



## Ryan N. Phelan, J.D., MBA

Partner

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Ryan N. Phelan is a registered patent attorney who counsels and works with clients in all areas of intellectual property (IP), with a focus on patents. Clients enjoy Ryan's business-focused approach to IP. With a MBA from Northwestern's Kellogg School of Management, Ryan works with clients to achieve their business objectives, including developing and protecting their innovations and businesses with IP.

Ryan routinely helps clients with:

- Preparing and prosecuting high-quality patent applications, and developing strategic patent portfolios for innovative products and services, including in the U.S. and foreign jurisdictions (e.g., Europe, China, and Japan).
- Preparing legal opinions as to the patentability, non-infringement, validity, and/or freedom-to-operate of innovative products or services.
- Litigating IP related issues to protect client market share from competitors and defend clients from IP lawsuits against competitors or non-practicing patent entities.

As a former technology consultant with *Accenture* and with a background in computer science and engineering, Ryan has extensive experience in computer system, hardware, and software design, engineering, development and related technologies. He represents numerous startup and Fortune 500 clients with patent matters in technical areas and industries including artificial intelligence and machine learning, medical devices, biometrics data and services, virtual reality, imaging, internet and e-commerce, computer networking, data storage and management, encryption and security, mobile telecommunications, consumer electronics, insurance and finance applications, mechanical devices, among others.

Ryan has been published in several well-known IP publications including the *World Intellectual Property Review*, *Bloomberg Law*, and *IP Litigator*, and has spoken as a panelist at various IP conferences, including for the International Intellectual Property Law Association (IIPLA), and for the University of Illinois Chicago Annual IP Conference. Ryan's recent article titled *Artificial Intelligence & the Intellectual Property Landscape* details how artificial intelligence is reshaping the business and intellectual property landscape.

Ryan is also an adjunct professor at Northwestern University's Pritzker School of Law where he teaches coursework on *Patenting Software Inventions*, with a focus on patent subject matter eligibility dealing with procuring software and computer related patents in view of 35 U.S.C. § 101 and the U.S. Supreme Court's decision in *Alice Corp. v. CLS Bank International*, 573 U.S. 208 (2014).

Ryan has been rated by *Super Lawyers*® and *Leading Lawyers*™ as a Rising Star and peer selected Emerging Lawyer, respectively, for years 2019 through 2020. Since 2021, Ryan has been named a Leading Lawyer.



Ryan is the moderator of PatentNext, a blog that focuses on patent and IP law relating to next-generation and new age technologies.

# PatentNext

## Practices

- Design Patents
- IP Litigation
- ITC 337 Investigations
- Patent Prosecution
- Post-Grant Patent Proceedings

## Industries

- Artificial Intelligence
- Blockchain & Cryptocurrency
- Consumer Products
- Electrical & Computer Technologies
- Industrial & Mechanical Technologies
- Insurance & Financial Services
- Internet & Cyberlaw
- Medical Devices

## Representative Experience

### Patent Preparation and Prosecution

On behalf of startups to Fortune 500 companies, Ryan prepares, prosecutes, and manages patents and patent portfolios, in various technologies and technical fields. Ryan's technical experience and background, together with his litigation experience, allows him to quickly understand his client's technology and products, and prepare high-quality, litigation ready patents.

Ryan has personally prepared and prosecuted, or has been involved in preparing and prosecuting, over one hundred (100) patent applications in emerging and technical areas and industries, including in the U.S. and foreign jurisdictions (e.g., Europe, China, and Japan).

Ryan has extensive experience in and has represented clients in technical areas including:

