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I. INSTRUCTIONS

A. *Generally Applicable Instructions*1. *Conventions*

By convention, these instructions use the word “examination” to refer to this document. The word “exam” refers to the event of taking this test, as in “exam room” “exam taker” or “exam time.”

2. *Identification*

Identify yourself only by your personal identification number as set forth below. Do not identify yourself in any other fashion.

If you are an L.L.M. student, write “LLM” after your personal identification number.

a. Bluebook Exam Takers

- (i) write your personal identification number on the cover of *each* of your bluebooks; and
- (ii) write your personal identification number on the top right-hand corner of the cover page of this examination and on *every* page of the examination problem itself (*but not* on these eight preliminary pages i to viii).

In addition, write the number given on the cover page of this examination on the cover of *each* of your bluebooks.

b. Typing Exam Takers

- (i) type your personal identification number in a prominent place on the first page of the typed answer;
- (ii) write your personal identification number on the top right-hand corner of the cover page of this examination and on *every* page of the examination problem itself (*but not* on these eight preliminary pages i to viii); and
- (iii) if the exam taking software allows you to insert a page break, *when you begin your analysis for a new area of law, insert a page break*, and then type your personal identification number at the start of the new page; otherwise please skip (or “hard return”) approximately six lines and then type your personal identification number and begin the analysis.

In addition, type the number given on the cover page of this examination in a prominent place on the first page of the typed answer.

3. *Prohibited actions: copying, reproducing, or memorializing this examination; or taking this examination from the exam room*

I have not determined whether I will make this final examination available to students in the future. Accordingly, I am prohibiting this examination from release. It is an honor code violation to take any action designed or intended to cause all or any portion of this examination to be released. ***Copying, reproducing, or memorializing this examination or any of its contents in any form or fashion will be treated as a violation of the Honor Code and will be penalized accordingly. Taking notes about any portion of this examination is expressly prohibited under this rule.***

4. *Hand-Writing Your Answer*

Write legibly. I cannot grade what I cannot read. Skip every other line and write only on the right side of the page (i.e., skip every other page). You are only permitted to submit what you have written in the exam room during the exam time. Previously-drafted attachments of any sort may not be submitted for grading.

Number your bluebooks consecutively on the outside cover of the bluebook, i.e., “1” for the first bluebook, “2” for the second, and so on.

5. *Typing Your Answer*

You are permitted to type your answer to the examination. If allowed by the capabilities of the exam taking software, double space your answer. Also, type only on one side of the page. You may not use the memory capabilities of your typewriter or computer in any manner.

For students typing their answer on a computer, the student is responsible for compliance with the various technical requirements and mechanics for using the exam taking software, Examssoft. In particular, the student is presumed to be on notice of all information available under the links at the web page maintained by the Law Center’s information technology department:

<http://www.law.uh.edu/lit/exams/examssoft/examssoft.htm>

In particular, students should review carefully the Frequently Asked Questions (FAQ) list posted at this web address. I am not undertaking any action to be in a position to provide any assistance with Examssoft.

6. *Materials Allowed*

This is an “open materials” exam. You may use class notes or outlines (prepared by yourself or others), commercial outlines, and other similar materials. You may not communicate or collaborate with anyone during the exam about the examination or obtain direct or indirect information or assistance from any person; except for questions to the professor in the case of a severe discrepancy, defect, issue or similar problem with the examination. You may not receive any assistance from any live or electronic retrieval/computer source during the exam. You may not do any library research or access the internet once the exam has begun.

Students writing the exam by hand are not allowed to use their computers for any purpose during the exam. Students typing the exam using the Law Center’s sponsored exam-taking software may only use their computers to run such software.

7. *Collection of Examinations and Materials*

The examinations, bluebooks, and scratch paper will be collected at the end of the designated time. ***You will not receive a grade in the class unless you turn in:***

- (i) your entire examination with your personal identification number written on the top right-hand corner of the pages indicated above;
- (ii) your bluebooks with your personal identification number and examination number written on the cover of each bluebook, ***or*** your typed answer with personal identification number and examination number typed in a prominent place on the first page of the typed answer; and
- (iii) ALL scratch paper that you have used.

