

The IP Beacon®

The Intellectual Property Law Newsletter of
Haynes and Boone, LLP

2022 YEAR IN REVIEW



Welcome

Welcome to the recap edition of the *Haynes Boone IP Beacon® Year in Review*. We are pleased to highlight key intellectual property (IP) news from 2022, and some of our representative IP client successes and publications over the past year that might be relevant to your business success in 2023.

Our patent trials team represented clients in 78 *inter partes* reviews/PTAB proceedings that were filed in 2022, and our patent prosecution team filed almost 2,000 U.S. patent applications and helped issue over 1,630 U.S. patents in 2022.

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 2022.

Year in Review Cases

[‘IPR TRICKS OF THE TRADE: FEDERAL CIRCUIT CLARIFIES SCOPE OF IPR ESTOPPEL’ IN REUTERS](#)



Eugene Goryunov



David McCombs



Jonathan Bowser

Patent Trial and Appeal Board post-grant validity challenges – for example, *inter partes* reviews (IPR) – are frequent components of a patent litigation strategy. However, filing an IPR petition does not come without risk. If the petitioner is unsuccessful in showing that the challenged claims of a patent are unpatentable, the petitioner may be estopped from challenging the validity of the challenged claims again, at least based on grounds that the petitioner raised or reasonably could have raised.

[‘HOW TO NAVIGATE PATENT ELIGIBILITY OF AI-DRIVEN DIAGNOSTICS’ IN MED DEVICE ONLINE](#)



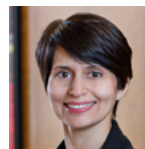
David McCombs



Vincent Shier



Eugene Goryunov



Dina Blikshteyn



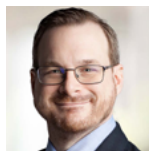
Jamie Raju



Brooke Cohen

In an attempt to formalize the law on patent eligibility under 35 U.S.C. § 101, the U.S. Supreme Court issued two major decisions outlining a two-part test: *Mayo v. Prometheus* and *Alice v. CLS Bank*. Instead of bringing clarity, however, *Mayo* and *Alice* spawned discord among various district courts and, as a result, increased the uncertainty in § 101 jurisprudence. The U.S. Supreme Court had the opportunity to clarify the state of the law in *American Axle*, but declined to do so, denying the certiorari petition.

[‘PTAB RULING SHOWS NEED TO SPLIT TERMINAL DISCLAIMER’ IN LAW360 ARTICLE](#)



Vincent Shier



Joseph Matal

The recent decision by the U.S. Patent and Trademark Office’s Patent Trial and Appeal Board in *Ex Parte Collect LLC* illustrates the overreach in current terminal disclaimer practice.

The mechanical application of the USPTO’s pre-Uruguay Round Agreements Act rules to post-URAA applications has transformed an equitable judicial doctrine into one that is having unintended punitive impacts, especially for same-family patents. Terminal disclaimer requirements need to be modified to serve equity by splitting the patent term disclaimer from the common ownership disclaimer.

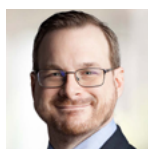
[‘HOW TO NAVIGATE THE PATENTING CHALLENGES OF AI-ASSISTED DRUG DISCOVERY’ IN PHARMACEUTICAL ONLINE](#)



Eugene Goryunov



David McCombs



Vincent Shier



Dina Blikshteyn



Brooke Cohen

The pharmaceutical industry faces multiple challenges when introducing new drugs to the market. Not only does the process sometimes take over a decade, over 90% of drugs fail before FDA approval. In addition, the average cost to bring a single drug to market is a staggering \$3 billion. With “low hanging fruit” drugs already in the market, companies are now looking at complicated or rare diseases and finding it more difficult to discover the next blockbuster treatment.

[LAWYERS PROVIDE UPDATE ON WRITTEN DESCRIPTION REQUIREMENT IN PATENT LAWYER MAGAZINE](#)



David McCombs



Eugene Goryunov



Alan Wang



Li Yang

In our earlier article – “Negative Limitations and the Written Description Requirement” – we examined the state of law on the written description requirement for negative limitations in view of *Novartis Pharmaceuticals v. Accord Healthcare Inc.*, No. 2021-1070 (Fed. Cir. Jan. 3, 2022). On June 21, 2022, the U.S. Court of Appeals for the Federal Circuit vacated its decision in *Novartis* and further refined the standard for when a silent specification can meet the written description requirement.



