

USPTO STUDY ON PATENT PRO BONO PROGRAM: LISTENING SESSION FOR PATENT LAWYERS AND AGENTS

WEDNESDAY, JUNE 7, 2023



Derrick Brent

**Deputy Under Secretary of Commerce for
Intellectual Property and Deputy Director of the
United States Patent and Trademark Office**

Derrick Brent is the Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office (USPTO). He serves as the principal advisor to Kathi Vidal, Under Secretary of Commerce for Intellectual Property and Director of the USPTO, for one of the largest intellectual property (IP) offices in the world, with more than 13,000 employees and an annual budget of more than \$4 billion.

Deputy Director Brent has served in all three branches of the federal government and the private sector. He clerked for the Hon. Algenon L. Marbley, Chief Judge of the U.S. District Court for the Southern District of Ohio, and served for six years as a Senior Trial Attorney at the U.S. Department of Justice, Civil Rights Division, where he received a Special Achievement Award for his trial work. Also, he served as a Chief Counsel in the U.S. Senate, where handled IP issues along with other areas such as constitutional law, civil rights, and judicial nominations.

Deputy Director Brent's experience in the private sector includes serving as Vice President/Associate General Counsel for Masimo, on the leadership team at Cut Golf, and as an engineer at General Motors.

Deputy Director Brent received a Bachelor of Science degree in mechanical engineering from The Ohio State University and a Juris Doctor degree from the Northwestern University School of Law (now the Northwestern University Pritzker School of Law).



David L. Berdan

General Counsel

As United States Patent and Trademark Office's (USPTO) General Counsel, David L. Berdan serves as the principal legal advisor to the Under Secretary of Commerce for Intellectual Property and Director of the USPTO. Mr.

Berdan also supervises the Office of General Counsel and its three component offices: the Office of the Solicitor, the Office of General Law, and the Office of Enrollment and Discipline.

Mr. Berdan is a graduate of the U.S. Military Academy at West Point, where he earned a Bachelor of Science in engineering and co-captained the Army football team as a defensive back. He is a combat veteran of Operation Desert Storm and is the recipient of numerous military awards, including a Bronze Star. Mr. Berdan has a Juris Doctor from Drake University Law School, where he was a founding member and President of the Drake Intellectual Property Law Society.

Over the past 26 years, Mr. Berdan has served in a variety of important legal positions, including as Patent Counsel at Corning, Inc., as Vice President and Intellectual Property Counsel at The Coleman Company, as Chief Counsel Intellectual Property at INVISTA, as Vice President Legal and Deputy General Counsel at International Game Technology, and, most recently, as General Counsel and Compliance Officer of Gaming Arts. Mr. Berdan also spent two years as an engineer and seven years in private law practice.



James Silberman

Senior Counsel for Enrollment and Intellectual Property Legal Services Office of Enrollment and Discipline

James M. Silberman is USPTO's Senior Counsel for Enrollment and Intellectual Property Legal Services in the Office of Enrollment and Discipline. He leads a team of attorneys that is responsible for all aspects of enrollment to practice before the USPTO, including development of the registration examination to measure an

applicants' knowledge of patent law and practice. He also is responsible for oversight and management of the USPTO Patent Pro Bono and Law School Clinic Certification Programs. Mr. Silberman is also responsible for Office of Enrollment and Discipline rulemaking and other non-disciplinary matters.

Prior to becoming Senior Counsel, Mr. Silbermann was a staff attorney in the Office of Enrollment and Discipline handling enrollment and discipline matters and also supervising the Law School Clinical Certification Program. Before joining USPTO in 2005, Mr. Silbermann worked at the law firm of Dickstein Shapiro Morin & Oshinsky LLP in Washington, D.C. and the Washington, DC office of Foley & Lardner LLP, where he specialized in intellectual property acquisitions, patent litigation and prosecution, and client consultation.

Mr. Silbermann received his B.S. degree in Chemical Engineering from the University of Maryland, College Park, and his J.D. degree, magna cum laude, from the Catholic University of America, Columbus School of Law, where he was an editor of the Journal of Contemporary Health Law and Policy.



