

NEXIS SEARCHES

Guidelines and Suggestions

I. THE BOOLEAN OPERATORS

The operators in Nexis are as follows:

And	Self-explanatory
Or	Self-explanatory
W/number of characters	Used as a proximater (w/10 means one term within 10 of the next term)
Pre/number of characters	Before/no. (X pre/2 Y means term X before 2 words of Y)
!	The truncation symbol
The Quotation marks	The exact terms will be returned
ALLCAPS	Good for searching acronyms
No caps	Eliminate words starting with capital letters
AND DATE BEF (month/year)	Entered as Date before (04/00), for example. (used to show the use of a descriptive term before applicant's entry into the marketplace, for example)
AND DATE AFT (month/year)	Entered as Date after (04/00), for example (used to supplement evidence from date of the last search)
PLURAL or SINGULAR	The plural or singular term will be retrieved (very useful to show the descriptiveness of a term the meaning of which changes according to whether it is plural or singular)

Note: Lexis/Nexis does not differentiate between singular and plural not does it read or search articles, prepositions and common search terms.

II. THE LIBRARIES

Once you have accessed Nexis, the library you would use most often would be **NEWS**; then select **ALLNWS**. For example, this library would be acceptable for the search of the descriptive nature of "TEEN READ WEEK." This is the best one to use for evidence in support of 2(d) refusals.

We cannot use news wire service stories and foreign publications because they are not in general circulation. Therefore, another library we use often is the **NEWS**; then **US** standing for US news library.¹

Sometimes, if the term is a technical computer term, you might want to use the **CMPCOM** library. This smaller file has articles from the technical journals and the hits therefore are more on-point. For example, this library would be good for the search of **WDSL** standing for Wireless Digital Subscriber Loop/Line.

Sometimes, if the term is a technical, scientific term, you might want to use the **PATENT** database. Then select **ALL**. This is the equivalent of the **NEWS** and **ALLNWS** libraries. For example, this library would be good to search for the descriptive use of the term **PHOTOPHORESIS** as a process in bio-medical applications.

III. THE LOGIC OF NEXIS AND THE MODIFYING OPERATORS

Nexis reads the “or” operator first, then the parentheses, then the “and,” and proximate operators (the w/10 operator).

Step 1: So, if you were to enter the search as follows:

(car or auto! or vehicle or truck) w/5 performance

The system will look for the “or” first and line up all stories which have the terms car(s), auto(s) or automobile(s) or vehicle(s) or truck(s). These stories are then put aside.

The system will then look for all stories with the term “performance” in them.

Then the system will check and pull up all stories which have the term “performance” within 5 words of the list of goods.

This search can be used to secure evidence for a 2(e)(1) refusal. The stories you might want to look for are “performance vehicles” or “cars with high performance degree” etc....

Step 2: If the above search gives you a big number of hits (93,000 or so); you will need to modify the search [the operator is **ALLCOMMANDS**, **MODIFY**]

Scroll through the hits and see which are not relevant. You can then eliminate the irrelevant hits:

M [standing for modify]
Then enter **AND NOT** (automatic! or Automated)
Result is down to 67,000

¹ The search usually should begin in **NEWS** and **ALLNWS** because the universe of stories is bigger and more likely to yield information.

Remember to start the modification with an operator (and, or, w/#)

Step 3: To avoid the proprietary use of the term Performance (for example, as part of companies' names) use the following device:

M[standing for modify]

Then enter **AND NOT CAPS (PERFORMANCE)** This eliminates all of the capitalized terms

Note that the hits are now in the range of 50,000. Scrolling through a few will give you a sense of whether the mark is descriptive.

***To refine the above search,** you might want to **change the library to US to limit the hits, and then** re-enter the search this way:

((car or automobile or truck or vehicle) w/5 performance) and not caps (performance)

Here, the system looks for all the “or,” expands out to the parentheses and then, lastly, eliminates the caps. The strategy gave you 26,000 hits

***Even further modification can occur.** If you know that “performance” is a feature of the car, then enter the search this way:

(performance w/5 (feature or asset)) w/5 (truck or vehicle or car or automobile)[511 hits—scroll through and you will see stories like “performance features like]

The search added elements which you know to be part of the test of descriptiveness.

IV. USING NEXIS AS A TOOL FOR GATHERING EVIDENCE

(A) Evidence for a descriptive mark:

When looking for 2(e)(1) evidence, break the individual terms apart and search them separately in Nexis in relation to the goods/services

For example: The mark is WEB INSTANT INQUIRY for use in connection with a search engine software.

- The term WEB is clearly descriptive of the environment in which the software operates; there is no need to search that on Nexis [although there is no harm if you would like to].
- The questionable portion of the mark are the terms INSTANT and INQUIRY. The search should first start with the narrow “instant inquiry” to see if it is a term of art in that industry.

“instant inquiry” w/10 (search engine or software or computer program or brows!)—5 hits—relevant but too few

- The next search could expand further and look like this:

(instant! w/3 inquir!) w/10 (search engine or software or computer program or brows!) –13 hits—some relevant but still too few.

- The search now should focus on the term INQUIRY which is a function of the engine. The descriptive nature of the term INSTANT can be supported by a dictionary definition.

(Inquiry w/5 (featur! or function! or process! or generat! or produc!)) w/5 (search engine or software or computer program or brows!)—305 hits—some good hits

The test for 2(e)(1) is that each term tells the users something about the goods and/or services. The search, therefore, does not have to show all the terms in the mark in the combination in which they appear. The evidence should show that each term, used in relation with the goods/services, identifies a feature, and, together, the combination of all the terms does no more than tell the users about the goods/services.

(B) Evidence for likelihood of confusion:

When looking for 2(d) evidence, know why you believe the goods/services are related to each other and look for them by a focused search.

For example, the registrant’s goods are computers and modems; and the applicant’s goods are speakers and scanners. The likelihood for confusion exists because there might be manufacturers who make all these goods [the expansion of trade doctrine] and/or the goods are sold in the same channel of trade to the same users. The searches could be as follows:

- (produc! or mak! or manufactur! or design!) w/5 ((computer or modem) w/5 (speaker or scanner))—over 5000 hits
- You can afford to refine the search with that many hits. Again, MODIFY and then enter: AND NOT CAPS (Design! or manufactur! or computer or speaker) to eliminate the proprietary uses—about 1300 hits; many are usable.

The next search should focus on the distribution channel. The search could be as follows

- (sell! or sale or display! or retail! or distribut!) w/5 ((computer or modem) w/5 (speaker or scanner))—1600 hits, many are usable.

- Again, you can afford to eliminate some extraneous hits. MODIFY and then enter AND NOT CAPS (computer or modem or speaker or scanner)—350 hits—some are usable.

Note: The example uses simple goods identified by their common commercial names. In Nexis, where appropriate, you will have to find synonyms. For example, scanners can be called OCR's; and modems can be the equivalent of "computer peripherals."

V. PRINTING OPTIONS

When you are ready to print the articles, you may select various options which bold, underline or otherwise highlight the search terms for you.

From the GUI [graphical user interface], you should select PRINT. Then on the right hand side of the dialog box, you will find OPTIONS. Click on OPTIONS and you will find all of the options listed. Check off the ones you like and make it your default. All searches will come out with these options.

VI. HELP NUMBER

Nexis help number is (800-543-6862).