



MASTER OF LAWS

Course Code: LAW 639

Course Title: Commercialisation of Intellectual Property Rights

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PRE-REQUISITE/CO-REQUISITE/MUTUALLY EXCLUSIVE COURSE(S)

It will be assumed that students have no prior knowledge of intellectual property law.

COURSE SPECIALISATION

N.A.

GRADING BASIS

Graded

COURSE UNIT

1 CU

FIRST OFFERING TERM

Academic Year: AY2016/2017

Academic Term: Term I

COURSE DESCRIPTION

This course provides an introduction to the legal and practical issues that arise when attempting to commercialise intellectual property rights (IPRs) such as patents, copyrights and trade marks. Starting with a high-level explanation of the different rights and how international aspects affect them, the various methods of exploiting the rights are then examined, particularly licensing, using sample agreements. The IT industry is looked at as a case study of how IP rights affect methods of commercialising software and IP issues arising on the Internet will also be considered. The course then explains the process and issues involved in conducting due diligence on IP/IT issues in corporate transactions, using practical agreements and questionnaires. Finally, the impact of antitrust laws on IP commercialisation is considered and the role an effective IP enforcement strategy should play in the commercialisation of the rights. Practical examples are used throughout the course.

LEARNING OBJECTIVES

By the end of this course, participants will have a good understanding of the issues that may arise in cross-border transactions involving IP rights and will be familiar with the types and structure of agreements they will encounter.

RECOMMENDED TEXT AND READINGS

There are no textbooks on this subject and readings for the individual topics will be posted on the course website or provided in soft and hard copy format.

For a basic understanding of intellectual property rights in Asia and an introduction to the commercialisation issues we will be examining, students should read Llewelyn, *Invisible Gold in Asia: Creating Wealth through Intellectual Property* (Marshall Cavendish Singapore, 2010), particularly Part One and chapters 15&16.

ASSESSMENT METHOD

Class participation: 20%

Team project and presentation: 40% (20% joint written paper, 20% presentation)

Take-home Exam: 40%

As this is a course on a topic that is very practical, class participation is important and students will be expected to contribute actively (and meaningfully). Students will be expected to keep up with business developments involving IP commercialisation through reading the business media such as the BT and the FT or Wall Street Journal Asia, as examples occur daily and we shall be discussing them as they arise.

Many of the issues arising in connection with the international commercialisation of IPRs are common-sense and a deep knowledge of a particular law is not required (indeed, in many MNCs the commercialisation is done by people without formal legal training but who have a lot of commercial experience).

Important: Academic Integrity

All acts of academic dishonesty (including, but not limited to, plagiarism, cheating, fabrication, facilitation of acts of academic dishonesty by others, unauthorized possession of exam questions, or tampering with the academic work of other students) are serious offences.

All work (whether oral or written) submitted for purposes of assessment must be the student's own work. Penalties for violation of the policy range from zero marks for the component assessment to expulsion, depending on the nature of the offence.

When in doubt, students should consult the instructors of the course. Details on the SMU Code of Academic Integrity may be accessed at <http://www.smuscd.org/resources.html>

GENERAL ORDER OF TOPICS

1. Introduction to the rights
2. Ownership questions, international aspects, general look at dealings.
3. Dealings with trade marks
4. Dealings with patents
5. Dealings with know-how (or trade secrets)
6. Dealings with copyright and designs
7. IT/IS industry and IP issues
8. IP due diligence in corporate transactions
9. Internet and IPRs
10. Antitrust and IPRs
11. Enforcement

You should note that the above is the “general” order of topics: all of those areas will be dealt with but not necessarily in that strict order, depending on class discussions and where they take us.

Two other warnings:

1. As this is not a course on the law of any one country but considers the issues at a relatively high level, so as to prepare you for involvement in cross-border commercialisation of IPRs that could involve more or less any country, there will be very little reference to case-law and particular statutory provisions. I will use bullet-point Powerpoint™ presentations which will be uploaded after the seminars for you to annotate with your notes if you wish.
2. Whilst the subject-matter of the commercialisation that we will be discussing is IPRs, there are quite a number of different legal subjects that we will need to consider for their impact on commercialisation: the most important being contract law, but also aspects of tort law (or the law of delict, depending on the country), property law, company and partnership laws, insolvency law, conflict of laws, litigation. That's what makes it so interesting!!

COURSE SCHEDULE

Session	Topics
1.	Introduction to IP law and the business of IP: how we have got to where we are. International trade and IP. Patents, Trade Marks, Copyright, Designs, Plant Varieties, Confidential Information. International aspects. Ownership; employees/independent contractors. Dealings generally – assignments, different types of licences (sole and exclusive, oral and written, express and implied).
2.	[Continuation of Session 1]

	Dealings in Trade Marks: difference between registered and unregistered rights. Registered users. Quality control. Trusts. Franchising. Merchandising. Right to sue.
3.	Dealings in Patents: licences and assignments. Agreements to assign. Oral and written licences/assignments. Defining rights. Compulsory licensing. International aspects – TRIPS & Doha Declaration. Right to sue. Registration of assignments/licences. Assignee/licensee estoppel. Patent pooling. Standard setting, Patent ambushes and FRAND. Employees' statutory compensation rights. Dealings in Plant varieties.
4.	Dealings in Know How and trade secrets: nature of the rights, express and implied creation of rights, relative secrecy, licences and assignments. Oral and written licences/assignments. Defining rights. Right to sue. Employees' rights. Restrictions on employees during the post employment. Unreasonable restraint of trade. Whistleblowing.
5.	Dealings in Copyrights: licensing, franchising, merchandising, photos, architects, films. Dealings in Registered and unregistered designs.
6.	IT/IS. Structure of the industry and contractual relations. Software licensing, shrink wrap, dealing with software. Outsourcing and IP.
7.	IP due diligence in corporate transactions, IP issues in corporate transactions, incl. share purchase versus business purchase. NDAs; checking ownership of IPRs; registered versus unregistered rights; international aspects. Reviewing licence agreements, both in- and out-, and other commercial agreements with IP provisions; checking consequences of corporate transaction on validity. Drafting the disclosure letter and negotiating the warranties and indemnities. The financing aspects: recording assignments and taking security, international aspects.
8.	The Internet and IP dealings: including domain name disputes, website design/hosting.
9.	Antitrust and IP dealings: UK, EU and US, EU free movement issues.
10.	Protecting value: Enforcing rights, litigation (interlocutory, full trial, Anton Piller and Mareva), damages and accounts of profits, arbitration (choice of law, choice of forum, enforcement of awards, arbitrable disputes), mediation, ICANN. Settlement agreements.
	Project presentations will be held at the beginning of sessions 5-10, depending on the number of students (projects will be assigned to pairs of students.)