

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28
FILED IN THE
U.S. DISTRICT COURT
EASTERN DISTRICT OF WASHINGTON

Dec 30, 2022

SEAN F. McAVOY, CLERK

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF WASHINGTON

HER MAJESTY THE QUEEN IN RIGHT
OF CANADA AS REPRESENTED BY
THE MINISTER OF AGRICULTURE
AND AGRI-FOOD, a Canadian
governmental authority,

Plaintiff/Counter-Defendant,

v.

VAN WELL NURSERY, INC., a
Washington Corporation; MONSON
FRUIT COMPANY, INC., a Washington
Corporation; GORDON GOODWIN, an
individual; and SALLY GOODWIN, an
individual,

Defendants/Counter-Plaintiffs,

v.

SUMMERLAND VARIETIES
CORPORATION,

Third Party Defendant/
Counter-Defendant.

No. 2:20-CV-00181-SAB

**ORDER GRANTING
DEFENDANTS' MOTION FOR
SUMMARY JUDGMENT RE:
PATENT INVALIDITY**

**ORDER GRANTING DEFENDANTS' MOTION FOR SUMMARY
JUDGMENT RE: PATENT INVALIDITY *1**

1 Before the Court is Defendants' Motion for Summary Judgment, ECF No.
 2 229. The motion was considered without oral argument. Plaintiff Her Majesty the
 3 Queen in Right of Canada, as Represented by the Minister of Agriculture and Agri-
 4 Food a Canadian Governmental Authority, and Third-Party Defendant
 5 Summerland Varieties Corporation, are represented by Jennifer D. Bennett,
 6 Michelle K. Fischer, and Daniel William Short. Defendant Monson Fruit Co., Inc.
 7 is represented by Mark P. Walters and Mitchell D. West. Defendant Van Well
 8 Nursery, Inc. is represented by Quentin D. Batjer, Kent N. Doll, and Timothy J.
 9 Billick; Mr. Batjer and Mr. Billick also represent Defendants Gordon Goodwin and
 10 Sally Goodwin.

11 The Court finds Defendants are entitled to summary judgment on Plaintiff's
 12 plant patent infringement claim. The '551 Patent was commercially sold in 2000
 13 before the critical date. Plaintiff's experimental use defense fails because Staccato
 14 was reduced to practice before the sale. Accordingly, the '551 Patent is invalid and
 15 unenforceable against Defendants.

16 **FACTS¹**

17 ***A. Discovery of Staccato***

18 Plaintiff the Minister of Agriculture and Agri-Food is a department of the
 19 Canadian government that operates a tree fruit breeding program. This breeding
 20 program develops sweet cherry varieties, including "Staccato," a late-harvest
 21 cherry that is central to this action. Staccato was first labeled as variety "13S-20-
 22 09," and later given the commercial name Staccato. Staccato is patented in the
 23 United States under U.S. Patent No. 20,55 ("the '551 Patent"), and Plaintiff is the
 24 owner and assignee of the patent.

25
 26 ¹ The following material facts are construed in the light most favorable to
 27 Plaintiff as the non-moving party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242,
 28 255 (1986).

**ORDER GRANTING DEFENDANTS' MOTION FOR SUMMARY
 JUDGMENT RE: PATENT INVALIDITY *2**

1 Staccato was discovered in 1982 by inventor Dr. David Lane. Staccato trees
2 were first budded and planted in Canada between 1990–1992, yielding the first
3 generation of sufficient fruit for evaluation between 1995 and 1999. For each
4 season after 1992, Staccato was asexually reproduced, and its distinguishing traits
5 conserved over each successive generation in Canada. The '551 Patent states that
6 Staccato's asexual propagation took place in Summerland, British Columbia,
7 Canada, and under these growing conditions, the variety consistently had
8 characteristics that distinguished it from other cherry varieties.

