THE TEACHING OF INTELLECTUAL PROPERTY LAW AT THE JOHN MARSHALL LAW SCHOOL

by
Donald W. Banner
Distinguished Professor of Law
The John Marshall Law School
Chicago, Illinois,
United States of America

The formal teaching program of Intellectual Property at the John Marshall Law School is divided into two separate phases. Phase I is taught in the Undergraduate Law School. There are two separate courses, the first of which covers the basic aspects of patent law and trade secret law. This course requires thirty classroom hours of teaching. The material covered consists of the fundamentals of patent law with emphasis on its historical basis, the substantive aspects of the statutes in the United States, the requirements for obtaining U.S. patents and a generalized treatment of the patenting procedure. Aspects of infringement, patent interpretation, licensing and the fundamentals of patent assignment law are also included. The teaching which relates to trade secret law deals with the fundamentals of the requirements for trade secrets, the methodology of protection, the rights which stem from ownership of trade secrets, a comparison of those rights with those which stem from other forms of intellectual property, and the law concerning the utilization of such secrets in licensing and other mechanisms of technology exchange. This course is taught by Professor Donald W. Banner.

The second course in the Undergraduate School deals with the fundamentals of trademark and copyright law. The basic law of trademarks, including their historical basis as well as their statutory basis in the United States, are reviewed with emphasis on the important case law which has developed. The role of trademarks in the broader field of unfair competition is emphasized. Requirements for registration of trademarks in the federal forum are also treated. The copyright law in its present and historical form are also taught in this course in a general mode, including the creation and enforceability of copyrights in the United States. This course also involves thirty hours of classroom work; it is taught by Mr. Louis Altman.

Phase II, the more major phase of the teaching of Intellectual Property Law at The John Marshall Law School, involves a comprehensive program which has been developed over a period in excess of forty years. This course of study is presented in the Graduate School; it is open only to members of the bar, or graduates of law schools, having a demonstrated career interest in some phase of Intellectual Property Law. The Degree of Master of Laws in Intellectual Property is granted to candidates who complete the course of instruction which requires 315 classroom hours of work in the required courses plus a supervised dissertation which must be a unique contribution to the law of a substantive nature. The topic choice and the dissertation content are developed in cooperation with a supervisory board of three distinguished lawyers, who are experts in the field of the dissertation. The Graduate School program in Intellectual Property Law at The John Marshall Law School is directed by Distinguished Professor of Law Donald W. Banner.

The courses presented in the Graduate School will be briefly described.

A course in Substantive Patent Law is divided into two parts, each part requiring 45 hours of classroom work. The first part involves a study of the modern law of patentability and validity in the United States, with emphasis on the developments interpreting the Patent Act of 1952 and including the latest and most substantive Supreme Court cases. Controlling case law is analyzed in depth as it relates to the statutory categories of patents and novelty, utility and unobviousness as conditions of patentability. Prior art and loss of right to patent are thoroughly and particularly studied. Consideration in depth is also given to the requirements of a proper disclosure and the methodology of appropriate and exact disclosure of the invention described in the patent. The course is taught by Mr. Homer Schneider.

The second part of the course in Substantive Patent Law, also requiring 45 hours of classroom work, relates substantively to enforcement issues. It includes the various factors involved in determining the construction to be accorded to a U.S. patent. This involves a detailed consideration of the legal criteria involved in determining patent scope, such as the legal and background factual influences considered in making a patent scope determination. In addition, the statutory basis for infringement is studied in depth. Included in this aspect are direct and contributory infringement as well as inducement of infringement, with emphasis upon the differences and the consequences of each type of infringement. The course also includes a study of the law of file wrapper estoppel and other defenses, the law relating to the equitable doctrine of equivalents and the manner of its utilization and limitation. Equitable defenses such as patent misuse and fraud on the Patent Office are included in this study. Jurisdictional and venue considerations involved in U.S. patent infringement litigation, as well as injuctive and monetary consequences of infringement, are thoroughly covered. This course is taught by Mr. John Hofeldt.

