PATENT MARKING

Legal Standards and Practical Issues

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MIPLA – Nov. 9, 2023

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AGENDA

I. Requirements for Proper Marking
II. False Marking
III. Implementation:
    A. Overview
    B. Issues and Examples
IV. Q & A

REQUIREMENTS FOR PROPER MARKING

Basic Legal Requirements for Traditional and Virtual Patent Marking

35 USC § 287(a)

Who Must Mark What & When

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,

How to Mark & Where

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,

Where Marked Alternative

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.

Effect of Failure

In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement,

Actual Notice Alternative

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.

HISTORY: PRE-1952 PATENT ACT

- Marking requirement originated with Patent Act of **1842**:
  - Required “all patentees and assignees of patents . . . to stamp, [or] engrave . . . on each article vended, or offered for sale, the date of the patent.”

    5 Stat. 543, 544-45, § 6
  - If “any person or persons, patentees or assignees, shall neglect to” mark each article, the penalty was the same as false marking, namely, a fine of “not less than one hundred dollars.”

    5 Stat. 543, 544-45, §§ 5-6
- Marking statute amended in Patent Act of **1861**:
  - Required “either by fixing thereon the word patented, together with the day and year the patent was granted; or when, from the character of the article patented, that may be impracticable, by enveloping one or more of the said articles, and affixing a label to the package or otherwise attaching thereto a label on which the notice, with the date, is printed”
  - Fine abolished and penalty for “failure” to mark was now a limitation on the patentee's right to recover, such that “no damage shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued after such notice to make or vend the article patented.”

    12 Stat. 246, 249, § 13
- Some changes to wording in **1870** (*see* R.S. § 4900 (1878))
- Statute amended again in **1927**, replacing requirement to list “the day and year the patent was granted” with requirement to instead list “the number of the patent” (for patents granted on or after April 1, 1927)

  Ch. 67, 44 Stat. 1058-59
- Codified as 35 U.S.C. § 49 (1946 [last version before 1952 Patent Act])

HISTORY: 1952 TO THE PRESENT

- Re-codified as 35 U.S.C. § 287 in Patent Act of **1952**

  Ch. 950, 66 Stat. 813

- In 1988, labeled as subsection (a) (subsection (b) added, unrelated to marking)

  Pub. L. 100–418, title IX, § 9004(a), 102 Stat. 1564

- In **1994**, conforming amendments to part (a) to add offer for sale and importing language

  Pub. L. 103–465, title V, § 533(b)(6), Dec. 8, 1994, 108 Stat. 4990

- In 1996, subsection (c) added, unrelated to marking, which was amended in 1999 and 2011

  Pub. L. 104–208, div. A, title I, § 101(a) [title VI, § 616], 110 Stat. 3009, 3009–67 to -68, § 616; Pub. L. 112–29, §§ 3(g)(2), 16(a)(1), 20(i)(4), (j), 125 Stat. 288 and 335, §§ 3 and 20

- In **2011**, America Invents Act (AIA) added new virtual patent marking option

  Pub. L. 112–29, §§ 3(g)(2), 16(a)(1), 20(i)(4), (j), 125 Stat. 328-29, § 16

BASIC PATENT MARKING REQUIREMENTS

- In order to receive pre-actual-notice damages from infringers, the patentee (and authorized parties) must mark products covered by the patent with the word “patent” or the abbreviation “pat.”, together with the number of the patent or the Internet address (URL) for a posting accessible without charge that associates the product with the patent

  35 U.S.C. § 287(a)

CONSTRUCTIVE NOTICE

WHAT MATTERS	*WHAT DOESN'T MATTER*
<u>Patentee</u> Took Sufficient Action to Provide Proper Marking Notice (*in rem*)	**<u>Infringer</u> Actually Knew About Patent**
	<u>Infringer</u> Actually Saw Marking Notice

Devices for Medicine, Inc. v. Boehl, 822 F.2d 1062, 1066 (Fed. Cir. 1987); *Amsted Indus. Inc. v. Buckeye Steel Castings Co.*, 24 F.3d 178, 187 (Fed. Cir. 1994); *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1446 (Fed. Cir. 1998)

PURPOSE

- Marking requirements:
  1. help to avoid innocent infringement
  2. encourage patentees to give notice to the public that the article is patented
  3. aid the public to identify whether an article is patented

  Nike, Inc. v. Wal-Mart Stores, Inc., 138 F.3d 1437, 1443 (Fed. Cir. 1998)

- Provides "protection against deception by unmarked patented articles"

  Wine Ry. Appliance Co. v. Enter. Ry. Equip. Co., 297 U. S. 387, 397 (1936)

- Public may "exploit an unmarked product's features without liability for damages until a patentee provides either constructive notice through marking or actual notice."

  Rembrandt Wireless Techs., LP v. Samsung Elecs. Co., Ltd., 853 F.3d 1370, 1383 (Fed. Cir. 2017); *see also Bonito Boats, Inc. v. Thunder Craft Boats, Inc.,* 489 U.S. 141, 162 (1989) ("The public may rely upon the lack of notice")

WHAT MUST BE MARKED

- Claim(s) determine marking obligations, so patentee must initially:

  (1) Interpret claim(s) to ascertain correct scope, and

  (2) Compare claim(s) (as properly interpreted) to article(s) in question to determine if patented

  See Markman v. Westview Instruments, Inc., 52 F.3d 967, 976 (Fed. Cir. 1995) (*en banc*), ***aff'd***, 517 U.S. 370 (1996); *Clontech Labs., Inc. v. Invitrogen Corp.*, 406 F.3d 1347, 1352 (Fed. Cir. 2005)

WHAT MUST BE MARKED (CONT.)

- When no products have been produced, marking not required to recover pre-notice damages

  Tex. Digital Sys., Inc. v. Telegenix, Inc., 308 F.3d 1193, 1219-20 (Fed. Cir. 2002); *accord Wine Ry. Appliance Co. v. Enter. Ry. Equip. Co.*, 297 U.S. 387, 398 (1936)

- When a patent has only method / process claims, marking not required to recover pre-notice damages

  Bandag, Inc. v. Gerrard Tire Co., 704 F.2d 1578, 1581 (Fed. Cir. 1983) ("the notice requirement of this statute does not apply where the patent is directed to a process or method"); *accord ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.,* 694 F.3d 1312, 1334-35 (Fed. Cir. 2012) ("we reaffirm the bright-line easy to enforce rule: if the patent is directed only to method claims, marking is not required.")

WHAT MUST BE MARKED (CONT.)

- When a patent contains both method and apparatus claims, and any apparatus claims are asserted, a patentee is obligated to mark

  Am. Med. Sys., Inc. v. Med. Eng'g Corp., 6 F.3d 1523, 1538 (Fed. Cir. 1993); *Devices for Med., Inc. v. Boehl*, 822 F.2d 1062, 1066 (Fed. Cir. 1987)

- **Possible exception:** when a patent has both method and apparatus claims, but *only method claims are asserted*, marking is <u>not</u> required to recover pre-notice damages

  Crown Packaging Tech., Inc. v. Rexam Beverage Can Co., 559 F.3d 1308, 1316 (Fed. Cir. 2009) (rejecting dicta in *Am. Med. Sys*.); *Hanson v. Alpine Valley Ski Area, Inc.*, 718 F.2d 1075 (Fed. Cir. 1983); *but see Rembrandt Wireless Techs., LP v. Samsung Elecs. Co., Ltd.,* 853 F.3d 1370, 1382-84 (Fed. Cir. 2017) (statutory disclaimer of selected claim made a few days after complaint filed "cannot serve to retroactively dissolve the § 287(a) marking requirement for a patentee to collect pre-notice damages.")

WHAT MUST BE MARKED (CONT.)

Any left-side condition avoids need to prove notice for back damages

WHO MUST MARK

- "**Patentees**, ***and*** **persons** making, offering for sale, or selling within the United States any patented article **for or under them**"

  35 U.S.C. § 287(a) (emphasis added)

- Marking requirement "applies to authorizations by patentee of other persons to make and sell patented articles regardless of the particular form these authorizations may take and regardless of whether the authorizations are **'settlement agreements,' 'covenants not to sue' or 'licenses.'**"

  In re Yarn Processing Patent Validity Litig., 602 F. Supp. 159, 169 (W.D. N. Car. 1984) (emphasis added)

- Marking requirement also applies to ***implied*** **licensees** who make or sell patented product with implied permission of patentee

  Amsted Inds. Inc. v. Buckeye Steel Castings Co., 24 F.3d 178, 185 (Fed. Cir. 1994) (unpatented individual component sold with instructions for how to assemble into patented assembly created implied license requiring marking)

WHERE MARKING NOTICE MUST APPEAR

- 35 U.S.C. § 287(a) states that "**when**, from the character of the article," the patent marking cannot be applied to the product ("this can not be done"), ***then and only then*** the marking can be accomplished with a label affixed to the product or to a package for the product

- Under statutory scheme, marking product package generally ***not sufficient*** if product itself can be marked

  Zadro Prods., Inc. v. Feit Elec. Co., Inc., 514 F. Supp. 3d 1209, 1214-17 (C.D. Cal. 2021) (explaining statutory preference for marking products directly and how such marking can provide more effective notice than on packages/labels); *Wayne Gossard Corp. v. Sondra Mfg. Co.*, 434 F. Supp. 1340, 1364 (E.D. Pa. 1977) ("The statute sets forth the requirements for constructive notice, and provides for alternative marking only when the article cannot be directly marked."), *aff'd*, 579 F.2d 41 (3d Cir. 1978) (per curiam); *see also Global Traffic Techs. LLC v. Morgan*, 620 Fed. App'x 895, 906 (Fed. Cir. 2015) (nonprecedential) ("when a patentee marks the packaging rather than the article, the district court should evaluate the specific character of the article at issue");

WHERE MARKING NOTICE MUST APPEAR (CONT.)

- If product has or had other markings (*e.g.*, country of origin, branding, certifications, etc.), patent marking must be on product not package or label

  E.g., Zadro Prods., Inc. v. Feit Elec. Co., Inc., 514 F. Supp. 3d 1209, 1214-17 (C.D. Cal. 2021) (products had been marked "patent pending" so later marking only package with patent number insufficient); *Creative Pioneer Prods. Corp. v. K Mart Corp.*, 5 U.S.P.Q.2d 1841, 1848 (S.D. Tex. 1987) (patented tool had lettering and calibrations embossed on it so marking only packaging insufficient); *John L. Rie, Inc. v. Shelly Bros., Inc.*, 366 F. Supp. 84, 90-91 (E.D. Pa. 1973) (when products had been marked "PAT PEND." and had other inscriptions, marking the patent number only on packaging carton found insufficient)

- However, patentee should be given leeway in close call situations

  Sessions v. Romadka, 145 U.S. 29, 50 (1892) ("in a doubtful case, something must be left to the judgment of the patentee, who appears in this case to have complied with the alternative provision of the act, in affixing a label to the packages"); *see also Rutherford v. Trim-Tex, Inc.*, 803 F. Supp. 158, 161-62 (N.D. Ill. 1992) (some courts "generally apply a liberal construction of §287 and do not severely scrutinize the character of the patented articles to determine whether the article was capable of being marked") [minority view, called into question by cases like *Global Traffic Techs. LLC v. Morgan*, 620 Fed. App'x 895, 906 (Fed. Cir. 2015) (nonprecedential) and *Zadro*]

WHERE MARKING NOTICE MUST APPEAR (CONT.)

- Marking product literature not sufficient if product can be marked

  E.g., Egenera, Inc. v. Cisco Sys., Inc., 547 F. Supp. 3d 112, 126-27 (D. Mass. 2021) (marking four user manuals insufficient when no reason established why licensee's hardware could not be marked directly); *Metrologic Instruments, Inc. v. PSC, Inc.*, No. 99-cv-04876, 2004 WL 285195 (D.N.J. Dec. 13, 2004) (granting summary judgment of no constructive notice when marking pat. nos. directly on products ceased and the only marking on product or package was a label that said, "See User's Guide for Patent Coverage," which patentee admitted was done for marketing reasons and aesthetics)

  But see, e.g., Rexnord, Inc. v. Laitram Corp., 6 U.S.P.Q.2d 1817, 1845 (E.D. Wis. 1988) (some patent numbers marked on product and additional one listed in accompanying installation instructions found to meet marking requirements)

- Marked literature must, at a minimum, actually be distributed with product (*e.g.*, inside its package)

  E.g., Acantha LLC v. Depuy Orthopaedics Inc., No. 15–CV–01257, 2018 WL 1951231 (E.D. Wis. Apr. 25, 2018); *Stryker Corp. v. Intermedics Orthopedics, Inc.,* 891 F. Supp. 751, 829-30 (E.D.N.Y. 1995), ***aff'd***, 96 F.3d 1409 (Fed. Cir. 1996)

WHERE MARKING NOTICE MUST APPEAR (CONT.)

- What product characteristics might establish infeasibility?
  - Impossibility of holding markings (*e.g.*, patented liquid or powder)
  - Size constraints / legibility
  - Interference with use (*e.g.*, biocompatibility, all surfaces functional)
  - Visibility

- What are bad reasons?
  - Subjective preference
  - Convenience
  - No one else does it (*i.e.*, failure of others)
  - Anything contradicted by evidence!

HOW: FORM OF MARKING

- Notice must include “patent” or “pat.”

  E.g., A to Z Machining Serv., LLC v. Nat'l Storm Shelter, LLC, 10-CV-00422, 2011 U.S. Dist. LEXIS 149387, 2011 WL 6888543 (W.D. Okla. Dec. 29, 2011) (“The statute's language is clear: the website 'together with' either the word 'patent' or 'pat.' must be marked on the item. Accordingly, Plaintiffs' affixing their website to the storm shelter, without including the word 'patent' or the abbreviation thereof, fails to give notice”)

- Notice must include patent number(s) *or* URL for online association

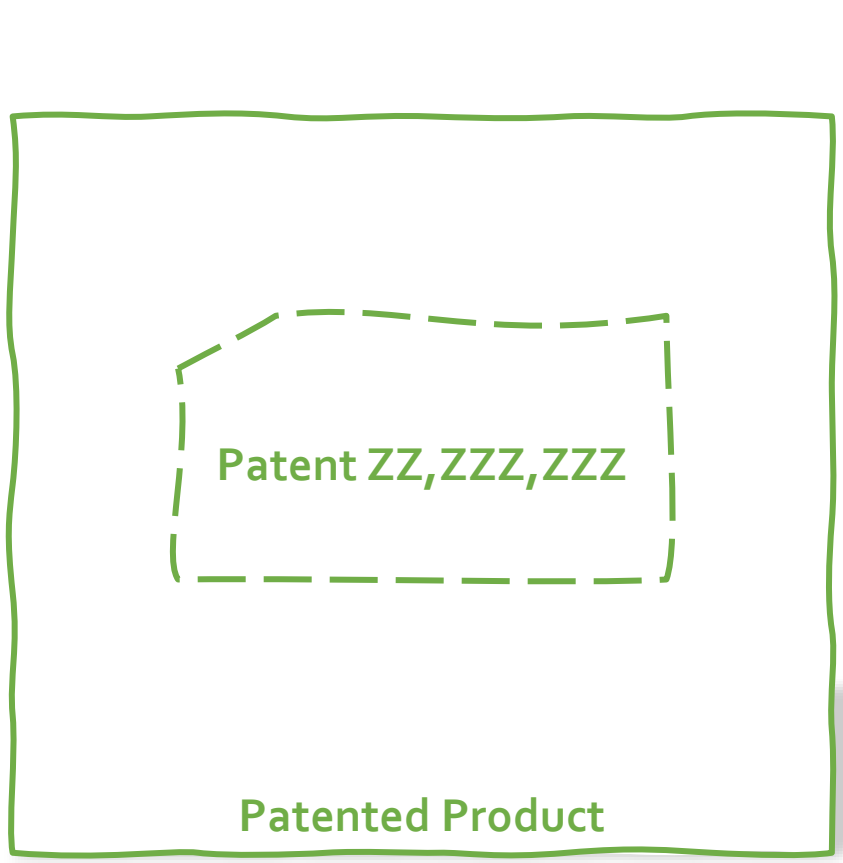
  E.g., Metrologic Instruments, Inc. v. PSC, Inc., No. 99-cv-04876, 2004 WL 285195 (D.N.J. Dec. 13, 2004); *see also* ch. 67, 44 Stat. 1058 (Feb. 7, 1927) (pat. no. requirement added) *and* Pub. L. 112–29, § 16(a), 125 Stat. 328 (Sept. 16, 2011) (virtual marking option added)

