RESEARCHING REMEDIES IN INTELLECTUAL PROPERTY ACTIONS INVOLVING COMPUTER TECHNOLOGY: A RESEARCH GUIDE

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ABSTRACT

The purpose of this research guide is not to answer the question "What remedies are available to an owner of computer related technology whose rights have been infringed?" but to provide a methodology by which a legal practitioner can find the answer to this question. This guide sets forth materials and methods of research that can be used for an inquiry that is broad in scope, such as researching which legal scheme's remedial component best suits a client's technology, but that are also capable of being used for a narrow or limited inquiry, such as looking for specific remedies available in litigation to enforce a client's rights.

The guide points to many useful materials that practitioners in the field of intellectual property will find very helpful. The article will prove to be an invaluable resource to those doing research in the area of intellectual property for the first time, and to those law office librarians who are looking to gather intellectual property resources for attorneys conducting such research.

PART I: INTRODUCTION

A. *Why Research Remedies in Intellectual Property Actions Involving Computer Technology?*

As computer technology becomes increasingly important in our everyday lives, so will the importance of the computer industry, as it relates to the economy as a whole. Part of what will determine the growth of this industry is the system of laws that regulate the products it creates. In the United States, the laws governing intellectual property (or IP), such as copyright law, patent law, trademark law and trade secret law, will indirectly influence the ideas, inventions and innovations arising from this digital age. The right of inventors or entrepreneurs to control and keep ownership of their intangible work, as set forth in these laws, is a key element in determining the extent to which innovation will occur. And as with any right, the scope of the remedies set forth to enforce this right of ownership and control underlie the strength of the right. Thus, knowing what remedies are available to inventors and entrepreneurs in this digital age, which set forth the disincentives that prevent others from infringing on these inventors or owners rights, is one of the most important aspects of the system of intellectual property laws.

The purpose of this research guide is not to answer the question "What remedies are available to an owner of computer related technology whose rights have been infringed?" but to provide a methodology by which a legal practitioner can find the answer to this question. This guide sets forth materials and methods of research that can be used for both a broad inquiry, such as researching which legal scheme's remedial component best suits a client's technology, and a narrow inquiry, such as looking for specific litigation remedies to enforce a client's legal rights.

B. *An Overview of The Remedies Available Under Various IP Law Regimes*

IP law, like other areas of law, sets forth two main types of remedies for the infringement of someone's rights: money damages and injunctive relief. However, the scope of the injunctive relief available, and the determination of those money damages, depends both on the type of IP law being applied, and its relationship to the disputed computer technology. Although copyright law, patent law, trademark law and trade secret law are all rooted in the notion that the intangible result of a person's work should be afforded the same protection as tangible property, the manner in which each type of IP law achieves this objective differs tremendously. Further, computer technology in both its form and capability

have such a scope that it has made all four of these separate regimes relevant to a legal practitioner dealing with this technology. For instance, software can be considered a literary work worthy of copyright protection, yet also be part of an integral process entitling it to patent protection. Further, instead of both or either of these protections, it could also be afforded trade secret protection. A practitioner must be aware of the remedies available under all of these legal schemes when deciding how to protect the software from theft. Thus, this guide provides methods to conduct research for each of these sets of laws.

C. *Overview of This Research Guide's Methodology*

This research guide lays out the different avenues of research in the typical order that research in this field should be conducted. Chapter II refers to treatises, which often provide a great starting point for research, since they examine the law as a whole and set forth the relationship between statutes and case law in the area. Chapter II also provides a brief overview of searching for books that may be of use to a practitioner. Then, chapter III refers to periodicals and related publications, which can be used to provide a more recent analysis than treatises or books. Chapter IV deals with statutes, the backbone of IP law. Chapter V analyzes case law, which is a core part of legal research in this field. Chapter VI looks at litigation research and how to find the outcomes in similar IP cases. Chapter VII deals with citation services and update services, which can be used to supplement and update case research. Finally, chapter VIII examines the use of the internet to find web sites dealing with IP damages. Although research should follow this order generally, practitioners with expertise in the area, or with a narrow purpose, may find it useful to refer to one chapter in particular. Also, to aid practitioners seeking to use this research guide as a reference, the beginning of each chapter contains a Quick Tips section designed to give a quick overview of the chapter and the methods explained therein.

D. *Finding Research Materials*

1. The Location of Print Sources Generally

Although this guide sets forth in specificity what print sources are most useful for research of remedies for IP actions involving computer technology, practitioners planning on specializing in this area should become familiar with their library's holdings of print sources in this area more generally. If the library employs Library of Congress (LC) numbering, there are generally two areas that will be of interest to researchers.

First, KF390 and KF390.5 contain, among other things, publications regarding "computer law," loosely defined as laws that govern technology related to computers.[1] Second, IP law is generally cataloged from KF2972 to KF3197, in the order of copyright, patent, trademark and trade secret materials. Most of the print sources referred to in this guide can be found within these ranges of LC numbers. Partial LC numbers are included in the footnotes to aid in research.[2]

2. The Location of Online Sources Generally

The two online sources most used by legal practitioners are Westlaw and LEXIS. Except for chapter VIII, which is devoted to internet web site generally, when referring to online sources, this guide will stay within these two sources. Both Westlaw and LEXIS have sections organized by topic, which can be useful to researchers. Relevant for this guide are the topical groupings for IP law.

On Westlaw, materials useful for IP research are grouped in two ways. First, within the web site's main directory, under *Topical Materials by Area of Practice*[3] is the *Intellectual Property* category, which lists all sources related to IP law. Second, one can customize Westlaw to include a tab called *Intellectual Property* at the top of the web site that is devoted to commonly searched IP related databases.

On LEXIS, materials are organized into the various types of IP law. Under *Area of Law—by Topic*, there are a number of groupings of interest, including *Copyright Law*, *Cyberlaw*, *E-Commerce*, *Patent Law*, and *Trademarks*.

PART II: TREATISES, OTHER BOOKS & BIBLIOGRAPHIES

A. *Quick Tips*

Treatises are the best source for an overview of the differing remedy theories for intellectual property cases dealing with computer technology. Thus, they are a good secondary source with which to start research. Although there is not one great single treatise dealing with the particular subject, a number of treatises have chapters dealing with the issue extensively. Good treatises to refer to include:

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1.   Part of "computer law" is the law relevant to commercial transactions and the marketing of computer technology, both of which are beyond the scope of this research guide.

2.   The first part of the LC number is provided as a starting point in order to guide the reader within a library or within an online catalog.

3.   To avoid confusion, this guide has online sources, categories, databases and search terms in italics.

- Part III, Part G, chapters 90–94 of *Intellectual Property Counseling and Litigation* published by Matthew Bender.[4]

- Vol. 4, chapter 14 of *Nimmer on Copyright*, published by Matthew Bender.[5]

- Vol. 7, chapter 20 of *Chisum on Patents*, published by Matthew Bender.[6]

- Vol. 5, chapter 30 of *McCarthy on Trademarks and Unfair Competition*, published by West Group.[7]

- Various sections of *Scott on Computer Law*, published by Aspen Publishers.[8]

To find books, use online library catalogs that use LC headings. Use keyword/subject heading search functions in these catalogs to find current publications dealing with damages in IP technology actions. Good search strings/terms include:

- Intellectual property damages

- Computer damages

- Patent damages

- Technology damages United States

- Technology trial practice United States

- Copyright—Cases—United States

- Software protection—Law and legislation—United States

- Patent infringement—United States

- Trademark infringement—United States

B. *Using Treatises, Other Books, & Bibliographies for Research*

Treatises are the best starting point for research on remedies for intellectual property actions dealing with computer technology. Good

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4. The current edition of this Matthew Bender treatise may be found on LEXIS by searching Part III, Part G, chapters 90–94 of *Intellectual Property Counseling and Litigation*. An older version of this treatise was printed in 1998 by Lester Horwitz and Ethan Horwitz. LC KF2979.

5. 4 MELVILLE D. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 14 (1978). LC KF2991.5.

6. 7 DONALD S. CHISUM, CHISUM ON PATENTS § 20 (1978). LC KF3114.

7. 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 30 (1996). LC KF3180.

8. MICHAEL D. SCOTT, SCOTT ON COMPUTER LAW (2d ed. 1991). LC KF390.5.

treatises not only provide a thorough review of the differing remedy theories of IP cases, but also include comprehensive footnotes citing the more prominent cases discussing these theories. Most importantly, treatises are updated by pocket parts, supplements, or loose-leaf inserts. As the area of IP law is constantly in flux, most treatises dealing with this area of law or a subset of this area are in loose-leaf form, allowing for easier updating.

Like other areas of law, the four main branches of IP, those being copyright, patent, trademark and trade secrets, have extensive treatises devoted to them. Also, there are treatises that deal with computer law and IP laws relating to software, and the protections and remedies available to this subject matter under various IP laws.

Other than treatises, books dealing with such narrow topics are scarce, and even if such books are found, they are normally dated and thus do not include the most recent developments and decisions pertinent to IP actions and remedies stemming from such actions. As this area of law is constantly changing because of the changing reach and potency of new technologies, practitioners may find that a book published only a year ago will provide information of little relevance to the case at hand. In searching for useful book sources, practitioners should look for recent publications from legal associations and conferences that focus on IP actions dealing with computer technology. Such publications will normally address the currently contested topics and/or provide a good overview of the process and procedure of litigating damages.

Bibliographies can be more useful to the extent that they cite sources that are updated frequently. However, by relying on bibliographies, which suffer from the same problems as books, one runs the risk of missing a more recent publication with pertinent information.

C. *Finding Treatises*

1. In Print

Unfortunately, finding a treatise in a particular area of law can be difficult for a neophyte, as they are not distinguished from other books or publications in a consistent manner. Sometimes the word "treatise" will be included in the title, but this is far from a rule. Typically, treatises are published by established legal publishers, such as Matthew Bender (a division of Lexis Publishing), the West Group (which now includes the Lawyers Cooperative), Aspen Publishers (Aspen), and the Practising Law Institute (P.L.I). Referring to the customer service departments of these publishers may prove useful in finding out whether there is a treatise by the publisher in the area of law being researched.

In looking for treatises dealing with computer technology related litigation, it is most useful to search an online library catalog using particular LC numbers, and perusing the list of titles that appear.[9] Typically, publications that have multiple volumes, or cover various LC subjects, may be considered treatises worth perusing. The most relevant LC headings are listed below:

- KF390.5.C6—Computers—Law & Legislation—U.S.
- KF2991—Copyright—U.S.
- KF2991.5—Copyright—U.S.
- KF 2993—Copyright—U.S.—Cases
- KF2994—Copyright—U.S.
- KF 2995—Copyright—U.S.
- KF3024.C6—Copyright—Computer Programs—U.S.
- KF3114—Patent Laws & Legislation—U.S.
- KF3180—Trademarks—Law & Legislation—U.S.
- KF3197—Trade Secrets—U.S.

Just because a multi-volume publication does not list remedies as part of the LC subjects covered does not mean it is not worth perusing, as treatises generally cover a wide range of issues within a particular area of law. Below are a number of treatises, listed by area of law, that address remedies in IP actions involving computer technology. Within each area of law, treatises are ordered by the depth in which remedies are addressed. Thus, the first title listed should be sought first, and so on.

2. Online

A number of treatises that are in print are also available online on Westlaw or LEXIS. These treatises can be found as part of the grouped IP materials in each web site,[10] or under a separate heading devoted to treatises. Although online treatise databases are more difficult to peruse than their print counterparts, they do offer the advantage of boolean and natural language searching.[11] The extent to which a treatise can be browsed, using its table of contents as a guide, or searched, using terms and connectors, depends on the database publisher.

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9.   Searching an online library catalog is preferable to simply going to the shelf because the catalog will list all titles available at the library, including those that have been checked out. Thus, the catalog provides an "ideal shelf" for viewing.

10. *See supra* Part I.D.2.

11. *See infra* Part V.C.

A wide range of Matthew Bender treatises can be found on LEXIS. These electronic versions typically include a search term option and a browse by the table of contents option.[12] The search term option can either use boolean terms and connectors or natural language. Using the boolean search term option, one can limit the search to only the chapter dealing with remedies by inserting the chapter number in a limited search: *heading(chapter __).*[13] Unfortunately, for Matthew Bender treatises, there is no segment search that can reduce searching to a particular section or subsection of the treatise.

Treatises by Aspen are also available on LEXIS. These electronic versions include a search term option and a browse by the table of contents option. The search term option can either use boolean terms and connectors or natural language. Using the boolean search term option, one can limit the search to only a chapter dealing with remedies by inserting *heading(remedies)* or *heading(chapter __)* in the search box. However, unlike Matthew Bender treatises on LEXIS, searching can be further limited to certain sections by including the section number or title in *section(__)*[14] in the search box.[15]

PLI treatises can be found on LEXIS as well. Unlike other online treatises available on LEXIS, these databases cannot be browsed using their table of contents, and can only be searched using either boolean terms and connectors or natural language. Like Aspen's online treatises, searching can be further limited to certain sections by including the section number or title in *section(__)* and inserting this segment in the search box.

D. *Remedies in Intellectual Property Infringement Actions*

1. Intellectual Property: Counseling and Litigation

Part III, Part G, chapters 90 to 94 of the Matthew Bender treatise *Intellectual Property Counseling and Litigation*[16] addresses the types of remedies available under various IP infringement actions, with over 225

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12. Note that occasionally the online database's table of contents has errors in its layout that need to be corrected by the online publishers.

13. For example, to limit searching to chapter 90 of *Intellectual Property Counseling and Litigation*, *supra* note 4, use the search term *heading(chapter 90)* as part of the search in LEXIS.

14. For example, to limit searching to § 11.0 of Goldstein's *Copyright*, *infra* note 19, which deals with permanent injunctive relief, use the search term *section(11.0)* as part of the search in LEXIS.

