

soned that section 9(c)(1)(B) gave employers the option to petition for an election. Failing to exercise this option, the employer either had to bargain or risk a section 8(a)(5) violation.⁴⁶

Despite the lack of rationale strictly interpretive of the Act, the *Linden* decision appears to be sound. Employers are protected from orders to bargain when their knowledge of the representative's majority status is later subjectively found to have been sufficient to have raised a bargaining obligation. Employees are also protected from interference with their right to organize by other sections of the Act. For example, if an employer threatens employees or discharges them as a response to a request to bargain, the employer could be held to have violated sections 8(a)(1)⁴⁷ or 8(a)(3)⁴⁸ respectively. Then the Board would consider the degree to which the violations interfered with the employee's right to organize and, using *Gissel* as a guideline, would fashion an appropriate remedy.

Further, by imposing the burden upon the representative, the Court has not deprived either the employer or the union of any tactical advantage which may accrue from filing the petition at a particular time. For example, even though not required to do so, the employer may wish to petition for an election if it feels that the representative's strength has waned such that the union would lose the election. No election could be held in that bargaining unit for twelve months following the election.⁴⁹

In summary, the *Linden* doctrine is that when an employer is confronted by authorization cards signed by a majority of employees, it may refuse to collectively bargain as long as it does not commit any collateral unfair labor practices. The burden is then upon the union to file for an election and no section 8(a)(5) violation charge will lie against the employer. However, if the employer commits acts which tend to upset the laboratory conditions after it has been asked to bargain, then an appropriate remedy will be issued by the Board to counteract those actions. Such a remedy may be an order to bargain, an order to cease and desist, or an order to take whatever affirmative action is necessary to restore the laboratory conditions, depending upon the severity of the employer's interference with the employees' right to organize.

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46. *Id.* at 436.

47. 29 U.S.C. § 158(a)(1) (1970).

48. 29 U.S.C. § 158(a)(3) (1970).

49. 29 U.S.C. § 159(c)(3) (1970). Note that before an election can be held, and thus the twelve month bar invoked, the Board must find that a "question of representation" exists. Thus, no frivolous petitions can be filed by employers to simply gain twelve months of peace.

PATENTS—THE AVAILABILITY OF THE EXPERIMENTAL USE EXCEPTION AS A STAY OF THE ON SALE OR PUBLIC USE BAR IN 102(b) DEPENDS IN PART ON THE INTENT OF THE INVENTOR.—*In re Yarn Processing Patent Validity Litigation* (5th Cir. 1974).

In the mid-1930's two co-inventors began experiments leading toward the invention of the single heater false twister. The co-inventors first converted an upwister to their single heater false twist in July of 1950. On December 15, 1952 the co-inventors granted a license to Synfoam to use their false twist process. More than a year later on January 4, 1954, the inventors filed applications for the three patents in issue.¹ Defendant Leeson acquired the patent applications in December of that year and the patents issued on August 20, 1957. Actions were filed by several plaintiffs against Leeson to declare invalid the three patents whose teachings laid the technological foundation for the development of the double-knit fabrics. Granting a partial summary judgment for plaintiffs in a consolidated proceeding the trial court held the patents invalid on the basis of their being non-experimentally on sale and in public use more than one year prior to the application. On appeal the Fifth Circuit, *held*, reversed and remanded, the question of whether use more than one year before the application for a patent is experimental depends in part upon a factual determination of the intent of the inventor. *In re Yarn Processing Patent Validity Litigation*, 498 F.2d 271 (5th Cir. 1974).

To obtain a patent an inventor must show that his invention is useful,² novel,³ and a nonobvious development over the prior art.⁴ The *United States Code* provides that an inventor shall not be entitled to a patent 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 . . ."⁵ A finding of "on sale" or in "public use" under Section 102(b) negates the inventions novelty, and will, in addition to precluding the issuance of a patent, invalidate a previously issued patent.⁶ Public use has been interpreted broadly by the courts.⁷ The concept of public use has been applied to a single use,⁸

1. For a description of the patented inventions see *In re Yarn Processing Patent Validity Litigation*, 360 F. Supp. 74, 91-99 (S.D. Fla. 1973), *rev'd*, 498 F.2d 271 (5th Cir. 1974). For a general discussion of patent law see Voorhees, *A Summary of Patent Law for the General Practitioner*, 20 *DRAKE L. REV.* 227 (1971).

