FINAL EXAMINATION

INTELLECTUAL PROPERTY

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Tuesday, December 14, 2004

8:30 AM - 11:30 AM

THIS IS A THREE (3) HOUR EXAMINATION.

THIS EXAMINATION CONTAINS SIX (6) PAGES.

THIS EXAMINATION CONTAINS FIVE (5) QUESTIONS.

\[ I = 30 \text{ min.} \quad II = 60 \text{ min.} \quad III = 30 \text{ min.} \quad IV = 40 \text{ min.} \quad V = 20 \text{ min.} \]

FILL IN YOUR EXAMINATION NUMBER ON THE BLUEBOOK STICKER.

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YOU MAY BRING IN YOUR STATUTORY SUPPLEMENT, BUT NOTHING ELSE. You may write in the margins and on the blank pages of the supplement.

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Instructions:

1. These questions will be graded on the basis of the times indicated with each questions. The indicated time for the questions total 3 hours. You will be given 3 hours to write the examination. Budget your time carefully or you may not finish.

2. Be sure to state a result whenever a question asks for one. Merely stating the arguments on both sides of a legal issue will result in only partial credit because you will not have completed the analysis required by that type of question.

3. If you find it necessary to make factual assumptions in order to answer a question, be sure to state the assumption.

4. Do not assume additional facts for the purpose of avoiding a legal issue or making its resolution easier.

5. Comment briefly on each legal issue reasonably raised by the questions and on each reason for your answer, even when you decide that one legal issue or reason controls the result.

6. The difference between triumph and disaster may lie in a careful reading of the questions.
HealthMonitor is an Ohio corporation that provides remote electronic monitoring devices and emergency response services for at-home clients in 25 states, including Missouri. It solicits local hospitals and home health care agencies to become members of its national network. Typically, HealthMonitor leases monitoring equipment to local provider-member agencies, which provides it to its individual patient-subscribers. HealthMonitor also maintains a round-the-clock support center, which responds to the subscriber's emergency calls in a prearranged fashion. HealthMonitor also can arrange to monitor patient-subscribers’ medical equipment or monitor with a GPS transponder the whereabouts of an at-risk patient-subscriber, such as one suffering from Alzheimer's disease.

Each provider-member agency markets HealthMonitor's monitoring programs and equipment to its individual patient-subscribers, bills them, and pays HealthMonitor a monthly fee for each.

HealthMonitor markets its services and equipment under its HealthMonitor mark. It began marketing them in 1991 in some of the 25 states. From 1992 to 1999, it spent about $50,000 attempting to sell its services and equipment in Missouri. Despite these efforts, it made only one $500 sale in Missouri to an end user, who terminated the subscription in April 1994. HealthMonitor had no further sales in Missouri until July 1999, when it entered into contracts with seven health care agencies. In that year, its revenues were $82,000. None of these contracts were in the six-county region in central Missouri served by CM (see next paragraph). These seven contracts are still in force. HealthMonitor received federal registration of its HealthMonitor mark on May 4, 1999.

Central Missouri Area Health Agency [CM] was established in 1979 to provide a broad range of health support services to elderly and disabled persons in a six-county region in central Missouri. It has 750 employees and 300 volunteers assisting about 10,000 client-patients, all of whom live in the six-county region. Prior to 1996, it did not provide a personal emergency response service. In 1996, it decided to provide a monitoring equipment and emergency response service similar to HealthMonitor's. Without knowledge of HealthMonitor's service in other states or of its one client in Missouri up to 1995, CM adopted the trade name “Health Monitor” for this new service, since it was easy for client-patients to remember. CM prominently displayed this trade name on stationery, business cards, client-patient information materials, and other publicity materials related to the service. It did not use the “Health Monitor” trade name for its traditional health support services. CM registered its Health Monitor trade name as a mark with the Missouri Secretary of State on March 23, 1996. CM's activities are confined to the six-county region in central Missouri, but they are publicized beyond the region by news coverage, telephone listings, advertisements, and a monthly column in a Missouri newspaper for the elderly.

