

RESEARCHING U.S. INTELLECTUAL PROPERTY LAW IN THE DIGITAL AGE: HOW ONLINE RESEARCH ON WESTLAW CAN ENHANCE YOUR RESULTS

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ABSTRACT

Given today's advanced technology and ease of communication, Intellectual Property (IP) law has become significantly vital in protecting IP owner's property from unauthorized access or use. The aim of this paper is to educate researchers outside the U.S. on how to do research on American Intellectual Property and analysis in order to gain at least a modicum of understanding, and dispel the myth of online legal research being a difficult task for users familiar with print resources.

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I. Introduction

When we talk about Intellectual Property (IP), we are referring to concepts like patents, copyrights, trademarks and an owner's intangible assets, i.e. design and idea respectively.

Legal research is not merely a search for information, but it involves several stages, such as collecting empirical information, in-depth critical analysis and comprehensive understanding. Many publications like Blaustein (1969),¹ Kelso (1965),² and Rombauer (1973)³ have stressed that legal research is fundamental for students and lawyers in their profession. Hence, we should take legal research instruction seriously and seek to master it whether online or in the library. This is made easier with the online legal research service Westlaw.

With the use of Westlaw, users can have access to an extensive collection of IP law-related material. These include secondary materials such as legal encyclopedias, treatises and practice guides, periodicals, law reviews or journals, and primary materials such as statutes and cases.

II. Foundations of American Legal System

For researchers to approach the American jurisdiction, it is fundamental to digest the components of the structure of the American legal system. As shown in Gionfriddo (2007), whose paper suggested that before a researcher can identify and pool together the relevant authority into an analytical framework, understanding of the nature and hierarchy of authority in the American legal system is prerequisite.⁴

The United States of America is a federal union consisting of 50 independent states, each with its own constitution. Statutes are contained in statutory codes at the federal and state levels. Statutes are primary source of law. However, statutes do not cover all circumstances, and every case has its own particular issue and the US court has the power to interpret the statutes if a dispute arises. The judge will take into account previous cases as a guide, in deciding how they interpret the statute and the reasoning.⁵ Hence, the court's conclusion for each case may serve as precedent, which is often binding and always important to subsequent court decisions. Ruggero Aldisert, the judge of the United States Court of Appeals for the Third

¹ See Albert P. Blaustein, *On Legal Writing*, 18 CLEV. MARSHALL L. REV. 237 (1969).

² See CHARLES D. KELSO, A PROGRAMMED INTRODUCTION TO THE STUDY OF LAW (Bobbs-Merrill 1965).

³ See MARJORIE DICK. ROMBAUER, LEGAL PROBLEM SOLVING: ANALYSIS, RESEARCH, AND WRITING (West 1973).

⁴ See Jane Kent Gionfriddo, *Thinking Like a Lawyer: The Heuristics of Case Synthesis*, 40 TEX. TECH L. REV. 1, 4 (2007).

⁵ See BLACK'S LAW DICTIONARY (9th ed. 2009) (interpreting "stare decisis").

Circuit, stated that “precedent is the basic ingredient of the common-law tradition. It is a narrow rule that emerges from a specific fact situation.”⁶

Aldisert has also defined precedent as:

[T]he rule of the case creates a binding legal precept. A judicial precedent attaches a specific legal consequence to a detailed set of facts in an adjudged case or judicial decision, which is then considered as furnishing the rule for the determination of a subsequent case involving identical or similar material facts and arising in the same court or a lower court in the judicial hierarchy.⁷

As mentioned above, they may serve as authorities at which are often binding. Hence, it drives how decisions are made in future cases.⁸ Consequently, it could be said that the common law is comprised of the opinions of courts. As such, for lawyers or students, who would like to produce a persuasive argument, it is recommended to approach the case law databases first in their research, which gives a more conclusive and judicially interpreted view of the law.

