



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

***Madey
v.
Duke Univ.***

No. 01-1567
Federal Circuit
Oct. 3, 2002

“[S]o long as the act is in furtherance of the alleged infringer’s legitimate business and is not solely for amusement, to satisfy idle curiosity, or for strictly philosophical inquiry, the act does not qualify for the very narrow and strictly limited experimental use defense.”

On October 3, 2002, the Federal Circuit, *inter alia*, reversed and remanded the district court’s summary judgment that Duke did not infringe U.S. Patents No. 4,641,103 and No. 5,130,994, which related to free electron lasers, because the experimental use defense applied to Duke’s use of Madey’s patented laser technology. The Federal Circuit stated:

Our precedent, to which we are bound, continues to recognize the judicially created experimental use defense, however, in a very limited form. [And] experimental use is [not] an affirmative defense.

[T]he district court had an overly broad conception of the very narrow and strictly limited experimental use defense. The district court stated that the experimental use defense inoculated uses that “were solely for research, academic, or experimental purposes,” and that the defense covered use that “is made for experimental, non-profit purposes only.” [T]he defense [is] very narrow and limited to actions performed “for amusement, to satisfy idle curiosity, or for strictly philosophical inquiry.” Further, use does not qualify for the experimental use defense when it is undertaken in the “guise of scientific inquiry” but has “definite, cognizable, and not insubstantial commercial purposes.” [U]se is disqualified from the defense if it has the “slightest commercial implication.” Moreover, use in keeping with the legitimate business of the alleged infringer does not qualify for the experimental use defense. . . .

Our precedent clearly does not immunize use that is in any way commercial in nature. Similarly, our precedent does not immunize any conduct that is in keeping with the alleged infringer’s legitimate business, regardless of commercial implications. [M]ajor research universities, such as Duke, often sanction and fund research projects with arguably no commercial application whatsoever. However, these projects unmistakably further the institution’s legitimate business objectives, including educating and enlightening students and faculty participating in these projects. These projects also serve, for example, to increase the status of the institution and lure lucrative research grants, students and faculty.

In short, regardless of whether a particular institution or entity is engaged in an endeavor for commercial gain, so long as the act is in furtherance of the alleged infringer’s legitimate business and is not solely for amusement, to satisfy idle curiosity, or for strictly philosophical inquiry, the act does not qualify for the very narrow and strictly limited experimental use defense. Moreover, the profit or non-profit status of the user is not determinative.

In the present case, the district court attached too great a weight to the non-profit, educational status of Duke, effectively suppressing the fact that Duke’s acts appear to be in accordance with any reasonable interpretation of Duke’s legitimate business objectives. On remand, the district court will have to significantly narrow and limit its conception of the experimental use defense. The correct focus should not be on the non-profit status of Duke but on the legitimate business Duke is involved in and whether or not the use was solely for amusement, to satisfy idle curiosity, or for strictly philosophical inquiry.