

**6241 Licensing and Technology Transfer – 22908 (2 hours)**

**Spring, 2024**

**Monday 7:30-9:30 PM**

**Instructors:**

Lou Brucculeri and Tom Mavrakakis  
Mobile: 832-423-3212 (Lou); 650-714-0345 (Tom)  
Email: [lou@brucculeri.com](mailto:lou@brucculeri.com); [mav@me.com](mailto:mav@me.com)

**Book and Materials:**

Intellectual Property, Licensing and Transactions, Theory And Practice, by Jorge L. Contreras  
Supplements provided electronically by professor (no cost to students)

**Grading:**

Your grade will be primarily based upon your score on the final exam, which is assessed according to your statistical Z score as relating to JD candidates (i.e., LLM candidates are not counted within the statistical analysis).

We use class participation to boost grades for the students that contribute most during classes. The boost is equivalent to a single +/- ( $\sim 0.33$ ) on the student's grade. This is important for everyone because UH places a cap on the grade average for the JD candidates in a class. Since this class will seek to maximize your grades within the cap restriction (i.e., we will keep the class average as high as we are allowed), by boosting some grades, others may suffer relatively.

**Attendance and Participation**

We attempt to gain class participation by asking for volunteers, but we will call on students to induce engagement from everyone.

This is a face-to-face class. We expect to hold the class in person, but we will often use videoconferencing to bring an instructor or guest into the classroom. We also understand that students sometimes might be forced to miss class if remote access is not made available. Since we prefer your remote attendance over no attendance at all, we routinely allow remote attendance, if it is pre-cleared and practically necessary for the student. However, please do not expect to use remote learning more than a few times during the semester.

**Office hours:**

Any time by appointment  
Questions answered by email any time

**Prerequisites:**

None

**What you will learn:**

By the end of the course, you should be familiar with the primary practical issues that occur in technology licensing. In addition, you will have an understanding of the principles required to resolve or address those issues.

### **Review Session:**

We plan to provide a review session during the last class of the semester. This is our intent but will ultimately be based upon the pace of the class and the interests of the students.

### **Classroom Etiquette**

Our classroom is a learning space where each student is treated with respect and dignity and where everyone is provided the opportunity to participate, contribute, and succeed. In this course, all students are welcome regardless of background or identity. I encourage you to speak up and share your views appropriately throughout the semester. I also expect every class member to remember that in this learning environment, we will engage respectfully and with professionalism toward each other. In the words of the Texas Lawyer's Creed, "[a] lawyer should always adhere to the highest principles of professionalism."

### **AI Policy:**

With one large exception, you may use AI for anything you find useful as long as it is allowed by the UH Honor Code. The one exception is that you may not use AI tools to aid you in providing responses to assessment materials such as the final exam questions.

### **Syllabus:**

Detailed set of class daily assignments will be posted no later than the end of December, but may be modified during the semester to reflect the pace and decisions of the class.

The 2024 version of the class will be streamlined compared to prior versions taught by us. We also plan to include some guests from law firms and industry to help us illustrate the practical side of some lessons.

### **The class topics will include:**

#### **I. INTRODUCTION TO IP LICENSING**

- IP and Licensing in Business
- Ownership and Assignment of IP
- Nature of a License
- Implied Licenses and Unwritten Transactions
- Confidentiality and Pre-license Negotiations

#### **II. LICENSE BUILDING BLOCKS**

- License Grant and Scope
- Exclusivity
- Financial Clauses
- Allocation, Management and Enforcement of IP

Representations, Warranties and Indemnification  
Assignment and Transfer of Licenses  
Term and Termination  
Other License Provisions

### III. INDUSTRY AND CONTEXT SPECIFIC LICENSING TOPICS

Academic Technology Transfer  
Trademark and Franchise Licensing  
Music Licensing  
Consumer and Online Licenses  
Proprietary Software, Data and the Cloud  
Public Licenses: Open Source, Creative Commons and IP Pledges  
Technical Standards and FRAND  
The Supply Chain – Distribution, OEM and Agency Agreements

### IV. ADVANCED LICENSING TOPICS

Estoppel and No Challenge Clauses  
First Sale and Exhaustion  
IP Misuse  
Antitrust and Competition Issues  
Joint Ventures  
IP Pools and Aggregators  
Bankruptcy Issues

#### **Required notices:**

#### **Law Center Attendance Policy**

As noted in the student handbook, the Law Center has a minimum 80% attendance policy for students. The ABA standards say that the Law Center must have a policy. The 80% threshold is that policy. The instructors will take attendance for each class, and you must be present for at least 80%. If a student misses more than 20% of the classes, the Office of Student Affairs (OSA) will be notified.

#### **Honor Code**

The UHLC Honor Code applies to all aspects of this course. You are responsible for knowing all Honor Code provisions and for complying with the Honor Code. Please inquire if you have any questions regarding how the Honor Code's provisions apply to specific activities or situations related to this course. Your continuing enrollment in this course is deemed to be a pledge by you under the Honor Code to comply with the Honor Code in relation to this course and to comply with the instructions in the course syllabus.

