

UT LAW CLE

33<sup>RD</sup> ANNUAL TECHNOLOGY  
LAW CONFERENCE

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## BEYOND SAAS: LICENSING STRATEGIES FOR TODAY'S TECHNOLOGY

Devika Korbacher  
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.*

- 9<sup>th</sup> 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.*

- 2<sup>nd</sup> Circuit Explains When Copyright Act Precludes Assertion of Breach of Contract Claims

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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, <i>Plaintiff-Appellant,</i>	No. 18-55331
v.	D.C. No. 2:17-cv-07435-JFW-E
OFFICE DEPOT, INC., a Delaware corporation, <i>Defendant-Appellee.</i>	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.

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4

4

## Background:

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## **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.”

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

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