



IPLAC Newsletter – Summer 2019

President’s letter to you

Dear IPLAC Members, and other readers,

As our new IPLAC year moves along, please consider: why should you join or stay with IPLAC? We have many good reasons.



As you’ll see in “banner ads” running across the IPLAC website, one of which is included here, IPLAC includes these among many benefits: (1) unique open admission, (2) one-of-a-kind local networking, (3) social and CLE events without equal, (4) incomparable local opportunities to serve and lead our IP bar, and (5) dues as little as half other bar groups. [President’s letter continued on a later page, see below]

Unique open admission + one-of-a-kind local networking + social and CLE events without equal + incomparable local opportunities to serve and lead our IP bar + dues as little as half other bar groups

= IPLAC

IPLAC Congratulates Chief Judge Pallmeyer

Speaking of “banner ads” on our website, and then also our active LinkedIn and FaceBook posts, IPLAC is pleased to congratulate Judge Rebecca Pallmeyer upon her becoming Chief Judge of the Northern District of Illinois. Here is our website’s banner ad of congratulations.

IPLAC congratulates Judge Rebecca Pallmeyer on becoming the Chief Judge of the United States District Court for the Northern District of Illinois.

We applaud the Chief Judge for her energy, commitment, humility, and passion on the bench, to our IP cases, and in her new responsibilities.

To see the Chief Judge in a wonderful interview on WTTW Chicago Tonight, please search "Judge Pallmeyer breaks glass ceiling."

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International Relations Committee of IPLAC to foster cooperation with international IP bars

IPLAC is pleased to announce the formation of a new International Relations Committee of IPLAC, to foster cooperation with IP bars in international jurisdictions. With the success of the recent IPLAC Delegation to Tokyo, Japan (Japanese Patent Attorneys Association (JPAA)) and an upcoming opportunity in China, we are soliciting, are you interested in participating in the committee? Please let us know.

Click here [<https://iplac.memberclicks.net/assets/docs/Proposal.pdf>] to kindly find the final proposal and information about the Comparative IP Mock trial in China. We have an opportunity to co-sponsor such mock trial with China National Intellectual Property Administration (CNIPA) this October or November.

Please contact the co-chairs of the committee – **Patrick Burns** [pburns@gbc.law], **Tron Fu** [tfu@step toe.com], and **Arthur Yuan** [ayuan@loeb.com] – with any questions.

Future Events

August 29, 6 p.m. to 9 p.m. Young Members' Committee presents A Night You Cannes Not Miss: Rooftop Rose Tasting (at Groupon's Rooftop)

September 12 8:30 am to 5:30 p.m. Women in IP present MIP International Women's Leadership Forum (at Westin River North)

Symposium and Judges Dinner

October 17! Everyone, please note the Symposium and Judges' Dinner is on a Thursday, October 17 this year!

We have fantastic agendas planned again for both events. More details to follow soon.

Past Events

May 9, 2019 – Chicago

IPLAC Litigation – Mandamus Practice Before the Federal Circuit

William Burgess, a distinguished Appellate Attorney from Kirkland & Ellis' D.C. office, led a distinguished panel which analyzed how to prepare a successful Writ of Mandamus.

May 16, 2019 – Chicago

IPLAC and The Linn Inn

The Honorable Judge Richard Linn presided over this Mock Trial on the issue of trade secrets, with practicing attorneys representing the plaintiff and defendant. The jurors consisted of

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generous law student volunteers. After brief arguments from both parties, the audience had an opportunity to witness the live jury deliberation and engage in subsequent discussion including comments by jury consultants, Jury Scope, Inc. A reception immediately followed.

The Program Chairs were **John Augustyn** (Leydig, Voit & Mayer, Ltd.) and **David De Bruin** (Honigman LLP). Sponsors included IPLAC, Leydig, Voit & Mayer, Ltd., and Honigman LLP.

May 23, 2019 – Chicago

Tequila Summer-ise

We celebrated the end of the school year and the start of summer by kicking Memorial Day weekend off right with complimentary tequila tasting featuring Código 1530 tequila. A cash bar was available for those not wishing to participate in the tasting or for those who prefer their tequila in a cocktail. This event was held at Madison Tavern, 500 W. Madison, Chicago.