When CM learned of HealthMonitor's use of the HealthMonitor mark in 1999, it sent a cease-and-desist letter to HealthMonitor. The parties were unable to resolve the resulting dispute. HealthMonitor then sued in federal district court, seeking an injunction against CM's continued use of the HealthMonitor mark. CM counterclaimed, seeking an injunction against HealthMonitor's continued use of the HealthMonitor mark in Missouri. What relief, if any, should the court grant to either party? Discuss your reasoning on all relevant issues. State a result.
Stewart Douglas conceived of using a color inkjet photocopy machine to copy a picture and then print it, using edible ink, on an edible substrate sheet. However, the photocopy machine, edible substrate sheets, inkjet printer cartridges, and edible ink were not novel. The edible sheets and edible ink were invented previously for use in a silk-screening process. However, the process conceived by Douglas, using a combination of nonnovel equipment elements, was a novel process and was granted a patent (the '530 patent). His invention is used to make cakes with an image photocopied onto the edible substrate which is placed on the frosting.

Photocopy machines typically feed the paper through one or more sharp turns during the photocopying process. Also, photocopy machines bake the ink on the paper to fix it permanently. Douglas solved the problem of breaking the edible substrate in sharp turns by specifying that the manual feed mode be used on the photocopier, which avoid sharp turns. Furthermore, he specified that the edible substrate sheets can be fortified in the photocopier by adhering them to a carrier sheet for passage through the photocopier. The baking problem was solved by disabling the heaters in the photocopier; the edible inks on the edible substrate do not need heat-fixing. In other respects, Douglas's process resemble the conventional photocopying process, in which the image to be copied is placed on the scanner glass of the photocopy machine, an edible substrate sheet is placed in the manual paper feed tray, an edible ink cartridge is used in place of the conventional inkjet cartridge, the user pushes a button, and the machine scans the image and copies it onto the edible substrate by the conventional xerographic process. The cake baker then places the printed edible substrate sheet on the surface of a frosted cake.

CopyCake Enterprises, which sells supplies for cake decorating, produces and sells a machine for reproducing color photographs onto an edible substrate sheet for placement on a frosted cake. Its system uses a conventional computer scanner linked through a computer to a conventional computer inkjet printer. CopyCake sells the edible substrate sheet and inkjet cartridges filled with edible ink. The user buys the conventional scanner-computer-inkjet printer equipment either from CopyCake or elsewhere. CopyCake specifies which brand of inkjet printers can be used with its edible substrate sheets and edible inkjet cartridges (printers must have a non-tortuous paper feed path; CopyCake sells only a couple of brands of inkjet printer cartridges filled with edible ink). Any brand of scanner and computer can be used. The user places the image to be copied on the scanner, puts an edible substrate sheet in the paper feed of the inkjet printer (loaded with CopyCake's edible ink cartridge), and presses a button. The scanner scans the image and the printer reproduces it onto the edible substrate sheet. The cake baker then places the printed substrate sheet on a frosted cake.

One day after the issuance of the '530 patent, Douglas sued CopyCake for infringing and inducing infringement of the '530 patent by marketing and selling the CopyCake substrate, edible ink cartridges, and conventional scanner-computer-inkjet printer systems. The claim in the '530 patent alleged to be infringed is:
passing an edible web along an elongated, no tortuous copy path in the photocopy machine without substantially heating the edible web, ... such that the edible web passes along the copy path without following any tortuous bends; and

reproducing the image on the copy glass onto the edible web with edible ink as it passes along the copy path.

The parties agree that both the photocopy machine and the inkjet printer specified by each party have a copy path that is nontortuous (i.e., no sharp bends that would break an edible substrate sheet).

A. (40 minutes)

Should the court grant an injunction against CopyCake prohibiting sale or marketing of its CopyCake edible substrate sheets, inkjet cartridges filled with edible ink, and scanner-computer-inkjet printer systems? Discuss your reasoning on all relevant issues. State a result.

B. (20 minutes)

For several years bakers have used the silk-screen method of printing edible ink images on edible substrate sheets for placing on frosted cakes. Also, as members of the general public, they have used photocopy machines to copy images onto paper. In recent years, refillable cartridges for inkjet printers have become available and are widely advertised.

