

Licensing & Tech. Transfer

- Module 1
- Nature of a License

Licensing Taxonomy

- Business Models
 - Media (movies, music, etc.)
 - Manufacturing
 - Software/Information

Standardized Approaches

Grant: IP/Info + Conditions + Covenants

Assent
Use ReadMe Shrink Click SignedK

Grant: IP.Rights/Info + Conditions

Remedies:
© / K

Grant: Information

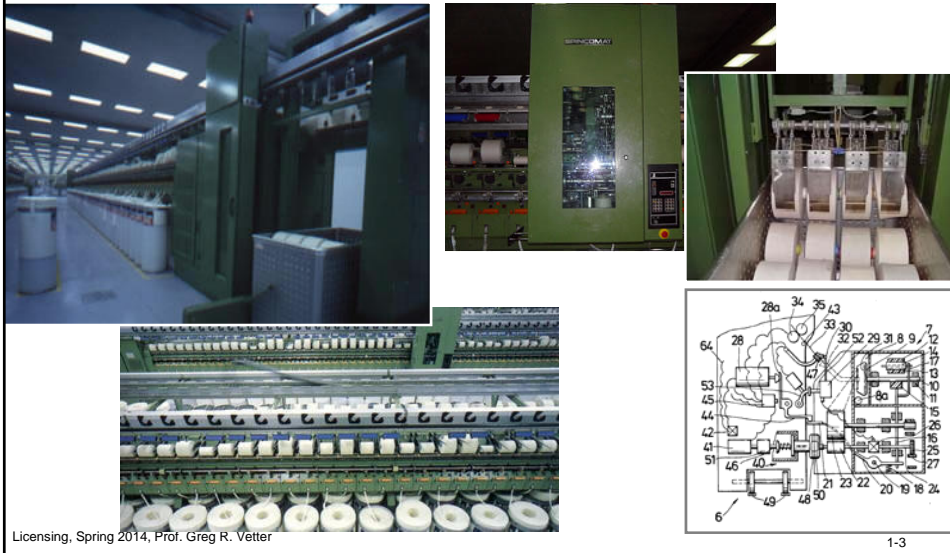
Grant: IP Rights

Scope

Intention

SpindelFabrik v. Schubert & Salzar (Fed. Cir. 1987)

- Suessen as P; Schubert as D; yarn-spinning
- What is Murata's role; Dist. Ct. & Fed. Cir. result?



Siedle v. NASD (MD Florida 2003)

http://www.benchmarkalert.com/forensic_investigations-0.html

FEATURED INTERVIEW

Based in Ocean Ridge, Florida, Benchmark was founded by Edward Siedle. The media has referred to Siedle as "the Sam Spade of Money Management" and "the Pension Detective." He was born Edward Ahmed Hamilton Siedle in Trinidad, British West Indies. He has lived in Trinidad, Venezuela, Panama, Peru, England, Uganda, Egypt and the United States.

Siedle, who attended Simon's Rock Early College, the nation's first "early college" for high school aged students, later graduated Summa Cum Laude from Franklin Pierce College and received his Juris Doctorate from Boston College Law School. He began his career in law with the SEC's Division of Investment Management, which regulates money managers and mutual funds; he later served as Legal Counsel and Director of Compliance to Putnam Investments, one of the largest international money management firms. Since 1989, Siedle has founded and managed firms offering specialized services to municipalities, pension funds and money managers.

He is nationally recognized as an authority on investment management and securities matters. He has testified before the Senate Banking Committee regarding the mutual fund scandals and the Louisiana State Legislature regarding pension consultant conflicts of interest. He was a testifying expert in the Madoff litigation. Articles about him have appeared in publications including Time, BusinessWeek, Wall Street Journal, The New York Times, Barron's, Forbes, USA Today, Boston Globe, and Institutional Investor. He widely lectures and has appeared on CNBC, Wall Street Week, and Bloomberg News. He recently appeared in a Bloomberg special on "Hidden 401k Fees" which earned Bloomberg its first Emmy Award.

