TEACHING INTELLECTUAL PROPERTY AS A SKILLS COURSE

Malla Pollack[a]

Introduction

Legal education needs more than books. Because law is something one does, *students* need to practice doing law. Practicing with live clients, however, is hard on both clients and law schools. Therefore, "[e]ach law school is encouraged to be creative in developing programs of instruction in professional skills related to the various responsibilities which lawyers are called upon to meet, using the strengths and resources available to the school."[1]

This article supports using intellectual property courses for skills instruction by sharing easily reproducible exercises, one each on covenants not to compete, copyright, trademark/trade dress, and patent. The exercises have been field tested on students. Any required props are relatively inexpensive, easily available, and reasonably small. Size is an issue because the students need to be able to handle the materials while working on their individual projects. My usual solution is to place the materials for each project in a cardboard carton and place the carton (as a single item) on reserve in the law library. The patent-project does have the draw-back of needing set-up; my accommodating library allows me to put this on the top shelf of a book cart parked in the reserve section (where student access is mediated by library staff).

These exercises have another major virtue; they model counseling to prevent law suits, in addition to discussions of what happens during litigation. The casebook method focuses law students on cleaning up client's messes. Much, probably most, of law is different. Lawyers spend most of their time trying to help clients keep out of court. Generally, clients want to do business; lawsuits are business failures.

I. Example One: Dealing With Covenants Not to Compete

A. The Written Assignment Given to the Class

> **Due:** [Due date], at the beginning of class. Late papers will be penalized. If you are late to class on [due date], your paper is late.
>
> **Format:** Paper should be typed, double spaced, and proof read. Please use 12 point font or larger. Do not put your name anywhere on the paper. Identify the paper only with your anonymous student grading number. All sheets of paper in the assignment should be stapled together at the upper left hand corner. Please do not use folders or binders of any kind.

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[a] Professor, American Justice School of Law. The author gives permission to anyone who wishes to reproduce or edit any of the exercises and related exhibits for the purposes of teaching.

[1] Interpretation 302-2 to ABA standard 302.

Assignment: You are associate T. Tryhard at the law firm of Yours, Mine, and Ours, P.C., 400 Legal Lane, DeKalb, IL. You have received the attached memo from senior partner Milton Mine. Each student (taking the persona of T. Tryhard) will have a one-half hour interview with Ms. Paula Prudent. The interviews will be observed by Professor _____ who will remain silent through out. On [due date], you must hand in (i) a proposed letter from Mine to Samuel Standup, and (ii) a cover memo from Tryhard to Mine.

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To: T. Tryhard
From: Milton Mine
Client: Elvira Enterprises, Inc.
Client Contact: Mr. Samuel Standup, Esq. , Corporate Counsel
Billing Code: 666666-0038
Date: [two weeks before due date]

I need you to work on a project for one of our major clients, Elvira Enterprises, Inc. ("EE"). Since I will be out of town on trial, you will have to interview Ms. Paula Prudent. Please remember that Prudent is not our client.

On my return, I would like to find your proposed draft of my letter to Samuel Standup. Standup is not an intellectual property attorney, but he insists on being told the legal basis of any proposed course of action. He is also very busy. Please be concise.

EE is planning to open its first boutique pet store. The pilot store will be located in the Water Tower shopping mall on Michigan Avenue in Chicago. Currently, EE manufactures high priced pet supplies and toys. EE has been selling these products wholesale. EE wants to begin marketing its own products by catalog, internet, and retail store. The store in the Water Tower is the first step in this expansion. EE is headquartered in Chicago and incorporated in Illinois.

EE plans to have an attractive animal greet its customers at the Water Tower store. The same animal will be used in the catalog and internet promotions. Ms. Paula Prudent's goffins' cockatoo, Gandalf, is a prime candidate for the position of greeter. Since cockatoos have strong ties to specific humans, Prudent would be a salaried employee of EE. Gandalf will remain the property of Prudent.

Standup's legal concern focuses on the contract Prudent signed when she sold her pet store to Mildred Mouse. Prudent's former store is Paula Prudent's Parrots ("PPP") in Naperville,

Illinois. PPP was never incorporated; it is a registered fictitious business name. Prudent ran PPP for 25 years. During that time, Prudent brought her personal pet parrot to the store with her whenever possible. The pet had a perch behind the sales counter. Gandalf, a goffins' cockatoo, took on this role about 15 months before Prudent sold PPP.

The contract defines "Buyer" as Mildred Mouse, "Seller" as Paula Prudent, "PPP" as Paula Prudent's Parrots, and "Pre-existing Customers" as "persons who bought any item from PPP while it was owned by Seller." The "effective date" of the contract is January 5, 2006. Among other provisions, the contract reads:

> Buyer has the exclusive right to use the name "Paula Prudent's Parrots."
>
> Seller will not open a competing store within the State of Illinois for three years after the effective date of the contract. For five years after the effective date, Seller will not solicit pet-related business from Pre-existing Customers. Seller will not use any information from PPP's sales records, mailing lists, or lists of suppliers at any time for any competing enterprise unless such information becomes public knowledge without fault of Seller.

As you know, Water Tower Place is a very high end shopping complex in downtown Chicago. Naperville is one of Chicago's dormitory, commuter-train communities. Paula Prudent's Parrots is approximately thirty-two miles from the Water Tower. Without traffic delays, the trip from Naperville to the Water Tower takes about forty-five minutes by automobile.

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B. Assignment Goals

This problem provides students with an opportunity to respond to a realistic assignment which requires legal research, professional writing, and using an interview to gather information. If resources are scarce, the interview can be done in class by the students as a group. However, having each student do a separate interview (which the professor can later critique) would support the course's eligibility for meeting the ABA requirement that each student take courses

with substantial professional skills components.[2] Video taping the interviews to allow students to see their own performances would increase the value of the exercise.[3]

The problem starts with the type of memorandum commonly sent by partners to junior associates. The associate is given a reasonable, but extremely limited, amount of time to review the basic law and think through the type of information she needs to obtain from Paula Prudent. If the entire class is interviewing en mass, the professor can play Paula Prudent.[4] Otherwise, the professor needs to recruit substitutes and provide them with background information from which they may not deviate during interviews. Of course, Prudent should not volunteer information. Since Prudent is not Tryhard's client, the students practice professional reticence.

Paula Prudent knows (and will only reveal if questioned) that during her ownership Paula Prudent's Parrots had a largely repeat clientele most of whom lived in Naperville and worked in Chicago. She knows this because the store was located near the commuter railroad station and many of her customers came there on the way home from work. The store's only advertisements were in local classified telephone directories and the type of free publications piled near the exits of supermarkets. Paula worked in the customer area of the store at least forty hours a week when she was younger. During the last five years, however, Paula has largely confined her work to the store's back office where she was invisible to retail customers. As for PPP's customers recognizing Gandalf, all goffins' cockatoos look identical to most humans. Gandalf's vocabulary does not include the name of the store where he used to hang out. He says: "Hello"; "I love you"; "Parrot Power"; "Want to shake hands?"; "Gandalf rules"; "Share"; and "Let me out."

Hopefully, students will suggest three possibilities to Mr. Samuel Standup, Esq., Corporate Counsel, to Elvira Enterprises, Inc.: (i) obtaining a release from Mildred Mouse, (ii)

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[2] *See* Interpretation 302-3:

> A school may satisfy the requirement for substantial instruction in professional skills in various ways, including, for example, requiring students to take one or more courses having substantial professional skills components. To be "substantial," instruction in professional skills must engage each student in skills performances that are assessed by the instructor.

ABA Accreditation Standard 302 was revised effective February 14, 2005, adding new standard 302(a)(4):

> "A law school shall require that each student receive substantial instruction in: . . . (4) other professional skills generally regarded as necessary for effective and responsible participation in the legal profession."

See Memorandum from John A. Siebert, Consultant on Legal Education, to Deans of ABA-Approved Law Schools (Feb. 17, 2005).

[3] *See, e.g.,* Miguel A. Méndez, *Teaching Evidence*, 50 ST. LOUIS UNIV. L.J. 1133, 1145 (2006) (recognizing that reviewing video-tapes of student enactments is a valuable but time-intensive teaching activity).

[4] The only prop needed here is optional - a cockatoo. I use the real Gandalf when I play Paula, but a stuffed animal would supply some ambiance without risking tort liability.

limiting Paula Prudent's job duties to minimize any possible liability (providing specifics), and (iii) not hiring Prudent. Also hopefully, students will recognize that the final choice is a business decision to be made by the client.

