



Brandon R. Theiss

J.D., PE
partner

732.991.7285
btheiss@addyhart.com

practice areas

IP & Commercial Litigation	Intellectual Asset Portfolio Mgmt.
IPRs and Post-Grant Proceedings	Patent Acquisitions
Licensing & Monetization	Strategic Counseling
Opinions	

Brandon R. Theiss is a patent attorney who combines deep technical knowledge with sophisticated intellectual property strategy. Drawing on more than a decade of engineering experience before entering the legal profession, he advises clients on patent prosecution, post-grant proceedings, licensing, and complex intellectual property matters involving emerging technologies. His practice spans industries including medical devices, software, fintech, cloud computing, artificial intelligence, industrial automation, and advanced manufacturing.

Brandon's path to patent law was intentionally built on a foundation of real-world engineering experience. Before becoming an attorney, he worked as an engineer for companies including Medtronic and American Standard, where he developed industrial control systems, automation technologies, and spinal implant products. His engineering background continues to shape his approach to legal practice, allowing him to engage with inventions at a highly technical level while developing practical strategies that align with his clients' business objectives.

Over the course of his career, Brandon has represented inventors, startups, established technology companies, pharmaceutical manufacturers, and multinational corporations. He is particularly recognized for his work in patent eligibility under 35 U.S.C. § 101, one of the most complex and rapidly evolving areas of U.S. patent law. Through his widely followed publication, *Divergent Patent Law*, he provides in-depth analysis of patent doctrine, regulatory developments, and emerging issues affecting innovation-driven industries. His writing frequently examines the intersection of patent law, regulatory frameworks, and international intellectual property systems.

One of Brandon's most significant professional accomplishments was developing and leading the open source patent licensing program at Intellectual Ventures. The program generated more than \$250 million in revenue and established a novel licensing framework for technologies implemented through open source software. Brandon developed the underlying licensing strategy, evidence-of-use methodologies, and supporting infrastructure that enabled widespread adoption of the program. Today, a substantial percentage of U.S. financial institutions operate under licenses negotiated through those efforts. He also played an active role in defending the associated patent portfolio through inter partes review proceedings and related litigation.

Prior to joining AddyHart, Brandon served as a Shareholder at Volpe Koenig, where he built and led the firm's post-grant proceedings practice. His experience before the Patent Trial and Appeal Board, combined with his technical background and prosecution experience, allows him to guide clients through the full lifecycle of intellectual property protection and enforcement.

Brandon remains actively engaged in the legal and academic communities. Since 2024, he has served as an Adjunct Professor at Villanova University Charles Widger School of Law, teaching patent prosecution. He has also mentored students through the New Jersey Governor's School of Engineering and Technology, helping future engineers develop practical experience analyzing and evaluating real-world patent issues. In addition, he is a co-author of FDA and Intellectual Property Strategies for Medical Device Technologies and serves as Secretary of the CMIPA, an American Bar Association liaison council focused on harmonizing patent law between the United States and China.

Known for his ability to bridge the gap between technical innovation and legal strategy, Brandon is trusted by clients facing complex intellectual property challenges. Whether prosecuting patents, navigating post-grant proceedings, or developing licensing strategies, he brings a unique combination of engineering insight, legal acumen, and business-minded problem solving to every engagement.

outside of the office

Brandon dedicates significant time to teaching, mentoring, and exploring the next frontier of patent law. He annually serves as a judge for the New Jersey Junior Science and Humanities Symposium at Rutgers University and mentors student teams at the New Jersey Governor's School of Engineering and Technology.

