Under AIA 35 U.S.C. 102(a)(1), there is no geographic limitation on where prior public use or public availability occurs. Furthermore, a public use would need to occur before the effective filing date of the claimed invention to constitute prior art under AIA 35 U.S.C. 102(a)(1).

The pre-AIA case law also indicates that a public use will bar patentability if the public use occurs before the critical date and the invention is ready for patenting. Under pre-AIA 35 U.S.C. 102(b), the critical date is the date that is one year prior to the date of application for patent in the United States. See *Invitrogen Corp. v. Biocrest Manufacturing. L.P.*, 424 F.3d 1374, 1379-80, 76 USPQ2d 1741, 1744 (Fed. Cir. 2005) and MPEP § 2133. Under pre-AIA 35 U.S.C. 102(b), the uses of an invention before the patent's critical date that constitute a "public use" fall into two categories: the use either "(1) was accessible to the public; or (2) was commercially exploited." See *American Seating Co. v. USSC Group, Inc.*, 514 F.3d 1262, 1267, 85 USPQ2d 1683, 1685 (Fed. Cir. 2008) and MPEP § 2133.03(a). Whether a use is a pre-AIA 35 U.S.C. 102(b) public use also depends on who is making the use of the invention. "[W]hen an asserted prior use is not that of the applicant, [pre-AIA 35 U.S.C.] 102(b) is not a bar when that prior use or knowledge is not available to the public." See *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1371, 47 USPQ2d 1363, 1366 (Fed. Cir. 1998). In other words, a use by a third party who did not obtain the invention from the inventor named in the application or patent is an invalidating use under pre-AIA 35 U.S.C. 102(b) only if it falls into the first category: That the use was accessible to the public. See MPEP § 2133.03(a), subsection II.C. On the other hand, "an inventor's own prior commercial use, albeit kept secret, may constitute a public use or sale under [pre-AIA 35 U.S.C.] 102(b), barring him from obtaining a patent." See *Woodland Trust*, 148 F.3d at 1370, 47 USPQ2d at 1366 and MPEP § 2133.03(a), subsection II.A. Also, an inventor creates a public use bar under pre-AIA 35 U.S.C. 102(b) when the inventor shows the invention to, or allows it to be used by, another person who is "under no limitation, restriction, or obligation of confidentiality" to the inventor. See *American Seating*, 514 F.3d at 1267 and MPEP § 2133.03(a), subsection II.B.

Further, under pre-AIA 35 U.S.C. 102(a), "in order to invalidate a patent based on prior knowledge or use" by another in this country prior to the patent's priority date, "that knowledge or use must have been available to the public." See *Woodland Trust*, 148 F.3d at 1370, 47 USPQ2d at 1366 and MPEP § 2132, subsection I. Patent-defeating "use," under pre-AIA 35 U.S.C. 102(a) includes only that "use which is accessible to the public." See *id.* (quoting *Carella v. Starlight Archery*, 804 F.2d 135, 139, 231 USPQ 644, 646 (Fed. Cir. 1986)).

As discussed previously, public use under AIA 35 U.S.C. 102(a)(1) is limited to those uses that are available to the public. The public use provision of AIA 35 U.S.C. 102(a)(1) thus has the same substantive scope, with respect to uses by either the inventor or a third party, as public uses under pre-AIA 35 U.S.C. 102(b) by unrelated third parties or others under pre-AIA 35 U.S.C. 102(a).

As also discussed previously, once an examiner becomes aware that a claimed invention has been the subject of a potentially public use, the examiner should require the applicant to provide information showing that the use did not make the claimed process accessible to the public.

2152.02(d) On Sale [R-11.2013]

*[Editor Note: This MPEP section is **only applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in 35 U.S.C. 100 (note). See MPEP § 2159 et seq. to determine whether an application is subject to examination under the FITF provisions, and MPEP § 2133.03 et seq. for information about on sale in regard to applications subject to pre-AIA 35 U.S.C. 102.]*

The pre-AIA case law indicates that on sale activity will bar patentability if the claimed invention was: (1) the subject of a commercial sale or offer for sale, not primarily for experimental purposes; and (2) ready for patenting. See *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 67, 48 USPQ2d 1641, 1646-47 (1998). Contract law principles apply in order to determine whether a commercial sale or offer for sale occurred. In addition, the enablement inquiry is not applicable to the question of whether a claimed invention is

