



Is Patent Marking the Patent Owner's Right or Statutory Duty? – A comparative study of U.S. and Chinese Laws in Recovering Damages Prior to Litigation

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Abstract : Patent marking refers to the act of a patent owner printing or including the relevant patent number on the goods she sells. Imagine that a patentee is selling her products in the United States and China. She obtained patents in both countries but did not mark the goods with patent numbers. Someone else sells identical products in both countries, infringing on the patent rights. The patentee sues the infringing party in the United States and in China. The infringing party immediately stops selling the identical products. Contrary to her belief, even if the patentee wins the suit, she cannot recover any damages in the United States but can in China. The outcomes of the above scenario are common and are contrary to conventional wisdom. This article compares patent marking and related statutes in the U.S. and China, presents several cases in both U.S. and China, and concludes the review by providing recommendations of some best practices for patent owners.

I. Introduction

Patent marking statutes impose limitations on past damages entitled to a patentee as a result of an infringer's patent infringement activities for a period of time before the patentee sues the infringer. Under the U.S. patent marking statutes¹, a patentee suing an infringer for patent infringement may be entitled to a recovery of past damages for up to six years before the filing of the suit if the patentee has provided the accused infringer with either a constructive notice or an actual notice. While the actual notice entails either a notice letter from the patentee to the accused party identifying the patent number or the filing of the complaint, the constructive notice may be satisfied if the patentee has complied with patent marking. If the patentee has not complied with patent marking for any period of time during which her product was infringed, then the past damages are limited. In a scenario when a patentee gave no actual notice other than the filing of the complaint itself, and if

complaint itself, and if in addition, the patentee did not comply with patent marking prior to the filing of the complaint, the patentee would not be entitled to any past damages.

In China, patent marking statutes² are drastically different from their U.S. counterparts: a patentee has the right to mark her patented product or the package of said product with the patent number, but is not required to comply with patent marking in order to collect past damages³. The China National Intellectual Property Administration (CNIPA) promulgated the "Measures for Patent Marking"⁴ and the "Guidelines for Investigating Conduct of Patent Counterfeiting and Handling Cases of Irregular Patent Marking"⁵ in 2012 and 2020, respectively. The Measures and the Guidelines have refined the ways that patentees and their licensees can mark patents, and imposed penalties for non-compliance and counterfeit markings. In the Measures and Guidelines, however, patent marking is not directly related to litigation

directly related to litigation damages nor is it a precondition for requesting damages prior to a litigation. When applying Chinese law to the scenario earlier in this section, the patentee is entitled to past damages, regardless of whether or not the patentee marks her products.

The remainder of this article discusses the key elements of patent marking in the U.S. and equivalent counterparts in China. In addition, this article discusses statutes related to patent marking, such as provisional rights and false marking, followed by the authors' recommendations of best practices to patent holders.

II. Affirmative act of the patentee

A patentee's affirmative act highlights key differences between the statutes in the U.S. and China. In the U.S., a patentee's affirmative act with respect to patent marking is a burden imposed on the patentee to consistently and continuously mark her products as a constructive notice to the infringer. A lack of such affirmative act of the patentee is a non-compliant with the patent marking or a failure of constructive notice.

*Radware, Ltd. v. F5 Networks, Inc.*⁶ and *American Medical Systems Inc. v. Medical Engineering Corp.*⁷ provide examples of the extent of a patentee's affirmative act for full compliance with the constructive notice requirement. In *Radware*, the patentee virtually marked "some but not all" of its products, and the court held that "merely encouraging a customer to buy a marked ... product in combination with the unmarked ... products is not sufficient to constitute constructive notice." Similarly, in *American Medical Systems*, subsequent to the issuance of the patent, the patentee continued selling the stocked unmarked products before selling marked products months later. Although the patentee started marking the goods with the new patent number (without distribution) while selling the stocked unmarked products, the court held that compliance was not achieved because marking products alone, without distribution, is irrelevant when "ship[ping]...unmarked products ... continues to mislead the public into

mislead the public into thinking that the product was freely available." *Id.*

In the U.S., a patentee's affirmative act cannot be waived by the infringer's knowledge or act. An infringer's knowledge is irrelevant to whether a patentee has given a constructive notice, and is not a substitute for the patent marking requirement. In *Arctic Cat*⁸, the infringer was found willfully infringing, thus, the patentee argued that the willfulness, as an indication that the infringer knew about the patent and her infringement, should be sufficient to establish an actual notice. The court, however, denied that argument because the infringer's knowledge turns on the knowledge of the infringer but is not directed to the conduct of the patentee.

