

Master of Legal Studies (M.L.S.), Patent Practice Concentration

Course Descriptions

A. Required Courses:

1) Courses required for the MLS degree:

LAW 581 (FALL OR SPRING, ONLINE): US Law & Legal Analysis, 3 credits

This will introduce MLS and LL.M students to the U.S. legal system and to the types of legal reasoning used by lawyers and judges. Students will be provided the necessary instruction to use legal reasoning in their academic work, including reading and understanding cases and statutes, doing basic legal research and writing legal memoranda, and applying existing law to the issue at hand. Finally, the course will provide an overview of a handful of key areas that are particularly important for business and policy applications, such as federalism/pre-emption, constitutional law and administrative law.

2) Courses required for the Patent Practice emphasis:

LAW 664 (SPRING): Intellectual Property, 3 credits

This course will survey the laws conventionally grouped as “intellectual property,” with a focus on patents, copyrights, and trademarks. The policy rationales for each body of law will be explored. The course will be particularly relevant for two types of students: (i) those who are unsure they want to specialize in IP and want a general introduction, and (ii) those who do not have room in the schedules to take all of the upper-level offerings here at ASU.

LAW 645 (FALL): Patent Law, 3 credits

This course provides a general introduction to patent law and policy. A patent is a federally-granted bundle of entitlements that include, most importantly, the right to prevent others from making, using, selling, or importing the patented invention for a defined period of time. The course will cover the history of patent law; the policy rationales for granting or withholding patents; a summary introduction to patent preparation and prosecution procedure; and a more detailed consideration of the patentability requirements (patentable subject matter, utility, novelty, nonobviousness, and disclosure), the concept of patent infringement, defenses and limitations to patent rights, and remedies.

LAW 691 (SPRING): Patent Preparation and Prosecution, 2 credits

The course is targeted at teaching the fundamental knowledge and skills required for preparing patent applications for filing at the U.S. Patent and Trademark Office (PTO) and pursuing them to issuance. The patent practitioner must be prepared to interview the inventor, learn the technology, and prepare the patent application. Further, the patent practitioner negotiates with the examiner and prosecutes the application. Clients expect the practitioner to provide useful counsel on how to pursue the application, options for appealing or otherwise overcoming

adverse decisions, and protecting the technology from domestic and foreign competition. The course is designed to train the patent practitioner to understand the patent options for various technologies, clients, and situations. Students learn the basics of drafting patent applications, pursuing the patent application through the PTO process, meeting adverse decisions from the PTO, and maintaining the issued patent. The course also addresses anticipating litigation issues, protecting developing technologies, and pursuing patents abroad.”

LAW ___ (SPRING): Patent Drafting, 3 credits

This course is a skills course that focuses on developing students’ claim drafting, specification, and office action response writing skills. Over the course of the semester, students will be given three drafting/writing assignments, provided with feedback on their work, and may be asked to submit revisions, if necessary. Assignments will be given to students tailored to their area of technical expertise, with rough general breakdowns in the following three categories: bio/chem, mechanical/hard science, and software/business methods.

LAW ___(FALL):Comprehensive Patent Practice, 5 credits

This course discusses the major aspects of drafting and prosecuting a patent before the United States Patent and Trademark Office. Topics covered include: patent research skills, patentability analysis, drafting of the application, filing documents and submission of the application, communications from the USPTO and office actions, allowance of the patent, patent issuance, types of rejections, examiner interviews, extrinsic evidence, the America Invents Act, and post-grant procedures. All topics will be discussed in conjunction with the relevant MPEP sections and associated USPTO ethics considerations.

3) Culminating experience required for the certificate:

LAW 791 (SUMMER): Lisa Foundation Patent Law Clinic, 3 credits

The Lisa Foundation Patent Law Clinic provides students with hands-on experience in real-world patent prosecution, licensing and litigation. The clinic is open to students having a background in science and engineering who are qualified to sit for the Patent Bar exam as well as students with a non-technical background who have a strong interest in patent law. Faculty will attempt to match students’ areas of technical expertise with available projects.

LAW791 (SUMMER): Contingent Fee Patent Licensing and Enforcement, 2 credit

This hands-on course is designed to teach the skills necessary to recognize the characteristics of a valuable and enforceable patent. Once those characteristics are recognized, the course will address from a practical perspective, how to structure an effective patent prosecution, licensing and enforcement program, as well as how to defend such programs.

B. Potential Elective Courses:

LAW 596 (FALL): Professional Legal Writing, 3 credits

This course aims to help non-lawyers learn how to organize a legal research project by analyzing the facts and identifying the issues involved, determining the research tools needed to correctly investigate the legal problem, and systematically using these tools to strengthen and support

the desired legal argument. Students will complete research and writing exercises. Students most likely will prepare one memorandum of law.

LAW 691 (SPRING): Patent Litigation, 2 credits

This is a practical course, drawn on real world litigation experience, addressing key issues in patent litigation. We will cover, at a minimum, pre-litigation issues including pre-filing investigation and identifying proper parties; jurisdiction, venue, and pleadings; disclosure and discovery; privilege issues; experts; dispositive motions, pretrial, and trial; claim construction; infringement and non-infringement; invalidity; unenforceability; remedies; appeal; and reexamination and reissue. We will survey applicable provisions of Titles 28 and 35 of the United States Code, as well as the Federal Rules of Civil Procedure. We also will cover significant patent litigation changes wrought by 2011's America Invents Act. Reading assignments and lectures will be designed to help students gain an understanding of what the real world practice of law is like. Prior completion of, or at least concurrent enrollment in, Civil Procedure is strongly encouraged. Prior completion of, or at least concurrent enrollment in, Evidence and an introductory course addressing patent law is desirable, but not required.

LAW 648 (FALL): International Intellectual Property, 3 credits

This course will examine the international system for regulation and direction of intellectual property. Although the emphasis will be on the United States, some comparative review of foreign intellectual property systems will be discussed.

___ ___: Graduate Engineering/Science Elective, 3 credits

Students may choose up to three credit hours from a graduate-level mathematics, science, or engineering course that will help expand their professional and technical knowledge (as approved by the college or school offering the course).

LAW ___: Other Law Course

Students may choose up to six credits from any IP or technology-related law course.