

No. 22-1827

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

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CELANESE INTERNATIONAL CORPORATION,  
CELANESE (MALTA) COMPANY 2 LIMITED, CELANESE SALES U.S. LTD.,

*Appellants,*

v.

INTERNATIONAL TRADE COMMISSION,

*Appellee,*

ANHUI JINHE INDUSTRIAL CO., LTD., JINHE USA LLC,

*Intervenors.*

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Appeal from the United States International Trade Commission,  
Investigation No. 337-TA-1264.

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**CELANESE INTERNATIONAL CORPORATION, CELANESE (MALTA)  
COMPANY 2 LIMITED, AND CELANESE SALES U.S. LTD.'S  
REPLY BRIEF**

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APRIL 18, 2023

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## CERTIFICATE OF INTEREST

Counsel for Celanese International Corporation, Celanese (Malta) Company 2 Limited, and Celanese Sales U.S. Ltd. certify under Federal Circuit Rule 47.4 that the following information is accurate and complete to the best of their knowledge:

1. **Represented Entities.** Provide the full names of all entities represented by undersigned counsel in this case.

Celanese International Corporation; Celanese (Malta) Company 2 Limited;  
Celanese Sales U.S. Ltd.

2. **Real Parties in Interest.** Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.

None.

3. **Parent Corporations and Stockholders.** Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.

Celanese (Malta) Company 2 Limited is a wholly owned, indirect subsidiary of Celanese Corporation, a publicly held company. Celanese Sales U.S. Ltd. and Celanese International Corporation are wholly-owned subsidiaries of Celanese Corporation. No publicly held corporation holds 10% or more of Celanese Corporation's stock.

4. **Legal Representatives.** List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court.

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5. **Related Cases.** Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case.

Proceedings in *Celanese International Corporation, et al. v. Anhui Jinhe Industrial Co. Ltd. et al.*, No. 2:21-CV-03070-AB-KS (C.D. Cal.) are stayed until the International Trade Commission's determination becomes final. Proceedings in *Celanese International Corporation, et al. v. Anhui Jinhe Industrial Co. Ltd., et al.*, No. 1:20-cv-1775-RGA (D. Del.) are stayed pending resolution of this appeal.

6. **Organizational Victims and Bankruptcy Cases.** Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees).

Not applicable.

Dated: April 18, 2023

/s/ Deanne E. Maynard

Deanne E. Maynard

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## INTRODUCTION

When Congress said the “claimed invention” must be on sale to trigger the on-sale provision in the America Invents Act (“AIA”), Congress meant what it said. To avoid that straightforward conclusion, the ITC and Jinhe adopt two tactics to divert attention from the statute’s text. First, they insist this case is controlled by *Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA*, 139 S. Ct. 628 (2019). Second, they dismiss the ordinary tools of statutory interpretation as inapplicable because this Court had applied the pre-AIA on-sale bar to cover the types of sales at issue here.

Both diversionary tactics fail. Although the ITC and Jinhe scarcely mention it, the question presented in *Helsinn* was narrow, and the case involved a conceded sale of the claimed invention. Nothing in the Supreme Court’s holding, or its reasons for reaching it, answers the distinct legal question here: whether a “claimed invention” is on sale solely because a product of the invention’s use has been.

Nor should the AIA’s on-sale provision be interpreted to cover such sales just because this Court, on a handful of occasions, applied pre-AIA §102(b)’s on-sale bar to patentee’s sales of products made with inventive processes. This Court’s pre-AIA gloss is even less consistent with the text of the AIA’s on-sale provision than it was with the pre-AIA’s on-sale bar. There is no good reason to conclude Congress intended to incorporate that atextual gloss into its new statute.

Quite the contrary, the ordinary tools of statutory interpretation confirm it did not. The text, structure, purpose, and history of the AIA all point to the same conclusion: the AIA’s on-sale provision is triggered only by sales of the “claimed invention” itself, not by sales of products of the claimed invention’s use.

## **ARGUMENT**

### **UNDER A CORRECT INTERPRETATION OF THE AIA, CELANESE’S SALES OF PRODUCTS MADE BY ITS SECRET PROCESS DO NOT INVALIDATE ITS PATENT CLAIMS ON THE PROCESS**

#### **A. *Helsinn* Does Not Compel The ALJ’s Decision**

The ITC and Jinhe rely on an expansive view of *Helsinn*’s holding that is unsupported by the decision and contrary to how the Supreme Court decides cases. They argue that *Helsinn* held that the AIA incorporated wholesale this Court’s interpretations of the pre-AIA on-sale bar and thus compelled the ALJ’s decision. ITC.Br.12; Jinhe.Br.1.

But the question presented in *Helsinn* was narrow: “whether the sale of an invention to a third party who is contractually obligated to keep the invention confidential places the invention ‘on sale’ within the meaning of §102(a).” 139 S. Ct. at 630. The Supreme Court answered that question in the affirmative: “[A] commercial sale to a third party who is required to keep the invention confidential may place the invention ‘on sale’ under the AIA.” *Id.*

Nothing in *Helsinn* compelled the ALJ’s decision here. As no one disputes, *Helsinn*’s holding—that a “commercial sale to a third party who is required to keep the invention confidential may place the invention ‘on sale’ under the AIA” (*id.*)—does not control this case. Nor does the reasoning necessary to *Helsinn*’s holding. *Contra* Jinhe.Br.16. *Helsinn* reasoned: (1) the settled meaning of pre-AIA §102(b) that an invention is “‘on sale’ ... when it was ‘the subject of a commercial offer for sale’ and ‘ready for patenting’” did not “require that the sale make the details of the invention available to the public,” and (2) Congress’s “reenactment of the phrase ‘on sale’ in the AIA did not alter *this* meaning.” 139 S. Ct. at 630. (emphasis added). The Supreme Court did not address whether *other* interpretations of the pre-AIA on-sale bar were sufficiently settled and consistent with the AIA’s language such that Congress must have intended to incorporate them.

