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New Research Uses for Patent and Trademark Data

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by Roger V. Skalbeck

Patent and trademark databases are most commonly used to support the information needs of people trying to protect products and inventions. During the application process, called prosecution, attorneys and information professionals regularly consult a core set of data sources to determine questions of novelty, uniqueness, and availability. These same data sources are also useful for other kinds of research, much of which requires little knowledge of patent or trademark law.

In this article, I examine alternative uses for information found in patent and trademark filing databases, suggesting ways to locate a law firm's clients, perform competitive intelligence, and locate or investigate expert witnesses. Finally, I talk about an interesting non-law use of patent data, i.e., historical research.

Finding a Firm's Clients or a Company's Firm(s)
Although it is possible for someone to apply for a patent or trademark without hiring a lawyer, most companies don’t do this. In applying for a patent or trademark, lawyers and law firms have to provide their contact information for communicating with the United States Patent and Trademark Office (USPTO). This information is recorded in a specific field in United States patent and trademark databases, and it serves as a great key for finding a law firm’s clients or a client’s law firms.

Our first stop is trademark databases. LexisNexis and Westlaw offer comparable databases for trademark law. With LexisNexis, trademark data is found in the ALLTM or FEDTM databases. Because trademark protection is available at both state and federal levels, choosing the larger database will get you more results, even if it is marginally more expensive. The situation on Westlaw is fairly similar, with the ALL-TM and FED-TM databases. LexisNexis data comes from CCH Corsearch, while the Westlaw data comes from Thomson and Thomson.

Attorney information is found in the Correspondent field on LexisNexis and in the FILING-CORR field (FC for short) on Westlaw. On either service, this field contains a single attorney name with the firm name and address. Though the free trademark search site from the USPTO lets you search for attorney of record, it does

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not currently list law firm names. For anyone interviewing with a law firm or doing a thorough conflicts check, searching this field should give a quick answer as to the names of a law firm’s clients. It is just as easy to find a company’s law firm representatives.

Patent databases offer similar options. Westlaw’s parent Thomson Reuters also owns Dialog, which has been a core provider of patent data for many years. Given this, there are numerous good patent databases on Westlaw. LexisNexis has comparable coverage for patent filings, also providing PDF images of patent documents, for a fee.

To search for law firm names on LexisNexis, use the field LEGAL-REP and on Westlaw the field is ATTORNEY. On the USPTO website, you can search for law firm names in the field LREP, though searching is not as easy as on commercial services.

There are drawbacks. Searching for a law firm name is not perfect for at least two reasons. First, law firms change their names often. Second, companies may employ specialized firms for their intellectual property work, while using a different, general practice firm for other major legal assistance.

One downside to using Westlaw or LexisNexis for getting client lists is that it takes some effort to customize the output in a useful manner. Though fielded searching is very robust on both services, don’t expect to easily extract only company and law firm names from the records. Patent and trademark records are long, so either get citation lists or expect to do a lot of cutting and pasting for any quantitative analysis. Although LexisNexis has four citation formats for its patent database, none include law firm names.

Of course, if you have access to native Dialog, customized output and tabulated results can be created with utmost precision. Where I work, I seem to be the only person who misses Dialog’s command line interface, so you need to know their search syntax well to get the best results.

Competitive Intelligence

One type of trademark application can be a boon for competitive intelligence researchers. Just a few years ago, you could file for a federal trademark only if you had actually used the mark for goods or services. This meant that companies had few options for reserving a name in advance of, say, a product launch. Now it is possible to file what is called an “Intent to Use” application, which means just what the name suggests—you intend to use it for something. This lets companies reserve a name to better protect a mark. However, it is also a way to let others know what mark you intend to use, thus telling others the products or services you may be launching soon.

Interested in knowing which products a company may introduce some day? Consider setting up a tracking service to look for only those marks listed as “intent to use” filings. Savvy companies do all they can to conceal competitive information in the trademark filings. That said, if Gillette saw mention of an intent to use application from Schick for the “Quattro,” I suspect they could have guessed that it would be a four-blade razor.

Patent applications are no less useful for competitive intelligence. There are numerous methods for using patent data for competitive intelligence, often requiring sophisticated data analysis tools. You can analyze a company’s portfolio of issued patents, look at distribution of inventions based on a particular classification, or use citation analysis tools to determine the importance and quality of a company’s patents. Here I suggest two ideas of how to use patent databases for competitive intelligence.

Today, with few exceptions, all patent applications are published 18 months after the application date, whether or not a granted patent has been issued in that time. By choosing to monitor just the published patent applications of a company, you can track patent plans as soon as is legally possible.

A published application gives the applicant no legal right of enforcement, but it puts people on notice of what they plan to enforce. Of course, after an 18-month lapse, many described technologies could be discovered through other means. For companies with a limited list of known competitors, it is a good idea to keep track granted patents as well as published applications, which is easy on both Westlaw and LexisNexis.

Another tool for monitoring patent documents is to use Google’s Patent Search. They provide the option to track updates to any search of their database with a customized RSS feed provided by their site. With this, when new items are added to their database that meet your criteria, you can find out about them in your RSS news reader. LexisNexis and Westlaw’s alert services can be much more targeted, but Google’s RSS option is free.

One other tip for finding competitive intelligence...
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on smaller companies is to look for patents owned by
chief officers, especially in the area of information
technology and biotechnology. On several occasions,
I have found no patents assigned to or owned by a
company, although a company officer had been
granted patents in his or her own name.

Finding Expert Witnesses

For people involved in litigation requiring scientific
knowledge or expertise, patent documents can
provide good information on the skills and abilities of
numerous inventors and scientists. Also, when consid­
ering a potential expert witness, searching patent data­
bases can reveal specific knowledge and experiences
that might not be described in other literature.

One nice thing about patents is that they are in a
way the ultimate "peer reviewed" publication. A
patent is not granted until somebody at the USPTO
knowledgeable about its subject matter has reviewed
the application in great detail. Since inventors prob­
ably never draft entire applications, patent documents
are obviously not written by them. That said, if you
need to find somebody who knows a very specific
scientific discipline well, finding a patent on the
subject can lead you quickly to a potential witness.

Historical Research

Patents are useful not only for understanding the legal
protections that they provide. There is also a wealth of
information in patent documents describing the nature
of the inventions, much of which can be used to give
the historical context for many technologies. As but
one example, science professor and historian Henry
Petroski regularly includes information in his books
available only from granted patents. One of the best
examples for using patents for historical research can
be found in his book The Evolution of Useful Things,
in which he traces the history of common objects such
as zippers, paper clips, and forks.

One section of modern patents is called the "back­
ground of the invention." This section provides the
narrative context for the patented invention, requiring
that it contain a statement about the prior art known
to the patent applicant. This is a good potential way
to understand societal problems through history, and
views as to how to solve them.

With more than seven million patents issued so far
in the United States, this gives you many options for
non-legal research. Thankfully, patents are search­
able on Google (www.google.com/patents), so you
don't have to pay expensive database charges to try
this out.

Conclusion

In conclusion, remember that when performing
research, patent and trademark databases aren't just
for intellectual property practitioners. If you've shied
away from using them for any reason, consider these
suggestions for other uses. Also, if you just want to
know what kind of technologies and products have
existed over time, both patent and trademark data­
bases go back for a long period of time. They docu­
ment the millions of products and ideas developed
over more than a century. With some creative
thinking and careful search strategies, these sources
can provide new tools for your research arsenal.

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