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THE IP BEACON[®]

The Intellectual Property Law Newsletter
of Haynes and Boone, LLP

**YEAR IN REVIEW 2017-2018
SPECIAL EDITION**



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WELCOME

Welcome! We are pleased to highlight some of our representative intellectual property-related client successes and publications over the past year that might be relevant to your business 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 125 IP lawyers, 11 patent agents, and 2 scientific advisors. We participated in more than 30 *inter partes* review proceedings and a few other PTAB proceedings, and our patent prosecution team filed nearly 2,000 U.S. patent applications and helped issue more than 1,500 U.S. patents just in 2017. We also helped close the IP issues in dozens of financings, M&A transactions, and joint venture/licensing arrangements

We invite you to read on for updates on some of our litigation efforts, select IP-related publications, and a few of the awards our Intellectual Property team is most proud of from 2017.

RECENT CASES

ERICSSON INC.

Haynes and Boone defended Ericsson, a Swedish multinational communication and technology services corporation, in a patent suit brought by Sycamore IP Holdings LLC in the Eastern District of Texas. The Plaintiff in the case alleged that certain Ericsson products that fall under industry standards infringed the patent-in-suit. The matter was resolved with quite favorable terms for Ericsson.

Haynes and Boone also represented Ericsson as petitioner in four *inter partes* reviews (IPRs) of Intellectual Venture patents, with all claims found

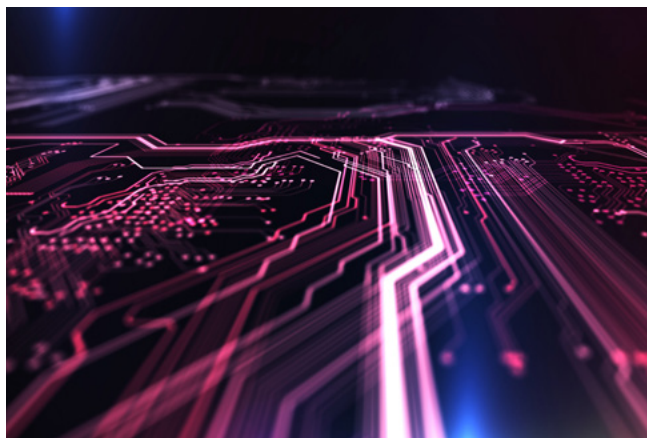
to be unpatentable on Final Written Decision by the Patent Trial and Appeal Board. These decisions were affirmed by the Federal Circuit. The firm continues to represent Ericsson as both petitioner and patent owner in at least four additional ongoing *inter partes* review matters pending before the U.S. Patent and Trademark Office.

[Read more](#)

RIVERBED TECHNOLOGY

Haynes and Boone successfully defended Riverbed Technology against Realtime Data in a jury trial in Tyler, Texas in May 2017. Realtime asserted two patents and a total of three claims. The trial team obtained jury verdicts of noninfringement and invalidity on two of the three claims (and the more important patent). While Realtime obtained an infringement verdict on the remaining claim, the jury awarded a fraction of their requested damages. Haynes and Boone successfully invalidated that same claim in an IPR. Post-verdict motions are pending in the district court case, while the IPR decision is on appeal at the Federal Circuit.

[Read more](#)



RECENT CASES

ZENIMAX MEDIA, INC. AND ID SOFTWARE

Haynes and Boone helped secure a significant verdict on behalf of clients Zenimax Media Inc. and ID Software in a high-profile jury trial followed closely by the technology industry. The three-week jury trial took place in the Northern District of Texas against Oculus VR Inc. and Facebook. The trial featured testimony from Mark Zuckerberg, Palmer Luckey, John Carmack, and Robert Altman. The Haynes and Boone trial team was led by Phillip Philbin, who tried the case with Skadden, Arps, Slate, Meagher & Flom, LLP. The verdict was a major victory for the clients in their years-long battle to be compensated for the theft of their cutting-edge technology used in virtual reality headsets.

[Read more](#)

BLUESTONE NATURAL RESOURCES II, LLC

Haynes and Boone lawyers secured a summary judgment of noninfringement for client BlueStone Natural Resources II, LLC in an Eastern District of Texas patent-infringement case.

Effective Exploration LLC claimed that natural gas wells BlueStone operates in the Barnett Shale infringed a patent for a system of drilling multiple wells from a single drilling pad. However, the Haynes and Boone team of Partner Russ Emerson and Associates Stephanie Sivinski and Matthew Chiarizio, successfully argued that Effective Exploration had not proven that BlueStone's wells met a required element of the patent.

[Read more](#)

LYNK LABS, INC.

Haynes and Boone helped client Lynk Labs, Inc., a leading LED technology manufacturer, settle a patent infringement and breach of contract suit against Acuity Brands, Inc.



