

GWid: _____

EXAMINATION
INTELLECTUAL PROPERTY – LAW 470 – SIEGEL
Spring, 2010

INSTRUCTIONS

1. This is an open book examination. You may use any written materials that you have brought with you (including typewritten, printed, or published materials). Computer use is permitted.
2. You have THREE HOURS to complete the exam.
3. The exam consists of this cover page plus 13 exam pages numbered 1 through 13.
4. There are three essay questions and 15 multiple-choice questions. All students must answer all questions. The recommended time allocations are:

Essay Questions: 40 minutes each

Multiple Choice Questions: 60 minutes total

The weights of the questions are proportional to the recommended time allocations.

5. Do not put your name anywhere on your answers. Use your GWid number. Do not indicate whether you are taking the class pass/fail. Do not write “Thank you for a great class” or anything similar on your exam. If you are writing your answers by hand, remember to *write legibly*.
6. If, with regard to any essay question, you think additional facts are needed to answer the question, state clearly what facts you think are missing. Then make a reasonable assumption about the missing facts and answer the question based on your assumption. Do not change the given facts.

For all questions, if no location is stated for one of the given facts, assume that it occurred within the United States.

7. Using good judgment, address all the issues presented and assigned by the essay questions, even if your answers to some issues would, in real life, eliminate the need to address other issues. Provide reasons for your answers to the essay questions.
8. Good luck.

QUESTION ONE
(40 minutes)

On June 1, 2010, Phyllis Pritzker, a recent college graduate, is thinking about ways to make money. She thinks to herself: "I'll sell T-shirts that say 'Repeal the Mandate.'" Such T-shirts, she thinks, will appeal to people who don't like the health-care reform law recently passed by Congress, which mandates that all Americans buy health insurance. Pritzker writes "Repeal the Mandate" on a piece of paper. "Maybe I can trademark this – or perhaps I'll copyright it," she thinks.

Pritzker creates thousands of T-shirts that say "Repeal the Mandate" on them. Starting on July 1, 2010, she sells the T-shirts to retailers, who in turn sell them to the public. Pritzker, who lives in Oregon, sells the T-shirts only to retailers in the west coast states of Oregon, Washington, and California. The T-shirts prove very popular and sell well in those states. On November 1, 2010, Pritzker files an application with the Patent and Trademark Office to register the phrase "Repeal the Mandate" as a trademark for clothing. Her application is granted on February 1, 2011.

Meanwhile, on August 1, 2010, the Funtime Corporation starts selling T-shirts that say "Repeal the Mandate" in the southeastern states of Florida, Georgia, and Alabama. At that time, Pritzker and the Funtime Corporation are each unaware of the other's products. Seeing that the T-shirts are selling well, the Funtime Corporation starts to expand its sales area. By October 31, 2010, the Funtime Corporation is selling its "Repeal the Mandate" T-shirts in its original sales area plus Mississippi, Tennessee, and South Carolina. By January 31, 2011, the sales area also includes Louisiana, Arkansas, Missouri, Kentucky, and North Carolina.

The T-shirts sold by both Pritzker and the Funtime Corporation are just plain T-shirts with the words "Repeal the Mandate" printed on them in bold letters.

On March 1, 2011, Pritzker becomes aware of the activities of the Funtime Corporation. She brings suit against them in federal district court. She asserts such claims as might be expected on the above facts. Both sides make all appropriate arguments.

You are the law clerk to the district judge hearing the case. The judge asks that you write a memorandum discussing the issues raised by the case and that you make a recommendation on each issue and on the overall case.

The judge asks you to be sure to consider what remedy Pritzker could get if she wins on a trademark theory, but, with regard to any other theory, to discuss liability only and not remedy.

Write the requested memorandum. (In case you missed them, be sure to read instructions 5-7 on the cover page.)

QUESTION TWO

(40 minutes)

Patrick Pinkerton, a chemist by training, owns a firm that manufactures roof tiles. On March 1, 2010, Pinkerton, by doing research in his laboratory, discovers that when slate roof tiles are treated with a certain chemical, they perform much better than traditional slate tiles at preventing leaks and keeping a building insulated. By April 1, 2010, Pinkerton has perfected a slate tile that uses his discovery. On December 1, 2011, Pinkerton applies for a patent on a “Chemically Treated Slate Tile.” He claims “a roof tile consisting of slate infused with the following chemical: [the claim specified the formula of the chemical].”

