

ITALY

Standards for the Protection of New Plant Varieties*

Consolidated Text of Decree No. 974 of 12 August 1975, as amended
by Articles 76 to 78 of Decree No. 338 of 22 June 1979,
and Law No. 620 of 14 October 1985

Article 1

Patents for industrial inventions may be granted in respect of new plant varieties capable of agricultural or industrial application.

Within the meaning of this Decree, a new plant variety, regardless of how it is obtained, is one that meets the following criteria:

(a) it must be sufficiently homogeneous, having regard to the particular features of its sexual reproduction or vegetative propagation;

(b) it must be stable in its essential characteristics, that is to say, it must remain true to its description after repeated reproduction or propagation and, where the breeder has defined a particular cycle of reproduction or multiplication, at the end of each cycle;

(c) whatever may be the origin, artificial or natural, of the varieties from which it derives, it must be clearly distinguishable by one or more important characteristics from any other plant variety whose existence is a matter of common knowledge at the time when protection is applied for. Common knowledge may be established by reference to various factors such as: cultivation

* Italian title (of Decree No. 974): Decreto del Presidente della Repubblica, 12 agosto 1975, No. 974 - Norme per la protezione delle nuove varietà vegetali.

Consolidated text prepared by the Office of the Union from the texts published in the *Gazzetta Ufficiale della Repubblica Italiana*:

Decree No. 974 of August 12, 1975: *GU* of April 26, 1976;
Decree No. 338 of June 22, 1979 (Revision of the National Patent Legislation Pursuant to the Delegation Given by Law No. 260 of May 26, 1978): *GU* of August 7, 1979;
Law No. 620 of October 14, 1985 (Ratification and Implementation of the Act for the Revision of the International Convention of December 2, 1961, for the Protection of New Varieties of Plants, as Revised on November 10, 1972, Signed at Geneva on October 23, 1978, and Amendment of the Decree of the President of the Republic No. 974 of August 12, 1975, Containing the Standards for the Protection of New Plant Varieties): *GU* of November 12, 1985.

or marketing already in progress, entry in an official register of varieties already made or in the course of being made, inclusion in a reference collection or precise description in a publication.

At the time of the application for a patent, the plant variety must not have been, with the agreement of the breeder or his successor in title, the subject of commercial acts for longer than one year in Italy, or for longer than six years in the case of grapevine, forest trees, fruit trees and ornamental trees, including, in each case, their rootstocks, or for longer than four years in the case of the other plants in the territory of any other State.

However, the fact that a new plant variety has been the subject of trial cultures, or has been entered or submitted for entry in an official register, shall not affect the right of the breeder of such a variety or his successor in title.

The characteristics which permit a new plant variety to be defined and distinguished may be of a morphological or physiological nature. In all cases, they must be capable of precise description and recognition.

The provisions of this Decree shall in every case be without prejudice to those of Article 14, third paragraph, and Article 15, third paragraph.¹

Processes whereby new plant varieties are obtained shall not be protectable under the provisions of this Decree, even if they are described in the patent application; however, such processes may be the subject of separate applications for a patent for an industrial invention, in accordance with the provisions of Royal Decree No. 1127 of June 29, 1939, provided that they are not essentially of a biological nature.

Article 2

The provisions of Articles 2584 to 2591 of the Civil Code and those of Royal Decree No. 1127 of June 29, 1939, as subsequently completed and amended, and of the Rules approved by Royal Decree No. 244 of February 5, 1940, as subsequently completed and amended, are

¹ Of the Law on Patents for Inventions (Royal Decree No. 1127 of June 29, 1939, as last amended by Decree of the President of the Republic No. 338 of June 22, 1979).

Article 14, paragraph (3), reads as follows:

"Additionally, the content of Italian patent applications, or of European or international patent applications designating Italy, as filed, of which the dates of filing are prior to the date referred to in the preceding paragraph and which were published or made available to the public on or after that date, shall be considered as comprised in the state of the art."

Article 15, paragraph (3), reads as follows:

With respect to inventions for which priority is claimed under international conventions, the existence of the novelty requirement provided for under Article 14 must be evaluated with reference to the starting date of the priority."

applicable to new plant varieties, provided that they are not inconsistent with those of this Decree.

