

Intro IP 2008 Grading Rubric -- STUDENT ID:

- | | <u>Points</u> |
|--|---|
| <ul style="list-style-type: none"> • Problem One: Delilah's Origami Duplicating Machine • Call of the Question / Tone <ul style="list-style-type: none"> • This is a motion for dismissal, so I expect argument. • Counter-arguments should be raised, but the emphasis should be on why your side should win and the other side should lose. • Up to three points for getting the tone right. <ul style="list-style-type: none"> • One point for barely playing the role (introduction and conclusion but little else) • Two points for playing the role throughout but only intermittently • Three points if it really feels like an advocate's brief • If they miss this tone issue, they can still get most of the other points, but not these three. • Also, if someone is really "in role" pretending to be an advocate, I will be forgiving about their failure to discuss some of the weaknesses in their cases, below. In other words, a good role-playing brief will downplay some of the points raised but should nevertheless get the points. • Valid Copyright? <ul style="list-style-type: none"> • Possible Works <ul style="list-style-type: none"> • Designs hanging in museums • Ten simpler designs described in "Penelope's Secrets Revealed." • Originality <ul style="list-style-type: none"> • Independent Creation <ul style="list-style-type: none"> • One point for flagging. • Modicum of Creativity <ul style="list-style-type: none"> • Museum pieces <ul style="list-style-type: none"> • One point for small discussion; two points for more detailed discussion • Issue: how many ways to fold a single sheet of paper? • BUT: counter-argument: These are so complex that skilled artisans can't duplicate them upon sight. <ul style="list-style-type: none"> • Also people are willing to pay high prices. • These really seem to fall well beyond the threshold for creativity. • Book <ul style="list-style-type: none"> • As to the simpler, book ones, perhaps these aren't complex enough. • Some discussion of selection/coordination/arrangement and comparison of this book to yellow pages/white pages. • Fixation <ul style="list-style-type: none"> • One point for flagging/cursory analysis; two points for teasing out the complexity. • What are folds on paper? Are they really the subject matter of copyright? • They seem somewhat less concrete and firm than ink-on-paper or rock chipped away in a sculpture, but does that matter for copyright? • They are easy to undo, but should that matter? | <p>3</p> <p>1</p> <p>1</p> <p>2</p> <p>2</p> <p>2</p> |

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| <ul style="list-style-type: none"> • And is the analysis different for the designs in the book, which seem much more traditionally fixed, than the designs hanging in museums? • Type of Work <ul style="list-style-type: none"> • PGS (origami) • Literary work (book) probably containing PGS (diagrams) • Idea / Expression <ul style="list-style-type: none"> • Many students evaluated the book and the origami in the museums separately for idea/expression. Typical arguments: <ul style="list-style-type: none"> • Both <ul style="list-style-type: none"> • Origami itself is based on an ancient art, so arguably close to unprotectable ideas. • The book is full of simple ideas which might be subject to merger--there are only so many ways to shape a box or crane, for example. • Book and Baker v. Selden <ul style="list-style-type: none"> • As for book, a discussion of Baker is warranted. • Delilah can protect the description of the art, but she can't stop people from using the processes she describes. • However, this might be distinguishable from Baker, because not only is the literary work (the book) the subject of copyright, but the thing that results from the process (the origami design) is also the subject of copyright, unlike the accounting method in Baker. Thus, although Penelope can't use a copyright in the instructions to stop one from following those instructions, she still retains the copyright in the end-product, which after all, is what people have been copying? <ul style="list-style-type: none"> • Bonus point to anyone who comes close to realizing this subtlety. • Useful Article doctrine <ul style="list-style-type: none"> • One point for flagging issue; two for more sophisticated analysis. • PGS? Yes. • Merely to portray the appearance? Seems like it. No further analysis needed • Subtotal (Tone + Validity) • Third Party Infringement? <ul style="list-style-type: none"> • Organization Note <ul style="list-style-type: none"> • Some might focus first on the infringement by the purchasers of the device, because you can't have third-party liability without direct infringement. I prefer to have third-party infringement discussed first, but only slightly, because the facts seem to focus much more on the third-party aspects than the infringement aspects. • Vicarious Liability <ul style="list-style-type: none"> • Prongs <ul style="list-style-type: none"> • 1. Profit from infringing activity • 2. Right and ability to prevent infringement • Applied <ul style="list-style-type: none"> • Profit. Indirect, but probably no less indirect than in Fonavisa or the dance hall cases. • What right and ability to prevent? | <p>1</p> <p>2</p> <p>2</p> <p>1</p> <p>2</p> <p>2</p> <p>19</p> <p>2</p> |

