

2022-1827

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**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

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**CELANESE INTERNATIONAL CORPORATION,  
CELANESE (MALTA) COMPANY 2 LIMITED,  
CELANESE SALES U.S. LTD.,**  
*Appellants,*

v.

**INTERNATIONAL TRADE COMMISSION,**  
*Appellee,*

and

**ANHUI JINHE INDUSTRIAL CO., LTD., JINHE USA LLC,**  
*Intervenors.*

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Appeal from the United States International Trade  
Commission in Investigation No. 337-TA-1264

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**BRIEF OF APPELLEE  
INTERNATIONAL TRADE COMMISSION**

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**U.S. PATENT NO. 10,023,546 CLAIMS 1, 11, 15, AND 27 (APPX380-381)**

1. A process for producing a finished acesulfame potassium composition, the process comprising the steps of:

(a) contacting a cyclizing agent and a solvent selected from the group consisting of halogenated aliphatic hydrocarbons, esters of carbonic acid with lower aliphatic alcohols, nitroalkanes, alkyl-substituted pyridines, aliphatic sulfones, acetone, acetic acid, and dimethylformamide to form a cyclizing agent composition;

(b) reacting an acetoacetamide salt with the cyclizing agent in the cyclizing agent composition to form a cyclic sulfur trioxide adduct; and

(c) forming from the cyclic sulfur trioxide adduct the finished acesulfame potassium composition comprising non-chlorinated acesulfame potassium and less than 35 wppm 5-chloro-acesulfame potassium;

wherein contact time from the beginning of step (a) to the beginning of step (b) is less than 60 minutes.

\* \* \*

11. The process of claim 1, wherein the finished acesulfame potassium composition comprises from 0.001 wppm to 2.7 wppm 5-chloro-acesulfame potassium.

\* \* \*

15. The process of claim 1, wherein the reacting is conducted for a cyclization reaction time, from the start of the reactant feed to the end of the reactant feed, less than 35 minutes.

\* \* \*

27. The process of claim 1, wherein the process yields at least 100 grams of finished acesulfame potassium composition per hour.

## TABLE OF CONTENTS

<b>TABLE OF AUTHORITIES .....</b>	<b>v</b>
<b>STATEMENT OF RELATED CASES .....</b>	<b>x</b>
<b>STATEMENT OF THE ISSUE.....</b>	<b>1</b>
<b>STATEMENT OF THE CASE.....</b>	<b>1</b>
I.    The Proceedings Below .....	1
II.   The Patents and Technology at Issue .....	3
III.  The On-Sale Bar .....	4
IV.  The Commission’s Findings and Determination.....	7
<b>SUMMARY OF THE ARGUMENT .....</b>	<b>12</b>
<b>ARGUMENT.....</b>	<b>15</b>
I.    Standard of Review .....	15
II.   The Commission’s Determination of No Violation Is a Correct and Unremarkable Application of Controlling Precedents to Undisputed Facts. ....	15
A.  It is Well Settled That an Inventor’s Sale of a Product Made by a Patented Process Places That Process “On Sale” Within the Meaning of Pre-AIA § 102(b). ....	16
B.  By Retaining the Words “On Sale,” Without Alteration, in the Post-AIA On-Sale Bar, Congress Did Not Alter the Well-Settled Understanding of When an Inventive Process Is “On Sale.” .....	18
C.  There Is No Dispute That Celanese Sold Products That It Made with Its Patented Processes More Than One Year Before the Effective Filing Date for Those Processes. ....	19
D.  Because All of the Claims on Which Celanese Relies to Establish a Domestic Industry Are Invalid, It Cannot Demonstrate a Section 337 Violation. ....	20

**TABLE OF CONTENTS (cont'd)**

III. Celanese Fails to Show Error in the Commission’s Determination.....21

    A. Celanese’s Interpretation of the On-Sale Bar of § 102(a)(1) Lacks Support in the Text, Structure, and Purpose of the AIA. ....22

        1. The Text of the AIA Does Not Support Celanese’s Interpretations of § 102(a)(1). ....22

            (a) § 102(a)(1)’s “Claimed Invention”.....23

            (b) § 273’s “Useful End Result” .....27

            (c) § 271’s “Offers to Sell” .....29

            (d) § 102(a)(1) ’s “Otherwise Available to the Public” .....31

            (e) § 102(a)’s Title .....31

        2. The Structure of the AIA Does Not Support Celanese’s Interpretations of § 102(a)(1).....33

            (a) “Disclosures” in §§ 102(b) and 103 .....33

            (b) The Prior-Use Defense of § 273 .....36

            (c) Post-Grant Reviews Under § 321 .....37

        3. The Policies Behind the AIA Do Not Support Celanese’s Interpretations of § 102(a)(1).....38

    B. Celanese’s Criticisms of the Commission’s Determination Miss the Mark.....43

        1. The Reenactment Canon Applies to the Meaning of “On Sale” in § 102(a)(1).....43

        2. *Helsinn* Supports the Commission’s Determination.....51

        3. The Legislative History of the AIA Is Consistent with the Commission’s Determination .....52

        4. The MPEP Is Consistent with the Commission’s Determination.....55

**CONCLUSION .....56**

## TABLE OF AUTHORITIES

<b>Cases</b>	<b>Page(s)</b>
<i>3D Sys., Inc. v. Aarotech Labs., Inc.</i> , 160 F.3d 1373 (Fed. Cir. 1998) .....	30
<i>BASF Corp. v. SNF Holding Co.</i> , 955 F.3d 958 (Fed. Cir. 2020) .....	<i>passim</i>
<i>Bostock v. Clayton Cnty., Ga.</i> , 140 S. Ct. 1731 (2020).....	38, 39
<i>BP P.L.C. v. Mayor of Balt.</i> , 141 S. Ct. 1532 (2021).....	47
<i>In re Caveney</i> , 761 F.2d 671 (Fed. Cir. 1985) .....	17, 36, 41, 44, 45
<i>D.L. Auld Co. v. Chroma Graphics Corp.</i> , 714 F.2d 1144 (Fed. Cir. 1983) .....	6, 10, 17, 44, 49, 50
<i>Dippin’ Dots, Inc. v. Mosey</i> , 476 F.3d 1337 (Fed. Cir. 2007) .....	17, 45
<i>Dow Chem. Co. v. Nova Chems. Corp. (Canada)</i> , 809 F.3d 1223 (Fed. Cir. 2015) .....	21, 22
<i>FAA v. Cooper</i> , 566 U.S. 284 (2012).....	29
<i>Exxon Mobil Corp. v. Allapattah Servs., Inc.</i> , 545 U.S. 546 (2005).....	53
<i>Finnigan Corp. v. ITC</i> , 180 F.3d 1354 (Fed. Cir. 1999) .....	22
<i>Fresenius USA, Inc. v. Baxter Int’l, Inc.</i> , 582 F.3d 1288 (Fed. Cir. 2009) .....	22
<i>Group One Ltd. v. Hallmark Cards, Inc.</i> , 254 F.3d 1041 (Fed. Cir. 2018) .....	26

**TABLE OF AUTHORITIES (cont'd)**

<b>Cases (cont'd)</b>	<b>Page(s)</b>
<i>Hazani v. USITC</i> , 126 F.3d 1473 (Fed. Cir. 1997) .....	22
<i>Helsinn Healthcare S.A. v. Teva Pharms. USA, Inc.</i> , 139 S. Ct. 628 (2019).....	<i>passim</i>
<i>Helsinn Healthcare S.A. v. Teva Pharms. USA, Inc.</i> , 855 F.3d 1356 (Fed. Cir. 2017) .....	52, 53
<i>Innova-Pure Water, Inc. v. Safari Water Filtration Sys., Inc.</i> , 381 F.3d 1111 (Fed. Cir. 2004) .....	24
<i>InterDigital Commc'ns, LLC v. Int'l Trade Comm'n</i> , 707 F.3d 1295 (Fed. Cir. 2013) .....	20, 21
<i>In re Kollar</i> , 286 F.3d 1326 (Fed. Cir. 2002) .....	<i>passim</i>
<i>Jama v. Immig. &amp; Customs Enf't</i> , 543 U.S. 335 (2005).....	48
<i>Laerdal Med. Corp. v. ITC</i> , 910 F.3d 1207 (Fed. Cir. 2018) .....	15
<i>Metallizing Eng'g Co. v. Kenyon Bearing &amp; Auto Parts Co.</i> , 153 F.2d 516 (2d Cir. 1946) .....	5, 43, 46, 47, 49, 50
<i>Molzof v. United States</i> , 502 U.S. 301 (1992).....	29
<i>Morissette v. United States</i> , 342 U.S. 246 (1952).....	29
<i>NTP, Inc. v. Research In Motion, Ltd.</i> , 418 F.3d 1282 (Fed. Cir. 2005) .....	30
<i>Pennock v. Dialogue</i> , 27 U.S. 1 (1829).....	46, 47

**TABLE OF AUTHORITIES (cont'd)**

<b>Cases (cont'd)</b>	<b>Page(s)</b>
<i>Pfaff v. Wells Elecs., Inc.</i> , 525 U.S. 55 (1998).....	<i>passim</i>
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) ( <i>en banc</i> ) .....	13, 24
<i>Sage Prod., Inc. v. Devon Indus., Inc.</i> , 126 F.3d 1420 (Fed. Cir. 1997) .....	22
<i>Scaltech, Inc. v. Retec/Tetra, L.L.C.</i> , 269 F.3d 1321 (Fed. Cir. 2001) .....	6, 17
<i>Shapiro v. United States</i> , 335 U.S. 1 (1948).....	19
<i>State Street Bank &amp; Trust Co. v. Signature Fin. Grp. Inc.</i> , 149 F.3d 1368 (Fed. Cir. 1998) .....	39
<i>Stone Container Corp. v. United States</i> , 229 F.3d 1345 (Fed. Cir. 2000) .....	12
<i>W.L. Gore &amp; Assocs., Inc. v. Garlock, Inc.</i> , 721 F.2d 1540 (Fed. Cir. 1983) .....	6, 17, 44, 49, 50
<b>Statutes</b>	
19 U.S.C. § 1337 .....	1, 4, 11, 16, 20, 21
19 U.S.C. § 1337(a) .....	2, 20, 21
35 U.S.C. § 100(j) .....	13, 24
35 U.S.C. § 102(a) .....	<i>passim</i>
35 U.S.C. § 102(b) .....	5, 33, 34, 35
35 U.S.C. § 102(b) (2006) .....	<i>passim</i>
35 U.S.C. § 103 .....	28, 33

