

## I. Introduction

The foundation of trademark law dates back to the 51st year of the reign of Henry III.<sup>1</sup> In 1266, the *Statutum de Pistoribus* ascribed marks to bread makers, for use in identifying the bakers of loaves.<sup>2</sup> The baker's mark remained the most typical regulatory mark throughout the Middle Ages, and served to form the common law field known as trademarks.<sup>3</sup> Today, trademark law is governed in the United States by the Lanham Act, and internationally directed by the Madrid Protocols.<sup>4</sup> As amended in 1984, the Lanham Act provides that a "trademark" includes any word, name, symbol, or device, or any combination thereof—(1) used by a person, or (2) which a person has a bona fide intention to use in commerce . . . .<sup>5</sup> In short, the former baker's mark now applies to nearly any means a merchant can dream up to identify itself or its product. To the public, trademarks serve to help designate the origin of a particular product or service, ensure a standard of quality, distinguish a good or service from competition, and convey the goodwill of the producer or service provider.<sup>6</sup> To accomplish this, a mark must be distinctive to consumers, that is, it must identify and distinguish the goods or services from those of a competitor.<sup>7</sup> There are four classifications of distinctiveness in trademark law, as defined by the courts. "Arbitrary and fanciful," the strongest classification, signifies that a mark is not descriptive of the product whatsoever, and therefore does not run the risk of confusion.<sup>8</sup> Examples are XEROX and CLOROX. "Suggestive" marks require a leap of imagination to link the name with the product.<sup>9</sup> Examples are FROOT LOOPS and APPLE CRISP. Merely "descriptive" marks, however, cannot be automatically registered on the principle trademark register at the United States Patent and Trademark Office (USPTO).<sup>10</sup> Because they run the risk of confusion, they require a showing of

---

<sup>1</sup> FRANK I. SCHECHTER, *THE HISTORICAL FOUNDATIONS OF THE LAW RELATING TO TRADE-MARK LAW* 49 (The Lawbook Exchange, Ltd. 2004).

<sup>2</sup> *Id.*

<sup>3</sup> *Id.* at 50.

<sup>4</sup> 1 ANNE GILSON LALONDE, *GILSON ON TRADEMARKS* § 1.01 (Matthew Bender 2009).

<sup>5</sup> 15 U.S.C. § 1127.

<sup>6</sup> 1 ANNE GILSON LALONDE, *GILSON ON TRADEMARKS* § 1.03 (Matthew Bender 2009).

<sup>7</sup> *Id.* at § 2.01.

<sup>8</sup> *Id.*

<sup>9</sup> *Id.*

<sup>10</sup> SIEGRUN D. KANE, *KANE ON TRADEMARK LAW: A PRACTITIONER'S GUIDE* § 2.1 (5th ed. 2009). The United States Patent and Trademark Office is a U.S. agency within the Department of Commerce. It is tasked with the management and administration of granting and issuing patents and the registration of trademarks, as well as disseminating this information to the public.

secondary meaning, or establishment of identity within the eyes of consumers.<sup>11</sup> The fatal classification for a trademark is “generic.” If a product brand name comes to be synonymous with the good or service, then it is said to be a “generic” mark, and is thus unenforceable.<sup>12</sup>

The “shrinking world” doctrine of global trade has broadened the scope of trademarks. No longer must a trademark practitioner merely be familiar with federal and state law. As industry routinely does business in national and even global markets, cross-state and international trademark protection becomes more important. This research guide is intended to assist both the trademark practitioner and the novice law student in the research of trademark law. To maximize effectiveness, resources have been sectioned in the order they should be consulted. Not all sections need be accessed, however. Whereas a law student should consult basic trademark law resources in Section II, a trademark practitioner may choose to skip directly to secondary sources in Section III. Or a seasoned U.S. trademark veteran may jump directly to the international resources in Section IX.

Because of the sheer scope of the trademark subject matter, hundreds of resources devoted to its study have followed. It would be improper to attempt to list them all here. Each section begins with comments on the most effective means to identify relevant sources, followed by a sample of the most prevalent sources. Though the search terms may vary depending on the section, one research strategy remains congruent. The researcher can use the sources listed as a seedling for subject headings.<sup>13</sup> By cross-referencing the subject headings of the included sources, the user of this pathfinder can quickly identify additional resources in her own library. In addition, the call numbers of the sources are listed, allowing for a tactile adjacent search within the stacks themselves. The researcher should be aware that, though many trademark resources will be lumped together, they are not all located within the same area. Many libraries display the international trademark law sources in a separate international section. Several sources may live only on microfiche or in electronic format.

Trademark law is effectively still being worked out in the courts. The very dynamic nature of it requires the researcher to be thorough in updating. Many sources take the amorphous

---

<sup>11</sup> *Id.*

<sup>12</sup> *Id.*

<sup>13</sup> Most online library catalogues include subject heading information as a dynamic link, allowing the catalogue user to redefine the search by the heading itself. This will effectively capture all of the resources identified under that subject heading. Because many sources exist within multiple subject headings, cross-reference of those headings will further narrow the search.

complexity of trademark law into account, but even looseleaf secondary sources cannot disseminate updates in real-time. The researcher is encouraged to follow the process laid out in this guide to ensure all sources are up-to-date and complete.

Westlaw and LexisNexis online databases are considered at the end of most sections. Both online resources provide a prepackaged “Trademark” tab. It is recommended that the researcher apply that tab before beginning the research process, as many of the resources listed below will be accessible from that tab.

## II. Getting Started

### A. Research Guides

This pathfinder assumes the researcher has at least a fundamental grasp of advanced legal research. If not, it is suggested that the researcher first review a text on the subject.

1. SPENCER L. SIMONS, TEXAS LEGAL RESEARCH (Carolina Academic Press 2009). [KFT1275.S56]

Though it often focuses on Texas law, this text reduces legal research into its most basic elements, providing a structured path through a seemingly endless body of material. Following the seven-step process laid out in the book will shave countless hours off the research period and, moreover, will help guide the reader to the correct legal solution.

2. ROBERT C. BERRING & ELIZABETH A. EDINGER, FINDING THE LAW (12th ed. Thompson West 2005). [KF240.B45]

Like the *Simons* text, this book marshals readers through court reporters, citators, case finding tools, statutes, legislative history, and secondary authority. Chapter 11 includes a good section on research strategies.

### B. Quick Reference Guide

Brief overviews of trademark law are available in several sources. This allows those not versed in the field to understand the basics.

1. USPTO Basic Trademark Information. [<http://www.uspto.gov/trademarks/basics/index.jsp>]

This page serves as the United States Patent and Trademark Office how-to guide.

2. ABA Basic Trademark Information. [<http://www.abanet.org/intelprop/comm106/106trade.html-wit>]

The American Bar Association has a quick guide on trademark law.

3. ROBERT F. FROHWEIN & GREGORY SCOTT SMITH, THE POCKET IDIOT'S GUIDE TO TRADEMARKS (Alpha 2004). [KF3180.Z9F76]

This 200-page pocket guide touches the surface of most aspects of trademark law. Expect not much more than a few paragraphs on each subject. It is best suited for the small business owner who wants to protect her brand.

### III. Secondary Resources

#### A. Overview

Both the veteran legal practitioner and novice should begin research in secondary sources. Lawyers, judges, academics, and legal specialists have, through secondary sources, attempted to reduce vast areas of law to manageable levels. Several types exist and the researcher will benefit from careful selection. The various types are categorized below. As mentioned in the introduction, the best way to find additional sources in your library is to search on the samples below and reference the subject headings for additional sources. Applicable search terms are included in Appendix A.

#### B. Leading Texts

Texts often concentrate on one narrow area of law. Because they have a stationary publish date, it is necessary to update information accordingly.

1. FRANK I. SCHECHTER, THE HISTORICAL FOUNDATIONS OF THE LAW RELATING TO TRADE-MARK LAW (The Lawbook Exchange, Ltd. 2004). [KF3180.S3]

This text chronicles the dawn of trademark law from personal and proprietary marks in the middle ages through the advent of the cloth and cutlery trades up to the modern statutes.

2. LINDA A. TANCS, UNDERSTANDING TRADEMARK LAW : A BEGINNER'S GUIDE (Oceana 2009). [KF3180.T36]

Focuses on how to register a mark with the USPTO, how to protect and use a mark, how to complete an application, and how to monetize trademark assets.

#### C. Looseleaf Services

These “mini-libraries” venture to cover a vast area of a particular type of law. They are best suited for dynamic legal fields, like trademark law. Because they can be easily updated, they are usually more current than other secondary sources. This is the recommended starting source for trademark practitioners. When selecting search terms, remember that trademarks are sometimes associated with unfair competition. Sources may be in the “trade regulation” section of the library.

