

**Helsinn Healthcare: Does § 102 Abrogate Metallizing Engineering?**

In *Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.*, Fed. Cir. 2016-1284, the Federal Circuit is expected to consider whether the secret commercialization bar of *Metallizing Engineering* survives the redrafting of 35 USC §102 in the *Leahy Smith America Invents Act*.

**Amicus Brief of The Naples Roundtable, Inc.:** As *amicus curiae*, The Naples Roundtable, Inc., a nonprofit 501(c)3 organization, provides a comprehensive analysis of the harmonization objectives of the *Leahy Smith America Invents Act* in the context of its new Section 102 that implements the first-inventor-to-file system. The organization's brief provides a comparative analysis of the laws of major countries of the world, while also delving into the weak foundation of *Metallizing Engineering* as explained by patent law expert Professor Karshedt.

A copy of the amicus brief of The Naples Roundtable, Inc. is attached.

Regards,

Hal

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

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HELSINN HEALTHCARE S.A., ROCHE PALO ALTO LLC,  
*Plaintiffs-Appellees,*

v.

TEVA PHARMACEUTICALS USA, INC., TEVA PHARMACEUTICAL  
INDUSTRIES, LTD.,  
*Defendants-Appellants.*

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On Appeal from the United States District Court for the District of New Jersey, in  
Nos. 3:11-cv-03962-MLC-DEA, 3:11-cv-05579-MLC-DEA, 3:13-cv-05815-MLC-  
DEA, Judge Mary L. Cooper

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**BRIEF OF *AMICUS CURIAE* THE NAPLES ROUNDTABLE, INC.  
IN SUPPORT OF PLAINTIFFS-APPELLEES**

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## CERTIFICATE OF INTEREST

Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc., No. 16-1284

Counsel for *amicus curiae* the Naples Roundtable certify the following:

1. The full name of every party or *amicus* represented by us is:

The Naples Roundtable, Inc.

2. The names of the real party in interest represented by us is:

Not applicable.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or *amicus curiae* represented by me are:

The Naples Roundtable has no parent corporation and no publicly traded company owns 10% or more of its stock.

4. The names of all law firms and the partners or associates that appeared for the party or *amicus* now represented by me in the trial court or agency or are expected to appear in this court are:

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Dated: April 27, 2016

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## INTEREST OF AMICUS

The Naples Roundtable, Inc. is a 501(c)(3) non-profit organization whose primary mission is the exploration of ways to improve and strengthen the patent system.<sup>1</sup> To achieve this goal, the Naples Roundtable is engaged in the advanced study of international intellectual property law and policy, in fostering the exchange of ideas, viewpoints, and scholarly papers among leading jurists and practitioners in the intellectual property field, and in organizing conferences and other public events. More information about the Naples Roundtable can be found at *www.thenaplesroundtable.org*. None of the Naples Roundtable, the individuals on its Board of Directors, or its counsel have any personal interest in the outcome of this case.<sup>2</sup>

## SUMMARY OF ARGUMENT

The district court's well-reasoned and detailed opinion that the Leahy-Smith America Invents Act ("AIA") eliminated secret commercialization as prior art, thus

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<sup>1</sup> In accordance with Fed. R. App. P. 29 (c)(5), amicus curiae state that (A) no party's counsel authored this brief in whole or in part, (B) no party or its counsel contributed money that was intended to fund preparing or submitting this brief, and (C) no person other than the amicus curiae, its members, or its counsel contributed money that was intended to fund preparing or submitting this brief. The parties have consented to the filing of this brief. *See* FED. R. APP. P. 29(a).

<sup>2</sup> Judges Richard Linn and Kathleen O'Malley are named as honorary members of the Naples Roundtable's Advisory Committee, which is independent from its Amicus Committee and its Board. Judges Linn and O'Malley took no part in any discussion of this case or in the decision to file or preparation of this brief.



statutorily overruling *Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F.2d 516 (2d Cir. 1946), should be affirmed. Indeed, the language added to 35 U.S.C. § 102(a)(1) is plain and unambiguous in requiring prior art to be “available to the public” and thus not secret. This change in the law is also consistent with the overall objectives and policies behind passage of the AIA.

