FISH



W. Karl Renner

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Overview

As chair of Fish & Richardson's Post-Grant Practice Group, Karl Renner has provided direction for well over 900 America Invents Act post-grant matters, both challenging and defending patents, most commonly in coordination with litigation counsel amidst copending disputes. He also serves on the firm's management committee.

Karl's practice emphasizes client counseling, strategic patent prosecution, and contentious *inter partes* and *ex parte* post-grant and reissue work before the Patent Trial and Appeal Board. Karl previously served as president of the PTAB Bar Association, complementing his service as a founding director of the association, the first national bar association of its kind in more than 30 years The PTAB Bar Association intends to establish best practices for the unique practice and skills required before the PTAB.

Karl manages the patent portfolios of clients ranging from emerging companies to Fortune 50 corporations. He also regularly advises on effective commercialization/enforcement of company intellectual property, and on defensive tactics to address competitor IP. In this regard, he excels in post-grant matters, representing both patent owners and challengers.

His technical focus is on the electrical, computer-related, physics, and mechanical arts. As such, Karl has extensive experience in the following technologies: internet-driven solutions, network systems and protocols, data storage and retrieval standards and media, microprocessor and computer architecture, mobile and other communications equipment and processes, display technologies, semiconductor devices and fabrication processes, signal and image processing techniques, complex optical and mechanical devices, error detection and correction techniques, cryptography, telecommunications, financial processes, acoustics and video standards and equipment, and thermodynamic processes and systems.

Karl has prior engineering experience with the instrumentation branch of the U.S. Department of Energy, where he worked on the development and implementation of control systems, high-frequency optical imaging of particles during combustion processes, computer programming in machine and object-oriented languages, and computer design and breadboard testing of analog circuits. Karl is now a frequent lecturer and author on IP matters, regularly speaking at University of Maryland events, in conjunction with their engineering schools and Hinman CEO program.

Recognitions & awards

IAM Patent 1000 *IAM*2013-2024 IP Star *Managing IP*2013-2024 Patent Prosecutor of the Year Bar Association of the District of Columbia2024 Top PTAB Practitioner Managing Intellectual Property (MIP)2017-2022

Professional associations

PTAB Bar Association, Honorary Director Role of Immediate Past President (2022-2023), President (2021-2022), Founding Member of the Board of Directors (2016-Present)

Insights

Blog | April 25, 2025 PTAB Issues FAQs on Interim Process for Workload Management

Blog | March 31, 2025 What to Know About the PTAB's Discretionary Denial Shakeups

Post-Grant Report | March 5, 2025 2024 Post-Grant Annual Report

Webinar | January 8, 2025 2024 Post-Grant Year in Review

Article | November 20, 2024 How a Second Trump Presidency Could Shape IP

Blog | April 22, 2024 Legal Alert: USPTO Issues Proposed Rules on Discretionary Denial in PTAB Proceedings

Blog | April 17, 2024 Legal Alert: USPTO Issues Proposed Rules on Director Review

Post-Grant Report | January 17, 2024 2023 Post-Grant Annual Report

Webinar | January 17, 2024 Post-Grant 2023 Year in Review

Blog | October 17, 2023 USPTO Issues Proposed Rules on Pre-Issuance Internal Circulation and Review of PTAB Decisions

Blog | April 26, 2023 Legal Alert: USPTO Issues Advance Notice of Proposed Rulemaking for PTAB Proceedings

