

Intellectual Property

Eric E. Johnson
Associate Professor of Law
University of North Dakota School of Law

30/45 FORMAT PRACTICE FINAL ESSAY EXAM - MODEL ANSWER

Pulling Polymers

PRACTICE EXAM NO. 2 FROM "BAD DAYS FOR GOOD CHEER"

NOTES:

The practice exam facts are a subset of the facts used on the Spring 2012 IP exam, "Bad Days for Good Cheer," with slight modifications. The model answer produced below comprises the relevant portions of the publicly released model answer for that exam, with slight modifications.

The following notes accompany the "Bad Days for Good Cheer" model answer: *This model answer contains material amalgamated from the work of multiple students. Because of the cherry-picking involved, this model constitutes an answer that is better than any real response that was received. So, in some ways, it is better than the best. But it is also true that this model answer is not perfect. Student-drafted work done under deadline pressure, of course, never would be perfect. Analysis and issue coverage could be better in places, and I could quibble with various aspects. But, all things considered, it's very good. What this all means for you is that you should be circumspect about comparing your own response to this one as a way of gauging your preparedness for the exam.*

What are good lessons to draw from this model? One thing this response does very well is the way in which the law is applied to the facts. Rather than cut-and-pasted blackletter law or needlessly reiterated facts, this exam response focuses on providing analysis. That's excellent, because the analysis is the key to doing well on the exam. Also laudable, and universally applicable, is the sense of judgment this exam response displays with regard to conclusions: Close calls and toss-ups are presented as such, while rock-solid conclusions are made without hedging.

QUESTIONS

Provide analysis as follows. Keep your answer confined to United States law.

- 1. Analyze utility patent issues.**
Include answers to these questions: Can anything be patented here? If so, what?
- 2. Analyze copyright issues regarding the '55 and '66 card designs.**
Include answers to these questions: What aspects of Sapindale's '55 card are protectable with copyright? Could Good Cheer's '66 card infringe? What would be important to deciding such a claim?
- 3. Analyze the trademark claim regarding the '77 card design.**
Can Sapindale protect the '77 card design with trademark? (Note: You should be able to answer this question and provide a rationale with great brevity.)

Note that the questions will not be weighted. Instead, they are cumulative and will be graded together. So divide your time among the questions according to which ones require the most discussion and analysis. Plan ahead to put information where it belongs. Also, do not repeat the exact same analysis over again in a different context (for example, by using copy and paste). If analysis of an issue is similar to but not exactly the same as what you have written previously, then I suggest you note your prior analysis and go on to discuss any differences. Finally, do not provide analysis you haven't been asked for; for instance, do not provide trademark analysis regarding the '55 card or copyright analysis regarding the '77 card.

Some suggested abbreviations for your answer:

55	Sapindale design no. S5S-55	DD	Dieter Danvar
66	Good Cheer design no. 6026-66	GG	Good Cheer Greeting Card Co.
77	Sapindale design no. S77-77	HH	hypochromic hyperpolymer (hylonex)
CC	Carrie Carlyle	SS	Sapindale Sentiments

RESPONSE

1 – PATENT

When CC was able to synthesize a new kind of silane polymer that darkened in color under tension, it is likely she both had a patentable process and a patentable compound. The facts stipulate both are new, and each is clearly useful. Something is not useful merely because of aesthetics alone, but HH is useful in aesthetic applications, and that clearly counts. Certainly allowing for hiding and revealing text meets the threshold of utility. It also seems subjectively to be nonobvious. There seem to be no prior-art motivations or suggestions that would render this obvious to a phosita. Moreover, secondary factors point to nonobviousness: This is an unexpected result (colors usually lighten under tension), and despite a lot of work in polymer chemistry, others have failed to achieve this result. The specification will, of course, need to contain an enabling disclosure, but there are no barriers to providing this with the application.

There is also a potential patent in the greeting card itself, with its clever means of revealing hidden text mechanically through the opening of the card. This patent, however wouldn't provide any more economic value than the patent on HH itself, unless you could get a claim that is broad enough to encompass greeting cards that do this without using HH. That seems plausible, although a very broad claim on any greeting card that has a message appear after the card is opened would likely be obvious and might not even be novel.

There would be a difference between the HH and card patents in terms of inventors: CC is the sole inventor on the HH compound/process patent, and CC and DD are co-inventors on the card. But assuming GG has standard invention assignment clauses in their employment contracts, this is a distinction without a difference.

2 – COPYRIGHT

SS has a colorable claim against GG for infringement of the 55 card by the 66 card. The 55 card, as a whole, is clearly copyrightable subject matter and therefore copyrighted. But the idea of the card is not copyrightable, nor, for instance, is the word "pull" or the industry-standard dimensions. So assuming for the moment GG copied, there is a question of whether the appropriative similarity element of infringement can be shown. In other words, did GG copy the copyrighted work, or merely uncopyrightable elements of it? Comparing the 55 and 66 designs as a whole, a court might find substantial similarity: use of red, basically identical use of exclamation points, very similar language. But a court could well say that all that is being copied are uncopyrightable elements. To the extent that the arrangement of those elements is the same, the copied expression may be said to be driven by the central idea of the card, thus merger doctrine leaves the resulting work uncopyrightable.

Alternatively, we can say that the SS's copyright is a thin one, and since the copying is not literal or near-literal, then the thin copyright affords no cause of action here. We can also use

scenes-a-faire doctrine to reach the same result: Phrases such as "Get well soon!" are commonplace for the greeting-card genre and therefore cannot be monopolized with a copyright. These defenses can be unpredictable in the courts however, so the outcome is unsure. After all, the cards do present the immediate impression of looking a lot a like, and that will likely have an impact.

If there is appropriative substantial similarity, we must still ask whether there is copying. Even though GG's designers were apparently not consciously aware of the 55 card's existence, under the George Harrison case, subconscious copying is actionable. A jury could draw the inference that that is what happened here. And the case for indirect copying is strong, since there was access and the cards are probatively similar. Note that while I think the similarities are close enough for indirect proof of copying, as I explained above, I think the requisite similarity may be lacking for appropriative similarity as an element of infringement. In other words, there is similarity for evidentiary purposes, but perhaps not for substantive purposes.

3 – TRADEMARK

SS cannot have any common-law trademark rights in the '77 card design as it is secret and has not been released publicly: therefore it has not be used in commerce. Use is a pre-requisite to trademark rights. Also, product design is not inherently distinctive, and without being publicly released, there is no way the design could have acquired secondary meaning.