

Intellectual Property

Professor Grimmelmann

Final Exam - Spring 2008

I graded the two problems by creating a fifty-item checklist for each. You got a point for each item (e.g. “Woolly mammoths could be useful as an exhibition in zoos.”) you dealt with appropriately. I gave out frequent bonus points for creative thinking, particularly nuanced legal analyses, and good use of facts.

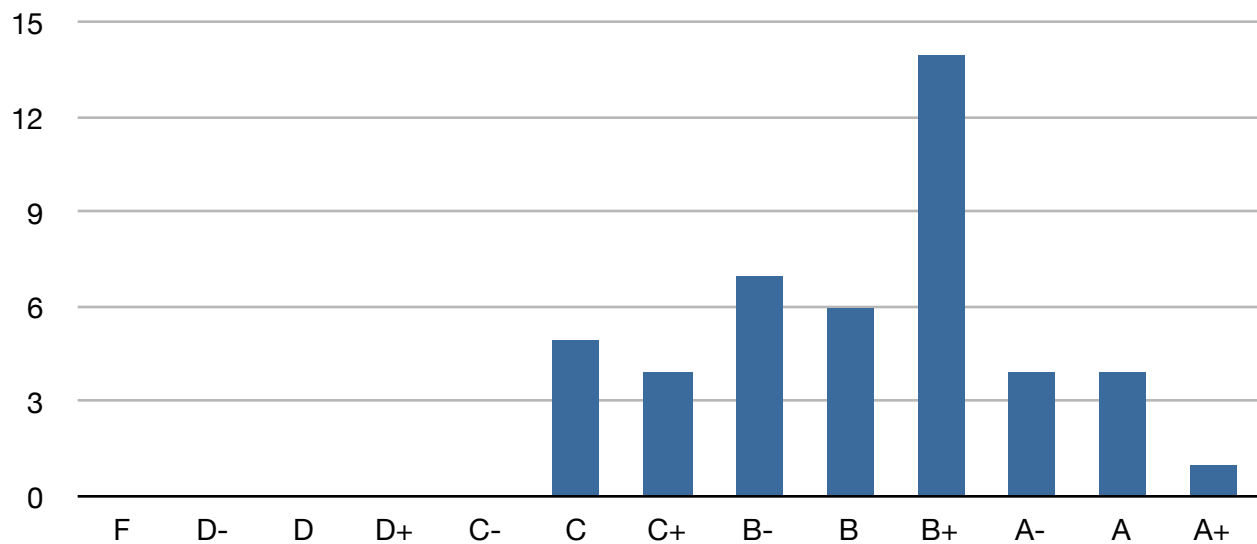
On the whole, your exams were solid. They all showed a good grasp of the fundamentals of the intellectual property systems we studied this semester. The better exams, of which there were many, were distinguished by greater creativity, greater precision, and greater understanding of issues beyond the basics. The final grades reflect your strong collective performance.

If you'd like to discuss your exam, the course, or anything else, please email me and we'll set up an appointment. If you have exam questions, please read through this memo before getting in touch.

It's been a pleasure and a privilege to teach you and learn from you. May you enjoy the best of luck in your future endeavors!

James

	Pleistocene Park	Rock Morris	Overall
Mean	22.6	25.1	47.7
Median	23	24	48
Std. Dev.	6.8	5.7	10.9



(1) **Pleistocene Park**

I was looking for three things here. First, I wanted you to take a firm, stand on some of the major issues. Specifically,

- The Goldblum article triggers the § 102(b) statutory bar; claim (3) is invalid.
- Since Spielberg was second to every major milestone and worked in secret, nothing it did could defeat Crichton’s priority in the patent.
- Spielberg is not liable for past infringement, because Crichton’s patent didn’t issue until after Spielberg finished cloning its mammoth.

These issues were weighted disproportionately—these three sentences, by themselves, would have gotten you 12 points.

Second, it was helpful to be precise in talking about individual claims. The question is loaded with issues that only affect some of the claims and not others. Claims (1) and (2) are to a product; but claims (3) and (4) are to a process, which affects the subject matter analysis. Claims (1), (2), and (4) mention a “wooly mammoth” but claim (3) doesn’t, which makes a big difference if you’re cloning mastodons. Claims (1) and (3) are independent; claims (2) and (4) are dependent, which matters when talking about literal and equivalent infringement. And so on. A few exams did well without getting into these details, but it was much easier to write a clear, comprehensive answer if you made these distinctions.

Third, I hoped you’d take the “extinct animal” ball and run with it. The fact that mammoths used to exist but currently don’t puts an interesting spin on our subject matter, novelty, utility, and enablement analyses. I wasn’t particularly rigorous about which doctrinal heading you put these issues under, but I was looking for creative use of this fact.

