

## JEOPARDY QUESTIONS: PATENT

Ellen Bierman – April 1, 2015

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Question:	This case established the analytical framework currently used to determine whether a patent claim covers a patent-ineligible abstract idea.
Answer:	What is <i>Mayo Collaborative Services v. Prometheus Labs</i> ?

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Question:	A decision from the Patent Trial and Appeal Board may be appealed to this court.
Answer:	What is the Federal Circuit or the U.S. District Court for the <u>Eastern</u> District of Virginia? (trick question – it is either)

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Question:	In <i>Alice v. CLS Bank</i> , the Supreme Court overruled the notion that this is the sole test for determining whether a computer-implemented invention for transforming data is considered patent eligible.
Answer:	What is the “machine or transformation” test of <i>In re Bilski</i> ?

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Question: Under this provision of the U.S. Code, “[w]hoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.”

Answer: What is 37 U.S.C. § 271(f)(1)?

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Question: Under this doctrine, a defendant cannot be held liable for inducing infringement of a patent method claim when no single entity has directly infringed the claim, even if all steps of the claim are performed by multiple entities.

Answer: What is divided infringement (or *Akamai v. Limelight*)?

6

Question: This standard governs the review of factual matters relating to claim construction.

Answer: What is the clear error standard? (no longer de novo) (*Teva Pharmaceuticals v. Sandoz*)

7

Question: This extrinsic evidence can be helpful to educate the court regarding the field of the invention and determining what one of skill in the art would understand claim terms to mean.

Answer: What are dictionaries and expert testimony? (Admissible under discretion of the court but must be considered in light of intrinsic evidence – Phillips v. AWH)

8

Question: These categories of claimed inventions are patent ineligible abstract ideas.

Answer: What are fundamental economic principles, certain methods of organizing human activities, an idea of itself, and mathematical relationships?

9

Question: Under this statutory rule, a patent for a claimed invention may not be obtained, ... if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.

Answer: What is obviousness under first to file rules (AIA)? (35 U.S.C. § 103)?

Question:	Judge Rader said of this: “The remedy for _____ is the “atomic bomb” of patent law.”
Answer:	What is inequitable conduct? ( <i>Therasense, Inc. v. Becton Dickinson</i> quoting Rader’s dissent in <i>Aventis</i> )

**JEOPARDY QUESTIONS: TRADEMARK**  
**Annie Allison / Lori Tonnes-Priddy**

1. This case, recently decided by the U.S. Supreme Court, holds that a private party can bring a Lanham Act /unfair competition claim even though a separate federal statute exists to resolve the same issue – not so “wonderful” for one of the parties involved! **(Answer: What is Pom Wonderful LLC v. Coca-Cola Co.?)**
  
2. You would use this section when registering a trademark for which you have a bona fide intent to use in commerce, but aren't yet using in commerce. **(Answer: What is Section 1(b) “Intent to Use”?)**
  
3. This trademark for "nutrient or tonic beverages" was registered in 1893. **(Answer: What is “Coca-Cola”?)**
  
4. This trademark for "explosive-engines and their parts" was registered in 1909. **(Answer: What is “Ford”?)**
  
5. This NFL football team attempted to trademark the phrase “19-0,” back in 2008, a reference to a spotless season, only to lose the Super Bowl two weeks later – perhaps they'd have better luck registering the trademark “deflategate” instead! **(Answer: Who are the New England Patriots? The Patriots didn't go 19-0 as they'd hoped — the New York Giants won Super Bowl XLII which dropped the Patriots' season to 18-1. Nah nah nah nah nah!!!)**
  
6. This hard-partying reality TV star lost the rights to her ubiquitous name to a cartoon cat? **(Answer: Who is Nicole “Snooki” Polizzi from “Jersey Shore”? Polizzi applied for the rights to her nickname in connection with her TV personality and line of books in 2010, but the USPTO had already granted a fictional feline the rights back in 2004. Snooky the Cat apparently has his own series of stories called “Adventures of Snooky.” The USPTO raised concerns that there would be a "likelihood of confusion" between Snooky and Snooki.)**
  