For that reason, *Helsinn* and this case present distinct statutory interpretation questions—not merely the factual difference between a patented product there and a patented process here. *Contra* ITC.Br.19; Jinhe.Br.1-2. In *Helsinn*, the Supreme Court addressed what it means for a claimed invention to be *on sale*, whereas this case involves what it means for a *claimed invention* to be on sale. *Helsinn* concluded an invention is on sale when the invention has been the subject of a commercial offer for sale and is ready for patenting, even if details of the invention have not been made publicly available. But that hardly suggests the Supreme Court would hold a

claimed invention is on sale when it has never been the subject of a commercial offer for sale, even if its useful end result has been.

The ITC and Jinhe take language out of context in suggesting the Supreme Court held “the AIA did not abrogate this Court’s longstanding precedents about the on-sale bar.” Jinhe.Br.10. The ITC, for instance, points to *Helsinn*’s statement that “Congress did not alter the meaning of ‘on sale’ when it enacted the AIA.” ITC.Br.12 (quoting *Helsinn*, 139 S. Ct. at 634). But the Supreme Court was referring to the meaning at issue—namely, that an invention is “on sale” “when it was ‘the subject of a commercial offer for sale’ and ‘ready for patenting.’” *Helsinn*, 139 S. Ct. at 630. The Supreme Court did not also conclude that Congress incorporated all of this Court’s pre-AIA on-sale bar case law into the AIA’s on-sale provision. The Supreme Court does not decide such abstract questions of law; it “decide[s] legal questions only in the context of actual ‘Cases’ or ‘Controversies.’” *Alvarez v. Smith*, 558 U.S. 87, 92 (2009). Thus, “general expressions, in every opinion, are to be taken in connection with the case in which those expressions are used.” *Cohens v. Virginia*, 19 U.S. 264, 399 (1821).

Indeed, the Supreme Court has already rejected one overreading of its AIA precedent. In *Cuozzo*, the Supreme Court held that 35 U.S.C. §314(d) barred appellate review of a challenge that the Patent Office “unlawfully initiated” *inter partes* review. *Cuozzo Speed Technologies, LLC v. Lee*, 579 U.S. 261, 271 (2016).

Later, in *SAS*, the Patent Office argued that §314(d) and *Cuozzo* “foreclos[ed] judicial review of any legal question bearing on the institution of *inter partes*” review, including whether it could institute review on some but not all challenged claims. *SAS Institute v. Iancu*, 138 S. Ct. 1348, 1359 (2018).

The Supreme Court disagreed: “this reading overreads both the statute and our precedent.” *Id.* The Court emphasized that *Cuozzo* involved only the question whether §314(d) precludes judicial review of the Director’s determination “that ‘there is a ‘reasonable likelihood’ that the claims are unpatentable on the grounds asserted.’” *Id.* It did not address “the sort of question” the Court was “called upon to decide” in *SAS*, which was whether “the Director exceeded his statutory authority by limiting the review to fewer than all of the [challenged] claims.” *Id.* Addressing that question, the Court held §314(d) did not bar the appeal there. *Id.* at 1359-60.

So too here: *Helsinn* did not answer the question presented, and the ITC and Jinhe overread it in contending otherwise.

**B. The AIA’s On-Sale Provision Is Not Triggered By Sales Of Products Made With A Secret Inventive Process**

Once the ITC’s and Jinhe’s attempts to hide behind *Helsinn* are rejected, the AIA’s on-sale bar should be read to mean what it says.

**1. The plain language of §102(a)(1) requires the “claimed invention” itself to be “on sale”**

**a. The plain language governs**

The plain language of §102(a)(1) requires the “claimed invention” itself (not the product of its use) to be the “subject of a commercial offer for sale.” Section 102(a)(1) provides that “[a] person shall be entitled to a patent unless ... the claimed invention was ... in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.” 35 U.S.C. §102(a)(1). Congress defined “claimed invention” in the AIA to mean “the subject matter defined by a claim in a patent or an application for a patent.” 35 U.S.C. §100(j). And the Supreme Court in *Helsinn* confirmed that a claimed invention is “on sale” under §102(a)(1) when it is “‘the subject of a commercial offer for sale’ and ‘ready for patenting.’” 139 S. Ct. at 630.

Thus, by its plain terms, §102(a)(1) requires “the subject matter defined by a claim in a patent or an application for a patent” to be “the subject of a commercial offer for sale.” *Celanese*.Br.17. That ordinary meaning is reinforced by other sections of the patent law that show Congress knows how to refer to sales of products of an invention’s use when it means to cover them. 35 U.S.C. §§ 271(g), 273(a)(1). And no one disputes that the subject matter defined by the patent claims at issue—*Celanese*’s process for making Ace-K—was never the subject of a commercial offer for sale. Appx6; Appx43-99; Appx7976-8034.

