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**Organization Newsletter**

October - November 2018

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In This Issue...

1. [President's Letter](#)
2. [Future Events](#)
3. [Past Events](#)

President's Letter

Dear IPLAC Members,

IPLAC had a busy Fall and continues to be central to the national intellectual property community.

Last month IPLAC hosted arguably the best IP Symposium in its rich history by featuring a powerhouse line up of preeminent speakers. **Federal Circuit Chief Judge Sharon Prost**, along with her Federal Circuit colleagues **Judges Raymond Chen** and **Richard Linn**, shared their recommendations for how to persuasively craft appellate briefs and effectively use oral argument. **Chief Judge Rubin Castillo** and his colleague from the Northern District of Illinois, **Matthew Kennelly**, discussed the state of the District and rationale behind the recently-amended local patent rules. We were also thrilled that **Judges Edmond Chang, Thomas Durkin, Virginia Kendall, and John Tharp Jr.**, and **Magistrate Judge Sidney Schenkier**-all from the Northern District of Illinois-shared their thoughts on court-mediated settlement discussions and current issues facing the bench and bar. And lastly, Midwest USPTO Director **Damian Porcari** and General Counsel and Associate Registrar of the U.S. Copyright Office **Regan Smith** both addressed current and future initiatives for their respective offices. What a program! Please join me in thanking our Symposium Committee co-chairs: **Casey Mangan, Peter Prommer, Jared Hedman, Serena Pruitt, and Alisa Simmons**.

Later that evening at the Judges' Dinner, I shared the remarkable history of the special connection between IPLAC and the creation of the Federal Circuit. In 1887, **John M. Harlan**, Associate Justice of the U.S. Supreme Court, addressed our membership and provided his vision for the creation of a "specialized court" in Washington D.C., one with appellate jurisdiction over patent matters arising from U.S. District Courts and the Patent Office. Given that background, we were thrilled, and it seemed only fitting, that Judge Linn presented Chief Judge Prost with the *IPLAC Distinguished Judicial Service Award*. We were honored to have Chief Judge Prost accept the award, and grateful to Judge Linn, a past recipient, for presenting the award. In addition to the judges who participated with our Symposium named above, we were further honored that the following judges also attended our dinner: The Honorable **Gerald Cohn, James Holderman, Joan Lefkow, Michael Mihm, and Loren Smith**, as well as the President of the Board of Trustees for The John Marshall Law School, **Paula Holderman**. Our Dinner Committee co-chairs, **Janet Pioli** and **Alisa Simmons**, along with **Patty Nelles**, orchestrated a truly special evening.

Also in November **U.S. Congressman Danny Davis** from the 7th Congressional District of Illinois held the inaugural Inclusive Innovation Forum at famed Jean Baptiste Point DuSable High School. The forum featured executive leaders from, for example, Chicago Inventors Organization (**Calvin Flowers**), IPLAC (**Adam Kelly**), USPTO (**Damian Porcari** and **James Wilson**), and WIPO (**John Sandage** and **Paul Halfpenny**), each of whom addressed the challenges facing and resources available to traditionally underserved entrepreneurs and innovators. IPLAC was honored to be included in this important event that will serve as the blueprint for subsequent forums held in other cities throughout the United States.

Turning to December, IPLAC hosted **USPTO Regional Director Damian Porcari** and **IP Attaché Program Director Dominic Keating**. The Directors were joined by **Attachés' Kitisri Sukhahpinda** (South East Asia), **Shilpi Jha** (India and South Asia), **Mike Mangelson** (China and Taiwan), **Susan Wilson** (European Union), and **Todd Reves** (Mexico and Central America). The Patents International Committee co-chairs (**Joshua Sarnoff**, **John Paniaguas**, and **Casey Mangan**) organized a fantastic program.

Lastly, we thank all of our fantastic committees who prepared and planned events this Fall, including our committees for AIA Trials, Field Day, Law School Outreach, Litigation, Paralegals, Membership, and Younger Members.

Please have a safe and happy holiday season!

Warmest wishes,



134th President



Future Events

December 11, 2018 - Chicago, IL

IPLAC Young Members Committee & Stout - Intellectual Property Valuation

Join us for this lunch presentation providing a primer on IP valuation. The presenters will explore the importance of valuation fundamentals and cover the three primary valuation approaches. The presentation will also include a case study showing a practical application of the covered concepts. Seating is limited to 30, so RSVP to rschermerhorn@marshallip.com ASAP

The event will take place 11:30 a.m. - 1:00 p.m. at Patterino's, 150 N. Dearborn Ave., Chicago, IL 60601. The event is free for IPLAC members and non-members. Please RSVP no later than December 11, 2018.

