

FINAL EXAMINATION
INTELLECTUAL PROPERTY

P.N. Davis

Wednesday, May 4, 1994

8:30 - 11:30 AM

THIS IS A THREE (3) HOUR EXAMINATION.
THIS EXAMINATION CONSISTS OF TEN (10) PAGES.
THIS EXAMINATION CONTAINS SEVEN (7) QUESTIONS.

I = 30 min. II = 20 min. III = 20 min. IV = 20 min.
V = 30 min. VI = 30 min. VII = 30 min.

FILL IN YOUR EXAMINATION NUMBER ON THE BLUEBOOK STICKER.

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YOU BRING INTO THE EXAM YOUR COPY OF THE STATUTORY
SUPPLEMENT, with any notations in the margins and blank pages you care to make.

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Instructions:

1. These questions will be graded on the basis of the times indicated with each questions. The indicated time for the questions total 3 hours. You will be given 3 hours to write the examination. Budget your time carefully or you may not finish.
2. Be sure to state a result whenever a question asks for one. Merely stating the arguments on both sides of a legal issue will result in only partial credit because you will not have completed the analysis required by that type of question.
3. If you find it necessary to make factual assumptions in order to answer a question, be sure to state the assumption.
4. Do not assume additional facts for the purpose of avoiding a legal issue or making its resolution easier.
5. Comment briefly on each legal issue reasonably raised by the questions and on each reason for your answer, even when you decide that one legal issue or reason controls the result.
6. The difference between triumph and disaster may lie in a careful reading of the questions.

I.

(30 minutes)

The Jefferson Rifle Association is a state non-profit corporation, associated with the National Rifle Association, which lobbies officials and educates the public in support of the ownership of firearms. The Handgun Control Federation is a non-profit organization which engages in similar activities toward a goal of limiting handgun ownership and reducing gun-related crime.

On February 5 and March 7, 1993, the JRA sent short newsletters to its members urging opposition to two gun control bills pending before the State of Jefferson legislature which provided for the ban of certain assault rifles and for waiting periods before gun purchases. Attached to each letter was a three-page listing of Jefferson state legislators with their district numbers, their home cities, and their phone numbers in their home cities and in the state capital. An asterisk was placed beside the name of each legislator who was a member of the Assembly and Senate committees which were considering the gun control bills. Below the list was the following text:

The State Assemblymen and Senators marked with an asterisk (*) serve on the Assembly and Senate Committees to which H.B. 372 and S. 5 have been referred. It is extremely important, especially if you are one of their constituents, to contact their office opposing those bills. Address your letters as follows: [omitted].

Neither newsletter contained a copyright notice.

On March 14, 1993, HCF mailed a 10-page newsletter to about 200 of its members, seeking to arouse support for the same bills. The newsletter began with a page briefly explaining the pending bill and urging the writing of letters to several major Jefferson newspapers, whose addresses were provided. Seven other pages provided detailed information about the types of guns, the effect of gun control legislation, and other states' related gun control laws. The last three pages contained the same lists of state assemblymen and senators as the JRA mailing; HCF admitted in depositions that it photocopied the list from the JRA mailing. The block of text at the bottom of the list

was photocopied as well, expect that the word "opposing" was blocked out and the word "supporting" was substituted.

On July 27, 1993, JRA obtained registration of a copyright for its newsletters. On September 14, 1993, it brought suit against HCF for copyright infringement, alleging that HCF unlawfully copied JRA's list of members of the Jefferson legislature and published it in its newsletter.

How should the court rule in this case? Discuss all relevant legal issues. State a result.

II.

(20 minutes)

Harriet Reid appeals from a decision of the Board of Patent Appeals affirming the final rejection of Reid's design patent application, Serial '904. The application depicts a vase formed by the intersection of an "oblate ellipsoid with a pentagonal cylinder". See attached Diagram A. The design for the vase of the '904 application was held obvious in light of a prior art vase by Reid herself in view of a secondary reference to a bowl design, designated "shape 1982" in the publication P.V. GARDNER, *THE GLASS OF FREDERICK CARDER* (1971).