That should be the end of the matter. The Supreme Court has “stated time and again that courts must presume that a legislature says in a statute what it means and means in a statute what it says there. When the words of a statute are unambiguous, then, this first canon is also the last: ‘judicial inquiry is complete.’” *Conn. Nat’l Bank v. Germain*, 503 U.S. 249, 253-54 (1992) (citations omitted).

**b. The reenactment canon is inapplicable**

Instead of reading the text to mean what it says, the ITC and Jinhe ask the Court to skip first principles and use the reenactment canon to read the text as meaning something else: that a patentee’s sale of a product made with its undisclosed inventive process triggers the on-sale provision. ITC.Br.16-19; Jinhe.Br. 18-23. But they cannot meet the conditions required for that canon. *Celanese.Br.34-42*.

*First*, neither the ITC nor Jinhe dispute that “the reenactment canon does not override clear statutory language.” *Oklahoma v. Castro-Huerta*, 142 S. Ct. 2486, 2498 (2022). Yet neither explains how §102(a)(1)’s language is unclear. It is not. It plainly requires that the “claimed invention” be on sale, not a product of the claimed invention’s use. *Celanese.Br.16-22*; *supra* pp. 6-7. The reenactment canon thus has no role here.

The ITC and Jinhe obliquely suggest that §102(a)(1)’s on-sale provision is unclear because, if given its ordinary construction, it would never apply to inventive

processes. ITC.Br.26; Jinhe.Br.30. Even if that were so, it would not render the provision unclear. Regardless, pre-AIA decisions from this Court suggest situations (unlike this one) where an inventive process could be the subject of a commercial offer for sale under the plain text of the AIA. For example, as the ITC recognizes (ITC.Br.6), this Court has held that an inventive process could be placed “on sale” by offering to perform the process itself in exchange for compensation—such as offering to use an inventive process as a service to another to process their waste into cleaner materials. *Scaltech, Inc. v. Retec/Tetra, LLC*, 269 F.3d 1321, 1328-31 (Fed. Cir. 2001). That would be akin to Jinhe’s hypotheticals of persons selling services that result in tangible items, such as a lawyer selling legal services that may entail writing a brief. Jinhe.Br.20-21.

But none of that is the same as just selling a product, which is all Celanese did here. No ordinary English speaker would say a farmer who merely sells his produce at the market is selling “produce-growing services.” This Court recognized as much in *W.L. Gore* when it explained that “[i]f Budd offered and sold anything, it was only tape, not whatever process was used in producing it.” *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983). Likewise, Celanese did not “sell” its inventive manufacturing process when it sold sweetener. Appx9.

While Celanese’s interpretation gives the on-sale provision its ordinary meaning, Jinhe and the ITC would stretch the statute to sweep in any



“commercialization” of an invention. ITC.Br.23; Jinhe.Br.20-21. That standard has no foundation in the text. And it would alter the relevant question from the straightforward inquiry into whether the “claimed invention” has been the subject of a commercial offer for sale to the amorphous question of whether any commercial benefit has been derived from the invention’s use. *Cf. Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 65-66 & n.11 (1998) (rejecting this Court’s “totality of the circumstances” test for the pre-AIA on-sale bar for similar reasons).

The ITC argues that regardless of the text’s clarity, *Helsinn* requires this Court to apply the reenactment canon because the Supreme Court did so. ITC.Br.43-44. But *Helsinn* did not hold that §102(a)(1) reenacted every interpretation of pre-AIA §102(b); it held only that Congress reenacted the interpretation at issue there. No one would suggest, for instance, that *Helsinn* compels this Court to read §102(a)(1) as limited to conduct within the United States simply because this Court interpreted pre-AIA §102(b) that way. ITC.Br.41 (agreeing §102(a)(1) is “no longer geographically constrained to the United States”).

*Second*, the interpretation of pre-AIA §102(b) as covering patentee’s sales of products of secret inventive processes was not well-settled when Congress enacted §102(a)(1). No one disputes that the Supreme Court never adopted that judicial gloss. That is reason enough to reject the reenactment canon: the Supreme Court has found it “most unlikely ... that a smattering of lower court opinions could ever

represent the sort of ‘judicial consensus so broad and unquestioned that we must presume Congress knew of and endorsed it.’” *BP PLC v. Baltimore*, 141 S. Ct. 1532, 1541 (2021).

The ITC and Jinhe suggest a different rule applies to this Court’s decisions, contending that *Helsinn* “principally” relied on this Court’s precedent to find the judicial construction there well settled. Jinhe.Br.25; ITC.Br.47-48. But the Supreme Court has never recognized a different rule for this Court’s precedent. And in *Helsinn*, the Supreme Court primarily relied on its own precedent to conclude that the meaning was well settled, adding that this Court had “made explicit what was implicit in our precedents.” 139 S. Ct. at 633.

The ITC and Jinhe are also wrong that Supreme Court decisions imply the construction they seek. As the ITC and Jinhe concede, *Pennock* did not interpret pre-AIA §102(b)’s on-sale bar. ITC.Br.46-47; Jinhe.Br.21-23. And the issue there was the correctness of a jury instruction that “an inventor [who] makes his discovery public” and allows it to be “publicly used” thereby “abandons” any patent rights. *Pennock v. Dialogue*, 27 U.S. 1, 14-15 (1829). As all agree, the invention in *Pennock* (whether it was the hose or the process of making it) became public because the patentee allowed a third party to make and sell thousands of feet of hose. ITC.Br.46-47; Jinhe.Br.21-23. Nor can the ITC and Jinhe glean support from

*Pennock*'s dicta: “dicta that does not analyze the relevant statutory provision cannot be said to have resolved the statute’s meaning.” *Castro-Huerta*, 142 S. Ct. at 2498.

