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**Organization Newsletter**

May-June 2018

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President's Letter

Dear IPLAC Members,

I am sincerely honored to serve as your 134th President.

To begin, please join me in recognizing **Paul Kitch** (Immediate Past President), **Serena Pruitt** (outgoing Immediate Past President), the officers, board, and committee leaders who led so many successful events, ranging from Field Day to the Judges Dinner to our fantastic committee-led CLE and social events. These invaluable efforts have set us apart from other bar associations.

At the annual member meeting at the University Club, I discussed our rich history and noted how we have evolved from primarily a patent law organization into now a national intellectual property bar association—one whose talented members assist clients to drive commerce by leveraging and protecting brands and innovation in our present age of digital disruption. Today, our modern practice is impacted by significant technological advances, generational shifts involving Generation X and the Millennials, and grass roots movements created by social media. Plus, we are practicing during a time when the U.S. Supreme Court is deciding more intellectual property cases than at any other period in its history. We are fortunate to be practicing in such exciting times.

Against that background, I shared a bold vision for how we will continue evolving this organization in our modern practice. To transform that vision into reality, we must:

- Institute more diversity and inclusion initiatives;
- Establish a formal mentorship program;
- Expand our understanding of "intellectual property" to include advanced and social media, advertising, Blockchain, data protection, outsourcing, privacy, and Top Level Domain (TLD);
- Promote positive wellness; and
- Continue our ground-breaking committee programming and networking events.

But none of these directives will materialize, unless we utilize the most valuable asset of our organization—*your time*. **Therefore, please pledge ten hours of your time over the next year:**

- Be a mentor;
- Serve on a panel;
- Attend our CLE events; or
- Actively serve on a committee.

For younger practitioners, devoting time to IPLAC will enable you to build your professional network, gain education on many ethical and legal topics, and invest in your career. Likewise, experienced practitioners will be able to share career experiences, mentor younger practitioners, and meaningfully contribute to our intellectual property community. Simply put, everyone will benefit from devoting their time to IPLAC.

In closing, I sincerely look forward to leading our continued evolution in 2018-2019.

Warmest wishes,

Adam Kelly



The annual IPLAC Committee Chair meeting was held on June 26 at Loeb & Loeb. The Chairs brainstormed ideas for the 2018-2019 programming year and planned an exciting series of educational and social events.



Paul Kitch (Past President), Bob Resis (Amicus), Ken Adamo (Litigation), Van Economou (Creator of the Year), Joe Nabor (History), Abby Lenz (Paralegal), Cindi Schermerhorn (Paralegal), Alisa Simmons (Dinner & Symposium), Howard Levin (AIA Trials), Mary Schnurr (Corporate), Jeff Chelstrom (Patents-US), Atanu Das (Diversity and Inclusion), Adam Kelly (President), Maria Hudson (CLE), Dustan Barnes (Young Members), Paul Henkelman (Field Day), Anisha Mehta (Advertising and Internet), Rachel Gartner (Advertising & Internet), Adam Wolek (Biotechnology), Melaina Jobs (Trademarks), Libby O'Neil (Women in IP), RiKaleigh Johnson (Women in IP), Jim Munson (ADR), Pat Burns (Appointments), Casey Mangan (Symposium), Brian Barnes (Website)

Renew Your IPLAC Membership for 2018-2019

Dear IPLAC Members:

Spring is in the air, which means it is time to renew your IPLAC membership! We thank you and our other members for your continued contribution to the organization. You have kept IPLAC among the largest (and oldest!) IP bar associations in the country. IPLAC exists for its members, and we provide you with many benefits, such as the Judges Dinner on November 9th, other CLE and networking events, women's events, opportunities to serve on committees covering the entire spectrum of IP practice areas, and the opportunity to work on amicus briefs in some of the most important IP cases, along with many other activities.

IPLAC's membership year runs from May 1st to April 30th. Please renew your membership online through the IPLAC [website](http://www.iplac.org) at www.iplac.org.

If your law firm or company would like to pay for multiple renewals with a single check, please renew through the IPLAC website and select the "send check" option for payment and then have your law firm send a check to the below P.O. Box address. Alternately, you can send the attached [form](#) for each renewal along with payment to the same P.O. Box address:

The Intellectual Property Law Association of Chicago P.O. Box 472 Chicago, IL 60690-0472

If you have any questions about your fee category or how to renew, please reach out to either of the Membership Chairs. We would be happy to assist you.

