

CAMPUS ID: _____ COURSE: _____ PROFESSOR: _____

**THESE EXAMINATION QUESTIONS MUST BE RETURNED AT THE END OF THE
EXAMINATION.
THE STANDARD EXAMINATION RULES GOVERN THIS EXAMINATION.**

Course: Trademarks & Unfair Competition
Professor: Scher
Essay and Multiple Choice (1 blue book)

Date: July 22, 2006
Hours: 3 hours
Open Book (any printed materials, no electronic materials)

PROFESSOR'S INSTRUCTIONS

1. Your exam consists of five fact patterns (“scenarios”) followed by multiple-choice and “short essay” questions. The weight to be given to each numbered question in grading is approximately equal. To avoid running out of time, try to move on to the next section after about 30 minutes.
2. **Multiple-Choice Questions.** Please answer the multiple-choice questions directly on the printed Exam by circling or otherwise **clearly** marking your choice.
 - A. To earn credit for a question, you must choose one and only one answer for that question. If you vote for two candidates, your ballot will not be counted. (If you indicate your selection in a blue book or in the Exam Software, that will take precedence over any inconsistent markings on the exam itself.)
 - B. If you find that there is no single perfect answer, you should choose the best (“least wrong”) answer. There is no penalty for guessing, but if you can narrow down the choices before guessing, you will improve your chances.
 - C. If you believe that more than one answer might be correct, or that no answers are correct, choose one anyway and use the “Optional Explanation” section to explain the choice you made. A good Optional Explanation may earn you full credit (if I agree with your reasoning) or partial credit (if I decide that your choice was wrong but not completely indefensible), but it will have no effect if you had chosen the correct answer in the first place. Try to use your time to best effect.
3. **Short Essay Questions.** Short essay questions may be answered in a blue book or using the exam software. Please refer to the Q number for clarity. You should be able to fit your answer into two to four paragraphs. If you feel a treatise is required, you may have misinterpreted the question.
4. **Open Book.** During the Exam, you may consult any printed or handwritten material that **you** brought with you. You may not use any interactive electronic sources, such as the Internet, e-mail or chat. You may not poll the audience or phone a friend.
5. **Sequence of Work.** You may work in any order. However, you should not consider **new facts** introduced in a later question when answering an earlier question.



STOP! DO NOT FLIP THIS COVER PAGE UNTIL TOLD TO DO SO BY THE PROCTOR!

Scenario One

Your firm represents a software startup named Confidante Systems. Its first product will be a privacy protection and anti-fraud program that plugs in to a user's web browser. A small animated character named Connie will float unobtrusively in the corner of the window, monitoring the activity of the browser. If fraud is suspected, Connie will alert the user and offer options for addressing the situation. Connie also will keep a secure database of the user's various passwords and account numbers, which the user can instruct Connie to supply to web sites as appropriate.

You have been asked to review the results of a preliminary scan of USPTO records for CONNIE THE CONFIDANTE; the gender neutral form, CONFIDANT, also was searched. There are no trademarks that combine both CONNIE and CONFIDANT(E), but there were several references for each term separately.

To narrow the search results to the most relevant references, the researcher used the following criteria: (1) the mark is registered or pending ("live") and not expired, canceled, or abandoned; (2) the application lists at least some goods in International Class 9 (electronics), or contains goods with any of the following terms: comput... or software or security or secure or browser or network... or web or internet.

Results for CONNIE

After narrowing the search results, there was only one relevant reference. The Spanish company Neptuno Films Production, S.L. owns an application for CONNIE THE COW which includes a design of three cows. The lengthy list of goods and services includes "computers," "computer game software," "computer software and computer interface software for children's education and children's entertainment," and "education services in the fields of computers . . . at the nursery, pre-school, primary, secondary and adult levels."



