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### Intellectual Property Research: From the Dustiest Law Book to the Most Far off Database

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# INTELLECTUAL PROPERTY RESEARCH TOOLS AND STRATEGIES

## SERIES INTRODUCTION

### INTELLECTUAL PROPERTY RESEARCH: FROM THE DUSTIEST LAW BOOK TO THE MOST FAR OFF DATABASE

JON R. CAVICCHI\*

#### I. INTRODUCTION

This issue of IDEA introduces a regular series of articles on intellectual property research tools and strategies based on my experience for over a decade as Intellectual Property Librarian and Research Professor at Franklin Pierce Law Center. Pierce Law is consistently ranked among the top law schools training IP professionals. I have taught IP legal research, patent, trademark and copyright searching to hundreds of students and IP professionals in Pierce Law Graduate Programs. I have tackled hundreds of reference and research questions as well as working on countless projects requiring IP information. So I have been faced with challenges and changes common to consumers of IP information. What are the types of data IP researchers seek? What are the options for access to such data? How do we evaluate the access points? What is the value added to our information access choices?

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The mission of this series is to present tools and strategies and answers some of these consumer questions within evaluative frameworks appropriate to the tools under consideration. Each information acquisition choice is made on a moment-by-moment basis subject to the press of business. Choices are made by the totality of the circumstances. Pressures and factors such as time and money often drive information consumption and will be acknowledged and addressed in the series.

Despite the intense growth of IP as a legal specialty, the widespread focus on IP in other disciplines outside the law and the increasing use of non-legal data such as patent statistical indicators, little has been written on IP research. There are no dedicated treatises or periodicals on IP legal research. There are no comprehensive treatises on patent, trademark or copyright searching. The intent of this series is not scholarship and footnotes. The intent is to provide some helpful tools and strategies to those performing IP research on the spectrum from law to facts. So, the phrase IP research in this introduction, unless otherwise specified, refers to the acquisition all types of IP information by the full range of consumers.

## II. THE RESEARCH PATH WE HAVE TRAVELED

This series will focus on tools and strategies in the new millennium. That said, the state of IP research today has evolved dramatically over the two centuries of IP law in the United States. Throughout the series, reference will be made to the historical evolution of IP tools.

The evolution of IP research has been the same for general legal and fact research—the path from dusty books to far off databases. Legal researchers, law librarians and special librarians in academia, law firms, government, NGOs and industry will relate to this discussion.

## III. FROM THE DUSTIEST LAW BOOKS . . .

### A. *IP Legal Research Example*

It is very difficult to get a comprehensive picture of early IP legal research tools. The following discussion is not comprehensive. It is largely U.S. centric. The intent is to provide a sense of how IP research was performed prior to the 1970s. For the first two centuries of U.S. legal history, primary sources of law (cases, statues, regulations, procedural manuals and administrative decisions) were solely in print. Production, distribution and subject access was slow and disorganized.

### **B. Judicial Opinion Example**

In the example of reported judicial opinions, there appears to have been no IP subject access until the late nineteenth century with the publication of the West National Reporter System and several sets of IP case reporters such as:

Samuel S. Fisher, *Reports Of Cases Arising Upon Letters Patent For Inventions, Determined In The Circuit Courts Of The United States* (R. Clarke & Co. 1867-1874);

Charles Sidney Whitman, *Patent Cases Determined In The Supreme Court Of The United States: Including Copyright And Trade-Mark Cases, And A Table Of All American Patent, Copyright, And Trade-Mark Cases Which Have Been Cited, Affirmed, Or Reversed. [1810-1874]* (W.H. & O. H. Morrison 1875-78); and

Stephen D Law, *Digest Of American Cases Relating To Patents For Inventions And Copyrights From 1789 To 1862: Including Numerous Manuscript Cases, Decisions On Appeals From The Commissioners Of Patents And The Opinions Of The Attorney General Of The United States Under The Patent And Copyright Laws, And Embracing Also The American Cases In Respect To Trade-Marks.* (Stephen D. Law and F.D. Lynn, 1877).

