

**United States Court of Appeals**

*for the*

**Federal Circuit**

IN RE BP LUBRICANTS USA INC.,

Petitioner.

Miscellaneous Docket No. \_\_\_\_\_

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ON PETITION FOR WRIT OF MANDAMUS FROM THE UNITED STATES  
DISTRICT COURT FOR THE NORTHERN DISTRICT OF ILLINOIS IN CASE  
1:10-CV-01258, JUDGE ROBERT W. GETTLEMAN

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**PETITION FOR WRIT OF MANDAMUS  
BP LUBRICANTS USA INC.**

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September 14, 2010

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U.S. COURT OF APPEALS  
FEDERAL CIRCUIT

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**CERTIFICATE OF INTEREST**

Counsel for Petitioner BP Lubricants USA Inc. certifies the following:

1. The full name of every party represented by me is:

BP Lubricants USA Inc.

2. There are no other real parties in interest represented by me.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party represented by me are:

BP Lubricants USA Inc. is a wholly-owned subsidiary of BP America, Inc., which is a wholly-owned subsidiary of BP plc.

4. The names of all the law firms and the attorneys that appeared for BP Lubricants USA Inc. in the district court or are expected to appear in this Court are:

Russell E. Levine, P.C., Paul D. Collier, and Matthew V. Topic of Kirkland & Ellis LLP.

Date: September 14, 2010

Respectfully submitted,



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## TABLE OF CONTENTS

INTRODUCTION.....	1
RELIEF SOUGHT .....	2
ISSUE PRESENTED.....	3
SUMMARY OF ARGUMENT .....	3
STATEMENT OF RELEVANT FACTS .....	8
JURISDICTIONAL STATEMENT AND STANDARD OF REVIEW .....	13
REASONS MANDAMUS SHOULD ISSUE IN THIS CASE.....	14
I. BP Lubricants’ Right to Relief is Clear and Indisputable .....	15
A. The District Court Erred by Allowing Knowledge of the Patent Expiration to be Pled Generally and Without Support.....	17
B. Relator Did Not Plead Knowledge of the Expiration by Specific Individuals Responsible for the Marking .....	19
C. Relator’s Allegations Could as Easily Be Explained by Lack of Knowledge of the Patent’s Expiration.....	20
II. BP Lubricants Has No Other Adequate Means to Attain Relief.....	22
A. Appeal from Final Judgment is Not an Adequate Alternative.....	22
B. Interlocutory Appeal is Not an Adequate Alternative.....	25
C. Mandamus is Required to Prevent the Threat of Extortionate Settlements.....	26
D. Interests in Judicial Economy Support Mandamus Here .....	28
CONCLUSION .....	29

## TABLE OF AUTHORITIES

### Cases

<i>American Dental Ass'n v. Cigna Corp.</i> , 605 F.3d 1283 (11th Cir. 2010) .....	20
<i>Ashcroft v. Iqbal</i> , 129 S. Ct. 1937 (2009).....	20, 21
<i>Banca Cremi, S.A. v. Alex Brown &amp; Sons, Inc.</i> , 132 F.3d 1017 (4th Cir. 1997) .....	27
<i>Bell Atl. Corp. v. Twombly</i> , 550 U.S. 544 (2007).....	20
<i>Brinkmeier v. BIC Corp.</i> , -- F. Supp. 2d --, 2010 WL 3360568 (D. Del. 2010).....	5, 12
<i>Brinkmeier v. Graco Children's Prods., Inc.</i> , 684 F. Supp. 2d 548 (D. Del. 2010).....	5
<i>Cheney v. U.S. Dist. Court for Dist. of Columbia</i> , 542 U.S. 367 (2004).....	13
<i>Decker v. Massey-Ferguson, Ltd.</i> , 681 F.2d 111 (2d Cir. 1982).....	27
<i>Exergen Corp. v. Wal-Mart Stores, Inc.</i> , 575 F.3d 1312 (Fed. Cir. 2009).....	passim
<i>Forest Group, Inc. v. Bon Tool Co.</i> , 590 F.3d 1295 (Fed. Cir. 2009).....	1, 3, 17, 26
<i>Forest Group, Inc. v. Bon Tool Co.</i> , Civil Action No. H-05-4127, 2010 WL 1708433 (S.D. Tex. April 27, 2010)....	26
<i>Hollander v. Etymotic Research, Inc.</i> , Civ. No. 10-256, 2010 WL 2813015 (E.D. Pa. July 14, 2010) .....	4
<i>In re Bridgestone/Firestone, Inc.</i> , 288 F.3d 1012 (7th Cir. 2002) .....	2
<i>In re Burlington Coat Factory Securities Litigation</i> , 114 F.3d 1410 (3d Cir. 1997).....	2, 26
<i>In re Deutsche Bank Trust Co. Americas</i> , 605 F.3d 1373 (Fed. Cir. 2010).....	25
<i>In re KGK Synergize, Inc.</i> , No. 2009-M-907, 2009 WL 3294864 (Fed. Cir. 2009) .....	25
<i>In re Mark Indus.</i> , 751 F.2d 1219 (Fed. Cir. 1984).....	13, 24
<i>In re Princo Corp.</i> , 478 F.3d 1345 (Fed. Cir. 2007).....	13, 23, 28

*In re Roche Molecular Sys., Inc.*,  
516 F.3d 1003 (Fed. Cir. 2008)..... 24

*In re Seagate Tech., LLC*,  
497 F.3d 1360 (Fed. Cir. 2007)..... 7

*In re TS Tech USA Corp.*,  
551 F.3d 1315 (Fed. Cir. 2008)..... 7, 13

*In re Volkswagen of America, Inc.*,  
545 F.3d 304 (5th Cir. 2008) ..... 24

*Inventorprise, Inc. v. Target Corp.*,  
No. 09-CV-00380, 2009 WL 3644076 (N.D.N.Y. Nov. 2, 2009)..... 5

*Matter of Rhone-Poulenc Rorer, Inc.*,  
51 F.3d 1293 (7th Cir. 1995) ..... 28

*Merck & Co., Inc. v. Reynolds*,  
130 S. Ct. 1784 (April 27, 2010) ..... 18

*Mississippi Chem. Corp. v. Swift Ag. Chem. Corp.*,  
717 F.2d 1374 (Fed. Cir. 1983)..... 28

