

INTELLECTUAL PROPERTY

Mr. Martin

December 15, 2011

Exam ID no. _____

FINAL EXAMINATION

This is an open book examination. You may use any materials which you have brought with you whether prepared by you or by others. Questions will be weighted equally and you should spend equal amounts of time on each question. Turn in this white examination paper along with your blue book or blue books.

Please write legibly, begin each question on a new page, and leave a margin on the left-hand side of the page.

Use only your examination identification number to identify this white examination paper and your blue book or blue books. Your exam ID number is the last six digits of your social security number followed by the numerals "59." Thus, if your social security number is 123-45-6789, your exam ID number will be 45678959. If you use more than one blue book, identify each one ("No. 1 of 2," "No. 2 of 2," etc.), make sure that your exam ID number is on each one, and insert all exam materials into the first blue book when you turn them in.

Questions relating to patents are to be answered by reference to Title 35, U.S. Code, as in effect on August 22, 2011, the first day of this semester.

ALL BLUE BOOKS AND THIS WHITE EXAMINATION PAPER MUST BE RETURNED AT THE END OF THE EXAMINATION. LABEL ANY SCRAP BLUE BOOK WITH THE WORD "SCRAP."

QUESTION ONE

Review Title 35, ss. 102(a) and 102(b), copies of which are being distributed with this examination.

The soft top automobile, or “convertible,” has been an also-ran of the American automobile industry for decades. Most American car makers have discontinued convertibles. Industry observers have noted, however, that among the buyers of high-priced, high-prestige European sports cars there is still an appetite for convertible models. Some American and Japanese makers are, under conditions of commercial secrecy, exploring the possibility of reintroducing convertible variants on cars made in this country, or on Japanese cars made for the American market.

These companies have commissioned market researchers to assess the prospects for sales of such cars in the United States. Among those surveyed, the overwhelmingly most often cited reason not to buy a convertible is fear that a convertible is a deathtrap in a rollover accident. Small teams of designers and mechanical engineers are therefore working at several companies to develop a convertible lift mechanism which will support the weight of the car during a rollover.

The team at Ford Motor Co., led by Alice Vroom, an engineer, is working with the metal titanium, five times stronger than steel of equal weight. On April 14, 2010, computer simulation disclosed that the team’s new design for the lift mechanism, if made from titanium, would remain rigid during a rollover. Due to delays in Ford’s legal department, a patent application was not filed until June 15, 2011.

Will any of the following activities create problems under 102(a) and 102(b)?

In each case, be sure to discuss both 102(a) and (102)(b).

1. Ford began to test prototypes of the roof lift mechanism in May of 2010.
2. Ford installed the new lift mechanism on one of its show cars displayed at the annual Detroit Auto Show. The show was attended by over 100,000 people and by press from around the world during the period June 1 to June 14, 2010. The lift mechanism was not described or deployed at the show.
3. Daimler, the German car maker, developed a strikingly similar titanium lift mechanism in January of 2008. Management decided not to use the new design, at least for a while.
4. Honda, the Japanese car manufacturer, also developed a titanium lift mechanism which closely resembled Ford's in May of 2010. Honda applied for a Japanese patent on June 1, 2010. The patent has not issued at this time.
5. Honda applied for a U. S. Patent in July of 2010. At that time Honda announced in commercials all over the United States and Canada, "Honda convertible— safe as a sedan." The commercial depicts a 2011 Honda skidding off a mountain road and rolling over several times before coming to rest upside-down, the roof still rigid. Technicians are then shown removing crash test dummies from the car, saved from destruction by the rigid roof. A viewer could not tell the difference between the new roof mechanism and any other, but the commercial goes on to say, "This is the new Honda TX4000 convertible roof, made from titanium."
6. Not wanting to lose out to Honda once again, Ford began a widespread campaign to sell its own convertibles with its new lift mechanism. The ad campaign began on July 16, 2010, and the first sale of a car with the new lift mechanism occurred on July 20, 2010. The car sold is a 2011 model.
7. In France, the daily Le Monde devoted half of the front page on June 1, 2010, to an article on new automotive safety devices. The article was submitted on April 1 and was sent to engineers to review before the June 1 publication date. Excellent investigative reporting revealed that the Swedish car maker Saab came up with a titanium convertible lift mechanism some years ago, but never sought a patent on it nor used it because Saab lacked the finances to put the mechanism into production. Technical specifications for the Saab lift mechanism were printed on page 47 of the newspaper. Alice does not speak or read French.

QUESTION TWO

After graduating from law school and passing the bar in 2006, Mary Gentleman joined the intellectual property law firm of Tydings, Comfort and Joy (“TC&J”). She signed a standard associate employment contract stating that she would provide legal services on behalf of TC&J in exchange for a compensation package (salary plus bonus tied to billable hours, bar dues, health plan, contribution to retirement plan). Mary rotated among the firm’s practice areas during her first two years: IP litigation, trademark prosecution, corporate transactions. She received solid evaluations. She particularly liked the trademark group and requested to specialize in that department, which already had four partners, six associates, and four paralegals. Sing Yee Noel, the lead partner in the department, viewed Mary favorably, and she joined the department early in her third year with the firm.

Six months into her third year, Mary began to feel that her trademark prosecution work was becoming monotonous. She increasingly recognized that many aspects of the work— validity analysis, record keeping, correspondence, etc., could be automated through the use of computer macros. She also felt that the efficiency of the office could be enhanced by creating an integrated database which all members of the department (and clients) could access and use. She mentioned this idea at a department lunch where it received mixed reactions. A few members of the group liked the idea and wanted to hear more about it. Sing Yee Noel noted that the department’s workload was tremendous and he did not want this type of project to distract Mary from her prosecution responsibilities.

Without discussing the matter further with her colleagues, Mary decided to

pursue the idea in her spare time. She had taken some computer classes while in college and had kept up with advances in microcomputers, network computing, web-based computing, and cloud computing. She liked fooling around with computers and began chipping away at the project at home. Using her own computer, and software that she purchased with her own funds, Mary developed a prototype of the program over the next year. She put in regular hours at the law office, and spent evenings and weekends in her home office working on the prototype. She occasionally accessed TC&J's website and files in the course of developing the program, and eventually loaded a copy of the program onto her office PC. She also tested the program using her office files. As the program components reached the operational stage, Mary began using (and refining) the program at the office. Her productivity increased, as did her enjoyment of work. The challenge of automating her practice brought tremendous satisfaction.

After more than a year of effort Mary completed a prototype for what she called "TM Prosecution Toolkit." The program stores information about clients and their applications, provides a checklist/expert system for assessing the applicability of bars to registration, identifies necessary actions for trademark protection, records actions taken, generates draft forms and correspondence for use in prosecution, calculates prosecution deadline dates, and alerts responsible individuals to impending deadlines.

