



Destination IP Virtual Summit

# Patent Marking: Statutory Requirements and Best Practices for Effectively Marking Your Products

# Before We Get Started...



## Recording

A link to the recording and slides will be emailed to all registrants.



## Questions

Type in the question box and we will answer in real time or during the Q&A.



## Social

Follow us on LinkedIn or go to [slwip.com](http://slwip.com) to see upcoming and on demand webinars.

# Panel

---



**Joel Harris**  
Independent  
Practitioner



**Doug Portnow**  
Principal  
Schwegman Lundberg &  
Woessner



Independent Practitioner

## Joel Harris

Joel has 20 years of IP experience developing and managing patent portfolios for emerging companies. He has held senior IP positions including Senior Director of IP at InCube Labs and Director of IP at Rita Medical. Joel has law firm experience at Wilson Sonsini Goodrich & Rosati and Kilpatrick Townsend. In addition to patent prosecution experience, he has supervised IP litigation. Before entering IP, Joel held engineering and management positions at Guidant, Abbott Laboratories, J&J and NASA. Joel is a J.D. from Santa Clara Law School. He also has a B.S. in Chemical Engineering from Northwestern and an M.S. Degree in Bioengineering from Penn State.



---

Registered Patent Attorney & Principal

## Doug Portnow

Doug is a registered patent attorney and Principal at Schwegman Lundberg & Woessner. His practice focuses primarily on medical device patent preparation, prosecution and intellectual property due diligence. Prior to entering the legal profession, Doug was an engineer designing medical and surgical devices. Doug has JD, MBA, MS, and BS degrees.



---

# Episode Overview

- What is patent marking?
- Statutory basis for patent marking
- Why is patent marking important?
- How to mark your products.
- False marking
- Best practices





# What is Patent Marking?





## What is Patent Marking?

- Similar to federally registered copyright mark © or registered trademark symbol ®
- Patent marking shows patent protection of products
- Not required but generally recommended





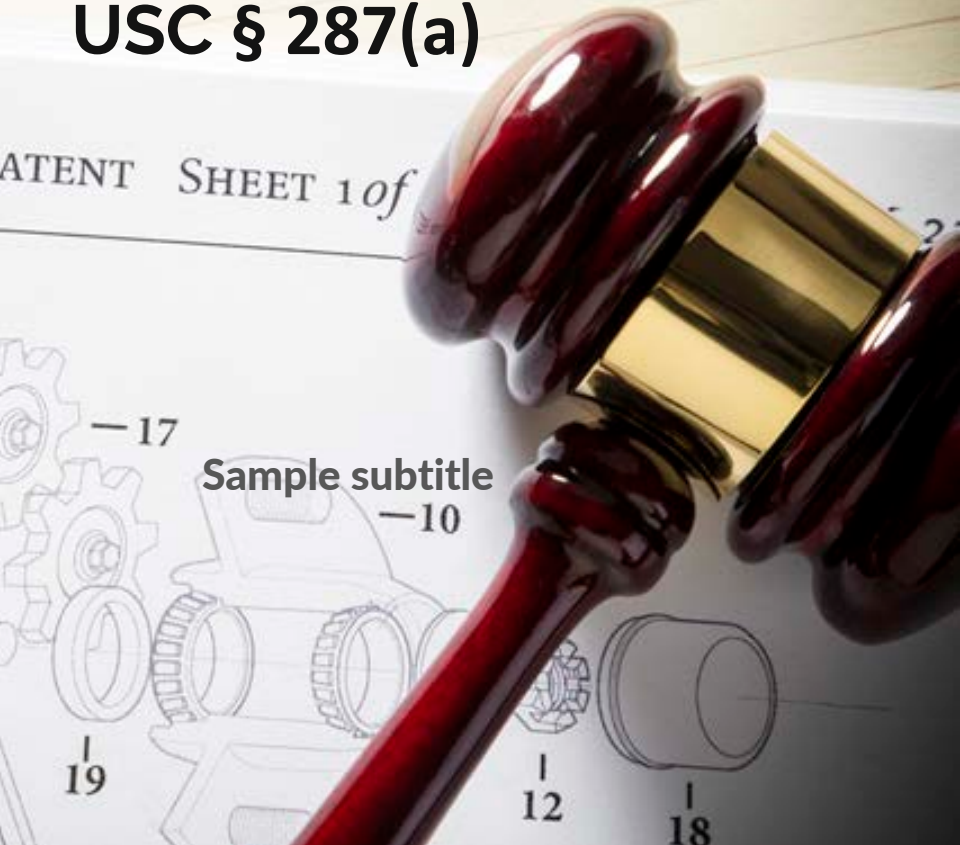
## What is Patent Marking, cont'd.?

