

Licensing & Tech. Transfer

- Module 2
- Implied Patent Licenses

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

Scope

Grant: IP Rights

Intention

**Genetic Implant Systems, Inc. v. Core-Vent Corp.
(Fed. Cir. 1987)**

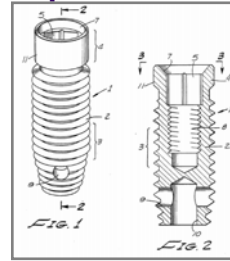
- Agreement type?
- Issue?

. . . exclusive worldwide marketing and distribution agreement with Dentsply International . . .

The appointment of a distributor to sell a product

covered by a patent is analogous to a grant of a patent license. . . .

The agreement contained other provisions similar to those typically found in a patent license agreement. Core-Vent agreed to maintain all patents covering the products and it agreed to file and prosecute applications for patents covering new products. Core-Vent also retained the right to pursue claims for infringement and it agreed to indemnify Dentsply for liability arising from any third party patent infringement action related to Dentsply's sale, use, or making of the products. Finally, Core-Vent authorized Dentsply to use Core-Vent's trademarks in marketing and distributing the products. . . .

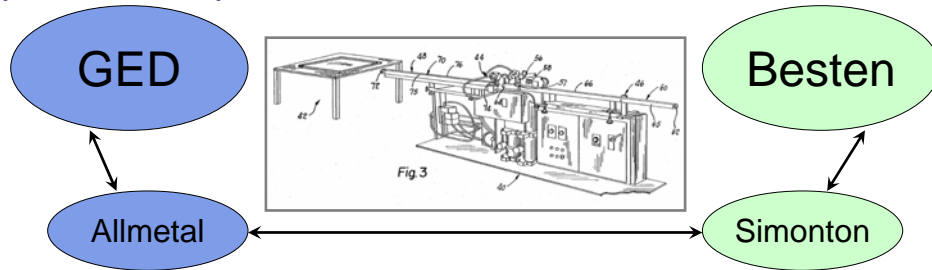


Bandag, Inc. v. Al Bolser's Tire Stores, Inc., (Fed. Cir. 1984)

- Where did Bolster buy Bandag retreads? What changed?
- Does the equipment sale exhaust any of Bandag's claims?
- Does Bandag's "no-buy-back" of the equipment help imply a license?



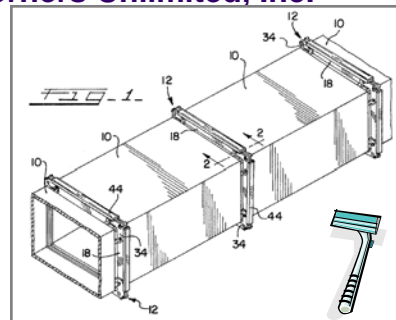
**Glass Equipment Development, Inc. v. Besten, Inc.,
(Fed. Cir. 1999)**



- Besten's implied license theory
- Patents at issue? Relation between the two?
- Federal Circuit's view of the Dist. Ct.'s implied license approach?
- Antitrust counterclaim

**Met-Coil Systems Corporation v. Korner's Unlimited, Inc.
(Fed. Cir. 1986)**

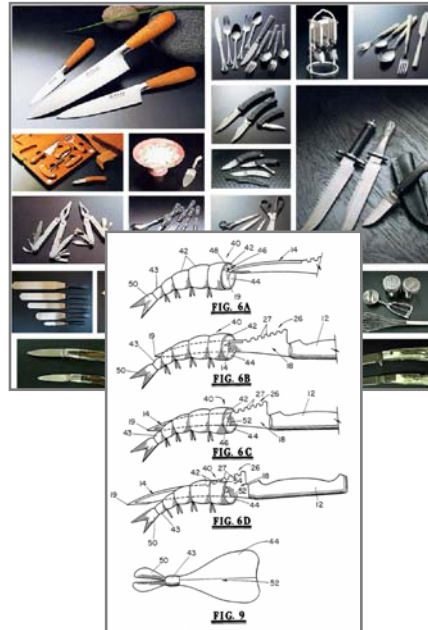
- What does Met-Coil's subsidiaries make and sell?
- What does Korner's sell?
- Who is the (alleged) direct infringer?



[(2)] A patent owner's unrestricted sales of a machine useful only in performing the claimed process and producing the claimed product "plainly indicate that the grant of a license should be inferred."

McCoy v. Mitsubishi Cutlery, Inc., (Fed. Cir. 1995)

- What did McCoy and ATD do?
- What resulted, and how did this become alleged patent infringement by Mitsubishi?
- Dist. Ct. analysis
- Fed. Cir. analysis
 - patent
 - trademark
 - Federal unfair competition
 - tortious interference



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2-7

Wang Laboratories, Inc. v. Mitsubishi Electronics America, Inc. (Fed. Cir. 1997)

- What did Wang patent?
- How did they promote it?
- What was the general effect of the promotion?
- What did Mitsubishi do?
 - What type of help did they have?
- Interaction of patents with industry standards
- Dist. Ct. result for the two patents
- Fed. Cir. analysis
 - Basis for appeal
 - Types of implied license



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2-8

Cardiovascular Diagnostics Inc. v. Boehringer Mannheim Corporation (ED NC 1997)

- Agreement & Amendment
- BMC's after-acquired patents
- Precedent
 - AMP
 - Suessen
- Does the convoluted arrangements between the parties mean that there is an implied license from BMC to CDI for the after-acquired patents?

11. LICENSE AGREEMENTS

The Company entered into a license agreement with Tokuyama Soda Company, Ltd. ("TSC"), as amended in December 1995, pursuant to which the Company granted TSC exclusive rights to manufacture and sell PT and aPTT tests and analyzers in certain Asian countries. The Company received royalty payments under this agreement of \$32,835, \$63,176 and \$46,450 during the years ended December 31 1996, 1995 and 1994, respectively.

Additionally, the Company had a license agreement with Boehringer Mannheim Corporation. The Company received royalty payments under this agreement of \$61,596 and \$88,841 during the years ended December 31, 1995 and 1994, respectively. All obligations under this license agreement were terminated effective June 30, 1995.

Anton/Bauer, Inc. v. PAG, Ltd. (Fed. Cir. 2003)

- Accused device is PAG L75 Battery Pack
- Dist. Ct. grants A/B prelim. inj.
- What is claimed?
- What does A/B supply to the market? How sold?
- Fed. Cir. analysis
 - Univis exhaustion
 - Met-Coil implied license