In China, an affirmative act is not required of a patentee. Instead, an infringer's knowledge about a patent is presumed when the patent is granted because the publication of the issued patent is accessible to the public. In other words, the publication of a patent is deemed to constitute a similar effect of "constructive notice" given to all potential infringers. Thus, an infringer knows or should know that her actions may constitute infringement, and bears the corresponding infringement liability.

The context of affirmative act in patent marking usually arises in Chinese cases when an accused infringing party excuses itself from infringement liability for not knowing the existence of the patentee's patent rights because of the patentee's failure to mark her products. However, this type of arguments does not usually prevail. For example, in *Ju Aijun v. Shandong Wucheng Gubeichun Group Company*⁹, the court held that "the right to mark is a right and not an obligation of the patentee. The patentee can exercise the patent marking right and can also waive the right." The court held that whether the patentee exercises her right to mark has no effect on determining the infringement liability.

The completely different paths in patent marking in the two countries stem from the policies behind each country. The U.S. patent system tends to encourage technological innovation and the public interest over granting monopoly patent rights¹⁰, whereas China currently chooses to preferentially protect the latter by not

to preferentially protect the latter by not imposing substantial burdens on the patentee. This difference reflects different stages of industrial development and intellectual property protection in the two countries.

III. Provisional Rights

Provisional rights are related to patent marking and are available in both the U.S. and China. Provisional rights allow a patentee to recover from past damages during a period when the patent application was still pending, between the publication of the patent application and the granting of the patent. In both countries, in order for provisional rights to apply, the claims in the patent application must be substantially identical to those in the issued patent. However, provisional rights statutes in U.S. and China differ in terms of the notice requirement.

In the U.S., provisional rights¹¹ differ from patent marking in that it requires that the *infringer* had “actual notice” or knowledge about the patent as opposed to requiring the *patentee* to have given notice (whether constructive or actual) through patent marking. Although the “actual notice” of an infringer with respect to patent rights does not explicitly require any affirmative act on the patentee with respect to patent marking, it is not to be viewed as more relaxed than the “constructive notice.” For example, in *Rosebud LMS Inc. v. Adobe Sys.*¹², the court reiterated the rule of no requirement of affirmative act on the patentee. Nevertheless, the court ruled in favor of the infringer because the patentee’s evidence did not show that Adobe had actual knowledge of the published patent application in suit¹³.

In China, provisional rights statutes¹⁴ seem consistent with patent marking statutes in that no “actual notice” or affirmative act of the patentee is required. The past “damages” for provisional rights may also be calculated from the date of the publication of the invention patent application, for which the applicant may require the entity or individual exploiting the invention to pay an “appropriate fee.” The “appropriate fee” could be reasonably determined by referring to the patent royalty in practice, which is different from actual damages. The rationale is that the aim of

The rationale is that the aim of provisional rights is to offset, rather than compensating for the patentee’s losses. In determining the “appropriate fee,” the court may additionally consider if the provisional use of the patented solution involves improper purposes of the infringer, such as maliciously obtaining market share and excluding competitors.

IV. Patent marking method and false marking

Full compliance with the patent marking statutes additionally includes following proper marking methods and failure to do so may trigger false marking. In the U.S., patent marking requires a patentee to mark a product either physically or virtually. The patentee may print “Patent” or “Pat.” along with the patent number associated with the product directly on the product or on the package. Whether the patent number should be marked on the product itself or on the package depends on the circumstances, such as, (i) whether it is feasible to mark on the product; (ii) the custom of the trade in terms of the method of marking; or (iii) whether the expense of marking on the product is too costly. The test for whether patent marking is sufficient is whether “notice to the public has been provided that the article is patented.”¹⁶

Virtual marking only became available under the America Invents Act (AIA). Virtual marking allows a patentee to provide an address to a webpage that lists the patents associated with the product, instead of affixing the patent number on the product or package.

