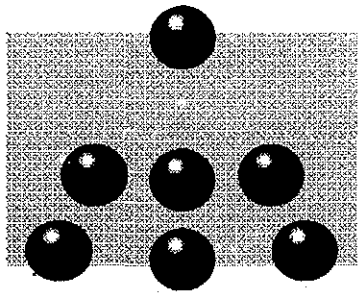

ASEAN REGIONAL SYMPOSIUM ON TEACHING AND TRAINING OF INTELLECTUAL PROPERTY

KUALA LUMPUR, JULY 6 - 8, 1995

ACADEMIC TRAINING IN THE FIELD OF INTELLECTUAL PROPERTY - THE EXPERIENCE OF THE FRANKLIN PIERCE LAW CENTER, USA.

by

Prof. Karl Jorda,
Franklin Pierce Law Center, USA.

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ACADEMIC TRAINING IN THE FIELD OF INTELLECTUAL PROPERTY THE EXPERIENCE OF FRANKLIN PIERCE LAW CENTER

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 protection of IP cannot be understated. For example, the rapidly-changing, highly-competitive computer and biotechnology industries have particularly caused a severe strain on IP law.

The demand for IP professionals in general, and patent practitioners, in particular, has far exceeded the supply. And the situation will probably remain that way for some time to come.

In addition to the growth of high tech industries, other factors creating a new demand for IP and patent professionals are the surge of imports and with it the influx of patent and trademark applications from foreign manufacturers, recent IP legislative reforms, 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 and IP law.

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 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 Appendix A.

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.[1]

Indeed, the basic legal curriculum, fairly standard throughout the U.S., does not include patent or IP related law. Historically, few schools have provided even elective coverage. Thus, most patent attorneys have had to acquire their knowledge and skills on the job. The situation 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

[1] 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)

hours) in IP law and thirty-five credits in the case of Franklin Pierce Law Center (FPLC). 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.

II. THE GULF BETWEEN LAW SCHOOL AND LAW PRACTICE

Before going into the specifics of academic training in the IP field offered by some law schools, it is appropriate, for background and perspective, to review and illuminate the present state of flux and ferment in law schools with respect to specialization or concentration 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, and law students increasingly need specialties.

The legal profession complains that law schools don't teach the skills students will actually need to practice law. Since at least 1990 "[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." (U.S. News & World Report, March 19, 1990, p.59, 61)

For 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 and warned against going too far and trivializing law school's scholarly and theoretical purposes and leading to a trade school approach.

This ferment was further dramatically high-lighted by the creation of a "Narrowing the Gap" task force by the American Bar Association (ABA) which led to the so-called "McCrate Report" containing very critical conclusions about the state of legal education in America.

Then ABA President, Talbot D'Alemberte, also deplored this education schizophrenia:

> "We are very much a divided profession. Our academic side is over here and the practicing lawyer is over there, and they don't connect very often.
>
> ....
>
> "Our insistence that we are part of the academy and our insistence that we are not a trade school has actually led us to cut ourselves off from the people who have things to say to our students, people from the profession and people from other schools in the university." (ABA Journal, Sept. 1990, p.53)

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 "exit semester" courses and other benchmark alternative (BMA) concepts. This is likely also true at other law schools with extensive IP programs since substantial IP programs and extensive IP training are recent law school innovations and IP faculties still consist by and large of IP practitioners, especially in the patent law field.

III. IP 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 IP 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 IP law firms hiring new law school graduates and in corporate IP departments doing the same or transferring scientists from R&D departments to IP

departments. Such transfers are taking place on a fairly large and increasing scale due to the shortage of IP practitioners, on the one hand, and, on the other hand, due to certain advantages that this harbors, i.e., familiarity with the company, its culture and its personnel as well as its R&D and IP operations. Often such transferees have gained experience in, e.g., 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 IP 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 IP training courses also designed to attract foreign practitioners. The Cushman, Darby and Cushman "Advanced Patent Seminar" is typical.

As regards IP teaching in universities, it appears that occasional 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." (Recent Personal Communication.)

It is highly questionable that apart from such introductory lectures any systematic in-depth IP law teaching takes place in universities in general in either undergraduate or graduate science and engineering curricula. In fact, even graduate business schools have paid little attention to teaching IP law and IP licensing/technology transfer in spite of the pervasive growing economic importance and impact of IP and IP licensing.[2] Interestingly, The Fletcher School of Law and Diplomacy at Tufts University, Boston, will only now start IP teaching with a course in International Intellectual Property Law (to be taught by this writer).

