

FINAL EXAMINATION  
INTELLECTUAL PROPERTY

P.N. Davis

Monday, May 8, 1995

8:30 - 11:30 AM

THIS IS A THREE (3) HOUR EXAMINATION.

THIS EXAMINATION CONSISTS OF TWELVE (12) PAGES.

THIS EXAMINATION CONTAINS FIVE (5) QUESTIONS.

I = 30 min. II = 30 min. III = 50 min. IV = 40 min. V = 30 min.

FILL IN YOUR EXAMINATION NUMBER ON THE BLUEBOOK STICKER.

\* \* \* \* \*

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

\* \* \* \* \*

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)

John Deere Implement Company is the world's largest manufacturer of agricultural equipment, including lawn tractors. For over 100 years, Deere has used a logo depicting a deer as a trademark identifying its products. Deere owns numerous trademark registrations for different versions of its logo. Although these versions vary slightly, all of them depict a static, 2-dimensional silhouette of a leaping male deer with antlers in profile. It is widely recognized.

General Implement began manufacturing lawn tractors 20 years ago under the *Yard-Eater* trademark. In 1993, it decided to create and produce a TV commercial that would use the Deere logo for the purpose of comparing Deere's line of lawn tractors with its own *Yard-Eater* tractor. The intent was to identify Deere as the market leader and convey the message that *Yard-Eater* was of comparable or better quality, but less costly, than a Deere lawn tractor. It altered the Deere logo by changing its proportions, particularly its width. It also removed the name "John Deere" and made the frame around the deer more sharply rectangular. Most significantly, the deer in its commercial was animated and assumed various poses, something Deere had never done. General's deer looked over its shoulder, jumped through the logo frame (which then broke into pieces and tumbled to the ground), hopped to a pinging noise, and, as a 2-dimensional cartoon, in apparent fear ran as it was pursued by a *Yard-Eater* lawn tractor and a barking dog. The dog was a cocker spaniel. In the commercial the fleeing deer appeared even smaller than the dog.

After the commercial was aired on several TV programs, Deere sued General seeking an injunction. A market survey by Deere showed that the public viewing the TV commercials did not think Deere was the source of the commercial. Some of those surveyed thought the commercial was a spoof on Deere lawn tractors, some thought the deer was related to some insurance company (Hartford Insurance uses an elk on mountain top logo), and others thought the deer was Bambi. Should the court grant the injunction? Discuss all relevant legal issues. State a result.

## II.

(30 minutes)

North River Industries and Jill Mason, Inc., are competing manufacturers of women's clothing. Both have nationally marketed pullovers with similar geometric designs. North River marketed its design first and has obtained a copyright registration for it. Its design is a geometric arrangement of color blocks banded in heavy lines. Later Jill Mason began marketing its similar pullovers. North River's design is designated "Style 7114" and is depicted in Sketch B, below. Jill Mason's design does not have a name and is depicted in Sketch C, below.

North River's design was undeniably influenced by the work of the great 20th century painter Piet Mondrian.

"[He] developed an entirely non-representational style [of art]. ... [H]e restricts his design to horizontals and verticals and his color to the three primary hues, plus black and white. Every possibility of representation is thereby eliminated. ... He was interested solely in relationships and wanted no distracting elements or fortuitous associations. ... Strange as it may seem, Mondrian's exquisite sense for nonsymmetrical balance is so specific that critics well acquainted with his work have no difficulty in distinguishing fakes from genuine pictures. Horst W. Janson, *History of Art* 729-30 (1991).

The judgment of art history critics is that Mondrian's creativity with geometric shapes was expressed in each of his over 1000 paintings.

