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GETTING AROUND THE MARKING REQUIREMENT: CLOSING THE LOOPHOLE ON DAMAGES

Ethan Buresh*

I. INTRODUCTION

Marking a patented product is one of the most important aspects of being a patent owner. By accurately marking a patented product, a patent owner ensures that proper notice is given to the public that a product is already patented.¹ Proper notice both entitles a patent owner to a full six years of damages² and helps the public avoid innocent infringement.³ While the statute “does not protect all innocent infringers, the statute protects those who “innocently infringe[s] because a patentee puts unmarked products into the marketplace.”⁴ 35 U.S.C. § 287 (a) lays out clear instructions for how patent owners are supposed to mark their products.

The patent marking statute states that a patent owner is required to give notice to the public that a product is patented before damages can begin accruing in an infringement case.⁵ There are two ways to give notice provided by the marking statute: actual and constructive notice.⁶ A patentee gives actual notice to an alleged infringer when the patentee “affirmative[ly] communicate[s] to the alleged infringer a specific charge of infringement by a specific accused product or device.”⁷ On the other hand, constructive notice is when a patent owner marks their patented product that is being produced in the United States.⁸

The marking requirement serves three purposes; it helps avoid innocent infringement, it encourages “patentees to give notice to the public that the article is patented,” and aids “the public to identify whether an article is patented.”⁹ 35

* Ethan Michael Buresh; J.D. Candidate 2025. I would first like to thank my wife, Hannah Buresh, who has been my voice of encouragement and has supported our family through my time in law school. Second, I’d like to thank my father, Eric Buresh, who taught me to have drive and passion for law. Third, I would like to thank Professor Holman, who was immensely helpful in the research and editing of this Comment. Finally, I would like to thank my editor, Wyatt Hough, who worked alongside me to make this piece possible.

¹ *Bonito Boats v. Thunder Craft Boats*, 489 U.S. 141, 162 (1989) (The notice requirement is designed for informing the public and “provides a ready means of discerning the status of the intellectual property embodied in an article of manufacture or design”).

² 35 U.S.C. § 286.

³ See *Tulip Computers Int’l B.V. v. Dell Computer Corp.*, 2003 U.S. Dist. LEXIS 5409, 58-59 (D. Del. 2003) (“Encouraging patentees to give notice to the public that an article is patented (by marking the article with its patent number) aids the public in identifying whether or not an article is patented. If the public is able to identify an article as patented, innocent infringement can be avoided.”).

⁴ *Nichia Corp. v. Feit Elec. Co.*, 2023 U.S. Dist. LEXIS 4600, 11 (C.D. Cal. 2023); see also *WiAV Sols. LLC v. Motorola, Inc.*, 732 F. Supp. 2d 634, 639 (E.D. Va. 2010) (“[A] patentee who is not required to mark is not contributing to the problem of innocent infringement, and thus, should not be punished through the preclusion of damages.”).

⁵ 35 U.S.C. § 287(a).

⁶ *Kininklijke Philips, N.V. v. Zoll Med. Corp.*, 2015 U.S. Dist. LEXIS 10801, 13 (D. Mass. 2015).

⁷ *Gart v. Logitech, Inc.*, 254 F.3d 1334, 1335 (Fed. Cir. 2001) (citing *Amsted Indus. Inc., v. Buckeye Steel Castings Co.*, 24 F. 3d 178, 187 (Fed. Cir. 1994)).

⁸ See *McAfee Enters. v. Ashley Entm’t Corp.*, 2016 U.S. Dist. LEXIS 99407, 6 (N.D. Ill.) (“Constructive notice is accomplished by marking the article or its packaging in compliance with the statute”).

⁹ *Nike Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1443 (Fed. Cir. 1998).

U.S.C. § 286 provides that a “patentee cannot recover for any infringement committed more than six years prior to the filing of the infringement complaint or counterclaim.”¹⁰ However, the marking requirement under 35 U.S.C. § 287 (a) stops patent owners from being able to obtain six years of damages until it is proven that the infringer was put on notice, either constructively or actually.¹¹ Therefore, if a patent owner is not properly marking their products, “the marking requirement protects the public’s ability to exploit an unmarked product without liability for damages until a patentee provides either constructive notice through marking or actual notice.”¹² Nonetheless, through years of litigation, patentees have figured out a loophole that allows them to accrue six years of damages even with a complete failure to mark their products by incorporating method claims into their patents.

There are two general types of patent claims: apparatus and method claims.¹³ An apparatus claim describes the physical components of an invention that work together to form a predetermined result.¹⁴ On the other hand, a method claim describes the steps of a process.¹⁵ Courts have the general rule that the marking requirement only applies to apparatus claims.¹⁶ Specifically, the “making or vending” of any patented article imposes a duty on the patentee to follow the marking requirement.¹⁷ Courts also have the rule that the marking requirement cannot be applied to method claims because “there is nothing to mark.”¹⁸ Patentees have thereby found a loophole to get the full six years of damages while avoiding the marking requirement by only asserting method claims even if the patent also includes apparatus claims.¹⁹

While some jurisdictions have attempted to push back against the loophole, all are stuck applying it as there is no precedent to refute it.²⁰ Courts have been misguided in their evolution of the marking requirement and have created “anti-consumer policies by bestowing on the patentee the power to selectively mark.”²¹ The statute that was enacted to protect the public from falling prey to innocent infringement is no longer able to accomplish that task. Wrongfully, courts look at the claims brought in litigation to decide if the marking requirement should

¹⁰ *Limitations on Damages*, PAT. DEF., <https://klarquist.com/patent-defenses/time-limitation-on-damages/> (last visited Mar. 17, 2023).

¹¹ 35 U.S.C. § 287(a).

¹² *Limitations on Damages*, *supra* note 10.

¹³ James Yang, *What is an apparatus claim versus method claim?*, OC PAT. LAW. (Oct. 15, 2022), <https://ocpatentlawyer.com/what-is-an-apparatus-versus-method-claim/>.

¹⁴ See generally *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243 (Fed. Cir. 1998).

¹⁵ See generally *Nassau Precision Casting Co. v. Acushnet Co.*, 556 F. App’x 933, 939 (Fed. Cir. 2014) (“A ‘method’ in a claim . . . is a ‘process,’ and ‘method’ and ‘process’ have a clear, settled meaning: a set of actions, necessarily taken over time.”).

¹⁶ See, e.g., *Wine Ry. Appliance Co. v. Enter. Ry. Equip. Co.*, 297 U.S. 387, 398 (1936) (holding that the marking requirement only applied to patentees who “make or vend” an article).

¹⁷ *Id.* at 395.

¹⁸ *Core Optical Techs., LLC v. Juniper Networks Inc.*, 562 F. Supp. 3d 376, 379 (N.D. Cal. 2021).

