

Marking

Marking, in the IP world, means labelling your product and services with details of the IP rights that protect it. In some countries marking can help you to effectively claim damages from infringers during litigation. Different jurisdictions have different rules on how (and if) products and services should be marked however, and some have strict penalties for incorrect marking. You should therefore weigh the benefits of marking against the potential risks before you launch your product or offering, and you should always keep your marking up to date.

What are the benefits of marking?

IP infringement is not always intentional. Sometimes a person infringes another's IP rights accidentally, simply because he or she did not know those rights existed. The IP law of many countries around the world has provisions that protect such "innocent infringers" from the full consequences of their infringement. For example, innocent patent infringers in the UK may pay reduced damages if they can show that they did not know your rights existed and had no reasonable grounds for suspecting it either.

The purpose of marking is to avoid this situation. An infringer will have difficulty proving that they had no knowledge of your rights if your product is clearly marked with information notifying him that those rights exist. Correctly marking your products can thus ensure that you are able to fully claim the damages to which you are entitled if you need to take an infringer to court.

Marking can also have a useful deterrent effect. Competitors can often be reluctant to copy a product that is obviously protected - at least without some consideration of the strength of the IP rights that cover it first.

Marking may also help a trade mark owner avoid descriptive use of the mark in advertising and labelling. Such use can lead to the mark become generic. A trade mark can become generic when the mark becomes the common name in the market for a particular product or service. In essence, everyone uses that trade mark to refer to the products/services regardless as to the point of origin. The trade mark is then generic and when this happens, it can no longer function as a trade mark denoting one company and it can become vulnerable to being removed from the register. Using the correct markings makes it clear to all that a particular name, is a trade mark of a business and not the "generic" product or service name.

Finally, marking can be a positive marketing tool - advertising that your product is protected can help you position yourself in the market as an innovative and cutting edge business.

Do I have to mark my products?

No, you do not. In most countries marking is entirely optional (we are not aware of any countries where it is currently compulsory). However, as described above, in many countries failing to mark your products can put you at risk of not being able to fully recover damages during litigation.

Are there any disadvantages to marking?

The short answer is, "not if you do it right". Many countries have penalties for falsely claiming that a product is protected however, and so it is important to make sure your marking is up to date and not misleading.

This is especially the case for patents in the USA, where you can be fined **per product** falsely marked. This means that 1000 falsely marked products would incur a fine of 1000 x the false marking fine. At present, the fine is up to \$500 per article, meaning a \$0.5 million fine could be levied for just 1000 wrongly marked items. Further, in USA it is possible for a competitor to sue you for damages caused by your false marking (in most countries, it is only the Patent Office who can sue). In practical terms, it is unlikely that such an action would be successful, as the competitor would have to be able to prove they suffered a competitive injury as a result of your false marking - this is only likely to be case if you falsely claim you have a patent when you don't, or if you claim that their patent covers your goods. A statement referring to a patent that once genuinely covered your product but that has now expired is not a cause for action, unless you have had reasonable time since the expiry to update the marking.

Other jurisdictions impose fines for incorrect marking too, but in general these are not so severe as those in USA. It is perhaps more significant that false marking is a criminal offence in the UK, and officers of an offending company may be personally liable. Therefore it is safer to make sure you mark your product correctly in order to avoid the risk of incurring a criminal record (although in reality prosecutions for false marking are very rare).

So how do I mark my product correctly?

Marking is not rocket science. In most cases all you need to do is make sure that in addition to saying your product is protected, you also provide enough information for a third party to identify the specific IP right or rights that cover that product. Usually this will mean including the official number of the right.

In many countries it is sufficient to mark your IP information on the packaging of your product or literature closely associated with the product (e.g. an instruction book). However in some countries, such as the USA, it is necessary to mark the product itself if that is feasible.

For instance, if the product is a moulding, then the marking could be incorporated in the die used for casting (though only if you are certain you won't need to change the marking before you want to change the die). Alternatively, the marking could be a decal applied to the product or could be etched or otherwise formed in the product. If at all possible, the marking should be naked-eye legible, and also included in any associated literature, advertisements and websites as well. However you choose to mark your product, the key things to make sure are:

- Marking information must be kept up to date - claiming you have a granted right when that right has lapsed is, in many countries, an offence. Similarly, claiming you have a pending application after it has been refused (or before it has been filed) is not permitted. Once your rights have lapsed you must amend your marking information to remove the claim that the product is protected. In the UK at least, you are allowed reasonable time to do this (e.g. time to sell off marked stock)

