

Fundamentals of Intellectual Property

Final Examination

Professor Field

Spring 2006

Instructions

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.

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

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 Cyber-Auction.com infringes Al's software patent, but he does not practice it:
 - A. he will be denied all relief because patentees must practice their patents.
 - B. no relief will be withheld merely because he doesn't practice it.
 - C. he will be denied damages for failure to practice.
 - D. he will be granted damages but no injunction.
2. Mabel assigned a patent to e-Com.net software. After that assignment was registered under § 261, she assigned the same patent to Bozo radio. The second assignment is:
 - A. void because the first one was registered.
 - B. void if it covers a different geographic area.
 - C. good if the two assignments cover different fields of use.
 - D. good because assignments convey only non-exclusive rights.
3. If GoofSoft infringes a patent, its best defense would be that:
 - A. information provided in the specification does not yield optimal results.
 - B. practicing the patent requires key information not in its specification.
 - C. GoofSoft's activities literally infringe no claim.
 - D. most claims are too broad.
4. Besides any defense mentioned above (Q3), GoofSoft would find it most helpful if the allegedly-infringed patent claims:
 - A. a mathematical algorithm.
 - B. a novel use of a well-known algorithm.
 - C. an important method of doing business.
 - D. a process for making an old, and well-known product.

5. SCJ manufactures and sells Fantastic®. If Ed's application claims its use for wart removal:
 - A. those claims are apt to be rejected unless SCJ approves of such use.
 - B. those claims are apt to be rejected absent FDA approval of such use.
 - C. and issues, and if FDA also approves, SCJ's future sales could infringe under § 271(b).
 - D. and issues, and if FDA also approves, SCJ's future sales could infringe under § 271(c).

6. Assume that Ed (Q5) disclosed his invention to Nostrums in confidence fourteen months before filing. If so, and his patent issues:
 - A. its validity would be unaffected by that disclosure.
 - B. it would probably be invalid under § 102(b).
 - C. it is sure to be invalid under § 102(a).
 - D. it is likely be invalid under § 103.

7. Assume that, after his demonstration (Q6), Nostrums, instead of Ed, then filed a patent application. If so, Ed's disclosure would invalidate any patent that might issue under:
 - A. § 102(c) if Ed is the named inventor.
 - B. § 102(d) if Ed is the named inventor.
 - C. § 102(c) unless Ed is the named inventor.
 - D. § 102(f) unless Ed is the named inventor.

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

Answer only 5 of 7.

1. Writers of manuscripts hold federal copyright:
 - A. if, and only if, they publish with notice and register within three months.
 - B. if, and only if, they register within three months of publication.
 - C. as soon as their work is published.
 - D. without further action.

2. Paula designed a doll and several costumes for it. If so, copyright(s) would be:
 - A. available for the doll but not for the costumes.
 - B. considerably less cost-effective than design patents.
 - C. unavailable for the doll if it is useful for entertaining children.
 - D. more useful than design patents for excluding infringing imports.

3. Robin designs bracelets, necklaces, rings and similar jewelry. If he attempts to register them:
 - A. and the Copyright Office happens to refuse, he can nevertheless sue infringers.
 - B. the Copyright Office is likely to refuse because his products are useful.
 - C. and the Copyright Office refuses, judicial review is unavailable.
 - D. the Copyright Office will register despite lack of originality.

4. Sally, an investigative reporter for XSTV, lied to get herself hired as a sweeper by Smith Dairy (SD). She then used a minicam to document disgusting, unsanitary conditions in SD's plant. If SD manages to tape and register the images when they are later broadcast by XSTV:
 - A. it would have no rights because facts are uncopyrightable.
 - B. it would hold no copyright even if Sally was SD's employee.
 - C. it would hold no copyright because XS was Sally's primary employer.
 - D. registration would provide irrebuttable proof of SD's ownership under § 410.

5. Angus subscribes to many newspapers. He cuts out stories and forwards them to clients. If multiple clients are mentioned in a story, he buys additional papers. If he is sued, he will:
- avoid injunction because so-far-unpublished stories cannot yet be registered.
 - avoid liability because news is not copyrightable subject matter.
 - be enjoined if clipped stories are regarded as derivatives.
 - is sure to be liable for reasons given in *Tasini*.
6. Professor Pander has happy students. She scans most assigned casebooks and puts them on her law school's website. No author has objected and some think that it is a good idea, so she is sure that this is OK. If a publisher sues:
- it will lose because § 107 exempts face-to-face teaching.
 - any statutory damages are apt to be comparatively small.
 - no relief will be available because judicial opinions are uncopyrightable.
 - an injunction is unlikely unless the general public has access to the website.
7. Fred has informed potentially affected parties of his intention to use their works. If one or more of them sues to prevent this, he should be enjoined unless:
- he pays the fair royalty to be determined by the Copyright Office.
 - he pays a fair royalty to be determined by the Federal Circuit.
 - his use is subject to a statutory compulsory licence.
 - he registers each custom CDs within a week.

