



**Morgan Lewis**

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**Patent Marking**

**June 14 | Jitsuro Morishita**

Morgan Lewis

# PATENT MARKING

## 35 U.S. Code § 271 (a)

Patentees, and persons making, offering for sale, or selling within the United States any patented article for or under them, or importing any patented article into the United States, **may give notice to the public that the same is patented**, either by fixing thereon the word "patent" or the abbreviation "pat.", together with the number of the patent...



# 35 U.S. Code § 271 (a) (AIA addition)

...or 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...



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Gillette Body 	Old Spice 	Cascade 	Metamucil 
Gillette Disposables 	Oral-B 	Charmin 	Mr. Clean 
Gillette Fusion 	Pantene 	Cheer 	Pampers 
Gillette Fusion ProGlide 	Safeguard 	Comet 	Pepto-Bismol 
Gillette Fusion ProShield 	Secret 	Dash 	Prilosec 
GilletteLabs Heated Razor 	SK-II 	Dawn 	Puffs 
Gillette TREO 	Tampax 	Downy 	Swiffer 
Gillette Mach3 	Venus 	Dreft 	The Art of Shaving 
	Vidal Sassoon 	Era 	Tide 
			Vicks 

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# Virtual Patent Marking: P & G

United States Patent Marking effective from October 29, 2019 until this list is revised.

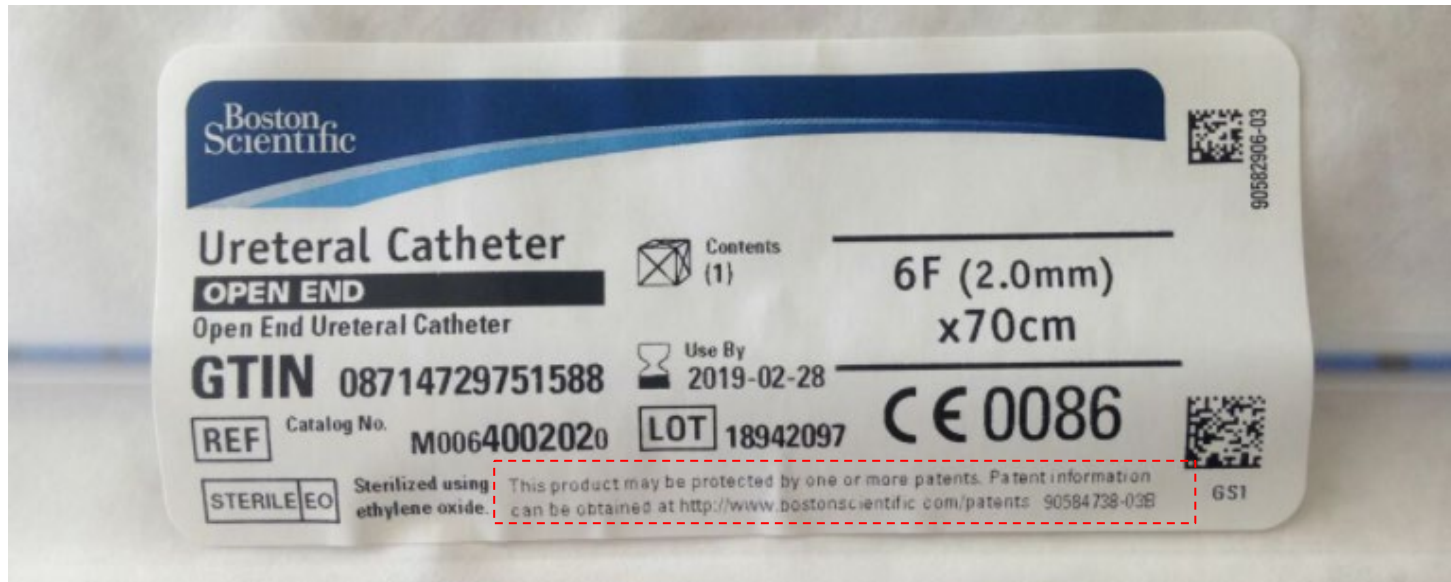
Gillette Fusion ProShield	
Product Name	Patent Number
ProShield Razor (including Chill)	
ProShield Cartridges	

Effective 2016 Sept 26  
Effective 2016 Oct 25  
Effective 2017 Apr 5  
Effective 2018 Apr 6



# 35 U.S.C. § 271 (a): Packaging

...or when, **from the character of the article, this can not be done**, by fixing to it, or to the **package** wherein one or more of them is contained, a label containing a like notice.