2. 35 U.S.C. § 101 (1970).

3. 35 U.S.C. § 102 (1970).

4. 35 U.S.C. § 103 (1970).

5. 35 U.S.C. § 102(b) (1970). The original patent statutes provided no grace period for public use. The Act of March 3, 1839, ch. 88, § 7, 2 Stat. 353 introduced a two-year grace period. This two-year period remained in force until the Act of Aug. 5, 1939, ch. 450, 53 Stat. 1212 reduced the period to the present one year.

6. See, e.g., *Consolidated Fruit-Jar Co. v. Wright*, 94 U.S. 92 (1876); *Shaw v. Cooper*, 32 U.S. (7 Pet.) 292 (1833).

7. *Kardulas v. Florida Mach. Prod. Co.*, 438 F.2d 1118, 1123 (5th Cir. 1971); *Vasil, Public Use: The Inventor's Dilemma*, 26 *Geo. Wash. L. Rev.* 297 (1958).

8. See, e.g., *Electric Storage Battery Co. v. Shimadzu*, 307 U.S. 5 (1939); *Minnesota Mining & Mfg. Co. v. Kent Indus., Inc.*, 409 F.2d 99 (6th Cir. 1969).

whether made by the inventor or by others,⁹ and whether visible or hidden from normal observation.¹⁰ The concept of sales has been applied to a single sale.¹¹ However, to be a sale under 102(b) the invention must be a reality and a contract to sell an invention not yet constructed does not place the invention on sale.¹²

A major exception to the on sale or in public use bar is the judicially created doctrine of experimental use. The inventor can avoid the running of the one-year period¹³ by showing that the use of his invention was "substantially for purposes of experiment."¹⁴ The experimentation must relate to a part of the invention claimed rather than to incidental features of the invention.¹⁵ In *City of Elizabeth v. American Nicholson Pavement Co.*,¹⁶ the United States Supreme Court expressed the general philosophy behind this exception to be the benefit of both the inventor and the public "that the invention should be perfect and properly tested, before a patent is granted for it."¹⁷ The extent of the exception is limited and in making determinations of experimental use the courts must be careful not to "interfere with the effectuation of the policy underlying the general rule of early disclosure."¹⁸

Determinations of experimental use under 102(b) most frequently arise in patent infringement or patent validity actions where the inventor used the invention more than one year before his application for a patent.¹⁹ In these cases the doctrine of experimental use is applied to the prior use asserted by the alleged infringer in his effort to have the patent held invalid.²⁰ The *United States Code* provides a statutory presumption in favor of patent validity.²¹ The party asserting that the patent is invalid under 102(b) has the burden of showing a prior use.²² Once the prior use has been shown, the pat-

9. See, e.g., *Magee v. Coca-Cola Co.*, 232 F.2d 596 (7th Cir. 1956).

10. See, e.g., *Hall v. Macneale*, 107 U.S. 90 (1882); *Egbert v. Lippmann*, 104 U.S. 333 (1881); *Koehring Co. v. National Automatic Tool Co.*, 362 F.2d 100 (7th Cir. 1966).

11. *Consolidated Fruit-Jar Co. v. Wright*, 94 U.S. 92 (1876).

12. *Hobbs v. AEC*, 451 F.2d 849, 859 (5th Cir. 1971).

13. See note 5 *supra*.

14. *Smith & Griggs Mfg. Co. v. Sprague*, 123 U.S. 249, 256 (1887).

15. *Midland Flour Milling Co. v. Bobbitt*, 70 F.2d 416 (8th Cir. 1934).

16. 97 U.S. 126 (1878).

17. *Id.* at 137.

18. *Koehring Co. v. National Automatic Tool Co.*, 362 F.2d 100, 103 (7th Cir. 1966).

19. See, e.g., *Smith & Griggs Mfg. Co. v. Sprague*, 123 U.S. 249 (1887); *City of Elizabeth v. American Nicholson Pavement Co.*, 97 U.S. 126 (1878); *In re Yarn Processing Patent Validity Litigation*, 498 F.2d 271 (5th Cir. 1974); *Aerovox Corp. v. Polymet Mfg. Corp.*, 67 F.2d 860 (2d Cir. 1933). Occasionally the experimental use exception may be an issue in ex parte appeals from patent interference proceedings. See *Watson v. Allen*, 254 F.2d 342 (D.C. Cir. 1958).