1. ANNE GILSON LALONDE, GILSON ON TRADEMARKS (Matthew Bender 2009). [KF3180.G542]

This ten-volume Matthew Bender treatise is published by LexisNexis. Volumes 1–3 consist of analysis of trademark law. Topics range from Trademark subject matter to rights to registration to licensing to litigation. There are two volumes devoted just to forms. Volume 6 contains primary sources, including a decent annotation of the Lanham Act as amended. Volumes 7–10 round out the legislative history, giving the practitioner or researcher a solid grasp of trademark past. This source is available on LexisNexis.

2. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (Thomson Reuters/West 2009). [KF3180.M29]

This seven-volume Thomson Reuters/West treatise is comparable to Gilson on Trademarks. The two operate in a similar manner, though McCarthy is more oriented toward discussion of raw trademark law and general distinctiveness theories, secondary meaning, priority, territoriality, etc. It still contains several forms to assist the practitioner. And McCarthy has an ample volume 7 appendices section, containing rules of practice in front of the USPTO, classifications of goods and services, selected legislative history of the 1988 revision to the Lanham Act, provisions for anti-counterfeiting, and selected examination guides. This source is available on Westlaw.

3. CCH TRADEMARK LAW GUIDE. [KF3178.4.A72]

This is a two-volume set with monthly updates. Authored by Thomas P. Arden, this set includes new legislation and regulations, judicial and agency developments, and a newsletter.<sup>14</sup> It is available on Westlaw, though a table of contents is not available. The user can only search the database, which gets costly.

4. LOUIS ALTMAN & MALLA POLLACK, CALLMAN ON UNFAIR COMPETITION, TRADEMARKS, AND MONOPOLIES (4th ed., West 2010). [KF1609.C33]

This set folds trademarks into overall trade law. Trademark law is located in Volume 3, Part VI. This source is available on Westlaw.

5. Westlaw Online

Westlaw's directory does not browse as easy as LexisNexis. The best way to find treatises in trademark law is to perform a search under the directory, using applicable search terms (see Appendix A).

6. LexisNexis Online

LexisNexis provides a handy directory on its main research page. Under the "secondary legal" section, the user can select one of several secondary treatises, such as Matthew Bender or BNA. From there, select area of law as trademarks or trade materials, accordingly.

## **D. Practitioner Guides**

Practice guides, like looseleaves, manage the dynamic aspects of trademark law well. However, they offer a more practical direction, often focusing on negotiations and litigation, forms and licensing.

1. SIEGRUN D. KANE, KANE ON TRADEMARK LAW: A PRACTITIONER'S GUIDE (5th ed., PLI 2009). [KF3180.K36]

This single-volume treatise is separated into twenty-two chapters and twenty-two appendices. Because this is a practice guide, the first twelve chapters serve as an abbreviated introduction to basic trademark principles, with an focus towards the practicing attorney. Chapters 13 to 22 provide tactical information for areas including negotiations, litigation, enforcement, appeal, *inter partes* proceedings, licensing, and assignments. Likewise, the appendices are geared towards the practicing attorney, including (for reference) several forms, sample illustrations, USPTO fees, and tables for applicable state laws.

2. CHRISTOPHER C. LARKIN & HELEN HILL MINSKER, NAVIGATING TRADEMARK PRACTICE BEFORE THE PTO : FROM FILING THROUGH THE TTAB HEARING (PLI 2006). [KF3181.Z9N292]

The Practising Law Institute (PLI) publishes course handbooks for several of its practitioner courses. This manual is a compilation of presentations given at PLI's annual series on navigating the PTO. Topics vary by year, so the researcher should review the table of contents for applicable issues, keeping in mind that trademark law is still maturing. Because this manual targets practicing experts in the field, it will not be overly beneficial for beginning researchers. It is, however, a good location to gain insight into recent court decisions or administrative law adjustments.

3. ANNE HIARING & LYNN S. FRUCHTER, UNDERSTANDING BASIC TRADEMARK LAW (PLI 2006). [KF3180.Z9U68]

This Practising Law Institute publication is still for practitioners, but delves into more basic aspects of trademark law. It is, perhaps, more oriented to experienced attorneys who are considering expanding their practices into trademark law.

---

<sup>14</sup> The author of this pathfinder was not able to gain full access to this set. Some articles included in this set are located at <http://business.cch.com/informtechnology/news/>.

4. GLENN SPENCER BACAL, HAROLD D. JASTRAM & HOWARD B. BARNABY, TRADEMARK ADMINISTRATION: A GUIDE FOR PARALEGALS, ADMINISTRATORS, AND ATTORNEYS (INTA 2005). [KF3181.T73]

This is the go-to quick reference guide for practicing attorneys in the field of trademark law. Subjects are separated by tab into selection, registration, maintenance, and litigation. Inside each section, the reader will find a brief overview and a list of forms to be used by the practitioner.

5. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (Jerome Gilson & Anne Gilson LaLonde eds., LexisNexis 2004) (TBMP). [KF3180.G5426]  
<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/>

This document contains information required to practice in front of the TTAB. It is organized in a similar manner to federal court rules. It does not modify or amend any existing statutes, rules, or decisional law and, moreover, it is not binding on the TTAB or the USPTO. Because cancellation and opposition proceedings are the two most common types of *inter partes* proceedings before the TTAB, this manual concentrates on those areas.

6. Westlaw and LexisNexis Online

Most of the above treatises are carried in either Westlaw or LexisNexis. Neither have isolated directories for practice guides, so the user will have to rely on a search. However, the search terms “trademark and practice” retrieve most of the sources. In Westlaw, navigate to “Directory > All Databases > Treatises, CLEs and Other Practice Material” and enter the search terms. In LexisNexis,

## **E. Legal Encyclopedias**

Legal Encyclopedias provide brief summaries of a large body of law, often reducing it to “black letter” rules. Encyclopedias often cite directly to case law and/or statutes. Some treatises do this as well. If the researcher begins in a practice guide but then decides she would like to see more case law, she may choose a legal encyclopedia, rather than consulting a more lengthy looseleaf treatise. Certain larger treatises (like Gilson and McCarthy) provide enough case law references that the encyclopedias may not be required, and digests may be used instead. Both Westlaw and LexisNexis provide access to at least one encyclopedia.

1. CORPUS JURIS SECUNDUM (CJS). [KF154.C63]

The trademark section is located in volume 87. A general table of contents is located at the front of the section, followed by a sub-analysis, and a more specific table of contents. CJS intersperses federal and state cases in its annotations.

2. AMERICAN JURISPRUDENCE 2D (Am Jur 2d). [KF154.A5]

The trademark section is located in volume 74. The title page of the section includes a brief summary of the scope as well as citations to other locations trademark law may appear, such as “fair trade, unfair competition, or literary property.” An extensive table of contents follows. This is a West publication, so it contains West key numbers.

## **F. American Law Reports**

A hybrid between encyclopedias and treatises, the ALR gets its own section. The ALR presents thorough research in a narrow area of a particular part of the law. These “annotations” define the issue, cite other secondary sources, and include a table of cases, laws, or rules.

1. AMERICAN LAW REPORTS (ALR). [KF132.6.I52]

Start with the ALR Index complete series. The index will reference the user to several different ALR volumes, depending on the particular subject matter. Most of the trademark references are in the ALR Federal. Each referenced

article covers a narrow area of law and includes an outline, research references, a comprehensive index, and a table of cases, separated by jurisdiction.

## G. Other

### 1. MODEL STATE TRADEMARK BILL. [KF3180.U5]

The International Trademark Association (INTA) was tasked with creating a model bill on trademark law for states. Many states have enacted this bill. Before it is adopted, however, it only serves to be persuasive authority.

### 2. RESTATEMENT (THIRD) OF UNFAIR COMPETITION. [KF395.A2U6435]

Restatements are syntheses of case law, as prepared by the American Law Institute (ALI). Chapter 3 of this volume is devoted to trademark law. Because it is a restatement of the case law, it is only persuasive in authority.

## IV. Statutes

### A. Overview

Though trademark law stems from its origins under common law, it has largely been codified in federal and state statutes. The most prevalent of this is the Lanham Act, which superseded the Trademark Act of 1905. Originally named for Representative Fritz G. Lanham of Texas, the Lanham Act serves to "(a) foster competition by enabling particular business entities to identify their goods or services and to distinguish them from those sold by others; (b) facilitate distribution by indicating that particular products or services emanate from a reliable though often anonymous source; (c) aid consumers in the selection process by denoting a level of quality relating to particular goods or services; (d) symbolize the reputation and good will of the owner, thereby motivating consumers to purchase or avoid certain trademarked products or services; and (e) protect the public from confusion or deception by enabling purchasers to identify and obtain desired goods or services."<sup>15</sup>

### B. Federal Statutes

#### 1. Lanham Act: also known as the Trademark Act of 1946, July 5, 1946, ch. 540, 60 Stat. 427 (15 U.S.C. 1051 *et seq.*) [KF 62.A2 v.8]

The Act is codified in Title 15, Chapter 22 of the United States Code and is separated into four sections.

