Fundamentals of Intellectual Property

Final Examination

Professor Field Fall 2006

HEED INSTRUCTIONS

Do not waste time answering more questions than you need to!

This is a three-hour, open-book exam. You may consult any written materials. Do not discuss the exam with others.

- **Put your exam number and answers on the sheet provided.**
- **Note that questions in Part I are worth four times as much as those in Part II.**

Part I: Multiple choice
[80 points — 20 questions total]

Enter the *letter* for the most correct concluding phrase or statement in the numbered space **on the answer sheet**. In Part I, *only the first 5 answers* will count in each section.

A. Patents [Section references to 35 U.S.C.]

*Answer **only** 5 of 7.*

1. If CyberBad.com applies for a business-method-software patent:
   A. U.S. protection would last 14 years (§ 173).
   B. U.S. protection is less likely than European protection.
   C. it will be refused if CyberBad already has copyright protection.
   D. U.S. protection would probably last at least 17 years (§ 154(b)(1)(B)).

2. Jones (J), a graduate assistant, made key contributions to an invention. Iffy Odds University, as employer-assignee, owns the patent later issued. J was not listed as an inventor, but she:
   A. has no rights because, inventorship aside, IOU owns the patent.
   B. can probably get all royalties that have been paid to IOU.
   C. should prevail in an action to correct inventorship.
   D. has no rights if the named inventor was her boss.

3. Because she didn't trust her boss, J (Q2) did not provide all of the information needed to make the invention work. In those circumstances:
   A. IOU's patent is invalid.
   B. she could quit her job and file for her own patent.
   C. she should offer to disclose the information to enhance her bargaining position.
   D. if she discloses the information to IOU, she could get a second patent in her name.

4. Two years before the application (Q2) was filed, IOU Professor Klewlus (K) published an article describing a similar invention. In those circumstances:
   A. K should tell IOU, and it should immediately file another application.
   B. K should get a share of royalties on the existing patent.
   C. the existing patent could be invalid under § 103.
   D. the existing patent is invalid under § 102(b).

5. Mojo (M) sells reusable swabs that, when dabbed in ordinary wood alcohol, remove warts. The unpatented swabs have no other use. M holds only a process patent. In such circumstances:

A. anyone can sell the swabs if they wish.
B. anyone who buys wood alcohol other than from M is an infringer.
C. M has no right to stop people from using unpatented products as they wish.
D. M can require people who buy its swabs also to buy its alcohol for wart removal.

6. M (Q5) has discovered that a novel blend of wood, grain and rubbing alcohols works unexpectedly better than wood alcohol alone. A second patent based on this discovery:

A. would be of little use; people have legal rights to mix common products.
B. could claim no more than use of the swabs with the novel blend.
C. could not claim the novel blend; it is obvious.
D. could probably claim the novel blend.

7. If a new chemical surprisingly enhances the aroma of many perfumes, a valid patent could:

A. probably claim only the way to make the chemical.
B. claim the chemical, both alone and mixed with existing perfumes.
C. not issue because improving perfumes is "frivolous and insignificant".
D. protect the chemical but probably not its "frivolous and insignificant" use.

B. Copyright [Section references to 17 U.S.C.]

*Answer **only** 5 of 7.*

1. Software copyright gives owners the right to prevent:

A. reverse engineering needed to write competing software based on underlying ideas.
B. copying of commands helpful but not required in competing software.
C. its being rewritten in different computer languages.
D. all of the above.

2. BeGreen (B), a U.S. firm, designed a new truck. After it made 3-D models, B hired Freelancer (F) to prepare engineering drawings. The sole document was a check.

A. Despite copyrights, B can legally copy F's drawings.
B. F will have copyrights as soon he registers his drawings.
C. Because he lacked written permission, F infringed copyright in B's models.
D. Copyrights would justify F's providing extra copies of his drawings to Honda.

3. If B (Q 2) had emailed F soliciting the work that it wished him to do:

A. B would hold copyright in the drawings as works-for-hire.
B. B would hold copyright in the drawings by assignment.
C. it could also have cut off F's termination interest.
D. that would not alter the rights of the parties.

4. Before B's new trucks (Q2) were sold, a transfer of ownership in the drawings was registered under § 205. Hal (H), a GM employee, later made substantially similar drawings. GM could:

A. be liable for indirect infringement.
B. be liable to F if H had access to his drawings.
C. infringe no copyrights if H saw only the new trucks.
D. infringe no copyrights unless H's drawings were identical.

5. Angus (A) put ten images on his website after Sam (S) said that he could. Ed, who never heard of S, can prove that he created and promptly registered the images. If Ed sues, A is unlikely:

A. to infringe copyrights if he altered the images' colors.
B. to be liable for maximum statutory damages.
C. to be liable for minimum statutory damages.
D. to be liable for attorney fees.

