

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.

## » ABOUT THE ROUNDTABLE

The Roundtable was inaugurated two years ago 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.

## 3<sup>rd</sup> annual Federal Circuit Clerk Roundtable

Wednesday, November 1, 2006  
3:00 - 4:00 pm, Room 580

**“Not So Obvious: Patent Law,  
the Supreme Court, and *KSR*  
*International*”**

CHICAGO-KENT COLLEGE OF LAW  
ILLINOIS INSTITUTE OF TECHNOLOGY

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## » NOT SO OBVIOUS: PATENT LAW, THE SUPREME COURT, AND KSR INTERNATIONAL

Although the U.S. Court of Appeals for the Federal Circuit hears all cases from across the country arising under the patent laws, the Supreme Court recently has taken an increasing interest in reviewing the Federal Circuit's patent cases. Some of the Justices have expressed a greater interest to have the Supreme Court, as a generalist institution, enter recent debate about the appropriate scope of patent protection. Justice Breyer, dissenting from the dismissal of the case *Laboratory Corp. of Am. V. Metabolite Laboratories, Inc.* that would have addressed patent eligible subject matter, noted that "a decision from this generalist Court could contribute to the important ongoing debate, among both specialists and generalists, as to whether the patent system, as currently administered and enforced, adequately reflects the 'careful balance' that 'the federal patent laws. . . embody[y].'"

Along those lines, the Court has granted *certiorari* in the case *KSR Intern.Co. v. Teleflex, Inc.*, which concerns when an invention is obvious under patent law, a central and vital part of the patent system. Specifically, the Court is set to address what effect the presence or absence of a motivation to combine prior scientific and technical references has on assessing whether an invention claimed in the patent is an obvious one. The Federal Circuit has required that a motivation be present in order to find an invention obvious. Commentators have criticized this standard as unduly formalistic, permitting trivial inventions to garner patent protection.

The Roundtable, composed of former law clerks to various judges at the Federal Circuit, will address the likely outcome of this case and various ways in which the Supreme Court could doctrinally alter the obviousness inquiry. Moreover, the clerks will discuss the institutional role of the Supreme Court vis-à-vis the Federal Circuit and whether this recent rash of cases by the Supreme Court portends greater involvement by the Court or is merely a passing fancy.

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.

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

Ms. Schneider is a partner at Sidley Austin 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.