Kimberly C. Kelleher

Attorney Advisor for the Office of Enrollment and Discipline

Kimberly C. Kelleher joined the United States Patent and Trademark Office in October 2012 as an Attorney Advisor in the Office of Enrollment and Discipline. As an Attorney Advisor, Ms. Kelleher investigates grievances alleging misconduct by practitioners, evaluates applications and conducts moral character investigations of applicants requesting registration before the USPTO, and assists with outreach to USPTO stakeholders. Prior to joining the USPTO, Ms. Kelleher engaged in the private practice of intellectual property law with a general practice law firm in Washington DC, worked as a high school biology and research teacher in New York and was a research scientist in a neurobiology lab. Her private practice focused primarily on counseling clients on intellectual property matters, patent procurement and patent portfolio management, drafting patentability, freedom to operate, validity and non-infringement opinions, and licensing of IP rights. She received a Bachelor's degree in Biology from the University of Virginia, a Master's degree in Physiology and Biophysics from Georgetown University and a Juris Doctor degree from Fordham University. She is admitted to the New York and Washington DC bars.



Janet Gongola

Vice Chief Judge for Engagement at the Patent Trial and Appeal Board

Janet Gongola manages internal and external engagement on behalf of the PTAB, including development of educational programs and PTAB

procedures and rules. She was appointed to the PTAB in October 2016. Before joining the Board, Judge Gongola was the Senior Advisor to the Under Secretary and Director of the USPTO where she advised on all matters of law and policy.

Judge Gongola also served as the Patent Reform Coordinator and managed the agency's implementation of the America Invents Act. She likewise was the Associate Commissioner for Patent Examination Policy and developed patent policy for the agency. Judge Gongola started her USPTO career as an Associate Solicitor providing legal advice to agency officials and defending decisions of the Patent Trial and Appeal Board before the U.S. Court of Appeals for the Federal Circuit and district courts.

Before joining the USPTO, Judge Gongola served as a law clerk for the Honorable Paul R. Michel at the U.S. Court of Appeals for the Federal Circuit and for the Honorable Judge Sue L. Robinson at the U.S. District Court for the District of Delaware. In addition, Judge Gongola worked as a patent attorney, patent agent, and research chemist at Eli Lilly and Company in Indianapolis, Indiana.

Judge Gongola graduated summa cum laude from Indiana University School of Law, and she received B.S. degrees in Chemistry and Mathematics from Muskingum University.

Judge Gongola is a past President of the Giles S. Rich American Inn of Court and has taught as an adjunct professor at the George Mason University School of Law and the George Washington University Law School.



Jim Patterson

Principal at Patterson Thuente IP; Chair of Pro Bono Advisory Council

Jim Patterson is the principal and founder of Patterson Thuente IP, a leading intellectual property law firm located in Minneapolis Minnesota. Patent pro bono (PPB) got its start over a decade ago through Jim's leadership in launching PPB's pilot program in his home state of Minnesota. Since then, Jim has been instrumental in achieving PPB's 50 state coverage. Internationally, Jim continues his leading role in the creation and ongoing expansion of the international patent pro bono program managed by the World Intellectual Property Organization's Inventor Assistance Program, an initiative undertaken in conjunction with the World Economic Forum. As an attorney, Jim has 30-plus years of experience in all elements of intellectual property prosecution, whether it be patents, trademarks or copyright, and even in litigation. He has spent his legal career helping companies and individual inventors protect and profit from their intellectual property.



Warren Tuttle

Open Innovation Director - MarketBlast; PBAC Board Member

Warren Tuttle is the Open Innovation Director for MarketBlast, the premier platform for submitting new, unique & innovative products directly to leading companies (www.marketblast.com). Warren also oversees the Open Innovation product programs for publicly traded Lifetime Brands in the housewares and table top arenas (Farberware, Kitchen Aid and 40 other brands) and Merchant Media in the DRTV space (Smart Spin, True Touch). For many years he also helped Techtronic Industries (Ridgid and Ryobi power tools) in a similar role. Warren has been behind the launch of many highly successful consumer products including MISTO, The Gourmet Olive Oil Sprayer, The SmartSpin Storage Container System, Food Huggers, The Odor Absorbing Splatter Screen and The Optical Knife Sharpener. Warren personally interacts with many thousands of inventors every year and has initiated over 100 new consumer product licensing agreements that have collectively generated over a billion dollars in retail sales. Warren is also a well-known advocate for inventor rights. He served for 12 years as the President of the United Inventors Association, a national

501c3 non-profit with high ethical standards that helps support inventors through education, advocacy and the sponsorship of inventor booth pavilions at several industry trade shows, most notably the National Hardware and Housewares Shows. Warren also serves as a board member of both the National Pro Bono Patent Advisory Council (PBAC) and the Department of Commerce's Council for Inclusive Innovation (CI2). Additionally, he co-chairs the Creators Committee for the United States Intellectual Property Alliance (USIPA). Warren's book, *Inventor Confidential: The Honest Guide to Profitable Innovation*, is published by Harper Collins and available on Amazon. He lives with his wife Lynn in Southern Connecticut and has three wonderful daughters, all well-educated and pursuing exciting careers. He enjoys skiing, motorcycling, golf and travel.