Scratch paper will neither be read nor graded. Nevertheless, you must turn in ALL of your scratch paper at the completion of the exam. You MAY NOT leave the exam room with any scratch paper that you used. You may mark on the examination itself.

a. Those Hand-Writing their Answer

Assemble your materials for collection by ordering your bluebooks sequentially, then place all scrap paper or other materials beneath the bluebooks, and then take the bluebook from the top of the stack, open it, and tuck all the other materials (including the examination) inside the first bluebook.

b. Those Typing their Answer

I will provide 8.5 x 11 inch envelopes for typing exam takers. Place all scrap paper, the examination, and the floppy disk inside the 8.5 x 11 inch envelope. Close the envelope with the metal clasp, but do not wet the adhesive. ***Write your personal identification number on the outside of the 8.5 x 11 inch envelope.***

8. *Restroom*

You may leave the exam room to visit the restroom. If you leave the exam room, you must leave your examination, any scrap paper, and your bluebooks with the proctor. If the proctor is not present, you must leave your examination, any scrap paper, and your bluebooks on the desk at the front of the room. You may not discuss the examination with anyone or consult any materials while you are out of the exam room.

If you leave the exam room, you must exercise a very high standard of care in exiting and entering the room in order to minimize disruption and noise that will distract other students.

9. *Makeup Exams*

Because certain members of the class may be taking a makeup exam, it is a violation of the Honor Code to discuss this examination with any class member who has not yet taken it. Do not discuss this examination with any students not in this class until after the makeup exam period is over. Do not discuss this examination with any student in the class without first asking such student whether he or she has taken the exam. Abide by the Honor Code in this and in all other particulars.

10. *Compliance*

Failure to follow any of the directions provided with this examination will result in such penalty as I deem appropriate to the nature and degree of the violation. ***The spirit of these instructions will be enforced as well as their letter.***

11. *Pledge*

In placing your identification number on your bluebook covers or typed answer, and on the examination pages, you are pledging that you have not received or given any unauthorized aid in preparing for or taking this examination or violated any of the instructions given here. Such behavior is grounds for the imposition of a variety of sanctions, including expulsion from law school.

B. *Instructions Specific to this Particular Exam*

1. *Structure*

The final examination is designed to be two hours in length. It consists of one integrated fact pattern and an assignment from a law firm partner relating to that fact pattern.

2. *Suggested Time Allocation*

The emphasis of this examination is roughly proportional to the emphasis of the four areas of intellectual property law covered in class. Our class coverage by time is approximately: fifteen percent (15%) trade secrets; thirty percent (30%) patents; thirty percent (30%) copyright; and twenty-five percent (25%) trademarks. ***For a two hour final, if one takes twenty minutes to read the problem and plan the answer, then one would spend the remaining time as follows: 15 minutes writing the trade secret answer, 30 minutes for patent law, 30 minutes for copyright, and 25 minutes for trademark.***

3. *Materials Needed*

To take this examination, you may/will need a copy of the assigned casebook and supplement. I also recommend that you have a dictionary. Bluebook exam takers will also need a pen and bluebooks.

According to the Examssoft FAQs, typing exam takers should also have bluebooks and writing instruments as a backup mechanism in the case of technical difficulty.

4. *Applicable Law*

The law applicable to this examination is the law covered in this class from: the assigned reading from the casebook and supplement, the primary statutory provisions relating to the assigned reading materials, and the law provided in the class overheads (collectively, the “Materials”). Be sure to answer all questions on the basis of the law provided in the Materials.

