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Representative Matters

Patents

Preparation and prosecution of utility and design patent applications; infringement litigation; infringement, validity, and right-to-use (freedom-to-operate) studies and opinions; reexamination proceedings; post-grant trial proceedings at the USPTO Patent Trial and Appeal Board (PTAB); appeals to the PTAB and the U.S. Court of Appeals for the Federal Circuit; arbitration.

Trademarks and unfair competition

Trademark application preparation and prosecution; infringement litigation; policing of marks and investigation of unauthorized third party users; proceedings before the Trademark Trial and Appeal Board (appeals, cancellations, and oppositions); false advertising; trade secret counseling; advertising injury insurance coverage.

Copyrights

Copyright registration; infringement litigation; music performance rights (ASCAP, BMI).

Computer software and information technology

Patent, trademark, trade secret, and copyright protection; website and software development agreements, and related litigation; corporate software protection audits and plans.

Licensing and agreements

Patent, know-how, trademark, copyright, computer software, and music license agreements and related contracts; non-disclosure agreements.

Antitrust

Predatory pricing; distribution and dealer termination issues; monopolization; intellectual property antitrust; industry standards; litigation.

International trade

Patent infringement proceedings before the U.S. International Trade Commission; economic injury under 19 U.S.C. § 1337 (prior to and since the passage of the Omnibus Trade and Competitiveness Act of 1988); export licensing and controls (ITARs).

Employment agreements

Preparation of employment, invention assignments, and non-compete agreements; exit interviews.

Government contracts

Patent and data rights.

Industries Served

- aeronautical and aircraft
- automotive
- broadcast and media
- computer hardware and software
- electronics
- fashion and jewelry
- finance and insurance
- food; baking
- industrial machinery and tools
- Internet; website and application development
- medical, dental, and healthcare
- pharmaceutical
- photographic
- semiconductor
- sports
- telecommunications and wireless
- toy and collectibles

Representative Technologies

- analog and digital circuitry
- artificial intelligence
- avionics and radar
- broadcasting (AM/FM/TV; CATV/cable)
- communications (HF, VHF, UHF; land mobile radio)
- computer hardware and software; mobile device apps
- digital display systems and image processing
- digital signal processing
- electromechanical control systems
- food and bakery production
- healthcare products and medical electronics
- Internet, hosting, website development (HTML, CSS)
- navigation systems
- open source software (Linux OS, Apache server)
- optoelectronics and digital display systems
- pollution control systems
- semiconductor technology (process, architecture, and circuitry)
- telephony and wireless

Education

J.D., 1978, University of Miami, Coral Gables, Florida
B.S.E.E., 1975, Lafayette College, Easton, Pennsylvania

Bar Admissions

Member of the District of Columbia, New Jersey, and New York Bars.
Admitted to practice before the U.S. Patent and Trademark Office.

Prior Affiliations

Patent Examiner, U.S. Patent and Trademark Office, Washington, D.C.
The Singer Company, Kearfott (Aerospace) Division, Little Falls, N.J.
Weil, Gotshal & Manges, New York, N.Y.

Associations and Leadership Positions

Fellow, American Bar Foundation (New York State chapter).

Chair, Legal Activities, Institute of Electrical and Electronics Engineers,
North Jersey Section, 2012–date.

Chair, *Inter Partes* Review Subcommittee, USPTO Affairs (Post Grant and
Inter Partes) Committee, ABA Section of IP Law, 2011–2013.

Co-Chair, Patents and Legislative Affairs Subcommittee, Electronic and Computer
Law Committee, AIPLA, 2008–2012.

Chair, Patentable Subject Matter Subcommittee, Software and Cloud Computing
Committee, ABA Section of IP Law, 2008–2011.

Co-Chair, § 101 Subcommittee of the Patent Law Committee, AIPLA, 2009–2011.

Member, Task Force Subcommittee on Business Method Patents, 2009–2010.

