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C. Instructions Specific to this Particular Exam

1. Structure

The final examination is designed to be two (2) hours in length. It consists of one integrated fact pattern and an assignment to write an analysis for the issues arising from that fact pattern.

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.

Our class coverage by time was approximately: ten percent (10%) trade secrets; thirty percent (30%) patents; thirty percent (30%) copyright; and thirty percent (30%) trademarks. For a two (2) hour final, if one takes 20 minutes to read the problem and plan the answer, then one would spend the remaining time as follows: 10 minutes writing the trade secret answer, 30 minutes for patent law, 30 minutes for copyright, and 30 minutes for trademark.

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 major area of law.

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

4. Read the Assignment Section in Advance

Even if you do not read the “Background” and “Dispute” sections before starting, it is ***highly recommended*** that you read the “Assignment” section before you begin.

Further, it is ***highly recommended*** that you read the “Assignment” section ***first***, before reading the “Background” and “Dispute” sections of the examination. The Assignment section is one of several portions of the examination that was made available before the exam date via the class web page.

5. *Notation for Patent Claim Amendments*

Some of my examinations will include issues related to patent law. Some of these issues may spring from facts surrounding an amendment of a patent claim during patent procurement or “prosecution.” 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”.

6. *Starting and Stopping the Exam*

The actual examination problem(s) section describing the case/dispute has four (4) pages, numbered pages 1 to 4.

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. IP SURVEY FINAL EXAMINATION

1. *The Background*

Perry's company has a cloistered, access-controlled windowless room where they polish camera lenses. She combined traditional polishing brushes, conventional abrasives, and customary polishing solutions in a unique way: the process occurs in a vacuum. The resulting lenses, sold under the mark LightAbide[®], have no trace of the polishing process and the market recognizes them as the best in the low-end consumer market. This always galled Damien, a competitor. He was aware of recent advances in direct-nerve-stimulus technology, combined with wireless communications, allowing for a remote-controlled rat. Damien obtained such a rat and mounted a small, wireless camera on the rat. Just as one might drive a remote-controlled toy car around a parking lot, Damien released his rat outside Perry's company building and navigated the rat to the polishing room.¹ Via the wireless camera, he saw the key to the process. He now uses it to make very expensive microscope lenses he sells under the mark LiteAlive.

Perry protects LightAbide lenses with a patent having claim 1: A lens comprising: (a) a round polished lens body having a first and a second side; (b) said body comprised of glass or quartz; and (c) two or more nonintersecting substantially-parallel spaced apart SuperFunkySlightlySquiggly (SFSS)² grooves penetrating into the surface of said first side of said lens body.³ The patent shows three embodiments, each showing two grooves with the

¹ Where this occurs no law prohibits the surveillance aspects of the remote-controlled rat, but it is clear that a remote-controlled instrumentality like the rat constitutes trespass.

² SFSS grooves are a technique known to POSITAs in the relevant art to enhance the optical properties of a lens. The SFSS grooves are not related to Perry's secret polishing process.

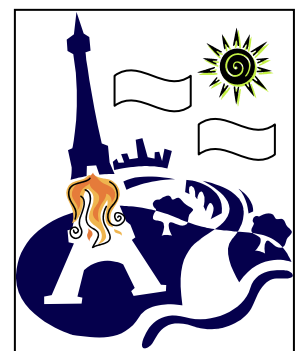
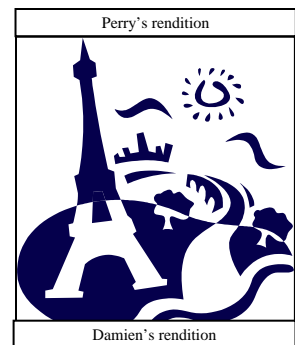
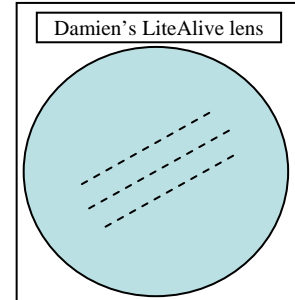
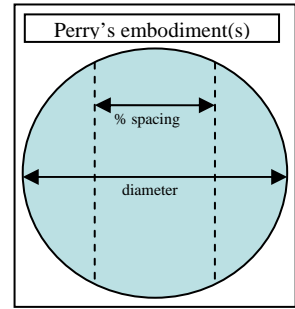
³ During prosecution the PTO examiner initially rejected Perry's application as obvious in light of a prior art patent to Allen. That patent disclosed a two-sided, round, quartz lens with three equal-length SFSS grooves on one side connected to form a triangle. Perry amended the claim as indicated by adding the underlined words, and the PTO allowed the patent to issue.

spacing between the grooves expressed as the following percentages of the lens diameter: 30%, 40%, and 50%.⁴

LiteAlive is a two-sided, round, polished quartz lens with three SFSS grooves each spaced 15% of diameter from the others.