PANASONIC HOLDINGS CORP. V. GETAC TECHNOLOGY CORP. ET AL.

Haynes Boone represented Panasonic Holdings Corp. in its lawsuit against Getac Technology Corp. claiming some of their laptops violated four design patents issued by the U.S. Patent and Trademark Office from September 2016 to May 2017. In court, the jury found that Getac infringed three of Panasonic's Toughbook laptop patents and awarded \$17.5 Million in damages. The patents in suit are U.S. Design Patent Nos. D766,232; D756,998; and D785,634. In August 2022, Panasonic requested attorney fees and costs for counsel.

HAYNES BOONE WINS CDRP DISPUTE FOR MATTRESS FIRM

Haynes Boone achieved a rare win for client Mattress Firm, recovering an infringing third-level domain name, which incorporated the client's name, via the CentralNic Dispute Resolution Policy (CDRP), a largely unknown but powerful tool for brand owners in the case: *Mattress Firm, Inc. v. Redacted for Privacy / Privacy service provided by Withheld for Privacy ehf, FA2203001989499*.

AMERICAN PATENTS LLC V. UNIFIED PATENTS LLC.

Haynes Boone represented Unified Patents in *American Patents LLC v. Unified Patents LLC* (21-1635) involving U.S. Patent No. 7,373,655. A panel composed of U.S. Circuit Judges Pauline Newman, Alan D. Lourie and Richard G. Taranto, upheld the PTAB's invalidation of a network patent challenged by Unified Patents. American Patents' appeal did not challenge the PTAB's analysis of the patent's merits and instead focused on procedural aspects of the PTAB's ruling unrelated to the merits. The panel wasn't persuaded and affirmed the PTAB's judgment of invalidity.

HELMERICH & PAYNE INTERNATIONAL DRILLING COMPANY ET AL. V. NABORS DRILLING TECHNOLOGIES USA, INC.

Haynes Boone served as lead PTAB counsel for patent owner Nabors Drilling Technologies in *Helmerich & Payne International Drilling Company et al. v. Nabors Drilling Technologies USA, Inc.* The PTAB denied institution of trial for petitioner's validity challenges to six (6) of Nabors' patents that we helped Nabors obtain. The PTAB denied institution of IPR petitions against six Nabors' patents involved in parallel litigation against Helmerich & Payne. IPR2021-00621, IPR2021-00671, IPR2021-00897, IPR2021-01018, IPR2021-01043, and IPR2021-01044, and the USPTO issued a reexamination certificate in a subsequent related proceeding without any further issues being raised.

Bilt TECHNOLOGIES, INC. V. Bilt, INC. (SDNY) BILT, INC. V. Bilt TECHNOLOGIES, INC. (TTAB)

Our client BILT provides official 3D instructions for some of the world's best-known brands. With voice and text prompts, the free BILT app guides consumers through product assembly and installation with self-paced steps. Millions of users in over 200 countries have downloaded our client's app.

We initially filed a Notice of Opposition in the TTAB in May of 2021 against a trademark application for the mark BILT filed by Bilt Technologies. As discovery was proceeding, Bilt Technologies filed a Complaint in federal court in New York claiming that it was not infringing our client's rights, but that our client was the infringer, even though our client was in business for years before the other company ever launched. As a result, the TTAB Opposition has been suspended and we have been actively litigating the case in federal court in New York throughout 2022