*Panduit Corp. v. All States Plastic Mfg. Co., Inc.*,  
744 F.2d 1564 (Fed. Cir. 1984)..... 22

*Patent Compliance Group, Inc. v. Interdesign, Inc.*,  
3:10-CV-0404-P, Order, Docket No. 22 (N.D. Tex. June 28, 2010)..... 6

*Pequignot v. Solo Cup Co.*,  
608 F.3d 1356 (Fed. Cir. 2010)..... passim

*Pugh v. Tribune Co.*,  
521 F.3d 686 (7th Cir. 2008) ..... 19

*Richardson-Merrell, Inc. v. Koller*,  
472 U.S. 424 (1985)..... 22

*Shizzle Pop, LLC v. Wham-O Inc.*,  
CV No. 10-3491-PA, 2010 WL 3063066 (C.D. Cal. Aug. 2, 2010)..... 4

*Simonian v. Adv. Vision Res., Inc.*,  
Case No. 10-cv-1310, Minute Order, Docket No. 30 (N.D. Ill. Aug. 13, 2010)... 6

*Simonian v. Cisco Sys. Inc.*,  
10-C-1306, 2010 WL 2523211 (N.D. Ill. June 17, 2010) ..... 6

*Simonian v. Cisco Sys. Inc.*,  
10-C-1306, 2010 WL 3019964 (N.D. Ill. July 29, 2010)..... 6

*Simonian v. Mead Westvaco Corp.*,  
Case No. 10-C-1217, Minute Order, Docket No. 23 (N.D. Ill. June 3, 2010) ..... 4

*Third Party Verification, Inc. v. Signaturelink, Inc.*,  
492 F. Supp. 2d 1314 (M.D. Fla. 2007)..... 5

*U.S. ex rel. Rost v. Pfizer, Inc.*,  
507 F.3d 720 (1st Cir. 2007)..... 27

<i>Uni*Quality, Inc. v. Infotronx, Inc.</i> , 974 F.2d 918 (7th Cir. 1992) .....	27
<i>United States v. Bertoli</i> , 994 F.2d 1002 (3d Cir. 1993).....	24

**Statutes**

28 U.S.C. § 1651(a).....	23
35 U.S.C. § 287 .....	21
35 U.S.C. § 292 .....	13, 17, 26

**Rules**

Fed. R. Civ. P. 12(b)(6).....	3
Fed. R. Civ. P. 8(a).....	3, 6, 20, 21
Fed. R. Civ. P. 9(b) .....	passim

**Other Authorities**

S. Rep. 97-275, 97th Cong., 1st Sess. ....	22
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## INTRODUCTION

This petition, sought in one of the hundreds of false patent marking cases filed after this Court's decision in *Forest Group, Inc. v. Bon Tool Co.*, 590 F.3d 1295 (Fed. Cir. 2009), presents the question whether general allegations of intent to deceive based upon information and belief and supported by little more than the allegation of a patent's expiration are sufficient to survive a motion to dismiss. Under this Court's clear precedent—which the district court failed to follow—a claim based on intent to deceive “requires that the pleadings allege sufficient underlying facts from which a court may reasonably infer that a party acted with the requisite state of mind.” *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1326-27 (Fed. Cir. 2009). Further, as this Court held in *Pequignot v. Solo Cup Co.*, 608 F.3d 1356 (Fed. Cir. 2010), where the alleged false marking is based solely on expired patents, a relator must satisfy a “particularly high bar” in establishing deceptive intent. *Id.* at 1363. As such, the district court's decision permitting generalized allegations of intent to deceive based merely on a patent's expiration is manifestly erroneous, and BP Lubricants USA Inc.'s (“BP Lubricants”) right to issuance of the writ is clear and indisputable.

Allowing this case to continue would subject BP Lubricants to undue prejudice for which it has no adequate remedy at law. Indeed, no adequate relief is available because the cost of litigation and the uncertainty regarding the amount of

penalty applicable in a false marking case following this Court's decision in *Forest Group* will force settlements in cases such as these long before appellate review can be had. Cf. *In re Burlington Coat Factory Securities Litigation*, 114 F.3d 1410, 1418 (3d Cir. 1997); *In re Bridgestone/Firestone, Inc.*, 288 F.3d 1012, 1015-16 (7th Cir. 2002). Moreover, immediate review by this Court is particularly warranted given the significant division that has arisen among the district courts. While some courts have carefully followed this Court's teaching in *Pequignot* and *Exergen*, others have not. Precisely because this Court sits to bring uniformity to application of the patent laws, expeditious review of this issue is warranted.

### **RELIEF SOUGHT**

Petitioner BP Lubricants respectfully petitions this Court for a writ of mandamus directing the United States District Court for the Northern District of Illinois to: (i) vacate its August 25, 2010 order denying BP Lubricants' motion to dismiss; and (ii) order that the complaint in this case be dismissed in accordance with this Court's decisions in *Pequignot v. Solo Cup Co.*, 608 F.3d 1356 and *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312. In so doing, the relief sought will remedy the clear error below while resolving the growing split among the district courts applying the pleading standard for false marking cases.

## ISSUE PRESENTED

Did the district court clearly err when it denied BP Lubricants' motion to dismiss Relator's false patent marking case for failure to plead supporting factual allegations sufficient to infer an intent to deceive under this Court's precedent in *Pequignot v. Solo Cup Co.*, 608 F.3d 1356 and *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312?

## SUMMARY OF ARGUMENT

Following this Court's decision in *Forest Group*, federal district courts have been flooded with false patent marking suits. There are approximately 331 false marking suits currently pending against 591 different defendants in 40 courts before 137 different judges. (PA 93-96.)<sup>1</sup> The complaints in these suits typically follow the same boilerplate template in which the statutorily-required intent to deceive is supported by little more than a patent's expiration and descriptions of the defendant as a "sophisticated company" who "knew or should have known" of the expiration.

Many false patent marking defendants, in response to these cursory and legally insufficient allegations, have filed motions to dismiss under Federal Rules of Civil Procedure 8(a), 9(b), and 12(b)(6). In ruling on these motions, district

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<sup>1</sup> The supporting materials required by Fed. R. App. 21(a)(2)(c) are contained in a separate Appendix that has been contemporaneously filed with this petition. Citations to the Appendix appear herein as "(PA \_\_\_\_.)".

courts and even different judges in the same districts have reached irreconcilably different conclusions.

