Forrest Gothia Authors IP Watchdog Article on Lessons Learned in Commercial Offers for Sale

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PRACTICES Intellectual Property, Design Patents, Mechanical, Patents, Patent Prosecution and Counseling, Chemical, Oil and Gas

Recently, the U.S. Court of Appeals for the Federal Circuit (CAFC) further explained the "on-sale" bar in *Junker v. Medical Components, Inc.*, Case No. 2021-1649 (Feb. 10, 2022). As previously reported here, the case hinged on whether a letter between Larry Junker's business partner and Boston Scientific Corporation (BSC) was a "commercial offer for sale" before the one-year grace period took effect. The CAFC held that all necessary terms for a commercial offer were present in the letter, and therefore, the letter qualified as a commercial offer for sale invalidating Junker's patent.

On-Sale Bar

According to the patent statute, "a person shall be entitled to a patent unless…the invention was… 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-America Invents Act (AIA) 35 U.S.C. § 102(b). Although the case was examined under pre-AIA 35 U.S.C. § 102, the analysis is analogous to post-AIA 35 U.S.C. § 102 following the Supreme Court's ruling that the AIA's on-sale bar analysis remains unchanged from pre-AIA (aside from AIA § 102 not requiring that the sale happen "in this country"). *Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc*. 139 S. Ct. 628 (2019). Additionally, even though this case involved a design patent, the on-sale bar of § 102 applies evenly to design, plant, and utility patents and applications.

To trigger the on-sale bar, the invention must:

(1) be the subject of a commercial offer for sale, and

(2) the invention must be ready for patenting.

Excerpted from *IP Watchdog*. Read more here.