

35 USCS § 287

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§ 287. Limitation on damages and other remedies; marking and notice

(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, 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, 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. 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.

(b)

(1)An infringer under section 271(g) [35 USCS § 271(g)] shall be subject to all the provisions of this title relating to damages and injunctions except to the extent those remedies are modified by this subsection or section 9006 of the Process Patent Amendments Act of 1988 [35 USCS § 271 note]. The modifications of remedies provided in this subsection shall not be available to any person who--

(A)practiced the patented process;

(B)owns or controls, or is owned or controlled by, the person who practiced the patented process;
or

(C)had knowledge before the infringement that a patented process was used to make the product the importation, use, offer for sale, or sale of which constitutes the infringement.

(2)No remedies for infringement under section 271(g) [35 USCS § 271(g)] shall be available with respect to any product in the possession of, or in transit to, the person subject to liability under such section before that person had notice of infringement with respect to that product. The person subject to liability shall bear the burden of proving any such possession or transit.

(3)

(A)In making a determination with respect to the remedy in an action brought for infringement under section 271(g) [35 USCS § 271(g)], the court shall consider--

(i)the good faith demonstrated by the defendant with respect to a request for disclosure,

(ii)the good faith demonstrated by the plaintiff with respect to a request for disclosure, and

(iii)the need to restore the exclusive rights secured by the patent.

(B)For purposes of subparagraph (A), the following are evidence of good faith:

(i)a request for disclosure made by the defendant;

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- (ii) a response within a reasonable time by the person receiving the request for disclosure; and
- (iii) the submission of the response by the defendant to the manufacturer, or if the manufacturer is not known, to the supplier, of the product to be purchased by the defendant, together with a request for a written statement that the process claimed in any patent disclosed in the response is not used to produce such product.

The failure to perform any acts described in the preceding sentence is evidence of absence of good faith unless there are mitigating circumstances. Mitigating circumstances include the case in which, due to the nature of the product, the number of sources for the product, or like commercial circumstances, a request for disclosure is not necessary or practicable to avoid infringement.

(4)(A) For purposes of this subsection, a "request for disclosure" means a written request made to a person then engaged in the manufacture of a product to identify all process patents owned by or licensed to that person, as of the time of the request, that the person then reasonably believes could be asserted to be infringed under section 271(g) [35 USCS § 271(g)] if that product were imported into, or sold, offered for sale, or used in, the United States by an unauthorized person. A request for disclosure is further limited to a request--

- (i) which is made by a person regularly engaged in the United States in the sale of the same type of products as those manufactured by the person to whom the request is directed, or which includes facts showing that the person making the request plans to engage in the sale of such products in the United States;

- (ii) which is made by such person before the person's first importation, use, offer for sale, or sale of units of the product produced by an infringing process and before the person had notice of infringement with respect to the product; and

- (iii) which includes a representation by the person making the request that such person will promptly submit the patents identified pursuant to the request to the manufacturer, or if the manufacturer is not known, to the supplier, of the product to be purchased by the person making the request, and will request from that manufacturer or supplier a written statement that none of the processes claimed in those patents is used in the manufacture of the product.

(B) In the case of a request for disclosure received by a person to whom a patent is licensed, that person shall either identify the patent or promptly notify the licensor of the request for disclosure.

(C) A person who has marked, in the manner prescribed by subsection (a), the number of the process patent on all products made by the patented process which have been offered for sale or sold by that person in the United States, or imported by the person into the United States, before a request for disclosure is received is not required to respond to the request for disclosure. For purposes of the preceding sentence, the term "all products" does not include products made before the effective date of the Process Patent Amendments Act of 1988.

(5)(A) For purposes of this subsection, notice of infringement means actual knowledge, or receipt by a person of a written notification, or a combination thereof, of information sufficient to persuade a reasonable person that it is likely that a product was made by a process patented in the United States.

(B) A written notification from the patent holder charging a person with infringement shall specify the patented process alleged to have been used and the reasons for a good faith belief that such process was used. The patent holder shall include in the notification such information as is reasonably necessary to explain fairly the patent holder's belief, except that the patent holder is not required to disclose any trade secret information.

(C) A person who receives a written notification described in subparagraph (B) or a written response to a request for disclosure described in paragraph (4) shall be deemed to have notice of

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infringement with respect to any patent referred to in such written notification or response unless that person, absent mitigating circumstances--

(i) promptly transmits the written notification or response to the manufacturer or, if the manufacturer is not known, to the supplier, of the product purchased or to be purchased by that person; and

(ii) receives a written statement from the manufacturer or supplier which on its face sets forth a well grounded factual basis for a belief that the identified patents are not infringed.

(D) For purposes of this subsection, a person who obtains a product made by a process patented in the United States in a quantity which is abnormally large in relation to the volume of business of such person or an efficient inventory level shall be rebuttably presumed to have actual knowledge that the product was made by such patented process.

(6) A person who receives a response to a request for disclosure under this subsection shall pay to the person to whom the request was made a reasonable fee to cover actual costs incurred in complying with the request, which may not exceed the cost of a commercially available automated patent search of the matter involved, but in no case more than \$ 500.

(c)

(1) With respect to a medical practitioner's performance of a medical activity that constitutes an infringement under section 271(a) or (b) [35 USCS § 271(a) or (b)], the provisions of sections 281, 283, 284, and 285 [35 USCS §§ 281, 283, 284, and 285] shall not apply against the medical practitioner or against a related health care entity with respect to such medical activity.

(2) For the purposes of this subsection:

(A) the term "medical activity" means the performance of a medical or surgical procedure on a body, but shall not include (i) the use of a patented machine, manufacture, or composition of matter in violation of such patent, (ii) the practice of a patented use of a composition of matter in violation of such patent, or (iii) the practice of a process in violation of a biotechnology patent.

(B) the term "medical practitioner" means any natural person who is licensed by a State to provide the medical activity described in subsection (c)(1) or who is acting under the direction of such person in the performance of the medical activity.

(C) the term "related health care entity" shall mean an entity with which a medical practitioner has a professional affiliation under which the medical practitioner performs the medical activity, including but not limited to a nursing home, hospital, university, medical school, health maintenance organization, group medical practice, or a medical clinic.

(D) the term "professional affiliation" shall mean staff privileges, medical staff membership, employment or contractual relationship, partnership or ownership interest, academic appointment, or other affiliation under which a medical practitioner provides the medical activity on behalf of, or in association with, the health care entity.

(E) the term "body" shall mean a human body, organ or cadaver, or a nonhuman animal used in medical research or instruction directly relating to the treatment of humans.

(F) the term "patented use of a composition of matter" does not include a claim for a method of performing a medical or surgical procedure on a body that recites the use of a composition of matter where the use of that composition of matter does not directly contribute to achievement of the objective of the claimed method.

(G) the term "State" shall mean any State or territory of the United States, the District of Columbia, and the Commonwealth of Puerto Rico.

(3) This subsection does not apply to the activities of any person, or employee or agent of such person (regardless of whether such person is a tax exempt organization under section 501(c) of the Internal

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Revenue Code [26 USCS § 501(c)], who is engaged in the commercial development, manufacture, sale, importation, or distribution of a machine, manufacture, or composition of matter or the provision of pharmacy or clinical laboratory services (other than clinical laboratory services provided in a physician's office), where such activities are:

(A) directly related to the commercial development, manufacture, sale, importation, or distribution of a machine, manufacture, or composition of matter or the provision of pharmacy or clinical laboratory services (other than clinical laboratory services provided in a physician's office), and

(B) regulated under the Federal Food, Drug, and Cosmetic Act [21 USCS §§ 301 et seq.], the Public Health Service Act [42 USCS §§ 201 et seq.], or the Clinical Laboratories Improvement Act.

(4) This subsection shall not apply to any patent issued based on an application which has an effective filing date before September 30, 1996.

History

(July 19, 1952, ch 950, § 1, [66 Stat. 813](#); Aug. 23, 1988, P.L. 100-418, Title IX, Subtitle A, § 9004(a), *102 Stat. 1564*; Dec. 8, 1994, P.L. 103-465, Title V, Subtitle C § 533(b)(5), *108 Stat. 4989*; Sept. 30, 1996, P.L. 104-208, Div A, Title I, § 101(a) [Title VI, § 616], *110 Stat. 3009-67*; Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), *113 Stat. 1536*.)

(As amended Sept. 16, 2011, P.L. 112-29, §§ 3(g)(2), 16(a)(1), 20(i)(4), (j)(1), *125 Stat. 288, 328, 335*.)

Prior law and revision:

Based on 35 U.S.C., 1946 ed., § 49 (R. S. § 4900; Feb. 7, 1927, ch 67, [44 Stat. 1058](#)).

Language is changed. The proviso in the corresponding section of existing statute is omitted as being temporary in character and now obsolete.

Annotations

Notes

References in text:

The "Clinical Laboratories Improvement Act", referred to in this section, is § 5 of Act Dec. 5, 1967, P.L. 90-174, which appears as [42 USCS § 263a](#) and notes.

As to the "effective date of the Process Patent Amendments Act of 1988", referred to in this section, see § 9006 of Act Aug. 23, 1988, P.L. 100-418, which appears as *35 USCS § 271* note.

Explanatory notes:

The amendment made by § 1000(a)(9) of Act Nov. 29, 1999, P.L. 106-113, is based on § 4803 of Subtitle H of Title IV of S. 1948 (*113 Stat. 1501A-589*), as introduced on Nov. 17, 1999, which was enacted into law by such § 1000(a)(9).

Amendments:

1988 . Act Aug. 23, 1988 (effective 6 months after enactment and applicable as provided by § 9006 of such Act, which appears as *35 USCS § 271* note) designated the existing provisions as subsec. (a); and added subsec. (b).

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1994 . Act Dec. 8, 1994 (effective 1/1/96, pursuant to § 534 of such Act, which appears as *35 USCS § 154* note), in subsec. (a), substituted "making, offering for sale, or selling within the United States" for "making or selling" and inserted "or importing any patented article into the United States,;" in subsec. (b), in para. (1)(C), substituted "use, offer for sale, or sale" for "use, or sale", in para. (4), in subpara. (A), in the introductory matter, substituted "sold, offered for sale, or" for "sold or", in cl. (ii), substituted "use, offer for sale, or sale" for "use, or sale" and, in subpara. (C), substituted "have been offered for sale or sold" for "have been sold" and substituted "United States, or imported by the person into the United States, before" for "United States before".

1996 . Act Sept. 30, 1996 added subsec. (c).

1999 . Act Nov. 29, 1999, in subsec. (c)(4), substituted "based on an application the earliest effective filing date of which is prior to September 30, 1996" for "before the date of enactment of this subsection".

2011 . Act Sept. 16, 2011 (applicable to any case pending on, or commenced on or after, enactment, as provided by § 16(a)(2) of such Act, which appears as a note to this section), in subsec. (a), inserted "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,".

Such Act further (effective 1 year after enactment and applicable to proceedings commenced on or after that effective date, as provided by § 20(l) of such Act, which appears as *35 USCS § 2* note), in subsec. (b)(2), deleted "of this title" following "271(g)"; and in subsec. (c), in para. (1), deleted "of this title" following "271(a) or (b)" and "285", and in para. (2)(G), substituted "any State" for "any state".

Such Act further (effective 18 months after enactment and applicable as provided by § 3(n) of such Act, which appears as *35 USCS § 100* note), substituted "which has an effective filing date before" for "the earliest effective filing date of which is prior to".

Other provisions:

Application of amendment made by § 16(a) of Act Sept. 16, 2011. Act Sept. 16, 2011, P.L. 112-29, § 16(a)(2), *125 Stat. 328*, provides: "The amendment made by this subsection [amending subsec. (a) of this section] shall apply to any case that is pending on, or commenced on or after, the date of the enactment of this Act."

Case Notes

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I. IN GENERAL

1. Generally

Patentee cannot recover for infringement unless the article is marked "patented" or notice is given. [Coupe v Royer \(1895\) 155 US 565, 39 L Ed 263, 15 S Ct 199.](#)

Two forms of notice were authorized, one to public by visible mark, and other by actual advice to infringer; the second became necessary only when the first had not been given; and the first could only have been given in connection with some fabricated article. [Wine R. Appliance Co. v Enterprise R. Equipment Co. \(1936\) 297 US 387, 80 L Ed 736, 56 S Ct 528.](#)

Word "damages" included profits. [Franklin Brass Foundry Co. v Shapiro & Aronson, Inc. \(1921, CA3 Pa\) 278 F 435; Flat Slab Patents Co. v Turner \(1922, CA8 Minn\) 285 F 257,](#) cert den (1923) 262 US 752, 67 L Ed 1215, 43 S Ct 700; [Steinthal v Arlington Sample Book Co. \(1937, DC Pa\) 18 F Supp 643,](#) affd (1938, CA3 Pa) [94 F2d 748,](#) cert den (1938) 305 US 613, 83 L Ed 390, 59 S Ct 72.

Notice provisions of 35 USCS § 287 do not apply where patent is directed to process or method. [Crystal Semiconductor Corp. v Tritech Microelectronics Int'l, Inc. \(2001, CA FC\) 246 F3d 1336, 57 USPQ2d 1953.](#)

Marking and notice requirements did not apply to patentee and its licensee who did not make or sell entire patented article. [Olsson v United States \(1931\) 72 Ct Cl 72; Cameron Iron Works, Inc. v Edward Valves, Inc. \(1959, DC Tex\) 175 F Supp 423, 122 USPQ 497,](#) affd (1961, CA5 Tex) [286 F2d 933, 128 USPQ 307,](#) mod and reh den (1961, CA5 Tex) [289 F2d 355, 129 USPQ 131, 4 FR Serv 2d 843,](#) cert den (1961) 368 US 833, 7 L Ed 2d 34, 82 S Ct 55, 131 USPQ 498; [Abington Textile Machinery Works v Carding Specialists, Ltd. \(1965, DC Dist Col\) 249 F Supp 823, 148 USPQ 33.](#)

Unique nature of compensation provided by [28 USCS § 1498](#) precludes broadly applying infringement notice requirements set forth in 35 USCS § 287. *Simmonds Precision Products, Inc. v United States* (1967, Ct Cl) 153 USPQ 465.

Summary judgment for failure to mark or notify before bringing suit is dismissed because questions of fact remain as to whether patentee or licensees made or sold any patented products, and other issues remaining for trial would result in piecemeal litigation if summary judgment were granted. *Hale Bros. Associates, Inc. v United States* (1976, Ct Cl) 192 USPQ 114.