- Q1. What is your level of concern over the application for CONNIE THE COW in relation to the client's ability to use its mark free of infringement liability?
- A. None. "Cow" and "Confidante" look and sound so different and have such different meanings that CONNIE THE can be ignored. There is no overlap between the client's security software and the applicant's software. And our client's "Connie" is depicted as a human.
 - B. Low. "Cow" and "Confidante" look and sound different and have different meanings, so the marks differ as a whole. While the two companies' goods could be used together, the client's software is quite different in purpose and function from game/education/entertainment software, and computers are a bit more different than that.
 - C. Moderate. The marks have a similar structure: "Connie the C-word." Although the two C-words have considerable differences, the shared pattern suggests that they could be related in some manner because consumers have a better memory for the first part of a mark. When marks are this similar, quite different goods can pose a conflict.
 - D. High. The parallel structure of the marks and identical alliteration, and the fact that both would be marketed to unsophisticated home computer users, override any differences in sight, sound and meaning. Nowadays, computer security is inseparable from computers, so the goods are very close as well.
 - E. Undecided. It isn't possible to advise on this reference without conducting an actual investigation of the "strength," "customer care," "market channels" and "likelihood of expansion" factors.

Optional Explanation for Q1 (if commenting in a blue book/ExamSoft, refer to Q1):

Results for CONFIDANT / CONFIDANTE

The references from this search have been charted as follows:

Owner	Mark(s)	Goods/Services
Friend, Jeff	CONFIDANT ® <i>First Use July 2000</i>	“consulting services, namely, providing computerized research information and advice to banks and other institutions concerning data security issues”
Friend, Jeffrey	CONFIDANT <i>ITU Filed Dec. 2005</i>	“computer software for accessing a global telecommunications network or interactive computer communications network, instant messaging, voice over internet protocol (VOIP), transmitting, securing, and searching electronic data”
Computerized Security Systems, Inc.	CONFIDANT MT ® <i>First Use May 2005</i>	“electronic locks”
Computerized Security Systems, Inc.	CONFIDANT <i>ITU Filed May 2006</i> CONFIDANT LTD <i>ITU Filed May 2006</i> CONFIDANT LIMITED <i>ITU Filed May 2006</i>	“electronic entry control system”
Computerized Security Systems, Inc.	CONFIDANT LITE <i>ITU Filed May 2006</i>	“electronic access control systems”

The search also turned up another application Jeffrey Friend filed this year for financial services for banks. Therefore, it appears likely that “Jeff” and “Jeffrey” are the same person, even though the addresses differ.

A brief Google search indicates that CONFIDANT MT is used in connection with electronic door locks for hotel guest rooms.

- Q2.** In assessing whether the client could register its mark, assume its application would describe its goods as “computer software for protecting users’ private data and avoiding online fraud.” Assume also that the Friend registration (the older of the two marks) will be uncovered in the Trademark Office’s search; that the Examiner applies the likelihood of confusion test in TMEP §1207.01; and that the Examiner views CONFIDANTE as the dominant portion of the mark. Which of the following appears to be the most likely outcome in the first office action?
- A.** No citation, because software is a Class 9 good and computer consulting is a Class 42 service, and a different class rules out confusion.
 - B.** Refusal, because the goods do not need to be related when the marks are identical.
 - C.** No citation, because Friend’s customers are expressly limited to banks and other institutions, while the client’s application refers to users.
 - D.** Refusal, because Friend’s services refers to “data security,” which is related to “protecting private data,” even though one is a service and the other is software.
 - E.** It could go either way, depending on whether the Examiner reads the word “advice” in Friend’s registration to refer to the specific warnings and suggestions offered by “Connie” when she detects a problem.

Optional Explanation for Q2 (if commenting in a blue book/ExamSoft, refer to Q2):

Q3. Assume the client would file its mark for “computer software for protecting users’ private data and avoiding online fraud,” and that the Friend application covering software for “securing . . . electronic data” would be cited. In response you would of course argue that the appearance, sound, and meaning of CONNIE THE CONFIDANTE is quite different than that of CONFIDANT alone. Which of the following additional arguments, if any, would be likely to sway the Examiner and help overcome a citation of the recent Friend application?