He also serves as in-house patent counsel to Swooped In Technologies, a startup operating at the edge of emerging technologies and evolving intellectual property issues. True to his

interest in unconventional legal questions, Brandon has long studied the outer limits of patent protection, including 35 U.S.C. § 105, which extends U.S. patent rights to inventions used in outer space and aboard spacecraft.

representative matters

- **Preserved Key Patent Claims in Tesla PTAB Challenges:** Represented Intellectual Ventures II LLC in inter partes review proceedings brought by Tesla, securing PTAB decisions that upheld all eight challenged claims of one patent and nine of the fourteen challenged claims of a second patent involving image recognition and digital camera technologies.
- **Created a First-of-Its-Kind Open-Source Licensing Program:** Developed and led Intellectual Ventures' open-source patent licensing program, pioneering a licensing strategy built around technologies implemented through open source software. The program generated more than \$250 million in revenue and resulted in licensing agreements covering at least 80% of U.S. banks across the open-source software, fintech, payment technologies, and network security sectors.
- **Defended Innovative Patent Enforcement Strategies Before the PTAB:** Supported and defended patent portfolios through inter partes review proceedings, helping clients navigate complex technical and procedural challenges while advancing novel legal positions, including matters involving contested Fintiv factors that later became cited authority within the PTAB community.
- **Built a Nationally Recognized Post-Grant Practice:** Established and led the post-grant proceedings practice at Volpe Koenig, counseling clients on inter partes reviews, post-grant challenges, and creative portfolio strategies designed to maximize both protection and commercial value.
- **Advanced New Thinking at the Intersection of FDA and Patent Law:** Co-authored FDA and Intellectual Property Strategies for Medical Device Technologies, exploring how FDA regulatory submissions and patent prosecution interact and identifying cross-agency issues years before they became central to high-profile litigation such as the Petra Pharmaceuticals matter.
- **Developed Patent Strategies for Emerging and Complex Technologies:** Managed patent prosecution and portfolio strategy for companies ranging from startups to global enterprises, advising on inventions involving artificial intelligence, cloud computing, big data analytics, wireless communications, medical devices, advanced manufacturing systems, and other rapidly evolving technologies.

- Recognized for Strategic Innovation in Intellectual Property: Named to the IAM Strategy 300: The World's Leading IP Strategists in both 2025 and 2026, recognizing his ability to develop unconventional and commercially effective intellectual property strategies for technology-driven organizations.
- Shaped Future Patent Practitioners and Innovators: Served as an Adjunct Professor of Patent Prosecution at Villanova University Charles Widger School of Law since 2024, teaching students to think beyond traditional patent drafting and prosecution approaches while preparing them for practice before the USPTO, PTAB, and Federal Circuit.
- Earned Early Recognition for Challenging Conventional Engineering Approaches: Received the Early Career Achievement Award from the Institute of Industrial Engineers for developing a novel software system that applied industrial engineering principles in an unconventional way and continues to be used by pharmaceutical companies, medical device manufacturers, logistics providers, and industrial organizations worldwide.

education

- J.D., Rutgers University School of Law
- M.S., Industrial & Systems Engineering, Rutgers University School of Engineering
- B.S., Electrical & Computer Engineering, Rutgers University School of Engineering
- B.A., Physics, Rutgers University

bar admissions

- Washington
- United States Patent and Trademark Office
- United States Court of Appeals for the Federal Circuit

memberships

- AIPLA
- INTA
- IPLAC

organizations

- American Society of Quality, Senior Member
- CMIPA – ABA Liaison Counsel, Secretary
- PIPLA Bar Association, Member
- PTAB Bar Association, Member
- New Jersey Junior Science & Humanities Symposium at Rutgers University, Judge
- The New Jersey Governor’s School of Engineering & Technology, Project Mentor

awards & recognition

- IAM Strategy 300: The World’s Leading IP Strategists, 2025 and 2026
- USPTO Registered Patent Attorney
- Licensed Professional Engineer, State of Vermont
- Early Career Achievement Award, Institute of Industrial Engineers