9 ***B. Testing Program and Commercial Sale***

10 On June 16, 1994, Plaintiff and Third-Party Defendant Summerland
11 Varieties Corporation—formerly known as the Okanagan Plant Improvement
12 Corporation (“SVC/PICO”—entered into a license agreement. Under the
13 agreement, SVC/PICO would coordinate “testing” for cherry cultivars developed
14 by Plaintiff’s tree fruit breeding program. This included Staccato.

15 Beginning in 1995, and pursuant to the license agreement, SVC/PICO
16 executed testing or growing agreements with U.S. farmers. Per those agreements,
17 U.S. farmers would pay royalties to plant Staccato trees for evaluation. Dr. Frank
18 Kappel, the breeder for Plaintiff since 1994, visited Staccato test orchards in the
19 United States, spoke with test growers, and communicated test growers’ comments
20 to SVC/PICO. Staccato’s inventor, Dr. Lane, was not involved in the testing
21 program or evaluation of the U.S. plantings.

22 One test grower of Staccato was Kyle Mathison. In 1995, Mr. Mathison
23 entered into a testing agreement with SVC/PICO and grew Staccato on behalf of
24 Stemilt Growers, Inc. (“Stemilt”), in Wenatchee, Washington. While it is unclear
25 when the Staccato trees were first planted, Mr. Mathison had fruiting trees on
26 approximately 3.3 acres of land by 2000. In 1999, Mr. Mathison approached
27 SVC/PICO seeking exclusive U.S. marketing rights of Staccato fruit for Stemilt;
28 Stemilt was ultimately awarded these rights.

**ORDER GRANTING DEFENDANTS’ MOTION FOR SUMMARY
JUDGMENT RE: PATENT INVALIDITY *3**

1 The parties do not dispute that Stemilt was in possession of Staccato,
2 pursuant to Mr. Mathison's testing agreement, in 2000. In addition, Stemilt's
3 business records indicate the company received and packed 22,394 pounds, or 11.2
4 tons, of "STOCATA" in 2000. Mr. Mathison testified that "STOCATA" was a
5 misspelling of Staccato that reflected the way farmers pronounced the variety.
6 Plaintiff states that Staccato would have been packed for the first time by Stemilt
7 in 2000 to see how it would hold up on the packing line. However, the business
8 records also demonstrate that in 2000, Stemilt sold 18,200 pounds of Staccato for
9 \$37,683, at \$2.0705 per pound.

10 **C. Patent Application**

11 SVC/PICO, working with the inventor Dr. Lane, submitted a provisional
12 patent application for Staccato on March 13, 2002. On March 6, 2003, a non-
13 provisional patent application was filed, which claimed the early filing date to the
14 provisional patent application. The '551 Patent for Staccato was issued on
15 December 15, 2009.

16 **LEGAL STANDARD**

17 Summary judgment is appropriate "if the movant shows that there is no
18 genuine dispute as to any material fact and the movant is entitled to judgment as a
19 matter of law." Fed. R. Civ. P. 56(a). There is no genuine issue for trial unless
20 there is sufficient evidence favoring the non-moving party for a jury to return a
21 verdict in that party's favor. *Anderson*, 477 U.S. at 250. The moving party has the
22 initial burden of showing the absence of a genuine issue of fact for trial. *Celotex*
23 *Corp. v. Catrett*, 477 U.S. 317, 325 (1986). If the moving party meets its initial
24 burden, the non-moving party must go beyond the pleadings and "set forth specific
25 facts showing that there is a genuine issue for trial." *Anderson*, 477 U.S. at 248.

26 In addition to showing there are no questions of material fact, the moving
27 party must also show it is entitled to judgment as a matter of law. *Smith v. Univ. of*
28 *Wash. Law Sch.*, 233 F.3d 1188, 1193 (9th Cir. 2000). The moving party is entitled

**ORDER GRANTING DEFENDANTS' MOTION FOR SUMMARY
JUDGMENT RE: PATENT INVALIDITY *4**

1 to judgment as a matter of law when the non-moving party fails to make a
 2 sufficient showing on an essential element of a claim on which the non-moving
 3 party has the burden of proof. *Celotex*, 477 U.S. at 323. The non-moving party
 4 cannot rely on conclusory allegations alone to create an issue of material fact.
 5 *Hansen v. United States*, 7 F.3d 137, 138 (9th Cir. 1993). When considering a
 6 motion for summary judgment, a court may neither weigh the evidence nor assess
 7 credibility; instead, “the evidence of the non-movant is to be believed, and all
 8 justifiable inferences are to be drawn in his favor.” *Anderson*, 477 U.S. at 255.

