

# Fundamentals of Intellectual Property

## Final Examination

Professor Field

Fall 2009

This is a three-hour, open-book exam. Any written materials may be used, but you may 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 each section (A–D) count.**

#### A. Patents [Section references to 35 U.S.C.]

Answer only 5 of 7.

1. A jury gave Bob a large cash award after Zex was found to willfully infringe his patent. If, because Bob does not practice his invention, the court refuses to issue an injunction:
  - A. royalties for future infringement must be awarded.
  - B. that flagrantly ignores Bob's patent as property.
  - C. Bob will have received all that he is entitled to.
  - D. the award should also be set aside.
2. Dento holds U.S. patents on electric toothbrushes marketed as disposable. Fred, who has a supply of used Dento brushes that were refurbished abroad, will, within the United States:
  - A. be found to induce infringement.
  - B. be found to infringe if he sells them.
  - C. be able to sell them if he labels the Dento brushes as recycled.
  - D. be liable for breaching an implied agreement not to reuse them.
3. Ed's doodad is useful for solving a long-standing refrigeration problem. If the doodad is patentable, a valid patent:
  - A. could also claim all solutions to the problem because he was the first to solve it.
  - B. could claim uses of the doodad only in the context of refrigeration.
  - C. could cover all possible uses of his doodad.
  - D. cannot cover any use of algorithms.
4. Prior inventors got nothing but sparks and noise, but Joe discovered that specific members of three families of substances can be variously combined to good use. His invention:
  - A. is unpatentable if his substances occur in nature.
  - B. is unpatentable because his combinations produce unexpected results.
  - C. is patentable, but claims must be limited to specific disclosed combinations.
  - D. can be more broadly claimed if he understands how blended components interact.

5. Only experts can distinguish Sally's synthetic vicuña fur from the real — very rare and expensive — thing. If she got a patent on the process of making her fur:
  - A. it would be invalid if her synthetic is essentially the same as the natural fur.
  - B. enforcement could be denied if she uses her invention to deceive people.
  - C. it would provide a defense against prosecution for deceit or fraud.
  - D. sellers of natural fur would be contributory infringers.
  
6. Sally (Q 5) initially offered to sell her rights to one manufacturer who wasn't interested. If, a year later, another agreed to underwrite the costs of obtaining a patent, that patent would be:
  - A. valid despite pre-filing activity.
  - B. invalid for filing more than one year after disclosure to a stranger.
  - C. invalid under § 102 for filing more than one year after an offer to sell.
  - D. invalid under § 103 for filing more than one year after an offer to sell.
  
7. After Jesus, a chemist, became a chef, he discovered that most chefs know nothing of science. If he then got food-preparation patents based on elementary chemistry, they would be:
  - A. valid if no chemist would expect his methods to work.
  - B. invalid if some chefs know a great deal of chemistry.
  - C. valid if no chef would expect his methods to work.
  - D. invalid for lack of novelty.

**B. Copyrights [Section references to 17 U.S.C.]**

**Answer only 5 of 7.**

1. Theo, who lives in Sweden, distributes his book on the internet. If Ed, a Canadian, copies Theo's book and sells it in the United States, Theo:
  - A. cannot sue here unless he registers.
  - B. would have had no reason to register.
  - C. cannot get attorney fees here unless he registers.
  - D. cannot sue here regardless of whether he registers.
  
2. If Mort sells exact replicas of fancy cemetery statues:
  - A. § 120(a) provides that photographs of his replicas would not infringe.
  - B. the Copyright Office would definitely not register his work.
  - C. he need not worry about infringing copyright himself.
  - D. his work is probably unprotected by copyright.
  
3. Mary hired Bob, a freelance jokester, to write captions for her cartoons. After she published a very successful collection, he asked for a share of her income. If she refuses:
  - A. she will need to establish that his work was for hire.
  - B. he will nevertheless be entitled to half as joint author.
  - C. he will need to establish that his work was not for hire.
  - D. he will nevertheless be entitled to a third as joint author.
  
4. In his show, Zuper-Dude performs a series of dangerous skateboard stunts. Lest it bring bad luck, he never videotapes them. If MTV tapes an entire show without Z-D's permission:
  - A. infringement is impossible because his work falls outside the scope of § 102.
  - B. MTV's use of its tape would be protected under the First Amendment.
  - C. Z-D will have no cause of action because he never fixed his work.
  - D. a state court could award damages.

5. After learning that Fred had copied four of their \$25 CDs for Bro, his kid brother, Musico hoped that filing criminal charges would deter other pirates. If officials agree to prosecute:
  - A. neither brother can be convicted of a crime.
  - B. Bro could be convicted under state law for holding stolen property.
  - C. Fred could be convicted, but only under § 506 of the Copyright Act.
  - D. Bro could be convicted under federal law for holding stolen property.
  
