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2004

### A Guide to U.S. Intellectual Property Searching Online

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#### Recommended Citation

Selby, Jennifer. "A Guide to Intellectual Property Legal Research Online," Mich. B. J. 83, no. 8 (2004): 52-54.

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# A Guide to U.S. Intellectual Property Searching Online

Intellectual property is an umbrella term that refers to patents, trademarks, copyrights, trade secrets, and trade dress, among other “tangible personal property that is created through the intellectual efforts of its creator or creators.”<sup>1</sup>

The advent of online searching capabilities for intellectual property presents mostly great advantages, along with a few disadvantages too. Prior to free internet searching of U.S. patents and trademarks, a searcher would have to travel to either a Patent and Trademark Depository Library (PTDL) or to the U.S. Patent Trademark Office (PTO) in Washington D.C. in order to conduct a basic patent or trademark search.

Today, there are numerous federally sponsored PTDLs throughout the U.S. A PTDL is a “library designated by the U.S. Patent and Trademark Office (PTO) to receive and house copies of U.S. patents and patent and trademark materials, to make them freely available to the public, and to actively disseminate patent and trademark information.”<sup>2</sup> This depository library system began in 1871.

The University of Michigan Art, Architecture and Engineering Library (Duderstadt Center) is a PTDL, along with the Great Lakes Patent and Trademark Center (GLPTC) at the Detroit Public Library. Ferris State University also supports a depository library at the Abigail S. Timme Library.<sup>3</sup> The University of Michigan Duderstadt Center<sup>4</sup> provides assistance with online searching and also holds copies of patents on microfilm. The Detroit Public Library GLPTC,<sup>5</sup> a PTDL since 1871, provides specialized, fee-based research services in addition to help with conducting your own patent and trademark searches online at the PTO website.<sup>6</sup>

The disadvantage to searching intellectual property online, patents in particular, is that the available online databases do not encompass the array and extent of tools needed to

conduct a comprehensive search.<sup>7</sup> Essentially, you can search patents on the web, but you cannot do a true patent search. A complete patentability search must include not only U.S. patents, but foreign patents and all relevant non-patent literature also (all resources together are referred to as “prior art” for an invention).<sup>8</sup> These additional resources can be researched at the Patent Office Library in Washington D.C., and, on a more limited basis, at a local PTDL. The fact that an online search of your invention did not produce any relevant patents, therefore, does not mean that your invention is patentable.<sup>9</sup>

## Patent

Patents grant inventors the sole right to prevent others from making, using, or selling an invention.<sup>10</sup> The federal constitutional basis for this is found in Art. 1, sec. 8, cl. 8: “The Congress shall have Power... to promote the Progress of Science and useful Arts, by securing for Limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”

Congress delegated its authority to grant patents to the PTO, which is part of the Commerce Department. U.S. patent law is found in Title 35 of the *United States Code*, and related regulations in Title 37 of the *Code of Federal Regulation*. A 20-year monopoly gives inventors incentive to create in exchange for new technology that benefits the public. The invention must be novel, useful, and non-obvious.<sup>11</sup>

There are three basic types of patents: utility, design, and plant. Utility patents are any new and useful process, machine, article of manufacture, or compositions of matters,

or any new useful improvement thereof. Design patents cover new, original, and ornamental designs for an article of manufacture. Plant patents include an invention or discovery and asexual reproduction of any distinct and new variety of plant.<sup>12</sup>

Patent applications may now be filed online.<sup>13</sup> However, the process of prosecuting a patent is much more involved than that of trademark and copyright, as prosecution in the PTO of even a simple patent application can take years. Fees for initial filing and continuing prosecution can add up quickly, as patent applications are almost never approved by examiners upon filing.<sup>14</sup>

A U.S. patent body includes an abstract, specification, claims, and drawings. Each allowed patent application is given a patent number and assigned at least one class/subclass. Searchers conduct U.S. patent searches for a variety of reasons, including to determine patentability of an invention and obtain a U.S. patent, build on existing patented ideas to obtain an improvement patent, determine if an invention is infringing or determine the “right to use” of an invention, and simply learn new technologies for one’s own use.

