

No. 24-635

In the Supreme Court of the United States

CELANESE INTERNATIONAL CORPORATION, ET AL.,
PETITIONERS

v.

INTERNATIONAL TRADE COMMISSION

*ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT*

**BRIEF FOR THE FEDERAL RESPONDENT
IN OPPOSITION**

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QUESTION PRESENTED

Whether a process invention is “on sale” within the meaning of 35 U.S.C. 102(a)(1) when a patentee sells a product that was made by secret use of the later-patented process.

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OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-18a) is reported at 111 F.4th 1338. The final determination of the International Trade Commission (Pet. App. 19a-25a) is unreported but is available at 2022 WL 1043922. The initial determination of the administrative law judge (Pet. App. 26a-45a) is unreported but is available at 2022 WL 142328.

JURISDICTION

The judgment of the court of appeals was entered on August 12, 2024. On October 23, 2024, the Chief Justice extended the time within which to file a petition for a writ of certiorari to and including December 10, 2024, and the petition was filed on December 9, 2024. The ju-

isdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

A. Legal Background

1. To strike a balance between “motivating innovation and enlightenment” while “avoiding monopolies that unnecessarily stifle competition,” Congress has imposed several conditions on the right to patent an invention. *Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.*, 586 U.S. 123, 129 (2019) (quoting *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 63 (1998)). “One such condition is the on-sale bar, which reflects Congress’ ‘reluctance to allow an inventor to remove existing knowledge from public use’ by obtaining a patent covering that knowledge.” *Ibid.* (quoting *Pfaff*, 525 U.S. at 64). As this Court explained nearly 200 years ago, “it would materially retard the progress of science and the useful arts” to allow an inventor to “sell his invention publicly” and later “take out a patent” to “exclude the public from any farther use than what should be derived under it.” *Pennock v. Dialogue*, 27 U.S. (2 Pet.) 1, 19 (1829) (Story, J.).

Seven years after this Court’s decision in *Pennock*, Congress enacted the Patent Act of 1836, ch. 357, 5 Stat. 117, which was the first United States patent law to include an express on-sale bar. The 1836 law prohibited the patenting of any invention that was “in public use or on sale, with [the inventor’s] consent or allowance,” when the patent application was filed. § 6, 5 Stat. 119; see *Pfaff*, 525 U.S. at 65. The Patent Act of 1952, ch. 950, 66 Stat. 792 (35 U.S.C. 1 *et seq.*), preserved the on-sale bar, prohibiting the patenting of any invention that “was patented or described in a printed publication in this or a foreign country or in public use or on sale in

this country” more than one year before the date of the patent application. 35 U.S.C. 102(b) (1952).

The current codification of this longstanding principle was enacted in 2011 as part of the Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29, 125 Stat. 284. See 35 U.S.C. 102. Section 102(a)(1) states that “[a] person shall be entitled to a patent unless * * * the claimed invention was patented, described in a printed publication, or in public use, *on sale*, or otherwise available to the public before the effective filing date of the claimed invention.” 35 U.S.C. 102(a)(1) (emphasis added). Section 102(b)(1)(A) provides that, under specified circumstances involving disclosures by the inventor, “[a] disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1).” 35 U.S.C. 102(b)(1)(A). In cases like this one, the patentability of an invention accordingly turns on whether the claimed invention was “on sale” more than one year before the effective filing date of the patent application. “[A]ny new and useful process, machine, manufacture, or composition of matter” may potentially be patented, 35 U.S.C. 101, and therefore qualify as a “claimed invention,” 35 U.S.C. 100(j).