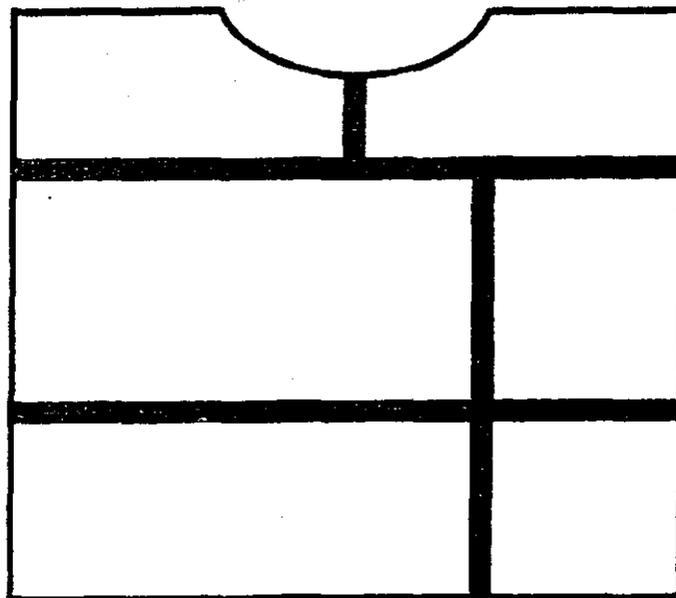
In the fashion industry, Mondrian's work still is principally associated with the French fashion designer Yves St. Laurent, who was the first to adapt the type of rectangular block designs used by Mondrian to women's clothing. The "Mondrian look", as it appeared in St. Laurent's dress designs, was widely popular in the 1960's and is copyrighted by him. North River's designer admittedly studied Mondrian's art in art school. No knowledgeable person in the fashion industry is unaware of St. Laurent's work, whose Mondrian inspired work was showcased in a recent industry publication. The St. Laurent "Mondrian" design closest to North River's is depicted in Sketch A, below.

All 3 designs uses blocks in the 3 primary colors (red, yellow, blue), white, and black.

The location of the colors is the same in all 3 designs, and are not marked on the sketches.

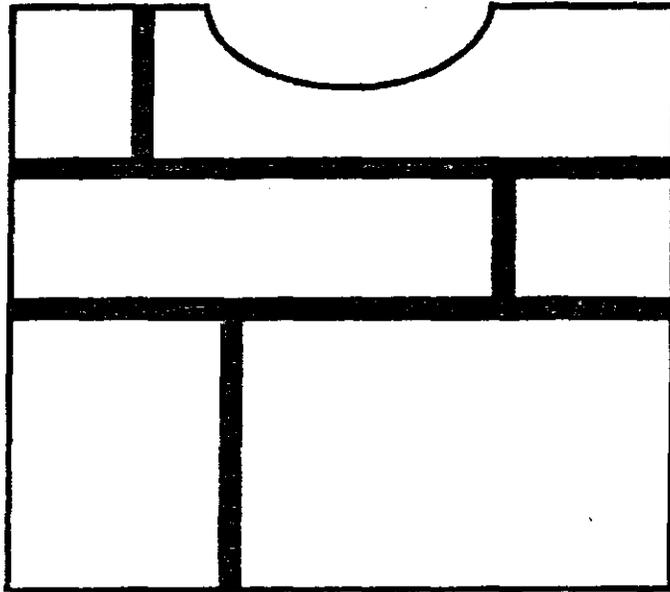
North River sued Jill Mason for copyright infringement, seeking an injunction against future sales, destruction of all existing Jill Mason pullovers, and lost profits (the necessary records are available to compute this). Should the court hold that the Jill Mason design (Sketch C) infringes the North River design (Sketch B)? Discuss all relevant issues. (Assume the requested remedies are appropriate if infringement is found.) State a result.

### SKETCHES



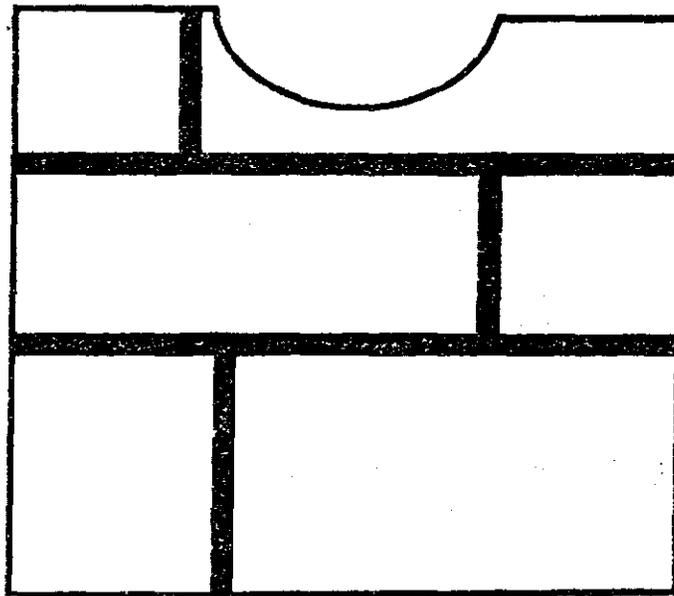
SKETCH A

Yves St. Laurent's rendition of Mondrian's painting,  
commonly seen on women's dresses



