25 percent rule, see Royalty-Rules of Thumb	Standardization, and, 831, 856–57, 864–65
AAD I DA OO	Tying, 794, 827, 848–57
A.A. Poultry v. Rose Acre, 838	Affiliate, definition, 136–37
Abandonment of trademark, 466–69, 476–77	Alice Corp. v. CLS Bank, 580
Acceptance (of deliverables), 262	Amendment of agreements, 415, 554
Adams v. Burke, 752–55	American Society of Mechanical Engineers, Inc. v.
Alfred E. Mann Found. for Sci. Research v. Cochlear	Hydrolevel Corp., 873, 874
Corp., 321–22, 327	Apparent authority, see Authority to contract
ALL CAPS, 295	Apple App Store, 17, 18, 197
All substantial rights (in patent), 321–27	Apple, Inc. v. Motorola, Inc., 663–67
Allen Archery, Inc. v. Precision Shooting Equipment, Inc.,	Apple Inc. v. Qualcomm Inc., 711
209–13	Application Programmer Interface (API), 582–83, 633
Allied Tube v. Indian Head, Inc., 871–75	Application Service Provider (ASP), see Software as a
Android operating system, 14, 623	Service (SaaS)
Anticommons, 887–88, 890	Arbitration clauses, 352–57, 544, 550, 730
Antitrust issues, 824–84	Arbitron, Inc. v. Tralyn Broadcasting, Inc., 220–24
Agency enforcement policy, 826	Aronson v. Quick Point Pencil Co., 207, 530–31, 805–7
Clayton Act, 791, 793, 794, 825	Arista Records, LLC v. Launch Media, Inc., 511–16
Essential facilities doctrine, 866	ASCAP, see Music – Am. Soc'y Composers
Federal Trade Commission Act, 826	Assignment
Franchising, 849–53, 854–55	Copyright, 22–27
Injury, 870–71, 883	FRAND commitments, see Fair, Reasonable and
Market Allocation, 832–39	Nondiscriminatory (FRAND) Licensing
Market Power, 839, 852, 853-54, 857-66, 883, 908	commitments – transfer of
Monopolization, 825, 840, 857–54	Goodwill, 37–41
Nine No-Nos, 827–28b, 849	IP underlying license, 64–66, 400
Oligopsony (buyers' cartel), 831, 917	Licenses, 149, 394–400
Output restrictions, 830–31	Patent, 27–36, 426–29, 456, 669
Patent misuse, and, 798, 862–63, 865, 866	Termination, statutory, 26
Pay for Delay, see Antitrust issues – Reverse Payment	Trade secrets, 41–42
Settlements	Trademark, 37–41, 126–27
Per se illegality, 827–28, 836–37, 838, 840, 841, 843–44,	Assignor estoppel – see Estoppel
847, 849, 861, 863, 870	At-will termination, see Termination for Convenience
Platform technologies, 855-56	Attribution requirement, 594, 595–96, 608
Pooling of IP, 891–97b, 898–910, 911–16	Au-Tomotive Gold Inc. v. Volkswagen of America, Inc., 747-52
Price fixing, 828–31, 840, 848	Audit clauses, 245–47
Refusal to Deal (group boycott), 866-67	Authentic Apparel Grp., LLC v. United States, 475
Remedies, 839-40	Authority to contract, 549–50
Resale Price Maintenance, 735, 827, 840-48	Automatic Radio Co. v. Hazeltine Research, Inc., 215,
Reverse Payment Settlements, 875–83	225–26, 699, 704, 798, 808–10, 887, 916
Rule of Reason, 836, 840, 841, 843-44, 847, 849	
Sherman Antitrust Act, 825, 828, 832, 835-38, 840, 841,	Background IP, 263, 264
848, 849, 852, 857, 866, 867–68, 873, 875, 885,	Bankruptcy and licenses, 15, 380, 673-90
891–94	Assignment by DIP, 684–85

Automotic star of proceedings 6-2	Commonwealth Film Duccooking Inc. of Country Ide
Automatic stay of proceedings, 673–77	Commonwealth Film Processing, Inc. v. Courtaulds
Contractual clauses, 684, 686	United States, Inc., 68 Community for Creative Non-Violence v. Reid, 25
Debtor in possession, 673	Compton v. Metal Products, Inc., 820–21
Escrow, and, 687–90 Estate in bankruptcy, 673, 677–78	Compulsory licensing,
Executory contracts, 678–84	Copyright, 497–504, 506
Trademarks and, 683–84	Patent, 439, 840
U.S. Bankruptcy Code, Sec. 365(n), 679–84	Computer Communications, Inc. v. Codex Corp., 677, 686
See also <i>ipso facto</i> clauses	Computer Fraud and Abuse Act, 549
Barcamerica International USA Trust v. Tyfield Importers,	Condition v. covenant, 60–64, 619–21, 622
Inc., 469–74	Conditional sales, 585, 764–71
