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TEACHING OF PATENT LAW

by

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I. INTRODUCTION

Intellectual property (IP) law is an extremely complex legal field that covers not only patents but also trademarks, copyrights, trade secrets, know-how and licensing. In today's highly competitive economic environment which includes national and international competitors, the importance of adequate patent protection cannot be understated. For example, the rapidly-changing, highly-competitive computer and biotechnology industries have particularly caused a severe strain on patent law.

In addition to the growth of high tech industries, other factors creating a new demand for patent professionals are the surge of imports and with it the influx of patent applications from foreign manufacturers and recent legislative reforms of the Patent Laws, not to mention the creation in 1982 of the U.S. Court of Appeals for the Federal Circuit (CAFC) whose jurisprudence has had a very beneficial effect on the patent system.

While the overall number of U.S. lawyers has more than doubled in the past fifteen years (from over 400,000 to over 800,000 — 1 million by the year 2000), the number of patent lawyers increased only marginally to the present level of over 13,000.

The demand for patent professionals or practitioners has far exceeded the supply. And the situation will probably remain that way for some time to come because not nearly enough scientists and engineers are coming out of American universities and those that do have other options, more so than before.

The biggest bottleneck to the entry of new practitioners into the patent field is the need for strong technical credentials. Would-be patent lawyers invariably hold undergraduate degrees (and perhaps second graduate degrees) in one of the sciences or engineering. A prerequisite for taking the patent bar examination that a law student or graduate must pass before admission to practice before the U.S. Patent and Trademark Office (USPTO) is a bachelor's or graduate degree, or the equivalent thereof, in a specified scientific or technical subject from a recognized U.S. college or university. Such subjects are listed in Annex I.

As in the case for other graduates from law school (typically a three-year proposition), the candidate also has to hurdle a general state bar examination to become a licensed attorney.

As was pointed out in a Business Week article entitled "Patent Lawyer":

> "Ordinarily, the law school curriculum departs little from that followed by general practitioners, although students aiming for the field will choose intellectual property courses as electives. A few schools, such as the Franklin Pierce Law Center in Concord, N.H., offer more intensive course work and actual casework experience... enabling students to pass the patent bar before graduating.
>
> Interestingly, because technical credentials are key, the pressure to

get into a prestigious law school, felt heavily by general practitioners, is less applicable to patent specialists." (Business Week, Sept. 1987, p.80)

Indeed, the basic legal curriculum, fairly standard throughout the U.S., does not include patent or related IP law. Historically, few schools have provided even elective coverage. Even today patent and other IP courses are merely electives since IP law has not been required for state bar admission purposes and is not a subject covered by state bar examinations. Thus, most patent attorneys have had to acquire their knowledge and skills on the job.

The situation as regards patent law teaching and training has improved over the past decade or so. A few law schools now offer as many as twenty or more credits (well within the usual range of law school elective hours) in IP law and thirty-five credits in the case of Franklin Pierce Law Center (FPLC). This is due in large part to the fact that we live in a golden age for patents and the subject of patents has become hot and topical, if not sexy and glamourous.

II. THE GULF BETWEEN LAW SCHOOL AND LAW PRACTICE

In addition to these problems, there is considerable ferment in law schools with respect to the question of specialization and the gulf between law school and law practice. Law school teaching has changed very little over the years and decades. Its cornerstone by and large is still the Socratic method and case analysis pioneered at Harvard more than a century ago. Yet, the practice of law has changed significantly, especially in more recent times, following changes in the business and political worlds.

Law schools don't teach the skills students will actually need to practice law, that is the charge. According to U.S. News & World Report "Best Law Schools" article (March 19, 1990, p.59) "[l]egal education is under attack from both academics and practicing lawyers."

U.S. News & World Report continues:

> "Schools are being pulled in conflicting directions: Academics accuse them of promoting rote learning while neglecting analysis and original scholarship. Practicing lawyers complain that they lag far behind rapid changes in the law business. ... Students are torn between those professors who lead them in pursuit of arcane theories and those who stress techniques of drafting briefs."

Finally, U.S. News & World Report concludes that "[c]ries from the organized bar that educators must do more to narrow the gap between the classroom and law-office realities will grow louder." (*Id.* at 61)

This ferment is further dramatically high-lighted by the creation of a "Narrowing the

Gap" task force by the American Bar Association (ABA) and the publication of a Special Report entitled "The Making of a Professional — Law School in the Nineties" in the ABA Journal, September 1990 (p.43). An interesting point in this report is a warning against going too far and "trivializing law school's scholarly and theoretical purposes" and leading to a "trade school approach" and David Link, Dean, Notre Dame Law School, recalled that "[f]or a long time, the law schools and practitioners argued about whose responsibility it was to teach students practice. Many schools contended their job was only to teach the law." (*Id.* at 45) Later, some schools came around to "teaching skills through simulations or in clinical settings" but this approach lacked mentoring and feedback so that it is now realized that both law schools and law firms have a "common interest in mentoring (and) need to meet halfway" (*Ibidem*).

FPLC, as will be seen below, is clearly ahead of this fray or outside of this furor with its practice-oriented approach, including "bridging semester" or "capstone" courses and other benchmark alternative (BMA) concepts. This is likely also true at other law schools with extensive patent and other IP programs since substantial programs and extensive training in patent and IP law are recent law school innovations and patent law faculties still consist by and large of practicing patent attorneys.

III. POLICY OBJECTIVES OF PATENT LAW

Before going into the specifics of patent law teaching and curricula, it is appropriate, for background and perspective, to also review and illuminate the policy objectives of patent law.

In an interview a few years ago, Judge Giles S. Rich of the CAFC answered the question of whether our Patent Laws promote the progress of the useful arts as follows:

> "I think they certainly do. And I think that I might mention the way the incentives of the patent system actually operate. There are four of them. The first one is the incentive to invent, and I think that's the least important because people are going to invent anyway. The second one is that it is an inducement to disclose the invention to the public which is done when you file a patent application and get the patent issued, without which the invention might not be disclosed and be kept as a trade secret. And the third one, which I think is of the most important, is the inducement to invest risk capital to develop and promote the sale or use of the invention. There's a fourth one, which is a sort of backhanded thing, which is known usually as the negative inducement to "invent around" the potential invention. The issuance of a patent causes competitors

> of the patentee to devise still further ways of doing the same thing and that produces more inventions — more progress in the useful arts. So, in those four ways, I've been convinced all my life as a patent lawyer that the Patent system surely does promote the progress of the useful arts."

Studies and proposals for alternatives to patents as incentives were made time and again but the Patent System survived them as, in the final analysis, the very best and most viable time-honored alternative itself. For instance, a Congressional Study by Giligillan ("Invention and the Patent System", Joint Economic Committee, Washington, Government Printing Office, 1964) which the author ambitiously called a "first appraisal" of the Patent System, identified "15 or so rival institutions" and proposed additional ones, in particular a "new institution" which

> "would avoid almost all the shortcomings of the existing systems, and support invention much better than ever before, with unlimited funds, and guidance for social welfare, yet with direction by businessmen, through licensed, nonmonopolistic, semipublic trade associations, which would acquire universal membership through gaining control of all good patents, through being granted them on better terms than to non-cooperating inventors." (p.9)

But it is noteworthy that even this proposed "new institution" is based on patents and involves patent pools.

More recently, Professor Dr. Carlos Fernandez Novoa of Santiago de Compostela, Spain has dealt with and rejected alternative systems (notably a governmental monetary award system) in his book "Hacia Un Nuevo Sistema de Patentes" (Towards a New Patent System) (Editorial Montecorvo, S.A. 1982). He concluded that "... the Patent System is the best system for promoting technological research that is compatible with a free market system." (p.32)

Accordingly, it can now be stated confidently that patents

1. do have a great impact on research by disseminating information on advances in technology,
2. do promote the innovation process,
3. do encourage high risk investments which lead to industrialization,
4. do facilitate licensing and technology transfer, and
5. do have a significant influence on economic progress.

What kind of patent protection will provide the greatest incentives for 1.) research and development with the aim to achieve useful innovations; 2.) productive investments and 3.) national and international technology transfer? I submit that it will not be a patent system which is overly restrictive in terms of patentable subject matter and patent duration, on the one hand, and overly liberal in terms of compulsory licenses, forfeitures, and other

sanctions for nonworking, on the other hand. In this connection, see Annex II for a series of credos or guiding principles that I have put together over the years.

One of the principles, a new and novel realization that has set in, should be underscored in particular. It is the conclusion that a patent system should be part of a country's infrastructure from the outset rather than something that one thinks about after reaching a fairly advanced state of development. This thesis is found in a recent book authored by Robert M. Sherwood (an international Washington, D.C.-based business counselor) and entitled "Intellectual Property and Economic Development" (Westview Press, 1990). "Although largely invisible, an intellectual property system which protects innovation and creative expression may be viewed as a helpful precondition to creating and using new technology which boosts economic growth and aids development. From this point of view, the intellectual property protection system may be considered as a valuable part of a country's infrastructure" like schools, hospitals, transportation and communication systems. "[V]iewing intellectual property protection as an important aspect of a country's infrastructure would focus attention and analysis on its role in the economic development process rather than on trade conflicts." (p.5) This is quite a novel insight and an incisive truism.