¹⁹ *Id.*

²⁰ *Id.*

²¹ Christina Sharkey, *Strategic Assertions: Evading the Patent Marking Requirement*, 12 NW. J. TECH. & INTELL. PROP., 103 (2014) [hereinafter *Strategic Assertions*].

apply to the damage calculation.²² However, this Comment takes the position that the marking requirement should be based on whether there are any claims in the patent covering an apparatus that can be marked, instead of basing the requirement on what claims a plaintiff asserts in litigation. The federal circuit should attach the marking requirement on a patent-by-patent basis instead of a claim-by-claim basis.

This Comment seeks to discuss how misconstrued the marking requirement is today, and suggests a change that courts need to make to return the marking requirement to its original intent. In Part II, this Comment will focus on the history and evolution of the marking requirement as well as the policy behind it. In Part III, this Comment will focus on the *Wine Railway* decision and its effect on the marking requirement. Part IV of this Comment will focus on how other courts have attempted to fill the gaps left by the *Wine Railway* decision. In Part V, this Comment will discuss how the loophole affects the choices patent owners make when bringing litigation. Part VI will focus on how courts have attempted to push back against the loophole and change the view of the marking requirement to reflect the very policy reasons the statute was created to promote. Finally, Part VII will conclude by arguing that courts should apply the marking requirement on a patent-by-patent basis instead of a claim-by-claim basis.

II. THE MARKING REQUIREMENT: ITS LONG AND EVER-CHANGING HISTORY

The language and conditions of the marking requirement today resembles nothing of the early patent statutes. “The earliest patent statutes imposed no duty on a patent owner to mark articles.”²³ Mere public record was the only way to take notice of a patent.²⁴ However, a duty arose through the Patent Act of 1842, which required the date of the patent be put on each product, and a failure of that duty resulted in a fine of no less than 100 dollars.²⁵ The language of the current statute is very much the same as it was in 1842,²⁶ minus a few notable amendments made under the Patent Act of 1861 that played a large role in the present loophole.²⁷ The Patent Act of 1861 shifted the fee punishment for failure to mark to the rule that damages would not begin to accrue until the article had been marked or the infringer had been put on notice.²⁸ Public notice, by definition of the Act, is

²² See, e.g., *Hanson v. Alpine Valley Ski Area, Inc.*, 718 F.2d 1075, 1082-83 (Fed. Cir. 1983) (holding the marking requirement does not apply because only method claims were found infringed).

²³ Carl Oppedahl, *Patent Marking of Systems*, 11 SANTA CLARA HIGH TECH. L.J. 205, 209 (1995).

²⁴ Sharkey, *supra* note 21, at 105.

²⁵ Act of Aug. 29, 1842, ch. 263, § 6, 5 Stat. 543, 543-45 (repealed 1861).

²⁶ See Sharkey, *supra* note 21 (“The language of the current marking statute remains largely the same as it did in 1842, with only one major modification”).

²⁷ See *A Brief History Of The Patent Law Of The United States*, LADAS & PARRY (May 7, 2014), <https://ladas.com/education-center/a-brief-history-of-the-patent-law-of-the-united-states-2/> (Stating that a number of important amendments were made. One important amendment was “the 1861 revision provided . . . a requirement that to secure damages for patent infringement either the patented article had to be marked as such or the infringer had to have been given notice in some other way of the existence of the patent.”).

²⁸ Act of Mar. 2, 1861, ch. 88 § 13, 12 Stat. 249, 249 (repealed 1870).

satisfied either (1) by fixing the word “patented” on the article along with the date the patent was issued, or (2) by attaching a label to the packaging with the word “patented” and the date the patent was issued.²⁹ Akin to the present marking statute, the Patent Act of 1861 applied strictly to “cases where an article is made or vended by any person under the protection of letters-patent.”³⁰ Patent marking has remained substantially unchanged since the Patent Act of 1861.

The Patent Act of 1870 essentially rewrote the Patent Act of 1861, but in clearer terms.³¹ The act contained the same two ways of a patent holder putting the public on notice, and the same restriction on damages for failure to properly mark.³² Similarly, the Patent Act of 1927 remained virtually the same as the preceding patent acts, except it changed requiring the date of issue to requiring the patent number.³³ Following suit, the Patent Act of 1952 allowed the abbreviation ‘pat.’ to be used in place of the word ‘patent.’³⁴ The Patent Act of 1952 was the final act until 2006, when Congress passed the present marking requirement under 35 U.S.C. § 287(a).³⁵

Under 35 U.S.C. § 287(a), the patent marking statute “sets forth how to mark a patented article with a patent notice and the incentive for such marking.”³⁶ The exact language of the marking requirement states:

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, either by fixing thereon the word “patent” or the abbreviation “pat.,” together with the number of the patent, or 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, 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. 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

²⁹ *Id.*

³⁰ *Id.*

³¹ *See generally* Act of July 8, 1870, ch. 230, § 38, 16 Stat. 198, 203 (repealed 1927).

³² *See generally id.* (stating it was the duty of all patentees making or vending any patented article to give notice “either by fixing thereon the word “patented,” together with the day and year the patent was granted; or . . . by fixing it on or to the package . . . a label containing the like notice.” Failure to do so resulted in no damages, “except on proof that the defendant was duly notified of the infringement.”).

³³ Act of Feb. 7, 1927, ch. 67, § 4900, 44 Stat. 1058 (repealed 1952).

³⁴ Act of July 19, 1952, ch. 950, § 287, 66 Stat. 792, 813 (*codified* as amended at 35 USC § 287 (1952)).

³⁵ 35 U.S.C. § 287(a).

³⁶ *Making the Most of Your Patent: Patent Marking*, VENABLE LLP (May 31, 2017), <https://www.venable.com/insights/publications/2017/05/making-the-most-of-your-patent-patent-marking>.

damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.³⁷

It is the clear intent of Congress that the marking requirement only apply to articles that are capable of being made and labeled with proper notice. Section 287(a) had the original intent of “being a sort of gotcha trap for a patent owner who fails to mark their product.”³⁸ Effectively, a patent owner is estopped from collecting damages on patent infringement if they sell their patent without proper marking and lead “the public to believe that it is not patented.”³⁹ The idea behind this line of thinking is that a patent owner does not have a right to complain “for damages if a member of the public who has not been given actual notice of the patent chooses to copy the product.”⁴⁰

However, through litigation at the federal circuit, the obvious “gotcha” trap against patent owners transitioned to a sneaky “gotcha” trap against innocent infringers. Plaintiffs realized that even if they did patent both apparatus claims (where the marking requirement applies) and method claims (where the marking requirement does not apply), they could still collect full damages by only asserting infringement of method claims.⁴¹ The policy reasons behind the marking requirement have been subverted, and the marking requirement is no longer able to protect innocent infringers.⁴²

III. LEADING PRECEDENT: *WINE RAILWAY* PAVING THE WAY FOR LOOPHOLES

In the landmark case, *Wine Railway Appliance Co. v. Enterprise Railway Equipment Co.*,⁴³ the Supreme Court resolved many concerns regarding the vagueness of the marking requirement by narrowly construing what the language of the statute applies to.⁴⁴ One of the primary issues decided in this case was whether the infringer, Enterprise Railway, should be liable for damages for infringing on a patented product that was never made or produced by Wine Railway, the patentee.⁴⁵ Because Wine Railway never produced the patented article, Enterprise’s first notice of infringement was when the infringement suit

³⁷ § 287(a).

