

such relief would *promote* public health by prohibiting patients from using diagnostic laboratories that don't have its track record in interpreting mutations. If a court were to agree with these arguments (and of course agree with Myriad's argument that its claims are likely to be valid, also a contested proposition), NIH should consider counterarguments that the Myriad track record is not as unequivocally superior as the firm claims. If these arguments appear meritorious, NIH might evaluate whether licensing to other firms would promote Bayh-Dole's objectives with respect to health and safety. Even though NIH appears to have background rights in only some of the patents that are being asserted, even an incomplete stake might provide some leverage.

Beyond Diagnostics

For many in the biopharmaceutical industry, the concern raised by *Myriad* is not invalidation of gDNA patents but instead unintended consequences for patents associated with therapeutic molecules. All therapeutic molecules require approval by the FDA, and most analysts agree that patents provide important incentives for expending the resources necessary to secure such approval. The amicus briefs filed by the solicitor general and Eric Lander called specifically for upholding cDNA claims typically associated with therapeutics.

Therapeutic products that could be affected include proteins and antibodies. Although many protein and antibody patents now claim molecules that are

clearly synthetic, certain claims could be seen as encompassing naturally occurring molecules. Even in these cases, however, the claims wouldn't necessarily be invalid. Presumably the antibodies and proteins would, in the words of the *Myriad* Court, be claimed as something closer to "specific chemical compositions" than to information. Lower courts could focus on this aspect of the *Myriad* opinion in upholding such claims. Similarly, in addressing patents covering small molecule chemicals with important therapeutic uses that have been isolated from nature, courts could focus on the fact that these patents typically claim "specific chemical compositions."

In the wake of *Myriad*, some analysts have also expressed concern about an inability to patent prokaryotic DNA, which lacks noncoding regions, or DNA products based on sequences found in nature. However, if DNA molecules do prove directly useful as therapeutic products, they will likely not be claimed as "merely isolated." Rather they will have been combined with some other material, such as a vector.

Conclusion

Without a doubt, the Court's recent spate of activity in the area of diagnostic patenting has caused considerable anxiety for those concerned about innovation. To some extent, the anxiety is justified. But lower courts could choose to read the Court's opinions in a manner that is friendly to innovation. This essay has attempted to provide a path forward for lower courts. ■

Joseph D. Kearney

Remarks at the Investiture of Judge G. Michael Halfenger

On April 12, 2013, in the federal courthouse in Milwaukee, G. Michael Halfenger took the oath of office as a U.S. bankruptcy judge, with various federal judges on the bench, including Seventh Circuit Chief Judge Frank H. Easterbrook. Eastern District of Wisconsin Chief Judge William C. Griesbach, L'79, presided. Judge Halfenger's former law partner, Thomas L. Shriner, Jr., of Foley & Lardner, made the motion to administer the oath of office, which Dean Joseph D. Kearney seconded. Here are Dean Kearney's remarks.

Thank you, Chief Judge Griesbach, and May It Please the Court. Mr. Shriner and I are accustomed to sharing a podium: we do so a couple of times a week in the various courses that we teach together each semester at Marquette Law School. So if, at any moment, I pause or flinch, it is because I expect Mr. Shriner, in our usual classroom

style, simply to interject whenever it pleases him to do so—and I will hope, as always, that his purpose will be to elaborate rather than to correct.

I am glad for my specific role here: left to my own discretion, I might wander too far afield. Indeed, when I asked Mr. Halfenger whether two speakers were too few, he related that he thought that Chief

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Photo by Ellen Cook

Joan Halfenger and Melissa Halfenger look on as Mike Halfenger, respectively their son and husband, takes the oath of office as a U.S. bankruptcy judge.

Judge Easterbrook had limited the speakers at his own investiture to one, asking Dean Gerhard Casper of the University of Chicago Law School to say a few words, perhaps about a law review article.

I liked it. This suggested that today might be an opportunity to talk about an essay that I wrote last year marking the 125th anniversary of the Interstate Commerce Act. That was an historical occasion that it seemed (to me and to a few others) noteworthy.

