Index

A. A. Associates v. Prem Goel (India) 417
Access to Medicines Index 244
admission service agreements 436–7
Agromore v. Chembond Chemicals (India) 407
American Law Institute (ALI)
ALI principles governing jurisdiction/choice of law 331, 332–3
software contracts law see software contracts principles
anonymity 37
antitrust law 334–5, 394
arbitration
advantages for international IP disputes 353–6
licensing see arbitration and licensing nature 338–9
arbitration and licensing 337–52
arbitrability 356–60
inter partes decisions 359–60, 367–8
limits of jurisdictional powers of arbitral tribunals/erga omnes 358–60
moral rights 357–8
public order 358
confidentiality 361
challenges to arbitral awards before state courts, public nature of 362–3
trade secret/know-how protection 361–2
execution of the contract 341–2
exclusive, semi-exclusive, sole and simple licenses 342–3
France see under France governing law 366–9
coexistence agreements 366–7
validity of IP rights disputes 367–8
issues 356–75
obligation to work the subject matter of the license 343–7
economic approach 345–7
express provisions and implied duty to work 343–5
non-monetary relief 371–2
preliminary disclosures 339–41
arbitration clause, interpretation of 339
culpa in contrahendo 339
disclosure duties under Swiss law 340–41
promotion for arbitration of Intellectual Property, need for 375–7
provisional orders 369–71
applying for court injunctions 369–70
“emergency arbitrators” 370
recognition and enforcement of foreign awards 372–5
commercial relationships 374
New York Convention 372–5
ordre public 373
scope of arbitration clause 363–6
arbitration as creature of contract 363
need to embrace “universe of disputes” 364–5
non-contractual claims within arbitral tribunal’s jurisdiction, ensuring 365–6
termination for cause 347–51
Switzerland see termination UNIDROIT Principles of International Commercial Contracts 348–9
Arblade (Court of Justice, EU) 336
assignment/alienation
co-owner licensing or assigning interest 136–7
copyright (US)
divisible nature of rights 6
exclusive rights transfer 5, 7–8, 27
formal requirement 5–6, 7–8
non-exclusive rights transfer 5–6

Jacques de Werra - 9781781005989
Downloaded from Elgar Online at 02/16/2019 04:38:46AM via free access
state statutes of frauds 6
transfer of ownership of material
copy/rights 7–8
transferability 316–17
distinguished from license 34–5
European Patent Convention 130–31
license (Japan) 446–7
nature of 34
patent (UK) 131, 132, 135, 136–7
patent’s priority right (France) 141
transitive effect 35
see also US copyright contracts
attribution/paternity, right of 27, 358
default version of the CC license
requiring attribution 23
negatively expressed 37
US statutory moral rights of
attribution 10
Australia 164–5
Austria
copyright licensing 34
Private International Act 321
technology licensing model
agreements 185
authors
author’s rights 325, 327–8, 347
moral rights see moral rights
employees see under employers/
employers
in US see under United States
(US)
good faith: a uniform principle
351–2
overriding mandatory provisions
336
publicity for 23, 33
automated disablement see under
software contracts principles
Aviat Chemicals v. Magna Laboratories
(India) 419
Babul Products v. Zen Products (India)
401
bankruptcy 281–311
analysis and discussion 283–308
IP rights and debtor’s licenses
falling into debtor’s estate 281
relevant laws, effect of 281–3
bankruptcy of the licensee 296–300
distinct constellation 296
German law 298–9, 300
inclusion into the estate and
realization of license rights
300
Swiss law 296–8, 300
US law 299–300
bankruptcy of the licensor 289–96
German law 291–3, 296
Japanese law 447–8
maximization of the value of the
estate as dominant criterion
295–6
Swiss law 289–91, 296
US law 293–5, 296
bankruptcy proceedings, inherent
principles/goals in 286
contractual solutions 300–303
issues and interests 300–301
“survival” clauses 301–3
termination clauses 303
impacts of bankruptcy on license
agreements 281–3, 283–5
bankruptcy affecting all
agreements to which debtor a
party 283–4
“fully-paid” and “irrevocable”
licenses 285
licenses treated as sales or works
contracts 285
non-challenge undertakings 285
rights and entitlements of a
proprietary nature 285
specific treatments in proceedings
for ongoing agreements 284
treatment of license in bankruptcy
dependent on particular IP
licensed 285
interests at stake 286–9
bankrupt licensor’s agreements
should continue to be binding,
whether 287–9
burdensome obligations 282, 286
estate/administrators/creditors 286

Jacques de Werra - 9781781005989
Downloaded from Elgar Online at 02/16/2019 04:38:46AM
via free access
legislative activities and policy considerations 287–9
licensee of the bankrupt debtor 287
licensor of the bankrupt debtor 287
rehabilitation/reorganization proceedings 283, 286
policy perspectives and specific regulation 308–11
different regimes for different IP rights, whether 309
economic and related general policy considerations 308–9
obstacles to inclusion of license rights into debtor’s estate 310–11
privileged treatment, grant of 310
recordal of a license in the IP registry and its effects 303–5
registration of licenses 303–5
registration of other rights 305
treatment of license agreements in bankruptcy 289–300
bankruptcy of the licensor 289–96
contractual solutions 300–303
recordal of a license in the IP registry and its effects 303–5
territorial aspects and conflict of laws 306–8
Berne Convention for the Protection of Literary and Artistic Works 11, 112
Art 6bis: morals rights 11
Art 9: right of reproduction 432
lex loci protectionis as conflict of law rule 318
“three-step test” 432
“Best efforts” Patent (US) 144–5
binary use software (BUS) 78–9, 87–8, 92
breach of license
trade secret 155–6
Boardman v. Phipps (UK) 163–4
Bowden Wire (UK) 199–200, 202–3, 206
Burroughs v. MGM (US) 13–14
Canada: trade secrets and R v. Stewart (Can) 164
Center of Intellectual Property Law 185
certification mark 214
Chamberlain v. Skylink Technologies, Inc. (US) 114–15
caracteristic performance 325–8
China 381–99
China Copyright Protection centre 388
definition 382–6
categories of licensing 383–4
subject matter of license 382–3
validity of licensing agreements 384–6
future improvements 399
intellectual property laws 381
protection of public interests and national security 394–9
compulsory licensing regarding new varieties of plants 386, 395
compulsory patent licensing 386, 395
limitations on moral rights 398
non-voluntary licensing of layout design of integrated circuits 386, 396
statutory copyright licensing 386, 391–3, 396–8
technology transfer 398–9
regulation of licensing 387–99
co-ownership 388–9
employees/employers 390
freedom of contract 387
non-mandatory norms 391
non-retroactivity 389
presumptions 389–90
recordal of licences 387–8
reduction of transaction costs 387
statutory limitation of rights 391–3
waiver 389
safeguard of market competition 393–4
anti-monopoly 394
compulsory patent licensing 393–4
validity of licensing agreements 384–6
standard terms 385–6
written form 384–5
choice of law
ALI principles governing jurisdiction/choice of law 331, 332–3
consumer protection 320
employment contracts 320
freedom of contract arbitration 66–9
IP agreements see law governing international IP licensing agreements
model provisions on choice of law/jurisdictions 331–4
party autonomy 318–20
terms in patent license agreements 144–8