The course on the law relating to Practice Before The United States Patent Office involves 45 hours of classroom work. The Rules of Practice, and the Manual of Patent Examining Procedure are carefully reviewed, with emphasis on the case law interpreting the Rules and the Manual. Included in the consideration are the cases which relate to the patent application itself; those involving detemination of inventorship, oath, the proper specification, the appropriate claims, drawings and formal documents. The examination and prosecution aspects are carefully considered, together with a review of the law relating to rejections, objections, amendments and affidavits. In depth treatment is also given to appellate practice involving patent applications before the Board of appeals, the Board of Patent Interferences, the Court of Customs and Patent Appeals and the United States District Courts. In addition, consideration is also given to basic law and practice of interferences (the procedure for determining which one of a plurality of claimants is the first inventor) of interferences. The correction of patents by certificates of correction, and disclaimers is covered, as is the procedure for changing the stated inventorship. Correction of the patent by reissue and reexamination are also studied in detail as a part of this course. This course is taught by Mr. Gerald Rose.

The course in United States Trademark Law and Practice involves 30 hours of classroom work. It constitutes a review and analysis of state and federal trademark infringement and unfair competition cases, especially including cases interpreting the federal trademark statute. Particular emphasis is placed upon the nature and theory of trademarks and trade indentity, unfair competition and the developing trends in civil litigation and inter-partes

proceedings in the United States Patent and Trademark Office, including jurisdictional issues. The burden of proof required of plaintiffs for sustaining charges of trademark infringement are treated, as are the legal and equitable defenses available to defendants in trademark infringement litigation. Elements considered for preliminary and permanent equitable relief and monetary awards are reviewed. The limits of protection accorded labels, colors, geographical terms, surnames, trade names and product configurations, as determined by the appropriate cases, are discussed. Also studied are the differing standards of review on appeal in trademark matters. This course is taught by Mr. Thomas Hofstetter and Mr. Raymond Geraldson.

The course in Copyright Law and Practice is one requiring 45 hours of classroom work. This course reviews in depth the Copyright Statute of 1909 as well as the 1976 Copyright Statute of the United States. It includes case material relating to all aspects of copyright, and peripheral law, including the rights of privacy, publicity, protection of ideas and misappropriation. In addition to a study of the landmark cases in the field, current cases are reviewed and analyzed. An in depth review of international copyright relations and law with emphasis on the U.C.C. and the Berne Convention is also made. Consideration is also given to the preparation and prosecution of copyright registration applications, to related pending legislation in the United States. This course is taught by Mr. Charles Rowe.

The course relating to Antitrust Law requires 45 classroom hours of study. Included in the course is the case material, and other authoritative source discussions, on restraint of trade under the common law; horizontal price fixing and horizontal division of markets; monopolization and attempts to monopolize under the Sherman Act; group boycotts and barriers to entry; resale price maintenance; vertical territory restrictions; exclusive dealing arrangements; tying arrangements; foreign trade problems and criminal and civil enforcement proceedings. The course is taught by Mr. Jerome Lamet.

The course relating to Interference Practice, by which the "first inventor" is determined, is one requiring 15 class hours of work. In that course the theory and statutory basis for interferences is covered. Also taught are the steps of setting up interferences including the suggestion of different types of claims by the Patent Examiner. Copying claims from a patent, and the shaping and determination of "counts" is considered. The strategic importance of the correct count is emphasized. In addition the requirements of Preliminary Statements and associated exhibits are covered together with a study of motions including those relating to matters both ancillary and nonancilliary to priority. Discovery, including a study of the information and documents obtainable and procedures relative thereto, are covered. The testimony practice and procedure are reviewed together with a consideration of the abandonment, suppression or concealment and the steps involved in the settlement of interferences. Post-interference prosecution of applications is also within the scope of this course. The course is taught by Mr. Caliste Alster.

The course in Patent Contracts is one which involves 15 semester hours of classroom work. In this course the case and statutory material relating to title to inventions, joint inventorship, assignments and other aspects of ownership are studied. In addition, licenses with both express and complied conditions are studied, including those relating only to certain geographical

or technical fields. The assignment and termination of licenses, and the recording of license, is considered. Warranties, estoppels, noncontest clauses and tax issues are studies in this course. The course is taught by Mr. Louis Altman.