The first possibility provides a follow-up exercise in another skill– negotiating a release. Each student sits down with Mildred Mouse and attempts to obtain a release by offering some combination of contractual promises regarding Paula Prudent's duties at EE, suggestions about the lack of overlap between EE's new project and Paula Prudent's Parrots, and (c) payment in money, products, or services. Additionally, students can practice drafting both Prudent's job description and Mouse's release.

II. Example Two: Alleged Copyright Infringement of a Children's Book

A. The Written Assignment Given to the Class (Litigation Version)

ABC BOOK WRITING PROJECT

The first draft of the ABC Book project is due at the beginning of class on [date]. The professor will return the papers with written comments (but without grades) as soon as possible. The final version of the paper (which will be graded) is due at the beginning of the class meeting on [date].

The exhibits will be placed on reserve in the Law Library for this class as "ABC BOOK WRITING PROJECT." Each exhibit will have a numbered label.

Writing Project

Your assignment is to write a trial brief to Judge Jane Justice on the sole issue of substantial similarity. Of course, to reach this issue you need to argue about what copyrightable material, if any, is common to the Plaintiff's Work and the Defendants' Book. You may represent either side. The assignment includes locating the most pertinent cases. Do not limit your discussion to the cases covered in class. **This is an individual project. Discussing it with another person is a violation of the honor code.** The brief's format should be:

Table of Contents
Table of Authorities
Summary of Argument
Argument (broken into appropriate subparts)
Conclusion

The first draft is not required to include either the Table of Contents or the Table of Authorities.

For both drafts, use Times New Roman 12 point font, with single spaced lines, one inch margins. No page limit or minimum, but briefer is better. **Be sure to number the lines of your document.**

This will help the professor key her comments to your paper.

A good brief will:

(i) include discussion of the most pertinent cases;

(ii) include all the legal doctrines the court will need to decide the issue;

(iii) **argue fact details**;

(iv) be well written; and

(v) be technically correct in citation format.

Background Litigation.

The case is *Phoebe Philbert v. Alan Baker and Larousse Kingfisher Chambers, Inc.* (No. 06-1234, Judge Jane Justice, S.D.N.Y.). Philbert is represented by that well-known [town where law school is located] firm, Myers, Myers and Yours, P.C. (specifically associate Mable Mixitup and partner John Myers). Both defendants are represented by the New York City firm of Maximum, Punitive, and Damages, P.C. (with partner Matilda Maximum leading).

The case file so far contains:

(1) a Complaint (verified by an affidavit from Phoebe Philbert)[see below];

(2) the Answer [see below];

(3) an affidavit signed by Georgette Gofor [see below];

(4) the Work (as defined by the Complaint);

(5) the allegedly infringing book ("Defendants' Book" as defined by the Complaint);

(6) copies of the books listed as exhibits to Gofor's affidavit.

For purposes of this project, assume counter factually that Defendants' Book was published for the first time in 2006. I have not made "copies" of the certificates of service, or the copyright registration forms. You should assume that these items exist and are not at issue.

To save money and efficiently dispose of the case, Judge Jane Justice has scheduled a bench trial on the sole issue of substantial similarity. To make this ruling, Judge Justice needs to decide what copyrightable subject matter (if any) is common to both Phoebe Philbert's Work and the Defendants' Book (as defined in the Complaint). The bench trial will consist of a stipulated record and oral argument by telephone. So far, the Stipulated Record consists of the items in the case file (including all exhibits).

Before the telephone argument, both sides are to submit Trial Briefs to the judge. Either side has the option of providing additional exhibits with supporting affidavits. (The professor would be interested in copying or repurchasing additional exhibits for addition to the case file).

The Work

The Work is provided as an appendix to this article. I usually put a hard copy on reserve in the law library and post a PDF version on line.

United States District Court
Southern District of New York

Phoebe Philbert, Plaintiff	)	
v.	)	Civ. Case No. 06-1234 (JJ)
Alan Baker, Larousse Kingfisher Chambers, Inc., Defendants.	)	

COMPLAINT

1. This is a cause of action for infringement of copyright in a literary and pictorial work in violation of the Copyright Act of 1976 as amended, 17 U.S.C. § 101 *et.seq.*
2. This Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1332(a)(1) and 1338.
3. Plaintiff Phoebe Philbert ("Philbert") is a natural person domiciled in the city of [law school's city, state].
4. On information and belief, Defendant Alan Baker ("Baker") is a natural person domiciled in Manhattan County, New York City, New York State.
5. On information and belief, Defendant Larousse Kingfisher Chambers, Inc. ("Kingfisher") is a corporation organized

under the laws of the State of New York with its principal place of business in Manhattan County, New York City, New York State.

6. Venue is proper in the Southern District of New York pursuant to 28 U.S.C. §§ 1391(b), (c) and 1400(a).
7. On information and belief, the amount in controversy exceeds seventy-five thousand dollars ($75,000.) exclusive of costs and interest.
8. On or around January of 2004, Philbert completed a saleable draft of a children's alpha-bet book entitled "A is for Apple: Adorable Bunnie Draws an Apple" (the "Work"). A true and correct copy of the Work is attached to this Complaint as Exhibit A.
9. On or around January of 2004, Philbert filed an application for copyright registration of the Work with the Copyright Office of the United States. Registration was issued on March 4, 2004. A true and correct copy of the registration certificate is attached to this Complaint as Exhibit B.
10. The Work is the original creation of Philbert.
11. Philbert is sole author of the Work.
12. The Work contains copyrightable subject matter.
13. On or around April of 2004, Philbert mailed a copy of the Work to Defendant Kingfisher with a request that Defendant Kingfisher contact Philbert about publishing a later version of the Work and paying Philbert for permission to do so. The mailing was not returned to Philbert by the United States Post Office.
14. In 2006 Defendant Kingfisher published in the United States a children's book purporting to have been authored by Defendant Baker. Defendants' book was marked "BLACK AND WHITE RABBIT'S ABC [by] Alan Baker" ("Defendants' Book"). A true and correct copy of Defendants' Book is attached to this Complaint as Exhibit C.
15. Defendants never asked Philbert for permission to use the Work. Defendants never received permission from Philbert to use the Work. Defendants never paid Philbert for using the Work.
16. Defendants' Book violates Philbert's rights pursuant to the Copyright Act of 1976 as amended, 17 U.S.C. § 101 *et. seq.*

WHEREAS Plaintiff Philbert requests this Court to:

(1) Enjoin Defendants from continuing to publish and

distribute Defendants' Book;

(2) Order Defendants to recall all copies of Defendants' Book that have not yet been sold to consumers;

(3) Order Defendants to pay Plaintiff damages of all types allowable under the Copyright Act of the United States;

(4) Order Defendants to pay Plaintiff's costs and attorneys' fees for this suit; and

(5) order whatever other relief the Court deems proper.

April 10, 2006

Mable Mixitup
Mable Mixitup, Esq.
John Myers, Esq.
Myers, Myers & Yours, P.C.
4333 Legal Lane
[town, state, zip code]
xxx-xxx-xxxx
COUNSEL FOR PLAINTIFF
PHOEBE PHILBERT

AFFIDAVIT OF PHOEBE PHILBERT

I, Phoebe Philbert, having been duly sworn affirm:

1. I am above the age of eighteen. I have personal knowledge of the information contained in this affidavit.
2. I am the sole author of the Work described in paragraph 8 of this Complaint. A true and correct copy of the Work is attached to this Complaint as Exhibit A.
3. All facts mentioned in this Complaint are true.
4. All facts pleaded "on information and belief" in this Complaint are based on a reasonable investigation conducted by me or my agents.

FURTHER AFFIANT SAYETH NOT.

Phoebe Philbert

Signed and Sworn to before me this 10th day of April 2006.
My commission expires on January 15, 2008.

