

2008

## New Research Uses for Patent and Trademark Data

Roger V. Skalbeck

*University of Richmond*, [rskalbeck@richmond.edu](mailto:rskalbeck@richmond.edu)

Follow this and additional works at: <http://scholarship.richmond.edu/law-faculty-publications>



Part of the [Intellectual Property Law Commons](#), and the [Legal Writing and Research Commons](#)

---

### Recommended Citation

Roger V. Skalbeck, *New Research Uses for Patent and Trademark Data*, *Legal Info. Alert*, Feb. 2008, at 1, 3-4.

This Article is brought to you for free and open access by the School of Law at UR Scholarship Repository. It has been accepted for inclusion in Law Faculty Publications by an authorized administrator of UR Scholarship Repository. For more information, please contact [scholarshiprepository@richmond.edu](mailto:scholarshiprepository@richmond.edu).

Journal  
2484

UNIVERSITY OF RICHMOND

JUL 07 2008

LAW LIBRARY

## New Research Uses for Patent and Trademark Data

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

*continued on page 3*

### Contents

<b>New Research Uses for Patent and Trademark Data</b>	<b>1</b>
<b>New Sources</b>	<b>6</b>
<b>Publishers</b>	<b>15</b>
<b>Index</b>	<b>15</b>
<b>Last Word: Memories of Roy Mersky</b>	<b>16</b>

## New Research Uses...

*continued from page 1*

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 ThomsonReuters also owns Dialog, which has

---

***On the [patent office] website, you can search for law firm names in the field LREP, though searching is not as easy as on commercial services.***

---

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 file 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 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

*continued on page 4*

## New Research Uses...

*continued from page 3*

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 considering a potential expert witness, searching patent databases 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

### **A Note About Copyright Databases**

One thing you may have noticed about this article is that there is no mention of alternative uses for copyright databases. This does not mean that there are no good databases for copyright records, but alternative uses for them are minimal. In fact, the Library of Congress provides a copyright registration database online free of charge: [www.copyright.gov/records/](http://www.copyright.gov/records/). Here you have more than a dozen fields you can search for copyright registration information, ranging from title to ISBN to author to general keyword. What you don't find is a field for the name of a legal representative, such as a lawyer or law firm.

Section 7 of the current form for literary works (Form TX) has a field for correspondence, where many companies probably list their lawyers. Copyright registration rarely involves extended interaction between the Library of Congress and the person applying for protection. For this reason, there may be little reason to track or report legal representation in the process. A more practical reason for excluding Section 7 information from the registration database is that it asks for an e-mail address and phone number. Presumably easy e-mail harvesting is a non-traditional use of an intellectual property database the Library of Congress expressly chose not to support.

*Roger V. Skalbeck*

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 probably 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 "background 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 searchable on Google ([www.google.com/patents](http://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 databases go back for a long period of time. They document 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. **A**

*Roger V. Skalbeck is Associate Law Librarian for Electronic Resources and Services at Georgetown Law Library in Washington, DC. His e-mail address is [rvs5@law.georgetown.edu](mailto:rvs5@law.georgetown.edu).*