20. See, e.g., *City of Elizabeth v. American Nicholson Pavement Co.*, 97 U.S. 126 (1878); *In re Yarn Processing Patent Validity Litigation*, 498 F.2d 271 (5th Cir. 1974); *Magnetics, Inc. v. Arnold Eng'r Co.*, 438 F.2d 72 (7th Cir. 1971).

21. 35 U.S.C. § 282 (1970).

22. *Julian v. Drying Systems Co.*, 346 F.2d 336 (7th Cir. 1965) (mere preponderance is not sufficient); *Bourns, Inc. v. Dale Electronics, Inc.*, 308 F. Supp. 501 (D. Neb. 1969) (a heavy burden).

entee has the burden of proving the use was experimental.²³ The determination of experimental use involves a question of fact, not to be disturbed on appeal unless clearly erroneous.²⁴

The doctrine of experimental use has been recognized by all the circuits as well as the Court of Customs and Patent Appeals.²⁵ The holdings by the various courts have been confusing, inconsistent and contradictory.²⁶ In the evaluation of experimental uses the courts have developed two analytical approaches. The first asks whether the *invention* was in an experimental stage,²⁷ and the second asks whether the *use* made in the instant case was experimental.²⁸ In many cases the exact approach, or combination of the two approaches, is unclear. The trial court in *In re Yarn Processing Patent Validity Litigation*,²⁹ seemed to adopt the position that experimentation ends at the time a commercially usable model comes into existence.³⁰ The presence of the license to Synfoam ended the inquiry of the trial court, for the license was determinative of the end of the experimental stage.³¹ On appeal in *In re Yarn Processing Patent Validity Litigation*,³² the Fifth Circuit chose to look at whether the actual use was experimental in holding that the license could be either consistent or inconsistent with experimental use, depending upon a factual determination.³³

There is apparent agreement that experimental use can continue beyond the first actual reduction to reality. The courts are divided on just how long the experimental use exception is available. Some authority holds that the experimental use exception is not available beyond the legal reduction to practice.³⁴ The courts following this view find legal reduction to practice when the

23. *Aerovox Corp. v. Polymet Mfg. Corp.*, 67 F.2d 860 (2d Cir. 1933) (stronger proof than in ordinary civil suits); *In re Blaisdell*, 242 F.2d 779 (C.C.P.A. 1957).

24. *McCullough Tool Co. v. Well Surveys, Inc.*, 343 F.2d 381, 394 (10th Cir. 1965), *cert. denied*, 383 U.S. 933 (1966).

25. *In re Yarn Processing Patent Validity Litigation*, 498 F.2d 271 (5th Cir. 1974); *Robbins Co. v. Lawrence Mfg. Co.*, 482 F.2d 426 (9th Cir. 1973); *Cali v. Eastern Airlines, Inc.*, 442 F.2d 65 (2d Cir. 1971); *Magnetics, Inc. v. Arnold Eng'r Co.*, 438 F.2d 72 (7th Cir. 1971); *Minnesota Mining & Mfg. Co. v. Kent Indus., Inc.*, 409 F.2d 99 (6th Cir. 1969); *Universal Marion Corp. v. Warner & Swasey Co.*, 354 F.2d 541 (10th Cir. 1965), *cert. denied*, 384 U.S. 927 (1966); *Nicholson v. Carl W. Mullis Eng'r & Mfg. Co.*, 315 F.2d 532 (4th Cir. 1963); *Atlas v. Eastern Air Lines, Inc.*, 311 F.2d 156 (1st Cir. 1962), *cert. denied*, 373 U.S. 904 (1963); *Watson v. Allen*, 254 F.2d 342 (D.C. Cir. 1958); *U.S. Chem. Corp. v. Plastic Glass Corp.*, 243 F.2d 892 (3d Cir. 1957); *Smith & Davis Mfg. Co. v. Mellon*, 58 F. 705 (8th Cir. 1893); *Federal Mfg. & Printing Co. v. United States*, 42 Ct. Cl. 479 (1907); *In re Blaisdell*, 242 F.2d 779 (C.C.P.A. 1957).

