

Curriculum Vitae

Janice M. Mueller

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CURRENT EMPLOYMENT

9/09 **Co-Founder and Faculty Member, Chisum Patent Academy, Inc.**
to Present Seattle, WA

TENURE-STREAM APPOINTMENTS

7/04 **Professor of Law, University of Pittsburgh Law School**
to 7/11 Courses: Patent Law, Advanced Topics in Patent Law Seminar, International
Intellectual Property Law, Property Law.
Director, J.D. Certificate Program in Intellectual Property and Technology Law,
January 2006 to July 2011.
Chair, Faculty Appointments Committee, 2006-07.
Faculty Advisor, Giles S. Rich (Patent) and BMI/Cardozo (Copyright)
Intellectual Property Moot Court Teams.

8/03 **Professor of Law, John Marshall Law School, Chicago, Illinois**
to 7/04 Associate Professor with Tenure, 8/01-8/03.
Associate Professor on Tenure Track, 7/99-7/01.
Courses: Antitrust Law, Intellectual Property Law, Patent and Trade Secret Law,
Substantive Patent Law I: Patent Procurement (LL.M.), Substantive Patent Law
II: Patent Enforcement (LL.M.).
Faculty Advisor to Giles S. Rich Intellectual Property Moot Court Team (2001
National Champions) 1999-2004;
Faculty Advisor to *JMLS Review of Intellectual Property Law*, 2001-2004.

7/96 **Assistant Professor of Law**
to 6/99 **Suffolk University Law School, Boston, Massachusetts**
Courses: Patent Law, Trademark Law, Intellectual Property Law Survey,
International/Comparative Intellectual Property Seminar.
Faculty Advisor, High Technology Concentration Theses.
Faculty Advisor to Giles S. Rich Intellectual Property Moot Court Team (1997 &
1999 National Runners-Up) 1996-1999.

VISITING APPOINTMENTS AND INSTRUCTORSHIPS

- 1/2012
To 6/2012 **Adjunct Professor of Law**
University of Kentucky College of Law, Lexington, Kentucky
Course: Patent Law
- 1/2010
to 6/2010 **Visiting Professor of Law**
University of Kentucky College of Law, Lexington, Kentucky
Courses: Patent Law; Advanced Topics in Patent Law Seminar.
- 1/08
to 6/08 **Visiting Professor of Law**
Seattle University School of Law, Seattle, Washington
Courses: Patent & Trade Secret Law; Intellectual Property Law.
- 7/07
to 12/07 **Visiting Professor of Law**
University of Washington School of Law, Seattle, Washington
Course: Intellectual Property Core (co-taught LL.M. course; 8 quarter credits).
- 1/02
to 5/02 **Visiting Associate Professor of Law**
Santa Clara University School of Law, Santa Clara, California
Courses: Trademark and Unfair Competition Law, Patent Litigation Seminar.
- 8/95
to 6/96 **Visiting Assistant Professor of Law**
William Mitchell College of Law, Saint Paul, Minnesota
Courses: Patent Law, Intellectual Property Survey.
- 8/99, 8/00
8/01, 8/02,
8/03, 8/05,
8/07, 8/09 **Instructor**, Baylor University Law School
Foreign Summer Program in Guadalajara, Mexico
Course: International/Comparative Intellectual Property Law.
- 6/04 **Instructor**, Suffolk University Law School, Summer Program at the University of
Lund, Sweden
Course: International Intellectual Property Law.
- 7/03 **Instructor**, Tulane University Law School, Summer Program in Amsterdam,
Netherlands
Course: U.S. Intellectual Property I: Patent Law.
- 6/01 **Instructor**, St. Thomas University (Miami) School of Law
Summer in Spain Program, San Lorenzo de El Escorial, Spain
Course: International/Comparative Intellectual Property Law.

OTHER PROFESSIONAL EMPLOYMENT

- 10/92 **Trial Attorney**
to 7/95 Attorney General's Honors Program
United States Department of Justice, Washington, D.C.,
Civil Division, Commercial Litigation Branch, Intellectual Property Section
[Patent & Copyright Litigation in the U.S. Claims Court and U.S. Court of
Appeals for the Federal Circuit].
- 9/90 **Law Clerk to the Honorable Giles S. Rich**
to 9/92 United States Court of Appeals for the Federal Circuit, Washington, D.C.
- 5/88 **Patent Agent/Intellectual Property Law Clerk**
to 8/90 Merchant & Gould, P.A., Minneapolis, Minnesota
[Patent and trademark prosecution & litigation].
- 4/86 **Research Engineer and Manufacturing Systems Engineer**
to 5/88 Honeywell, Inc., Corporate Systems Development Division,
Minneapolis, Minnesota.
- 3/82 **Chemical Engineer, Cooperative Education Program**
to 9/84 Ashland Oil, Inc., Ashland, Kentucky.

EDUCATION

William Mitchell College of Law, St. Paul, Minnesota

Juris Doctor, *Magna Cum Laude*, June 1990.

Giles S. Rich Moot Court Regional Team Member, 1989-90.

WILLIAM MITCHELL LAW REVIEW, Staff Member, 1987-88.

Published student article: J. Mueller, *Determining the Scope of Copyright Protection for Computer/User Interfaces*, IX COMPUTER/LAW JOURNAL (University of Southern California Law Center) (Winter 1989).

Virginia Polytechnic Institute, Blacksburg, Virginia

B.S. Chemical Engineering, *Magna Cum Laude*, March 1986.

Minor in Economics.

Tau Beta Pi, Omega Chi Epsilon (engineering honoraries).

BOOKS

J. MUELLER, PATENT LAW, THIRD EDITION (Aspen 2009) (ISBN-13: 978-0-7355-7831-9).

ARTICLES

J. Mueller, *Facilitating Patient Access to Patent-Protected Genetic Testing*, 6:1 J. BUSINESS AND TECH. L. 81 (forthcoming 2011); U. of Pittsburgh Legal Studies Research Paper No. 2010-32 (Oct. 19, 2010), available at SSRN: <http://ssrn.com/abstract=1694760>.

