

No. 22-1827

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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,*

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

*Intervenors.*

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

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**BRIEF OF THE NATIONAL ASSOCIATION OF MANUFACTURERS AS *AMICUS CURIAE* IN  
SUPPORT OF APPELLANTS**

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## **CERTIFICATE OF INTEREST**

Counsel for the National Association of Manufacturers certifies under Federal Circuit Rule 47.4 that the following information is accurate and complete to the best of their knowledge:

1. **Represented Entities.** Provide the full names of all entities represented by undersigned counsel in this case.

National Association of Manufacturers (“NAM”).

2. **Real Parties in Interest.** Provide the full names of all real parties in interest for the entities.

None.

3. **Parent Corporation and Stockholders.** Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.

None. Pursuant to Rule 26.1 of the Federal Rules of Appellate Procedure, the undersigned counsel certifies that NAM is a not for profit organization. The NAM has no parent corporation, and no publicly held company has 10% or greater ownership in the NAM.

4. **Legal Representatives.** List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court.

Duane Morris LLP: Brian Pandya, Andrew Sperl, Brianna Vinci.

5. **Authorship and Funding.**

Pursuant to Rule 29(a)(4)(E) of the Federal Rules of Appellate Procedure, the undersigned counsel certifies that (1) no party’s counsel authored this brief in whole or in part, (2) no party or party’s counsel contributed money that was intended to fund preparing or submitting the brief, and (3) no person—other than the amicus curiae, its members, or its counsel—contributed money that was intended to fund preparing or submitting the brief.

6. **Related Cases.** Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case.

Not applicable.

7. **Organizational Victims and Bankruptcy Cases.** Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees).

Not applicable.

Dated: October 28, 2022

/s/ Brian Pandya  
Brian Pandya

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## **STATEMENT OF INTEREST OF AMICI**

The National Association of Manufacturers (“NAM”) is the largest manufacturing association in the United States, representing large and small manufacturers in every industrial sector and in all fifty states. Manufacturing employs nearly 12.8 million Americans, contributes more than \$2.77 trillion to the United States economy annually, has the largest economic impact of any major sector, and accounts for nearly two-thirds of private-sector research and development. NAM is a voice for the manufacturing community and the leading advocate for a policy agenda that helps manufacturers compete in the global economy and create jobs across the United States.

NAM’s policy positions are approved by the NAM Board of Directors, which is selected from a cross-section of American manufacturers. Those policy positions reflect the importance of robust patent and trade secret protections to manufacturing innovation. In particular, NAM’s policy interests include the “reform and harmonization of the global patent . . . system in a way that improves global IPR [intellectual property rights] protection, ensures robust enforcement of IPR rules, builds support among all countries on the importance of enforcing IPR rules, and reduces costs and increases efficiencies in establishing global IPR protections in all

nations.”<sup>1</sup> NAM also expressly “supports actions to strengthen trade secret protection” because trade secrets are “increasingly important for U.S. manufacturers.”<sup>2</sup>

Manufacturing is a capital-intensive sector that requires significant investments at all phases, from initial research and development to building and maintaining production facilities and distribution channels. Most NAM members source components and sell products globally. Thus, manufacturers depend on stable intellectual property laws to protect their investments and also have an interest in knowing that their innovations will be subject to consistent protection worldwide. The International Trade Commission’s interpretation of Section 102 of the Leahy-Smith America Invents Act (“AIA”) undermines the predictability that Congress intended and puts American patent law at odds with the rest of the world. This appeal accordingly raises issues of direct concern to NAM, its members, and the American manufacturing sector as a whole.

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<sup>1</sup> National Association of Manufacturers, *Policy Positions*, [https://documents.nam.org/Nam.org\\_Web\\_Archive/www.nam.org/uploadedFiles/NAM/Site\\_Content/Issues/Official-Policy-Positions/policy.text.for.board.approve.9.14.2018.pdf](https://documents.nam.org/Nam.org_Web_Archive/www.nam.org/uploadedFiles/NAM/Site_Content/Issues/Official-Policy-Positions/policy.text.for.board.approve.9.14.2018.pdf) (last accessed Oct. 6, 2022).