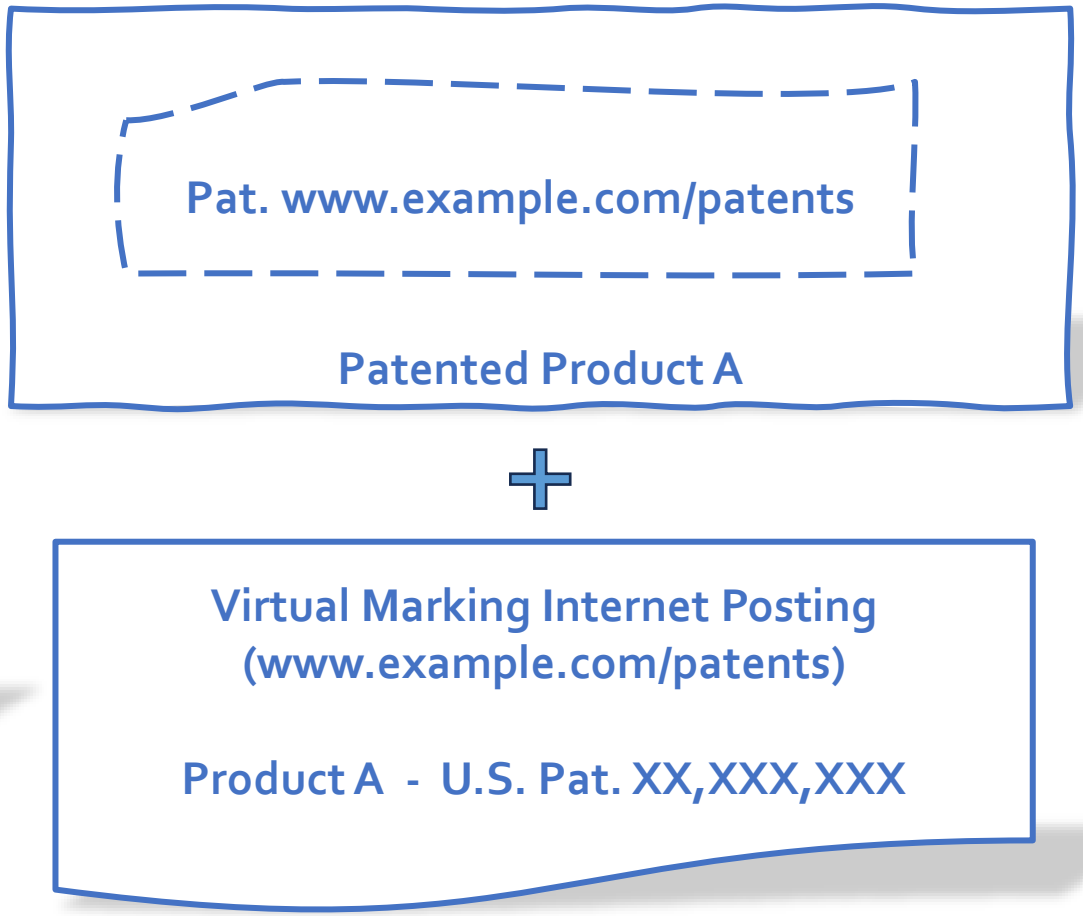
- Marking must be legible

  E.g., Trussell Mfg. Co. v. Wilson-Jones Co., 50 F.2d 1027, 1030 (2d Cir. 1931) (“He must mark his goods plainly. He cannot placate the trade by using only illegible references to his patent monopoly and yet put competitors on notice on the theory that their interest will be keen enough to induce them to employ a magnifying glass to discover what the marking says. He cannot eat his cake and have it too.”)

Cf. 37 C.F.R. § 202.2 (copyright notice guidelines)

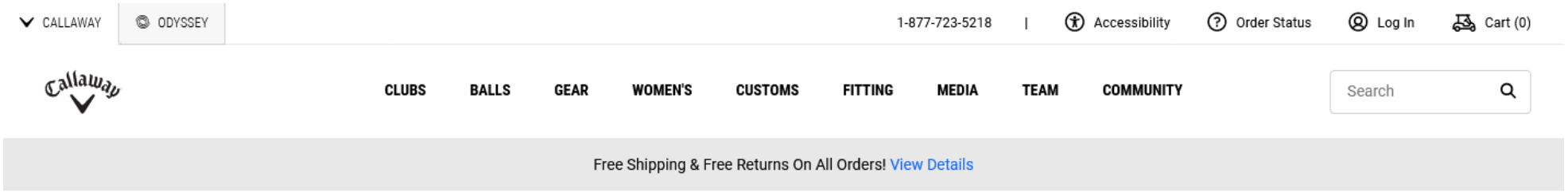
HOW: FORM OF MARKING (CONT.)





HOW: FORM OF MARKING (CONT.)

HOW: PATENT-TO-PRODUCT ASSOCIATION



Callaway Golf believes that investing in the best research and design in the business leads to the development of superior products. The Company spends tens of millions of dollars on research and design every year, and our patents represent that investment. Callaway Golf typically files more than 100 U.S. patent applications per year. In our 30-year history, we have established what we believe is one of the largest patent portfolios in golf. A patent portfolio that consists of more than 1,200 U.S. patents—all part of our commitment to protect the innovations that set us apart in the golf industry.

In accordance with Section 287(a) of Title 35 of the United States Code, the reader is hereby placed on notice of Callaway Golf Company's rights in the United States Patents listed on this site and associated with the following products.

Patents related to older products may be viewed here.

Woods:

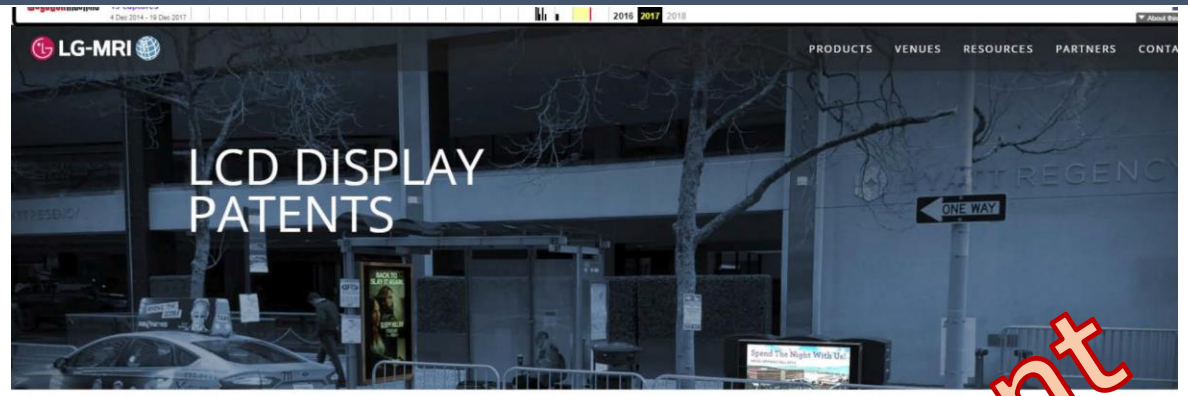
Big Bertha Beta Driver

- D786,993
- D726,856

Big Bertha Fusion Driver

- D773,577
- D813,327

HOW: PATENT-TO-PRODUCT ASSOCIATION (CONT.)



App. No.	Title	App Date	Grant Date	Patent No.	
12/787,152	A METHOD FOR DRIVING A COOLING FAN WITHIN AN ELECTRONIC DISPLAY	05/25/2010	04/15/2	8,70[illegible]6	United States
12/266,749	ADVERTISING DISPLAYS	11/07/2008	[illegible]	8,[illegible]52	United States
13/858,426	APPARATUS AND METHOD FOR ASSEMBLING LARGE ELECTRONIC DISPLAYS	04/08/2013	[illegible]/13	[illegible]6 9,317,060	United States
12/124,741	BACKLIGHT ADJUSTMENT SYSTEM	[illegible]	[illegible]28/2012	8,125,163	United States
⋮					
	ELECTRONIC DISPLAY				States
13/569,753	WIRE PASS TH[illegible]IGH[illegible]VICE	08/08/2012	06/23/2015	9,065,259	United States
14/741,118	WIRE[illegible] [illegible]MISSION SYSTEM FOR [illegible]OUI[illegible]E DIS[illegible]	06/16/2015	12/27/2016	9,526,352	United States
14/247,6[illegible]	[illegible]THOD FOR MAINTAINING A CO[illegible]TENT TEMPERATURE GRADIENT ACROSS AN E[illegible]TRONIC DISPLAY	04/08/2014	03/14/2017	9,594,271	United States

One or more of the above listed MRI patents may be used by LG-MRI products under license from MRI, Inc.

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Held Insufficient

Mfg. Res. Int'l, Inc. v. Civiq Smartscapes, LLC, 397 F. Supp. 3d 560, 577-78 (D. Del. 2019)

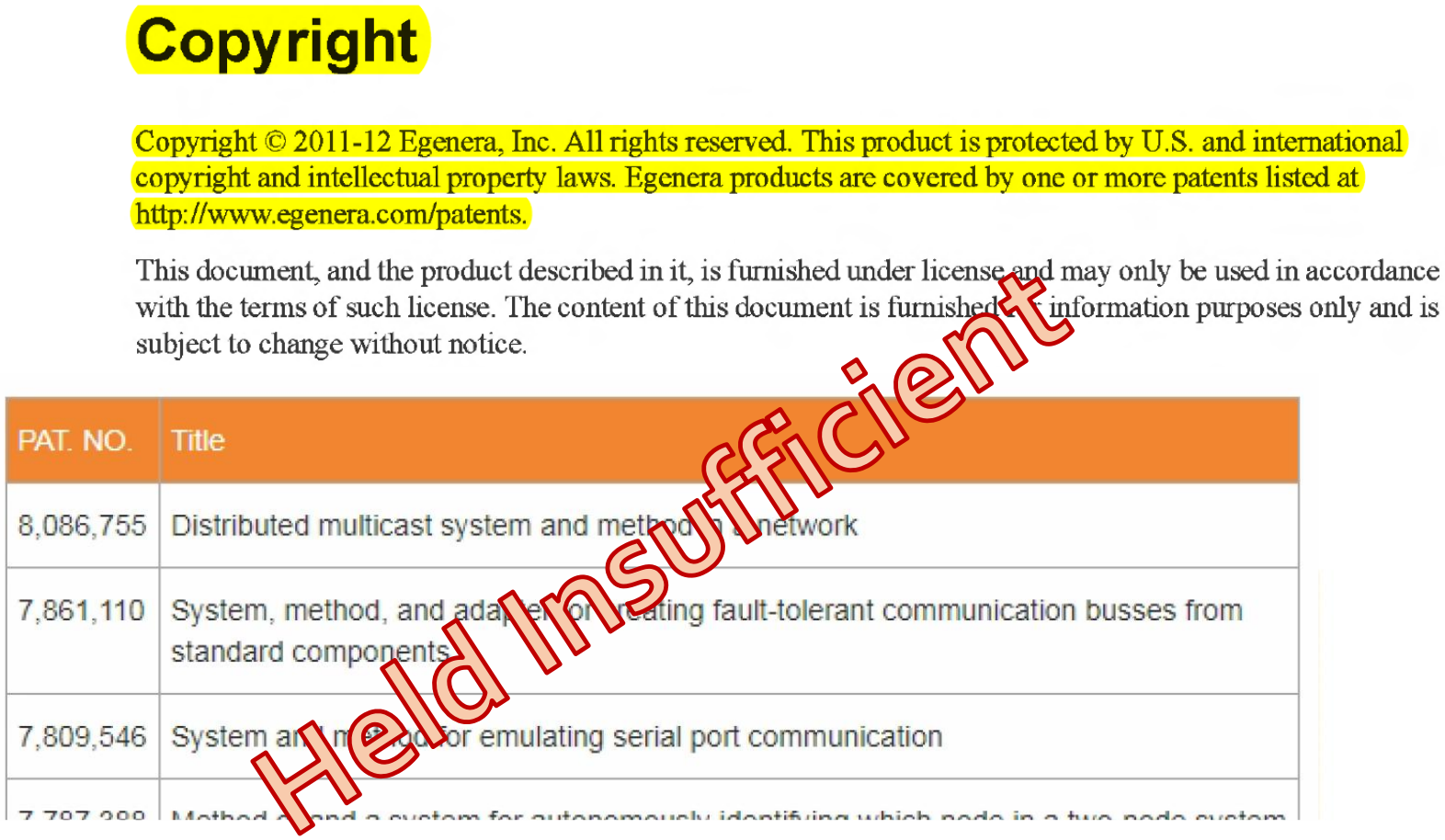
- "**Simply listing all patents that could possibly apply to a product or all patents owned by the patentee on the patentee's marking website does not give the public notice. It merely creates a research project for the public.**"
  - "Plaintiff has submitted various iterations of its marking website. (D.I. 242, Ex. EEEE). One such iteration lists 94 patents, with 77 of those being United States patents, but **makes no reference to specific LG-MRI products**. (Id. at 193-202). At the bottom of the list of patents in this iteration, the website states, 'One or more of the above listed MRI patents may be used by LG-MRI products under license from MRI, Inc.' (D.I. 242 at 202)." (emphasis added)
  - "Plaintiff's website does nothing to 'associate' any specific product it has marked with the patents which cover it. **While the website clarifies the patent category (LCD Display Patents), it does not mention a single specific patented article by product number or product name (e.g., CoolVu, BoldVu)**. (Id. at 153-257). **Thus, the website does nothing to 'associate' any of 112 patents with any of the 46 identified covered products** . . ." (emphasis added)

HOW: PATENT-TO-PRODUCT ASSOCIATION (CONT.)

VLSI Tech. LLC v. Intel Corp., No. 1:19-CV-00977, 2021 WL 2773013 (W.D. Tex. April 12, 2021)

- "Although the link . . . only directed a user to Sigmatel's homepage, not the patents page, **even if the user stumbled upon the patents page, they would find no statement that the '522 and '187 patents were practiced by the 35XX products or any others**. Rather, they would find a 15×4 cell datasheet listing numerous patents. This Court adopts the . . . reasoning of the Delaware Court that **rejects this sort of 'research project'**"

HOW: PATENT-TO-PRODUCT ASSOCIATION (CONT.)



Copyright

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PAT. NO.	Title
8,086,755	Distributed multicast system and method in a network
7,861,110	System, method, and adapter for creating fault-tolerant communication busses from standard components
7,809,546	System and method for emulating serial port communication
7,787,388	Method and a system for autonomously identifying which node in a two-node system

Held Insufficient

Egenera, Inc. v. Cisco Sys., Inc., 547 F. Supp. 3d 112, 126-28 (D. Mass. 2021)

- "webpage displays only a table of patent numbers and titles, and **does not include the product information** that it now seeks to rely on.[19] Further, **that a smaller number of patents entails a less time-consuming research project does not alter the fact that the webpage does not provide the statutorily required association** between a patented product and the applicable patents."

HOW: PATENT-TO-PRODUCT ASSOCIATION (CONT.)

- Similar issues arise even for traditional (non-virtual) marking:
  - "He must mark his goods plainly. *** He cannot eat his cake and have it too."

    See Trussell Mfg. Co. v. Wilson-Jones Co., 50 F.2d 1027, 1030 (2d Cir. 1931) (illegibly small marking held inadequate)

  - Sufficiently clear **nexus** required for marking to be adequate

    IMX, Inc. v. Lendingtree, LLC, No. 03-CV-1067, 2005 WL 3465555, at *2-4 (D. Del. Dec. 14, 2005) (indications on website lacked nexus to system for server-based loan processing claims)

  - "As [Magistrate] Judge Stark and [defendant] Swisslog correctly note, **a user has no way of knowing which patents listed on the log-in screen cover which of the multiple products controlled by the** Connect-Rx **software**, **or whether the patents cover the** Connect-Rx **software itself**. The court concludes that the marking displayed by the Connect-Rx software does not sufficiently apprise the public that the Robot-Rx [product] is covered by the patents-in-suit."

    McKesson Automation, Inc. v. Swisslog Italia S.P.A., 712 F.Supp.2d 283, 296-97 (D. Del. 2010) (emphasis added)

HOW: PATENT-TO-PRODUCT ASSOCIATION (CONT.)

Best practices:

- Assess claims and identify specific patented articles in good faith
  - Don’t misstate, overstate, inflate, or exaggerate patent coverage (no matter how much patentee wants to)
- Don’t get cute or use non-informing “notice”
  - Be clear, upfront, and accurate about what is covered (and not covered), adding explanations where needed
    - Ask yourself: would you be happy (or satisfied) if your competitor’s marking associations were like yours?
  - Don’t impose a research project or otherwise shift burden to the public
    - Clearly identify specific patented product(s) by model number or the like (and not merely general category)
    - Clearly link specific patent number(s) with specific patented product(s), and no others
- Use an accessible format/layout that is as simple as possible but no simpler (Einstein)
  - Legible!
  - Avoid login requirements, visitor tracking, complex menus (*e.g.*, no precision clicking required), anything buggy or weird
  - Convey same information to blind & colorblind visitors too (*e.g.*, use sufficiently informing alt text labels for images, if any)
- Update, update, update!
  - Later patent grants, reissues, expirations/lapses, invalidations, etc.?
  - New and modified product offerings?

HOW: SUFFICIENCY OF MARKING

- Once marked, a patentee's marking must be "substantially consistent and continuous."