J. Mueller and Daniel H. Brean, *Overcoming the "Impossible Issue" of Nonobviousness in Design Patents*, 99 KENTUCKY L.J. 419 (forthcoming 2011), Univ. of Pittsburgh Legal Studies Research Paper No. 2009-30 (Nov. 12, 2009), available at SSRN: <http://ssrn.com/abstract=1505384>.

J. Mueller and Donald S. Chisum, *Enabling Patent Law's Inherent Anticipation Doctrine*, 45 HOUSTON L. REV. 1101 (2008), available at SSRN: <http://ssrn.com/abstract=1153493>.

J. Mueller, *Chemicals, Combinations, and "Common Sense": How the Supreme Court's KSR Decision Is Changing Federal Circuit Obviousness Determinations in Pharmaceutical and Biotechnology Cases*, 35 N. KY. U. L. REV. 281 (2009), available at SSRN: <http://ssrn.com/abstract=1079118>.

J. Mueller, *Biotechnology Patenting in India: Will Bio-Generics Lead a "Sunrise" Industry to Bio-Innovation?*, 76 UMKC L. REV. 437-490 (2007), available at SSRN: <http://ssrn.com/abstract=1087131>.

J. Mueller, *Patenting Human Embryonic Stem Cells in the United States: The Legal and Ethical Debate*, 14 CENTER FOR ADVANCED STUDY AND RESEARCH IN INTELLECTUAL PROPERTY (CASRIP) NEWSLETTER (Autumn 2007), <http://www.law.washington.edu/CASRIP/Newsletter/Vol14/newsv14i4StemCell.html>, available at SSRN: <http://ssrn.com/abstract=1413448>.

J. Mueller, *Taking TRIPS to India—Novartis, Patent Law, and Access to Medicines*, NEW ENG. J. MED. (Feb. 8, 2007), at 541-43, available at <http://content.nejm.org/cgi/reprint/356/6/541.pdf> and SSRN: <http://ssrn.com/abstract=1397729>.

J. Mueller, *The Tiger Awakens: The Tumultuous Transformation of India's Patent System and the Rise of Indian Pharmaceutical Innovation*, 68 UNIVERSITY OF PITTSBURGH L. REV. 491-641 (2007), available at SSRN: <http://ssrn.com/abstract=923538>. English and

Japanese translation published in book form by Intellectual Property Division, Tokyo Medical and Dental University (Oct. 2008).

- J. Mueller, *Patent Controls on Genetically Modified Crop Farming*, 4 SANTA CLARA J. INT'L L. 1 (2006), available at SSRN: <http://ssrn.com/abstract=1346543>.
- J. Mueller, *Supreme IP: Moving Beyond Merck*, IP LAW & BUSINESS (Sept. 2005), at 26-27.
- J. Mueller, *Slaying the Patent Trolls: Proposed Cure is Worse than the Disease*, UNIVERSITY OF PITTSBURGH LAWNOTES (Fall 2005), at 1, available at SSRN: <http://ssrn.com/abstract=1395880>.
- J. Mueller, *Supreme Court Decision Curbs Rights of Patent Holders*, IP LAW BULLETIN (June 13, 2005), available at <http://www.iplawbulletin.com/> and at SSRN: <http://ssrn.com/abstract=1367858>.
- J. Mueller, *Antitrust Issues in Intellectual Property Cases*, PROCEEDINGS OF THE ABA ANTITRUST SECTION SPRING MEETING 2005 FUNDAMENTALS PROGRAM 341-374 (2005), available at SSRN: <http://ssrn.com/abstract=1417945>.
- J. Mueller, *Federal Circuit 2004: Eight Significant Patent Law Developments Every IP Litigator Must Understand*, 11 IP LITIGATOR 27-38 (Aspen) (Jan./Feb. 2005), available at SSRN: <http://ssrn.com/abstract=1439749>.
- J. Mueller, *The Evanescent Experimental Use Exemption from U.S. Patent Infringement Liability: Implications for University/Nonprofit Research and Development*, 56 BAYLOR L. REV. 917 (2004), available at SSRN: <http://ssrn.com/abstract=691424>.
- J. Mueller, *U.S. Patent Law: Year in Review (Nov. 2003-Oct. 2004)*, in PROCEEDINGS OF THE ANNUAL MEETING OF THE AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION, Washington, D.C. (Oct. 2004) (CD-ROM).
- J. Mueller, *Willful Infringement and the Federal Circuit's Pending En Banc Decision in Knorr-Bremse v. Dana Corp.*, 3 J. MARSHALL REV. INTELL. PROP. L. 218 (Spring 2004), available at SSRN: <http://ssrn.com/abstract=1367855>.
- J. Mueller, *Potential Antitrust Liability Based on a Patent Owner's Manipulation of Industry Standard Setting*, IV STATE ANTITRUST ENFORCEMENT ABA COMMITTEE NEWSLETTER 10-25 (Fall 2003).
- J. Mueller and M. Rustad, *Interview with Professor Janice M. Mueller, Author of "An Introduction to Patent Law,"* BIMONTHLY REVIEW OF LAW BOOKS 3-4 (July/Aug. 2003).