<sup>2</sup> *Id.*

**STATEMENT OF COMPLIANCE WITH RULE 29(a)**

This brief is submitted in accordance with Rule 29(a) of the Federal Rules of Appellate Procedure. All parties have consented to the filing of this brief.

No party or party's counsel authored this brief in whole or in part; no party or party's counsel contributed money to fund the preparation or submission of this brief; and no other person except *amici curiae*, its members, or its counsel contributed money intended to fund the preparation or submission of this brief.

## ARGUMENT

The ITC erred in finding that the sale of a product made by a secret process creates an on-sale bar that precludes patenting that process, even though there was no public disclosure of that process. The ITC's interpretation finds no basis in the text of the AIA, undermines Congressional intent, and prevents manufacturers from developing complementary patent and trade secret rights. This Court should reverse.

### **I. Clarifying the Applicability of the On Sale Bar is Vitally Important to Manufacturers**

NAM and its members depend on complementary intellectual property protections to remain competitive and to continue contributing to the United States economy. This includes ensuring that secret processes are protected prior to patenting and remain eligible for patent protection. As explained below, Congress enacted the AIA mindful of both the common practice of protecting secret processes and the need to encourage innovation. The ITC's decision conflicts with those goals and harms manufacturers—and should accordingly be reversed.

#### **A. Protecting Manufacturing Processes is Necessary for Maintaining Global Competitiveness**

The manufacturing industry relies heavily on patents and other intellectual property protections to remain strong and competitive. The way a product is manufactured is often just as economically important—if not more so—than the resulting end-product. Manufacturers may develop new ways of making existing products that are more efficient or more environmentally friendly than old processes.

The vitality of the American manufacturing sector—which employs millions and contributes an enormous sum to the American economy—depends on innovative manufacturing processes that are continually “more flexible, efficient, and precise.”<sup>3</sup> Protecting these processes allows companies to continue innovating and to employ a larger number of American workers.<sup>4</sup>

Between 2008 and 2012 alone, the USPTO granted 44,148 utility patents relating to “miscellaneous manufacturing.”<sup>5</sup> Similarly, the number of registered patents relating to industrial manufacturing processes has increased more than 150% since 1981.<sup>6</sup> Statistics like these reflect manufacturers’ significant and continuing reliance on patent protection for manufacturing processes. The ITC’s decision thwarts that reliance by adopting an interpretation of Section 102’s on-sale bar that creates significant confusion about the scope of patent protection.

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<sup>3</sup> See McKinsey & Co., *Manufacturing process innovation for industrials* (Sept. 16, 2021), <https://www.mckinsey.com/industries/advanced-electronics/our-insights/manufacturing-process-innovation-for-industrials> (last accessed Oct. 20, 2022).

<sup>4</sup> *Id.*

<sup>5</sup> See USPTO Patent & Trademark Monitoring Team, *Patenting by NAICS Industry Classification*, [https://www.uspto.gov/web/offices/ac/ido/oeip/taf/naics/naics\\_stc\\_fg5/28naics\\_stc\\_fg.htm](https://www.uspto.gov/web/offices/ac/ido/oeip/taf/naics/naics_stc_fg5/28naics_stc_fg.htm) (last accessed Oct. 20, 2022).

<sup>6</sup> See McKinsey & Co., *supra* note 2.

## **B. Manufacturers Rely on Complementary Patent and Trade Secret Strategies to Protect Their Innovations**

As explained in NAM's official policy positions, "the value of American manufacturing companies aligns . . . closely with their intellectual property," and protecting all types of intellectual property is vital "for U.S. companies to thrive in the global economy."<sup>7</sup> That protection must extend not only to patented inventions, but also to processes that manufacturers elect to protect by trade secrets. The ITC's decision creates a tension between trade secret and patent protection, which is legally insupportable and detrimental to U.S. manufacturers.

