SYLLABUS FOR
PATENT & KNOW-HOW LICENSING (LAW 286-001)
2 CREDIT HOURS
HAZEL HALL
FALL 2015

PROFESSOR: Michael V. O’Shaughnessy

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CLASS SCHEDULE: The course will meet on Thursdays 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/).
Class 1 - August 20, 2015

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, 2015

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

Sublicenses, compulsory licenses, shop right, foundry, and “have made” rights
Class 3 – September 3, 2015

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, 2015

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, 2015.
**Class 5 – September 17, 2015**

**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, 2015**

**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, 2015

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, 2015

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

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 Pharmas., 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)


**Class 9 – October 15, 2015**

**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**


*Princo Corp. v. ITC*, 563 F.3d 1301 (Fed. Cir. 2009)


**Second Drafting Exercise** will be distributed. The Second Drafting Exercise will be due on **October 22, 2015**.
Class 10 - October 22, 2015

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 – October 29, 2015

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 5, 2015

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 12, 2015

Licensing of Government and Universities

Text - Chapter 31

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)

Licensing of Trademarks, Copyright, and the Right of Publicity

Class 14 – November 19, 2015

Review

The final writing assignment will be distributed, and is due by Tuesday, December 8, 2015 at 6:00 p.m. Please submit your assignment by email to my firm address at moshaughnessy@mwe.com. If you experience any difficulties sending your assignment to that address, please send to oshaughmdc@gmail.com or contact me at (202) 253-8584.