

The America Invents Act: Virtual Patent Marking

By Greg Bernabeo

Contacts:

Scott D. Patterson
Chair

SUMMARY

Under the America Invents Act (signed into law on September 16, 2011) patent owners may now comply with patent marking requirements easily and inexpensively, by marking their products with an internet address of a web page that identifies patent numbers in association with the marked product.

U.S. patent laws allow for recovery of patent infringement damages for the period of time after an infringer had actual or constructive notice of the infringed patent. Actual notice can be provided by way of a letter, after infringement has begun and been discovered. Constructive notice can be provided before actual notice by marking a patented product with an applicable patent number, thereby extending the period for which damages can be recovered.

Prior to the America Invents Act, 35 U.S.C. §287(a) provided that patent owners could mark a product by physically fixing onto the patented article the word "patent" or the abbreviation "pat," together with the patent number, usually by affixing a label imprinted with the notice to the product or its packaging, or configuring a mold, die or the like such that it would form the notice as an integral part of the finished product. Though effective, this approach can be relatively costly in that the labels or mold need to be updated periodically as new patents are issued. In addition, to avoid false marking issues, best practices require removing patent marking from patented articles when the existing patents are invalidated or expire.

The America Invents Act amends 35 U.S.C. §287(a) to provide that patent owners may satisfy the marking requirement "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." This "virtual marking" provision allows the patent owner to provide constructive notice by marking the product with a URL, and maintaining a web page at that URL that identifies the patented product and provides an associated list of patent numbers relating to the patented product. Any required changes to the list of associated patent numbers in view of patent expiration or invalidation may be effected easily and inexpensively simply by modifying the relevant web page. This eliminates the need to modify in any way the product or associated labels or packaging, and associated mold, part and manufacturing expenses are thereby avoided.

As mentioned above, there are penalties for improper, or “false,” marking. A virtual patent marking program can provide cost savings and other advantages to patent owners, but must be implemented with care.

For more information about virtual patent marking, please contact Greg Bernabeo (gbernabeo@saul.com) or any other member of Saul Ewing’s Intellectual Property & Technology Practice.

This Alert was written by Greg S. Bernabeo, a member of the firm’s Intellectual Property & Technology Practice. Greg can be reached at 215.972.7755 or gbernabeo@saul.com. This publication has been prepared by the Intellectual Property & Technology Practice for information purposes only.

The provision and receipt of the information in this publication (a) should not be considered legal advice, (b) does not create a lawyer-client relationship, and (c) should not be acted on without seeking professional counsel who have been informed of the specific facts. Under the rules of certain jurisdictions, this communication may constitute “Attorney Advertising.”

© 2012 Saul Ewing LLP, a Delaware Limited Liability Partnership.
ALL RIGHTS RESERVED.

Baltimore, MD

500 East Pratt St.
Charles O. Monk, II
410.332.8668

Boston, MA

131 Dartmouth St.
Richard D. Gass
617.723.3300

Chesterbrook, PA

1200 Liberty Ridge Dr.
Michael S. Burg
610.251.5750

Harrisburg, PA

2 North Second St.
Eric L. Brossman
717.257.7570

Newark, NJ

One Riverfront Plaza
Stephen B. Genzer
973.286.6712

New York, NY

555 Fifth Ave.,
Michael S. Gugig
212.980.7200

Philadelphia, PA

1500 Market St.
Bruce D. Armon
215.972.7985

Princeton, NJ

750 College Rd. E
Marc A. Citron
609.452.3105

Washington, DC

1919 Pennsylvania Ave, NW
Mark L. Gruhin
202.342.3444
Edward R. Levin
202.342.3420

Wilmington, DE

222 Delaware Ave.
Wendie C. Stabler
302.421.6865
William E. Manning
302.421.6868