



Marking Products as Patented in the UK

In the UK, marking patented products as patented is not compulsory. However, there are several benefits to marking products as patented and both guidance from the UK Intellectual Property Office, and UK law, effectively encourage this practice. However it is important for patentees considering marking their products as patented to ensure that this is done correctly because failure to do so can potentially lead to adverse consequences.

This briefing provides an overview of patent marking in the UK and some practice points for patentees to bear in mind when considering whether and how to mark their products.

Why Mark Products?

Patentees may seek to mark their products as being protected by patent for a variety of reasons.

The most common reason for marking a product as being protected by a patent is to increase the chances of financial remedies being awarded if a third party is found to infringe the relevant right(s).

Secondary considerations for some patentees include product marking primarily for marketing reasons, to demonstrate legitimacy and to encourage consumers to select one product over another. For example, in some markets, being able to refer to a patented product or process adds significantly to a brand's cachet - consider how many advertisements use phrases such as: "...*made according to our unique patented process*"; "*our patented formula leads to outstanding results*", etc.

Product marking may also play a defensive role. By clearly marking a product as being protected by patent, third parties may be dissuaded from seeking to commercialise competing products or processes in the first place.

The Legal Framework

In the UK, a patentee who can demonstrate that a third party has infringed a valid patent may be entitled to financial remedies, for example damages resulting from the infringement.

However, the UK Patents Act (UKPA) provides infringers with a defence to such claims. Thus, section 62(1) UKPA states that

"In proceedings for infringement of a patent damages shall not be awarded ... against a defendant or defender who proves that at the date of the infringement he was not aware, and had no reasonable grounds for supposing, that the patent existed..."

Patent marking is one way in which patentees seek to reduce the likelihood of infringers successfully relying on this so-called "innocent infringement" defence. Careful marking of a product as patented can ensure that a third party has no grounds for arguing that they were not aware, nor had reasonable grounds for

supposing, that the patent(s) at issue existed.

Unfortunately for patentees, the situation is not entirely straightforward. Thus, section 62 UKPA expressly states that it is **not** sufficient merely to mark a product as being "patented" (or equivalent language). Rather, this section expressly states that a person shall not be considered to be aware of the patent or to have reasonable grounds for supposing that it exists unless the product itself is marked with

"the number of the patent or a relevant internet link... (a) which is accessible to the public free of charge, and (b) which clearly associates the product with the number of the patent."

Therefore, in order to prevent potential third parties from claiming "innocent infringement" it is necessary for patentees to match the product with the number of the patent effective in the UK and which covers the product.

One way in which this is often done is by referring to an internet web-link providing details of the enforceable patent right(s) in question, which is sometimes referred to as "virtual patent marking". Virtual marking offers a cost-effective and flexible way of complying with the UK requirements and those of many other countries such as the US. The UK IPO has provided guidance on the form and content that such a web link should take for the purposes of the UK.[#]

It is important to note that not all countries accept virtual marking as sufficient to counter a defence of innocent infringement. For country-specific advice, feel free to contact us.

If allocating the product to a specific patent number is unattractive (for example because it is undesirable to make modifications to packaging or the product for different markets, or the administrative burden is too high), it is permissible to mark the product only as "patented" (or even "patent pending"). However, such marking does not prevent a third party from running an "innocent infringement" defence and still requires a degree of administration to ensure that the product so marked is covered by an enforceable UK patent.

Risks for Patentees

Given the advantages of patent marking, not least those arising from section 62 UKPA, it is not surprising that many patentees do seek to mark their products accordingly. However, patentees need to be aware of the risks associated with failure to mark products correctly.

One key risk for patentees arises from sections 110 and 111 UKPA. These sections specify that it is an offence to falsely represent that a product is patented or covered by a pending patent application. A patentee or applicant found to have done so can face summary conviction and a substantial fine.

It is important to note that the standard under section 62 UKPA is **not** the same as that under sections 110/111 UKPA. Thus, as discussed above, marking a product simply as being “patented” or as “patent pending” **may not** be sufficient to counter a potential third party “innocent infringement” defence. However, it **may be** enough to render proprietors liable under sections 110/111 UKPA.

Best Practice for Patentees

In view of the considerations above, patentees are advised carefully to consider whether and how to mark their products as being protected by patent. Circumstances will differ between patentees in view of the markets in which they operate and the likelihood of infringement proceedings, but the following guidance is typically applicable:

1. Patentees need to be careful to avoid sanctions for false marking. References to a product being “patented” or “patent pending” or to specific patents on products or weblinks should relate to *the enforceable right(s) at issue*. For example, in the scenario where an initial national application has been filed in order to establish a priority date, and subsequently allowed to lapse in favour of a priority-claiming PCT application that entered the national phase in Europe and following grant is in force in the UK, the enforceable right is the granted EP(UK) patent, *not* the PCT application or priority application.
2. Patentees seeking to prevent third parties from using the “innocent infringer” defence should ensure when marking products that *specific information* is given, either in the form of referencing specific patent(s), or to a specific web-link (not just the patentee’s homepage) with details of the patent(s) protecting any given product.
3. Products marketed in different countries may need *country-*

For more information, please contact:

James Cracknell - jcracknell@jakemp.com

specific markings. For example, patentees should typically avoid marking products with UK specific details if such products are also being marketed in countries where no patent protection exists. Similarly, patentees may not be able to rely in the UK on references to foreign rights (such as granted US patents), even if equivalent granted UK rights exist.

4. Patentees should bear in mind that patents remain in force only whilst regular annuities are paid, and until they expire. Patent markings or websites listing relevant patents must therefore be *kept up to date*, both to ensure that all relevant rights are appropriately disclosed, and to ensure that any lapsed rights are no longer referenced.
5. Patentees should also consider whether product marking needs updating *if the product itself changes*. For example, a change in product formulation may mean that a patent or patent application which covered the previous formulation no longer covers the new formulation.
6. It is not always easy for patentees to determine whether or not a specific product or process falls within the scope of the claims of a given patent. Patentees in any doubt should contact their usual contact at J A Kemp LLP, who will be happy to assess this and advise accordingly.

It is important to note that the benefits of product marking, and the consequences of incorrect marking, vary from country to country. The summary above relates to the situation in the UK, and should not be considered as representing the legal situation elsewhere.

Please speak to your usual J A Kemp contact for further information.

Footnotes

1. [UK IPO guidance](#)

Martin Jackson - mjackson@jakemp.com