As was stated in the introductory chapter, even in law schools, the most that can be expected is that an introductory IP survey course is being taught by a regular faculty member who is not an IP specialist or an adjunct professor who is a local IP practitioner and that only in about 50% of American law schools.

B. IP Survey Courses in American Universities

The Dickinson School of Law (Dickinson) of Carlisle, Pennsylvania is one of the schools in a second category of law schools with typical IP survey courses. Dickinson, in fact, has three elective survey courses for two semester hours each. This undoubtedly has

[2]According to a recent survey conducted by this writer as LES Education Committee Chairman.

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." (Recent Personal Communication.) 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 University of Baltimore School of Law is another illustration of a law school with three IP survey courses, undoubtedly due to the presence of Professor William T. Fryer III, who is well-known and very active in IP circles and associations. In the school's catalog IP is listed with its three courses as a "specialized area" among many others like "Child and Family," "Civil Rights," "Corporate," "Criminal Law," "International Relations," etc. all of which feature seven to nine courses.

To give two more illustrations: 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 taught in alternate years. One covers Copyright, Trademarks and Trade Regulations and is taught by resident Professor Joseph Bauer; the other deals with Patents and is taught by an adjunct professor, a local patent lawyer. A few additional law schools across the country, possibly increasing in numbers due to the present-day "sex appeal" and glamour of IP law and practice, exhibit this three-survey-course pattern.

IV. LAW SCHOOLS WITH IP SPECIALIZATION

A. Ranking of Law Schools by Specialties

U.S. News & World Report publishes a ranking of all American law schools (over 180) in March of every year. In addition, the ten best law schools in the specialties of International Law, Environmental Law, Tax Law, Health Law, Clinical Training and Trial and Appellate Advocacy as well as in IP Law are listed. In the speciality of IP Law, the ranking according to the March 20, 1995 issue (p.85) is as follows:

1. George Washington Univ. (D.C)
2. Franklin Pierce Law Center (N.H.)
2. Columbia University (N.Y.)
4. Stanford University
5. New York University
5. University of Houston
7. John Marshall Law School (Ill.)
8. Boston University
9. Chicago-Kent College - IIT
10. George Mason University (Va.)

Some of these schools as, for example, Columbia, Stanford, New York, made the top-ten list because of their strength and prowess in Copyrights, Trademarks and/or Unfair Competition rather than Patents.

The ranking of law schools by specialties was started in 1992 when only the five top schools were listed and when FPLC ended up in third place after George Washington and New York Universities, which was no small accomplishment for the country's smallest independent law school that was only 18 years old and not located in a big city.

B. The George Washington University

The first-ranked 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: Environmental Law, Government Contracts, Land Use Management and Control Law, International Law and IP Law.

According to the George Washington's 1994-95 Bulletin, the IP Law Program, under the direction of Professor Harold C. Wegner, comprises the following curriculum:

Biotechnology Patent Policy [2]
Chemical and Biotech Patent Policy and Practice [2]
Comparative and International Intellectual Property Seminar [1]
Comparative Patent Law Seminar [2]
Computer Law [3]
Copyright Law[2 or 3]
Electronics and Computers: Policy and Practice [2]
International and Comparative Patent Law [2]
International and U.S. Regulation of Foreign Trade [2]
Japanese Patent Policy [2]
Licensing of Intellectual Property Rights [2]
Patent Enforcement [2]
Patent Law [2 or 3]
Patent Policy and Practice [2]
Trademark Law [2]
Unfair Trade Practices [3]

George Washington also has a Joint Juris Doctor-Master's Degree Program so that students can work concurrently toward both the J.D. degree in the National Law Center and a master's degree in the University's Graduate School, in such related fields as business administration, economics, international affairs, political science, and public administration.

Speaking of George Washington it is worthwhile recalling Professor Glen E. Weston's excellent presentation at the WIPO/ATRIP (International Association for the Advancement of Teaching and Research in IP) Symposium in San Jose, September 17-21, 1990. The title of his paper was "Experience of the Teaching of Intellectual Property ... at an English-speaking University." After "40 years of teaching primarily at George Washington," Professor Weston recounted the travails encountered in shaping an IP program as is now in existence at George Washington and, more particularly, the problems of

— persuading university administrations and faculty to approve new IP courses,
— obtaining adequate teaching materials,
— finding well-qualified teachers for IP courses,
— demonstrating sufficient student interest in new courses, and
— continuing close supervision to assure quality.