Bassett v. Mashantucket Pequot Tribe, 53–59	See also, Exhaution – Patent
Bayer AG v. Housey Pharmaceuticals, Inc., 726–27, 728,	Confidential Information – 54, 108, 110, 118, 364, 443,
798	572, 583, 597, 601
Bayh-Dole Act of 1980, 424-39, 449	Anti-confidentiality clause, 604
March-in rights, 432–39	Arbitration, and, 356
Preference for US Industry, 430, 431–32	See also Nondisclosure Agreements
Royalty sharing, 429–30, 431	contra proferentem, 416
Beer Nuts, Inc. v. King Nut Co., 722, 723, 724	Control, definition, 136, 137
Beneficial ownership of IP, 320	Convergence of IP rights, 466
Berne Convention for the Protection of Literary and	Cooperative R&D Agreement (CRADA), 445
Artistic Works, 147	Copyleft, 596, 599, 601, 604, 608, 609–10, 624
Best efforts, see Efforts required	Cornell University v. Hewlett-Packard Co., 213–14
Beta testing, 120	Cost Reimbursement, 237–38, 277
Beta version (pre-release), 187	Covenant not to sue, 49–51, 359
Bilski v. Kappos, 580	Cournot complements, 889–90
"Biobucks", 229	Cozza v. Network Assoc., 5
Bio-Rad Labs, Inc. v. ITC and 10X Genomics, 35–36	C.R. Klewin, Inc. v. Flagship Properties, Inc., 68
Block booking (motion pictures), 855, 887	Creative Commons, 592–97, 618, 636
See also Antitrust issues – Tying	CRISPR-Cas9 licensing, 174
Board of Trustees of the Leland Stanford Junior University	Customizations, 255
v. Roche Molecular Systems, Inc., 32–34, 142, 149,	Cyrix Corp. v. Intel Corp., 150–57, 168
426–29 P. H. Marrill Community of the co	DE Charles to Hallian L.I.C. Tomoform
Bobbs-Merrill Co. v. Straus, 732–36, 745, 771, 776	D.E. Shaw Composite Holdings, L.L.C. v. Terraform
Boilerplate, 122, 390–91, 419	Power, LLC, 126
Bona fide purchaser, 168 Boosey & Hawkes Music Publishers, Ltd. v. The Walt	Dana-Farber Cancer Inst., Inc. v. Ono Pharm. Co., 36 Data,
Disney Co., 159–64	•
Bowers v. Baystate Technologies, Inc., 532	Individual Health Information (IHI), 557–59 Legal protection for, 556–59
Bowman v. Monsanto, 539, 762-64	Licensing terms, 560–66
Break-up fee, 118	Privacy, see Privacy
See also – Termination, for convenience	Propertization of, 557–59
Browsewrap agreement, 523, 541–50	Trade secret, as, 560, 575
Brulotte v. Thys Co., 225–26, 799–807, 812	See also Economic Espionage Act
	See also EU Database Directive
Cannibalization, product, 12, 17	Datatreasury Corp. v. Wells Fargo & Co., 65
Cascades Computer Innovation LLC v. RPX Corp., 917	Date of agreement, see Effective Date
Celeritas Technologies, Ltd. v. Rockwell International Corp., 113–16	Dawn Donut Co. v. Hart's Food Stores, Inc., 467–69,
Change in control clauses, 399, 406	Declaratory Judgment Act, 97–106, 709–12
Change orders, 257–58	Defensive termination/suspension clause, 615–16, 641,
Character licensing, 462–66	909
Clickthrough agreement, see Clickwrap agreement	De Forest Radio Telephone Co. v. United States, 91, 762
Clickwrap agreement, 415, 523, 540	Demand letters, 106–7
Cloud computing, 586–91	Dependencies (of non-breaching party), 378–80
Co-exclusive licensee, 173	Derivative works, 248–51
Commercial purposes, definition, see Noncommercial	No derivatives license, 594
purposes	Design patents, 464–66
Commissioned works, 81–88, 254–55	Digital Millennium Copyright Act of 1998 (DMCA),
Commodores Entm't Corp. v. McClary, 45	557, 609, 610, 738

Dilizance requirements see Milestones	Injunctive relief effect on 662 68
Diligence requirements, see Milestones	Injunctive relief, effect on, 662–68
Disclosure schedule, 287–88	Nondiscrimination, 659–62
Distribution agreements, 581	Royalty-Free licensing, 658–59
Divisibility of rights, 26, 36	Servitudes, compared to, 670
Donald F. Duncan, Inc. v. Royal Tops Manufacturing	Third party beneficiaries of, 658
Co., Inc., 176–79	Transfer of, 66, 668–70
Drackett Chem. Co. v. Chamberlain Co., 706–7	See also Defensive suspension/termination,