The same is true for their reliance on *Pfaff*, which merely quoted *Metallizing* for the point that *Pfaff*'s holding found support “not only in the text of the statute but also in the basic policies underlying the statutory scheme.” *Pfaff*, 525 U.S. at 68 (citing *Metallizing Eng'g Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F.2d 516, 520 (2d Cir. 1946)). And it is beside the point that Supreme Court precedent “‘suggest[ed]’ that a sale ‘need not make an invention available to the public’ to trigger the on-sale bar.” *Jinhe.Br.26* (quoting *Helsinn*, 139 S. Ct. at 633) (brackets in original). The reason Celanese’s sales of Ace-K do not trigger §102(a)(1)’s on-sale provision is because they did not place Celanese’s inventive process on sale at all.<sup>1</sup>

Even if this Court could make the law “well settled” for purposes of the reenactment canon, the ITC and *Jinhe* fail to show this Court settled on a single meaning. Instead, this Court gave two *different* meanings to the pre-AIA on-sale bar depending on who sold the product made with the inventive process. *Celanese.Br.38*. And neither the ITC nor *Jinhe* disputes that the same words in a

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<sup>1</sup> And because Celanese’s inventive process remained secret until Celanese filed its patent applications (Appx9), *Jinhe* conceded that §102(a)(1)’s “public use” provision “is not at issue here.” Appx8225 n.6.

single statutory provision cannot have different meanings for different actors. *Clark v. Martinez*, 543 U.S. 371, 378 (2005).

Jinhe asserts this asymmetry is illusory because this Court supposedly only “evaluates third-party use under the separate ‘public use’ bar, not the on-sale bar.” Jinhe.Br.25. That is incorrect. The pre-AIA on-sale bar applied to third-party sales. *Pennwalt Corp. v. Akzona Inc.*, 740 F.2d 1573, 1580 n.14 (Fed. Cir. 1984) (“[I]t is well settled that the ‘on sale’ bar applies to sales made by the inventor or another, with or without the inventor’s consent.”); *J.A. LaPorte, Inc. v. Norfolk Dredging Co.*, 787 F.2d 1577, 1581 (Fed. Cir. 1986) (similar). It could hardly be otherwise because the pre-AIA on-sale bar provision made no textual distinction between patentee and third-party sales. 35 U.S.C. §102(b) (2006). That was not by accident. An earlier version of the on-sale bar was expressly limited to offers of sale made by or with the patentee’s consent. Patent Act of 1836, ch. 357, §6, 5 Stat. 117, 119. Congress subsequently eliminated that requirement. *BASF Corp. v. SNF Holding Co.*, 955 F.3d 958, 964 (Fed. Cir. 2020) (describing history).

The reason third-party sales of the product of an inventive process did not trigger the pre-AIA on-sale bar was not because this Court did not apply the on-sale bar; it was because this Court applied the plain language of the on-sale bar and concluded such sales did not place the invention on sale. *W.L. Gore & Assocs., Inc.*, 721 F.2d at 1550 (“If Budd offered and sold anything, it was only tape, not whatever

process was used in producing it.”). Only for *patentees* did this Court engraft an addition onto the text such that a patentee’s sale of a product made with an undisclosed inventive process triggered the on-sale bar. And that addition was based on a judicial policy judgment supposedly “parallel[ing]” the statutory scheme yet unsupported by a “literal construction” of the statutory text. *D.L. Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 1147 (Fed. Cir. 1983) (explaining “[t]he ‘forfeiture’ theory expressed in *Metallizing* parallels the statutory scheme of §102(b)”); *BASF*, 955 F.3d at 967 (explaining *Metallizing* “recognized that a secret process was neither ‘publicly’ used, nor itself on sale, under a literal construction of §102(b)”).

In response, Jinhe challenges Celanese’s description of this Court’s pre-AIA interpretation as a gloss, asserting those decisions are “precedential, binding, statutory interpretation” and “any arguments about the[ir] correctness ... should be directed to the *en banc* Court or the Supreme Court.” Jinhe.Br.24. But this Court has recognized its interpretation is a gloss, not a “literal construction” of the statutory text. *BASF*, 955 F.3d at 967. And the question here is not whether this Court’s pre-AIA §102(b) precedent should be overruled; it is whether Congress should be presumed to have adopted that gloss in enacting §102(a)(1), despite the gloss’s conflict with the plain text.

The asymmetry of this Court’s gloss also disproves the theory that this Court was simply (and consistently) interpreting the words “on sale” in pre-AIA § 102(b) to mean “commercializes.” ITC.Br.23; Jinhe.Br.21 (arguing that “[i]n the context of the on-sale bar, to ‘sell’ is to ‘commercialize’”). If “on sale” meant “commercializes,” then a third party’s sale of the product of an inventive process would have triggered the on-sale bar too. Yet this Court recognized that such conduct did not place the inventive process on sale. *W.L. Gore & Assocs., Inc.*, 721 F.2d at 1550. That is because the words “on sale” in pre-AIA §102(b) required the invention to be “the subject of a commercial offer for sale.” *Pfaff*, 525 U.S. at 67. Mere commercialization did not suffice. *BASF*, 955 F.3d at 969 (“The invention itself must be sold or offered for sale, and the mere existence of a ‘commercial benefit ... is not enough to trigger the on-sale bar’ on its own.”).