- J. Mueller, *Public Access Versus Proprietary Rights in Genomic Information: What is the Proper Role of Intellectual Property Rights?*, 6:1 J. HEALTH CARE L. & POL'Y 222 (2003), available at SSRN: <http://ssrn.com/abstract=1367849>.
- J. Mueller, "Interpretive Necromancy" or Prudent Patent Policy? *The Supreme Court's "Arising Under" Blunder in Holmes Group v. Vornado*," 2 J. MARSHALL REV. INTELL. PROP. L. 57 (Fall 2002), <http://www.jmls.edu/ripl/vol2/issue1/mueller.pdf>, available at SSRN: <http://ssrn.com/abstract=1367857>.
- J. Mueller, *Patent Misuse Through the Capture of Industry Standards*, 17 BERKELEY TECH. L.J. 623 (2002), available at SSRN: <http://ssrn.com/abstract=1346546>.
- J. Mueller, *At Sea in a Black Box: Charting a Clearer Course for Juries Through the Perilous Straits of Patent Invalidity*, 1 J. MARSHALL REV. INTELL. PROP. L. 3 (Fall 2001), available at SSRN: <http://ssrn.com/abstract=1367852>.
- J. Mueller, *Patenting Industry Standards*, 34 J. MARSHALL L. REV. 897 (Summer 2001).
- J. Mueller, *Presto Festo! The Incredible Disappearing Doctrine of Equivalent*, 3 JMLS CENTER FOR INTELLECTUAL PROPERTY L. NEWS SOURCE 8 (Winter 2001).
- J. Mueller, *No "Dilettante Affair": Rethinking the Experimental Use Exception to Patent Infringement for Biotech Research Tools*, 76 WASH. L. REV. 1 (2001), available at SSRN: <http://ssrn.com/abstract=1346545>.
- J. Mueller, *Recent Decisions: Patent Law—Selected Annotated Cases, November 1999–September 2000*, PROCEEDINGS OF THE AMERICAN INTELLECTUAL PROPERTY LAW ANNUAL MEETING (October 19-21, 2000) (on CD-ROM).
- J. Mueller, *Experts at the Gate: Assessing Evidentiary Reliability of Expert Testimony in Patent Cases*, 2 JMLS CENTER FOR INTELLECTUAL PROPERTY L. NEWS SOURCE 6 (Spring 2000).
- J. Mueller, *Responding to Public Criticism, PTO Revises Written Description Guidelines*, 2 JMLS CENTER FOR INTELLECTUAL PROPERTY L. NEWS SOURCE 9 (Winter 2000).
- J. Mueller, *Patent Law: Examination Guidelines*, NAT'L L.J. (Jan. 24, 2000), at B7, available at SSRN: <http://ssrn.com/abstract=1479763>.
- J. Mueller, *A Rich Legacy*, 14 BERKELEY TECH. L.J. 895 (1999) and 81 J. PAT. & TRADEMARK OFF. SOC'Y 755 (October 1999), available at SSRN: <http://ssrn.com/abstract=1392758>.

- J. Mueller, *Federal Circuit Patent Law Developments: Prosecution History Estoppel*, 1 JMLS CENTER FOR INTELLECTUAL PROPERTY L. NEWS SOURCE 5 (Fall 1999).
- J. Mueller and William Lee, *Prosecution History Estoppel: A Discussion of Festo and Sextant*, PROCEEDINGS OF THE ANNUAL MEETING OF THE AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION (October 1999).
- J. Mueller and Jeffery Atik, *New International Dimensions in the Gray Market Goods Debate*, 1 JMLS CENTER FOR INTELLECTUAL PROPERTY L. NEWS SOURCE 6 (Summer 1999).
- J. Mueller, *An Interview with Judge Giles S. Rich, U.S. Court of Appeals for the Federal Circuit*, 17 ABA INTELLECTUAL PROPERTY LAW SECTION NEWSLETTER 1 (Spring 1999), reprinted at 9 FED. CIR. B.J. 1, 75 (1999).
- J. Mueller and Donald R. Ware, *A Trial Lawyer's Guide to Presenting Evidence on Patent Claim Construction*, 22 THE TRIAL LAWYER: JOURNAL OF STRATEGY, TECHNIQUE & CASE MANAGEMENT 152 (Mar.-Apr. 1999).
- J. Mueller and Donald R. Ware, *Presenting Evidence on Claim Construction*, Intellectual Property Conference 1998, at 109 (Mass. Continuing Legal Ed. 1998).
- J. Mueller, *Sidebar: Understanding Section 102*, in DONALD S. CHISUM ET AL., PRINCIPLES OF PATENT LAW (Foundation Press 1998).
- J. Mueller, *Conception, Testing, Reduction to Practice: When Is It Really On Sale?*, 80 J. PAT. & TRADEMARK OFF. SOC'Y 305 (May 1998), available at SSRN: <http://ssrn.com/abstract=1434518>.
- J. Mueller, *The Evolving Application of the Written Description Requirement to Biotechnological Inventions*, 13 BERKELEY TECH. L.J. 615 (Spring 1998), available at SSRN: <http://ssrn.com/abstract=1431446>.
- J. Mueller et al., *High Technology Law in the Twenty-First Century: Panel Discussion*, XXI SUFFOLK TRANSNAT'L L. REV. 13 (Winter 1997) (edited transcript).
- J. Mueller and Ann Mueting, *What Recent Chemical Patent Decisions Teach Us*, BULLETIN OF THE AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION 33 (1997 Annual Meeting Issue).
- J. Mueller, *Current Patent Litigation Issues*, distributed at the Marcus B. Finnegan Memorial Lectures, George Washington University Law School, Washington, D.C., September 19, 1997, and published in PROCEEDINGS OF THE "HIGH

TECHNOLOGY LAW IN THE TWENTY-FIRST CENTURY" CONFERENCE, co-sponsored by Suffolk University Law School and Boston Patent Law Association, Sept. 26, 1997.

J. Mueller, *Crafting Patents for the Twenty-First Century: Maximize Patent Value and Avoid Prosecution History Estoppel in a Post-Markman/Hilton Davis World*, 79 J. PAT. AND TRADEMARK OFF. SOC'Y 499 (July 1997); Japanese translation published at 43 AIPPI-JAPAN 15 (1998).

J. Mueller, *Taking Inventory After Markman: The Supreme Court Confirms a New Era in Patent Litigation*, THE LAW WORKS (June 1996); excerpted in INTELLECTUAL PROPERTY LAWCAST (July. 29, 1996).

J. Mueller and Steven E. Lipman, *The Markman Case*, PROCEEDINGS OF THE ABA SECTION OF INTELLECTUAL PROPERTY LAW ELEVENTH ANNUAL CHERRY BLOSSOMS AND CLE PROGRAM 527 (April 1996).

