Transactional Intellectual Property: From Startups to Public Companies
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A Successor to Intellectual Property in Business Organizations: Cases and Materials

FOURTH EDITION

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Dedication

For Marie — R.S.G.
For Soma — S.G.
For my parents, maternal grandmother and maternal uncles — J.P.K.
Preface

Intellectual property (IP) is a pervasive concern in modern society. Individuals regularly utilize diverse items—from computer software to pharmaceutical drugs—that are the products of innovation and subject to intellectual property protection. Businesses have developed new operating models based on extensive use of intellectual property and transfers of the embodiments of such property to their customers. Law schools and business schools are expanding their course offerings concerning intellectual property and its business implications. Academic journals in many disciplines publish articles on the impact of intellectual property and related laws in those fields. The popular press is filled with news stories on intellectual property laws, legal reform of those IP laws, and lawsuits over infringing software, hardware, books, and movies.

Despite all this attention, the concept of intellectual property is far from well understood. Many people, including leading scholars, question whether intellectual property is really property. Others struggle to reconcile intellectual property’s right to exclude with the restrictions on exclusionary conduct in antitrust law. Another focus of attention is on how intellectual property laws further and/or hinder progress in particular industries, such as biotechnology, software, and the entertainment industries, both in the United States and worldwide.

Into these debates, we introduce the following casebook, *Transactional Intellectual Property: From Startups to Public Companies*. This text is a successor to our previous casebook *Intellectual Property in Business Organizations: Cases and Materials*. Our perspective is unique and central to the modern role of intellectual property. We propose that intellectual property should be studied and understood in its business context. This approach helps to resolve many of the current policy questions and substantive uncertainties surrounding intellectual property laws. Like other business assets, such as securities, intellectual property has aspects of property. Furthermore, when viewed in business contexts, intellectual property’s role in markets and industries can be more systematically appreciated and analyzed. Given its importance in modern society as a whole, there is a surprisingly limited amount of scholarship focused on intellectual property as a business asset and its role in business organizations. A few scholars have addressed intellectual property in these contexts, and their work is cited in many places in our book. We hope that this casebook will stimulate further study of how businesses use intellectual property and how intellectual property law shapes markets and the structure of business activities.
The focus of our casebook reflects our professional and academic interests as attorneys and law professors. We have brought our own combined expertise in economics, engineering, and law, developed through our experience in law firms and in industry, to bear in assembling cases, statutes, regulations, and articles written by practitioners and professors in the fields of business organizations, commercial law, taxation, and intellectual property. The materials are designed to present a wide-ranging picture of the different roles that intellectual property plays in various stages of business activity, ranging from business formation and initial ownership structuring processes, to bankruptcies, mergers, and acquisitions, to public stock offerings and other advanced business transactions. Students using these materials will gain a rich exposure to the place of intellectual property in the contemporary marketplace that will inform their subsequent contexts and their understanding of intellectual property policy.

The topics of business organizations and intellectual property can each be intimidating to students. Putting the two together may be doubly intimidating. We hope that by bringing intellectual property and business organizations together, we can illuminate both fields and make each more understandable for students. In law school settings, we believe these materials will be useful as a basis for a survey course introducing students to the fields of intellectual property and business transactions. If used in more depth, this casebook can also serve as the basis for a capstone course for students who may have taken other intellectual property and business courses and are seeking a practical and applied course that focuses on important aspects of the relationship between intellectual property and various business organizations with differing scope, size, and focus. In order to facilitate usage of this casebook in courses without requiring any prior knowledge of intellectual property, we have included an Appendix that provides a brief introduction to different intellectual property regimes for the uninitiated. In choosing and organizing the materials, we have been sensitive to the multiple needs of different types of students and law school and business school professors. We have also sought to assemble materials that demonstrate how intellectual property interests figure in contemporary business and legal environments. By using this text to provide students with illustrations of the business significance of intellectual property, we also hope that professors in both law schools and business schools will make use of these materials in other courses on intellectual property, business transactions, and technology management.

Because of the salience of intellectual property, it is important that we recognize and study how to conduct business transactions involving intellectual property. While other intellectual property materials have largely focused on litigation involving intellectual property, our book provides a unique and comprehensive overview of transactional lawyering and management decision-making regarding intellectual property. Whether you approach these materials as an instructor or as a student, we hope that we are able to give you a deeper appreciation of the richness of intellectual property and its importance in shaping modern technology, industry, and business organizations.

