

BEYOND SAAS: LICENSING STRATEGIES FOR TODAY'S TECHNOLOGY

Devika Kornbacher
Edward A. Cavazos



1

WHAT WE PLAN TO DISCUSS

- **Recent Technology Licensing Developments**
 - Licensing Case Law Update
 - The Next “X” in XaaS?
 - “App-Store” Requirements
 - Antitrust Guidelines for the Licensing of Intellectual Property
- **Data Monetization Practice Points**
- **XaaS Licensing Tips**

2

RECENT DEVELOPMENTS

LICENSING CASE LAW UPDATE

• Licensing Case Law Updates

- ***Great Minds v. Office Depot, Inc.***
 - 9th Circuit Weighs In On Scope of Creative Commons License Terms
- ***Mission Product Holdings v. Tempnology, LLC***
 - SCOTUS Clarifies Trademark Licensee's Rights After Rejection in Bankruptcy
- ***Universal Instruments Corp. v. Micro Systems Engineering, Inc.***
 - 2nd Circuit Explains When Copyright Act Precludes Assertion of Breach of Contract Claims

For information only. Not legal advice.

3

3

GREAT MINDS V. OFFICE DEPOT, INC.

Facts:

Great Minds is the copyright owner for certain educational materials licensed to the public under Creative Commons Attribution License (non-commercial use).

School districts requested that Office Depot copy the materials at its copy shops. Great Minds sued FedEx for copyright infringement arguing that Office Depot was a commercial business and could not avail itself of the non-commercial use permission of the CC license.

FOR PUBLICATION	
UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT	
GREAT MINDS, a non-profit organization, Plaintiff-Appellant,	No. 18-55331
v.	D.C. No. 2:17-cv-07435-JFW-E
OFFICE DEPOT, INC., a Delaware corporation, Defendant-Appellee.	OPINION
Appeal from the United States District Court for the Central District of California John F. Walter, District Judge, Presiding	
Argued and Submitted November 8, 2019 Pasadena, California	
Filed December 27, 2019	
Before: Jerome Farris and M. Margaret McKeown, Circuit Judges, and Virginia M. Kendall,* District Judge.	
Opinion by Judge Farris	

*The Honorable Virginia M. Kendall, United States District Judge for the Northern District of Illinois, sitting by designation.

For information only. Not legal advice.

4

4

Background:

Creative Commons Attribution —Non-Commercial—Share Alike 4.0
International Public License

(<https://creativecommons.org/licenses/by-nc-sa/4.0/legalcode>)

“worldwide, royalty-free, non-sublicensable, non-exclusive, irrevocable
license to...reproduce and Share the [Materials], in whole or in part, for Non-
Commercial purposes only”

Great Minds v. Office Depot, Inc., Case. No. 18-55331 (9th Cir. Dec. 27, 2019) Holding:

“Under the License, a non-commercial licensee may hire a third-party contractor, including those working for commercial gain, to help implement the License at the direction of the licensee and in furtherance of the licensee’s own licensed rights. The License extends to all employees of the schools and school districts and shelters Office Depot’s commercial copying of Eureka Math on their behalf. Holding differently would prevent proper non-commercial licensees from using relatively common means of reproduction to share, engage with, and exercise their rights to the licensed work in a way that would contravene the intent of the License and undermine its utility. We conclude that the licensees’ contract with Office Depot to exercise the licensees’ rights under the License does not impose an independent liability on Office Depot. As a result, Great Minds has failed to state a plausible claim to relief on its copyright infringement claim.”

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](https://utcle.org/elibrary)

Title search: Beyond SaaS: Licensing Strategies for Today's Technology

Also available as part of the eCourse

[2020 Technology Law eConference](#)

First appeared as part of the conference materials for the
33rd Annual Technology Law Conference session
"Beyond SaaS: Licensing Strategies for Today's Tech"