THE GEORGE MASON UNIVERSITY SCHOOL OF LAW

SYLLABUS FOR
PATENT & KNOW-HOW LICENSING (LAW 286-001)
2 CREDIT HOURS
HAZEL HALL ROOM 412
FALL 2013

PROFESSOR: Michael V. O’Shaughnessy

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CLASS SCHEDULE: The course will meet on Tuesdays 8:00 PM – 9:50 PM.

REQUIRED COURSE MATERIALS:


2. Cases and materials cited below.

3. Newly decided cases and other materials may be handed out during the semester.

EVALUATION/GRADING METHODS: Grades will be based on a combination of two mid-term writing assignments and a final take-home assignment, based on the following allocation: 20% for each of the two drafting exercises; and 60% for final assignment. In addition, while class participation is not mandatory, I reserve the right to increase or reduce a final course grade to the next higher or lower grade (e.g., from a B to a B+ or from an A- to a B+) based on class participation.

CLASSROOM POLICIES:

• CLASS ATTENDANCE: The School of Law’s academic regulations require regular and punctual class preparation and attendance for academic credit to be earned. If a student is absent for any reason for more than 20 percent of the sessions of a course, the student is not eligible for credit in that course. A student who is not present for at least 75 percent of a session of the course is absent from that session. (AR 4-1.1.) In other words, please try not to miss any classes, but in any event, don’t miss more than 3.

• DISABILITY SUPPORT SERVICES: Any student who may need an accommodation based on the potential impact of a disability must
present the student disability issue to the Assistant Dean, Student Records or to the Director, Student Academic Affairs. Students with disabilities must be evaluated by the University’s Office of Disability Services before an appropriate accommodation can be determined.

- **HONOR CODE:**
The Law School has an Honor Code in place that articulates minimum standards for student conduct and procedures for handling allegations of Honor Code violations. The Honor Code applies to all students at all times after admission to the Law School and until certification of graduation. The Honor Code prohibits, among other things, lying, cheating, or stealing. Additional information about the Honor Code can be found at: http://www.gmu.edu/org/honorcouncil/).
SYLLABUS - SPRING 2012

Class 1 - August 20, 2013

Introduction to Course

Introduction to Patent Licensing

Reasons for Licensing and Business Aspects of Licensing

Craft of Drafting License Agreements

Transfer of Patent Rights

License vs. Assignment

Text - Chapters 1 and 2

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 – August 27, 2013

Types of License Agreements

Exclusive, Nonexclusive, Sole, Covenant Not to Sue

Text - Chapter 4

Cases

Field of use, cross-license, grant-back

Text - Chapter 5

Sublicences, compulsory licenses, shop right, foundry, and “have made” rights
Text - Chapter 5

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 – September 3, 2013

Elements of a License Agreement (1)

Opening Part of the Agreement

Text - Chapter 8

Definitions

Text - Chapter 9

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

The Grant Clause and Reservations

Text - Chapters 10 and 11

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 11, 25

Cases
Augustine Medical, Inc. v. Progressive Dynamics, Inc., 194 F.3d 1367 (Fed. Cir. 1999)
Class 4 – September 10, 2013

Elements of a License Agreement (2)

Consideration and Royalty Clauses

Text - Chapter 12

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

Most Favored Licensee Clauses

Text - Chapter 14

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

Best Efforts Clauses

Text - Chapter 4.03E

Cases

Third Party Infringement

Text - Chapter 14.01

Assignability of License Agreements

Text - Chapter 15

Cases
Institute Pasteur v. Cambridge Biotech Corp., 104 F.3d 489 (1st Cir. 1997)

First Drafting Exercise will be distributed and negotiating roles assigned for negotiation session. (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 in two weeks, on September 24, 2013.
Class 5 – September 17, 2013

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 7

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 6 – September 24, 2013

First Drafting Exercise is Due

Elements of a License Agreement (3)

Representations and Warranties

Text - Chapter 16

Indemnification

Text - Chapter 17

Responsibility for Patent Prosecution

Text - Chapter 18

Miscellaneous Clauses

Text - Chapter 19, 20

Term and Termination

Text - Chapter 21
Execution of Agreements

Text - Chapter 22

Class 7 – October 1, 2013

Implied Licenses

Text - Chapter 6

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 6

Cases
Adams v. Burke, 84 U.S. 453 (1873)
U.S. v. Univis Lens Co., 316 U.S. 241 (1942)
Jazz Photo Corp. v. ITC, 264 F.3d 1094 (Fed. Cir. 2001)
Fuji Photo v. Jazz Photo, 394 F.3d 1368 (Fed Cir. 2005)

Class 8 – October 8, 2013

Antitrust Considerations in Licensing

Text - Chapter 32

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 A

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)


October 15, 2013 – Observe MONDAY schedule – NO CLASS

Class 9 – October 22, 2013

Misuse Considerations in Licensing

Text - Chapter 32.02-32.06

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)
Zila v. Tinnell, 502 F.3d 1014 (9th Cir. 2007)

Second Drafting Exercise will be distributed. The Second Drafting Exercise will be due on October 29, 2013.

Class 10 - October 29, 2013

Second Drafting Exercise is Due.

Lear Doctrine

Text - Chapter 24

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

Class 11 – November 5, 2013

International Technology Transfer and Regulation

Text - Chapters 29, 30

Bankruptcy Issues in Licensing

Text - Chapters 13, 23

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)

Class 12 – November 12, 2013

Know-How and Trade Secret Agreements

Text - Chapters 26-28
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 – November 19, 2013

Licensing of Government and Universities

Text - Chapter 31

Cases
*Central Admixture Pharmacy Services, Inc. v. Advanced Cardiac Solutions*, 482 F.3d 1347 (Fed. Cir. 2007)

Licensing of Trademarks, Copyright, and the Right of Publicity

Class 14 – November 22, 2013 – Observe a TUESDAY schedule

Review

The final writing assignment will be distributed, and is due by December 6, 2013 at 8:00 p.m. Please submit your assignment by email to my firm address at oshaughm@finnegan.com. If you experience any difficulties sending your assignment to that address, please send to oshaughmdc@gmail.com or contact me at (202) 408-4456.