U.S. Patent Law Research

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I. Introduction

Gaining a basic knowledge of patent information resources is an essential step in developing effective patent law research skills. This guide describes publications and databases that facilitate research in U.S. patent law. It is intended primarily for users of the Jacob Burns Law Library, and indicates the location of materials within the Library or online.

To determine if a source listed in this guide is available in Bloomberg Law, Lexis Advance, or Westlaw Edge, enter the name of the source in the search box at the top of the page and then select the source from the drop-down list. To obtain Bloomberg Law, Lexis Advance, or Westlaw Edge credentials, email your request to electronicservices@law.gwu.libanswers.com and include your GWid number.

For additional information, see the research guide Patent Law, http://law.gwu.libguides.com/patents, where you can also access this guide in PDF. For research help, visit http://law.gwu.libguides.com/researchguides for contact information.

II. Patents: A Brief Overview

A U.S. patent is a federal intellectual property right, derived from Article I, Section 8 of the U.S. Constitution, which gives its owner, the patentee, the right to exclude others from making, using, selling, or importing the patented invention for a limited time. In exchange for the patent grant, the inventor provides a full public disclosure of the invention. Title 35 of the United States Code contains the main body of law concerning patents.

Patents are one of the four major types of U.S. intellectual property, along with copyrights, trademarks, and trade secrets. There are three types of patents:

- Utility Patents, the most common type of patent, protect new machines, processes, articles of manufacture, or compositions of matter (35 U.S.C. § 101).
- Design Patents are available for new and original ornamental designs of manufactured articles (35 U.S.C. § 171).

Violation of any of the patentee’s rights may constitute infringement and may lead to a suit for damages and/or injunctive relief. Like other forms of personal property, patents may be assigned and licensed. When a patent expires, the invention may be made, used, or sold by anyone without the patentee’s permission.

A patent is also the legal document in which a patented invention is officially disclosed. It includes the following parts:

- The Front Page shows the patent number and issue date, the inventor’s name and location, the title of the invention, the assignee (person/organization to whom/which patent ownership may be transferred), and references to earlier patents and related technical literature.
The Specification describes the invention in detail, explains how to make and use it, and distinguishes it from preexisting technology (or the “prior art”).

The Claims define the patent and the scope of the patentee’s property rights.

Patents encourage public disclosure of technology, and provide incentives for innovation, including economic reward. Advances in high-tech fields such as computer software, telecommunications, biotechnology, chemical engineering, pharmaceuticals, and artificial intelligence, not to mention substantial corporate investments, may have given patents more commercial significance than ever before.

III. Starting Points for Patent Research

  - Print: KF3114 .A33 2018 (Location: RESERVE)

  - Print: KF3114 .L36 2018 (Location: RESERVE)


IV. Selected Secondary Sources

Secondary sources can often be the best materials with which to begin legal research. Treatises and legal periodical articles enhance research by providing explanation of concepts and issues, commentary on relevant cases, and analysis of current legislative and administrative policy issues.

There are helpful secondary sources in Bloomberg Law, Cheetah (Wolters Kluwer), Lexis Advance, and Westlaw Edge, as noted below beneath the relevant source.

A. JACOB: the Library’s catalog (https://www.law.gwu.edu/library)

JACOB may be used to locate treatises and other secondary sources held in the Library’s collection.

Sample Subject searches:

- Patents -- United States
- Patent Laws and Legislation -- United States
- Patents and Government Developed Inventions -- United States
- Patent Practice -- United States
- Patent Licenses -- United States
- Patent Suits -- United States
Sample Keyword searches:
Federal Circuit; Patent Damages; Patent Drafting; Patent Infringement; Patent Legislative History; Patent Litigation; Patent Practice; Patent Prosecution; Patent Suits; Patent Trial and Appeal Board (PTAB); Inter Partes Review (IPR); Post Grant Review

B. Selected Secondary Sources: Titles

1. Primers

  - Print: *KF2979 .C478 2015* (Location: RESERVE)

  - Print: *KF2980 .M42 2019* (Location: RESERVE)

  - Print: *KF2980 .M52 2018* (Location: RESERVE)

  - Online: Westlaw Edge

  - Online: Westlaw Edge

  - Print: *KF3114 .M84 2016* (Location: RESERVE)