Subchapter I - The Principal Register - §§ 1051-1072 (Sections 1 to 22)

Subchapter II - The Supplemental Register - §§ 1091-1096 (Sections 23 to 28)

Subchapter III - General Provisions - §§ 1111-1129 (Sections 29 to 45) [note: §§ 1128 & 1129 have no corresponding Lanham Act number]

Subchapter IV - The Madrid Protocol - §§ 1141 (The Madrid Protocol provides a filing system for international trademark registration.)

#### 2. Title 35 of United States Code: Establishment and affairs of the United States Patent and Trademark Office (USPTO). [KF 62.A2 v.20]

The United States Patent and Trademark Office is a U.S. agency within the Department of Commerce. It is tasked with the management and administration of granting and issuing patents and the registration of trademarks, as well as disseminating this information to the public. 35 U.S.C. §§ 1-2. Further sections of title 35 provide applicable dates and filing processes at the USPTO. *See also* 6 GILSON ON TRADEMARKS app. 2 (2009), *infra*.

---

<sup>15</sup> A.J. Canfield Co. v. Honickman, 808 F.2d 291, 304 (3rd. Cir. 1986) (quoting S. Rep. at 2, U.S. CODE CONG. & ADMIN. NEWS 1984, at 5718, 5719).

### 3. Code References

#### 3(a). UNITED STATES CODE ANNOTATED (USCA). [KF62.U5]

This is a Westlaw publication of the United States Code with research aids. It cites to cases that reference or interpret the code, complete with Westlaw's key service. The U.S.C.A is generally thought of to be more comprehensive as compared to the U.S.C.S selectivity (see below).

#### 3(b). UNITED STATES CODE SERVICE (USCS). [KF62.U6]

This is the LexisNexis annotations of the U.S. Code. Similar to the U.S.C.A., though thought to be more selective. It also includes references to LexisNexis secondary sources, using the Lexis headnotes system. U.S.C.S. also includes some references to non-U.S.C. materials that aren't found in the U.S.C.A.

#### 3(c). Bitlaw Legal Resource. [<http://www.bitlaw.com/source/15usc/index.html>]

Bitlaw is a general purpose intellectual property website operated by a patent attorney. It's mostly a good quick reference (see Section II) but it also carries a full reproduction of the Lanham Act (last updated in October of 2005), complete with a keyword index (<http://www.bitlaw.com/source/15usc/wordindex.html>). The keyword index was created off a previous version of the Lanham Act, but still serves as a handy guide to the statute.

#### 3(d). Legal Information Institute at Cornell University.

[[http://www.law.cornell.edu/uscode/html/uscode15/usc\\_sup\\_01\\_15\\_10\\_22.html](http://www.law.cornell.edu/uscode/html/uscode15/usc_sup_01_15_10_22.html)]

Cornell University provides web access to nearly all U.S. Code. All statutes are updated regularly and the website contains a classification table for all statutes, which tells not only the date the source was updated, but also which section was updated by session year as well the public law number and the statutes at large volume and page number. It is a handy resource in a pinch when a researcher doesn't have access to an official source of the code.

#### 3(e). U.S. TRADEMARK LAW: RULES OF PRACTICE AND FEDERAL STATUTES (USPTO 2009).

[<http://www.uspto.gov/web/offices/tac/tmlaw2.pdf>]

The USPTO puts out a publication on rules of practice (see Section VIII(b)). This document contains an appendix with a full reproduction of the Lanham Act as amended and the applicable title 35 statutes.

## **C. Federal U.S. Congressional Session Laws**

Because statutes are codified only every six years (or annually in the annotated statute services), it may be necessary to check for recent statutes passed by Congress.

### 1. UNITED STATUTES AT LARGE. [KF50.A2]

The Statutes at Large reports a full reproduction of every public law passed by Congress, in order. Thus, it is not easy to find trademark updates. A better reference is THOMAS.

### 2. THOMAS Website: Library of Congress. [<http://thomas.loc.gov/>]

The easiest way to search for trademark law updates on the THOMAS website is to use the "word search" under the bill summary status field. However, if the researcher is searching for trademark law in a specific area, she can use the "advanced search," which allows search by particular house or senate committees.

### 3. HEIN Online. [<http://www.heinonline.org/>]

Hein Online reproduces the entire statutes at large from 1789 through 2007. More importantly, it allows the researcher to browse by volume, public law number, or popular name. A browse on trademarks returns the Trademark Act of 1946 plus six additional acts dealing with trademarks.

#### 4. U.S. CODE CONGRESSIONAL AND ADMINISTRATIVE NEWS (West). [KF63.U5]

The first section in this monthly publication is dedicated to Public Laws.

### **D. Proposed Bills and Pending Legislation**

Merely relying on codified statutes can get a researcher in trouble. It is important to consider recent legislation that has not been codified yet, and even proposed bills that haven't left the floor.

#### 1. THOMAS Website: Library of Congress. [<http://thomas.loc.gov/>]

A THOMAS word search returns items of pending legislation. However, bear in mind that the search engine is rather primitive and really only accepts broad searches. For example, a search for "trademark" brings up proposed legislation to amend title 35 for patent reform. But a search for "trademark 35" returns nothing, while a search of "trademark & 35" returns everything.

#### 2. BNA'S PATENT, TRADEMARK & COPYRIGHT JOURNAL (BNA). [KF3091.A3] [<http://news.bna.com/ptln>] (Subscription)

The Bureau of National Affairs (BNA) provides a handy legislation table of pending and enacted intellectual property legislation by Congress session. It is not broken down by type of intellectual property, but it does provide a summary and status field that allows for quick inspection of the subject. Moreover, the researcher can use the "finding tools" section to browse indexes by topic. Indexes can also be searched. Results show not only the pending legislation per subject, but also the current stage of the legislation and a cross reference to other areas of the index that may be useful. The online indices go back to May 2003.

#### 3. CCH TRADEMARK LAW GUIDE. [KF3178.4.A72]

This is a two-volume set with monthly updates. Authored by Thomas P. Arden, this set includes new legislation and regulations, judicial and agency developments, and a newsletter.<sup>16</sup> It is available on Westlaw, though a table of contents is not available. The user can only search the database, which gets costly.

### **E. Legislative Histories**

Courts often consider the intent of Congress in statutory interpretation. The researcher must have a full command of how a law came into being. For trademark law, there are a few sources that compile tailored legislative history.

#### 1. ANNE GILSON LALONDE, GILSON ON TRADEMARKS (Matthew Bender 2009). [KF3180.G542]

Volumes 7–10 are devoted to legislative history, compiled for trademark law.

#### 2. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (Thomson Reuters/West 2009). [KF3180.M29]

Appendices A5 and A6 contain selected legislative histories of the 1988 Trademark Law Revision Act.

#### 3. U.S. CODE CONGRESSIONAL AND ADMINISTRATIVE NEWS. [KF63.U5]

This contains the most comprehensive legislative history of public laws. The publication is separated by congressional session number and generally follows about one year behind the current session.

#### 4. LexisNexis Congressional. [<http://web.lexis-nexis.com/congcomp>] (Subscription)

<sup>16</sup> The author of this pathfinder was not able to gain full access to this set. Some articles included in this set are located at <http://business.cch.com/informtechnology/news/>.

LexisNexis Congressional provides a simple word search of all materials as well as an advanced search. Returns are organized into committee prints, hearing transcripts, legislative history, reports, and digital collections. The advanced search gives the researcher the ability to search within several congressional databases, restrict by date or congress session, and provides several field restrictors.

#### 5. THOMAS Website: Library of Congress. [<http://thomas.loc.gov/>]

THOMAS can provide legislative history, however, it's best to enter THOMAS with a bill number in hand. Word search typically just draws from the most recent pending legislation.

#### 6. GPO Access Website. [<http://www.gpoaccess.gov/>]

The GPO Access website is a tremendous repository of legislative material, including not only full reproductions of the U.S. Code (including limited annotations), but also a bill history search engine [<http://www.gpoaccess.gov/hob/index.html>]. The search field allows the researcher to enter a public law number, house report number, section number, or even the popular name of an act or bill.