C. Trademarks [references to Lanham Act]

Answer only 5 of 7.

1. Dipsy sells a uniquely shaped cereal. After it became popular, Topsy began to sell a slightly larger version under a similar name. D's best grounds for relief is that:
- it spent several million dollars advertising its cereal.
 - both the shape and name of its cereal have "secondary meaning".
 - that type of cereal can be less expensively made in a different shape.
 - a few restaurant patrons believed that Topsy's cereal was made by Dipsy.
2. After Owner failed to renew its federal Fodo registration for shoes, Bif and Bof both rushed to market with that brand of shoe. If Bif was quicker, but Bof spent more money:
- Bof has exclusive rights to Fodo-brand shoes because it spent more money.
 - Owner may be able to stop them both under § 43(a)(1)(A).
 - Bif used first, so it has exclusive rights to the Fodo brand.
 - Owner can stop them both under § 43(a)(1)(B).
3. For eight years, New England retailer, Snif, has promoted gardenia scent as its mark for socks. Two years ago, after the Federal Circuit (CAFC) reversed a PTO rejection, Snif's scent-mark was registered. Last year, a California firm began promoting gardenia scent as its source indicator for socks. If Snif learns of that and sues, it will prevail under:
- § 32 because Snif's trademark is federally registered.
 - § 43(a) after Snif sells a few scented socks in California.
 - § 43(c) regardless of whether Snif ever sells any socks in California.
 - § 32 if the 9th Circuit agrees with the CAFC that scents qualify as marks.

4. Knowing that A had filed an intent-to-use application, B used the same mark on the goods designated by A and registered it as a domain name. When A's mark was published, B opposed. B also asked a court to enjoin A's use of the mark as intended. In those circumstances:
 - A. even if A can register, B has a prior use defense under § 33(b)(5).
 - B. if A can register, it is likely to prevail against B under § 43(d).
 - C. B's opposition is likely to succeed under § 2(d).
 - D. the court must enjoin A's use under § 43(a).

5. Cookers (C) sells \$50 Sizzle skillets. Its federal registration issued in 1996. Dud (D) has sold \$500 Sizzler outdoor grilles since 1998. If their products sell nationally, once C discovers D:
 - A. lack of prior confusion will be helpful to D.
 - B. C must show actual confusion to win under § 32.
 - C. most judges will infer that D intended to free ride.
 - D. C should prevail under § 32 because its mark is strong.

6. If Dud (Q5) owns the domain name, e-sizzler.com:
 - A. it can easily prevent C from registering e-sizzle.com as a domain name.
 - B. a court would be obligated to transfer D's registration to C.
 - C. D is likely to be a cybersquatter.
 - D. D is likely to be able to keep it.

7. F0 is a franchisor. Its federal registration (Fonduit for restaurant services) issued in 1988. Recently F0 licensed F3 in Salem — 250 miles from F1, a current franchisee, and 75-miles from a town where F2, another franchisee, had opened in 1987. F2, however, went out of business in 1994. If Fx, a restaurant of the same name, has been operating in Salem since 1989:
 - A. a court is likely to halt rather than delay the opening of F3.
 - B. a court is more likely to delay than to halt the opening of F3.
 - C. F0's long delay forfeited all rights within about 25 miles of Fx.
 - D. given its customers' interests, Fx should not be forced to change its name.

D. Miscellaneous

Answer only 5 of 7.

1. Klutz (K) sued Lou (L) for misappropriating his complex polymer recipe for superballs. Before trial, L learned that, although it was in an envelope, K had carelessly left the recipe on a restaurant table for several hours. If L now moves to dismiss, a court is most likely to rule that:
 - A. secrecy was forfeited because restaurant employees might have opened the envelope.
 - B. L must show that the recipe was seen and understood by a non-confident of K.
 - C. L need only show that the recipe was understood by someone other than K.
 - D. obvious superball recipes are unprotectable as secrets.

2. Assume that L (Q1) has not learned of the restaurant scenario. Rather, he has just discovered that a disgruntled former employee published K's recipe on the web two days ago. If the recipe is otherwise protectable and the court adopts a property theory, L will be:
 - A. liable only for prior uses of K's recipe.
 - B. liable only for future uses of K's recipe.
 - D. liable for both prior and future uses of K's secret.
 - C. compared to the facts in Q1, more free to use the recipe.

