UNITED STATES SENATE
COMMITTEE ON THE JUDICIARY

QUESTIONNAIRE FOR JUDICIAL NOMINEES

PUBLIC

1. **Name**: State full name (include any former names used).

   Raymond T. Chen

2. **Position**: State the position for which you have been nominated.

   United States Circuit Judge for the Federal Circuit

3. **Address**: List current office address. If city and state of residence differs from your place of employment, please list the city and state where you currently reside.

   United States Patent and Trademark Office
   Office of the Solicitor
   600 Dulany Street
   Alexandria, Virginia 22314

   Residence: Bethesda, Maryland

4. **Birthplace**: State year and place of birth.

   1968; New York, New York

5. **Education**: List in reverse chronological order each college, law school, or any other institution of higher education attended and indicate for each the dates of attendance, whether a degree was received, and the date each degree was received.

   1991 – 1994, New York University School of Law; J.D., 1994

   1986 – 1990, University of California, Los Angeles; B.S., 1990

6. **Employment Record**: List in reverse chronological order all governmental agencies, business or professional corporations, companies, firms, or other enterprises, partnerships, institutions or organizations, non-profit or otherwise, with which you have been affiliated as an officer, director, partner, proprietor, or employee since graduation from college, whether or not you received payment for your services. Include the name and address of the employer and job title or description.

   1998 – Present
   United States Patent and Trademark Office

Office of the Solicitor
600 Dulany Street
Alexandria, Virginia 22314
Deputy General Counsel for Intellectual Property Law and Solicitor (2008 – Present)
Associate Solicitor (1998 – 2008)

1996 – 1998
United States Court of Appeals for the Federal Circuit
717 Madison Place, NW
Washington, DC 20439
Technical Assistant

Summer 1993, 1994 – 1996
Knobbe, Martens, Olson & Bear
2040 Main Street, 14th Floor
Irvine, California 92614
Associate (1994 – 1996)
Summer Associate (Summer 1993)

Summer 1992
Pretty, Schroeder, Bruggemann & Clark (now dissolved)
444 South Flower Street
Los Angeles, California 90017
Summer Associate

1989 – 1991
Hecker & Harriman (now Hecker Law Group)
1925 Century Park East, Suite 2300
Los Angeles, California 90067
Scientist

7. **Military Service and Draft Status**: Identify any service in the U.S. Military, including dates of service, branch of service, rank or rate, serial number (if different from social security number) and type of discharge received, and whether you have registered for selective service.

   I have not served in the military. I am registered for selective service.

8. **Honors and Awards**: List any scholarships, fellowships, honorary degrees, academic or professional honors, honorary society memberships, military awards, and any other special recognition for outstanding service or achievement.

   Attorney of the Year, Office of the Solicitor (2002)

   Bronze Medal Award, United States Department of Commerce (2005)

Eta Kappa Nu (electrical engineering honor society) (1989 – 1990)

Gold Medal Award, United States Department of Commerce (2011)

Tau Beta Pi (engineering honor society) (1989 – Present)

United Technologies Scholarship (1986 – 1990)

9. **Bar Associations**: List all bar associations or legal or judicial-related committees, selection panels or conferences of which you are or have been a member, and give the titles and dates of any offices which you have held in such groups.

Advisory Council for the U.S. Court of Appeals for the Federal Circuit (2011 – Present)

American Intellectual Property Law Association (1994 – 1997)

Asian Pacific American Bar Association, Washington, DC Chapter (2012 – Present)

Federal Circuit Bar Association (2007 – Present)
Patent and Trademark Office Committee (2009 – 2011)

10. **Bar and Court Admission**:

a. List the date(s) you were admitted to the bar of any state and any lapses in membership. Please explain the reason for any lapse in membership.

California, 1994 (inactive since January 1, 1998)
District of Columbia, 1997

There have been no lapses in membership, although as indicated, my membership in California is inactive.

b. List all courts in which you have been admitted to practice, including dates of admission and any lapses in membership. Please explain the reason for any lapse in membership. Give the same information for administrative bodies that require special admission to practice.

Supreme Court of the United States, 2009
District of Columbia Court of Appeals, 1997
Supreme Court of California, 1994
United States Patent and Trademark Office, 1996 (inactive)

There have been no lapses in membership.

11. **Memberships**:

a. List all professional, business, fraternal, scholarly, civic, charitable, or other organizations, other than those listed in response to Questions 9 or 10 to which you belong, or to which you have belonged, since graduation from law school. Provide dates of membership or participation, and indicate any office you held. Include clubs, working groups, advisory or editorial boards, panels, committees, conferences, or publications.

Elementary School Parent Teacher Association (2005 – Present)

Middle School Parent Teacher Association (2010 – Present)

Mohican Swimming Pool Association (2006 – Present)

U.S. Patent and Trademark Office Asian Pacific American Network
Executive Advisor (2011 – Present)

b. The American Bar Association's Commentary to its Code of Judicial Conduct states that it is inappropriate for a judge to hold membership in any organization that invidiously discriminates on the basis of race, sex, or religion, or national origin. Indicate whether any of these organizations listed in response to 11a above currently discriminate or formerly discriminated on the basis of race, sex, religion or national origin either through formal membership requirements or the practical implementation of membership policies. If so, describe any action you have taken to change these policies and practices.

To the best of my knowledge, none of these organizations listed above currently discriminates or previously discriminated on the basis of race, sex, religion, or national origin, either through formal membership requirements or through the practical implementation of membership policies.

12. **Published Writings and Public Statements**:

a. List the titles, publishers, and dates of books, articles, reports, letters to the editor, editorial pieces, or other published material you have written or edited, including material published only on the Internet. Supply four (4) copies of all published material to the Committee.

The Broad Discretion of Arbitrators to Award Remedies: the Intel Decision, 1 Computer and Telecommunications Law Review 129 (1995). Copy supplied.

b. Supply four (4) copies of any reports, memoranda or policy statements you prepared or contributed in the preparation of on behalf of any bar association, committee, conference, or organization of which you were or are a member. If you do not have a copy of a report, memorandum or policy statement, give the

name and address of the organization that issued it, the date of the document, and a summary of its subject matter.

Privacy Impact Assessment, United States Patent and Trademark Office, February 24, 2010. Copy supplied.

c. Supply four (4) copies of any testimony, official statements or other communications relating, in whole or in part, to matters of public policy or legal interpretation, that you have issued or provided or that others presented on your behalf to public bodies or public officials.

In 2002, I participated as an observer for the United States Patent and Trademark Office at a series of joint hearings held by the Federal Trade Commission and Department of Justice on the intersection between competition law and intellectual property law and policy. I was not a presenter but occasionally offered oral comments to clarify the USPTO's perspectives and practices, particularly when I thought that presenters misunderstood the USPTO position. I have no notes, transcript, or recording from these hearings. A copy of the Federal Trade Commission's final report is supplied.

d. Supply four (4) copies, transcripts or recordings of all speeches or talks delivered by you, including commencement speeches, remarks, lectures, panel discussions, conferences, political speeches, and question-and-answer sessions. Include the date and place where they were delivered, and readily available press reports about the speech or talk. If you do not have a copy of the speech or a transcript or recording of your remarks, give the name and address of the group before whom the speech was given, the date of the speech, and a summary of its subject matter. If you did not speak from a prepared text, furnish a copy of any outline or notes from which you spoke.

November 16, 2012: Moderator for panel on "Patent Law: Perspectives from the Bench," at the National Asian Pacific American Bar Association (NAPABA) 2012 Annual Convention, held in Washington, DC. Outline supplied.

October 11-12, 2012: Member of three panels discussing litigation issues arising from the recently-enacted America Invents Act at the 13th Annual Sedona Conference on Patent Litigation, held in Del Mar, California. My comments during the panel discussions addressed the new post-grant opposition procedures available at the Patent Office, and claim construction. Notes supplied.

