



Roberto Capriotti

Partner

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OVERVIEW

Roberto Capriotti is admitted to practice in Pennsylvania and by the United States Patent and Trademark Office. He is not currently admitted in California.

Roberto Capriotti focuses his practice on intellectual property law, primarily in the preparation, prosecution, and litigation of high technology patents, trademarks, and copyrights. Roberto also counsels clients on intellectual property strategy, portfolio development, and transactional matters.

Patent Litigation: Roberto's practice involves representing clients in patent infringement litigation and has litigated patents regarding magnetic storage density, digital imaging, and video compression technology. In particular, Roberto was part of K&L Gates' core team representing Carnegie Mellon University (CMU) in the *CMU v. Marvell Technology Group* case. Following the Federal Circuit's affirmance of the infringement and validity jury verdicts, the defendant agreed to pay the firm's client, CMU, \$750 million—the largest patent infringement settlement ever for computer science patents.

Roberto also played a role in *Apple v. Kodak* patent litigation involving digital cameras and image processing technology and represented complainants and respondents in section 337 intellectual property infringement investigations brought before the ITC, including obtaining a judgment of non-infringement, invalidity, and no domestic industry against Apple.

PTO Litigation: Another substantial portion of Roberto's practice involves Patent Office post-grant proceeding including *Inter Partes Review* (IPR) and reexamination proceedings including in the context of litigation and product development strategy.

Patent Procurement: Roberto's practice also encompasses the preparation and prosecution of patent applications for a range of technologies including electrical and electronic systems including computers, microprocessors, semiconductor memory devices, software, firmware, internet, nanotechnology, disk drives, wired and RF wireless telecommunications devices and equipment, smartphones, routers, switches, timing error recovery, Viterbi sequence detectors, global positioning systems, optics, digital imaging and compression, and medical devices.

Client Counseling: In addition, Roberto's practice involves counseling clients on patent matters, such as developing patent portfolios, non-infringement and freedom-to-use counseling and opinions, and negotiating

business transactions. Roberto's practice also encompasses the analysis and preparation of non-infringement, patentability, and freedom-to-use opinions for various technologies including industrial automation systems, haptic touch feedback devices, mobile devices, spectrum analyzers, and medical devices.

PROFESSIONAL BACKGROUND

Prior to joining the firm, Roberto held various positions as a patent agent and as an electronics design engineer where he designed microprocessor embedded systems including telecommunication devices, sensors, and instruments for various industries including energy measurement and distribution systems. In particular, Roberto developed hardware, software, and firmware for smart meters, flow computers, and telecommunications equipment development.

ACHIEVEMENTS

- Listed as a leader in Pennsylvania IP Prosecution, *IAM Patent 1000*, 2020-present

PROFESSIONAL / CIVIC ACTIVITIES

- American Intellectual Property Law Association (AIPLA) (Member 2005 – Present)
- AIPLA Membership Committee and Committee on Board Nominations (2014 – Present)
- AIPLA Emerging Technologies Committee (Chair, 2013 – 2014; Vice Chair, 2011 – 2013)
- AIPLA Intellectual Property Practice in Latin America Committee (Chair, 2009 – 2011; Vice Chair, 2007 – 2009)

SPEAKING ENGAGEMENTS

- Panelist, "Interested in Intellectual Property ("IP") Law?" Carnegie Mellon University, January 13, 2010.
- Moderator, "A Global Perspective of IP Licensing - A Comparative Discussion; Do's and Don'ts; and How Recent Developments Have Changed Licensing Practices Around the World," American International Property Law Association (AIPLA) Annual Meeting, October 21, 2009.

EDUCATION

- J.D., William Mitchell College of Law, 2002 (*cum laude*)
- B.S., University of Pittsburgh, 1985 (*Electrical Engineering*)

ADMISSIONS

- Bar of Pennsylvania

- Not Admitted in California
- United States Patent and Trademark Office

LANGUAGES

- Italian

NEWS & EVENTS

- 1 August 2023, K&L Gates Intellectual Property Practice Listed Among Leaders in 2023 IAM Patent 1000 Rankings
- 11 July 2022, K&L Gates Intellectual Property Practice Recognized Among Leaders in 2022 IAM Patent 1000 Rankings
- 12 August 2021, K&L Gates Intellectual Property Practice Again Ranked Among Leaders in 2021 IAM Patent 1000
- 5 August 2020, K&L Gates Intellectual Property Practice Ranked Among Leaders in 2020 IAM Patent 1000

AREAS OF FOCUS

- IP Procurement and Portfolio Management
- IP Litigation
- Post-Grant Patents
- Technology Transactions and Sourcing

INDUSTRIES

- Digital Health
- Health Care Sector