During this same time period similar case reporting tools were being published primarily in London to report British IP cases. It appears that IP researchers referred to primary and secondary British sources. Likewise, British sources appears to have been slow and in no way comprehensive.

This appears to have been the state of IP case reporting until 1929 when the legal publisher the Bureau of National Affairs (hereinafter BNA) offered a new case reporter called *United States Patents Quarterly* (hereinafter "USPQ"). The *Prefatory Note* to volume one informs this discussion:

*With this issue, The United States Patents Quarterly is inaugurated to provide decisions on patents, trade marks and copyrights in a convenient and extensively indexed form. Every effort has been made to prevent the publication from being merely another addition to the heavy loads already carried by shelves in the libraries of patent attorneys. Before the actual decision to issue the book was made, hundreds of letters were addressed to potential subscribers. These letters, asking whether the proposed service would be sufficiently valuable to warrant initiation, brought answers which stamped the contemplated service as thoroughly feasible. Many suggestions advanced in these communications from the leading patent attorneys of the United States have been incorporated in the publication. The United States Patents Quarterly provides the texts of scores of decisions printed in The United States Daily during the indicated three month period. Among these decisions are many not published elsewhere. The decisions are arranged chronologically according to the dates of appearance in The United States Daily. Thus the publication may be used as a supplement to files composed of clippings from the daily newspaper. 1 U.S.P.Q. 4 (BNA 1929).*

Here we see the beginning of publication of IP cases as a value added business. The strategies here include offering a comprehensive consolidated source of cases in three areas IP law in a timely manner with value added subject access. The cases were tied to the publication of a BNA news source to allow the lawyer to link the news to the full text—a theme that takes on new meaning in the electronic milieu discussed below.

USPQ has remained a premium IP case reporter for almost eight decades. It has added coverage of other related areas of IP law discussed below. During those eight decades other legal publishers have developed IP niche case reporters following the BNA model of a cumulating loose-leaf reporter tied to news and commentary. Examples are the *Copyright Law Bulletin*, *Copyright Law Decisions* and the *Trademark Law Guide* published by Commerce Clearing House (hereinafter CCH) and *Allen's Trademark Digest* by Aspen. The role of the dusty law book in the new millennium will be examined in light of the growth of computer assisted legal research, discussed below.

### C. *Secondary Source Example*

Finding IP secondary legal materials was also exclusively via print until the 1970s. IP was a small specialty practice area until the 1980s. It continues to grow as an integral piece of Internet and electronic commerce law and regulation.

During the nineteenth and most of the twentieth century a relatively small and discreet collection of IP treatises was published. During this period the legal system in Britain saw periods of significant changes, giving way to more modern forms. In the United States, the English legal system heritage was transformed into a new model demanded by the burgeoning industrial democracy.

A collection produced by legal publishing giant Thomson called *Nineteenth Century and Twentieth Century Legal Treatises* chronicles the establishment of both British and American law, and covers important and influential legal writers. *Nineteenth Century Legal Treatises* includes British and American works from the world's leading libraries, with the majority of material acquired from the Harvard Law School Library. This collection encompasses a range of literature produced during this century for research into legal and general history, including casebooks, local practice manuals, books on legal form, works for lay readers, pamphlets, letters and speeches. An analysis of this collection shows that only two hundred IP titles were collected during the entire nineteenth century. These titles included patent, trademark and copyright law.

Likewise, there were few IP law journals as we know them today. IP articles were published in U.S. and British academic law reviews. For earliest

U.S. examples see, Note, *Law of Patents - Decision of Judge Van Ness*, 1 U.S. L.J. 563 (1822-1823) and Simon G. Crosswell, *Infringement Cases in Patent Law*, 3 Harv. L. Rev. 206 (1889-1890). The following illustrates the oldest vintage of the most recent huge and ever growing collection of IP related journals:

Patent and Trade-Mark Review - 1902

Trademark Reporter - 1911

Journal of the Patent Office Society - 1918

American Patent Law Association Bulletin - 1939

Copyright Office Society Bulletin - 1953

Patent, Trade-Mark & Copyright Journal of Research and Education (now called IDEA) - 1957

Today the Pierce Law IP Library subscribes to over one hundred fifty active English language periodicals covering IP, commerce and technology. In addition are dozens of titles, which ceased publication over the last century. These physical holdings are supplemented by a collection of Web e-journals since many law schools and publishers now offer Web only access to IP related periodical literature.