Fact of notice and subsequent infringement, when disputed, had to be determined by court, not by master. [Shapiro & Aronson, Inc. v Franklin Brass Foundry \(1921, DC Pa\) 272 F 176,](#) mod (1921, CA3 Pa) [278 F 435.](#)

License requiring articles involving "method and means" to be marked with patent in suit precluded patentee from contending that patent was for process only and did not need to be marked. [Hazeltine Corp. v Radio Corp. of Am. \(1937, DC NY\) 20 F Supp 668](#) (criticized in [Aerogroup Int'l v Marlboro Footworks \(1997, SD NY\) 1997 US Dist LEXIS 2044.](#)

35 USCS § 287 is not permissive, but prescribes the exclusive method by which notice can be given to entitle patent holder to collect damages from infringer. [Carlisle v Estes \(1967, DC Colo\) 157 USPQ 6.](#)

Notice requirement of 35 USCS § 287 is limited to patented articles and does not apply to methods or processes so that plaintiff is entitled to damages for all infringing uses under method patent. [Bandag, Inc. v Gerrard Tire Co. \(1982, WD NC\) 217 USPQ 769,](#) revd on other grounds (1983, CA) [704 F2d 1578, 217 USPQ 977.](#)

In context of 35 USCS § 287(c)(1), "procedure" is defined as act or conduct of medical diagnosis, treatment, or operation. [Emtel, Inc. v LipidLabs, Inc. \(2008, SD Tex\) 583 F Supp 2d 811.](#)

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35 USCS § 287(c), which defines "medical activity" as performance of medical or surgical procedure on body, includes procedures that are performed remotely by physicians by means of video-conferencing technology. [Emtel, Inc. v LipidLabs, Inc. \(2008, SD Tex\) 583 F Supp 2d 811.](#)

Because its legislative history shows that 35 USCS § 287(c) is intended to protect physicians from infringement suits for procedures they use to treat patients, while allowing patent protection for medical devices, biotechnology, or drugs and methods of using them, diagnosing patient is potentially "medical or surgical procedure" subject to § 287(c)'s physician immunity provision. [Emtel, Inc. v LipidLabs, Inc. \(2008, SD Tex\) 583 F Supp 2d 811.](#)

Because 35 USCS § 287(b) pertained to remedies for infringement of process patent and not to remedies for infringement of product patent, notice provision of § 287(b)(5)(A) was inapplicable to patentee's claim that importers' sale of replicas of patentee's patented tobacco pipe infringed patentee's patent. [Lee v Accessories By Peak \(2010, WD NY\) 705 F Supp 2d 249.](#)

Notice requirement applies to articles and not to patented processes or methods so that lack of marking on patented method of tire recapping does not restrict damages for infringement to time of actual notice. [Bandag, Inc. v Gerrard Tire Co. \(1983, CA\) 704 F2d 1578, 217 USPQ 977.](#)

These provisions were not applicable where patent was exclusively for a process. [United States Mitis Co. v Carnegie Steel Co. \(1898, CCD Pa\) 89 F 206,](#) affd (1898, CA3) 90 F 829; [United States Mitis Co. v Midvale Steel Co. \(1904, CCD Pa\) 135 F 103;](#) [Wagner v Corn Products Refining Co. \(1928, DC NJ\) 28 F2d 617.](#)

Requirement with reference to marking patented articles had no application to circumstances under which the patent had lain absolutely dormant. [Ewart Mfg. Co. v Baldwin Cycle-Chain Co. \(1898, CCD Mass\) 91 F 262.](#)

These provisions were made applicable to design patents. [Lichtenstein v Straus \(1908, CCD NY\) 166 F 319.](#)

2. Limitation on damages

Damages could not have been recovered by patentee unless he has given notice of his right, either to the whole public by marking his article "patented" or to the particular defendants by informing them of his patent and of their infringement of it. [Dunlap v Schofield \(1894\) 152 US 244, 38 L Ed 426, 14 S Ct 576](#) (superseded by statute as stated in [Maxwell v J. Baker, Inc. \(1992, DC Minn\) 805 F Supp 728, 26 USPQ2d 1241;](#) [Coupe v Royer \(1895\) 155 US 565, 39 L Ed 263, 15 S Ct 199;](#) [Gibson v American Graphophone Co. \(1916, CA2 NY\) 234 F 633.](#)

No damages for infringement by sale could have been recovered if the patentee at time of such sale, had not complied with these provisions. [Monroe v Anderson \(1893, CA3 Pa\) 58 F 398.](#)

Where first notice defendants had of existence of complainant's patent was by commencement of infringement suits against them, all the relief to which complainant was entitled was a permanent injunction against infringement. [Morton Trust Co. v Standard Steel Car Co. \(1910, CA3 Pa\) 177 F 931.](#)

In absence of proof that defendant made profits after notice of patent there could have been no recovery, and an interlocutory decree could not have amounted to an implied finding that such notice existed. [O'Nate v Bahr \(1933, CA9 Cal\) 67 F2d 180.](#)

Damages and profits could not have been recovered for manufacture of loose leaf books covered by pending application for patent containing no notice of patent, in absence of other notice of infringement. [Steinthal v Arlington Sample Book Co. \(1938, CA3 Pa\) 94 F2d 748,](#) cert den (1938) 305 US 613, 83 L Ed 390, 59 S Ct 72.

Recovery would not have been permitted of damages for infringement occurring while infringer was ignorant of patent, word "patented" not having been affixed to the article, or label attached, but recovery would have been limited to infringements arising after notice. [Swan Carburetor Co. v Nash Motors Co. \(1943, CA4 Md\) 133 F2d 562,](#)

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[56 USPQ 341](#), cert den (1943) 320 US 762, 88 L Ed 454, 64 S Ct 36, 59 USPQ 496, reh den (1943) 320 US 812, 88 L Ed 491, 64 S Ct 155; [McComb v Brodie \(1872, CCD La\) 5 Fish Pat Cas 384, 1 Wood 153, 15 F Cas 1290](#), No 8708; [Allen v Deacon \(1884, CCD Cal\) 10 Sawy 210, 21 F 122](#); [Parker Rust Proof Co. v Ford Motor Co. \(1928, DC Mich\) 23 F2d 502](#); [Royal Lace Paper Works v U. S. Lace Paper Works, Inc. \(1935, DC NY\) 11 F Supp 15](#).

35 USCS § 287 provides for damages only if there is a marking, giving notice to public that article is patented, together with patent number or if there is proof that alleged infringer was notified of infringement and continued to infringe thereafter; since neither prerequisite is present, plaintiff is not entitled to damages and, hence, has no right to jury trial. [Filmon Process Corp. v Sirica \(1967, App DC\) 126 US App DC 395, 379 F2d 449, 153 USPQ 440, 11 FR Serv 2d 997](#).

In discussing damages, district court erred in concluding that shoe retailer's reasonable steps and good faith efforts to bring its infringing activity to timely end equated to immediate cessation for purposes of 35 USCS § 287 where case law clearly provided that patentee was entitled to recover damages for infringement that continued after actual notice was provided under 35 USCS § 287. [DSW, Inc. v Shoe Pavilion, Inc. \(2008, CA FC\) 537 F3d 1342](#).

In patent infringement case, district court erred in excluding patentee's evidence of pre-notice, under 35 USCS § 287, price erosion because such evidence was relevant in calculating damages for defendant's post-notice direct infringement. [Power Integrations, Inc. v Fairchild Semiconductor Int'l, Inc. \(2013, CA FC\) 711 F3d 1348, 106 USPQ2d 1361](#).

Use of invention by government is irrelevant to notice of provisions, and party cannot resist answering interrogatories relative to governmental use because of failure of patentee to mark product with patent number. [Ampex Corp. v United States \(1980, Ct Cl\) 207 USPQ 440](#).

Infringers without notice were liable for profits. [Shapiro & Aronson, Inc. v Franklin Brass Foundry \(1921, DC Pa\) 272 F 176](#), mod (1921, CA3 Pa) [278 F 435](#).

Where plaintiff did not comply with these provisions and did not notify defendant of infringement, it could not have required accounting for profits and damages. [General Electric Co. v George J. Hagan Co. \(1929, DC Pa\) 40 F2d 505](#).

Failure to notify defendant of patent before filing suit limits damages to those occurring after suit. [Creative Pioneer Products Corp. v K Mart Corp. \(1986, SD Tex\) 5 USPQ2d 1841](#).

Plaintiff seeking declaratory judgment of patent invalidity and noninfringement is denied summary judgment on issue of damages occurring before counterclaim for infringement. [Sig Swiss Industrial Co. v Fres-Co System USA, Inc. \(1992, ED Pa\) 26 USPQ2d 1149](#).

Actual notice of infringement to maker of imitative cable wrapping machines is adequate without inclusion of number of infringed patent, so that determination of adequate actual notice is made; but conflicting evidence on whether patent number was marked consistently on cable wrapping machines results in denial of motion for summary judgment for limiting damages on grounds of failure of marking. [Ceeco Mach. Mfg., Ltd. v Intercole, Inc. \(1992, DC Mass\) 817 F Supp 979, 25 USPQ2d 1774](#).

Sales without notice of articles covered by claim 1 of patent do not bar recovery of damages for articles allegedly infringing claim 16 of patent, which deals with different feature, so that summary judgment limiting damages to suit filing date is denied. [Toro Co. v McCulloch Corp. \(1995, DC Minn\) 898 F Supp 679, 35 USPQ2d 1622](#).

Marking requirement for entitlement to damages does not apply to method patent in suit in which only method claims are alleged to be infringed, so that motion to exclude evidence of damages for lack of marking is denied. [American Bank Note Holographics v Upper Deck Co. \(1997, SD NY\) 41 USPQ2d 2019](#).

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Sales of unmarked products by licensees of patentee results in summary judgment for defendant on suit filed after expiration of patent. [Clancy Sys. Int'l v Symbol Techs. \(1997, DC Colo\) 953 F Supp 1170, 42 USPQ2d 1290.](#)

Under marking statute, to recover damages for infringement, patentee must adequately mark patented products with patent number or give alleged infringer notice of patent protection; where patentee has distributed unmarked products, damages do not begin to accrue under marking statute until patentee distributes marked products and stops distributing unmarked products, and (1) date that patentee begins marking its products is irrelevant for purposes of marking statute because marking alone without distribution provides no notice to public where unmarked products are continuing to be shipped, (2) patentee is not in full compliance with marking statute while it continues to ship its unmarked products, which continue to mislead public into thinking that product is freely available, and (3) full compliance is not achieved until patentee consistently marks substantially all of its patented products and no longer distributes unmarked products. [Halliburton Servs. v Smith Int'l, Inc. \(2004, ED Tex\) 317 F Supp 2d 719.](#)

Company that was sued for infringing three patents was entitled to partial summary judgment with regard to its 35 USCS § 287 damage limitation claims as to one patent but was not entitled to partial summary judgment as to remaining two patents; although company correctly asserted that marking statute limited damages that patentee could collect and that it applied to products made pursuant to patent that contained both method and apparatus claims, company's motion was only partially granted because (1) patentee could collect damages as of date it started both marking its products and shipping properly marked products, (2) with regard to two of patents, patentee had admitted date that it began marking its products and had raised material issues of fact with regard to date when it began shipping marked products, (3) with regard to products made pursuant to third patent, patentee had failed to present any evidence showing that it had properly marked products prior to filing patent infringement suit against company, (4) because it had not marked those products, company was not provided actual or constructive notice of patent under marking statute until suit was filed, and (5) therefore, with regard to products made pursuant to third patent, patentee could not collect damages prior to time patent infringement suit was filed. [Halliburton Servs. v Smith Int'l, Inc. \(2004, ED Tex\) 317 F Supp 2d 719.](#)

DVD manufacturer alleged that corporation sent letters to retailer and issued press releases accusing manufacturer of patent infringement, and, on basis of these actions, manufacturer sought to recover for intentional interference with its contractual relationship with retailer and for intentional interference with potential advantageous business relationships with retailer and other clients; however, manufacturer failed to allege bad faith. From face of corporation's letters and press releases, it appeared that corporation's patent right assertions were made in good faith and were not objectively baseless, and manufacturer offered no factual allegations to suggest otherwise; because manufacturer failed to plead that corporation acted in bad faith in asserting its patent rights, its state law tort claims were preempted by federal patent law. [Clearplay, Inc. v Nissim Corp. \(2008, SD Fla\) 555 F Supp 2d 1318.](#)

Patent assignee was precluded under 35 USCS § 287(a) from seeking damages from competitor for any infringement of assignee's patents that occurred prior to day assignee filed its infringement suit; the assignee did not show that substantially all of its patented products were marked. [Extreme Networks, Inc. v Enterasys Networks, Inc. \(2008, WD Wis\) 558 F Supp 2d 909,](#) motions ruled upon (2008, WD Wis) [2008 US Dist LEXIS 40173,](#) motions ruled upon (2008, WD Wis) [2008 US Dist LEXIS 40676.](#)

To collect damages in patent infringement case, patentee must notify infringer of infringement. 35 USCS § 287(a); thus, patent holder has right to send cease and desist letters for purpose of discontinuing allegedly infringing activity without subjecting patentee to liability under [Lanham Act. Futuristic Fences, Inc. v Illusion Fence, Corp. \(2008, SD Fla\) 558 F Supp 2d 1270, 21 FLW Fed D 282.](#)

Patent holder could not recover treble damages under 35 USCS § 284 with regard to company's alleged pre-filing infringement of several of holder's patents because compensatory damages were not available to holder as to that infringement under 35 USCS § 287: (1) treble damages were based on amount of compensatory damages recovered by holder in its infringement suit; (2) under § 287, holder had to provide notice of its patents in order to

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recover actual damages for infringement of those patents; and (3) holder could not recover compensatory damages, and hence could not recover treble damages under 35 USCS § 284, because it had not provided notice of several of its patents, either by marking devices at issue with patent number or by some other means, such as by referencing patents in its publicly distributed marketing materials. [*GSI Group, Inc. v Sukup Mfg. Co. \(2008, CD Ill\) 591 F Supp 2d 977.*](#)

In patent infringement case involving quick connect fittings for junction boxes, maker of accused products was entitled to have any damages under 35 USCS § 287 limited to period after date on which patentee actually notified maker of alleged infringement; despite settlement agreement between parties prohibiting infringement in general, under § 287, patentee had affirmative duty to police its patent and, in event it unearthed incident of infringement, to notify purported infringer. [*Arlington Indus. v Bridgeport Fittings, Inc. \(2009, MD Pa\) 610 F Supp 2d 370.*](#)

35 USCS § 287(b)(2) does not require party alleging infringement to provide notice; thus, fact that patent holder did not give notice of alleged infringement prior to filing its complaint did not establish absence of genuine issue of fact as to whether Delaware corporations that sold citalopram that was manufactured by Danish corporation knew that it was likely that products in its possession were made by patented process within meaning of 35 USCS § 271(g); because Delaware corporations could have received notice that processes used by Danish corporation in manufacturing citalopram infringed patent holder's patent by means other than communication from patent holder, Delaware corporations were not entitled to limitation of damages at summary judgment stage. [*Infosint, S.A. v H. Lundbeck A/S \(2009, SD NY\) 612 F Supp 2d 402,*](#) partial summary judgment gr, patent interpreted (2009, SD NY) [*612 F Supp 2d 405.*](#)

