

Patentable Subject Matter: Anything Under the Sun Made by Man...*Really?*

Fifth Annual Federal Circuit Clerk Roundtable

Wednesday, Oct. 15, 2008

3:00 - 4:00 PM

Room C50

Free of charge

Ever since the Supreme Court's landmark decision in *Diamond v. Chakrabarty*, the appropriate subject matter for patent protection has appeared to be ever-expanding. The likely highwater mark for this trend was the Federal Circuit's decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, in which the Federal Circuit confirmed the patentability of business methods. In *State Street's* wake have come inventions relating to software, sports moves, and tax preparation strategies. The several Supreme Court justices expressed their displeasure with the current state of the law in dissenting from the dismissal of *Laboratory Corp. of America Holdings v. Metabolite Laboratories, Inc.* The Federal Circuit may have taken the Court's cue, as in *In re Comiskey* and *In re Nuijten*, the court concluded that the relevant patent claims covered ineligible subject matter. And, of course, *In re Bilski* is currently pending *en banc* to clarify the law of eligible subject matter, including whether to overrule *State Street*.

At this event, former clerks at the Federal Circuit will discuss the cases leading up to *Bilski*, will explore possible outcomes, and analyze hypothetical claims to determine whether such claims do -- or should -- constitute eligible subject matter.

Scheduled to participate are:

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.

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.

David C. McKone, *Nixon Peabody LLP*

Mr. McKone is an associate at Nixon Peabody LLP. He is a former law clerk to the Honorable William Bryson 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.