



MEETING RECAPITULATION

THE PAULINE NEWMAN IP AMERICAN INN OF COURT

THURSDAY,
JANUARY 14, 2016

The new logo of the Pauline Newman American Intellectual Property Inn of Court is displayed on the left side of this page..

The first Inn meeting of the 2016 calendar year held in the offices of the Oblon firm near the headquarters of the U.S. Patent & Trademark Office in Alexandria, Virginia. A reception with food and drink began at 6:00 p.m. in a round room in the round tower on the side of their office building.



The program was an Intellectual Property parody of the Jeopardy television game show. (I presume that as a parody it did not infringe the copyrights or trademarks of the game show's owners.) It began at 7:00 p.m. in a conference room with a very elongated table.



The members attending were divided into four teams, based on where they happened to be sitting at the conference table. Most of the rules from the Jeopardy game show applied. An exception was that if one team missed a question, another team would be asked to answer the question.

The question categories from which the team whose turn it was could select were IP history, statutes and standards, pop culture, practice rules, ethical conduct, and trademarks. The following is a summary of the questions and answers:

Identify who said, "A country without a patent office was like a crab, and could not travel anyways but sideways." Correctly answered, "Mark Twain".

Identify by whom the first U.S. Patent was granted. Correctly answered, “Thomas Jefferson”. Bonus for 100 points, “What was the patent for?” A method for making potash.

What judge presided over the Apple v. Samsung patent trial? Richard Posner.

Who filed a caveat with the Patent Office on the same day that Alexander Graham Bell filed his patent application for the telephone? Elisha Gray.

Who said, “The patent system is adding the fuel of interest to the fire of genius.” Abraham Lincoln.

What is the name of the Trademark Office’s mascot? T Markey.

Under Federal Rule of Evidence 408, settlement negotiations are admissible in court for what purposes? To prove liability. Also, to establish witness bias or prejudice, to negate a contention of undue delay, to prove an effort to obstruct a criminal investigation or prosecution, or to show a separate cause of action arising out of the settlement negotiations themselves.



A soccer star has obtained a trademark for this on-field action: Holding his hand in the shape of a heart after scoring a goal.

This actor played the role of the intermittent windshield wiper inventor Robert Kearns in *Flash of Genius*: Greg Kinnear.

The court imposed sanctions against Medtronic and its attorneys for doing this: Incorrect answers: spoliation, asking the jury to interpret the claims. Correct answer. Attempting to hire hitmen to murder the judge.



The Supreme Court in a recent IP decision quoted this comic book series when it said, “In this world, with great power comes great responsibilities.” The Amazing Spiderman. Name the case. *Kimble v. Marvel*.

37 CFR 11.101 states that competent representation requires knowledge in these two areas: law and technology.

Trademark that describes three consecutive championships: threepeat.

George Harrison was found to have infringed this song in *My Sweet Lord*: *He’s So Fine*.

This trademark for “explosive engines and their parts” was registered in 1909: Incorrect: Diesel. Correct: Ford.

Something is material to patentability under 37 CFR 1.56 if it satisfies one of these criteria: It establishes a *prima facie* case of unpatentability of a claim, or if it refutes, or is inconsistent, with a position taken by the applicant.

In *Alice*, the Supreme Court overturned the notion that this is the sole test for determining whether a computer-implemented invention for transforming data is patent eligible: wrong: insolubly ambiguous. Right: Machine or transformation (from *Bilski*).

This standard governs the review of factual matter relating to claim construction on appeal from district courts: *de novo*.

This TV star lost the right to his name to a cartoon cat: Nooky.

The sole purpose of this type of trademark is to indicate that the user is a member of a particular organization: Incorrect: Service mark. Correct: Membership mark.

An attorney’s false or misleading statements during trademark prosecution can lead to this happening to the trademark registration during subsequent litigation: Wrong: Rendering the mark unenforceable. Right: Cancelling the registration.

Under this section the federal district courts have original jurisdiction over all federal cases relating to patents: Wrong: §1337. Right: §1338.



Under this section, actively inducing the combination of components without the United States that would infringe within the United States makes one liable for inducing infringement: §271(f)(1).

In 2014 a judge in the Northern District of California imposed millions of dollars in sanctions for violating a protective order by doing this: Incorrect: Spoliation of evidence; holding a press conference and disclosing confidential information. Correct: Allowing a client to give confidential information. Bonus: What kind of information? Correct answer: A damages expert report.

In 2014, the Federal Circuit admonished an attorney for failing to do this, which caused a \$40,000,000 patent verdict to be set aside: Read the entire order.



For the final question, each team was asked to write down their answer. In a show cause order in 2014, the Supreme Court threatened to sanction an attorney for doing this in a petition for a writ of certiorari: Correct answer: Disregarding his client's wishes and rewriting the brief.

The program ended at 7:48 p.m.

Respectfully submitted,

Stephen Christopher Swift
Secretary