In patent infringement action wherein patents-in-suit claim involved automated systems for selecting and delivering packages to fill orders, such as patient prescriptions, district court adopted magistrate judge's report and recommendation, in part, which found that multiple issues of material fact existed warranting denial of alleged infringer's motion for summary judgment on its claim of noninfringement; however, two limitations construed by magistrate were overruled, namely magistrate judge's association of x, y coordinate with location of packages themselves because patents-in-suit contemplated coordinate system anchored by various means for holding packages, and magistrate judge identifying picking means 38 as providing insufficiently specific structure because district court concluded that one of ordinary skill would understand corresponding structure of that means limitations to be picking means 38; further, district court adopted recommendation of magistrate judge to grant patent owner's motion for summary judgment of no inequitable conduct, concluding that alleged infringer failed to demonstrate either that patentees knew or should have known of materiality of references, or that they intended to deceive *United States Patent and Trademark Office. McKesson Automation, Inc. v Swisslog Italia S.P.A. (2010, DC Del) 712 F Supp 2d 283.*

Patentee is not precluded from collecting damages for period in which marking was not required even if requirements of marking statute were later triggered and patentee failed to comply. [*WiAV Solutions LLC v Motorola, Inc. \(2010, ED Va\) 732 F Supp 2d 634.*](#)

In patent infringement action, 35 USCS § 287(a) applied with respect to one of patents at issue (computer chips), and operated to bar plaintiff patent holder from recovering pre-suit damages based on licensees' resale of chips manufactured by defendants; plaintiff had asserted apparatus claims against defendants in litigation, and furthermore sales were authorized by licenses granted by plaintiff without restriction as to products authorized by plaintiff, or contractual requirement to mark any such products. [*Carnegie Mellon Univ. v Marvell Tech. Group, LTD. \(2012, WD Pa\) 906 F Supp 2d 399.*](#)

Where plaintiffs' products did not practice patent at issue, marking rule did not limit claim for damages. [*SSI Sys. Int'l Inc. v Tek Global S.R.L. \(2013, ND Cal\) 929 F Supp 2d 971.*](#)

Absence of notice on airless snow making machines made by licensee of patentee does not bar collection of damages from user of machine that infringes method claims in patent. [*Hanson v Alpine Valley Ski Area, Inc. \(1983, CA\) 718 F2d 1075, 219 USPQ 679.*](#)

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Where there was neither proof that complainant's device was marked "patented," nor proof that actual notice was given, there could have been no accounting for profits and damages. [Westinghouse Air Brake Co. v New York Air Brake Co. \(1901, CCD NY\) 111 F 741](#); [B. B. Hill Mfg. Co. v Stewart \(1902, CCD NY\) 116 F 927](#).

Unpublished Opinions

Unpublished: District court properly limited inventor's patent infringement damages because court properly declined to consider alleged evidence that infringement continued beyond date court found infringement ended, as (1) such evidence was properly excluded under Fed. R. Civ. P. 37(c)(1), and (2) evidence attached to inventor's untimely motion to compel was properly not considered. [Malico, Inc. v Cooler Master USA Inc. \(2014, CA FC\) 594 Fed Appx 621](#).

II. MARKING AS NOTICE

3. Generally

No authority was granted for patentee to prescribe by notice attached to patented machine or article the conditions of its use and the supplies which had to be used in its operation, under pain of infringement of patent. [Motion Picture Patents Co. v Universal Film Mfg. Co. \(1917\) 243 US 502, 61 L Ed 871, 37 S Ct 416](#).

Notice by marking gave no notice whatever to a seller of an infringement committed by manufacturer. [Gimbel v Hogg \(1899, CA3 Pa\) 97 F 791](#).

Marking and advertising were intended to constitute caveats, notices of existence of patents, to end that all parties might have examined and learned for themselves whether or not their prima facie validity would have been their ultimate legal effect. [Rice-Stix Dry Goods Co. v J. A. Scriven Co. \(1908, CA8 Mo\) 165 F 639](#), affd (1911) 223 US 708, 56 L Ed 622, 32 S Ct 518.

Permissive wording of statute and policy of encouraging notice by marking results in construing 35 USCS § 287(a) to preclude recovery of damages for infringement for any time prior to compliance with marking or actual notice requirements so that delay between issuance of patent and compliance with marking provisions does not prevent recovery of damages after date that marking has begun; and district court conclusion to contrary is reversed. [American Medical Sys. v Medical Eng'g Corp. \(1993, CA FC\) 6 F3d 1523, 28 USPQ2d 1321](#), reh, en banc, den (1993, CA FC) [1993 US App LEXIS 32603](#) and cert den (1994) 511 US 1070, 128 L Ed 2d 366, 114 S Ct 1647.

Patent marking provisions of 35 USCS § 287 apply to recovery of profits for design patent infringement, so that judgment to contrary is reversed and remanded for determination of adequacy of patentee's marking of patented design for athletic shoes. [Nike Inc. v Wal-Mart Stores \(1998, CA FC\) 138 F3d 1437, 46 USPQ2d 1001](#), reh, en banc, den (1998, CA FC) [1998 US App LEXIS 10173](#) and cert den, motion gr (1999) 528 US 946, 145 L Ed 2d 284, 120 S Ct 363 and (criticized in [Tulip Computers Int'l B.V. v Dell Computer Corp. \(2003, DC Del\) 2003 US Dist LEXIS 5409](#)).

Because of [7 USCS § 2567](#)'s similarity to 35 USCS § 287(a), party seeking to recover damages for infringement under Plant Variety Protection Act (PVPA), [7 USCS §§ 2321](#) et seq., must allege and prove marking or actual notice requirements of [7 USCS § 2567](#); therefore, cotton cooperative did not waive its arguments based upon knowledge requirements of § 2567 because cotton cooperative did not bear burden of establishing element of knowledge at trial, and trial court's failure to require corporations to plead and prove their damages claim under [7 USCS § 2541\(a\)\(6\)](#) was erroneous as matter of law. [Syngenta Seeds, Inc. v Delta Cotton Coop., Inc. \(2006, CA FC\) 457 F3d 1269, 79 USPQ2d 1576](#).

District court properly granted summary judgment that defendant was not liable for pre-issuance damages because, based on record, no reasonable jury could find that defendant had actual knowledge of published patent application

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at issue; constructive notice, even if established, would not suffice, but nor was patentee required to affirmatively act to give notice in order for infringer to have actual knowledge, such as with marking statute. [Rosebud LMS Inc. v Adobe Sys. \(2016, CA FC\) 812 F3d 1070, 117 USPQ2d 1717.](#)

As general rule, marking of goods with patent number estops marker from denying that product is within scope of patent. [Crane Co. v Aeroquip Corp. \(1973, ND Ill\) 356 F Supp 733, 177 USPQ 666.](#)

Asphalt preserver delivered from bulk storage tanks into transport trucks is subject to patent marking provisions, since storage tanks could have been marked, so that defendant's motion to limit damages to period after actual notice is granted. [Western Emulsions v Copperstate Emulsions \(1997, DC Ariz\) 42 USPQ2d 1856.](#)

Where software company accused of patent infringement argued that patentee failed to comply with 35 USCS § 281(a) when it failed to take reasonable efforts to ensure that its licensees marked patented product and where patentee disputed that any such legal requirement existed and noted that software company failed to identify any evidence of distribution of unmarked product by licensees, genuine issues of material fact existed with respect to compliance with 35 USCS § 281(a), which issues precluded award of partial summary judgment in favor of software company. [Imagexpo, L.L.C. v Microsoft Corp. \(2003, ED Va\) 299 F Supp 2d 550.](#)

Where corporation had patent that contained both method and apparatus claims on universal remote controls, corporation's damages were limited under 35 USCS § 287(a) because corporation did not mark its universal remote controls. [Philips Elecs. N. Am. Corp. v Contec Corp. \(2004, DC Del\) 312 F Supp 2d 649,](#) stay gr, injunction gr, motion gr, motion den (2004, DC Del) [2004 US Dist LEXIS 13455.](#)

Only time that notice provisions of federal marking statute do not come into play is when patent is directed to only method or process, but when patent contains both method and apparatus claims and when there is tangible item by which notice of asserted method can be given, patentee must mark tangible item to comply with marking statute; reason that marking statute does not apply to method claims is that, ordinarily, where patent claims are directed to only method or process there is nothing to mark, but where patent contains both apparatus and method claims, to extent that there is tangible item to mark by which notice of asserted claims may be given, party is obliged to do so if it intends to avail itself of constructive notice provisions of 35 USCS § 287(a). [Halliburton Servs. v Smith Int'l, Inc. \(2004, ED Tex\) 317 F Supp 2d 719.](#)

4. Time for marking

Unless and until patentee marks patented article or serves actual notice on infringer, he can recover no damages, but 35 USCS § 287 does not require marking or notice within any period after issuance of patent as a condition for recovery of damages for infringement; penalty for failure to do either is limited to denial of damages for infringement prior to compliance with statute. [Wm. Bros. Boiler & Mfg. Co. v Gibson-Stewart Co. \(1963, CA6 Ohio\) 312 F2d 385, 136 USPQ 239;](#) [Bros. Inc. v W. E. Grace Mfg. Co. \(1963, CA5 Tex\) 320 F2d 594, 138 USPQ 357, 7 FR Serv 2d 1143.](#)

Failure to prove time of commencement of marking patent notice on package containing patented foot socks results in denial of damages for infringement prior to commencement of suit. [Wayne-Gossard Corp. v Sondra Mfg. Co. \(1978, CA3 Pa\) 579 F2d 41, 200 USPQ 11.](#)

There is no requirement in 35 USCS § 287 that the patentee begin marking the patent number within any given time after its issue; penalty for failing to mark, and failing in alternative to give actual notice of infringement, is limited to denial of damages for infringement occurring prior to compliance with § 287. [Briggs v M & J Diesel Locomotive Filter Corp. \(1964, ND Ill\) 228 F Supp 26, 141 USPQ 96,](#) affd (1965, CA7 Ill) [342 F2d 573, 144 USPQ 701,](#) cert dismd (1965) [382 US 801, 15 L Ed 2d 55, 86 S Ct 11.](#)

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Successful party in suit involving infringement of DNA probes it licensed from university and distributed to infringer for research purposes can recover damages only after it filed suit, not earlier when it sent defendant letter notifying recipients that patent had issued and that it had exclusive license in technology covered by patent where letter did not warn defendant that it believed patent was being infringed, giving actual notice within meaning of 35 USCS § 287 [Promega Corp. v Lifecodes Corp. \(1999, DC Utah\) 53 USPQ2d 1463](#).

Manufacturers' renewed motion for judgment as matter of law for limitation of damages on ground that patent holder failed to prove that it complied with marking requirement of 35 USCS § 287(a) was denied where patent holder adduced witness testimony about patent holder's patent marking procedures and date it began shipping marked product and manufacturer pointed to no persuasive evidence for its speculation about lag inherent in shipping products from foreign country and depleting unmarked inventory. [Fisher-Price, Inc. v Safety 1st, Inc. \(2003, DC Del\) 279 F Supp 2d 530, 51 UCCRS2d 341](#), injunction gr, stay den (2003, DC Del) [279 F Supp 2d 526](#) and affd in part and mod in part, revd, in part (2004, CA FC) [109 Fed Appx 387](#).

Where, before filing suit, patent holder failed to provide notice of infringement of patent to manufacturer, as required by 35 USCS § 287(a), trial court did not commit clear error in ruling that patent holder was precluded from recovery of pre-suit claims. [Sunbeam Prods. v Wing Shing Prods. \(BVI\) \(2004, SD NY\) 311 BR 378](#).

5. Sufficiency of marking

Marking of patented article in such a way that marks could not have been discovered except by use of magnifying glass, was insufficient. [Trussell Mfg. Co. v Wilson-Jones Co. \(1931, CA2 NY\) 50 F2d 1027](#).

Provisions requiring patented articles to be marked with notice that they were patented required more than registration in Patent Office, and until such time as the manufactured article was marked "patented" there was no actual notice to the public that the article was protected by patent laws. [Steinthal v Arlington Sample Book Co. \(1938, CA3 Pa\) 94 F2d 748](#), cert den (1938) 305 US 613, 83 L Ed 390, 59 S Ct 72.

Licensee under several patents needed to mark only one patent number on specific device since device was covered by only that patent and such marking was in compliance with license agreement. [Casco Products Corp. v Sinko Tool & Mfg. Co. \(1940, CA7 Ill\) 116 F2d 119, 47 USPQ 484](#), cert den (1941) 312 US 693, 85 L Ed 1129, 61 S Ct 713, 48 USPQ 713.

Proper marking of 95 percent of shoes, with efforts to improve marking accuracy and completeness, is adequate notice of patent, so that judgment rejecting marking defense is affirmed. [Maxwell v J. Baker, Inc. \(1996, CA FC\) 86 F3d 1098, 39 USPQ2d 1001](#), reh, en banc, den (1996, CA FC) [1996 US App LEXIS 23200](#) and cert den (1997) 520 US 1115, 137 L Ed 2d 327, 117 S Ct 1244.

Where markings were on crates in which wooden dishes were shipped, rather than upon dishes themselves, there was improper marking. [Smith v Walton \(1892, DC NY\) 51 F 17](#).

Attaching a tag to a patented cherry seeder was not within the term "fixed thereon." [Rollman Mfg. Co. v Universal Hardware Works \(1913, DC Pa\) 207 F 97](#).

Notice of patent was sufficient when stamped upon the wheels manufactured under the patent. [Munger v Perlman Rim Corp. \(1917, DC NY\) 244 F 799](#).

Place of marking on patented article was subject to judgment of manufacturer with limitation that marking had to be done in good faith. [Connecticut Tel. & Electric Co. v Automotive Equipment Co. \(1926, DC NJ\) 14 F2d 957](#), affd (1927, CA3 NJ) 19 F2d 990, cert den (1927) 275 US 564, 72 L Ed 428, 48 S Ct 121.

Marking was an in rem form of notice good against all the world; notice of infringement was individual and had to be brought home in personam against infringer; it was not the number of articles seen by defendant which was

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controlling on an issue of marking, but whether patentee performed his statutory duty; there had to be marking of every patented article sold, subject to implied exception of de minimis, as failure to mark few articles among many; marking 46 per cent, 66 per cent, and 87 per cent of patented articles during various periods was not adequate marking. [*Hazeltine Corp. v Radio Corp. of Am.* \(1937, DC NY\) 20 F Supp 668](#) (criticized in [*Aerogroup Int'l v Marlboro Footworks* \(1997, SD NY\) 1997 US Dist LEXIS 2044](#)).

