The Four-Step Legal Research Process

In this training, you'll learn about :

- The four-step legal research process
- The first three steps of the legal research process

The Four-Step Legal Research Process

Legal Research Process

Barkan, Mersky and Dunn's Assignments to Fundamentals of Legal Research, 9th and Legal Research Illustrated, 9th New York: Foundation Press, 2009:

- Step 1: Identify and analyze the significant facts.
- Step 2: Formulate the legal issues to be researched.
- Step 3: Research the issues presented.
- Step 4: Update

The Four-Step Legal Research Process

Step 1. Identify and Analyze the Material Facts:

Your client, Toy Company, manufactures a very popular doll, Dindi. Dindi is manufactured to represent a glamorous adult woman. She has a sports car, mansion, boyfriend named Karl, and many other exciting, lifestyle oriented accoutrements.

An unrelated entity, Joke Products LLC, is marketing and selling a doll called Dreg of Society Dindi. The doll looks remarkably like Dindi, except not quite so glamorous. She is marked wearing tattered clothes and has messed up hair. Toy Company feels that this is an obvious attempt to criticize and devalue its product, while capitalizing on the Dini name. Toy Company wants to know if they have a claim against Joke Products LLC for infringement of its trademark.

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Step 1. Identify and Analyze the Material Facts:

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Step 2: Formulate Legal Issues:

- Does Jokes Products LLC's conduct constitute trademark infringement?
- Are there any defenses available to Jokes Products?

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Step 3: Research

- Brainstorm search terms
- Where should we start our research?
  - Primary Law?
  - Secondary sources?
  - legal encyclopedias v. treatises

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1. To began your research, think about all the **terms** that might help you find the information you need.

2. Then, consider **where** you'll look for those terms.

   - Law libraries contain integrated collections of traditional research materials and info technologies that can be used together.
   - You can also use table of content for those publications on **Westlaw.**

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Brainstorm search terms:

- Assume we are unfamiliar with Intellectual property law.
- In that case, let's start with Secondary resources or Treatise and Practice Guides to quickly learn about your topics.
- It save you time with easy-to find, accurate answers and allow you to browse to specific topics using table of contents.
- Include citations to relevant primary law.

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Practice-Area Treatises:

Begin with a comprehensive intellectual property treatise to obtain an overview of the law:

- *McCarthy on Trademarks and Unfair Competition, 4th*
- *Moy's Walker on Patents, 4th*

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McCarthy on Trademarks and Unfair Competition, 4th

- Appendices
  - The Lanham Act
  - References to statute relevant to trademark law
  - Trademark Rules of Practice of the Patent and Trademark Office, as amended (T.M.R.P.)
  - Classification of Goods and Services under the FTA
  - Many other relevant resources
- Table of Cases
- Table of Lanham Act Statutes
- Index