The Reid prior art vase has a shape formed by the intersection of a sphere with a cube. See attached Diagram B. The Carder shape 1982 bowl has a shape which when rotated about its central axis forms an oblate ellipsoid. See attached Diagram C, which shows a cross-section of the vase. The examiner contended that the claimed design differed from the reference only in the specific pair of geometric solids used (*i.e.*, ellipsoid versus sphere and pentagonal cylinder versus cube). According to the examiner, the substitution of one common geometric solid for another would have been *per se* obvious. She cited *In re Hopkins*, 34 F.2d 1016, 3 U.S.P.Q. 112 (C.C.P.A. 1929), which affirmed a rejection of a design patent covering the shape of a loudspeaker having a circular outline when the prior art loudspeaker had an octagonal shape. The court reasoned that the substitution in design of one aspect, from octagonal to round, was not "inventive in character".

On appeal from the Board of Patent Appeals, should the Federal Circuit affirm or reverse the rejection of Reid's design patent application? (*Note*, that obviousness is a question of law which is reviewed *de novo*.) Discuss all relevant legal issues. State a result.

See Diagrams A, B and C on next page.

DIAGRAMS IN II.

Exhibit A
1904 Harvey Application

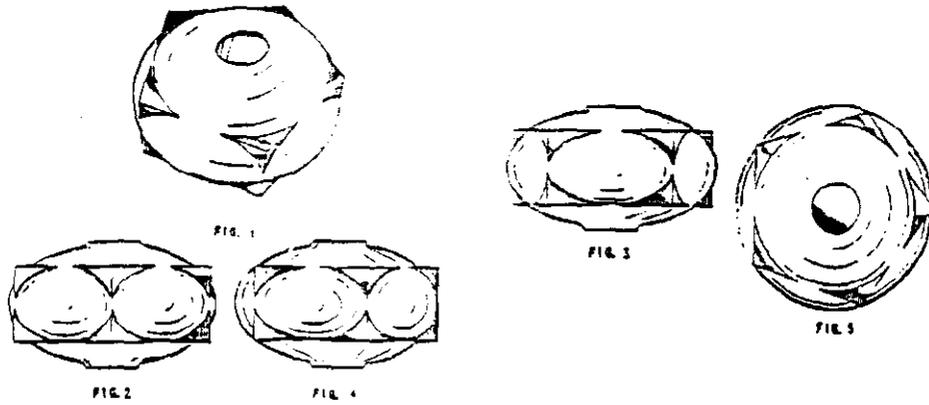


Exhibit B
Prior Art Harvey Design



Exhibit C
Carder 1932 Design (cross section)



III.

(20 minutes)

Davis Furniture, Inc., seeks to register the following service mark for "custom manufacturing of furniture upholstered with fabrics furnished or pre-selected by customers":



Davis Furniture had used those words and that logo for 10 years in St. Louis, Missouri. Evidence submitted by applicant was a market survey which shows that 40 percent of persons queried recognized the logo as a whole as that of a St. Louis furniture store. The survey did not ask persons whether they recognized the phrase alone. The examiner and the Trademark Trial and Appeal Board refused registration of the phrase, but granted registration of the logo as a whole.

On appeal, should the court affirm or reverse the TTAB's refusal to register the phrase "the sofa and chair company"? Discuss all relevant legal issues. State a result.

IV.

(20 minutes)

Kathleen Darby wrote a musical play based on the Greek myth of Medea, who married Jason (of the Golden Fleece) and killed their sons after he left her for another woman. Darby was one of the founders of a summer theater company in Columbia, Missouri, which ultimately became known as Elmwood Barn. She served Elmwood in various capacities, including playwright, artistic director, actress, play director, business manager, and member of the board of directors.

Medea is a Greek-style drama set to music. It takes the form of an operetta, with musical scenes connected with spoken dialogue. Some of the scenes and music were written by Darby while she taught high school drama. Other scenes were written later while at Elmwood Barn. Some of the non-musical scenes were improvisational were made during rehearsals, so as a result of suggestions, particularly by actors Patty Lynn and Will Kling. (The improvisational process is a form of theater in which there is no script. Actors work with an idea and a loose structure to create a play.) Lynn testified that the improvisational scenes were a collaborative effort. But she conceded that Darby took all the notes from rehearsals and compiled them into the script, and that nothing was included in the script without Darby's approval.