Notice on cartons that article therein was made under "one or more" of listed patents was not improper where at least one of listed patents was used in manufacture and no competitor was frightened from entering field by notice; this was common practice where multiple patents expiring at different times covered several objects; public was not deceived. *United States v General Electric Co.* (1949, DC NJ) 82 F Supp 753, 80 USPQ 195.

During pendency of patent application, patent owner sold machines marked with plate bearing "Patent Pending"; after patent issued, same plate continued to be used with addition of patent number; this was insufficient marking to satisfy statute. [*Maescher v Reliance Mfg. Co.* \(1956, DC Ind\) 144 F Supp 574, 110 USPQ 113](#).

During period of 8 months after issuance of plaintiff's patent, some cartons containing patented articles bore notation "patent pending" but substantial amount did not bear patent number; thereafter, all cartons bore patent number; defendant was not prejudiced by such failure to mark cartons with patent number since it was aware of existence of patent and its possible infringement before it commenced alleged infringement 3 years later; plaintiff adequately marked articles. [*Duo-Flex Corp. v Builders Service Co.* \(1962, ND Tex\) 207 F Supp 813, 134 USPQ 167](#), affd in part and revd in part on other grounds (1963, CA5 Tex) [*322 F2d 94, 138 USPQ 542*](#).

Marking of patent number on packages for footsocks is insufficient to establish notice for damage purposes, when there is reason to believe that footsocks themselves could have been marked without defacement and no evidence is presented to indicate that this is impractical. [*Wayne-Gossard Corp. v Sondra, Inc.* \(1977, ED Pa\) 434 F Supp 1340, 195 USPQ 777](#), affd (1978, CA3 Pa) [*579 F2d 41, 200 USPQ 11*](#).

Marking patent notice on bulk packages of product preserves right to damages without actual notice to defendant even though unlicensed customer repackaged product in smaller packages and sold without patent notice. [*Analytical Controls v American Hospital Supply Corp.* \(1981, SD Ind\) 518 F Supp 896, 217 USPQ 1004](#).

Conveyor products having patent numbers marked on sprockets, marked on instructions placed in shipping box and called to attention of defendant, are adequately marked and notified to defendant, who is otherwise known to be aware of patents, so that damages apply to commencement of infringement. [*Rexnord, Inc. v Laitram Corp.* \(1988, ED Wis\) 6 USPQ2d 1817](#).

Marking of patent number on package containing product is adequate when marking of product itself would cause additional manufacturing burden, so that marking on package for product entitles patentee to discovery of early sales of infringer. [*Rutherford v Trim-Tex, Inc.* \(1992, ND Ill\) 803 F Supp 158, 25 USPQ2d 1866](#).

Failure of patentee to mark patent number on product or packaging results in summary judgment against damages before date of actually notifying defendant of infringement. [*Calmar Inc. v Emson Research* \(1994, CD Cal\) 31 USPQ2d 1833](#).

Because patentee satisfied requirements of 35 USCS § 287 by providing appropriate patent markings on all bags of its patented soybean and cotton seed, alleged infringer's defense of lack of proper notice of patents-in-suit failed. [*Monsanto Co. v Scruggs* \(2004, ND Miss\) 342 F Supp 2d 584](#).

Summary judgment was denied on patent holder's failure to mark or provide notice of infringement where letter that it sent to competitor, alleging that one of competitor's catalytic converters infringed patent, and indicating that other products that were manufactured by competitor may have infringed, was sufficient notice that remaining accused products infringed patents in suit. [*Tenneco Auto. Operating Co. v Visteon Corp.* \(2005, DC Del\) 375 F Supp 2d 360](#).

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Manufacturer was entitled to summary judgment as to its 35 USCS § 292 mismarking claims on patent that was used to mark patentee's wall patch products where it was undisputed that patent was expired; although 35 USCS § 287 did not require that expiration dates be included with patent markings, patentee's use of expired patent raised inference of intent to deceive, and patentee failed to rebut that inference. *DP Wagner Mfg. Inc. v Pro Patch Sys.* (2006, SD Tex) 434 F Supp 2d 445.

Genuine issues of material fact exists as to whether patent owner who owned two patents describing universal forms engine designed to provide more efficient way for third-party forms servicer to process on-line forms such as college applications gave reasonable public notice by marking its computer servers; accordingly, its competitor's motion for summary judgment as to patent owner's accrual of damages was denied. [*Collegenet, Inc. v Xap Corp.* \(2006, DC Or\) 442 F Supp 2d 1036.](#)

Certain emails raised question with respect to actual notice--whether or not identification of G723 standard relative to defendant's software was sufficient, without more, to provide defendant with actual notice; rather than identify particular product, emails only stated that plaintiff had asserted certain patents against G.723 standard in relation to defendant's software products. [*Lucent Techs. Inc. v Gateway, Inc.* \(2007, SD Cal\) 470 F Supp 2d 1180,](#) summary judgment gr, summary judgment den, motions ruled upon (2007, SD Cal) [470 F Supp 2d 1187.](#)

Summary judgment was inappropriate regarding issue as to whether inventor of type of dice complied with primary marking scheme of 35 USCS § 287(a) because important factors were either disputed or not yet ascertained; these factors included, but were not limited to, relative size of dice, processes required to affix statutory label upon dice, costs associated with these processes, appearance of dice with statutory label, and industry practices. [*Bowling v Hasbro, Inc.* \(2007, DC RI\) 490 F Supp 2d 262.](#)

Patentee proved that its patent for two-piece plunger lift system for use in natural gas wells to remove accumulated liquids and thereby increase gas flow through well to surface was directly and contributorily infringed under 35 USCS § 271(a), (c), because judge sitting as fact finder found that competitor's principal had copied product's design, even though product was adequately marked under 35 USCS § 287(a) so as to supply infringer with notice. [*MGM Well Servs. v Mega Lift Sys., LLC* \(2007, SD Tex\) 505 F Supp 2d 359.](#)

Based on preponderance of evidence standard, jury found that patentee had "continuously marked substantially all of his dice, or if not practical, packaging of dice, with his patent number from August 17, 1999, through November 10, 1999"; without evaluating credibility of witnesses or weighing evidence, and drawing all reasonable inferences in his favor, evidence presented at trial sufficiently supported verdict to preclude granting alleged infringer's renewed Fed. R. Civ. P. 50 motion. [*Bowling v Hasbro, Inc.* \(2008, DC RI\) 582 F Supp 2d 192.](#)

Because marking outer packaging, when marking product could be done, was insufficient for notice requirements of 35 USCS § 287(a), actions of defendants were equally insufficient for false marking liability under penal statute, 35 USCS § 292(a). [*Rainworks Ltd. v Mill-Rose Co.* \(2009, ND Ohio\) 609 F Supp 2d 732.](#)

Considering undisputed evidence of marking in light most favorable to patentee, there was clear and substantial evidence sufficient to support jury's verdict of marking under 35 USCS § 287(a). [*Lighting Ballast Control, LLC v Philips Elecs. N. Am. Corp.* \(2011, ND Tex\) 814 F Supp 2d 665,](#) app dismd, motion gr (2012, CA FC) [2012 US App LEXIS 5808](#) and revd on other grounds (2013, CA FC) [498 Fed Appx 986,](#) vacated, reh, en banc, gr (2013, CA FC) [500 Fed Appx 951.](#)

In patent infringement action, defendants' motion for judgment as matter of law on damages was denied because substantial evidence supported jury's conclusion that plaintiff complied with marking statute of 35 USCS § 287; evidence of product as prior art system to '011 patent provided substantial evidence that product was not covered by '011 patent, but was actually prior art to '011 patent. [*SSL Servs., LLC v Citrix Sys.* \(2013, ED Tex\) 940 F Supp 2d 480.](#)

6. Failure to mark

Fact that patentee failed to mark his patented articles did not preclude a decree in his favor for accounting for infringement committed after notice given to defendant by complaint filed in the suit. [Maimen v Union Special Mach. Co. \(1908, CA3 Pa\) 165 F 440.](#)

Where plaintiff failed to mark its patented article, it had to be denied all right to recover damages, unless it could have proved that "defendant was duly notified of the infringement and continued after such notice to make use or vend the article so patented." [American Caramel Co. v White \(1915, CA7 Ill\) 234 F 328](#); [Ford Motor Co. v K. W. Ignition Co. \(1921, CA7 Ind\) 278 F 373](#), cert den (1922) 257 US 658, 66 L Ed 421, 42 S Ct 185.

Presence of method claims in patent having product claims covering product sold for period of time after patent issuance without being marked with patent number does not absolve patent owner from marking requirements, so that damages for infringement are recoverable from date that patent marking became effective. [American Medical Sys. v Medical Eng'g Corp. \(1993, CA FC\) 6 F3d 1523, 28 USPQ2d 1321](#), reh, en banc, den (1993, CA FC) [1993 US App LEXIS 32603](#) and cert den (1994) 511 US 1070, 128 L Ed 2d 366, 114 S Ct 1647.

Typographical error in sticker affixed to patented concrete riding trowel did not result in failure to mark under 35 USCS § 287(a) because error involved only misplaced semicolon, and parties sufficiently interested in patents would have had no difficulty discerning actual patent number. [Allen Eng'g Corp. v Bartell Indus. \(2002, CA FC\) 299 F3d 1336, 63 USPQ2d 1769](#) (criticized in [BorgWarner, Inc. v New Venture Gear, Inc. \(2002, ND Ill\) 237 F Supp 2d 919](#)).

Patentee failed to rebut presumption of surrender that arose from its narrowing of its claims by amendment during prosecution history of its patents to control airflow surge in auxiliary power units. Its claims for infringement were thus barred under doctrine of equivalents; patentee also failed to mark its invention. [Honeywell Int'l, Inc. v Hamilton Sundstrand Corp. \(2008, CA FC\) 523 F3d 1304.](#)

District court erred when it dismissed patentee's counterclaim for infringement of U.S. Patent No. 4,774,839 ('839 patent) for failure to mark under 35 USCS § 287(a); although '839 patent also included unasserted apparatus claims, because patentee asserted only method claims of '839 patent, marking requirement of 35 USCS § 287(a) did not apply. [Crown Packaging Tech., Inc. v Rexam Bev. Can Co. \(2009, CA FC\) 559 F3d 1308, 90 USPQ2d 1186.](#)

In patent infringement case, district court did not err in denying defendants' motion for judgment as matter of law on pre-suit damages for one patent due to plaintiff's failure to mark its products under 35 USCS § 287(a) because patent at issue involved nothing but method claims and patents with only method claims do not require marking whereas patents with apparatus claims do; court declined to extend marking requirement to patents with nothing but method claims, if patentee also asserted other patents with apparatus claims embodying same invention in same litigation. [ActiveVideo Networks, Inc. v Verizon Communs., Inc. \(2012, CA FC\) 694 F3d 1312, 104 USPQ2d 1241.](#)

District court did not commit error on its grant of judgment of infringement as matter of law under Fed. R. Civ. P. 50(a), where its clarified claim construction was supported in intrinsic record, patent claims were not obvious under 35 USCS § 103(a), and damages accrued from notice of infringement, under 35 USCS § 287(a). [K-Tec, Inc. v Vita-Mix Corp. \(2012, CA FC\) 696 F3d 1364, 104 USPQ2d 1408.](#)

Owner of patent and exclusive licensee were excluded from right to have accounting when devices made were not marked, although when patent was not exploited, accounting could have been had in absence of marking. [Hazeltime Corp. v Radio Corp. of Am. \(1937, DC NY\) 20 F Supp 668](#) (criticized in [Aerogroup Int'l v Marlboro Footworks \(1997, SD NY\) 1997 US Dist LEXIS 2044](#)).

Only penalty for failing to mark articles patented was that no recovery could have been had for infringement of any patent not marked. [Zenith Radio Corp. v Radio Corp. \(1948, DC Del\) 78 F Supp 591, 78 USPQ 186.](#)

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Under 35 USCS § 287, notice may be given by marking product with patent number or by giving direct notice of infringement to alleged infringer; although patentee should comply with statute or be foreclosed from exacting tribute from infringers, there is nothing in statute which thus penalizes him for failure to mark patent within any specific or reasonable time after its issue; unless and until patentee marks patent or serves actual notice upon alleged infringer, he can recover no damages; there is nothing in statute requiring marking or notice as a condition for recovery of damages; penalty for failure to do either is limited to denial of damages for infringement at any time prior to compliance with statute. [Wm. Bros. Boiler & Mfg. Co. v Gibson-Stewart Co. \(1961, ND Ohio\) 202 F Supp 6, 132 USPQ 268](#), mod on other grounds (1963, CA6 Ohio) [312 F2d 385, 136 USPQ 239](#).

Failure to mark patented bag closure device with patent number even though other identification was marked on device is noncompliance with 35 USCS § 287 and precludes recovery of damages until actual notice of infringement occurs. [John L. Rie, Inc. v Shelly Bros., Inc. \(1973, ED Pa\) 366 F Supp 84, 181 USPQ 157](#).

Although there is inclusive evidence that infringer knew of plaintiff's patent before provable date of actual notice, failure to mark patent number on plaintiff's product results in damages assessed only back to date of clearly provable notice. [Milgo Electronic Corp. v United Telecommunications, Inc. \(1978, DC Kan\) 200 USPQ 481](#).

Failure of patentee to mark patent number on pumps sold in commerce and failure to notify defendant of infringement before commencing action, when notice could easily have been given, limits damages to commencement of suit. [Ellipse Corp. v Ford Motor Co. \(1978, ND Ill\) 461 F Supp 1354, 201 USPQ 455](#), affd without op (1979, CA7 Ill) [614 F2d 775](#), cert den (1980) [446 US 939, 64 L Ed 2d 792, 100 S Ct 2160, 206 USPQ 288](#).

Lack of patent marking on any yarns made under the patent by licensees of patentee and lack of any actual notice to defendants before patent in suit expired bars action for damages which is summarily dismissed. [In re Yarn Processing Patent Validity Litigation \(1984, WD NC\) 602 F Supp 159, 225 USPQ 765](#).

Failure by patent owner to mark patent number on component and failure of assemblers to mark patent number on patented assembly using component results in no damages before actual notice. [Amsted Indus. v Buckeye Steel Castings Co. \(1993, ND Ill\) 28 USPQ2d 1352](#), affd in part and vacated in part, remanded (1994, CA FC) [24 F3d 178, 30 USPQ2d 1462](#).

Fact that patentee did not make claimed combination of patent, but only made part of combination, does not excuse patentee or its customers from marking requirements of 35 USCS § 287, so that damages are properly calculated from date of letter notifying infringer. [Amsted Indus. v Buckeye Steel Castings Co. \(1993, ND Ill\) 28 USPQ2d 1352](#), affd in part and vacated in part, remanded (1994, CA FC) [24 F3d 178, 30 USPQ2d 1462](#), costs/fees proceeding, remanded (1994, CA FC) [23 F3d 374, 30 USPQ2d 1470](#) and reh, en banc, den (1994, CA FC) [1994 US App LEXIS 14623](#).

