



Richard P. Beem

Partner | richard.beem@lathrooggpm.com

CHICAGO

155 North Wacker Drive
Suite 3000
Chicago, IL 60606-1787

T: 312.920.3303

DALLAS

2101 Cedar Springs Road
Suite 1400
Dallas, TX 75201

T: 469.983.6100
F: 469.983.6101

Assistant

Angela Williams
816.460.5767

PRACTICE AREAS

Intellectual Property Litigation

Intellectual Property

Patents

Inter Partes Review

Trademarks

Non-Compete, Non-Solicit,
Trade Secrets & Other
Restrictive Covenants

Appellate Practice

Copyrights

INDUSTRIES

Life Sciences

Manufacturing

Technology

With more than 30 years of experience in patent law across a range of technologies and industries in the U.S. and abroad, Richard Beem enjoys working with each client to serve their business and to protect their intellectual property. From preparation, filing and prosecution of patent applications to litigation, trials and appeals, Rich assists clients in securing their intellectual property rights — and, more importantly, contributes to the success of their innovations and ultimately to the growth of their business. To serve clients' national and global intellectual property needs, Rich maintains relationships with top lawyers who assist in protecting inventions and technologies in many other regions and countries.

Rich has worked with clients in many industries and technologies, including:

- Chemicals and polymers
- Computers and computer-implemented inventions
- Electronics
- Gaming
- Internet-based applications and services
- Manufacturing and processes
- Mechanical and electro-mechanical devices
- Medical information systems and devices
- Oil and gas
- Pharmaceuticals
- Software

COURT MEMBERSHIPS

- Illinois
- Texas
- U.S. Court of Appeals for the Federal Circuit
- U.S. Court of Appeals for the Seventh Circuit
- U.S. District Court for the Northern District of Illinois
- U.S. Patent and Trademark Office
- U.S. Supreme Court

EDUCATION

University of Houston Law Center, J.D., *cum laude*, 1985

- *Houston Law Review*, Editor
- Order of the Coif

DePaul University, Mediation Certificate

Iowa State University, B.S., Chemical Engineering

CLERKSHIP(s)

Law Clerk to the Honorable Edward S. Smith, Circuit Judge, U.S. Court of Appeals for the Federal Circuit

Rich has extensive experience as a patent trial lawyer, including appearances in U.S. district courts and the U.S. International Trade Commission (ITC) and in the appellate phase before the U.S. Court of Appeals for the Federal Circuit. Also, he often acts as a co-counsel or local counsel with referring attorneys in patent infringement cases.

Early in his career, Rich gained business and technical experience, having worked as a refinery operations engineer for an oil corporation and as a technical sales representative for a water and process management solutions leader. He also served for two years as law clerk to the Honorable Edward S. Smith, Circuit Judge of the U.S. Court of Appeals for the Federal Circuit. During this time, Rich worked on hundreds of appeals from the Patent Office and federal courts and tribunals. Since then, he has continued building an extensive network of associates worldwide through his leadership and involvement in U.S. and international professional associations.

Rich is the past president of the U.S. group of the International Association for the Protection of Intellectual Property (AIPPI) and a leader at the bar locally, nationally and internationally. He has published and lectured on patent law and practice in the U.S., Europe and Asia.

Representative Experience

- *180s, Inc. et al v. Gordini U.S.A., Inc.* (D. Md.). Currently defending client in pending patent and trade dress infringement case.
- *Air Products v. Commissioner of Patents* (D.D.C.). Won summary judgment against U.S. Commissioner of Patents and Trademarks, resulting in reinstatement of client's patent application.
- *American National Can v. Continental PET Technologies* (D. Conn.). Represented patent owner in discovery and motion practice in patent infringement case.
- *Biopolymerengineering, Inc. et al. v. Biorigin* (N.D. Ill.). Successfully obtained Stipulated Dismissal from plaintiff of all claims during case involving patent infringement litigation, discovery and motion practice.
- *BlackJack Sulky Ltd. v. Evolution Racing, LLC et al.* (N.D. Ohio). Successfully reached a settlement on patent infringement case for

defendant.