  Nike, Inc. v. Wal-Mart Stores, Inc., 138 F.3d 1437, 1446 (Fed. Cir. 1998)

- Examples:
  - *Radware, Ltd. v. F5 Networks, Inc.*, 147 F. Supp. 3d 974, 1010 (N.D. Cal. 2015) (patentee sold three different products practicing one or more claims of asserted patents; marking only one but not all three patented products precluded pre-suit damages)
  - *Funai Elec. Co v. Daewoo Elecs. Corp.*, 616 F.3d 1357, 1374-75 (Fed. Cir. 2010) (evidence that 88-91% of patented products were marked supported verdict that such marking was substantially consistent and continuous)
  - *Metrologic Instruments, Inc. v. PSC, Inc.*, No. 99-CV-04876, 2004 WL 285195 (D.N.J. Dec. 13, 2004) (no constructive notice when marking of patent numbers directly on products ceased in favor of deficient notice)
  - *Nike,* 138 F.3d at 1447 (remanded to determine whether patentee's alleged 96.6% marking compliance was accurate figure, where patentee continued to distribute unmarked products and to sell unmarked products from outlet stores even after suit filed and allegedly did not maintain complete records of marking compliance)
  - *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1111 (Fed. Cir. 1996) (licensee marking 95% of patented products was substantially consistent and continuous)

HOW: SUFFICIENCY OF MARKING (CONT.)

- Authorized party compliance
  - "[W]ith third parties unrelated to the patentee, it is often more difficult for a patentee to ensure compliance with the marking provisions. A **'rule of reason'** approach is justified in such a case and **substantial compliance may be found to satisfy the statute**."
  - "Therefore, when . . . the failure to mark is caused by someone other than the patentee, the court may consider **whether the patentee made reasonable efforts to ensure compliance with the marking requirements**."

Maxwell v. J. Baker, Inc., 86 F.3d 1098, 1111-12 (Fed. Cir. 1996) (emphasis added)

CURING DEFECTIVE MARKING

- Possible to cure defective marking if and when patentee begins consistently marking substantially all patented products and stops distributing unmarked products

  Am. Med. Sys., Inc. v. Med. Eng'g Corp., 6 F.3d 1523, 1538 (Fed. Cir. 1993) *cert. denied* 511 U.S. 1070 (1994)

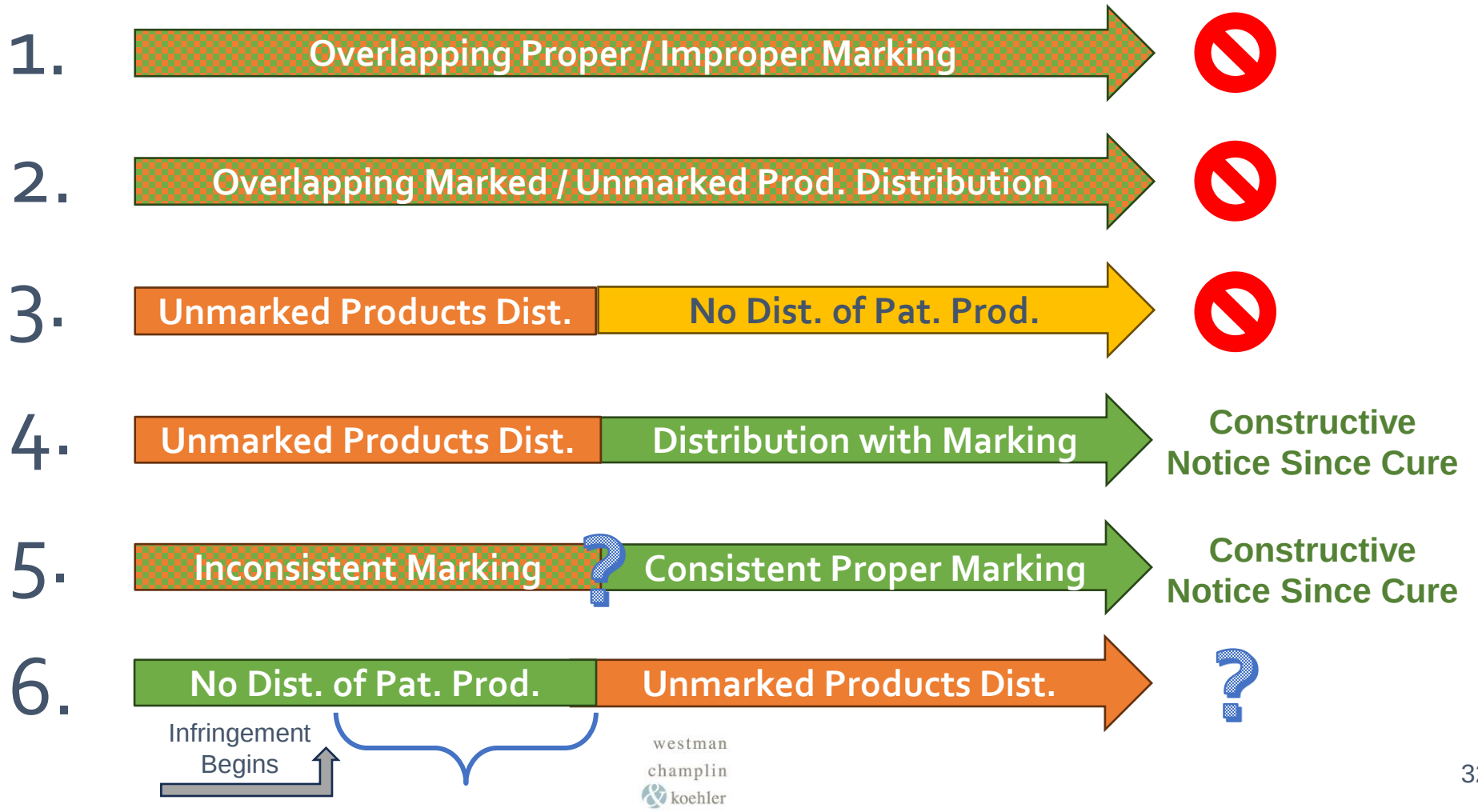
- Merely stopping distribution of unmarked products is not sufficient – must affirmatively begin/resume distribution with proper marking

  Arctic Cat, Inc. v. Bombardier Recreational Prods., Inc., 950 F.3d 860, 861,864-66 (Fed. Cir. 2020) (*Arctic Cat II*)

- What if unmarked articles distributed, but only *after* infringement begins?

  E.g., NXP USA, Inc. v. Impinj, Inc., No. 2:20-CV-01503 (W.D. Wash. May 4, 2023)

CURING DEFECTIVE MARKING (CONT.)



PLEADING AND PROVING MARKING

- Must plead marking in complaint / counterclaim !
  - "[T]he **duty of alleging, and the burden of proving**, either of these facts[, **marking the articles**, or notice to the infringers,] **is upon the plaintiff**."

    Dunlap v. Schofield, 152 U.S. 244, 248 (1894) (emphasis added) *accord Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1111 (Fed. Cir. 1996); *but see, e.g., Sentry Protection Prods., Inc. v. Eagle Mfg. Co*., 400 F.3d 910, 918 (Fed. Cir. 2005) (pleading "infringements have been willful and with full knowledge of the '611, and '781 patents" held sufficient to avoid waiver of constructive notice marking arguments [relying on questionably truncated quote from *Dunlap*; conflicts with precedent like *Boehl* and *Amsted* that said what was pled here is irrelevant])

- Alleged infringer challenging marking compliance bears initial burden of production to articulate the products it believes are unmarked "patented articles"
  - "To be clear, this is a low bar. The alleged infringer need only put the patentee on notice that he or his authorized licensees sold specific unmarked products which the alleged infringer believes practice the patent. The alleged infringer's burden is a burden of production, not one of persuasion or proof."
  - "The burden of proving compliance with marking is and at all times remains on the patentee."

    Arctic Cat, Inc. v. Bombardier Recreational Prods., Inc., 876 F. 3d 1350, 1366-68 (Fed. Cir. 2017) (*Arctic Cat I*)

FALSE MARKING

Limits on Marking: Penalties for Mismarking Unpatented Articles or Falsely Advertising Patent Status for the Purpose of Deceiving the Public; Counterfeit Marking Prohibitions

POLICY RATIONALE

- Marking notice requirement "**provides a ready means of discerning the status of the intellectual property** embodied in an article of manufacture or design. The **public may rely upon the lack of notice** in exploiting shapes and designs accessible to all."

  Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 162 (1989) (emphasis added) (citations omitted); *Wine Ry. Appliance Co. v. Enter. Ry. Equip. Co.*, 297 U. S. 387, 397 (1936) (statutory marking requirement is "for the information of the public" and provides "protection against deception by unmarked patented articles")

- False marking:

  (1) **misleads the public** into believing that a patentee controls the article in question (as well as like articles),

  (2) **externalizes the risk of error in the determination**, placing it on the public rather than the manufacturer or seller of the article, and

  (3) **increases the cost to the public** of ascertaining whether a patentee in fact controls the intellectual property embodied in an article

  Clontech Labs., Inc. v. Invitrogen Corp., 406 F.3d 1347, 1356-57 and n.6 (Fed. Cir. 2005)

- *See also*
  - 18 U.S.C. § 497 prohibition on forging patents
  - Lanham Act § 43(a) false advertising and state unfair competition law
  - FTC Act § 5 unfair methods of competition

35 U.S.C. § 292

Counterfeiting & Imitation (incl ads)

(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

False Marking & Advertising

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—

Crime

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

Civil Action

(b) A person who has suffered a competitive injury as a result of a violation of this section may file a civil action in a district court of the United States for recovery of damages adequate to compensate for the injury.

Expiration Exclusion

(c) The marking of a product, in a manner described in subsection (a), with matter relating to a patent that covered that product but has expired is not a violation of this section.

HISTORY: PRE-1952 PATENT ACT

Penalty for infringing the rights of a patentee, &c. by marking.

SEC. 5. *And be it further enacted*, That if any person or persons shall paint or print, or mould, cast, carve, or engrave, or stamp, upon any thing made, used, or sold, by him, for the sole making or selling which he hath not or shall not have obtained letters patent, the name or any imitation of the name of any other person who hath or shall have obtained letters patent for the sole making and vending of such thing, without consent of such patentee, or his assigns or legal representatives; or if any person, upon any such thing not having been purchased, from the patentee, or some person who purchased it from or under such patentee, or not having the license or consent of such patentee, or his assigns or legal representatives, shall write, paint, print, mould, cast, carve, engrave, stamp, or otherwise make or affix the word "patent," or the words "letters patent," or the word "patentee," or any word or words of like kind, meaning, or import, with the view or intent of imitating or counterfeiting the stamp, mark, or other device of the patentee, or shall affix the same or any word, stamp, or device, of like import, on any unpatented article, for the purpose of deceiving the public; he, she, or they, so offending, shall be liable for such offence, to a penalty of not less than one hundred dollars, with costs, to be recovered by action in any of the circuit courts of the United States, or in any of the district courts of the United States, having the powers and jurisdiction of a circuit court; one half of which penalty, as recovered, shall be paid to the patent fund, and the other half to any person or persons who shall sue for the same.

How recoverable, &c.

Patent Act of 1842, 5 Stat. 543, 544, §5 (1842)

Penalty for falsely marking or labeling articles as patented.

8 July, 1870, c. 230, s. 39, v. 16, p. 203.

SEC. 4901. Every person who, in any manner, marks upon anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor without the consent of such patentee, or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any such patented article the word "patent" or "patentee," or the words "letters-patent," or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offense, to a penalty of not less than one hundred dollars, with costs; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed.

Revised Statutes, § 4901 (1878)

§ 50. Falsely marking or labeling articles; penalty.

Every person who, in any manner, marks upon anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor without the consent of such patentee, or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any such patented article the word "patent" or "patentee," or the words "letters patent" or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offense, to a penalty of not less than $100, with costs; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed. (R. S. § 4901.)

DERIVATION

Act July 8, 1870, ch. 230, § 39, 16 Stat. 203.

35 U.S.C. § 50 (1946)

HISTORY: 1994 AND 2011 AMENDMENTS TO § 292 (1952)

- 1994:
  - Conforming amendments to part (a) to add offer for sale and importing language

    Pub. L. 103–465, title V, § 533(b)(6), Dec. 8, 1994, 108 Stat. 4990
- 2011 (AIA, § 16):
  - Part (a) amended to confirm elimination of *qui tam* actions (added: "Only the United States may sue for the penalty authorized by this subsection"; uncodified effective date statement also terminated pending *qui tam* lawsuits)
  - Part (b) amended to replace old *qui tam* provision with new civil cause of action for "competitive injury" damages
  - Part (c) newly added to eliminate liability for marking a product with expired patent ("marking of a product . . . with matter relating to a patent that covered that product but has expired is not a violation . . . .")
    - [note: "product" vs. "article" and "marking of a product" vs. "uses in advertising"]

    Pub. L. 112–29, § 16(b)(1)–(3), Sept. 16, 2011, 125 Stat. 329

CONFUSING (PARTIAL) ABROGATION OF CASELAW

- Unaffected / Not Abrogated:
  - Policy rationale
    Sukumar v. Nautilus, Inc., 785 F.3d 1396, 1401-02 (Fed. Cir. 2015); *but see also* 35 U.S.C. § 298
  - Two elements of cause of action: falsity by inapplicability and intent
    First three clauses of § 292(a) not amended
  - Per article liability (gov't prosecutions only)
    H.R. Rep. 112-98, 53, 2011 U.S.C.C.A.N. 67, 84 (under AIA, U.S. gov't would still be "allowed to seek the $500-per-article fine")
- Probably / Possibly Not Abrogated:
  - Advertising as "patented" without "[t]he marking of a product" when only expired patent(s) apply
    But see, e.g., Introsan Dental Prods., Inc. v. Dentsply Tulsa Dental, LLC, No. 09-CV-03111, 2012 WL 3011830 (D. Md. July 20, 2012) (dicta)
- Clearly Abrogated:
  - *Qui tam* actions
    Hall v. Bed Bath & Beyond, Inc., 705 F.3d 1357, 1373 (Fed. Cir. 2013)
  - Liability for marking product with applicable but expired patent
    35 U.S.C. § 292(c)
- Probably / Possibly Also Abrogated or Inapplicable:
  - Strict construction of penal statute in new "competitive injury" civil actions
  - Criminal intent/*mens rea* standard in new "competitive injury" civil actions
    See Brooks v. Dunlop Mfg. Inc., 702 F.3d 624, 629 (Fed. Cir. 2012)

DIFFERENT THRESHOLDS: CONSTRUCTIVE NOTICE VS. FALSE MARKING

- "[S]ometimes a falsely marked product is also properly marked with other patents"

  Sukumar v. Nautilus, Inc., 785 F.3d 1396, 1402 (Fed. Cir. 2015)

- Constructive notice (§ 287(a)) requires both "patent"/"pat" **and** patent no. (incl. virtual):
  - "may give notice . . . , 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 . . ."
- Falsity of marking/advertising (§ 292(a)) can occur with only **one or the other**, or merely patent pending:
  - "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" (emphasis added)
  - "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" (emphasis added)

DIFFERENT THRESHOLDS: CONSTRUCTIVE NOTICE VS. FALSE MARKING (CONT.)

DIFFERENT THRESHOLDS: CONSTRUCTIVE NOTICE VS. FALSE MARKING (CONT.)

“PATENTED WORLDWIDE” OR “PATENTED INTERNATIONALLY”

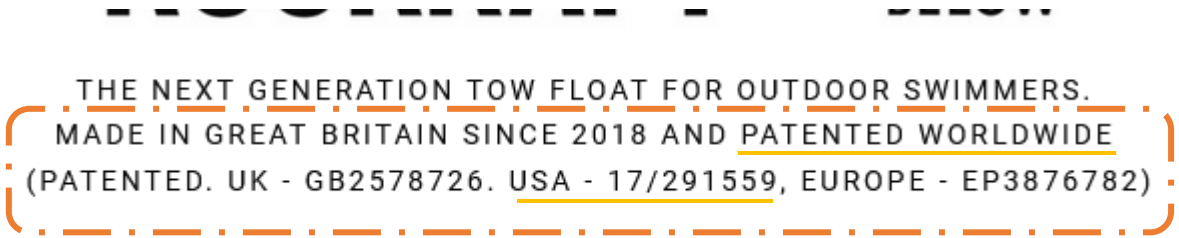
AN AUTHENTIC REVOLUTION. Tannus anti-puncture tires are made of a worldwide patented material called Aither. This material made from polymers and olefin co-polymers contains about 1,000,000,000 (billion) micro “bubbles” of closed air in each tire, representing a real revolution among bicycle tires.

- **The safest tires on the planet**

Our tires have a rim anchorage system by Pins®, patented worldwide, that provide great security and make the performance optimal.

A tire has 40 points of anchorage by Pins ®, which provides stability, security and rigidity. These PINs secure the Tannus to the rim and make it impossible to detach.

Even if you are driving at high speed and a nail is stuck or a puncture occurs, you will not lose stability and with Tannus you can continue without worrying.



