

Tech Licensing 2025 Year in Review: Transactional & Litigation Perspectives

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In the Matter of Certain Power Converter Modules (U.S. ITC)

IN THE MATTER OF CERTAIN POWER CONVERTER MODULES & COMPUTING SYS. CONTAINING THE SAME COMM'N OPINION, USITC INV. NO. 337-TA-1370, 2025 WL 857695 (FEB. 26, 2025).

Case Background

- Foxconn asserts license defense against patent infringement.
- Foxconn & Vicor had years-long prior course of dealing.
- Foxconn was on notice of Vicor's terms & conditions.
- Foxconn emailed two POs. Vicor sent emails in response with essential terms and delivery dates.
- The emailed delivery dates \neq Delivery dates in the POs.
- The POs required Vicor to confirm with buyer "within 2 working days upon seller's receipt" or accept the POs by delivery of the goods.



In the Matter of Certain Power Converter Modules (U.S. ITC)

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Case Holdings

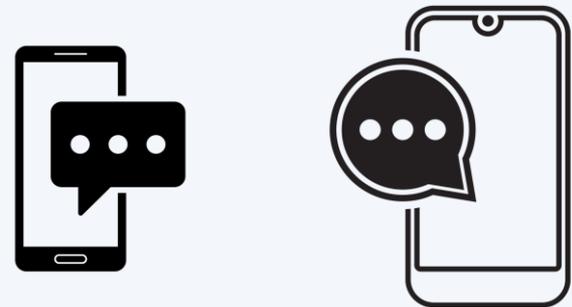
- Binding contract was created via the email exchange.
- The terms & conditions provided to Foxconn before the POs did not govern.
- “Courtesy emails” or “stray”/“interim” emails = valid acceptances.
- Emailed request to “confirm ETA asap” = proper “delivery demand.”
- Provision limiting acceptance method was not clear and definite.
- *Drafting Considerations: Specify in emails that they are not final pending acceptance via another method. Specify in POs the terms and conditions governing acceptance.*

iWTNS, Inc. v. MotionMobs, LLC (Ala.)

IWTNS, INC. V. MOTIONMOBS, LLC, NO. SC-2024-0591, 2025 WL 2424330 (ALA. AUG. 22, 2025).

Case Background

- Breach of contract case. Parties consider settlement over text.
- Text from iWTNS: Offered \$30k per month for 5 months.
- Text from MotionMobs: Would settle for that amount “in exchange for a mutually agreeable release” with “agreeable acceleration and default judgment clauses.”
- Text from iWTNS: “I will get this drafted for us so it will be done next week.”



iWTNS, Inc. v. MotionMobs, LLC (Ala.)

IWTNS, INC. V. MOTIONMOBS, LLC, NO. SC-2024-0591, 2025 WL 2424330 (ALA. AUG. 22, 2025).

Case Holdings

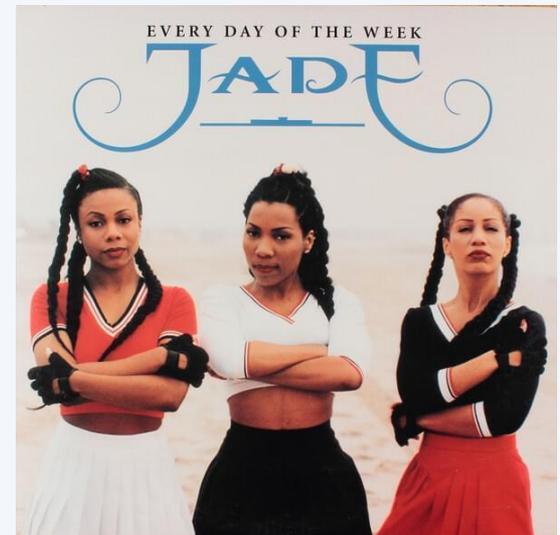
- Texts ≠ Binding settlement agreement.
- Texts indicated intent to draft proposal, not intent to formalize agreement in writing.
- Relied on contract formation principles. Did not decide whether text messages constituted a writing.
- *Drafting Considerations: Texts may constitute “writings.” Be careful agreeing to material terms via text with the intent to formalize later.*

Reed v. Marshall (5th Cir.)