6. Professor Pander has had several hundred happy students since she began scanning assigned casebooks and putting them on the web. She is sure that this is OK because no author has yet objected; indeed, one of them likes the idea. In these circumstances, she could:

A. not be liable; if students can use the website for free, her use is fair.
B. not be criminally liable despite an erroneous belief that her use is fair.
C. be subject to generic federal criminal liability, e.g., for theft or wire fraud.
D. be subject to generic state criminal liability, e.g., for holding stolen property.

7. Morton (M), a musician, hired Sandoval (S), a professional, to take photographs of his band. If M wants to get more (cheaper) copies made at Wal-Mart, he can do so:

A. legally because the photographs were made for hire.
B. legally if S has no certificate of registration.
C. legally because M & S are joint authors.
D. No statement above is correct.

C. Trademarks [references to Lanham Act]

Answer only *5 of 7*.

1. Figby (F) sells parrot-shaped suckers as "Polly-Pops". After F's design patent expired, Toffee (T) began to sell exact copies as "Parrot-Pops". If parrots are often called "Polly" and F holds no registrations, F's best grounds for relief is that its suckers':

A. shape is inherently distinctive.
B. name has "secondary meaning".
C. shape has "secondary meaning".
D. popularity with children and pirates establishes unfair competition.

2. Of these possibilities, T's (Q1) best defense is that:

A. purchasers are interested in the suckers' shape, not their source.
B. children and pirates are unsophisticated shoppers.
C. F should have copyrighted its suckers.
D. parrots are often called "Polly".

3. Of these possibilities, T's (Q1) best defense would be (if factually accurate) that F:

A. holds no state or federal registration.
B. was denied federal registration for its suckers' name.
C. was refused federal registration for its suckers' shape.
D. F makes candy in New Hampshire but T makes it in Connecticut.

4. Of these possibilities, T (Q1) would probably be best off if F:

A. asserts only a state unfair competition claim.
B. sells its suckers at much higher prices.
C. sells its suckers at much lower prices.
D. files suit based on only § 43(a).

5. Gal has long sold expensive flip-flops and sandals for teenage girls at several small stores in the southeast. Its bright awnings feature an image of a "big toe" with a red toenail. Federal registration of Gal's logo was issued in 1996.

Tow registered its name in 2000; at that time, it made inexpensive men's shoes for sale by national retailers. Recently, Tow ran ads for a "BIG Tow" sale intended to launch a new line of women's sandals. If Gal asks for advice, you will point out that:

A. suit is hopeless if no consumer has so far been confused.
B. Gal might be able to establish likely confusion under § 32.
C. Gal might be able to establish likely confusion under § 43(a).
D. under § 33(b), Gal is out of luck if Tow's mark is incontestable.

6. If Tow (Q5) later files an intent-to-use application for a large-purple-toe (LPT) logo, Gal:

A. need not worry; examiners will reject the logo for lack of use in commerce.
B. would be well advised to start using the LPT logo before Tow does.
C. might successfully oppose based on § 2(e)(1).
D. might successfully oppose based on § 2(d).

7. Gal (Q5) has discovered Bodi, a southwestern shop with a very similar logo — the sole difference is that the toenail is pink, not red. Bodi has offered pedicures, piercing and tattoos since January 1, 2002. If Gal sues because it also offers pedicures at some of its stores:

A. such use is essentially irrelevant to its rights.
B. Bodi might lose under § 32 if the court follows the *Roots* case.
C. Gal might win under § 43(a) unless Bodi offered pedicures earlier.
D. Gal would win under § 43(c) if it begins offering pedicures at all locations.

D. Miscellaneous

Answer only *5 of 7*.

1. Morris (M) found a roll of paper in the Concord planning office dumpster. It contains detailed plans for a new Pierce Law (P) library. Based on that, M bought a small, key piece of land. After P's plan was approved, M sold the land to P for ten times what he paid. P later learned the facts and sued. If the new Restatement governs, M would most likely be liable under:

A. § 40(b)(1).
B. § 40(b)(2).
C. § 40(b)(3).
D. § 40(b)(4).

2. M's best defense (Q1) would be that, when he found the plans:

A. the exact location of the proposed library was generally known.
B. P had already shown the plans to city officials.
C. the plans had only potential value.
D. the roll of papers was in the trash.

3. Leaving no stone unturned (Q1), M's lawyer also plans to argue that P's suit is preempted by copyright and patent laws. If so, a court is apt to be receptive to:

A. copyright but not patent preemption.
B. patent but not copyright preemption.
C. both patent and copyright preemption.
D. neither patent nor copyright preemption.