An online search for U.S. patents should begin at the PTO website.<sup>15</sup> Patents are searchable in full-text from 1976–present. It is important to note that patents from 1790–1975 are searchable only by patent number or current U.S. classification number.

A quick search allows you to search by inventor, patent number, keyword, etc., while an advanced search includes field codes. However, “to conduct an actual search for patents efficiently and effectively, you must understand the U.S. Patent Classification

***An online search for U.S. patents should begin at the PTO website.***

System (USPCS).<sup>16</sup> Searchers should use the PTO Manual of Classification,<sup>17</sup> including its index, to identify the primary class and the relevant subclass(es) for the invention. All U.S. patents assigned to that particular class/subclass or topical arrangement are then linked in either full-text or image format. The searcher can then view and download the relevant patents for a comprehensive review of the known technology.

Another online database that includes full-text searchable U.S. patents is *Lexis-Nexis Academic*, which is available on the University of Michigan Network.<sup>18</sup> This database covers full-text drawings of U.S. Patents from 1971–present, classification searching, and the Manual of Classification. There are also several fee-based services, including *Delphion Intellectual Property Network*, where you can freely search, but must pay a fee to download patents.<sup>19</sup> U.S. patents may be searched full-text on *Lexis*, *Westlaw*, and *Dialog*, which are also password, fee-based online databases.

## Trademark

A trademark is a word, phrase, symbol, or design, or a combination thereof, that identifies and distinguishes the source of the goods of one party from those of others, commonly referred to as a brand name.<sup>20</sup> A service mark is the same as a trademark, except that it identifies and distinguishes the source of a service rather than a product.<sup>21</sup> “Trademark” and “mark” generally refer to both trademarks and service marks. The PTO also administers trademarks.

Trademark law is found in Title 15 of the *United States Code*, Section 1051 et seq., the 1946 Trademark Act or “Lanham Act,” and related regulations in Title 37 of the *Code of Federal Regulation*. Trademark rights arise from either filing a proper application to register a mark in the PTO, stating a “bona fide intention” of using the mark in commerce, or by actual use of a mark, known as “common law rights.”<sup>22</sup>

Federal trademark registration requires filing a trademark application with the PTO, including a statement identifying the goods and/or services with which the mark is used or will be used, a clear drawing of the mark you want to register, an application fee (currently \$335), and a specimen that is not the

actual product (such as a tag or label for goods, and a sign or brochure for a service).<sup>23</sup>

It is advisable to conduct a search of existing trademarks before attempting trademark registration in order to save yourself time and money. After filing, a trademark application goes through a legal and procedural review by an examiner, and is published for opposition.<sup>24</sup> Other trademark holders may oppose registration if they believe it to be too similar to a currently used mark. Once the Trademark Office issues a Certificate of Registration, a federal registration then must be maintained. The rights can last indefinitely if the owner continues to use the mark on or in connection with the goods and/or services in the registration, and files all necessary documentation in the PTO at the appropriate times. Federal registration also provides legal presumption of ownership.<sup>25</sup>

Online trademark searching is free on the PTO website in the TESS (Trademark Elec-

tronic Search System) database.<sup>26</sup> This database includes live, dead, and pending federal marks and images, and is current within one month of filing. Fee-based services for trademark searching include *Thomson & Thomson*, *TRADEMARKSCAN*, *Dialog*, *Lexis*, and *Westlaw*. Trademark registrations may also be obtained under state law, and many states have their own free online databases of registered marks.

## Copyright

Copyright is a form of protection provided by the laws of the U.S. to authors of “original works of authorship,” both published and unpublished, including literary, dramatic, musical, artistic, and certain other intellectual works.<sup>27</sup> The U.S. Copyright Office, which is part of the Library of Congress, administers copyrights.<sup>28</sup>

U.S. Copyright Law is found in Title 17 of the *United States Code*, and related regulations

in Title 37 of the *Code of Federal Regulation*. Copyright protection for a work created after January 1, 1978, is automatically protected from the moment of creation and has a term of author's life plus 70 years after the author's death.<sup>29</sup>