³⁸ Oppedahl, *supra* note 23, at 211 (“Thus, § 287 may be thought of as a “gotcha”, a trap for the unwary patent owner who fails to mark a product.”).

³⁹ *Id.*

⁴⁰ *Id.*

⁴¹ *See, e.g.*, *Core Optical Techs., LLC v. Juniper Networks Inc.*, 562 F. Supp. 3d 376, 379 (N.D. Cal. 2021) (first case holding that the only claims the marking requirement applied to was the claims brought in litigation).

⁴² *See, e.g.*, Tarun Gopalakrishnan & Adarsh Ramanujan, *Patent Marking in the U.S. and India – A Comparison*, LAKSHMIKUMAMARAN & SRIDHARAN (Dec. 7, 2011) (“The purpose achieved by marking the article is awareness among the general public and to protect innocent infringers.”).

⁴³ *Wine Ry. Appliance Co. v. Enterprise Ry. Equipment Co.*, 297 U.S. 387, 398 (1936).

⁴⁴ *Id.*

⁴⁵ *Enterprise Ry. Co. v. Wine Ry. Appliance Co.*, 77 F.2d 159, 160-61 (6th Cir. 1935) (the names are reversed because Enterprise appealed to the 6th circuit).

was filed by Enterprise.⁴⁶ Due to a lack of uniformity on how to interpret the patent marking statute at the time, the Sixth Circuit attempted to hand down a clear, cut-throat rule on how to apply the marking statute.⁴⁷

The Sixth Circuit Court of Appeals began by comparing the patent marking statute in effect at the time, 35 U.S.C. § 49, and the former Patent Act of 1861.⁴⁸ The Court of Appeals recognized that the Patent Act of 1861 did create a duty for a patentee to give notice to the public only if the patent encompassed an article that was “made or vended.”⁴⁹ Then, the Court turned to the present statute and attempted to “give the statute a construction which seems to us to carry out [35 U.S.C. § 49’s] purpose.”⁵⁰ The Court noted that Patent Act of 1861 specifically included language that only patent owners who made or vended an article were required to mark their articles.⁵¹ However, as the Court noticed, the marking requirement under § 49 added the language that “notice be given by all patentees and their assigns and legal representatives, and also, by all persons making or vending the patented article.”⁵² Therefore, the Court read the additional language of “all patentees and their assigns” as the marking requirement applying to all patentees.⁵³ Because of this difference, the Court of Appeals concluded that “the present [statute] requires notice be given by all patentees.”⁵⁴ Thus, the Court decided that Wine Railway could not begin accruing damages until *after* proper notice was given, which in this case was the date of the lawsuit.⁵⁵

Wine Railway appealed the Court of Appeal’s decision to the Supreme Court of the United States. Enterprise once again argued that under 35 U.S.C.S § 49, “the duty to give notice of infringement is imposed without limitation upon ‘all patentees.’”⁵⁶ Enterprise pointed the Supreme Court back to the very reason for the creation of the patent marking statute in the first place: “to prevent innocent infringement.”⁵⁷ Wine Railway argued that the Court of Appeals decision on the statute applying to all patentees completely misconstrues the language in § 49.⁵⁸ Instead, Wine Railway argued that the legislative intent was that the burden of putting the public on notice only applied to patented articles that are “made or vended.”⁵⁹ The Supreme Court sided with Wine Railway and stated that the

⁴⁶ *Id.*

⁴⁷ *Id.* at 160.

⁴⁸ *Id.*

⁴⁹ *Id.* at 160-61.

⁵⁰ *Id.* at 160.

⁵¹ *Id.* at 160-61.

⁵² *Wine Ry. Appliance Co. v. Enterprise R. Equipment Co.*, 297 U.S. 387, 397-98 (1936).

⁵³ *Enterprise Ry. Co.*, 77 F.2d at 160.

⁵⁴ *Id.*

⁵⁵ *See id.* at 161 (“This is the only difference between the two statutes, and in our opinion the amendment to the old statute as embodied in the new requires the patentee or his assignee who does not make or vend the article to give notice of the patent and limits the recovery for infringement thereof to damages sustained thereafter. As no notice was given in this case until the date of the filing of the counterclaim, the period of accounting began on that date.”).

⁵⁶ *Wine Ry. Appliance Co.*, 297 U.S. at 394.

⁵⁷ *Id.*

⁵⁸ *Id.* at 393-94.

⁵⁹ *Id.* at 393.

language only applies if an individual makes or sells an article, and does not apply to method patents as that conclusion would place an undue burden on the owner.⁶⁰ This decision was based on the court's interpretation of the history of the marking requirement as well as its application in prior cases.⁶¹ In consequence, the judgment was overturned, and leading precedent was established that the patent marking requirement solely pertains to apparatus claims.⁶² While the court's reasoning seems sound when applying its ruling to cases where patents only contain method or apparatus claims, the case is not without its inadequacies. *Wine Railway* failed to shed light on the question that would lead to the development of the present loophole: how does the marking requirement apply to patents that contain both types of claims?

IV. HOW OTHER COURTS HAVE FILLED THE GAP LEFT BY *WINE RAILWAY*

A. How the Marking Requirement Should Apply to Patents Containing Both Apparatus and Method Claims

Other courts have attempted to fill the gap that was left by the *Wine Railway* decision. For example, the court in *Devices for Medicine, Inc. v. Boehl* faced the issue of how the present marking requirement under § 287(a) applies to patents that contain both apparatus and method claims. In *Devices for Medicine*, Devices for Medicine (“DFM”) sued Boehl for infringing DFM’s patented medical introducer (a device used to insert medical devices into a human body).⁶³ The key issue was that the patent claimed both an apparatus for a medical introducer and method claims for “using the introducers to insert medical devices in the human body.”⁶⁴ DFM failed to mark the medical introducers they were manufacturing, but argued they were still entitled to the full range of damages because the patent contained method claims.⁶⁵ The court failed to see the merit in the argument and reinforced the concept that if there is something to mark, it must be marked or notice must be served to the infringer before damages can accrue.⁶⁶ An interesting argument made by DFM is that Boehl knew that the patent existed, and that should

⁶⁰ *Wine Ry. Appliance Co. v. Enterprise R. Equipment Co.*, 297 U.S. 387, 395 (1936) (“If the word ‘patentees’ is not qualified by ‘making or vending any patented article,’ the section would seem to impose on such persons a duty to the public impossible of performance when no article is made or vended by them.”).