The most common mistake I saw in answers to this question was to focus either on patentability or infringement and neglect the other. It’s a very rare patent case in which they’re not both at stake. The second most common problem was to talk about patent policy and the Constitution for pages and pages without getting around to the facts of the question. An exam question is like a cab ride: whether you’re getting where you want to go or you’re stopped in traffic, the meter is always running.

§ 101

Is a mammoth patentable subject matter? *Chakrabarty* deals with the objection that they’re living things. Yes, it’s true that they’ve existed before, but their long period of extinction gives a strong *Parke-Davis* argument that a mammoth today is a “new thing.” Good answers also noted that the process claims were less problematic in this regard (we didn’t discuss the abstract idea exclusion in class and I didn’t expect you to raise that issue) than the product claims. Bottom line: the mammoths are probably proper statutory subject matter.

Utility is also relatively easy to show. You can put a mammoth in a theme park (some of you made this point, then said that this wasn’t “useful”; I disagree, but gave full credit). *Juicy Whip* takes care of any morality objections to cloning long-dead animals that could eat us all. And bringing the pregnancy all the way through live birth almost certainly suffices to show operable

utility. Yes, Crichton's mammoth died after a few days, but the Wright Brothers' first public flight lasted only twelve seconds.

§ 102

If you write out the timeline, two facts should be apparent.

First, Crichton beat Spielberg to every milestone: the idea, the idea of using the Goldblum algorithm, the DNA sequence, implantation, and birth. Crichton wins this race unambiguously, and there's no need to get into reasonable-diligence arguments. Spielberg's use was in secret, so it doesn't generate any § 102(b) issues.

Second, Goldblum's 2004 publication is clearly more than a year before Crichton's 2007 filing. That triggers the § 102(b) statutory bar, and knocks out claim (3), which is exactly what Goldblum described in the article. Some clever answers used Knight's access to the article to show that it was a publication in the *In re Hall* sense.

§ 103

In light of the previous existence of mammoths, standard biolab techniques, and the Goldblum article, are any of the claims obvious? Knight's parallel realization that the algorithm could be used on mammoth DNA suggests that the idea was in the air, and that this was an inevitable next step, like putting electronic sensors on pedals. If you agree (and you didn't need to agree to get full credit for applying *Graham* and *KSR*), claim (4) is also in trouble.

§ 112

Crichton published the full DNA sequence for its mammoth. Given that sequence, they appear to have used only standard techniques to actually make a mammoth, so claim (2) is definitely enabled. For the same reasons that claims (3) and (4) may now be invalid over the Goldblum article, they're probably also enabled. Read the article and you know how to carry them out. Claim (1) might be the trickiest one here; as in the *Incandescent Lamp Patent* case, claiming all mammoths while only showing how to make *a* mammoth might be an overly broad claim. I didn't mean to put a written description or best mode issue into the problem; I was very happy that almost all of you who discussed best mode pointed out that we simply don't have the facts at hand to let us reach a conclusion on the issue.

Infringement

The most important thing to point out here is that Spielberg *has not yet infringed*. The patent only issued in 2008; all of Spielberg's cloning work took place between 2004 and 2007. The patent rights only start when the patent is issued; yes, patents expire 20 years from the date of filing, but they're not retroactive. (See § 154(b).)

Cloning more mammoths, though, is a different matter. The way I analyze the issue, claims (3) and (4) aren't implicated, since Spielberg already has the DNA sequence. It doesn't need to run

the algorithm again. Claim (1) is literally infringed if Spielberg “makes” another mammoth (or sells the one it already has), though this isn’t a problem if you’ve concluded that claim (1) is invalid. Claim (2) isn’t literally infringed—Spielberg’s mammoth has 2% different DNA—but might be equivalently infringed. That depends on how significant you think 98% identity is in the context of DNA; I didn’t expect you to reach a definitive answer.

Cloning mastodons poses the opposite problem. Here, claims (1) and (2) are clearly not literally infringed. Mammoths aren’t mastodons. Similarly, claim (4) can’t be literally infringed, mammoth DNA isn’t mastodon DNA. Claim (3) would be literally infringed by the use of the Goldblum algorithm to do the matching, but I hoped you’d stick to your guns and say that claim (3) is no threat, since it’s invalid for § 102(b) reasons. This leaves open the possibility that a court would find equivalent infringement by holding a mastodon equivalent to a mammoth. That sounds silly to me, but hey, stranger things have happened and I was happy if you teed up the issue.