Drafting practices and tips, 123–27, 394	Reciprocity requirements, Royalties
Drug Price Competition and Patent Term Restoration	Fair Use doctrine,
Act of 1984, see Hatch-Waxman Act	Copyright, 441, 521, 522, 532, 585, 593, 822
DSC Comme'ns Corp. v. Pulse Comme'ns, Inc., 744	Trademark, 142
DTM Research, L.L.C. v. AT&T Corp., 42	Fathers & Daughters Nevada, LLC v. Zhang, 315–20
	Federal common law, 53, 405
eBay Inc. v. MercExchange, L.L.C., 662, 663	Federal agencies, licensing by, 333-34, 440
Economic Espionage Act, 560	Federal Rule of Evidence 408 – see Settlement of
Eden Hannon & Co. v. Sumitomo Trust & Banking Co.,	Litigation
567–72, 575	Federal Trade Commission v. Actavis, Inc., 875–83
Effective Date of agreement, 362-63, 392	Federal Trade Commission v. Qualcomm, 762, 856-57
Effects Associates, Inc. v. Cohen, 84-86, 88	Feist Publications v. Rural Telephone, 556-57
Efforts required, 187–95, 341	Field of Use (FOU), 143-46, 279, 447
Eli Lilly & Co. v. Emisphere Techs., Inc., 64	Filmtec Corporation v. Allied-Signal Inc., 28-33
Elorac, Inc. v. Sanofi-Aventis Can., Inc., 298-99	First Nationwide Bank v. Florida Software Services, 406
Employee rights in IP, 27–31	First sale doctrine,
End user license agreement (EULA), 61, 531–32, 550–55, 592	Copyright, 731–36
Endo Pharms., Inc. v. Actavis, Inc., 94, 360	International, 771–78
Enesco Corp. v. Price/Costco Inc., 749	Digital works, 746
Enforcement of IP	Trademark, 746–52
Contractual terms relating to, 185, 319, 320, 336–41	International, 781–89
Equity compensation, 235–37	Flex-Foot, Inc. v. CRP, Inc., 713–17, 722, 725–27
Ericsson v. D-Link, 656, 657, 661	Flynn v. McGraw Hill LLC, 215
Escrow,	Foad Consulting Group, Inc. v. Musil Govan Azzalino, 79
Disputed sums, 380	Force majeure, 380, 409–11, 419
Source code, 583, 687–90	Foreground IP, 263, 264
Essential step defense (copyright), 744	Foundry rights, 156–57
Estoppel	Franchising, 480–92
Assignor, 691–99, 703, 706–7	Advertising, 485
Licensee, 699–799	Agreements, 485–92, see also IHOP Restaurants LLC
Ethicon v. United States Surgical Corp., 42–43	v. Moeini Corp.
EU Database Directive, 557, 560	Disclosures, 483–84
EU General Data Protection Regulation (GDPR), 573	Operations manual, 491–92
Everex Systems, Inc. v. Cadtrax Corp., 405, 685	Termination of, 383, 491
Eviction from license, 706–9	See also, Antitrust issues – Franchising
Exhibits to agreement, 123	Fraunhofer-Gesellschaft v. Sirius XM, 374, 377
Exclusion of Damages, see Limitations of Liability	Free licenses, 18, 658–59
Exclusivity, 118, 197, 245, 252–53, 325–26b, 332, 405–6,	Free software movement, 597–601
430, 443-44, 888	Functionality doctrine (trademark), 747-48
Exhaustion doctrine,	Future grants of rights, 32
Conditional sales, see Conditional sales	
International, 778–81	General Talking Pictures Corp. v. Western Electric,
Patent, 359, 660	143–44, 145, 146, 760, 769–70
See also, First Sale Doctrine	Gen-Probe Inc. v. Vysis, Inc., 710, 726, 728
Export controls, 409, 441–42, 604	Georgia-Pacific Corp. v. U.S. Plywood Corp., 655
Exxon Corp. v. Oxxford Clothes Inc., 476–77	Genericide (trademark), 480
T (* //	Good faith efforts, see Efforts required
Fabryzyme petition, see Bayh-Dole Act of 1980 –	Google, 14, 17, 18
March-in rights	Google v. Oracle, 578
Fair, reasonable and nondiscriminatory (FRAND)	Grantbacks, 252–54, 590, 904, 905, 908–9, 914
licensing commitments, 66, 445, 632, 640–41,	Gray market, see First Sale Doctrine – Trademark –
	International
654–59, 904, 906–7 Antitrust remedy as 840	
Antitrust remedy, as, 840	Greenberg v. Miami Children's Hospital Research
Enhanced damages for breach of, 666–67	Institute, Inc., 559

Greenfield v. Twin Vision Graphics, Inc., 538	Joint ventures, 265–75
Gruen Marketing Corp. v. Benrus Watch Company, Inc.,	JP Morgan Chase Bank, N.A. v. DataTreasury Corp., 245
