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Patent Marking After the America Invents Act (AIA)

In order to collect damages in a patent infringement case, the patentee must provide notice to the potential infringer that the patent exists. Damages are collected for infringements subsequent to the notice. United States law provides for a “constructive notice” to the potential infringer if the patentee marks the patent number on the patented product.

- The AIA allows for Virtual Marking, wherein “patent” or “pat.” along with a website address is marked upon the product, rather than an actual patent number. The webpage located at the marked website address must associate the patented product with the patent number.
- The AIA allows for expired patent numbers to remain marked on products. Previously, if a product was marked with an expired patent number, the seller could be found liable for False Marking.
- The AIA changed the law with respect to False Marking lawsuits, eliminating “qui tam” actions brought on behalf of the United States by unrelated third parties.
- These changes are effective as of September 16, 2011, the date of enactment of the AIA. The changes will also apply to cases that were pending on the date of enactment.

Virtual Marking

You are no longer required to mark actual patent numbers on the product in order to establish Patent Marking. Virtual Marking allows you to mark the product with “patent” or “pat.” along with a website address, so long as the website associates the product with the patent at issue.

Virtual Marking is particularly attractive when a product needs to be marked with multiple patent numbers, which would be more cumbersome than a website address.

When changes to the patent marking are required, Virtual Marking allows for the website to be updated, without having to change the specific text that is marked on the product itself.

- Under the new Virtual Marking provision, the word “patent” or the abbreviation “pat.” must be marked, along with a web address. For example, “patent vaslaw.com/notice” or “pat. vaslaw.com/notice”.
- The web address must be accessible to the public without charge.
- The web address must clearly associate the patented product(s) with the patent number(s) that cover the product. When multiple products are listed, provide associations for each product.

The specifics of this requirement have not been explored by the courts, as the Virtual Marking provision is new. We recommend assuming that a mere list of patent numbers with nothing more will not be sufficient to establish constructive notice. The web page should 1) clearly identify a product at issue; and 2) clearly indicate the patent(s) that are relevant to the product by at least the patent number. We also recommend that the title(s) of the patent(s) be listed, and that a hyperlink to a full copy of each patent be provided. The goal is to establish a good faith effort to notify the public of the patent rights associated with the product.

Additional notes:

Save copies of the web page - In order to establish notice via virtual marking, you will need to submit evidence that the website was in existence as of the date the notice occurred. We recommend archiving a copy of the website periodically in a “non-modifiable” format (e.g. PDF), and archiving a copy any time the website changes.

If you are choose to mark, mark all products - Constructive notice requires a patentee to appropriately mark substantially all of the distributed products that are covered by patent protection. *Nike, Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1446 (Fed.Cir. 1998)

If marking the product itself is not feasible, mark the packaging – 35 USC 287 allows for marking of packaging when, from the character of the article, marking the article cannot be done. Note however that if the article includes non-patent markings (e.g. trademarks, logos, letters, etc.), a patent marking on the article itself will likely be required.

False Marking

A party that falsely marks a product as patented when no patent exists is guilty of false marking. The theory is that the public is deceived by the false marking and overpays for the product believing it to be patented.

Before the AIA, any party could file a false marking lawsuit on behalf of the United States (a “qui tam” action), and could recover statutory damages of up to \$500 per false marking offense. Any damages recovered from the defendant in a Qui tam action would be split between the plaintiff and the United States. Also, before the AIA, failing to remove a patent marking when the patent expired could be construed as false marking.

After the AIA:

- Patent marking can remain on a product after the patent expires, and it will not be considered false marking. 35 USC 292(c).
- Qui tam actions by third parties are no longer permitted. Only the United States may bring an action to recover the statutory damages outlined in 35 USC 292(a).
- A person who suffered a competitive injury as a result of false marking can bring a false marking lawsuit to recover their actual damages. 35 USC 292(b).