Fundamentals of Intellectual Property

Final Examination

Professor Field Spring 2008

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 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 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. Jocko (J) asked Bowler (B) for a license to practice its currently unused patent for an improved bowling ball. Should B refuse and J uses it anyway, B is:
   A. unlikely to get an injunction if J pays a fee set by the PTO.
   B. unlikely to get an injunction if J pays a statutory fee.
   C. unlikely to get an injunction.
   D. likely to get an injunction.

2. By agreement, Fred (F) and George (G) have a right to make Ralph's (R) patented widgets, but F can sell only in Maine and G only in Ohio. If F sells to Mary, an Ohio resident, he:
   A. may infringe G's rights.
   B. is sure to infringe G's rights.
   C. will infringe R's rights unless he has a license.
   D. will infringe R's rights unless he has an assignment.

3. Taylor (T) did not disclose exact dimensions in his patent application drawings. If T's patent issues and Huff (H) infringes its claims, H will:
   A. not be liable because skilled artisans would know those dimensions.
   B. be liable because skilled artisans need to know those dimensions.
   C. be hard pressed to establish inadequacy of the disclosure.
   D. be able to force T to supply any dimensions he needs.

4. Diehr's (D) utility patent claims a very economical method for asexually reproducing rare plants normally grown from seed. If Kalo (K) is found to infringe, K should argue that:
   A. D's patent is invalid; only plant patents are available for such inventions.
   B. D's patent is invalid because living things are unpatentable.
   C. Both A and B because both are true.
   D. Neither A nor B; both are untrue.

5. If Mary's patent claims use of coffee grounds to counter male pattern baldness:
   A. her right to practice it requires no FDA approval.
   B. her advertising claims are not subject to FTC action.
   C. she will have great difficulty enforcing it under § 271(a).
   D. sellers of ground coffee could easily be liable under § 271(c).

6. Bogart (B) offered to convey all rights in his invention to Kruk Co. (K). Negotiations were unsuccessful, so over a year later, B filed for and obtained a patent. If K infringes:
   A. no injunction will issue if K meets B's last royalty offer.
   B. K will be estopped to deny the validity of B's patent.
   C. a court will find B's patent invalid under § 102(b).
   D. B should prevail under § 271(a).

7. Ed's patent covers a carpenter's tool. It sells well because its standard razor blades replace more expensive blades used by competitors. On those facts, a challenge to validity will:
   A. fail because Ed's tool is a a commercial success.
   B. succeed if competitors would have foreseen the merits of his tool.
   C. succeed if all components of his tool are well known to competitors.
   D. fail because carpenters are unlikely to know much about razor blades.

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

Answer only 5 of 7.

1. BudCo (B) recently replaced its advertising agency (A1) with another (A2). If, because A2's bottle photos are similar to ones it earlier published, A1 sues, A1 is apt to lose:
   A. unless some of A2's photos are "substantially similar."
   B. unless A2 had access to A1's photos.
   C. unless A2 uses some of A1's photos.
   D. because of the merger doctrine.

2. If Bling, after being refused registration, sues Ming for copying its jewelry:
   A. the registration decision will be irrelevant.
   B. a court should dismiss for lack of registration.
   C. the factual basis for denying registration will bind a jury.
   D. the factual basis for denying registration will warrant consideration.

3. If Beth (B) pays Ed (E) and Jo (J) to make separate parts of a statue:
   A. the copyright will belong to B because she paid for the statue.
   B. the statue will belong to B because she paid for it.
   C. B, E, and J will share ownership as joint authors.
   D. E and J will share ownership as joint authors.

4. George (G), who sells cups and the like, found an anonymous collection of old aphorisms such as "A bird in the hand is worth two in the bush." If Alice (A) can prove that she is its author and publisher and that individual lines from her book appear on his merchandise, G:
   A. probably infringes any copyright she may have.
   B. is unlikely to infringe any copyright she may have.
   C. cannot infringe if the book contains no copyright notice.
   D. cannot infringe unless she registered before G began to copy from her book.

