Fundamentals of Intellectual Property

Final Examination

Professor Field Spring 2009

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.
- Questions in Part I are worth four times as much as those in Part II.
- **Do not waste time by answering more questions than you need to!**

Part I: Multiple Choice

[80 points — 20 questions total]

Specific Instructions: Put the letter for the most correct concluding phrase or statement in the numbered spaces on the answer sheet. **Only the first 5 answers in I.A through I.D count.**

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

Answer only 5 of 7.

1. Apex (A) holds a patent on optical transistors. It assigned exclusive rights for use in radios to Beta (B) and for use in TVs to Cox (C). If B sells to Drat (D), a computer manufacturer:
   A. B infringes C's rights.
   B. B infringes both A's and C's rights.
   C. only D is apt to infringe A's rights.
   D. both B and D are apt to infringe A's rights.

2. If Bob invents a way to synthesize X, a naturally occurring substance, a valid patent could cover:
   A. the range of processes taught in the specification.
   B. all non-natural processes for synthesizing X.
   C. nothing because X is not new.
   D. Bob's preferred process.

3. Ralph (R) discovered that the utility of optical fibers with core and cladding is affected by those components' relative dox index. It was then possible to change only the core dox index, so that is what R claimed. If, when it became possible to change the cladding dox index, Zing (Z) did so, Z:
   A. infringed literally.
   B. may infringe under the doctrine of equivalents.
   C. cannot infringe; R forfeited his rights by claiming narrowly.
   D. cannot infringe because R can no longer expand his claims by reissue.

4. Abe's (A) patent, filed in 2007, claims an inventory management scheme that considers anticipated sales, lag time to replenish stock and other variables. If Rocco (R), who has used the same process in secret since 2005, is alleged to infringe, R's best defense is that:
   A. A's patent is invalid because the preferred process uses computers.
   B. R uses much improved techniques for obtaining necessary data.
   C. A's patent is invalid because it claims a business method.
   D. provided by § 273(b).

5. If A's process (Q. 4) does not require use of mass-produced software:
   A. he will have difficulty overcoming challenges to validity.
   B. R can compete in teaching people how to use it.
   C. infringement will be very difficult to detect.
   D. infringement will be impossible to prove.

6. Bogart has a patent claiming wristwatches for dogs. If the key element, a band that keeps the watch in place without interfering with circulation, has been used in diving gear, according to the latest relevant Supreme Court decision, the patent:
   A. is invalid under § 102.
   B. is invalid if use of the band is a matter of common sense.
   C. is invalid under § 103 if diving gear is relevant technology.
   D. is invalid under § 101 if diving gear is relevant technology.

7. Medex (M) sells a device and capsules useful for determining pregnancy. Their patented use is licensed, per statements on the goods, only to purchasers who use M's capsules. If so:
   A. the condition makes the patent unenforceable as a matter of law.
   B. the patent is unenforceable as long as the condition is imposed.
   C. if the condition is unenforceable, the patent has little value.
   D. the condition is probably unacceptable under § 271(d)(1).

B. Copyright [section references to 17 U.S.C.]
Answer only 5 of 7.

1. Bob's software manipulates graphics. If Ed's software does the same thing, it:
   A. will infringe unless it was created independently.
   B. cannot infringe absent essential identity of the code.
   C. cannot infringe absent substantial similarity of the code.
   D. will infringe unless Ed can prove that his was created earlier.

2. Under § 101, uniquely ornate vases enjoy copyright protection:
   A. if aesthetic and utilitarian features are seen as conceptually separable.
   B. as such, if any utility is seen as derived solely from their appearance.
   C. as such, only from the effective date of their registration.
   D. only for original graphics that appear on their surfaces.

3. If Fred is denied registration for his jade pendants:
   A. his copyright is invalid and unenforceable.
   B. under § 411, he can sue the Register of Copyright.
   C. his copyright is enforceable but is not presumed valid.
   D. he cannot have the validity of his copyright determined by a jury.

4. Cal's (C) letter to the editor was published in Newzy (N) with no indication of copyright ownership. A copyright notice appears elsewhere in the same issue. If someone copies the letter:
   A. unless registration occurs within a month, statutory damages are unavailable.
   B. and both C and N register, both can sue.
   C. formalities aside, only C can sue.
   D. formalities aside, only N can sue.

5. Sue photographed a woman standing in a bar, holding a glass of wine. It was featured in many wine ads. If Bob's later photo shows a man in the same bar with a beer, infringement is:

A. impossible.
B. possible, but only if access can be proven.
C. possible if artistic choices are found to be strikingly similar.
D. established as a matter of law if the photos feature the same background.