Many district courts have granted motions to dismiss in whole or in part.

For example:

- *Simonian v. Mead Westvaco Corp.*, Case No. 10-C-1217, Minute Order, Docket No. 23 (N.D. Ill. June 3, 2010), (dismissing complaint with identical allegations regarding intent to deceive as complaint filed by Simonian against BP Lubricants, *compare id.*, Docket No. 1, at ¶¶ 14-24 with *Simonian v. BP Lubricants USA Inc.*, Case No. 10-CV-1258, Docket No. 1, at ¶¶ 17-31) (PA 77-84, 198-206.);<sup>2</sup>
- *Shizzle Pop, LLC v. Wham-O Inc.*, CV No. 10-3491-PA, 2010 WL 3063066, at \*4 (C.D. Cal. Aug. 2, 2010) (“Here the complaint alleges ‘upon information and belief’ that Defendant has knowledge that its products are not patented under the ‘678 Patent and that it intended to deceive the public. The only fact which Plaintiff has pointed to as a basis for these beliefs is the fact that the packaging on the Pro Classic is marked with a copyright dated 2009. Plaintiff argues that because Defendant took the time to update its packaging in 2009 it must have realized at that time that the ‘678 Patent was expired. However, creating new packaging does not create a reasonable inference that Defendant knew the ‘678 Patent had expired. Courts applying the Rule 9(b) standard, and in some cases even the regular *Twombly* standard, have found that further factual detail is needed in order to survive a motion to dismiss.”) (internal citation omitted);
- *Hollander v. Etymotic Research, Inc.*, Civ. No. 10-256, 2010 WL 2813015, at \*6 (E.D. Pa. July 14, 2010) (“Although Plaintiff has alleged that Defendant knew or reasonably should have known that the products were marked with expired patents, Plaintiff attempts to support those allegations by averring merely that: (1) Defendant knows that patents have limited duration; (2) the patents at issue

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<sup>2</sup> Copies of all unpublished orders and pleadings are provided in the Appendix.

expired; and (3) Defendant continued to mark its products with those patents after expiration. Those allegations do not sufficiently articulate knowledge of falsity or intent to deceive because Defendant's knowledge of the limited duration of patents and the actual expiration of the patents do not create an inference that Defendant knew that the patents at issue actually expired. Moreover, Plaintiff's allegations based on information and belief are insufficient under Rule 9(b) where Plaintiff has failed to set forth specific facts upon which such belief is reasonably based. Therefore, Plaintiff's allegations do not meet Rule 9(b)'s heightened pleading standards.");

- *Brinkmeier v. Graco Children's Prods., Inc.*, 684 F. Supp. 2d 548, 553 (D. Del. 2010) (*Brinkmeier I*) (dismissing claims alleging that "Defendant employs an Intellectual Property Manager responsible for patent markings," but upholding claim for which Plaintiff alleged that "Defendant has [sued]<sup>3</sup> two competitors for infringing the [patent in question], and that Defendant has revised its patent markings at least 3 times since the [patent] expired");
- *Brinkmeier v. BIC Corp.*, -- F. Supp. 2d --, 2010 WL 3360568 (D. Del. 2010) (*Brinkmeier II*) (discussed in greater detail below);
- *Inventorprise, Inc. v. Target Corp.*, No. 09-CV-00380, 2009 WL 3644076, at \*6 (N.D.N.Y. Nov. 2, 2009) (dismissing complaint pre-*Forest Group* that purported to infer knowledge and intent from fact that defendant was a sophisticated company with extensive patent experience).

Other courts have ruled that Rule 9(b) does not apply. *See Third Party Verification, Inc. v. Signaturelink, Inc.*, 492 F. Supp. 2d 1314, 1327 (M.D. Fla. 2007). Still others, including the court below, facially applied Rule 9(b), found that Rule 9(b) would be satisfied assuming it applied, or did not decide what

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<sup>3</sup> While the court's opinion states that the Defendant "had been sued" by two competitors, the Complaint in fact alleged that Defendant sued two competitors. *Brinkmeier v. Graco Children's Products Inc.*, C.A. No. 09-262-JJF, Amended Complaint, Exhibit 1 to Docket No. 16, at ¶ 10 (D. Del. Feb. 2, 2010) (PA 122.).

standard applies, but upheld generalized allegations of intent that do not comply with Rule 8(a), Rule 9(b), or this Court's precedent in *Pequignot* or *Exergen*. For example:

- *Patent Compliance Group, Inc. v. Interdesign, Inc.*, 3:10-CV-0404-P, Order, Docket No. 22, at 18 (N.D. Tex. June 28, 2010) (“Armed with actual documentation that a product was falsely marked, a court may draw an inference of the defendant’s knowledge simply by the finite nature of patents and the ordeal an entity must go through to actively create and maintain a patent.”) (settled shortly after ruling) (PA 148, 165.);
- *Simonian v. Adv. Vision Res., Inc.*, Case No. 10-cv-1310, Minute Order, Docket No. 30 (N.D. Ill. Aug. 13, 2010) (“[T]he complaint is sufficient. It alleges that defendant is a sophisticated company and that it (or its lawyers) know how long a patent lasts, and therefore knew these patents had expired. No more is necessary at this stage.”) (PA 197.);
- *Compare Simonian v. Cisco Sys. Inc.*, 10-C-1306, 2010 WL 2523211, at \*2-5 (N.D. Ill. June 17, 2010) (dismissing first complaint, stating “Simonian has alleged that ‘upon information and belief’ Cisco is ‘a sophisticated company and has many decades of experience applying for, obtaining, and/or litigating patents.’ . . . Simonian has not alleged any specific facts upon which he bases this allegation. . . . Thus, Simonian has failed to plead specific facts showing Cisco’s knowledge of the mismarking or its intent to deceive the public.”); *with Simonian v. Cisco Sys. Inc.*, 10-C-1306, 2010 WL 3019964, at \*1-2 (N.D. Ill. July 29, 2010) (allowing amended complaint to proceed based on additional allegations that defendant has an “extensive patent portfolio,” an “automated, web-based patent tracking system,” and a “legal team . . . devoted to intellectual property matters,” because “Simonian alleges that Cisco has knowledge of the legal status of its intellectual property.”).

