

Virtual Trademark Marking – An Idea Whose Time Has Come¹

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The Leahy-Smith America Invents Act (AIA)³, signed into law on September 16, 2011, was designed to establish a more efficient and streamlined patent system to improve patent quality and limit unnecessary litigation costs. The AIA made many changes to United States patent law, including an amendment to 35 U.S.C. § 287(a), the so-called “marking” statute. The amendment provides patentees with the option of using “virtual marking,” *i.e.*, affixing onto the article or its packaging the word “patent” or the abbreviation “pat.” followed by an address of a posting on the Internet that associates the patented article with the number of the patent.

Similarly, a registrant of a trademark needs to somehow give notice that a mark is registered, or forego some rights.⁴ Unfortunately, the requirements on trademark marking vary by country, and even more confusingly, there are a variety

¹ On résiste à l’invasion des armées; on ne résiste pas à l’invasion des idées, Victor Hugo, *Histoire d’un Crime* (1852)

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³ Public L. No. 112-29, 125 Stat. 284-341 (2011).

⁴ In the U.S, this is governed by 15 U.S.C. § 1111.

of registration marks in addition to the common⁵ ®, which vary by language, including "Marca Registrada" or "MR"⁶, and "Marque Déposée," "Marque de Commerce," or their abbreviations, "MD" and "MC".⁷

In today's economy, where commerce increasingly relies upon the Internet, it is almost impossible to understand what these marks refer to. Does a mark bearing a ® mean that the mark is registered in the US Patent and Trademark Office, or some other national office? What if you are viewing a website on a computer in one country, coming to you from a server in a second country, describing a product manufactured in a third country? Given the criminal statutes for false marking in some countries, this is not a trivial issue.⁸

Even for marks on product being sold only in the U.S. and domestically manufactured, the problem of how to give notice of registration is complex. There may be a belief that registration in a state or foreign country gives a right to use the ® registration symbol⁹; the registration might only be for of a portion of the mark¹⁰;

⁵ In addition to the United States, several countries recognize use of the symbol ® to designate registration: Belgium, China (People's Republic), Costa Rica, Denmark, Ecuador, Germany, Guatemala, Hungary, Luxembourg, and Netherlands, among others. This gives rise to ambiguity as to what the mark means.

⁶ In countries where Spanish is the dominant language.

⁷ In countries where French is the dominant language.

⁸ Germany, Brunei, India, Japan and Korea. The problem faced by global brands is explored here <http://www.blankrome.com/index.cfm?contentID=37&itemID=3194> (accessed April 7, 2015).

⁹ See *Brown Shoe Co., Inc. v. Robbins*, 90 USPQ2d 1752 (TTAB 2009); *Du-Dad Lure Co. v. Creme Lure Co.*, 143 USPQ 358 (TTAB 1964).

¹⁰ See *Coca-Cola Co. v. Victor Syrup Corp.*, 218 F.2d 596, 104 USPQ 275 (C.C.P.A. 1954))

registration of the mark might be for other goods¹¹; registration may have recently expired, been cancelled, or even been granted¹²; or the symbol relates to a second mark on the same label.¹³

The limited experience with virtual patent marking indicates that “[t]he use of Internet technologies for virtual marking allows patentees to dynamically update patent information without making expensive modifications to the manufacturing process, to provide a real-time, complete list of associated patents, and to include additional patent-related information.”¹⁴ There is every reason to expect that these same benefits will follow virtual trademark marking, and indeed a single URL might be used for both uses.¹⁵ As with virtual patent marking, by allowing trademarks to be listed on an easily and rapidly updatable Web page as opposed to listing them on the article or its labeling, should lead to much lower packaging cost.¹⁶

¹¹ See *Duffy-Mott Co., Inc. v. Cumberland Packing Co.*, 424 F.2d 1095, 165 USPQ 422 (C.C.P.A. 1970), *aff’d* 154 USPQ 498 (TTAB 1967); *Meditron Co. v. Meditronic, Inc.*, 137 USPQ 157 (TTAB 1963).