A. Sources of law

Laws are made at three basic levels: federal, state and local. Operating at each of these are three sources of law: legislatures, judges and executive officers.⁹

These government bodies belong to one of the three branches of government which are 1) The Legislative Branch which produces statutes; 2) The Judicial Branch which produces judicial decisions; and 3) The Executive Branch which issues orders, regulations and administrative opinions. All of these types of law, and how to research them, are discussed in detail below.

III. Tools for Legal Research in the U.S.

Wren and Wren (1988) wrote one of the first articles in giving legal research instruction.¹⁰ Their paper emphasized on the word bibliography, which obviously becomes a so-called Bibliographic Method of Research.

⁶ See RUGGERO J. ALDISERT, *OPINION WRITING* (2d ed. 2009).

⁷ See *Allegheny Gen. Hosp. v. N.L.R.B.*, 608 F.2d 965, 969-970 (3rd Cir. 1979).

⁸ See *INTERNATIONAL ENCYCLOPEDIA OF THE SOCIAL SCIENCES* (David L Sills ed., Macmillan 1968) (defining “Law”); see also *Encyclopedia.com*, <http://www.encyclopedia.com> (last visited June 1, 2012) (checking “Law”).

⁹ See STEPHEN ELIAS & SUSAN LEVINKIND, *LEGAL RESEARCH: HOW TO FIND & UNDERSTAND THE LAW* 22.

¹⁰ See Christopher G. Wren & Jill Robinson Wren, *The Teaching of Legal Research*, 80 *LAW LIBR. J.* 7, 47 (1988).

Bibliographic resources in the law are broadly divided into two categories. Primary sources refer to publication of code, statutes, court opinions and decision. Secondary sources refer to those resources that further explain the Primary sources. Both Primary and Secondary Sources are available on Westlaw.

Users can find IP resources within Westlaw in two simple ways. Firstly, users are able to choose “Intellectual Property” directly from a list of material called “Topical Practice Area”. Users can further narrow your search by choosing the more specific sources. Alternatively, at the top of the main page, there is a tab for Intellectual Property.

A. Secondary Sources

1. Keywords

The main idea is “keyword”. This may sound too obvious. However, this is where researchers often go wrong and struggle where no useful information is found. To do a good search you need to think and analyze the subject that you are researching.¹¹

The process of legal research involves the proficiency of defining the legal matters, having access to law resources, and the aptitude to relate and apply what is being discovered. Hence, researchers should always bear in mind what they are trying to achieve.

To start off with your research, think about all the terms and words that might possibly assist you in finding the material that you need. You should avoid simply digging out the fact-pattern keywords and go directly to statutes or case.¹² It might be a waste of time eventually if those words have not been actually used in the statutes or cases that you are looking for.

Wren and Wren suggest that researchers must have a good understanding of the statutes or cases to form its models to make up an argument.¹³ However, it is not always the fact that researcher could understand the statutes or cases simply by reading through cases and statutes.

2. Legal Encyclopedias, Treatises and Practice Guides

Consequently, if researchers are unfamiliar with the area of Intellectual Property law, it is suggested to use Secondary resources such as Legal encyclopedias, Treatises, Practice Guide to comprehend your topics and have a broader overview of the area. These sources mentioned not only provide comprehensive footnotes citing the most prominent cases and authorities

¹¹ See Scott P. Stolley, *Shortcomings of Technology: The Corruption of Legal Research*, 46(no. 4) FOR THE DEFENSE 39, 40 (2004).

¹² See Michael J. Lynch, *An Impossible Task but Everybody Has to Do It-Teaching Legal Research in Law Schools*, 89 LAW LIBR. J. 415 (1997).

¹³ See Wren & Wren, *surpa* note 10, at 47.

discussing these theories, these materials help you to locate valuable information such as professional law vocabularies or procedures commonly used in that area. The content will also link you to the journals and law review articles for further searching.

