

**GEORGETOWN UNIVERSITY
BCHB 523: INTELLECTUAL PROPERTY**

SYLLABUS Fall 2008

***INTRODUCTION TO INTELLECTUAL PROPERTY
PRIMARILY PATENT LAW AND PATENTS***

1 credit

Thursdays 6:00 – 8:00 pm 9/4/2008 – 12/11/2008

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- 1 **WHAT IS A PATENT?**
- 2 **WHY HAVE PATENTS?**
- 3 **WHAT RIGHT(S) DOES A PATENT CONFER?**
- 4 **HOW ARE PATENT RIGHTS ESTABLISHED AND ADMINISTERED?**
- 5 **HOW IS THE PATENTED INVENTION DEFINED?**
- 6 **WHAT ARE THE REQUIREMENTS FOR PATENTING AN INVENTION?**
- 7 **BIOTECHNOLOGY-SPECIFIC ASPECTS OF PATENT LAW**
- 8 **HOW ARE PATENT RIGHTS ENFORCED?**
- 9 **HOW ARE PATENTS USED IN BUSINESS?**
- 10 **HOW ARE PATENTS INTERPRETED?**
READING A PATENT: PART 2
- 11 **EXAMPLES: AMGEN ERYTHROPOIETIN PATENTS**
(READING A PATENT: PART 3)
- 12 **SEARCHING PATENTS AND PRIOR ART**
- 13 **SELECTED REFERENCES ON PATENT LAW**
TEXTS, GUIDES, CODE, RULES, MANUALS AND TREATIES
35 U.S. CODE ("35 USC")

The law ('statutes') of the land pertaining to patents, trademarks and copyrights. I believe this is available free from the USPTO Web site. It also is available from the GPO and can be found in Samuels' "Patent, Trademark and Copyright Laws" listed above.

37 CODE OF FEDERAL RULES ("37 CFR")

The rules of the Patent and Trademark Office. Although not laws, they are binding on the PTO and on applicants for patents. This probably is the single most useful reference book for a patent attorney to keep near at hand. The rules are available from the GPO and may be available free from the USPTO web site.

USPTO MANUAL OF PATENT EXAMINING PROCEDURE ('MPEP')

This is the handbook of Patent Office examiners. It is meant to guide examiners to apply the law and the rules properly, and to codify the informal rules of the Office for examining patent applications. It references and explains not only the statutes but also judicial decisions bearing on their proper interpretation and application. Furthermore, it describes and explains many informal rules and procedures of the USPTO. Since it is intended to help examiners carry out their examining tasks, it provides very detailed

instructions about formal requirements for documents submitted by applicants and documents prepared by the USPTO. It is meant to be explanatory, as well; but, it is not an easy read for a novice. Moreover, the text is written from the USPTO point of view and does not always comport with the view of practicing attorneys outside the office. It is nonetheless an essential tool that every patent agent and attorney uses essentially on a daily basis if they are engaged in patent prosecution before the office. The MPEP can be down-loaded for free from the USPTO web site.

WIPO INTELLECTUAL PROPERTY HANDBOOK: POLICY, LAW AND USE

A one-volume (about 500 pages) sourcebook published by the World Intellectual Property Organization. This volume does a good job describing the general forms of intellectual property, their import, use and administration, from a European perspective.

PATENT PRACTICE, Irving Kayton, Ed., PRG Press (Latest edition)

A treatise in 6 volumes (perhaps more) that is, arguably, the most clearly written, cogent and comprehensive discussion of US patent law currently available. Volume 1 provides a very good introduction to the most basic subjects. Available upon registering for the PRG patent law review seminar and (maybe) available from PRG via the web.

PATENT PROSECUTION: Patent & Procedure Before the U.S. Patent Office, Irah H. Donner, BNA Books, Washington DC (Latest edition)

A comprehensive one-volume introduction to getting a patent (*i.e.*, practice before the USPTO).

PATENT LAW AND PRACTICE, Herbert F. Schwartz, Federal Judicial Center, Washington, DC (2nd Edition - 1995)

This is a short book that might serve well as a primer. It may only be available from the Federal Judicial Center, Thurgood Marshall Federal Judiciary Building, One Columbus Circle, N.E., Washington, DC 20002-8003. Look for the most recent edition.

BIOTECHNOLOGY AND THE FEDERAL CIRCUIT, Kenneth J. Burchfiel, BNA Books, Washington, DC (First edition - 1995)

A compendium of decisions relating to biotechnology by the 'high court' of patent law, with commentary and discussion. Look for most recent edition.

PATENTS AND THE FEDERAL CIRCUIT, Latest Edition, Robert L. Harmon, BNA Books, Washington, DC (2003)

A compendium of decisions by the 'high court' of patent law, covering all the basic issues and then some, in all technical areas, with commentary and discussion. Quite well written and generally comprehensive. Look for most recent edition.