



Joseph Matal

Partner

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PRACTICES Intellectual Property, Patent Office Trials, Trademark and Advertising, Technology Transactions

Joseph Matal is a partner in the Intellectual Property Practice Group in the Washington, D.C. office of Haynes and Boone, LLP.

Joe has served as both the U.S. Patent and Trademark's Acting Director and Acting Solicitor. As Acting Solicitor, he defended the agency in intellectual property cases before the U.S. Court of Appeals for the Federal Circuit and U.S. Supreme Court. In his role in the Solicitor's Office, he participated in briefing almost every major case involving PTAB trials that has come before the Federal Circuit, including cases that have defined the Board's powers and the evidence that it may consider, the content of final decisions, and the burdens and scope of motions to amend. Recent cases include *Uniloc v. Hulu*, *Thryv v. Click-to-Call*, and *Aqua Products v. Matal*. Previously, Joe served in senior legal roles for more than a decade for the U.S. Senate Judiciary Committee. In that capacity, he negotiated and drafted many of the key provisions of the America Invents Act.

In his roles at the USPTO, Joe briefed and argued numerous appeals of patent and trademark decisions before the Federal Circuit; oversaw the management of the USPTO and its 13,000 employees; and advised the U.S. Solicitor General's Office in key IP cases before the Supreme Court.

His practice focuses on USPTO post-issuance proceedings and Federal Circuit appeals.

QUALIFICATIONS

EDUCATION

- J.D., University of California Berkeley School of Law, 1996, Order of the Coif; Articles Editor, *California Law Review*
- B.A., Stanford University, 1993

CLERKSHIPS

- Law Clerk to the Honorable William C. Canby, Jr., U.S. Court of Appeals for the Ninth Circuit, 1997-98
- Law Clerk to the Honorable Jay A. Rabinowitz, Alaska Supreme Court, 1996-97

LANGUAGES

- French
- Czech

ADMISSIONS

- U.S. Patent and Trademark Office (inter partes cases only)
- District of Columbia

COURT ADMISSIONS

- U.S. Court of Appeals for the Federal Circuit
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PUBLICATIONS AND SPEAKING ENGAGEMENTS

- "Patent Eligibility: Has the Supreme Court and Federal Circuit Struck the Right Balance?" Panelist, Artificial Intelligence Masters™ 2023 Program, IP Watchdog, March 7, 2023.
 - "PTAB Ruling Shows Need To Split Terminal Disclaimer," co-author, *Law360*, May 26, 2022.
 - "Arthrex: The Future of Director Review & Corresponding Litigation Strategy," speaker, Annual Berkeley-Stanford Advanced Patent Law Institute, Stanford, CA, September 10, 2021.
 - "[The PTAB's Post-Arthrex Future](#)," *World IP Review*, July 2021.
 - "[Why the USPTO Does not Receive Chevron Deference](#)," *The Patent Lawyer*, May/June 2021.
 - "[Jury Trials are not an Adequate Substitute for Patent Validity Review at the PTAB](#)," Thomson Reuters Westlaw Today, April 2021.
 - "[The Three Types of Abstract Ideas](#)," 30 Fed. Cir. B.J. 87 (2021).
 - "[A Guide to the Legislative History of the America Invents Act: Part I of II](#)," 21 Fed. Cir. B.J. 435 (2012).
 - "[A Guide to the Legislative History of the America Invents Act: Part II of II](#)," 21 Fed. Cir. B.J. 539 (2012).
 - "The Road to the Adoption of the First Inventor to File System," Keynote Speaker, Patent Information Users Group, Alexandria, Virginia, May 2018.
 - "New Developments in Patent and Trademark Practice," Keynote Speaker, Rocky Mountain IP & Technology Law Institute, Denver, Colorado, May 2018.
 - "Limits on Serial Petitions and Other Changes to PTAB Practice," Keynote Speaker, Biotechnology Industry Organization, New Orleans, Louisiana, April 2018.
 - "Management of PTAB Trials," Luncheon Speaker, Advanced Patent Law Institute, Alexandria, Virginia, March 2018.
 - "USPTO Update," Keynote Speaker, Intellectual Asset Mgmt., Washington, D.C., November 2017.
 - "Adapting to PTAB Challenges to Patent Validity," Keynote Speaker, INTERPAT, Washington, D.C., Nov. 2017.
 - "New Policy and Legal Developments in Patent Law: the View from USPTO," Keynote Speaker, Georgetown Institute for Technology Law & Policy, Washington, D.C., November 2017.
 - "USPTO Update on Decisions at the Federal Circuit and the PTAB," Keynote Speaker, AIPLA, Washington, D.C., October 2017.
 - "The State of Patent and Trademark Law, Keynote Speaker," Intellectual Property Owners Assoc., San Francisco, California, September 2017.
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AWARDS AND RECOGNITIONS

HAYNES BOONE

- Recognized by *Managing IP Magazine*, Euromoney Legal Media Group, as a highly recommended "IP Star," 2021-2022
- Recognized for "Trademarks: Non-Contentious (including Prosecution, Portfolio Management and Licensing)", *Legal 500*, 2021
- U.S. Department of Commerce Bronze Medal Award, for revisions to the USPTO's patent subject matter eligibility guidance, August 2018
- U.S. Department of Commerce Bronze Medal Award, for support of the USPTO's role in ongoing patent-reform legislative efforts, August 2018