In the U.S. the Patent System, has indeed, been part of the country's infrastructure from the beginning and it has encouraged the genius of hundreds of thousands of inventors for 201 years. It has protected the inventor by giving him an opportunity to profit from his labors and it has benefited society by systematically recording new inventions and releasing them to the public after the inventors' limited rights expired.

At the present we live in a golden age for patents and the Patent System where patents are ever so much more valuable and enforceable. It was ushered in by the CAFC which went into operation in 1982, as mentioned above, and is a very special institution in our Patent World. The CAFC, a combination of the former Court of Customs and Patent Appeals (CCPA) and Court of Claims, was formed to assume sole jurisdiction over appeals in patent cases from all federal district courts as well as to retain jurisdiction for appeals in patent and trademark cases from the USPTO. It was intended by this action to harmonize the varying bodies of law developed in the different Circuit Courts and to eliminate forum shopping.

Due to the existence of the CAFC and also due to more patent legislation and less antitrust enforcement, our Patent System indeed has been revitalized. Patents are indeed more valuable and the courts "read the riot act" to infringers. This, of course, is good news to any patent holders be they large or small, and to R&D-minded companies and entrepreneurs alike.

While before 1982 trial courts held patents invalid more often than not, normally assessed only "reasonable-royalty" damages and rarely granted injunctions or double or treble damages so that it literally paid off to infringe, nowadays many more patents are upheld and penalties for infringement have become severe. "Patents create a formidable

defense which may crush patent infringers with actual and even treble damages, post-infringement interest, attorney's fees, legal costs and a permanent injunction." (Trade Secret Reporter, June 1986, p.33)

IV. PATENT TRAINING IN AMERICA AND IN AMERICAN UNIVERSITIES

A. On-the-job Training, CLE Programs, Patent Academy

As was pointed out in the Introduction, historically most of the patent training has been of the on-the-job type and has taken place in a mentor system and this is still generally the case even nowadays in patent law firms hiring new law school graduates and in corporate patent departments doing the same or transferring scientists from R&D departments to their departments. Such transfers are taking place on a fairly large and increasing scale due to the shortage of patent practitioners, on the one hand, and, on the other hand, due to certain advantages that this holds, i.e., familiarity with the company and its personnel as well as its R&D and patent operations. Often such transferees have gained experience in patent practice as [co]inventors or liaison personnel and their training needs are not as urgent nor as extensive. They become patent agents as soon as they pass the examination for registration to practice in patent cases before the USPTO. Most of these, especially the younger ones, also enter upon a four-year law school evening program.

This on-the-job training and mentoring is supplemented by periodic internal seminars and attendance at programs held by local and national bar and IP associations as well as the Practicing Law Institute (New York) or Patent Resources Group (Washington, DC), etc., and with increasing frequency, by law schools, such as, John Marshall Law School, George Washington National Law Center and FPLC. In states with CLE (Continuing Legal Education) requirements, compliance with those requirements by attendance at professional meetings and patent courses is an additional motivation.

The USPTO, traditionally a source of skilled patent practitioners for law firms and corporate departments, maintains a Patent Academy which trains its new examiners in an extensive four-phase program. The USPTO admits a few non-government employees to each training course, an opportunity which for the most part foreign practitioners intent on learning U.S. patent law take advantage of.

For completeness sake, mention might be made at this point that some Washington, DC law firms, in particular, hold annual patent training courses also designed to attract foreign practitioners. The Cushman, Darby and Cushman "Advanced Patent Seminar" is typical. Annex III gives dates, topics and other details of their 1990 Seminar.

As regards patent teaching in universities, it appears that lectures are given in engineering and science colleges. Dr. Thomas J. Harrison, Chairman and Professor, Department of Electrical Engineering, College of Engineering of the Florida State

University wrote: "I give a lecture each semester on patent law, with some discussion of other means of protecting intellectual property, as part of the introduction to our laboratory courses. During this lecture, I usually discuss the career opportunities in patent (and related) law." (Personal Communication, Jan. 17, 1990.)

It is highly questionable that apart from such introductory lectures any systematic in-depth patent law teaching takes place in universities in general in either undergraduate or graduate science and engineering curricula.

As was stated in the introductory chapter, even in law schools, the most that can be expected is that an introductory survey course is being taught by a regular faculty member who is not a patent specialist or an adjunct professor who is a local patent attorney.

B. Survey Courses at Some Law Schools

The Dickinson School of Law (Dickinson) of Carlisle, Pennsylvania and the University of Baltimore Law School for example, are schools in a second category of law schools with typical patent law survey courses. Dickinson, in fact, has three elective survey courses for two semester hours each. This undoubtedly has something to do with the presence of Professor William J. Keating, a former Patent Counsel at AMP Inc., who in fact teaches these courses. Professor Keating assesses the situation as follows: "... the few schools that have an intellectual property program offer a survey course including patents, trademarks and copyrights. Except for Franklin Pierce, John Marshall and the Washington, DC schools, most schools do not have enough students to justify a program." (Personal Communication, March 18, 1991.) But interestingly Professor Keating's classes are relatively large: they "usually have 40 students in Patents; 70 students in Copyrights and 80 students in Trademarks." The course description for the patent course is as follows:

> Patents — 2 semester hours — Spring
>
> An in-depth treatment of patent protection, including interviewing inventors, drafting patent applications, prosecuting a patent application, patent litigation, conveyancing and licensing. The course also treats foreign rights and interface with the antitrust laws. The syllabus of the patent course offered by Dickinson is appended as Annex IV.

As can be seen from the syllabus, Professor Keating relies heavily (for every subject if not for every class, especially for the patent course) on participation by practising patent lawyers from Philadelphia and Washington, DC.

The University of Baltimore School of Law is another illustration of a law school with IP survey courses, undoubtedly due to the presence of IP Professor William T. Fryer III. The IP course descriptions and the syllabus of the seminar course are rendered in Annexes V and VI. In the seminar course which has an enrollment of about 20 students, patent alumni/ae are enlisted to help out.

To give two more instances: Albany Law School, Albany, New York, where IP Professor Michael Hutter has been in residence for many years, has two-or-three-credit survey courses in Industrial Property and in Copyrights, which are taught by adjunct professors and Unfair Trade Practices which Professor Hutter teaches. And Notre Dame Law School, South Bend, Indiana, has two two-credit IP courses, one deals with Patents and is taught by an adjunct professor, a local patent lawyer. It is taught in alternate years with over ten students taking it. A few additional law schools across the country, possibly increasing in numbers due to the present-day "sex appeal" and glamour of patent law and practice, have such a survey-course pattern.

V. LAW SCHOOLS WITH PATENT LAW SPECIALIZATION

A. George Mason University School of Law

The George Mason University School of Law (George Mason) in Arlington, Virginia — first on a list of five "up and coming" U.S. law schools, published in U.S. News & World Report (March 19, 1990, p.60) — touts as its "contemporary approach to legal education" several areas or "tracks" of specialization, in addition to its day and evening division standard programs. One is the Patent Law Track which is a four-year evening division program "designed to provide students with a level of expertise usually found only in attorneys with post-J.D. study or several years of experience" (George Mason's Admissions Prospectus 1991, p.4).

The Patent Law Track is only for students with scientific or engineering training who intend to practice patent law.

For graduation 87 semester hours are required, with 22 in IP Law courses (of which 14 semester hours are patent-specific and 8 are in Unfair Trade Practices, Copyrights, and Trademarks), 40 in required Standard Program courses, and 25 in courses considered valuable for practice in most areas of law, and at the same time clearly of value for a career in Patent Law.

During their initial year in law school, Patent Law Track students take the same first-year courses that are required for the Standard Program Evening Division students.

The Patent Law courses are evenly distributed over the last three years of this four-year evening program. Three-fourths of the course work is outside Patent law ensuring that students "become well-rounded lawyers."

The detailed curriculum of the Patent Law Track is given as Annex VII. The course designations are self-explanatory, except for the fact that "Patent Law" covers the law of patents subsequent to issuance, "Patent Office Practice" deals with the procedure leading to issuance and "Advanced Topics in Patent Law" includes patent infringement law, interference practice and patent litigation damages.

The IP faculty is headed by George Mason University Foundation Professor Irving Kayton (formerly at George Washington in a similar capacity) and includes such part-time

lecturers in law as David Kera and Richard Schwab who practice in the Washington area.

Established by authority of the Virginia General Assembly in 1979, George Mason has about 700 students today.

B. The John Marshall Law School

The John Marshall Law School (John Marshall) of Chicago, Illinois is one of the largest independent law schools in the nation, with an enrollment of over 1,200 students.

John Marshall has a day and evening division as well as an eight-week summer session. In the evening division at least four years and one summer session are required for completion. The day division is standard. The requirements for the J.D. degree program are at least 90 semester hours. John Marshall also has two graduate programs: Taxation and IP requiring 24 semester hours or 21 semester hours and an independent study project to obtain an LL.M.

The faculty of the IP Division consists of Associate Professor Albert G. Tramposch as its Director and adjunct professors from the Chicago IP bar, i.e. local practitioners, e.g. Messrs. Louis Altman, John Crystal, Raymond Geraldson, Thomas Hoffmann, Donald Peterson, Leonard Rubin, etc.