In *Helsinn*, this Court considered whether the AIA version of the on-sale bar applied to an invention that was the subject of a sale under which the buyer was contractually obligated to keep the invention (a dosage for an anti-nausea drug) confidential. 586 U.S. at 125-126. The Court noted that under its pre-AIA precedent, an invention is “on sale” when two conditions are met: the invention is “the subject of a commercial offer for sale,” and the invention is “ready for patenting.” *Id.* at 125 (quoting *Pfaff*, 525 U.S. at 67). The *Helsinn* Court fur-

ther observed that, “[a]lthough this Court ha[d] never addressed the precise question presented in this case, [the Court’s] precedents suggest[ed] that a sale or offer of sale need not make an invention available to the public” to trigger the on-sale bar. *Id.* at 130; see *id.* at 130-131 (citing cases). The Court stated as well that pre-AIA decisions of the Federal Circuit (which has exclusive jurisdiction over patent appeals, see 28 U.S.C. 1295(a)) “ha[d] made explicit what was implicit” in the Court’s own precedents: that “‘secret sales’ can invalidate a patent.” *Helsinn*, 586 U.S. at 131 (citing two Federal Circuit decisions).

“In light of this settled pre-AIA precedent on the meaning of ‘on sale,’” this Court “presume[d] that when Congress reenacted the same language in the AIA, it adopted the earlier judicial construction of that phrase.” *Helsinn*, 586 U.S. at 131. The inventor argued that, by adding a new catchall phrase (“‘or otherwise available to the public’”) to the provision that contained the on-sale bar, the AIA had limited the phrase “‘on sale’” to sales that make the invention publicly available. *Id.* at 131-132 (quoting 35 U.S.C. 102(a)(1)). The Court rejected that inference, however, reasoning that Congress’s addition of the catchall language “would be a fairly oblique way of attempting to overturn” the pre-AIA “settled body of law” applying the on-sale bar to secret sales. *Id.* at 131 (citation omitted); see *id.* at 132. The Court instead held that “an inventor’s sale of an invention to a third party who is obligated to keep the invention confidential can qualify as prior art” under Section 102(a). *Id.* at 132.

B. Proceedings Below

1. This case involves an investigation under Section 337 of the Tariff Act of 1930, 19 U.S.C. 1337 (Section

337), which prohibits “[t]he importation into the United States * * * of articles that * * * infringe a valid and enforceable United States patent.” 19 U.S.C. 1337(a)(1)(B)(i). The International Trade Commission (ITC or Commission) is authorized to investigate alleged violations of Section 337. 19 U.S.C. 1337(b)(1). A respondent to such an investigation may raise “[a]ll legal and equitable defenses,” including an argument that the asserted patent is invalid. 19 U.S.C. 1337(c).

The invention at issue is a process for making the artificial sweetener acesulfame potassium (Ace-K). Pet. App. 2a. Petitioner (the patentee) asserted claims from three patents—U.S. Patent Nos. 10,023,546, 10,208,004, and 10,590,095—all of which claim petitioner’s Ace-K-making process. *Id.* at 2a-3a. The asserted patents have an effective filing date of September 21, 2016, and are governed by the AIA. *Id.* at 3a. It is undisputed that petitioner’s patented process was in secret use in Europe more than one year before that filing date. *Ibid.* It is also undisputed that petitioner sold Ace-K in the United States made through secret use of the patented process before that one-year mark. *Ibid.*

2. a. Petitioner filed a Section 337 complaint with the Commission, asserting that respondents Jinhe Industrial Co., Ltd. and Jinhe USA LLC (collectively, Jinhe) were importing Ace-K that had been made using a process that infringed petitioner’s patents. Pet. App. 2a. In proceedings before the administrative law judge (ALJ), Jinhe moved for a summary determination that petitioner’s patent claims were invalid under the on-sale bar in Section 102(a).

The ALJ issued an initial determination finding petitioner’s patents invalid. Pet. App. 26a-42a. Applying *Helsinn*, the ALJ agreed with Jinhe that the on-sale bar

applied even though petitioner's sales of Ace-K during the relevant period had kept the patented process secret. *Id.* at 32a-40a.

b. The ITC adopted the ALJ's initial determination as the agency's final determination. Pet. App. 19a-22a.