Mary demonstrated the program to the trademark group in February, 2010, at a department-wide planning retreat. By that time the department had grown to almost twenty lawyers. Everyone was impressed. Noel recommended that the system be implemented throughout the department immediately. TC&J advertised the use of the program on its website and promotional materials. The materials identified the system as "TC&J's innovative TM Prosecution Toolkit." (TM) Harold Angels, the

webmaster at the firm, adapted aspects of Mary's program so that clients and attorneys could gain access to the firm's trademark database through a password protected portal. The firm touted this new service as its "TM Fileshare."SM

Mary received a particularly large bonus the following December. She was pleased by the reaction of her colleagues and clients. She was deeply chagrined, however, when Noel informed her that TC&J planned to register the copyright and trademark in the firm's name, and to market the program to other law firms and trademark consulting firms. He informed Mary that TC&J owned all rights in the programs and that the firm intended to exploit its market edge aggressively. He invited Mary to serve on a committee that she was forming to guide Harold Angels and the firm's computer staff on improving the products and services. Although there were some other programs of this general type available, the firm considered Mary's program to be the best available. Its user interface (designed by Mary) and networking features (originally designed by Mary, but augmented by Harold Angels, went well beyond the competing programs.

You are a lawyer at Holly & Ivey, another IP law firm. Mary comes to you for advice. A prominent trademark search firm, TM's 'R' Us, has approached Mary about acquiring the program. In addition, Riseup, Shepherd & Follow ("RS&F"), yet another IP law firm, is interested in bringing Mary on board in a lucrative "Of Counsel" position to allow her to develop a business around the TM Prosecution Toolkit. The RS&F opportunity provides what she considers to be an ideal mix of law practice and entrepreneurship. In addition, her income would go up significantly. RS&F would want Mary to license the program to it on a non-exclusive basis, and charge fees to any other firms (including TC&J, a principal competitor) using the software.

Part A.

(Fifty per cent of this question)

Who owns the copyright in TM Prosecution Toolkit? Discuss.

Part B.

(Twenty-five per cent of this question)

Who owns the copyright in TM Fileshare? Discuss.

Part C.

(Twenty-five per cent of this question)

Can Mary prevent TC&J from further use of the programs? Discuss.

QUESTION THREE

Plaintiff Mattel Corp. asks the federal court to prohibit defendant Furbish Lousewort from producing and selling photographs containing Mattel's "Barbie" doll. Most of Furbish's photos portray a nude Barbie in danger of being attacked by vintage household appliances. Mattel argues that Furbish is infringing its copyrights. Furbish responds that he is engaged in fair use. Each party seeks summary judgment in its favor. The court finds facts as follows.

Furbish, a/k/a/ Gauley River Productions, is a self-taught photographer who resides in Summersville, West Virginia. He produces photographs with social and political overtones. In 2007, Furbish developed a series of 78 photographs entitled "Food Chain Barbie," in which he depicted Barbie in various absurd and often sexualized positions. Furbish uses the word "Barbie" in some of the titles of his works. While his works vary, Furbish generally depicts one or more nude Barbie dolls juxtaposed with vintage kitchen appliances. For example, "Malted Barbie" features a nude Barbie placed on a vintage Hamilton Beach malt machine. "Fondue

a la Barbie” depicts Barbie heads in a fondue pot. “ Barbie Enchiladas” depicts four Barbie dolls wrapped in tortillas and covered with salsa in a casserole dish in a lit oven.

The Copyright Act, 17 U.S.C. s. 106, protects the owner of a copyright by granting him or her exclusive rights to “reproduce, distribute and publicly display copies of the work.” A prima facie case of copyright infringement by reproduction is established by showing ownership of the copyright by the plaintiff, and copying by the defendant. Mattel owns the copyright to the unadorned Superstar Barbie head, and parts of the figure including revisions to the hands, feet, neck, shoulder and buttocks. Because Furbish photographed the Barbie figure and reproduced these photographs, Mattel has established a prima facie case of copyright infringement.

In his memorandum in support of his motion for summary judgment, Furbish described the message behind his photographic series as an attempt to “critique the objectification of women associated with Barbie, and to lambaste the conventional beauty myth and the societal acceptance of women as objects, because that is what Barbie embodies.” He explains that he chose to parody Barbie in his photographs because he believes that “Barbie is the most enduring of those products that feed on the insecurities of our beauty and perfection-obsessed consumer culture.” Furbish claims that, throughout his series of photographs, he attempts to communicate thorough artistic expression his serious message with an element of humor.

Furbish’s market success was limited. He displayed his works at two art festivals. He promoted his works through a postcard, a business card, and a website. Furbish printed 2000 promotional postcards depicting his work, “Barbie Enchiladas,” only 500 of which were ever circulated. Of those that were distributed, some were distributed throughout his home town, Summersville, and some to a feminist scholar

who used slides of Furbish's works in her academic presentations. He also sold 180 of the postcards to a friend who owned a book store in Summersville so that she could resell them in the book store. He sold an additional 22 postcards to two other friends. Prior to this lawsuit, Furbish received only four or five unsolicited phone calls relating to his work. The "Food Chain Barbie" earned Furbish a total gross income of \$3,659, at least half of which was attributable to purchases by Mattel's investigators.

Furbish also produced 1000 business cards which depicted "Champagne Barbie." His name and self-given title, "Artsurdist," were written on the card. He used these cards at fairs and as introductions to gallery owners.

Finally, Furbish had a website on which he depicted low-resolution pictures of his photographs. The website was not configured for on-line purchasing. "Furbish Lousewort's Artsurdist Statement," in which he described his intent to critique and ridicule Barbie, was featured on his website.

Discuss Furbish's defense of fair use.

QUESTION FOUR

Review note 4 on pp. 837-8 in your casebook, "Copyright's influence on patent law: compulsory licensing."

For a variety of reasons, most patents are never commercialized. The reasons can include lack of adequate financing, absence of commercial value, or bad business judgment on the part of the inventor. But there are less benign reasons as well. Inventions may be deliberately patented as a matter of course, in case they turn out to be useful. Many biotechnology companies follow this practice. Inventions may be deliberately patented and then not used, in order to deny competitors the

opportunity that a new technological advance might present, even though the patentee does not intend to alter its equipment or production process in order to take advantage of the new invention. See Special Equipment Co. v. Coe, CB p. 815, 816 (Douglas, J., dissenting): “The right of suppression of a patent came into the law over a century after the first patent act was passed. . . . I think it is time to be rid of that rule. It is inconsistent with the Constitution and the patent legislation which Congress has enacted. . . .”

Commentators have long argued over whether suppression actually occurs, and whether it is an economically rational strategy. Nonuse of patents certainly occurs. Whether true suppression occurs has never been resolved. There is some evidence that products as obscure as artificial caviar and as important as photocopiers have been strategically shelved. A study of Bell Laboratories and magnetic tape recording documented Bell’s suppression of the Hickman patents covering magnetic recording, a practice that the author argues was pursued by AT&T to preserve markets and for “ideological reasons,” specifically the threat to privacy from recorded telephone conversations. Automobile manufacturers are charged with suppressing new auto anti-pollution technology in the 1970’s because they feared that they would be forced by government regulators to install the new devices. And, according to a rumor, manufacturers of panty hose are supposed to have suppressed their design for “no run” hose in order to maintain the lucrative market for short-lived, disposable, products.

In all of these cases (and numerous others) patents for the allegedly suppressed products existed. What is uncertain is why the products were never commercialized. The companies involved usually claim that the products did not, in fact, work as promised. Those claims are bolstered by the argument of economists that suppression

makes no sense. If a new invention is truly superior to current products, they argue, the patent holder could sell that invention and more than make up for any losses that it might sustain in the market for its current products. Indeed, economists argue, this is the definition of a superior product.