Do those facts suggest a defense in the suit against CopyCake? Discuss your reasoning on all relevant issues. State a result.
On Tuesday, December 7, 2004, the MU Concert Series presented the performance *Christmas from Dublin: The Three Irish Tenors*. The performing tenors were Claran Nagle, Anthony Norton, and Brian Dunphy; all are Irish. Assume that they began performing together under the name *The Three Irish Tenors* in 2001.

On PBS, on recordings, and in live performances over the past six or seven years, *The Irish Tenors* have performed. A couple of their gala performances were recorded live for broadcast on PBS in the late 1990's; these have been rebroadcast from time to time since then. There are three tenors: John McDermott, Anthony Kearnes, and Ronan Tynan. All were Irish the time they started performing together, although one of them (Tynan, I think) has recently become a naturalized American citizen. Assume that *The Irish Tenors* was registered in 2000 and that they still occasionally perform together.

When I went to the performance, having not read the Concert Series publicity carefully before ordering tickets, I assumed that McDermott, Kearnes, and Tynan would be singing, even though the radio publicity always stated that *The Three Irish Tenors* would be performing. I was surprised to discover who was singing; I do not know whether others in the audience were similarly surprised. (*The Three Irish Tenors* proved to be excellent performers.) However, both the ticket ordering publicity and the performance program clearly state that the tenors would be Nagle, Norton, and Dunphy. Since the publicity materials do not indicate that the two groups are related, assume that they are independent groups.

Do *The Irish Tenors* have a cause of action against *The Three Irish Tenors*? Do the latter have any viable defenses? Discuss your reasoning on all relevant issues. State a result.
Mid-Mo Schools publishes an annual magazine for prospective home buyers in the central Missouri area. It includes information about schools in Columbia, Jefferson City, Fulton, Centralia, Moberly, Mexico, Fayette, Boonville, and other small town and rural schools in the six-county region of Missouri. It distributes its magazine through local real estate agents. In addition to articles, the magazine features tables of information on area public and private schools.

Mid-Mo Schools table organizes information by topic. School districts are listed alphabetically in a column at the left-hand side of the table. Mid-Mo Schools has separate tables for "Athletic" topics and "General Information/Academic" topics. Topic column headings are listed in a row across the top of the table. Some general information topic columns indicates information about the number of teachers, number of students, school facilities, and school services at each school. Some academic topic columns, such as "Bachelor," "Masters," and "Doctorate" indicate the number of academic degrees attained by staff members. Other academic topic columns, which have checkmarks in appropriate rows, such as "French," "Spanish," "German," and "Latin," describe particular classes offered at each school. The substantive content of the table is the information listed in each topic column.

Jeri Andrews, a Columbia real estate agent, also organizes and lists information on local schools. She compiles and publishes her information on an internet website. Unlike Mid-Mo Schools, Andrews does not publish information on all area schools in a single table. Instead, her website provides a list of school districts with links to information on each school. When an internet user clicks on a school district name, the website takes the user to a page of information Andrews has compiled exclusively on that school district.

The pages of information on Andrews's website do not consist solely of tables. Each page does include a table of information on "School Statistics" - statistics on school population, accreditation, pupil-staff ratio, and pupil/computer ratio at the particular school. On the rest of each page, topics are organized into groups. Each group of information is displayed in a separate row. For example, there is a row of information on "Certified Staff," another row on "Classes Offered," and another one of "Miscellaneous" information. "Athletic" information is listed in this same format on the same page as non-athletic information.

Mid-Mo Schools and Andrews's website cover many of the same topics. For example, both provide information on the population of school districts and schools, on the availability of services like busing and hot lunch, on staff credentials and certification, on classes offered, and on student test scores. The 64 topics covered by Andrews's website include 56 of the 76 topics listed in the Mid-Mo Schools table. Where both covered the same topics, the information was consistent and was also consistent with information available from each school district.

Mid-Mo Schools sued Andrews, seeking an injunction against further publication of Andrews's website. Andrews counterclaimed for summary judgment. What causes of action are available to Mid-Mo Schools? Should the court grant or deny summary judgment for defendant on each? Discuss your reasoning on all relevant issues. State a result.
A.

A TV advertisement depicts a fat person getting stuck in the mouth of a cannon in a human cannonball act. It does not identify the person getting stuck.

