



## Federal Circuit finds that there was "not a scintilla of evidence" showing that Solo Cup intended to deceive the public in the claim for false patent marking

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The April 6, 2010 oral argument before the Federal Circuit on Pequignot's appeal from the district court, ruling against it on summary judgment that there "was not a scintilla of evidence" to support the claim that Solo Cup acted with intent to deceive the public when it continued to mark cups with the numbers of patents that had expired, signaled strong consideration of making the burden of proof "beyond a reasonable doubt" for a plaintiff asserting §292(b) claim. The judges noted repeatedly that the legislative history of the section referenced Title 18, indicating Congress' intent that the statute be considered a criminal statute. Pequignot's argument was that under *Clontech Labs, Inv. v. Invitrogen Corp.*, 406 F.3d 1347 (Fed. Cir. 2005), cited as authority in *Bon Tool*, a party asserting false marking must show by a preponderance of the evidence that the accused party did not have a reasonable belief that the products were properly marked. In colloquy with counsel, one of the judges suggested that this portion of the opinion in *Bon Tool* was dicta. References were also made to decisions of sister circuits which had adopted a higher standard than that of preponderance of the evidence.

The facts of the case present the question of whether continuing to mark products with patent numbers of expired patents constitutes "false marking." The evidence is undisputed that Solo Cup was aware that certain patent numbers marked on its cup lids, while correct at the time the cup molds were made, had expired by 2000. Solo argued that patent law was silent as to when such markings had to be removed, and that its reliance on the advice of counsel that it could remove the markings for expired patents at its convenience was appropriate. At appellate argument, Solo was asked if there was a point in time when continued marking of products with expired patents moved toward deceiving the public. Its response was that there was no such point in time because marking products with truthful patent numbers, even if expired, benefits the public. The numbers, which are easily searchable, benefit the public because it is easy to determine that the invention is at that point available for public use.

It is possible that the court could affirm the decision of the district court awarding summary judgment without addressing the issue of the standard of proof by adopting the trial court's

finding that “not a scintilla of evidence” supported a finding of intent to deceive under either the preponderance standard or the more rigorous standard Peguignot argues that the district court applied.