  - Print: *KF3114 .S34 2019* (Location: RESERVE)

2. General Treatises

  - Online: Lexis Advance
  - Print: *KF3110 .D82* (Location: SL3)
3. Patent Applications, Claim Drafting, & Prosecution

  - Online: Westlaw Edge
  - Print: KF3114 .P36 (2014 Updates) (Location: SL3)

  - Online: Bloomberg Law
  - Print: KF3120 .D66 2019 (Location: RESERVE)

  - Online: PLI Plus (2019)
  - Print: KF3125 .C5 L34 (2013 Updates) (Location: RESERVE)

  - Online: Cheetah (Wolters Kluwer) (2019)
  - Print: KF3125.C5 K342 (Location: SL3)

  - Online: USPTO | MPEP Archives, 1948 -.

4. Patent Litigation

  - Print: KF3155.A65 A382 (2016 Updates) (Location: SL3)

  - Online: Bloomberg Law
  - Print: KF3155 .P37 2015 (2018 Updates) (Location: RESERVE)
5. International Trade Commission (ITC) Practice

  - Print: KF3195 .F42 (2019-20 Updates) (Location: SL3)

  - Print: KF6662 .L38 2019 (Location: SL3)

6. Patent Alternative Dispute Resolution

  - Online: Bloomberg Law
  - Print: KF3155 .P37 2015 (2018 Updates) (Location: RESERVE)
    - (Ch. 3: Use of ADR in Patent Infringement Litigation)

  - Print: KF3155 .N49 2018 (Location: SL3)

  - Print: KF2983 .A93 2017 (Location: SL3)
7. Patent Licensing

  - Online: Lexis Advance

  - Online: PLI Plus (2018)


  - Print: KF3145 .O74 2015 (Location: RESERVE)

- Wright, Bradley C., ed. *Drafting Patents for Litigation and Licensing*. VA: BNA Books; Chicago: Section of IP Law, American Bar Association, 2008-.
  - Print: KF3145 .D727 2013 (2017 Updates) (Location: RESERVE)

8. Patents and Antitrust Law

  - Online: Westlaw Edge

  - Online: Cheetah (Wolters Kluwer)
  - Print: KF3116 .H68 2017 (2018 Updates) (Location: SL3)

9. Software Patents

  - Online: Bloomberg Law
  - Print: KF3133 .C65 E43 2016 (2017 Supplement) (Location: SL3)

  - Online: Cheetah (Wolters Kluwer)
  - Print: KF3133 .C65 S762 (2019 Updates) (Location: SL3)

10. Biotechnology, Chemical, & Pharmaceutical Patents

  - Online: Westlaw Edge | Print: KF3133 .B56 C662 (2014 Updates) (Location: SL2)
  - Online: Cheetah (Wolters Kluwer)

  - Online: Bloomberg Law
  - Print: KF3133.D78 T46 2015 (2016 Updates) (Location: RESERVE)

11. Business Method Patents

  - Print: KF3133.B87 R67 2012 (Location: SL3)

  - Online: Cheetah (Wolters Kluwer)
  - Print: KF3133.B87 S762 (Location: SL3)

12. United States Court of Appeals for the Federal Circuit

  - Online: Lexis Advance
  - Print: KF3114 .C47 (Location: RESERVE)

  - Online: Bloomberg Law
  - Print: KF3114 .H347 2017 (2018 Updates) (Location: RESERVE)

13. Leahy-Smith America Invents Act (“AIA”)

  - Online: KluwerIPLaw
  - Print: KF3100.99 .A44 (2016 Updates) (Location: SL3)

  - Print: KF3101.62011 .H37 2017 (Location: SL3)

  - Print: KF3120 .M47 2014 (Location: SL3)
14. Patent Trial and Appeal Board (PTAB)

  - Print: KF3156 .P73 2016 (Location: SL3)

  - Print: KF3156 .E87 2018 (Location: SL3)

  - Print: KF3155 .N49 2018 (Location: SL3)

- Oblon Spivak. Post-Grant Proceedings Before the Patent Trial and Appeal Board. 2013-.
  - Online: PLI Plus (2018)
  - Print: KF3120.A4 2013 (Location: SL3)

15. Dictionaries

  - Online: Lexis Advance (2018)

  - Online: Westlaw Edge
  - Print: KF3109 .A35 2011 (Location: REFERENCE)

  - Online: Lexis Advance
  - Print: KF2977 .G332 (Location: REFERENCE)

16. Form Books

  - Online: Westlaw Edge
  - Print: KF3111 .K73 (Location: SL3)
C. Periodical Literature (Journal articles, etc.)