C. 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. Its IP Program is the oldest in the country and is now headed by Donald P. Reynolds. The faculty of the IP Division are adjunct professors from the Chicago IP bar.

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 following IP courses are offered at John Marshall:

Advanced Claim Drafting Workshop [1]
Clinical Legal Education: Intellectual Property Law [1-3]
Comparative & International Patent Law [3]
Entertainment Law [2]
Independent Research in Intellectual Property Law [1-2]
Intellectual Property Law Planning and Practice [3]
Introduction to Intellectual Property Law [2]
Patent & Trade Secret Law [3]
Seminar on Selected Topics in Intellectual Property Law [2]
Trademark & Copyrght Law [3]
Unfair Competition & Trade Regulation [3]

V. 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 over twenty adjunct lecturers, a student body of about 450 students (close to 50% of whom specialize in IP or related law), and a record of innovations in training students to meet the challenges of practice.

As one of the leading institutions of IP 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 70 patents to his name.

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

The number of course credits at FPLC pertaining to patent and other IP 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:

Administrative & Related Processes in IP [3]
Advanced Patent Prosecution I [1]
Advanced Patent Prosecution II [1]
Computer Law: Use of IP in Commercializing
Computer Innovations [3]
Copyright Law [2]
IP & Competition Law in the Europe Union [1]
IP Management [2]
IP Pretrial Practice [3]
Information Technologies [2]
Information Torts [3]
International Comparative Copyright Law [1]
International Comparative Patent Law [2]
International Comparative Trademark Law [1]

Introduction to IP [3]
Licensing IP [3]
Patent & Trade Secret Law [3]
Patent Practice & Procedure [2]
Regulation & Protection of IP in Advertising [2]
Selected Topics in IP I [2]
Selected Topics in IP II [2]
Survey of IP [3]
Trademarks & Deceptive Practices [3]
Trial Advocacy — Patent Section [3]

Description for the above courses are reproduced in Appendix B.

This curriculum is enlarged through independent studies, externships (internships) and special seminars and lectures on IP 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. However, starting in the fall of 1996, an LL.M. degree program in IP law will be instituted.

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.

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, trademarks, copyrights, trade secrets, IP licensing, the law of international trading and business relationships and international and comparative IP law. Skills instruction covers drafting patent claims, preparing patent applications, designing and drafting technology licenses, managing IP assets, and making legal arguments in mock 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 semester" places foreign MIP students for one month or more, in an IP law firm and/or in the IP department of an American corporation and/or a governmental agency.

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 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 when FPLC enrolled five persons from the People's Republic of China as well as one student from each of five other countries: Taiwan, South Africa , Korea , the Philippines and Singapore.

In the following years students completing the MIP Programs came from all corners of the world, even including such countries as Mongolia, Zimbabwe, etc. They were, for the most part, high-level patent and trademark office and other governmental officials as well as IP practioners from law firms and corporate departments.

When these "students" return to their home countries they have a heightened awareness of how much IP protection promotes invention, innovation and economic progress.

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)

Further, FPLC offers courses each summer in IP subjects for law students, lawyers, engineers, scientists and managers. IPSI offers a seven-week program in June and July comprising one or two-credit courses on Entertainment Law, Financing & Valuation of IP, IP Management, IP Evaluation, IP Research Tools, International & Comparative Patent Law, International & Comparative Copyright Law (1), International & Comparative Trademark Law (1), Basic Licensing, Patent Practice & Procedure, Patent & Trade Secret Law, Trademarks, and Copyrights.

With the permission of their home schools, law students can apply credits earned in the IPSI toward the J.D. degree. In addition to FPLC students, students from as many as 50 American law schools not having extensive offerings in IP subjects, attend IPSI. Also participants in IPSI have come from major U.S. corporations and research institutes as well as from many foreign countries.

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 three years of full-time study. Up to 50 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. In lieu of such a paper, a faculty-approved project, e.g. national moot court participation, will also do.