- Patent marking = marking your products with the relevant U.S. or foreign patents that cover the products
- Should be on the product but may be on packaging or labeling accompanying the product
- Virtual marking on the Internet now permissible

# Statutory Basis for Patent Marking

---

# Statutory Basis for Patent Marking: 35 USC § 287(a)



(a) Patentees, and persons making, offering for sale, or selling within the United States any patented article for or under them, or importing any patented article into the United States, may give notice to the public that the same is patented, either by fixing thereon the word “patent” or the abbreviation “pat.”, together with the number of the patent, or by fixing thereon the word “patent” or the abbreviation “pat.” together with an address of a posting on the Internet, accessible to the public without charge for accessing the address, that associates the patented article with the number of the patent, or when, from the character of the article, **this can not be done**, by fixing to it, or to the **package** wherein one or more of them is contained, **a label** containing a like notice. In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall **constitute such notice**.

# Why is Patent Marking Important?



# Why is Patent Marking Important?



- Proper patent marking services as constructive notice
- Damages in a patent infringement suit are normally calculated from the time actual notice is given to an infringer
- If there is constructive notice, damages may be calculated from the early constructive notice date
- Constructive notice potentially allows higher damages to be awarded
- Provides notice to the public about IP protection
- Helps deter infringement
- Helps avoid unintentional infringement

# Why is Patent Marking Important, continued...



- In order to take advantage of the deterring effect that patent marking has, manufacturers should have an active patent marking program
- Foreign jurisdictions have similar patent marking laws so consider marking product destined for sales outside the U.S. with relevant foreign patents
- Check with foreign counsel for local patent marking rules and best practices
- Example of actual notice may include cease & desist letter, warning letter, offer to license, actual lawsuit served on defendant

# Examples of Damages Calculation



- Hypothetical 1:
  - Patent owner does not employ patent marking. Infringer starts infringing January 1, 2018. Patent owner learns of infringement June 1, 2019 and sends a cease and desist letter to the infringer on June 1, 2019. If the court finds infringement, damages are only calculated from actual notice date June 1, 2019, so patent owner loses out on 18 months of damages.
- Hypothetical 2
  - Patent owner employs patent marking beginning at product launch in 2015. Infringer starts infringing January 1, 2018. Patent owner learns of infringement June 1, 2019 and sends a cease and desist letter to the infringer on June 1, 2019. If the court finds infringement, damages are calculated from constructive notice date January 1, 2018. No loss of damages.



# How to Mark Your Products







# How to Mark Your Products

- Simply marking a product as “Patent Pending” is generally insufficient to qualify as constructive notice. Just good for marketing or hyping up a product
- In the U.S. mark the product with the word “Patent” or abbreviation “Pat.” followed by a listing of the applicable patent numbers
- Do not conceal the marking. Should be easy to read
- Substantially all of the patented products must be marked, not just a select few of the products



## How to Mark Your Products, continued...

- Placement may be adjusted to accommodate for wear and tear
- If the product is not suitable for marking due to size constraints or in the case of a method where there is nothing to mark, marking the packaging or labeling accompanying the product may be an acceptable substitute
- Simply marking product packaging or product literature that does not accompany the product may not satisfy the constructive notice requirements