February 9, 2019 - Chicago, IL

Midwest Regional of the INTA Saul Lefkowitz Moot Court Competition - Volunteers Needed!

The Midwest Regional of the INTA Saul Lefkowitz Moot Court Competition will be held on Saturday, February 9, 2019, from 8:00 a.m. to 2:30 p.m. at the Dirksen Federal Building, 219 South Dearborn Street, Chicago, Illinois. The Lefkowitz Moot Court Competition features a problem dedicated to trademarks and unfair competition. Bailiffs are essential to hosting the competition. Bailiffs run the courtrooms during the competition, help check in participating students, and help keep students on track as to time remaining during their oral arguments. The INTA Midwest Regional Planning Committee for the Lefkowitz competition invites you to volunteer as a bailiff during the competition. Please contact [Jasmine Davis](#) or [Alisa Simmons](#) to volunteer and to learn more information.

Save the Date

February 19, 2019 - Chicago, IL

The Corporate Committee will be hosting a fireside chat with USPTO Director Andrei Iancu at Chicago Kent Law School. Director Iancu will be facilitating a discussion with local area in-house counsel regarding the various initiatives underway at the USPTO and eliciting their feedback. Further details will be announced in 2019.

Past Events

September 21, 2018 - Chicago, IL

2018 Supreme Court IP Review (SCIPR)

Registration and continental breakfast took place from 8:30 to 9:00 a.m. The conference was held from 9:00 a.m. to 5:15 p.m. A reception followed from 5:15 to 6:15 p.m.

This event was held at Chicago-Kent College of Law at Illinois Tech, [565 West Adams Street](#) Chicago, Illinois 60661.

This conference was approved for 6.5 hours of general MCLE credit in Illinois and Pennsylvania.

September 26, 2018 - Chicago, IL

IPLAC Patents-International - European and Canadian Patent Practices

Part 1 of the seminar was devoted to tips on drafting patent applications for filing in the European Patent Office. Part 1 was presented by **Dr. Mash-Hud Iqbal**, a European Patent Attorney at Marks & Clerk. Part 2 of the seminar covered maximizing patent protection in Canada. Part 2 was presented by **Tomas Karger**, a Canadian Patent Attorney, also from Marks & Clerk.

The event took place at **DePaul College of Law, 25 East Jackson, Chicago, IL.**

Lunch was provided.

September 27, 2018

IPLAC Membership and Paralegal Committees - New Member, Committee Chair & Paralegal Reception

The IPLAC Membership and Paralegal Committees jointly hosted a complimentary networking reception for new members, paralegals, committee chairs and vice-chairs, officers, and board members. Attendees were encouraged to bring a friend that may be interested in joining IPLAC. Hors D'oeuvres and open bar.

The event took place at Moe's Cantina - River North, Second Floor Private Room, 155 W. Kinzie St., Chicago, IL 60654.

October 6, 2018 - Chicago, IL

Inventors Conference

IPLAC sponsored the 2018 Inventors Conference on October 6 at the Illinois Institute of Technology. For more information, please contact [Jessica Bahr](#).

October 10, 2018 - Chicago, IL

DePaul Law - 2018 Multi-Bar Association Fair

On October 10, 2018, DePaul University College of Law hosted its Multi-Bar Association Fair and invited IPLAC to join the other organizations. **Kenny Matuszewski**, Vice-Chair of the Membership Committee, was on hand to answer questions from students, faculty members, and recent graduates. He also helped them register for membership. While there are no tricks in becoming a member or getting involved with IPLAC, in the spirit of the holiday, treats were provided to everyone at the fair. IPLAC looks forward to returning to the Multi-Bar Association Fair next year, and seeing attendees at future IPLAC events.

October 11, 2018 - Chicago, IL

Young Member's Committee - An Evening of Design

This event took place at the IIT Chicago-Kent College of Law. A panel of industrial designers and design law attorneys discussed current issues in design protection. Speakers included **Rotimi Solola** (Industrial Designer), **Alisa Abbott** (Attorney, Banner & Witcoff), **Joey Zeledón** (Design Principal, Steelcase), and **Christopher Carani** (Shareholder, McAndrews, Held & Malloy). The Moderator was **Professor Graeme Dinwoodie** (Co-Director & Co-Founder of Chicago-Kent's Center for Design, Law & Technology).