SKETCH B

Geometric design produced and copyrighted by  
North River Industries



SKETCH C

Allegedly infringing design by  
Jill Mason, Inc.

### III.

(50 minutes)

James Wells applied for a patent for improvements in the design of handbells, of the type used by music groups in churches, schools, and the like, on June 26, 1988. Quoting the application, "[a] chorus of players using a plurality of tuned bells may render any given tune which falls within the range of notes offered by the specific bells." Handbells generally are made up of the bell itself, a handle attached to the closed end of the bell, and a clapper assembly pivotably mounted inside the bell and moving in a single plane. Attached to one of the clapper assembly is a generally circular clapper or striker which, when the handbell is swung, strikes the bell to ring it.

Handbells usually are played by a group of persons, often 4 to 8 of them. Each tuned bell plays a single note. So a range of 5 octaves requires 60 bells, ranging in size from 1 inch across the open end to 12 inches or more. A single note on a bell is played by flicking the wrist in the direction of the plane of movement of the clapper, usually a forward and back motion. Because the clappers move in only one plane, it is possible to play 2 bells in one hand, ringing one bell with a forward and back motion, and the other with a to and fro sideways motion. Hence, one player can play up to 4 bells.

Traditional handbells, of relatively ancient design, have a round clapper of a single hardness. Muted notes must be played on a separate set of bells with softer clapper striking faces.

The Wells patent application discloses provision of a clapper mechanism for allowing the loudness of the bell to be adjusted quickly "on the fly," *i.e.*, while the bell is being played. Specifically, it was known in the prior art to provide the peripheral surface of the clapper with portions of differing hardness so that, by rotating the clapper, one could change which portion of it struck the bell and consequently the loudness of the bell. However, while those prior art clappers could be adjusted by rotating, they could not be adjusted while the bell was being played; the rotation was effected by loosening a set screw on the clapper with a screwdriver.

The Wells patent application not only provided the clapper with striking surfaces of differing hardness around the periphery thereof, but also provided a detent mechanism which

releasably locked the clapper in each desired position. (A detent mechanism is used in a variety of devices, such a hi-fi function switches and pencil sharpener hole size dials.) In that way, the player could rotate the clapper by hand while the handbell was being played. The detent mechanism provided a resistance to rotation which held the clapper in position during playing.

Because of the rapid adjustability of the bells disclosed in the patent application, performers could achieve musical effects not previously available in the old, indeed ancient, art of handbell music. After this handbell was first made available for sale, composers of handbell music adopted a new system of notation for handbell scores to indicate the clapper hardness to be used. Music for handbells began to be written that could not have been performed before.

Claim 3 of the Wells patent application claims:

3. A handbell comprising in combination: a bell having a generally closed end; a clapper assembly adapted to be removably carried within said bell and centrally of the closed end thereof, said assembly comprising a clapper shaft having one end pivotally associated centrally of the closed end of said bell and carrying a clapper member at its free extremity, said clapper member comprising a generally circular striker assembly rotatably positioned substantially normal to said clapper shaft and including a plurality of striking buttons positioned in opposed pairs around the outer periphery thereof and wherein each opposed pair of buttons has a different degree of hardness; means on said clapper assembly coaxing with said rotatable striker assembly for permitting rotation of said striker assembly relative to said clapper shaft for selectively positioning desired opposed pairs of buttons in striking relation to said bell; and detent means cooperating with said ratable striker for releasably holding said striker assembly in any preselected position.

The Wells patent application contained 2 drawings, one showing a side view of the bell and adjustable clapper and the other showing an end view of the clapper with its opposed pairs of striker "buttons" of varying hardness. (Those 2 drawings are attached to the end of this question.)

