

July 16, 2014

The Honorable Michelle K. Lee
Deputy Under Secretary of Commerce for Intellectual Property and
Deputy Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22312

Via email: virtualmarking@uspto.gov

**Re: Response to the Notice of Request for Comments on Virtual Marking
79 Fed. Reg. 34291 (June 16, 2014)**

Dear Deputy Under Secretary Lee:

The American Intellectual Property Law Association (AIPLA) is pleased to have this opportunity to present its views with respect to the United States Patent and Trademark Office (“Office”) Notice of Proposed Rulemaking entitled “Request for Comments on Virtual Marking” as published in the June 16, 2014 issue of the Federal Register. 79 Fed. Reg. 34291 (“Notice”).

AIPLA is a national bar association with approximately 15,000 members who are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, and copyright law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

U.S. patent law limits the availability of damages in an infringement suit by requiring that the alleged infringer had notice of the claimed infringement. Patent owners may provide constructive notice by complying with the patent marking requirements of 35 U.S.C. 287(a), or they may provide actual notice, as with an affirmative communication or the filing of a lawsuit. However, the failure to properly mark an article can limit damages to those infringing acts occurring after notice.

Section 16(a)(1) of the Leahy-Smith America Invents Act (AIA) amended the patent marking requirement to permit the placement of the term “patent” or “pat.” on the patented article together with a publicly accessible Internet address that associates the article with its corresponding patent number. The intention of the amendment was to save costs for producers of products that include technology on which a patent issues after the product is on the market, and to facilitate effective marking on smaller products.

Section 16(a)(3) of the AIA also requires the Office to submit a report to Congress three years after the date of enactment providing the following:

- (A) An analysis of the effectiveness of “virtual marking” as an alternative to the physical marking of articles;
- (B) An analysis of whether such virtual marking has limited or improved the ability of the general public to access information about patents;
- (C) An analysis of the legal issues, if any, that arise from such virtual marking; and
- (D) An analysis of the deficiencies, if any, of such virtual marking.

In the June 16, 2014 Federal Register Notice, the Office requests public input to aid in drafting its report to Congress on virtual marking. It seeks comment on the use of virtual marking as an alternative to physical marking for providing notice to the public that such articles are subject to patent protection.

Although some AIPLA members reported use of the virtual marking option, it is not clear how wide spread use of this new alternative is. Members using this option noted that the flexibility virtual marking offers for updating the patent information (e.g., patent numbers) is a significant advantage to both the patent owner and the public.

It is a particular advantage for patent owners over the requirements of physical marking using patent numbers, which may require listing the numbers on an expensive mold and then require an investment in new molds merely to update the numbers. By contrast, virtual marking permits a physical marking of a single Internet address where the patent owner can update the relevant patent information on the Internet, and provide more real-time information and up-to-date notice concerning articles that may be protected by patent.

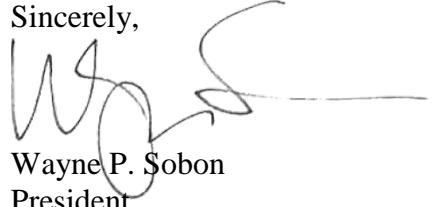
A concern some members have regarding virtual marking is the need to ensure that those using the virtual marking option provide an Internet address to publicly accessible information that is easy to obtain and that is available at no charge. In addition, the information should be accessible with no requirement to provide personal information or to sign up as a user of the information service.

To address the apparent relatively low use of virtual marking, we suggest the Office provide more educational information on the use of virtual patent marking and on the advantages this marking option offers. Increased knowledge and awareness of the advantages, for both patent owners and the public, may lead to more usage of this alternative. It would also be useful in this educational outreach to include information on physical patent marking, in particular that virtual marking continues to require a physical mark on the products to indicate “patent” or the abbreviation “pat.” together with a URL address. The education effort should also stress the ongoing need to update the online virtual marking information itself as a regular part of the company’s procedure for designing a new product or redesigning an existing product.

To further aid patent owners and the public in understanding patent marking, we suggest creating a post-issuance timeline similar to the “USPTO Patent Application Initiatives Timeline” available at http://www.uspto.gov/patents/init_events/patapp-initiatives-timeline.jsp.

AIPLA appreciates the opportunity to comment on virtual marking. We look forward to further dialogue with the Office on this topic.

Sincerely,

A handwritten signature in black ink, appearing to read 'Wayne P. Sobon', with a long horizontal line extending to the right.

Wayne P. Sobon

President

American Intellectual Property Law Association