Clayton X-Ray Co. v. Professional Systems Corp. (US) 65
“clickwrap” licenses 4, 413
CLIP Principles 331–4
closest connection test 328–31
Coco v. A.N. Clark Limited (UK) 167–70
collecting societies/collective management societies
author’s moral rights 37
collective agreements 38
cross-border and European Directives Proposal 49–51
Extended Collective Licenses 43–4
nature 42–4
origins 43
India 415–16
national territories, based on 49–50
reciprocity agreements between collective societies 49
role 36
commercial law see under contracts/contract laws
commissioned works/works made for hire 5, 32, 390
model provisions 46–7
competition
unfair competition 105–6
see also under individual country
compulsory licenses 228, 230, 233, 243, 425
China see China
India 408, 422
Japan 428–9
computer crime 115–16
confidentiality/confidential information arbitration see under arbitration and licensing
employees confidential information and know-how 162
employees’ confidentiality agreements 179
technical assistance/process becoming employee’s own skill/knowledge 181
implied contractual obligation of confidentiality (India) 420
misappropriating valuable information see Japan
registration of licenses 448
trade secrets/know-how see trade secrets and know-how licensing
conflict of laws
bankruptcy 306–8
international IP licensing see law governing international IP licensing agreements
consumers
concluding international contracts 313
consumer protection 74, 119, 128, 259
ALI principles see software contracts principles
automated disablement 67
choice of law 320
copyright licenses 48, 52
overriding mandatory provisions 313, 336
Sales Convention 73
electronic standard forms 56–7
end-user license agreements, disputes over 26
India 410
personal injury 124
trademark licensing 206–8, 214, 221
contract manufacture 213–14
contracts/contract laws
adaptation of contracts 350–51
admission service agreements 436–7
ALI principles of software contracts see software contracts principles
arbitration as creature of contract 363–6
bankruptcy see bankruptcy
certainty in contracting 95–6
commercial law 257–8
general commercial law 259
IP commercial law as enabling law 259–61
key distinguishing features of IP commercial law 261–2
model law see model intellectual property commercial law
need for an IP commercial law 262
place of IP commercial law 258–9
conflict of laws see law governing international IP licensing agreements
contractual covenants/conditions see under covenant
copyright contract 37–8
distribution contracts see distribution execution of the contract 341–2
factual information/databases see information licensing
franchise contracts 323
freedom of contracting 95–6
copyright field see under European copyright licensing
general contract law 259
harmonization
EU harmonization 148, 471
international 130
information provision service agreements 435–6
IP commercial contract law model see model intellectual property commercial law
license exchange contracts/reciprocal agreements 330
and licenses see under licenses
material transfer agreements 435
patent licensing see under international patent licensing
performance service agreements 436
Principles of International Commercial Contracts, UNIDROIT 260, 319, 348–9
relational contracts 350, 352
remedies
bankruptcy 284
remedy limits 124
sale of goods 324–5
service provision contracts 186–7, 323–5
license agreement as contract for provision of services 464–8

Jacques de Werra - 9781781005989
Downloaded from Elgar Online at 02/16/2019 04:38:46AM via free access
termination of contracts see termination
trademarks 217–18
works contracts 186–7, 337
Convention on Contracts for the International Sale of Goods 148, 260, 262
Art 42: warranty for Intellectual Property Rights 72–4
Convention on International Interests in Mobile Equipment 260
copyright 99, 100
arrangement’s level of protection 101–3
and bankruptcy 309
conflict of laws see under law governing international IP licensing agreements
databases see information licensing
European copyright licensing see European copyright licensing
model provisions for copyright licensing see under European copyright licensing
moral rights see moral rights
open source licenses see open source licenses
recordal of licenses, no provision for 303–4
software 93
transferability see under assignment/alienation
see also individual countries
Copyright Treaty 112
Council of Europe see European Council
Covenant
covenants/conditions 90–91
MDY case’s 92–5
license conditions 90–97
MDY complication 95–7
non-assertion covenants 228–9
Creative Commons (CC) see open source licenses 4, 21–6, 28, 32
criminal law and trespass 115–16
cross-border licensing
cross-border dimension of copyright licensing/soft international law-making 47–8
Japan 448–9
need for rules and/or EU instrument for 47–51
online exploitation of copyrighted works 49–51
standardization of copyright licenses through the practice 48
culpa in contrahendo 339
Cybercrime Convention 115
Cvent v. Eventbrite (US) 118–19
data protection and privacy 123–4
databases see information licensing
Dawn Donut (US) 210
Denmark 42–4
Deshmukh v. Avinash Khandekar (India) 409
design
imposing formalities/freedom of contract in Europe 32
India see under India
developing countries see social voluntary patent licensing
digital media
automated disablement see automated disablement
databases see information licensing
digital libraries 30, 42–4
Digital Opportunity (Hargreaves Report) 51–3
Dior-Copad (Court of Justice, EU) 452–5, 461
disclosure
arbitration see under arbitration and licensing
disclosure of intent to use self-help 68–9
fairness of terms
alternatives to disclosure not feasible 59–60
increased disclosure leading to fairer terms 58–9
Index 479

trade secrets, non-disclosure/confidential disclosure agreements for 173–5
distribution 213, 323
general dealership 343
Doha Declaration 227
DuPont (US) 210

employees/employers
academics see technology licensing between academic institutions/private companies
authors/creators working as employees
China 390
Europe 32
United States 5
choice of law 320
freedom of contract erosion 31–2
labor disputes 374
model provisions 46
overriding mandatory provisions 336
trade secrets confidential information and know-how 162
employees’ confidentiality agreements 179
technical assistance/process becoming employee’s own skill/knowledge 181
endorsement 215–16
end-user license agreements (EULAs) 26
enforcement
enforcement of foreign awards 372
enforcement of circumvention control of access 111–15
see also enforcement of open source software licenses
enforcement of open source software licenses 76–98
benefit from Jacobsen v. Katzer and MDY Trio’s 98
covenants see under covenant and license conditions
Jacobsen v. Katzer (US) 76, 80–85, 92, 98

contract law applying to open source licenses 84–5
ignoring license condition as breach and as copyright infringement 83
injunctive relief for breaches of open source licenses 83–4, 85
license provision as pure contractual covenant or license condition 84
MAITrio of cases 76–7, 86
MDYTrio of cases 76–7, 86–97, 98
covenants/conditions: MDY case 90–97
definition of a license: Vernor v. Autodesk 86–9
primer on open source licensing see under open sources licenses
EPI Technologies Inc. v. Symphony Plastic Technologies Plc. (UK) 176