According to its most recent brochure on its "Center for Intellectual Property Law", John Marshall offers one of only a few programs in the country dedicated solely to training lawyers and law students in U.S. IP law. "... [T]he Intellectual Property Division... offers J.D. candidates, LL.M. candidates, practicing attorneys and paralegals specialized training in all aspects of patent, trademark and copyright law, trade secrets, unfair competition and international intellectual property law."

Its J.D. and LL.M. Programs are described therein as follows:

> "After completion of their first year of required core courses, J.D. students may take classes in Patent and Trade Secret Law, Trademark and Copyright Law, IP Law and Practice, Unfair Competition and Trade Regulation, and Entertainment Law. Internships allow students to work with an IP law firm while studying in the program. LL.M. courses are also available to advanced J.D. students.
>
> ....
>
> John Marshall offers an advanced degree, Master of Laws in IP, for law school graduates who want to obtain specialized and advanced training in all aspects of intellectual property law.
>
> A comprehensive patent program is offered for students with a science or engineering background, including advanced courses in Substantive Patent Law, Patent Office Practice, Interference Practice, Patent Litigation, Technology Licensing and International Patent Law.

Trial Advocacy for Intellectual Property Attorneys trains students in trial techniques unique to patent cases.

The IP course offerings in the 1991 Spring Semester are attached as Annex VIII and a complete list of IP graduate courses including course descriptions is likewise attached as Annex IX.

C. The George Washington University

The National Law Center of the George Washington University (George Washington) has a J.D. degree program with day and evening divisions and a summer session as well as graduate (LL.M. and D.J.S.) programs. It has several specialized LL.M. programs, one of which is IP Law. Total student enrollment numbers over 1600.

According to the George Washington's 1990-91 Bulletin, the Patent Law Program, under the direction of Professor Donald W. Banner of the Washington firm of Banner, Birch, McKie & Beckett,

> "has been developed to offer as complete and as integrated a collection of courses in this field of law as possible. The program is one of the most extensive in the U.S. The object of the IP Law Program is to provide the student with a concentration in this field of law at a level of specialization and maturity that can enable advancement far more rapidly than usual in this field." (Bulletin, p.69)

The curriculum of the IP Law Program includes the following:

Licensing of IP Rights [2]
Chemical and Biotech Patent Practice [2]
Advanced Topics in Patent Law [2]
Interference Law and Practice [2]
Enforcement of Patent Rights [2]
Electronics and Computers: Patent Practice [2]
Foreign and Comparative Patent Law [2]

LL.M. candidates in the area of Patent Law "who have not taken the following courses or their equivalent as part of a (J.D.) program" are to include them in their LL.M. program:

Federal Antitrust Laws [3]
Trade Secret and Patent Law [3]
PTO Practice in Patent Matters [2]
Unfair Trade Practices [3]

In addition to the Director, Professor Banner, the IP law faculty includes as adjunct faculty, such patent attorneys of the D.C. area as Messrs. Brian Brunsvold, Lawrence Hefter, Maurice Klitzman, Rene Tegtmeyer, Harold Wegner, etc.

VI. FRANKLIN PIERCE LAW CENTER

A. An Innovator in Legal Education

Franklin Pierce Law Center (FPLC) began in 1973 as a small, pioneering law school and as New Hampshire's only law school.

Now FPLC has a faculty of over twenty full-time professors and twenty adjunct lecturers, a student body of close to 400 students (about 25% of whom specialize in patent or related IP law), and a record of innovations in training students to meet the challenges of practice.

As one of the leading institutions of Patent Law training in the U.S. today, FPLC differs from such other leaders as George Mason, John Marshall or George Washington. Instead of emphasizing advanced-degree or evening-school programs, it provides a well-rounded, full-time curriculum leading to the basic legal degree, the Juris Doctor (J.D.). FPLC is the only law school having more than one full-time professor who is a qualified patent attorney. FPLC, in fact, has five. In addition, the President and Founder of FPLC, Robert H. Rines is a practising patent attorney and an inventor with over 60 patents to his name.

As an innovator in legal education, FPLC emphasizes learning the essential skills for professional practice. As an example, for Patent Law law practice, the skills include preparing patent specifications and claims, negotiating and drafting licenses, and litigating patent controversies. As a result, FPLC graduates "hit the deck running" as patent lawyers.

The number of course credits at FPLC pertaining to Patent Law is higher than any other U.S. law school's offerings designed for J.D. degree students. The current list of courses, is as follows:

International Patent Law [2]
International Trade Regulation [2]
Legal Skills II — Patent Sections [2]
Licensing IP [3]
Patent Practice & Procedure I [2]
Patent Practice & Procedure II [2]
Proactive IP Management [2]
Science, Technology & Administrative Process [3]
Selected Topics in Patent Law I [2]
Selected Topics in Patent Law II [2]
Survey of IP [3]
Trial Advocacy — Patent Section [3]
Patent Litigation [2]
Description for the above courses are reproduced in Annex X.

This curriculum is enlarged through independent studies, externships (internships) and special seminars and lectures on patent subjects. One externship opportunity places students in Washington, DC for a full semester in the chambers of a judge of the CAFC, which has exclusive jurisdiction over appeals in patent litigation.

B. Master of Intellectual Property Degree

The Kenneth J. Germeshausen Center for the Law of Innovation and Entrepreneurship (Germeshausen Center), launched by FPLC in 1985, is the umbrella organization for FPLC's specialization and policy studies in the legal protection, management and transfer of IP, especially as they relate to the commercialization of technology. It designs and supports IP programs ranging from brief orientation sessions for foreign visitors to a six-week summer school, to a half-year-long or a year-long, full-time course of study leading to a Diploma or a Master of Intellectual Property (MIP) degree. These programs have been attended by administrators, practitioners and law students not only from virtually every state in the U.S., but also from every continent of the world.

The MIP has been created as a master level degree but not a graduate LL.M.-type law degree inasmuch as some students have technical backgrounds but do not have law degrees. For both foreign and U.S. nationals who do not need law degrees to become licensing experts, the Diploma and MIP Programs are very appropriate.

These programs are also appropriate domestically to help alleviate the serious shortage of patent professionals through "training individuals as patent agents for six months or one year," as suggested by the Long Term Planning Committee of the American Intellectual Property Law Association (AIPLA) in 1990. In fact, the 1990-91 MIP Class includes a domestic student from Massachusetts for the first time.

MIP Program participants spend two semesters at FPLC taking a thorough curriculum of academic courses, practical skills training and comparative law exposure. Subjects intensively treated are contract law, patents, technology licensing, trademarks, copyrights, trade secrets, the law of international trading and business relationships and international patent law. Skills instruction covers drafting patent claims, preparing patent applications, designing and drafting technology licenses, managing IP assets, and making legal arguments in mock patent litigation. In addition, students unfamiliar with the U.S. legal structure are introduced to it through special lectures as well as research and writing exercises.

The third MIP semester places foreign students for one month each at the USPTO in Washington, DC, in an patent law firm and in the patent department of an American corporation.

In July 1990 the New Hampshire Postsecondary Education Commission extended indefinitely into the future the authority of FPLC to confer the MIP degree, after an initial

three-year approval subject to annual reporting requirements. The extension was based on the report of an evaluation team appointed by the Commission. The report cited the "extremely impressive" MIP Program as occupying a "unique niche in legal education worldwide."

In a WIPO/ATRIP (International Association for the Advancement of Teaching and Research in IP) Symposium in San Jose, Costa Rica, September 1990, Professor Stanislaw Soltysinski, Mickiewicz University, Poznan, Poland, gave a description of FPLC's MIP Program, recognized it as "unique" and recommended its "transplantation" elsewhere in his lecture entitled "Planning of Special Studies on the Protection of Industrial Creations."

The MIP Program began in August 1986 with ten students and over the ensuing years students completing the MIP Programs came from Argentina, Belgium, Guatemala, Italy, Japan, Korea, Mexico, New Zealand, Pakistan, the PRC, Peru, Saudi Arabia, Tanzania, Taiwan, Venezuela, and Zimbabwe.

FPLC also offers a shortened, one-semester Diploma Program for applicants who cannot spend an entire year in residence. The six-month Diploma Program includes the same courses as required in the first semester of the MIP Program; upon completion of the semester, participants take part in a one-month internship at a single U.S. institution.

C. Intellectual Property Summer Institute (IPSI)

FPLC also offers short courses each summer in IP subjects for law students, lawyers, engineers, scientists and managers. The IPSI offers a six-week program in June and July comprising two-credit courses on Patent and Trade Secret Law, Patent Practice and Procedure, Licensing/Technology Transfer, Trademarks, and Copyrights. In addition, a weekly luncheon seminar on Current Issues in IP brings together IPSI students on an informal basis.

With the permission of their home schools, law students can apply credits earned in the IPSI toward the J.D. degree. In addition to students from law schools not having extensive offerings in IP subjects, participants in the IPSI have come from major U.S. corporations and research institutes as well as such foreign countries as Brazil, Canada, Columbia, Jamaica, Japan, the Netherlands, Paraguay, Peru, Spain, Switzerland, Taiwan, Venezuela and Yugoslavia.

D. Joint JD/MIP Degree Program

In late October 1990 the Law Center faculty approved a program allowing Juris Doctor degree students to earn both the JD and MIP degrees in a total of three and one-half years or even in three years of full-time study. Twenty second- and third-year students have already enrolled.