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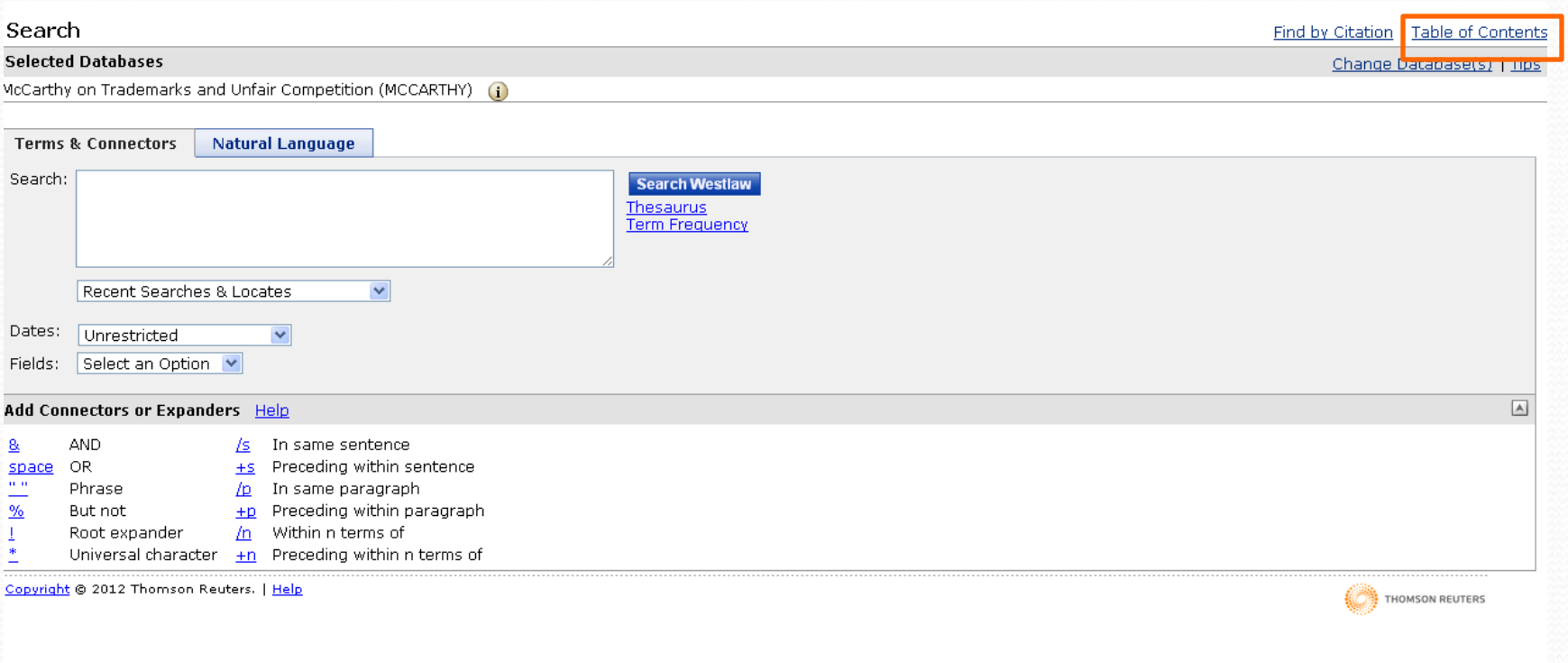
Step 4: Update

A number of different paths are available, based on our print research:

1. Find the USCA citation on **Westlaw** and quickly link to relevant content and **Keycite**.
2. Using what we have learned, craft either a Terms and Connectors or Natural Language search in the Federal Labour Cases (FLB-CS) database.
3. Search the **ALR database** for an on-point article.

As with most reference book, you can start searching for entries of your term in the index or you can also use table of content for those publications on **Westlaw**.



