

CHARLES DUAN

EXPERIENCE

- 2013–Present* **Director, Patent Reform Project, at Public Knowledge**, a public interest organization dedicated to promoting technological innovation, protecting the rights of all users of technology, and ensuring that emerging technology law serves the public interest.
- Prepared and filed *amicus curiae* briefs before the Supreme Court, Federal Circuit, and Ninth Circuit, as well as administrative comments before the USPTO, FTC, and OMB.
 - Testified before the House of Representatives Energy and Commerce Committee, on public concerns with patent demand letters.
 - Discussed patent policy proposals with offices of Congress, White House staff, and USPTO leadership.
 - Authored a comprehensive white paper on the public interest perspective on the patent system and areas for reform.
 - Spoke on patent reform at briefing panels in Congress, intellectual property scholar conferences, technology conferences, and other events.
 - Wrote op-ed pieces and articles published in national papers and widely read journals, explaining patent law and issues to the general public.
- 2012–2013* **Research Fellow with Colorado Law School**, for Professor Paul Ohm, funded by the National Science Foundation.
- Analyzed next-generation Internet technologies for legal implications in the areas of intellectual property, privacy, federal investigative law, and communications law.
 - Prepared research papers and presented discussions explaining technology law to computer science researchers.
- 2008–2012* **Attorney at Knobbe Martens Olson & Bear, LLP**, an intellectual property law firm. Specialized in patent litigation and computer patent prosecution.
- Drafted and prosecuted over 100 patent applications, many successfully to issuance, and conducted interviews with over 30 patent examiners.
 - Prepared patent non-infringement analysis opinions, and drafted reexamination requests.
 - Counseled clients on patent portfolio strategy, invention disclosures, design-arounds, and other intellectual property matters.
- Representative litigation matters:
- *Autobytel Inc. v. Auto by Rent, Inc.* (Trademark Trial & Appeal Bd. 2011): Successfully opposed a competitor's trademark on the grounds of likelihood of confusion.
 - *Toshiba Corp. v. Wistron Corp.* (Int'l Trade Comm'n 2010): Successfully defended against summary judgment of invalidity and noninfringement, involving detailed analysis of patents and computer source code.
 - *Advanced Thermal Sciences v. Applied Materials, Inc.* (C.D. Cal. 2010): Trial counsel for plaintiff in patent inventorship dispute. Court ruled in favor of Advanced Thermal Sciences on all substantive issues.
- 2007–2008* **Chief software developer at Labmeeting.com, Inc.**, a web technology startup. Developed online software for facilitating collaboration in biotechnology and biomedical research fields.
- Summer 2006* **Electronic Frontier Foundation** legal intern. Prepared legal research and advocacy materials on technology and intellectual property issues.

- Summer 2006* **National Consumer Law Center** legal intern. Drafted comments for FTC rulemaking on identity theft. Analyzed legislation on bankruptcy and mobile home tenant laws.
- Summer 2005* **Electronic Privacy Information Center** summer clerk. Prepared legal advocacy and educational materials on emerging privacy and technology issues, such as surveillance under the Fourth Amendment.
- 2004–2007* **Berkman Center for Internet and Society at Harvard Law School** intern and research assistant to co-director, Prof. Jonathan Zittrain. Investigated international use of Internet filtering and censorship; studied substantive trends in spam e-mails and legal implications of such trends.
- 2003* **Summer Quantitative Analyst** for Geode Capital Management, LLC. Designed statistical models for predicting the stock market, for a medium-sized hedge fund corporation. Worked with major financial databases and non-linear mixed effects models.

EDUCATION

- 2004–2007* **Harvard Law School:** JD. Focused on intellectual property law, including patent law.
- 2000–2004* **Harvard University:** AB in Computer Science, *magna cum laude*. Thesis title: *A Theoretical Taxonomy of Anti-Spam Technologies*.