This argument has substantial force when the allegedly suppressed invention is in the same market as the patent holder's current products. Thus panty hose manufacturers could presumably switch from selling disposable hose to selling no-run hose and, assuming the no-run hose was really a better product, charge prices high enough to make up for the fact that they would be selling fewer pairs of hose. This argument is not completely convincing, however. If the process for producing no-run hose requires different machinery from that which the manufacturers currently use, there will be substantial fixed costs associated with the switch. Manufacturers may prefer to delay introducing the new product until the time when they have to replace their current machines anyway; they will suppress the invention until then. By suppressing the patent, therefore, the patent holder causes society to lose the benefits of immediate availability of the new invention. A documented example of this occurred in the rubber industry, when Standard Oil admitted in a 1942 consent decree to inhibiting the introduction of synthetic rubber. The reason was clearly to preserve its investment in natural rubber production processes.

In any event Congress, and the courts beforehand, have declined to forbid patent suppression. In 1988 Congress made this explicit by amending 35 U.S.C. s. 271(d)(4) (old statute) to protect nonuse.

Why do you think that Congress and the courts have rejected all remedies for patent suppression? What does this history tell us about American attitudes to patent law? What interest groups in this country, do you think, are responsible (as litigants

and as lobbyists) for maintaining the dominant position? What interest groups, do you think, have tried and failed to restrict patent suppression? Would you favor compulsory licensing as a remedy? Would you favor forfeiture for non-use? Share your thoughts.

END OF EXAMINATION

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PREAMBLE TO QUESTIONS ONE, TWO AND THREE

Standardized tests such as the Scholastic Aptitude Test ("SAT"), the Graduate Record Examination (GRE") and the Law School Admission Test ("LSAT") are anomalies of copyright law because they are economically exploited by the copyright owners but are not publicly disseminated. They conform neither to the copyright model of published works such as mass-market novels, for which economic exploitation coincides with public access to the work, nor to the copyright model of unpublished works such as private letters, which are neither economically exploited nor accessible to the public.

The Register of Copyright has, by regulation, permitted the copyright owners of standardized tests to deposit with the Copyright Office only the front and back covers of each copyrighted test. This exception to the usual requirement for deposit of two copies of the best edition of the work has been sustained in litigation, where it was held to be a valid exercise of the discretion conferred on the Register by Congress, and is therefore not an issue on these questions One, Two and Three. Excused, thus, from statutory disclosure, the copyright owners take every possible step to safeguard the secrecy of these tests, which in copyright lingo are known as "secure tests." The copyright owners serially number the test booklets, do not permit examinees to bring into the testing room any paper on which notes might be surreptitiously recorded, and do not permit examinees to leave the exam room without turning in their test booklets. Secrecy serves more than one objective for the copyright owners. Secrecy is, obviously, important to the integrity of each test administration. Over the longer term, the copyright owners argue, they would lose market share if their reputations for secrecy were compromised. They also admit to repeat use of exam questions, which would be made impossible if questions were publicly disclosed. They emphasize that repeat use of questions serves certain

purposes associated with test validation, but de-emphasize that repeat use of questions saves them the expense of developing more new questions for each exam.

The Law School Admission Council ("LSAC") owns the copyrights to all successive editions of the Law School Admission Test ("LSAT"). The LSAT is prepared for LSAC by Educational Testing Service, Inc. ("ETS"), of Princeton, New Jersey, under a contract by which ETS assigns all of its copyright rights to LSAC. ETS, in turn, solicits test questions and answers for the MBE from impecunious junior faculty members at colleges and universities, paying them \$100 for each question that is accepted by ETS.

Parties with an interest in disclosure of secure tests include companies that are in the business of preparing students to take the tests. Among these is Manley Klapman, Inc. ("Klapman"), a company that offers test preparation services to people who plan to take the LSAT. As a major marketing tool, Klapman administers a test called "Preliminary Law School Admission Test," or, as abbreviated, "Pre-LSAT" to prospective LSAT takers. Upon payment of a fee of \$10, any student or interested person can register to take the Pre-LSAT and receive a grade. The pool of registrants thus produced provides Klapman with a target audience, known by name and address, for the purpose of selling its \$2500 LSAT prep course.

QUESTION ONE
(suggested time: fifteen minutes)

LSAC sues Klapman for infringement of its unregistered trademarks "Law School Admission Test" and "LSAT" in connection with Klapman's Preliminary Law School Admission Test or Pre-LSAT.

What result? Why?

QUESTION TWO
(suggested time: thirty minutes)

For the purposes of its Pre-LSAT and, more importantly, for the purposes of its LSAT prep course, Klapman needs to develop questions that approximate, as closely as possible, questions actually used by LSAC on its LSAT. Therefore Klapman encourages graduates of its LSAT prep course to report anything of interest about the LSAT. Klapman keeps a computer data base of all such reports. Klapman goes further and encourages certain exam-takers to memorize five questions, as nearly as possible, to write them out immediately after taking the exam, and to turn them over to Klapman. Klapman pays the examination fees of these persons in exchange for their services. As a result of these efforts, and others, Klapman has developed banks of questions which are quite similar, indeed close to identical, to actual LSAT questions. Because of LSAC's use of repeat questions it is possible, even likely, that a graduate of Klapman's LSAT prep course will when taking the LSAT encounter questions which he or she has seen before, has studied, has discussed, and to which he or she has learned the correct answer.

LSAC sues Klapman for copyright infringement. Discuss the claims and defenses of the parties.

QUESTION THREE
(suggested time: forty-five minutes)

In 2009 the state of West Dakota enacted legislation called the Fairness in Standardized Testing Act ("FIST Act") in order to open the standardized testing process to public scrutiny. The FIST Act provides that within thirty days after the results of any standardized test administered in West Dakota are released, the testing agency must file, with the state's Commissioner of Education, a copy of the test questions and the corresponding acceptable answers to those questions. Once filed with the Commissioner of Education, the tests and answers are deemed "public

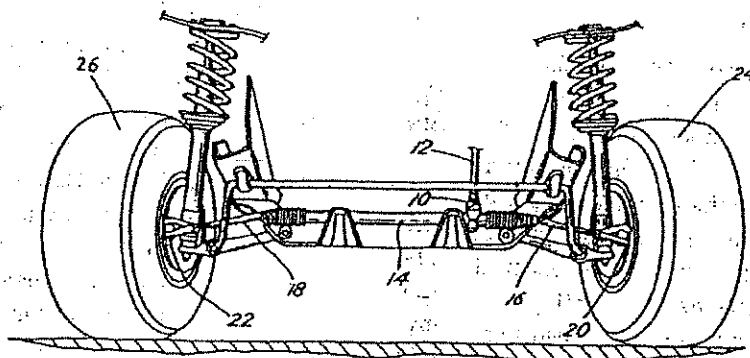
records," meaning that they may be inspected and copied by any member of the public. Finally, the FIST Act says that the testing agency must provide to the test-taker the opportunity to secure copies of the test questions and answers upon payment of a nominal fee.

LSAC sues the State of West Dakota claiming (1) that the FIST Act constitutes a seizure of LSAC's property without due process of law, (2) that the FIST Act facilitates infringement of its copyrights, and (3) that the FIST Act violates the federal Copyright law and is, therefore, preempted by s. 301(a) thereof and by the Supremacy Clause of the United States Constitution.

