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# Patent Marking: The Good, the Bad & the Ugly

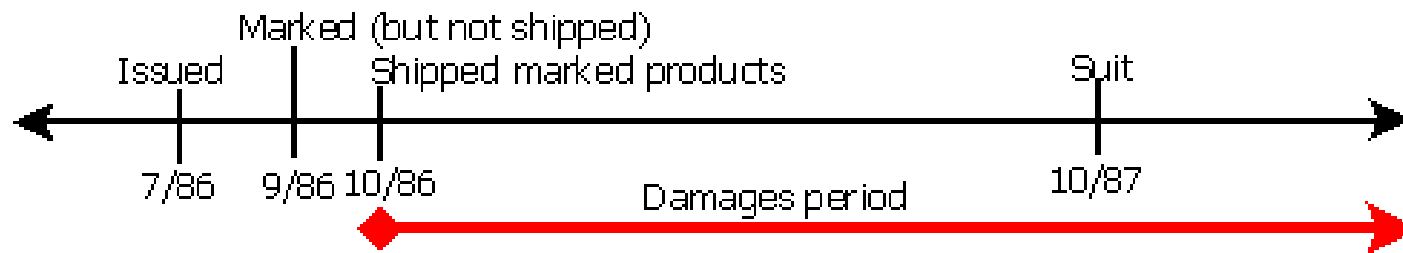
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# Proper Patent Marking – Why Bother?

- Am. Med. Sys. v. Med. Eng'g Corp., 6 F.3d 1523 (Fed. Cir. 1993)



- “Congress structured the statute so as to tie failure to mark with disability to collect damages ...”
- Tex. Digital Sys. v. Telegenix, 308 F.3d 1193 (Fed. Cir. 2002)
  - “forfeiture of damages”

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## § 287(a)

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### **35 U.S.C. § 287(a):**

“In the event of failure so to mark,  
no damages shall be recovered by the patentee in  
any action for infringement,  
except on proof that the infringer was notified of  
the infringement and continued to infringe  
thereafter,  
in which event damages may be recovered only  
for infringement occurring after such notice.  
Filing of an action for infringement shall  
constitute such notice.”

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## § 287(a)

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### **35 U.S.C. § 287(a):**

“Patentees, and  
persons making, offering for sale, or selling within  
the United States  
any patented article  
for or under them,  
or importing any patented article into the  
United States,  
may give notice to the public that the same is  
patented,”

# “Any Patented Article” / “Patentee”

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- Tex. Digital Sys. v. Telegenix, 308 F.3d 1193 (Fed. Cir. 2002)
  - Damages: 6 yrs. preceding notice
  - TDS did not make or sell the product
  - § 287(a) did not apply
- Amsted Indus. v. Buckeye Steel Castings, 24 F.3d 178 (Fed. Cir. 1994)
  - Patentee sold center plate for use in making patented railcars
  - No pre-notice damages

# “For or Under Them”

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- Devices for Medicine v. Boehl, 822 F.2d 1062 (Fed. Cir. 1987)
  - DFM’s licensee did not mark
  - No error in denying new trial when jury awarded no damages
- Amsted Indus. v. Buckeye Steel Castings, 24 F.3d 178 (Fed. Cir. 1994)
  - “impliedly authorized its customers to make, use, and sell”
  - Damages were limited

# Only Method Claims (or Asserted)

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- Bandag v. Gerrard Tire, 704 F.2d 1578 (Fed. Cir. 1983)
  - Tire retreading process (only method claims)
  - Pre-notice damages permitted
    - § 287(a) notice requirement “does not apply where the patent is directed to a process or method.”
  
- Hanson v. Alpine Valley Ski Area, 718 F.2d 1075 (Fed. Cir. 1983)
  - Snow-making method asserted; not apparatus
  - Pre-suit damages permitted

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# Both Method & Article Claims

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- Devices for Medicine v. Boehl, 822 F.2d 1062 (Fed. Cir. 1987)
  - Introducer (unmarked) & method of using
  - No error to deny new trial after no damages
- Am. Med. Sys. v. Med. Eng'g Corp., 6 F.3d 1523 (Fed. Cir. 1993)
  - Prosthesis (unmarked) & method of packaging
  - No error to deny damages prior to notice

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# How to Mark Properly

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## **35 U.S.C. § 287(a):**

“either by fixing thereon the word "patent" or the abbreviation "pat.",

together with the number of the patent,  
or when, from the character of the article, this can  
not be done,

by fixing to it, or to the package wherein one  
or more of them is contained, a label  
containing a like notice.”