SKILLS AND ABILITIES

- 2008–Present* **Intellectual property law.** Member of the California Bar. Registered U.S. patent attorney. Skilled in patent prosecution, pre-litigation patent risk analysis, and patent litigation.
- Computer programming** proficiency in numerous languages (e.g., C/C++, Java, Ruby, Perl, SQL). Also proficient in networking and web technologies (e.g., HTML, Javascript, HTTP, TCP/IP, SMTP).
- Bar admissions:**
- District of Columbia Bar
 - California State Bar
 - Northern District of California
 - Central District of California
 - United States Supreme Court
 - Court of Appeals for the Ninth Circuit
 - Court of Appeals for the Federal Circuit
 - United States Patent & Trademark Office

AMICUS CURIAE BRIEFS

- 2015* Brief of Public Knowledge, the R Street Institute, the American Library Association, the Association of Research Libraries, the Association of College and Research Libraries, and the Center for Democracy and Technology as *Amici Curiae* in Support of Respondent, *Commil USA, LLC v. Cisco Sys., Inc.*, No. 13-896 (U.S. Feb. 24, 2015), *available at* <https://www.publicknowledge.org/assets/uploads/blog/brief-commil-copyright.pdf>. Discussed in:
- Joe Mullin, *If You Believe Enough, Can You Invalidate a Patent? Supreme Court to Decide*, ARS TECHNICA (Mar. 31, 2015), <http://arstechnica.com/tech-policy/2015/03/if-you-believe-enough-can-you-invalidate-a-patent-supreme-court-to-decide/>.
- Brief of Public Knowledge as *Amicus Curiae* in Support of Respondent, *Kimble v. Marvel Enters., Inc.*, No. 13-720 (U.S. Mar. 4, 2015), *available at* https://www.publicknowledge.org/assets/uploads/documents/13-720_bsac_Public_Knowledge.pdf. Discussed in:
- Joe Mullin, *Supreme Court Mulls Lengthy Patent Deals in Spat over Spider-Man Toy*, ARS TECHNICA (Mar. 31, 2015), <http://arstechnica.com/tech-policy/2015/03/supreme-court-mulls-lengthy-patent-deals-in-spat-over-spider-man-toy/>.

Brief of *Amici Curiae* Public Knowledge and the Electronic Frontier Foundation in Support of Petitioner, *K/S HIMPP v. Hear-Wear Techs., LLC*, No. 14-744 (U.S. Jan. 22, 2015).

2014

Brief of *Amici Curiae* Application Developers Alliance, Computer and Communications Industry Association, Electronic Frontier Foundation, Engine Advocacy, National Restaurant Association, and Public Knowledge in Support of Defendant-Appellee Bravo Media, LLC, *DietGoal Innovations LLC v. Bravo Media LLC*, No. 14-1631 (Fed. Cir. Nov. 24, 2014), available at https://www.eff.org/files/2014/11/25/14-1631_dietgoal_amicus_final.pdf.

Brief of *Amicus Curiae* Public Knowledge in Support of Appellee, *Microsoft Corp. v. Motorola, Inc.*, No. 14-35393 (9th Cir. Nov. 21, 2014), available at <https://www.publicknowledge.org/assets/uploads/documents/brief-ms-v-motorola.pdf>. Discussed in:

- Aaron Vehling, *Apple, Intel Back Microsoft in Landmark RAND Ruling Row*, LAW360 (Nov. 24, 2014), <http://www.law360.com/articles/598757/apple-intel-back-microsoft-in-landmark-rand-ruling-row>.

Brief of *Amicus Curiae* Public Knowledge in Support of the Petition, *Google, Inc. v. Oracle Am., Inc.*, No. 14-410 (U.S. Nov. 7, 2014), available at <https://www.publicknowledge.org/assets/uploads/documents/brief-oracle-v-google.pdf>. Discussed in:

- Mike Masnick, *Computer Scientists, Legal Experts Explain to Supreme Court Why APIs Are Not Copyrightable*, TECHDIRT (Nov. 10, 2014), <https://www.techdirt.com/articles/20141108/06411929085/computer-scientists-legal-experts-explain-to-supreme-court-why-apis-are-not-copyrightable.shtml>.

