whether protecting innovative technologies, complying with new industry regulations, structuring finance deals and partnership agreements, or managing insurance and liability risks. We bring together the technical knowledge and industry experience to effectively advise clients operating in this rapidly evolving space.

INDUSTRIES



CHEMICAL

Our Chemical Industry Team comprises lawyers whose educational backgrounds, technical and legal experience help clients employing chemicals and chemical technology in their business, spanning pharmaceuticals, agriculture, materials including plastics and polymers, and more. The cross-sectional Chemical Practice Group represents clients at the interface of chemistry and the law, and includes lawyers from our intellectual property transaction and litigation, environmental, OSHA, food and drug, and insurance recovery practice groups, as well as other legal disciplines. We help clients develop and implement a comprehensive approach to managing legal risks and addressing issues affecting the chemical industry, including environmental cleanup risk, innovation protection, and product and process clearance.

FINTECH, VIRTUAL CURRENCY AND BLOCKCHAIN

Virtual currency and blockchain technology continue their rapid advance into the daily lives of our clients. Investors, entrepreneurs, and innovators envision a multitude of industries through which this new technology could spread, while regulators try to keep pace.

Our multidisciplinary team of lawyers represents clients in addressing a variety of legal issues within this growing area of commerce. Such issues include intellectual property matters relating to the ownership and protection of virtual currency and blockchain innovations, compliance with statutes and regulations to protect consumers, mechanisms and structures to fund investments, rules for trading virtual coins and tokens, and the application of blockchain's distributed ledger technology to healthcare, property records, cap tables and other arenas. Our securities regulatory lawyers and commercial litigators have experience dealing with applicable laws and regulations in this area and the resolution of related disputes.

To address this changing landscape, Haynes and Boone created an active FinTech, Virtual Currency and Blockchain Practice Group that possesses experience in a broad range of specialties, including intellectual property, finance, derivatives, prime brokerage, funds, securities, energy, commodities regulation and litigation.



INDUSTRIES

MEDICAL DEVICE AND TECHNOLOGY

With deep experience in the medical device area, Haynes and Boone attorneys help companies safeguard their core products and methodologies. We understand the highly competitive nature of this space and is fully committed to protecting our clients' assets and innovations and managing IP risk in commercial operations.

Our experience in this area covers all aspects of the product life cycle and includes drafting durable patents, providing due diligence in the context of mergers and acquisitions, providing strategic guidance on domestic and international patent portfolio development and management, rendering product clearance opinions regarding competitors' intellectual property rights, challenging and defending patents and post-grant patent proceedings before the USPTO, and enforcing and litigating patents, trademarks, and trade secrets for medical device companies in United States courts as well as coordinating actions in foreign jurisdictions.

PRECISION MEDICINE AND DIGITAL HEALTH

Emerging technologies are changing the way clients operate in the rapidly evolving healthcare industry. Haynes and Boone's Precision Medicine and Digital Health Practice Group understands where the industry has been and where it is going, and we are ready to help companies of all sizes navigate and excel in this growing market.

Our lawyers provide full service counsel to the key players in precision medicine and digital health – from technology startups to established corporations, health insurers, pharmaceuticals, and investors supporting the industry. Our team draws on the firm's highly regarded healthcare, life sciences, technology and intellectual property experience to address trends in evolving markets, cutting-edge advances in technology, and legal and regulatory changes.

STREAMING MEDIA

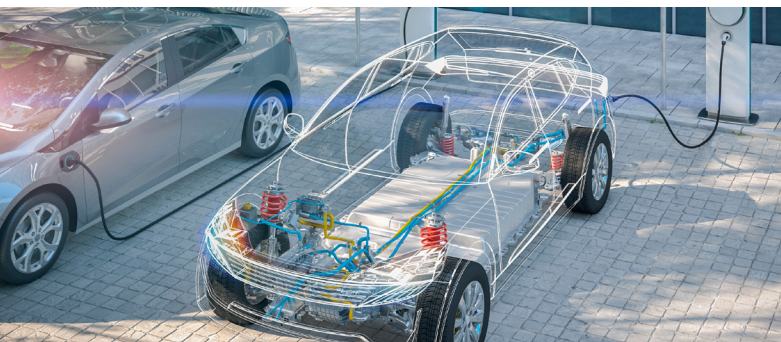
In the streaming media space, we have conducted trademark counseling, prosecution, and enforcement; IPRs, technology transactions, including drafting and negotiating use and licensing agreements; patent prosecution; copyright (including the Digital Millennium Copyright Act); merchandising counseling; and advising on advertising and branding issues.