The ITC and Jinhe also claim “[t]his Court has repeatedly restated *D.L. Auld*’s holding.” Jinhe.Br.19-20; ITC.Br.44-45. But the reenactment “canon does not apply to dicta.” *Castro-Huerta*, 142 S. Ct. at 2498. And virtually all the decisions

the ITC and Jinhe cite merely reiterated *D.L. Auld* in dicta.<sup>2</sup> This Court’s actual application of its gloss in (at most) a handful of cases over four decades is poor evidence that it was so well settled that Congress must have adopted it.

The ITC’s cited treatises cannot make law either, let alone settle it. *Contra* ITC.Br.17-18. That is especially so when, as here, the treatises question the foundation for the allegedly well-settled law. 2A Donald S. Chisum, Chisum on Patents §6.02[5][c] (2022) (“Both *D.L. Auld* and *Gore* leave unclear the theory for finding a bar when the secret commercial use of a process or machine is by the inventor/patentee but not when it is by another.”).

*Third*, the reenactment canon is inapplicable because Congress did not reenact pre-AIA §102(b) “without change.” *Jama v. Immigr. & Customs Enf’t*, 543 U.S. 335, 349 (2005). Congress made several changes to §102, including the addition of

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<sup>2</sup> *BASF*, 955 F.3d at 968-71 (holding license agreement and acquisition did not place process invention on sale); *Medicines Co. v. Hospira, Inc.*, 827 F.3d 1363, 1376 (Fed. Cir. 2016) (en banc) (holding supplier’s sale of contract manufacturing services did not place product-by-process inventions on sale); *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 866 (Fed. Cir. 2010) (holding product advertisement did not place apparatus invention on sale); *In re Kollar*, 286 F.3d 1326, 1333 (Fed. Cir. 2002) (holding license agreement between applicant’s assignee and corporation did not trigger on-sale bar); *Brasseler, USA I, LP v. Stryker Sales Corp.*, 182 F.3d 888, 891 (Fed. Cir. 1999) (holding sale of blades placed blade invention on sale); *In re Caveney*, 761 F.2d 671, 675-76 (Fed. Cir. 1985) (holding cable ties invention placed on sale by offer to sell the cable ties); *W.L. Gore & Assocs., Inc.*, 721 F.2d at 1550 (holding third-party sale of tape produced with inventive process did not place inventive process on sale).

the term “claimed invention,” the addition of the phrase “or otherwise available to the public,” the elimination of the words “loss of rights” from the title, and the creation of a grace period that refers to §102(a)(1)’s prior-art categories as “disclosures.” *Celanese*.Br.39-42. The ITC downplays these changes by once again citing *Helsinn*. ITC.Br.48. But *Helsinn* did not even mention most of these changes, let alone address whether they affect the pre-AIA gloss at issue here.

For example, *Helsinn* never addressed the impact of Congress’s addition of the term “claimed invention” to §102(a)(1) and the definition of that term. The ITC and Jinhe argue these changes are immaterial because pre-AIA §102(b) used the term “invention,” courts already understood that term to mean the subject matter of a patent’s claims, and yet this Court nevertheless interpreted the pre-AIA on-sale bar as applying to patentee sales of the product of a claimed process. ITC.Br.23-24; Jinhe.Br.28-29. In other words, because this Court’s pre-AIA gloss was already at odds with the statutory text, Congress must have intended for courts to disregard the new language it adopted too. No principle of statutory interpretation supports such a counter-intuitive expectation. *Castro-Huerta*, 142 S. Ct. at 2498 (“the reenactment canon does not override clear statutory language”).

The argument is also wrong because it ignores that, to the extent Congress is presumed to know of this Court’s pre-AIA interpretations, Congress’s choice of words shows which of the differing interpretations it chose. Under pre-AIA law,



this Court had usually required the claimed invention itself to be the subject of a commercial offer for sale. Only in the context here—sales of products of inventive processes—had it made an exception by treating a patentee’s sale of the product as a triggering sale. *Compare D.L. Auld Co.*, 714 F.2d at 1147-48 with *W.L. Gore & Assocs., Inc.*, 721 F.2d at 1544-46. In the AIA, Congress rejected that textual approach by doubling-down on the textual interpretation, expressly defining “claimed invention” and requiring that *it* be on sale. 35 U.S.C. §§100(j), 102(a)(1).

The ITC and Jinhe also do not dispute that Congress’s addition of the words “otherwise available to the public” implies that Congress meant for the activities listed in §102(a)(1) to at least make the claimed invention available to someone. *Celanese*.Br.20-21. Instead, they contend *Helsinn* rejected this argument. ITC.Br.31; Jinhe.Br.30-31. But this is another overreading of *Helsinn*. *Helsinn* concluded that the addition of “otherwise available to the public” was too “oblique” a way to overturn the settled understanding, including in Supreme Court precedent, that an invention is “on sale” when it is the “subject of a commercial offer for sale” and “ready for patenting.” 139 S. Ct. at 633-34. *Helsinn* did not hold the language offers no interpretative guidance at all.

The ITC and Jinhe similarly cannot explain Congress’s elimination of the “loss of right” language in §102’s title. *Celanese*.Br.21-22. According to them, this must have been a mistake because the pre-AIA on-sale bar was wholly maintained.