There are some situations where the Materials provide alternative rules or tests for resolving a specific legal issue. In these instances, except for trade secret issues (see below) the “majority” rule is the rule or test relied on by the majority in a primary case in the casebook/supplement. Any other different tests or rules, whether mentioned by the majority opinion, offered in a dissent, described in the notes to the case, or given in the overheads, are alternative or “minority” rules. Please note that for a small number of issues the overheads give additional law beyond that provided in the casebook/supplement. This instruction does not necessarily mean that issues exist in this examination requiring the application of alternative or minority rules. Nor will it always be necessary to analyze any or all such alternative or minority rules depending on the facts provided.

With respect to trade secret issues, the provisions of the Uniform Trade Secrets Act (“UTSA”) are the “majority” rule, whereas the law in the Materials based on the common law of trade secrets, derived primarily from the Restatement, when different, is the “minority” rule. However, the common law cases are strong persuasive authority for the UTSA majority rule.

5. *Recommendations for Exam Taking*

Grades for this examination will be based upon both the correctness of answers and the quality of discussion, including articulating arguments on both sides of an issue. ***Issue spotting is important to your performance.*** Many, but not necessarily all, of the facts in the examination problem(s) are relevant to an issue arising under the examination's fact pattern. References to relevant primary statutory provisions and cases will be marginally beneficial, but only if the reference is correct. ***Even more important than citing a source for a rule, is to correctly state the rule that you apply to an issue.*** Similarly, take care to correctly recite the problem's facts that you use in your answer – misstating the given facts increases the difficulty of awarding partial credit.

Plan out your answers, at least briefly, before you start to write, so that they are clear, well-organized, and succinct. Relevancy of discussion is more important than length of discussion - although the examination will be time-pressured and factually dense, the best answers are not necessarily those that contain the longest discussion. On the other hand, it is to your benefit to demonstrate your reasoning, especially in order to allow me to account for partial credit when only part of the analysis of an issue, test or rule is correct. Stick to the problem's facts and be judicious and even-handed in the factual inferences you draw. Write your answer based on the problem's facts, not based on an alternative hypothetical set of facts of your own creation.

Abbreviations can be useful when writing an exam answer because they save time and allow one's thoughts to not be interrupted writing a long phrase such as "person of ordinary skill in the art." Writing POSITA is much more efficient. However, students should be careful in use of abbreviations. They should always be defined on the student's answer. They should not be overused. The best choice for any abbreviation is one that you know the professor is familiar with, say, for example, because the professor used the abbreviation in overheads, in the examination, in a model answer, or in some other writing.

Budget your time to discuss and resolve the most prominent issues arising under the facts. It is better to ensure that you cover all the major issues before spending time on minor issues or minority rules. The discussion of issues raised by this examination should roughly approximate the percentage of time spent covering each area of intellectual property. Budget your time accordingly.

6. *Use a new BlueBook (or, if typing and allowed by the exam taking software, insert a page break) before your analysis of each area of IP*

The problem in the examination requests that your answer be organized by area of intellectual property law in the following order: trade secret, patent, copyright, trademark. However, ***this does not mean that you must work on the four areas in that temporal order.***

Start a new bluebook before beginning your analysis of each area. Remember to put your personal identification number on the cover of the bluebook.

If the exam taking software allows you to insert a page break, ***when you begin your analysis for a new area of IP law, insert a page break***, and then type your personal identification number at the start of the new page. If the exam taking software does not allow you to insert a page break, please skip (or "hard return") approximately six lines and then type your personal identification number and begin the analysis for the next area of law.

7. *Notation used for claim amendments*

If the examination discusses an amendment to a patent claim, it will use the following notation to describe the amendment: additions are in double underline and deletions are in ~~strikeout~~. For example, assume a patent's claim one states: "a widget comprising: a green base and three legs". The inventor wants to amend the claim to cover a blue base with four legs. The amended claim would appear as follows: "a widget comprising: a ~~green~~blue base and ~~three~~four legs".

8. *Even if you do not read all of the "Background" and "Dispute" sections before starting to write, it is **strongly recommended** that you read the "Assignment" section before you begin your work*

No matter what you do, please read the "Assignment" section before you begin writing.