The patent application has a specification that satisfies § 112 of the Patent Act. Research by the Patent and Trademark Office (PTO) reveals the following:

- The chemical described in the patent has been in widespread use in the United States as a lubricant (i.e., a substance that reduces friction) since 1970.
- On May 1, 2002, the PTO issued a patent on chemically treated slate tile which was identical to Pinkerton’s claimed invention except that it used a different chemical (which was not as good as Pinkerton’s at improving the performance of the tile).
- On June 1, 2010, Pinkerton installed some of his new tiles on the roof of his own personal home, but didn’t tell his neighbors that there was anything special about it.
- On August 1, 2010, an article in the German-language *Journal für Praktische Chemie* (“Journal of Practical Chemistry”) was published, in Germany only. The article described the chemical used by Pinkerton and said that it was remarkably good at improving the performance of *clay* tiles.
- On September 1, 2011, Pinkerton’s company advertised that it would accept orders for what it called “Megalon Tile,” which would be tiles that would embody the claimed invention, although the tiles would not be available for delivery until February 1, 2012.

Part A. Should the PTO issue the requested patent? Explain.

Possibly in accordance with your view and possibly contrary to it, the PTO issues Pinkerton’s patent on March 1, 2013. Assume for the remainder of the question that the patent is valid.

Pinkerton’s Megalon Tiles prove very popular. However, it is discovered that the specially added chemical evaporates over a period of about five years, leaving completely ordinary slate tiles. In 2020, the Dow Chemical Corporation starts marketing the chemical used in the Pinkerton tiles as a product called “Rejuva-Tile.” The products’ label prominently states, “Rejuva-Tile Restores Megalon Tile.” Many homeowners who have Megalon tile installed on their roofs buy the Rejuva-Tile chemical from Dow and spray it on their roof tiles, which restores the Megalon tiles to their original condition. Pinkerton sues Dow for patent infringement and for trademark infringement.

Part B. Is Dow infringing Pinkerton’s patent or trademark? Explain.

QUESTION THREE

(40 minutes)

Professor Goodman, a law professor at George Washington University, prepares a casebook on (what else?) intellectual property law. Like most casebooks, Professor Goodman's casebook consists primarily of court decisions. Each decision is followed by notes and questions written by Professor Goodman. In preparing the court decisions for inclusion in the casebook, Professor Goodman edits most of them down from their full, original text, leaving out those portions that he believes are not necessary for understanding of the key issues. The book is called "Intellectual Property: Cases and Materials."

Professor Goodman writes the casebook under contract with the West Publishing Company. The written contract between West and Professor Goodman makes no express reference to intellectual property rights, but it does provide that the casebook "shall be considered a work made for hire." The casebook is published in July 2009 and West sends free copies to all professors teaching intellectual property at all law schools in the United States. The casebook contains no copyright notice and no claim of copyright to it is registered.

Professor Crooks, a law professor at Georgetown University, comes out with a casebook in the summer of 2012, published by Aspen Publishers, which is also called "Intellectual Property: Cases and Materials," and which also consists of edited court decisions followed by notes and questions. Professor Crooks has long been a nationally recognized scholar with regard to trademarks and patents, but he has no great expertise in copyright law.

Upon receiving a copy of Professor Crooks's casebook, Professor Goodman observes that, of the 20 cases in the casebook that concern copyright law, 19 also appear in Professor Goodman's casebook. Moreover, with regard to 15 out of those 19 cases, Professor Goodman observes that the edited version of the case in the Crooks casebook coincides exactly with the edited version of the case that appears in his own casebook. All of the cases in question are federal court decisions. There is no similarity between the notes and questions that follow the cases in Professor Goodman's casebook and the corresponding material in Professor Crooks's casebook.

Professor Goodman brings a copyright infringement action against Professor Crooks and Aspen Publishers in federal district court. The defendants raise all defenses that might be expected on the above facts, and each side makes all appropriate arguments.

Among other evidence in the case, Professor Crooks testifies that when he receives textbooks from publishers, he immediately throws them out. He states that he chose all the cases in his casebook himself and edited them all himself. Professor Goodman presents no witnesses who can personally and directly contradict Professor Crooks's testimony, but he presents such evidence and makes such arguments as would be expected given the facts described above.

You are the law clerk to the district judge considering the case. Write a memorandum

discussing the issues raised by the case and making a recommendation as to how the judge should rule on each issue and on the overall case. The judge says, “don’t worry about remedy – just discuss whether the defendants are liable.”

MULTIPLE CHOICE QUESTIONS
(60 minutes total)

INSTRUCTIONS

- 1. For all multiple choice questions, choose the best answer from the answers provided.**
- 2. Mark your answers on the bubble sheet using a #2 pencil. Do NOT simply mark your answers on the exam itself; that will NOT count.**
- 3. There is no penalty for wrong answers, so answer every question.**

QUESTIONS

[Redacted]

END OF EXAM