ITC.Br.31-32; Jinhe.Br.33-34. But there is a simpler explanation for the deletion: the on-sale provision was retained but solely as a novelty provision. The loss-of-right rule that this Court applied as a gloss was eliminated. Joe Matal, *A Guide to the Legislative History of the America Invents Act*, 21 FED. CIR. B.J. 435, 450 (2012) (“Matal”) (“In light of the AIA’s repeal of all ‘loss of right to patent’ provisions based on secret activities from §102, those words have been removed from the title of §102.”).

The ITC and Jinhe also argue that Congress’s elimination of pre-AIA §§102(c) and (g) is irrelevant because those provisions provided no support for this Court’s asymmetrical gloss. ITC.Br.49-50; Jinhe.Br.31-32. If that is correct, it is a concession that there never was any textual foundation for this Court’s pre-AIA asymmetrical gloss. That is another good reason Congress’s enactment of clear language requiring the claimed invention itself to be on sale should not be construed as adopting judicial decisions holding the opposite.

**2. *The structure of the AIA shows that §102(a)(1) excludes sales of products made with secret inventive processes***

The plain-text reading of §102(a)(1) is bolstered by the AIA’s structure. Celanese.Br.22-29. The ITC and Jinhe strain to pick off Congress’s structural changes individually but cannot refute that Celanese’s reading fits better with the structure of the AIA as a whole.

**a. The AIA on-sale provision's grace period**

Celanese's interpretation of §102(a)(1) is confirmed by its grace period. Section 102(b) creates a one-year grace period for "disclosures" by inventors that would otherwise create prior art under §102(a)(1). 35 U.S.C. §102(b). Congress intended this grace period to be coextensive with §102(a)(1)'s prior-art categories, with the House Report explaining it would "apply to all actions by the patent owner during the year prior to filing that would otherwise create §102(a) prior art." H.R. Rep. No. 112-98, at 42-43 (2011). Under Celanese's interpretation of §102(a)(1), Congress achieved its goal because all activity under §102(a)(1) involves a "disclosure" to someone, and thus any such activity by an inventor taken within a year of filing a patent application would qualify for §102(b)'s grace period. But under the ALJ's interpretation, §102(a)(1) also covers activity (like Celanese's sales of Ace-K) that involves no "disclosure," and so some actions by an inventor that create prior art under §102(a)(1) would not be entitled to §102(b)'s grace period even if taken within a year of filing a patent application. In other words, §102(a)(1) and its grace period are mismatched.

The ITC and Jinhe cannot agree on how to reconcile their interpretation of §102(a)(1) with the grace period. They agree only that this case "does not implicate the grace period" so the Court should ignore it. Jinhe.Br.38; ITC.Br.34-35. But Celanese's point is not that the grace period should apply here; it is that the structure

of §102, including its grace period, shows Congress did not intend §102(a)(1)'s on-sale provision to apply to sales of products made by secret, inventive processes. That question is directly implicated here.

As for Jinhe, it agrees with Celanese that Congress intended for the grace period to be coextensive with §102(a)(1)'s prior-art categories. Jinhe.Br.38-39. But Jinhe argues that its interpretation still allows §102(a)(1) and its grace period to be coextensive because a patentee's sale of a product made with an undisclosed inventive process supposedly is a "disclosure" of the process and could thus trigger §102(b)'s grace period. *Id.* But a sale of a product made with an undisclosed inventive process discloses the invention to no one. *D.L. Auld*, 714 F.2d at 1147 (acknowledging this Court's gloss applies even "[w]here a method is kept secret, and remains secret after a sale of the product of the method"). So treating such activity as triggering the on-sale provision would result in a mismatch between the prior-art categories and grace period Congress intended to be coextensive.

For its part, the ITC acknowledges its reading of §102(a)(1) makes it mismatched with the grace period but argues *Helsinn* compels this result. ITC.Br.33-34. Not so: in *Helsinn*, the claimed invention was disclosed because it was offered for sale to a third party. The ITC also argues that any mismatch makes sense because Congress might have wanted to "prevent effective extension of [a] patent term by gamesmanship." ITC.Br.35. But if that were the goal, the ITC's

reading makes no sense. Under the ITC's view, Congress allowed inventors of inventive *products* to "exten[d]" their "patent term" by making unlimited sales of their product for up to a year before filing a patent application. *Id.* But if the inventor of an undisclosed *process* makes even a single sale of a product made with that process, then under the ITC's view, the process is immediately unpatentable.

**b. The AIA's prior-user defense**

The ITC's interpretation also conflicts with the AIA's prior-user defense because, if taken to its logical conclusion, no one would need §273's infringement defense for commercial uses of inventive processes. *Celanese.Br.26-27.*

The ITC and Jinhe respond that the defense will not be superfluous because third-party sales of products made with inventive processes will not trigger §102(a)(1)'s on-sale provision, so third parties will still need §273's infringement defense for such sales. *ITC.Br.36; Jinhe.Br.39-40.* But they never square that conclusion with §102(a)(1)'s text, which applies equally regardless of the actor making the sale. If a patentee's sale of a product of an inventive process triggers the on-sale provision, a third party's sale of such a product should do so too.