ELEMENTS OF FALSE MARKING

(Non-counterfeiting) § 292 false marking claims have two/three elements:

(1) falsity in marking an unpatented article, or in advertising article as patented or pat. pend. or importing (*i.e.*, implying) the same, *and*

(2) intent to deceive the public

Forest Group, Inc. v. Bon Tool Co., 590 F.3d 1295, 1300 (Fed. Cir. 2009) *abrogated in part on other grounds by statute as recognized by Sukumar v. Nautilus, Inc.*, 785 F.3d 1396, 1399-1402 (Fed. Cir. 2015); *Juniper Networks, Inc. v. Shipley*, 643 F.3d 1346, 1350-52 (Fed. Cir. 2011) (addressing "affixing with a label" and "advertising" prongs of § 292 as distinct from "marking upon" prong)

(3) competitive injury as a result of the false marking (civil action plaintiffs)

Sukumar, 785 F.3d at 1399-1402; *Hall v. Bed Bath & Beyond, Inc.*, 705 F.3d 1357, 1373 (Fed. Cir. 2013)

FALSITY

- "When the statute refers to an 'unpatented article' the statute means that the article in question is **not covered by at least one claim of each patent with which the article is marked**."

  Clontech Labs., Inc. v. Invitrogen Corp., 406 F.3d 1347, 1356-57 (Fed. Cir. 2005) (emphasis added)

- Determining whether an article is "unpatented" under § 292 involves:

  (1) interpreting the claim in question to ascertain its correct scope, and

  (2) ascertaining if the claim (as interpreted) reads on the article in question

  Clontech Labs., 406 F.3d at 1352; *cf. Markman v. Westview Instruments, Inc.,* 52 F.3d 967, 976 (Fed. Cir. 1995) (*en banc*), ***aff'd***, 517 U.S. 370 (1996) (two-step § 271 infringement analysis)

- Plus:
  - Omission of applicable patents cannot, in itself, be false marking

    Arcadia Mach. & Tool, Inc. v. Sturm, Ruger & Co., 786 F.2d 1124, 1125 (Fed. Cir. 1986)
  - Marking "patent pending" on (patented) articles after patent has issued is not false marking

    Hall v. Bed Bath & Beyond, Inc., 705 F.3d 1357, 1373 (Fed. Cir. 2013)
  - Threatened false marking insufficient; article must be completed and marked

    Lang v. Pac. Marine & Supply Co., 895 F.2d 761, 765 (Fed. Cir. 1990)
  - False advertising must involve actual advertisement of patented status of an unpatented product

    Juniper Networks, Inc. v. Shipley, 643 F.3d 1346, 1351-52 (Fed. Cir. 2011)

INTENT

- "Intent to deceive is a state of mind arising when a party acts with sufficient knowledge that what it is saying is not so and consequently that the recipient of its saying will be misled into thinking that the statement is true. *** Thus, 'objective standards' control and 'the *fact* of misrepresentation coupled with proof that the party making it had knowledge of its falsity is enough to warrant drawing the inference that there was a fraudulent intent'."

  Clontech Labs. Inc. v. Invitrogen Corp., 406 F.3d 1347, 1352 (Fed. Cir. 2005) (citation omitted; emphasis in original); *see also Krieger v. Colby,* 106 F. Supp. 124, 130 (S.D. Cal.1952) ("The presumption is, until the contrary appears, that the mark was placed on the article with the intention to deceive.")

- "[T]o establish knowledge of falsity the plaintiff must show by a preponderance of the evidence that the party accused of false marking did not have a reasonable belief that the articles were properly marked (i.e., covered by a patent)."

  Clontech Labs., 406 F.3d at 1352-53

- "[T]he required intent is not intent to perform an act, *viz.*, falsely mark a product, but instead intent to deceive the public."

  Pequignot v. Solo Cup Co., 608 F.3d 1356, 1364 (Fed. Cir. 2010) *abrogated in part by statute* (nonprecedential?)

- "[C]ombination of a false statement and knowledge that the statement was false creates a rebuttable presumption of intent to deceive the public, rather than irrebuttably proving such intent"

  Pequignot, 608 F.3d at 1362-63 *abrogated in part by statute* (nonprecedential?)

INTENT (CONT.)

- "[W]here one 'has an honest, though mistaken, belief that upon a proper construction of the patent it covers the article which he marks,' the requisite intent to deceive the public would not be shown."

  Clontech Labs., 406 F.3d at 1352 (*quoting London v. Everett H. Dunbar Corp.,* 179 F. 506, 510 (1st Cir.1910) *rejected in part on other grounds by Forest Group, Inc. v. Bon Tool Co.,* 590 F.3d 1295, 1304 (Fed. Cir. 2009); and *citing Brose v. Sears, Roebuck and Co.*, 455 F.2d 763, 768-69 (5th Cir.1972))

- "[T]he mere assertion by a party that it did not intend to deceive will not suffice to escape statutory liability. Such an assertion, standing alone, is worthless as proof of no intent to deceive where there is knowledge of falsehood."

  Clontech Labs., 406 F.3d at1352-53; *see also, e.g., Sadler-Cisar, Inc. v. Commercial Sales Network, Inc.,* 786 F. Supp. 1287, 1296 (N.D. Ohio 1991) ("mere fact that they had consulted a patent attorney does not exonerate them"); *cf. SRI Int'l, Inc. v. Advanced Tech. Labs., Inc.,* 127 F.3d 1462, 1465 (Fed. Cir. 1997) ("When [an advice of counsel] defense is raised the court may consider the nature of the advice, the thoroughness and competence of the legal opinion presented, and its objectivity. The court will determine whether the advice of noninfringement or invalidity or unenforceability could have reasonably been relied on, and whether, on the totality of the circumstances, exculpatory factors avert a finding of willful infringement.")

- Can use letter to eliminate innocent intent defense by party falsely marking / advertising

  Johnston v. Textron, Inc., 579 F. Supp. 783, 794-96 (D.R.I. 1984), ***aff'd***, 758 F.2d 666 (Fed. Cir. 1984) *abrogated in part on other grounds*

- Willful blindness?

  Cf. Motiva Patents, LLC v. Sony Corp., 408 F. Supp. 3d 819, 836-38 (E.D. Tex. 2019) ("Since . . . willful blindness is a substitute for actual knowledge in the context of [induced] infringement, it follows that willful blindness is also a substitute for actual knowledge with respect to willful infringement.")

- Intent to deceive public *about patentee's burden* to determine whether article is patented?

COMPETITIVE INJURY

A. Current commercial rival
- "'[a] wrongful economic loss caused by a commercial rival, such as the loss of sales due to unfair competition; a disadvantage in a plaintiff's ability to compete with a defendant, caused by the defendant's unfair competition.' Black's Law Dictionary (9th ed. 2009)." (alternation in original)
- "To suffer a disadvantage in the 'ability to compete,' an entity must have some present ability to compete—if only in part—that is disadvantaged."

B. Potential competitor
- "§ 292 must [also] include what is arguably the most egregious type of competitive injury: the prevention of market entry altogether."
- More than pure subjective intent required:
  1. Intent to enter the market with a reasonable possibility of success; and
  2. An action to enter the market ("Dreaming of an idea but never attempting to put it into practice is insufficient.")
     - Business plan developed? Prototype designed? Engineering knowledge amassed? Manufacturing capacity development investigated?

- Standing present if competitive injury was caused by the alleged false marking

Sukumar v. Nautilus, Inc., 785 F.3d 1396, 1400-02 (Fed. Cir. 2015)

COMPETITIVE INJURY (CONT.)

- Many open questions:
  - Is burden/cost of investigation a competitive injury due to false marking?

    See Clontech Labs., Inc. v. Invitrogen Corp., 406 F.3d 1347, 1356-57 and n. 6 (Fed. Cir. 2005) (it "increases the cost to the public of ascertaining whether a patentee in fact controls the intellectual property embodied in an article" "In each instance where it is represented that an article is patented, a member of the public desiring to participate in the market for the marked article must incur the cost of determining whether the involved patents are valid and enforceable. Failure to take on the costs of a reasonably competent search for information necessary to interpret each patent, investigation into prior art and other information bearing on the quality of the patents, and analysis thereof can result in a finding of willful infringement, which may treble the damages an infringer would otherwise have to pay")

    Cf., e.g., Engstrom v. Whitebirch, Inc., 931 N.W.2d 786, 787 (Minn. 2019) ("person who is targeted by a fraudulent demand and consequently pays an attorney to investigate his liability in response to that demand has been 'injured' within the meaning of the private attorney general statute" MINN. STAT. § 8.31 sub. 3a); *Stewart v. Farmers Ins. Group*, 773 N.W.2d 513, 518-19 (Wis. App. 2009) ("Actual attorney fees in the context of a bad faith claim are not a necessary *cost* of litigation to which a prevailing party is entitled — instead, they are an item of *damages* intended to compensate the victims.")

  - Is (mere) delay in market entry due to false marking a recoverable competitive injury?

    Cf., e.g., Yu & Gupta, "Pioneering Advantage in Generic Drug Competition", 8 INT'L J. PHARM. AND HEALTHCARE MARKETING 126 (2014) ("pay for delay"); Christopher S. Drewry, "Delay Claim Damages – How Do You Prove Them?" *at* <https://dsvlaw.com/delay-claim-damages-how-do-you-prove-them> (Aug. 31, 2018) (proving damages for delay in contractual performance)

  - Falsely advertising patented status:

    ThermoLIFE Int'l LLC v. Sparta Nutrition LLC, No. 19-CV-01715, 2020 WL 248164 (D. Ariz Jan. 16, 2020) (injury in fact standing but no competitive injury from merely "conclusory" allegations of being competitors)

  - Counterfeit mark:
    - Hidden location of counterfeit mark insufficient for SJ of no false marking; competitive injury damages supported by expert report on lost profits

      Raffel Sys. LLC v. Man Wah Holdings Ltd., Inc., 570 F. Supp. 3d 613, 631-32 (E.D. Wis. 2021)

PLEADING REQUIREMENTS

- Must plead all ~~two~~ three statutory elements

- Must allege specific underlying facts upon which court can reasonably infer intent (and competitive injury)
  - "[T]he fact of misrepresentation coupled with proof that the party making it had knowledge of its falsity is enough to warrant drawing the inference that there was a fraudulent intent"

    Clontech Labs., 406 F.3d at 1352 (citation omitted); *see also, e.g., Norix Group, Inc v. Correctional Techs., Inc.*, No. 17-cv-07914 (N.D. Ill. Aug. 6, 2018) (collecting cases)
  - Controversial *Iqbal / Twombly* decisions extended to effectively replace "generally" with "plausibility" threshold in FRCP 9(b)'s provision that "Malice, intent, knowledge, and other conditions of a person's mind may be alleged generally" (circuit split)

    In re BP Lubricants USA Inc., 637 F.3d 1307, 1309,1311 (Fed. Cir. 2011) *abrogated in part by statute*

    Cf. G. Neustadter, "Randomly Distributed Trial Court Justice: A Case Study and Siren from the Consumer Bankruptcy World," 24 ABI L. REV. 351 (2016); Christian Helmers and Brian J. Love, "Welcome to Waco! The Impact of Judge Shopping on Litigation," J.L., ECON., & ORG. (forthcoming) *available at* <https://ssrn.com/abstract=4185189 or http://dx.doi.org/10.2139/ssrn.4185189>

- Pleading "should have known" (recklessness)
  - False marking allegation insufficient if *only* asserts conclusory allegations that defendant is a "sophisticated company" and "knew or should have known"

    In re BP Lubricants USA Inc., 637 F.3d at 1309,1312 *abrogated in part by statute*
  - "[S]hould have known" standard has been sufficient to establish inequitable conduct and no reason for more stringent "actual knowledge" standard for false marking intent

    Brinkmeier v. Graco Children's Prods. Inc., 767 F. Supp. 2d 488, 495-97 (D. Del. 2011) (Stark, J.) (not limited to "whistleblower" situations; direct "actual knowledge" not required) *abrogated in part by statute*; *accord Simonian v. Blistex, Inc.,* No. 10-CV-01201, 2010 WL 4539450, at *4 (N.D. Ill. Nov. 3, 2010)

- 5-Year Statute of Limitations (28 U.S.C. § 2462)

LEAVE TO AMEND / RULE 27

- If few facts for intent to deceive available when answer is due, consider taking discovery and seeking to add counterclaim later

  See, e.g., Infinity Headwear & Apparel, LLC v. Jay Franco & Sons, Inc., No. 15-CV-01259, 2016 WL 5372843 (S.D.N.Y. Sept. 26, 2016); c*f., e.g., Persawvere, Inc. v. Milwaukee Elec. Tool Corp.*, No. No. 21-CV-00400 (D. Del. June 1, 2023) (inequitable conduct)

  - Possibly note intent to investigate and seek leave to add counterclaim in answer and/or in 26(f) report (and/or Rule 16 initial scheduling conference)

- Consider pre-suit deposition(s) to perpetuate testimony – FRCP 27

IMPLEMENTATION: OVERVIEW

General Considerations for Implementing a Patent Marking Program

TO MARK OR NOT TO MARK?

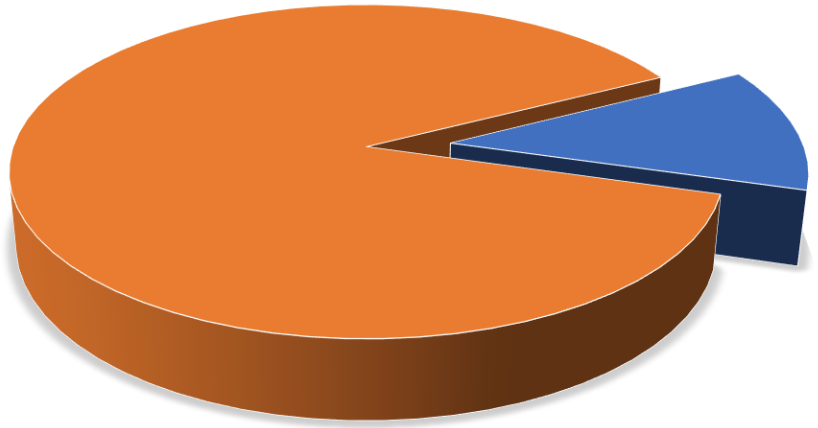
- Less chance of declaratory judgment action & forum shopping (than w/ actual notice)
- Very high or very low volume sales
- Easily reverse engineered & manufactured
- Many potential customers (esp. consumer products)
- Easy to mark (product size, etc.)
- Patent(s) are narrower / weaker (e.g., only designs)
- Litigation funding needed
- Infringement likely / inevitable
- Difficulty getting injunction (*eBay*)
- Marketing benefits
- Pride / vanity

- Constantly changing product designs
- Continually changing/growing patent portfolio
- Marketing / saleability aesthetic concerns
- Expensive / hard to mark products (cost/benefit, effort bandwidth, multi-jurisdictional complexity, etc.)
- Ease of actual notice, e.g.:
  - Regulated ind. barriers to entry
  - Small / captured customer base (esp. industrial products)
- Preference for injunction over $$$
- Unwillingness to reveal licensing
- Lack of knowledge of U.S. law
- Potential false marking liability

STATISTICS: WHO VIRTUALLY MARKS?