**TABLE OF AUTHORITIES (cont'd)**

<b>Statutes (cont'd)</b>	<b>Page(s)</b>
35 U.S.C. § 271 .....	29, 30, 31
35 U.S.C. § 271(a) .....	29, 30
35 U.S.C. § 271(a) (2006).....	30
35 U.S.C. § 271(g) .....	30
35 U.S.C. § 271(g) (2006) .....	30
35 U.S.C. § 273 .....	<i>passim</i>
35 U.S.C. § 273(a) .....	27
35 U.S.C. § 273(b) (2006) .....	28
35 U.S.C. § 273(g) .....	28, 37
35 U.S.C. § 282(b) .....	27, 37
35 U.S.C. § 321(b) .....	37
Leahy-Smith America Invents Act, Pub. L. 112-29, 125 Stat. 284 (2011) .....	4, 11, 40, 54
First Inventor Defense Act of 1999, Pub. L. 106-113, 113 Stat. 1501 (1999) .....	28
 <b>Legislative History Materials</b>	
157 Cong. Rec. S5402-02 (Sept. 8, 2011) .....	10
H.R. 2795 (June 8, 2005) .....	32
H.R. 1908 (Apr. 18, 2007) .....	32
H.R. Rep. No. 110-314 (2007).....	53
S. Rep. No. 110-259 (2007) .....	54



**TABLE OF AUTHORITIES (cont'd)**

<b>Treatises &amp; Other Authorities</b>	<b>Page(s)</b>
Robert A. Matthews, <u>Annotated Patent Digest</u> Vol. 3 (2023) .....	17, 45
Donald S. Chisum, <u>Chisum on Patents</u> , vol. 2A § 6.02[5][b] (2022) .....	17, 45
Donald S. Chisum, <u>Chisum on Patents</u> , vol. 5 § 16.03[4][a] (2022) .....	28, 39
F. Scott Kieff, Pauline Newman, Herbert F. Schwartz, Henry E. Smith, <u>Principles of Patent Law</u> (4th ed. 2008).....	17, 18, 45
USPTO’s Manual of Patent Examining Procedure, 8 <sup>th</sup> Ed., Rev. 8 (Jul. 2010).....	45
USPTO’s Manual of Patent Examining Procedure 9 <sup>th</sup> Ed., Rev. 10.2019 (June 2020).....	11, 18, 55, 56

## **STATEMENT OF RELATED CASES**

The Commission is unaware of any related case other than the district court actions recited in the opening brief of Appellants Celanese International Corporation, Celanese (Malta) Company 2 Limited, and Celanese Sales U.S. Ltd. (collectively, “Celanese”).

## **STATEMENT OF THE ISSUE**

Whether the Commission correctly determined that Celanese's manufacture and sale of high potency sweetener made with its patented process placed that process "on sale" within the meaning of the 35 U.S.C. § 102(a)(1).

## **STATEMENT OF THE CASE**

To present an accurate description of the proceedings below and of the pre- and post-AIA on-sale bar, the Commission provides its own statement of the case.

### **I. The Proceedings Below**

The Commission instituted the investigation below on May 14, 2021, based on a complaint filed by Celanese. Appx5060-5061. Celanese alleged violations of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, in the importation into the United States, the sale for importation, or the sale within the United States after importation of high-potency sweeteners, processes for making same, and products containing the same that infringed certain claims of U.S. Patent Nos. 10,023,546 ("the '546 patent"), 10,208,004 ("the '004 patent"), 10,590,098 ("the '098 patent"), 10,233,163 ("the '163 patent"), and 10,590,095 ("the '095 patent"). Appx5060. Celanese further alleged that a domestic industry exists relating to articles protected by each of those patents. Appx5060. During the course of the investigation below, Celanese withdrew its allegations as to a number of originally asserted claims, including all of the claims asserted from the '098 and '163 patents. Only the '546, '004, and '095 patents are at issue in this appeal.

The Commission identified twenty-one respondents in the investigation below, including the intervenors in this appeal, Anhui Jinhe Industrial Co. and Jinhe USA LLC (collectively, “Jinhe”). The Commission’s Office of Unfair Import Investigations (“OUII”) also participated in the investigation. The Commission found in default, or terminated by consent order, all but five of the twenty-one respondents. Jinhe was among the five remaining respondents.

On September 2, 2021, Jinhe moved for summary determination of no violation of section 337. Among other things, Jinhe’s motion alleged that Celanese could not satisfy the domestic industry requirement of section 337. *See* 19 U.S.C. § 1337(a)(2)-(3). To satisfy section 337’s domestic industry requirement in a patent-based investigation, a complainant must show the existence of articles protected by the asserted patents. *Id.* § 1337(a)(2). Per Jinhe, Celanese could not make that showing because the claims on which it relied to demonstrate the existence of protected articles were invalid under the on-sale bar of 35 U.S.C. § 102(a)(1). On September 13, 2021, Celanese filed a brief opposing Jinhe’s motion. OUII filed a brief in support of Jinhe’s motion on the same day. The Commission’s Chief Administrative Law Judge (“CALJ”), who presided over the investigation below, held oral argument on the motion on September 28, 2021.

On January 11, 2022, the CALJ issued his initial determination granting Jinhe’s motion. Appx5-18. The CALJ found that the claims on which Celanese

relied to show the existence of protected articles were invalid pursuant to the on-sale bar of § 102(a)(1) and therefore that Celanese could not establish a violation of section 337. Appx17-18. Celanese timely petitioned the Commission to review the CALJ's initial determination. Jinhe and OUII subsequently submitted timely oppositions to Celanese's petition. On April 1, 2022, the Commission determined not to review the initial determination, which therefore became the agency's final determination in this investigation. Appx1-2. This appeal arises from that final determination, and particularly from the invalidity finding therein.

## **II. The Patents and Technology at Issue**

The '546 patent, Appx363-381, '004 patent, Appx383-401, and '095 patent, Appx446-467, (collectively, the "asserted patents") are drawn to processes for making acesulfame potassium ("Ace-K")—a type of high-potency artificial sweetener used in beverages, dairy products, and dental floss (to name a few). *See, e.g.*, Appx364 (abstract). The claimed processes produce Ace-K with reduced impurities. *See* Appx364 (abstract). All three asserted patents share the same effective filing date of September 21, 2016. Appx364; Appx384; Appx447. At the time the Commission issued its determination terminating the investigation, the following claims remained at issue in the investigation:

- '546 Patent Claims: 11, 15, **27**
- '004 Patent Claims: 7, 11, **28**, 33
- '095 Patent Claims: **1, 19, 34**.

*See* Appx6. Celanese contended below that it satisfied the domestic industry requirement of section 337 because it sold Ace-K in the United States that it produced using a process that practiced each of the boldfaced claims above. There is no dispute that Celanese's Ace-K-producing process practices every limitation of each of the boldfaced claims.

### **III. The On-Sale Bar**

This appeal turns on the scope of the on-sale bar to patentability. The current iteration of the on-sale bar is codified at 35 U.S.C. § 102(a)(1), which provides:

(a) Novelty; Prior Art.—A person shall be entitled to a patent unless—

(1) 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). This iteration of the on-sale bar was enacted via the Leahy-Smith America Invents Act (“AIA”), and there is no dispute that it controls in this appeal. The immediate predecessor to the on-sale bar of § 102(a)(1) appeared in pre-AIA § 102(b), which provided:

A person shall be entitled to a patent unless —

\* \* \*

(b) the invention 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 prior to the date of the application for patent in the United States.

35 U.S.C. § 102(b) (2006) (hereinafter “pre-AIA § 102(b)”) (emphasis added).

Thus, with the enactment of the AIA, Congress reorganized § 102, placing a grace period in new § 102(b) and eliminating the geographic limitation that disqualifying sales must occur “in the United States.”

Interpreting pre-AIA § 102(b), the Supreme Court explained that the on-sale bar applies when (1) the invention is the subject of a commercial offer for sale, and (2) the invention is ready for patenting. *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 67 (1998). Elaborating, the Court explained that:

“[I]t 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.”

*Id.* at 68 (quoting *Metallizing Eng’g Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F.2d 516, 520 (2d Cir. 1946)).

In applying the holding of *Pfaff* to an inventive process, as opposed to an apparatus, this Court recognized that “[a] process is ... not sold in the same sense as is a tangible item.” *In re Kollar*, 286 F.3d 1326, 1332 (Fed. Cir. 2002). The

sale of “[k]now-how’ describing what the process consists of and how the process should be carried out” and “the freedom to carry it out pursuant to the terms of the transaction ... is not a ‘sale’ of the invention within the meaning of § 102(b).” *Id.* Neither is the sale of “a license to a patent covering a process.” *Id.* Nonetheless, an inventive process can be “on sale” within the meaning of pre-AIA § 102(b). “[A] sale by the patentee or a licensee of the patent of a product made by the claimed process would constitute such a sale.” *Id.* at 1333 (citing *D.L. Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 1147-48 (Fed. Cir. 1983); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983)). So too would “performing the process itself for consideration.” *Id.* (citing *Scaltech, Inc. v. Retec/Tetra, L.L.C.*, 269 F.3d 1321, 1328 (Fed. Cir. 2001)). This Court recently reaffirmed *Kollar*’s understanding of when a process is “on sale” under pre-AIA § 102(b) in *BASF Corporation v. SNF Holding Company*. *See* 955 F.3d 958, 969-70 (Fed. Cir. 2020).

The Supreme Court interpreted the post-AIA on-sale bar of § 102(a)(1) in *Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.*, 139 S. Ct. 628 (2019). There, the issue was “whether the sale of an invention to a third party who is contractually obligated to keep the invention confidential places the invention ‘on sale’ within the meaning of § 102(a).” *Id.* at 630. Put more simply, did the AIA make public disclosure a third required element of the on-sale bar? *See id.*



*Helsinn* answered that the AIA did not, and that the two requirements of *Pfaff* continued to control when an invention is “on sale.” *Id.* The Supreme Court reached that decision through application of the reenactment canon of statutory interpretation. *Id.* at 633-34. Because the phrase “on sale” as used in pre-AIA § 102(b) had acquired a well-settled meaning, and because that well-settled meaning encompassed sales that did not disclose the details of the invention, the Court concluded that, “when Congress reenacted the same language in the AIA, it adopted the earlier judicial construction of that phrase.” *Id.* More succinctly, *Helsinn* held that “Congress did not alter the meaning of ‘on sale’ when it enacted the AIA.” *Id.* at 634. Celanese does not contend that *Helsinn* was wrongly decided, and the Commission is aware of no precedents abrogating *Helsinn*’s holding.

#### **IV. The Commission’s Findings and Determination**

In its final determination, the Commission found that claims 11 and 27 of the ’546 patent, claims 7, 28, and 33 of the ’004 patent, and claims 1, 19, and 34 of the ’095 patent are invalid pursuant to the on-sale bar of § 102(a)(1). Appx17. In support of that finding, the Commission found, based on undisputed facts, that “Celanese’s process to make Ace-K claimed in the Asserted Patents has been in secret use in Europe since before the undisputed critical date, which is September 21, 2015.” Appx9. The Commission also found that the “Ace-K product made

using Celanese's process has been exported and sold in the United States since before September 21, 2015," and that "Celanese's method of making Ace-K has not changed in any material way since 2011." Appx9. Celanese disputes none of those findings on appeal.