Under the U.S. false marking statutes¹⁷, the acts of false marking include counterfeiting the mark of the patentee or inducing the public to believe that the product was made, offered for sale, or imported into the U.S. by or with the consent of the patentee. The acts also include marking an unpatented article with the word “patent” or marking an article with “patent pending” or alike when no patent application has been filed. One of the key elements for deciding whether a patentee has constituted false marking is to show whether the patentee has the intent to deceive the public. For example, marking with expired patents alone,

deceive the public. For example, marking with expired patents alone, without showing intent to deceive the public, is not an offense. In *Arcadia Mach. & Tool, Inc. v. Sturm, Ruger & Co.*¹⁸, inadvertent errors and omissions in patent notices, listing patents which products “may be manufactured under” are held not to be false marking, in absence of evidence of intent to deceive. In contrast, in *Clontech Labs., Inc. v. Invitrogen Corp.*¹⁹, the patentee found her products are not covered by the subject patent, yet did not correct her mismarking. The court held that the party acted with sufficient knowledge of marking an unpatented article, giving rise to intent to deceive.

The fine for false marking in the U.S. is up to \$500 per falsely marked article²⁰. There is not jail time. The fine can make a huge difference when large quantities of products are involved. For example, in *Presidio Components, Inc. v. American Technical Ceramics Corp.*²¹, the court fined Presidio \$0.35 per article for 651,675 falsely marked BB capacitors. This penalty is summed to a total of nearly \$230K, approximately 32% of Presidio’s average sales price.

In China, a patentee may clearly mark on her patented product, the package of said product, or the documentation of said product (e.g., product manual) with the patent type and patent number²². For a pending patent application, the patent applicant should label in Chinese the type of patent application, the patent application number, and a statement “patent pending, not issued yet” to constitute proper patent marking²³. Under other statutes, the Chinese Advertisement Law²⁴ prohibits advertising by using pending patent applications and invalid patents, and accordingly the patent applicant cannot include information about the patent application in her advertisement of the product. Further, virtual marking is not applicable in China, but proposals for virtual marking have been circulated, since more and more products with complicated technologies embody many patents, which make labelling directly on products or packages difficult.

In China, the acts corresponding to false marking in the U.S. are provided in the Chinese statutes

in the U.S. are provided in the Chinese statutes²⁵ as patent counterfeiting, which include: marking a product or package of the product for which no patent rights has been granted; continuing to mark after the patent rights was declared invalid or ceased; or marking without authorization, a product or package with a patent number of another person. Intent to deceive the public is presumed in the above listed acts, however, there is an exception - selling a product with a patent marking after the related patent rights were ceased is not an act of patent counterfeiting if the marking was made before such patent rights were ceased.

A person held liable for patent counterfeiting will face civil liability and confiscation of her unlawful gains by a patent authority. Unlike in the U.S., the fine for patent counterfeiting in China is based on the gains rather than the number of articles sold. For example, the fine may not be more than four times the unlawful gains or may include administrative liability of not more than CNY 200,000 if there are no unlawful gains. Further, a crime may result from serious acts of patent counterfeiting, and lead to jail time. Examples of serious acts may include unlawful turnover of over CNY 200,000 or unlawful gain of over CNY 100,000, or patent counterfeiting that inflicts direct economic losses of over CNY 500,000 to the patentee.

V. Practical issues

Whereas the laws in the U.S. and China on patent marking differ significantly, a multi-national company selling products in both countries needs to be aware of its obligations or rights in each country, know the consequences of noncompliance of respective statutes, and implement the best strategies to protect its potential damage pool. These strategies include proper actions of the patentee in both the after-issuance phase and before-issuance phase of a patent, which are summarized in Table 1 below and further explained in this section.

