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“Tip of the Month”

Virtual Patent Marking

In patent infringement, a patent owner is able to recover damages for infringement only for infringing acts that occurred after the infringer had notice of the patent. Failure to properly mark an article can preclude an award of damages before the infringer had notice. The notice requirement can be satisfied by providing actual or constructive notice of the patent. Now, under the America Invents Act, passed in 2011, patentees can use virtual patent marking to satisfy the notice requirement.

An example of actual notice is serving the infringer with an infringement lawsuit along with a copy of the patent. Constructive notice is accomplished by properly marking an article with the word “patent” or “pat.” along with the patent number, such as “Patent No. x,xxx,xxx.” Marking an article with the word “patented” alone is insufficient notice.

Small articles are difficult to mark physically. A small article may lack enough space to list applicable patents legibly or the patent marking may take over the product’s appearance. Even larger articles can present difficulties with physical marking. The patent owner must know which patents apply to the article, must monitor the expiration of those patents so as to properly mark the article with all of the active patents, and must avoid marking the article with any inapplicable or expired patents. Sometimes dozens of patents apply to an article, so that new molds or packaging must be made to mark the article properly whenever a new version of the article is released that is covered by different patents, whenever a new patent issues that covers the article, or whenever a patent expires that covers the article. Retooling and packaging changes can be expensive and wasteful, and they can be out of date by the time the change is implemented.

The primary objectives of the revised marking statute are to reduce manufacturing costs and to facilitate marking small articles. Using the new virtual marking method, the patentee affixes “patent” or “pat.” on the article or its packaging together with a URL address accessible by the public that associates the patented article with the number of the patent. An example of virtual marking is “Patent www.COMPANY.com/patents.” Virtual patent marking helps avoid innocent infringement, encourages patent owners to give notice to the public, and aids the public in determining whether an article is patented. Instead of expensive retooling and redesigned packaging, constructive notice is now effective and accurate by simply updating a website.

Now three years old, virtual marking has the benefit of easy access to patent information by the public and the ability of patentees to quickly update patent information as it changes. However, virtual marking has not been used extensively, possibly because patent holders don’t know enough about it.

Examples of virtual marking can be found at the following website addresses:

http://www.symantec.com/about/profile/policies/virtual_patent_marking.jsp

<http://www.kimberly-clark.com/ourcompany/innovations/patents.aspx>

For questions on patent marking or any other intellectual property issue, contact the attorneys at Mesmer & Deleault by calling (603) 668-1971 or by email at mailbox@biz-patlaw.com.

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