Estimated Percentage of Assignees Who Virtually Mark

Do Not Virtual Mark **88%**

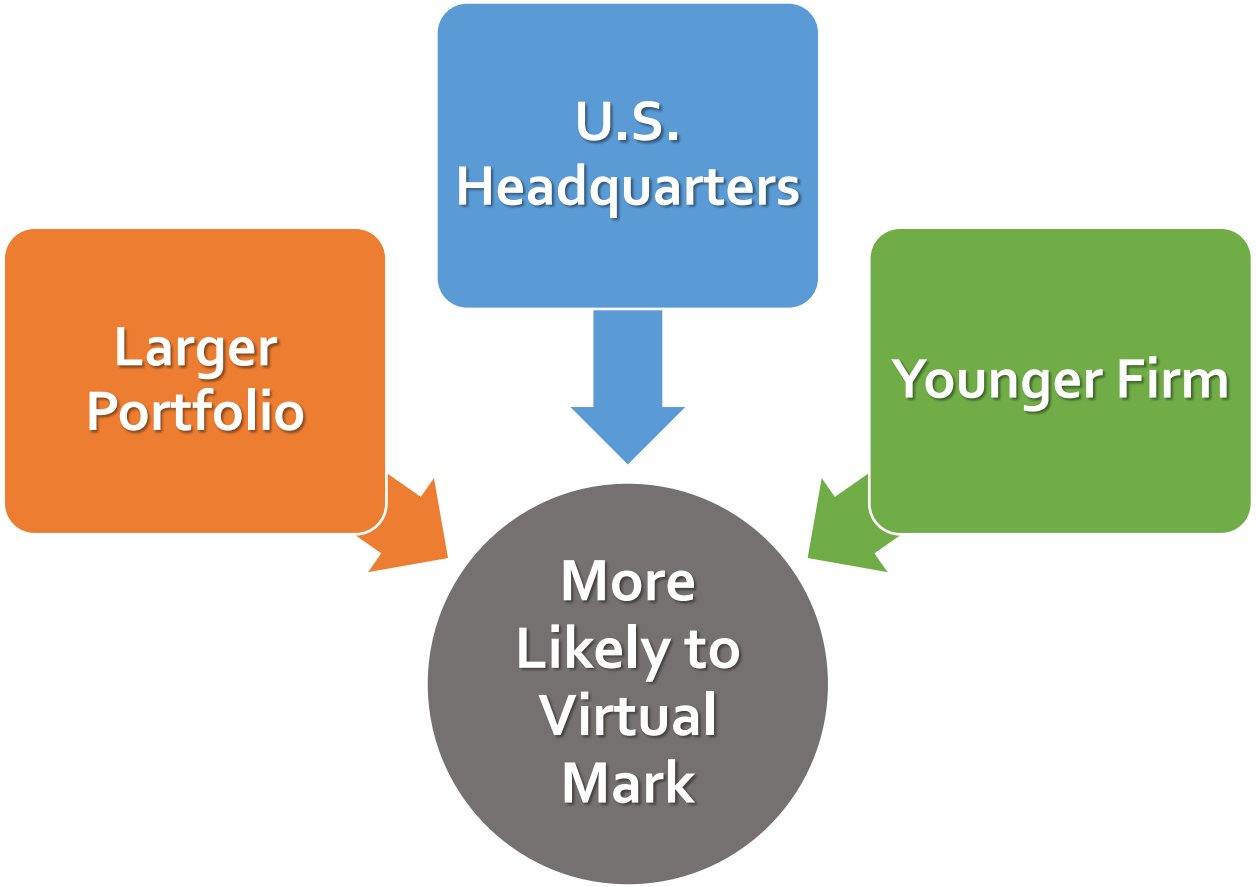


Do Virtual Mark **12%**

8.6 - 17.9 %
(95-percent conf. interval)

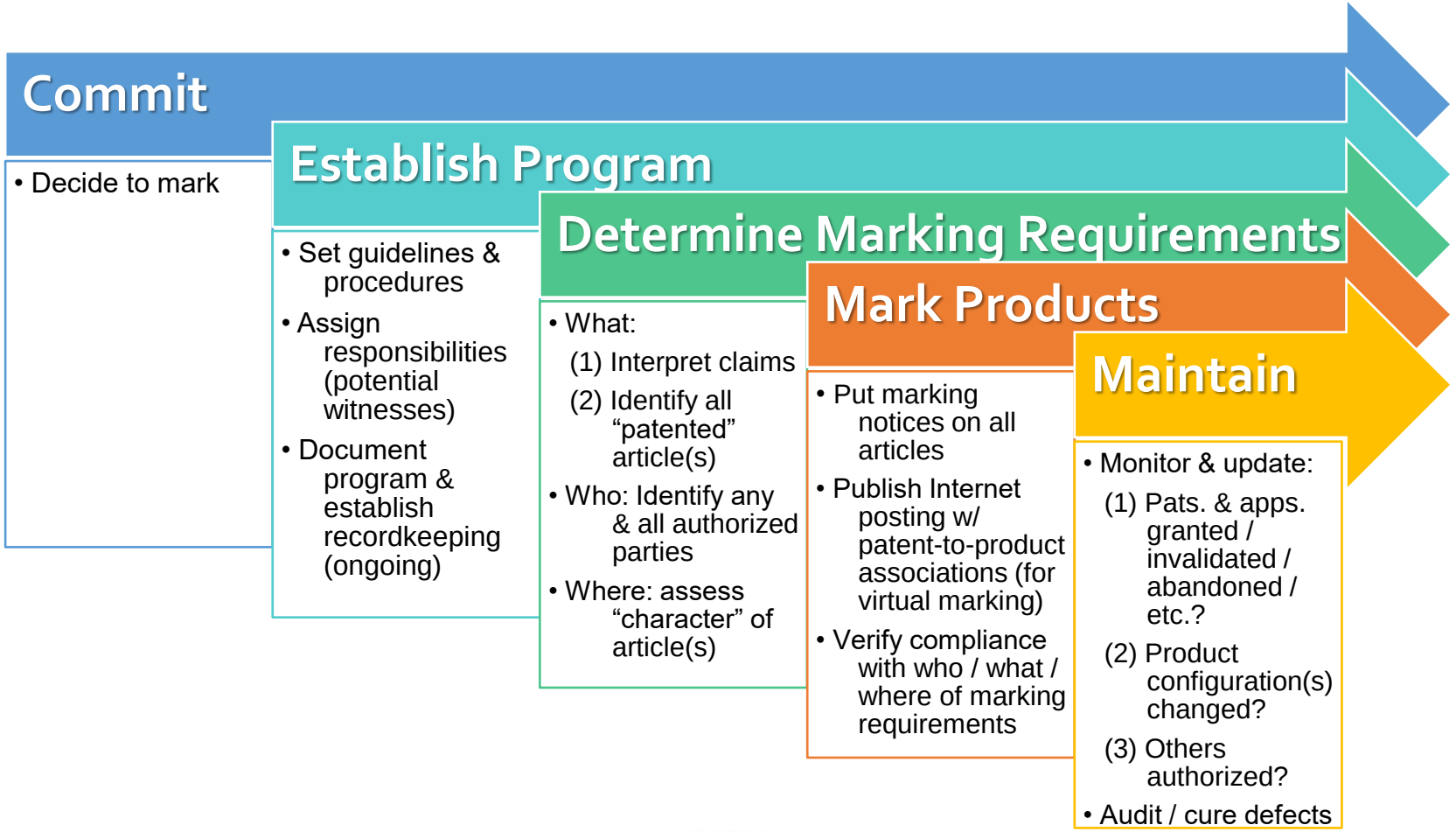
Source: G. de Rassenfosse, "Notice Failure Revisited: Evidence on the Use of Virtual Patent Marking" NBER Working Paper 24288 *at* http://www.nber.org/papers/w24288 (Feb. 2018) (based on random sample of 200)

STATISTICS: WHO VIRTUALLY MARKS? (CONT.)



Source: G. de Rassenfosse, "Notice Failure Revisited: Evidence on the Use of Virtual Patent Marking" NBER Working Paper 24288 *at* http://www.nber.org/papers/w24288 (Feb. 2018)

IMPLEMENTING A MARKING PROGRAM



EVIDENTIARY REQUIREMENTS AND BEST PRACTICES

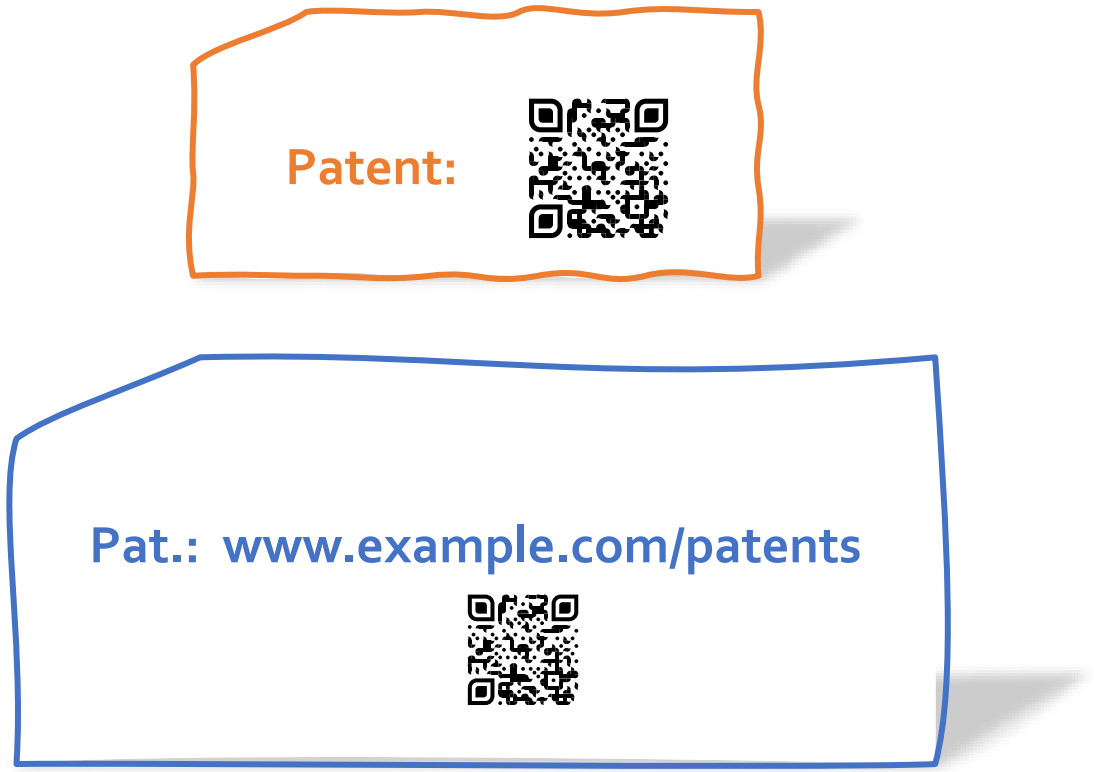
- Retain evidence of:
  1. Form and content of marking
  2. Continuity & consistency of marking
  3. Reasonable efforts re: compliance by licensee, etc. (if any)

- Consider:
  - Witness(es) with personal knowledge
  - Corroborating documentation
    - Internet Archive Wayback Machine (https://archive.org/legal) or proprietary archiving services
    - Engineering change orders (ECOs), mfg. specs., etc.
    - Document retention / destruction issues (~20-yr. patent term + 6-yr. post-expiration enforceability)
  - Admissibility
    - FRE 803(6) – Hearsay exception for “Records of a Regularly Conducted Activity”
    - FRE 902(11) – Self-authentication of “Certified Domestic Records of a Regularly Conducted Activity”

IMPLEMENTATION: ISSUES AND EXAMPLES

Pragmatic Issues and Real-World Examples Regarding Patent Marking Implementation

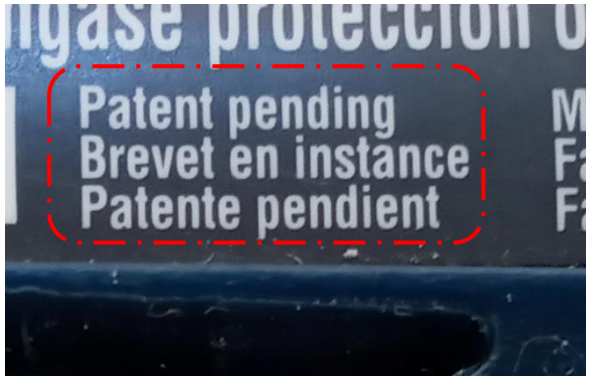
USE OF QR CODES / BAR CODES



- QR or bar code instead of alphanumeric characters to indicate an address of a posting on the Internet?

- QR or bar code in addition to an alphanumeric URL?

TEXT IN OTHER LANGUAGE(S)



- "Patent Pending" followed by French and Spanish
- "Patents/Brevets" in English/French followed by URL
- English notice and URL followed by French notice (and same URL)

ELECTRONIC ONLY INVENTIONS: AN "ARTICLE"?

US006128415A

United States Patent [19]
Hultgren, III et al.

[11] **Patent Number: 6,128,415**
[45] **Date of Patent: *Oct. 3, 2000**

[54] **DEVICE PROFILES FOR USE IN A DIGITAL IMAGE PROCESSING SYSTEM**

5,615,282	3/1997	Spiegel et al.	.....	382/276
5,634,092	5/1997	Stokes	.....	345/418

What is claimed is:

1. A device profile for describing properties of a device in a digital image reproduction system to capture, transform or render an image, said device profile comprising:

first data for describing a device dependent transformation of color information content of the image to a device independent color space; and

second data for describing a device dependent transformation of spatial information content of the image in said device independent color space.

US00D604305S

(12) **United States Design Patent**
Anzures et al.

(10) **Patent No.: US D604,305 S**
(45) **Date of Patent: ** *Nov. 17, 2009**

(54) **GRAPHICAL USER INTERFACE FOR A DISPLAY SCREEN OR PORTION THEREOF**

D565,588	S	4/2008	Sherry	
D567,171	S *	4/2008	Yu et al.	..... D13/110

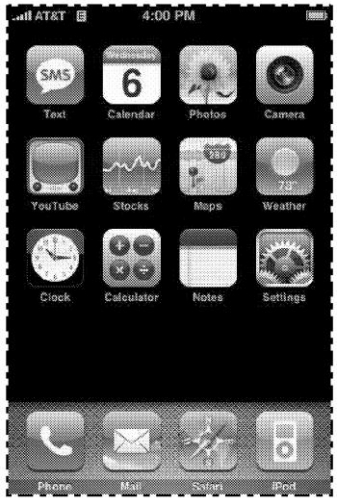


FIG. 1

(57) **CLAIM**

The ornamental design for a graphical user interface for a display screen or portion thereof, as shown and described.

DESCRIPTION

The patent file contains at least one drawing executed in color. Copies of this patent with a color drawing will be provided by the Office upon request and payment of the necessary fee.

FIG. **1** is a front view of a graphical user interface for a display screen or portion thereof showing our new design; and,

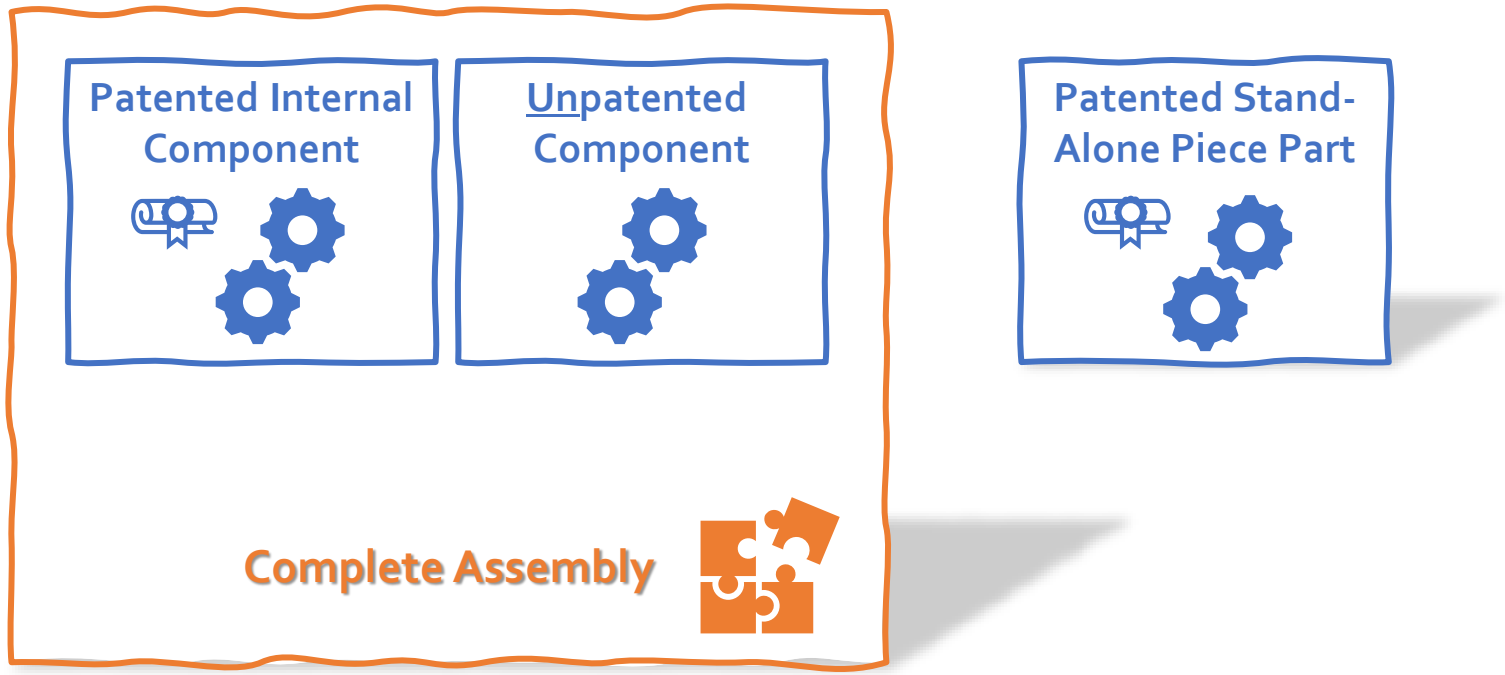
FIG. **2** is a front view of a second embodiment thereof.

The broken line showing of a display screen in both views forms no part of the claimed design.

ELECTRONIC ONLY INVENTIONS: AN "ARTICLE"? (CONT.)