#### **Inclusion**

UHLC is committed to ensuring inclusive online and classroom learning spaces, where you will be treated with respect and dignity, and where everyone is provided the equitable opportunity to participate, to contribute, and to succeed.

In this course, all students are welcome regardless of socio-economic status, age, race, ethnicity, disability, religion, national origin, veteran's status, sex, sexual orientation, gender identity, gender expression, political affiliation, marital status and other diverse identities that we each bring to class. Our class is richer for being open to everyone.

Inclusive learning spaces facilitate the innovation and creative thought that enhance student success. This success arises from the participation, support, and understanding of you and your colleagues. I encourage you to speak up and to share your views, but also understand that you are doing so in a learning environment in which we're all expected to engage respectfully with regard to the dignity of all others.

If you feel like your class performance is impacted in any way by your experiences inside or outside of class, please reach out to us. We want to be a resource for you. If you feel more comfortable speaking with someone else, the Office of Student Affairs (OSA) is an excellent resource.

### **Mental Health and Wellness Resources**

The University of Houston has a number of resources to support students' mental health and overall wellness, including CoogsCARE and the UH Go App. UH Counseling and Psychological Services (CAPS) offers 24/7 mental health support for all students, addressing various concerns like stress, college adjustment and sadness. CAPS provides individual and couples counseling, group therapy, workshops and connections to other support services on and off-campus. For assistance visit [uh.edu/caps](http://uh.edu/caps), call 713-743-5454, or visit a Let's Talk location in-person or virtually. Let's Talk are daily, informal confidential consultations with CAPS therapists where no appointment or paperwork is needed.

The Student Health Center offers a Psychiatry Clinic for enrolled UH students. Call 713-743-5149 during clinic hours, Monday through Friday 8 a.m. - 4:30 p.m. to schedule an appointment.

The A.D. Bruce Religion Center offers spiritual support and a variety of programs centered on well-being.

Need Support Now? - If you or someone you know is struggling or in crisis, help is available. Call CAPS crisis support 24/7 at 713-743-5454, or the National Suicide and Crisis Lifeline: call or text 988, or chat [988lifeline.org](https://988lifeline.org).

### **Title IX/Sexual Misconduct**

Per the UHS Sexual Misconduct Policy, your instructor is a "responsible employee" for reporting purposes under Title IX regulations and state law and must report incidents of sexual misconduct (sexual harassment, non-consensual sexual contact, sexual assault, sexual exploitation, sexual intimidation, intimate partner violence, or stalking) about which they become aware to the Title IX office. Please know there are places on campus where you can make a report in confidence. You can find more information about resources on the Title IX website at <https://uh.edu/equal-opportunity/title-ix-sexual-misconduct/resources/>.

### **Reasonable Academic Adjustments/Auxiliary Aids**

The University of Houston is committed to providing an academic environment and educational programs that are accessible for its students. Any student with a disability who is experiencing barriers to learning, assessment or participation is encouraged to contact the Justin Dart, Jr. Student Accessibility

Center (Dart Center) to learn more about academic accommodations and support that may be available to them. Students seeking academic accommodations will need to register with the Dart Center as soon as possible to ensure timely implementation of approved accommodations. Please contact the Dart Center by visiting the website: <https://uh.edu/accessibility/> calling (713) 743-5400, or emailing [jdcenter@Central.UH.EDU](mailto:jdcenter@Central.UH.EDU).

### **Recording of Class**

Students may not record all or part of class, livestream all or part of class, or make/distribute screen captures, without advanced written consent of the instructor. If you have or think you may have a disability such that you need to record class-related activities, please contact the Justin Dart, Jr. Student Accessibility Center. If you have an accommodation to record class-related activities, those recordings may not be shared with any other student, whether in this course or not, or with any other person or on any other platform. Classes may be recorded by the instructor. Students may use instructor's recordings for their own studying and notetaking. Instructor's recordings are not authorized to be shared with anyone without the prior written approval of the instructor. Failure to comply with requirements regarding recordings will result in a disciplinary referral to the Dean of Students Office and may result in disciplinary action.

### **Security Escorts and Cougar Ride**

UHPD continually works with the University community to make the campus a safe place to learn, work, and live. The security escort service is designed for the community members who have safety concerns and would like to have a Security Officer walk with them, for their safety, as they make their way across campus. Based on availability either a UHPD Security Officer or Police Officer will escort students, faculty, and staff to locations beginning and ending on campus. If you feel that you need a Security Officer to walk with you for your safety, please call 713-743-3333. Arrangements may be made for special needs.

Parking and Transportation Services also offers a late-night, on-demand shuttle service called "Cougar Ride" that provides rides to and from all on-campus shuttle stops, as well as the MD Anderson Library, Cougar Village/Moody Towers and the UH Technology Bridge. Rides can be requested through the UH Go app. Days and hours of operation can be found at <https://uh.edu/af-university-services/parking/cougar-ride/>.