#### **D. *Non-legal IP Research***

This category includes interdisciplinary journals, patent, trademark and copyright registrations and finding facts. The history of access to this data is the same. Before the development of computer research, discussed below, these IP related sources were in print format only. IP researchers spent their time in dusty libraries – there was no other choice.

One historical example is the journal IDEA, which was conceived as an interdisciplinary publication. This was an unusual choice for a law school publication. Volume one was published in 1957. A citation analysis of that volume shows heavy use of non-legal sources:

Primary legal 96

Secondary legal 21

Legislative History 14

Government Reports 16

Non-legal sources 76

These non-legal sources included print books dealing with accounting, economics, statistics, industries, management, inventorship, national resources and more.

Print journals cited in volume one include: *Review of Economics and Statistics*, *Journal of Political Economy*, *Review of Economic Statistics* *Business Week*, *Steel*, *Inventor's Reader*, *Fortune*, *Iron Age*, *Metal Treating*, *Purchasing News*, *American Journal of Sociology*, *Atlantic Monthly*, *Bell Telephone Magazine*, *New York Times* and *The Chemist*.

Patent searching is another example. Patent searching was done manually in print sources. Some searching could be done using the *Official Gazette of the United States Patent Office*, but any serious search was performed in the public search room at the U.S. Patent Office.

One longtime guest speaker in my Patent Searching class, Dick Wise, Esq. relates being issued a bib to protect his suit as he searched through the “shoes” at the Patent Office. If you don't know the term “shoes” you are dating yourself. The shoes were the boxes, which held the patent and file wrapper history documents. A good novel could be written about the mysteries and mayhem of missing and misplaced patent files. Wise also spoke of the absolute necessity of searching private print collections of art within corporations. He was counsel for International Shoe and the Gillette Razor. Corporations were often the best and sometimes only source of disclosed information. Inventors and marketing departments often knew better why an invention was new.

#### IV. ... TO THE MOST FAR OFF DATABASE

##### A. *Computer Assisted Legal Research*

IP research crawled along at the speed of U.S. Mail until the 1970s with the application of computers to legal research. Computer Assisted Legal Research (hereinafter “CALR”) has forever changed and expanded the ways we access IP information. During the same time period computer assisted research developed in many fields so that IP searchers began to have computer access to other types of data they needed such as non-legal journals, patent, trademark and copyright registrations and facts to assist transactional and litigation planning and decision making.

Research moved from the controlled world of digests, indexes and reporters to full text searching, allowing pinpoint search results within large documents. As Pierce Law Professor Tom Field reports, “[i]n the past, I had to read and read (closely) to find out whether something of interest was in a case; now full text searching eliminates that.”

My personal experience with CALR began in 1981 when I was a law student. During the 1980s most law schools offered faculty and students Lexis or Westlaw use. Both services offered access via terminals the size of a small

room. There was one password for each school. CALR use was scheduled in one-hour blocks. Printing was to silver thermal paper.

After graduation I practiced law in small firms using mostly print research tools. I saw a dramatic change in CALR access in 1992 when I returned to Pierce Law as computer research librarian and research professor. As personal computers were in wide use, Lexis and Westlaw had developed research software. Law students had unlimited use on any computer with research software and a phone line. Ten years later in 2002 the Internet was in wide use and both services provided unlimited use to law students via World Wide Web browsers—taking full advantage of the ability to link the user directly from citation to full text. In 2006 CALR can be done almost anywhere using hand held devices.

Not only has CALR technology evolved over the last two decades, IP content expands on a daily basis. In the 1980s Lexis and Westlaw were primarily case finding tools. In 2006 new databases are constantly added. Many databases are updated hourly. Both services offer millions of documents ranging from primary and secondary legal sources, non-legal sources and factual data. Databases have slowly gone global, offering foreign, comparative and international IP sources.

