

**FINAL EXAMINATION
INTELLECTUAL PROPERTY LAW SURVEY
PROFESSORS BOB MORRILL AND WILLIAM GALLAGHER
SPRING 2006**

1. You have **three (3) hours** to complete this exam.
2. This is an **open** book exam. You may use any written materials.
3. This exam consists of three (3) essay questions. You are not required to spend the entire time working on the exam; the average time for completion is between two and three hours. You should outline your response to each question, before writing the response. We recommend that you spend one third of the time you spend on each question creating your outline, and the remainder of your time writing your answer. For example, if you spend 1.0 hour per question, devote 20 minutes to the outline, and 40 minutes writing the answer.

Question 1: 33 points

Question 2: 33 points

Question 3: 34 points: (Part A, 10 points / Part B, 8 points / Part C, 16 points)

4. Please answer these questions in the blue books provided to you. Write only on the right hand side of the page (skipping a page each time) and double-space your work. Please write legibly.
5. Question 3 pertains to patent law. This question will be graded by Adjunct Professor Morrill. **YOU MUST ANSWER THE THIRD (PATENT) QUESTION IN A SEPARATE BLUE BOOK AND WRITE PATENT QUESTION ON THE BLUE BOOK COVER.** If you need more than one blue book to answer Question 3, each blue book you use must be labeled Patent Question.
6. Write your **exam number** on your exam envelope. Put student exam # at the top of this page, each page of questions, and each blue book. **Do not** use your name, student ID number, Social Security Number, or in any other way identify yourself on any exam materials.
7. At the conclusion of the exam, return all exam materials to the exam 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!

QUESTION NO. 1 (33 points):

Your client, Karen, came up with the idea for a new cookbook with recipes from various parts of the world. Part of her idea was to include a discussion of local geography, customs, and culture relevant to the particular recipes she would include in her book. Karen selected and arranged her favorite recipes from three areas of the globe: the Mediterranean, South America, and Northern Africa. Karen decided that her cookbook should be titled *Global Eats*. Before she wrote any of her ideas or recipes down, Karen discussed in detail her ideas for the cookbook with Brian, a former chef she was acquainted with and whose opinions Karen valued.

Three months after speaking with Brian, Karen wrote a draft of her cookbook, exactly as described to Brian. Karen did not register her book with the US Copyright Office. While she was trying to interest a publisher into publishing and promoting her proposed cookbook, Karen saw that Brian had recently published a new cookbook that was very similar to Karen's. His cookbook contained recipes from Brazil, Greece, and Morocco, and it contained descriptions of each of these countries local geography, culture, and customs. At least 20 recipes in Brian's book are identical to recipes that Karen had used in her book, and they were generally presented in Brian's book in the same order as in Karen's. Brian's book was titled *Eating Globally*.

Karen wants to bring legal claims against Brian for stealing her book idea. She has specifically asked you to tell her (1) whether she has any claims against Brian for his use of her cookbook concepts, and (2) whether she has any claims against Brian for copyright infringement of her cookbook draft. What do you tell her? Be sure to discuss what claims might be available, what defenses might be available, and whether you believe Karen will be successful against Brian for any of her claims.

END OF QUESTION # 1

QUESTION NO. 2 (33 points):

You have been asked to represent a new client, Believers Against Repulsive Fatty Foods (BARFF). BARFF is an activist organization that seeks to educate consumers about the deleterious effects that fast food has on the nation's health and what it believes is the unnecessary cruelty animals used for fast food undergo in factory farms.

BARFF has recently produced and shown a nationwide television commercial that depicts an obese Ronald MacDonald - a clown-like character made famous by the MacDonald's hamburger chain, which has used Ronald MacDonald as a company symbol for decades chasing after a scared cow with an axe in what looks to be a MacDonald's food processing plant (the commercial uses a 20-foot mock version of the famous MacDonald's golden arches as a backdrop to its commercial, and there are visible MacDonald's logos throughout the fake processing plant depicted in the commercial). At

the end of the commercial, an actor who looks remarkably like actor Arnold Schwarzenegger in his famous role from The Terminator movies, comes on the screen, shoots the Ronald MacDonald character with an assault rifle, and says in a thick Austrian accent, Let's Terminate our Unhealthy and Inhumane Fast-Food Culture!

After seeing this commercial, MacDonald's has sued BARFF for trademark infringement and trademark dilution. Additionally, BARFF has been sued by Arnold Schwarzenegger for violating his right of publicity. BARFF has asked you to analyze the merits of each of these legal claims, including analysis of any potential defenses it might raise, as well as your assessment of the likely outcome for each claim. What do you say?

END OF QUESTION # 2

QUESTION NO. 3 Patent Law Question (34 total points) (Please note that there are three subparts to this question, with points indicated for each subpart).

[Please note that parts of the patent law are attached to the end of this examination should you wish to use it.]

Jacob W. Davis had a tailor shop in Reno, Nevada during the 1870s. Part of Jacob's business, and not the most enjoyable part, was repairing the pockets in the pants of the local miners and ranchers. The seams below their pockets would often split due to pressure on the thread from tools, rock specimens, etc. being carried in the pockets, and Jacob would have to sew the seam back together.

In early 1872 Jacob became aware of U. S. Patent No. 123,313, issued to Lucius K. Washburn on January 30, 1872 for a method of making more durable slippers. The Washburn patent described how to make a more durable slipper by using a metallic rivet. Figure 2 from the Washburn 313 patent, reproduced below, shows how the rivet, C, is used to help fasten the toe, B, to the sides of the shoe, A, along seam a, at the point of maximum stress.

