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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALAIN A. MEILLAND

Appeal 2012-001480
Application 12/929,715
Technology Center 1600

Before MELANIE L. McCOLLUM, ERICA A. FRANKLIN, and
SHERIDAN K. SNEDDEN, *Administrative Patent Judges*.

McCOLLUM, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving a claim to a rose plant variety. The Examiner has rejected the claim as anticipated. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Claim 1 is pending and on appeal (App. Br. 2). Claim 1 reads as follows:

1. A new and distinct variety of Hybrid Tea rose plant characterized by the following combination of characteristics:
 - (a) exhibits semi-erect growth habit,

- (b) abundantly forms on a continuous basis attractive double yellow suffused with red blossoms having a very strong fragrance,
 - (c) forms very dense dark green foliage having a glossy aspect that contrasts well with the blossom coloration, and
 - (d) is particularly well suited for growing as attractive ornamentation in parks and gardens;
- substantially as herein shown and described.

Claim 1 stands rejected under 35 U.S.C. § 102(b) as anticipated by French Breeder's Right Application No. 0171375 and EC Breeder's Right Application No. 1990287 in view of Appellant's admission that "Meibderos" was publically available in France as early as September 1999 (Ans. 4).

FINDINGS OF FACT

1. The present application claims the benefit of an application filed April 3, 2002 (Spec. 1).
2. The present application describes a plant variety that "has been named the 'Meibderos' variety" (*id.* at 3).
3. It is undisputed that both French Breeder's Right Application No. 0171375 and EC Breeder's Right Application No. 1990287 are prior art under 35 U.S.C. § 102(b) (Ans. 4; App. Br. 3).
4. It is also undisputed that each of these applications discloses, but does not enable, Meibderos (Ans. 4; App. Br. 4).
5. Appellant admits that "[p]lants of the 'Meibderos' variety are understood to have been first placed in the hands of the public in France . . . during September 1999" (Page 4 of the Oct. 14, 2003 Response in parent Application No. 10/114,445).

PRINCIPLES OF LAW

As with utility patents, “only an ‘enabling’ publication is effective as a bar [under 35 U.S.C. § 102(b)] to a subsequent [plant] patent.” *In re LeGrice*, 301 F.2d 929, 1138 (CCPA 1962). However, “evidence of [a] foreign sale of a claimed reproducible plant variety may enable an otherwise non-enabled printed publication disclosing that plant, thereby creating a § 102(b) bar.” *In re Elsner*, 381 F.3d 1125, 1128 (Fed. Cir. 2004). In particular,

[w]hen a publication identifies the plant that is invented or discovered and a foreign sale occurs that puts one of ordinary skill in the art in possession of the plant itself, which, based on the level of ordinary skill in the art, permits asexual reproduction without undue experimentation, that combination of facts and events so directly conveys the essential knowledge of the invention that the sale combines with the publication to erect a statutory bar.

Id. at 1129.

“[T]he precise focus of the analysis is not whether the foreign sales are themselves § 102(b) prior art, but whether the publication has placed the claimed invention in the possession of the public before the critical date.” *Id.* at 1129-30. In this regard, the *Elsner* court explained that “[t]he foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. Its availability must have been known in the art, just as a printed publication must be publicly available.” *Id.* at 1131. In addition, the *Elsner* court explained that, “even if the interested public would readily know of the foreign sales, those sales [must] enable[] one of ordinary skill in the art to reproduce the claimed plants without undue experimentation.” *Id.*

ANALYSIS

The French and EC Applications, which were each published more than a year before the effective filing date of the present application, each disclose the plant recited in claim 1 (Findings of Fact (FF) 1-4). In addition, this plant was publically available (in France) more than a year before the effective filing date of the present application (FF 5). Moreover, the Examiner finds, and Appellant does not dispute, that possession of the plant would enable one of ordinary skill in the art to reproduce the claimed plant without undue experimentation (Ans. 6). Thus, in view of *In re Elsner*, we agree that the Examiner has set forth a prima facie case that the French and EC Applications each anticipate claim 1. In addition, Appellant's arguments do not persuade us otherwise.

With regard to *In re LeGrice*, we do not agree that the *Elsner* court overlooked this precedent (App. Br. 5). On the contrary, the *Elsner* court specifically discussed *LeGrice*, noting that the *LeGrice* court recognized that "there are inherent differences between plants and manufactured articles." *In re Elsner*, 381 F.3d at 1129 (quoting *In re LeGrice*, 301 F.2d at 935). In addition, as stated in *Elsner*:

LeGrice decided only the narrow issue whether a printed publication of a plant patent that is not enabled is a statutory bar. That decision did not address the manner in which a publication may be enabled, and it did not decide whether other evidence such as the availability of an invention through foreign sales may be considered in determining whether a printed publication enables a skilled artisan to reproduce a claimed plant.

In re Elsner, 381 F.3d at 1130. Thus, we agree with the Examiner that *Elsner* is controlling.

CONCLUSION

The evidence supports the Examiner's conclusion that claim 1 is anticipated. We therefore affirm the anticipation rejection.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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