#### 7. CONGRESSIONAL INFORMATION SERVICE INDEX (CIS). [KF49.C62]

CIS is separated into two volumes per year, abstracts and index, both of which reference accompanied microfiche documents. The abstracts volume is further organized by house committee publications, joint committee publications, senate committee publications, and legislative histories. The CIS claims to cover the full body of information derived from the committees and subcommittees of Congress, including hearings, reports, committee prints, and even house/senate documents and special publications. The CIS publishes updates monthly and then accumulates the index yearly. The CIS Annual contains more than the monthly publications, including brief descriptions and legislative histories, guides to multi-volume hearings, and additional bibliographic information. Part Two of the Annual contains the indexes by subjects and names; bill, report, and document numbers; the aforementioned guides to multi-volume hearings; and a list of committee and subcommittee chairmen. The CIS can be an effective alternative to the LexisNexis Congressional database, however, it is usually on microfiche and organized by year, so it doesn't allow the cross-year search like LexisNexis. This database goes back to at least 1970.

#### 8. HEIN Online. [<http://www.heinonline.org/>](Subscription)

Hein Online contains a Federal Legislative History Library, organized by congressional session. A researcher can browse by session or by public law. The public law search is organized alphabetically by popular act name, making it easy to find the Trademark Law Revision Act of 1988, for example. However, a researcher cannot search the database.

#### 9. NANCY P. JOHNSON, SOURCES OF COMPILED LEGISLATIVE HISTORIES (Fred B. Rothman & Co. 2007). [KF42.2 1979]

This looseleaf reference contains a public law index in the back that will give the researcher the public law number of an act. So, for example, the Trademark Registration Act is law number 79-489. In the main body of the reference, the public law number cross-references the statute number and a secondary reference for more information. For the Trademark Registration Act, the secondary reference is a two-volume set by J. Thomas McCarthy (see above).

#### 10. BERNARD D. REAMS, JR., FEDERAL LEGISLATIVE HISTORIES: AN ANNOTATED BIBLIOGRAPHY AND INDEX TO OFFICIALLY PUBLISHED SOURCES (Greenwood Press 1994). [KF42.2]

This text is an annotated bibliography, describing 255 legislative histories from the 37th Congress (though it covers public laws beginning with the 4th Congress) through the 101st Congress (1862 – 1990). It includes five indices for access. The indices are compiled by public law, Congressional session number, and bill number.

#### 11. Westlaw

Westlaw provides a legislative history database for U.S. Code from 1948 to present. This will capture all amendments to the Lanham Act, but not the Lanham Act itself, which was promulgated in 1946. This works like bill tracking on THOMAS.

## 12. LexisNexis

LexisNexis has a selection within the Trademark tab entitled "Congressional Bills and Bill Tracking - Current Congress". Lexis' version allows for search terms.

# **V. Administrative Law**

## **A. Existing Regulations**

Trademark regulations are located in Title 37 of the Code of Federal Regulations, Chapter 1.

### 1. CODE OF FEDERAL REGULATIONS. [KF70.A3]

Published by the Office of the Federal Register, the C.F.R. contains a brief explanation of the document, the title, and a number of finding aids, including a table of C.F.R. titles and chapters, an alphabetical list of agencies, and a list of C.F.R sections affected by the current publication (and, for Title 37, all the way back to 2001).

### 2. CODE OF FEDERAL REGULATIONS, ANNOTATED (West 2007). [KF2974.599]

West publishes an annotated version of Title 37 of the C.F.R., although, according to WorldCat, only four libraries in the country carry it. This database was not found on Westlaw.

### 3. HEIN Online. [<http://www.heinonline.org/>] (Subscription)

Hein Online scans in the Code of Federal Regulations as published by the Office of the Federal Register (see above). Hein is the best location to find previous versions of the C.F.R. Their database carries scanned Postscript Data Files all the way back to 1938. Text within the PDFs are not searchable.

### 4. GPO Access Website. [<http://www.gpoaccess.gov/>]

The Government Printing Office reproduces the latest version of the entire Code of Federal Regulations.

### 5. U.S. TRADEMARK LAW: RULES OF PRACTICE AND FEDERAL STATUTES (USPTO 2009). [<http://www.uspto.gov/web/offices/tac/tmlaw2.pdf>]

37 C.F.R. parts 2, 3, 6, 7 10, and 11 are reproduced in this online PDF document. Note: the version from the Office of the Federal Register sometimes groups certain parts in separate sections. This official document from the USPTO puts most relevant parts together for ease of browsing.

## 6. Legal Information Institute at Cornell University. [<http://www.law.cornell.edu/cfr/cfr.php>]

Cornell University merely provides links to the GPO Access website.

## 7. LexisNexis

Lexis attached a reference to title 37 of the C.F.R. on the Trademark tab.

## 8. Westlaw

Westlaw is not intuitive in searches for regulations. From the directory, navigate to "All Databases > U.S. Federal Materials > Administrative Rules & Regulations > Code of Federal Regulations." This provides yet another costly Westlaw search engine. A search for "trademark" returns over 2000 hits.

## **B. Pending/Proposed Regulations**

### 1. Federal Register

To update the C.F.R., the researcher will need to review the Federal Register for updates. The most efficient way to do this is to pull the latest List of C.F.R. Sections Affected (LSA) [KF70.A3] (updated monthly) that will be located immediately after the C.F.R. Review Title 37 for any updates. Then pull the most recent Federal Register volume number [KF70.A2] (updated daily). Page "i" in the back will list the C.F.R. parts affected in that month. Review that month for any updates to the regulation in question. GPO Access allows the researcher to perform this review online.

### 2. GPO Access Website. [<http://www.gpoaccess.gov/fr/index.html>]

GPO Access provides an online finding tool for proposed and recently promulgated regulations. The HTML or PDF result directly mirrors the text in the Federal Register. Remember to use quotations on the GPO Access website search field.

### 3. HEIN Online. [<http://www.heinonline.org/>] (Subscription)

Hein Online reproduces the Federal Register in full. More importantly, it is more current than in most libraries, by about two to three weeks.

### 4. BNA'S PATENT, TRADEMARK & COPYRIGHT JOURNAL (BNA). [KF3091.A3] [<http://news.bna.com/ptln>] (Subscription)

The Bureau of National Affairs provides a regulatory table intended for pending regulation. At the time of the creation of this pathfinder, the table was empty, so a review cannot be penned. Mostly likely, the table will be similar to the legislation table (see Section IV.C above). The "finding tools" section allows for browsing of trademark subjects. Results typically bring up articles by practicing attorneys; many of the articles review new pending legislation.

### 5. CCH TRADEMARK LAW GUIDE (CCH). [KF3178.4.A72]

This is a two-volume set with monthly updates. This set includes new legislation and regulations, judicial and agency developments, and a newsletter.<sup>17</sup> It is available on Westlaw, though a table of contents is not available. The user can only search the database, which gets costly.

---

<sup>17</sup> The author of this pathfinder was not able to gain full access to this set. Some articles included in this set are located at <http://business.cch.com/informtechnology/news/>.

6. USPTO Rulemaking Webpage. [<http://www.uspto.gov/trademarks/law/rules.jsp>], [[http://www.uspto.gov/news/fedreg/fr\\_2010.jsp](http://www.uspto.gov/news/fedreg/fr_2010.jsp)]

The USPTO publishes federal register notices on changes to the rules. Present and past rule proposals are posted on the site.

## VI. Federal Case Law and Judicial Opinions

### A. Digests and Restricted Reporters

#### 1. Allen's Trademark Digest (Aspen) (Available electronically on proquest) [Subscription Required]

This monthly digest organizes and classifies both published and unpublished slip copy decisions from the Trademark Trial and Appeal Board (TTAB) and the Trademark Commissioner. The digest provides a quick scan index along the left hand side for fast reference to particular areas of trademark law. Each summary of a decision is marked by a proprietary classification number that appears at the beginning of the summary. Graphical representations of marks are reproduced for many of the summaries. The digest groups classifications of marks to show current adversarial nature, in an almost boxing card format. For example, if a practitioner represents a tailor, she may scan for "suits" and find that suits are up against leather and imitations of leather goods this issue, see code F-402. Further examples are cheese v. pasta sauce or phonetical bouts, like Zeno v. Xenon. Part III contains petition decisions in a tabular form, allowing the practitioner to quickly review the status of important appeals.

#### 2. UNITED STATES PATENTS QUARTERLY (BNA). [KF2975.A2U54]

This quarterly reporter specializes in intellectual property cases, including patents, copyrights, trademarks, and trade secrets, from 1913 to the present. It is published by the Bureau of National Affairs and reports case law from the United States Supreme Court, courts of appeal, United States Court of Federal Claims, and United States Court of Customs and Patent Appeals. There is a decent classification system for locating opinions on a specific topic.

#### 3. CCH TRADEMARK LAW GUIDE (CCH). [KF3178.4.A72]

This is a two-volume set with monthly updates. This set includes new legislation and regulations, judicial and agency developments, and a newsletter. Notices of cases in the U.S. Supreme Court docket are provided, as well as some full text decisions from federal and state courts.<sup>18</sup> It is available on Westlaw, though a table of contents is not available. The user can only search the database, which gets costly.