⁶¹ *See id.* at 396-97.

⁶² *Id.* at 398 (holding that the marking requirement only applied to patentees who “make or vend” an article).

⁶³ *Devices for Med., Inc. v. Boehl*, 822 F.2d 1062, 1063 (Fed. Cir. 1987).

⁶⁴ *Id.*

⁶⁵ *See id.* at 1066 (“DFM made no further objection, but argues on appeal that the stipulation of infringement made notice unnecessary . . . and that notice is not required when the patent contains method claims.”).

⁶⁶ *Id.*

serve as adequate notice of infringement.⁶⁷ Nonetheless, the court doubled down and held “BOEHL’s ‘knowledge of the patents’ is irrelevant. Section 287 requires ‘proof that the infringer was *notified of the infringement.*’”⁶⁸ Thus, *Devices for Medicine* set precedent for how to address the marking requirement when dealing with a patent that contains both apparatus and method claims.

Many other courts reinforced the *Devices for Medicine* court and established the “tangible item” rule.⁶⁹ The case *American Medical Sys. v. Medical Eng’g Corp.* dealt with the very same issue that *Devices for Medicine* did.⁷⁰ This case began in District Court when American Medical Systems (“AMS”) sued Medical Engineering Corp. (“MEC”) for patent infringement of a patent for a prosthetic device that contained both method and apparatus claims.⁷¹ Since the court found that MEC was infringing AMS’s patent, the issue turned on how to calculate damages for an infringement suit that involved both method and apparatus claims.⁷² MEC argued that damages should be limited because AMS failed to mark their patent and AMS “never provided ‘notice’ of the claimed infringement until [the] lawsuit was filed.”⁷³ Following the same line of logic as the court in *Devices For Medicine*, the District Court agreed with MEC’s argument and stated, “a patentee should not be relieved of its duty to alert the public that its product is patented simply because the patent also alleges method claims.”⁷⁴ Because of this, the District Court concluded that damages were limited to the date that MEC was put on notice of their infringement on AMS’s patent.⁷⁵

AMS then appealed the ruling on damages to the Court of Appeals. The Court of Appeals affirmed the lower court’s holding because of the policy reasons for the marking requirement under § 287(a).⁷⁶ In the words of the court:

The purpose behind the marking statute is to encourage the patentee to give notice to the public of the patent. The reason that the marking statute does not apply to method claims is that, ordinarily, where the patent claims are directed to only a method or process there is nothing to

⁶⁷ See *id.* (“DFM made no further objections, but argues on appeal that the stipulation of infringement made notice necessary, that John Boehl admitted ‘knowledge of the patents . . .’”).

⁶⁸ *Devices for Med., Inc. v. Boehl*, 822 F.2d 1062, 1066 (Fed. Cir. 1987) (emphasis in original).

⁶⁹ See, e.g., *Am. Bank Note Holographics, Inc. v. Upper Deck Co.*, 1997 U.S. Dist. LEXIS 657, 3-4 (S.D.N.Y.) (“Where the patent contains both apparatus and method claims, however, to the extent there is a **tangible item** to mark by which notice of the asserted method claims can be given, a party is obliged to do so if it intends to avail itself of the constructive notice provisions of section 287(a).”) (emphasis added).

⁷⁰ See generally *Am. Med. Sys. v. Med. Eng’g Corp.*, 6 F.3d 1523 (Fed. Cir. 1993).

⁷¹ *Am. Med. Sys. v. Med. Eng’g Corp.*, 794 F. Supp. 1370, 1376 (E.D. Wis. 1992).

⁷² *Id.* at 1387 (“Since the court has determined that the Klatt patent is not invalid for obviousness, and MEC has stipulated that its Flexi-Flate prosthesis would infringe upon such a finding, the court must consider the amount of damages to which AMS is entitled.”).

⁷³ *Id.* at 1391.

⁷⁴ *Id.*

⁷⁵ See *id.* at 1393 (“Thus, AMS’ damages for lost profits are limited to November and December 1987 and appropriately determined as follows . . .”).

⁷⁶ See *Lairam Corp. v. Hewlett-Packard Co.*, 806 F. Supp. 1294, 1296 (E.D. La. 1992) (stating that “[t]he purpose of [the constructive notice provision] is to give patentees the proper incentive to mark their products and thus place the world on notice of the existence of the patent”).

mark. Where the patent contains both apparatus and method claims, however, to the extent that there is a tangible item to mark by which notice of the asserted method claims can be given, a party is obliged to do so if it intends to avail itself of the constructive notice provisions of section 287(a).⁷⁷

The court recognized that the reason for even having the marking requirement in the first place is to protect innocent infringers.⁷⁸ Accordingly, the *American Medical Systems* court reinforced the unofficial “tangible item” rule that states where a patent contains an apparatus that can be marked, the patentee must mark their product or face significantly less damages.⁷⁹ If courts would have left the “tangible item” rule for all patents that contain both method and apparatus claims, there would be no loophole. However, one issue was still left to be faced by courts: what to do when a patent contains both method and apparatus claims, but only method claims are asserted in litigation.

B. How the Marking Requirement Should Apply When Only Method Claims are Asserted

This very question was answered by the case *Hanson v. Alpine Valley Ski Area, Inc.*⁸⁰ The issue before the court in *Hanson* revolved around Alpine Ski infringing Hanson’s patent for “a method and apparatus for making snow used in winter sports.”⁸¹ While the patent contained both method and apparatus claims, only the method claims were brought forward in the litigation. Alpine Valley—following the established “tangible item” rule found in *Devices for Medicine* and *American Medical Systems*—still attempted to argue that damages should be significantly reduced because Hanson failed to show that they properly marked their snow making products.⁸² Nonetheless, the *Hanson* court stated that the only patent claims brought forward were claims directed to “the method of forming, distributing and depositing snow upon a surface . . .”⁸³ The court added that “[i]t is settled in the case law that the notice requirement of this statute does not apply where the patent is directed to a process or method.”⁸⁴ Therefore, it was decided that 35 U.S.C. § 287(a) did not apply to this suit, and that Hanson had no duty to mark or put Alpine Valley Ski on notice that they were infringing before damages could accrue.⁸⁵ Hence, because of the *Hanson* decision, the present outrageous

⁷⁷ *Am. Med. Sys. v. Med. Eng’g Corp.*, 6 F.3d 1523, 1538-39 (Fed. Cir. 1993).