September 24, 2012: Luncheon address at a patent law conference sponsored by Knobbe, Martens, Olson & Bear in Palo Alto, California. My talk concerned the Patent Office's efforts to implement various elements of the America Invents Act, including establishing a new satellite office in Silicon Valley. I also was a member of a panel on "Dealing Strategically with the America Invents Act." Luncheon address notes supplied.

September 19, 2012: Member of panel previewing important intellectual property litigation cases to be addressed in the coming year, held at Catholic University School of Law in Washington, DC. I presented a summary of the *Already v. Nike* case, which was pending at the Supreme Court. A webcast video of the panel is available at http://video.law.edu/patentlitigation.cfm.

July 27, 2012: Member of a panel on "Multiple Systems for Challenging Validity: Roles of USPTO and Courts," at the 2012 High Technology Protection Summit, Center for Advanced Study & Research on Intellectual Property (CASRIP), held at University of Washington School of Law in Seattle, Washington. PowerPoint presentation supplied.

May 30, 2012: Mock appellate argument before a panel of Federal Circuit judges, co-sponsored by the Federal Circuit Bar Association and China Law Society, held at Renmin University in Beijing, China. The mock argument was designed to educate Chinese patent lawyers and judges from the intellectual property division of the Supreme People's Court about oral argument at the Federal Circuit. I have no notes, transcript, or recording. The address of the Federal Circuit Bar Association is 1620 I Street, NW, Suite 801, Washington, DC 20006.

May 21, 2012: Member of a panel on "The PTO/District Court Interface," at the Patent Institutions Summit, held at Stanford Law School in Palo Alto, California. A webcast video of the panel is available at http://www.youtube.com/watch?v=KnipvEXdiIM.

May 18, 2012: Member of a panel on recent developments on patent law in the United States and Germany at the 2012 German-U.S. Bench & Bar Conference, sponsored by the Federal Circuit Bar Association, held in Washington, DC. I have no notes, transcript, or recording. The address of the Federal Circuit Bar Association is 1620 I Street, NW, Suite 801, Washington, DC 20006.

April 27, 2012: Member of a panel on "Judicial Oversight in Patents and Antitrust," held at Duke University School of Law in Durham, North Carolina. The panel focused on the institutional relationship between the Federal Circuit and the Patent Office. I have no notes, transcript, or recording. The address of Duke University School of Law is 210 Science Drive, Box 90362, Durham, NC 27708.

April 18, 2012: Luncheon address at the Austin Intellectual Property Law Association, held in Austin, Texas. My talk addressed the Patent Office's efforts to implement various aspects of the America Invents Act and provide guidance on handling patent-eligibility issues. I have no notes, transcript, or recording. The Association does not have a physical address.

April 17, 2012: Member of a panel discussing the patentability of medical diagnostic methods, sponsored by the Biotechnology Industry Organization

(BIO), held in Austin, Texas. I discussed the Supreme Court's opinion in *Mayo Collaborative Servs. v. Prometheus Labs, Inc.* I have no notes, transcript, or recording. The address of BIO is 1201 Maryland Avenue, SW, Washington, DC 20024.

March 23, 2012: Member of a panel at a CLE event about the impact of the America Invents Act on patent litigation, sponsored by the New York Intellectual Property Law Association (NYIPLA), held in New York, New York. I discussed the interaction between the Patent Office's new post-grant opposition procedures and district court patent infringement litigation. I have no notes, transcript, or recording. NYIPLA's address is 2125 Center Avenue, Suite 406, Fort Lee, NJ 07024.

March 9, 2012: Member of a panel on "Interpreting and Implementing the America Invents Act and Considering Related Ethical Issues," at the Ninth Annual Intellectual Property Law Seminar, Institute of Intellectual Property & Social Justice, Howard University School of Law, held in Washington, DC. I discussed the inequitable conduct doctrine and the new supplemental examination procedure provided by the America Invents Act, and gave a short summary on the state of the Patent Office. I have no notes, transcript, or recording, but press coverage is provided. Howard University School of Law's address is 2900 Van Ness Street, NW, Washington, DC 20008.

February 24, 2012: Member of a panel at a CLE event about Section 101 of the Patent Act and patent-eligible subject matter, sponsored by Suffolk University Law School, held in Boston, Massachusetts. I discussed recent relevant case law and the Patent Office's guidelines on patent-eligibility. I have no notes, transcript, or recording. Suffolk University Law School's address is 120 Tremont Street, Boston, MA 02108.

January 19, 2012: Member of a panel discussing Section 101 of the Patent Act and patent-eligible subject matter, sponsored by the Advanced Patent Law Institute, University of Texas School of Law Office of Continuing Legal Education (UTCLE), held in Alexandria, Virginia. I discussed recent relevant case law and the Patent Office's guidelines on patent-eligibility. I have no notes, transcript, or recording. UTCLE's address is 727 East Dean Keeton Street, Austin, TX 78705.

January 17, 2012: Member of a panel discussing the state of patent litigations in the smartphone market, sponsored by the Internet Caucus Advisory Committee, held in Washington, DC. An audio recording of the panel is available at http://www.netcaucus.org/conference/2012/patent.shtml.

November 18, 2011: Member of a panel on important changes in intellectual property law at the National Asian Pacific American Bar Association's

(NAPABA) 2011 Annual Convention, held in Atlanta, Georgia. I discussed various aspects of the America Invents Act. PowerPoint presentation supplied.

October 27, 2011: Mock appellate argument before a panel of Federal Circuit judges, sponsored by the Federal Circuit Bar Association, held in Tokyo, Japan. The mock argument was designed to educate Japanese patent lawyers and judges from the Tokyo Intellectual Property High Court about oral argument at the Federal Circuit. Outline supplied.

October 24, 2011: Presentation to Taiwanese patent examiners and management on U.S. patent law, examination issues, and the role of the Office of the Solicitor in the Patent Office, held at the Taiwan Intellectual Property Office (TIPO) in Taipei, Taiwan. PowerPoint presentation supplied.

October 20, 2011: Member of a panel discussing the Patent Office's views on Sections 101 and 112 of the Patent Act at the 2011 American Intellectual Property Law Association (AIPLA) Annual Meeting, held in Washington, DC. PowerPoint presentation supplied.

October 12, 2011: Luncheon address at the Fifth Annual Symposium on Patent Law and Pharmaceuticals, held at Rutgers Law School. I discussed current trends in patent law. Notes supplied.

September 13, 2011: Member of a panel about the inequitable conduct doctrine in light of the Federal Circuit's *en banc* decision in *Therasense v. Becton Dickinson*, at the Intellectual Property Owners Association (IPO) 2011 Annual Meeting, held in Los Angeles, California. I discussed the Patent Office's position as well as its consideration of an amendment to its regulations. I have no notes, transcript, or recording, but press coverage is provided. IPO's address is 1501 M Street, NW, Washington, DC 20005.

August 16, 2011: Member of a panel about the inequitable conduct doctrine in light of the Federal Circuit's *en banc* decision in *Therasense v. Becton Dickinson*, at the American Intellectual Property Law Association's (AIPLA) Electronics and Computer Patent Law Summit 2011, held in St. Paul, Minnesota. I discussed the Patent Office's position as well as its consideration of an amendment to its regulations. I have no notes, transcript, or recording. AIPLA's address is 241 18th Street South, Suite 700, Arlington, VA 22202.

August 6, 2011: Member of a panel about the patentability of business method patents, at the American Bar Association (ABA) Annual Meeting – Intellectual Property Law Section, held in Toronto, Canada. I discussed the Patent Office's examination guidelines on patent-eligibility. I have no notes, transcript, or recording. The ABA's address is 321 North Clark Street, Chicago, IL 60654.