The critical dispute before the Commission below was whether Celanese's sale of Ace-K made with the process covered by its patents, more than a year before the effective filing date of those patents, rendered the claims to those processes invalid pursuant to the on-sale bar of § 102(a)(1). The Commission found that it did. In so finding, the Commission noted that, prior to the enactment of the AIA, "it was well settled that a patentee's sale of an unpatented product made according to a secret method triggered the on-sale bar to patentability," and therefore "Celanese's pre-2015 U.S. sales of Ace-K made according to its secret method, which it later claimed in the Asserted Patents, would have triggered the pre-AIA on-sale bar." Appx9. However, because Celanese contended that the AIA removed such sales from the scope of the on-sale bar, the Commission acknowledged that Jinhe's motion turned "on whether the AIA changed the meaning of the on-sale bar provision such that Celanese's pre-2015 sales of Ace-K do not invalidate the Asserted Patents." Appx9. The Commission found that the AIA did not change the meaning of the on-sale bar as relevant here. Appx17.

The Commission based its determination on the Supreme Court’s holding and analysis in *Helsinn*. Appx10-12. The Commission acknowledged that *Helsinn* did not address the exact facts of this investigation—the claims at issue in *Helsinn* were drawn to apparatuses, not processes. Appx12. Nonetheless, the Commission concluded that *Helsinn*’s holding left no room to reach a different outcome under the facts of this investigation. Appx12. The Commission found that it was well settled that Celanese’s sale of Ace-K made with its patented process would trigger the on-sale bar as to that process under pre-AIA § 102(b) because “a patentee’s sale of a product made by a later-patented process is considered a sale of the invention.” Appx8. Applying *Helsinn*’s holding that the AIA did not alter the well-settled meaning of “on sale,” the Commission found that “Congress’s enactment of the AIA did not overturn long-established precedent holding that a patentee’s sale of an unpatented product made according to a secret method triggers the on-sale bar to patentability under § 102.” Appx12.

The Commission’s determination also addressed each of Celanese’s counterarguments. It rejected Celanese’s contention that the addition of the word “claimed” before “invention” in § 102(a)(1) evinced Congressional intent to alter the meaning of “on sale” as it applies to inventive processes. Appx12-13. The Commission explained that the addition of the word “claimed” could not have worked such a change because pre-AIA case law applying the on-sale bar to

process inventions already recognized “that the product of a claimed method was distinct from the steps of a method invention.” Appx12-13. However, the case law “also recognized that a product could embody commercialization of a method invention sufficiently to trigger the on-sale bar.” Appx13 (citing *D.L. Auld*, 714 F.2d at 1148).

The Commission likewise rejected Celanese’s contention that the AIA’s elimination of pre-AIA § 102(g)’s first inventor provisions evinced Congressional intent “to treat the secret use of processes that result in commercialized products by patentees and third parties the same.” Appx13 (quoting Appx11189). Rather, as the Commission explained, “the change to § 102(g) was driven by the congressional preference to convert the U.S. patent system to a ‘first-inventor-to-file’ system.” Appx14 (citing 157 Cong. Rec. S5402-02, 2011 WL 3962364 (daily ed. Sept. 8, 2011)). The Commission also rejected Celanese’s assertion that the AIA’s expansion of prior use rights under § 273 likewise “demonstrates that the secret use of a process by a patentee no longer creates a statutory bar under the AIA version of § 102.” Appx14. While Celanese claimed that § 273’s prior use rights would be rendered a nullity if the on-sale bar retained its pre-AIA scope, the Commission explained that Celanese had conflated infringement and invalidity and noted that “[a] patentee may very well retain a valid patent even after successful invocation of the § 273 prior use defense by an accused infringer.” Appx15.

Finally, the Commission rejected Celanese's appeal to the legislative history of the AIA to work a change in the scope of the on-sale bar. Appx15-17. As the Commission explained, the legislative history was entirely consistent with the conclusion that Congress did not intend to alter the scope of the on-sale bar, particularly given that the Act attained passage only after the words "on sale," which had been omitted from an early precursor bill, were re-added to § 102. Appx15-16. The Commission noted that its interpretation of the legislative history was also consistent with guidance given to patent examiners in the USPTO's Manual of Patent Examining Procedure. Appx16-17 (quoting Manual of Patent Examining Procedure, 9<sup>th</sup> Ed., Rev. 10.2019, § 2152.02(d) (June 2020) (hereinafter, "MPEP")).

Having dispensed with Celanese's arguments, the Commission found claims 11 and 27 of the '546 patent, claims 7, 28, and 33 of the '004 patent, and claims 1, 19, and 34 of the '095 patent invalid pursuant to the on-sale bar of § 102(a)(1). Appx17. Because that finding encompassed all of the claims on which Celanese relied to establish a domestic industry, the Commission found that Celanese could not establish a violation of section 337 and terminated the investigation. Appx18.

## SUMMARY OF THE ARGUMENT

This appeal involves only the unremarkable application of controlling law. As Celanese readily concedes, it sold Ace-K that it manufactured with a process that is claimed in the asserted patents more than a year before the effective filing date of those patents. Because an inventive process is “on sale” for purposes of the on-sale bar when its inventor commercializes the process by selling products made therewith, Celanese’s claims to its Ace-K-producing process are invalid pursuant to the on-sale bar of § 102(a)(1). There was no error in the Commission’s application of settled law concerning when a process invention is “on sale” to the undisputed facts developed in the investigation below to reach that conclusion.

Celanese’s sole argument on appeal is that, when Congress enacted the AIA and reorganized § 102, it up-ended decades of law concerning when a process is “on sale.” That argument cannot stand in the face of the Supreme Court’s decision in *Helsinn*, wherein the Court expressly held that “Congress did not alter the meaning of ‘on sale’ when it enacted the AIA.” 139 S. Ct. at 634. Neither the Commission below, nor this Court now, can abrogate that clear holding from the Supreme Court. *See Stone Container Corp. v. United States*, 229 F.3d 1345, 1349-50 (Fed. Cir. 2000). This Court’s analysis need go no further to affirm the Commission’s determination.

Notwithstanding the clear guidance of *Helsinn*, in tandem with decades of precedents from this Court holding that an inventor’s sale of a product made by a patented process places the process “on sale,” Celanese asserts that the AIA narrowed the scope of the on-sale bar such that an inventor’s sale of a product made with a patented process no longer places the process “on sale.” Its arguments in support of that assertion fall broadly into two groups. First, Celanese argues that the addition of the word “claimed” before “invention” in § 102(a)(1) narrowed the scope of the on-sale bar as applied to process inventions. That argument fails because there is no difference in scope between the “invention” recited in pre-AIA § 102(b) and the “claimed invention” recited in current § 102(a)(1). It was well-established in pre-AIA case law that “invention” already meant the subject matter defined by the claims of a patent, just as “claimed invention” means now.

*Compare Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (*en banc*) with 35 U.S.C. § 100(j). Second, Celanese argues that the AIA made disclosure of an invention a prerequisite to placing that invention “on sale” and, therefore, that the sale of a product that does not disclose the details of the inventive process with which it was made does not place the process “on sale.” This argument fails because its predicate—that all sales that trigger the on-sale bar must effect a disclosure of the invention—is foreclosed by *Helsinn*. See 139 S. Ct. at 630.

Celanese's principal brief leads with the observation that it is raising a novel question of law inasmuch as no patentee before it has argued that the AIA overturned decades of settled law concerning when a process is "on sale." Celanese Br. at 1. That may be true, but it does not mean that the question is difficult or complex. Whether the AIA changed the meaning of "on sale" was decided in *Helsinn*. The reasoning therein and the holding reached leave no room for a different conclusion as to patented processes in this appeal. As such, this Court should affirm the Commission's final determination.



## ARGUMENT

### I. Standard of Review

The only issue presented in this appeal is the scope of the on-sale bar of 35 U.S.C. § 102(a)(1), which is a legal issue that is reviewed *de novo*. *Laerdal Med. Corp. v. ITC*, 910 F.3d 1207, 1211 (Fed. Cir. 2018).

### II. The Commission's Determination of No Violation Is a Correct and Unremarkable Application of Controlling Precedents to Undisputed Facts.

The Commission's determination—that the claims upon which Celanese relies to satisfy the domestic industry requirement are invalid under the on-sale bar of § 102(a)(1) and that Celanese therefore cannot establish a violation of section 337—is an unremarkable application of controlling precedents from this Court and the Supreme Court to undisputed facts. First, it was well settled prior to the AIA's enactment that an inventor's sale of a product made with the patented process would place that process "on sale" within the meaning of pre-AIA § 102(b). *See, e.g., Kollar*, 286 F.3d at 1333. Second, the Supreme Court unequivocally held that "Congress did not alter the meaning of 'on sale' when it enacted the AIA." *Helsinn*, 139 S. Ct. at 634. Third, there is no dispute that Celanese sold Ace-K made with its patented processes more than a year before the effective filing date of the asserted patents. Appx9-10 (citing Appx11210-11213; Appx10539-10590; Appx10665-10706). Accordingly, Celanese's sale of its Ace-K placed its patented processes "on-sale" within the meaning of § 102(a)(1), and the claims thereto are

invalid. Because an invalid claim cannot support the existence of a domestic industry, and all the claims on which Celanese based its domestic industry case are invalid, Celanese could not satisfy the domestic industry requirement of section 337 nor establish a violation thereunder.

**A. It is Well Settled That an Inventor’s Sale of a Product Made by a Patented Process Places That Process “On Sale” Within the Meaning of Pre-AIA § 102(b).**

Prior to the enactment of the AIA, 35 U.S.C. § 102(b) provided:

A person shall be entitled to a patent unless —

\* \* \*

(b) the invention 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 prior to the date of the application for patent in the United States.

Pre-AIA § 102(b) (emphasis added). Under this provision, “[a]n invention is ‘on sale’ under § 102(b) when it is ‘the subject of a commercial offer for sale,’ and is ready for patenting.” *BASF Corp.*, 955 F.3d at 969 (quoting *Pfaff*, 525 U.S. at 67).