5. Studly (S), a formally trained model, invests heavily in his appearance and carefully selects poses. Should Sue, his photographer, be uninterested in suing someone who copies his photos, S:
   A. may do so as owner of an underlying work.
   B. may assert his moral rights under § 106A.
   C. may do so under an implied license.
   D. may do so as joint author.

6. Joe (J) copies parts of several West (W) casebooks for sale to students at cost. If W sues:
   A. J should lose under § 107(4).
   B. J should win because § 107 favors classroom use.
   C. W will lose because court decisions are not copyrightable.
   D. W should win based on its exclusive rights under § 106(1-3).

7. If Bo's (B) satirical video contains two fleeting glimpses of Wu's (W) vase, B's use:
   A. is likely to be seen as fair because his work is satirical.
   B. infringes unless he has W's permission.
   C. infringes if his video is commercial.
   D. is likely to be seen as de minimis.

C. Trademarks [statutory references to Lanham Act]

Answer only 5 of 7.

1. Al's $50 stools that bear his logo have thus far been sold only to neighbors. If a PTO examiner refuses registration for lack of interstate commerce:
   A. Al must stop using the logo.
   B. Al should wait until his logo is published for opposition.
   C. the examiner's legally unsound rejection is best addressed on appeal.
   D. the examiner's legally unsound rejection is best overcome outside the PTO.

2. Bling's (B) packaging has been a novel shade of green for the past six years. Thus, recent adoption of that color by a competitor:
   A. cannot be halted; source identity comprising only a single color is unprotectable.
   B. could be halted under § 43(a) upon proof of secondary meaning.
   C. could be halted only if B obtains registration under § 2(f).
   D. could have been halted as soon as B began to use it.

3. Siegel's (S) Diamond™ jewelry often features zircon or lead crystal, but never diamonds. If all components of his merchandise are accurately labeled:
   A. his mark is best described as arbitrary.
   B. S's unclean hands will bar relief under § 34(a).
   C. his mark will be unregisterable under § 2(e)(1).
   D. competitors can halt S's use of the mark under § 43(a)(1)(B).

4. Since 1978, PedCo (P) has sold Fut™ shoes, but only in Vermont. In 2006, BroCo (B) began selling Fut™ shoes in the West. If, after spanning five states, B seeks PTO registration:
   A. that will show bad faith if it knows of P's first use.
   B. P's use will surely give rise to a rejection under § 2(d).
   C. B should get all of the U.S., subject to others' common law rights.
   D. P can intervene and, as first user, get all unoccupied U.S. territory.

5. Medco's (M) syringes are sold for "single use only." If, after cleaning and replacing needles, for example, syringes may be legally recycled by Fog (F), a court is likely to find that:

A. the goods are useless absent the identity of the original manufacturer.
B. F may retain M's logo if packaging states that its goods are recycled.
C. it would be a misleading to reference M as original manufacturer.
D. used goods may be unconditionally resold under original names.

6. Lalah (L) saw the logo used by Al (Q 1) and found it attractive. She then integrated it into a decorative pattern that appears on some of her $1000 purses and bags. If Al sues under § 43(c)(5), a court is most likely to:

A. dismiss the action.
B. enjoin use of the logo under § 34.
C. order L to disgorge profits under § 35(a).
D. order destruction of L's goods under § 36.

7. From its Xonex.com website, ZoCo sells Xonex umbrellas. If Exxon sued, it would be most consistent with precedent to:

A. penalize use of the anagram as a domain name under § 43(d).
B. enjoin both uses of the anagram under § 43(a)(1)(A).
C. enjoin both uses of the anagram under § 43(c).
D. refuse relief.

D. Miscellaneous

Answer only 5 of 7.

1. Pu's (P) "How to Walk on Water" seminars falsely claim to teach that potentially useful skill. To recover his otherwise lost investment, Nu (N), a former pupil, recently began to sponsor seminars under the same name. If N also distributes copies of some of P's original literature, the Ninth Circuit is most apt to halt infringement of:

A. P's copyrights and mark.
B. P's copyrights but not his mark.
C. P's mark but not his copyrights.
D. neither P's copyrights nor his mark.