- *Colt Industries v. Index-Werke*. Briefed patent infringement appeal in Federal Circuit court.
- *D.Y.L. Co., Ltd. v. Camping World, Inc.* (N.D. Ill.). Represented plaintiff in pet food container patent infringement case where monetary settlement was reached including stipulated final judgment including permanent injunction against defendant.
- *Ellenby Technologies, Inc. v. Fireking Security Group, et al.* (N.S. Ill.). Represented plaintiff in patent infringement litigation, and litigated to settlement.
- *GlaxoSmithKline v. Torpharm, Warner-Lambert v. Torpharm, and Abbott v. Torpharm* (N.D. Ill.). Represented pharmaceutical client in patent infringement litigation, discovery and motion practice.
- *Heat-N-Glo v. Heatilator* (S.D. la.). Represented client in patent infringement and trade secret litigation involving direct vent fireplaces. Successfully won motions and partial dismissal en route to a settlement.
- *Intelligent Medical Objects, Inc.* (Fed. Cir.). Handled appeal from USPTO (appellant/applicant) for an electronic medical records software. Following opening brief, Solicitor agreed to vacate patent-eligibility rejection and application was ultimately allowed without further prosecution.
- *James River v. Hallmark Cards* (E.D. Wis.). Represented client in paper plate patent litigation.
- *Knorr-Bremse v. Dana*, 383 F.3d 1337 (Fed. Cir. 2004) (*en banc*). Successfully convinced the Court to hold that no adverse inference can be drawn from refusal to waive attorney-client privilege and produce opinion of counsel. Rich was principal author of brief of amicus curiae American Bar Association, which helped in this case.
- *Lakewood Engineering and Mfg. Co., Inc., Gregg Szilagyi et al. v. Chicago American Manufacturing, LLC. et al.* (Bankr. N.D. Ill.). Defended client patent and trademark infringement, discovery and motion practice for box fans product.
- *MCI v. AT&T* (E.D. Pa.). Defended telecommunications software patent infringement litigation.
- *Mentor v. Inamed, McGhan Medical, and Cox-Uphoff*. Represented client in patent infringement litigation and appeals in Central District of California (Los Angeles), U.S. Bankruptcy Court for C.D. Cal. (Santa Barbara) (received recommendation from Court for litigation results and favorable settlement), N.D. Tex. (Dallas),

Federal Circuit and U.S. Supreme Court.

- *MIT Automobile, Inc., et al., Gary Mfg.* (W.D. Missouri). Represented U.S. and Chinese defendants in case of alleged patent infringement involving truck lift systems, obtained dismissals and settlements.
- *Mohawk Resources Ltd., Vehicle Services Group, LLC, v.* (S.D. Ind. and USPTO before the Patent Trial and Appeal Board). Represented defendant, obtained Inter Partes Review instituted for all petitioned claims; and settled case through mediation.
- *NanJing ManWei Fushi Co. Ltd.* (N.D. IL). Represented defendant in trademark infringement pertaining to website product promotion and sales. Obtained settlement and partial recovery of funds.
- *Phillips Petroleum v. U.S. Steel et al.* Team member in successful Federal Circuit appeal affirming district court judgment of patent infringement, culminating 30 years of litigation and interferences over Nobel prize-winning invention of crystalline polypropylene.
- *Portfolio Technologies, Inc. v. Church & Dwight Co., Inc. and Medtech Products, Ltd. and Intellx, Inc.* Represented plaintiff in patent infringement litigation, discovery and motion practice, trial (International Trade Commission). Briefed appeal and oral argument in Federal Circuit regarding male prophylactics.
- *Power Probe v. Innova Electr. (D.Nev.)*. Representing defendant in case of alleged patent infringement involving automotive electronics testing device.
- *Presto Industries v. Dazey Corporation* (N.D. Ill.). Represented client in design patent and trade dress litigation.
- *Rite-Hite Corporation v. Serco Corporation* (N.D. Tex.). Completed four-week jury trial where jury found both parties' patents valid and not infringed.
- *Sabratek, Inc., Sims Deltec, Inc. v.* (D. Minn). Represented defendant in case of alleged patent infringement, resolved through settlement.
- *SFG, Inc. v. Kimbal Musk, et al. (N.D. Ill.)*. Litigated trademark infringement case for plaintiff, resolved by settlement through mediation.
- *Torpharm v. Genpharm & Novopharm*. Briefed and argued Federal Circuit appeal and prepared and filed petition for certiorari to U.S. Supreme Court