Discuss all relevant issues. Do not limit yourself to claims (1), (2) and (3) of LSAC's complaint, noted in the previous paragraph. Consider also the defenses that the State of West Dakota will raise in response to these claims, and the policies of American copyright law.

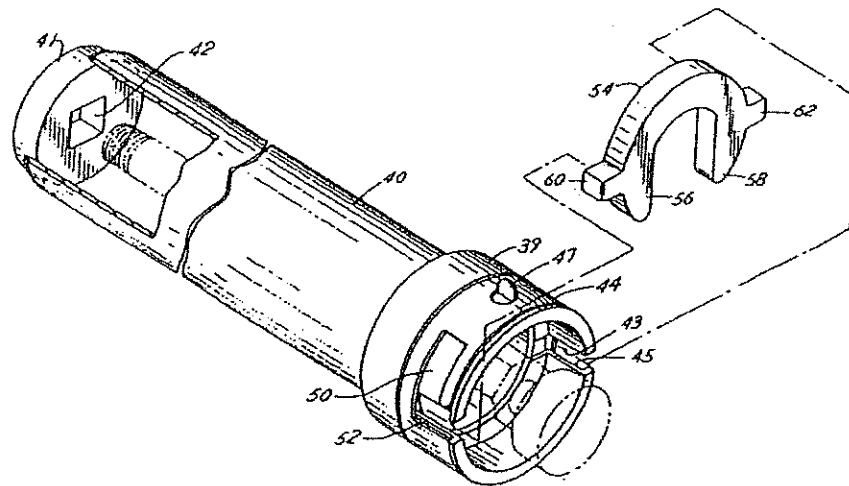
QUESTION FOUR (suggested time: forty-five minutes)

Most automobiles today are equipped with a rack and pinion steering control system. A component of the rack and pinion steering control system is a pair of inner tie rods (16, 18 in the drawing below). Servicing a rack and pinion system often requires removal and replacement of the tie rods. This can be a tedious procedure due to the location of the tie rods, the very confined working space on today's downsized cars, and the variety of fastener shapes holding the tie rods in place.



In 1999 Hartwrench Co. ("Hartwrench"), a designer and manufacturer of automotive tools based in Wheeling, Iowa (population 6000) became interested in developing an improved tie rod tool. On or about December 12, 1999, Hartwrench delivered a prototype of the tool to four different automobile repair shops in Wheeling. Hartwrench did not receive any payment for these prototypes. Hartwrench did not require any of the mechanics to enter into a formal confidentiality agreement and no restrictions were placed on the use of the prototype tool by the mechanics.

As ultimately developed and patented, the tool is shown in the drawing below:



The tool alleviates the need for automobile mechanics to completely dismantle steering control systems and to keep multiple tie rod tools for various inner tie rod designs. It is composed of two distinct parts, a C-shaped wrench disc (54 in drawing) and a hollow tube (40). The tool works by placing the wrench disc over the fitting that secures the inner tie rod (shown in the figure above by hatched lines) and then sliding the hollow tube over the tie rod which has been unbolted for this purpose. The user of the tool can readily engage or disengage the wrench disc from the body of the tool by rotating the retainer ring from an open position to a closed position and vice versa. The tool accomplishes its objective of replacing multiple tie rod tools by allowing a single tie rod tool to utilize wrench discs of varying

dimensions and shapes.

The inventor, Dan Williams, an engineer at Hartwrench, needed to know if the prototype tool would fit in the confined location of the tie rods in different automobile models. He and other engineers at Hartwrench contacted the mechanics who were given the prototype tool every two to four weeks by telephone or in person to receive testing feedback. Based on their input, Williams modified the design of the retainer in the prototype tool and added additional wrench disc sizes. However, no documentation was kept regarding the actual testing of the prototype tool.

Hartwrench made it a business practice to solicit suggestions from local mechanics and to place prototype tools into their hands for evaluation and improvement. The engineers at Hartwrench were personally acquainted with the local automobile mechanics and automobile repair shop owners. Hartwrench showed its appreciation for their input by selling Hartwrench tools to them at discounted prices or by giving tools as outright gifts. The local mechanics, obviously, were not a large enough market for automotive tools so Hartwrench also advertised in trade publications and rented booths at trade shows. At the trade shows Hartwrench displayed not only actual tools but also photographs of other tools. Among these photographs at a two-day trade show in Omaha, Nebraska, in April of 2001, were seven photographs of a prototype of the Hartwrench tie rod tool. The photographs were marked "under development." On advice of its patent counsel, Hartwrench did not repeat this display of photographs.

Not until June 26, 2002, thirty months after the prototypes were first put into the hands of the local mechanics, did Hartwrench apply for a patent on its final version of the tie rod tool. The patent was granted in July, 2006. Thereafter Hartwrench commenced the marketing and sale of its tie rod tool.

In the meantime a competitor, Rocket Socket Co. ("Rocket Socket"), began

marketing a tie rod tool so similar to Hartwrench's early prototype as to warrant an inference that its design had been copied from Hartwrench's. Upon issuance of the patent to Hartwrench, Hartwrench sued Rocket Socket for infringement. Rocket Socket denied infringement and counterclaimed seeking a declaration that Hartwrench's patent was invalid.

Assume that Hartwrench is able to prove patent infringement. Discuss Rocket Socket's claim of invalidity. Reach a conclusion on this claim.

QUESTION FIVE

(suggested time: forty-five minutes)

Elmark Corp. ("Elmark"), a manufacturer of medical supplies and equipment, sells a radioaerosol delivery kit to hospitals. The kit includes a patented manifold/nebulizer assembly and is used for lung scans with radio-labelled aerosols. Elmark also sells this device for use in administering drugs to patients, including pentamidine to AIDS patients. The device is sold under the registered trademarks "Elmark" and "UltraVent.

Elmark owns a total of five U.S. patents relating to the UltraVent, and at least one claim of each of the five covers a portion of the nebulizer and/or manifold. The top of the manifold is marked with the Elmark trademark and also with a legend that reads "Single Use Only." The bottom of the nebulizer is marked with the number of one of Elmark's patents. Neither the claims nor the specifications of any of the patents state that the nebulizer and/or manifold are for single use only or must be disposed of after such use.

However, the package insert that accompanies the UltraVent at the time of sale contains the following warning:

The UltraVent apparatus is protected by U.S. patents. The sale of this product to you grants you a license under the patents for single use only. Subsequent use constitutes infringement of the patents. Elmark, Inc., regards any re-use of this product as potentially hazardous and a violation of the license terms granted to you upon its sale.

The package insert also instructs that, after use, the apparatus must be disposed of in accordance with procedures for the disposal of biohazardous waste. The hospital is instructed to seal the used apparatus in a radiation-shielded container, supplied with the UltraVent, prior to proper disposal.