Representative 2022 IP Transactions

- Haynes Boone served as Intellectual Property counsel to **Orthofix** in connection with its merger with SeaSpine, a combination that will create a leading global spine and orthopedics company with combined portfolios of biologics, innovative spinal hardware, bone growth therapies, specialized orthopedic solutions and a leading surgical navigation system, the companies announced in a release. Working closely with Orthofix, our team provided input on the agreement and advised the company regarding intellectual property issues associated the proposed merger.
- Haynes Boone's Life Sciences team served as sole patent counsel to **TeneoBio, Inc.** and advised on all IP-related aspects of the company's acquisition by Amgen. Following completion of the transaction, Amgen engaged Haynes Boone to continue managing the legacy TeneoBio patent portfolio.
- We represented **American Airlines** in the revision and negotiation of several agreements, amendments, and statements of work with various vendors covering the outsourcing, implementation, development and delivery of software, platforms, and related services, including:
 - Negotiation of an agreement with a technology vendor to deploy an artificial intelligence solution to continuously monitor and update COVID-19 restrictions posted online by various governments and agencies.
 - Negotiation of numerous 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.
- Drafting and negotiating 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.
- We represented **Alcon Vision** in various information technology and data processing agreements in support of all facets of its operations. We assisted with the drafting and negotiation of dozens of SaaS agreements, on premises software licenses, IT services, and hosting agreements. We also assisted in the revision and negotiation of over a dozen new amendments and statements of work with various vendors covering the outsourcing, implementation, development and delivery of new software, platforms, and related services to support Alcon.
- Haynes Boone represented **SK Lubricants Co., Ltd.** in its investment in Green Revolution Cooling, Inc., a leading producer of single-phase immersion cooling technologies. The IP team evaluated intellectual property assets, conducted diligence of Green Revolution IP, and negotiated IP issues in the transaction documentation.
- We advised **NextGen Healthcare** in its acquisition of TSI Healthcare, which included providing counsel on the intellectual property issues and conducting the privacy diligence, which involved investigating and verifying the types of personal data processed by the target, the privacy policies and consent forms of TSI Healthcare, as well as the company's technical and organizational data security measures.
- We led the intellectual property and privacy due diligence effort related to **Valesco's** investment in North American Kitchen Solutions, Inc. (NAKS), which included investigating and verifying the intellectual property and third-party licenses held by the target company, as well as reviewing the processing of personal data by NAKS and the company's relevant privacy policies.



Practice Highlights

BIOTECHNOLOGY

Our growing Biotechnology Intellectual Property team provides legal insight on intellectual property strategy, patent prosecution and transactional IP due diligence for Life Sciences companies of all sizes. We provide strategic counseling for clients in the areas of large molecule therapeutics (e.g., antibodies and peptides), small molecule therapeutics, cellular therapeutics, molecular diagnostics, biotechnology, and alternative foods/meat substitutes.

Our practitioners routinely handle domestic and foreign prosecution for patent portfolios of all sizes, providing sophisticated counseling and portfolio management, as well as representation in post-grant proceedings at the U.S. Patent and Trademark Office (USPTO), litigation in federal courts and cases before the U.S. International Trade Commission (ITC).

The high volume of our filings over the years has also given us particularly strong skills and insight into helping clients with patent reviews and reexaminations, reissues and other contested post-grant proceedings before the USPTO, including *inter partes* reviews and covered business method patent reviews.

We have devised IP strategies that encompass not only patents, but also data rights and the strategic use of trade secrets to provide overlapping end-to-end protection for proprietary products and services and partnering agreements to leverage or monetize such technology and IP rights.

Depth of Industry Knowledge – We understand the Biotechnology industry inside and out – from where it’s been, to where it is, to where it’s going next. We have managed or worked in the following areas:

Monoclonal Antibodies, Antibody Drug Conjugates (ADCs), Bispecific T-cell Engagers (TCEs) and CAR-T Cells

- Genomic Analysis and Gene Editing
- Immunology
- Computational Biology
- Molecular Diagnostics
- Synthetic Oligosaccharides
- AI/Machine Learning as applied to the Life Sciences Sector
- Tumor Profiling Assays and Interpretive Software
- Bioprocess Manufacturing

QUANTUM TECHNOLOGIES

Quantum technology takes advantage of the physics of subatomic particles. Past innovation in quantum technology yielded MRI machines, lasers, and atomic clocks. However, a new wave of technology is now being researched and developed for improvements in existing quantum products and services, as well as interesting products and services never before implemented that take advantage of quantum behaviors. A profound increase in research and investment is being focused on cutting-edge quantum computing and quantum sensing technologies. As more companies enter the quantum technology playing field, increased competition makes it more important than ever for companies to consider appropriate intellectual property protection to best protect the end goals of the company.

For example, many quantum technology companies are start-ups with the goal of going public via IPO. Quantum technology companies pursuing this goal or other goals need to consider how best to brand their business and how to protect their specific innovations to maximize value for potential investors and distinguish themselves from competitors. Also, in forming joint ventures and collaborations with others, careful consideration of IP issues is critical for ensuring that the company will have the rights needed to maintain control over their innovations.

To best advise clients in the quantum technology field, we have found it beneficial for attorneys to have science backgrounds and an understanding of advanced physics. Members of the Haynes Boone Quantum Technologies Practice Group hold degrees in computer science, electrical engineering, physics, and other relevant fields, and many of our attorneys have worked in-house at leading quantum-related technology companies. Our Quantum Technologies team is well-situated to focus on all aspects of intellectual property protection for the highly specialized field of quantum technology. We work closely with our clients as trusted advisors to protect and enforce our clients' intellectual property rights.