- *Limelight Networks, Inc. v. XO Commc'ns, LLC*, 241 F. Supp. 3d 599, 608 (E.D. Va. 2017) (U.S. Pat. Nos. 7,693,959; 8,307,088; 8,122,102; 6,820,133; & 7,472,178):
  - "Whether a website counts as an 'article' that a patentee must mark has been a topic of debate among the district courts, but courts considering the issue have determined that a patentee must mark a website either [1] where the website is somehow intrinsic to the patented device or [2] where the customer downloads patented software from the website."
- *Cf. Juniper Networks, Inc. v. Shipley,* 643 F.3d 1346, 1351 (Fed. Cir. 2011)
  - "[W]ebsites may both embody intellectual property and contain identifying markings"
  - "[W]ebsites can qualify as unpatented articles within the scope of § 292"
- *Egenera, Inc. v. Cisco Sys., Inc.*, 547 F. Supp. 3d 112, 126-27 (D. Mass. 2021)
  - "[I]t is the combination of third-party hardware and the [patentee's] software that is asserted to embody the . . . patent. [The patentee] does not dispute that a patent notice could have been physically placed on the third-party hardware . . . [and] does not explain why third-party hardware installed with [the patentee's software] could not have been appropriately marked by the hardware manufacturer or the distributor."

MARKING HIDDEN PATENTED COMPONENTS

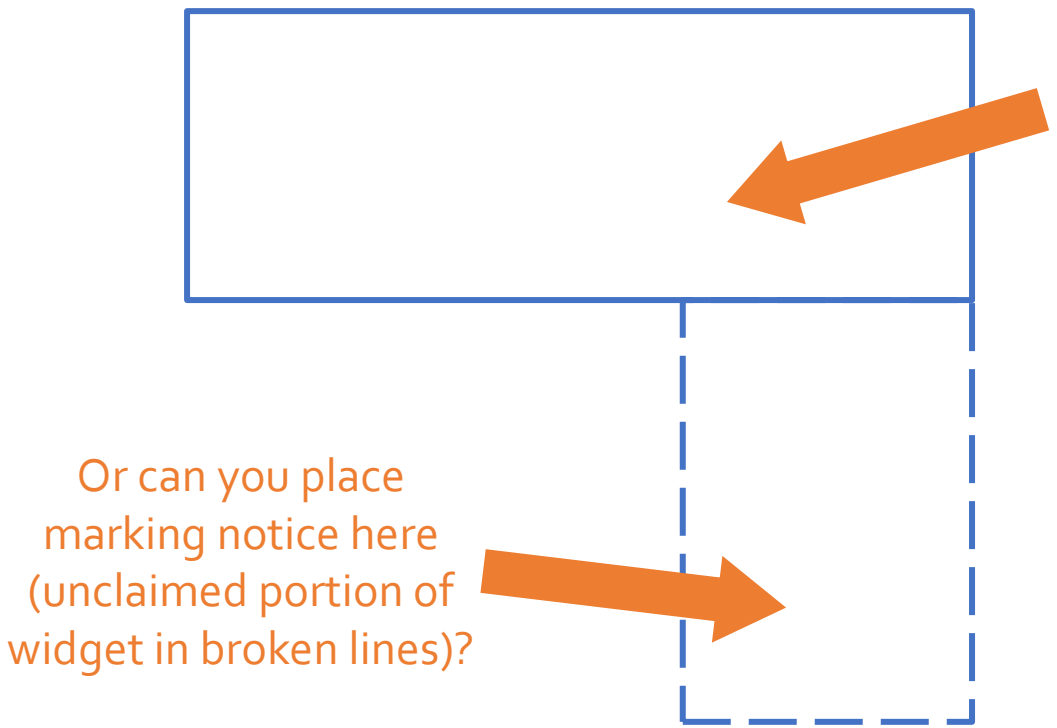


What if patented component is sold both as

(i) stand-alone part and

(ii) within (unpatented) assembly?

MARKING PARTIAL DESIGN CLAIMS



- Title: “Portion of a Widget”
- Claim: “The ornamental design for a portion of a widget, as shown and described.”
- Specification: “Portions of the widget shown in broken lines are for illustrative purposes only and form no part of the claimed design.”

SELECTING INTERNET ADDRESS

- Risk of loss of domain name:
  - Corporate M&A and name change / rebranding implications
  - UDRP and other cybersquatting issues
  - Loss of control (*e.g.*, rogue employee)
  - Failure to renew domain registration (*e.g.*, employee/vendor incompetence or negligence)
- Licensee reluctance to reference competitor domain name
- Use of “/patent” in URL? Or “/IP”?

INTERNET ADDRESS SPECIFICITY REQUIREMENTS

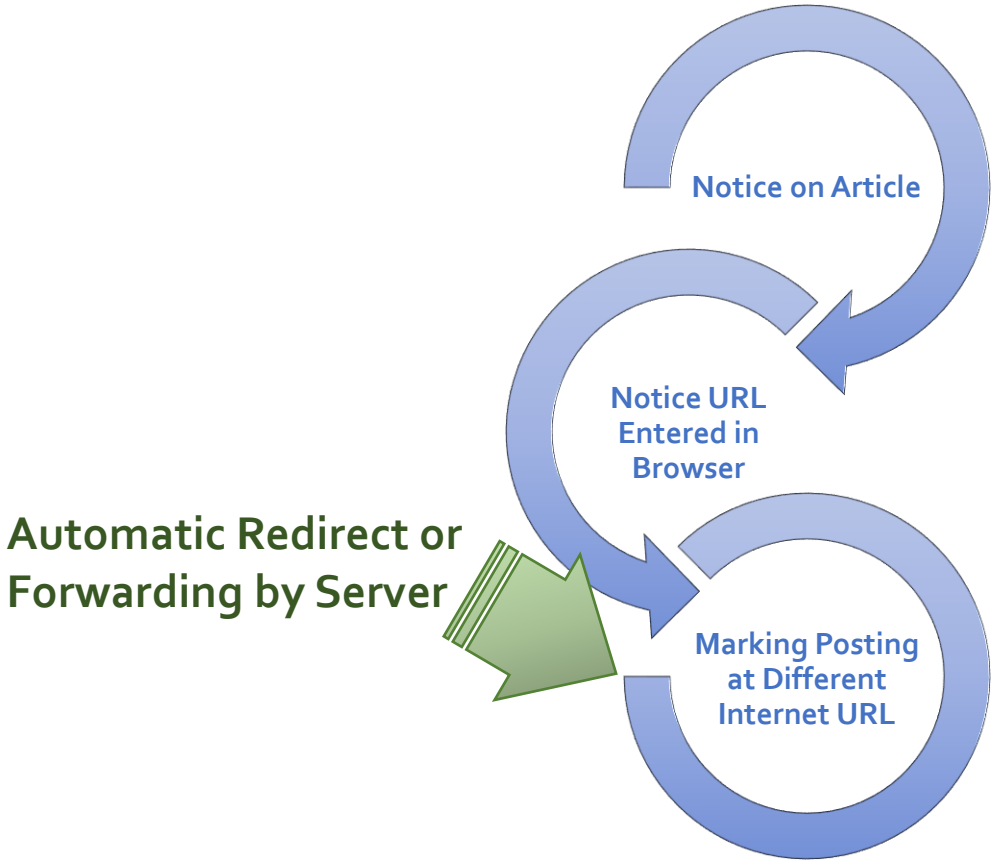
- Can you omit “http://” and/or “www”?

- Can you list a general company home / landing page URL on a marking notice and expect visitors to find and navigate to a separate patent marking page from there?

  See, e.g., VLSI Tech. LLC v. Intel Corp., No. 1:19-CV-00977, 2021 WL 2773013 (W.D. Tex. April 12, 2021); *Nat’l Prods., Inc. v. Arkon Res., Inc.*, No. 18-CV-02936 AG, 2019 WL 1034321, at *16 (C.D. Cal. Jan. 9, 2019)

- Can you list a posting that combines marking information with other, unrelated content? Is there a reasonableness limit?

USE OF SERVER REDIRECTS / FORWARDING



LICENSED USE MARKING

Home / Legal / Virtual Patent Marking

Legal

Company Registration Details

Virtual Patent Marking

Terms of Use

Mimecast Virtual Patent Marking

[redacted]

Third Party Software

Certain Mimecast products may include functionality that is subject to a license from each of Finjan, Inc., Finjan Mobile, Inc. and Finjan Blue, Inc (collectively, "Finjan") under one or more Finjan patents referenced at:

- **https://www.finjan.com/technology/patents**

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Licensed under the CC BY-ND 3.0 license (the "License").
You may obtain a copy of the license at **https://creativecommons.org/licenses/by-nd/3.0/legalcode**
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Use of the Code is not an endorsement or promotion by TW-fonts, Jiehong, or the names of any contributors thereto of any products, services, or any other related materials derived from the Code.

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CLICK

Patents

For over two decades Finjan has worked to develop world-class technologies aimed at keeping the web, networks, and endpoints safe from malicious code and security threats.

The relevance of our patented technologies only continues to increase.

View Patents

CLICK

U.S. ISSUED PATENTS TO FINJAN LLC

U.S. PATENT NO.	TITLE
6,092,194	SYSTEM AND METHOD FOR PROTECTING A COMPUTER AND A NETWORK FROM HOSTILE DOWNLOADABLES
6,154,844	SYSTEM AND METHOD FOR ATTACHING A DOWNLOADABLE SECURITY PROFILE TO A DOWNLOADABLE
6,167,520	SYSTEM AND METHOD FOR PROTECTING A CLIENT DURING RUNTIME FROM HOSTILE DOWNLOADABLES
6,480,962	SYSTEM AND METHOD FOR PROTECTING A CLIENT DURING RUNTIME FROM HOSTILE DOWNLOADABLES
6,804,780	SYSTEM AND METHOD FOR PROTECTING A COMPUTER AND A NETWORK FROM HOSTILE DOWNLOADABLES
6,965,968	POLICY-BASED CACHING
7,058,822	MALICIOUS MOBILE CODE RUNTIME MONITORING SYSTEM AND METHODS

MARKING ESTOPPEL

- “The practice of marking a product with a patent number is a form of extrajudicial admission that the product falls within the patent claims.”
- “Generally, extrajudicial admissions of facts, such as patent marking, are simply evidence that may be countered by the party that made the admission.”

Frolow v. Wilson Sporting Goods Co., 710 F.3d 1303, 1309-10 (Fed. Cir. 2013)

WEB SITE NAVIGATION ISSUES

- "The Web [Internet] is fundamentally designed to work for all people, whatever their hardware, software, language, location, or ability. When the Web meets this goal, it is accessible to people with a diverse range of hearing, movement, sight, and cognitive ability."
- "Web accessibility means that websites, tools, and technologies are designed and developed so that . . . people can: perceive, understand, navigate, and interact with the Web . . . ."

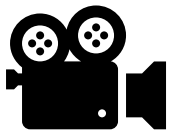
World Wide Web Consortium (W3C) Web Accessibility Initiative (WAI), "Introduction to Web Accessibility" *at* https://www.w3.org/WAI/fundamentals/accessibility-intro1 (emphasis added)

TECHNICAL MEDIUM OF POSTING ON THE INTERNET

Classic Web Page
HTML, etc.

or

PDF



Video

Audio

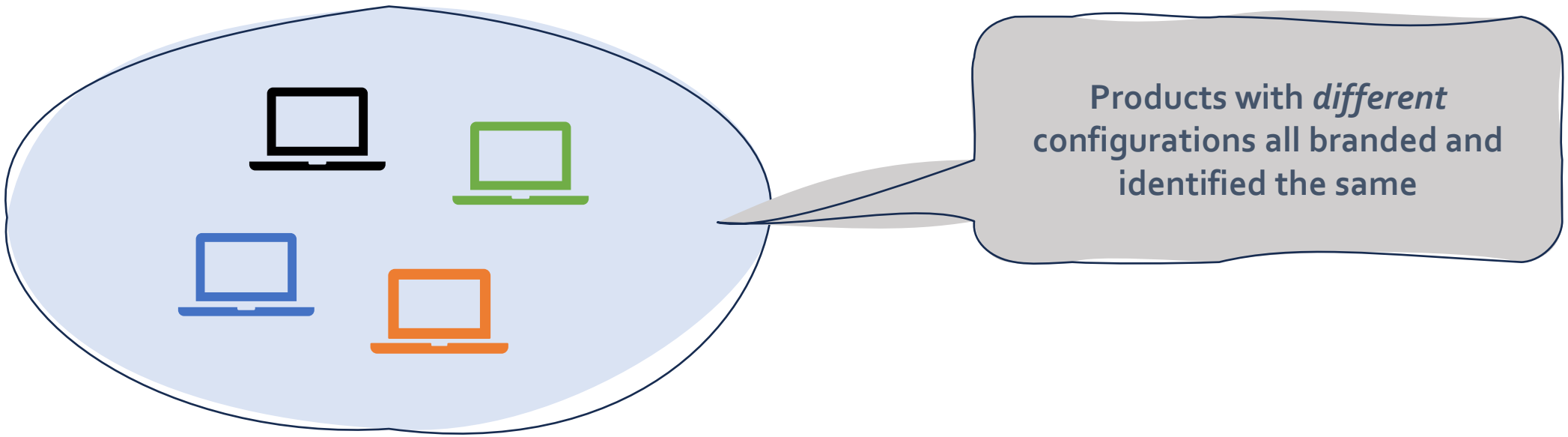
PRODUCT PHOTOS, ANIMATIONS, ETC. FOR IDENTIFICATION

Virtual Marking Internet Posting

Product	Patent No(s).
	U.S. Pat. XX,XXX,XXX
	U.S. Pat. YY,YYY,YYY

Can you show only images or animations in lieu of product model numbers or the like?

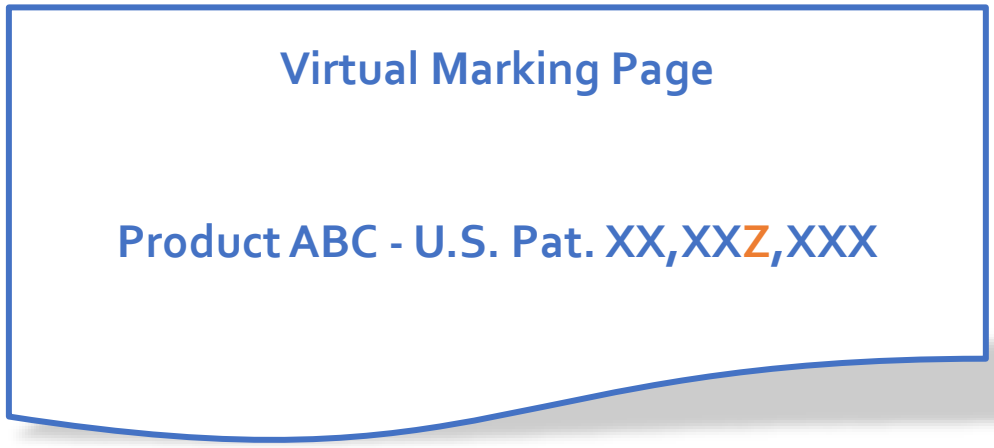
LACK OF UNIQUE MODEL NOS.



SHOULD TRADEMARKS BE USED TO IDENTIFY PRODUCTS?

- MPEP § 2173.05(u):
  - Claim indefinite if trademark or trade name used as a limitation to identify or describe a particular product or material (*citing Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982))
  - "a trademark or trade name is used to identify a source of goods, and is not the name of the goods themselves."
  - "In fact, the value of a trademark would be lost to the extent that it became the generic name of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name."
- TMEP § 1202.16 *et seq.*:
  - "While letters, numbers, or alphanumeric matter may serve as both a trademark and a model or grade designation [a "dual-purpose" mark], matter used merely as a model or grade designation serves only to differentiate between different products within a product line or delineate levels of quality, and does not indicate source."
  - "Evidence that other manufacturers use similar numbering systems to identify model numbers for their goods may be submitted to show that consumers are familiar with the use of alphanumeric designations as model numbers and are consequently less likely to perceive the applicant's use of the mark as source indicating."
- *Packet Intelligence LLC v. NetScout Sys., Inc.*, 965 F.3d 1299, 1313-14 (Fed. Cir. 2020)
  - Evidence of evolving/changed use of "marketing term" did not meet burden of proving unmarked article was unpatented
- *Cf. Gipson v. Mattox*, 511 F. Supp. 2d 1182, 1190-91 (S.D. Ala. 2007)
  - District court permitted corrective assignment (without loss of standing) when original assignment erroneously identified invention by trademark not actually used with invention claimed in asserted patent

EFFECT OF ERRORS / TYPOS



- Correct URL is www.example.com/patents
- Correct patent no. is XX,XXX,XXX

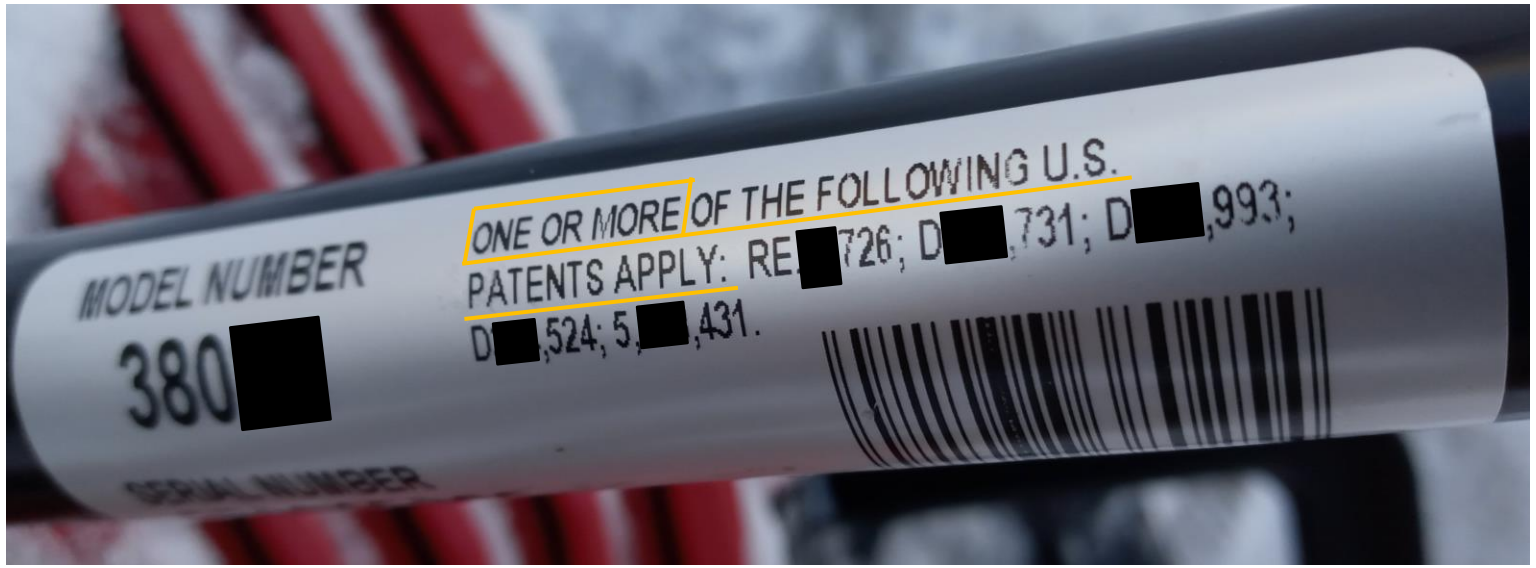
USE OF DISCLAIMERS

- Are disclaimers permitted? And effective?
- False marking liability?