When renewing your membership, please consider making a tax-deductible, voluntary contribution to the IPLAC Educational Foundation. Each year, the Foundation awards one-time college scholarships to at least two Chicago Public High School seniors who are planning to major in science, engineering or pre-law.

Finally, please take note that IPLAC uses email as its primary means to communicate with its members. Therefore, we very much appreciate you keeping your contact information current with us at all times - in particular when you obtain employment following law school graduation or change employers. When renewing, please consider providing a secondary email address to ensure our communications continue to reach you. We have found that some firm and company email filters block some IPLAC communications. Thus, we encourage you to provide a personal email address as well to ensure that you receive IPLAC communications.

Thank you for your continued membership. We look forward to working with you throughout the new membership year!

Sincerely,

Eric Maiers and Luke Curran
Membership Committee Chairs

IPLAC Adopts Resolution to Amend 35 U.S.C. § 101 on Patent Subject Matter Eligibility

The Intellectual Property Law Association of Chicago (IPLAC) has adopted a resolution to amend the statute directed to patent subject matter eligibility. In doing so, IPLAC joins the IPO, AIPLA, ABA and other bar associations across the country to propose revisions to 35 U.S.C. § 101.

Founded in 1884, IPLAC is the country's oldest bar association devoted exclusively to intellectual property matters. Located in Chicago, a principal forum for the nation's authors, artists, inventors, scholarly pursuits, arts, creativity, research and development, innovation, patenting, and patent litigation, IPLAC is a voluntary bar association of over 1,000 members with interests in the areas of patents, trademarks, copyrights, and trade secrets, and the legal issues they present. Its members include attorneys in private and corporate practice representing clients before federal courts throughout the United States, as well as the U.S. Patent and Trademark Office and the U.S. Copyright Office.

Having reviewed the USPTO July 2017 report "Patent Eligible Subject Matter: Report on Views and Recommendations from the Public" that summarizes public input to the USPTO October 17, 2016 Federal Register Notice, 81 Fed. Reg. 71485 seeking comments on revisions to 35 U.S.C. § 101, IPLAC believes that the revisions to subject matter eligibility that have been proposed by IPO and AIPLA represent the most straightforward and comprehensive revisions to Section 101. Based on these two similar proposals, IPLAC recommends a harmonized proposal by adopting language from each.

Between IPLAC, IPO, and AIPLA, these three organizations include over 25,000 members who are involved in the practice of intellectual property law and who represent a wide variety of industries and technologies in the U.S. and abroad. IPLAC's proposal seeks to combine the recommendations from IPO and AIPLA into a single proposal that

further the current dialog regarding possible Section 101 revisions that can address the ambiguity and uncertainty recent Supreme Court precedent has created.

IPLAC's resolution for amending 35 U.S.C. § 101 is as follows:

RESOLVED, the Intellectual Property Law Association of Chicago (IPLAC), supports, in principle, replacing in its entirety the current statutory language of 35 U.S.C. § 101 with language substantively consistent with the following:

101(a) Eligible Subject Matter: Whoever invents or discovers, and claims as an invention, any useful process, machine, manufacture, composition of matter, or any useful improvement thereto, shall be entitled to a patent for a claimed invention thereof, subject only to the exceptions, conditions, and requirements set forth in this Title.

101(b) Sole Exceptions to Subject Matter Eligibility: A claimed invention is ineligible under subsection (a) if and only if the claimed invention as a whole exists in nature independently of and prior to any human activity, or exists solely in the human mind. In determining eligibility, each claimed invention shall be considered as a whole.

101(c) Sole Eligibility Standard: The eligibility of a claimed invention under subsections (a) and (b) shall be determined without regard to (i) the requirements or conditions of sections 102, 103, and 112 of this Title, (ii) the manner in which the claimed invention was made or discovered, or (iii) the claimed invention's inventive concept.

A comparison of the resolutions of IPLAC, IPO, and AIPLA can be found [here](#) on the IPLAC website.

IPLAC's letter to the USPTO can be found [here](#).

WesternGeco v. Ion - Supreme Court Decision

The recent Supreme Court decision in *WesternGeco v. Ion* agreed with IPLAC's position in its amicus brief. IPLAC's amicus authors were **Don Rupert**, **David Applegate**, and **Jon Linzer**.