In 2006 a company called Rxpeat, Inc. ("Rxpeat") began recycling Elmarks's UltraVents. Rxpeat solicits business directly from the hospital purchasers of UltraVents. Its customers, after one use of the UltraVent, send it to Rxpeat for a reconditioning procedure. Rxpeat segregates the UltraVents by hospital and returns to each hospital the UltraVents which the hospital sent to Rxpeat, minus any broken or defective units. (Rxpeat disposes of broken or defective units in accordance with hazardous waste disposal protocols). The company has a license from the federal Food and Drug Administration to perform medical device recycling, and is in compliance with all relevant FDA regulations. Since commencing this line of business, Rxpeat has recycled approximately 14,000 UltraVents for 49 hospitals, and the company has received no complaints from any of its hospital customers about defective or unsatisfactory recycled UltraVents.

Elmark sues Rxpeat for patent infringement.

Discuss the claims and defenses of the parties. Do not fail to consider the validity of Elmark's claim to enforce a one-use-only policy on the purchasers of its patented product. Is this a sale of goods upon a condition regarding use of the goods

(perfectly OK as a matter of contract and sales law) or is it an unlawful attempt by Elmark to extend the monopoly of its patent? Consider patent policy as well as patent law.

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QUESTION ONE

Part A

(seventy-five per cent of this question)

In 1957 an ex-cowboy named McErrant began to participate in rodeos, horse shows, and parades. From the beginning he indulged a penchant for costume. He was already equipped with a black moustache. He soon settled on a black shirt, black pants, and a flat-crowned black hat. He affixed a St. Mary's medal to the hat. He adopted the name "Paladin" after an onlooker of Italian descent hurled an epithet at him containing the word "Paladino." On looking up the word Paladin in a dictionary McErrant found that it meant "champion of knights," which he liked. On another occasion, as McErrant was about to mount his horse, an onlooker called out "Have gun, will travel," a phrase that McErrant adopted as his personal slogan. The finishing touches were the silhouette of a chess knight which McErrant used on his business card (bearing the words "Have gun will travel, wire Paladin, Providence, RI"), a silver copy of the knight silhouette on his six-shooter holster, and an antique derringer strapped under his arm.

So accoutred, McErrant as "Paladin" would appear in parades, the opening and finales of rodeos, at auctions and at horse shows. From time to time at rodeos he would stage a western gunfight featuring his quick draw and the timely use of his hidden derringer. He would pass out photographs of himself and his business cards, some 250,000 cards in all. He happily accepted invitations to perform in all parts of the United States. Fame he sought but not fortune. He sold no product or service, charged no fees, and performed only for the entertainment of himself and others.

Ten years after he had begun to live his avocational role of Paladin, McErrant saw the first CBS television production of the series “Have Gun Will Travel” starring mustachioed Richard Boone, who played the part of an elegant black-clad knight of the Old West, always on the side of the good—for a fee. The television Paladin also wore a flat-crowned black hat bearing an oval silver decoration, had a silver chess knight on his holster, and announced himself with a card bearing a chess piece and the words “Have gun, will travel; wire Paladin, San Francisco.” The television series went on to be notably successful, appearing in 225 first-run episodes.

Discuss McErrant’s intellectual property rights, if any, against CBS.

PART B

(ten per cent of this question)

Suppose that, upon first learning of CBS’s “Have Gun Will Travel” television series, McErrant applied to the Patent and Trademark Office (“PTO”) to register the following mark:



CBS opposes McErrant’s application for registration. What result? Why?

PART C

(fifteen per cent of this question)

Suppose that, notwithstanding CBS’s opposition, the PTO registers the above mark in McErrant’s name. How, if at all, will this change your answer to Part A, above? Explain. If the answer is “not at all,” explain why not.

QUESTION TWO

International Newslines, Inc., publishes “abstracts” of newspaper articles from around the world, both in hard copy and in internet editions. About one third of the abstracts are rewrites of articles originally prepared by Nippon News Service written in Japanese. These articles deal with financial, business and industry news subjects. Nippon News sells its articles in both the original Japanese and in English translation. The English versions are made available by license through wire services, an English language website, and on American online news services.

International Newslines editors select articles and forward them to “abstractors,” who translate them from their original language, condense them to about one half their original lengths, and edit them into a consistent style. It takes an abstractor thirty-six minutes on average to convert a news article into an International Newslines abstract. International Newslines abstracts taken from Japanese versions of Nippon News articles are headed by a byline stating “abstracted from Nippon News,” followed by the date of original publication.

In July, 2008, Nippon News Service began to register its articles with the U. S. Register of Copyrights. Since 1985 it has had a U. S. Registration of its trademark, Nippon News. In November, 2008, it filed suit in federal court against International Newslines for copyright infringement, trademark infringement, and common law misappropriation.

International Newslines admits that its abstracts are condensations of Nippon News Service articles. In addition, the evidence shows the following:

1. The abstracts recite most of the facts disclosed in the original articles.

2. The abstracts usually have the same organization as the original articles.

3. The facts in the abstracts usually have the same chronological and substantive grouping as the original articles. The abstracts track the information in the original articles in sequence. Only occasionally do the abstracts combine two sentences from the original articles, divide a sentence, or rearrange the facts among different sentences.

4. The abstracts usually reach the same conclusion as the original articles.

5. The abstracts often employ identical phraseology and word selection as the original articles.

6. Often the abstracts are direct translations from the original articles, edited only for clarity and condensation.

International Newslines abstracts compete with Nippon News Service articles in the same English language print news service and online news service markets..

Should the court enjoin International Newslines from continuing to prepare abstracts based on Nippon News Service articles? If so, on what basis should the injunction be granted and what should be the scope of the injunction? Should the court grant damages for the past preparation of those abstracts? If so, how should the damages be calculated? Should the court enjoin International Newslines from referring to the Nippon News trademark? If so, on what basis should the injunction be granted and what should be the scope of the injunction? Discuss all relevant issues, but be sure to come to conclusions to the questions posed in this paragraph.

QUESTION THREE

Middlesex Packing Company (“Middlesex”) developed a process for making and freezing precooked sausage for pizza toppings. Middlesex’s product had the appearance, taste, and other characteristics of freshly cooked sausage. It surpassed other precooked products in price, appearance, and taste. This process and the equipment needed to produce it in commercial quantities were perfected by April 10, 2001. However, Middlesex did not sell any frozen sausage made by this process for some time because it could not find any buyers. At no time did Middlesex publish any information about its new process. Its employees were cautioned several times not to discuss this new process with anyone outside Middlesex’s premises.

On September 13, 2004, Middlesex entered into a written agreement with Mama Monopoli, Inc. (“Mama”), a franchise chain of pizza restaurants, to sell frozen precooked sausage to Mama. Shipments began on January 1, 2005. Mama agreed to make these purchases on condition that Middlesex disclose its process to several others of Mama’s suppliers, to assure that backup supplies would be available in case Middlesex could not supply all of Mamas’s needs. In exchange, Mama agreed to buy a large minimum quantity of frozen precooked sausage from Middlesex for an indefinite period at a price fixed in the contract.

Pursuant to this agreement Middlesex disclosed its process to several of Mama’s suppliers, subject to a confidentiality agreement with each of them. (Middlesex never disclosed its process to anyone else). Middlesex also leased its specialized equipment to these suppliers and invested \$4.5 million in a new plant to

meet Mama's needs. By early 2007, Mama's other suppliers had learned how to duplicate Middlesex's results. At that time, Mama told Middlesex that it would not purchase any more sausage without drastic price reductions. Middlesex refused to sell its product to Mama at less than the contract price. Mama then gave notice that it would refuse to accept shipments after July 1, 2007.