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- **Problem Two: The Sporknife**
 - **Patent**
 - **Call of the question says to focus on problems with validity, so parts about claim construction, DoE, PHE, etc. are not worth points unless they somehow bear on validity.**
 - **Not all validity issues were discussed in this class. These aren't worth anything.**
 - **Utility**
 - **These validity issues don't really seem present here.**
 - **Enablement**
 - **Best Mode**
 - **Obviousness**
 - **Test from John Deere**
 - **Scope and content of prior art** 2
 - One point for noting that prior art isn't limited to the five things recited in the patent, and bringing in at least one other thing that might be added to the list. 1
 - **Differences between prior art and claims** 2
 - Simple combination of S + K + F
 - Added a knife blade to spork
 - Shrunk contractor's buddy
 - **Level of ordinary skill** 1
 - Hard to tell, but should say something.
 - **Secondary considerations** 2
 - One point for listing; two for going more in-depth
 - **Commercial success**
 - Sold thousands of these
 - **long felt but unsolved need**
 - **failure of others**
 - **Application / KSR** 5
 - One point for barely applying tests
 - Two points for short, undetailed discussion
 - Three points for longer discussion that is incomplete or flawed in minor ways
 - for example, lots of focus on the rules, not enough on the application
 - Four points for detailed, convincing discussion.
 - Five points if they do what's need for four and delve deeply into theory/policy/etc.
 - Some points they should raise:
 - This is clearly a combination situation
 - In fact, the word "combines" is in the specification!
 - Combination patents

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- Combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results
- when patent claims structure altered by mere substitution of one element for another known in the field, combination must do more than yield predictable result.
 - Seems very bad for this invention, although this isn't really "substitution"
- simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect...obvious.
- Obvious to try might mean obvious.
- PHOSITA
 - A person of ordinary creativity; not an automaton
- **SUBTOTAL** 13
- **Novelty / Statutory Bars** 2
 - **One point for stating requirement; two for discussion of rules**
 - **Not really at issue here, because none of the five pieces of prior art seem to anticipate the invention, and you must have the entire invention in one piece of prior art.**
 - **Possible problem to flag with contractor's buddy and "of any size".** 1
 - **Also, might have been anticipated by something not in problem.**
 - **Finally, might have been statutorily barred if he began selling it more than a year before applying for the patent.** 1
- **Written Description requirement** 3
 - **One point for cursory analysis; two points for more depth; three points for deep discussion and analysis.**
 - **State rule: patent applicant must show through the specification that he was in possession of the invention later claimed.**
 - Compare the original specification with the final claim, signifying whether the specific features and embodiments later claimed were in fact important aspects of the invention.
 - **Problem: the "of any size" language in the claim seems at odds with the paragraph in the specification.**
 - **Specification graf:**
 - 1. tiny
 - 2. easy-to-carry
 - 3. crams
 - 4. Unlike the contractor's buddy, this tool is small enough to fit in a pocket.
 - **Comparison to Gentry Galley is useful for this discussion.**
- **Patentable Subject Matter** 1
 - **Counts as a manufacture.**
 - **Also, an improvement patent.**
- **SUBTOTAL** 8
- **Trademark**

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- **Call of the question says to focus on the strength of the trademark.**
- **Strength of the mark**
 - **Use in commerce** 1
 - No TM unless used in commerce. Seems satisfied here.
 - **Distinctiveness scale** 4
 - One point for cursory analysis.
 - Two points for more depth and discussion but incomplete or with flaws.
 - Three points for good, detailed discussion.
 - Four points for meeting three points and adding layers of sophistication or depth.
 - This is the combination of "spoon" "fork" "knife"
 - It might be generic.
 - At the very least it is descriptive.
 - Doesn't really seem suggestive.
 - Tests for distinguishing between descriptive and suggestive (from Zatarain's)
 - Dictionary test
 - Imagination test
 - Competitor need
 - Actual prior use
 - Don't knock students down too much for failing to know that combining generic terms doesn't necessarily make something suggestive. We discussed in class, but perhaps not in enough depth.
 - **Secondary Meaning?** 2
 - If merely descriptive, we need to establish secondary meaning.
 - "I've sold thousands" is good, but questions about how well it has been marketed.
 - Discussion of the surveys we will need to run is helpful.
 - **Possible conflict with prior mark** 3
 - Three points hard to come by here.
 - A few students did the entire sleekcraft analysis. Two points.
 - One point for flagging; two points for short discussion; three points for detailed discussion including awareness of ramifications.
 - "Spork" was used for decades and was well-known.
 - Even if not registered, probably a trademark.
 - Is it generic?
 - Priority rule says that senior user wins
 - **Effect of Registration** 1
 - One point for detailed, mostly accurate discussion of conflicts between registered and unregistered marks and geography.
 - **Trade Dress / Functional Trademarks** 2
 - Because the call of the question talks about "the trademark", it isn't really fair to give too many points for this, so only give up to two points for very, very detailed discussions.

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- **Strength**
 - Product Design, not product packaging -> cannot be inherently distinctive.
 - Secondary meaning
- **Functionality**
 - Traffix: Essential to the use or purpose or affects the cost or quality of the article.
 - Grant of patent strongly suggests utility
- **Subtotal** 13
- **PROBLEM TOTAL** 34
- **Problem Three: Patent Fair Use**