Congress made its intentions clear in two “sense of Congress” provisions it included in the AIA. Those provisions expressly state that the objectives and policies behind the first-inventor-to-file regime embodied in revised § 102 include “harmonization of the United States patent system” with those commonly used throughout the world, as well as achieving “greater certainty regarding the scope of protection” provided by U.S. patents. *See Leahy-Smith America Invents Act of 2011*, Pub. L. No. 112-29, §§ 3(o)-(p), 125 Stat. 284, 293 (2011). First, because the vast majority of patent applications filed outside the United States are filed in jurisdictions where secret commercialization is not regarded as prior art, the elimination of this category of prior art brings the U.S. patent system in line with the rest of the world. Second, the AIA’s abrogation of *Metallizing* furthers Congress’ goal of achieving greater certainty by making it easier to determine what is or is not prior art without resorting to expensive discovery, and fits logically within the policy framework of a first-inventor-to-file system.

## ARGUMENT

### I. The District Court Properly Interpreted the Plain Language of the AIA

The first inquiry in statutory interpretation “is to determine whether the language at issue has a plain and unambiguous meaning with regard to the particular dispute in the case. [This] inquiry must cease if the statutory language is unambiguous and the statutory scheme is coherent and consistent.” *Bettcher Indus., Inc. v. Bunzl USA, Inc.*, 661 F.3d 629, 644 (Fed. Cir. 2011) (internal quotation and citation omitted).

In this case, the inquiry can and should end here. The district court opinion contains a thorough and well-reasoned analysis of the new statutory language—“or otherwise available to the public”—which aptly demonstrates why secret commercialization no longer constitutes prior art. *Helsinn Healthcare S.A. v. Dr. Reddy's Labs., Ltd.*, No. 11-3962 (MLC), 2016 BL 65089, at \*44-45 (D.N.J. Mar. 03, 2016). Indeed, the district court’s reliance on *Finisar Corp. v. DirectTV Grp., Inc.*, 523 F.3d 1323 (Fed. Cir. 2008), for the proposition that “[w]hen a modifier is set off from a series of antecedents by a comma, the modifier should be read to apply to each of those antecedents,” *id.* at 1336, finds direct support for its application to the precise AIA language at issue, in both the legislative history as well as from an industry leader directly involved in the drafting of the statute. *See* 157 Cong. Rec. S1360, 1370 (daily ed. Mar. 8, 2011) (statement of Sen. Jon Kyl)

(expressly noting application of *Finisar* to the very phrase in § 102(a)(1) at issue); *see also*, Robert A. Armitage, *Understanding the America Invents Act and Its Implications for Patenting*, 40 AIPLA Q.J. 1, 58 (2012) (explaining same).

## **II. The “Sense of Congress” Provisions of the AIA Support the District Court’s Interpretation of the AIA**

Should this Court, however, deem it necessary to inquire beyond the plain language of § 102(a)(1), the clearly expressed objectives and policies behind the AIA, found within the statute itself, further support the district court’s conclusion.

In *Richards v. United States*, the Supreme Court stated a basic canon of statutory construction:

We believe it fundamental that a section of a statute should not be read in isolation from the context of the whole Act, and that in fulfilling our responsibility in interpreting legislation, “we must not be guided by a single sentence or member of that sentence, but [should] look to the provisions of the whole law, and to its object and policy.”

369 U.S. 1, 11 (1962) (quoting *Mastro Plastics Corp. v. Labor Board*, 350 U.S. 270, 285 (1956)). *See also* 1A NORMAN SINGER & J.D. SHAMBIE SINGER, STATUTES AND STATUTORY CONSTRUCTION § 25:3 (7th ed. 2008) (“The statute should be construed according to its subject matter and the purpose for which it was enacted.”).

Sometimes the object and policy behind a statute are readily discernible because they are expressly stated in provisions indicating the “sense of Congress.”

In such instances, courts have found while “[such] language is precatory and merely reflects a policy statement, nevertheless, such language can be useful in resolving ambiguities in statutory construction.” *State Highway Comm’n of Mo. v. Volpe*, 479 F.2d 1099, 1116 (8th Cir. 1973). Indeed, there are numerous examples of courts, including the Supreme Court, expressly relying upon “sense of Congress” statements in legislation when determining the meaning of statutory provisions. *See, e.g., Accardi v. Pennsylvania R.R.*, 383 U.S. 225, 229 (1966) (Selective Training and Service Act of 1940); *Hanson v. Espy*, 8 F.3d 469, 476 (7th Cir. 1993) (Disaster Assistance Act of 1988); *United States v. Ellis*, 714 F.2d 953, 955-56 (9th Cir. 1983) (Consolidated Farm and Rural Development Act of 1961).