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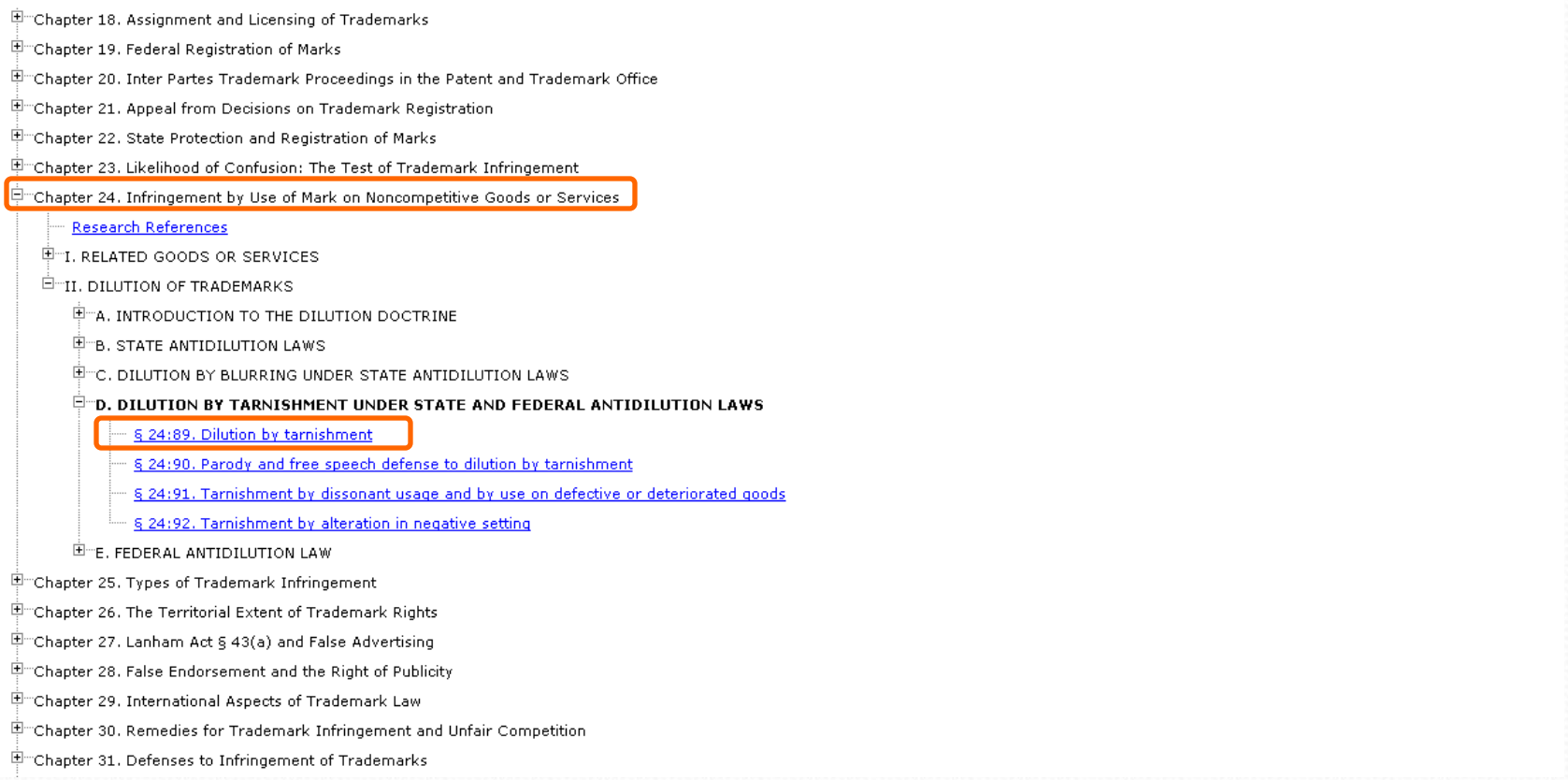

