

**Arthur Tan-Chi Yuan**  
袁丹吉

**The John Marshall Law School**  
**315 South Plymouth Court**  
**Chicago, Illinois 60604**  
**(312) 994-1106**  
**SSRN page: <http://ssrn.com/author=1551344>.**

**CURRICULUM VITAE**

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**Current Position**

*The John Marshall Law School, Chicago, IL USA*

- Director, Patent Clinic, August 2012 to present
- Director, Chinese Intellectual Property Resource Center, September 2012 to present
- Adjunct Professor, November 2010 to present

Loeb & Loeb LLP, Chicago, IL USA

- Senior Counsel, January 2014 to present

AIPLA Quarterly Journal Editorial Board, 11/2013 – 11/2015

**Courses**

*Clinical or Practice Courses:*

Advanced Patent Clinic	Patent Office Practice
Patent Attorney Opinion	Patent Planning & Practice
Patent Drafting and Examination: (online and in-person at National Chiao Tung University in Taiwan)	

*Substantive law courses:*

Intellectual Property Survey	US Patent Fundamentals
International IP Survey	US Patent Fundamentals and IP Management

**Employment**

Adjunct Assistant Professor, National Chiao Tung University, Hsin-Chu, Taiwan, R.O.C.,  
Fall 2012 to 2015

Executive Director, Chinese Intellectual Property Resource Center of the John Marshall Law School, May 2010 to September 2012

Associate, Senniger Powers, LLP, Saint Louis, Missouri – March 2004 to April 2010

Law Extern, Wallenstein & Wagner, LLP  
Chicago, IL – Fall 2003

Law Clerk, City of Chicago, Department of Law, Building and Land Use Litigation  
Division, Chicago, IL – Summer 2003

Judicial Extern, Honorable Joan B. Gottschall, U.S. District Court, Northern District of  
Illinois, Chicago, IL – Spring 2003

Extern, City of Chicago, Department of Law, Building and Land Use Litigation Division,  
Chicago, IL – Summer 2002 & Spring 2003

Research Assistant, Professor Ronald C. Smith, The John Marshall Law School,  
Chicago, IL – July 2001-December 2003

IT-Specialist & Proofreader, Attorney General's Office, Belmopan, Belize – August-  
December 2000

## **Education**

The John Marshall Law School, Chicago, IL  
Juris Doctor, January 2004

- Communications Editor, THE JOHN MARSHALL JOURNAL OF COMPUTER & INFORMATION LAW, Fall '02 & Spring '03
- Scholarships:
  - Allen H. Schwartz Scholarship, Fall '02;
  - Edith and Philip Bairn Scholarship, Spring '03;
  - Edward D. Rosenberg Memorial Student Aid Award, Fall '03
- Dean's List: Fall 2001, Spring & Fall 2002
- Member of Phi Delta Phi Fraternity

University of Houston, Houston, TX  
Bachelor of Science in Computer Science, 1997-1999  
Member of the Honors College    Minor Mathematics

Georgetown University, Washington, DC  
Edmund A. Walsh School of Foreign Service, 1995-1996

## Publications

### Works in Progress

- Could *TianRui* Decision Make Prior Use Acts In China Become A Defense In A Section 337 Case Even Though Prior Commercial Use Defense Under The AIA Has A Narrower Exception?
- Precedential instability: how CAFC and SCt decisions shape the foundation of the patent law
- Submission priority: how non-US patent watchers can take advantage of the new third party submission section in the AIA
- Hornbook: What does it mean? An introduction to patent claim drafting
- The 5 WH's of the United States Patent Law, upcoming casebook
- Enforcing Patent Rights Against Indian Nations After the AIA, upcoming 2013
- Defining "Standard" legally in Standard Essential Patents, upcoming 2013

### Published works

#### 2013

- *Playing the winning cards in Chinese patent invalidation appeals*, 432-438, *International Patent Law and Policy*, by Bagley, Okediji, and Erstling, WEST Academic Publishing (2013).

#### 2012

- *Exploring Apple's iPad Trademark Blunder: Chinese Trademark Approval Procedure Is A Trademark Protection Safeguard Or Another National Protectionism?*, 11 *J. Marshall Rev. Intell. Prop. L.* 777 (2012).
- *Chinese Court May Compare Yi, Jordan*, *Chicago Daily Law Bulletin*, April 11, 2012, Vol. 158, No. 71.
- *Amendments to Titles of the United States Code by Leahy-Smith America Invents Act*, September 11, 2011, available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1928305](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1928305); updated on April 7, 2012, available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2041599](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2041599).
- *Uniqueness of Patent Terms under the US Patent Law*, *Mysipo Digest*, January 2012, vol. 2, Beijing, China.