The AIA contains two express statements of the “sense of Congress” directly pertinent to the issue in this case:

(o) SENSE OF CONGRESS.—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 promote the progress of science and the useful arts by securing for limited times to inventors the exclusive rights to their discoveries and provide inventors with greater certainty regarding the scope of protection provided by the grant of exclusive rights to their discoveries.

(p) SENSE OF CONGRESS.—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 §§ 3(o)-(p).

As explained below, both of these provisions support the district court's interpretation.

**A. Requiring Prior Art be Public is Consistent with the Intention that the AIA Achieve Harmonization of the U.S. Patent System with those Commonly in use Worldwide**

It is beyond question that interpreting the AIA to require that prior art be public is consistent with Congress's stated goal, set forth in AIA § 3(p), of harmonizing the U.S. patent system with those commonly used worldwide. Indeed, as explained below, the four other members of the IP5 Offices ("IP5"),<sup>3</sup> which receive and examine the vast majority of all patent applications filed throughout the world,<sup>4</sup> all require that commercialization of an invention be public in order to

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<sup>3</sup> IP5 Offices, [www.fiveipoffices.org](http://www.fiveipoffices.org) (China, European Patent Office, Japan, Republic of Korea, and the United States).

<sup>4</sup> According to the World Intellectual Property Organization, 2,680,990 patent applications were filed worldwide in 2014. Of those, 2,195,922 patent applications were filed, either directly or as national stage entries of the PCT, in the national filing office of the IP5. Therefore, the IP5 received 81.9% of all patent applications filed in 2014. The United States accounted for 26.4% of the IP5 applications

qualify as prior art.

## Europe

### Article 54(2)

The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.

European Patent Convention art. 54, Oct. 5, 1973, 13 I.L.M 268 (available at <https://www.epo.org/law-practice/legal-texts/html/epc/2013/e/ar54.html>).

### 7.2.2 Agreement on secrecy

The basic principle to be adopted is that subject-matter has not been made available to the public by use or in any other way if there is an express or tacit agreement on secrecy which has not been broken, or if the circumstances of the case are such that such secrecy derives from a relationship of good faith or trust. Good faith and trust are factors which may occur in contractual or commercial relationships. Reference should be made to the particular case of a non-prejudicial disclosure arising from an evident abuse in relation to the applicant, in accordance with Art. 55(1)(a) (see below, G-IV, 7.3.2; G-V).

EUROPEAN PATENT OFFICE, GUIDELINES FOR EXAMINATION IN THE EPO PART G IV-9 (2015) (available at <https://www.epo.org/law-practice/legal-texts/guidelines.html>).

What can be considered as part of the state of the art is laid down in Article 54(2) EPC as everything made available to the public by means of a written or oral description, by use or in any other way,

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received, and represented 21.6% of all applications filed globally. *See* WORLD INTELLECTUAL PROPERTY ORGANIZATION, WIPO IP Statistics Data Center, <http://ipstats.wipo.int/ipstatv2/keyindex.htm> (last visited April 22, 2016).

before the date of filing of the European patent application. The case law (see Case Law of the Boards of Appeal of the European Patent Office, 4th edition 2001 Section I.C.1.6.6) accepts that information is "available to the public" if only a single member of the public is in a position to gain access to it and understand it, and if there is no obligation to maintain secrecy. However in every such case (see also T 932/96 of 16 June 1998 points 2.4.4.4 and 2.4.4.5, or T 11/99 of 10 October 2000 points 1.2.1 and 1.2.2) the information was made available to one or more persons who at the time of the information being made available could be described as a member or members of the public.

*Acetals/New Japan Chemical*, Case T 1081/01, slip. op. at ¶ 5 (E.P.O. Enlarged Bd. App. Sept. 27, 2004) (available at: <http://www.epo.org/law-practice/case-law-appeals/pdf/t011081eu1.pdf>).

## **China**

### Article 22

22.1 Inventions and utility models for which patent rights are to be granted shall be ones which are novel, creative and of practical use.

22.2 Novelty means that the invention or utility model concerned is not an existing technology; no patent application is filed by any unit or individual for any identical invention or utility model with the patent administration department under the State Council before the date of application for patent right, and no identical invention or utility model is recorded in the patent application documents or the patent documentations which are published or announced after the date of application.

22.3 Creativity means that, compared with the existing technologies, the invention possesses prominent substantive features and indicates remarkable advancements, and the utility model possesses substantive features and indicates advancements.

22.4 Practical use means that the said invention or utility model can be used for production or be utilized, and may produce positive results.