The writing of this casebook was a truly collaborative enterprise. We each learned a great deal about the fundamental character of intellectual property issues from the
authors of the materials used in our text as well as from reviewing the work of our co-authors. We also benefited from the generosity and expertise of the many colleagues, students, and staff members who contributed to the completion of this text at various stages. We particularly wish to thank Professor John R. Allison, Professor Ronald J. Mann, and Professor Peter Yu, who provided insightful comments on early chapters and the original proposal that was the seed for this casebook.

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Contents

Introduction

Chapter 1 · Creating and Protecting the Business Model

A. Capturing Value through Intellectual Property
   Jon E. Hokanson & Sa’id Vakili, Intellectual Property Issues for the Technology Startup Company
   Victoria A. Cundiff, How a Startup Company Can Put Its Intellectual Property at Risk
   Motor City Bagels, LLC. v. American Bagel Co.
   Notes & Questions

B. Valuing Intellectual Property
   Ted Hagelin, Valuation of Intellectual Property Assets: An Overview
   Hughes Tool Co. v. Dresser Industries, Inc.
   UNILOC USA, Inc. v. Microsoft Corp.
   Notes & Questions

C. Avoiding Forfeitures of Intellectual Property Interests
   Patent Act
   Conditions for Patentability; Novelty and Loss of Right to Patent
   Copyright Act
   Registration and Infringement Actions
   Pfaff v. Wells Electronics, Inc.
   Notes & Questions

D. Tax and Accounting Issues Raised by Intellectual Property
   Joseph Bankman & Ronald J. Gilson, Why Start-Ups?
   Syms Corp. v. Commissioner of Revenue
   Permanent Subcommittee on Investigations of the U.S. Senate, Memorandum: Offshore Profit Shifting and the U.S. Tax Code
   Notes & Questions

E. Export Controls Affecting Intellectual Property
   NYS Science + Technology Law Center, Export Guidebook (2016) (Excerpts)
   Notes
Chapter 2 · Organizing and Financing an Intellectual Property Based Start-Up Company

A. Commercializing Intellectual Property: Selecting a Business Entity and Obtaining Initial Financing  85
   1. Business Entity Choices 85
      Richard A. Mann et al., Starting from Scratch: A Lawyer’s Guide to Representing a Start-up Company 85
   2. Early Stage Financing Options 89
      Kristopher D. Brown & Graham D. S. Anderson, Financing and Strategic Alliances for the New Media Company 89
      Notes & Questions 97
   3. Crowdfunding 101
      Securities and Exchange Commission, Crowdfunding 101
      Notes & Questions 109
   4. Venture Capital Financing 112
      Manuel A. Utset, Reciprocal Fairness, Strategic Behavior & Venture Survival: A Theory of Venture Capital-Financed Firms 113
      Ronald J. Mann, Do Patents Facilitate Financing in the Software Industry? 119
      Beverly A. Berneman, J.D., LL.M., Benjamin, Berneman, and Brom, LLC, Venture Capital Financing for the Development of Intellectual Property Assets: A Marriage of Convenience 129
      Notes & Questions 132
   B. Financing through Security Interests in Intellectual Property 134
      In re Peregrine Entertainment, Ltd. 135
      Notes & Questions 142
   C. Misstatements in Financing Transactions 147
   1. Standards Governing Securities Fraud 148
   2. Examples of Fraudulent Representations Regarding Intellectual Property 170
      Pommer v. Medtest Corporation 170
      Notes & Questions 174
      Alna Capital Associates v. Wagner 175
      Notes & Questions 183
      Gompper v. VISX, Inc. 184
      Notes & Questions 186
   D. Fiduciary Duties of Corporate Leaders Regarding Intellectual Property Development and Management 189
      Henderson v. Axiam, Incorporated 190
      Notes & Questions 200
Chapter 3 · Trade Secrets

A. Introduction — What Is a Trade Secret?
   Notes & Questions

B. Civil Protection of Trade Secrets
   1. Federal Protection
      a. Defend Trade Secrets Act
         Notes & Questions
   2. State Protection
      a. Uniform Trade Secrets Act
         i. Introduction
         ii. Application of the UTSA
      b. Non-UTSA Jurisdictions
         Sylmark Holdings Ltd. v. Silicone Zone Intern. Ltd.
         Notes & Questions
      c. Defenses to Misappropriation and Rights against Others
         i. The Honest Discoverer
         ii. The Innocent Wrongful User
      d. Trade Secrets versus Patent
         i. Scope of Protection
         ii. Choice: Trade Secrets versus Patent
      e. Trade Secrets Termination
         i. Public Disclosure
         ii. Exceptions