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 35 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

The gulf between legal education and legal practice, discussed above in Chapter II, is in fact getting wider, notwithstanding clinical-skills programs, as more and more elite law schools 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 benchmark alternative (BMA) to academic research and writing can encompass a variety of steps and things, such as, in particular, "intensive semesters" and "bridging semester" for starters. One illustration of the former is a "legal reasoning" BMA for the first year to strengthen students' basic thinking and reasoning and hence writing skills. Other possibilities for "mastery courses" in other semesters: ADR (Alternative Dispute Resolution) concentration, "master advocacy semester," etc.

An example of the latter is the "Proactive IP Management" course which this writer teaches 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 intellectual property/licensing practice.

VI. CONCLUSION

The advent of the Golden Age for patents and IP and the severe shortage of patent and IP professionals, have brought about great changes in the world of IP teaching and training. The subject of IP is now perceived as glamorous and enrollment in IP courses of

study and programs has increased accordingly. While in the not-too-distant past, most IP practitioners had to acquire their skills on the job, many law schools now offer one or more IP survey courses and some 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 over 35, IP credit hours. Outside of law schools no systematic IP teaching to speak of (apart from introductory lectures) have taken place in colleges and universities.

Law schools noted for their IP specialization or concentration, apart from FPLC, are George Mason University School of Law, John Marshall Law School, George Washington University National Law Center. Most IP teaching is still largely a matter of evening classes taught by adjunct faculty. 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 IP specialization with a full-time IP faculty of five and over 35 IP course credits. The IP 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 IP 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.

Karl F. Jorda
David Rines Professor of Intellectual Property
Franklin Pierce Law Center
Concord, NH, USA

APPENDIX A

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

ADMINISTRATIVE & RELATED PROCESSES IN IP Thomas Field 3 Credits
AD0009-01 Fall Semester

Limited enrollment: 21 (except auditors). Can satisfy the administrative process requirement, but people who have already done so are welcome. Open only to students who have completed Patent Practice I and Survey of Intellectual Property or equivalent.

In the event of overenrollment, third-year students will be given preference. Second-year students will be selected based on performance in Survey of IP (including extra-credit papers, if any). *Students who enroll but do not attend the first class* without my prior approval, *will be bumped in favor of others who want to take the course and do attend the first class.*

The administrative process requirement. Satisfied by passing a comprehensive, two-hour, objective, *otherwise optional examination* administered at the end of the term—as well as otherwise completing course requirements. The exam will be graded Pass/Fail.

Course grade. (O/S/U) based on attendance, participation, *paper, two class presentations,* and the exam (if taken). It is unlikely that anyone would receive an O without an excellent score on the exam (if taken).

Course objectives. The same as those for my generic Administrative Process course—as described above. This seminar has the additional objective of trying to make process as relevant as possible to students intending to pursue a career in patent or trademark law. Most attention will be given to the PTO, but some will be given to the Copyright Office. We will also briefly consider other agencies that regulate technology, e.g., FDA or OSHA, or agencies that sponsor scientific research, e.g., NIH.

✦ ✦ ✦

ADVANCED PATENT PROSECUTION I Ben Hauptman
IP0024-01 Spring Semester

No course description available at time of publication.

ADVANCED PATENT PROSECUTION II Ben Hauptman
IP0025-01 Fall Semester

No course description available at time of publicaiton.

✦ ✦ ✦

✦ ✦ ✦

COMPUTER LAW: Use of IP in Commercializing Computer Innovations **Chris Blank** 3 Credits
Spring Semester
IP0027-01

The course is limited to ten students.

We live in a new age, we are told. We have progressed from an industrial economy into a post-industrial age, an information age. Where capital was once the underlying factor to be accounted for to explain our institutions, we now look to information or knowledge to provide explanation. Several questions do present themselves for our consideration: Will the technologies that are developing promote the underlying causes of our institutions? Will knowledge be spread or horded? Will knowledge and information be transformed so that it dictates culture versus being a condition of culture?

While these are very interesting questions and may indeed be the correct questions to ask, there is a greater need to understand how the present property paradigms are being used or not, to effect development of information technologies. Do any of these paradigms operate as expected or designed? Are any of the players capable of ascertaining the effect of property principles in the realm of knowledge and information?