Natalie Notary
Notary Public

United States District Court
Southern District of New York

Phoebe Philbert, Plaintiff	)	
v.	)	Civ. Case No. 06-1234 (JJ)
Alan Baker, Larousse Kingfisher Chambers, Inc., Defendants.	)	

ANSWER of Defendant Larousse Kingfisher Chambers, Inc. and of Defendant Alan Baker

1. Admits that the Complaint in this action purports to assert a cause of action for infringement of copyright in a literary and pictorial work in violation of the Copyright Act of 1976 as amended, 17 U.S.C. § 101 *et.seq*. Otherwise denies all allegations of Paragraph One of the Complaint.
2. Admits that if the Complaint is accurate, this Court has subject matter jurisdiction.
3. Lacks information sufficient to admit or deny.
4. Admits.
5. Admits.
6. Admits that if the Complaint is accurate, venue is proper in the Southern District of New York.
7. On information and belief, denies that the amount in controversy exceeds seventy-five thousand dollars ($75,000.) exclusive of costs and interest.
8. Lacks information sufficient to admit or deny.
9. Admits that Exhibit B to the Complaint appears to be a copy of a Registration certificate issued on March 4, 2004. Otherwise lacks information sufficient to admit or deny the allegations of paragraph 9.
10. Lacks information sufficient to admit or deny.
11. Lacks information sufficient to admit or deny.
12. Denies.
13. Denies that Kingfisher has any record of receiving a copy of the Work at any time. Otherwise lacks information sufficient to admit or deny the allegations of paragraph 13 of the Complaint.

14. Admits that in 2006 Defendant Kingfisher published in the United States an original children's book authored by Alan Baker with the title, "Black and White Rabbit's ABC." Admits that Exhibit C to the Complaint appears to be a black and white copy of the pages and cover from "Black and White Rabbit's ABC" by Alan Barker as published by Kingfisher in 2006 in the United States. Otherwise denies the allegations of paragraph 14 of the Complaint.
15. Admits.
16. Denies.

FIRST AFFIRMATIVE DEFENSE

Plaintiff is barred from relief by the doctrine of latches.

SECOND AFFIRMATIVE DEFENSE

Plaintiff is barred from relief by the doctrine of unclean hands.

WHEREAS both Defendants request this Court to:
(1) dismiss the Complaint with prejudice;
(2) grant judgment for Defendants;
(3) rule that Plaintiff takes nothing of Defendants;
(4) order Plaintiff to pay Defendants' costs and attorneys' fees for this suit; and
(4) issue whatever other orders and relief the Court deems just.
April 20, 2006.

Matilda Maximum, Esq.
Matilda Maximum, Esq.
Maximum, Punitive, and Damages, P.C.
One Courthouse Lane
New York City, New York 10000-1111
212-xxx-xxxx
ATTORNEYS FOR DEFENDANTS
ALAN BAKER and
LAROUSSE KINGFISHER CHAMBERS, INC.

AFFIDAVIT OF GEORGETTE GOFOR

I, Georgette Gofor, having been duly sworn do hereby affirm:

1. I am over the age of eighteen. I have personal knowledge of the information in this affidavit.
2. For five years, I have been employed by the law firm of Myers, Myers and Yours as a legal assistant.
3. On or about April 15, 2006, I went to the branch of Barnes and Nobles Bookstore on Mainer St. and Crossmain St. in [law school's city, state].
4. During my visit to Barnes and Noble, I asked a sales clerk to gather for me one copy of each different alphabet book for children stocked by Barnes and Noble.
5. The clerk gathered together one copy each of eighteen books.
6. One of the books was "Black and White Rabbit's ABC" by Alan Barker, published by Larousse Kingfisher Chambers, Inc.
7. One of the books was "God's Alphabet." God's Alphabet uses names of biblical characters for the letters. A was for Abraham; D was for David.
8. I did not buy a copy of either "Black and White Rabbit's ABC" or "God's Alphabet." I did buy copies of each of the other sixteen books.
9. Later the same day, I went to the local public library and asked the children's librarian to help me locate all the alphabet books. The only new title she located was "Peter Rabbit's ABC 123" by Beatrix Potter. I made a xerox copy of that book for use only as an attachment to this filing.
10. Attached to this Affidavit are true and correct copies of the sixteen titles I bought at Barnes and Noble on April 15, 2006 and the one xerox I made at the library. The chart immediately below gives the titles, purported authors, and exhibit numbers of the seventeen books:

EXHIBIT	**TITLE**	**AUTHOR**
1	A My Name is Alice	Jane Bayer
2	A is for Angry; an animal and adjective alphabet	Sandra Boynton
3	Clifford's ABC	Norman Bridwell

4	Barney's Alphabet Soup	Mary Ann Dudko
5	The Alphabet Book	P.D. Eastman
6	The ABC Bunny	Wanda Ga'g
7	A to Z: Look and See	Audean Johnson
8	From ACORN to ZOO and Everything in Between in Alphabetical Order	Satoshi Kitamura
9	The Frog Alphabet Book	Jerry Pallotta
10	A Is For Animals	David Pelham
11	Peter Rabbit's ABC 123	Beatrix Potter
12	Alphabet Travels	Rand McNally, Inc.
13	Little Ernie's ABC's	Anna Ross
14	Dr. Seuss's ABC	Dr. Seuss
15	So Many Bunnies: A Bedtime ABC and Counting Book	Rick Walton & Paige Miglio
16	Letters and Sounds	Beth Alley Wise
17	Precious Moments Uppercase Alphabet	Dalmatian Press, no author indicated

FURTHER AFFIANT SAYETH NOT
Georgette Goffer
Georgette Goffer

Signed and Sworn to before me this 20th day of *April* 2006.
My commission expires on January 15, 2008.
Natalie Notary
Notary Public

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B. Assignment Goals

This assignment combines standard law school research and writing practice with the type of project suitable for first year associates. Students are exposed to standard format for complaints, answers, and supporting affidavits. Even more important, students are forced to accept the centrality of facts; this project requires them to focus on the specifics of the books in the case file both to locate similarities and differences between the plaintiff's and defendant's works and to argue the legal importance of these similarities and differences.[5]

Originally, I went to the local Barnes and Noble and purchased one of each available alphabet book (except for the overly expensive "God's Alphabet"). I created the plaintiff's work on my computer with one eye on the book I wished to target as the allegedly infringing work. One mark of an excellent student is the submission of additional alphabet books as exhibits (obtained by purchase or library borrowing). Over the years, I have expanded the case file by copying (or buying) such proffered exhibits. To reproduce the problem, you can purchase all (or most) of the books listed in the complaint and Gopher's affidavit. Alternatively, you can purchase different children's books and create a matching Plaintiff's Work based on those.[6]

Children's books are better than adult-oriented ones for a number of reasons. First, hard cover children's books are relatively inexpensive. Second, they use pictorial details which add both complexity and color to the project. Third, they are short, thus allowing the students to fully compare the books without investing an inordinate amount of time. Fourth, creating a possibly infringing draft children's book is much less work for the law professor.

The project can be expanded in several ways. First, students can be assigned sides to allow drafting of a plaintiff's brief, a defendant's brief, and a plaintiff's reply brief. This would give students an opportunity to discuss the tactics behind saving ammunition for a reply brief and an experience with writing against an actual opponent. Second, the students may present oral arguments on and off brief which may both be critiqued by the professor and taped for the students' own review. Third, the students may hold a settlement conference and, if successful, draft a settlement contract and a joint motion for entry of a consent decree. The project can also

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[5] The students' papers should pay major attention to the idea/expression dichotomy, *see* 107 U.S.C. 102(b) (providing statutory basis); Herbert Rosenthal Jewelry Corp. v. Kalpakian, 466 F.2d 739, 741 (9th cir. 1971) ("A copyright, we have seen, bars use of the particular 'expression' of an idea in a copyrighted work but does not bar use of the 'idea' itself. Others are free to utilize the 'idea' so long as they do not plagiarize its 'expression.'"), and the scenes a faire doctrine, *see, e.g.,* Walker v. Time Life Films, Inc., 784 F.2d 44, 50 (2d Cir. 1985) ("Elements such as drunks, prostitutes, vermin and derelict cars would appear in any realistic work about the work of policemen in the South Bronx. These similarities therefore are unprotectible as 'scenes a faire,' that is, scenes that necessarily result from the choice of a setting or situation."), *cert. denied*, 476 U.S. 1159 (1986).

[6] I believe that including copyright-protected pictures in a mock-children's book which is posted on line in a manner reachable only by students constitutes fair use. For this article, I created a well-illustrated allegedly infringed work without copyright exposure by licensing content through a clip-art service, The Graphics Factory at <http://www.graphicsfactory.com/>.

be narrowed by assigning only a subissue, for example, the substantial similarity of the "look and feel" of the works. The students can be warmed-up for this shorter version by an in-class discussion of the similarities between other specific elements of the works.