#### Pre-2012

- Co-Authored, "Translating China's Struggle with IP," available at <http://www.unboundedition.com/content/view/7538/50>, August 15, 2008;
- Ask the Professional: "Now that I have filed a patent application to protect my invention in the US, what should I do next to protect my invention in other countries?" St. Louis Bus. Journal, Sept. 29, 2006;
- Co-authored, James P. Muraff, et al., *Industry Standards Organization "Requests for Comments" Not As Reliable As Dictionaries And Treaties*, available at <http://web.archive.org/web/20040109155326/http://apl.org/news/actv-v-disney.shtml> (Fall 2003);
- Inside a Judicial Externship, Vo. IV No. 3 JMLS Ctr. for Intell. Prop. L. News Source 22 (Spring 2003)

## **Presentations/Interviews**

### **2015**

Speaker, *The Latest Development of US Patent Law*; Intellectual Property Court, New Taipei City, Taiwan, R. O. C., May 15, 2015.

Speaker, *The Latest Development of US Patent Law*; China Intellectual Property Training Center, Beijing, China, March 19, 2015.

### **2014**

Speaker, *Standard Essential Technology and Patent – the latest development in the US*; China Technology Exchange, Beijing, China, June 19, 2014.

Moderator, IP on the Edge Conference, Patent on the Edge (panelists: The Honorable Richard Linn, Judge, United States Circuit Court for the Federal Circuit; The Honorable James Holderman, Judge, United States District Court for the Northern District of Illinois; Robert Stoll, Drinker Biddle (former Commissioner of Patents); Kevin Noonan, PhD, Partner, McDonnell Boehnan Hulbert & Berghoff LLP), The John Marshall Law School, Chicago, IL, USA, May 2, 2014.

Speaker, *The Latest Development of US Patent Law*; Intellectual Property Court, New Taipei City, Taiwan, R. O. C. January 13, 2014.

### **2013**

Commentator, *The 6<sup>th</sup> Annual Sino-US IP Law Conference: The Latest Updates on Sino-US IP Laws*, China Intellectual Property Training Center, Beijing, China, June 24, 2013

Speaker, *Latest Development of US Patent Law*, Northwest University Law School, Xi'an, Shaanxi Province, China, June 20, 2013

Speaker, *Difference in Definition of "Support" between the US and Chinese Patent Specification*, Patent Reexamination Board, Beijing, China, June 9, 2013

Moderator (for morning session on May 10, 2013), *5<sup>th</sup> Annual BRICS Intellectual Property Conference*, The John Marshall Law School, Chicago, IL, USA, May 9-11, 2013

Opening plenary panelist, *IP in China is not the Wild Wild West*, IP on China: Growth and Opportunities for US Companies – Overview, Congress Plaza Hotel, Chicago, IL, USA, May 2, 2013

Presenter, *Enforcing Patent Rights Against Indian Nations After the AIA*, IP on the Edge: Celebrating World Intellectual Property Day, The John Marshall Law School, Chicago, IL, USA, April 26, 2013

Moderator, *IP Roundtable Discussions on Patent Damages*, The John Marshall Law School, The John Marshall Law School, Chicago, IL, USA, April 22, 2013

Presenter, *United States IP Litigations: US IP Case Law Developments in the Last 20 years*, Celebrating 20<sup>th</sup> Anniversary of Cooperation Between the State Intellectual Property Office and the John Marshall Law School, Friendship Hotel, Beijing, China; sponsored by State Intellectual Property Office of PRC and the John Marshall Law School, April 11, 2013

Presenter, *Trading With China: What You Need To Know*, Offices of SmithAmundsen, Chicago, IL; sponsored by Organization of Women in International Trade, Chicago Chapter (OWIT), SmithAmundsen, and Chinese American Bar Association; February 21, 2013

Presenter, *Webinar – Enforcing Intellectual Property and Copyrights in China*, Chicago, IL; sponsored by Illinois Chamber of Commerce, SmithAmundsen, and Chinese American Bar Association; February 20, 2013

## **2012**

Interviewed by Roy Strom, "AIA fails to corral IP theft by Chinese," Chicago Daily Law Bulletin, Oct. 10, 2012, Vol. 158, No. 199

Interpreter, "Training Courses of High End Intellectual Property Services," Beijing China, August 6-10, 2012

Speaker, "What does AIA mean to Chinese businesses?" Kangxin Partners, P.C., Beijing, China, June 26, 2012