Presentations

- Presenter, "Software Patent Appeal Victory," Intellectual Property Owners - IPO Webinar, Committee on Software-Related Inventions, December 19, 2018
- Presenter, "What Will You Trade? Knowledge, IP, Global Impact," Technology, Globalization and Culture, Iowa State University, October 10, 2018
- Presenter, "Winning, Gatekeeping, Courtesy," John Marshall Law School Program on Ethical Issues Arising in Patent Litigation, April 27, 2018
- Presenter, "Protect Valuable IP in Key Markets," Technology, Globalization and Culture, Iowa State University, November 1, 2017
- Presenter, "Patentability of Software Inventions," American Intellectual Property Law Association (AIPLA), IP Law Associations Committee Webinar, May 5, 2017
- Presenter, "Inter Partes Review of Patents," Chicago Bar Association, IP Law Committee, March 25, 2015
- Presenter, "Details, Mistakes & Cures in IP Law Practice," Illinois Paralegal Association Fall Conference, November 20, 2014
- Instructor, "IP Trial Advocacy 8-Day Course," IIT Chicago-Kent Law School, 2014 & 2015
- Presenter, "Intellectual Property (IP)/Patents: Key Assets in Global Economy - Software and Digital Games," Technology, Globalization and Culture, Iowa State University, October 14, 2014
- Presenter, "Patent Eligibility of Computer-Implemented Inventions (CII): Digital Gaming," U.S. Bar - EPO Liaison Council Meeting, Munich, Germany, October 17, 2013
- Presenter, "Patent Eligibility of Computer-Implemented (Software) Inventions," Technology, Globalization and Culture, Iowa State University, October 1, 2013
- Presenter, "Patent Eligibility of Computer-Implemented Inventions (CII): Digital Gaming," International Association for the Protection of Intellectual Property (AIPPI) Forum, Workshop IV Digital Gaming and IP, Finland, September 2013
- Moderator, "Hot Topics in International IP Law," American Bar Association's 26th Annual Intellectual Property Law Conference, April 7, 2011
- Presenter, "What Every Business Manager Needs to Know About Patents and Trade Secrets," Alliance for Illinois Manufacturing - IP

Seminar, March 29, 2011

- Presenter, "Video Animation in Markman Hearings and Patent Litigation," AIPLA IP Practice Meeting in Tokyo, April 22, 2010
- Co-presenter, "U.S. Patent Prosecution: Attorney's & Examiner's Perspectives," AIPLA Annual Meeting - IP Practice in Japan Committee, October 14, 2009
- Panelist, "*Rambus* is Final: Where Do We Go From Here?" Illinois State Bar Association, September 11, 2009
- Panelist, "Developing Business as an IP Attorney," Chicago Kent College of Law, April 1, 2009
- Presenter, "Double Patenting In re Basell Poliolefine," AIPLA Midwinter Meeting - IP Practice in Japan Committee, January 28, 2009
- Presenter, "Obviousness after KSR - Litigation Perspective," AIPLA Annual Meeting - IP Practice in Japan Committee, October 21, 2008
- Presenter, "Preparing the Patent Specification for Filing in the United States," Association of Intellectual Property Protection International (AIPPI) Congress, September 2008
- Presenter, "Do Patent Prosecution Rules and Practices Lead to Legal and Commercial Uncertainty?" International Association for the Protection of Intellectual Property (AIPPI) Forum, Singapore, October 5, 2007
- Presenter, "Trials with Sensitive Topics," American Bar Association Annual Meeting, San Francisco, California, August 2007
- Presenter, "Writing Good Invention Disclosures for Obtaining Good Patents," U.S. Army, Army Scientists and Engineers, 2005 & 2006
- Presenter, "Why Talk When You Can Litigate?" American Bar Association - IPL Section of Alternative Dispute Resolution, Las Vegas, Nevada, October 21, 2005
- Presenter, "Patents & Trade Secrets for Engineers," American Society of Mechanical Engineers (ASME), March 2004
- Presenter, "The Role of Engineers in Creating Intellectual Property," American Society of Mechanical Engineers (ASME) Central Region Administrative Conference, March 27, 2004
- Presenter, "Willfulness, Opinions & Privilege: Knorr-Bremse & The Coming New 'Totality of Circumstances' Standard," 48th Annual IP Conference, John Marshall Law School, February 27, 2004