With over 300 false marking suits pending in the district courts for violations of what this Court has described as a criminal statute mandating a bar for proving deceptive intent that is “particularly high,” *Pequignot*, 608 F.3d at 1363, the need to adhere strictly to the pleading standards set by this Court is of paramount importance, as is the need for district court judges to apply those standards uniformly when ruling on motions to dismiss. As it now stands, in suits based on practically identical allegations, some defendants are granted the relief to which they are entitled under Rule 9(b) while others are improperly forced either to incur significant costs to defend the litigation and risk a damages award for which there is currently little guiding caselaw or settle their cases. This disparity in results among identical cases, all of which are brought on behalf of the same U.S. government, should not be allowed to continue. The treatment of these cases should not be determined by a relator’s choice of venue or the random assignment of judges within that venue.

Mandamus is an extraordinary remedy not to be granted lightly, but this Court has not hesitated to use mandamus where, as here, there is no other practical alternative for correcting serious errors of law with wide-reaching effects. *See, e.g., In re TS Tech USA Corp.*, 551 F.3d 1315 (Fed. Cir. 2008) (transfer); *In re Seagate Technology, LLC*, 497 F.3d 1360 (Fed. Cir. 2007) (willfulness standard).

BP Lubricants respectfully asks this Court to grant BP Lubricants' mandamus petition and order this case dismissed.

### **STATEMENT OF RELEVANT FACTS**

Relator Thomas A. Simonian ("Relator" or "Simonian") has brought nearly 40 false marking suits in the Northern District of Illinois. (PA 24-27.)<sup>4</sup> As this Court has clearly held, false marking is not a strict liability offense, but rather requires intent to deceive, which can be weakly and rebuttably presumed where a relator has established that the marking was made with knowledge of its falsity. *See Pequignot*, 608 F.3d at 1363. Simonian's complaint against BP Lubricants, like his complaint against dozens of other defendants and like complaints filed by many other relators, purports to satisfy the obligation to plead intent to deceive with particularity through only generalized allegations:

- ¶ 19: Upon information and belief, Defendant is a sophisticated company and has experience applying for, obtaining, and litigating patents. (PA 81.)
- ¶ 20: Defendant by itself or by its representatives cannot genuinely believe that a patent does not expire and that prospective patent rights apply even after its expiration. (*Id.*)
- ¶ 21: Upon information and belief, Defendant knows, or should know (by itself or by its representatives), that the '509 Patent marked on the CASTROL® Products have expired and/or do not cover the products to which the marking is affixed. (*Id.*)
- ¶ 22: Upon information and belief, Defendant knows, or should know (by itself or by its representatives), that the CASTROL®

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<sup>4</sup> Case No. 98-cv-7950, listed on PA 24, was not a false patent marking case.

Products are not covered by the '509 Patent marked on such products because an expired patent has no prospective patent rights. (*Id.*)

- ¶ 23: As a sophisticated company with, upon information and belief, experience applying for, obtaining, and litigating patents, Defendant knows, or reasonably should know, of the requirements of 35 U.S.C. § 292. (*Id.*)
- ¶ 25: Upon information and belief, Defendant intentionally included the '509 Patent in the patent markings of the CASTROL® Products in an attempt to prevent competitors from using the same or similar bottle design. (*Id.*)
- ¶ 26: Upon information and belief, Defendant marks the CASTROL® Products with the '509 Patent for the purpose of deceiving the public into believing that something contained in or embodied in the products is covered by or protected by the expired '509 Patent. (PA 82.)
- ¶ 29: Upon information and belief, Defendant knows, or reasonably should know, that marking the CASTROL® products with false patent statements was and is illegal under Title 35 United States Code. At a minimum, Defendant had and has no reasonable basis to believe that its use of the false markings was or is proper or otherwise permitted under federal law. (*Id.*)

In addition to these repetitive and speculative allegations, most of which merely allege unactionable negligence at most, Relator asserted in his opposition brief, citing no factual support whatsoever, that “BP [Lubricants] assessed the risk of its false marking, determined that the risk warrants the ‘rewards,’ and decided to leave the expired patent on its product packaging and take its chances that it either would not get caught or the fine would not be substantial enough to affect its

bottom-line.” (PA 46-47.) Ultimately, however, Relator summarized the entire basis of his position as follows:

Accordingly, having alleged that BP [Lubricants] is a sophisticated company, that BP [Lubricants] was aware that its ‘509 Patent had expired, and that subsequent to that expiration BP [Lubricants] marked (or continued to mark) the ‘509 Patent on the accused product, the Relator has alleged a plausible claim for false marking based on the rebuttable presumption that BP [Lubricants] falsely marked for the purpose of deceiving the public.

(PA 57.) These allegations are insufficient as a matter of law because they do not claim that any specific individual within BP Lubricants responsible for the marking had knowledge of this specific patent’s expiration, but merely purport to show generalized corporate knowledge about patents. Furthermore, accepting Relator’s generalized factual allegations as true, the alleged false marking could just as easily be explained by a *lack* of knowledge that the patent at issue had expired and a resulting inadvertent failure to remove the mark.

The district court denied BP Lubricants’ motion to dismiss, relying solely on Seventh Circuit law, and without addressing this Court’s decision in *Exergen* regarding the standard for pleading intent to deceive in the context of inequitable conduct, or the “particularly high bar” for proving deceptive intent set in this Court’s decision in *Pequignot*. (PA 1, 2, 8-10.) Rather, the district court concluded that Simonian adequately pled the “who, what, when, where and how” of the alleged fraud, and that Simonian “alleged the deceptive intent generally,

which conforms to the requirements of Rule 9(b).” (PA 7-9.) The court found that deceptive intent was “sufficiently, albeit generally,” alleged, because: (1) “the combination of a false statement and knowledge that the statement was false creates a rebuttable presumption of intent to deceive the public”; (2) “Simonian’s complaint specifically states that the [patent at issue is] expired and [was] falsely marked on products”; and (3) Simonian pled “that [BP Lubricants] had knowledge that [the patent was] expired and therefore [that] the marks were false.” (PA 9-10.) What the district court failed to address, however, was whether Simonian had adequately pled the factual support for his allegation that any individual or individuals within BP Lubricants involved in the product’s labeling had actual knowledge of the expiration of the patent at issue—the underlying and unsupported assumption upon which Simonian’s inference of intent to deceive was premised.