October 12, 2018 - Chicago, IL

John Marshall Law School - IP Executive Seminar, Standard Essential Patents: What Every IP Attorney and In-House Counsel Should Know

This seminar was designed for IP attorneys, licensing professionals, and technologists interested in gaining valuable insights into the why and how of SEP development and licensing. It was taught by a renowned former jurist, a respected licensing executive, and an innovative IP strategist who will bring their perspectives to bear on this fascinating field.

The event took place from 9 a.m. - 4:30 p.m. at The John Marshall Law School.

October 17, 2018 - Chicago, IL

The IPLAC Trademark & Anti-Counterfeiting and Advertising & Internet Committees - Advertising 101



We had a lively and informative presentation on advertising law basics presented by **Nerissa Coyle McGinn**. Nerissa Coyle McGinn is a partner in the Advanced Media & Technology group in the Chicago office of Loeb & Loeb, LLP.

This event took place from 12:00 p.m.-1:15 p.m. at K&L Gates LLP, 70 W. Madison, Suite 3300, Chicago, IL 60602.

October 24, 2018 - Chicago, IL

IPLAC Trade Secret and Unfair Competition Committee - Crisis Management for IP Lawyers & Their Clients - Trade Secrets and Reputation Risk Management

This event included a fast-paced talk by veteran crisis management and communications specialist **Bruce Hennes**, from Hennes Communications in Cleveland, Ohio, who focused on a highly-strategic approach to crisis management and crisis communications for a wide variety of situations, offering methods to establish and maintain "control of the message," enabling attorneys to help their firms and clients move messages forward or mount a defense against an outraged public, unhappy customers or a sudden press onslaught.

The event took place at the Union League Club, 65 West Jackson Blvd., Chicago, IL 60604.

October 24, 2018 - Chicago, IL**IPLAC's Paralegal Committee and the Illinois Paralegal Association - Innovations and Future Trends in IP**

This event was sponsored by RWS and took place from 12:00-1:00 PM at the Law Offices of Baker & McKenzie.

October 25, 2018 - Chicago, IL**IP Speed Networking**

This event was a great opportunity for JD students to network with IP attorneys.

Speed networking took place from 5:30-6:30 p.m., followed by a general reception from 6:30-7:30 p.m., at the Loyola University School of Law.

October 30, 2018 - Chicago, IL**IPLAC Women in IP - Money Matters for Women Lawyers**

This Lunch and Learn with **Jen Dawson**, a Certified Financial Planner and Hemington's Chicago Managing Director included a conversation about common money issues of women lawyers. We are all Breadwinner Women who contribute a meaningful portion of our household's income. Regardless of age, position at the firm, marital status, kids or no kids, we know that your breadwinner status comes with a certain level of stress and unique challenges for women... especially women lawyers. Hemington Wealth Management is an independent firm that was founded on its expertise and data collected about Breadwinner Women. Jen Dawson, a Certified Financial Planner TM and Hemington's Chicago Managing Director, is a lawyer-loving wealth advisor who spends her time working with lawyer clients to turn their professional success into financial freedom. We brought Jen in to discuss the power and challenges of a Breadwinner Woman, and - more specifically - the common money issues, worries, and missteps of women lawyers. Jen highlighted the habits and behaviors of the happiest women lawyers in Chicago, and provide concrete tips for mastering the "3 C's" of Happy Lawyers, who have found answers to questions like these: 1. Control over cash flow - Why do you somehow feel cash-poor despite your healthy paycheck? Do you know your numbers for how much to save annually, above and beyond your retirement plans? What should you do with your bonus once your loans are paid off? 2. Clarity about your financial plan - Are there tax strategies that could save you money this year? Have you executed a will, trust, and powers of attorney (and remember what they say...)? Do you have too much or too little life and disability insurance? Are you giving too much or too little to charity? Does your big-picture plan align with your money values and family's priorities? 3. Confidence that your investments are aligned with your plan - Are you getting the right kind of financial advice? When is the right time to hire an advisor and what is a reasonable fee structure? What questions should I be asking my advisor? This was not a presentation about a specific investment strategy or current stock market conditions. Jen's goal was to empower the group with education and prioritization of what's most important for women lawyers and their personal finances. Jen also offered complimentary one-hour follow-up sessions to anyone with specific money questions that may be best addressed in a one-on-one setting.

The event took place at Constellation Brands, 131 S Dearborn St #1200, Chicago, IL 60603.

