

# Table of Contents

## CHAPTER 1. INTRODUCTION TO LICENSING ISSUES

- § 1:1 Definition of license
- § 1:2 Comparison of assignments and licenses
- § 1:3 Creation of licenses
- § 1:4 —Express licenses
- § 1:5 —Implied licenses
- § 1:6 Types of rights licensed
- § 1:7 Exclusive licenses
- § 1:8 Non-exclusive licenses
- § 1:9 Choosing between exclusive and nonexclusive license
- § 1:10 Future rights; “fluid” membership in licensee class
- § 1:11 Restricted licenses
- § 1:12 —Duration
- § 1:13 —Manufacture, use or sale
- § 1:14 —Field of use
- § 1:15 —Geography
- § 1:16 —Quantity
- § 1:17 —Standing to sue
- § 1:18 License negotiations
- § 1:19 —Evaluation of market value

## CHAPTER 2. CONTRACT LAW ASPECTS OF LICENSES

- § 2:1 Laws governing: Federal or State
- § 2:2 Forum: Federal or State
- § 2:3 Forum selection clauses; interpretation and enforcement
- § 2:4 Laws governing: Federal or State—Choice of law provisions
- § 2:5 Choice of law clause applied to forum selection clause
- § 2:6 Federal preemption of state contract law
- § 2:7 —Federal substantive law affecting licenses and assignments
- § 2:8 —Copyrights
- § 2:9 —Mask works
- § 2:10 —Patents
- § 2:11 —Trademarks
- § 2:12 —Effects of releases of federally created rights
- § 2:13 Requirements for formation of a license or assignment agreement
- § 2:14 —Agreement to agree
- § 2:15 —Requirement of a writing
- § 2:16 —Statute of frauds

- § 2:17 — —Recovery for consideration rendered
- § 2:18 — —Writing satisfying the statute
- § 2:19 — —Other means of satisfying the statute
- § 2:20 — —Other statutes
- § 2:21 — —Formal written agreements
- § 2:22 —Sufficient consideration arrived at through bargaining
- § 2:23 — —Patent rights
- § 2:24 — —Trade secrets and know-how
- § 2:25 — —Uncopyrightable idea
- § 2:26 — —Implied covenant of good faith and fair dealing
- § 2:27 Promissory estoppel
- § 2:28 Assignability
- § 2:29 Warranty of validity of the licensed patent
- § 2:30 Best efforts obligation
- § 2:31 Right to sue for past infringement
- § 2:32 Obligation to sue infringers
- § 2:33 Exclusion of exclusive licensor
- § 2:34 Assignment for purposes of litigation
- § 2:35 Right to sublicense
- § 2:36 Construction and interpretation of license or assignment agreements
- § 2:37 Ambiguity
- § 2:38 Parol evidence rule
- § 2:39 —Exceptions to the rule
- § 2:40 —Inapplicability of the rule
- § 2:41 — —Fraud
- § 2:42 — —Mistake
- § 2:43 — —Non-existence of the contract
- § 2:44 Implied licenses
- § 2:45 —Shop right
- § 2:46 —Permissible repair
- § 2:47 —License to complete a patented combination
- § 2:48 —License to use purchased device
- § 2:49 —Use and sale of parts purchased from patentee or authorized sources
- § 2:50 —Equitable license
- § 2:51 —License to remedy patentee's breach
- § 2:52 —Implied license resulting from express grants
- § 2:53 Breach of the license agreement
- § 2:54 —Major or material breach
- § 2:55 —Minor breach
- § 2:56 —Anticipatory repudiation
- § 2:57 —Damages
- § 2:58 Rejection of patent application
- § 2:59 Rescission of license agreement
- § 2:60 —Fraud in the inducement
- § 2:61 —Mistake
- § 2:62 —Mutual assent
- § 2:63 New use

## TABLE OF CONTENTS

- Appendix 2A. Patent Law Provisions on Assignments
- Appendix 2B. Copyright Law Provisions on Transfer of Ownership
- Appendix 2C. Copyright Law Provisions on Ownership and  
Transfer of Mask Works
- Appendix 2D. Lanham Act Provision on Assignment of Trademarks

