

New Virtual Notice System for Marking Products Patented

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Marking a product to inform the public that it is patented is desirable because a failure to do so can limit the monetary damages that would be available in the event of successful patent infringement litigation. A proper patent marking notice may allow a larger amount of damages to be awarded to a patent owner by a court. The possibility of a greater damage award strengthens the negotiating position of a patent owner who wants to negotiate a settlement with an infringer instead of litigating the infringement law suit.

There is now an additional and often more convenient way to mark a product in compliance with the patent statute. It is called *Virtual* Marking and it enables you to mark the product by reference to an internet address. That way when a patent expires, a new patent on the product is granted or a mistake has been discovered, only the web site information can be changed without the need to change the text on the labels.

More specifically, you can mark a product with a patented notice by

- (1) marking on the product itself, or when, from the character of the article, this cannot be done, by fixing to the product, or to the package wherein one or more of them is contained, a label containing the notice; and
- (2) having the notice state the word “patent” or the abbreviation “pat.” together with
- (3) an address of a posting on the Internet; and
- (4) the internet posting must be accessible to the public without charge for accessing the address (i.e. the posting), and
- (5) the internet posting must associate the patented article with the number of the patent.

For example, you could mark the product or a label on the product with the text “Patent www.ohiopatent.com”. The quotation marks are not needed and the web address should be your web address on which the product is associated with the patent number. The label can be on the package only if, from the character of the article, it cannot be on the article.

Then, on your web site and in association with each product which is covered by a patent, you could write “Patent” followed by the patent number. If multiple patents are applicable to a product, that marking notice can be repeated for each patent number. Although the statute does not require a separate web page dedicated to patent marking notices, it is very desirable that the notice be reasonably accessible rather than in some obscure location where it might seem concealed. If you already have information on your web site for each of your products, you could incorporate the Virtual Notice into that information.

When the patent expires, you should cease marking the product as patented because a person who has suffered a competitive injury as a result false marking may sue you for recovery of damages adequate to compensate for the injury. However, your false marking must be for the purpose of deceiving the public for such damages to be recovered. Additionally, you have a 3 year grace period after the patent expires and there is no recovery for false marking that occurs before the expiration of that three year grace period.

Therefore, Virtual Marking allows you to more easily make changes and additions to patent marking notices without actually changing anything on the product or packaging. Of course, to maintain the effectiveness of your Virtual Marking, you will need to maintain your web site at the address on the product or label or have that address redirected to a new web address.

Finally, there is one more option now available to you. After a patent covering a product has expired, you can continue to call attention to the patent with a modified patent marking notice. During or at the end of the three year grace period, you can place the word “expired” before the word “patent”, the abbreviation “pat”, or the patent number on the internet posting. You can make that same change on the product or label if you prefer to mark the product instead of using Virtual Marking.

The relevant part of the actual statute as it has been amended, it is reproduced below

§ 287. Limitation on damages and other remedies; marking and notice

(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.

§ 292. False marking (c) Whoever engages in an activity under subsection (a) for which liability would otherwise be imposed shall not be liable for such activity— (1) that is engaged in during the 3-year period beginning on the date on which the patent at issue expires; or (2) that is engaged in after the end of that 3-year period if the word “expired” is placed before the word “patent”, “patented”, the abbreviation “pat”, or the patent number, either on the article or through a posting on the Internet, as provided in section 287(a).
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