328–32	Jury trial, waiver of, 343
	7 7 7 7510
Hague Conference on Private International Law, 345	Karl Storz Endoscopy-America, Inc. v. Surgical Tech.,
Hartford-Empire Co. v. United States, 897	Inc., 749, 750, 752, 788
Hatch-Waxman Act, 876–77	Keen, Inc. v. Gecker, 678
Have-made rights, 154–57	Kennedy v. Natl. Juvenile Detention Assn., 150, 249-51
Henry v. A. B. Dick Co., 860	Kepner-Tregoe, Inc. v. Vroom, 181–83
Hill v. Gateway 2000, Inc., 546	Kewanee Oil Co. v. Bicron Corp., 807
Huawei v. ZTE (Eur. Ct. Justice), 667-68	Klipsch Inc. v. WWR Technology Inc., 412-13
Human samples, treatment of, 456	Kimble v. Marvel Entertainment, LLC, 800-5
Hyperlinks, 549	Kirtsaeng v. John Wiley & Sons, Inc., 771–78
7.1	Know-How,
I.A.E., Inc. v. Shaver, 81–87	Definition, 130, 138–39
I.Lan Systems, Inc. v. Netscout Service Level, 523	Licensing, 138–40
Idaho Potato Comm. v. M&M Produce Farm & Sales,	
	Knowledge qualifiers, 287, 289
719–24	Krehl v. Baskin Robbins Ice Cream Co., 854–55
Idea disclaimers, 78	Laconcomb v. Downalda 000
Idea pitches, 68–80	Lasercomb v. Reynolds, 818-21
Idea registration, 79–80	Law v. Bioheart, Inc., 229–34
IHOP Restaurants LLC v. Moeini Corp., 486–91	Le Tote Inc. v. Urban Outfitters Inc., 111
Illinois Tool Works Inc. v. Independent Ink, Inc., 790, 859–63	Lear, Inc. v. Adkins, 695–96, 699–709, 711, 715–16, 721–22,
Implied licenses, 67, 68–96, 134, 615	723, 724, 726, 728, 808
Impression Products, Inc. v. Lexmark International, Inc.,	Leegin Creative Leather Products, Inc. v. PSKS, Inc.,
765–71, 778–81	841–47
Improvements (to licensed technology), 251, 447	Letter of Intent – see Preliminary Documents
See also Derivative Works	License back, see Grantback
Indemnification,	Limitations of Liability, 295–97, 534
IP infringement, 297, 299–311, 364, 448, 589	Linux operating system, 18, 601, 609, 615, 618, 623, 627
Termination of European sales representatives, 386	Listerine, see Warner-Lambert Pharm. v. John J.
Independent Wireless Telegraph Co v. Radio Corp of	Reynolds, Inc., 14
America, 334	Lock-in, 634, 639
Inequitable conduct, 652	Loew's Inc. v. Wolff, 281–84, 293
Injunctive relief clauses – 110, 111, 349, 350, 668	Lone Star Silicon Innovations LLC v. Nanya Tech. Corp.,
Innovatio IP Ventures, 656, 657	322–28, 335
Institut Pasteur v. Cambridge Biotech Corp., 685	Lost profits, 298–99
Insurance clause, 311–12	Lubrizol Enterprises, Inc. v. Richmond Metal Finishers,
Integration clause, see Merger clause	Inc., 679, 683
Intercompany agreements, 566	
Interim agreements, 119–20	M.A. Mortenson Company, Inc. v. Timberline Software
Internal use limitation (software), 581	Corp., 532–37
International Business Machines (IBM), 14, 18, 78, 150–54	M.D. Mark, Inc. v. Kerr-McGee Corp., 562–66, 575
International News Service v. Associated Press, 556, 557	Macy's Inc. v Martha Stewart Living Omnimedia, Inc.,
International Salt Co. v. United States, 850, 862, 863	183–84
Invitation to license – see Demand Letter	Madey v. Duke Univ., 442
Ipso facto clause, 363, 685–87	Malicious code, 289
Irrevocable licenses, 374	MAI Systems Corp. v. Peak Computer Inc., 578, 740–42,
IXL, Inc. v. AdOutlet.Com, Inc., 258–62, 380	744 Maintanana
	Maintenance,
Jachosen v. Katzer, 602, 616–22, 623–24	Hardware, 584
Jefferson Parish Hospital Dist. No. 2 v. Hyde, 849, 859,	Product, 292
861, 863	Software, 584, 586
Johnson v. Jones, 87–88	Mallinckrodt, Inc. v. Medipart, Inc., 764–65, 766, 770
Joinder, 332–36, 337, 338	Marking
Joint ownership of IP, 263, 264	Confidential information, 112
Copyrights – 43	Patents, 406–8
Non-US law – 46	Trademarks
Patents - 42-43	Material adverse effect, 287
Trademarks	Material Transfer Agreement, 451–56
Trade Secrets – 43–44	Materiality (of breach), 375-76, 379

McCoy v. Mitsuboshi Cutlery, Inc., 89–93	SESAC, Inc., 505, 887
MacMahan Pharmacal Co. v. Denver Chemical Mfg.	
