

**LEGAL ISSUES IN INTELLECTUAL PROPERTY LICENSING SEMINAR
Spring 2022**

**Course Number LAW 6936
Class Number 14271**

Syllabus

Time/Place

University of Florida College of Law
Wednesday 7:00 p.m. to 9:00 p.m.
285A Holland Hall

Professor

Richard S. Vermut
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Suite 1200
Jacksonville, Florida 32202
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Office Hours

Wednesdays 5:00 to 6:00 p.m.
Wednesdays 6:00 to 7:00 p.m.

Location: 323 Holland Hall

Course Materials

The required text for this course is:

Licensing Intellectual Property in the Information Age, Second Edition, Port et al., Carolina Academic Press (2005)

The text is out of print but available on-line in digital format at the following address:

<https://redshelf.com/book/589606/licensing-intellectual-property-in-the-information-age-589606-9781531005092-kenneth-l-port-jay-dratler-jr-faye-m-hammersley-terence-p-mcelwee-charles-r-mcmanis-and-barbara-a-wrigley>

Other handouts and materials will be assigned during the semester.

Recommended Materials

Selected Intellectual Property and Unfair Competition 2021 (West)

Office Hours

Office hours are:

Wednesdays before class from 5:00 p.m. to 7:00 p.m in room 323 Holland Hall.

While you should feel free to stop by without an appointment during office hours, I highly recommend that you make an appointment to reserve the amount of time that you need, and eliminate wait time. If you

are unable to meet with me during my regularly scheduled office hours please send me an e-mail and I will be happy to arrange another mutually convenient time.

Contact Information

You can reach me during non-office hours by phone or e-mail:

(904) 807-8207

RVermut@DriverMcAfee.com

I strongly encourage you to contact me regularly during the semester and to ask any questions that you may have about the course or even more generally about the practice of law.

Course Description

In this course we will explore select legal principles, policies and issues that arise when drafting contracts that affect intellectual property rights. The topics to be covered are listed below in the weekly course assignments.

Class Preparation and Participation

Preparation for class is mandatory. Before each class you must complete the assigned reading and be prepared to provide thoughtful answers to questions that I pose during class. (Do *not* substitute commercial study aids for my assignments.)

I expect you to participate meaningfully, professionally, and effectively in this course. Exceptional preparation and participation may, at my discretion, be rewarded with an increase of your final course grade by up to one letter grade.

Those who are consistently unprepared and/or who do not participate meaningfully and professionally in class could be penalized with a deduction of up to one letter grade. My assessment of the strength of your participation in the course includes, but is not limited to, such factors as the quality of classroom comments, the amount of interest demonstrated in the subject, degree of preparation for class and willingness to respond to questions, demonstration of active engagement of the material via application to contemporaneous events, class attendance, disruptive, distracting, or unprofessional behavior in the classroom, and observance of course policies.

Please note that while I encourage the free exchange of ideas and opinions in class, expressions of disagreement must be made in a professional manner that is respectful of your classmates.

Conducting yourselves in a professional manner also means not engaging in any behavior during class that may distract me or your classmates. **This includes, but is not limited to, playing computer games, surfing the web, sending e-mails, and any other use of your computers during class that does not involve note taking.** Your failure to comply with this policy may be subject to the grade deduction for participation described above, your removal from the classroom, and/or loss of your privilege to use a laptop in the classroom.

Class Attendance

Attendance is mandatory and you are expected to be on time. It is your responsibility to locate and initial the sign-in sheet for each class session. By signing your initials you affirm that you are physically present in class during that class period. It will be considered a violation of the course rules and the Honor Code

to falsely indicate that you were present in class, or to assist a classmate in such misrepresentation. Only students who are registered in the course are permitted to attend class. Guests are not permitted without my express consent.

