Partner

# Steven G. Parmelee

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## Profile

> **"I love the challenge of preparing a difficult patent … and then going the extra mile to identify and extract the patent's optimum business value."**

For over 40 years, businesses of various sizes and stages, independent inventors and others have turned to Steven G. Parmelee for high-quality, client-focused patent services. Steve has personally written well over 2,200 patent applications, handling ordinary prosecution as well as administrative and judicial appellate work, post-grant reexamination work, and other sophisticated patent needs. Clients, both U.S. and foreign, often seek Steve's counsel to manage their patent portfolios, whether comprising existing inventions or new prospective ventures.

Steve has also litigated various cases for both bench and jury trials. He has handled appellate work before the Court of Appeals for the Federal Circuit, as well as considerable enforcement and defensive work. Steve's litigation and licensing experience greatly informs the drafting and prosecution of his patent applications.

An electrical engineer by training, Steven is especially well-versed in the following areas:

- Artificial Intelligence
- Wireless communications, Internet and software-based technologies
- Business, including in particular insurance, real estate, and financial fields
- Promotional methods and systems
- High-energy imaging systems
- Digital processing techniques, including encryption, encoding, and compression
- Data networks, including both electronic and optical technologies
- Lighting
- Robotics (including terrestrial and airborne drones)
- RFID and NFC tags and reader

### Education

J.D., Creighton University School of Law, 1978, *magna cum laude*

B.S., Electrical Engineering, Rose-Hulman Institute of Technology, 1975

### Bar Admissions

Nebraska

U.S. Patent and Trademark Office

U.S. Court of Appeals for the Federal Circuit

U.S. District Court for the Districts of Nebraska and Minnesota

### Recognition

Named a Leading Lawyer in Illinois in Intellectual Property Law and Patent Law (2014–24)

### Services

International IP Protection

IP Portfolio Management

IP Strategy Development

Patent Preparation + Prosecution

PTAB Trial Practice

Reissue + Reexamination Proceedings

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- Automotive electronics
- Semiconductor fabrication
- Remote controls
- networks
- Packaging and vending systems
- Medical devices and systems, including radiation treatment platforms

Steve is effective at helping clients identify and realize the value in their patent assets. He has led numerous white-space inventing efforts for various clients and is a founding member of the International Association of Innovation Professionals. Steve's experience with structured innovation resulted in dozens of strategically placed patents with many tens of millions of dollars in licensing value.

Several other strengths set Steve apart to his clients' advantage. Because he served in an in-house position for 17 years, he better understands his clients' challenges, what it takes to make their job easier, and the importance of communicating clearly with both clients and patent examiners. His overseas assignment—managing Motorola's IP activities in Southeast Asia—offers an edge when dealing with non-U.S. patent systems. Steve has also conducted hundreds of interviews with U.S. Patent Examiners, an experience that has given him a solid understanding of the internal challenges and issues faced by examiners.

Steve is a member of Fitch Even's Diversity, Equity, and Inclusion Committee.

## Representative Matters

- Successfully combined various patent prosecution practices (including reissue, continuation, and in-person examiner interviewing practice) to issue a key patent during the course of litigation involving this patent family.
- Successfully prosecuted to issuance dozens of troubled patent applications transferred in from numerous clients. This includes applications with exceptionally long, unfruitful-to-date prosecution histories due to such things as complicated prior art issues, changing legal standards, substandard technical descriptions, and/or strained relations with the patent examiner.
- A major wireless telephony system relied on Steve to lead its comprehensive development of a patent portfolio. Unlike others in the industry, this portfolio successfully resisted all efforts by competitors to market unlicensed compatible offerings and generated tens of millions of dollars in licensing revenue.
- Served in several in-house capacities for Motorola, Inc.:
  - As Vice President, Director of Intellectual Property for Nascent and

### Industries

Artificial Intelligence

Computer Software + Hardware

Electronics

Environmental Engineering

Food + Agricultural Sciences

Internet + E-Commerce

Medical Devices + Diagnostics

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Emerging Technologies and Director of Portfolio Management, Steve was responsible for identifying and crafting strategic patent assets in support of forward-looking business opportunities.

- Steve was on a small team that shortened patent application preparation time while improving quality as measured pursuant to a Six Sigma standard of review—the first-ever corporate team to win Motorola's Total Customer Satisfaction competition, the company's highest award.
- Worked on various patent acquisition issues in a standards-setting context. This includes representing Motorola in meetings of standards-setting bodies and designing the intellectual property curriculum for Motorola University's three-day Standards Development course.