3. The court of appeals affirmed the Commission's determination. Pet. App. 1a-18a.

The court of appeals observed that, in interpreting the pre-AIA on-sale bar, the Federal Circuit had "long held that sales of products made using a secret process before the critical date would bar the patentability of that process." Pet. App. 6a. The court highlighted its holding in *D.L. Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144 (Fed. Cir. 1983), that a method patent was invalid where the patentholder had sold sample products made using the patented method while keeping the method secret. The court in *D.L. Auld* had explained that the on-sale bar applied "to preclude [the] inventor's attempt to profit from commercial exploitation of his invention for more than one year before seeking a patent." Pet. App. 7a (discussing *D.L. Auld*, 714 F.2d at 1147). And the court here noted that it had "reiterated" *D.L. Auld*'s holding in several decisions spanning four decades. *Ibid.* (citing *Medicines Co. v. Hospira, Inc.*, 827 F.3d 1363, 1376 (Fed. Cir. 2016) (en banc); *In re Kollar*, 286 F.3d 1326, 1333 (Fed. Cir. 2002); *In re Caveney*, 761 F.2d 671, 675 (Fed. Cir. 1985); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)).

The court of appeals further explained that its precedent was consistent with this Court's decision in *Pennock*, which deemed a process invention unpatentable based on the inventors' prior sale of products made using the process. See 27 U.S. (2 Pet.) at 3, 19, 23-24; see

also Pet. App. 7a. The court of appeals also pointed to the Second Circuit’s 1946 decision in *Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F.2d 516 (L. Hand, J.), which held that an inventor had forfeited his right to patent a process invention that had been secretly used to make products the inventor had placed on sale, “regardless of how little the public may have learned about the invention.” *Id.* at 520; see *id.* at 517-518; see also Pet. App. 7a-8a.

In light of that “long-settled pre-AIA precedent,” Pet. App. 8a, and the *Helsinn* Court’s holding that the AIA did not alter the scope of the on-sale bar, *id.* at 9a-10a (discussing *Helsinn*), the court of appeals concluded that Section 102(a)(1) continues to bar patents on process inventions that have been used to manufacture products placed on sale, even if the process itself has remained secret. Petitioner argued that current Section 102(a)(1)’s use of the term “claimed invention,” to replace the term “invention” used in the pre-AIA on-sale bar, had the effect of exempting process inventions where the process itself is not placed on sale. *Id.* at 11a-12a. But the court concluded that Congress’s “addition of the word ‘claimed’” was properly viewed not as a “foundational change,” but as a “clerical refinement of terminology for the same meaning in substance.” *Id.* at 12a.

Petitioner also argued that Section 102(a)(1)’s new catchall phrase (“or otherwise available to the public”) demonstrated that the on-sale bar exempts sales of a product that do not publicly disclose the underlying process. Pet. App. 12a-13a. But the court of appeals observed that this Court in *Helsinn* had rejected the same argument about the catchall phrase. *Id.* at 13a.

Petitioner contended that applying the on-sale bar to sales of goods made using a secret process would create a “mismatch” with the grace period in Section 102(b)(1)(A), which protects certain “disclosure[s]” made by the inventor in the year before the patent application is filed. Pet. App. 14a (quoting 35 U.S.C. 102(b)(1)(A)); see p. 3, *supra*. Without endorsing petitioner’s understanding that Section 102(b)(1)(A) is limited to *public* disclosures, the court declined to address a provision that is not implicated in this case. *Id.* at 15a. The court also found unpersuasive petitioner’s attempts to draw inferences from two AIA provisions that govern patent infringement, 35 U.S.C. 271(g), 273(a). Pet. App. 15a-16a. The court explained that, because patentability and infringement “are distinct issues” with distinct frameworks and rationales, “[t]he fact that Congress elected to write *infringement*-related sections in a certain way does not support a conclusion that Congress meant to rewrite sections on *patentability* or *validity*.” *Id.* at 16a.

The court of appeals accordingly concluded that petitioner “fail[ed] to show the AIA overturned settled precedent that pre-critical date sales of products made using a secret process preclude the patentability of that process.” Pet. App. 18a.