C. Criminal Protection for Trade Secrets
   1. Federal Protection
      a. Economic Espionage Act
         Notes & Questions
      b. Actual Theft of Trade Secrets
         United States v. Lange
      c. Conspiracy to Steal Trade Secrets
         United States v. Martin
      d. Disputes over Jury Instructions
         United States v. Liew
Chapter 4 · Employment Issues

A. Ownership of Intellectual Property

1. Statutory Default Rules
   a. Patents
      i. Shop Right
      *McElmurry v. Arkansas Power & Light Co.*
      Notes & Questions
      274
   ii. Hired to Invent
      *Standard Parts Co. v. Peck*
      Notes & Questions
      279
   b. Trade Secrets
      i. Introduction
      *Wexler v. Greenberg*
      Notes & Questions
      283
   ii. Implied Duties of Employees
      *Harry R. Defler Corporation v. Kleeman*
      Notes & Questions
      290
   c. Copyrights
      *Community for Creative Non-Violence v. James Earl Reid*
      295

2. Private Adjustments Through Employment Contract Terms
   a. Introduction
   b. Invention Assignments
      *Freedom Wireless, Inc. v. Boston Communications Group, Inc.*
      Notes & Questions
      303

B. Transfers of Intellectual Property Upon Changes in Employment

1. Enforceability of Restrictions on Subsequent Employment for Parties Holding Trade Secrets
   a. Nonuse and Nondisclosure Agreements
      *Union Pacific Railroad Company v. Brent Mower*
      Notes & Questions
      307
   b. Covenant Not to Compete
      i. Generally
      *Nike, Inc. v. Eugene McCarthy*
      Notes & Questions
      313
   ii. Hold-Over/Trailer Clauses
      *Milliken & Co. v. Morin*
      Notes & Questions
      321
2. Inevitable Disclosures of Trade Secrets as a Basis for Preemptive Employment Limitations 332
   a. Generally 332
   Pepsico, Inc. v. Redmond 333
   Notes & Questions 341
   b. Hazards of Applying the “Inevitable Disclosure” Doctrine 343
   William Lejeune v. Coin Acceptors, Inc. 343
3. Risks to New Employers from Hiring Experienced High-Tech Employees 352
   a. Misappropriation: Wrongful Use or Disclosure 352
      i. Acts Giving Rise to Third Party Liability 352
      Colgate-Palmolive Co. v. Carter Products 353
      Notes & Questions 357
   b. Intentional Interference with Contractual or Fiduciary Relationship 361
      i. Generally 361
      Robert L. Reeves v. Daniel P. Hanlon 362
      ii. When Is Interference Considered Improper? 367
      Storage Technology Corp. v. Cisco Systems, Inc. 367
      Notes & Questions 372
Chapter 5 · Licensing in Business Organizations 373
A. Patent Licensing 375
   1. The Right to Sue for Infringement 376
      Morrow v. Microsoft Corp. 376
      Notes & Questions 382
   2. Challenges to Patent Validity 384
      a. Res Judicata 384
      Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation 384
      Notes & Questions 390
      b. Estoppel 391
      Lear, Inc. v. Adkins 391
      Medimmune v. Genentech 396
      Notes & Questions 400
   3. Duration of Obligation to Pay Royalties 403
      a. Post Patent Expiration Royalties 403
      Kimble v. Marvel Entertainment, LLC 403
      b. License Royalties on Unpatented, Publicly Disclosed Products 406
      Aronson v. Quick Point Pencil Co. 406
      Notes & Questions 411
   4. Limits on Patent Rights 412
CONTENTS

a. Patent Exhaustion and the First Sale Doctrine 412
   Quanta Computer, Inc. v. LG Electronics, Inc. 412
   Notes & Questions 418
b. Compulsory Licenses 421

5. Cross-Licensing 423
   a. Why Enter into a Cross-Licensing Agreement? 423
      Texas Instruments v. Hyundai Electronics Industries 423
      Notes & Questions 428
      Texas Instruments v. Hyundai Electronics Industries 431