26. Compare *Watson v. Allen*, 254 F.2d 342 (D.C. Cir. 1958) with *In re Blaisdell*, 242 F.2d 779 (C.C.P.A. 1957) (reaching opposite results on ex parte appeals from a single patent interference proceeding).

27. See, e.g., *Cataphote Corp. v. De Soto Chem. Coatings, Inc.*, 356 F.2d 24, 27 (9th Cir.), *cert. denied*, 385 U.S. 832 (1966).

28. See *Ushakoff v. United States*, 327 F.2d 669 (Ct. Cl. 1964). Cf. *Aerovox Corp. v. Polymet Mfg. Corp.*, 67 F.2d 860 (2d Cir. 1933).

29. 360 F. Supp. 74 (S.D. Fla. 1973).

30. *Id.* at 84.

31. *Id.*

32. 498 F.2d 271 (5th Cir. 1974).

33. *Id.* at 285.

34. *Nicholson v. Carl W. Mullis Eng'r & Mfg. Co.*, 315 F.2d 532 (4th Cir. 1963); *Minnesota Mining & Mfg. Co. v. Kent Indus., Inc.*, 274 F. Supp. 993 (E.D. Mich. 1967),

invention is perfected to a form that is of the quality and character to be useable in normal use or operation.³⁵ There is also considerable authority that the period of experimentation can continue beyond the date of legal reduction to practice.³⁶ One district court has expressed this view as:

[T]he test for establishing a reduction to practice is different than the test for establishing an experimental use. To establish a reduction to practice of the inventor's idea, there must be a demonstration that the inventor's idea works; in other words, that the invention will perform in a manner which will accomplish its intended purpose Thus, there may be an experimental use even following reduction to practice where the experiments are part of an attempt to further refine the device.³⁷

The courts following the view that experimentation may continue beyond legal reduction to practice do not automatically preclude a finding of experimental use even though the invention may have been functional for general public use. In *Elizabeth* a six year durability test of a section of the roadway in normal usage was found to be experimental. This approach contains the flexibility needed when inventions teach in complex and newly opened areas.

Whether the use of an invention is for experimental purposes depends upon the good faith intent of the inventor.³⁸ In *Yarn Processing* much stress was placed on the point that experimental use depends on this factual determination of intent.³⁹ The inventor's subjective intent must be supported by objective evidence and in the face of evidence to the contrary the inventor's testimony of his intent to experiment has little probative force.⁴⁰ The courts have focused upon several objective factors to determine the intent of the inventor. Some of these factors are the degree of commercial exploitation,⁴¹ developmental changes,⁴² transfer of title,⁴³ inspection⁴⁴ and retention of control.⁴⁵ These criteria aid the court in deciding whether the experimental

aff'd, 409 F.2d 99 (6th Cir. 1969); *Sperry Rand Corp. v. Bell Tel. Laboratories, Inc.*, 208 F. Supp. 598 (S.D.N.Y. 1962), *appeal dismissed*, 317 F.2d 491 (2d Cir. 1963).

35. In *Field v. Knowles*, 183 F.2d 593 (C.C.P.A. 1950), the court stated: "Actual performance is required of the function for which the machine is intended with a quality, extent, and character of operation sufficient to indicate its utility in the environment in which it is contemplated to be useful." *Id.* at 601.

36. *Atlas v. Eastern Air Lines, Inc.*, 311 F.2d 156 (1st Cir. 1962), *cert. denied*, 373 U.S. 904 (1963); *Solo Cup Co. v. Paper Mach. Corp.*, 240 F. Supp. 126 (E.D. Wis. 1965), *modified on other grounds*, 359 F.2d 754 (7th Cir. 1966); *General Motors Corp. v. Bendix Aviation Corp.*, 123 F. Supp. 506 (N.D. Ind. 1954).

37. *Cataphote Corp. v. De Soto Chem. Coatings, Inc.*, 235 F. Supp. 931, 934 (N.D. Cal. 1964), *aff'd*, 356 F.2d 24 (9th Cir.), *cert. denied*, 385 U.S. 832 (1966).