Lack of product for patentee to mark relieves patentee of marking requirement, and motion to limit damages to time of actual notice of patent is denied. [Medical Graphics Corp. v SensorMedics Corp. \(1995, DC Minn\) 36 USPQ2d 1275](#).

Patent owner was entitled to summary judgment on computer manufacturer's claim that patent licensee's purchase and resale, without use of patent mark, of manufacturer's allegedly infringing products, limited owner's damages for infringement pursuant to 35 USCS § 287(a); licensee's actions did not fall within scope of license agreement and could not be imputed to owner. [Tulip Computers Int'l B.V. v Dell Computer Corp. \(2003, DC Del\) 262 F Supp 2d 358](#).

Although patentee raised disputed fact issue as to its compliance with 35 USCS § 287(a) in marking its software, it failed to present evidence that its licensees complied with marking law or that licensees marked their websites so as to establish constructive notice to Internet vendor of its alleged infringement, making summary judgment

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appropriate as to those issues in patentee's infringement action. [Soverain Software LLC v Amazon.com, Inc. \(2005, ED Tex\) 383 F Supp 2d 904.](#)

In patent infringement suit, patentee was not entitled to pre-filing damages because it failed to mark any of patented products with numbers of patents and, thus, it failed to comply with 35 USCS § 287(a). [CIVIX-DDI, LLC v Cellco P'ship \(2005, ND Ill\) 387 F Supp 2d 869.](#)

Motion for summary judgment was granted in patent infringement case on issue of limiting damages because internal combustion engine was not marked; therefore, damages were limited to those accruing after notice of possible infringement was given. [Briggs & Stratton Corp. v Kohler Co. \(2005, WD Wis\) 398 F Supp 2d 925,](#) reinstated, in part, motion gr, patent interpreted (2006, WD Wis) [2006 US Dist LEXIS 353.](#)

Defendant's motion seeking summary judgment pursuant to 35 USCS § 287(a), limiting plaintiff's damages in patent infringement action for failure to properly mark its products was granted; even assuming that law excused failure to mark in cases where government prohibited marking, plaintiff's mere reference to certain military regulations did not create issue of fact sufficient to defeat summary judgment because despite plaintiff's general reference to standards, it failed to point to any particular provision prohibiting marking of goods in accord with § 287(a). [Erie Engineered Prods. v Wayne Integrated Techs., Corp. \(2005, ED NY\) 402 F Supp 2d 424.](#)

Patentee was not entitled to reconsideration of ruling that patentee's potential damages in infringement suit were limited because of patentee's failure to comply with marking requirements of 35 USCS § 287(a); court did not construe "use" of patented article as triggering event under § 287(a), although patentee was incorrect in asserting that use was never employed in determining whether there was obligation to mark; also, patentee's argument that no duty to mark existed when patent contained only system and not method claims lacked merit, and patentee's system included wall jack that could have been marked. [Inline Connection Corp. v AOL Time Warner \(2007, DC Del\) 465 F Supp 2d 312.](#)

In patent infringement case, patentee was not entitled to summary judgment on competitor's claimed marking defense under 35 USCS § 287 because court could not find as matter of law that patentee's licensees marked any potentially relevant products in compliance with marking statute. [Cordance Corp. v Amazon \(2009, DC Del\) 631 F Supp 2d 484,](#) motion to strike den, as moot (2009, DC Del) [631 F Supp 2d 477,](#) summary judgment gr, in part, summary judgment den, in part,, summary judgment den, motion den, as moot (2009, DC Del) [639 F Supp 2d 406.](#)

Manufacturer was denied summary judgment on its claim that patent holder failed to mark its products where there was conflicting evidence as to whether products were too small to be marked themselves and whether packaging of substantially all of patented products were marked. [Halo Elecs., Inc. v Pulse Eng'g, Inc. \(2011, DC Nev\) 810 F Supp 2d 1173.](#)

Judgment based on jury verdict of no damages for failure to mark product with patent number or notify defendants of existence of patent is proper and affirmed for defendants who promptly stopped buying products from unlicensed sources, when notified. [Devices for Medicine, Inc. v Boehl \(1987, CA\) 822 F2d 1062, 3 USPQ2d 1288.](#)

It was no excuse that the stamping or marking would have been expensive, and would have enhanced price of the article. [Putnam v Sudhoff \(1874, CCED Mo\) 1 Ban & A 198, 20 F Cas 88,](#) No 11483.

Unpublished Opinions

Unpublished: Question of whether patent owner was obligated to mark clevis links under 35 USCS § 287(a) depended entirely on whether it had authorized alleged infringers' customer to produce clevis links (i.e., whether customer had express or implied license); if customer was authorized, there was no need to address notice issue, as express or implied license was defense to infringement; because court held that customer had Have Made license, its suppliers, including alleged infringers, could not be sued for infringement with respect to any accused products made for customer. [Radar Indus., Inc. v Cleveland Die & Mfg. Co. \(2011, CA FC\) 2011 US App LEXIS 6639.](#)

7. Intent

In furtherance of policy to keep patent from scrutiny of courts as long as possible, patentee deliberately failed to give infringer notice of infringement as required by 35 USCS § 287; giving of actual notice was not excused; hence, infringer is not liable for period prior to commencement of infringement action. [Union Carbide Corp. v Graver Tank & Mfg. Co. \(1960, CA7 Ind\) 282 F2d 653, 127 USPQ 3](#), cert den (1961) 365 US 812, 5 L Ed 2d 691, 81 S Ct 692, 128 USPQ 557 and cert den (1961) 365 US 812, 5 L Ed 2d 691, 81 S Ct 695, 128 USPQ 557.

District court correctly interpreted *MedImmune, Inc. v. Genentech, Inc.*, when it concluded that subject matter jurisdiction was lacking where generic manufacturer's supplemental complaint against patent holder failed to establish case or controversy under U.S. Const. art. III or Declaratory Judgment Act, 28 USCS § 2201. Marking product under 35 USCS § 287 was insufficient to raise case or controversy of infringement. [Prasco, LLC v Medicis Pharm. Corp. \(2008, CA FC\) 537 F3d 1329, 87 USPQ2d 1675](#).

Where holder of expired patent marked its products that they "may be covered" by patent, holder was properly granted summary judgment on qui tam false marking claim brought under 35 USCS §§ 287(a) and 292, because it successfully rebutted presumption that it had intent to deceive public. [Pequignot v Solo Cup Co. \(2010, CA FC\) 608 F3d 1356](#).

Where a manufacturer of contact lenses does nothing to assure that the contact lenses or the containers of such lenses which are delivered to users are marked with the patent number for the lenses, the manufacturer has not met the marking requirement of 35 USCS § 287. [Butterfield v Oculus Contact Lens Co. \(1971, ND Ill\) 332 F Supp 750, 171 USPQ 527](#), affd (1973, CA7) 177 USPQ 33.

Marking of many irrelevant patent numbers on patented product is considered along with other misconduct in finding consistent course of fraud making patent unenforceable. [Hart-Carter Co. v J.P. Burroughs & Son, Inc. \(1985, ED Mich\) 605 F Supp 1327, 225 USPQ 285](#).

III. ACTUAL NOTICE

8. Generally

By predecessor to 35 USCS § 287, patentee or his assignees, if he makes or sells article patented, cannot recover damages against infringers of patent, unless he has given notice of his right, either to whole public by marking his article "patented," or to particular defendants by informing them on his patent and of their infringement of it. [Dunlap v Schofield \(1894\) 152 US 244, 38 L Ed 426, 14 S Ct 576](#) (superseded by statute as stated in [Maxwell v J. Baker, Inc. \(1992, DC Minn\) 805 F Supp 728, 26 USPQ2d 1241](#)).

Before patentee may be held liable under 15 USCS § 1125(a) for marketplace activity in support of its patent, and thus be deprived of right to make statements about potential infringement of its patent, marketplace activity must have been undertaken in bad faith. [Zenith Elecs. Corp. v Exzec, Inc. \(1999, CA FC\) 182 F3d 1340, 51 USPQ2d 1337, 1999 CCH Trade Cases P 72571](#).

Actual notice requirement of 35 USCS § 287(a) demands notice of patentee's identity as well as notice of infringement. [Lans v Digital Equip. Corp. \(2001, CA FC\) 252 F3d 1320, 59 USPQ2d 1057](#), reh den, reh, en banc, den (2001, CA FC) [2001 US App LEXIS 17244](#).

Requirement of actual notice is designed to assure that accused infringer knew of adverse patent and alleged infringement during period in which its liability accrues. [Gart v Logitech, Inc. \(2001, CA FC\) 254 F3d 1334, 59](#)

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[USPQ2d 1290](#), reh, en banc, den (2001, CA FC) [2001 US App LEXIS 21100](#) and cert den (2002) 534 US 1114, 151 L Ed 2d 886, 122 S Ct 921 and summary judgment den, patent interpreted (2003, CD Cal) [254 F Supp 2d 1119, 67 USPQ2d 1263](#).

Knowledge of patent cannot be imputed to defendant from knowing about developments in industry, advertisements by plaintiff's licensee in trade journals, other litigation under patent by plaintiff or other circumstantial evidence so that absence of actual notice and patent marking requires dismissal of suit for infringement of expired patent when actual notice was first given defendant after expiration of patent. [Lemelson v Fisher Price Corp. \(1982, SD NY\) 545 F Supp 973, 218 USPQ 504](#).

Notice of infringement through telecommunications company press releases and general statements to telecommunications union, as well as from software company's competitors and licensors, and its own employees, was insufficient under [28 USCS § 287](#) and software company's motion for partial summary judgment on damages was granted. [AT&T Corp. v Microsoft Corp. \(2003, SD NY\) 290 F Supp 2d 409](#).

9. Sufficiency

Letter announcing ownership of patent and general intention of enforcing patent fails to give notice of infringement to defendant, even though defendant knew of patent, so that damages run from date of later letter giving proper notice of infringement. [In re Schrader \(1994, CA FC\) 22 F3d 290, 30 USPQ2d 1455](#), reh den (1994, CA FC) [1994 US App LEXIS 10544](#).

Letters notifying infringer of patent and products covered by patent, and offering license under patent give adequate notice even though infringement action is not threatened. [SRI Int'l v Advanced Tech. Lab. \(1997, CA FC\) 127 F3d 1462, 44 USPQ2d 1422](#).

Actual notice requirement of 35 USCS § 287(a) demands notice of patentee's identity as well as notice of infringement. [Lans v Digital Equip. Corp. \(2001, CA FC\) 252 F3d 1320, 59 USPQ2d 1057](#), reh den, reh, en banc, den (2001, CA FC) [2001 US App LEXIS 17244](#).

As long as communication from patentee provides sufficient specificity regarding its belief that recipient may be infringer, statutory requirement of actual notice is met; thus, patentee need not make unqualified charge of infringement. [Gart v Logitech, Inc. \(2001, CA FC\) 254 F3d 1334, 59 USPQ2d 1290](#), reh, en banc, den (2001, CA FC) [2001 US App LEXIS 21100](#) and cert den (2002) 534 US 1114, 151 L Ed 2d 886, 122 S Ct 921 and summary judgment den, patent interpreted (2003, CD Cal) [254 F Supp 2d 1119, 67 USPQ2d 1263](#).

Though U.S. district court properly granted partial summary judgment to alleged infringer of patent for high-pressure mercury vapor discharge lamp filled with gaseous mixture on patentee's suit to extent that infringement claim was based on independent claim 1, it was error to rule that period of time for which patentee would be entitled to damages for infringement, if proven, was limited to period beginning on date on which suit was filed because letter sent by patent portfolio manager for patentee's licensee satisfied criteria in 35 USCS § 287(a) that affirmative communication of specific charge of infringement by specific accused product or device be afforded to alleged infringer. [U.S. Philips Corp. v Iwasaki Elec. Co. \(2007, CA FC\) 505 F3d 1371](#).

Jury instructions on actual notice failed to apprise jury of proper legal standard under 35 USCS § 287(a) where they did not clearly articulate that, in context of ongoing relationship between parties, knowledge of specific infringing device was not legal prerequisite to finding that exchanges constituted actual notice. [Minks v Polaris Indus. \(2008, CA FC\) 546 F3d 1364](#).

District court did not err when it found that farmer infringed U.S. Patent Nos. 5,352,605 and RE39,247E when he planted soybean seeds that were not purchased from company that held both patents or one of its licensees; although patent holder allowed growers to sell second-generation seeds to local grain elevators as commodity

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without requiring growers to place restrictions on grain elevators' subsequent sales of seeds, once farmer planted commodity seeds that contained patent holder's technology and next generation of seeds developed, he created newly infringing article; there was also no merit to farmer's argument that patent holder could not recover damages because it did not provide actual notice and did not mark or require growers to mark second-generation seeds in compliance with 35 USCS § 287(a). [Monsanto Co. v Bowman \(2011, CA FC\) 657 F3d 1341, 100 USPQ2d 1224, 41 ELR 20297.](#)

Notice of infringement of parachutes given to United States air service was sufficient; and failure to mark goods not in physical existence did not defeat recovery. [Van Meter v United States \(1930, DC NY\) 37 F2d 111](#), mod (1931, CA2 NY) [47 F2d 192](#) (criticized in [Aerogroup Int'l v Marlboro Footworks \(1997, SD NY\) 1997 US Dist LEXIS 2044](#)).

Oral conversations between officers of plaintiff and defendant corporations did not constitute notice. [Hazeltine Corp. v Radio Corp. of America \(1932, DC NY\) 1 F Supp 758.](#)

Constructive notice is not established where only one manufacturer, among many, marked its devices. [Miller v Daybrook-Ottawa Corp. \(1968, ND Ohio\) 291 F Supp 896, 158 USPQ 635.](#)

The fact that an alleged infringer saw a trade brochure advertising the patentee's device and mentioning the patent is not adequate notice of infringement within meaning of 35 USCS § 287. [Briggs v Wix Corp. \(1969, ND Ill\) 308 F Supp 162, 163 USPQ 283.](#)

In a suit for patent infringement, where plaintiff has mailed letters which clearly identify the patent as well as indicating the plaintiff's belief that the addressee is infringing the patent, the plaintiff has met the requirement of notice of infringement under 35 USCS § 287 as to those defendants receiving the letters. [Butterfield v Oculus Contact Lens Co. \(1971, ND Ill\) 332 F Supp 750, 171 USPQ 527](#), affd (1973, CA7) [177 USPQ 33](#).

