

Brown & Wood LLP. She served as a law clerk to the now-Chief Judge Paul R. Michel of the Federal Circuit. Ms. Schneider graduated from Northwestern University School of Law.

Michael R. Weiner, *Marshall, Gerstein & Borun LLP*

Mr. Weiner is a partner at Marshall, Gerstein & Borun LLP. He previously served as a law clerk to the Honorable S. Jay Plager of the Federal Circuit. He is an alumnus of the University of Illinois College of Law, where he graduated summa cum laude.

The Roundtable will be moderated by Professor Timothy R. Holbrook, who served as a law clerk to the Honorable Glenn L. Archer, Jr., former Chief Judge of the Federal Circuit.

» THE ROUNDTABLE

The Roundtable was inaugurated last year in conjunction with the visit of the Honorable Arthur J. Gajarsa of the Federal Circuit, who also served as the Charles E. Green Lecturer in Law and Technology. The Roundtable is an annual event where former Federal Circuit clerks discuss current issues surrounding the Federal Circuit and patent law. The clerks offer their unique perspectives on a range of issues of great importance to patent practice.

The Roundtable is sponsored by Chicago-Kent's Intellectual Property program. Chicago-Kent founded one of the first programs in IP law in the United States more than two decades ago and is nationally recognized as a leader in the field. As the importance of IP law has expanded, the program has continued to reflect and anticipate the constant challenges of contemporary IP practice. The IP Program includes a certificate program for J.D. students in intellectual property and the nation's first LL.M. in International Intellectual Property Law.

2nd annual
» Federal Circuit
Clerk Roundtable

Monday, October 31, 2005
1:00 - 3:00 pm, Room 580

**“Waiving Your Patent Case
Goodbye: Preserving Issues
for Appeal in an Era of
De Novo Review”**

» WAIVING YOUR PATENT CASE GOODBYE: PRESERVING ISSUES FOR APPEAL IN AN ERA OF DE NOVO REVIEW

The U.S. Court of Appeals for the Federal Circuit hears all appeals from cases arising under the patent laws of the United States. Congress created the Federal Circuit in 1982 to bring uniformity to U.S. patent law. In furtherance of that objective, the Federal Circuit concluded that the interpretation of a patent is a question of law for the court, not a jury, to decide and that such issues are reviewed on appeal under the plenary, de novo standard. The court exercises de novo review in other significant areas as well, such as various issues relating to the validity of a patent.

Such plenary review, however, creates tension with the procedural rule that issues not raised at the trial court are waived on appeal. If the court is truly discerning the correct meaning of the patent, then why should new arguments be precluded? The Federal Circuit undisputedly has the authority to adopt any construction of the patent claim it would like. Indeed, it has adopted interpretations proffered by neither party.

If a party articulates a claim construction argument that it did not raise below, when - or should - the party be viewed as having waived it? The Federal Circuit has not provided much guidance in this regard and has offered seemingly contradictory opinions on the matter. Parties before the court therefore frequently encounter this difficulty. Further complicating matters is the tendency of litigants to file conditional cross-appeals to preserve various issues, incurring the ire of the Federal Circuit, as demonstrated in the case *Bailey v. Dart Container Corp.*, 292 F.3d 1360 (Fed. Cir. 2002).

The Roundtable, composed of former law clerks at the Federal Circuit, will address this pressing concern. The participants presently scheduled include:

Meredith Martin Addy, *Brinks Hofer Gilson & Lione*

Ms. Addy is a shareholder at Brinks Hofer Gilson & Lione. She is a former clerk to the

Honorable Paul R. Michel, the current Chief Judge of the Federal Circuit. Ms. Addy currently serves on the Advisory Council for the Federal Circuit. She earned her J.D. at the University of Georgia and her LL.M. in Intellectual Property, with honors, at John Marshall Law School.

Laura L. Donoghue, *Sidley Austin Brown & Wood LLP*

Ms. Donoghue is an associate at Sidley Austin Brown & Wood LLP. She is a former law clerk to the Honorable Timothy B. Dyk of the Federal Circuit and also to the Honorable Amy J. St. Eve, United States District Court for the Northern District of Illinois. She is a graduate of the University of Chicago Law School.

Sasha D. Mayergoyz, *Latham & Watkins LLP*

Mr. Mayergoyz is an associate with Latham & Watkins LLP. He is a former clerk for the Honorable Arthur J. Gajarsa of the Federal Circuit. Mr. Mayergoyz earned his J.D. from Northwestern University School of Law.

David McKone, *Latham & Watkins LLP*

Mr. McKone is an associate at Latham & Watkins LLP and served as a law clerk to the Honorable William Bryson of the Federal Circuit. He graduated from the University of Michigan Law School.

Peter N. Moore, *Latham & Watkins LLP*

Mr. Moore is associated with Latham & Watkins. He is a former law clerk to the Honorable William Bryson of the Federal Circuit. He earned his law degree from Northwestern University School of Law.

Kristen R. Osenga, *Visiting Assistant Professor of Law, Chicago-Kent College of Law*

Ms. Osenga is currently a Visiting Assistant Professor of Law at Chicago-Kent. She is a former law clerk to the Honorable Richard Linn of the Federal Circuit. She is an alumna of the University of Illinois College of Law, where she earned her J.D. magna cum laude.

Lisa A. Schneider, *Sidley Austin Brown & Wood LLP*

Ms. Schneider is a partner at Sidley Austin