

INTERNATIONAL IP FINAL EXAMINATION

PROF. GREG R. VETTER

FALL 2004

Greg R. Vetter
University of Houston Law Center
Office: (713) 743-3596
Cell: (713) 213-0360
gvetter@uh.edu

December 14, 2004

9:00 a.m. to noon

Examination No. _____

GENERALLY APPLICABLE EXAM INSTRUCTIONS TABLE OF CONTENTS

I. EXAM INSTRUCTIONSI

A. Instructions Applicable to the Administration of My Exams..... i

1. Conventions.....i

2. Identification.....i

 a. Bluebook Exam Takers..... i

 b. Typing Exam Takers..... ii

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

4. Hand-Writing Your Answer.....ii

5. Typing Your Answer.....ii

6. Materials Allowed.....ii

7. Collection of Examinations and Materials – Via 8.5 x 11 Inch Envelopesiii

 a. Those Hand-Writing their Answer..... iii

 b. Those Typing their Answer..... iii

 c. I Perform a Post-Exam Inventory of the 8.5 x 11 Inch Envelope’s Contents..... iii

8. Restroom..... iv

9. Makeup Exams iv

10. Compliance..... iv

11. Pledge..... iv

B. Instructions Generally Applicable to Writing Answers for My Examinations..... v

1. Materials Needed v

2. Applicable Law..... v

I. EXAM INSTRUCTIONS

A. *Instructions Applicable to the Administration of My Exams*

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 *the last* page of the examination problem itself.

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

GENERALLY APPLICABLE EXAM INSTRUCTIONS

b. Typing Exam Takers

- (i) type your personal identification number in a prominent place on the first page of the typed answer; and
- (ii) write your personal identification number on the top right-hand corner of the cover page of this examination and on *the last* page of the examination problem itself.

In addition, type the examination serial 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(s) maintained by the Law Center’s information technology department related to use of the exam taking software. Please realize that I am not undertaking any action to be in a position to provide any assistance with the exam taking software.

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

GENERALLY APPLICABLE EXAM INSTRUCTIONS

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 – Via 8.5 x 11 Inch Envelopes*

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 serial number written on the cover of each bluebook, ***or*** your typed answer with personal identification number and examination serial 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.

I will provide 8.5 x 11 inch envelopes for exam takers. Use the envelope to turn in ALL your materials, including all of the examination, your answer, and any scratch paper.

a. Those Hand-Writing their Answer

Assemble your materials for collection by ordering your bluebooks sequentially, then place all scrap paper or other materials and the examination beneath the bluebooks. Place this stack 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.***

b. Those Typing their Answer

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.***

c. I Perform a Post-Exam Inventory of the 8.5 x 11 Inch Envelope's Contents

As soon as practically possible after collecting the examinations, I cause administrative assistants to perform an extensive inventory process to ensure that all original examinations have been returned. If you discover that you have inadvertently kept some materials contrary to these instructions, get in touch with my administrative assistant immediately. Do not contact me personally because that creates the possibility of you losing your anonymity.

On the flip side, if in the inventory process we discover that a particular exam taker did not turn in the examination or some portion of it, this creates a potentially grave situation, especially if we cannot communicate with you to inquire about the situation. My administrative assistant would attempt to get in

GENERALLY APPLICABLE EXAM INSTRUCTIONS

touch with you in this instance. Thus, it is important to pay attention to your regular communication channels even though you may be undertaking other exam preparation.

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 personal identification number on your bluebook covers or typed answer, and on the examination pages, and by writing and turning in an answer to this examination, 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.

GENERALLY APPLICABLE EXAM INSTRUCTIONS

B. Instructions Generally Applicable to Writing Answers for My Examinations

1. Materials Needed

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

Computer software typing exam takers should also have bluebooks and writing instruments as a backup mechanism in the case of technical difficulty.

2. Applicable Law

The law applicable to this examination is the law covered in this class from: the assigned reading from the casebook and any assigned supplement, and additional law (if any) provided in the class overheads (collectively, the “Materials”). In my upper level Intellectual Property classes the Materials also include the primary statutory, regulatory, or treaty-based provisions relating to the assigned reading 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, 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, (which could be multiple) 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. This instruction does not necessarily mean that issues exist in this examination requiring the application of alternative or minority rules. And, it may or may not be necessary to analyze any or all such alternative or minority rules depending on the specific examination instructions and/or the facts provided.

