

JAMES DONALD SMITH



POSITIONS

Chief Intellectual Property Counsel – ECOLAB COMPANY

St. Paul, Minnesota
2015 - Present

Chief intellectual property counsel for a multi-national, provider of water, hygiene and energy technologies and services with \$14 billion in annual revenue; responsible, globally, for intellectual property litigation and licensing, and for all matters related to patent prosecution, trademarks, copyrights, and related areas; management of in-house staff, including intellectual property lawyers, and all outside IP counsel worldwide; reporting to Vice President and General Counsel.

Adjunct Professor – University of South Dakota School of Law, Vermillion, SD

Chief Administrative Patent Judge -- U.S. PATENT TRIAL AND APPEAL BOARD

Alexandria, Virginia (DC)
2011 - 2015

Chief Judge of the tribunal of the U.S. Patent and Trademark Office (and tribunal's predecessor, the Board of Patent Appeals and Interferences) responsible for appeals arising from decisions of the Office not to grant patent rights and trials on matters of patentability and invention priority; oversee operations involving 230 judges, and 80 staff in six offices in 5 cities (DC, Detroit, Denver, Dallas, and Menlo Park), including achieving Board expansion from 95 to 230 judges and from 1 office to 6 offices, and for the Board's implementation of changes to the patent system under the America Invents Act of 2011; oversee and participate in decisional work on more than 11,000 matters per year; oversee personnel matters including selection of supervisory judges, and the budget; reporting to U.S. Under Secretary of Commerce for Intellectual Property.

Associate General and Chief Intellectual Property Counsel -- BAXTER INTERNATIONAL, INC.

Deerfield, Illinois
2007 - 2011

Chief intellectual property counsel for a multi-national, diversified healthcare products (and services) company with approximately \$12 billion in annual revenue; responsible, globally, for intellectual property litigation and licensing, and for all matters related to patent prosecution, trademarks, copyrights, and related areas; management of 36 person in-house staff, including approximately 20 intellectual property lawyers, and all outside IP counsel worldwide; reported to Vice President and General Counsel.

Global Director, Intellectual Property Rights (IPR), Licensing -- NOKIA CORPORATION

Irving, Texas; Helsinki, Finland
2005 (February 2005 – October 2007)

Served as lead IPR licensing negotiator for and oversaw and directed all aspects of patent licensing programs for leading mobile communications company with approximately \$40 billion in annual revenue, including management of strategic licensing relationships with all major multi-national companies; advised on all major IPR litigation and portfolio management decisions; managed licensing group of 25 in five offices; reported to Global Vice President of IPR.

Office Managing Partner -- DEWEY BALLANTINE, L.L.P. (approximately 700 lawyers)

Austin, Texas
2002 – 2005 (*Partner* 2002 – 2004; *Managing Partner* 2004 – 2005) (40 lawyers and staff)
[As part of the same attorney practice group from 1998 to 2005.]

Intellectual property litigation; strategic counseling to high technology companies on matters related to licensing, portfolio building and management; licensing negotiations in connection with mergers and acquisitions and portfolio purchases, and settlements; preparation of validity and infringement opinions; due diligence activities related to acquisitions.

Partner -- BROBECK, PHLEGER & HARRISON, L.L.P. (approximately 800 lawyers)

Austin, Texas
1998 - 2002

Intellectual property litigation; strategic counseling to high technology companies on matters related to licensing, portfolio building and management; licensing negotiations in connection with mergers and acquisitions and portfolio purchases, and settlements; preparation of validity and infringement opinions; due diligence activities related to acquisitions.

Chief Counsel, Intellectual Property Law -- LEXMARK INTERNATIONAL, INC.
(Formerly the Office Products Division of IBM)

Lexington, Kentucky
1996 - 1998

Chief intellectual property law officer for laser and ink jet printer and supplies company with \$2.6 billion in annual revenue; responsible for litigation, licensing, and worldwide operations in patent, trademark, copyright, and related areas; primary negotiator for all worldwide IP licensing matters; managed 10-person in-house staff and all outside IP counsel worldwide; reported to Vice President and General Counsel.

Partner -- ARNOLD, WHITE & DURKEE

Houston, Texas; Minneapolis, Minnesota
1989 - 1992; 1993 - 1995: ***Associate***; 1996: ***Partner***

IP litigation; preparation of infringement, validity and product clearance opinions; reissue and reexamination proceedings (including preparation of protests and requests); counseling on portfolio management and licensing; and preparation and prosecution of patent applications.

Adjunct Professor - William Mitchell College of Law, St. Paul, MN - Spring 1995 (Patent Litigation)
South Texas College of Law, Houston, TX - Fall 1993 (Patent Litigation)

***Assistant Dean and Dean of Students,
Adjunct Intellectual Prop. Law Prof. (non-tenure track) --*** EMORY UNIVERSITY SCHOOL OF LAW

Atlanta, Georgia
Spring, 1992 - Fall, 1993 **[Four semesters.]**

Student services staff management; academic and personal counseling; teaching (IP law course on patents, trademarks, copyrights and trade secrets; appellate advocacy; and upper level directed research in IP Law); IP law curriculum coordination; Moot Court Program Director; Equal Opportunity and Faculty and Student Misconduct Officer; liaison to other university departments and bar associations.

Of Counsel - Arnold, White & Durkee, Houston, TX: Spring, 1992 - Fall, 1993

Law Clerk to (Ret.) Cir. Judge Paul Michel -- U.S. COURT of APPEALS for the FEDERAL CIRCUIT

Washington, D.C.: 1988 - 1989

Associate -- FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER

Washington, D.C.: 1986 - 1988
Preparation and prosecution of patent applications; infringement and validity opinions; and litigation.

Patent Examiner -- U.S. PATENT AND TRADEMARK OFFICE

Arlington, Virginia: 1983

SCHOLASTICS

Juris Doctor -- DUKE UNIVERSITY

Durham, North Carolina; 1986

Chairman, Moot Court Board
Dean's Advisory Council
Law School Admissions Committee
Vice President, Black Law Students Association
Intramural Men's Basketball Champion

Bachelor of Science in Electrical Engineering -- UNIVERSITY OF MARYLAND

College Park, Maryland; 1983

Tau Beta Pi and Eta Kappa Nu Engineering Honor Societies
National Achievement Scholar
Chancellor's Scholar
General Honors Program
University Board of Regents Selection Panel
Undergraduate Admissions Scholarship Committee
Intramural Basketball Champion

MEMBERSHIPS

Licenses - Minnesota, Pennsylvania, Texas and United States Patent Bars

Associations - American Bar Association; American Intellectual Property Law Association;
Federal Circuit Bar Association; Minnesota Bar Association; Minnesota Intellectual
Property Law Association; National Bar Association; Pennsylvania Bar Association;
Texas Bar Association; Intellectual Property Law Association of Chicago.