Recently Perry and Damien attended a trade show in Paris, France. On a tour bus trip they both contemporaneously hand-sketched a rendition of the Eiffel Tower. Neither saw the other's rendition. Perry posted her rendition in a display case where attendees could post items. Damien noticed it, picked the case lock, and took it.

Damien scanned a high-resolution digital image of Perry's rendition, which created an exact, literal copy, and then sold the original rendition for \$2,000 to a dealer named Max. Max sold thousands of copies all over the U.S. for \$20 each. Damien also scanned his rendition, and used his rendition-image in a new company brochure. He was planning to also use his rendition-image on his company web site, but he lost his original and all digital copies. In a bind, Damien decided to use the scan of Perry's rendition and posted that image on his company web site. Next, wanting to poke fun at the French, Damien created a 30-second video clip from Perry's image where the Eiffel Tower struts and dances around the tree-spotted field in Perry's rendition, and then turns into an upright, dancing French Fry with a face carrying a very smug look. Damien sold millions of downloads of the video clip to U.S. customers for \$0.25 each from his web site.



⁴ The dashed lines in the lens diagrams are SFSS grooves.

2. *The Dispute*

Perry sues Damien for copyright infringement (after registering her rendition), patent infringement, trademark infringement/dilution of the LightAbide mark, and trade secret misappropriation of the lens polishing process. Additional items are discovered and/or arguments and stipulations are made:

(i) Damien contends that Perry's polishing process is a mere improvement.

(ii) Besides Allen, the only other relevant art existing prior to Perry's date of invention is Baker's article discussing plastic square lenses with two nonintersecting SFSS grooves on one side, spaced apart at 10% of diameter. The article says this makes a very good lens (even for glass lenses), and that more SFSS grooves are even better.⁵ It also says, however, that spacing SFSS grooves more than 25% of diameter might cause distortion.

(iii) Damien admits that his lens has element (a) of claim 1. Perry offers her expert who opines that Damien's SFSS grooves are "spaced apart" because a POSITA would view that phrase as being satisfied if any space exists between the SFSS grooves. Damien disagrees, arguing that "spaced apart" means 30% to 50% of diameter. Perry gets Damien's expert to admit that Damien's SFSS grooves perform a substantially similar function (SSF) in a substantially similar way (SSW) with a substantially similar result (SSR) compared to the claimed grooves.

(iv) Perry alleges that the rendition in the company brochure and web site, as well as the video clip, infringe her copyright. Damien asserts a number of defenses, including asserting fair use for the web site and video clip uses.

⁵ Damien disclaims challenging Perry's patent based on the first (subject matter), second (utility), third (novelty/bars), and fifth (disclosure requirements) elements of patentability. Perry waives assertion of the Festo rebuttal criteria for tangentialness and for "reasonable expectations of those skilled in the art."

(v) Perry licenses her Eiffel Tower rendition for a \$5,000 down-payment to an advertising company to use it to make a 60-second commercial where the Eiffel Tower will sprout arms, have a face, and sing while wildly waving its arms, but will remain rooted in place. When the commercial is 75% complete, the advertising company discovers Damien's video clip. It cancels the contract without paying Perry the remaining payment of \$45,000.

(vi) Perry disclaims copyright protection in the pattern of her lens embodiments. She asserts that the lens embodiment's parallel, spaced-apart SFSS groove pattern is a product shape/design mark infringed by Damien.⁶ Perry also asserts that LiteAlive infringes her senior, famous, incontestable mark LightAbide, offering a survey that 40% of her customers who don't purchase LiteAlive (and who had never heard of it) thought LiteAlive would be her product when shown the mark. Damien began using LiteAlive after LightAbide became famous.

(vii) Damien's advertising includes this: "make your light abide by the best in lenses – use LiteAlive brand lens products." Perry admits this isn't dilution, but asserts confusion.

(viii) Damien regularly gives his distributors a post card to send to customers. One side has the traditional space for a message, address and stamp. The other side has the phrase "put bad LightAside" above a fuzzy, out-of-focus image of some writing. When one turns the writing into the light at certain angles, the writing is readable: "Get into focus – see the clear winner in lens products." The writing also includes the LiteAlive mark in small type. Every month a few of Perry's customers send her this card with a note saying that receiving it makes it hard for them to take Perry's LightAbide mark seriously. Perry admits this isn't confusion, but asserts dilution.

⁶ Admitting that the lens pattern product configuration/shape "mark" is not famous, Perry disclaims any dilution protection for it.