6. Bro (Q 5) made copies for his friend, Sam, who made copies for about twenty friends. If so:
  - A. Fred and Bro both have civil liability as direct infringers.
  - B. Sam has neither civil nor criminal liability; his use is fair.
  - C. Sam may be subject to civil but not criminal liability.
  - D. Bro is liable as a contributory infringer.
  
7. Eric makes ceramic coin banks, sometimes many of the same bank, often only one or two. The latter are highly valued. Bob has taken pictures of each one. If Myrtle displays Bob's pictures (with corresponding current prices) on the web:
  - A. she will facially violate § 106(1), but not § 106(2).
  - B. neither Bob nor Eric hold copyright until they register.
  - C. she is more likely to infringe Bob's copyright than Eric's.
  - D. Eric's copyright is unaffected by potential uses of his banks.

**C. Trademarks** [Statutory references to Lanham Act]

**Answer only 5 of 7.**

1. For a year or so, Eric's banks (Q B-7) have all been distinguished by red polka dots. If Bud begins to decorate substantially similar banks with red polka dots, Eric:
  - A. can use § 32 to halt copying of the polka dots.
  - B. can use § 32 to halt copying of the similar structures.
  - C. might recover under state law for copying the polka dots.
  - D. might recover under state law for copying the similar structures.
  
2. When Moon-mist (MM) formally abandoned its mark, Mi and Tu both began to use it.
  - A. If Mi files an ITU application before Mi uses, it will get the rights.
  - B. MM could probably prevent registration by either Mi or Tu.
  - C. If Tu ships across state lines first, it will get exclusive rights.
  - D. MM no longer has any rights.
  
3. As a service mark, Moon-mist would be:
  - A. strong because the term is coined.
  - B. unregistrable because it is deceptive.
  - C. weak because it consists of common words.
  - D. weak because it is a term that others could justifiably use.
  
4. Dodo registered its mark for toothpaste, but, because "paste" is unappetizing, it then began calling the product tooth "polish." A combined §§ 8 & 15 affidavit using an old "paste" label:
  - A. would not affect Dodo's capacity to sue under § 43(a)(1)(A).
  - B. would forfeit incontestability of the registration.
  - C. would cause loss of Dodo's common law rights.
  - D. would likely be regarded as fraudulent.

5. Sun-Kist and Sunkist both object to MoCo's use of "Sun-Kissed" for fresh lettuce and spinach. Assuming the facts are otherwise the same as in the case we read:
- neither is likely to prevent use or registration.
  - both should be able to halt use of the mark under § 32.
  - both should be able to successfully oppose under § 2(d).
  - at least one should prevail because its goods are in the same class as MoCo's.
6. JCo has several "Joe" coffee shops in Boston and just added another. When a web search revealed that KCo has long had one "Joe" coffee shop in rural Iowa, JCo filed for federal registration. KCo probably:
- cannot halt registration, but JCo would have no rights outside of Boston.
  - could prevent registration if KCo's shop opened before any of JCo's.
  - can register too, but it would end up with less territory than JCo.
  - could prevent registration because JCo operates in only one state.
7. Apricot buys old Apple computer cases and replaces most internal components. If those refurbished computers will no longer run its software, Apple is likely to:
- only get disclaimers.
  - get no relief; it made the cases.
  - only get original logos and other identification removed or obliterated.
  - prevent use of cases that by design alone indicates it to be the manufacturer.

#### **D. Miscellaneous**

##### **Answer only 5 of 7.**

1. The Restatement (Third) of Unfair Competition § 40(b)(4) forbids use of secrets accidentally disclosed and discovered. This means that:
- a suggestion to the contrary in *Kewanee* is unlikely to be followed.
  - all courts would have to so hold as a matter of federal law.
  - only state courts would be bound to so hold.
  - a state court might be inclined to so hold.
2. PubCo recently received Joe's unsolicited manuscript. If it will publish only on condition that Joe agrees in writing that he wrote it as a work for hire, that agreement:
- would make him an employee under § 203(a)(5).
  - cannot prevent the exercise of his termination rights.
  - would be enforceable because it doesn't run against the world.
  - can't be enforced under state law because it governs use of a copyrighted work.
3. Before PubCo (Q 2) could publish, it got a letter from Apex claiming that Joe's manuscript infringed its copyright. PubCo refused to publish unless Joe could obtain a judicial determination of noninfringement. He eventually prevailed based on a close fair use analysis. If, meanwhile, much of the value of his time-sensitive work is lost:
- Apex will probably be liable to Joe for interference with business relationships.
  - Apex will probably be liable to PubCo for unfair competition.
  - Neither Apex nor PubCo are apt to be liable to anyone.
  - PubCo will probably be liable for breach of contract.

