Exam #_____

Federal Trademark & Copyright Registration Practice
Spring, 2010
Final Examination
May 5, 2010

Instructions:

- This exam counts as **35%** of your grade.
- Use your exam number; do not use your name anywhere.
- This is a closed book exam.
- All questions pertain to the United States federal trademark and/or copyright registration systems.
- **Section 2 of the Lanham Act is attached for your reference.**
- Following is the point distribution:

Question Number	Point Value
1	5
2	40
3	5
4	20
5	5
6	15
7	10
Total:	100

Questions:

1. (a) (3 points) Describe one way you can know for certain that you have succeeded in electronically filing an application, response to office action, or other document with the U.S. Patent and Trademark Office (PTO).

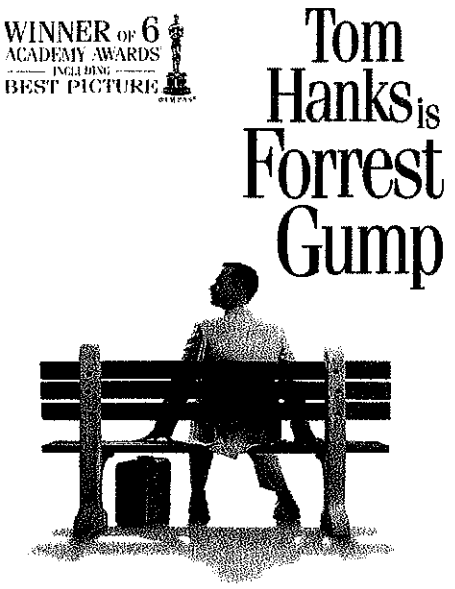
(b) (2 points) What proof of a successful filing is unique to trademark applications?

2. The 1994 motion picture film Forrest Gump, starring Tom Hanks and Sally Field, won the coveted Oscar Award for Best Picture, as well as five other Oscar Awards. Tom Hanks plays a character named Forrest Gump, a man of limited intelligence who inadvertently manages to be present at a number of historic events and also manages to make millions of dollars investing in Apple Computers (and gives most of it away for a local hospital). Among other things, he fought in the Vietnam War, played football, played table tennis competitively internationally, told the police about flashlights at the Watergate Hotel, ran across the country and back three

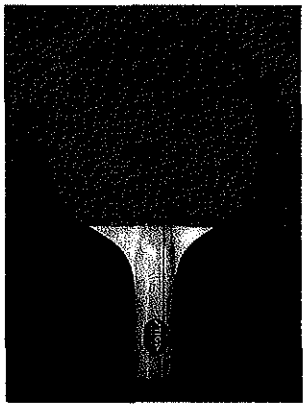
times, and started Bubba Gump Shrimp Company. The movie explores the age-old debate of whether one makes his own destiny or is moved by the forces around him. One of the famous lines from the movie is from when he is sitting on a bench waiting for a bus with a box of chocolates in his lap and tells the woman on the bench sitting next to him, "My momma always said, 'Life was like a box of chocolates. You never know what you're gonna get.'" The movie poster and Madam Tussaud's Wax Museum (in London) both depict Forrest Gump in the setting for this famous line.



Woman posing with wax museum character



This movie asset is presently owned by Paramount Pictures and is one of a select few movies managed by the Paramount Famous Productions Division. Paramount Pictures Corporation owns copyright registration number PA0000726079 for the motion picture (which it still sells in DVD and Blu-Ray from its web site), two federal trademark registrations for BUBBA GUMP SHRIMP CO. RESTAURANT & MARKET (plus design) for restaurant services (January 30, 2001 registration date for mark with SHRIMP SHACK; updated logo registered April 24, 2007) and several other registrations for things sold at the restaurant like ornaments, t-shirts, hats, pencils, playing cards, plush toys, table tennis paddles, magnets, and the like (all under the mark BUBBA GUMP SHRIMP CO. RESTAURANT & MARKET). In 1994, Paramount filed an intent-to-use trademark application for FORREST GUMP for chocolates but abandoned the application after all of the extensions to file a statements of use elapsed without a filing.



← Table Tennis Paddle

On August 21, 2008, an individual named Ray Stahl from Arkansas applied to register the trademark FOREST BUMPS for "medicated skin preparation for use in treating insect bites, poison ivy, poison oak and other plant associated rashes." Mr. Stahl's application is an intent-to-use application.