June 23, 2011: Member of a panel about the role of government and intellectual property in stimulating innovation, at the Federal Circuit Bar Association's 13th Annual Bench & Bar Conference, held in Key Biscayne, Florida. I have no notes, transcript, or recording, but press coverage is provided. The address of the Federal Circuit Bar Association is 1620 I Street, NW, Suite 801, Washington, DC 20006.

May 25, 2011: Member of a panel about the pending legislation that later became the America Invents Act, at a CLE event sponsored by World Research Group, held in New York, New York. PowerPoint presentation supplied.

April 28, 2011: Member of a panel about developments in patent case law, at the 19th Annual Conference, Intellectual Property Law & Policy, Fordham Intellectual Property Law Institute, held in New York, New York. I discussed the Supreme Court's recent decision in *Microsoft v. i4i*, 131 S.Ct. 2238 (2011). I have no notes, transcript, or recording. The address of Fordham Law School is 140 West 62nd Street, New York, NY 10023.

March 11, 2011: Member of a panel about the inequitable conduct doctrine during the pendency of the Federal Circuit's *en banc* decision in *Therasense v. Becton Dickinson*, at the Eighth Annual Intellectual Property Law Seminar, Institute of Intellectual Property & Social Justice, Howard University School of Law, held in Washington, DC. I have no notes, transcript, or recording. Howard University School of Law's address is 2900 Van Ness Street, NW, Washington, DC 20008.

January 27, 2011: Member of a panel about the inequitable conduct doctrine during the pendency of the Federal Circuit's *en banc* decision in *Therasense v. Becton Dickinson*, at the Los Angeles Intellectual Property Law Association (LAIPLA) Washington in the West Conference, held in Los Angeles, California. I have no notes, transcript, or recording. LAIPLA has no physical address.

November 22, 2010: Member of a panel about the PTO's Solicitor's Office and possible careers in intellectual property law in the government, at the University of Maryland School of Law in Baltimore, Maryland. I have no notes, transcript, or recording. The University of Maryland School of Law's address is 500 West Baltimore Street, Baltimore, MD 21201.

November 9, 2010: Member of a panel discussing *Therasense v. Becton Dickinson*, held at Catholic University School of Law in Washington, DC. A webcast of the video is available at http://video.law.edu/therasense.cfm.

October 21-22, 2010: Member of two panels about the interaction between reexamination and patent litigation and patentability issues arising from Sections 101 and 112 of the Patent Act, at the 11th Annual Sedona Conference on Patent Litigation, held in Phoenix, Arizona. I have no notes, transcript, or recording.

The address of the Sedona Conference is 5150 North 16th Street, Suite A-215, Phoenix, AZ 85016.

October 6, 2010: Member of a panel about the patent-eligibility of business methods in view of the Supreme Court's decision in *Bilski v. Kappos*, at the International Bar Association 2010 Conference, held in Vancouver, Canada. PowerPoint presentation supplied.

September 23, 2010: Speaker at the USPTO's Business Method Partnership Meeting, discussing the Federal Circuit's case law and the agency's examination guidelines on patent-eligibility, held in Alexandria, Virginia. PowerPoint presentation supplied.

July 23, 2010: Member of a panel about patent-eligibility under Section 101 of the Patent Act, at the 2010 High Technology Protection Summit, Center for Advanced Study & Research on Intellectual Property (CASRIP), held at the University of Washington School of Law, in Seattle, Washington. I discussed the Patent Office's efforts to conform its examination guidelines to follow the Supreme Court's decision in *Bilski v. Kappos*. I have no notes, transcript, or recording. The University of Washington School of Law's address is William H. Gates Hall, Box 353020, Seattle, WA 98195.

June 26, 2010: Member of a panel about patent law's effects on innovation and competition at the Federal Circuit Bar Association's 12th Annual Bench and Bar Conference, held in Colorado Springs, Colorado. I have no notes, transcript, or recording. The address of the Federal Circuit Bar Association is 1620 I Street, NW, Suite 801, Washington, DC 20006.

May 26, 2010: Co-moderator of a panel on "Permanent Injunctions in the District Courts and ITC: Effects on Competition and Innovation," at a joint roundtable conference co-sponsored by the Federal Trade Commission, Department of Justice, Antitrust Division, and the Patent Office, held in Alexandria, Virginia. I have no notes, transcript, or recording, but press coverage of the event is supplied. The address of the U.S. Patent and Trademark Office is 600 Dulany Street, Alexandria, VA 22314.

April 21, 2010: Member of a panel about the then-pending Supreme Court decision in *Bilski v. Kappos*, at the American Bar Association (ABA) Antitrust Law Section Spring Meeting, held in Washington, DC. I presented the agency's perspective on the case. I have no notes, transcript, or recording. The ABA's address is 321 North Clark Street, Chicago, IL 60654.

February 9, 2010: Speaker at the Santa Clara High Tech Law Institute at Santa Clara Law School about recent Patent Office initiatives and litigations. Transcript supplied.

December 7, 2009: Member of a panel about the then-pending Supreme Court decision in *Bilski v. Kappos*, at the Intellectual Property Owners Association (IPO) 20th Annual Conference on USPTO Law and Practice: PTO Day, held in Washington, DC. I presented the agency's perspective about the case. I have no notes, transcript, or recording, but press coverage is supplied. The IPO's address is 1501 M Street, NW, Washington, DC 20005.

November 19, 2009: Member of a panel about the then-pending Supreme Court decision in *Bilski v. Kappos*, at the American University, Washington College of Law, held in Washington, DC. I presented the agency's perspective about the case. A webcast video of the panel is available at http://www.wcl.american.edu/pijip/go/bilski-nov2009.

January 29, 2009: Member of a panel about the then-pending Supreme Court decision in *Bilski v. Kappos*, at the Los Angeles Intellectual Property Law Association (LAIPLA) Washington in the West Conference, held in Los Angeles, California. I presented the agency's perspective about the case. I have no notes, transcript, or recording. LAIPLA has no physical address.

January 14, 2009: Member of a panel about abstract patents and Section 101 of the Patent Act, at the Brookings Institution, held in Washington, DC. Transcript supplied.

November 20, 2008: Speaker at the Cardozo School of Law IP Speaker Series on "Recalibrating Perceptions of Patent Eligible Subject Matter," held in New York, New York. Notes supplied.

November 13, 2008: Member of a panel discussing recent Federal Circuit and USPTO Patent Board decisions on patent-eligible subject matter as well as the agency's recent examination guidelines on that same subject, sponsored by the Advanced Patent Law Institute, University of Texas School of Law Office of Continuing Legal Education (UTCLE), held in Alexandria, Virginia. I have no notes, transcript, or recording. UTCLE's address is 727 East Dean Keeton Street, Austin, TX 78705.

October 15, 2008: Speaker at a CLE event about patent-eligible subject matter and Section 101 of the Patent Act, sponsored by the Patent Law Institute, held in San Francisco, California. PowerPoint presentation supplied.

July 29, 2008: Member of a panel at a CLE event about the patentability of business methods in light of *In re Bilski* (*en banc*), sponsored by World Research Group, held in New York, New York. I have no notes, transcript, or recording. World Research Group's address is 16 East 40th Street, 5th Floor, New York, NY 10016.

May 22, 2008: Member of a panel at a CLE event about the Federal Circuit *en banc* argument in *In re Bilksi*, sponsored by the Federal Circuit Bar Association, held in Washington, DC. A webcast video of the panel is available at https://fedcirbar.webex.com/tc0506l/trainingcenter/record/downloadViewAction.do?recordId=25072232&siteurl=fedcirbar&actionType=view&setted=102&Rnd=0.5331058738883625.

March 7, 2008: Presentation on patent-eligible subject matter and Section 101 of the Patent Act at the Fifth Annual Intellectual Property Law Seminar, Institute of Intellectual Property & Social Justice, Howard University School of Law, held in Washington, DC. PowerPoint presentation supplied.