3. Paula published a book of photographs. They show several views of her original dolls. The book's back cover has a very small notice advising original purchasers of the book that they may make one copy of any doll shown therein. If Paula can prove that Sam has made two copies of any of her dolls and sues him, Sam will:
- A. be found to have infringed her copyright.
 - B. be liable, if at all, only for breach of contract.
 - C. win because her restriction is preempted by 17 U.S.C. § 107.
 - D. win because her restriction is preempted by 17 U.S.C. § 109(a).
4. Apex (A) sells waffle irons and toasters on condition that the secret means for ensuring that food is never over- or under-cooked not be reverse engineered. Beta (B), after purchasing a few of each, reverse engineered A's products. If A sues, B will:
- A. be liable under § 1 of the Restatement (3d) of Unfair Competition.
 - B. win unless A's temperature release mechanism is copyrighted.
 - C. win unless it infringes one or more of A's patents.
 - D. be liable for misappropriating A's trade secrets.
5. Rather than sue, A (Q4) decided to inform most resellers of B's products that they are likely to infringe A's important IP rights. B's sales then plummeted. If A holds no patents, in deciding whether to sue, B should consider that:
- A. false commercial speech cannot be enjoined.
 - B. deceptive commercial speech may be halted despite its literal truth.
 - C. the Federal Circuit has consistently regarded such speech as privileged
 - D. paraphrasing an old nursery rhyme, "Words can never (legally) harm you."
6. Orville (O) is a comedian and story teller. His presentations, closely tailored to audience reaction and current events, are spontaneous and never rehearsed. Although explicitly forbidden, Myrtle (M) taped O's recent show at the Ohio state fair. If she puts an MP3 file on the web and O sues, the case is most likely to be governed by:
- A. the 1976 Copyright Act because O's material has been fixed.
 - B. the Restatement (3d) of Unfair Competition § 43.
 - C. Ohio law governing unfair competition.
 - D. Ohio law governing rights of publicity.
7. PixCo published a series of ads for its new digital cameras. The ads, featuring robots made to resemble them, make fun of famous people. If an ad features an Elvis-Presley-look-alike robot and his estate sues, relief is:
- A. unlikely if the court follows only *Hoffman*.
 - B. unlikely if the court follows only *Cardtoons*.
 - C. likely if the court follows *Cardtoons* and *Hoffman*.
 - D. likely under § 43(a)(1)(A) because the ad would imply Elvis's endorsement.

Part II: Matching

[20 points]

Answer only 20 of 24

Lettered clauses match only one term. Please enter the best letter in the corresponding space on the answer sheet.

- | | |
|----------------------------|----------------------------------|
| 1. Story | 13. Unclean hands |
| 2. Treaty power | 14. Outside submissions |
| 3. Independent creation | 15. NET Act |
| 4. Exhaustion | 16. CCPA |
| 5. Doctrine of equivalents | 17. Machlup |
| 6. Consumer deception | 18. Priority of appropriation |
| 7. Court of claims | 19. Misdescriptive |
| 8. Statute of Monopolies | 20. State trade dress protection |
| 9. Architectural works | 21. Accidental discovery |
| 10. Dilution | 22. Unfair competition |
| 11. Written document | 23. Rich |
| 12. Striking similarity | 24. Merger doctrine |

- A. Often preempted by patent law.
- B. Described very early patent grants.
- C. Authored many seminal patent opinions.
- D. Common way to acquire trademark rights.
- E. Increasingly likely to be treated as trade secrets.
- F. Designed to void patents granted as royal favors.
- G. Resolved most applicants' challenges to PTO refusals.
- H. A problem sometimes effectively solved by disclaimers.
- I. Authored several seminal patent and copyright opinions.
- J. A basis for refusing injunctive (and possibly other) relief.
- K. May substitute for a need to show access to copied works.
- L. Patent law equivalent to copyright law's first-sale doctrine.
- M. Synonymous with "arbitrary" when applied to trademarks.
- N. A basis for liability when literal infringement cannot be shown.
- O. An arguable defense to claims of trade secret misappropriation.
- P. May apply to simple ideas with limited options for distinct expression.
- Q. A trademark-related cause of action recently added to the Lanham Act.
- R. Altered conditions needed to establish criminal liability for infringement.
- S. Solid defense to claims that trade secrets or copyrights have been infringed.
- T. Necessary to transfer rights exceeding those conferred by copyright licenses.
- U. Resolves patent and copyright claims asserted against the federal government.
- V. Until recently, the term indicated only a narrow, trademark-related cause of action.
- W. Works that, if visible from public places, are subject to limited rights of reproduction.
- X. Supplements commerce clause and patent and copyright clause support for IP legislation.

Answer Sheet

Part I — (80%)

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

A. Patents

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

C. Trademarks

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

B. Copyrights

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

D. Miscellaneous

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

Part II — (20%)

Answer only 20 of 24 (1% each)

- | | |
|-----------|-----------|
| 1. _____ | 13. _____ |
| 2. _____ | 14. _____ |
| 3. _____ | 15. _____ |
| 4. _____ | 16. _____ |
| 5. _____ | 17. _____ |
| 6. _____ | 18. _____ |
| 7. _____ | 19. _____ |
| 8. _____ | 20. _____ |
| 9. _____ | 21. _____ |
| 10. _____ | 22. _____ |
| 11. _____ | 23. _____ |
| 12. _____ | 24. _____ |