HAHN LOESER

Marking a method: Is it required?

By: Rex W. Miller, Patent Agent

On March 17, 2009, the Federal Circuit revisited the marking requirement under 35 U.S.C. §287(a) in *Crown Packaging Technology, Inc. v. Rexam Beverage Can Co.* In short, the marking requirement encourages patent owners to inform the public, and especially potential infringers, of the existence of a patent by placing the patent number on the physical product covered by that patent. In exchange for marking their patented products in this fashion, patent owners are able to collect damages for infringement occurring prior to giving actual notice to or filing a lawsuit against an alleged infringer.

The public notice function served by the marking requirement, however, is more difficult to accomplish for patented processes. As the Federal Circuit has previously stated, "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 mark."[1]

In *Crown Packaging*, Rexam alleged infringement of its patented method of forming an end or "neck" on a beverage can. Rexam had licensed a third-party, Belvac Production Machinery, to produce machines that were capable of performing the patented method in addition to other non-infringing methods depending upon how the machine was configured. Crown purchased 26 of these machines and used them to perform the patented method.

Crown argued that Rexam should not be permitted to collect infringement damages because the purchased machines were not marked with Rexam's patent number. It was undisputed that the machines were not marked by Belvac; however, under the terms of the license between Rexam and Belvac, Belvac was required to notify its customers that they would require a separate license from Rexam to use the machine for Rexam's patented method.

In reviewing the marking requirements, the Federal Circuit observed that the "law is clear" that the marking requirement of §287 does not apply to patented methods or processes. Although Rexam's patent contained both product and method claims, because Rexam only asserted the method claims, the court concluded that marking was not required and that Rexam was entitled to collect damages for infringement.

The fact that Rexam only asserted the method claims of its patent is particularly important. In a situation where both product and method claims are asserted, marking the product may still be required to collect on infringement of the method claims. As the Federal Circuit has previously cautioned, "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)."

The marking requirement of §287 serves the important function of alerting others to the existence of a patent covering the marked product. While the Federal Circuit has reaffirmed that marking is not required when only method claims are asserted, the decision of which claims to assert is one that will often occur well after the decision has been made to mark a physical product. Therefore, when a tangible item or product may be closely related to a patented method, or when both product and method claims may be infringed, marking the product may still be advisable to alert potential infringers to the existence of the patent.

[1] American Medical Systems, Inc. v. Medical Engineering Corp., 6 F.3d 1523 (Fed. Cir. 1993).

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