Our experience covers all aspects of business development services necessary for companies pursuing the development of quantum technologies, including patents, trademarks, technology transactions and corporate/venture capital.

Publications

'The Made in China Act'

Real Clear Policy | November 21, 2022

Joseph Matal

Haynes Boone Partner Joseph Matal authored an article in Real Clear Policy warning about a congressional bill that would abolish patent validity review at the U.S. Patent and Trademark Office (USPTO).

'AI And Life Sciences: How Much Disclosure Is Enough?'

Life Science Leader | November 21, 2022

David McCombs, Vincent Shier, Eugene Goryunov, Dina Blikshteyn, Brooke Cohen

Under the *quid pro quo* of the patent system, inventors are given a 20-year exclusionary right over their inventions in return for disclosing to the public sufficient details about their invention. Through this exchange, inventors are rewarded for investing time and resources into advancing the science. At the same time, science continues to advance as a result of the enabling disclosure.

'How Mayo V. Prometheus Strays from Patent Precedent'

Law360 | November 17, 2022

Joseph Matal, Vincent Shier, Angela Grant

Over the last four years, the U.S. Supreme Court has requested the views of the solicitor general in five different patent-eligibility cases. Though the high court has yet to grant review in a case, it appears to be concerned about this area of law.

'IPR Tricks of the Trade: Options to Obtain Review of PTAB Decision'

Thomson Reuters Westlaw Today | October 28, 2022

David McCombs, Eugene Goryunov, Jonathan Bowser

The Patent Trial and Appeal Board (PTAB) adjudicates disputes over the validity of an issued patent. Parties accused of infringement often file a petition for inter partes review (IPR) to challenge the validity of an asserted patent.

'Interactive Wearables is Not the 101 Case That You've Been Waiting For'

IPWatchdog | October 24, 2022

Joseph Matal

On October 3, the U.S. Supreme Court once again requested the views of the Solicitor General (SG) in a Section 101 case, *Interactive Wearables v. Polar Electric Oy*.

'Ferretting Out Fakers: How Cryptocurrency Companies Can Protect Their Brands in Cyberspace'

Brave New Coin | October 12, 2022

Erin Hennessy, Annie Allison

Brand imitation, hijack and infringement, are key concerns for many crypto brands - especially in an ecosystem where funds can be transferred effortlessly and anonymously. This article by IP lawyers Erin Hennessy and Annie Allison highlights the various vulnerabilities faced by cryptocurrency brands and shares tips for identifying and safeguarding against infringers.

'IPR Tricks of the Trade: Director Vidal Implements Changes to Discretionary Institution Policies at PTAB'

Thomson Reuters Westlaw | September 14, 2022

David McCombs, Eugene Goryunov, Jonathan Bowser

Kathi Vidal has implemented significant policy changes for the Patent Trial and Appeal Board (PTAB) since becoming Director of the U.S. Patent and Trademark Office approximately four months ago. One of those changes included a clarification of the circumstances in which the PTAB may exercise its discretion to deny institution of a petition for inter partes review (IPR) or post-grant review (PGR) of a patent that is involved in parallel litigation in U.S. federal district court or the International Trade Commission (ITC).

‘Patent Eligibility Reform May Require a Legislative Approach

Law360 | September 13, 2022

Vincent Shier

On July 25, U.S. Patent and Trademark Office Director Kathi Vidal used the director’s blog to explain that she will be revisiting the 2019 Subject Matter Eligibility Guidance and requested public comment.

Vidal recently issued a Federal Register notice acknowledging “overwhelming interest in this subject matter” and extended the period for providing comment to Oct. 15. In addition, the notice requires that any comments be submitted via the Federal eRulemaking Portal.

‘The Effects of Erroneous Prior Art Disclosure on an Invalidity Challenge’

Patent Lawyer Magazine | September 9, 2022

David McCombs, Eugene Goryunov, Alan Wang, Tim Hsu

An invalidity challenge to a claim may not rely upon an erroneous portion of a prior art disclosure if the error would have been apparent to one of ordinary skill in the art. This article examines the current state of the law on determining whether an error in a prior art disclosure is obvious in view of the latest opinion from the U.S. Court of Appeals for the Federal Circuit: *LG Electronics v. ImmerVision Inc.*

Calmer Waters Ahead? Senator Tillis’ Proposed 35 U.S.C. § 101 Legislation Brings Highly Requested Legislative Review to Patent Eligibility Storm

Haynes Boone News | August 22, 2022

Vincent Shier, Forrest Gothia

On August 3, 2022, Senator Thom Tillis, Ranking Member of the Senate IP Subcommittee, released a first draft of what could become the highly sought-after change in U.S. patent eligibility that many in the patent world have been seeking in recent years. After the Supreme Court decisions of *Mayo*, *Myriad* and *Alice*, and its most recent refusal to further examine the issue in *American Axle*, patent practitioners can only hope that this will be the light at the end of the tunnel.