Master, Essex Inn of Court, Justice William A. Brennan, Jr. Chapter, Newark, N.J.,
American Inns of Court (1997–2000).

International Trademark Association (Project Editorial Board, 1997–1999).

Chair, Computer-Related Law Committee, N.J. State Bar Assoc., 1993–1995.

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National Institute on Appellate Advocacy (ABA), 1984.

Diploma, National Institute for Trial Advocacy, Mid-Atlantic Regional, 1983.

Recent Articles and Publications

The Patent Trial and Appeal Board: Advocacy and Practice, Second Edition (2017) (book).

The Patent Trial and Appeal Board: Advocacy and Practice (2013) (book).

Current Developments at the PTAB — The USPTO Patent Trial and Appeal Board (2012–date), at www.joelmillerlaw.com/ptab.shtml.

Patent Appeals at the USPTO: Appellate Advocacy and Practice (2012) (book).

Appellate Advocacy and Practice before the USPTO Board of Patent Appeals and Interferences: How to draft a persuasive and compliant appeal brief under the new ex parte rules, American Intellectual Property Law Assoc. (online program), Jan. 18, 2012.

Appellate Advocacy and Practice before the USPTO Board of Patent Appeals and Interferences: How to draft a persuasive and compliant appeal brief, N.J. Intellectual Property Law Assoc. Electronics, Telecom, and Software Patent Practice Update (2011). An earlier version of this paper was presented at the American Intellectual Property Law Assoc. 2011 Annual Meeting.

What you have to prove at the PTO: Burdens of proof during patent examination and standards of review during appeal to the BPAI and the courts, ABA Section of Intellectual Property Law 26th Annual Intellectual Property Law Conference (2011).

The PTO Board of Patent Appeals and Interferences: Appellate Advocacy and Practice (2010) (book).

Current Developments at the BPAI — The PTO Board of Patent Appeals and Interferences (2010–2011).

Foreign Filing Licenses, Secrecy Orders, and Export Controls: USPTO Procedures and the International Traffic in Arms Regulations (ITARs), American Intellectual Property Law Assoc. 2009 Annual Meeting.

Current Developments in Patentable Subject Matter under 35 U.S.C. § 101 — in the Courts and at the PTO (2009–12).

Summary Outline of Post-Bilski Opinions on Subject-Matter Eligibility (2009).

Federal Circuit Selects a Machine-or-Transformation Test for Determining Patent Subject-Matter Eligibility, in *ABA Section of Intellectual Property Law, Annual Review of Intellectual Property Law Developments 2006–2008*, 66–73 (2009).

Claim Construction at the PTO — The “Broadest Reasonable Interpretation...”, 88 J. Pat. & Trademark Off. Soc. 279–96 (March 2006).

Programs and Presentations

“Patents and technology: Managing protection for your products,” IEEE Technology Management Council and MTT/AP-Society, Paterson, N.J., May 8, 2013.

“How the courts ruled in 2012 and how it may affect your practice,” presentation to a corporate intellectual property legal department, Jan. 23, 2013.

“Patent Law for Engineers: How to safeguard your idea,” IEEE MTT-Society & AP-Society Joint Chapter 27th Annual Symposium, East Hanover, N.J., Oct. 4, 2012.

“Intellectual Property: Protecting the fruits of your labor,” IEEE/ACM Information Technology Professional Conference, Ewing Township, N.J., Mar. 9, 2012.

“Don’t Lose Your Appeal! Learn about the New Ex Parte Rules,” American Intellectual Property Law Assoc. (online program), Jan. 18, 2012.

“Appellate Advocacy and Practice before the USPTO Board of Patent Appeals and Interferences: How to draft a persuasive and compliant appeal brief,” N.J. Intellectual Property Law Assoc. Electronics, Telecom, and Software Patent Practice Update, New Brunswick, N.J., Nov. 9, 2011; also presented at the American Intellectual Property Law Assoc. 2011 Annual Meeting, Washington, D.C., Oct. 2011.