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# Sessions v. Romadka

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- Sessions v. Romadka, 145 U.S. 29 (1892)
  - Patented item: spring catches
    - Smallest ones not marked – legibility?
  - “It is not altogether clear that the stamp could not have been made ..., but, in a doubtful case, something must be left to the judgment of the patentee.”

## “Can not be done” – Other Markings

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- Creative Pioneer Prods. v. K Mart, 5 USPQ2d 1841 (S.D. Tex. 1987)
  - Wire strippers marked: “MANUFACTURED BY ELCONTROL - ITALY PAT. -PAT. APPL. IN I-UK-WG-F-USA-ROC-J.”
  - Damages limited by post-bench-trial order
- Rutherford v. Trim-Tex., 803 F. Supp. 158 (N.D. Ill. 1992)
  - Drywall “T” had no other markings
  - Pre-notice discovery allowed

## “Can not be done” – Other Factors

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- Bowling v. Hasbro, 490 F. Supp. 2d 262 (D.R.I. 2007)
  - Polyhedral dice had markings
    - Numerals showing values
  - MSJ to limit damages denied
  
- Heraeus Electro-Nite v. Midwest Instr., 2007 U.S. Dist. LEXIS 84408 (E.D. Pa. 2007)
  - Probe with some writing on it
    - Immersed in molten steel / destroyed after opening
  - MSJ to limit damages denied

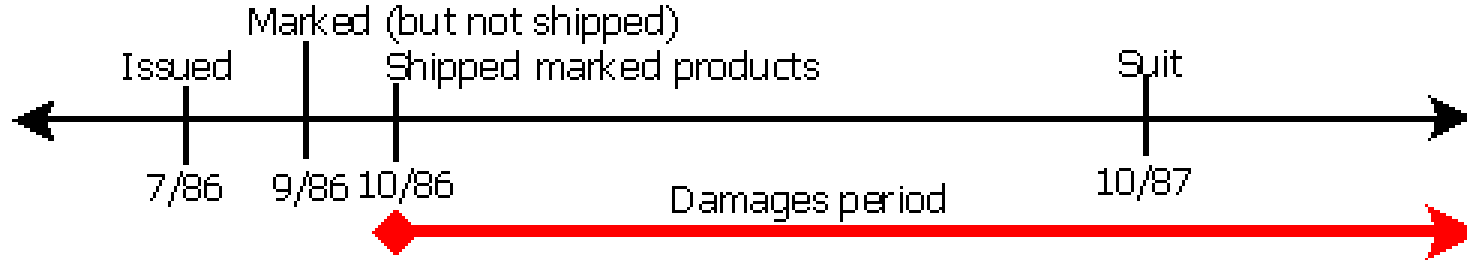
# “To the package”

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- Western Emulsions v. Copperstate Emulsions, 42 USPQ2d 1856 (D. Ariz. 1997)
  - Liquid – stored then put into buyer’s container
  - MSJ to limit damages granted
- U.S. Cosmetics v. Greenberg Traurig, 2007 U.S. Dist. LEXIS 22793 (D.N.J. 2007)
  - Powder - patents listed on invoice / bill of L.
  - MSJ of no malpractice liability granted

# Compliance: Timing

- Am. Med. Sys. v. Med. Eng'g Corp., 6 F.3d 1523 (Fed. Cir. 1993)



- Substantially all patented products
  - Are consistently marked
  - Unmarked products no longer distributed
- Caveat: “once marking has begun, it must be substantially consistent and continuous”

# “Substantially All”

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- Maxwell v. J. Baker, 86 F.3d 1098 (Fed. Cir. 1996)
  - Prior agreement to mark & notice of issuance
  - Follow-up with lic'ee & ~95% compliance
  - JMOL of no marking – denied / aff'd
    - Substantial compliance & reasonable efforts

# Proposed Amendment to § 287(a)

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## Current:

by fixing thereon the word "patent" or the abbreviation "pat.", together with the number of the patent, or

## Proposed:

by fixing thereon the word 'patent' or the abbreviation 'pat.' together with an address of a posting on the Internet, accessible to the public without charge for accessing the address, that associates the patented article with the number of the patent

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# False Marking

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- Clontech Labs. v. Invitrogen, 406 F.3d 1347 (Fed. Cir. 2005)
  - False marking elements met
    - “More info than legally required!”
  - Answer: “the words of the statute, which holds liable ‘whoever’ deceptively marks ‘any unpatented article.’”

