

Experimental Use—A Fragile Shield Against The One-Year Deadline For Filing Your Patent Application

By George Jakobsche

Experimental use is a judicial doctrine that may be invoked to delay the start of the one-year clock¹ for filing U.S. patent applications. A recent court ruling suggests that inventors tread cautiously in relying on the doctrine. Ordinarily, a public use or sale of an invention made more than one year before a patent application is filed bars the inventor from obtaining a patent. “Experimental use” allows an inventor to engage in activities that would otherwise bar him from obtaining a patent under the public use bar, as long as the use is necessary for experimentation. If the activity qualifies as experimental, the inventor can refute a charge that the activity rendered the invention unpatentable.

In *Clock Spring, L.P. v. Wrapmaster, Inc.*,² the Federal Circuit rejected Clock Spring’s argument that a demonstration of its technology should be considered an experimental use and affirmed a judgment invalidating its patent for failure to satisfy the one-year deadline. Clock Spring had demonstrated its gas pipe repair invention to representatives of several gas transmission companies more than one year before filing its patent application, without obligations of confidentiality. Clock Spring argued that the demonstrations were experimental uses, thus exempt from the statutory bar.

The Federal Circuit disagreed, because the tests were not designed to test claimed features of the invention or to determine if the invention worked for its intended purpose. The Federal Circuit found that the demonstrations were designed to seek input from industry representatives on the performance of the methods and their practicality, and to begin training maintenance personnel. No clear definition exists of experimental use. Generally, if the inventor’s intent is to perfect claimed features of the invention or verify its operability, the activity is experimental.

However, the Federal Circuit has cautioned, in *Netscape Communications Corporation v. Allan M. Konrad*,³ that an experimental use must test the

invention, not the market. Similarly, in *Atlanta Attachment Co. v. Leggett & Platt Inc.*,⁴ the court held that a test designed to determine if an invention suits a particular customer’s purpose does not satisfy the experimental use exception, particularly if the customer controls the test.

Clock Spring contended that its experiments were designed to test durability of the invention and assure its suitability for intended purposes. The court rejected this argument because the repaired pipes were buried and not dug up and examined until after the patent application had been filed. Thus, durability could not have been tested for purpose of the patent application.

In *Allen Engineering Corp. v. Bartell Industries, Inc.*,⁵ the Federal Circuit listed thirteen factors that tend to indicate whether a use is commercial or experimental. In short, an inventor should strive to:

1. Design the experiment to test the claimed invention, not the market for the invention;
2. Control the use of the invention during the experiment;
3. Inform spectators and participants (including co-workers) that all information about the invention and test is confidential;
4. Monitor the experiment;
5. Record and analyze data from the experiment and recover and examine the tested items before the patent application is filed; and
6. Avoid sales or offers for sale of the experimental equipment or methods in connection with the experiment.

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1. http://www.uspto.gov/web/offices/pac/mpep/documents/appxl_35_U_S_C_102

2. <http://www.cafc.uscourts.gov/opinions/08-1332.pdf>

3. <http://www.ll.georgetown.edu/federal/judicial/fed/opinions/01opinions/01-1455.pdf>

4. <http://www.cafc.uscourts.gov/opinions/07-1188.pdf>

5. <http://www.ll.georgetown.edu/federal/judicial/fed/opinions/01opinions/01-1238.pdf>

An inventor is understandably anxious to tweak every aspect of his invention and to talk up his creation to potential customers. However, to prevent becoming a victim of his own bid for success, the inventor should consult patent counsel about test objectives, the credentials (and number) of people involved in the tests, and test protocol and duration, before going forward.

Furthermore, since most other countries do not recognize experimental use as a basis for postponing the filing deadline, such use may bar the filing of patent applications in most of the rest of the world. Thus, to preserve foreign rights, it may be critical to file a patent application before demonstrating technology to third parties, even if the event is in the nature of an experiment. ■