Federal copyright registration in general is only a legal formality. In the U.S., a person who creates an original work automatically has a copyright in the work upon creation.<sup>30</sup> Even though registration is not a requirement for protection, copyright owners receive various benefits, such as establishing a public record of the copyright claim and allowing statutory damages and attorney's fees to be available to the copyright owner in court actions.<sup>31</sup>

The process of obtaining a copyright registration includes sending to the Library of Congress a completed application form, a filing fee of \$30, and a non-returnable deposit of the work being registered (for works published after January 1, 1978, you must submit two copies).<sup>32</sup>

Conducting a search of federally registered copyrights may be accomplished by a variety of methods. For a fee, the Copyright Office will conduct a search of registered copyrights for public patrons. Many libraries hold the *Catalog of Copyright Entries*, which

can be searched for registered U.S. copyrights from 1891 to the present.<sup>33</sup> Online searching through the Copyright Office website is limited to either an "experimental search method" ("for short, simple searches and occasional users."), or via the database, LOCIS (Library of Congress Information System).<sup>34</sup> LOCIS is intended for use as a more advanced database, but is an older system and somewhat difficult to use.

In order to have comprehensive protection for an invention or creation, a searcher may have to conduct patent, trademark, and/or copyright searches for a single invention. For example, the need for trademark and copyright protection may overlap, where trademark laws protect a product name and/or slogan, and copyright law protects the creative written expression in an advertisement. Patent and trademark protection may also overlap, such as where patent laws protect a product design (i.e., a design patent for jewelry), and trademark laws protect the same design as a product identifier. ♦

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## FOOTNOTES

1. <http://www.baypatents.com/glossary>.
2. <http://www.uspto.gov/web/offices/ac/ido/ptdl/ptdlgen.htm>.
3. <http://www.ferris.edu/library/patent/homepage.html>.
4. <http://www.lib.umich.edu/ael/division.php?divisionID=15&d=v>.
5. [http://www.detroit.lib.mi.us/glptc/glptc\\_index.htm](http://www.detroit.lib.mi.us/glptc/glptc_index.htm).
6. <http://www.uspto.gov>.
7. Sharpe, Charles C. *Patent, Trademark, and Copyright Searching on the Internet*, 37. North Carolina: McFarland & Company, 2000.
8. *Ibid.*
9. *Ibid.*
10. <http://www.uspto.gov/web/offices/pac/doc/general/whatis.htm>.
11. 35 USC 101-103.
12. Sharpe. *Patent, Trademark, and Copyright Searching on the Internet*, 6-7.
13. <http://www.uspto.gov/ebc/efs/index.html>.
14. <http://www.uspto.gov/main/howtofees.htm>. For example, the application fee for a utility patent is currently \$770 for a large entity or \$385 for small entity.
15. <http://www.uspto.gov/patft/index.html>.
16. Sharpe. *Patent, Trademark, and Copyright Searching on the Internet*, 42.
17. <http://www.uspto.gov/go/classification/>.
18. <http://web.lexis-nexis.com/universe>.
19. <http://www.delphion.com/>.
20. Sharpe. *Patent, Trademark, and Copyright Searching on the Internet*, 68-69.
21. *Ibid.*, 70.
22. *Ibid.*, 73.
23. *Ibid.*, 78-79.
24. *Ibid.*, 82. Marks are published for opposition in the *Official Gazette of the United States Patent and Trademark Office* (OG), which is not available online, but held at depository libraries in paper.
25. *Ibid.*, 73.
26. <http://tess2.uspto.gov/bin/gate.exe?f=tess&state=v4pk3h.1.1>.
27. <http://www.uspto.gov/web/offices/pac/doc/general/whatis.htm>.
28. <http://www.copyright.gov/>.
29. U.S. Copyright Office. *Copyright Basics: Circular 1*, 5. Washington D.C.: U.S. Government Printing Office, 2004. See also: <http://www.copyright.gov/circs/cir1.html>.
30. *Ibid.*, 3.
31. *Ibid.*, 7.
32. *Ibid.*
33. This title is available in paper and microfiche for 1891-1978 at the University of Michigan Graduate Library. See the Graduate Library's online catalog, *Mirlyn*, at: <http://www.lib.umich.edu/mirlyn/mirlynpage.html>.
34. <http://lcweb.loc.gov/copyright/rb.html>.