July – Chicago

IPLAC Professional Development Book Club

This new IPLAC group led by **IPLAC vice President Erin Lothson** reports: "What a fabulous evening for our inaugural Professional Development book club discussion. On tap at the City Winery at the Riverwalk was a lively discussion on David Walton's "Get Smart About Emotion, A Practical Guide to Emotional Intelligence." #iplac #professionalwomen #professionaldevelopment #IP See the equally upbeat group selfie nearby!



June 18, 2019 – Washington D.C. (live) and Webcast

Hot Topics at the U.S. Trademark Office and the Trademark Trial and Appeal Board

A webcast was sponsored by the Trademark Committee of the D.C. Bar Intellectual Property Law Community and we, IPLAC, and the IP Law Section of the California Lawyers Association, International Trademark Association (INTA), The Pauline Newman IP American Inn of Court, and Virginia State Bar, Intellectual Property Section, all co-sponsored.

The program covered an overview of statistics of work flow and recent developments at the USPTO Trademark Office and Trademark Trial & Appeal Board (TTAB).

July 11 – Chicago

Chicago Trademark Breakfast

Along with AIPLA, and Banner & Witcoff, we co-sponsored a Chicago Trademark Breakfast with the USPTO. This report is from our co-host: "We had a great turnout for the Chicago Trademark Breakfast that we hosted yesterday



with the American Intellectual Property Law Association (AIPLA) and the Intellectual Property Association of Chicago (IPLAC). Thank you to our speakers, **Dan Vavonese** of the USPTO and TTAB Judge **Linda Kuczma**, for sharing updates and practice tips."



**June 27, 2019 – Woodridge
IPLAC Field Day**

This year's IPLAC Field Day was a tremendous success! With over 110 total participants, the IPLAC members were out in force and couldn't have asked for a more beautiful day. The Field Day Committee chaired by **Brian Verbus** and **Evan Kline-Wedeen** hosted our Field Day this year at Seven Bridges Golf Club in Woodridge on scenic "Mulligan" Drive. Throughout the day, our members participated in lunch, golf, dinner, a reception, and (at least a few) drinks. There were prizes to be had by all. Most importantly, the event featured new low pricing of only \$175 for members that signed up early!

Many of the groups even got to challenge the past-president, Adam Kelly, in a rousing game of "Beat the President" to raise money for charity. Out of 17 groups, only 5 managed to beat him. Adam was a good sport about "losing" though, because we managed to raise over \$1,400 for the IPLAC Foundation!

This year, we also debuted our new golf-alternative: the "Field Games." For our less golf-inclined members, we had a variety of yard games set up around the clubhouse so everyone could join in the fun. Some members came for golf, others for the "Field Games," and still more just to join in the dinner reception. IPLAC would like to extend a massive thank you to all of our sponsors this year for their support. We could never have hosted such an incredible event without generous donations from Kirkland & Ellis LLP, Fitch, Even, Tabin & Flannery LLP, Greer Burns & Crain Ltd., Banner & Witcoff, Ltd., Loeb & Loeb LLP, Marshall, Gerstein & Borun LLP, Cook Alex Ltd., Adam Kelly, Charles Shifley, Ted Mahan, and Legal Advantage.

We hope to see you all again next year! We don't know who this is in the image nearby, but he was there, we loved his golf swing!

**July 18, 2019 – Chicago
IPLAC Corporate & Biotechnology Committees – Freedom to Operate Searches and
Summer Networking**

A panel discussion on Freedom to Operate Searches began at 5:30 p.m., and IPLAC Summer Networking began at 6:30 p.m. on Porter's outdoor patio.

Panelists included **Dimitry Kapmar**, Zebra Technologies, **Saumil Mehta**, Gogo LLC, **Pete Slawniak**, Argonne National Lab, and **Adam Wolek**, Taft Stettinius & Hollister LLP.

The event took place at Porter Kitchen + Deck, 150 N Riverside, Chicago.
This event was sponsored by Taft Stettinius & Hollister LLP.

July 22, 2019 – Chicago

IPLAC Biotech – Building a Strong Patent Portfolio for Nucleic Acid-Based Inventions

This event provided an overview of the road from the bench to the marketplace for Nucleic Acid-Based Inventions. We had a lively discussion about building a patent portfolio including maximizing Patent Term Adjustment and Patent Term Extension. Our exceptional panel of speakers included: **Dr. David Giljohann**, Chief Executive Officer of Exicure; **James Velema**, Partner at Lathrop Gage LLP; and **Dr. Laura Labeots**, Partner at Lathrop Gage LLP.