15. The number of segment search options available for Aspen treatise databases in LEXIS are greater than those available for Matthew Bender treatise databases.

16. INTELLECTUAL PROPERTY COUNSELING AND LITIGATION, *supra* note 4.

pages covering the subject. Each chapter is devoted to relief under a different area of IP law, including patent, trademark and copyright. Although the treatise does not deal with computers and other such technology in any particular manner, it does cite to cases involving technology while discussing more general IP litigation issues. It is updated on an irregular basis by cumulative supplements and new loose-leaf inserts, with these updates being released biannually.

As these chapters provide an in-depth analysis of the basic theories for IP infringement remedies, and focus on litigation issues that arise in proving damages, it is a great research tool for practitioners. Like other Matthew Bender treatises, subjects are arranged in a useful outline format. Each section is broken down into further subsections describing in detail the alternative theories for damages as set forth in various Federal appellate decisions. Courts rarely cite to this treatise as an authoritative source, and thus practitioners should refrain from citing to it directly in court documents. This treatise is also available online through LEXIS under the database called *Intellectual Property Counseling and Litigation*.

E. *Remedies in Copyright Infringement Actions*

1. Nimmer on Copyright

Volume 4, chapter 14 of Melville B. Nimmer and David Nimmers' *Nimmer on Copyright*[17] is devoted to the remedies available for copyright infringement. This chapter is approximately 170 pages and sets forth the alternative forms of remedies available, such as actual damages, defendant's profits, and injunctive relief. It is updated by loose-leaf pages on an irregular basis, with updated pages being released around twice a year. Like other general treatises, *Nimmer on Copyright* does not address problems particular to the application of copyright law remedies to copyrighted software, but sets forth the more general scheme for remedies in copyright infringement actions.

In sum, this treatise provides a comprehensive analysis for practitioners, with topics arranged in a useful outline format, and with sections describing in detail the alternative theories for damages as set forth in various Supreme Court and Circuit Court decisions. Courts cite this treatise often as an authoritative source on copyright law and as such practitioners can cite it directly in court documents as well.[18] *Nimmer on*

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17. 4 NIMMER, *supra* note 5.

18. In fact, the treatise indicates when a court decision has cited the treatise for a given proposition. *See*, *e.g.*, 4 NIMMER § 14.01 n.15, *supra* note 5.

Copyright is a Matthew Bender treatise that also available online through LEXIS under a database by the same name.

2. Goldstein's Copyright

Volume II, Part 6 of Paul Goldstein's *Copyright*[19] also summarizes the various remedies available for copyright infringement. This treatise organizes these remedies into two broad categories. First is a discussion in chapter 11 of injunctions and other forms of coercive relief, and second is a discussion in chapter 12 of monetary damage awards. These chapters are further broken down into sections and subsections providing a good outline of the material discussed. These two chapters together are approximately 140 pages in length, and the treatise is in loose-leaf format, updated by supplements and inserts on a yearly basis. Although the treatise does delve into the particulars of proving liability for the infringement of differing forms of copyrightable works, including software,[20] the treatise does not provide a similar analysis for the intricacies of applying more generalized theories for remedies to these copyrightable forms.

Like its Matthew Bender equivalent, this treatise provides a comprehensive analysis for practitioners, with more emphasis being placed on arguing the validity, or invalidity for that matter, of the more important decisions in the area, rather than just instructing the reader as to the law and citing to the relevant decisions for these propositions. Appellate courts have cited this treatise as an authoritative source on copyright law, but not to the same extent as *Nimmer on Copyright*. This Aspen publication is also available online through LEXIS under the database simply called *Copyright*.

3. Henn on Copyright Law: A Practitioner's Guide

Chapter 28 of Harry G. Henn's *Henn on Copyright Law: A Practitioner's Guide*[21] sets forth the various remedies available for copyright infringement. This chapter, which is approximately twenty pages, does not address issues specific to computer technology. The treatise is not updated, and thus lacks citations to current cases relevant to computer software and other technology. Thus, it is not a very useful tool for research in this area. *Henn on Copyright Law* is a PLI treatise.

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19. 2 PAUL GOLDSTEIN, COPYRIGHT § 11.0 (2d ed. 1996). LC KF2994.

20. *See id.* at § 8.5.

21. HARRY G. HENN, HENN ON COPYRIGHT LAW: A PRACTITIONER'S GUIDE § 28 (3d ed. 1991). LC KF2994.

4. Copyright Law in Business and Practice

John W. Hazard, Jr.'s *Copyright Law in Business and Practice*[22] is a one-volume treatise with chapter 9 devoted completely to remedies available in a copyright infringement action. This short chapter consisting of fourteen pages provides a quick overview of the law in the area, which can provide a good starting point for those who are unfamiliar with copyright law. This treatise is also available on Westlaw under the database identifier *COPYLPB*.

5. Copyright Law and Practice

Volume 2, chapter 15 of William F. Patry's *Copyright Law and Practice*[23] is devoted to copyright litigation, including a discussion of remedies for copyright infringement actions. As such, it provides only a brief synopsis of the differing types of remedies available in the approximately thirty pages covering the topic. The treatise is updated annually by a cumulative supplement. As the focus of the treatise is more on the interpretation of the Copyright Act and its legislative history, the treatise does not provide much help for practitioners at the remedies stage of litigation. Although appellate courts have occasionally cited this treatise, it does not have the reputation of *Nimmer on Copyright* in the area.

F. *Remedies in Patent Infringement Actions*

1. Chisum on Patents

Volume 7, chapter 20 of Donald S. Chisum's *Chisum on Patents*[24] deals exclusively with remedies for patent infringement. This chapter is extensive with over 760 pages devoted to remedies in patent actions. Although the treatise does not deal with computers and related technology in any particular manner, it does cite cases involving technology while discussing more general patent litigation issues. It is updated on an irregular basis by cumulative supplements and new loose-leaf inserts, with these updates being released approximately five times per year.

On the whole, although this treatise is intended for use by practitioners, it has an extremely lengthy historical overview of remedies for patents.[25] Of particular usefulness to practitioners are §§ 20.03 and 20.04 of the chapter, which set forth the available forms of monetary relief and

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22. JOHN W. HAZARD, JR., COPYRIGHT LAW IN BUSINESS AND PRACTICE (1989). LC KF2994.

23. 2 WILLIAM F. PATRY, COPYRIGHT LAW AND PRACTICE § 15 (1994). LC KF2994.

24. 7 CHISUM, *supra* note 6.

25. *See id.* at § 20.02.

injunctive relief. Like other Matthew Bender treatises, subjects are arranged in a useful outline format. Each section is broken down into further subsections describing in detail the alternative theories for damages as set forth in various Supreme Court and Federal Circuit decisions.[26] Cases are quoted at length and this detracts somewhat from the treatises overall usefulness as a research tool. However, courts cite this treatise frequently as an authoritative source on patents and, as such, practitioners can also directly cite it in court documents. This Matthew Bender treatise is also available online through LEXIS under the database called *Chisum on Patents*.

2. Patent Litigation Procedure and Tactics

Volume 3, chapter 9 of Robert A. White's *Patent Litigation: Procedure and Tactics*[27] addresses damages for patent infringement extensively,[28] with over 170 pages devoted to this area. Although the treatise does not deal with computer technology in any particular manner, it does cite to cases involving technology in discussing more general patent litigation issues. It is updated on an irregular basis by cumulative supplements and loose-leaf inserts, with these updates being released approximately biannually.

As this treatise is intended for use by those specializing in patent litigation, it is extremely useful to practitioners.[29] Like other Matthew Bender treatises, subjects are arranged in a useful outline format. Each section is broken down into further subsections describing in detail the alternative theories for damages as set forth in various Supreme Court and Federal Circuit decisions. Most propositions are supported by string cites to many cases. Because courts do not cite this treatise frequently as an authoritative source, it should not be cited by practitioners in court documents. This Matthew Bender treatise is also available online through LEXIS under the database called *Patent Litigation Procedure & Tactics*.

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26. As all patent appeals from Federal district court decisions are to the U.S. Court of Appeals for the Federal Circuit, these circuit court decisions are the authoritative source for patent law.

27. 3 ROBERT A. WHITE, PATENT LITIGATION: PROCEDURE & TACTICS § 9 (1971). LC KF3155.

28. Preliminary and permanent injunctions are also addressed to a lesser extent in §§ 4.05 and 8.04, respectively.

29. In fact, the LEXIS version expands upon the print version of the treatise and offers additional information, including a section addressing the effect of taxes on damage awards. *See* 2–9 WHITE, *available at LEXIS*.

3. Patent Law Perspectives

Chapter 5 of Martin J. Adelman's *Patent Law Perspectives*[30] deals exclusively with remedies for patent infringement, with over 150 pages devoted to the subject. Although the treatise does not deal with computers and related technology in any particular manner, it does cite to cases involving technology when discussing more general patent litigation issues. It is updated on an irregular basis by cumulative supplements and new loose-leaf inserts, with these updates being released approximately three times per year.

As this chapter provides a good overview of the theories for patent remedies, it is a good place for practitioners to start. Like other Matthew Bender treatises, subjects are arranged in a useful outline format. Each section is broken down into further subsections describing in detail the alternative theories for damages as set forth in various Federal appellate decisions. Courts do cite to this treatise on occasion, but not with the regularity of more authoritative works like *Chisum on Patents*. This Matthew Bender treatise is also available online through LEXIS under the database called *Patent Law Perspectives*.

4. Walker on Patents

In Ernest B. Lipscomb's *Walker on Patents*, Volume 7, chapter 25[31] and volume 8, chapter 27[32] set forth injunctive and damages remedies in patent infringement actions, respectively. These chapters are 350 pages combined, but because the main text is somewhat dated, citations to cases dealing with more recent technology can be found in the pocket part supplements found at the back of these volumes. The treatise is updated by pocket parts every December.

Though somewhat dated, this treatise can be of some use to current practitioners. Chapter 25 sets forth the law relating to temporary injunctions in §§ 25:4–25:32, then addresses permanent injunction remedies in §§ 25:33–25:47. The chapter dealing with damages has a number of subsections devoted to the historical development of this area, dating back to English law.[33] More useful to practitioners are §§ 27:11 to 27:50 of the chapter, which set forth the general theories and tests under which damages are calculated. However, reference to the supplement is necessary to get more recent and relevant cases. Federal appellate courts do cite this

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30. 4 Martin J. Adelman et al., Patent Law Perspectives § 5 (2d ed. 1982). LC KF3110.

31. 7 Ernest Bainbridge Lipscomb III, Walker on Patents § 25 (3d ed. 1988). LC KF3114.

32. 8 *id*. at § 27.

33. *See id*. at §§ 27.2–27.10.

treatise frequently as an authoritative source on patents and, as such, practitioners can directly cite it in court documents as well. This treatise is not available through LEXIS or Westlaw.

5. Patent Law Fundamentals

Volume 3, chapter 17, § 17.08 of Peter D. Rosenberg's *Patent Law Fundamentals*[34] sets forth a summary of remedies in patent infringement actions, as part of a chapter devoted to patent litigation more generally. This section is around seventy pages, and provides a good overview of the general remedy theories, along with citations to recent cases. The treatise is in loose-leaf format and updated three times a year in March, June and October.

The sections of the text are further divided into subsections, and subjects are arranged in a useful outline format. The treatise extensively cites case law for its propositions and thus should be useful to practitioners as a starting point for research. Federal appellate courts do cite this treatise frequently as an authoritative source on patents and as such it can be cited directly in court documents by practitioners as well. This treatise is not available through LEXIS or Westlaw.

6. Patent Law: A Practitioner's Guide

Ronald B. Hildreth's *Patent Law: A Practitioner's Guide*[35] is a single volume treatise on patent law. The treatise does not address remedies for patent infringement at any length and is of no real use to those doing research in this area. The treatise is updated by loose-leaf pages annually each December. This PLI treatise is also available online through LEXIS under the database called *Patent Law: A Practitioner's Guide*.

G. *Remedies in Trademark Infringement Actions*

1. McCarthy on Trademarks and Unfair Competition

Volume 5, chapter 30 of J. Thomas McCarthy's *McCarthy on Trademarks and Unfair Competition*[36] contains an extensive discussion of the available remedies for trademark infringement and unfair competition. This chapter is approximately 200 pages, and concisely sets forth the varying types of remedies available, such as injunctive relief, preliminary injunctions and monetary damages. The treatise also contains

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34. 3 PETER D. ROSENBERG, PATENT LAW FUNDAMENTALS § 17 (2d ed., West Group 2001). LC KF3114.

35. RONALD B. HILDRETH, PATENT LAW: A PRACTITIONER'S GUIDE (3d ed. 1998). LC KF3114.

36. 5 MCCARTHY, *supra* note 7.

sample court documents and forms that are useful in the damages stage of a trial. It is updated by loose-leaf pages on a quarterly basis, with new releases in March, June, September and December. Although the treatise does not address problems particular to the application of trademark law remedies to trademarked software or internet domain names containing trademarks, it does set forth the more general scheme for remedies in trademark infringement actions.

Overall, this treatise provides a good introduction and starting point for practitioners. This Matthew Bender treatise contains only sections, and the numbering system is not broken down into further subsections. However, the titles of the sections contain hyphens and double-hyphens indicating if the section contains information that is a subset of the previous section. Appellate courts cite this treatise often as an authoritative source on trademark law and, as such, it can be cited directly in court documents by practitioners as well.