- Presenter, "United States Design Patents," Association of Intellectual Property Protection International (AIPPI) MIE Conference on Intellectual Property, September 6, 2003
- Presenter, "Winning the Patent Battle Without Spending an Arm and a Leg: A Challenge to Corporate Counsel," American Bar Association (ABA) Annual Meeting, 2003
- Panelist, "Meaning and Effect of Supreme Court IP Disputes on Practice, Patent Prosecution and Litigation In View of Festo v. SMC and Holmes v. Vornado," John Marshall Law School 47th Annual Conference on Developments in IP Law, 2003

Publications

- Author, "IP Lawyer: Does TC Heartland Signal the End of East Texas' Dominance?" *IAM*, August 1, 2017
- Author, "Federal Circuit Weighs Attorney-Client Privilege," *Chicago Daily Law Bulletin*, March 1, 2004
- Author, "Winning the Patent Battle Without Spending an Arm and a Leg: A Challenge to Corporate Counsel," *Chicago Daily Law Bulletin*, August 26, 2003
- Co-author, "Candor in Prosecution," American Intellectual Property Law Association (AIPLA), 1985

In The News

- ADVFN Features Growth of Intellectual Property Litigation Group as New Partner Richard Beem, Associate Alex Shtraym Join Chicago, Dallas Offices
January 10, 2023
- Le Léopard Features Growth of IP Litigation Group: Lathrop GPM Announce New Partner Richard Beem, Associate Alex Shtraym to Join Chicago, Dallas Offices
January 10, 2023
- Law360 Features New Partner Richard Beem, Associate Alex Shtraym as Intellectual Property Litigation Practice Expands
January 9, 2023
- Chicago Bar Association Record Quotes Partner Richard P. Beem on Use of Attorney-Client Privilege in Willful Infringement Case
March 30, 2004
- The National Law Journal Quotes Partner Richard P. Beem on Chicago Attorneys' Efforts to Seek a More Predictable Patent System

October 3, 2008

News Releases

- Three Lathrop GPM Attorneys Named 2024 Illinois Super Lawyers and Rising Stars
January 25, 2024
- Two Lathrop GPM Attorneys Named to Illinois Super Lawyers and Rising Stars
February 2023
- Lathrop GPM LLP Intellectual Property Litigation Group Grows
January 9, 2023

Professional Affiliations

- American Bar Association
 - IPL Section Liaison to EPO - U.S. Bar Council, 1984-present
- American Intellectual Property Law Association (AIPLA)
 - Europe and Japan IP Committees
 - Electronic and Computer Law Committee
- Chicago Bar Association
 - IP Law Committee, Chair, 1997-1998
- International Association for the Protection of Intellectual Property (AIPPI-US)
 - President, 2009-2012
- Intellectual Property Law Association of Chicago (IPLAC)
 - Secretary, 1992-1994

Community Involvement

- Chicago Engineers' Foundation
 - President, 2014-2015
 - Member, Board of Directors, 2010-2014
- Union League Club of Chicago
 - Secretary, 2021-present
 - Member, Board of Directors, 2015-2018

Honors

- *Illinois Super Lawyers*, Intellectual Property, 2006-2008, 2010-2024
- Fellow, American Bar Foundation, January 2012