

Introduction to Intellectual Property
Professor Ohm

Spring 2006
Final Exam Grading Rubric

What follows is the (slightly modified) grading rubric I created and used for grading final exams in Spring 2006.

The heart of the document is a detailed outline listing almost every possible issue that could have been spotted in my exam questions that semester. In the right column of the rubric, I specified how many points were available for each particular issue. Some issues were worth one point, meaning the student got the point for noting the issue or didn't otherwise. Other issues (usually issues that demanded a lengthier analysis) were worth more than one point, and in those cases I used a somewhat subjective (but hopefully consistent) assessment to decide how many of the available points a particular answer earned. In some cases, an issue was worth one or more points and a sub-issue of that issue was worth one or more additional points. For example, students were awarded one point for noting that Copyrights need to be valid, and one additional point each for discussing the Originality and Fixed in a Tangible Medium requirements.

The answers are divided into subtopics, and the Subtotal for each subtopic is underlined.

- **Problem One: American Idol v. American Idle**
 - **TOTAL SCORING RUBRIC:**
 - **Copyright: 29**
 - **Trademark: 19**
 - **Dilution: 12**
 - **TOTAL POINTS POSSIBLE: 60**
 - **Copyright (POINTS: Prima Facie: 14 + Fair Use: 15= 29).**
 - **Discussion of list of Possible Works (3) 3.00**
 - **Two basic approaches (either acceptable):**
 - One: Focus on "the show" as a unitary copyrighted work, one with lots of components.
 - Two: Focus on different "aspects" of the show as individual copyrighted works.
 - **Possibly copyrighted "aspects" of the Idol show (for either approach)**
 - The performances themselves
 - The judges' assessments
 - The set design
 - **Valid Copyright? (1) 1.00**
 - **Original? (1) 1.00**
 - Absolutely
 - **Fixed (1) 1.00**
 - Presumably so, although it's not in the facts. IDOL is a "Live" show, so it's possible that it's not recorded by the producers. This is pretty unlikely, but if it were true, IDOL could not sue.
 - **Idea-Expression**
 - See discussion under the Misappropriation prong of infringement.
 - Points available if this discussion is found in either place.
 - **Infringement? 3.00**
 - **Copied? (3)**
 - **Would be conceded. No need to march through factors. If they want to discuss the factors, they are:**
 - Access?
 - Yes.
 - Substantial similarity?
 - Can use experts and dissection. Here, no problem. (Particularly because of clips, but even without).
 - **Wrongful appropriation? (5) 5.00**
 - **From point of view of ordinary viewer.**
 - **Clips**
 - Clearly appropriated.
 - **Everything else?**
 - Were these things idea or expression? (Think Steinberg)
 - Set design; Not appropriated. Facts state a mere "passing resemblance."

- Performances?; Not appropriated. Mere caricatures. Probably varied wildly.
- Judges' Comments? Not appropriated. Just the "idea" is taken.
- **Conclusion**
 - **Yes. Infringement.**
- **COPYRIGHT PRIMA FACIE** **14.00**
- **Defense: Fair Use**
 - **I: Nature of Use (1) (element weighs for D or perhaps for nobody)** **1.00**
 - **Transformative Parody (1)** **1.00**
 - Policy: Doctrine has been interpreted to favor transformations (1) **1.00**
 - **Commercial (1)** **1.00**
 - Absolutely. Ad banners, tip jar, and t-shirts.
 - Sony says "presumption" but Campbell cuts back for Parody. Doesn't hurt D.
 - **II: Nature of Copyrighted Work (1) (for neither)** **1.00**
 - **Creative.**
 - Usually cuts in favor of P.
 - **BUT for Parody, this is almost never weighed since people don't create parodies of factual nonfiction. (1)** **1.00**
 - **III: Amount Taken (3) (for neither)** **3.00**
 - **Clips -- 30 seconds of 2-3 minute pieces**
 - The heart? Debateable
 - The song selection? (Taken)
 - The judges assessment? (facts state that these are the "true stars of the show") (Not Taken)
 - The performances (Taken)
 - For parody: You have to take the heart. (1) **1.00**
 - So: 1/4 to 1/6 of the songs were taken and none of the judges' commentary was taken.
 - **IV: Market Effect (1) (for D, because parody)** **1.00**
 - **Framing Q: Will IDOL viewers watch IDLE instead? (1)** **1.00**
 - Will viewership actually drop?
 - Will Clips keep people from watching the show?
 - **For parody: Doubtful. As in Campbell, the point of the "show" is different. (1)** **1.00**
 - Those who watch IDLE only are probably not "Fans" in the first place. (You can disagree with this point and still get full points).
 - **Creative argument available that this is time shifting (1)** **1.00**
 - Sony. BUT -- slightly different since it's not the user who is doing the shifting.
 - **Affect market for derivatives? (1)** **1.00**
 - Is there a market for derivatives of TV shows?
 - Not really. Not like Campbell in this regard. (Songs are covered; tv shows usually aren't).
 - **FAIR USE Subtotal** **15.00**