- Medical devices and software-related medical device technologies such as Software as a Medical Device (SaMD) and Software in a Medical Device (SiMD)
- Artificial intelligence (AI) and machine learning, including self-driving vehicles
- Robotics, including electronically controlled prosthetics
- Biotechnology, including data and image processing, analysis, and learning
- Computer engineering, architecture, and networking
- Cloud-based computing and client-server architectures
- Internet of Things (IoT), devices, and applications
- Internet and e-commerce related web systems
- Blockchain and Cryptocurrency
- Big Data systems and applications
- Data management and storage
- Imaging applications, including 3D, point cloud, and sensor based systems and applications
- Virtual Reality (VR), Augmented Reality (AR), and Mixed Reality (MR) technologies
- Computer graphics and gaming
- Security, cryptography and encryption
- Secured Sockets Layer (SSL) and Transport Layer Security (TLS) internet communication technology
- Digital rights management technology
- Databases and information systems
- Wireless, mobile, and related telecommunications systems
- Next generation mobile devices
- Radio frequency communication circuits and systems
- Digital signal processing
- Interactive user program guide interfaces
- Financial and Insurance industry innovations
- Mechanical devices

## Intellectual Property Litigation

Ryan focuses on results for his clients and represents clients in intellectual property litigation in both defensive and offensive IP matters. He has represented clients in cases in various U.S. district courts, including the Northern District of California, the Eastern District of Texas, the Northern District of Illinois, among others, and has practiced before the U.S. Patent Trial and Appeal Board (PTAB), and before the U.S. International Trade Commission (ITC).

He is experienced in all stages of litigation, including pleadings, discovery, summary judgment and trial.

Ryan's litigation experience includes:

- *In re the Matter of Certain Height-Adjustable Desk Platforms and Components Thereof* (USITC 337-TA-1125) – Counsel for Lorell and Huizhou Chang He Home Supplies Co., Ltd. in a patent infringement case involving height adjustable desks. Reached settlement agreement following claim construction. (Settlement reached: Q1 2019).
- *In re the Matter of Certain Collapsible Sockets for Mobile Electronic Devices and Components Thereof* (USITC 337-TA-1056) – Counsel for PopSockets in a patent infringement case involving consumer products for mobile devices. The International Trade Commission found in favor of PopSockets and issued a General Exclusion Order (GEO) preventing infringing products from being imported into the United States. (GEO issued: 6/14/2018).
- *ContentGuard Holdings, Inc. v. Apple, Inc.* (E. D. Tex.) – Counsel for Apple in a patent infringement case involving digital rights management technology and Apple iTunes. Jury found on behalf of Apple with a verdict of non-infringement (Jury Verdict: 09/23/2015).
- *Petitions for Inter Partes Review (IPR2015-01956 and IPR2015-01957)* – Counsel for Old Republic General Insurance Group for IPR petitions filed to invalidate patents regarding Internet and e-commerce technologies that were asserted in district court litigation. The Patent Trial and Appeal Board (PTAB) instituted the petitions on all grounds asserted.
- *Intellectual Ventures II LLC v. BITCO General Insurance Corporation f/k/a Bituminous Casualty Corporation et al.* (E.D. Tex.) – Counsel for BITCO General Insurance Corp. and Great West Casualty Company in a patent infringement case involving Internet, e-commerce, and encryption technologies.
- *Protegrity Corp v. Trustwave Holdings, Inc.* (D. Conn.) – Counsel for Trustwave in a patent infringement case involving database security and encryption.
- *Wargaming.Net LLP v. Changyou.com Limited et al* (N.D. Ill.) – Counsel for Changyou in a copyright infringement case involving Wargaming's World of Tanks® video game; claims against Changyou settled in 2014.
- *Stambler v. Northern Trust Corporation et al* (E.D. Tex.) – Counsel for Northern Trust in a patent infringement case involving Secured Sockets Layer (SSL) and Transport Layer Security (TLS) Internet communication technology; claims against Northern Trust dismissed in 2013.

- *TQP Development, LLC v. Northern Trust Corporation* (E.D. Tex.) – Counsel for Northern Trust in a patent infringement case involving the RC4 internet encryption algorithm; claims against Northern Trust dismissed in 2013.
- *In the Matter of Certain Products Containing Interactive Program Guide and Parental Controls Technology* (USITC 337-TA-820) – Counsel for Rovi Corporation in a patent infringement case involving Internet technology and interactive program guides brought against Vizio Inc.; claims against Vizio settled in 2013.
- *In the Matter of Certain Products Containing Interactive Program Guide and Parental Controls Technology* (USITC 337-TA-845) – Counsel for Rovi Corporation in a patent infringement case involving Internet technology and interactive program guides brought against various respondents, including LG Electronics and Mitsubishi; claims against Mitsubishi and LG Electronics settled in 2013.
- *Guardian Media Technologies, Ltd. v. Acer America Corporation et al* (E.D. Tex.) – Counsel for defendant Office Depot in a patent infringement case involving consumer electronic equipment; claims against Office Depot dismissed in 2013.
- *Extreme Networks, Inc. v. Enterasys Networks, Inc.* (W.D. Wis.) – Trial counsel for Extreme Networks, defending Extreme Networks in a patent infringement jury trial involving computer networking equipment. Jury found on behalf of Extreme Networks with a verdict of non-infringement (Jury Verdict: 11/04/2011).