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# False Marking

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## **35 U.S.C. § 292:**

“Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article, the word ‘patent’ or any word or number importing that the same is patented for the purpose of deceiving the public”

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## *Qui Tam* – Up to \$500 / Offense

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### **35 U.S.C. § 292:**

“(a) ...Shall be fined not more than \$500 for every such offense.

(b) Any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States.”

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# What is an Offense?

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- Forest Group v. Bon Tool, 590 F.3d 1295 (Fed. Cir. 2009)
  - Act of falsely marking article
  - OR
  - Decision to mark falsely
- Per item fine
  - Rejected “single, continuous, act” from 1910 *London case*
  - Supported by policy & statute

# “Unpatented Article”

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- Clontech Labs. v. Invitrogen, 406 F.3d 1347 (Fed. Cir. 2005)
  - “[N]ot covered by at least one claim of each patent with which the article is marked.”
  
- Pequignot v. Solo Cup, 540 F. Supp. 2d 649 (E.D. Va. 2008) (appeal argued Apr. 6, 2010)
  - “May be covered by one or more ...”
  - Covered (only) by expired patents
  - Mot. to dismiss (not unpatented) - denied

# “Purpose of Deceiving the Public”

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- Clontech Labs. v. Invitrogen, 406 F.3d 1347 (Fed. Cir. 2005)
  - Inference of “fraudulent intent”
    - Fact of misrepresentation
    - Knowledge of the statement’s falsity
  - Knowledge of falsity
    - Absence of a “reasonable belief that the articles were properly marked (i.e., covered by a patent)”
    - Or -- no “honest good faith belief”

# Reasonable Belief

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- Forest Group v. Bon Tool, 590 F.3d 1295 (Fed. Cir. 2009)
  - Aug.: MSJ: identical product did not infringe
  - Nov.: Another MSJ (other case) & adverse opinion by counsel
  - False marking liability > November

# Good Faith & Rebutting Intent

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- Arcadia Machine & Tool v. Sturm, Ruger, 786 F.2d 1124 (Fed. Cir. 1986)
  - “Manufactured under one or more of the following ...”
  - MSJ of no false marking (no intent) aff’d
- Pequignot v. Solo Cup, 646 F. Supp. 2d 790 (E.D. Va. 2009) (appeal argued Apr. 6, 2010)
  - Expired patents
  - “May be covered” language
  - Inference rebutted - MSJ of no false marking

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# Potential Standing Defense

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- Stauffer v. Brooks Bros., 615 F. Supp. 2d 248 (S.D.N.Y. 2009) (app'd July 7, 2009)
  - *Qui tam* action
  - No injury in fact – standing issue
  - Mot. to dismiss granted
    - Not “concrete and particularized” and “actual or imminent, not conjectural or hypothetical”

# Proposed Issa Amendment to § 292(b)

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## Current:

Any person  
may sue for the penalty,  
in which event one-half shall go to the person  
suing and the other to the use of the United States.

## Proposed:

A person who has suffered a competitive injury as a  
result of a violation of this section  
may file a civil action in a district court of the  
United States for recovery of damages  
adequate to compensate for the injury.

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# Things to Remember

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1. ONLY method claims? No product? Don't worry
2. Otherwise? Damage may be forfeited
3. Your licensees are marking, right?
4. Putting other writing on the article? Put it there
5. Never too late to mark (unless already sued...)
6. Up to \$500 per item...
7. Don't rely on "One or more of the following..."
8. Is the product covered? By expired patents?

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# Questions?