I have the right to excuse a student from attending a class or from meeting a class deadline for good cause shown. I will determine what constitutes good cause in my discretion and the amount of time for any deadline extension. Whenever possible, students should always request an excused absence or an extension of a deadline in advance of the class or upcoming deadline. If a student fails to make such a request in advance, the student must show why he or she was unable to do so in addition to demonstrating good cause.

A student with six (6) or more absences, will be barred from taking the final exam and/or submitting a final paper, and will automatically *fail* this course. Two (2) or more absences may result in a grade reduction as described below. The University recognized religious holidays are exempt. Please provide me with advance notification of such absences.

Grading

Course grading is determined primarily upon the final seminar paper submitted in connection with the course. The following additional considerations will be taken into account during grading and may affect a student's grade:

1. Unless excused by me, each student must submit written agreements, paper topics, paper outlines, paper drafts and final papers on or before the deadlines established for those submissions. Students will be required to draft at least two agreements, which will likely be a confidentiality and non-compete agreement, and a patent license and know-how agreement. The agreements, paper topics, paper outlines and paper drafts will not be graded. However, I expect each student to make a good faith submission of the agreements and each paper submission. I will approve paper topics and provide feedback and comments on paper outlines and paper drafts. I reserve the right to lower a student's grade for any failure to make a timely submission by the deadline, or the failure to make a submission using reasonable effort and good faith.
2. Unless excused by me each student must attend every class. I have the right to lower a student's grade for failing to attend class.
3. I may increase a student's grade by one-half letter grade for exceptional participation. Exceptional participation includes regularly volunteering in class and meaningful participation in class discussions.
4. Each student is required to volunteer for and orally brief one case listed on the syllabus during class. Students may arrange in advance with me to reserve a case for briefing.
5. The Levin College of Law's mean and mandatory distributions are posted on the College's website and this class adheres to that posted grading policy. The following chart describes the specific letter grade/grade point equivalent in place:

Letter Grade	Point Equivalent
A (Excellent)	4.0
A-	3.67
B+	3.33
B	3.0
B-	2.67

C+	2.33
C (Satisfactory)	2.0
C-	1.67
D+	1.33
D (Poor)	1.0
D-	0.67
E (Failure)	0.0

The law school grading policy is available at: <https://www.law.ufl.edu/life-at-uf-law/office-of-student-affairs/current-students/uf-law-student-handbook-and-academic-policies>.

Academic Misconduct

Academic honesty and integrity are fundamental values of the University community. Students should be sure that they understand the UF Student Honor Code at <http://www.dso.ufl.edu/students.php>.

Recording Devices and Cell Phones

Students are allowed to record video or audio of class lectures. However, the purposes for which these recordings may be used are strictly controlled. The only allowable purposes are (1) for personal educational use, (2) in connection with a complaint to the university, or (3) as evidence in, or in preparation for, a criminal or civil proceeding. All other purposes are prohibited. Specifically, students may not publish recorded lectures without the written consent of the instructor.

A “class lecture” is an educational presentation intended to inform or teach enrolled students about a particular subject, including any instructor-led discussions that form part of the presentation, and delivered by any instructor hired or appointed by the University, or by a guest instructor, as part of a University of Florida course. A class lecture does not include lab sessions, student presentations, clinical presentations such as patient history, academic exercises involving solely student participation, assessments (quizzes, tests, exams), field trips, private conversations between students in the class or between a student and the faculty or lecturer during a class session.

Publication without permission of the instructor is prohibited. To “publish” means to share, transmit, circulate, distribute, or provide access to a recording, regardless of format or medium, to another person (or persons), including but not limited to another student within the same class section. Additionally, a recording, or transcript of a recording, is considered published if it is posted on or uploaded to, in whole or in part, any media platform, including but not limited to social media, book, magazine, newspaper, leaflet, or third party note/tutoring services. A student who publishes a recording without written consent may be subject to a civil cause of action instituted by a person injured by the publication and/or discipline under UF Regulation 4.040 Student Honor Code and Student Conduct Code.