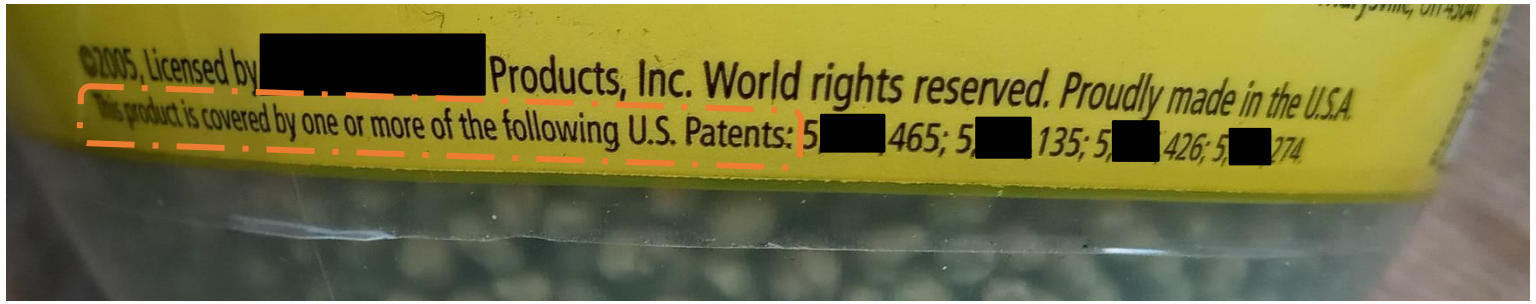
Possible disclaimers:

- Expired (or lapsed) patents
- Invalidated / disclaimed patents (wholly or partially)
- “For use under”
- Conditional language
- Marked under protest (by licensee)
- Jurisdictional statements
- Referencing add’l patented prods.
- Etc.?

CONDITIONAL MARKING

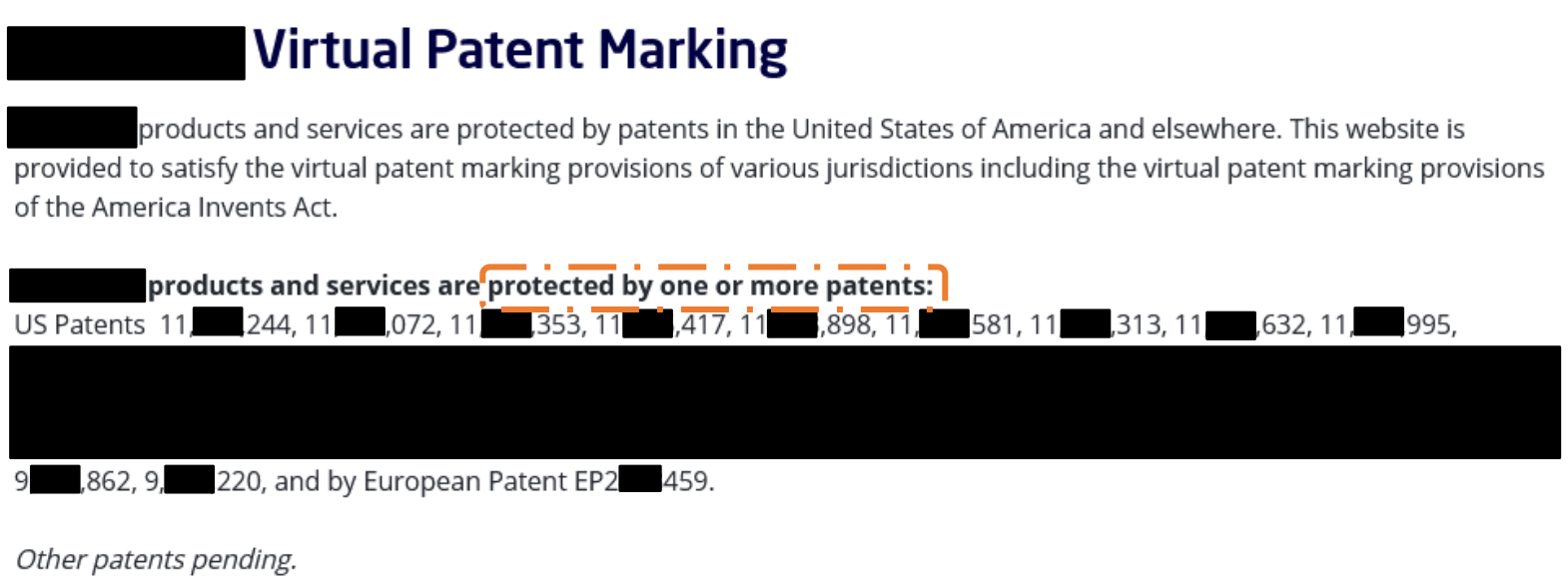


"**ONE OR MORE** OF THE FOLLOWING U.S. PATENTS APPLY…"



"This product is covered by **one or more** of the following U.S. Patents…"

CONDITIONAL MARKING (CONT.)



[redacted] Virtual Patent Marking

[redacted] products and services are protected by patents in the United States of America and elsewhere. This website is provided to satisfy the virtual patent marking provisions of various jurisdictions including the virtual patent marking provisions of the America Invents Act.

[redacted] **products and services are protected by one or more patents:**

US Patents 11,[redacted]244, 11[redacted],072, 11[redacted],353, 11[redacted],417, 11[redacted],898, 11,[redacted]581, 11[redacted],313, 11[redacted],632, 11,[redacted]995,

[redacted]

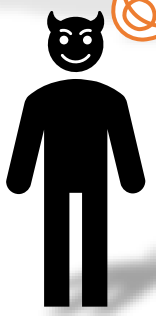
9[redacted],862, 9,[redacted]220, and by European Patent EP2[redacted]459.

Other patents pending.

"products and services are protected by **one or more** patents:"

CONDITIONAL MARKING (CONT.)

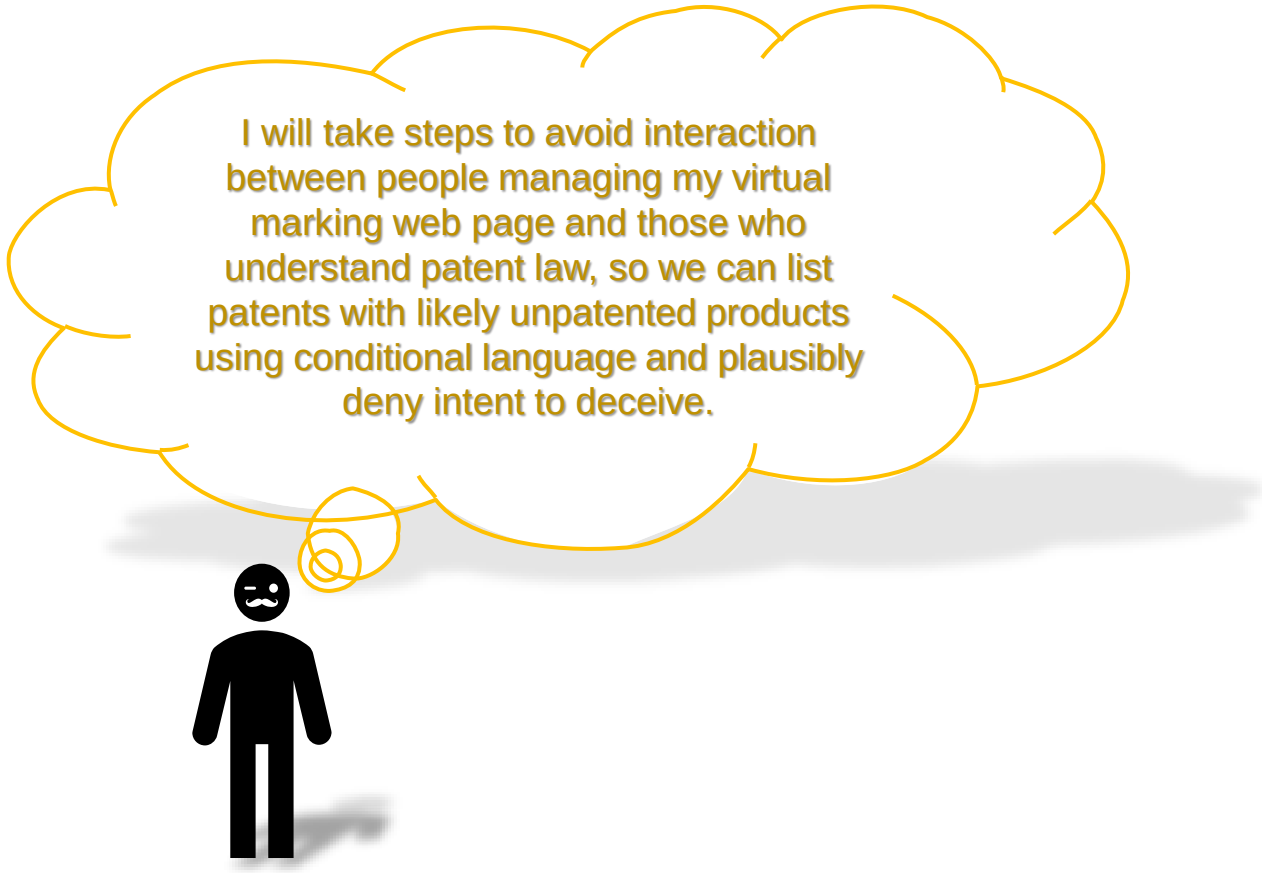
I know that most of these listed patents don't apply to this product, and the applicable one is about to expire, but competitors can try to figure that out themselves. Saying that these inapplicable patents "may apply" will confuse and discourage them!



One or more of the following patents may apply: X, Y, Z

Claim interpretation is hard! I think all of these listed patents apply to this product. But I don't want to be liable for being wrong, so I'll say that one or more "may apply".

CONDITIONAL MARKING (CONT.)



UPDATES: NEWLY GRANTED PATENT(S)

- Products already manufactured and being sold, when a new patent issues
  - Effect of “patent pending” marks
  - The unsold inventory conundrum

UPDATES: CHANGES TO PRODUCT DESIGN

- Scenario #1
  - Patent claims require feature X
  - All products marked
  - ***Change*:** all products redesigned for manufacturability, eliminating feature X

- Scenario #2
  - Patent claims require feature Z
  - Product A always included feature Z; product A always marked
  - ***Change*:** product B redesigned to add feature Z; product B not previously marked

UPDATES: EXPIRED AND LAPSED PATENTS

U.S. ISSUED PATENTS TO FINJAN LLC

U.S. PATENT NO.	TITLE
6,092,194	SYSTEM AND METHOD FOR PROTECTING A COMPUTER AND A NETWORK FROM HOSTILE DOWNLOADABLES
6,154,844	SYSTEM AND METHOD FOR ATTACHING A DOWNLOADABLE SECURITY PROFILE TO A DOWNLOADABLE
6,167,520	SYSTEM AND METHOD FOR PROTECTING A CLIENT DURING RUNTIME FROM HOSTILE DOWNLOADABLES
6,480,962	SYSTEM AND METHOD FOR PROTECTING A CLIENT DURING RUNTIME FROM HOSTILE DOWNLOADABLES
6,804,780	SYSTEM AND METHOD FOR PROTECTING A COMPUTER AND A NETWORK FROM HOSTILE DOWNLOADABLES
6,965,968	POLICY-BASED CACHING
7,058,822	MALICIOUS MOBILE CODE RUNTIME MONITORING SYSTEM AND METHODS
9,294,493	COMPUTER SECURITY METHOD AND SYSTEM WITH INPUT PARAMETER VALIDATION
9,444,844	MALICIOUS MOBILE CODE RUNTIME MONITORING SYSTEM AND METHODS
9,525,680	SPLITTING AN SSL CONNECTION BETWEEN GATEWAYS
9,800,553	SPLITTING AN SSL CONNECTION BETWEEN GATEWAYS
10,552,603	MALICIOUS MOBILE CODE RUNTIME MONITORING SYSTEM AND METHODS
10,673,819	SPLITTING AN SSL CONNECTION BETWEEN GATEWAYS

* GRAY TEXT INDICATES EXPIRED PATENTS.

“ * GRAY TEXT INDICATES **EXPIRED** PATENTS”

- Appears at bottom of pages 2-4, but not on first page
- No “ * ” on first page)

UPDATES: EFFECT OF INVALIDATION / STATUTORY DISCLAIMER

- False marking?
  - "(c) **The marking of a product**, in a manner described in subsection (a), with matter relating to **a patent that covered that product but has expired** is **not a violation** of this section."

    35 U.S.C. § 292(c) (emphasis added)
  - "When the statute refers to **an 'unpatented article'** the statute **means** that the article in question is **not covered by at least one claim of each patent with which the article is marked**."
  - "[W]here one 'has an **honest, though mistaken, belief** that upon a *proper construction* of the patent it covers the article which he marks,' the requisite **intent to deceive** the public **would not be shown**."

    Clontech Labs., Inc. v. Invitrogen Corp., 406 F.3d 1347, 1356-57 (Fed. Cir. 2005) (emphasis added)
- 35 U.S.C. § 253 – Partial invalidation or statutory disclaimer of only some claims?

  See Rembrandt Wireless Techs., LP v. Samsung Elecs. Co., Ltd., 853 F.3d 1370, 1382-84 (Fed. Cir. 2017) (statutory disclaimer of selected claim made a few days after complaint filed "cannot serve to retroactively dissolve the § 287(a) marking requirement")

WEB SITE MAINTENANCE AND REDESIGN

- Effect of virtual marking posting downtime due to server maintenance, etc.?

  See, e.g., Egenera, Inc. v. Cisco Sys., Inc, 547 F. Supp. 3d 112, 126 and n. 15 (D. Mass. 2021)

  .

- Changes to web site design?
  - Changes to navigation / menus
  - Link permanence / link rot

"WITHOUT CHARGE"

- "…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…"

  35 U.S.C. § 287(a) (emphasis added)

  - Does visitor tracking on a virtual marking web page constitute a *non-monetary* "charge"? Does ability to opt-out matter?

  - Does requiring login credentials for access constitute a *non-monetary* "charge"?

OTHER LAWS

- Americans with Disabilities Act (ADA)
- Privacy laws:
  - California Consumer Privacy Act (CCPA)
  - Illinois Biometric Information Privacy Act (BIPA)
  - Video Privacy Protection Act (VPPA)
  - General Data Protection Regulation (GDPR) in Europe
  - Personal Information Protection and Electronic Documents Act (PIPEDA) in Canada
- "Congress never intended that the patent laws should displace the police powers of the States, meaning by that term those powers by which the health, good order, peace, and general welfare of the community are promoted."

  Webber v. Virginia, 103 U.S. 344, 347-48 (1881)

“HIDDEN” FALSE MARKING?

- Web pages with invisible text saying “patented” etc. (*e.g.*, white-on-white)
  - Visible in search engine snippets?
- Metadata saying “patented” etc.
  - Visible in search engine results?
- Images saying “patented” that are accessible via search engines but not used on web pages
- Internet keyword advertising buys involving “patented” etc.