## CHAPTER 3. THE LICENSE AGREEMENT

- § 3:1 Overview and strategy
- § 3:2 Special patent considerations
- § 3:3 The introduction
  - § 3:4 —Consideration
- § 3:5 Recitals
- § 3:6 Definitions
  - § 3:7 —Patent rights
  - § 3:8 —Know-how; confidential or trade secret information
  - § 3:9 —Inventions
  - § 3:10 —Sale
  - § 3:11 —Elements of royalty and payments
  - § 3:12 —Subsidiaries and affiliates
- § 3:13 Duration of license
- § 3:14 Granting clause
  - § 3:15 —Intellectual rights transferred
- § 3:16 Exclusivity
- § 3:17 Territorial limits
- § 3:18 Restrictions on use
- § 3:19 Restrictions on quantity
- § 3:20 Restrictions on sales
- § 3:21 Right to sublicense
- § 3:22 Assignability
- § 3:23 Fixed fee payments
  - § 3:24 —Lump sum payments
  - § 3:25 — —Installment payments
  - § 3:26 —Initial payment
- § 3:27 Royalty payments
  - § 3:28 —Royalty basis
  - § 3:29 —Royalty rate
  - § 3:30 —Variable royalties
  - § 3:31 —Minimum royalty clauses
  - § 3:32 —Changes of royalty rates
- § 3:33 Payments for maintenance of licensed rights
- § 3:34 Other fees
- § 3:35 Best efforts clause
- § 3:36 Confidentiality clause
- § 3:37 Grant back clauses
- § 3:38 Patent markings clauses
- § 3:39 No contest clauses
- § 3:40 Records and reports clause

- § 3:41 Most favored nation clause
- § 3:42 Warranties
- § 3:43 —Implied warranties
- § 3:44 —Express warranty of title
- § 3:45 —Express warranty of non-infringement
- § 3:46 Disputes involving third party's patents
- § 3:47 Release for past infringement
- § 3:48 Equipment
- § 3:49 Technical assistance
- § 3:50 Quality control
- § 3:51 Liability and indemnification
- § 3:52 —Insurance
- § 3:53 —General liability release for employees
- § 3:54 Prior approval of changes
- § 3:55 Termination clauses
- § 3:56 Post-termination obligations clauses
- § 3:57 —Return of information and tangible property
- § 3:58 —Royalties
- § 3:59 —No-compete
- § 3:60 Termination—Access
- § 3:61 Force majeure
- § 3:62 Arbitration
- § 3:63 Choice of law and forum
- § 3:64 Damages
- § 3:65 Notice
- § 3:66 Waiver clause
- § 3:67 Severability clause
- § 3:68 Integration and merger clauses
- § 3:69 Amendments clause

## CHAPTER 4. PATENTS

- § 4:1 Patent reform
- § 4:2 Patent rights in general
- § 4:3 Utility patents
- § 4:4 Design patents
- § 4:5 —Combination utility and design patents
- § 4:6 Plant patents
- § 4:7 Pioneer patents
- § 4:8 Process patents
- § 4:9 —America Invents Act and covered business methods
- § 4:10 —Infringement
- § 4:11 Combination patents
- § 4:12 Patent estate
- § 4:13 Inventions
- § 4:14 —Distinguished from ideas
- § 4:15 —Patent and literature searches
- § 4:16 —Grace period
- § 4:17 Printed matter

## TABLE OF CONTENTS

§ 4:18	Patent applications
§ 4:19	—America Invents Act
§ 4:20	—Inventorship
§ 4:21	—Disclosure and description
§ 4:22	—America Invents Act—Best mode
§ 4:23	— —Third party submissions
§ 4:24	—Hague Agreement concerning International Registration of Industrial Designs
§ 4:25	Derivation proceedings
§ 4:26	Patent applications—Inequitable conduct
§ 4:27	—America Invents Act—Supplemental examination
§ 4:28	—Appeals
§ 4:29	—America Invents Act—Inter partes review
§ 4:30	— —Amending claims
§ 4:31	Duration
§ 4:32	Patent rights
§ 4:33	—Right to exclude
§ 4:34	—Third parties
§ 4:35	Claimed invention
§ 4:36	Patentability
§ 4:37	—Novelty and Prior Art; America Invents Act
§ 4:38	—Public use
§ 4:39	—America Invents Act—Prior art—Tax strategies
§ 4:40	—Nonobviousness
§ 4:41	Nonobviousness—Double patenting
§ 4:42	Patentability—America Invents Act—Nonobviousness
§ 4:43	—Reexamination based on prior art
§ 4:44	—Utility
§ 4:45	Marking
§ 4:46	—False marking
§ 4:47	— —America Invents Act
§ 4:48	Literal infringement
§ 4:49	Construing the claim
§ 4:50	—Procedure
§ 4:51	Claim construction—Appellate review
§ 4:52	Equivalents
§ 4:53	Remedies
§ 4:54	—Injunction
§ 4:55	—Injunction-Contempt
§ 4:56	—Damages
§ 4:57	—Increased damages
§ 4:58	Patents—Post-grant review
§ 4:59	— —Grant of review
§ 4:60	— —Related proceedings
§ 4:61	—Decision and appeal
§ 4:62	Remedies—Damages—Design patents
§ 4:63	—Increased damages—Advice of counsel
§ 4:64	—Standard setting and RAND