McCarthy on Trademarks and Unfair Competition is also available online through Westlaw under the database called *MCCARTHY*. This electronic version allows for boolean and natural language searching. When searching using boolean terms and connectors, one can limit the search to only the chapter dealing with remedies by inserting *ti("s 30")* in the search box.[37]

2. Trademark Protection and Practice

Volume 1a, chapter 8, §§ 8.07 and 8.08 of Jerome Gilson's *Trademark Protection and Practice*[38] address injunction and damage remedies for trademarks and are approximately 100 pages in length. Although the treatise does not deal with computer technology in any particular manner, it does cite to cases involving technology in discussing more general patent litigation issues. It is updated biannually, in May and December by supplements and loose-leaf inserts.

Although this treatise has only brief sections analyzing available remedies, it can be an invaluable source for statutory research. For instance, it has an extensive legislative history for the Lanham Federal Trademark Act[39] and uniform codes for state trademark acts. Like other Matthew Bender treatises, subjects are arranged in a useful outline format. Courts do cite this treatise regularly as an authoritative source on

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37. For example, a simple boolean search using *TI("S 30") & COMPUTER* will return five documents, three of which deal with damages for video games, computer chips, and criminal penalties for counterfeiting labels for computer programs.

38. 1a JEROME GILSON, TRADEMARK PROTECTION AND PRACTICE §§ 8.07–8.08 (1992). LC KF3180.

39. *See infra* Part IV.G.

trademarks and as such it can be cited directly in court documents by practitioners as well.[40] This Matthew Bender treatise is also available online through LEXIS under the database called *Gilson on Trademark Protection and Practice*.

3. Trademark Law: A Practitioner's Guide

Chapter 16 of Siegrun D. Kane's *Trademark Law: A Practitioner's Guide*[41] sets forth the law as to injunctive and monetary relief in trademark enforcement litigation. This chapter, which is approximately forty pages, does not address issues specific to the internet and other technology. However, chapter 10 does address the interaction of trademark law and the internet, with § 10:6.4 setting forth the remedies available for infringement on the internet. The treatise is updated by loose-leaf pages on an annual basis, around October. This treatise is well organized, but lacks the depth of other treatises in this area of law, especially when setting forth the remedies available where new technology is involved.[42] This PLI treatise is also available online through LEXIS under the database called *Trademark Law*.

H. *Useful Treatises for Remedies in Trade Secret Litigation Involving Technology*

1. Milgrim on Trade Secrets

Volume 4, chapter 15, § 15.02 Roger M. Milgrim's *Milgrim on Trade Secrets*[43] deals exclusively with remedies in trade secret litigation. This section is extensive with over 110 pages devoted to damages in trade secret actions. Although the treatise does not deal with computer technology in any particular manner, it does cite to cases involving technology in discussing more general trade secret litigation issues. It is updated three times a year on an irregular basis by cumulative supplements and new loose-leaf inserts.

Like other Matthew Bender treatises, subjects are arranged in a useful outline format. Each section is broken down into further subsections describing in detail the alternative theories for damages as set forth in various Federal and state appellate courts. Courts cite this

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40. In fact, the treatise indicates when a court decision has cited the treatise for a given proposition. *See*, *e.g.*, 3 GILSON § 8.07 n.14.

41. SIEGRUN D. KANE, TRADEMARK LAW: A PRACTITIONER'S GUIDE (3d ed. 1997). LC KF3180.

42. *See id.* at 16–19 n.94 (treatise cites to secondary sources as authority in stating propositions).

43. 4 ROGER M. MILGRIM, MILGRIM ON TRADE SECRETS § 15 (1967). LC KF3197.

treatise frequently as an authoritative source on patents and, thus, practitioners can cite it directly in court documents.[44] This Matthew Bender treatise is also available online through LEXIS under the database called *Milgrim on Trade Secrets*.

2. Trade Secrets Law

Volume 1, chapter 7 of Melvin F. Jager's *Trade Secrets Law*[45] focuses on remedies available in trade secret litigation. The chapter is approximately 130 pages, and sets forth the varying types of remedies available, such as injunctive relief, monetary damages, attorney's fees and seizure or return of stolen trade secrets. It is updated by loose-leaf pages on a biannual basis, with new releases in March and September. Although the treatise does not address problems particular to the application of trade secrets law remedies to technology, it does set forth the more general scheme for remedies in trade secret litigation.

Overall, this treatise provides a comprehensive summary for practitioners. This material is very well outlined using numbering system containing sections and subsections. However, courts rarely cite this treatise as an authoritative source on trade secret law and practitioners should likewise refrain from doing so in court documents. This Matthew Bender treatise is not available on LEXIS or Westlaw.

3. Pooley on Trade Secrets

Chapter 7 of James Pooley's *Trade Secrets*[46] is devoted to remedies available in trade secret litigation. The chapter is approximately fifty pages, and sets forth the varying types of remedies available. It is updated by loose-leaf pages on a biannual basis. As this one volume treatise has been published recently, most of the more recent cases cited do involve high technology, although the treatise only sets forth the more general scheme for remedies in trade secret litigation.

Overall, this treatise provides a good starting point for researching practitioners. It follows a more basic outline format than that of other Matthew Bender treatises. As courts have not cited to this treatise as an authoritative source on trade secret law, practitioners should likewise refrain from doing so in court documents. This treatise is not available on LEXIS or Westlaw.

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44. In fact, the treatise indicates when a court decision has cited the treatise for a given proposition. *See id.* at 15–123 n.10.

45. 1 MELVIN F. JAGER, TRADE SECRETS LAW § 7 (West Group 2002) (1985). LC KF3197.

46. JAMES POOLEY, TRADE SECRETS § 7 (2002). LC KF3197.

4. Trade Secrets: A Practitioner's Guide

Chapter 13 of Henry H. Perritt's *Trade Secrets: A Practitioner's Guide*[47] sets forth the law as to injunctive and monetary relief in trade secret enforcement litigation. This chapter, which is approximately seventy pages, does not address issues specific to the internet and other technology. The treatise is updated annually by a cumulative supplemental issue. This treatise does not follow an outline format, and lacks the depth of other treatises in this area of law, especially when setting forth the remedies available where new technology is involved. This PLI treatise is available online through LEXIS under the database called *Trade Secrets—A Practitioner's Guide*.

I. *Treatises on Laws Applicable to Computer Software and Other Technology*

1. Scott on Computer Law

Volume 1 of Michael D. Scott's *Scott on Computer Law*[48] is a two-volume treatise on computer law. As part of a chapter devoted to the application of copyright laws to computers, Chapter 3, § 3.48 addresses remedies available under copyright law. Likewise, chapter 4, § 4.25 sets forth the remedies available under patent laws. Chapter 4A, § 4A.18[C] summarizes remedies available under trademark law. Chapter 5, § 5.20 examines remedies available under the Semiconductor Chip Protection Act (SCPA). Finally, chapter 6, § 6.18 addresses remedies available under trade secret law. These sections combined are approximately fifty pages. The treatise is updated by loose-leaf pages on an annual basis, near the beginning of each year. This treatise addresses the issues regarding the application of IP laws to computers and sets forth how the remedial schemes of IP laws translate to this area.

This treatise provides a comprehensive analysis for practitioners and sets forth particular problems in applying different IP law remedies to computer related litigation. The sections dealing with copyright, patent and SCPA remedies are the most extensive. The topics are organized in a very useful outline format. Each chapter first addresses business considerations under a particular legal scheme and then sets forth procedures and laws applicable to litigation under the scheme. Citations to cases are numerous and provide in depth detail.[49] However, courts do not cite this

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47. HENRY H. PERRITT, JR., TRADE SECRETS: A PRACTITIONER'S GUIDE (1994). LC KF3197.

48. SCOTT, *supra* note 8.

49. For example, the footnotes indicate the various tests applied by different Circuit Courts within the Federal system. *See*, *e.g.*, SCOTT, *supra* note 8, at § 3.48[A] n.1127.

treatise often as an authoritative source and practitioners should therefore refrain from doing so as well. This Aspen treatise is also available online through LEXIS under the database called *Scott on Computer Law*.

2. Computer Software Protection/Liability/Law/Forms

L.J. Kutten's *Computer Software Protection/Liability/Law/Forms*[50] is a multi-volume treatise that addresses various legal considerations in developing and protecting computer software. Each chapter addresses the protection of software under an intellectual property regime. Volume 1, chapter 2, § 2.07[7] is devoted to remedies under copyright law. Volume 1, chapter 3, § 3.05[1] has parts dealing with remedies under patent law. Volume 1, chapter 4, § 4.04[4] and [6] deal with remedies under various trade secret laws. Volume 1, chapter 4A, § 4A.04 gives an overview of the intersection between trademark law and software and the remedies available under trademark law. Finally, Volume 2, chapter 15, § 15.04 addresses the range of potential remedies for software misappropriation more generally, as part of a chapter devoted to issues specific to software litigation. These sections total approximately forty pages and set forth in simple terms the remedies available under various legal schemes. It is updated by loose-leaf pages biannually at irregular times.

Overall, the material is very well outlined. This treatise provides a quick overview of the remedies available for software misappropriation, although its focus is more on commercial laws and their application to the development and sale of software. However, courts rarely cite this treatise as an authoritative source on trade secret law and practitioners should likewise refrain from doing so in court documents. This treatise is not available on LEXIS or Westlaw.

3. The Law of Computer Technology

Raymond T. Nimmer's *The Law of Computer Technology*[51] examines the application of various laws, such as copyright, patent and trade secret, to computer related technologies. As part of an overview of applicable laws, the treatise addresses the types of remedies available for software misappropriation or infringement. Chapter 1, ¶ 1.29 sets forth remedies under copyright law. Chapter 2, ¶ 2.20 addresses remedies under patent law. Chapter 3, ¶¶ 3.14 and 3.15 set forth remedies under trade secret law. These paragraphs, in combination, are approximately fifteen

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50. L.J. KUTTEN, COMPUTER SOFTWARE PROTECTION/LIABILITY/LAW/FORMS (West Group 2002) (1987). LC KF3024.

51. RAYMOND T. NIMMER, THE LAW OF COMPUTER TECHNOLOGY (3d ed. 1997). LC KF390.5.

pages. This treatise is in loose-leaf format, but currently is updated three times per year. As this treatise only provides a cursory overview of remedies, it is not very useful for research in this area. It is not available on LEXIS or Westlaw.

4. Computer Software Protection Law

Computer Software Protection Law[52] by Cary H. Sherman et al. is a two-volume treatise dealing with the application of varying intellectual property laws to computer software. Unfortunately, this treatise has not been updated since 1991 and is currently out of print. The treatise is divided into differing series, including copyrights, patents, and trade secrets, and each series is devoted to a legal scheme under which protection may be sought.[53] Also, one series is devoted to protection available under the SCPA. Within each area of law, different remedies are addressed. Remedies under copyright law are in chapter 211. Remedies under trade secret law in chapter 315 deal with injunctive relief, while chapter 316 deals with damages, and chapter 317 addresses criminal liability. Chapter 407, § 407.2 discusses remedies for patented software. Remedies available under the SCPA are addressed separately in chapter 510.

Subjects are arranged in a useful outline format. Each section is broken down into further subsections describing in detail the alternative theories for damages as set forth in various Federal and state appellate courts. It is in loose-leaf format, with annual updates available until 1991. This treatise cites numerous appellate cases and statutes for its propositions, and may still be of use to a practitioner doing research in this area, despite the fact that it is somewhat dated. However, this source is not cited by courts and thus should not be relied upon as an authority in court documents. This treatise is not available on LEXIS or Westlaw.

5. Bender's Computer Law

David Bender's *Computer Law*[54] is a multi-volume treatise focusing on the application of laws to computers. Even though the treatise does address the different types of legal protections available under the laws of copyright, patent and trade secret, the treatise addresses remedies available under these laws only in a cursory fashion. As such, reference

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52. CARY H. SHERMAN, ET AL., COMPUTER SOFTWARE PROTECTION LAW (1989). LC KF3024.

53. For example, chapters dealing with copyright are in the 200 series, chapters dealing with trade secrets are in the 300 series, and chapters dealing with patents are in the 400 series.

54. DAVID BENDER, COMPUTER LAW (Matthew Bender 1988) (previously published in 1978 as *Computer Law: Evidence and Protocol*). LC KF8947.

to this treatise will not provide much aid to those doing research in this area. It is updated by loose-leaf pages on a biannual basis. It also follows an outline format, but not to the same depth as other Matthew Bender treatises. This treatise is available on LEXIS under the database *Computer Law*.

J. *Finding Books & Bibliographies*

1. Using Library Catalogs to Find Books & Bibliographies

Most law school libraries and public law libraries have online catalogs accessible via telnet or the Internet. There are three all-encompassing catalogs: RLG's Eureka Catalog,[55] OCLC's WorldCat,[56] and Indiana University's Virtual Law Library.[57] These catalogs include holdings of multiple institutions that are available online. Such online catalogs typically employ LC subject headings to describe their various holdings. When conducting an online search of a specific topic, it is best to employ a strategy that combines relevant LC subject headings in a keyword/subject-heading search. For instance, *remedies*, *damages*, *injunctions* and *trial practice* are narrow LC subject headings that can be combined with other headings describing intellectual property in a keyword search to receive narrow results. Relevant IP subject headings[58] include:

- Computer
- Computer—Law and legislation
- Computer Files
- Computer Files—Law and legislation
- Computer Networks—Law and legislation
- Computer Software
- Computer Software—Accounting—Law and legislation
- Computer Software—Law and legislation
- Copyright—Cases—United States
- Copyright—Computer Files

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55. RLG's Eureka Catalog, *available at* http://eureka.rlg.org. A subscription is required.

56. OCLC FirstSearch, *available at* http://www.worldcat.org. A subscription is required.

57. Indiana University's Virtual Law Library, *available at* http://www.law.indiana.edu/v-lib/index.html. This is a free service.

58. This list is an exhaustive one. The researcher should narrow the potential search terms based on the type of case (i.e. copyright, patent, trademark) and the type of computer technology in dispute.