9 DISCUSSION

10 Plaintiff brings causes of action for: (1) plant patent infringement, in
 11 violation of 35 U.S.C. § 271; (2) correction of inventorship under 35 U.S.C. § 256
 12 for the Glory patent; (3) declaratory judgment against the Goodwin Defendants
 13 pursuant to 28 U.S.C. § 201; (4) unfair competition and false designation of origin
 14 under the Lanham Act, 15 U.S.C. § 1125(A)(1)(A); (5) false advertising under the
 15 Lanham Act, *id.* § 1125(A)(1)(B); (6) conversion; (7) tortious interference with
 16 economic relations; and (8) unfair competition, RCW § 19.86.020.

17 A. *First Cause of Action: Plant Patent Infringement*

18 Defendants move for summary judgment on Plaintiff’s patent infringement
 19 claim. They argue the ’551 Patent is invalid because it was on sale prior to the
 20 “critical date,” which is one year prior to the effective filing date of the patent
 21 application. The Court agrees with Defendants and grants summary judgment in
 22 their favor.

23 The Patent Act, 35 U.S.C. § 1 *et seq.*, provides general requirements for
 24 patentability of an invention. Section 102 states that an inventor shall be entitled to
 25 a patent unless

26 the claimed invention was patented, described in a printed publication, or in
 27 public use, on sale, or otherwise available to the public before the effective
 28 filing date of the claimed invention[.]

ORDER GRANTING DEFENDANTS’ MOTION FOR SUMMARY JUDGMENT RE: PATENT INVALIDITY *5

1 *Id.* § 102(a)(1). This section “serves as a limiting provision” that prohibits, among
 2 other things, the patenting of an invention where a commercial sale was made one
 3 year or less before the effective filing date of the claimed invention. *Pfaff v. Wells*
 4 *Elecs., Inc.*, 525 U.S. 55, 64 (1998); 35 U.S.C. § 102(b). The limitation is known
 5 as the “on-sale bar.”

6 The on-sale bar of § 102(b) “establishes a one year grace period based on
 7 publication or public use or sale, after which an inventor is barred from access to
 8 the patent system.” *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368,
 9 1370 (Fed. Cir. 1998). The U.S. Supreme Court has directed that the on-sale bar
 10 applies when two conditions are satisfied before the critical date: (1) the invention
 11 is the subject of a commercial offer for sale, and (2) the invention is ready for
 12 patenting, that is, “reduced to practice.” *Pfaff*, 525 U.S. at 67. A commercial sale
 13 of an invention by a third-party is sufficient to invalidate a patent. *Abbott Labs v.*
 14 *Geneva Pharms, Inc.*, 182 F.3d 1315, 1318 (Fed. Cir. 1999).

15 For plant inventions specifically, “[w]hoever invents or discovers and
 16 asexually reproduces any distinct and new variety of plant, . . . may obtain a patent
 17 therefor.” 35 U.S.C. § 161. “An actual reduction to practice is completed when the
 18 new variety is actually reproduced by any satisfactory method of asexual
 19 propagation and it is determined that the progeny in fact possess the characteristic
 20 or characteristics which distinguish it as a new variety.” *Dunn v. Ragin*, 50
 21 U.S.P.Q. 472 (1941); *Imazio Nursery, Inc. v. Greenhouses*, 69 F.3d 1560, 1566
 22 (Fed. Cir. 1995) (holding that “asexual reproduction confirms the existence of a
 23 new variety by separating variations resulting from fluctuations in environmental
 24 conditions from true plant variations”).

