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Winter 2012 Newsletter

Volume 5, Issue 1

AIA Update: Patent Marking

By Emily M. Hinkens

In a previous newsletter, we detailed the nuances of patent marking, including how to mark products, the benefits of marking products, and the consequences of marking with a false or expired patent number. With the passage of the America Invents Act (AIA) in September of 2011, some of the guidance outlined in our previous newsletter requires updating. The following provides information regarding (1) "notice" for obtaining damages for patent infringement and (2) false marking of supposedly patented products.

Notice Provisions

A patent owner may obtain damages dating back to a date on which the patent owner provided an infringer with notice of the infringement, so long as the infringer continues to infringe after such notice. The patent owner can give notice in one of two ways: (1) *Actual notice* – The patent owner sends a letter to the infringer stating specifically what product it believes infringes its patent. Merely stating that a patent exists is not enough; it is wise to state specifically the patent the owner believes to be infringed and perhaps even how the accused device infringes certain of those claims. (2) *Constructive notice* – The patent owner marks 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 AIA added the latter option, known as "virtual marking," to make it easier for patent owners to update their products without having to re-label or re-produce a line of products when, for example, a new patent issues that covers the products.

Constructive notice has a few caveats:

- 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.

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FIRM NEWS

U.S. News and World Report Lists Andrus as a Top Tier Patent Law Firm

We are proud to announce that Andrus has been ranked as a "Tier 1" patent law firm by U.S. News and World Report. Our ranking as one of America's Best Law Firms for 2011 was based on survey data gathered from clients and attorneys, as well as marketing and recruiting officers, regarding our firm's expertise, responsiveness, understanding of a business and its needs, civility, integrity, and cost-effectiveness.

Additionally, Andrus attorneys Dan Fetterley, Gary Essmann, and George Solveson were recently selected by their peers for inclusion in *The Best Lawyers in America*® 2012 (Copyright 2011 by Woodward/White, Inc., of Aiken, S.C.).

As stated by U.S. News and World Report, "Since its inception in 1983, *Best Lawyers* has become universally regarded as the definitive guide to legal excellence. Because *Best Lawyers* is based on an exhaustive peer-review survey in which more than 39,000 leading attorneys cast almost 3.1 million votes on the legal abilities of other lawyers in their practice areas, and because lawyers are not required or allowed to pay a fee to be listed, inclusion in *Best Lawyers* is considered a singular honor. *Corporate Counsel* magazine has called *Best Lawyers* 'the most respected referral list of attorneys in practice.'"

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- 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 has changed considerably due to the AIA. False marking is still 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. Changes, however, include:

- 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. This addition to the Patent Act is likely in response to the well-publicized case of *Pequignot v. Solo Cup Co.* (Fed. Cir. 2010) in which a patent attorney sued Solo Cup for marking its articles with expired patent numbers due to Solo Cup's desire to delay the cost and burden of replacing working molds bearing the expired patent numbers.
- Only the United States government can sue for up to $500 for every falsely-marked article. This is likely also in response to the *Solo Cup* case, in which the plaintiff technically could have won $10.8 trillion, half of which would go to the U.S. government, and incidentally, would have been enough to pay off 42% of the country's national debt at the time!
- A person who has suffered a competitive injury due to false marking can sue in federal court for damages to compensate for the injury.

If you have any questions about how or why to mark your products, or regarding changes with the passage of the AIA, please do not hesitate to contact us.

100 East Wisconsin Avenue
Suite 1100
Milwaukee, Wisconsin 53202

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p 414-271-7590
f 414-271-5770
w andruslaw.com