REED V. MARSHALL, 142 F.4TH 338 (5TH CIR. 2025).

Case Background

- Reed, Harris, & Marshall apply for joint ownership of the trademark JADE.
- Marshall, Harris, & Holloway (a licensee of Marshall & Harris) performed under JADE.
- Reed sues Marshall, Harris, & Holloway for trademark infringement and dilution, among other claims.
- District court grants summary judgment on statutory standing. Reed appeals.



***Reed v. Marshall* (5th Cir.)**

REED V. MARSHALL, 142 F.4TH 338 (5TH CIR. 2025).

Case Holdings

- While disfavored, joint trademark ownership results in each owner holding a complete interest in the mark.
- No trademark infringement or dilution cause of action against co-owners of a mark.
- No trademark infringement or dilution cause of action against licensees authorized by other co-owners.
- “Clarion call” for co-owners of a trademark to enter into contractual agreements.
- *Drafting Considerations: Co-owners of trademarks (+ copyrights, patents) should rely on contracts, rather than generally applicable law, to define their rights.*

Curadev Pharma V. Univ. of Tex. Southwestern Med. Ctr. (Tex. App.)

CURADEV PHARMA PVT. LTD. V. UNIV. OF TEX. SOUTHWESTERN MED. CTR., 721 S.W.3D 90 (TEX. APP. 2025).

Case Background

- Curadev licensed technology/trade secrets to Takeda.
- Takeda entered sponsored research agreement with Southwestern (public university).
- Curadev terminated relationship with Takeda.
- Southwestern researchers published their research.
- Curadev sued Southwestern & researchers for misappropriation of trade secrets, conversion, and unconstitutional taking.
- Sovereign immunity asserted.



Curadev Pharma V. Univ. of Tex. Southwestern Med. Ctr. (Tex. App.)

CURADEV PHARMA PVT. LTD. V. UNIV. OF TEX. SOUTHWESTERN MED. CTR., 721 S.W.3D 90 (TEX. APP. 2025).

Case Holdings

- Affirmed dismissal based on sovereign immunity.
- UTSA doesn't provide "clear and unambiguous" waiver.
- Misappropriation and conversion claims not waived by the Texas Tort Claims Act.
- No takings claim: State acquired property through contractual capacity from Takeda.
- *Drafting Considerations: Consider establishing direct contractual privity with public universities or ensuring the licensee is directly responsible and liable for the sublicensee's acts and omissions.*

Case Study: Intellectual Property Frameworks for Federal Research Grants



Federal IP Framework – DOE Grant Example

- DNP.org sought grant to expand framework of energy substation communication protocol (IEEE 1815 standard)
- Department of Energy (DOE) grant to provide funding; third-party software companies to implement working software modules using DNP IP (1815 IEEE)
- *Problem:* Bayh-Dole statutory license: 35 U.S.C. § 202(c)(4) (government “shall have a nonexclusive, nontransferable, irrevocable, paid-up license to practice or have practiced for or on behalf of the United States any subject invention throughout the world”).
- *Problem:* (1) DOE by default retains title to inventions produced by grant funding; (2) third-parties wish to later sell grant-funded software

Case Study: Federal Grant IP Framework (cont.)



Solutions to IP Challenges

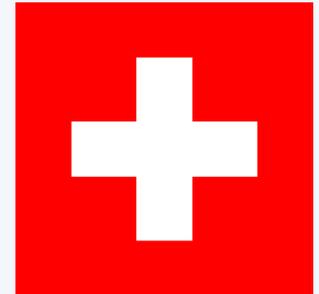
- DNP IP license protecting pre-existing IP; flow down to 3rd parties
- DNP to utilize right to retain new IP under 37 C.F.R. §401.14(a), provided elections are timely made
- Control over “improvements”: License mandates that any derivative works or inventions produced during grant are either assigned to DNP or provided as a perpetual, exclusive license back to DNP.
- Summary deliverables provided to DOE (rather than source code) (if approved by DOE, this is a key point)
- *Third Party Software Sales: DNP license allows participating 3rd parties to retain rights to “software implementations” under the grant; these are not “Derivative Works” of DNP.*

Molecular Dynamics v. Spectrum Dynamics ML (2d Cir.)