In 2015, Lynk sued Juno Lighting, a subsidiary of Schneider Electric that Acuity acquired, in federal court for infringing patents related to LED lighting. Following nearly two years of litigation, Haynes and Boone helped its client successfully resolve the matter.

The Haynes and Boone team believes the settlement helps pave the way for successful actions against similarly situated companies and larger players in the lighting industry.

[Read more](#)

PUBLICATIONS

Three IP Lawyers Promoted in Haynes and Boone's 2018 Class of New Partners

Haynes and Boone News | January 1, 2018

Haynes and Boone is proud to announce the promotion to partnership of nine lawyers from the firm's Dallas, Mexico City and Richardson offices. Three of those lawyers are members of the IP Practice Group.

The three IP lawyers promoted are Charlie Jones, Michael Parsons and Clint Wilkins. The other lawyers promoted are Troy Christensen, Erin England, Cory Feldman, Patricia Mastropiero, Timothy Newman and Blaine Statham.

"Haynes and Boone's future is in good hands with these lawyers, each of whom exemplifies our culture and our values in their own unique way," said Managing Partner Tim Powers. "They have demonstrated dedication to clients, the firm and each other. We are proud to call them our partners and look forward to how they will shape the firm in the years to come."

Mastermine v. Microsoft: Following Precedent or Pivoting Away?

Haynes and Boone News | December 6, 2017
Adam Fowles

At the end of October, in *Mastermine Software, Inc. v. Microsoft Corp.*, No. 2016-2465 (Fed. Cir. Oct. 30, 2017), the Federal Circuit reversed a district court's determination that a system claim was invalid for indefiniteness. The Federal Circuit disagreed with the district court's conclusion that certain claims were indefinite for improperly claiming two different classes of subject matter. The court found that the claims informed those skilled in the art with "reasonable certainty" in conformity with the *Nautilus* guidance, specifically on the basis that one can determine when infringement occurs.

Tom King in *Law360*: Amicus Arguments for and Against *Inter Partes* Review

Law360 | November 22, 2017
Thomas King

Over the last five years, the U.S. patent system has been dramatically impacted by new post-grant proceedings such as *inter partes* reviews. However, the constitutionality of these proceedings has been called into question by the U.S. Supreme Court granting certiorari in *Oil States Energy Services LLC v. Greene's Energy Group LLC*, which asks whether IPRs are consistent with Article III and the Seventh Amendment. Recognizing the potential of a decision in *Oil States* to impact the patent system, more than 50 amicus briefs representing hundreds of amici and a substantial share of the U.S. GDP have been filed with the court.

Raghav Bajaj in *Law360*: Ignore Broader Claim Constructions at Your Own Risk

Law360 | November 7, 2017
Raghav Bajaj

In *Owens Corning v. Fast Felt Corp.*, No. 2016-2613, 2017 U.S. App. LEXIS 19827 (Fed. Cir. October 11, 2017), the Federal Circuit reversed the Patent Trial and Appeal Board's (PTAB) final written decision in IPR2015-00650. While the PTAB found that the petitioner had failed to show obviousness of any challenged claim, the Federal Circuit disagreed, finding that under a proper broadest reasonable interpretation of the claims, the "record conclusively establishe[d] obviousness." The Federal Circuit therefore reversed the PTAB's final written decision without remand, finding the challenged claims unpatentable as obvious.

PUBLICATIONS

Alan Wang in *Law360*: Still Difficult for Patent Holder to Use Equivalents

Law360 | October 24, 2017

Alan Wang

In *Jang v. Boston Scientific Corp. & Scimed Life Systems Inc.*, No. 16-1275 (Fed. Cir. Sept. 29, 2017), the Federal Circuit affirmed the district court's vacatur of the jury's infringement verdict, finding that Boston Scientific Corporation's (BSC) product did not infringe the asserted claims of Dr. David Jang's patent under the DOE because Jang did not meet his burden of proving that his DOE theory did not ensnare the prior art.

Take Action by December 31st or Lose DMCA Safe Harbor Protection for User-Generated Content

Haynes and Boone News | October 23, 2017

Jason Bloom and Jeffrey Becker

The Digital Millennium Copyright Act of 1998 (DMCA) provided a safe harbor to shield website owners, ISP's, and other online service providers from certain claims for copyright infringement based on user-generated content. This safe harbor has been very successful. But to obtain its effective protections, everyone that relies on it must register an agent to receive DMCA notices using the Copyright Office's new online DMCA registration system by December 31, 2017. Even website owners, ISP's, and other online service providers that previously registered their DMCA agent prior to December 1, 2016 must re-register using the new online system by December 31, 2017.

