Patent and Know-How Licensing (W)
Law 286

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Other recent cases available on electronic databases (e.g., Lexis or Westlaw)

Other: The cases listed in syllabus are relevant to the topics that will be discussed in class. An understanding of the principles in those cases (as they relate to title, licensing, competition laws, etc.) is important.

Grade: No Exam. Writing Course. At least three projects --
(1) drafting portion of patent license agreement
(2) drafting portion of patent license agreement and opinion on patent license issue
(3) drafting complete patent license agreement

Class Schedule: 8:00 PM to 9:50 PM Wednesdays. There may be conflicts with out-of-town travel. I will always warn in advance and will get a substitute if possible. Some classes may be cancelled.
Class 1 (Aug. 22, 2012)

Introduction to Course

Introduction to Patent Licensing

Reasons for Licensing and Business Aspects of Licensing

Craft of Drafting License Agreements

Text - Chapter 6

Transfer of Patent Rights

License vs. Assignment

Text - Chapter 1

Cases
Waterman v. Mackenzie, 138 U.S. 252 (1891)
Alfred Mann Foundation v. Cochlear Corp., 604 F.3d 1354 (Fed. Cir. 2010).
WIAV v. Motorola, 631 F.3d 1257 (Fed. Cir. 2010)

Joint Ownership

Cases
Schering Corp. v. Roussel-UCLAF SA, 104 F.3d 341 (Fed. Cir. 1997)
Ethicon, Inc. v. U.S. Surgical Corp., 135 F.3d 1456 (Fed. Cir. 1998)

Class 2 (Aug. 29, 2012)

Types of License Agreements (1)

Exclusive, Nonexclusive, Sole, Covenant Not to Sue

Text - Chapter 2
Cases

Field of use, cross-license, grant-back

Text - Chapter 3

Sublicenses, compulsory licenses, shop right, foundry, and “have made” rights

Text - Chapter 3

Cases
Rhone-Poulenc Agro, S.A. v. DeKalb Genetics Corp., 284 F.3d 1323 (Fed. Cir. 2002)
Cyrix Corp. v. Intel Corp., 77 F.3d 1381 (Fed. Cir. 1996)

Class 3 (Sept. 5, 2012)

Types of License Agreements (2)

Implied Licenses

Text - Chapter 4

Cases
Wang Labs Inc. v. Mitsubishi Electronics Am. Inc., 103 F.3d 1571 (Fed. Cir. 1997)
Scholle Corp. v. Blackhawk Molding Co., Inc., 133 F.3d 1469 (Fed. Cir. 1998)

Patent Exhaustion

Text - Chapter 4

Cases
Adams v. Burke, 84 U.S. 453 (1873)
Class 4 (Sept. 12, 2012)

Elements of a License Agreement (1)

Opening Part of the Agreement

Text - Chapter 7

Definitions

Text - Chapter 8

Cases
Panduit Corp. v. Hellermanntyton Corp., 451 F.3d 819 (Fed. Cir. 2006)

The Grant Clause and Reservations

Text - Chapters 9, 10

Cases
Imation Corp. v. Philips, 586 F.3d 980 (Fed. Cir. 2009)
Mid-West Conveyor Co., Inc. v. Jervis B. Webb Co., 92 F.3d 992 (10th Cir. 1996)

Grants for Improvements, Releases

Text - Chapter 10, 23

Cases
Augustine Medical, Inc. v. Progressive Dynamics, Inc., 194 F.3d 1367 (Fed. Cir. 1999)
**Class 5 (Sept. 19, 2012)**

**Elements of a License Agreement (2)**

Consideration and Royalty Clauses

**Text** - Chapter 11

**Cases**

*Uniloc USA v. Microsoft*, 632 F.3d 1292 (Fed. Cir. 2011)

**Class 6 (Sept. 26, 2012)**

**Elements of a License Agreement (3)**

Most Favored Licensee Clauses

**Text** - Chapter 13.00

**Cases**

*Waterloo Furniture v. Haworth*, 467 F.3d 641 (7th Cir. 2006)

Best Efforts Clauses

**Text** - Chapter 2.03D

**Cases**


Third Party Infringement

**Text** - Chapter 13.01

Assignability of License Agreements

**Text** - Chapter 14.00-14.01

**Cases**
Representations and Warranties

**Text** - Chapter 16

**First Drafting Exercise** will be distributed and negotiating roles assigned for the negotiation session, which will take place on **October 3, 2012**. (Participation in this exercise will be a useful learning experience, but you will not be graded on your performance; volunteers are encouraged.) The First Drafting Exercise will be due two weeks later, on **October 17, 2012**.

**Class 7 (Oct. 3, 2012)**

**Negotiation Session**

During the first hour, a mock two-party negotiation session will be held based on the fact pattern set out in the First Drafting Exercise. Since it is important for the exercise that you actually observe the exercise, please make every effort to attend this class.