ARGUMENT

Petitioner argues (Pet. 12-32) that a patented process is not “on sale” for purposes of the bar in 35 U.S.C. 102(a)(1) when the patentee sells a product made by secret use of that process. The court of appeals correctly adhered to its longstanding precedents in concluding that the on-sale bar applies in this situation. The court’s conclusion that those precedents remain in force resulted from a straightforward application of this Court’s

decision in *Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.*, 586 U.S. 123 (2019), which held that in reenacting the pre-AIA version of the on-sale bar without material change, Congress had adopted the settled judicial construction of that provision. Petitioner does not ask this Court to overrule *Helsinn*, and petitioner’s various attempts to sidestep that controlling decision lack merit. The petition for a writ of certiorari should be denied.

1. The court of appeals correctly affirmed the Commission’s invalidity finding in this case. There is no dispute that, more than a year before the effective filing date of the asserted patents, petitioner commercially sold Ace-K that had been made through the process claimed in those patents. Pet. App. 3a. Under pre-AIA Section 102(b), the predecessor to the current on-sale bar in Section 102(a)(1), such transactions constituted sales of the process for making Ace-K. *Id.* at 8a. As a result, the transactions likewise triggered the current on-sale bar. See *Helsinn*, 586 U.S. at 131.

In *Helsinn*, this Court observed that “Congress enacted the AIA in 2011 against the backdrop of a substantial body of law interpreting § 102’s on-sale bar.” 586 U.S. at 130. “In light of this settled pre-AIA precedent on the meaning of ‘on sale,’” the Court “presume[d] that when Congress reenacted the same language in the AIA, it adopted the earlier judicial construction of that phrase.” *Id.* at 131; see pp. 3-4, *supra*. And because precedent from this Court and the Federal Circuit established that “a sale * * * need not make an invention available to the public” to qualify, the Court held that the sale in that case—the terms of which obligated the buyer to keep the invention secret—triggered the on-sale bar. *Helsinn*, 586 U.S. at 130, 132.

The same analytical approach controls here. See Pet. App. 10a. The Federal Circuit “has long held that sales of products made using a secret process before the critical date would bar the patentability of that process.” *Id.* at 6a. Indeed, shortly after the Federal Circuit’s creation, the court held that, if a patentee “produced [a product] by the method of the invention and offered that [product] for sale before the critical date, the right to a patent on the method must be declared forfeited.” *D.L. Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 1147 (1983). The Federal Circuit has reiterated that rule many times since. See, e.g., *Medicines Co. v. Hospira, Inc.*, 827 F.3d 1363, 1376 (Fed. Cir. 2016) (en banc) (“It is with vigilance that we have held that the sale of products made using patented methods triggers the on-sale bar, even though title to the claimed method itself did not pass.”); *In re Kollar*, 286 F.3d 1326, 1333 (Fed. Cir. 2002) (“[A] sale by the patentee or a licensee of the patent of a product made by the claimed process would constitute such a sale because that party is commercializing the patented process in the same sense as would occur when the sale of a tangible patented item takes place.”); *In re Caveney*, 761 F.2d 671, 675 (Fed. Cir. 1985) (explaining that “where a patented method is kept secret and remains secret after a sale of the unpatented product of the method,” “[s]uch a sale prior to the critical date is a bar if engaged in by the patentee or patent applicant”).

Nearly 40 years before *D.L. Auld* was decided, the Second Circuit had reached the same conclusion. See *Metallizing Eng’g Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F.2d 516, cert. denied, 328 U.S. 840 (1946). In *Metallizing*, the Second Circuit held that an inventor’s sale of a product made by a patented process will trig-

ger the on-sale bar in light of the inventor’s “competitive exploitation of his machine or of his process,” whether or not the details of the process are revealed. *Id.* at 520. As Judge Learned Hand explained—in a passage this Court has repeatedly quoted—“it is a condition upon an inventor’s right to a patent that he shall not exploit his discovery competitively after it is ready for patenting; he must content himself with either secrecy, or legal monopoly.” *Ibid.*; see *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68 (1998); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 149 (1989). *Metallizing*, in turn, relied on this Court’s decision in *Pennock v. Dialogue*, 27 U.S. (2 Pet.) 1 (1829) (Story, J.), which invalidated a patent for a method for making hose because the inventor had sold the hose before seeking a patent. See *Metallizing*, 153 F.2d at 518; see also p. 2, *supra*; p. 15, & note 2, *infra*; Pet. App. 7a.