7. The sole purpose of this kind of trademark is to indicate that the user of the mark is a member of a particular organization. **(Answer: What is a collective membership mark?)**
  
8. The addition of this numeric symbol to an otherwise unregistrable trademark typically will not magically make the mark registrable! (Hint: as the *Unbreakable Kimmy Schmidt* would say, “Hashbrown, Fail!”) **(Answer: What is a hashtag?)**

9. This international treaty allows a trademark owner to seek registration in any of the countries or intergovernmental organizations that have joined by submitting a single trademark application. **(Answer: What is The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks?)**
  
10. This factor completes the four (4) Morton-Norwich functionality factors which include: (1) advertising by the applicant that touts the utilitarian advantages of the design; (2) facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture; and (3) facts pertaining to the availability of alternative designs. **(Answer: What is the existence of a utility patent that discloses the utilitarian advantages of the design sought to be registered)**

**SEATTLE IP INN OF COURT: GROUP 7'S APRIL 16, 2015 PRESENTATION**

**TRADE SECRETS**

<b>Level</b>	<b>Answer</b>	<b>Question</b>	<b>Authority</b>
100	This can be defined as any valuable business information that is not generally known and is subject to reasonable efforts to preserve confidentiality.	What is a trade secret?	<i>E.g.</i> , <u>RCW 19.108.010(4)</u> (Washington's version of UTSA).
100	Examples of these may include customer lists, manufacturing methods, chemical processes and formulas, source code, cost information, or marketing data and strategies.	What are trade secrets?	
200	This attempted to codify and harmonize the basic principles of common law trade secret protection.	What is the Uniform Trade Secret Act?	
200	To date, this has been enacted by 47 states, the District of Columbia, Puerto Rico and the U.S. Virgin Islands.	What is the Uniform Trade Secret Act?	
300	Trade secrets must be <i>this</i> to be protected, meaning they cannot be readily ascertainable from another legitimate source.	What is "novel"?	<i>E.g.</i> , <i>Spokane Research &amp; Defense Fund v. City of Spokane</i> , 983 P.2d 676, 682 (Wash. Ct. App. 1999).
300	This occurs when a person discloses, or uses a trade secret without consent and knows or should know that the trade secret was acquired under circumstances that gave rise to a duty to maintain its secrecy or limit its use.	What is misappropriation of a trade secret?	<i>E.g.</i> , <u>RCW 19.108.010(2)(b)</u> .
400	At common law (before the UTSA), many courts relied on this, published in 1939, to determine whether information was a trade secret.	What is the 1939 Restatement (First) of Torts?	<i>E.g.</i> , <i>Ed Nowogroski Ins., Inc. v. Rucker</i> , 971 P.2d 936, 944 (Wash. 1999).
400	This federal statute imposes criminal penalties for trade secret misappropriation, including fines of up to \$250k and/or 10 years imprisonment for individuals and fines of \$5M for organizations convicted.	What is the the Economic Espionage Act (or 18 U.S.C. §§ 1831-39)?	

500	These three states have not adopted the UTSA and instead protect trade secrets under unique state statutes or under the common law.	What are Massachusetts, New York, and Texas?	
500	This proprietary formula for Coca-Cola was one of the most well-known examples of a trade secret.	What is Merchandise 7X?	In 2007, a federal district court in Georgia upheld conviction and 8-year prison sentence of Coca-Cola employee found guilty of conspiring to sell Coca-Cola's trade secrets. <i>See</i> <a href="http://www.justice.gov/criminal/cybercrime/press-releases/2007/williamsSent.pdf">http://www.justice.gov/criminal/cybercrime/press-releases/2007/williamsSent.pdf</a> .