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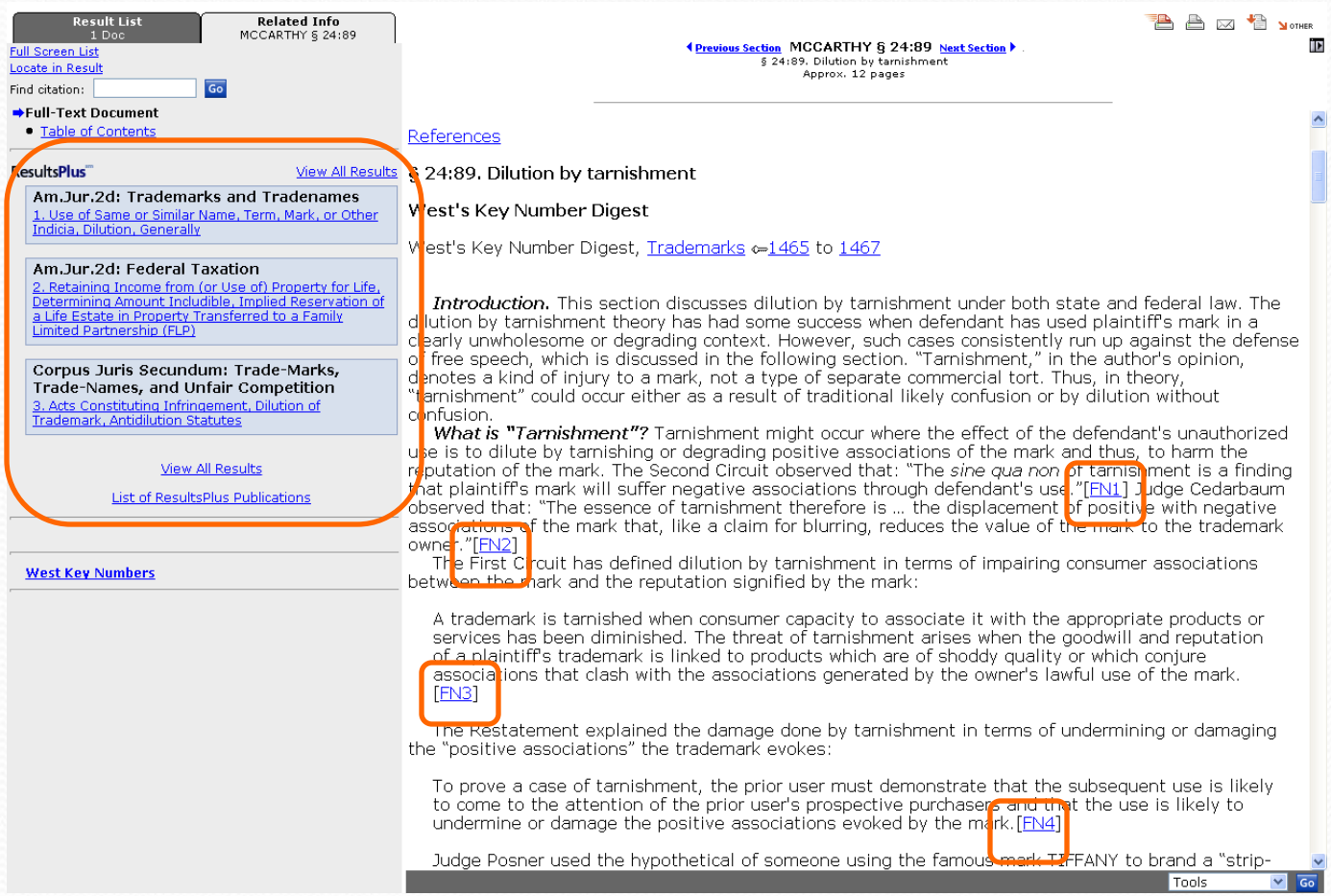

Result List
1 Doc

Related Info
MCCARTHY § 24:89

Full Screen List
Locate in Result
Find citation: Go

➡Full-Text Document
- Table of Contents

ResultsPlus View All Results

Am.Jur.2d: Trademarks and Tradenames
1. Use of Same or Similar Name, Term, Mark, or Other Indicia, Dilution, Generally

Am.Jur.2d: Federal Taxation
2. Retaining Income from (or Use of) Property for Life, Determining Amount Includible, Implied Reservation of a Life Estate in Property Transferred to a Family Limited Partnership (FLP)

Corpus Juris Secundum: Trade-Marks, Trade-Names, and Unfair Competition
3. Acts Constituting Infringement, Dilution of Trademark, Antidilution Statutes

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West Key Numbers

◂ Previous Section MCCARTHY § 24:89 Next Section ▸
§ 24:89. Dilution by tarnishment
Approx. 12 pages

References

§ 24:89. Dilution by tarnishment

West's Key Number Digest

West's Key Number Digest, Trademarks ⇦1465 to 1467

Introduction. This section discusses dilution by tarnishment under both state and federal law. The dilution by tarnishment theory has had some success when defendant has used plaintiff's mark in a clearly unwholesome or degrading context. However, such cases consistently run up against the defense of free speech, which is discussed in the following section. "Tarnishment," in the author's opinion, denotes a kind of injury to a mark, not a type of separate commercial tort. Thus, in theory, "tarnishment" could occur either as a result of traditional likely confusion or by dilution without confusion.

What is "Tarnishment"? Tarnishment might occur where the effect of the defendant's unauthorized use is to dilute by tarnishing or degrading positive associations of the mark and thus, to harm the reputation of the mark. The Second Circuit observed that: "The *sine qua non* of tarnishment is a finding that plaintiff's mark will suffer negative associations through defendant's use." [FN1] Judge Cedarbaum observed that: "The essence of tarnishment therefore is ... the displacement of positive with negative associations of the mark that, like a claim for blurring, reduces the value of the mark to the trademark owner." [FN2]

The First Circuit has defined dilution by tarnishment in terms of impairing consumer associations between the mark and the reputation signified by the mark:

> A trademark is tarnished when consumer capacity to associate it with the appropriate products or services has been diminished. The threat of tarnishment arises when the goodwill and reputation of a plaintiff's trademark is linked to products which are of shoddy quality or which conjure associations that clash with the associations generated by the owner's lawful use of the mark. [FN3]

The Restatement explained the damage done by tarnishment in terms of undermining or damaging the "positive associations" the trademark evokes:

> To prove a case of tarnishment, the prior user must demonstrate that the subsequent use is likely to come to the attention of the prior user's prospective purchasers and that the use is likely to undermine or damage the positive associations evoked by the mark. [FN4]

Judge Posner used the hypothetical of someone using the famous mark TIFFANY to brand a "strip-

Tools Go

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Step 4: Update

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2. Using what we have learned, craft either a Terms and Connectors or Natural Language search in the Moy's Walker on Patents (MOY-PAT).
3. Search the **ALR database** for an on-point article.

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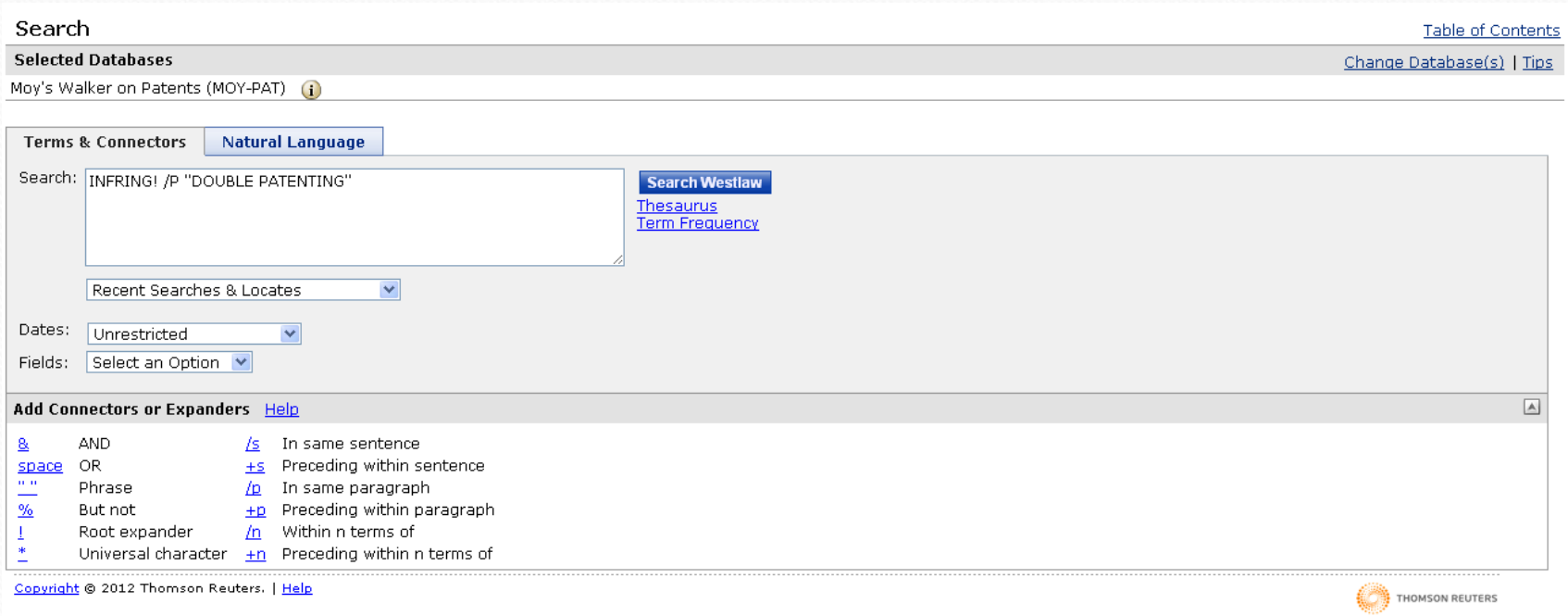