22.5 For the purposes of this Law, existing technologies mean the technologies known to the public both domestically and abroad

before the date of application.

Patent Law of the People's Republic of China art. 22 (China) (available at [http://english.sipo.gov.cn/laws/lawsregulations/201101/t20110119\\_566244.html](http://english.sipo.gov.cn/laws/lawsregulations/201101/t20110119_566244.html)).

## 2.1 Prior Art

According to Article 22.5, the prior art means any technology known to the public before the date of filing in China or abroad. The prior art includes any technology which has been disclosed in publications in China or abroad, or has been publicly used or made known to the public by any other means in China or abroad, before the date of filing) or the priority date where priority is claimed).

The prior art shall be the technical contents that are available to the public before the date of filing. In other words, the prior art shall be in such a state that it is available to the public before the date of filing and shall contain such contents from which the public can obtain substantial technical knowledge.

It should be noted that technical contents in the state of secrecy are not part of the prior art. The state of secrecy includes not only the situation where the obligation to keep secret arises from regulations or agreements regarding confidences but also the situation where the obligation to keep secret arises from social customs or commercial practices, that is, from implicit agreements or understandings.

However, if a person having the obligation to keep secret breaches the regulation, agreement, or implicit understanding, rendering the technical contents disclosed and making the technologies available to the public, these technologies shall form part of the prior art.

STATE INTELLECTUAL PROPERTY OFFICE OF THE PEOPLE'S REPUBLIC OF CHINA,  
GUIDELINES FOR PATENT EXAMINATION 171-72 (2010) (China) (available at <http://www.sipo.gov.cn/zlsqzn/sczn2010eng.pdf>).

### 2.1.2.2 Disclosure by Use

Disclosure by use means that by use the technical solution is disclosed or placed in the state of being available to the public.

Means of disclosure by use include making, using, selling,



importing, exchanging, presenting, demonstrating, exhibiting and the like that can make the technical content available to the public. So long as by the above means the relevant technical content is placed in such a state that the public can know it if they wish, disclosure by use can be established, and it is of no relevance whether the public had actually known it. However, of at an exhibition or demonstration of a product no explanation of the technical contents thereof is provided so that the structure and function or compositions of the product is not known to person skilled in the art, the exhibition or demonstration does not constitute a disclosure by use.

Where disclosure by use is concerned with a product, it can be established even if the product or device used needs to be destroyed to get its structure and function known. Moreover, disclosure by use also includes disclosure on an exhibition stand or in a shop window of informative materials that are readable by the public or directly visible materials, such as posters, drawings, photographs, specimens, and samples.

The date on which the product or process is available to the public shall be regarded as the date of disclosure by use.

*Id.* at 173.

## **Korea**

### Article 29 (Requirements for Patent Registration)

(1) Inventions having industrial applicability may be patentable unless they fall under any of the following paragraphs:

1. Inventions publicly known or worked in the Republic of Korea or in a foreign country prior to the filing of the patent application;
2. Inventions described in a publication distributed in the Republic of Korea or in a foreign country prior to the filing of the patent application or inventions made accessible to the public through telecommunication lines prescribed by Presidential Decree.

Patent Act (Act No. 950 as amended up to Act. No. 11,117), art. 29(1)

(2011) (S. Kor.) (available at [http://www.wipo.int/wipolex/en/text.jsp?file\\_id=281593](http://www.wipo.int/wipolex/en/text.jsp?file_id=281593)).

### 3.1 Publicly Known Invention

A “publicly known” invention means an invention the contents of which have been known to an unspecified person without obligation of secrecy in the Republic of Korea or a foreign country prior to the filing of the application. The time of filing in the “prior to the filing of the application” refers to the exact point of time of filing, even to the hour and minute of the filing (if the invention is publicly known, the time is converted into Korean time). It does not mean the concept of the date of filling. “Unspecified persons” refers to the general public who does need to abide by secret observance duty.

### 3.2 Publicly Worked Invention

A “publicly worked” invention means an invention which has been worked under the conditions where the contents of the invention are to be publicly known or can potentially be publicly known in the Republic of Korea or a foreign country (Definition of "working" refers to the Patent Act Article 2). Also, “being public” means a situation where it is no longer kept in secret. So, even when a small fraction of inner part of an invention is kept in secret with regard to working of the invention, it shall not be considered as a publicly worked invention.