It is common for manufacturers to keep a manufacturing process secret while commercially selling the end-product resulting from that process. In some instances, manufacturers may elect to protect processes with trade secrets while patenting end-products. In many other instances, manufacturers elect to patent both processes and products. Yet due to the iterative nature of manufacturing processes, manufacturers may not immediately know whether a process should be patented. For example, a company may start selling a product and continue to fine-tune its processes before deciding the process is ready for patent filing.

Manufacturers that sell globally must also consider how they will protect their intellectual property internationally. If one jurisdiction forces a manufacturer to

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<sup>7</sup> See NAM Policy Positions, *supra* note 1, at § 1.0.3

decide prematurely between filing a patent or losing patent rights, that manufacturer may decide to forgo pursuing patent protections—depriving the public of the benefits of the patent disclosure—and instead opt for trade secret protections. Or the manufacturer may lose trade secret protections in one jurisdiction due to the patenting decisions in another jurisdiction. It seems implausible that the AIA intended to put manufacturers in this box.

Courts have long recognized the necessity of protecting secret, unpatented processes. The Supreme Court in *Kewanee Oil Co. v. Bicron*, 416 U.S. 470, 493 (1974), explained the complementary nature of patent and trade secret law, noting that “[t]rade secret law and patent law have co-existed in this country for over one hundred years. Each has its particular role to play, and the operation of one does not take away from the need for the other.”<sup>8</sup> Under this framework of coexistence, manufacturers reasonably depend on trade secret law to protect secret processes and to remain competitive. Those manufacturers should not be punished with the loss of both trade secret *and* patent protection when they seek to publicly disclose their innovative processes through patenting.

A key impetus to the passage of the AIA was Congress’s desire to enable inventors—including manufacturers—to rely upon complementary trade secret and patent protection. The AIA declares that “[i]t is the sense of Congress that the patent

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<sup>8</sup> *Kewanee Oil Co. v. Bircon Corp.*, 416 U.S. 470, 493 (1974).

system should promote industries to continue to develop new technologies that spur growth and create jobs across the country which includes protecting the rights of small business and inventors from predatory behavior that could result in the cutting off of innovation.”<sup>9</sup>

Manufacturers frequently rely upon trade secret law to protect the unpatented aspects of their manufacturing processes, while patenting others. The ITC’s decision undermines these protections by converting common commercial practices into invalidating prior art by allowing process patents to be invalidated, not by a disclosure of the process, but instead based on sales of an end-product resulting from indisputably secret process. Instead of promoting the development of new technology, the ITC’s decision weakens patent rights by finding a common industry practice to be invalidating and risks “cutting off . . . innovation.”<sup>10</sup>

## **II. The ITC’s Decision Disturbs Settled Expectations of Manufacturers**

The ITC’s decision is inconsistent with manufacturers’ well-supported expectations. Specifically, the decision undermines the goals of the AIA by creating inconsistencies between U.S. and international patent law. Additionally, the decision ignores explicit changes to the language of Section 102 of the Patent Act and the reasoning behind those changes.

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<sup>9</sup> Leahy-Smith America Invents Act, Pub. L. 112-29, 125 Stat. 284, 112th Cong. § 3 (2011) [hereinafter “AIA”].

<sup>10</sup> *See id.*

## A. The AIA Was Meant to Harmonize US and Global Patent Law

Harmonization is a major goal of the AIA. The Senate Report recommending passage of the AIA identifies “harmonizing our system for granting patents with the best parts of other major patent systems throughout the industrialized world for the benefit of U.S. patent holders” as a key concern of Congress in enacting the AIA.<sup>11</sup> The goal of harmonization is further reflected in the AIA’s text. For example, and most famously, Section 3 of the AIA states that, with respect to the implementation of a first-to-file rule:

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*.<sup>12</sup>

Importantly, advocates of the AIA, including NAM and its members, specifically asserted that “[a] major component of any harmonization treaty should be the maintenance of the right to obtain patent protection so long as the acts of the inventor are not publicly accessible to persons of ordinary skill in the art.”<sup>13</sup> Thus,

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<sup>11</sup> See S. Rep. No. 111-18 (2009).

