



Scott M. Kelly

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Scott represents clients throughout the life of an invention — from the birth of an idea through procuring a patent and enforcing it to protect key technologies and business interests. He has experience with a wide range of technologies, including computer software, networking, and business methods. In addition to preparing and prosecuting patent applications, Scott regularly counsels clients on validity, infringement, and other issues presented by asserted patents or potential acquisitions.

As a former examiner at the USPTO, Scott offers clients valuable experience with the practices and procedures of the agency offices. During his time at the USPTO, Scott examined patents in class 715 – Presentation Processing of Documents and Operator Interface Processing, relating to a variety of technologies ranging from word processing and spreadsheets to input validation and assistive technologies. He also examined business method patents, including several directed to the process of drafting a patent. Scott has worked with a wide variety of technologies, such as user interfaces, machine learning, cloud computing, algorithms, virtual and augmented reality, video games, computer networking and routing, wireless communications, and interactive television program guides.

And thanks to his own experiences with startup companies, Scott understands many of the business issues facing his clients. His last venture before joining Banner Witcoff was founding a company to develop an intelligent patent search engine using document similarity analysis that was eventually acquired by a startup foundry. Prior to that experience and before attending law school, Scott was the sixth employee at a startup company that developed gigapixel resolution video cameras for use on drone aircraft.

Beyond patent prosecution, Scott represents clients in Inter Partes Reviews (IPR) and Ex Parte Reexamination proceedings before the USPTO's Patent Trial and Appeal Board (PTAB). He works with his clients to assess risks associated with potential patent assertions and to develop strategic and cost-effective responses. In 2019, Patexia listed Scott as among both the most active and best performing IPR attorneys.

Scott also counsels clients regarding patent and other IP issues that arise during a merger or acquisition. He helps clients assess the substantive value of a company's patents and other IP assets, conducting IP-focused due diligence as part of a broader coordinated team. He also assists his clients in evaluating risks associated with outside intellectual property when considering a deal. Scott is a member of the Alliance of Mergers & Acquisitions Advisors (AM&AA) and has spoken at M&A conferences on IP issues and how they can impact a deal.

Scott has developed a particular niche for himself in the videogame industry. He frequently speaks about intellectual property law at video game and interactive entertainment conferences, and writes on the impact of IP law on the business of videogames. He serves as chair for the Digital Games and New Media committee of the American Bar Association's Intellectual Property Law Section, an assistant editor at PatentArcade.com, and a contributing author to the ABA Legal Guide to Video Game Development, 2nd Edition (2016).

Scott received his Bachelor of Science degree in honors from Virginia Tech, where he majored in computer science with minors in physics and mathematics. He received his J.D. from the University of Virginia School of Law, where he served on the editorial board of the Virginia Journal of Law and Technology.

Education

Admissions

Bar Admissions

2010, Virginia

2015, District of Columbia

Court Admissions

District of Columbia Court of Appeals

Superior Court of the District of Columbia

Supreme Court of Virginia

U.S. Court of Appeals for the Federal Circuit

U.S. Patent and Trademark Office

Practices

Copyright

Counseling, Opinions + Licensing

PTAB Litigation

Patent Prosecution

Industries

Electrical + Computer Technologies

Internet, E-Commerce + Business Methods

Accolades

- Named a "DC Rising Star" in the National Law Journal's 2023 Legal Awards
- Recognized for litigation, IAM Patent 1000: The World's Leading Patent Professionals, 2023
- Recognized as a Washington D.C. Super Lawyers' "Rising Star" since 2017
- Recognized as among the top 100 best performing attorneys overall (representing petitioners and patent owners), Patexia's 2019 IPR Intelligence Report, 2019
- Recognized as one of the top petitioner attorneys at the PTAB, Managing Intellectual Property, 2017

Representative Matters

- Prepared and prosecuted patent applications for dozens of clients in the US and worldwide.
- Represented a Fortune 50 company in over 50 IPRs as part of an ongoing patent assertion involving over 35 patents.

Affiliations/Memberships

Member, American Bar Association

Chair, Digital Games and New Media Committee, American Bar Association's Intellectual Property Law Section
Editorial board the Interactive Entertainment Law Review
Member, Alliance of Mergers & Acquisitions Advisors (AM&AA)
Member, Video Game Bar Association

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[Event - Witcon - 06.11.24](#)

WITCON London Continued: Adapting Your IP Approach for the US/EP: Strategic Claiming and The Continuation

[EVENT - 06.10.24](#)

Scott Kelly Presents at The Sedona Conference on AI and the Law

[NEWS - 06.06.24](#)

IAM Patent 1000 Recognizes 14 Banner Witcoff Attorneys, Patent Prosecution, and Litigation Practices

[EVENT - 04.30.24](#)

Patents and AI in the Video Game Industry: Ross Dannenberg and Scott M. Kelly Present at More Than Just a Game Conference in London

[NEWS - 04.22.24](#)

Nine Banner Witcoff Attorneys Named 2024 Washington, D.C. Super Lawyers and Rising Stars

[EVENT - 01.18.24](#)

IP Law in the Metaverse: Scott Kelly presents with Massachusetts CLE

[EVENT - 12.28.23](#)

Banner Witcoff's Matt Becker and Scott Kelly Present 2023 Patent Case Law CLE for the D.C. Bar

[EVENT - 12.28.23](#)

Corporate IP Roundtable Webinar Reviews Key 2023 Patent Law Developments

[EVENT - 12.04.23](#)

Matt Becker and Scott Kelly Explore 2023's Significant Patent Case Law Developments for the D.C. Bar CLE Program

[NEWS - 09.18.23](#)

Washington's Top 40 Under 40: Scott M. Kelly Recognized as "DC Rising Star" by National Law Journal

[EVENT - 09.18.23](#)

AI Inventorship, Everything is Obvious? - Scott Kelly Joins Panel at IP-Con 2023

[NEWS - 06.27.23](#)

IAM 1000 Recognizes 15 Banner Witcoff Attorneys, Patent Prosecution, and Litigation Practices

[NEWS - 04.24.23](#)

11 Banner Witcoff Attorneys Named 2023 Washington, D.C. Super Lawyers and Rising Stars

[EVENT - 04.13.23](#)

Banner Witcoff Attorneys Present at More Than Just a Game Conference in London

[EVENT - 01.26.23](#)

DMV Corporate IP Roundtable to Provide Discussion on Invention Harvesting, Building a Patent Pipeline, and Inventor Incentives

EVENT - 01.11.23

Corporate IP Roundtable Webinar to Discuss Key Patent Law Developments of 2022

NEWS - 07.06.22

Banner Witcoff's Patent Prosecution and Litigation Practices Recognized in IAM 1000

NEWS - 04.29.22

12 Banner Witcoff Attorneys Named 2022 Washington, D.C. Super Lawyers and Rising Stars

EVENT - 04.04.22

Banner Witcoff Attorneys to Speak at More Than Just a Game Conference in London

EVENT - 01.27.22

Corporate IP Roundtable Webinar to Discuss Key Patent Law Developments Over the Past Year

NEWS - 10.15.21

Drafting Patents for Litigation and Licensing, Fourth Edition, Now Available

NEWS - 09.12.21

The History of Video Game IP: A Challenging Level of Law