25 Patents are presumed valid, and “[t]he burden of establishing invalidity of a
 26 patent or any claim thereof shall rest on the party asserting such invalidity.” 35
 27 U.S.C. § 282(a). The challenging party must prove invalidity by clear and
 28 convincing evidence. *Microsoft Corp. v. i4i Ltd. P’ship*, 564 U.S. 91, 95 (2011).

**ORDER GRANTING DEFENDANTS’ MOTION FOR SUMMARY
 JUDGMENT RE: PATENT INVALIDITY *6**

1 1. Whether Staccato was subject to a commercial sale.

2 To determine whether the on-sale bar applies, the Court must first
 3 determine whether Staccato was offered for sale or sold. The Federal Circuit has
 4 “made clear” that “[t]he transaction at issue must be a ‘sale’ in a commercial law
 5 sense,’ and that ‘[a] sale is a contract between parties to give and to pass rights of
 6 property for consideration which the buyer pays or promises to pay the seller for
 7 the thing bought or sold.”” *Medicines Co. v. Hospira, Inc.*, 827 F.3d 1363, 1373
 8 (Fed. Cir. 2016) (citation omitted). The title transfer of an invention is a significant
 9 factor. *See id.* at 1376.

10 In this case, in 2000 Stemilt’s business records unambiguously depict a sale
 11 of 18,200 pounds of Staccato for \$2.0705 per pound, totaling \$37,683. These
 12 shipments of Staccato to a third-party, in return for monetary consideration, is
 13 clear and convincing evidence of a contract for commercial sale. *See Microsoft*
 14 *Corp.*, 564 U.S. at 95. The sale occurred prior to the critical date, which is one year
 15 prior to the effective filing date of the patent application. *Pfaff*, 525 U.S. at 64. The
 16 Court need not determine the exact date that governs, because Stemilt’s sales in
 17 2000 were before either of the parties’ purported critical dates of May 13, 2001,
 18 and March 6, 2002.

19 Plaintiff claims that Defendants’ factual assertions regarding the sale are
 20 disputed. The Court finds Plaintiff’s disputes are not genuine. Plaintiff has not
 21 provided evidence to place the sale of Staccato in dispute and its claims are not
 22 supported by the record. Plaintiff offers three core disagreements it asserts
 23 preclude summary judgment: (1) “STOCATA” is not the commercial name of
 24 Staccato, (2) the Stemilt business records do not specifically depict sales, and
 25 (3) Stemilt’s 3.3 acres of Staccato could not have produced sufficient fruit for the
 26 sales.

27 Plaintiff’s first contention is immaterial, because Plaintiff does not dispute
 28 that the “STOCATA” was actually Staccato. Plaintiff does not argue that Stemilt

**ORDER GRANTING DEFENDANTS’ MOTION FOR SUMMARY
 JUDGMENT RE: PATENT INVALIDITY *7**

1 was not in possession of Staccato at the time, and Mr. Mathison confirmed at his
2 deposition that “STOCATA” was a misspelling of “Staccato.” Plaintiff did not
3 submit evidence to the contrary. Thus, this is not a genuine dispute of material fact

4 In addition, Plaintiff contends Stemilt’s business records only show that
5 Staccato was received and packed, not shipped and sold to customers. This
6 characterization of the evidence is untenable. The record clearly shows that there
7 were “SALES” of Staccato for \$2.0705 per pound, providing a grand total of
8 \$37,683 for 18,200 pounds sold. There is no dispute that Stemilt received this
9 money for these boxes of fruit, and there is no dispute that Stemilt labeled these
10 transactions as “SALES.” The evidence shows commercial sales of Staccato.