## How to Mark Your Products, continued...

- Patents that contain only method or process claims that read on the product do not need to be marked on the product
  - Good way of keeping the patent stealth but lose the advantage of constructive notice
  - And keep in mind that sophisticated counsel can more than likely find the method patent
- For patents with both method and apparatus claims, some disagreement about marking but in general:
  - If the apparatus claims will be asserted then marking is advised
  - If only the method claims will be asserted then marking probably not required



## How to Mark Your Products, continued...

- Marking should be updated to remove expired patents, add new patents or remove patents that do not cover the product
- Updating patent marking can be costly as it may require tooling changes, reprinting costs or scrapping of old packaging and labeling
- AIA (Sept. 2011) introduced virtual marking which overcomes many of the issues associated with traditional marking
- Accomplished by marking the product with “Patent” or abbreviation “Pat.” followed by a website address that has all the relevant information
- Manufacturers, contract manufacturers and licensees should

 This file claims compliance with the PDF/A standard and has been opened read-only to prevent modification.

# Medtronic

Downloaded from www.medtronic.com/patents					
MINIMALLY INVASIVE THERAPIES					
This internet posting serves as notice under 35 U.S.C. §287(a) that the following Medtronic products may be covered by the following U.S. patent(s). Each product may also be covered by one or more foreign patents, and additional patent application(s) may be pending. Products may be sold individually or as part of a system. Listed SKUs are representative only (e.g., more SKUs may be covered and some SKUs may have been discontinued).					
Product Brand	Product Type	Product Information	Size	Patent Information	Representative SKUs
RESPIRATORY & INFORMATICS					
BIS™	Quatro sensor			U.S. Patent 6,032,072.	186-0106
BIS™	Bilateral sensor			U.S. Patent 6,032,072.	186-0212
BIS™	Extended sensor			U.S. Patent 6,032,072.	186-0160
BIS™	Pediatric sensor			U.S. Patent 6,032,072.	186-0200
INVOS™	Infant Regional Saturation Sensor	Somatic		U.S. Patents D615,657; D615,659.	IS-S
INVOS™	Infant Regional Saturation Sensor	Cerebral		U.S. Patents D615,658; D615,660.	IS-C
INVOS™	Infant Regional Saturation Sensor	Cerebral/Somatic		U.S. Patents 8,670,812; 8,718,736; 8,560,035; D613,413.	IS
CapnoLine™ H	Sampling Line			U.S. Patent 6,437,316.	008177; 008178; 008179; 012465; 008180; 08181; 012111; 015075
Smart CapnoLine™ H Plus	Sampling Line			U.S. Patents 6,437,316; 7,383,839; 6,422,240.	010433; 010625; 012463; 015017
Smart CapnoLine™	Sampling Line			U.S. Patents 6,437,316; 6,422,240.	007266; 007269; 007743; 015027
Smart CapnoLine™ H	Sampling Line			U.S. Patents 6,437,316; 6,422,240.	010581; 010582; 012464
Smart CapnoLine™ Plus	Sampling Line			U.S. Patents 6,437,316; 7,383,839; 6,422,240.	009818; 010209; 010340; 010339; 009822; 010210; 009826; 010341; 015018; 015024
Smart CapnoLine™ Guardian	Sampling Line			U.S. Patents 6,437,316; 8,534,278; 8,770,189; 8,555,886.	012528; 012537; 012529; 012538; 012530; 012539; 015020; 015023
O2/CO2 Nasal FilterLine™	O2/CO2 Nasal Cannula			U.S. Patent 6,437,316.	006912; 010304; 010343; 007739; 010344; 006913
Nasal/NIV Line™	CO2 Nasal Cannula			U.S. Patent 6,437,316.	XS04476; 008174; 008175
VitalLine™ H Set	Sampling Line			U.S. Patents 5,857,461; 6,437,316.	010787; 010807; 015026
FilterLine™ Set Adult/Pediatric	Sampling Line			U.S. Patents 5,857,461; 6,437,316.	XS04620; 010579; 007768; 015021
FilterLine™ H Set Adult/Pediatric	Sampling Line			U.S. Patents 5,857,461; 6,437,316.	XS04624; 010580; 007737; 006324; 007738; 015019

