



## Overview

Mr. Kelly has over 27 years of experience in assisting clients with intellectual property related matters. He has extensive transactional and litigation experience representing plaintiffs and defendants in patent, trademark, copyright, trade secret, contract, licensing, and technology transfer disputes, including first chair jury trial experience in federal district court. Mr. Kelly is well-versed in patent, trademark, and copyright (including software) prosecution and infringement, trade secrets and unfair competition, international dispute resolution, and intellectual property insurance and legal opinions.

## Contact

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- Phoenix, AZ

## Areas of Focus

- Patent Procurement, Enforcement, and Defense



- Freedom to Practice, Validity/Invalidity, and Patentability Opinions
- International Patent, Trademark, Copyright, and Copyright Infringement
- International Dispute Resolution
- Mergers, Acquisitions, and Intellectual Property Asset Collateralization

## **Education**

B.S., Marquette University, Electrical & Computer Engineering (1991)

J.D., University of Illinois (1987)

B.S., University of Illinois, Mechanical & Industrial Engineering (1983)

## **Biography**

Mr. Kelly has over 27 years of experience in assisting clients with intellectual property related matters. He has extensive transactional and litigation experience representing plaintiffs and defendants in patent, trademark, copyright, trade secret, contract, licensing, and technology transfer disputes, including first chair jury trial experience in federal district court. Mr. Kelly is well-versed in patent, trademark, and copyright (including software) prosecution and infringement, trade secrets and unfair competition, international dispute resolution, and intellectual property insurance and legal opinions. He is also familiar with the rules and procedures governing United States patent and trademark prosecution, as well as the evolving protocols in Europe, the Middle East, and Asia.

Mr. Kelly's technical expertise includes encryption, cyber security, medical imaging, software architecture, data cache and database systems, microprocessors, optics, semiconductor processing and wafer fabrication technologies, cloud computing, advanced weapons systems, medical devices, supersonic aircraft design, automotive systems, business methods, avionics, credit and financial services, mobile devices, smartphone applications, and consumer electronics.

## **Admissions**

### **Court Admission**

- U.S. Court of Appeals, Ninth Circuit (2002)
- U.S. District Court, District of Arizona (1992)
- Arizona Supreme Court (1991)
- Wisconsin Supreme Court (1987)
- U.S. District Court, Eastern District of Wisconsin (1987)

### **Admitted to Practice**

- Arizona (1992)
- Wisconsin (Inactive)

## **Media and Presentations**



## Articles

- Co-Author, "[The Demise of Software Patents has been Greatly Exaggerated](#)," *District Energy Magazine* (2nd Quarter 2018)
- Contributor, "Protection or Privacy?," *AZ Business Magazine* (2016)
- Co-author, "The Evolving Cyber Security Regulatory Environment," *Hospitality Technology Magazine* (2015)
- Author, "*Smartflash v Apple*," *Intellectual Property Magazine* (2015)
- Contributor, "What to Do if Someone is Infringing on Your Patent," *InsideCounsel Magazine* (2015)
- Contributor, "Data Security Experts Reveal the Biggest Mistakes Companies Make with Data and Information Security," *Digital Guardian* (2015)

## Interviews

- "Protect Your Intellectual Property Assets," *Arizona Horizon* (2015)
- "Arizona Technology and Innovation: Securing Data," *Arizona Horizon* (2015)

## Presentations

- "Cyber Security," Imagine Technologies Group and TouchPoint Management Services (November 2017)
- "*TC Heartland v. Kraft Food Group*," LFA IP Community (October 2017)
- "Trending Cybersecurity Breach Vectors," Arizona Business Council (May 2017)
- Co-presenter, "Cybersecurity and SEC Reporting: What Needs to Be Reported, and When," Association of Corporate Council Arizona (2016)
- Guest Lecturer, Patent Law, Summit Law School (2016)
- Panelist, "Emerging Cybersecurity Disruptive Technology Strategies," 5th Annual ATIC-ACTRA/AZ InfraGard Program (2015)
- Co-presenter, "Patent Prosecution Practice Tips," CLE in the Gardens: Cultivating Best Practices in Intellectual Property Law, State Bar of Arizona (2015)
- Co-presenter, "Cybersecurity: Minimizing Risk and Responding to Breaches," Jennings Strouss and the AZ Chamber of Commerce & Industry (2015)
- Co-presenter, "Cybersecurity: Minimizing Risk and Responding to Breaches," Lucid Agency + Google 2015 Digital Summit (2015)

## Memberships

### State Bar of Arizona

- Member, Intellectual Property Law Section, Executive Council
- Past Chair, Intellectual Property Law Section, Executive Council

### State Bar of Wisconsin

- Inactive Member



**American Intellectual Property Law Association**

**Institute of Electrical and Electronics Engineers Licensing Executives Society**

**International Trademark Law Association**

**Federal Circuit Bar Association**

**Honors and Awards**

- Listed, *The Best Lawyers in America*® in the categories of Litigation – Intellectual Property, Patent Law, and Trademark Law (2018-2019)

**Community Involvement**

**Teen Addiction Anonymous**

- Member, Board of Directors