Table 1. Practical steps for patentees to comply with respective statutes in patent marking.

| In the U.S. | In China |
|---|---|
| <i>After patent is issued</i> | |
| <ul style="list-style-type: none"> • Patentee is obligated to mark consistently and continuously: <ul style="list-style-type: none"> - When selling products, mark products with patent number - Once non-compliance is found, patentee should correct it by complying with patent marking - Make reasonable efforts to ensure licensee also comply • Patent marking may be waived: <ul style="list-style-type: none"> - If patentee sells no products - If patents include only method claims | <ul style="list-style-type: none"> • Patentee is not obligated, but has the right to do patent marking • Patentee may require licensees to also do patent marking • Patentee may use patent marking as a useful tool to establish branding, differentiate her products from counterfeits, or use as evidence to prove malicious infringement in view of up to five times punitive damages prescribed in the new law²⁶ |
| <i>When patent application is pending</i> | |
| <ul style="list-style-type: none"> • Consider early publication • When a patent application is published, consider sending a notice letter if a third party is already identified to practice the claims in the application • Consider re-publication if significant changes to the claims are made during examination • Expressly include provisional rights in patent transfer • As a defense strategy, limit exposure to third-party published patent applications | <ul style="list-style-type: none"> • Patentee is not obligated, but has the right to mark published patent application number • Consider early publication • Expressly include provisional rights in patent transfer |
| <i>Method of marking</i> | |
| <ul style="list-style-type: none"> • List “patent” or “pat.” together with patent number on product or packaging • May use virtual marking by providing address of website that lists the patent numbers. Need to make the website publicly accessible and patent information easy to locate • Avoid false marking <ul style="list-style-type: none"> - Use “patent pending” when patent application is applied for but not issued - Monitor expiration date of patents and update patent numbers in patent marking - Use “may be” language in patent marking if unsure of applicable patent numbers | <ul style="list-style-type: none"> • List patent number together with the type of patent in Chinese on product, packaging, or documentation • Use statement “patent pending, not issued yet” for pending patent application • Do not include information about pending patent application in advertisement to avoid violation of Advertisement Law • Virtual marking is not applicable • Avoid patent counterfeiting |

A. After a patent is issued

Once a patent is issued, in the U.S., the patentee should diligently safeguard her damage pool through the affirmative act on patent marking, to satisfy the constructive notice requirement. This is practically useful because an actual notice (e.g., a cease-and-desist letter) may not be practical as the patentee may not know who is infringing her patent at that time.

A failure to comply with patent marking also requires the patentee’s affirmative act to cure. That is, once a patentee has failed to comply with the patent marking statute, the patentee can cure the noncompliance, but only by an affirmative act. In *Arctic Cat Inc. v. Bombardier Rec. Prods.*²⁷, at the time the patents were issued, the patentee Arctic Cat licensed its patents to the licensee Honda, which began selling unmarked products. Honda stopped selling the unmarked products about a year before Arctic Cat sued the infringer. The patentee argued that the failure of its licensee’s marking was cured a year before the patent infringement complaint was filed when the licensee Honda ceased selling unmarked products, thus, Arctic Cat felt that it was entitled to past damages from the date when Honda stopped selling the unmarked products. The court denied Arctic Cat’s arguments by holding that the “cessation of sales of unmarked products certainly did not fulfill Arctic Cat’s notice obligations... nor did it remove the notice requirement ...”²⁸

If a patentee has licensees to her patents, he should also make reasonable efforts to ensure that the licensees also comply with the patent marking statutes. In *Arctic Cat*²⁹ above, the final version of the license agreement between Arctic Cat and its licensee, Honda, expressly stated that Honda had no marking obligations. Thus, Honda did not mark its products. Further, Arctic Cat made no effort to ensure that Honda mark its licensed products. The court held that Arctic Cat failed to comply with the patent marking requirement. In contrast, in *Maxwell v. J. Baker Inc.*³⁰, the licensee, Target, agreed to mark on all pairs of shoes, yet Target made no effort to change the marking from “patent pending” to reciting the patent number. Once the patentee Maxwell found out its licensee’s failure to mark, it required the licensee to mark per license

agreement and made several attempts to notify the licensee to mark. The court held that the patentee complied with the marking statute because the deficiency in marking was not due to Maxwell or any failure on its part to ensure compliance by the licensees.

Certain waivers apply to patent marking. Patent marking only applies to the products that practice the claims of the patent. For example, if a patentee sells no products that practice the issued claims of the patent, or sells no products at all, then the patentee is entitled to the past damages without needing to show patent marking. Comparing with the above scenario in which a company stopped selling unmarked products, having not sold any product is different. While the former constitutes a noncompliance not being cured, the latter falls into the waiver. While the former results in no recovery of past damages until the patentee affirmatively acted to correct the noncompliance, the latter results in a full recovery of past damages.