Faced with materially identical allegations, other courts have properly reached the opposite conclusion. For example, the District of Delaware recently addressed a complaint alleging the following:

According to plaintiff, BIC “is a sophisticated company that has many decades of experience applying for, obtaining, and litigating patents.” BIC has an in-house legal department, which is responsible for its intellectual property, marketing, labeling, and advertising law and who “regularly litigate[s], or oversee[s] litigation of, patent infringement and false advertising claims.” BIC has previously accused companies of (and itself has been accused of) patent infringement. Plaintiff alleges that BIC “knows, or reasonably should know, of the

requirements of” the marking statute and laws pertaining to product marking. . . . Plaintiff further alleges that BIC “reviews and revises the patent markings on the products identified [] above” and therefore “knows, or should know, that one or more of the patents marked on the products identified [above] are expired.”

\* \* \*

To support her claim that BIC intentionally marked its products with expired patents, plaintiff asserts that: (1) “as BIC well knows, after a patent issues, a maintenance fee must be paid or else the patent will expire;” (2) “[a] sophisticated company such as BIC likely would not inadvertently include expired patents in its patent markings;” (3) “BIC’s continued marking of its lighters with expired patents after the filing of the complaint is simply inexcusable and conclusively demonstrates BIC’s deceptive intent;” and (4) “the massive volume of lighters BIC sells also establishes its intent to deceive.”

*Brinkmeier II*, 2010 WL 3360568, at \*2, 7.

The Delaware court found that Rule 9(b) applies to false marking cases, and noted that the purposes of Rule 9(b) include “reduc[ing] the number of frivolous suits brought solely to extract settlements.” *Id.* at \*5, 8. Citing *Exergen*, the court then found that while “a relaxed Rule 9(b) standard may apply when essential information lies uniquely within another party’s control,” a plaintiff may plead intent based upon information and belief “only if the pleading sets forth the specific facts upon which the belief is reasonably based.” *Id.* at \*5 (internal quotation marks omitted). The court dismissed the relator’s complaint because “it appears just as likely on the facts pled that BIC made a marking error.” *Id.* at \*10.

Thus, based on similar allegations to those upheld below, other district courts have dismissed false marking claims under Rule 9(b) based on this Court's precedent. This Court should grant mandamus to correct the error below, to confirm that the approach taken by courts granting motions to dismiss these basically identical complaints is the correct one, and to create uniformity in the lower courts on this important issue of patent law.

### **JURISDICTIONAL STATEMENT AND STANDARD OF REVIEW**

Relator's claim arises under 35 U.S.C. § 292. (PA 77.) Therefore, this Court has exclusive jurisdiction over all appeals in this case, and as a result, may issue any writs in furtherance of that jurisdiction, including the writ of mandamus sought here. *See, e.g., In re Mark Indus.*, 751 F.2d 1219, 1222 (Fed. Cir. 1984). In addition, because the claim at issue is unique to the Patent Act, this Court applies its own law of mandamus. *See In re TS Tech*, 551 F.3d at 1319. Under Supreme Court precedent applicable to this Court, BP Lubricants must show: (1) that it has no other adequate means to attain the relief it seeks; (2) that BP Lubricants has a clear and indisputable right to mandamus; and (3) that mandamus would be appropriate in this case. *Cheney v. U.S. Dist. Court for Dist. of Columbia*, 542 U.S. 367, 380-81 (2004). These requirements, "however demanding, are not insuperable." *Id.*

The decision whether to grant or deny mandamus is within “the sound discretion of the court.” *In re Princo Corp.*, 478 F.3d 1345, 1357, 1352-53 (Fed. Cir. 2007) (collecting examples of cases in which this Court has exercised its mandamus authority). This Court’s precedent and jurisdictional mandate, in light of the unique circumstances following from this Court’s decision in *Forest Group*, support the mandamus relief sought in this case.

### **REASONS MANDAMUS SHOULD ISSUE IN THIS CASE**

BP Lubricants’ petition does not seek mandamus of a typical denial of a motion to dismiss. BP Lubricants fully recognizes that this Court could not possibly entertain a mandamus petition every time a motion to dismiss is denied. In this case and the hundreds of identical false marking cases currently pending, however, there are unique circumstances and a unique need, which can be addressed only through mandamus, for district courts to remain faithful to the pleading standards set by this Court.

Nearly every week, more false patent marking suits are filed. (PA 93-120.) In some instances, defendants, including BP Lubricants, have even been sued by multiple relators and forced to seek dismissals of the later filed suits. *See San Francisco Technology, Inc. v. Aero Products Int’l, Inc.*, Case No. 10-CV-2994-HRL, Complaint, Docket No. 1 (N.D. Cal. July 8, 2010) (PA 168.). In addition to the constant stream of new cases, courts are issuing opinions at a blistering pace on

motions to dismiss—some of which have followed this Court’s clear precedent and others that have not.

In light of the large and still-growing number of false patent marking cases, as well as the growing potential for false marking suits to be used to extract settlements from defendants facing uncertain penalty standards, mandamus should be granted so that this Court can correct the error below and by doing so promptly and effectively confirm the rigorous pleading standard applicable to false marking cases and ensure uniformity throughout the district courts. Decisions applying a lenient Rule 9(b) standard, including the decision below, are clearly and indisputably erroneous, and should be addressed through mandamus.

**I. BP LUBRICANTS’ RIGHT TO RELIEF IS CLEAR AND INDISPUTABLE**

While this Court has recognized that Congress intended the false marking statute to be used to protect the public from intentional false marking, Congress has also made clear, and this Court has recognized, that false marking is not a strict liability offense, but rather requires an intent to deceive. *Pequignot*, 608 F.3d at 1363. As a result, relators must provide a sufficient factual basis for any allegations of intent to deceive, just as securities fraud and False Claims Act plaintiffs, for example, must satisfy Rule 9(b) despite the equally laudable goals of those statutes. If anything, Rule 9(b) serves an even greater purpose here because false-marking relators bring suit on behalf of the U.S. government, who has no

apparent statutory authority to ensure that only suits with an adequate factual basis are brought in its name.