Pre-AIA § 102(b) is agnostic as to the class of inventions to which it applies. A commercial offer for sale of an inventive process will trigger the on-sale bar just as will a commercial offer for sale of an inventive apparatus. *Id.* (“[A] process may be sold in a manner which triggers the on-sale bar.”). While the sale of an apparatus occurs by “the passing of title from the seller to the buyer for a price,”

*id.* (quoting U.C.C. § 2-106(1)), the sale of a process may occur by the inventor’s “perform[ance of] the process itself for consideration,” or by the inventor’s “sale of a product made by his later-patented process.” *Id.* (citing *Scaltech*, 269 F.3d at 1328-29; *D.L. Auld*, 714 F.2d at 1147-48); *accord Kollar*, 286 F.3d at 1333. That an inventor’s sale of a product made by a later-patented process will trigger the on-sale bar of pre-AIA § 102(b) has been a settled, and controlling, principle of law since nearly the inception of this Court’s exclusive jurisdiction over patent appeals. *See D.L. Auld*, 714 F.2d at 1147-48; *W.L. Gore*, 721 F.2d at 1550; *In re Caveney*, 761 F.2d 671, 675 (Fed. Cir. 1985); *Dippin’ Dots, Inc. v. Mosey*, 476 F.3d 1337, 1344 (Fed. Cir. 2007); *Kollar*, 286 F.3d at 1333; *BASF*, 955 F.3d at 969; *accord* 2A Donald S. Chisum, Chisum on Patents § 6.02[5][b] (2022) (“[I]t is now well established that commercial exploitation by the inventor of a machine or process constitutes a public use even though the machine or process is held secret.”); 3 Robert A. Matthews, Annotated Patent Digest § 17:111 (2023) (“Where the patentee places a product made by the patented process on the market before the critical date, the on-sale bar generally applies to invalidate the claims, even if the patentee keeps the process secret and the details of the process cannot be gleaned from the product.”); F. Scott Kieff, Pauline Newman, Herbert F. Schwartz & Henry E. Smith, Principles of Patent Law, Ch. 4, 370 (4th ed. 2008) (“[T]he sale of a product made by the process or performing the process itself for consideration

[will] trigger the on-sale bar.”) (hereinafter “Principles of Patent Law”); MPEP 9<sup>th</sup> Ed., Rev. 10.2019, § 2133.03(c)(III) (June 2020) (“[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 pre-AIA 35 U.S.C. 102(b).”). The Commission is aware of no precedent to the contrary.

**B. By Retaining the Words “On Sale,” Without Alteration, in the Post-AIA On-Sale Bar, Congress Did Not Alter the Well-Settled Understanding of When an Inventive Process Is “On Sale.”**

The AIA reorganized section 102, including folding the pre-AIA § 102(b) on-sale bar into the current § 102(a), which provides:

(a) Novelty; Prior Art.—A person shall be entitled to a patent unless—

(1) 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). Interpreting current § 102(a), and the on-sale bar therein specifically, the Supreme Court in *Helsinn* “determine[d] that Congress did not alter the meaning of ‘on sale’ when it enacted the AIA.”

139 S. Ct. at 634. The Court explained that, because “on sale” had a settled meaning in precedent interpreting pre-AIA § 102(b), and because “[t]he new § 102 retained the exact language used in its predecessor statute (‘on sale’),” it must “presume that when Congress reenacted the same language in the AIA, it

adopted the earlier judicial construction of that phrase.” *Helsinn*, 139 S. Ct. at 634 (citing *Shapiro v. United States*, 335 U.S. 1, 16 (1948)).

While the invention in *Helsinn* was an apparatus rather than a process, the Supreme Court’s analysis and holding in that case leave no room to conclude that Congress changed the meaning of “on sale” for some inventions but not for others. The Court unequivocally held that Congress did not change the meaning of “on sale” when it enacted the AIA, and it reached that conclusion because the phrase had acquired a settled meaning prior to Congress’s choice to reenact the same phrase in on-sale bar of the AIA. Because the meaning of “on sale” in pre-AIA § 102(b) was settled as to process inventions—an inventor’s sale of a product made with a patented process places the process “on sale”—*Helsinn* dictates that Congress likewise did not disturb the settled understanding of when a process is “on sale” for purposes of the on-sale bar.

**C. There Is No Dispute That Celanese Sold Products That It Made with Its Patented Processes More Than One Year Before the Effective Filing Date for Those Processes.**

Now, as in the proceedings below, there is no dispute that Celanese sold in the United States Ace-K sweetener made with the processes claimed in the asserted patents more than one year before the asserted patents’ effective filing date of September 21, 2016. Appx7; Appx9-10. Specifically, the Commission found, and Celanese does not dispute that, “[t]he Ace-K product made using Celanese’s

process has been exported and sold in the United States since before September 21, 2015,” and that “Celanese’s method of making Ace-K has not changed in any material way since 2011.” Appx9. The Commission also found that:

Celanese’s process to make Ace-K practices (at least) the following asserted claims:

- ’546 patent: claims 11 and 27;
- ’004 patent: claims 7, 28, and 33;
- ’095 patent: claims 1, 19, and 34.

Appx9-10. Because Celanese sold Ace-K that it made with a process that practices claims 11 and 27 of the ’546 patent, claims 7, 28, and 33 of the ’004 patent, and claims 1, 19, and 34 of the ’095 patent, those claims are invalid pursuant to the on-sale provision of § 102(a)(1).<sup>1</sup> Appx17.

**D. Because All of the Claims on Which Celanese Relies to Establish a Domestic Industry Are Invalid, It Cannot Demonstrate a Section 337 Violation.**

In order to establish a violation of section 337, Celanese was required to demonstrate that a domestic industry relating to the articles protected by its patents exists or is in the process of being established. 19 U.S.C. § 1337(a)(2). To so demonstrate, Celanese was required, among other things, to establish the existence of articles protected by its patents. *Id.*; see also *InterDigital Commc’ns, LLC v.*

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<sup>1</sup> Current § 102(b) provides various exceptions to the patentability criteria of § 102(a); however, Celanese does not contend that any of those exceptions apply here.

*Int'l Trade Comm'n*, 707 F.3d 1295, 1297 (Fed. Cir. 2013). Celanese attempted to make that showing by pointing to the Ace-K it made with its patented process. *See* Appx10539-10590; Appx10665-10706. However, every claim that Celanese relied on to establish a domestic industry is invalid pursuant to the on-sale bar of § 102(a)(1). As neither Celanese's Ace-K, nor its Ace-K-producing process, can be "protected" by invalid patent claims, Celanese could not demonstrate that a domestic industry relating to articles protected by its patents exists or is in the process of being established. *See* 19 U.S.C. § 1337(a)(2). That is fatal in a patent-based section 337 investigation. *Id.* The Commission thus concluded that Celanese failed to establish a violation of section 337 and terminated the investigation. Appx17-18. The Commission's determination is based on an unremarkable application of settled law to undisputed facts and should be affirmed as such. Celanese's scattershot arguments on appeal do not demonstrate otherwise.

### **III. Celanese Fails to Show Error in the Commission's Determination.**

Celanese's principal brief deploys a panoply of arguments in an apparent attempt to make this case far more complicated than it is. But this is not a complicated or difficult case. The Supreme Court has held that "Congress did not alter the meaning of 'on sale' when it enacted the AIA." *Helsinn*, 139 S. Ct. at 634. Each and every one of Celanese's arguments would require this Court to overrule that holding, which, like the Commission, it cannot do. *See Dow Chem.*

*Co. v. Nova Chems. Corp. (Canada)*, 809 F.3d 1223, 1227 (Fed. Cir. 2015).

Celanese's arguments on appeal can be readily dismissed for that reason alone.

Moreover, Celanese's arguments suffer from numerous additional flaws, each of which is addressed in turn *infra*.

**A. Celanese's Interpretation of the On-Sale Bar of § 102(a)(1) Lacks Support in the Text, Structure, and Purpose of the AIA.**

Celanese contends that the on-sale bar of § 102(a)(1) is not triggered by the sale of a product made with a secret inventive process. It looks for support for that contention in the text of the AIA, the structure of the AIA, and the policies behind the AIA. None of those sources, however, support Celanese's contention that Congress altered the decades-old understanding that an inventor's sale of a product made with a patented process places the process "on sale" for purposes of the on-sale bar.

**1. *The Text of the AIA Does Not Support Celanese's Interpretations of § 102(a)(1).***

Celanese deploys a variety of text-based arguments, many never presented to the Commission below,<sup>2</sup> in support of its assertion that the AIA narrowed the

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<sup>2</sup> Arguments not presented to the presiding ALJ in Commission proceedings are deemed waived. *See Hazani v. USITC*, 126 F.3d 1473, 1476-77 (Fed. Cir. 1997). Assertions of error in an ALJ's initial determination that are not preserved in a petition for review before the Commission are also waived. *Finnigan Corp. v. ITC*, 180 F.3d 1354, 1362 (Fed. Cir. 1999). Arguments raised for the first time on appeal are also waived. *Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 582 F.3d 1288, 1296 (Fed. Cir. 2009); *Sage Prod., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1426



meaning of “on-sale” as it applies to method claims. Individually and collectively, these arguments serve only to demonstrate that Celanese misapprehends the on-sale bar, both pre- and post-AIA, as it applies to process claims.

*(a) § 102(a)(1)’s “Claimed Invention”*

Celanese’s headlining argument is that, because the current on-sale bar of § 102(a)(1) is directed to a “claimed invention,” while the pre-AIA on-sale bar was directed to an “invention,” a claimed process is no longer “on sale” when a product made with the process is offered for sale by the process’s inventor. Celanese Br. at 17-18. That contention fails for two reasons. First, it incorrectly presumes that an inventor’s sale of a product of a claimed process triggered the on-sale bar of pre-AIA § 102(b) because of the breadth of the term “invention.” As this Court has explained, an inventor’s sale of a product made with a claimed process places the process “on sale” because the inventor “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. Thus, it is the commercialization of the process, not the breadth of the term “invention,” that causes an inventor’s sale of a product made by a patented process to place the process “on sale.”

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(Fed. Cir. 1997). Each of Celanese’s waived arguments is specifically identified *infra*.

Second, there is no support for Celanese’s suggestion that “invention” and “claimed invention” differ in meaning or scope. As Celanese acknowledges, the AIA defines “claimed invention” to mean “the subject matter defined by a claim in a patent or an application for a patent.” 35 U.S.C. § 100(j). But that is no different from the well-settled meaning of “invention” as that term is used in American patent law, including in pre-AIA § 102(b). As this Court explained in *Phillips*:

It is a “bedrock principle” of patent law that “*the claims of a patent define the invention to which the patentee is entitled the right to exclude.*” That principle has been recognized since at least 1836, when Congress first required that the specification include a portion in which the inventor “shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery.”

415 F.3d at 1312 (emphasis added) (quoting *Innova-Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004)). Thus, Celanese’s focus on the addition of the word “claimed” before “invention” in § 102(a)(1) is a distinction without a difference. Such a meaningless distinction is not indicative of Congressional intent to jettison a decades-long understanding of what constitutes the sale of a claimed process.

Celanese attempts to demonstrate its “claimed invention” argument by rewriting § 102(a)(1) with the statutory definition of “claimed invention” and the settled judicial definition of “on sale” substituted in place of those terms, *e.g.*:

[a] person shall be entitled to a patent unless [the subject matter defined by a claim in a patent or an application for a patent] was . . . [the subject of a commercial offer for sale and ready for patenting] . . . before the effective filing date of the claimed invention.