Europe/EU
competition law 139, 159
antitrust law 334–5
contract law harmonization 148, 471
copyright licensing see European copyright licensing
European Commission see European Commission
harmonization of IP licensing law see harmonization of IP licensing law, need for
innovation policy 450–51
IP licensing/block exemption regulations
“grey clauses” 139
no challenge clauses 139
law applicable to 314, 316, 321–5, 452
caracteristic performance 325–8
closest connection 328–31
law applicable in absence of choice 321–5
law applicable to non-contractual obligations 368
lex loci protectionis rule see lex loci protectionis
overriding mandatory provisions 319–20, 334–5
Rome Regulations see Rome Regulation I; Rome Regulation II
standing 468–70
“know-how” definition 159–60
patents 305
international patent licensing see under international patent licensing
recordal of licenses 305
trademarks 305
European Commission
copyright licensing harmonization 29
codification of copyright directives 47
European framework for online copyright licensing 49
IP licensing as key element of innovation policy 450–51
no-challenge clauses 139
Recommendation on collective cross-border management of copyright for music 50
state aid for research and development and innovation 194
European Copyright Code (Wittem group) 44–5
European copyright licensing 29–53
cross-border licensing see cross-border licensing
current issues European copyright licensing 29–31
convergence in licensing practices 30
divergence in copyright licensing rules 29–30
no uniform contract law 29
objectives of copyright licensing rules 30
sector specific variations in licensing practices 30
databases 101, 105–6
freedom of contract in the copyright field 31–4
constraints on freedom of contract in employment contracts 31–2
evolution of copyright contract with dissemination of works online 33–4
patent, trademark and design contracts 32
statutory limitations for copyright contracts 31–2
harmonization 29
developing model provisions for copyright licensing 44–7
fostering digital uses 51–3
rules for cross-border licensing 47–51
key features of copyright licensing 34–44
distinction between license and assignment 34–5
extended collective licensing 42–4
formal conditions for copyright contracts/proof, specification 37–8
future works and unknown modes of exploitation 39
general right to remuneration 41–2
interpretation 40
obligation to specify the terms of the assignment/license 39–40
scope of licenses/exclusive and non-exclusive 35–6
statutory limitations to copyright licenses 38–41
termination 40–41
waivers of moral rights 36–7
misappropriation/EU Database Directive extraction rights 105–6
model provisions for copyright licensing (European Copyright Code) 44–7
economic rights 45
limits 45–6
works made on commission 46–7
works made in course of employment 46
European Council 115
European Court of Justice 470–71
European Directive
Cable and Satellite Directive, EU 43
Database Directive, EU 105–6
European Trademarks Directive 217, 305
Art 8 453–5, 457, 459–63
recordal of licenses in IP registries 305
European Patent Convention (EPC) 130–35, 135–6
assignment and transfer see under assignment
contractual licensing 130
law, applicable 130
national law 130–31
registration 305
transactions under the EPC 130–31
European Patent Office 131
European Unitary Patent 131–6
draft regulation 131–2
exhaustion principle 452–63
contractual remedies 462–3
dior-Copad (Court of Justice, EU) 452–5, 461
divergence of relevant rules on suing for infringement 457–8
Greenstar-Kanzi Europe NV v. Hustin and Goossens (Court of Justice, EU) 455–7, 462
Japan 434
license agreements not offering unrestricted protection to third parties 454–5
list of contractual provisions of Art 8(2) Directive 2008/95 exhaustive 455
presumption for licensed goods 454
problems with listing provisions triggering infringement remedies on breach 461–3
protection enjoyed by the holder not to be excessive 456–7
regulations and IP remedies available only for rights infringement 459–61
uncertainty whether licenses and sub-licensees benefit from rights 463
extended collective licenses see under collective societies/collective management societies
extraction right 106
factual information see information licensing
fairness of terms see under software contracts principles
Falco (Court of Justice, EU) 324, 464–8
Fedders North American v. Show Line (India) 422
first sale doctrine 86–7, 431–2
exhaustion principle see exhaustion principle
FOSS (free and open source software) 78, 79
France
arbitration of IP disputes 376
copyright 44
copyright contracts conditions 37–8
copyright contracts to specify breadth of rights licensed 38
future works and unknown modes of exploitation 39
obligation to specify the terms of the assignment/license 39–40
remuneration for use of copyrighted works 41
statutory limitations for copyright contracts 31–2
moral rights, untransferable nature of 36
patents
license agreements, implied terms in 143
“priority right” assignment 141
simple license 345
trade secrets protection by contract/tort remedies/labor law 166
trademark licensing 218–19
code-focused approach to trademark licensing 218

Jacques de Werra - 9781781005989
Downloaded from Elgar Online at 02/16/2019 04:38:46AM
via free access
proprietary rights of licensors 218–19
quality control 219
trademark law 218
franchises 323, 337
provisions protecting franchisees 335
Frank & Sons v. Information Solutions, Inc. (US) 65
Fred Ahlert Music Corp. v. Warner-Chappell Music (US) 18–19
Fred Fisher v. Witmark (US) 19–20, 21
Free Software Foundation see open source licenses
freedom of contract 461–2
China see China
choice of law arbitration 366–9
IP agreements see law governing international IP licensing agreements
compulsory licenses see compulsory licenses
European copyright licensing see European copyright licensing
party autonomy and choice of law 318–20
Germany
automated disablement see under Software contracts principles
bankruptcy code 284, 308
administrator’s decision whether ongoing agreements performed 287
agreements that are unfulfilled at time of bankruptcy 284
bankruptcy of the licensee 298–9
bankruptcy of the licensor 291–3, 296
inclusion into the estate and realization of license rights as main issues 300
maximization of the value of the estate as dominant criterion 295–6
proposal that bankrupt licensor’s agreements continue to be binding 287–9
“survival clauses” 302
territorial aspects and conflict of laws 307–8
copyright 44
conditions for copyright contracts 37–8
Copyright Act 299
copyright only capable of being licensed 34–5
employees’ inventions 183–5
future works and unknown modes of exploitation 39
interpretation 40
obligation to specify the terms of the assignment/license 40
remuneration for use of copyrighted works 41–2
statutory limitations for copyright contracts 31–2
termination 40–41
see also technology licensing between academic institutions/private companies
licensing agreements
establishing existence of 341
general license 343
simple license 345
terminating long-term agreements for just cause 349–51
overriding mandatory provisions 336
patents
implied obligations in patent license agreement 140
interpretation/“actual will of the parties” 144
sub-licensing 137
trademark licensing 216–18
German Trademark Act 217
nature of the license 217–18
trade secrets protection by unfair competition 166
global policies for arbitrating intellectual property disputes see arbitration and licensing
Index