The Patent and Trademark Office granted Wells a patent on January 10, 1992.

On April 19, 1992, Lou Ann Jones applied for a similar adjustable handbell with

rotatable clapper. It, too, combined a detent mechanism and a clapper with 3 opposed pairs of striker faces of varying hardness. Although Jones disclosed a different detent mechanism than that disclosed by Wells, they were functionally identical. The Jones patent application contained a drawing of an end view of the clapper with its opposed pairs of striker faces of varying hardness. One pair of faces was described as composed of solid plastic, another pair composed of plastic with a moon-shaped space removed behind it (so the face would partially collapse upon impact), and the last pair composed on felt inserts. (This drawing is attached at the end of this question.)

After receipt of the Jones patent application, the Patent & Trademark Office declared an interference under § 135(a). Jones opposed the declaration of the interference on the ground that her invention did not read on the claims in the Wells patent; therefore, she was entitled to a patent as well as Wells. Also, in the first alternative, she claimed that she was the first inventor and was entitled the patent, not Wells. Furthermore, in the second alternative, she claimed that Wells handbell was not patentable for violating the prerequisites of patentability under § 102.

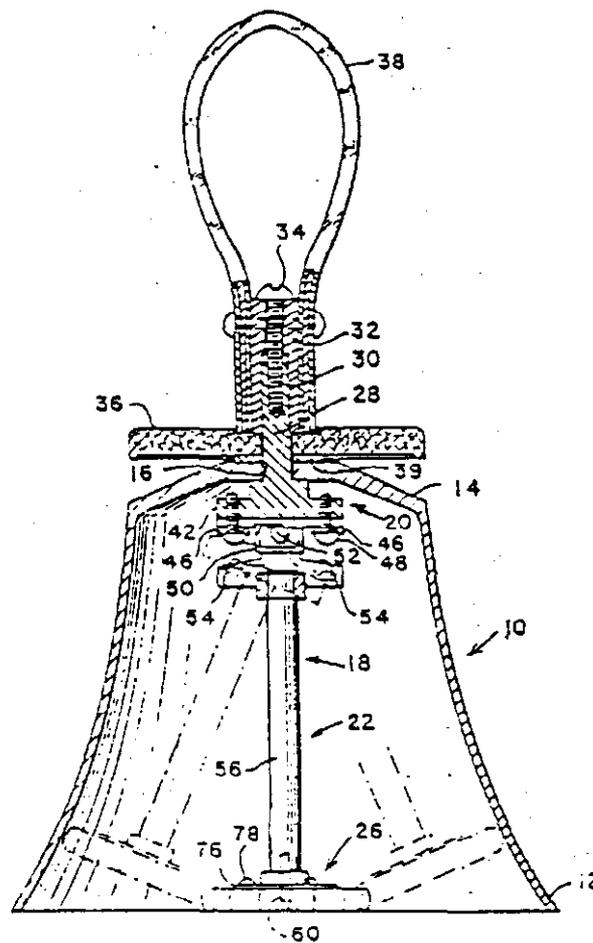
In defense of his patent, Wells introduced evidence that he had constructed a 3-octave set of adjustable bells using his detent mechanism and adjustable clapper with "buttons" and caused his church bell choir to use them for services during the Christmas season in December 1985. He then took them home for 21 months until September 1987, while he constructed another 2 octaves of bells. He and his church bell choir began using the full 5-octave set of bells in his church continuously from September 1987. He took a disclosure of his invention to his patent attorney on February 1987. After a long summer vacation following elective surgery in the summer 1987, his patent attorney began drafting Wells's patent application, which was submitted June 26, 1988.

Jones introduced evidence showing that she thought of her invention with her detent mechanism and adjustable clapper with "faces" in June 1986. She told her bell choir director of her idea and drew it on the back of a dated church bulletin (which she preserved and submitted as evidence). She then contracted with a commercial workshop to have a 4-octave set of prior art bells modified with her detent mechanism and adjustable clapper. These were completed in July 1988. Her set of handbells were first used in her church during the Christmas season in December 1988. Thereafter, her bells were not used for two years while she sought

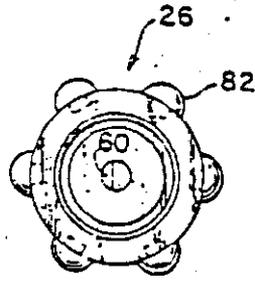
a manufacturer. She found one in January 1991. It financed the cost of the patent application, which was submitted on April 19, 1992.