Speaker, "Update on US Patent Practices," Lung Tin International Intellectual Property Agent, Ltd., Beijing, China, June 25, 2012

Co-Presenter, "Hot Issues in Sino-US Intellectual Property Laws", Renmin University International College (Suzhou Research Institute), Suzhou, China, June 15, 2012

Co-Presenter, "Hot Issues in Sino-US Intellectual Property Laws", Nanjing University of Science and Technology, Nanjing, China, June 14, 2012

Speaker, "US Patent Practices", Sunshine Intellectual Property International Co., Ltd., Beijing, China, June 5 & 7, 2012

Speaker, "US Patent Practice and Patent Exchange" Mysipo Forum, Beijing, China, June 3, 2012

Co-Presenter, "What do Chinese IP Professionals Need to Know About the New American Patent Law", King & Wood Mallesons, Shanghai, China, April 17, 2012

Co-Presenter, "What do Chinese IP Professionals Need to Know About the New American Patent Law", China Intellectual Property Training Center, Beijing, China, April 11, 2012

Co-Presenter, "What do Chinese IP Professionals Need to Know About the New American Patent Law", Patent Examination Cooperation Center of the Patent Office, SIPO, Beijing, China, April 9, 2012

Interviewed by Roy Strom, "Jordan Challenges Chinese Company Over Name Use," Chicago Daily Law Bulletin, Feb. 28, 2012, Vol. 158, No. 40

## **2011**

Speaker, "Basics of U.S. Patent Law", PC-Associates, Beijing, China, June 24, 2011

Speaker, "US Patent Practice", CCPIT Patent and Trademark Office, Beijing, China, June 22, 2011

Speaker, "US Patent Practice", Lung Tin International Intellectual Property Agent, Ltd., Beijing, China, June 21, 2011

### **Pre-2011**

Interviewed by Peter Warren, "A Dangerous Domain," Jan. 26, 2006, The Guardian, available at <http://technology.guardian.co.uk/weekly/story/0,,1694495,00.html>;

### **Professional Activities**

#### Admissions:

State of Missouri, 2004 (56,259); Illinois, 2011 (6,305,246)

United States Patent and Trademark Office: 2005-2008 (Limited Recognition L0113); 2008-present (Reg. No. 62,449)

Translated Chinese IP cases from Chinese to English weekly involving at least one non-Chinese entity at <http://chineseip.jmls.edu/sites/en/>

Represent domestic and international clients before the United States Patent & Trademark Office

Prepared and prosecuted U.S. clients' patent applications and prosecuted the client's corresponding foreign (EP, Chinese, NZ, AU, IL, etc.) patent applications relating to electronics, computer systems, software systems and business methods, such as media processing, telecommunication systems, search engines, database structures, operating systems, business management applications, data security and electronic medical devices, mobile devices, online social networks, web mash-up programming

Acted as a virtual in-house counsel for a client reviewing Chinese associates' work

Authored patentability opinions and non-infringement/freedom-to-operate opinions

Advised US clients on Chinese patent law issues

Advised Chinese/Taiwanese clients on US IP laws, patent infringement litigation before US District Court, ITC proceedings, Re-examination proceeding before the USPTO

Practiced appeals before the Board of Patent Appeals and Interferences.

Drafted a bench memorandum construing patent claims in a patent infringement case (Databurst v. CheckFree) and a bench memorandum regarding defendant's motion to transfer venue. The decision in Databurst was appealed to the CAFC and affirmed by the CAFC without an opinion under Rule 37

Prosecuted municipal code violations in Administrative Law Court on behalf of the City of Chicago

Defended administrative review cases in the Circuit Court

Drafted and argued motions at bench trials

Wrote bench memorandums involving administrative law

Researched issues relating to federal money laundering statute

Maintaining the National Criminal Justice Trial Advocacy Competition Web site at [www.abacrimtrial.com](http://www.abacrimtrial.com)

Contracted by Swedish International Services to construct the Belize Legal Information Network (BLIN) as part of the Library of Congress's Global Legal Information Network (GLIN)

Created and designed the BLIN Web site ([www.belizealaw.org/lawadmin/index.html](http://www.belizealaw.org/lawadmin/index.html))

Volunteer:

Peer to Patent

- Reviewed pre-grant publication number 20100257413
- Reviewed pre-grant publication number 20100262918
- Reviewed pre-grant publication number 20100274914
- Reviewed pre-grant publication number 20100275012
- Reviewed pre-grant publication number 20100274876

AIPLA



- Reviewed First Round 2011 Robert C. Watson Writing Essays

**Foreign Language**

Chinese Mandarin (native)