One of Mama's largest suppliers was Essex Packing Co. ("Essex"), up to that time selling meat products other than sausage and not one of the suppliers with which Middlesex had shared its technology. Mama gave Essex its specifications for formulation of sausage toppings. After signing a confidentiality agreement, Mama transferred information to Essex about the sausage process. Essex hired a former supervisor in Middlesex's plant sausage to be its production superintendent. Five months later, after Essex had established its sausage-making process, it fired that employee. By late 2007 Mama was buying most of its frozen precooked sausage from Essex.

On August 5, 2006, Middlesex had filed applications for patents on its specialized equipment and on the sausage-making process itself. In 2009 it was awarded a patent on its equipment and another patent on the process.

Following the award of the patents Middlesex sued Essex for infringement of its equipment and process patents. It also sued Mama for indirect infringement (but not for breach of contract). Essex and Mama counterclaimed claiming that Middlesex's patents were invalid.

Should the court grant Middlesex relief on its patent infringement claims? Should the court grant relief on any other grounds? What other grounds would be available? Is Middlesex's patent valid? Discuss all relevant legal issues, and state your conclusions.

QUESTION FOUR

Review Harper & Row v. Nation Enterprises, casebook p. 430.

Justice O'Connor's majority opinion seems to hold that the copyright-holder's right not to publish is of equal stature with the copyright-holder's right exclusively to publish. Does the Supreme Court have the correct calculus when the copyright-holder is seeking, not to time the market (as was the publisher Harper & Row) but, rather, to prevent publication altogether?

Consider the Church of Scientology. Scientology is a body of beliefs and related practices founded by L. Ron Hubbard (1911-1986), starting in 1952, as a successor to his earlier self-help system, Dianetics. Hubbard characterized Scientology as a religion and in 1953 incorporated the Church of Scientology in New Jersey. Scientology has been surrounded by controversies since its inception. It has often been described as a cult that financially defrauds and abuses its members, charging exorbitant fees for its spiritual services.

Scientology is known for (1) its secretiveness and (2) its litigiousness. The latter reinforces the former. On many occasions Scientology has sought by litigation to suppress hostile criticism. Among the arrows in Scientology's litigation quiver is copyright protection.

A Danish corporation about which little is known, but which may fairly assumed to be under the control of the Church of Scientology, holds the copyrights to all of L. Ron Hubbard's works, published and unpublished. These are multitudinous. In 2006 the Guinness Book of World Records identified Hubbard as the world's most published and most translated author, having published 1,084 fiction

and nonfiction works that have been translated into seventy-one languages. The copyright-holder has regularly sued to prevent writers hostile to Scientology from quoting materials from Hubbard's works and other Scientology writings.

Two hostile biographies of Hubbard, advocating generally that Hubbard was a charlatan and that Scientology is a dangerous cult, generated litigation in the Southern District of New York and the United States Court of Appeals for the Second Circuit in the 1980's. In both cases the authors claimed that the best evidence of Hubbard's mendacity was his own writings, which the authors quoted extensively. The Scientologists sued to enjoin publication of these excerpts as copyright infringements. The authors sought to justify their use of copyrighted material as warranted because of the public interest in Scientology and because they were used "in the interest of accuracy, not piracy." The resulting litigation occasioned so much disagreement among the judges, especially those of the Second Circuit, as to warrant a conclusion that there is no judicial consensus on the question posed in the first paragraph, above. (Disagreement continued outside the judicial arena. No fewer than four Second Circuit judges published law review articles to justify their divergent views).

What do you think? Should copyright extend to the right to disable hostile criticism? Is it possible to reconcile the rights of copyright with the need to quote copyrighted material that historians, critics, and journalists believe is essential to their work? Write an essay supporting your view, with reference to material studied in this course.

INTELLECTUAL PROPERTY

Mr. Martin

December 11, 2008

Social security no. _____

FINAL EXAMINATION

This is an open book examination. You may use any materials which you have brought with you whether prepared by you or by others. Questions will be weighted in accordance with the amount of time suggested for each question. All questions are to be answered in one or more blue books.

Please write legibly, begin each question on a new page, and leave a margin on the left-hand side of the page.

Use only your social security number to identify your blue book or blue books. If you use more than one blue book, identify each one ("No. 1 of 2," "No. 2 of 2," etc.), make sure that your social security number is on each one, and insert all others into the first one.

Because one or more students will be taking this examination on a deferred basis, you must turn in this white examination paper along with your blue book or blue books. This is a temporary measure for examination security only, and the examination paper will be returned to you upon request after all students have completed the examination.

**ALL BLUE BOOKS MUST BE RETURNED AT THE END OF THE
EXAMINATION.**

LABEL ANY SCRAP BLUE BOOK WITH THE WORD "SCRAP."

QUESTION ONE
(suggested time: fifteen minutes)

What is the maximum term of protection allowed by current United States law for each of the following?

- a. Patent;
- b. Design patent;
- c. Copyright;
- d. Trademark (common law);
- e. Trademark (registered).

What explains the very large differential among the answers to the above question?

QUESTION TWO
(suggested time: fifteen minutes)

Your instructor has a friend who grew up in the North End of Boston in a family that for two generations owned a neighborhood bar. My friend tells many funny stories about the patrons of the bar. It opened early in the morning. Some patrons would arrive every day when the bar first opened to enjoy a little eye-opener. When I heard about this practice I thought of a terrific invention.

My invention resembles a jelly doughnut except that in the middle, instead of a shot of jelly, there is a shot of bourbon. I have patented this invention and the process by which it is produced. (The trick is to insert the bourbon after the doughnut has been fried; otherwise heat will vaporize the alcohol). I plan to market this

product exclusively to licensed purveyors of alcoholic beverages under the name “Drunken Doughnuts.”

From an intellectual property perspective, do I have anything to worry about?

Suppose that I sharply distinguish my product from Dunkin’s with different packaging, different color scheme, different typeface, different marketing (no sales directly to consumers) and a disclaimer such as the following: “A product of THM Corp. This product has no connection to the Dunkin’ Donuts Co.” Do I still have anything to worry about?

QUESTION THREE

(suggested time: forty-five minutes)

Part A. (seventy per cent of this question)

Famed artist Saul Steinberg sued Columbia Pictures Corp. (“Columbia”), producers of the movie “Moscow on the Hudson,” in federal court, alleging copyright infringement.

Steinberg alleged that Columbia’s promotional poster for “Moscow on the Hudson” infringed his copyright in an illustration which he drew for The New Yorker magazine and which appeared on the cover of the March 29, 1976, issue. On the next, fold-out, page of this examination you will see (reproduced from another casebook) Steinberg’s illustration and the allegedly infringing poster.

The essential facts were not disputed. Steinberg’s illustration is widely known as a parochial New Yorker’s view of the world. The New Yorker registered its copyright with the United States Copyright Office and subsequently assigned the copyright to Steinberg. About three months later, Steinberg and the magazine entered into an agreement to print and sell 100,000 copies of the illustration in poster form.