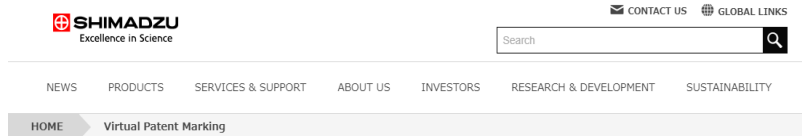




# Virtual Patent Marking: Boston Scientific

Product Name	Patent #	UPN #(s) or Catalog #
Apex Push Monorail		H7493896108150, H7493896112150, H7493896115150, H7493896120150
Apex Flex Monorail		H7493895908150, H7493895912150, H7493895915150, H7493895920150
Capio RP Suture Capturing Device		M0068321010
Dreamwire Guidewire		M00556101, M00556111, M00556121, M00556131, M00556141, M00556151, M00556161, M00556171
Graspit Nitinol Stone Retrieval Forceps		M0063204000, M0063204010, M0063204020, M0063204030
Hurricane RX Balloon Dilatation Catheter		M00545890, M00545900, M00545910, M00545920, M00545930, M00545940, M00545950, M00545960
LithoCatch 12 Wire Helical Immobilization Device		M0068404120
Polaris Ultra Dual Durometer Percuflex Material Ureteral Stent		M0061921110, M0061921120, M0061921130, M0061921140, M0061921150, M0061921200, M0061921210, M0061921220, M0061921230, M0061921240, M0061921250, M0061921300, M0061921310, M0061921320, M0061921330, M0061921340, M0061921350, M0061921400, M0061921410, M0061921420, M0061921430, M0061921440, M0061921450, M0061921500, M0061921510, M0061921520, M0061921530, M0061921540, M0061921550, M0061931110, M0061931120, M0061931130, M0061931140, M0061931150, M0061931200, M0061931210, M0061931220, M0061931230, M0061931240, M0061931250, M0061931300, M0061931310, M0061931320, M0061931330, M0061931340, M0061931350, M0061931400, M0061931410, M0061931420, M0061931430, M0061931440, M0061931450, M0061931500, M0061931510, M0061931520, M0061931530, M0061931540, M0061931550
Precision Twist Transvaginal Anchor System		M0068201550
Prefix PPS Pre-Pubic System		M0068506001, M0068506000

# Virtual Patent Marking: Japanese Companies



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\* Shimadzu U.S. Registered Trademarks or Trademarks – symbolized by ™

Analytical and Measuring Instruments	
Mass Spectrometry	
Product/Product Series Name	Patent Number
LCMS-2020/8040/8045/8050/8060	

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No.5 (2020-06-23)

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## 35 U.S. Code § 271 (a): Effects

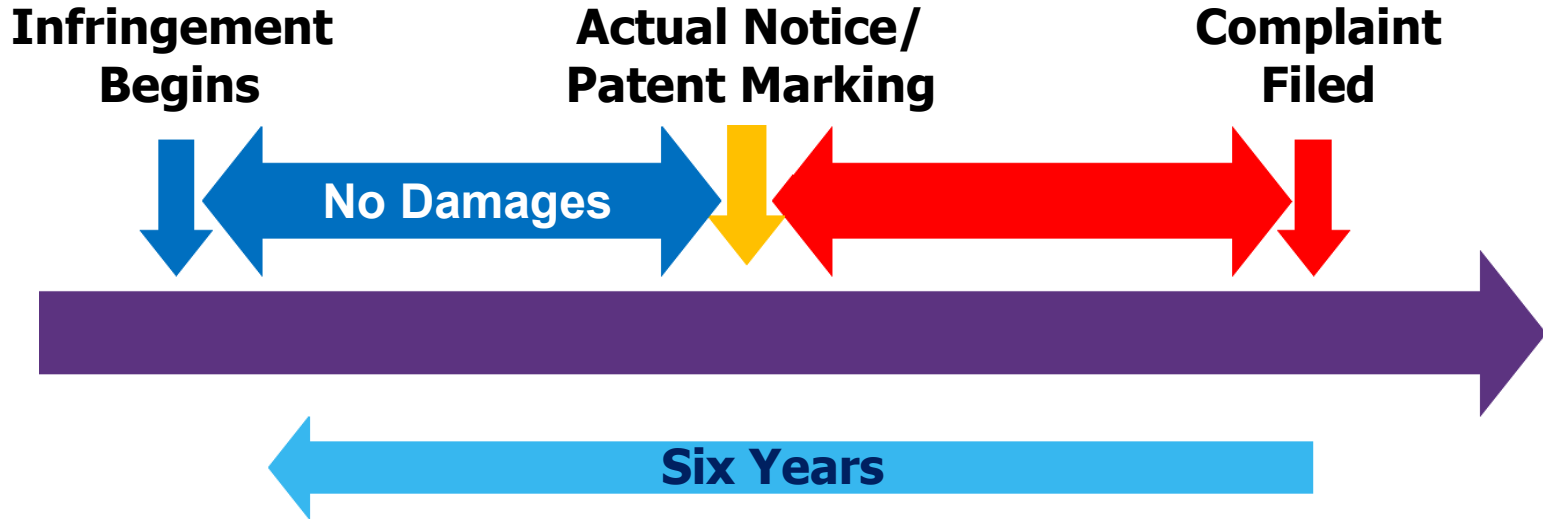
In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.