VIRTUAL MARKING EXAMPLE #1

Virtual Patent Marking

This website is provided to satisfy the virtual patent marking provisions of various jurisdictions including the virtual patent marking provisions of the America Invents Act and provide notice under 35 U.S.C. §287 (a).
[redacted] products may be covered by one or more of the following U.S. or Canadian Patents or corresponding patents in other countries. The following list of patents may not be all-inclusive and some products may be covered by patents that are not listed.

DRIVE TRANSMISSION SYSTEM AND METHOD
Canada
2[redacted],521
06/08/2019

DRIVE TRANSMISSION SYSTEM AND METHOD
U.S.A.
9,[redacted]5,079
14/04/2015

HYDRAULIC ASSEMBLY AND LOGGING EQUIPMENT USING SAME
U.S.A.
10,[redacted],487
16/10/2018

REACH ACTUATION FOR ENERGY SAVING HYDRAULIC KNUCKLE BOOMS
U.S.A.
6,[redacted]7,221
14/02/2006

VIRTUAL MARKING EXAMPLE #2

Patents

The following Klean Kanteen products are protected by patents in the U.S. and elsewhere. This website is provided to satisfy the virtual patent marking provisions of various jurisdictions including the virtual patent marking provisions of the America Invents Act. The following list of Klean Kanteen products may not be all inclusive, and other Klean Kanteen products not listed here may be protected by one or more patents.

Classic Bottles and Caps

US D614440, US D599616, US D669732, US D669733, US D616743, US D620357, US D620358, US D680431, US D655571, US D655572, AU 340417, AU 340357, AU 359347, AU 359447, AU 331519, AU 331587, AU 340804, CA 160223, CA 135912, CA 135911, CA 160222, CA 162182, CA 162181, CA 162180, EU 1959206, EU 1959222, EU 2600130, EU 2600155, EU 1725243, EU 1725235, EU 1980400, EU 2693069, EU 2693077, EU 2693085, CN ZL201130473502.3, CN ZL201130473504.2, CN ZL 201030243450.6, CN ZL201230010932.6, CN ZL201530126458.7, CN ZL201530126535.9, CN ZL201530126543.3, CN 201030243471.8 , JP 1454658, JP 1454659, JP 1532394, JP 1532395, JP 1455059, D800,503, US D784,146 S, US D794,460 S. Additional patents may be pending in the U.S. and elsewhere.

Wide Bottles and Caps

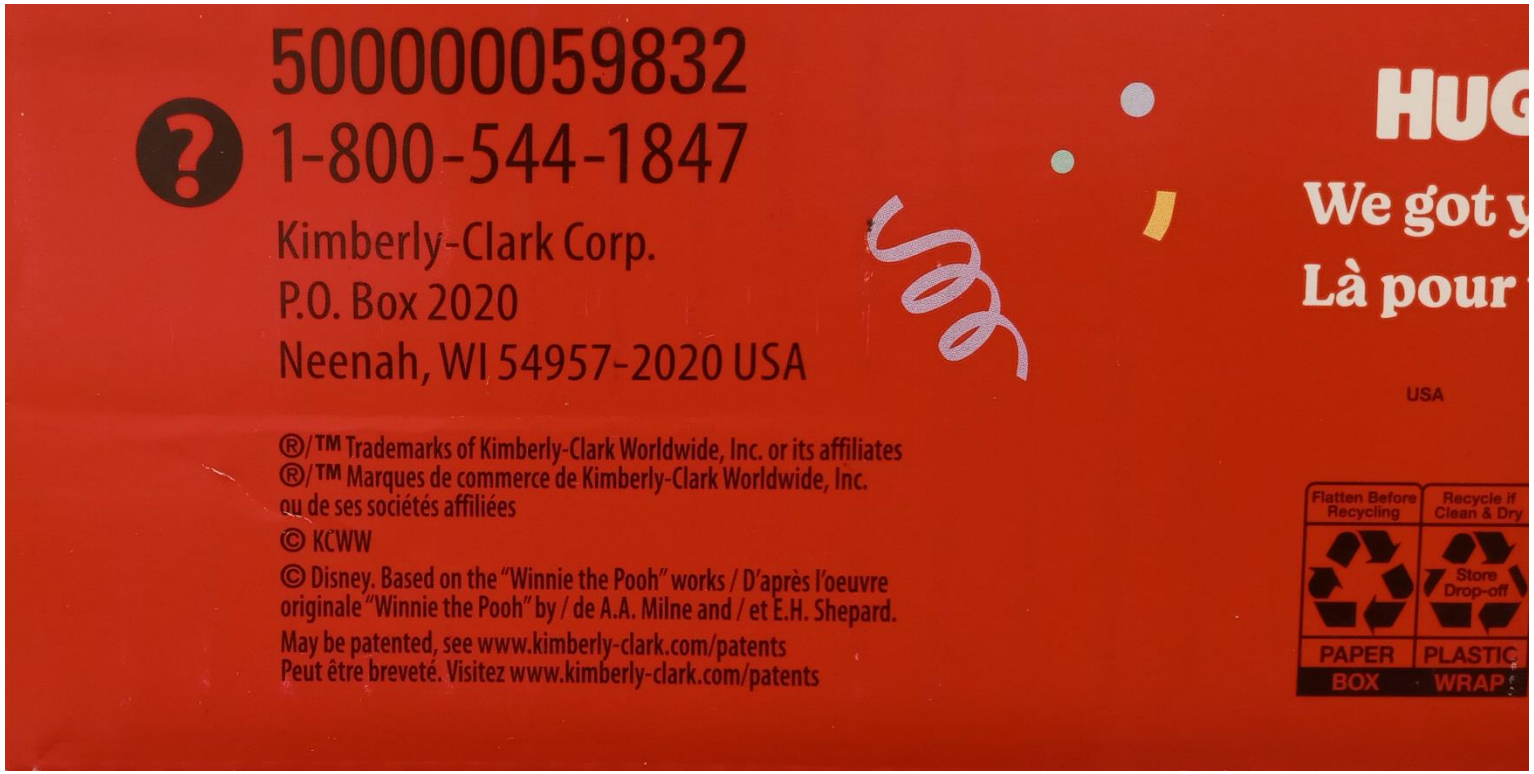
US D633794, US D633795, US D633796, US D633797, US D633798, US D633799, US D629691, US D626416, US D629689, US D629690, US D626414, US D614955, US D616744, US D620798, US D612235, US 9,394,083 B2, AU 330469, CN 134727, CN ZL201030144211.5, CN 201020545768.4, EU 1686700, US 9,815,600. Additional patents may be pending in the U.S. and elsewhere.

TK Wides and Caps

EU 00532496-0001, EU 005324969-0002, EU 005324969-0003, EU 005324969-0004, AU 201813821, AU 201813797, AU 201813795, CN 2018303721970, CN 2018303725702

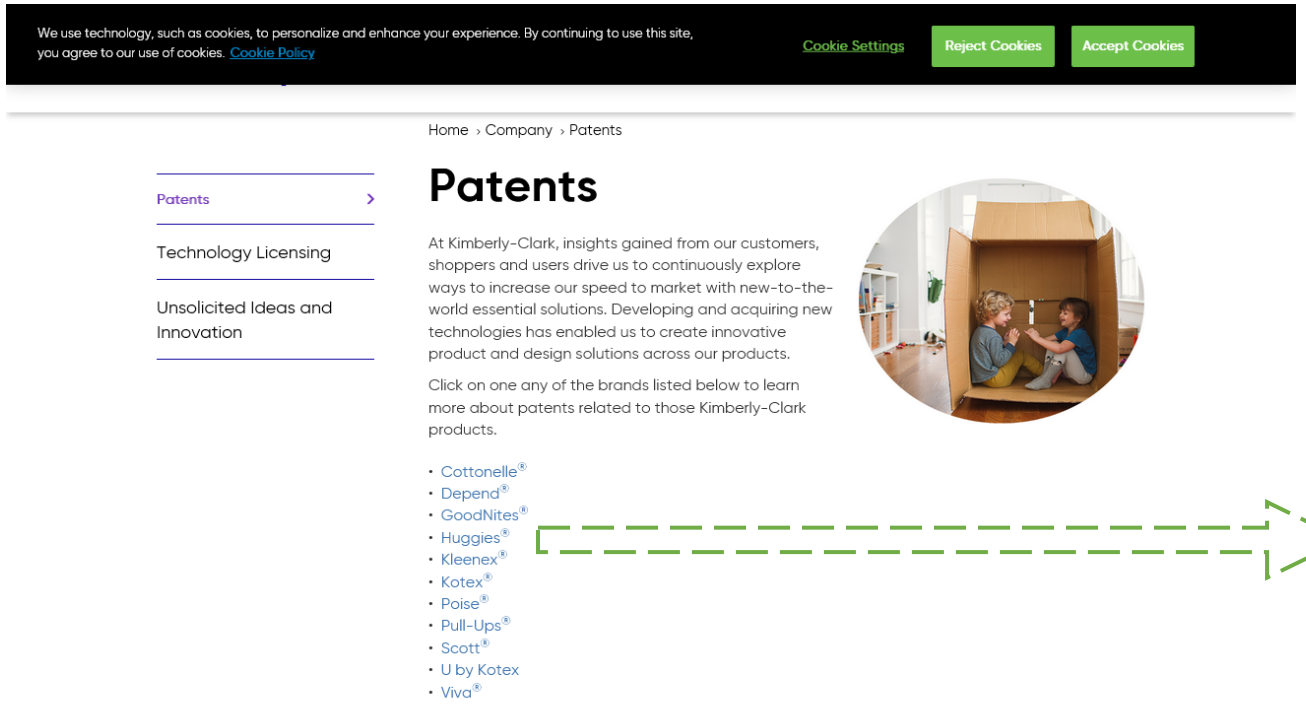
Food Canisters

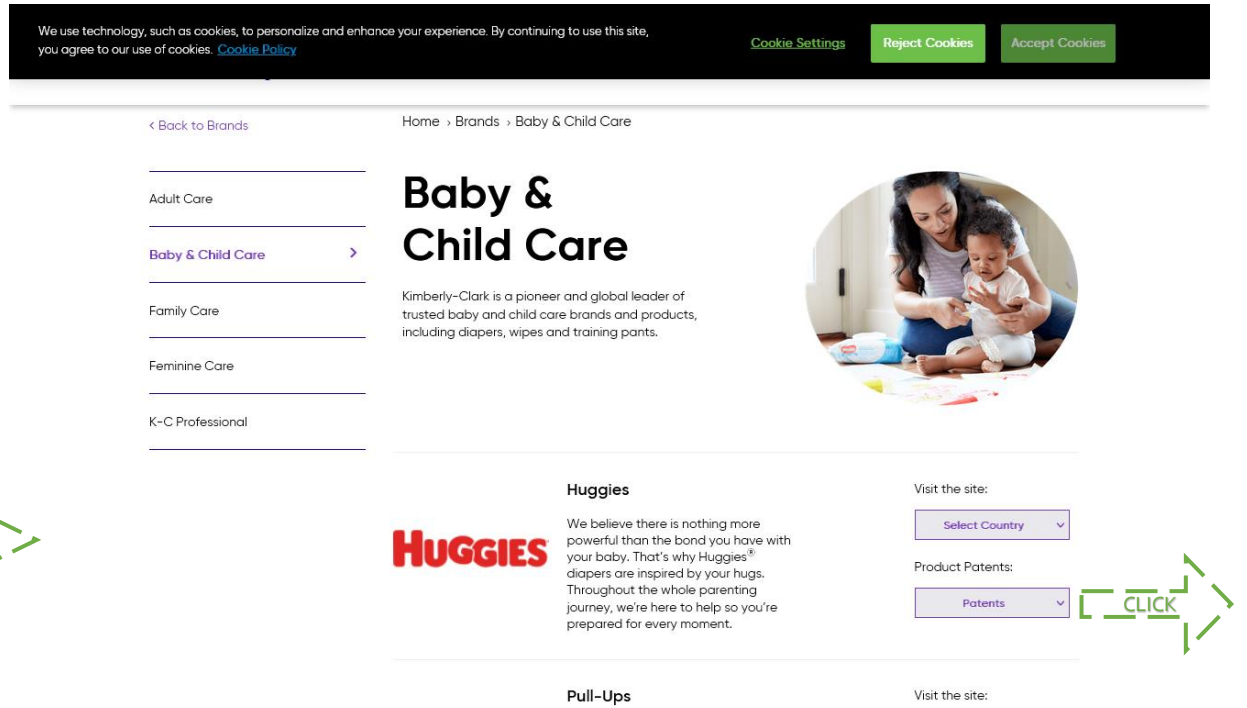
VIRTUAL MARKING EXAMPLE #3



- Box (product package) says "May be patented, see www.Kimberly-clark.com/patents"

VIRTUAL MARKING EXAMPLE #3





VIRTUAL MARKING EXAMPLE #3 (CONT.)

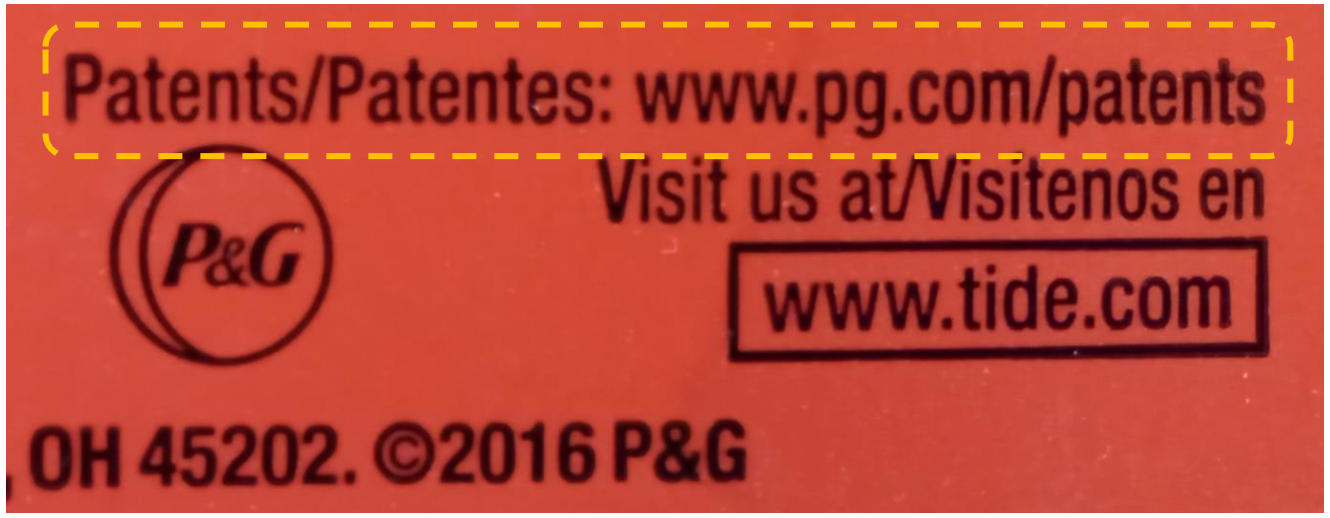
United States Patent Marking for HUGGIES® Absorbent Products made from May 6, 2020 until this list is next revised. Each list of patents by product name applies to all sizes, genders, and package counts, unless stated differently. If you have any questions about this list, please contact Kimberly-Clark at 888-525-8388.

HUGGIES® Little Snugglers Diapers Size P
10,478,354
10,231,883
9,480,609
9,474,660

HUGGIES® Little Snugglers Diapers Size N
10,478,354
10,231,883
10,159,610
9,480,609
9,474,660

HUGGIES® Little Snugglers Plus Diapers Size N
10,478,354
10,231,883

VIRTUAL MARKING EXAMPLE #4



VIRTUAL MARKING EXAMPLE #4 (CONT.)

Canada - FR

Patent Marking

Patent Marking Notification

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Canada - FR

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Patent Marking

Align	Patents	
The Art of Shaving	Patents	
Tide	Patents	CLICK
Venus	Patents	
Vicks	Patents	

VIRTUAL MARKING EXAMPLE #4 (CONT.)

United States Patent Marking effective from Feb. 9, 2021 until this list is revised.

TIDE® patent marking

TIDE® liquid laundry detergent (including base TIDE®, TIDE® Ultra Stain Release™, TIDE® Cold Water, and TIDE® with Bleach Alternative) (HE = for high efficiency washing machines)	US8097579 US8093202 US8785171 US9493730 US7208459 US8247364 US 8367598 US 8703688 US6855680 (HE versions) US8492325 (Ultra Stain Release HE) US8785364 (Ultra Stain Release HE) US9120997 (HE versions) US9284544 US9670436 USD559116 (25oz bottles) USD546185 (46-100oz bottles) USD555485 (46-100oz bottles) USD575151 (press-tap containers; e.g., 150oz)
TIDE® plus FEBREZE® Freshness liquid laundry detergent	US8097579 US8093202

ADDITIONAL RESOURCES

- "U.S. Patent Marking Guide" www.blueovergray.com/guides/patent-marking

- USPTO, "Report on Virtual Marking" (Sept. 2014) https://www.uspto.gov/sites/default/files/aia_implementation/VMreport.pdf

THANK YOU

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