4. Laura (L) invented a new wrench. On June 1, 2006, she sent detailed drawings to several companies, but only X-act (X) was interested. On Dec. 1, 2006, L assigned all of her rights. In return, X promised to file an application no later than June 1, 2007 and to pay (based on net sales) 4% while the application is pending, 6% during the term of any patent that issues and 2% otherwise. X then began to manufacture the wrench and to pay a 2% royalty. Based on cases we discussed:

A. regardless of patent-related events, L is entitled to nothing after Dec. 1, 2026.
B. if a patent issues and is invalidated, L will thereafter be entitled to nothing.
C. L will be entitled to at least 2% as long as X sells the wrenches.
D. if a patent issues, X will owe nothing after 2027.

5. L (Q4) also sent drawings to Skaters (S). S did not respond but began to make the wrenches. X and L learned of this on Dec. 15, 2006. They then filed a patent application and a lawsuit. X also wrote a letter to S's wholesale customers — relating key events and offering to supply cheaper wrenches. When S's sales began to dip, it filed counterclaims.

A. Its sending the letters might make X liable to S for diverted sales.
B. Until S can be stopped or forced to pay royalties, X need not pay either.
C. S must pay L for sales made before Dec. 1 and pay X for sales made thereafter.
D. If X implies that S's wrenches infringe its IP, it might be liable for diverted sales.

6. When S's (Q5) sales began to drop, it also ran ads that said: "Barney may be famous, but he never used a Skaters wrench!" If owners of rights in the purple dinosaur sue:

A. 15 U.S.C. § 1125(a)(1)(B) would provide the best cause of action.
B. 15 U.S.C. § 1125(a)(1)(A) would provide a good cause of action.
C. they would be hard pressed to support a right of publicity claim.
D. truth would provide a good defense to any cause of action.

7. Later, S (Q6) also ran ads that said "Dick Cheney may have poor aim, but he never shot anyone with a Skaters wrench!" If the vice president files suit, S would probably:

A. lose on a right of publicity claim.
B. lose any case based on 15 U.S.C. § 1125.
C. lose because people may not poke fun at top U.S. officials.
D. win because parodies are protected by the First Amendment.

Part II: Matching
[20 points]
*Answer **only** 20 of 24*

Each numbered item is intended to match only one lettered item. Please enter the **best** letter in the corresponding space **on the answer sheet**.

1. A state
2. Repair
3. Copying
4. Licenses
5. Dilution
6. Abramson
7. Right to use
8. Patent clause
9. Ninth Circuit
10. Cybersquatting
11. *DuPont* factors
12. Federal Circuit
13. Justice Douglas
14. Designer gowns
15. Judge Kozinski
16. Providing notice
17. Commerce clause
18. Strength of mark
19. First sale doctrine
20. Statutory damages
21. Scope of protection
22. D.C. District Court
23. Rules for playing games
24. Disclosure of best mode

A. Patentees' obligation.
B. Conferred by no form of IP.
C. Explicitly unpatentable in Europe.
D. Quotes the Statute of Monopolies.
E. Illegal activity involving domain names.
F. Not copyrightable in the United States.
G. Generally constitute promises not to sue.
H. Regards opinions of the CCPA as precedential.
I. Criticized parties who "did lunch, not contracts."
J. Invalidated a patent for claiming an "aggregation".
K. Often adversely affected by many unrelated users.
L. Does not permit rental of some copyrighted works.
M. Provides federal authority for trademark legislation.
N. For purposes of copyright law, Puerto Rico qualifies.
O. Unavailable for patent and trade secret infringement.
P. Activity that may increase recovery in copyright cases.
Q. Activity permitted after patentees' rights are exhausted.
R. Negotiated with the PTO but not the Copyright Office.
S. Does not provide federal power for trademark legislation.
T. Subject of the most recent amendment to the Lanham Act.
U. Activity giving rise to a good defense in the *Scott Paper* case.
V. Can consider testimonial evidence when reviewing PTO decisions directly.
W. Useful for determining registerability of marks under 15 U.S.C. § 1052(d).
X. Broadly viewed 17 U.S.C. § 106(2) and narrowly viewed 15 U.S.C. § 1052.

Examination No. ____KEY_____

Answer Sheet

Part I — (80%)

*Answer **only** 5 of 7 in each set* (4% each)

A. Patents

1. __D__
2. __C__
3. __A__
4. __C__
5. __D__
6. __D__
7. __B__

B. Copyrights

1. __C__
2. __A__
3. __D__
4. __C__
5. __B__
6. __B__
7. __D__

C. Trademarks

1. __C__
2. __A__
3. __C__
4. __A__
5. __C__
6. __D__
7. __A__

D. Miscellaneous

1. __D__
2. __A__
3. __D__
4. __C__
5. __D__
6. __C__
7. __A__

Part II — (20%)

*Answer **only** 20 of 24* (1% each)

1. __N__
2. __Q__
3. __U__
4. __G__
5. __T__
6. __D__
7. __B__
8. __S__
9. __X__
10. __E__
11. __W__
12. __H__
13. __J__
14. __F__
15. __I__
16. __P__
17. __M__
18. __K__
19. __L__
20. __O__
21. __R__
22. __V__
23. __C__
24. __A__