6. If Joe copies a band's new CD for twenty fraternity brothers, he:

A. is criminally liable only if he was aware that the CDs were copyrighted.
B. cannot be criminally liable unless each copy is worth at least $50.00.
C. is criminally liable only if the CDs were copyrighted.
D. cannot be criminally liable unless he sold them.

7. If Mo uses a substantial part of Ed's poster in a satirical work, under § 107, that is:

A. unlikely to be fair if Mo's work is sold.
B. unlikely to be fair unless Ed's work is the target of the satire.
C. sure to be fair if Mo's use has no effect on sales of Ed's work.
D. sure to be unfair if Mo's use causes sales of Ed's work to drop.

C. Trademarks [statutory references to Lanham Act]

Answer only 5 of 7.

1. If Grog (G) copies the unique shape of unpatented Nog (N) mugs, § 43(a) liability is:

A. unlikely unless G is actually making sales that N would have made.
B. likely if consumers regard G's mugs as coming from N.
C. likely if N's extensive ads make them very popular.
D. unlikely if the source of G's mugs is clear.

2. Zax (Z) registered its name for a pizza chain in 1989. A restaurant of the same name (Z2) has been in Rhode Island since 1940. If Z2 attempts to register, Z might be able to:

A. limit the geographical scope of Z2's registration.
B. halt its use of the mark registered twenty years earlier.
C. prevent registration under § 13 unless 20% of Z2's customers cross state lines.
D. prevent registration under § 13 if less than 20% of Z2's customers cross state lines.

3. Toffs (T) has sold green-wrapped candies in New England since 1990. If it holds none, federal registration of its color would:

A. immediately confer incontestable rights throughout the country.
B. give it no rights over others who now use the same color.
C. give it trivial advantages over its common law rights.
D. not issue in light of § 2(e)(5).

4. One of T's candies (Q 3), called Boffs, is uniquely flavored. When MeTu discovered the key flavor ingredient, it began to sell "boffs." If T sues, a court would be most apt to:

A. enjoin all uses of the name.
B. permit use of the name but not the flavor.
C. enjoin use of the flavor as a source indicator.
D. permit use of the flavor and reference to the name.

5. Toffs (Q.4) later registered MeTuCandies.com for settlement purposes. Such action:
   A. might be actionable under § 43(a)(1)(A).
   B. constitutes flagrant trademark misuse.
   C. might be actionable under § 43(d).
   D. might be actionable under § 43(c).

6. If Myrtle sells mostly Toffs candies online from Toffs-and-more.com, Toffs (Q. 3):
   A. is unlikely to stop her.
   B. could stop her under § 43(c).
   C. could stop her under § 43(d).
   D. could stop her under §§ 32 and 43(a).

7. If Newsco publishes "The Best of Peeple, an Anthology," a spoof of People (P) magazine, P:
   A. should be able to get relief under § 43(c).
   B. should be able to get relief under § 32.
   C. neither A nor B is correct.
   D. both A and B are correct.

D. Miscellaneous
Answer only 5 of 7.

1. Bo is an engineer. By contract, he promised to work for JuteCo (J) and, among other things, to preserve its trade secrets. If Bo instead took a job with Competitor (C), J should be entitled to:
   A. an order compelling Bo to work for J.
   B. an order compelling C to discharge Bo.
   C. an order enjoining C from using J's trade secrets.
   D. damages, if any, caused by Bo's breach of contract.

2. When ModCo (M) prosecuted a suit, the court granted its request that the public not have access to specified confidential documents used in the litigation. When that suit ended, a key document (KD) was accidentally left, unsealed, in a file. When M later sued another party (D2), its attorney discovered KD. D2 would probably be free to use the information in KD:
   A. under § 42 of the Restatement (3d) of Unfair Competition.
   B. under § 1(2)(C) of the current Uniform Trade Secrets Act.
   C. because M's measures to preserve secrecy were inadequate.
   D. if everything in KD appears in an issued patent.

3. Bud (B) learned in early May that his employer (E) intended to introduce a new product (NP) in August and offered to sell release details to a major competitor. When he arrived in mid-May with ads designed for the NP release, B found the FBI waiting. Prosecution under § 1832(a)(4) of the Economic Espionage Act might nevertheless fail:
   A. if B could not be tried before October.
   B. if E had displayed a prototype at an April trade show.
   C. because he was prevented from transferring any secrets.
   D. if B's employer later cancelled its plans to introduce NP.

