

Marking Products Protected by Patents and Registered Designs

In the context of patents and registered design rights, “marking” is the process of visually labelling a product with a related patent number (or application number) and/or a registered design number (or application number).

In the UK, marking is not mandatory, but it is often employed by IP owners to deter would-be infringers by:

- highlighting the fact that a product is (or will potentially be) protected by a patent and/or protected by a registered design right; and
- reducing the likelihood that an infringer could successfully claim they were “innocently” infringing those rights (i.e., claim they were unaware, or could not have been aware, that the infringed patent or registered design existed).

It should be noted that a patent can be infringed at any time after its publication during prosecution, but enforcement action can only be taken once a patent is granted. In the UK, registered designs can only be infringed after they are registered, but there may still be some benefit in marking a product with the registered design application number as a ‘keep off the grass’ sign, if the length of time between the application date and registration is significant.

Preventing defendants from claiming “innocent infringement” is beneficial for patent proprietors and licensees, as damages/accounts of profit are not awarded against defendants who can prove they were “innocently” infringing a patent. Similarly, damages are not awarded against defendants who can prove they were “innocently” infringing a registered design.

What are the rules regarding patent/registered design marking?

Marking products protected by patent/registered design rights is subject to national domestic law within Europe. Therefore, for products marketed or sold in the UK, any marking must comply with UK law to have the intended legal consequences in infringement proceedings. In the UK, any words marked on a product expressing or implying that a patent has been obtained for the product, or that a design applied to (or incorporated in) the product is registered, must be accompanied by:

- the number of the patent/registered design; or
- a website address that is accessible to the public free of charge and clearly associates the product with the number of the patent/registered design (commonly referred to as ‘virtual’ or ‘web’ marking).

The general principle is that a third party should be able to readily locate the IP rights concerned

and understand which rights apply to the product. Therefore, a webpage that simply contains a list of IP rights without clearly identifying **which rights apply to which products** might not be adequate to put a would-be infringer on notice. Of course, there may be strategic risk in advertising this information to your competitors, so the decision to mark (or not) should be made a case-by-case basis balancing the various factors.

It is crucial that the marking is accurate; falsely representing a product as being protected by a patent (application) or a registered design (application) is **illegal in the UK**. For example, this includes marketing or labelling a product for sale in the UK as “patent pending” when no such UK application exists.

False patent marking also includes references to a patent or patent application for which the claim scope **no longer covers the product being marked** (e.g., due to amendment during prosecution/post grant) and references to a patent or patent application **which no longer exists** (e.g., due to refusal/withdrawal of a patent application, or revocation/ expiry of a patent). For the latter case, UK law does allow for a period of time for removal of the inaccurate patent marking, during which the false representation of protection is not considered an illegal act. This period of time is defined as “reasonably sufficient” to enable steps to be taken to ensure the false representation is not made.

False registered design marking includes stamping, engraving, impressing, or otherwise applying the word “registered”, or any other words implying that there is a subsisting registered design right, to a product which is not so protected, unless it is shown that the reference is to a valid design registration elsewhere than in the UK.

Therefore, it is important to monitor and update any marking you may employ to ensure you are acting within the law. This is often easier to achieve using virtual marking; keeping an internet link updated with relevant patent and/or design registration information is often cheaper and less labour intensive than updating a collection of pre-marked stock or accompanying paper literature. For the same reason, businesses may wish to consider marking only select products for which they intend to actively deter infringers (e.g., their most profitable, protected products).

This is for general information only and does not constitute legal advice. Should you require advice on this or any other topic then please contact hk@hik-ip.com or your usual HLK advisor.