Article 3

The breeder of a new plant variety or his successor in title may claim a right of priority, either at the time of filing the application for a patent or within two months thereafter, based on the first application filed previously in another State of the Paris Union for the Protection of New Varieties of Plants for the purpose of obtaining a title of protection for the same variety. The right of priority may only be enforced if the application for a patent and claim in respect of priority are filed in Italy within the mandatory period of twelve months from the date of filing of the first application.

The breeder or his successor in title who claims the right of priority shall be allowed a period of four years after the expiration of the period of priority in which to furnish the additional documents and material necessary for the examination provided in Article 8 below. Those documents and the material necessary for the examination may be requested, however, before the expiration of the four-year period and within an adequate period where the application whose priority is claimed is rejected or withdrawn. The period of six months laid down in Article 20 of the Rules approved by Royal Decree No. 244 of February 5, 1940, for the submission of a copy, certified by the competent authority, of the documents which constitute the first filing shall remain unaffected.²

Article 4

The rights conferred by a patent in respect of a new plant variety shall consist of the exclusive right to produce for sale, to put on the market and to introduce in the territory of the State, propagating or reproductive material of the patented new variety.

Such exclusive right shall extend to the production, the marketing and the introduction in the territory of the State of the products of the patented new variety in cases where its predominant use occurs through the sale of plants, parts of plants or flowers to be used for ornamental purposes.

Where the new variety is derived from another patented variety but can be reproduced independently from that other variety, the provisions of Article 5 of Royal Decree No. 1127 of June 29, 1939, shall not apply.³

² The third paragraph of that Article reads as follows:

"The patent shall be granted without the mention of priority if the documents specified in the first paragraph of Section 11 above have not been submitted in the prescribed form within six months from the filing of the application."

³ That Article reads as follows:

Authorization by the proprietor of the patent shall be required, however, when the repeated use of the plant variety is necessary for the commercial production of another variety.

However, third parties have the right to produce the patented new plant variety for the purpose of research or of obtaining hybridization material. Such production shall, in all cases, be restricted in such a way as to preclude the commercial exploitation of the product, which shall not be distributed for purposes of gain outside the farm where it was produced.

The maximum limits on such production shall be laid down for the various plant families and species by the Ministry of Agriculture and Forestry, on the advice of the Commission referred to in Article 18 below.

Article 5

The new plant variety being the subject of a patent shall have the denomination given to it by the breeder, who shall specify it at the time of filing of the application for a patent.

The denomination must be such as to enable the new variety to which it refers to be identified and may not consist solely of figures, except where this is established practice for designating varieties. The denomination must meet the following criteria:

(1) it must not be contrary to law, public order or morality;

(2) it must be identical to the denomination already registered as the designation of the same variety in one of the States of the Paris Union for the Protection of New Varieties of Plants, subject to the power of the Central Patent Office to request a translation into Italian of the original denomination;

(3) it must not be liable to mislead or to cause confusion concerning the characteristics or value of the plant variety or the identity of the breeder; in particular, it must be different from every denomination which designates, in any member State of the aforementioned International Union, an existing variety of the same or a closely related botanical species.

The denomination of the patented new plant variety shall be regarded as the generic name of that variety and shall be used in order to distinguish it, even after the expiration of the protection of that variety.

The denomination of the patented new plant variety shall also be entered in the appropriate register.

It shall be prohibited to use the aforementioned denomination to designate plant varieties of the same species but which differ from the patented variety.

"The patent for an industrial invention, the working of which involves the working of inventions protected by prior, still valid patents for industrial inventions, may not be worked or used without the consent of the proprietors of such prior patents."

It shall be permitted to associate a trademark, trade name or other similar indication with the variety denomination, provided that the variety denomination remains easily recognizable.

Article 6

It shall be prohibited to the breeder or his successor in title to use, as the denomination of a new plant variety, distinguishing words or signs in respect of which he enjoys the protection, either in the State or in a member State of the Union for the Protection of New Varieties of Plants, accorded to trademarks and which serve to distinguish a botanical species that is identical or similar to the new variety; neither may he use, for the aforementioned purpose, a denomination liable to cause confusion with the said mark.

If the breeder or his successor in title wishes to use, as the denomination of the new variety to be patented, a trademark such as that described in the preceding paragraph, or a denomination liable to cause confusion with such a mark, he may renounce his right to protection of that mark. In that case, his renunciation shall be effective from the date of its entry in the trademark register.

If a denomination coming under the prohibition laid down in the first paragraph above is nevertheless registered, the breeder or his successor in title may not continue to assert his right to the trademark in respect of the new variety or a similar one.