Co-editor, May 1994 JOURNAL OF THE PATENT & TRADEMARK OFFICE SOCIETY (issue honoring Judge Giles Rich).

J. Mueller, *Determining the Scope of Copyright Protection for Computer/User Interfaces*, IX COMPUTER/LAW JOURNAL (University of Southern California Law Center) (Winter 1989).

WORKS IN PROGRESS

J. MUELLER, PATENT LAW (multi-volume treatise for professional/academic market; contract with Aspen Publishers signed in December 2009; manuscript due December 2011).

LECTURES, INTERVIEWS, PRESENTATIONS, and AWARDS

Co-Moderator, Intellectual Property Professionals Roundtable, sponsored by Pittsburgh IP Law Association, University of Pittsburgh School of Law, January 26, 2011.

Ranked among the seven "Most Cited Scholars" at the University of Pittsburgh School of Law in Gregory Sisk et al., *UST Scholarly Impact Study, Scholarly Impact of Law School Faculties: Extending the Leiter Rankings to the Top 70* (September 1, 2010), available at SSRN: <http://ssrn.com/abstract=1674764>.

Lecturer on the Novelty and Nonobviousness Requirements of Patentability, BarBri Patent Bar Review Course, Washington, D.C., May 25, 2010.

- Commentator/Discussion Leader for “Virtual Property and Copyright” presentation by Professor M. Scott Boone, at the University of Kentucky College of Law “Developing New Ideas” Conference, Lexington, Kentucky, May 13, 2010.
- Ranked as #11 among U.S. patent law professors in Professor Dennis Crouch’s “Reputation Ranking of Patent Law Faculty,” April 15, 2010, <http://www.patentlyo.com/patent/2010/04/ranking-patent-programs.html>.
- Panel Discussant on “Gene Patentability and the Implications of *ACLU v. Myriad Genetics*” at the University of Maryland School of Law, Baltimore, April 2, 2010, as part of the *Journal of Business and Technology Law* Spring 2010 Symposium, “The Future of Genetic Disease, Diagnosis, and Treatment: Do Patents Matter?,” <http://www.law.umaryland.edu/faculty/conferences/detail.html?conf=97>.
- “Overcoming The ‘Impossible Issue’ Of Nonobviousness in Design Patents,” Randall-Park Colloquium Series Invited Lecture, University of Kentucky College of Law, February 11, 2010.
- “An Introduction to the Legal Protection of Intellectual Property,” guest lecture to business and law students in the Commercializing New Technology course at the University of Pittsburgh’s Katz Graduate School of Business, October 5, 2009.
- “The Global Future of Industrial Design Protection,” introduced and moderated symposium at University of Pittsburgh School of Law, February 26, 2009.
- “The Gathering Storm Over Compulsory Patent Licensing in India: Public Health Safeguard, or an End to Innovation?,” presented to faculty and students of Seattle University School of Law, Oct. 24, 2008.
- “Enabling Patent Law’s Inherent Anticipation Doctrine,” co-presented with Donald S. Chisum to participants of the University of Houston’s Santa Fe IPIL Conference (“Patent Law in Perspective”), June 7, 2008.
- “The Evolution of India’s Patent Regime: Implications for Public Health and Pharmaceutical Innovation,” presented to faculty and students of Seattle University School of Law, April 15, 2008.
- “Chemicals, Combinations, and ‘Common Sense’: How the Supreme Court’s *KSR* Decision Is Changing Federal Circuit Obviousness Determinations in Pharmaceutical and Biotechnology Cases,” presented at N. Ky. Univ. Chase Law School IP Symposium, Covington, Ky., February 16, 2008.
- “Chemicals, Combinations, and ‘Common Sense’: How the Supreme Court’s *KSR* Decision Is Changing Federal Circuit Obviousness Determinations in Pharmaceutical and Biotechnology Cases,” presented to students and faculty of the Advanced Patent Law Seminar, University of Washington School of Law, Seattle, February 7, 2008.
- “The Evolution of India’s Patent Regime: Implications for Public Health and Pharmaceutical Innovation,” presented to students and faculty of the IP

Innovations in Science & Technology Seminar, University of Washington School of Law, Seattle, October 23, 2007.

Moderated and participated in panel discussion of "Human Embryonic Stem Cells: Patentability, Access, and Ethical Issues," CASRIP High Technology Protection Summit, University of Washington School of Law, Seattle, July 21, 2007.

Quoted in Jason Cato, "Scientists Put Skills to Work in the Law," PITTSBURGH TRIBUNE-REVIEW, May 29, 2007, available at http://www.pittsburghlive.com/x/pittsburghtrib/search/s_509885.html.

"The Evolution of India's Patent Regime: Implications for Public Health and Pharmaceutical Innovation," presented to students and faculty of the IP Innovations in Science & Technology Seminar, University of Washington School of Law, Seattle, April 30, 2007.

"The Evolution of India's Patent Regime: Implications for Public Health and Pharmaceutical Innovation," presented to students and faculty of the Intellectual Property Workshop, University of Michigan School of Law, Ann Arbor, April 11, 2007.

"Audio Interview with Janice Mueller on a Pharmaceutical-Industry Challenge to Indian Patent Law," NEW ENGLAND JOURNAL OF MEDICINE (Feb. 8, 2007), available at <http://content.nejm.org/cgi/content/full/356/6/541/DC1>.

"Developing Country Patent Systems: India as a Case Study" and "Comparative Patent Claim Interpretation," lectures delivered at Santa Clara University Law School's Summer Program in European Intellectual Property Law, Munich, Germany, July 5 & 6, 2006.

"India's New Product Patent Regime and Its Public Health Implications," presented at the International Intellectual Property Regime Complex Conference at Michigan State University Law College, April 7, 2006.

Interviewed by CNBC news crew in Mumbai, India, Nov. 24, 2005, concerning India's recent patent law reforms.

"Recent Developments Concerning the U.S. Patent Utility Requirement" and "Status of Pending U.S. Patent Reform Legislation," colloquium presented to attorneys and biotechnologists at National Law School of India University, Bangalore, Nov. 18, 2005.