The goal of this class is to avoid abstraction to as great a deal as possible. Our first goal is to review literature concerning the use of existing intellectual property forms in the field of software and computers. We will look to procedures for obtaining property rights in order to understand what kinds of legal impediments exist for those who wish to obtain property. Our second goal will then be to ascertain what portion of those that might participate in an existing property system do so.

Our third goal will be to see what kinds of practices have developed for the transfer of "property." Economic models of value creation will be reviewed to inform participants in their evaluation of the existing paradigms.

Lastly, we will survey individuals and business in the software and computer field to ascertain their acceptance or judgement of property law.

✦ ✦ ✦

COPYRIGHT LAW William Strong 2 Credits
Spring Semester
IP0001-01

This course examines copyright law as applied to the full range of eligible works, from fine art to computer programs. The emphasis is on close analysis of both statutory and case law, as they relate both to principles and to technical issues. The Berne Convention and moral rights are also discussed.

The grade is based on a take-home exam.

✦ ✦ ✦

INFORMATION TECHNOLOGIES: Rights & Responsibilities — William Murphy — 2 Credits, Fall Semester
BS0009-01

Prerequisite: none. Non-intellectual property students are encouraged to enroll.

Advances in information technology have permitted an unprecedented explosion in the collection, storage, and use of information. The law of intellectual property generally concentrates on the ownership aspects of these knowledge and information assets, but there are other significant legal considerations that must be addressed.

Information, whether stored in computers, on paper, or even in chemical form such as DNA, has value. What responsibilities do the creators, collectors, and users of this information have toward those who may be the subjects of it? Encoded information and knowledge in the form of software increasingly is in control of the machinery of everyday life, from fly-by-wire aircraft to the "smart" kitchen appliance. What duties and, as a consequence, liabilities are associated with this encoded information? Scientific teams in the U.S. and Japan are in a race to decode the human genome. What legal issues will acquisition of this knowledge entail? A business examines the electronic mail that is circulated by its employees, both within and without the corporation. Have the legal rights of the employees been violated? Your local grocery and retail stores collect detailed information on your purchases from their laser-scanning equipment. What use can be made of this information and who gets to decide?

This course will examine the rapidly evolving areas of the law that seek to resolve the issues of privacy, liability, and access as they relate to information and information technology. As we enter the Information Age we will be continually forced to address new and unexpected legal issues arising from this advancing technology. As a result, we increasingly witness a legal system trying to adjust and accommodate the changing realities of life in the modern society, trying to strike a balance among conflicting and competing interests and concerns.

Topics to be covered: rights of privacy in the Information Age, liability for defective intellectual property, issues surrounding the ownership and use of DNA sequences, new crimes from new technologies, use of electronic evidence, electronic commerce, and rights of access to information. The course grade will be determined from class contribution and projects (40 percent), and a final paper (60 percent).

✦ ✦ ✦

INFORMATION TORTS Hugh Gibbons 3 Credits
RS0007-01 Spring Semester

The information torts are those in which the causal agent of injury is information rather than physical impact. With the exception of defamation, the information torts are of recent origin, their shape still unsettled in law. The information age, particularly in the form of worldwide digital networks, has focused attention upon these torts. Can the privacy torts, for example, adequately protect the interest in privacy? Does copyright enforcement threaten to throttle the flow of information on the highway? The questions are many and difficult.

This course is conducted as a research seminar. Based upon the materials that have been developed in the prior iterations of the course, we will focus upon the most problematic intersections between tort law and information technology. In 1994 the focus was on privacy and resulted in a scheme of rules and principles to protect privacy on the information superhighways. That scheme will be reexamined, along with the law governing the negligence liability of information providers and the enforcement of copyrights.

In addition to the mastery of the initial materials in the course, there will be weekly written or research assignments based upon a memo written by the instructor capturing the thoughts of the class for the preceding week. Grades will be based upon in-class and written contributions to the work of the seminar, and upon a final paper exploring in-depth one of the issues developed during the semester.

✦ ✦ ✦

INTELLECTUAL PROPERTY & COMPETITION LAW IN THE EUROPE UNION Bryan Harris 1 Credit Spring Semester
IP0023-01

Most lawyers who advise corporations trading in the Member States of the European Union (EU) do so in the context of intellectual property law, unfair competition law, competition (or antitrust) law, or antidumping law. These areas of law overlap to a large extent. The purpose of the course is to explain the general rules applying at EU level to the respective areas of law, with particular reference to the underlying policies governing the way in which the laws are made, interpreted and applied.