MOLECULAR DYNAMICS, LTD. V. SPECTRUM DYNAMICS MEDICAL LIMITED, 143 F.4TH 70 (2D CIR. 2025).

Case Background

- Biosensors, SDBM, & Chauncey formed joint venture (Molecular Dynamics) via Agreements.
- Agreements included arbitration clause designating Switzerland as arbitral seat. Agreements were to be construed under NY Law.
- Joint venture failed. Foreign arbitration in Switzerland resulted in award to Spectrum.
- Molecular Dynamics sought vacatur of the foreign arbitral awards in U.S. Federal Court.



Molecular Dynamics v. Spectrum Dynamics ML (2d Cir.)

MOLECULAR DYNAMICS, LTD. V. SPECTRUM DYNAMICS MEDICAL LIMITED, 143 F.4TH 70 (2D CIR. 2025).

Case Holdings

- Federal courts, as secondary jurisdictions, lack subject matter jurisdiction (SMJ) over vacatur of foreign arbitral awards.
- “Did not decide” whether parties could “designate by contract one country as the arbitral seat and another as the venue for vacatur proceedings” under the NY Convention.
- *Drafting Considerations: When drafting arbitration clauses, consider the seat of arbitration carefully. Continue to monitor whether parties can designate a separate venue for vacatur.*

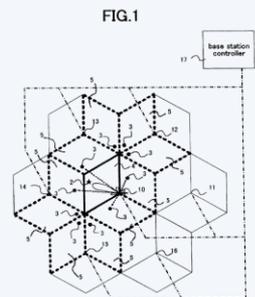
Daingean Techs. v. T-Mobile USA (E.D. Tex.)

DAINGEAN TECHS. LTD V. T-MOBILE USA, INC., NO. 2:23-CV-00347-JRG-RSP (E.D. TEX. MAY 13, 2025).

Case Background

- Mitsubishi and Nokia entered a License Agreement (NMLA), where Mitsubishi licensed “Essential Patents” to Nokia and gave Nokia an option to license one of 7 “non-Essential Patents.”
- Meanwhile, Mitsubishi assigned a non-Essential Patent (“the Patent”) to Daingean.
- Daingean sued T-Mobile for infringing the Patent.
- To cover T-Mobile’s use of the Patent, Nokia attempted to exercise option under NMLA during the Daingean litigation.

(10) **Patent No.:** **US 8,576,803 B2**
(45) **Date of Patent:** **Nov. 5, 2013**



A Closer Look at *Daingean*

- “Licensed Patent’ shall mean any Patent
 - (a) which is owned or controlled by the Grantor at any time during the term of this Agreement and in respect of which and to the extent to which the Grantor has the right to grant the rights hereunder, or
 - (b) which is not owned or controlled by the Grantor at any time during the term of this Agreement but with respect to which and to the extent to which the Grantor has the right to grant exclusive licenses and rights within the scope as herein purported to be granted,
and which is an Essential Patent or is one of a maximum of seven (7) non-Essential Patents selected by the Grantee at any time during the term of this Agreement”

A Closer Look at *Daingean*

- 8.01: “No Grantor shall assign any of its Licensed Patents, unless such assignment is made subject to the maintenance of the licenses and rights as herein granted thereunder. Subject to the provisions of Articles 8.05 and 8.06 regarding internal transfer or assignment within Nokia Corporation, no Grantee shall assign any of its rights or privileges hereunder without the prior written consent of the Grantor. Any attempted assignment in derogation of the foregoing shall be void.”
- 4.06: “In furtherance to Article 8.01, all parties agree that, in the event, after the signature of this Agreement, one party transfers or assigns to a third party any patent which is covered by the scope of this Agreement, such transfer or assignment shall be made subject to the maintenance of the licenses and rights herein granted to the other party(ies).”
- All of the rights, privileges, title and interest in and to the Patents being transferred assigned and set over to Daingean hereunder *include without limitation all . . . right to license, sublicense and assign*”

Daingean Techs. v. T-Mobile USA (E.D. Tex.)