- Do not imply you have a protection if you don't - if you haven't filed an application yet, do not claim that you have. Similarly, if you have a pending application, do not imply that it is granted. If you have a mixed set of granted rights and pending applications that all cover your product, a distinction should be drawn between the applications and the granted rights so that there is no suggestion that an application has been granted when it hasn't. (N.B. the opposite is not such a problem - in the UK, at least, it is unlikely to be unlawful to suggest that there is a pending application when that has now matured into a granted right)
- Make sure you include the numbers of your rights - if you don't, your marking is unlikely to be effective, but you can still be open to prosecution for making false claims that your product is protected (if it is not)
- If you are not sure, check - marking requirements can differ from country to country, and some countries (e.g. France) prefer you to identify your rights in their local language. Marking in English still is usually acceptable, but it is nevertheless advisable to check the local requirements in any key countries not listed above in which English is not an official language to confirm whether or not marking in English will be effective

Patents

The marking should indicate if your product is covered by a granted patent (patented) or an application that is still undergoing examination (patent pending). Examples of suitable forms of marking are:

Patent applied for number/no. Patent pending number/no. Patent application number/no. Pat. Pending Brevet déposé (in FR)	GB 2312345.6 or US 23/123,456
International patent publication number/no. Patent publication number/no.	WO 2024/123456 EP 1234567 A
Patents Pat. no. Patent nos Breveté (in FR)	US 6789012 or EP 1234567 B (AT, CH, DE, BE)*
Patent information is available at www.example.co.uk/patents	(but see the section below on virtual marking)

**For European patents that have been validated in a number of countries, "Pat. No. EP 1 234 567 B (AT, CH, DE, FR)" should be sufficient in each of the validation countries; in this case Austria (AT), Switzerland (CH), Germany (DE) and Belgium (BE), without needing to identify a separate patent number for each.*

Trade marks

TM stands for trade mark and is often used in superscript such as TM. This symbol is usually used in connection with an unregistered trade mark right or a trade mark which is going through the application process. This symbol can be used regardless as to whether or not the mark is registered and can be used even if an application for the mark is ultimately refused. The TM symbol in effect puts third parties on notice that you consider the trade mark as your trade mark.

The ® symbol is used to denote that the mark is registered providing notice of the legal ownership of the mark it is used with. The ® mark should only be used when the mark is registered. In a number of jurisdictions, using the ® symbol when the mark is not registered is a civil and/or criminal offence.

Typically, these symbols are placed close to the mark itself.

In addition, you can use a proprietary legend in conjunction with use of the mark. For example, in the small print of your website, you can add a proprietary legend, such as:

- X is a trade mark of [company name].
- X is a registered trade mark of [company name]

Designs

Registered Design applied for number/no. Registered Design application number/no. Design patent pending (in US)	GB 1234569 or EM 001234567-0001 or US 29/123,456
International Design Registration Hague Design no.	DM/123 456 (EM, US, CA)*
Registered Design. Reg. Des. Design Patent (in US)	GB 1234569 or EM 001234567-0001 or US D 123 456
Information on registered designs is available at www.example.co.uk/designs	(but see the section below on virtual marking)

* For international design registrations, the designated countries should be indicated.

Copyright

The format for copyright marking is one of:

- © YYYY Name of owner
- Copyright YYYY Name of owner

YYYY is the publication year or an interval of years (E.g., 2019-2022) in case the content gets updated over time.

What is virtual marking?

The option of “virtual” or “web” marking can be used in some countries, most notably the UK and USA. Virtual marking means marking your goods with a website address that directs a third party to a website detailing the rights that protect them, rather than marking the goods themselves with the details of those rights.

Whilst it is much easier to keep marking information up to date on a website than it is on a product or its packaging - it is not without its own potential pitfalls. To be effective, it is important that the website indicated on the product is **freely accessible** and **clearly associates** the product in question with the relevant numbers of the IP rights, e.g. by including any relevant model numbers and variants that exist.

Simply providing the web address of the company home page and expecting a third party to navigate to the information themselves is unlikely to suffice.

Virtual marking is less widely accepted than the more conventional method of physically marking the products or packaging and is not currently recommended in many European countries. In the UK it is an option for patents and registered designs. It is likely that virtual marking will become more widespread over time however, and so if you have a particular interest in the current position in a specific European country, or if you have any other marking queries, please contact your usual Barker Brettell attorney.

What next?

If you would like more information, then please get in touch. You can email us info@barkerbrettell.co.uk or call us on **+44 (0)121 456 0000**.