publications & presentations

- Brandon R. Theiss, *Claim Scope and Disclosure in U.S. and Chinese Patent Law: Written Description, Support, Sufficient Disclosure, and the Forum-Specific Nature of Review*, Divergent Pat. L. Blog (June 15, 2026), <https://www.divergentpatentlaw.com>.
- Brandon R. Theiss, *Reframing Patent Eligibility: U.S. § 101 Case Law Through the Lens of Japanese Technicality Doctrine*, Divergent Pat. L. Blog (June 11, 2026), <https://www.divergentpatentlaw.com>.
- Brandon R. Theiss, *Cross-Agency Candor: Managing FDA-USPTO Consistency to Avoid Inequitable Conduct and Regulatory Exposure*, Divergent Pat. L. Blog (June 8, 2026), <https://www.divergentpatentlaw.com>.
- Brandon R. Theiss, *Restriction Requirements as Substantive Limiters: Lessons from Focus Products v. Kartri*, Divergent Pat. L. Blog (June 5, 2026), <https://www.divergentpatentlaw.com>.

- Brandon R. Theiss, *The POSITA at the Eligibility Gate: SMEDs, Skilled-Artisan Evidence, and the Claim-Centric Limits of § 101*, Imagine That IP L. Blog (May 20, 2026), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon Theiss, *A Fed. Circ. Blueprint For Drafting Medical Device Patents*, Law360 (May 19, 2026, 6:08 PM EDT), <https://www.law360.com/articles/2474566>.
- Brandon R. Theiss, *If AI Can Be Rightfully Named As A Joint Inventor, Is The Patent Invalid?*, Imagine That IP L. Blog (May 18, 2026), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon Theiss, *PTAB Memo Recenters Discretion On US Manufacturing*, Law360 (Apr. 6, 2026), <https://www.law360.com/articles/2458288>.
- Brandon R. Theiss, *SMED Declarations Under 35 U.S.C. § 101: The Evidentiary Limits of Uncorroborated Inventor Testimony*, Imagine That IP L. Blog (Mar. 23, 2026), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *The POSITA Under BRI: The Constraint That Keeps "Broad" from Becoming "Anything"*, Imagine That IP L. Blog (Feb. 25, 2026), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *Open Source, Closed Door: Managing Patent Risk in Open Source (OSS)-Driven Products*, Imagine That IP L. Blog (Feb. 20, 2026), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *Sharpening the Sword, Exposing the Shield: SDD Practice and the Ironburg "Skilled Searcher" Standard*, Imagine That IP L. Blog (Dec. 1, 2025), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *From Shield to Sword: Using Examiner-Considered Art to Beat § 325(d)*, Imagine That IP L. Blog (Nov. 18, 2025), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *"Settled Expectations" as the New Gatekeeper for PTAB Discretionary Denials*, Imagine That IP L. Blog (June 20, 2025), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *When an IDS Comes Back to Haunt You: Lessons from iRhythm v. Welch Allyn*, Imagine That IP L. Blog (June 13, 2025), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *ChatGPT Meets the POSITA: How AI is Reshaping the Foundations of Patent Law*, The Legal Intelligencer (Apr. 23, 2025); also published at Imagine That IP L. Blog (Apr. 23, 2025), <https://www.vklaw.com/ImagineThatIPLawBlog>.