The joint degree program will permit FPLC students to obtain both degrees by satisfactorily completing 96 course credits (including 24 in IP courses, in which a B

average must be maintained) and a substantial paper. The paper, to be designed and prepared under close faculty supervision, is the equivalent in the MIP program as a professional degree curriculum of a master degree thesis in an academic degree curriculum. Each paper is to respond to a demonstrated need arising in the administration or practice of IP law for legal or empirical research, policy development, critical analysis, or insightful synthesis.

The rationale behind the JD/MIP degree program is threefold. First, a student who comes to FPLC to specialize in IP within the parameters of the JD degree finds herself or himself in a squeeze. Enrolling in all or most of the IP courses the school offers leaves the student insufficient time to take the general law courses (including all the ones important in IP practice) that they should take or would like to take. Conversely, students who take the general law courses other JD students take may shortchange themselves by electing less than the full complement of IP courses.

Second, the IP curriculum — over 30 credits — is so extensive as in reality to amount to a separate degree program, especially when joined with the requirement of completing a substantial, professionally-valuable paper. Many of the FPLC IP courses could be offered at the LL.M. level, as is done in other law schools. Third, earning the MIP as well as the JD degree provides students with accurate credentials. Earning both degrees permits them to demonstrate readily, to potential employers and the rest of the world, that specialization in IP at FPLC means much more than, on the one hand, a few courses in the subject or, on the other, a sketchy general legal education.

Graduates from other law schools will also be able to take advantage of the combined degree program. They can apply toward the 24 credits required for the MIP degree up to 12 IP and IP-related credits earned earlier in their JD degree education.

E. Benchmark Alternatives (BMA)

The gulf between legal education and legal practice, discussed above in Chapter II, is in fact getting wider, notwithstanding clinical-skills programs, as some elite law schools have tried to emulate graduate schools in emphasizing academic research and writing.

In contrast to this trend, the FPLC faculty is asking questions such as the following: Does the proposed program or course address a real-world issue or concern that legal education isn't adequately addressing? Does it relate to what is going on out in the practical world instead of relating primarily to academic exchanges? Will it improve the education of our students in helping them become more thoughtful, aware, skillful, and humane lawyers? Should the primary responsibility of the full-time faculty be individual growth of our students as legally-trained persons? These questions aim at the greatest weakness in the structure of American legal education — the failure of anyone to be charged with responsibility for training a person who shortly will be licensed to make a major impact on individuals and society under the cloak of professional responsibility.

A practice-oriented individualized learning [IL] program as a BMA to academic research and writing can encompass a variety of steps and things, such as, in particular, "intensive semesters" and "bridging semesters".

An example of the latter is the "Proactive IP Management" course which I teach in the sixth semester and which is designed as a "capstone" course building on all of the IP courses taken in the second and third years, and a "bridging" (or "exit" or "transition") course spanning academia and real-life private or corporate practice. As such, it is a very practical course on how to get a headstart in patent/licensing practice.

VII. CASE ANALYSIS TEACHING METHOD

The Socratic method with its use of casebooks, which reigned supreme for many decades, has come under attack but has survived albeit in modified form. Some type of discussion method with students actively involved is now widely employed in preference to a pure lecture system of teaching. After all, "participants of advanced programs are eager to participate actively in classes and seminars," as was stated by Professor Soltysinski (*supra*, p.13).

According to Professor Glenn E. Weston a "problem method" of teaching has taken hold:

> "Some Professors use the method entirely by giving students a series of hypothetical problems to which the students are required to supply either written solutions or to give their solutions orally in a classroom discussion of the problems. This type of teaching is also used as an adjunct to the Casebook system. It works best with small classes of less than 100 and, preferably, not more than 75.
>
> ....
>
> The principal drawbacks of use of the problem method of teaching are that problems require a great deal of the professor's time to prepare, supervise and evaluate. They also require a great deal of class time, making it difficult to cover all of the subject matter of the course. But a selective use of the problem method is a very effective teaching technique." (Paper delivered at WIPO/ATRIP Symposium in San Jose, September 1990, p.9.)

The problem method was also strongly endorsed by Professor Charles R. McManis, School of Law, Washington University, St. Louis, Missouri. "Beyond the first year of law school .... the case method is simply not a particularly efficient and effective method for analyzing the complex statutory schemes (e.g. IP legislation) that predominate in the second and third year of law study." (McManis, WIPO/ATRIP Presentation,

Geneva, July 1989, p.5).

Indeed, in teaching patent courses with manageable student enrollment the problem method is a very good one. Instead of hypothetical problems, I am able to use actual real-life problems culled from experience. In fact, sometimes my "hypothetical" problems are camouflaged actual problems. The drawbacks of the problem method as perceived by Professor Weston are outweighed in my view by the effectiveness of this technique, especially in a practice-oriented approach aimed at "bridging" academia and post-graduation practice and at enabling students to "hit the deck running."

VIII. CONCLUSION

The advent of the Golden Age for patents and the severe shortage of patent professionals, have brought about great changes in the world of Patent Law teaching and training. The subject of patents is now perceived as glamorous and enrollment in patent courses of study and programs has increased accordingly. While in the not-too-distant past, most patent practitioners had to acquire their skills on the job, many law schools now offer at least one or more survey courses and have one full-time IP professor among the faculty. A very small number of law schools — too few — have started or expanded their IP curricula and now offer over 20, or, as in the case of FPLC 35 IP credit hours. Outside of law schools no systematic patent teaching to speak of (apart from introductory lectures) takes place in colleges and universities.

In law schools, the first year is composed of certain basic required courses devoted to the study of judicial cases concerned with general public and private law subjects, such as constitutional law, criminal law and procedure, and the various civil law and procedure subjects concerned with enforcing private contractual, personal and property rights and providing compensation for civil wrongs, and more complex statutory or administrative law subjects (including intellectual property law) that build on these basic courses, are offered as elective subjects in the second or third year of law school.

Law schools noted for their patent specialization or concentration, apart from FPLC, are George Mason University School of Law, John Marshall Law School, George Washington University National Law Center. Most patent law teaching is still largely a matter of evening classes taught by adjunct faculty, that is, local patent attorneys. But changes are afoot in this respect, too. These law schools also tend to have graduate master-level programs as, for example, LL.M. degree programs.

FPLC has a particularly extensive patent IP specialization with a full-time patent faculty of five and 35 IP course credits. The patent program is practice-oriented and involves the actual preparation of patent specifications and claims, of responses and appeal briefs and of license agreements which enables students to take and pass the USPTO admission examination and enables graduates to "hit the deck running" upon entering patent practice.

The graduate program at FPLC, the MIP Program, is also different — in fact its been acclaimed as "unique" — because non-lawyers from the U.S. and from many foreign countries are admitted to it. Most recently, FPLC has started a joint JD/MIP degree program which will permit students to obtain both degrees simultaneously or almost simultaneously provided the requirements regarding more course credits, higher grade average and preparation of a paper are fulfilled.

In the area of teaching methods, syllabi and aids, the traditional casebook method has given way to the problem method of teaching which is particularly suitable for teaching patent law courses. In addition, FPLC has enhanced its practice-oriented approach by such additional innovative features as "bridging semester" courses to span academia and post-graduation practice.

KFJ/Ruh/10.11.91

ANNEX I

USPTO
Approved Scientific/Technical Subjects

- Biology
- Biochemistry
- Botany
- Electronics
- Technology
- Engineering —
  - Aeronautical
  - Agricultural
  - Biomedical
  - Ceramic
  - [Electro]chemical
  - Civil
  - Computer
  - Electrical
  - Engineering Physics
  - Geological
  - Industrial
  - Mechanical
  - Metallurgical
  - Mining
  - Nuclear
  - Petroleum
- Food Technology
- General Chemistry
- Marine Technology
- Microbiology
- Molecular Biology
- Organic Chemistry
- Pharmacology
- Physics
- Textile Technology

ANNEX II

CREDOS

- An effective IP system is indispensable to technological development which leads to economic growth and social welfare;
- an IP system should be part of a country's infrastructure from the outset rather than something that one thinks about after reaching a fairly advanced stage of development (Robert Sherwood);
- "A country without a patent office and good patent laws is just like a crab that can't travel any way but sideways or backways" (Mark Twain);
- a patent and other IP are property and are not and cannot be monopolies (a patent does not take from the public and give to the individual; it takes from the individual and gives to the public) and this misconception has caused a lot of mischief;
- stringent application of provisions for compulsory licenses, cancellation for non-working, exclusion of importation from infringement thwart a patent law and turn it into a hoax;
- lead times for commercializing inventions have become longer in all areas and not just the pharmaceutical area and hence the conventional periods of three or four years till lapsing or compulsory licensing are badly out of step with present realities;
- "Everything under the sun made by man is patentable" (U.S. Supreme Court in the Chakrabary decision); hence, there should virtually be no exclusions of subject matter from patentability;
- subject matter that is viewed as too important to be protected is, on the contrary, "too important not to be protected" (Professor Thomas Field);
- some countries have gold, some have oil — and some have technology and those that have gold and oil do not consider them part of the "common heritage of mankind" and accordingly give them away for free (Naboth Mvere, Controller of IP, Zimbabwe);
- technology transfers, licensing and investments are ever so much easier to carry out and accomplish via patents and other IP as vehicles or bases;
- the days when technology transferors took advantage of transferees in developing countries are gone, the realization having taken hold that the only viable license is one that results from a win/win approach and passes the fairness test.

