

# Some Key Issues in Software Licensing

Anchorage  
Bellevue  
Los Angeles

New York  
Portland  
San Francisco

Seattle  
Shanghai  
Washington, D.C.

# Introduction

- About me
- “Five Minute University”
  - <http://www.youtube.com/watch?v=kO8x8eoU3L4>
- Plan of attack
- The end

# What is a License?

- **A permission**
- **Not just intellectual property**
- **A contract, subject to all  
“normal” contracting rules**

# Contract Formation

- Offer, acceptance, consideration
- Mortenson v. Timberline
- Mechanism of acceptance

# Applicable Law

- State choice of law – substantive!
- Applicable federal law
  - Federal IP laws, Mag-Moss (?), other
- UCC, UCITA, UNCISG
- Other?

# Washington-specific Issues

- Not software-specific
- RCW 62A.2-316(4)
- RCW 62A.2-719(3)
- Berg v. Hudesman, 115 Wn.2d 657, 667, 801 P.2d 222 (1990)

# IP-specific Issues

- Assignment – Contract v. “rights & duties”
  - Traicoff v. Digital Media, Inc., 439 F.Supp.2d 872 (S.D.Ind. 2006)
- Assignment – Copyright
  - In re Golden Books, 269 B.R. 300 (Bankr.D.Del. 2001)
- Assignment – Patent
  - In re CFLC, Inc., 89 F.3d 673 (9th Cir.1996)
- Assignment – Trademark
  - Miller v. Glenn Miller Prods, Inc., 454 F.3d 975 (9th Cir. 2006)

# License Grants

- “Install and use”
- “under all licensor’s IP rights”
- Consider being specific ...
  - ... if it helps your client 😊
  - Patent – make, use, sell, offer to sell, import – 35 USC §271
  - Copyright – reproduce in copies, prepare derivative works, distribute copies, publicly perform, publicly display, digitally perform – 17 USC §106



# License Limitations

- Common limitations
  - What some of these mean
- Limitation or covenant (and why do I care)

# Be Practical

- In the technology space (and maybe elsewhere?) clients seem less and less patient with detail
- Understand what is perfect, advise what is perfect (first), but then recognize what you can lose and how it affects risk and be ready to pivot

# Word Tricks

- Auto Numbering
- Auto Cross Referencing
- Resolving / Removing References
- The Spike
- Other

# Questions?

# Thanks!

(and please email me if you would like my Microsoft Word templates and instructions)