

Roberto Capriotti

Partner

Pittsburgh
+1.412.355.6423

Palo Alto
+1.650.798.6700

roberto.capriotti@klgates.com

OVERVIEW

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

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

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

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

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

Patent Procurement: Roberto's practice also encompasses the preparation and prosecution and portfolio management of patent applications for a range of technologies including electrical and electronic systems including computers, microprocessors, semiconductor memory devices, software, firmware, internet, nanotechnology, disk drives, wired and RF wireless telecommunications devices and equipment, smartphones, routers, switches, timing error recovery, Viterbi sequence detectors, global positioning systems, optics, digital imaging and compression, and medical devices. His patent procurement and counseling experience includes technologies relating to locomotives and rail transportation, nuclear energy systems, financial payment processing networks, warehouse management and distribution systems, and natural gas drilling and distribution.

Client Counseling: In addition, Roberto's practice involves counseling clients on patent matters, such as developing patent portfolios, non-infringement and freedom-to-use counseling and opinions, and negotiating business transactions. Roberto's practice also encompasses the analysis and preparation of non-infringement, patentability, and freedom-to-use opinions for various technologies including industrial automation systems, haptic touch feedback devices, mobile devices, spectrum analyzers, and medical devices.

PROFESSIONAL BACKGROUND

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

ACHIEVEMENTS

- Recognized by *The Legal 500 United States* as a Recommended Lawyer for Patents: Prosecution (Including Re-Examination and Post-Grant Proceedings), 2026
- Listed as a leader in Pennsylvania, Litigation, Transactions, and Prosecution, *IAM Patent 1000*, 2020–present

PROFESSIONAL / CIVIC ACTIVITIES

- Pittsburgh Ballet Theatre Board of Directors, 2026–Present
- STEM Coding Lab, Pittsburgh, a nonprofit expanding access to computer science education for K-8 students in underserved communities, Board of Directors, 2025–Present
- American Intellectual Property Law Association (AIPLA), Member, 2005–Present)
- AIPLA Membership Committee and Committee on Board Nominations, 2014–Present
- AIPLA Emerging Technologies Committee
  - Chair, 2013–2014
  - Vice Chair, 2011–2013
- AIPLA Intellectual Property Practice in Latin America Committee
  - Chair, 2009–2011
  - Vice Chair, 2007–2009

SPEAKING ENGAGEMENTS

- Panelist, "Interested in Intellectual Property ("IP") Law?" Carnegie Mellon University, 13 January 2010.

- Moderator, "A Global Perspective of IP Licensing - A Comparative Discussion; Do's and Don'ts; and How Recent Developments Have Changed Licensing Practices Around the World," American International Property Law Association (AIPLA) Annual Meeting, 21 October 2009.

EDUCATION

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

ADMISSIONS

- Bar of Pennsylvania
- Not Admitted in California
- United States Patent and Trademark Office

LANGUAGES

- Italian

THOUGHT LEADERSHIP *POWERED BY HUB*

- 25 September 2026, NCS Multistage Inc. v. Nine Energy Service, Inc.: Private Sales Are Not Necessarily Public Disclosures Under the AIA
- 28 August 2026, Federal Circuit Confirms § 112(a) Support Required for a Reference's Provisional Prior-Art Date
- 14 November 2025, USPTO Director Squires Signals Future Update to AI Patent Eligibility Guidance at 2025 AIPLA Annual Meeting

NEWS & EVENTS

- 2 June 2026, K&L Gates IP Practice and Lawyers Recognized in 2026 Edition of IAM Patent 1000
- 6 June 2025, K&L Gates' IP Practice, Lawyers Recognized Among Leaders in 2025 Edition of IAM Patent 1000
- 10 June 2024, K&L Gates' IP Practice, Lawyers Recognized Among Leaders in 2024 Edition of IAM Patent 1000
- 1 August 2023, K&L Gates Intellectual Property Practice Listed Among Leaders in 2023 IAM Patent 1000 Rankings

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

AREAS OF FOCUS

- IP Procurement and Portfolio Management
- IP Litigation
- Payments, Banking Regulation, and Consumer Financial Services
- Post-Grant Patents
- Technology Transactions and Sourcing

INDUSTRIES

- Energy
- Energy Storage and Distributed Resources
- Healthcare
- Logistics and Warehousing
- Nuclear Energy
- Pharmaceuticals, Biologics, and Medical Devices
- Rail and Roads
- Technology
- Transportation and Logistics