The Supreme Court held that a patent owner who proves infringement under 35 U.S.C. § 271(f)(2) can recover for lost foreign profits.

IPLAC Amicus Position was that lost profits should be recoverable for patent infringement found under 35 U.S.C. § 271 (f), irrespective of where those damages are determined to have arisen or occurred.

Future Events

July 14, 2018 - Chicago, IL

IPLAC Women in IP Committee and ChiWIP - The Blended Bubbly Brunch

The IPLAC Women in IP Committee is proud to partner with ChiWIP to bring together women in Chicago's IP and legal communities for a brunch-style dining and networking experience, with great food and vibrant discussions. Please join us on Saturday, July 14, 2018 for a laid back and exciting summer event on a beautiful rooftop overlooking the Chicago cityscape.

The event takes place at Bernie's Lunch & Supper, 660 N. Orleans St., Chicago, IL 60654 from 11 a.m. to 1 p.m.

Registration fees are \$50 per guest. The fee includes food and unlimited mimosa bar.

To register, click [here](#). Please RSVP no later than July 10, 2018.

August/September 2018

IPLAC Field Day

In view of the cancellation of the June 21, 2018 event due to inclement weather, this event will be rescheduled for August or September. Please stay tuned for details. Thank you for your understanding and patience.

September 26-28, 2018 - Chicago, IL

AIPF 2018 Annual Meeting

For many, it seems we live in an era where it feels everything feels different to what was the norm just a few years ago. The same applies in the realm of IP, whether one is seeking to develop and exploit IP or one is providing services in this sector. The 2018 AIPF Annual Meeting builds on the Association's long-standing practice of providing attendees with information and insights that will help attendees navigate an IP world where "everything feels different."

Speakers include:

- **Hon. Linda Kuczma**, US Patent & Trademark Office
- **Stefano Di Natale**, European Union IP Office
- **Kimberly Chotkowski**, LES
- **Chris Clancy**, Panduit
- **Isabelle Jomphe**, Goudreau Gage Dubuc
- **Jovan Jovanovic**, The Watson IP
- **Ben Klosowski**, Thrive IP
- **David Kramer**, Gemini Risk Partners
- **Erik Pelton**, Erik M. Pelton & Associates
- **Megan Redmond**, Erise IP
- **Diego Rocabado**, Cervieri Monsuarez & Asociados

Topics include:

- What's New @ TTABVUE?
- Global Patent Portfolio Management
- Lessons Learned From Malpractice Claims Against IP Firms
- Navigating Discovery in Patent Litigation
- Pro bono Offerings & Access to Justice in IP
- Take the Long View on Patents - A Roundtable Perspective on Navigating Patent Protection
- Management of Trademark Practice in Times of Technological Change

The event will take place at the Swissôtel, Chicago, Illinois.

Early Registration ends August 15th!

For more details or to register now, click [here](#).

For questions, please contact the [AIPF Executive Office](#).

November 9, 2018 - Chicago, IL

The 124th Annual Judges' Dinner and IP Symposium.

Federal Circuit Chief Judge Sharon Prost will be speaking at the Symposium and awarded a Distinguished Judicial Service Award at the Judges' Dinner.

Past Events

March 22, 2018 - Chicago, IL

The IPLAC Trademarks & Anti-Counterfeiting and Paralegal Committees - Brexit-Challenge or Opportunity? Navigating the Changing European IP Landscape

British Prime Minister Theresa May says "Brexit means Brexit", but what does it really mean for IP owners operating in Europe? This session provided practitioners with the information US businesses need to know in order to maintain an effective protection strategy.

This event took place from 12:00 p.m. - 1:15 p.m. at Madison Room, 10 S. Wacker Drive, Chicago, IL 60606.

April 10, 2018 - Chicago, IL

The IPLAC Diversity and Inclusion - We the People: How to Overcome Blindspots, Biases and Stereotypes

This highly interactive program started out by simulating the experience of being on the outside group looking in. Participants then engaged in a group discussion on why many Americans find it difficult to engage in subjects of

difference, particularly racial difference, and how that difficulty is reflected in the ongoing diversity and inclusion challenges in the workplace. Finally, through the use of large and small group activities, participants recognized how implicit biases and stereotypes affect how they perceive people who are different, practice how to speak with their peers about difference, and learn crucial skills to resolve conflicts that can arise when different perspectives are given equal space. By the end of the course, lawyers had: recognized the key roles diversity and inclusion play in today's workplace, implemented strategies to challenge biases and stereotypes, and cultivated conflict resolution skills to utilize in the workplace.