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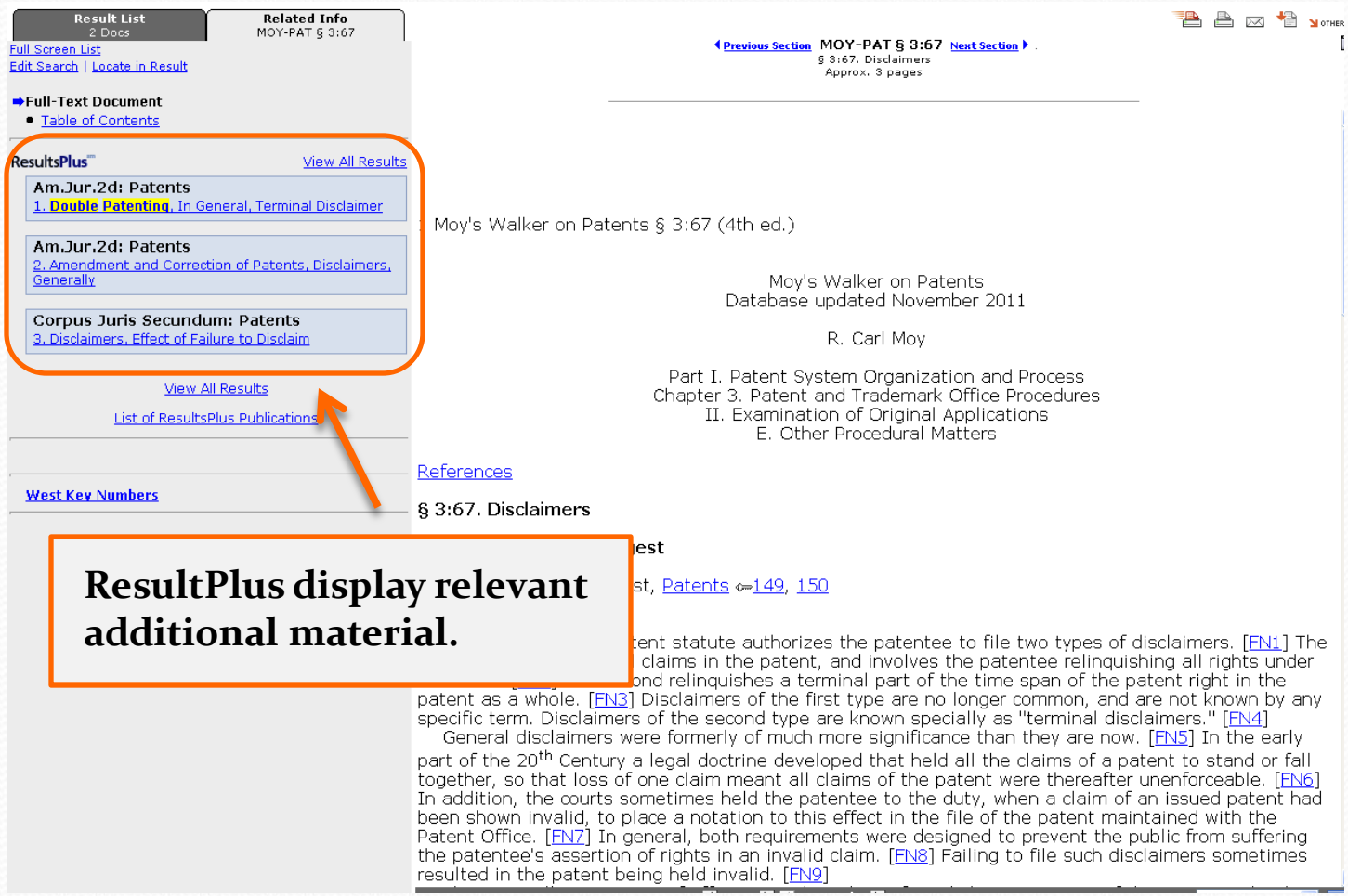