DAINGEAN TECHS. LTD V. T-MOBILE USA, INC., NO. 2:23-CV-00347-JRG-RSP (E.D. TEX. MAY 13, 2025).

Case Holdings

- Option extinguished with assignment based on terms of the contract.
- NMLA “Licensed Patent” = Only patents that Mitsubishi could license without third-party consent.
- Assignment without limits to Daingean disqualified the Patent as NMLA “Licensed Patent.”
- Assignment to Daingean not void. Anti-assignment clauses interpreted “very narrowly.”
- *Drafting Considerations: Take care in drafting the scope of patents subject to requirements. Options can be transferred with patent assignment, but language should be express.*

Rasmussen Instruments v. DePuy (Fed. Cir.)

RASMUSSEN INSTRUMENTS, LLC V. DEPUY SYNTHES PRODUCTS, INC., 2025 WL 2828185 (FED. CIR. 2025).

Case Background

- Rasmussen: Owned patents.
- Wright + Rasmussen formed business relationship.
- 2006 Agreement: Rasmussen assigned patents to Wright.
- 2013: Wright + Rasmussen “unwind” business relationship. Execute two 2013 Agreements to do so.
- 2013 Agreements did not explicitly/formally reassign patents back to Rasmussen.
- 2020: Rasmussen “assigned” patents to Rasmussen Instruments LLC (“the LLC”).
- The LLC filed patent infringement suit against DePuy.
- DePuy challenged the LLC’s standing / patent ownership.



Rasmussen Instruments v. DePuy (Fed. Cir.)

RASMUSSEN INSTRUMENTS, LLC V. DEPUY SYNTHES PRODUCTS, INC., 2025 WL 2828185 (FED. CIR. 2025).

Case Holdings

- The 2013 Agreements’ “*nunc pro tunc* modification” of the 2006 Agreement did not revoke the 2006 assignment.
- “Merely claiming to retroactively amend the contract effectuating the assignment” was ineffective. Formal re-assignment of the patent was needed.
- LLC lacked standing.
- *Drafting Considerations*: Must use formal, explicit language to revoke prior patent assignments.

***Thomson v. Hodgson* (9th Cir.)**

THOMSON V. HODGSON, 150 F.4TH 1097 (9TH CIR. 2025).

Case Background

- 1977 - Members of Supertramp entered Agreement allocating songwriting and publishing royalties (copyrighted compositions).
- No express end date, did not expressly continue in perpetuity.
- Later agreements confirmed “continuing obligation” under the 1977 Agreement. Royalties would remain the same “in perpetuity.”
- 2018 – Sub-publishing company & two former members of Supertramp (defendants) stopped paying royalties to other former members (plaintiffs).
- Plaintiffs sued. Defendants argued Agreement terminable at will after a reasonable time.



Thomson v. Hodgson (9th Cir.)

THOMSON V. HODGSON, 150 F.4TH 1097 (9TH CIR. 2025).

Case Holdings

- CA court's 3-step analysis to determine the duration: 1) Express?, 2) Implied?, 3) If not, terminable at will after a reasonable time.
- Consider nature of contract, totality of circumstances, and post-effective date conduct.
- Eventual cessation of royalties from copyrights is an ascertainable event that “necessarily” implies termination.
- Cessation of royalties = implied end date.
- *Drafting Considerations: Expressly state duration, even if perpetual. Consider specifying a duration for post-termination obligations.*

Lavery v. Pursuant Health (6th Cir.)

LAVERY V. PURSUANT HEALTH, INC., 126 F.4TH 1170 (6TH CIR. 2025).

Brulotte/Kimble: Royalty obligation unenforceable if calculated based on the use of inventions claimed in the licensed patents after expiration.