483

global software licensing policy see software contracts principles

good faith

good faith considerations in international patent licensing 143–4

principle of 352

termination for cause 351

trade secrets and equitable duty of good faith 167

**Gracen v. Bradford Exchange** (US) 17

**Greenstar-Kanzi Europe NV v. Hustin and Goossens** (Court of Justice, EU) 455–7, 462

“grey clauses” 139

**Gujarat Bottling Co. Ltd. v. Coca Cola Co.** (India) 411–12

Hargreaves Report see under United Kingdom

harmonization

European contract law 148

European copyright law 29

benefits from developing model provisions 44–7

European perspective see harmonization of IP licensing law, need for

international patent licensing harmonization 126, 130, 148–54

harmonization of IP licensing law 450–72

exhaustion principle/products commercialized by licensee 452–7

impact on European landscape 457–61

see also exhaustion principle

IP licensing as key element of innovation policy 450–51

issues of harmonization 470–71

license: contract for provision of services/ *Falco* 464–8

licensee’s standing to sue third party infringers 468–70

present status of European IP licensing law 452

**Herbert Morris v. Saxelby** (UK) 163

hire, works made for see commissioned works/works made for hire

HIV/AIDS drugs see socially responsible IP licensing policies, developing

Hooper Report see United Kingdom

immunity-from-suit agreements 228–9, 231

indemnification

international patent licensing 154

software contracts infringement see under software contracts principles

India 237, 400–424

default rules on duration/territory of agreements/reversion 404

definition

inventions, nature of 230

generic drugs production 229–30, 243

pharmaceutical product patents 230, 243

software definition 413

exclusive, non-exclusive and sole licenses 406–7

copyright law 406

design law 407

patent law 406

trademark law 406

formal conditions of validity for licensing agreements 401–3

copyright law 401–2

designs 403

patent law 403

trademark law 402–3

laws and act

Consumer Disputes Redressal Commission 410

Contract Act 411–13

Copyright Act 400, 401–2, 404–8, 413–17, 423

Copyright (Amendment) Act 404–5, 415–16

Designs Act 403, 407

Finance Act 420

Jacques de Werra - 9781781005989

Downloaded from Elgar Online at 02/16/2019 04:38:46AM
via free access
Industrial Policy 408
Patents Act 230, 243–4, 403, 406, 408–9
Patents (Amendment) Act 403
Specific Relief Act 418
Trade Marks Act 402–3, 406, 408–9
moral rights 413
obligation to actively use 404–5
legal standing to sue 407–8
copyright law 407
patent law 408
trademark law 408
public policy considerations 411–23
future modes of exploitation 416–17
guidelines on distinction between breach and infringement 413–14
implied contractual obligation of confidentiality 420
invalidity of the IP license 420
licensee estoppel 421–2
post-termination right of sell-off 419
protection mechanisms for benefit of weaker party 405, 415–16
regulatory approvals 419–20
restraint of trade 411–12
termination of IP licenses 417–18
waiver of statutory rights 413
reversionary rights 404–5, 413
standard form contracts 409–10
information licensing 99–125
access issues in digital setting 111–16
circumvention of copyright protection systems 112–15
control of access by technological means 111
criminal law and trespass 115–16
contract rights 100–101, 116–19
contract formation online 117–18
importance of contractual nature of license agreement 116–17
imposition of contractual terms to public site 118–19
limitations as part of scope of permitted use/promises about use 117
copyright law issues 101–5
estimates and professional judgments constituting expression 104–5
exclusion of facts from copyright protection 103
protected arrangements or selection 101–3
thin copyright 101, 103
US and European protection for databases as to creative selection 101
definition of a fact for licensing 103–5
difficulty of obtaining protection 124–5
liability issues 119–24
defamation 122
digital products on tangible media and goods-based obligations 119–20
general liability issues 119–22
implied warranties and obligations 120–22
privacy and data protection 123–4
quality/accuracy of data/database provided 119, 120–22
remedy limits 124
general framework 99–100
misappropriation 105–11
criteria for when general misappropriation survives preemption 108
EU Database Directive extraction rights 105–6
extraction and reutilization 106
“hot news” doctrine (US) 107–10
meaning of misappropriation/unfair competition 105
property law basis for licensing 109–10
US misappropriation law subject to preemption by federal law 106–7
Index 485

terms of use 100–101
information provision service agreements 435–6
Information Society Directive, EU 43
innovation/inventions
EU Framework for State Aid for Research and Development and Innovation 194
inventions as a form of knowledge, nature of 227–8
IP licensing as key element of innovation policy 450–51
insolvency see bankruptcy
intellectual property (IP)
bankruptcy see bankruptcy
importance of IP assets 257
intellectual property law
IP commercial law as enabling law 259–61
key distinguishing features of IP commercial law 261–2
need for an IP commercial law 262
place of IP commercial law 258–9
international IP licensing see law governing international IP licensing agreements
model law see model intellectual property commercial law
international patent licensing 126–54
differences in national patent laws 136–41
assignment of “priority right” 140–41
consent of co-owner for licensing/assignment 136–7
licensee’s right to sue infringers 138–9
obligation to sue infringers 138
patent improvement 140
right to sub-license 137–8
validity challenge of a licensed patent 139–40
existing European and international laws 130–36
Community patents/Community Patent Convention 131–5
European Patent Convention 130–31
Patent Cooperation Treaty 136
laws affecting patent licensing agreements 127–9
commercial and consumer laws 128
common areas of dispute 128–9
contract and tort 127–8
general property law 127
private international laws 128
national contract law and practice 141–8
“best efforts” and “reasonable efforts” 144–5
choice of law affecting terms in patent license agreements 144–8
courts, judiciary and litigation costs 143
cultural influences and business trends 143
differences between common and civil law approach 142–3
factors affecting patent license agreements 143–8
general contract law principles affecting interpretation of terms 142
good faith considerations 143–4
implied terms in agreement, extent of 143
implied warranties of title 145–6
limiting/excluding liability for breach of contract 147–8
procedural differences in contract litigation 143
termination for licensee’s insolvency/bankruptcy 146–7
proposal for a European Unitary Patent 131–6
proposal for standard set of obligations in patent license agreements 126, 148–54
assignment and change of control 153–4
cooperation 152
co-ownership and licensing 150
financial terms 152
governing law/dispute resolution 153
indemnification 154
interpretation 154
licensing 151
prosecution and infringement 151–2
registration of licenses 150
scope 149
termination 153
title and warranties, registration of interests 149

Internet
advantages of Internet publishing 33
automated licensing via the Internet: legal and policy issues 21–8
general observations about public “sharing” licenses 21–6
standard forms and public sharing licenses 26–7
Creative Commons (CC) licenses see open source licenses
cross-border licensing 47–9
end-user license agreements 26
evolution of copyright contract with dissemination of works online 33–4
need for clearing mechanisms to foster digital uses 51–3
standard forms/fairness of terms see software contracts principles
terms of use 26–7
user-generated content sites 26–7
watchdog groups 59
inventions see innovations/inventions
form of knowledge 227–8
Ireland 41, 44
Italy 41, 131