November 29, 2007: Member of a panel about current issues in reexamination proceedings at the Patent Office, at the 8th Annual Advanced Patent Law Institute, University of Texas School of Law Office of Continuing Legal Education, held in San Jose, California. Partial PowerPoint presentation supplied.

November 5, 2007: Member of a panel about Federal Circuit case law developments, at Cardozo School of Law in New York, New York. I have no notes, transcript, or recording. Cardozo School of Law's address is 55 Fifth Avenue, New York, NY 10003.

August 14, 2007: Member of a panel about patent reform issues being considered by Congress, sponsored by the Electronics Industry Alliance, held in Hot Springs, Virginia. I have no notes, transcript, or recording. EIA ceased operations in February 2011 and has no physical address.

March 9, 2006: Presenter on intellectual property litigation and the relationship between appellate and trial courts in the United States, and mock oral argument for judges from countries that comprise the Association of Southeast Asian Nations, sponsored by the U.S. Patent and Trademark Office, held in Bangkok, Thailand. PowerPoint presentations supplied.

July 22, 2005: Member of a panel about patent reform legislation under consideration in Congress, at the 2005 High Technology Protection Summit, Center for Advanced Study & Research on Intellectual Property (CASRIP) University of Washington School of Law, held in Seattle, Washington. I spoke about the proposed post patent grant opposition procedures. PowerPoint presentation supplied.

November 23, 2004: Member of a panel about developments in Federal Circuit case law, at Cardozo School of Law in New York, New York. I have no notes, transcript, or recording. Cardozo School of Law's address is 55 Fifth Avenue, New York, NY 10003.

June 7, 2003: Member of a panel about preliminary injunctions in patent cases at the Los Angeles Intellectual Property Law Association (LAIPLA) Spring Conference, held in La Jolla, California. I also performed a mock oral argument at this event. I have no notes, transcript, or recording. LAIPLA has no physical address.

April 21, 2001: Member of a panel about business method patent examination and litigation, sponsored by the Beverly Hills Bar Association, held in Los Angeles, California. I have no notes, transcript, or recording. The Association has no physical address.

May 18, 2000: Member of a panel discussing litigation and examination issues relating to means-plus-function claiming and 35 U.S.C. Section 112, paragraph 6, at the American Intellectual Property Law Association (AIPLA) Spring Conference, held in Pittsburgh, Pennsylvania. I have no notes, transcript, or recording. AIPLA's address is 241 18th Street South, Suite 700, Arlington, VA 22202.

March 29, 2000: Member of a panel at a CLE event about business method patents and the Patent Office's recent examination guidelines on means-plus-function claims, sponsored by the San Francisco Intellectual Property Law Association, held in San Francisco, California. I have no notes, transcript, or recording. The Association's address is 237 Kearny Street, #123, San Francisco, CA 94108.

Teaching: In July 2001, 2002, and 2004 to 2007, I taught "Advanced Patentability Issues" at the Summer Institute for the Center for Advanced Study & Research on Intellectual Property, at the University of Washington School of Law. The course each time comprised two two-hour lectures covering numerous patentability issues. A PowerPoint presentation, which did not substantially change over the years, is supplied.

Guest Lectures: I have served as a guest lecturer about five times over the last 10 years in the patent law class that Chief Judge Rader and former Solicitor John Whealan teach at George Washington University Law School. The subjects I covered in these lectures included novelty, obviousness, and patent prosecution procedure. I have no notes, transcript, or recording. The address of the George Washington School of Law is 2000 H Street, NW, Washington, DC 20052.

e. List all interviews you have given to newspapers, magazines or other publications, or radio or television stations, providing the dates of these interviews and four (4) copies of the clips or transcripts of these interviews where they are available to you.

Gene Quinn, *Interview Finale: USPTO Attorneys Knight and Ray*, www.ipwatchdog.com, September 29, 2012. Copy supplied.

Gene Quinn, *Exclusive Interview: USPTO Attorneys Bernie Knight and Ray Chen*, www.ipwatchdog.com, September 27, 2012. Copy supplied.

Dolly Y. Wu & Steven M. Geiszler, *Patentable Subject Matter: What is the Matter with Matter?*, 15 Va. J.L. & Tech. 101 (2010). Copy supplied.

13. **Judicial Office**: State (chronologically) any judicial offices you have held, including positions as an administrative law judge, whether such position was elected or appointed, and a description of the jurisdiction of each such court.

I have not held any judicial office.

a. Approximately how many cases have you presided over that have gone to verdict or judgment? _____

i. Of these, approximately what percent were:

jury trials:	___%
bench trials:	___% [total 100%]
civil proceedings:	___%
criminal proceedings:	___% [total 100%]

b. Provide citations for all opinions you have written, including concurrences and dissents.

c. For each of the 10 most significant cases over which you presided, provide: (1) a capsule summary of the nature the case; (2) the outcome of the case; (3) the name and contact information for counsel who had a significant role in the trial of the case; and (3) the citation of the case (if reported) or the docket number and a copy of the opinion or judgment (if not reported).

d. For each of the 10 most significant opinions you have written, provide: (1) citations for those decisions that were published; (2) a copy of those decisions that were not published; and (3) the names and contact information for the attorneys who played a significant role in the case.

e. Provide a list of all cases in which certiorari was requested or granted.

f. Provide a brief summary of and citations for all of your opinions where your decisions were reversed by a reviewing court or where your judgment was affirmed with significant criticism of your substantive or procedural rulings. If any of the opinions listed were not officially reported, provide copies of the opinions.

g. Provide a description of the number and percentage of your decisions in which you issued an unpublished opinion and the manner in which those unpublished opinions are filed and/or stored.

h. Provide citations for significant opinions on federal or state constitutional issues, together with the citation to appellate court rulings on such opinions. If any of the opinions listed were not officially reported, provide copies of the opinions.

i. Provide citations to all cases in which you sat by designation on a federal court of appeals, including a brief summary of any opinions you authored, whether majority, dissenting, or concurring, and any dissenting opinions you joined.

14. **Recusal:** If you are or have been a judge, identify the basis by which you have assessed the necessity or propriety of recusal (If your court employs an "automatic" recusal system by which you may be recused without your knowledge, please include a general description of that system.) Provide a list of any cases, motions or matters that have come before you in which a litigant or party has requested that you recuse yourself due to an asserted conflict of interest or in which you have recused yourself sua sponte. Identify each such case, and for each provide the following information:

a. whether your recusal was requested by a motion or other suggestion by a litigant or a party to the proceeding or by any other person or interested party; or if you recused yourself sua sponte;

b. a brief description of the asserted conflict of interest or other ground for recusal;

c. the procedure you followed in determining whether or not to recuse yourself;

d. your reason for recusing or declining to recuse yourself, including any action taken to remove the real, apparent or asserted conflict of interest or to cure any other ground for recusal.

I have not held any judicial office.

15. **Public Office, Political Activities and Affiliations**:

a. List chronologically any public offices you have held, other than judicial offices, including the terms of service and whether such positions were elected or appointed. If appointed, please include the name of the individual who appointed you. Also, state chronologically any unsuccessful candidacies you have had for elective office or unsuccessful nominations for appointed office.

I have not held any public office. I have not had any unsuccessful candidacies for elective office or unsuccessful nominations for appointed office.

b. List all memberships and offices held in and services rendered, whether compensated or not, to any political party or election committee. If you have ever

held a position or played a role in a political campaign, identify the particulars of the campaign, including the candidate, dates of the campaign, your title and responsibilities.

I have not held office in or rendered services to any political party or election committee. I have not held a position or played a role in any political campaign.

