James D. Smith ’86

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IP leader to patent judge

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— James Smith ’86

It’s probably an understatement to say that James Smith has a full schedule.

Consider the docket he oversees as chief administrative patent judge at the Board of Patent Appeals and Interferences (BPAI) at the United States Patent and Trademark Office (USPTO): almost 25,500 ex parte appeals from patent examiners’ decisions; expanded jurisdiction under the America Invents Act to hear certain contested proceedings; and oversight of other matters delegated to him by the USPTO director. Aiming to cut the processing time of patent appeals by two-thirds, Smith, who assumed his post in May 2011 by appointment of then-Secretary of Commerce Gary Locke, also has a congressional mandate to hire 100 new BPAI judges by January 2013; by mid-February, he had presided over more than 80 candidate interviews and several dozen hires.

Yet Smith, who is in his fifth year as a member of the Law School’s Board of Visitors, sounds content as he describes his busy schedule, as well as the entire course of his career since his Duke Law graduation.

“I really can’t imagine having scoped out a better 25-year course of study for this job than the one I happened into,” he says of a career in intellectual property law that has included a clerkship at the U.S. Court of Appeals for the Federal Circuit, private practice focused on patent litigation and licensing, oversight of global licensing for Nokia, and service as chief intellectual property counsel for Baxter International.

Having arrived at Duke Law with a degree in electrical engineering in hand and a summer at the USPTO behind him, Smith acknowledges that the “gravitational pull” of intellectual property law was strong from the start. Even as he aimed to keep his options open, he made sure to take every class taught by Professor David Lange, then a virtual one-man IP department, and clerked both summers with Washington firms that specialized in the practice. He practiced patent law with Finnigan Henderson for two years before being recommended by a Duke Law classmate for a clerkship with now Chief Judge Paul R. Michel, who then was the newest judge on the Federal Circuit.

“Those years of practice and learning about litigation, patent law, and patent litigation were a very necessary education before the clerkship,” says Smith, calling his friend’s good word and the clerkship itself life changing events. “The experience that I gained on the court helped frame the years of my career that followed and certainly made me much more comfortable doing this job than I would have felt...
otherwise.” He still turns to Michel’s guidance with regularity, he adds.

Smith returned to private practice following his clerkship. He was focusing on patent litigation at the district court level and serving as managing partner for a Dewey Ballantine office in Texas when he was asked to consider becoming global director of intellectual property licensing at Nokia in 2004. The mobile device manufacturer’s technology and attendant legal issues aligned well with his longtime practice, he says.

“It was just a fabulous job,” he says of his three-and-a-half years at Nokia. “I traveled constantly, participating in licensing and cross-licensing of technology for mobile devices, cell phones, computers — Nokia’s entire product set. And I got to conduct negotiations in countries all over the world, and to visit and participate in companion litigation. The entire time was a highlight reel.”

Smith calls his position as chief intellectual property counsel at Baxter International “equally fabulous.” Significantly, it gave him exposure to biotechnology patent and licensing matters, which has proven useful in his current position, he says.

Smith credits his career satisfaction with motivating his longtime volunteer service on the Duke Law Alumni Association and now on the Board of Visitors.

“Being granted admission to Duke Law was one of the best things that ever happened to me,” he says, noting that such professors as Lange, Jerome Culp, Robert Mosteller, John Weistart, and Sara Sun Beale left a lasting impression.

“It was a fabulous place to go to school — the atmosphere of learning, the simultaneously collaborative and competitive ethos of the school were remarkable. The fabulous opportunities for learning and the caring instruction I received made me feel permanently indebted to the school.”

Smith also praises the efforts of Dean David F. Levi and his predecessors to encourage alumni engagement with Duke Law.

“Just the thrill of being invited back to participate in the Law Alumni Association motivated further interest to get involved.”

— Frances Presma
James Donald Smith, BPAI Chief Administrative Patent Judge

Judge James Donald Smith was appointed to the Board of Patent Appeals and Interferences as the Chief Administrative Patent Judge effective May 8, 2011.

Judge Smith has had a long career in the law and in intellectual property, including a brief time as an examiner at the USPTO. A former Assistant Dean of the law school at Emory University in Atlanta, Smith also served as a clerk at the Federal Circuit, as a patent litigator and patent prosecutor, and led international licensing and day-to-day management of in-house IP teams for three multi-national corporations, Lexmark, Nokia, and most recently Baxter International, where he served as Associate General Counsel and Chief Intellectual Property Counsel.

Judge Smith clerked for now retired Chief Judge Paul Michel at the U.S. Court of Appeals for the Federal Circuit. In addition to his work at Baxter International and Emory University, Smith practiced with Arnold White & Durkee and, later, Dewey Ballantine (now Dewey Le Boeuf), serving as the office managing partner of Dewey’s Texas office, before leaving to serve as the Global Licensing Director for Nokia Corporation.

Judge Smith received a Juris Doctor degree from the School of Law at Duke University and a Bachelor of Science degree in electrical engineering from the University of Maryland at College Park.