



Patent Marking

Patent marking is an often neglected aspect of patent law, but in recent years has come into the spotlight. Most countries, including the UK, have a provision that damages from infringement can be awarded where an infringer has copied a product only where said infringer is put on notice of the existence of a patent right by virtue of the patent number being applied to (i.e. 'marked' on) the product (cf Section 62 (1) of the UK Patents Act).

Patent law in the US provided for a penalty to be exacted in the case of false marking and a reward provided to the person spotting it. In 2009, the Federal Circuit ruling in *Forest Group Inc. v Bon Tool Co.* reversed decades of precedents on false marking and held that each individual wrongly marked product was a separate violation of patent law. Suddenly, there was great incentive for private parties to bring false marking suits and 'bounty'-collecting patent suits very quickly sprang up based around on-sale products for which the relevant acknowledged patent rights had only just expired, for example the previous day! With potential damages of \$500 per product item, the filing of false marking lawsuits promised to be a lucrative plaintiffs' practice.

This practice, while legal, was swiftly and widely recognised as being detrimental (and unfair) to patent proprietors. In the America Invents Act (AIA), the possibility of suing for such 'bounty' payments was 'outlawed'! Most of the suits brought under the old law have since been dismissed.

The AIA also brought the area of patent marking right up to date with technology advances by introducing the concept of virtual patent marking.

Under virtual patent marking, in place of a patent number a product bears the details of an URL where the patent details can be found. The URL webpage can be much more easily maintained to show the correct, and in force, patent rights for a product or products and thus enables the public to be given correct and up to date patent details.

Currently the IPO in the UK is considering whether virtual patent marking should also be made acceptable under UK law. The IP Federation wholeheartedly supports this move.

Carol Arnold and Vicki McKinney, 14 November 2012