### **100 point questions**

1. In a civil action, a jury's verdict must be this unless otherwise stipulated.
  - a. What is unanimous?
    - i. Rule 48(b)
2. When calculating a time period for a responsive brief, this day is excluded.
  - a. What is the day of filing?
    - i. Rule 6(a)(1)(a)

### **200 point questions**

1. Often the subject of dispute, the manner in which these are counted may impact your strategy for written discovery to your opponent.
  - a. What are subparts?
2. A corporate entity must identify for the court any parent corporation which owns at least this much of its stock.
  - a. What is 10%?
    - i. Rule 7(a)(1)

### **300 point questions**

1. If you are at least 18 years old and not a party, you are permitted to do this.
  - a. What is serve a summons and complaint?
    - i. Rule 4(c)(2)
2. This rule governs default judgments.
  - a. What is Rule 55?

### **400 point questions**

1. Prior to entry of a preliminary injunction, a court must provide this to the adverse party.
  - a. What is notice?
    - i. Rule 65(a)(1)
2. This type of error is one which does not affect any party's substantial rights.
  - a. What is harmless error?
    - i. Rule 61

### **500 point questions**

1. The Federal Rules of Civil Procedure do not apply to this type of proceeding in admiralty.
  - a. What are prize proceedings?
    - i. Rule 81(a)(1)
2. When suing the federal government, expect to wait this many days before receiving a response.
  - a. What is 60 days?
    - i. Rule 12(a)(2)

**Seattle Intellectual Property American Inn of Court  
April 16, 2015 "IP Jeopardy" Presentation**

**10 Ethics Clues / Q&A**

1. Clue: In a rare U.S. Supreme Court show cause order in 2014, the Justices threatened to sanction an attorney for unprofessional conduct in a patent case due to his failure to do this with his client in filing a petition for certiorari.

Answer: Disregarding his client's wishes and rewriting the brief.

Notes: The U.S. Supreme Court made the surprising move of ordering Foley & Lardner LLP partner Howard N. Shipley to show why he shouldn't be sanctioned for his conduct stemming from an apparently jumbled petition for a writ of certiorari filed in a suit over a telephone call routing patent.

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2. Clue: According to Washington RPC 4.2, if a lawyer for Party A wishes to speak directly to Party B (who is represented by counsel), Party B must first do this.

Answer: Party B must get Party B's lawyer to consent. (The consent of Party B itself is not sufficient.)

Note: RPC 4.2 (Communications with Represented Parties)

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3. Clue: In 2014, the Federal Circuit admonished an attorney for failing to do this, which resulted in the deadline to appeal a \$40 million patent verdict to be missed.

Answer: Timely reading every minute order and substantive order entered by the district court judge.

Note: Fed. Circ. Slams Sidley & Austin For Blown Deadline In \$40M AT&T Case

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4. Clue: An attorney's false or misleading statements to the PTO during trademark prosecution can lead to this happening to the trademark registration during subsequent litigation.

Answer: Cancellation for fraud.

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5. Clue: According to Washington RPC 7.3, a lawyer may solicit business from a prospective client via written communications unless the following applies.

Answer: (1) the prospective clients has made known to the lawyer they do not want to be solicited; or (2) the solicitation involves coercion, duress, or harassment.

Note: RPC 7.3 Lawyer Solicitations

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6. Clue: In 2014, a U.S. District Court Judge for the District of Idaho sanctioned defense counsel in a radar detector patent case for knowingly producing the wrong version of this to support a non-infringement defense.

Answer: Source code.

Note: Wood Herron Attorneys Sanctioned For “Reckless” Misdirection

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7. Clue: Fed. R. Evid. 408 settlement communications are admissible in court for this purpose.

Answer: To establish (1) witness bias or prejudice, (2) to negate a contention of undue delay, (3) to prove an effort to obstruct a criminal investigation or prosecution, or (4) to show a separate cause of action arising out of the settlement negotiations themselves.

Note: Admissibility of Settlement Communications

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8. Clue: In 2014, a U.S. District Court Judge for the Northern District of California admonished counsel in a patent case, under penalty of sanctions, to stop doing this in violation of the law governing Fed. R. Civ. P. 32(d).