Legal: Users should consult the periodical resources in Bloomberg Law, Lexis Advance, and Westlaw Edge. In addition, HeinOnline’s Law Journal Library contains more than 2,700 law and law-related periodicals for users to search: http://law.gwu.libguides.com/electronicresources/databases. For more sources, including legal periodical indexes, consult the Library’s guide Journal Articles Research.

Non-legal: The GW Gelman Library provides access to a number of article databases in business, engineering, the sciences, and the social sciences: http://library.gwu.edu/. The GW Himmelfarb Library provides access to article databases in the health sciences: https://himmelfarb.gwu.edu/.

V. Federal Case Law

Patent infringement actions are litigated in the U.S. District Courts, except for infringement suits brought against the U.S. government, which are handled by the U.S. Court of Federal Claims (http://www.uscfc.uscourts.gov) (under 28 U.S.C. § 1498). Although a patent is “presumed valid” in an infringement action (35 U.S.C. § 282), it may be invalidated by a federal court. Invalidity of a patent is commonly asserted as a defense in patent litigation -- an invalid patent cannot be infringed.

The history of federal patent appeals is divided into two time periods:

Prior to October 1, 1982: Appeals from patent decisions of the U.S. District Courts went to the regional U.S. Courts of Appeals (2nd Circuit, 9th Circuit, etc.). Administrative appeals from the Patent and Trademark Office (known as just the Patent Office prior to 1975) were decided by the U.S. Court of Customs and Patent Appeals (“CCPA”).

Starting on October 1, 1982: Due to conflicting patent precedent among the circuits, combined with the Supreme Court of the United States’ inability to resolve these conflicts quickly, a new federal law directed patent appeals to a specialized court: the United States Court of Appeals for the Federal Circuit. The CCPA was abolished when the Federal Circuit was established.

A. United States Court of Appeals for the Federal Circuit

http://www.cafc.uscourts.gov/

Under 28 U.S.C. § 1295, the United States Court of Appeals for the Federal Circuit (known as the “Federal Circuit” or “CAFC”) has exclusive jurisdiction over patent appeals from the following:

U.S. District Courts: https://www.uscourts.gov/
Although review of Federal Circuit decisions by the Supreme Court of the United States has increased, the case law of the Federal Circuit is of central importance to the development of U.S. patent law. The Federal Circuit has been instrumental in creating a more uniform patent jurisprudence.


  - Print: KF9053 .A4 1982 (2017 updates) (RESERVE)

B. West Reporters & Digests

Patent-related case law is published in the standard West reporters (e.g., Federal Reporter) and represented in the various West federal digests (e.g., Federal Practice Digest), all of which are located on the 2nd floor of the Library.

West’s Annotated Patent Digest (Matthews) contains “summaries of all relevant patent law decisions in the U.S. along with expert commentary. This work is organized by topic and provides case summaries for U.S. Federal patent cases from 1998 going forward, as well as selected older cases from all levels of U.S. Federal courts.”
  - Online: Westlaw Edge


The U.S.P.Q. contains the full-text of IP decisions from federal and state courts and administrative agencies, including the USPTO’s Patent Trial and Appeal Board (formerly called the Board of Patent Appeals and Interferences) and Trademark Trial and Appeal Board.

- Coverage of U.S.P.Q. is 1929 (vol. 1) to date.
- U.S.P.Q. decisions include headnotes summarizing points of law.
- Classification numbers (e.g., “115.1109, Claim adequacy”) are assigned to the headnotes and tie each case into U.S.P.Q.’s unique classification system.
- To obtain relevant classification numbers, use the Classification Outline or the Topical Index (in current U.S.P.Q. binders on Stack Level 3 of the Library).
  - Print:
    - Bound volumes: KF2975 .A2 U54 (Location: SL3)
  - Online: Bloomberg Law

- Abstracts of all reported decisions of the Federal Circuit (1982 to date).
- Topical outline arrangement. Chronological table of cases included.
  - **Print**: KF3114 .C47 (Location: RESERVE)
  - **Online**: Lexis Advance (Click on “Part III. Federal Circuit Guide.”)