<sup>12</sup> See AIA, § 3(p) (emphasis added).

<sup>13</sup> *Implementation of America Invents Act: Hearing on H.R. 1249 Before the H. Comm. on the Judiciary*, 2012 WL 1703949 (2012) (statement of Robert A. Armitage, General Counsel, Eli Lilly & Co.).

the AIA's goal of harmonization is particularly important in the context of determining prior art and patentability.

Harmonizing U.S. and global patent law depends on the consistent treatment of processes across regimes, including consistency in determining whether certain actions by an inventor result in a loss of right to patent. The ITC's decision disrupts and undermines the Congressional goal of harmonizing American and global patent law by creating an inconsistency between the treatment of trade secret processes in the United States and abroad. In the European patent system, for example, "the governing principle . . . is that of a public teaching."<sup>14</sup> As a result, "the concept of forfeiture as barring patentability is not recognized by the [European Patent Convention]."<sup>15</sup> Thus, under the European regime, "a secret/non-disclosing use of an invention does not make the invention 'available to the public'" and does not undermine patentability.<sup>16</sup> Maintaining consistency between American and international patent systems necessarily requires the "maintenance of the right to obtain patent protection so long as the acts of the inventor are not publicly accessible" and the elimination of forfeiture based on the public sale of an end

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<sup>14</sup> See Dale Bjorkman, Gilbert Voortmans, Lindsay M. Block, "Made available to the public" – *Understanding the differences of the America Invents Act from the European patent convention in its definition of prior art*, 4 *Cybaris An Intell. Prop. L. Rev.* 191, 211 (2013).

<sup>15</sup> *Id.*

<sup>16</sup> *Id.*

product created through a secret, undisclosed process.<sup>17</sup> Because the ITC’s decision would create inconsistencies between U.S. and international patent law—directly contradicting the AIA’s goal of harmonization—it should be reversed.

**B. The ITC’s Decision Was Unexpected and Inconsistent with Explicit Changes to the Language of the On-Sale Bar**

American businesses, including manufacturers, rely upon predictability in the law. Because manufacturing plays such a significant role in the U.S. economy, consistency and predictability in the law are also vital to the economy as a whole. Predictability in the law is particularly important in the context of innovation and intellectual property, where manufacturers are averse to taking action that could jeopardize their intellectual property rights. In that context, unpredictability risks chilling innovation. The ITC’s decision—which was contrary to both the language and the purpose of the AIA—was an unpredictable surprise.

**1. The ITC ignored the plain meaning of additional language that Congress added to the AIA**

The AIA modified Section 102 of the Patent Act by inserting the word “claimed” before “invention” and stating that the AIA’s patentability bars apply only where the “claimed invention” was “patented, described in a printed publication, or in public use, on sale, or otherwise available to the public” before the patent was

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<sup>17</sup> *Id.*

filed.<sup>18</sup> The AIA defines “claimed invention” as “the subject matter defined by a claim in a patent or an application for a patent.”<sup>19</sup> The plain terms of the AIA render Section 102’s on-sale bar inapplicable to a claimed invention of an *undisclosed process* used to create an unpatented end-product placed on sale.

Where statutory language is “clear and unambiguous, . . . the plain meaning of the statute is generally conclusive, and [courts] give effect to the unambiguously expressed intent of Congress.”<sup>20</sup> Accordingly, manufacturers, such as NAM’s members, had good reason to rely on the AIA’s clear language. The ITC ignored the meaningful addition of “claimed invention” to Section 102 when it concluded that “Congress did not alter the meaning of the on-sale bar provision when it enacted the AIA.” That not only misinterprets the statute’s language, it disrupts the well-founded expectations of stakeholders.

## **2. Congress intended to eliminate forfeiture provisions by adding the phrase “available to the public” to Section 102**

The ITC’s decision ignored clarifying language added to Section 102. In particular, Congress added the phrase “available to the public”<sup>21</sup> as a catchall phrase

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<sup>18</sup> Compare 35 U.S.C. § 102 (pre-AIA) with *id.* (post-AIA).