Patent marking may also be waived for patents with method claims only, or, when only method claims of the patents are asserted³¹. In practice, when a patent includes both method claims and apparatus claims, and if the patentee sells products covered by the patent, it is best for the patentee to comply with patent marking so that she can assert both method claims and apparatus claims for infringement and maximize the recovery of past damages.

In China, although it is a right, rather than an obligation of a patentee to mark, the patentee can use patent marking as an effective tool to establish branding and differentiate her products from counterfeits. First, the patent marking has certain advertising effect, which may increase the recognition of the patentee's product in the market, and can more clearly define the patent ownership of the product. Second, the higher the reputation of the product, the easier it is for distributors and consumers to recognize a reasonable pricing, legitimacy of the sales channels, and the fact that patent marking should be attached to genuine products, providing a basis for the public to differentiate the genuine product from competitors' or counterfeit

the genuine product from competitors' or counterfeit products. Further, the patentee may require her licensees to mark on patented products or products made from patented methods.

In light of the newly amended Chinese Patent Law, patent marking may be used as evidence in proving malicious infringement, which may result in punitive damages of up to five folds³² - currently the highest fine worldwide for patent infringement. For cases where the process and technology of the patented product are complex and have special details that have not been disclosed in the patent literature, when an infringing product is found to be identical to the patented product in all aspects, it can be presumed that the infringer has had access to and has reverse engineered the patented product. If the patented product is marked, it can be reasonably presumed that the infringing party has had malicious infringing conduct.

B. Before a patent is issued

Requesting early publication is an avenue to secure provisional rights early, and is available in both the U.S. and China. The patentee, however, should also consider carefully the negative impact of an early publication before deciding to publish early. For example, an early publication of a patent application may cause a loss of right to file patents in other countries when other remedies would have been available³³. In addition, an early publication may cause a company's proprietary technologies to be prematurely revealed to the public, including its competitors, unless the company has already publicly disclosed the technologies or started selling its products. Thus, requesting early publication should only be considered if the priority application (e.g., a parent application) has already been published.

Practically, in the U.S., if significant changes have been made to the patent claims during prosecution, the patentee should consider requesting re-publication to reflect the scope of the claims in a to-be-issued patent. Re-publication would allow the patentee to establish the provisional rights early to maximize past damages without having to wait until the patent

until the patent is issued. Considering a scenario when the claims are amended to be in condition for appeal. While the appeal may take a year or two to be heard by the Appeal Board, having the patent application re-published will buy that one or two years of time for the patentee to collect damages, assuming the patentee prevails in the appeal. In China, there is no avenue for re-publication.

Another step for a patentee to protect her potential past damage pool is to evaluate whether or not any third party is already practicing the claims once a patent application is published. If such third party is identified, the patentee may consider sending a notice letter so that the third party will have an "actual notice."

An often overlooked issue in the context of patent assignment agreement is whether the provisional rights are also transferred to the transferee (assignee) absent express language of the transfer of such rights in the agreement. For example, in China, the subject requesting license fees associated with provisional rights is the patent applicant, whereas the subject requesting compensation for patent infringement is the patentee. If a patent is transferred during its pendency, and if the transfer instrument does not expressly include the right to collect licensee fees associated with the provisional rights, then the new patentee may not be entitled to recover from such licensee fees. For the avoidance of doubt, it is best practice to expressly include the provisional rights in a patent transfer.

Whereas patent provisional rights require actual notice or knowledge of an alleged infringer, in the U.S., as a defensive strategy, a company should be careful of its exposure to third-party published patent applications because an alleged infringer's knowledge of the third-party published patent application would give rise to past damages as liable by the company. This practice should include refraining from routinely monitoring competitors' published patent applications. Further, once a company has learned about a closely related third-party published patent application, it should continuously monitor the prosecution of the patent application to assess allowed claims and avoid infringing them.