- Copyright—Computer Programs—United States—Trial Practice

- Copyright—Computer Software

- Copyright Infringement

- Intellectual Property

- Internet—Law and legislation

- Internet Domain Names—Law and legislation

- Patent infringement

- Patent infringement—Law and legislation

- Patent laws and legislation

- Patent suits

- Patents

- Patents—Law and legislation

- Patent Infringement—United States

- Software protection—Law and legislation—United States

- Software Compatibility—Law and legislation

- Technology—Information services—Law and legislation

- Technology and law

- Technology transfer—Law and legislation

- Trademark Infringement—United States

- Trademark—Law and legislation

- Trade secrets

Depending on the depth of the library's holdings, it may also be useful to include *United States* as a limiting subject heading, thus limiting the search to books that deal with U.S. IP law. For example, in searching for a book dealing with damages from computer software infringement, a good search would be *find ksh computer damages United States* where *ksh* is the term limiting the search to keywords in the subject. Search terms and search capabilities do vary between the various online catalogs.

K. *Useful Books in 2001*

Below is a list of current books that have useful information regarding damages in technology related IP actions. The books are listed in order of usefulness, with the top six being particularly useful because they are updated frequently, or are part of an ongoing series with annual editions.

1. *Handbook of Intellectual Property Claims and Remedies*[59]

2. *Trademark Counterfeiting*[60]

3. *Patent Litigation Strategies Handbook*[61]

4. *Litigating Copyright, Trademark & Unfair Competition Cases for the Experienced Practitioner*[62]

5. *Patent Litigation*[63]

6. *Electronic and Computer Patent Law*[64]

7. *Scoops v. Business-Aide, Inc.: A Case File*[65]

8. *Valuing Intellectual Property and Calculating Infringement Damages: A Nonauthoritative Guide*[66]

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59. PATRICK J. FLINN, HANDBOOK OF INTELLECTUAL PROPERTY CLAIMS AND REMEDIES (2000) (includes loose-leaf with updates and bibliographical references). LC KF2979.

60. TRADEMARK COUNTERFEITING (George W. Abbott, Jr. & Lee S. Sporn eds., 1999) (includes loose-leaf with updates and bibliographical references). LC KF3193.

61. PATENT LITIGATION STRATEGIES HANDBOOK (Barry L. Grossman & Gary M. Hoffman eds., BNA 2000). LC KF3155.

62. BRUCE D. KELLER & D. PETER HARVEY, LITIGATING COPYRIGHT, TRADEMARK & UNFAIR COMPETITION CASES FOR THE EXPERIENCED PRACTITIONER (PLI 1998) (compilation of works presented by lawyers at a PLI conference held in November and December 1998. These conferences are held annually and similar publications are available dating back to 1983). LC KF3195.

63. TOM ARNOLD & LAURENCE H. PRETTY, PATENT LITIGATION 1990 (PLI 1990) (compilation of works presented by lawyers at a PLI conference held in October 1990. These conferences are held annually, and have resulted in similar publications dating back to 1983). LC FK3155.

64. ROBERT GREENE STERNE, ELECTRONIC AND COMPUTER PATENT LAW (PLI 1990) (compilation of works presented by lawyers at a PLI conference held in March 1990 and includes two lectures on damages in patent infringement actions). LC KF3024.

65. HENRY L. HECHT, SCOOPS V. BUSINESS-AIDE, INC. (PLI 1990) (case file was developed for use in pre-trial and trial skills training programs). LC KF8925.

66. JOSEPH A. AGIATO & MICHAEL J. MARD, VALUING INTELLECTUAL PROPERTY AND CALCULATING INFRINGEMENT DAMAGES: A NONAUTHORITATIVE GUIDE (1999) (includes bibliographical references). LC KF2983.

9.   *Valuation of Intellectual Property and Intangible Assets*[67]

10. *Modern Patent Litigation*[68]

PART III: LAW REVIEWS, PERIODICALS, ANNOTATED
LAW REPORTS & RESTATEMENTS

A. *Quick Tips*

American Law Reports (ALRs), articles and periodicals are good secondary sources to supplement treatises.

- ALRs: use searches in Westlaw's online ALR database to find reports that are relevant to your area of interest. A search restricted to ALR titles, such as *TI((Copyright Patent Trademark "Trade Secret" Computer Internet) & (Remedies Damages Injunctions))* is the best method to find relevant reports online.

- Periodical articles: search the Legal Resource Index database online and limit the search to subject headings, by using Library of Congress subject terms enclosed by *IN(___)* in Westlaw or *DESCRIPTORS(___)* in LEXIS.

- If researching trade secret and trademark remedies, consult *Restatement (Third) of Unfair Competition*[69] §§ 35–37, 44 & 45.

B. *Using Annotated Law Reports, Periodicals,
& Restatements For Research*

Before conducting a case law search, it is advisable to supplement research with relevant ALRs, periodical articles, and Restatements of law. Each of these sources has a slightly different focus, and reference to each can be very useful to gain a more complete understanding of available remedies.

1. Finding ALRs Dealing with Remedies
in Intellectual Property Actions

Finding relevant information in ALRs has been characterized as "hit and miss." Reports are usually published in response to a foreseen need

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67. GORDAN V. SMITH & RUSSELL L. PARR, VALUATION OF INTELLECTUAL PROPERTY AND INTANGIBLE ASSETS (2000) (this publication also has a 2001 supplement). LC KF2979.
68. PAUL M. JANICKE, MODERN PATENT LITIGATION (1999). LC KF3155.
69. RESTATEMENT (THIRD) OF UNFAIR COMPETITION (1995). LC KF3195.

in the legal community and normally address specific issues. Each ALR is usually thorough and usually provides a survey of relevant case law, thus making it an invaluable secondary source. As such, an ALR can address issues with much more specificity than treatises. Thus, a practitioner should also conduct a quick search through an ALR database in hopes of saving some time.

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

In constructing such a search, take advantage of the fact that the titles of the reports in the ALR are usually a good description of the subject matter covered. Thus a title search including key terms will retrieve relevant documents without being overbroad like an index search. A title search should include a combination of relevant terms grouped by similar topics. For example, a Westlaw search for all reports on remedies in IP actions involving computer technology should include *TI((Copyright Patent Trademark "Trade Secret" Computer Internet) & (Remedies Damages Injunctions))*. A narrower search would exclude some of these terms covering certain legal areas or certain forms of remedies.

2. Finding Periodical Articles

Recent periodical articles often offer review and analysis of current decisions, new laws, and recent legal problems. Thus, a relevant article can provide useful information for relevant laws that have recently changed. They can also warn the practitioner of new legal pitfalls, and recommend new strategies in approaching legal problems. Although general academic law reviews may contain useful analysis, the bulk of information that will be useful to specialized practitioners will be in bar journals and academic journals that focus exclusively on law and technology. Thus, before conducting a case search, a practitioner should run a quick search through an article database in hopes of finding a recent article that is on point.

The most efficient way to locate articles addressing remedies in IP actions involving computer technology is to use online indexes of periodicals.

a. Using the Legal Resource Index to Find Articles

In researching current trends and issues in IP law remedies, it is most useful to conduct online subject searches in the *Legal Resource Index* (LRI),[70] provided by Gale Publications. This index is updated monthly and covers legal periodicals such as law reviews, bar association journals, legal newspapers, and selected legal articles from various newspapers and periodicals that cover subjects other than law. In addition, the LRI uses LC subject headings, and is available online on Westlaw under a database called *LRI* and on LEXIS under a database called *Legal Resource Index*.[71]

The most efficient method of searching through the LRI for relevant articles is by LC subject headings. For the Westlaw database, enter the library of congress subject headings within the index restriction *IN(____)*. For the LEXIS version, enter the subject heading within the descriptors segment *DESCRIPTORS(_____)*. Also, to further limit a search to more current issues, consider adding a date restriction.[72] Although the search can be further restricted by jurisdiction, doing so is not advisable.[73] Use the search terms *remedies*, *damages*, *injunctions* and *trial practice* with one or more of the relevant topical headings listed below:

- Computer
- Computer Software
- Copyright
- Copyright Infringement
- Intellectual Property
- Internet
- Internet Domain Names

- Patent infringement
- Patents
- Software protection
- Technology
- Trademark infringement
- Trademark
- Trade secrets

For example, a general search on remedies in IP actions involving technology on Westlaw's LRI database would look like *IN(remedies & "intellectual property") & DA(>1990)*.

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70. The print equivalent of this online database is the CURRENT LAW INDEX (Gale Group 2002). LC K33.

71. Even though both databases contain the same raw data, it would appear that Westlaw's method parsing of the data into fields has made it a better search tool than its LEXIS equivalent. On average, the Westlaw database returns more items for a given search than the LEXIS database.

72. For Westlaw, a search limited to articles after 1995 would include *DA(>1995)*. The same restriction in LEXIS would be *DATE(>1995)*.

73. For Westlaw, to restrict the jurisdiction to the U.S., include *SU("United States")*. In LEXIS, include *GEOGRAPHIC-TERMS (United States)*. However, both these restrictions limit searching to those articles that have been explicitly indexed as pertaining to the U.S., and thus the result can omit relevant articles.

b. Using the Current Index to Legal Periodicals to Update an LRI Search

As the LRI is updated on a monthly basis, it may not contain listings of articles published within the last month. The *Current Index to Legal Periodicals* (CILP)[74] provides weekly updates of the LRI, but within a more limited number of publications. It is available online in a searchable form on Westlaw under a database called *CILP*, which maintains the previous eight weekly publications. Although the database does use subject headings, they are few and overly general.[75] To search for articles under relevant headings for research on remedies for IP actions involving technology enter *TO("Computer Law" "Intellectual Property Law" Remedies)* in the search box.

c. Using the Index to Legal Periodicals to Find Articles

Wilson's *Index to Legal Periodicals and Books* (ILPB),[76] an extension of the *Index to Legal Periodicals* (ILP), is a competitor to the LRI. The ILPB does not employ LC subject headings, and, although generally considered inferior as a searching tool, it can be used to find books dealing with damages in IP actions involving technology.[77] In using the ILPB, restrict the search in Westlaw using *IN(___)*, and including one or more of the subject headings below:

- Computers
- Copyright/Computer Software
- Intellectual Property
- Internet
- Domain names
- Electronic Commerce

- Patents
- Patents/Computer Software
- Technology
- Trademarks
- Trade secrets

d. Useful Periodical Articles in 2001

The following is a list of useful law journal and newspaper articles that resulted from one of the above searches in the ILP database in Westlaw. They are ranked in reverse chronological order, as the more recent articles address current issues in the field of intellectual property damages.

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74. CURRENT INDEX TO LEGAL PERIODICALS (Muriel A. Quick & Sue Sorenson eds., Marian Gould Gallagher Law Library, Univ. of Washington 2001).

75. A current list of subject headings can be found online at *http:// lib.law.washington.edu/cilp/revsub.html* (last revised July 2000).

76. INDEX TO LEGAL PERIODICALS & BOOKS (H.W. Wilson Co. ed., 1994) (searchable both in Westlaw under a database called *ILP* and in LEXIS under a database called *Index to Legal Periodicals*. This series in print is a continuation of the ILP series). LC K9.

77. For more on finding books, *see supra* Part II.J.

1.   Alan Ratliff, *It's Not Just About Injunctions Anymore: Money Damages in Intellectual Property Litigation*, CORP. COUNS., Feb. 2000, at A18.

2.   Marion B. Stewart, *Calculating Economic Damages in Intellectual Property Disputes: The Role of Market Definition*, 77 J. PAT. & TRADEMARK OFF. SOC'Y 321 (1995).

3.   Kent Walker, *Federal Criminal Remedies for Theft of Intellectual Property*, 16 HASTINGS COMM. & ENT. L.J. 681 (1994).

4.   Robert B. Dellenbach, *Understanding the Enigmatic: On Infringement Indemnities*, Apr. 27, 1994 L.A. DAILY J. 7, col. 1.

5.   Wendy J. Gordon, *Of Harms and Benefits: Torts, Restitution, and Intellectual Property*, 21 J. LEGAL STUD. 449 (1992).

6.   Jules L. Coleman, *Intellectual Property and Corrective Justice*, 78 VA. L. REV. 283 (1992).

3. Restatements

Restatements are produced by the ALI in hopes of having them adopted as common law by many jurisdictions, a practitioner who finds a relevant restatement section can use it to narrow her search of case law. Restatements are especially useful when the laws vary among jurisdictions, as is the case with state common law.

At present, the only restatement addressing issues within the realm of IP law is the *Restatement (Third) of Unfair Competition*.[78] In particular, chapter 3, §§ 35 to 37 deal with remedies in trademark law, while Chapter 4, §§ 44 and 45 deal with injunctive and monetary relief for misappropriation of trade secrets. As with all restatements, the rules are accompanied by annotations citing cases quoting these rules. These annotations are updated by an annual pocket part. This restatement also has a searchable database version through LEXIS[79] and Westlaw under the identifier *REST-UNCOM*. A good boolean search would incorporate one of the above chapter headings, a term describing the type of relief sought, and a term describing the technology at issue. For example, a

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78. RESTATEMENT (THIRD) OF UNFAIR COMPETITION, *supra* note 69.

79. The restatement can be accessed in three forms: browsing through the table of contents using *Restatement 3d, Unfair Competition, Table of Contents*, searching through the rules sections using *Restatement 3d, Unfair Competition, Rule Sections*, or searching through the annotations using *Restatement of the Law—Unfair Competition—Case Citation*.

search for injunctive relief for computer trade secrets would be *"s. 44" & COMPUTER*.