SPECIFIC EXAM INSTRUCTIONS TABLE OF CONTENTS

C. Instructions Specific to this Particular Exam..... vi
 1. Structure vi
 2. Suggested Time Allocation vi
 3. BlueBook Use..... vi
 4. Read the Assignment Section in Advance..... vii
 5. Starting and Stopping the Exam..... vii
 II. ISSUE ANALYSIS SECTION (45%) 1
 III. DOCTRINE-APPLICATION “IRAC” SECTION (30%) 4
 IV. POLICY ANALYSIS SECTION (25%) 6
 V. THE ASSIGNMENT A
 1. “Policy” Analysis A
 2. Issue and IRAC Analysis A

C. Instructions Specific to this Particular Exam

1. Structure

The final examination is designed to be three (3) hours in length. It consists of three sections, each of which presents an independent problem, issue, or opportunity to discuss policy (or, some mixture of all three). Each section has a particular unique focus, and is worth a different amount of the total points available on the examination. The point weights are given in the table of contents immediately above on this page.

2. Suggested Time Allocation

The emphasis of this examination is roughly proportional to the emphasis of the areas of intellectual property law covered in class.

Given the point percentages for the three sections disclosed above, one logical division of time in a three hour (3) examination is to spend 30 minutes reading the examination sections and planning one’s answer. Then, the remaining time would be spent as follows: 68 minutes writing the analysis for the first section worth 45% of the points; 45 minutes writing the analysis for the second section worth 30% of the points; and 37 minutes writing the analysis for the third section worth 25% of the points.

If one instead read each section and wrote the answer for that section before going on to the next section, the suggested total time allocation for each section would be: 80 minutes for the first section worth 45% of the points; 55 minutes for the second section worth 30% of the points; and 45 minutes for the third section worth 25% of the points.

3. BlueBook Use

Start a new bluebook before beginning your analysis of each major area or logical subdivision. This means that you should use a new BlueBook (or, if typing and allowed by the exam taking software, use its mechanisms to create a page break) before your analysis of each section.

Remember to put your personal identification number on the cover of each bluebook.

4. *Read the Assignment Section in Advance*

It is ***highly recommended*** that you read the “Assignment” section first, before reading the other sections of the examination, and before you begin. The “Assignment” section is the portion of the examination made available before the exam date via the class web page.

5. *Starting and Stopping the Exam*

The actual examination sections describing the case/dispute/problem/issue has six (6) pages, numbered pages 1 to 6.

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.

A proctor will provide “warning” that the end of the exam period is approaching by writing on the board 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. ISSUE ANALYSIS SECTION (45%)

Senator Smith wants you to evaluate whether her proposed change to patent law will be subject to attack by opponents on the basis that the change will not comply with U.S. obligations under the TRIPS treaty. Smith's change relates to a unique aspect of U.S. patent law compared to the patent law of most countries: the "on-sale bar."

The U.S. has a first-to-invent system. One's date of filing does not ultimately determine who is entitled to a patent. If an applicant can prove a date of invention earlier than her date of filing, that invention date determines whether the applicant was first to invent and whether potentially invalidating art is "prior." Most other countries simply award patent priority to the applicant who files first. Under the U.S. first-to-invent system, inventors can confidently develop their invention experimentally and file when the disclosure and enablement support for the technology is robustly complete. There is no incentive to rush the development and skimp on the disclosure as some argue exist in a first-to-file system.

Critics of the U.S. approach, however, argue that inventors can delay filing, keeping the knowledge from the public. While this is true, U.S. law limits an inventor's latitude to commercially exploit the technology. These limits are the statutory bars. For the on-sale bar, the subject of Senator Smith's proposal, when an inventor or third-party puts a later-claimed invention "on sale," the applicant must file within a year of the on-sale event or lose all ability to obtain patent protection for any claims covered by the on-sale event. The commercial act of selling or offering to sell the technology starts a "grace period" within which the inventor must file in order to obtain patent protection. The penalty for not filing within the one-year grace period is the loss of all rights to patent any claims covered by the technology subject to the on-sale bar.