KOREAN INTELLECTUAL PROPERTY OFFICE, PATENT EXAMINATION GUIDELINES  
208-09 (2013) (S. Kor.) (available at [http://www.kipo.go.kr/upload/en/download/patent\\_examination\\_guidelines\\_2013\\_07.pdf](http://www.kipo.go.kr/upload/en/download/patent_examination_guidelines_2013_07.pdf)).

## **Japan**

### Article 29(1)

An inventor of an invention that is industrially applicable may be entitled to obtain a patent for the said invention, except for the following cases:

- (i) inventions that were publicly known in Japan or a foreign country prior to the filing of the patent application;
- (ii) inventions that were publicly worked in Japan or a foreign country prior to the filing of the patent application; or
- (iii) inventions that were described in a distributed publication,

or inventions that were made publicly available through an electric telecommunication line in Japan or a foreign country prior to the filing of the patent application.

Patent Act (Act No. 121 of April 13, 1959, as amended up to Act No. 36 of May 14, 2014), art. 29(1) (1959) (Japan) (available at <http://www.wipo.int/edocs/lexdocs/laws/en/jp/jp198en.pdf>).

### 3.1.3 Publicly known prior art (Article 29(1)(i))

‘Publicly known prior art’ means prior art which has become known to anyone as an art without an obligation of secrecy (Note).

(Note) Prior art disclosed by a person on whom obligation of secrecy is imposed to another person who are not aware of its secrecy is ‘publicly known prior art’ irrespective of the inventor’s or applicant’s intent to keep it secret. Generally, an article of academic journal would not be put in public view even if it was just received. Therefore, prior art described in the article is not ‘publicly known prior art’ until the article is published.

‘Publicly known prior art’ often become known in lecture, briefing session and so on generally. In this case, the examiner specifies the prior art on the basis of the matters explained in the lecture, briefing session and so on. In interpreting the explained matters, the examiner may use the matters derived by a person skilled in the art as a base for specifying ‘publicly known prior art’ by considering the common general knowledge at the time of the lecture, briefing session and so on.

JAPANESE PATENT OFFICE, EXAMINATION GUIDELINES FOR PATENT AND UTILITY MODEL IN JAPAN, Part III, ch. 2, § 3, at 6 (2015) (Japan) (available at: [https://www.jpo.go.jp/tetuzuki\\_e/t\\_tokkyo\\_e/files\\_guidelines\\_e/03\\_0203\\_e.pdf](https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/files_guidelines_e/03_0203_e.pdf)).

Interpreting the AIA to retain the secret prior art regime of *Metallizing*, as appellants urge in this case, would frustrate Congress’s stated objective of promoting international harmonization and would impede the USPTO’s ability to

efficiently examine applications through collaborative “work-sharing” initiatives among all the other IP5 offices.

**B. Requiring Prior Art be Public is Consistent with the Intention that the AIA Result in Greater Certainty Regarding the Scope of Patent Protection**

The AIA’s abrogation of *Metallizing* will also result in simplification in determining what is and is not prior art, thereby furthering Congress’s stated objective, set forth in AIA § 3(o), of creating greater certainty in the patent system.

First, *Metallizing* was problematic on several levels and was by no means the well-crafted cornerstone of the patent system some try to make it out to be. As one scholar summarized at the conclusion of a comprehensive review of the case:

The patent forfeiture rule of *Metallizing* is unsupported by precedent or statute, and is inequitable on the actual facts of the case. . . . The disclosure and extension of monopoly rationales for the rule are questionable, and all the more so because the most important policy rationale for the existence of a patent system—to provide incentives to invest and engage in inventive activities—might not be well served by the *Metallizing* rule. In addition the rule likely contributes to over-patenting, which can lead to patent thickets that stifle competition.

Dmitry Karshedt, *Did Learned Hand Get it Wrong? The Questionable Patent Forfeiture Rule of Metallizing Engineering*, 57 Villanova L. Rev. 261, 336 (2012).  
*See also* Toshiko Takenaka, *Rethinking the United States First-To-Invent Principle from a Comparative Law Perspective: A Proposal to Restructure §102 Novelty and Priority Provisions*, 39 Hous. L. Rev. 621, 634-36 (2002) (noting *Metallizing*, by

leading to “inclusion of secret commercial use within the meaning of ‘public use or on sale’ provisions of §102(b), has “introduce[d] a significant uncertainty in U.S. patent validity”).

