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Mark My Words: Financial Benefits of Virtual Patent Marking

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November 17, 2021



Fascinated by chemistry and the process of ideation, creation, testing and improvement, Adam Baechler worked as a materials and process engineer while earning his degree in chemical engineering. He brings his technical knowledge and skill, along with his ability to speak the language of inventors, to defending clients' intellectual property assets.

Adam performs legal research and drafts memoranda addressing patent misuse and divided infringement, provides comprehensive technical analysis for patent clearance opinions, and responds to actions relating to chemicals, software, control systems, and medical devices. He also accesses and reports on patentability and freedom to operate.

While earning his law degree, Adam worked with three Chicago law firms. In those roles, he drafted memoranda outlining Alice analysis prongs, a provisional patent application for an organosilane-based sealant system, and claims for a thermal process control scheme, cellular applications, and chemical additives.

Adam gained additional experience prior to law school as a process engineer with two major U.S. chemical companies in their fluoroelastomer and aramid divisions. He spearheaded process improvements that were valued in excess of \$250,000, oversaw plant and related operations, and developed testing procedures to release over \$500,000 worth of inventory. Additionally, Adam managed distributed process control system changes, including numerous upgrades of bulk property monitoring sensors and software.

Outside of his practice, Adam enjoys acrylic painting, woodworking and woodturning, cooking, and working on his diesel truck.

Adam is not regularly admitted to practice in the local courts of Illinois.

Honors

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EDUCATION

Chicago-Kent College of Law, (J.D.), certificate in intellectual property, associate editor of Chicago Kent Journal of Intellectual Property, member of Intellectual Property Law Society of Chicago-Kent, Dean's List

Drexel University, (B.S.), chemical engineering, Dean's List

LANGUAGES

English

PRACTICES

Intellectual Property





Valued by clients and colleagues alike for her responsiveness and in-depth technical and scientific knowledge, education and training, Joan Kluger works diligently with her clients to make critical strategic decisions surrounding valuable intellectual property assets.

With extensive global patent and trademark prosecution, maintenance and enforcement experience, Joan helps her clients to devise tactical, comprehensive plans regarding their intellectual property holdings and market objectives.

Joan draws upon her prior research and development experience in the aeronautics, telecommunications and semiconductor industries and her educational background in physics to assist clients in realizing their commercial objectives. Joan provides a diverse clientele with patent procurement advice in the electrical, mechanical, chemical process and computer fields.

Notably, she helps clients obtain patent protection of software-implemented inventions. Joan has patented inventions directed to autonomous driving technology, artificial intelligence, integrated circuit manufacturing processes, energy production systems, medical devices, videography equipment, and industrial manufacturing equipment, among other technologies.

Joan works diligently with clients to assure their brands are protected through domestic and foreign trademark registration, portfolio management, licensing and enforcement against infringers.

Professional and Community Involvement

Advisory Board member, Delaware Law School

Former co-vice chair, Delaware State Bar Association E-Discovery and Technology Law section

Member, Delaware State Chamber of Commerce Economic Development

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EDUCATION

Delaware Law School, (J.D.)

University of Delaware, (M.S. physics
coursework completed)

Johns Hopkins University, (B.A.)

BAR ADMISSIONS

Delaware

New Jersey

Pennsylvania

U.S. Patent and Trademark Office

COURT ADMISSIONS

U.S. District Court for the District of
Delaware

U.S. District Court for the Eastern
District of Pennsylvania

U.S. Supreme Court

LANGUAGES

English

PRACTICES

Entrepreneurial and Emerging
Companies

Intellectual Property

International IP

IP Strategy and Management

Licensing

Mergers and Acquisitions - Intellectual
Property

Committee

Adviser, Patent Pro Bono Program; worked with the Delaware Law School to create the program

Former professor/teacher, university-level physics

Former adjunct patent law professor, Delaware Law School

Former member, Technology Transfer Practice Manual Editorial Committee, Association of University Technology Managers

Former board member, Philadelphia Intellectual Property Law Association

Former member, U.S. Patent and Trademark Office Semiconductor Partnership Committee

Former member, Delaware Children's Museum Advisory Board

Honors

The Best Lawyers in America, 2022

Managing Intellectual Property IP Stars, Patent and Trademark Star – Delaware, 2019-2020