We provide a broad spectrum of counseling and litigation services related to media and First Amendment law (including anti-SLAPP statutes), Communications Decency Act, negligence, fraud, breach of contract, libel, defamation, royalties, and FTC investigations.

We also provide a full complement of services for domestic and international media and entertainment transactions, including private equity and capital markets transactions as well as commercial finance and corporate governance matters for clients operating within the industry. Mergers, acquisitions, and joint ventures are also a key part of the firm's capabilities in assisting clients in their strategic planning. We have broad experience in handling industry specific transactions such as live event productions; television, video, and user-generated content transactions; television and motion picture production and distribution; transactions involving intellectual property; and digital media transactions.



INDUSTRIES



VEHICLE ELECTRIFICATION

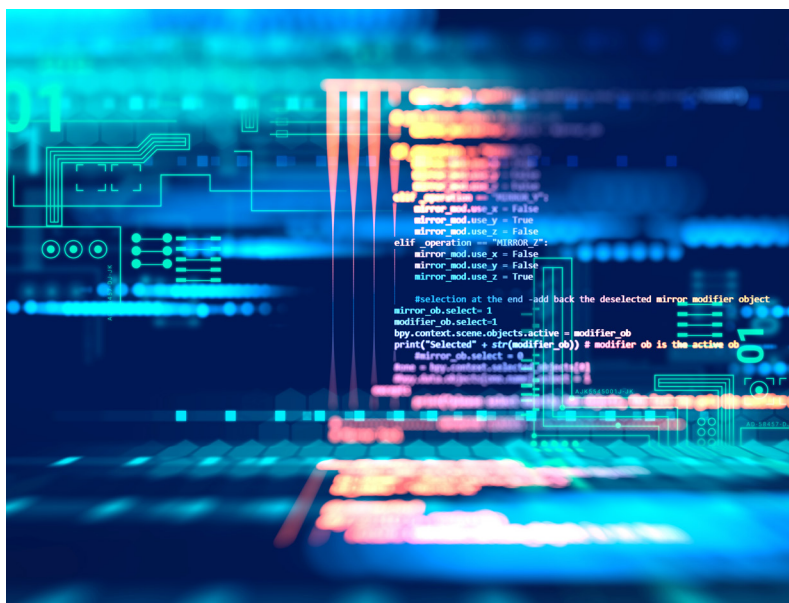
Advances in electric mobility continue to shape the transportation industry, changing the way we commute and travel. As electric vehicle deployment grows across the globe, companies operating in this space must consider several factors regarding their business decisions including: corporate structure formation and tax planning, managing project finance, protecting their intellectual property and R&D related to emerging technologies, supply chain management, compliance with environmental laws, and meeting other regulatory requirements in a constantly evolving landscape.

Our Vehicle Electrification industry group includes an array of engineers and professionals with experience in various facets of electrification technology, including on-the-ground industry experience in automotive design and manufacture. We have substantive knowledge of power sources, including fuel cells, batteries, and capacitors, propulsion systems including motor and transmission design, power management, body and mechanical structure, steering, regenerative braking, navigation aids, vehicle-to-vehicle (V2V) and vehicle-to-infrastructure (V2I) communications, and other EV-related and vehicle technologies. Collectively, our intellectual property department has 35 electrical engineering degrees and 17 mechanical engineering degrees, in addition to experience representing numerous clients across the automotive industry, from vehicle manufacturers to parts suppliers and more.