**Ethics in License Negotiations**

**Litigation Consequences of License Negotiations**

**Text** - Chapter 5

**Cases**

*Minnesota Mining v. Nippon*, 63 F.3d 694 (8th Cir. 1995)

*SanDisk v. STMicroelectronics*, 480 F.3d 1372 (Fed. Cir. March 26, 2007)

**Class 8 (Oct. 10, 2012)**

**Elements of a License Agreement (4)**

**Indemnification**

**Text** - Chapter 17

**Responsibility for Patent Prosecution**
Miscellaneous Clauses

Term and Termination

Execution of Agreements

Class 9 (Oct. 17, 2012)

First Drafting Exercise is Due

Antitrust Considerations in Licensing

Antitrust Statutes - Per se vs. Rule of Reason

Cases
- Mallinckrodt v. Medipart, 976 F.2d 700 (Fed.Cir. 1992)

DOJ/FTC Antitrust Guidelines

Text - Appendix K

Licensing Practices With Possible Antitrust Issues: Price Fixing, Market Division, Patent Pools, Refusals to License, Tying, Packaging,

Cases
- In re Independent Service Organization, 203 F.3d 1322 (Fed. Cir. 2000)

Antitrust and Settlement Agreements
Cases
In re Ciprofloxacin Hydrochloride Antitrust Litigation, 544 F.3d 1323 (Fed. Cir. 2008)
Arkansas Carpenters v. Bayer, 604 F.3d 98 (2d Cir. 2010)
Valley Drug Co. v. Geneva Pharms., Inc., 344 F.3d 1294 (11th Cir. 2003)
In re Cardizem CD Antitrust Litigation, 332 F.3d 896 (6th Cir. 2003)

Antitrust and Standard Setting

Cases
Rambus v. Infineon Technologies, 318 F.3d 1081 (Fed.Cir. 2003)
Rambus v. FTC, 522 F.3d 456 (D.C. Cir. 2008)
Qualcomm Incorporated v. Broadcom Corp., 548 F.3d 1004 (Fed. Cir. 2008)

January 23, 2008 Statement of the F.T.C. in the matter of Negotiated Data Solutions, Inc., and Dissenting Statements
(available at http://www.ftc.gov/os/caselist/0510094/index.shtm)
April 30, 2007 DOJ Business Review Letter re IEEE

Class 10 (Oct. 24, 2012)

Misuse Considerations in Licensing

Text - Chapter 29.02-29.06

Patent Misuse and the Federal Circuit

Cases
Princo Corp. v. ITC, 616 F.3d 1318 (Fed. Cir. 2010) (en banc)
Virginia Panel Corp. v. MAC Panel Co., 133 F.3d 860 (Fed. Cir. 1997)

Specific Types of Misuse: Tying, Tie-Outs, Compulsory Package Licensing, Compulsory Total Sales Royalty, Label Licensing, Post-Expiration Royalties

Cases
Morton Salt Co. v. G.S. Suppiger Co., 314 U.S. 488 (1942)
Princo Corp. v. ITC, 563 F.3d 1301 (Fed. Cir. 2009)
U.S. Philips. Corp. v. ITC, 424 F.3d 1179 (Fed. Cir. 2005)
Scheiber v. Dolby, 293 F3d 1014 (7th Cir 2003)
Second Drafting Exercise will be distributed. The Second Drafting Exercise will be due on October 31, 2012.

Class 11 (October 31, 2012)

Second Drafting Exercise is Due.

Lear Doctrine

Text - Chapter 15

Cases
Baseload Energy, Inc. v. Roberts, 619 F.3d 1357 (Fed. Cir. 2010)

International Technology Transfer and Regulation

Text - Chapter 27

Class 12 (Nov. 7, 2012)

Know-How and Trade Secret Agreements

Text - Chapters 24, 25, 26

Cases
Celeritas v. Rockwell, 150 F.3d 1354 (Fed. Cir. 1998)
IDX Systems v. Epic Systems, 285 F.3d 581 (7th Cir. 2002)
Class 13 (Nov. 14, 2012)

Licensing of Government and Universities

Text - Chapter 28

Cases
Campbell Plastics Engineering & Mfg, Inc. v. Brownlee, 389 F.3d 1243 (Fed. Cir. 2004)
Central Admixture Pharmacy Services, Inc. v. Advanced Cardiac Solutions, 482 F.3d 1347 (Fed. Cir. 2007)

Bankruptcy and Tax Issues in Licensing

Text - Chapter 12, 14.02-14.04

Cases
In re Catapult Entertainment, 165 F.3d 747 (9th Cir. 1999)
In re Storm Technology, 260 B.R. 152 (N.D. Cal. Br. 2001)

Thanksgiving Recess (Nov. 19 - Nov. 23, 2012)

Class 14 (Nov. 28, 2012)

Review

Final Drafting Exercise will be distributed. The Final Drafting Exercise will be due on December 12, 2012.