If you know very little about the topic you are researching, it is recommended to consult a Legal Encyclopedia to develop terms for searching other tools, or to obtain references to primary or secondary materials. The two major legal encyclopedias are: *American Jurisprudence 2d* (AMJUR) and *Corpus Juris Secundum* (CJS).

Identifying a good legal treatise and getting the background and context often give the most successful legal research. Treatises are defined as the monographs that give comprehensive guides to discrete areas of law.

Westlaw provides research tools to make your research faster and easier, such as links from cases and statutes to the full text of treatises on Westlaw which cite them. Browsing of Tables of Contents is recommended as a starting point of the research, which you'll be able to browse to specific point of law that's most interesting and helpful to your research. Westlaw also provide the advantage of natural language and terms & connectors searching though out all content including Key Numbers. Many treatises are also available as citing reference in KeyCite.

A library of treatises is also available online on Westlaw. These are conveniently grouped for specific practice area such as IP (eg. IP-TP) and can also be found in the Directory.

Practice guides are in-depth resources that provide step-by-step procedures, legal interpretations and analyses of the law. They also provide sample pleadings and transaction forms for your reference. Practice Guides are well-written and well-organized; give researchers a better understanding of the procedural and substantive law, as well as the hands-on instructions necessary to file before deadline. To sum up, practice guides explain what to do, when to do it, and how to do it.

3. Annotated Law Reports, Law Reviews, and Periodicals

In order to conduct case law research, it is advisable to include of relevant American Law Reports, Law Reviews and Journal articles. Each of these sources has a slightly different focus, and reference to each can be very useful to gain a more understanding of the research issue.

American Law Reports (ALR-IP) are annotated law reports written by attorneys and contain annotation covering timely or contemporary issues. A typical annotation discusses a leading case, summarizes related cases on a particular legal issue or fact situation. As such, an ALR can address issues with much more specificity than treatises. An ALR annotation typically contains an article outline, references to law review articles and other analytical materials which allow you to get an in-depth understanding.

In searching for annotated law reports, it is preferable to use the online searchable databases rather than the current print version. This is because searching in the print version would require sorting through various indexes and pocket parts to these indexes. A well constructed search through an electronic version of ALR, available on Westlaw under a database called ALR-IP and will retrieve all relevant documents in IP law.

Law reviews articles are often written by law professors, unlike legal encyclopedias, the contents are selective and exclusive. However, there may be some times that particular issues might not be covered under those articles; if that is the case then you will have to turn to an alternative searching tool. Recent periodical articles often offer review and analysis of current decisions, new laws, and recent legal problems. Thus, a relevant article can provide useful information for relevant laws that have recently changed. They can also warn the practitioner of new legal pitfalls, and recommend new strategies in approaching legal problems. Thus, running a quick search through an article database for recent articles that are on point is highly recommended.

Most intellectual property journals are indexed in the weekly editions of the Current Index to Legal Periodicals (CILP) and more than 1,000 law reviews and journals are available under the database Intellectual Property-Law Reviews, Texts & Bar Journals (IP-TP) on Westlaw which give researcher access to a wealth of information.

B. Primary Sources

1. Statutes

As discussed above, effective legal research can begin by reading secondary sources. When reading these secondary sources, the researcher should always be on the lookout for statutory references.

Federal statutes from the United States Code Annotated (USCA) that relate to intellectual property rights are contained in the Federal Intellectual Property-U.S. Code Annotated database (FIP-USCA). Corresponding federal regulations are contained in the Federal Intellectual Property-Code of Federal Regulations database (FIP-CFR).

USCA will annotate statutes with case citations, helping the researcher to find case law.

The annotated codes are extremely useful for these annotations, as attorneys and law students can quickly scan these case annotations to locate cases for further research. Each annotation will include a case citation with which the case can be retrieved from Westlaw.

Secondary sources will often cite Public Laws as published in the Statutes at Large, particularly when citing to new legislation and the researcher will need to convert the citation to a United States Code cite in

order to perform effective and current research and find the text of the statute as codified. The statute at large table will enable the researcher to pinpoint exactly where the statutory provisions became codified.