Like treatises, finding restatements can be difficult. A keyword/title search in an online library catalog for the term *restatement of the law* may provide a listing of current and old versions of restatements available. Typically, recent and relevant restatements can also be found online on LEXIS[80] and Westlaw.[81]

PART IV: STATUTES & LEGISLATIVE HISTORY

A. *Quick Tips*

Where treatises or cases do not provide adequate analysis of new statutes or legal problems surrounding new technology, direct reference to the IP law statutes that set forth remedies and their legislative history can prove quite useful. If the remedies differ by jurisdiction, reference to a restatement or uniform code, will prove useful. Refer to annotated statutes, such as the *United States Code Annotated* (*U.S.C.A.*)[82] or the *United States Code Service* (*U.S.C.S.*),[83] for some basic legislative history.

A few statutes that are relevant to remedies are listed and will be discussed below:

- Copyright Act of 1976, 17 U.S.C. §§ 502–509.[84]

- Semiconductor Chip Protection Act (SCPA) of 1984, 17 U.S.C. § 901–914.

- Patent Act of 1952, 35 U.S.C. §§ 281–287.

- Lanham Trademark Act of 1946, 15 U.S.C. §§ 1114–1118 (2000).

- Anticybersquatting Consumer Protection Act (ACPA) of 1999, 15 U.S.C. §§ 1117(d), 1125(d)(2), 1129(2).

- State trade secret law: Uniform Trade Secrets Act with 1985 Amendments § 2–4.

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80. Current restatements are listed under *All Sources*: *Secondary Legal*: *Individual Restatements of Law*.

81. Current restatements can be found in the directory under *Forms, Treatises, CLEs and Other Practice Material: Restatements of the Law & Uniform Laws*.

82. UNITED STATES CODE ANNOTATED (West 2001). LC KF62.5.

83. UNITED STATES CODE SERVICE (Law Co-op 2000). LC FK62.

84. Some of the legislative history for the Copyright Act of 1976 (P.L. 94-553), include H.R. REP. NO. 94-1476 (1976) and H.R. REP. NO. 94-1733, can be found in 17 U.S.C.S. Appendix.

B. *Using Statutes and Legislative History for Research*

For the most part, IP laws are rooted in the U.S. Code and state statutes. Remedies available under various legal schemes, such as copyright, patent, trademark and trade secret, are typically codified as part of the whole set of statutory laws governing an area. At times, these statutory remedies may be a simple codification of case law, or to the contrary, it may be the result of the legislative body's express intent to overturn the rule set forth by common law. Reference to a statute's legislative history will provide a better idea of the reasoning behind the statute's structure and thus will give the researcher a better sense of how the statute should be applied to a new legal problem.

Due to technology's constant evolution, familiar sources such as business practices used to fund and finance new technology ventures, previous case law, or analysis provided by learned treatises, may prove insufficient to address newly arising ambiguities. Understanding the underlying theory of the remedial scheme will prove very helpful in setting forth a solution that will withstand judicial scrutiny. Legislative history can also be extremely helpful where a statute has been enacted very recently and thus there is little, if any, case law to provide analysis as to its application.

C. *Finding Relevant Statutes and Legislative History*

Finding the full text of IP statutes is relatively easy. Although treatises dealing with remedies under various IP regimes will undoubtedly refer to the relevant statutes, these sections of the Code can be located independently. As copyrights, patents and trademarks are within the Federal government's domain, reference to the general index of either the *U.S.C.A.*[85] or the *U.S.C.S.*[86] is a good starting point to find the relevant sections of the U.S. Code. For the *U.S.C.A.* General Index, look under the main types of law, such as Copyrights, Patents, or Trademarks and Trade Names. Then look under the headings and subheadings such as Damages Infringement, Injunctions and Remedies. The index will refer to the U.S. Code title and sections that deal with remedies under the particular IP regime. As an additional measure, one should look for entries dealing with the specific technology at issue, such as software, semiconductor computer chips, etc., as there may be specific legislation. A similar search can be done using the *U.S.C.S.* General Index, again looking under the main types of law, such as Copyright and Literary Property, Patents, or Trademarks, and then looking under the headings

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85. U.S.C.A., *supra* note 82.
86. U.S.C.S., *supra* note 83.

Damages, Infringement, Injunctions and Remedies. For example, in seeking the sections of code dealing with remedies under copyright, look in the *U.S.C.A.* General Index under Copyrights, locate Infringement, then Remedies, and then Damages and profits: 17 § 504[87] and Injunction: 17 § 502.[88]

Although the *U.S.C.A.* and *U.S.C.S.* are great sources for current code, their annotations provide only limited legislative history. The *U.S.C.A.* provides revision notes and summaries of relevant legislative reports published at the time of each statutory section's enactment. It also notes any amendments and related reports. For more legislative history, the *U.S.C.A.* cites to *U.S. Code Congressional and Administrative News* (*U.S.C.C.A.N.*).[89] Finally, the *U.S.C.A.* lists secondary sources and notes of decisions relevant to each section of the statute, arranged by topic. The U.S.C.A. can also be found online on Westlaw under a database called *USCA*.

The *U.S.C.S.* also provides some legislative history on sections of the Code, but is much more inconsistent in doing so. For some sections, the full text of prominent legislative reports is provided, while for others, no legislative history is mentioned. Like the *U.S.C.A.*, the *U.S.C.S.* lists the enactments of amendments to the statutes and how they changed the statute. It also contains citations to relevant secondary sources and case law, arranged by topic. The *U.S.C.S.* can also be found online on LEXIS under a database called *USCS—United States Code Service; Code, Const, Rules, Conventions & Public Laws*.

To conduct an in-depth study of the legislative history, look for pre-compiled legislative histories either in treatises or by the Congressional Information Service (CIS). Although a print version of the CIS Index is available, it is preferable to search for relevant materials on the CIS Index database, available online through http://web.lexis-nexis.com/congcomp, either under *US—CIS Legislative Histories* for statutes enacted after 1970, or *CIS/Historical Index* for statutes enacted before 1970. Searching for the legislative history is best done by searching using a statute's public law (P.L.) number. To find relevant history on remedies, enter the relevant P.L. numbers for the section on remedies, as indicated in either the *U.S.C.A.* or *U.S.C.S.*, within the segment *PL(___)*. Such a search will reveal any compiled legislative history associated with the law. For example, the Copyright Act of 1976 was passed as P.L. 94-553. Thus, to search for the Act's legislative history, search *US—CIS Legislative Histories* with *PL(94-553)* as the search term. One of the

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87. 7 U.S.C.A. § 504, *supra* note 82.

88. *d.* at § 502.

89. U.S. Code Congressional and Administrative News (West 2001). LC KF48.

documents will be *LEGISLATIVE HISTORY OF: P.L. 94-553, Copy-rights, CIS-NO: 76-PL94-553*.

Generally, histories will include: document numbers starting with an "H," referring to Congressional House Reports, Committee Reports and Hearings; document numbers starting with an "S," referring to Congressional Senate Reports, Committee Reports and Hearings; and references to a Congressional Record Volume that contains records of debates on the law before it was enacted.[90] Some of these materials may be available online on LEXIS, and are normally linked to the legislative history reference numbers. If not online, these documents can be found: as part of the *Congressional Information Service*[91] for documents from 1970 and on; as part of the *CIS Serial Set*;[92] or as part of the permanent *Congressional Record*. All three sources are on microfiche and are usually available at law school libraries or public law libraries. Abstracts are also available in text as part of the yearly *CIS Annual Abstracts*[93] and indicate the subject matter, any witnesses who testified at hearings, and other important information.

Searches for legal histories can also be done through Westlaw under a database called *LH*. Like CIS, searching by P.L. number is preferable. To do so, enter the relevant P.L. numbers for the section on remedies, as indicated in either the *U.S.C.A.* or *U.S.C.S.*, within the segment *TO(___)*. LH also refers to congressional reports, but does not indicate CIS accession numbers to the full text of these documents. However, it does provide a summary of the documents listed.

Beyond these online databases, compiled legislative histories can be found using Nancy P. Johnson's *Sources of Compiled Legislative Histories*,[94] which is updated annually. This index provides a listing of compiled legislative histories located in various sources, organized by P.L. number. Included with the listing is a chart indicating what types of documents are included as part of the history.

D. *Copyright Law: Remedial Statutes and Their Legislative History*

The Copyright Act of 1976 was the last major revision of the Act. Amendments to 17 U.S.C. §§ 502–509 since 1976 have made only minor changes, like increasing the period in which an action must be

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90. For an example, *see infra* Part IV.D.

91. CIS ANNUAL (1970). LC KF49.

92. UNITED STATES CONGRESSIONAL SERIAL SET (Gov't Printing Office ed., 1817). LC KF12.

93. CIS ANNUAL ABSTRACTS (Joyce Ball et al. eds.). LC KF49.

94. NANCY P. JOHNSON, SOURCES OF COMPILED LEGISLATIVE HISTORIES (Am. Ass'n of Law Libraries, Publ. Series No. 14, 2000). LC KF42.

commenced and the amount of statutory damages. An extensive history of the development of U.S. copyright law, both before and after the Copyright Act of 1976, can be found in Volumes 7 to 10, Appendices 1 through 29 and 32 through 45 of *Nimmer on Copyright*.[95] The legislative debates and documents that refer to the Act are the following:

- Bill: 94 S. 22.

- Statute at Large: Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2584.

- Debate:

    - 122 CONG. REC. 94,2734 (1976) (Senate consideration and passage).

    - 122 CONG. REC. 94,3097 (1976) (Senate consideration and passage).

    - 122 CONG. REC. 94,3240 (1976) (Senate consideration and passage).

    - 122 CONG. REC. 94,3488 (1976) (Senate consideration and passage).

    - 122 CONG. REC. 94,3715 (1976) (Senate consideration and passage).

    - 122 CONG. REC. 94,31751 (1976) (Senate amendment consideration and passage).

    - 122 CONG. REC. 94,33777 (1976) (Senate and House agreement regarding conference report).

- Documents and Hearings:

    - S. REP. NO. 91-1219 (1970).

    - *Copyright Act of 1976: Hearing on S. 1361 Before the Senate Comm. on the Judiciary*, 93rd Cong. (1973).

    - S. REP. NO. 93-1035 (1974).

    - S. REP. NO. 93-983 (1974).

    - S. REP. NO. 94-473 (1975).

    - *Copyright Act of 1976: Hearing on H. 2223 Before the House Comm. on the Judiciary*, 94th Cong. (1975).

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95. *See* NIMMER, *supra* note 5. *See also supra* text in Part II.E.1.

- *Copyright Act of 1976: Hearing on S. 1111 Before the Senate Comm. on the* Judiciary, 94th Cong. (1975).

- H.R. REP. NO. 94-1476 (1976).

- H.R. REP. NO. 94-1733 (1976).

E. *The Semiconductor Chip Protection Act: Remedial Statutes and Their Legislative History*

The SCPA was enacted as Title III of P.L. 98-620, to provide copyright protection for electronic designs embodied in computer semiconductor chips. The legislative debates and documents that include the SCPA are the following:

- Bill: H.R. 6163, 98th Cong. (1984).

- Statute at Large: Semiconductor Chip Protection Act of 1984, Pub. L. 98-620, 98 Stat. 3335 (1984).

- Debate:

    - 126 CONG. REC. 18,757–60 (1980) (Senate consideration and passage of S. 2387).

    - 128 CONG. REC. 20,107–14 (1982) (Senate consideration and passage of S. 537).

    - 130 CONG. REC. 12,428–33 (1984) (Senate consideration and passage of S. 1201).

    - 130 CONG. REC. 12,999–13,007 (1984) (House consideration of H.R. 4145).

    - 130 CONG. REC. 13,363 (1984) (House consideration and failure to pass H.R. 4145).

    - 130 CONG. REC. 15,651–59 (House consideration and passage of H.R. 5525).

    - 130 CONG. REC. 15,687–89 (House passage of S. 1201 and tabling of H.R. 5525.).

    - 130 CONG. REC. 17,930-39 (1984) (Senate consideration and passage of S. 384).

    - 130 CONG. REC. 22,365–67 (1984) (House consideration and passage of H.R. 4222).

    - 130 CONG. REC. 26,571–72 (1984) (House consideration and passage of H.R. 6163).

- • 130 CONG. REC. 28,076–78 (1984) (House consideration and passage of H.R. 6285).

- • 130 CONG. REC. 28,952–74 (1984) (Senate consideration and passage of H.R. 6163 with amendments).

- • 130 CONG. REC. 30,931–56 (1984) (House concurrence in the Senate amendments to H.R. 6163).

- • Documents and Hearings:

  - • S. REP. NO. 98-425 (1984).

  - • H.R. REP. NO. 98-781 (1984).

  - • *Semiconductor Chip Protection Act of 1983: Hearing on S. 1201 Before the Subcomm. on Patents, Copyrights and Trademarks of the Sen. Comm. on the Judiciary*, 98th Cong. (1984).

  - • *Copyright Protection for Semiconductor Chips: Hearings on H.R. 1028 Before the Subcomm. on Courts, Civil Liberties, and the Admin. Of Justice of the House Comm. on the Judiciary*, 98th Cong. (1984).

Also, House Report No. 98-781[96] and a relevant explanatory memorandum[97] can be found in volume 9, appendices 30 and 31 of *Nimmer on Copyright*,[98] respectively.

F. *The Patent Act of 1952: Remedial Statutes and Their Legislative History*

Although the Patent Act of 1952 was the last major revision of the U.S. patent laws, Congress has continually amended Title 35 of the U.S. Code, which contains these laws, to address new legal and technical issues. Although the CIS system does have some of the documents that are part of the legislation's history,[99] a much more complete set of records

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96. Note: The appendix title incorrectly states the Report No. and the Congressional session.

97. This Explanatory Memorandum, emanating from the House of Representatives, is in effect a conference report by both houses. *See* 9 NIMMER App.31 n.*.