- § 4:65 —Joinder of parties
- § 4:66 —Prejudgment interest
- § 4:67 Joint inventorship actions
- § 4:68 Patent assertion entities
- § 4:69 Attorney fees
- § 4:70 Costs
- § 4:71 First inventor defense
- § 4:72 Prior commercial use defense
- § 4:73 Laches
- § 4:74 —Length of delay
- § 4:75 Equitable estoppel
- § 4:76 Collateral estoppel
- Appendix 4A. 2019 Revised Patent Subject Matter Eligibility Guidance
- Appendix 4B. American Innovation at Risk: the Case for Patent Reform (Federal Trade Commission, Feb. 15, 2007)
- Appendix 4C. Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.
- Appendix 4D. A Guide to Filing A Non-Provisional (Utility) Patent Application U.S. Patent and Trademark Office
- Appendix 4E. A Guide To Filing A Design Patent Application U.S. Patent and Trademark Office
- Appendix 4F. Pilot Program for Green Technologies Including Greenhouse Gas Reduction
- Appendix 4G. Rules of Practice for Trials before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions
- Appendix 4H. Patent Trial and Appeal Board Consolidated Trial Practice Guide (Abridged) (Nov. 2019)
- Appendix 4I. Changes to Implement Post-Grant Review Proceedings
- Appendix 4J. Changes to Implement Transitional Program for Covered Business Method Patents
- Appendix 4K. Transitional Program for Covered Business Method Patents—Definition of Technological Invention
- Appendix 4L. Changes to Implement Derivation Proceedings
- Appendix 4M. Changes to Implement the Inventor’s Oath or Declaration Provisions of the Leahy-Smith America Invents Act
- Appendix 4N. Changes to Implement the First Inventor to File Provisions of the Leahy-Smith America Invents Act
- Appendix 4O. Examination Guidelines for Implementing the First

## TABLE OF CONTENTS

	Inventor To File Provisions of the Leahy-Smith America Invents Act
Appendix 4P.	Rules and Regulations: Changes to Implement the Patent Law Treaty—Summary
Appendix 4Q.	Patent Assertion Entity Activity: An FTC Study
Appendix 4R.	Patent Cooperation Treaty
Appendix 4S.	Patent and Trademark Office: PTAB Rules of Practice for Instituting on All Challenged Patent Claims and All Grounds and Eliminating the Presumption at Institution Favoring Petitioner as to Testimonial Evidence (abridged) (Dec. 9, 2020)
Appendix 4T.	Rules of Practice to Allocate the Burden of Persuasion on Motions to Amend in Trial Proceedings Before the Patent Trial and Appeal Board
Appendix 4U.	Patent and Trademark Office: COVID-19 Prioritized Examination Pilot Program (abridged) (May 14, 2020)
Appendix 4V.	Copyright Registration Guidance: Works Containing Material Generated by Artificial Intelligence

## CHAPTER 5. COPYRIGHTS

§ 5:1	Subject matter
§ 5:2	—Combination of utilitarian and artistic features
§ 5:3	Nature of rights; right to prevent unauthorized copying
§ 5:4	—Moral rights
§ 5:5	Limitations on rights of copyright ownership
§ 5:6	—Fair use
§ 5:7	—Libraries
§ 5:8	Copying services
§ 5:9	Limitations on rights of copyright ownership—First sale doctrine
§ 5:10	—Works for hire
§ 5:11	—Government edicts doctrine
§ 5:12	—Collective works
§ 5:13	Duration
§ 5:14	—Works created after January 1, 1978
§ 5:15	—Works created before but published or copyrighted after January 1, 1978
§ 5:16	Copyright duration—Subsisting copyrights
§ 5:17	—Renewal
§ 5:18	—Renewal term: assignment
§ 5:19	Copyright notice
§ 5:20	—Form
§ 5:21	—Requirement and effect
§ 5:22	—Collective works
§ 5:23	—Corrections
§ 5:24	Registration and deposit of copyrights

