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Reminder to Patent Holders: Mark Your Products

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If you are a patent holder and are selling a product covered by your patent, please remember to mark your products. The purpose of patent marking is to give notice to the public that the product being sold is patented. If you have been diligent in marking your products, you may be eligible to obtain back damages for any infringement that has occurred in the previous six years.

Patent holders may satisfy the notice requirement of 35 U.S.C. § 287 by affixing the word “patent” or “pat.” and the patent number to the article being sold. Alternatively, patent holders may virtually mark articles by providing a URL on the article. The webpage associated with the URL must be free and publicly available and must clearly link the patented product with the relevant patent number(s).

In the event a patent holder sells a product that is not marked with the patent number, the patent holder may notify an infringer of the infringement, such as by initiating a lawsuit. Damages in these cases are limited only to infringement occurring after the notice, therefore back damages will not be awarded.

The notice provisions thus look to the patent holder’s conduct, placing an affirmative duty on the patent holder to associate the product being sold with the issued patent. Although it may seem counterintuitive, an infringer’s knowledge of the patent is not relevant for purposes of notice. Rather, an infringer’s knowledge of the patent enables patent holders to obtain treble damages in infringement suits if the patent holder can prove willful infringement.

Marking Considerations

Whether you should physically mark or virtually mark your product depends on a few different factors, such as the type of product and the number of patents covering a product. Patent markings should be visible and easy to read, so manufacturers should consider marking the packaging or label instead of the product itself if the product is small or subject to wear. In these cases, the marked packaging or label must accompany the sold product. Stamping or imprinting the patent

number into the product may be viable, so long as the marking is not concealed.

Manufacturers who have larger patent portfolios may want to consider virtual marking as an option, especially if more than one patent covers a single product. Manufacturers may consider placing stickers containing the URL on each product or providing the URL on the product packaging. Virtual marking may allow manufacturers to update the patent marking without changing the product itself. Accordingly, someone within the organization will need to keep the product webpage(s) updated with the associated patent number(s).

Moreover, manufacturers should mark products being sold in the United States with both U.S. patent and foreign patent numbers covering the product. Foreign jurisdictions may have optional or mandatory marking requirements, so consider marking products bound outside of the U.S. If in doubt, please consult foreign counsel for local rules and best practices.

Another issue to be mindful of is the timing of the marking. Products may be marked with the “patent pending” designation during the prosecution of the patent application, which may alert others of a potential patent. However, once the patent is issued, the product must identify the patent number, either physically or virtually, to comply with the marking requirements. Once a patent expires, the product should be updated to remove the marking. Markings should be updated for any subsequently issued patents covering the product.

Exclusions

Patent holders who do not sell products covered by their patents are excluded from this rule because they have no product to mark. Patent holders may still be rewarded with reasonable royalties in an action but are not eligible for lost profits if they do not practice the invention.

Patents with method claims may also be excluded from this rule. Because the statute requires that “patented articles” be marked, patents drawn to method claims are excluded from the category of patents requiring marking. However, where a patent covers both method and apparatus claims, and the patent holder asserts both in an action, the patent holder must mark any product(s) covered by the apparatus claims to be eligible for back damages. In other words, if the patent holder has not marked a product, he shouldn’t assert both method and apparatus claims and expect to obtain back damages. Thus, patent holders can avoid this result by only asserting method claims.

Some courts have expressed skepticism with this kind of gamesmanship. One district court has said “the Federal Circuit took a wrong turn when it began basing application of the marking requirement on a patentholder’s litigation decisions rather than on whether an article covered by the patent was marked” (*Core Optical Techs., LLC v. Juniper Networks Inc.*, 562 F. Supp. 376, 380 (N.D. Cal. 2021)). But that’s the rule for now. If the Federal Circuit were to change anything, one might imagine the court would say that policy goals would be best served by requiring marking when an asserted method is linked with an apparatus claim, even if only method claims are asserted in an action. Therefore, when in doubt, you are best served by marking anyways—and this is your reminder to do so.

If you have any concerns or questions about complying with the marking requirements, please consult a Vorys attorney.