Deborah Miron

Executive Director – Federal Circuit Bar Association

Ms. Miron brings to the FCBA a wealth of legal and managerial experience through a long, distinguished career as judge, executive, litigator, and dedicated public servant for the United States Government. From 2002-2020, she served as Director of Regional Operations and Chief Administrative Judge of the United States Merit Systems Protection Board (MSPB), whose primary reviewing court is the United States Court of Appeals for the Federal Circuit. In that capacity, she had legal and supervisory oversight of the agency's regional offices, where more than 60 Administrative Judges are charged with hearing and issuing decisions in over 5,000 federal employment appeals each year. She also coordinated the agency's Mediation Appeals Program. She was appointed a member of the Advisory Council for the United States Court of Appeals for the Federal Circuit.

Previously, Ms. Miron served as Deputy Assistant General Counsel (Manpower and Reserve Affairs) for the Department of the Navy, where she was a senior legal advisor on military and civilian personnel issues in the Pentagon, and supervised 19 legal offices in the United States, Europe, and the Middle East. She held prior positions of increasing supervisory responsibility within the Department, and was appointed Counsel to the Standing Committee on Opportunities for Military and Civilian Women in the Navy.

Earlier in her career, Ms. Miron was a civil trial litigator in federal and local courts on behalf of the District of Columbia, supervisory attorney of a law students in court program, and attorney for the United States Commission on Civil Rights. She received her B.A. magna cum laude from

the State University of New York at Buffalo, where she was elected to Phi Beta Kappa, and from which she also received her J.D. She was a Senior Executive Fellow at the John F. Kennedy School of Government at Harvard University, and selected as a member of the Senior Executive Service of the United States of America.

Ms. Miron is the recipient of numerous awards including MSPB's highest honor, the Theodore Roosevelt Award. She received the U.S. Attorney for the District of Columbia's Justice for Victims of Crime Award, presented to her by former United States Attorney General Eric Holder, for extraordinary assistance to her employee who was the victim of stalking and violent assault, that enabled the Department of Justice to prosecute the stalker and saved the life of the victim. Ms. Miron was made an Honorary Tailhooker by virtue of having catapulted off a U.S. Navy carrier. She received the Navy Superior Civilian Service Award and twice received the Navy Medal for Meritorious Civilian Service.



Rodney Rothwell

Partner - Kilpatrick Townsend

Rodney Rothwell is a registered patent attorney with more than 15 years of experience in patent procurement, client counseling, and portfolio development and enforcement, primarily at the intersection between biology and software. Mr. Rothwell has counseled a diverse set of clients including individual inventors, start-ups, and small- mid- and large-sized companies, including

Fortune 500 companies in a wide range of technologies with an emphasis on bioinformatics/computational biology and artificial intelligence technologies.

Representing a leading healthcare company in intellectual property related services, including patent prosecution. Technologies include bioinformatics/computational biology; pharmaceuticals; diagnostics; clinical trial services; digital pathology; and biotechnology.

Representing a leading clinical laboratory services provider in intellectual property related services, including patent prosecution, freedom to operate analyses, due diligence, and pre-litigation counseling. Technologies include clinical diagnostic services; robotics; bioinformatics/computational biology; genome mapping; genetic testing; gene mapping and counseling; companion diagnostics; blood testing services; and biotechnology.

Representing a number of software development and consumer goods companies in intellectual property related services, including patent prosecution. Technologies include digital

assistants/chatbots; virtual assistants and extended reality applications; artificial intelligence and machine learning services; and cloud applications and infrastructure.

Representing a semi-secret research and development facility and organization in intellectual property related services, including patent prosecution. Technologies include bioinformatics/computational biology; systems modeling; gene editing; artificial intelligence and machine learning services; and biotechnology.

Representing a Fortune 500 global technology and specialty materials company in multiple IPRs for patents relating to the manufacture of acetic acid.

Representing a large international concessions and construction company in an acquisition of a partial interest in a software company owning rights to toll management software. Performing IP due diligence including open source software analysis and freedom-to-operate analysis.