Senator Smith understands the policy argument for the on-sale bar, but she thinks the consequence is too harsh. Her proposal is that instead of destroying all patenting rights, an on-sale bar event should result in a loss of some patent term. The U.S. system presently allows for a twenty year patent term.¹ Under Smith's proposal, defendants in a patent infringement suit, or the U.S. PTO, can assert an on-sale bar event, but successfully proving the event² does not invalidate the claims at issue. Instead, those claims receive patent protection only ten years from filing instead of the twenty years otherwise provided under U.S. law. Smith believes there is sufficient incentive arising from the potential loss of ten years of patent term to inhibit too-early commercialization of patentable technology. The incentive will influence everyone, she believes, because no one wants to lose ten years of term. But the impact during litigation, she believes, is small because over the last ten years there were on average 2,000 patent litigation cases filed each year. On average, in twenty percent of these cases the defendant asserted the on-sale bar. In two percent of the cases, or 40 cases per year on average, the on-sale bar was adjudicated to a final outcome, with half of these invalidating some or all patent claims.³ The

¹ For purposes of this examination, ignore the U.S. system of patent term adjustment which provides term extension if U.S. PTO patent application processing exceeds defined time frames. Also, ignore patent term disclaimer practice associated with double patenting.

² Successfully proving an on-sale barring event requires showing: (i) that the technology offered for sale or sold was covered by the patent claims at issue; (ii) that an actual sale or offer took place, and determining the date of such sale or offer; and (iii) that filing in the U.S. PTO occurred more than a year after the sale or offer date.

³ During these ten years, an average of 100,000 new U.S. patents issued each year.

assertion of the on-sale bar before the PTO is negligible; they typically don't have the information to reject patents on that basis.

Smith understands that some will oppose her proposal because it means more patents will be valid and on the PTO rolls. A patent with only ten years of term still inhibits anyone other than the patent holder from using the technology during those ten years. Opponents will say: "these patents should be invalidated because the inventor commercialized her technology and did not file quickly enough! Letting these patents exist for even ten years is bad policy; they inhibit third-party use of the technology when the inventor was not careful to limit her commercialization before filing." Smith calls her proposal On-Sale Bar Term Reduction (OSBTR). She would apply it to any U.S. patent, regardless of the nationality of the owner. She is worried that opponents will argue that with a lesser consequence from an on-sale event (mere loss of some patent term), more patentees will be willing to sue on their patents, increasing an already accelerating rate of patent infringement litigation with its attendant costs and innovation-chilling effects.

Assume that the OSBTR is enacted into U.S. law. Articulate the likely analysis of OSBTR by a WTO DSB panel, assuming a challenge by a WTO/TRIPS member country whose nationals have significant patenting activity in the U.S. Consider that the U.S. as "defendant" will assert in the alternative that: (i) the OSBTR does not violate any TRIPS articles; or (ii) that if it does, that the violation is justified and within the U.S.'s rights.

III. DOCTRINE-APPLICATION "IRAC" SECTION (30%)

Pride Sweaters, Inc. (PSI) is a Scottish headquartered company manufacturing sweaters and selling them under the mark GALLUS.⁴ They are aimed at the high quality end of the market. Despite being quite expensive, the sweaters have sold well in various locations in Europe, partly because various golfers have endorsed the GALLUS product during golfing events in Europe and Canada that are televised globally. PSI sells the GALLUS sweaters mostly in northern European countries where their windproof qualities are particularly appreciated.

Mr. Hank Hacker noticed the GALLUS sweaters while vacationing in Scotland and purchased one of their specially windproofed lambswool sweaters with the mark GALLUS woven discreetly into the upper half of the sweater. PSI recently filed a CTM registration for GALLUS. The mark issued to PSI before Hacker's trip to Scotland.

Thus far, PSI has not sold any GALLUS sweaters in the U.S., but it has sold a lighter cotton sweater under a different trademark for golf products in the U.S. Regularly, however, pictures of European golfers wearing GALLUS sweaters (with the mark visible) appeared in U.S. newspapers and magazines. Also, European golfers are known to wear their GALLUS sweaters in some golfing events in the northeast U.S.