2. As sole listed inventor, Professor Low (L) receives a share of royalties paid to a Florida university, the obligatory assignee based on school policy. In fact, the sole inventor is Av (A), L's graduate assistant. If A brings suit to establish that fact:

A. her suit will be dismissed because the school owns the patent either way.
B. she will accomplish nothing except to invalidate the patent under § 256.
C. she should receive the inventor's share of past and future royalties.
D. she can probably get the patent reassigned to her.

3. In another instance, L (Q2) did not report A's invention to the tech transfer office. Rather, she took everything home and filed privately. Later, she found a party willing to pay substantial royalties for assignment of the ensuing patent. If so:

A. the current assignment is sure to be void.
B. L's multiple frauds make the patent invalid.
C. L could be prosecuted under state and federal criminal law.
D. L could be prosecuted under state, but not federal, criminal law.

4. Zed (Z) sent rules for his original promotional game to several manufacturers and made it clear that he expected to be compensated for any commercial use. One firm did not respond but used the game with great commercial success. If Z sues for compensation, he will likely recover:

A. on a trade secret theory under New York common law.
B. on a copyright theory in the First Circuit.
C. for misappropriation in most states.
D. nothing.

5. A consumer edition of Pfo's (P) photo editing software bears several shrinkwrap agreements. An overarching agreement (#1) defines and forbids "professional" use. Another (#2) forbids copying the menu hierarchy except as needed for acceptable use of the application. If so:

A. #1 is apt to be enforced in the Seventh Circuit.
B. #2 is likely to be enforceable in the First Circuit.
C. both agreements are inconsistent with 17 U.S.C. § 102(b).
D. neither agreement is inconsistent with 17 U.S.C. § 102(b).

6. A competitor, Gnu (G), uses P's (Q 5) menu hierarchy in its otherwise independently created software. Based on that, P runs ads that threaten G's customers with suit for infringing its copyrights and trade secrets. If G sues to halt or restrict those ads:

A. G should be able to halt P's threats concerning trade secret liability.
B. under *Mikohn,* any basis for state liability should be preempted.
C. the First Amendment provides P with a complete defense.
D. G can halt all references by P to its products or marks.

7. Bob's nonparodic, high-quality prints are signed and numbered. They accurately reproduce famous trademarks, often as seen on owners' goods. If so, any suit brought to halt Bob's activities:

A. would have merit under Lanham Act § 43(a).
B. would be unaffected by the First Amendment.
C. would have no merit under Lanham Act § 43(c).
D. might succeed in California under the theory of *Comedy III.*

Part II: Matching

[20 points]

Specific instructions: Answer only 20 of 24.

Numbered topics are addressed in letter-denominated cases. Put the best letter in 20 spaces on the answer sheet. Only the first 20 answers count.

1. Patent misuse
2. Right to repair
3. Assignee estoppel
4. Trademark misuse
5. Copyright fair use
6. Trademark fair use
7. Patents as "property"
8. Patents for processes
9. File wrapper estoppel
10. Deceptive advertising
11. Copyright injunctions
12. Trademark disclaimers
13. Fraud on the PTO
14. Rights of publicity
15. Patent preemption
16. Parody as a defense
17. Deceptive inventions
18. Copyright formalities
19. Copyright preemption
20. Trade secrets as "property"
21. Criminal copyright liability
22. "Hot news" misappropriation
23. Patent versus copyright protection
24. Advantages to trademark registrants

A. Juno
B. Berge
C. Festo
D. Mazer
E. Tasini
F. Wilson
G. Qualitex
H. Hoffman
I. Wheaton
J. Tilghman
K. Paper Bag
L. Cardtoons
M. Morehouse
N. LaMacchia
O. Juicy Whip
P. Group One
Q. Scott Paper
R. Morton Salt
S. Bonito Boats
T. Rock and Roll
U. Folsom v. Marsh
V. Eastern Air Lines
W. Planned Parenthood
X. National Basketball Ass'n

Examination No. _____

Answer Sheet

Part I — (80%)

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

A. Patents

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

B. Copyrights

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

C. Trademarks

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

D. Miscellaneous

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

Part II — (20%)

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

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