Trade journal advertisement of patent rights more than 6 years before suit fails as actual notice to defendants, and lack of patent marking on yarns made under patent by licensees results in no notice of infringement to defendants before expiration of patent so that suit for damages is summarily dismissed. [In re Yarn Processing Patent Validity Litigation \(1984, WD NC\) 602 F Supp 159, 225 USPQ 765.](#)

Settlement of previous dispute does not constitute notice of patent infringement, but later letter indicating patent number does constitute notice, so that summary judgment against collection of damages before date of letter is granted. [Konstant Prods., Inc. v Frazier Indus. Co. \(1992, ND Ill\) 25 USPQ2d 1223.](#)

Failure to notify defendant that cash drawers infringe more recent patent than patents marked on plaintiff's cash drawers results in granting of partial summary judgment barring damages prior to 6 years before filing of suit. [M-S Cash Drawer Corp. v Block & Co. \(1992, CD Cal\) 26 USPQ2d 1472.](#)

Since material issue of fact exists as to whether or not plaintiff's letter to defendant contains words "U.S. Patent enclosed" provided actual notice of design patent infringement, court denies defendant's motion for summary judgment on patent infringement claim in part. [Bazz, Inc. v Catalina Lighting, Inc. \(1998, SD Fla\) 49 USPQ2d 2009.](#)

Company was granted partial summary judgment in patent infringement action on claim that patentee did not adequately "mark" its patented seed corn, where there were genuine issues of fact as to whether patentee marked bags beginning with 1996 sales season, but bag tags before 1996 did not reference any patent, activity of specific defendant believed by patentee to be infringement, threaten suit, or otherwise propose means of abatement; therefore, limited label license of earlier bags did not provide actual notice required by "marking" statute, 35 USCS § 287(a), even if it unambiguously notified buyer that buyer was licensed only to produce grain or forage, not to resell seed corn. [Pioneer Hi-Bred Int'l, Inc. v Ottawa Plant Food, Inc. \(2003, ND Iowa\) 283 F Supp 2d 1018, 51 UCCRS2d 659](#), motions ruled upon (2003, ND Iowa) [219 FRD 135](#).

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Under marking statute, party is entitled to damages from time when it either began marking its products in compliance with statute or when it actually notifies infringer of its infringement, whichever is earlier, and patentee bears burden of proving compliance by preponderance of evidence; in determining whether patentee has marked its products sufficiently to comply with constructive notice requirement, focus is not on what infringer actually knew but on whether patentee's actions are sufficient to provide notice in rem. [Halliburton Servs. v Smith Int'l, Inc. \(2004, ED Tex\) 317 F Supp 2d 719.](#)

Patentee's damages for infringement were limited to those occurring after complaint was filed because adequate notice of previous infringement was not given under 35 USCS § 287(a); act of pleading inducement and equitable estoppel was insufficient. [Tech. Licensing Corp. v Thomson, Inc. \(2005, ED Cal\) 76 USPQ2d 1146.](#)

Patent holder's infringement damages were limited pursuant to 35 USCS § 287(a) where holder did not mark DRAM chips with numbers of patents in suit and where holder specifically accused only three of seller's products of infringement before filing suit; holder could seek damages for any asserted infringement of methods-only patent, which was not subject to § 287(a). [MOSAID Techs. Inc. v Samsung Elecs. Co. \(2005, DC NJ\) 362 F Supp 2d 526.](#)

Internet vendor was entitled to partial summary judgment as to marking under 11 USCS § 287(a) where patentee failed to offer any evidence that raised material fact question as to whether vendor was on actual notice of its alleged infringement prior to filing of infringement action; patentee showed that vendor and predecessor met to discuss possible licensing agreement, but without more, such meeting did not raise issue as to indicate notice of infringement. [Soverain Software LLC v Amazon.com, Inc. \(2005, ED Tex\) 383 F Supp 2d 904.](#)

In patent infringement suit, patentee was not entitled to pre-filing damages because it failed to provide defendants with actual notice of infringing conduct as required by 35 USCS § 287(a); letter from patentee to defendants' predecessor did not identify any of patent in suit, which had not yet been issued, and, thus, letter did not constitute actual notice. [CIVIX-DDI, LLC v Cellco P'ship \(2005, ND Ill\) 387 F Supp 2d 869.](#)

Defendant's motion seeking summary judgment pursuant to 35 USCS § 287(a), limiting plaintiff's damages in patent infringement action for failure to properly mark its products was granted because there was no question that product at issue was not actually marked as patented until approximately June 2003, and plaintiff's reliance on defendant's general knowledge of patent's existence, even if true, was insufficient to constitute marking that would trigger running of damages for infringement; correct approach to determining notice had to focus on action of patentee, not knowledge or understanding of infringer. [Erie Engineered Prods. v Wayne Integrated Techs., Corp. \(2005, ED NY\) 402 F Supp 2d 424.](#)

In action in which plaintiff patent holders filed suit against defendant alleged infringers alleging infringement under 35 USCS § 271 of plaintiffs' patents, since defendant failed to provide constructive notice, and provided actual notice only after expiration of patent, no damages were recoverable under defendant's counterclaim *I. Crown Packaging Tech., Inc. v Rexam Bev. Can Co. (2007, DC Del) 498 F Supp 2d 734.*

In action in which plaintiff patents holder filed suit against defendant alleged infringers alleging infringement under 35 USCS § 271 of plaintiffs' patents, regarding '385 and '242 patents, there was genuine issue of material fact as to whether defendant knew or should have known that plaintiffs were infringing its bottom forming patents; defendant had duty to police its bottom forming patents and satisfied that duty by engaging another company in licensing discussions in 1995 and 1996. [Crown Packaging Tech., Inc. v Rexam Bev. Can Co. \(2007, DC Del\) 498 F Supp 2d 734.](#)

Patentee complied with notice requirements of 35 USCS § 287(a) because patentee provided importers with actual notice of infringement by affirmatively communicating to importers at trade show that importers' sale of replicas of patentee's patented pipe was infringement of patentee's patent; that importers denied that patentee ever showed them copy of patent was irrelevant to determining whether patentee satisfied notice requirement. [Lee v Accessories By Peak \(2010, WD NY\) 705 F Supp 2d 249.](#)

Since patent holder made conscious choice not to bring suit in timely fashion, it could not at present rely on uncorroborated conversation as its sole source of actual notice; having failed to provide constructive or actual notice to alleged infringer prior to commencement of district court action, patent holder was precluded from recovery of pre-suit claims. [*Sunbeam Prods. v Wing Shing Prods. \(BVI\) Ltd. \(AI Realty Mktg. of N.Y., Inc.\) \(2003, BC SD NY\) 293 BR 586*](#), affd in part and revd in part (2004, SD NY) [*311 BR 378*](#).

Oral notice of patent could have been given. [*New York Pharmaceutical Asso. v Tilden \(1882, CCD NY\) 21 Blatchf 190, 14 F 740*](#).

Infringement period that required compensation ran from when defendants began selling accused candle through last date of sales figures where patent holder's e-mail was sufficient to put defendants on actual notice of patent infringement. [*Ball Aerosol & Specialty Container, Inc. v Limited Brands, Inc. \(2007, ND Ill\) 514 F Supp 2d 1051*](#).

Unpublished Opinions

Unpublished: In patent infringement case, jury's finding that patentee complied with marking statute was upheld because there was substantial evidence for jury to find that patentee substantially complied by marking packaging. [*Global Traffic Techs., LLC v Morgan \(2015, CA FC\) 620 Fed Appx 895*](#), cert den (2016, US) *136 S Ct 824, 193 L Ed 2d 718* and cert den (2016, US) [*2016 US LEXIS 1420*](#).

Unpublished: In patent infringement case, jury's finding that patentee complied with marking statute was upheld because there was substantial evidence for jury to find that patentee substantially complied by marking packaging. [*Global Traffic Techs., LLC v Morgan \(2015, CA FC\) 620 Fed Appx 895*](#), cert den (2016, US) *136 S Ct 824, 193 L Ed 2d 718* and cert den (2016, US) *84 USLW 3475*.

10. Persons notified

Notice to individual infringer could have been sufficient as notice to corporation subsequently formed by him to exploit infringing machine. [*Wright Co. v Herring-Curtiss Co. \(1914, CA2 NY\) 211 F 654*](#).

Where city was party to suit for infringement of patent, notice of infringement served on city's sewage commission was valid notice of such to said city by virtue of its interest and provisions of local statute. [*Milwaukee v Activated Sludge, Inc. \(1934, CA7 Wis\) 69 F2d 577*](#), cert den (1934) *293 US 576, 79 L Ed 673, 55 S Ct 87*.

District court did not err when it denied manufacturer's request for preliminary injunction prohibiting patentee from sending letters to manufacturer's customers which suggested that product manufacturer sold infringed U.S. Patent No. 7,182,120; the court did not rely on erroneous legal or factual premises when it concluded that manufacturer failed to show likelihood of success on merits of its claims that '120 patent was unenforceable and that patentee violated § 43(a) of Lanham Act, *15 USCS § 1125(a)*, when he sent letters. [*Judkins v HT Window Fashion Corp. \(2008, CA FC\) 529 F3d 1334, 86 USPQ2d 1352*](#).

Notice of infringement prior to commencement of infringement suit was given to individual defendants but not to corporate defendant which succeeded to business of individuals; parties stipulated that admitted receipt of notice by individual defendants should have been deemed notice to corporate defendant. [*Rowley v Tresenberg \(1941, DC NY\) 37 F Supp 90, 48 USPQ 360*](#), affd (1941, CA2 NY) [*123 F2d 844, 51 USPQ 401*](#).

Notice of infringement was sufficient where given orally and in writing to individual, not particularly as representative of particular company, but as representative of whichever of companies controlled by him was making product complained of, even though company was not mentioned or identified by name. [*Adorjan Newman & Co. v Richelieu Corp. \(1948, DC NY\) 81 F Supp 763, 79 USPQ 34*](#).

During negotiations between parties, defendant's house patent counsel acknowledged that defendant was piling up liabilities to plaintiff by its indecision whether to become licensee under patent; coming from trained patent counsel,

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who must have known that notice is necessary for accruing of damages for infringement, this was admission of receipt of such notice; it is significant that, although counsel was still in defendant's employ, defendant failed to call him to testify. [International Nickel Co. v Ford Motor Co. \(1958, DC NY\) 166 F Supp 551, 119 USPQ 72.](#)

Reasons for allowing recovery for infringement without statutory forms of notice are not present even though defendant's employee was aware of existence of patent since he was not required to presume from his knowledge that patentee was demanding relief from his actions, especially since patentee had actual notice of infringement and failed to do anything about it. [Miller v Daybrook-Ottawa Corp. \(1968, ND Ohio\) 291 F Supp 896, 158 USPQ 635.](#)

Patent making provision of 35 USCS § 287 is not defense available to government under [28 USCS § 1498](#) for using patent rights. [Motorola, Inc. v United States \(1984, CA\) 729 F2d 765, 221 USPQ 297, 31 CCF P 72229.](#)

11. Actual knowledge of infringer

Notification was unnecessary where infringer had knowledge of acts. [American Ornamental Bottle Corp. v Orange-Crush Co. \(1935, CA4 Va\) 76 F2d 969.](#)

Defendant's general knowledge, gained in part from transactions under canceled licenses from plaintiff, that plaintiff owned many patents or that it had been granted blanket protection from plaintiff's far flung monopoly in trademark and patent field, was not sufficient to constitute knowledge of specific patents in suit; patentee could have complied by marking articles "patent" or by proving that defendant was duly notified; proof as to latter had to be no less definite and certain than that required as to former; defendant was not "duly notified" unless facts with which he was supplied would, if fixed on patented article, have constituted "sufficient notice"; defendant had to receive actual notice of specific patent alleged to be infringed; it was doubtful whether notice could have been proved by circumstantial evidence. [Smith v Dental Products Co. \(1944, CA7 Ill\) 140 F2d 140, 60 USPQ 260,](#) cert den (1944) 322 US 743, 88 L Ed 1576, 64 S Ct 1146, 61 USPQ 543.

Accounting for patent infringement runs from date when patent owner filed state court unfair competition action against infringer, inasmuch as infringer moved to dismiss that action as being only for patent infringement; notice under 35 USCS § 287 need only be actual knowledge that patent owner is contending that there is valid patent and that infringer is infringing; when one acknowledges for his adversary that latter is claiming infringement, law does not compel patent owner to repeat it more explicitly. [Livesay Window Co. v Livesay Industries, Inc. \(1958, CA5 Fla\) 251 F2d 469, 116 USPQ 167.](#)

Notice of infringement was sufficient where it stated that defendant was infringing and contained numbers of infringed patents; moreover, since notice showed that infringer knew that combination for which his component was especially designed was both patented and infringing, infringer cannot assert that it was not given notice of contributory infringement. [Armstrong v Motorola, Inc. \(1967, CA7 Ill\) 374 F2d 764, 152 USPQ 535, 1967 CCH Trade Cases P 72162,](#) cert den (1967) 389 US 830, 19 L Ed 2d 88, 88 S Ct 95, 155 USPQ 768, reh den [\(1967\) 389 US 997, 19 L Ed 2d 500, 88 S Ct 464.](#)

Actual notice to defendant did not excuse failure to mark goods or to give notice. [Muther v United Shoe Machinery Co. \(1927, DC Mass\) 21 F2d 773.](#)

One who had actual notice of the patent and of his own infringement thereof could have been liable notwithstanding defects in marking of articles. [T. C. Weygandt Co. v Van Emden \(1930, DC NY\) 40 F2d 938.](#)

Before defendant seller received infringing articles from defendant manufacturer one of plaintiffs personally notified seller that articles would have infringed; this notice was sufficient; manufacturer agreed to indemnify seller against infringement; before suit was brought plaintiffs had not notified manufacturer although manufacturer had actual knowledge of plaintiffs' patents before bidding for contract to make articles for seller; in absence of sufficient patent

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stamping, there could have been no recovery of damages unless defendant was expressly notified by patentees that particular articles it was making or proposing to make did or would have constituted an infringement of plaintiffs' patents. *Kilgore Mfg. Co. v Triumph Explosives, Inc.* (1941, DC Md) 37 F Supp 766, 48 USPQ 510, 49 USPQ 51, affd in part and revd in part on other grounds (1942, CA4 Md) [128 F2d 444](#), [52 USPQ 199](#), cert den (1942) 317 US 660, 87 L Ed 530, 63 S Ct 59, 55 USPQ 493.

In determining date of infringement notice under 35 USCS § 287, it is irrelevant that defendant knew of patent and had soundest possible reason to believe that plaintiff would regard quantity production as infringement; statutory requirement of notice is unambiguous; there can be no recovery for period before defendant is expressly notified by patentee that it is infringing a particular patent. *International Nickel Co. v Ford Motor Co.* (1958, DC NY) 166 F Supp 551, 119 USPQ 72.