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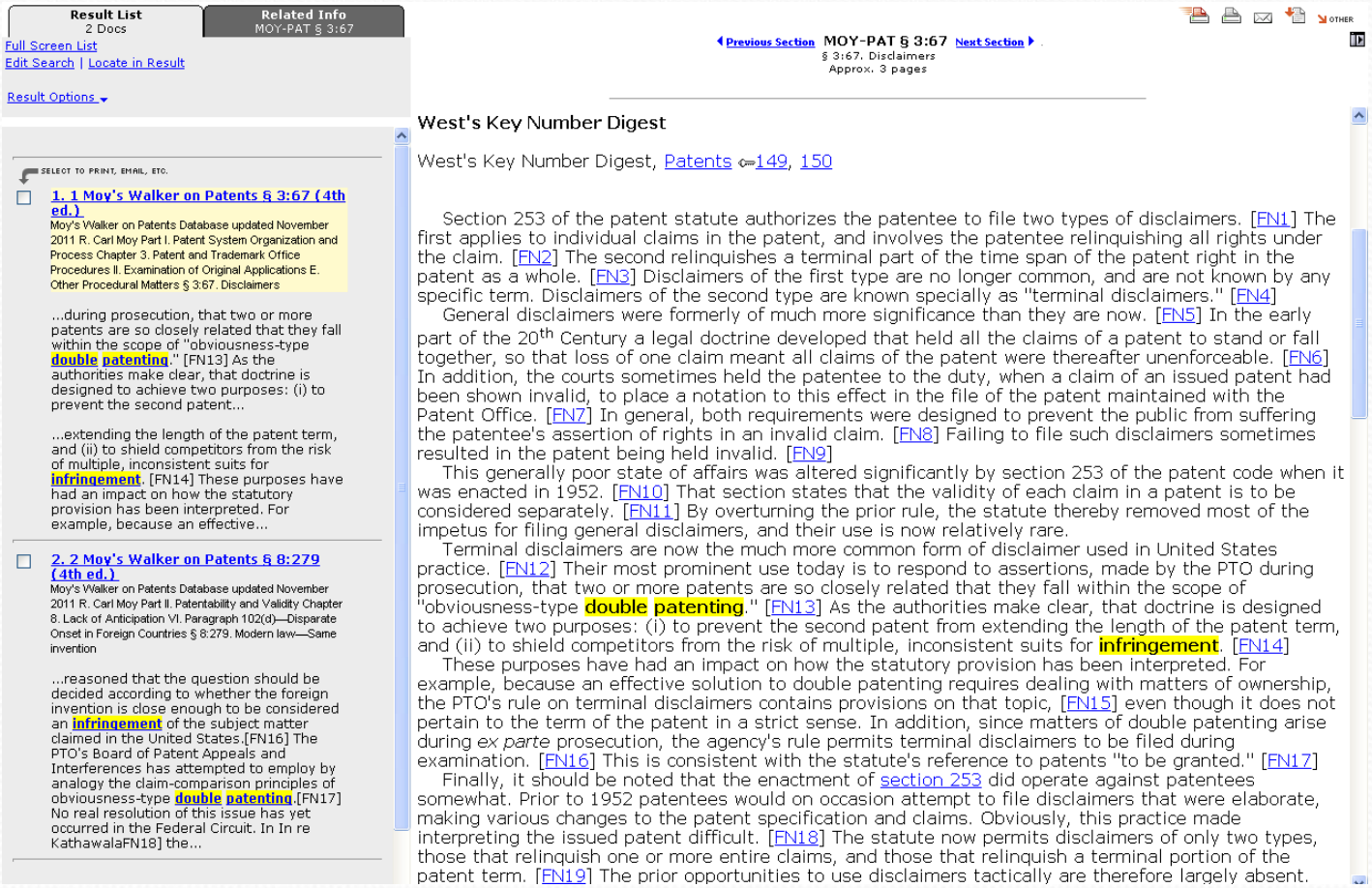