Managing Intellectual Property IP Stars, Patent Star – Delaware, 2021

Opinions

Patent Services - Counseling and Prosecution

Technology Transactions

Trade Secrets

Trademark Litigation and Unfair Competition

Trademark Oppositions and Cancellations

Trademarks

INDUSTRIES

Telecommunications



Grant Peters serves as intellectual property law general counsel with a dedication to providing comprehensive tactile counsel for large and middle-market companies seeking to protect, leverage and monetize their creativity and intangible assets. With broad national and international skills, he focuses on IP coordination, development, prosecution, management, protection, licensing and enforcement for companies involved in a wide array markets and technologies.

Grant counsels clients on patent, trademark and copyright prosecution; patent and trademark clearance, validity and infringement opinions; trademark opposition and cancellation; IP due diligence investigations, licensing and audits; and internet issues. His patent prosecution practice involves mechanical, electromechanical, system, business methods and design patents. Grant has filed, prosecuted and secured thousands of patents and trademarks domestically and internationally, and uses that experience to counsel clients on IP strategies, risk management and portfolio design, coordination and management.

Whether Grant is answering a spontaneous question or resolving a difficult problem, he works to provide practical and cost-efficient legal counsel. He is committed to designing solutions that are grounded in what is right for each client's specific business, needs and budget. Grant is valued by clients and colleagues for his intellectual acuity and ability to navigate the broader landscape of a challenge or obstacle.

Grant strives to serve as a calming force in support of thoughtful, 360-degree problem-solving, and is recognized for his high level of diplomacy and discretion. His in-depth analysis and tireless focus on developing and tailoring client and situation specific solutions is appreciated in his long-term client relationships. These same clients also value Grant's broad and multifaceted institutional knowledge and memory of their business and technology space.

He has experience and skill as a legal analyst and translator of legalese as applied to technology and other creative innovations. Grant's diverse industry experiences include: beverage and food technology and

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EDUCATION

Loyola University Chicago School of Law, (J.D.)

University of Iowa, (B.S.), engineering

BAR ADMISSIONS

Illinois

U.S. Patent and Trademark Office

COURT ADMISSIONS

Illinois Central District Court

Illinois Northern District Court

U.S. Court of Appeals for the Federal Circuit

U.S. Court of Appeals for the Seventh Circuit

U.S. Supreme Court

LANGUAGES

English

PRACTICES

Advertising and Marketing

Chinese Services

Climate Change

Copyrights

Corporate

Data Security and Privacy

Entrepreneurial and Emerging Companies

branding; aerospace components and systems; human and animal grooming devices and products and their branding; commercial architectural lighting systems, designs and LED applications; retail and hospitality; green tech; sustainable and fair trade products; branding issues for distillers and growers; internet of things devices; and Native American business IP issues.

Prior to practicing law, Grant worked as an engineer and patent specialist for Interand Corporation, a developer and manufacturer of video graphic teleconferencing systems, where he worked as an engineer and an IP liaison. He also worked for Rockwell International Corporation in the areas of commercial and general avionics and printed circuit board design and production. Having worked in-house, Grant has the perspective to understand his client’s daily priorities and is dedicated to being a partner to help manage their risks and cultivate opportunities within their business operations and across the relevant markets.

He is a former adjunct faculty member Loyola University Chicago School of Law, where he taught intellectual property law.

Professional and Community Involvement

Member, American Bar Association Section of Science and Technology Law’s Internet of Things Committee

Member, Industrial Designers Society of America

Member, Institute of Electrical and Electronics Engineers’ Internet of Things Community Group

Member, Licensing Executives Society

Board of trustees member and former vice president, Chicago Sinai Congregation

Member, Chicago Sinai Congregation House Committee, Interfaith Committee, Islamic Relations Group, and Social Action Committee

Former board member, Boy Scouts of America-Chicago Area Council

Former board member, Suzuki-Orff School of Music

Volunteer, Cabrini Green Tutoring, Habitat for Humanity and Hurricanes Katrina and Sandy relief projects