The court below made three clear and fundamental errors in denying BP Lubricants' motion to dismiss. First, the district court permitted Relator to plead intent to deceive generally and without adequate supporting factual allegations from which such intent could be inferred. Second, the district court failed to apply this Court's precedent in *Exergen* and similar persuasive Seventh Circuit precedent that make clear that intent to deceive cannot be analyzed at the corporate level; rather, Relator will ultimately be required to establish, and at the pleading phase is required to plead, that specific individuals at BP Lubricants responsible for the label at issue were aware of the expiration of the specific patent at issue.<sup>5</sup> And third, the district court failed to recognize that the underlying factual allegations relied upon by Relator could just as easily be explained by inadvertent lack of knowledge of the patent's expiration.

BP Lubricants' mandamus petition is an opportunity for this Court to confirm for the district courts that *Exergen* and *Pequignot* require false marking complaints to be supported with sufficient and detailed factual allegations well beyond what was pled by Relator. This Court should hold that a false marking

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<sup>5</sup> Under this Court's decision in *Pequignot*, such a showing would give rise to a weak presumption of intent to deceive, which BP Lubricants would then be required to rebut. 608 F.3d at 1364.

relator must allege specific facts sufficient to support an inference that specific individuals responsible for a product's labeling had knowledge of the expiration of the specific patent at issue, and should clarify that simply alleging that a false marking has occurred and that the defendant is a "sophisticated company" with patent experience and a legal department is insufficient under Rule 9(b).

**A. The District Court Erred by Allowing Knowledge of the Patent Expiration to be Pled Generally and Without Support**

A false marking claim requires intent to deceive the public. 35 U.S.C. § 292; *Forest Group*, 590 F.3d at 1300. These claims clearly sound in fraud, and therefore, under this Court's precedent in *Exergen*, Rule 9(b) applies. 575 F.3d at 1331 (allegations of "deceptive intent" giving rise to inequitable conduct claims must be pled with specificity under Rule 9(b), "lest inequitable conduct devolve into 'a magic incantation to be asserted against every patentee' and its 'allegation established upon a mere showing that art or information having some degree of materiality was not disclosed.'") (citation omitted).

Because Rule 9(b) applies, a relator must plead "the specific who, what, when, where and how" of the alleged fraud. *Id.* at 1326-27. While intent to deceive may be pled generally, this Court's precedent, "like that of several regional circuits, requires that the pleadings allege sufficient underlying facts from which a court may reasonably infer that a party acted with the requisite state of mind." *Id.* at 1327. These underlying facts must "provide a factual basis" to conclude that the

alleged fraud “was not unintentional,” because this Court “decline[s] to infer facts to support a claim that must be pled with particularity.” *Id.* at 1328 (internal quotation marks and citations omitted); *see also Merck & Co., Inc. v. Reynolds*, 130 S. Ct. 1784, 1796-97 (April 27, 2010) (rejecting argument that “facts that tend to show a materially false or misleading statement . . . are ordinarily sufficient to show scienter as well” and noting that “[a]n incorrect prediction about a firm’s future earnings, by itself, does not automatically tell us whether the speaker deliberately lied or just made an innocent (and therefore nonactionable) error”).

The district court’s decision did not cite *Exergen* or comply with its requirements. Instead, the district court found that “[b]y alleging that [BP Lubricants] had knowledge of [the] false marking and that the marks were false [the complaint] creates a rebuttable presumption of deceptive intent.” (PA 1, 9.) The court acknowledged that Relator only pled “deceptive intent generally,” but concluded that such practice “conforms to the requirements of Rule 9(b).” *Id.*

The district court’s conclusion was clear error. This Court’s decision in *Exergen* makes clear that while state of mind can be alleged generally, those general allegations must be supported with allegations of specific facts upon which the inference is based. Yet the court below did not cite to any such specific factual allegations as supporting Relator’s general allegation of intent, and in fact, no such

factual allegations were pled. Therefore, the district court's decision was clearly and indisputably erroneous.

**B. Relator Did Not Plead Knowledge of the Expiration by Specific Individuals Responsible for the Marking**

Based on this Court's decision in *Exergen*, as well as similar precedent from the Seventh Circuit, a false-marking relator must plead, and ultimately establish, "a specific individual" who both knew of the false information and misrepresented it with an intent to deceive; allegations directed generally to a corporation and its agents and employees are insufficient. 575 F.3d at 1329; *see also*, *Pugh v. Tribune Co.*, 521 F.3d 686, 697 (7th Cir. 2008) ("[T]he corporate scienter inquiry must focus on the state of mind of the individual corporate official or officials who make or issue the statement (or order or approve it or its making or issuance, or who furnish information or language for inclusion therein, or the like) rather than generally to the collective knowledge of all the corporation's officers and employees acquired in the course of their employment.") (internal quotation marks and citation omitted). In its decision below, the district court did not analyze whether Relator's complaint sufficiently alleged that any specific individuals within BP Lubricants involved in the decision to mark the products at issue had knowledge of the patent's expiration. The complaint contains no such allegations, and is therefore clearly inadequate under Rule 9(b).

### **C. Relator’s Allegations Could as Easily Be Explained by Lack of Knowledge of the Patent’s Expiration**

Whether Rule 9(b) applies or not, Rule 8(a) requires all complaints to contain a “short and plain statement of the claim showing that the pleader is entitled to relief,” but does not permit mere “labels and conclusions,” “a formulaic recitation of the elements of a cause of action,” or “naked assertion[s] devoid of further factual enhancement.” *Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949 (2009) (internal quotation marks and citations omitted). Rather, the plaintiff must allege “enough facts to state a claim to relief that is plausible on its face.” *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In other words, the “[f]actual allegations must be enough to raise a right to relief above the speculative level.” *Id.* at 555. Where equally compelling inferences could be drawn from the same set of facts, only one of which gives rise to a cause of action, a claim has not been stated. *Iqbal*, 129 S. Ct. at 1950 (“Acknowledging that parallel conduct was consistent with an unlawful agreement, the [*Twombly*] Court nevertheless concluded that it did not plausibly suggest an illicit accord because it was not only compatible with, but indeed was more likely explained by, lawful, unchoreographed free-market behavior.”); *see also American Dental Ass’n v. Cigna Corp.*, 605 F.3d 1283, 1290 (11th Cir. 2010) (“The alternative inferences that could be drawn from the facts—namely, that the arrests were likely lawful and justified by a nondiscriminatory intent to detain aliens who were illegally present in the United States and who had

potential connections to those who committed terrorist acts—were at least equally compelling. Accordingly, the Court ruled that Iqbal’s complaint must be dismissed.”) (internal citation omitted).

