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SUMMARY OF EXPERIENCE

Prior to entering private practice, I served for over thirty-three years in the United States Patent and Trademark Office (USPTO) making patentability determinations. The last nineteen years of service in the USPTO was as an Administrative Patent Judge (APJ) on the now Patent Trial and Appeal Board. Previous experience in the USPTO included serving as a Special Program Examiner in the Office of Assistant Commissioner for Patents and as a Patent Examiner.

PATENT EXPERIENCE

BAKER HOSTETTLER

September 2007-Present

Of Counsel

As Of Counsel at Baker Hostetler¹, I advise the firm's clients in regard to issues arising in difficult prosecutions and appeals in patent applications, reissues and reexamination proceedings as well as in contested cases. I am also asked to prepare opinions in regard to patentability, validity and infringement as well as to consult on patentability, claim construction and inequitable conduct issues arising in patent litigations. I have served as a neutral third party adjudicator in a patent interference and have been appointed as a Special Master for claim construction purposes.

CLEMENTS BERNARD

December 2005-September 2007

Of Counsel

I assisted in prosecuting U.S. and foreign patent applications and advised clients on patentability and infringement issues. I also consulted on patentability, claim construction and inequitable conduct issues arising in patent litigations.

¹ Woodcock Washburn LLP merged into Baker Hostetler on January 1, 2014.

ADMINISTRATIVE PATENT JUDGE

May 1986-December 2005

Patent Trial and Appeal Board

My duties and achievements included:

- Served on merits panels of the Board making decisions on ex parte appeals involving original and reissue applications and reexamination proceedings as well as patentability and priority issues in interferences, primarily in the biotechnology and chemical arts. Prepared written opinions applying the law to the facts of each case reflecting the decision and views of at least a majority of the designated panel Board members. Those decisions constituted final agency action and were reviewable only by the Court of Appeals for the Federal Circuit (35 U.S.C. § 141) or by a U.S. District Court (35 U.S.C. §§ 145 and 146).
- Received a Special Act Award for developing and implementing the Biotechnology team at the Board. Created innovative systems for processing biotechnology appeals including those to be heard and to be decided on brief to facilitate decisions on the merits. As a result, the Biotechnology division was able to reduce and maintain its inventory of ex parte appeals from over three years to less than six months.
- Mentored and trained patent examiners and managers as well as other interns and externs who have served at the Board. Also mentored newly appointed APJs as they assumed their duties at the Board.
- Developed and implemented outreach training programs to assist the Patents operation in preparing better cases on appeal.
- Assisted in revising the rules governing Board proceedings, 37 CFR § 41. et seq. (2004).
- Developed and taught courses such as “Legal Analysis in Making Patentability Determinations” at the Patent Academy.
- Frequent speaker at AIPLA and IPO conferences and bar meetings on practice and procedure before the Board and PTO.

SPECIAL PROGRAM EXAMINER

September 1985-May 1986

Office of the Assistant Commissioner for Patents

- Determined issues arising under the duty of disclosure provisions of 37 CFR § 1.56.
- Decided petitions.
- Special projects such as conducting briefings on legal topics for visiting dignitaries.

Resume of William F. Smith

PATENT EXAMINER

September 1972-September 1985

Then existing Examining Group 130, Art Unit 133

- Made patentability determinations in original and reissue applications and in reexamination proceedings. As Primary Examiner (1979-1985), I signed all official actions.
- Received Master's Level rating in the field of Papermaking and a Generalist's rating denoting ability to examine applications in wide ranging technical fields.
- Awards included the Department of Commerce Bronze Medal.

EDUCATION

UNIVERSITY OF BALTIMORE SCHOOL OF LAW, J.D. 1976

GEORGIA INSTITUTE OF TECHNOLOGY, BChE 1972

PUBLICATIONS

"The Times Are Changing at The Board of Patent Appeals and Interferences," *The Legal Intelligencer*, October 15, 2008

Co-author of course materials and co-presenter of Patent Resources Group "When, Why and How to Effectively Appeal to the USPTO Board of Patent Appeals and Interferences" course

Co-author of "Guide To Inter Partes Review," published on IP 360 on August 10, 2012, http://www.law360.com/ip/articles/365324?nl_pk=f9ec904d-8061-4fb1-b81e-a0e71e97742c&utm_source=newsletter&utm_medium=email&utm_campaign=ip

Co-author of "In Order To Form A More Perfect Patent Examination System—It Is Time To Update Compact Prosecution to Compact Prosecution 2.0," posted September 24, 2013 on the IPO Law Journal-Patent Section web page

PROFESSIONAL AFFILIATIONS

Member: Virginia State Bar, AIPLA, IPO (Vice Chair of Patent Office Practice Committee, 2009-present)

Registered to practice before the USPTO

EXPERT REPORTS AND DECLARATIONS

MAX-PLANCK-GESELLSCHAFT ZUR FÖRDERUNG DER WISSENSCHAFTEN E.V.; MAX-PLANCK-INNOVATION GMBH; and ALNYLAM PHARMACEUTICALS, INC., v. WHITEHEAD INSTITUTE FOR BIOMEDICAL RESEARCH; MASSACHUSETTS INSTITUTE OF TECHNOLOGY; and BOARD OF TRUSTEES OF THE UNIVERSITY OF MASSACHUSETTS, U.S. District Court For The District Of Massachusetts, (Civil Action No. 2009-11116-PBS) (On behalf of Max Planck and Alnylam)

FRESENIUS MEDICAL CARE HOLDINGS, INC.; and FRESENIUS USA, INC., v. BAXTER INTERNATIONAL, INC., and BAXTER HEALTHCARE CORPORATION, U.S. District Court; Northern District Of California, (Oakland Division) (Case No. C 03-01431 SBA (EDL)) (On behalf of Fresenius Medical and Fresenius USA)

MAX-PLANCK-GESELLSCHAFT ZUR FÖRDERUNG DER WISSENSCHAFTEN E.V., v. WOLF GREENFIELD & SACKS, PC, U.S. District Court For The District Of Massachusetts, (Civil Action No. 2009-11168-PBS) (On behalf of Max Planck)

SUNOVION PHARMACEUTICALS INC., v. TEVA PHARMACEUTICALS USA, INC., et al., U. S. District Court; District Of New Jersey, (Civil Action No. 09-1302 (DMC)(MF)) (On behalf of Sunovion Pharmaceuticals, Inc.)

GREEN CROSS CORPORATION v. NEKTAR THERAPEUTICS, U. S. District Court; District Of Delaware, (Civil Action No. 09-160) (JAP)) (On behalf of Nektar Therapeutics)

ASTRAZENECA UK LIMITED, IPR PHARMACEUTICALS INC., and SHIONOGI SEIYAKU KABUSHIKI KAISHA, v. WATSON LABORATORIES, INC. (NV), and EGIS PHARMACEUTICALS, PLC, U.S. District Court Of Delaware (Civ. No. 10-915-LPS) (On behalf of AstraZeneca UK Limited et al.)