6. Patent Pools 438
   Matsushita Electrical Industrial Co., Ltd. v. Cinram International, Inc. 438
   Notes & Questions 444

7. Patent Packages 450
   Well Surveys, Inc. v. Perfo-Log, Inc. 450
   U.S. Philips Corporation v. International Trade Commission 453
   Notes & Questions 464

8. University Licensing 465

B. Trade Secret Licensing 466
   1. Introduction 466
      Notes & Questions 467
   2. Duration of Trade Secret Royalties 468
      Warner-Lambert Pharmaceutical Company v. John J. Reynolds, Inc. 468
      Notes & Questions 474

C. Trademark Licensing 474
   1. Requirement of Good Will: Prohibition Against “Bare” or “Naked” License 475
      International Cosmetics Exchange, Inc. v. Gapardis Health & Beauty, Inc. 475
      Notes & Questions 477
   2. Control Over the Mark 479
      Dawn Donut Company v. Hart’s Food Stores, Inc. 479
      Notes & Questions 484
   3. Antitrust Concerns: Tying 486
      Principe v. McDonald’s Corporation 487
      Notes & Questions 490

D. Copyright Licensing 490
   1. Introduction 490
      Silvers v. Sony Pictures Entertainment, Inc. 491
      DRK Photo v. McGraw-Hill Global Education Holdings, LLC 492
      Notes & Questions 499
2. Scope of the Use: Unforeseen Uses

   HarperCollins Publishers LLC v. Open Road Integrated Media, LLP 501

3. Performance Rights Organizations: ASCAP & BMI 509

E. Licensing Multiple Types of Intellectual Property: Hybrid Licensing 510
   1. Patent and Trade Secret Licensing 510
   2. Patent and Trademark Licensing 511

Chapter 6 · Intellectual Property Assets and the Termination of a Business 513

A. Termination through Bankruptcy 515
   1. The Bankruptcy Estate 516
      Patrick A. Casey, P.A. v. Joel S. Hochman, M.D. 516
      Penick Pharmaceutical, Inc. & Unofficial Committee of Equity Holders of Penick Pharmaceutical, Inc. v. McManigle 519
      Simplified Information Systems, Inc. v. Cannon 523
      C Tek Software, Inc. v. New York State Business Venture Partnership 525
      Notes & Questions 530
   2. The Automatic Stay and Intellectual Property Litigation 533
      Checkers Drive-In Restaurants, Inc. v. Commissioner of Patents and Trademarks 533
      In re: The Singer Company 539
      Notes & Questions 543
   3. The Intellectual Property License in Bankruptcy 544
      a. Statutory Background 544
      Notes & Questions 546
      b. Licensor as Debtor 549
      In re: Cellnet Data Systems, Inc. 549
      Lubrizol Enterprises, Inc. v. Richmond Metal Finishers, Inc. 558
      Notes & Questions 562
      c. Licensee as Debtor 564
      Institut Pasteur v. Cambridge Biotech Corporation 564
      In re Catapult Entertainment, Inc. 568
      Notes & Questions 574

B. Termination Outside of Bankruptcy: Business Dissolutions and Joint Ventures 575
   Hapgood v. Hewitt 575
   Pav-Savr Corp. v. Vasso Corp. 580
   Southwest Whey Inc. v. Nutrition 101, Inc. 587
   Ronald S. Laurie, Inflexion Point Strategy, LLC, Intellectual Property Allocation Strategies in Joint Ventures 595
   Notes & Questions 601

Chapter 7 · Intellectual Property Issues in Mergers and Acquisitions 603

A. Some Basic Terminology 605
B. Ownership Issues 610
David H. Kennedy, Intellectual Property Issues Arising Out of Acquisitions 610
*PPG Industries, Inc. v. Guardian Industries Corp.* 621
*Verson Corporation v. Verson International Group, PLC* 629
*Motorola, Inc. v. Amkor Technology, Inc.* 635
Notes & Questions 640

C. Liability Issues 641
*Ed Peters Jewelry Co., Inc. v. C & J Jewelry Co., Inc.* 641
*TXO Production Co. & Marathon Oil Co. v. M.D. Mark, Inc.* 647
Notes & Questions 650

D. Transfer Issues 651
*Biolife Solutions, Inc. v. Endocare, Inc.* 651
Notes & Questions 658

E. Impacts of Ineffective Transfers and Inadequate Diligence 659
*Paragon Trade Brands, Inc. v. Weyerhaeuser Company* 659
Notes & Questions 671