⁷⁸ *Id.* at 1538.

⁷⁹ *Id.* at 1538-39.

⁸⁰ *Hanson v. Alpine Valley Ski Area, Inc.*, 718 F.2d 1075 (Fed. Cir. 1983).

⁸¹ *Id.* at 1076.

⁸² *Id.* at 1082.

⁸³ *Id.* at 1083.

⁸⁴ *Id.* (citing *Bandag, Inc. v. Gerrard Tire Co.*, 704 F.2d 1578, 1581 (Fed. Cir. 1983)).

⁸⁵ See generally *Hanson*, 718 F.2d at 1082-83 (The magistrate judge rejected the argument that § 287(a) should apply because “the patent is a process patent.” The Court of Appeals agreed with the magistrate judge because “[t]he only claims that were found infringed in this case . . . were claims

loophole was born. 35 U.S.C. § 287(a) no longer can protect innocent infringers, and patent owners are now able to cleverly evade the marking requirement by only asserting method claims in litigation.

V. HOW THE LOOPHOLE AFFECTS LITIGATION FOR PATENT OWNERS

An important stage for a patent owner in every patent litigation is deciding what claims they believe are being infringed.⁸⁶ However, while this may seem like an obvious decision for a patent owner to make, § 287(a) has created a whole new dynamic for patent owners to think about. Because of the established loophole in the marking requirement, owners of patents containing both method and apparatus claims need to think about how the marking requirement and the loophole will affect their damages.⁸⁷ The safe advice to give patent owners is if the patent contains apparatus claims that results in a tangible item, the owner should make every effort to mark the item for pre-suit damages to start accruing.⁸⁸ Under the expressed language of 35 U.S.C. § 286, “[e]xcept as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.”⁸⁹ Thus, if properly marking, a patent owner can start from the day of filing the initial complaint and count backwards six years to calculate the amount of damages they are entitled to.⁹⁰

However, not every owner executes their marking due-diligence, which is where the loophole saves the owner and allows them to still obtain six years of pre-

1,2, and 6 of the Hanson patent which are drawn to ‘the method of forming, distributing and depositing snow upon a surface’” (citing *Hanson v. Alpine Valley Ski Area, Inc.*, 611 F.2d 156, 158 (6th Cir. 1979)).

⁸⁶ See David K. Mroz & Laith M. Abu-Taleb, *Maximizing Damages: The Importance of Considering Marking Law When Selecting Claims to Assert in Litigation*, FINNEGAN (Oct. 2017), [Finnegan.com/en/insights/articles/maximizing-damages-the-importance-of-considering-marking-law-when-selecting-claims-to-assert-in-litigation.html](https://www.finnegan.com/en/insights/articles/maximizing-damages-the-importance-of-considering-marking-law-when-selecting-claims-to-assert-in-litigation.html) (“At every point in every patent litigation, a plaintiff must identify the specific claims it believes are infringed.” However, the issue is “the fact that patents often have different types of claims, i.e., some claims can be directed to an apparatus while others can be directed to a method of using that apparatus.”).

⁸⁷ See Douglas Portnow, *Patent Marking: The Proper Method to Display Protection*, NAT’L L. REV. (July 23, 2020), <https://www.natlawreview.com/article/patent-marking-proper-method-to-display-protection> (patent owners must think about their decision because “[i]n situations where the patent has both method and device claims . . . if only the method claims are going to be asserted against an infringer, patent marking is probably not required.” However, “[i]f the device claims are going to be asserted, patent marking is appropriate.”).

⁸⁸ See, e.g., *Patent Marking Requirements: Patented Articles Must be Marked as Patented in Order For Patentee to Recover Damages Due to Patent Infringement*, FINDLAW (June 9, 2017), [corporate.findlaw.com/intellectual-property/patent-marking-requirements-patented-articles-must-be-marked-as.html](https://www.findlaw.com/intellectual-property/patent-marking-requirements-patented-articles-must-be-marked-as.html) [hereinafter *Patent Marking Requirements*].

⁸⁹ 35 U.S.C. § 286.

⁹⁰ See Jean Dassie, *Federal Circuit on Section 286 and the statute of limitation for patent infringement damages*, FED. CIR. ON DAMAGES AND OTHER REMEDIES (Jan. 9, 2020),

suit damages.⁹¹ Patent attorneys advise their clients to file patents that contain both apparatus and method claims to cover all their bases for pre-suit damages.⁹² In litigation, asserting method claims becomes “even more appealing if the plaintiff can assert a viable damages theory that links the defendant’s use of the method claims to product sales (i.e., a theory that allows the plaintiff to collect product sale damages for method claim infringement).”⁹³ However, method claims may not be the strongest claims to bring in litigation and “may allow the introduction of non-infringement defenses that do not apply to system claims (such as for method claims that requires the participation of multiple parties).”⁹⁴ Method claims are typically weaker during litigation because method claims are hard to detect and it is easier to design around method claims.⁹⁵

Corey Johanningmeier, a patent attorney in San Francisco, says he wouldn’t advise a client to “drop apparatus claims at any point in a case – even if there were marking issues – because getting damages on method claims could be challenging.”⁹⁶ Johanningmeier believes that clients who assert apparatus claims in litigation have a better chance at gaining more damages because they “could argue that defendants infringed if they sold, imported or used the allegedly infringing product.”⁹⁷ “But plaintiffs that only assert method claims are more likely to have to rely on theories of induced infringement, or on showing that defendants actively encouraged infringement among users.”⁹⁸ Induced infringement is an infringement theory that “the defendant knew of the patent and knew that ‘the induced acts constitute patent infringement.’”⁹⁹ Induced infringement is difficult to prove because a plaintiff must prove that a defendant knew (1) of the plaintiff’s patent, and (2) knew that the acts it was inducing would infringe plaintiff’s

<https://www.fedcircdamages.com/federal-circuit-on-section-286-and-the-statute-of-limitations-for-patent-infringement-damages> (stating “one starts from the filing of a complaint or counterclaim and counts backward to determine the date before which infringing acts cannot give rise to a right to recover damages”); *see also* *Kippen v. Pack*, 491 Fed. Appx. 187, 189 (Fed. Cir. 2012) (“Second, the district court properly applied section 286 of the Patent Act in holding that Mr. Kippen could not be awarded damages for infringements occurring more than six years before the filing of this case.”).

⁹¹ *See Dassic, supra* note 90.

⁹² *See, e.g., Patent Marking Requirements, supra* note 88 (stating “[i]f patentee does not mark the tangible item, then patentee might be able to recover damages for infringement occurring prior to notice by asserting only the process claims.”).

⁹³ *Mroz & Abu-Taleb, supra* note 86.

