



# Stu Kaback Business Impact Award

PIUG 2020 Annual Conference



## Background of the Award

Established in 2013 to honor the memory of Dr. Stuart Kaback for his many accomplishments over his 42 year career at ExxonMobil.

Stu was an internationally recognized expert in patent information, who inspired a generation of patent information professionals.

Stu's unparalleled technical expertise in patent information & a diverse range of chemical and petroleum related technologies provided invaluable support to both R&D and IP within ExxonMobil.

Stu's accomplishments demonstrate how a patent information professional can be critical to the success of a business.



## Purpose of the Award

Recognize the achievements of an individual or team who, in performing as patent information professionals, have made a distinct impact on their organization.

The achievement, in the context of this award, is project-based, rather than a lifetime achievement-based award.

A patent information professional, in the context of this award, is someone who searches, analyzes, organizes and disseminates patent information; or who designs patent information retrieval systems.



2020 Stu Kaback Business Impact Award Recipient

**Martha Yates**



# *Patent Marking—2020 Stu Kaback Award*



**Martha Yates**

**Principal Information Scientist  
Bayer Crop Science**





# Patent marking and virtual patent marking

- // Why you mark
- // What countries you mark in
- // False marking
- // Solo Cup case
- // Patent marking trolls
- // Virtual patent marking
- // Overview of project



# Why you mark

## Provide constructive notice

Once products covered by a patent are properly marked, infringers are said to have constructive notice and therefore can be liable for patent infringement damages even if they did not have actual notice of the patent.

Deter potential competitors from entering market





# United States Patent Law

United States patent law requires that a product covered by a patent be marked with its respective patent number in order to collect infringement damages for the period before the accused infringer received actual notice of infringement.

The marking should be fixed on the product, unless because of the nature or character of the product this cannot be done, in which case it is permissible to fix the marking to the product's packaging. Courts generally allow alternative marking when there is some reasonable consideration presented for not marking the product, for example physical constraints or other limitations.





# United States Patent Law

The failure to mark a product can be cured. A delay between issuance of the patent and compliance with the marking provisions generally will not prevent recovery of damages after marking has begun. Once started, the marking must thereafter be consistent and continuous.

If there has been a failure to mark products covered by the patent, the patent owner can still recover damages from the time when the infringer received actual notice of infringement. The infringer's awareness of the patent is not enough; in the absence of patent marking the infringer must be specifically accused on infringement.



# *Pequignot v. Solo Cup*

*Pequignot v. Solo Cup* was one of many qui tam actions pending in the wake of the Federal Circuit's December decision in *The Forest Group v. Bon Tool*, 590 F.3d 1295 (Fed. Cir. 2009). In *Forest Group*, the CAFC interpreted 35 U.S.C. § 292 to impose a fine for each falsely marked product, as opposed to the singular decision to falsely mark all products.

In *Solo Cup*, plaintiff Matthew A. Pequignot had charged that the cup lids were “unpatented articles” and that Solo Cup had “falsely marked [them] ... for the purpose of deceiving the public[,]” as required under § 292(a) to trigger the fines prescribed by the statute. The CAFC agreed with Pequignot that the cup lids were indeed “unpatented articles,” but disagreed that Solo Cup had intended to deceive the public.



# *Pequignot v. Solo Cup*

The Court of Appeals for the Federal Circuit found no violation by defendant Solo Cup for falsely marking 21 billion cup lids as being covered by expired patents, affirming the Eastern District of Virginia's prior determination as to liability and stating that Solo Cup lacked "the requisite intent to falsely mark its products."

This case had two key effects: (1) it sprouted "patent marking trolls" or a class of individuals that specifically looked for articles marked with expired patents; and (2) it caused parties to closely consider its patent marking practices

# America Invents Act –September 16, 2011

## Virtual Marking

- Under the AIA, virtual marking is now permitted. The product may be marked with “pat.” or “patent” and a free-to-access web address. The webpage at the web address must identify a product covered by one or more patent numbers. When the patent list needs to be modified, the web page can be easily modified.

## False marking

- Previously, anyone could sue a patentee for false marking. Under the AIA, only the United States or someone with a competitive injury can sue a patentee for false marking. This has effectively closed numerous false patent marking pending lawsuits. Moreover, the AIA clarifies that marking a product with an expired patent is never a violation of the false marking statute.



## Overview of project

- // Produced internal database of patents and patent applications and related them to products
  - // Across all jurisdictions
  - // Used for patent marking
  - // Used for product lifecycle management
- // Includes third party patents that are applicable to products
- // Produced virtual patent marking website  
[www.monsantotechnology.com](http://www.monsantotechnology.com)

## Products

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### Home

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### Seed Traits

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### Weed Control

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### Lawn and Garden

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### Monsanto BioAg

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### Vegetables

# Monsanto Virtual Patent Marking Website

Monsanto Company, together with its commercial partners, provides agricultural products including seeds, traits, agricultural chemicals, plant varieties, and agricultural productivity solutions for farmers worldwide. Many of the agricultural products are patented articles under the protection of the patent laws of many countries, including without limitation the United States Patent Laws. In accordance with 35 U.S.C. § 287(a), Monsanto Company is providing this website to give notice to the public about the association of certain patented articles with the number(s) of certain United States patents. The listing of patent numbers on this page may not be all-inclusive, and it does not preclude Monsanto Company from pursuing other legal rights not reflected on this page.

Please choose the product area below to find the product you are interested in, and the associated patent numbers.

[Seed Traits](#)

[Weed Control](#)

[Lawn & Garden](#)

[Monsanto BioAg](#)

[Vegetables](#)

# Corn Patents

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## **Roundup Ready® Corn 2**

Roundup Ready® Corn 2 is protected by one or more of the following U.S. Patent No(s): – 6,825,400; 7,582,434; 8,273,959; 8,722,969; 9,701,980.

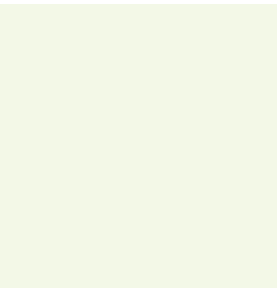
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## **VT Double PRO® and VT Double PRO® RIB Complete®**

VT Double PRO® and VT Double PRO® RIB Complete® is protected by one or more of the following U.S. Patent No(s): – 6,825,400; 7,582,434; 8,034,997; 8,273,959; 8,581,047; 8,722,969; 9,428,765; 9,816,104; 10,006,046.

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**SmartStax® and SmartStax®  
RIB Complete® Corn**

SmartStax® and SmartStax® RIB Complete® Corn is protected by one or more of the following U.S. Patent No(s): – 7,112,665; 8,034,997; 8,212,113; 8,581,047; 8,686,230; 9,428,765; 9,816,104; 10,006,046.

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**Dow AgroSciences Patent  
Rights for SmartStax®**

Dow AgroSciences Patent Rights for SmartStax® is protected by one or more of the following U.S. Patent No(s): – 6,943,282; 7,956,246; 8,592,653; 8,901,378; 8,952,223.



*Thank you!*

