Licensing & Tech. Transfer

- Module 1
- Nature of a License

Licensing Taxonomy

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

Grant: IP/Info + Conditions + Covenants

Grant: IP.Rights/Info + Conditions

Grant: Information

Grant: IP Rights

Scope

Assent

Use ReadMe Shrink Click SignedK

Intention

Remedies: © / K

Standardized Approaches
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)
- 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of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title.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 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?

- 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 . . .


. . .

(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.