J.K. Jain v. Ziff-Davis (India) 421
Jacobsen v. Katter (US) 22, 76, 80–85, 86, 92, 98
Japan 425–49
admission service agreements and IP licenses 436–7
information provision service agreements and IP licenses 435–6
material transfer agreements and IP licenses 435
performance service agreements and IP licenses 436
assignment of IP rights on licensing 445–6
bankruptcy 446, 447–8
Bankruptcy Act 447–8
patent license 447–8
protection for licensees of a bankrupt debtor 288
Civil Code 427, 443–4
court proceedings and public nature 361
cross-border license agreements 448–9
definition 425
distinguishing between IP licenses and related/similar transactions 435–7
compulsory or statutory licenses 428–9
licensor’s rights based on customs and practices 427–8
licensor’s rights based on misappropriating valuable information law 426–7
licensor’s rights based on a specific intellectual property law 426
licenses based on law regulating misappropriation of valuable information law 426–7
licensor’s rights based on the Civil Code 443–4
Unfair Competition Prevention Act 444–5
limitation and exceptions of right 429–34
exhaustion of patent rights 434
first sale doctrine 431–2
limitations on the exclusive rights 430–31
personal use of copyrighted works 432–3
research and development exceptions 433–4
misappropriation of information see misappropriation
registration of licenses 437–9, 440–41, 447–9
rights granted 429–30
specific IP law 437–43
Act on the Circuit Layout of Semiconductor Integrated Circuits 426, 442
Copyright Act 425–6, 428–33, 436, 438–40, 445–6
Design Act 426, 440, 446
Plant Variety Protection and Seed Act 426, 442–3
Trademark Act 426, 430, 440–41, 446
Utility Model Act 426, 437–8, 446
transfer of license’s right 446–7
Transparency of Japanese Law Project 332, 333
Unfair Competition Prevention Act 427, 444–5
Jean Christian Perfumes Ltd/Jigsaw European Sales Ltd v. Sanjay Tharkar (UK) 468–9
John Richard Brady v. Chemical Equipment Processes (India) 420
just cause, termination for 349–51
know-how see trade secrets and know-how licensing
Konrad Wiedemann GmbH v. Standard Castings (UK) 420
Korean Private International Association (KOPILA) 332, 333
law governing international IP licensing agreements 312–36
applicable law in the absence of choice 320–34
characteristic performance 325–8
closest connection 328–31
license agreements under Rome I Regulation 321–5
typology of contracts and connecting factors 320–21
characterization and scope of law applicable to IP rights 313–18
copyright and related rights 316–18
industrial property rights 313–16
globalization of commercial activity, effects of 313
model provisions and future perspectives 331–4
ALI principles governing jurisdiction/choice of law 331, 332–3
CLIP Principles 331–4
Korean Private International Association (KOPILA) 332, 333
Transparency of Japanese Law Project 332, 333
Waseda University Global-COE Project 332
need for careful drafting of international contracts 312
overriding mandatory provisions 334–6
antitrust law 319–20, 334–5
mandatory provisions and public interests, importance of 313, 333, 334, 335–6
party autonomy 318–20
territorial nature of IP rights 312–13
legal fictions 201–2
lex contractus 319, 326, 339
lex loci protectionis 314–15, 317–19, 324, 329
and lex originis 317
liability for information see under factual information and databases licensing
license exchange contracts/reciprocal agreements 330
licenses/licensing arbitration and licensing see arbitration and licensing
bankruptcy see bankruptcy China see China
“clickwrap” licenses 4, 413
compulsory licenses 228, 230, 233, 243
and contracts 84–5, 100–101, 228
license agreement as contract for
provision of services 464–8
databases see factual information and
databases licensing
definition 170–71, 337–8, 425, 464
essential nature of a “license”
170–71
exclusive licenses 342–3, 344,
406–7, 438, 447
general license 343
key structure and components of
licenses 172–3
nature of license 34, 337–8
non-exclusive licenses 406–7,
437–8, 447–8
semi-exclusive license 342–3
simple license 342–3, 344
sole license 342–3, 346–7, 406–7
trade secret licenses 170–71
distinction between contractual
coventns and license conditions
90–97
illustrating distinction between
covenants/conditions 90–91
MDY case’s take on covenant/
condition distinction 92–5
sliding scale approach that
addresses the MDY
complication 95–7
distinction from assignment 34–5
enforcement of open source software
licenses see enforcement of open
source software licenses
European copyright licensing see
European copyright licensing
extended collective licenses see
collective societies/collecting
management societies
India see India
international IP licensing see law
governing international IP
licensing agreements
Japan see Japan
license exchange contracts 330
obligation to work the subject matter
of the license 343–7
economic approach 345–7
express provisions and implied
duty to work 343–5
open source see open source licenses
patent licenses 228
international see international
patent licensing
pharmaceutical sector see socially
responsible IP licensing policies,
developing
production licenses 324–5
“promotional” licensing 221–2
Rome I Regulation see Rome I
Regulation
scope of licenses/exclusive and
non-exclusive 35–6
shrink-wrap licenses 413
social voluntary patent license
responsible see social voluntary
patent licensing
sub-license, implied right to 137
technical assistance/know-how
licenses see technical assistance/
know-how licenses
technology licensing
general aspects of 171–3
see also technology licensing
between academic
institutions/private companies
termination see under arbitration and
licensing
trade secrets and know-how see trade
secrets and know-how licensing
Maganlal Savani v. Rupam Pictures
(India) 417
MAI Systems v. Peak Computer (US) 77,
86
material transfer agreements 435
Max Planck Institutes 331
MDY Industries v. Blizzard
Entertainment (US) 90–97, 98,
114–15
Médecins sans Frontières 231
Index 489

medicines/drugs production see social voluntary patent licensing

Medicines Patent Pool Foundation 233–4, 239, 241, 243

Mills Music v. Snyder (US) 15–19
misappropriation
databases/factual information 105–11
criteria for when general misappropriation survives preemption 108
EU Database Directive extraction rights 105–6
extraction and reutilization 106
“hot news” doctrine 107–10
meaning of misappropriation/unfair competition 105
property law basis for licensing 109–10
US misappropriation law subject to preemption by federal law 106–7
EU 101, 105–6
Japan
licenses based on law on misappropriating valuable information 443–5
licensor’s rights based on misappropriating valuable information law 426–7

Mishara Bandhu Karyalaya v. Shivratnanlal Koshal (India) 414
model intellectual property commercial law 257–80
general observations 258–62
IP commercial law as enabling law 259–61
key distinguishing features of IP commercial law 261–2
need for an IP commercial law 262
place of IP commercial law 258–60
model intellectual property commercial law 269–80
overview of proposed model law 262–8
formation 264–5
general provisions 262–4
interpretation 265
performance 266
remedies 267–8
transfer 267
transition 268
warranties 265–6
model provisions for copyright licensing see under European copyright licensing
model provisions on choice of law/jurisdictions 331–4
Moorgate Tobacco Co. Ltd v. Philip Morris Ltd (Aus) 164–5
moral rights
arbitration 357–8
Berne Convention for the Protection of Literary and Artistic Works (art. 6bis) 11
China 398
collecting/collective management societies 37
economic rights 358
Japan 439–40
untransferable/inalienable moral rights 36, 316–17, 357, 439–40
waivers of moral rights 11–12, 36–7, 316–17
attrition, right of 37
moral right of integrity 37