Other IP Rights

I hoped you’d point out that Crichton can’t use trade secret as a weapon; it itself publicized its techniques and applied for a patent on them. Moreover, Spielberg misappropriated nothing, from anyone. A few answers surprised me by pointing out that the Goldblum method isn’t copyrightable because it’s a process. That’s quite true, and in context it’s useful to note.

Sources

This is, of course, a *Jurassic Park* problem. Michael Crichton wrote the novel, Steven Spielberg directed the movie version. Laura Dern, Jeff Goldblum, Richard Attenborough, Sam Neill, and Wayne Knight starred. Some of the legal issues explored in the problem are discussed in greater detail in Ryan Hagglund, *Patentability of Cloned Extinct Animals*, 15 GEO. MASON. L. REV. 381 (2008).

(2) **The Truth About Rock Morris**

I was looking for two things in your answers:

First, trademark law is amazingly rich in causes of action. In real life, Norris sued for trademark infringement, false endorsement, false designation of origin, trademark dilution, ACPA violation, and right of publicity violation. I wanted you to pull as many of these out of your hat as you could. Designating them as separate causes of action was less important than pointing out the facts giving rise to the related-but-distinct kinds of harms involved.

Second, this fact pattern has a copyright mess of the sort that many, many sites with user-generated content share. Paris and Nicky and those similarly situated to them are the authors of the content they upload, so Jeremy Hawke could be an infringer or a compilation copyright owner. Jay Sherman is also a potential infringer, and his case raises a strange twist on fair use.

Scores on this question were slightly higher; I think you were in general more comfortable with the subject matter. To get a good score on this question, it was hardly necessary to touch on every base I'll discuss below. I gave out points generously as long as you hit a good cross-section of issues and made good points on the issues you chose to take up. No one ran the table here, but most of you did well.

Trademark Ownership

Morris can't sue for trademark infringement unless he has trademark rights. The problem unambiguously establishes that he's been using his ROCK MORRIS marks in commerce for the sale of hot sauces. That's the basic prerequisite, and it ought to support his federal registrations. He's got nationwide constructive use due to the registration. Some of you suggested that it might be incontestable. It would be, if Morris filed the appropriate forms with the USPTO after five years of registration. The problem doesn't say, but it's a good issue to flag for further investigation.

How strong a mark is it? For hot sauces, ROCK MORRIS certainly doesn't describe any characteristics of the sauce, nor is it a synonym for hot sauce. That makes it arbitrary, and thus inherently distinctive. It's probably not a famous mark, though. Morris may be famous, and his name may be famous, but that doesn't necessarily make the *trademark* famous. Given his regional—and quite modest, as major brands go—sales, the nationwide consuming public probably doesn't associate the phrase ROCK MORRIS with hot sauces, let alone with his hot sauces. There's also a name-mark issue for registrability. The mark here consists of his full name. Since he has his own consent, there's no § 2(c) issue. Nor is it merely a *surname* under § 2(e): the mark here consists of his full name.

General Trademark Issues

Here, I wanted you to start by thinking about defendants. Morris is probably upset both about the web site and the book. That means he's going to be suing both Hawke and Arbitrary House. I wanted at least some distinction between the web site and the book: the web site doesn't sound like it's directly commercial. That could be an issue under dilution, under the ACPA, and for

right of publicity. The book is obviously commercial. So Morris's best hook in regard to the web site may be to argue that the web site is advertising for the book.

Trademark Causes of Action

There's trademark infringement, of course. It was okay if you ticked off important issues. The most important thing to note here is that the goods involved are completely dissimilar: hot sauces and books (or fictional "facts"). Under *Sleekcraft*, that would mean there's no possibility of confusion and thus no infringement lawsuit. But perhaps initial interest confusion (especially given the defendant's URL) could fix that gap.

Dilution probably doesn't work, since the mark isn't famous. Other than that, it's a viable cause of action. The problem contains plenty of facts that would suggest tarnishment, including some rude "facts" about Morris. (The statement about the EPA doesn't directly tarnish the mark *qua* mark, but the one about Mrs. Palsgraf certainly puts a negative spin on "Rock Morris.") Blurring is also quite plausible.

The ACPA suit is obvious; everything turns on whether Hawke's registration is in bad faith. I don't think it is; he's not a Zuccarini. But good answers argued both sides here. They also pointed out the availability of the UDRP as an alternative.

There's pretty clearly some kind of false endorsement issue here; in addition to flagging it under the right of publicity, some of you suggested a § 43(a) suit raising it. The facts are ambiguous as to whether it'd succeed. The book doesn't call itself "official" or "authorized," but perhaps the consuming public would simply expect that it would be.