On the other hand, researchers will frequently be asked to retrieve a statute by its so-called popular name, such as Lanham Act under the area of IP law. The Lanham Act also known as the Trademark Act 1946. When you need to find out what the name of a statute is, the best resource you can turn to is a popular name table. The Acts cited by the USCA Popular Name Table (USCA-POP) will steer the researcher to the correct name of the statute.

a. Citation

The easiest way to retrieve a specific document when researchers have the citation is to use the Find Services. A typical citation to the U.S.C.A. looks like this: 17 U.S.C.A 107. This is a reference to U.S. Code Annotated, Title 17, section 107 (which happens to be the fair use provisions of copyright).¹⁴

The Find services allow the users to retrieve a specific document as if the researchers have the citation in hands. Documents can also be located using one of the two search methods (Terms & Connectors and Natural Language) for searching full text materials.

2. Case Law Research

Here we advised that legal research should start off with an examination of secondary sources and then review carefully all controlling statutes and regulations. However, as legal research must involve detailed analysis and requires some lateral thinking to identify all the topics needed to comprehensive research of a particular area which can be time consuming.

a. West American Digest System

Judges write opinions. These are also called decisions, or orders or rulings. They are also called cases. All these terms refer to the same thing: a writing of the court. Judicial decisions are published in sets called “reporters”. There is a team of editors from West providing case citations and summaries of cases discussing legal points (digests). West Digests arrange their points of law case summaries by a topic, subject and key numbers classification system.

The Key Numbers are part of the West Digest System. West has taken law as a subject and divided into over 700 subject areas, called topics.¹⁵

¹⁴ See THE BOSTON COLLEGE LAW LIBRARY, LEGAL RESEARCH GUIDE #1 READING LEGAL CITATIONS (2004), http://www.bc.edu/content/dam/files/schools/law_sites/library/pdf/researchguides/citations.pdf.

¹⁵ See Doug Batey, Westlaw Changes Topics and Key Numbers for LLCs and Corporations (June 2, 2011), <http://www.llclawmonitor.com/2011/06/articles/legal-research/westlaw-changes-topics-and-key-numbers-for-llcs-and-corporations/>.

These subjects are then further divided into subtopics, which are subdivided into what are called “Key Numbers”. There are over 100,000 individual Key Numbers used in the arrangement. A topic and subtopic together comprise a Key Number.

Key Number editors assign a key number for every point of law found in an opinion. In West Digests the topic and Key Number for Patent 291 look like the example below.

The Key Number, 291k refers to the subject Patent. 291k162k represents “Contemporaneous construction of inventor” under Patent. West gathered points of law concerning Contemporaneous construction of inventor under the 291k162 label.

The editors then write a paragraph summarizing the point of law represented by the Key Number. These paragraphs, along with the Key Numbers are superimposed upon each opinion. The Key Number along with its paragraph of text is called a headnote. Each headnote is given a headnote number, a topic, Key Number, and sometimes a statute, court rule, or regulation citation. Headnotes are listed immediately before the beginning of the opinion.

Westlaw organizes all IP cases into the Federal Intellectual Property-Cases (FIP-CS) database.

3. Natural Language

For case research, researchers are recommended to select Natural Language as the searching method. Natural Language allows you to enter a description of your legal issue in plain English. Researchers can type in whatever comes to mind and there is always a search result, as Westlaw will identify legal phrases in your description (such as novelty and statutory bars, fair use, disclosure and enablement), removes common terms (such as *is* and *for*), and generate variations of terms (such as infringed, infringing and infringement).

For Asian researchers, there are sometimes work or terms that we might use words which are not commonly used at the articles from U.S. You can add your own related terms to a description or you can add terms suggested by the Westlaw thesaurus. For example, we are searching trade secrets regarding workers of the company, if we use the thesaurus we might find out that workers can also be known as employee and thus we can add it to our search in order to retrieve more related articles.