Relator’s complaint jumps to the conclusion that BP Lubricants knew of the patent’s expiration and intended to deceive the public based solely on the expiration itself and the fact that BP Lubricants is a “sophisticated company” with patent experience. In doing so, both Relator and the district court ignored other more plausible explanations. One such explanation is that BP Lubricants began marking its products to avail itself of the benefit of 35 U.S.C. § 287 and inadvertently kept the patent number on the product label after its alleged expiration based not on knowledge of the expiration, but rather, by mistake or inadvertence. Absent additional factual allegations to support Relator’s unfounded conclusion that the markings were the result of an intent to deceive, the complaint must be dismissed. *See Iqbal*, 129 S. Ct. at 1950-54.

In sum, the district court’s decision would improperly turn every allegedly mismarked label by a “sophisticated company” into a false patent marking case. This is clearly and indisputably improper, and renders Rules 8(a) and 9(b) powerless to fulfill the goal of protecting defendants from unfounded fishing expeditions and strike suits.

## **II. BP LUBRICANTS HAS NO OTHER ADEQUATE MEANS TO ATTAIN RELIEF**

### **A. Appeal from Final Judgment is Not an Adequate Alternative**

This Court “has a mandate to achieve uniformity in patent matters.” *Panduit Corp. v. All States Plastic Mfg. Co., Inc.*, 744 F.2d 1564, 1574 (Fed. Cir. 1984), *disapproved on other grounds by Richardson-Merrell, Inc. v. Koller*, 472 U.S. 424 (1985). The Senate Report leading to the creation of this Court noted that prior to this Court’s creation, “patent law [was] an area in which the application of the law to the facts of a case often produces different outcomes in different courtrooms in substantially similar cases.” *See Panduit*, 744 F.2d at 1573-74 (citing S. Rep. 97-275, 97th Cong., 1st Sess. 5, *reprinted in* 1982 U.S. Code Cong. & Ad. News 11, 15). As this Court has explained:

The fundamental underpinning for uniformity [in patent law] was Congress’ abhorrence of conflicts and confusion in the judicial system. That was the underlying motivation for the creation of this court, and it must remain the spirit and guiding principle of this court.

*Id.* To achieve this goal of uniformity in patent cases and to eliminate “different outcomes in different courtrooms in substantially similar cases,” this Court has been granted exclusive jurisdiction over the appellate review of patent law matters, and BP Lubricants’ mandamus petition should be considered with that jurisdictional mandate in mind.

The present state of district court decisions on dismissal of false marking cases is precisely the scenario this Court was created to address. Different outcomes are occurring in different courtrooms in cases that are not only “substantially similar,” but functionally identical in their allegations, despite this Court’s precedent in *Exergen* and *Pequignot*. Direct appeal of final judgments later in these cases would do little to address this problem, as such appeals would not likely address the denial of the motion to dismiss, but rather, the final judgments that never should have been rendered in the first place. Thus, absent the remedy of mandamus, this Court would be unable to ensure that its jurisdictional mandate of uniformity in patent law is achieved, and therefore, mandamus is necessary to aid in this Court’s jurisdiction. *See In re Princo Corp.*, 478 F.3d at 1351 (“This court plainly has jurisdiction to issue a writ of mandamus. The All Writs Act, 28 U.S.C.A. § 1651(a), vests authority in the Supreme Court and all courts established by Act of Congress to issue all writs necessary or appropriate in aid of their respective jurisdictions and agreeable to the usages and principles of law.”).

Appeal from a final judgment in this case would not adequately serve this Court’s jurisdictional mandate. Confusion and inconsistency in the lower courts is widespread already, and will only continue in the absence of firmer direction from this Court on the pleading standard applicable to these cases. Mandamus is

particularly appropriate under such circumstances. *See In re Volkswagen of America, Inc.*, 545 F.3d 304, 319 (5th Cir. 2008) (“[W]rits of mandamus are supervisory in nature and are particularly appropriate when the issues also have an importance beyond the immediate case. *See United States v. Bertoli*, 994 F.2d 1002, 1014 (3d Cir. 1993). Because venue transfer decisions are rarely reviewed, the district courts have developed their own tests, and they have applied these tests with too little regard for consistency of outcomes. Thus, here it is further appropriate to grant mandamus relief, as the issues presented and decided above have an importance beyond this case.”).

Further, decisions in which motions to dismiss have been denied, including the decision below, reflect a fundamental misunderstanding of this Court’s false marking precedent, as well as precedent from the similar context of inequitable conduct. This error is likely to manifest itself again during the summary judgment and trial phases of these cases, which further counsels in favor of prompt clarification through mandamus. *See In re Roche Molecular Sys., Inc.*, 516 F.3d 1003, 1005 (Fed. Cir. 2008) (Newman, J. dissenting) (“Postponing review of this law, as my colleagues have ruled, can result in trial of possibly unnecessary issues, while omitting critical issues that could resolve the dispute. This posture can only serve to extend the proceedings . . . serving no one, and least of all the interests of efficient justice.”); *see also In re Mark Indus.*, 751 F.2d at 1224-25 (granting

mandamus from district court sanction order eliminating presumption of patent validity at trial, because “[h]ad the trial been conducted and the jury instructed as set forth in the district court’s order, this court on appeal would have been required to order a new trial”).

**B. Interlocutory Appeal is Not an Adequate Alternative**

Similarly, interlocutory appeal is not an adequate alternative. While this Court has previously denied a mandamus petition from a denial of a motion to dismiss on the grounds that interlocutory appeal offered an adequate alternative to mandamus, *In re KGK Synergize, Inc.*, No. 2009-M-907, 2009 WL 3294864, at \*1 (Fed. Cir. 2009), that case did not involve the issue of irreconcilable results in identical cases before different district courts. Nor did that case present “an important issue of first impression in which courts have disagreed,” which led in part to this Court’s consideration and ultimate grant of mandamus in *In re Deutsche Bank Trust Co. Americas*, 605 F.3d 1373, 1375 (Fed. Cir. 2010) (granting mandamus regarding patent prosecution bar). Given the untenable circumstances of irreconcilable orders from different district courts across the federal judiciary, mandamus is appropriate here.<sup>6</sup> Despite this Court’s clear

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<sup>6</sup> Waiting for an appeal to be filed in a decision granting a motion to dismiss a false marking case is an inadequate alternative as well. No such appeal is before this Court, and BP Lubricants should not be left at the mercy of relators who may prefer not to risk the denials of motions to dismiss they have garnered against other defendants based on the same basic complaints.

precedent in *Exergen* and *Pequignot*, many district courts are not applying Rule 9(b) to these cases properly, and likely will not until this Court addresses the issue squarely.