C. Refocusing the Copyright Assignment into Counseling

A non-litigation assignment can be constructed on the same foundation. In this version, the client first created her draft and only then saw Barker's "The Black and White Rabbit" (or your substitute target book). The client has asked the firm for counsel on what changes, if any, she needs to make before submitting her work to a publisher without fear of being sued for infringement by Barker and Barker's publisher. As a first step, the partner sent Georgette Gopher to the local bookstore and library to locate the current universe of alphabet books. The student's assignment is to draft a memorandum to the partner on the client's exposure and potential methods to avoid such exposure. As before, provide the student with the published books, the supporting affidavit, and the client's draft alphabet book.

This scenario can be expanding by adding a negotiation session between the client and agents of Barker and Barker's publisher. Such a negotiation, however, would be unrealistic. An economically-rational small client advised that her unfinished children's book might provoke litigation would be more likely to change the draft substantially.[7]

III. Example Three: Trade dress/Trademark Advice

A. The Written Assignment Given to the Class

YOURS, MINE and OURS, P.C.
3000 LEGAL LANE
[law school city and state]
xxx-xxx-xxxx

MEMORANDUM
TO: T. Tryhard
FROM: Milton Mine
CLIENT: Leon Legitimate, Inc.
BILLING CODE: 44444-0007
DATE: [two weeks before due date]

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[7] Unintentionally creating an unpublished draft which bears substantial similarity to an earlier work to which the author has been exposed may be copyright Infringement. *See, e.g.,* Bright Tunes Music Corp. v. Harrisongs Music, Ltd., 420 F. Supp. 177, 181 (S.D.N.Y. 1976) (holding that almost identical reproduction of another's tune is "infringement of copyright, and is no less so even though subconsciously accomplished."), *aff'd sub nom.*, 722 F.2d 988 (2d Cir. 1983). The potential plaintiff, however, is unlikely to sue in this situation since (i) the plaintiff does not know of the possible infringement, and (ii) an unpublished draft does not depress the market for the plaintiff's work.

Background: Leon Legitimate, Inc. unveiled CHOCOLATE SANDWICH SHAPES™ at the fall Toy Show in Chicago in early October. Preliminary orders ran well above expectations. To meet these orders, LL must start production no latter than [four months after due date]. Last week, Clutch got a cease and desist letter from Fisher-Prices' counsel. I shot off our usual first response. Clutch wants us to back-down Fisher-Price as far as possible, but he does not want to go to court. Clutch says that Fisher-Price has a reputation for barking about everything, but rarely sues unless pushed all the way.[8]

Finished Product Needed: Please write a very short substantive response to Bigger to go out over my signature. One or two pages at most. I would prefer one strong argument to four weak ones. In addition, I would like a short memorandum (a) giving your opinion of the strength of the argument in the letter, and (b) suggesting one back-up position.[9] I need these no later than [due date].

Materials Available:

a. Letter of [one month before due date] from Bigger to Clutch;

b. Letter of [three weeks before due date] from me to Bigger;

c. New Product Prospectus on Chocolate Sandwich Shapes™ (with two attachments and sample package);

d. sample of Fisher-Price's OREO™ Matchin' Middles toy;[10]

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[8] The statements about Fisher-Price's attitude toward intellectual property are purely products of my imagination.

[9] NOTE TO STUDENTS from Professor _____ : assume that Milton Mine is a trademark/trade dress specialist. You do not need to teach him basic law. In the memo, cite ONLY if you find a case with FACTS close to your client's problem. The referenced attachments to Bigger's letter are trademark records which you can locate through the US PTO trademark search engine at <http://tess2.uspto.gov/bin/gate.exe?f=tess&state=i4k4ii.1.1> Fisher-Price's toy and the exhibits to Benjamin Busy's affidavit are on reserve in the law library as "Professor ....."s Trademark Project."

[10] Oreo® Matchin' Middles™ Game is manufactured by Fisher-Price which currently lists it as product number 78858 with an approximate retail price of $9.00. *See* <http://www.fisher-price.com> (visited May 9, 2008).

e. affidavit by my secretary (Benjamin Busy) with exhibits.

Billing limits: Clutch wants this settled before he has to decide on production. He has OK'd anything within reason. If you need to, you can send out one of the legal assistants to locate other relevant evidence. If you do so, give me an affidavit for possible court use as recorded recollection.

LEON LEGITIMATE, INC.
435 Downtown Ave.
[law school's town, state, zip code]
xxx-xxx-xxxx

NEW PRODUCT PROSPECTUS

NAME: Chocolate Sandwich Shapes!
AGE GROUP: 3-7 years
SUGGESTED RETAIL PRICE: $5.00

PACKAGING: Clear plastic tub with snap-on blue plastic top.[11]

Label in center of top reading "Leon Legitimate, Inc." in small black print; "Chocolate Sandwich Shapes"in larger red stylized script, followed by small black "™."

Main label is a blue oval, "Chocolate Sandwich Shapes"in large red stylized script, followed by small black "™." In smaller black print, "Shape matching game for 2-4 players; no reading required; ages 3-7; 24 sandwich cookie halves; directions for four different games enclosed."

A sample tub made of readily available materials is supplied with prospectus. Final tub will be straight sided, larger, have labels made of heavy, shiny paper.

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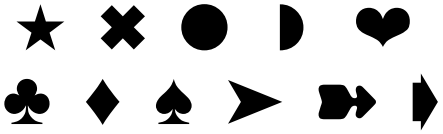
[11] For those professors who want to be thorough, blue-topped plastic storage containers are available in most grocery stores and many home-products stores.

CONTENTS OF PACKAGE: 24 plastic objects, each represents one half of a chocolate cookie with vanilla cream filling. 12 of the halves have a shape inset as a cutout into the plastic vanilla cream filling. The other 12 halves have matching extrusions that can be inserted into the cutouts. The outside of each cookie half is a dark brown oval marked with a repetitive design. (See full-size picture labeled "side view of cookie.") Each package has one pair of cookie-halves for each of 12 different shapes. (See picture labeled "shapes to use inside shape matching toy.") Written directions for playing four different matching games. (Not yet written.)

The label:[12]



SHAPES TO USE INSIDE MATCHING TOY:[13]

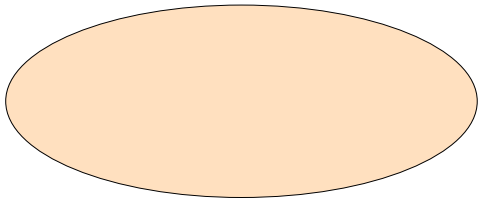


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[12] The label is created on TextArt which is packaged with WordPerfect.

[13] The shapes are from the standard "symbol" inserts available with WordPerfect.

SIDE VIEW OF COOKIE:[14]



BIG, BIGGER & BIGGEST, P.C.
1111 Legal Lane
Chicago, Illinois 60601
312-xxx-xxxx

[one month before due date]
Mr. Claude Clutch
Chief Executive Officer
Leon Legitimate, Inc.
432 Downtown Ave.
[law school's city and state]
xxx-xxx-xxxx

Dear Mr. Clutch,

On behalf of Matel/Fisher-Price, Inc. ("Fisher-Price"), you are hereby warned to cease and desist all publicity, manufacturing, and sales of "Chocolate Sandwich Shapes!" ("Shapes"). Shapes infringes on Fisher-Price's rights in "OREO™ Matchin' Middles." Fisher-Price is the only toy firm licensed to make any product based on Nabisco's world famous OREO® cookie. Nabisco is the registered owner of multiple trademarks for OREO®. Enclosed are short records for 1901838 and 0093009; both are incontestible marks in use since 1912.

Sincerely,

Brigham Bigger, Esq.

encl.

---

[14] The cookie is created with the shape insert tool packaged with WordPerfect which allows choice among multiple repetitive patterns inside the shape.

YOURS, MINE AND OURS, P.C.
3000 LEGAL LANE
[LAW SCHOOL'S CITY AND STATE]

to call writer directly: xxx-xxx-xxxx

[three weeks before due date]
Mr. Brigham Bigger, Esq.
Big, Bigger & Biggest, P.C.
1111 Legal Lane
Chicago, Illinois 60601
312-xxx-xxxx

RE: Chocolate Sandwich Shapes!
file no.: 44444-0007

Dear Mr. Bigger,

Yours, Mine and Ours, P.C. represents Leon Legitimate, Inc. ("Legitimate") with regard to CHOCOLATE SANDWICH SHAPES!™ brand matching toy. Legitimate has forwarded to me your letter of [one month before due date] regarding this product. Kindly address all further correspondence to me.