ANNEX III

CUSHMAN, DARBY & CUSHMAN

ADVANCED PATENT SEMINAR

1990

Date	Topic		Lecturer
May 7, 1990	Welcome		
	I.	Overview of U.S. Patent Prosecution	Chris Comuntzis
May 8, 1990	II.	Claim Drafting	Glenn J. Perry
May 9, 1990	III.	Selected Aspects of Advanced Claim Drafting, Construction and Integration	Dale S. Lazar
May 10, 1990	IV.	Filing Foreign Origin Applications	G. Lloyd Knight
	V.	Double Patent and Restriction	Nancy J. Linck
May 11, 1990	VI.	Responding to Official Actions	Kendrew H. Colton
May 14, 1990	VII.	Affidavits	Larry A. Hymo
	VIII.	Final Rejections and Continuations	Joerg-Uwe Szipl
May 15, 1990	IX.	Interview and Mock Interview	Glenn J. Perry Dale S. Lazar
	X.	Priority and Inventorship	Diane W. Fitzcharles
May 16, 1990	XI.	Appeals to the PTO Board of Board of Appeals and Interferences and Beyond	Glenn J. Perry William T. Bullinger
	XII.	Interference Practice	Watson T. Scott
May 17, 1990	XIII.	Reissue	Scott C. Harris
	XIV.	Reexamination	Michelle N. Lester
May 18, 1990	XV.	European Patent Practice	David Harrison
May 19-20, 1990		Williamsburg Trip	

May 21, 1990	XVI.	British Patent Practice	David Hartley
May 22, 1990	XVII.	Canadian Patent Practice	Jean Dubuc
May 23, 1990	XVIII.	A Look at PCT	G. Lloyd Knight
May 24, 1990	XIX.	Computers and Computer Software-Patents, Copyrights and Trademarks	Dale S. Lazar
	XX.	Legal Protection for Semiconductor Chip Design	David A. Jakopin
May 25, 1990	XXI.	Protection of Inventions In Biotechnology	Paul E. White
	XXII.	Duty of Candor and Disclosure	G. Lloyd Knight
May 28, 1990	XXIII.	Trademarks	Richard L. Kirkpatrick
May 29, 1990	XXIV.	Design Patent Protection	David W. Brinkman
	XXV.	Copyright Protection	David W. Brinkman
May 30, 1990	XXVI.	Patent Litigation	Peter W. Gowdey
May 31, 1990	XXVII.	Licensing, Patent Misuse and Antitrust	Stephen L. Sulzer Arthur Wineburg
June 1, 1990	XXVIII.	International Trade Commission	Marcia H. Sundeen
	XXIX.	Final Exam	

ANNEX IV

Dickinson School of Law

LAW FIRM SCHEDULE PATENTS PROF. KEATING

Jan. 14 - Introduction - Course Objectives (Amended 1/28/91)

Jan. 17 - Distinction between Patents, Trademarks & Copyright
Statutory classes of patentable invention

Jan. 21 - Definition of patentable invention; prior art

Jan. 24 - Definition of "non-obviousness"
Jan. 24 - Case: Hotchkiss v. Greenwood (p. 36)

Jan. 28 - Basis for denying the grant of a patent

Jan. 31 - Components of a patent application
Jan. 31 - Case: A & P v. Supermarket Corp. (p. 61)
Law Firm: Jay Di Marino Susan Sciamanna

Feb. 4 - Interviewing client

Feb. 7 - Selecting and cooperating with patent attorney
Feb. 7 - Case: Graham v. John Deere (p. 73)
Law Firm: Steve Gray Tom Finn

Feb. 11 - Prosecution of a patent application

Feb. 14 - Prosecution of a patent application (cont.)
Feb. 14 - Case: Calmar v. Cook (p. 99)
Law Firm: Clark Hering, Liane Lazzari

Feb. 18 & 21 RECESS

Feb. 25 - Appeal from refusal to grant a patent

Feb. 28 - Managing a patent portfolio
Feb. 28 - Case: U. S. v. Adams (p. 111)
Law Firm: William Goldman Fiona Line

~~Mar. 1 - Managing a patent portfolio (corporation)~~

Mar. 4 - Counseling independent inventors
Mar. 7 - Patent Interference Practice
Mar. 7 - Cases: Pavement Salvage v. Anderson Black Rock (p. 123)
Anderson Black Rock v. Pavement Salvage (p. 129)
Law Firm: Suzanne McGrath-Dale
Cheryl Gordon

Mar. 11 - Patent Interference Practice (continued)

Mar. 14 - Patent Litigation
Mar. 14 - Case: Diamond v. Chakrabarty (p. 156)
Law Firm: Kimberly Kardelis Sandra Bein

(over)

Mar. 18 - Patent Litigation (continued)

Mar. 21 - Patent Ownership (employed inventors) & conveyance
Mar. 21 - Case: DuPont v. American Potash
Law Firm: Patrick Murphy Maryellen Sheehan

Mar. 25 - Submission of invention by non-employees

Mar. 28 - Trade Secrets
Mar. 28 - Case: Kewanee v. Bicron
Law Firm: Tara Mucha Maureen Calder

Apr. 1 & 4 RECESS

Apr. 8 - Trade Secrets (continued)

Apr. 11- - Patent Licensing
Apr. 11 - Case: Aronson v. Quick Point
Law Firm: Pat Hickey Katherine Rodosky

Apr. 15 - Patent Licensing (continued)

Apr. 18 - Patent Licensing (continued)
Apr. 18 - Case: Brulotte v. Thys
Law Firm: Catherine Bonin
Mark Lacotta

Apr. 22. - Speaker: John Larue, Esq., AMP Inc.

Apr. 25. - Patents and antitrust
Apr. 25 - Case: Morton Salt v. Suppiger and
Walker Process v. FMC
Law Firm: Thomas Cummings Brett Davis
Apr. 29 - International Patents

May 2 - Open

EXAM - Wed. May 15 - 8:30 am

LAW FIRM GUIDELINES

The purpose of the law firm presentation is to stimulate discussion by the class. Students may use any suitable format (within the bounds of good taste) to encourage discussion. Emphasis should be directed toward the importance of the case, opposing points of view and what changes in the facts would change the result. At least one member of the law firm will meet with me prior to the presentation. Material to be distributed should be given to me at least two days before the presentation.

ANNEX V

Baltimore School of Law

Law 902 — Basic Course 1 — Fall Semester
Patents, Trademarks and Technology — 3 credits

Introduction to product image and technology protection and utilization, including computer law. Basic principles and application of trade secrets, employment agreements, research and development proposals, patents. Semiconductor Chip Protection Act, trademarks, tradenames, unfair competition, licensing practices, antitrust considerations for technology transfer, and enforcement procedures, including litigation.

Law 901 — Seminar — Spring Semester
Patent, Copyright and Trademark Law — 3 credits

Advanced study concerning current problems in patent, trademark, trade secret and copyright law. The course includes an analysis of the interrelationship of these areas, and the effectiveness of controls that are designed to prevent misuses of these rights. Each student is to prepare and present a paper concerning at least one of these four areas of IP law.

ANNEX VI

PATENT, COPYRIGHT AND TRADEMARK SEMINAR
U OF B SCHOOL OF LAW
SPRING 1991
PROFESSOR FRYER

TENTATIVE SCHEDULE

Date	Topic
1/14/91	Session 1 Topic: Course Introduction Session 2 Topic: Trademark Surveys - Part I
1/21/91	NO CLASS - HOLIDAY
1/28/91	Session 1 Topic: Trademark Surveys - Part II Session 2 Topic: Research Topics Discussion
2/4/91	Sessions 1 and 2 topic: Review of significant, recent cases, laws and legislation.
2/11/91	Students turn in written description of research topic for approval, and list initial, anticipated research sources. This paper will be turned in at the beginning of class.
	Sessions 1 and 2 Topic: Role playing of Simulated Patent Law Harmonization Diplomatic Conference (real one to be held on June 3 - 28 at the Hague; we will used the same documents and represent the various political groups, EC, US, Japan, Third World, and non-governmental organizations). It is expected that several guests will participate who are interested in this topic.
2/18/91	Sessions 1 and 2 Topic: Continue Patent Law Harmonization Simulated Diplomatic Conference.
2/25/91	Sessions 1 and 2 Topic: Copyright law - Teachers' Right to Reproduce Copyrighted Material for Classroom Use Now that US is a Member of Berne. It is expected that University and State Attorney General representatives will be present.
3/4/91	Sessions 1 and 2 Topic: Trademark Dilution. There will be a debate on whether a State and/or the Federal Government should Adopt

a dilution statute.

3/11/91 — Sessions 1 and 2 Topics: A Practical Exercise on Negotiating Transfer of Technology Agreements. This class will be conducted by Charles E. Yocum, patent attorney, Black & Decker Corp. (U of B Law School graduate). He introduces this topic by asking the question "[why] do trade secrets give me more gray hairs than any intellectual property?"

Each student will submit a written outline of their research paper. The professor will review it and may set up conferences this week to discussion the research paper work. This outline will be submitted at the beginning of the class.

3/18/91 — NO CLASS - SPRING BREAK

3/25/91 — Sessions 1 and 2 Topic: Genetic Engineering and Intellectual Property, including Farmers' Right to Reproduce Patented Animals (Congressional legislation). Guests are expected who will contribute to this discussion.

