

ANTONIN SCALIA LAW SCHOOL AT GEORGE MASON UNIVERSITY

SYLLABUS FOR
PATENT & KNOW-HOW LICENSING (LAW 286-001)
2 CREDIT HOURS
CRN 73890
LOCATION - TBA
FALL 2021

Professor James Love
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Professor Vincent Shier
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CLASS SCHEDULE: The course will meet on Tuesdays 8:10PM-10:10PM

Office Hours – upon request

REQUIRED COURSE MATERIALS:

1. Brunsvold, O'Reilly, & Kacedon, *Drafting Patent License Agreements*, (9th ed.), BNA Books [hereafter “**DPLA**”].

This book can be accessed for free after creating a GMU academic account at Bloomberglaw.com at: <https://www.bloomberglaw.com/browser/105.456350>

2. Cases and materials cited below in TWEN.
3. Newly decided cases and other materials posted to TWEN.

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, since class discussion is important to the learning process, we may also take class participation into account, raising grades for consistent, high-quality participation or lowering grades for chronic lack of preparation or unprofessional conduct. Classroom participation may account for a discretionary, single-increment adjustment either upward or downward (*e.g.*, from B to B+ or from A- to B+).

LEARNING OUTCOMES: By the end of the course students should have acquired/be able to:

- Understand a patent license
- Draft a patent license
- Understand the various considerations that relate to licenses such as implied licenses, patent exhaustion, Anti-trust, Misuse, Lear Doctrine, Bankruptcy, Trade-secret, Trademark, Copyright, and Right of Publicity

CLASSROOM POLICIES:

- **CLASS ATTENDANCE:**

Attendance will be taken at the beginning of each class. A student may be absent for three classes and still be in compliance with the attendance policy. Anyone showing up more than 25 minutes late will be marked “absent.” If you are tardy and arrive after attendance has been taken, it will be your responsibility to make sure that we mark you “present.”

- **COMPUTER USE**

Students may use computers or handheld devices for taking notes. Extraneous computer activities, such as surfing the internet or checking email, are strongly discouraged as they can negatively affect your performance.

- **EMAIL**

Students must use their MasonLive email account to receive important University information, including communications related to this class. We will not respond to messages sent from or send messages to a non-Mason email address.

- **CLASS RECORDINGS PROHIBITED:** Pursuant to Academic Regulation 4-2.2, no portion of a class session or an examination may be preserved by means of a recording device such as an audio recording device or camera. Any exceptions to this policy must be expressly permitted in writing by us.

- **COVID HEALTH & SAFETY REQUIREMENTS:** Any student or instructor who anticipates being on campus for any reason should refer to the most up-to-date University policies [here](#).

SYLLABUS – Fall 2021

Class 1 - August 24, 2021

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 1-3

Cases

Waterman v. Mackenzie, 138 U.S. 252 (1891)

Independent Wireless Telegraph. Co. v. RCA, 269 U.S. 459 (1926).

Alfred Mann Foundation v. Cochlear Corp., 604 F.3d 1354 (Fed. Cir. 2010).

WIAV v. Motorola, 631 F.3d 1257 (Fed. Cir. 2010)

Arachnid, Inc. v. Merit Indus., Inc., 939 F.2d 1574 (Fed. Cir. 1991).

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)

See TWEN for cases

Class 2 – August 31, 2021

Types of License Agreements

Exclusive, Nonexclusive, Sole, Covenant Not to Sue

Text - Chapter 4

Cases

TransCore, LP v. Elec. Trans. Consults. Corp., 563 F.3d 1271 (Fed. Cir. 2009)

Field of use, cross-license, grant-back

Text - Chapter 5

Sublicenses, 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)

E.I. du Pont de Nemours & Co., Inc. v. Shell Oil Co., 227 U.S.P.Q. 233
(D. Del. 1985)

Cyrix Corp. v. Intel Corp., 77 F.3d 1381 (Fed. Cir. 1996)

Class 3 – September 7, 2021

Elements of a License Agreement (1)

Opening Part of the Agreement

Text - Chapter 10

Definitions

Text - Chapter 11

Cases

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

The Grant Clause and Reservations

Text - Chapters 12 and 13

Cases

Imation Corp. v. Philips, 586 F.3d 980 (Fed. Cir. 2009)

Timeline, Inc. v. Proclarity Corp., 2007 WL 1574069 (W.D. Wash. May 29, 2007)

Mid-West Conveyor Co., Inc. v. Jervis B. Webb Co., 92 F.3d 992 (10th Cir. 1996)

Jacobs v. Nintendo of America, Inc., 370 F.3d 1097 (Fed. Cir. 2004)

Grants for Improvements, Releases

Text - Chapter 13, 28

Cases

Augustine Medical, Inc. v. Progressive Dynamics, Inc., 194 F.3d 1367
(Fed. Cir. 1999)

Diversified Dynamics Corp. v. Wagner Spray Tech Corp., 109 Fed. Appx. 29
(Fed. Cir. 2004)

Dinesol Building Prods. Ltd. v. Tapco Int’l, 201 Fed. Appx. 764 (Fed. Cir. Sept. 11, 2006).

Class 4 – September 14, 2021

Elements of a License Agreement (2)

Consideration and Royalty Clauses

Text - Chapter 14

Cases

Georgia-Pacific Corp. v. U.S. Plywood Corp., 318 F. Supp. 1116 (S.D.N.Y. 1970)

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

Most Favored Licensee Clauses

Text - Chapter 17

Cases

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

Studiengesellschaft Kohle M.B.H. v. Hercules, Inc., 105 F.3d 629
(Fed. Cir. 1997)

Best Efforts Clauses

Text - Chapter 4.03E

Cases

Flight Concepts Ltd. v. Boeing Co., 819 F.Supp. 1535 (D. Kan. 1993)

Third Party Infringement

Text - Chapter 17.01

Assignability of License Agreements

Text - Chapter 18

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 28, 2021**.