VIDEO CODING

In the video coding space, we provide legal solutions in licensing, portfolio review and analysis, IP litigation, post-grant proceedings, and patent prosecution. We have significant experience in licensing of Standard Essential Patents (SEPs) and Fair Reasonable and Non-Discriminatory (FRAND) commitments. We handle numerous types of patent disputes, including high-stakes competitor litigation, FRAND/SEP litigation, and administrative patent challenges.

We help our clients capitalize on technology while addressing their challenges related to privacy, cybersecurity, technology transactions and licensing, antitrust, litigation, regulatory enforcement, and more. Our lawyers are skilled at evaluating issues with antitrust and IP law, including distribution and licensing arrangements, issues related to streaming media, licensing disputes, mergers and acquisitions, settlements of disputes, and standard setting. We also regularly counsel and represent clients in agency investigations involving declared SEPs, including reviewing the validity of patents declared to be essential to video coding standards.



IP TRENDS THE VIEW FROM THE TRENCHES

We asked a few industry pros for their thoughts about trends in IP, in their industries, about efficiency, and more.

What IP trends are you seeing in patent filings and strategy?

As a small company, we've developed a strategy with our patent counsel where we wait until we have enough research, data, internal trials, and third-party validation before we ever file for a patent so that we're confident that our patent claims cover us broadly. What that translates to in real world scenarios, is that we're often really far along in the go-to-market strategy and product development cycle before we ever tip our hand by filing for a patent. It creates a compression of work for our team in the last mile, but it's a way to provide some assurances that we're protecting current and future IP.

CEO of Chemical Industry Company

What trends do you see in your industry affecting IP strategy?

We're closely monitoring patent cliffs that multinational companies are facing. These days, you read a lot about that in pharmaceuticals: from companies facing huge revenue declines because of patent expiration in the next three to five years to the sheer number of patents that companies file to stave off the cliff. We're monitoring this situation in agriculture where it's reported that 19 active agrochemicals will come off patent over the next six years. Our technology can provide a tremendous value from a licensing perspective to those companies who have invested millions of dollars and years of R&D into active ingredients.

Bravis Brown, CEO, BPS Technology, LLC

Are Standard Essential Patents (SEPs) an Issue?

We've seen that clients in the high-tech field are seeing increased transactional activity surrounding standards essential patents, particularly in the video codec space. As a result, there is need for guidance navigating FRAND licensing in this area, especially with foreign tribunals declaring authority to set global FRAND rates.

What change in IP practice could help (or has helped) boost your efficiency or that of your innovation team?

We've been able to create an integrated development process that has helped us with our patent strategy tremendously. Because of the potentially endless applications of our [] technology, it would be easy to get distracted by every opportunity that pops up. Instead, we have been methodically evaluating active ingredients, and we've developed a process for each assessment to determine where we have the maximum potential. That allows us to then allocate the right resources and pursue patents on efforts of high-value. In 2020, that process allowed us to pursue and file about a dozen patent applications. To put that in perspective, there are labs out there triple our size with quadruple our manpower who might only file two or three patent applications in a year and that would be considered a win. It's really a testament to the efficiency and our team that the process provides to our evaluation stage gate.

Mid-Size Chemical Company

We greatly appreciate the participation of our valued clients in this Inaugural IP Trends feature.

MEET THE TEAM

NEW OFFICE LOCATIONS

SAN FRANCISCO

In 2020, Haynes and Boone opened a San Francisco office to serve clients in the intellectual property and emerging technologies sectors, adding more than a dozen lawyers in various practice areas in Palo Alto and San Francisco, and expanding our services in Palo Alto, including the creation of our Precision Medicine and Digital Health (PMDH) practice centered in the Bay Area. The PMDH Team is headed by Roger Kuan and includes Jason Novak, Phil Albert, and our newest partner Benjamin Pelletier.

The firm's Northern California expansion into San Francisco enhances our ability to serve technology-driven companies, investment managers, and financial services clients nationwide. Building on Haynes and Boone's reputation as a go-to firm in the technology sector, the San Francisco office provides a full range of corporate, labor and employment, litigation, and intellectual property services. Its attorneys have been helping tech companies, entrepreneurs, and venture capitalists for decades, relying on their deep ties to San Francisco and the Greater Bay Area.