38. *Smith & Griggs Mfg. Co. v. Sprague*, 123 U.S. 249 (1887); *In re Yarn Processing Patent Validity Litigation*, 498 F.2d 271 (5th Cir. 1974); *Chromalloy Am. Corp. v. Alloy Surfaces Co.*, 339 F. Supp. 859 (D. Del. 1972); *Lanham v. Southern Bakeries Co.*, 198 F. Supp. 926 (N.D. Ga. 1960), *aff'd*, 295 F.2d 816 (5th Cir. 1961).

39. 498 F.2d 271, 285-86 (5th Cir. 1974).

40. *Robbins Co. v. Lawrence Mfg. Co.*, 482 F.2d 426, 431 (9th Cir. 1973).

41. See text accompanying notes 48-50 *infra*.

42. See text accompanying note 51 *infra*.

43. See text accompanying notes 58-66 *infra*.

44. See text accompanying notes 68-71 *infra*.

45. See text accompanying notes 72-78 *infra*.

stage of development has ended, or whether the particular use is experimental.⁴⁶

Use of the invention for experimental purposes where, as an incident to the experimental use, the inventor receives financial gain does not make the use public within the meaning of 102(b).⁴⁷ Similarly, the inventor may in certain situations sell the product of an experimental machine.⁴⁸ However, the experimental use period ends when the primary motivation of the use ceases to be experimental, and the motivation of the inventor becomes the commercial exploitation of the invention.⁴⁹ This limitation is imposed to prevent the inventor from increasing the length of his limited monopoly by exploiting the invention until the competitors near and then seeking the protection of a patent.⁵⁰

The majority view today is that experimental uses need not be fashioned with an intent to modify the invention.⁵¹ The lack of development or change as a result of a claimed experiment may indicate the experiment period has ended.⁵² The authority is divided on the question of whether the focus of the experiment must be directed toward the invention itself, or if it is possible for the inventor to test the value of the invention on the market. The Eighth Circuit, in *Smith & Davis Manufacturing Co. v. Mellon*,⁵³ held that a testing of the market to see how well the article would sell did not constitute such an experimental use as to be an exception to 102(b).⁵⁴ On the other side, the Second Circuit in *Aerovox Corp. v. Polymet Manufacturing Corp.*,⁵⁵ held that an inventor may experiment not only to put his invention into reality but also "to see whether his ideas are worth exploiting."⁵⁶ Under economic conditions where the potential market may be a determinative factor to the inventor in his decision to pursue his invention the view adopted by the Second Circuit would seem to be the better reasoned view. Under either view the intent of the inventor, not the intent of potential users or buyers, determines whether the use is experimental.⁵⁷

46. See text accompanying notes 27-28 *supra*.

47. *Smith & Griggs Mfg. Co. v. Sprague*, 123 U.S. 249, 256 (1887); *Merrill v. Builders Ornamental Iron Co.*, 197 F.2d 16 (10th Cir. 1952).

48. *American Caramel Co. v. Thomas Mills & Bros.*, 149 F. 743 (3d Cir. 1906) (product of candy cutting machine sold); *Bryce Bros. Co. v. Seneca Glass Co.*, 140 F. 161 (N.D.W. Va. 1905) (product of glass engraving machine sold).

49. *Koehring Co. v. National Automatic Tool Co.*, 362 F.2d 100, 103 (7th Cir. 1966); *Solo Cup Co. v. Paper Mach. Corp.*, 240 F. Supp. 126, 131 (E.D. Wis. 1965), *modified on other grounds*, 359 F.2d 754 (7th Cir. 1966).

50. *Koehring Co. v. National Automatic Tool Co.*, 362 F.2d 100, 103 (7th Cir. 1966); *Metallizing Eng'g Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F.2d 516, 520 (2d Cir.), *cert. denied*, 328 U.S. 840 (1946).

51. See, e.g., *City of Elizabeth v. American Nicholson Pavement Co.*, 97 U.S. 126 (1877); *Cali v. Eastern Airlines, Inc.*, 442 F.2d 65, 70 (2d Cir. 1971); *Aerovox Corp. v. Polymet Mfg. Corp.*, 67 F.2d 860, 862 (2d Cir. 1933). But see *Smith & Davis Mfg. Co. v. Mellon*, 58 F. 705, 707 (8th Cir. 1893).

52. *Pigott, The Concepts of Public Use and Sale*, 49 J. PAT. OFF. SOC'Y 399, 413 (1967).

