

ONE SIZE DOES NOT FIT ALL: KEEPING THE “TOTALITY OF
THE CIRCUMSTANCES” TEST FOR PUBLIC USE CASES
AFTER *PFAFF* AND *SMITHKLINE*

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ABSTRACT

The public use and on sale bars of 35 U.S.C. § 102 allow an inventor a one-year grace period to file for a patent from the first time the invention is used publicly or offered for sale. Until the Supreme Court decided *Pfaff v. Wells Electronics, Inc.*, the courts had been using the “totality of the circumstances” test for both the public use and on sale bars. In its holding in *Pfaff*, the Supreme Court changed the standard for applying the on sale bar from the “totality of the circumstances” test to the “ready for patenting” test; however, the Court was silent as to the public use bar.

The patent law community, on the whole, considered this silence to mean that the test for a public use had remained the same, and, aside from one Federal Circuit decision in 2004 that held otherwise (but was later vacated), the courts have continued to decide public use bar cases using the “totality of the circumstances” test. This has led some to criticize the “totality of the circumstances” test as vague and unpredictable and to argue for a *Pfaff*-like test in the context of a public use.

Although the “ready for patenting” test of *Pfaff* may work for the on sale bar, the public use bar requires the more flexible analysis provided by the “totality of the circumstances” test. The public use bar, although similar in some respects to the on sale bar, has different underlying policy justifications, consists of activities that are different by their nature from those of the on sale bar, and is intricately related to the experimental use doctrine. For these reasons, maintaining the multi-factor “totality of the circumstances” test for public use is the best way to ensure that the public

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will not be stripped of an invention that has been placed in the public domain and that the inventor will be allowed the time to perfect the work, ultimately providing the public with the fullest possible disclosure of the invention.