In addition to the firm's growth in Northern California, our IP department has expanded nationwide, hiring new partners including Theresa Conduah in Southern California, Erin Hennessy in New York, Joseph Matal in Washington D.C., and promoting Jason Lao in Southern California and Vera Suarez, Jade Laye, and Adam Fowles across Texas to the partner ranks.



DALLAS-NORTH (OFFICE MOVE)

Haynes and Boone relocated its Dallas-North office to a new building in the Legacy West development, in Plano, about 25 miles north of downtown Dallas. The Dallas-North office is home to a large group of IP patent practice professionals, along with corporate, security and technology law professionals.

The Dallas-North professionals are prepared to handle any type of IP or technology law challenge. With degrees and experience in many different technology disciplines, the lawyer-engineers are qualified to help tech companies of any size in nearly every industry. The lawyers focus in the areas of medical devices, software, computer architecture, telecommunications, semiconductor processing, oil and gas, artificial intelligence (AI), and many others. They also work with both mature companies and startups to design solutions for their unique business problems.

MEET THE TEAM

NEW 2020/2021 LATERAL PARTNERS



PHIL ALBERT

July 2020
San Francisco | Palo Alto
Patent Prosecution



THERESA CONDUAH

November 2020
Orange County
Trademark



ERIN HENNESSY

May 2020
New York
Trademark



ROGER KUAN

May 2020
San Francisco | Palo Alto
Patent Prosecution,
Precision Medicine and
Digital Health



JOSEPH MATAL

July 2020
Washington, D.C.
Patent Trials and
Counseling



JASON NOVAK

May 2020
San Francisco
Patent Prosecution,
Precision Medicine and
Digital Health



BENJAMIN PELLETIER

January 2021
San Francisco
Patent Prosecution,
Precision Medicine and
Digital Health

PROMOTIONS 2020/2021



ADAM FOWLES

Promoted to Partner in
January 2021
Dallas - North
Patent Prosecution



JASON LAO

Promoted to Partner in
January 2021
Orange County
Intellectual Property
Litigation



JADE LAYE

Promoted to Partner in
January 2021
Houston
Patent Prosecution



VERA SUAREZ

Promoted to Partner in
January 2021
Dallas
Patent Prosecution



GREGORY HUH

Promoted to Partner in
January 2020
Dallas - North
Patent Trials and
Counseling



ROB LEBLANC

Promoted to Partner in
January 2020
Dallas
Trademark



STEPHANIE SIVINSKI

Promoted to Partner in
January 2020
Dallas
Intellectual Property
Litigation

RECOGNITIONS

MANAGING IP 2020

- Haynes and Boone has been ranked #5 in *Managing IP's* listing of the top petitioner law firms based on Patent Trial and Appeal Board (PTAB) filings from the first half of 2020
- Haynes and Boone was named Patent Prosecution Firm of the Year - U.S. South

INTELLECTUAL ASSET MANAGEMENT (IAM) PATENT 1000

Haynes and Boone was featured as a leading firm for patent prosecution nationally and in Texas, and was also ranked in patent litigation and patent transactions in Texas.

- Randall Brown
- Tom Chen
- Randall Colson
- Ralph Gabric
- Alan Herda
- Lee Johnston
- David McCombs
- Greg Michelson
- Laura Beth Miller
- David O'Brien
- David O'Dell
- Mark Tidwell
- Jeffrey Wolfson

JURISTAT

- With 120.53% organic growth in its patent prosecution practice, Haynes and Boone was featured as a top 25 growing patent firm.

MANAGING IP 2020 IP STARS DIRECTORY

Haynes and Boone was ranked nationally for Patent Prosecution and Patent Trial and Appeal Board (PTAB) Litigation as well as Trademark Prosecution.

Additionally, the firm was highly recommended in the Patent Prosecution, Trademark Prosecution, and Patent Contentious practice areas in Texas.