<sup>19</sup> 35 U.S.C. § 100(j).

<sup>20</sup> *E.g.*, *Athey v. U.S.*, 908 F.3d 696, 707 (Fed. Cir. 2018); *Hyatt v. U.S.P.T.O.*, 904 F.3d 1361, 1374 (Fed. Cir. 2018) (“When the language of the statute is clear and unambiguous, the plain meaning of the statute is conclusive absent special circumstances.”).

<sup>21</sup> Compare 35 U.S.C. § 102 (pre-AIA) with *id.* (post-AIA).

to capture material otherwise covered by the patent bar that does not fit into a different category of the bar—*i.e.* patented, described in a printed publication, or in public use, on sale. This change was intended to “emphasize the fact that [prior art] must be *publicly accessible*” for the bar to apply.<sup>22</sup> Advocates of this language explained the necessity of the “available to the public” language:

The ‘available to the public’ standard was employed in part, according to this analysis, *to overrule old ‘loss of right to patent’ provisions, most notable among which were the ‘forfeiture provisions’ in pre-AIA 102(b) in which an inventor’s secret offer for sale or secret use of an invention, once deemed ‘ready for patenting,’ would bar the inventor from seeking a valid patent for the invention unless the patent was sought within the one-year period from the date of such a secret undertaking.* . . . Thus, one of the primary objectives of . . . the supporters of H.R. 1249 was to assure that secret, private, confidential or otherwise non-public acts of the inventor would no longer constitute a ‘forfeiture’ of the inventor’s right to secure a patent on the invention.<sup>23</sup>

In other words, Congress intended for prior art to include only that which is available to the public and not secret in nature.<sup>24</sup> Accordingly, trade secret processes which remain undisclosed to the public should remain patentable even if the end-product resulting from those processes is disclosed or sold.

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<sup>22</sup> See H.R. Rep. No. 112-98, at 43 (2011) (emphasis added).

<sup>23</sup> *Implementation of America Invents Act: Hearing on H.R. 1249 Before the H. Comm. on the Judiciary*, 2012 WL 1703949 (2012) (emphasis added).

<sup>24</sup> See *id.*

Legislative history further confirms that Congress intended Section 102 to be consistent with other amendments to the Patent Act, which represented a significant change from pre-AIA law:

By adopting the first-to-file system . . . the present bill already provides ample incentive for an inventor to enter the patent system promptly. There is no need to also require forfeiture of patents simply because the inventor has made some use of the invention that has not made the invention available to the public. And the current on-sale bar imposes penalties not demanded by any legitimate public interest. There is no reason to fear ‘commercialization’ that merely consists of a secret sale or offer for sale but that does not operate to disclose the invention to the public.<sup>25</sup>

Significantly, the legislative history indicates that “contrary construction of section 102(a)(1), which allowed private and non-disclosing uses and sales to constitute invalidating prior art, would be *fairly disastrous* for the U.S. patent system.”<sup>26</sup>

When an entity sells its end product without disclosing the process through which that end product is created, only the end product—not the process—is available to the public. In such a transaction, the purchaser of the product, and the public at large, remain unaware of any secret process used in manufacturing the end product. The addition of “available to the public” to Section 102 reflects this understanding and allows the sale of an end product, without disclosure of the secret process by which the product was made, without creating a bar to patenting of that

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<sup>25</sup> 157 Cong. Rec. S1360-02 (daily ed. March 8, 2011) (statement of Sen. Kyl).

<sup>26</sup> *Id.* (emphasis added).

process.<sup>27</sup> Because the ITC’s decision fails to acknowledge this important change to the patentability bars, it should be reversed.