Morris Communications Corp. v. PGA Tour, Inc. (US) 109–10, 111
Motorpresse International Verlagsgesellschaft Holding MBh. v. Mistrale Publishing (India) 421
Mundipharma AG v. Wockhardt (India) 412

Nariman Films v. Dilip R. Mehta (India) 414–15
National Basketball Association v. Motorola, Inc. (US) 108–9, 110
National Publishing House v. Amit Sachdeva (India) 409
National Research Development Corporation v. ABS Plastics (India) 418

Jacques de Werra - 9781781005989
Downloaded from Elgar Online at 02/16/2019 04:38:46AM
via free access
Research handbook on intellectual property licensing

Netherlands copyright 44 patents “best endeavors”, interpretation of 145 good faith considerations 143 license agreements, implied terms in 143 New York Convention 341, 364, 372–5, 376 commercial relationships 374 limited grounds of non-recognition/ non-enforcement of foreign awards 373–4 New York Times Co. v. Tasini (US) 8, 9 no challenge clauses 139 non-assert declarations 227, 228–9, 231, 235–6 North Texas Preventive Imaging, LLC v. Eisenberg (US) 65 Norway 42–4 open source licenses 4, 21–6, 28, 32 advantages 25–6, 33 definition core feature of CC licenses 23 nature of open source license 78 Open Source Definition 77–8 Open Source Initiative 78 enforcement see enforcement open source software licenses evolution of copyright contract with dissemination of works online 33–4 Free and Open Source Software (FOSS) 78–9 Free Software Foundation (FSF) 78 freedom of contract leading to development of new forms of licensing 32 incompatible with inalienable right to terminate grants of rights 23–4 localizing Creative Commons licenses to take account of national frameworks 48 moral rights waiver 317 see also morals rights new technologies 25 “non-commercial” limitation 24–5 non-exclusivity nature of public licenses 24 open source licensing not restricting transfer 87 providing for reservation of range of rights 22 remuneration commercial/new business models of online distribution 33–4 consumer protection/competition aspects 48 no direct remuneration provided for uses 23, 28 publicity for authors, useful for 23, 33 reputation and popularity 33 reproduction rights and public performance/communication rights 25 standardization of for-profit and free/open licenses 48 transfer free transferability of software at heart of open source licensing 87 open source licensing not restricting transfer 87 validity and enforceability under copyright law 22 “viral” license 4, 28 Oracle v. Ubisoft (Court of Justice, EU) 453 ordre public see public order and national security “orphan works” 42 Paris Convention for the protection of Industrial Property national treatment principle 314 registration without authorization 441 right of priority 140–41 unfair competition 165 Patent Convention, European see European Patent Convention (EPC)
Patent Cooperation Treaty 130, 136
patents 99, 100
compulsory licenses see compulsory licenses
European see European Patent Convention (EPC)
immunity-from-suit agreements 228–9
imposing formalities/freedom of contract in Europe 32
initial IP owner usually marketing protected goods 33
international patent licensing see international patent licensing licenses 228, 326–7
and bankruptcy 447–8
non-assert declarations 227, 228–9, 235–6
non-assertion covenants 228–9
open patent pledges/patent pools agreements 32
pharmaceutical sector see social voluntary patent licensing see also individual countries; social voluntary patent licensing
paternity, right of see attribution/paternity, right of
Percept D'Mark (India) v. Zaheer Khan (India) 411
performance service agreements 436
pharmaceutical sector licenses see social voluntary patent licensing
Principles of European Contract Law (PECL) 62
“priority right” 140–41
privacy and data protection 123–4
proprietary/commercial software 78–9
public order and national security 264, 270, 358, 373–4, 376
arbitration 358
China see under China
India see under India
see also compulsory licensing
public “sharing” licenses see open source licenses
Qimonda (US) 307–8
quality control see under trademark licensing
Rajasthan Breweries v. The Stroh Brewery (India) 417–18
Random House, Inc. v. Rosetta Books, LLC (US) 10
reciprocal agreements 330
recordal of licenses in IP registries 303–5
China 387–8
copyright licenses, no provision for 303–4
effect of recordal of licenses 304
European Trade Marks Directive 305
India 403, 418
Japan 437–9, 440–41, 447–9
Switzerland 304
UK registered user regime 203–4, 208, 210
Regina Glass Fibre Ltd v. Werner Schuller (UK) 177
relational contracts 350, 352
remedies
bankruptcy 284
contractual remedies 462–3
remedy limits 124
software copyright remedies 71–2
specific breach of license contract 459–61
trade secret 166
research and development (R&D) 337
R&D Agreements Regulation 139
research and development agreements 324
see also technology licensing
between academic institutions/private companies
restraint of trade (India) 411–12
reutilization 106
Rome Convention 321, 326, 336
Rome I Regulation 316
law applicable in absence of choice 321–5
characteristic performance 325–8
closest connection 328–30
license agreements under 321–5
Research handbook on intellectual property licensing