Cellular telephones should not be used during class, and ringers must be silenced.

Assignments

Below are the updated reading assignments for the course. I *reserve the right to modify* the assignments from time to time, and to utilize additional handouts and materials. All assignments are from the required text unless otherwise noted.

Exam Delays and Accommodations

The law school policy on exam delays and accommodations can be found [here](#).

Online Course Evaluation Process

Students are expected to provide professional and respectful feedback on the quality of instruction in this course by completing course evaluations online via GatorEvals. Click [here](#) for guidance on how to give feedback in a professional and respectful manner. Students will be notified when the evaluation period opens and may complete evaluations through the email they receive from GatorEvals, in their Canvas course menu under GatorEvals, or via <https://ufl.bluer.com/ufl/>. Summaries of course evaluation results are available to students [here](#).

Workload/Class Preparation and Requirements

Students should expect to spend, on average, approximately two hours preparing for every hour of class. Reading assignments are set forth below in the syllabus and may be available on-line as posted by the Law School. ABA Standard 310 requires that students devote 120 minutes to out-of-class preparation for every “classroom hour” of in-class instruction. This course has 2 “classroom hours” of in-class instruction each week, requiring at least 4 hours of preparation outside of class. Accordingly, you will have about 120 pages of reading each week, on average throughout the semester.

Student Learning Outcomes

After completing this course, students should be able to:

1. Demonstrate an understanding of the general principals of licensing trade secrets and confidential information and drafting non-competition agreements in Florida, and the strategy of using contract law to protect information not otherwise protected by traditional intellectual property law.
2. Demonstrate an understanding of the general legal principals of licensing and transferring ownership of patents, copyrights and trademarks and explain the legal principals and statutes governing those agreements.
3. Provide basic advice to clients on the drafting intellectual property license agreements with an understanding of the general principals of license drafting and of the issues that arise for licensors and licensees.
4. Understand the principals of antitrust and misuse law that affect the licensing and use of intellectual property.
5. Understand the principals of licensing computer software and technology.
6. Understand the fundamentals of interviewing a client and drafting and preparing confidentiality and non-compete agreements, and intellectual property licensing, through drafting those agreements and reviewing their terms and understanding the underlying concepts, themes and strategies.
7. Understand and experience the requirements for drafting an article or comment on an area of intellectual property licensing, including identifying issues, organizing and drafting the paper, and conducting legal research with citations to support an argument, position and facts.

The weekly class reading assignments are as follows:

Week 1 - January 19

Licensing Introduction

Pages 3-22

Overview of Intellectual Property Law

Pgs. 23-95

Skim the cases

Cases on Patents: Graham v. John Deere, Diamond v. Chakrabarty, State Street Bank & Trust Co. v. Signature Financial Group, Inc.

Cases on Copyrights: Baker v. Seldon, Feist Publications, Inc. v. Rural Telephone Services Co., Inc., Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.

Cases on Trademarks: United States v. Steffens, Abercrombie & Fitch Co. v. Hunting World, Inc., Qualitex v. Jacobson Products, Co., Wal-Mart Stores, Inc. v. Samara Brothers, Inc.

Week 2 - January 26

Overview of Intellectual Property Law (Cont'd)

Trade Secrets

- Uniform Trade Secrets Act (with 1985 Amendments)
- Florida Statutes §§ 688.01 *et seq.* (Uniform Trade Secret Act)

Pgs. 128-141

Nilssen v. Motorola, Inc.

Noncompetition Agreements

- Florida Statutes §§ 542.335 *et seq.* (covenants not-to-compete)

Week 3 – February 2

Trade Secrets and Noncompetition Agreements (Cont'd)

Ownership, Assignments and Licenses Generally

Implied Licenses

Pgs. 333-355

Western Electric Co. Inc. v. Pacent Reproducer Corp., De Forest Radio Telephone & Telegraph Co. v. U.S.

