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Failure to Mark Patent Number on Products Results in Complete Loss of Pre-Suit Infringement Damages

By James J. Aquilina

As highlighted by a recent decision of the U.S. District Court for the Southern District of New York,¹ a party's failure to properly mark its products with its issued U.S. patent number(s) will very likely result in a complete loss of the ability to recover infringement damages that occurred prior to the delivery of a specific allegation of infringement to an accused infringer. As further explained below, companies should thus very seriously consider the inclusion of patent markings on all relevant products.

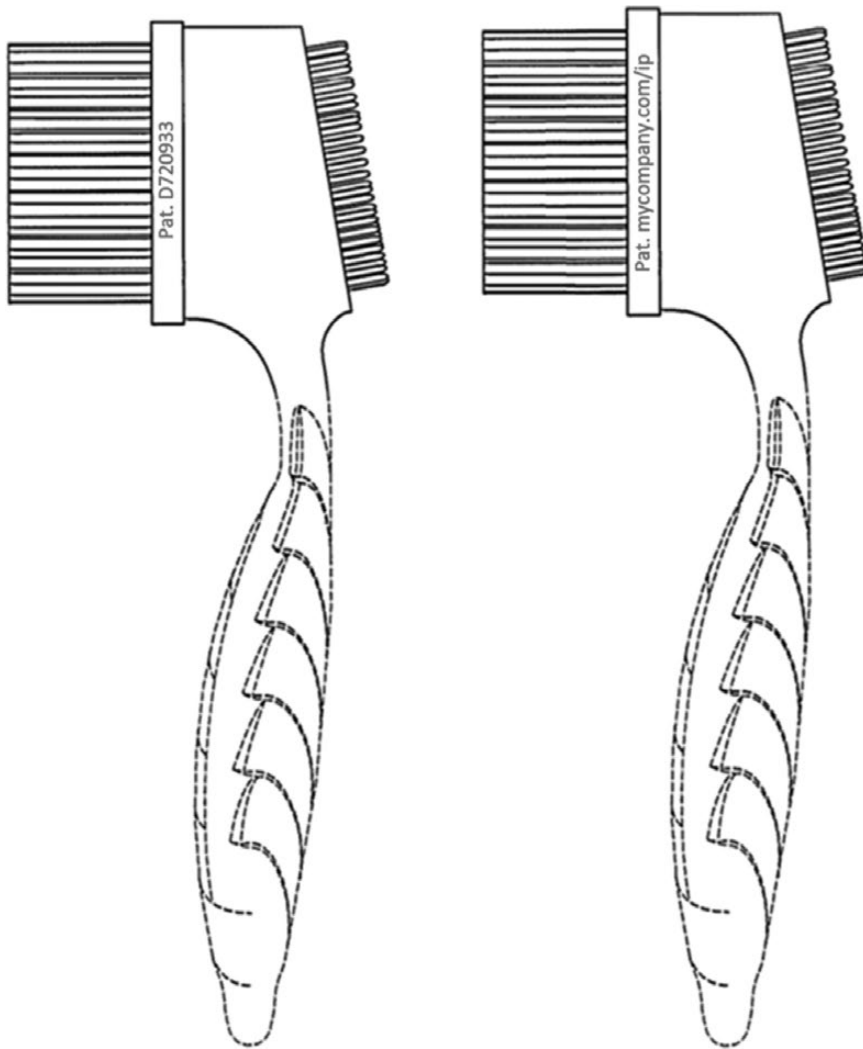
At bottom are two annotated versions of a figure from U.S. Design Patent No. USD720,933 for a "FACE WASHING BRUSH," issued on January 13, 2015, which was the design patent asserted in the matter noted above. While physically marking such a product is not always trivial (or desirable from a product aesthetic/marketing standpoint), an appropriate patent marking as suggested below would have provided the patent owner with the ability to collect pre-suit damages.

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Since U.S. patent law provides for a six-year statute of limitation to bring an infringement action, the difference in available damages in a design patent infringement suit could be the enormous one between zero dollars and the infringer's total profits for sales of the infringing products² over up to said six-year period, depending only on the presence of an appropriate patent marking on a product.

As a practical matter, proper patent marking can occur in one of two ways: (1) physical marking, or (2) "virtual" marking.

A patent holder may only collect patent infringement damages from the date that proper "notice" under the U.S. Patent Act³ has been provided. Such "notice" is either deemed to have been provided "constructively" – i.e., by proper, direct marking of covered products as shown below – or else must be provided "actually," in the form of a cease and desist letter or infringement complaint that identifies the patent(s) by number and makes an allegation of infringement. As can be seen in this example, while patent marking can often



Annotated versions of Figure 1 of U.S. Design Patent No. USD720,933, with two types of proposed patent markings – “actual” (left) and “virtual” (right).

occur immediately from the outset of sales of a product, “actual” notice of infringement via a letter or lawsuit will almost always come at a significantly later date.

PROPER PATENT MARKETING

As a practical matter, proper patent marking can occur in one of two ways: (1) physical marking, or (2) “virtual” marking.

Physical marking involves placing the word “patent” or the abbreviation “pat.,” along with the

appropriate patent number, on the article itself or (in limited circumstances) its packaging. Examples of proper patent markings include “Patent D654,321” and “Pat. 7,654,321.”

“Virtual” marking provides patent owners with an alternative to physical patent marking by giving them the option of affixing on the article the word “patent” or the abbreviation “pat.,” followed by an internet address at which a patent number is associated with the product(s) that are covered by the claim(s) of that patent.

Thus, instead of physically engraving, molding, or stamping an article with a patent number, a patent owner may mark its article with, for example, “Pat. mycompany.com/ip.”

If the virtual marking option is chosen, the accompanying website should be free, readily accessible to the public without the use of cookies or other tracking software, and kept up-to-date with a current list of active patent(s) that correspond with the name(s), model number(s), and/or other

publicly-available identifier(s) for the appropriate patented product(s).

Notes

1. Blackbird Tech LLC v. Argento SC By Sicura, Inc., No. 21cv11018 (DLC), 2022 BL 301209 (S.D.N.Y. Aug. 26, 2022) (Cote, J.).
2. 35 U.S.C. § 289.
3. 35 U.S.C. § 287.

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