**C. Mandamus is Required to Prevent the Threat of Extortionate Settlements**

Violation of the false patent marking statute carries a penalty of up to \$500 for each sale. 35 U.S.C. § 292(a); *Forest Group*, 590 F.3d at 1301. While lower courts have discretion in determining an appropriate penalty and may award as little as a fraction of a penny per article, *see Forest Group*, 590 F.3d at 1304, false-marking defendants face great uncertainty regarding how a penalty would be calculated, and therefore, face the potential for massive and disproportionate penalty awards, especially if the upper limits of penalties are assessed. *See Forest Group, Inc. v. Bon Tool Co.*, Civil Action No. H-05-4127, 2010 WL 1708433, at \*2 (S.D. Tex. April 27, 2010) (awarding, on remand, a penalty exceeding the total amount of revenue received by the defendant for the articles in question); *see also Pequignot*, 608 F.3d at 1359, 1359 n.1 (noting that relator sought \$5.4 trillion award). Because the potential stakes of a false patent marking suit are so high and so much is still unclear from existing caselaw, it is particularly appropriate for this Court to grant mandamus and ensure that “Rule 9(b)’s heightened pleading standard . . . reduces the number of frivolous suits brought solely to extract settlements.” *In re Burlington Coat Factory*, 114 F.3d at 1418 (Alito, J.)

(upholding dismissal on 9(b) grounds to defeat “a frivolous attempt by appellants to extort money” from the defendant based only on allegations of “a few negligently made errors”), *cited by Exergen*, 575 F.3d at 1331; *see also U.S. ex rel. Rost v. Pfizer, Inc.*, 507 F.3d 720, 733 (1st Cir. 2007) (Rule 9(b) “discourages plaintiffs from filing allegations of fraud merely in the hopes of conducting embarrassing discovery and forcing settlement”); *Banca Cremi, S.A. v. Alex Brown & Sons, Inc.*, 132 F.3d 1017, 1036 n.25 (4th Cir. 1997) (Rule 9(b) “deters the use of complaints as a pretext for fishing expeditions of unknown wrongs designed to compel *in terrorem* settlements”); *Uni\*Quality, Inc. v. Infotronx, Inc.*, 974 F.2d 918, 924 (7th Cir. 1992) (“Rule 9(b) ensures that a plaintiff have some basis for his accusations of fraud before making those accusations and thus discourages people from including such accusations in complaints simply to gain leverage for settlement or for other ulterior purposes.”); *Decker v. Massey-Ferguson, Ltd.*, 681 F.2d 111, 116 (2d Cir. 1982) (“Rule 9(b) will have failed in its purpose if conclusory generalizations such as these will permit a plaintiff to set off on a long and expensive discovery process in the hope of uncovering some sort of wrongdoing or of obtaining a substantial settlement.”).

Absent a mandamus ruling by this Court, the only alternative available to BP Lubricants is to litigate at great cost and risk or settle. Rule 9(b) is intended to guard against exactly this potentially extortionate scenario—a scenario that could

not be addressed through subsequent appeal without BP Lubricants and other defendants undertaking a tremendous risk that Rule 9(b) plainly does not require. *Cf. Matter of Rhone-Poulenc Rorer, Inc.*, 51 F.3d 1293, 1297 (7th Cir. 1995) (“Nevertheless we shall assume in accordance with the judge’s letter that eventually there will be a final judgment to review. Only it will come too late to provide effective relief to the defendants; and this is an important consideration . . . . The reason that an appeal will come too late to provide effective relief for these defendants is the sheer magnitude of the risk to which the class action, in contrast to the individual actions pending or likely, exposes them.”).

**D. Interests in Judicial Economy Support Mandamus Here**

Mandamus is appropriate in the interests of judicial economy that effect this case and the others like it. This Court has previously found appeal from final judgment to be inadequate where a party would wrongfully be forced to participate in litigation in the first place. *In re Princo Corp.*, 478 F.3d at 1357 (“Accordingly, we find that Princo has demonstrated that its right to issuance of the writ is ‘clear and indisputable.’ Princo’s right to a stay during the damages phase of the district court proceeding cannot be vindicated by direct appeal from the ultimate damages determination since § 1659 is designed to prevent the ongoing damages proceedings from occurring at all. Princo thus ‘lacks adequate alternative means to obtain the relief sought.’”); *Mississippi Chem. Corp. v. Swift Ag. Chem. Corp.*, 717

F.2d 1374, 1380 (Fed. Cir. 1983) (granting mandamus where “[t]he effect of the district judge’s action is to require [the accused infringer] to litigate that validity of the [asserted] patent despite a prior determination of invalidity in a case in which [the patentee] had a full and fair opportunity to litigate that issue”).

Here, the effect of the decision below is to force false marking defendants to litigate cases that lack adequate support to warrant their continuation under Rule 9(b). This Court’s precedent supports mandamus under these circumstances.

### **CONCLUSION**

The current state of false marking cases in the district courts challenges this Court’s mandate to ensure that the patent laws are uniformly applied, and indicates that many courts, including the court below, are not complying with this Court’s precedent in *Exergen* and *Pequignot*. Defendants should not be subjected to different results in different venues based on identical allegations. This Court should grant BP Lubricants’ mandamus petition and confirm the role of Rule 9(b) in upholding the intent to deceive element of a false marking claim. BP Lubricants respectfully asks this Court to grant BP Lubricants’ mandamus petition.

DATED: September 14, 2010

Respectfully submitted,



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## PROOF OF SERVICE

I hereby certify that on September 14, 2010, I caused an original and four true and correct copies of the PETITION FOR WRIT OF MANDAMUS OF BP LUBRICANTS USA INC. and the APPENDIX TO THE PETITION FOR WRIT OF MANDAMUS OF BP LUBRICANTS USA INC. to be served on the Clerk of the United States Court of Appeals for the Federal Circuit and I further certify that I caused the following individuals to be served with a true and correct copy of the foregoing via Federal Express:

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