Quanta Computer, Inc. v. LG Electronics, Inc., 553 U.S. 617 (2008) (not in case book)

Week 4 - February 9

Ownership, Assignments and Licenses Generally (Cont'd)

Key Provisions in License Agreements and Special Types of License Agreements

Pgs. 287-332

Read the following cases (Professor will e-mail them):

Talbot v. Quaker-State Oil Refining Co., Why Corp. v. Super Ironer Corp., Filmtec Corp. v. Allied-Signal, Inc., and Richardson v. Suzuki Motor Co., Ltd.

Week 5 - February 16

Licenses Generally (Cont'd)

Read the following cases (Professor will e-mail them):

Leese v. Bernard Gloekler Co., Waterman v. Mackenzie, United States v. Dubilier Condenser Corp., Ushakoff v. United States, North Branch Products, Inc. v. Fisher, Unarco Indus., Inc. v. Kelley Co., Inc., Bristol Locknut Co. v. SPS Technologies, Inc., Meehan v. PPG Industries, Inc., Dwight & Lloyd Sintering Co., Inc. v. American Ore Reclamation Co., and Roberts v. Sears, Roebuck & Co.

Medimmune, Inc. v. Genentech, Inc., 549 U.S. 118 (2007) (not in case book)

Week 6 - February 23

Review a confidentiality agreement and related documents

Week 7 – March 2

Computer Software

Shrink-Wrap and Click-Wrap Licenses

Pgs. 355-387

ProCD, Inc. v. Zeidenberg, Hill v. Gateway 2000, Inc., Specht v. Netscape Communications Corp.

License Agreements Prohibitions and Preemption

Pgs. 387-423

Bowers v. Baystate Technologies, Inc.

Week 8 - March 9

No Class - Spring Break

Week 9 - March 16

Computer Software (continued)

Week 10 - March 23

Licensing Litigation and Trends in Judicial Enforcement

Licensee Estoppel

Pgs. 567-579

Lear v. Adkins, Diamond Scientific v. Ambico, Inc., Seven-Up bottling Co. v. The Seven-Up Co., Deer Park Spring Water, Inc. v. Appalachian Mountain Spring Water Co., Twin Books Corp. v. The Walt Disney Co.

Enforcing License Agreements

Pgs. 590-630

Rhone-Poulenc Agro, S.A. v. DeKalb Genetics Corp., v. Monsanto Co., PPG Industries, Inc. v. Guardian Industries, Corp., Burlington Indus. v. Solutia, Inc., Sun Microsystems, Inc. v. Microsoft Corp., Texas Instruments, Inc. v. Tessera, Inc., and U.S. International Trade Commission, Microchip Technology, Inc. v. U.S. Phillips Corp. and Phillips Electronics North America Corp.

Week 11 - March 30

Antitrust and Misuse Issues in Licensing

Pgs. 425-516

Lasercomb America, Inc. v. Reynolds

Patent Misuse and Hybrid Licenses

Pgs. 580-590

Brulotte v. Thys Co., Aronson v. Quick Point Pencil Co., Scheiber v. Dolby Laboratories, Inc. and Dolby Laboratories Licensing Corp.

Supplemental Materials for Week 11 (Professor will provide)

Morton Salt Co. v. G. S. Suppiger Co., United States v. Studiengesellschaft Kohle, Dawson Chemical Co. v. Rohm & Haas Co., Mallinckrodt, Inc. v. Medipart Inc.

Additional cases (not in case book)

Kimble v. Marvel Entertainment, LLC, 576 U.S. ____ (2015)

Kirtsaeng v. John Wiley & Sons, Inc., 568 U.S. 519 (2013)

Impression Products, Inc. v. Lexmark International, Inc., 581 U.S. ____ (2017)

Week 12 - April 6

Antitrust (continued)

Review a patent license agreement

Week 13 - April 13

Student presentations

Week 14 - April 20

Student presentations