Should the court accept any of Jones's three arguments (*see above*) and grant appropriate relief? Discuss all relevant legal issues. State a result.

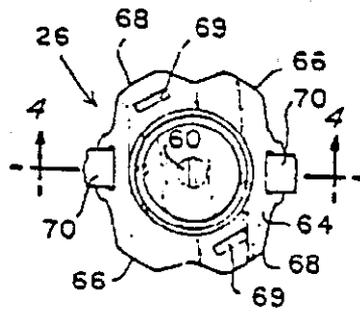
### DRAWINGS



Side view of Wells Adjustable Handbell



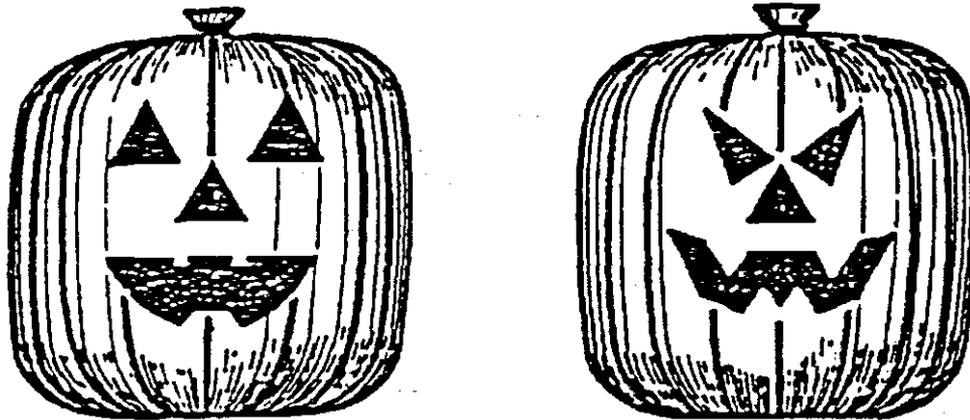
Top View of Wells Rotatable Clapper with "Buttons"



Top View of Jones Rotatable Clapper with "Faces"

IV.  
(40 minutes)

Moonbeam Products claims an ornamental design for a lawn bag, as shown below:



Its jack o'lantern face does not include a copyright symbol.

Moonbeam Products's patent claims to this design are three:

- (1) shiny orange color of bag,
- (2) "jack o'lantern faces" on opposite sides of the bag, and
- (3) closure of the bag bottom by a drawstring.

As sold, its bag has black-outline happy and scary jack o'lantern faces on opposite sides with vertical stripes (representing the wrinkles of a pumpkin). When stuffed with leaves, wadded newspaper, or other debris and tied at the top, the bag resembles a huge Halloween pumpkin. The art work for Moonbeam Products's bag was prepared by an in-house artist.

Novelty World later decided to enter the Halloween lawn bag market. It designed an unpatented line of plastic lawn bags incorporating the following features:

- (1) nonshiny orange color of bag,
- (2) a black-outline happy jack o'lantern face on one side of the bag,
- (3) closure of the bag bottom by a rubber band.

Its design has no vertical stripes. When stuffed with leaves, wadded newspaper, or other debris and tied at the top, the bag resembles a huge Halloween pumpkin. The art work for Novelty

World's facial features is identical to some of its prior art novelty products, such as party place cards and napkins.

Third party prior art includes an unpatented yellow plastic trick-or-treat bag sold by Famous Industries. The two sides of Famous's bag are identical, as shown below:



It has the following features:

- (1) yellow color of bag,
- (2) orange (with black outline) picture of a happy jack o'lantern printed on opposite sides of the bag,
- (3) vertical stripes on the jack o'lantern face, and
- (4) hand holes at the top of the bag for carrying.

The Famous bag can be stuffed with wadded paper and tied at the top. The result resembles a small "pumpkin".