Celanese Br. at 17 (bracketed material by Celanese); *see also* § 102(a)(1). But there is nothing inconsistent between § 102(a)(1) so re-written and the settled principle that a process is offered for sale when a product made with the process is put on sale. The central issue, again, is what constitutes a sale, or offer for sale, of “the subject matter defined by a claim in a patent or an application for a patent,” when that subject matter is a process. That issue has been settled for decades and nothing in the text of § 102(a)(1) indicates that Congress intended to disturb that precedent. *See supra* Argument §§ II.A-B.

Celanese overlooks the significant effect of its interpretation of § 102(a)(1) as well. Under Celanese’s interpretation of § 102(a)(1), it is unclear if the on-sale bar could ever apply to a process claim. Indeed, though it strongly contends that a process is not offered for sale when its inventor sells a product made by the process, Celanese is conveniently silent on what *would* constitute the sale of a patented process. Its arguments on appeal suggest that Celanese is laboring under the assumption that an apparatus and a process can be sold in the same way, *i.e.*, through transfer of title for consideration. But, as this Court explained in *Kollar*

when the Board of Patent Appeals and Interferences indulged the same assumption:

The Board ... erred in failing to recognize the distinction between a claim to a product, device, or apparatus, all of which are tangible items, and a claim to a process, which consists of a series of acts or steps. A tangible item is on sale when, as we held in *Group One [ Ltd. v. Hallmark Cards, Inc.]*, the transaction “rises to the level of a commercial offer for sale” under the Uniform Commercial Code. 254 F.3d [1041,] 1047, 59 USPQ2d [1121,] 1126 [(Fed. Cir. 2018)]. When money changes hands as a result of the transfer of title to the tangible item, a sale normally has occurred. A process, however, is a different kind of invention; it consists of acts, rather than a tangible item. It consists of doing something, and therefore has to be carried out or performed.

A process is thus not sold in the same sense as is a tangible item.

*Kollar*, 286 F.3d at 1332. Celanese’s failure to recognize that the sale of a process is fundamentally different than the sale of an apparatus leads to an interpretation of § 102(a)(1) that inexplicably renders the on-sale bar a nullity as to process claims. If the addition of the phrase “otherwise available to the public” in § 102(a)(1) was too “oblique” to overturn the settled understanding that secret sales of an invention will trigger the on-sale bar, *see Helsinn*, 139 S. Ct. at 633-34, the addition of the word “claimed” to § 102(a)(1) as a vehicle to remove inventive processes from the reach of the on-sale bar altogether is even more so.

*(b) § 273's "Useful End Result"*

Failing to find support for its anomalous interpretation of the on-sale bar in § 102(a)(1), Celanese looks for support in other sections of the AIA unrelated to patentability. For example, Celanese claims support from the following language of § 273:

(a) In General.—A person shall be entitled to a defense under section 282(b) with respect to subject matter consisting of a process, or consisting of a machine, manufacture, or composition of matter used in a manufacturing or other commercial process, that would otherwise infringe a claimed invention being asserted against the person if—

(1) such person, acting in good faith, commercially used the subject matter in the United States, either in connection with an internal commercial use or an actual arm's length sale or other arm's length commercial transfer of *a useful end result of such commercial use*....

35 U.S.C. § 273(a)-(a)(1) (emphasis added). Celanese contends that this provision “shows that the Congress that enacted the AIA knew how to refer to sales of the *product* of a claimed invention when it wanted to do so.” Celanese Br. at 18.

As an initial matter, Celanese failed to raise this argument before the CALJ below, and thus waived it. *See supra* note 2. Moreover, § 273 is an infringement provision, not a validity provision, and Celanese is simply wrong that the “useful end result” language of § 273 is a product of the AIA. The “useful end result” language was originally enacted into § 273 by a different Congress more than a

decade before the AIA via the First Inventor Defense Act of 1999. *See* Pub. L. 106-113, § 4301-4302, 113 Stat. 1501 (1999). There, the prior-use defense of § 273 was limited to allegations of infringement of a business method. *Id.* at § 4302. By including the “useful end result” language, the First Inventor Defense Act made clear that, while limited to method claims for “doing or conducting business,” the fact that a business method claim might result in the creation of a product would not take the method outside the scope of § 273. *See* 5 Chisum on Patents § 16.03[4][a] (“A broad interpretation of ‘conducting’ business is supported by provisions in Section 273 that refer to covered methods resulting in the ‘sale or other disposition of a useful end product.’ These provisions suggest that the defined methods can include processes creating products.”).

There is no indication that Congress also intended to upset the settled meaning of when a process is “on sale” within the meaning of pre-AIA § 102(b) by the inclusion of the “useful end result” in § 273. On the contrary, by its own terms, § 273, then and now, expressly forecloses tying the scope of the on-sale bar to the scope of prior-use rights under § 273. *See* 35 U.S.C. § 273(g) (“A patent shall not be deemed to be invalid under section 102 or 103 solely because a defense is raised or established under this section.”); *accord* 35 U.S.C. § 273(b)(9) (2006).

Moreover, the fact that this Court’s decisions in *Kollar* and *BASF* post-dated the 1999 enactment of § 273 demonstrates that the “useful end result” language did not

alter what it means for a process to be on sale within the meaning of pre-AIA § 102(b). With the AIA, Congress carried over the same “useful end result” language that existed harmoniously with the settled understanding of when a process is on sale, while also expanding the availability of the prior-use defense beyond business method claims. There is no indication that, by reenacting the same “useful end result” language from pre-AIA § 273, Congress intended to narrow the settled understanding of when a process is “on sale.” *See FAA v. Cooper*, 566 U.S. 284, 292 (2012) (“[I]t is a ‘cardinal rule of statutory construction’ that, when Congress employs a term of art, ‘it presumably knows and adopts the cluster of ideas that were attached to each borrowed word in the body of learning from which it was taken.’”) (quoting *Molzof v. United States*, 502 U.S. 301, 307 (1992); *Morissette v. United States*, 342 U.S. 246, 263 (1952)).

*(c) § 271’s “Offers to Sell”*

Celanese advances a similar argument based on § 271(a), but it fares no better. Specifically, Celanese contends that, while § 271(a) applies infringement liability to one who “offers to sell, or sells any patented invention,” the sale of a product made by a patented process is not direct infringement under § 271(a). *Celanese Br.* at 19. Infringement liability will lie instead under § 271(g), which proscribes sales and offers for sale of products made by a patented process. *Id.* at 20. Celanese contends that these subsections of § 271 demonstrate that “Congress

has long understood how to refer to sales of the products of claimed processes,” and that the AIA’s failure to use the same language in § 102(a) must indicate that Congress must have intended to alter the meaning of “on sale” as it applies there. *Id.* That argument fails for two reasons.

First, as with § 273, the language of § 271 on which Celanese focuses is not a product of the AIA. The language pre-dates the AIA and has long coexisted harmoniously with the settled principle that an inventor’s sale of a product made by the inventive process will place the process “on sale” within the meaning of pre-AIA § 102(b). *See, e.g.*, 35 U.S.C. § 271(a), (g) (2006) (pre-AIA). Celanese fails to explain why the AIA’s reenactment of language in sections 271(a) and (g) compels “on sale” to take on a different meaning in § 102(a)(1) than it did in pre-AIA § 102(b). Second, Celanese’s argument implicitly asks the Court to substitute precedent interpreting the scope of infringement for settled precedent interpreting the scope of the on-sale bar. That request is not new. It has been rejected at least twice before. *See NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1320 (Fed. Cir. 2005) (“[W]e have previously ‘decline[d] to import the authority construing the ‘on sale’ bar of § 102(b) into the ‘offer to sell’ provision of § 271(a).”’) (quoting *3D Sys., Inc. v. Aarotech Labs., Inc.*, 160 F.3d 1373, 1379 n.4 (Fed. Cir. 1998) (“‘[O]ffer to sell’ under § 271 cannot be treated as equivalent to ‘on sale’ under § 102(b).”)). Celanese fails to explain why this Court should reach



a different conclusion the third time. Moreover, like its “useful end result” argument, Celanese failed to raise its § 271 argument below, and therefore waived it. *See supra*, note 2.

*(d) § 102(a)(1) ’s “Otherwise Available to the Public”*

Celanese’s next text-based argument is notable in that it repeats the exact argument that was rejected in *Helsinn*. Celanese contends that the phrase “or otherwise available to the public” in § 102(a)(1) “confirms that the AIA’s on-sale provision excludes sales of a product that do not disclose the inventive process” because “[t]he phrase ‘available to the public’ must mean that the invention is available to at least one other person” and “‘otherwise’ indicates that placing a claimed invention ‘on sale’ is another way of making the claimed invention so available.” Celanese Br. at 20-21. That exact argument was before the Court in *Helsinn*, and it was explicitly rejected. *Helsinn*, 139 S. Ct. at 634. As such, Celanese’s argument amounts to little more than a request for this Court to abrogate *Helsinn*, which it may not do. Moreover, Celanese never raised this argument before the Commission, and it is therefore waived. *See supra*, note 2.

*(e) § 102(a) ’s Title*

Celanese’s fifth text-based argument centers on the title of § 102(a). Celanese contends that, because the title of § 102(a) makes no reference to “loss of right to a patent,” while the title to pre-AIA § 102 did include such a reference, the

change must be indicative of Congress’s intent to do away with the application of the on-sale bar to the sale of products made with a patented process. *Celanese Br.* at 21-22. The crux of *Celanese*’s argument here is that the absence of the phrase “loss of right” in the title of § 102(a) indicates that § 102(a) no longer reaches conduct that would have been considered a loss-of-right provision under pre-AIA § 102, the on-sale bar of pre-AIA § 102(b) being one such example. *Id.* That argument is contrary to the plain language of § 102(a)(1), which expressly includes an on-sale bar, *i.e.*, a loss-of-right provision. *See BASF*, 955 F.3d at 963. Accordingly, there can be no question that § 102(a) continues to embrace at least one loss-of-right provision. Presumably, *Celanese* would limit its “loss of right” argument to sales of products of a patented process, *Celanese Br.* at 22, but it offers no justification for doing so. The fact that § 102(a)(1) explicitly includes the on-sale bar forecloses *Celanese*’s argument.<sup>3</sup>

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<sup>3</sup> The legislative history behind the title of § 102(a) also calls into question whether the absence of the words “loss of right” signifies the Congressional intent that *Celanese* presumes it does. The title of § 102(a) was introduced in a bill that was an early precursor to the AIA. *See* 109 H.R. 2795, § 3 (June 8, 2005) (available via West at 2005 CONG US HR 2795). That bill omitted all loss-of-right provisions from § 102, including the on-sale bar. *Id.* That version of § 102 did not persist as Congress worked towards the bill that ultimately became the AIA. The on-sale bar was added back into § 102, but the title was never changed. *See* H.R. 1908, § 3 (Apr. 18, 2007) (available via West at 2007 CONG US HR 1908).

**2. *The Structure of the AIA Does Not Support Celanese's Interpretations of § 102(a)(1).***

Celanese also attempts to find support for altering the settled meaning of “on sale” in the structure of the AIA. These arguments, many of which, again, were never presented below and are thus waived, fare no better than Celanese’s textual arguments.