Thus, for decades before the AIA was enacted, “[c]ase law confirmed that performing the patented method for commercial purposes before the critical date constitutes a sale under § 102(b).” 2A Donald S. Chisum, *Chisum on Patents* § 6.02[6][f] (2022) (internal quotation marks omitted); see F. Scott Kieff et al., *Principles of Patent Law*, Ch. 4, 370 (4th ed. 2008) (“[T]he sale of a product made by the claimed process * * * [will] trigger the on-sale bar.”). That rule was also recognized in the Manual of Patent Examining Procedure (MPEP) issued by the United States Patent and Trademark Office (USPTO) before the AIA’s enactment. MPEP § 2133.03(c)(III) (8th ed., rev. 2010) (“[S]ale of a product made by the claimed process by the patentee or a licensee would constitute a sale of the process within the meaning of 35 U.S.C. 102(b).”). The current MPEP likewise instructs that “[t]he phrase ‘on sale’ in AIA 35 U.S.C. 102(a)(1) is

treated as having the same meaning as ‘on sale’ in pre-AIA 35 U.S.C. 102(b).” MPEP § 2152.02(d) (9th ed., rev. 2024); see *ibid.* (cross-referencing MPEP § 2133.03, which states the same rule regarding process inventions as in the 2010 version).

The court of appeals accordingly concluded that, when Congress reenacted the “‘on sale’ language,” the legislature “was aware of [this] pre-AIA precedent and adopted [this] settled judicial interpretation of the term” with respect to products made through use of process inventions, whether secretly or not. Pet. App. 10a. That result accords with the holding of *Helsinn* itself, which concluded that the on-sale bar applies whether or not the invention is actually made available to the public. 586 U.S. at 132. Indeed, *Helsinn* cited one of the Federal Circuit’s precedents involving a method invention, *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368 (1998), in support of the Court’s rule regarding “secret sales,” *Helsinn*, 586 U.S. at 131; see *Woodland Trust*, 148 F.3d at 1369-1371.

2. Petitioner argues (Pet. 13-15, 22-23) that the revised text in Section 102(a)(1)—namely, the AIA’s addition of the phrases “claimed invention” and “otherwise available to the public”—demonstrate that Congress abrogated the on-sale bar’s application to products made through use, or at least through secret use, of a process invention. Petitioner alternatively argues that the pre-AIA law respecting the on-sale bar’s application to such products was not sufficiently well established to fall within *Helsinn*’s rule. Both contentions lack merit.

a. The court of appeals correctly rejected petitioner’s argument that the AIA’s shift from the term “invention” to “claimed invention” had the effect of excluding products made using a patented process. Pet.

App. 11a-13a; compare 35 U.S.C. 102(b) (2006), with 35 U.S.C. 102(a)(1). To begin with, it is clear that the pre-AIA on-sale bar's reference to "invention" already meant "claimed invention"; pre-AIA decisions from the Federal Circuit and this Court had used the word "claimed" to describe the invention at issue. See Pet. App. 12a (citing *Pfaff, Medicines, Kollar, and Caveney*). And the AIA's change makes sense in light of Congress's effort to standardize terminology: "claimed invention" is now used across the patent laws. See 35 U.S.C. 102, 103; see also 35 U.S.C. 100 (defining "claimed invention"). The AIA's replacement of "invention" with "claimed invention" thus amounted to no more than a "clerical" revision of the on-sale bar, not a "foundational" change to the bar's coverage. Pet. App. 12a.