Moonbeam Products sued Novelty World for infringement of both its lawn bag design patent and its registered copyright on the facial features used on the bag. Should the court grant relief for design patent and copyright infringement? Discuss all relevant issues. State a result.

V.  
(30 minutes)

Briefly define the following:

- (1) misappropriation
- (2) diligence
- (3) originality
- (4) nonobviousness
- (5) concurrent use
- (6) experimental use
- (7) secondary meaning
- (8) derivative work
- (9) reduction to practice
- (10) right of integrity

## INTELLECTUAL PROPERTY -- W 95

### I. (30 minutes)

#### A. Lanham Act trademark infringement claim:

- use of identical or substantially similar mark, such that likelihood of confusion would occur
  - on same type or related products/services
- here, General did not use Deere's mark on a product; no infringement

#### B. Dilution claim:

- def.: (1) appropriation of business good will, (2) by a competitor or noncompetitor, (3) causing a likelihood of confusion about origin or dilution of good will associated with mark
    - can involve injury to value of mark, diminution of uniqueness of mark, or tarnishing of business good will
    - is intended (1) to reserve a senior user's right to enter related product/service areas, and (2) to protect the senior mark from marketing of inferior products by junior users
  - there must be some consumer confusion or tarnishing of mark's value
  - factors: distinctiveness of senior mark, similarity of marks, similarity of products, sophistication of customers, predatory intent, comparative renown of marks
  - comparison ads are permitted
    - competitor's mark & product are properly identified
    - provided the attributes of the competitor's product are not misrepresented
  - parody defense is limited to noncommercial satire (*Bean*)
    - product disparagement is not allowed
    - there must be no likelihood of confusion
  - alteration of appearance of mark is relevant: to consumer identification; to tarnishment
  - here, "blurring" and tarnishment of Deere mark would be alleged
  - here, the product comparison was by parody; that violates the nondisparagement requirement
- decide whether there is "blurring" of Deere mark by the parody

### II. (30 min.)

2 issues: (1) is North River's design copyrightable? (2) did Jill Mason copy that design?

- the latter issue is irrelevant if North River's design is not copyrightable.

#### A. Copyrightability of North River's design.

- pictorial & graphic designs are copyrightable
- design must be in fixed medium of expression
  - clothing designs are fixed
- design must be original:
  - it was created by designer, not copied from a prior public domain or copyrighted work
  - it must show substantial creative input

- design need not have a novel or different appearance to be original
  - but it must have more than trivial variation from prior design
  - but the more elements of similarity there are, the less likely the work is original
- copying may be inferred by proving: (1) access + (2) substantial similarity
  - NR had access to YSL's design because it was nationally marketed
  - while similar, there is a noticeable difference in geometric relationships between the YSL and NR designs
- decide whether NR's design is distinguishable enough from YSL's design to be copyrightable
- B. Infringement of North River's design by Jill Mason's design
  - copying may be inferred by proving: (1) access + (2) substantial similarity
  - copying can be disproved by showing: (1) original creation, or (2) copying from prior work
  - literal copying is not required; immaterial variations may be present
    - there must be more than a borrowing of ideas or concepts
      - since only expression is copyrightable
    - there must be more than trivial variation from copyrighted work to avoid infringement
  - a 2-step process should be followed:
    - *1st*, the ideas of the 2 works must be compared to determine if they contain similar ideas or concepts
    - *2d*, if they do, then the expression in the 2 works must be compared to determine if they are substantially similar
  - discuss copying:
    - JM had access to NR's design, because it was nationally marketed
    - while similar, there is a noticeable difference in geometric relationships between the NR and JM designs
  - decide whether JM's design infringes NR's design

### III. (50 min.)

- A. Does Jones read on claims of Wells?
  - (if Jones does not read on Wells's claims, Jones is a combination of different elements and is independently patentable
    - (unless the Jones "faces" are obvious) [no other prior art described]
  - Wells claims a detent mechanism, rotatable clapper, & 3 opposed pairs of striker "buttons" of varying hardness
  - Jones teaches a detent mechanism, rotatable clapper, & 3 opposed pairs of striker "faces" of varying hardness
    - the type of detent mechanism is not specified
    - are "buttons" and "faces" equivalent?
- B. Is Wells or Jones the first inventor?
  - the earliest of conception, reduction to practice, or application dates is the applicable priority date
    - provided applicant then proceeded to application with reasonable diligence
  - Wells:

- does not assert a conception date
  - asserts a reduction to practice date of 12-85
  - asserts an application date of 6-26-88
  - gap in diligence from 1-86 to 2-87 (when he submitted disclosure to patent attorney)?
  - attorney gap in diligence from 2-87 to 9-87 (long vacation)?
    - attorney should work on applications in order without significant gaps in work effort, except illness and normal vacations, etc.
  - Jones:
    - asserts a conception date of 6-86 (informal drawing)
    - asserts a reduction to practice date of 7-88 (after modification of conventional bells by outside contractor)
    - asserts an application date of 4-19-92
    - gap in diligence from 6-86 to 7-88? (finding contractor, construction)
    - gap in diligence from 7-88 to 1-91? (finding a manufacturer)
  - if priority dates are taken without questioning diligence, Wells was first
  - if lack of diligence is found in each "gap", Wells has priority date of 2-87 and Jones has priority date of 1-91; Wells was first
  - discuss each "gap" in diligence
- C. Is Wells subject to the § 102(b) "on sale" bar?
- if invention is used in public, or is "on sale", for more than 1 year before application, invention is not patentable
  - Wells used bells in church in 12-85 and after 9-87 (application was 6-88)
  - bell use in 12-85 could be construed as "experimental use"
    - def.: use to determine whether invention is operative
    - experimental use in public does not trigger § 102(b) time period
  - bell use after 9-87 was a public use (not experimental); time period expires 9-88, 3 months after application
  - Wells patent is barred only if the 12-85 public use was not experimental
- D. Are either Wells or Jones subject to the § 102(g) suppression bar?
- senior inventor loses priority dates before application date if invention was suppressed; junior inventor who invents before senior's application date become "first" inventor
  - was Wells's 9 month period of nonuse from 1-86 to 9-87 a "suppression" or "concealment"?
    - Query?
      - he took 21 months to complete the set of bells before further use
      - he disclosed his invention to his patent attorney in 2-87
  - was Jones's 24 month period of nonuse while she looked for a manufacturer a "suppression" or "concealment"?
    - Query?
      - cannot delay application while looking for a manufacturer
      - cannot piggyback a patent upon an earlier trade secret
  - but period of "gap" in diligence was very similar to Well's 21 months, also for

manufacturing

- Jones loses all priority dates before application date of 4-19-92

Result: decide (1) diligence, (2) Wells's public or experimental use, (3) Wells's 21 month and Jones's 24 month development periods

#### IV. (40 min.)

##### A. Design patent:

- patentable design must be novel, original, and ornamental
- design patents can be granted only for nonfunctional ornamental features of an industrial product
  - here, lawn bag is an industrial product
  - jack o'lantern art work is nonfunctional
- infringement occurs when features of alleged infringing product read on claims of patented design
  - specific art work is irrelevant
  - novel features of design must be appropriated
- discuss: number of faces, vertical stripes, shininess, method of bottom closure

##### B. Copyright:

- pictorial works are copyrightable
  - here, the jack o'lantern face is a pictorial work
- originality is required
  - Moonbeam's art work was original
- pictorial work must have independent artistic existence
  - here, Moonbeam's jack o'lantern face with vertical stripes could be used as a print, as well as on industrial products
- since 3-1-89, a copyright symbol on the work has not been required (§ 401); a copyright is presumed even without the notice symbol
  - *bonus*: Novelty would not have an innocent infringer defense, since it did not seek consent from the apparent copyright owner
- hence, Moonbeam's copyright was valid
- infringement requires copying/reproduction without consent
  - Novelty's art work was taken from its prior art works: they were identical
- hence, there is no copyright infringement

VI. (30 min.)

- (1) misappropriation
- (2) diligence
- (3) originality
- (4) nonobviousness
- (5) concurrent use
- (6) experimental use
- (7) secondary meaning
- (8) derivative work
- (9) reduction to practice
- (10) right of integrity