Both Sides Seek Knockout in Patent-Marking Bout

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Solo Cup Figure from Patent Documentation

With discovery complete, both Solo Cup Co. and Matthew A. Pequignot have asked the Eastern District of Virginia to resolve major issues in the patent marking case *Pequignot v. Solo Cup Co.*, No 1:07cv897-LMB/TCB (E.D. Va.). Solo contends that it cannot be liable for improper marking because it has acted in accordance with advice from counsel while implementing a plan to reduce and eventually eliminate the marking of products with expired patent numbers. Pequignot counters that Solo knowingly marked its products improperly and should be penalized for each article so marked.

In moving for summary judgment, Solo argues that no trial is necessary because Pequignot cannot prove that Solo marked its products “for the purpose of deceiving the public,” as required by 35 U.S.C. § 292(a). This is the case, says Solo, because its attorneys advised it that phasing out the manufacturing components that applied the patent numbers to the products would be legally permissible. Solo contends that a wholesale replacement of all the components at once, which Solo alleges would have been very expensive, was not necessary to comply with § 292.

Pequignot takes a contrary position, stating that the controlling facts regarding the deception element of § 292 are that Solo knew its products were no longer patented and yet marked them anyway. Pequignot argues that the advice of counsel Solo received is legally irrelevant because it was not directed to the question of whether the marked products were actually patented.

Solo’s motion also includes the alternative position that even if the Court were to find a deceptive purpose to Solo’s conduct, the applicable “offense” was Solo’s decision to mark the products, not each and every marking of a product. Under Solo’s view, it would thus be guilty of, at most, three such offenses, which limits its liability under a law that calls for a fine of “not more than $500 for every such offense.” 35 U.S.C. § 292(a). Pequignot counters that the plain language of the statute shows that each instance of intentional improper marking is a separate offense, and notes that if Solo’s position were adopted, a party could flood a market with as many wrongly marked products as it wished and pay no more than a $500 penalty. The Court has set July 2 as the hearing date for both motions.