

The Supreme Court - January 22, 2019

The Supreme Court of the United States issued the following decision this morning:

Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc., No. 17-1229: Every patent statute over the past two centuries has included an “on-sale” bar, which as a general matter precludes a person from obtaining a patent on an invention that was “on sale” before the effective filing date of the patent application. In 2011, Congress enacted the Leahy-Smith America Invents Act (“AIA”), which, *inter alia*, 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 date of the claimed invention.” 35 U.S.C. §102(a)(1). The predecessor version of the law was similar in precluding a patent on an invention that was “in public use or on sale in this country, more than one year prior to the date of application for patent in the United States,” but did not include the “or otherwise available to the public” language in the AIA. See 35 U.S.C. §102(b) (2006 ed.). Here, petitioner Helsinn Healthcare sued two Teva Pharmaceutical entities for patent infringement regarding one of its pharmaceutical products. Teva asserted the on-sale bar under the AIA as a defense, based on two agreements Helsinn entered into with another company to distribute, promote, and market its product in the United States, both of which required the other company to keep any propriety information confidential. The District Court concluded that the on-sale bar did not apply here, because under the AIA, an invention is not “on sale” unless the sale or offer in question made the claimed invention available to the public. The Federal Circuit reversed, holding that so long as the sale itself was publicly disclosed, the on-sale bar applied. Today, the Court affirmed, unanimously holding that the reenactment of the phrase “on sale” in the AIA did not alter its pre-AIA meaning that an invention was “on sale” when it was the subject of a commercial offer for sale and ready for patenting, and thus, a commercial sale to a third party who is required to keep the invention confidential may place the invention “on sale” under the AIA.

The Court's decision is available [here](#).

Related Capabilities

- Appellate
- Intellectual Property Litigation

Today, the Supreme Court granted certiorari in the following case:

NY State Rifle & Pistol v. New York, No. 18-280: Whether New York City's ban on transporting a licensed, locked, and unloaded handgun to a home or shooting range outside city limits is consistent with the Second Amendment, the Commerce Clause, and the constitutional right to travel.

The Supreme Court today issued the following orders in pending cases:

Trump v. Karnoski, No. 18A625; **Trump v. Stockman**, 18A627: The Court granted the Government's application for a stay of the District Court's order granting a preliminary injunction in these cases, thus permitting the Trump administration's transgender military service ban to take effect during the pendency of the Government's appeal in the circuit courts and any petition for a writ of certiorari.