IP Stars:

- Purvi Patel Albers
- Jeffrey Becker
- David Bell
- Randall Brown
- Tom Chen
- Andrew Ehmke
- Erin Hennessy
- David McCombs
- Laura Beth Miller

Notable Practitioners:

- Scott Jarratt
- Rob LeBlanc

Rising Stars:

- Thuc Nguyen
- Aaron Taggart
- Jason Whitney

CHAMBERS USA 2020

- **Purvi Patel Albers**
Intellectual Property:
Trademark and Copyright
- **Jeffrey Becker**
Intellectual Property:
Trademark and Copyright
- **Randall Colson**
Technology: Outsourcing
- **Russell Emerson**
Intellectual Property
- **David McCombs**
Intellectual Property
- **Laura Beth Miller**
Intellectual Property

2020 WORLD TRADEMARK REVIEW 1000 (WTR 1000)

Haynes and Boone was recognized as a nationally ranked firm.

- Purvi Patel Albers
- Jeffrey Becker
- David Bell
- William Nash
- Richard Rochford

2020 WORLD TRADEMARK REVIEW (WTR) GLOBAL LEADERS

- Purvi Patel Albers
- Jeffrey Becker
- David Bell

LEGAL 500 U.S. 2020

- **Trademarks:
Non-Contentious (including
Prosecution, Portfolio
Management and Licensing)**

RECOGNITIONS

| PATEXIA INC.'S 2020 IPR INTELLIGENCE REPORT

- Haynes and Boone ranked as the 7th most active firm for petitioners at the PTAB and one of the top ten best performing firms overall.
- Top 100 most active attorneys representing PTAB petitioners:
 - David McCombs ranked 6th, with 122 petitioner cases
 - Eugene Goryunov ranked 14th, with 93 petitioner cases.
 - Andrew Ehmke ranked 35th, with 64 petitioner cases.
 - Theo Foster ranked 44th, with 58 petitioner cases.
 - Gregory Huh ranked 47th, with 57 petitioner cases.
 - Jonathan Bowser ranked 80th, with 41 petitioner cases.
 - David O'Dell ranked 91st, with 39 petitioner cases.
- Top 100 Most Active Attorneys overall (representing PTAB petitioners or patent owners):
 - Eugene Goryunov ranked 15th, with 146 cases.
 - David McCombs ranked 18th, with 131 cases.
- Top 100 most active attorneys representing patent owners at the PTAB:
 - Eugene Goryunov ranked 46th, with 53 cases.
- Top 100 best performing attorneys representing PTAB petitioners:
 - Theo Foster ranked 22nd, with a score of 73.7%.
 - David O'Dell ranked 26th, with a score of 72.8%.
 - Andrew Ehmke ranked 61st, with a score of 61.9%.
 - David O'Brien ranked 70th, with a score of 59.9%.
 - David McCombs ranked 74th, with a score of 59.5%.
- Top 100 best performing attorneys (representing PTAB petitioners or patent owners):
 - Theo Foster ranked 12th, with a score of 83.5%.
 - David McCombs ranked 31st, with a score of 70.8%.
 - Andrew Ehmke ranked 51st, with a score of 65.1%.
 - David O'Dell ranked 69th, with a score of 59.0%.
- Haynes and Boone was also ranked in the following PTAB categories:
 - 10th among Top 100 best performing firms overall, with a score of 89.8%.
 - 13th among Top 100 best performing firms representing petitioners, with a score of 86.6%.
 - 61st among Top 100 best performing firms representing patent owners, with a score of 56.9%.
 - 7th among Top 100 most active firms representing petitioners, with 228 cases.
 - 13th among Top 100 most active firms overall, with 251 cases.
 - 92nd among Top 100 most active firms representing patent owners, with 23 cases.