“**Actual Notice**” requires “affirmative communication of a **specific charge of infringement by a specific accused product or device**,” regardless of how the accused infringer may have interpreted a communication about potential infringement.

*See Amsted Indus. Inc. v. Buckeye Steel Castings Co.* (Fed. Cir. 1994)

# 35 U.S. Code § 271 (a): Effects

**35 U.S. Code § 286** ...no recovery shall be had for any infringement committed more than **six years** prior to the filing of the complaint or counterclaim for infringement in the action.



# Merits of Patent Marking

- Completes the prosecution of US patent rights
- Detering effect by the constructive notice
- Effective licensing and cross-licensing
- Business Promotion (product/technology)

# Demerits of Patent Marking

- Initial cost and efforts
- Continuous effort for updating/time stamping/  
licensee management
- Information disclosure

## False Marking is no longer a major issue

35 U.S.C. § 292(c): The marking of a product, in a manner described in subsection (a), with matter relating to a patent that covered that product **but has expired is not a violation of this section.**

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# PATENT MARKING IN LITIGATION



# Association: Patent List

## Fitbit Patent List



Last Update: December 4, 2020  
[version 2.5]

Fitbit products are covered by one or more US patents, including, but not limited to:



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[W]ebsite itself must do more than simply list the patentee's patents.

Simply listing all patents that could possibly apply to a product or all patents owned by the patentee merely creates a research project for the public, as opposed to giving public notice.

*See Mfg. Res. Int'l v. Civiq Smartscales* (D. Del. 2019)

# Method Claim v. Apparatus Claim

If the patentee asserts both apparatus and method claims, then the marking requirement needs to be met.

*See Am. Medi. Sys., Inc. v. Medical Engineering Corp.* (Fed. Cir. 1993)

If the patentee asserts only method claim in a patent that includes both apparatus and method claims, marking requirement need not be met.

*See Crown Packaging Tech. Inc. v. Rexam Beverage Can Co.* (Fed. Cir. 2009)

# Licensors' Obligation

[Marking] must be **substantially consistent and continuous** in order for the party to avail itself of the constructive notice provisions of the statute.

[W]hen others than the patentee are involved in sales to the public, a 'rule of reason' is applied, **consistent with the purpose of the constructive notice provision to encourage patentees to mark their products** in order to provide notice to the public of the existence of the patent and to prevent innocent infringement.

*See Am. Med. Sys., Inc. v. Med. Eng. Corp.*, (Fed. Cir. 1993)

# Patentee's Obligation

The notice requirement to which a patentee is subjected **cannot be switched on and off** as the patentee or licensee starts and stops making or selling its product.

[U]nmarked products remain on the market, incorrectly indicating to the public that there is no patent, while no corrective action has been taken by the patentee. **Confusion and uncertainty may result.**

Thus, **once a patentee begins making or selling a patented article**, the notice requirement attaches, and the obligation imposed by § 287 is discharged **only by providing actual or constructive notice.**

*See Arctic Cat Inc. v. Bombardier Recreational Products Inc.* (Fed. Cir. 2020)

# Ortiz & Associates Consulting v. Visio Inc.

- N.D. Tx. Nov. 2023
- Dismissing patent litigation case with prejudice due to lack of damages (i.e. failing to plead facts sufficient to state a claim for relief under Rule 12(b)(6))
- 12(b)(6) dismissal was based on failure to comply with the patent marking statute. The parties agreed that the asserted patent had expired and the NDTX Court dismissed pre-suit damages due to lack of marking of licensed products

# Ortiz & Associates Consulting v. Visio Inc.

- The patentee **must make reasonable efforts** to ensure its licensees comply with marking requirements of the marking statute... **In a patent infringement suit, patentees bear the burden of pleading compliance with the marking statute.**

