

**Scott M. Kelly**

Attorney  
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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](http://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**

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Virginia Polytechnic Institute and State University

### **Admissions**

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#### **Bar Admissions**

2010, Virginia  
2015, District of Columbia

#### **Court Admissions**

U.S. Patent and Trademark Office  
Supreme Court of Virginia  
U.S. Court of Appeals for the Federal Circuit

### **Accolades**

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- 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**

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- 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**

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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

### **Recent News + Events + Related Publications**

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#### **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**

#### **EVENT - 06.11.21**

**Banner Witcoff to Host Virtual Booth at CogX Festival 2021**

#### **EVENT - 03.22.21**

**Binal Patel and Scott Kelly to Speak About Future of Software IP at IPBC Connect**

#### **NEWS - 02.22.21**

**28 Banner Witcoff Attorneys Named 2021 Super Lawyers and Rising Stars**

#### **EVENT - 11.09.20**

**IP Corporate Roundtable to Present Patent Year in Review**

#### **NEWS - 10.06.20**

**Centripetal Networks Awarded \$2.6B-\$3.2B Verdict with Four Banner Witcoff-Drafted Patents**

**NEWS - 09.18.20**

Banner Witcoff Ranked as One of the Best Performing, Most Active Law Firms in IPR

**NEWS - 08.08.20**

Bloomberg Law Quotes Scott M. Kelly on Challenge to USPTO's Rejection of Artificial Intelligence as an Inventor

**EVENT - 04.14.20**

Scott Kelly to Discuss Professional Development With Young Lawyers

**NEWS - 01.14.20**

Bloomberg Law Quotes Scott M. Kelly on PTAB's Recent Hulu Decision

**NEWS - 12.30.19**

Scott Kelly Co-Authors Article for Interactive Entertainment Law Review

**NEWS - 10.29.19**

Banner Witcoff Attorneys Featured in Chicago Daily Law Bulletin Article

**EVENT - 10.17.19**

Banner Witcoff Duo to Speak at Chicago Video Game Law Summit

**EVENT - 07.11.19**

Banner Witcoff Trio to Speak at Global M&A Conference

**NEWS - 04.22.19**

Eleven Banner Witcoff Attorneys Named 2019 Washington, D.C. Super Lawyers, Rising Stars

**NEWS - 04.08.19**

Scott M. Kelly Discusses Non-Patent Literature in Bloomberg Article

**PRESS - 01.30.19**

Banner & Witcoff Elects President Mu & New Shareholder Class

**EVENT - 01.03.19**

Banner & Witcoff sponsors North Shore Corporate IP Roundtable program in Northbrook, Ill.

**EVENT - 01.03.19**

Banner & Witcoff sponsors West Suburban Corporate IP Roundtable program in Oak Brook, Ill.

**LIBRARY - 12.11.18**

Patent Law Year in Review 2018 Presentation

**EVENT - 12.07.18**

Scott M. Kelly presents "Patent Law Year in Review 2018" to The D.C. Bar in Washington, D.C.