Brief of *Amici Curiae* Public Knowledge and the Electronic Frontier Foundation in Support of Appellants, *ClearCorrect Operating, LLC v. Int'l Trade Comm'n*, No. 14-1527 (Fed. Cir. Oct. 16, 2014), available at <https://www.publicknowledge.org/assets/uploads/documents/brief-clearcorrect.pdf>. Discussed in:

- Russell Brandom, *The MPAA Has a New Plan to Stop Copyright Violations at the Border*, THE VERGE (Jan. 2, 2015), <http://www.theverge.com/2015/1/2/7481409/the-mpaa-has-a-new-plan-to-stop-copyright-violations-at-the-border>.
- Tim Cushing, *MPAA Wants Regulators to Force ISPs to Block Sites 'at the Border'*, TECHDIRT (Jan. 5, 2015), <https://www.techdirt.com/articles/20150102/19563929582/mpaa-wants-regulators-to-force-isps-to-block-sites-border.shtml>.
- Jessica Corso, *Advocates Urge Fed. Circ. to Curtail ITC Digital Data Ruling*, LAW360 (Oct. 16, 2014), <http://www.law360.com/articles/587742/advocates-urge-fed-circ-to-curtail-itc-digital-data-ruling>.
- Lisa Shuchman, *Tech Players Line Up Against ITC Power to Ban Digital Files*, THE LITIGATION DAILY (Oct. 21, 2014), <http://www.litigationdaily.com/id=1202674159665/Tech-Players-Line-Up-Against-ITC-Power-to-Ban-Digital-Files?slreturn=20150016135931>.

Brief of *Amicus Curiae* Public Knowledge in Support of Defendant-Appellee, *Ultramercial, Inc. v. Hulu, LLC*, No. 10-1544 (Fed. Cir. Aug. 28, 2014), available at <https://www.publicknowledge.org/assets/uploads/documents/brief-ultramercial-cafc-supp.pdf>.

Brief of *Amici Curiae* Electronic Frontier Foundation and Public Knowledge in Support of Petitioner, *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (Mar. 3, 2014) (No. 13-369), available at <http://www.publicknowledge.org/assets/uploads/blog/nautilus-amicus-brief.pdf>.

Brief of Public Knowledge and the Application Developers Alliance as *Amici Curiae* in Support of Respondents, *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (Feb. 26, 2014) (No. 13-298), available at http://www.publicknowledge.org/assets/uploads/blog/13-298_bsac_Public_Knowledge_and_the_Application_Developers_Alliance.pdf. Discussed in:

- Joe Mullin, *How Far Will the Supreme Court Go to Stop Patent Trolls?*, ARS TECHNICA (Mar. 31, 2014), <http://arstechnica.com/tech-policy/2014/03/how-far-will-the-supreme-court-go-to-stop-patent-trolls/>.
- Tim Cushing, *Public Knowledge Deflates Another Dubious Software Patent by Reducing It to Seven Lines of BASIC*, TECHDIRT (Mar. 3, 2014), <https://www.techdirt.com/articles/20140227/09465426377/public-knowledge-deflates-another-dubious-software-patent-reducing-it-to-seven-lines-basic.shtml>.

Brief of Public Knowledge and the Electronic Frontier Foundation as *Amici Curiae* in Support of Petitioner, *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (Oct. 23, 2013) (No. 13-369), available at <http://www.publicknowledge.org/files/pk-nautilus-brief.pdf>.

- 2013 Brief of Public Knowledge as *Amicus Curiae* in Support of Petitioner, *WildTangent, Inc. v. Ultramercial, LLC*, 134 S. Ct. 2870 (Sept. 23, 2013) (No. 13-255), available at <http://www.publicknowledge.org/files/wildtangent-v-ultramercial-pk-amicus.pdf>. Discussed in:
- Tim Cushing, *Amicus Brief from Public Knowledge Distills Ultramercial's 'Complex' Patent to 16 Lines of Code*, TECHDIRT (Sept. 26, 2013), <https://www.techdirt.com/articles/20130924/13500824642/amicus-brief-public-knowledge-distills-ultramercials-complex-patent-to-16-lines-code.shtml>.

TESTIMONY AND ADMINISTRATIVE COMMENTS

- 2015 Charles Duan, *Comments of Public Knowledge on 2014 Interim Guidance on Patent Subject Matter Eligibility* (USPTO Mar. 16, 2015), available at http://www.uspto.gov/sites/default/files/documents/2014ig_a_public_2015mar16.pdf.

