

GUIDELINES FOR PATENT MARKING

Patent marking plays a vital role in preserving a company's rights to recover money damages from an infringer. In many cases, no damages are available from an infringer if the company has not properly marked its products with the applicable patent numbers. In other cases, improperly marking products with incorrect patent numbers can lead to liability for the company.

These guidelines outlined within provide information on patent marking fundamentals.

HOW MARKING PROVIDES "NOTICE" TO INFRINGERS

A patent owner may obtain damages dating back to a date on which the patent owner provided an infringer with a notice of the infringement. Marking is a critical way to provide this notice.

Marking is accomplished by marking the patented product with the word "Patent" or "Pat.," followed by the patent number or a web address where the patent number is listed.

The latter option, known as "virtual marking," allows a company to update its products without having to re-label or re-produce a line of products when, for example, a new patent issues that covers the products.

Marking has a few critical requirements:

- ✓ If virtual marking is used, the web address must be "accessible to the public without charge for accessing the address."
- ✓ The patent number or web address where the patent number can be found is required. It is not enough to merely state "Patented" on the article.
- ✓ If a family of products is covered by one or more patents, the mark can say "covered by one or more of Patents:" followed by a list of applicable patent numbers or the web address where they can be found. Not every patent listed must cover every member of the product family.

- ✓ Marking of patented articles must be substantially consistent and continuous for the notice provisions to attach. This means that "substantially all" of the patented articles must be marked.
- ✓ A patent owner who is licensing the patent must make reasonable efforts to ensure that a licensee is following a marking program, such as by notifying the licensee that marking is required or by including a requirement to mark in the license agreement.
- ✓ The mark must be legible and unconcealed. If the product is subject to wear, placement of the mark can be less visible if such placement will lessen likelihood that the mark will be worn away.
- ✓ If marking a product is not feasible due to size constraints, a corresponding package or label may be marked instead. However, if words are printed on the product itself, the patent number or web address should be included on the product as well.
- ✓ Marking a product with the words "Patent Pending" and the patent publication number will not satisfy the notice provisions.

FALSE MARKING

False marking is defined as marking a product with a patent number without consent of the patentee, using a patent number on an unpatented article, or using the words "Patent Pending" on an article for which no patent is pending.

False marking does not include marking an article with the number of a patent that has expired, but that at one time covered the product.

Only the United States government can sue for up to \$500 for every falsely-marked article.

A person who has suffered a competitive injury due to false marking can sue in federal court for damages to compensate for the injury.