# Ortiz & Associates Consulting v. Visio Inc.

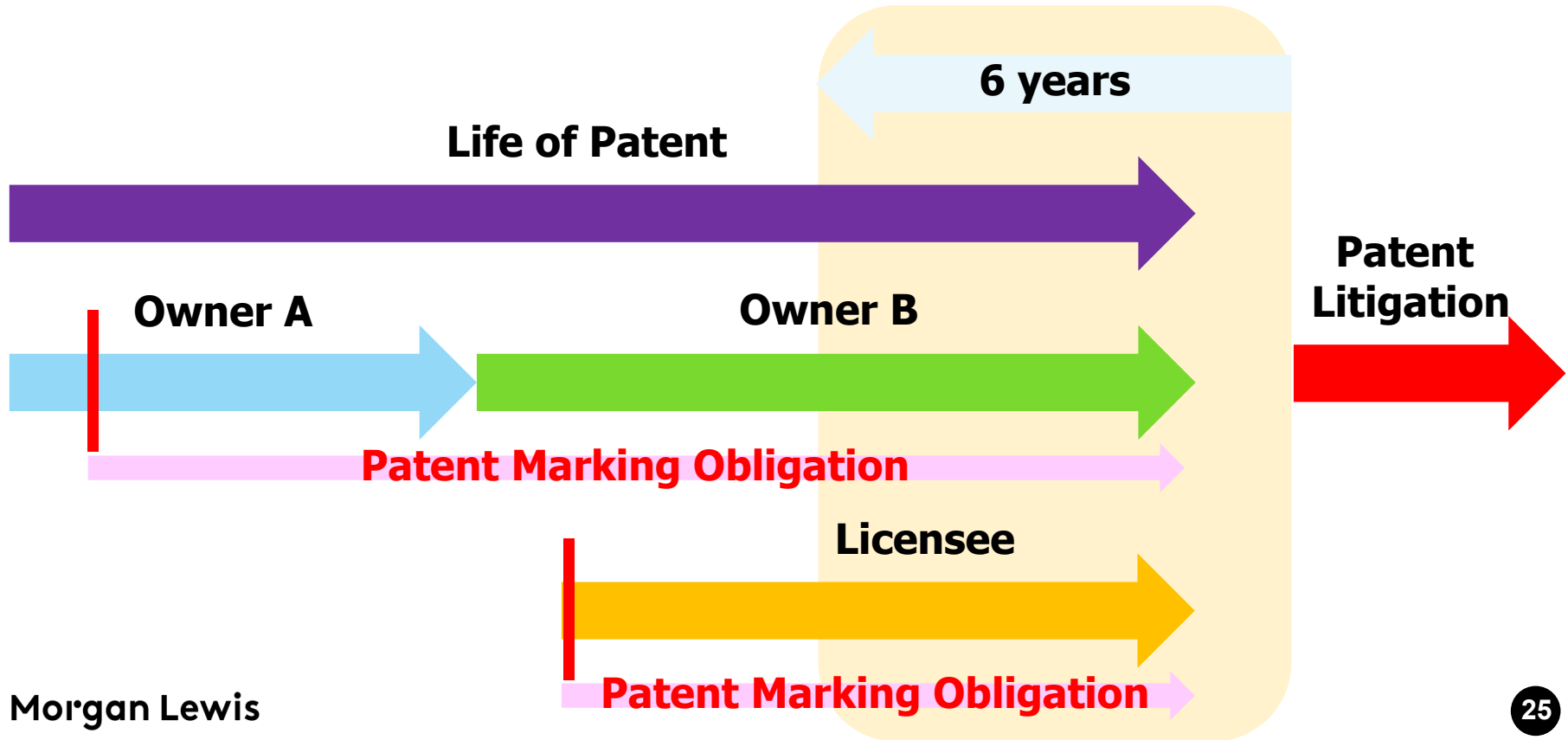
- Ortiz does not itself sell products that need to be marked, nor are any formal licensing agreements alleged. Nevertheless, VIZIO contends that Ortiz is subject to the marking statute because its **previous dismissals with prejudice of suits** against manufacturers selling products that allegedly infringe on the Asserted Patents **constitute licenses by operation of law**, meaning those products should be marked pursuant to section 237(a).

# Ortiz & Associates Consulting v. Visio Inc.

- VIZIO argues these voluntary dismissals with prejudice function as licenses to the Asserted Patents for use in the products at issue in those suits. **The Court agrees.** In the patent context, a license has been “described as a mere waiver of the right to sue by the patentee.” Further, the Federal Circuit has “on numerous occasions explained that a non-exclusive patent license is equivalent to a covenant not to sue[.]”