Upon returning to the U.S., Hacker's trademark search reveals that no mark conflicting with GALLUS is registered or in use in the U.S. Hacker sets up a company and begins selling sweaters bearing the GALLUS mark. He also files for a U.S. trademark registration. Hacker makes a unique sweater: it looks fluffy and warm, and it is warm in cold climates, but its

⁴ In Scottish dialect, the word has a first meaning of "self-confident, daring, cheeky" and a second meaning of "stylish, impressive."

high-tech fabric vents heat in warm climates. Thus, the Hacker high-tech GALLUS sweaters become a fashion rage for beach wear.

Since Spain has good beaches, Hacker has his brother, who lives in Barcelona, setup a distributorship and Hacker begins selling his high-tech GALLUS sweaters in Spain. Speaking with some customers at a beach outside Barcelona, Hacker's brother later discovers that the word "gallus" as spoken in Portugal means "the warmth of a loving animal."⁵ Other customers tell Hacker: "at first when I saw people wearing these sweaters at the beach on a warm day I thought this was odd because I assumed this was the Scottish GALLUS sweaters, which are very warm you know, but later when I purchased mine at the beachfront store I realized that this was a different sweater."⁶

PSI seeks to stop Hacker's U.S. registration for GALLUS. Evaluate PSI's chances, assuming that PSI has no problems to bring an opposition or cancellation proceeding in the appropriate forum. PSI also seeks to stop Hacker's use of GALLUS in Spain. Again, evaluate PSI's chances. If needed, any likelihood of confusion analysis under Spanish law should be evaluated as if Spain used the U.S. law likelihood of confusion eight-factor test.⁷

⁵ This is not actually true in the Portuguese language, but assume it is true for this exam.

⁶ PSI has not sold its GALLUS sweaters in Spain. In recent unrelated litigation, PSI admitted that its GALLUS mark was not well known in southern Europe. Also, assume for purposes of this examination that the CTM conversion procedure would not be available to PSI for GALLUS in Spain.

⁷ PSI disclaims any dilution-like protection that might be available under Spanish law. The eight-factor test is given on class overheads 6.1.c through 6.1.e.

IV. POLICY ANALYSIS SECTION (25%)

Law Professor Jones has a proposal relating to U.S. and international copyright law. Jones is concerned with his perception that copyright IP rights are increasingly limiting the ability of developing and least-developed countries to educate their populations. Under Jones' understanding of the Berne Convention (which may or may not be correct), he is sure that the Berne Convention requires developing and least-developed countries to implement increasingly high levels of protection for copyrightable works. Jones' concern is that these increasingly high levels of protection raise the cost of books and other educational materials for such countries, and generally restrict access to educational information.

Seeing the Berne Convention as the problem, Jones proposes elimination of that treaty. In Jones' view, high levels of copyright IP protection do not make sense in developing and least-developed countries. These protections restrict sharing and low-cost access for educational materials such as books. Jones reasons that it is more important to allow such countries an unbridled access to reproducing these materials at the lowest possible cost in order to facilitate the development of their human capital so that they can someday join the world's economic order.

<p>Critique from a policy perspective Jones' proposal. Would you endorse it, reject it, or implement it in altered form?, and if so, how would you alter it? Will it solve, in part or in whole, the problems that concern Jones? Is Jones' understanding of the problem correct?</p>

V. THE ASSIGNMENT

Write an analysis for each of the issue(s) raised by the facts or information enumerated in the examination sections. At the end of each section the focus or “call” of the question is given in a short paragraph enclosed in a rectangle.

Organize your written answer logically by the three sections of the examination. Your written answer does not need a general introduction. Proceed immediately to analyzing the issues, problems or questions in each section

The sections vary in the degree to which they suggest incorporating policy analysis. One section, the third, overtly suggests policy analysis. Another, the second, explicitly suggests traditional IRAC analysis: Issue, Rule, Application and Conclusion. The first section calls for elements of both types of analysis within a particular framework studied in class.

Organize your answer for each section in a logical, orderly way. In most cases that means you won't organize your answer explicitly using the questions/assignments in the rectangle as headings for your answer. Your answer should address the questions/assignments in the rectangle containing the “call” of the question, but typically the questions/assignments themselves do not make a good organizational vehicle.

