EXAM NO._____

INTELLECTUAL PROPERTY MANAGEMENT
FINAL EXAM
SPRING '05

Professor Jorda April, 2005

Instructions:
This is a two-hour (more for certain foreign students) open-book exam. You may consult the course materials as well as any other materials.

Write your answers in the blue books supplied, but please use only one side of the page and observe the margins. Please write or print as legibly as possible.

Grading will be anonymous; please do not put your name on anything you turn in. BE SURE YOUR EXAM NUMBER IS ON EACH BLUE BOOK YOU TURN IN.

PROBLEM I
Pinnacle, Inc., in conjunction with Zenith Corp., claimed to have invented an electropneumatic gun. Pinnacle holds USP 5,600,700 covering such a gun. This patent lists William Jones, Adam Jones, Cabot and Smith as inventors, none of whom have backgrounds in electronics or engineering. The Joneses are associated with Pinnacle, while Cabot and Smith are associated with Zenith. Byron became a shareholder of Zenith in 1990, but never signed any shareholder agreement. Byron, an engineer, agreed to assist Zenith in its efforts to design an electropneumatic gun. Pinnacle admitted that Byron designed at least one circuit board for use in such a gun on or before the effective filing date of the '700 patent. Byron worked from his home and kept a scientific notebook of his ideas and efforts. He was never separately compensated for his work on the design and development efforts. In 1998 he became convinced that he should have been named as an inventor and eventually assigned his rights in the '700 patent to Summit Ltd.

When subsequently, Pinnacle sued Summit for patent infringement, Summit moved for summary judgment on inventorship, claiming that Byron was the sole inventor of the patent or at the very least, a co-inventor and arguing that Byron designed the only patentable features of the '700 patent, namely, the electrical circuit and the placement of the electrical circuit on a circuit board. Summit relied on several pieces of evidence, including Byron's design notebook, to corroborate Byron's testimony that he invented at least some of what was claimed in the patent. Byron's notebook contained months' worth of ideas, experimentation, and research that reflected what Byron put into designing an electrical circuit, timing circuit, circuit board, and how the elements worked together. The notebook was corroborated by others. Aside from a limited notebook produced by Cabot, the named inventors offered no documentation of their contributions to the conception or reduction to practice of the claimed invention.

How should the Court rule on this summary judgment motion? **[15 points]** **-OVER-**

PROBLEM II

ABC, Inc. sued XYZ Corp. for infringement of its patent (USP 6,000,000) on an improvement in ink jet printers, which had issued with 10 named inventors. In trial, XYZ argued that the presence of 10 named inventors was ground for invalidation of the patent because it was "absurd to believe that it took ten people" to invent the claimed improvement, which was merely a very simple plastic container of ink. It contended that the burden was on ABC to substantiate the inventive contribution of each of the named inventors. ABC countered that the patent had 60 figures and 20 embodiments and that the invention was not a simple one. XYZ contended further that misjoinder was established with regard to two of the named inventors because they were not listed on any of the foreign priority documents. Again ABC countered that the only contribution of the two omitted inventors was to dependent Claim 10, the subject matter of which was not described in the priority documents. XYZ had deposed at least nine of the named inventors. In deposition after deposition, the named inventors testified that, although they were incapable of recalling each individual's specific contribution, they all had collaborated together in a series of meetings to produce the patented invention and none of the inventors testified that any named inventor was not involved in that collaborative effort.

What should the court's ruling be on this issue? **[15 points]**

QUESTIONS

1. Must the inventorship designation be identical between corresponding U.S and foreign patent applications? Why or why not? **[5 points]**
2. What five corporate policies or practices would in your opinion be most productive in terms of harvesting inventions? **[5 points]**
3. What is the legal importance of Invention Disclosures in the patent solicitation process? **[5 points]**
4. Why are companies reluctant to accept inventive ideas from outside inventors (unsolicited disclosures) and what are the conditions or requirements under which companies will look at unsolicited disclosures? **[5 points]**
5. For what specific reasons should patents and trade secrets be relied on complementarily for any given invention and why is such reliance legally possible? **[5 points]**
6. What is the interface between a) trademarks and trade names and b) housemarks and trademarks/service marks? **[5 points]**

---END OF EXAMINATION---

KFJ/Ruh/4.28.05