overriding mandatory provisions 319–20, 334–6
party autonomy
  codified in broad terms 319
  consumer protection 320
  restrictions and exceptions 320
Rome II Regulation 314, 368
Rupendra Kashyap v. Jiwan Publishing (India) 406
safe harbour requirements 57–8
Saregama India v. Suresh Jindal (India) 410, 414
Scandecor (UK) 205–8, 220
Schroeder Music v. Macaulay (UK) 410
self-publishing 21–6
service provision contracts 186–7, 323–5
Shringar Cinemas v. Bharat Bala Productions (India) 415, 418
shrink-wrap licenses 413
Siegel v. Warner Bros. (US) 13, 14–15
social voluntary patent licensing 227–56
  assessment of current strategies 241–4
  Access to Medicines Index 244
  added value of license agreements in potential for reduced prices 242
advantages of voluntary licensing agreements 242
increasing pressure to expand licensing programmes 243–4
limitations of current voluntary licensing agreements 242–3
  corporate responsibility programmes 230–31, 242
current license agreements 231, 245–53
current trends in voluntary licensing programmes 235–41
  geographic scope of marketing rights 237–9, 242
  number of licensees 237, 242
other aspects 241
  products and disease areas 235–7
  royalties 239, 242
  technology transfer 240, 242
developing countries 229–30, 242, 244
diseases/illnesses
  cancer treatment 244
HIV/AIDS treatment 229–32, 233–6, 239, 242
  influenza 232–3, 237
increasing use of non-exclusive licenses by pharmaceutical companies 227, 231
initiatives in pharmaceutical sector 231–2
  emergency responses/programmes 232–3
  licensing programmes developed from specific legal disputes 231–2
Medicines Patent Pool Foundation 233–4, 239, 241, 243
patent licenses 228–9
covenants 228–9
immunity-from-suit agreements 228–9, 231
importance of patent exclusive rights in pharmaceutical sector 229
non-assert declarations 227, 228–9, 231, 235–6
soft law-making
  European 50–51
  international 47–8
software contracts principle 54–75
  assent to electronic standard forms and fairness of terms 56–60
  alternatives to disclosure 59–60
  consumer behaviour to standard forms 58–9, 60
  contract formation/safe harbour requirements 57–8
  cooling-off periods 60
  fair warning 58
  fairness of terms 56–7
increased disclosure leading to fairer terms 58–9
suspect terms 56, 57
watchdog groups 59
automated disablement 64–9
definition 66–7
disclosure of intent to use self-help 68–9
exclusion of consumer agreement and standard form licenses 67
flexible standard 74
impairment of access to other programs/data 67
requirements for exercise 68
restrictions on use as remedy for breach 67–9
self-help 65–6, 68
UCITA 64–7
enforcement see enforcement of open source licenses
implied warranty of no material hidden defect 60–64
criticisms of disclosure requirement, answers to 63
disclosure advantages 62–3
fraudulent disclosure 62
non-disclaimable warranties 60–62, 64
indemnification against infringement 69–74
disclaimers of warranty of title 70
implied indemnification system 71–2
international approaches 72–4
limitations on obligations 72
remedies 71–2
warranty liability 70–71
Uniform principles efforts 5
South Africa 232, 238
Spain
patents 131
implied warranties of title 146
licensees having right to sue infringers 138
rights of co-owners 137
termination for licensee’s bankruptcy 146–7
remuneration for use of copyrighted works 41
sponsorship 214–15
standard form contracts 409–10
automated disablement see under software contracts principles
standing
India 407–8
copyright law 407
patent law 408
trademark law 408
legal standing to sue third party infringers 468–70
US patent law standing to sue 139
state aid 194
Sun Microsystems, Inc. v. Microsoft Corp. (US) 84
“survival clauses” 301–3
Sweden 145
Switzerland
arbitration 340, 367
challenges to arbitral awards before state courts, public nature of 362–3
disclosure duties 340–41
non-monetary relief 372
obligation to work the invention 345–6
terminating long-term agreements for just cause 349–51
bankruptcy 308
bankruptcy of the licensee 296–8
bankruptcy of the licensor 289–91, 296
Debt Collection and Bankruptcy Act 290–91, 297–8, 301, 303
inclusion into the estate and realization of license rights as main issues 300
maximization of the value of the estate as dominant criterion 295–6
recordal of licenses 304
specific treatments in proceedings for ongoing agreements 283–4
“survival clauses” 301–2
territorial aspects and conflict of laws 306–7
Code of Obligations 290, 297
contract law 298
licensing agreements, establishing existence of 341
Private International Law Act 306–7, 362
terminating long-term agreements for just cause 349–51
Taprogge Gesellschaft MBH v. IAEC India (India) 412
Tata Chemicals v. Skypak Couriers (India) 410
technical assistance/know-how licenses 324, 327
trade secrets see under trade secrets and know-how licensing
technology licensing between academic institutions/private companies 183–95
Berlin contract components 185, 186–93, 195
common features in research commissions/research cooperation 188–9
contract components for research commissions 189–90
contracts for work and services 186–7
industrial partner’s results 190
joint results 190–91
modernization of Berlin contract in revised “2007 edition” 192–3
present practice under Berlin contract 191–2
research commissions 187
research cooperation 187–8
research cooperation research results 190–91
structure and organization 186
university results 191
BMWi contract 185, 193–4, 195

German law concerning employees’ inventions 183–5
professor/researcher having right not to publish 184
professor/researcher not able to be forced to provide consultancy 184
waiver of rights 184
model agreements 185
advantages 185
utility 195
Munich contract 185, 193
recent developments and publications 194
summary 195
Technology Licensing Organizations 185
trilateral agreements, reasons for 184–5
technology transfer 240, 242
China 398
European Union 139
intellectual property rights 159
“know-how”, definition of 159–60
India 400, 419
overriding mandatory provisions 334, 335
see also technology licensing between academic institutions/private companies
termination of licenses
bankruptcy 146–7, 289–91, 296–8, 303
contractual 303
copyright
Germany 40–41
for cause 351
India 417–19
right of sell-off 418
patent
proposal 153
Switzerland 347–51
long-term agreement 349–51
notice 351
trade secret 176–7
Index 495

United States see under US Copyright Law
terms of use
factual information/databases 100–101
Internet 26–7
tort
factual information/database licensing
accuracy 121
defamation 122
Japan 427, 432–3, 443–4
patent licensing 127–8
trade secrets protection 166
trademarks
coeexistence agreements 366–7
commercial purpose/meaning 198–9
exhaustion principle see exhaustion principle
goodwill 199
imposing formalities/freedom of contract in Europe 32
initial IP owner usually marketing protected goods 33
licensing see trademark licensing
source theory of trademarks 198, 199–200
quality control function 200–202
source identification function 201
symbolic intermediation of marks 199
trademark law’s focus on dynamic/symbolic value of marks in commerce 197
trademark merchandising/
“promotional” licensing 221–2
see also individual countries
Trade Marks Directive, European see European Trade Marks Directive
trade secrets and know-how licensing
155–82, 185, 327
arbitration protecting confidentiality in disputes 361–2
basis for protecting trade secrets 162–70
actions for breach of contract/confidence 157, 161, 166–70
breach of confidence 169
employees 162
equitable duty of good faith 167
incentive notion 163
principles 167–70
property notion 163–5
quality of confidence 168
“relationship of confidence” 166, 168–9
TRIPS Agreement 157
unfair competition 165–6
definition of a trade secret 157–60
aspects, specific 175–81
common features from definitions 160
definition of information 169–70, 177–8
essential nature of a “license” 170–71
EU Technology Transfer Regulation definition of “know-how” 159
key structure and components of licenses 172–3
nature of trade secrets and licensee breach 155–6
terminology 161–2
United Kingdom 157–8
United States 158–9
licensing of trade secrets 170–81
general aspects of technology licensing 171–3
non-disclosure/confidential disclosure agreements 173–5
pre-licensing considerations 173–5
pure trade secret or know-how licenses 175, 177–9
confidentiality obligations 178–9
defining confidential information 177–8
employees’ confidentiality agreements 179
grant clauses 178
“need to know” provisions 178
restrictions on use of information 179
specific aspects of trade secret licensing 175–81
certainty clubs 176
features of agreement generating problems 175–6
pure trade secret or know-how licenses 175, 177–9
right to use information on termination of license 176–7
technical assistance/know-how licenses (“show-how”) 175, 179–81
technical assistance/know-how licenses (“show-how”) 175, 179–81
confidentiality provisions 181
risks 181
turnkey solutions 179
trademark licensing 196–223
evolution of trademark licensing 197–200
challenge of modern commerce 199–200
trademark use at the dawn of the industrial age 198–9
French approach 218–19
future direction of trademark licensing narrative 219–22
challenge to validity of quality control 220
merchandising/”promotional” licensing 221–2
three-tier typology for current trademark licensing 219–20
whether trademark license likely to cause consumer deception 221
German approach 216–18
nature of a trademark license 212
other third party uses 212–16
certification mark 214
contract manufacture 213–14
distribution 213
endorsement 215–16
sponsorship 214–15
quality control (UK) 200–208
implementation 202–4
macro and micro behaviour 206–7
quality control requirement 204, 205–8
Scandecor approach/effects 208, 220
Scandecor revolution 205
trademark licensing (U.S) 209–11
see also individual countries
transfer see assignment
Transparency of Japanese Law Project 332
Treaty on the Functioning of the European Union (TFEU) restriction of competition 139, 194, 335
restrictions on import 50
restrictions on freedom of service 50
TRIPS Agreement
undisclosed information 157, 166
national treatment principle 314
turnkey solutions 179