Class 5 – September 21, 2021

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 9

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 28, 2021

First Drafting Exercise is Due

Elements of a License Agreement (3)

Representations and Warranties

Text - Chapter 19

Indemnification

Text - Chapter 20

Responsibility for Patent Prosecution

Text - Chapter 21

Miscellaneous Clauses

Text - Chapter 22, 23

Term and Termination

Text - Chapter 24

Execution of Agreements

Text - Chapter 25

Class 7 – October 5, 2021

Implied Licenses

Text - Chapter 7

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)

TransCore, LP v. Elec. Trans. Consults. Corp., 563 F.3d 1271 (Fed. Cir. 2009)

General Protecht Group, Inc. v. Leviton Mfg. Co., 2011 WL 2666222 (Fed. Cir. July 8, 2011)

Patent Exhaustion

Text - Chapter 8

Cases

Quanta Computer Inc. v. LG Electronics, Inc., 128 S. Ct. 2109 (2008).

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)

October 12, 2021 – No class

Class 8 – October 19, 2021

Antitrust Considerations in Licensing

Text - Chapter 35

Antitrust Statutes - Per se vs. Rule of Reason

Cases

United States v. General Elec. Co., 272 U.S. 476 (1926)

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

Independent Ink, Inc. v. Illinois Tool Works, Inc., 126 S.Ct. 1462 (2006)
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
(available at <http://www.usdoj.gov/atr/public/busreview/222978.htm>)

Class 9 – October 26, 2021

Misuse Considerations in Licensing

Text - Chapter 35.02-35.06

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)
Zenith v. Hazeltine Research, Inc., 395 U.S. 100 (1969).
Princo Corp. v. ITC, 563 F.3d 1301 (Fed. Cir. 2009)
U.S. Philips. Corp. v. ITC, 424 F.3d 1179 (Fed. Cir. 2005)
Brulotte v. Thys Co., 379 U.S. 29 (1964).
Kimble v. Marvel Entertainment, 576 U.S. ___ (2018)

Class 10 – November 2, 2021

Lear Doctrine

Text - Chapter 27

Cases

Lear v. Adkins, 395 U.S. 653 (1969)

Foster v. Hallco Mfg. Co., 947 F.2d 469 (Fed. Cir. 1991)

Studiengesellschaft Kohle M.B.H. v. Shell Oil Co., 112 F.3d 1561 (Fed. Cir. 1997)

Medimmune, Inc. v. Genentech, inc., 127 S.Ct. 764 (2007)

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

Second Drafting Exercise will be distributed. The Second Drafting Exercise will be due on **November 9, 2021**.

Class 11 – November 9, 2021

Second Drafting Exercise is Due

International Technology Transfer and Regulation

Text - Chapters 32, 33

Bankruptcy Issues in Licensing

Text - Chapter 26

Cases

In re Alltech Plastics, Inc., 5 U.S.P.Q.2d 1806 (W.D. Tenn. 1987)

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 16, 2021

Know-How and Trade Secret Agreements

Text - Chapters 29 and 30

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 23, 2021

Licensing of Government and Universities

Text - Chapter 34

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)

Stanford v. Roche Molecular Sys., 131 S.Ct. 2188 (2011).

Licensing of Trademarks, Copyright, and the Right of Publicity

The **final writing assignment** will be distributed, and is **due by Tuesday, November 30, 2021 at 6:00 p.m.** Please submit your assignment by email.

ADDITIONAL SCHOOL POLICIES AND RESOURCES:

ACADEMIC INTEGRITY: It is expected that students adhere to the Antonin Scalia Law School Honor Code. The Honor Code prohibits lying, cheating, or stealing. This includes a student obligation to never represent the work of another as their own, and to never provide or accept unauthorized assistance on any school related assignment. The Honor Code is available here: <https://sls.gmu.edu/honor/>.

ACADEMIC REGULATIONS - [Click Here](#)

CLASSROOM ACCOMMODATIONS: Disability Services at George Mason University is committed to providing equitable access to learning opportunities for all students by upholding laws that ensure equal treatment of people with disabilities. If you are seeking accommodations for this class, please visit <http://ds.gmu.edu/> for detailed information about the Disabilities Registration Process. Faculty may not receive or respond to requests for an accommodation. All requests must be handled by the office of Disability Services. You may contact Disability Services directly via email at ods@gmu.edu or phone at (703) 993-2474. If you have any questions about how in-class or testing accommodations are implemented at the law school, please contact the Assistant Dean, Student Academic Affairs for more information.

FINAL PAPER DELAYS:

- **PAPER EXTENSIONS:** Except for instances described in AR 4-4.1(b)(ii), faculty may not grant deadline extensions for final papers (i.e. any written assignment that accounts for 50% or more of the final course grade); all authority in this matter is delegated to the Assistant Dean, Student Academic Affairs. Excuses and requests for a deadline extension must be presented, with appropriate documentation, to the Assistant Dean, Academic Affairs. Except in emergencies, deadline extensions must be sought in advance of the scheduled deadline.

UNIVERSITY LIFE: University Life provides student support resources such as **Counseling and Psychological Services** (<https://caps.gmu.edu/>), **Student Health Services** (<https://shs.gmu.edu/>), and the **Student Support and Advocacy Center** (<https://ssac.gmu.edu/>). For more information about University Life on the Arlington Campus, please visit: <https://ularlington.gmu.edu/>