C. Method of marking

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As practical issues, one should always follow proper methods of patent marking and avoid false marking. In the U.S., although proving the intent to deceive the public may be difficult in practice, a patentee should nevertheless avoid marking a product with "patent pending" when no patent was filed, marking a product with "patented" when the patent is still pending or when the patent has expired, or making similar statement in the product manual or other documentations. In China, the Guidelines³⁴ provide samples of patent marking which should be followed. For example, a marking of "Infringement must be investigated" when the patent is still pending is not permitted.

Although it is convenient to use virtual marking, it is important to update the relevant websites in a timely manner as old patents expire, or new patents are issued. When uncertainties about patent coverage exist, a patentee may also use the "may be" language in patent marking³⁵. The website for virtual marking should also be easily accessible and patent information should be easily located by the public. A patentee should also avoid purposefully obscuring which patent actually covers the product, for example, by marking with a long list of patents when most of them are not applicable.

VI. Conclusion

Patent marking statutes in the U.S. and China take completely different stances. In the U.S., patent marking requires an affirmative act of the patentee to mark her products, and failure to comply with patent marking may drastically limit the past damages afforded to the patentee before a litigation on patent infringement had begun. In contrast, patent marking in China only gives the patentee the right, rather than the obligation to mark, whereas the patentee may be entitled to a fully recovery of past damages regardless of whether or not she has done patent marking. However, marking in China may allow the patentee to maximize her damages up to five folds if infringement and malicious acts of the infringer are found. In practice, in both countries, a patentee should diligently do patent marking, and at the same time use proper marking methods to

marking methods to avoid false marking or patent counterfeiting.

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Endnotes

1. Patent marking statutes are covered by 35 USC 287(a) (<https://www.law.cornell.edu/uscode/text/35/287>) and 35 USC 286 (<https://www.law.cornell.edu/uscode/text/35/286>).
2. Chinese Patent Law, Article 16 (2). (https://www.cnipa.gov.cn/art/2020/11/23/art_97_155167.html)
3. This complies with Article 5 (D) of the Paris Convention: no indication or mention of the patent, of the utility model, of the registration of the trademark, or of the deposit of the industrial design, shall be required upon the goods as a condition of recognition of the right to protection. (<https://wipolex.wipo.int/en/text/288514>)
4. See https://www.cnipa.gov.cn/art/2013/10/23/art_74_27596.html.
5. See https://www.cnipa.gov.cn/art/2020/7/17/art_53_150392.html.
6. Radware, Ltd. v. F5 Networks, Inc., 147 F.Supp.3d 974 (2015). (<https://www.leagle.com/decision/infdco20151207c25>)
7. American Medical Systems Inc. v. Medical Engineering Corp., 28 USPQ2d 1321 (Fed. Cir. 1993). The patentee's marking but failure to distribute the marked product to the public, while distributing remaining unmarked products, is not in full compliance. (<https://openjurist.org/6/f3d/1523/american-medical-systems-inc-v-medical-engineering-corporation>)
8. Arctic Cat Inc. v. Bombardier Rec. Prods., 950 F.3d 860 (2020). (<https://casetext.com/case/arctic-cat-inc-v-bombardier-recreational-prods-inc-9>)
9. (2000) Lu Economic 2nd Instance No. 339, Shandong High People's Court.
10. For example, the notification requirement of § 287 "serves three related purposes: (1) helping to avoid innocent infringement; (2) encouraging patentees to give public notice that the article is patented; and (3) aiding the public to identify whether an article is patented." (see Arctic Cat I, 876 F.3d at 1366 (citing Nike, Inc. v. Wal-Mart Stores, Inc., 138 F.3d 1437, 1443 (Fed. Cir. 1998))). (<https://www.leagle.com/decision/infco20171207168>)
11. See 35 USC 154(d). (<https://www.law.cornell.edu/uscode/text/35/154>)
12. Rosebud LMS Inc. v. Adobe Sys., 812 F.3d 1070, 2016 U.S. App. LEXIS 2181, 117 U.S.P.Q.2D (BNA) (<https://www.leagle.com/decision/infco20160209170>)
13. The patentee Rosebud argued that Adobe knew of the related grandparent patent but not the patent in suit. The court held that this is not enough because "the notice requirement is not limited to the specification. The alleged infringer must also have notice of the claims of the published patent application." See note 12.
14. Chinese Patent Law, Article 13 (https://www.cnipa.gov.cn/art/2020/11/23/art_97_155167.html) states that after the patent application is published, the patentee may request the party or individual who implemented the patent to pay "appropriate fees." There is no statute on provisional rights for utility model and design patents.
15. 35 U.S.C. 287(a). See note 1.
16. Report on Virtual Marking, United States Patent and Trademark Office, Report to Congress, September 2014, page 12 (citing Sessions v. Romadka, 145 U.S. 29, 49-50 (1892)). (https://www.uspto.gov/sites/default/files/aia_implementation/VMreport.pdf)
17. See 35 U.S.C. 292. (<https://www.law.cornell.edu/uscode/text/35/292>)
18. 786 F.2d 1124 (Fed. Cir. 1986). (<https://law.justia.com/cases/federal/appellate-courts/F2/786/1124/409737/>)
19. 406 F.3d 1347 (Fed. Cir. 2005). (<https://law.resource.org/pub/us/case/reporter/F3/406/406.F3d.1347.03-1464.04-1099.html>)
20. Forest Group, Inc. v. Bon Tool Co., 590 F.3d 1295, 2009. (<https://www.courtlistener.com/opinion/893/forest-group-inc-v-bon-tool-co/>)
21. 723 F.Supp. 2d 1284 (S.D. Cal. 2010). (<https://www.courtlistener.com/opinion/2541087/presidio-components-v-american-tech-ceramics/>)
22. "Measures for Patent Marking". See note 4.
23. Id.
24. Article 12. See http://www.npc.gov.cn/zgrdw/npc/cwhhy/12jcwh/2015-04/25/content_1934594.htm
25. Chinese Patent Law, Article 13 (See note 14), and Implementing Regulations of Chinese Patent Law, Rule 84 (See https://www.cnipa.gov.cn/art/2015/9/2/art_98_28203.html).
26. The Fourth Amendment to Chinese Patent Law, effective from June 1st, 2021, Article 71. (https://www.cnipa.gov.cn/art/2020/11/23/art_97_155167.html)
27. Arctic Cat Inc. v. Bombardier Rec. Prods., 950 F.3d 860 (2020). See note 8.
28. Id.
29. Id.