11 Third, Plaintiff relies on a declaration from Ken Haddrell, the former
12 Operations Manager for SVC/PICO between 1995 and 2013. Mr. Haddrell asserts
13 that during a June 7, 2000 visit to Stemilt’s Staccato test orchards, he observed
14 “only 3.3 acres of test trees were fruiting” and “those trees may have a small
15 amount of fruit because they may have had frost as they were located in a low
16 spot.” ECF No. 243 at 7–8, ¶ 10. Mr. Haddrell opines that he would have
17 “expected that [Stemilt’s] 3.3 acres of trees would produce significantly less than
18 22,394 pounds of fruit.” *Id.* at 7–8, ¶¶ 10–11. He claims that including frost
19 damage, only 500 pounds of fruit per acre could be harvested or approximately
20 1,650 pounds from those 3.3 acres. *Id.* at 7, ¶ 11.

21 Mr. Haddrell’s opinion is inadmissible. Mr. Haddrell was not disclosed as an
22 expert, and Plaintiff did not attempt to qualify him as an expert. Fed. R. Civ. P.
23 26(a)–(e) (requiring disclosure of experts); *see Quevedo v. Trans-Pacific Shipping,*
24 *Inc.*, 143 F.3d 1255 (9th Cir. 1998) (affirming exclusion of expert testimony when
25 the expert was disclosed twenty days late, and the expert reports were six weeks
26 late). Mr. Haddrell also did not lay a proper foundation for these opinions. *See* Fed.
27 R. Evid. 702 (stating the opinion must be the product of the reason application of
28 professionally reliable principles and methods).

**ORDER GRANTING DEFENDANTS’ MOTION FOR SUMMARY
JUDGMENT RE: PATENT INVALIDITY *8**

1 In any case, Mr. Haddrell's opinion does not actually conflict, at least in a
 2 material way, with Mr. Mathison's testimony and the Stemilt records. He does not
 3 say with certainty that Stemilt's test orchard had frost damage in 2000, or even that
 4 the trees necessarily bore a small amount of fruit that season. His factual assertions
 5 rely on speculation, and his opinions are not based in any purported expertise. This
 6 is insufficient to create a genuine dispute of fact.

7 In a last-ditch attempt to survive summary judgment, Plaintiff incredulously
 8 argues that Mr. Mathison's testimony should be dismissed because his testimony is
 9 uncorroborated and Mr. Mathison is an "interested" party. Plaintiff cites language
 10 from *Union Carbide Chems. & Plastics Tech. Corp. v. Shell Oil Co.*, 308 F.3d
 11 1167 (Fed. Cir. 2002), a case where the Federal Circuit declined to consider
 12 evidence from former employees of the defendant.

13 Mr. Mathison's deposition testimony is not uncorroborated. It is
 14 corroborated by Stemilt's business records. Plaintiff also has not supported its
 15 claim that Mr. Mathison is an interested party. The record indicates the contrary is
 16 more likely. Mr. Mathison has little to gain from this Court finding the Staccato
 17 patent invalid, as Stemilt owns exclusive marketing rights for Staccato in the
 18 United States, and arguably, Stemilt would stand to gain if Plaintiff is able to
 19 enforce the '551 Patent against Stemilt's competitors. In any case, Mr. Mathison
 20 and Stemilt are not directly involved in this litigation, and they have no
 21 cognizable interest in the litigation in the way Plaintiff purports.

22 Overall, Plaintiff's arguments do not create genuine disputes of material
 23 fact, and no rational juror could find in Plaintiff's favor based on any "counter"
 24 evidence presented. Defendants have proffered clear and convincing evidence that
 25 Staccato was sold commercially in 2000. The next question is whether Staccato
 26 was "reduced to practice," that is, ready for patenting.

27 //

28 //

**ORDER GRANTING DEFENDANTS' MOTION FOR SUMMARY
 JUDGMENT RE: PATENT INVALIDITY *9**

1 2. Whether Staccato was ready for patenting.