¹² See *Rieser Co., Inc. v. Munsingwear, Inc.*, 128 USPQ 452 (TTAB 1961)). On December 30, 2014, Target Brand’s registration for the house mark “up & up” arrow issued No. 4,664,130. Extensive number of pre-registration product is undoubtedly still on the shelves, months after registration.

¹³ See *S.C. Johnson & Son, Inc. v. Gold Seal Co.*, 90 USPQ 373 (Comm’r Pats. 1951)).

¹⁴ REPORT ON VIRTUAL MARKING 2-3, United States Patent & Trademark Office (September 2014, hereinafter “REPORT”))

¹⁵ This is the approach used by at least one company, *e.g.*, <http://www.spacelabshealthcare.com/patents-trademarks#.VSRa51y8l7k> (accessed April 7, 2015).

¹⁶ See Corey McCaffrey, *The Virtues of Virtual Marking in Patent Reform*, 105 NW U.L. REV. 367, 369 (2011); *see also* *Pequignot v. Solo Cup Co.*, 608 F.3d 1356, 1359 (Fed. Cir. 2010) (citing high cost of recasting molds, which left patent number imprint in plastic drink cup lids, was a deterrent to contemporaneously removing patent numbers from the lids on date of patent expiration).

Virtual Trademark Marking Would Increase the General Public's Access to Information About Trademarks

Unlike physical patent marking, physical trademark marking contains no information whatsoever as to the associated registration number, *e.g.*, it is limited to a symbol such as ®. Virtual marking would result in greater public information, since the trademark registration number would be supplied at the indicated URL. The public would then know which country had issued the registration, and be able to examine the registration online. While it is true that lack of Internet connectivity in a particular location or interruptions of Internet service might render a server hosting a virtual marking Web page inaccessible, this must be contrasted with the status quo for trademarks, which is the complete absence of information.

Privacy Can Be Protected

In its Report to Congress, the USPTO noted that some comments about virtual patent marking were directed to the possibility that through “cookies” or other page analytics or roadblocks, patent holders could require members of the public to provide personal information to register or create a personal account in order to gain access to its content, or otherwise store information about the user accessing the Web page, such as logging IP addresses.¹⁷ With the benefit of hindsight, this unwanted tracking can be excluded with a simple adjustment in the enabling legislation, as shown below.

¹⁷ REPORT, *supra*, 15-16.

Proposed Legislation

While a virtual marking statute in the U.S. would not solve the international problem for global brands, it would go a long way in serving as a laboratory for virtual marking, and if successful in reducing confusion and lowering costs, international harmonization should be expected. To that end, a simple amendment to the U.S. marking statute, Section 1111 of title 15 would do the trick. As amended, the statute would read, harmonized to the language of the recently amended patent marking Section 287, as follows:

Notwithstanding the provisions of section 1072 of this title, a registrant of a mark registered in the Patent and Trademark Office, may give notice that his mark is registered by displaying with the mark the words "Registered in U. S. Patent and Trademark Office" or "Reg. U.S. Pat. & Tm. Off." or the letter R enclosed within a circle, thus ®, *or an asterisk, thus *, together with an associated asterisk and address of a posting on the Internet, accessible to the public without tracking or charge for accessing the address, that associates the trademark with a registration number*; and in any suit for infringement under this Act by such a registrant failing to give such notice of registration, no profits and no damages shall be recovered under the provisions of this Act unless the defendant had actual notice of the registration. *(emphasis added to indicate amendment language)*

A proposed Bill to accomplish the amendment is in the Appendix.

Appendix

A BILL

To amend title 15, United States Code, to provide for virtual trademark marking.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,

SECTION 1. SHORT TITLE

This Act may be cited as the “Virtual Trademark Marking Act”.

SEC. 2. VIRTUAL NOTICE OF REGISTRATION.

Section 1111 of Subchapter III of Chapter 22 of title 15, United States Code, is amended as follows, by inserting after the text “thus ®” and before the semi-colon,

“, or an asterisk, thus *, together with an associated asterisk and address of a posting on the Internet, accessible to the public without tracking or charge for accessing the address, that associates the trademark with a registration number”.