What this means to the IP researcher is that both services are vast, serving as comprehensive and complex sources of all types of IP information, including:

- \* Primary legal sources such as cases, statutes, regulations, procedural manuals and administrative decisions. Most of these are U.S. sources, but foreign and international primary sources are also being offered as they are acquired.
- \* IP dockets, briefs, pleadings and other court documents.
- \* Secondary sources such as journals, law reviews, treatises, encyclopedias and practice materials. This is an area of great growth since both services have acquired publishers of legal treatises that are being added on a monthly basis. This is discussed below.
- \* Legal newspapers, newsletter and current awareness materials.
- \* U.S., foreign and international patent, trademark and copyright registration databases.
- \* Non-legal sources with applications including interdisciplinary research, non-patent disclosures, trademark use searching, capturing and culling royalty rate information and more.

Many IP researchers think of Lexis and Westlaw primarily for legal research. The Westlaw Web integrates Dialog data—the largest collection of non-legal databases in the world. Dialog is considered the “supermarket” of databases, offering news, business, science, social science, medical and other possi-



bly IP related information. Both Westlaw and Dialog are Thomson companies leading to more and better information delivery. Likewise, Lexis offers news, business, public record, medical and other non-legal information in the Nexis files that are integrated into the LexisNexis family of Web products.

As further discussed below, both services offer topical IP areas and libraries. They allow you to customize your menus to have ready reference to IP sources. Both services allow you to purchase IP slices at customized pricing plans. The challenge is to learn what IP data they offer. Much data IP searchers look for is in general sources which are not considered IP and are not “sliced and diced” into the topical areas. Mixing and matching general and dedicated IP tools is discussed below and is a theme of the series.

### ***B. World Wide Web***

If Lexis in Ohio and West in Minnesota are far off databases, the growth of the World Wide Web brings us to virtual law library servers in the most remote corners of the globe. While the power of Lexis and Westlaw to deliver more IP information has been profound, the growth of the World Wide Web over the last decade has forever changed access to almost all types of IP data that can be imagined. Yet, like the premium vendors Lexis and Westlaw, the Web fails to capture countless IP sources. The series will consistently alert readers of IP information not on the Web.

While since 1990, the Supreme Court has released its decisions to the Internet, most law and law related sites were developed after the release of graphical browsers like Mosaic and Netscape in 1994. A look at the Web Way-back Machine shows that major IP law sites such as WIPO, EPO, USPTO and the Copyright Office, along scores of NGOs such as IPO, AIPLA, INTA and the Pierce Law IP Mall premiered sites in the 1996 and 1997.

It is hard to imagine that almost every IP organization around the globe has developed a Web presence in less than a decade. The ability to connect with IP professionals and the information they produce on a near real time global basis is astounding. The world of access to IP data has expanded beyond primary and secondary legal sources. All manner of IP information never generally publicly available is free 24/7 with the click of a button:

Patent, trademark and copyright filings

News

Reports

Databases

Documents

Support services

Legal Services

Academic commentary

Interdisciplinary sources

Not only is the challenge to know what you can find on the Web but what you can't find on the Web.

### ***C. Premium Services – Competition Rises***

The growth of the Web as a delivery avenue has led to numerous other online legal research services. The earliest companies to nibble at the primary legal source business of the giants included Casemaker, Fastcase, Lawprobe, Loislaw, National Law Library, QuickLaw America, RegScanLaw, TheLaw.net Corporation and VersusLaw. Upstarts have come and gone.

Like Lexis and Westlaw, other IP publishers now offer online Web versions. Examples are Aspen, BNA and CCH, discussed earlier, which now bundle Web versions of treatises and periodicals, often linking to primary sources.

## **V. COMPLICATIONS/IMPLICATIONS OF IP RESEARCH IN 2006**

### ***A. Growth of Scope of IP***

The earlier review of the IP treatises of the nineteenth century showed that IP included patents, trademarks, copyrights, trade secrets and unfair competition. In the new millennium IP embraces many associated legal specialties as well as interdisciplinary studies. Some associated legal specialties with IP synergy might include, art law, bankruptcy, business, biodiversity, commercial torts, crimes, cultural rights, damages, debtor/creditor, economics, employment (trade secrets), entertainment law, environment (sustainable development), health, human rights, indigenous rights, insurance, remedies, sports, taxation, telecommunications, traditional knowledge, world trade and more.