III. THE ASSIGNMENT

Write a short analysis for each of the issues raised by the facts enumerated in the examination question, **based only on the law from the IP Survey class**. The analysis should communicate the following as briefly as possible based on the facts available: (i) discuss the arguments, positions and IP rights that the plaintiff should assert, or has asserted,^a against the defendant(s); (ii) evaluate the arguments and substantive merits from plaintiff's perspective and defendant(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 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 copyright fair use issue, and you have already related the four fair use 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

Organize your written answer logically by subdivisions within intellectual property law in the following order: (i) trade secret law; (ii) patent law; (iii) copyright law; and (iv) the law of marks. In addition, as a general matter, discuss any invalidity/protectability issues before any infringement issues. For example, in the patent law discussion, discuss any invalidity issues before any infringement issues.

^a The examination question is written in such a way that certain issues are clearly "in" the case/dispute because they have been asserted by either plaintiff or defendant(s). 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 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.

Your written answer does not need a general introduction. Proceed immediately to analyzing the issues. 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.^c

Apply only the majority rules from the applicable law. Thus, your memo can ignore any significant outcome-determinative differences in majority/minority rules and need not supply/apply minority rules. Probably the only way in which minority rules or dissents are relevant is that they sometimes provide inspiration for counterarguments. With respect to trade secret issues, the provisions of the Uniform Trade Secrets Act (“UTSA”) are the “majority” rule.^d In addition, do not apply the Restatement factors to determine whether information is a trade secret; use the UTSA definition instead.

You should analyze clearly presented (either explicitly or by the facts) infringement issues in the case/dispute even if your memo 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 would typically not analyze the likelihood of confusion test to determine if the accused product shape infringes the product shape/design allegedly functioning as a mark. Your analysis, however, 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.

In this vein, some patent claims may have multiple issues of invalidity charged against them. Each invalidity issue raised by the problem’s facts should be evaluated even if your analysis determines that a patent claim is invalid due to one of the raised issues. Other areas of IP might also allow for multiple bases of invalidity.

A related problem exists for multiple types of infringement (and potentially for the predicate inquiry: claim construction). For example, in patent infringement, any particular element/limitation of a claim can be met by the accused infringing device/process either literally or under the Doctrine of Equivalents (DOE). Thus, you must make a determination whether to analyze only literal infringement for a claim element/limitation, or whether to analyze both literal infringement and DOE. Whether you additionally analyze DOE depends on the certainty of meeting the claim element/limitation under a literal analysis. If it is clear that the claim

^c Despite this jurisdictional orientation, the issues in this examination do not include jurisdictional and procedural issues, but rather focus on the substantive IP law and rights from the class materials. In addition, you are to analyze and discuss the probable ultimate outcomes under the substantive law studied. Do not analyze any intermediate standards, such as likelihood of success in obtaining a preliminary injunction. In addition, we did not study the details of potential remedies or damages, so do not discuss these items.

^d Although the UTSA is the majority trade secret law, the common law trade secret cases studied in class are relevant to “fill gaps” in interpreting terms/concepts used in the UTSA.

element/limitation is met under a literal analysis,^e do not analyze DOE. If, however, the literal analysis is contestable, i.e., it is reasonably and legitimately disputable, the safe route to avoid missing a possible points-earning examination issue is to evaluate both literal and DOE infringement for the element/limitation in question.

Here is a concrete example of this principle. A claim element/limitation on the examination says: “a nail made of steel or aluminum.” The accused infringing device described in the examination includes a nail made of steel. This element/limitation is clearly met under a literal analysis and you should forego DOE analysis.^f Even a diligent and prudent litigator would admit/stipulate that this claim/element is met.

An example going the other way is an examination claim element/limitation that says: “a square seat.” The accused infringing device has a seat with a square-like shape but having rounded corners. Here, there is a reasonable question as to whether the accused infringing device literally meets the claim element/limitation. A diligent and prudent litigator would also assert and contest the DOE analysis for this situation.

Another version of this problem is with the DOE analysis itself. In discussing DOE, one might note that there are several doctrines limiting DOE. Whether the test for any such doctrines should be described and analyzed depends on whether there are any facts relevant to such DOE-limiting doctrines. If no such facts are given, the analysis should probably stop after relating that “no facts are present to raise any of the various limitations on the reach or applicability of DOE.”

^e One way to think about whether a claim element/limitation is literally met is to ask whether a reasonable litigant (defendant) would admit that the element/limitation is satisfied by the accused infringing device/process. Parties to patent infringement suits regularly admit/stipulate that some claim elements/limitations are met in order to focus the issues to a small number of contested elements/limitations where the infringement count will be won or lost.

^f If you undertook DOE analysis for the nail, it would only hurt you in the sense of opportunity cost. DOE for the nail was not a points-earning issue on the examination, so the time spent analyzing it takes away from time you could spend on actual points-earning issues. Also, please note that if you find yourself undertaking DOE analysis for every element/limitation in the claim, you are probably undertaking DOE analysis for some non-points-earning issues. This in essence means that the examination does not consider these to be actual, disputable issues. The patent issues on an examination are unlikely to contemplate application of DOE for every claim element/limitation.