

# Called to Serve

## TWO PROMINENT GW LAW ALUMNI ENJOY SECOND CAREERS AS ADMINISTRATIVE PATENT JUDGES

BY LAURA HAMBLETON

THROUGHOUT HIS LIFE AS AN ATTORNEY, TOM SMEGAL, JD '61, has excelled in two areas: patent law and public service. Regarding the former, he is one of the country's top experts on intellectual property, having practiced for more than 50 years at several law firms, ending his career at a San Francisco firm.

At the same time, he has represented clients too poor to pay him, which led the National Legal Aid and Defender Association to honor him for his lifelong dedication to the indigent. He also was named twice to the board of directors of Legal Services Corp., once by President Ronald Reagan and again by President Bill Clinton.

Now, at 78, Mr. Smegal has been called to serve again, this time as one of the newest judges on the expanded Patent Trial

“IT IS NOT UNUSUAL FOR LAWYERS WITH LONG YEARS OF PRACTICE EXPERIENCE TO SERVE AS JUDGES. IN FACT, EXPERIENCE AND EXPERTISE ARE FUNDAMENTAL REQUIREMENTS FOR GOOD JUDGES.”

—James Smith

and Appeal Board. He joins another GW Law graduate, Tom Giannetti, JD '76, as one of 170 judges on the board. The board will grow to 220 by the fall.

“Their presence greatly enhances our ability to meet the challenges before us,” says James Smith, the chief administrative patent judge. “It is not unusual for lawyers with long years of practice experience to serve as judges. In fact, experience and expertise are fundamental requirements for good judges.”

The intent of hiring new judges, under the America Invents Act of 2011, is to streamline the appeals process for inventors or companies challenging the validity of a patent decision by the U.S. Patent and Trademark Office. Prior to this act of Congress, the board had a backlog of 27,000 cases, which could have easily mounted to 30,000 to 40,000 in the next few years, Mr. Smith says.

In addition to its original base in Alexandria, Va., the board now has offices in Denver, Detroit, Dallas, and the Silicon Valley region of California.

Mr. Smegal adjudicates from his law office on the 21<sup>st</sup> floor



Administrative Patent Judge  
Tom Smegal, JD '61



Administrative Patent Judge  
Tom Giannetti, JD '76

of a downtown San Francisco building, where he practiced law for 15 years. Similar to his days as a partner, he routinely puts in 12 hours daily, staying in touch with the other patent judges electronically.

When he turned 70 in 2005, Mr. Smegal faced mandatory retirement from his law firm. “Partners have to step out at age 70 [from Knobbe, Martens, Olson & Bear],” he says. “I had no interest in retiring. I became a mediator and arbitrator and would be continuing to do that, except this judgeship seemed like something fun to do.”

He knows how an examiner thinks since he worked as one in the late 1950s while attending law school at night. After his studies and a stint in the military, Mr. Smegal started his career in 1961 as a patent attorney with Shell Development Co. in California. That led to becoming partner in three different San Francisco law firms: Townsend and Townsend, Graham & James, and then Knobbe, Martens, Olson & Bear until 2005.

In private practice, Mr. Smegal wrote thousands of applications for U.S. patents and trademarks as well as hundreds of infringement and validity opinions on patents. He was the lead trial counsel in the U.S. District Courts on many trials that involved patent validity and infringement.

Pro bono cases, though, drew more and more of his attention. As a young lawyer new to San Francisco, he received a case from

the Ninth Circuit Court, for which he was asked to get a retrial for an inmate in San Quentin. He won a retrial but lost the case, and the prisoner returned to San Quentin.

That case stirred a passion in him to represent those without means. Mr. Smegal helped start the Employment Law Center and a youth legal program in San Francisco, called the National Center for Youth Law. He fought to keep funding for the Legal Aid Society during years of threats of cuts in funding from members of Congress. In addition, Mr. Smegal served in many capacities on the American Bar Association, the California Bar Association, and various boards focused on patent and intellectual property law.

The Law School named him alumnus of the year in 1996.

When Mr. Giannetti, 66, received the call to join the Board of Patent Appeals and Interferences (now called the Patent Trial and Appeal Board) more than a year ago, he was considering whether to take a position as an in-house corporate lawyer. He had retired as a partner with Jones Day in 2010, and was looking for just the right opportunity. He had read that Congress was hoping to reform the way patent disputes were handled, and when his daughter saw another story that the Board of Patent Appeals and Interferences was expanding, he decided to apply to be a judge.