- **Overall Conclusion**
 - **Would probably be infringement, except for fact that it is a fair use, especially b/c parody.**
- **Trademark (POINTS: Valid 7 + Sleekcraft 6 + SleekDress 3 + SleekCatch 3 = 19)**
- **Valid Marks? (3) 3.00**
 - **Title: American Idol (1) 1.00**
 - These word marks are Descriptive or Suggestive.
 - Secondary Meaning?
 - Not directly in facts.
 - But presumably tons. Tens of millions of people tune in. (1) 1.00
 - **Trade dress of the show--the set. (1) 1.00**
 - Turns on Samara -- is this product design or product packaging or tertium quid?
 - Inherently distinctive?
 - Under two pesos, probably; "glitzy, elaborate, shimmering"
 - Then again, is this just standard for TV talent shows?
 - Secondary meaning?
 - Unclear. Like discussion above for the name of the show, but even less likely to be the part with secondary meaning; no idea whether people recognize it.
 - **Catch-phrase (1) 1.00**
 - Not terribly distinctive.
 - Certainly not generic and certainly not arbitrary or fanciful.
 - **NOTE: In the Spring semester, we did NOT cover the trademark use doctrine, which may have been another means for finding no infringement with the trade dress of the show.**
 - **But even under the doctrine, seems that the T-Shirt and Performances are trademark uses.**
 - **Infringed? Likelihood of confusion?**
 - **Again: Threshold point: Parody.**
 - This isn't an absolute defense, but it influences the factors
 - **IDOL -- Sleekcraft factors (5) 5.00**
 - Strength of the Mark (for D, slightly)
 - Not so strong. Close to "descriptive" line.
 - Proximity of the Goods (for D)
 - Far apart. (some facts missing): Commercial TV vs. Internet
 - Similarity of the Marks (for P)
 - Under sight/sound test -- pretty similar. (necessary for parody?)
 - Actual Confusion (unknown)
 - Marketing Channels Used (for D?)
 - Likely different. (not enough facts)
 - Type of Goods and Degree of care (for P)

- Probably high; You only select some shows to watch out of tons. (contra: channel surfing is mindless).
- Intent of D (for D?)
 - Clearly intentional mockery (Parody)
 - BUT, not intentionally trying to steal customers. (but 30-second clips loom large as bad fact for D)
- Likelihood of expansion of product lines (for P)
 - Perhaps. IDOL may want to put clips on web. They may already do.
- Conclusion: Either Way
- Likelihood of Confusion for Trade Dress (3) 3.00
 - No likelihood of confusion. The set has a "passing resemblance." (No additional points for marching through factors.)
- Likelihood of Confusion for Catch-phrase (3) 3.00
 - Similar to IDOL, so probably should point to earlier analysis.
 - Factors that are better for D
 - Strength of mark -- very weak.
 - Similarity -- pretty fundamentally different.
 - T-shirt market is further from TV market.
 - Factors that are different, but still good for P
 - Expansion of product lines
 - Maybe IDOL will want to go into the T-shirt market.
- Defenses
 - None worth discussing.
- Likely outcome.
 - For D (because Parody).
- TRADEMARK 19.00
- Trademark Dilution (POINTS: 12)
 - Same three marks as for TM
 - Are any FAMOUS enough? (3) 3.00
 - On these facts, the only one worth discussing is American Idol.
 - Pretty famous. But probably not the level described in the cases.
 - Distinctive? (1) 1.00
 - As above -- somewhat distinctive.
 - BUT, maybe not inherently.
 - Commercial use in commerce? (1) 1.00
 - Absolutely.
 - Tarnishment (1) 1.00
 - yes. Obscenities. Harshly critical of the performances.
 - Blurring (1) 1.00
 - Maybe.
 - Actual Harm (1) 1.00
 - Not presented on facts. Unsure of what this test is.

- **Defenses (3)** 3.00
 - **Parody; Kozinski/Barbie/Noncommercial Use**
 - This does more than merely proposes a commercial transaction.
 - **Conclusion**
 - **No dilution because of parody/noncommercial defense or lack of fame.**
 - **Dilution** 12.00
- **Problem Two: 3M vs. 3P (Post-It Flag vs. Sticky Mark)**
 - **TOTAL SCORING RUBRIC**
 - **All-Elements: 4**
 - **Claim Construction: 7**
 - **Literal Infringement Applied: 3**
 - **DoE: 6**
 - **PHE: 6**
 - **TOTAL POINTS POSSIBLE: 26**
 - **Literal Infringement**
 - **All-Elements Rule (3)** 3.00
 - **Articulated: Does the alleged infringing device (Sticky Mark) possess every element of the claim?**
 - **Break Claim into Elements**
 - Many ways to do this.
 - 1. Small; 2. Clear; 3. Flexible; 4. Paper or paper-like material; 5. Top; 6. Bottom; 7. Coated with lightly-binding adhesive on one edge.
 - **Elements Likely in dispute (1 must raise at least three of these)** 1.00
 - Small (1) Clear (2) Flexible (3) Paper or paper-like (4) and lightly-binding adhesive (5).
 - **All-Elements** 4.00
 - **Claim Construction (5 - nobody will have all, but 5s still possible)** 5.00
 - **Test: At the time, what would the term mean to someone of ordinary skill in the art?**
 - **Question of Law -- Markman Hearing**
 - **Phillips: Sources (1)** 1.00
 - Intrinsic: Claims; Spec; File Wrapper
 - Extrinsic: Dictionary; Experts; Treatises, Books
 - **Ordinary Skill in the Art? (1) (Paper inventors)** 1.00
 - **Small**
 - Likely result: Prosecution History / Specification and Prior Art all suggest "Small" means at least "Smaller" than a note. (but how much smaller?)
 - Fewer points if you try to affirmatively say where 2x Flag fits.
 - **Clear**
 - Question: Is "somewhat opaque" and "partially obscured" clear? Or: Does clear mean "totally clear"?