98. *See* NIMMER, *supra* note 5.

99. S. REP. NO. 82-1979 (1952) (revising Title 35, United States Code, entitled Patents); H.R. REP. NO. 82-1923 (1952) (revising Title 35, United States Code, entitled Patents).

can be found in Volume 9, Appendix 19 of *Chisum on Patents*.[100] The same volume also contains, in various appendices, previous legislation and amendments with legislative history since the 1952 Act.

G. *The Lanham Trademark Act of 1946: Remedial Statutes and Their Legislative History*

The Lanham Trademark Act of 1946 is the cornerstone of Federal trademark legislation. The legislative effort culminating in the Trademark Act of 1946 spanned twenty-two years. The record is comprised of well over 3,000 pages of bills, hearings, reports and debates. Yet the Act has been the subject of continuing refinement and revision and, since 1945, Congress has added some 2,000 pages to the materials underlying the evolution of the original forty-five substantive sections.[101]

Although the CIS system does have some of the documents that are part of the legislation's history,[102] a much more complete set of records can be found on LEXIS in Volume 7, chapter I et seq. of Gilson's *Trademark Protection and Practice*, a Matthew Bender publication.[103] The legislative history is divided into eight chapters that span three volumes. As such, the documents are much too voluminous to be listed here.

H. *The Anticybersquatting Consumer Protection Act: Remedial Statutes and Their Legislative History*

The ACPA was intended to prevent against the exploitation of trademark holders by extending the rights of trademark holders to the technology of the internet. The ACPA prevents cybersquatters from registering and using domain names that are the exact same or similar to registered trademarks. The ACPA incorporated remedies already existing under the Lanham Trademark Act and added more. The ACPA was passed in P.L. 106-113 as part of a number of Year 2000 appropriations, and thus debates and hearings about the ACPA are interspersed among voluminous records. The legislative documents relevant to the SCPA are as follows:

- Bill: S. 1255, 106th Cong. (1999).

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100. *See* 9 CHISUM, *supra* note 6, at App. 19.

101. *See* 7-I GILSON, *supra* note 38, at § Scope, *available at LEXIS*, Matthew Bender Library, Trademarks, Unfair Competition & Trade Secrets file.

102. H.R. Rep. No. 79-2322 (1946) (reporting on bill providing for registration and protection of trademarks); S. Rep. No. 79-1333 (1946) (providing for registration and protection of trademarks); and H.R. Rep. No. 79-219 (1946) (providing for registration and protection of trademarks)

103. *See* GILSON, *supra* note 100.

- Statute at Large: Anticybersquatting Consumer Protection Act, Pub. L. No. 106-113, 113 Stat. 1501A-545 (1999).

- Document:
    - S. Rep. No. 106-140 (1999).

I. *Remedies Available Under State Trade Secret Legislation*

The exact nature of remedies available under trade secret law varies by state. However, the Uniform Trade Secrets Act (UTSA), as compiled by the National Conference of Commissioners on Uniform State Laws (NCCUSL), is an effort to have consistency among states. Sections 2 through 5 of the Act, in particular, set forth a remedial scheme which has been adopted by a number of states. The UTSA was amended in 1985, and both pre- and post-amendment versions are in Volume 14 of *Uniform Laws Annotated*.[104] The extent to which these laws have been adopted by particular states is covered in depth in *Trade Secrets: A State-by-State Survey*,[105] which is updated annually. Also, for some history on the Uniform Law's development, one can search the *National Conference of Commissioners on Uniform State Laws'* Archive Publications,[106] which are available on microfiche.

Part V: Case Law

A. *Quick Tips*

Thorough case law research is a fundamental part of determining what the current law is regarding remedies in IP actions. To find relevant cases:

1. Use online databases that contain only the subset of Federal and state case law that may be relevant to your search (i.e. Westlaw's Federal IP cases in *FIP-CS*, or LEXIS' *Computer and Cyberlaw Cases, Combined.*

2. Use a case categorization system like West's Key Number system or LEXIS' Core Concepts system in combination with terms that describe the relevant technology (e.g. *soft-*

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104. 14 U.L.A. 437–67 (1990). LC KF165.

105. Trade Secrets: A State-by-State Survey (Arnold H. Pedowitz & Robert W. Sikkel eds. 1997). LC KF3197.

106. National Conference of Commissioners on Uniform State Laws (William S. Hein & Co., Inc.).

ware, *domain name*) in constructing a search for cases in the online database.

B. *Using Case Law For Research*

While statutes set forth the bare-bone principles for damages in IP actions, cases provide the full body of law surrounding those principles. As the common law formed by cases tends to change over time and adapt to new scenarios and legal problems, good research techniques to find relevant cases are very important. Researching cases provide two useful functions:

1. To confirm and update the analysis provided by credible secondary sources. Thus, proper case research will ensure that the propositions of learned treatises are still valid and can be relied on in making arguments in court documents.

2. To find cases with fact scenarios similar to the case at hand. Previous outcomes in cases that addressed similar or analogous situations can be useful predictors for current litigation.

Finding relevant cases with useful legal analysis is a very important task for researchers. At the same time, given the number of options and methods available to conduct case law research, the task of conducting proper and useful research can be a daunting one.

C. *Finding Case Law*

1. Searching Online Versus Searching in Texts

Finding case law using online case databases is by far a better alternative to conducting research using digests and case reporters in print. Not only do online sources incorporate the categorization provided by digest editors, but they also allow for full text searching of cases. Also, updating print sources often involves the repetitive process of checking through supplements and pocket parts, whereas updates to online databases are fully integrated into the primary source. As the development of remedies in IP cases involving computer technology is a fairly recent legal phenomenon, the traditional concern with electronic sources not including information retroactively[107] is not a major issue in this area of

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107. When created, most electronic databases were well designed to accumulate new case law moving forward. A more difficult task was to include case law published before the existence of the database. Including older case law has only recently become a focal point for electronic database administrators.

case law. Therefore, the rest of this section will discuss how to conduct effective searches using online databases on Westlaw and LEXIS.

Although there are many ways to find relevant case law in online databases, the most effective and cost efficient way to do research is to be very selective in choosing the databases to be included in a search, and to construct searches with very particularized criteria. Choosing a database that is narrow in scope, but that is also inclusive of all cases relevant to IP law, will not only yield more relevant results, but will typically be cheaper to search. Beyond choosing the right database, employing the right search is paramount. To this end, the best searches employ:

1.   Terms or numbers that are part of a categorization system, such as the West Key Number or Lexis Core Terms systems, that identify case law regarding remedies in IP infringement actions;

2.   Boolean search terms to effectively limit the cases retrieved to those dealing with computer related technology; or

3.   A natural language search using phrases to effectively retrieve the most relevant cases.

Each one of these search techniques is explored in more detail below.

2. Online Databases on Westlaw

Although Westlaw has overarching databases containing all Federal and state case law, of more use to practitioners is the variety of case databases stemming from these all-inclusive databases, including databases limited to particular jurisdictions or areas of law. As IP law, with the exception of trade secrets, is predominantly Federal law, choosing a database with a particular subset of Federal cases can tremendously increase the search's efficiency. As lower courts must follow the law as decided by the higher court in the jurisdiction, and as lower court judges tend to render decisions in line with other decisions in their district and circuit, searching in a database containing all the law for a particular Federal district can also be very useful. In Westlaw, databases with case law applicable to a particular Circuit are named *FED_-ALL*, with the number of the Circuit inserted in the blank space.[108]

Topical databases can also be very useful. Westlaw now has databases containing only Federal decisions that relate to IP law. These

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108.   For the D.C. Circuit, the database is *FEDDC-ALL*. For the Federal Circuit, the database is *CTAF*. Circuit court decisions particular to one circuit can be found under databases named *CTA*, with the number of the Circuit inserted in the blank space.

databases include all Federal IP cases in *FIP-CS*, U.S. Supreme Court cases in *FIP-SCT*, Circuit Court cases in *FIP-CTA*, District Court cases in *FIP-DCT*, and the Court of Federal Claims and the Court of Claims in *FIP-FEDCL*. West editors determine which Federal cases are contained in these subsets. Also, the United States Patents Quarterly in *USPQ*[109] contains patent and other IP cases, as determined by BNA.[110]

Since trade secret law is based in common law tort, and not Federal statutory law, searching for remedies based on trade secret misappropriation involving computer technology typically requires searching in the jurisdictional database for applicable state law. In Westlaw, all state law databases are identified by __-*CS*, with the particular state's postal code inserted in the blank space.

3. Using West's Key Number System

Not only does Westlaw contain narrow databases for effective searching, it also employs West's Key Number system within all its searchable case databases. The West Key Number system is the most comprehensive categorization of case law available to researchers. The Key Number system has two parts:

1. Area of law subject heading. Each heading has a corresponding number that appears before the key or its online equivalent "k."

2. Legal topics relevant to the area of law. Each legal topic is given a number that appears after the key or the "k," with further subtopics stemming from more general topics.

Below is a listing of current areas of law and corresponding legal topics that are relevant to damages in IP actions:[111]

Area of Law and Subtopics	Key Number
COPYRIGHT & INTELLECTUAL PROPERTY	99
Copyrights	99(I)
Infringement	99I(J)
Remedies	99I(J)2

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109. United States Patents Quarterly (BNA 1987). LC KF2975.3.

110. As this publication and database is produced by the BNA, it does not employ West's Key Number System, but has its own head note system.

111. A current listing of all key numbers can be found online on Westlaw by clicking on the drop-down menu at the top right corner of the screen and choosing Key Numbers & Digest topics. It can also be found in print form in WEST'S ANALYSIS OF AMERICAN LAW (West Group 2000). LC KF240.

Area of Law and Subtopics	Key Number
Penalties & Actions therefore, and offenses and prosecutions therefore	99k70
Seizure and forfeiture	99k71
Actions for infringement	99k72
In general	99k72.1
Nature of Remedy	99k73
Preliminary injunction	99k85
Permanent relief	99k86
Damages and Profits	99k87
In general	99k87(.5)
Recovery in general; actual damages and profits	99k87(1)
Elements, measure, and amount	99k87(2)
Statutory damages; minimum award	99k87(3)
In general	99k87(3.1)
Amount of recovery; multiple infringements	99k87(4)
Costs	99k90
In general	99k90(1)
Attorney fees	99k90(2)
Intellectual Property	99II
Remedies	99k109
PATENTS	291
Infringement	291(XXII)
Actions at Law	291(XXII)(B)
Nature and form of remedy	291k262
Damages	291k275
Costs	291k279
Suits in Equity	291(XXII)(C)
Nature of remedy	291k280
Preliminary Injunction	291k293
In general	291k293.1
Scope and extent of injunction	291k305
Scope and extent of relief in general	291k316
Permanent injunction	291k317
Profits	291k318
In general	291k318(1)
Profits in addition to damages	291k318(2)
Measure of profits in general	291k318(3)
Entire profits or those attributable to infringement of patent	291k318(4)
In general	291k318(4.1)
Commercial value attributable to infringement	291k318(4.2)
Improvements	291k318(4.3)
Design Patents	291k318(4.4)

Area of Law and Subtopics	Key Number
Process Patents	291k318(4.5)
Interest	291k318(5)
Expenses and other charges against the proceeds	291k318(6)
Damages	291k319
In general	291k319(1)
Nominal damages	291k319(2)
Right to increase damages awarded	291k319(3)
Interest	291k319(4)
Penalties	291k320
Costs	291k325
In general	291k325.1
Amount of recovery	291k325.3
Disbursements in general	291k325.11
In general	291k325.11(1)
Attorney fees	291k325.11(2)
In general	291k325.11(2.1)
Award to plaintiff	291k325.11(3)
Award to defendant	291k325.11(4)
Proceedings for allowance; evidence	291k325.11(5)
TORTS	379
Interference with employment or occupation, or injury to business	379k10
In general	379k10(1)
Misuse of or interference with trade secrets, inventions or patent rights	379k10(5)
TRADE REGULATION	382
Trade-marks & Trade-names & Unfair Competition	382I
Actions	382I(G)
In general	382I(G)1
Nature and form of remedy	382k540
In general	382k540.1
Injunction	382k541
Preliminary or Temporary Injunction	382I(G)4
Order; form and scope of injunction	382k628
Permanent Injunction	382I(G)5
In general	382k641
Scope and extent of relief	382k644
In general	382k644.1
Damages and Profits	382IG6
Right to recovery or accounting	382k671
In general	382k671.1
Damages	382k672
Profits	382k673
Both damages and profits	382k674
Measure and amount of damages	382k680

Area of Law and Subtopics	Key Number
In general	382k680.1
Loss of profits	382k681
Legal expenses and attorney's fees	382k682
Punitive or exemplary damages; treble damages	382k683
Measure and amount of profits	382k684
In general	382k684.1
Deductions and credits	382k685
Accounting period and methods	382k686
Interest	382k687
Judgment and Review; Costs	382I(G)8
Costs	382k728
In general	382k728.1
Attorney's fees	382k729

Although the Key Number system does have numerous key numbers for the areas of copyright, patent and trademark, it does not have the same depth in its treatment of state trade secret law.

The system is a great search tool because each Key Number is an alphanumeric code. Each of these terms is inserted as part of West's headnotes at the beginning of a case. Entering a key number in a search will automatically yield all cases with law relevant to the topic, as determined by West editors. Inserting a Key Number with terms that describe the technology at issue can provide practitioners with decisions of cases similar to the one they currently face. Also, a Key Number with a date restrictor can be used to update analysis of the relevant law as provided by treatises, articles or other sources.