Please be advised that Legitimate has a long standing policy of respecting other firms' intellectual property rights and, in turn, demanding respect for its own rights.

I have begun a thorough review of the issues raised in your letter and will contact you as soon as possible with a substantive response.

Sincerely,

Milton Mine, Esq.
Counsel for LEON LEGITIMATE, INC.

cc. Mr. Claude Clutch

AFFIDAVIT OF BENJAMIN BUSY

I, Benjamin Busy, having been duly sworn, hereby affirm:

11. I am over the age of eighteen. I have personal knowledge of the information in this affidavit.
12. I am currently employed as a secretary at the law firm of Yours, Mine and Ours, P.C. in [law school's city and state]. I have worked at this firm for over 25 years.
13. On [three weeks before due date], I went to the Publix Supermarket at Merrill Road off Route 9A[15]. At the Publix, I went to the customer service booth and requested help from the person in charge of ordering cookies. The person inside the booth paged "baked-goods manager." A man responded to the page and introduced himself to me as "John, the day shift baked-goods manager." The man who introduced himself as John was wearing a badge saying, "John Sweeny, Baked-Goods Manager."
14. I asked John to provide for me one box of each different available brand of oval or round sandwich cookies having chocolate wafers and vanilla cream. John provided five packages, all of which I purchased. I removed all cookies from each package and placed a few sample cookies from each package into separate, marked plastic storage bags. I made up labels, initialed each label, and applied these initialed labels to the bags and packages.
15. Associated with this affidavit are the empty cookie packages and bags of sample cookies referred to earlier in this affidavit.
16. The packages and sample cookies are labeled as follows:

BRAND[16]	**PACKAGE**	**COOKIES**
Publix	A	A1
Ballsen	B	B1

[15] Substitute the name and address of your local supermarket.

[16] This affidavit reflects the cookies available during a trip to the supermarket in Jacksonville, Florida a number of years ago. Substitute the brands currently available in your area.

Oreo	C	C1
Murray	D	D1
Sunshine-Hydrox	E	E1

The above is true and correct. Further affiant sayeth not.

_____

Benjamin Busy

Signed and sworn to before me this [3 weeks before due date]

_____

Notary Public

B. Assignment Goals

This assignment reproduces a common situation: a client who has been threatened with litigation after the announcement of a new product, but before full production. It demonstrates use of a first response letter, followed by factual investigation, followed by legal analysis. The student practices the difference between writing for supervising and opposing counsel, as well as making tactical suggestions.

The project can be extended with a negotiating session between student/counsel for Leon Legitimate and student/counsel for Fisher-Price. Such a negotiating session should consider modifying all of the package, the labels, and the toy. If negotiation is successful, the students can draft a settlement contract. The negotiation can both be critiqued by the professor and video tapped for student review.

C. Litigation Version

To create a litigation version, provide the same facts about the products, but tell the students to draft a complaint for injunctive relief to be filed by Fisher-Price or one for declaratory judgement of non-infringement to be filed by Leon Legitimate. The project can be expanded by then assigning an answer and papers for and against a preliminary injunction.

IV. Example Four: Counseling How to Avoid Infringing a Patent

Patent projects involving claim interpretation are very difficult for most students to handle. A realistic assignment would provide a full prosecution file and let the students wade through it looking for any relevant tidbits. The full file for this patent involves only seven documents, which is manageable for students taking an entire class on patents. The project, however, can be greatly simplified for the more easily intimidated. In this version, the prosecution history is entirely eliminated. The students need only consult the patent itself. While students should work from the entire patent, the issues involved in this assignment turn on the following excerpts from the Johnson patent at issue:

> I claim:
>
> 1. A creative medium comprising:
>
> an upwardly opening container;
>
> the bottom of said container including a light-transmissive panel;
>
> a layer of fluent material in place over said bottom panel;
>
> said container including a containing wall upstanding from the periphery of said bottom panel;
>
> and means on said device including an artificial light source below said bottom panel for illuminating the lower surface thereof;
>
> whereby the pattern of artificial illumination visible through said bottom panel is a function of the distribution of said fluent material thereover.
>
> . . . .
>
> FIELD OF THE INVENTION
>
> This invention relates to a creative artistic medium for adults, or a creative toy for children. It combines some features of a child's sandbox, a sand sculpture, and an illuminated sketching device.
>
> . . . .
>
> DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS
>
> . . . .

> Three different embodiments of the invention will be described below, each having its own distinctive advantages. What they all have in common is that one or more lamps are employed to shine light toward a thin layer of sand or comparable masking material. The three embodiments described represent specific examples of various means by which the masking material may be conveniently retained in place relative to the light source. In the embodiment of FIGS. 1 and 2, for example, a layer of sand 10 is distributed over a flat horizontal translucent sheet of glass or plastic material 12 which in turn is supported within a suitable channel formed on a rectangular framework 14. . . .
>
> . . . .
>
> The material 10 need not be sand. It could instead be any other material which is "fluent" in the sense that it is yieldable and thus redistributed easily, yet retains its new distribution either until disturbed again, or at least for a substantial period of time before flowing. Such materials either do not flow spontaneously, or at least are so viscous that they flow only over relatively long periods of time compared to ordinary fluids, i.e. gases and liquids. Most granular materials and viscous creams are fluent in this sense. Here again, the imagination of the user is called upon to supply the most suitable material. One can easily imagine that an aerosol shave cream, or a layer of talcum powder, might make suitable media for certain types of creations.
>
> . . . .[17]

A. The Written Assignment Given to the Class

> YOURS, MINE and OURS, P.C.
> 3000 LEGAL LANE
> [law school city, state]
>
> MEMORANDUM
>
> **TO:** T. Tryhard
> **FROM:** Milton Mine
> **CLIENT:** Leon Legitimate, Inc.
> **BILLING CODE:** 44444-0002
> **DATE:** [three weeks before due]

---

[17] U.S. Patent 3,835, 307 issued to Johnson, *available at* <http://www.uspto.gov/> (visited August 19, 2006). My thanks to Louis Altman who prosecuted this patent and brought it to my attention as a possible teaching exhibit.

> Great job you did on the Polly Prudent matter! Here's a new one for Claude Clutch.
>
> Your Topic: Assuming that U.S. Patent 3,835,307 issued to Johnston (the '307 patent) is valid through [date several years after assignment], does the proposed "Marble Maestro" sculpture toy infringe claim one of the '307 patent?
>
> Finished Product Needed: Please write a full memorandum of law including all case cites. We will need to keep this in the file in case of later litigation. No page limit, but be as concise as consistent with clarity and accuracy. Required no later than [due date].
>
> Materials Available:
>
> a. '307 patent (attached);
> b. pre-production prototype of "Marble Maestro."[18]
>
> Billing limits: Do not obtain copies of other patents mentioned in the prosecution history or otherwise. Client does pre-approve any other legal research you think advisable.
>
> Background: Ned Newstuff came up with the idea of the "Marble Maestro" art toy. Basically the toy consists of a light stand topped by a large see-through box. Inside the box are several clear plastic holders that are filled with marbles. The artist can rearrange the marbles to change the sculpture. To get the best view of the sculpture, you turn on the bottom light. Before deciding on production, Clutch wants the firm's opinion on whether Marble Maestro infringes the '307 patent. Use the pre-production prototype as the definitive "Marble Maestro."
>
> John Yours and Mary Ours are working on other aspects of this problem. I have a meeting with Clutch on [two days after due date].
>
> ---

Building the Marble Maestro requires: (i) two plastic storage boxes with removable tops; (ii) clear plastic drinking glasses; (iii) marbles (translucent ones in mixed colors work best); and (iv) one press-to-light light fixture (of the kind you can glue into your car trunk or onto your

[18] NOTE TO STUDENTS from Professor ----------: The Marble Maestro is on reserve in the law library as "Professor _____'s Patent Project."

baby's crib).[19]

Put the light in the bottom of one storage box. Place the other storage box bottom inside the first. (If you press the top one down, the light should go on.) Fill the top storage box with clear plastic drinking cups. Put marbles inside some, but not all, of the cups. This is not particularly attractive, but it arguably infringes the '307 patent which covers a "CREATIVE OPTICAL ARTISTIC MEDIUM" involving "[a] structure providing a creative medium [which] includes a light source directing white, colored, or variegated light through a layer of sand or comparable material supported under a light-transmissive panel. The light source and panel are supported upon a framework which also acts as container for the layer of sand. The artist inscribes lines and/or areas in the material, or otherwise redistributes it in patterns which form creative displays by virtue of the way light is passed through the material from the light source therebelow."[20]

B. Assignment Goals

This project allows even the most unscientific of students to work with patent claims. It involves a project which a non-specialized law firm would be able to handle in-house if it had a patent-savvy associate (even one who had not joined the so-called "patent bar"). The project, therefore, allows the student to appreciate the importance of understanding niche areas of law even for a general practice – and gives the professor an opportunity to discuss the ethical and practical aspects of deciding whether to refer your client to another firm.

