



## Aaron J. Morrow

### Partner

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## OVERVIEW

Aaron Morrow focuses his practice on IP procurement and portfolio management.

He also provides strategic IP counseling, due diligence research and analysis for portfolio acquisitions, and opinion work such as patentability, validity, non-infringement, and freedom-to-operate opinions. His counseling has included IP strategies for development and sale of commercial products, which involves robust IP protection for the commercial product combined with a detailed approach for avoiding infringement of third party IP rights.

Aaron is a PTO-registered patent attorney with a background in biochemistry and biology and experience in all aspects of patent prosecution. His practice involves a broad range of complex technologies with an emphasis in preparing and prosecuting patent applications related to chemistry, biochemistry, food sciences, nutritional compositions, and pharmaceuticals. He also has experience navigating foreign-derived patent applications to allowance in the U.S. Patent and Trademark Office.

His experience teaching laboratory classes and performing substantial scientific research during undergraduate and graduate school allows him to consult and collaborate effectively with clients in the life sciences. Furthermore, during law school he was candidacy editor for the John Marshall Review of Intellectual Property Law where he honed a high level of attention to detail in writing that he uses in corresponding with the PTO.

Aaron regularly publishes and presents on the topic of patentable subject matter, particularly regarding the guidelines issued by the U.S. Patent Office and their implementation by Patent Examiners. He also counsels clients regarding the patent eligibility of life sciences inventions and devises strategies for ensuring the patent eligibility of such inventions.

His strategic counseling also includes trade secret analysis, for example developing procedures for establishing, maintaining and enforcing trade secret protection.

## PROFESSIONAL BACKGROUND

Prior to joining K&L Gates, Aaron worked at an IP boutique focusing on U.S. and foreign patent prosecution in diverse technologies, such as medical devices, multimedia processing and rendering, software, hydrocarbon drilling technology, and programmable cylinders. His work at the IP boutique also involved both U.S. and foreign

trademark matters, including consent agreements and opposition proceedings before the U.S. Trademark Trial and Appeal Board.

During law school, he worked as a clerk and a summer associate at Bell, Boyd & Lloyd, a K&L Gates predecessor firm.

## SPEAKING ENGAGEMENTS

- *Defend Trade Secrets Act*, Annual Meeting of the IP Law Section of the North Carolina Bar, (April 28, 2017)
- *Section 101 Patent Eligibility: The New World of Patentable Subject Matter*, Chicago-Kent College of Law, Sanjay Murthy (Partner, K&L Gates, Chicago), Margaux Nair (Associate, K&L Gates, Chicago), Aaron Morrow (Associate, K&L Gates, Chicago), Professor Joshua Sarnoff (DePaul College of Law), and Professor David Schwartz (Chicago-Kent College of Law), Invited Panelists (November 5, 2014)
- Navigating the USPTO's Guidance on Patent-Eligible Subject Matter for Natural Products, West LegalEdCenter, Thomson Reuters, Morrow, A. and Nair, M., Invited Speakers (June 6, 2014)

## ADDITIONAL BACKGROUND

### EDUCATION

- J.D., John Marshall Law School, 2005 (*magna cum laude*, *Dean's List*, *The John Marshall Review of Intellectual Property Law*)
- M.S., University of Missouri, St. Louis, 2002 (*summa cum laude*; *Biology, Cell Biology emphasis*)
- B.S., University of Dayton, 1997 (*Biochemistry*)

### ADMISSIONS

- Bar of Illinois
- United States Patent and Trademark Office

## THOUGHT LEADERSHIP POWERED BY HUB

- 26 August 2022, No (More) Bites at the mRNA Apple: Pfizer and BioNTech Seek Declaratory Judgment of Noninfringement Relating to Their COVID-19 Vaccine in New Suit
- 9 October 2019, Don't B Late; Federal Circuit Interprets the B Delay Calculation
- 13 May 2019, Federal Circuit Declines to Follow U.S. Patent & Trademark Office § 101 Guidance and Holds Diagnostic Method Patent Claims Invalid
- 20 September 2018, 23andME, INC. v. Ancestry.com DNA, LLC