## Examples of Virtual Marking

The screenshot shows a web browser window with two tabs: 'CVG-Patent-Marking.pdf' and 'Cardiovascular Patents | Abbott'. The address bar shows the URL 'https://www.abbott.com/patents/legal-notice-patents/cardiovascular-patents.html'. The browser's taskbar at the bottom shows several open applications, including 'Black Hills', 'Google Patents', 'Master Planner for...', 'Google', and '2020 SLW Sponsors...'. The Abbott website header is dark blue with navigation links: 'INVESTORS', 'NEWSROOM', 'RESPONSIBILITY', 'LIVE HEALTHY', and an American flag icon. Below this is a black navigation bar with the Abbott logo, 'CONSUMERS', 'HEALTHCARE PROFESSIONALS', 'CAREERS', 'ABOUT ABBOTT', and a search bar with the text 'SEARCH' and a magnifying glass icon. Below the navigation bar is a light gray breadcrumb trail: 'HOME > PATENTS > ST. JUDE MEDICAL LEGAL NOTICES AND PATENTS > CARDIOVASCULAR PATENTS'.

CVG-Patent-Marking.pdf x Cardiovascular Patents | Abbott x +

https://www.abbott.com/patents/legal-notice-patents/cardiovascular-patents.html

Black Hills Google Patents Master Planner for... Google 2020 SLW Sponsors...

INVESTORS NEWSROOM RESPONSIBILITY LIVE HEALTHY

Abbott CONSUMERS HEALTHCARE PROFESSIONALS CAREERS ABOUT ABBOTT

SEARCH

HOME > PATENTS > ST. JUDE MEDICAL LEGAL NOTICES AND PATENTS > CARDIOVASCULAR PATENTS

### BILIARY STENT SYSTEMS

#### Absolute Pro™ Vascular Self-Expanding Stent System

United States Patents: 6,537,311; 6,814,749; 6,375,826; 6,568,235; 6,929,660; 7,128,757; 6,626,937; 7,128,758; 6,582,460; 6,929,657; 6,939,373; 6,635,083; 6,755,854; 6,521,865; 7,175,655; 6,679,980; 6,676,693; 6,964,750; 6,846,323; 6,896,697; 7,303,798; 7,175,650; 7,258,697.



# False Marking



# False Marking



Statutory basis 35 U.S.C. § 292(a):

(a) **Whoever, without the consent of the patentee, marks upon, or affixes to, or uses in advertising in connection with anything made, used, offered for sale, or sold by such person within the United States, or imported by the person into the United States, the name or any imitation of the name of the patentee, the patent number, or the words “patent,” “patentee,” or the like, with the intent of counterfeiting or imitating the mark of the patentee, or of deceiving the public and inducing them to believe that the thing was made, offered for sale, sold, or imported into the United States by or with the consent of the patentee; or**

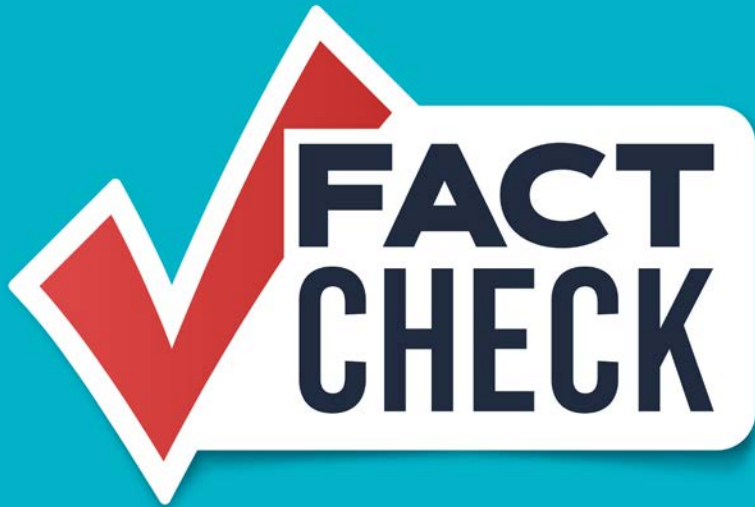
**Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article, the word “patent” or any word or number importing that the same is patented, for the purpose of deceiving the public; or**