*(a) “Disclosures” in §§ 102(b) and 103*

Celanese’s first structural argument is that, because §§ 102(b) and 103 refer to “disclosures” under § 102(a), and because the sale of a product made by a patented process does not disclose the process, such a sale must not trigger the on-sale bar of § 102(a)(1). This argument is new on appeal and is therefore waived. *See supra* note 2. Moreover, the logic of Celanese’s argument is flawed. Neither § 102(b) nor § 103 state that all of the grounds precluding patentability in § 102(a)(1) are disclosures. Accordingly, there is no conflict between §§ 102(b) and 103 and the settled principle that a sale, or offer for sale, need not reveal the details of an invention to trigger the on-sale bar, regardless of whether such a sale or offer for sale is a disclosure under §§ 102(b) or 103.

Celanese’s suggestion that § 102(a)(1)’s on-sale provision can only be triggered by sales and offers for sale that effect a disclosure of the invention cannot be squared with the Supreme Court’s decision in *Helsinn*, which unequivocally held that disclosure is not required to trigger the on-sale bar. *Helsinn*, 139 S. Ct. at

633 (“[A]n offer for sale could cause an inventor to lose the right to patent, without regard to whether the offer discloses each detail of the invention.”). All that is required is a commercial offer for sale and an invention that is ready for patenting. *Id.* at 630; *see also Pfaff*, 525 U.S. at 67. Unlike Celanese’s arguments on appeal, the Commission’s refusal to make disclosure a third required element of the on-sale bar is a faithful application of *Helsinn* and *Pfaff*.

Undeterred by *Helsinn* and *Pfaff*, Celanese argues that this Court should redefine when an invention is “on sale” such that public disclosure is a prerequisite. *See Celanese Br.* at 23. Specifically, Celanese complains that, if not so defined, the on-sale bar of § 102(a)(1) will not be tempered by the one-year grace period of § 102(b). *Id.* at 23-25. However, to the extent Celanese’s argument suggests that affirmance of the Commission’s decision necessarily requires the Court to hold that the grace period of § 102(b) does not extend to the on-sale bar of § 102(a)(1), that is not the case. Because Celanese failed to raise its “disclosures” argument below, and because it is undisputed that Celanese sold Ace-K made with its patented process more than one year before the effective filing date of the asserted patents, *see Appx9-10* (citing Appx11210-11213; Appx10539-10590; Appx10665-10706), the Commission had no occasion to consider the scope of § 102(b) in its final determination. As such, affirmance of the Commission’s determination does not require this Court to offer an advisory opinion on the scope of § 102(b). The

Court need only hold, as the Supreme Court has already held, that the AIA did not alter the settled meaning of “on sale” in the context of § 102. *Helsinn*, 139 S. Ct. at 633-34.

Celanese’s contention that there is no “logical reason” that Congress would have enacted a grace period that applies to disclosures but not to secret acts of commercialization, is also wrong. This Court has identified three reasons for the statutory bars: (1) “to prevent the public from being deprived of that which it has come to rely on as publicly available,” (2) “to encourage prompt disclosure of inventions,” and (3) “to prevent effective extension of patent term by gamesmanship.” *BASF*, 955 F.3d at 967. Of these purposes, only the latter two address secret acts of commercialization. *See id.* The first, which presumes public disclosure as a prerequisite, is inapposite to such secret acts of commercialization. *See id.* Given the differing reasons for precluding patentability under § 102, it would not be illogical for Congress to determine that a grace period should apply to one patentability doctrine but not the other, *i.e.*, by treating “extension of a patent term by gamesmanship” more harshly than public disclosure. *Id.* In any event, how to weigh the rationales for withholding patentability is a policy question for Congress and one that this Court need not reach given that the scope of post-AIA § 102(b) is not at issue in this appeal.

*(b) The Prior-Use Defense of § 273*

Celanese next complains that the Commission's decision is incongruous with the prior-use defense of § 273. But Celanese's argument is based on a misreading of the Commission's decision. Specifically, Celanese contends that, if the sale of a product of an inventive process triggers the on-sale bar, then "no one would need this [prior use] defense to infringement for such sales." Celanese Br. at 26. Celanese's contention assumes that a third party's (as opposed to the inventor's) sale of a product created by an inventive process will trigger the on-sale bar. *See id.* The Commission's determination, however, did not so hold, nor could it have, given that the law is settled that such a third-party sale will not trigger the on-sale bar. *Caveney*, 761 F.2d at 675. The Commission's determination is limited to the facts of this case, which implicate only Celanese's own sale of Ace-K made with its patented process. In addressing those facts, the Commission applied the settled rule that an inventor's sale of a product made by a patented process places that process on sale for purposes of the on-sale bar. *See BASF*, 955 F.3d at 969. So understood, the Commission's determination creates no conflict between the on-sale bar of § 102(a)(1) and the prior-use defense of § 273. The on-sale bar precludes an inventor's pre-patenting commercialization of the process, while § 273 protects prior users of the process from infringement liability. Triggering the infringement defense does not, as Celanese contends, necessarily

defeat patentability. *See id.* at 968, n.8 (“A successful prior-use defense, however, does not necessarily establish invalidity.”) (citing 35 U.S.C. § 273(g)).

*(c) Post-Grant Reviews Under § 321*

Celanese’s post-grant review argument, also raised for the first time in this appeal and thus waived, *see supra* note 2, fares no better than its prior-use and grace period arguments. The gist of the post-grant review argument is that the on-sale bar of § 102(a)(1) must require public disclosure because post-grant reviews are limited to the consideration of patentability grounds under § 102. Celanese Br. at 27-29. Baked into that argument is the assumption that post-grant reviews can only be based on publicly available prior art. *See id.* That argument fails for at least two reasons.

First, the plain statutory text does not restrict the scope of post-grant reviews to publicly available prior art. To the contrary, “[a] petitioner in a post-grant review may request to cancel as unpatentable 1 or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of [35 U.S.C. §] 282(b) (relating to invalidity of the patent or any claim).” 35 U.S.C. § 321(b). Paragraph (2) of § 282(b) includes “[i]nvalidity of the patent or any claim in suit on any ground specified in part II as a condition for patentability,” which in turn covers all of § 102(a), including the on-sale bar. 35 U.S.C. § 282(b)(2); *see also* § 102(a).

Nowhere does the AIA limit post-grant reviews to grounds that disclose an invention to the public.

Second, *Helsinn*'s holding proves that post-grant reviews may reach patentability grounds that do not involve public disclosure of the invention. This is because the on-sale bar of § 102(a)(1) is clearly within the scope of post-grant reviews under § 321, and *Helsinn* established that public disclosure is not a required element of a triggering sale under that provision. *See Helsinn*, 139 S. Ct. at 634. Celanese fails to explain how the Commission, or this Court, could craft a decision in its favor without running afoul of the holding in *Helsinn*.

**3. *The Policies Behind the AIA Do Not Support Celanese's Interpretations of § 102(a)(1).***

Lacking support in the text of the AIA and the precedents interpreting it, Celanese “fall[s] back to the last line of defense for all failing statutory interpretation arguments: naked policy appeals.” *Bostock v. Clayton Cnty., Ga.*, 140 S. Ct. 1731, 1753 (2020); *see also* Celanese Br. at 29-33. Of that approach to statutory interpretation, the Supreme Court takes a particularly dim view:

If we were to apply the statute's plain language, they complain, any number of undesirable policy consequences would follow. Gone here is any pretense of statutory interpretation; all that's left is a suggestion we should proceed without the law's guidance to do as we think best. But that's an invitation no court should ever take up. The place to make new legislation, or address unwanted consequences of old legislation, lies in Congress.



*Bostock*, 140 S. Ct. at 1753 (citations omitted). The last line of the prior quotation is particularly prescient here. Given *Helsinn*, there is no question that the AIA did not add a disclosure requirement to the meaning of “on sale” in the context of the on-sale bar. Four years have passed since *Helsinn* was decided, with no shortage of ink spilled about the decision. Congress is doubtless aware of the decision and its implications, yet has declined to step in and exercise its unique authority to abrogate the Supreme Court’s decision through legislation. If the continued persistence of the pre-AIA meaning of “on sale” is an unwanted or unintended consequence of the AIA, Congress, not this Court, possesses the power to address the issue. *See id.* And, in the patent sphere, Congress has proven itself capable of acting expeditiously to address judicial holdings when it so intends. *See* 5 Chisum on Patents § 16.03[4][a] (“Enactment [of pre-AIA § 273] came soon after a landmark Federal Circuit decision, *State Street Bank & Trust Co. v. Signature Financial Group Inc.*[, 149 F.3d 1368 (Fed. Cir. 1998)].”). In the absence of Congressional action though, as here, it is at least as likely, if not more so, that Congress views the persistence of the pre-AIA meaning of “on-sale” as neither unintended nor unwanted. Regardless, this Court need not attempt to divine Congress’ views on that issue. As explained *supra*, *Helsinn* controls and clearly dictates the outcome in this case: the AIA wrought no change to the meaning of

“on sale” in the context of the on-sale bar; Celanese’s sale of Ace-K made with its patented process bars the patentability of its claims to the same.

To the extent this Court is inclined to entertain Celanese’s policy arguments, they are overblown. For example, Celanese points to Congress’ desire in enacting the AIA to achieve greater international uniformity and suggests that the Commission’s determination frustrates that desire. Celanese Br. at 29-30. Not so. The centerpiece of the AIA was its conversion of the American patent system from a first-to-invent system to a first-to-file system. That change achieved Congress’s goal of increasing international uniformity. Indeed, the AIA makes that point expressly:

It is the sense of the Congress that converting the United States patent system from “first to invent” to a system of “first inventor to file” will improve the United States patent system and promote harmonization of the United States patent system with the patent systems commonly used in nearly all other countries throughout the world with whom the United States conducts trade and thereby promote greater international uniformity and certainty in the procedures used for securing the exclusive rights of inventors to their discoveries

Leahy-Smith America Invents Act, Pub. L. 112-29, § 3(p), 125 Stat. 284 (2011).

Celanese’s suggestion that the AIA should be interpreted to harmonize every aspect of domestic and foreign patent law goes well beyond the harmonization that Congress expressly stated was intended.

Similarly, Celanese's assertion that the Commission's determination "supercharge[s]" the on-sale bar by allowing "product sales (1) anywhere in the world (2) by anyone (3) even a day before the effective filing date of the patent application" to trigger the bar is based on the same misreading of the determination that animates Celanese's prior use argument. Celanese Br. at 30-31. As explained above, the Commission did not determine that the sale "by anyone" of a product made by an inventive process triggers the on-sale bar. *See supra* at pp. 36-37. The Commission merely applied the established meaning of "on-sale" in the context of § 102, which, for sales of products made by an inventive process, is limited to sales by the inventor. *Caveney*, 761 F.2d at 675. Celanese cannot manufacture error in the Commission's determination by attacking holdings that the Commission did not make. Moreover, while Celanese is correct that the on-sale bar of § 102(a)(1) is broader than that of pre-AIA § 102(b) inasmuch as it is no longer geographically constrained to the United States, *compare* pre-AIA § 102(b) *with* § 102(a)(1), the decision to make that change came from Congress, not the Commission.