"Significance and Opportunities in Intellectual Property Law From a U.S. Perspective," presentation to law students of the National Law School of India University, Bangalore, Nov. 18, 2005.

Quoted in Sam Mamudi, "Supreme Court Provides IP Guidance," *Managing Intellectual Property* 13 (July/August 2005).

"U.S. Patent Reform: General Harmonization Topics," presented at 2005 High Technology Protection Summit, University of Washington Law School, Seattle, July 22, 2005.

Lectured on “Comparative Patent Claim Interpretation” and “Compulsory Patent Licensing” at Santa Clara University Law School’s Summer Program in European Intellectual Property Law, Munich, Germany, July 13-14, 2005.

Quoted in Marcia Coyle, “Merck Ruling Leaves Big Questions: High Court Silent on Research Tools,” *National Law Journal*, June 20, 2005, at 1.

Quoted in Hope Yen, “Drug Patents Don’t Bar Rival Research,” *The Washington Post*, June 14, 2005.

“Patent Controls on Genetically Modified (GM) Crop Farming,” presented at the “Future of Food: Legal and Ethical Challenges” conference at Santa Clara University, April 15, 2005.

“Antitrust Issues in Intellectual Property Cases,” presented at the ABA Section of Antitrust Law’s Spring Meeting Fundamentals Program, Washington, D.C., Mar. 30, 2005, available at SSRN: <http://ssrn.com/abstract=1417945>.

Commentator, “Where IP Meets IT: Technology and the Law” Symposium, University of Pittsburgh School of Law, Mar. 18, 2005, commenting on Professor Carl Moy’s paper, “Altruism versus Self-Interest: The Relative Roles of Persuasion and Coercion at the Federal Circuit.”

“Shields to Infringement Liability: Experimental Use Exemption,” Town Hall Meeting on Patent Reform, co-sponsored by Federal Trade Commission, National Academies of Science, and American Intellectual Property Law Association, San Jose, Cal., Feb. 18, 2005.

Quoted in Steven Andersen, “Federal Circuit Strikes Down Presumed-Guilty Rule,” *Corporate Legal Times* (Nov. 2004), at 13.

“Patent Law: Year in Review,” speech to the Pittsburgh Intellectual Property Law Association (Oct. 21, 2004).

“Patent Law: Year in Review,” speech at the American Intellectual Property Law Association Annual Meeting, Washington, D.C. (Oct. 16, 2004).

“Patent Law: Year in Review,” presented to Intellectual Property Practice Group of Kirkpatrick & Lockhart LLP, Pittsburgh, PA (Sept. 14, 2004).

Quoted in Allen Cheng, “China to See More Patent Lawsuits After Viagra, Avandia Cases,” *Bloomberg News* (Aug. 26, 2004).

Commentator, Symposium on Willful Infringement, co-sponsored by Oracle Corporation and George Washington University Law School, Washington, D.C., Mar. 19, 2004, quoted in *Patent Law Experts Explore Strategies for Implementing Willful Infringement Policies*, 67 BNA PATENT, TRADEMARK & COPYRIGHT J. 483 (Mar. 26, 2004).

“The Evanescent Experimental Use Exemption from U.S. Patent Infringement: Implications for University/Nonprofit Research and Development,” speech at the 48th Annual Conference on Developments in Intellectual Property Law, John Marshall Law School, Chicago, Feb. 27, 2004.

Panel Moderator, Changes in International Trade Commission Section 337 Practice, at the 48th Annual Conference on Developments in Intellectual Property Law, John Marshall Law School, Chicago, IL Feb. 27, 2004.

“The Experimental/Research Use Exemption to Patent Infringement,” speech to the XV Congress of the Inter-American Association of Industrial Property (ASIPI) in Mexico City, Mexico, Nov. 17, 2003 (simultaneously translated into Spanish).

“The Continuing (De-)Evolution of the Written Description Requirement of 35 U.S.C. § 112, ¶ 1: Federal Circuit Update,” presented at the American Intellectual Property Law Association’s 2003 Annual Meeting in Washington, D.C., Oct. 31, 2003.

“The ‘Very Narrow’ Experimental Use Exemption from U.S. Patent Infringement Liability: Strictly Construed to a Nullity?,” presented to the 2003-2004 IP Innovation in Science and Technology Seminar, University of Washington School of Law, Seattle, WA, Oct. 27, 2003.

“Hot Topics in U.S. Biotech Patent Law,” Seminar on Obtaining, Enforcing, and Evaluating Intellectual Property Rights in Europe, Boehmert & Boehmert, Anwaltssozietat, Munich, Germany, July 1, 2003.

“Return to Appellate Forum Shopping?” The Federal Circuit’s Jurisdiction as Narrowed by *Holmes Group v. Vornado*, John Marshall Law School, 48th Annual IP Developments Conference, Feb. 28, 2003.

“Public Access versus Private Rights in Genomic Information—What is the Proper Role of Intellectual Property Rights?,” presentation at the “At the Crossroads—Public/Private Priorities Concerning Access to Genetic Information” conference, University of Maryland School of Law, Oct. 21, 2002.

“A Lawyer’s Obligation to Supervise,” presented at Plenary Session on “Mentoring,” American Intellectual Property Law Association Annual Meeting, Washington, D.C., Oct. 19, 2002.

“Best Practices for Diversity,” Panel Discussant at American Intellectual Property Law Association Annual Meeting, Washington, D.C., Oct. 17, 2002.

“U.S. Biotech Patent Law Developments: The *Enzo* Decision and the Written Description Requirement,” presentation to patent attorneys and clients of Boehmert & Boehmert, Munich, Germany, July 3, 2002.

“Patent Misuse and Industry Standards,” invited lecture at University of Washington School of Law, Seattle, WA, Apr. 24, 2002.

Interviewed on April 1, 2002 by reporter Brenda Sandburg of *The Recorder* on Federal Circuit’s decision in *Johnson & Johnston Assoc., Inc. v. R.E. Service Co.* (Fed. Cir. 2002) (*en banc*).