Notification of the Passing of IPLAC Past President Paul Flattery



Dear members, please note the passing earlier this year of IPLAC Past President 1987 **Paul Flattery**. A photograph provided by his family is included. Paul graduated from Notre Dame with a degree in Electrical Engineering, served in the U.S. Marine Corps, and then went on to Georgetown University. He started his law career with Fish and Neave in New York City and ultimately led Baxter Healthcare as Chief Patent Counsel.

Paul is survived by at least his wife Dorothy and sons including son, Paul. We have let the family know how sorry we are for the family's loss, and how proud we are that we had Paul as our President. We all can see online his name on many important court cases, patents, and as to many patent licensing activities. By his education, military service, start at Fish & Neave, and rise at Baxter even those of us who did not know Paul can know that he had a distinguished lifelong career of service and accomplishment.

To the extent IPLAC can speak appropriately for the whole of the United States patent system, we thanked the family for his many actions that brought progress to patent law, its practice, and its other actors. We also thanked them for the time and dedication of their beloved to IPLAC. It was certainly a labor of dedication to our Chicago bar, with a lasting gift to us. We are sure his greatest legacies, though, are a loving marriage of 60 years, his children, and his grandchildren.

An obituary is here: <https://www.toalebrothers.com/obituaries/Paul-Flattery-2/#!/Obituary> You may contact Paul's wife Dorothy here: Dorothy Flattery, 7211 Marston Court, University Park, FL 34201 and the whole of the family here through son Paul: Paul Flattery, 22106 Oakcreek Hollow Lane, Katy, TX 77450, Telephone 281-398-5975, flattepc@bp.com

IPLAC also remembers

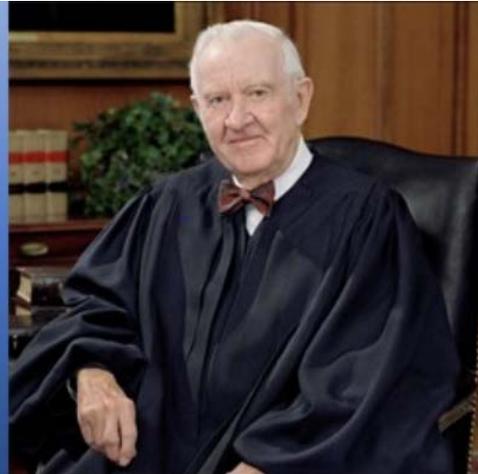
IPLAC also remembers the life and contributions to IP of **Justice John Paul Stevens**.

IPLAC remembers the life and contributions to IP of Justice John Paul Stevens.

Author of *Sony v. Universal City Studios* and *Pfaff v. Wells*, and of other opinions of great benefit to the law.

Believer in balance between creators' rights and the rights of the public and other actors.

Born in Hyde Park in Chicago, graduate of the University of Chicago and Northwestern Law, founder of a Chicago law firm, judge of the Seventh Circuit, life long Chicago baseball fan, Chicago always his home.



Committees! Join in! Lead!

IPLAC acts through its committees, and all the committees welcome new members. Join in! And don't be afraid to lead! We have leadership needs with a few committees, and welcome you to leadership! See the IPLAC website for the list of committees! Volunteer to lead ADR, AIA Trials, and Newsletter, this newsletter!



IPLAC Someone You Should Know

From time to time, we intend to bring you "Someone You Should Know," a person who is in IPLAC and is a leader of our bar. For our first person you should know, you should know **Edward Manzo**. Ed is an IPLAC member of 40 years of membership. IPLAC President in 2010, he was also Membership Committee Chairman, Amicus Committee Chairman, Claim Construction Chairman, Vice President, President Elect, and is now an honored Past President.

Most impressively in terms of activities with IPLAC, Edward has edited our book "Claim Construction at the Federal Circuit" annually, for many years, since he created it. If you know it, you may say you "love this book!" as an unprompted lawyer exclaimed recently. If you don't know it, you should. It has been cited by the United States Supreme Court. A dozen district court decisions have also cited it in published opinions. For Ed, it has been a labor of love, dedication to the profession.