To further simplify the use of the Key Number system in searches, Westlaw has a new search technique called "KeySearch." This system allows the user to delve through the system's hierarchy of topics and, once a topic is selected, a search box allows the user to choose a jurisdiction and add additional search terms. Within this search tool, Westlaw has also tried to fill in some of the gaps of its current Key Number system by creating a search to capture certain legal topics for which a particular Key Number has not been assigned. An example of this is the trade secret area. By choosing *Intellectual Property*, then *Trade Secrets*, Westlaw will generate a boolean query which is used in lieu of a specific Key Number for this topic.

4. Searching for Cases on Westlaw Using Boolean Terms and Connectors

In order to yield relevant results, boolean searches on Westlaw should not include simple connectors like *and* (*&*) or o*r* (*_*) but should use more restrictive connectors like within the same sentence (*/S*) or within the same paragraph (*/P*). Searches should also be limited to recent case law using field restrictions such as date restrictions (*DA(>____)*) and court restrictions (*CO(_____)*). In conducting a general search, combine relevant legal terms, or West Key Numbers, to the terms describing the technology at issue. The following are examples of this methodology.

- To retrieve case law dealing with damages in copyright actions involving computer software:

99k87 & COMPUTER /S SOFTWARE & DA(>1995)

- To retrieve case law dealing with damages in patent actions involving computer technology:

291k262 291k275 291k318 291k319 & COMPUTER & DA(>1995)

- To retrieve case law dealing with remedies in trademark actions involving internet domain names:

(382I(G)4 382I(G)5 382I(G)6) & INTERNET /S DOMAIN & DA(>1995)

5. Online Databases on LEXIS

Like Westlaw, LEXIS has all-inclusive databases containing all Federal and state case law and a variety of case databases stemming from these all-inclusive databases. Subsets include jurisdictional and topical databases. However, the LEXIS topical case databases are narrower in scope than their Westlaw counterparts. Samples of LEXIS databases that include IP law and computer technology are:

- Copyright Cases, Federal

- Computer and Cyberlaw Cases, Combined

- Federal Computer and Cyberlaw Cases, Combined

- State Computer and Cyberlaw Cases

- United States Patent Quarterly by BNA[112]

- Patent Cases from Federal Courts

- U.S. Court of Appeals for the Federal Circuit—Patent Cases

- U.S. Court of Customs & Patent Appeals

- Federal and State Trademark Cases

- Federal Trademark, Unfair Competition, and Trade Secret Cases

- U.S. Court of Appeals for the Federal Circuit—Trademark Cases

- State Trademark, Unfair Competition & Trade Secret Cases

6. Using Lexis's Core Concepts and Core Terms System

Although LEXIS has not developed an elaborate system of categorization like the West Group, it does have three other research tools to help narrow searches. Recently, LEXIS has instituted Core Concepts and Core Terms sections as part of its own summary of a case. Core Concepts are headnotes included by a LEXIS editor and are similar to West's headnotes. Thus, using multiple Core Concepts as part of a boolean search is an effective way to locate relevant cases. Useful topics for researching remedies in IP actions include:

COPYRIGHT LAW
    Infringement
        Damages
        Injunctive Relief
        Costs & Attorney Fees
CYBERLAW
    Copyright
        Damages
        Injunctive Relief
    Trademarks
        Infringement
        Internet Domain Names
E-COMMERCE LAW
    Copyright Protection
        Damages
        Injunctive Relief
    Trademark Protection
        Damages
        Injunctive Relief

E-COMMERCE LAW cont'd)
    Trade Secret Protection
        Trade Secrets
PATENT LAW
    Remedies
    Injunctions
        Damages
        Collateral Assessments
        Bad Faith Enforcement
        Costs & Attorney Fees
TRADEMARK LAW
    Infringement
        Damages
        Injunctive Relief

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112. The *United States Patent Quarterly* database is provided by BNA and does not utilize LEXIS' Core Terms or Core Concepts tools for searching.

By contrast, the Core Terms section is a listing of key words as generated by a computer algorithm, based on the number of times an uncommon word appears in the case's text. The core terms section can also be searched using a field limiter in a boolean search.

7. Searching for Cases on LEXIS Using Boolean Terms and Connectors

Although slightly more complicated than using Westlaw's alphanumeric key system, the LEXIS Core Concepts and Core Terms systems can be utilized using field restrictors to construct a narrow search. Core Concepts should be included in the field *CORECONCEPTS(_____)* while Core Terms should be included in the field *CORE-TERMS(_____).* Like Westlaw, a search can employ other custom restrictions, including date restrictions, in addition to terms that describe the technology at issue to achieve good searches. The following are examples of this methodology:

- To retrieve case law dealing with damages in copyright actions involving computer software:

CORECONCEPTS(Copyright /S Infringement /S Damages) AND CORE-TERMS(Software) AND DATE(>1995)

- To retrieve case law dealing with damages in patent actions involving computer technology:

CORECONCEPTS(Patent /S Remedies /S Damages) AND CORE-TERMS(Computer) AND DATE(>1995)

- To retrieve case law dealing with remedies in trademark actions involving internet domain names:

CORECONCEPTS(Trademark /S Infringement) AND CORE-TERMS(Internet AND Domain) AND DATE(>1995)

8. Searching for Cases on Westlaw or LEXIS Using Natural Language Searching

Westlaw and LEXIS also provide natural language searching as an alternative to boolean searches. A natural language search should consist of a question or phrase that incorporates terms relevant to the subject area being searched. Contrast the above boolean searches with their equivalent natural language searches:

- To retrieve case law dealing with damages in copyright actions involving computer software:

What are the copyright damages for computer software?

• To retrieve case law dealing with damages in patent actions involving computer technology:

What are patent damages for computers?

• To retrieve case law dealing with remedies in trademark actions involving internet domain names:

What are the trademark remedies for internet domain name use?

Part VI: Litigation Materials

A. *Quick Tips*

Litigation reporters offer a more holistic view of disputes and include case developments both inside and outside the courtroom. *Andrews Computer & Online Industry Litigation Reporter*, available on Westlaw as *ANCOILR* and on LEXIS as *Andrews Publications Newsletters— Computer Law*, and *Mealey's Litigation Report: Intellectual Property*, available on Westlaw as *MLRIP* and on LEXIS as *Intellectual Property: Mealey's Litigation Report*, are two such reporters narrowly focused on computer issues and IP issues, respectively. Furthermore, brief reporters, which contain briefs submitted to courts in leading cases, can be invaluable resources for both the law and arguments regarding new computer technology or IP issues. Such reporters include LEXIS' *Brief Reporter* and Westlaw's U.S. Supreme Court briefs, in *SCT-BRIEF*, and California Supreme Court Briefs, in *CA-BRIEF*. Searches in these databases should include keywords such as *copyright*, *patent*, *trademark*, *infringement*, *remedies*, *damages*, *injunction*, *computer*, *software*, *hardware*, *internet*, *domain name*, etc.

B. *Finding Litigation Updates, Brief Reporters & Other Litigation Materials*

Finding litigation reporters is a difficult task, as these publications, which typically focus on a particular area of the law or a particular subject matter, begin and cease depending on market demand for the publication. As such, there are at present a great many publications, most beginning in the 1990s, devoted to reporting litigation concerning IP and computer related technology. Although some of these publications do exist in print form, using this format is not advisable, as these highly specialized journals are not indexed in any effective way. However, as

most of these publications have online database equivalents with searchable text, using boolean or natural language searches to find relevant articles in these databases is a great way to supplement case law research. As Westlaw and LEXIS each organize databases by subject matter, including IP law topics,[113] perusing the list of available sources under these directories is a time-consuming, yet effective, way to find out what litigation reporters are available.

Compilations of briefs are a relatively new phenomenon and, for these reasons, current compilations are not extensive. However, as practitioners recognize their usefulness as research tools, the increase in demand for them will likely cause them to proliferate. To find databases containing such compilations, refer to Westlaw's or LEXIS' litigation topical groupings.[114]

C. *Using Litigation Updates, Brief Reporters, & Other Litigation Materials*

Although case decisions provide a good analysis of the law concerning remedies in IP actions, they are less useful when trying to research the real outcome of litigation in terms of the dollar amount of damages received and the specific injunction instituted. Also, case decisions do not fully address all the arguments presented on both sides of an action, as these holistically would make these decisions even longer than they currently are. For this reason, litigation reporters and updates can provide useful information to practitioners who are looking for guideposts in determining the value of their clients' claims, or the potential liability their client is facing. Also of practical use are litigation materials, such as briefs and motions, from cases that are similar in nature to the one being litigated, as they could provide in-depth arguments and citations to cases that may be of use to practitioners.

D. *Searching Litigation Updates, Brief Reporters, & Other Litigation Materials*

The litigation updates and materials described below are available online in searchable databases on Westlaw and LEXIS. Because these litigation reports do not employ extensive categorization or indexing like case reporters, searching is restricted to simple boolean or natural language searching using key legal concepts like *copyright*, *patent*, *trademark*, *infringement*, *remedies*, *damages*, and *injunction*, with

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113. *See supra* Part I.D.2.
114. For Westlaw, look under *Topical Materials by Area of Practice*: *Litigation*.
       For LEXIS, look under *Litigation*: *Cases*: *Trial Transcripts & Briefs*.

keywords describing technology such as *computer*, *software*, *hardware*, *internet*, *domain name*, etc.

Searches should omit keywords that generally coincide with the reporter's focus. For instance, one should omit *computer* from a search in a computer litigation reporter, as it may unnecessarily restrict searching. However, a search can be narrowed by including terms describing a particular technology of interest, such as *software*. Furthermore, the search should contain some keywords that restrict the cause of action described, thus omitting reports about technology licensing and other contract based claims. For instance, in searching for remedies for software theft, infringement or misappropriation, an effective search in a computer litigation reporter would be, *(damages remedies injunction) & software & (copyright patent trademark "trade secret") /S (infringement theft misappropriat!)*.

E. *Current Litigation Reporters & Brief Reporters*

The following is a list of litigation reporters currently available online on Westlaw or LEXIS:

1. Andrews Computer & Online Industry Litigation Reporter

This reporter tracks computer and internet related disputes, including cases dealing with copyrights, patents and trademarks and trade secrets. It was first published in June 1995 and new reports issue on a biweekly basis. It is available on Westlaw under a database called *ANCOILR*[115] and on LEXIS under *Andrews Publications Newsletters—Computer Law*. This reporter contains extensive narratives of recent events in ongoing litigation.[116]

2. Andrews Intellectual Property Litigation Reporter

This reporter tracks significant litigation covering copyright, trademark and patent infringement and licensing, trade secrets, and unfair competition. It was first published in March 1996 and new reports issue on a biweekly basis. It is available on Westlaw under a database called *ANIPLR*[117] and on LEXIS under *Andrews Publications Newsletters—*

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115. This database contains reports from November 1996 onward.

116. For an example of a good update from this source, see *Supreme Court Declines Petition In Software Outsourcing Case:* Beckman Instruments v. Cincom Sys., 18 ANDREWS COMPUTER & ONLINE INDUS. LITIG. REP. No. 15, Apr. 10, 2001 at 11.

117. This database contains reports from November 1996 onward.

Intellectual Property. Like its computer law counterpart, this reporter contains extensive narratives of recent events in ongoing litigation.[118]

3. Mealey's Litigation Report: Intellectual Property

Similar to its Andrews counterpart, this reporter tracks significant litigation covering copyright, trademark, trade secrets, unfair competition, and patent infringement and licensing, both in the U.S. and abroad. It was first published in January 1993 and new reports issue twice per month. It is available on Westlaw under a database called *MLRIP*[119] and on LEXIS under *Mealey's Litigation Report: Intellectual Property*. Like the Andrews reporter, event summaries are comprehensive in nature.[120]

4. Mealey's Litigation Report: Patents

This reporter covers Federal patent litigation exclusively, addressing issues such as infringement, claim interpretation, licensing agreements, affirmative defenses, trials, jurisdiction, and discovery. It was first published in June 1993 and new reports issue twice per month. It is available on Westlaw under a database called *MLRPAT*[121] and on LEXIS under *Mealey's Litigation Report: Patents*.[122] Like its IP reporter equivalent, this Mealey's reporter includes a comprehensive description of developments in ongoing litigation, similar to a news article in scope and nature.[123]

5. E-Commerce Law Report

This reporter, published by Glasser LegalWorks, contains monthly coverage of legislation, regulation, and court decisions pertaining to e-commerce. First published in September of 1998, it can be accessed online on Westlaw under a database called *GLECOMLR*. This

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118. For an example of a good update from this source, *see Supreme Court To Hear Arguments In Electronic Publishing Case*: New York Times Co. v. Tasini, 7 ANDREWS INTELL. PROP. LITIG. REP. No. 17, Mar. 16, 2001 at 3.

119. This database is updated two months after the publication of a new report in print. Practitioners looking for recent developments should note this significant lag time.

120. For an example of a good update from this source, see Recording Industry Likely to Succeed on Claim, But Injunction Is Overbroad, 9 No. 10 *Mealey's Litig. Rep.: Intell. Prop.* 4 (Feb. 2001).

121. This database is updated two months after the publication of a new report in print. Practitioners looking for recent developments should note this significant lag time.

122. LEXIS also has a database that combines Mealey's reporters on IP and patents. The combined searchable database is called *Mealey Publications Newsletters—Intellectual Property*.

123. For an example of a good update from this source, *see Federal Circuit Affirms Denial of Injunction, Cites Lack of Key Element*, 8 No. 17 MEALEY'S LITIG. REP.: INTELLECTUAL PROP. (2001), *available at* http://newlettersonline.com.

publication contains information about recent litigation as part of articles that address changes to the law surrounding e-commerce.[124]

6. Derwent LitAlert

The Derwent *LITALERT* database on Westlaw contains records for patent and trademark litigation lawsuits filed in ninety-four U.S. District courts that have been reported to the Commissioner of the U.S. Patent and Trademark Office (PTO). It also includes records for lawsuits filed since the early 1970's that have never been published in the PTO's Official Gazette. Relevant information includes parties, court, docket number and judgment date. Coverage begins in 1973, with some gaps in the period from 1973 to 1984 and in 1991. This database is updated weekly and includes information ten days after its receipt by the PTO.