4. State enacted a statute to halt reverse engineering of software. Publishers may exploit that law by placing a red octagon on their products. Anyone who duplicates software so marked is subject to fines up to $3,000. If Mo is prosecuted, his best defense will be that the statute:

A. is preempted by 17 U.S.C. § 301(a) because software is copyrightable.
B. is preempted under Supreme Court interpretations of patent law.
C. is preempted by Lanham Act § 2(e)(5).
D. No prior choice is correct.

5. Gina (G) submitted her article with a novel thesis to the So-So Law Review. Editor (E) rejected it but, using only cases cited by G, published an original article that advances her thesis. If G sues, she would be most likely to succeed:

A. by establishing that E had an implied duty of confidentiality.
B. because E improperly took a free ride on her original research.
C. by claiming misrepresentation under Lanham Act § 43(a)(1)(A).
D. by registering and bringing an action for copyright infringement.

6. When Toffs filed a protest with Myrtle (Q. C.6), she cancelled her domain name registration and registered Toffssucks.com. She sells some other brands of candy from her home in Utah, but that is barely mentioned at her website, where she mostly complains about Toffs' rudeness. Under those circumstances, Toffs is most apt to:

A. prevail for trade libel and unfair competition under Utah law.
B. prevail under Lanham Act § 43(a)(1)(B) and § 43(c).
C. find itself without an effective remedy.
D. prevail under Lanham Act § 43(d).

7. Julia is an Ohio storyteller. She interweaves recurring themes, melodies and basic plots, but her performances are spontaneous. She clearly conditions attendance on patrons' understanding that photography and other forms of recording are forbidden. Despite her best efforts, Rob recorded a show. If she learns of this and sues in state court:

A. 17 U.S.C. § 1101(d) will preempt her action.
B. Rob's recording will be protected as free speech.
C. she may prevail for unlawful appropriation of her property.
D. Restatement (3d) of Unfair Competition § 46 may be useful.

Part II: Matching
[20 points]

Specific instructions: Answer only 20 of 24.

Match numbered items with their letter-denominated descriptions. Put the best letter matches in any 20 spaces on the answer sheet. **Only the first 20 answers count.**

1. Abramson
2. eBay
3. Tilghman
4. Funk
5. Fregeau
6. Pfaff
7. Mallinckrodt
8. TrafFix
9. Wheaton
10. Oddzon
11. CCNV
12. Lipton
13. Lee
14. Sandoval
15. duPont v. Christopher
16. Chou
17. Aronson
18. NBA
19. Manhattan Industries
20. Morehouse
21. Champion
22. McGregor-Donniger
23. Mikohn
24. Rock and Roll

A. Makes it clear that processes are patentable.
B. Mentions the use of copyrights to bar imports.
C. Clarifies the bases for the patentability time bar.
D. Suggests that corporations have rights of privacy.
E. Stresses that products of nature are unpatentable.
F. Illustrates academic technology transfer schemes.
G. Illustrates the application of a de minimis defense.
H. Finds copying based on mathematical probabilities.
I. Missed an opportunity to apply 17 U.S.C. § 120(a).
J. Lack of actual confusion may have been undervalued.
K. Uses the Restatement (Agency) to resolve a copyright issue.
L. Uses § 106A to decipher the meaning of 17 U.S.C. § 106(2).
M. Illustrates an infrequently used way of challenging PTO refusals.
N. Addresses the factors that determine the availability of injunctions.
O. Holds that first users do not necessarily get exclusive rights to marks.
P. Trade dress protection is unavailable for functional aspects of goods.
Q. Discusses how Art. I §8 cl. 8 derives from the Statute of Monopolies.
R. Stresses the PTO's different roles in patent and trademark proceedings.
S. Illuminates the early history of copyright in England and the United States.
T. Suggests, by way of dicta, that "hot news" actions survive 35 U.S.C. § 301(a).
U. Single-use restrictions on patented goods do not necessarily offend public policy.
V. Federal law regulates communications between patentees and potential infringers.
W. Nothing prevents durationally unlimited obligations to pay for unpatented inventions.
X. Faced a conflict between interests of a trademark owner and consumers of used goods.

Examination No. _____

Answer Sheet

Part I — (80%)

Again, in each set, **only the first 5 answers count** (4% each).

A. Patents

1. _____
2. _____
3. _____
4. _____
5. _____
6. _____
7. _____

C. Trademarks

1. _____
2. _____
3. _____
4. _____
5. _____
6. _____
7. _____

B. Copyrights

1. _____
2. _____
3. _____
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5. _____
6. _____
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D. Miscellaneous

1. _____
2. _____
3. _____
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6. _____
7. _____

Part II — (20%)

Again, **only the first 20 answers count** (1% each).

1. _____
2. _____
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24. _____