“Comparative Biotech Patent Law Developments,” presented at the International IP in the Digital World Conference, Santa Clara University School of Law, Mar. 22, 2002.

Moderator and Organizer, "Strategies for Federal Circuit Clerkships," panel discussion presented to IP Society of Santa Clara University School of Law, Mar. 20, 2002.

Panel Moderator and Presenter, "Patents and Industry Standards," panel discussion presented to the Silicon Valley Intellectual Property Law Association, Santa Clara, CA, Mar. 13, 2002.

Invited Paper Presenter, "Patent Misuse Through the Capture of Industry Standard," Patent System Reform Conference, University of California at Berkeley (Mar. 1, 2002).

Quoted in "The Incredible Shrinking Patent," *IP Worldwide* (Dec. 2001), at 46.

Panel Member, "What Do We Gain and What Do We Lose With Patent Harmonization," sponsored by University of Washington School of Law, Dec. 12, 2001.

Quoted in "U.S. Supreme Court Upholds the Right to Patent Plants," *Wall St. Journal* (Dec. 11, 2001), at B5.

Interviewed on Chicago Public Radio WBEZ's "Odyssey" program (Oct. 30, 2001), on the topic of finding an appropriate balance between patent rights and the public's access to health care including patented pharmaceuticals.

Quoted in "I Can't Believe It's Patented!," *Small Business Computing*, July 2001, at 14.

Work-in-Progress Seminar: "Patenting Industry Standards," presented to the faculty of the John Marshall Law School, Apr. 17, 2001.

Quoted in "Law and Order," *Ziff Davis Smart Business* (Mar. 12, 2001) (discussing *Festo*), at <<http://www.zdnet.com/smartbusinessmag/stories/all/0,6605,2688775,00.html>>.

Quoted in "*Festo* Decision Narrows Doctrine of Equivalent," *Corporate Legal Times* (Mar. 2001), at 70.

Quoted in "Hot Issue: New Patent Regulations Require Automatic, and Early, Publication of Applications" <<http://www.arthurandersen.com/website.nsf/content/MarketOfferingsBusinessConsultingResourcesHotIssuesHotpatents?OpenDocument>> (Feb. 12, 2001).

Quoted in "Dispute Over Prozac Patent Leads to Rare Attack on Amici," <<http://www.law.com>> (Jan. 8, 2001).

Quoted in "A Fight Over the Friends of Prozac," *Legal Times* (Jan. 8, 2001).

Interviewed on the impact of *Festo v. Shoketsu* (Fed. Cir. 2000) (*en banc*) for two-part "Top Story" feature in VI *Intellectual Property LAWCAST*, No. 23 (Dec. 11, 2000) (audiocassette, CD, and paper outline); and VI *Intellectual Property LAWCAST*, No. 24 (Under-Reported Stories 2000) (audiocassette, CD, and paper outline).

Quoted in "Double Patenting Ruling Zaps Prozac Patent," 10 *Corporate Legal Times* (Nov. 2000), at 82.

"Patent Law: Year in Review," Annual Meeting of the American Intellectual Property Law Association, Arlington, VA, Oct. 21, 2000.

"Federal Circuit Patent Review," lecture given at seminar titled "Patents, the Evolving Law, and the Federal Circuit," sponsored by Minnesota Continuing Legal Education, Minneapolis, MN, Oct. 3, 2000.

"The Federal Circuit's Impact on Innovation," invited public lecture at the University of Akron School of Law, Sept. 28, 2000.

"Research Tools and the Experimental Use Exception," colloquium for faculty of University of Akron School of Law, Sept. 28, 2000.

Speaker and Plenary Session Chair, "Performing Research with Patented Materials," 18th Annual Biotech Patent & Licensing Forum, American Type Culture Collection, Arlington, VA, Sept. 7, 2000.

Quoted in "CAFC Decision a Winner for Club Maker," 10 *Corporate Legal Times* (July 2000), at 102.

Panel Member, "Hot 21st Century Patent Litigation Topics: Issues for the Bench, Bar, and Academia," ABA Intellectual Property Law Section's 15th Annual Spring CLE Program, Washington, D.C., Apr. 3, 2000.

Quoted in "Federal Circuit Gets Passing Marks to Date," 10 *Corporate Legal Times* (Mar. 2000), at 86.

Quoted in "PTO's New Guide to DNA Info," *National Law Journal* (Jan. 17, 2000), at B6 <http://www.ljx.com/cgi bin/f_cat?prod/ljextra/data/texts/2000_0108_59.html>.

Quoted in "Silent Partners: A Confidentiality Pact is the Next Best Thing to Keeping Your Ideas Under Lock and Key," *Business Week* (Dec. 6, 1999), at F.16.

Quoted in "Study Finds Women in IP Law Have Come a Long Way," *IP Law Weekly* (Nov. 17, 1999), at 759.

Quoted in "CAFC Splatters California Court's Ruling in Curious Case of *Juicy Whip v. Orange Bang*," 9 *Corporate Legal Times* (Dec. 1999), at 76.

Co-presenter, "Prosecution History Estoppel: A Discussion of *Festo* and *Sextant*," at Annual Meeting of the American Intellectual Property Law Association, Arlington, VA, Oct. 1, 1999.

"Career Options and Judicial Clerkships for IP Law Grads," presented to John Marshall Law School's Intellectual Property Law Students Association, Oct. 14, 1999.

"Federal Circuit and Supreme Court Update: Important New Patent Decisions," teleseminar presented Oct. 4, 1999, to clients and attorneys of Schwegman, Lundberg, Woessner & Kluth, P.A., Minneapolis, MN.

Remarks in memory of Judge Giles S. Rich, presented at the Memorial Session of the U.S. Court of Appeals for the Federal Circuit, Washington, D.C., Sept. 27, 1999.

"Research Exemptions to Patent Infringement," presented to 17th Annual Biotech Patent & Licensing Forum, American Type Culture Collection, Herndon, VA, Sept. 24,

1999; Chair of ATCC Plenary Session on "Performing Research with Patented Materials."