The assignment can be extended by attempting to negotiate a release from the current holder of the '307 patent. If successful, the students may draft the release. The negotiation can both be critiqued by the professor and video-taped for student review.

Conclusion

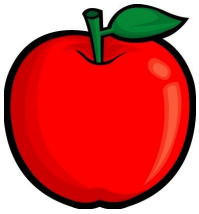
This article purports to add nothing to the theoretical literature. It merely shares some (to my mind) excellent teaching exercises to help other law professors fulfill their obligation to give students realistic skills training.

APPENDIX

[19] Optronics Touch On/Off Dome Light, manufacturer's number IL51LC is available from $9.99 from <http://www.BoatersWorld.com> (visited May 9, 2006); the Green Bay Packers sell a tap-on-light shaped like a football for $16.95, <http://www.packertime.com/products/pths133.html> (visited May 9, 2006).

[20] U.S. Utility Patent 3,835,307 (abstract).

A is for APPLE





Adorable Bunnie Draws An Apple

Phoebe Philbert

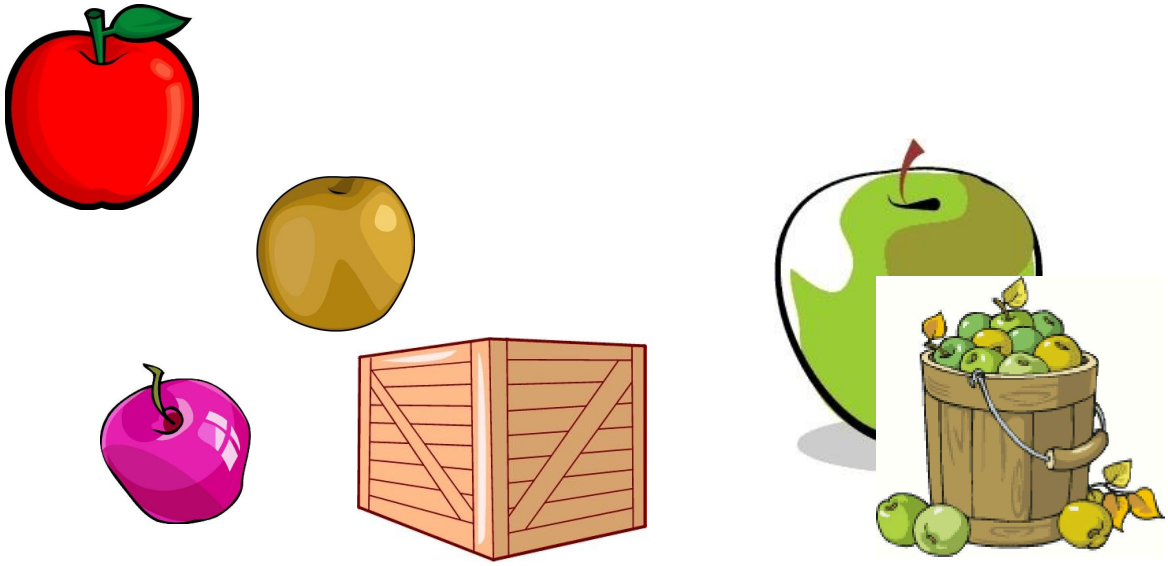
Aa
is for
APPLE



AaAaAaAaAaAaAaAaAaAaAaAaAaAaAaAaAaAaAaAaAa

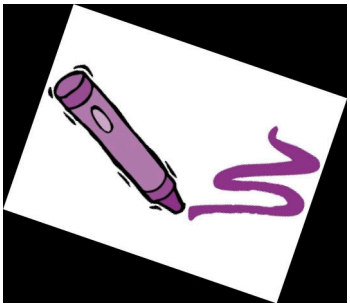
Bb
is for
BUNNIES

Adorable BUNNIES put Apples into BOXES.



BbBbBbBbBbBbBbBbBbBbBbBb







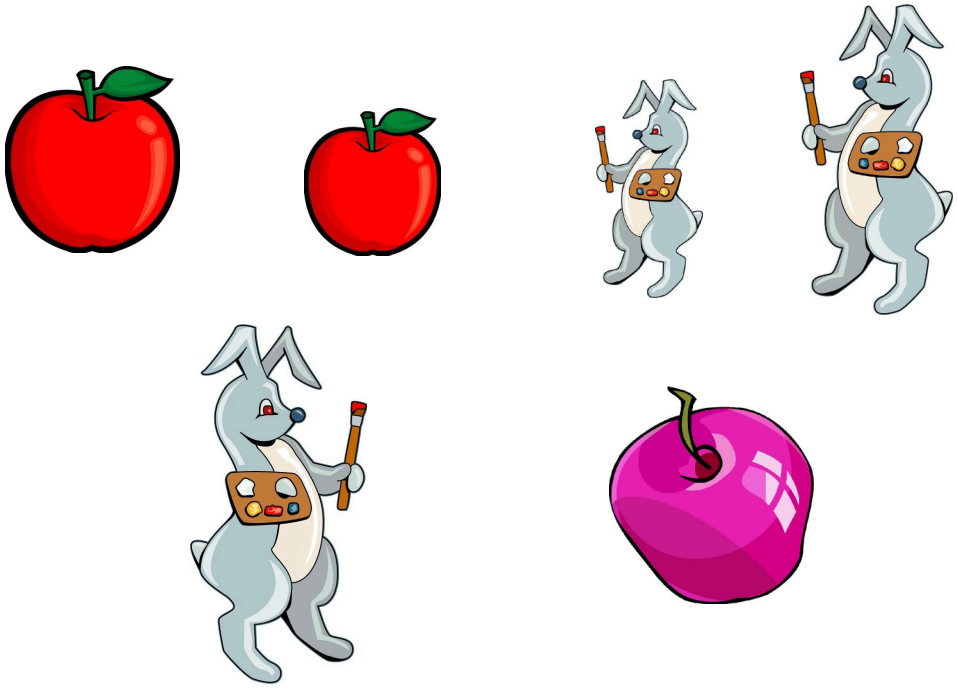
Cc
is for
CRAYON





CcCcCcCcCcCcCcCcCcCcCcCcCcCcCcCcCcCcCcCcCcCcCcCcCcCcCc

Dd
is for
DRAWING

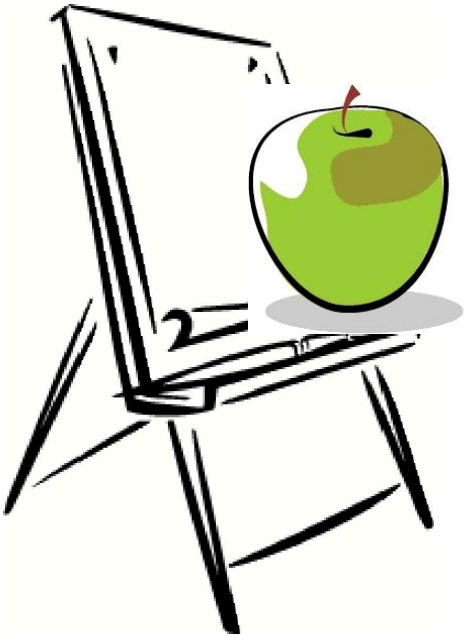


Adorable Bunnies DRAW Apples.

DdDdDdDdDdDdDdDdDdDdDdDdDdDdDdDdDdDdDdDdDd

Ee
is for
EASEL

Adorable Bunnies
Draw Apples on EASELS.





EeEeEeEeEeEeEeEeEeEeEeEeEeEeEeEeEeEeEeEeEeEeEeEeEeEeEe

Ff is for F A L L I N G!!!!!