16. **Legal Career:** Answer each part separately.

a. Describe chronologically your law practice and legal experience after graduation from law school including:

i. whether you served as clerk to a judge, and if so, the name of the judge, the court and the dates of the period you were a clerk;

I have not served as a clerk to a judge.

ii. whether you practiced alone, and if so, the addresses and dates;

I have never practiced law alone.

iii. the dates, names and addresses of law firms or offices, companies or governmental agencies with which you have been affiliated, and the nature of your affiliation with each.

1994 – 1996
Knobbe, Martens, Olson & Bear
2040 Main Street, 14th Floor
Irvine, CA 92614
Associate

1996 – 1998
United States Court of Appeals for the Federal Circuit
717 Madison Place, NW
Washington, DC 20439
Technical Assistant

1998 – Present
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314
Deputy General Counsel for Intellectual Property Law and Solicitor (2008 – Present)
Associate Solicitor (1998 – 2008)

iv. whether you served as a mediator or arbitrator in alternative dispute resolution proceedings and, if so, a description of the 10 most significant matters with which you were involved in that capacity.

I have never served as an arbitrator or mediator in alternative dispute resolution proceedings.

b. Describe:

i. the general character of your law practice and indicate by date when its character has changed over the years.

My practice has been focused on intellectual property law, with a primary emphasis on patent appellate litigation.

In my first two years of practice, as an associate at Knobbe, Martens, Olson & Bear from 1994 to 1996, I drafted a number of district court briefs and legal memoranda on specific patent and trademark issues. In addition, I drafted several patent applications spanning various technologies, as well as amendments and responses to actions from the Patent Office.

In 1996, I moved to Washington and joined the Senior Technical Assistant's Office at the Federal Circuit as one of three technical assistants. I researched and wrote memoranda commenting on drafts of court opinions for both legal and technical accuracy as well as identification of conflicting legal precedent. I also performed legal research and writing for individual judges occasionally.

From 1998 to 2008, I served as an Associate Solicitor in the Office of the Solicitor at the United States Patent and Trademark Office. During that time, I was first or second chair on several dozen Federal Circuit briefs defending the agency's patent and trademark decisions, and presented approximately 20 arguments in the Federal Circuit. I also regularly appeared in district court defending the agency against lawsuits brought under the Administrative Procedure Act. In addition, I was a legal advisor on several patent policy and legal issues within the agency. Another aspect of my duties was occasionally prosecuting patent attorneys, who were members of the agency's patent bar, in administrative proceedings for violating the agency's code of professional responsibility.

Since 2008, when I was selected to become the Deputy General Counsel of Intellectual Property Law and Solicitor, I have been supervising the litigation work of the other lawyers in the Solicitor's Office, and have presented oral arguments less frequently. Besides editing briefs and assisting others in formulating strategy and arguments, I deal with higher

level patent and trademark policy issues within the agency. I also coordinate and participate in discussions with lawyers from other parts of the government in determining what positions the United States should take as an *amicus* in intellectual property cases before both the Supreme Court and the Federal Circuit. Furthermore, I am responsible for the review and clearance of all new regulations and amendments to existing regulations for the Office of the Solicitor.

ii. your typical clients and the areas at each period of your legal career, if any, in which you have specialized.

During my two years as an associate at Knobbe, Martens, Olson & Bear from 1994 to 1996, I did patent work for a wide array of clients from fields including computer software, computer hardware, semiconductor devices, medical devices, and mechanical and electro-mechanical inventions. In the trademark area, I represented clients in the furniture and clothing industries.

Since I joined the United States Patent and Trademark Office in 1998, my client has been the agency and the United States.

c. Describe the percentage of your practice that has been in litigation and whether you appeared in court frequently, occasionally, or not at all. If the frequency of your appearances in court varied, describe such variance, providing dates.

In my first two years of practice, as an associate at a law firm, about 50% of my work was litigation, drafting pleadings, developing theories and researching issues. I did not appear in court.

At the United States Patent and Trademark Office, my work has been 70-75% litigation, primarily in the Federal Circuit. A small percentage of my litigation work has been directed to disciplinary proceedings before an administrative law judge.

i. Indicate the percentage of your practice in:
   1. federal courts: 95%
   2. state courts of record: 0%
   3. other courts: 0%
   4. administrative agencies: 5%

ii. Indicate the percentage of your practice in:
   1. civil proceedings: 100%
   2. criminal proceedings: 0%

d. State the number of cases in courts of record, including cases before administrative law judges, you tried to verdict, judgment or final decision (rather

than settled), indicating whether you were sole counsel, chief counsel, or associate counsel.

I served as chief counsel in one disciplinary trial before an administrative law judge that went to verdict. I was co-counsel in one civil action in which both sides introduced evidence, and prevailed on summary judgment. Although Administrative Procedure Act (APA) cases are usually based on solely the administrative record and do not go to trial, I have prevailed in numerous APA cases on summary judgment, as either chief counsel or associate counsel.

i. What percentage of these trials were:
   1. jury: 0%
   2. non-jury: 100%

e. Describe your practice, if any, before the Supreme Court of the United States. Supply four (4) copies of any briefs, *amicus* or otherwise, and, if applicable, any oral argument transcripts before the Supreme Court in connection with your practice.

As an Associate Solicitor of the Patent Office from 1998 to 2008, and Solicitor from 2008 to present, I have had significant involvement in formulating the United States' views in the following intellectual property cases:

Retractable Technologies, Inc., et al. v. Becton, Dickinson and Company, No. 11-1154 (cert. denied). Brief for the United States as *amicus curiae*, at the Court's invitation, suggesting denial, http://www.justice.gov/osg/briefs/2012/2pet/6invit/2011-1154.pet.ami.inv.pdf.

GlaxoSmithKline v. Classen Immunotherapies, Inc., No. 11-1078 (cert. denied). Brief for the United States as *amicus curiae*, at the Court's invitation, suggesting denial, http://www.justice.gov/osg/briefs/2012/2pet/6invit/2011-1078.pet.ami.inv.pdf.

Already LLC v. Nike, Inc., No. 11-982, 568 U.S. __ (2013). Brief for the United States as *amicus curiae* supporting vacatur and remand, 2012 WL 3613368.

Bowman v. Monsanto Co., No. 11-796 (cert. granted, pending). Brief for the United States as *amicus curiae*, at the Court's invitation, suggesting denial, 2012 WL 3643767; Brief for the United States as *amicus curiae* supporting affirmance, 2013 WL 137188.

Kappos v. Hyatt, 566 U.S. ___ (2012). Brief for U.S. Patent and Trademark Office as petitioner, 2011 WL 3808356; Reply Brief, 2011 WL 5999274.

Mayo Collaborative Servs. v. Prometheus Labs., Inc., 566 U.S. ___ (2012). Brief for the United States as *amicus curiae*, supporting neither party, 2011 WL 4040414.

Saint-Gobain Ceramics & Plastics, Inc. v. Siemens Medical Solutions USA, Inc., No. 11-301 (cert. denied). Brief for the United States as *amicus curiae*, at the Court's invitation, suggesting denial, 2012 WL 1436668.

Microsoft Corp. v. i4i Ltd. Partnership, 564 U.S. ___ (2011). Brief for the United States, as *amicus curiae*, supporting respondents, 2011 WL 991991.

Applera Corp. v. Enzo Biochem, Inc., No. 10-426 (cert. denied). Brief for the United States as *amicus curiae*, at the Court's invitation, suggesting denial, 2011 WL 1881824.

Bilski v. Kappos, 561 U.S. ___ (2010). Brief for U.S. Patent and Trademark Office as respondent, 2009 WL 3070864.

LabCorp v. Metabolite Labs., Inc., 548 U.S. 124 (2006) (cert. dismissed as improvidently granted). Brief for the United States as *amicus curiae*, 2005 WL 3533248.

Merck KGaA v. Integra Lifesciences I Ltd., 545 U.S. 193 (2005). Brief for United States as *amicus curiae*, supporting petitioner, 2005 WL 429972.

