



JOHN G. RAUCH SHAREHOLDER

“I’ve seen a lot of mistakes over the years, solved a lot of problems, and developed a lot of skills. My clients benefit from all of that.”

In his nearly 25-year career as a patent attorney, John Rauch has helped his clients determine what to patent, when to patent, and how to obtain patents as quickly and painlessly as possible. He has worked with companies of every size, from small start-ups to semiconductor and telecom giants, and has worked across a broad spectrum of technologies, with particular experience advising clients in the electronics, software, and biomedical fields.

John helps his clients and inventors move strategically through patent prosecution, beginning with discussions that pinpoint the invention and clarify the scope of the patent application. His article “*What to Patent is a Strategic Question*,” which appeared in *Executive Counsel*, exemplifies the way he thinks forward to help his clients right-size and otherwise manage their patent portfolios.

John tailors his approach to the specific challenges his clients face. For a large semiconductor client, for instance, he conducted “harvesting sessions” to elicit details from the inventors on what was innovative about a particular new chip. In other patent prosecutions, he acts as a fireman, solving problems and making adjustments as necessary to see that an application is allowed. When appropriate, John is a negotiator, bridging communication gaps with patent examiners to ensure successful patent prosecution. At all times, he views his role as problem solver, with each prosecution a puzzle capable of solution.

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EDUCATION

B.S., Electrical Engineering
Purdue University, 1984

J.D., with High Honors
Illinois Institute of Technology,
Chicago-Kent College of Law,
1992

BAR ADMISSIONS

Illinois
U.S. Dist. Court, N.D. Illinois
U.S. Patent & Trademark Office

EXPERIENCE | OVERVIEW

- John advised Yahoo! in its pursuit of a patent relating to the bidding and charging processes for display advertisements on its site. Yahoo was able to license this patent application, generating a royalty stream. He also helped GoTo.com, acquired by Yahoo!, secure a separate patent relating to Internet advertising.
- For Broadcom, John has worked on patent prosecutions involving communications and radio products.
- John successfully executed several appeals to the Patent and Trademark Appeal Board following a patent examiner's rejection of his client's patent applications.
- An electrical engineer by training, John worked two stints at Motorola, first as an integrated circuit designer and later as a patent attorney supporting the company's cellular phone business. His technical expertise covers business methods and software, digital and analog electronics, semiconductors, signal processing, telecommunications and medical devices.

EXPERIENCE | LEGAL

Brinks Gilson & Lione, Chicago, Illinois
1998-Present

Motorola, Inc., Libertyville, Illinois
Patent Attorney, 1995-1998

Foley & Lardner, Chicago, Illinois
Associate, 1992-1995

EXPERIENCE | NON-LEGAL

Applied Micro Circuits Corp., San Diego, California

Cray Research, Inc., Chippewa Falls, Wisconsin

Motorola, Inc., Mesa, Arizona
Integrated Circuit Designer, 1984-1989

EXPERIENCE | TEACHING

Chicago-Kent College Of Law, Chicago, Illinois
Adjunct Professor of Law, August 1994-2001
Mr. Rauch taught a course in Advanced Legal Research in Intellectual Property Law to second and third year law students.

PRACTICE GROUP(S)

- Licensing
- Patent Prosecution
- Post-Grant Patent

TECHNICAL BACKGROUND

- Business Methods
- Digital Electronics
- Semiconductors
- Signal Processing

- Software

FORWARD THINKING

Publications

- What to Patent is a Strategic Question - *April/May 2012*
- The Law of Reverse Engineering - *August, 1993*
- "The Realities of Our Times: the Semiconductor Chip Protection Act of 1984 and the Evolution of the Semiconductor Industry," 3 *Fordham Ent. Media & Intell. Prop. L.F.* (1993) (also published at 75 *J. Pat. & Trademark Off. Soc'y* 93 (February, 1993)). - *February, 1993*

Alerts

- Federal Circuit Finds Visual Memory's Patent Claims Directed to an Improved Computer - *August 22, 2017*
- U.S. Supreme Court to Review the Doctrine of Laches in Patent Cases - *May 19, 2016*
- Defend Trade Secrets Act Signed Into Law - *May 12, 2016*

HONORS

- Leading Intellectual Property Lawyer, Leading Lawyers Network, Law Bulletin Publishing Company, 2010-2016

AFFILIATIONS

- Institute of Electrical and Electronics Engineers
- Intellectual Property Owners Association