More fundamentally, the crucial interpretive question here concerns "what it means for a claimed process invention to be placed on sale," Pet. App. 11a-12a, not what counts as the claimed invention. And pre-AIA precedent established that an inventive process is "on sale" when the patentee "is commercializing the patented process in the same sense as would occur when the sale of a tangible patented item takes place." *Kollar*, 286 F.3d at 1333; see, e.g., *BASF Corp. v. SNF Holding Co.*, 955 F.3d 958, 969 (Fed. Cir. 2020) ("[A] process may be sold in a manner which triggers the on-sale bar. For example, * * * a patentee's sale of a product made by his later-patented process [is sufficient].") (citing *D.L. Auld* and *Metallizing*). Per *Helsinn*, Congress's reenactment of the phrase "on sale" carried forward that phrase's prior judicial construction.¹

¹ The legislative process leading up to the AIA's enactment further undermines petitioner's contention regarding the significance

Petitioner next relies on the AIA’s addition of the catchall phrase “or otherwise available to the public.” 35 U.S.C. 102(a)(1). Petitioner contends that Congress added the phrase to “emphasize the fact that [prior art] must be publicly accessible.” Pet. 13-14 (citation omitted). But the Court in *Helsinn* squarely rejected that argument. See 586 U.S. at 131-132.

The same goes for petitioner’s argument (Pet. 30) that a policy underlying *D.L. Auld* and similar decisions—the need to incentivize inventors to file for patents early, rather than extending their monopolies through secret commercialization of the invention, see Pet. App. 7a—was sufficiently addressed by the AIA’s shift to a first-inventor-to-file system. The petitioner in *Helsinn*, as well as the United States as amicus, raised the same point to explain why it made sense that the AIA had cabined the on-sale bar to sales that make the invention publicly available. Pet. Br. at 16, 31-32, *Helsinn, supra* (No. 17-1229); U.S. Amicus Br. at 23-25, *Helsinn, supra* (No. 17-1229). This Court was unpersuaded. See *Helsinn*, 586 U.S. at 132.

of the phrase “claimed invention.” The word “claimed” was added to Section 102(a), and the definition of “claimed invention” was added to Section 100, in the 2005 House bill that was the earliest precursor of the AIA. See H.R. 2795, 109th Cong., 1st Sess., § 3(a) and (b)(1) (as introduced June 8, 2005). That bill contained no on-sale bar at all. See *ibid.* The “on sale” language was then reinserted in later House and Senate bills that retained the term “claimed invention.” H.R. 1908, 110th Cong., 1st Sess., § 3(a) and (b)(1) (as introduced Apr. 18, 2007); S. 1145, 110th Cong., 1st Sess., § 2(a) and (b)(1) (as introduced Apr. 18, 2007). It is particularly unlikely that Congress intended the phrase “claimed invention” to abrogate pre-AIA on-sale-bar precedents when the phrase was introduced in a legislative proposal that contained no on-sale bar at all.

b. Petitioner alternatively contends (Pet. 23-28) that *Helsinn* does not apply here because the law respecting the on-sale bar’s application to process inventions, or to products made through secret use of process inventions, was not well-settled before the AIA. That is not persuasive. See pp. 10-12, *supra*. Indeed, as the court of appeals noted, petitioner initially did not dispute the state of the pre-AIA law on this question. Pet. App. 3a; see *id.* at 32a.

Even now, petitioner identifies no decision holding that the on-sale bar does not apply when an inventor sells a product made (secretly or otherwise) through use of a process invention. Petitioner instead argues (Pet. 24) that only an on-point precedent of this Court can establish “judicial consensus” regarding the pre-AIA on-sale bar’s scope. But the Court did confront this situation in *Pennock*: it held that inventors lost their right to a patent for “a new and useful improvement in the art of making leather tubes or hose” because they had allowed a licensee to sell hose made using that process. 27 U.S. (2 Pet.) at 14; see *id.* at 23-24. To be sure, *Pennock* was decided before the first U.S. on-sale bar was enacted, and it resolved an issue of prior use. But this Court has relied on *Pennock* in explicating the on-sale bar’s purpose. See *Helsinn*, 586 U.S. at 129; *Pfaff*, 525 U.S. at 64-65.²