The event took place from 12:00 p.m. - 1:30 p.m. at the Chicago Kent Law School.

April 12, 2018 - Chicago, IL

IPLAC's Young Members Committee - Spring Mixer & Tequila Tasting

This happy hour and tequila tasting helped shake off the winter blues by catching up with fellow IPLAC members and learning about and sampling Código 1530 tequila. We were joined by Liz Feiner of Código 1530, who poured free samples. Drinks, including Código 1530 cocktails, were available from the cash bar. Although the event was hosted by IPLAC's Young Members Committee, our early vintage members were also very much welcome to attend.

April 18, 2018 - Chicago, IL

IPLAC ADR - Breaking a Mediation Impasse in IP Disputes

This event included a discussion how impasses occur in the mediation of IP disputes and techniques for breaking them.

The event took place from 5:30 p.m. - 7:00 p.m. at Kirkland & Ellis, 300 North LaSalle, Chicago, IL 60654.

April 19, 2018 - Chicago, IL

IPLAC & Chicago Intellectual Property Alliance - IP Speed Mentoring

IPLAC, in conjunction with the Chicago Intellectual Property Alliance, sponsored another opportunity for law students to meet IP attorneys from different practice areas in a relatively short period of time. Students had the opportunity to interact with and receive advice from at least ten attorneys during the speed mentoring portion in small groups. Students followed up with some of these attorneys during the general session and also meet other attorneys as well.

This event was held at Loyola University of Chicago School of Law, 25 E. Pearson St., 13th Floor.

April 23, 2018 - Chicago, IL

Joint Meeting Between IPLAC and the Linn Inn

Guest Speaker **Jerold Jacover** presented his thought-provoking presentation, Happiness and the Law.

The event was held at the Chicago-Kent College of Law.

The event was Jointly Sponsored - with many thanks - by McAndrews, Held & Malloy and IPLAC.

April 24, 2018 - Northfield, IL

Paralegal Committee - North Suburban Happy Hour Event

The Paralegal Committee was pleased to host a happy hour in the north suburbs. A fun evening of drinks and appetizers was had while networking with other IP practitioners. The event was sponsored by Neal & McDevitt, LLC.

The event took place at the Happ Inn in Northfield, IL.

April 27, 2018 - Chicago, IL

The John Marshall Law School - 9th Annual Conference, Ethics in the Practice of Intellectual Property Law

This in-depth program covered a variety of topics on ethics and professionalism that are relevant to lawyers practicing intellectual property law. Attendees learned about the types of ethical issues that arise in their daily practices, as well as fundamental principles, rules, and insights to help them handle these issues. Lunch was available at registration, and a reception followed the program.

May 1, 2018 - Chicago, IL

IPLAC Annual Meeting

The Annual Meeting of the Intellectual Property Law Association of Chicago took place on Tuesday, May 1, 2018 at The University Club of Chicago. The IPLAC 2018 Creator of the Year Award was presented during dinner to **Dale N. Gerding M.D.** More information about Dr. Gerding can be found [here](#). The IPLAC Educational Foundation presented the Scholarship Awards to deserving Chicago Public School high school seniors. The brief business portion of the meeting included the election of Officers and Board Members for 2018-2019. We were pleased to announce that the election of the following members as Officers and Board Members:

President-Elect: **Charles W. Shifley**
Vice President: **Clinton H. Hallman, Jr.**
Secretary: **Tiffany D. Gehrke**

Board of Managers:

Erin J. Fox
Anna L. King
Tanya Miari
Kevin E. Noonan

In accordance with the IPLAC By-laws, **Adam Kelly**, who served as President-Elect during this membership year automatically becomes President for the coming year. **Tamara Miller** will serve her second year as Treasurer. **Paul Kitch**, who served ably as President during this membership year, continues on the Board as Immediate Past President. **Erin Lothson** has completed the second year of her two-year term as Secretary, for which we extend our heartfelt appreciation. **Serena Pruitt** has also completed her service as Immediate Past President, for which we extend our gratefulness for her efforts and contributions.

