



TECHNOLOGY LICENSING

FALL 2008

**KARL F. JORDA
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SYLLABUS

TECHNOLOGY LICENSING

August 25-December 5, 2008

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General:

The emphasis in this course will be on creative, domestic and foreign licensing arrangements involving licensing patents, trade secrets and trademarks (including franchising), understanding and drafting some of the more important basic clauses, valuation and royalty determinations, actual licensing situations, antitrust and misuse problems and negotiation and administration of license agreements.

This course will include both licensing your client's intellectual property to another and licensing intellectual property from another to your client.

A technological background is not a prerequisite, but some knowledge of intellectual property law (patents, trade secrets and trademarks) is necessary for this course.

Grade:

40% — Creative Licensing Problem

60% — Final Exam

Course Materials:

1. Photocopied Course Materials
2. Materials On Reserve in Library
3. Drafting Patent License Agreements, Brian G. Brunsvold, Dennis P. O'Reilly, Fifth Edition.

OBJECTIVES:

1. Be familiar with basic concepts and principles in the field of technology licensing.
2. Be able to think in terms of technology licensing concepts and principles.
3. Correctly use terminology related to technology licensing.
4. Be familiar with sources of information, tools and techniques involved in the technology licensing process.
5. Be able to analyze and resolve technology licensing issues and problems as might arise in real life.
6. Understand that technology licensing can be a very creative activity that is very useful in developing business strategies.
7. This course relates to and enhances other courses, such as, Contracts, Patents and Trade Secrets, Trademarks and IP Management, which you have already taken, are taking now or will take in the future.

CLASS 1. THURSDAY, August 28, 3:00-5:00PM

Introduction to Course

Licensable Properties

Integration of IPRs

Reading assignment:

1. Jay Dratler — “Overview of Intellectual Property” — ON RESERVE
2. Course Materials, pp.1-29
3. Brunsvold, Appendix A

CLASS 2. THURSDAY, SEPTEMBER 4, 3:00-5:00PM

Historical and General Background

Reading assignment:

1. Basil Bard — “The Historical Role of Licensing...” — ON RESERVE
2. Course Materials, pp.30-52

CLASS 3. THURSDAY, SEPTEMBER 11, 3:00-5:00PM

Patent Licensing

Reading assignment:

Course Materials, pp.53-70

Drafting Patent License Agreements

Reading assignment:

1. Course Materials, pp.71-77
2. Brunsvold, Chapters 1-6

CLASS 4. THURSDAY, SEPTEMBER 18, 3:00-5:00PM

Drafting Patent License Agreements (continued)

Reading assignment

1. Course Materials, pp.78-99
2. Brunsvold, Chapters 7, 9, 11-16

CLASS 5. THURSDAY, SEPTEMBER 25, 3:00-5:00PM

Drafting Patent License Agreements (continued)

Reading assignment:

1. Brunsvold, Chapters 17-18, 20
2. Brunsvold, Appendices B-E (OPTIONAL)

CLASS 6. THURSDAY, OCTOBER 2, 3:00-5:00PM

IP Valuation and Royalty Setting

Reading assignment:

1. Martin Landis — “Pricing...Technology” — ON RESERVE
2. Tom Arnold — “100 Factors...” — ON RESERVE
3. Course Materials, pp.100-127, APPENDICES pp.477-488
4. Brunsvold, Chapter 10

CLASS 7. THURSDAY, OCTOBER 9, 3:00-5:00PM

Clock Calculator and Gould Laser Patents Case Histories

Reading assignment:

Course Materials, pp.128-136, 137-140 (OPTIONAL)

CLASS 8. THURSDAY, OCTOBER 16, 3:00-5:00PM

Trade Secrets

Reading Assignment:

Course Materials, pp.141-160, APPENDICES pp.489-492

CLASS 9. THURSDAY, OCTOBER 23, 3:00-5:00PM

Trade Secret Licensing

Reading assignment:

1. Ken Payne — “Trade Secret Licensing” — ON RESERVE
2. Course Materials, pp.161-215
3. Brunsvold, Appendices F, H (OPTIONAL)

Illustrative Licenses

Reading assignment:

Course Materials, pp.216-247

CLASS 10. THURSDAY, OCTOBER 30, 3:00-5:00PM

Trademark Licensing

1. Siegrun Kane — “Assigning a Trademark” — ON RESERVE
2. Siegrun Kane — “Licensing a Trademark” — ON RESERVE
3. Course Materials, pp.248-264

Franchising

Reading assignment:

Course Materials, pp.265-277

CLASS 11. THURSDAY, NOVEMBER 6, 3:00-5:00PM

Misuse and Antitrust Considerations

Reading assignment:

Course Materials, pp.278-295

CLASS 12. THURSDAY, NOVEMBER 13, 3:00-5:00PM

International Licensing/Technology Transfer

Reading assignment:

1. William Brunet — “International Licensing and Technology Transfer” — ON RESERVE

2. Course Materials, pp.296-371

3. Brunsvold, Chapter 22

CLASS 13. THURSDAY, NOVEMBER 20, 3:00-5:00PM

Due Diligence, Licensing Negotiations, Bankruptcy and Licenses and Administration of Licensing Program

Reading assignment:

1. William Venema — “Intellectual Property Due Diligence” — ON RESERVE

2. Course Materials, pp.372-390

FINAL EXAM

Open book exam. Bring any materials you want.

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