Jinhe argues that even if a third-party sale of the product of an inventive process places the inventive process on sale (thereby invalidating the patent), §273 could still do work in "other situations." *Jinhe.Br.40.* But Jinhe never identifies what those are, and it is hard to imagine them. In particular, Jinhe has no explanation

for what work §273's text creating a defense for "commercial use" of "subject matter consisting of a process" would do. 35 U.S.C. §273(a)(1). If, as the ITC and Jinhe suggest, the relevant question under §102(a)(1) is whether "the patented process" has been "commercialize[d]" (ITC.Br.51), then what need is there for a defense to infringement for "commercial use[s]" of an inventive "process"?

**c. The AIA's post-grant review proceedings**

Congress's enactment of post-grant review proceedings also supports Celanese's interpretation. Congress allowed patents issued after the AIA to be challenged in post-grant review proceedings, which would be governed by §102. But it also allowed challenges of business-method patents issued before the AIA, and for those patents (which would have presumptively been governed by pre-AIA §102), it expressly limited prior art to pre-AIA §102(a) and certain conduct that "discloses the invention." AIA §18(a)(1)(C). Yet it made no similar limitation for post-AIA business-method patents, which it simply subjected to §102. By doing so, Congress signaled its belief that §102(a) was already limited to prior art that involved disclosures. Celanese.Br.27-29.

In their responses, the ITC and Jinhe ignore this issue, instead taking issue with arguments Celanese did not make. The ITC, for instance, argues that post-grant review proceedings can involve all grounds for unpatentability under §102(a). ITC.Br.37. Celanese never said otherwise. The point is that Congress's careful

drafting of post-grant review provisions shows it understood that the activities covered by §102(a) all involved disclosures to someone.

Jinhe similarly avoids the issue, arguing that investigating secret uses of inventive processes during post-grant review proceedings will not be fact intensive. Jinhe.Br.40-41. But Jinhe mistakes the facts here with the category of cases to which the ITC's reading potentially applies. Unlike Celanese, a patentee will not always concede that it sold a product made with a secret process not materially different than its patented process. Plus, if taken to its logical conclusion, the ITC's interpretation suggests anyone's sales of products made with secret inventive processes anywhere in the world (even a day before the patent application) would be grounds to invalidate a patent and thus be fair game for discovery.

***3. The ordinary meaning of §102(a)(1) serves Congress's objectives in enacting the AIA***

The ordinary meaning of §102(a)(1) also coheres with Congress's purposes of harmonizing the United States patent system with foreign patent systems and simplifying prior-art determinations. Celanese.Br.29-33.

No one disputes that Celanese's reading of §102(a)(1) brings the United States patent system closer to those of its sister countries. Jinhe instead argues it does not meaningfully close the gap because foreign patent systems supposedly have no on-sale bar at all. But Jinhe is mistaken. Other major patent systems also allow sales of inventions to create prior art. *See, e.g.,* Convention on the Grant of European

Patents art. 54(2). What they do not do is treat secret commercial uses as a patentability bar. And the ITC caricatures Celanese's argument as suggesting "the AIA should be interpreted to harmonize every aspect of domestic and foreign patent law[s]." ITC.Br.40. But Celanese's point is that giving §102(a)(1) its ordinary meaning will naturally advance one of Congress's express statutory purposes, which is good evidence the ordinary meaning is what Congress intended.

The ITC likewise does not dispute that Celanese's interpretation serves Congress's goal of simplifying prior-art determinations. (Jinhe does, but only because it wrongly assumes this case is representative of all cases encompassed by the ITC's interpretation of §102(a)(1). *Supra* pp. 22-23.) Instead, the ITC argues that if Congress did not like the consequences of *Helsinn*, it would have overruled it. ITC.Br.39. But again, *Helsinn* did not decide this question (*supra* pp. 2-5), so Congress's inaction cannot signal its approval of the ALJ's reading here.

The ITC and Jinhe also argue that maintaining this Court's pre-AIA gloss is necessary to encourage inventors to disclose their inventions "and thus advance the progress of science and the useful arts." ITC.Br.41; Jinhe.Br.47-49. But this Court's pre-AIA gloss had the opposite effect for the types of processes its covered. Inventors of processes used to create products have fewer incentives to disclose their inventive processes in patent applications because "in many cases a process patent affords inadequate protection in exchange for the inventor's disclosure, since



process claims are often difficult if not impossible to police.” Gary L. Griswold & F. Andrew Ubel, *Prior User Rights—A Necessary Part of a First-to-File System*, 26 J. MARSHALL L. REV. 567, 577-78 (1993). One of the AIA’s own sponsors understood this problem. *See* 157 Cong. Rec. H4483 (daily ed. June 23, 2011) (Statement of Rep. Smith) (“The patents issued on manufacturing processes are very difficult to police, and oftentimes patenting the idea simply means giving the invention away to foreign competitors.”). This Court’s pre-AIA gloss made it even less likely such processes would ever enter the public domain because “if a manufacturer did use a process in the United States for more than a year, pre-AIA §102(b)’s preclusion of patenting created a strong incentive to keep the process secret indefinitely.” *Matal*, 21 FED. CIR. B.J. at 469 n.226.

And if, as the ITC suggests (ITC.Br.33-35), the AIA’s new grace period does not apply to sales of products made with undisclosed inventive processes, the situation will be even worse. If a single sale of a product made with a secret process bars patentability of the process forever, few manufacturers would ever choose to share knowledge of their secret processes with the public through a patent application. Entry of such inventions into the public domain would be more delayed, not less.

