

## JOSEPH MATAL



### EXPERIENCE

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#### **HAYNES AND BOONE, LLP** – Partner, 2020 to present

- Member of the firm’s Intellectual Property Practice Group, with a focus on USPTO post-issuance proceedings and Federal Circuit appeals.

#### **U.S. PATENT & TRADEMARK OFFICE** – Associate Solicitor, 2012 to 2020

- **Acting Solicitor** From 2018 to January 2019, managed and oversaw the legal work of the Solicitor’s Office, which represents the USPTO in appeals of patent and trademark matters, provides legal advice to the Under Secretary, and advises the Justice Department in intellectual property cases before the Supreme Court.
- **Interim Director** During eight months from 2017 to 2018, performed the functions and duties of the USPTO Under Secretary and Director, leading and overseeing an agency with over 12,000 employees and a budget of over \$3 billion. Represented the USPTO in intragovernmental meetings, before international bodies, and at intellectual property trade and professional associations.
- **Litigation** As an associate solicitor, argued 14 appeals of patent decisions before the U.S. Court of Appeals for the Federal Circuit and one trademark appeal before the U.S. District Court. Provided legal advice to the U.S. Solicitor General in patent and copyright cases before the U.S. Supreme Court. Briefed or served as second attorney on other patent cases, and provided internal legal advice on patent and administrative-law matters to the USPTO General Counsel.
- **Congressional Matters** Participated in preparing the USPTO Director to testify at congressional oversight, confirmation, and legislative hearings. Participated in providing technical and legal advice and drafting assistance to congressional staff on patent and trademark legislation. Recipient, U.S. Department of Commerce Bronze Medal Award, August 2014, for support of the USPTO’s role in ongoing patent-reform legislative efforts.

#### **U.S. SENATE JUDICIARY COMMITTEE** – 2002 to 2012

- **General Counsel**, Senator Jeff Sessions, Ranking Member, 2009-2011. Member of Judiciary Committee Republicans’ senior leadership team; supervised lawyers and provided advice on legal, policy, legislative, and political matters. Negotiated and drafted, in cooperation with industry leaders and USPTO officials, key provisions of March 2010 managers’ amendment to the Senate bill that became the Leahy-Smith America Invents Act, Pub. L. No. 112-29 (2011).
- **Counsel**, Senator Jon Kyl, 2002 to 2009 & 2011 to 2012. Co-managed Senate Judiciary Committee and Senate floor consideration of the America Invents Act, February to March, 2011; assisted House of Representatives staff with drafting and defense of House companion bill, drafting of committee report for bill, and participated in negotiation of final Senate agreement with House of Representatives, March to June, 2011; participated in defense and floor management of Senate passage of clean House bill, September 2011.

## PUBLICATIONS

- **Author**, *The Three Types of Abstract Ideas*, 30 FED. CIR. B.J. 87 (2021); *A Guide to the Legislative History of the America Invents Act: Part I of II*, 21 FED. CIR. B.J. 435 (2012) (also published in *ABA Section of Intellectual Property Law Annual Review for 2011*); *A Guide to the Legislative History of the America Invents Act: Part II of II*, 21 FED. CIR. B.J. 539 (2012).

## SPEECHES

- **Speaker** on patent law and policy before conferences and in webinars conducted by Intellectual Property Owners Assoc. (Keynote Speaker, Sept. 2017; 3-part webinar, Oct.-Dec. 2011; panel discussion, Sept. 2010), Am. IP Law Ass'n (Keynote Speaker, Oct. 2017; panel, May 2012), Intellectual Asset Mgmt. (Keynote Speaker, Nov. 2017), INTERPAT (Keynote Speaker, Nov. 2017), Georgetown Institute for Tech. Law & Policy (Keynote Speaker, Nov. 2017), PatCon 8 (academic conference) (Luncheon Speaker, Mar. 2018), Biotechnology Indus. Org. (Oct. 2009; Apr. 2014; Keynote Speaker, Apr. 2018), Federalist Soc'y Western Chapters Conference (Jan. 2015), Advanced Patent Law Institute (Luncheon Speaker, Mar. 2018), Rocky Mountain IP & Tech. Law Institute (Keynote Speaker, May 2018), Assoc. of Corp. Patent Counsel (June 2008; Dec. 2011), Patent Information Users Group (Keynote Speaker, May 2018), Berkeley Center for Law & Tech. (Apr. 2018), Naples Group (Feb. 2018), Thomas Jefferson Law School (Apr. 2016), Analysis Group (June 2010), Licensing Exec. Soc'y (Apr. 2011), AdvaMed (Sept. 2011), NACHA (electronic payments) (Nov. 2011), Kauffman Foundation (Yale Law School) (Nov. 2011), N. Va. Tech. Council (Dec. 2011), Thomson Reuters (Dec. 2011), Catholic U. (Apr. 2012), Princeton CITP (May 2012), Suffolk University Law School (Mar. 2013), Patent Law Institute (Duke Law School) (Keynote Speaker, May 2013), Center for Am. and Int'l Law (May 2014).

## EARLY EMPLOYMENT AND CLERKSHIPS

- **Policy Director**, U.S. Senator Peter Fitzgerald, 2000-2002. Advised the Senator on Judiciary and Commerce Committee matters.
- **Associate Attorney**, Gibson, Dunn & Crutcher, 1998-2000. Member of appellate and constitutional law practice group.
- **U.S. Court Of Appeals for the Ninth Circuit**, Law Clerk, 1997-1998, Senior Judge William C. Canby, Jr., Phoenix, Arizona.
- **Alaska Supreme Court**, Law Clerk, 1996-1997, Justice Jay A. Rabinowitz, Juneau, Alaska.

## EDUCATION & LANGUAGES

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**BOALT HALL SCHOOL OF LAW (U.C. BERKELEY)**, J.D. – May 1996

Order of the Coif; Articles Editor, California Law Review; Prosser Prizes in Civil Procedure, Habeas Corpus, and Federal Courts. Two-time moot court quarterfinalist.

**STANFORD UNIVERSITY**, B.A. in Public Policy and English – June 1993

Member, Stanford Debate Society.

Fluent in French and Czech.