“What you have to prove at the PTO: burdens of proof during patent examination and standards of review during appeal to the BPAI and the courts,” ABA Section of Intellectual Property Law 26th Annual Intellectual Property Law Conference, Arlington, Virginia, April 2011.

“The U.S. Supreme Court’s Decision in *Bilski v. Kappos*: The ongoing controversy over what may be protected by a patent and the broader implications of the debate,” N.J. State Bar Assoc., Internet & Computer Law Committee, New Brunswick, N.J., Jan. 20, 2011.

“What to do about Section 101?,” American Intellectual Property Law Assoc. 2010 Annual Meeting, Washington, D.C., joint meeting of the Education, Patent Law, and Patent Litigation Committees, Oct. 22, 2010 (speaker, moderator, and organizer).

“Anatomy of an Infringement Claim: Analyzing and Responding to a Letter Asserting Trademark or Patent Infringement,” an interactive workshop, ABA Section of Intellectual Property Law 25th Annual Intellectual Property Law Conference, Arlington, Virginia, April 2010.

“Foreign Filing Licenses, Secrecy Orders, and Export Controls: Pitfalls for the Unwary,” American Intellectual Property Law Assoc. 2009 Annual Meeting, Washington, D.C., Oct. 15, 2009.

Programs and Presentations (cont'd)

“Anatomy of a Trademark Infringement Claim: Analyzing and Responding to a Claim Letter,” an interactive workshop, N.J. Trademark Counsel, Basking Ridge, N.J., Sept. 30, 2009.

“Patentable Subject Matter after *In re Bilski*,” ABA Section of Intellectual Property Law 24th Annual I.P. Law Conference, Arlington, Virginia, April 2009.

“*In re Bilski* - Is your client’s method of doing business patentable?,” N.J. State Bar Assoc., Internet and Computer Law Committee, New Brunswick, N.J., Jan. 14, 2009.

“International Intellectual Property,” Nat’l Contract Management Assoc., Montclair, N.J., Nov. 18, 1998.

“Website Development Agreements: Allocating Rights and Obligations,” N.J. State Bar Assoc. 1998 Annual Meeting, Atlantic City, N.J., May 15, 1998.

“Justice and Jurisdiction along the Information Highway: Does the Internet have a Long Arm?,” Trademark Luncheon Club, West Orange, N.J., Oct. 9, 1996, and 1997 N.J. State Bar Assoc. Annual Meeting, Atlantic City, N.J., May 16, 1997.

“Computer Law: Substantive Legal Issues and Jurisdiction,” 1996 N.J. State Judicial College, Teaneck, N.J., Nov. 26, 1996.

“Patent Protection for Computer Software: Has Anything Changed at the Patent Office?,” N.J. State Bar Assoc., Computer-Related Law Committee, New Brunswick, N.J., Mar. 30, 1995.

“Insurance Coverage for Intellectual Property Disputes: Relief for Beleaguered Defendants,” Trademark Luncheon Club, West Orange, N.J., Nov. 9, 1994.

“Copyright Basics — A Brief Overview of Copyright Law as it relates to Computers and Computer Technology,” N.J. State Bar Assoc. 1994 Annual Meeting, Atlantic City, N.J., May 14, 1994.

Program Chair, ABA/USTA National Institute on Trademark Trial Advocacy, Tarrytown, N.Y., June 1993.

Program Chair, “Protecting the Computer Environment: Database Privacy and Computer Facility Security,” N.J. State Bar Assoc. Computer-Related Law Committee, New Brunswick, N.J., Feb. 25, 1993.

Program Chair, ABA National Institute on Trademark Trial Advocacy, Boston, Nov. 1986.

Program Chair, ABA-AIPLA National Institute on Patent Trial Advocacy, Washington, D.C., Nov. 1984.