

**Plant varieties: a bean "travelling" between the USA and Italy**

A recent case decided by the Italian Supreme Court (ord., section VII, 28/02/2023, n. 6074) offers a reminder that under the umbrella of intellectual property rights there is one category - with a restricted scope of application - aimed at protecting the different characteristics within a biological species: plant varieties.

Plant varieties – which include well-known examples like the "Pink Lady" apple or the yellow-fleshed "Soreli" kiwi – are protected through a series of ad hoc provisions: they are excluded from the list of the subject matter that can be protected by means of the utility patent (though the patenting of plants obtained through bioengineering processes or the patentability of biological material isolated from a plant is admitted) and the holder of the right is identified as "the breeder" or "the creator". According to this sui generis patent right, the breeder could be the person who created or discovered and perfected the variety, or the employer in the case of an employment relationship, or the customer if a self-employment contract is involved.

In Europe, protection is available both at the Community and the national level and can extend, from the date of granting of the patent, up to 30 years for new woody varieties (trees and vines) and, in the EU, up to 25 years for others plant varieties (in Italy up to 20 years). Somewhat similarly to utility patents, plant varieties must meet some requirements to be protected, namely: novelty (the propagating or harvested material must not have been marketed before the date of filing the application, namely one year on the national territory or no more than four years in any other country and a longer term of six years for woody varieties); distinctiveness (the variety must have different characteristics from every other known variety at the time the application was filed); uniformity (all specimens must have the same traits) and stability (the characterizing traits of the variety must be constant even after reproduction and subsequent multiplication).

In interpreting the relevant provisions, the Italian Supreme Court's decision n. 2023/6074 focused precisely on one of the above-mentioned requirements. The judges were called upon to establish whether a plant variety that was originally filed for protection in the United States could be classified as prior art capable of invalidating the requirement of "distinctiveness" with respect to the subsequent application filed in Italy for the same variety.

Simplifying the facts of the case, and focusing on what is relevant for our purposes, we can say that the dispute concerned a US patent from 1990 and an Italian patent from 1993 for the same variety of bean, i.e. the variety "Phaseolus Vulgaris" (called "Etna"), which was originally owned by the Asgrow Seed Company. The Italian patent was later assigned to the company Siminis Vegetables Seeds, Inc. which, in turn, granted a license to the Italian company Montesanto Agricoltura Italia S.p.A.

The dispute arose following an infringement action brought by the owner and the licensee of the patent against the company Suba S.r.l. and, in particular, in which the latter filed a claim for a declaration of nullity of the Italian patent due to lack of distinctiveness pursuant to article 104 of the Italian Code of Industrial Property and, more specifically, based on the pre-existence of the US patent. However, the request to declare the Italian patent null and void was rejected by the first instance judge, as well as by the appeal judge, since both came to the conclusion that the US patent was not to be considered as a disabling prior art for the Italian patent.

The case then reached the Supreme Court, which deemed it appropriate to rule on this point, even despite the joint request of the parties to declare the action devoid of purpose following the settlement agreement reached by the parties. This is a clear indicator of the importance of the issue raised and the absence of judicial precedents on the subject.

In reading the decision, it can be noted that according to the appellant, the trial judges erred in adopting a literal interpretation of the provisions contained in article 104 Italian IP Code, in the sense that “(...) *the distinctive character required by art. 104 c.p.i. implies that the variety must be different from any other variety currently known, including the same variety already patented as such; and this because, as pointed out by prior jurisprudence, identity always conceptually excludes distinctiveness*”.

After a brief discussion on the relevant provisions contained in the Italian IP Code, namely articles 100 (relating to the scope of the right on a new plant variety) 102, 103 and 104 (which regulate the requirements necessary to obtain the protection of the variety), the Supreme Court focused on the interpretation of article 104 which governs the requirement of distinctiveness and reads as follows:

*“1. The variety is deemed to be distinct if it is clearly distinguishable from any other variety whose existence, as of the date of filing of the application, is well-known.*

*2. In particular, another variety is deemed to be well-known when:*

*a) an application for the conferral of the breeder's right or entry in an official register has been filed, in any country, provided that the application has the effect of conferring the breeder's right or the entry of the varieties in the official register;*

*b) it appears in public collections”.*

By referring to the provisions of article 104 and the legal framework in which it is to be considered (UPOV Convention of 1961 and EU Regulation no. 2100/1994), the Court then analysed the appellant's thesis according to which “(...) *the application filed in a specific country (in this case the USA) for plant variety rights by a breeder is prior art - and therefore invalidating - of the requirement of ‘distinctiveness’ in relation to any subsequent application for the same plant variety filed in another country*”.

However, the Court rejected the appellant's claim arguing that the Italian legislation is in line with the EU legislation and that, in both cases, the legislator has clearly indicated that a variety can be considered to be "distinct" from another well-known variety when, at the date of the application, it is distinguishable by a particular genotype or combination of genotypes. In adopting a reasoning that is somewhat familiar in the context of utility patents, the Court then specified that “*If it is true that even minimal genetic differences with respect to known varieties (when resulting in significant phenotypic differences, or in different plant properties) are sufficient to comply with the distinctiveness requirement - a point on which the prevailing legal scholar opinion agrees - it follows that the judgment or comparison can only take place with ‘other’ plant varieties*”.

Therefore, the conclusion to be drawn is that there is no lack of distinctiveness if the same breeder (or its assignor) has been granted the protection for the plant variety abroad, and this on the grounds that the "same variety" cannot be considered as "other known plant variety".

The fact that the Supreme Court decided to rule on the appellant's claim, regardless of the agreement reached between the parties and the consequent discontinuance of the matter, is a sign of the growing attention to the sector of plant varieties. Indeed, it is a sector in full swing, also thanks to the significant and recent technological evolution of the agricultural business world as confirmed, for example, by a news article published at the end of 2022 (<https://www.freshplaza.it/article/9469921/il-comitato-per-la-gestione-dell-orri-intensifica-il-controllo-sulle-grandi-aziende-agricole-non-autorizzate/>) relating to the identification of 10,000 illegal plants (the mandarin variety "Orri") located in the Spanish territory and detected by means of IT tools designed for the control of protected plant varieties, in combination with the latest generation drones. Moreover, these operations are supported by regulatory efforts aimed at strengthening the protection of intellectual property rights in the sector, as evidenced by the recent meeting between the president of the Community Plant Variety Office (CPVO) with the leaders of the European Food Safety Authority (EFSA) focusing, among other objectives, also on the so-called "Green Deal" which promises to be a topic of central importance for the coming decades (<https://www.freshplaza.it/article/9505560/la-delegazione-dell-ufficio-comunitario-delle-variet%C3%A0-vegetali-visiting-efsa-today/>).