‘Protecting Your Artificial Intelligence Innovations’

Wine Industry Advisor | June 30, 2022

Eugene Goryunov, David McCombs, Dina Blikshsteyn, Austin Lorch

Artificial Intelligence (AI) can be found in virtually all aspects of modern life, from manufacturing to healthcare, finance, social media and more. In the wine industry, AI is involved in everything from wine production to wine distribution — and even wine recommendation. This is accomplished using, as an example, agricultural robots, flavor and food pairing predictors, production efficiency analysis, and advanced marketing tools.

‘Are Artificial Intelligence Technologies a Game Changer for Patents in Finance?’

The Patent Lawyer | June 27, 2022

Eugene Goryunov, David McCombs, Dina Blikshsteyn, Nicolette Nunez

A new wave of patentable subject matter has arrived - artificial intelligence (AI) based inventions - and the financial sector should be paying attention. AI technologies are defined by the U.S. National Institute of Standards and Technology (NIST) as systems comprising “software and/or hardware that can learn to solve complex problems, make predictions or undertake tasks that require human-like sensing (such as vision, speech, and touch), perception, cognition, planning, learning, communication, or physical action.” The financial sector is using and investing in AI technologies to improve operation, efficiency, and security. J.P. Morgan Chase, for example, opened an AI lab to fully capitalize on AI.2 Applications of AI, and machine learning technologies range from chatbot assistants to fraud detection and security to actual asset management.

‘Thank You for Your Service, Justice Breyer’

Thomson Reuters *Westlaw Today* | June 24, 2022

Daniel Geysler, David McCombs, Eugene Goryunov, Nicolette Nunez

When the U.S. Supreme Court rises for its summer recess, a legal legend will descend from the bench one final time. After 27 years on the high court, Justice Stephen Breyer is retiring at the end of the Term. Justice Breyer has dedicated decades of service to the legal community and the nation, shaping all areas of the law with his distinct sense of pragmatism and commitment to common-law adjudication. And while he has touched virtually every major legal doctrine in his decades on the bench, we focus today on his oversized impact in the field of intellectual property.

Reuters IPR Tricks of Trade: USPTO Director's Changes to PTAB Review Procedures

Reuters | June 17, 2022

David McCombs, Eugene Goryunov, Jonathan Bowser

Kathi Vidal was sworn in as the Director of the U.S. Patent and Trademark Office (USPTO) on April 13, 2022. In her brief tenure, Vidal has already implemented policy changes aimed at increasing transparency at the Patent Trial and Appeal Board (PTAB).

The amount of authority the USPTO Director has to impact the PTAB's decisions has been a hot topic for Congress, the courts, and practitioners in recent years. In *United States v. Arthrex, Inc.*, the Supreme Court held that the PTAB's Administrative Patent Judges (APJs) were unconstitutionally acting as principal officers, rather than inferior officers, because APJs were issuing final decisions that were unreviewable by the Director. (141 S.Ct. 1970 (2021)).

Sign Ordinances and the First Amendment - City of Austin v. Reagan National Advertising

Haynes Boone News | May 19, 2022

Reid Pillifant

The Supreme Court has narrowed its definition of content based speech discrimination, retreating from a 2015 ruling that sought to draw a bright-line rule for content-related regulations. How the Court defines content discrimination is crucial in a variety of First Amendment cases, since that definition determines what level of scrutiny is applied.

In *City of Austin v. Reagan National Advertising*, decided on April 21, 2022, the Court held that Austin's distinction between on- and off-premises advertising is not a content-based regulation that is subject to strict scrutiny.

Mirror, Mirror? A New PDF Backup Option for DOCX Filings via Patent Center

Haynes Boone News | May 9, 2022

Jeffrey Wolfson, Braden Davies

In an effort to ease the transition to the new DOCX filing format for non-provisional utility patent applications, the United States Patent and Trademark Office (USPTO) recently announced it will allow the

option to file an applicant-generated PDF along with the DOCX filing of the application through December 31, 2022.