Examining Recent Supreme Court Cases in the Patent Arena: Hearing Before the Subcomm. on Courts, Intellectual Property, and the Internet of the H. Comm. on the Judiciary, 114th Cong. (2015) (statement of Charles Duan, Director, Patent Reform Project, Public Knowledge), <https://www.publicknowledge.org/assets/uploads/blog/testimony-scotus-cases.pdf>.

- 2014 Charles Duan, *Comments of Public Knowledge on MPHJ Technology Investments, LLC, et al.—Consent Agreement* (FTC Dec. 8, 2014), available at <https://www.publicknowledge.org/assets/uploads/documents/pk-ftc-mphj.pdf>.

Charles Duan & Wendy Knox Everette, *Comments of Public Knowledge on Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board* (USPTO Sept. 30, 2014), available at http://www.uspto.gov/ip/boards/bpai/public_knowledge_20140930.pdf.

Charles Duan & Sherwin Siy, *Comments of Public Knowledge on Strategy for American Innovation* (OSTP & NEC Sept. 23, 2014), available at <https://www.publicknowledge.org/assets/uploads/documents/comments-ostp-innovation.pdf>.

Charles Duan & Ethan Jeans, *Comments of Public Knowledge on Optimum First Action and Total Patent Pendency* (USPTO Sept. 8, 2014), available at http://www.uspto.gov/patents/law/comments/ofa_a_public_2014sep08.pdf.

Charles Duan & Joseph Savage, *Comments of Public Knowledge on Examination Instruction and Guidance Pertaining to Patent-Eligible Subject Matter* (USPTO July 31, 2014), available at <http://www.uspto.gov/sites/default/files/patents/law/comments/al-a-publicknowledge20140731.pdf>.

Charles Duan, *Comments of Public Knowledge on Agency Information Collection Activities (Patent Assertion Entities Study II)* (FTC & OMB June 18, 2014), available at http://www.ftc.gov/system/files/documents/public_comments/2014/06/00031-90497.pdf.

Charles Duan, *Comments of Public Knowledge on Changes to Require Identification of Attributable Owner* (USPTO Apr. 23, 2014), <http://www.publicknowledge.org/assets/uploads/blog/pto-attributable-ownership.pdf>.

Charles Duan, *Comments of Public Knowledge on the Use of Crowdsourcing and Third-Party Preissuance Submissions to Identify Relevant Prior Art* (USPTO Apr. 23, 2014), <http://www.publicknowledge.org/assets/uploads/blog/pto-crowdsourcing.pdf>.

Charles Duan, *Comments of Public Knowledge, the Electronic Frontier Foundation, and Engine Advocacy on Prior Art Resources for Use in the Examination of Software-Related Patent Applications* (USPTO Mar. 17, 2014), <http://www.publicknowledge.org/documents/uspto-comments-on-prior-art-resources>. Discussed in:

- Cory Doctorow, *EFF, Public Knowledge and Engine Tell the USPTO How to Improve Patent Quality*, BOING BOING (Mar. 18, 2014), <http://boingboing.net/2014/03/18/eff-public-knowledge-and-engi.html>.

2013 *The Impact of Patent Assertion Entities on Innovation and the Economy: Hearing Before the H. Subcomm. on Oversight and Investigations of the H. Comm. on Energy and Commerce, 113th Cong. (2013) (statement of Charles Duan, Director, Patent Reform Project, Public Knowledge), available at <http://docs.house.gov/meetings/IF/IF02/20131114/101483/HHRG-113-IF02-Wstate-DuanC-20131114.pdf>.*

Charles Duan et al., *Comments of Public Knowledge, the Electronic Frontier Foundation, and Engine Advocacy on Agency Information Collection Activities (Patent Assertion Entities Study I)* (FTC Dec. 16, 2013), available at http://www.ftc.gov/sites/default/files/documents/public_comments/2013/12/00039-87898.pdf.

Charles Duan, Julie Samuels & Daniel Nazer, *Comments of Public Knowledge and the Electronic Frontier Foundation on Strategies for Improving Claim Clarity: Glossary Use in Defining Claim Terms* (USPTO Oct. 24, 2013), available at <http://www.publicknowledge.org/files/comments-pto-roundtable.pdf>.

PUBLICATIONS

2015 Charles Duan, *The STRONG Patents Act Is a Death Squad for Innovation*, ROLL CALL (Mar. 17, 2015), <http://blogs.rollcall.com/beltway-insiders/the-strong-patents-act-is-a-death-squad-for-innovation/>.