Although there will be a full discussion of the ways in which EU law impinges on patents, trademarks, design rights, copyright, and neighboring rights, the emphasis will be on the relationship between intellectual property rights on the one hand, and on the other hand, the competition rules, the rules on the free movement of goods and services, and the other requirements of EU law. The course is intended to complement more detailed and technical studies of the individual branches of intellectual property law.

Although the course may be taken on its own, it is best taken together with the course on the Constitutional Law of the European Union, which will provide the context into which the present course fits.

✦ ✦ ✦

INTELLECTUAL PROPERTY MANAGEMENT Karl Jorda 2 Credits Spring Semester
IP0005-01

Grade is based on 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, 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.

This will also include advanced licensing topics as well as an overview of Interference and Chemical Practice with emphasis on practical 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.

✦ ✦ ✦

INTERNATIONAL COMPARATIVE PATENT LAW — Hans Goldrian — 2 Credits, Fall Semester
IP0014-01

This course introduces the patent provisions of the Paris Convention, the Patent Cooperation Treaty, the Patent Part of the TRIPS Agreement within WTO, and the substantive and adjective law of the European Patent Convention.

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INTERNATIONAL COMPARATIVE TRADEMARK LAW—Minicourse — José Gómez Segade — 1 Credit, Spring Semester
IP0015-01

Open to all second- and third-year students. No prerequisites but some understanding of basic trademark law is desirable.

This course will cover the major international conventions in the field of trademarks, namely, Paris Convention, Madrid Agreement and Madrid Protocol, Trademark Law Treaty. It will also deal with GATT, as well as with NAFTA and other regional agreements. Another main issue of the course will be trademark law in the European Union (EU), including European Court of Justice Jurisprudence, EU harmonization measures and Council Regulation on the EU trade mark. The course will finish with some highlights on protection of appellations of origin and some major points of national legislation on trademarks of some European countries.

The grade will be based upon a one-hour, open-book examination.

✦ ✦ ✦

INTRODUCTION TO INTELLECTUAL PROPERTY — Thomas Field — 3 Credits, Spring Semester
IP0028-01

Open to first-year students only. Enrollment ceiling of 40.

No technical background is necessary, but in the event of over enrollment, people with engineering and hard sciences backgrounds will be preferred.

Although Field will be responsible for such matters as organization, overall content, and grading, most classes will be conducted by or with the assistance of other intellectual property faculty, possibly including adjuncts and European visitors.

The course will examine the basic substantive requirements and procedures for obtaining, maintaining and enforcing patents, copyrights, trade secrets, trademarks, and related subject matter. In doing so it will explore underlying policy goals and conflicts internal and external to intellectual propert;, for example, the occasional tension between free speech and copyright or trademark protection. It will also explore such matters as the extent to which intellectual property is "property" and what difference that makes; relationships between legislatures, agencies and courts; and the relationships between state and federal governments.

Grade primarily, if not exclusively, based on a final examination.

✦ ✦ ✦

LICENSING INTELLECTUAL PROPERTY Karl Jorda 3 Credits
(Technology Transfer) 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.

PATENT & TRADE SECRET LAW Chris Blank 3 Credits
IP0021-01 Fall Semester

This course is designed as the casebook method of learning substantive patent and trade secret law delivered by way of study of the controlling statutory framework of each of these bodies of law. Trade secret law is carefully read by way of the vehicles of the Uniform Trade Secret Act and the Restatement of Torts. The law is then contrasted with United States patent law, once again introduced and studied using the vehicle of the U.S. Patent Act.

Students will read a variety of very recent cases, as well as a variety of very old cases in order to demonstrate the peculiar nature of the prevailing Patent Act (which may provide additional perspectives on statutory construction). Little attention is paid to the process by which patents are procured. To a great extent the perspective of the course is a litigation perspective which for many reasons is highly influential on the workings of the United States Patent and Trademark Office (PTO). Besides the state of the prevailing law we will also address some of the emerging issues in "patent law" which are bound to affect the future of patents and the activity which patent law is meant to foster.

✦ ✦ ✦

PATENT PRACTICE & PROCEDURE Robert Shaw 2 Credits
IP0004-01 Fall Semester

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.