4. Terms & Connectors

On the other hand, a more precise searching can be done using Terms & Connectors. This search engine would limit the keywords entered by the researcher, by using field limitation. Terms & Connectors searching provides user of Westlaw with forum to construct highly detailed and specific searches, leading to very focused results. For example:

“ti(McCarthy) & Website (web internet /s site page) /p copyright /s infringing!”

This search would limit itself to the title field of the case which is the name of the parties and it would use the connectors to retrieve cases with certain words and phrases appearing in certain word order as typed in by the researcher.

5. KeyCite

KeyCite is a powerful citation research service. It is useful whether you are beginning, expanding or updating your research. It provides the history of a case, statute, regulation, or administrative decision to help determine whether it is good law and to retrieve citing references.

This raises the importance of tracking whether the authorities are current and still valid at the point of checking. KeyCite also provides citing references from numerous analytical materials such as American Law Reports; and patents issued by the U.S. Patent and Trademark Office which cited your authority for a specific point of law.

KeyCite includes graphics such as status flags, depth of treatment stars, and quotation marks that enable you to focus your research on the citing references which will carry more weight. You can find the KeyCite status icons under KeyCite at the top of the page in Westlaw.

IV. Methodology

Whether online or print, the primary strategy of legal research is to identify and analyze the significant facts that raise the legal issue.¹⁶ Researchers are then suggested to increase their understanding by reviewing one or more analytical sources and determine relevant authorities related to the issue and at the end run a quick search to see whether they are up to date.

The problem for many researchers is how to begin. With today’s advanced technology, information has now been digitized. This saves us enormous time in flipping through the pages of law books and finding the right article or case.

As shown in Sanford N. Greenberg (2007),¹⁷ online research has tremendously overridden the use of print as it provides a quick and easy way of accessing content. Whilst traditional print sources provide the same information but it is extremely time consuming to find articles. On the other

¹⁶ See STEVEN M. BARKAN, ROY M. MERSKY & DONALD J. DUNN, *ASSIGNMENTS TO FUNDAMENTALS OF LEGAL RESEARCH AND LEGAL RESEARCH ILLUSTRATED* (9th ed. 2009).

¹⁷ See Sanford N. Greenberg, *Legal Research Training: Preparing Students for a Rapidly Changing Research Environment*, 13 *LEGAL WRITING: J. LEGAL WRITING INST.* 241 (2007).

hand, by entering keywords in online search engines such as Google Scholar¹⁸ and Science Direct, it can give you an effective way to filter to just the law related publications. Moreover, using specialist law databases like Westlaw provides subject specific function and advantages.

Nevertheless, do not be overwhelmed by the potential of online research. If an inefficient methodology and approach is adopted, it could lose its advantages. Researchers need to employ an effective research strategy with a clear understanding of how to use Westlaw, in order to achieve the best results.

Take the following potential trademark issue as an example:

Bolton LLC, owns “A’moe du Chocolat” the famous trademark for chocolates since 1950, and has nationally advertised its chocolates to be the world finest chocolates from France. Amy Jacoby is marketing and selling candies manufactured locally called “A’moe Jay Candies” which has the similar packaging to “A’moe du Chocolat.” Bolton LLC wants to know if they have a claim against Amy Jacoby.

A. Identify Issues

First, we should identify the issues and analyze the facts. With no difficulty, we should be able to highlight the key facts as below:

1. Bolton owns “A’moe du Chocolat” trademark for chocolates
2. Established since 1950 and advertised internationally
3. Amy Jacoby is selling candies called “A’moe Jay Candies”
4. Similar packaging

B. Formulate legal issue

Second, we should formulate the legal issues presented in the above case. For example, does Amy Jacoby’s conduct constitute trademark infringement? If yes, then are there any defenses available to her?