Celanese argues that there is no policy reason for triggering the on-sale bar based on an inventor's sale of a product made by the inventive process.

Specifically, Celanese argues that the transition to a first-to-file system eliminated the need to encourage inventors to disclose their inventions promptly and thus advance the progress of science and the useful arts, one of the key purposes of the

on-sale bar. *See* Celanese Br. at 31-32. Per Celanese, the fear of another inventor filing first and receiving a patent first will accomplish the same outcome. *Id.* at 32.

Setting aside that it was not the Commission's place below, nor this Court's place now, to weigh the policy rationales of the on-sale bar, Celanese's argument is undercut by the sole amicus filing in this case, which favors Celanese's interpretation of § 102(a)(1). The amicus brief by the National Association of Manufacturers ("NAM"), which is unabashedly frank in its purpose, explains that the problem with the Commission's determination, as NAM sees it, is that it will preclude manufacturers from protecting their processes as trade secrets before protecting them later via exclusive patent rights. *See* NAM Amicus Br. at 6-8 (ECF 16). NAM's position proves that the transition to a first-to-file system alone will not dissuade all manufacturers from seeking both trade secret and patent protection for the same process. Indeed, it did not dissuade Celanese. This case exists *because* Celanese did precisely what it claims that its interpretation of the AIA dissuades: it delayed filing for patent protection of its process while it enjoyed the benefits of its commercialization as a trade secret. This case disproves the contention that the transition to a first-to-file system alone is sufficient to encourage prompt disclosure of an invention. What Celanese and NAM plainly seek in this case is the elimination of the long-held principle that an inventor "must content himself with either secrecy, or legal monopoly," not both. *Pfaff*, 525 U.S.

at 68 (quoting *Metallizing*, 153 F.2d at 520). That relief is not justified by the AIA, nor is it within the Commission or this Court’s power to provide.

**B. Celanese’s Criticisms of the Commission’s Determination Miss the Mark.**

Separate from its arguments in support of its preferred interpretation of § 102(a)(1), Celanese raises three specific assertions of error in the Commission’s determination: (1) that the Commission wrongly applied the reenactment canon in interpreting the meaning of “on sale” in § 102(a); (2) that *Helsinn* does not dictate the outcome of this case; and (3) that the legislative history of the AIA does not support the Commission. Celanese’s criticisms are misplaced, as explained below.

**1. *The Reenactment Canon Applies to the Meaning of “On Sale” in § 102(a)(1).***

Celanese contends that the Commission erred by applying the reenactment canon of statutory construction in concluding that an inventor’s sale of a product made by the inventive process places that process “on sale” within the meaning of § 102(a). Celanese Br. at 34-42. This criticism is remarkable given that the Supreme Court found the reenactment canon applicable in *Helsinn* when it interpreted the meaning of the very same phrase at issue here, *i.e.*, “on sale.” *Helsinn*, 139 S. Ct. at 633-34 (“In light of this settled pre-AIA precedent on the meaning of ‘on sale,’ we presume that when Congress reenacted the same language in the AIA, it adopted the earlier judicial construction of that phrase.”). Celanese

gives five reasons in support of its criticism, but none is persuasive, particularly given the controlling nature of *Helsinn*.

First, Celanese contends that the reenactment canon does not apply here because its application would “override clear statutory language.” Celanese Br. at 34. However, Celanese’s “clear statutory language” arguments against applying the reenactment canon are coextensive with the textual and structural arguments it relies on for its preferred interpretation of § 102(a)(1). As explained above, those arguments are not persuasive. *See supra* Argument §§ III.A.1-2. There is no textual conflict between the AIA and the settled principle that a process is “on sale” when the inventor offers for sale a product made with the later patented process. *Id.*

Second, Celanese contends that it was not well-settled that an inventor’s sale of a product made by an inventive process would place the process “on sale” within the meaning of pre-AIA § 102(b), and thus the reenactment canon does not apply. Celanese Br. at 35-38. Celanese’s assertion that the principle at issue in this case was not well-settled is fanciful. The decisions interpreting pre-AIA § 102(b) uniformly agree that an inventor’s sale of a product made by a patented process placed the process “on sale” within the meaning of that section. *See D.L. Auld*, 714 F.2d at 1147-48; *W.L. Gore*, 721 F.2d at 1550; *Caveney*, 761 F.2d at

675; *Dippin' Dots*, 476 F.3d at 1344; *Kollar*, 286 F.3d at 1333; *BASF*, 955 F.3d at 969. Celanese fails to identify even a single case holding otherwise.

For support, Celanese cherry-picks a snippet from Chisum's treatise on patents, Celanese Br. at 35 (quoting 2A Chisum on Patents § 6.02[5][b]), but the same section of that treatise plainly states that "it is now well established that commercial exploitation by the inventor of a machine or process constitutes a public use even though the machine or process is held secret." 2A Chisum on Patents § 6.02[5][b]. Chisum's observation is echoed in other treatises, *see e.g.*, 3 Matthews, Annotated Patent Digest § 17:111 ("Where the patentee places a product made by the patented process on the market before the critical date, the on-sale bar generally applies to invalidate the claims, even if the patentee keeps the process secret and the details of the process cannot be gleaned from the product."), and in the leading patent law casebooks available immediately prior to the AIA's enactment, *see, e.g.*, Principles of Patent Law, Ch. 4, pp. 370-71 (2008) ("[T]he sale of a product made by the process or performing the process itself for consideration [will] trigger the on-sale bar."). The MPEP of the same time period said the same. MPEP 8<sup>th</sup> Ed., Rev. 8, § 2133.03(c)(III) (Jul. 2010) (available at: [https://www.uspto.gov/web/offices/pac/mpep/old/E8R8\\_2100.pdf](https://www.uspto.gov/web/offices/pac/mpep/old/E8R8_2100.pdf)) ("[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).").

Celanese looks to *Pennock* (from 1829) and *Metallizing* (1946) to support its contention that the phrase “on sale” in pre-AIA § 102(b) had not acquired a settled meaning when the AIA was enacted. Celanese Br. at 35-36 (citing *Pennock v. Dialogue*, 27 U.S. 1 (1829), and *Metallizing*, 153 F.2d 516). But neither of those cases interpreted pre-AIA § 102(b). Even if Celanese could show some conflict between *Pennock* and *Metallizing* and the rule that a process is “on sale” when its inventor offers a product made with the process for sale, it would not show that the phrase “on sale” as recited in pre-AIA § 102(b) did not have a settled meaning. In contrast, the cases that specifically interpret the scope of the phrase “on sale” in pre-AIA § 102(b) uniformly agree that the sale of a product made with a patented process by the process’s inventor places the process “on sale.” *See supra* at p. 44-45.

That said, Celanese’s argument also fails because there is no conflict between *Pennock*, *Metallizing*, and the precedents interpreting “on sale” in pre-AIA § 102(b). *Pennock*, for example, provides one of the earliest examples of American patent law’s distaste for allowing inventors to exploit their inventions through secrecy and legal monopoly:

If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; if he should for a long period of years retain the monopoly, and make, and sell his invention publicly, and thus gather the whole profits of it, relying upon his superior skill and knowledge of the structure; and then, and then only,



when the danger of competition should force him to secure the exclusive right, he should be allowed to take out a patent, and thus exclude the public from any farther use than what should be derived under it during his fourteen years; it would materially retard the progress of science and the useful arts, and give a premium to those who should be least prompt to communicate their discoveries.

*Pennock*, 27 U.S. at 19. *Metallizing* correctly paraphrased that sentiment when it explained that “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.” *Metallizing*, 153 F.2d at 520. While Judge Learned Hand could not have known of the precise contours of pre-AIA § 102(b) when he wrote *Metallizing*, the Supreme Court certainly did when it decided *Pfaff*, in which it quoted the very same portion of Judge Hand’s opinion with approval. *Pfaff*, 525 U.S. at 68. This Court, likewise, has repeatedly cited *Metallizing* with approval in its decisions interpreting § 102(b). *See, e.g., BASF*, 955 F.3d at 968-69.

Celanese contends that the interpretation of a statutory phrase can only be settled when the Supreme Court has produced the interpretation. *See Celanese Br.* at 37-38. That argument overreaches. While the Supreme Court declined to apply the reenactment canon to a federal removal statute based on “a smattering of lower court opinions,” *BP P.L.C. v. Mayor of Balt.*, 141 S. Ct. 1532, 1541 (2021), here, the “lower court opinions” come from a Circuit Court with exclusive jurisdiction

over the subject matter at hand, whose decisions interpreting the term “on sale” are consistent and uniform over the course of decades. Moreover, in *Helsinn*, when determining to apply the reenactment canon, the Supreme Court expressly identified this Court’s precedents when it explained how “on sale” came to have a settled meaning. *Helsinn*, 139 S. Ct. at 633.

Third, Celanese contends that “the reenactment canon is inapplicable because the AIA did not ‘reenact’ pre-AIA § 102(b) ‘without change.’” Celanese Br. at 39 (quoting *Jama v. Immigr. & Customs Enf’t*, 543 U.S. 335, 349 (2005)). Celanese points to the AIA’s reorganization of the subsections of § 102 and to the addition of the word “claimed” before “invention” and the phrase “otherwise available to the public.” *Id.* at 39-40. It also points to the sections of the AIA dealing with the grace period, prior use defense, and post-grant review proceedings. Celanese’s argument directly conflicts with *Helsinn* where the Supreme Court determined that the reenactment doctrine did apply. As the Court pointed out there, “[i]n light of this settled pre-AIA precedent on the meaning of ‘on sale,’ we presume that when Congress reenacted the same language in the AIA, it adopted the earlier judicial construction of that phrase.” *Helsinn*, 139 S. Ct. at 633-34. Celanese does not even attempt to explain how to square its contention that the reenactment canon does not apply with *Helsinn*’s express statement to the contrary.

Fourth, Celanese claims that the AIA's elimination of pre-AIA § 102(c) and § 102(g) demonstrates that the reenactment canon does not apply. Celanese Br. at 40-42. Of Celanese's reenactment arguments, this one is the most convoluted and most difficult to parse. However, the crux is this: Celanese believes that pre-AIA § 102(c), which dealt with abandonment, and pre-AIA § 102(g), which dealt with priority of invention, formed the basis for the settled rule that an inventor's sale of a product made by the inventive process places the process "on sale" within the meaning of pre-AIA § 102(b). *See id.* Based on that belief, Celanese contends that the elimination of those provisions evinces Congressional intent to alter the meaning of "on sale" as it applies to processes. *See id.* at 42.