4. After he filed a patent application, Fred disclosed his super-deluxe toothbrush holder to KrukCo, saying that he expected to be paid in the event that they decided to use it. If KrukCo has since made substantial money on sales of the holder, but no patent was ever granted, Fred will be entitled to:
- A. nothing.
  - B. a fair share of its profits.
  - C. a 5% royalty on net sales.
  - D. a 2.5% royalty on net sales.
5. Buildings that contain JCo's shops (Q C-6) are all shaped like large mugs. It recently obtained federal trade dress registration for them. Whiz, who works for the Boston Globe, took several photographs. One dramatic shot was published in the paper; it is also now sold as \$100 posters labeled "Joe Coffee." If JCo sues, there is:
- A. a remote chance of prevailing if the posters are seen as media, not merchandise.
  - B. a remote chance of prevailing under copyright but not trademark law.
  - C. a good chance that its trade dress and copyright are both infringed.
  - D. no chance that its right of publicity is being infringed.
6. While flying over ACo's construction site, Ralph decided to take photos. Only later did he learn that BCo was very interested in ACo's plant design. He sold them copies, but ACo didn't discover this until a patent had issued. If BCo has not yet used the photos in any way, ACo:
- A. could nevertheless get an injunction against its doing so.
  - B. is unlikely to prevail because it failed to cover its construction site.
  - C. is unlikely to prevail if the photos disclose no more than the patent.
  - D. cannot prevail against Ralph because he holds copyright in the photos.
7. Long-term employees of DudCo recently chose Star-class as the mark for its new gadget. Before marketing under that or any name, if it wants to avoid IP problems, DudCo must search:
- A. patents granted in the United States and elsewhere for the past thirty years.
  - B. PTO trademark registrations but not pending applications.
  - C. marks in current use on similar goods.
  - D. All foregoing statements are true.

## Part II: Matching

[20 points]

**Specific instructions:** Answer only 20 of 24. **Only the first 20 answers count.**

Each numbered item is intended to match only one lettered item. Put the **best** letter in up to 20 numbered spaces on the answer sheet.

- |              |                               |
|--------------|-------------------------------|
| 1. Juno      | 13. Paper Bag                 |
| 2. Berge     | 14. Cartoons                  |
| 3. Festo     | 15. Morehouse                 |
| 4. Mazer     | 16. Group One                 |
| 5. Tasini    | 17. Scott Paper               |
| 6. Wilson    | 18. Morton Salt               |
| 7. Belcher   | 19. Bonito Boats              |
| 8. Fregeau   | 20. Rock and Roll             |
| 9. Qualitex  | 21. Folsom v. Marsh           |
| 10. Wheaton  | 22. Eastern Air Lines         |
| 11. Hoffman  | 23. Planned Parenthood        |
| 12. Tilghman | 24. National Basketball Ass'n |

- A. Finds a process patent to be valid.
- B. Rejects trademark misuse as a cause of action.
- C. Refuses trademark, but grants copyright, relief.
- D. Presents an early summary of the fair use doctrine.
- E. Non-profit organizations may register service marks.
- F. To be patentable inventions must perform as claimed.
- G. Single colors may become registerable source indicators.
- H. State law that prevents reverse engineering is preempted.
- I. Demands strict compliance with U.S. copyright formalities.
- J. Copyright can exist in elements separable from useful objects.
- K. Publishers' ability to reuse work of free lance authors is limited.
- L. Refuses to find that a building had been used as a source indicator.
- M. Context may be used to rebut the notion of celebrity endorsement.
- N. A party entitled to use generic terms must use them non-deceptively.
- O. Permits an assignor later to practice technology claimed by his patent.
- P. Foreseeable repair of patented goods does not constitute infringement.
- Q. Compares the effects of fraud in PTO patent and trademark proceedings.
- R. Patent infringement can be based on more than the literal scope of claims.
- S. Patentees who impose overreaching license obligations may be denied relief.
- T. Limited relief from INS-type-misappropriation may survive 17 U.S.C. § 301(a).
- U. Finds baseball trading cards to be media that enjoys First Amendment protection.
- V. Finds state law incapable of redressing the allegedly improper use of data and ideas.
- W. Finds an injunction appropriate despite an infringer's willingness to license a patent.
- X. Some states focus on secrecy instead of the fairness of means used to get trade secrets.

**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. \_\_\_\_\_
- 4. \_\_\_\_\_
- 5. \_\_\_\_\_
- 6. \_\_\_\_\_
- 7. \_\_\_\_\_

**D. Miscellaneous**

- 1. \_\_\_\_\_
- 2. \_\_\_\_\_
- 3. \_\_\_\_\_
- 4. \_\_\_\_\_
- 5. \_\_\_\_\_
- 6. \_\_\_\_\_
- 7. \_\_\_\_\_

**Part II — (20%)**

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

- 1. \_\_\_\_\_
- 2. \_\_\_\_\_
- 3. \_\_\_\_\_
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- 24. \_\_\_\_\_