So, now you have to figure out how information sources define and classify IP. You have to expand your searches as many sites and services do not cover IP in the new age sense. You almost have to be a specialist within a specialty. You will capture and have to cull mountains of information if you claim to be an IP generalist.

**B. *IP Study is Global – from abundance to scarcity?***

The Internet, global transportation and communication have made the world a more connected place. As a current saying goes, the IP world is now flat. Many treaties and agreements require IP researchers to have access to foreign, comparative and international sources of law, policy and economic data. IP specialists can no longer say that their expertise stops at the U.S. border.

In the U.S., while there is an overload of primary sources of law, there is relative scarcity of much foreign IP law. While several commercial publishers and NGOs offer “IP Manuals” which cover statutes and practice outlines, English language access to most of the IP cases and administrative materials is not available. The same is true for patent and trademark registrations of many nations. How do you deal with this flat world without primary sources of law?

**C. *What About the Dusty IP Law Books***

No one can say how long we can say this but, to the shock of many students, most IP information is only in print. The print format is still essential for IP research. Most IP treatises and government documents prior to the 1990s are not in electronic format. Many current IP periodicals are not online. Some have a Web presence that requires acquiring and managing access to many subscriptions or turning to print.

Initiatives such as Project Gutenberg saw the beginning of attempts to offer older public domain content on the Web. Such initiatives have been slow and relatively narrow in scope. Recently a number of commercial and non-profit organizations have recognized that most of the legal treatises of the nineteenth and twentieth century are not in archival format. Microfiche collections of large treatise and journal collections were completed. These organizations have now begun to digitize these materials. Among them are many IP primary and secondary sources.

One major accomplishment is the service Hein Online that began as a general service offering Web access to older law journals. Their offerings continue to expand. Another example is the collection by legal publishing giant Thomson discussed above, *Nineteenth Century* and *Twentieth Century Legal Treatises*. The IP subsets of this collection are scheduled to be digitized for the Web in the near future. There are many other such projects. Details on all of these initiatives are beyond the scope of this introduction.

Google's mission is to organize the world's information, but they understand that most information isn't yet online. Google Print aims to get it there by putting book content where you can find it most easily—right in your Google search results. The book content in Google Print comes from two sources: pub-

lishers and libraries. Despite concerns about copyright and ethnocentrism, many say that resistance to Google Print is futile.

Another general Web service with many IP related books worth mention is Questia, the first online library that provides access to the world's largest online collection of books and journal articles in the humanities and social sciences, plus magazine and newspaper articles. You can full text word search all of the books and journal articles in the collection. You can read every title cover to cover. This scholarly content, selected by professional collection development librarians, is not available elsewhere on the Internet.

#### ***D. Multiplicity of Sources & Information overload***

Given this digital data explosion how do the consumers of IP information cope? There is multiplicity of sources. How do we keep up with these sources? How do we choose sources? This will be a major theme of this series.

#### ***E. Mix and Match General and dedicated IP sources***

There are only a handful of dedicated IP libraries around the world. IP resources are mixed in academic libraries are located throughout the collection. As pointed out in the beginning of this introduction, one theme of this series is that although print and electronic sources dedicated to IP abound, IP researchers often need to think beyond niche products. IP law, news, commentary and facts live in general sources. Such sources include general law and practice sets with IP topics.

The same holds true for the Web. IP law lives in dedicated sites as well as general law Web portals. There are many dedicated IP NGOs, but there are also many general NGOs in fields ranging from business to science that have quality IP content. IP news can be found on a spectrum from premium IP news vendors to free news feeds which report from thousands of Web sources. The next article in this series covers the full range of general and IP news sources.