# Ortiz & Associates Consulting v. Visio Inc.



# THE INVENTION (May 2023)



## 米国特許技術論争の論点整理

### 第5回 Patent Marking ~損害賠償期間の起点

米国特許の技術論争に際して、米国特許法287条のバテントマーキング (Patent Marking) の有無が問題となる場合がある。日本特許法と違い、米国特許法ではバテントマーキングが特許権者の義務として定められており、その有無によって損害賠償額が左右される。この米国特許法特有の論点に関し、基本的な考え方を連邦巡回控訴裁判所 (CAFC) 判例を通じて押さえるとともに、実務的な対応手段 (バーチャルバテントマーキング) について解説する。



森下実郎  
Morgan, Lewis & Bockius LLP  
California/Washington D.C. 弁護士、  
外国法事務弁護士

#### 1. バテントマーキングの基本的な考え方

##### (1) バテントマーキングの効果

〔a〕特許権者および特許権者のためにもしくはその指示に基づいて、合衆国において特許物品を製造し、販売の申し出をしもしくは販売する者または特許物品を合衆国に輸入する者は、その物品に「patent」という文字もしくはその略語「pat.」を特許番号と共に付することによって、……当該物品が特許を受けたものであることを公衆に通知することができる。そのような表示をしなかった場合、特許権者は侵害訴訟によって損害賠償を受けることができない<sup>31)</sup>

上記のとおり、米国特許の権利者は特許物品に「Patent」等の表記を特許番号と共に表示 (バテントマーキング) することを通じて特許物品が特許を受けたものであることを公衆に通知し、行わない場合には特許権侵害訴訟によって損害賠償を受けることができないとされています。米国特許法上の損害賠償請求期間は訴訟提起から6年間を超えてはかばかすることはできないため、訴訟提起前の6年間でバテントマーキングが行われた期間が損害賠償の対象となります<sup>32)</sup>。

##### (2) パッケージへのマーキング

特許物品を特許番号と結びつけたものは物品の性質上そのようにすることが不可能な場合は当該物品もしくは当該物品の1つ以上が入っている包装に同様の通知を含むラベルを付させることによつて<sup>33)</sup>

バテントマーキングは原則として特許物品そのものに対してなされますが、特許物品そのものへのマーキングが難しい場合にはそのラベルやパッケージに付することも許されます。パッケージへのマーキングが許される基準は、特許物品に付する場合よりも効果的に「公衆に対する通知」が行われる場合です<sup>34)</sup>。

##### (3) バーチャルバテントマーキング

〔またはその物品に「patent」という文字もしくはその略語「pat.」をインターネット上の掲載アドレスと共に付することによつて〕<sup>35)</sup>

特許番号を製品やそのパッケージに表示する通常のバテントマーキングに代えて、インターネット上の掲載アドレスを「Patent」等の表記と共に付することをバーチャルバテントマーキングと呼びます。インターネット上で特許番号と特許物品を関連付けて表示することで、その和訳特許についてバテントマーキングの効力が生じることとなります。

複数の特許番号を製品上に記載する必要性や、権利期間が満了した特許番号を製品表示から取り除く作業負担から特許権者を解放することを目的として2012年のAIAで導入された加付で、近年バーチャルバテントマーキングを行う企業は増加傾向にあります。よく誤解されているのですが、特許物品へのマーキング義務がなくなったわけではなく、インターネット上の掲載アドレスを特許物品に付す必要があるので、ご注意ください。

Morgan Lewis

# ANNOUNCEMENTS

# IP Webinar Series: Better Safe than Sorry 2024

- No. 1: Important IP Cases (2024.01.26)
- No. 2: Anticipation [Nagoya] (2024.03.15)
- No. 3: Patent Marking [Osaka] (2024.06.14)
- No. 4: IPR Update [MLB Tokyo] (2024.08.23)
- No. 5: [MLB Silicon Valley] (2024.10.22)
- No. 6: [Fukuoka] (2024.11.28)



# Introduction Campaign

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1. 今回のウェビナーの感想は？

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1

2

3

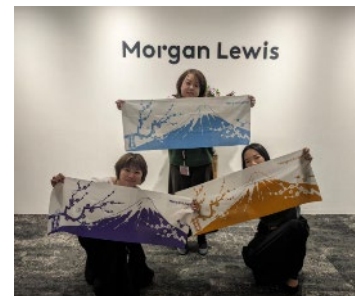
4

5



2. 今回が初めての参加の方で、ご紹介者がある場合はその方のお名前をご記入ください

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