Further, it is **highly recommended** that you read the "Assignment" section first before reading the "Background" and "Dispute" sections of the examination.

9. *Starting and Stopping the Exam*

Excluding the cover page, there are eight (i - viii) preliminary pages to this examination. The actual examination problem(s) section has ____ (____) pages.

Without looking at the content of the examination problem(s), please count your pages now to ensure that your examination is complete. If not, notify the proctor immediately.

"Warning" that the end of the exam period is approaching will be given by the proctor writing on the blackboard in the exam room(s) the amount of time remaining at approximately the five minute mark.

When time is called, stop writing immediately.

DO NOT TURN THE PAGE UNTIL YOU ARE INSTRUCTED TO DO SO.

II. FINAL EXAMINATION

A. *The Background*

Glenda Glow owns a factory that molds high-strength plastic handles for heavy-duty staplers. Molding machines in Glow's factory produce the plastic handles. Glow markets her handles to stapler manufacturers under the incontestable Federally registered mark BestLever[®]. Glow's handles are also famous with the manufacturers, as well as with the ultimate consumers, because they glow in the dark and for their unique "swan-neck" shape. Glow recently received a federal trademark registration for the "swan-neck" shape as a mark for her handles.¹

When Glow's molding machines eject a molded handle there are burs² on it. Glow's competitors remove the burs, i.e., debur, with a grinding wheel. Glow uses a different process to remove burs: directing a high-pressure "jet" of mixed air and sand at the bur. The sand is made from Japanese coral. Glow's coral sand air jet process ("CSAJP") is less expensive per handle than grinding and produces a better finish due to the unique properties of the coral sand. Glow located the CSAJP in an internal room in her factory. The room has doors with locks, glass windows and an internal roof. The windows are covered on the room's outside by opaque³ material. Coral sand is flying around in the air jet room. Glow removes practically all of the sand from the air jet operators and the debured handles before they exit the room. However, the operators disperse some coral sand to other areas of Glow's factory when walking around.

A few molding experts noticed the debur finish of Glow's handles. They obtained samples and discovered residue of a sandy substance. The experts have not identified the sandy substance with standard tests and are undecided whether to employ more expensive and complex tests. They have, however, correctly concluded that an air jet was used to direct the sandy substance to debur the handles. The experts also note that Glow's "swan-neck" shape optimizes the molecular coordination of every type of plastic used for stapler handles, meaning that the "swan-neck" shape provides a higher quality handle for less cost because it can use less-dense plastic.

Glow has a U.S. patent on a molding machine component. As originally filed, claim one is as follows: "a pre-mold comprising: an inner cavity; an outer cavity; means for allowing passage of a substance into the outer cavity; and a barrier separating said inner cavity and said outer cavity, said barrier made of heat-conductive material." The description and drawings in Glow's patent show a round hole on the top of the outer cavity. The PTO rejected claim one as: (i) anticipated by a prior art patent to Mr. Jones ("Jones"); and (ii) obvious in light of a prior art patent to Ms. Handy ("Handy") in view of Jones. The Jones embodiment met all the elements/limitations of Glow's claim one with the Jones barrier being a wall made of heat-conductive ceramic material. In response to the PTO's rejection, Glow amended claim one as follows, with additions in double underline and deletions in ~~strikeout~~: "a pre-mold comprising: an inner cavity; an outer cavity; means for allowing passage of a substance into the outer cavity; and a barrier separating said inner cavity and said outer cavity, said barrier made of ~~heat-conductive material~~ metal A, B,

¹ Very long ago, in some litigation, Glow disclaimed and disavowed any copyright protection in the "swan-neck" shape.

² bur: a rough edge or area remaining on material after it has been cast, cut, or drilled.

³ opaque: impenetrable by light; neither transparent nor translucent.

or C, and said barrier having a heat transfer index of approximately forty to sixty.”⁴ In submitting the amendment to the PTO, Glow remarked that Jones disclosed a heat transfer index of less than forty and Handy disclosed a heat transfer index of sixty-seven or greater. Glow made no other comments about the amendments but did argue that amended claim one was not obvious. The PTO then allowed Glow’s patent to issue.