#### 4. PRODUCTS COMPARISON MANUAL FOR TRADEMARK USERS (Francis Pinckney & David Higgins eds., BNA Books 2008). [KF3178.2.P56]

This set cites cases covered in the United States Patents Quarterly volumes 1–231 (1929 – 1986), and the Quarterly 2d volumes 1 – 80 (1987 – 2006), and the USPTO Official Gazette.

#### 5. WEST'S GENERAL DIGEST 12TH SERIES (West). [KF141.W481]

This general digest is published by year. Subjects are organized alphabetically, though there is an accompanied cumulative descriptive word index.

#### 6. ELEVENTH DECENNIAL DIGEST (West 2008). [KF141 11th]

This cumulative digest covers 2004 through 2007 cases. The trademark section is located in volume 52.

---

<sup>18</sup> The author of this pathfinder was not able to gain full access to this set. Some articles included in this set are located at <http://business.cch.com/informtechnology/news/>.

## 7. ALR DIGEST (ALR). [KF132.1.A45]

The trademark section is embedded in the trade regulation section in volume 19. Note: this series only covers cases in American Law Reports.

## **B. Federal Court Reporters**

It is assumed that the researcher is acquainted with reporters. However, Cornell provides a good resource for some free online case law.

### 1. Cornell Legal Information Institute. [<http://www.law.cornell.edu/federal/opinions.html>]

Cornell has organized links to all federal circuit home pages, where federal court opinions are available free of charge. However, some of the links are no longer active, and the search value is dependent on the particular circuit. The Fifth Circuit, for example, contains all opinions since 1992, but only accepts exact entry of the case name in the search engine.

### 2. Westlaw and LexisNexis

Naturally case law research is where Westlaw and LexisNexis really shine. If the researcher has access to one of these sites and the budget, she should take care to update using the applicable citators. Remember to check the direct history and look for negative treatment. Analyze the precedential value and the potential effect on the case at bar.

## **C. Administrative Law Judge Cases**

The USPTO houses the Trademark Trial and Appeal Board (TTAB), which hears appeals from denials of marks by USPTO examiners. The TTAB also presides over opposition hearings and *inter partes* proceedings. Judges of the TTAB are appointed by the United States Secretary of Commerce.

### 1. Final Decisions of the Trademark Trial and Appeal Board. [<http://des.uspto.gov/Foia/TTABReadingRoom.jsp>]

This is the USPTO e-FOIA (Electronic Freedom of Information Act) page, which allows free public searches of decisions from the Trademark Trial and Appeal Board (TTAB). The search engine employs powerful, yet complicated identifiers and operators, making a search difficult for the novice. Subject searches are extremely slow. There is a instantiated selection for decisions within the last 30 days. This selection retrieves a table showing the decision date, party names, issue, decision, and whether it is citable as precedent.

## **VII. Journals and Periodicals**

Technically a secondary source, periodicals typically go very deep into a narrow topic of law. The author of this pathfinder chose to break periodicals out from the Secondary Sources section because, in trademark law, it is helpful to have a handle on the case law and regulations before considering the complex topics usually reserved for journals. Periodical indexes provide the best means for finding particular articles, however, trademark journals of note are listed below.

### **A. Trademark and Intellectual Property Publications**

#### 1. HEIN Online Intellectual Property Law Journal Library. [<http://heinonline.org/HOL/Index?collection=spcola>]

There are several Law Journals that are either devoted to intellectual property matters or carry several articles related to IP issues. Hein Online has catalogued these journals into its online directory.

## 2. INTA Trademark Reporter (INTA). [K24.R33]

[\[http://www.inta.org/index.php?option=com\\_trademarkreporter&getcontent=1&Itemid=50\]](http://www.inta.org/index.php?option=com_trademarkreporter&getcontent=1&Itemid=50)

The INTA publishes a yearly 1400-page journal reviewing the status of trademark law since the passage of the 1946 Lanham Act. Topics include *Ex Parte* and *Inter Parte* cases, infringement, circuit rulings, counterfeiting, and defenses, among others.

## 3. BNA'S PATENT, TRADEMARK & COPYRIGHT JOURNAL (BNA). [KF3091.A3]

[\[http://news.bna.com/ptln\]](http://news.bna.com/ptln) (Subscription)

The Bureau of National Affairs Journal provides a daily publication of latest news. Highlights in intellectual property are listed at the top, followed by current news and events. To find journal articles, the advanced search is particularly helpful. Arranged in likeness to the Westlaw search interface, it allows the user to attach terms with operators, limit by field, and limit by date. A table of contents is attached to the Daily so the researcher can quickly review any new occurrences in a specific area of intellectual property (such as trademarks). The online version makes this table of contents linkable to the article or reference. Finally, a table of cases rounds out the Daily. Though there is not a short summary under the table of cases, the link takes the researcher not to the case, but to a full case note and review of the case.

## 4. AIPLA QUARTERLY JOURNAL (AIPLA). [K1.M447]

The American Intellectual Property Law Association publishes a quarterly journal devoted to matters of intellectual property. All members of AIPLA receive this journal, and it is carried at many law libraries.

## 5. TEXAS INTELLECTUAL PROPERTY LAW JOURNAL (U. Texas Law School). [K26.T36435]

Founded in 1993, the Texas IP Law Journal includes a section on recent developments. The journal also ends each issue with State Bar Section news.

## **B. Journal Indexes**

### 1. LegalTrac [Online Subscription Required]

LegalTrac is an index for legal periodicals, currently indexing over 1.5 million articles. LegalTrac provides a powerful search engine to quickly find relevant material. The best method to engage the search engine is through the advanced search. Bear in mind that the engine is calibrated to find articles, rather than periodicals. A researcher can search on publication title, but the engine will return articles, rather than publications. But LegalTrac offers the ability to browse by subject and publication. However, because it covers so many periodicals, the user may have to click through several pages to get to the sought after subject. Trademark Reporter, for example, is six pages into the browse list. LegalTrac's subject search is tremendously powerful. The trademark section is broken down in several subdivisions and returns excellent articles on the subject matter.

### 2. INDEX TO LEGAL PERIODICALS (The H.W. Wilson Co.). [K33.A55]

This set indexes by periodicals, subject, and author. It also gives a table of cases. The older issues (the University of Houston set goes back to 1926) had a separate section for author indexes, though the more recent issues have combined the subject and author indexes. Many libraries no longer carry this set in print, as LegalTrac has superseded it.

### 3. Legal Scholarship Network. [Online Subscription Required]

The Legal Scholarship Network is available through the Social Science Research Network (SSRN). In essence, it is a repository for academics to pre-publish their articles during authorship. Authors can elicit reviews and commentary on their articles as well as stack a claim on the subject. The search engine allows for search on both title only and title and keywords.

#### 4. Westlaw

Westlaw is an excellent source for journals and periodicals, housing a massive repository. Westlaw's powerful search engine is perhaps the best finding tool for legal periodicals, as well. The "law school" tab is an excellent resource for finding journals, periodicals, and news publications.

#### 5. LexisNexis

Lexis' "trademark" tab contains a database for trademark oriented law reviews and journals. More sources may be selected to broaden the search parameters.

### **VIII. Administrative Office Materials**

The United State Patent and Trademark Office is a tremendous resource for both the trademark practitioner and the layperson. On top of manuals and other helpful publications, the USPTO maintains a website with several search engines and instant resources.

#### **A. Finding Tools**

##### 1. Trademark Electronic Search System (TESS). [<http://www.uspto.gov/ebc/tess/index.html>]

TESS provides public access to the full trademark application and registration database maintained by the USPTO. The database includes only federal trademarks that have been registered or are currently pending, or have been abandoned, canceled, or expired. No state, foreign, or common law trademarks are found in TESS. TESS allows for search of designs using its Design Search Code Manual [<http://tess2.uspto.gov/tmdb/dscm/index.htm>]. Images are classified by category. However, given the sheer number of possible categories, this manual is paramount to a successful and thorough search. The manual describes the general guidelines and how to properly code an image into the classifications.

##### 2. USPTO Public Search Facility. [<http://www.uspto.gov/products/library/search/index.jsp>]

The USPTO houses a trademark search library at its Alexandria facility in Virginia.

##### 3. INDEX OF TRADEMARKS ISSUED FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO) (1975 -) [T223.V4 A]

Trademarks prosecuted in a given year are listed by owner name.

#### **B. Manuals**

##### 1. TRADEMARK MANUAL OF EXAMINING PROCEDURES (6th ed., USPTO 2009) (TMEP) [KF3181.A329U55] [<http://tess2.uspto.gov/tmdb/tmep/>]

The TMEP is the comprehensive documents for prosecution of trademarks in front of the USPTO. Though its main purpose is to disseminate filing protocols, the TMEP contains several resources on trademark law and treaties, including a reproduction of the Madrid Protocol and a table of decisions.