Practical Considerations About Your Russian IP

Haynes Boone News | March 22, 2022

Jeff Wolfson

In the wake of financial sanctions by the United States, the United Kingdom, EU nations, and various other countries against Russia for its unprovoked attack on Ukraine¹, you might be considering what, if anything, to do about your patents, trademarks, utility models, industrial designs, etc., in Russia.

'Forum Selection Clauses May Bar an IPR'

IPWatchdog | March 10, 2022

David McCombs, Eugene Goryunov, Jonathan Bowser, Matthew Beck

In light of recent Federal Circuit case law, parties involved in licensing, settlement, or confidential business discussions involving patents should carefully consider the impact a forum selection clause may have on the ability to seek an IPR.

'After West Texas Ruling, Patenting AI Could Be More Nuanced'

Law360 | February 25, 2022

Eugene Goryunov, David McCombs, Dina Blikhshteyn

In a first case of its kind, *Health Discovery Corp. v. Intel Corp.* on Dec. 27, the U.S. District Court for the Western District of Texas found claims of machine-learning patents invalid under Title 35 of the U.S. Code, Section 101, in a motion to dismiss filed under Federal Rule of Civil Procedure 12(b)(6).

Lego My Jacket! Fashion Designer Sues Toy Maker Over Mini-Fig Jacket Resembling Artist's Design

Haynes Boone News | February 22, 2022

Annie Allison

Danish toy maker LEGO received a rather harsh critique from New York-based fashion designer James Concannon, who is suing the world's largest toy company over its wardrobe selection for one of the plastic characters in the "Fab 5 Loft" LEGO set which is based on Netflix's *Queer Eye* series.

New IP Partners

Dina Blikshteyn

New York | Intellectual Property Practice Group



Dina's practice focuses on post-grant proceedings before the U.S. Patent and Trademark Office, preparing and prosecuting domestic and international patent applications, as well as handling trademark and other IP disciplines. Dina is also a co-chair of the Artificial Intelligence practice at Haynes Boone.

Dina focuses her patent practice on technology areas such as artificial intelligence and machine learning, cloud computing, cyber security, web applications, map and navigation applications, point-of-sale systems, data structures, algorithms, distributed systems, client-server applications, CPU/GPU processor design, operating systems, mobile technologies, databases, multimedia and video streaming, financial/banking software, healthcare systems, Internet, advertising software, wireless communications, telecommunications systems, marketing applications, industrial control systems (ICS), cable systems, and smart grid and micro grid technologies.

Tiffany Cooke

Dallas | Intellectual Property Practice Group



Tiffany's practice focuses on representing clients in commercial and intellectual property litigation in state and federal court. Tiffany's litigation experience includes representing plaintiffs and defendants in contract, trade secret, patent, copyright, trademark infringement, and complex commercial litigation.

Tiffany also has diverse technical experience that includes working on patent infringement actions involving semiconductors, medical device, pharmaceuticals, smartphone technology, web-based interactive advertising, optical sensors, vehicle surveillance systems, database technology, Radio Frequency Identification, electronic printing and document technology, and blood cholesterol testing devices.

Joseph Lawlor

New York | Intellectual Property Practice Group



Joe is a trusted advertising and IP lawyer with a practice that covers all aspects of marketing and branding, including disputes, transactions, and compliance. Joe litigates high-stakes advertising, trademark, and media disputes in federal court, the National Advertising Division (NAD), and the Trademark Trial and Appeal Board (TTAB). He also counsels clients on advertising claims and substantiation, marketing and sponsorship agreements, IP licenses, social media, endorsements, and influencers. His clients include well-known brands in consumer goods, telecommunications, higher education, media, pharmaceuticals, professional sports, and fintech.

New IP Partners

Charlene Liu, Ph.D.

San Francisco, Palo Alto | Intellectual Property Practice Group



Dr. Jiaping (Charlene) Liu is an intellectual property lawyer with an extensive knowledge of patents and a focus on patent prosecution and assertion matters. Charlene counsels clients and is a trusted advisor on portfolio development and management in various technological fields, in particular focusing on software, AI and deep learning, semiconductors, integrated circuits, financial service, and network security. Charlene also frequently counsels clients on assertions and licensing disputes, such as in the realm of standard essential patents (SEPs) and wireless technology.

Before her legal career, she obtained her Ph.D. in electrical engineering from Princeton University and was a Gordon Wu fellowship recipient. Her doctoral work focused on stochastic modeling of data networks, and she worked on wireless transmission protocols for ad hoc networks at Bell Labs during graduate school.