2 As noted, for a patent to be invalid pursuant to the on-sale bar, the invention
 3 must have been ready for patenting. *Pfaff*, 525 U.S. at 67. This condition may be
 4 satisfied by proof of reduction to practice before the critical date. *Id.*
 5 “Experimental use” is a judicially-created exception to the on-sale bar—it
 6 distinguishes experimentation from when “products [are] sold commercially.” *See*
 7 *Pfaff*, 525 U.S. at 64. Under the experimental use exception, an inventor looking to
 8 perfect their discovery “may conduct extensive testing without losing his right to
 9 obtain a patent for his invention—even if such testing occurs in the public eye.” *Id.*
 10 However, there is a bright red line: market testing and commercial testing do not
 11 quality as “experimental uses.” *See Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299
 12 F.3d 1336, 1353–55 (Fed. Cir. 2002). And crucially, “once the invention is reduced
 13 to practice, there can be no experimental use negation.” *Id.* at 1354 (citing
 14 *Zacharin v. United States*, 213 F.3d 1366, 1369 (Fed. Cir. 2000)).

15 Staccato was reduced to practice through asexual reproduction in Canada
 16 before 2000. The inventor, Dr. Lane, discovered Staccato in 1982. The ’551 Patent
 17 states that, under the direction of Dr. Lane, four trees were created by T-budding
 18 vegetative buds of the variety onto Mazzard rootstock. ECF No. 1-1 (U.S. Patent
 19 No. 20,551) at 3. The resulting trees were grown in a nursery, dug up in the fall of
 20 1991, and planted in a field in 1992. *Id.* The trees were stable in their horticultural
 21 traits and no off-types or variants occurred during the re-propagation of the plants.
 22 *Id.* The trees were also hand-pollinated with pollen from other blossoms of
 23 Staccato to ensure their fertility. *Id.*

24 Subsequent propagations of Staccato produced trees that were “stable, true-
 25 to-type and identical to the original tree in all the horticultural traits.” *Id.* For each
 26 season after 1992, Staccato was asexually reproduced, and its distinguishing traits
 27 conserved over each successive generation in Canada. The ’551 Patent plainly
 28 states that Staccato’s “asexual propagation” took place in Summerland, British

**ORDER GRANTING DEFENDANTS’ MOTION FOR SUMMARY
 JUDGMENT RE: PATENT INVALIDITY *10**

1 Columbia, Canada. *Id.* “Under growing conditions . . . at Summerland in the
2 Okanagan Valley of British Columbia, Canada,” the variety “consistently” had
3 characteristics that distinguished it from other cherry varieties. *Id.*

4 Yet, Plaintiff contends its testing program was conducted “in various
5 countries and geographical locations” to determine whether it “in fact” possessed
6 characteristics that distinguished it as a new variety and could be asexually
7 reproduced. Plaintiff asserts the trees planted in the United States only yielded fruit
8 sufficient for evaluation between 2001 and 2002, and thus, Staccato was not
9 “reduced to practice” at the time of the Stemilt sale. Essentially, Plaintiff argues
10 the inventor must have found these conditions present from plantings in *the United*
11 *States* before Staccato could be patentable.

12 Whether the conditions of patentability were observed in orchards growing
13 in the United States specifically is not relevant to the Court’s inquiry. Plaintiff has
14 not cited to, and the Court has been unable to find, caselaw that hinges on how
15 successful a plant is in different growing geographies. Plaintiff’s assertion that
16 Staccato not reduced to practice until it was tested and grown in the United States
17 conflicts with the face of the ’551 Patent, and it is not supported by the record
18 evidence. Plaintiff’s testing in the United States for geographic market viability
19 does not affect the fact that Staccato (1) was known to possess characteristics that
20 distinguished it as a new, late-harvest variety, and (2) was reproduced through
21 asexual propagation in Canada for each season after 1992. Accepting that Staccato
22 was not ready for patenting until the fruit were sufficiently evaluated from those
23 Canadian plantings between 1995 to 1999, these facts still demonstrate Staccato
24 was reduced to practice prior to 2000.²

25
26 _____
27 ² Plaintiff also has not provided evidence that the testing program was to
28 determine that Staccato was a distinct and new variety of plant that could be
asexually reproduced. Plaintiff admits Dr. Kappel oversaw the U.S. testing