Siedle is a licensed General Securities Principal (Series 24); Financial and Operations Principal (Series 28); Municipal Securities Principal (Series 33); General Securities Representative (Series 7); State Securities Agent (Series 63) and Combined State (Series 66). He is also the author of a critically acclaimed guide to the criminal and disciplinary history of the securities industry, The Siedle Directory of Securities Dealers. The findings of the Directory were reported in publications ranging from Fortune to The New York Law Journal. Siedle is an active member of the Massachusetts and Florida Bars.

SENATE BANKING COMMITTEE TESTIMONY

My Promise to You
By Edward Siedle
Click Here to Listen

THE SIEDLE GUIDE TO THE SECURITIES INDUSTRY
Click here for more information

- Siedle as P
 - What did Siedle do?
- First Click Agreement
- Second Click Agreement

ProCD v. Zeidenberg (7th 1996)

- ProCD
 - Business
 - Price Discrimination?
 - Threat of arbitrage?
- Zeidenberg
 - What did he do?
- Dist. Ct. outcome
- 7th Cir. outcome



§ 301. Preemption with respect to other laws

- (a) On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by [section 106](#) in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by [sections 102](#) and [103](#), whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.
- (b) Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to —
- (1) subject matter that does not come within the subject matter of copyright as specified by [sections 102](#) and [103](#), including works of authorship not fixed in any tangible medium of expression; or
 - (2) any cause of action arising from undertakings commenced before January 1, 1978;
 - (3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by [section 106](#); or
 - (4) State and local landmarks, historic preservation, zoning, or building codes, relating to architectural works protected under [section 102\(a\)\(8\)](#).

Dailey v. Firetree (M.D. Pa. 2006)

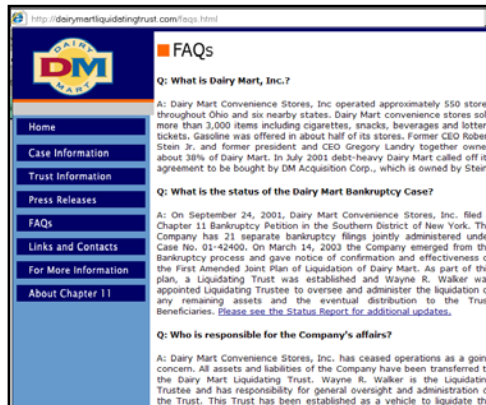
- Dailey sues with three counts
 - copyright infringement under the federal Copyright Act (Count I)
 - unfair competition under the common law (Count II)
 - tortious interference with advantageous business relations (Count III)
- Copyright preemption under section 301?
 - Subject matter requirement
 - General scope requirement – equivalent?
 - What counts as an “extra element” to remove equivalency?
- Unfair competition – “reverse passing off”
 - “plaintiff’s unfair competition claim is preempted, because it is grounded solely in the copying and distributing of plaintiff’s protected expression”
- Tortious interference
 - “Plaintiff’s tortious interference claim is preempted by federal law because it does not qualitatively differ from a claim made under the Copyright Act. It is indistinguishable from the claim for copyright infringement and fails the extra element test.”

Lasercomb v. Reynolds (4th 1990)

- Interact by Lasercomb
 - License to Holiday Steel
 - Unauthorized copies
- PDS-100 by Reynolds as Holliday employee
- Copyright misuse?
 - Restricting creation by LicEE of creating its own CAD/CAM die-making software
 - Agreement term of 99 years
 - Agreement execution by Holiday?
- Valid defense – not coterminous with an antitrust violation
 - Copyright used in a manner violative of © public policy
- Breadth of Lasercomb's restrictive language -> leads to conflict with what © policy?

Zapatha v. Dairy Mart (Mass 1980)

- Dairy Mart granted franchise to Zapatha
- Upon termination threat by DM, Zapatha sued claiming unconscionable terms and unfair competition
- UCC not directly applicable, but applicable by analogy?
- Outcome?



