Practical Considerations regarding Application of the "on-sale" Bar of 35 U.S.C. § 102 (b)

The First Subcommittee,
The Second Patent Committee

The U.S. Patent Act, Section 102(b), 35 U.S.C § 102 (b), sets forth a so-called "on-sale bar", providing that no one can obtain a patent for an invention that has been on sale more than one year before filing a patent application therefor. This "on-sale bar" is usually asserted as one of the grounds for invalidation of a patent by an accused party before the court. In an actual lawsuit, the issue is often contested whether or not an invention claimed as a patent has ever been on sale, so that the standard for the application of this on-sale bar has not necessarily been clear enough.

However, the US Supreme Court made this issue clear in its decision of the Pfaff case in November 1998, ruling that the on-sale bar applies when 1) the product has been the subject of a commercial offer for sale; and 2) the invention has been ready for being patented.

This article studies standard of the application of "on-sale bar" from the CAFC decisions given prior to the Pfaff case, and then examines the key factors of the Pfaff decision and its impact in order to provide the matters to be aware of in filling patent applications in US.

The article has been published in *"CHIZAI KANRI"* (Intellectual Property Management) Vol. 50, No. 6, pp.761-773, 2000.

Patent Enforcement for Computer Systems

The Second Subcommittee,
The Second Patent Committee

With the recent progress in digitization and networking, there are an increasing number of products incorporating computers that are subsequently connected to a network. The following points are generally said to be present in the infringement issues for computer system's patents.

(1) Recent computer systems are constructed from a combination of a number of products manufactured by different makers. Under the circumstances, a patent holder of a whole computer system's patent cannot enforce his/her patent right based on a direct infringement against a part of those makers.

(2) Hardware and software products become independently available from on the market due to the widespread use of personal computers. Under the circumstances, a patent holder of a combination of hardware and software patent cannot enforce his/her patent right based on a direct infringement against hardware makers and software makers.

(3) Since there are so many combinations for constructing a system to implement a certain function, there may be a case in which, even though a function on its face is equivalent to that of the patent, it does not necessarily follow what is worded in the claims of that patents.

This article discusses patent infringement issues with more focus on the application of contributory infringement and the doctrine of equivalents. It further discusses how the patent