

**LEGAL ISSUES IN INTELLECTUAL PROPERTY LICENSING SEMINAR  
Spring 2023**

**Course Number LAW 6936  
Class Number 13934**

**Syllabus**

**Time/Place**

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

**Professor**

Richard S. Vermut  
Driver, McAfee, Hawthorne & Diebenow, PLLC  
One Independent Drive  
Suite 1200  
Jacksonville, Florida 32202  
(904) 807-8207 / RVermut@DriverMcAfee.com

**Office Hours**

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

Location: TBD

**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 2023 (West)

**Office Hours**

Office hours are:

Wednesdays before class from 5:00 p.m. to 7:00 p.m in room TBD.

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 and Objectives**

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 in 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 Policy**

Attendance is mandatory and you are expected to be on time. Attendance in class is required by both the ABA and the Law School. Attendance will be taken at each class meeting. It is your responsibility to locate and sign the sign-in sheet for each class session. By signing the sheet, 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.

Students are allowed two (2) absences during the course of the semester. Students are responsible for ensuring that they are not recorded as absent if they come in late. A student who fails to meet the attendance requirement will be dropped from the course. The law school's policy on attendance can be found [here](#).

### **Observance of Religious Holidays:**

UF Law respects students' [observance of religious holidays](#).

- Students, upon prior notification to their instructors, shall be excused from class or other scheduled academic activity to observe a religious holy day of their faith.
- Students shall be permitted a reasonable amount of time to make up the material or activities covered in their absence.
- Students shall not be penalized due to absence from class or other scheduled academic activity because of religious observances.

### **Statement Related To Accommodations For Students With Disabilities**

Students requesting accommodations for disabilities must first register with the Disability Resource Center (<https://disability.ufl.edu/>). Once registered, students will receive an accommodation letter, which must be presented to the Assistant Dean for Student Affairs (Assistant Dean Brian Mitchell). Students with disabilities should follow this procedure as early as possible in the semester. It is important for students to share their accommodation letter with their instructor and discuss their access needs as early as possible in the semester. Students may access information about various resources on the UF Law Student Resources Canvas page, available at <https://ufl.instructure.com/courses/427635>.

### **Course Expectations and Grading Evaluation**

Students will be evaluated, and course grading will be 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 [here](#).

### **Compliance With UF Honor Code**

Academic honesty and integrity are fundamental values of the University community. Students should be sure that they understand the UF Law Honor Code located [here](#). The UF Law Honor Code also prohibits use of artificial intelligence, including, but not limited to, ChatGPT and Harvey, to assist in completing quizzes, exams, papers, or other assessments.

### **Recording Devices and Cell Phones**

All classes will be recorded via Mediasite in case students must miss class for health reasons. The Office of Student Affairs will work with faculty to determine when students may have access to these recordings, and the recordings will be password protected. It is the student's responsibility to contact the Office of Student Affairs as soon as possible after an absence.

Publication without the 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](#).

### **Student Course Evaluations**

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](#).

### **ABA Out-Of-Class Hours Requirements**

ABA Standard 310 requires that students devote 120 minutes to out-of-class preparation for every “classroom hour” of in-class instruction. Each weekly class is approximately 2 hours in length, requiring at least 4 hours of preparation outside of class including reading the assigned materials, drafting agreements, and developing your final paper.

### **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 principles of licensing and transferring ownership of patents, copyrights and trademarks and explain the legal principles and statutes governing those agreements.
3. Provide basic advice to clients on drafting intellectual property license agreements with an understanding of the general principles 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 principles 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.

### **Required Reading Materials**

Please be sure to register for the Canvas course and have any required materials with you in print or easily accessible electronic form in class. You are responsible for checking your Canvas page and the e-mail connected to the page on a regular basis for any class announcements or adjustments.

### **Course Schedule of Topics and Assignments**

This syllabus is offered as a guide to the direction of the course. Our pace will depend in part on the level of interest and the level of difficulty of each section and is subject to change. The weekly reading assignments are set forth below on the remaining pages of this Syllabus.

## **Week 1 - January 18**

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 25**

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 1**

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)

Kirtsaeng v. John Wiley & Sons, Inc., 568 U.S. 519 (2013) (not in case book)

Impression Products, Inc. v. Lexmark International, Inc., 581 U.S. \_\_\_\_ (2017) (not in case book)

## **Week 4 - February 8**

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 15**

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.

Minerva Surgical Inc. v. Hologic Inc., 594 U.S. \_\_\_\_ (2021) (not in case book)  
Medimmune, Inc. v. Genentech, Inc., 549 U.S. 118 (2007) (not in case book)

**Week 6 - February 22**

Review a confidentiality agreement and related documents

**Week 7 – March 1**

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.

HIQ Labs, Inc. v. LinkedIn Corp., 938 F.3d 985 (9th Cir. 2019) (not in case book)

**Week 8 - March 8**

Computer Software (continued)

**Week 9 - March 15**

No Class - Spring Break



**Week 10 - March 22**

## 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 29**

## 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. 446 (2015)

**Week 12 - April 5**

## Antitrust (continued)

## Review a patent license agreement

**Week 13 - April 12**

## Student presentations

**Week 14 - April 19**

## Student presentations