Micrel, Inc. v. Linear Tech. Corp., No. 02-39 (cert. denied). Brief for the United States as *amicus curiae*, at the Court's invitation, suggesting denial, http://www.justice.gov/osg/briefs/2002/2pet/6invit/2002-0039.pet.ami.inv.pdf.

TrafFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23 (2001). Brief for the United States as *amicus curiae*, supporting petitioner, 2000 WL 1236028.

I did not present oral argument in any of the above cases.

17. **Litigation**: Describe the ten (10) most significant litigated matters which you personally handled, whether or not you were the attorney of record. Give the citations, if the cases were reported, and the docket number and date if unreported. Give a capsule summary of the substance of each case. Identify the party or parties whom you represented; describe in detail the nature of your participation in the litigation and the final disposition of the case. Also state as to each case:

    a. the date of representation;

    b. the name of the court and the name of the judge or judges before whom the case was litigated; and

c. the individual name, addresses, and telephone numbers of co-counsel and of principal counsel for each of the other parties.

(1) *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (*en banc*) (before then Chief Judge Michel, and Judges Newman, Mayer, Lourie, Rader, Schall, Bryson, Gajarsa, Linn, Dyk, Prost, and Moore), *aff'd*, *Bilski v. Kappos*, 130 S.Ct. 3218 (2010).

This case involved the fundamental question of what types of process innovations are eligible for patent protection, as governed by 35 U.S.C. Section 101. The Patent Office had rejected Mr. Bilski's process claims, directed to hedging the cost risk of a commodity, for failing to satisfy Section 101 of the Patent Act. I was the lead attorney in defending the agency before the Federal Circuit. I drafted the brief and presented oral argument before the panel. Before rendering a decision, the Federal Circuit *sua sponte* ordered the case to be heard *en banc*. I drafted the agency's *en banc* supplemental brief and argued the case before the *en banc* court. The Federal Circuit affirmed the rejection of the claims. *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (*en banc*). The Supreme Court then granted Mr. Bilski's petition for *certiorari*. Working with co-counsel from the Solicitor General's Office and the Department of Justice, I played a significant role in developing the brief. Deputy Solicitor General Malcolm Stewart argued the case for the agency. The Supreme Court affirmed the Federal Circuit's decision, concluding that the claims violated the abstract idea exception to section 101, but rejected the view that the machine-or-transformation test was the sole test for deciding whether an invention is a patent-eligible "process." *Bilski v. Kappos*, 130 S.Ct. 3218 (2010).

In the Federal Circuit appeal, co-counsel were James A. Toupin, then General Counsel, Stephen Walsh, then Acting Solicitor, and Thomas W. Krause, United States Patent and Trademark Office, 600 Dulany Street, Alexandria, VA 22314, (571) 272-9035; and John J. Fargo, Scott R. McIntosh, and Mark R. Freeman, Department of Justice, 950 Pennsylvania Avenue, NW, Washington, DC 20530, (202) 514-2000.

Opposing counsel in the Federal Circuit appeal was David C. Hanson, The Webb Law Firm, One Gateway Center, 420 Fort Duquesne Boulevard, Suite 1200, Pittsburgh, PA 15222, (412) 471-8815.

In the Supreme Court appeal, co-counsel were Elena Kagan, then Solicitor General, Malcolm L. Stewart, and Ginger D. Anders, Department of Justice, 950 Pennsylvania Avenue, NW, Washington, DC 20530, (202) 514-2203. Principal opposing counsel was J. Michael Jakes, Finnegan, Henderson, Farabow, Garrett, & Dunner, L.L.P., 901 New York Avenue, NW, Washington, DC 20001, (202) 408-4000.

(2) *Therasense, Inc. v. Becton, Dickinson and Co.*, 649 F.3d 1276 (Fed. Cir. 2011) (*en banc*) (before Chief Judge Rader and Judges Newman, Lourie, Bryson, Gajarsa, Linn, Dyk, Prost, Moore, O'Malley, and Reyna).

This case involved the inequitable conduct doctrine, which is a defense to patent infringement that can bar enforcement of the patent, if proven. The Federal Circuit

granted the patent owner's request for rehearing *en banc* to clarify various elements of this doctrine. The court's *en banc* order specifically invited the Patent Office to submit an *amicus* brief. I played a leading role in the briefing, and presented oral argument as *amicus*. The court agreed with the Patent Office's position that inequitable conduct requires a specific intent to deceive the agency, and that a party invoking the defense must prove both specific intent and materiality by clear and convincing evidence. The majority adopted a narrower standard for materiality than the one urged by the Patent Office.

Co-counsel were Bernard Knight, General Counsel, Janet A. Gongola, and Sydney O. Johnson, Jr., United States Patent and Trademark Office, 600 Dulany Street, Alexandria, VA 22314, (571) 272-9035; and Scott R. McIntosh, Department of Justice, 950 Pennsylvania Avenue, NW, Washington, DC 20530, (202) 514-2000.

Principal counsel for Appellants was John M. Whealan, 2000 H Street, NW, Washington, DC, 20052, (202) 994-2195. Principal counsel for co-appellee Becton Dickinson was Bradford J. Badke, Ropes & Gray, LLP, 1211 Avenue of the Americas, New York, NY 10036, (212) 596-9031. Principal counsel for co-appellee Bayer was Rachel Krevans, Morrison & Foerster, LLP, 425 Market Street, San Francisco, CA 94105, (415) 268-7178.

(3) *Kappos v. Hyatt*, 132 S.Ct. 1690 (2012).

This case involved the scope of judicial review of a Patent Office decision denying a patent application, when that review is sought in district court, pursuant to 35 U.S.C. Section 145, rather than by direct appeal to the Federal Circuit. The question was whether the patent applicant may introduce new evidence in the district court that could have been presented to the agency in the first instance. The Federal Circuit heard the case *en banc* and ruled that Section 145 does not place any limits on the applicant's ability to introduce new evidence. I urged the Solicitor General's Office to file a *certiorari* petition, which was subsequently granted. I played a significant role in developing the brief and an attorney in the Solicitor General's Office argued the case for the agency. The Supreme Court affirmed the Federal Circuit's decision.

Co-counsel were Donald B. Verrilli, Jr., Solicitor General, Malcolm L. Stewart, Beth S. Brinkmann, and Ginger D. Anders, Department of Justice, 950 Pennsylvania Avenue, NW, Washington, DC 20530, (202) 514-2203; and Bernard J. Knight, Jr., General Counsel, Robert J. McManus, and Thomas W. Krause, United States Patent and Trademark Office, 600 Dulany Street, Alexandria, VA 22314, (571) 272-9035.

Principal opposing counsel was Aaron M. Panner, Kellog, Huber, Hansen, Todd, Evans & Figel, PLLC, Sumner Square, 1615 M Street, NW, Suite 400, Washington, DC 20036, (202) 326-7921.

(4) *Microsoft Corp. v. i4i Ltd. Partnership*, 131 S.Ct. 2238 (2011).

Section 282 of the Patent Act states that a patent shall be presumed valid and that a party contending that a patent is invalid bears the burden of proof. This case involved whether Section 282 requires an invalidity defense to be proven by clear and convincing evidence. While the default burden of proof in civil actions is that a plaintiff must prove its case by a preponderance of the evidence, the Federal Circuit had long held that invalidity challenges required clear and convincing evidence. Working with co-counsel from the Solicitor General's Office and Department of Justice, I played a significant role in developing the government's position and *amicus* brief supporting the burden of proof required by the Federal Circuit. Deputy Solicitor General Malcolm L. Stewart presented oral argument for the United States as *amicus curiae*. The Court agreed with the government's position and upheld the Federal Circuit's interpretation of Section 282.