Periodically, Glow’s factory managers create and post a list of the top twenty most efficient molding machine operators. They list the most efficient operator at the top and arrange the list by decreasing efficiency. John Fettle, an employee at the factory, usually takes each newly posted list and creates a large poster on opaque material. He does this on his own initiative, but while at work, and with the acquiescence of the factory managers. Fettle uses some of his own supplies and some company supplies, but does some of the work at home during evenings and weekends. The poster locates the list in the middle, but Fettle adds to the right of each name a quote he obtains from each listed operator. Around the outer edge of the poster, Fettle places a border around the names and quotes. The border is a collage made from (i) photographs Fettle took showing the Glow factory, and (ii) graphics and abstract pastel color sketches created by Fettle during his lunch hours at work. Fettle typically makes several full-size copies of the poster and displays them at various locations around the factory.

Brian Slick is a sales person for a company that supplies raw plastic to Glow. There is another factory in Slick’s sales territory that competes with Glow (the “Competitor”). Slick’s girlfriend’s brother owns the Competitor’s factory. Several months ago while in the lunch room of Glow’s factory, Slick notices Fettle’s poster on the wall. He decided to take the poster in order to show it to his girlfriend’s brother – thinking such a poster would help improve employee morale for the Competitor. The lunch room was empty at the time, so Slick took the poster from the wall. After doing so, he was surprised to find a window behind the poster. Looking through the window, he saw Glow’s CSAJP. Luckily for Slick, he noticed a spare copy of Fettle’s poster behind a cabinet in the lunch room. He put the spare copy on the wall so it covered the window before anyone in the air jet room or lunch room noticed his actions. Slick left the factory with the poster and went home, unable to forget what he saw in the air jet room. The particular poster Slick took listed Fettle at the bottom of the efficiency list. Instead of a quote, Fettle had authored a four-line “Ode to Molding” poem for his entry in the list. That night Slick noticed a small amount of sand on his shoes. Upon close inspection, Slick recognized it as the sand from the air jet room and that it was made from Japanese coral. Slick is a self-taught expert in Japanese coral from vacations spent scuba diving near Japan.

B. *The Dispute*

Glow recently noticed a new Competitor product marketed under the new name BestEver™ handles. This new Competitor product has a dramatic improvement in debured finish. Glow analyzes Competitor’s new handle and discovers that the handle has coral sand residue. Glow sues Competitor for trademark infringement and trade secret misappropriation and during discovery the following additional facts are discovered:

- (i) Competitor is using the CSAJP exactly as Glow’s factory uses it;

⁴ A person of ordinary skill in the relevant art (“POSITA”) understands the properties of materials A, B and C and understands the measurement entailed to determine a “heat transfer index.”

(ii) Slick sold the idea for the CSAJP to Competitor, telling Competitor how he discovered the CSAJP at Glow's factory;

(iii) Mr. Jones briefly worked for Competitor several years before his patent issued; while with Competitor he built a prototype pre-mold device that was exactly the same as the embodiment disclosed in the Jones prior art reference except that instead of a ceramic wall the prototype had a wall made of metal C with a heat transfer index of forty-one; Competitor briefly used the prototype in its manufacturing processes;

(iv) Competitor's molding machines have a pre-mold device called "Model One" with an inner cavity, an outer chamber with a round hole on top, a wall between the inner cavity and outer chamber, the wall being made of metal C having a heat transfer index of sixty-five;

(v) Competitor has built another pre-mold, called "Model Two" that is exactly the same as Model One except that its wall has a heat index of fifty and is made of a recent surprise discovery in metallurgy, metal D, which has the same thermal properties as metal C and performs the function of the wall similarly to metal C;

(vi) Competitor has posters in its factory arranged similarly to Fettle's poster, listing Competitor's operators by decreasing efficiency, without any quotes, but with a border of photos of Competitor's plant and public domain graphics, but not including any of Fettle's graphics or sketches;

