

Suit Highlights Danger of Leaky Patent Marking Practices

By *Philip H. Sheridan*

Although marking all articles covered by a patent is essential to maximizing a company's patent rights, a recent case highlights the importance of correctly marking articles with the correct, enforceable patent numbers.

In *Pequignot v. Solo Cup Co.*, E.D. Va., No. 1:07cv897, Washington, D.C., attorney Matthew A. Pequignot filed suit in the Eastern District of Virginia against Solo Cup Company under a nearly forgotten false marking patent law statute. Solo Cup manufactures disposable plastic and paper cups, lids, plates, bowls and utensils. The attorney alleged, among other things, that Solo Cup's marking its coffee cup lids with expired patent numbers constituted a false marking under the statute.



The statute, 35 U.S.C. 292, allows any person to sue "whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article, the word 'patent' or any work or number importing that the same is patented for the purpose of deceiving the public . . ." Pequignot contends the statute applies because the Solo cup lids identified in the complaint became "unpatented articles" upon the expiration of the patents with which they were marked. The statute also allows for a fine of not more than \$500 per offense, which is shared 50/50 by the plaintiff and the U.S. government.

In summary judgment motions, Solo Cup argued that it did not intend to deceive the public because it was merely acting on advice of counsel to replace patent-marking molds with non-marking molds as the molds became worn. Additionally, Solo Cup argued that the \$500 per offense fine applied not to each and every marking of a product, but instead to each product line.

On July 2, 2009, the court ruled favorably on Solo Cup's summary judgment motions, ruling that Solo Cup did not intend to mislead or defraud its competitors or the public, and that the \$500 per offense fine applied to each product line, not each individual product. However, the Judge did remark at oral arguments that the ruling was intended to "get [the] case teed up for the Federal Circuit."

In the meantime, and in order to reduce the chance of being sued for false marking under the statute, companies should schedule periodic reviews of their patent marking practices to ensure that all manufactured articles are appropriately marked with each applicable, enforceable patent.

Philip H. Sheridan is a partner at McAndrews, Held & Malloy.