	SoundExchange, 504, 510–11, 517 Streaming, 503–4
Co., 466–67 MDV Industries LLC v. Bliggard 60, 62	9 7 7 1
MDY Industries, LLC v. Blizzard, 60–63	Synchronization, 518–20
Mechanical Ice Tray Corp. v. Gen. Motors Corp., 178–79	Nadal v Play Py Play Toys & Novalties Inc. 60 -4
MedImmune, Inc. v. Genentech, Inc., 98, 102–4, 105–6,	Nadel v. Play-By-Play Toys & Novelties, Inc., 69–74
710–11, 726, 728, 729	Naked licensing of trademark, see Abandonment of
Memorandum of Understanding – see Preliminary	trademark
Documents Marrin Corte v. Vi. Oil Took N.V. 12	National Auto Lenders, Inc. v. SysLOCATE, Inc., 549–50
Memry Corp. v. Ky. Oil Tech., N.V., 42	NEC Corp. v. Intel Corp., 585
Mercoid Corp. v. Minneapolis-Honeywell Regulator Co.,	Net Sales definition, 208
795–96, 809, 862	New York Times Co., Inc. v. Tasini, 164
Mergers and acquisitions, 15, 380, 396–97, 399, 401–6	No-challenge clause, see Validity – Challenges to
Merger clause (integration clause), 194, 411–12	Noncircumvention, 566–72, 586
Mextel, Inc. v. Air-Shields, Inc., 377	Noncommercial purposes, 454, 456, 594, 604
MGP Ingredients, Inc. v. Mars, Inc., 44	Noncompetition agreement, 569–71, 572, 818–21
Microsoft Corp. v. Motorola, Inc., 655, 657, 660, 662	Nondisclosure Agreements, 107–16
Milestones, 173, 186–87, 379	Nondiscrimination requirement, 603, 613, 659–62, 906,
Payments, 228–35	907
Minerva Surgical, Inc. v. Hologic, Inc., 692–99	Level discrimination, 660–61
Mission Product Holdings v. Tempnology, LLC, 683–84	See also Fair, Reasonable and Nondiscriminatory
Misuse doctrine (patent), 652–53, 727–29, 790–817,	(FRAND) licensing
862–63	Nondisturbance agreement, 387
Bundling, see Misuse doctrine (patent) – Package	Non-practicing entities (NPEs)
Licensing	Copyright, 321
Contributory infringement, and, 796–97, 798	Patent, 14, 15–16, 140, 310–11, 327–28, 588, 589, 656, 669
No-challenge clauses, 807–8	Nonrefundable fees, 198–99
Package licensing, 808–17, 827, 902	Northwest Wholesale Stationers, Inc. v. Pacific
Patent Misuse Reform Act of 1988, 797, 816, 821, 863,	Stationery Printing Co., 870
866	Notice clause, 416–18
Post-expiration royalties, 798–805	Numerus clausus and licenses, 364
Total sales royalty, see Misuse doctrine (patent) –	
Package Licensing	Object code (software), 142, 575–77, 580
Tying, 791–95	Open Source Initiative (OSI), see Open source software
Misuse doctrine (copyright), 817–23	(OSS)
Mistake, doctrine of, 21	Open source software (OSS), 590, 597–632, 641
Modularization of agreements, 13	Affero General Public License (AGPL), 613
Most-favored status and clauses, 238–45	Apache License, 605, 615–16, 618, 623, 627, 631
Morton v. Rank Am., Inc., 44	Artistic License, 602, 616–22
Morton Salt Co. v. G.S. Suppiger Co., 791–95, 805, 809,	Black Duck Software, 632
821, 862, 863	BSD License, 602, 605–8, 615, 623, 631
The Movie 1 & 2 v. United Artists Communications,	Copyleft, see Copyleft
866–70	Definitions of, 601–5
Music,	Dual licensing strategy, 624, 630
American Society of Composers, Authors and	Due diligence, and, 631–32
Publishers (ASCAP), 22, 505–7, 887	Free Software Foundation (FSF), 608, 613, 627
Broadcast Music, Inc. (BMI), 22, 505–7, 887	General Public License (GPL), 602, 605, 608–16, 624,
Copyright in, 493–95	629, 630, 631
Copyright Royalty Board, 497, 498–503	GNU Project, 598–600
Cover license (statutory), 497–504	Lesser General Public License (LGPL), 605, 614–15,
Digital Performance Right in Sound Recordings Act	630, 631
of 1995 (DPRSRA), 510, 513	Mozilla Public License, 602, 605, 629
Harry Fox Agency, 503	Open Source Initiative (OSI), 601–5, 608, 609, 622,
Licenses, 508–22	627
Mechanical reproduction, 496-504	Patents, and, 611–13, 615
Music Modernization Act of 2018, 504, 517	Viral nature of OSS, see Copyleft
Noncommercial broadcasting license (statutory), 506	See also Android operating system, Jachosen v. Katzer,
Performing Rights Organizations (PROs), 504–8	Linux operating system, Stallman, Richard
Political rallies, 509–10	Option agreements and clauses, 235, 450, 451
Public performance rights, 508–18	Fees, 197–98
Sampling, 521–22	Original Equipment Manufacturer (OEM), 581–82