Second, by abrogating *Metallizing* in the AIA, Congress eliminated an entire area of contention and inquiry regarding the scope of prior art. This was intentional. As Senator Kyl stated before passage of the AIA, this change will have particular benefit in increasing certainty and reducing litigation discovery costs:

The main benefit of the AIA public availability standard of prior art is that it is relatively inexpensive to establish the existence of events that make an invention available to the public. Under current law, depositions and litigation discovery are required in order to identify all of the inventor’s private dealings with third parties and determine whether those dealings constitute a secret offer for sale or third party use that invalidates the patent under the current law’s forfeiture doctrines. The need for such discovery is eliminated once the definition of “prior art” is limited to those activities that make the [invention] accessible to the public. This will greatly reduce the time and cost of patent litigation and allow the courts and the [USPTO] to operate much more efficiently.

157 Cong. Rec. S5319, 5319-21 (daily ed. Sept. 6, 2011) (statement of Sen. Jon Kyl). This statement thus directly links Congress’s stated objective of achieving greater certainty with Congress’s abrogation of *Metallizing*.

Third, as prominent intellectual property groups such as the AIPLA and the ABA Section on Intellectual Property Law argued for years during the run-up to

the AIA, the forfeiture rule of *Metallizing* is both unnecessary and undesirable in a first-inventor-to-file system:

In the first-to-invent system, the forfeiture [rule] plays a necessary role in protecting the public and competitors from a trade secret holder that could wait—without prejudice to its ability to later patent the trade secret—until a competitor sought and/or obtained a patent on the same subject matter. The trade secret holder could use its status as the first to invent to belatedly seek and obtain a patent, taking patent rights away from the first-to-file competitor.

The first-inventor-to-file standard eliminates completely this possibility. Instead, it guarantees that the competitor—not the trade secret holder—can obtain the valid patent. Thus, unlike this necessary role for the forfeiture in a first-to-invent system, the forfeiture provision plays no such role under the first-inventor-to-file standard. . . .

Once a first-inventor-to-file standard is enacted, the *Metallizing Engineering* forfeiture will have an additional negative policy incentive that is not balanced with any offsetting policy justification for continuing the forfeiture. The forfeiture operates to force the trade secret holder into perpetual trade secrecy once a patent is not sought within a one-year grace period. There can be no turning back to the patent system. . . . Forcing perpetual secrecy has a perverse consequence of potentially *retarding* progress in the useful arts.

AM. INTELLECTUAL PROP. ASS'N, SPECIAL COMMITTEE ON PATENT LEGISLATIVE PRIORITIES REPORT ON “FORFEITURE” BASED UPON INVENTIONS “IN PUBLIC USE OR ON SALE” 7-8 (*adopted on Jan. 25, 1992, revised on Sept. 12, 2003*). *See also* AM. BAR ASS'N SEC. OF INTELL. PROP. LAW, A SECTION WHITE PAPER: AGENDA FOR

21<sup>ST</sup> CENTURY PATENT REFORM 7 (2005) (available at [http://www.americanbar.org/content/dam/aba/administrative/intellectual\\_property\\_law/advocacy/white\\_paper\\_sept\\_2010\\_revision.authcheckdam.pdf](http://www.americanbar.org/content/dam/aba/administrative/intellectual_property_law/advocacy/white_paper_sept_2010_revision.authcheckdam.pdf)) (explaining that “the Section supports . . . eliminat[ing] from U.S. law . . . an inventor’s forfeiture of his or her right to patent an invention . . . by providing that no such loss of right to patent an invention can arise unless the invention had become reasonably and effectively accessible to persons of ordinary skill in the art more than one year before the inventor sought a patent for the invention”).

Thus, the AIA’s abrogation of *Metallizing* was an intentional policy decision, one that achieves greater certainty regarding the scope of prior art and provides inventors a continuing incentive to be the first to file a patent application, even after the one-year grace period.<sup>5</sup>

## CONCLUSION

The district court’s decision that the AIA overruled *Metallizing* and thus eliminated secret commercialization as prior art should be affirmed. The decision is supported by the plain language of the AIA, as well as the two “sense of

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<sup>5</sup> To further promote certainty within the patent system, and in view of the detailed district court opinion and extensive *amicus* participation in this appeal, it would be appropriate and consistent with this Court’s practice to designate the panel’s interpretation of “otherwise available to the public” in § 102(a)(1) as having been decided *en banc*. Cf. *Kingsdown Med. Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 876 n.16 (Fed. Cir. 1988) (designating a section of the panel opinion as having been decided *en banc*).

Congress” statements in the statute expressing Congress’s twin goals of harmonizing U.S. patent law with the rest of the world and achieving greater certainty in the application of those laws.

Respectfully submitted,

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