#### ***F. IP Research is Fact Driven***

Ruth Carter Armstrong, Director of Information services at Goodwin Proctor LLP, in a presentation to the Law Librarians of New England, *Advanced Intellectual Property Research and Resources* (Boston University 2001) stated that in IP law firms, fifteen percent of all research is legal research. The other eighty five percent is finding facts. Other IP law librarians who hear this quote agree. Whether you are looking to analyze patent data for business and eco-

conomic purposes, conducting IP litigation or IP transactional planning you need facts to construct your proof, analysis or argument.

IP Litigation is in many ways the same as any other type of litigation, driven by facts. Who do we sue? Where do we serve process? What's the profile of the judge, opposing party, opposing counsel? How strong is the IP being infringed? What types of damages have been awarded in other like cases? We need facts, facts and more facts. Many of these facts are found in general services with IP content as discussed in the last section.

The list of IP fact research is almost endless. A few examples include,

- \* Bankruptcy records
- \* Dockets and pleadings
- \* Expert witnesses
- \* Government documents
- \* Intelligence on people
- \* Jobs
- \* Judgments
- \* Jury verdicts
- \* Lawyers and judges
- \* National offices
- \* NGOs
- \* Professional Associations
- \* Royalty rates
- \* Security interests
- \* Statistical sources

This series will include general and dedicated fact-finding tools and strategies.

### **G. *Media mix***

There are numerous articles, books and presentations on this topic beyond the scope of this introduction. We discussed that not all IP information is on the Web. We discussed the continued need for print and resources in other formats. The 2006 media mix includes print, CD-ROM, microform, the free Web and Web services ranging from low fee to premium. Electronic file formats range from plainest of text files to new fangled podcasts. Your challenge

is to find and use the dustiest law book and the most far off database in the most elegant combination to meet your information needs.

Having reference to print versions of statutes, regulations and procedural manuals may be important if the power goes out or you are on a plane, train or automobile without a local WiFi connection to the Web or your hand held device. That said, many IP libraries are discarding their print collections as more content in common use is in electronic format. It seems that space is expensive and many law firms are increasingly of the opinion that the “virtual library” or “libraries without walls” are fast approaching. As these libraries give in to space pressure conservation, you will have to expand your knowledge base to include places to find former tools no longer available. Books, microfiche and CD-ROMs still fill access needs. Some hope this only to be transitional to universal content and connectivity.

One such transitional technology is considered by some to be CD-ROMs. Pronounced dead by many, CDs and DVDs continue to be useful in IP research. Many IP treatises still integrate CD-ROM delivery of information. The same is true for the proceedings of many IP professional societies and continuing legal education vendors. CD-ROMs vendors seek to fill niche needs. One example of a value added CD research tool is the Achates Hypertext Law™ Libraries. Each of the three IP libraries of primary and secondary sources is easy to use because it's a “plug-in” to your web browser. This enables you to access the libraries with your browser in the same point-and-click manner that you use to surf the Web, but because the libraries install on your hard drive, your navigation through them is at warp speed. Furthermore, because each library is built with web technology, they can be shared via a standard intranet and they can interact via the Internet with additional resources on Achates' web server. Moreover, you can install the libraries on your notebook computer so you'll always have them with you.

#### ***H. Strategy: learn some factors to choose sources of IP information***

Given the general multiplicity of sources, multiple access points to the same data and information overload what is needed are approaches to evaluating sources. It has always been necessary to evaluate the weight of a secondary source. The sheer volume of somewhat undifferentiated Web pages magnifies this task. Just because something is on the Internet does not mean the information has any value. Teachers and librarians are now in the business of educating students from grade school to post graduate levels on how to evaluate information sources in the new millennium.

Value is relative to what you want to do with the information. Are you looking for news, commentary, scholarship? Are you drafting a presentation or paper? Are you writing a memo of law or a brief? Are you in the middle of a trial and need information yesterday?

Throughout history publishers have to some degree been the guardian of authority control. The reason large sums have been spent is because consumers trusted publishers to provide quality law sources as well as sources which explain the law and lead to further sources of quality law. This series will include factors to help researchers evaluate the integrity of IP content providers.