"on sale" under pre-AIA 35 U.S.C. 102(b). See *Epstein*, 32 F.3d at 1568, 31 USPQ2d at 1824. The phrase "on sale" in AIA 35 U.S.C. 102(a)(1) is treated as having the same meaning as "on sale" in pre-AIA 35 U.S.C. 102(b), except that the sale must make the invention available to the public. For a discussion of "on sale" as used in pre-AIA 35 U.S.C. 102(b), see generally MPEP § 2133.03(b) *et seq.*

Under pre-AIA 35 U.S.C. 102(b), if an invention was "on sale," patentability was precluded only if the invention was on sale "in this country." See MPEP § 2133.03(d). Under AIA 35 U.S.C. 102(a)(1), there is no geographic limitation on where the sale or offer for sale may occur. When formulating a rejection, Office personnel should consider evidence of sales activity, regardless of where the sale activity took place.

The pre-AIA 35 U.S.C. 102(b) "on sale" provision has been interpreted as including commercial activity even if the activity is secret. See MPEP § 2133.03(b), subsection III.A. AIA 35 U.S.C. 102(a)(1) uses the same "on sale" term as pre-AIA 35 U.S.C. 102(b). The "or otherwise available to the public" residual clause of AIA 35 U.S.C. 102(a)(1), however, indicates that AIA 35 U.S.C. 102(a)(1) does not cover secret sales or offers for sale. For example, an activity (such as a sale, offer for sale, or other commercial activity) is secret (non-public) if it is among individuals having an obligation of confidentiality to the inventor.

2152.02(e) Otherwise Available to the Public [R-11.2013]

[Editor Note: This MPEP section is ***only applicable*** *to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in 35 U.S.C. 100 (note). See MPEP § 2159 et seq. to determine whether an application is subject to examination under the FITF provisions, and MPEP § 2131-MPEP § 2138 for examination of applications subject to pre-AIA 35 U.S.C. 102.]*

AIA 35 U.S.C. 102(a)(1) provides a "catch-all" provision, which defines a new additional category of potential prior art not provided for in pre-AIA 35 U.S.C. 102. Specifically, a claimed invention is not entitled to a patent if it was "otherwise available to the public" before its effective filing date. This "catch-all" provision permits decision makers to focus on whether the disclosure was "available to the public," rather than on the means by which the claimed invention became available to the public or whether a disclosure constitutes a "printed publication" or falls within another category of prior art as defined in AIA 35 U.S.C. 102(a)(1). The availability of the subject matter to the public may arise in situations such as a student thesis in a university library (see, e.g., *In re Cronyn*, 890 F.2d 1158, 13 USPQ2d 1070 (Fed. Cir. 1989); *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986); *In re Bayer*, 568 F.2d 1357, 196 USPQ 670 (CCPA 1978) and MPEP § 2128.01, subsection I.); a poster display or other information disseminated at a scientific meeting (see, e.g., *In re Klopfenstein*, 380 F.3d 1345, 72 USPQ2d 1117 (Fed. Cir. 2004), *Massachusetts Institute of Technology v. AB Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985) and MPEP § 2128.01, subsection IV.); subject matter in a laid-open patent application or patent (see, e.g., *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981); see also *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 78 USPQ2d 1684 (Fed. Cir. 2006)); a document electronically posted on the Internet (see, e.g., *Voter Verified, Inc. v. Premier Election Solutions, Inc.*, 698 F.3d 1374, 104 USPQ2d 1553 (Fed. Cir. 2012), *In re Lister*, 583 F.3d 1307, 92 USPQ2d 1225 (Fed. Cir. 2009), *SRI Int'l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 85 USPQ2d 1489 (Fed. Cir. 2008), and MPEP § 2128); or a commercial transaction that does not constitute a sale under the Uniform Commercial Code (see, e.g., *Group One, Ltd. v. Hallmark Cards, Inc.*, 254 F.3d 1041, 59 USPQ2d 1121 (Fed. Cir. 2001) and MPEP § 2133.03(e)(1)). Even if a document or other disclosure is not a printed publication, or a transaction is not a sale, either may be prior art under the "otherwise available to the public" provision of AIA 35 U.S.C. 102(a)(1), provided that the claimed invention is made sufficiently available to the public.

2152.02(f) No Requirement of "By Others" [R-11.2013]

[Editor Note: This MPEP section is ***only applicable*** *to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in 35 U.S.C. 100 (note). See MPEP § 2159 et*