⁹⁴ Mitchell S. Feller, “*THIS PRODUCT IS COVERED BY MY PATENT*” – *THE IMPORTANCE OF PATENT MARKING*, GOTTLIEB, RACKMAN & REISMAN, P.C., <https://grr.com/publications/product-covered-patent-importance-patent-marking/> (last visited Jan. 26, 2024).

⁹⁵ *See PART 6: PROTECT YOUR METHOD WITH METHOD CLAIMS*, CHILDS PAT. L. (Apr. 7, 2020), <https://childspatentlaw.com/part-6-protect-your-method-with-method-claims/>.

⁹⁶ Rani Mehta, *How Marking Mishaps Mess up Patent Litigation Strategies*, MANAGING IP (May 13, 2022), <https://www.mckoolsmith.com/assets/htmldocuments/2022%2005%2016%20How%20Marking%20Mishaps%20Mess%20up%20Patent%20Litigation%20Strategies-Managing%20IP.pdf>.

⁹⁷ *Id.*

⁹⁸ *Id.*

⁹⁹ *Commil USA, LLC v. Cisco Sys.*, 575 U.S. 632, 640 (2015) (citing *Global-Tech Appliances, Inc. v. SEB S.A.*, 563 U.S. 754, 766 (2011)).

patent.¹⁰⁰ Infringement of method patents is also difficult to prove because, according to Supreme Court case law, “the patent is not infringed unless all the steps are carried out.”¹⁰¹ Additionally, the sale of an apparatus that is capable of performing a patented method is not direct infringement.¹⁰² “The sale of the apparatus is not a sale of the method. A method claim is directly infringed only by practicing the patented method.”¹⁰³ Therefore, patent owners have a tough choice between failing to mark and risk only bringing method claims, or to properly mark and have a much better chance at winning litigation.

VI. HOW COURTS HAVE ATTEMPTED TO PUSH BACK AGAINST THE LOOPHOLE

Some courts have attempted to negate the harsh loophole that has been created by the inadequacies of the marking requirement.¹⁰⁴ Take *Crown Packaging Technology, Inc. v. Rexam Beverage Can Co.* for example.¹⁰⁵ In this case, which appeared before the Delaware District Court, Crown Packaging attempted to argue that since the patent-in-suit contained both apparatus and method claims, the marking requirement should apply.¹⁰⁶ Crown Packaging did concede that if the patent-in-suit only contained method claims, then there would be no argument regarding the marking requirement because there would be nothing to mark.¹⁰⁷ The crux of Crown Packaging’s argument was that compliance with the marking requirement under 35 U.S.C. § 287(a) should be based on whether the patent was commercialized, not based on claim-choosing for litigation.¹⁰⁸ Crown Packaging supported this argument by pointing the court back to the policy behind the marking requirement, and stated: “As a policy matter, patentees should be encouraged to mark their products, and permitting patentees to later on elect to proceed only on method claims to excuse non-compliance with the marking statute would undermine that goal.”¹⁰⁹ The district court agreed with the argument, and awarded Crown Packaging summary judgment because Rexam’s failure to mark awarded them no damages under 35 U.S.C. § 287(a). Unfortunately, the Court of Appeals for the Third Circuit reversed the decision and claimed that they could not go against the established rule that 35 U.S.C. § 287(a) “did not apply where the

¹⁰⁰ *Global-Tech Appliances, Inc.*, 563 U.S. at 754.

¹⁰¹ *Limelight Networks, Inc. v. Akamai Techs., Inc.*, 572 U.S. 915, 921 (2014); *see also* *Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1317 (Fed. Cir. 2009) (“To [directly] infringe a method claim, a person must have practiced all steps of the claimed method.”).

¹⁰² *Joy Techs., Inc. v. Flakt, Inc.*, 6 F.3d 770, 774-75 (Fed. Cir. 1993).

¹⁰³ *Id.*

¹⁰⁴ *Crown Packaging Technology, Inc. v. Rexam Beverage Can Co.*, 498 F. Supp. 2d 718, (D. Del. 2007).

¹⁰⁵ *Id.*

¹⁰⁶ Response and Reply Brief of Plaintiffs-Appellants Crown Packaging Technology, Inc. and Crown Cork Seal USA, Inc. at *59, *Crown Packaging Tech., Inc. v. Rexam Beverage Can Co.*, 559 F.3d 1308 (Fed. Cir. 2009) (No. 08-1284).

¹⁰⁷ *Id.* at 57.

¹⁰⁸ *Id.* at 59-61.

¹⁰⁹ *Id.* at 63 (citing *Merck & Co. v. Mediplan Health Consulting, Inc.*, 434 F. Supp. 2d 257, 266 n.5 (S.D.N.Y. 2006)).

patentee only asserted the method claims of a patent which included both method and apparatus claims.”¹¹⁰

There are other small glimmers of hope that courts are starting to reverse course from leading precedent that has misconstrued the purpose of the marking requirement. One example can be found in *Honeywell International Inc. v. Hamilton Sundstrand Corp.*¹¹¹ This case consisted of Honeywell suing Hamilton for patent infringement of two patents, both relating to technology for auxiliary power units that were used to power small gas turbines typically found in airplanes.¹¹² The interesting part is the ‘893 patent was strictly an apparatus patent, while the ‘194 patent covered “a method for controlling surge.”¹¹³ Hamilton argued Honeywell’s damages should be significantly reduced because it failed to mark its products.¹¹⁴ Honeywell responded that since the ‘194 patent covers a method, it was not required to mark its patent in respect to damages for that patent.¹¹⁵ Honeywell even cited to the prosecution history for the two patents where the patent examiner urged Honeywell to create two separate patents instead of combining them into one because they claimed “materially different inventions.”¹¹⁶ By all means, the court had every right to follow precedent that the marking requirement does not apply to method claims.

Surprising, the court went the other direction. The court, in quoting *American Medical Systems*, restated that the purpose of § 287(a)

[I]s to encourage the patentee to give notice to the public of the patent. The reason that the marking statute does not apply to method claims is that, ordinarily, where the patent is directed to only a method or process[,] there is nothing to mark. Where the patent contains both apparatus and method claims, however, to the extent that there is a tangible item to mark by which notice of the asserted method claims can be given, a party is obligated to do so if it intends to avail itself of the constructive notice provisions of Section 287(a).¹¹⁷

¹¹⁰ *Crown Packaging Tech., Inc. v. Rexam Beverage Can Co.*, 559 F.3d 1316 (Fed. Cir. 2009).

¹¹¹ *Honeywell Int’l, Inc. v. Hamilton Sundstrand Corp.*, No. 99-309 GMS, 2001 U.S. Dist. LEXIS 26057, at 2-3 (D. Del. 2001).

