

Syllabus

NOTE: Where it is feasible, a syllabus (headnote) will be released, as is being done in connection with this case, at the time the opinion is issued. The syllabus constitutes no part of the opinion of the Court but has been prepared by the Reporter of Decisions for the convenience of the reader. See *United States v. Detroit Timber & Lumber Co.*, 200 U. S. 321, 337.

SUPREME COURT OF THE UNITED STATES

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PFAFF v. WELLS ELECTRONICS, INC.

CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

No. 97–1130. Argued October 6, 1998– Decided November 10, 1998

Under §102(b) of the Patent Act of 1952, no one can patent an “invention” that has been “on sale” more than one year before filing a patent application. In early 1981, petitioner Pfaff designed a new computer chip socket and sent detailed engineering drawings of the socket to a manufacturer. He also showed a sketch of his concept to Texas Instruments, which placed an order for the new sockets prior to April 8, 1981. In accord with his normal practice, Pfaff did not make and test a prototype before offering to sell the socket in commercial quantities. He filled the order in July 1981, and thus the evidence indicates that he first reduced his invention to practice that summer. He applied for a patent on April 19, 1982, making April 19, 1981, the critical date for §102(b)’s on-sale bar. After the patent issued, he lost an infringement action he filed against respondent, Wells Electronics, Inc. Subsequently, he brought this suit, alleging that a modified version of Wells’ socket infringed six of his patent’s claims. The District Court held, *inter alia*, that three of the claims were infringed, rejecting Wells’ §102(b) defense on the ground that Pfaff had filed the patent application less than a year after reducing the invention to practice. In reversing, the Court of Appeals concluded, among other things, that §102(b)’s 1-year period began to run when the invention was offered for sale commercially, not when it was reduced to practice.

Held: Pfaff’s patent is invalid because the invention had been on sale for more than one year in this country before he filed his patent application. Pp. 5–13.

(a) The primary meaning of “invention” in the Patent Act unquestionably refers to the inventor’s conception rather than to a physical embodiment of that idea. The statute contains no express “reduction

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to practice” requirement, see §§100, 101, 102(g), and it is well settled that an invention may be patented before it is reduced to practice. In *The Telephone Cases*, 126 U. S. 1, 535–536, this Court upheld a patent issued to Alexander Graham Bell even though he had filed his application before constructing a working telephone. Applying the reasoning of *The Telephone Cases* to the facts of this case, it is evident that Pfaff could have obtained a patent when he accepted Texas Instruments’ order, for at that time he provided the manufacturer with a description and drawings of “sufficient clearness and precision to enable those skilled in the matter” to produce the device, *id.*, at 536. Pp. 5–7.

(b) Pfaff’s nontextual argument— that longstanding precedent, buttressed by the interest in providing inventors with a clear standard identifying the onset of the 1-year period, justifies a special interpretation of “invention” in §102(b)— is rejected. While reduction to practice provides sufficient evidence that an invention is complete, the facts of *The Telephone Cases* and this case show that such proof is not necessary in every case. Pp. 7–11.

(c) The on-sale bar applies when two conditions are satisfied before the critical date. First, the product must be the subject of a commercial offer for sale. Here, the acceptance of the purchase order prior to April 8, 1981, makes it clear that such an offer had been made, and there is no question that the sale was commercial. Second, the invention must be ready for patenting. That condition may be satisfied in at least two ways: by proof of reduction to practice before the critical date; or by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention. This condition is satisfied here because the drawings sent to the manufacturer before the critical date fully disclosed the invention. Pp. 11–13.

124 F. 3d 1429, affirmed.

STEVENS, J., delivered the opinion for a unanimous Court.