Chapter 8 · Intellectual Property Due Diligence and Disclosures in Public Sales of Stock 675

A. Legal Significance of Due Diligence Reviews of Intellectual Property Prior to an IPO 681
1. Basic Features of Due Diligence Reviews of Intellectual Property 681
2. Potential Impacts of Due Diligence Reviews on Liability for Inaccurate or Incomplete Disclosures in an IPO 683
   a. Liability for Misstatements and Omissions in an IPO 683
   b. Due Diligence Defense 684
   c. Minimum Features of a Reasonable Investigation Supporting the Defense 686
Notes & Questions 687

B. Conducting a Reasonable Due Diligence Review 691
Diane J. Kasselman, Intellectual Property Due Diligence in Business Transactions 691
Mary J. Hildebrand & Jacqueline Klosek, Intellectual Property Due Diligence: A Critical Prerequisite to Capital Investment 705

C. Making Sufficient Disclosures 707
1. Drafting a Prospectus for a Public Offering 707
   a. Goals in Drafting a Prospectus 708
   b. Typical Contents of a Prospectus 708
   c. Disclosures in Prospectuses Regarding Intellectual Property 710
2. Regulatory Standards 713
   SEC Standards for Prospectus Contents: Regulation S-K (Excerpts) 713
3. Examples of Intellectual Property Disclosures 716
   S.E.C. Form S-1 Santarus, Inc (Excerpts) 716
Notes & Questions 724
4. Judicial Evaluations of Asserted Misstatements 726
   In re Stac Electronics Securities Litigation 726
   Sherleigh Associates, LLC v. Windmere-Durable Holdings, Inc. 731
   Notes & Questions 742

Chapter 9 · Advanced Techniques for Maximizing Intellectual Property Value in Mature Companies 745
A. Sources of Innovation and New Intellectual Property 748
   1. Allocating Resources to Innovation within Companies: Multi-Divisional Corporations as Internal Capital Markets 748
      George G. Triantis, Organizations as Internal Capital Markets: The Legal Boundaries of Firms, Collateral, and Trusts in Commercial and Charitable Enterprises 750
   2. Developing Intellectual Property Inside or Outside Companies: Decisions to “Make or Buy” New Intellectual Property 754
      Dan L. Burk, Intellectual Property and the Firm 756
      Notes & Questions 768
   3. Developing Intellectual Property Through Communities: Open Source Processes as Complements to Corporate Activities 770
      David McGowan, Legal Implications of Open-Source Software 770
      Notes & Questions 774
B. Intellectual Property Monetization 774
   Notes & Questions 776
C. Intellectual Property Securitization 780
   Hewson Chen, Don’t Sell Out, Sell Bonds: The Pullman Group’s Securitization of the Music Industry 781
   Notes & Questions 785
D. Insurance Aiding Intellectual Property Owners 786
   1. Intellectual Property Enforcement Insurance 786
   2. Other Insurance Benefiting Intellectual Property Owners 787
E. Valuable Transfers of Intellectual Property 788
   1. Intellectual Property Auctions 788
      In re: Commerce One, Inc. 790
      Notes & Questions 793
   2. Transfers Through Intermediaries 794
F. Other Valuable Dispositions of Intellectual Property 796
   1. Donations to Charitable Organizations 796
   2. Commitments to Non-Enforcement of Intellectual Property Rights to Enhance Open Source Product Development 798
      Steve Seidenberg, Big Blue Discovers New Way to Leverage Patents: Open-Source Revolution Keeps IBM in the Black 798
3. Open Source Releases of IP to Promote Indirect Monetization
4. Defensive Use of IP on Behalf of Customers

G. Creation and Management of Intellectual Property Portfolios
   R. Polk Wagner & Gideon Parchomovsky, Patent Portfolios
   Notes & Questions

H. Intellectual Property Goals and Challenges of Joint Ventures
   Kurt M. Saunders, The Role of Intellectual Property Rights in Negotiating and Planning a Research Joint Venture
   David J. Teece, Profiting from Technological Innovation: Implications for Integration, Collaboration, Licensing and Public Policy
   Notes & Questions