### *I. The Changing Face of IP Legal Publishing*

Until recently, the quality of legal authorities was in large part controlled by major legal publishers. They charge premium prices to deliver quality sources. The history of publishing IP primary and secondary sources, while fascinating, is beyond the scope of this introduction. Based on an analysis of the Harvard collection, discussed above, there was no predominant publisher of IP works in the nineteenth and early twentieth centuries. None of the major legal publishers we know today existed. The most active publishers appear to have been Little Brown in Boston, Baker Voorhis, Putnam and Strouse in New York as well as Stevens, Butterworth and Sweet & Maxwell in London. There were almost one hundred publishers that produced occasional treatises. That trend continues to today as hundreds of general publishers attempt to have some IP titles in their portfolios.

The latter twentieth century saw the growth of publishers filling the needs of IP researchers: BNA, Clark Boardman Callahan, CCH, Matthew Bender and Warren Gorham, Lamont. Most recently major collections have been offered by American Lawyer Media, Aspen, Oceana and Wiley.

Why is this important? This history leads to the new millennium, which is seeing the consolidation of numerous specialty legal publishers, and migration of secondary legal information into Web based research systems. Several major legal publishers have acquired numerous important IP specialty publishers.

The three current legal publishing giants are Thomson, Reed Elsevier and Wolters Kluwer. For example, Thomson Legal & Regulatory owns legal publishers covering IP in North America, Europe, Asia Pacific, Latin America and globally. These include West Publishing, Westlaw, the former Clark Boardman Callahan and Warren, Gorham & Lamont, Carswell (Canada), Sweet & Maxwell Group (Europe) and Lawbook Company (Asia). Many of the IP treatises from these companies are on the web as part of Westlaw. Reed Elsevier acquired Lexis Publishing, LexisNexis, the former Matthew Bender, Anderson Publishing, Michie, Mealey and Buttersworth that cover IP in Europe,

Africa and Middle East and Asia Pacific. Much of the IP information is vended on the Web as part of LexisNexis. The portfolio of Wolters Kluwer includes Aspen Publishers, Kluwer Law International and CCH Incorporated. This information is progressively being vended on the Web as part of several online services. Aspen Publishing is the fastest growing publisher of updated secondary sources on IP, Internet and e-commerce law.

Is this consolidation of publishing of IP secondary authority into the hands of a few giant corporations of any concern? Perhaps for those who have to pay for that information? But, never before in the history of humanity has there been so much published information with such little control. Most IP related organizations and firms around the globe publish information on the Web on a spectrum from news to scholarship. Anyone involved in any way with IP can find free space on the Web to publish ideas. The most recent delivery tool is blogs. Anyone with no knowledge of Web publishing can host a blog.

Similar trends can be discussed in the search for patent, trademark and copyright data and facts. The tap of information is wide open and there is information overload. Consumers of information in this open world must develop skills to evaluate the quality of all this stuff. One theme of this series is to teach approaches to evaluate Web information. As the author Richard Wurman has said: "One of the great ironies of the information age is that as the technology of delivering data becomes more sophisticated, the possibility that intellectual property professionals can process it all becomes more remote. It is as if we are at one end of an assembly line that is cranking out data at an alarming rate, and the machine has no off button. Raw data can be, but isn't necessarily information, and unless it can be made to inform, it has no inherent value. Understanding lags behind production. What has been virtually untapped is the understanding business. Understanding is the bridge between data and knowledge."

### *J. The Cost Spectrum – "you get what you pay for . . .?"*

In the new millennium, sources of IP information from legal research to patent, trademark and copyright searching often are on a spectrum from free to premium. Have primary sources of law, patent and trademark data become commodities in the U.S.? There is great competition for your research dollars and the hits that only the click of your mouse delivers.

There is some misconception by academic librarians that money is no object to rich law firms and corporations. Librarians and patent searchers in some of the largest organizations repeatedly teach me that keeping information costs down is an ever-growing pressure.

This series will help researchers evaluate when the use of free Web sources is indicated and when not. You may use the free Web to grab the text of



a new judicial opinion but not for in depth research. You might use a free patent searching site if you know a patent number, but not to do a validity or infringement search.