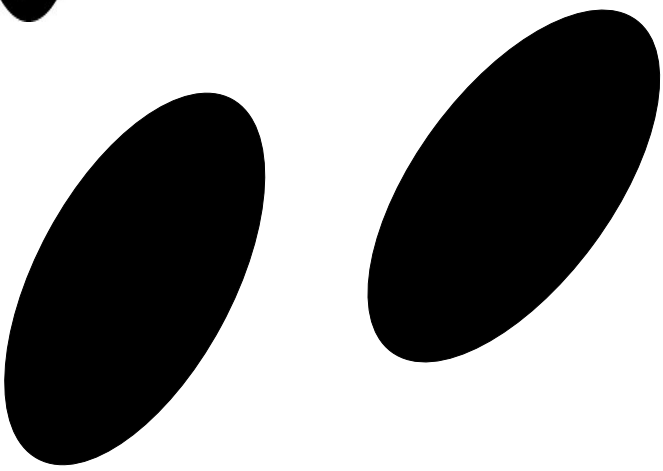


F fF fF fF fF fF fF fF fF fF fF fF fF fF fF fF fF fF fF fF fF fF fF fF fF fF fF f

Gg
is for
GLUE



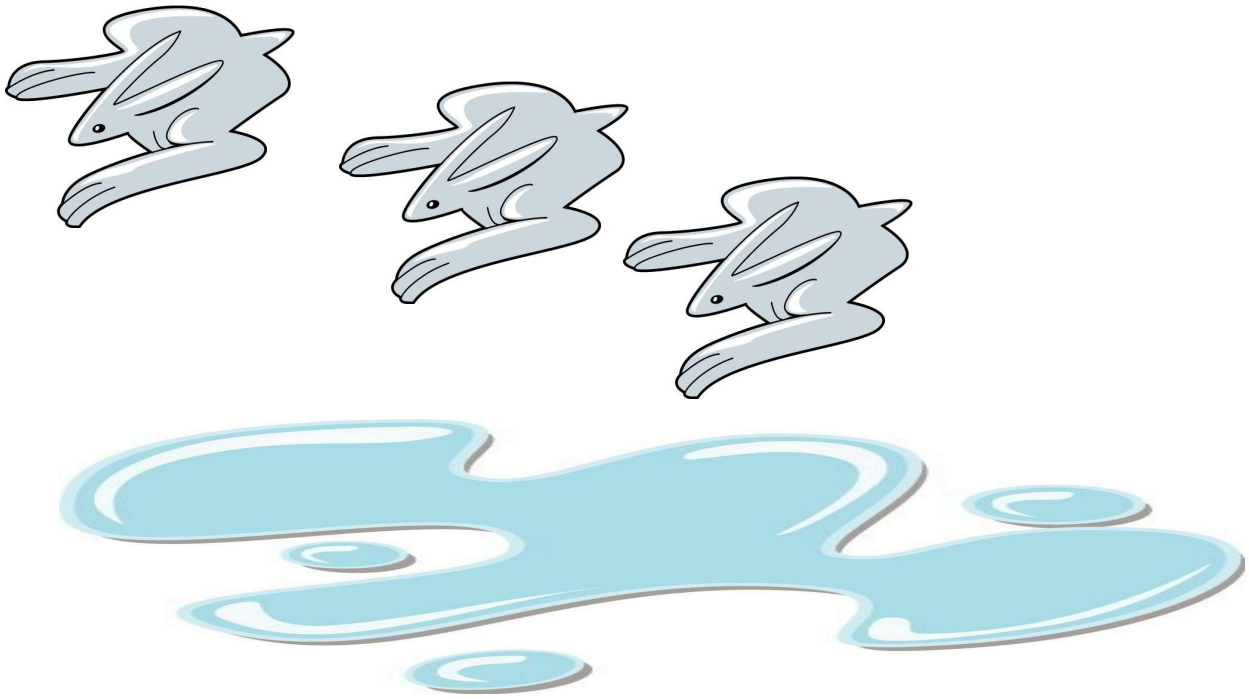




Oh, Oh–what a mess when the Adorable Bunnies used GLUE to stop the Apples from Falling.

GgGgGgGgGgGgGgGgGgGgGgGgGgGgGgGgGgGgGgGg

Hh
is for
HOP



Adorable Bunnies HOP
out of the gluey mess.

HhHhHhHhHhHhHhHhHhHhHhHhHhHhHhHhHhHhHhHhHh

Ii
is for
ICE CREAM





Adorable Bunnies will get no ICE CREAM unless they clean up the gluey mess.

IiIiIiI

Jj
is for
JAM



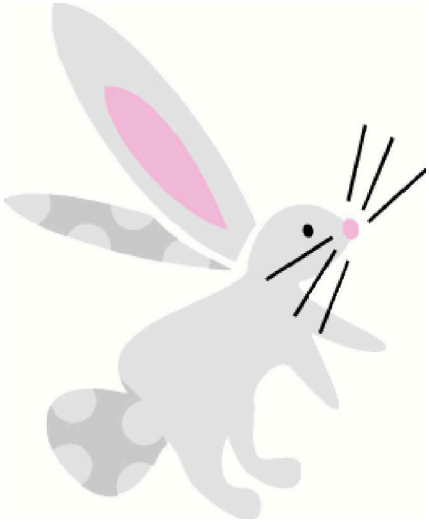




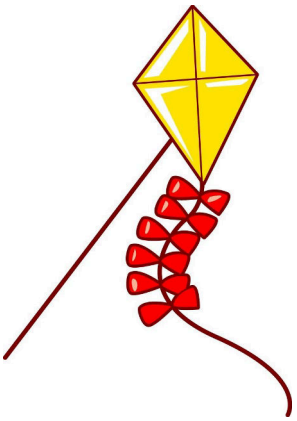
Adorable Bunnies will get no JAM on their toast unless they clean up the gluey mess.

JjJjJjJ

Kk
is for
KITE







Adorable Bunnies may not go out and play with their KITES until they clean up the gluey mess.

KkKkKkKkKkKkKkKkKkKkKkKkKkKkKkKkKkKkKkKkKkKkKkKk



Ll
is for
LOOK











LOOK at the Adorable Bunnies
clean up the gluey mess.

LlLlLlL

Mm
is for
MOP





The Adorable Bunnies used a MOP
to clean up the gluey mess.

MmMmMmMmMmMmMmMmMmMmMmMmMmMmM

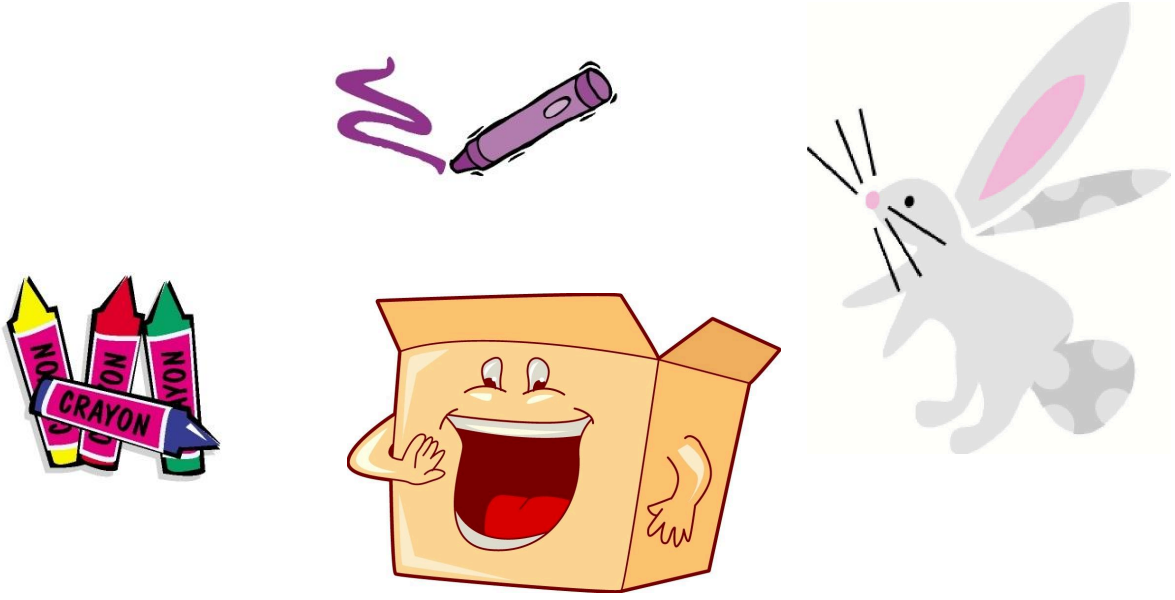
Nn
is for
NAP



Adorable Bunnie needs a NAP
before drawing any more apples.

