United States of America

“Helsinn Healthcare v. Teva Pharmaceuticals USA”

Decision of the Supreme Court of the United States

22 January 2019 – Case No. 17-1229

Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.

35 U.S.C. §102(a)

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Keywords Secret sales · Confidentiality agreement · Prior art · Sales before filing · Invention availability before filing date · Concept of “on sale”

I. JUSTICE THOMAS delivered the opinion of the Court.

The Leahy-Smith America Invents Act (AIA) bars a person from receiving a patent on an invention that was “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). This case requires us to decide 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). More than 20 years ago, this Court determined that an invention was “on sale” within the meaning of an earlier version of §102(a) when it was “the subject of a commercial offer for sale” and “ready for patenting.” *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 67 (1998). We did not further require that the sale make the details of the invention available to the public. In light of this earlier construction, we determine that the reenactment of the phrase “on sale” in the AIA did not alter this meaning. Accordingly, a commercial sale to a third party who is required to keep the invention confidential may place the invention “on sale” under the AIA.

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