Otto Preminger Films, Ltd. v. Quintex Entertainment, Ltd., 683	Recordation of IP interests, 26, 32, 40, 171 Recording Industry Assn. of Am. v. Librarian of Congress
Ownership of IP, see Assignment	498–503 Red Wing Shoe Co. v. Hockerson-Halberstadt, Inc.,
Pandora v. ASCAP, 507	711–12
Pav-Saver Corporation v. Vasso Corporation, 267-75	Register.com v. Verio, Inc., 547–48
Patent Assertion Entities (PAEs) – see Non-practicing	Research exemption, 442
Entities-Patent	Research tools, licensing, 176
Patent family, 130–32	Residuals clause, 109, 111, 112
Patent prosecution	Reverse engineering, 109, 111, 585–86
Costs, see Cost Reimbursement	Reversion of rights, 373
Responsibility, 276–77	Rhone-Poulenc Agro, S.A. v. DeKalb Genetics
1 7 7 77	
Patent troll – see Non-practicing entities	Corporation, 168–72
PBTM LLC v. Football Northwest, LLC, 126–27	Righthaven LLC v. Hoehn, 314, 320, 321
Permanence Corp. v. Kennametal, Inc., 189–93, 411	Rite-Hite Corp. v. Kelly Co. Inc., 325–26
Perpetual license, 365–74	Rolex Watch, U.S.A., Inc. v. Michel Co., 750, 752, 788
Pledges of intellectual property, 17, 586–87, 632–36	Royalty,
Market reliance, 634	Advance, 199
Open COVID Pledge, 636	Base, 208–17
Tesla Motors, 632, 634–36	Bundled rights, 225–26
Pooling of intellectual property, 17, 885–917	Buyout, 219–20
Allocation methods, 888	Caps, 219
Biotechnology, 890, 910	Entire market value rule (EMVR), 214
Competition among pools, 889	Escalation, 220–24
Complementarity, 906, 910	Fair, reasonable and nondiscriminatory (FRAND)
Defensive aggregation, 916–17	royalties, 224, 654-59
DVD pools, 226, 889, 907	Bottom-Up methodology, 656–57
Innovation, effect on, 898, 904-5, 909	Top-Down methodology, 656–57
Holdouts from, 889	Hybrid (patent/know-how), 206-7
Standards and pools, 898–910	In-kind compensation, 217
Portfolio licensing, 135–36, 215	Minimum royalties, 217–18
Preemption of state law claims, 529-31, 532, 807	Penalties for validity challenge, 727–29
Preliminary documents, 116–20	Pre-issuance, 706
Privacy, data, 573–75	Rate, 199–208
Private labeling, 832–39	Reach-through, 214–15
In Re Prize Frize, Inc., 681–83	Rules of Thumb, 205, 207
ProCD, Inc. v. Zeidenberg, 524–32, 536–37, 546, 746	Sharing under Bayh-Dole Act, 429–30, 431
PPG Industries, Inc. v. Guardian Industries Corp., 401–6	Smallest salable patent practicing unit (SSPPU), 214
Precedence, order of, 414–15	Stacking, 224–25, 889–90
Prestonettes, Inc. v. Coty, 748, 750	Tiers, 201–2
Princo cases, 816–17, 915–16	Total sales royalty, see Misuse doctrine (patent) –
Priority date (patent), 131	Package Licensing
Public domain, 596, 601	Royalty-free licensing – see Free licenses
Public licenses, 594–95, 618, 636	RPX Corp., 916–17
Puget Sound Financial, LLC v. Unisearch, Inc., 538	Ryan Data Exchange v. Graco, 179–80, 338–40, 376
Purchase orders, 533	C. Dillo Comiti I
	SanDisk Corp. v. STMicroelectronics, Inc. – 98–106
Qualcomm Inc. v. Broadcom Corp., 644-54	Sanyo limitation, 152–54
Quality control in trademark licenses, 469–79, 786	Saturday Evening Post v. Rumbleseat Press, Inc., 718–19,
Policing of quality, 474	724
Quality control clauses, 475–78	Schedules to agreement, 122
Quanta Computer, Inc. v. LG Electronics, 755-62, 767,	Scheiber v. Dolby Laboratories, Inc., 800, 805
768, 770–71	Schlaifer Nance & Company v. Estate of Andy Warhol,
Qui tam plaintiff, 408	285
	Schoenberg v. Shapolsky Publishers, Inc. – 54–59
Rambus Inc. v. Infineon Technologies AG, 645-46, 653	Schwendimann v. Arkwright Advanced Coating, Inc., 21–2
Rambus Inc. v. FTC, 654	Scott Paper Co. v. Marcalus Mfg. Co., 695–96, 703, 801-
Random House, Inc. v. Rosetta Books, LLC, 163-64	Sebastian Int'l, Inc. v. Longs Drug Stores Corp., 746, 74
Realtek Semiconductor Corp. v. LSI Corp., 657, 662-63	Securitization, 14–15
Reasonable efforts, see Efforts required	Security interests in IP, 40
Reciprocity requirements, 641	Seed licenses, 539

Lean Calant A Card Carte (Oa	American Matienal Charles Ind. Latitude (ANCI)
In re Select-A-Seat Corp., 683	American National Standards Institute (ANSI), 640
Settlement of litigation, 105	American Society of Mechanical Engineers, Inc.