Co-counsel were Neal Kumar Katyal, then Acting Solicitor General, Malcolm L. Stewart, and Ginger D. Anders, Department of Justice, 950 Pennsylvania Avenue, NW, Washington, DC 20530, (202) 514-2203; and Bernard J. Knight, Jr., General Counsel, Robert J. McManus, and William LaMarca, United States Patent and Trademark Office, 600 Dulany Street, Alexandria, VA 22314, (571) 272-9035.

Primary counsel for petitioner was Thomas G. Hungar, Gibson Dunn, 1050 Connecticut Avenue, NW, Washington, DC 20036, (202) 955-8558. Primary counsel for respondent were Seth P. Waxman, WilmerHale, 1875 Pennsylvania Avenue, NW, Washington, DC 20006, (202) 663-6363; and Donald. R. Dunner, Finnegan, Henderson, Farabow, Garrett, & Dunner, L.L.P., 901 New York Avenue, NW, Washington, DC 20001, (202) 408-4000.

(5) *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S.Ct. 1289 (2012).

This case involved a party's challenge to the validity of a patented method for using certain drugs to treat a disease, and diagnosing whether to increase the drug dosage. The issue was the scope of the law of nature exception to patentability, and the dividing line between a law of nature and a patent-eligible practical application of a law of nature. I was significantly involved in formulating the government's position and the briefing. Solicitor General Donald B. Verrilli presented oral argument for the United States as amicus curiae, urging that the patented method was not merely for a law of nature, but nevertheless was likely invalid due to a lack of novelty. The Supreme Court concluded that the challenged patent claims violated the prohibition against patenting laws of nature.

Co-counsel were Donald B. Verrilli, Jr., Solicitor General, Malcolm L. Stewart, and Mark R. Freeman, Department of Justice, 950 Pennsylvania Avenue, NW, Washington, DC 20530, (202) 514-2203; and Bernard J. Knight, Jr., General Counsel, Thomas W. Krause, and Scott C. Weidenfeller, United States Patent and Trademark Office, 600 Dulany Street, Alexandria, VA 22314, (571) 272-9035.

Primary counsel for petitioner was Stephen M. Shapiro, Mayer Brown, 71 South Wacker Drive, Chicago, IL 60606, (312) 701-7327. Primary counsel for respondent was Richard

P. Bress, Latham & Watkins, LLP, 555 Eleventh Street, NW, Suite 1000, Washington, DC, 20004, (202) 637-2137.

(6) *In re Inland Steel*, 265 F.3d 1354 (Fed. Cir. 2001) (before Chief Judge Rader, and Judges Newman and Bryson).

This case involved the Patent Office's reexamination of a patent for a method of producing electrical steel with improved magnetic properties. After the Patent Office concluded the patent claims were obvious and therefore unpatentable, based on new evidence presented to the Patent Office during the reexamination proceeding, Inland Steel appealed the agency's decision. I played the leading role in the briefing and I argued the case in the Federal Circuit, which affirmed the rejection of the claims. The court agreed with the Patent Office's reading of the prior art, and also granted the agency broad deference in weighing Inland Steel's evidence of unexpected results.

Co-counsel were Albin F. Drost, then Acting Solicitor, now retired, John M. Whealan, then Deputy Solicitor, now at 2000 H Street, NW, Washington, DC, 20052, (202) 994-2195, and William LaMarca, United States Patent and Trademark Office, 600 Dulany Street, Alexandria, VA 22314, (571) 272-9035.

Primary opposing counsel was Donald. R. Dunner, Finnegan, Henderson, Farabow, Garrett, & Dunner, L.L.P., 901 New York Avenue, NW, Washington, DC 20001, (202) 408-4000. Primary counsel for intervenor USX Corporation was Constantine L. Trela, Jr., Sidley & Austin, LLP, One South Dearborn, Chicago, IL 60603, (312) 853-7293.

(7) *In re Nuijten*, 500 F.3d 1346 (Fed. Cir. 2007) (before Judges Gajarsa, Linn, and Moore).

This case involved the novel question of whether an artificially created, propagated signal may be patented. The Patent Office had rejected the claimed signal as failing to fall within any of the four categories of patentable subject matter—process, machine, manufacture, or composition of matter—set forth in 35 U.S.C. Section 101. I played a leading role in the briefing and I argued the case in the Federal Circuit. The court, in a divided opinion, affirmed the Patent Office's decision, agreeing with its construction of the statute.

Co-counsel was Thomas W. Krause, United States Patent and Trademark Office, 600 Dulany Street, Alexandria, VA 22314, (571) 272-9035. Opposing counsel was Jack E. Haken, Phillips Intellectual Property & Standards, P.O. Box 3001, Briarcliff Manor, NY 10510, (914) 333-9650.

(8) *In re Comiskey*, 554 F.3d 967 (Fed. Cir. 2009) (before then Chief Judge Michel, and Judges Dyk, and Prost).

This case involved a patent applicant's attempt to patent a method of arbitrating disputes arising from wills or contracts. The Patent Office had rejected the claims under 35

U.S.C. Section 103 as obvious, and Mr. Comiskey appealed the decision. I played the lead role in the briefing, and I argued the case in the Federal Circuit. At oral argument the court questioned whether the patent claims should be rejected under 35 U.S.C. Section 101, and ordered supplemental briefing on the issue. I drafted the supplemental brief, setting forth the agency's position that the claims were unpatentable under Section 101. The court's decision affirmed the rejection of the broadest claims, largely based on the reasoning in the supplemental brief.

Co-counsel were James A. Toupin, then General Counsel, John M. Whealan, then Solicitor, and Thomas W. Krause, United States Patent and Trademark Office, 600 Dulany Street, Alexandria, VA 22314, (571) 272-9035. Primary opposing counsel was Thomas J. Scott, now at Goodwin Procter, LLP, 901 New York Avenue, NW, Washington, DC 20001, (202) 346-4332.

(9) *Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*, 598 F.3d 1336 (Fed. Cir. 2010) (*en banc*) (before then Chief Judge Michel, and Judges Newman, Mayer, Lourie, Rader, Bryson, Gajarsa, Linn, Dyk, Prost, and Moore).

The Federal Circuit in this case granted the petition for rehearing *en banc* to resolve the legal question of whether 35 U.S.C. Section 112, paragraph 1, contains a written description requirement that is separate from an enablement requirement. Over the years leading up to the case, the written description requirement had been growing in importance as a tool for containing overly broad patent claims, and the Patent Office had a strong interest in preserving it. Working with co-counsel from the Department of Justice, I played a significant role in developing the government's position and *amicus* brief. An attorney from the Department of Justice presented oral argument for the United States as *amicus curiae*. The *en banc* court's decision agreed with the government's interpretation of Section 112 of the Patent Act, reaffirming the written description requirement.

Primary co-counsel were Mark R. Freeman and Scott R. McIntosh, Department of Justice, 950 Pennsylvania Avenue, NW, Washington, DC 20530, (202) 514-2000; and James A. Toupin, then General Counsel, United States Patent and Trademark Office, 600 Dulany Street, Alexandria, VA 22314, (571) 272-9035.

Primary counsel for appellant was Charles E. Lipsey, Finnegan, Henderson, Farabow, Garrett, & Dunner, L.L.P., 901 New York Avenue, NW, Washington, DC 20001, (202) 408-4000. Primary counsel for appellee was John M. Whealan, 2000 H Street, NW, Washington, DC, 20052, (202) 994-2195.

(10) *In re Beineke*, 690 F.3d 1344 (Fed. Cir. 2012) (before Judges Dyk, Schall, and Reyna).

This case involved Mr. Beineke's appeal to the Federal Circuit from a Patent Office decision rejecting his plant patent applications. The patentability of his plant claims turned on the degree of human activity required by the Plant Patent Act in producing the

claimed plant. I played a leading role in the briefing, and I argued the case in the Federal Circuit. In a case of first impression, the court affirmed the USPTO's decision and interpretation of the Plant Patent Act.