## Presentations + Publications

### Presentations

- "Full Disclosure About Non-Disclosure Agreements," Fitch Even Webinar, with Michael R. Anderson, January 31, 2023.
- "AI Is Coming to an Invention Near You," Fitch Even Webinar, July 21, 2022.
- "Legal Ethics for IP Practitioners: A Cautionary Tale of Professional Irresponsibility," Fitch Even Webinar, December 16, 2020.
- "Where Do Patents Come From?," Idaho First District Bar Association, Coeur d'Alene, Idaho, October 21, 2019.
- "Navigating Open Source Risk with Tools for Usage Evaluation and License Compliance," Fitch Even Webinar, with Joseph F. Marinelli and Amanda Lowerre O'Donnell, February 28, 2019.
- "How to Conduct Patent Searches," University of South Carolina, Columbia, S.C., Feb. 7, 2017; Feb. 1, 2018; Feb. 7, 2019.
- "Provisional Patent Applications," University of South Carolina, Columbia, S.C., Jan. 17, 2017; Feb. 22, 2018; Jan. 31, 2019.
- "Presenting *Alice*-Friendly Patent Claims: Is *McRO* Worth a Second Look?," Fitch Even Webinar, October 25, 2017.
- Featured Interviewee, Fireside Chat, Innovation Collective, Coeur d'Alene, Idaho, July 13, 2016.

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- "Pro Bono Patent Applications," Kootenai County Bar Association, Coeur d'Alene, Idaho, February 29, 2016.
- "So You Think You Know Patent Claims? Advanced Lessons in Patent Drafting and Analysis," Fitch Even Webinar, with Allen E. Hoover, February 25, 2016.
- "Internet of Everything Challenges & Opportunities," 2015 Chicago Inventors Conference, Chicago, Ill., October 10, 2015.
- Opening Remarks—"Patent Minute," Think Big Festival, Innovation Collective, Coeur d'Alene, Idaho, August 21, 2015.
- "Are Abstract Technological Advances Patentable? Go Ask *Alice*," Fitch Even Webinar, with Nicholas T. Peters, July 24, 2014.
- "Patent Application Glossaries, Definitions, and Other Scary Stories," Intellectual Property Law Association of Chicago, Chicago, Ill., April 17, 2014.
- "Business Power: A Briefing on the Effects of IP on Corporate Performance," National Knowledge and Intellectual Property Management Taskforce, June 15, 2012.
- "KSR to the Rescue: A Prosecution Attorneys Guide to Living (and Sometimes Prospering) with KSR," National Association of Patent Practitioners, June 21, 2009.
- "Creating Liquidity and Earnings Through IP Transactions," National Knowledge and Intellectual Property Management Taskforce, June 11, 2008.
- "KSR to the Rescue," Center for Business Intelligence, November 16, 2007.
- "The Perils of Paula: An Introduction to Various Forms of Intellectual Property Protection Including Patents, Trademarks, Copyrights, and Trade Secrets," Intellectual Property Law Association of Chicago, May 24, 2005.
- "RFID, Standards, and Patents: the Real Story," RFID Journal Live: Intellectual Property and RFID, April 10, 2005.
- "Patent Portfolio Management and Asset Acquisition," National Knowledge and Intellectual Property Management Taskforce, December 7, 2004.
- "Debunking Patent Claims," Licensing Executives Society, December 2, 2003.

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- "Mastering Promotion Law Front to Back: Patently Obvious?" Promotion Marketing Association, Inc., June 24, 2002.

### Publications

- Shinsuke Ohnuki, Steven G. Parmelee, and Hideko Yamamoto, *The Essentials of Japanese Patent Prosecution* (Chicago: American Bar Association, 2020).
- "Safeguarding Intellectual Property" in *The Innovation Tools Handbook, Volume 1: Organizational and Operational Tools, Methods, and Techniques That Every Innovator Must Know* (New York: Productivity Press, 2016).
- "What Does the History of Robot Patents Reveal About Our Love of Machines?," The Future of Robotics and AI Series, Virgin.com, June 19, 2015.
- "Intellectual Property for Innovation," with Joseph T. Nabor, in *Global Innovation Science Handbook* (New York: McGraw Hill, 2014).
- "How to Turn White Space Dark for Fun and Profit" in *Business Power: Creating New Wealth From IP Assets* (Hoboken, N.J.: Wiley, 2007).
- *Strategic Patent Portfolio Management* (National Knowledge and Intellectual Property Management Taskforce, 2002).

## Memberships

- Chicago Intellectual Property Alliance
  - Co-Chair Science Fair Committee (2006–17)
- Innovation Collective
  - A Fellow since 2016
- International Association of Innovation Professionals
  - Founding Member (2014–present)
  - Business Essentials Working Group
- National Knowledge and Intellectual Property Management Taskforce (2000–19)

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