Honors

Illinois Super Lawyers, 2005-2006

The Best Lawyers in America, 2013-2022

- Intellectual Property
- International IP
- IP Strategy and Management
- Licensing
- Mergers and Acquisitions - Intellectual Property
- Nanotechnology
- Native American Law and Policy
- Opinions
- Patent Interferences
- Patent Litigation
- Patent Services - Counseling and Prosecution
- Post-Grant and Inter Partes Review
- Software and Technology Transactions
- Technology Transactions
- Trade Dress
- Trademark Litigation and Unfair Competition
- Trademark Oppositions and Cancellations
- Trademarks
- 中国客户服务

INDUSTRIES

- Charter Schools and School Innovation
- Education



Irina Sullivan devotes most of her time to managing patent portfolios for small and mid-size technology companies, including developing and executing effective patent prosecution strategies that directly support companies' immediate and long-term business and innovation objectives.

Critical to Irina's work is her ability to build relationships with the individuals who are at the heart of every business' patent portfolio building success, the engineers and scientists who identify challenges and devise technical solutions to overcome them. To that end, Irina collaborates with these technology leaders on creative ways to ensure regular and unimpeded flow of ideas in their roles within their companies.

In the course of her practice, Irina has prepared and prosecuted patent applications across a variety of areas, including telecommunications and networking, Internet of things (IoT), augmented reality environment implementations, computational and numerical methods and models, machine learning, encryption and identity verification solutions, speech recognition and natural language processing, antenna design, semiconductor fabrication methods, and embedded system design.

As an engineer-turned-patent attorney, Irina has been and remains deeply passionate about careers in STEM, particularly toward educating and encouraging girls and young women to move that direction. In addition to and in support of the advancement and professional growth of early- and mid-career women engineers, she speaks candidly about her journey to becoming a patent attorney in the hopes of inspiring and motivating women like her.

Before joining Barnes & Thornburg, Irina practiced at a bicoastal IP boutique law firm. Prior to law school, Irina amassed more than five years of engineering experience with General Motors Corporation as a service engineer conducting advanced serviceability planning for chassis subsystems and as a brand quality manager for hybrid and electric drive propulsion systems.

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EDUCATION

Wayne State University Law School,
(J.D.), 2014

University of Michigan, (M.S.), electrical
engineering, 2009

Kettering University, (B.S.), electrical
engineering, 2006

BAR ADMISSIONS

Illinois

Michigan

U.S. Patent and Trademark Office

LANGUAGES

English

Russian

PRACTICES

Chinese Services

Intellectual Property

中国客户服务

INDUSTRIES

Telecommunications

Professional and Community Involvement

Marketing committee member, Chicago Women in IP (ChiWIP) 2020-2021

Member, Federal Bar Association

Membership development chair, Institute of Electrical and Electronics Engineers (IEEE) Southeastern Michigan (SEM) Section 2018-2019

Vice chair, IEEE SEM Women in Engineering Affinity Group 2017-2018

Member, Society of Women Engineers

Presenters



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What is Virtual Patent Marketing?

- Virtual Patent Marking offers an **alternative** to complying with a public notice and marking requirement that typically requires listing on each product the numbers of patents that cover that product.
- In short, **marking virtually** means marking the product with a website address that directs consumers to a dynamic listing of patents and the products they protect.
- This allows the patent portfolio to be **regularly updated** without having to, among other things, retool production equipment every time a patent reference changes, such as when a patent issues or expires, or when a product design change means that a given patent no longer covers that product.

Why does “notice” matter?

- Patent marking – “constructive notice” or “actual notice” is required to recover damages. 35 U.S.C. §271(a).
- Patent marking deters infringement.
- Attorneys and litigation funding entities typically only take patent infringement cases if products have been marked.
- Proof of a disciplined marking program could provide value in litigation funding and licensing.
- Patent portfolio value is greater with a disciplined patent marking program.
- Proof of marking could be required in M&A due diligence if the enforceability of the portfolio is important.
- Possible avoidance of issues by other parties infringing.
- Other parties can see portfolio and use it to avoid infringing, chill the competition.

What are the minimum requirements for VPM?

1. Mark with an address of a posting on the Internet. Example: [www.\(Owner\).com/patents](http://www.(Owner).com/patents)
2. Make it accessible to the public without charge for accessing the address.
3. Associate the relevant patent number with the patented article(s).
4. Do not mark in a way that is false or misleading.