Co-counsel were Amy J. Nelson and Nathan K. Kelley, United States Patent and Trademark Office, 600 Dulany Street, Alexandria, VA 22314, (571) 272-9035. Primary opposing counsel was Alice O. Martin, Barnes & Thornburg, LLP, One North Wacker Drive, Suite 4400, Chicago, Illinois 60606, (312) 214-8316.

18. **Legal Activities**: Describe the most significant legal activities you have pursued, including significant litigation which did not progress to trial or legal matters that did not involve litigation. Describe fully the nature of your participation in these activities. List any client(s) or organization(s) for whom you performed lobbying activities and describe the lobbying activities you performed on behalf of such client(s) or organizations(s). (Note: As to any facts requested in this question, please omit any information protected by the attorney-client privilege.)

My career has primarily been devoted to litigating patent and trademark cases before the Federal Circuit, defending the decisions of the agency's administrative patent and trademark boards. I have also on occasion worked on litigations in which review of a patent or trademark board decision was sought in district court, rather than the Federal Circuit. In addition, I have handled Administrative Procedure Act claims in district court, as well as prosecutions of registered patent attorneys in administrative disciplinary proceedings. In each of these types of matters, there have been occasions where opposing counsel and I settled the dispute, avoiding unnecessary litigation.

As counsel to the agency, I also provide a significant amount of in-house advice and counsel agency decision-makers with an eye towards possible, future litigation. My staff of attorneys and I carefully review proposed new regulations and guidance documents on patent and trademark matters. The agency's recent implementation of many provisions of the America Invents Act is one major example of our internal counseling work.

In addition, my office and I regularly work with other attorneys within the Executive Branch to determine whether to file an *amicus* brief in an intellectual property case, or more generally to develop a coordinated government position on an intellectual property issue. In my role as Solicitor, I have been called upon to do a significant amount of public speaking and engagement with the patent bar and the public, in order to inform the public about new programs and changes at the agency, and also to share the agency's views on many different patent and trademark issues. These regular public outreach efforts also help broaden the agency's perspective in developing policy positions on a host of issues.

I have not performed any lobbying activities on behalf of clients or others.

19. **Teaching**: What courses have you taught? For each course, state the title, the institution at which you taught the course, the years in which you taught the course, and describe

briefly the subject matter of the course and the major topics taught. If you have a syllabus of each course, provide four (4) copies to the committee.

I have not taught any courses.

20. **Deferred Income/ Future Benefits**: List the sources, amounts and dates of all anticipated receipts from deferred income arrangements, stock, options, uncompleted contracts and other future benefits which you expect to derive from previous business relationships, professional services, firm memberships, former employers, clients or customers. Describe the arrangements you have made to be compensated in the future for any financial or business interest.

    I do not have any arrangements for deferred income or future benefits from previous business relationships.

21. **Outside Commitments During Court Service**: Do you have any plans, commitments, or agreements to pursue outside employment, with or without compensation, during your service with the court? If so, explain.

    I have no plans, commitments, or agreements to pursue outside employment during service with the court.

22. **Sources of Income**: List sources and amounts of all income received during the calendar year preceding your nomination and for the current calendar year, including all salaries, fees, dividends, interest, gifts, rents, royalties, licensing fees, honoraria, and other items exceeding $500 or more (if you prefer to do so, copies of the financial disclosure report, required by the Ethics in Government Act of 1978, may be substituted here).

    See attached Financial Disclosure Report.

23. **Statement of Net Worth**: Please complete the attached financial net worth statement in detail (add schedules as called for).

    See attached Net Worth Statement.

24. **Potential Conflicts of Interest**:

    a. Identify the family members or other persons, parties, categories of litigation, and financial arrangements that are likely to present potential conflicts-of-interest when you first assume the position to which you have been nominated. Explain how you would address any such conflict if it were to arise.

        I am unaware of any individuals, family or otherwise, that are likely to present potential conflicts of interest. My wife is a trial attorney at the U.S. Department of Justice's Consumer Protection Branch, which does not litigate cases that typically come before the Federal Circuit. In the unlikely event that a case in

which the Consumer Protection Branch is counsel were to be appealed to the Federal Circuit, I would not participate in that matter as a judge. I am aware of several appeals of decisions by the U.S. Patent and Trademark Office which are pending in the Federal Circuit. I would not participate in those matters as a judge.

b. Explain how you will resolve any potential conflict of interest, including the procedure you will follow in determining these areas of concern.

I will consult and abide by rules and decisions that address what constitutes a conflict of interest, including 28 U.S.C. Section 455 and the Code of Conduct for United States Judges.

25. **Pro Bono Work**: An ethical consideration under Canon 2 of the American Bar Association's Code of Professional Responsibility calls for "every lawyer, regardless of professional prominence or professional workload, to find some time to participate in serving the disadvantaged." Describe what you have done to fulfill these responsibilities, listing specific instances and the amount of time devoted to each.

I have spent most of my legal career in the public sector, serving the public interest. Over the years I have worked in the Office of the Solicitor, I have spent many hours counseling and advising individual inventors to help them understand the patent application process. Because procuring a patent often can be a complex and time-consuming process, most applicants are represented by a registered patent lawyer. Although I never represented any of these individual inventors as a client before the agency, I answered their questions about the legal process, and also translated for them the import of an agency action.

In recent years, I have mentored several minority attorneys and law students and become more active in addressing issues that they may face in their professional advancement. I am an Executive Advisor for the Patent Office's Asian Pacific American Network (APANet). I also participate in the Asian Pacific American Bar Association – DC Chapter's formal mentoring program, in which I mentor several local Asian American attorneys.

During law school, as part of New York University's Urban Law Clinic, I represented several low-income persons in landlord tenant disputes to help them remain in their homes.

I also contribute to the community outside of my law practice. Last year, my family and I helped plan and execute a community yard sale to benefit WarChild, an international organization that assists children of war. For the last four years, I have coached a boys' basketball team in a recreational league. I and my family have also volunteered at the annual "feed the homeless" Thanksgiving event held at McPherson Square in Washington, DC.

26. **Selection Process**:

a. Please describe your experience in the entire judicial selection process, from beginning to end (including the circumstances which led to your nomination and the interviews in which you participated). Is there a selection commission in your jurisdiction to recommend candidates for nomination to the federal courts? If so, please include that process in your description, as well as whether the commission recommended your nomination. List the dates of all interviews or communications you had with the White House staff or the Justice Department regarding this nomination. Do not include any contacts with Federal Bureau of Investigation personnel concerning your nomination.

On August 20, 2012, I received an email from an attorney in the White House Counsel's Office, asking if I was interested in discussing with him the possibility of serving as a judge on the Federal Circuit. I confirmed my interest in a return email and we spoke over the telephone on August 29, 2012. On October 9, 2012, the White House attorney informed me that I would be contacted shortly by an attorney in the Office of Legal Policy of the Department of Justice. Since that day, I have been in contact with officials from the Office of Legal Policy at the Department of Justice. On November 20, 2012, I met with officials from the White House Counsel's Office and the Department of Justice in Washington, DC. On February 7, 2013, the President submitted my nomination to the Senate.

b. Has anyone involved in the process of selecting you as a judicial nominee discussed with you any currently pending or specific case, legal issue or question in a manner that could reasonably be interpreted as seeking any express or implied assurances concerning your position on such case, issue, or question? If so, explain fully.

No.

AFFIDAVIT

I, Raymond T. Chen, do swear that the information provided in this statement is, to the best of my knowledge, true and accurate.

2/7/13
(DATE)

RTC
(NAME)

Kyra Elaine Abraham
(NOTARY)

Kyra Elaine Abraham
Commonwealth of Virginia
Notary Public
Commission No. 320911
My Commission Expires 6/30/2014