4/1/91 — NO CLASS - STUDENTS WILL WORK ON THEIR PAPERS

4/8/91 — Sessions 1 and 2 Topics: Student Research Papers Oral Presentations (20 minutes per student, approximately).

4/15/91 — Sessions 1 and 2 Topics: Same as 4/8/91.

4/22/91 — Sessions 1 and 2 Topics: Same as 4/8/91

4/29/91 — NO CLASS

Each student will have a conference with the professor this week to discuss the research paper. The research paper will be turned in prior to the conference, to allow sufficient time for the professor to review it. The research paper must be completed by the end of this week, unless other arrangements are made with the Professor.

NO FINAL EXAM

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PATENT, COPYRIGHT AND TRADEMARK SEMINAR
UNIVERSITY OF BALTIMORE SCHOOL OF LAW
1/18/91
PROFESSOR FRYER

ASSIGNMENT FOR CURRENT IP DEVELOPMENTS CLASS ON 2/4/91

General Note: Each case will have two students preparing it, one examining the plaintiff's side and the other the defendant's side. These students can work together and decide how to present the case. There will be 2 or 3 students reporting on each of the new laws. Students are encouraged to do some further reading to prepare their oral presentations (no written report is required). A handout or blackboard diagram may help present the topic. Student should indicate selection of topic on the sign-up sheet. The case presentations will be approximately 15 minutes and the new law presentations will be approximately 30 minutes. Each student should prepare an explanation of the topic that lasts about 5 minutes. There will be time for questions and the students presenting the topic should be prepared to answer them.

Session 1 - Computer Software

1. New law - computer software rental
Resources (handed out to all students): See 41 BNA-PTCJ 5 (11/1/90) for legislative history summary; see 41 BNA-PTCJ 18-20 (11/1/90) for Congressman Kastenmeier's statement on the legislation; see 40 BNA-PTCJ 548 - 554 (10/25/90) for the statute [bill S198 (101 Cong., 2nd sess.) corresponds in all respects to the enacted law, except for a provision on coin-operated video games].
Special Note: Explain the significance of the new law, including how software owners will take advantage of it and any problems they may have in applying the law.

2. Patent and computer program related cases
In re Grams, 888 F.2d 835, 12 USPQ2d 1824 (Fed. Cir. 1989);
In re Iwahashi, 888 F.2d 835, 12 USPQ2d 1908 (Fed. Cir. 1989).
Special Note: Compare these cases on the issue of statutory subject matter protection under the patent law for computer programs.

3. Trade secret and computer program related case
Otis Elevator Co. v. intelligent Systems, Inc., Superior Court of Conn. 1990 (found only on Lexis). The Lexis case numbers are 147 and 1689.
Special Note: Review the issue of what standard of care should be used in protecting computer software.

Session 2 - Other Intellectual Property

4. Trademark - protection of fragrance
In re Celia Clark (TTAB 1990). This case is only on Lexis. The Lexis number is 53.
Special Note: What is the criteria for trademark protection of fragrance.?

5. New law - Copyright protection of architectural works
Resources: Same as item 1 above resources.

6. New law - Moral rights
Resources: Same as item 1 above.

ANNEX VII

George Mason University
School of Law

Patent Law Track
(Evening Division Only)

First Year	
Fall	
Legal Research, Writing, and Analysis I	1
Contracts I	3
Property I	3
Quantitative Methods I	4
	11
Spring	
Contracts II	3
Property II	2
Constitutional Law	4
Quantitative Methods II	2
	11
Second Year	
Fall	
Legal Research, Writing, and Analysis II	2
Criminal Law	3
Torts	4
Patent Law	2
	11
Spring	
Civil Procedure I	4
Patent Office Practice	2
Copyrights	3
	9
Third Year	
Fall	
Civil Procedure II	2
Evidence & Trial Procedure	3
Antitrust	3
Trademark Law	2
Advanced Topics in Patent Law	2
	12
Spring	
Administrative Law	3
Trusts and Estates	3
Unfair Trade Practices	3
+Chemical Patent Practice OR	
+Electronics & Computer Patent & Copyright Practice	2
	11
Fourth Year	
Fall	
Business Associations	4
Commercial Paper	3
Professional Responsibility	2
+Patent & Copyright Litigation in Electronics & Computer Cases OR	
+Patent Litigation in Chemical Cases	2
	11
Spring	
Income Taxation	4
Conflict of Laws	3
Patent & Know-How Licensing	2
+Appeals from Patent Trials & Patent Office Proceedings OR	
+Biotechnology Patent Practice	2
	11

(+) Denotes elective courses.

1991 Spring Semester January 14 - May 9, 1991

All classes meet from 6:00 to 9:00 p.m. unless otherwise indicated. All classes subject to change.

IP 401
SUBSTANTIVE PATENT LAW II (3)
Prerequisite: IP 400 **
James A. Scheer
Welsh & Katz, Ltd.
Scope and construction of patents, infringement; contributory infringement; inducement to infringe; unenforceability defenses; jurisdiction in patent infringement and related actions; relief in patent infringement actions.
Tuesdays 1/15-4/30; exam 5/14

IP 407
INTELLECTUAL PROPERTY LICENSING (2)
Jack Shore
Dressler, Goldsmith, Shore, Sutker & Milnamow, Ltd.
Licensing strategy, implied licenses, express licenses, licensing provisions for patent, trademark and knowhow licenses, enforcement of license provisions, title interests in intellectual property and their transfer.
Wednesdays 1/16-3/20; exam 4/3

IP 408
PATENT LITIGATION (2)
Prerequisites: IP 400 and IP 401 **
Donald A. Peterson
Neuman, Williams, Anderson & Olson
Preliminary considerations in patent litigation including jurisdiction, venue, and potential relief; the pleadings; pretrial activities, including discovery; the trial, including witness and evidence considerations; injunctive and damage remedies; and appellate procedures.
Thursdays 1/17-3/21; exam 4/4

IP 409
TRADEMARK LITIGATION (2)
Prerequisite: IP 403 **
Raymond I. Geraldson, Jr.
Mark Partridge
Pattishall, McAuliffe, Newbury, Hilliard & Geraldson
Trademark litigation in Federal Court and before the Trademark Trial and Appeal Board; preliminary considerations, including, jurisdiction, venue, forum selection and potential relief; pleadings and motion practice; pretrial activities, including discovery; evidentiary considerations, including, experts and surveys; trial and appellate procedures; and settlement considerations.
Mondays 1/14-3/18; exam 4/1

IP 411
ANTITRUST AND MISUSE ASPECTS OF INTELLECTUAL PROPERTY (3)
Louis Altman
Laff, Whitesel, Conte & Saret
The Sherman Act, the Clayton Act, and the "Misuse Doctrine" as applicable to the acquisition, enforcement, and licensing of patents, trademarks, copyrights, and "know-how."
Thursdays 1/17-4/25: exam 5/9

IP 412
TAXATION OF INTELLECTUAL PROPERTY (1)
Thomas B. Lindgren
Federal tax law as it applies to patents, trademarks, copyrights, and "know-how." Consideration will be given to federal tax treatment of development and acquisition expenditures, proceeds from licensing and transfers, litigation expenses and recoveries, and evaluations.
Wednesdays 4/10-5/8; exam 5/15

IP 425
ART LAW (1)
E. Leonard Rubin
Willian Brinks Olds Hofer Gilson & Lione
Legal and practical concepts relating to protection, acquisition, exhibition and sale of works of art, including problems regarding art censorship, moral rights, endowments, tax implications, etc.
Tuesdays 4/9-5/7; exam 5/14

IP 426
SPORTS LAW (2)
E. Leonard Rubin
Willian Brinks Olds Hofer Gilson & Lione
Professional sports leagues and players; relationships, rights, options, free agency, drafts, player negotiations, arbitration, antitrust. Sports as entertainment, rules governing agents and college athletes.
Tuesdays 1/15-3/19; exam 4/2

IP 429B
MASTER CLASS IN INTELLECTUAL PROPERTY LAW (1)
[To Be Announced]

IP 431
INDEPENDENT STUDY (2 OR 3)
Albert Tramposch, Director
The undertaking of a project approved by the Director of the Division requiring scholarly independent study which will result in a significant contribution to the law of Intellectual Property.

IP 432
DISSERTATION (3)
Albert Tramposch, Director

IP 433
CLINICAL LEGAL EDUCATION IN INTELLECTUAL PROPERTY LAW (2)
Albert Tramposch, Director
Students selected to participate in this program work with intellectual property attorneys in private and corporate practice approved by the law school. The student will receive either a "pass" or "fail" grade based upon an evaluation of the student's work.

** Prerequisites may be waived only by written permission of the Instructor

1 Course Descriptions: Master of Laws Degree

INTELLECTUAL PROPERTY DIVISION
INTELLECTUAL PROPERTY 400
SUBSTANTIVE PATENT LAW I (3)

Prerequisite: Patent and Trade Secret Law or acceptance for LL.M. in Intellectual Property Law or waiver thereof based upon equivalent in academic credits or practical experience.

Not open to students who have taken IP 415 Law of Patents.