It was undisputed that unauthorized duplications of the poster were made and distributed in unknown numbers by unknown persons. Steinberg conceded that numerous posters had been made and published depicting other localities in the same manner by which he depicted New York City in his illustration. In deposition testimony the artist who created Columbia's poster acknowledged that he had seen Steinberg's illustration; in fact, he testified, it was hung (in poster form and along with other posters) in the office of the movie's art director.

Columbia denied infringement and asserted the affirmative defenses of fair use as a parody, estoppel, and laches.

Steinberg moved for summary judgment in his favor. Columbia cross-moved for summary judgment in its favor. The judge acknowledged that summary judgment is disfavored in copyright infringement cases but noted that neither party had requested a jury trial and so he (the judge) would be the trier of fact at trial. Finally, he observed that "[t]he voluminous submissions that accompanied these cross-motions leave no factual issues concerning which further evidence is likely to be produced at trial." Accordingly the judge entered summary judgment.

For which party? You decide. Explain your decision.

Part B. (ten per cent of this question)

Assume that Steinberg prevailed. How will his damages be calculated?

Part C. (ten per cent of this question)

Steinberg also sued many newspapers which had printed Columbia's illustration as a display advertisement for the movie. Assuming that Steinberg prevailed against Columbia, will he be entitled to damages from the newspapers?

Part D. (ten per cent of this question)

As noted above, Steinberg's illustration has encouraged many imitators to create comparable scenes involving other localities. Your instructor has seen a "Boston" version that is a view to the west from a high-rise building in the Back Bay. Cambridge is prominent in the foreground, Worcester is located in the middle distance, the Berkshire hills are on the horizon and, beyond the horizon, there are the tops of some tall buildings which might be in Chicago or Singapore. New York City is postage-stamp-size in the lower left-hand corner, apparently to make the point that Bostonians are even more parochial than New Yorkers.

Why is the "Boston" poster not an infringement of Steinberg's copyright?

QUESTION FOUR

(suggested time: forty-five minutes)

Fortunately for the student, not all patent cases require insight into complicated technology. Consider paving with precast concrete blocks, called "pavers" in the trade.

The ancient Romans were great road builders. They perfected the art of paving using cut stone blocks. Paving with red clay bricks has also been practiced for centuries. Paving with precast concrete pavers has been commonplace for at least the last hundred years. Is there anything new in the world of pavers?

Pat secured a patent on a precast concrete paver described in the principal patent claim as follows:

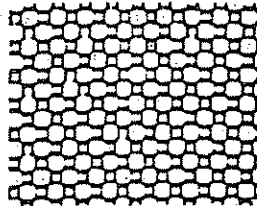
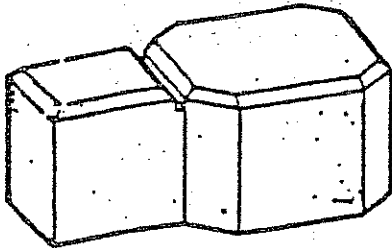
GO ON TO THE NEXT PAGE

9. Ground covering slab elements for paving ground areas, each of said elements being a single piece of concrete consisting of a head portion and a stem portion meeting at a dummy groove allowing, but not necessitating, breakage of said slab elements into heads and stems along said dummy grooves and being delimited by two opposite end faces of equal length joined by opposite sides that form angled traces about a longitudinal axis common to said head and said stem, each said angled trace being formed by a succession of sides comprising at said head an inclined side face inclined at 45° in one direction relatively to said axis, a lateral side face extending lengthwise with respect to said axis, and another inclined side face inclined at 45° in the opposite direction with respect to the said axis, and comprising at said stem a lateral side face extending lengthwise with respect to said axis, each said lateral face of said stem being complementary to a lateral face of

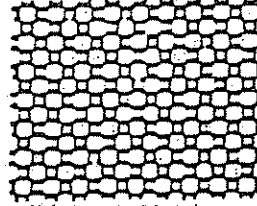
said head, said end face of said head together with said inclined sides of said head and said lateral faces of said head and said dummy groove describing a centrally symmetrically [sic] octagon, said dummy groove together with said end face of said stem and said lateral faces of said stem being symmetrical about the center of said stem, and said head and said stem being mirror symmetrical about said longitudinal axis, wherein said end face of said head, said lateral faces of said head, said inclined sides of said head and said dummy groove together describe an octagon, with equal lengths of said end face, said lateral faces and said dummy groove, and with equal lengths of said inclined sides of said head, wherein said inclined sides of said head are each shorter than said end face of said head.

This is one of those occasions on which a picture is worth many words:

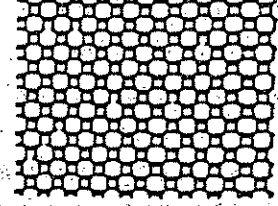
Pat's paver



HEFFINGBONE PATTERN

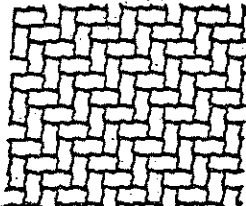
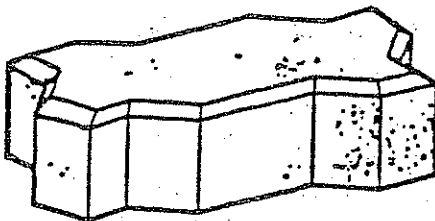


PARQUET PATTERN

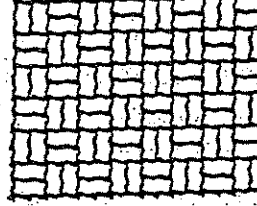


RUNNER BOND PATTERN

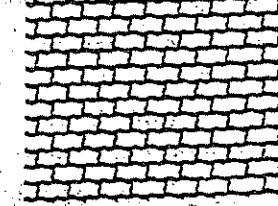
Unpatented commercial paver



HEFFINGBONE PATTERN



PARQUET PATTERN



RUNNER BOND PATTERN

Pat describes the advantages of Pat's paver as combining the feature of structural strength obtained from an elongated interlocking paver with the aesthetic and practical feature that, no matter how the asymmetric paver is laid, the effect is the same symmetrical pattern.

The manufacture of precast concrete products is everywhere a local business because of the cost of transportation relative to the purchase price of the products. (It has been said that, if you live more than twenty-five miles from the nearest place where such products are made, you can go into the business and make money). Pat, therefore, did not manufacture his paver. Instead he licensed the patent to local manufacturers. Pat's paver proved to be a solid commercial success wherever it was sold. It naturally attracted the interest of infringers. One of the infringers, Mike, started a declaratory judgment action in federal district court seeking to invalidate the patent. Mike's lawyer conceded to the judge that, if the patent was valid, Mike and a lot of other local precasting companies were infringers, saying "The patent has been copied. Half the industry are licensees. The other half are fighting this patent."

Following a bench trial, the district judge found the patent invalid for obviousness, lack of novelty, and inequitable conduct.