Authority to settle, 337, 340	(ASME), 873, 874
Settlement agreements, 244, 306–8, 358–61, 713–17,	Bluetooth Special Interest Group, 638
875-83	Consortia, 638
Severability clause, 413–14	European Telecommunications Standards Inst.
Shop rights, 28, 404, 406	(ETSI), 638, 663
Share-alike license, 594, 596	HDMI Forum, 638
Shrinkwrap agreement, 523, 524–31	Institute of Electrical and Electronics Engineers
Siegel v. Chicken Delight, Inc., 849–53	(IEEE), 638, 661, 668, 669
Signature of agreement, 122, 362	International Organization for Standardization (ISO),
Single use device, 764, 766	638, 641, 646, 899
Societe Des Produits Nestle, S.A. v. Casa Helvetia, Inc.,	International Telecommunications Union (ITU), 646,
474-75, 782-89	899, 912
Software	Internet Engineering Task Force (IETF), 638, 639,
Code, 142, 575–77	659, 669–70
Copyright in, 577–78	Joint Electron Device Engineering Council (JEDEC),
Licensing, 581–83	645–46, 653
See also End User License Agreement (EULA)	Joint Video Team (JVT), 644–45, 646–51
Maintenance, 584	National Fire Protection Association, 871–73
Patents in, 579–80, 588	Telecommunications Industry Association (TIA), 660
Sale versus License, 736–44	USB Forum, 638
Support, 584	Standards-essential patents, 638–70
Trade secrets in, 580	Essentiality, 641–42, 643, 817, 904, 906, 909–10, 914,
Updates and Upgrades. 584, 629	915–16
See also Object code, Source code	FRAND, see Fair, reasonable and nondiscriminatory
Software as a Service (SaaS), 587, 590–91, 613	(FRAND) licensing
Sole licensee, 173, 180	Hold out, 664, 666
Solid Oak Sketches, LLC v. 2 K Games, Inc., 88	Hold-up, 639, 640, 664
Source code (software), 142, 575-77, 580, 585-86, 591,	Lock-in, see Lock-in
602–3, 609	Market power, conferring, 864–65
Proprietary licenses of, 582–83	Pools, 643
See also Open Source Software (OSS)	Royalty-free licensing, 640
Southern California Gas Co. v. Syntellect, Inc., 306–11	Royalty stacking and, 640
Specht v. Netscape Communications, Inc., 541–48	Standing to sue (licensee), 314–36, 340
Specification, 257, 288	Stanford v. Roche, see Board of Trustees of Leland
Spindelfabrik Suessen-Schurr Stahlecker & Grill v.	Stanford Jr. Univ.