- 2 July 2018, Round Two: Method of Treatment Claims Survive Another § 101 Challenge – Reargument Denied in *Pernix Ireland Pain DAC v. Alvogen Malta Operations Ltd*
- 31 May 2018, Methods of Treatment Survive Another § 101 Challenge – *Pernix Ireland Pain DAC v. Alvogen Malta Operations Ltd*.
- 2 May 2018, Court Sanctions ANDA Filer for Failing to Disclose Testing Errors
- 2 May 2018, Federal Circuit holds that reissue application of hemodialysis shunt patent impermissibly recaptured surrendered subject matter
- 18 April 2018, The Federal Circuit Addresses Patent Eligibility of Methods of Treatment For First Time Post-Mayo
- April 2018, General Counsel University: Trade Secret Protection, Enforcement, and Risk Management in a Cyberworld
- 19 March 2018, The Federal Circuit Disagrees Over How to Analyze Patent Eligibility
- 16 February 2018, The Master Review Form Provides Insight into How the U.S. Patent & Trademark Office Treats Eligible Subject Matter Rejections under § 101
- 6 August 2017, USPTO Issues Report on Public Views Regarding Subject Matter Eligibility
- 11 July 2017, New Developments in Patent Eligibility of Diagnostic Methods
- 24 May 2016, Abstract Ideas and the USPTO: Examiner Guidance Post *Enfish* and *TLI*
- 11 May 2016, USPTO Clarifies Subject Matter Eligibility Procedure
- 10 May 2016, U.S. Patent Office Issues New Examples of Patent Eligibility Analysis of Life Sciences Claims
- 29 March 2016, Quality, Quantity and Comments: USPTO's New Patent Quality Metrics

## OTHER PUBLICATIONS

- "3 PTAB Cases Offer Guidance For Drafting Method Claims," *Law360*, 15 December 2022
- "Methods For Using Natural Compounds Can Be Patent-Eligible," *Law360*, 6 May 2019
- "How PTAB Applies Mayo To Methods Involving Natural Principles," *Law360*, 6 February 2017
- "A Look at USPTO's New Patent-Eligibility Examples," *Law360*, 16 May 2016
- "A Guide To USPTO Guidance On Patentable Subject Matter," *Law360*, 19 May 2014

## NEWS & EVENTS

- 2 March 2018, K&L Gates Names 34 New Partners Across Global Platform

## AREAS OF FOCUS

- IP Procurement and Portfolio Management

## INDUSTRIES

- Consumer Products
- Digital Health
- Food and Beverage
- Health Care Sector

## REPRESENTATIVE EXPERIENCE

- The client was interested in acquiring the right to a third party's commercial product and also the corresponding patent portfolio. I analyzed the strength of the patent portfolio and performed a detailed freedom-to-operate analysis to determine the product's risk of infringing another party's patent
- The client was interested in acquiring the right to a third party's commercial product and also the corresponding patent portfolio. I analyzed the strength of the patent portfolio and performed a detailed freedom-to-operate analysis to determine the product's risk of infringing another party's patent
- A third party challenged the validity of the client's patent in an Ex Parte Reexamination, and we successfully obtained a decision from the U.S. Patent Office upholding the patent.
- The client had a beverage product that was commercially promising, but a third party had numerous patents in the area and had already sued another entity for patent infringement; we advised the client on patent invalidity, design-around options, and other ways to minimize risk of infringement so that the client is working toward taking the product to market.
- The client has a biomedical device that was the subject of substantial R&D and needed to pursue IP protection as zealously as possible, and we determined which aspects of the device were well suited for patent protection and which aspects were better covered by trade secret.
- The client regarding a robust freedom-to-operate patent analysis in order to proceed in a joint venture with a third party, and we navigated a crowded technology area for them with a formal opinion.
- The client had an electromechanical device that was commercially promising, but a third party had numerous patents in the area and had already sued our client for patent infringement; we advised the client on design-around options and other ways to minimize risk of infringement and enabled the client to confidentially take the product to market.