¹¹² *Id.* (“Honeywell International Inc. (‘Honeywell’) filed this suit against Hamilton Sundstrand (‘Sundstrand’) in May of 1999 alleging that Hamilton Sundstrand Corporation (‘Sundstrand’) is infringing Honeywell patents: 4,380,893, 4,428,194 and the 4,337,615 ((the ‘893 patent,’ ‘194 patent,’ and the ‘615 patent,’ respectively). The lawsuit relates to technology for auxiliary power units (‘APU’). An APU is a small gas turbine engine, usually placed in the tail section of an airplane, that generates electricity for use while the aircraft is on the ground or in flight.”).

¹¹³ *Id.* at 8-9.

¹¹⁴ *See id.* at 7 (“Sundstrand also argues that Honeywell’s failure to mark its products before February 1999 limits damages in the event that Sundstrand is found to have infringed Honeywell’s patents.”).

¹¹⁵ *See id.* (“In contrast, Honeywell contends that it was not required to mark the products because the patents at issue involve method patents.”).

¹¹⁶ *Id.* at 9 (Before being reviewed by the patent office, the ‘893 and the ‘194 patent were originally presented as one patent. However, as Honeywell points out, the patent examiner decided to “separate the patents at the application stage because the two patents claimed “materially different inventions.”)

¹¹⁷ *Id.* at 10. (citing *Am. Med. Sys. v. Med. Eng’g Corp.*, 6 F.3d 1523, 1538-39 (Fed. Cir. 1993)).

Honeywell attempted to distinguish the '194 patent which was strictly a methods patent from the patent in *American Medical Systems* that consisted of both apparatus and method claims.¹¹⁸ However, the court was unpersuaded by this argument, and after considering the purpose of the statute as well as the reasoning of the *American Medical Systems*, granted summary judgement in favor of Hamilton for Honeywell's failure to mark.¹¹⁹ The decision serves as an example of a court attempting to "revert to the policy-driven definition of when the marking requirement should apply."¹²⁰

A very similar glimpse of hope took place in *Sovereign Software LLC v. Amazon.com, Inc.*¹²¹ In this case, Sovereign Software alleged that Amazon was infringing on three of their patents, all three including both method and apparatus claims.¹²² Specifically, the issue in the case came down to if a website was considered a "tangible item" that met the requirements to trigger the marking requirement.¹²³ Sovereign argued that a website "is an intangible object that cannot be marked."¹²⁴ Amazon disagreed with Sovereign's stance and stated that "Sovereign's thirty-two licensees that operate websites did not include a mark on those websites and thus failed to comply with the marking statute."¹²⁵ Amazon was also able to offer evidence proving that it was possible to mark websites with the patent number.¹²⁶ Thus, the decision on the issue was in the court's hands.

The court looked at the issue through the lens of the *American Medical Systems* decision. It applied the well-established rule that "[w]hen dealing with a patent that includes method and apparatus claims, a tangible item that can be marked is required to be marked in order to comply with the marking statute."¹²⁷ Through the evidence produced by Amazon, and the *American Medical Systems* holding, the court sided with Amazon and significantly reduced the damages available to Sovereign.¹²⁸ In the eyes of the court, to agree with Sovereign's arguments would go against the policy reasons for the marking requirement.¹²⁹

¹¹⁸ *Id.* at 9-10 ("Thus, Honeywell contends that the '194 patent is distinguishable from the patent in *American Medical Systems* which involved a single patent with both apparatus and method claims. The plaintiff in *American Medical Systems* contended that it did not have to mark the product because it was only asserting methods claims.").

¹¹⁹ *Id.* at 9-11.

¹²⁰ Sharkey, *supra* note 21, at 118.

¹²¹ *Sovereign Software v. Amazon.com*, 383 F. Supp. 2d 904 (E.D. Tex. 2005).

¹²² *Id.* at 906-09.

¹²³ *See id.* at 909 (Sovereign argued that a website was considered an intangible item that could not be marked, and asked the court to decide "an item's status as tangible or intangible defined apart from whether it can be marked.").

¹²⁴ *Id.*

¹²⁵ *Id.*

¹²⁶ *See id.* ("Here, however, Amazon has produced evidence that a website can be marked by submitting screen shots of websites that include patent notices. Amazon also submits evidence that Open Market did require one of its licensees to the 780 patent include a patent mark identifying the patent in its website's legal notices section.").

¹²⁷ *Id.* (citing *American Medical Sys.*, 6 F.3d at 1538).

¹²⁸ *See generally id.* (Sovereign was unable to raise an issue of fact that could defeat Amazon's summary judgment motion).

¹²⁹ *Id.* (the court states that Sovereign's position "contradicts the purposes of the marking requirement

Similarly, the policy reasons behind the marking requirement have recently led to the Federal Circuit to rule against parties using disclaimers to get around the marking requirement.

A disclaimer is when a patent owner renounces their ownership of a certain claim in a patent to the U.S. Patent and Trademark Office, removing all rights and interest to such claim.¹³⁰ This tactic was attempted in the case *Rembrandt Wireless Techs., LP v. Samsung Elecs. Co.* to get around the marking requirement. For background, Rembrandt Wireless (“Rembrandt”) sued Samsung for infringing two patents (the ‘580 and ‘228 patents) that related to a system and method for “communication among a plurality of modems in a network.”¹³¹ Prior to trial, Samsung “moved to limit Rembrandt’s potential damages award based on its failure to mark products covered by previously-asserted claim 40 of the ‘580 patent.”¹³² Because claim 40 of the asserted patent was a system claim, and because Rembrandt had sold unmarked products, “Samsung sought to limit Rembrandt’s damages to those incurred after Samsung received notice of Rembrandt’s patents,” which, according to Samsung, “occurred when Rembrandt filed its complaint.”¹³³ Coincidentally, eight days later, Rembrandt removed claim 40, the only apparatus claim, “from its infringement allegations and filed a statutory disclaimer pursuant to 35 U.S.C. 253(a) . . . disclaiming claim 40 in the U.S. Patent and Trademark Office.”¹³⁴ Originally, the district court “denied Samsung’s motion to bar Rembrandt’s recovery of pre-notice damages based on Rembrandt’s disclaimer of claim 40.”¹³⁵ The district court agreed with Rembrandt’s argument that any duty to mark vanished once Rembrandt disclaimed claim 40.¹³⁶ This ruling would have “effectively provide[d] an end-run around the marking statute” and was a blatant disregard for the statute’s purpose.¹³⁷

Nonetheless, the federal circuit was able to reconcile this mistake. The Court of Appeals emphasized “that the marking statute serves to protect the public.”¹³⁸ “In denying Samsung’s motion, the district court relied on the proposition that a disclaimer patent claim is treated as if it ‘had never existed in the patent,’” and therefore excused the failure to mark.¹³⁹ The federal circuit noted “while we have held that a disclaimer relinquishes the rights of the patent owner, we have never held that the patent owner’s disclaimer relinquishes the rights of the

-- avoiding innocent infringement, encouraging patentees to give notice to the public that the item is patented, and aiding the public in identifying patented articles.”)