Absent marking of patented product, 35 USCS § 287 requires that patent owner prove notification of infringement to infringer before latter becomes liable for damages; if patented article is unmarked, copyist is not required to make search to learn whether article is patented; he can go ahead without risk until notified of infringement; however above rule relates only to situations where infringer is not cognizant of infringement; it cannot apply to conscious and willful infringer who copies article from the patent; notice of infringement under such circumstances would be superfluous. *Union Carbide Corp. v Graver Tank & Mfg. Co.* (1959, ND Ind) 124 USPQ 62, affd in part and revd in part on other grounds (1960, CA7 Ind) [282 F2d 653](#), [127 USPQ 3](#), cert den (1961) 365 US 812, 5 L Ed 2d 691, 81 S Ct 692, 128 USPQ 557 and cert den (1961) 365 US 812, 5 L Ed 2d 691, 81 S Ct 695, 128 USPQ 557.

Patentee notifying infringer of issuance of patent on threaded drill rod supplied only by patentee and infringer who are both well known in industry is entitled to lost profits from all of infringer's sales. *Ingersoll-Rand Co. v Brunner & Lay, Inc.* (1974, SD Fla) 182 USPQ 257.

Although there is inclusive evidence that infringer knew of plaintiff's patent before provable date of actual notice, failure to mark patent number on plaintiff's product results in damages assessed only back to date of clearly provable notice. *Milgo Electronic Corp. v United Telecommunications, Inc.* (1978, DC Kan) 200 USPQ 481.

Indirect evidence that defendant knew of plaintiff's patents falls short of actual notice of infringement from plaintiff who did not mark products, so that partial summary judgment against recovery of damages before notice is granted. *Hoover Universal v Graham Packaging Corp.* (1996, CD Cal) 44 USPQ2d 1596.

Patentee gave actual notice of its claim of infringement to competitor when competitor received letter accusing it of infringement. *Vulcan Eng'g Co. v Fata Aluminum, Inc.* (2000, ED Mich) 2000 US Dist LEXIS 22742, affd in part and mod in part, remanded (2002, CA FC) [278 F3d 1366](#), [61 USPQ2d 1545](#), on remand, judgment entered (2002, ED Mich) [2002 US Dist LEXIS 16458](#) and cert den (2002) 537 US 814, 123 S Ct 81, 154 L Ed 2d 18.

Patent holder was not entitled to damages until date on which actual notice of infringement was provided to Internet Service Providers (ISP) because its licensee continued to sell and offer for sale, services and products embodying patent after that patent issued; thus, ISPs' joint motion for partial summary judgment limiting damages under 35 USCS § 287(a) was granted. *Inline Connection Corp. v AOL Time Warner, Inc.* (2006, DC Del) 465 F Supp 2d 312.

Patent owner failed to raise genuine issue of material fact that importer had actual knowledge that acetic acid on board ship headed to U.S. was produced in manner covered by any claim of owner's patent for importation infringement under 35 USCS § 271(g) and importer thus could rely on modification of remedies under 35 USCS § 287(b)(2). *Celanese Int'l Corp. v Oxyde Chems., Inc.* (2008, SD Tex) 554 F Supp 2d 725.

In patent infringement action, defendants were entitled to judgment as matter of law that earliest notice dates supported by evidence were: August 4, 2010 for '381 patent; April 15, 2011 for '915 and D'677 patents; and June 16, 2011 for '163, D'305, D'889, and D'087 patents; where plaintiff relied on actual, rather than constructive notice, notice must include specific patents at issue. *Apple, Inc. v Samsung Elecs. Co.* (2013, ND Cal) 926 F Supp 2d 1100.

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Infringers were bound if they had sufficient knowledge to put them on inquiry. [Smith v Stewart \(1893, CCD Pa\) 55 F 481](#), affd (1893, CA3 Pa) [58 F 580](#).

12. Commencement of action as notice

Prior suit was sufficient notice of infringement. [Warner v Tennessee Products Corp. \(1932, CA6 Tenn\) 57 F2d 642](#), cert den (1932) 287 US 632, 77 L Ed 548, 53 S Ct 83.

Filing of bill for infringement operated as notice for purpose of injunctive relief and accounting for infringement thereafter occurring. [Allied Metal Stamping Co. v Standard Electric Equipment Corp. \(1932, DC NY\) 57 F2d 296](#).

Proper procedure in respect of infringements occurring only after suit has been brought would have been to file another bill of complaint or supplemental bill in which reliance could properly have been placed on original bill as notice of infringement in personam on defendant therein. [Hazeltine Corp. v Radio Corp. of Am. \(1937, DC NY\) 20 F Supp 668](#) (criticized in [Aerogroup Int'l v Marlboro Footworks \(1997, SD NY\) 1997 US Dist LEXIS 2044](#)).

Plaintiff gave no notice of claim infringement of patent but never manufactured under it; however, he had sued third party for infringement and settlement had provided that third party could have completed and sold about 2,500 machines using infringing device; this constituted party a licensee and it became duty of plaintiff to see that the 2,500 machines were marked with patent and number thereof; since this was not done, plaintiff could not have recovered any damages for infringement prior to date of giving notice, which was date of commencement of prior suit defended against customer. [Gordon v Easy Washing Mach. Corp. \(1941, DC NY\) 39 F Supp 202, 49 USPQ 321](#).

Lack of any infringement notice letter and failure to mark patented footsocks directly with patent number results in notice as of commencement of action relative to damages for infringement of patent on footsocks. [Wayne-Gossard Corp. v Sondra, Inc. \(1977, ED Pa\) 434 F Supp 1340, 195 USPQ 777](#), affd (1978, CA3 Pa) [579 F2d 41, 200 USPQ 11](#).

Because complaint for patent infringement is notice under 35 USCS § 287, defendant's argument against jury trial because damages cannot be awarded for lack of notice fails, and jury trial motion is granted. [American Can Co. v Dart Industries \(1979, ND Ill\) 205 USPQ 1006](#).

In pharmaceutical company's patent infringement suit against six Canadian pharmacies for their online sales of generic version of its patented cholesterol medication, company was precluded from recovering damages prior to date of filing suit because (1) although patent contained both method and product claims, company was required to provide notice under patent marking statute, 35 USCS § 287(a), and (2) it did not provide requisite notice as its listing in FDA "Orange Book" did not constitute required notice under § 287(a). [Merck & Co. v Mediplan Health Consulting, Inc. \(2006, SD NY\) 434 F Supp 2d 257](#).

In consolidated cases involving several technology corporations, regarding patent describing methods relating to digital speech codes, which transformed speech into electrical pulses, summary adjudication was granted to patentee on many issues due to insufficient evidence, but not regarding actual notice because, pursuant to 35 USCS § 287(a), notice was triggered when patentee notified defendants of alleged infringement. [Lucent Techs. Inc. v Gateway, Inc. \(2007, SD Cal\) 470 F Supp 2d 1187](#).

Where there was no doubt that defendant had actual notice of charge of infringement because defendant and plaintiffs had already engaged in litigation over patent in which plaintiffs attempted to proceed with infringement claims by having court order correction of patent, court denied defendant's motion for summary judgment that plaintiffs could recover no damages prior to January 6, 2006 due to failure to mark or give notice. [Lucent Techs. v Microsoft Corp. \(2008, SD Cal\) 544 F Supp 2d 1080](#).

35 USCS § 287

Because there was sufficient evidence that corporation was liable for direct patent infringement, damages could be assessed against infringer regardless of its notice of infringed patent pursuant to 35 USCS § 287(a), rather than damages for indirect infringement for five days that it continued to sell infringing products after patent holder's lawsuit was filed. [Mass Engineered Design, Inc. v Ergotron, Inc. \(2009, ED Tex\) 633 F Supp 2d 361.](#)

Pursuant to 35 USCS § 287(a), manufacturer was not entitled to damages immunity for accused products that were delivered after manufacturer received actual notice of alleged infringement as manufacturer's actions in delivering products constituted post-notice continuing infringement. [Tesco Corp. v Weatherford Int'l Inc. \(2010, SD Tex\) 722 F Supp 2d 755.](#) motion to strike gr, in part, motion to strike den, in part, motion to strike den, motion dismd, as moot, summary judgment den, summary judgment gr, in part, summary judgment den, in part,, patent interpreted (2010, SD Tex) [2010 US Dist LEXIS 121054.](#)

Law was clear that limited liability company (LLC) bore burden of showing compliance with marking statute, and that included burden of showing that patentee was not subject to requirements of 35 USCS § 287(a); under 35 USCS § 287, LLC was barred from collecting damages before July 14, 2009, when actual notice of infringement was given through filing of complaint because: on whole, without expert testimony as to exhibits cited by LLC, one could not draw inference that products did not practice patent, and, without such testimony, LLC failed to meet its burden of demonstrating that marking statute was not triggered; LLC had to concede that licensees, beginning on December 31, 2007 sold or offered for sale patented articles without marking them; and it was undisputed that two licensees' products were unmarked. [WiAV Solutions LLC v Motorola, Inc. \(2010, ED Va\) 732 F Supp 2d 634.](#)

IV. PRACTICE AND PROCEDURE

13. Generally

Damages recoverable by nonproducing patentee or owner of patent for its infringement are not limited to those accruing during period subsequent to giving of notice of infringement, by provisions of predecessor to 35 USCS § 287 that it shall be duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to public that same is patented by fixing thereon, if possible, or, if not, to package containing such patented article, a label bearing the word "Patented" and date of granting of patent; and that in any suit for infringement by party failing so to mark no damages shall be recovered by plaintiff except on proof that defendant was duly notified of infringement, and continued, after such notice, to make, use, or vend article so patented. [Wine R. Appliance Co. v Enterprise R. Equipment Co. \(1936\) 297 US 387, 80 L Ed 736, 56 S Ct 528.](#)

It was too late to raise for first time in appellate court question that bill of complaint for infringement failed to allege that complainants marked their machines or notified defendants of the infringement. [Tuttle v Clafflin \(1896, CA2 NY\) 76 F 227.](#) cert den (1897) 166 US 721, 41 L Ed 1187, 17 S Ct 992.

Notice imported by records of Patent Office could not have been invoked to supply lack of the notice required by these provisions. [Flat Slab Patents Co. v Northwestern Glass Co. \(1922, CA8 Minn\) 281 F 51.](#)

It was judicially noticed that patented flooring could not have been marked or tagged and in view of the nature of the invention it was assumed there was no marking. [Flat Slab Patents Co. v Turner \(1922, CA8 Minn\) 285 F 257.](#) cert den (1923) 262 US 752, 67 L Ed 1215, 43 S Ct 700.

Question of failure to mark patented articles raised for first time in reply brief on appeal was waived. [Austin-Western Road Machinery Co. v Disc Grader & Plow Co. \(1923, CA8 Minn\) 291 F 301.](#) cert den (1924) 263 US 717, 68 L Ed 522, 44 S Ct 180.

35 USCS § 287

In action for infringement of patent covering typewriter ribbon seeking injunction and accounting for profits and damages, plaintiff's petition for writ of mandamus to require District Court judge to grant jury trial would be denied where plaintiff had not satisfied terms of 35 USCS § 287 providing for damages only (1) if there is marking giving notice to public that article is patented, together with patent number, or (2) if there is proof that alleged infringer was notified of infringement and continued to infringe thereafter; complaint did not allege any public marking by plaintiff of typewriter ribbon itself and it was undisputed that plaintiff had not given any notice to defendant of alleged patent infringements prior to institution of suit. [Filmon Process Corp. v Sirica \(1967, App DC\) 126 US App DC 395, 379 F2d 449, 153 USPQ 440, 11 FR Serv 2d 997.](#)

Compliance with marking statute (35 USCS § 287(a)) is question of fact. [Gart v Logitech, Inc. \(2001, CA FC\) 254 F3d 1334, 59 USPQ2d 1290](#), reh, en banc, den (2001, CA FC) [2001 US App LEXIS 21100](#) and cert den (2002) 534 US 1114, 151 L Ed 2d 886, 122 S Ct 921 and summary judgment den, patent interpreted (2003, CD Cal) [254 F Supp 2d 1119, 67 USPQ2d 1263](#).

Issue of compliance with 35 USCS § 287(a) is properly decided upon summary judgment when no reasonable jury could find that patentee either has or has not provided actual notice to particular defendants by informing them of his patent and of their infringement of it. [Gart v Logitech, Inc. \(2001, CA FC\) 254 F3d 1334, 59 USPQ2d 1290](#), reh, en banc, den (2001, CA FC) [2001 US App LEXIS 21100](#) and cert den (2002) 534 US 1114, 151 L Ed 2d 886, 122 S Ct 921 and summary judgment den, patent interpreted (2003, CD Cal) [254 F Supp 2d 1119, 67 USPQ2d 1263](#).

Jury instruction was not legally erroneous, at least with respect to one of two patents, as it correctly barred accumulation of damages prior to issuance date of method patent, for which no notice was required, and, accordingly, damages could begin accruing as of issuance date of that patent, regardless of when there was notice of either pending or issued patent. [State Contr. & Eng'g Corp. v Condotte Am., Inc. \(2003, CA FC\) 346 F3d 1057, 68 USPQ2d 1481](#).

Notice provisions are effective to limit damage amounts, but do not operate during liability determination to allow withholding of information in resistance to interrogatories because of failure of patentee to mark with patent notice. [Ampex Corp. v United States \(1980, Ct Cl\) 207 USPQ 440](#).

Where copy of complainant's patent was mailed to defendants with notice of the patent, damages were recoverable for infringement if proof was made that defendants were duly notified of the infringement and continued after such notice to use article so patented. [Macbeth-Evans Glass Co. v Rosenbaum Co. \(1912, DC Pa\) 199 F 154](#).

Court held that Fed. R. Civ. P. 60(b)(4) was not violated, as scope of allowable damages under 35 USCS § 287(a) had no bearing on whether judgment was void; court therefore denied company's motion for relief from default judgment. [In re Elonex Phase II Power Mgmt. Litig. \(2003, DC Del\) 279 F Supp 2d 521](#), subsequent app (2004, CA FC) 97 Fed Appx 329, reh den, reh, en banc, den (2004, CA FC) [2004 US App LEXIS 15664](#) and cert den (2005, US) 160 L Ed 2d 898, 125 S Ct 964.

Compliance with marking statute is question of fact; consequently, marking issue is properly decided upon summary judgment when no reasonable jury could find that patentee either has or has not provided actual notice to particular defendants by informing them of his patent and their infringement of it. [Halliburton Servs. v Smith Int'l, Inc. \(2004, ED Tex\) 317 F Supp 2d 719](#).