Case Background

- New company Pursuant Health enters agreements with patent owner Lavery for contribution of “Intellectual Property” attendant to patent.
- License provides for royalties for “Intellectual Property” – 1% for screening kiosks, 3% if use a retinal camera.
- PH stops paying royalty when Lavery patent expires.
- Lavery sues for DJ that 1% royalty not time limited.



Lavery v. Pursuant Health (6th Cir.)

LAVERY V. PURSUANT HEALTH, INC., 126 F.4TH 1170 (6TH CIR. 2025).

Case Holdings

- *Brulotte/Kimble* apply. Post-expiration royalties unenforceable.
- No specific identification of non-patent contributions.
- No step-down in royalties post-expiration.
- Royalty base turned on number of kiosks sold.
- “Deferred compensation” theory doesn’t work when it isn’t in contract.
- *Drafting Considerations*: Identify the specific basis for continuing royalties. “And trade secrets” not good enough in this case. Later or subject understanding not good enough in this case.

Novartis v. Incyte (S.D.N.Y.)

NOVARTIS PHARMA AG V. INCYTE CORP., 777 F. SUPP. 3D 340 (S.D.N.Y. APR. 6, 2025).

Case Background

- Novartis and Incyte enter commercialization agreement.
- Royalty has 3 possible endpoints: 1) expiration of patent rights, 2) ten years after first sale, or 3) end of regulatory exclusivity.
- Incyte owns patents covering Jakafi. Novartis did not.
- Incyte's Jakafi patents expire in 2028. Incyte terminated royalty payments to Novartis in 2021 (ten years after first sale).
- Novartis sues; Incyte asserts that Novartis's contract interpretation is barred by *Brulotte*.



Novartis v. Incyte (S.D.N.Y.)

NOVARTIS PHARMA AG V. INCYTE CORP., 777 F. SUPP. 3D 340 (S.D.N.Y. APR. 6, 2025).

Case Holdings

- *Brulotte* does not apply.
- Court focuses heavily on whether agreement was negotiated under the “leverage” of patent protection.
- Even perpetual royalty agreement allowed if federal patent law “played no part” in the negotiations.
- *Drafting Considerations*: Include clarity on term triggers, including the relevant patents.

**MORRISON
FOERSTER**

Thank You!



Appendix

A Closer Look at *Molecular Dynamics*

- **Primary Jurisdiction:** the country in which, or under the arbitration law of which, an award was made.
- **Secondary Jurisdiction:** all other signatory states to the NY Convention.
- **Foreign Arbitral Awards:** arbitral awards made in the territory of a State other than the State where the recognition and enforcement of such awards are sought.
- **Nondomestic arbitral awards:** arbitral awards that, despite having been made in the US, have some significant foreign nexus or reasonable relation with one or more foreign states.

- **Goal of the NY Convention:** encourage the *recognition and enforcement* of international arbitration awards.
- **FAA bestows no federal jurisdiction.** The FAA “works in tandem” with the NY Convention.

- **Actions to recognize and enforce foreign or nondomestic arbitral awards.**
- **Actions to vacate nondomestic arbitral awards.**
- **Necessary ancillary proceedings that ensure the proper functioning of the underlying arbitration (e.g. summons, attach property, preliminary injunctions).**
- **Note - After a foreign arbitral award has been ‘invoked’ against a party, the losing party may urge a secondary jurisdiction to refuse recognition and enforcement. Limited, reactive role for losing party.**

A Closer Look at *Molecular Dynamics*

Continued . . .

Discrete Carve Out:

- Losing party may initiate vacatur proceedings for foreign arbitral awards in the *primary* jurisdiction.

Potential Loophole:

- Expressly “did not decide” whether “parties to an international arbitration may, consistent with the New York Convention, designate by contract one country as the arbitral seat and another as the venue for vacatur proceedings.”

Genentech v. Biogen MA (N.D. Cal.)

GENENTECH, INC. V. BIOGEN MA, INC., NO. 23-CV-00909-YGR, 2025 U.S. DIST. LEXIS 265402 (N.D. CAL. SEP. 30, 2025).