Although the play program attributed the script to both Lynn and Darby and although Lynn was paid royalties by Elmwood Barn for the first year's performances at Elmwood Barn, Darby denied in testimony that she ever intended to include Lynn as joint author. She claimed that the program had been written by a secretary at Elmwood Barn without her approval and that the royalties had been paid by Elmwood Barn's treasurer in error.

Two years later, after Darby left Elmwood Barn for a career with the Peninsula Players in Wisconsin, Elmwood Barn produced *Medea* again with the consent of Lynn. After learning of this event, Darby brought suit against Elmwood Barn and Lynn for copyright infringement, seeking an injunction against future productions and damages.

Should the court grant the requested relief? If damages are granted, what quantum of damages should be granted? (Answer this second question regardless of how you answer the first question.) Discuss all relevant legal issues. State a result.

V.

(30 minutes)

Business Depot began operations in the State of Jefferson in 1991. Founded by Jack Brown, it is a discount office-supply warehouse operating several branches in Jefferson; it does not operate in any other state. It had sales of \$35 million and 450 employees in 1992. It obtained a state service mark registration in 1991 after opening its first outlet.

In February 1992, *Office Depot* began operations in Jefferson. It is a large franchise multi-state operation which opened its first store in Florida in 1986. Office Depot Corp. obtained federal registration of its service mark, *Office Depot*, in 1988. Before opening his *Business Depot* in Jefferson in 1991, Jack Brown had sought an *Office Depot* franchise. At that time (1990), Office Depot Corp. wrote Brown that it was not interested in opening any *Office Depot* outlets in Jefferson, since then it did not have any outlets in bordering states. However, it changed its corporate expansion plans and extended its operations to Jefferson and bordering states by acquiring the 20-outlet chain known as *Great Midwest Office Supplies Warehouse*. It does not have a state service mark registration in Jefferson.

Business Depot then brought suit in state court seeking to enjoin Office Depot Corp. from using the service mark *Office Depot* in Jefferson. Should the court grant the requested relief? Discuss all relevant legal issues. State a result.

VI.

(30 minutes)

Premier. Premier Podiatry Laboratory was assignee of patent rights under a patent application for a low profile orthotic, a device worn inside shoes to provide better support for the wearer's feet. The inventor was Michael Graver, an employee of Premier. Graver's patent application filing date was July 26, 1985. He claims to have conceived of the invention in January 1981, according to his testimony at trial and corroborated by testimony of his wife, Teresa Graver. He made his first sample of the invention in November 1983, after his prior work obligations were completed. Graver made a disclosure to his patent attorney, Timothy Smith, employed as patent counsel by Premier, in December 1983.

Smith generally processed Premier's invention disclosures in the order that he received them. However, for three months during the summer of 1984, he participated in a trans-Pacific sailing race, and, of course, did not patent law work. To prevent a complete logjam, he arranged for a local patent law firm to process any responses to the Patent Office for ongoing patent applications; however, the firm was not engaged to initiate any new patent applications. Smith began work on the Graver application in May 1985.

MLK. MLK Laboratories was assignee of patent rights to an identical invention, invented by its employee, Alice Allison. She conceived of the invention on October 10, 1983, as corroborated by a notarized written disclosure sent to MLK's patent law firm. She reduced the invention to practice in February 1984.

Before proceeding to a patent application, MLK decided to determine the effectiveness of the invention. Beginning in March 1984, it made 100 sets of orthotics per month for 4 successive months (March-June 1984) and offered them for sale through an insert to its mail order catalog of podiatry shoes and devices. It kept a list of the customers who ordered the orthotic and sent them a questionnaire in January 1985 asking about its durability and comfort. But MLK did not mention to any of those customers that

the device was being tested, did not request return of any of those orthotics for examination, and did not place any restrictions on either who could order them or how they were to be used.

In February 1985, MLK's patent law firm began work on Allison's patent application, which was filed August 10, 1985. The firm generally handled the patent applications from its clients in the order received.

Interference. Upon receipt of Allison's patent application, the PTO declared an interference between the Graver and Allison applications. Should the PTO grant a patent to Graver or Allison? (Assume the invention was neither anticipated nor obvious.) Discuss all relevant legal issues. State a result.

VII.
(30 minutes)

Briefly define the following terms:

1. anticipation
2. misappropriation
3. suppression
4. artist's moral rights
5. work for hire
6. incontestability
7. dilution
8. fair use
9. originality
10. doctrine of equivalents