30. Maxwell v. J. Baker Inc. 39 USPQ2d 1001 (Fed. Cir. 1996) (<https://www.courtlistener.com/opinion/719830/susan-m-maxwell-v-j-baker-inc-and-prange-way-inc/>)

31. Crown Packaging Tech., Inc. v. Rexam Bev. Can Co., 559 F.3d 1308, 2009. (<https://casetext.com/case/crown-packaging-v-rexam-beverage-can>)

32. See note 26.

33. Consider a scenario in which an application is not filed in other countries within the twelve-month limit, other methods may be used to remedy the situation, such as withdrawing domestic application and resubmitting the same as a PCT application. However, if the domestic patent application has already been published in the home country, the patentee will not be able to enter other countries because the published patent application has become a prior art.

34. See note 5.

35. 406 F.3d 1347 (Fed. Cir. 2005). See note 19.

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Matthew advises clients on patent matters with a deep understanding of the value of patents, combining his business, technical, and legal acumen. As former Director of Intellectual Property (IP) at SRI International and several other companies, Matthew has extensive in-house and law firm experience in all phases of a patent's life cycle. Matthew brings 26 years of experience in technology development, patent drafting and prosecution, intellectual property management, and patent acquisition. His practice concentrates on patent drafting and prosecution of utility and design patents, patentability and freedom-to-operate studies, trademark registration, IP due diligence, IP litigation support and IP licensing. His academic training in electrical and computer engineering, coupled with prior industry experience as a scientist and engineer, affords him an in-depth understanding of complex technologies behind his clients' innovations.



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Attorney at Law
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Ms. Zheng has expertise that broadly extends from patent disputes, copyright disputes to trademark and unfair competition disputes, involving dual practice in both US and China. Some of the typical cases include: representing Apple against a third party in a copyright infringement case, representing HomeLink over ten serial cases relating to trademark and unfair competition disputes, trademark administrative disputes, etc. Ms. Zheng was also deeply involved in several SEP cases, such as *Sony v. IWNCOMM* and *Huawei v. Samsung*.



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