Michael McArthur

Dallas | Intellectual Property Practice Group



Mike focuses on all aspects of trademark law, including brand management, clearance and prosecution, and global enforcement. In particular, Mike regularly investigates, analyzes, and opines on the availability of potential marks, drafts and prosecutes trademark applications through to registration, addresses intellectual property violations across social media, negotiates settlement and coexistence agreements, and manages Uniform Domain Name Dispute Resolution Policy (UDRP) proceedings, and trademark opposition and cancellation proceedings. Additionally, he has experience representing both rights holders and purported infringers in numerous cases involving seized or detained shipments by U.S. Customs and Border Protection.

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 that are engaged in economic development, public policy, education, arts and culture, and racial equity. We provide substantial monetary donations and services to myriad organization through our community engagements. Further, Haynes Boone boasts a strong legacy of pro bono work, and this past year was no exception. The firm provided 9500 pro bono hours to clients valued at over \$6.6 million.

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

- Haynes Boone is deeply committed to helping the National Portrait Gallery fulfill its mission to tell the story of America by portraying the people who shape the nation's history, development and culture. This year we sponsored the *Hung Liu: Portraits of Promised Lands Virtual Exhibit*, which was the first to feature an Asian woman artist. Liu's work combined photography and portraiture to highlight the stories of people often overlooked or marginalized by society.

The firm is currently sponsoring *Kinship*, which features the work of eight contemporary artists who illuminate the complexities of our closest interpersonal relationships through portraiture.
- The firm is a sponsor of the *Notorious RBG: The Life and Times of Ruth Bader Ginsburg* exhibit at the Holocaust Museum Houston, which explores the American judicial system through one of its sharpest legal minds, the late Ruth Bader Ginsburg.
- The firm joined the Dallas Association of Young Lawyers (DAYL) in the 2022 Freedom Run. The annual event honors the sacrifices of police officers and first responders by raising money for Dallas's Assist the Officer Foundation (ATO).
- Haynes Boone once again participated in the Salvation Army Angel Tree program across several offices where firm employees purchased gifts for kids in need.
- The firm donated laptops to the University of North Texas First-Generation Success Center and Food Pantry last week. The center and university serve as a Hispanic-Serving Institution.
- In a labor of love and show of respect for veterans, Haynes Boone Associate Emily Buchanan routinely visits the Veterans Administration Medical Center in Dallas to meet with veterans who are in hospice care. She uses her legal know-how to create wills and estate documents at no cost to the vets.
- Haynes Boone's Military, Veterans, and Partners (MVP) Network was proud to be one of the sponsors of 9/11 Day, a federally recognized day of service that took place in 11 cities across the country.
- The San Antonio office worked in the warehouse at the San Antonio Food Bank to prepare 1053 boxes of food for local families.
- The London Women Counsel and Associates in Energy and Shipping organized a clothing drive to support Smart Works, an organization that helps unemployed women secure jobs by improving their interview skills and providing them with professional clothes to boost their confidence.
- The firm supports Communities in Schools and similar organizations across the nation by frequently collecting and delivering much-needed school supplies, equipment, and paper products for elementary and other schools.

Awards and Recognitions

LEGAL 500 2022 LEGAL DIRECTORY

The Legal 500 ranked Haynes Boone among the Top 12 firms in the country and listed five partners as key lawyers for Trademarks: Non-Contentious (including Prosecution, Portfolio Management and Licensing).

The firm's Healthcare Practice also ranked among the nation's best in the 2022 Legal 500 U.S. directory which highlighted three attorneys as key lawyers: Benjamin Pelletier, Randy Peak, and Michael Smith.

CHAMBERS USA – TEXAS TECHNOLOGY: CORPORATE & COMMERCIAL

Haynes Boone ranked among the Top 8 firms in Texas in Technology: Corporate & Commercial. Chambers noted that the firm "is well placed to advise on an array of technology sector matters, ranging from software and IP licensing and development to strategic partnerships and joint ventures, with substantial strength in data privacy and cybersecurity," adding that "the firm brings to bear a team of technologically adept lawyers who are based in its Dallas office."

CHAMBERS USA – CALIFORNIA PATENT PROSECUTION

Haynes Boone's Patent Prosecution team was ranked Band 3 and complimented as a "respected group" with "notable experience." The guide cited the team's skill in patent portfolio management, prosecution, IPRs and related transactions. Chambers highlighted the firm's "enviable client base," which includes a number of household names within the tech sector.