- Brandon R. Theiss, *The Obvious Choice? Why Result-Effective Variables Matter in Patent Law*, Imagine That IP L. Blog (Feb. 24, 2025), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss & Emily A. Denisco, *Designs on Trial: Comparing U.S. and EU Design Protections Post-LKQ*, Imagine That IP L. Blog (Jan. 23, 2025), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *Artificial Ingenuity: Is Generative AI the New 'Person of Ordinary Skill' in Patent Law?*, Imagine That IP L. Blog (Nov. 21, 2024), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss & Emily A. Denisco, *The Expiration of the After Final Consideration Pilot Program 2.0 (AFCP 2.0)*, Imagine That IP L. Blog (Sept. 30, 2024), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *Patently Unclear: Why Result-Oriented Claims Don't Make the Cut Under 35 U.S.C. § 101*, Imagine That IP L. Blog (Sept. 27, 2024), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss & Emily A. Denisco, *Navigating Final Rejections in Patent Prosecution: AFCP 2.0 vs. 37 CFR § 1.116*, Imagine That IP L. Blog (Sept. 23, 2024), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *A Clear POV on Patent Eligibility Under 35 U.S.C. § 101: Contour's Claims Zoom Back Into Focus in Contour v. GoPro*, Imagine That IP L. Blog (Sept. 11, 2024), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *Understanding the Recent Federal Circuit Decision in Broadband iTV, Inc. v. Amazon.com, Inc. on Patent Ineligibility*, Imagine That IP L. Blog (Sept. 5, 2024), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *Federal Circuit Clarifies Obviousness-Type Double Patenting in Allergan v. MSN Laboratories*, Imagine That IP L. Blog (Aug. 21, 2024), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss & John M. Bollinger, *The Syntax of Markush and Superguide Constructions: Strategies for Claiming Elements in Combination*, Imagine That IP L. Blog (Dec. 13, 2023), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *Challenge to Prior Art in IPR Petitions – Is It Analogous Art?*, Imagine That IP L. Blog (Oct. 20, 2023), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *The Plain and Ordinary Meaning of the Petitioner's Burden in an IPR*, Imagine That IP L. Blog (Oct. 16, 2023), <https://www.vklaw.com/ImagineThatIPLawBlog>.

- Brandon R. Theiss, *Getting A Vector on Additional Pre Institution Briefing in IPRs*, Imagine That IP L. Blog (Sept. 11, 2023), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss & Daniel H. Golub, *A Reasonable Expectation of Success in an IPR Petition*, Imagine That IP L. Blog (Aug. 4, 2023), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss & Douglas J. Bucklin, *After 43 Years The Bayh-Dole Act Still Reigns Over US Government Funded Innovations*, Imagine That IP L. Blog (July 13, 2023), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *Anything You Say May Be Used For Or Against You In A Court Of Patent Law*, Imagine That IP L. Blog (July 5, 2023), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *The "Inventive Step" in Analogous Prior Art*, Imagine That IP L. Blog (May 25, 2023), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *Getting HIP with Inventorship*, Imagine That IP L. Blog (May 11, 2023), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *Potential Issue with Reissue Patents*, Imagine That IP L. Blog (Apr. 26, 2023), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss & Dawn C. Kerner, *Tackling the Sequoia of Claim Construction*, Imagine That IP L. Blog (Apr. 14, 2023), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *Does "A" Still Mean "At Least One" In Open-Ended Claims?*, Imagine That IP L. Blog (Apr. 13, 2023), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss & John M. Bollinger, *"At Least One Of" Revisited: Arguing SuperGuide as a Basis for Patent Validity*, Imagine That IP L. Blog (Mar. 31, 2023), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss & Dawn C. Kerner, *A New Cache to the "Known Technique" Test For Obviousness Under 35 U.S.C. § 103*, Imagine That IP L. Blog (Mar. 16, 2023), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss & Daniel H. Golub, *Director Vidal Further Clarifies When a Discretionary Denial of an IPR is Appropriate Under Fintiv*, Imagine That IP L. Blog (Mar. 9, 2023), <https://www.vklaw.com/ImagineThatIPLawBlog>.

- Brandon R. Theiss & Daniel H. Golub, *Discretionary Denials under Fintiv Rebooted by Vidal's Decision*, Imagine That IP L. Blog (Mar. 3, 2023), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss, *A Different State of Mind: Getting Technical With Post-Grant Proceedings Before the PTAB*, Imagine That IP L. Blog (Jan. 24, 2023), <https://www.vklaw.com/ImagineThatIPLawBlog>.
- Brandon R. Theiss & Gerald B. Halt Jr., *Including a Description of Technical Advantages During Patent Application Drafting May Help Patent Eligibility*, Imagine That IP L. Blog (Oct. 18, 2022), <https://www.vklaw.com/ImagineThatIPLawBlog>.