Reshaping IPR Estoppel

Haynes and Boone News | October 5, 2017

David O'Brien and Clint Wilkins, Ph.D.

Since the June grant of certiorari in *Oil States Energy Services, LLC v. Greene's Energy Group, LLC*, the possibility that the Supreme Court of the U.S. (SCOTUS) might find *inter partes* review (IPR), an adversarial proceeding at the U.S. Patent and Trademark Office (USPTO), to be unconstitutional has cast a shadow over IPR and other similar post-grant proceedings before the Patent Trial and Appeal Board (PTAB).

Notwithstanding the shadow, another case before the court this term may ultimately have greater effect on the interplay between PTAB and district court litigation. This article considers that case, *SAS Institute Inc. v. Matal*, in which the court also granted certiorari, just three weeks prior to *Oil States*.

Brian Kwok in *Law360*: Patent Venue Sort-Out Will Continue

Law360 | September 27, 2017

Brian Kwok

A decision by the U.S. Court of Appeals for the Federal Circuit setting guidelines where patent suits can be filed provided much-needed clarity in a contentious area of the law and should result in many cases leaving the Eastern District of Texas.

The appeals court ruled that U.S. District Judge Rodney Gilstrap of the Eastern District of Texas abused his discretion when he found that his court was the proper venue for a patent infringement suit against supercomputer maker Cray Inc. just because the Seattle-headquartered company has a sales representative who works remotely from his home in the district.

PUBLICATIONS

Cisco Honors Haynes and Boone for “Excellence in Partnering”

Haynes and Boone News | August 23, 2017

Worldwide technology provider Cisco Systems, Inc. selected Haynes and Boone for its *Excellence in Partnering* award in recognition of the firm’s stellar results on patent litigation and related issues.

In announcing the award, Cisco Vice President, Litigation Leslie McKnew thanked Partners David McCombs, Theo Foster, Andrew Ehmke and Ken Parker for their “incredible work” and said the team they led “has provided exemplary legal services and achieved significant successes in key matters” for the company.

Biosimilar Product Approval and the Implications of *Sandoz v Amgen*

Haynes and Boone News | July 31, 2017

Jeffrey Wolfson, Paul Dietze, Elizabeth Crompton, and Mini Kapoor, Ph.D.

The U.S. Supreme Court’s much-awaited decision in *Sandoz Inc. v. Amgen Inc.*, 2017 BL 198127, U.S., No. 15-1039, 6/12/17 is favorable to biosimilar applicants on two key sections of biosimilars law but many questions remain that will need to be addressed through litigation or regulation under this complex new regulatory regime.

What to Know About Post-Grant Review and the Biotech Industry

Haynes and Boone News | February 22, 2017

Brian Kwok, Nicholas Martini, and Nicole Johnson

Less than two days after an enforcement moratorium expired, U.S. and EU officials in transatlantic data transfer talks have reached a new “Privacy Shield” framework to replace the Safe Harbor regime struck down in the Schrems case. The new framework, also known as Safe Harbor 2.0, is expected to increase obligations on U.S. companies that handle the personal data of Europeans, while bringing stronger privacy enforcement by the U.S. Federal Trade Commission (FTC). The new Privacy Shield framework also includes new limitations on data surveillance by U.S. authorities, which had been a major sticking point during the negotiations.

2017 NEWSLETTERS

The IP Beacon®

March 2017 June 2017 September 2017

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The IP Beacon®: Patent Law Review

AWARDS

TEXAS LAWYER LITIGATOR OF THE WEEK

- **Russell Emerson**

CISCO “EXCELLENCE IN PARTNERING” AWARD

- **David McCombs**
- **Theo Foster**
- **Andrew Ehmke**
- **Kenneth Parker**

TEXAS SUPER LAWYERS 2017

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

Intellectual Property and
Intellectual Property Litigation

WASHINGTON, D.C. SUPER LAWYERS 2017

- **John Bateman**
- **Jeffrey Wolfson**
- **Philip Hampton**

ILLINOIS SUPER LAWYERS 2017

- **Jim Shimota**

SOUTHERN CALIFORNIA SUPER LAWYERS 2017

- **Kenneth Parker**

BEST LAWYERS IN AMERICA 2018

- **Jeffrey Becker**
Litigation - Intellectual Property,
Technology Law, Trademark Law
- **Jason Bloom, David O’Dell,
and Gary Edwards**
Intellectual Property Litigation
- **Randall Brown**
Patent Law
- **Randall Colson**
Privacy and Data Security Law,
Technology Law
- **Russell Emerson, David
Harper, David McCombs, and
Phillip Philbin**
Commercial Litigation, Litigation-
First Amendment, Litigation -
Intellectual Property
- **Kenneth Parker**
Litigation - Intellectual Property,
Trademark Law
- **Thomas Williams**
Commercial Litigation, Litigation-
First Amendment, Litigation -
Intellectual Property
- **Phillip Woo**
Patent Law