In cases where the denomination of the new variety specified in the patent application appears to fall under the prohibition laid down in the first paragraph above and it has not yet been registered, the breeder or his successor in title shall be allowed to request to substitute for it another denomination which meets the prescribed requirements. If he fails to submit a new denomination within six months from the date of the request to that effect, he may not continue to assert his right to the corresponding trademark in respect of the new variety or a similar one.

Once the new denomination has been registered for the variety, the breeder or his successor in title may prohibit the use of the previous denomination by persons obliged to use it before the entry into force of this Decree only after the expiration of a period of one year from the date of publication of the registration of the new denomination.

Article 7

The duration of a patent granted under this Decree shall be 15 years from the date of its grant.

The patent shall last for 30 years from the date of its grant in the case of plants with a woody stem such as grapevine, fruit trees and their rootstocks, forest trees and ornamental trees.

Subject to the provisions of Article 4, third paragraph, of Royal Decree No. 1127 of June 29, 1939,⁴ the effects of the patent shall commence on the date on which the application, together with its annexes, is made available to the public as provided in Article 9 below.

Article 8

The application for a patent in respect of a new plant variety shall be examined to ascertain:

(a) that the application and the documents appended thereto are in order;

(b) that the denomination of the new plant variety is in conformity with the provisions of this Decree;

(c) that there are no elements liable to impede the grant of a patent within the meaning of Article 1 above.

The Central Patent Office shall provide for the examination in respect of item (a) above. The examinations in respect of items (b) and (c) above shall be within the competence of the Ministry of Agriculture and Forestry, which may, however, decide to dispense with such examinations, wholly or in part, if such examinations have already been carried out with sufficient guarantees in Italy or in another State of the Paris Union for the Protection of New Varieties of Plants.

In that case, the applicant shall submit documentary evidence of the examinations made.

Article 9

Applications for patents in respect of new plant varieties shall be filed only in Rome, with the Central Patent Office. They may also be sent through the post in accordance with Article 2 of the Decree of the President of the Republic No. 540 of June 30, 1972.⁵ The other documents relating to the said applications may be filed with the Chambers of Commerce, Industry and Handicrafts of the capital towns of the provinces.

Within 60 days after the date of filing of the application for a patent, the Central Patent Office shall put up a notice to this effect on its notice board, where the notice shall remain for 30 days.

41 That paragraph reads as follows:

"With regard to persons whom the applicant notified his application, with the specification and possible drawings, the effects of the patent shall commence on the date of such notification."

5 i.e. by registered mail, return receipt requested.

For the applications for patents in respect of new plant varieties, the period provided in Article 4 of Royal Decree No. 1127 of June 29, 1939, for making the documentation available to the public shall be 90 days from the date of filing of the application.

Any person may, within the following 60 days, address its observations to the Central Patent Office, in duplicate, in respect of the patentability of the plant variety.

Article 10

The Central Patent Office shall satisfy itself that the application is in order and, where observations have been presented to it by third persons, it shall send the applicant a copy thereof, and invite him to submit any counterstatement.

Article 11

The Central Patent Office shall forward the documents relating to the application for a patent to the Ministry of Agriculture and Forestry, together with the observations, if any, of interested third parties, the applicant's counter-statement and any other relevant information, and request the Ministry for an advice as to whether the application is admissible.

The Minister of Agriculture and Forestry shall, before undertaking the examinations falling within his competence, invite the applicant to pay, within a period of three months, the fee prescribed under Article 22*bis* below and to transmit to it the receipt evidencing payment.

Any unjustified failure to pay within the said period shall entail the application for a patent to be considered withdrawn in all respects.

Article 12

On the advice of the Ministry of Agriculture and Forestry, the Central Patent Office shall either grant the patent or reject the application.

The patent granted under this Decree shall not exempt its proprietor or any other person using its subject matter from conforming with the laws and regulations governing the production, marketing and use of the subject matter.

The Ministry of Agriculture and Forestry shall have the right, at any time, to undertake a technical control test in order to establish that the conditions set forth in items (a) and (b) of the second paragraph of Article 1 are still being complied with.

Article 13

The patent shall be declared null and void if it is established that the conditions laid down in item (c) of the second paragraph and in the third paragraph of Article 1 of this Decree were not effectively complied with at the time the patent was granted.