(vii) When running the machinery, Competitor's operators wear protective bibs purchased from Slick that have some of Fettle's abstract pastel sketches printed on them in black and white "grayscale" tones, and Fettle's "Ode to Molding" poem printed on top of the sketches; operators have commented that they like the bibs in part due to the poem;

(viii) Slick donates all profits from sales of the bibs to the non-profit Organization of Injured Molding Machine Operators ("OIMMO"), but his sales of raw plastic has risen dramatically since he began underwriting this benevolent cause;

(ix) Competitor has a marketing brochure promoting its handles that says "our handles provide the best leverage in the stapling business" and says "we glow with quality;"

(x) Since before Glow entered the stapler handle business, Competitor has been selling a paper weight under the name HighWater SwanTM in the state of Alaska, but only in Alaska until last month, when it began selling in Florida; Competitor's customers in Alaska have come to know the paper weight by its swan-neck shape, which is exactly the same shape as Glow's handle; and

(xi) Competitor has just prepared for network television, but not yet aired, a short video commercial showing a darkened bathroom with Glow's handle attached to a toilet tank where the traditional flushing handle would go, the Glow handle glowing in the dark, with a voice-over saying "Competitor stapler handles flush the lights out of the Glow handles" while a hand pushes down the Glow handle to flush the toilet, and after the flush the Glow handle's emanating light flickers out as mood-depressing music plays.

C. *The Assignment*

You are an associate in a law firm representing Glow. To amend the complaint to respond to the additional facts uncovered thus far in discovery, the partner wants an informative memo, ***based only on the law from your Fall 2002 IP Survey class***, that does the following as briefly as possible: (i) discusses all the claims Glow should bring or consider bringing against Competitor ***and/or Slick*** (the partner recommends referring to them collectively, when appropriate, as the “Defendants”), including any claims Glow may have brought in the original complaint; (ii) evaluates the legal basis of each claim from Glow’s perspective and Competitor or Slick’s perspective, articulating defenses and counter-arguments Competitor or Slick might assert; (iii) assesses the strength of each party’s arguments; and (iv) determines for each issue who is likely to prevail and explains why.

Since discovery is ongoing, if there are any additional critical facts that would materially impact the outcome of a particular issue, the partner would like you to note what such facts would be. In such case, briefly describe how such critical facts might impact the outcome, i.e., indicate the differing results that would ensue from different reasonable factual assumptions.

The partner would like the memo organized by area of intellectual property law in the following order: (i) trade secret law; (ii) patent law (discussing any invalidity issues before any infringement issues); (iii) copyright law; and (iv) trade mark law. This requirement is only for the organization of your memo – it is perfectly fine with the partner if you prefer to work on the four areas in whatever temporal order suits you.

The memo does not need a general introduction. The partner would like you to proceed immediately to analyzing the issues. The location of final jurisdiction and/or venue for the expected trial is unknown at this time, except that it will be in federal court. Thus if there are any relevant and significant outcome-determinative differences in majority/minority rules, the partner would like these briefly noted and briefly analyzed if the facts are available to do so.

In the patent section of the memo, the partner would like you to analyze infringement issues even if your memo determines that claim one of Glow’s patent is invalid. Similarly, for trademarks, even if your memo determines that a mark is not protectable, analyze any infringement issues that may exist. Also, in the copyright section, the partner would like you to analyze Glow’s arguments as if Glow and Fettle are joined as plaintiffs, i.e., were a single entity, i.e., assuming Glow can assert all Fettle’s rights, and ignoring joint authorship issues or the need to register any existing copyrightable work(s) before adding such potential copyright claims to the suit. However, for copyright, when evaluating Competitor and Slick’s defenses, evaluate with the following possibility in mind: due to his philosophical inclinations, there is a significant risk that Fettle will be unwilling to join the suit as a plaintiff. In other words, what additional defense(s) might Defendants argue if Fettle is not in the suit?