What kind of information should be on the website?

- First, at least a listing of **the issued** US patents for which the owner wants to provide constructive notice.
- Second, enough information such that a party can ***easily and sufficiently*** identify which of these patents cover which particular products.
- Third, the website page should include **contact information** in case more information is needed.

Virtual marking sounds like a lot of effort, why go through that?

- Virtual marking simplifies patent marking.
- Easily associate products with multiple patents.
- Eliminate need to add or remove patent numbers to or from products.
- Virtual marking simplifies ending marking when patents expire or are deemed invalid.

Suggested Procedure

1. Generate a list of products with brief descriptions.
2. Create a list of patents with titles and abstracts.
3. Match patents to products.
4. Have patent counsel evaluate the patent claims against the products.

Do I need to make changes to the current marking on my products and/or packaging?

- Yes, but it doesn't have to happen overnight.
- Need to transition to the "virtual patent marking" address on product/packaging.
- Need to have the list on the website to avoid any lapses in marking.
- Depending on the current marking process.
 - Continue with current marking and make running changes from time to time (molds, stamping, other tooling, packaging printing).
 - Tell vendors you are making the change so they can flag windows to make changes.
 - Update information printed on a dataplate to use the web address.
- Use the current marking as a way to populate and check the list at the website.

Once a patent expires what do I need to do?

- The list at the website can be maintained to different degrees of specificity.
- Add a patent number when the patent issues.
- Delete the patent number when:
 - The patent expires at the end of its natural term, 20 years from the filing date (+/-).
 - The patent is allowed to lapse before its full term by not paying maintenance fee.
- Depending on strategy, can also mark:
 - Patent pending.
 - Publication number.
 - Leave patent number on the list and mark it “Expired” when it expires at the end of its natural term, up to 6 years after expiration.

What about my international patent markings?

- Include all foreign patents on the website.
- Ensure each foreign patent is correctly identified to cover each product.
- Products manufactured in foreign countries, imported into the US and covered by US patents, should be marked with the US patents.
- Or Products made in the US, exported to countries in which there are patents covering the products, should be marked with the foreign patents.
- International marking law varies greatly and conducting appropriate inquiry to ensure compliance with applicable legislation, case law, and local rules may be necessary.

Is there anything else I need to include in the VPM list on my website?

- List products and identify patents embodied in each products.
- Identify products as clearly as possible. Consider whether the description leaves room for an infringer to claim the correspondence was not clear.
 - Product name.
 - Product number.
- Include notice that content may change and may not be up to date.
- Include notice that webpage may be unavailable on occasion without notice due to maintenance or outages.
- Inform the reader that the information is being provided pursuant to 35 U.S.C. §287(a) to provide notice of [PATENT OWNER'S] rights

What about my product development, marketing, and communication teams?

- Talk to them early in the plan to transition to virtual patent marking.
- Explain the benefits of moving to virtual patent marking.
- Discuss and document the internal review process, approvals required, and time required to change markings.
 - Physical products – molds, stamping, printing.
 - Packaging –runout period.
- Discuss and document the process to update the list posted on the website.
 - Updating cycles or on demand.
- Use of a specific patent number or virtual marking for press releases.
- Provide/ negotiate a transition deadline.

Cases were mentioned, what are the courts saying about virtual patent marking?

- The biggest issue that has been litigated is the sufficiency of the webpage listing the patents.
 - **Takeaway:** The webpage must list all patents that cover the product in such a way that a consumer can easily determine which patents cover the product.
- Litigation has focused on avoiding a “research project” where consumers must search for the patent covering their product on the website.

QUESTIONS?

Submit through the chat window!

ACKNOWLEDGMENT & DISCLAIMER

These materials were prepared by the attorneys at the law firm of Barnes & Thornburg LLP. These materials present general information about Indiana law and federal law, and they only serve as a beginning point for further investigation and study of the law relating to these topics. Although these materials present and discuss labor and employment law issues, they are not intended to provide legal advice. Legal advice may be given and relied upon only on the basis of specific facts presented by a client to an attorney. Barnes & Thornburg LLP and the authors of these materials hereby disclaim any liability which may result from reliance on the information contained in these materials.