NnNnNnNnNnNnNnNnNnNnNnNnNnNnNnNnNnNnNnNnNnNn

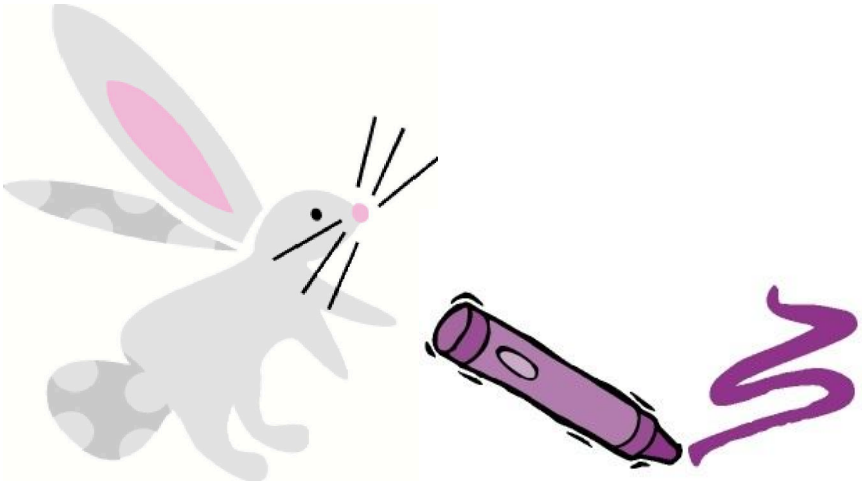
Oo
is for
OPEN



ONE Adorable Bunny OPENS the Crayon Box so that he can Draw Apples on his Easel.

OoOoOoOoOoOoOoOoOoOoOoOoOoOoOoOoOoOoOoOo

Pp
is for
PAW

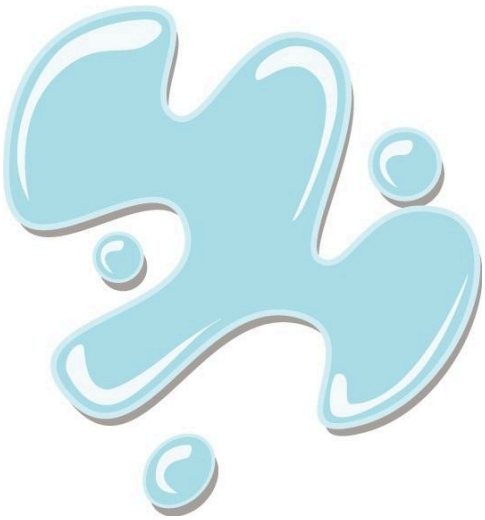


Adorable Bunny holds the Crayon
in his PAW
while Drawing Apples on his Easel.

PpPpPpPpPpPpPpPpPpPpPpPpPpPpPpPpPpPpPpPpPpPp

Qq
is for
QUILT





Adorable Bunny got Glue on the QUILT.

QqQqQqQ

Rr
is for
RUG



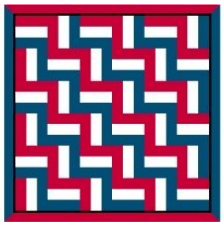
Adorable Bunny got GLUE
on the Rug.

RrRrRrR

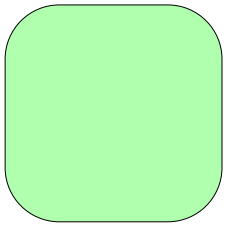
Ss
is for
SHHHHHHHHHHHHHHHHHHHH!!

SsSsSsSsSsSsSsSsSsSsSsSsSsSsSsSsSsSsSsSsSsSsSsSsSsSsSsSsSsSs

Tt
is for
TELL



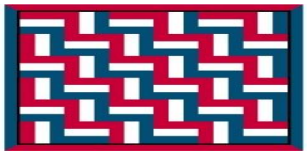


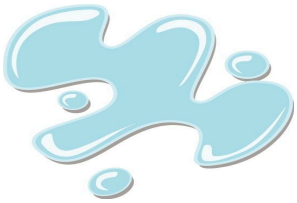


SHHHHH!!
Don’t TELL Mommy Bunny that Adorable Bunny got Glue on the Quilt. Don’t TELL Mommy Bunny that Adorable Bunny got Glue on the Rug.

TtTtTtTtTtTtTtTtTtTtTtTtTtTtTtTtTtTtTtTtTtTtTtTtTtTtTtTtTtTtTtTtTt

Uu
is for
UPSIDE down







Put the Quilt on the bed UPSIDE down and maybe Mommy Bunny won't notice the Glue.

UuUuUuUuUuUuUuUuUuUuUuUuUuUuUuUuUuUuUuUuUu

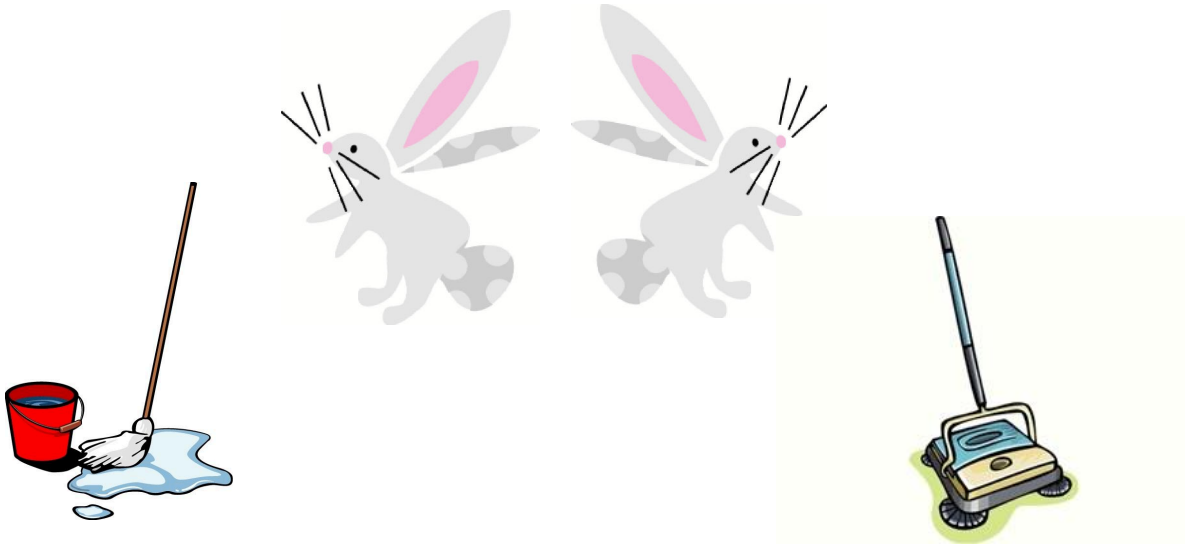
Vv
is for
VERY bad



Adorable Bunny was VERY
bad not to tell Mommy Bunny
about the Glue on the Quilt
and the Glue on the Rug.

VvVvVvVvVvVvVvVvVvVvVvVvVvVvVvVvVvVvVvVvVvVvVv

Ww
is for
WORK



Adorable Bunny will WORK hard
to clean the Glue off the Quilt
and the Rug.

WwWwWwWwWwWwWwWwWwWwWwWwWwWwWwW

Xx
is for
XXXX

XXXXXXXXXXXXX

xxxx xxxx

xxxx xxxx

xxxx xxxx

xxxx xxxx



XXXXXXXXXXXXX

Xx is for the kisses Mommy Bunny will give Adorable Bunny for cleaning up all the Glue.

XxXxXxXxXxXxXxXxXxXxXxXxXxXxXxXxXxXxXxXxXxXxXxXx

Yy
is for
Yawn



YAWN! Adorable Bunny is tired from all that Work.

YyYyYyYyYyYyYyYyYyYyYyYyYyYyYyYyYyYyYyYyYyYyYyYyYy

Zz
is for
ZZZZZZ

Z Z ZZ Z Z Z

Z
Z
Z
Z



Z
Z
Z
Z

What a tired bunnie. ZZZZZZ

ZzZzZzZzZzZzZzZzZzZzZzZzZzZzZzZzZzZzZzZzZzZzZzZzZzZzZzZz