✦ ✦ ✦

REGULATION & PROTECTION OF IP IN ADVERTISING E.C. Stone 2 Credits
IP0026-01 Fall Semester

It is intended that this seminar focus on all the elements that make up advertising strategy and the advertising itself from the point of view that advertising is speech protected by the First Amendment and the elements of the advertising constitute intellectual property.

Areas, *inter alia*, that must be familiar to lawyers who represent advertisers and their agencies are:

- Antitrust as it relates to acquisition of market power through use of advertising and discriminatory use of co-op allowances and other promotional devices.
- Business and legal practices as they relate to the use of a person's likeness and actions in both print and broadcast media.
- Constitutional protection of free expression of commercial ideas.
- Government and self-regulatory controls on misleading advertising.
- Use of traditional copyright and trademark concepts in both current media and new forms of dissemination of ideas.
- Rights of privacy and publicity.
- Comparative advertising.

Materials to be used would include case law, statutes, examples of both print and broadcast advertising that have led to litigation, and self-regulatory codes.

Grades will be based 50 percent on class participation and 50 percent on an original paper. There may be some short quizzes or take-home exams; they will be considered as part of class participation.

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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.

This third-year course is directed toward toward expanding the views of the students. Each is required to present several IP cases 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, the subject matter is recent court decisions found in the advanced sheets of the *Unitd States Patent Quarterly.*

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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.

✦ ✦ ✦

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

Open to second- and third-year JD students and MIP students. No prerequisites; prelaw training in marketing, business, languages, communication, or psychology may be helpful. No scientific or technical background is necessary.

This course will also be open to 20 first-year, second-semester students as an elective.

Grade based on an open-book exam.

The course examines the choices a firm may have to prevent and redress unfair and deceptive marketing practices of other firms. The primary focus is on obtaining, maintaining and enforcing legal protection for commercial goodwill through trademarks. However, related laws regarding false advertising, rights of publicity (commercial personality), sponsorship, and endorsement are also considered. In addition to treating the substantive law, the course explores trademark office practice, federal/state conflicts, administrative procedure, jurisdictional requirements, remedies (particularly equitable remedies), and defenses.

✦ ✦ ✦

INTELLECTUAL PROPERTY PRETRIAL PRACTICE — Chris Blank — 3 Credits
IP0011-01 — Fall Semester

Litigation is the course of last resort in resolving disputes amongst individuals and as such, should be ruled by rational rules, valuation, risk assessment and resolution. We know, of course, that the world does not operate as logically as some hope it would, and we must conduct ourselves in a world where decisions are made which are not always logical and the actions of others are not always predictable.

This course endeavors to provide a framework for dealing with the realities of litigation in the intellectual property realm by looking at this process from its inception. Just as armed conflicts are won off the battlefield, litigation is often won outside the courtroom. "Winning" at the litigation game requires numerous skills, many of which we will look at during the run of this course. Client counseling perspectives will be developed in in-class exercises as well as in written exercises. Strategic planning skills will be identified and used in prelitigation and trial drafting exercises. Risk assessment will be practice in valuation exercises.

Grades are based upon three exercises, class participation, and student capability. Since I hope to teach by posing problems which are designed to be as realistic as possible given the constraints of a classroom and a law school setting, I expect students to undertake comprehensive analysis of the problems I pose in the course. Understanding of civil procedure is required and an ability to deal with evidentiary issues is desirable. All forms of IP are looked at and frameworks for resolution of problems in each of the fields are developed.

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INTERNATIONAL COMPARATIVE COPYRIGHT LAW—Minicourse — Silke von Lewinski — 1 Credit
IP0013-01 — Spring Semester

Open to all second- and third-year students. No prerequisites but some understanding of basic copyright law is desirable.

This minicourse will cover the principal international conventions, namely, Universal Copyright, Berne, Rome, and Geneva, including current problems in the international copyright arena in light of recent tendencies toward greater reciprocity and the emergence of new kinds of works (computer programs, data banks, etc.) and new rights (rental right, public lending rights, etc.). It will also deal with GATT, NAFTA, and bilateral treaties as a new mechanism in international copyright relations and copyright within the European Union (EU) including European Court of Justice jurisprudence and EU harmonization measures. Comparative copyright law in terms of principles, methods and problems as well as the differences between the system of copyright and the system of "droit d'auteur" will also be covered.

The grade will be based on a class problem.

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