

4th annual
Federal Circuit
Clerk Roundtable

Wednesday, September 19, 2007
3:00 - 4:00 pm

***“MedImmune and SanDisk:
Seeking a License Without
Getting a Lawsuit”***

1.0 hour of IL MCLE credit

CHICAGO-KENT COLLEGE OF LAW
ILLINOIS INSTITUTE OF TECHNOLOGY

565 West Adams Street • Chicago, IL 60661

» ***MEDIMMUNE AND SANDISK: SEEKING A LICENSE WITHOUT GETTING A LAWSUIT***

In *MedImmune v. Genentech*, the Supreme Court concluded that the holder of a patent license could challenge the validity of that patent by bringing a declaratory judgment action without breaching the license. In so doing, the Supreme Court rejected the Federal Circuit's requirement that an accused infringer have a reasonable apprehension of being sued in order to file such an action. Subsequently, the Federal Circuit in *SanDisk* concluded that even invitations to license a patent can be sufficient to bring a declaratory judgment action.

The *SanDisk* decision makes it difficult for patent owners to seek licenses without opening themselves up to lawsuits. Moreover, patentees who have not marked their products with the patent number must provide notice to a potential infringer before they can receive damages. It may be difficult, if not impossible, to satisfy this notice requirement without triggering declaratory judgment jurisdiction.

The Roundtable, composed of former Federal Circuit law clerks, will address the implications of these decisions, strategies that attorneys can use to avoid triggering unwanted declaratory actions for patentees, and advantages these decisions may provide for accused infringers.

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.

Michelle Armond, *Marshall, Gerstein & Borun LLP*

Ms. Armond is currently an associate at Marshall, Gerstein & Borun and is a former law clerk to the Honorable Richard Linn of the Federal Circuit.

Leonard D. Conapinski, *McDermott Will & Emery LLP*

A former clerk to the Honorable Alvin A. Schall of the Federal Circuit, Mr. Conapinski is currently associated with McDermott Will & Emery.

Laura L. Donoghue, *Sidley Austin LLP*

Ms. Donoghue is an associate at Sidley Austin 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.

Laura A. Lydigsen, *Brinks Hofer Gilson & Lione*

Ms. Lydigsen is associated with Brinks Hofer Gilson & Lione. Prior to joining Brinks, she was a law clerk to both the Honorable Alvin A. Schall of the Federal Circuit and the Honorable Ruben Castillo of the Northern District of Illinois.

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.

David C. McKone, *Latham & Watkins LLP*

Mr. McKone is an associate at Latham & Watkins LLP. He is a former law clerk to the Honorable William Bryson of the Federal Circuit.

Lisa A. Schneider, *Sidley Austin LLP*

Ms. Schneider is a partner at Sidley Austin LLP. She served as a law clerk to the now-Chief Judge Paul R. Michel of the Federal Circuit.

Jonathan R. Spivey, *Foley & Lardner LLP*

Mr. Spivey is Senior Counsel with Foley & Lardner and a former clerk to the Honorable H. Robert Mayer of the Federal Circuit.

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.

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 three 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.