Result List
2 Docs
Related Info
MOY-PAT § 3:67
Full Screen List
Edit Search | Locate in Result
Result Options
SELECT TO PRINT, EMAIL, ETC.
1. 1 Moy's Walker on Patents § 3:67 (4th ed.)
Moy's Walker on Patents Database updated November 2011 R. Carl Moy Part I. Patent System Organization and Process Chapter 3. Patent and Trademark Office Procedures II. Examination of Original Applications E. Other Procedural Matters § 3:67. Disclaimers
...during prosecution, that two or more patents are so closely related that they fall within the scope of "obviousness-type double patenting." [FN13] As the authorities make clear, that doctrine is designed to achieve two purposes: (i) to prevent the second patent...
...extending the length of the patent term, and (ii) to shield competitors from the risk of multiple, inconsistent suits for infringement. [FN14] These purposes have had an impact on how the statutory provision has been interpreted. For example, because an effective...
2. 2 Moy's Walker on Patents § 8:279 (4th ed.)
Moy's Walker on Patents Database updated November 2011 R. Carl Moy Part II. Patentability and Validity Chapter 8. Lack of Anticipation VI. Paragraph 102(d)—Disparate Onset in Foreign Countries § 8:279. Modern law—Same invention
...reasoned that the question should be decided according to whether the foreign invention is close enough to be considered an infringement of the subject matter claimed in the United States.[FN16] The PTO's Board of Patent Appeals and Interferences has attempted to employ by analogy the claim-comparison principles of obviousness-type double patenting.[FN17] No real resolution of this issue has yet occurred in the Federal Circuit. In In re KathawalaFN18] the...
Previous Section MOY-PAT § 3:67 Next Section
§ 3:67. Disclaimers
Approx. 3 pages
West's Key Number Digest
West's Key Number Digest, Patents 149, 150
Section 253 of the patent statute authorizes the patentee to file two types of disclaimers. [FN1] The first applies to individual claims in the patent, and involves the patentee relinquishing all rights under the claim. [FN2] The second relinquishes a terminal part of the time span of the patent right in the patent as a whole. [FN3] Disclaimers of the first type are no longer common, and are not known by any specific term. Disclaimers of the second type are known specially as "terminal disclaimers." [FN4]
General disclaimers were formerly of much more significance than they are now. [FN5] In the early part of the 20th Century a legal doctrine developed that held all the claims of a patent to stand or fall together, so that loss of one claim meant all claims of the patent were thereafter unenforceable. [FN6] In addition, the courts sometimes held the patentee to the duty, when a claim of an issued patent had been shown invalid, to place a notation to this effect in the file of the patent maintained with the Patent Office. [FN7] In general, both requirements were designed to prevent the public from suffering the patentee's assertion of rights in an invalid claim. [FN8] Failing to file such disclaimers sometimes resulted in the patent being held invalid. [FN9]
This generally poor state of affairs was altered significantly by section 253 of the patent code when it was enacted in 1952. [FN10] That section states that the validity of each claim in a patent is to be considered separately. [FN11] By overturning the prior rule, the statute thereby removed most of the impetus for filing general disclaimers, and their use is now relatively rare.
Terminal disclaimers are now the much more common form of disclaimer used in United States practice. [FN12] Their most prominent use today is to respond to assertions, made by the PTO during prosecution, that two or more patents are so closely related that they fall within the scope of "obviousness-type double patenting." [FN13] As the authorities make clear, that doctrine is designed to achieve two purposes: (i) to prevent the second patent from extending the length of the patent term, and (ii) to shield competitors from the risk of multiple, inconsistent suits for infringement. [FN14]
These purposes have had an impact on how the statutory provision has been interpreted. For example, because an effective solution to double patenting requires dealing with matters of ownership, the PTO's rule on terminal disclaimers contains provisions on that topic, [FN15] even though it does not pertain to the term of the patent in a strict sense. In addition, since matters of double patenting arise during *ex parte* prosecution, the agency's rule permits terminal disclaimers to be filed during examination. [FN16] This is consistent with the statute's reference to patents "to be granted." [FN17]
Finally, it should be noted that the enactment of section 253 did operate against patentees somewhat. Prior to 1952 patentees would on occasion attempt to file disclaimers that were elaborate, making various changes to the patent specification and claims. Obviously, this practice made interpreting the issued patent difficult. [FN18] The statute now permits disclaimers of only two types, those that relinquish one or more entire claims, and those that relinquish a terminal portion of the patent term. [FN19] The prior opportunities to use disclaimers tactically are therefore largely absent.

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3. Search the **ALR database** for an on-point article.

Conclusion:

Legal Research Process in conclusion:

Once you identify and analyze material facts of your research and formulate the legal issue, you should then brainstorm the search terms and carry out update for the information.