ALERT

JULY 2018

High Court to Hear *Helsinn v. Teva*, Resolve AIA Secret Sales Question

On June 25, 2018, the United States Supreme Court agreed to review the Federal Circuit's decision in *Helsinn Healthcare v. Teva Pharmaceuticals*, No. 17-1229.

In *Helsinn*, the Federal Circuit considered whether the America Invents Act ("AIA") narrowed the scope of the on-sale bar and, specifically, whether the addition of the phrase "or otherwise available to the public" to the post-AIA § 102(a) requires that a sale must publicly disclose the details of the invention subject to the sale in order to be invalidating. The district court answered that question in the affirmative.

The Federal Circuit reversed, declining to read the new § 102 language as requiring public disclosure of the invention and holding that the AIA did not change the law. The Federal Circuit instead held that only the existence of the sale need be made public to trigger the AIA on-sale bar. Helsinn petitioned the Supreme Court for certiorari, framing the issue as follows: "Whether, under the Leahy-Smith America Invents Act, an inventor's sale of an invention to a third party that is obligated to keep the invention confidential qualifies as prior art for purposes of determining the patentability of the invention." The Supreme Court granted the petition.

The Supreme Court's decision will have important consequences on the scope of what constitutes an invalidating sale for post-AIA patents. Briefing on the merits will take place during the summer, and the case will likely be scheduled for argument in fall 2018. A decision from the Supreme Court is likely before the end of June 2019.


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