

**LOSS OF PATENT RIGHTS –
“EXPERIMENTAL USE” VS. ON-SALE BAR/PUBLIC USE**

Patents are often one of the most important assets a company possesses. The timing of patent filings is a crucial consideration for companies as new products are developed. A patent claim is not valid if “the invention was...in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.” *35 U.S.C. §102(b)*. The test is whether, prior to the critical date, the claimed invention (i) was the subject of a commercial sale or offer for sale or was publicly used by a person, other than the inventor, who is under no confidentiality obligation, and (ii) was ready for patenting. Experimental use may negate public use, sale, or offer for sale in certain circumstances, but the experimentation must perfect a feature in the patent claims or to improve or verify an inherent feature of the claims. The 102(b) bar has been used to as a defense to patent infringement, and has been used to invalidate significant patents. The federal courts have held that it is not necessary that any party to the use, sale or offer for sale recognize the patentable characteristics of the product at that time to trigger the 102(b) bar; merely advertising an invention (without an actual offer for sale) will not trigger the 102(b) bar (but the content of the advertisement might constitute invalidating prior art). Recently, clinical testing of a drug did not qualify as an experimental use to negate the 102(b) bar where the tests were conducted to determine safety and efficacy, and did not involve the claimed features of the invention. Since the courts have focused on features of the patent claims with respect to 102(b) bar issues, patent claim strategies and patent filings should be developed early and matched with critical development dates in order to avoid a possible loss of patent rights.

By: Cliff Davidson, Esq.
Davidson, Davidson & Kappel, LLC
485 Seventh Avenue, New York, NY 10018
Telephone: (212) 736-1940
Facsimile: (212) 736-2427
Email: cdavidson@ddkpatent.com
www.ddkpatent.com