Case Background

- Genentech licenses the Cabilly Patent to Biogen: Cabilly covers method of manufacturing antibody.
- Royalty owed on “all Net Sales of Licensed Product” in U.S.
- Biogen does not pay tail royalties on product manufactured before the expiration of patent but sold after the expiration of Cabilly Patent.
- Parties dispute when royalty obligations attached.



Genentech v. Biogen MA (N.D. Cal.)

GENENTECH, INC. V. BIOGEN MA, INC., NO. 23-CV-00909-YGR, 2025 U.S. DIST. LEXIS 265402 (N.D. CAL. SEP. 30, 2025).

Case Holdings

- Agreement reasonably susceptible to both parties' interpretations.
- Negotiation history supports Genentech view: **omission** of language on “fully paid up license” upon expiration; inclusion of sell-off period for termination.
- Course of conduct supports Genentech view: Biogen internal docs project payment of royalties well past patent expiration, and discuss inventory turnover.
- Biogen paid (maybe) tail royalties under other agreements.
- *Brulotte* issue?
- Drafting Considerations: Contemplate sell-off of post-patent inventory; align internal accounting and forecasting with IP strategy.

Key Takeaways for 2025

- Co-owners? Licensees authorized by co-owners? Public universities?

Courts unwilling to infer context not spelled out in contracts.

- Anti-assignment clauses are read narrowly.
- *Brulotte* can be planned around, but generic language may not work.

- Whether an option runs with an assignment.
- Re-assignment, not general revocation, of patents.
- Extent of tail royalties.
- Duration.

A Closer Look at Genentech

Pro Genentech Terms:

- Earned Royalties: Biogen paid two different royalty rates depending on the location of the sale. There was no temporal qualification on the timing of the sale.
 - Royalties on “all Net Sales of all Licensed Product sold in the United States,” and
 - Royalties on “all Net Sales of all Licensed Product” sold outside of United States, so long as the Licensed Product “manufactured in a country where such manufacture would, but for the license granted herein, infringe” the patent.”
- Licensed Product: “[A]ny antibody that binds specifically to Alpha4, [i.e. Tysabri], the making (or have made), using, selling, offering for sale **or** importing of which, but for the license . . . would infringe” the Cabilly Patent.
- Net Sales: “[G]ross invoice or contract price to Third Party for Finished Product.”
 - Again, no temporal component limiting it to only sales occurring before expiration.
- Term and Termination: “Licensee’s obligation to pay royalties to Genentech under this Agreement shall commence . . . (i) on the date of First Commercial Sale of Licensed Product, and (ii) shall continue . . . until expiration of the last patent within the Licensed Patents containing a Valid Claim that would be infringed by the manufacture, use, sale, offer for sale or importation of Licensed Product.”
 - References the First Commercial Sale of Licensed Product does not reference a corresponding “last commercial sale” in defining the end of Biogen’s royalty obligation.
- Effect of Termination: “[U]pon termination[,] the licenses granted . . . shall continue for a period of ninety (90) days for the disposition of any existing inventory of Licensed Product and Licensee shall pay royalties in accordance with Section 3.03 on all such Licensed Product sold during such period.”
 - Plain language covered termination “in whole or in part for any reason” and didn’t specify “early” termination.

