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Patently Enabled June 2025 – Experimental Use and Preserving Patent Rights

Key Takeaways

- A patent shall not issue if an invention was “on sale” more than one year before filing.
- The experimental use exception can prevent a sale or public use from triggering the On Sale Bar.
- Market testing is not a qualifying experimental use.
- Courts apply 13 factors to determine whether a transaction was experimental or commercial.
- Written agreements and customer awareness are critical to preserving patent rights.

A patent shall not issue if an invention was “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). Known as the On Sale Bar, one year after the first offer for sale, the inventor's own invention becomes prior art against the application. A sale for the purpose of technical experiment, however, may not activate the On Sale Bar. This is referred to as the experimental use exception. The experimental use exception similarly applies to any public use of the invention that might otherwise become blocking prior art.

Experimental use requires that the sale or use of the invention is designed to (1) test claimed features of the invention or (2) determine whether an invention will work for its intended purpose. The experimental use must be for the purpose of filing a patent application. Market testing is not a qualifying experimental use.
The experimental use exception may be asserted during prosecution of the patent or during litigation. During prosecution, the best practice is to disclose the prior sale or use of the invention and then present evidence to the examiner establishing the experimental use. This approach allows the examiner to assess the exception in light of the full factual record.

During litigation, the analysis proceeds differently. The accused infringer will first carry the burden of proving the sale or public use of the invention before the bar date by clear and convincing evidence. The patent holder can then seek to establish the applicability of the experimental use exception.

Courts evaluate whether a transaction was a commercial sale or instead for the purpose of experimental use by considering 13 factors. The same factors govern whether the experimental use exception applies to the public use bar. Several important factors include whether payment was made, whether there was a secrecy obligation, the degree of commercial exploitation during testing, and whether the invention reasonably requires evaluation under actual conditions of use.

Additional factors include the necessity for public testing, the amount of control over the experiment retained by the inventor, the nature of the invention, the length of the test period, whether records of the experiment were kept, who conducted the experiment, whether testing was systematically performed, whether the inventor continually monitored the invention during testing, and the nature of contacts made with potential customers.

It is critical that the customer is aware of the testing in the context of a sale. Otherwise, the transaction will normally be viewed as a commercial sale rather than an experimental one.

When patent protection is being considered and third parties must be involved in experimentation, especially where filing within one year may not be possible, it is important to have a written agreement clearly noting the intent of the parties. Often

such agreements take the form of a nondisclosure, confidentiality, or beta test agreement. Any such agreement, and the parties' performance under it, should address the 13 factors courts consider in evaluating experimental use.

Careful planning, documentation, and transparency are essential to preserving patent rights when experimental use is relied upon to avoid the On Sale Bar.

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