

5 KEY TAKEAWAYS

Making Sense of §102 Public Use and On Sale Bars to Patentability

Kilpatrick's [Justin Krieger](#) and [Karam J. Saab](#) recently presented at the "[23rd Annual Rocky Mountain Intellectual Property & Technology Law Institute](#)" in Westminster, Colorado. This two-day event brings together thought leaders, seasoned practitioners, and innovators to explore how emerging technologies, global regulations, and emerging legal theories shape the future of IP and technology law.

Justin and Karam spoke on the topic of "Making Sense of §102 Public Use and On Sale Bars to Patentability."

Here are their 5 key takeaways from the presentation:

1

Under 35 USC 102(a)(1), public use of a claimed invention serves as a bar to patentability. The Courts have broadly construed public use as requiring use by only a single person in a public manner. Recently, in decisions such as *Minerva Surgical, Inc. v. Hologic, Inc.* (2007) and *In re WinGen* (2023), the Federal Circuit has found that the presentation of an invention at a trade show outside of any confidentiality agreement can constitute public use and serve as a bar to patentability.

2

The on sale bar to patentability remains alive and well. To be "on sale" under § 102, an invention must be the subject of a commercial offer for sale—typically considered under the UCC—and be ready for patenting, e.g., reduced to practice or worked up in drawings. The law differs for product and process inventions. For products, an offer for sale anywhere in the world, even under an NDA, can create a prior art event for everyone. In contrast, under the forfeiture doctrine the sale of a product made by an inventive secret process triggers a prior art event for the process for the inventor only—not for others.

3

The one year "grace period" has been significantly weakened by the AIA. The AIA grace period under § 102(b) is a "first to disclose" statute and does not provide an absolute grace period. As a result, although the grace period will protect an inventor's own public disclosures or offers for sale made within one year of filing, it will only protect an inventor from another's independent disclosure or offer for sale of the invention if the inventor had earlier publicly disclosed the same subject matter. Since most inventors do not publicly disclose their inventions before filing for patent protection, the availability of the grace period over another's disclosure or sale is rarely available.

4

Experimental use has long served as a judicially-created exception to the public use and on-sale bars of 35 USC 102(a)(1). An offer for sale or public use of an invention does not constitute a disqualifying bar event if the primary purpose of the sale or public use was experimentation. The Courts have historically used a totality of the circumstances analysis reviewing factors such as the amount of control of testing maintained by the inventor, the level of record keeping maintained, and whether the invention ultimately claimed in a patent application was modified in response to the experimentation.

5

In *Sunoco Partners v. U.S. Venture, Inc.* (2023), the Federal Circuit found the language of a contract between the parties involved in a sale highly determinative in finding that no exemption to the on-sale bar would be granted for experimental use. While the inventors insisted that their intent in performing a sale was to test and monitor their invention, the Federal Circuit gave significant weight to the language used in the contract for sale. This decision emphasizes the importance of carefully defining contract language if use of the experimental use exception may be desired for filing of a patent application more than a year after an otherwise barring event.

For more information, please contact:

www.ktslaw.com

Justin Krieger, jkrieger@ktslaw.com and
Karam J. Saab, ksaab@ktslaw.com.