After all, to talk about the Interstate Commerce Act would have enabled me to talk about the filed rate doctrine—the precept that a railway, telephone, or trucking company had to embody its rates in tariffs filed with the federal government and could not depart from the filed rates under any circumstance, lest there be discrimination or favoritism. It would not even have been hard for me to tie this into bankruptcy, as the Supreme Court’s great modern filed rate doctrine case of 1990, *Maislin Industries, U.S., Inc. v. Primary Steel, Inc.*, arose from a bankruptcy case. There, trustees in bankruptcy of failed trucking companies went after shippers that had made the mistake of thinking

themselves to be in an ordinary marketplace and had paid only the rates that they had negotiated with the carriers, not the filed rates. Such a discussion was all in front of me.

Imagine my disappointment, then, to learn later in my conversation with Mr. Halfenger that the law review article discussed back in 1985 had not been Dean Casper’s own but rather one by the subject of the motion, Judge Easterbrook. This was a problem beyond depriving me of the Interstate Commerce Act: Mr. Halfenger has not been about writing law review articles during the more than 20 years that I have known him. Rather, he has been hard at the practice of law.

And this he has done most impressively and well. I know this from having worked with Mr. Halfenger starting in 1992: after clerking for Judge Easterbrook, he arrived to Chicago’s Sidley & Austin (before the firm lost the ampersand). Mr. Halfenger made his mark quickly: I can demonstrate this by a reference to now-Professor Jim Speta of Northwestern University. The latter graduated from law school the same year as Mr. Halfenger but joined the firm a year later. Mr. Speta was dispatched for his first assignment to help out in a pending case. He looked forward to meeting the important partner for whom he no doubt would be working—only to discover that his task was to review several boxes of documents that the not-much-earlier-arrived Mike Halfenger had in his office. So Mr. Halfenger was on his way to success at the firm: passing off discovery to anyone, let alone after only a year and to someone not junior to you, hints at *greatness*.

Imagine, then, our surprise at Sidley in 1994, when Mr. Halfenger moved to Wisconsin, which was where he and his wife, Melissa, had first met



“When a panel of a federal court of appeals a few years ago began, rather strangely, to question whether the law schools at Marquette and Madison especially taught Wisconsin law (a matter of some relevance to the diploma privilege then under attack), we at Marquette retained Mr. Shriner and Mr. Halfenger. That few other lawyers in town might have wished to deal with me as a client—and that no others would have permitted me to sit at their kitchen table, until three in the morning, finishing a brief with them—may have had something to do with the selection.”

(as undergraduates at Lawrence University), and was the home of Melissa’s parents. Mr. Halfenger then joined Foley & Lardner, as Mr. Shriner has described. I myself already knew Mr. Halfenger to be an excellent lawyer—something that I would like to think is correlated with success as a judge. And the testimony in this regard by his longtime law partner, Mr. Shriner, is sufficiently powerful that I do not feel the need to elaborate. Yet I do wish to relate that this esteem for Mr. Halfenger soon became the judgment also of my wife, Anne Berleman Kearney, when we followed Mike and Melissa to Milwaukee some three years after them, and Anne, having left the Corporation Counsel’s Office of the City of Chicago, joined him as a lawyer at Foley.

Anne, who worked with Mr. Halfenger closely, has noted to me that it is not just native intelligence that drove his success as a lawyer. In addition to this, Mr. Halfenger has always been willing to help his colleagues wrestle with difficult issues in cases that they were handling—and not merely in some offhand sort of way. When Mr. Halfenger is with you, he is with you: you have his attention, his engagement, his patience. He is not hurried, and you know that his purpose is to work through an issue with you—not to comply with your request in some formal but not especially helpful way, so that he may return to “his” case. What a great thing this is in a judge: the capacity and the affinity to listen, to converse, to attend. Anne, who still practices at a high level even though she now has only me (of counsel) as a professional colleague in her otherwise solo practice, suggested that she and other women lawyers at the firm especially valued Mr. Halfenger’s approach.