1. *“Policy” Analysis*

The policy oriented section is designed to allow one to employ some of the various policy arguments that arose during the class. These arguments include, without limitation: institutional considerations for the various treaties, structures and organizations underlying the international IP system; effects and causes of these structures and systems; efficacy, reliability, fairness and justification of the international IP system; and the impact of all this on individuals, companies, countries, and regional trade groupings or other regional divisions. This listing, however, is not necessarily a good way to organize the analysis. A productive organization of the analysis depends on the context of the problems, disputes or questions posed in the policy-oriented section.

Application and deployment of these and other arguments is the emphasis of the “policy” section. Some may view the question(s) in the “policy” section as having two “sides” along political or other ideological lines. Even assuming this view, however, an answer does not earn points by picking the “right” or “best” side of the issue, but rather by effectively marshalling arguments for the two (or many) facets of the issue.

The “policy” section, however, is not completely divorced from the doctrine studied in class. Question(s) in the “policy” section may require the application of, or recognition of, the doctrine studied in class to specific fact patterns.

2. *Issue and IRAC Analysis*

The analysis in these sections should communicate the following as briefly as possible based on the facts available and the law, principles and policy discussed in class: (i) discuss the

arguments, positions or IP rights that should be asserted, or have been asserted,^a by the parties; (ii) evaluate the arguments and substantive merits from each party's perspective, articulating defenses and counter-arguments each should/might assert; (iii) assess the strength of each party's arguments; and (iv) determine for each issue who is likely to prevail and explain why. Your written answer, however, should not be organized according to these four points.

Rather, for each issue, your analysis should communicate the issue, and then state/apply the law (element by element) to the issue's facts (applying counterarguments as well), and then conclude on the issue. An exception to this is that there is no need to restate a legal test that has already been stated; simply refer to the previous statement of the rule. For example, if there is a second trademark infringement issue, and you have already related the infringement likelihood of confusion factors for an earlier issue, you can abbreviate your analysis by directly applying the law to the facts and concluding. Another way to say this is that if a second issue arises where there is a need to apply a legal test already related and discussed, you may analyze the second issue by exception, i.e., discussing the differences in application and outcome.

If you believe that there are any additional critical yet unsupplied facts that would materially impact the outcome of a particular issue, you should note what such facts would be. In such case, *briefly* describe how such critical facts might impact the outcome, i.e., indicate *at most one and only one* differing result that would ensue from different reasonable factual assumptions about such unsupplied facts.^b

In addition, as a general matter, discuss any invalidity/protectability issues that may be presented before any infringement issues. For example, if you find yourself discussing a patent law infringement issue, discuss any invalidity issues before any infringement issues.

If the facts note that any issues are to be adjudicated in a U.S. court, the location of final jurisdiction and/or venue for the expected case/dispute is unknown at this time, except that it will be in federal court.

You should analyze clearly presented (either explicitly, or by the facts) infringement issues in the case/dispute even if your analysis determines that the relevant item of intellectual property is invalid, unenforceable or not properly the subject matter of protection. An example of this principle in trademark law is the assertion of product shape/design as a mark, but where the trademark defendant might have a functionality defense. In a real court opinion, if the court holds that the defendant wins on the functionality issue, the court might not analyze the

^a The examination question in certain sections is written in such a way that certain issues are clearly "in" the problem or case/dispute because they have been articulated or strongly suggested by the facts. You should analyze these issues, but there may be other issues to be analyzed as well because the examination question is silent about whether they have been, will, or will not be asserted by either side. In addition, the examination question in these sections may also indicate that certain other possible issues are "out" and not to be analyzed because the parties disclaim certain issues or protections.

^b Please note that if you find yourself discussing alternative outcomes for supposedly critical yet unsupplied facts for every issue you analyze, you are probably engaging in too much analysis of such alternative outcomes.

likelihood of confusion test to determine if the accused product shape infringes the product shape/design allegedly functioning as a mark. Your analysis, however, unless the facts clearly indicate otherwise, should evaluate both the functionality defense and infringement if clearly presented: even if you conclude that the shape/design is functional and thus not the proper subject matter of protection as a mark, go on to analyze whether the likelihood of confusion test is met for infringement of the shape/design mark. Similar examples exist within other areas of IP.