Making Your (Virtual) Mark in the Patent World

by Peter Malen

In order to recover damages for infringement of a patent, the patentee must give adequate notice to the public that the article, such as a widget, is patented. With no/inadequate public notice, it may be difficult or impossible to obtain damages for any infringement of the patent that occurred prior to adequate notice having been given. Particularly, 35 USC 287 provides that a patentee cannot recover damages in an action for infringement of the patent "…*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*…"

Before the advent of the internet, patentees had to display the patent number on the covered product and associated packaging where possible (and that is still good practice when practical to do). More recently though, so-called 'virtual' marking has become permissible. To virtually mark a product, and thereby provide adequate notice to the public as to (i) what articles are patented, and (ii) the specific patents that cover those articles, the website must identify the patented article and also clearly associate that patented article with the patent numbers of the patents that cover that article.

A recent court decision provides some useful insight on what does, and does not, constitute adequate virtual marking of a patented product. In *Manufacturing Resources International, Inc. v. Civiq Smartscapes LLC* (US District Court for the District of Delaware; Civil Action No. 17-269-RGA), the court took up the question of whether the patentee had adequately marked its products. In that case, the patentee had marked its products only with the word 'patent' and the address of its website, which simply listed a number of patents. The website did not clearly associate any of the listed patents with the specific product in question. In finding that the patentee's attempt at virtual marking did not satisfy the requirements of 35 USC 287, the court stated that "*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*." Id. at 20. Thus, the court found that the alleged infringer did not receive notice of the infringement until the time the complaint was filed, and no damages were awarded for infringement that occurred prior to

the notice that was provided by the filing of the suit.

So go ahead and make your virtual mark in the patent world, but make sure you do it in a way that adequate notice is provided to the public.