The course is Patent Litigation involves 30 hours of classroom work. considered in detail are jurisdictional and venue considerations and the proceedings in trial and appellate courts relating to such considerations. The content and preparation of required pleadings in infringement matters and the forms of discovery and motions which relate to discovery are treated. Consolidation and severance of cases and of issues within cases are studied. Pretrial preparation and proceedings including the selection and preparation of expert witnesses are considered. Also involved are study of the factors which bear on the decision to inititate litigation, including the strategic position of the patent in the relevant art and the commercial value of the litigation. The file wrapper proceedings and their interpretation in court are hearing and briefing practices in interference matters. Review of interference decisions by the Patent Office and the factors involved in chosing the mode of appeal are studied, as are the requirements for proving various aspects of interference practice such as conception, reduction to practice, diligence and corroboration; proofs required for emphasized. The result of success or failure in patent litigation and the alternatives to litigation are all included within the scope of this course. The course is taught by Mr. John Hofeldt.

The course in Unfair Trade Practices involves 45 hours of classroom work. Within this period of classroom effort, the economic and legal aspects of fair and unfair competition are discussed. The course covers deceptive advertising at common law, state regulation and remedies of competitors. Disparagement of product, title and business method are considered. The Federal Trade Commission regulation of unfair methods of competition and unfair or deceptive acts or practices is studied in depth, together with state statutes prohibiting sales below cost. Also included in the course are cases relating to price and service discrimination under the Robinson-Patman Act. The course is taught by Mr. Jerome Lamet.

The course relating to Antitrust and Misuse Aspects of Intellectual Property Rights involves 30 hours of classroom work and deals with the law relating to patents, trademarks, and copyrights and know-how in relation to the law which prohibits monopolization and acts leading toward incipient monopoliztion. Thus, the Sherman Act, the Clayton Act, and the Misuse Doctrine are studied in depth. Included in the course are the antitrust and misuse aspects of acquisition of patents, fraud on the Patent Office, grant backs, the use and nonuse of patents; licensing practices including those with minimum price provisions, with provisions granting the license only in particular areas or particular fields of technology, cross licenses, patent pooling, "block booking", and those associated with the purchase of items not within the scope of the licensed patent, and licenses to multiplicities of parties, both competitors and noncompetitors. Trademark problems arising out of antitrust considerations are considered in depth especially as they relate to license and franchise arrangements. Trade secret and "know-how" licensing as it impacts on this field of law is included within the scope of this course. The course is taught by Professor Donald W. Banner.

The course in Taxation of Intellectual Property involves 15 hours of classroom work. The tax treatment of expenditure of the purchase and licensing of patent rights, and prosecution expenses, is covered. In addition tax aspects of litigation expenses, including damange, as well as the treatment of proceeds from the sale or exchange of intellectual property rights, are considered. Particular issues relating to tax aspects of trademarks are considered as they relate to the costs involved in acquiring trademarks and their amortizable and nonamortizable nature. The tax consequence of abandonment of patents, trademarks and other intellectual property is also considered. The tax aspects of copyrights, especially their acquisition, sale and licensing are studied as are the rules relating to depreciation of copyrighted works. The course is taught by Mr. John Mann.

The course of Foreign Patents involves 30 classroom hours of work. The course includes a review of the national patent filing and prosecution practices in the major industrialized countries outside the United States of America as well as procedures for enforcement of the patents. Various ancillary national laws and practices dealing with antiturst, assignment and licensing, and employer-employee rights regarding inventions, are also considered. The history and development of the Paris Convention is studied together with the Patent Cooperation Treaty and the European Patent Convention. The course is taught by Mr. John Chrystal.

The course in Foreign Trademark Law involves 15 hours of classroom work. This course is a study of foreign trademark and unfair competition practice and includes selection, searching, filing, prosecution, renewal practice, licensing, assignments, oppositions, cancellation, infringement, use, marking, and other aspects of international trademark practice. A specific review of existing and proposed international treaties is made including the Trademark Registration Treaty, the European Trademark Treaty, the Andean pact, the Pan American Convention and the Central American Convention are included. The course is taught by Mr. Thomas Hoffmann.