**3. Congress chose to exclude language that would render the “useful end result” of a process prior art for that process**

Not only did Congress include new language in Section 102 of the AIA which indicates that secret processes are not invalidating prior art—it also chose to *exclude* from Section 102 language covering sales of the “useful end result” of a claimed process. Where “Congress has shown that it knows how to adopt . . . omitted language,” it is inappropriate for courts to insert absent language into a statutory provision.<sup>28</sup> Indeed, “[w]hen Congress includes particular language in one section of a statute but omits it in another, [courts] presume that Congress intended a difference in meaning.”<sup>29</sup>

Two sections of the Patent Act indicate that Congress did not intend for sales of the end product resulting from a secret process to trigger the on-sale bar of the AIA. First, in § 273, Congress created a prior-use infringement defense which applies to the use of “subject matter consisting of a process” which “would otherwise infringe a claimed invention.”<sup>30</sup> Under that section, it is a defense to patent

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<sup>27</sup> See 35 U.S.C. § 102; H.R. Rep. 112-98, at 43; 157 Cong. Rec. S1360-02; *Hearing on H.R. 1249 Before the H. Comm. on the Judiciary*, 2012 WL 1703949.

<sup>28</sup> *Rotkiske v. Klemm*, 140 S. Ct. 355, 361 (2019).

<sup>29</sup> *Digital Realty Tr., Inc. v. Somers*, 138 S. Ct. 767, 777 (2018).

<sup>30</sup> 35 U.S.C. § 273(a).

infringement where the defendant, “acting in good faith, commercially used the subject matter in the United States . . . in connection with . . . an actual arm’s length sale . . . of a *useful end result* of such commercial use. . . .”<sup>31</sup> Congress could have included this “useful end result” language in the AIA’s on-sale bar, but chose not to. The Court should therefore “presume that Congress intended a difference in meaning” in declining to state that sales of a “useful end result” would trigger the on-sale bar for a patented process.<sup>32</sup> The ITC’s decision improperly reads this language into the AIA’s on-sale bar<sup>33</sup> and should be reversed.

Second, 35 U.S.C. § 271 and the case law interpreting it indicate that Congress understood how to refer to sales of a patented process and chose not to do so in the AIA’s on-sale bar. Section 271(a) states that “whoever without authority . . . offers to sell, or sells any *patented invention*, within the United States . . . infringes the patent.” Courts have held that, under this provision, the “sale of a product made by a patented process does not itself infringe the patent.”<sup>34</sup> Section 271(g), by contrast, provides for liability as an infringer to whoever “without authority imports into the United States or offers to sell, sells, or uses within the United States a product which is made by a process patented in the United States.” This specific language creates

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<sup>31</sup> *Id.* (emphasis added).

<sup>32</sup> *Digital Realty Tr., Inc.*, 138 S. Ct. at 777.

<sup>33</sup> *Rotkiske*, 140 S. Ct. at 361.

<sup>34</sup> *U.S. v. Studiengesellschaft Kohle, m.b.H.*, 670 F.2d 1122, 1127-28 (D.C. Cir. 1981)

a different result from § 271(a) by explicitly allowing a finding of liability based on the sale of a product created by a patented process.<sup>35</sup> These subsections of the provision governing infringement indicate that Congress knew how to distinguish sales of a product resulting from a patented process. Congress’s decision not to do so in § 102 indicates that such sales are not included in the AIA’s on-sale bar.<sup>36</sup>

**4. The title of Section 102(a) reflects Congressional intent to eliminate the forfeiture doctrine**

Changes to Section 102’s subsection title further reflect the intent to exclude from the on-sale bar’s reach a secret, undisclosed process used to create a product for public sale. The Supreme Court has explained that the “title of a statute and the heading of a section are tools available for the resolution of a doubt about the meaning of a statute.”<sup>37</sup> Any “doubt about the meaning” of the AIA’s § 102 is resolved by its title. When Section 102 was first enacted, it was titled “Conditions for patentability; novelty and loss of right to patent.”<sup>38</sup> When Congress enacted the AIA’s § 102, it struck the “loss of right” language.<sup>39</sup> This change is meaningful. Under the original § 102, courts held that sale of the end product derived from a

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<sup>35</sup> Compare 35 U.S.C. § 271(g) with 35 U.S.C. § 271(a).