¹³⁰ See 35 U.S.C. § 253 (a) (“A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent.”).

¹³¹ *Rembrandt Wireless Techs. v. Samsung Elecs.*, 853 F.3d 1370, 1374 (Fed. Cir. 2017).

¹³² *Id.* at 1382.

¹³³ *Id.*

¹³⁴ *Id.*

¹³⁵ *Id.*

¹³⁶ *Id.* (The court accepted Rembrandt’s argument that any prior obligation to mark products embodying claim 40 vanished once it disclaimed claim 40.).

¹³⁷ *Id.* at 1383.

¹³⁸ *Id.*

¹³⁹ *Id.* (citing *Guinn v. Kopf*, 96 F. 3d 1419, 1422 (Fed. Cir. 1996)).

public.”¹⁴⁰ With the rights of the public in mind, the federal circuit held that a “disclaimer cannot serve to retroactively dissolve the 287(a) marking requirement for a patentee to collect pre-notice damages.”¹⁴¹

Possibly the biggest backlash against past precedent regarding the marking requirement came in the case *Core Optical Techs., LLC v. Juniper Networks Inc.*¹⁴² This case involved Core Optical suing Juniper Networks for patent infringement of a patent dealing with fiber optics.¹⁴³ In past litigation, Core Optical had sued several different companies asserting both method and apparatus claims from the ‘211 patent.¹⁴⁴ Contrarily, in this infringement suit, Core Optical was only asserting method claims.¹⁴⁵ Juniper Networks filed a motion to dismiss “arguing primarily that because Core Optical failed to comply with the marking requirement, it cannot now seek damages.”¹⁴⁶ However, citing the rule in *Hanson*, the court determined that Core Optical was not required to mark its product because it was only asserting method claims in litigation.¹⁴⁷ While the court openly admitted that the precedent “appears to be wrong,” they were “stuck applying it.”¹⁴⁸

While there have been some victories in seeing the marking statute applied for the very reason it was enacted, these victories are few and far between. Therefore, while courts voice their frustrations over the deficiencies of the marking statute,¹⁴⁹ they all remain bound by precedent. *Hanson’s* rule that the marking requirement only applies to patent claims brought in litigation remains the supreme law.¹⁵⁰

VII. CONCLUSION

35 U.S.C. § 287(a), a statute that was enacted to promote the protection of the public from innocent infringement, has now paved the way for one of the biggest loopholes in patent law. The general rule is that the marking requirement under § 287(a) does not apply to method claims because there is simply nothing to

¹⁴⁰ *Id.* at 1383-84.

¹⁴¹ *Id.* at 1384.

¹⁴² *Core Optical Techs., LLC v. Juniper Networks Inc.*, 562 F. Supp. 3d 376, 378-79 (N.D. Cal. 2021).

¹⁴³ *Id.* (The ‘211 patent dealt with “increase data transmission through fiber optic cables by decreasing signal interference”).

¹⁴⁴ *Id.* at 378.

¹⁴⁵ *Id.*

¹⁴⁶ *Id.* at 379.

¹⁴⁷ *Id.* (“Moreover, as relevant here, the Federal Circuit has held that even where a patent contains both apparatus and method claims, and even when there is something to mark, a patentee can avoid the marking requirement by asserting only method claims in litigation,” (citing *Hanson v. Alpine Valley Ski Area, Inc.*, 718 F.2d 1075, 1083 (Fed. Cir. 1983)).

¹⁴⁸ *Id.*

¹⁴⁹ *See id.* (The court in *Core Optical Techs.* stated courts have misconstrued how to apply 35 U.S.C. § 287(a) to patents containing both apparatus and method claims, and that the “precedent appears to be wrong.” However, the court was stuck “applying it.”).

¹⁵⁰ *See generally* *Am. Med. Sys. v. Med. Eng’g Corp.*, 794 F. Supp. 1370, 1376 (E.D. Wis. 1992); *cf. Laitram Corp. v. Hewlett-Packard Co.*, 806 F. Supp. 1294, 1296 (E.D. La. 1992).

mark.¹⁵¹ Following this strict line of thinking, courts have created the blackletter law that 35 U.S.C. § 287(a) does not apply where a patentee only asserts method claims even if the patent includes both method and apparatus claims.¹⁵² This rule goes against the very policy that the statute was enacted to protect against. Now, patent attorneys are advising their clients to include both method and apparatus claims in their patents to cover all their bases.¹⁵³ This allows patent owners room to get around the marking requirement and disregard public notice, but still have an opportunity to get six years of damages.¹⁵⁴ This is wrong. The marking requirement was established to hold patent owners to a high standard and protect the public from innocently infringing a product that they did not know was patented.¹⁵⁵

It makes sense that the marking requirement does not apply to method claims because with a purely method patent, there is nothing to mark.¹⁵⁶ However, where a patent contains both method and apparatus claims and claims a tangible object, that patent should be governed by the marking requirement. To borrow language from the federal circuit, “[t]he patent-by-patent versus claim-by-claim marking dispute . . . raises a novel legal issue not squarely addressed by our past decisions.”¹⁵⁷ It is time to answer that question. Courts should not look at what claims a patent owner brought in litigation but should look at the patent as a whole and analyze if there is a product that can be marked. If so, 35 U.S.C. § 287(a) should apply. Without courts willing to take a stand against the loophole, individuals and companies will continue to pay outrageous amounts of damages for innocent infringement.

¹⁵¹ *Core Optical Techs., LLC v. Juniper Networks Inc.*, 562 F. Supp. 3d 376, 379 (N.D. Cal. 2021).

¹⁵² *See Mroz & Abu-Taleb*, *supra* note 86.

¹⁵³ *See id.*

¹⁵⁴ *See* 35 U.S.C. § 286. *See also* *Crown Packaging Tech., Inc. v. Rexam Beverage Can Co.*, 559 F.3d 1316 (Fed. Cir. 2009) (stating 35 U.S.C. § 287(a) “did not apply where the patentee only asserted the method claims of a patent which included both method and apparatus claims.”).

¹⁵⁵ *See Nike Inc. v. Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1443 (Fed. Cir. 1998).

¹⁵⁶ *See Am. Med. Sys. v. Med. Eng’g Corp.*, 794 F. Supp. 1370, 1389 (E.D. Wis. 1992) (“[W]here the patent claims are directed to only a method or process there is nothing to mark.”).

¹⁵⁷ *Rembrandt Wireless Techs. v. Samsung Elecs.*, 853 F.3d 1370, 1384 (Fed. Cir. 2017).