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## FALSE MARKING IN PATENT MATTERS

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Using false markings, such as “breveté” or “patented” on a commercialized product is a marketing tactic that can lead to undesirable outcomes.

This article presents the risks incurred, in the United States as well as in Canada, when using false markings on a product that was not, or no longer is, patented.

With regard to marking a product as “patented” or “patent pending”, the following three (3) situations may exist:

- 1) the product is well covered by a valid patent in the country where the marked product is commercialized (or is under a pending application), in which case the marking is completely legitimate;
- 2) the product was never covered by a patent (or an application), and the marking “patented” is considered a false representation, in other words an offence; or
- 3) the product was protected by patent but no longer is, because the given patent has since expired; in this particular case, the situation is not as clear.

### In Canada

Section 75 c) of the *Patent Act* (C.R.S 1985, ch. P-4, s.75) stipulates that “every person who with intent to deceive the public offers for sale as patented in Canada any article not patented in Canada, is guilty of an indictable offence and liable to a fine not exceeding two hundred dollars or to imprisonment for a term not exceeding three months or to both.” This section does not specifically mention marking, but opens the door for a Canadian court to interpret it such that it could, in a litigation, impose a fine of up to two hundred dollars for each product sold as falsely patented. If the given product is sold in thousands of copies, the total amount of the fine could be significant.

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## In the United States

In the United States, the Act is more explicit than in Canada and stipulates that anyone who falsely marks a product with the word “patent”, or any equivalent, despite the fact that no patent has been granted for such product, runs the risk of a maximum fine of five hundred dollars for each offence committed (35 U.S.C 292 “False marking”). In a recent case (*Pequignot v. Solo Cup Co.*, 540 F.Supp. 2d 649 (E.D. Va. 2008)), the Federal District Court ruled that section 35 U.S.C. 292 applies even once the patent has expired. In this case, coffee cups were sold in thousands of copies and the plaintiff is claiming damages in the range of 100 billion dollars, based on the maximum fine of five hundred dollars per sold item. We are still waiting for a ruling on the merits of the claim but, in the cited ruling, the court rejected a preliminary motion for the dismissal of the claim filed by the defendants on the grounds that section 35 U.S.C. 292 did not apply to their case.

In conclusion, it is important to remember that, even though the marking “patented” can seem alluring, this designation is reserved in certain countries to genuine holders of this privilege. It is therefore advisable to always ensure that a product’s markings conform to the reality of the situation, which also means performing periodic reviews so that, once a patent has expired or an application has been abandoned, the marking is taken off the commercialized products in question