November 2, 2018 - Chicago, IL**John Marshall Law School - 62nd Annual Intellectual Property Law Conference**

Current Developments in Intellectual Property, Information Technology & Privacy Law were discussed. The event took place from 8 a.m. to 6:15 p.m. at the Union League Club, 65 W. Jackson Blvd, Chicago, IL 60604. 7 CLE credit hours are pending.

November 9, 2018 - Chicago, IL**2018 IPLAC IP Symposium**

IPLAC's IP Symposium was a great success. Held at The Standard Club, our program featured five sessions, each very different in its focus and content. Our first session addressed the *State of the Northern District of Illinois Courts and Experiences with the Local Patent Rules*. **Chief Judge Castillo**, **Judge Chang** and **Judge Kennelly** navigated these topics moderated by Chris Renk of Banner & Witcoff.

Next on our program agenda was a session confronting the topic of the *Age of Digital Disruption and the Rise in Technology Impacting Business*. Speaking on this panel were **Kris Carey**, SVP, General Counsel - Beer Division, Chief Compliance Officer and Chief Diversity Officer at Constellation Brands; **Kimberly Wong**, Senior Counsel, Privacy and Information Governance, at McDonald's Corporation; and **Nicholas Brescia**, Privacy Attorney at Walgreens. Serena Pruitt of McDonald's Corporation organized and moderated this session.

Following the *Digital Disruption* panel were representatives from the USPTO and the Copyright Office providing our Symposium with updates from their respective agencies. **Damian Porcari**, Director of the Midwest Regional USPTO updated us on PTO news and initiatives and **Regan Smith**, General Counsel and Associate Register of Copyrights at the US Copyright Office updated attendees on her office's initiatives and recent copyright legislation impacting music rights.

Our next topic covered *Advice, Practice Tips and Do's and Don'ts of Successful Practice in the Federal Courts*. Our panelists were **Judge Kendall**, **Judge Durkin** and **Magistrate Schenkier** from the Northern District of Illinois. Jared Hedman from Irwin IP organized and moderated this session.

Our final session of the day provided an *Update on Law and Practice in the Federal Circuit*. This session was moderated by Professor Josh Sarnoff of DePaul Law School and all attendees benefited from the engaging discussion among **Chief Judge Prost**, **Judge Linn**, and **Judge Chen** of the Federal Circuit.

IPLAC was pleased to have the support of several sponsors this year and extends its appreciation again for their commitment to IPLAC's IP Symposium: Barkley Court Reporters, Cardinal IP, Charles River Associates, Dennemeyer, PatPro, Inc. and Precision Discovery.

IPLAC also extends a special thank you to **Patrick Mangan**, DePaul 1L for covering the registration table for much of the day.

Thanks also to the planning committee for this year's Symposium: Jared Hedman, Casey Mangan, Peter Prommer, Alisa Simmons, and Serena Pruitt. Special thanks to Marshall Gerstein for hosting our Symposium website, and to Nixon Peabody and Fitch Even for their administrative support.

We're looking forward to seeing our IPLAC membership at next year's Symposium!

November 9, 2018 - Chicago, IL

The 124th Annual Dinner Honoring the Federal Judiciary



The Dinner was held at The Standard Club, in Chicago, Illinois. The evening began with a cocktail reception at 5:30 p.m., followed by dinner at 6:30 p.m. As always, this year's event was exceptionally fun and entertaining evening and was a great opportunity to treat your clients and colleagues to an enjoyable evening.

Distinguished Judicial Service Award

We awarded **the Honorable Chief Judge Sharon Prost** of the U.S. Court of Appeals for the Federal Circuit the IPLAC Distinguished Judicial Service Award.

After Dinner Get-Together

After dinner, we had our usual get-together with music, cocktails and a wonderful dessert table.

November 10, 2018 - Chicago, IL

Inclusive Innovation Conference



On November 10, **U.S. Congressman Danny Davis** for Illinois 7th Congressional District, AIPF, USPTO, and WIPO combined to host the inaugural Inclusive Innovation Conference at DuSable High School. Representing IPLAC, President **Adam Kelly** discussed the importance of creating initiatives to promote commerce and innovation among traditionally underserved entrepreneurs, as well as the recently-passed Success Act. Other notable speakers were Congressman Davis, **Damian Porcari** (Director of the Midwest Regional office of the USPTO), **Calvin Flowers** (President of Chicago Inventors Organization), and **John Savage** (Director of WIPO).

November 14, 2018 - Chicago, IL

IPLAC AIA Trials Committee and John Marshall Law School - AIA Trials Seminar

This event included an afternoon of discussions about the future direction of the PTAB co-hosted by the Intellectual Property Law Association of Chicago and John Marshall Law School. We explored changes in PTAB practice and strategies as a result of the Supreme Court's decisions in *Oil States* and *SAS Institute*, recent decisions by the Federal Circuit and current legislative initiatives.