² Petitioner contends (Pet. 24-25) that the patent at issue in *Pennock* was actually for the hose itself, or that the patented process would have been apparent from the hose. Those arguments lack merit. See *Pennock*, 27 U.S. (2 Pet.) at 3 (headnote describing the claimed invention); *id.* at 14; *Pennock v. Dialogue*, 19 F. Cas. 171, 171 (C.C.E.D. Pa. 1825) (synopsis), *aff’d*, 27 U.S. (2 Pet.) 1 (1829); see also *Metallizing*, 153 F.2d at 518 (describing *Pennock* as involving a patent granted “for a process of making hose by which the

In *Helsinn*, this Court acknowledged that its own pre-AIA decisions “ha[d] never addressed the precise question presented in th[at] case.” 586 U.S. at 130. The Court accordingly turned to Federal Circuit decisions to identify “settled pre-AIA precedent.” *Id.* at 131. And here, as in *Helsinn*, “[t]he Federal Circuit * * * has made explicit what was implicit in [this Court’s] precedents.” *Ibid.*; see Pet. App. 6a-7a. And the Second Circuit had reached the same conclusion before the Federal Circuit was created. See *Metallizing*, 153 F.2d at 520; Pet. App. 7a-8a.

Petitioner also attacks the substance of that pre-AIA rule, asserting (Pet. 26-27) that the court of appeals decisions on the subject were not well-reasoned or created a doctrinal anomaly. Even if petitioner’s criticisms had weight, that would be irrelevant to the analytical approach this Court followed in *Helsinn*, which did not assess the merit of the pre-AIA consensus that an inventor’s secret sale triggers the on-sale bar. And petitioner is wrong in arguing that the courts of appeals have given more than one meaning to the statutory term “on sale” depending on whether the inventor or a third party makes the sale. See Pet. 27. The Federal Circuit considers the effect of third-party sales of end products not under the on-sale bar, but under the public-use bar (which also is currently codified in Section 102(a)(1)). See *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1549-1550 (Fed. Cir. 1983); *Caveney*, 761 F.2d at 675 n.5. In any event, the distinction between inventor and third-party sales was similarly well-established before the AIA, see MPEP § 2152.02(c) (9th ed., rev. 2024) (de-

sections were joined together in such a way that the joints resisted pressure,” where “[i]t did not appear that the joints in any way disclosed the process”).

scribing pre-AIA law), so the more plausible inference is that Congress carried forward that distinction as well, see 5 *Chisum on Patents* § 16.03[4][b][viii] (2022).

c. Petitioner’s various other arguments are unpersuasive.

i. Petitioner argues (Pet. 16-18) that the court of appeals’ interpretation of the on-sale bar creates a “mismatch” with the grace-period provision in 35 U.S.C. 102(b)(1)(A). Under Section 102(b)(1)(A), “disclosure[s]” made within one year of a claimed invention’s filing date are not treated as prior art if the disclosure is made “by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.” 35 U.S.C. 102(b)(1)(A). Section 102(b)(1)(A) thus provides inventors with a one-year grace period in which they can make disclosures that would otherwise qualify as prior art under Section 102(a)(1) without causing their inventions to become unpatentable. See *Sanho Corp. v. Kaijet Tech. Int’l Ltd.*, 108 F.4th 1376, 1380-1381 (Fed. Cir. 2024).

Petitioner interprets Section 102(b)(1)(A) to apply only to a “sub-category of prior art” listed in Section 102(a)(1), on the assumption that “disclosure” must mean a *public* disclosure. Pet. 17. But that same subsection uses the phrase “publicly disclosed” in setting forth a different grace period and another prior-art exception. See 35 U.S.C. 102(b)(1)(B) and (b)(2)(B). Giving effect to that textual distinction, the court of appeals indicated in another recent decision, *Sanho*, that the “disclosure[s]” protected by the grace period in Section 102(b)(1)(A) are coextensive with the categories of prior art enumerated in Section 102(a)(1)—including on-sale-bar prior art—while the grace period and exception in

Section 102(b)(1)(B) and (b)(2)(B) apply to a narrower category of disclosures that make the invention available to the public. See 108 F.4th at 1380-1382. In any event, the proper interpretation of Section 102(b)(1)(A) is irrelevant here, as it is undisputed that petitioner sold its Ace-K more than a year before the effective filing date of its patents. See Pet. App. 15a.