- Decisions from the CCPA also reported in the Federal Reporter and U.S.P.Q.
  - **Print**: KF8764 .A85 1985 (Location: SL3)
  - **Online**: HeinOnline


- “Digest of Decisions” found at end of each volume. No cumulative index.
- Parallel citations to West federal reporters and to the patent version of the Official Gazette included for many decisions.
  - **Online**: HeinOnline

VI. **Patent Regulations**


A. **Code of Federal Regulations (C.F.R.)**

Regulations promulgated by the U.S. Patent and Trademark Office (USPTO) are published in Title 37 of the C.F.R. Included in 37 C.F.R. are the rules of practice relating to patent applications, fees, appeals, reexaminations, and the allocation of patent rights under federally-funded research.

**Online**:

- HeinOnline | Lexis Advance | Westlaw Edge | Bloomberg Law
- U.S. Government Publishing Office’s govinfo.gov > C.F.R.
- e-CFR (currently updated, but not an official legal edition)

**Print**: current year on RESERVE
B. **Federal Register (Fed. Reg.) and Official Gazette of the PTO**

Proposed and final patent regulations, as well as USPTO administrative notices, first appear in the Federal Register and in the “notices section” of the Official Gazette of the U.S. Patent and Trademark Office. (Note: there are separate versions of the Gazette for patents and trademarks.)

> **Federal Register**

Online:

- HeinOnline | Lexis Advance | Westlaw Edge | Bloomberg Law
- FederalRegister.gov
- USPTO Federal Register Notices

Print: current year on RESERVE

> **Official Gazette of the U.S. Patent and Trademark Office. Patents.**

- USPTO maintains current 52 issues online: https://www.uspto.gov/learning-and-resources/official-gazette/official-gazette-patents
- HeinOnline (1872-2002)

C. **Unannotated Versions of Patent Regulations**


- HeinOnline | Lexis Advance | Westlaw Edge | Bloomberg Law
- USPTO: https://www.uspto.gov/web/offices/pac/mpep/index.html MPEP Archives, 1948 -.

> **Rules of Practice in Patent and Trademark Cases.** MD: Rules Service Co., 1978-.

Print: KF3120 .A6 R8 (2016 Updates) (Location: RESERVE)

D. **Patent Office Rules and Practice**

An important secondary source, Patent Office Rules and Practice is a treatise that provides text, explanation, & analysis of all PTO regulations. (Vol. 4: index to the commentary.) Horwitz, Lester. Patent Office Rules and Practice. New York: LexisNexis, 1971-.

Online: Lexis Advance
VII. Current Awareness

A. Selected Sources

1) **Bloomberg Law: IP Law News**

   - Bloomberg Law also has a [Patents & Trade Secrets](#) practice center.

2) **Law360 > Intellectual Property**

   - Law360 (a LexisNexis company) covers news in IP law, as well as cases, legislation, regulatory developments, & personnel moves.

3) **Lexis Advance > Patent Law practice area** (includes patent law news)

4) **Westlaw Edge > Intellectual Property practice area** (includes news and insights)

B. Selected Websites and Blogs

**Websites**

1) USPTO: Patents: [https://www.uspto.gov/patent](https://www.uspto.gov/patent)
2) Patent and Trademark Resource Centers (PTRCs)

**Blogs (or Blawgs)**

1) Patently-O: [https://patentlyo.com/](https://patentlyo.com/)
2) IPWatchdog.com: [https://www.ipwatchdog.com/](https://www.ipwatchdog.com/)
3) Anticipate This!: [https://anticipatethis.wordpress.com/](https://anticipatethis.wordpress.com/)

For more blogs, consult the ABA’s directory, Justia’s Blawg Search, and the LexBlog Network.

Updated by Ken Rodriguez, Reference Department, Burns Law Library
The George Washington University Law School
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