(a) (5 points) Assume for this question 2(a) that today is December 28, 2008. You loved the movie Forrest Gump and are the PTO examining attorney newly assigned to the FOREST BUMPS application. The connection between the two marks immediately comes to your mind. Assuming there are no obvious problems with the applicant or indefiniteness problems with the identification, do you have any grounds to reject the application? Please explain.

(b) (5 points) Assume for purposes of this question that you come to a point where Mr. Stahl's application is approved for publication (still in intent-to-use basis) and that publication occurs on January 13, 2009. What is the purpose of publication and what could happen after the mark is published?

(c) (10 points) Assume again that Mr. Stahl's application advances to the next phase and that a notice of allowance issues on April 7, 2009. Today is now today (i.e. May 5, 2010), and Mr. Stahl's attorney submitted to the PTO today a filing used to demonstrate that the FOREST BUMPS mark is now used in interstate commerce. What is this document called and what was needed to be filed between April 7, 2009 and now? Also, what should Mr. Stahl's attorney do if the product for poison ivy is complete but not the product for insect bites?

(d) (10 points) The filing to demonstrate use includes the specimen of a label that would be affixed to a bottle of medicated lotion designed to stop itching caused by poison ivy. In addition to the mark FOREST BUMPS, the label depicts a man who is wearing a tan suit sitting on a park bench with a light brown suitcase sitting next to him. He and his park bench are surrounded by a forest. He is bent over, scratching his leg. Below the image is the following: "Life is like a forest of weeds. You never know what you're going to get." If Paramount wishes to challenge Mr. Stahl's product using PTO avenues (you do not need to discuss the likelihood of success on the merits of such claims, only the options from a procedural standpoint), what must Paramount do and by when does it need to do it?

(e) (5 points) Paramount's copyright registration information is below. If Paramount caught someone copying the Forrest Gump motion picture and filed a lawsuit for copyright infringement, would Paramount be entitled to statutory damages? Why? What are statutory damages?

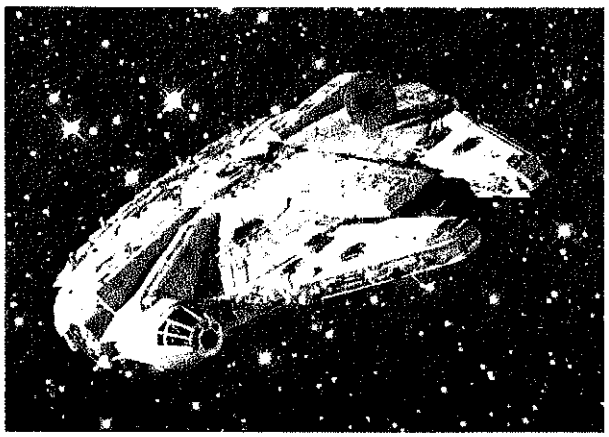
Forrest Gump / a Steve Tisch, Wendy Finerman production ; directed by...

Type of Work: Motion Picture
Registration Number / Date: PA0000726079 / 1994-09-22
Title: Forrest Gump / a Steve Tisch, Wendy Finerman production ; directed by Robert Zemeckis.

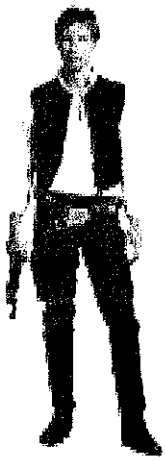
Description: 8 film reels ; 35 mm.
Notes: Based on the novel.
Copyright Claimant: Paramount Pictures Corporation (employer for hire)
Date of Creation: 1994
Date of Publication: 1994-06-21
Previous Registration: Some sound recordings prev. reg.
Basis of Claim: New Matter: remaining material.
Names: Tisch, Steve
Finerman, Wendy
Zemeckis, Robert
Paramount Pictures Corporation

(f) (5 points) What is a "deposit" when referring to a copyright registration? How many were mailed to the Copyright Office with the above-described Forrest Gump registration application and why?

3. (5 points) The movie Star Wars, Episode IV: A New Hope provides insight for this question. Below are some characters from this movie.