<sup>36</sup> *Rotkiske*, 140 S. Ct. at 361.

<sup>37</sup> *E.g.*, *Porter v. Nussle*, 534 U.S. 516, 528, 122 S. Ct. 983, 990 (2002).

<sup>38</sup> Pub. L. 82-593, 66 Stat. 792, 797 (1952).

<sup>39</sup> AIA, § 3(b)(1) (2011); 35 U.S.C. § 102.

secret process resulted in the forfeiture—the “loss of right” to patent that process.<sup>40</sup> The elimination of the “loss of right” language from the title of Section 102 stands in stark contrast to the judicially-created forfeiture doctrine. Thus, Congress’s explicit elimination of “loss of right” from the title of Section 102 reflects an intent to eliminate the forfeiture doctrine.

### 5. *Helsinn* does not foreclose patentability in this case

The ITC mistakenly relied on *Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.*, 139 S. Ct. 628 (2019) to conclude that the AIA’s on-sale bar precluded patentability. In *Helsinn*, the Supreme Court addressed whether the public sale of a product that did not disclose the details of the claimed invention, could trigger Section 102’s on-sale bar and held that it could. According to the Court, “Congress did not alter the meaning of ‘on sale’ when it enacted the AIA.”<sup>41</sup>

But the issue in this case is not the meaning of the phrase “on sale,” which the AIA did not modify. Instead, this case turns on new language that Congress added to the on-sale bar, including “claimed invention” and “available to the public.” For the reasons described above, that language was intended to affect a significant change to the on-sale bar, and it was simply not at issue in *Helsinn*. Moreover, unlike

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<sup>40</sup> See *Metallizing Eng’g Co., Inc. v. Kenyon Bearing & Auto Parts Co., Inc.*, 152 F.2d 516, 520 (2d Cir. 1946); *D.L. Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 1147 (Fed. Cir. 1983).

<sup>41</sup> 139 S. Ct. at 630, 634.

in *Helsinn*, here, there was no sale of the claimed invention at issue—a secret manufacturing process—only a sale of the product created by that process. Accordingly, *Helsinn* is inapposite.

Indeed, the Supreme Court’s interpretation of the on sale-bar pre- and post-AIA comports with this conclusion. Under Supreme Court precedent, “an invention [is] ‘on sale’ . . . when it [is] ‘the subject of a commercial offer for sale’ and ‘ready for patenting.’”<sup>42</sup> The Supreme Court has long construed section “102 of the Patent Act . . . as a limiting provision, both excluding ideas that are *in the public domain* from patent protection and confining the duration of the monopoly to the statutory term.”<sup>43</sup> This Court, however, strayed from the Supreme Court’s precedent in holding that section 102’s on-sale bar can apply to unsold secret processes. Congress used the plain text of the AIA to clarify as much. *Helsinn* says nothing to the contrary.

Accordingly, the Supreme Court’s finding of Congressional ratification in *Helsinn* is irrelevant here, where Congress did not “simply reenact” the relevant language “without change.”<sup>44</sup> The ITC’s decision, therefore, was unexpected and inconsistent with the reasonable expectations of U.S. manufacturers.

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<sup>42</sup> *Id.* at 630 (quoting *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 67 (1998)).

<sup>43</sup> *Pfaff*, 525 U.S. at 64 (emphasis added).

<sup>44</sup> *Jama v. Immigration & Customs Enf’t*, 543 U.S. 335, 349 (2005).

### III. CONCLUSION

The Court should reverse the ITC's determination and hold that the sale of an unpatented end product made by a secret process is not an on-sale bar to the patenting of that process.

Dated: October 28, 2022

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This brief complies with the type-volume limitations of Federal Circuit Rule 29(b) because it contains 4,327 words and 398 lines excluding the parts of the brief excluded by Fed. R. App. P. 32(f) and Federal Circuit Rule 32(b)(2), as determined by the word-counting feature of Microsoft Word, and is therefore not more than one half of the maximum page length authorized for a party's principal brief.

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Dated: October 28, 2022

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