UNCITRAL
Legislative Guide on Insolvency Law 289
Legislative Guide on Secured Transactions 260
Sales Convention see Convention on Contracts for the International Sale of Goods
Unfair Contract Terms Directive, EU 56–7
Article 3 56–7
UNIDROIT Convention on International Interests in Mobile Equipment 260
Model Law on Equipment Leasing 260, 262
Principles of International Commercial Contracts 260, 319, 348–9
Uniform Law on the International Sale of Goods (ULIS) 72
UNITAID 233
United Kingdom (UK) copyright 44
remuneration for use of copyrighted works 41
Index 497

Hargreaves Report 51–3
Hooper Report 52–3
“Copyright works” (UK Intellectual Property Office) 52–3
moral rights 36
patents 132
assignment see assignment
“best endeavors”, interpretation of 145
challenge of the validity of licensed IP 139–40
good faith considerations 143–4
implied terms in agreement 143
implied warranties of title 145
interpretation 144
obligation to provide/license improvements to patents 140
obligation to sue infringers 138
Patents Act (1977) 130
right to sue infringers 138
sub-licensing 137
termination for licensee’s insolvency 147
standing 468–9
Statute of Anne 3
trade secret definition 157–8, 169–70
trade secrets/confidential information as property 163–5
trade secrets
actions for breach of contract/confidence 157, 161, 166–70
breach of confidence 169
confidentiality clubs 176
employees and trade secrets, confidential information and know-how 162
equitable duty of good faith, jurisdiction based on 167
judge-made law 157
“know-how” licences, court’s consideration of 176
“necessary quality of confidence” 168
principles protecting trade secrets/confidential information 167–70
“relationship of confidence” 166, 168–9
statutory protection 158
termination and use of information 176–7
trademarks/trade mark licensing
embedding quality control within trademark registration framework 203
licence requirements 469
quality control requirement see under trademark licensing
recordal scheme for trademark licenses, dismantling of 205
registered user regime 203–4, 208, 210
registration for trademark licenses for transparency purposes 205
Trade Marks Act (1938) 203
Trade Marks Act (1994) 205, 469
United Nations
Commission on International Trade Law see UNCITRAL
Political Declaration on HIV/AIDS 230
Sales Convention see Convention on Contracts for the International Sale of Goods
United States
American Law Institute (ALI) see American Law Institute (ALI)
arbitration of IP disputes 376
automated disablement see under software contracts principles
bankruptcy
Bankruptcy Code 147, 308
bankruptcy of licensee 299–300
bankruptcy of licensor 293–5, 296
Intellectual Property Bankruptcy Protection Act 293
licensees of bankrupt debtor, protection for 288–9
maximization of the value of the estate as dominant criterion 295–6
“survival clauses” 302–3
territorial aspects and conflict of laws 307–8
treatment of “executory contracts” 284, 289, 293–5
see also bankruptcy
Communications Decency Act 122
copyright law see US copyright law
Criminal Fraud and Abuse Act 116, 118
criminal law and trespass 116
enforcement of licenses see
enforcing open source software licenses
Lanham Act 209
National Institutes of Health 233–4
patents
“best efforts”, interpretation of 144–5
co-owner licensing or assigning interest without consent 137
drafting 144
good faith 143
licensee challenging validity of licensed IP 140
standing to sue 139
termination for licensee’s bankruptcy 146–7
Restatement (Second) of Torts 121, 158
Restatement (Third) Unfair Competition 159
trade secret definition 158–9
Uniform Trade Secrets Act 159
trademarks/trademark licensing 209–11
conduct of the parties determining presence of quality control 203, 210
consumer deception 221
quality control requirements 210–11, 220–21
Uniform Commercial Code 65, 70
Uniform Computer Information Transaction Act (UCITA) 64–7, 118
electronic self-help 65

United States Golf In Association v. Arroyo Software Corp. (US) 110–11
universities see technology licensing between academic institutions/private companies
US copyright contracts 5–21, 27
alienability, statutory restrictions on 10–21, 27
adequacy of notice to grantees 13–15
derivative work prepared under authority of grant before termination 19
derivative works/continued use exception 15–19
inalienability/any agreement to the contrary 19–21
standard of creativity for derivative works 17
termination of transfers/statutory termination rights 12–13
Visual Artists’ Rights Act/moral rights waiver 11–12
authorship status 5, 27
commissioned works/“works for hire” 5
employers for whom creator created the work 5
scope of grant 6–10
case law 9–10
contributions to collective works 8
narrow interpretation 6–7
new communication technologies’ effect on pre-existing contracts 8, 9–10
revision privilege 8
specific statutory presumptions 7–8
transfers of rights see assignment
US copyright law
authors’ transfer and license contracts 3–28
automated licensing 21–8
CC licenses see open source licenses
public “sharing” licenses 21–6

Jacques de Werra - 9781781005989
Downloaded from Elgar Online at 02/16/2019 04:38:46AM
via free access
Index 499

standard forms and public sharing licenses 26–7
control of access see under factual information and databases
Copyright Act (1976) 3–4
collective works 8
copyright programs limitation 93
databases 101, 102
“first sale” doctrine 86–7
preemption 106–7
termination of transfer 12–13, 14, 20
transfer see under assignment
databases see factual information and databases licensing
Digital Millennium Copyright Protection Act 112–15
access control and protection of copyright rights 113–15
circumvention of copyright protection systems 112–13
protection of copyright management information 112
trafficking in technology devices to enable circumvention 113
enforcement of software licenses see enforcement of open source software licenses
US Constitution, copyright in 3, 5
US Federal law constraints see US copyright contracts
U.S. v. Wise (US) 87
user-generated content sites see under Internet

Vernor v. Autodesk (US) 86–9

“viral” licenses see under open source licenses
waiver
China 389
moral rights see under moral rights
India 413
United States see under US copyright contracts
warranties
databases/factual information and implied warranties/obligations 120–22
international patent licensing 145–6
registration of interests 149
model intellectual property commercial law 265–6
software contracts see under software contracts principles
Waseda University Global-COE Project 332
Witten group of copyright academics see European copyright code
Woods v. Bourne (US) 16, 17
World Health Organization 228, 230, 240, 242
World Intellectual Property Organization (WIPO) 48, 112, 441
WIPO Performances and Phonograms Treaty 112
WIPO Rules for Arbitration and Mediation 338, 366
World Trade Organization
China accession 381
Doha Declaration 227
TRIPS Agreement see TRIPS Agreement