- § 5:25 —Requirement
- § 5:26 —Procedure for registration
- § 5:27 —Collective works
- § 5:28 —News websites
- § 5:29 —Registration refused
- § 5:30 Registration and deposit of copyright—Inaccurate information
- § 5:31 Berne Convention; Uruguay Round Agreements Act
- § 5:32 Infringement
- § 5:33 —Joint ownership defense
- § 5:34 —Copyright estoppel
- § 5:35 —Internet
- § 5:36 —Defense of license
- § 5:37 —Internet—Limitations on liability
- § 5:38 —Sampling of music recordings
- § 5:39 —Use after license terminated
- § 5:40 Remedies
- § 5:41 —Standing of exclusive licensee
- § 5:42 —Compilations
- § 5:43 —Impounding and disposition of infringing articles; criminal violations
- § 5:44 —Copyright Remedy Clarification Act
- § 5:45 —Statute of limitations
- § 5:46 Anti-bootlegging statute
- § 5:47 Costs
- § 5:48 Attorney fees
- § 5:49 Common law protection for sound recordings
- § 5:50 Compulsory license of musical works—Music Modernization Act
- § 5:51 — —Musical Works Modernization Act
- § 5:52 — —Classics Protection and Access Act
- § 5:53 — —Allocations for Music Producers
- § 5:54 Receiving agents and the Webcaster Settlement Act of 2008
- Appendix 5A. Address of J. Thomas Rosch, Commissioner, A Different Perspective on DRM (Digital Rights Management) (Mar. 9, 2007)
- Appendix 5B. Address of Marybeth Peters, Register of Copyrights, Ensuring Artists Fair Compensation: Updating the Performance Right and Platform Parity for the 21st Century (July 31, 2007)
- Appendix 5C. Compulsory License for Making and Distributing Phonorecords, Including Digital Phonorecord Deliveries
- Appendix 5D. Resale Royalties: An Updated Analysis
- Appendix 5E. Group Registration of Newspapers Proposed Rules (2017)

## CHAPTER 6. TRADEMARKS

- § 6:1 Definitions



## TABLE OF CONTENTS

§ 6:2	Creation of rights
§ 6:3	—Territoriality principle
§ 6:4	Requirements for protection
§ 6:5	—Proper names
§ 6:6	—Geographic discription
§ 6:7	—Geographic description—Misdescription
§ 6:8	—Government insignia
§ 6:9	—Disparagement
§ 6:10	—Immoral or scandalous matter
§ 6:11	Tacking
§ 6:12	Registration
§ 6:13	—Federal procedure
§ 6:14	—Foreign registrants
§ 6:15	—U.S. licensed attorney
§ 6:16	—Federal procedure—Fraud
§ 6:17	—Duration
§ 6:18	—Secondary register
§ 6:19	—State registration
§ 6:20	—Madrid Protocol
§ 6:21	“Genericide”
§ 6:22	Abandonment
§ 6:23	Acquiescence
§ 6:24	Licensing
§ 6:25	—Quality control
§ 6:26	—Naked assignment
§ 6:27	Licensing-Merger rule
§ 6:28	Enforcement
§ 6:29	Discovery: Patent and Trademark Office proceedings
§ 6:30	Infringement suits
§ 6:31	—Confusion
§ 6:32	—Reverse confusion
§ 6:33	—Confusion—Issue preclusion
§ 6:34	— —Parody
§ 6:35	—Unauthorized sale
§ 6:36	—Contributory infringement
§ 6:37	—Remedies available
§ 6:38	—Attorney’s fees
§ 6:39	—Remedies available—Injunctions
§ 6:40	— —Lost profits
§ 6:41	— —Corrective advertising
§ 6:42	—Fair use
§ 6:43	—First sale doctrine
§ 6:44	—First Amendment
§ 6:45	—Federal courts
§ 6:46	— —Authorized use
§ 6:47	— —Extraterritoriality
§ 6:48	—State courts
§ 6:49	—Anti-dilution statutes

- § 6:50 — —Trademark Dilution Revision Act of 2006
- § 6:51 — —State statutes
- § 6:52 — —Trademark Counterfeiting Act
- § 6:53 — —Civil remedies
- § 6:54 — —Criminal sanctions
- § 6:55 — —False endorsement
- § 6:56 — —Liability of Internet site for counterfeit sales
- § 6:57 — —Enforcement by U.S. Customs
- § 6:58 — —Laches and progressive encroachment
- § 6:59 — —Relationship to copyright protection

Appendix 6A. Change of Ownership

Appendix 6B. Requirement of U.S. Licensed Attorney for Foreign  
Trademark Applicants and Registrants (2019)  
(Abridged)

Appendix 6C. Madrid Protocol

Appendix 6D. Trademark Manual of Examining Procedure

## CHAPTER 7. TRADE DRESS

- § 7:1 Purpose and definition
- § 7:2 Bases for protection
- § 7:3 Requirements for protection
- § 7:4 Requirements for protection under trademark theory—  
Nonfunctionality
- § 7:5 — —Color
- § 7:6 — —Multi-features
- § 7:7 Requirements for protection—Distinctiveness
- § 7:8 Requirements for protection under trademark theory—  
Inherent distinctiveness; secondary meaning—Product  
design
- § 7:9 Likelihood of confusion
- § 7:10 Infringement
- § 7:11 Dilution
- § 7:12 Palming Off
- § 7:13 Conflict between trade dress and other laws
- § 7:14 — —Copyright
- § 7:15 — —Patents

## CHAPTER 8. ANTI-BOOTLEGGING STATUTE

- § 8:1 In general
- § 8:2 Forfeiture
- § 8:3 Hybrid rights
- § 8:4 Right to record or re-communicate
- § 8:5 Constitutionality