Post-Grant Report | February 28, 2023 2022 Post-Grant Annual Report

Webinar | January 31, 2023 Post-Grant for Practitioners | 2022 Year in Review

Article | December 22, 2022 A Look Back on a Decade of Practice at the PTAB

Post-Grant Report | February 7, 2022 2021 Post-Grant Annual Report

News

News | December 17, 2024 Principal Karl Renner Named Patent Prosecutor of the Year by the Bar Association of the District of Columbia News | October 4, 2024 Fish & Richardson Ranked Highly by Managing IP, Attorneys Named IP Stars News | June 11, 2024 Fish & Richardson Receives Top Rankings in 2024 Edition of IAM Patent 1000: The World's Leading Patent Professionals News | October 5, 2023 Fish & Richardson Ranked Highly by Managing IP, Attorneys Named IP Stars News | June 27, 2023 Fish & Richardson Receives Top Rankings in 2023 Edition of IAM Patent 1000: The World's Leading Patent Professionals News | March 2, 2023 Lex Machina Ranks Fish & Richardson Most Active Firm for Patent Defense and PTAB Work News September 8, 2022 Fish & Richardson Receives Top Rankings in 2022 Edition of IAM Patent 1000: The World's Leading Patent Professionals News | June 21, 2022 PTAB Pro Bono Program Launches News | June 2, 2022 Fish & Richardson Named a Top ITC and Life Sciences Firm by Managing IP, Attorneys Named IP Stars News | May 25, 2022 Lex Machina Lists Fish & Richardson as Most Active Firm for Defendants and at the PTAB News | March 21, 2022 Fish Tops List of Most Active Firms for Patent Defense and PTAB Petitioner Work in 2021 News | February 28, 2022 Fish & Richardson Shortlisted for 2022 Managing IP Americas Awards News | July 7, 2021 Fish & Richardson Receives Top Rankings in 2021 Edition of IAM Patent 1000. The World's Leading Patent Professionals News | May 18, 2021 Fish & Richardson Principal Karl Renner Named President of the PTAB Bar Association News | January 25, 2021 Fish & Richardson Named #1PTAB Law Firm of 2020 by Managing Intellectual Property News August 24, 2020 Fish & Richardson Ranked #1 PTAB Law Firm in the U.S. for First Half of 2020 by Managing Intellectual Property News | August 12, 2020 Fish & Richardson Receives Top "Gold" Ranking from IAM Patent 1000 for National Litigation Practice; National Rankings in the Plaintiff Firm and Prosecution... News August 4, 2020 32 Fish & Richardson Attorneys Named 2020 "IP Stars" by Managing Intellectual Property Magazine News | March 9, 2020 Fish & Richardson Named Most Active Law Firm at Patent Trial and Appeal Board for Fourth Consecutive Year News | June 20, 2019 Fish & Richardson Receives Top "Gold" Ranking from IAM Patent 1000 for National Patent Litigation Practice News | May 22, 2019 Fish & Richardson Announces 32 Attorneys Named "IP Stars" by Managing Intellectual Property Magazine News | April 3, 2019 Fish Marks 1,000 Appearances at the PTAB News | February 26, 2019 Fish & Richardson Named Top PTAB Firm of 2018 by Managing Intellectual Property Media Coverage | January 23, 2019 Reviewing 'A Tremendous Year of Change' for the PTAB Managing Intellectual Property Media Coverage | January 3, 2019 What To Expect After Year Of Change At The PTAB

Law360

Media Coverage | September 14, 2018 Ruschke Leaves 'Big Shoes to Fill' for Next PTAB Chief Judge

Managing Intellectual Property

News | August 10, 2018 Fish & Richardson Ranked Top Firm for Petitioners at the PTAB by *Managing Intellectual Property*

News | June 14, 2018 Fish Receives Top "Gold" Ranking from *IAM Patent 1000* for National Patent Litigation Practice

News | May 21, 2018 Fish & Richardson Announces 39 Attorneys Named "IP Stars" by *Managing Intellectual Property* Magazine

Media Coverage | April 30, 2018 PTAB Unveils AIA Review Plans After High Court Shakeup

Law360

Media Coverage | April 26, 2018 SCOTUS Abolishes PTAB Practice Of Partial Claim Review

Managing Intellectual Property

Media Coverage | February 23, 2018 Leading PTAB Atty Says Changes At Board Create Opportunity

Law360

News | January 19, 2018 Fish & Richardson Named #1 PTAB Law Firm in the U.S. for 2017 by *Managing Intellectual Property Magazine*

News | July 24, 2017 Fish & Richardson Receives Top "Gold" Ranking from *IAM Patent 1000* for National Patent Litigation Practice

News | June 23, 2017 Fish & Richardson Announces 36 Attorneys Named "IP Stars" by *Managing Intellectual Property* Magazine

Media Coverage | May 1, 2017 4 Recent PTAB Decisions Attys Need To Know

Law360

News | March 29, 2017 Fish & Richardson Wins "Case of the Year" Award and "U.S. Specialty IP Firm of the Year" Award by *Managing Intellectual Property*