53. 58 F. 705 (8th Cir. 1893).

54. *Id.* at 707.

55. 67 F.2d 860 (2d Cir. 1933).

56. *Id.* at 862.

57. *Chromalloy Am. Corp. v. Alloy Surfaces Co.*, 339 F. Supp. 859, 871 (D. Del.

Early cases held that the inventor had to retain title to his invention in order to avail himself of the experimental use exception.⁵⁸ The recent trend of authority has been that the title may pass to a third party and transfer does not destroy the availability of the experimental use exception.⁵⁹ Any transfer must be made with the intent to have the invention tested.⁶⁰ The testing of the invention by the transferee will not make the use experimental in the absence of the requisite intent in the inventor at the time of the transfer.⁶¹ Even if the inventor has the requisite intent a public use will be found if the transferee makes a non-experimental disclosure.⁶² The public use may be found even though such a disclosure is a breach of the transferee's obligation to the inventor.⁶³ The Ninth Circuit in *Robbins Co. v. Lawrence Manufacturing Co.*,⁶⁴ adopted a rule that the requisite experimental intent will not be found in the absence of "an express or clearly implied condition that the sale or offering is made primarily for experimental use."⁶⁵ *Yarn Processing* rejected this view as excessively rigid, holding instead that an inventor should be given a chance to introduce evidence of an experimental intent.⁶⁶ There is some authority that an inventor can avoid public use by seeking to establish that the use by an inventor who developed the invention independently was an experimental use.⁶⁷

The amount of inspection is often an important factor in the determination of experimental use.⁶⁸ Experimentation without a program of inspection or reporting would be a fruitless effort. Lack of inspection may be more useful as a tool for determining when a use is not experimental than presence of inspection would be a guide for finding experimental use.⁶⁹ Several

1972); *Tool Research & Eng'r Corp. v. Honcor Corp.*, 240 F. Supp. 296, 301 (S.D. Cal. 1964), *aff'd*, 367 F.2d 449 (9th Cir. 1966), *cert. denied*, 387 U.S. 919 (1967).

58. *Smith & Griggs Mfg. Co. v. Sprague*, 123 U.S. 249 (1887).

59. *Robbins Co. v. Lawrence Mfg. Co.*, 482 F.2d 426, 431 (9th Cir. 1973); *Watson v. Allen*, 254 F.2d 342, 346 (D.C. Cir. 1958).

60. *Egbert v. Lippmann*, 104 U.S. 333 (1881).

61. *See, e.g., Tool Research & Eng'r Corp. v. Honcor Corp.*, 367 F.2d 449, 453 (9th Cir. 1966), *cert. denied*, 387 U.S. 919 (1967); *Cataphote Corp. v. De Soto Chem. Coatings, Inc.*, 235 F. Supp. 936, 939 (N.D. Cal. 1964), *aff'd*, 356 F.2d 24 (9th Cir.), *cert. denied*, 385 U.S. 832 (1966).

62. *Cali v. Eastern Airlines, Inc.*, 442 F.2d 65, 69 (2d Cir. 1971).

63. *Lorenz v. Colgate-Palmolive-Peet Co.*, 167 F.2d 423 (3d Cir. 1948), *noted in* 17 GEO. WASH. L. REV. 418 (1949).

64. 482 F.2d 426 (9th Cir. 1973).

65. *Id.* at 433.

66. *In re Yarn Processing Patent Validity Litigation*, 498 F.2d 271, 287 (5th Cir. 1974).

67. *Watson v. Allen*, 254 F.2d 342 (D.C. Cir. 1958). There are cases where such an effort has not been successful. *Atlas v. Eastern Air Lines, Inc.*, 311 F.2d 156 (1st Cir. 1962), *cert. denied*, 373 U.S. 904 (1963) (demonstration to news media showed experimental stage of independent inventor had ended); *Atlas Chem. Indus., Inc. v. Moraine Prod., Inc.*, 350 F. Supp. 353 (E.D. Mich. 1972) (use of same drug by independent inventor found not to be experimental).