Celanese's theory fails at least because there is no support for its predicate that the meaning of "on sale" as applied to processes stems from pre-AIA § 102(c) and (g). Celanese cites no cases that attribute the meaning of "on sale" to § 102(c), and it misreads the sole case it cites to attribute the meaning of "on sale" to § 102(g), *i.e.*, *W.L. Gore*. *See* 721 F.2d at 1550. *W.L. Gore* did not attribute the meaning of "on sale" to § 102(g). It expressly cited *D.L. Auld* and *Metallizing* for the proposition that an inventor's sale of a product of the patented process will trigger the on-sale bar as to the process. *W.L. Gore*, 721 F.2d at 1550 ("If Budd and Cropper commercialized the tape, that could result in a forfeiture of a patent granted them for their process on an application filed by them more than a year

later.”) (citing *D.L. Auld*, 714 F.2d at 1147-48; *Metallizing*, 153 F.2d 516).

Celanese’s misreading of *W.L. Gore* causes it to overlook a far more straightforward explanation of why Congress repealed pre-AIA § 102(c) and § 102(g): those sections became irrelevant with the transition to a first-to-file patent system.

Fifth, Celanese criticizes the Commission for observing that nothing in the legislative history demonstrates Congressional intent to do away with the distinction between an inventor’s sale of products made by the patented process and a third-party’s sale of products made by the same process. Celanese Br. at 42. Celanese’s argument is little more than a repeat of its argument that the Commission’s determination will result in a supercharged on-sale bar that applies to sales by “anyone, anywhere in the world, even a day before the filing of the patent application on the secret inventive process used to make the product.” *Id.* The Commission did not so hold, and this appeal does not implicate whether a third-party’s sale of a product made by an inventor’s process places the process on sale within the meaning of the on-sale bar. Celanese is free to argue against a supercharged on-sale bar should it find itself a party to a case that implicates the issue, but this is not such a case. This is a case where the Commission applied the decades-old rule that an inventor’s sale of a product made with a patented process places the process “on sale” within the meaning of the on-sale bar after the

Supreme Court instructed that the AIA did not change the meaning of “on sale.” There is no error in the Commission’s unremarkable application of controlling law.

## **2. *Helsinn Supports the Commission’s Determination.***

Celanese criticizes the Commission’s observation that *Helsinn* supports its determination. Celanese Br. at 42-45. But *Helsinn* unequivocally determined that “Congress did not alter the meaning of ‘on sale’ when it enacted the AIA,” which was precisely the Commission’s position. *Helsinn*, 139 S. Ct. at 634. Celanese does not dispute that holding, Celanese Br. at 43, and that should be the end of the matter.

Nonetheless, Celanese argues that *Helsinn* is inapplicable here because its Ace-K-producing process was not “on sale.” *Id.* at 42. That argument ignores the full scope of the settled meaning of “on sale,” particularly as it applies to inventive processes. As detailed *supra*, it was uniformly accepted at the time of the AIA’s enactment that an inventive process was placed “on sale” when its inventor commercialized the process by offering products made by the process for sale. *See supra* Argument § II.A. *Helsinn*’s holding dictates that the same actions that placed an inventive process on sale prior to the enactment of the AIA place it on sale now as well.

Celanese’s argument to the contrary seems to presuppose that the only way an invention can be on sale is by an offer to transfer title to the invention for some

consideration. But such a conception of the phrase “on sale” lacks applicability to processes. *Kollar*, 286 F.3d at 1332. The upshot of Celanese’s interpretation of “on sale” then is that an inventive process can never be “on sale” within the meaning of § 102(a). That extraordinary result has no support in the statutory text, precedent, or legislative history. It is certainly not consistent with *Helsinn*’s holding that “Congress did not alter the meaning of ‘on sale’ when it enacted the AIA.” *Helsinn*, 139 S. Ct. at 634.

**3. *The Legislative History of the AIA Is Consistent with the Commission’s Determination.***

Celanese criticizes the Commission for concluding that its determination is supported by the legislative history. Celanese Br. at 45-49. In Celanese’s view, the legislative history supports the conclusion that all § 102 prior art must disclose the underlying invention to the public. *Id.* at 45-46. Celanese derives support for that conclusion primarily from floor statements given by Senators Kyl and Leahy, but in doing so it only re-treads the same ground covered by this Court and the Supreme Court in *Helsinn*. Those same statements were raised during this Court’s and the Supreme Court’s consideration of *Helsinn* for the same purpose that Celanese relies on them now. *See* Pet’r Br. at 24-29, *Helsinn*, 139 S. Ct. 628 (No. 17-1229), *available at* 2018 WL 4043179, \*25-29 (Aug. 23, 2018); Principal Br. of Pls.-Appellees at 49-53, *Helsinn Healthcare S.A. v. Teva Pharms. USA, Inc.*, 855 F.3d 1356 (Fed. Cir. 2017) (No. 16-1284), *available at* 2016 WL 1698099, \*49-53

(Apr. 25, 2016) (ECF 64). The floor statements carried the day in neither decision, and for good reason:

[J]udicial reliance on legislative materials like committee reports, which are not themselves subject to the requirements of Article I, may give unrepresentative committee members—or, worse yet, unelected staffers and lobbyists—both the power and the incentive to attempt strategic manipulations of legislative history to secure results they were unable to achieve through the statutory text.

*Exxon Mobil Corp. v. Allapattah Servs., Inc.*, 545 U.S. 546, 568 (2005).

Moreover, as Judge O’Malley pointedly put it:

It is a stretch to characterize floor statements by individual Senators made the day after the bill was passed as legislative “history.” If anything is reflective of what Congress intended, beyond the words used in the enacted statute, it would seem that the House Report accompanying the 2007 bill—which reintroduced the “public use” and “on sale” language—would be. That report confirms that the Committee used “the current § 102(b) as the template from which to define the scope of prior art in the Act, primarily because of how the terms ‘in public use’ and ‘on sale’ have been interpreted by the courts.”

Order Denying Pet. For Rehr’g *En Banc, Helsinn*, 855 F.3d 1356 (Consol. No. 16-1284), *available at* 2018 WL 1583031 at \*4 n.4 (Fed. Cir. Jan. 16, 2018)

(O’Malley, J.) (concurring in denial of petition for rehearing *en banc*) (quoting H.R. Rep. No. 110-314, at 57 (2007)). Celanese criticizes the Commission for relying on the very same House Report because the 2007 bill was not ultimately

enacted. Celanese Br. at 46-47. Per Celanese, only the history of the 2011 Bill that was ultimately enacted matters. Celanese’s position feigns ignorance of the well-known fact that the AIA, which was the first major overhaul of the patent act since 1952, was the result of years of Congressional negotiation. To pretend that the AIA was not shaped by the back and forth of the bills that immediately preceded it strains credulity. Moreover, Celanese appears to have no problem relying on the legislative materials surrounding earlier unenacted bills when it serves its purpose. *See* Celanese Br. at 32 (quoting S. Rep. No. 110-259, at 7 (2007), *available at* 2008 WL 275437, at \*7 (2008)).

Accepting that the legislative history of the precursor bills may be persuasive, Celanese argues that the Commission should have weighed that history in its favor. Specifically, Celanese points to a Senate committee report stating that the phrase “otherwise available to the public” was added to § 102 “to make clear that secret collaborative agreements, which are not available to the public, are not prior art.” Celanese Br. at 48 (quoting S. Rep. No. 110-259, 2008 WL 275437, at \*39). But in so doing, Celanese again retreads the same ground already covered in *Helsinn*. Even Celanese must admit that *Helsinn* unequivocally established that the addition of the phrase “otherwise available to the public” did not import a public disclosure requirement into § 102’s on-sale bar. *Helsinn*, 139 S. Ct. at 634 (“The addition of ‘or otherwise available to the public’ is simply not enough of a



change for us to conclude that Congress intended to alter the meaning of the reenacted term ‘on sale.’”).

The situation here is this: the Court need not weigh the legislative history to affirm the Commission’s determination. Whatever ambiguity existed as to the effect of the AIA on the scope of the on-sale bar was resolved conclusively by *Helsinn*, which fully considered the same legislative history that Celanese offers here. To the extent the Court is inclined to look to the legislative history, there are no errors in the conclusions that the Commission drew from it.

**4. *The MPEP is Consistent with the Commission’s Determination.***

Celanese criticizes the Commission’s reliance on the MPEP as additional support for its determination. Celanese Br. at 49-50. Its criticism is twofold. First, Celanese contends that the MPEP supports its position, not the Commission’s. *See id.* at 50. Second, Celanese contends that, if the MPEP does not support its position, it should be given no deference. *See id.* Neither criticism is persuasive.

The relevant portion of the MPEP establishes three things, each of which support the Commission’s determination. First, in stating that “[t]he pre-AIA 35 U.S.C. 102(b) ‘on sale’ provision has been interpreted as including commercial activity even if the activity is secret,” it reinforces the fact that “on sale” had a settled meaning under pre-AIA § 102(b). MPEP § 2152.02(d). Second, it

confirms the USPTO’s understanding that “AIA 35 U.S.C. 102(a)(1) uses the same ‘on sale’ term as pre-AIA 35 U.S.C. 102(b) and is treated as having the same meaning.” *Id.* And third, it confirms the USPTO’s understanding that “a sale or offer for sale that does not disclose the subject matter of an invention or make the invention available to the general public may nevertheless qualify as prior art in an anticipation or obviousness rejection.” *Id.* Those points are consistent with the Commission’s determination, which is based on the settled meaning of “on sale” under pre-AIA § 102(b) and the fact that the AIA did not alter the meaning of that phrase. While it is true that the USPTO does not declare substantive patent law, it was not error for the Commission to observe that its interpretation of the AIA is consistent with the USPTO’s, as it is also consistent with this Court’s and the Supreme Court’s interpretation.

## **CONCLUSION**

The Commission’s determination below is an unremarkable application of controlling precedents. The Commission requests that the Court affirm its determination as such.

Respectfully Submitted,

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Date: January 27, 2023

**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME  
LIMITATION, TYPEFACE, AND TYPE STYLE REQUIREMENTS**

Pursuant to Federal Rule of Appellate Procedure 32(g)(1) and Federal Circuit Rule 32(b)(3), I hereby certify that the attached brief complies with the type-volume limitation and typeface requirements of Federal Rule of Appellate Procedure 32(a)(7) and Federal Circuit Rules 32(b)(1) and 32(b)(2). The brief has been prepared in a proportionally-spaced typeface using Microsoft Office 365, in Times New Roman 14-point font. The brief contains a total of 13,962 words, obtained from the word-count function of the word-processing system, including all footnotes and annotations.

/s/ Benjamin S. Richards  
Benjamin S. Richards

Date: January 27, 2023

## CERTIFICATE OF SERVICE

I, Benjamin S. Richards, hereby certify on this 27th day of January 2023 that I filed the attached **BRIEF OF APPELLEE INTERNATIONAL TRADE COMMISSION** using this Court's CM/ECF system. Service to principal counsel of record will be accomplished via the Court's CM/ECF system.

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