The patent shall become forfeit if the breeder or his successor in title:

(a) fails to provide the Ministry of Agriculture and Forestry with the reproductive or propagating material capable of producing the new variety with its morphological and physiological characteristics as defined when the patent was granted;

(b) within the prescribed period and after being requested to do so, does not provide the competent authority with the reproductive or propagating material, the documents and the information deemed necessary for checking the new variety, or does not allow inspection of the measures which have been taken for the maintenance of the variety;

(c) has failed to pay within the prescribed period such fees as may be payable to keep the patent in force.

In the cases referred to in items (a) and (b) above, the patent shall be declared forfeited by the Central Patent Office on the proposal of the Ministry of Agriculture and Forestry.

A patent may not be declared null and void or become forfeit on grounds other than those set out in this Article.

Article 14

The provisions of the Decree of the President of the Republic No. 849 of February 26, 1968, Concerning Compulsory Licenses, as subsequently amended, shall apply to patents in respect of new plant varieties insofar as they are compatible with the provisions of this Decree.

There shall be considered to be failure to work, suspension or reduction in working, within the meaning of Article 1 of the aforementioned Decree, if the breeder or his successor in title, either directly or by means of one or more licensees, fails to provide users on the territory of the State with the reproductive and propagating material of the patented plant variety to an extent that meets the requirements of the country's economy.

Article 15

In accordance with the same provisions of the aforementioned Decree of the President of the Republic No. 849 of February 26, 1968, for reasons of public interest and regardless of whether or not the patent is being worked, special-non-exclusive--compulsory licenses may be issued at any time, against payment of equitable compensation to the proprietor of the patent, for the exploitation of such patented plant varieties as are suitable for the production of food for human or animal consumption, therapeutic purposes or the manufacture of drugs.

Article 16

The licenses provided in the preceding articles shall be issued in accordance with the advice of the Ministry of Agriculture and Forestry, which shall decide the conditions prescribed

for the issuance of licences. The amount and terms of payment of the remuneration, in case of opposition in the sense of Article 54^{quater} of Royal Decree No. 1127 of June 29, 1939, shall be determined on the basis of Article 50, second paragraph, of the said Decree.⁶

The decision to issue a license may impose an obligation on the proprietor of the patent to provide the licensee with the necessary reproductive and/or propagating material.

Article 17

In order to undertake the examinations which are necessary for the advices to be given under the provisions of this Decree, the Ministry of Agriculture and Forestry shall be authorized to conduct experiments on national territory and to carry out inspections at productions sites.

For such purposes, the said Ministry shall be entitled to the assistance of agricultural research institutes, university institutes and those institutes set up under international conventions or agreements to which Italy is a party.

Article 18

In order to enable the Ministry of Agriculture and Forestry to give its advices in conformity with the provisions of this Decree, an Advisory Commission shall be set up in that Ministry by decree of the Minister of Agriculture and Forestry.

The Commission shall consist of:

(1) a Chairman, who shall be a Section Head of the Council of State and be appointed by its President;

(2) the Director General for Agricultural Production, Ministry of Agriculture and Forestry;

⁶ Article 54^{quater}, second paragraph, reads as follows:

"...the proprietor of the patent and any persons holding rights in the patent on the basis of recorded or registered acts, may oppose the grant of the application or declare not to accept the amount and terms of payment of the compensation. Such opposition must be accompanied by the reasons therefor."

Article 50, second paragraph, reads as follows:

"...[the] amount and the terms of payment shall be determined by a Board of Arbitration, consisting of three members, one to be appointed by each of the parties and the third by the first two or, in case of disagreement, by the President of the Board of Appeals. The Board of Arbitration shall base its award on a fair evaluation. If its award is clearly unfair or wrong or if one of the parties refuses to appoint its arbitrator, the matter shall be decided by a judge."

(3) the Director General of the Department for the Protection of Agricultural Production, Ministry of Agriculture and Forestry;

(4) the Director General of the Department of Upland Economy and Forestry, Ministry of Agriculture and Forestry;

(5) the Director of the Institute in charge of the registers of seed product varieties;

(6) the Director of the Central Patent Office;

(7) an ordinary professor from the faculty of agriculture of a university, who shall be appointed by the Minister of Education;

(8) the Director of an agricultural experimental institute, who shall be appointed by the Minister of Agriculture and Forestry;

(9) a technical examiner from the Central Patent Office;

(10) an official of the Ministry of Health.

