

Intellectual Property
Professor Lape

Monday, December 15, 1997
1:30 p.m.
Three (3) hours

SPECIAL INSTRUCTIONS

1. Answer all questions. Explain your conclusions and discuss fully the arguments on each side of every issue.
2. You may bring to this examination your statutory supplement, your casebook, your class notes, your outline and any other written or printed material.
3. Suggested time allocations for each of the questions are as follows:

Question I	70 minutes
Question II	70 minutes
Question III	20 minutes
Question IV	<u>20</u> minutes
	180 minutes

EXAMINATION CONTINUES

Question I

Porter wrote a tree identification book entitled *Know the Trees* in 1985. Ten thousand copies of *Know the Trees* were sold in 1985 with appropriate copyright notice at garden centers and tree nurseries. *Know the Trees* contains 75 trees arranged by similarity of leaf shape.

In 1997 Duncan prepared and published a tree identification book entitled *Trees Around Us*, which contains the same 75 trees as *Know the Trees*, also arranged by similarity of leaf shape, although not in the same order and not arranged according to the same categories of leaf shape. The entries in *Trees Around Us* bear the degree of resemblance to the entries in *Know the Trees* which is illustrated by the entries for apple tree provided below.

After learning of Duncan's book, Porter registered a claim of copyright in *Know the Trees* with the Copyright Office. In 1997 Porter filed a suit for copyright infringement against Duncan seeking an injunction and statutory damages. What are Porter's chances of success?

*Know the Trees*Apple *Malus sylvestris*

Height: 30-40'. Tree with a short trunk and rounded, spreading crown. Leaves green above, with dense gray hairs on undersurface; 2½ -3" long, 1¼-2¼" wide. Flowers white with pink tinge with 5 rounded petals appearing in spring. Fruit a round, yellow or red apple.

Apple *Malus sylvestris*

Height: 30-40'. Short trunk with round crown. Upper surface of leaves green, with hairy, gray undersurface; 2½-3" long, 1¼ -2¼" wide. Five-petaled white and pink flowers appearing in spring. Fruit a yellow or red apple, well-rounded.

Trees Around Us

EXAMINATION CONTINIUES

Question II

Palmer Industries, Inc. (“Palmer”) holds patent 4,779,728, which covers a disposal container for disposing of hazardous medical waste, including hypodermic needles. Palmer’s patent claim covers a disposal container with a slot “at the top of the container body” to allow entry of waste material, and a movable cover that slides into the slot to close it and slides out of the slot to open it. In September of 1994 Palmer placed 100 of its disposal containers in examining rooms and patient rooms in a large hospital for six months at no charge to the hospital. Under Palmer’s agreement with the hospital, Palmer could examine the disposal containers on a monthly basis, but Palmer did not examine the containers. At the end of the six month period Palmer distributed to hospital personnel a survey which asked how well the containers worked and whether the personnel would, if asked, recommend purchase of the containers by the hospital. The responses to the survey were overwhelmingly favorable. Palmer filed an application for a patent on its container in January of 1996 with the Patent and Trademark Office. The patent was issued to Palmer in July of 1997. Palmer began marketing the container in the fall of 1997; all containers distributed have borne appropriate patent notice.

In the fall of 1997 Davis Products, Inc. (“Davis”) began manufacture and marketing of a disposal container for disposing of hazardous medical waste, including hypodermic needles. Davis’ container differs from that of Palmer in that Davis’ container has a slot on the side of the container, said slot being located in the middle of the side of the container, and in that Davis’ container has a flat hinged lid that can be left open, but which locks in place and does not reopen once closed. Davis performed tests in its laboratory prior to marketing to compare the performance of a container with a slot on the top to the performance of a container with a slot on the side.

Palmer has brought suit against Davis for patent infringement seeking an injunction and damages. Davis will not contest the validity of Palmer’s patent on the grounds of obviousness. What are Palmer’s chances of success?

EXAMINATION CONTINIUES

Question III

- 1) Is a mark consisting of a realistic drawing of a tuna fish to be used on the label of cans of tuna fish registrable as a trademark under the Lanham Act without proof of secondary meaning? Be sure to discuss all possible classifications of this mark.

- 2) Where Able used the mark ZIPPO in commerce in connection with the sale of oven cleaner nationwide; then Better used the mark ZIPPO in connection with the sale of oven cleaner in the north-east without actual knowledge of Able's use; then Able filed an application to register ZIPPO as a trademark with the Patent and Trademark Office; then a certificate of registration issued to Able, what are the rights of the parties to the use of the trademark ZIPPO? Include in your response the impact of any relevant sections of the Lanham Act.

EXAMINATION CONTINUES

Question IV

Your client, Kelly, has come to you with an idea for a new children's board game, to consist of the trading of cards decorated with drawings of animals, governed by a set of rules devised by Kelly. Kelly plans to name the game "Zoo Flu." Thus far, Kelly has created no prototypes or models, but describes the rules and card decorations to you in detail. Kelly wants to sell her idea to Parker Brothers. What do you advise that Kelly do?

EXAMINATION ENDS