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# Cases

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## Supreme Court

- *Sessions v. Romadka*, 145 U.S. 29 (1892)
- *Wine Ry. Appliance v. Enterprise Ry. Equip.*, 297 U.S. 387 (1936)

## Appellate Court

- *Am. Med. Sys. v. Med. Eng'g Corp.*, 6 F.3d 1523 (Fed. Cir. 1993)
- *Amsted Indus. v. Buckeye Steel Castings*, 24 F.3d 178 (Fed. Cir. 1994)
- *Arcadia Machine & Tool v. Sturm, Ruger*, 786 F.2d 1124 (Fed. Cir. 1986)
- *Bandag, Inc. v. Gerrard Tire*, 704 F.2d 1578 (Fed. Cir. 1983)
- *Brose v. Sears, Roebuck*, 455 F.2d 763 (5th Cir. 1972)
- *Clontech Labs. v. Invitrogen*, 406 F.3d 1347 (Fed. Cir. 2005)
- *Crown Packaging Tech. v. Rexam Beverage Can*, 559 F.3d 1308 (Fed. Cir. 2009)
- *Devices for Medicine v. Boehl*, 822 F.2d 1062 (Fed. Cir. 1987)
- *Forest Group v. Bon Tool*, 2009 U.S. App. LEXIS 28380 (Fed. Cir. Dec. 28, 2009)
- *Hanson v. Alpine Valley Ski Area*, 718 F.2d 1075 (Fed. Cir. 1983)
- *K&K Jump Start v. Schumacher Elec.*, 52 Fed. Appx. 135 (Fed. Cir. 2002)
- *Kemin Foods v. Pigmentos Vegetales Del Centro*, 464 F.3d 1339 (Fed. Cir. 2006)
- *Lans v. Digital Equip. Corp.*, 252 F.3d 1320 (Fed. Cir. 2001)
- *London v. Everett H. Barr Corp.*, 179 F. 506 (1st Cir. 1910)
- *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098 (Fed. Cir. 1996)
- *Minks v. Polaris Indus.*, 546 F.3d 1364 (Fed. Cir. 2008)
- *Nike v. Wal-Mart Stores*, 138 F.3d 1437 (Fed. Cir. 1998)
- *State Contr'g & Eng'g v. Condotte Am.*, 346 F.3d 1057 (Fed. Cir. 2003)
- *Tex. Digital Sys. v. Telegenix*, 308 F.3d 1193 (Fed. Cir. 2002)
- *Transcore v. Electr. Transaction Consultants*, 563 F.3d 1271 (Fed. Cir. 2009)

# Cases

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## District Court

- *Astec Am. v. Power-One*, 2008 U.S. Dist. LEXIS 30365 (ED Tex. Apr. 11 2008)
- *Bowling v. Hasbro*, 490 F. Supp. 2d 262 (D.R.I. 2007)
- *Bowling v. Hasbro*, 582 F. Supp. 2d 192 (D.R.I. 2008)
- *Calmar v. Emson Research*, 850 F. Supp. 861 (C.D. Cal. 1994)
- *Creative Pioneer Prods. v. K Mart*, 5 USPQ2d 1841 (S.D. Tex. 1987)
- *DP Wagner Mfg. v. Pro Patch Sys.*, 434 F. Supp. 2d 445 (S.D. Tex. 2006)
- *Forest Group v. Bon Tool*, 2008 U.S. Dist. LEXIS 57134 (S.D. Tex. 2008)
- *Hazeltine Corp. v. Radio Corp.*, 20 F. Supp. 668 (S.D.N.Y. 1937)
- *Heraeus Electro-Nite v. Midwest Instr.*, 2007 U.S. Dist. LEXIS 84408 (E.D. Pa. 2007)
- *Metrologic Instr. v. PSC*, 2004 U.S. Dist. LEXIS 24949 (D.N.J. 2004)
- *Pequignot v. Solo Cup*, 540 F. Supp. 2d 649 (E.D. Va. 2008)
- *Pequignot v. Solo Cup*, 646 F. Supp. 2d 790 (E.D. Va. 2009)
- *Rutherford v. Trim-Tex.*, 803 F. Supp. 158 (N.D. Ill. 1992)
- *Stauffer v. Brooks Bros.*, 615 F. Supp. 2d 248 (S.D.N.Y. 2009)
- *U.S. Cosmetics v. Greenberg Traurig*, 2007 U.S. Dist. LEXIS 22793 (D.N.J. 2007)
- *Western Emulsions v. Copperstate Emulsions*, 42 USPQ2d 1856 (D. Ariz. 1997)