ii. The infringement provisions in 35 U.S.C. 271 and 273 likewise do not suggest that Congress abrogated the on-sale bar's application to process inventions. Petitioner relies (Pet. 14-15) on Section 271(g)'s reference to "a product which is made by a process patented in the United States," 35 U.S.C. 271(g), and on Section 273(a)'s reference to a person who "commercially used the subject matter" in connection with a "commercial transfer of a useful end result of such commercial use," 35 U.S.C. 273(a)(1). In petitioner's view, those provisions show that "Congress knew how to refer to products made from use of a patented process and to commercial use more broadly." Pet. 15.

Petitioner's reliance on those provisions is misplaced, since "infringement and invalidity are separate matters under patent law." *Commil USA, LLC v. Cisco Sys., Inc.*, 575 U.S. 632, 643 (2015). Section 273(g) recognizes this distinction, providing that "[a] patent shall not be deemed to be invalid under section 102 or 103 solely because a defense is raised or established under [Section 273]." 35 U.S.C. 273(g). The infringement provisions of Sections 271 and 273 shed no light on the scope of Section 102's validity provisions. See Pet. App. 16a.

Petitioner's argument about the significance of the infringement provisions' distinct wording fails on its own terms as well. The phrase in Section 271(g) that petitioner seizes upon pre-dates the AIA by more than

two decades. See Process Patents Amendments Act of 1988, Pub. L. No. 100-418, Tit. IX, § 9003, 102 Stat. 1563-1564. Section 273 also used the phrase “useful end result” more than a decade before the AIA. See First Inventor Defense Act of 1999, Pub. L. No. 106-113, § 4302, 113 Stat. 1501A-555. Thus, the infringement provisions and the pre-AIA understanding of the on-sale bar’s application to process inventions coexisted before the AIA was enacted. If Congress had intended to alter that status quo, reenacting the relevant language without material alteration would have been “a fairly oblique way” to do it. *Helsinn*, 586 U.S. at 131 (citation omitted).

The court of appeals also correctly rejected petitioner’s contention (Pet. 19) that maintaining the pre-AIA interpretation of the on-sale bar renders superfluous Section 273’s prior-use defense to infringement. See Pet. App. 16a. That contention relies on a ruling the court below never made: that “the sale of a ‘useful end result’ would invalidate the process patent regardless of the seller’s identity.” Pet. 19. The court did not diverge from its precedent holding that a private third-party sale does not implicate the on-sale bar. See p. 16-17, *supra*; see also Pet. App. 7a (citing *W.L. Gore*).

iii. The decision below reflects the Federal Circuit’s straightforward application of *Helsinn* and is otherwise consistent with the Court’s on-sale-bar precedents. See pp. 9-12, *supra*. Petitioner does not ask this Court to reconsider *Helsinn*, and no justification for doing so is apparent. See *Kimble v. Marvel Entm’t, LLC*, 576 U.S. 446, 455-456 (2015) (“Absent special justification, [the Court’s statutory interpretation decisions] are balls tossed into Congress’s court, for acceptance or not as that branch elects.”).

Petitioner’s concerns about industry upheaval and uncertainty (Pet. 32-34) are unfounded. The decision below—issued by the court of appeals that exercises exclusive jurisdiction over patent appeals—maintained the longstanding on-sale-bar rule for process inventions, consistent with *Helsinn*’s holding that the AIA did not alter the analysis that governs when a claimed invention is “on sale.” 586 U.S. at 132. As discussed, the USPTO’s guidance to examiners has recognized that same rule before and after the AIA’s enactment. See pp. 11-12, *supra*. And petitioner’s more specific concerns about the interaction between the holding below and other patent-law rules (Pet. 34) are misplaced for the reasons addressed above. See pp. 16-19, *supra*. The court of appeals’ reaffirmation of a long-settled limit on the patentability of process inventions thus poses no risk of upsetting industry expectations.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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