Edward has been an IP lawyer since 1975. He filed the first appeal ever to the Federal Circuit. Read here: Manzo, "The Untold Story of the First Appeal to the Federal Circuit," *Federal Circuit Bar Journal*, vol. 25, pp. 1-14 (2015). Ed's article "The Impact of The America Invents Act on Trade Secrets," 13 *J. Marshall Rev. Intell. Prop. L.* (2014) was chosen as one of the best articles on IP law in 2014 and republished in a 2015 compendium of such best articles on IP law.

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Edward's science degree is in Physics. Read more of his resume here.

<https://www.huschblackwell.com/professionals/edward-manzo>

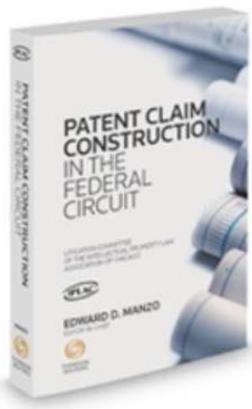
But he is a Renaissance man, too. He leads many IPLAC meetings a capella when we sing, and we sing the National Anthem. No easy task, leading, due to our song. Edward reaches toward the perfect. He is still more musical, too, enjoying the guitar, among other instruments.

Asked to say something about himself, Ed said: "I have greatly enjoyed practicing IP law in Chicago since 1979 and associating with so many wonderful colleagues in IPLAC. I am happy that the Association is going forward in good hands. I marvel at how it gets better each year, as each president and board bring something new. Personally, I am easing back a little from my professional life to make room for other things."

And then Edward cemented his Renaissance nature in place: "For instance, out of purely personal interest, I studied theology on a part-time basis at Trinity Evangelical Divinity School (Deerfield, IL) and received an MA-Theological Studies last December. Along the way, I took a course on Christian Ethics, enjoyed it, and dove deeper into the ethics field. I am now finishing an MA in Bioethics. I want to do some teaching and writing on ethics. As biotechnology develops, the bioethical issues are becoming more acute. Beyond bioethics, there are other ethical issues in our society to address. Besides academic interests, I have finally resumed classical guitar studies and am enjoying the beauty of the repertoire." "

Edward Manzo. Life long IP lawyer. IPLAC President. Active IPLAC member for 40 years. Person passionate about the founding goals of IPLAC, "to add to the dignity and reputation of this branch of the legal profession; be instrumental in promoting member interests, engage them in professional and social relations, aid reforms in the administration of the PTO, and assist in making our laws and practice more definite, uniform, convenient, and wise."

You should know Edward Manzo. Join in IPLAC. When you see someone you should know, please introduce yourself.



Patent Claim Construction in the Federal Circuit, 2019 ed

Now available!

IPLAC's 2019 edition book on claim construction is now available at Thomsom Reuters. Cited by the Supreme Court and in 12 district courts.

Or join IPLAC and receive your complimentary copy!

[President's letter, continued from page one]

How do we know? We've done the research. Here's the case we make.

(1) unique open admission

Our membership is significantly Chicago-local, and all-IP. There are other IP bar groups or IP group-within-groups you can join in or from Chicago, but among them, IPLAC is uniquely Chicago-local, all-IP, and open admission. There are no limits to our membership such that you must wait because of something such as a group size limit, and no qualifications that are directed to measures of your success, longevity in IP, or race, sex, or anything of the kind. You are welcome—you are asked, you are invited—to join us and stay with us all of your career, with your interest in IP. See information here.

(2) one-of-a-kind local networking

Our membership openness results in one-of-a-kind local networking. You can't find us, in our openness and focus, anywhere else. We're here, not there.

(3) social and CLE events without equal

Asked of you before, did you know? Did you go? We had 45 great and even amazing events for members in the program year just concluded. We know of no bar group that has come close to our number and quality of social and CLE events in the Chicago area in past years.

The value IPLAC brings to its membership is remarkable, and especially true for this program year we are just concluding. We stand head and shoulders above other groups in value. We have had the bountiful opportunities of scads of local IPLAC social and IP CLE events for the whole of our IP community—most events having aspects of both the social and CLE, with events throughout the year. We have had one of our best-ever groups of annual meetings, judges' dinners, symposiums, field days, and their associated luminary speakers, officials, guests, awards, wisdom, insights, fun, activity, and professional development for all of us who are IPLAC-aware. For example, to see one of our past events, go here and see USPTO Director Iancu in Chicago with IPLAC.