Media Coverage | March 7, 2017 Inter Partes Reviews Becoming Friendlier To Patent Owners

Law360

News | February 17, 2017 Fish & Richardson Named #1 PTAB Law Firm in the U.S. for 2016 by *Managing Intellectual Property* Magazine

Media Coverage | February 10, 2017 Once A Mystery, PTAB Remands Start To Take Shape

Law360

News | June 29, 2016 Fish Receives Top Tier 1 National Rankings in Patent Prosecution and Patent Litigation from *The Legal 500*

News | June 15, 2016 Fish & Richardson Named to *IAM* Patent 1000 for National Patent Litigation and Prosecution Practices

News | April 8, 2016 Fish & Richardson Obtains Full Federal Circuit Reversal for Cutsforth, Inc. After Faulty Inter Partes Review

News | January 26, 2016 Fish & Richardson Tops List of Busiest Firms at Patent Trial and Appeal Board News | February 17, 2015 Fish & Richardson Named #1 PTAB Law Firm in the U.S. for 2014 by *Managing Intellectual Property*

News | December 16, 2014 Fish's Post-Grant Practice Co-Chairs Named as Intellectual Property Trailblazers by *The National Law Journal*

News | November 13, 2014 Fish & Richardson Has Three Principals Named "Intellectual Property Trailblazers & Pioneers" by *The National Law Journal*

Media Coverage | January 17, 2014 5 Tips For Killing Patents In AIA Reviews

Law360

Media Coverage | April 22, 2013 Q&A With Fish & Richardson's Karl Renner

Law360

Media Coverage | November 27, 2012 Kappos A Tough Act To Follow As USPTO Director

Law360

Events

February 21, 2024 IPBC Korea 2024

April 20, 2023 IPBC Korea 2023

April 28, 2022 PTAB Inventor Hour | Episode 7

March 24, 2022 2022 PTAB Bar Conference

December 2, 2021 American Conference Institute (ACI) - PTAB Practice Briefing

September 22, 2021 2021 PTAB Bar Annual Conference

January 28, 2021 2021 PTAB Bar Association Thought Leader Summit

September 24, 2020 2020 PTAB Bar Association Annual Conference

November 14, 2019 PTAB Bar Association Thought Leader Summit

July 24, 2019 Protecting Innovations in the Financial Services Industry

March 13, 2019 PTAB Bar Association 2019 Annual Conference

January 28, 2019 Informa: 2019 Drug Delivery Partnerships Conference

November 13, 2018 2018 PTAB Bar Association's Thought Leader Summit

November 13, 2018 IAM's Patent Law & Policy Seminar

October 24, 2018 IP Update: United States and China

July 25, 2018

World Congress' 15th Annual Summit on Protecting Innovations in the Financial Services Industry

March 22, 2018 PTAB Bar Association: 2018 Annual Conference

December 7, 2017 Momentum 2017 IP Counsel Exchange

December 6, 2017 Daily Journal 2017 SoCal Patent Disputes Forum

September 28, 2017 George Washington University School of Law: Third Annual GW Law Conference - Post-Grant Practice Roundtable Discussion

May 23, 2017 Momentum: 2017 IP Counsel Exchange San Jose

March 1, 2017 PTAB Bar Association Inaugural Conference

December 1, 2016 Momentum: 2016 IP Counsel Exchange

June 21, 2016 Association of Corporate Patent Counsel [ACPC] 2016 Summer Meeting

June 5, 2016 Consero IP Management Forum 2016

March 14, 2016 PLI USPTO Post-Grant Patent Trials 2016

June 7, 2015 Consero 2015 Global IP Management Forum

April 17, 2015 USPTO Post-Grant Patent Trials 2015

April 2, 2015 (CPA Global) Mid-Atlantic IP Forum: Innovating IP Management

March 26, 2015 USPTO Post-Grant Patent Trials

November 7, 2014 26th Annual All Hands Meeting

November 6, 2014 UT Law 19th Annual Advanced Patent Law Institute

May 6, 2014 PTAB AIA Trial Roundtables in Final Week - Hear from Fish Participants on May 14th