"Research Exemptions to Patent Infringement," presented to Chicago Bar Association Patent Law Subcommittee, Sept. 14, 1999.

Quoted in "Supreme Court Curbs CAFC's Authority, 6-3 Ruling Sides with U.S. Patent Office," *9 Corporate Legal Times* (Sept. 1999), at 82.

Quoted in "Car Rental Firms Clash Over Pick-Up Line, But Trademark Dispute Short Circuits," *9 Corporate Legal Times* (Sept. 1999), at 78.

Panel Member, "A Dialog Between Bench, Bar & Academia," The John Marshall Law School Center for Intellectual Property Law, Centennial Conference on Intellectual Property Law, Chicago, IL (May 6, 1999).

Quoted in "PTO's Due Deference: How Closely Should the Courts Review Denials of Patents?," *CAL LAW* (Mar. 22, 1999) <<http://www.callaw.com/stories/edt0322.html>>.

"Federal Circuit Update: Important New Patent Decisions," teleseminar presented Mar. 29, 1999, to clients and attorneys of Schwegman, Lundberg, Woessner & Klutz, P.A., Minneapolis, MN.

Interviewed for "Top Story: Supreme Court Holds On-Sale Bar Applies When Invention Is 'Ready for Patenting' Before Critical Date," *IV Intellectual Property LAWCAST* (Nov. 23, 1998) (audiocassette tape and paper outline); interview also included in *IV Corporate Counsel LAWCAST* (Nov. 30, 1998) (audiocassette tape and paper outline).

"The Meaning of 'Invention' in the Statutory Bar Provision of U.S. Patent Law," presented at John Marshall Law School, Chicago, IL, Nov. 9, 1998.

"On Sale Bar: Section 102(b) Issues," presented at the 8th Annual All-Ohio Institute on Intellectual Property, in Cleveland and Cincinnati, OH, Oct. 8 & 9, 1998.

"Federal Circuit Update," presented to Fish & Richardson P.C., Boston, MA, July. 9, 1998.

"Comparing the Intellectual Property Laws of the United States and Mexico," guest lecture at Loyola University New Orleans School of Law's Foreign Summer Program, Cuernavaca, Mexico, June 24, 1998.

"Presenting Evidence on Claim Construction," presented at Massachusetts Continuing Legal Education's Intellectual Property Conference '98, Boston, MA, June 17, 1998.

"Writing the Patent With Litigation in Mind," presented at "Overview of Patent Litigation" Seminar, Litigation Committee of the Boston Patent Law Association, Boston, MA, Apr. 8, 1998.

"Conception, Testing, Reduction to Practice: When Is It Really On Sale?," presented at the ABA Section of Intellectual Property Law Annual Meeting, Washington,

- D.C., Mar. 31, 1998; excerpts of speech featured as "Tip of the Week" in IV *Intellectual Property LAWCAST* (Sept. 28, 1998) (audiocassette tape and paper outline).
- "Protecting Genetic Sequences: Patentability Issues," presented at "Biotechnology and the Law: New Perspectives on Public Access & Proprietary Rights," University of California at Berkeley, Feb. 21, 1998.
- "The Year in Patents: Hilton Davis and Beyond," audio interview published in III *Intellectual Property LawCast* No. 24 (Dec. 29, 1997) (audio cassette series); summarized in print form at III *Intellectual Property LAWCAST* Outline 7 (1997 Year End ed.).
- "High Technology Law at Suffolk University Law School," presented to the Intellectual Property Practice Group of Foley, Hoag & Eliot, LLP (Boston), Dec. 16, 1997.
- Moderator, "Careers in High Technology Law" Panel Discussion, Suffolk University Law School, Boston, MA, Oct. 20, 1997.
- "Workshop on What Recent Judicial Decisions Teach Us About Chemical Practice," Co-presented with Ann M. Muetting, Esquire at the Chemical Practice Committee and University Relations Committee Joint Meeting, American Intellectual Property Law Association Annual Meeting, Crystal City, VA, Oct. 17, 1997.
- Moderator, "Panel Discussion: Patent Litigation in the 21st Century," High Technology Law in the Twenty-First Century Conference, co-sponsored by Suffolk University Law School and the Boston Patent Law Association, Boston, MA, Sept. 26, 1997.
- "United States Patent Litigation After *Markman* and *Warner-Jenkinson*," Marcus B. Finnegan Memorial Lectures, George Washington University Law School, Washington, D.C., Sept. 19, 1997.
- "Current Issues Relating to Federal Circuit Review of USPTO Decisions," Presentation Opposing PTO Request for Application of Administrative Procedure Act Deference, Intellectual Property Owners (IPO) Annual Meeting, Washington, D.C., Sept. 9, 1997 (reported in 54 *BNA's Patent, Trademark & Copyright J.* 482-83 (Oct. 9, 1997)).
- "Maximize Patent Value and Avoid Prosecution History Estoppel in a Post-*Markman/Hilton Davis* World," Annual Spring Meeting, American Intellectual Property Law Association, San Antonio, TX, Apr. 30, 1997.
- "High Technology Law at Suffolk University Law School," presented to Hamilton, Brook, Smith & Reynolds, P.C., Lexington, MA, Apr. 18, 1997.
- "High Technology Law Career Opportunities," Virginia Polytechnic Institute & State University, Mar. 30, 1997.
- "Career Alternatives for Patent Professionals," Boston Patent Law Association, Boston, MA, Jan. 15, 1997.

“Life After the Federal Circuit’s *Markman* Decision,” William Mitchell College of Law IP Law & Litigation Seminar, Minneapolis, MN, Apr. 23, 1996.

“Life After the Federal Circuit’s *Markman* Decision,” ABA Section of Intellectual Property Law Annual Meeting, Arlington, VA, Apr. 12, 1996.

“Recent Significant Federal Circuit Patent & Trademark Decisions,” William Mitchell College of Law IP Law & Litigation Seminar, Minneapolis, MN, Mar. 18, 1996.