For the coming year, watch for new event announcements at this website and in your inbox, and make plans to be on IPLAC committees, and in IPLAC events, early and often!

(4) incomparable local opportunities to serve and lead our IP bar

IPLAC changes leadership every year! Our presidential officers advance such that we have a new president, new president-elect, new vice president, and new past president every year. We are diverse, and open to your leadership, through rapid rise to president, and we change half our board members every year too. Join us in officer and board leadership, or in committee leadership. Committees—we have 30 or so committees for you to engage with, and lead.

(5) Dues as little as half other bar groups

This one is big, by dues being small. We have compared our dues to those of many other bar associations, and find our dues to be as little as half other bar groups. At 2+ years of practice, you reach our maximum annual dues, and they stay the same thereafter throughout your career.

Conclusion

So we urge you, consider the benefits, and ratchet up your involvement in IPLAC! Enjoy IPLAC benefits; make your membership count for you.

And contact your new officers and board with your ideas for IPLAC. See the website pages that give contact information. And you can e-mail me at cshifley@bannerwitcoff.com, or call me at 312.463.5441, my direct line.

Yours, Charles Shifley, Your 2019-20 President

**IPLAC AMICUS COMMITTEE
CONTINUES ITS HIGH LEVEL
OF ACTIVITY**

The Amicus Committee is continuing its past high level of activity in speaking for all of us IPLAC members in amicus briefs on vital IP issues. Most recently, the committee prepared and filed our amicus brief, in late July, in the Supreme Court *Peter v. NantKwest* case. The PTO argues that applicants must pay the PTO’s attorneys’ fees when an unsuccessful patent applicant sues the Director of the PTO in district court under 35 U.S.C. § 145. Our amicus brief takes the position that an *en banc* Federal Circuit decision to the contrary should be affirmed. **Bob Resis** is our very active committee chair, **Peg Duncan** our vice-chair. Peg and **David Mlaver** were our principal authors of our brief, and **Don Rupert** provided invaluable comments in the brief preparation. A big thank you to all our contributors! Because of this committee, its leaders, and its large active membership, IPLAC members have a voice in the courts!

Join an IPLAC committee like Amicus! And make a difference!

No. 18-801

In the Supreme Court of the United States

LAURA PETER, DEPUTY DIRECTOR,
UNITED STATES PATENT AND TRADEMARK OFFICE,
PETITIONER,
v.
NANTKWEST, INC.,
RESPONDENT.

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT EN BANC

BRIEF OF THE INTELLECTUAL PROPERTY LAW
ASSOCIATION OF CHICAGO AS AMICUS CURIAE
IN SUPPORT OF RESPONDENT NANTKWEST,
INC.

MARGARET M. DUNCAN <i>Counsel of Record</i> MCDERMOTT WILL & EMERY LLP 444 W. Lake Street Suite 4000 Chicago, IL 60606 (312) 372-2000	<i>Of Counsel:</i> CHARLES W. SHIFLEY PRESIDENT THE INTELLECTUAL PROPERTY LAW ASSOCIATION OF CHICAGO P.O. BOX 472 CHICAGO, IL 60690
<i>Of Counsel:</i> DAVID MLAYER MCDERMOTT WILL & EMERY LLP 500 North Capitol St. NW Washington, DC 20001 (202) 756-8000	ROBERT RESIS BANNER & WITCOFF, LTD. 71 S. Wacker Dr., Suite 3600 Chicago, IL 60606 (312) 463-5000

Counsel for Amicus Curiae
The Intellectual Property Law Association of Chicago
July 22, 2019



Have Something to Tell IPLAC? Let Us Know!

The IPLAC Board meets once each month at least. If something needs our attention, please let us know! See the website for contact information for any of the board members and officers. Here we are at our last meeting! Charles in sunglasses had a temporary eye condition, but the smiles are long term, on behalf of IPLAC!

We also welcome submissions of material for its e-newsletter. Please forward information to **Ela Baio** [ebaio@nixonpeabody.com] of Nixon Peabody, LLP.

Join IPLAC!

Consider the value equation!

Unique open admission, one-of-a-kind local networking, social and CLE events without equal, incomparable local opportunities to serve and lead our IP bar, and the dues are as little as half other bar groups!