

- Problem One: Prentice v. Davis (began 3:12pm)
  - **TOTAL SCORING RUBRIC:**
    - **TM: 13**
    - **Copyright: 7**
    - **Writing Style Bonus: 3**
    - **Total Points Possible: 23**
  - **Trademark**
    - **Valid mark?**
      - **Two possible marks** 1
        - Get one point even if just focusing on dress
        - Three lines in frosting (mark)
        - The shape of the cookie itself (dress)
      - **How distinctive is this?** 3
        - [One point for decent discussion; Two if engages in raising difficulties with non-word marks; Three only if they hit many subtleties and/or discuss difference between lines and mugs in depth]
        - **Mark (three lines)**
          - Didn't really intend to test this separately when I wrote the Q, but give a point for students who addressed this above/beyond trade dress.
          - Pretty simple
          - Facts aren't clear whether secondary meaning for the lines
        - **Dress (mug)**
          - This is product design not packaging
            - From Samara Bros: Not inherently distinctive.
              - So secondary meaning is needed.
          - Seems pretty simple.
        - As an analog to the word mark scale? 1
          - [One bonus point if they explicitly note that Zatarain's word scale isn't directly applicable]
          - Simplicity may not defeat you. It's the connection between the mark and the product.
          - Here, there's nothing "descriptive" about cookies and coffee mugs.
            - Davis himself has twenty other designs.
            - Maybe "suggestive" because coffee and cookies?
          - So perhaps distinctive enough.
          - And evidence of secondary meaning.
            - But bonus point for spotting the fact that it might turn on how many passersby the reporter stopped before finding the three. 1
        - **Functional TM?** 1
          - **Are parts of this functional?**
            - Test: affects cost or quality or essential to the use or purpose?
            - Cookies are meant to be eaten, but none of these serve that purpose.
            - Also: the handle can be grasped for dunking.
              - So seems to affect quality?

- Somewhat strained argument: you can dunk the big, fat substantial part and not get your fingers wet?
- Maybe an aesthetic functionality argument?
  - But few points, because I expressly told some students not to focus on this.
  - If functional, can you separate out the handle from the rest of the cookie?
  - Likely held: Not functional.
- **Secondary Meaning?** 1
  - We need to test it.
  - The anecdotes from the news report are good. So it looks good.
    - Esp. because these were people in Gotham, not Metropolis.
- **Regional Rules** 1
  - No mention of federal registration.
  - Question: Are these the same market?
    - Three people know Penelope's in Gotham so encouraging fact.
    - 30 miles. Both large cities.
    - Local advertising, but not clear whether both cities served by paper.
- **Likelihood of Confusion?** 3
  - [One if bare mention; two if some detail; three if very sophisticated]
  - **Threshold Test: Do the products directly compete?**
    - Cafes and cookie stores.
    - But cookies are sold in both.
    - So possibly just similarity.
    - Then again, if speed boats and recreation boats don't compete, maybe these don't.
  - **Strength**
    - Somewhat
  - **Proximity of the goods.**
    - Very similar channels.
  - **Similarity of the marks.**
    - Close, but differences.
    - Green vs. blue. Small vs. large. Rounded vs. squared.
  - **Actual confusion.**
    - Some.
  - **Channels**
    - Parallel?
    - Maybe cafe customers eat in while cookie store customers eat out?
  - **Type of goods**
    - Not much care.
  - **Intent**
    - Unclear
  - **Expansion?**
    - Sure. Possible.