Panel 1: The Evolving Administration of the PTAB

The Supreme Court's *Oil States* decision upheld the constitutionality of the PTAB, but the Court overturned the practice of partial institution in *SAS Institute*. As a result, the USPTO has changed its rules, and litigants are rethinking their strategy as well. This panel explored what effects these changes have already had and what challenges lie ahead.

Panel 2: The Federal Circuit and the PTAB

Courts initially gave wide latitude to the PTAB's decisions and policy choices. This panel discussed the relationship between the Federal Circuit and the PTAB and recent decisions that have scaled back the PTAB's power.

Panel 3: The Way Forward

Congress and the USPTO itself have been exploring ways to improve PTAB post-grant proceedings, including proposed legislation and rule changes. This panel examined what persistent concerns these proposals are intended to solve.

This event took place at John Marshall Law School, 315 S. Plymouth Court, Chicago, IL 60604.

November 15, 2018 - Chicago, IL

IPLAC Litigation Committee - Patent Damages Apportionment: Navigating Through a Turbulent Legal Climate

Determining patent infringement damages can be one of the most challenging aspects of a District court litigation. While the U.S. Supreme Court has mandated (dating back to the late 1800s) that patentees separate or apportion the value of the patented invention from non-patentable parts when determining damages, there has been confusion and uncertainty provided by recent Federal Circuit decisions as to how to properly satisfy the apportionment requirement. This has led to an increased number of *Daubert* motions being filed against damages experts and jury verdicts being appealed to the CAFC alleging that damages awards should be vacated.

Ken Adamo and **James Conte**, co-chairs of the IPLAC Litigation Committee and **David Duski**, National Intellectual Property Practice Leader at BDO USA, LLP led a collaborative discussion of the evolution of patent damages case law over the last two decades as it relates to apportionment and the best practices damages experts use today to tie damages to the economic footprint of the patented invention in order to survive *Daubert* challenges.

The event took place at Kirkland & Ellis, 300 North LaSalle, Chicago, IL.

A reception with food and drink immediately followed the presentation.

Approval for 1 CLE credit hour is pending.

November 27, 2018 - Chicago, IL

DePaul University Law School - Cyber Risk R/Evolution - 5th Annual Cyber Risk Conference at DePaul University

We are all exposed to cyber risk, both as individuals and as professionals. We need to be able to use sensitive data and accurately price and value the risks that our employers and clients take on or are exposed to.

Four panels addressed the topics of emerging threats, supply chain security, evolving insurance, and privacy issues. The conference began and ended with keynote speakers who are experts in cyber security and included a lunch as well as a reception, providing opportunities for networking.

The keynote speakers were **Orin S. Kerr**, Frances R. and **John J. Duggan**, Distinguished Professor of Law, University of Southern California Gould School of Law.

The event took place at DePaul University Loop Campus DePaul Center.

December 3, 2018 - Chicago, IL

IPLAC Patents-International Committee and the ABA Intellectual Property Law Section - Meet the Attachés from the US Patent Office

This event was an exciting opportunity to interact with a group of Intellectual Property (IP) Attachés from the United States Patent and Trademark Office (USPTO) as they shared the latest IP-related issues arising in their assigned regions of China, Mexico, Central America and the Caribbean, Europe, India and South East Asia. The Attachés covered a wide range of international IP topics, including global IP policy developments, IP protection and enforcement abroad, counterfeiting, piracy, and much more. The USPTO IP Attaché Program provides valuable services to US stakeholders. IP Attachés advocate to improve IP policies, laws, and regulations abroad including raising issues with foreign government officials, providing training on IP law, enforcement and administration, conducting public awareness programs, and presenting and explaining US government positions. They can provide information on how to navigate foreign laws and regulations, how foreign courts and governments work, and how to protect and enforce IP abroad. IP Attachés are knowledgeable on all aspects of intellectual property rights. IP Attachés are located in the following regions: EU, China, Mexico, Central America and the Caribbean, India and Southeast Asia.

This event took place at Denton's Chicago Office.

December 4, 2018 - Chicago, IL

IPLAC ADR - Using Non-Payment to Frustrate Arbitration

This event took place at Kirkland & Ellis.

IPLAC welcomes submissions of material for its e-newsletter. Please forward information to [Ela Baio](#) of Nixon Peabody, LLP.