Answer: Making speaking / coaching objections during depositions.

Note: Judge Threatens Irell & Manella For Deposition Tactics In Patent Fight

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9. Clue: In 2014, a U.S. District Court Judge for the Northern District of California imposed millions of dollars in sanctions against a law firm for violating a protective order by doing this.

Answer: Inadvertently disclosing an AEO (damages) expert report to its client (in violation of the PO)

Note: Quinn Emanuel (Samsung) failed to carefully follow the protective order and notify the harmed parties (Apple and Nokia) about the breach.

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10. Clue: The “final chapter” of the *Aptix Corp. v. Quickturn Design Systems, Inc.* litigation was written when the patentee was imprisoned for this unethical conduct.

Answer: Attempting to hire a hitman to murder the judge.

Here are the clues for copyright. I tried to keep a theme of famous/interesting copyright cases.

Blurring the lines between inspiration and infringement, a jury awarded \$7.3 million in damages and lost profits against these two artists for infringing Marvin Gaye's hit song "Got to Give It Up."

Who are Robin Thicke and Pharrell Williams?

<http://www.rollingstone.com/music/news/robin-thicke-and-pharrell-lose-blurred-lines-lawsuit-20150310>

In a 2013 decision concerning the importation of copyrighted books from Thailand, the U.S. Supreme Court held that this doctrine applies equally to copies of a copyrighted work lawfully made abroad but imported into the United States without the copyright holder's permission.

What is the first sale doctrine?

<http://www.hollywoodreporter.com/thr-esq/supreme-court-rules-entertainment-industry-429695>

In the landmark copyright case pitting Roy Orbison's publisher of "Oh, Pretty Woman" versus 2 Live Crew, the U.S. Supreme Court set the standards for this type of fair use protected under the Copyright Act.

What is parody?

<http://www.usatoday.com/story/money/business/2014/06/05/2-live-crew-copyright-case-turk/10045249/>

In *Sony v. Universal City Studios*, the Supreme Court ruled that it was legal for consumers to record and later watch their favorite programs on VHS or Betamax recorders under this application of the fair use doctrine.

What is time shifting?

<http://eightiesclub.tripod.com/id408.htm>

In *A&M Records, Inc. v. Napster, Inc.*, the Ninth Circuit effectively killed Napster when it held that the peer-to-peer file sharing service constituted copyright infringement under these two theories of secondary liability?

What are vicarious liability and contributory infringement?

<http://onlinelaw.wustl.edu/case-study-am-records-inc-v-napster-inc/>

In cases involving invalid copyright registrations of characters from Beavis and Butthead and Star Wars, the Ninth Circuit held that the "Copyright Act does not contemplate the copyrighting of a now non-existent original on the basis of a tendered reconstruction" but instead requires the applicant to deposit this with the application for a certificate.

What is a bona fide copy of the original work?

<http://openjurist.org/152/f3d/1209/kodadek-v-mtv-networks-inc>

Cryptomnesia is the technical term for this type of copyright infringement first articulated in a case involving a lawsuit against the Beatles' George Harrison for his unintentional copying of the Chiffon's hit song "He's so Fine."

What is subconscious plagiarism?

<http://abbeyrd.best.vwh.net/mysweet.htm>

As made infamous by the scores of lawsuits against Forever 21, this form of expression is not copyrightable as the law deems it to be more utilitarian than aesthetic?

What is clothing design?

<http://www.cardozoelj.com/2014/09/19/protecting-fashion-a-comparative-analysis-of-fashion-design-copyright-protection-in-the-u-s-and-europe/#.VR2m7eFm7y8>

Much to the dismay of West Publishing, the Second Circuit held that West Publishing's compilation of judicial opinions in its case reports were not copyrightable due to the absence of this necessary element?

What is originality (or creativity)?

[https://www.law.cornell.edu/copyright/cases/158\\_F3d\\_674.htm](https://www.law.cornell.edu/copyright/cases/158_F3d_674.htm)