A study of the modern law of patentability and patent validity fundamentals with emphasis on the impact of the Patent Act of 1952 and modern Supreme Court and Federal Court cases. Controlling case law is analyzed in depth on statutory categories (35 U.S.C. 101), and novelty, utility, and unobviousness as conditions of patentability (35 U.S.C. 101, 102, and 103). Prior art and loss of right acts under 35 U.S.C. 102 and their relevance to patentability under 103 are thoroughly covered. Consideration is given to the substantive aspects of the disclosure and claiming requirements (35 U.S.C. 112). General requirements for obtaining Design Patents, Plant Patents and Plant Variety Protection Act (PVPA) certificates are addressed.

INTELLECTUAL PROPERTY 401
SUBSTANTIVE PATENT LAW II (3)

Prerequisite: IP 400 **

Scope and construction of patents, infringement; contributory infringement; inducement to infringe; unenforceability defenses; jurisdiction in patent infringement and related actions; relief in patent infringement actions.

INTELLECTUAL PROPERTY 402
PATENT OFFICE PRACTICE (3)

Prerequisite: IP 400 or IP 401 **

The formal requirements of the patent application, communications from the Examiner, requirements for restriction, rejection of applications and claims, interviews, appeal, certificates of correction, reissues, and other aspects of proceedings before the Patent and Trademark Office. This course includes a treatment of the art of preparing patent applications, including the drafting of claims.

INTELLECTUAL PROPERTY 403
TRADEMARK LAW AND PRACTICE (3)

The historical development and nature of trademark law; creation and maintenance of trademark rights; trademark registration and administrative proceedings; loss of trademark rights; infringement of trademark rights; proof of infringement; special defenses and limitations; unfair competition law; juriscition and remedies.

INTELLECTUAL PROPERTY 404
ANTITRUST (3)

Restraint of trade under the common law; the Sherman Act, Federal Trade Commission Act and State Anti-Trust Laws; agreements, combinations, and conspiracy in restraint of trade; monopolization under the Sherman Act; mergers under Section 7 of the Clayton Act; refusals to deal in relation to the antitrust law; exclusive dealing under the Sherman and Clayton Acts; tying clauses; criminal and civil enforcement proceedings.

INTELLECTUAL PROPERTY 405
INTERFERENCE PRACTICE (1)

Prerequisites: IP 400 and IP 401 **

Theory of interferences; affidavits under Patent Office Rule 202; setting up interferences; preliminary statements, motion period; hearings, review and determination of motions; form of testimony; testimony period and procedure; discovery; final hearing; review of interference decisions; proof (including corroboration) requirements; estopple issues, law of priority.

INTELLECTUAL PROPERTY LAW 406
COPYRIGHT LAW AND PRACTICE (3)

Scope and applicability of U.S. copyright law, including review of: those portions of the 1909 Copyright Act that continue in force; the 1976 Copyright Act now in effect; and the 1988 Berne Convention Implementation Act as it affects both domestic and foreign copyrights in the United States.

INTELLECTUAL PROPERTY 434
CLINICAL EDUCATION IN INTELLECTUAL PROPERTY LAW (2)

Students selected to participate in this program work with intellectual property attorneys in private and corporate practice approved by the law school. The student will receive either a "pass" or "fail" grade based upon an evaluation of the student's work.

** Prerequisites may be waived only by written permission of the Director.

INTELLECTUAL PROPERTY 407
TECHNOLOGY CONTRACTS (2)

Implied licenses, express licenses, enforcement of license provisions, title interest in intellectual property and their transfer.

INTELLECTUAL PROPERTY 408
PATENT LITIGATION (2)

Prerequisites: IP 400 and IP 401 **

Preliminary considerations in patent litigation including jurisdiction, venue, and potential relief; the pleadings; pretrial activities, including discovery; the trial, including witness and evidence considerations; injunctive and damage remedies; and appellate procedures.

INTELLECTUAL PROPERTY 409
TRADEMARK LITIGATION (2)

Prerequisite: IP 403 **

Preliminary considerations in trademark litigation including jurisdiction, venue and potential relief; the pleadings; pretrial activities including discovery; the trial, including witness and evidence considerations; and appellate procedures.

INTELLECTUAL PROPERTY 410
PRICING REGULATION (2)

Federal and state regulation of price discrimination; promotional allowance and service discrimination; buyer's liability for inducement of discriminatory prices, services, and allowances; predatory pricing and below-cost selling; legal relationships with brokers and manufacturers representatives.

INTELLECTUAL PROPERTY 411
ANTITRUST AND MISUSE ASPECTS OF INTELLECTUAL PROPERTY (3)

The Sherman Act, the Clayton Act, and the "Misuse Doctrine" as applicable to the acquisition, enforcement, and licensing of patents, trademarks, copyrights, and "know-how."

INTELLECTUAL PROPERTY 412
TAXATION OF INTELLECTUAL PROPERTY (1)

Federal tax law as it applies to patents, trademarks, copyrights, and "know-how." Consideration will be given to federal tax treatment of development and acquisition expenditures, proceeds from licensing and transfers, litigation expenses and recoveries, and evaluations.

INTELLECTUAL PROPERTY 413
INTERNATIONAL PATENT LAW (2)

Prerequisite: IP 400 **

The Paris Convention and its revisions, the Patent Cooperation Convention, review of principal foreign patent systems including the European Patent Convention; approaches to obtaining patent protection and enforcement in foreign countries, etc.

INTELLECTUAL PROPERTY 414
INTERNATIONAL TRADEMARK LAW (1)

Prerequisite: IP 403 **

Study of foreign trademark and unfair competition practice including selection, searching, filing, prosecution, renewals, licensing, assignments, watching, opposition, cancellation, infringement, use, marking, and review of existing and proposed international treaties, including European Trademark, Madrid Arrangement, and Pan American Convention.

INTELLECTUAL PROPERTY 415
LAW OF PATENTS (1)

Not open to students who have taken IP 400 Substantive Patent Law I and IP 401 Sunstantive Patent Law II.

A survey of concepts and terminology of American patent law designed for the degree candidate who has no intention of prosecuting patent applications before the United States Patent and Trademark Office. Emphasis is placed on the distinctions between patents and other forms of intellectual property.

INTELLECTUAL PROPERTY 416
INTERNATIONAL ANTITRUST ISSUES (1)

Prerequisite: IP 404, IP 413 & IP 414 **

The developing antitrust laws relating to patents and trademarks in Europe and the Pacific Rim countries. A look at a unified EEC after 1992.

** Prerequisites may be waived only by written permission of the Director.

INTELLECTUAL PROPERTY 417
ADVERTISING COMPLIANCE LAW (2)

Advertising litigation under the Lanham Act; private, state and local public remedies for consumer protection against deceptive advertising, FTC regulation of deceptive advertising and consumer protection, consumer protection under other federal statutes.

INTELLECTUAL PROPERTY 418
BUSINESS FRANCHISE LAW AND PRACTICE (2)

This course provides a theoretical foundation appropriate to representation of clients in a number of the situations peculiar to business franchise systems and operations. Federal and state statutes, regulations and cases are examined. Particular attention is given to: procedures, documents and disclosures required to comply with restrictions upon and conditions precedent to the establishing of business franchise systems; and legal limits on franchisors and franchisees relative to terminations and non-renewals of individual franchises in business franchise systems.

INTELLECTUAL PROPERTY 419
ENTERTAINMENT LAW (2)

A concentrated review of the areas of law most often involved in entertainment litigation, including: copyright, defamation, privacy, publicity and unfair competiton, and their applicability to the principal areas of the entertainment industry. The course includes synopses of the practical workings of the principal entertainment media, including: music, broadcasting, theater, motion pictures, publishing and sports.

INTELLECTUAL PROPERTY 420
CONTEMPORARY PROBLEMS IN COMPUTER LAW (2)

A seminar analyzing contemporary problems in Computer Law. Topics to be covered include: introduction to technology, intellectual property overview, recurring and significant contract provisions, integrated system transactions, liability and litigation, computer generated evidence/expert testimony, privacy/security, government contracting issues, bankruptcy and software escrows, taxation, international law and transactions, antitrust and domestic and international distribution, and software and database acquisitions.

INTELLECTUAL PROPERTY 421
CONTEMPORARY TECHNOLOGY AND INTELLECTUAL PROPERTY LAW (2)

A seminar examining problems in the law of Intellectual Property presented by new forms of technology. A study of the difficulties faced by the United States Patent and Trademark Office and the Courts in applying existing patent, copyright and trademark law to promote progress on the frontiers of science and proposed solutions. Areas to be considered include: the patentability of forms of life, inventions made in space, semiconductor topology, non traditional forms of property, look and feel of computer programs, biotechnology, colorization of movies, moral rights, industrial designs, shrink wrap licenses, states rights versus preemption and supremacy, copying for home use.

INTELLECTUAL PROPERTY 430
TRIAL ADVOCACY FOR INTELLECTUAL PROPERTY ATTORNEYS (3)

Prerequisites: IP 408 and knowledge of current rules of evidence **

The mechanics of trying patent lawsuits, opening statements, preparation, direct and cross-examination of, in-trial motions, closing arguments. The course is compacted into an intensive 9 a.m. to 6:30 p.m., 9½ day format. Faculty members and students believe this concentrated format aids learning and gives a more realistic understanding of the rigors of trial practice. The final examination is a simulated patent trial. Limited to ten students. Not available to J.D. candidates.

