

James M. Amend

Chief Circuit Mediator

U.S. Court of Appeals for the Federal Circuit

Washington, DC

Former Partner, Intellectual Property, Kirkland & Ellis LLP, Chicago, Illinois
(1968–2006)

Consulting Professor, Patent and Intellectual Property Law, Stanford University Law
School (1996–1997)

▪ **Education**

University of Michigan, B.S. (Mechanical Engineering) with High Honors, 1964
Outstanding Senior Engineer, Tau Beta Pi Engineering Honorary

University of Michigan, J.D., *magna cum laude*, 1967
Order of the Coif; Editor, *Michigan Law Review*

London School of Economics, Fulbright Scholar (British Unfair Competition Law),
1967-68

- **Author** - Patent Law - A Primer for Federal District Court Judges, 1st edition
published by the Berkeley Center for Law and Technology, 1998, 2nd edition
published 2006

▪ **Representative Clients and Cases**

Patent

- American Cyanamid Company - Bernstein v. American Cyanamid Company (dispute
over rights to patent for psoriasis treatment)
- Amoco Corporation - Mobil Oil v. Amoco (suit for infringement of patent relating to
petrochemical processes)
- Baxter Laboratories - Smith v. Baxter Laboratories (dispute over rights to patent on
drug to relieve pain from herniated discs)
- Caterpillar, Inc. - Caterpillar v. Detroit Diesel (serve as expert witness in patent
infringement suit relating to cruise controls)

- Kraft Foods, Inc. - Alpine Lace v. Kraft (suit for infringement of patent relating to process for making low-fat cheese)
- Motorola, Inc. - Nilssen v. Motorola (suit for infringement of patents and theft of trade secrets relating to electronic ballasts for fluorescent lights)
- Pittway Corporation - Pittway Corporation v. Black & Decker (patent infringement action involving rechargeable flashlights); American Optical v. Pittway Corporation (patent infringement action involving closures for dispensing containers); Raber v. Pittway Corporation (patent infringement action involving smoke detectors)
- United States Gypsum - Georgia-Pacific v. United States Gypsum (suit for infringement of patents relating to reinforced dry wall panels)

Trademark/Unfair Competition

- Blue Cross Blue Shield Association - Central Benefits Mutual Insurance Co. v. Blue Cross Blue Shield (obtained preliminary injunction against subsidiary of Member Plan using BLUE CROSS® and BLUE SHIELD® marks without license)
- California Cooler, Inc. - California Cooler, Inc. v. Loretto Winery, Ltd. (enforcement of rights in California Cooler trademark against infringement)
- Chicago Board of Trade - Chicago Board of Trade v. Dow Jones (challenge to ability of Board of Trade to use Dow Jones Industrial Average as a basis for a stock index futures contract)
- Coca-Cola Co. - Stokely-Van Camp, Inc. v. Coca-Cola Co. (dispute over rights to use trademark Refresh for beverages)
- General Foods Corporation - General Foods Corporation v. Borden, Inc. (suit for infringement of General Foods' "Country Time" trademark by Borden's use of "County Prize")
- S.C. Johnson Company - S.C. Johnson Company v. The Drackett Company (challenge to misleading advertising claims)
- Motorola, Inc. - (obtain registration of mark "Flip Phone" for cellular telephones)
- National Football League Properties - National Football League Properties v. Consumer Enterprises; National Football League Properties v. Dallas Cap (enforcement of rights in names and emblems of NFL teams against unauthorized use on merchandise)
- Warner Bros. - Various Matters (enforcement of Warner Bros.' rights in cartoon and television characters against unauthorized use in cases throughout United States)

Other

- Amoco Corporation - Amoco Cadiz Litigation (case against Amoco regarding oil spill from Amoco Cadiz super tanker into English Channel)
- General Motors Corporation - Engine Switching Cases (challenge to GM's use of engines produced by Chevrolet division in Oldsmobiles)
- International Harvester Company - Dynamics Corp. of America v. International Harvester (claim that plans and facilities for manufacturing trucks sold to plaintiff were incomplete and erroneous)

- **Alternative Dispute Resolution Training and Experience**
 - Mediation Training, International Institute for Conflict Prevention and Resolution (“CPR”)
 - Panelist, CPR Panel of Patent Neutrals
 - Member, CPR International Commission on Patent Disputes
 - Chairman, Expert Neutrals Panel, International Trademark Association (“INTA”)
 - Chairman, INTA Task Force for the Training and Evaluation of Its Expert Neutrals
 - Conduct training exercises for mediators
 - Founder and Member, Lanham Act Mediation Panel for the Northern District of Illinois
 - Special Master, Appointed to Conduct Markman Hearings, Eastern District of Wisconsin and the District of Arizona

- **Professional Activities**
 - Former Chairman - Copyright Subcommittee of ABA Litigation Section
 - Author - Unfair Competition Section, Intellectual Property Law, published by Illinois Institute on Continuing Legal Education, 1982
 - Author - Geographical Scope of Injunctions in Intellectual Property Cases, Trademark Reporter, 1987
 - Speaker - at Patent Trial Practice Institute, and before Patent, Trademark and Trade Secret Litigation Institute, on intellectual property litigation techniques and strategy
 - Speaker - at United States Trademark Association Forum on Trademarks in Corporate Transactions

- Speaker - at American Association of Public Opinion Research Forum on Use of Surveys in Intellectual Property Litigation
- Speaker - at ABA Patent/Trademark Section Meeting on Injunctions in Intellectual Property Cases

- **Community and Social Activities**

Board Member and Former Chairman - Chicago Lawyers' Committee for Civil Rights Under Law