In patent infringement case where jury found in favor of patentee and concluded that competitor engaged in both direct infringement and induced infringement, competitor was not entitled to new trial based on argument that patentee did not substantiate entitlement to pre-lawsuit damages because jury might have used improper notice date under 35 USCS § 287; competitor did not request question on verdict form asking what notice date was relied on by jury, and therefore court without any basis for concluding that pre-lawsuit damages were actually awarded. [Anchor Wall Sys. v Rockwood Retaining Walls, Inc. \(2009, DC Minn\) 610 F Supp 2d 998](#).

35 USCS § 287

In patent infringement action, court found that plaintiff patent holder violated Fed. R. Civ. P. 26(a)(1)(A)(ii), and Rule 26(e), in conjunction with plaintiff's failure to comply with 35 USCS § 287(a); plaintiff had duty to disclose evidence supporting its licensees' compliance with § 287(a) as to patent at issue, and was likewise obligated to produce evidence as to any actual notice provided to defendants of alleged infringement of patent at issue prior to initiation of instant lawsuit. [Carnegie Mellon Univ. v Marvell Tech. Group, LTD. \(2012, WD Pa\) 906 F Supp 2d 399.](#)

14. Pleading

Infringer who relied upon want of knowledge upon his part of actual existence of patent covering the article in controversy was required to aver same in his answer in infringement suit. [Sessions v Romadka \(1892\) 145 US 29, 36 L Ed 609, 12 S Ct 799; Winchester Repeating Arms Co. v American Buckle & Cartridge Co. \(1893, CCD Conn\) 54 F 703.](#)

Allegations of bill and answer presented issue of fact as to whether notice of infringement was given prior to filing of bill. [Bishop & Babcock Mfg. Co. v Fulton Co. \(1930, CA6 Ohio\) 37 F2d 293.](#)

Failure to mark or notify under 35 USCS § 287 is not defense to infringement action but is limitation on damages that should be pleaded, so that summary judgment dismissing portions of action for failure to mark or notify is denied, especially considering contested factual issues. *Hale Bros. Associates, Inc. v United States* (1976, Ct Cl) 192 USPQ 114.

Plaintiff is permitted to amend patent infringement complaint to allege compliance with 35 USCS § 287. [Dairy Foods, Inc. v Farmers Co-Operative Creamery \(1969, DC Minn\) 298 F Supp 774, 161 USPQ 26, 1969 CCH Trade Cases P 72910.](#)

In patent infringement action, failure of inventor to plead compliance with 35 USCS § 287(a) did not constitute waiver; although inventor did not affirmatively allege compliance with § 287(a) in his complaint, he did allege that alleged infringer knew of patent at least as early as date it referenced patent in letter to inventor--factual predicate for willful infringement. [Bowling v Hasbro, Inc. \(2007, DC RI\) 490 F Supp 2d 262.](#)

Because defendant in patent infringement action asserted marking defense under 35 USCS § 287 and claimed that assignee could not recover damages for alleged infringements occurring prior to filing of complaint because of improper marking, patent assignee was required to disclose marking information due to fact that it was relevant to this defense. [McKesson Info. Solutions LLC v Epic Sys. Corp. \(2007, ND Ga\) 495 F Supp 2d 1329,](#) motion gr, request den, motion gr (2007, ND Ga) [2007 US Dist LEXIS 53437.](#)

Patent owners' damages claims did not require dismissal under 35 USCS § 287(a) because issue of notice was question of fact precluding dismissal at this stage of case; more definite statement was not required because owners specifically claimed that they were entitled recover damages under 35 USCS § 284 and reasonable fees under 35 USCS § 285. [Loops, LLC v Amercare Prods. \(2008, WD Wash\) 636 F Supp 2d 1128.](#)

In patent infringement case, patentee adequately met its duty to plead compliance with 35 USCS § 287(a) because it alleged, as to each of its patents, that competitor's infringement was deliberate and willful; thus, it did not waive its argument against failure to mark defense. [Cordance Corp. v Amazon \(2009, DC Del\) 631 F Supp 2d 484,](#) motion to strike den, as moot (2009, DC Del) [631 F Supp 2d 477,](#) summary judgment gr, in part, summary judgment den, in part,, summary judgment den, motion den, as moot (2009, DC Del) [639 F Supp 2d 406.](#)

Where plaintiff brought action alleging defendant infringed its patents and misappropriated confidential and trade secret information, district court refused to strike defendant's affirmative defense of prosecution history estoppel; plaintiff had opportunity to obtain discovery on facts underlying defendant's affirmative defenses, and was not at risk for surprise and undue prejudice that justified striking bare bones allegations. [XpertUniverse, Inc. v Cisco Sys., Inc. \(2012, DC Del\) 868 F Supp 2d 376.](#)

35 USCS § 287

If bill for infringement and accounting fails to allege that patented article was marked, defendant could not avail himself of such omission where he made no issue of the point by his own pleading or proof. [United States Printing Co. v American Playing-Card Co. \(1895, CCD Mich\) 70 F 50.](#)

Objection by defendant in infringement suit that notice was not given as required could not have been raised for first time at hearing, it not having been brought up in answer. [Anderson v Saint \(1891, CCD Pa\) 46 F 760.](#)

Though infringement was clearly shown by the evidence, patentee would have been precluded from obtaining damages or an accounting if he failed to allege either that patented devices were marked "patented," or that actual notice of that fact was given to defendant as required. [National Co. v Belcher \(1895, CCD Pa\) 68 F 665,](#) mod (1896, CA3 Pa) [71 F 876.](#)

Bill for infringement failing to allege that complainant had marked patented articles, but alleging notice given to defendants of infringement, without stating date notice was given, required proof by complainant of such date before damages could have been given. [Lorain Steel Co. v New York Switch & Crossing Co. \(1907, CCD NJ\) 153 F 205.](#)

Explicit notice of infringement had to be alleged to have been given to defendant in infringement suit, where bill failed to allege that patented article was marked as required. [Westinghouse Elec. & Mfg. Co. v Condit Elec. Mfg. Co. \(1907, CCD NY\) 159 F 154,](#) affd (1909, CA2 NY) [167 F 546](#) and (criticized in [Aerogroup Int'l v Marlboro Footworks \(1997, SD NY\) 1997 US Dist LEXIS 2044.](#))

15. Proof

Where issue was made by answer, compliance by patentee with these provisions had to be affirmatively shown in order to lay ground for an account in infringement suit. [American Caramel Co. v Thomas Mills & Bro. \(1907, CA3\) 162 F 147.](#)

Burden of proving actual notice was on complainant. [Franklin Brass Foundry Co. v Shapiro & Aronson, Inc. \(1921, CA3 Pa\) 278 F 435.](#)

Notice could have been given otherwise than by statutory method, but patentee had burden of proving that infringer had such actual notice. [Flat Slab Patents Co. v Turner \(1922, CA8 Minn\) 285 F 257,](#) cert den (1923) 262 US 752, 67 L Ed 1215, 43 S Ct 700; [Oil Well Improv. Co. v Acme Foundry & Machine Co. \(1929, CA8 Kan\) 31 F2d 898.](#)

Patentee who had failed to mark his device as required had burden of proving actual notice. [Oil Well Improv. Co. v Acme Foundry & Machine Co. \(1929, CA8 Kan\) 31 F2d 898.](#)

Cause of action for damages or accounting for profits was not stated unless it was shown at trial that marking or notice occurred before trial. [Horvath v McCord Radiator & Mfg. Co. \(1938, CA6 Mich\) 100 F2d 326, 40 USPQ 394,](#) cert den (1939) 308 US 581, 84 L Ed 486, 60 S Ct 101, 43 USPQ 520, reh den (1939) 308 US 636, 84 L Ed 529, 60 S Ct 171; [Hazeltine Corp. v Radio Corp. of Am. \(1937, DC NY\) 20 F Supp 668](#) (criticized in [Aerogroup Int'l v Marlboro Footworks \(1997, SD NY\) 1997 US Dist LEXIS 2044.](#))

Failure to introduce documentary or convincing oral evidence of date that marking of patent notice commenced does not satisfy burden of proof and results in denial of damages for infringement before actual notice. [Wayne-Gossard Corp. v Sondra Mfg. Co. \(1978, CA3 Pa\) 579 F2d 41, 200 USPQ 11.](#)

District court erred by holding that plaintiffs' marking evidence did not preclude summary judgment and, therefore, plaintiffs were entitled to opportunity to prove constructive notice and corresponding entitlement to damages for infringement of their patent; appellate court's holding rendered issue of infringement of patent not moot. [Sentry Prot. Prods. v Eagle Mfg. Co. \(2005, CA FC\) 400 F3d 910, 73 USPQ2d 1929.](#)

35 USCS § 287

Plaintiff asking for an accounting was permitted to introduce proof before master of averments as to notice, not proved prior to interlocutory decree. *Bakelite Corp. v Brunswick-Balke-Collender Co.* (1928, DC Del) 24 F2d 418.

Consent decree of validity and infringement did not waive proof by patentee as to notice of infringement. *General Elec. Co. v Grand Gaslight, Inc.* (1942, DC NY) 46 F Supp 822, 55 USPQ 413 (criticized in [Aerogroup Int'l v Marlboro Footworks \(1997, SD NY\) 1997 US Dist LEXIS 2044](#)).

When compliance with 35 USCS § 287(a) turned on retailers' actions or inactions, alleged infringer's statistical survey of how many articles went unmarked was not conclusive of issue whether patentee's marking was "substantially consistent and continuous." *Bowling v Hasbro, Inc.* (2007, DC RI) 490 F Supp 2d 262.

Where patent holder asserted in infringement action that holder was not aware of any product or service made, sold, offered for sale by holder to preclude limitation of damages based on lack of marking under 35 USCS § 287(a), such statement was insufficient to support holder's motion for summary judgment; holder's equivocal and qualified statement did not conclusively establish that neither holder nor anyone acting for or under holder made, sold, or offered for sale any article patented under asserted patents. *Sprint Communs. Co. L.P. v Vonage Holdings Corp.* (2007, DC Kan) 500 F Supp 2d 1290.

Question of whether patentee complied with notice requirements of 35 USCS § 287(a) was jury question; jury's finding of no pre-suit notice was not against clear weight of evidence, and although court would have weighed evidence differently, jury's determination did not warrant new trial. *Lucent Techs., Inc. v Gateway, Inc.* (2008, SD Cal) 580 F Supp 2d 1016.

In suit involving method patent that allowed doctors to use video-conferencing providers to remotely diagnose medical conditions, providers did not satisfy requirements for medical immunity under 35 USCS § 287(c); although allegedly infringing acts involved performance of medical procedures on bodies, and providers were related health care entities as defined in § 287(c), medical immunity did not apply because doctors' mere performance of medical activities in steps outlined in Claims 1 and 4 of patent did not infringe patent. *Ertel, Inc. v LipidLabs, Inc.* (2008, SD Tex) 583 F Supp 2d 811.

There was substantial evidence from which jury could find that patent holder's marking of products that incorporated patent was substantially consistent and continuous; on second patent evidence provided sufficient basis for jury to calculate damages for infringement following infringer receiving actual notice of infringement. *Funai Elec. Co., Ltd. v Daewoo Elecs. Corp.* (2009, ND Cal) 593 F Supp 2d 1088.

Whether companies willfully infringed patents describing surgical breast biopsy mechanism enabling vacuum-assisted removal of multiple tissue samples with one needle insertion or were entitled to pre-suit damages under marking statute, 35 USCS § 287(a), was in dispute because fact-finder was entitled to consider presence of other markings on patented devices' packaging as factor in deciding whether infringement was willful. *Ethicon Endo-Surgery, Inc. v Hologic, Inc.* (2010, SD Ohio) 689 F Supp 2d 929.

Patent holder was granted summary judgment on 35 USCS § 287(a) marking defense where defendant had burden of proving that there were patented articles to mark and had not done so, and patent holder had only asserted method claims. *In re Katz Interactive Call Processing Patent Litig.* (2011, CD Cal) 821 F Supp 2d 1135.

Defendant was not entitled to summary judgment on issue of marking of patents-in-suit by prior owners because although defendant argued that prior owners of patents-in-suit failed to mark patents, and licensees of patent were also not required to mark, defendant failed to disclose its theory on marking well after close of discovery, and thus, was precluded from raising those contentions pursuant to *Fed. R. Civ. P. 37*. *Lake Cherokee Hard Drive Techs., L.L.C. v Marvell Semiconductor, Inc.* (2013, ED Tex) 964 F Supp 2d 653 (criticized in *Fr. Telecom S.A. v Marvell Semiconductor Inc.* (2014, ND Cal) 2014 US Dist LEXIS 52564).

Where the only evidence was of marking "as a rule" it was insufficient. *Matthews & W. Mfg. Co. v National Brass & Iron Works* (1895, CCD Pa) 71 F 518.

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Proof to support allegation that plaintiff's machine was marked as required was waived by defendant where allegation was not denied in answer, and no objection to failure of proof was made at hearing. [Pettibone, Mulliken & Co. v Pennsylvania Steel Co. \(1905, CCD Pa\) 134 F 889](#), rev'd on other grounds (1905, CA3 Pa) [141 F 95](#).

Where issue was duly tendered as to marking and giving notice, but no proof offered at hearing, and no objection made at hearing as to failure to make such proof, it was within province of court to permit proof thereof to be made at any time before final decree, and even before master on accounting. [Underwood Typewriter Co. v Elliott-Fisher Co. \(1909, CCD NY\) 171 F 116](#).

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This section is referred to in *35 USCS § 157*.

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60 Am Jur 2d, Patents § 793.

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89 Am Jur Proof of Facts 3d, Establishing the Defense of Issue Preclusion in a Subsequent Patent Infringement Suit, p. 1.

94 Am Jur Proof of Facts 3d, Establishing Liability of a Generic Drug Manufacturer for Inducing Patent Infringement, p. 179.

105 Am Jur Proof of Facts 3d, Establishing Infringement of a Design Patent, p. 1.

114 Am Jur Proof of Facts 3d, Establishing Lack of Utility Under *35 U.S.C.A. § 101 [35 USCS § 101]*, p. 587.

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1 Chisum on Patents (Matthew Bender), ch 1, Eligible Subject Matter § 1.03.

5 Chisum on Patents (Matthew Bender), ch 16, Direct Infringement §§ 16.02, 16.06.

5 Chisum on Patents (Matthew Bender), ch 17, Contributory Infringement § 17.03.

6 Chisum on Patents (Matthew Bender), ch 19, Defenses §§ 19.03, 19.05, 19.06.

7 Chisum on Patents (Matthew Bender), ch 20, Remedies § 20.03.

8 Chisum on Patents (Matthew Bender), ch 21, Jurisdiction and Procedure in Patent Litigation § 21.02.

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- 8 Chisum on Patents (Matthew Bender), ch 23, Design Patents § 23.07.
- 2 Gilson on Trademarks (Matthew Bender), ch 7, Federal Unfair Competition Law § 7.02.
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Annotations:

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Modern status of federal rules of res judicata in patent litigation. [4 ALR Fed 181](#).

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