RECOGNITIONS

BEST LAWYERS IN AMERICA 2021

- **Ralph Gabric**
Litigation - Patent
- **Eugene Goryunov**
Patent Law
- **Laura Beth Miller**
Litigation - Patent
- **Purvi Patel Albers**
Trademark Law
- **Jeffrey Becker**
Litigation - Intellectual Property,
Technology Law, Trademark Law
- **Jason Bloom**
Litigation - Intellectual Property
- **Randall Brown**
Patent Law
- **Randall Colson**
Privacy and Data Security Law, Technology Law
- **Russell Emerson**
Litigation - Intellectual Property,
Litigation - Patent
- **David Harper**
Litigation - Intellectual Property
- **David McCombs**
Litigation - Intellectual Property,
Litigation - Patent, Patent Law, Technology Law
- **Dustin Johnson**
Patent Law
- **Thomas Kelton**
Litigation - Intellectual Property,
Trademark Law
- **David O'Dell**
Litigation - Intellectual Property
- **Gregory Webb**
Patent Law
- **Lee Johnston**
Litigation - Intellectual Property,
Litigation - Patent
- **Thomas Williams**
Commercial Litigation,
Litigation - First Amendment,
Litigation - Intellectual Property
- **Gary Edwards**
Litigation - Intellectual Property
- **William Nash**
Litigation - Patent

BEST LAWYERS "ONES TO WATCH"

- **Tiffany Cooke**
Litigation - Intellectual Property
- **Marc Legrand**
Corporate Law
- **Mike McArthur**
Intellectual Property Law,
Litigation - Intellectual Property
- **Stephanie Sivinski**
Litigation - Intellectual Property
- **Ellie Sowanick**
Intellectual Property Law
- **Michael Tobin**
Intellectual Property Law
- **Adam Fowles**
Intellectual Property Law
- **Charlene Liu**
Intellectual Property Law

IP QUIZ - ANSWER

IS THIS A PROTECTABLE TRADEMARK?

According to the U.S. Trademark Trial and Appeal Board, the answer is **MAYBE**.

In a precedential ruling, the Federal Circuit gave us a little more color on when colors can be protected under trademark law, in the hopes of painting a different hue on the U.S. Supreme Court's earlier rulings regarding the protectability of colors used in trade dress.

The issue arose after Forney Industries, Inc. filed a trademark application for the above colors for use with its packaging for various welding and machining goods. Forney sought to register the color mark without showing acquired distinctiveness. In the subsequent Office Actions, the examining attorney refused registration on the basis that the mark, which the examiner noted was a common color pattern in Forney's industry, was not "inherently distinctive" and could not be registered on the Supplemental Register without demonstrating some acquired distinctiveness. In affirming the examining attorney's refusal, the Board relied on the Supreme Court's decisions in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992), *Qualitex Co. v. Jacobson Prod. Co.*, 514 U.S. 159 (1995), and *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000) to conclude that a particular color on a product or its packaging "can never be inherently distinctive and may only be registered on a showing of acquired distinctiveness." The Board further held, contradictorily, that a color mark could only be inherently distinctive when associated with a particular shape.

On appeal, the Federal Circuit found that the Board had gone a shade too far in its interpretation of the Supreme Court's color-based trade dress rulings. "[C]olor marks can be inherently distinctive when used on

product packaging, depending upon the character of the color design," wrote U.S. Circuit Judge Kathleen M. O'Malley. "As the Supreme Court has made clear, inherent distinctiveness turns on whether consumers would be predisposed to 'equate the [color] feature with the source.'" The Federal Circuit noted that a distinct color-based product packaging mark can be inherently distinctive if it indicates the source of the goods to a consumer.

The Federal Circuit reasserted the distinction between product design vs. product packaging, noting that while the Supreme Court's *Wal-Mart* ruling held that product design trade dress can never be inherently distinctive, nothing in the *Wal-Mart* decision questioned the established case law regarding when product packaging can be inherently distinctive, and further noted that the Board should have considered whether Forney's mark satisfied the criteria for inherent distinctiveness. The Federal Circuit further clarified that nothing in the case law requires that a color mark be associated with any specific peripheral shape or border in order to be inherently distinctive.

The application has since been remanded to the examining attorney for further examination applying the Federal Circuit's standard and the examining attorney has once again refused the application on the basis that the particular color design is not inherently distinctive, primarily based on evidence that Forney's color pattern is commonly used by others in Forney's industry.

The case is *In re: Forney Industries, Inc.*, No. 19-1073 (U.S. Court of Appeal for the Federal Circuit, 2020).



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