Zacchini and his circus human cannonball act have a worldwide reputation. Does this advertisement violate any rights of Zacchini, “The Human Cannonball”? Discuss your reasoning on all relevant issues. State a result.

B.

The National Geneological Library purchased a single copy of Hodges’s compilation of Irish genealogical research materials, and indexed it in its card catalog. Thereafter, from time to time, it made photocopies of it for walk-in patrons and in response to Inter-Library Loan requests.

Hodge sued the National Geneological Library for copyright infringement. What relief, if any, should the court grant? Discuss your reasoning on all relevant issues. State a result.
concurrent use
- first user prevails under common law in area of actual use in commerce
  - this is CM in central Missouri
- state registration by CM in 1996 does not alter common law of concurrent use
  - state registration does not grant any substantive right; it merely creates constructive notice of registrant’s claim
- federal registration grants substantive statutory rights
  - including exclusive right of use in area of actual use in interstate commerce
  - including preemptive right to use mark in future in areas of nonuse by anyone
    - does not include preemption of another’s first use of mark prior to date of registration in areas of actual use
- thus, CM was first pre-registration user in central Missouri (1996)
  - not preempted by HM’s later federal registration (1999)
- area of actual use defines scope of nonregistrant’s grandfathered use
  - here, county-by-county market area is appropriate
- thus, CM is entitled to continue use of mark in six-county region in Missouri
  - HM has actual use or preemptive rights in remaining counties in Missouri

II. (60 min.)
A. (40 min.)

Equivalence
- doctrine of equivalence provides that substitute elements in a machine or process are equivalent and infringing if:
  1. they perform the same function, 2. in substantially the same way, and 3. to achieve the same result.
- here, the question is whether an inkjet photocopy machine and a scanner-computer-inkjet printer combination are equivalent.
  - nothing in the definition of a photocopy machine requires that the scanning and printing functions be housed as an integral unit (the computer merely accomplishes and translation function which is hardwired in a photocopy machine)
    - note, scanner software always contains a “photocopy machine” icon button which causes a scanned image to be printed directly without intervening software manipulation
  - thus, the scanner-computer-printer combination is the functional equivalent of the photocopy machine specified in the patent claim
  - hence, use of the scanner-computer-inkjet printing process infringes on ‘530 process patent

contributory infringement - staple item of commerce
- vicarious infringement is inducing another to infringe, by enabling infringement
  - here, by sale of equipment suitable for use in the infringing process
- but, sale of staple items of commerce does not constitute vicarious infringement
  - because they have some or many other lawful uses
sale of elements
- none of the equipment elements used in the process are novel
- no physical elements are claimed in the '530 patent; it claims only a process
- except for inkjet printer cartridges filled with edible ink, none of them are specially adapted for use in the '530 process

B. (20 min.)

obviousness
- in addition to novelty and utility, an invention must be nonobvious to be patentable (s. 103)
- it must be nonobvious to a person with ordinary skill in the technology
  - based on two or more prior art references likely to be know to such a person
- bakers ought to be aware of innovations in cake-making technology, such as the silk-screen method of placing images on cake frosting
  - also, they ought to be aware of technologies used generally by the general public, such as photocopying
- arguably, printing an edible ink image on an edible substrate sheet by photocopying technology ought to be obvious to a baker
  - it combines the teachings of making edible ink images on an edible substrate sheet by the silk-screen method, conventional photocopying, and refilling inkjet printer cartridges with edible ink.

III. (30 min.)

trademark infringement
- infringement occurs when a second comer uses a mark that is identical or confusingly similar to a first comer’s mark, so that consumers are likely to be confused about the origin of the product or service
- here, The Three Irish Tenors probably is confusingly similar to The Irish Tenors
  - the second comer’s mark is identical except for the addition of the word “three”
  - both groups are comprised of 3 tenors from Ireland
- evidence of actual confusion supports a finding of likelihood of confusion
  - here, there was actual confusion
- hence, The Irish Tenors is entitled to an injunction against continued use of The Three Irish Tenors mark
  - plaintiffs also would be entitled to damages equivalent to defendant’s net profits
    - (no information is given to discuss this)

registrability
- The Irish Tenors is a combination of descriptive words indicating the nature and geographic origin of the group: Irish and tenors
- thus, the term cannot be registered until it acquires secondary meaning
- because of its PBS and live performances, the group surely acquired secondary meaning in the later 1990’s
hence, defendants are not entitled to a declaration that *The Irish Tenors* was improperly registered.