<u>Final Exam Solution Key--Fall 2007 Intro IP: Student ID:</u>	<u>Points</u>
<ul style="list-style-type: none"> <li>• Maybe confusing?</li> <li>• Dilution?</li> <li>• Famous Mark? <ul style="list-style-type: none"> <li>• Probably not, so nothing else needs to be discussed.</li> </ul> </li> <li>• No points if they don't discuss famousness requirement regardless of how deep they get with blurring/Nabisco/etc</li> </ul>	1
• <b>TRADEMARK SUBTOTAL</b>	<b>13</b>
• <b>Copyright</b>	
<ul style="list-style-type: none"> <li>• Valid Copyright?</li> <li>• Independent creation and modicum of creativity?</li> <li>• Fixed and PGS <ul style="list-style-type: none"> <li>• [one point for mentioning either or both]</li> <li>• Yes.</li> <li>• Extra point for discussing useful article in any depth, especially if conceptual separability is handled.</li> </ul> </li> <li>• Very, very simple.</li> <li>• Lines</li> <li>• Square</li> <li>• Handle</li> <li>• See NY Arrows case. Analog to short phrases.</li> <li>• Also: Idea Expression <ul style="list-style-type: none"> <li>• Idea of a coffee cup embodied here <ul style="list-style-type: none"> <li>• Particularly when you compare the things they have in common.</li> <li>• Merger / bumblebee example</li> <li>• Levels of Abstraction</li> </ul> </li> <li>• Might include discussion under Misappropriation prong</li> </ul> </li> </ul>	1 1 1 1
• Infringed?	2
<ul style="list-style-type: none"> <li>• [One for barely flagging the following; two for slightly more depth]</li> <li>• Possible rights infringed <ul style="list-style-type: none"> <li>• reproduction, derivative work, public display, distribution</li> </ul> </li> <li>• Copying <ul style="list-style-type: none"> <li>• Unclear from facts.</li> <li>• Some level of access (newspaper ad, 30 miles away)</li> <li>• Some similarity.</li> </ul> </li> <li>• Misappropriation <ul style="list-style-type: none"> <li>• No.</li> <li>• Might include idea/expression discussion here.</li> </ul> </li> </ul>	
• <b>COPYRIGHT SUBTOTAL</b>	<b>7</b>
• <b>Bonus points for quality of response</b>	<b>3</b>
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- **Problem Two: Traveling Saleswomen**
  - **SCORING BREAKDOWN:**
    - **Trade Secret: 11**
    - **Patent: 6**
    - **Writing Bonus: 3**
    - **TOTAL POINTS POSSIBLE: 20**
  - **Trade Secret**
    - **Two secrets** 2
      - [One point for noting the twin secrets; second bonus point for analyzing the two separately]
      - **Formula**
      - **Itinerary**
    - **Protectable?** 1
      - **Secret? (Bonus for catching one of the advanced thoughts below)** 1
        - Not many facts. But presumably so.
        - Itinerary is just tossed in the trash, so maybe not?
        - But article reveals a lot.
          - Court might frown on this.
      - **Valuable?**
        - Definitely.
    - **Reasonable steps to protect secret against disclosure by TS owner** 2
      - [Two for most of following; One for less]
      - **May be in the "secret" prong above.**
      - **Presumably so.**
        - Particularly because it's so hard to get itinerary data.
        - But it may turn on what others in industry do
      - **Can you really protect the secrecy of a public itinerary?**
        - Maybe inherently unprotectable? Not like a customer list.
    - **Misappropriation?**
      - **Improper Means?**
        - [For each, one for cursory analysis; two for more careful analysis and comparisons with facts of cases.]
        - **Digging through trash?** 2
          - Seems unseemly
          - Quote about Business Morals
          - Compare need to shred versus business morals with analogous discussion in Dupont
          - might turn on laws about trash digging
        - **Tailing with PI?** 2
          - Analogous to overflight case?
          - Probably bad?
          - But public streets.
      - **Reverse Engineering Defense?** 1

- Yes, for the formula.
- Maybe for the PI tailing?
- **TRADE SECRET SUBTOTAL** **11**
- **Patent**
  - **Novelty?** **3**
    - More than one year since published.
    - BUT: didn't disclose everything in the article, so probably not barred
    - Bonus point for discussing how four years of use is fine if you're the only one using it. **1**
      - But policy of sleeping in rights maybe implicated
  - **Patentable Subject Matter?** **2**
    - **Process**
    - **Mathematical formulae: State Street: useful, tangible, concrete result?**
      - Sure. Next city to visit.
    - **Rest aren't explored: Non-obviousness, WD/Enablement/Best Mode, Utility.**
  - **Conclusion**
    - **Probably patentable, depending on statutory bar.**
- **PATENT SUBTOTAL** **6**
- **Bonus points for writing style** **3**
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- **Problem Three: Corporations vs. Individuals**
  - **TOTAL SCORING RUBRIC**
    - **Discussion of three rules (3 x 3): 9**
    - **Reforms: 5**
    - **Writing Style: 5**
    - **TOTAL POINTS AVAILABLE: 19**
  - **Possible doctrines:**
    - **Work for Hire**
    - **Term for Copyright**
    - **Fair Use / Market definition?**
    - **Patent thicket production?**
      - **Defensive patenting.**
      - **Blocking patents.**
    - **Cost of prosecuting a patent.**
    - **Statutory damages for Copyright**