“Recent Significant Federal Circuit Patent Decisions,” Schwegman, Lundberg & Woessner, P.A., Attorney Training Seminar, Minneapolis, MN, Mar. 20, 1996.

“Intellectual Property Lawsuits Involving the Federal Government As A Party,” William Mitchell College of Law CLE, Minneapolis, MN, Sept. 1995.

GRANTS RECEIVED

University of Pittsburgh, Center for International Studies, Hewlett Grant of \$2,500 to support sabbatical research on India’s patent system, awarded May 2005.

PROFESSIONAL AFFILIATIONS

American Intellectual Property Law Association, 1996-present:

Amicus Committee Member, 2001-2003.

Presenter, “Patent Law: Year in Review,” Annual Meetings 2000 and 2004.

American Bar Association Intellectual Property Law Section, 1995-present:

Chair, Special Committee 655 on Patent Experts, 1999-2001;

Nominating Committee Member, 2000-2001.

Boston Patent Law Association, 1996-1999;

Law Students Subcommittee Chair, 1997-1999.

Federal Circuit Historical Society, Board of Trustees Member, 2007-present:

Nominated to a new three-year term beginning 2010.

Giles S. Rich American Inn of Court, Washington, D.C., 1991-1995.

Intellectual Property Law Association of Chicago, 1999-2003.

National Director, Giles S. Rich Moot Court Competition, 1993-94.

Patent Lawyers Club of Washington, 1991-1995.

Pittsburgh Intellectual Property Law Association, 2004-present.

Warren E. Burger American Inn of Court, St. Paul, MN, 1995-1996.

Washington State Patent Law Association, 2007-present.

BAR MEMBERSHIPS

U.S. Supreme Court

District of Columbia

State of Minnesota

U.S. Court of Federal Claims

U.S. Court of Appeals for the Federal Circuit

U.S. Patent and Trademark Office, Registered Patent Attorney (Registration No. 33,975)

CONSULTING, PRO BONO AND OTHER SERVICE

Advisory Committee, Model Patent Jury Instructions Project, U.S. District Court for the Northern District of California (San Jose):

- Invited Member, 2001-02.

American Intellectual Property Law Association:

- Amicus Committee Member, 2001-2003.
- Counsel of Record, AIPLA's *Amicus Curiae* Brief in Support of Petition for *Certiorari in Festo v. Shoketsu*, 234 F.3d 558 (Fed. Cir. 2000) (*en banc*); *cert. granted*, 2001 U.S. LEXIS 4495, 69 U.S.L.W. 3779 (June 18, 2001); Co-counsel, AIPLA's *Amicus Curiae* Brief on the Merits.
- Co-counsel, AIPLA's *Amicus Curiae* Brief in *Johnson and Johnston Assocs., Inc. v. R.E. Service Co., Inc.*, No. 99-1076 (Fed. Cir. 2001).

Chiron Corporation, Emeryville, California:

- Consultant on biotech patent application issues (2002).

Chisum Patent Academy, Seattle, Washington (www.chisumpatentacademy.com):

- Co-founder (2009).
- Co-Lecturer, Intensive Patent Law Training Seminar, Seattle, WA, July 23-25, 2009; July 29-31, 2010; Aug. 2-4, 2010.

Compaq Computer Corporation, Houston, Texas:

- Co-counsel for Respondent Compaq Corp. in *Dickinson v. Zurko*, 527 U.S. 150 (1999).

Consultative Group for International Agricultural Research (CGIAR), an international non-profit organization working to feed the world's poor:

- Member, Intellectual Property Expert Advisory Committee (EAC) for the Central Advisory Service of the CGIAR (2000-present).
- EAC Chair, 2002-present.
- Attended annual meetings at The Hague, Netherlands, 2000-03; Rome, Italy, 2004; Washington, D.C., 2005; Rome, Italy, 2006-2009.

Digital Equipment Corporation, Maynard, Massachusetts:

- Co-counsel for prevailing party in *In re Zurko*, 142 F.3d 1447 (Fed. Cir. 1998) (*en banc*) (denying application of more deferential Administrative Procedure Act standards of review to Patent and Trademark Office fact-findings), *reversed*, *Dickinson v. Zurko*, 527 U.S. 150 (1999).
- Taught an 8-session Patent Law Fundamentals Workshop for DEC attorneys and technical specialists.

Eli Lilly and Company, Indianapolis, Indiana:

- Filed *amicus curiae* brief in support of panel rehearing and rehearing *en banc* in *Eli Lilly and Co. v. Barr Labs., Inc. et al.*, 222 F.3d 973 (Fed. Cir. 2000) (urging court to reconsider decision invalidating Lilly's '549 patent on obviousness-type double patenting grounds).

Federal Circuit Historical Society, Washington, D.C.:

- Board of Trustees Member, October 2007 - present.

Foley, Hoag & Eliot, LLP, Boston, Massachusetts:

- Taught a 6-session Patent Law Fundamentals Workshop for Foley, Hoag attorneys and technical specialists.

Genentech Inc., South San Francisco, California:

- Founding member, Genentech Intellectual Property Advisory Board.
- Analysis of recent Federal Circuit biotech patent decisions.

Hamilton, Brook, Smith, & Reynolds, Lexington, Massachusetts:

- Consulted with counsel for Appellee on rehearing *en banc* petition in *Scaltech, Inc. v. Retec/Tetra, LLC*, No. 97-1365 (Fed. Cir. Sept. 10, 1998).

Jenkins & Gilchrist, Dallas, Texas:

- Consulted with counsel for Petitioner during Supreme Court briefing in *Pfaff v. Wells Elec., Inc.*, 119 S. Ct. 304 (1998).

Schwegman, Lundberg, Woessner & Kluth, P.A., Minneapolis, Minnesota:

- Conducted attorney/client training teleseminars on recent patent law developments.

Torshen, Spreyer, Garmisa & Slobig, Ltd., Chicago, Illinois:

- Retained as expert witness on trademark protectability issues in a case in U.S. Bankruptcy Court (1999-2000).