CHAMBERS USA 2017

- **Purvi Patel Albers and
Jeffrey Becker**
Intellectual Property:
Trademark and Copyright (Texas)
- **Randall Colson**
Technology: Outsourcing (Texas)
- **Russell Emerson, David
McCombs, and Phillip Philbin**
Intellectual Property (Texas)

INTELLECTUAL ASSET MANAGEMENT (IAM) PATENT 1000

- **Randall Brown**
- **Randall Colson**
- **David McCombs**
- **Phillip Philbin**
- **Mark Tidwell**
- **Jeffrey Wolfson**

TEXAS SUPER LAWYERS RISING STARS 2017

- **David Bell**
- **Jason Bloom**
- **Gavin George**
- **Charles Jones**

AWARDS

MANAGING INTELLECTUAL PROPERTY 2017 IP STARS

Patent Stars

- Randall Brown
- Andrew Ehmke
- David McCombs
- Kenneth Parker

Trademark Stars

- Purvi Patel Albers
- Jeffrey Becker
- Kenneth Parker

DALLAS BUSINESS JOURNAL 2017 40 UNDER 40 AWARDS

- Jason Bloom

WORLD TRADEMARK REVIEW 2017

- Purvi Patel Albers
- Jeffrey Becker
- David Bell
- Philip Hampton
- Jennifer Lantz
- William Nash
- Kenneth Parker
- Richard Rochford

D MAGAZINE BEST LAWYERS IN DALLAS

- Purvi Patel Albers
- Randall Colson
- David McCombs

WORLD INTELLECTUAL PROPERTY REVIEW 2017 LEADERS DIRECTORY

- Purvi Patel Albers
- Jeffrey Becker
- David McCombs

INTERNATIONAL LAW OFFICE (ILO) AND LEXOLOGY CLIENT CHOICE AWARD 2017

- David Bell

IP QUIZ

IS THERE A
LIKELIHOOD OF
CONFUSION?

Attempted registration of

KU:L

for bicycles

with the registered mark

kühl

for rugged outdoor
clothing, namely jackets,
shirts, pants, shorts,
t-shirts, and hats

See answer on the next page.

IP QUIZ - ANSWER

IS THERE A
LIKELIHOOD OF
CONFUSION?

Attempted registration of

The logo consists of the letters 'K', 'U', and 'L' in a bold, sans-serif font. The 'U' is stylized with a colon inside it. The 'K' and 'L' are connected to the 'U'.

for bicycles

with the registered mark

The logo consists of the letters 'k', 'u', 'h', and 'l' in a lowercase, sans-serif font. The 'u' is stylized with a dot above it.

for rugged outdoor
clothing, namely jackets,
shirts, pants, shorts,
t-shirts, and hats

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

The Board sustained an opposition brought by the owner of a family of KÜHL mark finding that there was a likelihood of confusion between the applicant's mark KU:L (stylized) for bicycles and one of the opposer's marks for rugged outdoor clothing.

As to the similarity of the marks, the Board held that ordinary consumers would consider the marks similar as to their appearances, sound, connotation, and commercial impression in part because both marks would be pronounced as "cool" and consumers would therefore perceive them to have similar meanings. The Board also found that the opposer's mark, while not clearly established as famous, was commercially strong, since it had achieved consumer recognition through more than 24 years of use in connection with a full line of outdoor wear sold through 1,000 retailers nationwide — a factor that also weighed in favor of a likelihood of confusion.

With regard to the similarity of the goods, the Board found bicycles and rugged clothing to be related. Of particular importance was the fact that the opposer sponsored numerous bicycle races and competitive bicycle teams, where the KÜHL mark was displayed

on the competitors' jerseys. The Board found that this exposure, coupled with the strength and uniqueness of the mark, evidenced a likelihood of confusion as to the source of the goods. The Board also found evidence of numerous third-party retailers that sell both bicycles and clothing, and the coexistence of 24 use-based, third-party registrations for marks covering both bicycles and various clothing persuasive to show that clothing and bicycles move in the same channels of trade. Finally, consumers in such circumstances were found to be unlikely to make careful purchasing decisions and more likely to "impulse" shop, which also supported a finding of likely confusion. As such, the Board sustained the opposition.

Alfwear Inc. v. Shuff, Opposition No. 91224467 (December 1, 2017) [not precedential].

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

IP BEACON® PARTNER CONTACTS



JOE MENCHER
PARTNER
joe.mencher@haynesboone.com
+1 512.867.8459



JEFF WOLFSON
PARTNER
jeff.wolfson@haynesboone.com
+1 202.654.4565