This is an open book examination. You may refer to your casebook, your statutory supplement, your class notes, and any outlines to which you have made a significant contribution.

2. The examination consists of three sections. Every section must be completed.
   Section I: Answer THE SINGLE QUESTION
   Section II: Answer BOTH QUESTIONS

3. 300 points are available in this examination. Those points are allocated among the sections as follows:
   Section I: 200 points
   Section II: 100 points

4. If you are handwriting the exam, write your answers in one or more bluebooks legibly in ink. Use only one side of each page in your bluebook (except for additional remarks made on the blank facing page, so long as you indicate where, on the opposite page, they fit).

   In your answers, support your analysis/argument, where possible, by referring to the relevant authorities in so far as they apply by analogy to the situation discussed. You will not be penalized for not remembering case names; if you cannot remember case names, refer to them by briefly describing their leading facts. If you need to know additional facts, tell me what they are, and why and how they would facilitate your analysis/argument.

5. Do not put your name on your exam; make sure you simply use your identification number.

6. Read carefully the instructions provided at the beginning of each section. Suggested times are listed at the beginning of each section.
Section I
200 points
Recommended Time: 120 minutes

You represent Babolat, a sport equipment manufacturer who manufactures a variety of sporting equipment, such as tennis rackets, squash rackets, racquetball rackets, and hockey sticks. Babolat’s top selling tennis racket is the SCIMITAR. Babolat has never registered this name at the Patent and Trademark office, but it has used the mark since 1990. The tennis rackets that Babolat has continually sold under SCIMITAR mark have a unique design. The side of the racket head is constructed of a lattice-like structure of triangle openings in the side of the racket. This design is based on technology upon which Babolat obtained a utility patent, although the patent only covered lacrosse sticks. The design from the patent is showed below:

![Triangle Design Diagram]

The triangles reduce the weight of the racket, which enhances the speed of the tennis player’s stroke and thus enhances the power of the stroke. In other words, it allows a tennis player to hit the ball harder. The patent on the lacrosse stick expired in 1995. That patent did not relate in any way to or even mention tennis rackets, and it is undisputed that the claims in the patent were directed only to lacrosse sticks. The patents claims did expressly cover the triangular openings.

The general tennis-playing public has come to recognize that the triangle design is associated with the SCIMITAR tennis racket, and customers routinely enter various sporting goods stores, asking for the “racket with the triangles” or the “lattice” tennis racket. You have evidence of these anecdotal stories that are admissible in court. The SCIMITAR is lower-end tennis racket, however, and sells for about $70. They are available in your average sporting goods store and department stores, such as Wal-Mart. Babolat advertises in periodicals such as Newsweek and Time, trying to reach the average consumer who might be interested in playing tennis. The SCIMITAR rackets are available across the United States.

As part of its marketing system, in 1990 Babolat started using the logo, “Its not rocket science, its racket science!” as a play on the popular maxim “its not rocket

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1 At its most basic, lacrosse involves using throwing a ball using a stick that has a head with netting attached to it to catch the ball. You do not need to know what lacrosse is to answer this question. Just realize that lacrosse is in no way related to tennis as a sport. Realize that the stick in lacrosse is used to catch and then throw a ball; the ball is not hit by the stick in the way that a tennis racket is used to hit a tennis ball.
science,” a phrase used to suggest that some concept is fairly easy. In 1993, Babolat modified its logo to state “Not rocket science. Racket science!” and ceased using the earlier mark. Eventually, in 1998, Babolat changed the logo to “Racket Science!” The logo was placed on all marketing materials and on the racket’s packaging. Babolat registered all of these marks, including the “Racket Science!” mark at the PTO in 1998. Babolat filed the appropriate affidavit to render the mark incontestable in 2003.

Prince is a competing tennis racket producing company. Since 2000, Prince has sold its racket, the SABER, a high-end racket used by professionals that retails for $199. It sells its rackets only in tennis specialty stores, catalogs, or at tennis clubs. It advertises on television and radio throughout the United States and in sports oriented magazines, such as Tennis magazine and Sports Illustrated. The saber uses a lattice structure that is formed out of trapezoids, as shown below.

![Trapezoid Design](image)

This design is one of many possible designs, including a solid frame, a frame with circles in it, and of course the triangle design of Babolat.

The SABER is also manufactured of a unique material that was developed by scientists designing materials for rockets. Prince was aware of the Babolat logo, but nevertheless adopted the logo “It IS Rocket Science!” in 1997, emphasizing the “IS” in the logo. Prince justified its decision to use the logo in part on the fact that the racket is indeed based on materials from rocket science. In 2001, Prince took its business on line and registered in the United States two domain names: rocketscience.com and racketscience.com. When typed in, both domain names direct the user to Prince’s webpage, where it can purchase the SABER. The first web page that the user see contains a disclaimer at the top right of the page in 24 point bold font that “This is NOT Babolat’s Web Page” but it did not mention the SCIMITAR itself by name.