The Millennium Falcon, Han Solo's ship



Han Solo



Jabba the Hutt

In the Star Wars movies, Jabba the Hutt, a crime lord, used Han Solo and his fast space ship, the Millennium Falcon, to deliver contraband around the universe. Once, while smuggling a load of contraband items (Kessell spice[1]) in the Millennium Falcon, Han Solo was pursued by Imperial patrols who actually boarded the Millennium Falcon. To avoid being caught and punished as a smuggler, Han jettisoned the cargo into space, thereby losing Jabba's cargo. Jabba demanded

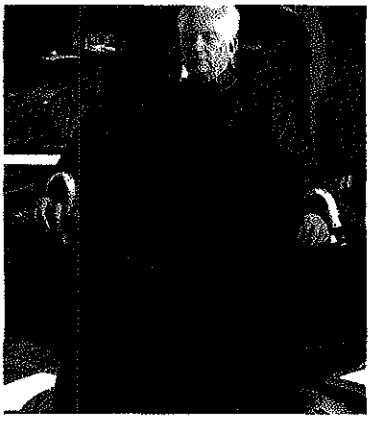
[1] The Kessell spice known as glitterstim (apparently for its photoactive qualities) is described as a "euphoric psychotropic drug beneficial in therapeutic uses" which also imbues the user "with a temporary increase in latent telepathy." Lucas Online, www.starwars.com, keyword "Kessel." It appears to be contraband due to the Empire's desire to monopolize the supply of glitterstim. *See Id.* Kessel is a planet in the Outer Rim of the Empire. *Id.*

payment for the cost of the cargo from Han Solo. Han does not have the money to pay. If Jabba were truly interested in recovering money of an equivalent value to the lost cargo – rather than freezing Han Solo into a carbonite form and using it as a wall decoration in his palace to serve as an example to others – and if it were today and if Han resided in Concord, New Hampshire and if Han owned a patent issued in the United States, a copyright registered with the U.S. Copyright Office, and a trademark registered in the United States and if Han agreed to giving Jabba a security interest in those assets, what should Jabba do to perfect his security interest in those assets in order to recover for the loss of proceeds from a successful smuggling of Kessel spice?

4. Assume, again, that Han Solo lives in Concord, New Hampshire and that it is today. Assume that the federal trademark registration he owns, registered in the year 2007 (the application was an intent-to-use), is for the mark KESSEL KARRIERS (plus design). Assume further that, as a result of a deal worked out between Chancellor Palpatine, supreme ruler of the Galactic Republic, and the members of the Madrid Protocol, which deal was approved by their respective legislative bodies, that the Galactic Republic is now a member of the Madrid Protocol.

(a) (10 points) Han Solo would like to take advantage of the Madrid Protocol filing option, since he does business under the name KESSEL KARRIERS in the Galactic Republic (as well as in the United States). Describe the process this filing will take. Will Han Solo get a priority date for the Madrid Protocol filing?

Chancellor Palpatine



(b) (10 points) If you had to take a guess, in what category of those listed below do you think Han's KESSEL KARRIERS mark fell in in the year 2007 for the examination and why? If you think there is a disclaimer and/or 2(f) claim in whole or in part, please identify it.

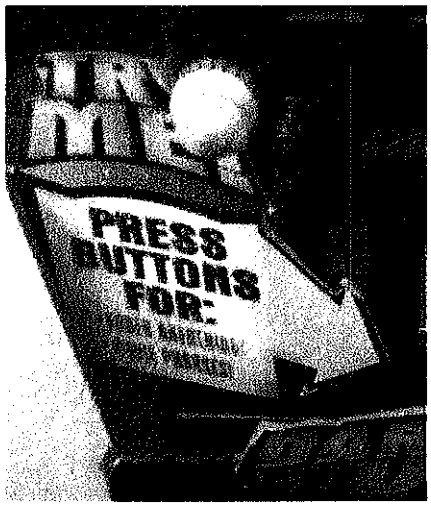
a. Principal Register without disclaimer
b. Principal Register with disclaimer
c. Principal Register with 2(f) claim
d. Supplemental Register
e. Supplemental Register with disclaimer

5. (5 points) Darth Vader is the central antagonist for purposes of the entire Star Wars movie series. As a result of some incredibly serious burns, he wears an outfit designed to allow him to function and which keeps him alive. Included within that outfit is a full-head mask which helps him to breathe. The result is a mechanical human breathing sound, which sounds as though someone is breathing through a scuba tank regulator. A recording of this mechanical breathing sound has been placed in Darth Vader Halloween costumes. Can Paramount protect this sound? How would it be protected?