- I. Purchasers take extra care in choosing computer software products, because the people who purchase and use computers tend to be sophisticated about technology products.
 - II. The client’s product plugs in to a user’s web browser, and appears in that context, whereas Friend’s software is a complete communications product that functions independently of the user’s browser (according to Friend’s web site).
 - III. Several other persons and entities have obtained Federal registrations for CONFIDANT or marks containing the word CONFIDANT and, accordingly, the cited application is entitled to a limited scope of protection.
- A. Both I and II.
 - B. Both II and III.
 - C. Both I and III.
 - D. I, II, and III.
 - E. None of the three arguments is likely to be persuasive in this case.

Optional Explanation for Q3 (if commenting in a blue book/ExamSoft, refer to Q3):

Q4. In the context of formulating advice to the client on its ability to use its mark free of infringement liability, what significance do you accord to the registration and pending applications owned by Computerized Security Systems, Inc.?

- I. The registered mark CONFIDANT MT establishes that CONFIDANT is weak in the field of security and therefore others (like the client) are entitled to use the same term. The pending intent-to-use applications only reinforce this perception.**
 - II. Although the goods in these applications are related to security, they most likely involve locks used to secure physical premises and therefore have little bearing on the client's ability to use its proposed mark (assuming the marks aren't famous).**
 - III. The proliferation of new variations on the mark suggest that the company is making a significant investment in this brand, and therefore the client would be wise to investigate the company's plans, separate and apart from the wording in the applications.**
- A. Both I and II.**
 - B. Both II and III.**
 - C. Both I and III.**
 - D. I, II, and III.**
 - E. Because the client's mark contains additional wording, these references are simply irrelevant.**

Optional Explanation for Q4 (if commenting in a blue book/ExamSoft, refer to Q4):

Scenario Two

Roger, a friend of a friend who operates an online T-shirt business has contacted you and forwarded an office action he received for his mark “High Tees” (filed for clothing and related ecommerce services). The Examiner refused registration on the grounds that the mark merely describes the goods and services. The refusal is based on two pages from Roger’s online store where the shirts depict marijuana and marijuana paraphernalia. The Examiner cites an online dictionary for the proposition that one meaning of the word “high” is a state of euphoria induced by the use of marijuana and other drugs. Accordingly, the mark merely describes the merchandise for sale under the mark.

While Roger has limited resources and would have to pay you in “half-off” coupons for use at his store, the case is intriguing to you because you suspect the refusal might have been motivated by the Examiner’s disapproval of the shirt designs. Still, you need a viable legal theory, or the application ultimately will be denied registration.

Q5. Suppose you decide to argue that the Examiner’s theory fails to prove the mark merely descriptive within the meaning of the TMEP (“a descriptive term . . . immediately tells something about the goods or services”). Instead, you would argue that considered as a whole the mark is at worst suggestive, and is entitled to registration with a disclaimer of the word Tees (that part really is descriptive). How might you spin the Examiner’s theory of the meaning of the mark into an application of the imagination test (marks that “require imagination, thought or perception to reach a conclusion as to the nature of [the] goods or services”)?

Please answer in a blue book or in the exam software, referring to Q5.

Q6. Suppose you decide to argue that the mark is “incongruous” because “high” implies “high fashion” while “tees” are decidedly “low fashion.” Thus, consumers encountering the mark High Tees would not perceive it as a potentially descriptive phrase (at least not immediately). Choose two of the following examples/cases to support your argument, and explain why they would be the best choices and how well they match the facts of this case:

APPLE PIE
CLEAN SHOWER
LA YOGURT
MOUSE SEED
POLY PITCHER
RS RAPIDSCREEN
SUGAR & SPICE
VEGGIE VISE

Please answer in a blue book or in the exam software, referring to Q6.