Prince does receive emails inquiring about “that racket named after a fancy sword, with the pretty lattice design on it.” The customer service system generally responds with information to the customer. Several emails back to the customer service express some surprise at the high price of the SABER, noting “I thought this was a cheaper racket.” Some of those responses nevertheless purchase the SABER, whereas others do not.
Webster’s dictionary provides the following definitions:

SABER: *a cavalry sword with a curved blade, thick back, and guard.*

SCIMITAR: *a saber having a curved blade with the edge on the convex side and used chiefly by Arabs and Turks.*

**Question 1.** You represent Babolat. Babolat would like to file a trademark infringement suit against Prince in the Northern District of Illinois seeking injunctive relief against Prince’s use of SABER and its “IT IS ROCKET SCIENCE!” logo. Discuss the potential causes of action that you could assert against Prince, including which marks could you assert, and any potential defenses that Prince might have. Babolat also wants to shut down both of Prince’s web pages and to obtain registration of the cites. Discuss the potential options available to Babolat in obtaining those web pages. Do not concern yourself with any counterclaims of infringement that Prince could bring, nor with any damages/injunctions.

Upon further investigation, Babolat makes an interesting discovery about Prince’s advertising campaign. A Prince brochure found at its store at the U.S. Open shows Lleyton Hewitt, who is the number 3 ranked tennis player in the world and who Prince officially endorses, playing with the racket manufacturer's SABER 2003 model. But in reality, Hewitt uses an older, discontinued racket (the SABER 2001) that was painted to look like the newer model. Customers therefore cannot currently purchase the actual racket used by Lleyton Hewitt. Apparently, other well-regarded tennis players who endorse Prince use a similar approach of using a paint job to disguise their outdated rackets to look like the newer models they are paid to endorse. While top players on the ATP and WTA Tours might be willing to cash a manufacturer's endorsement check, often they aren't willing to part with their most prized piece of equipment on the court. Current Prince advertisements touts Hewitt and Prince’s SABER 2003 as such: "20-year-old U.S. Open champ [Lleyton Hewitt] grabs the 'New' SABER 2003 racket to supercharge his game," it claims. "For playability and pinpoint control -- Lleyton's choice." An advertisement for the SABER 2003, which includes images of Hewitt, claims: "More power. More stability. More trophies."

**Question 2.** Babolat is interested in challenging these commercials and practices. Would there be a cause or causes of action available under the Lanham Act? Could Babolat bring such a suit, or would someone else need to? What problems might there be in bringing such a cause of action?
Section II
100 points
Recommended time: 60 Minutes

Answer both of the questions below. The first is worth 40 points, and the second is worth 60 points.

**Question One.** (40 points)

It is clear that trademark rights can be created by parties other than the actual trademark owner. In the *Coca-Cola v. Busch* case (p. 274), the use was by the public, which had adopted “Coke” as a nickname for Coca-Cola. The “Office Space” example on p. 280 posed the issue of whether the use of a red Swingline stapler in a movie gave trademark rights in red staplers that would inure to Swingline’s benefit, even though Swingline had nothing to do with the movie. The University of Wisconsin similarly obtained trademark rights over the mascot Bucky Badger even though the University had never created the character. From the perspective of our triumvirate of policy considerations, is allowing such surrogate uses to create trademark rights appropriate? What problems might such surrogate uses create, particularly trademark owners? Is this “surrogate use” truly a “use” under the Lanham Act that would afford the creation of rights?

**Question Two.** (60 points)

In 1842, Congress extended patent protection to "new and original designs for articles of manufacture" in order to fill a gap between copyright protection for authors and patent protection for inventors in the mechanical arts. These patents on product design are aptly-named “design patents.” Obviously, design patents were available before trademark law expanded to encompass the design of products.

A design patent is available for the design of a product that is novel and non-obvious (i.e. more trivially different) from prior product designs. To get protection under a design patent, the applicant does not have to show that the purchasing public associates that design with a particular producer, i.e. there is no secondary meaning requirement. Like any patent, the term is limited and currently is 14 years from the date the design patent is granted.

Design patent protection is only available for ornamental, non-functional aspects of the design. A design that is dictated by considerations of function is not a proper subject for a design patent. Also, a design is not patentable if the sole points of novelty or nonobviousness over prior designs are dictated by functional improvement or alteration.

In order to infringe a design patent, the accused design does not have to be identical. What is controlling is the appearance of the design as a whole in comparison to the accused product. Instead, the test for infringement of a design patent has two parts:
(a) the "ordinary observer" test, and (b) the "point of novelty" test.

The "ordinary observer" test states that two designs are substantially the same if the resemblance between the two designs is such as to deceive the ordinary observer, so that the ordinary observer would purchase the one good believing it to be the other. In other words, would an ordinary observer be confused so as to believe it was actually purchasing the patented good instead of the infringing good? Focus is not drawn to the identity of the source of the good; instead focus is on confusion between the two products.

The "point of novelty" test is distinct from the "ordinary observer" test and requires proof that the accused design appropriates the novelty which distinguishes the patented design from the prior art. In other words, to infringe, the accused design must use the features of the design that make it unique from previous designs.

The Supreme Court in Traffix concluded that the existence of an expired utility patent is "strong evidence" of functionality of an asserted product design. It has not spoken on the impact an expired design patent would have on the ability of a party to assert trade dress protection for a product's design. Given the role of design patents described above, explain how they are similar or different from trade dress protection. Relying on policy analysis, should design patent protection preclude an assertion of trade dress protection?

END OF EXAM.