1 Staccato was reduced to practice before Stemilt's commercial sale of the
 2 fruit in 2000. Therefore, "there can be no experimental use negation." *Allen*
 3 *Eng'ring Corp.*, 299 F.3d at 1354 (citing *Zacharin*, 213 F.3d at 1369). The Court
 4 finds Stemilt's sales of Staccato do not, and did not, constitute permissible
 5 experimental use. The '551 Patent is invalid. Because the patent is invalid, it
 6 cannot be infringed. *Commil USA, LLC v. Cisco Sys., Inc.*, 575 U.S. 632, 644
 7 (2015). Defendants are entitled to summary judgment on Plaintiff's claim for plant
 8 patent infringement.

9 **B. Remaining Cause of Actions: Lanham Act, Correction of Inventorship,
 10 and State-Law Claims**

11 Defendants move for summary judgment on Plaintiff's remaining claims, to
 12 wit: (2) correction of inventorship under 35 U.S.C. § 256 for the Glory patent;
 13 (3) declaratory judgment against the Goodwin Defendants pursuant to 28 U.S.C.
 14 § 201; (4) unfair competition and false designation of origin under the Lanham
 15 Act, 15 U.S.C. § 1125(A)(1)(A); (5) false advertising under the Lanham Act, *id.*
 16 § 1125(A)(1)(B); (6) conversion; (7) tortious interference with economic
 17 relations; and (8) unfair competition, RCW § 19.86.020.

18 The Court finds that genuine disputes of material facts preclude summary
 19 judgment on Plaintiff's remaining claims. The parties genuinely dispute whether
 20

21 program and eventual release of Staccato, not Staccato's inventor Dr. Lane. Dr.
 22 Lane directed the first asexual reproduction of Staccato in 1990–91, and the parties
 23 agree he is only inventor of the plant. Plaintiff has presented no evidence that Mr.
 24 Lane was ever involved with the U.S. testing program or that he sought
 25 experimental testing to ascertain whether Staccato was a new variety that could be
 26 asexually propagated. It appears the U.S. testing was not to determine whether
 27 Staccato was indeed a new variety, but whether it would grow well, and perform
 28 well, in the country's specific geography and market.

**ORDER GRANTING DEFENDANTS' MOTION FOR SUMMARY
 JUDGMENT RE: PATENT INVALIDITY *12**

1 Staccato is the same fruit variety as Glory, the origin of Glory, whether
2 Defendants had title to the specific trees and/or fruit in question, whether there has
3 been consumer confusion regarding Staccato and Glory, and the physical qualities
4 of Glory trees and fruit. The Court's declaration of the '551 Patent validity may
5 affect these claims, but that issue has not been briefed and is not before the Court.
6 Therefore, the Court denies summary judgment with respect to Plaintiff's
7 remaining claims.

8 Accordingly, **IT IS HEREBY ORDERED:**

9 1. Defendants' Motion for Summary Judgment, ECF No. 229, is
10 **GRANTED.**

11 2. Plaintiff's First Cause of Action for Plant Patent Infringement is
12 **DISMISSED with prejudice.**

13 3. U.S. Patent No. 20,551 is declared **INVALID** pursuant to the on-sale
14 bar, 35 U.S.C. § 102(b).

15 4. The parties are **DIRECTED** to file a Joint Status Report, no later than
16 **twenty-one (21) days** from the date of this Order, addressing the status of the case
17 and expectations regarding the amended scheduling order.

18 **IT IS SO ORDERED.** The District Court Clerk is hereby directed to enter
19 this Order and to provide copies to counsel.

20 **DATED** this 30th day of December 2022.



21
22
23
24 A handwritten signature in blue ink that reads "Stanley A. Bastian". The signature is fluid and cursive, with "Stanley" and "A." being more stylized and "Bastian" being more clearly legible.

25 Stanley A. Bastian
26 Chief United States District Judge
27
28

**ORDER GRANTING DEFENDANTS' MOTION FOR SUMMARY
JUDGMENT RE: PATENT INVALIDITY *13**