May 4, 2014 Global IP Management Forum

April 12, 2014 PTAB AIA Trial Roundtables

March 27, 2014 Inter Partes Review: Patent Owner's Perspective

February 27, 2014 The IP Counsel Exchange on Post-Grant Patent Challenges

January 22, 2014 ACI Patent Reform

January 8, 2014 Post-Grant for Practitioners Webinar Series Part XII: Inter Partes Review: The Year in Review

December 20, 2013 Inter Partes Review: The Year in Review

December 11, 2013 Part XI: Standing Before the Panel: Strategies for Post-Grant Oral Hearings

November 7, 2013

Challenging Validity in the Patent Office: A Look Back at the First Year, and a Look Ahead to Post-Grant Review and Potential Statutory Changes

November 5, 2013 Patent Dispute Forum 2013

September 11, 2013

Post-Grant for Practitioners Webinar Series Part VIII: Claim Amendments in Inter Partes Review: How? When? Why?

August 14, 2013

Webinar: Part VII: Inter Partes Review from the Patent Owner's Perspective

July 10, 2013

Post-Grant for Practitioners Webinar Series Part VI: Inter Partes Review - Claim Construction and Patent Owner Preliminary Response

June 25, 2013 Inter Partes Review: What Practitioners Need to Know About Using and Defending Against This New Tool

June 23, 2013 IP Management Forum

May 29, 2013 The IP Strategy Summit: Enforcement

May 8, 2013 Webinar: Conducting Trials in the PTAB

April 10, 2013 Webinar: Inter Partes Review and Covered Business Method Review - Recent Developments

February 8, 2013 U.S. Patent Law Developments 2009

September 19, 2012 Boston Breakfast Series: New Options for Challenging Patent Validity in the USPTO

October 24, 2011 U.S. Patent Law Developments 2011

April 22, 2010 Strategic Use of Patent Reexamination Seminar - Dallas

April 29, 2009 Inter Partes and Ex Parte Reexamination

Additional insights

Publications

- "IPR and PGR: A Complex and Shifting Landscape," Managing Intellectual Property (July 29, 2019)
- "To Reexamine or not to reexamine A look beyond statistics to answer this question when facing a hostile patent," *IP Law* 360 (2009)

Speaking engagements

- "Apply Best Practices in Oral Arguments Before The PTAB," World Congress The 14th Annual Patents for Financial Services Summit (July 2017)
- "Focus on the PTAB District Court Interplay: Timing, Discovery, Evidence, Claim Construction and the Management of Joint Patent Proceedings," *Momentum: IP Counsel Exchange on Post-Grant Patent Challenges at the PTAB: San Jose* (May 2016)
- "Discovery, Evidence, Claim Construction and Addressing Key Evidentiary Issues That Arise During the Co-Pendency of Counterpart Patent Proceedings," 2nd IP Counsel Exchange on Post-Grant Patent Challenges at the PTAB (March 2015)
- Co-Chaired Consero Group's "Post-Grant Executive Roundtable," (September 2014)
- "PTAB AIA Trial Roundtable," USPTO (May 2014)
- "AIA and Inter Partes Review," CPA Global Webinar (April 2014)

