

FINAL EXAMINATION
INTELLECTUAL PROPERTY SURVEY
PROF. VETTER

S / N

1. *Essay Exam*

This examination consists of one integrated fact pattern and an assignment to write an analysis for the issues arising from that fact pattern. Think of this examination as an aggregation of numerous short answer issues lying within the fact pattern.

2. *Open Book*

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 or obtain direct or indirect information or assistance from anyone. You may not use any live or electronic retrieval/computer source during the exam.

3. *Single-Part Exam*

The examination’s fact pattern constitutes all of a single-part examination. The point-earning 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.

4. *Time Allotted*

The final exam is two (2) hours in length.

5. *Page Length*

The problem and fact pattern is four (4) pages in length, pages 6 to 9 herein.

6. *Release Prohibited*

I have not determined whether I will make this examination available in the future. Accordingly, I am prohibiting it from release. Please return all problem pages. Copying, reproducing, or memorializing the problem in any form or fashion is prohibited.

7. *Other Instructions*

If using a blue book, please write on only one side of the page. Put your Exam Taker Number on each blue book.

Please bring your copy of the assigned casebook to the examination.

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. Please answer all questions on the basis of the law provided in the Materials.

The analysis in your examination answer is more likely to earn more of the available points the more that your analysis can use a vocabulary that corresponds to the precise vocabulary of intellectual property law as treated during class discussion.

There may be 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.

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”.

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 be structured to communicate the issue, and then state/apply the law to the issue’s facts (applying counter-arguments as well), and then conclude on the issue. It is alternatively appropriate to present the issue and the conclusion bundled together, followed by the rule(s) of law applied to the facts, although in this alternative approach the law applied should be made clear. 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

^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. The examination question may be 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 or waive certain issues or protections.

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.

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 analysis 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.

Any patents recited in the facts are given relevant dates such that the patent law that applies for this examination is that in effect after the America Invents Act (AIA) has come fully into force.

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

^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.

^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, this examination does not cover 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.

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 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 (and not disclaimed by a hypothetical party): 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 other 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 in patent law: 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 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 A diligent and prudent litigator would admit/stipulate that this claim/element is met.

^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.

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.”

Finally, for any claimed inventions discussed on this examination, prior art does not come from real life. Prior art references come only from what is given in the examination problem below.

While not necessarily an exhaustive list, here are some items which are affirmatively not tested on the examination because, while perhaps legitimately within the Materials for the course, they received nominal coverage or de-emphasis in class discussions: (i) “means-plus-function” claim elements/limitations; (ii) inherent anticipation; (iii) within novelty for patent law, section 102(b) exceptions to prior art; and (iv) geographic marks, that is, marks with a geographic term as a part of the mark.

HONOR CODE: Turning in an examination answer to this final examination is deemed to be a pledge under the Law Center honor code that the exam taker has complied with the honor code in all respects in relation to this examination.

(the examination problem starts on the next page)