



Thomas Kelton

Partner

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PRACTICES Intellectual Property, Patents, Patent Prosecution and Counseling, Patent Office Trials, Streaming Media

Thomas Kelton focuses his practice on complex and disputed matters, with special emphasis on United States Patent Office (USPTO) patent invalidation procedures such as reexamination and *inter partes* review (IPR). He serves as a trusted advisor to numerous large and mid-sized companies as they navigate their way through the complexities of the USPTO, where he recently led a project to invalidate more than 15 patents in a contested procedure, achieving great results and allowing his client to negotiate a favorable settlement in infringement litigation.

Thomas works closely with clients to understand their specific IP needs, and has extensive experience managing large patent portfolios, procuring intellectual property rights, and licensing intellectual property in mergers and asset purchase deals. He currently represents a variety of clients in telephony, microelectronics, electronic commerce, and data storage industries.

In addition to his practice, Thomas is active in his community and Bar Associations. During 2014-2015, he led the Patent Committee of the State Bar of Texas, working to keep other attorneys informed and engaged in developments in patent practice after implementation of the America Invents Act. Thomas is also an active leader in the Knights of Columbus Council 799, a century-old council with more than 1,500 members in Dallas. He recently led a team of 30 other members of his council in a two-weekend-long community home repair project in association with Hearts and Hammers Dallas, replacing siding and plumbing and performing exterior renovation on a home.

Professional and Community Activities

- Council, State Bar of Texas IP section (2017-present)
- Chair, Patent Committee, State Bar of Texas IP Section (2014–2015)
- Dallas Bar Association
- Texas Aggie Bar Association

Professional Recognition

- Recognized in *Best Lawyers in America*, Woodward/White, Inc., for Litigation - Intellectual Property, Trademark Law, 2019-2021
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QUALIFICATIONS

EDUCATION

- B.S., Electrical Engineering, Texas A&M University, 2000, *cum laude*
- J.D., University of Texas School of Law, 2003

ADMISSIONS

- Texas
 - U.S. Patent and Trademark Office
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PUBLICATIONS AND SPEAKING ENGAGEMENTS

- "Patent Prosecution Strategies and Ethics," presenter, Dallas Bar Association, March 11, 2020.
- "Where are we on IPRs? A Review of the Updated Trial Practice Guide, Claim Construction, and Federal Circuit Decision", co-presenter, Dallas Bar Association IP Section meeting, Dallas, Texas, September 26, 2019.
- "Advocacy Before the PTAB," moderator, 32nd Annual State Bar of Texas Advanced Intellectual Property Law Course, Dallas, Texas, March 1, 2019.
- "Tips and Tricks To Help Avoid (or Survive) IPR Proceedings," presenter, AIPLA CLE Webinar, January 16, 2019.
- "Current Climate Driving Patent Prosecution Practices," panelist, [USPTO 2018 Customer Partnership Meeting in conjunction with AIPLA](#), May 2, 2018.
- "Patent Drafting – Claiming Strategies for 2018 and Beyond," presenter, 55th Annual Conference on Intellectual Property Law, Institute for Law and Technology, November 14, 2017.
- "[PTAB Ethics: A Discussion of Evolving Case Law on Real Party Interest](#)," presenter, 30th Annual Advanced Intellectual Property Law Course, TexasBarCLE, February 23-24, 2017.
- "Ethical Landscape in PTAB Practice," presenter, Dallas Bar Association – IP Section, CLE Meeting, June 24, 2016.
- "[PTAB Ethics](#)," presenter, 29th Annual Advanced Intellectual Property Law Course, February 18-19, 2016.
- "The Intersection of IPR and Patent Drafting: Tips To Increase Chances of Surviving Validity Challenges," presenter, Dallas Bar Association – IP Section, CLE Meeting, September 25, 2015.
- "Post-Issuance Proceedings Under the AIA," presenter, State Bar of Texas Annual Meeting, June 19, 2015.
- "8 Tips for Drafting And Prosecuting Patents To Avoid IPR," author, *IP Law360*, June 1, 2015.
- "Ethics and the Post-AIA Patent World," presenter, 2015 Spring Symposium, The Tennessee Intellectual Property Law Association, May 2015.
- "Ethics in the Post-AIA World," presentation at the State Bar of Texas Advance Intellectual Property Law Course, March 2015.
- "The First Sale Doctrine and Patent Exhaustion: The Supreme Court's View on Exercising Control After a Sale," co-author with Hamilton Simpson, *State Bar of Texas Intellectual Property Law Section Newsletter*, Winter 2013-2014.
- "The First-Sale Doctrine and Patent Exhaustion: The Supreme Court's View on Exercising Control After a Sale," presentation to IP Section of Dallas Bar Association, July 2013.
- "Intellectual Property," guest Lecture to Entrepreneurship 3301 at University of Texas at Dallas, Jindal School of Business, June 2013.
- "Evolution of Patent-Eligible Subject Matter After Bilski," author, *Intellectual Property Today*, May 2011.

- “On-Sale Bar Issues Arising in the Representation of R&D Labs,” co-author with Huyen Luong, *Intellectual Property Today*, January 2010.
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PROFESSIONAL AFFILIATIONS AND ENGAGEMENTS

- Judge, 2022 USPTO Patent Application Drafting Competition
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SELECTED CLIENT REPRESENTATIONS

- Overseeing reexamination and *Inter Partes* Review proceedings in the USPTO for highly contested patents covering fundamental technology and highly commercially successful technology
- Advocating for clients in-person at the Board of Patent Appeals and Interferences at the USPTO
- Preparing and prosecuting domestic and international patents in the radio frequency, telephony, micro-electronics, electronic commerce, computer, optics, antenna, radar, and hydrocarbon production arts
- Conducting an interference proceeding in the USPTO, including putting on the case in chief and drafting motions, for determination of inventorship for advanced security technology
- Participating in technology acquisition projects in association with corporate mergers and deal structuring, including the transfer of a large patent portfolio
- Drafting technology licenses, technology transfer agreements, and secured debt agreements in the fields of communications, electronic commerce, software development, and banking
- Performing validity and infringement analysis for complex electrical and software cases