##### 2. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (Jerome Gilson & Anne Gilson LaLonde eds., LexisNexis 2004) (TBMP) [KF3180.G5426] [<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/>]

This document contains information required to practice in front of the TTAB. It is organized in a similar manner to federal court rules. It does not modify or amend any existing statutes, rules, or decisional law and, moreover, it is not

binding on the TTAB or the USPTO. Because cancellation and opposition proceedings are the two most common types of *inter partes* proceedings before the TTAB, this manual concentrates on those areas.

**3. U.S. TRADEMARK LAW: RULES OF PRACTICE AND FEDERAL STATUTES (USPTO, 2009):**  
[\[http://www.uspto.gov/web/offices/tac/tmlaw2.pdf\]](http://www.uspto.gov/web/offices/tac/tmlaw2.pdf)

The USPTO puts out a publication on rules of practice within the Office itself.

## **C. Forms**

The USPTO provides a full repository of forms for use within its Offices. Several treatises offer reproductions of these forms as well (see Sections III.B and III.C), however, the USPTO has almost fully transitioned to an electronic system. The online submission center (see TEAS in Section VIII.D below) allows for quick processing and filing dates.

**1. Trademark and application forms site.** [\[http://www.uspto.gov/forms/index.jsp - TM\]](http://www.uspto.gov/forms/index.jsp - TM)

The forms on this site are coded into a proprietary USPTO number system. Use the TMEP or a secondary source to determine which form is required.

## **D. Applications**

**1. Trademark Electronic Application System (TEAS).** [\[http://www.uspto.gov/teas/e-TEAS/index.html\]](http://www.uspto.gov/teas/e-TEAS/index.html)

The TEAS allows a prosecutor to submit nearly all forms online and obtain a near instant filing date. The forms contain an online entry format, though they attempt to replicate the paper forms somewhat. Generally, there is a time limit enforced by the website (it can be extended). Tutorial and FAQs links are located at the bottom of the TEAS home page. The USPTO is trying to encapsulate all forms electronically, but has yet to do so. For example, the Madrid Protocol still requires paper forms.

## **E. Fees**

**1. USPTO Fee Schedule.** [\[http://www.uspto.gov/main/howtofees.htm\]](http://www.uspto.gov/main/howtofees.htm)

The USPTO does not often amend fees, however, filing an application with the incorrect fee can sometimes be fatal. So it is best to check the current fee schedule before every application.

## **IX. International Research Tools**

The very nature of trademarks encapsulates foreign and international law, as companies compete to protect their brands in a global market. As a result, several international outlets exist for foreign trademark research. In the interest of brevity, only a few generic portals will be listed. More information on foreign and international research can be found at librarian Saskia Mehlhorn's website at [\[http://uhlcsaskia.pbworks.com/Foreign-and-International-Law-Research\]](http://uhlcsaskia.pbworks.com/Foreign-and-International-Law-Research).

### **A. Secondary Sources - Foreign Trademark Law Treatises and Looseleaf Guides**

Because of trademark law's profound applicability in the field of foreign and international law, there are several treatises and looseleaves devoted to the subject. These guides are the quickest way to gain insight into the localized laws and trademark practices of particular jurisdictions. A select few are addressed below.

1. JOHN R. OLSEN & SPYROS M. MANIATIS, TRADE MARKS: WORLD LAW AND PRACTICE (Thompson 2009). [K1555.T73]

Sweet & Maxwell's looseleaf guide to world trademark law is essentially a digest, laid out by country, covering country data, international conventions by jurisdiction, applicable trademark legislation, and other local legislation that may impact trademark prosecution in that country. See the "How to Use this Manual" in one of the front tabs.

2. ETHAN HORWITZ, WORLD TRADEMARK LAW AND PRACTICE (LexisNexis 2009). [K1555.4.H67]

This five-volume treatise is also laid out by country, though it goes much more in depth than the *Olsen* looseleaf above. Each country section contains several chapters that explain applications for filing, prosecution procedures, issues of registrability, renewal and post-registration issues, cancellations, infringement, and licensing. For each foreign state, Horwitz provides a handy checklist for filing. Sources are listed throughout the treatise, allowing additional references. This treatise is the most comprehensive of the ones listed here.

3. ANNE-LAURE COVIN, TRADEMARKS THROUGHOUT THE WORLD (4th ed., Thompson West 2006). [K1555.4.T7]

Also laid out by country, this treatise is basically an abbreviated version of the *Horwitz* guide (above). It covers much of the same information, but does not list sources of law, making it difficult to track down applicable statutes.

4. THE MADRID PROTOCOL: HOW IT WORKS & ITS IMPACT ON U.S. TRADEMARK PRACTICE (Nadine H. Jacobson ed., PLI 2003). [KF3180.Z9M33]

This Practicing Law Institute (PLI) course handbook contains presentations from a conference on the Madrid Protocol. PLI conferences are intended for legal practitioners and other professionals.

## **B. Treaties**

Treaties control international and much of foreign trademark law. It is important for the trademark attorney to consider the global aspects of the mark, from the beginning of the registration process. Perhaps the best way to get an overview of which treaties may apply is to review the *Olsen* treatise (listed above). At the beginning of each country is a list of international conventions. The attorney can quickly get an idea of which treaties are the most prevalent. A researcher can also look at the WIPO statistical website below for a comprehensive table of which conventions apply to each foreign state.

1. WIPO Trademark Treaties. [<http://www.wipo.int/trademarks/en/treaties.html>]

The WIPO site on treaties offers not only the full text of applicable treaties that deal with trademark law, but the site also contains statistical information on member countries, ratifications, applicability, etc. Model trademark law treaty forms are also provided.

2. INTERNATIONAL ENCYCLOPEDIA OF INTELLECTUAL PROPERTY TREATIES (A. Ilardi & M. Blakeney eds., Oxford 2004). [K1401.A35I428]

There are countless texts on intellectual property treaties. This encyclopedia is one of the most comprehensive. Part II-D deals exclusively with trademarks, organized by treaty and subsequent protocols.

3. Hein Online Treaties and Agreements Library. (Subscription) [<http://www.heinonline.org/HOL/Index?collection=ustreaties>]

Hein online provides a tremendous library of treaty references. Hein allows the user to search within the references themselves by clicking on the reference and selecting the "Search Treaties and Agreements Library" at the top. The user can search by text, title, date, and description.

#### 4. United Nations Treaty Series. [<http://treaties.un.org/>] (Subscription)

After finding applicable treaties for trademark law, the researcher should update by searching for pending treaty conferences. The U.N. is the best source for this, and the U.N. Treaty Collection website lists applicable and pending conferences. This website is difficult to navigate and there is no search engine. The U.N. publishes a cumulative index that is offered in both chronological and alphabetical order. This index is cumbersome, however, because it lists treaties by country to country.

### **C. International Law Portals**

#### 1. American Society of International Law. [<http://www.asil.org/electronic-resources.cfm>]

Founded in 1906, the ASIL is a nonprofit, nonpartisan educational organization devoted to the research of international and foreign law. It's 4000+ members hail from over 100 countries. From the main website, the researcher should navigate to the research tab and then to the electronic resources sub-tab.

#### 2. Global Lex (Hauser Global Law School Program). [<http://nyulawglobal.org/globalex/>]

NYU Law has collated one of the largest repositories of online research databases. Global Lex is an excellent portal to hundreds of research sites. Online databases are separated into International Law Research, Comparative Law Research, Foreign Law Research (organized by country), and Tools for Building Collections. Upon selection of an area of interest, Global Lex forwards the user not to another database, but to a research guide, or specific pathfinder, directed to that subject. For trademark law, pay particular attention to the Madrid Protocol link and the TRIPS link, both under International Law Research.

#### 3. Electronic Information System for International Law (EISIL). [<http://www.eisil.org/>]

EISIL is actually a sub-portal from the ASIL website. It is powerful enough, however, to merit its own mention here. The portal encompasses a broad set of categories. Trademark law is located under International Economic Law - Intellectual Property Rights.

### **D. International Law Organizations**

#### 1. World Trade Organization (WTO). [<http://www.wto.org/>]

The WTO is a massive repository of information. It can be overwhelming at first, though the search engine works well. Links to trademark law can be found under Trade Topics/Intellectual Property. This is the TRIPS Gateway: [[http://www.wto.org/english/tratop\\_e/trips\\_e/trips\\_e.htm](http://www.wto.org/english/tratop_e/trips_e/trips_e.htm)].

#### 2. United Nations Commission on International Trade Law (UNCITRAL). [<http://www.uncitral.org/>]

UNCITRAL houses an online library and case law research database. Directions on the website itself recommend using a targeted descriptor (see recommended search terms in Appendix A. UNCITRAL also offers a case law research portal [[http://www.uncitral.org/uncitral/en/case\\_law.html](http://www.uncitral.org/uncitral/en/case_law.html)] with an applicable search engine.