CHAMBERS USA – TEXAS INTELLECTUAL PROPERTY PRACTICE

The firm's Intellectual Property Practice Group, (Band 2, Texas), was described as "excellent" by Chambers. The guide praised its lawyers, saying they offered "extensive" knowledge in areas such as patent prosecution, post-grant reviews and inter partes review proceedings.

CHAMBERS USA – TEXAS TRADEMARK

Haynes Boone was one of only two law firms to receive a rating in Texas for Intellectual Property: Trademark, Copyright & Trade Secrets. Chambers lauded the firm's "excellent" IP department, including its "comprehensive support" to clients on trademark and copyright work for both plaintiffs and defendants.

CHAMBERS GLOBAL

Six Haynes Boone lawyers are ranked in the 2022 edition of the Chambers Global directory of the leading providers of legal services in the international marketplace.

PATEXIA INC.'S PATENT PROSECUTION INTELLIGENCE REPORT

Haynes Boone and three of its lawyers are included in Patexia Inc.'s April 2022 Patent Prosecution Intelligence Report. Among the highlights, Haynes Boone ranks fifth among the Top 100 Best Performing Law Firms.

PATEXIA INC.'S IPR INTELLIGENCE REPORT

Haynes Boone and 10 of its lawyers are included in the 2022 edition of Patexia Inc.'s IPR Intelligence Report on the nation's leaders in inter partes review (IPR) proceedings before the Patent Trial and Appeal Board (PTAB).

Among the report's highlights are a number of improved standings: Haynes Boone ranked as the 4th most active firm representing petitioners; 8th most active firm overall (representing petitioners or patent owners); and the 9th best performing firm representing petitioners.

Awards and Recognitions

PATEXIA INC.'S CAFC INTELLIGENCE REPORT

Haynes Boone and seven of its lawyers are recognized in Patexia's 2022 ranking of the nation's top firms and lawyers appearing before the U.S. Court of Appeals for the Federal Circuit (CAFC), an important venue for patent litigation.

MANAGING IP – IP STARS

Managing IP has again recognized Haynes Boone's Trademark Practice as one of the nation's best in its 2022 IP STARS directory of the leading IP firms worldwide, continuing the ranking for the last several years.

MANAGING IP – PTAB LITIGATION

Managing Intellectual Property ranked Haynes Boone Tier 1 nationwide in PTAB Litigation law firm in 2022. Haynes Boone is one of only six firms in the top tier for PTAB Litigation.

INTELLECTUAL ASSET MANAGEMENT (IAM) PATENT 1000

Haynes Boone and 15 of its partners from California, Colorado, Illinois, Texas and Washington, D.C., were recognized in the 2022 edition of the Intellectual Asset Management (IAM) Patent 1000 legal directory.

The publication recognized Haynes Boone among the top firms in the nation in various practice categories and among the leading firms in California, Illinois, and Texas. "Haynes Boone has filed more than 19,000 patent applications in the United States and abroad in the past five or so years and has honed its preparation and prosecution skills to a fine point while also cultivating exceptional strategic patent protection [experience]," IAM researchers said.

PATENT LAWYER MAGAZINE

The Patent Lawyer magazine ranked Haynes Boone among the Top 10 Patent Firms in the "North America – South" region in 2022.

The magazine conducts extensive research throughout the year to select leading intellectual property (IP) and patent firms in jurisdictions worldwide. Selection criteria include client testimonials, market reputation, and cited achievements over the past year, among other factors.

WORLD TRADEMARK REVIEW 1000

Haynes Boone has been honored as one of the nation's Top 12, "Gold-Tiered" trademark firms in the 2022 edition of the World Trademark Review 1000 directory. Additionally, the firm was ranked as one of two Gold-tiered firms in Texas and as a Top 20 trademark firm in New York.

BEST LAWYERS IN AMERICA

Haynes Boone had another impressive showing in The Best Lawyers in America directory published by Woodward/White, Inc., with a cross section of lawyers from offices across the country recognized in the 2023 edition. Ten Haynes Boone lawyers were recognized as "Lawyer of the Year" in their practice areas, while hundreds more were designated "Best Lawyers" and "Ones to Watch."

BEST LAW FIRMS

In the U.S. News & World Report and Best Lawyers "Best Law Firms" 2023 directory, Haynes Boone is ranked nationally (Tier 1-3) in 33 practice areas and regionally in about 100 practice areas.

LEXOLOGY CLIENT CHOICE AWARDS

Six Haynes Boone partners are recognized as leaders in their practice areas in the 2022 Lexology Client Choice Awards.

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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