Jacob recognized that rivets could also be used to make a more durable pair of pants by reinforcing the pocket openings. Jacob was also familiar with the use of rivets to attach large pieces of canvas cloth together to make tarps and tents. Unbeknownst to Jacob, or to anyone else in the United States, farmers in Chile had been using rivets to reinforce the pocket openings in their pants in the same way since 1869.

Jacob did some experimenting and found that pants with rivet reinforcing on the pockets were indeed far more durable than pants with pockets sewn only with thread. Jacob

applied for a patent on his invention on August 9, 1872, and U. S. Patent No. 139,121 entitled Improvement in Fastening Pocket-Openings issued to him on May 20, 1873. His patent contained one claim, as follows:

1. A pair of pants having the pocket-openings secured at each edge by means of rivets fastened in the seam of said pants so as to bind the two parts of cloth which the seam unites together, so that the rivet prevents strain or pressure from coming upon the thread with which the seam is sewed, whereby the seams at the edges of the pockets are prevented from ripping.

The figure in the 121 Davis patent is reproduced below. In the figure, A is the side seam of a pair of pants, and b represents the rivets at each edge of each pocket opening.

Jacob Davis was very successful in selling pants reinforced as described in his patent. He granted a license to his invention to Levi Strauss & Co, who was even more successful in selling the patented pants, so much so that such pants came to be known as Levis. Since it had a license, Levi Strauss & Co. was selling the riveted pocket pants with Davis's permission.

Although the facts in this question are over 130 years old, please assume that current U.S. patent law applies in answering the following questions.

Part A. 10 points.

Please analyze any possible issues which the above facts raise as to the validity of the Davis 121 patent under sections 102 or 103 of the patent law. Discuss each possible item of prior art. Be sure to give the arguments for and against validity.

Part B. 8 points.

Jacob Davis's new patented riveted pants were popular and became widely known in the western United States. A number of other tailors began making pants, without a license or permission from Davis, that came within the claim of the patent. An enterprising hardware merchant, Thad Pritchard, saw that these tailors would need rivets. Thad began special promotions on rivets, and advertised in newspapers that his rivets could be used to make the popular new pants with riveted pocket openings. The rivets which Thad sold, however, were ordinary rivets which he had in stock long before Jacob's invention.

Is Thad an infringer of the Davis 121 patent? Please discuss each possible theory of infringement which applies to Thad.

Part C. 16 points

A tailor in Los Angeles, Samuel Foust, saw a pair of Davis's riveted pants, made according to the claim of the Davis 121 patent, and decided to go into business making them. Although both Davis and Levi Strauss & Co. had marked every pair of pants which

they sold with the number of the Davis 121 patent, the pair which Foust happened to see had had the patent information ripped off. Foust had no idea that the riveted pants were patented.

Business was brisk, and Foust sold 10,000 pairs of riveted pants in each of 1874 and 1875. At the end of 1875 he received a letter from Davis's lawyer, informing him of the Davis 121 patent, enclosing a copy, and telling him that he certainly infringed. After chatting with a patent lawyer at a cocktail party for fifteen minutes, Foust concluded that the Davis 121 patent was invalid, and so kept making the pants in 1876, during which year he sold another 10,000 pairs.

At the end of 1876, Davis sued Foust for infringement of the 121 patent, and won the case about a year later. Levi Straus & Co. was not a party to the suit. The evidence at trial showed that Foust sold his pants for \$6.00 per pair (of which \$1.00 was profit), and Davis and Levi Strauss & Co. sold theirs for \$7.00 per pair (of which \$2.00 was profit). Davis had the capacity to make 1,000 more pairs of the riveted pants per year. Levi Strauss & Co., which had much greater sales than Davis, could have made 10,000 more pairs per year.

What remedies should Davis seek from Foust? Please discuss whether or not each remedy you consider is available to Davis.

END OF EXAM

SELECTED PORTIONS OF

TITLE 35 UNITED STATES CODE

CHAPTER 10 PATENTABILITY OF INVENTIONS

102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent . . .

(f) he did not himself invent the subject matter sought to be patented, or

(g) . . . before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

103. Conditions for patentability; non-obvious subject matter.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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CHAPTER 28 INFRINGEMENT OF PATENTS

271. Infringement of patent.

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

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CHAPTER 29 REMEDIES FOR INFRINGEMENT OF PATENT, AND OTHER ACTIONS

281. Remedy for infringement of patent.

A patentee shall have remedy by civil action for infringement of his patent.

282. Presumption of validity; defenses.

A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. . . . The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement or unenforceability,

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,

(4) Any other fact or act made a defense by this title. . . .

283. Injunction.

The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.

284. Damages.

Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed. Increased damages under this paragraph shall not apply to provisional rights under section 154(d) of this title.

The court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances.

285. Attorney fees.

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

286. Time limitation on damages.

Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action. . . .

287. Limitation on damages and other remedies; marking and notice.

(a) Patentees, and persons making, offering for sale, or selling within the United States any patented article for or under them, or importing any patented article into the United States, may give notice to the public that the same is patented. either by fixing thereon the word patent or the abbreviation pat., together with the number of the patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.

END OF SELECTED PORTIONS OF PATENT LAW