## Background and Credentials

Ryan received his J.D., *cum laude*, from Northwestern University School of Law, concurrent with an MBA from Northwestern University, Kellogg School of Management. While in law school, he served as an Executive Editor of the *Northwestern Journal of Technology and Intellectual Property*.

Prior to attending law school, Ryan worked as a capital markets technology consultant at *Accenture* where he developed broad experience in software engineering and computer architecture. Ryan has extensive experience with a variety of technologies, including Python, R, Java/J2EE, Microsoft C#/.NET, C++/C, Perl, XML, JSON, SOAP, XSL, HTML, CSS, JavaScript, Web 2.0, cloud-based and artificial intelligence (AI), and machine learning technologies and libraries, including Google TensorFlow and Facebook's PyTorch. Ryan is also a Certified Java Programmer.

Ryan received his B.S., *magna cum laude*, in computer science from the University of Louisiana-Lafayette. While at University of Louisiana-Lafayette, Ryan served as president of his school's *Association of Computing Machinery* (ACM) chapter.

## Education

- Northwestern University School of Law (J.D., *cum laude*)
- Northwestern University Kellogg School of Management (MBA)
- University of Louisiana Lafayette (B.S., *magna cum laude*)
  - Computer Science

## Bar Admissions

- Illinois
- U.S. Patent and Trademark Office
- U.S. District Court, Northern District of Illinois
- U.S. District Court, Eastern District of Texas
- U.S. District Court, Western District of Wisconsin

## Publications and Presentations

November 4, 2021

### **"Technology & Privacy"**

*University of Illinois Chicago 65th Annual IP Conference*

November 4, 2021

### **"IP & Non-Fungible Tokens"**

*IIPLA 2021 USA*

September 22, 2021

### **UK Appeals Court Ruled an Artificial Intelligence (AI) Machine Cannot be Listed as an "Inventor" on a Patent Application**

*Marshall Gerstein Insights*

September 14, 2021

### **Patent Applications for Software and Computer Related Inventions Need to Demonstrate Technology Improvement to be Patentable**

*Marshall Gerstein Insights*

September 3, 2021

### **U.S. District Court Judge Affirms USPTO's Finding That an Artificial Intelligence Machine (named "DABUS") Cannot be an Inventor Pursuant to Current U.S. Patent Law**

*Marshall Gerstein Insights*

August 10, 2021

**Australian Judge Becomes the First Jurist to Rule that Artificial Intelligence (AI) Systems Can Be Recognized as a Patent Inventor**

*Marshall Gerstein Insights*

July 30, 2021

**South Africa Issues the World's First Patent Listing an AI as the Sole Inventor**

*Marshall Gerstein Insights*

April 14, 2021

**"Protecting Software Related to a Medical Device: A Case Law Review & Strategy"**

*IPO webinar*

April 5, 2021

**"Protecting Software Related To a Medical Device: A Case Law Review and Strategy Guide"**

*Intellectual Property Owners Association*

February 17, 2021

**"Patenting Artificial Intelligence (AI) Inventions in Japan and the U.S."**

*Intellectual Property Law Association of Chicago (IPLAC) and Japan Patent Attorneys' Association (JPAA) Joint Event*

January 26, 2021

**"Patenting Artificial Intelligence Inventions in the U.S."**

*Center for International Legal Studies (CILS) Artificial Intelligence Think Tank Conference*

