

FINAL EXAMINATION
Trademark Law of the U.S. (LAW §891-LS1)
Professor Anolik
Spring 2007

1. You have **three (3) hours** to complete this exam. There are two (2) essay questions in this exam, and twenty (20) multiple-choice questions. Recommended (but not required) time allotments for each section are indicated at the beginning of each section.
2. This exam is an **open-book** examination. You may use your book, the statutes, and any printed, typed, photocopied, or handwritten materials, but you may not connect to the Internet, email, Lexis, or any other database, nor may you communicate with anyone else (other than your proctor) in completing this exam.
3. This exam consists of two parts.

Section I consists of two (2) essay questions. Please write your responses in the blue books provided. Please write clearly. Write on every other line and every other page to permit instructor comments. Number your blue books on the front cover of each blue book (for example, if you use three blue books, mark them as: 1 of 3; 2 of 3; 3 of 3). If you are set up to use ExamSoft, then you may use that for Section 1 instead of the blue books.

For Section 1, it is recommended that you spend one third of the time on each question creating an outline, and the remainder of your time writing the answer. For example, if you spend 60 minutes on a question, it is recommended (but not required) that you devote twenty minutes to the outline, and forty minutes to writing the answer

Section II consists of twenty (20) multiple-choice questions. Please mark your responses to the multiple choice questions on the separate “ParSCORE TEST FORM” using pen or pencil and following the instructions on that form. If you change your answer, place a clear **X** through the wrong answer and mark the correct answer. A machine will score the exam and any ambiguities will be counted as a wrong answer. It is recommended (but not required) that you spend 40 minutes on Section II.

4. Write your exam number on your exam envelope. Put your correct class section and student exam # at the top of this page, each page of exam questions, each blue book, and the “ParSCORE TEST FORM.” **Do not** use your name, student ID number or Social Security Number on any exam materials.
5. At the conclusion of the exam, return all test materials, including blue books, ParScore answer sheet, scratch paper, and this exam packet to the envelope and submit it to the proctor. **DO NOT** seal the envelope. Students who do not return all exam materials at the end of the exam may not be graded.

GOOD LUCK!

SECTION 1: ESSAY QUESTIONS

Question 1

(Question 1 is worth 50 points. Recommended time: 1 hours and 30 minutes.)

Yoga Inside Foundation (“the Foundation”), a small non-profit meditation group in Los Angeles, is having a bad day. Intel Corporation (“Intel”), the biggest semiconductor company in the world, which has long urged customers to look for the "Intel Inside" logo on computers, wants the Foundation to change its name.

The Foundation gives free yoga classes in inner-city schools, prisons, juvenile detention facilities, drug-treatment centers, and battered women's shelters in 31 states. All of these facilities are wired to the Internet and also focus on technology training as a vehicle for independence. The Foundation likewise directs its yoga participants to its website for further self-study of yoga principles.

The Foundation began in 1996 with gang members in Southern California juvenile detention facilities. The ‘inside’ refers to incarceration. “But it has a double meaning,” says Mark Stephens, the Foundation's founder and executive director. “It also refers to taking yoga within you. We are interested in reaching people who may be feeling broken in some way inside. I was thinking about Intel's slogan and how it was supposed to make you feel confident because all was working inside. Well, our groups need to be able harness that feeling as well.”

Your law firm represents Intel, whose “Intel Inside” logo has appeared on millions of computers around the world, and who has spent billions of dollars promoting the phrase. The “Intel Inside” logo (which Intel registered in 1991) is placed on all print advertising and packaging, and the “Intel Inside” program is one of the world's largest co-operative marketing programs. Since the program's inception in 1991, over \$7 billion has been invested by Intel and computer manufacturers in advertising that carried the “Intel Inside” logo. This has created an estimated 500 billion impressions, and helped to give Intel a net income of over \$11 billion dollars last year.

Many advertising professionals and technology analysts would agree that it was the unique brand identity of the “Intel Inside” campaign that played a significant role in Intel's ability to gain dominance throughout the industry. With so much invested in the "Intel Inside" mark, Intel believes that the public will reasonably understand the Foundation’s “Yoga Inside” mark as referring to Intel.