↓Darth Vader Toy Box →

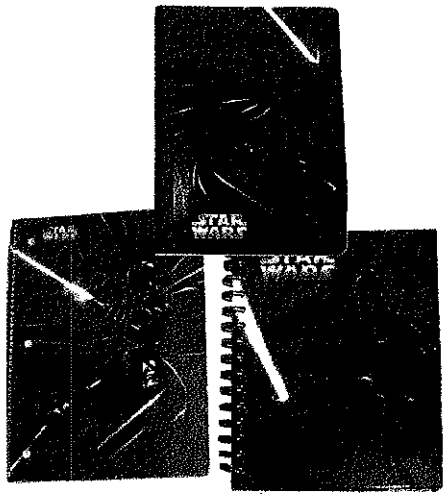




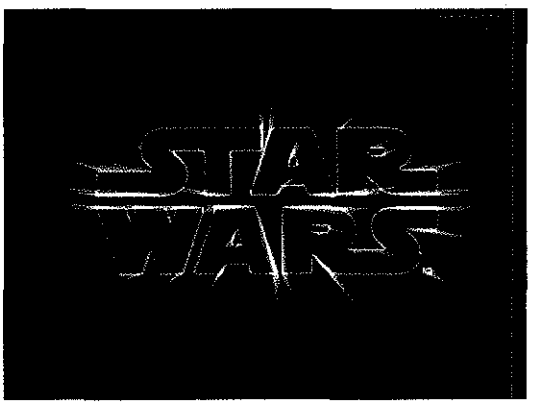


6. (15 points) You represent Lucasfilms (the maker of the Star Wars movies) and obtained a trademark registration for the below mark using the below specimen, which issued on September 23, 2008.

STAR WARS

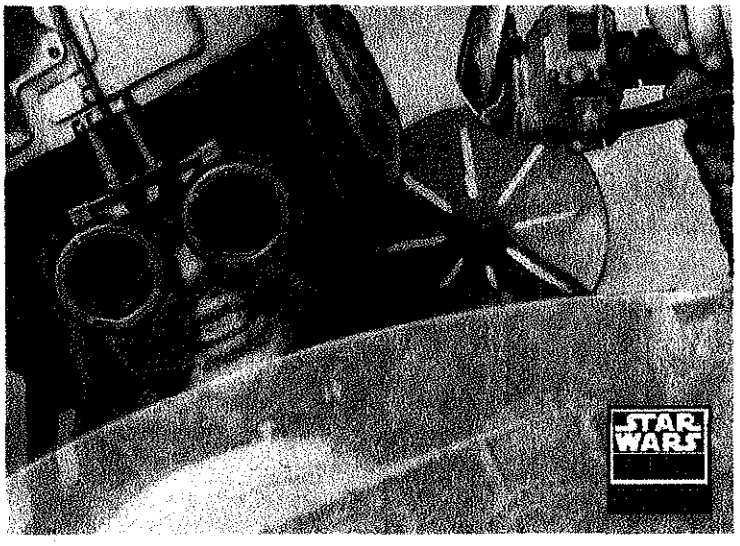


However, Lucasfilms has just informed you, its attorney, that it wants to change everything over to the new logo (below). What will happen with the trademark registration you have? How might your filings change and why? When will those filings need to be made?



7. (10 points) Lucasfilms writes screenplays for three sequels to the existing six Star Wars movies using three of its employees. What type of work is it? Who is/are the author(s)? What is the nature of authorship? What material is excluded? What material is included?

Have a Great Summer and May the Force Be With You!



Lanham Act § 2 Rejection Bases

§ 1052. Trademarks registrable on principal register; concurrent registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of Title 19) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: *Provided*, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before December 8, 1993.

A mark which when used would cause dilution under section 1125(c) of this title may be refused registration only pursuant to a proceeding brought under section 1063 of this title. A registration for a mark which when used would cause dilution under section 1125(c) of this title may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title.