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IP Links of Interest

- [US Patent Office](#) A host of useful, official information.
- [EKMS, Inc.](#) A strategic IP management partner of TechRoadmap.
- [The Patent Cafe](#) An on-line portal for IP matters.
- [AlvaMed, LLC](#) A medical device consulting company we work with.
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Welcome

Politicians and CEO's of large companies are taught to pseudo-apologize when they or their companies are caught red-handed. "If I offended anyone," they say, "I'm sorry for the pain I caused". They never actually apologize for the offending action; instead they tell us they were not intending to do wrong and therefore should be forgiven.

When it comes to erroneously marking your product as being patented, admitting it as an honest mistake is not enough to save you from penalty. Instead your must be able to demonstrate that your company had a good reason to believe the product actually fell within the marked patent number. Read "It was an honest mistake" to learn more.

• Balancing Intentions and Actions

Don't walk the tightrope. Abdicating your management responsibility to someone who doesn't understand the patent laws won't absolve you of liability associated with the falsifying action, no matter how good your intentions.



Acting as your Director of Intellectual Property, TechRoadmap can build your IP database that you can use to link your products to their underlying patents, helping you show your good-faith effort to avoid misrepresentation.

• It was an honest mistake.

Many times, when a company is in a jam, management appeals to our natural inclination to **forgive and forget**, as long as it appears no malice was intended. "Mistakes are made" we say in the passive, no-one-to-blame, voice. But a recent court ruling shows that when it comes to falsely marking your product as patented, the court will require **concrete evidence that you really believed those patents covered your product.**

The details of the particular case (Clontech v. Invitrogen) are complex, but the underlying principles are clear and simple. As we have often said, the patent system is essentially a contract between society and the inventor and, as in most contracts, there is a **presumed fairness and quid-pro-quo between the parties.**

With regard to patent marking, the patent holder is **allowed and encouraged to mark his products with the applicable patent numbers.** On his side of the fairness ledger, marking his products allows him to collect up to treble damages for **willful infringement** since the infringer can't say he wasn't warned about the patented state of the product. On society's side, competitors **don't waste time and money** copying what they think is in the public domain, only to find out at a later date that it is patented.

Invitrogen is the owner of 4 related patents and the manufacturer of a range of products. Apparently, they indiscriminately marked all the products with all four patent numbers. Unfortunately, at least some of the products were not covered by the patents.

According to statute, **when an unpatented article** (an article not covered by at least one claim of each patent with which the article is marked.) **is marked so as to suggest the article is patented, and such marking is for the purpose of deceiving the public, a fine is invoked.**

Invitrogen suggested that the extra patent marking served the purpose of the law and that it should not be illegal to provide *more than the minimum* information. But the court said "No", federal patent policy recognizes an **"important public interest in permitting full and free competition in the use of ideas** which are in reality a part of the public domain." That interest is "clearly injured by false marking because the act of false marking misleads the public into believing that a patentee controls the article in question, externalizes the risk of error in the determination, and increases the cost to the public of ascertaining whether a patentee in fact controls the intellectual property embodied in an article."

• Tip of the Month

Remember that actions speak louder than words - the courts will consider what you do not what you say :

- **Don't delude yourself** - if you put a patent number on a product, everybody knows you're doing it for your benefit, Don't pretend otherwise.
- **Build in a reference**- Somewhere in your engineering documentation make a reference to what patents and what claims you think apply.
- **Maintain a database** - track the assemblies in which your IP is embodied so you can quickly update patent markings on finished products

• Disclaimer

Nothing in this newsletter should be construed as legal advice. TechRoadmap serves as an interface between companies and their legal counsel.