7. Intellectual Property News

Dow Jones's Intellectual Property News database on Westlaw, called *IPNEWS*, contains articles, columns, letters, briefings, and other sections of text about intellectual property from newspapers, magazines, journals, newsletters, transcripts, and wires.[125] Coverage begins in September 1986, but a search by default is limited to the current year, unless a date restrictor specifies otherwise. The database is updated daily.

8. BNA Patent, Trademark & Copyright Law Daily

The Bureau of National Affairs' (BNA) offers a daily electronic transmission regarding activity that affects intellectual property law in legislatures, the PTO, and Federal and state courts. This information is captured by *BNA-PTD* on Westlaw, and *BNA Patent, Trademark & Copyright Law Daily* on LEXIS. Full coverage began in September 1989 and it is updated daily, Monday to Friday, usually by 7 AM EST.[126]

9. BNA Patent, Trademark & Copyright Journal

The *BNA-PTCJ* database on Westlaw and *BNA Patent, Trademark & Copyright Journal* on LEXIS capture the BNA's weekly publication on

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124. For an example of a good update from this source, see Ian Ballon, *Assessing and Limiting E-Commerce Liability Through Policies, Procedures and Web Site Audits*, 2 No. 11 E-COMMERCE L. REP. 2 (2000), *available at* http://www.ecommlawreport.com/ecommlawreport/.

125. For an example of a good article from this source, *see* Business Wire, *Juno Wins Key Victory in Patent Suit Filed by NetZero* (Apr. 12, 2001), *available at* http://freelists.org/archives/juno_accmail/04-2001/msg00053.html.

126. For an example of a good article from this source, see *Unauthorized Sale Did Not Make Goods Counterfeit*, PATENT, TRADEMARK & COPYRIGHT LAW DAILY (Mar. 26, 2001), *available at* http://pub.bna.com/ptcj/00932.htm.

Patents, Trademarks & Copyrights. The journal reports on and analyzes legislative, judicial and administrative activities that affect IP law, including digests of court decisions, important court rulings, and the full text of selected regulatory and legislative materials.[127] Coverage on Westlaw began in January 1986 and, in January 1982 for LEXIS.

10. Westlaw Topical Highlights—Intellectual Property

Westlaw's own *WTH-IP* database is prepared by the West Group editorial staff and summarizes recent developments in IP law. It features brief summaries of court decisions or other legal activity of interest. New documents are included on a daily basis if material is available.

11. The Brief Reporter

LEXIS' *Brief Reporter* contains full briefs submitted by attorneys throughout the U.S., from 1990 onwards.[128] Editors also create an abstract for each brief, and these abstracts can be searched using the *ABSTRACT(___)* search limiter. The database is updated on a monthly basis.

12. U.S. Supreme Court Briefs & California Supreme Court Briefs

Westlaw also has limited databases of briefs. U.S. Supreme Court briefs are in *SCT-BRIEF*, with limited coverage starting in 1990 and full coverage starting in 1996.[129] It also has California Supreme Court Briefs in *CA-BRIEF*, with limited coverage starting in 1997 and full coverage starting in 1999. There are no search limiters within these databases, making them inferior to their LEXIS counterparts.

PART VII: CITATION SERVICES & UPDATE SERVICES

A. *Quick Tips*

Westlaw's "KeyCite" and "KeyCite Alert" and LEXIS' "Shepard's for Research" and "Eclipse" can also be effective tools. Use KeyCite, with limits, or Shepard's, with custom restrictions, to find new cases citing seminal cases in this area of law. Practitioners could also use KeyCite Alert to track a recent case or statute that deals with a new

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127. *See id*.

128. For an example of such a brief, see Defendant-Appellant's Opening and Reply Brief in Sony Computer Entertainment Inc. v. Connectix Corp., 203 F.3d 596 (9th Cir. 2000).

129. For an example of such a brief, see U.S. Amicus Brief for New York Times Co., Inc. v. Tasini, 533 U.S. 483 (2001).

technology, thus retrieving all other documents that cite to it. Alternatively, Eclipse searches can provide continuous updates on searches designed to retrieve analysis on this area of law.

B. *Using Citation and Update Services For Research*

Practitioners often use citation and update services to ensure that the cases cited in legal documents still contain valid legal principles. However, beyond this critical function, these services can also be used to conduct effective legal research. One effective way to use these tools is to cite check seminal case law to bring up current cases, which may contain current views of the older case and branching theories based on the leading case's founding principles. Likewise, update services can keep track of new interpretations of older case law and statutes as they apply to new technologies. In another vein, update services can be set up to effectively keep track of laws revolving around a new form of computer related technology, such as the Internet.

C. *Using Citator Services For Legal Research*

Although citator services still exist in print form, their usefulness in this form is very limited as compared to their online equivalents. This is especially true when conducting research using citators. As such, this chapter will focus on the online version of these services and how to maximize their effectiveness as search tools.

1. Westlaw's KeyCite Service

Westlaw's KeyCite service is the newer of the two citatory-services most used by practitioners. Entering a case or statute citation will bring up a host of useful information. Among these is *KC History*, which lists all related documents that are part of the case's history. There is also *KC Citations*, which lists all cases that cite to the case or statute entered. Of course, both of these functions serve the purpose of determining whether a case has been reversed or overruled. However, the *KC Citations* function can also be used for purposes of researching the law in a particular area. A researcher can take a leading case, as described in a treatise, a statute or other secondary material, and look up its *KC Citations* to find more recent case law that expands on the principle first promulgated in the seminal case. In doing so, the researcher should utilize the *Limits* function, which uses West Key Numbers[130] and jurisdictional limiters to return only relevant results.

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130. *See supra* Part V.C.3.

2. LEXIS' Shepard's Citations System

Shepard's Citations is the oldest citatory system still used by practitioners. Although it does still exist in print form,[131] it is much more useful in its online version on LEXIS. Under the heading, *Get a Document*, choose *Shepard's for Research*. Entering a case or statute will reveal subsequent citations to the document entered. Like KeyCite, the results can be limited using the *Custom Restrictions* feature. Restriction types include jurisdictional, date, and topical. Unlike KeyCite, the topical restriction uses headnotes from LEXIS or Lawyer's Edition, which are not indexed in any fashion.

D. *Example of Using Citator Services for Legal Research*

The following are examples of how to use citatory services for cases, statutes and articles to conduct legal research:

Cases: Sheldon v. Metro-Goldwyn Pictures Corp., 309 U.S. 390 (1940) is considered the seminal case in apportioning damages from copyright infringement. Not surprisingly, a regular KeyCite of this case reveals over 260 cases citing to it. However, if one applies limitations to the key numbers dealing with damages, citations with in-depth treatment (with three or more stars), and cases after 1990, the results are reduced to five cases, two of which deal with computer related technology.[132]

Statutes: a KeyCite of the injunctive remedies section of the Copyright Act, 17 U.S.C. § 502, reveals 1050 documents. However, by restricting the cases to those that deal with computer software after 1990, the results are reduced to three cases. These deal with the law of injunctive remedies, within various Federal circuits, as it applies to computer software.[133]

Articles: by Shepardizing the law review article by Jules L. Coleman, entitled "Intellectual property and corrective justice," in 78 VA. L. REV. 149,[134] two cases and 103 citing articles were found. From these,

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131. Shepard's Citations includes print publications specializing in particular areas of law, including SHEPARD'S INTELLECTUAL PROPERTY LAW CITATIONS (Jane W. Morris ed., 3rd ed. 1995). LC KF3093.15.

132. The two cases are: Data General Corp. v. Grumman Sys. Support Corp., 36 F.3d 1147 (1st Cir. 1994); Allen-Myland, Inc. v. Int'l Bus. Machines Corp., 770 F.Supp. 1014 (E.D.Pa. 1991).

133. The three cases are: Autoskill Inc. v. Nat'l Educ. Support Sys., Inc., 994 F.2d 1476 (10th Cir. 1993); *In re* Indep. Serv. Org. Antitrust Litig., 910 F.Supp. 1537 (D.Kan. 1995); Control Data Sys., Inc. v. Infoware, Inc., 903 F.Supp. 1316 (D.Minn. 1995).

134   Coleman, *supra* Part III.2.d.

three articles dealt with issues of IP damages and computer related technology.[135]

E. *Using Update Services for Legal Research*

Update services work in tandem with the citator-services available on Westlaw and LEXIS. These services can be used to keep track of changes to the law and any recent decisions regarding remedies in IP actions involving computer technology.

1. Westlaw's KeyCite Alert

KeyCite Alert can be set up to deliver reports of any new citations to cases of interest. The alert can also be limited using the same restrictions that are available on KeyCite. Delivery schedules for updates include weekly, biweekly, and monthly. Thus, the alert cannot only keep track of an ongoing case of interest, but can also track the development of the law around a new technology by either tracking legislation or a seminal case.

For example, if a practitioner is interested in the retroactivity of the Anticybersquatting Consumer Protection Act and the injunctive remedies available under the statute, she can set up a KeyCite alert to track 15 U.S.C. § 1125, limited to issues of retroactivity, cases where injunctions were granted, and cases where injunctions were denied.

2. LEXIS' Eclipse

Eclipse is more expansive than KeyCite Alert in that it is not limited to updating citations to a case or statute, but instead reruns a previously specified search on a continuous basis and returns new results from that search, thus supplementing prior searches. To start Eclipse, simply choose *Save as ECLIPSE* in LEXIS' top menu after running the desired search in LEXIS for the first time. Eclipse can be set up to return new cases citing to a case of interest, or return results based on a search directly dealing with the subject matter of interest. Further, the search can employ LEXIS' Core Concepts and Core Terms, or other search restrictions. However, the Eclipse search is restricted to the database in which the original search was run.

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135. The three articles are: Pamela Samuelson et al., *A Manifesto Concerning The Legal Protection of Computer Programs*, 94 COLUM. L. REV. 2308 (1994); John Tessensohn, *The Devil's In The Details: The Quest For Legal Protection Of Computer Databases and the Collections of Information Act, H.R. 2652,* 38 IDEA 439 (1998); A. Samuel Oddi, *An Uneasier Case For Copyright Than For Patent Protection Of Computer Programs*, 72 NEB. L. REV. 351 (1993).

PART VIII: INTERNET SOURCES GENERALLY

A. *Quick Tips*

Finding web sites that contain useful information on remedies for IP actions involving computer related technology can be a very difficult task. A simple yet effective method of locating good web sites is a search on a good internet search engine, such as Google (*www.google.com*), using relevant keywords such as *intellectual property*, *copyright*, *patent*, *trademark*, *trade secret*, *remedies*, *damages*, *injunctions*, *computer*, *internet*, *software*, etc. General law web sites, such as Findlaw.com (*www.findlaw.com*) and Law.com (*www.law.com*), and web sites of IP organizations, such as the American Intellectual Property Law Association (www.aipla.org), may have new material relating to IP remedies.

B. *Using The Internet & Law Related Web Sites*

As IP law continues to develop and policy makers try to address its application to new technologies, the Internet has become a stage on which various organizations have presented their cases for how IP law, including its remedies, should develop. However, finding a web site with useful and credible information can be a daunting task given the wealth of information on the World Wide Web. At the same time, the relatively recent development of law meta-sites have given practitioners an added tool to search for these sources.

C. *Searching The Internet & Law Related Web Sites*

When looking for web-based resources, a practitioner should first consult a law meta-site which has included IP law, or more specifically, IP law remedies, as part of its topical arrangement. An example of this is Findlaw.com's IP web page at *http://findlaw.com/01topics/ 23intellectprop/*.

It contains a lawyers directory, a brief overview of the law in the area as submitted by practitioners, links to pertinent government agency web sites, and other general web sites, categorized under copyright, patent or trademark. Also useful is the Cornell Legal Information Institute's topical database at *http://www.law.cornell.edu/topics/topic1.html*, which contains sections on copyright, patent and trademark.

Each IP law regime has a web page devoted to an overview of statutory law in the area, state and international materials, government agency web sites, and other useful web sites. Law.com is another law meta-site that has web pages devoted to the subject of IP law, with the main IP page at *http://www.law.com/professionals/iplaw.html*.

These pages include updates of ongoing litigation, decisions and practice papers, but some are only accessible through a subscription service.

Beyond these meta-sites and their links to web sites dealing with IP issues, practitioners may wish to take a stab at locating useful documents on the web using a search engine. At present, the search engines that provide the most relevant results are Google (*http://www.google.com*), Northern Light (*http://www.northernlight.com*) and HotBot (*http://hotbot.lycos.com*). A good search should include keywords such as *intellectual property*, *copyright*, *patent*, *trademark*, *trade secret*, *remedies*, *damages*, *injunctions*, *computer*, *internet*, *software*, etc., but should limit the search to, at most, five terms.

D. *Useful Web Sites in 2001*

The following is a list of web sites containing useful information about remedies in IP actions involving computer technology and IP law more generally.

- The Intellectual Property Owners Association at *http://www.ipo.org*.

- The World Intellectual Property Organization at *http://www.wipo.org*.

- The American Intellectual Property Law Association at *http://www.aipla.org*.

- Electronic Frontier Foundation at *http://www.eff.org*.

- The Institute of Continuing Legal Education at *http://www.icle.org/PracticeAreas/Intellectual.cfm*.

- The BNA's IP Center at *http://ipcenter.bna.co.m*

- The ABA's IP section at *http://www.abanet.org/intelprop/*.

- The DOJ's IP crimes web site at *http://www.cybercrime.gov/ipmanual/07ipma.htm*.