**Whoever marks upon, or affixes to, or uses in advertising in connection with any article, the words “patent applied for,” “patent pending,” or any word importing that an application for patent has been made, when no application for patent has been made, or if made, is not pending, for the purpose of deceiving the public—**

**Shall be fined not more than \$500 for every such offense. Only the United States may sue for the penalty authorized by this subsection.**



## False Marking, continued...



- Marking a product with a patent that does not cover the product can create liability for false marking
- Other possible examples of false marking include marking a product with a patent number without consent from the patent owner, marking an unpatented product, or marking a product Patent Pending when there is no patent pending
- It's important to ensure patent marking is accurate



## False Marking, continued...

- Marking a product with an expired patent is no longer considered false marking
- Previously, a wave of *qui tam* citizen “whistleblower” lawsuits were filed for false marking of product with expired patents
- *Qui tam* suits permit a citizen to file a lawsuit on behalf of the U.S. government with monetary damages split between the citizen and the U.S. government
- Very famous Solo Cup lawsuit involved false marking of 21 billion drink cup lids with expired patents. Plaintiff asserted that each lid was an occurrence of false marking and statutory damages based on occurrences, therefore damages \$10 trillion (note U.S. economy is about \$22 trillion). *Pequignot v. Solo Cup* ([Fed. Cir. 2010](#))



## False Marking, continued...

- Courts eventually found no violation of patent marking laws because no intent to deceive
- Congress amended patent marking laws under AIA in 2011 to exclude expired patents from false marking.
- False marking suits can no longer be filed by ordinary citizens. Only government can pursue
- False marking suits have dropped off significantly
- Best practice to review/update patent marking
- Routine audit program may help show no deceptive intent
- Virtual marking is easier to update than changing tooling or reprinting packaging and labeling
- If the marking is in the tooling consider using removable inserts for updates





# Best Practices



# Best Practices

Applies to manufacturers,  
contract manufacturers  
and licensees



1. Patented products should be marked with the relevant patents that cover the product. Method only patents may optionally be marked on the product.
2. Make sure licensees or contract manufacturers are properly marking products with the relevant patents.
3. Maintain records of how products were marked in case there is legal action later, just like other manufacturing records.
4. If the product is unsuitable for marking, consider marking the product packaging, labeling, or using virtual marking methods.
5. Ensure that the patents marked on the product do in fact cover the product.
6. Routinely review and update patent markings to ensure they are accurate in order to avoid penalties associated with false marking.
7. Seek patent counsel for guidance on patent marking.
8. Check with foreign patent counsel for patent marking guidance outside of the U.S.

# Conclusions





# Conclusions

- **Marking your product with patents that cover the product provides constructive notice which may allow collection of higher damages in infringement suits.**
- **Incorrect patent marking can make a manufacturer liable for false marking.**
- **Effective patent marking requires routine monitoring and updating to ensure marking is accurate.**



Thank you for your interest.

# Questions?



Schwegman Lundberg & Woessner | [slwip.com](http://slwip.com)



A short, horizontal bar with a gradient from dark blue to light blue, located in the upper left area of the slide.

These materials are for general informational purposes only. They are not intended to be legal advice, and should not be taken as legal advice. They do not establish an attorney-client relationship.



Schwegman Lundberg & Woessner | [slwip.com](http://slwip.com)