Q7. Suppose you decided to argue that the mark contains a “double entendre” because consumers will immediately be reminded of the afternoon custom of “high tea,” which is a tradition sustained at fine hotels around the U.S. Thus, consumers encountering the mark High Tees would not perceive it as a potentially descriptive phrase (at least not immediately). Choose two of the following examples/cases to support your argument, and explain why they would be the best choices and how well they match the facts of this case:

APPLE PIE
CLEAN SHOWER
LA YOGURT
MOUSE SEED
POLY PITCHER
RS RAPIDSCREEN
SUGAR & SPICE
VEGGIE VISE

Please answer in a blue book or in the exam software, referring to Q7.

Scenario Three

You have been contacted by the Executive Director of the Clean Air Coalition. Its application to register the service mark FAIR TRADE for “a smoking cessation program offering antioxidant-rich dark chocolate in exchange for packs of cigarettes” has been refused registration on the alternative grounds that it either is merely descriptive or is deceptively misdescriptive under section 2(e)(1).

The Examiner states that “fair trade” has a particular meaning in relation to chocolate and other commodities. In particular, “fair trade” indicates that (i) the product was purchased at a fair price which guarantees a living wage to the producer; (ii) no forced or child labor was used in growing or manufacturing the product; and (iii) working conditions are safe and healthy. The refusal is based on this meaning: either the mark merely describes a significant feature, function, or characteristic of the services — that “fair trade” chocolate is exchanged for cigarettes — or it is deceptively misdescriptive because non-“fair trade” chocolate is provided instead. In support of the refusal, the Examiner provided copies of web pages referring to “fair trade” chocolate.

The Examiner requires that the Coalition’s response state whether its exchanges involve “fair trade” chocolate. In fact, the Coalition has never purchased “fair trade” chocolate for its program, and has no plans to do so in the future. During the five years it has been running the program, the Coalition has simply purchased good quality dark chocolate at Trader Joe’s. It does not apply any of its own branding to the bars themselves. Instead, when participants hand over their cigarettes to Coalition volunteers, they receive a flier along with their chocolate providing health information and smoking cessation tips. The FAIR TRADE mark is used on large signs or banners over the Coalition’s table, whether at a festival, fair, farmer’s market, or other venue, and in promotional materials promoting upcoming exchanges.

Q8. Assume that any office action response will accurately state the Coalition’s past history and future intentions with respect to its chocolate. What combination of the following arguments, if any, would be useful in overcoming the refusal of registration?

- I.** Because the Coalition uses its mark to identify its smoking cessation program and not chocolate bars, imagination, thought, or perception is required to associate the phrase “fair trade” with chocolate bars.
- II.** Because the Coalition uses its mark to identify its smoking cessation program and not chocolate bars, consumers will not believe that the bars are “fair trade” chocolate.
- III.** Because the Coalition’s applied-for services involve an exchange of one item for another, the mark would be perceived as having a double meaning (“double entendre”), and therefore is suggestive, not descriptive.

- A.** I only.
- B.** II only.
- C.** III only.
- D.** I, II, and III.
- E.** None of the three arguments would be useful in this case.

Optional Explanation for Q8 (if commenting in a blue book/ExamSoft, refer to Q8):

- Q9.** If the Coalition is not successful in overcoming the refusal of registration based on argument alone, and receives a “final” office action under section 2(e)(1), which of the following options would be worth pursuing?
- I.** Submitting a request for reconsideration along with a declaration evidencing the Coalition’s continuous and substantially exclusive use of the mark for at least five years in connection with the applied-for services.
 - II.** Submitting a request for reconsideration along with a declaration by the Coalition’s Executive Director showing that competitors neither use nor need to use FAIR TRADE in relation to the applied-for services.
 - III.** Filing an *ex parte* appeal with the Trademark Trial and Appeal Board on the grounds that NAFTA altered the requirements for refusals based on deceptive misdescriptiveness.
- A.** I only.
 - B.** II only.
 - C.** III only.
 - D.** I, II, and III (not necessarily in that order).
 - E.** None of the above, because like the designation “organic,” the phrase “fair trade” would materially influence a consumer’s purchasing decision.

Optional Explanation for Q9 (if commenting in a blue book/ExamSoft, refer to Q9):