- Spec and Prosecution History might be of some help. (Do they emphasize ability to read text?); Dict and experts helpful too.
- **Flexible**
 - 3P Device: What is "film"? What is "thin plastic"?
 - How thin? Does it bend? We know it won't rip or crease. Maybe not so flexible or paper-like?
 - Pat: How flexible is flexible?
- **Paper-Like**
 - See above. Is Plastic paper-like?
- **lightly-binding adhesive**
 - Same phrase used on both, but little else known; Probably a non-issue based on facts.
- **Claim Construction** 7.00
- **Literal Infringement?**
 - SO MUCH in dispute. Hard to make a guess.
 - Key points of dispute: Small, clear, flexible (3) 3.00
- **Literal Infringement** 3.00
- **Doctrine of Equivalence (5 - based on how much of following)** 5.00
 - **Test: All Elements or their equivalents present. (1)** 1.00
 - Sub-test: Function/Way/Result (W-J)
 - Sub-test 2: Insubstantial differences.
 - **Question turns on equivalence of disputed terms.**
 - Small: Sounds like it means "small enough for a bookmark" or "much smaller than a Note" (function: fit in a book -- same as SM).
 - Clear (function: can text be read? -- speculative but points for anything like this.)
 - Flexible (probably equiv).
- **DoE** 6.00
- **Prosecution History Estoppel**
 - **Basic Rule: Lose DoE if you give up equivalents through an amendment. (3)** 3.00
 - Threshold requirements: Narrowing Amendment, substantially related to patentability
 - Even if threshold met, still get around bar (flexible bar) under Festo if one of three things met.
 - Unforeseeable; Tangential; Other Reason
 - **Here:**
 - Narrowing Amendment? Yes.
 - Substantially related to patentability?
 - NO! (3) 3.00
 - Examiner didn't even have it yet; accepted without objection.
 - If you erred and said "maybe" then to get full points, you had to say...
 - Festo exceptions (or 3): Points if you say something like following
 - Unforeseeable: Nope.

- Nope.
- Tangential: Maybe. But once you say "related to patentability", it's kind of hard to fit it here.
- Other: Yes. A court would want to save it.
- **PHE** 6.00
- **Problem Three: Policy Question: Judicial Competence**
- **TOTAL SCORING RUBRIC:**
- **Discussion of Current Doctrine: 10** 10.00
 - **Criteria:**
 - How many relevant examples?
 - Accurate descriptions?
 - **Recommendations: 5** 5.00
 - **Criteria:**
 - Creativity?
 - Relevance?
- **TOTAL POINTS: 15**
- **Possible Rules to Discuss**
- **Patent: Claim Construction**
 - Phillips deemphasizes extrinsic evidence.
 - Possible critique: Roll back Phillips and force judges to look at dictionaries and experts.
 - Counter-argument: No! Defer more to judges since they are great at interpreting dense texts.
 - Same arguments as in Phillips itself and in casebook.
- **Copyright: We don't assess whether "news reporting" is actually "news reporting." Also, we don't assess whether "parody" is true parody. Finally, we don't critique the level of artistic skill in assessing originality.**
 - Forces deference.
 - Possible critique: Too much is protected, and given the length of terms, too much is kept out of the public domain.
 - Solution: Forget about fears of judges and let them keep things out of copyright protection when they are insubstantially original.
 - OR: let them decide what is news reporting.
 - OR: Let them decide what is parody.
 - Latter two obviously suffer from first amendment concerns.
- **Trade Secret: What is "wrongful" misappropriation. General business ethics? DuPont case.**
 - Possible critique: Not enough deference. Judges aren't business people usually. How can they judge where is the line between vigorous competition and misappropriation?
- **Role of experts generally.**
 - Copyright: Substantial Similarity and dissection.
 - Trademark: Survey evidence of confusion.
 - Possible Critique: We need more of this kind of thing. Why can't experts help:

- With the "wrongful appropriation" prong of copyright?