Schubert & Salzer Maschinenfabrik AG, 49, 50,	State law issues – 21, 51–52
132–35, 157–58	See also Preemption of state law
Sponsored Research Agreement, see University	Statement of Work (SOW), 257, 258-59, 260-61
Technology Transfer – Sponsored Research	Statute of Frauds – 21, 67–68
Stallman, Richard, 597-601, 608, 622-23	Statutory termination of rights, 26, 383
Standard Oil Co. v. United States, 853, 860	STC.UNM v. Intel Corp., 333–34, 335
Standard Oil Co. (Indiana) v. United States, 16, 879, 888,	Step-Saver Data Sys., Inc. v. Wyse Technology, 535–36,
891–97	537-38
Standards and standardization, 17, 637-70	Studiengesellschaft Kohle m.b.H. v. Hercules Inc., 241–45
Antitrust issues, 654, 661, 667–68	Sublicensing, 149, 165-72
De facto standards, 642-43	Effect of termination on, 386–87
Due process, 871–75	Income, 226–28
Office of Management and Budget (OMB) Circular	Sublicensees, breach by, 380-81
A- 119–20, 874	Sugar Busters LLC v. Brennan – 37
Patents and, see Standards-essential patents	Sun Microsystems, Inc. v. Microsoft Corp. – 51
Patent pools, and, 643, 898-910	Systems Unlimited v. Cisco Systems – 20–21
SDO IP Policies, 640-41	
Disclosure policies, 644–54	Taco Cabana Int'l, Inc. v. Two Pesos, Inc., 462-63, 474
Ex ante disclosure of licensing terms, 654	Tattoos – 88
see also Fair, reasonable and nondiscriminatory	Tax issues, 140, 217
(FRAND) licensing	T.B. Harms Co. v. Eliscu, 54-59
Standards Development Organizations (SDOs)	TCL v. Ericsson, 659
Alliance for Telecommunications Industry Solutions	Technical Standards, see Standards
(ATIS), 660	Term and duration, 108, 112, 362-74

Term sheet – see Preliminary Documents	Sponsored Research, 448–51
Termination of agreement,	Surrogate licensing, 446–47
Bankruptey, 380	Technology Transfer Offices, 440–41
Breach, 374–81	Unwired Planet v. Huawei, 659, 660
Challenge to Validity, 725–27	U.S. Philips Corp. v. ITC, see Princo cases
Convenience, 381–83	Use not Sell rights, 158
Without cause, see Termination for Convenience	User limits (in software licenses), 581
Territory, definition, 147–48	AZ IVIV. GED
Texaco, Inc. v. Pennzoil Co., 117–18	Validity of IP,
Third party components (software), 256, 262	Arbitration of, 730
Trade dress, 462–64	Challenges to, 380, 709–30
Trademark usage guidelines, 479–80	See also Declaratory Judgment Act
TransCore, LP v. Elec. Transaction Consultants Corp.,	No-challenge clauses,
94–95, 360	Copyright licenses, in, 718–19
Transfer of licenses – see Assignment	Patent licenses, in, 361, 712–30, 807–8
Transocean Offshore Deepwater Drilling, Inc. v. Noble	Trademark licenses, in, 719–24
Corp. PLC, 717	Other Penalties for challenge, 725–30
Trimble Inc. v. Perdiemco LLC, 712	Value Added Reseller (VAR), 581–82
Troxel Mfg. Co. v. Schwinn Bicycle Co., 708–9	Vernor v. Autodesk, Inc., 736–44, 746, 771
	Video games, 17, 88
UMG Recordings v. Augusto, 745–46	Video Pipeline, Inc. v. Buena Vista Home Entertainment,
Unconscionability doctrine, 539–40	Inc., 821–23
Uniform Commercial Code (UCC) – 21, 52–53, 284, 294,	VirnetX, Inc. v. Cisco Systems, Inc., 207
296, 298, 346, 526–29, 536–37, 544, 551	
Uniform Computer Information Transactions Act	Waiver clause (no waiver), 412–13
(UCITA) – 53, 59, 298, 341, 406	Waiver doctrine, 651–52
Uniloc USA v. Microsoft Corp., 205, 207	Warner-Lambert Pharm. v. John J. Reynolds, Inc., 14,
United Nations Convention on Contracts for the	366–73
International Sale of Goods (UNCISG), 346-47	Warranties, 281–99
United States v. Inslaw, Inc., 674-77	Disclaimers of, 293–96, 448
United States v. Loew's, Inc., 855, 860, 862, 863	Intellectual property, 360–61
United States v. Mfrs. Aircraft Ass'n, 896, 897	Survival, 364
United States v. Microsoft Corp., 855-56, 858, 865-66	Warren v. Fox Family Worldwide, Inc. – 22–25
United States v. Paramount Pictures, Inc., 851–52	Web crawling, see Web scraping
United States v. Terminal R.R. Ass'n of St. Louis, 866	Web scraping, 549, 554
United States v. Topco Associates, Inc., 832-39	Westinghouse Elec. & Mfg. Co. v. Formica Insulation
United States v. Univis Lens Co., 752, 757, 761, 767, 768	Co., 692, 694–97, 702, 703
United States v. Wise, 739–40	Westowne Shoes, Inc. v. Brown Group, Inc., 184–85
University technology transfer, 172, 176, 236–37, 423–61	Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc.,
Bayh-Dole Act, and, see Bayh-Dole Act of 1980	578
Copyright, 456–61	Whitewater West Indus. v. Alleshouse, 34–35
Nine Points document, 441–42, 447, 448	Wood v. Lucy, Lady Duff Gordon, 187–89
Reserved rights, 442-43	Works made for hire, 22-25, 259, 519
Sharing of revenue, 459, 460, see also Bayh-Dole Act	Wrench LLC v. Taco Bell Corp., 74-79
of 1980 – Revenue Sharing	
Socially-responsible licensing, 444–46	Zenith Radio Corp. v. Hazeltine Research, Inc., 798,
Spinout companies, 446, 449	811–16, 887