#### 3. Organisation for Economic Co-Operation and Development (OECD). [<http://www.oecd.org/>]

The OECD site lends itself more to economic indicators and statistics than international law. The table of contents along the left side of the homepage proves to be the best way to navigate the site. It is strong on browsing, though the search engine does return some information specific to trademark indicators.

## E. Foreign Trademark Law Website Databases

### 1. Organization of American State's Foreign Trade Information System (SICE): Intellectual Property Rights. [[http://www.sice.oas.org/int\\_prop/ipnale.asp](http://www.sice.oas.org/int_prop/ipnale.asp)]

SICE's Foreign Trade Information System organizes national legislation of intellectual property matters by foreign state. In many cases, applicable trademark and intellectual property law is located on the site itself (or a quick link away).

### 2. World Intellectual Property Organization (WIPO). [<http://www.wipo.int/clea/en/index.jsp>]

The WIPO provides the Collection of Laws for Electronic Access (CLEA). This database provides trademark as a subject matter search term from a drop-down list. The user can combine that descriptor with a country of origin as well, making for simple searches for trademark law. Search returns provide the date of passage, publication location, and brief notes on the law. In many cases, a PDF is attached with the entire code itself.

### 3. Foreign Law Guide: Current Sources of Codes and Basic Legislation in Jurisdictions of the World. [<http://www.foreignlawguide.com/ip>] (Subscription)

Thomas Reynolds and Arturo Flores have put together a comprehensive site in the area of foreign law research. The user can browse nonlinkable tables of contents in both subjects and material indexes. But to find material, the researcher must use the search engine. Trademark descriptors typically return information separated by country. Under each state, the site lists applicable law by subject, usually with a few words about the law. Several laws have an active website link.

### 4. Global Legal Information Network (GLIN). [<http://www.glin.gov/>]

The Library of Congress provides a free searchable website for foreign law. Searches return results similar to the WIPO, listing the date, publication location, and a brief summary. The full text of the law is also attached in PDF, though it is not always translated into English.

## F. Foreign Periodicals, Journals, and Newsletters

The Index to Foreign Legal Periodicals (IFLP) is the best source for articles, though some select publications will be mentioned.

### 1. INDEX TO FOREIGN LEGAL PERIODICALS (Institute of Advanced Legal Studies). [K33.I63] [<http://ovidsp.tx.ovid.com/>]

This index lists relevant journal and periodical articles by subject, geographical location, author, and periodical. Wolters Kluwer also offers this index online as a subscription service, complete with a powerful search engine. Don't be confused by the Wolters Kluwer Health logo on the site.

### 2. WORLD INTELLECTUAL PROPERTY REPORT (BNA 2005). [K1401.A13W6]

This monthly WIPO report includes summaries of important intellectual property law decisions from various countries, international developments from conventions and international patent and trademark offices.

### 3. TRADEMARK WORLD (Abigail Waraker ed., Informa). [K1551.2.T73]

Published ten times per year, this newsletter purports to be tailored for the international trademark practitioner, providing analysis on trademark developments, advice on trademark protection, and online archival access.<sup>19</sup>

---

<sup>19</sup> Note: author of this pathfinder was not able to view this source.

#### 4. JOURNAL OF WORLD INTELLECTUAL PROPERTY (Wiley-Blackwell). [Subscription Required]

This journal is published six times per year and is searchable online via library or personal subscription.

#### 5. MARQUES Monthly Newsletter.

[\[http://www.marques.org/Newsletters/NewsletterDownloads.asp\]](http://www.marques.org/Newsletters/NewsletterDownloads.asp)

MARQUES, the European trademark association, distributes a monthly newsletter to its members regarding recent events in international trademark law as well as conference listings. Archived newsletters are available on its website.

## **X. State Level Research**

Trademark law is also enacted on the state level and can be researched using the applicable sources for the state selected. Many states adopted the Model State Trademark Bill (MSTB), patterned after the Lanham Act itself. An example for Texas is given below. However, there are tools for finding research guides in a particular state. The University of Iowa maintains a website of sources by state.

### **A. Finding Tools for State Research Guides**

#### 1. University of Iowa State and Territory Research Guide.

[\[http://www.law.uiowa.edu/library/stateresources.php\]](http://www.law.uiowa.edu/library/stateresources.php)

This site provides a research guide for every state and several territories, including statutory materials, legislative materials, administrative materials, case law, court rules, and forms.

### **B. Secondary Sources**

#### 1. TEXAS JURISPRUDENCE 3D (Bancroft-Whitney) [KFT1265.T44]

This West encyclopedia is specific to Texas law, and is provided here by example. Begin by looking through the three-volume index. Trademark is located in volume 70. A table of contents is located at the front. Once the researcher finds the applicable section and area of legal interest, Texas Jur III offers representative cases and citations to Texas statutes. A west key number is located at the top of every section for reference to West's digests. All of the West key numbers are located in the research references section at the beginning of the trademark section, where the user can also find references to primary authority, A.L.R library, other legal encyclopedias, and form guides. This database is available on Westlaw and LexisNexis (under the Texas tab).

#### 2. AMERICAN LAW REPORTS (ALR). [KF132.6.I52]

Start with the ALR Index complete series. The index will reference the user to several different ALR volumes, depending on the particular subject matter. Most of the trademark references are in the ALR Federal. Each referenced article covers a narrow area of law and includes an outline, research references, a comprehensive index, and a table of cases, separated by jurisdiction.

#### 3. CORPUS JURIS SECUNDUM (CJS). [KF154.C63]

The trademark section is located in volume 87. A general table of contents is located at the front of the section, followed by a sub-analysis, and a more specific table of contents. CJS intersperses federal and state cases in its annotations. This database is available on Westlaw.

## C. Statutes

### 1. VERNON'S TEXAS CODES ANNOTATED (Vernons). [KFT1352.A3333]

Texas code is reproduced in this series, along with annotations. Chapter 16 is devoted to trademarks. The annotations, separated into sub-classifications of law, reference applicable Texas cases. This database is available on Westlaw.

### 2. Texas Legislature Online. [<http://www.capitol.state.tx.us/>]

Bill tracking for fresh and pending legislation is best accomplished at TLO. If the bill number is known, simply navigate to "bill lookup." However, most of the time, a researcher will not know a bill number, but will instead try to verify no legislation is pending on a particular subject. The researcher may engage the "section affected" area of the website, which links to a template with applicable drop-down menus for various areas of law. In the alternative, the user may perform a simple "bill search" or "text search" on the website.

### 3. Vernon's Texas Legislative Service. [Westlaw]

This service has been largely superseded by the TLO site mentioned above. However, it is still carried on Westlaw.

## D. Administrative Code

In Texas, the Office of the Secretary of State is the controlling administrative body.

### 1. WEST'S TEXAS ADMINISTRATIVE CODE (West 2009). [KFT1235.1988]

Garnering authority from the Administrative Procedure Act (V.T.C.A Government Code § 2001.001), the Office of the Secretary of State prepares the Texas Administrative Code. Volume 1, Chapter 93 is reserved for trademarks. However, other sections affect trademark regulations in Texas. Consult the T.A.C. general index.

### 2. Texas Secretary of State Website. [<http://www.sos.state.tx.us/tac/>]

This site provides means to view and search the Texas Administrative Code. The website is updated in near real-time and certainly more often than West's publication. In the alternative, a researcher can reference the Texas Register. [<http://www.sos.state.tx.us/texreg/index.shtml>]

## E. Case Law

### 1. WEST'S TEXAS DIGEST 2D (West). [KFT1247.1.T4]

Compare the key number found in Texas Jur III with the section in the Texas Digest. This will provide additional references to case law for a given subject, as well as cross-references to 5th circuit cases. Trademark is located in volume 46B, key numbers 1000 through 1800. This database is available on Westlaw.

### 2. Texas State Office of Administrative Hearings (SOAH). [<http://www.soah.state.tx.us/PFDSearch/Search.asp>]

Administrative Law Judge opinions are maintained in a searchable database at the SOAH website. Trademark law is within the Office of the Secretary of State. Westlaw and Lexis offer limited publications of some state agencies. Because of this limitation, a researcher should take extra care to use any citators available to update case law.

## F. Prosecution on the State Level

1. USPTO Trademark Information Website. [<http://www.uspto.gov/web/menu/statetmoffices.html>]

Every state has different rules and regulations (and offices) for filing a state-level trademark. The USPTO has collated links for most states.

2. Official Portal of Texas Trademark & Copyright.  
[<http://www.texasonline.com/portal/tol/en/bus/1/4>]

Texas Online allows for easy download of state trademark applications and forms.

