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# IP INSIGHTS

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## Proper marking protects valuable IP rights

Owners of patents, trademarks and copyrights can greatly enhance their rights by marking products, advertising and promotional materials with the appropriate words or symbols.

"Marking products provides notice and warning to competitors who might otherwise assume a right to copy," said **Theodore J. Long**, an intellectual property attorney at Lathrop & Clark LLP. "Marking can also create and enhance the owner's right to damages from infringers."

For example, notice of a prospective patent can be given with the marking, "Patent Applied For" or "Patent Pending."

"However, such markings cannot be placed on an article until an application for patent has been actually filed in the U. S. Patent & Trademark Office (PTO), and must be removed in the event that all patent applications covering the product are finally rejected and abandoned," Long said. "Although not specifically required under patent law, such markings give fair warning that a manufacturer is seeking patent protection for a product."

Once a patent has issued, marking the word "Patent" and the patent number on the product provides public notice of the patent and the scope of its protection. In the absence of such notice, the patent owner can generally collect damages from infringers only for products sold after the infringer had actual knowledge of the patent.

Words, phrases, slogans and artistic depictions that distinguish a company's goods and services from the competition often function as a trademark or service mark. Placing those marks with appropriate notice on products and materials serves to alert the public to the owner's claims of exclusivity. For example, the symbol "®" signifies that the accompanying mark has been

registered as a federal trademark.

"Competitors normally avoid the use of marks that are confusingly similar to marks previously registered, or known to be in use by others, on any relevant goods or services," Long said.

Marks that are not registered, or for which registration is being sought, should be identified by the symbol "TM" or "SM".

"This provides notice that the person using the mark considers it to be a trademark or service mark, subject to rights of exclusivity when applied to particular goods and services," Long said.

A competitor may have the PTO database searched to determine whether the user has obtained or applied for a registration of a mark accompanied by the "®", "TM" or "SM" symbols. The search will reveal pending applications for trademark registrations, claimed dates of first use, the goods or services for which the mark is sought to be registered, and whether the application has been abandoned or is still pending.

Long said one of the advantages of applying for federal trademark registration is that the application immediately enters the national trademark database, and will be seen by other companies considering the adoption and registration of new trademarks. "In such cases, the existence of the application for registration may be as effective as an issued registration to deter others from adopting a similar mark for similar goods or services," he said.

The effect of using a trademark notice is similar to that of a patent notice. In any suit for infringement under the Trademark Act, failure of the registrant to give notice of the registration will preclude recovery of profits and/or damages, unless the infringer had actual notice of the registration.

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Notice of a copyright is also important in the assertion and protection of rights. Copyright protection attaches to any original works that are fixed in a tangible medium of expression, for example, literary works, music, plays, advertising, computer software, motion pictures and other audio-visual works. In today's commercial world, packaging, advertising and promotional materials, and instructional materials should be assumed to contain content protectable by copyright.

While federal law establishes copyright protection for all works at inception, registration is required for enforcement in the U. S. courts, and early registration can enhance the award of damages. The copyright notice, © or "Copyright" with the year date of first publication and the owner's name, should be attached to each work at the time of first publication and thereafter.

Long said the copyright notice serves two principal functions. First, it provides the viewer with notice of the claim of copyright in the work. Second, the notice of copyright can prevent a defense of innocent infringement in the mitigation of actual or statutory damages.

Falsely marking goods with the words "Patent Applied For", "Patent Pending" or "Patent" may be

punishable by a fine of up to \$500, which can be assessed per marked article. Any person, including a competitor or former disgruntled employee, may sue and receive 50 percent of any penalty assessed by the court. A fraudulent copyright notice may subject the perpetrator to a fine of up to \$2,500. A false notice of trademark registration could preclude legal registration or enforcement of the mark.

"The smart business takes advantage of all rights granted to patent, trademark and copyright owners," Long concluded. "That means all eligible products and materials must be clearly, but properly, marked."

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*Theodore J. Long is a member of the Patent, Trademark and Copyright Group at Lathrop and Clark LLP, where he counsels clients on patents, trademarks, copyrights, unfair competition, and the licensing of intellectual property. Long has been admitted to practice before the U.S. Patent and Trademark Office, and served as chair of the State Bar of Wisconsin's Patent, Trademark and Copyright Section. He is also past president and a current director of the Wisconsin Intellectual Property Law Association. Long is a member of the Dane County and American Bar Associations, and the American Intellectual Property Law Association. He received an undergraduate degree in mechanical engineering and a law degree from the University of Wisconsin.*

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