Another creative angle would be to claim false advertising. The book promises the *truth* about Rock Morris, and doesn't deliver. I don't think the public—which buys this book for amusement, not edification—is really going to be deceived by that "claim." It's a Joe Isuzu claim. Some of you cleverly pointed out that the "fact" about the hot sauce's regulation is literally false. True enough, but in addition to the consumer-understanding issue, there's a deeper problem (one so subtle that I didn't expect you to discuss it). It's not clear that Morris is a relevant competitor here; this isn't a statement made by a competing maker of hot sauces.

Trademark Defenses

There are two general ways that Hawke and Arbitrary House could defend themselves. They overlap. First, there's a fair-use argument. You have to use the ROCK MORRIS mark in order to truthfully describe Rock Morris facts. (I think it's fair use, rather than nominative fair use, but I gave full credit whatever you called it. I did *not* give full credit if you applied the copyright fair use test. That's different and doesn't apply here.) Hawke is simply trying to use the Rock Morris name in the sense that it's come to have among the general public. Second, there's a first-amendment/parody defense. Hawke is making fun of Rock Morris. To the extent he's engaged in valuable speech, there's a first amendment problem if Morris can prevent criticism by trademarking his own name. I personally think that these arguments are winners, but I gave full credit wherever you came out, as long as you raised them and pointed out relevant facts.

Right of Publicity

Morris probably has a right of publicity (depending on state law, good for those of you who raised the issue of unknown state law/choice of law). The book is definitely using his name (and thus his persona) commercially (and the web site arguably is). In addition to the trademark-style defenses, there might be a *Saderup* transformative-use defense.

Copyrightability

I didn't expect Morris to have a copyright here. Any copyright in his character probably belongs to the screenwriter (and thus, per *Aalmuhammad*, to the movie studio). If he does, there's an interesting *Stallone*-style analysis of whether anyone has infringed. The "facts" are so outrageous, that I'd hesitate to call them derivative works; they seem to have borrowed only the idea of an extraordinarily tough guy.

The various facts are probably copyrightable. They certainly possess originality, and fixation (first in the computer and then definitely in the book) is no problem. Yes, they're "facts," but "facts" aren't facts and *Feist* is no problem. No one (I hope) thinks that these are actual truths about Rock Morris, nor does anyone think that Hawke is claiming that they're really true. In any event, they're highly expressive, with individuated turns of phrase.

Paris and Nicky would seem to have a copyright in the facts they wrote. (So would the other uses of the web site.) Are they joint authors of these facts, or does each own a few individually? Good question. Did they write their facts as a work-for-hire for the site? There's no contract, for employment or otherwise, so probably not. Hawke has a copyright in the book, a *compilation* copyright in his selection and arrangement of facts.

Unless he's a copyright infringer, that is. Per *Stallone*, if he's infringing when he copies the facts, he might not have a copyright at all. Thus, his infringement is a significant issue. Copying is basically conceded. I was hoping that you'd raise the question of whether his book is substantially similar to Paris and Nicky's work; he did only take five of their facts. He might also have a fair use defense, or, more usefully, he could argue that his users implicitly gave him permission when they clicked on the upload button.

Whoever owns the book copyright (which could be Arbitrary House, if Hawke assigned copyright, the way Gerald Ford did to Harper & Row) could sue Jay Sherman. Again, copying is conceded. Substantial similarity should be no problem, since he copied the whole thing. Fair use is interesting. Sherman acted with no commercial motive and he probably didn't hurt the market. (If Morris sues and shuts down publication, that's not market harm, since it wasn't a legitimate market.) But he copied a complete, pre-release book that he didn't need to. (He could have mailed his copy to Morris.) A few answers surprised me and pointed out that Sherman has no first-sale defense, since he made a new copy.

Question Sources

Yes, this is a Chuck Norris Facts problem. More than that, it's based on an actual lawsuit, *Norris v. Penguin Group (USA) Inc.*, No. 1:2007cv11480 (S.D.N.Y. complaint filed Dec. 21, 2007), available at <http://james.grimmelmann.net/courses/ip2008/norris-complaint.pdf>. While Norris uses chucknorrisfacts.com for an official collection of Chuck Norris facts, the defendant used truthaboutchucknorris.com and published a book entitled, yes, *The Truth About Chuck Norris*. You can view the offending site at <http://4q.cc/index.php?pid=fact&person=chuck>. Paris and Nicky take their names (and nothing else) from a well-known pair of socialites. Jay Sherman was the lead character in the TV show *The Critic*; Jeremy Hawke was his best friend, an Australian actor with more than a passing resemblance to Paul Hogan. Arbitrary House is a weak pun on Random House.