INTELLECTUAL PROPERTY 431, 432
INDEPEDENT STUDY (2 OR 3)

The undertaking of a project approved by the Director of the Division requiring scholarly independent study which will result in a significant contribution to the law of Intellectual Property.

INTELLECTUAL PROPERTY 433
DISSERTATION (3)

The preparation of a scholarly thesis suitable for publication adding significant new contributions to the fund of writing already in existence relating to the law of Intellectual Property and not merely a recapitulation. The topic to be approved by the Director of the Division. Available to degree candidates who have completed a major of 21 semester hours of subjects, including IP 400 Substantive Patent Law I or IP 415 Law of Patents, with a minimum grade point average 2.75.

** Prerequisites may be waived only by written permission of the Director.

ANNEX X

FRANKLIN PIERCE LAW CENTER
DESCRIPTION OF IP COURSES

LEGAL CAREER TRACKS
INTELLECTUAL PROPERTY

3d Semester	Credits	4th Semester	Credits
BA I	4	Patent Practice II	2
Survey of IP	3	Evidence	2
Patent Practice I	2		
Antitrust	3		
Crim Pro I	3		
5th Semester	**Credits**	**6th Semester**	**Credits**
Selected IP Topics I	2	Selected IP Topics II	2
Remedies	3	(Prereq: Patent	
Personal Tax	3	Practice I & II)	
Licensing	3	Wealth Transmission	4
		Proactice IP Counseling	2

LEGAL CAREER TRACKS

On the next few pages are course suggestions (tracks) for particular areas of concentration. Please note that the tracks are *suggested* only. It is almost always possible to take course in a different semester than the one suggested, and no track is meant to serve as an absolute requirement for all students interested in a particular area. If you have any questions, please see either the faculty member specializing in that area or the Academic Dean.

INTERNATIONAL PATENT LAW Michael Meller 2 Credits
IP0002-01 Spring Semester

Open to second- and third-year students interested in patents who have taken at least some basic U.S. patent law courses or to MIP students who have taken basic patent law courses in their respective countries.

This course introduces the patent law student to international patent law theory and practice, as well as the substantive aspects of patent law and how they differ from a comparative law standpoint between respective jurisdictions in the U.S., Canada, the English system countries, as well as Western Europe, Eastern Europe, including the Soviet Union, and in the Orient: Japan, China, Korea, Taiwan, as well as Australia, New Zealand, and the Latin American countries. The course also covers the international treaties, including EPC and PCT as well as some licensing law, especially as developed in the EEC, and International Litigation concepts.

The course is offered once every three weeks in five six-hour sessions, with class participation strongly encouraged, constituting 15 percent of the grade. The remainder of the grade will be based on a final exam to be given at the end of the course (60 percent), and a paper involving original research (25 percent).

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INTERNATIONAL TRADE REGULATION—Minicourse William Hennessey 1 Credit
CM0003-01 Fall Semester

Open to all second- and third-year students.

This minicourse will cover U.S. import and export regulations, the role of the U.S. International Trade Administration, International Trade Commission, and U.S. Trade Representative, the General Agreement on Tariffs and Trade (GATT), free trade agreements, and other regulations affecting international trade. Basis for a grade will be a short-answer final examination.

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LEGAL SKILLS II 2 Credits
RQ0014 Spring Semester

Skills II is a required second-semester course for every first-year student. The course consists of a moot court appellate argument. Each faculty member publishes a legal problem covering a particular area of the law. Small groups of eight students work on each of these problems and are supervised by that particular faculty member. Each student prepares a ten-page brief arguing her side (appellant or appellee) of the case. Each student then makes a 15-minute oral argument of her case before three judges (the faculty member involved, as well as two practicing attorneys from the community). Oral arguments are held in The

LICENSING INTELLECTUAL PROPERTY (Technology Transfer) — **Karl Jorda** — **3 Credits, Fall Semester**
IP0003-01

Grade is based on an exam and several class problems.

The emphasis will be on creative licensing arrangements involving intellectual property (including franchising), their negotiation and implementation, actual licensing situations, antitrust and misuse problems, understanding and drafting some of the more important basic clauses, royalty determinations and valuation of intellectual property, and administration of license agreements.

This course will include both licensing your client's intellectual property to another, and licensing intellectual property from another to your client.

A knowledge of intellectual property law (patents, trade secrets, know-how, trademarks, and copyrights) is not a prerequisite, nor is a technological background necessary for this course.

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PATENT PRACTICE & PROCEDURE I & II — **Robert Shaw** — **2 Credits Each Semester, Fall & Spring Semester**
IP0004-01 & IP0009-01

This is a year-long offering. No prerequisite.

This highly specialized course sequence is designed to provide comprehensive and intensive training in preparing patent claims and complete applications, and in meeting the objections to patenting raised by the Patent and Trademark Office (PTO), as well as a case study of the patent law. The overall reason for this offering is to provide training not now otherwise available, especially now that the PTO is more a place of career employment than of apprenticeship, as it formerly was.

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PROACTIVE INTELLECTUAL PROPERTY COUNSELING — **Karl Jorda** — **2 Credits, Spring Semester**
IP0005-01

Grade is based on an exam and two or more class problems.

Topics included are employer/employee law as it relates to inventions and confidential information, dealing with inventors and their inventions as clients or as co-employees, various types of patent and trademark searches and investigations, uncovering clients' inventions, invention records, criteria and procedures for decisions on whether to file patent applications in the U.S. and other countries, patents and the development of new products, public disclosure problems, secrecy agreements, avoiding infringement of the patents of others, employed inventor incentive plans, corporate/outside inventor problems, trademark problems, dealing with corporate management of your client or employer, and the difference between private and corporate intellectual property law practice.

This will also include such advanced licensing topics as U.S. export control laws, international transfer of technology practice, U.S. antitrust law in international patent and know-how licensing, etc., as well as an overview of Interference and Chemical Practice with emphasis on practical corporate aspects.

This course is intended for the sixth semester as it is designed as both a "capstone" course building on all of the intellectual property courses taken in the second and third years, and a "bridging" course spanning academic and real-life private or corporate practice. As such it is a very practical course on how to get a head start in intellectual property/licensing practice with effective proactive counseling.

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SELECTED TOPICS IN INTELLECTUAL PROPERTY I & II Robert Shaw 2 Credits Each Semester
IP0006-01 & IP0010-01 Fall & Spring Semester

This is a year-long offering. Prerequisite: Patent Practice & Procedure I & II.

This second course is a continuation of the second-year course, but the focus is changed. In the third-year course principal direction is toward expanding the view of the students. Each is required to present several papers to the class which then engages in in-depth discussion of the issues presented. In this way issues are addressed in a mature fashion, much as those same issues would be presented in the practice of patent law. The subject matter includes patents, but it includes as well, trademarks, copyrights, unfair competiton, and related subjects. The discussions are far-reaching.

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SURVEY OF INTELLECTUAL PROPERTY Thomas Field 3 Credits
IP0007-01 Fall Semester

Open to second- and third-year students. No technical background is necessary and there are no prerequisites. This is the basic introduction to intellectual property. Students intending to take other courses in the intellectual property program should take this course in their *second* year.

Grade based on an open-book examination.

The course, focusing on *preventing* client problems *rather than reacting* to situations after the fact, introduces: (1) Patents, copyrights and other law (e.g., trade secrets, misappropriation) designed to protect commercially valuable information; (2) Rights of artists, authors, performers, and independent inventors; and (3) Trademarks and other law designed to prevent consumer source deception and to protect commercial goodwill. The scope of protection and the necessary steps to secure and retain it are the primary emphasis. However, jurisdictional requirements, defenses, remedies and other procedural matters are also covered—as are pervasive overlaps and conflicts between, e.g., state and federal law.

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TRADEMARKS & DECEPTIVE PRACTICES William Hennessey 3 Credits
IP0008-01 Spring Semester

Open to second- and third-year students. No prerequisites, but Survey of Intellectual Property may be helpful. Prelaw training in marketing, business, languages, communication or psychology would also be helpful.

Grade based on an open-book exam or nonanonymous research paper.

The course examines the choices a firm may have in preventing and redressing unfair and deceptive marketing practices of other firms. The primary focus is on obtaining, maintaining and enforcing legal protection for commercial goodwill. However, related laws are also considered. In addition to exploring substantive law, the course explores federal/state conflicts, administrative procedure, jurisdictional requirements, (particularly equitable) remedies and defenses, and other constitutional and procedural issues which arise in a host of substantive contexts.

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TRIAL ADVOCACY 3 Credits
SK0007-01 Fall & Spring Semesters

Open to third-year students.

Prerequisites: Completion of or simultaneous enrollment in Evidence.

Grade will be based upon class exercises, written analyses of exercises, and final trial.

Sections of this course are taught by appellate and trial judges, and experienced trial attorneys. If course is over-enrolled, selection of students will be made by lottery.

This course is designed to teach students how to prepare a case for trial and how to competently advocate on behalf of a client during trial. Through the use of exercises designed to simulate segments of civil and criminal trials, students prepare and execute portions of trials (for example, drafting pleadings, drafting and arguing pretrial motions, conducting discovery, making opening statements, conducting direct and cross-examinations, arguing objections, and making closing arguments) during class sessions and a full trial at the conclusion of the semester. Students learn how to research and argue issues of substantive law, apply the rules of evidence, and develop an effective advocacy style.