C. Research

We can consult a treatise for a better understanding regarding trademark law. McCarthy on Trademark and Unfair Competition (MCCARTHY) is an example of a treatise. They are expert in areas of providing advice on protecting trademarks and registration; explain the law in details and give clear analysis on legal cases. Hence, for any researcher on trademark, approaching one of the treatises for research is a very good starting point for research.

¹⁸ See Anurag Acharya, *Finding the Laws That Govern Us*, THE GOOGLE OFFICIAL BLOG, Nov. 18, 2009, <http://googleblog.blogspot.com/2009/11/finding-laws-that-govern-us.html>.

Use the Table of Contents under McCarthy¹⁹ to locate the relevant section. The table serves as a quick reference point of which areas you are trying to look at. It also allows you to further narrow down your research by using the subheadings. From here, we are able to locate the section addressing dilution of trademarks. Researchers are then able to learn about the topic and identify relevant law using footnotes references.

The Lanham Act has often been cited under McCarthy, if you have an on-point statutory citation, you can turn to the USCA database and find the corresponding annotated code for your research.

Once you have a legal issue defined, you can turn to ALR in order to understand how the courts have handled that issue. You can run a keyword search to locate ALR annotations. In constructing such a search, take advantage of the fact that the titles of the reports in the ALR are usually a good description of the subject matter covered. Thus a title search including key terms will retrieve relevant documents without being over broad like an index search. A title search should include a combination of relevant terms grouped by similar topics:

“ti(trademark parody dilution) & infring! & similar /s pack! label”

Then depending on your needs, it gives you the choice of finding relevant cases and closely related materials.²⁰ Remember to check if the materials are up to date, which is extremely important to case-based arguments.

KeyCite the materials you found in your research to make sure they are current and still are good law. By entering the citation, you can quickly link to the relevant content and KeyCite flags allow you to check the status of a section at a glance. Researchers can easily determine whether there are problems with the cases, statutes, or other primary and secondary sources cited.

V. Conclusion

The universe of legal research resources can be a daunting prospect given the specificity of research requirements. Researchers may feel that they are looking for the proverbial ‘needle in the haystack.’ This can be the case when using traditional legal research methodologies using printed law books, treatises and law reports. The challenges involved in cross-referencing all these hard copy resources should not be underestimated. It is surprising then

¹⁹ MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (4th ed.).

²⁰ Westlaw eLearning Center Home Page,
http://www.westlearning.com/rc2/my_catalog.asp?cid=14&pid=0#.

that in the digital age, where the majority of these resources have been included in online legal research services like Westlaw, that some researchers still cling to the comfort blanket and familiarity of hard copy materials.

Online legal research has, as this article has explained, many advantages over traditional legal research methods, including helping to structure your research by providing tools such as Key Numbers and linkages between citations in content to help users quickly transition from source to source and to work through the issues in turn; providing certainty of your results through features like KeyCite, which clearly define the current status of laws, and judicial decisions, and often more critically, speed (the ability to quickly narrow down your search to the resources which contain the results you need).

The overriding benefit for researchers from all the features and functionalities of online legal research services like Westlaw is confidence. Users can be confident that they get comprehensive results, they can be confident that the content is up-to-date, they get the confidence of analytical content that backs up the interpretations they make of the law, and confidence that they can get informed of any important changes after they complete their research which may impact on their conclusions.

In this day and age in the resilient and fast growing markets throughout Asia especially, where the phrase *'time is money'* really does hold true, the advantages of legal research over traditional methods really are hard to ignore.

Cited as:

Bluebook Style: Chloe Lau, *Researching U.S. Intellectual Property Law in the Digital Age: How Online Research on Westlaw Can Enhance Your Results*, 1 NTUT J. of INTELL. PROP. L. & MGMT. 147 (2012).

APA Style: Lau, C. (2012). Researching U.S. intellectual property law in the digital age: How online research on Westlaw can enhance your results. *NTUT Journal of Intellectual Property Law & Management*, 1(1), 147-158.