Chapter 10 · Advanced Techniques for Minimizing Risks of Intellectual Property Infringement in Mature Companies
A. Responding to Partially Understood Threats: The Example of Intellectual Property Risks Associated with Open Source Products
   Lori E. Lesser, Simpson Thacher & Bartlett, LLP, A Hard Look at the Tough Issues in Open Source Licenses
   Notes & Questions
B. Infringement Insurance
   Steven E. Tiller & Briggs Bedigian, Intellectual Property and Technological Insurance Coverage
   Notes & Questions
   Mez Industries, Inc. v. Pacific National Insurance Company
   Notes & Questions
   Zurich Insurance Co. v. Killer Music, Inc.
   Notes & Questions
   State Farm Fire and Casualty Insurance Company v. White
   Notes & Questions
   Notes & Questions
C. Monitoring of IP Risks by Corporate Officers and Directors
   Steven E. Bochner & Susan P. Krause, Intellectual Property Management and Board Liability
   Notes & Questions

Chapter 11 · The Antitrust Perils of a Dominant Intellectual Property Position
A. Statutory Overview
   Sherman Act
## CONTENTS

<table>
<thead>
<tr>
<th>Section</th>
<th>Page</th>
</tr>
</thead>
<tbody>
<tr>
<td>Clayton Act</td>
<td>874</td>
</tr>
<tr>
<td>Federal Trade Commission Act</td>
<td>875</td>
</tr>
<tr>
<td>National Cooperative Research Act</td>
<td>875</td>
</tr>
<tr>
<td>Antitrust Guidelines for the Licensing of Intellectual Property</td>
<td>877</td>
</tr>
<tr>
<td>Notes &amp; Questions</td>
<td>886</td>
</tr>
<tr>
<td><strong>B. The Interface of Antitrust &amp; Intellectual Property</strong></td>
<td></td>
</tr>
<tr>
<td>Federal Trade Commission v. Actavis, Inc.</td>
<td>890</td>
</tr>
<tr>
<td>Notes &amp; Questions</td>
<td>900</td>
</tr>
<tr>
<td><strong>C. Improper Conduct</strong></td>
<td>903</td>
</tr>
<tr>
<td>1. Restricting Competitors</td>
<td>903</td>
</tr>
<tr>
<td>United States v. Microsoft</td>
<td>903</td>
</tr>
<tr>
<td>Notes &amp; Questions</td>
<td>915</td>
</tr>
<tr>
<td>United States v. Microsoft</td>
<td>919</td>
</tr>
<tr>
<td>Notes &amp; Questions</td>
<td>927</td>
</tr>
<tr>
<td>2. Downstream Licensing</td>
<td>928</td>
</tr>
<tr>
<td>Impression Products, Inc. v. Lexmark Intern., Inc.</td>
<td>928</td>
</tr>
<tr>
<td>Notes &amp; Questions</td>
<td>935</td>
</tr>
<tr>
<td><strong>D. Standard Setting Organizations and FRAND</strong></td>
<td>937</td>
</tr>
<tr>
<td>In re Innovatio IP Ventures, LLC Patent Litigation</td>
<td>937</td>
</tr>
<tr>
<td>Notes &amp; Questions</td>
<td>950</td>
</tr>
<tr>
<td><strong>E. International Perspective from The European Union</strong></td>
<td>954</td>
</tr>
<tr>
<td>Antitrust: Commission enforcement action in pharmaceutical sector following sector inquiry</td>
<td>954</td>
</tr>
<tr>
<td>Notes &amp; Questions</td>
<td>957</td>
</tr>
<tr>
<td><strong>Chapter 12 · Acquiring and Using Intellectual Property in University and Governmental Contexts</strong></td>
<td>959</td>
</tr>
<tr>
<td><strong>A. Commercializing University Research</strong></td>
<td>960</td>
</tr>
<tr>
<td>1. Intellectual Property Ownership and Use within the University</td>
<td>960</td>
</tr>
<tr>
<td>M.J. Madey v. Duke University</td>
<td>960</td>
</tr>
<tr>
<td>Fenn v. Yale University</td>
<td>964</td>
</tr>
<tr>
<td>University of Colorado Foundation, Inc. v. American Cyanamid Co.</td>
<td>972</td>
</tr>
<tr>
<td>Notes &amp; Questions</td>
<td>974</td>
</tr>
<tr>
<td>2. Transforming Federally Funded Research into Marketable Products: Goals of the Bayh-Dole Act</td>
<td>975</td>
</tr>
<tr>
<td>Notes &amp; Questions</td>
<td>979</td>
</tr>
<tr>
<td>3. Commercializing University-Generated Intellectual Property:</td>
<td>981</td>
</tr>
<tr>
<td>Impacts of the Bayh-Dole Act</td>
<td>981</td>
</tr>
<tr>
<td>Trinity Industries, Inc. v. Road Systems, Inc.</td>
<td>984</td>
</tr>
<tr>
<td>Board of Trustees of Leland Stanford Junior University v. Roche Molecular Systems, Inc.</td>
<td>990</td>
</tr>
<tr>
<td>Notes &amp; Questions</td>
<td>990</td>
</tr>
</tbody>
</table>
B. Transacting with State and Federal Governments 993
   *Xechem Intern., Inc. v. Univ. of Tex. M.D. Anderson Cancer Center* 993
   Notes & Questions 997
C. Collaborative Research and Development Agreements (CRADAs) 998
   *Edmonds Institute v. Bruce Babbitt, Secretary of the Interior* 998
   Notes & Questions 1004

