



## JOHN FREEMAN **SHAREHOLDER**

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### EDUCATION

J.D.,  
The George Washington University Law School, 1990  
M.S., Physics  
University of Wisconsin, 1983  
B.S., cum laude, Physics  
University of Illinois, 1981

### BAR ADMISSIONS

Illinois  
U.S. Patent & Trademark Office  
U.S. Dist. Court, N.D. Illinois  
U.S. Court of Appeals, Fed. Cir.

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A former U.S. Patent and Trademark Office (“USPTO”) Patent Examiner, John Freeman focuses his practice on patent preparation and prosecution; counseling; licensing; and opinion work, particularly in the electro-mechanical arts. He has extensive experience preparing and prosecuting both domestic and international patents. Clients regularly come to John for opinions regarding patentability and patent validity, as well as potential infringement liability for new products. He has recent experience with the new post-grant review proceedings instituted under the America Invents Act.

With both undergraduate and graduate degrees in physics, John’s technical background gives him a strong foundation for understanding his clients’ innovations. He helps clients think forward by identifying aspects of their inventions they might not have thought to patent, giving them even more protection for valuable, market-leading innovations. A dedicated advocate for his clients before the USPTO, John takes an aggressive approach to achieve the broadest patent protection possible.

Known as a problem-solver around the firm, John has developed a reputation for getting patents in cases that have stalled or run up against roadblocks at the USPTO. He often represents solo inventors who have good ideas but lack the experience needed to draft an effective patent application that will give adequate protection to a commercially viable product. John’s other clients include large international corporations and mid-sized companies. With such a diverse client base, he has developed a broad familiarity with many industries and technologies. As a Patent Examiner, John was responsible for reviewing applications involving the X-ray arts, and has handled a significant amount of work in that area. He also prepares and prosecutes patents for measuring devices that use diffraction principles, laser systems used in eye surgery, other medical equipment, and business processes.

### EXPERIENCE | REPRESENTATIVE MATTERS

- Prepared and prosecuted patent applications regarding clam-shell packages for sandwiches and burgers
- Prepared and prosecuted patent applications regarding machinery used for packaging individual cheese slices
- Prosecuted patent applications regarding meat products designed to be refrigerated and later cooked
- Prosecuted patent applications regarding packaging of liquids, such as wine, for consumer consumption

## Biographies | John Freeman

- Took over the case of a solo inventor of technology involved in laser vision correction that had stalled with the USPTO examiner for technical reasons. After working out the issues, secured a broad patent for the inventor of this next-generation technology
- Achieved broad patent protection for technology with the potential to become an industry standard for cone beam CT imaging
- Secured a broad patent for an innovative device that administers eye drops in the form of mist that does not trigger the blinking reflex and results in more medication being delivered to the surface of the eye

### EXPERIENCE | LEGAL EXPERIENCE

- **Brinks Gilson & Lion**, Chicago, Illinois  
September 1990-Present
- **U.S. Patent and Trademark Office**, Arlington, Virginia  
Patent Examiner, October 1985-May 1990  
Examined U.S. patent applications dealing with inventions which use radiant energy with special emphasis on gamma ray and X-ray inventions, including X-ray lithographic machines and processes.

### EXPERIENCE | NON-LEGAL EXPERIENCE

- **University of Illinois**, Urbana-Champaign, Illinois  
Lab Assistant, Physics Department, January 1981-May 1981

### EXPERIENCE | TEACHING EXPERIENCE

- **Loyola University Law School**, Chicago, Illinois  
Adjunct Professor, September 1991-Present
- **University of Wisconsin**, Madison, Wisconsin  
Teaching Assistant, August 1981-May 1985

### PRACTICE GROUPS

Patent Prosecution  
International Patent  
Post-Grant Patent

### AREA OF FOCUS

Mechanical  
Medical Device

### FORWARD THINKING

#### Alerts

- USPTO Announces Proposed Second Round of AIA Rule Changes, August 20, 2015
- Coalition for Affordable Drugs, September 11, 2015
- Coalition for Affordable Drugs Not Sanctioned by the PTAB , October 05, 2015
- Lee v. Tam: Supreme Court Hears Oral Arguments On Lanham Act Section 2(a) Prohibition of Registration of Disparaging Marks, January 30, 2017
- USPTO Proposes Adopting Phillips Claim Construction Standard For IPRs, PGRs, and CBMs in Effort to Improve AIA Trials and Patent System, May 11, 2018

### HONORS

- Leading Intellectual Property Lawyer, Leading Lawyers Network, Law Bulletin Publishing Company, 2004-2012, 2014-2016

**AFFILIATIONS**

- American Bar Association
- Illinois State Bar Association
- Chicago Bar Association
- American Intellectual Property Law Association
- Intellectual Property Law Association of Chicago

**TECHNICAL BACKGROUND**

- Business Methods