The screenshot shows the Dairy Mart Liquidating Trust website. The URL is <http://dairymartliquidatingtrust.com/foia.html>. The page features a navigation menu on the left with links to Home, Case Information, Trust Information, Press Releases, FAQs, Links and Contacts, For More Information, and About Chapter 11. The main content area is titled "FAQs" and contains several questions and answers regarding the Dairy Mart bankruptcy case.

Q: What is Dairy Mart, Inc.?
A: Dairy Mart Convenience Stores, Inc. operated approximately 550 stores throughout Ohio and six nearby states. Dairy Mart convenience stores sold more than 3,000 items including cigarettes, snacks, beverages and lottery tickets. Gasoline was offered in about half of its stores. Former CEO Robert Stein Jr. and former president and CEO Gregory Landry together owned about 38% of Dairy Mart. In July 2001 debt-heavy Dairy Mart called off its agreement to be bought by DM Acquisition Corp., which is owned by Stein.

Q: What is the status of the Dairy Mart Bankruptcy Case?
A: On September 24, 2001, Dairy Mart Convenience Stores, Inc. filed a Chapter 11 Bankruptcy Petition in the Southern District of New York. The Company has 21 separate bankruptcy filings jointly administered under Case No. 01-42400. On March 14, 2003 the Company emerged from the bankruptcy process and gave notice of confirmation and effectiveness of the First Amended Joint Plan of Liquidation of Dairy Mart. As part of this plan, a Liquidating Trust was established and Wayne R. Walker was appointed Liquidating Trustee to oversee and administer the liquidation of any remaining assets and the eventual distribution to the Trust Beneficiaries. [Please see the Status Report for additional updates.](#)

Q: Who is responsible for the Company's affairs?
A: Dairy Mart Convenience Stores, Inc. has ceased operations as a going concern. All assets and liabilities of the Company have been transferred to the Dairy Mart Liquidating Trust. Wayne R. Walker is the Liquidating Trustee and has responsibility for general oversight and administration of the Trust. This Trust has been established as a vehicle to liquidate the

Gilmer v. Buena Vista Home Video (WD Ark. 1996)

- Allegation by Gilmer of adult or debauchery-laden (subliminal) messages in three children's movies
 - Procedural posture
- What is the traditional scope of warranty for a book publisher?
- How does this approach apply to video tapes sold to the retail public?
 - For the type of tapes at issue in this case?



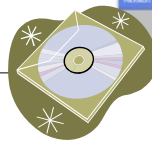
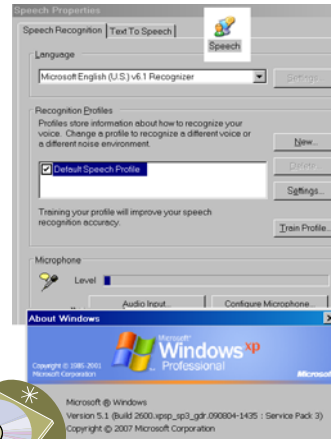
Advent Systems v. Unisys Corp. (3rd Cir. 1991)

- Advent makes EDMS, a hardware/software solution
- Unisys becomes distributor in the U.S.
- Is the EDMS solution goods or services under the UCC?
 - UCC definition of a good
 - What predominates in the transaction at issue?
 - What predominates generally?
- If goods, is there a violation of the statute of frauds?
 - Analogy to non-exclusive requirements K



Microsoft Corp. v. AT&T Corp., 550 U.S. 437 (2007)

- “Infringement occurs only when Windows is installed on a computer, thereby rendering it capable of performing as the patented speech processor.”
- “a copy of Windows, not Windows in the abstract, qualifies as a ‘component’ under § 271(f)”
- Does a single master CD sent abroad with copies made abroad equate to “supplied from the U.S.”?
- Presumption against extraterritoriality
- Dissent . . .



35 U.S.C. 271 Infringement of patent.

. . .

(f)(1) Whoever without authority **supplies or causes to be supplied in or from the United States** all or a substantial portion of the **components** of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.