But the Foundation is concerned as well. Mr. Stephens said their program, winner of one of Yoga Journal's 2001 Karma Yoga awards, may draw copycats. "We're a household name in the yoga community," he says, "just like Intel is in the computer industry." Stephens worried that all of the media exposure the Foundation had been receiving would leave them vulnerable. Accordingly, the Foundation filed for, and in June 2003 was granted, registration on the Federal Registry for the mark “Yoga Inside”, as related to free, yoga-based rehabilitation classes.

Two months prior to the Foundation receiving its approval from the US Patent and Trademark Office for the mark, another attorney at your firm sent a cease and desist letter on behalf of Intel to the Foundation expressing Intel's concern that the mark 'Yoga Inside' is likely to cause confusion with Intel's trademark rights. In that letter, your law firm noted that, "the Foundation's own pro-bono attorney - who filed the Foundation's articles of incorporation - asked Stephens, the Foundation's founder, whether or not he had permission from Intel to use the name."

The Foundation responded to your firm's letter by stating that they respect Intel's right to protect their trademark, but feel that Intel is being overzealous. "There's no risk of consumer confusion between a chip inside a computer with a yoga class inside a prison. They've spent billions promoting this name and somehow they are threatened by a tiny organization that has nothing to do with computers?" questioned the Foundation in their response letter. The Foundation also told Intel to 'chill out', and suggested that Intel's attorneys were in need of yoga classes (or some other form of meditation) themselves. Intel, who offers free yoga classes to its employees at its headquarters in California, was not amused, and has come to your law firm for assistance.

The senior partner at your law firm has asked you for a comprehensive memo detailing the claims available to Intel in a legal action it wants to bring against the Foundation in a federal district court under the Lanham Act. The memo should also identify both the defenses you believe that the Foundation will likely raise to Intel's claims, and how Intel will try to overcome those defenses.

Question 2

(Question 2 is worth 30 points. Recommended time: 50 minutes.)

While driving on the freeway to Sacramento, Mark, a self-proclaimed 'health food nut' who only eats foods he determines are healthy for his body, saw a sign that said, "New Avojelly – get yours today! Sold only at John's Jelly Store, at exit 8." Mark sighed, and said aloud, "if only they had something that I could eat there, but they just make jelly... with all those chemicals and processed sugar, that's not healthy!" Mark is meticulous about only eating healthy, non-processed foods, as he is a volunteer spokesperson for the Organic Food Council, a non-profit organization that promotes the benefits of organic food.

A mile further down the freeway, Mark saw a second sign for John's Jelly Store that had a picture of a jar of Avojelly next to a dozen avocados – some whole, some cut open, and some growing on a tree - with the words: "New Avojelly! Fresh! Green! Get yours today!"

"Well, who knew?" exclaimed Mark. "Apparently, Avojelly IS healthy! I've never heard of jelly being made from avocados, but it must be – the sign shows at least a dozen fresh ones on it!" Mark pulled off the freeway at John's Jelly Store, and gorged himself on many samples of Avojelly. He even bought a case for himself and few extra jars of Avojelly to share at his next Organic Food Council meeting. He brought the jars to the meeting, and told everyone of his new, yummy discovery. His announcement was met with surprise and shock from his fellow Council members, who pointed out the ingredients list written in small print on the bottom of the jars, which showed that Avojelly was purely a green chemical mixture with no real avocado in it.

Mark received a letter the next day informing him that the Organic Food Council would no longer be needing his services as a spokesperson for their organization.

Mark has now walked into your office very unhappy (and a few pounds heavier), and says, “I loved being the spokesperson for the Organic Food Council, and I would still have that honor if it weren’t for those liars at John’s Jelly Store. You’re a good lawyer, you went to Golden Gate University – what can I do??”

What advice would you give Mark? Your essay should include his options, including any potential causes of action (and against whom), and the likelihood of his success on those causes of action. (NOTE: Only discuss advice in the context of the subject matter of this Trademark Law class, i.e. do not discuss any employment or contract issues that may be implicated.)

END OF ESSAY QUESTIONS

END OF EXAM

Have a good summer!