A Closer Look at *Rasmussen*

2006 Agreement:

- 1.3 Inventions. “Inventions” shall mean improvements, modifications, enhancements, and later variations made solely by [Dr. Rasmussen] or jointly with others, including employees or agents of Wright which are related to the Product/Royalty Product/Licensed Product and which may be embodied in or related to the Product/Royalty Product/Licensed Product or later modifications thereof, whether patentable or not.
- *1.4 Know-How. “Know-How” shall mean all information, data, materials, and other information concerning or relating to the Product/Royalty Product/Licensed Product, including, but not limited to, all technology, including implants, instruments, surgical techniques, formulas, designs, data, processes, prototypes, or specifications developed prior to or during the term of this Agreement by [Dr. Rasmussen] and relating to the Product/Royalty Product/Licensed Product.
- 3.1 Disclosure of Know-How. [Dr. Rasmussen] agrees to make available to Wright all Know-How related to the Product and Licensed Product and to cooperate with Wright in the further development of the Product, Royalty Product and Licensed Product. Furthermore, [Dr. Rasmussen] agrees that [Dr. Rasmussen] shall promptly disclose to Wright all future Know-How and Inventions received or developed by [Dr. Rasmussen] relating to the Product, Royalty Product and Licensed Product.
- 3.2 Ownership. The Parties acknowledge that Wright shall be the sole owner of the Product, Royalty Product and Licensed Product, including those particular ideas contributed by [Dr. Rasmussen] which are utilized in the Product, Royalty Product and Licensed Product, and that Wright shall have the obligation and right within its sole business judgment to seek any patent or other proprietary rights protection for the Product, Royalty Product and Licensed Product as it may deem necessary or desirable. [Dr. Rasmussen] hereby assigns to Wright all of [Dr. Rasmussen’s] right, title, and interest in the Know-How and Inventions, all documentation relating thereto and all patent, trademark, trade secret, copyright, and other intellectual property rights relating thereto....
- Exhibit D of the 2006 Agreement lists the “ADVANCE® Intra-Operative Knee Tensioner” as the sole “Licensed Product.”
- Dr. Rasmussen testified that the “ADVANCE® Intra-Operative Knee Tensioner” is the Zen Instrument. J.A. 13558–59.

2013 Settlement and Licensing Agreements:

- The Settlement Agreement removed recitations in the 2006 Agreement of the “Licensed Product” from all the sections reproduced above.
- The Settlement Agreement “deleted in its entirety” Exhibit D from the 2006 Agreement and replaced it with the term “**RESERVED**.”
- While the 2006 Agreement as amended by the 2013 Settlement Agreement retained language that assigned intellectual property rights related to the Product and Royalty Product from Dr. Rasmussen to Wright, there was no language in any of the agreements stating that Wright was conveying any intellectual property rights to Dr. Rasmussen.
- The License Agreement does not include any language concerning patent assignment.

A Closer Look at *Daingean*

- “‘Licensed Patent’ shall mean any Patent
 - (a) which is owned or controlled by the Grantor at any time during the term of this Agreement and in respect of which and to the extent to which the Grantor has the right to grant the rights hereunder, or
 - (b) which is not owned or controlled by the Grantor at any time during the term of this Agreement but with respect to which and to the extent to which the Grantor has the right to grant exclusive licenses and rights within the scope as herein purported to be granted, and which is an Essential Patent or is one of a maximum of seven (7) non-Essential Patents selected by the Grantee at any time during the term of this Agreement”

- 8.01: “No Grantor shall assign any of its Licensed Patents, unless such assignment is made subject to the maintenance of the licenses and rights as herein granted thereunder. Subject to the provisions of Articles 8.05 and 8.06 regarding internal transfer or assignment within Nokia Corporation, no Grantee shall assign any of its rights or privileges hereunder without the prior written consent of the Grantor. Any attempted assignment in derogation of the foregoing shall be void.”

- 4.06: “In furtherance to Article 8.01, all parties agree that, in the event, after the signature of this Agreement, one party transfers or assigns to a third party any patent which is covered by the scope of this Agreement, such transfer or assignment shall be made subject to the maintenance of the licenses and rights herein granted to the other party(ies).”

- All of the rights, privileges, title and interest in and to the Patents being transferred assigned and set over to Daingean hereunder *include without limitation all . . . right to license, sublicense and assign*”

A Closer Look at *Brulotte/Kimble* & Duration Terms

- Attempts to extend monopoly past the limited term of exclusivity “runs counter to the policy and purposes of the patent laws.”
- Court asks whether a licensing agreement provides royalties for post-expiration use of a patent. “If not, no problem; if so, no dice.”
- Deferred payments for pre-expiration use of a patent into the post-expiration period.
- Can embrace “business arrangements other than royalties,” such as sales with respect to trade secrets or other non-patent property. *E.g.*, step-down royalties.
- Royalties can run until the latest-running patent covered in the parties’ agreement expires.