

**ELECTROMOTIVE DIVISION OF GENERAL MOTORS CORP. v. TRANSPORTATION**  
**SYSTEM DIVISION OF GENERAL ELECTRIC CO.: EXPERIMENTAL**  
**USE EXCEPTION TO 35 U.S.C. 102(b) “ON-SALE BAR”**

The Court of Appeals for the Federal Circuit (CAFC) affirmed a district court’s granting of summary judgment of invalidity concerning the applicability of the experimental use exception to 35 U.S.C. 102(b) on-sale bar. *See Electromotive Div. of Gen. Motors Corp. v. Transp. Sys. Division of Gen. Elec. Co.*, 417 F.3d 1203 (Fed. Cir. 2005). The CAFC ruled that the experimental use exception does not apply to pre-critical date public use or sale under § 102(b) except where the inventor maintains control of the invention and the customer is aware of such experimentation.

The CAFC acknowledged that there are several non-exhaustive factors that may be considered in determining whether experimental use applies such as: “(1) the necessity for public testing; (2) the amount of control over the experiment retained by the inventor; (3) the nature of the invention; (4) the length of the test period; (5) whether payment was made; (6) whether there was a secrecy obligation; (7) whether records of the experiment were kept; (8) who conducted the experiment; (9) the degree of commercial exploitation during the testing; (10) whether the invention reasonably requires evaluation under actual conditions of use; (11) whether testing was systematically performed; (12) whether the inventor continually monitored the invention during testing; and (13) nature of the contacts made with potential customers. *Id.* at 1213 (*citing Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1352 (Fed. Cir. 2002)).

Nevertheless, the CAFC noted that: “Certain factors, such as the requirement that the inventor control the testing, that detailed progress records be kept, and that the purported testers know that testing is occurring, are critical to proving experimental purpose.” *Id.* at 1214 (*citing C.R. Bard Inc. v. M3 Sys. Inc.*, 157 F.3d 1340 (Fed. Cir. 1998)). Consequently, the CAFC concluded: “. . . control and customer awareness ordinarily must be proven if experimentation is to be found.” *Id.*

In light of this ruling, it is prudent for inventors to carefully consider the implications of conducting experiments with customers or the general public particularly when the experiment involves an invention that is not the subject of a patent application filed in the United States Patent Office.

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