Those members listed in items (2) to (6) above may be represented by officials of their respective departments; for those members listed in items (7) to (10), an alternate shall be appointed.

On the decision, which must be justified, of the Chairman, particularly qualified experts, to a maximum of three, may be called upon to become members of the Commission for the examination of specific questions.

An official of the Ministry of Agriculture and Forestry from the category of directors, of a rank not lower than that of Head of Department, shall act as Secretary of the Commission.

The Commissions's term of office shall be three years, and that of its members shall be renewable.

In the event of the Commissions's term of office not being renewed on the date due, the Commission shall continue to function pending such renewal.

Before expressing its advice, the Commission may hear the views of the parties concerned or of their representatives, who shall in all cases be heard if they so request.

Article 19

Those members of the Commission who are not government officials shall receive, where appropriate, the per diem payable to higher officials.

Article 20

The expropriation referred to in Articles 60 *et seq.* of Royal Decree No. 1127 of June 29, 1939, shall, in the case of new plant varieties, be carried out in consultation with the Ministry of Agriculture and Forestry.⁷

Article 21

A copy of the introductory act of every civil legal proceeding and appeal to the Commission referred to in Article 71 of Royal Decree No. 1127 of June 29, 1939,⁸ in connection with patents for new plant varieties shall be communicated to both the Central Patent Office and the Ministry of Agriculture and Forestry by those persons instituting the proceedings. If this has not been done, the judicial authority or the aforementioned Commission may, at any stage in the proceedings and before reaching a decision, request that such a communication be made.

Article 22

The patents for new plant varieties shall be the subject of the same fees and the same time limits for payment as are provided for patents for industrial inventions.

For the application for and grant of a special compulsory license under Article 15 above, the same fees shall be due, and at the same dates, as are provided for the ordinary compulsory licenses in item 91 of title VIII of the tariff attached to the Decree of the President of the Republic No. 641 of October 26, 1972, as subsequently amended.

Article 22bis

For the issuance of the advices and the undertaking of the technical control tests provided by Articles 11 and 12 above, the compensations provided by the tariff fixed by Decree of the Minister of Agriculture and Forestry, after consultation of the competent department of the High Council for Agriculture and Forestry, shall be due in proportion with the cost of the service.

Such compensations shall be served into a special item of the State budget by the applicants for patents for new plant varieties.

Article 23

The costs of implementation of this Decree, estimated at 120 million Lira for 1976, shall be offset by the income derived from the fees laid down in the preceding Article.

⁷ i.e. in the interest of the military defense of the country or for other reasons of public interest.

⁸ i.e. the Board of Appeals.

The Minister for the Treasury shall be authorized, by means of appropriate decrees, to amend the budget as necessary.

Article 24

The provisions of this Decree shall apply, from the date of its coming into force, to new plant varieties of the following genera and species: (1) wheat; (2) barley; (3) rice; (4) maize; (5) lucerne; (6) clover; (7) rose; (8) carnation; (9) grapevine and its rootstocks; (10) poplar.

By decree of the Minister of Industry, Commerce and Handicrafts in agreement with the Minister of Agriculture and Forestry, the foregoing provisions may be extended gradually to new plant varieties of other genera and species.

Article 25

This Decree shall enter into force 180 days after the date of its publication in the Official Journal of the Italian Republic.

The necessary technical and administrative measures for implementation of this Decree shall be provided for by decree of the Minister for Industry, Commerce and Handicrafts, in agreement with the Minister of Agriculture and Forestry and the Minister of Health.

This Decree, fitted with the Seal of the State, shall be included in the Official Collection of Laws and Decrees of the Italian Republic. It shall be the obligation of each and every person to observe the Decree and to see that it is observed.

Article 15 of Law No. 620 of October 14, 1985

The compensations referred to in the preceding Article [Article 22*bis*] and the procedure for their collection shall apply to the applications for patents concerning new plant varieties filed after the date of entry into force of this Law.

Within one year from the date referred to in the preceding paragraph, there shall be provided, by Decree of the Minister of Industry, Commerce and Handicrafts, in agreement with the Minister of Agriculture and Forestry and the Minister of Health, for the amendment of the Ministerial Decree of October 22, 1976, published in the Official Journal No. 15 of January 18, 1977, containing the Implementing Regulations of the Decree of the President of the Republic No. 974 of August 12, 1975.

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