So the Kearney family knows Mike Halfenger. Indeed, as Your Honor has suggested, we are practically neighbors—separated by some six or eight houses. This is because Melissa Halfenger found us our house when we had unusual criteria, and it has been to the advantage of Michael, Stephen, and Thomas Kearney to have such ready access to Matt and Kyleigh Halfenger, and to all of us to get to know the larger Halfenger and Wagner families. And more than once the Kearney family has called on Mike for help, from routine matters to rather more unusual ones. I will not embarrass Mike, for example, or more likely myself by recounting how I have not hesitated to ask him to go to the store to get me some Gatorade when I was sick in bed. But we can agree, I should hope, that some kindness can be appropriate in a judge—whether in a bankruptcy judge especially, I will leave to others.

The relationship is not all personal. Marquette University Law School has relied on Mr. Halfenger for both legal representation and other support. When a panel of a federal court of appeals a few years ago began, rather strangely, to question whether the law schools at Marquette and Madison especially taught Wisconsin law (a matter of some relevance to the diploma privilege then under attack), we at Marquette retained Mr. Shriner and Mr. Halfenger. That few other lawyers in town might have wished to deal with me as a client—and that no others would have permitted me to sit at their kitchen table, until three in the morning, finishing a brief with them—may have had something to do with the selection. All ended well—and a good thing, too, for otherwise someone else might be here as dean (I mean,

Eckstein Hall is nice and all, but it's not the diploma privilege).

Mr. Halfenger had long before invested in Marquette Law School. The job of reading the draft case problem in our Jenkins Honors Moot Court Competition became his permanently almost a decade ago, when in this courtroom Judge Easterbrook inquired, from the bench, of the hapless student advocate why the defendant named in the moot court problem was a public school and not a school district (as would have been the case in the real world and as would have avoided the mootness issue in the case). Mr. Halfenger, who was in the courtroom that evening, allowed to me afterward that that had occurred to him as well. I would ask Your Honor, as an alum of Marquette Law School, to consider whether to clarify in ruling on the motion that, unlike a defense of the diploma privilege, this sort of work remains available to Mr. Halfenger to do.

Certainly, the evidence that a non-alum in Mr. Halfenger's position should be interested in Marquette Law School is ample. Judge Shapiro was a friend of the Law School even before I became dean. This is a large robe to fill in many ways, as both Your Honor and the bar of this Court well know.

My confidence in Mr. Halfenger is without limit. Some years back I delegated to him my position on the Wisconsin Supreme Court's Appointment Selection Committee, which Mr. Halfenger went on to chair. And when the Court told me that his term was up and that under the rules I needed to appoint someone else, I instead suggested to the chief justice that such a small matter as the end of a term or even a term limit should not get in the way of a good idea. Mr. Halfenger was reappointed.

Let me not continue. I respectfully submit that the Court should consider itself adequately informed in the premises of the motion. The Court has heard representations by members of its bar concerning Mr. Halfenger's intelligence, his outstanding work habits, his great knowledge of the law, his interest in people, his appreciation of public service, and many other qualities and characteristics that commend him for the awesome position of judge. Thus, to appear on behalf of Marquette Law School (which I get to do frequently), to represent the local legal community (as I do only on occasion), and to speak both for myself and (for the matter where I am perhaps most careful) for my wife, I respectfully second the motion that the Court administer the oath of office to Michael Halfenger. Thank you. ■

Sports Law Banquet | Gary D. Way

Nike's Gary Way Receives NSLI's Joseph E. O'Neill Award

On April 26, 2013, at the annual Marquette Law School Sports Law Banquet, Gary D. Way received the National Sports Law Institute's Joseph E. O'Neill Award from Professor Matt Mitten. The award, remembering a late partner at Davis & Kuelthau, has been given annually over the past 20 years to an individual who has made a significant contribution to the field of sports law while exemplifying the highest ethical standards. Mr. Way is Vice President & Global Counsel, Sports Marketing at Nike, Inc. He used the opportunity to share some advice for Marquette law students interested in sports law.



Gary D. Way

Thank you, Professor Mitten, for that generous introduction. When you describe my work, it sounds much better than the way I think about my job. If I were asked at the Pearly Gates about how I have used my law degree to better the world, I would be at a loss—because, in essence, my work is based upon helping to give away money and free shoes to millionaires.

Anyway, I'm thankful for this opportunity. I would like to take a few minutes to continue in the thank-you mode. First, I would like to thank the Marquette Law School community for the tremendous hospitality it has shown me throughout the day. ▶▶