## G. Forms

1. AM. JUR. LEGAL FORMS 2D §§ 247:25 to 247:27, 247:32:50. [KF170.A6]

2. TEXAS FORMS LEGAL AND BUSINESS § 36:81.

3. Secretary of State Website. [<http://www.sos.state.tx.us/corp/trademark.shtml>]

## XI. Newsletters, Gazettes, and Weekly Publications (Current Events Resources)

Several publications cater to trademark practitioners. Many of these stem from trademark or intellectual property associations. Because these publications cover burgeoning areas of trademark law, they may be one of the few sources for pending legislation or new case law.

### A. Legal Publications

1. OFFICIAL GAZETTE FOR TRADEMARKS (USPTO). [T223.A23]  
[[http://www.uspto.gov/news/og/trademark\\_og/index.jsp](http://www.uspto.gov/news/og/trademark_og/index.jsp)]

Published every Tuesday by the USPTO, the Official Gazette (OG) contains bibliographic information and a drawing of every mark published. This publication also contains a list of the most recently cancelled and renewed trademark registrations. The USPTO also feeds this information into its searchable database (TESS). OG publications for the most recent year are listed on the site. The OG, on occasion, delivers special notices on registrations that have expired and final decisions by the Trademark Trial and Appeal Board (TTAB).

2. BNA'S PATENT, TRADEMARK & COPYRIGHT JOURNAL (BNA). [KF3091.A3]  
[<http://news.bna.com/ptln>] (Subscription)

The Bureau of National Affairs Journal provides a daily publication of latest news. Highlights in intellectual property are listed at the top, followed by current news and events. The Daily also contains a calendar of conferences. A table of contents is attached to the Daily so the researcher can quickly review any new occurrences in a specific area of intellectual property (such as trademarks). The online version makes this table of contents linkable to the article or reference. Finally, a table of cases rounds out the Daily. Though there is not a short summary under the table of cases, the link takes the researcher not to the case, but to a full case note and review of the case.

3. TRADEMARK LAW HANDBOOK (Matthew Harris, Christy L.E. Hubbard, Paul Tackaberry, Peter E. Wild eds., INTA 2009). [KF3180.F54]

This yearly publication summarizes selected cases and international developments, including commentaries on trademark issues prepared by local practitioners in many jurisdictions.

#### 4. INTA TRADEMARK REPORTER (INTA). [K24.R33]

[\[http://www.inta.org/index.php?option=com\\_trademarkreporter&getcontent=1&Itemid=50\]](http://www.inta.org/index.php?option=com_trademarkreporter&getcontent=1&Itemid=50)

The INTA publishes a trademark journal every other month, composed entirely of member (and some nonmember) submitted articles. The journal is available in select libraries and online for members of the INTA. Topics generally include summaries of recent TTAB and Federal Court of Appeals for the D.C. Circuit decisions. A 1400-page annual version of this journal is also republished in its entirety on Hein Online.

## **B. Surveys and Economic Data**

### 1. AIPLA Economic Survey [Subscription to AIPLA Required]

AIPLA publishes data from its members regarding the status of the practice field. Though it doesn't cover trademark law, per se, it is extremely useful as an indicator for which aspects of trademark law are becoming more prevalent.

## **XII. Trademark Organizations (Alphabetical Order)**

Trade organizations provide vast resources for research. Though most cater to practitioners and exist primarily for member education and lobbying reasons, they often put out periodical publications and offer libraries and databases.

### **A. Associations**

#### 1. American Intellectual Property Law Association (AIPLA). [http://www.aipla.org/]

Boasting over 17,000 individual members, the AIPLA is a national bar association for patents, trademarks, copyright, and any other intellectual property matters. There are several trademark committees within AIPLA. The association releases a seasonal newsletter of recent updates in trademark law. AIPLA hosts at least two national conferences per year and publishes a quarterly journal.

#### 2. American Bar Association Section on Trademark Law. [http://www.abanet.org/intelprop/comm106/106trade.html]

Like AIPLA, the ABA has members specialized in trademark law. ABA offers CLEs and forms committees to promote interest of the association.

#### 3. European Communities Trade Mark Association (ECTA). [http://www.ecta.org/]

Formed in 1980 and headquartered in Brussels, the ECTA has approximately 1500 members from all member states of the European Union.

#### 4. Institute of Trade Mark Attorneys (ITMA). [http://www.itma.org.uk/]

Founded in 1934 and housed in the United Kingdom, the ITMA focuses primarily on trademark law in the U.K. It has over 500 practicing members, but extends membership over the European Union, causing the total membership to be over 1600.

#### 5. Intellectual Property Owners Association (IPO). [http://www.ipo.org/]

The IPO promotes the interests of its members through amicus briefs, position statements, and lobbying. It holds its own conferences, webinars, and meetings, but also works closely with the AIPLA. While it encapsulates trademark law, its focus is primarily on patents.

#### 6. International Trademark Association (INTA). [<http://inta.org/>]

In existence since 1878, the INTA is quite possibly the oldest and largest trademark organization. Every year it hosts dozens of conferences, roundtables, forums, and webinars. It boasts over 5900 members in 190 countries. The INTA's mission is to represent the trademark community, shape public policy, and advance professional knowledge and development. It publishes the Trademark Reporter, a monthly journal of member submitted articles.

#### 7. MARQUES: Association of European Trademark Owners. [<http://www.marques.org/>]

This is the European version of the AIPPLA, providing conferences and CLEs for its members. MARQUES encourages all members to be on a committee, or team, to collectively promote the interests of MARQUES. Teams author position papers, participate in lobbying, record changes in the law, and disseminate that information to its membership. MARQUES allows firm membership.

#### 8. World Intellectual Property Organization (WIPO). [<http://www.wipo.int/portal/index.html.en>]

The WIPO is a specialized arm of the United Nations, which, according to its website, is dedicated to "developing a balanced and accessible international intellectual property (IP) system, which rewards creativity, stimulates innovation and contributes to economic development while safeguarding the public interest." Its membership is made up of U.N. member states.

### **XIII. Summary**

Trademark law hails from medieval times, yet even today, it is undergoing a relatively dynamic period as brands stretch across oceans in this ever-collapsing legal and economic environment. As a result, a trademark practitioner must command a broad body of law. To stay competitive, employment of efficient research skills is imperative. This pathfinder was designed to help both novice and veteran attorneys navigate the dynamic field of trademark law. By following the structure of this guide and updating regularly, I hope to streamline the process of research in the field of trademark law.

## **XIV. Appendix A: Search Terms**

Trademark law encompasses such a large body, that it is difficult to reproduce effective search terms here. Perhaps the best location for a researcher to pick up search terms is in the tables of contents for the secondary sources listed in Section III above, primarily in Section III.B.

### **A. Primary search terms**

- Trademark
- Trade-mark
- Madrid Protocol
- TRIPS
- Arbitrary and Fanciful
- Intellectual Property
- TTAB
- Trade regulation
- Unfair competition
- Monopolies
- Copyright
- Competition, unfair
- United State Patent and Trademark Office

### **B. Modifiers**

- International
- World
- State Law
- Foreign
- Law and legislation
- Rules
- Practice

## **XV. Appendix B: Glossary of Acronyms/Abbreviations**

- AIPLA: American Intellectual Property Law Association
- ALI: American Law Institute
- ALR: American Law Reports
- ASIL: American Society of International Law
- BNA: Bureau of National Affairs
- CJS: Corpus Juris Secundum
- CLEA: Collection of Laws for Electronic Access
- E-FOIA: Electronic Freedom of Information Act
- ECTA: European Communities Trade Mark Association
- EISIL: Electronic Information System for International Law
- GLIN: Global Legal Information Network
- IFLP: Index to Foreign Legal Periodicals
- INTA: International Trademark Association
- IPO: Intellectual Property Owners Association
- ITMA: Institute of Trade Mark Attorneys
- LSA: List of C.F.R. Sections Affected
- MSTB: Model State Trademark Bill
- OECD: Organisation for Economic Co-Operation and Development
- SICE: Organization of American State's Foreign Trade Information System
- SOAH: State Office of Administrative Hearings
- SSRN: Social Science Research Network
- TAC: Texas Administrative Code
- TBMP: Trademark Trial and Appeal Board Manual of Procedure
- TEAS: Trademark Electronic Application System
- TESS: Trademark Electronic Search System
- TLO: Texas Legislature Online
- TLRA: Trademark Law Revision Act of 1988
- TMEP: Trademark Manual of Examining Procedures

- TRIPS: Trade-related aspects of intellectual property rights
- TTAB: Trademark Trial and Appeal Board
- WIPO: World Intellectual Property Organization
- WTO: World Trade Organization
- UNCITRAL: United Nations Commission on International Trade Law
- USCA: United States Code Annotated
- USCS: United States Code Service