**4. *The AIA's legislative history does not support the ALJ's decision***

Neither the ITC nor Jinhe defends the ALJ's erroneous conclusion that "the final language of §102 in the AIA was adopted over the objections of senators who wanted to get rid of the very rule being advanced by Jinhe here." Appx16. As Celanese showed, that is incorrect. Celanese.Br.48-49. The most vocal supporters of the AIA celebrated that its final language "d[id] away with precedent under current law that ... secret processes practiced in the United States that result in a product or service that is then made public may be deemed patent-defeating prior art." 157 Cong. Rec. S1496-97 (daily ed. March 9, 2011); *see* 157 Cong. Rec. S1370-71 (daily ed. Mar. 8, 2011); 157 Cong. Rec. H4429 (daily ed. June 22, 2011).

Instead, the ITC and Jinhe try to draw attention away from the ALJ's error by arguing this same legislative history was presented and rejected in *Helsinn*. Jinhe.Br.43. But as Jinhe concedes, the Supreme Court did not discuss this legislative history in its opinion. Jinhe.Br.43. For good reason. As this Court explained, the legislative history discussed here did not address the on-sale issue

presented there. *See Helsinn Healthcare S.A. v. Teva Pharms. USA, Inc.*, 855 F.3d 1356, 1368 (Fed. Cir. 2017).<sup>3</sup>

Like the ALJ, the ITC and Jinhe also place heavy reliance on the 2007 House Report, saying it indicates the House Committee chose not to entirely scrap the concepts of “on sale” and “in public use.” ITC.Br.53-54; Jinhe.Br.44-45. But they never explain how a report describing a different bill using different language can reliably indicate how Congress understood its enactment. Nor do they explain how Congress’s desire to not entirely eliminate the concepts suggests it meant for courts to carry forward all interpretations of pre-AIA §102(b) regardless of their inconsistency with the new text.

**5. *The PTO’s guidance provides no support for the ALJ’s decision***

Neither the ITC nor Jinhe can defend the ALJ’s reliance on the PTO’s guidance. As the ITC concedes, “the USPTO does not declare substantive patent law.” ITC.Br. 56. Although Jinhe implies the guidance is entitled to *Skidmore* deference (Jinhe.Br.17), any *Skidmore* deference owed to an agency interpretation comes only from “the thoroughness of its consideration and the validity of its

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<sup>3</sup> Although this Court described the legislative history as concerning “public use” (*id.*), the statements expressly refer to “secret processes ... that result in a product ... that is then made public,” the very situation here. 157 Cong. Rec. S1496-97 (daily ed. March 9, 2011).

reasoning.” *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543, 1550 (Fed. Cir. 1996). Here, the guidance contains no reasoning for why §102(a)(1)’s on-sale provision should be interpreted to cover activities that do not place the claimed invention itself on sale.

**6. *The ITC and Jinhe’s forfeiture arguments are meritless***

Finally, the ITC and Jinhe’s forfeiture arguments are wrong. There is no dispute that Celanese preserved the statutory interpretation of §102(a)(1) it presents for this Court’s review. In its brief and oral argument before the ALJ, Celanese argued that “under the America Invents Act the sale of a product made by a secret process does not invalidate a later patent on that process.” Appx11185 (capitalization and bold omitted); Appx11179-11204; Appx11205-11227; Appx11672-11860. And the ALJ expressly ruled on this question. Appx10-18. Likewise, in its petition for review, Celanese challenged that ruling: “[a]ccording to its terms, the AIA’s on-sale bar is not triggered by sales of an unpatented product made by a secret process.” Appx13640. These extensive arguments more than sufficed to preserve this issue. *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1342 (Fed. Cir. 2016) (“An issue is preserved for appeal ... so long as it can be said that the tribunal was fairly put on notice as to the substance of the issue.”) (quotations omitted), abrogated on other grounds by *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017).

Instead, what the ITC and Jinhe label forfeited or waived arguments are just support for the same statutory interpretation argument Celanese consistently advanced below. Appellate courts routinely consider such additional support. As the D.C. Circuit has explained: “appellate counsel will often present the same basic argument in a more polished and imaginative form than the [Federal Communications] Commission saw, but that, unfortunate as it may be for the Commission (and fortunate for us), is not the same thing as presenting a new argument on appeal.” *See, e.g., Southwestern Bell. Tel. Co. v. FCC*, 100 F.3d 1004, 1007-08 (D.C. Cir. 1996). For instance, this Court has consistently held that an appellant challenging the PTAB’s claim construction may point to additional parts of a patent’s specification or the intrinsic record to support a previously advanced claim construction. *Seabed Geosolutions (US) Inc. v. Magseis FF LLC*, 8 F.4th 1285, 1289-90 (Fed. Cir. 2021). Similarly here, while Celanese may be pointing to additional statutory provisions to support its interpretation of §102(a)(1), Celanese asks this Court to adopt the same interpretation it advanced below.

### **CONCLUSION**

The decision of the Commission should be reversed and the case remanded for further proceedings.

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Respectfully submitted,

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## CERTIFICATE OF COMPLIANCE

In compliance with Fed. R. App. P. 32(g) and Fed. Cir. R. 32(b)(3), I certify that:

This brief complies with the type-volume limitations of Fed. Cir. R. 32(b) because it contains 6,869 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(f) and Federal Circuit Rule 32(b), as determined by the word-counting feature of Microsoft Word.

This brief complies with the typeface requirement of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because it has been prepared in a proportionally spaced typeface, including serifs, using Microsoft Word 2022 in Times New Roman 14-point font.

Dated: April 18, 2023

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