Chapter 13 · Intellectual Property Influences on Resource Allocations:
Four Case Studies 1005
A. Approaching the Case Studies 1008
   1. The Projects Profiled 1008
   2. Analyzing Patent Influences at Individual and Organizational Levels 1009
B. The Patents and Inventions 1010
   Genetically Engineered Crops 1010
   Notes & Questions 1014
   DNA Copying via Polymerase Chain Reaction (PCR) 1016
   Notes & Questions 1020
   Hepatitis Vaccine 1022
   Notes & Questions 1025
   Cardiac Stents 1027
   Notes & Questions 1031
C. Lessons from the Case Studies 1032
   Notes & Questions 1033

Appendix · Introduction to Intellectual Property for the Nonspecialist 1035
I. Types of Intellectual Property Interests 1035
   A. Patents 1035
   B. Copyrights 1036
   C. Trademarks and Servicemarks 1036
   D. Trade Secrets 1036
II. Patent Laws 1037
   A. What Can Be Patented 1037
      1. Utility Patents 1037
      2. Design Patents 1038
      3. Plant Patents 1039
   B. Conditions for Obtaining a Patent: Novelty and Nonobviousness 1040
   C. The Role of the Patent Office 1041
   D. Who May Apply for a Patent 1042
   E. Contents of a Patent Application 1043
      1. Regular Patent Application 1043
      2. Provisional Patent Application 1043
   F. Patent Attorneys and Agents 1043
G. Publication of Patent Applications 1044
H. Examination of Patent Applications 1045
I. Administrative Challenges to Patents 1045
J. Nature of Patent Rights 1045
K. Maintenance Fees 1046
L. Patent Expiration 1046
M. Relief for Patent Infringement 1047
N. Patent Marking and Notices of “Patent Pending” 1048
O. Patent Assignments and Licenses 1048
1. Forms of Assignments 1048
2. Recording of Assignments 1049
3. Patent Licenses 1049
P. International Considerations 1050
1. Foreign Patents and Patent Rights 1050
2. The Paris Convention 1050
3. The Patent Cooperation Treaty (PCT) 1051
4. Foreign Filing License 1051
5. Foreign Applicants for United States Patents 1052

III. Copyright Laws 1052
A. Copyrightable Works 1052
B. Copyright Registration 1053
C. Initial Copyright Ownership 1054
D. Rights of Copyright Holders 1055
E. Fair Use Limitations on Copyright Enforcement 1056
F. Compulsory Licenses as Limitations on Copyright Enforcement 1057
G. Remedies for Copyright Infringement 1058
H. Duration of Copyright Protections 1059
1. Works Originally Created on or after January 1, 1978 1059
2. Works Originally Created before January 1, 1978, But Not Published or Registered by That Date 1059
3. Works Originally Created and Published or Registered before January 1, 1978 1059
I. Transfers of Copyright Interests 1060

IV. Trademark Laws 1061
A. Characteristics of a Trademark or Service Mark 1061
B. Items That May Serve as Trademarks 1061
1. Textual Marks 1062
2. Graphical Marks 1062
C. Registering a Trademark 1063
1. Application Based on Use in Commerce 1063
2. Application Based on Intent to Use 1064
D. Role of the USPTO 1064
E. Bases for Rejection of a Trademark Registration Application 1065
1. Likelihood of Confusion with an Existing Mark 1065