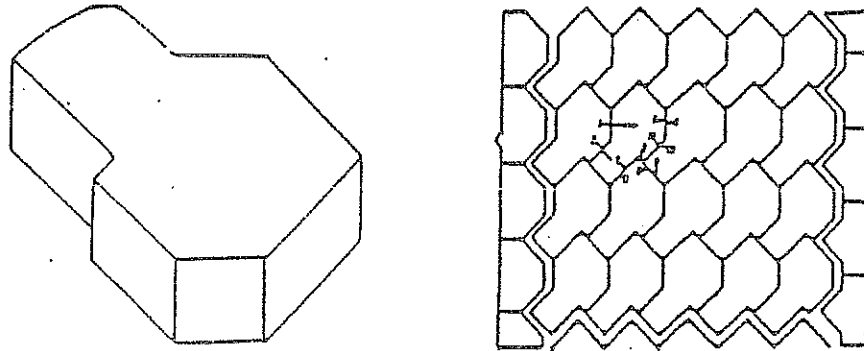
Obviousness. The trial judge found:

The prior art discloses pavers that are square. The prior art discloses pavers that are hexagonal and that are octagonal. The essence of the advance made by Pat's paver is to accomplish with one piece of concrete that which could be accomplished with one square piece and one octagonal piece by joining the square to the octagon.

Novelty. The trial judge found:

Pat's paver gives no significant structural advantage over other pavers. There is no evidence that Pat's paver results in a stronger or more durable pavement surface than other pavers.

Inequitable conduct. The trial judge found that Pat was guilty of inequitable conduct because Pat's patent application, although it disclosed seven German patents as references, did not disclose an eighth, Geb. '249, for a paver shaped as follows:



The evidence showed that Pat's German patent-searching attorneys identified nine German references and one Austrian one. They forwarded to Pat's American patent-searching attorneys drawings of seven of the ten. One of the three missing drawings was Geb. '249. When the American firm asked the German firm why it had not sent the three drawings, the German firm replied only, "This was not deemed necessary."

Pat appealed from the district court to the United States Court of Appeals for the Federal Circuit. Write the appellate argument for Pat.

You may be encouraged by the knowledge that, in the real case from which this question is adapted, "Pat's" lawyers were successful. The Federal Circuit reversed the district judge.

GO ON TO THE NEXT PAGE

QUESTION FIVE
(suggested time: forty-five minutes)

Patent and copyright cases usually begin with the initial question whether the invention or the work was patentable or copyrightable in the first place. In a patent infringement case, the first defense will be that the plaintiff's patent is invalid and never should have been issued by the PTO. As we have seen, this defense is successful in a surprisingly large number of cases. In a copyright infringement case, the first defense will be that the plaintiff has no valid copyright in the work allegedly infringed.

Should the initial decision about patent or copyright validity be made by the judge alone, or submitted to the jury under proper instructions? There are cases holding both ways. Courts have assumed that the Seventh Amendment does not preclude an initial decision about validity by the judge alone as a matter of law.

A well-respected federal district judge (and former law professor), Robert E. Keeton of the District of Massachusetts, had this to say in a case about alleged software infringement:

The legal test for determining copyrightability. . . is a standard requiring an evaluative mixed law-fact determination, as distinguished from a bright-line rule calling for a finding about disputed historical facts such as who did what, where and when. Moreover, this standard is far more heavily loaded with public policy implications than most other standards more commonly used in law, of which the negligence standard is an example. Juries applying the copyrightability standard would not be required or even permitted to explain their reasoning. They would be free as a practical matter to reach decisions inconsistent with the balance struck by Congress, as interpreted by the courts. . . .

For all of these reasons, I reach the tentative conclusion. . . that at least in the circumstances of this case (and probably more generally, though I need not so determine here), the issue or issues of copyrightability, including any fact questions bearing upon them, must be determined by the court, not the jury.

(Note that the same words could be written about “the issue or issues of patentability, including any fact questions bearing upon them”).

Discuss what Judge Keeton means by “public policy implications” and “the balance struck by Congress, as interpreted by the courts.” Illustrate your discussion with examples drawn from the patent and copyright cases and materials which you have read.

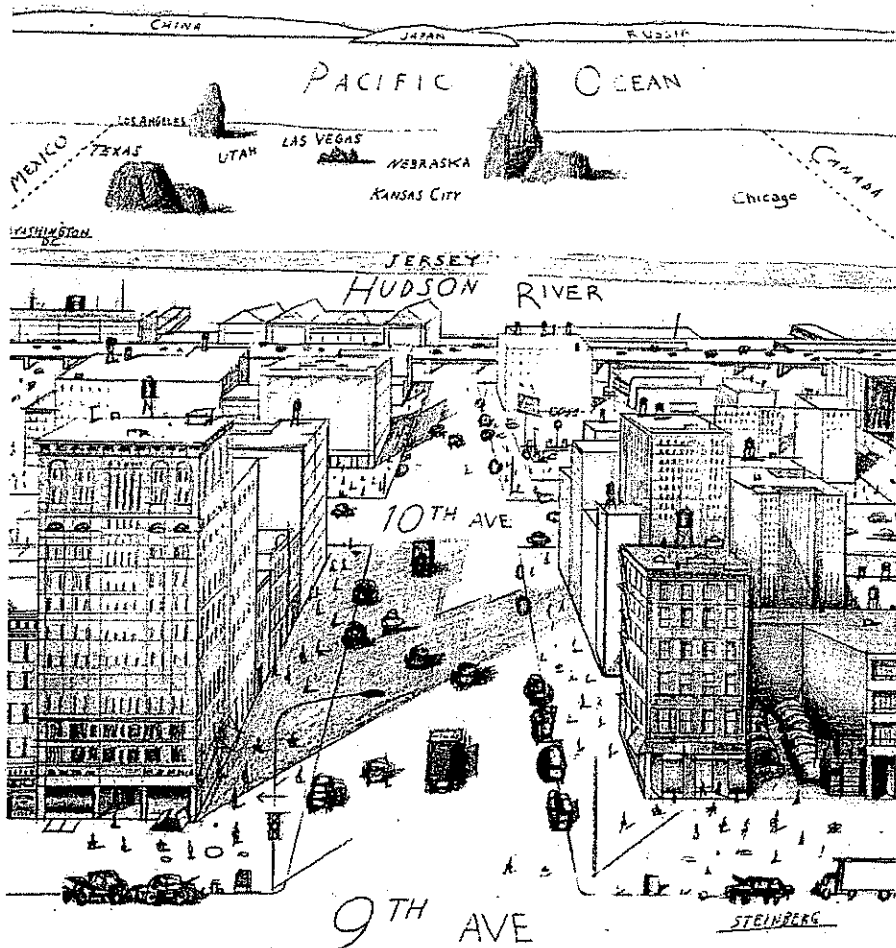
You are not being asked whether it is better that the issue of patentability or copyrightability be decided by the jury, or by the judge, so do not digress into this discussion nor into consideration of the Seventh Amendment.

QUESTION SIX
(suggested time: fifteen minutes)
(this question will not be graded)

Your instructor, teaching this course for the first time, praises and thanks all of you for your classroom contributions and asks you for one more contribution. Please use the final fifteen minutes of the examination to note two or three suggestions by which it could be improved in a future year. Thank you.

Have a good holiday season and enjoy your well-earned respite from the study of law.

THE NEW YORKER



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MOSCOW ON THE HUDSON

America is sometimes a strange place even for Americans.
 Let alone for Vladimir Ivanoff, a Russian defector with a black roommate,
 a Cuban lawyer and an Italian girlfriend.
 Who's learning to live with Big Macs, cable TV, hard rock, softcore,
 unemployment and a whole new wonderful word for him.
 Freedom.



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