

The Administrative Power of the USPTO

Why The Star Fruits Decision
is a Big Deal

Star Fruits S.N.C. v. United States

- Decided by Federal Circuit, Jan. 3, 2005 at 393 F.3d 1277 (Fed. Cir. 2005)
- Power of USPTO to obtain information from applicant
- USPTO and substantive Patent Law

Factual Background

- In April 2000, Star Fruits filed an application for a new variety of peach tree.
- In February 2001, PTO made a request of information under 37 CFR 1.105:
 - “any information available regarding the sale or other public distribution of the claimed plant variety anywhere in the world”
 - Copies of Plant Breeder’s Right grant

The Showdown

- In June 2001, Star Fruits submitted a brief refusing to submit the information because it “was not material to patentability.”
- In September 2001, the PTO issued a Notice of Abandonment deeming Star Fruits’ refusal a deliberate omission and hence an abandonment of the application.

The Procedural History

- Star Fruits appeals the Notice of Abandonment to the Commissioner who ruled that the examiner's request was "reasonably necessary" to the determination of patentability.
- After having its Request for Reconsideration denied, Star Fruits appealed to the district court in E. Va. Claiming that the PTO abused its discretion.

Star Fruits' Claims

- Under the terms of 102(b), only public use or sale in US can bar patentability
- Written description of plant variety alone cannot be enabling
- PTO cannot couple evidence of foreign use or sales with non-enabling publications to reject an application

United States' defenses

- Examiners' authority under 37 CFR 1.105
- A combination of printed publication and sales or public use may place the invention in the public possession
- Star Fruits' civil action is an improper advisory opinion

District Court Opinion

- “Examiner, not the applicant, determines what information is necessary to the patentability determination.”
- Star Fruits did abandon by not replying to the request.
- Improper advisory opinion.

Federal Circuit Affirms District Court

- "So long as the request from the examiner is not arbitrary and capricious, the applicant cannot impede the examiner's performance of his duty by refusing to comply with an information requirement which proceeds from the examiner's view of the scope of the law to be applied to the application at hand."

How the Federal Circuit Framed the Issue

- Judge Clevenger for the majority:
 - Can the PTO “compel disclosure of information that the examiner deems pertinent to patentability when the applicant has contrary view of the applicable law”?
- Judge Newman in dissent:
 - Was the PTO’s request “in accordance with law”?

Clevenger for the Majority

- Proceduralist point of view
- Power of PTO under 1.105
- “zone of information”

Anatomy of Newman's Dissent

- Substantive rather than procedural

- Questions In re Elsner, 381 F. 3d 1135 (Fed Cir. 2004):

Foreign public use or sale + published description = Enabling publication

Who Has It Right?

- PTO, like any agency, is bound by an unambiguous statute.
- Section 102(b) unambiguously excludes non-US public use and sale in the prior art.
 - Inclusion of plant varieties in Patent Act has not changed 102(b)
- USPTO cannot seek information about non-US public use or sale

Looking Ahead...

- Possible en banc hearing
- Need to clarify confusion from In re Elsner
- Need to clarify USPTO information gathering powers