68. *See, e.g., Baumler v. Ford Motor Co.*, 89 F. Supp. 218 (D. Minn. 1949); *Metallizing Eng'r Co. v. Kenyon Bearing & Auto Parts Co.*, 62 F. Supp. 42, 55-56 (D. Conn. 1945), *rev'd on other grounds*, 153 F.2d 516 (2d Cir.), *cert. denied*, 328 U.S. 840 (1946); *Kennedy v. Ford Motor Co.*, 45 U.S.P.Q. 126 (S.D. Ohio 1940).

69. 52 MINN. L. REV. 851, 854 (1968).

cases have found the absence of inspection an important factor in finding public rather than experimental use.⁷⁰ The presence of inspection is not enough to find an experimental use in the presence of other factors indicating public use,⁷¹ nonetheless *Yarn Processing* indicates that inspection or reporting is an important factor.

Lack of control over the experimental invention has been considered as an indication that the use is not experimental.⁷² Lack of control, like inspection, is better adapted as a measure of the absence of experimental use.⁷³ When the inventor is forced to allow a third party to test his invention, he is not penalized for his lack of facilities as long as he maintains sufficient contact with his invention.⁷⁴ There is a division of authority on what control an inventor must retain over a discarded experimental model of his invention.⁷⁵ In *Watson v. Allen*,⁷⁶ a flexible approach was taken to the question of control, the method of disposal to be determined from the facts of each case.⁷⁷ Although this flexible approach may seem desirable there is authority that a public use will be found when an inventor loses control over any discarded experimental prototype.⁷⁸

Only from an evaluation of all the relevant criteria can a determination of experimental use be made. The facts in *Yarn Processing* show that the co-inventors by their actions gave some, but not many, indications that the use of the invention was experimental. As a result of the license to Synfoam there were financial gains to the co-inventors. Under the agreement title to several of the new spindles passed to the licensee with no mention of experimentation. The co-inventors retained no control over their invention. There was experimentation on the Synfoam machines and reporting of operating results to the co-inventors. As a result of the use some improvements and alterations were made in the invention.⁷⁹

The alleged infringers in attacking the validity of the three patents argued that the facts surrounding the license showed that no factual issue of experimentation existed.⁸⁰ In opposition to the motion for summary judgment, Leeson, the patentee, tried to show that a factual question existed as to experimentation even though the written license did not show such a use.⁸¹ The Fifth Circuit, in reversing the summary judgment of invalidity, found an

70. Cases cited note 68 *supra*.

71. *Smith & Griggs Mfg. Co. v. Sprague*, 123 U.S. 249, 265 (1887).

72. *See, e.g., Bauml v. Ford Motor Co.*, 89 F. Supp. 218 (D. Minn. 1949); *In re Blaisdell*, 242 F.2d 779, 784 (C.C.P.A. 1957).

73. 52 M.N.N. L. REV. 851, 855 (1968).

74. *Cali v. Eastern Airlines, Inc.*, 442 F.2d 65, 69-70 (2d Cir. 1971).

75. *Compare Goodwin v. Borg-Warner Corp.*, 157 F.2d 267 (6th Cir. 1946), *cert. denied*, 329 U.S. 799 (1947) with *In re Blaisdell*, 242 F.2d 779 (C.C.P.A. 1957).

76. 254 F.2d 342 (D.C. Cir. 1958).

77. *Id.* at 347.

78. *In re Blaisdell*, 242 F.2d 779, 784 (C.C.P.A. 1957).

79. 498 F.2d 271, 287 (5th Cir. 1974).

80. *Id.* at 285.

81. *Id.* at 287.

issue of fact remained,⁸² but avoided any comment on the strength of the evidence of experimental use. The evidence presented by the patentee tending to show an experimental intent by the inventors must be taken in a light most favorable to the patentee in deciding a motion for summary judgment by those attacking the patent.⁸³ Decisions as to the credibility of the evidence, especially when intent of the inventors is involved, must be left to the trier of fact.⁸⁴

The decision in *Yarn Processing* clearly recognizes the intent of the inventor as a factual issue in the determination of whether a use is experimental. Almost any allegation by the patentee as to the inventor's intent when taken as true would present an issue of fact material enough to render inappropriate summary judgment. The effect of this recognition of intent would indicate that the availability of a summary judgment of invalidity where the sale or use is alleged to be experimental is severely limited.

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82. *Id.*

83. *Id.*

84. *Id.* at 288.

