IP Monitor: I Went Public With My Invention – Can I Still Get a Patent?

Intellectual Property

According to the Canadian *Patent Act,* to be granted a patent, an invention must not have been "available to the public" before the patent application was filed with the Canadian Patent Office. This is known as "novelty." However, every rule has its exceptions.

One of these exceptions was discussed in a decision from the Federal Court of Canada.[1] This exception is rarely invoked. The judge based his reasoning on old decisions, the earliest dating from 1904. The exception is based on an "experimental use" of the invention:

"[E]xperimental use in order to bring the invention to perfection, does not constitute public use[…]. This applies in particular where, of necessity, the experimental use must be conducted in public."

1 Bayer Inc. v. Apotex Inc. 2014 FC 436.

In this case, Bayer performed clinical studies with the general public which were necessary to prove that a drug was safe. Bayer took reasonable steps to ensure the confidentiality of the relevant documents and to ensure that unused tablets were returned. The theoretical possibility that some tablets were retained and analyzed was just that, theoretical. These clinical studies were therefore not considered a public use. Here are some other circumstances where the exception was applied.

Snowplow

The inventor of a snowplow tested his invention in Quebec City by attaching it to a tram and using it

openly in the streets for years before filing a patent application. The inventor said the use was experimental and that he was fine-tuning his invention based on his observations. The Court found that the publicly tested snowplow had never gone beyond the experimental phase, and said the public use of an invention by the inventor for the purpose of perfecting it does not make an invention accessible to the public as long the public acts were reasonable, necessary and done in good faith.

The animal feeder

A farmer had a patent on an animal feeder. Before he filed the patent application, the farmer used the feeder on his farm which was accessible to the public. The Court found that the farmer had no choice but to test his invention with his own cattle because they were on his farm and would eventually be sold. His public use was therefore considered experimental.

For a public use to qualify as an “experimental use,” the use has to be:

- necessary and reasonable. In other words, it was impossible to test the invention secretly and the inventor took reasonable steps to ensure a degree of confidentiality; and
- done for the singular goal of perfecting the invention, and not for a commercial purpose.

Even if this exception exists, it is risky to rely on it. The exception is not applied in the same way in all countries where inventors might wish to protect their inventions, and does not apply at all in some regions (e.g., Europe). One should therefore keep inventions confidential and secret until a patent application is filed.

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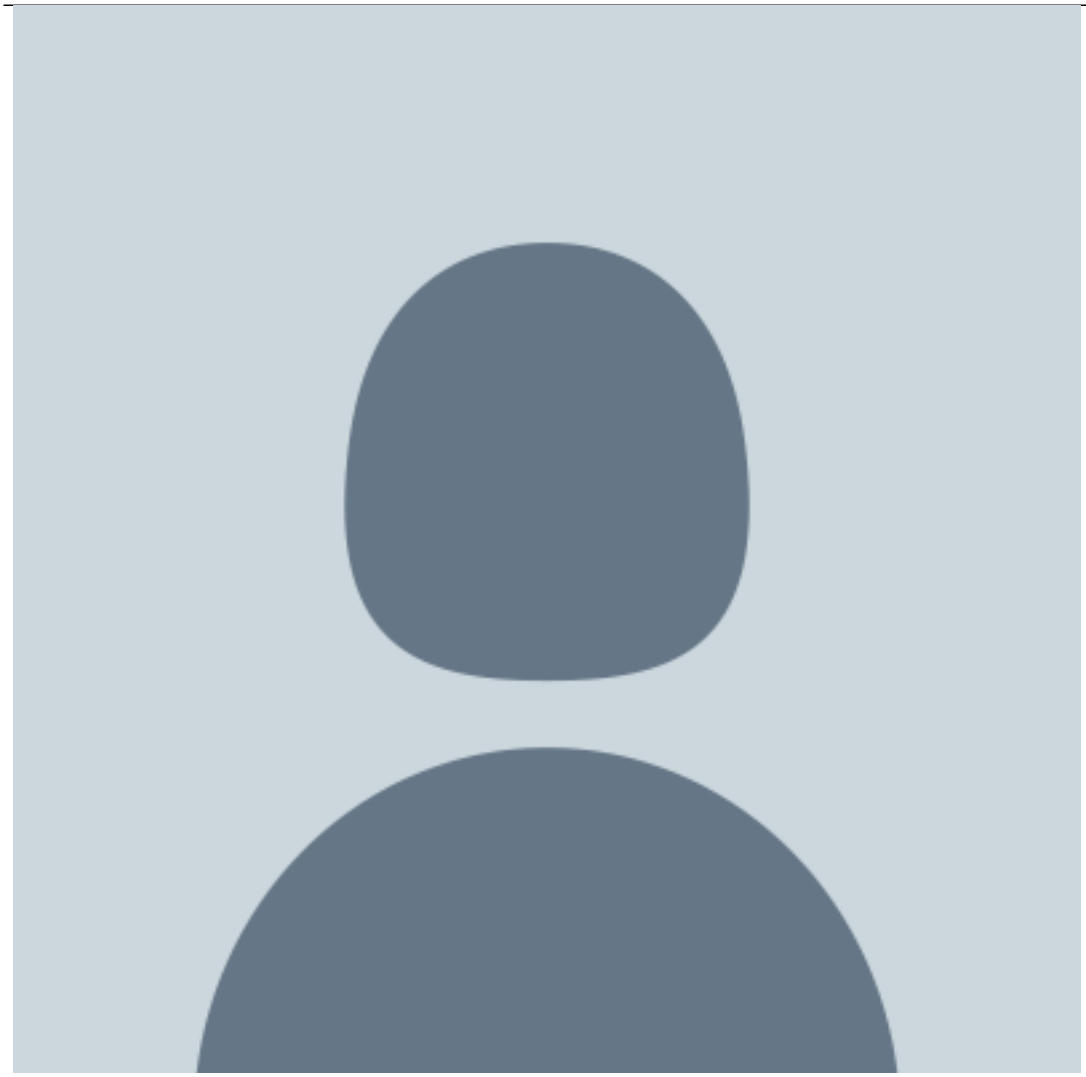

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