- "Challenging Patent Validity in the USPTO: Strategic Considerations in View of the USPTO's Final Rules Inter Partes Review," Fish & Richardson Webinar (October 2013)
- "How Post-Grant Challenges Have Evolved From Proposed Rules to Practice," *What European Companies Need to Know About the Extraordinary Changes in U.S. & European Patent Law* (May 2013)
- "The America Invents Act: How Patent Reform Will Impact Your IP Strategy," 2012 Intellectual Property Forum (2012)
- "When/Whether/Why Defend Using Inter Partes Review? And What Should You Do To Galvanize Your Patents Against It?" 2012 Intellectual Property Forum (2012)
- "AIA: Post-Grant Proceedings in Comparison With German Post-Grant Proceedings," What European Companies Need to Know About the Extraordinary Changes in U.S. Patent Law: The AIA & New Legal Standards from the Supreme Court & CAFC (May 2012)
- "Of Inter Partes Reexamination and Inter Partes Review: Preparing for the Transition," American Conference Institute (March 2012)
- "Protecting & Monetizing Intellectual Property in Emerging Markets," Consero Corporate Counsel Forum (May 2011)
- "Strategies a Chinese Company Can Employ to Maximize the Value of a U.S. Patent Portfolio," Selling to the U.S. Market: What Chinese Companies Need to Know About U.S. Patent Law (April 2011)
- "A Conversation with the United States Patent and Trademark Office," CLE Series hosted by U.S. District Court for the District of Delaware and the Federal Bar Association (May 2010)
- "Positioning Your Reexamination for Success by Incorporating Procedural Requirements and Other Tactical Considerations into Your Advanced Strategy," ACI's In-House Counsel Forum on Patent Reexamination (May 2009)
- Presented on various topics surrounding the basics of intellectual property protection, The University of Maryland's Technology Start-up Bootcamp (2002-2009)
- "Developing a Practical Multi-Country Approach for Patent Enforcement, Litigation Management, and Execution," ACI, Global Patent Litigation Congress (November 2008)
- "Current Developments in Patent Applications, Appeals, Oppositions and Reexaminations," Fish & Richardson Seminar (October 2008)
- "The Convergence of IP Law and Business," SIGGRAPH Conference (August 2008)
- "Be strategic with your IP: Maximize its Value An Opportunity and an Obligation," AeANET Retreat (2008)
- "Strategic Prosecution Building a Litigation-worthy Patent Portfolio," Fish & Richardson Seminar: United States Patent Law and Litigation – Important Issues Professionals in South Korea Need to Know (December 2006)
- "Reexamination: Knowing When and How to Use This Strategic Defensive Weapon," IP Law & Business Presents Innovations in IP Litigation (December 2006)
- "Equipping business leaders to manage intellectual property issues," Executive MBA Annual Meeting (June 2006)
- "What VCs Need to Know About the Changing Patent Process & IP Protection," National Venture Capital Association (June 2005)

Media mentions

- "<u>These Firms Are Leading In PTAB Work</u>," Law360 (February 8, 2024)
- "Fish & Richardson Cashes in as Big Tech's Go-To Trial Law Firm," Bloomberg Law (April 27, 2023)
- "These Firms are Pulling in the Most PTAB Work," Law360 (February 15, 2023)
- "These IP Boutique Firms Are Dominating PTAB Work," Law360 (May 19, 2022)
- "4 Big Issues That Shaped The PTAB In 2021," Law360 (December 20, 2021)
- "PTAB Institution Rate Drops, Petitions Stay Steady In FY 2020," Law360 (October 26, 2020)
- "Coronavirus Q&A: Fish & Richardson's PTAB Group Co-Chair," Law360 (July 10, 2020)
- "What To Expect After Year of Change At The PTAB," Law360 (January 1, 2019)
- "Reviewing 'A Tremendous Year of Change' for the PTAB," *Managing IP* (January 2019)
- "PTAB Unveils AIA Review Plans After High Court Shakeup," Law360 (April 26, 2018)
- "SCOTUS Abolishes PTAB Practice of Partial Claim Review," Managing IP (April 25, 2018)

- "Tough Questions Await As PTAB Partial Reviews Get Boot," Law360 (April 24, 2018)
- "Leading PTAB Atty Says Changes at Board Create Opportunity." Law360 (February 2018)
- "<u>3 Emerging Trends At The PTAB</u>," Law360 (May 4, 2017)
- "Once A Mystery, PTAB Remands Start To Take Shape," Law360 (February 9, 2017)
- "The Shifting Demarcations of the Inequitable Conduct Doctrine," Forbes (June 17, 2011)

Services

Post-Grant Standard Essential Patents Patent Patent Prosecution Strategic Patent Counseling & Opinions Patent Portfolio Management IP Licensing, Transactions & Agreements

Industries

Electrical & Computer Technology Software & Internet Hardware Semiconductors Consumer Electronics Optics Digital Media & E-Commerce Financial, Business & FinTech Services Telecommunications 5G Energy & Chemicals Petrochemical Cleantech Transportation, Aerospace & Defense

Admissions

U.S. Patent and Trademark Office District of Columbia Virginia Texas

Education

J.D., George Washington University Law School (1998)

B.S., Electrical Engineering, University of Maryland (1992)

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