Charles Duan, *Making the Supercookie a Little Sweeter: Nine Lines of Code Could Make Verizon's Controversial User-Tracking System a Bit Less Invasive*, SLATE: FUTURE TENSE (Jan. 30, 2015), http://www.slate.com/articles/technology/future_tense/2015/01/verizon_s_privacy_involving_uidh_supercookie_could_be_reined_in_with_this.html.

2014 CHARLES DUAN, PUB. KNOWLEDGE, *A FIVE PART PLAN FOR PATENT REFORM* (2014), available at <https://www.publicknowledge.org/documents/a-five-part-plan-for-patent-reform>.

Charles Duan, *Taking a Page from the Patent Troll Playbook*, SLATE: FUTURE TENSE (Dec. 17, 2014), http://www.slate.com/articles/technology/future_tense/2014/12/ben_edelman_used_patent_troll_tactics_in_going_after_a_chinese_restaurant.html.

Charles Duan, *Would You Like a Patent Lawsuit with Your Meal?*, ROLL CALL (Dec. 18, 2014), http://www.rollcall.com/news/would_you_like_a_patent_lawsuit_with_your_meal_commentary-238838-1.html.

Tristan Gray–Le Coz & Charles Duan, *Apply It to the USPTO: Review of the Implementation of*

Alice v. CLS Bank in Patent Examination, 2014 PATENTLY-O PAT. L.J. 1, <http://patentlyo.com/media/2014/11/GrayLeCozDuan.pdf>.

Charles Duan, *How Amazon Got a Patent on White-Background Photography: Bad Laws, Not Bad Examiners, Create Obvious Patents*, ARS TECHNICA (June 10, 2014), <http://arstechnica.com/tech-policy/2014/06/how-amazon-got-a-patent-on-white-background-photography/>.

Charles Duan, *A Definite Problem of Patent Law: Nautilus v. Biosig Instruments*, JURIST PROF. COMMENT. (May 7, 2014), <http://jurist.org/hotline/2014/05/charles-duan-patents-nautilus.php>.

Charles Duan, *Big Businesses Are Filing Frivolous Patent Lawsuits to Stifle Innovative Small Competitors*, FORBES (Feb. 24, 2014), <http://www.forbes.com/sites/realspin/2014/02/24/big-businesses-are-filing-frivolous-patent-lawsuits-to-stifle-innovative-small-competitors/>.

2013 Charles Duan, *Patent Trolls Are the Economy-Suffocating Exception to the 'No Free Lunch' Rule*, FORBES (Nov. 15, 2013), <http://www.forbes.com/sites/realspin/2013/11/15/patent-trolls-are-the-economy-suffocating-exception-to-the-no-free-lunch-rule/>.

Charles Duan, *First Rule of Patents: Do No Harm to Consumers*, THE HILL: CONGRESS BLOG (Oct. 24, 2013), <http://thehill.com/blogs/congress-blog/technology/330251-first-rule-of-patents-do-no-harm-to-consumers>.

Charles Duan, *Down with the Patent Trolls*, L.A. TIMES, Aug. 22, 2013, A17, available at <http://articles.latimes.com/2013/aug/22/opinion/la-oe-duan-troll-patent-abuse-consumer-20130822>.

2012 Katie Shilton, Jeff Burke, kc claffy, Charles Duan & Lixia Zhang, *A World on NDN: Affordances & Implications of the Named Data Networking Future Internet Architecture* (Named Data Networking, Technical Report No. NDN-0018, 2014) (based on work from 2012), <http://named-data.net/publications/techreports/world-on-ndn-11apr2014/>.

2009 Lauren Katzenellenbogen, Charles Duan & James Skelley, *Alternative Software Protection in View of In re Bilski*, 7 NW. J. TECH. & INTELL. PROP. 332 (2009), available at <http://scholarlycommons.law.northwestern.edu/njtip/vol7/iss3/5>.

2006 Charles Duan, *The Real Results of Stock-Touting Spam*, GTNEWS (Oct. 23, 2006), http://gtnews.afponline.org/Articles/2006/The_Real_Results_of_Stock-touting_Spam.html.