With his background in patent litigation, his experience made him an ideal fit. He was hired.

There was just one hitch: Mr. Giannetti and his wife were living in New York City, but the position was in Alexandria, Va. "My wife and I decided to divide our time between Alexandria and New York," he says. "She has a website that covers New York and D.C., womanaroundtown.com, so this fit in perfectly with her." He started in March 2012.

After Mr. Giannetti graduated from Yale University in 1968, he debated between working and going to law school. He took a job with Westinghouse Electric, stayed five years, and earned a master's degree at Carnegie Mellon. In 1973, he entered law school at GW.

"I was always interested in science, research, and writing," he says. "Like many people in the field with a keen interest in science, I didn't want to be a scientist. I had other skills. Patent law offered that to me."

Mr. Giannetti was attracted to GW because of its classes in patent law. He interned at some law firms in Washington, D.C., during his summers, moving to New York for a job with Fish & Neave. He became a partner; after 25 years, he joined Jones Day.

"Lawyers move all the time to bigger firms with larger platforms," he says.

As for the judgeship with the Patent Trial and Appeal Board, Mr. Giannetti is energized by the new opportunity and doesn't have plans to retire anytime soon.

"It's a little bit like litigation," he says. "Every day is a little different. You are not sure what is going to happen. The usual day involves writing and reviewing of opinions. There are always emergency things, where I have to file an order or have a conference. It's unpredictable. I am reading opinions by others and drafting opinions of my own."

Mr. Giannetti, like Mr. Smegal, is happy to start a new career past the normal retirement age. "I've had a very good experience," he says.

## WITH GRATITUDE

Vinod Gupta created The Ben Gupta Endowed Fund for International Legal Education. The \$1 million endowed scholarship will support students from developing countries seeking JD or LLM degrees, and those pursuing educational opportunities at the Law School on a non-degree basis. The fund is named for Mr. Gupta's son, a former JD/MBA student at GW who died in December 2011.

The Lawrence and Carol Horn Intellectual Property Scholarship was endowed with a gift of \$100,000 from the parents of former student Steven Horn. It will begin in 2015.

The Murray J. Schooner Endowed Government Procurement Law Scholarship was established with more than \$100,000 in gifts raised by Associate Dean for Government Procurement Law Studies Daniel I. Gordon, along with students, alumni, and family and friends of Mr. Schooner—the late father of Professor Steven L. Schooner, LLM '89. The scholarship will provide financial aid to second- and third-year JD or LLM students studying Government Procurement Law.

Former Federal Reserve Chairman Paul A. Volcker established the Paul A. Volcker Scholarships after a successful \$250,000 campaign. Two scholarships will be presented annually to second- or third-year law students with demonstrated financial need and strong academic records who intend to work with government agencies in the field of financial regulation.

A \$100,000 pledge by Lynn David created the Lynn David Research Professorship.

GW Law received an anonymous gift of \$125,000 to support a scholarship fund.

Now in its ninth year, the Class Gift Campaign enjoyed a 57 percent overall participation rate, with a record 44 percent of the class signing multi-year pledges. The Law School received an anonymous planned gift of \$40,000 and a multi-year pledge from Joseph D. Edmondson, Jr., BA '88, JD '91, to challenge the Class of 2013. A number of GW Law professors and deans also provided monetary incentives to help endow a scholarship.

Howard Rudge, JD '64, retired senior vice president of DuPont Corp., awarded a cash prize of \$5,000 to Caitlin Clarke, JD '13, for her winning paper on reducing youth unemployment. Mr. Rudge endowed the prize with a gift of \$150,000.

James A. Gass, JD '73, pledged a gift of \$100,000, which will double his scholarship fund. The James A. Gass Scholarship Fund provides financial aid to students from developing countries.

An anonymous pledge of \$375,000 was made to the Law School to benefit the Government Procurement Law Program.

GW Law will receive over \$200,000 in awards this year from Microsoft that will support three program areas: Intellectual Property; the Internet Freedom and Human Rights Program, and the Competition Law Center.