The formal course programs are supplemented by annual seminars. Each February a two-day seminar is presented in which outstanding lecturers from many countries, including Dr. Bogsch, the distinguished Director General of WIPO, have participated. Attendees come from all parts of the United States, as well as from other countries each year. The brochure describing the program earlier this year, the Twenty-Fifth Annual program, is enclosed.

Each summer a one-week course is presented directed to the many interesting yet subtle aspects involved in the creation of a proper and effective U.S patent application.

- . -

TEACHING MATERIALS FOR COURSES AND WORKSHOPS ON INTELLECTUAL PROPERTY LAW

Conclusion of the WIPO/ATRIP Working Group on Teaching Materials for Intellectual Property, July 1986

SUMMARY

This document contains the conclusions of the Working Group on Teaching Materials for Intellectual Property, organized by the World Intellectual Property Organization (WIPO) and the International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP), held in Geneva, in July 1986.

Conclusions of the Working Group

COLLECTION OF INFORMATION ON EXISTING TEACHING MATERIALS

ATRIP members (one to be selected by the President of ATRIP from each country) should prepare an annotated list of reading material available for teaching (not for detailed research) in their respective countries. An indication should be given of the nature of the material (e.g., legislative texts, judicial opinions, doctrinal commentaries), where the materials may be obtained, and their cost. The title of the material should be given in the original language with a translation, where appropriate, into English; if the material exists in different languages, the languages should be indicated. The list should be completed before the next meeting of the Working Group in July 1987.

CLASSIFICATION OF TEACHING MATERIALS

The Working Group should prepare a preliminary classification drawn from the curricula prepared by Professors Aracama and Beier and the International Bureau of WIPO model and from the collection of information on existing teaching materials (item 1, above) and the preliminary collection of teaching materials (item 3, below). The tasks will be assigned later.

COLLECTION OF TEACHING MATERIALS: the "Problem" Approach

(1) The possible subjects, by way of example, in respect of which materials reflecting different approaches or solutions would be collected could be as follows:

(a) Patents, Utility Models, Trade Secrets

(i) Economic Purpose and effect of Patent System and of types of licensing (exclusive, non-exclusive, compulsory). Significance for developing countries.

(ii) Relationship of utility model to patent protection; justifications for a dual system.

(iii) Relationship of know-how to patent protection, justifications for a dual system.

(iv) Types of compulsory licence regime: their applicability to the circumstances of developing countries seeking the transfer of technology.

(b) Trade Marks and Unfair Competition

(i) Function of trademark protection: economic objectives and legally recognized purposes. Position in developed and developing countries.

(ii) Comparison of trademark registration systems (deposit, full ex officio examination, ex officio and third party opposition); relation to general law of unfair competion.

(iii) "Stockpiling" of trademarks: legal requirements to use trademarks.

(iv) Scope of unfair competition laws: relation to regimes of consumer protection.

(c) Copyright

(i) Duration of copyright and its justification.

(ii) Relation between author's copyright and neighboring rights.

(iii) Administration of copyright through collecting societies and misuse of dominant position.

(iv) Exceptions to copyright to meet needs of (a) education; (b) developing countries.

(d) General

(i) Choice of law in intellectual property contracts and disputes

(ii) Types of remedy against piracy and counterfeiting of products embodying intellectual property.

(iii) Intellectual property and anti-competitive activity (cartels, merger, restrictive licensing etc.)

(iv) Legal and practical barriers to transfer of technology to developing countries.

(2) Upon the basis of expressions of interest, the President of ATRIP will arrange, as an initial step, for the collection of materials by four professors, one professor-rapporteur in respect of each of four subjects drawn from the above list, assisted by two other professors for the subject concerned. Each collection should be available for consideration by the Working Group at its next meeting in July 1987.

DISSEMINATION OF TEACHING MATERIALS

(1) Items to be considered include the following:

(a) Depositary location

(b) Limited publication

(c) Translation

(d) Computerized holding

(e) Copyright permissions.

(2) The teaching materials should be located at a central place, preferably at WIPO headquarters, and be available to members of ATRIP and teaching institutions in developing countries. As concerns the other items, they will be considered once the teaching materials are assembled and considered.

- . -