**K. *Are free sources alternative or complementary to premium services?***

This series will consistently cover all the IP tools along the spectrum to help think about the applications of these tools, asking the question—are the selection of free and low fee Web tools alternative or complimentary to premium services. This question is regularly asked in the context of legal research, patent, trademark and copyright searching. Why should we pay for stuff that's free on the Web?

The constant question we must ask as consumers of data is—what is the value added? Our first example in this article was case publication. There are many free and low fee access points. What value do Lexis and Westlaw add? Some factors include:

- Scope
- Coverage
- Currency
- Comprehensiveness
- Editorial enhancements such as topics and key numbers
- Libraries of related sources – “legal research systems”
- Unique services such as Shepard's and Keycite
- Proven history of reliability
- Star pagination to print reporters
- Integration of dockets and pleadings
- Integration of information on lawyers and judges involved in reported cases.

**L. *Don't be “penny wise and pound foolish”***

Time is limited. Often time is money. Does it make sense to spend hours looking for a free document? For certain needs, premium services such as Lexis and Westlaw may be a “one stop shop” for your news and research needs. Subscription options for services such as Westlaw and Lexis have greatly expanded over the last decade. If you have flat rate access to premium services,

you might not elect to spend your precious time finding and evaluating free sources just because they are free.

### ***M. Transferable Approaches to Searching***

This multiplicity of sources does not have to be daunting to searchers. Database searching skills are transferable. If you are a Lexis or Westlaw power searcher, there is a strong likelihood that those skills allow you to search other services—if you are mindful of your approach.

All database services organize the data. Westlaw has topical areas. Lexis has Libraries. Within each of these areas are databases or files. Inside of these databases are documents. All documents can be searched in logical pieces. These are called fields or Westlaw and segments on Lexis. Within the fields are words. Words are search by formulating using connectors. These are also known as Boolean searches. Both services allow natural language searches in some databases.

The approach I teach is:

1. find out the database you believe has the information you want
2. look at description of the database provided by the vendor
3. figure out how the document is arranged, i.e., what are the searchable fields
4. use the links and materials by the vendors to see which connectors are supported
5. formulate your search
6. evaluate your results

This is an iterative process that builds off what you learn. The two factors are precision (how good was my search) and recall (how much possibly relevant results I did retrieve).

Almost any major Website yields to this approach. This includes search engines. For example, look at Google's Advanced Search page that allows searchers to find results:

- with all of the words
- with the exact phrase
- with at least one of the words
- without the words
- by language
- by file format
- by page update frequency

by occurrences

by site or domain

by similarity

by pages that link to a page

This series will help demonstrate that certain search strategies work across most platforms and that you can learn the secrets of the super searchers.

### *N. Ethical and Liability Considerations.*

Professor Bob Berring, long-term legal research expert and now Dean of Boalt Hall Law School, has stated that presentations and articles on research should contain some ethical implications. What are some of the ethical and liability risks associated with IP related CALR in the new millennium?

Most of the authorities discuss legal research. Although there is no statutory duty to perform patent and trademark searches, failure to perform searches has come up in the content of willful infringement determinations. Some of the following will be discussed at times in this series:

- ethics violations
- duties of disclosure
- legal malpractice
- sanctions under Rules 11 of the U.S. Federal Rules of Civil Procedure
- abuse of process
- contempt
- public scolding in written decision

If you are a patent agent or lawyer, is not finding important relevant law, facts, prior art, trademark use, etc. a breach of the duty of competence? Diligence? Client informed consent? Meritorious claims? If the client instructs the lawyer to perform legal research, patent or trademark searches “on the cheap” does this violate the duty of exercising independent professional judgment? What about the duty of candor? Can a lawyer plead ignorance? Over three dozen journal articles have been written on these questions. Competent research is not optional.

## **VI. CONCLUSION**

I hope that this introduction raises some interesting questions. The intent is that this series will cover a very broad range of topics for consumers of IP

information. We will cover tools and strategies. We will cover new and emerging IP information delivery technologies. We will compare sources of information. We will review new products. We will present pathfinders on IP topics. Your suggestions for topics are very much requested. Email your suggestions to [jcavicchi@piercelaw.edu](mailto:jcavicchi@piercelaw.edu).