Board of Manager Members **Jessica Bahr**, **Vangelis Economou**, **Ellen Gutiontov**, and **Joseph Janas** will complete the second year of their two-year terms. The following Board of Manager Members have completed their two-year terms of service, for which we extend our appreciation: **Elizabeth Cutri**, **Jomarie Fredericks**, **Katherine Nye** and **Peter Prommer**.

May 10, 2018 - Chicago, IL

Corporate Committee of IPLAC and Weickmann & Weickmann - European Patent Strategies

On May 10, IPLAC's Corporate Committee, together with the Weickmann & Weickmann firm, presented a panel discussion on European Patent Strategies held at SRAM LLC, a maker of bicycle components, at their West Loop offices.

The panel members included **Albert Keyack**, EPO Attaché to the USPTO, **Dr. Frank Feller**, partner at Weickmann & Weickmann, a German patent firm, and **Steven Sarussi**, partner at McDonnell Boehnen, Hulbert & Berghoff, LLP. The moderator was **George Jonas** of BP America, Inc.

This panel discussed strategies for obtaining European patents and overcoming common issues, including intermediate generalization, opposition strategies, and the state of the Unitary Patent.

The panel suggested beginning each application with a comprehensive search of the claimed invention. This will allow the applicant to include a comprehensive list of embodiments of the claimed invention.

The panel also discussed that each feature of the invention should be clearly claimed and also supported in the initial specification, noting that subject matter not in the specification may not be later drawn from the initial claims. Descriptions of the embodiments should be specific and each claimed feature should be listed as a functional feature, not merely as a preferred embodiment. It was also suggested that potential claim combinations, specifically those arising from multiple dependent structures, may be added to a US specification to support inclusion of those claims in EP prosecution.

If the Examiner is presented with a specific technical solution to a technical problem, the Examiner will more likely

be able to limit and/or eliminate prior art references during his or her search. The prosecution phase of the application is thus shortened, due to the elimination of the need to argue against extraneous prior art references that would otherwise be considered by the Examiner.

Finally, Mr. Keyack recommended that certain clients may benefit from discussing first-filed US patent applications with foreign counsel before filing in the US. Although this strategy will increase legal costs and likely involves moving back the filing date, certain clients may benefit from the expertise of a European Patent Attorney when it comes time to prosecute or litigate that case in the EP.

There was a networking event immediately following the CLE and a brief tour of the SRAM offices with beer and pizza kindly supplied by Weickmann and Weickmann. Fun was had by all!

May 22, 2018 - Chicago, IL

Litigation Committee - Nuances in Amending Patent Claims and Avoiding Tribal Immunity at the PTAB

The IPLAC Litigation Committee held its seminar concerning amending claims before the PTAB, tribal immunity, and how the PTAB will institute proceedings after SAS. Kirkland & Ellis graciously hosted an after-seminar reception.

June 6, 2018 - Chicago, IL

IPLAC Advertising & Internet Law Committee & the International Association of Privacy Professionals (IAPP) - The GDPR Journey for Multinationals, the Intersection of Intellectual Property and Privacy Rights, and What Lies Ahead



The EU GDPR grace period is over. How are multinationals reflecting on the journey to compliance and handling their operational obligations post-May 25th? How will ongoing compliance be managed and what are some of the Data Protection Enforcement (DPA) priorities? This panel will discuss important IP, privacy and GDPR considerations.

Speakers included **Irene Amu**, Data Protection Officer, Motorola Solutions Inc. (Moderator), **Jim Coffing**, Lead IP counsel, Motorola Solutions, Inc. (Panelist), **Jennifer Schack**, Sr. Vice President, Global Head of Privacy, Northern Trust Corporation (Panelist), and **Martin Whittaker**, Lead Senior Counsel, American Bar Association's Center for Professional Responsibility (Panelist).

This was a very successful GDPR event yesterday held at Motorola Solutions. There were over 100 attendees.

June 7, 2018 - Chicago, IL

IPLAC Women in IP Committee - A Progressive Dinner: Bringing Women in IP Together

The IPLAC Women in IP Committee was proud to present its Annual Progressive Dinner on Thursday, June 7, 2018. The event was attended by an esteemed group of women and included an exciting evening with great food and vibrant discussions, as we celebrated the advancement of women in Chicago's IP community through a three-course dining and networking experience.

IPLAC welcomes submissions of material for its e-newsletter. Please forward information to **Ela Baio** of Nixon Peabody, LLP.