November 2, 2020

**"SUI Generis Right for Trained AI Models"**

*IPO AI & Other Emerging Technologies Committee Paper*

September/October 2020 Issue

**"Eyes Wide Open"**

*Loss Prevention Magazine*

**USPTO's New Report on AI**

*Marshall Gerstein Insights*

October 23, 2020

**Patent Applications Featuring Artificial Intelligence (AI) Doubled Since 2002**

*Marshall Gerstein Insights*



October 2020 Issue

**"AI and Plastics: The Revolution Begins" (featured quotes)**

*Plastics Engineering Magazine*

October 8, 2020

**USPTO Artificial Intelligence and Intellectual Property Policy October 2020 Report**

*Marshall Gerstein Insights*

August 28, 2020

**"Protecting COVID-19-Related Software Innovations"**

*IPWatchdog*

August 19, 2020

**"High Priority"**

*Intellectual Property Magazine*

August 14, 2020

**Under Current Legal Principals, an Artificial Intelligence Cannot be a Patent Inventor**

*Marshall Gerstein Insights*

June 12, 2020

**"Data Privacy Law and Intellectual Property Considerations for Biometric-Based AI Innovations"**

*Security Magazine*

May 1, 2020

**Federal Circuit reaffirms that software inventions are patentable in the U.S.**

*Marshall Gerstein Insights*

May 2020 Issue

**"Private Matter: Data Privacy Law and Intellectual Property Considerations for Biometric Based Artificial Intelligence Innovations"**

*Intellectual Property Magazine*

April 2020

**The Japanese Patent Office (JPO) provides patent examination case examples pertinent to artificial intelligence (AI) related technologies**

*Marshall Gerstein Insights*

April 2020

**Federal Circuit finds a cardiac monitor device not abstract (and, therefore, patent eligible) under the Supreme Court's Alice test**

*Marshall Gerstein Insights*



December 24, 2019

**"What's in the USPTO's 2019 Subject Matter Eligibility Guidance Update?"**

*World Intellectual Property Review*

November 27, 2019

**"Patent Practice Tips After the USPTO Guidance Update"**

*Bloomberg Law*

November 27, 2019

**"INSIGHT: Three Practice Tips Since USPTO Updated Its Subject Matter Eligibility Guidance"**

*Bloomberg Law*

September/October 2019 Issue

**"Four Decisions to Know Regarding the PTAB's Treatment of the New 2019 Patent Eligibility Guidelines"**

*IP Litigator*

September 17, 2019

**"Patenting Software & AI Inventions"**

September 2019

**Artificial Intelligence & the Intellectual Property Landscape**

*AI Insights*

February 24, 2019

**"Return Mail Reaction: Patent Bar Sampling Narrowly Favors Finding for Petitioner" (featured quotes)**

*IPWatchdog*

February 18, 2019

**"SCOTUS to Consider Whether Government is a 'Person' (featured quotes)**

*World IP Review*

July 30, 2018

**"Federal Circuit Ruling Invites PTAB Fights Over Hidden Parties" (featured quotes)**

*Law360*

June 15, 2018

**"What PTAB Attorneys Need to Know About Real Parties-in-Interest" (featured quotes)**

*Law360*

February 26, 2018

**"Patenting Software & AI Inventions: Why, What, and How"**

February 9, 2018

**"Patent Quality Review Including 101 Rejections"**

February 16, 2017

**"IP Law and the IoT"**

January 5, 2017

**"En Banc Federal Circuit Time-Bar Case May Increase AIA Appeals" (featured quotes)**

*Law360*

September 1, 2013

**"Case Exceptional for Maintaining Suit After Adverse Claim Construction Ruling"**

May 2013

**"Second Circuit is Not the Place to Judge Claims of Fraud, Negligence, Breach of Contract, Unjust Enrichment and Conversion Against the Holy See"**

September 2012

**"Web-Linking is Not Necessarily Copying"**

### **Community and Professional Involvement**

- Member, Intellectual Property Owners (IPO), AI & Other Emerging Technologies Committee and Software Related Inventions Committee
- Member, American Intellectual Property Law Association (AIPLA)
- Member, Intellectual Property Law Association of Chicago (IPLAC)
- Lawyers for the Creative Arts—Pro Bono Representation