**dilution**
- under s. 43(b), holders of “famous names” may enjoin use of confusingly similar names which cause dilution of the famous names.
- dilution is defined as depletion of the commercial value of a famous name or disparagement of it by another for commercial advantage.
  - a famous name is one of a celebrity or of a trade name widely recognized by the public as designating a particular person, entity, product, or service.
  - *The Irish Tenors* is famous because of the renown the group acquired from its PBS and live performances.
  - the similarity of names between the two groups could cause dilution of the value of the senior name.
  - hence, there is a cause of action for famous name dilution.

**unfair competition**
- common law unfair competition is using the trade name or appearance of someone’s product or service without permission for commercial advantage.
- a cause of action exists if such use is likely to cause confusion among consumers.
  - here the similarity of names is likely to cause confusion among the ticket-buying public.
  - hence, there is a cause of action under the common law.
- an injunction against future use and damages for past use are available remedies.

**IV. (40 min.)**

**copyright infringement**
- a copyright protects the expression of literary (graphic & sculptural) material in a fixed medium of expression.
- for infringement, there must be copying of expression.
- the only issue here is whether the expression in *Mid-Mo Schools* has been copied.
- facts and public domain information is not protected by copyright and may be copied (Feist).
  - the order and arrangement of facts is protectable only if it is a nongeneric arrangement (Feist).
- expression here consists of the selection and arrangement of information, not the information itself.
- the test for infringement is substantial similarity to the ordinary observer.
  - *Mid-Mo Schools* and Andrews had 56 topics of common information.
  - but they were not presented in the same way.
    - *Mid-Mo Schools* used a single table to enable the user to compare schools; Andrews used separate tables for each school.
    - apparently, *Mid-Mo Schools* displayed topics horizontally and Andrews displayed them
substantial similarity
- such that denial of copying could not be believed by the fact finder
- here, there was no direct proof of copying
- here, also, there was access, but no substantial similarity
- thus, there is no infringement and summary judgment should be granted

misappropriation
- common law misappropriation is the taking of the work product of another without consent for commercial advantage
- the copying of facts can be misappropriation only if it is time-sensitive (INS)
  - even though substantial work effort is involved in compiling the facts
- state law cannot prohibit what the federal copyright law allows
- the act allows the copying of facts
- thus, any common law misappropriation cause of action is preempted

unfair competition
- unfair competition is the presenting of a product or service in a way that the consumer is likely to be confused about its origin
- the facts do not indicate any elements in Andrews's website that would suggest it is provided by Mid-Mo Schools
- the information arrangements, methods of presenting similar information, and names are distinctly different
- thus, there is no unfair competition cause of action

V. (10 min. each)

A. right of publicity
- a celebrity is entitled to a right of publicity
- the right of publicity is defined as a celebrity’s right to exclusive use of his/her name, likeness, or indicia of identity
- persons appropriating such indicia for commercial advantage may be enjoined
- here, Zacchini is a celebrated circus act performer whose human cannonball act and trade name “The Human Cannonball” have worldwide recognition.

parody
- a parody of a celebrity or indicia of identity is likewise enjoinable, where it is used for commercial purposes (White)
- the TV advertiser may be enjoined

B. first sale doctrine
- copyright owner of a copyrighted work has the exclusive right to distribution and reproduction
- purchaser of copyrighted work has right to dispose of a lawfully acquired physical copy, but not to reproduce it
- library may allow access to copyrighted works in its collection, and may lend them
but that provision does not authorize libraries itself to copy copyrighted works for patrons (unless Copyright Clearance Center procedures are followed, or consent of the copyright owner is obtained)

- [check Inter-Library Loan provision in Act]
- libraries cumulatively making many individual copies of the same work is treated as unauthorized reproduction (American Geophysical) thus, NGL infringed